



Boards of Appeal  
Operations Area

# OVERVIEW OF GC/CJ CASE-LAW

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## Preface

The Operations Area of the Boards of Appeal prepares this OVERVIEW OF GC/CJ CASE-LAW.

It contains a systematic compilation of the most important key points of judgments and of orders rendered by the General Court and the Court of Justice of the European Union as from 1 of January 2019 on actions brought against decisions taken by the Office's Boards of Appeal in trade mark and design matters. The overview also contains key points of judgments rendered by the Court of Justice in preliminary rulings on IP rights and their enforcement. The key points consist of new or infrequent statements or statements that, while not new, are relevant in confirming established case-law.

Please note that the key points do not necessarily reproduce the exact wording of the judgments or orders. Each key point is preceded by indicators to allow the user to quickly identify the case-law of interest and the relevant issues.

The hyperlinks in the case reference lead to the Office's eSearch Case Law database, giving the user easy access to the full text of the judgment or order, together with any available translations of them, a summary of the case, and also further relevant information and documents (e.g. first instance and BoA decisions) and a link to the InfoCuria Database of the Court of Justice of the European Union.

This compilation will be constantly updated with the corresponding key points of future judgments and orders, allowing users to search quickly and easily the most recent case-law.

## List of abbreviations

BoA: Board of Appeal  
CD: Cancellation Division  
CJ: Court of Justice of the European Union  
GC: General Court of the European Union  
GI: Geographical Indications  
IR: International Registration  
LOC: Likelihood of confusion  
OD: Opposition Division  
RPCJ: Rules of Procedure of the Court of Justice  
RPGC: Rules of Procedure of the General Court  
Statute: Statute of the Court of Justice of the European Union  
TFEU: Treaty on the Functioning of the European Union  
WIPO: World Intellectual Property Organisation

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# CHAPTER I – PROCEDURAL MATTERS

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## 1 PROCEEDINGS BEFORE THE CJ

### 1.1 ADMISSIBILITY

#### 1.1.1 Appeal allowed / not allowed to proceed [applicable as from 1 May 2019]

##### **Article 58a(3) Statute – Article 170a(1) RPCJ**

An appeal brought against a decision of the GC concerning a decision of the BoA is only allowed to proceed, wholly or in part, where it raises an issue that is significant with respect to the unity, consistency or development of EU law, Article 58a(3) Statute, Article 170a(1) RPCJ (§ 2-4).

10/07/2019, C-359/19 P, [MEBLO](#), EU:C:2019:591, § 2-4

##### **Request that the appeal be allowed to proceed – Article 58a(3) Statute – Article 170a(1) RPCJ**

The appellant must annex to the appeal a request that the appeal be allowed to proceed (the request), setting out the issue raised by the appeal that is significant with respect to the unity, consistency or development of EU law and containing all the information necessary to enable the CJ to rule on that request, Article 170a(1) RPCJ (§ 4).

It is for the appellant to demonstrate that the issues raised by its appeal are significant with respect to the unity, consistency or development of EU law (§ 15-17).

The request must contain all the information necessary to enable the Court to give a ruling on whether the appeal should be allowed to proceed and to specify, where the appeal is allowed to proceed in part, the pleas in law or parts of the appeal to which the response must relate (§ 16).

The request must set out clearly and in detail the grounds on which the appeal is based, identify with equal clarity and detail the issue of law raised by each ground of appeal, specify whether that issue is significant with respect to the unity, consistency or development of EU law and set out the specific reasons why that issue is significant according to that criterion. As regards, in particular, the grounds of appeal, the request must specify the provision of EU law or the case-law that has been infringed by the judgment under appeal, explain succinctly the nature of the error of law allegedly committed by the GC, and indicate to what extent that error had an effect on the outcome of the judgment under appeal. Where the error of law relied on results from an infringement of case-law, the request that the appeal be allowed to proceed must explain, in a succinct but clear and precise manner, first, where the alleged contradiction lies, by identifying the paragraphs of the judgment or order under appeal that the appellant is calling into question, as well as those of the ruling of the CJ or the GC alleged to have been infringed, and, secondly, the concrete reasons why such a contradiction raises an issue that is significant with respect to the unity, consistency or development of EU law (§ 17).

24/10/2019, C-614/19P, [Personenkraftwagen / Kraftwagen et al.](#), EU:C:2019:904, § 4, 15-17

##### **Article 58a(3) Statute – Article 170b RPCJ – Request demonstrating that an issue is significant with respect to the unity, consistency or development of EU law – Appeal allowed to proceed**

In accordance with the burden of proof which lies with an appellant requesting that an appeal be allowed to proceed, the appellant must demonstrate that, independently of the issues of law invoked in its appeal, the appeal raises one or more issues that are significant with respect to the

unity, consistency or development of EU law, the scope of that criterion going beyond the judgment under appeal and, ultimately, its appeal (04/05/2021, C-26/21P, Juvederm ultra, EU:C:2021:355, § 16) (§ 27).

In order to demonstrate that that is the case, it is necessary to establish both the existence and significance of such issues by means of concrete evidence specific to the particular case, and not simply arguments of a general nature (04/05/2021, C-26/21P, Juvederm ultra, EU:C:2021:355, § 20) (§ 28).

In the present case the appellant, apart from identifying the issue, namely the question whether a possible legislative lacuna in an act of EU law (Article 41 CDR) can be made good by the direct application of a provision of international law which does not satisfy the conditions required by the case-law of the Court of Justice in order to have direct effect (Article 4 Paris Convention) (§ 23-25) having effect on the outcome of the judgment under appeal (§ 26), demonstrates to the requisite legal standard that the appeal raises an issue that is significant with respect to the unity, consistency and development of EU law (§ 31-34).

In that regard, the appellant points out that the point of law raised by its appeal goes beyond the scope of that appeal in that the allegedly erroneous interpretation of Article 41(1) CDR will have repercussions on the admissibility of priority claims for Community designs and on the assessment of the novelty of a Community design (§ 31). It states that its appeal also goes beyond the context of the law applicable to Community designs in that the principle established by the judgment under appeal is liable to determine the system of priority claims applicable to other types of intellectual property rights. It provides concrete examples of the consequences that the judgment under appeal could have for patent applicants and points to the risk of legal uncertainty and lack of reciprocity in certain third countries resulting from the recognition of a 12-month priority period for Community designs where the priority claim is based on a patent application (§ 32). Last, the appellant highlights the systemic consequences, affecting the unity, consistency and development of EU law, of recognising that Article 4 of the Paris Convention has direct effect in that, first, the interpretation of that article by the EU judiciary would be imposed on the EU legislature and the Member States of the EU and, second, such recognition would run counter to the objectives of the Paris Convention and the Agreement on Trade-Related Aspects of Intellectual Property Rights, contained in Annex 1C to the Marrakesh Agreement establishing the World Trade Organization (WTO) (§ 33).

10/12/2021, C-382/21 P, [Turn- oder Sportgeräte und -artikel](#), EU:C:2021:1050, § 27-28, 31-34

### **Appeal not allowed to proceed**

A general claim that the GC applied its own case-law or that of the CJ incorrectly is not, in itself, sufficient to establish, in accordance with the burden of proof which lies with the person requesting that an appeal be allowed to proceed, that that appeal raises an issue that is significant with respect to the unity, consistency and development of EU law (§ 18).

The fact that an issue of law has not been examined by the Court does not mean that that issue is necessarily one of significance with respect to the development of EU law. The appellant is still required to demonstrate that significance by providing detailed information regarding not only the novelty of that issue but also the reasons why the issue is significant in relation to such development (§ 21).

06/04/2022, C-19/22 P, [Labels](#), EU:C:2022:262, § 18, 21

## 1.1.2 Admissibility of the appeal

### 1.1.2.1 Locus standi, interest in bringing proceedings

#### **Appeal against GC judgment dismissing action brought against revocation decision – Interest in bringing an appeal – Admissibility**

An appellant's interest in bringing appeal proceedings presupposes that the appeal must be likely, if successful, to procure an advantage for it (§ 16). The BoA decision, which was subsequently revoked by the contested decision, was favourable to the appellant [proprietor] insofar as the appeal lodged by the invalidity applicant against the CD's decision, which was partially favourable in itself to the proprietor, was rejected. If the present appeal were allowed and the judgment under appeal annulled, the BoA's decision would remain in force, so that the appeal would procure an advantage to the appellant [proprietor], since the latter would continue to benefit from the protection for the word mark Repower for certain goods and services (§ 17-18). This cannot be called into question by the argument that this advantage would only be temporary, because the GC implicitly stated in the judgment under appeal that it would have to annul the BoA's decision which contains an inadequate statement of reasons (§ 19).

31/10/2019, C-281/18 P, [REPOWER](#), EU:C:2019:916, § 16-19

### 1.1.2.2 Form, time limit, means of communication

#### **Calculation of the time limit to bring an appeal – Extension on account of distance**

In accordance with Article 56 of the Statute, the time limit for bringing an appeal is two months from the date of notification of the decision to be appealed. That time limit is to be extended on account of distance by a single period of 10 days, Article 51 RPCJ (§ 22).

The single period of extension on account of distance is not to be considered to be distinct from the period for bringing an appeal referred to in Article 56 of the Statute, but rather as an integral part of that period which it extends by a fixed period of time. The period expires at the end of the day that, in the last month in which the period ends, bears the same number as the day from when the time limit started, that is to say the day of notification, and then to which is added a single period of 10 days on account of distance (11/06/2020, C-575/19 P, GMPO v Commission, EU:C:2020:448, § 30) (§ 25).

Consequently, Article 49(2) RPCJ, which states that 'if the time limit would otherwise end on a Saturday, Sunday or an official holiday, it shall be extended until the end of the first subsequent working day', applies only to the end of the period of two months plus 10 days (§ 26).

03/09/2020, C-174/20 P, [VirusProtect](#), EU:C:2020:651, § 22, 25-26

#### **Inadmissibility of an appeal relating to costs – Article 58 Statute**

'No appeal shall lie regarding only the amount of the costs or the party ordered to pay them' (Article 58 Statute). Where all grounds of an appeal are rejected, any form of order sought concerning the alleged unlawfulness of the GC's decision on costs is rejected as inadmissible (Order of 15/10/2012, Internationaler Hilfsfonds v Commission, C-554/11 P, EU:C:2012:629, § 38, 39) (§ 100).

29/07/2019, C-124/18P, [Blue and Silver \(COLOUR MARK\)](#), EU:C:2019:641, § 100

### 1.1.3 Admissibility of the pleas

#### 1.1.3.1 Distinction between points of law and matters of fact

- Points of law

##### **Methodological error in the assessment – Failure to take all relevant factors into account**

The existence of a LOC on the part of the public must be assessed globally, taking into account all the factors relevant to the circumstances of the case. Whereas the evaluation of those factors is an issue of fact that cannot be reviewed by the Court, failure to take all the relevant factors into account constitutes an error of law and may, as such, be raised before the Court in the context of an appeal (16/06/2011, C-317/10 P, *Uniweb*, EU:C:2011:405, § 45) (§ 13). An alleged methodological error in the assessment of the possible existence of a LOC, in that the GC failed to take account, in its examination of the similarity between the signs, of the name in normal script of the mark applied for, as set out in the *European Union Trade Marks Bulletin*, constitutes an error of law (§ 13).

04/07/2019, C-99/18 P, [Fl \(fig. / fly.de \(fig.\)\)](#), EU:C:2019:565, § 13

##### **Misinterpretation of Article 95(1) EUTMR – Rejection as inadmissible of a plea raised for the first time before the GC concerning alleged weak distinctive character of the earlier mark**

The allegation that the GC misinterpreted and misapplied Article 76(1) CTMR [now Article 95(1) EUTMR] by declaring the appellant's argument concerning the weak distinctive character of the earlier mark inadmissible on the ground that that argument had been put forward before it for the first time, is a question of law which may be subject to review on appeal (§ 26).

18/06/2020, C-702/18 P, [PRIMART Marek Łukasiewicz \(fig.\) / PRIMA et al.](#), EU:C:2020:489, § 26.

##### **Criteria for assessment of existence of genuine use – Methodology and criteria for assessment of conceptual similarity**

The criteria in respect of which the GC must assess the existence of genuine use of a trade mark for the goods or services for which it is registered, or part of those goods or services, within the meaning of Article 42(2) CTMR [now Article 47(2) EUTMR], as well as the methodology and criteria within the assessment of the conceptual similarity of the signs, are questions of law which can be subject to review by the CJ on appeal (12/12/2019, C-143/19 P, *EIN KREIS MIT ZWEI PFEILEN (fig.)*, EU:C:2019:1076, § 51) (§ 29, 74).

16/07/2020, C-714/18 P, [tigha / TAIGA](#), EU:C:2019:1139, § 29, 74

- Matters of fact

##### **Well-known facts**

The GC's finding on whether or not facts on which the BoA based its decision are well known is a factual assessment which, save where the facts or evidence are distorted, is not subject to review by the CJ on appeal (§ 69).

16/01/2019, C-162/17 P, [LUBELSKA \(FIG. MARK\) / Lubeca](#), EU:C:2019:27, § 69

- Control of the legal qualification of the facts

[No key points available yet.]

### 1.1.3.2 Distortion of facts

#### **Distortion of certain facts**

The GC has exclusive jurisdiction to assess the value of any items of evidence submitted to it, unless there has been a distortion of the facts or evidence (19/10/2018, C-198/16 P, *Agriconsulting Europe v Commission*, EU:C:2017:784, § 69 and the case-law cited) (§ 55).

16/09/2020, C-121/19 P, [EDISON \(fig.\)](#), EU:C:2020:714, § 55

#### **Distortion of certain facts – No impact on the result**

The CJ reveals numerous flaws in the GC's judgment: some of the facts were distorted by the GC in the judgment (§ 51-56); the GC did not justify its finding that the contested mark is similar to the sign used by the invalidity applicant and that it could be confused with it (§ 59); the GC was wrong to find that the proprietor intended to exploit the economic potential that could be mined from the name of the invalidity applicant's sign, because it is based on an unsubstantiated assertion that the signs in question are similar (§ 66). However, despite those flaws, the CJ upholds the GC's judgment, holding that the GC had highlighted certain objective circumstances and, solely on the basis of these circumstances, it was entitled to find that the proprietor had acted in bad faith (§ 67-68).

13/11/2019, C-528/18 P, [Outsource 2 India \(fig.\)](#), EU:C:2019:961, § 51-56, 59, 66-68

### 1.1.3.3 Pleas to be put forward expressly, intelligibly and coherently

[No key points available yet.]

### 1.1.3.4 Mere repetition of the arguments put forward before the GC

[No key points available yet.]

### 1.1.3.5 Inadmissibility of 'new' pleas and exceptions to the principle

[No key points available yet.]

### 1.1.3.6 Pleas raised for the first time in the reply or during the hearing

#### **Belated plea – Inadmissibility**

A plea of partial inadmissibility regarding a head of claim that it is raised only at the hearing is inadmissible, and in any event, ineffective, when it could have been raised at the stage of the reply (22/03/2018, T-581/16, *Popotas v Ombudsman*, EU:T:2018:169, § 66) (§ 24-26).

30/06/2021, T-531/20, [ROLF \(fig.\) / Wolf et al.](#), EU:T:2021:406, § 24-26

### 1.1.4 Cross-appeals

[No key points available yet.]

## 1.2 REVIEW OF THE DECISIONS OF THE GC

### 1.2.1 Essential procedural requirements

[No key points available yet.]

### 1.2.2 Conditions for admissibility

#### **Obligation to indicate the specific points of the GC judgment that are challenged**

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

16/09/2020, C-121/19 P, [EDISON \(fig.\)](#), EU:C:2020:714, § 37

### 1.2.3 Rights of the defence

[No key points available yet.]

### 1.2.4 Duty to state reasons

#### **Scope of the GC's duty to state reasons – Article 36 Statute – Article 53 Statute**

The GC's duty to state reasons under Article 36 and the first paragraph of Article 53 of the Statute does not require the GC to provide an account that follows exhaustively and one by one all the arguments put forward by the parties to the case. The reasoning may also be implicit, on condition that it enables the persons concerned to understand the grounds of the GC's judgment and provides the CJ with sufficient information to exercise its powers of review on appeal (20/09/2016, *Mallis and Others v Commission and ECB*, C-105/15 P to C-109/15 P, EU:C:2016:702, § 45) (§ 17).

04/07/2019, C-99/18 P, [Fl \(fig. / fly.de \(fig.\)\)](#), EU:C:2019:565, § 17

16/01/2019, C-162/17 P, [LUBELSKA \(FIG. MARK\) / Lubeca](#), EU:C:2019:27, § 79

#### **Sufficient implicit reasoning – References to other EUTMs / identical national marks**

The Court's reasoning in rejecting the applicant's references to earlier BoA or national decisions may also be implicit, without infringing the Court's obligation to state reasons (§ 45).

03/09/2020, C-214/19 P, [achtung! \(fig.\)](#), EU:C:2020:632, § 45

### 1.2.5 Obligation to respond to the heads of claim and pleas

[No key points available yet.]

## 1.3 STAY OF THE PROCEEDINGS

[No key points available yet.]

## 1.4 DISCONTINUANCE AND NO NEED TO ADJUDICATE

[No key points available yet.]

## 1.5 REMITTAL/NON-REMITTAL FROM THE CJ TO THE GC

[No key points available yet.]

## 1.6 COSTS

[No key points available yet.]

## 1.7 OTHER QUESTIONS

### Revision – Article 44 Statute – Article 159 RPCJ

Revision is not an appeal procedure, but an exceptional review procedure that allows the authority of res judicata attaching to a final judgment or to an order to be called into question on the basis of the findings of fact relied upon by the Court.

Revision presupposes the discovery of elements of a factual nature that existed before the judgment or the order and that were unknown at that time to the Court that delivered the judgment or the order as well as to the party applying for revision and that, had the Court been able to take them into consideration, could have led it to a different determination of the proceedings (§ 25).

08/05/2019, C-118/18 P REV [bittorrent](#), EU:C:2019:396, § 25

16/01/2020, C-118/18 P-REV II, [bittorrent](#), EU:C:2020:11, § 28

### Request to reopen the oral part of the procedure – Article 83 RPCJ

The RPCJ make no provision for submitting observations in response to the Advocate General's Opinion. Disagreement with the Advocate General's Opinion cannot therefore in itself constitute grounds justifying the reopening of the oral procedure. The Court is not bound by the description of the grounds of appeal and arguments, as set out in the Advocate General's Opinion. The findings in that opinion do not constitute a new fact submitted by a party after the closure of the oral part of the procedure within the meaning of Article 83 RPCJ (§ 37-38).

05/03/2020, C-766/18 P, [BBQLOUMI \(fig.\) / HALLOUMI.](#), EU:C:2020:170, § 37-38

## 2 PROCEEDINGS BEFORE THE GC

### 2.1 ADMISSIBILITY

#### 2.1.1 Admissibility of the application

##### 2.1.1.1 Locus standi, interest in bringing proceedings

#### Locus standi – Several applicants

Where admissibility must be established for one and the same application lodged by a number of applicants and the application is admissible in respect of one of them, there is no need to consider whether the other applicants are entitled to bring proceedings (24/03/1993, CIRFS and Others v Commission, C-313/90, EU:C:1993:111, § 31) (§ 17-19).

03/10/2019, T-533/18, [WANDA FILMS / WANDA et al.](#), EU:T:2019:727, § 17-19  
03/10/2019, T-542/18, [wanda films \(fig.\) / WANDA et al.](#), EU:T:2019:728, § 17-19

### **No locus standi – International registration designating the EU – No recording of the change in ownership in the international register – Inadmissibility of the action**

The admissibility of an action must be judged by reference to the situation prevailing when the application was filed (§ 20). Under Article 72(4) EUTMR, action against a BoA decision is open to any party to proceedings before the BoA adversely affected by its decision (§ 21).

Where the change in ownership of an international registration designating the European Union takes place after the BoA has adopted a decision, but before an action has been brought before the GC, the new proprietor may bring an action before the GC without having to submit an application for replacement and should be accepted as a party to the proceedings once it has proven ownership of the registration invoked before the EUIPO (see, by analogy, 28/06/2005, T-301/03, Canal Jean, EU:T:2005:254, § 19, and 21/04/2010, T-361/08, Thai silk, EU:T:2010:152, § 31) (§ 24).

However, the date on which a change in ownership is recorded in the international register is only relevant for establishing the admissibility of the action. According to the combined reading of Article 20 EUTMR, in particular Article 20(11) EUTMR, on the one hand, and Article 199 EUTMR on the other, the new proprietor may invoke the rights arising from the international registration only after the recording of a change in ownership in the international register (§ 22).

16/01/2020, T-128/19; [Sativa \(fig.\) / K KATIVA \(fig.\) et al.](#), EU:T:2020:3, § 21-22, 24

### **Interest in bringing the proceedings – Lenient interpretation of arguments and pleas in law – Admissibility of the action**

The BoA refused registration of the mark under two absolute grounds for refusal, Article 7(1)(b) and Article 7(1)(c) EUTMR. Before the GC, the applicant explicitly challenged only one of them (Article 7(1)(b) EUTMR). First, the interest in bringing the proceedings must be assessed based on the subject matter of the action, and not based on the merits. Second, what matters is the substantive content of the applicant's arguments, not the formal titles of the pleas in law. The applicant's various arguments in the action may be interpreted as also criticising the assessments of the BoA regarding descriptiveness under Article 7(1)(c) EUTMR (§ 19, 25). The applicant has a legitimate interest in seeking the annulment of the contested decision. The action is admissible (§ 16-26).

19/05/2021, T-535/20, [TIER SHOP \(fig.\)](#), EU:T:2021:283, § 16, 19, 25-26

### **Interest in bringing the proceedings – Invalidity of the contested mark following annulment or alteration of the contested decision capable in itself to have legal consequences and to procure an advantage to the applicant – Admissibility**

An interest in having the contested act annulled requires that the annulment of that act must be capable, in itself, of having legal consequences and that the action may therefore, through its outcome, procure an advantage to the party which brought it (17/09/2015, C-33/14 P, Mory and Others v Commission, EU:C:2015:609, § 55) (§ 18).

According to Article 62(2) EUTMR, a trade mark which has been declared invalid is to be deemed not to have had, from the outset, the effects specified in that regulation. It follows that the invalidity

of the contested mark, which is liable to occur only following the annulment or alteration of the contested decision, is capable of having legal consequences and the action is capable of procuring an advantage to the applicant in respect of the period prior to the expiry of the registration of the earlier design (§ 18).

Consequently, neither the fact that the registration of the earlier design has expired, nor the fact that the applicant cannot prohibit, by virtue of that design, the use of other marks registered after the expiry of the registration of that design deprived the applicant of an interest in having the contested decision annulled or altered (§ 18). Therefore the action is admissible (§ 19).

02/06/2021, T-169/19, [DEVICE OF A POLO PLAYER \(fig.\) / DEVICE OF A POLO PLAYER \(fig.\) et al.](#), EU:T:2021:318, § 18-19

### **Lack of interest in bringing the proceedings – Revocation of the earlier mark predating the contested BoA decision – No need to adjudicate**

The revocation of the earlier mark with effect from a date prior to that of the contested decision taken by the BoA, although declared after the adoption of the contested decision, deprives the invalidity proceedings of their very basis. Those proceedings having therefore become devoid of purpose, the contested decision has been deprived of its purpose and does not take effect (§ 42). Therefore, a judgment of the GC on the merits cannot bring any benefit to the appellant (§ 43), irrespective of the possible claims to be made in infringement actions before national courts (§ 44-47).

20/07/2021, T-500/19, [Coravin](#), EU:T:2021, § 42-47

### **Lack of interest in bringing proceedings – Action brought against an obsolete BoA decision – Article 71(3) EUTMR**

Where an invalidity application is withdrawn after the adoption of the BoA's decision and before the action was brought before the GC, within the two-month period for bringing an action before the GC, the contested decision becomes obsolete and cannot take effect nor become final. The EUTM proprietor does not have any interest in bringing proceedings since the annulment of an obsolete decision cannot procure it any advantage (§ 28-30).

23/05/2019, T-609/18, [d:ternity / iTernity et al.](#), EU:T:2019:366, § 28-30

### **No need to adjudicate – Opposition proceedings – Partial Invalidity of the earlier mark – Effects on the proceedings before the BoA**

The action before the GC becomes devoid of purpose where the earlier mark is partially declared invalid with effect *ex tunc* (Article 62(2) EUTMR) and the contested decision is based exclusively on the existence of that earlier right which has been declared invalid. The contested decision is deemed not to have had effect from the outset, and cannot take effect in the future. The GC therefore cannot rule on the legality of a decision, which is deprived of all legal effect. *A fortiori*, the GC cannot annul that decision (14/02/2017, T-333/14, SportEyes / EYES SPORT EYE (fig.) et al., EU:T:2017:108, § 22-26, 37-40). The applicant would not gain any advantage from the annulment of the contested decision (§ 41).

Where neither the OD nor the BoA examined whether there was a LOC between the opposing signs in respect of the goods for which the earlier mark remains registered, the BoA is still called upon to resolve the dispute in the appeal proceedings and to either examine the appeal itself or to remit the case to the OD for examination of whether there is a LOC between the mark applied for and the earlier mark, as it remains registered (§ 42).

23/02/2021, T-587/19, [MARIEN \(fig.\) / MARIN](#), EU:T:2021:107, § 37-42

### **No challengeable act – Action brought against an intermediate measure – Inadmissibility**

An action for annulment is, in principle, only available against a measure by which the institution concerned definitively determines its position upon the conclusion of an administrative procedure. An intermediate measure whose aim is to prepare the final decision cannot form the subject matter of an action for annulment (13/10/2011, C-463/10 P and C-475/10 P *Deutsche Post and Germany v Commission*, EU:C:2011:656, § 50) (§ 22).

The BoA's decision to suspend the proceedings before it pending a definitive decision of the GC in a parallel case (and taken in accordance with the principles of legal certainty, procedural economy and good administration, after balancing the interests of the parties to the dispute) constitutes an intermediate measure, the purpose of which is to prepare for the final decision to be adopted by the BoA. It is not intended to produce binding legal effects capable of affecting the interests of the applicant before the GC, by bringing about a distinct change in its legal position, insofar as it does not terminate the proceedings before the BoA and does not definitively determine the position of the BoA as to the outcome of the appeal before it (05/09/2019, C-162/19 P, *INSPIRED BY ICELAND-ICELAND*, EU:C:2019:686, § 5, 6) (§ 25).

*15/07/2020, T-838/19 to T-842/19, [Fluid distribution equipment](#), EU:T:2020:343, § 22, 25*

### **No challengeable act – Decision to refer an appeal case to the Grand Board of Appeal**

A decision of the Presidium to refer an appeal case to the Grand Board cannot be challenged as such, but only to the extent that this decision may affect the legality of the decision of the BoA, given that actions for annulment according to Article 72(1) EUTMR can only be made against decisions of the BoA (§ 22-23).

*01/09/2021, T-96/20, [Limbic® Types](#), EU:T:2021:527, § 22-23*

### **Challengeable act – Action against a BoA decision to remit the case to the OD – Admissibility**

While it is true that an action brought against a preparatory act is not admissible, since it is not brought against an act which constitutes the final position taken by the administrative body at the end of a procedure, the Courts of the EU have previously recognised the admissibility of actions against acts which did not set out the final position of the administrative body but whose implications for the persons to whom they were addressed justified them being regarded as more than merely preparatory acts. Furthermore, Article 72 EUTMR, which provides that 'actions may be brought before the GC against decisions of the BoA in relation to appeals', does not distinguish between those decisions depending on whether or not they constitute the final position of the EUIPO bodies (§ 44).

In the present case, the BoA had, in any event, given a final decision on certain aspects of the dispute, binding in respect of those points that the OD was tasked with considering after its remittal. Accordingly, the applicant had to be able to challenge the BoA's final conclusions, without having to wait for proceedings to continue before the OD so that it could then bring an appeal before the BoA and, if necessary, subsequently bring an action before the Court against the new decision (§ 45).

*[23/09/2020, T-421/18, MUSIKISS / KISS \(fig.\) et al.](#), EU:T:2020:433, § 44-45*

### **Article 50 TUE – Withdrawal of a Member State – Opposition based on earlier UK mark – Interest in bringing proceedings**

The fact that the earlier trade mark could lose the status of a trade mark registered in a Member State after the filing of the application for registration of the EU trade mark against which a notice of opposition has been filed on the basis of that earlier mark, in particular following the possible

withdrawal of the Member State concerned from the European Union under Article 50 TEU, without specific provision having been made in that respect in any agreement concluded under Article 50(2) TEU, is therefore, in principle, irrelevant to the outcome of the opposition (§ 19).

The existence of an interest in bringing proceedings before the GC against a decision of the BoA allowing such an opposition based on such an earlier national mark – or upholding a decision of the OD in that sense – is not, in principle, affected (see, by analogy, 08/10/2014, T-342/12, *Star*, EU:T:2014:858, § 23-29) (§ 19).

30/01/2020, T-598/18, [BROWNIE / BROWNIE, Brownie \(series mark\)](#); EU:T:2020:22, § 19

### **Withdrawal of the UK from the EU – Transition period – Opposition based on earlier UK mark – Protection of trade marks registered in the UK**

In the absence of any provisions to the contrary in the withdrawal agreement, the EUTMR continues to be applicable to UK trade marks and, accordingly, until the end of the transition period earlier marks registered in the UK continue to receive the same protection they would have received had the UK not withdrawn from the EU (§ 33).

The existence of a relative ground for opposition must be assessed as at the time of filing of the application for registration of an EUTM against which the opposition has been filed (30/01/2020, T-598/18, *BROWNIE / BROWNIE, Brownie (series mark)*, EU:T:2020:22, § 19) (§ 34).

The fact that the earlier trade mark could lose the status of a trade mark registered in a Member State at a time after the filing of the application for registration of the EUTM (in particular following the possible withdrawal of the Member State concerned from the EU) is in principle irrelevant to the outcome of the opposition (30/01/2020, T-598/18, *BROWNIE / BROWNIE, Brownie (series mark)*, EU:T:2020:22, § 19) (§ 35).

23/09/2020, T-421/18, [MUSIKISS / KISS \(fig.\) et al.](#), EU:T:2020:433, § 33-35

01/12/2021, T-467/20, [ZARA / ZARA \(fig.\) et al.](#), EU:T:2021:842, § 58-59

### **Withdrawal of the UK from the EU – Transition period – Opposition based on an earlier non-registered UK mark – Subject matter of the action – Interest in bringing proceedings – Admissibility**

The withdrawal of the United Kingdom from the European Union has not rendered this dispute devoid of purpose (§ 16-23). The withdrawal agreement, which set out the arrangements for the withdrawal of the United Kingdom from the EU, entered into force on 1 February 2020. It provided for a transition period between 1 February and 31 December 2020, during which EU law continued to be applicable in the United Kingdom (§ 16).

As regards the subject matter of the action and admissibility, the existence of a relative ground for opposition must be assessed at the time that the Office gives a decision on the opposition at the latest. The GC recently held that the earlier mark on which the opposition is based must be valid not only at the time of the publication of the application for registration of the mark applied for but also at the time that the Office gives a decision on the opposition (14/02/2019, T-162/18, *ALTUS (fig.) / ALTOS et al.*, EU:T:2019:87, § 41). There is contrasting case-law which states that, in assessing whether a relative ground for opposition exists, it is appropriate to look only at the time of filing of the application for an EUTM against which a notice of opposition has been filed on the basis of an earlier trade mark (17/10/2018, T-8/17, *GOLDEN BALLS / BALLON D'OR et al.*, EU:T:2018:692, § 19; 30/01/2020, T-598/18, *BROWNIE / BROWNIE, Brownie (series mark)*, EU:T:2020:22, § 19; 23/09/2020, T-421/18, *MUSIKISS / KISS et al.*, EU:T:2020:433, § 34). According to this case-law, the fact that the earlier sign could lose the status of a non-registered trade mark (or of another sign used in the course of trade of more than local significance) at a later date, in particular following the possible withdrawal of the Member State in which the mark enjoys protection is, in principle, irrelevant to the outcome of the opposition (see, by analogy,

30/01/2020, T-598/18, BROWNIE / BROWNIE, Brownie (series mark), EU:T:2020:22, § 19) (§ 17).

In the present case, there is no need to decide that question. The applicant applied for registration of the EUTM on 14 June 2017 at a time when the United Kingdom was a Member State of the EU. The decision of the BoA was taken on 2 April 2020 during the transition period. Until the end of that period, the earlier mark continued to receive the same level of protection that it would have received had the United Kingdom not withdrawn from the EU (§ 18).

Since the purpose of the action before the GC is to review the legality of decisions of the BoA, the GC must consider the date of the contested decision when assessing its legality (§ 19). For the GC to find that the litigation becomes devoid of purpose following the withdrawal of the United Kingdom from the EU, the GC would have to consider matters arising after the adoption of the contested decision which do not affect its merits (§ 20, 23).

The interest in bringing proceedings must continue until the final decision. This presupposes that the action must have the potential to procure an advantage for the party bringing it (§ 25). The GC rejects the Office's argument that the trade mark applicant had no interest in bringing proceedings because, if the opposition were upheld, the applicant would be able to convert their mark into national trade mark applications in all EU Member States. In principle, these considerations apply to all opposition proceedings (§ 24-26).

The annulment of the contested decision and referral back does not implicate that the BoA is obliged to dismiss the action in the absence of an earlier trade mark protected by the law of a Member State. Following the annulment of a decision of the BoA, the BoA must take a new decision on the same action considering the situation at the time that the action was brought, since the action is pending at the same stage as it had been before the contested decision (§ 27).

[06/10/2021, T-342/20, Abresham Super Basmati Sela Grade One World's Best Rice \(fig.\) / BASMATI, EU:T:2021:651, § 16-18, 20, 23-27](#)

### **No interest in bringing proceedings before the BoA – Article 67 EUTMR – Proceedings before the cancellation division devoid of purpose due to final decision declaring the EUTM invalid for lack of distinctive character at the date of the application**

The revocation of an EU trade mark has *ex nunc* effect, whereas the invalidation of an EU trade mark has *ex tunc* effect (§ 41).

An interest in legal protection remains even where the proprietor of an EU trade mark has surrendered it, provided that the applicant's action can still eliminate some of the effects (in the case of revocation) or, in principle, all the effects (in the case of invalidity) of the trade mark concerned. There is still an interest in continuing proceedings for a declaration of invalidity of an EU trade mark where it has been revoked. This is because the application for a declaration of invalidity can eliminate the effects of that trade mark more comprehensively than revocation. Therefore, the elimination would, in principle, concern all the effects produced by the trade mark in question (§ 45).

When examining whether the applicant still has an interest in continuing revocation proceedings, the focus should be on whether the effects of the contested trade mark can be eliminated more comprehensively by revocation than with the declaration of invalidity that has already taken place (§ 46). However, with the entry into force of the BoA's decision of 12 January 2017, which confirmed the Cancellation Division's (CD) decision of 29 January 2010 by declaring the contested mark invalid due to a lack of distinctive character at the time of filing, all effects of that mark were eliminated. Thus, the applicant could not achieve more with the revocation proceedings, which aimed to eliminate the effects of the contested trade mark as of the date of the application for revocation, than what it had already achieved through the revocation proceedings (§ 47).

Article 58(1)(a) EUTMR provides that an EU trade mark will be liable for revocation if the trade mark has not been put to genuine use in the EU in connection with the goods or services in respect of which 'it is registered'. An EU trade mark declared invalid with effect *ex tunc*, on the other hand, is deemed never to have been registered (§ 48).

In view of the above, the BoA did not err in law in holding that the applicant was not adversely affected by the CD's decision finding that the application for revocation had become devoid of purpose (§ 49). The BoA did not err in holding that the applicant was not adversely affected by the CD's decision to discontinue the proceedings and that that decision therefore did not constitute an appealable decision under Article 67 EUTMR (§ 54).

*04/02/2022, T-67/21, [Ultrafilter international](#), EU:T:2022:54, § 41, 45-49, 54*

### **Partial inadmissibility – Lack of interest in bringing proceedings**

A party to proceedings is not adversely affected by the BoA decision as far as the latter grants the request of that party, even if the BoA refrained from examining other grounds or arguments adduced by that party (§ 14).

*07/12/2022, T-747/21, [Fohlenelf](#), EU:T:2022:773*

### **Opposition proceedings – Partial revocation of earlier right postdating the contested decision**

Since the partial revocation of the earlier mark on which the opposition is based takes effect after the adoption of the BoA's contested decision, the GC does not have to take it into account for the review of legality of the contested decision (§ 20).

*21/12/2022, T-250/19, [Tradicion cz s.l. / Rivero cz et al.](#), EU:T:2022:838*

#### **2.1.1.2 Representation**

##### **Representation – No representation by a lawyer – Inadmissibility**

According to Article 19 of the Statute, two cumulative conditions must be met in order that a person may validly represent parties other than the Member States and the EU institutions before the Courts of the EU, namely: (i) that person must be a lawyer and (ii) he or she must be authorised to practise before a court of a Member State or of another State which is a party to the EEA Agreement (§ 8).

With regard to the first of those conditions, it also follows from the case-law that the person who signs the application must be a member of the Bar in order to be regarded as a lawyer for the purposes of Article 19 of the Statute; it is not sufficient that that person is entitled to represent parties in proceedings before the courts of a Member State (§ 9). The notion of 'lawyer', within the meaning of Article 19, must be interpreted independently and without reference to national law (11/05/2017, C-22/17 P, *neonart*, EU:C:2017:369, § 6-7) (§ 10).

In the present case, Mr Kivitie, who signed the application, is not a member of the Bar of Finland. Even if, as the appellant contends, Mr Kivitie was granted authorisation to practise as a licenced legal counsel and to represent his clients before all courts of law in Finland, he cannot be regarded as a 'lawyer' (*asianajaja*) within the meaning of the Finnish version of Article 19 of the Statute (§ 11). Accordingly, Mr Kivitie does not satisfy the first of the two cumulative conditions and was therefore not authorised to represent the applicant before the Court (§ 12).

*05/07/2021, T-128/21, [rubyred CRANBERRY \(fig.\)](#), EU:T:2021:479, § 8-12*

*05/07/2021, T-191/21, [Fittings for windows](#), EU:T:2021:470, § 8-12*

### **Representation by a lawyer who is not an independent third party – Lack of connections which manifestly has a detrimental effect on the representative’s capacity to carry out the client’s defence**

From the use of the word ‘represented’ in the third paragraph of Article 19 of the Statute, it follows that, for the purposes of bringing an action before the GC, a ‘party’, within the meaning of that article, in whatever capacity, is not permitted to act on its own behalf, but must use the services of a third person authorised to practise as a lawyer before a court of a Member State or of a State which is party to the EEA Agreement (04/02/2020, C-515/17 P and C-561/17 P, *Uniwersytet Wrocławski and Republic of Poland / REA*, EU:C:2020:73, § 58 and case law cited) (§ 8). The concept of the independence of lawyers, is determined not only negatively, that is to say, by the absence of an employment relationship, but also positively, that is, by reference to professional ethical obligations (06/09/2012, C-422/11 P and C-423/11 P, *Prezes Urzędu Komunikacji Elektronicznej and Republic of Poland / European Commission* EU:C:2012:553, § 24) (§ 11). In that context, the lawyer’s duty of independence is to be understood not as the lack of any connection whatsoever between the lawyer and his or her client, but the lack of connections which manifestly has a detrimental effect on his or her capacity to carry out the task of defending his or her client while acting in that client’s interests to the greatest possible extent (04/02/2020, C-515/17 P and C-561/17 P, *Uniwersytet Wrocławski and Republic of Poland / REA*, EU:C:2020:73, § 64) (§ 12).

The Court has previously held, in that regard, that a lawyer who has been granted extensive administrative and financial powers which place his or her function at a high executive level within the legal person he or she is representing, such that his or her status as an independent third party is compromised, is not sufficiently independent from that legal person. The same is true for a lawyer who holds a high-level management position within the legal person he or she is representing, or a lawyer who holds shares in, and is the Chair of the management board of the company he or she is representing (04/02/2020, C-515/17 P and C-561/17 P, *Uniwersytet Wrocławski and Republic of Poland / REA*, EU:C:2020:73, § 65) (§ 13).

In the present case, Mr Kwaśniewski and Mr Zych, who represent the applicant, a non-governmental organisation governed by Polish law (NGO), are president and vice-president of the applicant respectively, and cannot therefore be considered to satisfy the condition of being a *third party* in relation to the applicant (§ 14-16).

Mr Słoniowski, who also represents the applicant, acts as a legal adviser in a law firm where one of the partners is Mr Kwaśniewski, president of the applicant (§ 20). In view of (i) the legal nature of the duties he performs for the NGO, (ii) the fact that one of the partners of the law firm in which he acts as legal adviser is president of the NGO, and (iii) the fact that he cooperates with the president and the vice-president of the NGO for the purposes of the present case, the links between Mr Słoniowski and the NGO, applicant he represents, have a manifestly detrimental effect on his capacity to defend the client to the greatest possible extent whilst acting in that client’s interests, even though he does not occupy a management position within the applicant he represents and there is no financial connection (§ 21).

25/06/2021, T-42/21, [Fundacja Instytut na rzecz kultury prawnej Ordo Iuris v Parliament](#), EU:T:2021:385, § 12-16, 21

### **Representation by a lawyer who is not an independent third party**

From the use of the word ‘represented’ in Article 19, third paragraph of the Statute follows that, for the purposes of bringing an action before the GC, a ‘party’ within the meaning of that article, in whatever capacity, is not permitted to act itself but must use the services of a third person authorised to practise as a lawyer before a court of a Member State or of a State which is a party to the EEA Agreement (04/02/2020, *Uniwersytet Wrocławski and Republic of Poland / REA*, C-515/17 P and C-561/17 P, EU:C:2020:73, § 58 and case law cited) (§ 7).

A legal person cannot be properly represented before the EU Courts by a lawyer who occupies a directing position within the body which he represents (04/12/2014, C-259/14 P, ADR Center/Commission, EU:C:2014:2417, § 23, 27; 06/04/2017, C-464/16 P, PITEE/Commission, EU:C:2017:291, § 25). In the present case, the lawyer who represents the applicant is one of three members of the board of directors and cannot be considered to satisfy the condition of being a *third party* in relation to the applicant (§ 9-10).

17/11/2020, T-495/20, [sb hotels \(fig.\)-Sbe](#), EU:T:2020:556, § 7, 9-10

### **Representation by a lawyer who is not a third party – Director of a legal person**

A lawyer representing the applicant (legal person), who is the sole director of the applicant, cannot be considered to be a third party within the meaning of Article 19 of the Statute (05/12/1996, C-174/96 P, Lopes v Court of Justice, EU:C:1996:473, § 11; 04/12/2017, T-522/17, Nap Innova Hoteles v SRB, EU:T:2017:881, § 6-8).

26/03/2021, T-716/20, [CRZ](#), EU:T:2021:175, § 6-8

### **Article 19 Statute – Article 91(1) and (2) of the withdrawal agreement of the UK – Lack of representation – Action introduced after the end of the transition period – Contested decision adopted after the end of the transition period – Manifest inadmissibility**

According to Article 19(4) of the Statute of the CJEU, only a lawyer authorised to practise before a court of a Member State or of another State which is a party to the Agreement on the European Economic Area may represent or assist a party before the Courts of the EU. Article 91(1) and (2) of the withdrawal agreement of the UK provides for various situations in which a lawyer who is authorised to practise before the courts or tribunals of the UK may represent or assist a party before the Courts of the EU. These situations cover proceedings that were pending before the Courts of the EU prior to the end of the transition period; decisions adopted by institutions, bodies, offices and agencies of the EU before the end of that period; proceedings for failure to fulfil obligations brought by the Commission; administrative procedures concerning compliance with EU law by the UK or persons residing or established there, or concerning compliance with EU law relating to competition; European Anti-Fraud Office procedures or State aid procedures (§ 19-22).

The present action was not covered by any of the situations set out in the withdrawal agreement, with the result that the applicant's lawyers were unable to represent the applicant before the Courts of the EU (§ 24-25).

Furthermore, the case was not covered by Article 97 of the withdrawal agreement, because this provision relates solely to representation in ongoing proceedings before the EUIPO, and not before the Court (§ 23).

07/12/2021, T-422/21, [Iq / Eq](#), EU:T:2021:888, § 19-22, 23-25

### **Power of attorney signed by the applicant's legal representative**

The RPGC no longer require proof that the authority granted to the lawyer was conferred on him/her by someone authorised for that purpose, Article 51(3) RPGC (28/09/2016, T-476/15, FITNESS, EU:T:2016:568, § 19) (§ 13-14).

19/12/2019, T-40/19, [THE ONLY ONE by alphaspirt wild and perfect \(fig.\) / ONE](#), EU:T:2019:890, § 13-14

### **Certificate of the lawyer's authorisation to practise – No need to provide a translation into the language of the proceedings**

There is no need to provide a translation into the language of the proceedings (Article 46(2) RPGC) for documents lodged pursuant to Article 51(2) RPGC. In particular, the certificates showing that the parties' representatives are members of the Bar are intended first and foremost for the GC, so that it can ascertain whether the parties are properly represented. This admissibility criterion relates to public policy and the GC must verify of its own motion that it is satisfied (07/10/2014, T-531/12, T, EU:T:2014:855, § 22) (§ 20-23).

27/01/2021, T-817/19, [Hydrovision \(fig.\) / Hylö vision](#), EU:T:2021:41, § 20-23

### **Representation by a lawyer who is not an independent third party – Lack of connections which manifestly has a detrimental effect on the representative's capacity to carry out the client's defence – Lawyer working as an associate in a law firm**

From the use of the word 'represented' in the third paragraph of Article 19 of the Statute, it follows that, for the purposes of bringing an action before the GC, a 'party', within the meaning of that Article, in whatever capacity, is not permitted to act on its own behalf, but must use the services of a third person (§ 61). Representation in court, in order to protect and defend the client's interests to the greatest possible extent, can only be ensured by a lawyer acting in full independence and in line with the law and professional rules and codes of conduct (§ 62-64).

In that context, the lawyer's duty of independence must be understood not as the lack of any connection whatsoever between a lawyer and their client, but only a lack of connection which has a manifestly detrimental effect on their capacity to carry out the task of defending their client while acting in that client's best interests (04/02/2020, C-515/17 P and C-561/17 P, *Uniwersytet Wrocławski / REA*, EU:C:2020:73, § 62-64) (§ 69).

Cases of inadmissibility due to failure to perform the task of representation must be limited to situations in which it is clear that the lawyer themselves is not in a position to carry out their task of defending their client while acting in that client's best interests (§ 74). Therefore, the mere existence of a private-law contractual relationship between a lawyer and their client is insufficient to consider that that lawyer is in a situation which is manifestly detrimental to their ability to defend their client's interests (04/02/2020, C-515/17 P and C-561/17 P, *Uniwersytet Wrocławski / REA*, EU:C:2020:73, § 66-67) (§ 72).

It must be assumed that an associate lawyer in a law firm, even if they practise their profession under an employment contract, satisfies the same requirements of independence as a lawyer practising individually or as a partner in a firm. However, a distinction must be made on the basis of the situation of the client being represented (§ 79-80).

If the client is a natural or legal person who is a third party in relation to the law firm in which the associate in question carries out their duties, this does not raise any particular issue of independence. That is not the case where the client, a natural person, is themselves a founding partner of the law firm and can therefore exercise effective control over the employee. In such a case, it must be held that the links between the associate lawyer and the client – a partner – manifestly undermine the independence of the lawyer (§ 81).

24/03/2022, C-529/18 P and C-531/18 P, [PJ v EUIPO](#), EU:C:2022:218, § 61, 62-64, 6972, 79-81

### **Representation by a lawyer who is not an independent third party**

In the present case, the managing director of the applicant is also the owner and managing director of the law firm in which the applicant's representative works. In view of the relationship of subordination within the law firm in which the applicant's representative in the present dispute works, it must be assumed that the responsible owner of that law firm can exercise effective control over that representative, who, moreover, is his only employee.

Thus, the employment relationship between the applicant's representative and the responsible owner of the law firm may influence the independence of that representative, even if that law firm is a legal organizational entity distinct from the applicant. The interests of this law firm, whose owner is also the managing director of the applicant, are in fact largely identical with those of the applicant. There is therefore a risk that the professional views of the applicant's representative will be influenced, at least in part, by his professional environment (§ 31-33).

[16/06/2022, T-83/20, Tagesschau](#) annulled by judgment [30/01/2024, C-580/22 P, Tagesschau, EU:C:2024:101](#) stating in particular the following:

### **Representation by a lawyer who is not an independent third party – Presumption of independence**

Where the applicant before the GC is a legal person that is formally distinct from the law firm in which its representative works, the fact that the said representative is the only employee of the law firm whose owner and managing director is also the legal representative and managing director of the applicant and therefore they cooperate regarding the applicant's representation before the court, cannot, in itself, and in the absence of concrete evidence demonstrating the dependence of the lawyer concerned, constitute a factor capable of calling into question the independence of that lawyer (§ 57-61).

[30/01/2024, C-580/22 P, Tagesschau, EU:C:2024:101](#) annulling the GC order [16/06/2022, T-83/20, Tagesschau](#)

### **Power of attorney**

The attorney acting as a representative of a party need only prove to the GC that they are admitted to practice law and need not present a power of attorney in proper form. The power of attorney need only be proved on contestation. Even if it turns out that the power of attorney was not signed by the applicant but by his son, the general power of attorney giving authorisation to the son, which was submitted in response to a measure of organisation of procedure under Article 89 RPGC, is sufficient (§ 14-16).

[19/04/2023, T-749/21, Josef grund gerüstbau / grund \(fig.\), EU:T:2023:200](#)

### **2.1.1.3 Time limit, force majeure, means of communication**

#### **e-Curia – Article 56a(4) RPGC**

If a procedural document is lodged via e-Curia before the supporting documents required for validation of the access account have been produced, and those supporting documents are not lodged within the following 10 days, the action is manifestly inadmissible (§ 4-10).

[25/02/2019, T-759/18, Open data security, EU:T:2019:126, § 4-10](#)

[16/07/2020, T-309/20, Travelnetto / Nett-Travel et al., EU:T:2020:356, § 5-11](#)

[02/07/2021, T-290/21, Meso fresh vitamin, EU:T:2021:476, § 4-10](#)

#### **Time limit – Electronic communications – Notification by eComm – Dies a quo**

Article 4(4) of Decision No EX-13-2 of 26 November 2013 concerning electronic communication must be interpreted as meaning that notification will be deemed to have taken place on the fifth calendar day following the day on which the Office placed the document in the user's inbox, unless the actual date of notification can be accurately established as a different date within that period of time (§ 43).

[NB: Article 4(4) of Decision No EX-13-2 of 26 November 2013 was repealed by Article 3(4) of Decision No EX-19-1 of 18 January 2019 (which entered into force on 1 March 2019), which now reads ‘Notification will be deemed to have taken place on the fifth calendar day following the day on which the Office placed the document in the user’s inbox.’ Therefore, when a document is now notified electronically by the Office, an automatic extension of five calendar days following the day on which the document is placed in the User Area is included in the time limit set for any response or procedural step to be taken.]

10/04/2019, C-282/18 P, [Formula E](#), EU:C:2019:300, § 43

### **Time limit for bringing an action before the General Court**

Under Article 263 (§ 6) TFEU, an action for annulment must be instituted within 2 months of the publication of the contested measure, of its notification to the applicant, or of the day on which it came to the applicant’s knowledge. Under Article 72(5) EUTMR, this action is to be brought before the GC within 2 months of the date of notification of the decision of the BoA; a time limit that, pursuant to Article 60 RPGC, is to be extended, on account of distance, by 10 days (§ 14). The time limit for bringing proceedings is a matter of public policy (§ 15).

24/03/2022, T-544/21, [DEVICE OF THREE HORIZONTAL BLACK STRIPS \(fig.\) / DEVICE OF THREE HORIZONTAL CURVED-EDGED BLACK STRIPS \(fig.\)](#), EU:T:2022:202, § 14, 15

### **No force majeure or unforeseeable circumstances – Situation associated with the COVID-19 pandemic – Manifest inadmissibility**

In accordance with Article 45 (§ 2) of the Statute of the Court of Justice of the European Union, no right is to be prejudiced due to the expiry of a time limit if the party concerned proves the existence of unforeseeable circumstances or of force majeure (§ 17).

The concepts of unforeseeable circumstances or of force majeure require that there be abnormal difficulties that are independent of the will of the applicant and apparently inevitable, even if all due care is taken (§ 26). Both of those concepts contain an objective element, relating to abnormal circumstances extraneous to the applicant, and a subjective element on the part of that applicant, involving the obligation to guard against the consequences of the abnormal event by taking appropriate steps without making unreasonable sacrifices. In particular, the applicant must pay close attention to the course of the procedure set in motion and, in particular, demonstrate diligence in order to comply with the prescribed time limits. Therefore, the concepts of unforeseeable circumstances and of force majeure do not apply to a situation in which, objectively, a diligent and prudent person would have been able to take the necessary steps before the expiry of the period prescribed for instituting proceedings (§ 27-28).

In its action, the applicant relies on serious circumstances that have created a chaotic situation, which have a considerable impact on both the private life and the professional life of its employees. The applicant claims that, in particular, the health measures relating to the COVID-19 pandemic, imposed by the Government of Maharashtra in India, considerably restricted access to its Navi Mumbai offices from March 2021 until the end of June 2021. It maintains that those constraints, combined with IT problems beyond its control, prevented it from bringing the action earlier than 03/09/2021, when the expiry date for bringing the action was 04/06/2021 (§ 24).

However, the applicant did not provide any evidence to show that the situation associated with the COVID-19 pandemic constituted, during the 2 months and 10 days following notification of the contested decision to its representative on 25/03/2021, abnormal and unforeseeable circumstances which prevented it from bringing the action within the applicable period (§ 32-37). As regards the subjective element of unforeseeable circumstances or of force majeure, even if the disadvantages and malfunctions relied on by the applicant and resulting from the health crisis

constituted abnormal and unforeseeable circumstances extraneous to it, the applicant has not shown which steps it took in order to deal with those circumstances (§ 42-44).

[24/03/2022, T-544/21, \*DEVICE OF THREE HORIZONTAL BLACK STRIPS \(fig.\) / DEVICE OF THREE HORIZONTAL CURVED-EDGED BLACK STRIPS \(fig.\)\*, EU:T:2022:202, § 17, 24, 26-28, 32-37, 42-44](#)

#### **Application for legal aid – Compliance with time limit to bring an action by a lawyer designated by the GC**

An application for legal aid (Article 147(7) RPGC) suspends the applicant's time limit for bringing the action, which begins to run again from the date of the GC's decision on that application for legal aid. Where the GC designates the lawyer responsible for representing the applicant, that order (including a power of attorney) is notified to that lawyer, who must consequently ensure compliance with the remaining time limit for bringing proceedings (§ 14-15).

[15/01/2024, T-638/22, \*Boca parintele\*](#)

#### **2.1.1.4 Other**

#### **Admissibility of the action before GC – Article 263 TFEU – Article 63(3) EUTMR – *Res judicata***

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.

Since Article 263 TFEU governs the conditions relating to the admissibility of an action before the Court, it cannot be interpreted in the light of a provision of secondary legislation such as Article 63(3) EUTMR, which concerns the admissibility of an application for revocation or for a declaration of invalidity which has been submitted before EUIPO. The GC examination of the compliance with the conditions laid down by the provision governing 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).

[22/06/2022, T-739/20, \*Waterford\*, EU:T:2022:381](#)

#### **2.1.2 Admissibility of a cross-claim**

##### **Locus standi – Inadmissibility of a cross-claim**

Insofar as a decision of a BoA upholds a party's claims in their entirety, that party is not entitled to bring an action before the Court (14/07/2009, T-300/08, *Golden Elephant Brand*, EU:T:2009:275, § 27). A BoA decision upholds the claims of one of the parties when it has granted the party's application on the basis of one of the grounds for refusal or for invalidity of a mark or, more generally, of only part of the arguments put forward by that party, even if it did not examine, or if it rejected, the other grounds or arguments raised by that party (25/09/2015, T-684/13, *BLUECO / BLUECAR*, EU:T:2015:699, § 28 and the case-law cited therein; 17/01/2019, T-671/17, *TURBO-K / TURBO-K (fig.)*, EU:T:2019:13, § 91) (§ 24-31).

[05/02/2019, T-44/19; \*TC Touring Club \(fig.\) / TOURING CLUB ITALIANO et al.\*, EU:T:2020:31, § 24-31](#)

##### **Locus standi – Inadmissibility of a cross-claim**

By the contested decision, the BoA upheld the intervener's claims in their entirety, notwithstanding the fact that the intervener did not share the contested decision's findings relating to the goods in

respect of which genuine use was deemed proven. Therefore, the intervener is not entitled to bring a cross-claim against the contested decision, including the part of the contested decision by which the BoA declared the cross-appeal inadmissible. As a result, the cross-claim before the GC must be dismissed as inadmissible (§ 21-27).

28/04/2021, T-31/20, [THE KING OF SOHO \(fig.\) / SOHO](#), EU:T:2021:217, § 21-27

### 2.1.3 Replacement (Articles 174-176 RPGC)

#### **Transfer of an intellectual property right during proceedings before the GC**

Where an intellectual property right has been transferred to a third party, the successor to that right may apply to replace the original party in the proceedings before the GC, Article 174 RPGC. If the application for replacement is granted, the successor to the party who is replaced must accept the case as it finds it at the time of that replacement. The party is bound by the procedural documents lodged by the party which it has replaced, Article 176(5) RPGC (§ 18-21).

After entry of the transfer of an EUTM application in the Office Register, the successor may rely on the rights deriving from that application, Articles 17 and 24 CTMR [now Articles 20 and 28 EUTMR] (§ 19).

19/09/2019, T-176/17, [VEGA ONE \(fig.\) / Vegas et al.](#), EU:T:2019:625, § 18-21

### 2.1.4 Admissibility of the heads of claim

#### 2.1.4.1 Claim to issue directions to the EUIPO

##### **General principle**

Under Article 72(3) EUTMR, in an action brought against a decision of the BoA, the Court has jurisdiction to annul or to alter that decision. According to settled case-law, in an action before the EU judicature against the decision of a BoA, the Office is required, under Article 72(6) EUTMR, to take the measures necessary to comply with judgments of the EU judicature. Accordingly, it is not for the Court to issue directions to the Office, but for the Office to draw the appropriate inferences from the operative part and grounds of the judgments of the EU judicature (§ 16-18).

25/06/2019, T-82/19, [EAGLESTONE \(fig.\)](#), EU:T:2019:484, § 16-18

##### **Head of claim – No GC competence to issue directions – Inadmissibility**

A head of claim by which the applicant asks that the Court reject the application for registration of the mark or address an injunction to the opposition decision is inadmissible. The GC is not entitled to issue directions to the Office. It is for the latter to draw the conclusions from the operative part of this judgment and the grounds on which it is based (§ 31-32).

17/05/2021, T-328/20, [Aicook / My cook](#), EU:T:2021:291, § 31-32

##### **Head of claim seeking to alter the contested decision by declaring the contested mark invalid – No request to issue directions – Admissibility**

A head of claim requesting that the Court alter the contested decision by declaring the contested mark invalid cannot be interpreted (as the applicant argued) as asking the Court to issue directions. Rather, it is a request to alter the contested decision (§ 15). The admissibility of the request for alteration must be assessed in light of the powers conferred on the BoA (30/06/2009, T-285/08, Natur-Aktien-Index, EU:T:2009:230, § 14-15) (§ 16). As the BoA is competent to

declare the contested mark invalid (Article 71(1) EUTMR and Article 163(1) EUTMR), the request is admissible (§ 16).

The question of whether the conditions for the exercise of the Court's power to alter the contested decision are met is a question of substance and not of admissibility (12/03/2020, T-296/19, Sum011 / ORIGINAL Sumol ORANGE ORIGINAL Sumol LARANJA (fig.), EU:T:2020:93, § 22).

02/06/2021, T-169/19, [DEVICE OF A POLO PLAYER \(fig.\) / DEVICE OF A POLO PLAYER \(fig.\) et al.](#), EU:T:2021:318, § 15-16, 22

### **Head of claim – No GC jurisdiction to issue directions**

A head of claim seeking the GC to refer the EUTM application to the EUIPO and order the EUIPO to proceed with its registration is inadmissible on the grounds of lack of jurisdiction (§ 12).

17/05/2023, T-480/22, [panidor \(fig.\) / ANIDOR Toute la tendresse du chocolat \(fig.\) et al.](#), EU:T:2023:266

#### **2.1.4.2 Claim to alter an EUIPO decision**

##### **Claim seeking alteration of the contested decision – Interpretation**

The head of claim requesting the alteration of the contested decision may be interpreted, in the light of the contents of the application, as including a claim for annulment even though it is not explicitly expressed in the head of claim itself (§ 18-19).

22/05/2019, T-197/16, [ANDREA INCONTRI / ANDREIA et al.](#), EU:T:2019:347, § 18-19

##### **Head of claim ‘to alter the contested decision for reimbursement of the appeal fees’**

The head of claim ‘to alter the contested decision with a view to reimbursement of the appeal fees’ can be interpreted as a request for an order requiring the Office to reimburse the appeal fee paid (Article 68 EUTMR) under Article 190(2) RPGC (§ 20).

09/12/2020, T-30/20, [Promed](#), EU:T:2020:599, § 20

##### **Single head of claim seeking alteration – Inadmissibility of the action**

A single head of claim seeking that the GC should alter the contested decision so as to instruct that the trade mark applied for should be registered is inadmissible because the BoA does not have the power to take cognisance of an application requesting that it register an EU trade mark. Consequently, it is not for the GC to take cognisance of an application for alteration requesting that it amend the decision of a BoA to that effect. Accordingly, the action as a whole is dismissed as manifestly inadmissible (§ 12-16).

28/03/2019, T-631/18, <#>, EU:T:2019:208, § 12-16

25/11/2020, T-882/19, [ΑΠΛΑ! \(fig.\)](#), EU:T:2020:558, § 23-26

##### **Claim seeking to annul the OD's decision – Interpretation as claim seeking to alter the contested decision**

The form of order sought seeking annulment of the OD's decision falls within the GC's jurisdiction to annul or to alter decisions, as provided for in Article 72(3) EUTMR (§ 97).

29/04/2020, T-37/19, [cimpres / p impress \(fig.\) et al.](#), EU:T:2020:164, § 97

### **Head of claim seeking to alter the contested decision by declaring the contested mark invalid – Admissibility**

A head of claim requesting that the Court alter the contested decision by declaring the contested mark invalid cannot be interpreted (as the applicant argued) as asking the Court to issue directions. Rather, it is a request to alter the contested decision (§ 15). The admissibility of the request for alteration must be assessed in light of the powers conferred on the BoA (30/06/2009, T-285/08, Natur-Aktien-Index, EU:T:2009:230, § 14-15) (§ 16). As the BoA is competent to declare the contested mark invalid (Article 71(1) EUTMR and Article 163(1) EUTMR), the request is admissible (§ 16).

The question of whether the conditions for the exercise of the Court's power to alter the contested decision are met is a question of substance and not of admissibility (12/03/2020, T-296/19, Sum011 / ORIGINAL Sumol ORANGE ORIGINAL Sumol LARANJA (fig.), EU:T:2020:93, § 22).

02/06/2021, T-169/19, [DEVICE OF A POLO PLAYER \(fig.\) / DEVICE OF A POLO PLAYER \(fig.\) et al.](#), EU:T:2021:318, § 16, 22

### **No obligation for the Office to systematically defend the decisions of the BoA – No competence to seek annulment or alteration on a point of law not raised by the application – Independence of the BoA**

The Office cannot be obliged to systematically defend every contested decision of a BoA nor to automatically claim that every action challenging such a decision should be dismissed (07/05/2019, T-629/18, DARSTELLUNG EINES AUTOS IN EINER SPRECHBLASE (fig.), EU:T:2019:292, § 18 and the case-law cited). Nothing precludes the EUIPO from endorsing the heads of claim of the applicant or from simply leaving the decision to the discretion of the Court while putting forward all the arguments it considers appropriate for giving guidance to the Court (§ 15).

In contrast, the Office may not seek an order annulling or altering the decision of the BoA on a point not raised in the application, or put forward pleas in law not raised in the application (29/04/2020, T-78/19, green cycles (fig.), EU:T:2020:166, § 47 and the case-law cited) (§ 15).

The Office does not possess the power to amend or withdraw the decision, nor can it instruct the BoA to do so, as the independence of the BOA is enshrined in Article 166(7) EUTMR (§ 17).

22/09/2021, T-195/20, [chic ÁGUA ALCALINA 9.5 PH \(fig.\) / Chic Barcelona et al.](#), EU:T:2021:601, § 15, 17

### **Head of claim seeking alteration – Interpretation as claim for annulment**

The Applicant called into question the legality of the decision twice by a) referring to the subject matter of this action as an appeal against *that decision* and b) claiming that *it was vitiated by error* due to insufficient legal reasoning. Therefore, the head of claim to alter the decision to the effect that the contested mark is registered for *entertainment* in Class 41 is interpreted as aiming at the annulment of the BoA decision. To that extent this head of claim was considered admissible (§ 11).

29/06/2022, T-640/21, [bet-at-home \(fig.\)](#), EU:T:2022:408

### **Head of claim seeking alteration**

If the BoA ruled on the admissibility of the opposition without taking a position on its merits, the GC cannot, in the context of an application for alteration, carry out an assessment as to the substance of the case without the BoA having already adopted a position. The head of claim seeking alteration of the BoA decision is unfounded (§ 18-22).

[18/01/2023, T-758/21, Clavis /Clavis, EU:T:2023:3](#)

### **Inadmissible head of claim – Claim seeking alteration of the contested decision – Request to register the trade mark – No BoA jurisdiction – No GC jurisdiction**

The GC has jurisdiction under Article 72(3) EUTMR to alter the decision of the BoA. Nevertheless, that power is intended to ensure that the GC adopts the decision that the BoA ought to have taken, which means that the admissibility of a claim for alteration must be assessed in the light of the powers conferred on that BoA. Although the registration of an EUTM is a consequence of the finding that all the conditions as per Article 51 EUTMR have been met, the departments of the EUIPO that are responsible for the registration of EUTMs do not adopt any formal decision that might be the subject of an appeal. Accordingly, the BoA, which may, under Article 71(1) EUTMR, either exercise any power within the competence of the department that was responsible for the appealed decision or remit the case to that department for further treatment, does not have the power to take cognisance of an application that seeks to have it register an EUTM or declare that registration is possible. Consequently, the GC has no jurisdiction to take cognisance of a claim for alteration requesting that it alter the decision of a BoA to that effect (§ 13-17).

[25/10/2023, T-773/22, GILBERT TECKEL \(fig.\) / DEVICE OF A DACHSHUND IN BLACK \(fig.\) et al., EU:T:2023:674](#)

### **Head of Claim – No GC competence to annul first instance decision**

A head of claim seeking the annulment of the first instance decision must be rejected, since the GC does not have the power to annul the OD decision (§ 23).

[24/01/2024, T-55/23, SALVAJE \(fig.\) / SALVANA, EU:T:2024:30](#)

### **Intervener's head of claim to alter the contested decision – Inadmissibility in the absence of a cross-claim**

The intervener's head of claim, which could be understood as requesting to alter the BoA decision on a point not raised in the application, is inadmissible in the absence of a cross-claim (§ 25).

[07/02/2024, T-220/23, CITY STADE \(fig.\), EU:T:2024:61](#)

### **Head of claim seeking registration of a trade mark – Lack of jurisdiction**

A head of claim seeking that the GC grant the registration of the trade mark applied for may be understood as a request for alteration within the meaning of Article 72(3) EUTMR. However, since the BoA is not authorised to rule on an application for registration of an EUTM, it is also not for the GC to alter the BoA decision to that effect. Therefore, the head of claim must be dismissed for lack of jurisdiction (§ 9).

[13/03/2024, T-243/23, MORE-BIOTIC, EU:T:2024:162](#)

#### **2.1.4.3 Claim to confirm a decision**

##### **Action against a confirmatory decision – Inadmissibility**

An action against a confirmatory decision is inadmissible as it merely confirms an earlier decision not challenged in due time. A decision is regarded as a mere confirmation of an earlier one if it contains no new factors compared with the earlier decision and if it was not preceded by any re-examination of the situation of the addressee of that earlier decision (§ 38-39). However, a decision cannot be regarded as 'confirmatory' of a decision adopted by the OD in the context of

different opposition proceedings concerning the same parties and the same trade marks, in particular when it concerns the genuine use of the earlier mark or the conceptual comparison, which can vary depending on the relevant public and also over time (§ 40-42).

07/11/2019, T-380/18, [INTAS / INDAS \(fig.\) et al.](#), EU:T:2019:782, § 38-42

### **Action following an appeal against a partially confirmatory decision – Partial inadmissibility**

An action against a confirmatory decision must be declared inadmissible. A decision is regarded as a mere confirmation of an earlier decision if it contains no new factors as compared with the earlier measure and is not preceded by any re-examination of the situation of the addressee of the earlier measure (07/11/2019, T-380/18, INTAS / INDAS (fig.) et al., EU:T:2019:782, § 38-39). This requires the identity of (i) the parties to the proceedings, (ii) their submissions, their pleas, their arguments, and (iii) the relevant matters of law and fact characterising those proceedings and determining the operative parts of those decisions (08/02/2011, T-157/08, Insulate for life, EU:T:2011:33, § 29-41; 06/10/2015, T-545/14, engineering for a better world, EU:T:2015:789, § 18-29). The assessment relating to the existence of an absolute ground for refusal of registration cannot be called into question solely because the examiner or the appeal body did not follow the Office's decision-making practice in a specific case (08/02/2011, T-157/08, Insulate for life, EU:T:2011:33, § 38; 06/10/2015, T-545/14, engineering for a better world, EU:T:2015:789, § 23) (§ 22-26).

16/06/2021, T-487/20, [imot.bg \(fig.\)](#), EU:T:2021:366, § 22-26

### **Challengeable act – No confirmatory decision – Admissibility**

With regard to orthopaedic shoes in Class 10, the contested decision is not merely a confirmatory decision of the judgment 11/07/2013, T-208/12, Rote Schnürsenkelenden, EU:T:2013:376 (confirmed by judgment 11/09/2014, C-521/13 P, Rote Schnürsenkelenden, EU:C:2014:2222).

The red colour of the shoelace ends has been defined more precisely in the present application and the goods covered by this application differ from those covered by the earlier application. The present action, and the earlier decisions referred to above, do not concern the same subject matter. Therefore, the application is not inadmissible (§ 28-31).

The criterion that the mark applied for must satisfy in the present case is not that of mere originality. Instead, in order to be registrable, the mark applied for must deviate significantly from what is customary in the sector, which is not apparent from the file (§ 49).



17/11/2021, T-298-19, [FORM VON ROTEN SCHNÜRSENKELENDEN \(Posit.\)](#), EU:T:2021:792, § 28-31, 49

#### **2.1.4.4 Claim in excess of what is appealable**

##### **Head of claim seeking registration of the mark applied for – Inadmissibility**

A head of claim seeking registration of the mark applied for is inadmissible. Albeit the claim could be interpreted as seeking an alteration of the BoA's decision, the BoA has no competence to deal with a request to register an EUTM. Thus, it is not for the GC to take a decision on an application requiring the alteration of the BoA decision in this respect (§ 10-13).

20/03/2019, T-760/17, [Triotherm+](#), EU:T:2019:175, § 10-13

### **Head of claim seeking to ‘declare that the trade mark applied for may proceed to registration’– Inadmissibility**

A head of claim seeking to ‘declare that the trade mark applied for may proceed to registration’ is inadmissible since the Court has no jurisdiction to deliver declaratory judgments (§ 18-20).

09/07/2019, T-397/18, [Hugo's Burger Bar \(fig.\) / H'ugo's et al.](#), EU:T:2019:489 § 18-20

### **Head of claim seeking to issue declaratory judgments – Inadmissibility**

A head of claim by which the applicant asks the Court that it declare that proof of use of the earlier mark has not been adduced is neither a request for annulment nor alteration of the contested decision, but an express request for delivery of a declaratory judgment. The GC has no jurisdiction when exercising its judicial review of legality to issue declaratory judgments (§ 23-24).

17/05/2021, T-328/20, [Aicook / My cook](#), EU:T:2021:291, § 23-24

### **Head of claim seeking to obtain confirmatory or declaratory rulings – Inadmissibility**

A head of claim seeking to obtain confirmatory or declaratory rulings is inadmissible (§ 23-27).

29/01/2019, T-336/17, [YATEKOMO / YA TE COMERE EL VACIO QUE TE LLENA \(fig.\)](#), EU:T:2019:36, § 23-27

12/03/2019, T-463/18, [SMARTSURFACE](#), EU:T:2019:152, § 9-11

### **Head of claim seeking a declaration that the action before the GC has become devoid of purpose – Inadmissibility**

Where a contested decision is obsolete at the moment of the introduction of the action before the GC, the action is already devoid of purpose at that moment. It has not become devoid of purpose in the course of the proceedings before the GC (§ 37).

23/05/2019, T-609/18, [d:ternity / iTernity](#), EU:T:2019:366, § 37

### **Head of claim challenging part of the decision that was not challenged before the BoA – Inadmissibility**

The OD's decision becomes final in respect of the part of the decision/goods not challenged before the BoA. A head of claim challenging that part of the OD's decision before the GC is therefore inadmissible (§ 15).

28/05/2020, T-333/19, [GN Genetic Nutrition Laboratories \(fig.\) / GNC GENERAL NUTRITION CENTERS et al.](#), EU:T:2020:232, § 15

#### **2.1.4.5 Clarification of a claim**

##### **Possibility of clarification of pleas – Plea challenging the reasoning of the OD decision – Limit – Formal requirements of the application – Article 21 Statute and Article 177(1)(d) RPGC – Inadmissibility**

The Court has jurisdiction to rule on actions relating to decisions of the BoA and not decisions of the OD, Article 72 EUTMR (§ 21). The purpose of those actions is to review the legality of decisions of the BoA, a review which must, pursuant to Article 95 EUTMR, be carried out in light of the factual and legal context of the dispute as it was brought before the BoA (§ 22).

The Court must interpret the pleas in law on which an applicant relies in terms of their substance rather than of their classification (05/09/2014, T-471/11, *Éditions Odile Jacob v Commission*,

EU:T:2014:739, § 51). However, such an interpretation is possible only provided that that substance is sufficiently clear from the application, Article 21 of the Statute and Article 177(1)(d) of the RPGC (§ 27).

The applicant's plea submitting that the OD erred in examining the opposition under Article 8(1)(b) EUTMR, although it had been brought only on the basis of Article 8(1)(a) EUTMR is rejected as inadmissible since the applicant has not identified, in a sufficiently clear and precise manner, the reasons why, in its view, the BoA made an error in reviewing the merits of the assessments which had led the OD, in its decision, to reject the opposition under Article 8(1)(b) CTMR [now EUTMR] (§ 18, 28-31).

12/05/2021, T-70/20, [MUSEUM OF ILLUSIONS \(fig.\) / MUSEUM OF ILLUSIONS \(fig.\)](#), EU:T:2021:253, § 18, 22, 27-31

### **Modification of a head of claim – Principle of unalterability of proceedings – Modification of the application – Inadmissibility**

Pursuant to Article 86(1) RPGC, where a measure, the annulment of which is sought, is replaced or amended by another measure with the same subject matter, the applicant may, before the oral part of the procedure is closed, or before the decision of the GC to rule without an oral part of the procedure, modify the application to take account of that new factor (§ 22). As an exception to the principle of unalterability of proceedings, Article 86 must be interpreted strictly (20/09/2018, C-114/17 P, Spain v Commission, EU:C:2018:753, § 54) (§ 23).

In its statement of modification of the form of order sought, the applicant not only seeks the annulment of the contested decision, that claim having already been included in the application, but also asks the Court to uphold the action for cancellation of the contested mark's registration (§ 21). Since the applicant does not refer to any replacement or amendment of the contested decision, the modification of its first head of claim is inadmissible (§ 24).

06/10/2021, T-254/20, [DEVICE OF A LOBSTER \(fig.\)](#), EU:T:2021:650, § 21-24

#### **2.1.4.6 Interpretation of a claim by the GC**

##### **Interpretation of the intervener's head of claim seeking to confirm the contested decision**

An intervener's head of claim seeking to confirm, or to 'uphold', the contested decision is interpreted as seeking the dismissal of the action (§ 15) (13/12/2016, T-58/16, APAX / APAX et al., EU:T:2016:724, § 15).

27/02/2019, T-107/18, [Dienne \(fig.\) / ENNE \(fig.\)](#), EU:T:2019:114, § 15  
12/07/2019, T-698/17, [MANDO / MAN \(fig.\) et al.](#), EU:T:2019:524, § 16

##### **Interpretation of the applicant's head of claim seeking annulment of a decision by which the BoA had upheld its claim in part**

Even though the BoA partially upheld the applicant's appeal, the applicant's head of claim seeking annulment of the contested decision is interpreted as seeking the annulment of the contested decision in part (26/02/2015, T-713/13, 9flats.com, EU:T:2015:114, § 19).

10/07/2020, T-616/19, [Wonderland / Wondermix et al.](#), EU:T:2020:334, § 19

##### **Interpretation of a head of claim requesting the alteration of a contested decision**

A head of claim requesting the alteration of a contested decision may be interpreted in the light of the contents of the application as including a claim for annulment, even though it is not explicitly expressed in the head of claim itself (§ 18-19).

22/05/2019, T-197/16, [ANDREA INCONTRI / ANDREIA et al.](#), EU:T:2019:347, § 18-19  
29/04/2020, T-106/19, [ABARCA SEGUROS \(fig.\) / Abanca](#), EU:T:2020:158, § 16

### **Interpretation of a head of claim seeking to alter a contested decision**

Where the applicant before the GC (opponent) seeks to have the BoA decision altered, without seeking the annulment of that decision, the application for alteration necessarily includes an application for annulment (07/11/2013, T-666/11, Gato domestico, EU:T:2013:584, § 18) (§ 19). Insofar as the opponent requests the GC to order the rejection of the application for registration for the services in Classes 35 and 39 in respect of which its appeal was dismissed by the BoA, the opponent is essentially asking the GC to adopt the decision which, in its view, the Office should have taken, that is to say, a decision finding that the conditions of opposition are satisfied, so that the Office enforces it by refusing registration of the trade mark applied for in respect of those services. Accordingly, the opponent requests that the contested decision be altered, Article 72(3) EUTMR (§ 18-21).

12/03/2020, T-296/19, [Sum011 / ORIGINAL Sumol ORANGE ORIGINAL Sumol LARANJA \(fig.\)](#), EU:T:2020:93, § 18-21

### **Interpretation of a head of claim seeking alteration of the contested decision and confirmation of the OD decision**

The applicant's head of claim, seeking the annulment or alteration of the contested decision and the confirmation of the OD's decision, is admissible. It is to be understood as requesting that the contested decision be annulled insofar as the BoA annulled the OD's decision, or that the BoA take the decision which it should have taken, which is to say that the appeal against the OD's decision should be dismissed in its entirety (Article 71(1) and Article 72(3) EUTMR; 04/05/2017, T-97/16, GEOTEK, EU:T:2017:298, § 17 and case-law cited) (§ 20, 22-23).

10/02/2021, T-821/19, [B.home / B-Wohnen](#), EU:T:2021:80, § 20, 22-23

### **Interpretation of a head of claim seeking to annul the OD's decision as claim seeking to alter the contested decision**

The form of order sought seeking to annul the OD's decision falls within the GC's jurisdiction to annul or to alter decisions, as provided for in Article 72(3) EUTMR (§ 97).

29/04/2020, T-37/19, [cimpres / p impress \(fig.\) et al.](#), EU:T:2020:164, § 97

### **Interpretation of a single head of claim seeking alteration and annulment – Admissibility**

The applicant requests the Office to 'be ordered to register the mark applied for also in respect of the other goods in Class 21, namely [...]' (§ 7).

If this single head of claim were to be interpreted as seeking to alter the contested decision, it would be inadmissible (30/06/2009, T-285/08, Natur-Aktien-Index, EU:T:2009:230, § 21; 17/05/2017, T-164/16, THE TRAVEL EPISODES (fig.), EU:T:2017:352, § 24) (§ 10-13).

However, where from the content of the application it is apparent that, by its single head of claim, the applicant seeks not only to alter the contested decision but also to annul it (07/11/2013, T-666/11, Gatto domestico, EU:T:2013:584, § 18), the sole head of claim must be interpreted as also seeking annulment of the contested decision and is therefore admissible (§ 14-15).

30/06/2021, T-624/19, [FORM EINES HANDGRIFFS MIT BORSTEN \(3D\)](#), EU:T:2021:393, § 7, 10-15

### **Interpretation of the intervener's head of claim seeking to confirm the contested decision**

The GC cannot issue confirmatory or declaratory judgments. However, in light of the content of the response filed by the intervener, its request for confirmation of the contested decision and declaration of invalidity of the contested RCD can be interpreted as a request for dismissal of the action (§ 19-20).

[21/06/2023, T-347/22, Schmelztiiegel II, EU:T:2023:344](#)

### **Interpretation of the head of claim seeking revocation of the contested decision**

The head of claim requesting that the GC revoke the contested decision must be read together with the grounds of the application. In this case, it appears that the purpose of the action is to obtain the annulment of the contested decision. Under Article 103 EUTMR, a decision taken by the EUIPO can be revoked by the body that adopted the decision while, pursuant to Article 72(3) EUTMR, the Court may annul or alter the decision of the BoA (§ 21-22).

[24/01/2024, T-55/23, SALVAJE \(fig.\) / SALVANA, EU:T:2024:30](#)

### **Interpretation of the head of claim seeking alteration – Implicit claim for annulment**

Having regard to the content of the application before the GC, the applicant's heads of claim to alter the contested decision in its entirety and to reject the opposition implicitly include an application for annulment of the contested decision (§ 14).

[07/02/2024, T-101/23, Buffet \(fig.\) / Buff et al., EU:T:2024:65](#)

## **2.1.5 Formal requirements**

### **2.1.5.1 Oral hearing request**

#### **Possibility to rule by reasoned order at any time according to Article 126 RPGC despite an oral hearing request**

Pursuant to Article 126 RPGC, the GC can decide to rule by reasoned order without taking further steps in the proceedings, notwithstanding the fact that a hearing was requested (12/09/2019, T-182/19, SOFTFOAM (fig.), EU:T:2019:604, § 10) (§ 18).

[11/06/2020, T-553/19, PERFECT BAR, EU:T:2020:268, § 18](#)

[11/06/2020, T-563/19, PERFECT BAR \(fig.\), EU:T:2020:271, § 18](#)

[16/06/2020, T-558/19, HOSPITAL DA LUZ LEARNING HEALTH TRAINING, RESEARCH & INNOVATION CENTER \(fig.\) / C LUZCLINICA LA LUZ \(fig.\) et al., EU:T:2020:274, § 18](#)

#### **Inadmissible request for oral hearing – Request submitted together with the application**

The request for oral hearing submitted with the application for annulment and not within three weeks after service on the parties of notification of the close of the written part of the procedure is inadmissible (§ 27, 29).

[14/09/2022, T-607/21, Skilltree studios, EU:T:2022:553](#)

#### **Oral hearing request – No reasoned request**

A request for an oral hearing must be reasoned. In the absence of a reasoned request, the GC may, if it considers that it has sufficient information available to it, rule on the action without an oral part of the procedure (§ 18-22).

[14/06/2023, T-200/20, Stone brewing / Stones et al., EU:T:2023:330](#)

#### **Oral hearing request – No reasoned request**

A request that does not contain any indication as regards the aspects or arguments on which the party wants to elaborate, or which it wants to refute, in an oral hearing, but only lists items of evidence in relation to which it requests witnesses to be heard, cannot be considered as a reasoned request for an oral hearing in the sense of Article 106(2) RPGC. It must be regarded as a request for measures of inquiry, which is rejected because the scope and probative value of the evidence in question can be assessed without particular difficulty on the basis of the case file (§ 16-18).

[21/06/2023, T-347/22, Schmelztiegel II, EU:T:2023:344](#)

#### **2.1.5.2 General references to documents produced before a BoA**

##### **Formal requirement of the application – General references**

According to Article 21 Statute and Article 171 and Article 177(1) RPGC, any application must indicate the subject matter of the proceedings and a summary of the pleas in law relied on. The basic matters of fact and law relied on must be indicated, at least in summary form, coherently and intelligibly in the application. The summary and the pleas of law must be sufficiently clear and precise to enable the defendant to prepare its defence and the competent court to rule on the action. Although the body of the application may be supported and supplemented in relation to specific points by references to extracts from documents annexed to it, general references to other written submissions are inadmissible, even if these submissions are annexed, to the extent that they cannot be linked to the pleas and arguments put forward in the application itself (§ 11, 12).

[11/07/2019, T-349/18, TurboPerformance \(fig.\), EU:T:2019:495, § 11, 12](#)

##### **Article 177(1)(d) RPGC – Inadmissibility of the general reference to the arguments put forward during the procedure before the EUIPO**

The applicant cannot validly refer the Court to all the arguments it put forward in the proceedings before the EUIPO in so far as that general reference cannot be connected to pleas and arguments developed in the application (§ 22).

[02/03/2022, T-86/21, Makeblock \(fig.\), EU:T:2022:107, § 22](#)

##### **Formal requirements of the application – General references – Inadmissibility**

The application before the GC must contain the subject matter of the dispute and a brief statement of the grounds on which the application is based. That statement must be sufficiently clear and precise to enable the defendant to prepare its defence and for the Court to exercise its power of judicial review. Although the body of the application may be supported and supplemented in relation to specific points by references to extracts from documents annexed to it, general references to other written submissions are inadmissible, even if these submissions are annexed, to the extent that they cannot be linked to the pleas and arguments put forward in the application itself (§ 54-55).

[08/11/2022, T-672/21, GRUPA LEW. \(fig.\) / Lew](#)

### **Inadmissible general references to earlier submissions**

The applicant cannot validly refer the GC, in a blanket manner, to its submissions in the proceedings before the EUIPO. It is not for the GC to try to locate the relevant elements in the documents to which they refer (§ 39).

[22/03/2023, T-408/22, SEVEN SEVEN 7 \(fig.\) / Seven, EU:T:2023:157](#)

### **Inadmissible plea – Plea not put forward in a comprehensible manner – General reference to previous submissions**

Pursuant to the first paragraph of Article 21 of the Statute and to Article 177(1)(d) RPGC, an application must contain the pleas in law and arguments relied on and a summary of those pleas in law. Consequently, the application, insofar as it refers generally to the written submissions filed before the EUIPO, is inadmissible to the extent that the general reference that it contains cannot be linked to the pleas and arguments put forward in that application itself (§ 13-14).

[18/10/2023, T-566/22, ENDURANCE \(fig.\), EU:T:2023:655](#)

### **Inadmissible general references to previous submissions**

Although the application for annulment can be substantiated and supplemented on certain points by referring to extracts of documents attached to it, the annexes merely have an evidentiary and auxiliary function. The annexes cannot therefore serve to elaborate on a plea briefly set out in the application by citing arguments not contained in the application. It is not for the Court to substitute the parties by attempting to identify the relevant details in the documents to which they refer. The same requirements apply to an argument put forward in support of a plea in law (§ 81).

Where the applicant does not specify which case-law of a national Court the BoA allegedly disregarded, but merely refers 'for further details, to [the] statement of grounds of appeal', the GC cannot take into account this argument, which was not relied on in support of its plea before the GC (§ 82-83).

[08/11/2023, T-665/22, NIVEA SKIN-IDENTICAL Q10 / SKINIDENT et al., EU:T:2023:704](#)

### **General references**

General references to previous submissions lodged before the Office are inadmissible according to Article 21 Statute and Article 177(1)(d) RPGC (§ 15-23).

13/02/2019, T-278/18, [DENTALDISK](#), EU:T:2019:86, § 15-23

08/07/2020, T-328/19, [SCORIFY \(fig.\) / Scor et al.](#), EU:T:2020:311, § 20-21

07/07/2021, T-205/20, [I-cosmetics](#), EU:T:2021:414, § 42

#### **2.1.5.3 Others**

### **Unforeseen documents in the RPGC – Request to lodge a reply**

As the RPGC no longer provide for requests to lodge a reply in IP proceedings, any such request is rejected (§ 24-26).

13/02/2019, T-278/18, [DENTALDISK](#), EU:T:2019:86, § 24-26

### **Extension of time limit to file a response only for the party who requested it**

The other party to the proceedings before the BoA cannot automatically benefit from an extension of the time limit to file a response accorded to the Office. Its response has to be filed within the time limit prescribed, unless it asks the Court for an extension (§ 28).

23/02/2021, T-587/19, [MARIEN \(fig.\) / MARIN](#), EU:T:2021:107, § 28

### **Formal requirements of the application – Article 76(d) RPGC – Admissibility of arguments and pleas**

The BoA did not consider that the examination of the distinctive character of the sign applied for had to be different depending on whether it related to orthopaedic footwear (Class 10) or to footwear in general (Class 25). In these circumstances, the applicant was not obliged to put forward specific arguments relating to orthopaedic footwear in order to avoid the inadmissibility of its action in respect of those goods. Moreover, the absence of these specific arguments cannot be interpreted as meaning that the applicant waived its right to challenge the contested decision insofar as it rejects the application for orthopaedic footwear in Class 10 (§ 23-25).

17/11/2021, T-298-19, [FORM VON ROTEN SCHNÜRSENKELENDEN \(Posit.\)](#), EU:T:2021:792, § 28-31, 49

### **Formal requirements of pleas and arguments of the response – Inadmissibility of the intervener's arguments**

The intervener's argument regarding the fact that some documents submitted during the administrative proceedings were not translated into the language of the proceedings does not satisfy the requirements of Article 180(1)(c) RPGC in so far as, first, it did not identify the documents which should be disregarded on the ground that they had not been translated into the language of the case during the administrative proceedings and, second, it did not dispute the BoA's findings which were based on those documents (§ 19).

24/11/2021, T-434/20, [dziandruk \(fig.\)](#), EU:T:2021:815, § 19

### **Formal requirement of the application – In an application to the Court, a mere abstract statement of grounds is not sufficient**

The application made in the context of an action brought against the EUIPO must contain, inter alia, the subject matter of the dispute and a brief statement of the pleas in law relied on. It must, accordingly, specify the grounds on which the action is based, with the result that a mere abstract statement of the grounds is not sufficient. Moreover, that statement, albeit brief, must be sufficiently clear and precise to enable the defendant to prepare its defence and for the Court to rule on the action, if necessary, without any further information (§ 89).

02/03/2022, T-86/21, [Makeblock \(fig.\)](#), EU:T:2022:107, § 89

### **Article 21 Statute of the Court of Justice of the European Union (1-5-2019) and Article 177(1)(d) RPGC – Manifest inadmissibility of the application**

According to Article 21 Statute of the Court of Justice of the European Union (1-5-2019) and Article 177(1)(d) RPGC, all applications must contain the subject matter of the dispute and a brief statement of the grounds on which the application is based. That statement must be sufficiently clear and precise to enable the defendant to prepare its defence and for the Court to exercise its power of judicial review. In order to guarantee legal certainty and sound administration of justice and for an action to be admissible under the aforementioned provisions, it is necessary that the basic legal and factual particulars relied on be indicated, at least in summary form, coherently and intelligibly in the application itself. The body of the application may be underpinned and

supplemented on specific points by references to extracts from annexed documents. However, an overall reference to other documents, even those annexed to the application, cannot make up for the absence of the essential arguments in law that, in accordance with the abovementioned provisions, must feature in the application (§ 5). The application did not satisfy the minimum requirements and was rejected as manifestly inadmissible (§ 7).

02/03/2022, T-783/21, [tipin \(fig.\)-tipwin \(fig.\)](#), EU:T:2022:131, § 5, 7

### **Admissible application – Identical arguments before the BoA and before the GC**

Article 177(1) RPGC sets out the requirements for the admissibility before the GC of an application for annulment of a decision by the EUIPO. The fact that the motivation for the action is partially identical to that presented before the BoA does not imply its inadmissibility (§ 18).

[20/12/2023, T-27/23, THE FEED, EU:T:2023:856](#)

## **2.2 SUBJECT MATTER OF THE PROCEEDINGS BEFORE THE GC**

### **2.2.1 Admissibility of pleas in law, arguments and evidence**

#### **Admissible plea – Allegation of insufficient evidence for the BoA’s confirmation of an undisputed issue – Part of the factual and legal background of the dispute**

The BoA considered that the disclosure of the earlier design was undisputed, since the RCD proprietor had acknowledged in a letter that the design had been introduced on the European market in 2009. Therefore, the question concerning the disclosure of the earlier design had been examined and formed part of the factual and legal background to the dispute brought before the BoA. Consequently, the RCD proprietor’s claim before the GC that the evidence on which the BoA had based its decision was not sufficient to find that the earlier design had indeed been made available, is admissible (§ 17-18).

08/07/2020, T-748/18, [Pneumatic power tools](#), EU:T:2020:321, § 17-18

#### **2.2.1.1 Pleas to be put forward expressly, intelligibly and coherently**

#### **Inoperative single plea in law – Declaration of invalidity granted on the basis of two grounds with regards to the descriptive character and lack of distinctive character**

The BoA allowed an application for a declaration of invalidity of a trade mark both on the basis of Article 7(1)(c) EUTMR with regard to the descriptive character of the mark and on the ground of lack of distinctive character within the meaning of Article 7(1)(b) EUTMR. In these circumstances, the contested decision may only be annulled if the applicant puts forward sufficiently clear and precise arguments and demonstrates that the BoA’s assessments are vitiated by errors of law in relation to each of those grounds for invalidity.

The applicant has not challenged the BoA’s assessment that the contested mark is devoid of any distinctive character within the meaning of Article 7(1)(b) EUTMR by putting forward a plea in law that is sufficiently clear and precise. The single plea is rejected inoperative (§ 24).

15/12/2021, T-188/21, [Malle](#), EU:T:2021:903, § 24

#### **Inadmissible plea – Plea not put forward in a comprehensible manner**

The clear and precise identification of the error made by the BoA in the contested decision, at least in summary form, but in a coherent and comprehensible manner, in the text of the application for annulment in itself, is an admissibility requirement under Article 177(1)(d) RPGC (§ 21).

06/04/2022, T-680/21, [Amsterdam poppers](#), EU:T:2022:216, § 21

### **Admissible plea – No identification of the legal basis**

An applicant is not obliged expressly to state on which particular rule of law his or her complaint is based, provided that his or her line of argument is sufficiently clear for the defendant and the Courts of the European Union to be able to identify the rule without difficulty (§ 15).

[08/06/2022, T-738/20, Holux / Holux et al., EU:T:2022:343](#)

### **Inadmissible plea – Plea not put forward in a comprehensible manner**

For an action to meet the minimum requirements of Article 177(1)(d) RPGC, the essential factual and legal circumstances on which the application is based must be apparent – at least in a concise form, but in any event, in a coherent and comprehensible way – from the wording of the application itself (§ 17). For the goods and services for which the applicant failed to submit any specific arguments in its application (Classes 4, 6, 8, 14, 25, 34, 36, 38, 39 and 42) and to clarify for which of these goods genuine use had been proven, the action is thus inadmissible (§ 16-20).

[07/12/2022, T-747/21, Fohlenelf, EU:T:2022:773](#)

### **Admissible plea – Plea of lack of genuine use forming part of the arguments of a plea under Article 8(1)(b) EUTMR**

The applicant has formally put forward only a single plea in law, alleging infringement of Article 8(1)(b) EUTMR. However, in the context of that plea, the applicant has put forward a specific and substantiated first complaint, alleging lack of genuine use of the earlier mark. In so doing, it puts forward, in essence, a first plea in law, alleging infringement of Article 47(2) EUTMR. Consequently, the fact that the complaint alleging lack of genuine use of the earlier mark has been put forward in the context of the plea alleging infringement of Article 8(1)(b) EUTMR, cannot entail its inadmissibility, but only its reclassification by the GC (§ 25).

[07/06/2023, T-63/22, BROOKS ENGLAND \(fig.\) / Brooks, EU:T:2023:312](#)

### **Inadmissible plea – No indication of matters of fact and of law explaining the alleged infringement**

Merely relying on Article 7(1)(d) and Article 7(1)(e)(i) EUTMR, without indicating the matters of fact and of law capable of explaining the extent to which the contested decision infringes those provisions, does not satisfy the requirements of Article 177(1)(d) RPGC. These pleas must be rejected as inadmissible (§ 18-19).

[26/07/2023, T-591/21, DEVICE OF THE OUTLINE OF A BEAR \(fig.\), EU:T:2023:433](#)

## **2.2.1.2 No alteration of the subject matter of the proceedings**

### **Scope of the GC's review – Admissible plea**

The plea relating to the 'agent-principal' relationship is admissible despite the fact that the invalidity applicant did not challenge the conclusion of the CD before the BoA (§ 28). Even if the appellant has not raised a specific ground of appeal, the BoA is required to examine whether a new decision with the same operative part as the decision under appeal may be lawfully adopted at the time of the appeal ruling (§ 27). The invalidity applicant made submissions regarding the 'agent-principal' relationship before the cancellation. Therefore, it also appeared in the documents before the BoA that correctly proceeded to analyse the conditions of the invalidity ground (§ 28).

14/02/2019, T-796/17, [MOULDPRO](#), EU:T:2019:88, § 27-28

### **Scope of the GC's review – Admissible plea – Issue to be examined *ex officio* by the BoA**

In opposition proceedings based on Article 8(1) CTMR [now Article 8(1) EUTMR], the assessment of the inherent distinctive character of the earlier mark constitutes an issue of law which is necessary to ensure the correct application of the trade mark regulation: the instances of the Office are required to examine that issue, of their own motion if necessary, and it forms part of the subject matter of the proceedings before the BoA within the meaning of Article 188 RPGC (§ 43).

Therefore, the GC erred in law by declaring the appellant's plea concerning the allegedly weak distinctive character of the earlier mark inadmissible on account of Article 76(1) CTMR since that argument had been put forward before it for the first time (§ 47).

18/06/2020, C-702/18 P, [PRIMART Marek Łukasiewicz \(fig.\) / PRIMA et al.](#), EU:C:2020:489, § 43 and 47.

### **Scope of the GC's review – Subject matter of the proceedings – Article 95(1) EUTMR**

According to Article 95(1) EUTMR, in proceedings relating to relative grounds for refusal the Office is restricted in its examination to the facts, evidence and arguments provided by the parties and the relief sought. Therefore, the BoA may base its decision only on the relative grounds for refusal relied on by the party concerned, and the related facts and evidence presented by the parties (18/06/2020, C-702/18 P, [PRIMART Marek Łukasiewicz \(fig.\) / PRIMA et al.](#), EU:C:2020:489, § 41) (§ 28). In light of Article 188 RPGC, the parties, in proceedings before the Court, do not have the power to alter the legal context of the dispute, as set out in the claims and contentions that they had put forward during the proceedings before the BoA (08/03/2019, T-326/18, [CARAJILLO LICOR 43 CUARENTA Y TRES \(fig.\) / Carajillo \(fig.\)](#), EU:T:2019:149, § 35-36) (§ 26-27, 29).

Where the BoA was right in finding that the applicant had agreed with the OD's assessment regarding genuine use of the earlier mark in connection with certain goods and was entitled to restrict its assessment of the LOC to those goods alone, the applicant's arguments seeking to question the evidence of use of the earlier mark are ineffective and irrelevant (§ 31-33).

30/06/2021, T-227/20, [BIOVÈNE BARCELONA \(fig.\) / Biorene](#), EU:T:2021:395, § 26-27, 29, 31-33

30/06/2021, T-232/20, [Biovène / Biorene](#), EU:T:2021:396, § 26-27, 29, 31-33

### **Article 188 RPGC – Article 95(1) EUTMR – Invalidity proceedings – Burden of proof – Difference between Article 7(3) and Article 8(5) EUTMR – Plea as to acquired distinctiveness through use raised for the first time before the Court – Inadmissibility**

According to Article 188 RPGC, the pleadings lodged by the parties in proceedings before the GC may not change the subject matter of the proceedings before the BoA. The parties in proceedings before the Court do not therefore have the power to alter before that Court the terms of the dispute, as delimited in the respective claims and allegations put forward by the parties to the proceedings before the BoA. Any line of argument that would require the Court to carry out a review of the legality of the decision of the BoA beyond the factual and legal context of the dispute as it was brought before that BoA must be rejected as inadmissible (§ 21).

According to Article 95(1) EUTMR, in invalidity proceedings pursuant to Article 59 EUTMR, the Office is to limit its examination to the grounds and arguments submitted by the parties (10/06/2020, T-105/19, [DEVICE OF A CHEQUERBOARD PATTERN \(fig.\)](#), EU:T:2020:258, § 23 and case-law cited). It is for the parties to provide the facts and evidence in support of the relief

sought (11/04/2019, T-655/17, ZARA TANZANIA ADVENTURES (fig.) / ZARA et al., EU:T:2019:241, § 37) (§ 22).

In the context of invalidity proceedings, it is for the proprietor of the mark for which a declaration of invalidity is sought to claim that the contested mark has distinctive character through use if that mark is devoid of inherent distinctive character. It is also for the proprietor of the mark to submit appropriate and sufficient evidence to prove that the mark has acquired distinctive character through use (§ 24). The requirements for proof of reputation and of distinctive character acquired through use are not the same, particularly with regard to territory. For reputation, it is sufficient that that reputation is proved in a substantial part of the territory of the EU (06/10/2009, C-301/07, Pago, EU:C:2009:611, § 27) (§ 28). By contrast, in light of the unitary character of the EU trade mark, in the absence of inherent distinctive character, distinctive character acquired through use (i.e. at least a significant proportion of the relevant public identifies the goods or services concerned as originating from a particular undertaking because of the mark) must be proved throughout the territory of the EU and not only in a substantial part or the majority of the territory of the EU (25/07/2018, C-84/17 P, C-85/17 P & C-95/17 P, SHAPE OF A 4-FINGER CHOCOLATE BAR (3D), EU:C:2018:596, § 76, 78, 83, 87) (§ 29).

The items of evidence, intended to prove that the mark has a reputation, do not allow the inference to be drawn that the EUTM proprietor validly relied on Article 7(3) or Article 52(2) CTMR in the proceedings before the BoA (§ 26-27). The EUTM proprietor did not expressly put forward as a defence that the contested mark had acquired distinctive character through use for the purposes of Article 7(3) or Article 52(2). Consequently, that issue is not part of the subject matter of the proceedings before the BoA. The plea is rejected as inadmissible (§ 30-35).

19/01/2022, T-483/20, [Shoes \(3D\)](#), EU:T:2022:11, § 21-22, 24, 26-35

#### **Subject matter of the proceedings before the GC – Inadmissible plea**

Where an opposition is only based on Article 8(1)(b) EUTMR and the BoA has not examined or ruled on Article 8(1)(a) EUTMR, claims to the Court regarding the latter are inadmissible (§ 21).

26/01/2022, T-498/20, [WOOD STEP LAMINATE FLOORING \(fig.\) / Step](#), EU:T:2022:26, § 21

#### **Scope of the GC's review – Plea directed against grounds that are only included in first instance decisions – Inadmissible plea**

Under Article 72(1) EUTMR, actions may be brought before the EU judiciary only against BoA decisions. Therefore, pleas are only admissible when directed against such decisions, and cannot be directed against grounds that are only included in first instance decisions or communications (§ 39-40).

12/03/2019, T-463/18, [SMARTSURFACE](#), EU:T:2019:152, § 39-40

#### **Scope of the GC's review – Presumption of identity of the goods by the BoA – Inadmissible plea**

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

20/09/2019, T-367/18, [UKIO / <IO \(fig.\)](#), EU:T:2019:645, § 28, 31

### **Scope of the GC's review – Similarity of goods and services disputed for the first time before the GC – Admissible**

The fact that the applicant did not dispute the similarity of the goods of the opposing signs before the BoA cannot deprive it of the right to challenge the findings of the BoA before the GC in that respect, BoA having endorsed the grounds of the OD's decision (28/11/2019, T-665/18, *Vibble / Vybe et al.*, EU:T:2019:825, § 31) (§ 36).

24/02/2021, T-61/20, [B-direct / bizdirect \(fig.\)](#), EU:T:2021:101, § 36

### **Scope of the GC's review – Examination of facts ex officio – Incorrect assessment by the BoA – Principle of interdependence**

Where it is called upon to assess the legality of BoA decisions, the Court cannot be bound by an incorrect assessment of the facts by the BoA, since that assessment is part of the findings the legality of which is being disputed before it (18/12/2008, C-16/06 P, *Mobilix*, EU:C:2008:739, § 48; 05/02/2020, T-44/19, *TC Touring Club (fig.) / TOURING CLUB ITALIANO et al.*, EU:T:2020:31, § 88) (§ 49).

Although the opponent did not challenge the BoA's conclusion in relation to the conceptual comparison, it did call into question the BoA's assessment relating to the LOC. Therefore, by virtue of the principle of interdependence, the Court has jurisdiction to examine the BoA's findings on the conceptual comparison (05/12/2019, T-29/19, *Idealogistic Verhoeven Greatest care in getting it there (fig.) / iDÉA (fig.) et al.*, EU:T:2019:841, § 89) (§ 50).

02/12/2020, T-35/20, [DEVICE OF CLAW-LIKE SCRATCH \(fig.\) / DEVICE OF CLAW-LIKE SCRATCH \(fig.\) et al.](#), EU:T:2020:579, § 49-50

### **Scope of the GC's review – Examination of facts ex officio – Incorrect assessment by the BoA – Principle of interdependence**

Where one of the parties claiming that the BoA should be annulled has called into question the BoA's assessment relating to the LOC, the Court has, by virtue of the principle of interdependence between the factors taken into account, in particular the similarity of the trade marks and that of the goods and services covered, jurisdiction to examine the BoA's assessment of not disputed factors. Where it is called upon to assess the legality of a decision of a BoA of EUIPO, the Court cannot be bound by an incorrect assessment of the facts by that BoA, since that assessment is part of the findings the legality of which is being disputed before it (18/12/2008, C-16/06 P, *Mobilix*, EU:C:2008:739, § 47-48) (§ 37).

12/05/2021, T-70/20, [MUSEUM OF ILLUSIONS \(fig.\) / MUSEUM OF ILLUSIONS \(fig.\)](#), EU:T:2021:253, § 37

### **Scope of the GC's review – Examination of facts ex officio – Incorrect assessment of the BoA**

In spite of the fact that the applicant has not disputed the general public's level of attention, the GC, where it is called upon to assess the legality of a decision, cannot be bound by an incorrect assessment within it. This is because that assessment is part of the findings the legality of which is being disputed before the GC (18/10/2012, C-101/11 P & C-102/11 P, *Ornamentación*, EU:C:2012:641, § 40). In this case, the BoA's assessments regarding the general public's level of attention are part of the findings the legality of which is being disputed before the Court (§ 25-26).

21/12/2021, T-369/20, [Cefa certified european financial analyst / Cfa et al.](#), EU:T:2021:921, § 25-26

### **Technical standards invoked for the first time in the proceedings before the GC – Alteration of the subject matter of the proceedings**

The specific harmonized standards deriving from EU law invoked for the first time before the GC are inadmissible (§ 55).

[15/06/2022, T-380/20, Radiatori per riscaldamento, EU:T:2022:359](#)

### **Scope of the GC's review – No change of the subject matter of the proceedings before the BoA – Arguments related to an earlier right not examined by the BoA inadmissible**

Where the BoA confirmed the OD's refusal of the contested EUTM application exclusively on the basis of one specific earlier right, the arguments put forward in the proceedings before the GC related to another earlier right, which has not been examined by the BoA, are inadmissible (§ 19-22).

[22/09/2022, T-624/21, primagran \(fig.\) / PRIMA \(fig.\) et al.](#)

### **Scope of the GC's review – Inadmissible arguments**

Arguments that seek to have the GC examine a ground for invalidity that the BoA did not examine and, therefore, change the subject-matter of the proceedings before the BoA within the meaning of Article 188 RPGC, must be rejected as inadmissible from the outset (§ 28, 29).

[21/06/2023, T-347/22, Schmelztiegel II, EU:T:2023:344](#)

### **Scope of GC's review – Admissible plea**

The argument invoked for the first time before the GC, according to which genuine use of the contested mark has been proved only in connection with a subcategory of food supplements for medical purposes, is admissible since it does not go beyond the context of the dispute brought before the BoA (§ 61-62).

[12/07/2023, T-585/22, Artresan, EU:T:2023:392](#)

### **Scope of the GC's review – Similarity of the signs disputed for the first time before the GC – Admissible**

New arguments regarding the comparison of signs under Article 8(1)(b) EUTMR raised for the first time before the GC are admissible because the application of that provision requires the EUIPO to adjudicate on the comparison of the signs (§ 31).

[08/11/2023, T-41/23, POLLEN + GRACE \(fig.\) / Grace \(fig.\) et al., EU:T:2023:705](#)

### **Scope of the GC's review – Trade mark becoming a common name**

It follows from the logic of Article 58(1)(b) EUTMR that the finding that the contested mark has become a common name (objective condition) is a prerequisite for examining whether the loss of distinctive character is due to the proprietor's acts or inactivity (subjective condition). Where the action for annulment before the GC only contests the BoA assessment of the subjective condition, the GC has to review the assessment of the objective condition since it cannot base its decision on erroneous legal consideration (§ 30-32).

[07/02/2024, T-220/23, CITY STADE \(fig.\), EU:T:2024:61](#)

### 2.2.1.3 Admissible amplified pleas in law and arguments

#### Admissibility of new arguments before the GC

As regards the applicant's argument submitted for the first time before the General Court that, in essence, the lack of any development of a ground for refusal of Article 7(1)(b) EUTMR ought to be analysed as a withdrawal of that ground, that argument is part of an extension of the applicant's line of argument, both in its appeal before the BoA and before the Court, by which it sought to show that the BoA was not entitled to examine the validity of the contested mark in the light of Article 7(1)(b)EUTMR, and it constitutes an amplification of that line of argument. Therefore, it is admissible (§ 47).

[19/10/2022, T-486/20, Swisse \(fig.\), EU:T:2022:642](#)

#### Admissibility of new arguments before the GC

The argument related to a part of the relevant public mentioned for the first time before the GC is admissible, as the definition of the relevant public constitutes one of the issues on which the BoA must, for the purposes of assessing whether there is any LOC, necessarily rule (§ 24). By contrast, the arguments based on factual circumstances referred to for the first time before the GC are inadmissible (§ 27).

[07/06/2023, T-47/22, THE PLANET \(fig.\) / PLANETE+ \(fig.\), EU:T:2023:311](#)

### 2.2.1.4 Inadmissible new evidence

#### General principle

Documents, produced for the first time before the Court, cannot be taken into consideration since the purpose of actions before the GC is to review the legality of decisions of the BoA. Therefore, it is not the Court's function to review the facts in the light of documents produced for the first time before it (24/11/2005, T-346/04, Arthur et Félicie, EU:T:2005:420, § 19) (§ 15, 52).

12/07/2019, T-264/18, [mo.da](#), EU:T:2019:528, § 15, 52

24/10/2019, T-708/18, [Flis Happy Moreno choco \(fig.\) / MORENO \(fig.\) et al.](#), EU:T:2019:762, § 26-28

09/09/2020, T-144/19, [ADLON / ADLON](#), EU:T:2020:404, § 19

#### Website extract

A website extract produced as evidence for the first time before the GC (reproduction of an extract of a page of the Wikipedia website which refers to the letter 'æ' of the Danish alphabet) cannot be taken into account within the review of legality of the contested decision and is therefore inadmissible (§ 16).

28/11/2019, T-642/18, [DermoFaes Atopimed / Dermowas](#), EU:T:2019:819, § 16

#### Claims made and evidence filed for the first time before the GC – Inadmissibility

The claim of the earlier trade mark's particular strength of reputation must be made in the proceedings before the Office and cannot be made for the first time in the proceedings before the GC (§ 67-81). The same applies to evidence submitted in support of the claims made (§ 117-118, 122).

19/05/2021, T-510/19, [DEVICE OF A JUMPING ANIMAL \(fig.\) / PUMA \(fig.\) et al.](#), EU:T:2021:281, § 67-81, 117-118, 122

### **Community design – Evidence produced for the first time in the proceedings before the GC – Inadmissibility**

The evidence, which was acquired through the use of freely accessible applications (such as Google and the Wayback Machine) and submitted for the first time before the GC, is inadmissible since the purpose of actions brought before the GC is to review the legality of decisions of the BoA, as referred to in Article 61 CDR. It is not the GC's function to review the facts in light of documents that have been produced for the first time before the GC itself (§ 11-14).

*20/10/2021, T-823/19, [Bobby pins](#), EU:T:2021:718, § 11-14*

### **Scope of the proceedings before the GC – Documents produced for the first time before the GC – Inadmissibility**

The purpose of actions before the GC under Article 72(2) EUTMR is to obtain a review of the legality of decisions of the BoA. Article 95 EUTMR requires that these reviews must be carried out in light of the factual and legal context of the dispute as it was brought before the BoA. The GC may not annul or alter a decision against which an action has been brought on grounds that come into existence after its adoption (§ 18). Therefore, it is not the GC's function to review the facts in light of documents adduced for the first time before it. To allow the examination of such evidence would be contrary to Article 188 RPGC, according to which the parties' submissions may not alter the subject matter of the proceedings before the BoA. Accordingly, evidence submitted for the first time before the GC must be declared inadmissible and there is no need to examine it.

*16/03/2022, T-315/21, [Apial / Apiretal](#), EU:T:2022:141, § 18*

### **Inadmissible new evidence – Evidence translated in the language of proceedings for the first time before the GC**

Evidence translated in the language of proceedings for the first time before the GC shall be considered as produced for the first time before the GC and is, therefore, inadmissible (§ 35, 39).

*[14/09/2022, T-607/21, Skilltree studios](#), EU:T:2022:553*

### **Inadmissibility of case-law relied on for the first time before the court**

Previous case-law – in that case, decisions taken by EUIPO – submitted for the first time before the Court that is intended to prove aspects of factual nature is inadmissible (§ 23, 24).

*[05/10/2022, T-711/20, CMS Italy \(fig.\) / PUMA \(fig.\) et al.](#), EU:T:2022:604*

### **Inadmissible new evidence – Evidence submitted for the first time at the oral hearing**

The evidence submitted by the applicant for the first time during the oral hearing is inadmissible pursuant to Article 188 RPGC (§ 95).

*[07/12/2022, T-623/21, Puma / Puma \(fig.\)](#), EU:T:2022:776*

### **Inadmissible new evidence – Evidence submitted for the first time at the oral hearing**

An extract of the Nice Classification produced for the first time during the oral hearing before the GC cannot be taken into consideration (§ 13, 14).

*[15/02/2023, T-8/22, TCTC CARL \(fig.\) / carl touch \(fig.\)](#), EU:T:2023:70*

### **Inadmissible new evidence – Provisions of national law relied on for the first time before the GC**

In the context of Article 8(4) EUTMR, provisions of the national law invoked for the first time before the GC are inadmissible (§ 31). This is also the case for the new wording of a provision already invoked (§ 35).

[01/03/2023, T-36/22, PERFECT FARMA CERVIRON \(fig.\) / Cerviron, EU:T:2023:94](#)

See also, [01/03/2023, T-37/22, Cerviron / Cerviron, EU:T:2023:95](#), § 28, 32

See also, [01/03/2023, T-38/22, CERVIRON perfect care \(fig.\) / Cerviron, EU:T:2023:96](#), § 28, 32

### **Inadmissible new evidence**

The documents produced for the first time before the GC, comprising Wikipedia extracts referring to the word 'STORY' in different languages, must be rejected as inadmissible (§ 13-17).

[26/07/2023, T-434/22, VEGE STORY / végé', EU:T:2023:426](#)

#### **2.2.1.5 Admissible new evidence**

### **Evidence to refute new arguments in the contested decision – Extracts from the Office's database**

Evidence produced for the first time before the GC is admissible if it is necessary to refute arguments put forward for the first time in the contested decision (§ 17).

Extracts from the Office's database containing information about similar registered EUTMs are admissible, since they relate to decisions already taken in respect of similar applications for registration, which must be examined by the Office of its own motion (§ 20-23).

[11/04/2019, T-223/17, ADAPTA POWDER COATINGS \(fig.\), EU:T:2019:245](#), § 17, 20-23

### **Database extracts from the Office, National Trade Mark Offices and WIPO**

The database extracts from the Office, the German Patent and Trade Mark Office and WIPO, which were produced in order to argue that the contested decision was vitiated by an error in the comparison of goods and services and the LOC with regard to the list of goods for which the earlier marks were registered, are admissible, as this error could not have been detected before the contested decision was adopted (§ 30).

[24/10/2019, T-708/18, Flis Happy Moreno choco \(fig.\) / MORENO \(fig.\) et al., EU:T:2019:762](#), § 30

### **Evidence relating to the Office's decision-making practice**

Documents that relate to the Office's decision-making practice are not, strictly speaking, evidence within the meaning of Article 85 RPGC and are admissible, even if they are produced for the first time at the hearing. A party may refer to them even where that practice post-dates the proceedings before the Office (24/11/2005, T-346/04, Arthur et Félicie, EU:T:2005:420, § 20) (§ 18-19).

[12/07/2019, T-264/18, mo.da, EU:T:2019:528](#), § 18-19

### **National judgment submitted for the first time before the GC**

A national judgment submitted for the first time before the GC is admissible where the party does not claim that it should have been taken into account by the BoA, but relies on that judgment to support its argument that the BoA was correct to conclude that authorship of the work invoked

had not been proven. Admissibility of a judgment of a national court depends on the purpose for which it is relied on by the person concerned (§ 82).

[20/01/2021, T-656/18, \*MANUFACTURE PRIM 1949 \(II\)\*, EU:T:2021:17, § 82](#)

### **Evidence to establish the accuracy of well-known facts**

Evidence that is restricted to commenting on matters which are common knowledge or to establish the accuracy of well-known facts cannot be regarded as new evidence and is therefore admissible (§ 18).

[11/07/2019, T-349/18, \*TurboPerformance \(fig\)\*, EU:T:2019:495, § 18](#)

[10/09/2019, T-744/18, \*Silueta en forma de elipse discontinua \(fig.\) / Silueta en forma de elipse \(fig.\)\*, EU:T:2019:568, § 59, 61](#)

### **Admissible evidence submitted at the oral hearing – Evidence relating to the EUIPO's decision-making practice**

A party has the right to submit and refer to a BoA decision for the first time at the hearing because it does not constitute evidence within the meaning of Article 85 RPGC, even if that practice postdates the procedure before the EUIPO (§ 25).

[01/03/2023, T-552/21, \*Camel\*, EU:T:2023:98](#)

### **Admissible new evidence – Documents that were referred to in the form of a hyperlink**

The GC admits the submission for the first time before it of the documents that were merely referred to in the form of an internet hyperlink in the duly submitted evidence. The factual conditions for admission are two: (i) the BoA consulted the internet hyperlink during the administrative procedure in order to access the hyperlinked documents and (ii) the BoA based its reasoning on the hyperlinked documents (§ 18).

[22/03/2023, T-650/21, \*casa \(fig.\)\*, EU:T:2023:155](#)

### **Admissible new evidence – Evidence submitted before the GC in the context of a measure of organisation of procedure**

The evidence and the factual details submitted in response to the questions put by the GC are admissible without a need of any justification (§ 16-18).

[22/03/2023, T-617/21, \*Welding torches \(part of -\)\*, EU:T:2023:152](#)

### **Admissible new evidence – Annex relating to the definition of a term**

The annex relating to the definition of a term, which was not adduced during the administrative procedure, is inadmissible. By contrast, where the definition of a term has already been submitted before the OD and the BoA, it is not a new fact put forward for the first time before the Court, even if the definition is taken from a different website (§ 15-16).

[29/03/2023, T-436/22, \*ALMARA SOAP \(fig.\) / ALMENARA\*, EU:T:2023:167](#)

### **Admissible evidence submitted at the oral hearing – Evidence relating to the EUIPO's decision-making practice**

Although a decision of the OD is submitted for the first time at the hearing before the GC, that decision does not, strictly speaking, constitute evidence, within the meaning of Article 85 RPGC,

but relates to the EUIPO's decision-making practice, to which, even if it postdates the procedure before the EUIPO, a party has the right to refer for the first time before the GC. Neither the parties, nor the GC itself, can be precluded from drawing on the case-law or national decision-making practice for the purposes of interpreting EU law (§ 73).

[18/10/2023, T-566/22, ENDURANCE \(fig.\), EU:T:2023:655](#)

#### **2.2.1.6 Pleas raised for the first time during the hearing**

##### **Principle – Article 84(1) RPGC, Article 191 RPGC**

A new plea in law that was not alleged in the application but put forward for the first time in the oral hearing, without justifying that it is based on matters of law or of fact which came to light in the course of the procedure, is inadmissible, Article 84(1) RPGC, Article 191 RPGC (§ 15-18).

[19/06/2019, T-479/18, Premiere, EU:T:2019:430, § 15-18](#)

##### **Amplifying admissible arguments and new inadmissible arguments put forward at the oral hearing**

The applicant's arguments concerning the proof of genuine use put forward for the first time at the oral hearing can be interpreted as being a development of the argumentation already contained in the application (§ 25, 28). However, the argument that seeks to challenge the lack of a translation of the evidence into English is inadmissible, as it cannot be considered to be implicitly contained in the statement that the evidence is not 'solid and objective' (§ 25, 28-29, 32).

[07/11/2019, T-380/18, INTAS / INDAS \(fig.\) et al., EU:T:2019:782, § 25, 28-29, 32](#)

##### **Admissible new plea – Plea alleging failure to state reasons – Matter of public policy**

A plea alleging failure to state reasons is a plea involving a matter of public policy which may be put forward at any stage of the procedure (§ 87-89).

[29/04/2020, T-108/19; TasteSense By Kerry \(fig.\) / Multisense et al., EU:T:2020:161](#)

[29/04/2020, T-109/19; TasteSense \(fig.\) / Multisense et al., EU:T:2020:162, § 87-89](#)

##### **Inadmissible new argument – Argument presented for the first time at the oral hearing**

Before the GC, at the oral hearing, the Applicant claimed for the first time that the BoA had wrongly considered that reputation for one of the earlier marks was not established. However, it has not established, or even claimed, that that complaint resulted from matters of law or of fact that came to light in the course of the procedure or that the complaint amplified the plea alleging infringement of Article 8(5) EUTMR or was closely connected with that plea. That claim must therefore be rejected as inadmissible pursuant to Article 84(1) RPGC (§ 54).

[18/01/2023, T-726/21, DEVICE OF A CROWN \(fig.\) / ROLEX \(fig.\) et al., EU:T:2023:6](#)

#### **2.2.1.7 Distortion of facts in the GC's decision**

[No key points available yet.]

#### **2.2.1.8 Other**

##### **Ineffective plea**

A plea seeking to dispute a ground added for the sake of completeness is ineffective and is therefore rejected (§ 48).

31/01/2019, T-97/18, [STREAMS](#), EU:T:2019:43, § 48

### **Request for investigative measures**

A party may rely before the Court on the existence of evidence that may question the accuracy of the content or probative value of the evidence considered by the Office by requesting investigative measures for that evidence to be produced, for the first time, before the Court. However, in such a case, the party requesting such measures must explain in detail the reasons for considering that the evidence taken into account by the Office does not correspond, in its view, to reality, or the reasons for considering that the probative value of that evidence has not been established (§ 51). According to Article 97 EUTMR, parties to proceedings before the Office may request or propose investigative measures in order to establish facts relevant to the case. However, the applicable provisions do not impose an obligation on the Office to take such measures (§ 53).

29/09/2021, T-592/20, [Agate / Agate](#), EU:T:2021:633, § 51, 53

### **Conditions for annulment of a decision with several pillars of reasoning**

Where the operative part of a decision is based on several pillars of reasoning, each of which would in itself be sufficient to justify that operative part, that decision should, in principle, be annulled only if each of those pillars is vitiated by an illegality. In such a case, an error or other illegality which affects only one of the pillars of reasoning cannot be sufficient to justify annulling the decision at issue because that error could not have had a decisive effect on the operative part adopted by the decision-maker (§ 38).

24/11/2021, T-434/20, [dziandruk \(fig.\)](#), EU:T:2021:815, § 38

### **Ineffective plea – Plea disputing the summary of the facts**

The plea relating to an error mentioned in the summary of the facts, and not in the grounds of the decision, is ineffective (§ 100, 101).

27/04/2022, T-327/20, [Shower drains](#), EU:T:2022:263, § 100, 101

### **Ineffective plea – Translation into the language of the proceeding – Errors in the translation of the list of goods not affecting the comparison**

The partially different translation of the description of some of the goods covered by the earlier mark to which the BoA referred in the contested decision cannot have affected the comparison of the goods at issue on which the contested decision is based since the goods concerned are a general type of goods and a more specific type of goods which do not have fundamentally different purposes (§ 39, 40).

It is therefore not necessary to establish whether errors made in the translation of the list of goods which were relied on in the application for a declaration of invalidity resulted in an infringement of the principles of equality of arms and of neutrality or an infringement of Article 17(3) EUTMDR (§ 42).

27/04/2022, T-181/21, [SmartThinQ \(fig.\) / SMARTTHING \(fig.\)](#), EU:T:2022:247, § 39, 40, 42

### **Ineffective error or illegality of BoA decision**

Where the operative part of a decision is based on several pillars of reasoning, each of which would in itself be sufficient to justify that operative part, that decision should, in principle, be annulled only if each of those pillars is vitiated by an illegality. In such a case, an error or other illegality which affects only one of the pillars of reasoning cannot be sufficient to justify annulment of the decision at issue because that error could not have had a decisive effect on the operative part adopted by the decision maker (§ 21).

The fact that the first plea is well founded has no bearing on the legality of the contested decision, since the second plea directed against the second pillar of that decision is not, for its part, well founded and that second pillar is such as to justify, by itself, the operative part of that decision. The action must therefore be dismissed (§ 108, 109).

[29/06/2022, T-306/20, LA IRLANDESA 1943 \(fig.\), EU:T:2022:404](#)

### **Violation of the scope of a legal provision – Examination ex officio by the GC**

The scope of legal provisions shall be examined by the GC of its own motion as a plea in law. The GC must also determine, without complaint by a party, whether the decision was rendered on the basis of a norm that cannot apply (§ 27). The GC examined ex officio, after hearing the parties on this point, whether the BoA should have examined Article 7(1)(a) CTMR before deciding on Article 7(1)(b) CTMR (§ 29-31).

[07/12/2022, T-487/21, DARSTELLUNG EINES ZYLINDRISCHEN SANITÄREN EINSETZTEILS \(posit.\), EU:T:2022:780](#)

### **Examination by the BoA of Article 7(1)(b) CTMR but not Article 4 CTMR – Examination by the GC of Article 4 CTMR as a preliminary legal question**

The question whether the requirements of Article 4 CTMR are fulfilled is a preliminary question which is necessary for the examination of the pleas in law against Article 7(1)(b) CTMR and Article 95(1) EUTMR. Even without a complaint by the parties, the GC is obliged to determine whether the decision was issued on the basis of a provision [Article 7(1)(b) CTMR] that may not be applicable. This would be the case if - which the BoA has not examined - the sign is not a trade mark within the meaning of Article 4 CTMR. The GC cannot decide on the dispute by applying Article 7(1)(b) CTMR without first determining whether it is applicable (§ 47, 48).

[07/12/2022, T-487/21, DARSTELLUNG EINES ZYLINDRISCHEN SANITÄREN EINSETZTEILS \(posit.\), EU:T:2022:780](#)

### **Ineffective plea – *Obiter dictum***

BoA's considerations, prefaced by the expression 'for the sake of completeness', are an *obiter dictum*, so that the complaint made against them by the applicant, even if it were well founded, is not capable of resulting in the annulment of the contested decision (§ 95).

[01/02/2023, T-565/21, Papouis Halloumi Papouis Dairies LTD PAP since 1967 \(fig.\) / HALLOUMI, EU:T:2023:28](#)

See also, [01/02/2023, T-558/21, fino Cyprus Halloumi Cheese \(fig.\) / HALLOUMI, EU:T:2023:27, § 91](#)

### **Ineffective plea – Violation of the right to be heard by the first instance**

The plea alleging the infringement by the CD of the right to be heard, of the right to a fair trial or to equal treatment is ineffective in the context of an action before the GC (§ 42).

[24/01/2024, T-562/22, NOAH \(fig.\), EU:T:2024:23](#)

### **Ineffective plea challenging the first-instance decision**

An applicant before the GC is not entitled to challenge the lawfulness of a decision taken by a first-instance body within the EUIPO in an action for annulment. The purpose of an action before the GC is solely to review the legality of the decisions of the BoA (§ 27).

[07/02/2024, T-302/23, KABI / KABIR DONNAFUGATA \(fig.\) et al., EU:T:2024:62](#)

### **Ineffective argument – Contesting the BoA analysis of similarity without contesting the conclusion**

Where the applicant before the GC objects only to the BoA's analysis of similarity but does not contest its finding regarding the degree of similarity between the signs, the applicant's arguments are ineffective (§ 51).

[07/02/2024, T-101/23, Buffet \(fig.\) / Buff et al., EU:T:2024:65](#)

### **Request for witnesses to be heard by the GC**

Where the GC is able to rule on the action on the basis of the claims, pleas in law, and arguments put forward during the written and oral parts of the procedure, the request for witnesses to be heard must be rejected (§ 75).

[06/03/2024, T-59/23 & T-68/23, DEC FLEXIBLE TECHNOLOGIES \(fig.\), EU:T:2024:148](#)

### **Ineffective plea – Arguments against grounds included for the sake of completeness**

Arguments directed against grounds that were included in a decision purely for the sake of completeness are ineffective (§ 59, 67, 72).

[06/03/2024, T-652/22, ORANGE, EU:T:2024:152](#)

## **2.2.2 Restriction of the list of goods and services**

### **2.2.2.1 Admissible restrictions**

#### **Restriction of the goods and services – Subject matter of the proceedings before the GC**

In principle, a restriction within the meaning of Article 49(1) EUTMR of the list of goods or services made after the adoption of the BoA decision challenged before the GC cannot affect the legality of that decision (09/07/2008, T-304/06, Mozart, EU:T:2008:268, § 25) (§ 21).

Where the restriction amounts to a change in the subject-matter of the proceedings in the course of the proceedings, it cannot be taken into account by the GC (Article 188 RPGC; 09/07/2008, T-304/06, Mozart, EU:T:2008:268, § 29) (§ 22-23). However, a restriction of the list of the goods and services is possible if the applicant confines itself to withdrawing one or more goods or services from the list, or one or more categories of goods or services. In such a case, it is clear that the GC is in fact being asked to review the legality of the BoA decision not insofar as it relates to the goods or services withdrawn from the list but only insofar as it relates to the other goods or services remaining on that list (09/07/2008, T-304/06, Mozart, EU:T:2008:268, § 27-28) (§ 24-25).

[10/02/2020, T-341/20, Radioshuttle, EU:T:2021:72, § 21, 24-25](#)

#### **Request for limitation of goods and services – Subject matter of the dispute**

Where the trade mark applicant requests the limitation of the goods and services after the BoA's decision, this statement is interpreted in the sense that the contested decision is being challenged only insofar as it covers the remainder of the goods concerned, or as a partial withdrawal, where that statement made during the proceedings before the GC does not alter the subject matter of the proceedings before the BoA. Such a limitation must be taken into account by the Court, since it is no longer asked to review the legality of the BoA's decision with regard to the goods or services withdrawn from the list but only insofar as it relates to the remaining goods or services (§ 31-33).

28/11/2019, T-736/18, [Bergsteiger / BERG \(fig.\) et al.](#), EU:T:2019:826, § 31-33

### **Request for the limitation of goods and services – General conditions**

A request for limitation must be filed expressly and unconditionally (§ 45).

31/01/2019, T-97/18, [STREAMS](#), EU:T:2019:43, § 45

### **Procedure for the limitation of goods and services**

Granting the request for the restriction of the goods and services without asking the opponent whether, for that reason, it intended to waive the opposition procedure does not constitute an infringement of Article 95 EUTMR (§ 104-105).

16/05/2019, T-354/18, [SKYFi/SKY et al.](#), EU:T:2019:33, § 104-105

### **Admissible restriction of goods and services – Deletion of a term – No alteration of the subject-matter of the dispute**

A restriction which is made after the BoA has adopted its decision cannot, in principle, affect the legality of that decision (§ 10). However, a declaration by the applicant that it withdraws its application in respect of certain goods originally covered may be construed as a declaration that the contested decision is being challenged only in so far as it covers the remaining goods concerned; that declaration does not alter the subject-matter of the dispute (§ 11). The applicant's restriction of the list of goods in Class 9, consisting in the deletion of the term 'lithium batteries', must be interpreted as a declaration that the contested decision is not challenged in so far as it relates to 'lithium batteries' in Class 9 (§ 12).

[14/09/2022, T-795/21, Li-SAFE, EU:T:2022:550](#)

### **Admissible restriction of goods and services – Deletion of a term – Use of 'namely' – Specification of the material used to manufacture the goods**

A restriction of the list of goods, which could lead to legal uncertainty as to the scope of protection of the mark applied for, cannot be allowed. Furthermore, the goods covered by the application must be identified with clarity and precision in order to be entered in the register (§ 21, 22).

The purpose or intended use of goods or services is a relevant indication as to whether a requested restriction should be taken into account. Since consumers themselves take those criteria into account before any purchase, they are relevant for defining a sub-category of goods or services (§ 23).

The deletion of some of the goods from the list of goods of the trade mark applied for has no effect on the clarity and precision of the wording of the other goods covered by this trade mark (§ 26).

A restriction made pursuant to Article 49(1) EUTMR after the adoption of the contested decision may be taken into account by the GC where the applicant strictly limits himself to restricting the

subject matter of the dispute by deleting certain categories of goods or services from the list of goods or services covered by the trade mark application (§ 27).

Replacing of the adverb 'in particular' by 'namely' restricts the registration of the mark applied for to the goods subsequently specifically listed (§ 29, 30).

The material used to manufacture goods is in fact a characteristic which can define the goods. Consequently, in order to restrict the list of goods and services pursuant to Article 49(1) EUTMR, it must be possible to specify the material used to manufacture the goods, provided that the definition of that material itself is clear and unambiguous (§ 38, 39).

 [05/10/2022, T-168/21, BLAU \(col.\), EU:T:2022:605](#)

## 2.2.2.2 Inadmissible restrictions

### Inadmissible limitation of goods and services at the oral hearing

The applicant's restriction of the goods from *software applications for mobile phones and software applications for computer* to *software applications for smartphones and tablets*, requested in the oral hearing, does not constitute an admissible limitation of the goods. It is, rather, a modification of the category of goods that would lead to a modification of the subject matter of the dispute. Therefore, it cannot be taken into account by the Court when assessing the legality of the decision (§ 19-20).

24/09/2019, T-492/18, [Scanner Pro](#), EU:T:2019:667, § 19-20

### Inadmissible limitation of goods and services – Infringement of the obligation to draw up the list of goods with clarity and precision

The proprietor of the trade mark should not gain from the infringement of its obligation to draw up the list of goods with clarity and precision (§ 80). Given that the concept of *means of transport* is so general and broad that it may naturally be understood as including *moving vehicles for children*, the interpretation of the opponent's limitation *means of transport, excluding bicycles and children's bicycles; moving vehicles for children* in Class 12, in the sense that the list of goods covers only *means of transport* and does not concern *moving vehicles for children* cannot be considered as admissible (§ 78-79).

28/11/2019, T-736/18, [Bergsteiger / BERG \(fig.\) et al.](#), EU:T:2019:826, § 78-80

### Inadmissible limitation of goods and services – Alteration of the subject matter of the dispute – Relevant public and its level of attention

A restriction of the services of the mark applied for, requested by the applicant after the BoA decision, is not limited to reducing the subject matter of the dispute by withdrawing certain services in the same category of those applied for, but is capable of changing the subject matter of the dispute by altering the composition of the relevant public and its level of attention. Therefore, it cannot be taken into account by the GC for the purposes of examining the legality of the contested BoA decision (§ 22-23).

09/12/2020, T-819/19, [BIM READY \(fig.\) / BIM freelance \(fig.\)](#), EU:T:2020:596, § 22-23

### Restriction of the services covered by the mark applied for – Change of the subject matter of the dispute before the GC – Inadmissible

Where the restriction leads to a change in the subject matter of the dispute, in that it results in the introduction of new elements which had not been submitted for examination by the BoA for the

purposes of the adoption of the contested decision, it may not, in principle, be taken into account by the Court. This is the case where the restriction of the goods and services consists of specifications capable of influencing the assessment of the similarity of the goods and services or the determination of the target public and of changing, consequently, the factual context presented before the BoA (30/04/2015, T-100/14, *TECALAN / TECADUR et al.*, EU:T:2015:251, § 32 and the case-law cited) (§ 23-24).

02/06/2021, T-17/20, [GAMELAND \(fig.\) / Gameloft](#), EU:T:2021:313, § 23-24

### **Inadmissible restriction of goods and services – Amendment impacting the examination of the mark – Alteration of the subject-matter of the dispute**

The restriction of the list of goods in Classes 6 and 20, consisting in the deletion of the words 'batteries of all kinds as well as', involves a partial amendment of the description of the goods covered by those classes, which has an impact on the examination of the mark at issue. It is tantamount to an alteration of the subject-matter of the dispute in the course of the proceedings, which is inadmissible under Article 188 of the RPGC (§ 14).

[14/09/2022, T-795/21, Li-SAFE](#), EU:T:2022:550

### **Inadmissible restriction of goods and services – Alteration of the subject-matter of the dispute before the GC**

Where the restriction of the list of goods or services covered by an EUTM application has as its object the total or partial amendment of the description of those goods or services, it cannot be excluded that that amendment has an impact on the examination of the trade mark at issue carried out by the EUIPO in the course of the administrative procedure. To allow such an amendment at the stage of the action before the GC would, in those circumstances, be tantamount to amending the subject-matter of the proceedings, which is inadmissible under Article 188 RPGC (§ 14).

[15/11/2023, T-97/23, THE SCIENCE OF CARE](#), EU:T:2023:719

### **Inadmissible restriction of goods and services – Alteration of the subject-matter of the dispute**

Where there is, before the GC, a restriction of the list of goods that does not merely consist of a deletion but which leads to a change in the description of the goods concerned, this could alter the factual context to which the BoA's examination related. Therefore, this restriction cannot be taken into account by the GC when examining the legality of the contested decision (§ 22-24).

[21/02/2024, T-767/22, Horex / MOLDEX \(fig.\)](#), EU:T:2024:108

## **2.3 STAY OF THE PROCEEDINGS**

### **Decision to stay the proceedings – Discretion of the GC**

The decision whether or not to stay proceedings falls within the GC's discretion (§ 18).

13/06/2019, T-392/18, [Innocenti / i INNOCENTI \(fig.\)](#), EU:T:2019:414, § 18

## **2.4 POWER OF ALTERATION**

### **Alteration of the contested decision**

The power of the Court to alter decisions pursuant to Article 72(3) EUTMR does not have the effect of conferring on that Court the power to carry out an assessment on which the BoA has not

yet adopted a position. Exercise of the power to alter decisions must therefore, in principle, be limited to situations in which the Court, after reviewing the assessment made by the BoA, is in a position to determine, on the basis of the matters of fact and of law as established, what decision the BoA was required to take (16/05/2017, T-107/16, AIR HOLE FACE MASKS YOU IDIOT, EU:T:2017:335, § 45 and the case-law cited) (§ 139).

In this case, the BoA adopted a position on whether there was a LOC between the signs with regard to the initial list of goods covered by the earlier marks, with the result that the Court has the power to alter that decision in that regard (§ 130).

24/10/2019, T-498/18, [Happy Moreno choco \(fig.\) / MORENO \(fig.\) et al.](#), EU:T:2019:763, § 130, 139

## 2.5 INTERVENTION

### **Intervener's independent plea – Plea incompatible with form of order sought**

Where the intervener has requested the dismissal of the action before the GC, its plea, according to which the BoA should have rejected the invalidity action on the ground that the contested RCD did not fall within Article 8(1) CDR and not on the ground that that design could fall within the exception provided for in Article 8(3) CDR, is incompatible with the form of order and, therefore, must be rejected (§ 20-23).

24/01/2024, T-537/22, [Building blocks from a toy building set](#), EU:T:2024:22

## 2.6 DISCONTINUANCE AND NO NEED TO ADJUDICATE

### **No need to adjudicate – Opposition proceedings – Expiry of the contested International Registration – Action devoid of purpose**

As a result of the non-renewal of the contested international registration, the latter has expired. It follows that the IR holder has, in essence, waived the protection of the mark applied for in the territory of the European Union, with the result that the action has become devoid of purpose (see, by analogy, 19/03/2018, T-229/16, QUIS UT DEUS (fig.), EU:T:2018:177, § 5). Accordingly, there is no longer need to adjudicate, in accordance with Article 130(2) RoP (§ 6,7).

05/10/2022, T-45/20, [INDIA SALAM Pure Basmati Rice \(fig.\) / INDIA GATE \(fig.\) et al.](#), EU:T:2022:622

### **Action not devoid of purpose – Expiry of the contested IR during the proceedings before the GC**

Even if the contested IR has expired as a result of its non-renewal after the BoA's contested decision was taken, it cannot be concluded that the action before the GC has become devoid of purpose since it has not been argued nor demonstrated that that non-renewal has *ex tunc* effect. It is only as of the date of non-renewal of the IR at issue that the latter no longer has the effects provided for by the EUTMR and not in respect of the earlier period with regard to which the contested decision was adopted (§ 19-21).

03/05/2023, T-459/22, [BIOLARK \(fig.\) / Bioplak](#), EU:T:2023:237

## 2.7 COSTS

### **Repartition of costs of the proceedings before the GC – Article 135(2) RPGC – Equity and unreasonable or vexatious costs – Avoidable incurred travel costs to the oral hearing due to the withdrawal of the request for the oral hearing**

By its conduct, the Office caused the applicant to incur travel expenses that could have been avoided. Therefore, even though the applicant was unsuccessful, as per Article 135(2) of the RPGC, the Office was ordered to pay the applicant's lawyers' travel costs to the oral hearing that was initially requested by the Office, scheduled and then cancelled following the withdrawal of the Office's request for the oral hearing (§ 117-119).

10/11/2021, T-353/20, [ACM 1899 AC MILAN \(fig.\) / Milan et al.](#), EU:T:2021:773, § 117-119

### **Costs of the proceedings before the GC – Article 139a RPGC**

In principle, proceedings before the GC are free of charge. However, where a party has caused the GC to incur avoidable costs, in particular where the action is manifestly an abuse of process, the GC may order that party to refund them, Article 139a RPGC.

Following the withdrawal of the application in the night before the delivery of the judgment, the GC orders the parties to refund a portion of the costs incurred over a number of months with a view to delivering a decision closing the proceedings (amounting to EUR 5 000). These costs could have been avoided if at least one of the parties had informed the GC, in the context of a request to stay the proceedings, of the existence of negotiations aimed at an amicable agreement, Article 69(c) RPGC (§ 15-20).

24/09/2019, T-748/17 and T-770/17, [iBeat](#), EU:T:2019:607, § 15-20

### **Recoverable costs – Article 190(2) RPGC**

According to Article 190(2) RPGC, recoverable costs are the costs necessarily incurred by the parties for the purposes of the proceedings before the BoA. They do not include costs incurred in the proceedings before the OD (§ 72).

28/11/2019, T-642/18, [DermoFaes Atopimed / Dermowas](#), EU:T:2019:819, § 72  
27/01/2021, T-382/19, [Skylife \(fig.\) / SKY](#), EU:T:2021:45, § 56

## 3 PROCEEDINGS BEFORE THE BoA

### 3.1 APPEAL DEEMED NOT TO BE FILED

#### **Failure to comply with the obligation to pay the appeal fee within the prescribed period**

The notice of appeal to be filed in writing within two months of the date of notification of the contested decision is deemed to have been filed only when the fee for appeal has been paid (Article 68 EUTMR) (§ 25).

The date on which the payment is considered to have been made is the date on which the amount of the payment or transfer is actually entered in a bank account held by the Office (Article 180(1) EUTMR).

In this case, the BoA was entitled to consider that the appeal fee had not been paid within the period provided for in Article 68 EUTMR and that the appeal was deemed not to have been filed (Article 23(3) EUTMDR) (§ 27).

## 3.2 ADMISSIBILITY OF THE APPEAL

### 3.2.1 Locus standi, interest in bringing proceedings

#### Article 59 CTMR [now Article 67 EUTMR]

The EUTM proprietor has no interest in bringing an appeal before the BoA against the CD's decisions to close the invalidity proceedings after the withdrawal of the invalidity application. The EUTM proprietor had claimed that it had been deprived of the possibility of obtaining a positive decision on the validity of its EUTM. The EUTM proprietor is not adversely affected by the CD's decisions insofar as the EUTMs remain on the Office's register. The question whether a decision adversely affects a party must be evaluated with respect to the current proceedings and not in comparison, or in conjunction, with other proceedings. The existence of other proceedings before EU trade mark courts has no bearing on the conditions for the admissibility of the action before the BoA (§ 5).

15/01/2019, C-463/18 P, [Hip Ball \(3D\)](#), EU:C:2019:18, § 5

#### Inadmissibility of a cross-claim – Possibility of conversion does not give *locus standi*

The cross-claim must be likely to procure, by its outcome, an advantage. The risk that the EUTM applicant might request the conversion of its EUTM application into an application for a national trade mark concerns a future and uncertain legal situation (§ 96-100).

17/01/2019, T-671/17, [TURBO-K / TURBO-K \(fig.\)](#), EU:T:2019:13, § 96-100

#### Invalidity proceedings – Relation between Article 7(1)(a) EUTMR and 7(1)(b) EUTMR – Adverse effect of the BoA decision – Admissibility of an action or of a cross-claim

Where an application for a declaration of invalidity is based on the fact that the sign at issue has been registered contrary to the provisions of Article 7(1)(a) EUTMR or the provisions of Article 7(1)(b) EUTMR, it is essential to examine the first of these grounds before assessing, where appropriate, whether the mark has inherent distinctive character or whether it has acquired distinctive character through use (§ 44-48).

The invalidity applicant is adversely affected by the BoA's decision which upheld the invalidity request on the basis of Article 7(1)(b) EUTMR and remitted the case to the Cancellation Division for the assessment of Article 7(3) EUTMR, but which did not examine Article 7(1)(a) EUTMR, which was also invoked by the invalidity applicant (§ 54).

In light of the relationship between Article 4 and Article 7(1)(a) EUTMR, and of Article 7(1)(b) thereof, the Grand Board of Appeal could not dispense with the examination of the ground for invalidity under Article 7(1)(a) EUTMR and refer the case back to the Cancellation Division to decide on the possible acquisition of distinctive character by the mark following the use which has been made of it, in accordance with Article 7(3) and Article 52(2) EUTMR (§ 69).

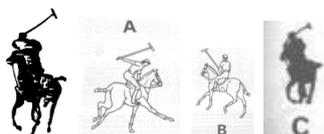
06/10/2021, T-124/20, [DEVICE OF A REPEATED GEOMETRIC DESIGN \(fig.\)](#), EU:T:2021:668, § 44-48, 54, 69

#### Invalidity proceedings – Relevant date for the establishment of the existence and protection of the earlier right – Date on which the Office takes its decision

It follows from the broad logic of the other provisions of the regulation concerning relative grounds for refusal that an application for a declaration of invalidity must be rejected where the cancellation

applicant is unable to prove that its earlier mark continues to enjoy protection on the date on which the Office takes its decision and it is established, with certainty, that the conflict with the earlier trade mark no longer exists (§ 27-29).

In the context of Article 52(2)(d) CTMR [now Article 60(2)(d) EUTMR] the proprietor of an earlier industrial property right must therefore establish that he may prohibit the use of the contested EU trade mark not only on the date of filing or priority of that mark, but also on the date on which the Office gives a ruling on the application for a declaration of invalidity (§ 30).



02/06/2021, T-169/19, [DEVICE OF A POLO PLAYER \(fig.\) / DEVICE OF A POLO PLAYER \(fig.\) et al.](#), EU:T:2021:318, § 27-30

### **Invalidity proceedings – Continued existence of earlier right throughout proceedings before the Office**

An earlier mark invoked as the basis of an invalidity request in proceedings before the Office must exist (i) at the filing/priority date of the contested EUTM (§ 33-34) and (ii) throughout the proceedings until the date on which the Office decides on the request for invalidity (§ 35). This follows from the applicable provisions in the EUTMR and the EUTMDR (§ 36-39), and also from the principle that any claim before an administrative body is conditional upon the existence of a legitimate interest, vested and present, in the success or rejection of that claim (§ 40-41).

20/07/2021, T-500/19, [Coravin](#), EU:T:2021, § 33-41

### **Admissibility of the appeal – Transfer of the mark during the course of the proceedings**

When EUIPO examines the admissibility of an appeal brought before it, it must take into account the EUTM Register (§ 31).

14/12/2022, T-530/21, [PL \(fig.\) / PL \(fig\) et al.](#), EU:T:2022:818

### **Admissibility of the appeal – Incorrect identification of the appellant in the notice of appeal – Rectifiable defect**

It follows from a combined reading of Article 21(1)(a) and Article 23(1)(c) EUTMDR, as well as Article 2(1)(b) EUTMR, that the incorrect identification of the appellant in the notice of appeal filed in accordance with Article 68(1) EUTMR is a defect capable of being rectified (§ 37).

14/12/2022, T-530/21, [PL \(fig.\) / PL \(fig\) et al.](#), EU:T:2022:818

## **3.2.2 Time limit and form of appeal, means of communication**

### **Article 68 EUTMR – Article 23(1)(b) EUTMDR**

A notice of appeal before the BoA prepared in the applicant's User Area of the Office's website in 'DRAFT' status is, in the absence of further evidence, not capable of proving the timely submission of the notice of appeal (§ 43).

15/01/2019, T-111/17, [COMPUTER MARKET \(fig.\)](#), EU:T:2019:4, § 43

### **Electronic communications – Notification by eComm – *Dies a quo***

Article 4(4) of Decision No EX-13-2 of 26 November 2013 concerning electronic communication must be interpreted as meaning that notification will be deemed to have taken place on the fifth calendar day following the day on which the Office placed the document in the user's inbox, unless the actual date of notification can be accurately established as a different date within that period of time (§ 43).

[NB: Article 4(4) of Decision No EX-13-2 of 26 November 2013 was repealed by Article 3(4) of Decision No EX-19-1 of 18 January 2019 (which entered into force on 1 March 2019), which now reads 'Notification will be deemed to have taken place on the fifth calendar day following the day on which the Office placed the document in the user's inbox.' Therefore, when a document is now notified electronically by the Office, an automatic extension of five calendar days following the day on which the document is placed in the User Area is included in the time limit set for any response or procedural step to be taken.]

10/04/2019, C-282/18 P, [Formula E](#), EU:C:2019:300, § 43

#### **Notification of decisions – Notification by email – Notification by registered post with advice of delivery – Burden of proof**

A decision is properly notified, provided that it is communicated to the person to whom it is addressed and the latter is put in a position to become acquainted with it (21/02/2018, C-326/16 P, LL/Parliament, EU:C:2018:83, § 47, 48) (§ 42).

Notification by registered post with advice of delivery under the meaning of Article 58(1) EUTMDR, for which the Office bears the burden of proof according to Article 58(3) EUTMDR, requires a signature of the addressee (§ 50). Lacking such a signature, the Office is not able to prove the delivery (§ 55).

A decision is duly notified by email according to Article 56(2)(a) EUTMDR and Article 57(1) EUTMDR, in so far it is possible to prove that the addressee indeed received it and was able to acquire the knowledge of its contents (07/12/2018, T-280/17, GE.CO.P./Commission, EU:T:2018:889, § 50; 21/02/2018, C-326/16 P, LL/Parliament, EU:C:2018:83, § 50) (§ 57-58).

08/07/2020, T-305/19, [Welmax / Valmex](#), EU:T:2020:327, § 42, 50, 55, 57-58

#### **Notification of decisions – Notification by post without acknowledgement of receipt – Article 61 EUTMDR in conjunction with Article 58(3) EUTMDR**

Where notification of decisions subject to a time limit for appeal is carried out by courier service or registered post, it should be done with advice of delivery (first sentence of Article 58(1) EUTMDR) (§ 18).

If the EUIPO has erred by carrying out notification by registered post without acknowledgement of receipt, Article 61 EUTMDR must be applied in conjunction with Article 58(3) EUTMDR. In such a case, notification of the document concerned is deemed to have taken place on the date of its actual receipt only if it has reached the addressee after the 10th day following its posting. However, it has not been shown that that was the case here (§ 28).

19/01/2022, T-76/21, [Pomodoro](#), EU:T:2022:16, § 18, 28

#### **Notification of a decision containing blank spaces – Article 98(1) EUTMR**

The Office has to prove that the decision was duly notified to the parties, Article 98(1) EUTMR and Article 56(1) EUTMDR (§ 17-23, 29). However, the parties must show good faith and notify the Office in good time of any omissions or errors that they have detected in the documents sent to them (§ 17, 30).

13/06/2019, T-366/18, [SUIMOX / ZYMOX](#), EU:T:2019:410, § 17-23, 29, 30

### **Notifications to duly authorised representatives – Effect**

Where a representative has been appointed, notifications are to be addressed to that representative. A notification or other communication addressed by the Office to the duly authorised representative has the same effect as if it had been addressed to the represented person, Article 60(1) and (3) EUTMDR (§ 30).

28/05/2020, T-564/19, [Libertador](#), EU:T:2020:228, § 30

### **Admissibility of the appeal – Official designation and legal form of the entity – Article 21(1)(a) EUTMDR, Article 2(1)(b) EUTMIR**

The BoA was wrong in declaring the appeal inadmissible due to the applicant's failure to provide the essential information (official designation and legal form of the entity) required by Article 21(1)(a) EUTMDR and Article 2(1)(b) EUTMIR (§ 24-25). The BoA should have taken into account the applicant's status in the EUTM Register on the date on which the contested decision was delivered (§ 23).

11/02/2020, T-262/19, [FORM EINER TASSE \(3D\)](#), EU:T:2020:41, § 23

### **3.2.3 Restitutio in integrum**

#### **Time-limit to file a restitutio in integrum – Locus standi – Licence agreement**

Under Article 53(1) EUTMR, only the proprietor of the trade mark or a person expressly authorised by him can be regarded as a party to the renewal proceedings (§ 25).

No provision in the EUTMR precludes a 'party to the renewal proceedings' from being regarded as a 'party to proceedings before [the EUIPO]', within the meaning of Article 104(1) EUTMR (§ 26).

An EUTM licensee is not on the same legal footing, for the purposes of the renewal of an EUTM registration, as the EUTM proprietor: in the same way as any other person, the licensee must be expressly authorised by the proprietor to be able to submit a request for renewal and must prove the existence of such authorisation (§ 27).

According to Article 104(2) EUTMR, an application to have rights re-established must be filed in writing within 2 months of the removal of the obstacle to compliance with the time limit (§ 45). The lack of an express authorisation from the EUTM proprietor to the EUTM licensee does not constitute an obstacle to compliance within the meaning of Article 104 (§ 48). Therefore, the 2-month period cannot begin to run from the date on which the licensee received the proprietor's authorisation (§ 47).

23/09/2020, T-557/19, [7SEVEN \(fig.\)](#), EU:T:2020:450, § 25-27, 47

#### **Restitutio in integrum – Representative's duty of care – Article 67 CDR**

Restitutio in integrum is subject to two cumulative conditions: i) that the party before the Office acted with all due care required by the circumstances; ii) that the party's inability to observe a time limit had, as a direct consequence, the loss of a right or of a means of redress (§ 58). Since the duty of care provided for in Article 67 CDR rests, in principle, on the applicant's representative (§ 20), the question of whether the RCD holder has exercised the necessary vigilance to compensate for the errors of its representative is not relevant (§ 21).

31/01/2019, T-604/17, [REJECTION OF RESTITUTIO IN INTEGRUM \(RECORDAL\)](#), EU:T:2019:42, § 20-21, 58

### **Restitutio in integrum – Duty of care – Due care requires system of internal control and monitoring of time limits**

A system of internal control and monitoring of time limits, which is based in essence on one person controlling the work of the other, cannot generally preclude involuntary non-compliance with time limits (§ 31).

21/04/2021, T-382/20, [Table knives, forks and spoons](#), EU:T:2021:210, § 31

### **Restitutio in integrum – Due care required by the circumstances – Error of bank transfer**

In support of his action, the applicant alleged solely an error in the transmission of the data to the bank or an error by the bank in the execution of the transfer to the EUIPO (§ 29).

However, since such errors are neither rare nor improbable, they cannot be regarded as exceptional and unforeseeable (§ 30). The applicant was under an obligation to anticipate those circumstances and to take the necessary precautions to ensure that the payment was made within the established time period. This applies a fortiori in the case of an action as important as the renewal of the registration of a trade mark, where the transfer was ordered via an online banking system on the same day as leaving for a stay abroad and where the first deadline for carrying out this formality had been missed (§ 31).

Therefore, despite the absence of an error message from the bank regarding the execution of the transfer, the applicant should have enquired with his bank about the execution of the transfer to remedy any non-payment. Indeed, an effective system of internal control and monitoring of compliance with deadlines should have included such a check. Moreover, the requirement to take such precautions does not infringe the principle of proportionality, since, under Article 53(8) EUTMR, the breach of an obligation such as compliance with the time limits prescribed by that regulation is, in principle, punishable by the loss of rights (§ 32). The BoA did not err in finding that, in the present case, the applicant had not exercised all the due care required by the circumstances and that, therefore, the first condition of Article 104(1) EUTMR was not satisfied (§ 36).

13/10/2021, T-732/20, [Crystal](#), EU:T:2021:696, § 29-32, 36

13/10/2021, T-733/20, [Bandit](#), EU:T:2021:697, § 30-32, 36

### **Restitutio in integrum – Article 67(1) CDR – Duty of care – Letter sent by ordinary mail – Due care requires verification of reception**

According to Article 67(1) CDR *restitutio in integrum* is subject to two requirements, the first being that the party has exercised all due care required by the circumstances. The second requirement is that the non-observance by the party has the direct consequence of causing the loss of any right or means of redress.

Where an applicant, proprietor, or any party to proceedings before the Office is represented, the representative is subject to the requirement to take due care. The expression ‘all due care required by the circumstances’ in Article 67(1) CDR requires a system of internal control and monitoring of time limits to be put in place which generally excludes the involuntary non-observance of time limits. It follows that *restitutio in integrum* may be granted only in the case of exceptional events, which cannot therefore be predicted from experience (31/01/2019, T-604/17, REJECTION OF RESTITUTIO IN INTEGRUM (RECORDAL), EU:T:2019:42, § 11, 17-19, 31) (§ 17-20). As the observance of time limits is a matter of public policy and *restitutio in integrum* is liable to undermine legal certainty, the conditions for the application of *restitutio in integrum* must be interpreted strictly (19/09/2012, T-267/11, VR, EU:T:2012:446, § 35) (§ 21).

In those circumstances, the risk inherent in sending a document by ordinary mail, which is the method of communication chosen by the representative before the Office, cannot be borne by the

addressee of that letter, where the addressee of that letter makes various claims such as to cast reasonable doubt as to the receipt of the document in question (25/10/2012, T-191/11, Miura, EU:T:2012:577, § 32-34) (§ 29, 32). In such a situation, it is for the representative before the Office, as a professional who is requested to take all due care required by the circumstances, to ensure that the disputed letter, which he claims was sent by ordinary mail, was received within the time limit set (§ 33-34). An effective system of internal supervision and monitoring of compliance with time limits, where posting of mail by ordinary mail is used as a method of communication, must include verification that such mail has been received by its addressee (§ 38).

20/01/2021, T-276/20, [Air deodorizing apparatus](#), EU:T:2021:26, § 21, 29, 32-34, 38

### **Restitutio in integrum – Duty of care – Lawyer’s sworn declaration as evidence – Specific sudden illness – Article 97(1)(f) EUTMR – Probative value**

Where a sworn declaration, submitted as evidence according to Article 97(1)(f) EUTMR, is made in the interest of the declarant, it has only limited probative value and should be supported by additional evidence (16/06/2015, T-585/13, JBG Gauff Ingenieure (fig.) / Gauff et al., EU:T:2015:386, § 28-31). The assessment of the probative value to be attributed to such a statement, however, must consider the circumstances of the concrete case (§ 51-52).

As regards a declaration made by a lawyer, the fact that the lawyer is a member of the legal profession who is required to carry out his duties in accordance with the rules of professional conduct and moral requirements, and who would be exposed to penal sanctions in case of a false statement that would be, moreover, prejudicial to his reputation, must be considered (§ 55). A written sworn declaration by a lawyer (and by his wife) constitutes, in itself, sound evidence of the information contained therein, if it is clear, consistent and conclusive and there is no doubt about its authenticity (§ 56, 58).

Where additional evidence capable of supporting the content of a sworn declaration, such as a medical certificate, could not reasonably be required or was not available, (namely in case of a specific and sudden illness), the situation is different from those where such statements are submitted in order to establish purely objective facts, such as genuine use of a mark, and where according to established case-law, the declarations must be supported by additional evidence for their probative value (§ 57-59).

16/12/2020, T-3/20, [Canoleum / Marmoleum](#), EU:T:2020:606, § 51-52, 56-59

### **Restitutio in integrum – Late payment of the appeal fee – Inadmissibility of the appeal before the BoA – Article 101(4) EUTMR**

The BoA rightly considered that it was not competent to adopt a decision pursuant to Article 101(4) EUTMR, which covers the Executive Director’s power to extend the time limit on account of an exceptional occurrence or disaster. The BoA has no such competence, nor can it transmit corresponding requests to the Executive Director (§ 29-30).

The only solution for a party that has failed to comply with a time limit (in the present case time limit for paying appeal fees, laid down in Article 68 EUTMR) is to submit an application for *restitutio in integrum* (§ 31, 33-35). In the context of the *restitutio in integrum* procedure, the applicant could have raised all of its substantive arguments. These were the fact that Bulgaria was facing the exceptional occurrence of the COVID-19 pandemic (which also affected its representative who was placed in quarantine), and the capital control measures then in place in Lebanon that prevented the representative from making payments outside the country (§ 32). However, the applicant did not submit an application for *restitutio in integrum* (not disputed) (§ 34).

The Office is not required to direct the applicant to submit an application for *restitutio in integrum* so that it can argue its reasons for non-compliance with the time limit laid down in Article 68 EUTMR. There is no provision requiring the Office to inform a party of the procedures available to it under Article 104 EUTMR and Article 68 EUTMDR. Nor is the Office required to advise a party to pursue any particular legal remedy. Moreover, information for the parties is contained in the Office's Guidelines, particularly applicable in the event of the expiry of a time limit (§ 36).

06/10/2021, T-635/20, [Juvéderm vybrance](#), EU:T:2021:656, § 29-36

06/10/2021, T-636/20, [Juvéderm voluma](#), EU:T:2021:657, § 29-36

06/10/2021, T-637/20, [Juvéderm volite](#), EU:T:2021:658, § 29-36

### **Restitutio in integrum – Duty of care – Human errors in the management of renewals – Foreseeable event**

The inability to correctly process manual tasks in a system is a foreseeable event (§ 33). The fact that within a renewal provider's system instruction letters do not reach their intended recipients, and that employees erroneously produce internal receipts in a management tool are foreseeable errors that a control system must be able to detect (§ 35).

Case law concerning Art. 47(3) CTMR is not relevant for the application of *restitutio in integrum* provisions. The judgment of [22/06/2016, C-207/15 P, CVTC, EU:C:2016:465](#) and the Opinion of the Advocate General in that case concerned whether subsequent applications for renewal of a mark could be lodged within the time limit provided for in the provision concerned. Unlike in *restitutio in integrum* cases, the non-observance of time limits was not at issue in that case (§ 40).

[09/12/2022, T-311/22, Medical instruments \(part of -\)](#)

### **Restitutio in integrum – Duty of care – No evidence proving the impact of COVID-19 pandemic**

The GC must be enabled to assess in specific terms to what extent the COVID-19 pandemic could have actually interfered with the work carried out and how it could have prevented the employees from carrying out the necessary checks and detecting the error committed, or from setting up additional control systems (§ 37).

[09/12/2022, T-311/22, Medical instruments \(part of -\)](#)

### **Restitutio in integrum concerning cancelled registrations – Strict interpretation of the conditions – Principle of legal certainty**

The conditions governing an application for *restitutio in integrum* in respect of a registration after it has been cancelled must be interpreted strictly, given that, in particular, that application is liable to undermine legal certainty, while observance of time limits is a matter of public policy. Those conditions do not, therefore, run counter to the objective pursued by the CDR of ensuring effective protection of RCD within the EU (§ 53).

[09/12/2022, T-311/22, Medical instruments \(part of -\)](#)

### **Restitutio in integrum – Strict interpretation of the conditions**

The loss of an intellectual property right due to non-compliance with the rules concerning *restitutio in integrum* is in no way 'punitive'; it is not a penalty. At the time when Article 67 CDR was created, the EU legislature was well aware of the objectives relating to investment protection that were set out in the legislation on intellectual property rights. Moreover, compliance with time limits is a matter of public policy and that *restitutio in integrum* of a registration after its cancellation is liable

to undermine legal certainty, with the result that the conditions for the application of *restitutio in integrum* must be interpreted strictly (§ 54).

[20/09/2023, T-616/22, Cooking devices, EU:T:2023:576](#)

### 3.2.4 Continuation of proceedings (not applicable to designs)

#### **Article 72(6) EUTMR – Resumption of proceedings before the BoA after the annulment of a previous decision by the GC – Article 94(1) EUTMR – Right to be heard**

In order to comply with a judgment annulling a measure and to implement it fully, the institution responsible for adopting that measure must have regard not only to the operative part of the judgment but also to the grounds constituting its essential basis, insofar as they are necessary for determining the exact meaning of what is stated in the operative part. These grounds identify the exact provision held to be unlawful on the one hand and, on the other, indicate the specific reasons for the finding of unlawfulness contained in the operative part, which the institution concerned must take into account when replacing the annulled measure (§ 24-26, 30-31).

The second sentence of Article 94(1) EUTMR in no way requires that, after resuming proceedings before the Office following the annulment of a BoA decision by the GC, the applicant be invited to submit observations again on points of law and fact on which it has already had ample opportunity to express its views during the earlier written procedure, given that the file, as then constituted, has been taken over by the BoA (§ 33-34).

[14/07/2021, T-749/20, VERONESE \(fig.\) / Veronese, EU:T:2021:430, § 24-26, 30-31, 33-34](#)

### 3.2.5 Interruption of proceedings

#### **Article 106(1)(b) EUTMR – Conditions for interruption of proceedings**

According to Article 106(1)(b) EUTMR, proceedings must be interrupted 'in the event of the applicant for, or proprietor of, an EUTM being prevented, for legal reasons resulting from action taken against his property, from continuing the proceedings before the Office'. This cannot extend to applicants for a declaration of invalidity. This strict interpretation is justified by the possibility to ask for *restitutio in integrum* (§ 45).

[06/10/2021, T-635/20, Juvéderm vybrance, EU:T:2021:656, § 45](#)

[06/10/2021, T-636/20, Juvéderm voluma, EU:T:2021:657, § 45](#)

[06/10/2021, T-637/20, Juvéderm volite, EU:T:2021:658, § 45](#)

### 3.2.6 Suspension

#### **Principle – Suspension of the proceedings – BoA's broad discretion – Restricted judicial review**

The right to be heard is not infringed by not giving the party that requests a stay of the opposition the opportunity to reply to the observations on that request, since there is no provision that lays down this possibility (§ 55). Pursuant to Rule 20(7)(c) and Rule 50(1) CTMIR [now Article 71(1) EUTMDR] and also case-law, the BoA has a broad discretion as to whether or not to suspend proceedings (§ 57-58). Any judicial review on its merits is restricted to ascertaining that no manifest error of assessment or misuse of powers has occurred (§ 59).

[16/05/2019, T-354/18, SKYFi /SKY et al., EU:T:2019:33, § 55, 57-59](#)

#### **Manifest error of assessment – Lack of weighing of competing interests**

Within the broad discretion of the BoA as to whether or not to suspend ongoing proceedings, the decision must follow upon a weighing of competing interests (§ 20-21). It is a manifest error of assessment when a request for suspension of opposition proceedings, filed on the ground of initiation of invalidity proceedings, is rejected solely on the basis of the relevant party's failure to identify the prospects of success of the invalidity proceedings and the reasons why those proceedings were not brought at an earlier stage (§ 31).

12/06/2019, T-346/18, [VOGUE / VOGA](#), EU:T:2019:406, § 20-21, 31

### **Manifest error of assessment – Lack of weighing of competing interests – Pending revocation proceedings against the earlier mark**

A suspension is not mandatory when revocation proceedings against the earlier mark are pending (§ 38). It was, however, for the BoA to determine, *prima facie*, the likelihood of success of an application for revocation for the purposes of weighing the competing interests (§ 44). The fact that opposition proceedings may become devoid of purpose does not render the grace period conferred by Article 18(1) EUTMR and Article 57(1)(a) and (2) EUTMR illusory, since that period remains intact during the five years provided (§ 48). The BoA may take into account the stage of the procedure at which the application for suspension was filed and the possible dilatory conduct of the party requesting suspension (§ 51). In that regard, the BoA must examine the circumstances in which the request for suspension has been made (§ 52).

14/02/2019, T-162/18, [ALTUS \(fig.\) / ALTOS et al.](#), EU:T:2019:87, § 38, 44, 51-52

### **No manifest error of assessment – Pending revocation proceedings against the earlier mark**

The BoA has broad discretion to suspend proceedings before it. The scope of judicial review by the Courts of the EU is restricted to ascertaining that no manifest error of assessment or misuse of powers has occurred. The mere fact that revocation proceedings against the earlier mark on which the opposition was based were pending does not suffice to categorise the BoA's refusal to suspend the proceedings as a manifest error of assessment (§ 35-36).

13/06/2019, T-392/18, [Innocenti / i INNOCENTI \(fig\)](#), EU:T:2019:414, § 35-36

### **No manifest error of assessment – *Prima facie* analysis of the likelihood of success of the counterclaim for a declaratory judgment before the German Courts**

The BoA did not commit a manifest error of assessment or misuse of powers in rejecting the request for suspension of the appeal proceedings (§ 134). Taking into account the case-law in the pilot proceedings before the GC and the CJ and also the case-law in the parallel cases before the German courts (Oberlandesgericht Düsseldorf and the Bundesgerichtshof), the BoA did not err in finding that the applicant had not proved that the demarcation agreement conferred on it the right to have EU trade marks registered (§ 131, 132). It was therefore possible to conclude the *prima facie* analysis of the likelihood of success of the counterclaim for a declaratory judgment by asserting that this likelihood had not been established (§ 133).

13/05/2020, T-443/18, [Vogue Peek & Cloppenburg / Peek & Cloppenburg](#), EU:T:2020:184, § 117-120

13/05/2020, T-444/18, [Peek & Cloppenburg](#), EU:T:2020:185, § 124-127

13/05/2020, T-445/18, [Peek & Cloppenburg / Peek & Cloppenburg](#), EU:T:2020:186, § 120-123

13/05/2020, T-446/18, [Peek & Cloppenburg / Peek & Cloppenburg](#), EU:T:2020:187, § 122-125

13/05/2020, T-534/18, [Peek / Peek & Cloppenburg](#), EU:T:2020:188, § 129-131

13/05/2020, T-535/18, [Peek's / Peek & Cloppenburg](#), EU:T:2020:189, § 131-134

### **No manifest error of assessment – No reasoned request for suspension of proceedings**

A mere reference to revocation proceedings that does not contain any explanation cannot satisfy the requirements of Article 71(1) EUTMDR, which requires a reasoned request from one of the parties. The fact that an action for revocation of the earlier mark on which the opposition is based is pending is not, in itself, sufficient to classify the BoA's refusal to stay proceedings as a manifest error of assessment. As regards the applicant's argument that the Office should have stayed the opposition proceedings of its own motion, under Article 71(1) EUTMDR it is for the BoA to decide whether or not to order the stay, and it only exercises that power if it considers it justified (§ 51-53).

01/12/2021, T-359/20, [Team Beverage](#), EU:T:2021:841, § 51-53

### **Failure to state reasons – Pending invalidity proceedings against the earlier mark – Annulment of the OD's decision and remittal of the cases recommending suspension**

The BoA examined the appeals without stating reasons for its final decision not to suspend the proceedings, even though it found that it was appropriate to suspend them on account of invalidity proceedings relating to the earlier marks. It upheld the appeals, annulled the OD's decisions and remitted the cases to OD recommending that it suspend the opposition proceedings until the final decisions were reached concerning the validity of the earlier marks (§ 67, 72).

Respect for the right of the persons concerned to have adequate reasons provided for a decision that affects them is particularly important where that decision stems from a broad discretion, as is the case when the BoA has to decide on the possible suspension of the proceedings before it (§ 73).

The approach, aimed at a delayed application of Article 71(1) EUTMDR, is improper (§ 75). The examination of the question of whether to suspend the appeal proceedings must be carried out first before the examination of whether there is a LOC. If the BoA finds that it is appropriate to suspend the proceedings, it has no other option than suspending them, and may not therefore examine the appeal. Since the BoA had found that it was appropriate to suspend the proceedings, it could not rule on the appeals and was unable to make any recommendation whatsoever to the OD, as any referral of the cases to the latter would mean examining the appeals and would therefore stem from an error of law (§ 76).

28/05/2020, T-84/19 & T-88/19 to T-98/19, [We IntelliGence the World \(fig.\) / DEVICE OF TWO OVERLAPPING CIRCLES \(fig.\) et al.](#), EU:T:2020:231, § 67, 72-73, 75-76

### **Manifest error of assessment – Lack of weighing up of the competing interests of the parties in the proceedings**

The request for a suspension of proceedings cannot be rejected merely because the cancellation action against the earlier mark on which the opposition was based had been brought out of time, that is to say after the filing of the appeal, by pointing out the lack of diligence on the part of the proprietor of the mark applied for (§ 29).

By merely confirming that it weighed up the interests of both parties, without referring to any analysis in that regard, without carrying out a prima facie assessment of the likelihood of success of the application for a declaration of invalidity and without verifying whether that application could have resulted in a decision that would have had an impact on the opposition BoA failed to carry out a weighing up of the parties' competing interests. The mere fact that the parties had the opportunity to present detailed information both before OD and before BoA cannot be considered, in itself, to be the result of a weighing up of the competing interests by the Board of Appeal (§ 32-34).

04/05/2022, T-619/21, [Taxmarc / TAXMAN \(fig.\)](#), EU:T:2022:270, § 29, 32-34

### **Suspension of the proceedings – BoA’s broad discretion**

The BoA has a broad discretion in its assessment of whether to suspend the appeal proceedings. However, in exercising its discretion, the BoA must comply with the general principles governing procedural fairness within a EU governed by the rule of law. The BoA must take into account not only the interests of the party whose EUTM is contested, but also those of the other parties. The decision whether or not to suspend the proceedings must follow upon a weighing of the competing interests (§ 35-37).

[08/11/2022, T-672/21, GRUPA LEW. \(fig.\) / Lew](#)

### **No manifest error of assessment – No automatic suspension of the proceedings – Pending invalidity proceedings against the earlier mark**

Where neither of the parties has submitted a request to suspend the proceedings either before the OD or the BoA, the BoA is not required to examine the issue of a suspension at the parties’ request for the purposes of Article 71(1)(b) EUTMDR (§ 27).

Pursuant to Article 71(1)(a) EUTMDR and according to the case-law, suspension remains an option for the BoA. The BoA suspends the proceedings only where it considers it justified. The existence of parallel proceedings, the outcome of which is liable to have an impact on that of the appeal proceedings, does not automatically result in a suspension and, accordingly, is not a sufficient basis, in itself, to categorise the fact that the BoA refrained from suspending the proceedings as a manifest error (§ 28-29).

[26/04/2023, T-147/22, pinar KURUYEMIS \(fig.\) / Pinar et al., EU:T:2023:213](#)

[26/04/2023, T-148/22, pinar KURUYEMIS \(fig.\) / Pinar et al., EU:T:2023:214](#)

## **3.2.7 Cross appeal**

### **Inadmissible cross appeal – No separate document from the response**

The cross appeal not filed by a document separate from its observations in reply, but following those observations, in the same document is inadmissible (§ 29, 30).

[22/06/2022, T-502/20, Munich10A.T.M. / MUNICH X \(fig.\) et al., EU:T:2022:387](#)

## **3.3 SCOPE OF THE APPEAL**

### **Extent of the appeal – Goods and services**

The BoA is not competent to extend its examination to goods and services which are not subject of the appeal (§ 31). However, where the operative part of the contested decisions is limited to the dismissal of the appeal (§ 26, 32), the statements made in the contested decisions that relate to the examination of goods and services for which the examiner had not raised any objections do not affect the scope of the contested decision (§ 34) The plea alleging infringement of Article 64 CTMR [now Article 71 EUTMR], due to the BoA’s lack of competence to examine goods and services that were accepted by the examiner, is ineffective (§ 35).

[28/03/2019, T-251/17 and T-252/17, \*Simply. Connected. \(fig.\)\*, EU:T:2019:202, § 26, 31-32, 34-35](#)

### **Matters of law for the Office to take into account of its own motion**

In proceedings relating to relative grounds for refusal, a matter of law may have to be ruled on by the Office of its own motion, even when it has not been raised by the parties, if it is necessary to

resolve that matter in order to ensure the correct application of the EUTMR. Therefore, the matters of law put forward before the BoA also include any issue of law that must necessarily be examined for the purpose of assessing the facts and evidence relied on by the parties and for the purpose of allowing or dismissing the claims, even if the parties have not put forward a view on those matters, and even if the Office has omitted to rule on that aspect (§ 31).

28/02/2019, T-459/18, [PEPERO original \(fig.\) / REPRÉSENTATION D'UN BATÔNNET \(fig.\)](#), EU:T:2019:119, § 31

### **Matters of law for the Office to take into account of its own motion**

Under Article 71(1) EUTMR, the BoA has the power to carry out a new, full examination of the merits of the opposition by conducting a new examination of the LOC with the marks that formed part of the subject matter of the proceedings before the OD. It can also decide on earlier rights that were not taken into account by the OD in its decision (§ 71).

16/05/2019, T-354/18, [SKYFi/SKY et al.](#), EU:T:2019:33, § 71

### **Scope of the appeal – BoA’s power to examine essential procedural requirements not raised by the parties – No amendment of the form of order sought – Legitimate expectations**

The power of the BoA to review infringements of essential procedural requirements in the first instance does not mean that it has the power to amend, of its own motion, the form of order sought by an appellant since this approach would disregard the distinction between the pleas in law and the form of order sought in an action. It is the form of order sought that defines the limit of the dispute (§ 24-25).

The applicant’s alleged belief that the decision of the Opposition Division complied with the procedural rules, despite the procedural defect committed by that division, cannot give rise to a legitimate expectation that the decision was formally valid (§ 29).

13/10/2021, T-712/20, [DEVICE OF ARROW WITH WING \(fig.\) / DEVICE OF ARROW WITH WING \(fig.\)](#), EU:T:2021:700, 24-25, 29

### **No examination of absolute grounds in invalidity proceedings based on relative grounds**

It is not incumbent on the Office or the GC, in the context of invalidity proceedings based on relative grounds, to examine whether an earlier national mark is constituted by a shape, which gives substantial value to the product, within the meaning of Article 7(1)(e)(iii) EUTMR (§ 47).

28/02/2019, T-459/18, [PEPERO original \(fig.\) / REPRÉSENTATION D'UN BATÔNNET \(fig.\)](#), EU:T:2019:119, § 47

### **BoA’s right to re-open the examination of absolute grounds**

The BoA has the right to re-open the examination of absolute grounds of refusal on its own initiative at any time before registration, where appropriate, including the right to raise a ground for refusal of the application for registration of the trade mark that has not already been invoked in the decision subject to appeal, Article 45(3) EUTMR and Article 27(1) EUTMDR (§ 21-22).

12/12/2019, T-747/18, [SHAPE OF A FLOWER \(3D\)](#), EU:T:2019:849, § 21-22

### **BoA’s obligation to decide on the limitation of the contested EUTM**

Where a request for limitation of the goods and services which, according to Article 49(1) EUTMR, can be made 'at any time', is filed in the course of the appeal proceedings, the BoA is bound to process this request, irrespective of any decision on the admissibility of the appeal, Article 27(5) EUTMDR (§ 27-30).

07/05/2019, T-629/18, [DARSTELLUNG EINES AUTOS IN EINER SPRECHBLASE \(fig.\)](#), EU:T:2019:292, § 27-30

### **Admissible limitation of goods and services – No extension of the original list of services covered by the earlier national mark**

The limitation of the *retail services* in Class 35 by adding the words *namely clothing, headgear made of textile materials, household linen, bed linen and table linen* (§ 29) clarifies the scope of protection of the German mark insofar as the word 'namely' is exhaustive and limits the scope of protection only to the specifically listed goods or services (§ 30). The German term 'Textilien' refers not only to textile materials, fabrics and textiles, but also to 'clothing' and 'products made from textiles'. Therefore, that term refers to goods such as *clothing, headgear made of textile materials, household linen, bed linen and table linen*, so the addition is a limitation and not an extension or amendment of the original list of services covered by the earlier national mark (§ 31).

08/07/2020, T-659/19, [kix \(fig.\) / kik](#), EU:T:2020:328, § 30-31

### **Cross-appeal ancillary to the appeal before the BoA**

Where the claims of a party to opposition proceedings have been rejected in part, that party can either file an (independent) appeal against the decision of the OD, under Articles 66 and 67 EUTMR, or make incidental submissions seeking the annulment or alteration of that decision on a point not raised during the appeal, under Article 8(3) of Regulation No 216/96 (Rules of Procedure of the BoA) (§ 14). In the latter case, in the event of discontinuance of the proceedings, its capacity to take part in legal proceedings is inextricably linked to the intentions of the other party that brought the action before the BoA (§ 15).

The action brought before the GC by the party that made incidental submissions against the decision is necessarily linked, procedurally, to the other party's appeal against the decision of the OD, insofar as the BoA has ruled on the OD's decision. Furthermore, an appeal, brought within the prescribed periods, leads to the suspension of the taking effect of the BoA decisions, under Article 71(3) EUTMR (§ 17).

Therefore, the GC did not err in law in finding that it was still possible for the other party to withdraw its appeal before the BoA, and that this withdrawal meant, as a result, that the BoA was no longer required to rule on the incidental submissions (§ 18).

10/07/2019, C-170/19P, [Cheapflights \(fig.\) / Cheapflights \(fig.\)](#), EU:C:2019:581, § 15, 17, 18

### **Scope of Appeal – Invalidity action based on several grounds**

EUIPO is not required to base the rejection of the trade mark application on all the grounds for refusal of registration put forward in support of the opposition or the invalidity action, on the basis of which a trade mark application could be rejected. Neither Article 71 EUTMDR nor Article 27 EUTMDR imposes any such obligation on the BoA (§ 19).

When the BoA re-examines the dispute by virtue of the devolutive effect, it is entitled not to re-examine all the grounds and arguments put forward in support of the application for a declaration of invalidity that were capable of justifying its decision, given that it had found, on the same basis as the CD, the existence of a relative ground for invalidity which was sufficient to confirm the invalidity decision (§ 22).

**Scope of the appeal – Matters of law which must be examined by EUIPO – Re-examination by the BoA – Comparison of goods and services under Article 8(1)(b) EUTMR**

Although under Article 95(1) EUTR the BoA's examination is to be restricted to the facts, evidence and arguments provided by the parties, it nevertheless follows from Article 27(2) EUTMDR that matters of law not raised by the parties may be examined by the Board of Appeal where it is necessary to resolve them in order to ensure a correct application of the EUTMR having regard to the facts, evidence and arguments provided by the parties (§ 35). As a global assessment of LOC implies, in particular, the similarity of the trade marks and that of the goods or services covered, the BoA was required, in order to ensure the correct application of Article 8(1)(b) EUTMR relied on by the applicant, to examine the similarity and the degree of similarity of the goods at issue, even in the absence of specific arguments put forward by the parties in relation to that aspect (§ 36). According to settled case-law, the criteria for applying a relative ground for refusal or any other provision relied on in support of arguments put forward by the parties are part of the matters of law submitted for examination by EUIPO (§ 37, 38, 40).

[22/09/2022, T-624/21, primagran \(fig.\) / PRIMA \(fig.\) et al.](#)

**Scope of the appeal – Matters of law which must be examined by EUIPO – Re-examination by the Board of Appeal – Comparison of goods and services and comparison of signs under Article 8(1)(b) EUTMR**

In the context of opposition proceedings based on Article 8(1)(b) EUTMR, the assessment of the similarity of the goods at issue and of the signs at issue constitute matters of law which are necessary to ensure the correct application of that regulation, with the result that the adjudicating bodies of EUIPO are required to examine those matters, if necessary of their own motion. As that assessment does not presuppose any matter of fact which it is for the parties to provide and does not require the parties to provide grounds or arguments tending to establish the existence of those similarities, EUIPO is able, on its own, to detect and assess the existence thereof having regard to the earlier mark on which the opposition is based (§ 24).

[19/10/2022, T-437/21, GREENWICH POLO CLUB \(fig.\) / Beverly hills polo club et al., EU:T:2022:643](#)

**Scope of the appeal – Issue of nature of use of the earlier mark raised in the statement of grounds – Matters of law which must be examined by BoA – Place, time, extent and nature of use**

The BoA is not required to respond to arguments that are not raised in the statement of grounds (§ 49). Where the OD concludes that proof of genuine use of the earlier mark has been provided and, accordingly, upholds the opposition, the BoA may examine the question of that proof only if the applicant for the mark raises it specifically in its appeal (§ 51). However, an issue of law may have to be ruled on by the EUIPO even where it has not been raised by the parties if it is necessary to resolve that issue in order to ensure the correct application of the EUTMR (§ 54). Proof of use must relate to the place, time, extent and nature of use of the earlier mark, and those requirements concerning proof of use of the earlier mark are cumulative, with the result that, if one of those criteria is not satisfied, genuine use of the earlier mark cannot be regarded as having been demonstrated (§ 55).

The issue of proof of genuine use was raised before the BoA since the EUTM applicant challenged the OD's assessment that there had been no alteration of the distinctive character of the earlier mark in its registered form, which concerns the nature of use and which is one of the conditions required in order to demonstrate genuine use of the earlier mark (§ 52). Hence, the BoA was

required to examine the other conditions relating to proof of use, insofar as that issue was before it (§ 56).

[08/03/2023, T-372/21, Sympathy Inside / Inside., EU:T:2023:111](#)

### **Scope of Appeal – Inadmissible request to set an earlier date than the filing date of the application for revocation**

Since, in the statement of grounds before the Board of Appeal, the appellant only sought annulment of the CD's decision insofar as it had rejected the application for revocation in respect of some of the goods, the CD's decision has become final with regard to the goods for which the revocation was upheld. Consequently, the applicant's request to set an earlier date than the filing date of the application for revocation was inadmissible (§ 20-24).

[26/07/2023, T-638/21, DEVICE OF THE OUTLINE OF A BEAR \(fig.\), EU:T:2023:434](#)

### **Scope of the appeal – Matters of law which must be examined by EUIPO – Re-examination by the BoA**

Where Article 8(1)(b) EUTMR is invoked, the BoA is entitled to examine, as a matter of law and of its own motion, the similarity of the goods and the signs, including the examination of the elements of the signs (§ 27-31).

[13/09/2023, T-328/22, EST. KORRES 1996 HYDRA-BIOME \(fig.\) / Hydrabio et al., EU:T:2023:533](#)

## **3.4 ESSENTIAL PROCEDURAL REQUIREMENTS**

### **3.4.1 Right to be heard**

#### **Scope of the principle**

The right to be heard for the purposes of Article 94(1) EUTMR extends to the factual and legal matters on which the decision-making act is based, but not to the final position that the authority intends to adopt (07/09/2006, T-168/04, Aire limpio, EU:T:2006:245, § 116) (§ 27).

[26/03/2020, T-653/18, GIORGIO ARMANI le Sac 11 \(fig.\) / LESAC et al., EU:T:2020:121, § 27](#)  
[26/03/2020, T-654/18, le Sac 11 \(fig.\) / LESAC et al., EU:T:2020:122, § 27](#)

#### **Scope of the principle – No need for further observations after annulment by the GC/CJ**

The second sentence of Article 94(1) EUTMR in no way requires that, upon the resumption of proceedings before the Office after the annulment of the BoA decision by the GC, the parties be invited again to submit observations on points of law and fact on which they already had ample opportunity to express their views in the course of the written procedure previously conducted, given that the file as then constituted has been taken over by the BoA (03/02/2017, T-509/15, Premeno / Pramino, EU:T:2017:60, § 26 and case-law cited) (§ 50).

[28/04/2021, T-509/19, Flügel / ... Verleiht Flügel et al., EU:T:2021:225, § 50](#)

#### **Scope of the principle – Article 62 CDR**

The right to be heard, as enshrined in Article 62 CDR, extends to all the matters of fact or of law which form the basis of the decision, but not to the final position which the authority intends to adopt (09/02/2017, T-16/16, BECHER, EU:T:2017:68, § 57) or to each well-known fact on which

it relies in order to arrive at that position (01/06/2016, T-34/15, CHEMPIOIL / CHAMPION et al., EU:T:2016:330, § 83) (§ 15).

29/04/2020, T-73/19, [wood splitting tools](#), EU:T:2020:157, § 15

### **Scope of the principle – Well-known fact**

An infringement of the right to be heard cannot be invoked with respect to well-known facts (§ 74). The right to be heard is not infringed where the concerned party is not invited by the BoA to put forward its arguments on observations that do not bring any new argument and are limited only to answering the notice of appeal (§ 78). Neither is it infringed if the observations do not form the basis of the decision, but are merely of an illustrative nature (§ 84). The BoA's conclusion could stand on the basis of practical experience alone, without requiring the supporting evidence on which the EUTM proprietor claims it was not heard (§ 85).

29/03/2019, T-611/17, [REPRESENTATION D'UNE SEMELLE DE CHAUSSURE \(3D\)](#), EU:T:2019:210, § 74, 78, 84-85

### **Scope of the principle – Well-known fact**

The right to be heard is not infringed if the contested decision is based on information and on the content of a website (i.e. an online dictionary) that had not been communicated to the party other than in the form of an internet link, where the content of the website corresponds precisely to the definitions given by the examiner and the meaning of the terms constitutes a well-known fact (§ 17-18). Since the web pages were still accessible and their content had not changed in relation to the content cited by the examiner, the issue of not being able to access the content, or changes to it (07/02/2007, T-317/05, Guitar, EU:T:2007:39) does not arise (§ 19-21).

23/05/2019, T-439/18, [ProAssist](#), EU:T:2019:359, § x

### **Scope of the principle – Well-known fact**

The use by the BoA of dictionary definitions to clarify the meaning of the words composing the sign cannot be regarded as a reason on which the applicant should have had an opportunity to present its comments, within the meaning of Article 94 CTMR [now Article 94 EUTMR], even though such definitions were not mentioned in the examiner's decision, (§ 29).

12/03/2019, T-463/18, [SMARTSURFACE](#), EU:T:2019:152, § 29

### **Infringement of the right to effectively submit observations before the BoA**

An infringement of the right of defence entails the annulment of the contested decision if, in the absence of that procedural irregularity, it is shown that there was even a slight chance that the applicant would have been better able to defend himself (§ 48).

After annulment of the contested decision and referral of the case back to the BoA, the opponent was misled by the chairperson's invitation to comment on the consequences to be drawn from the GC judgments and, notably, by the indication that the communication was not an invitation to submit additional documents at that stage of the proceedings. The communication therefore had an influence on the content of the opponent's views and on the way in which he submitted them (§ 37). In the case of submission of additional evidence, the BoA would have had to exercise its discretion (§ 38). Therefore, the opponent's right to effectively submit his views before the BoA had been infringed (§ 35-37).

14/05/2019, T-89/18 and T-90/18, [Café del Sol / Café del Sol \(fig.\) et al.](#), EU:T:2019:331, § 35-38, 48

### **Infringement of the right to be heard – The Office’s obligation to obtain information about national law invoked under Article 8(4) EUTMR**

The obligation of the Office to obtain information *ex officio* about the national law invoked under Article 8(4) EUTMR by all means available to it in relation to its power of verification should have been better reconciled with the obligation under Article 94(1), second sentence, EUTMR (the right to be heard). By failing to invite the opponent to take a position on an important provision of the Bulgarian Law on Marks and Geographical Indications, which had a decisive impact on the outcome of the dispute, the BoA infringed the opponent’s right to be heard (§ 51-52).

25/11/2020, T-57/20, [GROUP Company TOURISM & TRAVEL \(fig.\)-GROUP Company TOURISM & TRAVEL \(fig.\)](#), EU:T:2020:559, § 51-52

### **No infringement of the right to be heard – *Audi alteram partem* rule – Failure to request authorisation to submit a reply according to Article 26(1) EUTMDR**

Where the appellant failed to request authorisation to submit a reply according to Article 26(1) EUTMDR, as a means available to it in order to submit its observations on the new arguments and evidence adduced by the other party in its response, it cannot be alleged that the BoA deprived the appellant of the opportunity to comment on the evidence adduced for the first time before the BoA and thereby vitiated the administrative procedure, in breach of the *audi alteram partem* rule and the right to be heard (§ 86-89).

16/06/2021, T-215/20, [HYAL](#), EU:T:2021:371, § 86-89

### **No infringement of the right to be heard – Application of case-law**

The BoA is under no obligation under the second sentence of Article 94(1) EUTMR or Article 95(1) EUTMR to inform the applicant regarding the case-law on which it intended to rely in its findings (§ 92).

30/06/2021, T-531/20, [ROLF \(fig.\) / Wolf et al.](#), EU:T:2021:406, § 92

### **No infringement of the right to be heard – No duty to inform about evidence to submit for the substantiation of arguments**

The right to be heard set out in the second sentence of Article 94(1) EUTMR requires that decisions of the Office be based only on reasons on which the parties have had an opportunity to present their views. However, this right does not mean that the Office informs the parties what evidence they have to submit in order to substantiate their arguments (§ 87).

17/11/2021, T-298-19, [FORM VON ROTEN SCHNÜRSENKELENDEN \(Posit.\)](#), EU:T:2021:792, § 87

### **No infringement of the right to be heard – Article 72(6) EUTMR – Resumption of proceedings before the BoA after the annulment of a previous decision by the GC**

In order to comply with a judgment annulling a measure and to implement it fully, the institution responsible for adopting that measure must have regard not only to the operative part of the judgment but also to the grounds constituting its essential basis, insofar as they are necessary for determining the exact meaning of what is stated in the operative part. These grounds identify the exact provision held to be unlawful on the one hand and, on the other, indicate the specific reasons for the finding of unlawfulness contained in the operative part, which the institution concerned must take into account when replacing the annulled measure (§ 24-26, 30-31).

The second sentence of Article 94(1) EUTMR in no way requires that, after resuming proceedings before the Office following the annulment of a BoA decision by the GC, the applicant be invited

to submit observations again on points of law and fact on which it has already had ample opportunity to express its views during the earlier written procedure, given that the file, as then constituted, has been taken over by the BoA (§ 33-34).

14/07/2021, T-749/20, [VERONESE \(fig.\) / Veronese](#), EU:T:2021:430, § 24-26, 30-31, 33-34

### **No infringement of the right to be heard – Functional continuity between the first instance and the BoA**

According to Article 71(1) EUTMR, enshrining the principle of functional continuity, the BoA is under no obligation to remit the case to the OD for a decision on new factors (such as the limitation of the list of services covered by the earlier mark) liable to alter the outcome of the case (§ 34). Where the parties have had the possibility to submit their observations on the comparison of services and the limitation of the scope of protection of the earlier rights after the OD's decision, the right to be heard is not infringed (§ 35).

08/07/2020, T-659/19, [kix \(fig.\) / kik](#), EU:T:2020:328, § 35

### **Infringement of the right to be heard – BoA's statement on proof of genuine use for period not discussed by the parties – CD's error in calculating the relevant periods**

There is no obligation for the CD to determine the relevant periods for the proof of genuine use (§ 33). If the BoA finds an error by the CD in calculating the relevant periods, it cannot base its decision on a lack of genuine use of the earlier marks for a period, which was never discussed by the parties and on which they had no opportunity to comment or to submit evidence at any stage of the proceedings before the Office (§ 39).

20/03/2019, T-138/17, [PRIMED / GRUPO PRIM \(fig\) et al.](#), EU:T:2019:174, § 33, 39

### **No infringement of the right to be heard – Procedure for suspension of the proceedings**

The right to be heard is not infringed by not giving the party that requests a stay of the opposition proceedings the opportunity to reply to the observations on a request for suspension, since there is no provision that lays down this possibility (§ 55).

16/05/2019, T-354/18, [SKYFi /SKY et al.](#), EU:T:2019:33, § 55

### **No infringement of the right to be heard – Confidential information vis-à-vis third parties – Scope of the right to be heard**

Article 88(4) CTMR, read in conjunction with Rule 88(c) CTMIR [now Article 114(4) EUTMR], concerns the non-disclosure of certain documents or items of business information considered to be confidential vis-à-vis third parties and not vis-à-vis parties to proceedings before the Office (§ 27-28).

The Office's decisions are to be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments, (Article 75 CTMR and Article 63(2) CTMR [now Article 94 EUTMR and Article 70(2) EUTMR]) (§ 33-34). The right to be heard is not infringed when the party is in a position to present its comments on all the matters of fact and of law that form the basis of the contested decision (§ 37-39).

05/03/2020, T-80/19, [DECOPAC](#), EU:T:2020:81, § 27-28, 37-39

### **Scope of the right to a 'fair hearing' enshrined in Article 6 ECHR – Right to be heard**

The right to a 'fair hearing', enshrined in Article 6 ECHR, does not apply to proceedings before the BoA since these are administrative and not judicial in nature (11/07/2013, T-197/12, Metro, EU:T:2013:375, § 54) (§ 24).

28/05/2020, T-564/19, [Libertador](#), EU:T:2020:228, § 24

### **Infringement of rights of defence – Impact on contested decision**

A violation of the rights of defence (right to be heard) does not require showing that the decision would have been different. It is sufficient to prove that such a possibility cannot be ruled out (§ 28).

20/03/2019, T-138/17, [PRIMED / GRUPO PRIM \(fig\) et al.](#), EU:T:2019:174, § 28

### **Right of defence – No bearing on the outcome**

The rights of the defence are infringed by reason of a procedural irregularity only in so far as the irregularity actually has an effect on the ability of the undertakings involved in the dispute to defend themselves. Non-compliance with rules in force whose purpose is to protect the rights of the defence can vitiate the administrative procedure only if it is shown that the procedure could have had a different outcome if the rules had been observed (§ 27).

06/04/2022, T-370/21, [Nutrifem agnubalance / Nutriben](#), EU:T:2022:215, § 27

### **No infringement of the right to be heard – Oral proceedings – Hearing of witnesses**

Although EUIPO may hold oral proceedings, a refusal is vitiated by manifest error only if it is shown that EUIPO did not have all the necessary information (§ 159, 160). As regards the refusal to hear witnesses, there is no manifest error where the statements could be given in writing and, a fortiori, where those statements have been submitted (§ 163-165).

27/04/2022, T-327/20, [Shower drains](#), EU:T:2022:263, § 159, 160, 163-165

### **No infringement of the right to be heard – Ex officio examination by BoA – Comparison of goods not compared by OD**

Through the effect of the appeal before it, the BoA are called upon to carry out a full re-examination of the merits of the opposition, in both law and fact (§ 18). Thus the BoA has the power to carry out of its own motion a full review of the merits of the opposition and may proceed to compare the goods as they see fit, even where OD concerned did not consider it necessary to make that comparison (§ 19). The applicant could have submitted additional arguments that it considered relevant in respect of all the goods which were the subject of the opposition, at the appeal stage even if the BoA did not specifically invite it to do so (§ 24).

11/05/2022, T-93/21, [SK SKINTEGRA THE RARE MOLECULE \(fig.\) / Skintegrity et al.](#), EU:T:2022:280, § 18, 19, 24

### **Right to be heard – Errors in the assessment of evidence**

The question whether BoA erred in its assessment of the evidence produced by the applicant by considering trade mark registrations which are in fact design registrations, is an issue which relates not to the right to be heard or to the reasoning of the contested decision, but to the merits of that decision (§ 38).

04/05/2022, T-117/21, [DEVICE OF TWO CROSSED STRIPES PLACED ON THE SIDE OF A SHOE \(fig.\)](#), EU:T:2022:271, § 38

### **Ineffective plea – Infringement of the right to be heard – No bearing on the outcome**

The applicant's claim regarding an infringement of its right to be heard by the BoA pursuant to Article 94(1) EUTMR is ineffective. The administrative procedure can only be vitiated by an error due to such an irregularity if it is shown that it might otherwise have led to a different result (§ 74).

[07/12/2022, T-747/21, Fohlenelf, EU:T:2022:773](#)

### **No infringement of the right to be heard – No bearing on the outcome**

Any failure on the part of the BoA to comply with the applicant's right to be heard as regards the relevant public's understanding of the symbol 'Λ' present in the contested mark – if there were such a failure in this instance – did not have any bearing on the outcome in this case. Consequently, it cannot be held that the BoA infringed the applicant's right to be heard (§ 82-83).

[13/09/2023, T-473/22, LAAVA \(fig.\) / Lav \(fig.\) et al., EU:T:2023:543](#)

### **Oral proceedings – Discretion of the BoA**

Where a party requests that oral proceedings be organised, the BoA has the discretion to decide whether they are necessary. Where the request for oral hearing is based on the contradictory nature of affidavits, but such contradictory nature is not proved, the BoA does not infringe Article 96(1) EUTMR in refusing to hold a hearing (§ 71-74).

[06/03/2024, T-59/23 & T-68/23, DEC FLEXIBLE TECHNOLOGIES \(fig.\), EU:T:2024:148](#)

## **3.4.2 Duty to state reasons**

### **Principle – Article 94(1) EUTMR**

The obligation to state reasons according to Article 94(1) EUTMR has the same scope as that which derives from Article 296 TFEU. It is settled case-law that the statement of reasons required by Article 296 TFEU must disclose, in a clear and unequivocal manner, the reasoning followed by the institution that adopted the measure in question in such a way as to enable the persons concerned to ascertain the reasons for the measure and to enable the court having jurisdiction to exercise its power of review (§ 25).

[13/06/2019, T-75/18, MANUFACTURE PRIM 1949 \(fig.\), EU:T:2019:413, § 25](#)

#### **3.4.2.1 Scope of the duty to state reasons**

##### **Scope of the duty to state reasons – Facts and legal considerations of decisive importance**

The purpose of the obligation to state reasons is twofold: to enable the parties concerned to ascertain the reasons for the measure in order to defend their rights, and to enable the competent European court to exercise its power of review of the legality of the decision. However, in stating the reasons for their decisions, the BoA are not obliged to take a view on every argument that the parties have submitted to them. It is sufficient that they set out the facts and legal considerations having a decisive importance in the context of the decision (§ 41).

[11/09/2019, T-649/18, transparent pairing, EU:T:2019:585, § 41](#)

##### **Functional continuity between the first instance and the BoA**

When the BoA confirms some aspects of the first instance decision, and given the functional continuity between the first instance and the BoA, that decision, together with the statement of

reasons pertaining to those aspects, forms part of the context in which the BoA decision was adopted, a context which is known to the parties and enables the Court to carry out fully its review as to whether the BoA's assessment was well founded (§ 19).

06/02/2020, T-135/19, [LaTV3D / TV3](#), EU:T:2020:36, § 19

### **Scope of the duty to state reasons – Article 94(1) EUTMR – Implicit reasoning**

The reasoning of a decision may be implicit, on the condition that it enables the persons concerned to know the reasons for the BoA's decision and provides the competent Court with sufficient material for it to exercise its power of review (12/03/2020, T-321/19, *Jokers WILD Casino* (fig.), EU:T:2020:101, § 15-17 and case-law cited) (§ 21).

24/03/2021, T-354/20, [Representation of a fish \(fig.\) / Blinka](#), EU:T:2021:156, § 21

### **Scope of the duty to state reasons – No obligation to provide concrete examples – Well-known fact**

It is not the BoA's responsibility to provide concrete examples of the generally acquired practical experience of the marketing of products on which it based its assessment (§ 21).

28/03/2019, T-829/17, [RAPPRESENTAZIONE DI UNA FORMA CIRCOLARE, FORMATA DA DUE LINEE OBLIQUE SPECULARI E LEGGERMENTE INCLINATE DI COLORE ROSSO](#) (fig.), EU:T:2019:199, § 21

### **Scope of the duty to state reasons – Evidence not mentioned in the BoA's decision**

Just because the BoA did not mention a particular document in the contested decision does not mean that the BoA did not consider that document (§ 70).

20/01/2021, T-656/18, [MANUFACTURE PRIM 1949 \(II\)](#), EU:T:2021:17, § 70

### **Exception to the obligation to examine (as a preliminary matter) proof of genuine use of an earlier mark – Article 94 EUTMR – No contradiction or failure to state reasons**

Where there is no LOC between the signs, it is not necessary to examine proof of use of the earlier mark as a preliminary step before the analysis of the similarity of the signs (§ 24-25). The Office and the Court can carry out a comparison of the signs by taking into consideration a situation which is fictitious but close to reality, determining a hypothetical relevant public having regard to the goods and services in respect of which the earlier mark can be deemed to be registered (15/02/2005, T-296/02, *Lindenhof*, EU:T:2005:49, § 49-68) (§ 26). However, where the BoA considers that the differences between the marks are not sufficient to rule out the existence of a LOC on the part of the relevant public, the preliminary examination of genuine use of the earlier mark has to be carried out (§ 30, 58, 61).

28/04/2021, T-300/20 [Accusi-Acústic \(fig.\) et al](#), EU:T:2021:223, § 24-26, 30, 58, 61

### **Scope of the duty to state reasons – Decisions implying a broad discretion – Failure to state reasons regarding the suspension of the proceedings**

Respect for the right of the persons concerned to have adequate reasons provided for a decision that affects them is particularly important where that decision stems from a broad discretion, as is the case when the BoA has to decide on the possible suspension of the proceedings before it (§ 73).

28/05/2020, T-84/19 & T-88/19 to T-98/19, [We Intelligence the World \(fig.\) / DEVICE OF TWO OVERLAPPING CIRCLES \(fig.\) et al.](#), EU:T:2020:231, § 67, 72-73, 75-76

### **Scope of the duty to state reasons – Confirmation of a lower-level decision in its entirety**

Where the BoA confirms a lower-level decision of the Office in its entirety, that decision together with its statement of reasons forms part of the context in which the BoA's decision was adopted, which is known to the parties and enables the EU judicature to carry out fully its judicial review as to whether the BoA's assessment was well founded (§ 79).

The institutions are not obliged, when stating the reasons for the decisions which they are called on to make, to take a view on every argument that the parties have submitted to them. It is sufficient if they set out the facts and legal considerations having decisive importance in the context of the decision (§ 82).

30/06/2021, T-531/20, [ROLF \(fig.\) / Wolf et al.](#), EU:T:2021:406, § 79, 82

### **Scope of the duty to state reasons – BoA decision taken following annulment of an earlier decision by the GC – Reference to the grounds of that earlier annulled decision – Not permissible**

A judgment annulling a measure takes effect *ex tunc*, retroactively eliminating the annulled measure from the legal system. Thus, that initial decision does not exist in the EU legal order and can therefore have no effect (§ 200). Consequently, that initial decision does not form part of the legal context in the light of which the statement of reasons of the decision subsequently adopted by the BoA to implement that judgment must be assessed (§ 201).

Where, on an appeal against a decision of the BoA, the Court finds that the BoA's assessment is invalid, it must annul that decision in its entirety, even if it is only invalid for one of the grounds of opposition relied on (§ 207). In such a situation, when providing the basis for the operative part of the decision subsequently adopted to implement the judgment annulling the initial decision, the BoA is not permitted to reject all the grounds of opposition relied on by referring, for certain ones of those grounds, to the reasoning of the initial decision without examining and rejecting each of the grounds of opposition (§ 203).

23/09/2020, T-796/16, [Grass in bottle / Bottle with strand of grass et al.](#), EU:T:2020:439, § 200-203

### **Duty to state reasons – Difference between the failure to state reasons or inadequacy of the reasons given and the plea alleging inaccuracy of the reasons given**

The issue whether certain premiss on which BoA decision is based is incorrect or whether BoA erred in its assessment of the evidence produced by the applicant are issues which do not fall within the scope of the statement of reasons for the contested decision, but rather the merits of that decision (§ 26).

04/05/2022, T-117/21, [DEVICE OF TWO CROSSED STRIPES PLACED ON THE SIDE OF A SHOE \(fig.\)](#), EU:T:2022:271, § 26

### **Duty to state reasons**

The duty to state reasons does not require the BoA to deal exhaustively with all the arguments put forward by the parties one after the other in their submissions. It is sufficient if they present the facts and legal considerations which are of fundamental importance to the structure of the decision (§ 17).

26/10/2022, T-621/21, [BLAU](#), EU:T:2022:676

### **Duty to state reasons – Difference between the failure to state reasons and the plea alleging inaccuracy of the reasons given**

The reasoning of a decision consists in a formal statement of the grounds on which that decision is based. If those grounds are vitiated by errors, the latter will vitiate the substantive legality of the decision, but not the statement of reasons in it, which may be adequate even though it sets out reasons which are incorrect (§ 50).

[09/11/2022, T-639/21, CCB / CB \(fig.\) et al., EU:T:2022:698](#)

### **Scope of the duty to state reasons**

The duty to state reasons does not require the BoA, in their reasoning, to deal exhaustively with all the arguments put forward by the parties in turn. It is sufficient if the statement of reasons includes facts and legal consideration of major importance, and it enables the parties to know the reasons for the decision while it gives the competent court sufficient information to enable it to exercise its power of review. The obligation to state reasons is an essential procedural requirement which must be distinguished from the merits of the statement of reasons, which is a matter of the substantive legality of the disputed act. The reasoning of a decision consists in formally expressing the grounds on which the decision is based. If those grounds are vitiated by errors, those errors affect the substantive legality of the decision, but not the statement of reasons for the decision, which may be sufficient while expressing erroneous grounds (§ 24-27).

[23/11/2022, T-701/21, Cassellapark, EU:T:2022:724](#)

### **Scope of the duty to state reasons**

The BoA cannot be required to provide a statement of reasons which would exhaustively follow one by one all the arguments put forward. The statement of reasons may be implicit, provided that it enables the parties concerned to know the reasons for which the decision was adopted and the court to have sufficient information to carry out its review (§ 51). The BoA set out a clear and comprehensible reasoning for the assessment of the descriptive character of the contested mark, through the presentation of the relevant statutory provisions and case-law, the determination of the relevant public, and the detailed analysis of the relationship between the verbal sign and the goods at issue (§ 52). The BoA was not required to respond to all of the applicant's arguments (§ 53).

[16/12/2022, T-751/21, Airflow](#)

### **No failure to state reasons**

The fact that the BoA did not comment exhaustively on all the examples of earlier registrations invoked by the EUTM applicant cannot be regarded as a failure to state reasons (§ 82).

[21/12/2022, T-777/21, ECO STORAGE \(fig.\), EU:T:2022:846](#)

### **Scope of the duty to state reasons – Standard for justification of dissimilarity of goods**

The BoA held that the goods in question were different in nature and in the intended purpose. It added that those goods did not share the same distribution channels and that they were neither in competition nor complementary. Those grounds refer to the requisite legal standard to the relevant factors in order to characterise the relationship between the goods at issue. There is no requirement for the BoA to expressly mention the supposed proximity of the market segments to which the goods at issue belong. By not doing so, the BoA did not vitiate its assessment of a failure to state reasons (§ 23, 24).

### **No failure to state reasons – Endorsement of the first instance’s decision**

The BoA was entitled to confine itself, in the contested decision, to endorsing the uncontested grounds of the OD’s decision, and to setting out the grounds on which it confirmed the contested grounds (§ 62). When the BoA upholds the decision of the OD on certain points, and taking into account the continuity in terms of function between the OD and the BoA, that decision, together with its statement of reasons, forms part of the context in which the BoA’s decision was adopted. This context is known to the parties and enables the GC to fully carry out its review as to whether the BoA’s assessment was well founded (§ 60).

[08/03/2023, T-372/21, Sympathy Inside / Inside., EU:T:2023:111](#)

### **Implicit endorsement of the first instance’s assessment – Identification of the relevant public**

By reproducing, in the summary of the facts of the BoA decision, the OD’s assessment that the goods at issue were aimed at the general public with an average level of attention, the BoA implicitly, but necessarily, endorsed the OD’s assessment as regards the relevant public and its level of attention, in spite of the lack of any express finding in that regard in the BoA’s decision (§ 31).

[22/03/2023, T-5/22, DEVICE OF A CHEVRON \(fig.\) / DEVICE OF A STRIPE \(fig.\) et al., EU:T:2023:150](#)

### **No failure to state reasons – Erroneous instruction on the right of appeal**

An erroneous instruction on the right of appeal (reference to the provision of Article 75 EUTMR instead of Article 72 EUTMR) does not constitute a breach of law which could lead to the annulment of the decision containing that defect, in particular where, despite the lack of information on the right of appeal, the applicant has validly brought an action before the GC against that decision (§ 22).

[17/05/2023, T-267/22, Acasa, EU:T:2023:268](#)

### **No failure to state reasons – Clerical error**

A clerical error, which does not prevent the parties from correctly understanding the BoA’s reasoning, cannot lead to the annulment of the BoA’s decision (§ 23).

[17/05/2023, T-267/22, Acasa, EU:T:2023:268](#)

### **No failure to state reasons by reference to another document**

The obligation to state reasons can be complied with by reference to another document provided that it enables the persons concerned to know the reasons for the decision at hand and provides the competent court with sufficient material for it to exercise its power of review (§ 40). Although the evidence on which the BoA has based its findings is not expressly identified in the contested decision, the latter (i) refers to the observations of third parties of which the parties had the opportunity to become acquainted (ii) contain sufficiently precise, quantified and consistent information (§ 41-43).

[24/05/2023, T-2/21, Emmentaler, EU:T:2023:278](#)

### **No failure to state reasons – Joint examination of Articles 7(1)(b) and (c) EUTMR – Endorsement of the first instance’s decision**

By finding that the contested sign was distinctive and that, therefore, it was also not descriptive, and by making reference to the reasoning and findings of the CD, the BoA complied with its duty to state reasons insofar as both provisions invoked were concerned (§ 22-23).

[07/06/2023, T-735/21, DEVICE OF A STYLISED DEPICTION OF A BLACK BAT INSIDE A WHITE OVAL FRAME \(fig.\), EU:T:2023:304](#)

### **No failure to state reasons – Confidential submissions – General summary of confidential data in the decision**

No illegality can be inferred from the mere fact that the BoA indicated in the decision on objection that, due to the request for confidentiality, it would confine itself to a general and summarised description of the said observations without disclosing any commercial data (§ 26). There is, in particular, no breach of the duty to state reasons, as the description allows the parties to understand the reasons for the decision (§ 27).

[07/06/2023, T-239/22, Rialto, EU:T:2023:319](#)

### **No failure to state reasons – Endorsement of the first instance’s decision**

Given the continuity in terms of function between the OD and the BoA – to which Article 71(1) EUTMR attests – when the BoA confirms a decision of the OD on certain points, that decision, together with its statement of reasons on such points, forms part of the context in which the BoA’s decision was adopted; a context that is known to the parties and enables the GC to carry out its review fully on the merits of the assessment by the BoA (§ 53).

[13/09/2023, T-167/22, Tmc transformers / TMC \(fig.\) et al., EU:T:2023:535](#)

See also, [13/09/2023, T-163/22, TMC TRANSFORMERS \(fig.\) / TMC \(fig.\) et al., EU:T:2023:534, § 54](#)

### **Functional continuity between the first instance and the BoA – Determination of the distinctive and dominant elements**

Given that the BoA endorsed the decision of the OD in its entirety and having regard to the functional continuity between the OD and the BoA, the statement of reasons contained in the OD decision regarding the distinctive and dominant elements of the signs must be taken into account when assessing the legality of the BoA’s decision (§ 46).

[08/11/2023, T-592/22, Liquid+Arcade / LIQUIDO \(fig.\), EU:T:2023:708](#)

### **Functional continuity between the first instance and the BoA – Mark with reputation – Determination of the degree of similarity between the signs**

Although it is true that the BoA did not expressly specify in the contested decision the degree of similarity between the signs, given the functional continuity between the OD and the BoA, the degree of similarity stated in the OD decision was implicitly but necessarily confirmed by the Board of Appeal and formed part of the context in which the BoA decision was adopted (§ 62-64).

[15/11/2023, T-677/22, imaster.golf \(fig.\) / MASTERS et al., EU:T:2023:720](#)

### **Scope of the duty to state reasons – References to previously registered trade marks**

The EUIPO is not obliged to expressly analyse all the previously registered marks invoked and to provide detailed arguments for each of them (§ 44).

[20/12/2023, T-189/23, \*my mochi \(fig.\)\*, EU:T:2023:853](#)

### **No failure to state reasons**

The obligation to state reasons, an obligation which is incumbent on the BoA and which stems from, inter alia, Article 94(1) EUTMR, has been the subject of settled case-law according to which the statement of reasons must disclose in a clear and unequivocal manner the reasoning followed by the institution that adopted the measure in question. The obligation to state reasons does not require the BoA to provide an account that follows exhaustively and one by one all the lines of reasoning articulated by the parties before them. It is sufficient that it set out the facts and the legal considerations having decisive importance in the context of the decision. The obligation to state reasons is an essential procedural requirement, which must be distinguished from the question as to whether the reasons given are correct, which goes to the substantive legality of the contested measure (§ 27-30).

[20/12/2023, T-221/22 & T-242/22, \*Lutamax\*, EU:T:2023:858](#)

### **Functional continuity between the first instance and the BoA – Determination of the relevant public and level of attention**

Although the BoA did not expressly determine the relevant public and its degree of attention in relation to ‘sales services’, given that the BoA endorsed the decision of the OD in its entirety, the statement of reasons contained in the OD decision regarding the relevant public and its degree of attention for ‘sales services’ must be taken into account when assessing the legality of the BoA’s decision (§ 63, 73-75).

[24/01/2024, T-55/23, \*SALVAJE \(fig.\) / SALVANA\*, EU:T:2024:30](#)

#### **3.4.2.2 Ex officio examination**

##### **Matter of public policy – Ex officio examination**

Failure to state reasons in the contested decision is a public policy issue that can be examined *ex officio* (§ 20)

17/01/2019, T-368/18, [ETI Bumbo / BIMBO \(fig.\)](#), EU:T:2019:15, § 20

08/05/2019, T-269/18, [ZARA / ZARA \(fig.\) et al.](#), EU:T:2019:306, § 37, 47-51, 55

23/09/2020, T-677/19, [SYRENA](#), EU:T:2020:424, § 84

##### **Matter of public policy – Ex officio examination**

Compliance with the duty to state reasons is a matter of public policy that must be raised, if necessary, of the Court’s own motion (§ 93).

12/07/2019, T-792/17, [MANDO \(fig.\) / MAN et al.](#), EU:T:2019:533, § 93

#### **3.4.2.3 General reasoning for goods and services**

##### **General reasoning – Sufficiently homogeneous category or group of goods or services**

In examining absolute grounds for refusal, the competent authority may use only general reasoning for all the goods or services concerned when the same ground for refusal is given for a category or group of goods and services, provided that these are interlinked in a sufficiently

direct and specific way that they form a sufficiently homogeneous category or group of goods or services (§ 48-49).

11/04/2019, T-223/17, [ADAPTA POWDER COATINGS \(fig.\)](#), EU:T:2019:245, § 48-49

17/01/2019, T-91/18, [DIAMOND CARD \(fig.\)](#), EU:T:2019:17, § 18-21

20/09/2019, T-650/18, [Reaktor](#), EU:T:2019:635, § 40-50

03/09/2020, C-214/19 P, [achtung! \(fig.\)](#), EU:C:2020:632, § 41

### **General reasoning – Requirement of substantiated argumentation for alleging lack of a sufficiently direct and specific link between the sign and the goods and services**

Arguments concerning the lack of a sufficiently direct and specific link between the sign and the goods and services must be sufficiently substantiated. The citation of examples in this regard is not sufficient. The specific goods and services to which the submission relates must be specified and it must be explained why there is no sufficiently direct and specific link between the sign and those goods and services (§ 32, 62).

02/12/2020, T-152/20, [Home Connect \(fig.\)](#), EU:T:2020:584, § 32, 62

### **General reasoning for goods and services – Perception of the relevant public**

For the examination of the homogeneity of the goods and services, the specificity of the mark applied for or, in particular, of its perception by the relevant public must be taken into account (§ 44) (17/05/2017, C-437/15 P, [deluxe \(fig.\)](#), EU:C:2017:380, § 32, 44).

04/04/2019, T-804/17, [DARSTELLUNG VON ZWEI SICH GEGENÜBERLIEGENDEN BÖGEN \(fig.\)](#), EU:T:2019:218, § 32, 44

### **General reasoning for goods and services – Laudatory marks**

If the EUTM application is a slogan and covers several goods and services, global reasoning could be considered sufficient. In such cases, all the goods/services belong to a sufficiently homogeneous category, linked by the fact that they can offer benefits, since the sign is perceived as an advertising promise (§ 61-62).

10/10/2019, T-832/17, [achtung! \(fig.\)](#), EU:T:2019:2, § 61-62

### **General reasoning for goods and services – Slogans**

In view of the meaning of the mark applied for, the BoA was entitled to find that the services were in a homogeneous category and an overall reasoning was justified (§ 48). When the BoA explained that, for all the services for which protection was sought, the trade mark application would be perceived by the relevant public as a 'motivational slogan [involving] the consumer in the innovation actions [of the trade mark proprietor]', it adequately explained how it had defined the homogeneous category on which it based its assessment of the distinctive character of the trade mark applied for (§ 49).

13/02/2020, T-8/19, [Inventemos el futuro](#), EU:T:2020:66, § 48-49

### **Descriptive character – General reasoning – Sufficiently homogeneous category or group of goods or services – Article 94(1) EUTMR – Lack of reasoning**

The BoA correctly found, on the basis of all the evidence before it, that the term 'loop' refers, in the telecommunications and computer sector, to a telecommunications or an internet connection line and is therefore descriptive (§ 37). The contested mark is however annulled for the goods in

Class 9 and services in Classes 38 and 42 since the goods and services in these categories are too heterogeneous to be caught by a general reasoning (§ 65, 91-94, 98, 103, 106).

[09/03/2022, T-132/21, \*Loop\*, EU:T:2022:124, § 37, 65, 91-94, 98, 103, 106](#)

### **General reasoning – Sufficiently homogeneous category or group of goods or services**

It cannot be excluded *a priori* that all the goods and services covered by the EUTM application share a common feature which is relevant to the analysis of the application of absolute grounds for refusal and that they can be grouped, for the purposes of examining the EUTM application at issue in the light of those absolute grounds for refusal, to a single sufficiently homogeneous category or group (§ 22).

[14/09/2022, T-367/21 & T-432/21, \*READY 4YOU\* \(fig.\), EU:T:2022:552](#)

### **General reasoning for goods and services – Goods and retail services of those goods**

The competent authority may limit itself to general reasoning for all the goods and services concerned if the same ground for refusal is raised against a category or group of goods or services (§ 34). The BoA rightly considered that homogeneity resulted from the fact that all the goods concerned in Class 30 were foodstuffs in the form of bars and that the services at issue in Class 35 were retail or wholesale services relating thereto (§ 39, 40).

[14/09/2022, T-686/21, \*Energy cake\*, EU:T:2022:545](#)

### **General reasoning for goods and services – Goods and services not expressly mentioned – No failure to state reasons**

All the goods and services have a common feature, namely that they are linked to gaming tournaments or competitions. In that regard, the goods and services at issue are sufficiently homogeneous to allow the BoA to limit itself to general reasoning (§ 54).

Where a decision has been adopted in a context with which the person concerned is familiar, it may be reasoned in a summary manner. Moreover, the BoA cannot be required to provide an account that follows exhaustively and one by one all the lines of reasoning articulated by the parties before them. The reasoning may therefore be implicit, on condition that it enables the persons concerned to know the reasons for the BoA's decision and provides the competent Court with sufficient material for it to exercise its power of review (§ 94). Although some goods and services are not expressly mentioned in the analysis grouping the goods and services in the corresponding classes (§ 94), the BoA did not infringe the obligation to state reasons referred to in the first sentence of Article 94(1) EUTMR (§ 98).

[26/10/2022, T-776/21, \*GAME TOURNAMENTS\* \(fig.\), EU:T:2022:673](#)

### **General reasoning – Sufficiently homogeneous category or group of goods or services**

All the goods at issue are inherent to the circulation of water in a counter-current swimming system and necessary to create a strong current of water. They belong to a sufficiently homogeneous category to allow a general reasoning regarding the descriptive character of these goods (§ 37, 38).

[23/11/2022, T-14/22, \*Jet stream\*, EU:T:2022:719](#)

### **General reasoning for goods and services – Sufficiently direct and specific link between the goods and services concerned**

The goods, such as nail polish, nail care products and cosmetics (Classes 3 and 8), and services in question (in Class 35) have a sufficiently direct and specific link between each other, both as regards to the sector to which they belong (e.g., retail services for cosmetics) and the relevance of the colour characteristics. The BoA was therefore entitled to adopt a general reasoning (§ 54).

[30/11/2022, T-780/21, LiLAC \(fig.\), EU:T:2022:732](#)

### **General reasoning for goods and services**

An examiner is not required to state reasons for the outcome of the comparison for each of the individual goods and services specified in the application for registration. Instead, general reasoning for groups of the goods concerned may be used as long as those goods have analogous features. Here, all the contested goods belong to the broader category of vehicles and conveyances or are parts and fittings for those goods. Therefore, the BoA could merely state overall reasons for all those goods (§ 29).

[01/02/2023, T-569/21, Google car / Google et al., EU:T:2023:38](#)

### **Descriptive – General reasoning – Homogeneous category of goods**

The determination of a homogeneous category of goods for the purpose of the assessment of descriptiveness must not be carried out only in relation to the description of the goods in respect of which the contested mark has been registered. Accordingly, in order to determine common characteristics of the goods, the fact that the description of some of those goods does not specify that common characteristic, is irrelevant (§ 29).

[26/02/2024, T-505/23, MATE MATE \(fig.\)](#)

#### **3.4.2.4 Principles of legality, equal treatment and sound administration**

##### **Principle of legality – Principles of equal treatment and sound administration – Obligation to provide express reasons for departing from previous decisions**

The BoA has to provide explicit reasoning when it decides to take a different view from previous decisions. However, the legality of the decisions must be assessed solely on the basis of the EUTMR. The BoA gave express reasons for departing from the previous decisions (§ 53-55).

[31/01/2019, T-97/18, STREAMS, EU:T:2019:43, § 53-55](#)

[22/05/2019, T-161/16, CMS Italy \(fig.\) / PUMA \(fig.\) et al., EU:T:2019:350, § 30-31, 35, 44, 46, 50.](#)

##### **Departure from previous EUIPO decisions – Duty to state reasons – Principle of sound administration**

The BoA is not required to respond expressly and exhaustively to all of the arguments put forward by the applicant, provided that it sets out the facts and legal considerations having decisive importance in the contested decision. As long as the BoA sets out the decisive reasons for its conclusion regarding the lack of a link between the earlier marks and the mark applied for, it was not obliged to respond expressly to the argument by which the applicant relied on a previous EUIPO decision. That EUIPO decision was not relied on as evidence of a factual situation such as that relating to the reputation of the earlier mark, but merely to claim that legal provisions should be applied in the same way to comparable factual situations (§ 92-94).

[10/03/2021, T-71/20, Puma-system / PUMA \(fig.\), EU:T:2021:121, § 92-94](#)

### **No obligation of express reasons for departing from previous decisions not relied on by a party**

The BoA does not have to explicitly set out the reasons why it intends to depart from previous decisions that were not relied on by a party before it. Moreover, the duty to state reasons in respect of previous apparently diverging decisions is 'less stringent where the examination depends exclusively on the mark applied for than on factual findings which are independent of this mark' (§ 36-38, 48).

05/09/2019, T-753/18, [#BESTDEAL \(fig.\)](#), EU:T:2019:560, § 36-38, 48

### **Action for infringement – Opposition proceedings**

As for the claim that the BoA erred in disregarding the judgment of the *Audiencia Provincial de Alicante* (Provincial Court, Alicante) and a judgment of the First Chamber of the *Qorti Ċivili* (Civil Court), Malta, the EUTMR does not contain any provision by which the Office is bound by a decision, even now definitive, of an EU trade mark court delivered in an action for infringement, in the context of the exercise of its exclusive jurisdiction over registration of EU trade marks and, in particular, when it examines oppositions lodged against applications to register EU trade marks (21/07/2016, C-226/15 P, English Pink / PINK LADY, EU:C:2016:582, § 48) (§ 153).

10/03/2021, T-693/19, [KERRYMAID / Kerrygold \(fig.\)](#), EU:T:2021:124, § 153

### **Decisions of first instance**

The BoA is not bound by the Office's first instance decisions (§ 96). The legality of the BoA's decisions must be assessed solely on the basis of the EUTM Regulation, as interpreted by the EU courts (§ 97-109).

19/09/2019, T-679/18, [SHOWROOM \(fig.\) / SHOWROOM 86 \(fig.\)](#), EU:T:2019:631, § 96-109

### **Decisions of national authorities – Identical marks**

The Office is not required to take into account decisions of national authorities concerning marks identical to those on which it has to give a decision. If it does take them into account, it is not bound by those decisions (§ 83-84).

24/01/2019, T-785/17, [BIG SAM SPORTSWEAR COMPANY \(fig.\) / SAM et al.](#), EU:T:2019:29, § 83-84

19/12/2019, T-624/18, [GRES ARAGÓN \(fig.\)](#), EU:T:2019:868, § 28-29.

### **Relevance of case-law post-dating the EUTM application**

The BoA did not err in basing the contested decision on, inter alia, the interpretation given by the CJ and by the GC to Article 7(1)(b) and (c) EUTMR in decisions delivered after the date the application for registration of the contested mark was filed, insofar as, by those decisions, the EU Courts merely interpreted the substantive rules applicable on the date the application was filed, with the result that such decisions, which clarify the scope and conditions for application of Article 7(1)(b) and (c) EUTMR, allow conclusions to be drawn about the legal situation as it was on that date (§ 33).

Registration of an EU trade mark cannot create a legitimate expectation by the proprietor of that mark regarding the outcome of subsequent invalidity proceedings, since the applicable rules expressly allow for a possible subsequent challenge to that registration in an application for a declaration of invalidity or in a counterclaim in infringement proceedings. The fact that a mark was initially registered by the EUIPO does not bind the EUIPO in the future, since the registration of a

mark does not preclude that mark from being declared invalid if it was registered in breach of one of the absolute grounds for refusal set out in Article 7 EUTMR (§ 95).

The applicable provisions do not set out a period within which an application for a declaration of invalidity on the ground of absolute nullity must be filed. The requirement of legal certainty constitutes the general interest pursued by Article 51(1) EUTMR. The objective of that provision is to make it possible to rectify any errors committed by the examiner at the time of filing an application for registration (§ 107, 109). The applicant does not raise a plea of illegality in respect of Article 51(1)(a) EUTMR pursuant to Article 277 TFEU (§ 116).

*01/09/2021, T-834/19, [e\\*message \(fig.\)](#), EU:T:2021:522, § 33, 95, 107, 109, 116*

### **No infringement of principles of legality, equal treatment and sound administration – BoA's change of position after remittal**

BoA is not bound by previous decisions and can change its position on a factual point such as the saturation of the state of art as long as it provides sufficient reasoning and allows the parties to present evidence and observations on that point (§ 152, 153).

*[15/06/2022, T-380/20, Radiatori per riscaldamento, EU:T:2022:359](#)*

### **Departure from previous EUIPO decisions – Previous BoA decision regarding identical trade mark**

As the Board of Appeal was right to find that the EUTM application fell under Article 7(1)(c) EUTMR, the applicant cannot successfully rely on previous BoA decision ([24/07/2014, R 52/2014-4, STAHLWERK](#)) to invalidate that conclusion (§ 34).

*[14/09/2022, T-705/21, Stahlwerk, EU:T:2022:546](#)*

### **No infringement of principle of legal certainty – Opposition admissible on the basis of earlier rights not mentioned in the previous confirmation of admissibility**

Where (i) the admissibility of the opposition was first confirmed at least on the basis of one of several earlier rights invoked but clearly indicating that the admissibility may, if necessary, be examined in relation to the other earlier rights at a later stage and (ii) both instances of the EUIPO later find that the opposition is admissible based also on the other earlier right, the BoA cannot be accused of having infringed the principle of legal certainty by finding that the opposition was admissible insofar as it was based on that earlier right (§ 17-18).

*[21/06/2023, T-514/22, VITROMED Germany \(fig.\) / VITROMED et al., EU:T:2023:350](#)*

### **Decisions of national authorities – Non-binding effect**

The EU design regime is an autonomous system with its own set of objectives and rules peculiar to it, and that system applies independently of any national system. Therefore, national judicial proceedings cannot have impact on the legality of the contested decision in the present case (§ 35-36).

*[06/09/2023, T-377/22, Motos acuáticas, Embarcaciones a motor, EU:T:2023:504](#)*

### **Principle of legality – Principles of equal treatment and sound administration – Obligation to provide express reasons for departing from previous decisions**

Where the adjudicating bodies of the EUIPO decide to take a different view from the one adopted in their previous decisions, they should provide an explicit statement of their reasoning for

departing from those decisions. The BoA explicitly stated why the findings made in the earlier decisions of the EUIPO, relied on by the applicant, could not be transposed to the present case. The goods covered by the earlier mark were compared not to ‘sports cars and their component parts’ in Class 12, but to a wider range of goods in the same class, which contained, in essence, vehicles and cars in general, whose purpose cannot be restricted to that of sports cars. Accordingly, the BoA did not commit any error of assessment inasmuch as it did not base its findings as to the similarity of the goods at issue on the assessments made in those decisions (§ 22-25).

[29/11/2023, T-53/23, TVR \(fig.\) / TVR Italia \(fig.\) et al., EU:T:2023:764](#)

### **Assessment of bad faith – Previous decisions of national authorities**

Although the EUIPO is not bound by decisions issued by national authorities, such decisions, without being binding or decisive, may be taken into account as evidence in the assessment of the facts of the case (§ 35).

[13/12/2023, T-382/22, El rosco / El rosco, EU:T:2023:800](#)

[13/12/2023, T-383/22, EL ROSCO \(fig.\) / El rosco, EU:T:2023:801](#)

See also, [13/12/2023, T-381/22, El rosco / El rosco, EU:T:2023:799](#), § 33

### **Decisions of national authorities – Non-binding effect**

The EUIPO is not bound by a decision given in a Member State, or even a third country, that holds that the sign in question is registrable as a national trade mark. This applies even where such a decision was adopted under national legislation in a country belonging to the language area in which the word sign in question originated (§ 39).

[20/12/2023, T-189/23, my mochi \(fig.\), EU:T:2023:853](#)

### **3.4.2.5 Lack of reasoning**

#### **Lack of reasoning – Geographical name**

The Office is obliged to demonstrate that the geographical name is known to the relevant public as the designation of a place and that the name in question currently suggests to that public a link with the goods or services in question, or that it is reasonable to assume that such a name may, for that public, designate the geographical origin of the goods or services mentioned (15/01/2015, T-197/13, MONACO, EU:T:2015:16, § 51 and the Office’s Guidelines, Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 4, Descriptive trade marks (Article 7(1)(c) EUTMR), paragraph 2.6, Geographical terms) (§ 42, 43).

19/12/2019, T-624/18, [GRES ARAGÓN \(fig.\)](#), EU:T:2019:868, § 42-43

#### **Lack of reasoning – Previous decisions – Lack of explicit statement of reasoning for departing**

Where the Office decides to take a different view from the one adopted in previous decisions, it should provide an explicit statement of reasoning for departing from those decisions (§ 54, 55, 58).

27/06/2019, T-334/18, [ANA DE ALTUN \(fig.\) / ANNA \(fig.\) et al.](#), EU:T:2019:451, § 54, 55, 58

#### **Scope of the duty to state reasons – Different assessment compared to previous decisions – No obvious differences that would justify different answers**

Although the Office is not bound by its previous decisions, it must take into account decisions already taken and consider with special care whether it should decide in the same way or not. In that regard, the Office has not shown to what extent in the previous decisions the understanding of the semantic content of the word 'amen' by the general public differed from that in the present case. In actual fact, in view of the limited scope of that question, there are no obvious factual differences that would justify different answers. In particular, since the BoA based its assessment of the semantic content on the *Collins* English-language dictionary, it cannot be accepted that a difference arises from the language context of the relevant public, namely the general German-, Slovak- or Czech-speaking public, on the one hand, and the European or Italian public, on the other (§ 58).

**.A.M.E.N.** 05/05/2021, T-442/20, [Âme / .A.M.E.N. \(fig.\)](#), EU:T:2021:237, § 58

#### **Lack of reasoning – Mere quotation of case-law**

The mere quotation of case-law does not meet the requirements of the obligation to state reasons within the meaning of Article 75(1) CTMR [now Article 94(1) EUTMR] (§ 31).

20/03/2019, T-762/17, [DARSTELLUNG EINER GEOMETRISCHEN FIGUR \(fig.\)](#), EU:T:2019:171, § 31

#### **Lack of reasoning – Previous decisions – Lack of explicit statement of reasoning for departing**

Where an opposition is based on Article 8(5) CTMR [now Article 8(5) EUTMR], the opponent is free, in principle, to choose the form of evidence it considers useful to submit to the Office, pursuant to Rule 19(2)(c) CTMR [now Article 7(2)(f) EUTMR]. Thus, the opponent is free to rely, as evidence of the reputation of the earlier mark relied upon, on one or several previous decisions of the Office finding that that mark enjoys a reputation. The Office is required to take into account those decisions when they are identified in a precise manner in the notice of opposition (28/06/2018, C-564/16 P, *DEVICE OF A JUMPING ANIMAL (FIG. MARK) / PUMA (FIG. MARK) et al.*, EU:C:2018:509, § 69) and to consider whether or not it should decide in the same way and, if not, to provide an explicit statement of its reasoning for departing from those decisions, stating why they are no longer relevant (§ 30-31, 35, 44, 46, 50).

22/05/2019, T-161/16, [CMS Italy \(fig.\) / PUMA \(fig.\) et al.](#), EU:T:2019:350, § 30-31, 35, 44, 46, 50.

#### **Lack of reasoning – Proof of use in a form different from the one registered**

A finding of an alteration of the distinctive character of the mark as registered requires an assessment of the distinctive and dominant character of the elements added, based on the intrinsic qualities of each of those elements and their relative position within the arrangement of the trade mark (§ 47). The finding in the contested decision that the verbal element 'ZARA' is distinctive and is included identically in 'the earlier trade marks' does not provide clear and sufficient indications about the existence or not of use of the earlier trade marks in a form differing in elements which do not alter their distinctive character (§ 48, 51). The BoA's analysis and the conclusion reached in respect of a possible alteration of the distinctive character of the earlier marks are equivocal and imprecise and do not enable the GC to review the legality of the contested decision.

08/05/2019, T-269/18, [ZARA / ZARA \(fig.\) et al.](#), EU:T:2019:306, § 47, 48, 51

#### **Lack of reasoning – General reasoning – Sufficiently homogeneous category of goods and services**

The BoA disregarded its obligation to state reasons by failing to establish whether the goods and services represent a sufficiently homogeneous category which could be subject to general reasoning. Moreover, it committed an error of assessment in considering that there is a sufficiently direct and specific link between the sign and goods and services such as *computers, namely laptops, personal computers, satellite computers*, and software relating to *3D printing and space technology* in Class 9 and *arranging and conducting competitions in the field of computer coding* in Class 41 (§ 40-50)

20/09/2019, T-650/18, [Reaktor](#), EU:T:2019:635, § 40-50

### **Lack of reasoning – Invalidity proceedings based on different prior rights**

On applications for a declaration of invalidity based on different prior rights it follows from the *ratio legis* of Article 53(4) CTMR [now Article 60(4) EUTMR] that such provision is applicable even if the initial application for a declaration of invalidity has been withdrawn or considered inadmissible, the **mere filing** of an initial application being sufficient (§ 45).

The BoA did not describe the rights relied on in support of each of the two applications. In particular, as regards the signs used in the course of trade, it did not specify their nature and the verbal elements of which they are composed. Because of the deficiencies in the statement of reasons, it is not sufficiently clear and precise what those rights are and whether the BoA considered that the right or rights relied upon in support of the second application for a declaration of invalidity had or had not been relied upon in the first application for a declaration of invalidity (§ 58, 61, 64, 77).

01/09/2021, T-566/20, [PALLADIUM HOTEL GARDEN BEACH \(fig.\) / Grand hotel palladium](#), EU:T:2021:525, §§ 45, 58, 61, 64, 77

15/09/2021, T-207/20, [PALLADIUM HOTELS & RESORTS \(fig.\) / Grand hotel palladium](#), EU:T:2021:587, § 45, 58, 61, 64, 77

### **Lack of reasoning – Belated evidence in the proceedings before the BoA – Licensee's entitlement to file the opposition – Proof of entitlement**

Proof of the licensee's entitlement to file an opposition must be submitted during the substantiation period (§ 47). The proprietor's authorisation cannot be presumed from the mere existence and registration of a licence if this licensee (exclusive or not) does not explicitly address the licensee's right to file oppositions (§ 50). On the facts of the case, such proof could not be deduced from the following circumstances: (i) the proprietor of the earlier EU marks and the opponent are members of the same group of companies and are economically linked (§ 53, 62); (ii) the two companies have the same representative before the Office; (iii) the application to register the licence was submitted through that common representative, who also filed the opposition; (iv) the EUTM proprietor and its licensee are owners of parallel marks in the UK (§ 63) and (v) the EUTM applicant never challenged, either before the OD or in the appeal against the OD's decision, the opponent's entitlement to file the opposition during the administrative proceedings (§ 61). The BoA violated its duty to state reasons in failing to take position on whether proof of the licensee's entitlement was admissible for the first time on appeal (§ 59, 79-80).

30/06/2021, T-15/20, [Skyliners / Sky et al.](#), EU:T:2021:401, § 47, 50, 53, 59, 61-63, 79-80

### **Lack of reasoning – Contradictory reasoning in the contested decision**

It is apparent from paragraph 97 of the contested decision that the BoA excluded the existence of a likelihood of confusion between the earlier EU word mark HYALISTIL and the mark applied for, finding that the term 'hyal' could allude to hyaluronic acid for part of the Italian-speaking relevant public. However, in paragraph 28 of that decision, the BoA had stated that it would focus primarily on the Italian-speaking part of the public which is more prone to confusion, considering

that this part of the relevant public would not perceive the term as evoking the concept of hyaluronic acid (§ 24).

The BoA's reasoning in relation to the existence of a likelihood of confusion is based on contradictory considerations (§ 25-33). The lack of clarity in the contested decision cannot be remedied by the clarifications provided by the Office in its written pleadings (§ 34). The decision is annulled in its entirety on the basis of breach of the obligation to state reasons. The case is referred back to the Office, since the Court cannot substitute its own assessment for that which was worded ambiguously by the BoA regarding the relevant public taken as a reference point in the present case and for all the other assessments based on that assessment (§ 35).

[21/12/2021, T-194/21, \*HYALOSTEL ONE \(fig.\) / HyalOne \(fig.\) et al.\*, EU:T:2021:934, 24, 25-33, 35](#)

### **No lack of reasoning – No assessment of figurative elements**

The BoA did not expressly rule on the question whether the figurative element of the mark applied for could endow it with distinctive character. However, EUIPO do not need to address all the arguments put forward by the parties. The mere fact that BoA did not reproduce or reply to all the arguments of a party cannot be taken to mean that that BoA refused to take them into account. The reasoning may therefore also be implicit provided that it enables the parties concerned to know the reasons for the BoA decision and gives the competent court sufficient information to enable it to exercise its power of review. Furthermore, if the BoA furthermore upholds the first instance decision in its entirety, that decision and its reasoning form part of the context in which the BoA decision was adopted and of which is known to the parties and which enables the Court to exercise its review of legality in relation to the correctness of the BoA's assessment in its entirety (§ 19-22).

In the present case, *first*, the examiner dealt with the figurative element of the mark applied for in her decision. *Second*, in its summary of the reasons on which the examiner's decision is based, the BoA referred to the examiner's view of the figurative element in the mark applied for. *Third*, the BoA reproduced all the arguments put forward by the applicant concerning the figurative element in the mark applied for. *Fourth*, the description of the mark applied for shows that the figurative element was not disregarded. *Fifth*, the word elements were considered to be the dominant element of the mark applied for. *Sixth*, the BoA upheld in its entirety the examiner's decision. Therefore, the BoA considered and implicitly dismissed the Applicant's arguments concerning the figurative element of the mark applied for and was not obliged to explicitly address each of these arguments (§ 24-31).

[29/06/2022, T-640/21, \*bet-at-home \(fig.\)\*, EU:T:2022:408](#)

### **Lack of reasoning – Interdependence of the factors in global assessment of LOC**

The reasoning may be implicit, on condition that it enables the persons concerned to know the reasons for the BoA decision and provides the competent court with sufficient material for it to exercise its power of review (§ 53). In this case, the BoA did not sufficiently explain the reasons why it confirmed the opposition division's conclusion on the existence of LOC. It did not indicate the reasons why it considered that the low degree of similarity of some of the services was sufficiently offset, in the context of the weighing up the various factors to be taken into account, by a higher degree or relative importance of the other relevant factors (§ 55).

Such reasoning was all the more necessary as these other factors were not, a priori, of a high degree, since the BoA had found that the signs were visually similar to a low degree and phonetically similar to average degree, the conceptual comparison was neutral, and the earlier mark had an average inherent distinctiveness (§ 56). The BoA did not refer to all the factors but

only to the similarity of the signs. It did not explain which aspect should prevail or how the low degree factors would have been offset by factors of a significant higher degree (§ 59).

[12/10/2022, T-460/21, C2 CYPRUS CASINOS \(fig.\) / C8 \(fig.\), EU:T:2022:623](#)

See also, [12/10/2022, T-461/21, C2 \(fig.\) / C8 \(fig.\), EU:T:2022:624](#), § 52-54, 57

### **Lack of reasoning – Contradictory reasoning in finding bad faith**

The reasons why the BoA considered that former members of an association continued to enjoy legal protection on the earlier sign following the acquisition of the corresponding national mark by the EUTM proprietor are not disclosed in a clear and unequivocal manner (§ 30). The findings that, on the one hand, legal protection of the earlier sign can be inferred from the multilateral agreement between the members of the association and, on the other hand, that the termination of that agreement had no effect on that legal protection, are contradictory (§ 31). The BoA should have explained on what legal basis it found the legal protection favouring the members of the association (§ 32, 36).

[15/02/2023, T-684/21, Mostostal, EU:T:2023:68](#)

### **Contradictory reasoning – Assessment of descriptiveness**

The reasoning of the decision is contradictory where certain goods in Class 3 were found non-descriptive on the ground that there were meant 'to give pleasant and desirable scent to a person's body or to his or her living environment and cleaning the teeth' (*perfumes, toilet water, eau de Cologne, essential oils, incense, perfume water, dentifrices*), while other goods with the same purpose were found descriptive (*body deodorants, soaps, make-up removing preparations*) (§ 23-24).

[22/03/2023, T-750/21, Bio-beauté, EU:T:2023:147](#)

### **Lack of reasoning – Assessment of distinctive character – Need to assess the mark as a whole**

Distinctive character of a composite mark may be assessed, in part, in respect of each of its elements, taken separately, but that assessment must, in any event, be based on the overall perception of that trade mark by the relevant public and not on the presumption that elements individually devoid of distinctive character cannot, on being combined, present such character (§ 38). Failure to carry out an overall assessment of distinctive character of the mark amounts to a failure to state reasons (§ 51).

[24/05/2023, T-477/21, SHAPE OF AN INHALER \(3D\), EU:T:2023:280](#)

### **No contradictory reasoning – Level of attention – 'High' and 'heightened' and 'higher-than-average'**

The terms 'high' and 'heightened' and the expression 'higher-than-average' are used as synonyms. Both a 'high level of attention' and a 'higher-than-average level of attention' indicate a heightened level of attention on the part of the public (§ 18). The BoA's findings that the level of attention is 'higher-than-average' and 'particularly high' are not contradictory since that level is, in any event, higher than an average level of attention (§ 22).

[11/10/2023, T-435/22, PASCELMO / PASCOE, EU:T:2023:610](#)

### 3.4.3 Res judicata

#### Implementation of GC's Judgment – Res judicata

The obligation to state reasons is an essential procedural requirement that must be distinguished from the question of the merits of those reasons, which concern the substantive legality of the contested measure (§ 48). Where the GC rules only that the BoA had, to the requisite legal standard, stated the reasons forming the basis of the contested decision (in this case, with regard to only some of the contested goods), but did not examine the parties' arguments and did not rule on the substantive legality of the contested decision, the force of res judicata concerns only the statement of reasons as an essential procedural requirement and not its substantive legality (§ 51).

The force of res judicata extends only to the grounds of a judgment that constitute the necessary support of its operative part and are therefore inseparable from it (25/07/2018, C-84/17 P, C-85/17 P and C-95/17 P, SHAPE OF A 4-FINGER CHOCOLATE BAR (3D), EU:C:2018:596, § 52) (§ 52).

19/12/2019, T-690/18, [Vita](#), EU:T:2019:894, § 48, 51-52

#### Res judicata

The force of res judicata attaches not only to the operative part of the judicial decision, but also to the *ratio decidendi* of that decision, which is inseparable from it (§ 26). In the present case, the Board's findings regarding the establishment of events constituting disclosure of the earlier design are covered by the force of res judicata (§ 28-33).

02/03/2022, T-1/21, [Furniture](#), EU:T:2022:108, § 26, 28-33

#### Decision taken following the annulment of an earlier decision by the GC – Article 72(6) EUTMR – No res judicata

In order to comply with a judgment annulling a measure and to implement it fully, the Office is required to adopt a new decision. This decision must have regard not only to the operative part of the judgment, but also to the grounds that led to that ruling and constitute its essential basis, in so far as they are necessary in determining the exact meaning of what is stated in the operative part. It is those grounds that, on one hand, identify the precise provision held to be illegal and, on the other, indicate the specific reasons underlying the finding of illegality contained in the operative part, which the Office must take into account when replacing the annulled measure (10/10/2019, T-536/18, FITNESS, EU:T:2019:737, § 34-35 and the case-law cited) (§ 36-37).

In the present case, for the purposes of complying with the annulling judgment, the BoA was required, when re-examining the applicant's arguments regarding the enhanced distinctiveness and the reputation of the earlier mark, to raise the question of whether that reputation could be established on the basis of a trade mark registered in a different form (§ 38-44).

The GC was not itself, pursuant to the powers conferred on it by Article 72 EUTMR, entitled to assess the merits of those arguments. It does not have the power to substitute its own reasoning for that of the BoA or to carry out an assessment on which the BoA has not yet adopted a position (§ 47-48). The question of whether the proprietor of a mark can rely on evidence that proves that its mark has a reputation in a different form had neither been raised nor analysed by the BoA as regards the earlier mark (§ 49-52).

Secondly, when a decision of the BoA is annulled by the GC, the grounds on the basis of which the GC dismissed certain arguments relied upon by the parties cannot be considered to have gained the force of res judicata (25/07/2018, C-84/17 P, C-85/17 P & C-95/17 P, SHAPE OF A 4-FINGER CHOCOLATE BAR (3D), EU:C:2018:596, § 53) (§ 51).

In the present case, in paragraphs 108 to 111 of the annulling judgment, the GC rejected the arguments which the opponent had put forward in order to establish that the earlier mark had a reputation in a different form by holding specifically that those arguments had not been assessed during the proceedings before the Office (§ 52). Consequently, the considerations set out in those paragraphs did not, contrary to what the BoA found in paragraph 28 of the contested decision, have the force of *res judicata* and were not in any way final with regard to that BoA (§ 53).

17/11/2021, T-616/20, [THE ONLY ONE by alphaspirt wild and perfect \(fig.\) / ONE](#), EU:T:2021:794, § 36-44, 47-53

### **Power to re-open the examination on absolute grounds – Res judicata**

Whilst the Office is able to reopen, on its own initiative and at any time prior to registration, the examination of absolute grounds for refusal if it deems it appropriate (§ 47-50), it can only do so in compliance with its obligation to comply with a final decision (that is, the operative part and the reasons that led to it) of the EU judge annulling a previous decision of the BoA on the matter (§ 49-50). The Office's power to examine the facts on its own initiative does not enable it to call into question matters of fact and of law that have been settled by the EU judge, even when new facts become apparent following the final decision of the court (§ 56-57).

01/09/2021, T-96/20, [Limbic® Types](#), EU:T:2021:527, § 47-50, 56-57

### **Invalidity proceedings – Decisions of EU trade mark court's ruling on an action for a declaration of non-infringement – No res judicata – No infringement of the principles of equal treatment and of sound administration**

Article 63(3) EUTMR provides that an application for revocation or for a declaration of invalidity is to be inadmissible where an application relating to the same subject matter and cause of action, and involving the same parties, has been adjudicated on its merits, either by the Office or by an EU trade mark court as referred to in Article 123 EUTMR, and the decision of the Office or that court on that application has acquired the authority of a final decision (§ 41).

In order for decisions of a court of a Member State acting as an EU trade mark court to be capable of being binding on the Office, they need to be *res judicata*. This requires that parallel proceedings before that court and the Office must concern the same parties and have the same subject matter and cause of action (21/07/2016, C-226/15 P, English Pink / PINK LADY, EU:C:2016:582, § 52) (§ 42).

The decisions of the Venice District Court and the Venice Court of Appeal ruling on an action for a declaration of non-infringement did not have the same subject matter as the invalidity proceedings before the Office and were not binding on the BoA (§ 43-44).

There is no infringement of the principles of equal treatment and sound administration or of the obligation to state reasons since the BoA was right in finding that it was not bound by the findings of the Venice District Court and the Venice Court of Appeal relating to the reputation and distinctiveness of the contested mark. Only an application for a declaration of non-infringement had been brought before those courts as EU trade mark courts (§ 47-52).

19/01/2022, T-483/20, [Shoes \(3D\)](#), EU:T:2022:11, § 41-44, 47-52

### **No infringement of res judicata – Article 7(1)(e) EUTMR independent from Article 7(1)(b) EUTMR**

*Res judicata* only extends to those factual and legal issues that are actually and necessarily the subject matter of a judgment. As the first decision was only based on Article 7(1)(b) EUTMR, the annulling judgment did not examine the absolute grounds for refusal under Article 7(1)(e) EUTMR. The absolute grounds for refusal under Article 7(1)(b) and (e) EUTMR pursue different objectives

and the perception of the targeted public must only be taken into account under Article 7(1)(b) EUTMR. Furthermore, the specific considerations of the Court in the annulling judgment made in the context of Article 7(1)(b) EUTMR were not incompatible with the application of Article 7(1)(e) EUTMR (§ 16-22).

[05/07/2023, T-10/22, FORM EINER FLASCHE \(3D\), EU:T:2023:377](#)

### **Res judicata**

An earlier judgment refusing the contested mark for part of the contested goods on absolute grounds has become res judicata, which precluded the BoA from taking those goods into account in the context of the comparison of the goods (§ 15).

[20/12/2023, T-564/22, DEVICE OF A LION HEAD \(fig.\) / DEVICE OF A LION HEAD \(fig.\), EU:T:2023:851](#)

### **3.4.4 Ultra petita**

[No key points available yet.]

### **3.4.5 Other**

#### **Guidelines – Internet searches**

The Office's examination guidelines, although they lack binding force, are not only a reference source on the Office's practice in respect of trade marks, they are also a consolidated set of rules setting out the line of conduct which the Office itself proposes to adopt. Provided that these rules are consistent with the legal provisions of higher authority, they constitute a self-imposed restriction on the Office, namely that of compliance with the rules which it has itself laid down. However, the Office did not breach these guidelines when consulting electronic sources to determine the meaning of the word 'PANORAMICZNYCH'. It is clear from the text of the examination guidelines, in its version of 1 February 2014, that the possibility of using internet sources to define the meaning of a mark was not limited to new terms. In the 1 October 2017 version, moreover, it states that 'an internet search also constitutes a valid means to prove a descriptive meaning, especially where new terms, technical jargon or slang expressions are concerned' (§ 47-49).

[26/06/2019, T-117/18 to T-121/18, 200 PANORAMICZNYCH, EU:T:2019:447, § 47-49](#)

#### **Translation errors**

The question whether the BoA correctly translated the word 'pack' from English into German is irrelevant. Since German only was the language of proceedings at the Office, the conclusions as to how the relevant English-speaking public understands that word are not influenced by the accuracy of its translation into German, as long as those conclusions are objectively correct (09/03/2015, T-377/13, *ultra.air ultrafilter*, EU:T:2015:149, § 20) (§ 26).

[04/07/2019, T-662/18, \*Twistpac\*, EU:T:2019:483, § 26](#)

#### **Procedural irregularity – Decisive influence on the outcome of the proceedings**

A procedural irregularity entails the annulment of a decision in whole or in part only if it is shown that, had it not been for the irregularity, the contested decision might have been substantively different. Where the examiner or the BoA does not consider with particular attention whether or

not to decide in the same way as in a previous registration decision for a similar mark for the same goods, as required by the principles of equal treatment and sound administration (10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 75), there could be a failure to comply with such principles. However, in the present case, the decision would not have been substantively different, so there is no such influence on the outcome of the decision (§ 110-121).

26/06/2019, T-117/18 to T-121/18, [200 PANORAMICZNYCH](#), EU:T:2019:447, § 110-121

### **Procedural irregularity – Decisive influence on the outcome of the proceedings**

A procedural irregularity can vitiate the administrative procedure only if it is shown that, had it not been for that irregularity, the outcome of the procedure might have been different (§ 33).

11/04/2019, T-223/17, [ADAPTA POWDER COATINGS \(fig.\)](#), EU:T:2019:245, § 33

### **Reallocation of a case to a BoA following a judgment annulling a decision**

The provision on the basis of which a case should have been reallocated to a BoA following the GC annulment of the BoA decision was Article 1(d) of Commission Regulation No 216/96 and not Article 35(4) of Delegated Regulation 2017/1430 (§ 30). The latter provision does not apply to appeals filed before the BoA before 1 October 2017, which is the case here (§ 31). Accordingly, pursuant to Article 1(d)(1) of Regulation No 216/96, the decision to reallocate a case to a BoA following a judgment annulling a decision was a matter for the Presidium of the BoA and not for the President of the BoA (§ 34).

09/12/2020, T-722/18, [BASIC \(fig.\) / BASIC et al.](#), EU:T:2020:592, § 34

### **Exclusion of a member of the BoA**

A member of the BoA is not excluded from taking part in appeal proceedings pursuant to Article 169(1) EUTMR on the grounds that he participated in taking the previous decision in the appeal which has been subsequently annulled by the GG; the exclusion pursuant to Article 35(4) EUTMDR does not apply where the appeal is referred to the Grand Board of Appeal (§ 29-30).

01/09/2021, T-96/20, [Limbic® Types](#), EU:T:2021:527, § 29-30

### **Remittal to OD – Exercise of BoA's broad discretion**

The BoA exercised the broad discretion which Article 71(1) EUTMR confers on it for the purposes of remitting the case to the first instance. In the absence of any arguments on the part of the applicant against the specific grounds which were relied on in order to remit the case to OD, in particular the parties' legitimate interest that the case be examined by both instances of EUIPO, it cannot be maintained that the BoA made any error (§ 69, 70).

That finding is not capable of being called into question on the basis of Article 27(3)(b) EUTMDR, the aim of which is to delimit the scope of appeals before the BoA and not to circumscribe the discretion of the BoA to remit the case to OD. Moreover, in the light of the hierarchy of norms, a provision of the EUTMDR cannot circumscribe a discretion which is conferred on the BoA by the EUTMR (§ 71).

04/05/2022, T-4/21, [ASI ADVANCED SUPERABRASIVES \(fig.\) / ADI \(fig.\) et al.](#), EU:T:2022:274, § 69-71

### **Proceedings before the BoA – Applicability of EUTMDR to Design cases**

Provisions of EUTMDR in so far as they concern proceedings before the BoA are also applicable to cases related to Community designs by virtue of Article 108 CDR (§ 33).

[30/11/2022, T-611/21, Remote controls \[wireless\] \(Accessories for -\), EU:T:2022:739](#)

[30/11/2022, T-612/21, Remote controls \[wireless\] \(Accessories for -\), EU:T:2022:731](#)

### **Legal effects of the transfer of a trade mark vis-à-vis third parties**

Under the first sentence of Article 23(1) CTMR, the transfer of a trade mark is to have effects vis-à-vis third parties only after entry in the Register. The lack of effects, vis-à-vis third parties, of transfers which have not been entered in the Register is intended to protect a person who has, or may have, rights in an EUTM as an object of property (§ 44).

[14/12/2022, T-530/21, PL \(fig.\) / PL \(fig\) et al., EU:T:2022:818](#)

### **No objection for suspected partiality of a BoA member – Decision on objection**

There is no ground for suspected partiality (Article 169(3) EUTMR) where it is established that the objected member i) has neither represented one of the parties nor taken part in the decision under appeal, ii) has participated as one of three members of a cancellation division in taking a decision in different proceedings, a decision which can thus not be considered to be a personal statement made by that individual member, and iii) no personal interest of that member in the proceedings at hand has been alleged or shown (§ 23-24).

As provided in Article 169(4) EUTMR, the decision on the objection request must be taken without the participation of the member concerned who is, for this purpose, replaced by their alternate (§ 32).

[07/06/2023, T-239/22, Rialto, EU:T:2023:319](#)

### **Inadmissible observations in reply – Rejection of submissions after closure of the written procedure**

In accordance with Article 26(1) EUTMDR, the BoA may authorise the appellant to supplement the statement of grounds with a reply to the other party's observations. This authorisation may only be granted upon a reasoned request filed within 2 weeks of the notification of the response. In the absence of such a request, the observations in reply could be considered inadmissible, although the party had the opportunity to submit them (§ 40-43). The fact that these observations were placed on the file does not guarantee that they are admissible (§ 132).

[26/07/2023, T-638/21, DEVICE OF THE OUTLINE OF A BEAR \(fig.\), EU:T:2023:434](#)

### **Remittal to first instance – Remittal as regards two conditions of Article 8(4) EUTMR**

After taking a decision only as regards the first and second conditions provided for in Article 8(4) EUTMR, the BoA was entitled not to examine the third and fourth conditions provided for in Article 8(4) EUTMR and to decide to remit that examination to the CD (§ 68).

[26/07/2023, T-67/22, XTRADE \(fig.\) / X-trade brokers \(trade name\), EU:T:2023:436](#)

### **Subsidiary claim of acquired distinctiveness – No examination before the final decision on absolute grounds – Lack of BoA competence**

Where the EUTM applicant has made a subsidiary claim of acquired distinctiveness through use within the meaning of Article 7(3) EUTMR, this claim will only be examined once the decision declaring that an absolute ground for refusal is applicable, has become final (§ 30).

The BoA has no competence to examine that subsidiary claim in appeal proceedings against the examiner's decision pursuant to Article 7(1)(b) to (d) EUTMR. The BoA's statements relating to the subsidiary claim at that stage of the proceedings does not affect the legality of the BoA decision nor the subsequent examination of a such subsidiary claim (§ 31-32).

[17/01/2024, T-60/23, Ilovepdf, EU:T:2024:9](#)

#### **Remittal to first instance – Exercise of BoA's broad discretion**

The BoA has broad discretion to remit the case to first instance pursuant to Article 71(1) EUTMR, which can be reviewed by the GC for manifest errors of assessment only (§ 27-31).

[17/01/2024, T-800/22, BV \(fig.\) / 42 BELOW et al.](#)

#### **No objection for suspected partiality of a BoA member – Participation of the BoA member in another decision involving the EUTM proprietor – Participation in an IP association**

The mere fact that the BoA rapporteur was a member of another BoA that adopted the decision in another case, even if that other case involved a company whose managing director was the same as that of the contested EUTM proprietor, cannot be used to infer that the rapporteur was biased. Furthermore, in the absence of any other evidence of bias or personal prejudice on the part of the rapporteur against the EUTM proprietor, the fact that the BoA rapporteur and the invalidity applicant's lawyer are members of the same association for further education in the field of intellectual property, even if it is considered to be proven, is not capable of establishing the existence of a breach of the requirement of impartiality affecting the legality of the contested decision (§ 92, 93).

[17/01/2024, T-650/22, Athlet, EU:T:2024:11](#)

#### **EUIPO Guidelines – Non-binding effect**

It is apparent from the case-law that the EUIPO Guidelines are not binding legal acts for the purpose of interpreting provisions of EU law (§ 55).

[21/02/2024, T-765/22, LA CREME LIBRE \(fig.\) / LIBRE, EU:T:2024:106](#)

### **3.5 CORRECTION AND REVOCATION OF DECISIONS**

#### **Corrigendum of decisions – Article 102(1) EUTMR – Errors and manifest oversights**

The substitution of the list of goods covered by the earlier marks cannot be classified as a linguistic error nor an error of transcription, and it does not correspond to a manifest oversight that can justify the adoption of a corrigendum in accordance with Article 102(1) EUTMR (§ 38-39).

[24/10/2019, T-708/18, Flis Happy Moreno choco \(fig.\) / MORENO \(fig.\) et al., EU:T:2019:762, § 38-39](#)

[24/10/2019, T-498/18, Happy Moreno choco \(fig.\) / MORENO \(fig.\) et al., EU:T:2019:763, § 38-39](#)

#### **Revocation of decisions – Article 80(1) CTMR [now Article 103 EUTMR] – Obvious procedural error**

Any infringement of the obligation to state reasons, such as a failure to state reasons or an inadequate statement of reasons, constitutes a procedural error for the purposes of Article 80(1) CTMR [now Article 103 EUTMR], which should lead to the revocation by the Office of the decision vitiated by it where that error is obvious (§ 34).

31/10/2019, C-281/18 P, [REPOWER](#), EU:C:2019:916, § 34

### **Corrigendum of decisions – Article 102(1) EUTMR – Errors and manifest oversights**

Where a paragraph amounts to an erroneous restatement of what the BoA allegedly noted in an earlier passage of the contested decision and thus is the result of a manifest oversight (§ 34-38), it can be corrected according to Article 102 EUTMR (§ 39).

28/05/2020, T-724/18 & T-184/19, [AUREA BIOLABS \(fig.\) / Aurea et al.](#), EU:T:2020:227, § 39

### **Cancellation of an entry in the register which contains an obvious error attributable to the Office – Trade mark involved in insolvency proceedings – Duty of diligence – Registration of the transfer of the mark – Effects vis-à-vis third parties**

When dealing with a request for recordal of a transfer of an EUTM, the Office's competence is, in principle, confined to examining the formal requirements set out in Article 20 EUTMR and Article 13 EUTMIR and does not imply an assessment of substantive issues that may arise under the applicable national law (§ 61). However, the Office must diligently take into account facts that can have legal implications for the application for registration of such a transfer, including the existence of insolvency proceedings (§ 62-65, 68).

The duty of diligence is all the more imperative where, before receiving an application for registration of the transfer of an EUTM, the Office is informed – by an earlier request for recordal which has been submitted in accordance with Article 24(3) EUTMR – that that mark has been involved in insolvency proceedings. In such a case, the Office has to take into consideration the objective of 'guarantee[ing] the effectiveness' of the insolvency proceedings referred to in recital 36 of Regulation 2015/848 on insolvency proceedings, in particular if the existence, validity or particular date of that transfer is disputed by the liquidator. (§ 58, 69).

According to Article 27(1) EUTMR, transfers of an EUTM have effects vis-à-vis third parties only after entry in the EUTM register. Such an entry does not have retroactive effect (§ 64). Furthermore, according to Article 27(4) EUTMR the effects vis-à-vis third parties of insolvency proceedings are governed by national law (§ 65). Under the applicable Italian law, the insolvency proceedings at issue had the effect of making ineffective the formalities required to ensure that an act by the debtor was enforceable against third parties, since those formalities had been carried out after the declaration of insolvency. Consequently, the Office was required to suspend the registration of those transfers until the national court had examined the substance of the case (§ 72).

The Office made an obvious error within the meaning of Article 103 EUTMR by entering the successive transfers of the mark in the register on 16 April 2018, having failed to enter the insolvency proceedings concerning the proprietor of the mark at issue in the register. The result was that the entries of 16 April 2018 containing the obvious error had to be cancelled as soon as possible (§ 114-117).

22/09/2021, T-169/20, [Marina yachting](#), EU:T:2021:609, § 61, 58, 62-65, 68-69, 72, 114-117

22/09/2021, T-173/20, [Henry Cotton's and Henry Cotton's \(fig.\)](#), EU:T:2021:610, § 62, 59, 63-66, 68-10, 73, 115-118

### **Revocation of BoA decision taken by a single member – New BoA decision taken by three members – No obligation to change the reasoning**

Where the BoA decision has been revoked because it shall not have been taken by a single member, the correction of that obvious error does not necessarily imply a change in the outcome of the earlier decision or even its reasoning. The repetition of the reasoning of the earlier decision does not in itself establish that the case at issue was not re-examined (§ 22, 23).

**Translation error in the list of goods and services – Obvious error – No bearing on the outcome**

An error consisting in substituting a term from the list of goods and services, with another term (due to a translation error), does not have an impact on the legality of the decision, provided that the term which was de facto analysed by the BoA included the one that the trade mark was originally applied for (§ 28-32).

[21/12/2022, T-777/21, ECO STORAGE \(fig.\), EU:T:2022:846](#)

**Revocation of decisions – Article 103 EUTMR – Article 70 EUTMDR – No obvious error – No impact of the error on the outcome**

An error may only be classified as obvious where it can readily be detected, in the light of the criteria to which the legislature intended the administration's exercise of its discretion to be subject, and where the evidence adduced is sufficient to make that administration's assessment implausible and that assessment cannot be accepted as justified and consistent (§ 34). It is common ground that Rule 50(1) CTMIR is not applicable in the context of invalidity proceedings based on absolute grounds for invalidity (§ 38). However, as it has not been shown that the incorrect reference to Rule 50(1) CTMIR had an impact on the reasoning followed by the BoA or on its finding, that reference does not constitute an obvious error within the meaning of Article 103 EUTMR (§ 44).

[07/06/2023, T-519/22, FITNESS, EU:T:2023:314](#)

**Revocation of decisions – Article 103 EUTMR – Article 70 EUTMDR – No obvious error – Non-obviousness of the possible error**

The possible error, arising from the transposition of considerations related to the justification of the submission of additional evidence in the context of the application of Rule 22(2) CTMIR to a case governed by Rule 37(b)(iv) and Rule 39(3) CTMIR, cannot be categorised as obvious (§ 49). While those are indeed two different procedural contexts, they are nevertheless comparable in that, in both cases, the EUIPO establishes a time-limit for the submission of evidence and rejects the applications where that evidence is not submitted. Therefore, although they are different procedures, this cannot, by itself, constitute sufficient reason to consider that it is manifestly not possible to transpose the case-law relating to proof of use to invalidity proceedings (§ 52).

[07/06/2023, T-519/22, FITNESS, EU:T:2023:314](#)

### **3.6 ASSESSMENT OF EVIDENCE**

**Assessment of evidence in the proceedings before the BoA – Probative value of surveys – Probative value of sworn statements**

The probative value of a survey depends on the survey method used, inter alia, on the way in which the questions are formulated. The Board of Appeal was therefore correct to call into question the probative value of the provided survey on the ground that the questions asked led to 'unusual speculation' (§ 40-45).

Sworn statements by persons with close ties to the party concerned are of lower probative value than those of third parties and therefore cannot on their own constitute sufficient evidence. That is why the particulars in a written sworn statement by a person linked, in any manner whatsoever, to the company relying on it must, in any event, be supported by other evidence (§ 49).

02/03/2022, T-125/21, [Eurobic / BANCO BiG BANCO DE INVESTIMENTO GLOBAL \(fig.\) et al.](#), EU:T:2022:102, § 40-45, 49

### **Assessment of evidence in the proceedings before the BoA – Probative value – Friends’ opinions and of chats with colleagues**

The applicant refers to interviews with friends, social acquaintances and colleagues, which revealed that those persons had not yet seen the type of collar which is the subject-matter of the application for registration. However, those interviews have no probative value with regard to the distinctive character of the mark applied for. According to case-law, the probative value of an interview depends on the method of examination used. Neither the scope or extent of the surveys relied on by the applicant nor the unknown circumstances of their preparation allow the distinctive character of the mark applied for to be established throughout the European Union. Those surveys are limited to the applicant’s friends, acquaintances and colleagues. However, in assessing the distinctive character of the mark applied for, the relevant consumer must be the relevant consumer throughout the European Union (§ 38-40).

23/03/2022, T-252/21, [FORM EINES STEHKRAGENS \(3D\)](#), EU:T:2022:157, § 38-40

### **Probative value – Stakeholder association’s certificate reliable despite its president being related to the contested EUTM proprietor**

The certificates issued by Andema (association for the defence of trade marks) are to be signed by the Director-General of the association, not by the President. Andema’s President has a merely representative and administrative role, with no involvement in the issuance of certificates. Accordingly, regardless of whether the said President is related to the contested EUTM proprietor, Andema’s certificate appears to be reliable and to have evidential value (§ 65, 66).

26/07/2023, T-638/21, [DEVICE OF THE OUTLINE OF A BEAR \(fig.\)](#), EU:T:2023:434

## **3.6.1 Evidence found by the BoA on its own motion – Article 95(1) EUTMR**

### **Absolute grounds of refusal – Internet researches**

Having the same competences as the examiner, the BoA can rely, after hearing the party, on the existence of facts found through internet searches conducted after the filing date (§ 30-31). However, keeping in mind that the relevant date for the assessment of an absolute ground for refusal is the date on which the application for registration was filed, the GC takes into consideration only those documents that contain a date earlier than the filing date (§ 34-35).

13/02/2019, T-278/18, [DENTALDISK](#), EU:T:2019:86, § 34-35

### **Absolute grounds of refusal – Internet research**

Since the orthographic deviation is negligible, BoA did not err in conducting internet research on the correctly spelled sign ‘dental disc’, and was entitled to demonstrate by means of internet extracts that the expression ‘dental disc’ was descriptive (§ 51, 69). Descriptive use of the sign by only one operator already constitutes corroborating evidence of the descriptive nature of the sign (§ 70).

13/02/2019, T-278/18, [DENTALDISK](#), EU:T:2019:86, § 51, 69, 70

### **Absolute grounds for refusal – Discretion to accept belated evidence in invalidity proceedings – Examination of facts**

In invalidity proceedings concerning absolute grounds for refusal, the BoA cannot accept belated evidence on the grounds of public interest but must ascertain whether the two requirements of Article 27(4) EUTMDR are satisfied (§ 28).

In invalidity proceedings based on an absolute ground for refusal, as the registered EU trade mark is presumed to be valid, it is for the person who has filed the application for a declaration of invalidity to invoke before the Office the specific facts which call the validity of that trade mark into question. Therefore, the second sentence of Article 95(1) EUTMR, which consolidates the Court's previous case-law (13/092013, T-320/10, Castel, EU:T:2013:424, § 28), provides that, in invalidity proceedings pursuant to Article 59 of that regulation, the Office is to limit its examination to the grounds and arguments submitted by the parties (10/06/2020, T-105/19, DEVICE OF A CHEQUERBOARD PATTERN (fig.), EU:T:2020:258, § 23 and the case-law cited) (§ 40).

Although, in invalidity proceedings based on an absolute ground for refusal, the Office is to limit its examination to the grounds and arguments submitted by the parties, that does not, however, preclude the BoA, in its own examination of the facts, arguments and evidence submitted by the applicant for a declaration of invalidity, from reaching a different conclusion from that proposed by the latter. In that regard, it follows from Article 71(1) EUTMR that, through the effect of the appeal brought before it, the BoA may exercise any power within the competence of the department that was responsible for the contested decision and is therefore called upon, in this respect, to conduct a new, full examination as to the merits of the appeal, in terms of both law and fact (§ 42-43).

The BoA was therefore required to carry out an examination which was limited to the grounds and arguments of the parties, without prejudice to the possibility of taking well-known facts into account (§ 44).

02/06/2021, T-854/19; [Montana](#), EU:T:2021:309, § 40, 42-44

02/06/2021, T-855/19; [MONTANA \(fig.\)](#), EU:T:2021:310, § 40, 42-44

02/06/2021, T-856/19; [MONTANA \(fig.\)](#), EU:T:2021:311, § 40, 42-44

### **Opposition proceedings – Limitation of examination in inter partes proceedings**

Where reputation of the earlier mark is claimed by relying on an earlier decision of the Office recognising a specific strength of reputation, the Office's examination is restricted to whether or not that specific strength of reputation has been established (§ 93, 96-99).

19/05/2021, T-510/19, [DEVICE OF A JUMPING ANIMAL \(fig.\) / PUMA \(fig.\) et al.](#), EU:T:2021:281, § 93, 96-99

### **Opposition proceedings – No obligation to examine the earlier marks in a specific order**

Neither Article 95, Article 67 nor Article 71(1) EUTMR require the Office to examine the earlier marks on which the opposition is based in the order chosen by the party that filed the opposition (§ 33).

16/05/2019, T-354/18, [SKYFi/SKY et al.](#), EU:T:2019:33, § 33

### **Opposition proceedings – Bad faith is not analysed in opposition proceedings**

In opposition proceedings, the Office cannot examine whether the earlier mark has been registered in bad faith pursuant to Article 59(1)(b) EUTMR, even if the EUTM applicant claims that the earlier marks may have merely been identical re-filings in bad faith of marks previously filed (§ 46-48).

16/05/2019, T-354/18, [SKYFi/SKY et al.](#), EU:T:2019:33, § 46-48

### **Invalidity proceedings – Interpretation by the BoA of the nature of the trade mark – Colour mark – Issue of the nature of the contested mark not raised by the parties – Infringement of Article 95(1) EUTMR – Infringement of the right to be heard**

In the context of a declaration of invalidity, by virtue of the presumption of validity of the registered mark, the Office's obligation under Article 95(1) EUTMR to examine of its own motion the relevant facts which may lead it to apply absolute grounds for refusal is restricted to the examination of the EUTM application carried out by the examiners of the Office and, on appeal, by the BoA during the registration procedure of that mark. As the registered EUTM is presumed to be valid, it is for the person who has filed the application for a declaration of invalidity of that mark to invoke before the Office the specific facts that question the validity of that trade mark (see by analogy, 29/03/2019, T-611/17, REPRESENTATION D'UNE SEMELLE DE CHAUSSURE (3D), EU:T:2019:210, § 45 and the case-law cited) (§ 33).

At the *inter partes* stage of the application for a declaration of invalidity in the present case, the question of the nature of the contested mark was not a matter of fact or of law raised by the parties. Nor did that question concern relevant fact or essential procedural requirements. It was not necessary to resolve it to ensure the correct application of the EUTMR. The BoA had taken the issue of the nature of the contested mark into account and had already decided upon it in the context of the registration procedure (§ 37).

The presumption of validity of the registration cannot prevent the Office, *inter alia* in the light of what was put forward by the party questioning the validity of the contested mark, from relying not only on the arguments and evidence submitted by that party in support of its application for a declaration of invalidity, but also on the well-known facts identified by the Office during the invalidity proceedings (15/10/2020, T-48/19, smart:)things (fig.), EU:T:2020:483, § 69) (§ 38). However, in the present case, no evidence or well-known facts were submitted or relied on before the BoA (§ 39). In interpreting the trade mark application filed on 12 February 1998 of its own motion as relating to a figurative mark composed of a clearly defined contour, the BoA went beyond the pleas and arguments submitted by the parties, in infringement of the last sentence of Article 95(1) EUTMR, read in conjunction with Article 27(2) EUTMDR. In so doing, it exceeded its jurisdiction (§ 40).

The BoA did not question the parties on the issue of the nature of the contested mark which it raised of its own motion. In so doing, it infringed the applicant's right to be heard, within the meaning of Article 94(1) EUTMR and Article 41(2)(a) of the Charter of Fundamental rights (§ 46-52).



15/09/2021, T-274/20, [ORANGE \(fig.\)](#), EU:T:2021:592, § 33, 37-40, 46-52

### **Invalidity proceedings – Absolute grounds for refusal – Presumption of validity of the registered trade mark**

The BoA is not required to carry out of its own motion the examination of the absolute grounds for refusal which the examiner conducted. The EUTM is regarded as valid until it has been declared invalid following invalidity proceedings. Therefore, it is up to the applicant for a declaration of invalidity to produce the 'specific facts' capable of supporting its claim that the contested trade mark was devoid of any distinctive character at the relevant date (§ 26, 33, 35).

The mere existence of images on the internet does not demonstrate that golden bottles are widespread on the market (§ 33). The submitted evidence was not sufficient to support the claims as to the lack of distinctive character of the contested trade mark. The BoA is limited to considering the submitted evidence and cannot decide on the distinctive character of the trade mark as a whole on its own motion, since the registered trade mark enjoys the presumption of validity (§ 35).

08/05/2019, T-324/18, [BOTTIGLIA DORATA \(3D\)](#), EU:T:2019:297, § 26, 33, 35

### **Absolute grounds of invalidity – Burden of proof**

It is for the party making the application for a declaration of invalidity to rely, before the Office, on the specific elements that might call the validity of the mark into question (§ 59).

08/12/2021, T-294/20, [Kaas keys as a service](#), EU:T:2021:867, § 59

### **Invalidity proceedings – Absolute grounds for refusal – Well-known facts**

The presumption of validity of the EUTM cannot prevent the Office from relying on well-known facts observed by the Office in the invalidity proceedings (§ 46); neither can the rules on burden of proof (§ 134). The BoA inferred its conclusions from its internet searches. As the results obtained required a low degree of technical investigation, they may be regarded as capable of being well-known facts (§ 50, 53). The Office is not required to establish the accuracy of its internet searches (§ 55)

29/03/2019, T-611/17, [REPRESENTATION D'UNE SEMELLE DE CHAUSSURE \(3D\)](#), EU:T:2019:210, § 46, 50, 53, 55, 134

### **Invalidity proceedings – Absolute grounds for refusal – Well-known facts – Burden of proof**

The fact that the BoA took into account a well-known fact when finding that the mark at issue lacked inherent distinctive character in the context of invalidity proceedings is not contrary to the rules on the burden of proof (21/04/2015, T-360/12, Device of a chequerboard Pattern (grey), EU:T:2015:214, § 64-65) (§ 29).

10/06/2020, T-105/19, [DEVICE OF A CHEQUEROARD PATTERN \(fig.\)](#), EU:T:2020:258, § 29

### **Invalidity proceedings – Article 95(1) EUTMR – Well-known facts**

While the presumption of validity of the registration restricts the Office's obligation to an examination of the relevant facts, it does not preclude it, particularly in view of the elements put forward by the party challenging the validity of the mark, from relying, not only on those arguments and on any evidence produced by that party in its application for a declaration of invalidity, but also on well-known facts observed by the Office in the context of the invalidity proceedings (§ 128, 134).

12/02/2021, T-19/20, [I love \(fig.\)](#), EU:T:2021:17, § 128, 134

### **Invalidity proceeding – Burden of proof – Article 52 and 55 EUTMR – Article 71(1) EUTMR – Article 95(1) EUTMR – Article 127 EUTMR**

According to Articles 52 and 55 EUTMR, an EU trade mark is regarded as valid until it has been declared invalid following invalidity proceedings. It therefore enjoys a presumption of validity. Consequently, in the context of an application for a declaration of invalidity, it is for the person who has filed that application to invoke before the Office the specific facts that call the validity of that trade mark into question. Furthermore, the last sentence of Article 95(1) EUTMR provides that, in such proceedings, the Office is to limit its examination to the grounds and arguments submitted by the parties (§ 58).

In an appeal brought against a decision of the Cancellation Division (CD), the BoA is competent to assess all the evidence submitted before the CD (Article 71(1) EUTMR). In addition, according to Article 95(2) EUTMR, the BoA is able to take evidence into account that has been submitted for the first time before it (§ 59).

Article 127 EUTMR applies solely to proceedings brought before national courts acting as EU trade mark courts (§ 56).

19/01/2022, T-483/20, [Shoes \(3D\)](#), EU:T:2022:11, § 56, 58-59

### **Invalidity proceedings – Evidence – Well-known facts – Websites – General accessible sources provided that the information is not highly technical**

Well-known facts that can be taken into account *ex officio* are facts that are likely to be known by anyone or that may be learned from generally accessible sources (22/06/2004, T-185/02, Picaro, EU:T:2004:189, § 29). Well-known facts can be taken into account (§ 67).

Websites can be categorised as generally accessible sources, provided that the items of information in question are not deemed to be highly technical and thus may constitute well-known facts (29/03/2019, T-611/17, REPRESENTATION D'UNE SEMELLE DE CHAUSSURE (3D), EU:T:2019:210, § 52 and case-law cited) (§ 68).

19/01/2022, T-483/20, [Shoes \(3D\)](#), EU:T:2022:11, § 67-68

### **Examination of the facts by the Office of its own motion when assessing absolute grounds for refusal**

Since the BoA must examine all relevant factual and legal circumstances of the individual case carefully and impartially, it is in line with its duty of care that it also examines the facts put forward by the EUTM applicant. Therefore, the BoA cannot be criticised for also assessing the norms of the sector on the basis of the facts put forward by the EUTM applicant itself (§ 47-52).

[06/09/2023, T-277/22, POSITIONSMARKE BESTEHEND AUS DEN FARBEN ROT UND WEISS AUF EINER QUADERFÖRMIGEN VERPACKUNG, EU:T:2023:498](#)

See also, [06/09/2023, T-276/22, POSITIONSMARKE BESTEHEND AUS DEN FARBEN WEISS, MITTELROT UND DUNKELGRÜN AUF EINER QUADERFÖRMIGEN VERPACKUNG, EU:T:2023:497, § 49-54](#)

## **3.6.2 Discretionary power and belated evidence – Article 95(2) EUTMR**

### **Proof of use – Discretionary power**

The BoA is not prohibited from taking account of additional evidence which is submitted after the expiry of the period that it has initially set, due to its discretionary power, Article 76(2) CTMR [now Article 95(2) EUTMR] (§ 52, 55). When genuine use must be established with regard to two relevant periods (the five-year period before the cancellation application and the five-year period before the publication of the application of the contested EUTMR), the evidence relating to one of the relevant periods, even if it is submitted late, is, in addition to the initial evidence forwarded within the time limits, relating to the other relevant period (§ 56) and does not constitute new evidence (§ 57, 59).

20/03/2019, T-138/17, [PRIMED / GRUPO PRIM \(fig\) et al.](#), EU:T:2019:174, § 56-57, 59

### **Reputation of the earlier marks recognised in previous decisions – Additional evidence**

Where an opposition is based on Article 8(5) CTMR [now Article 8(5) EUTMR], the opponent is free, in principle, to choose the form of evidence it considers useful to submit to the Office, pursuant to Rule 19(2)(c) CTMIR [now Article 7(2)(f) EUTMDR]. Thus, the opponent is free to rely, as evidence of the reputation of the earlier mark relied upon, on one or several previous decisions of the Office finding that that mark enjoys a reputation. The Office is required to take into account those decisions, when they are identified in a precise manner in the notice of

opposition (28/06/2018, C-564/16 P, DEVICE OF A JUMPING ANIMAL (fig.) / PUMA (fig.) et al., EU:C:2018:509, § 69) and to consider whether or not it should decide in the same way and, if not, to provide an explicit statement of its reasoning for departing from those decisions, stating why they are no longer relevant (§ 30-31, 35, 44, 46, 50). When, under such circumstances, additional evidence is filed with the statement setting out the grounds of appeal, it cannot be excluded as inadmissible as new evidence submitted out of time (§ 51, 62).

22/05/2019, T-161/16, [CMS Italy \(fig.\) / PUMA \(fig.\) et al.](#), EU:T:2019:350, § 30-31, 35, 44, 46, 50, 51, 62

### **Invalidity proceedings – Absolute grounds for refusal – Discretionary power**

Evidence submitted in due time for the first time before the BoA in invalidity proceedings, that is either evidence supplementary to that submitted in the proceedings before the CD or evidence on a new matter that could not be raised during those proceedings, is not automatically admissible. It is for the party presenting that evidence to justify why that evidence has been submitted at that stage of the proceedings and demonstrate that submission during the proceedings before the CD was impossible. Accordingly, it is for the BoA to assess the merits of the reasons put forward by the party that has submitted that evidence in order to exercise its discretion as to whether or not it should be taken into account (§ 44).

The BoA has discretion to disregard facts or evidence pursuant to Article 76(2) CTMR [now Article 95(2) EUTMR] when they have been produced late (§ 46). The BoA erroneously found that it followed from the judgment of the CJ on appeal and the annulment judgment of the GC that it was required to take the evidence into account. Therefore, the BoA infringed Article 65(6) CTMR [now Article 72(6) EUTMR] and failed to comply with its obligation to exercise its discretion according to Article 76(2) CTMR [now Article 95(2) EUTMR] and its obligation to state the reasons on which its decision on the taking into account of that evidence was based (§ 46-48).

10/10/2019, T-536/18, [FITNESS](#), EU:T:2019:737, § 44, 46-48

### **Renewal certificate submitted for the first time before the BoA – Discretion to accept belated evidence – Article 27(4) EUTMDR**

The applicant did not dispute that the renewal certificate was relevant to the proceedings and that the purpose of the submission of the renewal certificate was to contest the finding that the Cancellation Division had made of its own motion, namely that the earlier mark no longer existed during the relevant period of time. By agreeing to take the renewal certificate into account on the basis of that justification, the BoA complied with the two cumulative requirements laid down in Article 27(4) EUTMDR and, consequently, exercised its discretion correctly (§ 26-30).

27/10/2021, T-356/20, [Racing Syndicate \(fig.\) / Syndicate](#), EU:T:2021:736, § 26-30

### **Evidence filed for the first time before BoA – Discretion to accept belated evidence – Article 27(4) EUTMDR**

Within the context of Article 27(4) EUTMDR, supplementary evidence is characterised by a link with other evidence previously submitted in due time that it supplements (§ 40) (14/05/2019, T-89/18 and T-90/18, CAFE DEL SOL (fig.) / CAFE DEL SOL (fig), EU:T:2019:331, § 42).

The fact that the number of items of evidence submitted for the first time before the BoA is considerably higher than that of the items of evidence submitted before the Cancellation Division does not make that evidence inadmissible. Nothing in the law suggests that evidence submitted for the first time before the BoA should be rejected where its number or volume exceeds a certain threshold (§ 44-45).

19/01/2022, T-76/21, [Pomodoro](#), EU:T:2022:16, § 42, 44-45

### **Belated evidence – Article 95(2) EUTMR – Article 27(4) EUTMDR – Burden of proof**

It is for the party submitting evidence for the first time before the BoA to explain to what extent that submission satisfies the conditions laid down in Article 27(4) EUTMDR (10/10/2019, T-536/18, FITNESS, EU:T:2019:737, § 42-43) (§ 57-59).

06/10/2021, T-254/20, [DEVICE OF A LOBSTER \(fig.\)](#), EU:T:2021:650, § 57-59

### **Relevant point in time for submitting proof of use in revocation proceedings**

Proof of use in revocation proceedings has to be filed within the period set by the Cancellation Division in accordance with Rule 40(5) CTMIR [now Article 19(1) EUTMDR]. Any submission made after the expiry of that period is not submitted in due time within the meaning of Article 95(2) EUTMR (§ 64-69) and, where filed for the first time in the appeal proceedings before the BoA, within the meaning of Article 27(4) EUTMDR (§ 39).

09/02/2022, T-520/19, [Heitec](#), EU:T:2022:66, § 39

### **Duty to state clearly, precisely and unequivocally the relevance of evidence submitted out of time**

Where evidence of use is not submitted in due time, the trade mark owner has the duty to state its relevance (Article 27(4)(a) EUTMDR) in a clear, precise and unequivocal manner (§ 45). This requirement is not met by a general statement that, in conjunction with the evidence submitted in time, would prove such relevance (§ 46, 49).

09/02/2022, T-520/19, [Heitec](#), EU:T:2022:66, § 46, 49

### **Burden of proof for establishing genuine use exists independently of any submission to the contrary made by the revocation applicant**

The owner of a trade mark, and not the EUIPO acting *ex officio*, has the burden of establishing genuine use of that trade mark, irrespective of the applicant's argument for revocation (§ 47).

09/02/2022, T-520/19, [Heitec](#), EU:T:2022:66, § 47

### **The BoA's discretionary power to accept evidence submitted out of time is circumscribed by the two cumulative conditions set out in Article 27(4) EUTMR**

As regards facts and evidence submitted for the first time before the BoA, the exercise of the discretion provided for in Article 95(2) EUTMR is circumscribed by the two cumulative conditions set out in Article 27(4) EUTMR (§ 36, 53).

09/02/2022, T-520/19, [Heitec](#), EU:T:2022:66, § 36, 53

### **The merely supplementary nature of evidence submitted out of time does not necessarily justify, of itself, its admissibility before the BoA**

The complementary nature of a piece of evidence submitted late is only a necessary condition for having to decide on the question of the consideration of such evidence. It is not a sufficient condition for its actual consideration. The rejection of evidence submitted out of time can result from other factors, in particular from the failure of the party submitting that evidence to properly conduct the proceedings (§ 73).

09/02/2022, T-520/19, [Heitec](#), EU:T:2022:66, § 73

### **Admissibility of belated evidence – Link between proof of enhanced distinctiveness and proof of use**

Proof of use and proof of enhanced distinctiveness or of reputation are indissociably linked. Only an excessive and illegitimate formalism would dictate that the evidence of use could not be adduced as proof of enhanced distinctiveness or of reputation. BoA exercises its discretion in deciding that it is appropriate to take that evidence into consideration and in finding that that evidence is genuinely relevant (§ 81).

Moreover, Article 27(4) EUTMDR is not applicable, as there are no 'facts or evidence submitted for the first time before BoA' since the evidence of use in question was submitted before OD (§ 83).

*04/05/2022, T-4/21, [ASI ADVANCED SUPERABRASIVES \(fig.\) / ADI \(fig.\) et al.](#), EU:T:2022:274, § 81, 83*

### **Invalidity proceedings – Admissibility of belated evidence – Complementary evidence of use**

When proof of use is requested in invalidity proceedings, belated evidence relating to only one of the two relevant periods of use is deemed to be complementary within the meaning of Article 27(4)(b) EUTMDR, provided that some evidence of use was filed within the time limits, even if it relates only to the other relevant period of use (§ 93, 96, 97, 104, 112).

*[23/11/2022, T-515/21, Euphytos / EuPhidra \(fig.\)](#), EU:T:2022:722*

### **Lack of reasoning – Exercise of discretionary power to accept belated evidence**

The BoA must exercise its discretion to take account of facts and evidence adduced for the first time before it in a reasoned manner and taking due account of all the relevant circumstances. Moreover, the question of admissibility of facts and evidence submitted for the first time before the BoA constitutes a necessary preliminary step before examining those facts or evidence for the purposes of an appeal (§ 36-39). The mere fact that the parties have not submitted any comments regarding the admissibility of facts and evidence provided for the first time before the BoA does not exempt it from the obligation to provide reasoning as regards admissibility of those facts and evidence (§ 57).

*[30/11/2022, T-611/21, Remote controls \[wireless\] \(Accessories for -\)](#), EU:T:2022:739*

*[30/11/2022, T-612/21, Remote controls \[wireless\] \(Accessories for -\)](#), EU:T:2022:731*

### **Facts and evidence submitted for the first time before the BoA – Duty to explain the submission not made in due time**

The party submitting facts and evidence for the first time before the BoA (Article 95(2) EUTMR) is under the duty to explain before it to what extent that submission satisfies the conditions laid down in Article 27(4) EUTMDR which circumscribe the BoA's discretionary power to accept belated facts and evidence (§ 43, 48, 50).

*[01/02/2023, T-772/21, efbet \(fig.\)](#), EU:T:2023:36*

### **Argument raised for the first time before the BoA – No valid reasons – Not supplementing facts and evidence submitted in due time**

The EUTM owner's claim to have established genuine use for some of the goods and services challenged by the application for revocation – and which was submitted for the first time before

the BoA – does not qualify as an argument that merely supplements facts and evidence submitted in due time for the purpose of Article 27(4) EUTMDR (§ 45).

[01/02/2023, T-772/21, efbet \(fig.\), EU:T:2023:36](#)

### **Admissibility of belated evidence – No relative quantitative restriction on belated evidence**

There is nothing in Article 27(4) EUTMDR or in any other provision of that regulation, or in the EUTMR, to indicate that evidence submitted for the first time before the BoA should be rejected where the number of such items of evidence or their volume exceeds a certain threshold. Therefore, if that evidence satisfies the conditions laid down in Article 27(4) EUTMDR, the BoA may accept it (§ 30).

[12/07/2023, T-325/22, Terylene / Terralene, EU:T:2023:397](#)

### **Supplementary evidence – Proof of the continued existence of the earlier right**

In order to admit new evidence before the BoA, it suffices that some evidence seeking to prove the continued existence of the use of the trade name at issue was submitted before the CD (§ 32). It is not necessary that the party concerned be unable to submit evidence before the CD for additional evidence of use of the trade name at issue, produced for the first time before the BoA, to be taken into account. An interpretation to the contrary of Article 95(2) EUTMR and of Article 27(4) EUTMDR is likely to restrict the discretion granted to the BoA under those provisions and to adversely affect the principles of legal certainty and of sound administration justifying that discretion (§ 33).

[26/07/2023, T-67/22, XTRADE \(fig.\) / X-trade brokers \(trade name\), EU:T:2023:436](#)

### **Belated evidence – Burden of proof**

It is for the party submitting facts and evidence for the first time before the BoA to explain to what extent that submission satisfies the conditions laid down in Article 27(4) EUTMDR (§ 28). The statement that the evidence submitted before the BoA '[was] merely supplementing relevant facts and evidence which [had] already been submitted in due time' cannot justify its late submission. Such a statement does not enable the BoA to know, for the purpose of exercising its discretionary power, the reasons why the applicant had not been in a position to submit that evidence in due time (§ 33).

[13/09/2023, T-549/22, PROLACTAL / Proláctea \(fig.\) et al., EU:T:2023:538](#)

### **Belated evidence – Supplementary evidence**

Where the coexistence of the marks has been argued before the OD, but no evidence in support of that claim was submitted, the evidence submitted for the first time before the BoA in relation to that coexistence does not constitute supplementary evidence (§ 32).

[13/09/2023, T-549/22, PROLACTAL / Proláctea \(fig.\) et al., EU:T:2023:538](#)

### **Belated evidence – Proof of use – Evidence prima facie not relevant for the outcome**

Where belated evidence is not such as to establish that the goods covered by the mark at issue have been marketed under that mark, the first condition provided for in Article 27(4)(a) EUTMDR is not fulfilled (i.e. that the evidence is not, on the face of it, likely to be relevant for the outcome of the case) (§ 41-43).

[04/10/2023, T-510/22, Tante Mitzi Caffè CAFFÈ - STRUDEL - BARETTO \(fig.\), EU:T:2023:605](#)

### **Belated evidence – Evidence not relevant for the outcome – Lack of explanation on the relevance of the new evidence by the party submitting it**

The party submitting facts and evidence for the first time before the BoA must show how that submission satisfies the conditions laid down in Article 27(4) EUTMDR. Despite being expressly requested to do so by the BoA rapporteur, the applicant did not explain which specific parts of the new and voluminous evidence were relevant to the appeal proceedings and what conclusions could be drawn from it for the present case. Therefore, the BoA was able to find that this evidence was not to be taken into account under Article 27(4)(a) EUTMDR as, *prima facie*, not relevant to the outcome of the case (§ 65, 67).

[17/01/2024, T-650/22, \*Athlet\*, EU:T:2024:11](#)

### **Belated evidence before the first instance – Valid reasons for late submissions**

The fact that the evidence of use, filed within the prescribed time limit, was disputed may justify the submission of further evidence, together with the observations in reply. Where supplementary evidence was produced before the CD in reply to observations disputing the evidence initially produced within the prescribed time limit, it was therefore without manifest error that the BoA decided to take it into consideration in support of its assessment, pursuant to Article 10(7) EUTMDR (§ 30).

[24/01/2024, T-562/22, \*NOAH \(fig.\)\*, EU:T:2024:23](#)

### **3.6.3 Distortion of facts in the BoA decision**

[No key points available yet.]

## **3.7 PRINCIPLES OF UNION LAW**

### **Preliminary ruling – Principles of legal certainty and the protection of legitimate expectations – Application *ratione temporis***

The substantive rules of EU law must be interpreted as applying to situations existing before their entry into force only insofar as it clearly follows from their terms, objective or general scheme that such effect must be given to them (§ 30).

[14/03/2019, C-21/18, \*Textilis\*, EU:C:2019:199, § 30](#)

### **Application *ratione temporis* – Substantive rules – Procedural rules – Distinction**

The date on which the application for registration was filed is decisive for the purposes of identifying the applicable substantive law (05/10/2004, C-192/03 P, BSS, EU:C:2004:587, § 42 and 23/04/2020, C-736/18 P, GUGLER (fig.) / GUGLER FRANCE, EU:C:2020:308, § 3 and case-law cited) (§ 17). Procedural rules are generally held to apply on the date on which they enter into force (11/12/2012, C-610/10, Commission v Spain, EU:C:2012:781, § 45 and case-law cited) (§ 19).

[19/01/2022, T-483/20, \*Shoes \(3D\)\*, EU:T:2022:11, § 17, 19](#)

### **Application *ratione temporis* – Procedural rules – Substantive rules – Distinction**

According to settled case-law, procedural rules are generally held to apply from the date on which they enter into force, as opposed to substantive rules, which are usually interpreted as applying

to situations existing before their entry into force only insofar as it follows clearly from their terms, their objectives or their general scheme that such effect must be given to them (§ 18-24).

06/06/2019, T-220/18, [Battistino \(fig.\) / BATTISTA et al.](#), EU:T:2019:383, § 18-24

### **Application *ratione temporis* of substantive rules**

The absolute grounds for refusal to register a trade mark or to declare the invalidity of a previously registered trade mark must be applied in accordance with the valid version of the Regulation at the date of the filing of the application for registration (§ 16-18).

08/05/2019, T-324/18, [BOTTIGLIA DORATA \(3D\)](#), EU:T:2019:297, § 16-18

### **Application *ratione temporis* of substantive rules – Date of filing – Priority date – Date of filing of proof of use**

The filing date of the application is relevant (08/05/2014, C-591/12 P, Bimbo Doughnuts, EU:C:2014:305, § 12; 18/06/2020, C-702/18 P, PRIMART Marek Łukasiewicz (fig.) / PRIMA et al., EU:C:2020:489, § 2). The priority date is the date of filing, according to Article 29(1) and Article 31 CTMR (now Article 34(1) and Article 36 EUTMR), which means that Article 42 CTMR applies. However, Article 10 EUTMDR applies, according to Article 82(2)(d) EUTMDR, since the request for proof of use of the earlier mark was filed after 1 October 2017 (§ 17).

10/11/2021, T-353/20, [ACM 1899 AC MILAN \(fig.\) / Milan et al.](#), EU:T:2021:773, § 17

### **Principle of legality – Principle of equal treatment – Principle of sound administration – References to other EUTMs / identical national marks**

As to the Office's practice in similar cases, although the Office is required to exercise its powers in accordance with the general principles of EU law and must take into account the decisions already taken on similar applications, the application of those principles must be reconciled with respect for the principle of legality (§ 39-43). Previous decisions at national level are irrelevant, since the EU trade mark regime is an autonomous system (§ 46).

05/02/2019, T-88/18, [ARMONIE](#), EU:T:2019:58, § 39-43, 46

10/10/2019, T-832/17, [achtung! \(fig.\)](#), EU:T:2019:2, § 67-69; 03/09/2020, C-214/19 P, [achtung! \(fig.\)](#), EU:C:2020:632, § 45

26/03/2019, T-787/17, [GlamHair](#), EU:T:2019:192, § 52

04/04/2019, T-804/17, [DARSTELLUNG VON ZWEI SICH GEGENÜBERLIEGENDEN BÖGEN \(fig.\)](#), EU:T:2019:218, § 30

28/03/2019, T-829/17, [RAPPRESENTAZIONE DI UNA FORMA CIRCOLARE, FORMATA DA DUE LINEE OBLIQUE SPECULARI E LEGGERMENTE INCLINATE DI COLORE ROSSO \(fig.\)](#), EU:T:2019:199, § 85-87

14/02/2019, T-123/18, [DARSTELLUNG EINES HERZENS \(fig.\)](#), EU:T:2019:95, § 37

11/04/2019, T-226/17, [Rustproof System ADAPTA](#), EU:T:2019:246, § 59

08/05/2019, T-469/18, [HEATCOAT](#), EU:T:2019:302, § 46-53

22/09/2021, T-250/20, [AIRSCREEN \(fig.\)](#), EU:T:2021:602, § 62-65, 70

### **Principle of equality of arms – Well-known facts**

The BoA may raise well-known facts for the first time without infringing the principle of equality of arms (03/05/2018, T-463/17, RAISE, EU:T:2018:249, § 21, 30) (§ 50).

10/06/2020, T-105/19, [DEVICE OF A CHEQUERBOARD PATTERN \(fig.\)](#), EU:T:2020:258, § 50

### **Obligation of the Office, including the BoA, to adopt decisions within a reasonable time**

The excessive length of the administrative procedure cannot be remedied by the annulment of the decision if it has no impact on the outcome of the dispute (§ 92).

29/03/2019, T-611/17, [REPRESENTATION D'UNE SEMELLE DE CHAUSSURE \(3D\)](#), EU:T:2019:210, § 92

### **No infringement of principle of effective judicial protection – Decision of suspension – Possibility of bringing an action against inappropriate length of the BoA proceedings**

The [RCD] proprietor has the opportunity of relying on the possible unlawfulness of the BoA's decision to suspend the proceedings within an action before the GC, directed against the final decision of the BoA. If it considers, at the end of the proceedings before the BoA, that the Office has infringed its obligations with regard to the duration of the proceedings, it will be able to assert its rights by bringing an action that it deems appropriate for that purpose (15/03/2019, T-410/18, *Silgan Closures and Silgan Holdings v Commission*, EU:T:2019:166, § 27). Consequently, the inadmissibility of the present action does not result in a lack of effective judicial protection for the applicant (§ 27, 28).

15/07/2020, T-838/19 to T-842/19, [Fluid distribution equipment](#), EU:T:2020:343, § 27-28

### **Free movement of goods – No infringement of Articles 34-36 TFEU in case of correct application of the EUTMR**

A correct application of the EUTMR is incapable of comprising an infringement of Articles 34-36 TFEU (§ 108).

26/01/2022, T-498/20, [WOOD STEP LAMINATE FLOORING \(fig.\) / Step](#), EU:T:2022:26, § 108

### **Protection of legitimate expectations – Reclassification of the goods**

The fact that the EUIPO registered the contested mark in respect of the goods referred to in the request for reclassification gives rise to a legitimate expectation, with regard to the proprietor of that mark and other market participants, that that mark will be protected only in respect of those goods (§ 62). In this revocation proceedings, the BoA was right to disregard both the initial application for registration of the contested mark and the circumstances relating to the reclassification of the goods in question, which was initiated by the EUIPO but accepted by the EUTM proprietor (§ 60, 63).

26/04/2023, T-794/21, [Mouldpro](#), EU:T:2023:211

## **3.8 COSTS**

### **Rule 94 CTMIR [now Article 109 EUTMR]**

The flat rate of EUR 1 000 for representation and cancellation proceedings can only be awarded to the winning party if this party has participated in the administrative proceedings (§ 60).

27/03/2019, T-265/18, [Formata \(fig.\) / Formata \(fig.\) et al.](#), EU:T:2019:197, § 60

### **Costs – Award of representation costs reimbursement**

Where a party took part in the administrative proceedings, albeit to a limited extent, but to an extent which attests to the fact that it had been informed of the proceedings and had even asked itself to participate more actively, for instance, if its representative intervened once to request an

extension of a time limit, remained the same throughout the entire proceedings, and could receive all documents communicated in that respect, the fact that the said party did not submit any observations before the OD or before the BoA is insufficient to find that that party has not incurred representation costs, which have not been warranted and may be arbitrarily fixed by the BoA to the losing party pursuant to and within the limits of Article 109 EUTMR and Article 18 EUTMIR (§ 61, 66-67).

[24/05/2023, T-509/22, BimboBIKE \(fig.\) / BIMBO et al., EU:T:2023:281](#)

## 4 PROCEEDINGS IN FIRST INSTANCE

### 4.1 ESSENTIAL PROCEDURAL REQUIREMENTS

#### 4.1.1 Duty to state reasons

[No key points available yet.]

#### 4.1.2 Right to be heard

[No key points available yet.]

#### 4.1.3 Res judicata

##### **Res judicata – Conversion request**

In order to ensure legal certainty and the stability of legal relations and the proper administration of justice after all legal action has been exhausted or after the expiry of the relevant time limits for appeal, it is no longer possible to call into question court decisions that have become final. Therefore, in the proceedings concerning request for conversion, it is not possible to re-examine the evidence already assessed by the BoA and GC in the proceedings concerning revocation for non-use (§ 67, 68).

[29/06/2022, T-337/20, bittorrent, EU:T:2022:406](#)

#### 4.1.4 Other

##### **No obligation to provide information on legal remedies**

Although the revocation decision concerning the request for conversion did not include information on the right to appeal, such a deficiency did not constitute a breach of rights which could have led to the annulment of that decision. In any event, notwithstanding the lack of information on the right of appeal, the party to the proceedings had effectively brought an appeal before the BoA against the revocation decision (§ 90).

[29/06/2022, T-337/20, bittorrent, EU:T:2022:406](#)

##### **Reference to the principles of procedural law generally recognised in the Member States**

Article 107 EUTMR applies only in the event of a lacuna or ambiguity in the procedural provisions in the EUTMR or in acts adopted pursuant to that regulation (§ 46-50).

[18/01/2023, T-758/21, Clavis /Clavis, EU:T:2023:3](#)

## **No discretion to accept belated evidence as regards absolute admissibility requirements**

The possibility provided for in Article 95(2) EUTMR for parties to proceedings before the EUIPO to submit facts and evidence after the expiry of the periods specified for that purpose is conditional upon there being no provision to the contrary. Article 5(3) EUTMDR constitutes an express provision to the contrary, according to which the rejection of the opposition is mandatory and not merely an option subject to the EUIPO's discretion. Thus, the EUIPO's discretion under Article 95(2) EUTMR does not apply to the conditions of admissibility of the opposition laid down in Article 5(3) EUTMDR (§ 58, 61).

[18/01/2023, T-758/21, Clavis /Clavis, EU:T:2023:3](#)

## **4.2 EX PARTE PROCEEDINGS**

### **4.2.1 Trade mark cases**

[No key points available yet.]

#### **4.2.1.1 Admissibility**

[No key points available yet.]

#### **4.2.1.2 Time limits, form, means of communication**

[No key points available yet.]

#### **4.2.1.3 Other procedural questions**

- Repetitive filings and confirmatory decisions

## **No confirmatory decision in the context of different opposition proceedings**

An action against a confirmatory decision is inadmissible as it merely confirms an earlier decision not challenged in due time. A decision is regarded as a mere confirmation of an earlier one if it contains no new factors compared with the earlier decision and if it was not preceded by any re-examination of the situation of the addressee of that earlier decision (§ 38-39). However, a decision cannot be regarded as 'confirmatory' of a decision adopted by the OD in the context of different opposition proceedings concerning the same parties and the same trade marks, in particular when it concerns the genuine use of the earlier mark or the conceptual comparison, which can vary depending on the relevant public and also over time (§ 40-42).

07/11/2019, T-380/18, [INTAS / INDAS \(fig.\) et al.](#), EU:T:2019:782, § 38-42

- Seniority

## **Seniority – Conditions for the admissibility of the seniority claim**

In view of the consequences of claiming seniority of an identical earlier national trade mark under Articles 39 and 40 EUTMR, which derogate from the principle that the proprietor of such a trade mark loses the rights conferred by it in the event of non-renewal of its registration, the conditions under which such a claim may be allowed must be interpreted restrictively (§ 23).

According to the wording of Article 40(1) EUTMR, the identical earlier national trade mark whose seniority is claimed by the proprietor of the EU trade mark must, depending on the language version, be a trade mark 'registered' in a Member State or a trade mark which is 'registered' in a Member State. This wording in the present indicative makes it clear that the identical earlier national trade mark whose seniority is claimed in favour of the EU trade mark must be registered at the time the claim of seniority is made (§ 24-25).

Therefore, the applicant's argument that Article 40 EUTMR, read in conjunction with Article 39 EUTMR, simply requires that the earlier national mark must have been registered at some time in the past to prevent the claim of seniority from being based only on a mark in use, is unfounded (§ 26).

It follows from all of the foregoing that the BoA did not err in law when it interpreted Article 40 EUTMR, read in conjunction with Article 39 EUTMR, as meaning that the identical earlier national trade mark whose seniority is claimed in favour of a subsequently registered EU trade mark must itself be registered and in force at the time the application for seniority is made (§ 40).

06/10/2021, T-32/21, [Muresko](#), EU:T:2021:643, § 23-26, 40

- **Costs**

[No key points available yet.]

## **4.2.2 Design cases**

[No key points available yet.]

### **4.2.2.1 Admissibility**

[No key points available yet.]

### **4.2.2.2 Time limits, form, means of communication**

[No key points available yet.]

### **4.2.2.3 Other procedural questions**

#### **Representative's authorisation – Authorisation covering all steps related to the RCD, including the renewal**

A representative's capacity to act on behalf of the RCD holder covers all procedural steps relating to the RCD; in particular, all the acts necessary to complete the renewal procedure for the RCD (§ 42). In principle, any authorisation, whether in writing or not, is deemed to be of general scope, unless there is an express statement, in writing or otherwise, as to its limits. The interpretation of 'authorisation' adopted by the Court of Justice in the field of trade marks (30/09/2010, C-479/09 P, DANELECTRO, EU:C:2010:571, § 38) applies, by analogy, to the field of designs (§ 46).

[20/09/2023, T-616/22, Cooking devices, EU:T:2023:576](#)

## 4.3 INTER PARTES PROCEEDINGS

### 4.3.1 Trade mark cases

#### 4.3.1.1 Opposition proceedings

- Admissibility of an opposition, time limits and form, means of communication

#### **Clear identification of the earlier mark**

An earlier mark is to be identified clearly in the respective field of the opposition notice. Allegations made in other parts of the form, in particular not made in the language of proceedings, cannot be taken into account (§ 50-51).

13/02/2019, T-823/17, [Etnik / ETNIA](#), EU:T:2019:85, § 50-51

#### **Entitlement to file an opposition – Article 46(1) EUTMR**

When an opponent has not proved that it was entitled to file an opposition as an authorised licensee of the proprietor of an earlier trade mark, but it was the proprietor of another earlier mark on which the opposition was based, it can, in that capacity, file an opposition against the mark applied for (§ 25-27).

16/05/2019, T-354/18, [SKYFi / SKY et al.](#), EU:T:2019:33, § 25-27

#### **Licensee's entitlement to file the opposition – Proof of entitlement – Belated evidence in the proceedings before the BoA – Lack of reasoning**

Proof of the licensee's entitlement to file an opposition must be submitted during the substantiation period (§ 47). The proprietor's authorisation cannot be presumed from the mere existence and registration of a licence if this licensee (exclusive or not) does not explicitly address the licensee's right to file oppositions (§ 50). On the facts of the case, such proof could not be deduced from the following circumstances: (i) the proprietor of the earlier EU marks and the opponent are members of the same group of companies and are economically linked (§ 53, 62); (ii) the two companies have the same representative before the Office; (iii) the application to register the licence was submitted through that common representative, who also filed the opposition; (iv) the EUTM proprietor and its licensee are owners of parallel marks in the UK (§ 63) and (v) the EUTM applicant never challenged, either before the OD or in the appeal against the OD's decision, the opponent's entitlement to file the opposition during the administrative proceedings (§ 61). The BoA violated its duty to state reasons in failing to take position on whether proof of the licensee's entitlement was admissible for the first time on appeal (§ 59, 79-80).

30/06/2021, T-15/20, [Skyliners / Sky et al.](#), EU:T:2021:401, § 47, 50, 53, 59, 61-63, 79-80

#### **No invocation of prior rights upon expiry of the opposition period**

Trade marks cannot be validly invoked for the first time after the expiry of the opposition period (Article 46(1) EUTMR) as the basis of an opposition (§ 29).

07/03/2022, T-382/21, [airscreen \(fig.\) / Airscreen](#), EU:T:2022:128, § 29

#### **Earlier right according to Article 8(4) EUTMR**

An allegation of unfair competition cannot serve as a basis for opposition under Article 8(4) EUTMR (§ 60).

06/04/2022, T-118/21, [Halix records / HALIX RECORDS Edition of CILEM RECORDS INTERNATIONAL et al.](#), EU:T:2022:214, § 60

### **Clear identification of the earlier right**

The notice of opposition must contain a clear identification of the earlier mark on which the opposition is based. The elements that are necessary to clearly identify the earlier mark on which the opposition is based in the notice of opposition are apparent from Article 2(2)(b)(i) EUTMDR, and include, inter alia, an indication of the registration number of that mark. The BoA cannot be asked to carry out further research to identify the earlier right (§ 29, 33, 34).

[18/01/2023, T-758/21, Clavis /Clavis, EU:T:2023:3](#)

### **Incorrect identification of an earlier right**

If the contested trade mark application is indicated as a basis of the opposition in the notice of opposition, this cannot constitute an earlier right. In such a case, no earlier right is deemed to have been clearly identified for the purposes of Article 2(2)(b)(i) EUTMDR (§ 32).

[18/01/2023, T-758/21, Clavis /Clavis, EU:T:2023:3](#)

### **Absolute admissibility deficiency – No duty to invite the opponent to remedy**

Article 5 EUTMDR draws a distinction between two categories of conditions of admissibility. In case the opponent fails to satisfy one of the conditions for admissibility of the opposition provided for in Article 5(3) EUTMDR and the deficiency is not remedied before the expiry of the opposition period, the EUIPO is not required to invite the opponent to remedy that deficiency before rejecting the opposition as inadmissible (§ 36, 37, 39).

[18/01/2023, T-758/21, Clavis /Clavis, EU:T:2023:3](#)

### **Opposition inadmissible – No adversarial part of the opposition proceedings**

The adversarial part of the opposition proceedings, which includes, inter alia, inviting the parties to submit observations, begins only after the opposition has been found to be admissible (Article 6(1) EUTMDR). If the adversarial stage of the opposition proceedings has not been initiated, the adversarial examination procedure provided for in Article 47 EUTMR cannot be applied (§ 27, 41).

[18/01/2023, T-758/21, Clavis /Clavis, EU:T:2023:3](#)

- [Substantiation of the earlier right/s](#)

### **Substantiation of the earlier right – Belated acquisition**

The later acquisition of the earlier national marks is a circumstance which occurred later, so that the opponent's proof of that late acquisition does not affect the condition of ownership of the earlier national marks at the time the opposition was filed (§ 44).

06/04/2022, T-118/21, [Halix records / HALIX RECORDS Edition of CILEM RECORDS INTERNATIONAL et al.](#), EU:T:2022:214, § 44

### **Substantiation of the earlier right – Extract from the TMview database**

An extract from the TMview database constitutes a document equivalent to a copy of the certificate of registration of the mark, provided that it contains all the relevant information (§ 32).

27/04/2022, T-181/21, [SmartThinQ \(fig.\) / SMARTTHING \(fig.\)](#), EU:T:2022:247, § 32

- Other procedural questions regarding opposition proceedings

### **Principles of res judicata and *ne bis in idem***

The principle of res judicata is not applicable to subsequent opposition decisions, given that these proceedings are administrative and not judicial. A fortiori, the grounds of an OD decision in different opposition proceedings do not have the force of res judicata and are not capable of creating acquired rights or legitimate expectations with regard to the parties concerned (§ 35).

The principle of *ne bis in idem* is applicable only to penalties. Therefore, it cannot be applied in the context of opposition proceedings (§ 37).

07/11/2019, T-380/18, [INTAS / INDAS \(fig.\) et al.](#), EU:T:2019:782, § 35, 37

### **Opposition proceedings – Relevant point in time for assessing an opposition**

In opposition proceedings before the Office, the only relevant point in time for assessing the existence of a conflict between the contested EU trade mark application and the earlier right invoked as the basis for the opposition is the filing date of the contested EU trade mark application (§ 28-31).

16/03/2022, T-281/21, [Ape tees \(fig.\) / DEVICE OF APE HEAD \(fig.\) et al.](#), EU:T:2022:139, § 28-31

### **No extension of the opposition grounds after the opposition period**

The facts, evidence and observations submitted after the expiry of the opposition period cannot be taken into consideration in order to determine the grounds of opposition. Once the opposition period has expired, the scope of the opposition must be regarded as being fixed. As such, the information provided after the expiry of the opposition period cannot alter the scope of the opposition, in particular due to the risk that this could have on the effectiveness of mandatory time limits and, therefore, the principle of equal treatment (§ 30-33, 37).

[01/02/2023, T-349/22, Hacker space / Hacker-pschorr et al.](#), EU:T:2023:31

### **No extension of the opposition grounds after the expiry of the opposition period**

On expiry of the deadline for filing an opposition, set out in Article 46 EUTMR, the opponent may no longer rely on new earlier rights or new grounds of opposition (§ 56). The opponent's observations submitted after the expiry of the opposition period cannot admissibly introduce a new ground of opposition (§ 65).

[28/06/2023, T-452/22, Hofmag / Hofmag](#), EU:T:2023:362

### **Opposition proceedings – Interpretation of the notice of opposition online form of the Office**

An opponent who only invoked a non-registered trade mark in the opposition form under the heading 'Basis of opposition', cannot validly claim that it also intended to rely on an 'other sign used in the course of trade' (§ 62).

The opposition form enables the opponent to add both a non-registered trade mark and another sign used in the course of trade (§ 59). Under Article 2(2)(b)(iv) EUTMDR, the notice of opposition must contain a clear identification of the earlier mark or earlier right on which the opposition is

based. Consequently, the opponent should add in the opposition form an additional basis of opposition, specifying that it relies on Article 8(4) EUTMR, not only on the basis of a ‘word mark’ but also on the basis of a ‘commercial designation’, if it intends to also rely on the latter basis (§ 60).

The indication of the choice of basis, in the opposition form, then enables the opponent to indicate more specifically what that basis consists of and, thus, allows the EUIPO and the EUTM applicant to take cognisance of it. The opponent must therefore indicate the type of mark, its description, and the territories covered (§ 61).

[28/06/2023, T-452/22, Hofmaq / Hofmaq, EU:T:2023:362](#)

### **Locus standi – Date of recordal of a change of ownership**

A change in the ownership of an international registration is recorded by the WIPO as of the date of receipt of the request complying with the applicable requirements (Rule 27(1)(b) of Regulations under the Protocol Relating to the Madrid Agreement) (§ 33).

[13/09/2023, T-167/22, Tmc transformers / TMC \(fig.\) et al., EU:T:2023:535](#)

[13/09/2023, T-163/22, TMC TRANSFORMERS \(fig.\) / TMC \(fig.\) et al., EU:T:2023:534](#)

### **Non-registered trade mark – Indication of goods and services in the opposition form**

The opposition form does not clarify that a proprietor of a non-registered mark does not need to take account of the reference to the business activity when filling in the box ‘goods and services / business activity’. Given that the specific wording used in the form shows that the opponent intended to describe only its business activity, it must be deemed to have failed to indicate the goods or services it intended to rely on in the earlier non-registered mark. Where such a scenario arises, the BoA must inform the party of this deficiency and ask the opponent to remedy it within two months pursuant to Article 5(5) EUTMDR read in conjunction with Article 2(2) EUTMDR (§ 21-26).

[31/01/2024, T-173/23, BANDIT / BANDIT et al., EU:T:2024:49](#)

#### **4.3.1.2 Cancellation proceedings**

- [Invalidity proceedings](#)

### **Substantiation of the earlier right in invalidity proceedings – Rule 19(2) CTMIR [now Article 7(2) EUTMDR]**

The representation of the sign in black and white does not constitute reliable proof of the existence, validity and scope of the protection of the earlier mark when colours are claimed, as per Rule 19(2) CTMIR [now Article 7(2) EUTMDR], applicable by analogy for invalidity proceedings (§ 47-48). If a reproduction of the earlier mark in colour is not provided, the formal requirements related to the evidence of registration of the earlier mark as a substantial condition are not fulfilled (§ 49-53).

[27/03/2019, T-265/18, Formata \(fig.\) / Formata \(fig.\) et al., EU:T:2019:197, § 47-53](#)

### **Invalidity proceedings – Relevant date for the assessment of the descriptiveness of the sign – Conditions for consideration of subsequent evidence**

The date on which the application for registration of the mark was filed is the relevant date for the assessment of the descriptiveness of the sign. However, evidence subsequent to the date on which the contested mark was filed can be taken into consideration when it enables conclusions

to be drawn about the situation as it was on that date. In the present case, the evidence, such as extracts from Wikipedia refers to articles dating from the relevant time and some of the additional evidence predates the filing date, enabled the BoA to confirm the assessment in the first instance on the basis of evidence subsequent to the filing date. The BoA did not base its reasoning on assumptions or estimations, but made relevant assessments of the descriptiveness of the sign 'HYAL' as it was on the date of filing (§ 57-62, 74).

*16/06/2021, T-215/20, [HYAL](#), EU:T:2021:371, § 57-62*

### **Determination of the grounds of an application for a declaration of invalidity in light of the statement of reasons**

In order to determine the grounds on which an application for a declaration of invalidity is based, it is necessary to examine all of the application, especially in light of the detailed statement of reasons in support of it (18/03/2016, T-501/13, WINNETOU, EU:T:2016:166, § 26) (§ 27).

*09/12/2020, T-30/20, [Promed](#), EU:T:2020:599, § 27*

### **Invalidity proceedings – Examination limited to the grounds and arguments submitted by the parties**

The applicant did not submit, before the adjudicating bodies of EUIPO, any argument or evidence in support of its application for a declaration of invalidity based on Article 7(1)(d) EUTMR. It is for the applicant to invoke before EUIPO the specific matters that call into question the validity of the contested mark whilst EUIPO is to limit its examination to the grounds and arguments submitted by the parties. Accordingly, the BoA was correct in finding that the application for a declaration of invalidity based on Article 7(1)(d) EUTMR had to be rejected as unfounded, given the lack of any argument in support of that application (§ 57-59).

*[13/07/2022, T-369/21, uni \(fig.\), EU:T:2022:451](#)*

### **Invalidity proceedings – EUIPO decision taken after the end of the transition period provided for in the Withdrawal agreement (Brexit) – Irrelevance of enhanced distinctiveness in the UK**

In cancellation proceedings, the proprietor of an industrial property right, particularly an earlier mark, must establish that he or she may prohibit the use of the EU trade mark at issue, not only on the filing or priority date of that mark but also on the date on which EUIPO decides on the application for a declaration of invalidity. The same applies, a fortiori, in the context of opposition proceedings (§ 99). For the evidence of enhanced distinctiveness of the earlier mark acquired through use in the UK to be relevant for the application for a declaration of invalidity of the contested mark, that use must still be capable of being relied on at the date on which EUIPO rules on the application for a declaration of invalidity (§ 100). The date of the contested decision – 18 February 2021 – postdates the expiry of the transition period (§ 101).

In the light of the fundamental principle of territoriality of intellectual property rights, set out in Article 1(2) EUTMR, after the expiry of the transitional period, no conflict can arise in the UK between the contested mark and the earlier mark, which are no longer protected in that territory. At the date of the contested decision, the public of the UK was no longer part of the relevant public of the EU (§ 103).

While it is true that the date to be taken into account for assessing the enhanced distinctiveness of the earlier mark is the filing date of the contested mark application, the fact remains that the requirement of permanence or persistence of the prior right at the date on which EUIPO rules on the application for a declaration of invalidity is a matter of enforceability, previous to such a substantive assessment (§ 104).

[12/10/2022, T-222/21, Shoppi \(fig.\) / Shopify, EU:T:2022:633](#)

**Invalidity proceedings – Scope of examination limited to the grounds supported by a specific reasoning – Irrelevance of the overlap between the scopes of Article 7(1)(b) and Article 7(1)(g) EUTMR**

It is settled case-law that there is a degree of overlap between the respective scopes of the absolute grounds for refusal set out in Article 7(1)(b) to (d) EUTMR. There is also a degree of overlap between the respective scopes of Article 7(1)(b) and (g) EUTMR since a trade mark is incapable of fulfilling its essential function of guaranteeing the identity of origin of the goods or services covered where the information it contains is of such a nature as to deceive the public (§ 58, 59).

However, it is clear from equally settled case-law that each of the grounds for refusal to register listed in Article 7(1) EUTMR is independent of the others and requires separate examination (§ 60). The overlap between the absolute grounds for refusal set out in Article 7(1) EUTMR cannot compensate for the total lack of any arguments in relation to one of the grounds for refusal on the part of the applicant for a declaration of invalidity (§ 63).

In the absence of any arguments, in the application for a declaration of invalidity, seeking to show that Article 7(1)(b) EUTMR applies, the BoA infringed Article 63(2) EUTMR, because, even though the application contained no reasoning in that regard, the adjudicating bodies of EUIPO nevertheless relied on that ground. In that respect, merely selecting that ground from the drop-down menu on the form is not sufficient (§ 68-69).

[19/10/2022, T-486/20, Swisse \(fig.\), EU:T:2022:642](#)

**Invalidity proceedings – Sign protected as a GI – Scope of examination – Examination limited to the grounds invoked by the invalidity applicant**

Where the invalidity applicant has not based its invalidity action on a conflict between the contested mark and a protected geographical indication, such possible conflicts cannot be examined in the context of the assessment of acquired distinctiveness through use without infringing Art. 95(1) EUTMR (§ 68-75).

Where the invalidity applicant has not put forward any argument in support of its claim that the contested mark is deceptive, the EUIPO cannot declare that mark invalid of its own motion on that ground of invalidity (§ 120).

[14/12/2022, T-526/20, DEVIN, EU:T:2022:816](#)

**Application for a declaration of invalidity filed after the expiration of the contested EUTM – Inadmissibility**

As an EUTM is a registered trade mark (Article 1(1) EUTMR), it cannot, in principle, be declared invalid after its expiry and cancellation from the register (Article 53(8) EUTMR). That possibility is limited to the specific situation regulated in Article 17(5) EUTMDR in which i) the EUTM expires after the filing of the invalidity request and ii) the invalidity applicant shows a legitimate interest in obtaining a decision on the merits (§ 22-25, 28).

[14/03/2023, T-254/22, ANITA / Anita \(fig.\) et al., EU:T:2023:146](#)

**Invalidity proceedings – Presumption of validity – Well-known facts**

In invalidity proceedings, the presumption of validity of the EUTM does not preclude the EUIPO from relying, not only on the arguments and evidence put forward by the parties, but also on well-

known facts that the examiner might have omitted to take into consideration in the registration proceedings (§ 21). Well-known facts are facts that are likely to be known by anyone or that can be learned from generally accessible sources, including information from standard dictionaries (§ 22).

[07/02/2024, T-80/23, BEAUTYBIO, EU:T:2024:58](#)

- [Revocation proceedings](#)

### **Admissibility of application for revocation – Abuse of proceedings not relevant**

The question of the possible existence of an abuse of rights is not relevant for the purposes of analysing the admissibility of an application for revocation brought under Article 63(1)(a) EUTMR, which does not make the admissibility or merits of an application for revocation subject to the applicant's good faith. In any event, the facts of the present case cannot be compared with those of the 'Sandra Pabst' case ([R 2445/2017-G](#)), since the latter was characterised by exceptional circumstances, absent from the present case (§ 24, 25).

[07/09/2022, T-699/21, My boyfriend is out of town, EU:T:2022:528](#)

See also, [07/09/2022, T-754/21, bâoli \(fig.\), EU:T:2022:529, § 24, 25](#)

### **Revocation proceedings – Proof of use – Inadmissibility of the request for hearing of witnesses**

According to Art. 97(1)(a) and (d) EUTMR, both the hearing of parties and the hearing of witnesses are measures of inquiry that EUIPO may undertake in any proceedings. Nevertheless, in revocation proceedings for non-use, genuine use must be proven by evidence limited to the submission of specific supporting document, which does not include hearing of witnesses [Article 10(4) EUTMDR, applicable mutatis mutandis to invalidity proceedings pursuant to Article 19(1) EUTMDR]. Therefore, the BoA did not err in dismissing the request for the hearing of witnesses as inadmissible (§ 22-27).

[07/12/2022, T-747/21, Fohlenelf, EU:T:2022:773](#)

### **Revocation proceedings – Presumption of distinctiveness**

Where an application for revocation is solely based on Article 58(1)(a) EUTMR, it is not for EUIPO, nor is it for the GC, to challenge the presumption of inherent distinctiveness in the context of the revocation proceedings (§ 23).

[14/12/2022, T-553/21, FORM EINES SMILEYS \(3D\), EU:T:2022:813](#)

### **No requirement to show a particular interest for filing a revocation request for non-use – Abuse of rights not relevant**

Article 63(1)(a) EUTMR requires no interest in bringing proceedings, given that the absolute grounds for refusal and the grounds for revocation protect the public interest (§ 38-41). Therefore, the question of the possible existence of an abuse of rights is irrelevant as regards a revocation request for non-use (§ 42).

[07/06/2023, T-239/22, Rialto, EU:T:2023:319](#)

### **Revocation proceedings – Presumption of validity**

The earlier trade mark cannot be found to be generic, descriptive or devoid of any distinctive character, without calling into question its validity in revocation proceedings (§ 79).

[26/07/2023, T-638/21, DEVICE OF THE OUTLINE OF A BEAR \(fig.\), EU:T:2023:434](#)

### **Revocation proceedings – Irrelevance of bad faith**

Article 63(1)(a) EUTMR does not make the admissibility or merits of an application for revocation subject to good faith on the part of the applicant for revocation. In that context, arguments based on alleged bad faith on the part of the revocation applicant are ineffective (§ 20).

[06/09/2023, T-601/22, OPTIVA MEDIA \(fig.\), EU:T:2023:510](#)

- Burden of proof, acquiescence

### **Invalidity proceedings – Lack of distinctive character – Burden of proof**

In invalidity proceedings, as the registered EUTM is presumed to be valid, it is for the applicant person who has filed the application for a declaration of invalidity to invoke before EUIPO the specific facts which call the validity of that trade mark into question (§ 62).

[04/05/2022, T-117/21, DEVICE OF TWO CROSSED STRIPES PLACED ON THE SIDE OF A SHOE \(fig.\), EU:T:2022:271, § 62](#)

- Other procedural questions regarding cancellation proceedings
  - *Res judicata*

### **Res judicata – New application for revocation – Inadmissible arguments**

Arguments which had already been rejected in the decision dealing with the first application for revocation, and have not been the subject of a fresh assessment by the CD or BoA when dealing with the second application for revocation, are inadmissible (§ 39, 42).

[22/06/2022, T-739/20, Waterford, EU:T:2022:381](#)

- *Other*

### **Guidelines – Binding effect on the Office – Request for extension of time limit**

Although the guidelines lack binding force, they constitute a reference source on EUIPO's practice in respect of EUTMs. They are a consolidated set of rules setting out the line of conduct which EUIPO itself proposes to adopt, with the result that, provided that those rules are consistent with legal provisions of higher authority, they constitute a self-imposed restriction on EUIPO, namely that of compliance with the rules which it has itself laid down (§ 38, 39). Therefore, the CD could not, in response to the second request for an extension of the time limit for filing evidence of use of the contested mark, simply reject that request, but had to, in accordance with the the guidelines, grant an extension of time from the day of communication of its reply (§ 44).

[08/06/2022, T-293/21, Um, EU:T:2022:345](#)

## **4.3.2 Design cases – Invalidity proceedings**

### **4.3.2.1 Admissibility, time limits and form, means of communication**

**Admissibility of RCD invalidity application – Irrelevance of bad faith, infringement of a contractual obligation or abusive character – Existence of a national court settlement**

In the context of the examination of a ground for invalidity invoked before the EUIPO, the alleged existence of bad faith, of a possible infringement of a contractual obligation by the invalidity applicant or of the alleged abusive character of the invalidity application is irrelevant. While the existence of such factors may be relied on in the context of ad hoc civil law proceedings between the parties concerned, it cannot usefully be relied on as a defence in invalidity proceedings, given that, in such proceedings, it is a matter of ruling on the individual character of the contested design, the assessment of which is objective. There is no need to rule on conduct, whether it be that of the contested RCD holder or the invalidity applicant (§ 15).

Since the court settlement between the parties was intended to terminate the infringement proceedings but not to create a prohibition of seeking a declaration of invalidity of the contested design, that court settlement cannot serve as a factual basis for concluding that there was bad faith or an abuse of rights (§ 16).

[06/03/2024, T-647/22, Shoes, EU:T:2024:147](#)

#### 4.3.2.2 Other procedural questions regarding invalidity proceedings

##### Community design – Invalidity of the design and maintaining it in an amended form

The possibility of maintaining the registration of the design in an amended form according to Article 25(6) CDR is an alternative to invalidating the design in its entirety. This ensures the proportionality of the sanction (§ 39-40).



[25/10/2021, T-329/20, Pendenti, EU:T:2021:732, 39-40](#)

##### Evidence – Translation into the language of proceedings

Article 29(5) CDIR provides that '[w]here the evidence in support of the application is not filed in the language of the invalidity proceedings, the applicant shall file a translation of that evidence into that language within two months of the filing of such evidence.' It follows that the Office is not required to take into account untranslated evidence. Similarly, it follows from Article 31(2) CDIR, according to which '[i]f the holder files no observations, the Office may base its decision concerning invalidity on the evidence before it', that the Office was not required to request a translation of its own motion in the present case (§ 45).

[07/07/2021, T-492/20, Leuchten, EU:T:2021:413, § 45](#)

##### Not need to provide a translation into the language of the proceedings

While evidence submitted by the parties to invalidity proceedings before the EUIPO must, in principle, be in the language of the proceedings, if this is not the case, the BoA has a margin of appreciation under Article 81(2) CDIR as to whether the translation of evidence into the language of proceedings is to be required. The mere fact that certain evidence was produced in a language other than the language of the proceedings is, therefore, not sufficient reason for rejecting the application for a declaration of invalidity (§ 34).

[21/06/2023, T-347/22, Schmelztiegel II, EU:T:2023:344](#)

##### Identification of prior designs

Prior designs invoked as a basis of an invalidity action under Article 25(1)(b) CDR must be clearly and specifically identified (§ 27, 29).

[06/09/2023, T-492/22, Socks \(Set of -\), Packaging boxes, EU:T:2023:516](#)

## CHAPTER II – ABSOLUTE GROUNDS FOR REFUSAL / INVALIDITY

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### 1 ARTICLE 7 EUTMR – GENERAL PRINCIPLES

#### **Relation between Article 7(1)(a) EUTMR and 7(1)(b) EUTMR – Adverse effect of the BoA decision – Admissibility of an action or of a cross-claim**

Where an application for a declaration of invalidity is based on the fact that the sign at issue has been registered contrary to the provisions of Article 7(1)(a) EUTMR or the provisions of Article 7(1)(b) EUTMR, it is essential to examine the first of these grounds before assessing, where appropriate, whether the mark has inherent distinctive character or whether it has acquired distinctive character through use (§ 44-48).

The invalidity applicant is adversely affected by the BoA's decision which upheld the invalidity request on the basis of Article 7(1)(b) EUTMR and remitted the case to the Cancellation Division for the assessment of Article 7(3) EUTMR, but which did not examine Article 7(1)(a) EUTMR, which was also invoked by the invalidity applicant (§ 54).

In light of the relationship between Article 4 and Article 7(1)(a) EUTMR, and of Article 7(1)(b) thereof, the Grand Board of Appeal could not dispense with the examination of the ground for invalidity under Article 7(1)(a) EUTMR and refer the case back to the Cancellation Division to decide on the possible acquisition of distinctive character by the mark following the use which has been made of it, in accordance with Article 7(3) and Article 52(2) EUTMR (§ 69).

*06/10/2021, T-124/20; [DEVICE OF A REPEATED GEOMETRIC DESIGN \(fig.\)](#), EU:T:2021:668, § 44-48, 54, 69*

#### **Sign with tactile aspect – Unclear compliance with Article 4 CTMR – Impossible examination of Article 7(1)(b) CTMR**

Article 7(1)(b) CTMR concerns 'trade marks' and can only apply once it has been established that there is a trade mark within the meaning of Article 4 CTMR. The BoA examined the distinctiveness of the sign without first examining whether that sign can constitute a trade mark (§ 35-37). Even assuming that BoA examined the possible distinctiveness of the various hypothetical shapes that the sign applied for could take, such an examination does not relieve BoA of its duty under CTMR to examine the absolute grounds for refusal. Since signs must be examined as a whole, the BoA was not entitled to examine distinctiveness selectively on the basis of certain aspects (in particular under exclusion of its tactile aspect) (§ 40-42).



*[07/12/2022, T-487/21, DARSTELLUNG EINES ZYLINDRISCHEN SANITÄREN EINSETZTEILS \(posit.\)](#), EU:T:2022:780*

#### **Absolute grounds for refusal under Article 7(1) CTMR – No specific order of examination – Article 7(1)(e) CTMR not necessarily before Article 7(1)(b) CTMR**

Article 7(1) CTMR lists the various absolute grounds for refusal that may be raised against the registration of a trade mark application, but it does not specify the order in which those grounds should be considered. The absolute grounds for refusal set forth in Article 7(1)(e) CTMR are not grounds for refusal that need to be examined before Article 7(1)(b) CTMR (§ 17, 26).

*[05/07/2023, T-10/22, FORM EINER FLASCHE \(3D\)](#), EU:T:2023:377*

## 2 ARTICLE 4, 7(1)(a), 59(1)(a) EUTMR – CLEAR AND PRECISE REPRESENTATION

### **Preliminary ruling – Colour mark or figurative mark – Graphic representation of a mark submitted as a figurative mark – Insufficiently clear and precise graphic representation – Article 2 and Article 3(1)(b) Directive 2008/95/EC**

When the trade mark application contains an inconsistency between the sign's representation in the form of a drawing and the classification given to the mark by the applicant, in such a way that it is impossible to determine exactly the subject matter and scope of the protection, the trade mark registration must be refused on account of the lack of clarity and precision of the application (§ 40, 45).



27/03/2019, C-578/17, [Oy Hartwall Ab](#), EU:C:2019:261, § 40, 45

### **Colour mark – Sufficiently clear and precise graphic representation – Requirement for a systematic arrangement associating the colours in a predetermined and uniform way**

A sign may be registered as a mark only if the applicant provides a graphic representation in accordance with the requirements of Article 4 CTMR, to the effect that the subject matter and scope of the protection sought are clearly and precisely determined. Where the application is accompanied by a verbal description of the sign, it must be consistent with the graphic representation and must not give rise to doubts as to the subject matter and scope of that graphic representation (27/03/2019, C-578/17, [Oy Hartwall Ab](#), EU:C:2019:261, § 39, 40) (§ 36-37).

A graphic representation of two or more colours, designated in the abstract and without contours, must be systematically arranged so that the colours concerned are associated in a predetermined and uniform way. The mere juxtaposition of two or more colours, without shape or contours, or a reference to two or more colours 'in every conceivable form', does not exhibit the qualities of precision and uniformity required by Article 4 CTMR (24/06/2004, C-49/02, [Blau/Gelb](#), EU:C:2004:384, § 33-35). The GC was correct to find that the mere indication of the ratio of colours is insufficient. Regard can be made to the manner in which the mark is used, if registration was obtained under Article 7(3) EUTMR (§ 38, 47-48).



29/07/2019, C-124/18P, [Blue and Silver \(COLOUR MARK\)](#), EU:C:2019:641, § 36-37, 38, 47-48

### **Colour mark – Sufficiently clear and precise graphic representation – Requirement for a systematic arrangement associating the colours in a predetermined and uniform way**

The juxtaposition of two colours, without shape or contours, does not amount to claiming protection of such colours 'in every conceivable form', where the description makes it clear that the combination of colours follows a predetermined arrangement, such as a vertical partition of the colours on the housing of chainsaws divided into one upper and one lower part (§ 37-39).



24/03/2021, T-193/18, [GREY AND ORANGE \(col.\)](#), EU:T:2021:163, 37-39

### Three-dimensional mark – Conditions for registration – Sufficiently clear and precise graphic representation – Obligation to align the description with the representation

The representation of the mark as filed defines its scope of protection, and not the description of the mark provided by the applicant. This description must define what can be seen in the mark's representation. The scope of protection is also not broadened by a possible interpretation of what the applicant meant by that representation or what it had in mind (§ 112).



23/09/2020, T-796/16, [Grass in bottle / Bottle with strand of grass et al.](#), EU:T:2020:439, § 112

### No precise and self-contained graphic representation – Sign with tactile aspect

The tactile impression is not clearly apparent from the graphic representation itself but at most, from the description. Therefore, the description does not specify graphic representation of the sign but attempts to broaden the subject-matter of the protection. Consequently, the sign does not comply with Article 4 CTMR (§ 57, 58).



07/12/2022, T-487/21, [DARSTELLUNG EINES ZYLINDRISCHEN SANITÄREN EINSETZTEILS \(posit.\)](#), EU:T:2022:780

### Colour mark – Sufficiently clear and precise graphic representation – Durability of a digital colour sample

A digital colour sample makes it possible to record a colour in a permanent form. The Court of Justice's findings in [06/05/2003, C-104/01, Libertel, EU:C:2003:244](#) that a colour sample does not possess the durability required by Article 2 of Directive 89/104, are formulated with regard to such a sample on paper. The argument that the colour sample at issue does not fulfil the criterion of durability are purely hypothetical and speculative and call into question the EUIPO's register as a whole. The digital colour sample at issue, by itself, met the requirements of Article 4 CTMR (§ 51-54).



06/03/2024, T-652/22, [ORANGE](#), EU:T:2024:152

## 3 ARTICLES 7(1)(b), 59(1)(a) EUTMR – DISTINCTIVE CHARACTER

### 3.1 ASSESSMENT OF DISTINCTIVE CHARACTER

#### Preliminary ruling – Article 3(1)(b) Directive 2008/95/EC – Distinctive character – Criteria for assessment

Article 3(1)(b) Directive 2008/95/EC must be interpreted as meaning that, in examining the distinctive character of a sign, all the relevant facts and circumstances must be taken into account, including all the likely types of use of the mark applied for. The latter correspond, in the absence of other indications, to the types of use that, in the light of the customs in the economic sector concerned, can be practically significant (§ 34).

The examination of the distinguishing capacity of a sign cannot be limited to the 'most likely' use unless 'solely one type of use is practically significant in the economic sector concerned'. This examination must take into account all practically significant conceivable uses of the sign in the

economic sector concerned by the goods. Where a sign consists of a slogan that can be placed either on the front of T-shirts or on a label, the mark will be found to be distinctive if the consumers perceives it as a badge of origin according to at least one of the alternative types of placement of the sign (§ 25-30).

12/09/2019, C-541/18, [Deutsches Patent-und Markenamt](#), EU:C:2019:725, § 25-30, 34

### **Non-independent examination of lack of distinctive character**

Descriptive signs within the meaning of Article 7(1)(c) EUTMR are also devoid of distinctive character (§ 68). However, this cannot be extrapolated by analogy to the application of Article 7(1)(b) EUTMR where the distinctive character is called into question for reasons other than its descriptive character (§ 68). By basing the finding of a lack of distinctiveness upon the premise of the descriptive character of the mark applied for, the Grand Board of Appeal did not examine Article 7(1)(b) EUTMR independently, and consequently failed to take into account the general interest that this absolute ground of refusal seeks to protect (§ 77).

01/09/2021, T-96/20, [Limbic® Types](#), EU:T:2021:527, § 68, 77

### **Non-distinctive – Assessment of distinctive character – Consideration of all likely types of use of the sign – Inapplicability of the Doublemint principle to Article 7(1)(b) EUTMR**

The assessment of the distinctive character of a sign cannot be carried out by simply taking into account the most probable use of that sign. Instead, it should take into account all the likely types of use of the mark applied for, that is, those types which can be practically significant (12/09/2019, C-541/18 P, #darferdas?, EU:C:2019:725, § 33) (§ 29).

The reasoning stated in case-law that a sign is regarded as being descriptive pursuant to Article 7(1)(c) EUTMR if at least one of its possible meanings designates a characteristic of the goods or services concerned (23/10/2003, C-191/01 P, Doublemint, EU:C:2003:579, § 30, 32) is not transposable by analogy to the application of Article 7(1)(b) EUTMR (§ 35).

**achtung** <sup>H</sup> 03/09/2020, C-214/19 P, [achtung ! \(fig.\)](#), EU:C:2020:632, § 29, 35

### **Assessment of distinctive character – Delimitation of Article 7(1)(b) EUTMR and Article 7(1)(c) EUTMR**

The ambiguity of the sign is a relevant factor which must be taken into account in the context of Article 7(1)(b) EUTMR. The case-law according to which a sign is to be classified as descriptive within the meaning of Article 7(1)(c) EUTMR where at least one of its potential meanings designates a characteristic of the goods concerned is not applicable by analogy in the context of Article 7(1)(b) EUTMR where the distinctive character of the sign is called into question for reasons other than its descriptive character (03/09/2020, C-214/19 P, [achtung!](#), EU:C:2020:632, § 35) (§ 37).

In the absence of the establishment of the descriptive character of the sign and a sufficiently direct and specific link between the sign and the goods (in the sense of 'a tube remaining cold or cool') the applicant may rely on the argument as to its ambiguity (namely that the relevant public may also perceive the sign as an indication of a 'negligent' or 'pleasant' tube). The BoA was wrong to find that the sign lacked the minimum degree of distinctive character according to Article 7(1)(b) EUTMR without having established the descriptive character of the mark applied for (§ 36, 41).

16/06/2021, T-481/20, [Cooltube](#), EU:T:2021:373, § 36-37, 41

### **Non-distinctive – Figurative mark used as logo attached to textiles – Distinctive character of the mark to be assessed as it was filed not as it is used**

The mark must be assessed as it was filed, not as it is used. The applicant filed the mark applied for without adding a description to restrict the scope of protection to a logo or a label and without specifying where the mark might be positioned on its products. As a result, the mark is sought in respect of a scope of protection that covers all possible uses as a figurative mark, including as a pattern applied to the surface of the goods in question (§ 36).



03/12/2019, T-658/18, [DEVICE OF A CHECKERED GINGHAM PATTERN \(fig.\)](#), EU:T:2019:830, § 36

### **Non-distinctive – Mere promotional and laudatory message – Figurative mark used as logo attached to textiles – Irrelevance of the particular use of the sign**

The collocation of the capital letter 'I', which corresponds to the English personal pronoun of the first person in the singular, and a heart, which is commonly used as a symbol of the verb 'love', form a simple, clear and unambiguous idiomatic expression meaning 'I love' (not disputed). The relevant public will perceive the contested mark immediately and exclusively as a laudatory advertising message, which expresses a preference or affection for the goods (§ 62). The evidence submitted by the invalidity applicant demonstrates a widespread use of the sign throughout the EU in diverse formulae and combinations at the time of the application (§ 55-56, 63). Consequently, the contested trade mark is neither striking nor original, requiring at least some interpretation or the setting-off of a cognitive process in the minds of the public. The relevant public does not perceive the sign beyond its obvious advertising message or as an indication of the commercial origin of the goods (§ 63-64).

The fact that the contested trade mark is affixed to the goods as a logo or in accordance with the identification practices of the clothing sector does not invalidate this finding (§ 88). The mark must be assessed as it was filed, not as it is used (§ 90). The applicant filed the mark applied for without adding a description to restrict the scope of protection to a logo or a label and without specifying where the mark might be positioned on its products. It is therefore not possible to assess the distinctive character of the contested trade mark in relation to a particular use (03/12/2019, T-658/18, DEVICE OF A CHECKERED GINGHAM PATTERN (fig.), EU:T:2019:830, § 36) (§ 90).



12/02/2021, T-19/20, [I love \(fig.\)](#), EU:T:2021:17, § 55-56, 62-64, 88, 90

### **Non-distinctive – Assessment of distinctive character – Mere promotional and laudatory message – Impact of particular method of use – Applicant's burden of proof**

A sign which is immediately and without further reflection understood by the relevant public as a typical clear and unambiguous promotional message for the goods and services applied for (§ 34) is devoid of distinctive character (§ 34, 50). Where the EUTM applicant contests such a finding made by the Office, it has to show that the sign will be interpreted differently and perceived by the public to have a different meaning (§ 40, 47).

The affixing of the sign to the goods according to the relevant and significant customs of the sector concerned does not automatically lead the public to perceive that sign as an indicator of business origin (§ 56). The EUTM applicant has to show why a particular method of affixing the sign on the goods would significantly alter the meaning and perception of the sign applied for (§ 55).

21/04/2021, T-345/20, [Men+](#), EU:T:2021:209, 6 34, 40, 47, 50, 55, 56

### **Non-distinctive – Specific link between the meaning of the sign and the characteristics of the goods – Descriptive of one of the characteristics of the designated goods**

The English-speaking public of the EU (general consumers and professionals in the construction sector) perceives the sign 'MaxWear' as a combination of the terms 'max' and 'wear'. The element 'max' is understood as an abbreviation of the word 'maximum' and the element 'wear' as meaning, inter alia, 'deterioration through use' or 'sustainability during use' (§ 26, 31). The sign is devoid of distinctive character due to the fact that it is perceived, by a non-negligible part of the relevant public, as being descriptive of one of the characteristics of the designated goods (floors and flooring material), namely their durability in use (§ 28-29, 31).

10/03/2021, T-99/20, [MaxWear](#), EU:T:2021:120, § 26, 28-29, 31

### **Minimum degree of distinctive character – Not Descriptive**

Since a thought process involving a number of steps is necessary to establish a link between the sign Wave and the expressions 'wave effects' and 'wavelength' used in the market sector of aquariums, the sign Wave cannot be considered descriptive of a characteristic of *aquarium lights* in Class 11 (§ 26-28). Therefore, the sign Wave is capable of indicating the commercial origin of the goods and is not devoid of a minimum degree of distinctiveness (§ 29).

23/09/2020, T-869/19, [Wave](#), EU:T:2020:447, § 29

### **Minimum degree of distinctive character – Not descriptive – No customary nature**

The English word 'body' means 'the complete physical form of a person or animal' and the English word 'secrets' means something which is 'kept from knowledge or observation' (§ 62). In their usual meaning, those words are not laudatory (they do not refer to superior quality) (§ 63). The evidence adduced in support of the application for a declaration of invalidity does not demonstrate a direct link between the expression 'body secrets' and the goods at the time when the application for registration of the contested mark was filed. Accordingly, the expression 'body secrets' will not be perceived by the relevant English-speaking public as a promotional formula (§ 23-24, 46-51, 64).

As the legality of BoA decisions must be assessed solely on the basis of the EUTMR and, in its review of legality, the Court is not bound by the decision-making practice of the Office, the applicant's argument that the Court ought to take into account the Office's decision concerning the application for registration of the sign 'BEAUTY SECRETS' cannot succeed. In any event, the expressions 'beauty secrets' and 'body secrets' do not have the same marketing value and are not interchangeable expressions, insofar as, when faced with goods bearing the mark 'BODYSECRETS', a consumer will not be attracted by the suggestion that those goods will be special and capable of producing enhancing effects rarely found in other products on the market (§ 32, 66-67).

The reference to the words 'body secrets', always used in conjunction with other words in the titles of magazine articles adduced by the invalidity applicant as evidence, does not lead to the conclusion that, when confronted with the contested mark, the relevant public would perceive it immediately and without further thought as a description of the goods covered by it or of one of the goods' characteristics (§ 77-83).

The customary nature of the expression 'body secrets' for beauty, cosmetic and fashion products was not established at the time of the filing (§ 91-92).

**BODYSECRETS**

14/07/2021, T-810/19, [BODYSECRETS \(fig.\)](#), EU:T:2021:460, § 32, 62-63, 66-67, 77-83, 91-92

### **Non-distinctive – Applicant’s burden of proof for intrinsic distinctive character**

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

11/09/2019, T-649/18, [transparent pairing](#), EU:T:2019:585, § 46

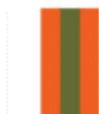
### **Non-distinctive – Assessment of distinctive character – Probative value of web pages**

The evidence submitted by the applicant relating to the geographical distribution of the audiences of the websites mentioned by the examiner, as well as post-dating the filing date of the application for registration, does not make it possible to draw conclusions about the relevant public, namely English-speaking professionals and the English-speaking general public in the EU. This is because, as the applicant states itself, no indication of the number of visitors to each site is given (§ 54).

13/10/2021, T-523/20, [Blockchain Island](#), EU:T:2021:691, § 54

### **Non-distinctive – Assessment of distinctive character – Irrelevance of circumstances outside of the right conferred by the trade mark**

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



09/09/2020, T-81/20, [Darstellung eines Rechtecks mit drei farbigen Segmenten \(fig.\)](#), EU:T:2020:403, § 34

### **Non-distinctive – ‘Family of marks’ concept not applicable within absolute grounds for refusal**

The ‘family of marks’ concept does not apply to absolute grounds for refusal, but only to relative grounds for refusal. Therefore, the BoA had to assess whether the mark was distinctive in the light of its inherent characteristics without taking into consideration the other allegedly similar marks the applicant was the proprietor of (§ 53).

12/03/2019, T-463/18, [SMARTSURFACE](#), EU:T:2019:152, § 53

### **Name of a historical building – Assessment of distinctive character**

The names of historical buildings or museums are not, in principle, excluded from signs that may constitute an EUTM (§ 20). The distinctiveness of such a mark does not depend upon whether or not the EUTM applicant owns that historical building (§ 39). A sign does not need to be fanciful to possess a minimum degree of distinctive character (§ 40). In principle, the public can perceive in a sign consisting of a name of a known historical building at the same time a reference to that building and an indication of the commercial origin of the designated goods (§ 42). The goods’ place of sale does not, as such, designate specific characteristics, qualities or features of those goods (§ 27). The goods’ possible souvenir function is not an objective characteristic inherent in the nature of the product (§ 28).

24/03/2021, T-93/20, [Windsor-Castle](#), EU:T:2021:164

**Assessment of inherent distinctive character – The actual use of the contested mark is irrelevant – A combination of allusive or suggestive elements constitutes a creation that, in fact, includes a certain fanciful element**

The actual use of the contested mark has no effect on its inherent distinctive character, which must be assessed solely in the light of the representation of it provided with the application for registration (§ 73).

The combination of elements communicating allusions and suggestions rather than factual statements, as in the contested mark, constitutes a creation that, in fact, includes a certain fanciful element (§ 80).

**Makeblock**

*02/03/2022, T-86/21, [Makeblock \(fig.\)](#), EU:T:2022:107, § 73, 80*

**Assessment of distinctive character – Irrelevance of LOC**

The question whether a sign or a component of a sign has distinctive character does not depend on whether there is a likelihood of confusion within the meaning of Article 8(1)(b) EUTMR, but on whether that sign or element can serve as an indication of the commercial origin of the goods or services in question. In other words: the distinctive character of the earlier sign or the matching elements is a prerequisite for the existence of a LOC, but cannot be its consequence. Thus, the argument based on the existence of a LOC is completely irrelevant for the purposes of proving the distinctive character of the green arc and, consequently, of the mark applied for (§ 43, 44).

**bet-at-home** *29/06/2022, T-640/21, [bet-at-home \(fig.\)](#), EU:T:2022:408*

**Assessment of distinctive character – Irrelevance of LOC**

LOC is not a relevant factor for the purposes of assessing the absolute grounds for refusal under Article 7(1)(b) and (d) EUTMR. The applicant clearly confused the application of the absolute grounds for refusal set out in Article 7 EUTMR, with that of the relative ground for refusal set out in Article 8(1)(b) EUTMR (§ 65).

*13/07/2022, T-369/21, [uni \(fig.\)](#), EU:T:2022:451*

**Non-distinctive – Assessment of distinctive character – Well-known facts**

As regards the applicant's argument that the BoA did not adduce any evidence to support its findings that the terms 'electronic technology' and 'e-tech' have lost any capacity to distinguish the services in question, it should be noted that the BoA's findings are based on an understanding on the part of the relevant public which may be regarded as a well-known fact, namely a fact of which everyone is aware or which could be inferred from generally accessible sources. The terms 'electronic technology' and 'e-tech' are particularly broad. They may serve as a basis for the labelling of a range of services which is so broad, that the relevant public will not be able spontaneously to associate a service labelled with one of those terms with a particular undertaking. For the relevant public, those terms are not capable of indicating a concrete commercial origin (§ 33).

*14/09/2022, T-737/21, [E-tech](#), EU:T:2022:544*

**Non-distinctive – Method of use – Sign placed on a label**

The judgement ([12/09/2019, C-541/18, #darferdas?](#), EU:C:2019:725) does not establish a general rule by which a sign can be registered in the clothing and related sectors merely by virtue of being placed on a label inside the goods (§ 56). Such placement does not automatically mean

that the relevant public perceives a sign as an indication of commercial origin, instead accepting such a position would circumvent the absolute ground for refusal enshrined in Article 7(1)(b) EUTMR (§ 57).

[15/03/2023, T-178/22, \*Fucking awesome\*, EU:T:2023:131](#)

### **Assessment of distinctive character – Need to assess the mark as a whole**

Distinctive character of a composite mark may be assessed, in part, in respect of each of its elements, taken separately, but that assessment must, in any event, be based on the overall perception of that trade mark by the relevant public and not on the presumption that elements individually devoid of distinctive character cannot, on being combined, present such character (§ 38).

[24/05/2023, T-477/21, \*SHAPE OF AN INHALER \(3D\)\*, EU:T:2023:280](#)

### **Distinctive – Not descriptive – Mark associated with a fictitious character – Overlap between copyright and trade mark protection**

The fact that the contested mark is associated with a fictitious character does not, in itself, make it possible to rule out that that mark can also serve as an indication of origin (§ 32). Moreover, the existence of copyright protection does not preclude the sign from being protected under trade mark law (§ 44).

The evidence put forward by the invalidity applicant was insufficient to show that the relevant public would not associate the Batman character with the EUTM proprietor, that the mark was associated with another commercial origin (§ 42), or that the relevant public would perceive the mark as a reference to the fact that the goods in question contain a depiction of the Batman character (§ 53).

[07/06/2023, T-735/21, \*DEVICE OF A STYLISTED DEPICTION OF A BLACK BAT INSIDE A WHITE OVAL FRAME \(fig.\)\*, EU:T:2023:304](#)

### **Assessment of distinctive character – Perception of a sign – Outline of a figure**

If the subtlety of the outline of a figure requires some imagination or fantasy on the part of consumers in order to associate that outline with the figure of a teddy bear, it will not necessarily be perceived as such by all consumers. That conclusion cannot be called into question by the fact that the contested sign is intentionally communicated to the relevant public as representing a teddy bear. The examination as to absolute grounds for refusal cannot be dependent on the commercial intentions, whether carried out or not, and naturally subjective, of the trade mark proprietors (§ 54, 55).

[26/07/2023, T-591/21, \*DEVICE OF THE OUTLINE OF A BEAR \(fig.\)\*, EU:T:2023:433](#)

### **Assessment of distinctive character – No impact of the Vienna Agreement's classification**

The classification of a sign under the Vienna Agreement cannot affect the scope of protection of a mark or the assessment of the perception of the mark by the relevant public. This classification is intended to serve exclusively administrative purposes (§ 57, 58).

[26/07/2023, T-591/21, \*DEVICE OF THE OUTLINE OF A BEAR \(fig.\)\*, EU:T:2023:433](#)

### **Assessment of distinctive character – No direct connection between the sign and jewellery**

Although jewellery may take a variety of shapes, including that of animals, it cannot be established that the relevant public will associate the motif of a bear with items of jewellery. The shape of a teddy bear relates to a different category of goods (i.e. toys for children). It cannot be associated by consumers with jewellery (§ 62, 63).



[26/07/2023, T-591/21, DEVICE OF THE OUTLINE OF A BEAR \(fig.\), EU:T:2023:433](#)

### **Non-distinctive – Composite sign**

The distinctiveness of a composite sign must be considered globally. However, this does not preclude a prior examination of its individual components (§ 36-37). A component of a composite sign can be both decorative and functional (§ 40).

[06/09/2023, T-277/22, POSITIONSMARKE BESTEHEND AUS DEN FARBEN ROT UND WEISS AUF EINER QUADERFÖRMIGEN VERPACKUNG, EU:T:2023:498](#)

[06/09/2023, T-276/22, POSITIONSMARKE BESTEHEND AUS DEN FARBEN WEISS, MITTELROT UND DUNKELGRÜN AUF EINER QUADERFÖRMIGEN VERPACKUNG, EU:T:2023:497](#)

### **Non-distinctive – Mere promotional message – Non-specific characteristic**

The mere fact that the semantic content of the word sign applied for does not convey any information about the nature of the goods concerned is not sufficient to make that sign distinctive. For a finding that there is no distinctive character, it is sufficient that the semantic content of the sign in question indicates to the consumer a characteristic of the goods or services which, whilst not specific, comes from promotional or advertising information that the relevant public will perceive first and foremost as such, rather than as an indication of the commercial origin of the goods and services in question (§ 26, 41).

[ENDURANCE 18/10/2023, T-566/22, ENDURANCE \(fig.\), EU:T:2023:655](#)

### **Non-distinctive – Assessment of distinctive character in connection with the characteristics of the goods**

The fact that the trade mark applied for has several meanings may be relevant for determining its distinctiveness. Firstly, the meanings of the words 'absolute' and 'flow' in German is irrelevant, as the perception of the trade mark applied for must be assessed in relation to the relevant English-speaking public. Secondly, while the word 'flow' has various meanings, including the colloquial meaning of a certain state of mind or concentration, the distinctiveness of the trade mark applied for must be assessed in relation to the goods for which protection is sought, namely devices and sensors for measuring the flow and volume of liquid hydrogen (§ 25-28).

[10/11/2023, T-21/23, ABSOLUTEFLOW](#)

### **Non-distinctive – Assessment of distinctive character – EUTM applicant's burden of proof**

It is up to the EUTM applicant, who relies on its distinctive character and has a precise knowledge of the market in question, to provide specific and substantiated information proving that the trade mark has inherent distinctive character or has acquired distinctive character through use, as it is best placed to do so (§ 34).

[15/11/2023, T-35/23, YOUR PERFORMANCE PLUS, EU:T:2023:718](#)

### **Non-distinctive – Reference to ingredients of a foodstuff**

Where the ingredients of a foodstuff play a role in characterising that foodstuff, the indication of such an ingredient in a trade mark creates a direct link with the goods at issue in the minds of the relevant public (§ 27).

[20/12/2023, T-189/23, my mochi \(fig.\), EU:T:2023:853](#)

#### **Non-distinctive – Assessment of inherent distinctive character – Irrelevance of successful use of the mark on the relevant market**

The circumstance that the contested mark has been used successfully on the relevant market is not a relevant factor in the context of the application of Article 7(1)(b) EUTMR (§ 55).

[17/01/2024, T-60/23, Ilovepdf, EU:T:2024:9](#)

#### **Non-distinctive – Trade mark registered in Member States and third countries**

The mere fact that the contested mark is registered in Denmark and in the UK does not imply that the mark applied for has distinctive character for the relevant public throughout the EU. On account of linguistic, cultural, social or economic differences between Member States, a sign which is devoid of distinctive character in one State may not be devoid of distinctive character in another State (§ 43).

[21/02/2024, T-92/23, DESIGNERS TRUST, EU:T:2024:107](#)

#### **Non-distinctive – Assessment of distinctive character – Several meanings**

The application of Article 7(1)(b) EUTMR is not precluded by the fact that the trade mark applied for, or the words of which it consists, may have other meanings (§ 31).

[13/03/2024, T-243/23, MORE-BIOTIC, EU:T:2024:162](#)

#### **Non-distinctive – Irrelevance of the actual use of the sign**

Actual use cannot have any influence on the inherent distinctiveness of the trade mark, which is to be assessed solely on the basis of the representation submitted with the application. Actual use is only to be assessed in the context of Article 7(3) EUTMR (§ 44).

[13/03/2024, T-243/23, MORE-BIOTIC, EU:T:2024:162](#)

## **3.2 RELEVANT PUBLIC AND LEVEL OF ATTENTION**

#### **Distinctiveness threshold – Relevant public**

The fact that the relevant public is a specialist public cannot have a decisive influence on the legal criteria used to assess the distinctive character of a sign (§ 14).

[07/05/2019, T-423/18, \*vita\*, EU:T:2019:291, § 14](#)

#### **Distinctiveness threshold – Relevant public's level of attention**

A mark must allow the relevant public to distinguish the products covered by that mark from those of other undertakings without paying particular attention, so the distinctiveness threshold necessary for the registration of a mark cannot depend on the public's level of attention (§ 17).



[14/02/2019, T-123/18, \*DARSTELLUNG EINES HERZENS \(fig.\)\*, EU:T:2019:95, § 17](#)

### **Distinctiveness threshold – Relevant public’s level of attention**

Neither the relevant public’s level of attention nor the fact that the relevant public is a specialist one is decisive for assessing whether a sign has distinctive character. Although it is true that the level of attention of the specialist public is, by definition, higher than that of the general public, it does not necessarily follow that a weaker distinctive character of a sign is sufficient where the relevant public is a specialist one (§ 28).

*13/10/2021, T-523/20, [Blockchain Island](#), EU:T:2021:691, § 28*

### **English-speaking part of the EU – Not exclusively countries with English as their official language**

The English-speaking part of the EU does not only consist of the countries in which English is an official language, but also of those in which, at the very least, English is widely understood, which includes, in particular, Denmark, the Netherlands, Finland and Sweden (§ 35).

The mark applied for therefore conveys a message which is capable of setting off a cognitive process in the minds of the relevant public making it easy to remember and which is consequently capable of distinguishing the applicant’s goods from goods which have another commercial origin (§ 46).

*20/01/2021, T-253/20, [It’s like milk but made for humans](#), EU:T:2021:21, § 35, 46*

### **Distinctiveness threshold – Relevant public’s level of attention**

The distinctiveness threshold necessary for registration of a mark cannot depend on the public’s level of attention (§ 43).

*[29/07/2022, T-51/22, FORME DE PRESSE AGRUMES \(3D\)](#), EU:T:2022:490*

### **Non-distinctive – Irrelevance of the accuracy of the sign’s translation into the language of the proceedings**

It is irrelevant whether the BoA correctly translated the word mark from English into German. Since German was only the language of the proceedings, the conclusions as to how the English-speaking public understands that phrase are not affected by the accuracy of its translation into German, as long as those conclusions are objectively correct. The finding that the mark applied for will be perceived by the relevant public as a whole as an advertising statement is not a question of the translation of the slogan, but rather a question of the relevant public’s perception (§ 34).

*[15/03/2023, T-133/22, The future is plant-based](#), EU:T:2023:129*

### **Non-distinctive – Shape of the product – Level of attention of professional consumers**

Even though the level of attention of professional consumers is above average, considering the case-law – according to which the public is not necessarily accustomed to immediately perceive a sign as an indication of the commercial origin of the product when it merges with the appearance of the product it has been applied for – the level of attention must be assumed to be only slightly higher than average (§ 27).

*[06/09/2023, T-277/22, POSITIONSMARKE BESTEHEND AUS DEN FARBEN ROT UND WEISS AUF EINER QUADERFÖRMIGEN VERPACKUNG](#), EU:T:2023:498*

*[06/09/2023, T-276/22, POSITIONSMARKE BESTEHEND AUS DEN FARBEN WEISS, MITTELROT UND DUNKELGRÜN AUF EINER QUADERFÖRMIGEN VERPACKUNG](#), EU:T:2023:497*

## 3.3 (LACK OF) DISTINCTIVE CHARACTER OF THE SIGN IN QUESTION

### 3.3.1 Word signs

#### 3.3.1.1 Titles of books

[No key points available yet.]

#### 3.3.1.2 Single letters

[No key points available yet.]

#### 3.3.1.3 Prefix or suffix

##### **Non-distinctive – Prefix**

According to existing case-law, use of the verbal element 'bio' as a prefix or suffix has acquired a highly suggestive connotation, which may be perceived in different ways according to the product offered for sale. However, in general, it refers to the idea of environmental protection, the use of natural materials or ecological manufacturing processes (§ 48). Where a sign provides the relevant public with information regarding the content of the goods, it does not indicate their commercial or industrial origin and cannot therefore be regarded as being distinctive (§ 77).

05/06/2019, T-229/18, [Biolatte](#), EU:T:2019:375, § 77

#### 3.3.1.4 Abbreviations

##### **Non-distinctive – Abbreviation**

The word mark 'Fi Network' is devoid of distinctive character. The term 'network' lacks distinctive character and the term 'fi' is understood as abbreviation of 'fast infonet' which is a standard system of file compression and will be associated with goods and services such as electrical devices and telecommunications by the relevant public (§ 34, 35, 39).

11/07/2019, T-601/18, [Fi Network](#), EU:T:2019:510, § 34-35, 39

##### **Non-distinctive – Term with an immediately comprehensible meaning**

The term 'pro' (e.g. in the expression 'proassist') is immediately understood by the relevant public as meaning 'professional' in the context of specialised services (§ 41-42, 44-45).

23/05/2019, T-439/18, [ProAssist](#), EU:T:2019:359, § 41-42, 44-45

#### 3.3.1.5 Slogans

##### **Non-distinctive – Mark comprising advertising slogans**

Concise formulations and the repetition of some of the words making up a trade mark, like the element 'more', are commonly used in advertising to make slogans stronger and cannot suffice to endow the mark with striking features and make it easier to memorise for the relevant public (§ 29).

03/04/2019, T-555/18, [See More. Reach More. Treat More.](#), EU:T:2019:213, § 28-29

### **Non-distinctive – Mark comprising advertising slogans**

Although the CJ clarifies certain questions relating to the acceptability of slogans as trade marks, in the *Vorsprung durch Technik* judgment (21/01/2010, C-398/08 P, *Vorsprung durch Technik*, EU:C:2010:29), the case-law cannot and should not be read as suggesting that any promotional phrase can now be registered as a trade mark simply because it is presented in the form of an advertising slogan (§ 31-36).

13/05/2020, T-49/19, [Create delightful human environments](#), EU:T:2020:197, § 31-36

### **Non-distinctive – Mark comprising advertising slogans**

All marks made up of signs or indications that are also used as advertising slogans convey, by definition, to a greater or lesser extent, an objective message, even a simple one, and can still be capable of indicating to the consumer the commercial origin of the goods or services, in particular where those marks are not merely an ordinary advertising message, but possess a certain originality or resonance, requiring at least some interpretation or setting off a cognitive process. (21/01/2010, C-398/08 P, *Vorsprung durch Technik*, EU:C:2010:29, § 56-57; 25/05/2016, T-422/15 & T-423/15, *THE DINING EXPERIENCE* (fig.), EU:T:2016:314, § 48) (§ 27).

08/07/2020, T-696/19, [Moins de migraine pour vivre mieux](#), EU:T:2020:329, § 27

08/07/2020, T-697/19, [Weniger Migräne. Mehr vom Leben](#), EU:T:2020:330, § 27

### **Non-distinctive – Mark consisting of a single word – Slogan mark**

Even a sign consisting of a single word which is clearly laudatory is capable of constituting a promotional formula that is unfit to identify the commercial origin of the products and services it designates (§ 24-27, 37).

08/07/2020, T-729/19, [Favorit](#), EU:T:2020:314, § 24-27, 37.

### **Non-distinctive – Slogan**

The contested mark 'WE DO SUPPORT', designating 'technical support services in the field of computer software' in Class 42, would immediately be understood by the relevant public as meaning 'we provide support'. It is likely to be perceived by the relevant public as indicating that it may find and obtain customer support services in the field of computer software from the holder of that mark (§ 34, 50).

The combination of common English words in a single sign, which is in conformity with the rules of English grammar, conveys a clear and unequivocal message which is immediately apparent and does not require any interpretative effort on the part of an English-speaking consumer (§ 35).

The word 'we', when it is used in slogans, generally refers to the provider of services. Accordingly, it cannot be claimed that the presence of that word in the contested mark causes a personalisation giving the impression that it is the services that assist and thereby contributes to strengthening the distinctive character of that mark (§ 37).

The mere lack of information in the mark applied for concerning the manner in which the services at issue are provided or their objective cannot be sufficient to make it distinctive. Since the relevant public is not very attentive to a sign whose semantic content is merely promotional information of a more general nature, it will not take the time either to enquire into the sign's various possible functions or mentally to register it as a trade mark (§ 38).

13/07/2022, T-634/21, [We do support](#), EU:T:2022:459

### **Non-distinctive – Slogan**

All marks made up of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by those marks convey by definition, to a greater or lesser extent, an objective message, even a simple one, and can still be capable of indicating to the consumer the commercial origin of the goods or services in question. That can be the position, in particular, where those marks are not merely an ordinary advertising message, but possess a certain originality or resonance, requiring at least some interpretation by the relevant public, or setting off a cognitive process in the minds of that public (§ 16).

‘Together.forward.’ conveys a simple, clear and unequivocal message which will be perceived as an advertising slogan praising the goods at issue. Contrary to the mark at issue in the judgment of 21/01/2010, C-398/08P, *Vorsprung durch Technik*, EU:C:2010:20, the meaning of ‘Together.forward.’ does not constitute a play on words which could be perceived as imaginative, surprising or unexpected. The meaning of the sign ‘Together.forward.’ is not such as to confer any particular originality or resonance on it, to require at least some interpretation or to trigger a cognitive process, notwithstanding the fact, that that mark does not contain any verb and that the word ‘together’ is positioned before the word ‘forward’ (§ 17-22).

[05/10/2022, T-500/21, \*Together.forward.\*, EU:T:2022:609](#)

### **Non-distinctive – Slogan – Laudatory message**

For the English-speaking public in the EU, the expression ‘sustainability through quality’ is consistent with English grammar and syntax rules. While very slight nuances are possible in its understanding, this fact in no way implies that its meaning is vague, imprecise or ambiguous (§ 39). The mark applied for highlights general and laudatory positive features of the goods and services claimed. It makes it unmistakably clear to its English-speaking consumers that they can expect a higher quality and sustainability of those goods and services, with the result that their impact on the environment would be limited or that there would be no such impact (§ 44).

Moreover, the CJ judgment of [21/01/2010, C-398/08 P, \*Vorsprung durch Technik\*, EU:C:2010:29](#) is not applicable by analogy. Unlike the trade mark ‘Vorsprung durch Technik’, the mark applied for does not feature a play on words nor could it be perceived as imaginative, surprising and unexpected and therefore memorable. (§ 52-54).

[01/02/2023, T-253/22, \*Sustainability through quality\*, EU:T:2023:29](#)

### **Non-distinctive – Slogan – Obvious promotional meaning**

The word ‘we’, when used in slogans, generally refers to the service provider. As such, it has a clear meaning and does not confer any originality on the sign in which it is included (§ 28).

The relevant public is not very attentive to a sign the semantic content of which is merely promotional information of a rather general nature. It will not take the time either to enquire into the various possible functions of the group of words or to commit it to memory as a trade mark (§ 31).

The slogan ‘other companies do software we do support’, made up in accordance with the rules of English grammar and syntax has an obvious promotional meaning, the sole function of which is to highlight the positive aspects of the services in question (Class 42) and to attract customers. It does not display any originality or resonance that would require at least some interpretation by the relevant public, nor would it set off a cognitive process in the minds of that public. Therefore, it is not capable of indicating to the consumer the commercial origin of the services in question (§ 33, 35, 43, 44).

[15/02/2023, T-204/22, \*Other companies do software we do support\*, EU:T:2023:76](#)

### **Non-distinctive – Perception of the letter ‘B’ in a slogan**

The addition of the upper-case letter 'B' after the word 'PLANET' will be directly perceived by the relevant public as a reference to an alternative planet (§ 40).

[13/09/2023, T-324/22, BECAUSE THERE IS NO PLANET B, EU:T:2023:536](#)

#### **Non-distinctive – Prior use of a slogan**

It is a well-known fact that the expression 'because there is no planet B' has been used as a slogan in demonstrations against climate change or has been broadcast by several world-renowned personalities (§ 41). Therefore, it will be understood by the relevant public as referring to the absence of an alternative planet and to the concept of sustainable development (§ 45).

[13/09/2023, T-324/22, BECAUSE THERE IS NO PLANET B, EU:T:2023:536](#)

#### **Non-distinctive – Mark comprising advertising slogans**

13/05/2020, T-156/19, [We're on it](#), EU:T:2020:200

15/11/2023, T-97/23, [THE SCIENCE OF CARE](#), EU:T:2023:719

### **3.3.1.6 Laudatory marks**

#### **Non-distinctive – Mere laudatory message**

The term 'Armonie', being the plural of the Italian word 'armonia', refers to the concepts of 'proportionate correspondence'/'adequate arrangement [of the elements] in a whole'. The Italian-speaking consumers could consider that the relevant products are primarily intended to create or organise a pleasant place/environment insofar as it is harmonious (§ 28). Furthermore, and taking into account the simplicity of the sign itself, it also has a laudative character in terms of advertising, being a mere promotional formula highlighting a positive quality of the products concerned (§ 29-30).

05/02/2019, T-88/18, [ARMONIE](#), EU:T:2019:58, § 29-30

#### **Non-distinctive – Mere promotional message**

The word mark *Premiere* is understood by the relevant public, at least in one of its possible meanings, as a reference to first-class quality or premium characteristics of the goods or services and therefore is understood as being a quality indication (§ 45). A trade mark consisting of an advertising slogan is to be regarded as non-distinctive if it is perceived by the relevant public only as a simple advertising statement (§ 44). It must therefore be examined whether the sign could also be understood, beyond this indication of quality, as an indication of the commercial origin of the goods or services in question, particularly because it is not confined to a common advertising message, but possesses a certain originality or resonance requiring at least some interpretation by the relevant public, or setting off a cognitive process in the minds of that public (§ 46).

The sign '*Premiere*' does not contain any intrinsic characteristic such as to allow the assumption that the sign, beyond its indication of quality or advertising message, is perceived as an indication of commercial origin (§ 47).

19/06/2019, T-479/18, [Premiere](#), EU:T:2019:430, § 45-47

#### **Non-distinctive – Mere promotional message**

The verbal element, 'eurolamp', may provide information on the nature of the goods or their geographical origin, but they cannot serve as an indication of the commercial origin (§ 34). The verbal elements 'pioneers in new technology' contain no unusual element and have no originality

capable of endowing the sign with distinctive character. The relevant public will perceive the expression as a mere promotional message (§ 37-39). The mark applied for, taken as a whole, is not greater than the sum of its parts (§ 40-41). Thus, the mark is devoid of distinctive character (§ 42).

14/05/2019, T-465/18, [EUROLAMP pioneers in new technology](#), EU:T:2019:327, § 34, 40-41, 42

#### **Non-distinctive – Mere promotional and laudatory message**

The fact that the word ‘free’ has a wide variety of possible meanings cannot call into question the validity of the meaning accepted by the BoA, since a word sign must be refused registration under Article 7(1)(b) EUTMR if at least one of its possible meanings designates a characteristic of the goods or services (25/04/2013, T-145/12, Eco Pro, EU:T:2013:220, § 34) (§ 30).

The mark applied for conveys a promotional message and has a laudatory meaning because it indicates to the consumer a positive characteristic, namely that the goods and services (related to slimming, weight control, diet, food, beverages, nutrition, dieting, exercise, health, fitness, recreation, lifestyle, eating habits and well-being) relate to, or are connected with, goods that are free or clear from undesirable or harmful constituents. In addition, the word ‘free’ is commonly used in trade as a generic laudatory term. It is therefore devoid of distinctive character (§ 20, 35, 45, 47, 48).

12/07/2019, T-113/18, [FREE](#), EU:T:2019:531, § 20, 30, 35, 45, 47, 48

12/07/2019, T-114/18, [FREE](#), EU:T:2019:530, § 20, 30, 35, 45, 47, 48

#### **Non-distinctive – Mere promotional and laudatory message**

The relevant public perceives the term ‘moda’ in relation to the goods (building materials for flooring and coverings) as a laudatory message of a promotional nature concerning a general characteristic of those goods rather than as an indication of their commercial origin. The sign is devoid of distinctive character (§ 37-40).

12/07/2019, T-264/18, [mo.da](#), EU:T:2019:528, § 37-40

#### **Non-distinctive – Mere promotional and laudatory message – Non-negligible part of the public**

The term ‘xoxo’ will be understood as meaning ‘hugs and kisses’. This understanding is, in particular, shown by the online dictionaries *Urban dictionary* and *Internetslang* (§ 42). It is irrelevant that perhaps only teenagers and very young women will attribute that meaning to the sign ‘XOXO’, since it is sufficient that a ground of refusal exists in relation to a non-negligible part of the target public (§ 43). With regard to goods that are capable of being offered as gifts, the sign will be perceived as a promotional message conveying feelings of love and affection. The sign is thus devoid of distinctive character (§ 45-49).

13/05/2020, T-503/19, [Xoxo](#), EU:T:2020:183, § 45-49

#### **Non-distinctive – Assessment of distinctive character – Mere laudatory message**

The word marks ‘doglover’ and ‘catlover’ are a mere invitation to purchase, an advertising or laudatory statements and therefore are devoid of distinctive character in relation to nutritional supplements, pet food and treats (Classes 5, 31). The BoA is not obliged to provide evidence that the sign applied for is capable of being a generic or otherwise common name to identify or designate the relevant goods (§ 33, 34).

Whether an allusion to the benefits or advantages of the goods is more or less direct or indirect, as the case may be, is irrelevant for the purpose of establishing the capacity of a trade mark to indicate the commercial origin of the goods to the relevant public (§ 36).

[08/11/2022, T-232/22, catlover](#)  
[08/11/2022, T-231/22, doglover](#)

#### **Non-distinctive – Mere promotional message**

The use of the somewhat vulgar intensifier ‘fucking’ does not make its combination with the word ‘awesome’ unusual or original, nor does the combined expression constitute a ‘play on words’ (§ 50). It merely conveys a promotional message by way of very well-known informal language, which does not set off any cognitive process (§ 51-53).

[15/03/2023, T-178/22, Fucking awesome, EU:T:2023:131](#)

#### **Non-distinctive – Mere promotional message**

The contested mark is a clear indication to that public that the goods in question contain or may contain natural ingredients or materials and that they are environmentally friendly. During the short space of time in which the consumer is faced with a mark, they perceive the meaning of the terms intuitively rather than in a linguistically scientific way. The consumer will therefore understand the sign at issue in the most obvious way, that is, as a positive message about the qualities of the goods concerned (§ 54-56).

[12/07/2023, T-772/22, Back-2-nature, EU:T:2023:394](#)

#### **Non-distinctive word signs comprising a mere promotional or laudatory message**

24/09/2019, T-749/18, [ROAD EFFICIENCY](#), EU:T:2019:688, § 16, 34  
15/10/2019, T-434/18, [ULTRARANGE](#), EU:T:2019:746  
20/03/2019, T-760/17, [Triotherm+](#), EU:T:2019:175, § 36  
12/12/2019, T-54/19, [BIANCOFINO](#), EU:T:2019:893, § 38-40, 47  
11/09/2019, T-649/18, [transparent pairing](#), EU:T:2019:585, § 28  
13/02/2020, T-8/19, [Inventemos el futuro](#), EU:T:2020:66, § 48-49  
[06/09/2023, T-658/22, SMART!, EU:T:2023:517](#)

#### **Non-distinctive – Mere promotional and laudatory message**

Since the relevant public is not very attentive if a sign does not immediately indicate to it the origin or intended purpose of the object of its intended purchase, but rather gives it purely promotional and abstract information, it will not take the time either to enquire into the various possible meanings of the expression constituting the sign applied for or to memorise it as a trade mark. ‘AMAZING AIR’ would be perceived by the relevant public as a mere promotional slogan intended to highlight the positive characteristics of ‘air purifiers’ in Class 11 (§ 28-29).

[31/01/2024, T-269/23, AMAZING AIR, EU:T:2024:44](#)

#### **Non-distinctive – Merely promotional message**

The promotional meaning of the contested mark overshadows any indication of the commercial origin of the goods and services, so the trade mark will not be memorised by the relevant public as an indication of origin. There is a sufficiently concrete and direct link between the semantic content of the sign and the goods and services (§ 34).

[13/03/2024, T-243/23, MORE-BIOTIC, EU:T:2024:162](#)

### 3.3.1.7 Other

#### Non-distinctive word signs

25/06/2020, T-379/19, [Serviceplan](#), EU:T:2020:284  
25/06/2020, T-380/19, [Serviceplan solutions](#), EU:T:2020:285  
23/09/2020, T-36/19, [ElitePartner](#), EU:T:2020:425  
10/02/2020, T-341/20, [Radioshuttle](#), EU:T:2021:72  
[28/06/2022, T-704/21, Trusted Handwork](#) (Order)

### 3.3.2 Figurative marks

#### 3.3.2.1 Commonplace figurative elements

##### Non-distinctive – Expression with an immediately comprehensible meaning

The figurative mark ‘Simply. Connected.’ is not understood as two separate and independent words but as an expression with an immediately comprehensible meaning (§ 62). In view of the obvious meaning, the typographical features, such as the fact that the words stand above and below one another, and the presence of upper-case letters and a full stop, are not pertinent (§ 63). The global assessment confirms the dominant position of the verbal elements compared to the figurative elements that are devoid of distinctive character (§ 99-100).



28/03/2019, T-251/17 and T-252/17, [Simply. Connected. \(fig.\)](#), EU:T:2019:202, § 62-63, 99-100

##### Non-distinctive – Slogan

The mark applied for does not have any particular originality or significance and does not require a minimum interpretative effort or trigger any particular cognitive process on the part of the relevant public. Rather, it is merely an ordinary advertising slogan according to which the goods and services make people more intelligent.



08/05/2019, T-473/18, [getsmarter \(fig.\)](#), EU:T:2019:315, § 38

##### Non-distinctive – Laudatory mark

The laudatory message is reinforced by the drawing of the diamond (§ 23-39).



17/01/2019, T-91/18, [DIAMOND CARD \(fig.\)](#), EU:T:2019:17, § 23-39

##### Non-distinctive – Laudatory mark

The mark will be understood merely as a laudatory message, namely that the goods cater to the welfare and safety of animals (§ 19-23). The figurative element (a heart that will be interpreted by the public in light of the verbal elements) does not give any distinctive character to the mark applied for (§ 24-25).



24/01/2019, T-181/18, [TAKE CARE \(fig.\)](#), EU:T:2019:30, § 19-25

## Non-distinctive laudatory figurative signs

achtung<sup>H</sup>

10/10/2019, T-832/17, [achtung! \(fig.\)](#), EU:T:2019:2; 03/09/2020, C-214/19 P, [achtung ! \(fig.\)](#), EU:C:2020:632

EUROLAMP

14/05/2019, T-466/18, [EUROLAMP pioneers in new technology \(fig.\)](#), EU:T:2019:326



09/04/2019, T-277/18, [PICK & WIN MULTISLOT \(fig.\)](#), EU:T:2019:230

ONE-OFF

10/06/2020, T-707/19, [ONE-OFF \(fig.\)](#), EU:T:2020:251



25/11/2020, T-882/19, [ΑΠΛΑ! \(fig.\)](#), EU:T:2020:558

## Non-distinctive – Sign of extreme simplicity – Basic geometric shapes

A sign of extreme simplicity, representing a basic geometric form or diverging from it only in a negligible way, does not permit the identification of the good or service for which registration is sought as originating from a specified undertaking. Such a sign, unless it has acquired distinctive character through use, is not capable of transmitting a message about the commercial origin that will be memorised by the relevant public, but will be perceived as exercising a purely ornamental or decorative function (§ 57-58). The fact that the mark applied for consists of part of a mark that is already registered is irrelevant (§ 64).



28/03/2019, T-829/17, [RAPPRESENTAZIONE DI UNA FORMA CIRCOLARE, FORMATA DA DUE LINEE OBLIQUE SPECULARI E LEGGERMENTE INCLINATE DI COLORE ROSSO \(fig.\)](#), EU:T:2019:199, § 57-58, 64

## Non-distinctive – Sign of extreme simplicity

The mark is excessively simple. The fact that the sign does not represent a geometrical form is irrelevant (§ 23-25). No aspect of the sign may be easily and instantly remembered, even by the most attentive relevant public, nor allow it to be immediately perceived as an indication of the commercial origin of the goods and services (§ 26-27). The trade mark applied for will be perceived exclusively as a decorative element (§ 28).



04/04/2019, T-804/17, [DARSTELLUNG VON ZWEI SICH GEGENÜBERLIEGENDEN BÖGEN \(fig.\)](#), EU:T:2019:218, § 23-25, 28

## Non-distinctive – Sign consisting solely of a colour representation of an octagonal polygon

The circumstance that a sign that does not represent a basic geometrical figure as such, does not suffice to support the view that it has the minimum distinctive character necessary to be registered as an EU trade mark (§ 28). A sign consisting solely of a colour representation of an octagonal polygon does not have any striking features that would be perceived immediately as an indication of the commercial origin of the goods by the relevant public (§ 29).



06/06/2019, T-449/18, [ACHTECKIGES POLYGON \(fig.\)](#), EU:T:2019:386, § 28-29

### Non-distinctive – Excessively simple sign

An excessively simple sign is not in itself capable of conveying a message which consumers can remember, so that they will not regard it as a trade mark unless it has acquired distinctiveness through use. The green arc in the mark applied for is a simple geometric shape with an ornamental or decorative function, which emphasizes the verbal elements. It is neither conspicuous nor has a lasting impression on the relevant public. That finding is not called into question by the use of the colour green, which is a colour frequently used in trade for advertising and marketing purposes (§ 38-40).

***bet-at-home*** [29/06/2022, T-640/21, bet-at-home \(fig.\), EU:T:2022:408](#)

### Distinctive character

There is no sufficiently direct and specific link between the EUTM ‘UNI’ and the goods at issue (‘writing instruments including correction pens’ in Class 16) that would enable the relevant public, immediately and without further thought, to perceive a reference to those goods. The public likely to perceive the term ‘uni’ as an abbreviation of the word ‘university’ must make a mental effort involving several steps. In so far as it means ‘unicolour’, it is difficult to perceive the term ‘uni’ as denoting one of the characteristics of the goods at issue unable to indicate the commercial origin of those goods (§ 37, 38, 49).

**uni** [13/07/2022, T-369/21, uni \(fig.\), EU:T:2022:451](#)

### Non-distinctive – Simple figurative sign – Combination of lines in black and white

A sign which is excessively simple and is constituted by a basic geometrical figure, such as a circle, a line, a rectangle or a conventional pentagon, is not, in itself, capable of conveying a message which consumers will be able to remember, with the result that they will not regard it as a trade mark unless it has acquired distinctive character through use (§ 17). However, it cannot be inferred from this that a mark is distinctive merely because it does not represent a basic geometric figure or an excessively simple shape. The mark must also have aspects which may be easily and instantly memorised by the relevant public and which would make it possible for that sign to be perceived immediately as an indication of the commercial origin of the goods it covers (§ 18).

Combination of black and white colour is commonplace, with the result that it cannot, by itself, confer on the marks a characteristic likely to be perceived by the relevant public as an indication of the origin of the goods at issue (§ 22).

Considered as a whole, the marks applied for do not represent more than the sum of black and white lines of which they are composed. Since those lines are not likely to present aspects, or communicate a message, which would be easily and instantly memorised by the relevant public, the marks will be perceived by the relevant public as having a decorative purpose and are devoid of any distinctive character (§ 26, 29).



[05/10/2022, T-501/21, DEVICE OF A COMBINATION OF LINES IN BLACK AND WHITE \(fig.\), EU:T:2022:610](#)

See also:  [05/10/2022, T-502/21, DEVICE OF A COMBINATION OF LINES IN BLACK AND WHITE \(fig.\), EU:T:2022:611](#)

### Non-distinctive – Sign of extreme simplicity

The cases of great simplicity of a sign are not limited to basic geometric figures, and the fact that a sign does not represent a geometric shape is not in itself sufficient for the sign to be considered as having the minimum degree of distinctiveness (§ 21). The sign applied for is a very simple shape, with no easily and immediately memorable characteristic that can enable it to be perceived immediately as an indication of the commercial origin of the services at issue (§ 27).



[13/09/2023, T-745/22, DARSTELLUNG EINER GESCHWUNGENEN WEISSEN LINIE IN EINEM DUNKLEN QUADRAT \(fig.\), EU:T:2023:545](#)

### Non-distinctive – Basic geometric figures

The contested sign will be perceived as a commonplace representation of a square inside a rectangle, which is not unusual, visually eye-catching or easy to memorise, irrespective of how they are arranged and, therefore, it will not be remembered as an indication of commercial origin (§ 44-46).



[07/02/2024, T-591/22, DEVICE OF A SQUARE IN A RECTANGLE \(fig.\), EU:T:2024:66](#)

### Non-distinctive figurative signs



05/09/2019, T-753/18, [#BESTDEAL \(fig.\), EU:T:2019:560](#)



20/11/2019, T-101/19, [imot .bg \(fig.\), EU:T:2019:793](#)



11/09/2019, T-34/19, [PRODUCED WITHOUT BOILING SCANDINAVIAN DELIGHTS ESTABLISHED 1834 FRUIT SPREAD \(fig.\), EU:T:2019:576](#)



26/09/2019, T-663/18, [Soba JAPANESE FRIED NOODLES \(fig.\), EU:T:2019:716](#)



23/09/2020, T-522/19, [BBQ BARBECUE SEASON \(fig.\), EU:T:2020:443](#)



22/10/2020, T-833/19, [DARSTELLUNG EINER GEOMETRISCHEN FIGUR \(fig.\), EU:T:2020:509](#)



30/06/2021, T-290/20, [Goclean \(fig.\), EU:T:2021:405](#)



Cash App 20/10/2021, T-210/20, [\\$ Cash App \(fig.\), EU:T:2021:711](#)



Cash App 20/10/2021, T-211/20, [\\$ Cash App \(fig.\), EU:T:2021:712](#)



19/01/2022, T-270/21, [PURE BEAUTY \(fig.\), EU:T:2022:12](#)

### 3.3.2.2 Typographical symbols

#### Non-distinctive – Symbols of the euro and of the dollar

It is a well-known fact that the symbols of the euro and of the dollar are commonly used to represent these currency units in daily life exchanges as well as in international trade and financial exchanges (§ 64). In view of the financial nature of the services at issue, it is possible that the relevant public perceives a link between the said symbols and these services, irrespective of the fact that these are not necessarily always linked with transactions in euros or dollars (§ 99). The public is likely to perceive the mark applied for as an indication or information about the price of the goods at issue (i.a., software in Class 9) (§ 103).

 16/12/2020, T-665/19, [€\\$\(fig.\)](#), EU:T:2020:631, § 112

### **Distinctive character – Trade mark comprising words and typographical signs – Lack of descriptive character**

The figurative sign has inherent distinctive character for the English-speaking part of the public at large with an average level of attention for goods in Class 3, such as *hair care preparations; perfumery; perfumed body spray and body butters* (§ 28, 56). The word ‘so’ can have several meanings depending on the context in which it is used and depending on whether it is used as an adverb or as a conjunction (§ 32, 43). The word as a conjunction meaning ‘therefore’ or ‘and then’ does not have any laudatory connotation (§ 34-35, 44).

As regards trade marks comprising words and typographical signs (here full stops and question marks), distinctiveness may, in part, be examined in relation to each of its terms or elements, considered separately, but must, in any event, depend on an appraisal of the whole which they comprise. The mere fact that each of those elements, considered separately, is devoid of distinctive character does not mean that their combination cannot present a distinctive character (§ 40-41). In the present case the signs added semantic content to the sign as a whole. The three full stops create a certain suspense and the question mark at the end of the sign raises a question. The punctuation marks therefore induce the relevant public to ask themselves what the word ‘so’ means and what it refers to. To answer this, and to give any meaning at all to the sign, interpretation is required of the relevant public (§ 42, 45).

The applicant does not put forward any argument seeking to show that the contested mark suggests a sufficiently direct and concrete link to the goods (§ 62).

[SO...?](#) 09/03/2022, T-196/21, [SO...? \(fig.\)](#), EU:T:2022:117, § 28, 32, 43, 34-35, 40-44, 45, 56, 62.  
09/03/2022, T-197/21, [So...?](#), EU:T:2022:118, § 29, 35-36, 41-43, 46, 57

#### **3.3.2.3 Pictograms**

##### **Non-distinctive**



07/11/2019, T-240/19, [DEVICE OF A BELL ICON \(fig.\)](#), EU:T:2019:779

#### **3.3.3 Shape marks**

##### **Non-distinctive**

The case-law relating to three-dimensional marks consisting of the appearance of the product designated is also applicable to the cases where the mark (the shape of a sole) constitutes only part of those goods (§ 111-112). The figurative patterns in the mark do not significantly differ

from those generally present on soles, that always involve more or less complex geometric patterns (§ 118-119).



29/03/2019, T-611/17, [REPRESENTATION D'UNE SEMELLE DE CHAUSSURE \(3D\)](#), EU:T:2019:210, § 111-112, 118-119

### Non-distinctive

Where a three-dimensional mark is constituted by the shape of the product, the mere fact that that shape is a 'variant' of a common shape of that type of product is not sufficient to establish that the mark has distinctive character for the purposes of Article 7(1)(b) EUTMR. It must always be determined whether such a mark permits the average consumer of that product, who is reasonably well informed and reasonably observant and circumspect, to distinguish the product concerned from those of other undertakings without conducting an analytical examination and without paying particular attention (§ 24-26).



19/06/2019, T-213/18, [SHAPE OF FAUCET/TAP FOR PREPARING AND DISPENSING BEVERAGES \(3D\)](#), EU:T:2019:435, § 24-26

### Non-distinctive – Assessment of distinctive character

Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or verbal element. It could therefore prove more difficult to establish distinctive character in relation to a three-dimensional mark than in relation to a word or figurative mark (22/06/2006, C-25/05 P, Bonbonverpackung, EU:C:2006:422, § 27 and the case-law cited) (§ 31).

The more closely the shape resembles the shape most likely to be taken by the product, the greater the likelihood of the shape being devoid of any distinctive character. Only a mark that departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character (07/10/2004, C-136/02 P, Torches, EU:C:2004:592, § 31 and the case-law cited).

The originality of a shape must be evaluated in the light of the situation on the market, taking as the starting point the date of filing of a three-dimensional mark. The presence on the market of shapes which might be counterfeit copies is irrelevant (21/05/2014, T-553/12, BATEAUX MOUCHES, EU:T:2014:264, § 46).

Where, in a specific market with an international dimension, such as the electric guitar market, the prevailing cultural references are, nonetheless, universal values also recognised by EU consumers, evidence from North American publications, which contains references to musicians from the EU, allows the characteristics of the EU market to be evaluated (§ 46-50).



28/06/2019, T-340/18, [SHAPE OF A FLYING V GUITAR \(3D\)](#), EU:T:2019:455, § 31, 46-50

### Non-distinctive – Assessment of distinctive character – Norms or customs of the sector

The shape of a bottle that is customary in the wine sector (shape of the traditional 'Bocksbeutel' bottle) (§ 40, 43-44) is also not distinctive in respect of beverages other than wines pertaining to adjacent markets, such as beers and mineral water, since these goods have a similar nature and target the same consumers (§ 20-22, 50, 53-54). The mark is devoid of distinctive character for *bottles*, regardless of whether they are filled with content or empty (§ 20-22, 56-58).



24/09/2019, T-68/18, [FORM EINER FLASCHE \(3D\)](#), EU:T:2019:677, § 20-22, 40, 43-44, 50, 56-58

### **Distinctive character – Assessment of distinctive character – Norms or customs of the sector**

A three-dimensional mark depicting the form of the good applied for can only be considered to be distinctive where that mark departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin (12/01/2006, C-173/04 P, Standbeutel, EU:C:2006:20, § 29, 31; 07/05/2015, C-445/13 P, Bottle, EU:C:2015:303, § 90-91) (§ 24-26).

There is no need to explicitly define the norms and customs of the sector of the goods concerned (C-445/13 P, Bottle, EU:C:2015:303, § 82-87) (§ 31).

Various factors, such as the aesthetic result and the aesthetic value, can be considered to justify the finding of a significant departure from the norms of the sector, as long as these factors relate to the finding of an 'objectively unusual visual effect of the design' of the shape (§ 32).



12/12/2019, C-783/18P, [FORM EINER FLASCHE \(3D\)](#), EU:C:2019:1073, § 24-26, 31-32

### **Non-distinctive**

The protection of a design right concerns the appearance of a product that differs from existing designs, and is based on the novelty of that design, namely that no identical design has been publicly disclosed, and on its individual character. By contrast, in the case of a trade mark, while the shape of the mark must necessarily be significantly different from the norm or from the customs of the sector concerned in order for it to have distinctive character, the mere novelty of that shape is not a sufficient ground for finding that distinctive character exists, since the decisive criterion is the ability of that shape to fulfil the function of indicating commercial origin (§ 64).



05/02/2020, T-573/18, [FORM EINES SCHNÜRSENKELS \(3D\)](#), EU: T:2020:32, § 64

### **Non-distinctive**

The mere possibility that a trade mark constitutes the whole or a part of the shape of the goods for which protection is claimed is sufficient to apply to figurative marks the case-law relating to signs which are indissociable from the appearance of the goods (§ 45).



05/02/2020, T-331/19, [REPRÉSENTATION D'UNE TÊTE DE LION ENCERCLÉE PAR DES ANNEAUX FORMANT UNE CHAÎNE \(fig.\)](#), EU:T:2020:33, § 45



05/02/2020, T-332/19, [REPRÉSENTATION D'UNE TÊTE DE LION ENCERCLÉE PAR DES ANNEAUX FORMANT UNE CHAÎNE \(fig.\)](#), EU:T:2020:33, § 45

### Non-distinctive

It is sufficient that a ground for refusal exists in relation to a non-negligible part of the target public (11/07/2019, T-601/18, *Fi Network*, EU:T:2019:510, § 26) (§ 16).

In order to determine whether the shape of the contested sign is significantly different from the norms or customs of the sector, it is not required to prove that an identical or almost identical shape already exists on the market. However, it must be checked whether, in the industry in question, a large variety of shapes is present, and whether the mark will be considered only as a variant of those shapes (28/06/2019, T-340/18, *SHAPE OF A FLYING V GUITAR (3D)*, EU:T:2019:455, § 35, 36) (§ 21).

If a shape is very simple, the relevant public will perceive it as a mere variant of the available shapes on the market, and not as originating from a particular manufacturer (§ 22).

Where a market is characterised by a wide variety of forms, the existing shapes on the market are a well-known fact (§ 29).

Novelty or originality are not relevant criteria when assessing the distinctive character of a mark (§ 33).



26/03/2020, T-570/19, [FORM EINES KÄSESTRANGS \(3D\) III](#), EU:T:2020:127, § 16, 21, 22, 29, 33



26/03/2020, T-571/19, [FORM EINES KÄSESTRANGS \(3D\)](#), EU:T:2020:128, § 16, 21, 22, 29, 33



26/03/2020, T-572/19, [FORM EINES KÄSESTRANGS \(3D\) II](#), EU:T:2020:129, § 16, 21, 22, 29, 33

### Non-distinctive

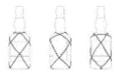
When the trade mark for which registration is sought consists of the three-dimensional shape of the packaging of the goods, the relevant norm or customs may be those that apply in the sector of the packaging of goods that are of the same type and intended for the same consumers as those goods for which registration is sought (12/01/2006, C-173/04 P, *Standbeutel*, EU:C:2006:20, § 33-34) (§ 28).



02/04/2020, T-546/19, [FORME D'UN RÉCIPIENT DORÉ AVEC UNE SORTE DE VAGUE \(3D\)](#), EU:T:2020:138, § 28

#### **Non-distinctive – Assessment of distinctive character – Norms or customs of the sector**

In its analysis of whether the mark departed from the norms or customs of the sector, the BoA was right to take into consideration the alcoholic beverages sector in general, rather than just the sector dedicated to rum (§ 37). Depending on the nature of the product, it may be necessary to consider a broader sector (§ 38). The analysis should not be limited to the sector dedicated to rum, since it cannot be excluded that rum consumers' perception of the mark might be influenced by the marketing methods developed for other drinks of the same kind and intended for the same consumers, including *alcoholic drinks* (§ 41).



13/05/2020, T-172/19, [FORME D'UN TRESSAGE SUR UNE BOUTEILLE \(3D\)](#), EU:T:2020:202, § 41

#### **Non-distinctive – Assessment of distinctive character – Norms or customs of the sector**

Novelty and originality are not relevant criteria in assessing the distinctive character of a trade mark. A trade mark must differ substantially from the basic forms of the product in question commonly used in trade. Furthermore, it cannot be a mere variant, or even a possible variant, of those forms. In this regard, there is no need to provide evidence of the usual character of the form used in trade in order to demonstrate the lack of distinctive character of the mark (07/10/2015, T-244/14, *Shape of a face in the form of a star (3D)*, EU:T:2015:764, § 38 and the case-law cited therein; see, to that effect, 28/06/2019, T-340/18, *SHAPE OF A FLYING V GUITAR (3D)*, EU:T:2019:455, § 39) (§ 39).

The presence on the market of a considerable number of shapes encountered by consumers makes it unlikely that they will regard a particular shape as belonging to a specific manufacturer rather than being just one of the variety of shapes characterising the market. The broad range of shapes with an original or fanciful appearance already present on the market limits the likelihood of a particular shape being considered as departing significantly from the prevailing norms on that market and, therefore, from being identified by consumers solely on the basis of its specificity or its originality (28/06/2019, T-340/18, *SHAPE OF A FLYING V GUITAR (3D)*, EU:T:2019:455, § 36) (§ 40).

On the basis of relevant case law, to assess the distinctive character of a three-dimensional mark consisting of the shape of the product itself or its packaging, it is necessary to verify whether the mark differs significantly from the norm or uses in the sector concerned (12/12/2019, C-783/18 P, *FORM EINER FLASCHE (3D)*, EU:C:2019:1073, § 24, 26 and 30) (§ 47).



25/11/2020, T-862/19, [FORME D'UNE BOUTEILLE \(3D\)](#), EU:T:2020:561, § 39-40, 47

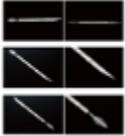
#### **Non-distinctive**



16/12/2020, T-118/20, [FORM EINER VERPACKUNGSFORM \(3D\)](#), EU:T:2020:604

### Non-distinctive

The three-dimensional mark is devoid of distinctive character since, in the perception of the general and specialised public of the EU with an average level of attention, the sign showing a low-price everyday product does not differ significantly from the norms and customs in the sector (§ 49-51, 59).



30/06/2021, T-624/19, [FORM EINES HANDGRIFFS MIT BORSTEN \(3D\)](#), EU:T:2021:393, § 49-51, 59

### Distinctive character – Three-dimensional EU trade mark consisting in the shape of the product itself – Criteria for assessment – Norm or customs of the sector

The assessment of distinctive character is not based on the originality or the lack of use of the mark applied for in the field to which the goods and services concerned belong (§ 40). A three-dimensional mark consisting in the shape of the product must necessarily depart significantly from the norm or customs of the sector concerned. Accordingly, the mere novelty of that shape is not sufficient to conclude that there is distinctiveness. However, the fact that a sector is characterised by a wide variety of product shapes does not mean that a new possible shape will necessarily be perceived as one of them (§ 41). The fact that goods have a high-quality design does not necessarily mean that a mark consisting in the three-dimensional shape of those goods makes it possible for them to be distinguished from the goods of other undertakings (§ 42). Taking into account the aesthetic aspect of the mark applied for does not amount to an assessment of the attractiveness of the product in question, but aims to determine whether that product is capable of generating an objective and uncommon visual effect in the perception of the relevant public (§ 43-44).

Considering the norm and customs of the sector concerned, the shape in question is uncommon for a lipstick and differs from any other shape existing on the market, most of which represent cylindrical and parallelepiped lipsticks (§ 49). The fact that a sector is characterised by a wide variety of product forms does not imply that a possible new form will necessarily be perceived as one of them (§ 50). The shape is reminiscent of that of a boat hull or a baby carriage (§ 52). The presence of the small oval embossed shape is unusual and contributes to the uncommon appearance of the mark applied for (§ 53-55). The fact that the lipstick represented by the mark cannot be placed upright reinforces the uncommon visual aspect of its shape (§ 56). Consequently, the relevant public will be surprised by this easily memorable shape and will perceive it as departing significantly from the norm and customs of the lipstick sector and capable of indicating the origin of the goods concerned. Accordingly, the mark applied for has distinctive character (§ 57).



14/07/2021, T-488/20, [FORME D'UN ROUGE À LÈVRE OBLONGUE, CONIQUE ET CYLINDRIQUE \(3D\)](#), EU:T:2021:443, § 34-44, 57

### **Non-distinctive – Packaging of liquid goods – Sole use of the shape**

Since liquid goods must, out of necessity, be packaged for sale, the average consumer will perceive the packaging first and foremost simply as a type of container. A three-dimensional trade mark consisting of such a container is not distinctive unless it permits the average consumer of the goods concerned, who is reasonably well informed and reasonably observant and circumspect, to distinguish those goods from the goods of other undertakings without any detailed examination or comparison and without being required to pay particular attention (§ 65).

The fact claimed by the applicant, that it was the only company producing the packaging as in the EUTM applied for, does not necessarily lead to a conclusion that this packaging was distinctive (§ 67).



08/09/2021, T-489/20, [FORM EINES KUGELFÖRMIGEN BEHÄLTERS \(3D\)](#), EU:T:2021:547, § 65, 67

### **Non-distinctive**

The trade mark applied for does not depart significantly from the norms or customs of the sector (i.e. the market for double-walled cups in Class 21). The common heart form is not distinctive as it merely stands for strong, positive emotions in a general laudatory sense (§ 23-31, 35, 40). With respect to drinks in Classes 30 and 32, a cup is a necessary tool for storage and/or proper consumption. The trade mark applied for is just an insignificant variant of common double-walled cups used for drinks. It is devoid of distinctive character (§ 31, 36-40). The evidence submitted to prove that the trade mark had acquired distinctive character through use is insufficient (§ 52-54).



17/11/2021, T-658/20, [FORM EINER TASSE \(3D\)](#), EU:T:2021:795, § 23-31, 35, 40, 52-54

### **Three-dimensional mark – Assessment of distinctive character – Significant departure from the customs or norms of the sector – Consideration of well-known facts – Irrelevance of presence of potential counterfeit copies on the market – Non-distinctive**

In order to ascertain whether the three-dimensional mark departs significantly from the customs or norms of the sector, it is not necessary to show that there are other goods on the market that reproduce all of the features of the contested mark. In order to conclude that there is no distinctive character, it is not necessary for the contested mark to be identical to existing shapes. It is necessary that the overall impression conveyed by that mark does not depart significantly from the norms or customs of the sector. In other words, the fact that a mark has an overall shape similar to variants of the product that are usually available on the market does not permit the finding that the mark, as a whole, departs significantly from the customary shapes in the sector (26/10/2017, T-857/16, SHAPE OF A TALL GLASS (3D), EU:T:2017:754, § 37-38) (§ 95-96).

It is a matter of common knowledge that, overall, the shape of the contested mark corresponds to the common shape of after-ski boots. The BoA could take this well-known fact into consideration (§ 98).

The presence on the market of shapes that are potential counterfeit copies is irrelevant to the assessment of the inherent distinctiveness of the contested mark with regard to its perception by the relevant public (28/06/2019, T-340/18, SHAPE OF A FLYING V GUITAR (3D), EU:T:2019:455, § 40 and case-law cited) (§ 110).



19/01/2022, T-483/20, [Shoes \(3D\)](#), EU:T:2022:11, § 95-96, 98, 110

### Non-distinctive – Beauty is irrelevant

It is not sufficient that the shape of the mark applied for differs from other shapes available on the market in relation to certain aesthetic characteristics of the product, such as the presence of a collar band forming only the lower part of the collar or its round shape. On the contrary, those characteristics must be sufficiently pronounced for consumers to be able to distinguish the product bearing the sign from those of other undertakings solely on the basis of its shape. In that regard, it cannot be ruled out that the aesthetic aspect of the mark applied for may be considered alongside other factors in order to determine whether it is different from the norm and customary in the sector. However, that aesthetic aspect must be understood as referring not to the beauty or lack of beauty of the goods offered in the shape of the mark applied for, but to the objective and unusual visual impact created by the specific design of the shape mark (§ 27).



23/03/2022, T-252/21, [FORM EINES STEHKRAGENS \(3D\)](#), EU:T:2022:157,

§ 27

### Non-distinctive

It is not sufficient for the public to be able to recognise the differences between the various citrus juicers, which is within the reach of a specialised public as in the present case, but it must be able to perceive the EUTM applicant's variant of citrus juicer as an indication of the origin of the product. Moreover, novelty or originality are not relevant criteria when assessing the distinctive character of a mark (§ 50, 51).



29/07/2022, T-51/22, [FORME DE PRESSE AGRUMES \(3D\)](#), EU:T:2022:490

### Shape mark – Significant departure from the norms or customs of the sector – Relevant sector not limited to the sector of the goods applied for

Packaging used in a wider sector, i.e. the medical sector, can be taken into account to establish the norm and customs relevant for the shape of products belonging to a narrower sector, i.e. dental preparations and articles in Class 5 (§ 27, 28, 31).

[21/09/2022, T-700/21, FORM EINER VERPACKUNGSFORM \(3D\)](#), EU:T:2022:565

### Non-distinctive – Blister packs in medical sector – Empty packaging

A basic rectangular, round or amorphous shape has become established as the standard in the medical sector for blister packs, which therefore also applies to flat blister packs for packaging 'dental preparations' in Class 5. On the one hand, the arrangement of the blisters varies on such a flat package, but is usually symmetrical; on the other hand, the blisters are sealed on the top with a film that is either smooth or embossed (§ 32, 33).

The contested mark is composed only of non-distinctive components and there are no elements that would indicate that the contested mark as a whole is distinctive. The fact that a composite mark is made up only of features which are devoid of any distinctive character in relation to the goods concerned generally leads to the conclusion that that trade mark, taken as a whole, is devoid of distinctive character. That would not be the case only if concrete factors, such as the way in which the various features are combined, were to indicate that the composite trade mark, taken as a whole, is greater than the sum of its parts (§ 52-54).

Where the shape of a packaging is devoid of distinctive character together with the packaged goods, it cannot be distinctive as empty packaging either (§ 57, 58).



[21/09/2022, T-700/21, FORM EINER VERPACKUNGSFORM \(3D\), EU:T:2022:565](#)

### **Non-distinctive – Figurative mark – Shape of the packaging of the goods**

The fact that the sign is not represented in perspective in the EUTM application, or that it can also be perceived as a flat figure, does not preclude the possibility that a significant part of the relevant public may perceive, without reflection, the sign at issue as a depiction of a container capable of containing the goods for which protection was sought (§ 21). The principles developed in the context of three-dimensional trade marks consisting of the appearance of the product or its packaging is applicable to figurative trade marks consisting of a two-dimensional representation of the product or its packaging, even where the sign is a very simple and purely schematic representation of the product in question, without any perspective (§ 27).



[29/03/2023, T-199/22, RAPPRESENTAZIONE DI UN CONTENITORE CILINDRICO DALLE LINEE ONDULATE \(fig.\), EU:T:2023:173](#)

### **Distinctive – Goods taking the shape of the sign – Sign not representing the goods**

The figurative mark at issue is not a two-dimensional representation of the goods (jewellery). The fact that items of jewellery may take the shape of a teddy bear is not in itself sufficient to establish that the contested mark consists of a two-dimensional representation of the shape of the goods at issue. Such an assessment would preclude any other use of the sign as a figurative mark; the contested mark may be used as such on packaging, labels or other advertising material (§ 45-47).



[26/07/2023, T-591/21, DEVICE OF THE OUTLINE OF A BEAR \(fig.\), EU:T:2023:433](#)

### **Non-distinctive – Shape of the goods**

The shape of the bag constituting the mark applied for bears a significant resemblance to the most common bag shapes. The few particularities are not sufficiently distinctive features to suggest that the mark deviates significantly from the norms and customs in the sector. These are merely variations of the shapes that can be found in this industry. Consequently, the mark applied for lacks distinctive character (§ 57).



[08/11/2023, T-113/23, FORM EINER TRAGETASCHE \(3D\), EU:T:2023:702](#)

See also,



[EU:T:2023:703](#), § 55

[08/11/2023, T-114/23, FORM EINER TRAGETASCHE \(3D\),](#)

### 3.3.4 Position marks

#### Non-distinctive

According to established case-law, only a mark that departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) EUTMR. That case-law, which was developed in relation to three-dimensional trade marks consisting of the appearance of the product itself, also applies where a figurative sign consists of the two-dimensional representation of a product (§ 25). It further applies where a mark represents only part of a designated product inasmuch as the relevant public will immediately, and without further thought, perceive it as a representation of a particularly interesting or attractive detail of the product in question, and not as an indication of its commercial origin (§ 26). The decisive element is the fact that the sign is indissociable from the appearance of the product designated (§ 28).



[14/11/2019, T-669/18, VIER AUSGEFÜLLTE LÖCHER IN EINEM REGELMÄßIGEN LOCHBILD \(posit.\), EU:T:2019:788, § 25, 26, 28](#)

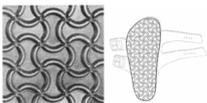
#### Non-distinctive – Three-dimensional position mark

Average consumers are not in the habit of making assumptions about the origin of products on the basis of signs that are indistinguishable from the appearance of the goods. The case-law applies to three-dimensional marks, two-dimensional figurative marks representing the external appearance of the goods, pattern marks and position marks (§ 17). The bottle top does not depart significantly from the norms and customs of the sector, since it is composed of several components that are not untypical for spirits and liqueurs (§ 37).



[16/01/2019, T-489/17, DARSTELLUNG EINES FLASCHENVERSCHLUSSES \(Posit.\), EU:T:2019:9, § 17, 37](#)

#### Non-distinctive – Position mark



[02/06/2021, T-365/20, FORM EINES MUSTERS EINER SCHUHSOEHLE \(3D\), EU:T:2021:319](#)

#### Non-distinctive – Position mark

The sign is devoid of distinctive character for goods in Class 19, namely tiles and other non-metallic coatings. The relevant public will not perceive the pattern as a design that departs

substantially from the finishes and appearances of the commonly used materials in this sector. The complexity of the design pattern applied for will not enable the relevant public to retain its specific details (§ 35-38).



12/01/2022, T-259/21, [Marca de patrón](#), EU:T:2022:1, § 35-38

### **Inherent distinctiveness of simple and banal shapes placed on shoes**

While it is true that it has already been held that there is nothing to prevent a distinctive sign from also serving other purposes, in particular a decorative purpose and that simple signs consisting of a single letter were not, a priori, devoid of distinctive character within the meaning of Article 7(1)(b) EUTMR, the fact remains that a design, which is simple and banal, is unlikely to acquire distinctive character simply because it is placed on the side of the shoe, since many manufacturers of sports shoes or casual shoes use relatively simple patterns on the side of the shoe (§ 59).

Although many manufacturers of sports shoes have developed a practice of placing their trade mark on the side of the shoe or that sellers display in shops the side of the shoes on which the mark appears, that information still does not make it possible to determine that the average consumer has learned to establish an automatic link between the sign featuring on the side of a sports shoe and a particular manufacturer and that that consumer will therefore necessarily perceive any geometric shape placed on the side of a sports shoe as being a trade mark (§ 60).

To accept that every geometric shape, even the most simple, has distinctive character because it features on the side of a sports shoe would make it possible for some manufacturers to appropriate simple, and above all decorative, shapes, which must remain accessible to everyone, with the exception of those situations in which the distinctive character of the sign has been acquired by use (§ 61).

The fact that certain manufacturer or other company marketed footwear with various kinds of stripes and graphic features on the side of the shoe or even that designs containing similar stripes were registered cannot, in itself, suffice to show that the mark lacks distinctive character (§ 66).



04/05/2022, T-117/21, [DEVICE OF TWO CROSSED STRIPES PLACED ON THE SIDE OF A SHOE \(fig.\)](#), EU:T:2022:271, § 59-61, 66

### **Assessment of distinctive character – Requirement of significant departure from the norms and customs of trade**

As regards the applicant's argument that the Board of Appeal did not take account of the specific conditions which apply to marks that are indissociable from the appearance of the goods, it is sufficient to state that it is ineffective since the contested mark takes the form of a design intended to be placed on part of the designated goods and not the form of a two-dimensional representation of a shoe (§ 70).



04/05/2022, T-117/21, [DEVICE OF TWO CROSSED STRIPES PLACED ON THE SIDE OF A SHOE \(fig.\)](#), EU:T:2022:271, § 70

### 3.3.5 Pattern marks

#### **Pattern trade mark / Figurative trade mark – Lack of distinctive character – Inherent distinctive character – Acquired distinctive character – Article 7 (1)(b) EUTMR**

The presence on the market of a significant number of shapes encountered by consumers makes it unlikely that they will regard a particular shape as belonging to a specific manufacturer rather than being just one of the variety of shapes characterising the market (§ 21).

With regard to the broad range of the applicant's goods (Classes 3, 6-9, 11, 12, 14, 16, 18, 20, 21, 24, 25, 27, 28), the consumer is in general confronted with a large number of patterns or combinations of basic geometric shapes, such as various designs of lines, circles, rectangles, pentagons or stars. In the present case, it is decisive whether the design of geometric figures embodied in the trade mark applied for departs significantly from the norms or customs of the sector and is therefore perceived by the relevant public as an indication of the commercial origin of these goods. On account of the simplicity of this design – regular repetition of a geometric figure such as a three-pointed star, (in two different sizes), in white on a black background – the relevant public will not see in this shape the identification of the goods of a particular manufacturer, but rather the expression of the variety of shapes on the market concerned. As regards the services (Classes 35-37, 39, 41 and 43), whose appearance cannot coincide with the mark applied for, the decisive factor is whether that mark is capable, from the point of view of the relevant public, of distinguishing the services of one undertaking from those of other undertakings. In this regard, it is found that the targeted public would merely see in the contested mark the juxtaposition of simple geometric figures in two different sizes in white against a black background, which would be perceived as a purely decorative or aesthetic element and not as an indication of the origin of the services (§ 22).

Article 7 EUTMR clearly distinguishes between, on the one hand, the intrinsic properties and, on the other hand, the acquired properties of the sign (including its constituent elements). Whether a sign has acquired a distinctive character through the use in the marketplace is only examined within the context of Art. 7(3) EUTMR (§ 25).

In its trade mark application, the applicant did not rely on Article 7 (3) EUTMR, nor did it claim that the trade mark applied for had acquired distinctive character through use within the meaning of that provision. Thus, it cannot successfully rely on the actual and specific use of the trade mark applied for or on the reputation of another trade mark that differs from the trade mark applied for and constitutes an isolated 'tri pointed star within a circle'. Such considerations are irrelevant here, since this does not give the trade mark applied for any original distinctive character within the meaning of Article 7 (1) (b) EUTMR (§ 26).



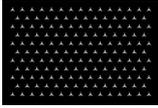
30/03/2022, T-277/21, [DARSTELLUNG VON DREIZACKIGEN ELEMENTEN AUF SCHWARZEM HINTERGRUND I](#) (other), EU:T:2022:194, § 21, 22, 25, 26



30/03/2022, T-278/21, [DARSTELLUNG VON DREIZACKIGEN ELEMENTEN AUF SCHWARZEM HINTERGRUND II](#) (other), EU:T:2022:195, § 21, 22, 25, 26



30/03/2022, T-279/21, [DARSTELLUNG VON DREIZACKIGEN ELEMENTEN AUF SCHWARZEM HINTERGRUND IV](#) (fig.), EU:T:2022:196, § 21, 22, 25, 26



30/03/2022, T-280/21, [DARSTELLUNG VON DREIZACKIGEN ELEMENTEN AUF SCHWARZEM HINTERGRUND III](#) (fig.), EU:T:2022:197, § 21, 22, 25, 26

### 3.3.6 Colour marks

#### 3.3.6.1 Single colours

##### **Non-distinctive – Colour marks – Colour per se**

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



09/09/2020, T-187/19, [Colour Purple -2587C \(col\)](#), EU:T:2020:405, § 51

##### **Relevant public – Colour marks**

Colour marks can be distinctive if the relevant market is a very specific market (6/05/2003, C-104/01, Libertel, EU:C:2003:244, § 66). The distinctiveness must be assessed, inter alia, by reference to the perception of the relevant public. Therefore, the BoA is obliged to define the relevant public in an unambiguous manner (§ 78).



05/10/2022, T-168/21, [BLAU \(col\)](#), EU:T:2022:605

##### **Non-distinctive – Colour mark – Agricultural machinery in Class 7**

Colours and abstract colour combinations only have original distinctive character in exceptional circumstances, since in general they are indistinguishable from the appearance of the designated goods themselves and are not, in principle, used as a means of identifying commercial origin (§ 30).

The characteristics of the relevant market such as the fact that there are not many suppliers of agricultural apparatus and machines, that the farmers are relatively attentive and that the goods are relatively expensive do not correspond to a 'very limited' market within the meaning of findings in the judgments of 06/05/2003, C-104/01, Libertel, EU:C:2003:244, § 66 and 21/10/2004, C-447/02 P, shade of orange, EU:C:2004:649, § 79. It cannot be inferred from these judgments that the mere fact that the number of goods in question is very limited and the relevant market is very specific makes the circumstances so exceptional that the colour mark in question must be presumed to have an inherent distinctive character (§ 49, 50).

Various shades of the colour blue are used in the agricultural sector. The colour 'sky blue' is a simple and common colour and is by no means a striking or surprising colour in the agricultural equipment and machinery sector (§ 58, 60).



26/10/2022, T-621/21, [BLAU](#), EU:T:2022:676

#### 3.3.6.2 Colour combinations

##### **Non-distinctive – Colour mark**

The inherent distinctiveness of a colour is inconceivable other than in exceptional circumstances, where the number of goods or services for which the mark is claimed is very restricted and the relevant market very specific. However, it cannot be inferred that any colour mark is necessarily distinctive on the sole ground that it designates only a very restricted number of goods (in this case *field sprayers* in Class 7) and that the relevant market is very specific (in this case the agricultural machines sector) (§ 20).



[04/05/2023, T-618/22, GREEN, ORANGE](#)

### 3.3.7 Sound marks

#### Assessment of distinctive character – Sound mark – Criteria

A sound must have ‘a certain resonance’ (13/09/2016, T-408/15, SON D’UN JINGLE SONORE PLIM PLIM (sound mark), EU:T:2016:468, § 45) enabling the target consumer to perceive and consider it as a mark (§ 24). Such resonance is lacking where the sound is perceived as a functional element of the goods and services applied for (§ 24, § 41) or as an indicator without any intrinsic characteristic of its own (§ 24), for example, due to its excessive simplicity or banality (§ 27).

The target consumer must, by the mere perception of the sound mark alone – that is without its combination with other elements – be able to link the goods or services to their commercial origin (§ 25). Marketing habits in the economic sector can evolve in a very dynamic way, including as regards the use of sound marks (§ 26).

The requirement that a sign ‘departs significantly from the norm or customs of the sector’ established by case-law (07/10/2004, C-136/02 P, Torches, EU:C:2004:592, § 31) for assessing the consumer’s perception of marks consisting of the shape or the packaging of the products applied for does not apply to sound marks (§ 32).

The first element of the mark – the sound of opening a can – is perceived by the relevant consumer as purely technical and functional, as it is intrinsic to a specific technical solution for handling and consuming the beverages applied for (§ 40). Its second sound element – the sound of fizzing bubbles – is perceived as referring to the drinks applied for (§ 42). Perceived in its entirety, the mark is not distinctive (§ 43, 48). This is so despite the silence of ten seconds between the two sound elements and the length (nine seconds) of the second sound element. Such nuances of the classic sounds made by drinks when their container is opened are perceived as mere variants of the usual sounds (§ 45). They are not sufficiently resonant to distinguish them from comparable sounds (§ 46). The mere fact that the sound of fizzing bubbles is usually shorter and follows immediately the sound of opening a can does not confer any significance on the sounds allowing the relevant consumer to identify them as indicator of business origin of the goods (§ 47). The combination of the sound elements and the silent element is not unusual in its structure. Rather, these elements correspond, as they are predictable and common in the drinks market (§ 48).

[07/07/2021, T-668/19, KLANG EINES GERÄUSCHES, WELCHES MAN BEIM ÖFFNEN EINER GETRÄNKEDOSE HÖRT, EU:T:2021:420, § 24-27, 32, 41-43, 45-48](#)

### 3.3.8 Motion, multimedia and hologram marks

[No key points available yet.]

## 4 ARTICLES 7(1)(c), 59(1)(a) EUTMR – DESCRIPTIVE TRADE MARKS

### 4.1 ASSESSMENT CRITERIA

#### **Invalidity proceedings – Evidence for descriptive character must relate to the trade mark’s filing date**

In an invalidity action, the evidence of the descriptive character of a mark must relate to the time of the application to make it possible to draw conclusions about the situation at that time (§ 58).

13/05/2020, T-86/19, [BIO-INSECT Shocker](#), EU:T:2020:199, § 58

#### **Assessment of descriptive character – ‘Characteristic’ under Article 7(1)(c) EUTMR**

A characteristic, within the meaning of Article 7(1)(c) EUTMR, must be objective and inherent to the nature of the product or service, as well as intrinsic and permanent for that product or service (07/05/2019, T-423/18, *vita*, EU:T:2019:291, § 44 and case law cited) (§ 42).

26/02/2021, T-809/19, [EL CLASICO](#), EU:T:2021:100, § 42

#### **Assessment of descriptive character – Possible characteristics referred to in Article 7(1)(c) EUTMR – Taste or flavour of goods – Colour of a product**

A trade mark which contains elements capable of referring to the taste or flavour of goods may be regarded as descriptive (18/01/2017, T-64/16, *Tasty Puff* (fig.), EU:T:2017:13, § 35 (§ 48).

The colour of a product may be one of the characteristics referred to in Article 7(1)(c) EUTMR, that colour constitutes a characteristic which is objective and inherent to the nature of that product, as well as being intrinsic and permanent for that product (25/06/2020, T-133/19, *OFF-WHITE* (fig.), EU:T:2020:293, § 43) (§ 58).

09/06/2021, T-130/20, [SIENNA SELECTION](#), EU:T:2021:341, § 48, 58

#### **Assessment of descriptiveness of a sign with several elements – Reference to online databases as evidence**

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

The descriptiveness of a trade mark which consists of several elements may be assessed, in part, for each of those elements taken separately, but must also be established for the whole that they comprise (19/12/2019, T-69/19, *Bad Reichenhaller Alpensaline* (fig.), EU:T:2019:895, § 22) (§ 43).



23/09/2020, T-738/19, [Wi-Fi Powered by The Cloud](#) (fig.), EU:T:2020:441, § 38, 43

#### **Descriptive – Assessment of descriptiveness – Irrelevant criteria for the assessment**

The sign is descriptive, since it will be directly understood by English-speaking consumers as ‘extreme sun protection’ or ‘intensive high-quality sun protection’, corresponding to the purpose and effect of products for sun protection (§ 29-33, 47). For the assessment of descriptiveness it is irrelevant (i) whether the component ‘ULTRA’ may be perceived otherwise than ‘extreme’,

(ii) whether the mark may have additional alternative meanings, (iii) whether the mark may be also perceived as a fanciful combination of word elements or (iv) whether the mark is currently in actual use as a descriptor (§ 32).

25/02/2021, T-437/20, [Ultrasun](#), EU:T:2021:109, § 29-33, 47

### **Criteria for assessment of descriptive and non-distinctive character – Irrelevance of prior use as a trade mark**

Article 7(1)(b) and (c) CTMR [now EUTMR] relate solely to the intrinsic characteristics of a sign for which registration is sought. It is only in the context of the application of Article 7(3) CTMR [now Article 7(3) EUTMR] that the actual use of a sign for which registration is sought must be assessed. This provision allows the registration of a sign which is not originally distinctive but which has acquired distinctive character in respect of the goods or services for which registration is sought by virtue of the use made of it (§ 44).

The argument that the term ‘mastihacare’ is perceived by the Greek-speaking consumer as a distinctive sign enabling the goods bearing it to be identified as originating from the applicant, thus fulfilling the function of origin indicator of the mark applied for, must be rejected (§ 43). Similarly, the fact put forward by the applicant that the Greek authorities granted the applicant the exclusive right to exploit ‘mastiha’ and its products is not relevant to the assessment of the descriptive character of the mark applied for nor its intrinsic distinctive character. Such a circumstance has no bearing on the perception and understanding by the relevant public of the term ‘mastihacare’ with regard to the goods (§ 45). The possibility that the Greek-speaking public may recognise the terms ‘mastiha’ or ‘mastihacare’ as distinguishing the applicant’s own goods cannot, in this case, preclude the application of the absolute grounds for refusal laid down in Article 7(1)(b) and (c) CTMR [now EUTMR], as this perception of the mark applied for can be taken into account only in the context of the application of Article 7(3) of that regulation (§ 46).

29/09/2021, T-60/20, [Mastihacare](#), EU:T:2021:629, § 44-46

### **Descriptiveness – Burden of proof – Relevant date – Well-known fact – Terms found in dictionaries**

The term ‘scruffs’ is associated with worn goods that are already in the possession of their owner and are suitable for casual or informal wear or activities which are hard on clothes. Consequently, the BoA did not make any error of assessment in finding that the evidence showed colloquial use of the term ‘scruffs’ to designate clothes worn for comfort and not appearance, which may be exposed to dirt or destroyed without consequence. It also did not err in finding that those goods did not constitute an objective category of clothing, in that their worn state was not perceived as constituting an intrinsic or essential characteristic of shop-bought items. This is because recycled or second-hand goods are, in principle, sold in a good state and consumers do not expect to purchase clothes which were in a devalued state (§ 32).

The EUIPO’s obligation to examine, of its own motion, the relevant facts that may lead it to apply absolute grounds for refusal is restricted to the examination of the application for an EU trade mark carried out by the EUIPO’s examiners and, on appeal, by the BoA during the procedure for registration of that mark. However, in invalidity proceedings, as the registered EU trade mark is presumed to be valid, it is for the person who has filed the application for a declaration of invalidity to invoke, before the EUIPO, the specific facts that call the validity of that trade mark into question (§ 36).

In the context of an application for a declaration of invalidity based on Article 59(1)(a) EUTMR, the relevant date for the purpose of examining whether an EU trade mark complies with Article 7 EUTMR is the date on which the application for registration was filed (§ 38).

The applicant has not established that the definition of the term 'scruffs' constituted a relevant well-known fact at the date of filing of the application for registration of the contested mark (§ 41).

The mere inclusion of a term in one or more dictionaries cannot suffice to show that the relevant public will immediately perceive its meaning, even if they are native speakers of the language concerned (§ 43).

[30/03/2022, T-720/20, \*Scruffs\*, EU:T:2022:189, § 32, 36, 38, 41, 43](#)

### **Not descriptive – No clear definition – Assessment of descriptive character – Irrelevance of Google Trends Analysis**

The evidence submitted does not prove that there is a single and explicit definition of the term 'skilltree' as it can be interpreted differently depending on the fields or games involved. In the absence of a clear semantic definition of the term 'skilltree', it cannot therefore be established in the present case that that term is immediately and without any further consideration perceived by the relevant public as an easily recognisable characteristic of software or a computer game (Class 9) (§ 71, 72).

For the purposes of assessing the descriptive character of a sign, it is irrelevant how many users have entered an expression or a term in the internet search engine since just from that cannot be inferred whether these internet users understand the term as descriptive or non-descriptive for the goods and services at issue (§ 76).

[14/09/2022, T-607/21, \*Skilltree studios\*, EU:T:2022:553](#)

### **Characteristic of goods or services**

A 'characteristic' of goods or services within the meaning of Article 7(1)(c) EUTMR is one which serves to designate a property, easily recognizable by the relevant trade circles, of the designated goods or services (§ 26). It can concern not only an actual but also a potential characteristic of those goods or services, even if it does not exist in the current state of the art (§ 27). It is immaterial whether such a characteristic is commercially essential or incidental. However, it must nevertheless be objective and inherent in the nature of the product or service concerned, as well as intrinsic and permanent for that product or service (§ 28).

[05/10/2022, T-802/21, \*JUST ORGANIC \(fig.\)\*, EU:T:2022:599](#)

### **Perception of Greek words transliterated in Latin character**

Transliterations into Latin characters of Greek words must be treated in the same way, for the purpose inter alia of examining the absolute grounds for refusal set out in Article 7(1)(b) and (c) EUTMR, as words written in Greek characters (§ 27).

[09/11/2022, T-13/22, \*POLIS LOUTRON \(fig.\)\*, EU:T:2022:688](#)

### **Descriptive – Irrelevance of the commercial significance of the characteristic**

The characteristic described by the trade mark applied for does not have to be commercially essential, provided that it is objective and inherent in the nature of the goods or services. The fact that consumers are guided in their purchases by other considerations, such as the shape, weight or style of the product, does not affect the descriptive character of the mark applied for (§ 53).



[21/12/2022, T-777/21, \*ECO STORAGE \(fig.\)\*, EU:T:2022:846](#)

### **Assessment of descriptive character – Probative value of Wikipedia extracts**

Information derived from an article in the online collective encyclopaedia Wikipedia, the content of which can be modified at any time and in certain cases by any visitor, even anonymously, constitutes unreliable information. However, such articles can nevertheless corroborate information from other sources such as press articles and statements from professionals, traders and consumers (§ 28).

[01/02/2023, T-319/22, aquamation, EU:T:2023:30](#)

### **Descriptive – Future descriptive use**

For the refusal of an EUTM application under Article 7(1)(c) EUTMR, it is not necessary that the signs and indications referred to in this provision are already actually used to describe the goods and services or characteristics thereof. It is sufficient that the signs and indications could be used for that purpose. In order to assess descriptiveness, the EUIPO must therefore examine not only whether a trade mark for which registration is sought currently represents, in the eyes of the relevant public, a description of the characteristics of the goods or services concerned, but also whether this can be reasonably expected for the future (§ 32, 33).

[01/02/2023, T-319/22, aquamation, EU:T:2023:30](#)

### **Descriptive – Perception of word signs belonging to a certain linguistic area**

The legal principles developed by the EU case-law for assessing the perception of word signs are equally applicable across all linguistic areas of the EU (§ 55).

[26/07/2023, T-315/22, Sütat, EU:T:2023:432](#)

### **Assessment of descriptive character – Irrelevance of the use as a company name**

The fact that a term corresponds to the company name of a legal person is irrelevant for the purposes of examining the descriptive character of that term, having regard to the fact that such an examination is carried out, first, in relation to the goods and services in respect of which registration of the mark has been applied for and, second, in relation to the perception of the relevant public (§ 64).

[20/12/2023, T-779/22, Haus & Grund, EU:T:2023:854](#)

### **Assessment of descriptive character – Economically incidental characteristic**

A characteristic within the meaning of Article 7(1)(c) EUTMR must be an 'objective characteristic inherent in the nature of the product [or service]' or an 'intrinsic and permanent' characteristic of that product or service, even if it does not matter whether such a characteristic is economically essential or incidental (§ 69).

[20/12/2023, T-779/22, Haus & Grund, EU:T:2023:854](#)

### **Assessment of descriptive character – Descriptive character for a subset of specific goods – Application of Article 7(1)(c) EUTMR to the broader category**

The EUIPO may take into account that there is a subset of specific goods among the registered categories of goods for which a trade mark may be descriptive. In such a case, the finding of descriptiveness of a trade mark applies not only to that subset of specific goods for which the trade mark is directly descriptive, but also, in the absence of a corresponding limitation by the trade mark applicant, to the broader category to which those goods belong (§ 42).

[28/02/2024, T-746/22, COMPTON, EU:T:2024:134](#)  
[28/02/2024, T-747/22, Compton \(fig.\), EU:T:2024:135](#)

## 4.2 RELEVANT PUBLIC AND LEVEL OF ATTENTION / RELEVANT TRADE CIRCLES

### **Specialist public – No decisive influence the assessment of the descriptiveness**

The fact that the relevant public is a specialist public cannot have a decisive influence on the legal criteria used to assess the distinctive character of a sign. The same is true of the assessment of the descriptiveness of a sign (§ 14).

*07/05/2019, T-423/18, [vita](#), EU:T:2019:291, § 14*

### **Relevant public – Level of command of the non-EU languages**

The GC did not distort the evidence or fail to reason its assessment of the relevant public and the descriptiveness of the term 'PLOMBIR' for ice cream (as the transliteration into Latin characters of the word 'Пломбир', meaning 'ice cream' in Russian). The relevant public was the Russian-speaking public, which included that part of the general public within the EU that understood or spoke Russian in Germany and the Baltic States. Whether or not Russian was understood in Germany, or whether the GC had committed an error in finding that Russian was understood in Germany, was irrelevant, as the judgment would still stand on the basis of the well-known fact established by the GC that Russian was understood in the Baltic States (§ 41-43). Although the GC had not stated whether the level of command of Russian in the Baltic States was that of a native speaker, it had adequately reasoned that it had been proven that 'Plombir' was used in everyday Russian (§ 68-74).

*18/06/2020, C-142/19 P, [PLOMBIR](#), EU:C:2020:487, § 41-43, 68-74*

### **Relevant public – Colloquial expression**

To ensure the effectiveness of the prohibition on registration of descriptive marks pursuant to Article 7(1)(c) EUTMR, EUIPO is entitled to take into account that there is a narrower segment within the general public consisting of persons for whom the goods or services covered by the mark concerned are primarily intended (§ 31).

With regard to the argument that the BoA took into account evidence which did not concern the relevant public, namely recipe suggestions, discussion forums or newspaper articles, it is sufficient to note that the purchasers of barbecues, irrespective of whether they belong to the professional or general public, can rely on such sources in the present case (§ 40).

The use of a colloquial expression may be known and understood by the relevant public if, inter alia, its use has become common in the course of trade (§ 44).

*04/05/2022, T-261/21, [Steaker](#), EU:T:2022:269, § 31, 40, 44*

### **Relevant public's knowledge of a language other than its mother tongue – Basic English words**

The terms 'good' and 'calories' are words belonging to the basic vocabulary of English, the meaning of which can be assumed to be known to the average consumer in the general public of the Union. Therefore, the argument that BoA made an extensive assessment of English-speaking consumers, by reference to the Scandinavian countries or Finland, is inoperative (§ 33, 34).

[22/06/2022, T-602/21, good calories \(fig.\), EU:T:2022:382](#)

### **Relevant public's knowledge of a language other than its mother tongue – Basic American English**

The relevant public in the Scandinavian countries, the Netherlands and Finland has a basic understanding both of British English and of American English. Consumers in those Member States are accustomed, from the youngest age, to seeing films and television series which are produced in the United States and are broadcast in their original language (§ 51).

[14/09/2022, T-498/21, Black Irish, EU:T:2022:543](#)

### **Assessment of distinctive or descriptive character – Determination of the relevant public and its level of attention not decisive**

The level of attention of the relevant public is not decisive in assessing whether a mark is caught by the grounds for refusal set out in Article 7(1)(b) or in Article 7(1)(c) EUTMR (§ 23). The accurate determination of the relevant public will not, in this instance, have a decisive effect on the assessment as to whether the sign is descriptive (§ 24).

[26/10/2022, T-776/21, GAME TOURNAMENTS \(fig.\), EU:T:2022:673](#)

### **Determination of the relevant public**

If the goods are very specific apparatus used in chemical laboratories, such as liquid-liquid extraction columns in Class 7, and despite the fact that these goods are intended for industry professionals, the relevant public are not only industry professionals but also scientists and researchers (§ 23, 24).

[25/01/2023, T-351/22, Scheibel, EU:T:2023:16](#)

[25/01/2023, T-352/22, Karr, EU:T:2023:17](#)

### **Descriptive – Non-negligible part of the relevant public**

Article 7(1)(c) EUTMR precludes registration of a trade mark where a non-negligible part of the relevant public perceives that mark as descriptive. Consequently, the BoA could examine the descriptiveness only in relation to IT and marketing specialists (§ 16, 17).

[26/07/2023, T-22/23, MARKT-PILOT, EU:T:2023:439](#)

### **Descriptive – Level of attention**

The argument that the general public is accustomed to the name of a game being indicative of its content does not demonstrate an increased level of attention. Moreover, the public's knowledge of these alleged customs of the games industry does not necessarily increase the likelihood that the sign will be perceived as non-descriptive or distinctive. Rather, it could lead to a finding that it is descriptive or non-distinctive (§ 20).

[06/09/2023, T-425/22, Commandos, EU:T:2023:508](#)

### **General public – Goods sold without prescription – Average level of attention**

The level of attention for 'gums for medical purposes' in Class 5 is average as these products are sold without a prescription and intended for all consumers (§ 30, 31).

[11/10/2023, T-87/23, THE GOOD GUMS \(fig.\), EU:T:2023:617](#)

### **Assessment of descriptive character – Irrelevance of the level of attention**

The question as to whether the level of attention of the relevant public is low, average, or high is irrelevant for the application of Article 7(1)(c) EUTMR (§ 40).

[20/12/2023, T-779/22, Haus & Grund, EU:T:2023:854](#)

### **Assessment of descriptive character – Substantial part of the relevant public – Narrower circle within the relevant public**

In order to ensure the practical effectiveness of Article 7(1)(c) EUTMR, the EUIPO may take into account that there is a narrower circle within the public at large, consisting of persons for whom the goods or services covered by the trade mark applied for are primarily intended, and, in particular, persons who have specialised knowledge in a particular field which puts them in a better position to understand the meaning of certain terms or concepts. Article 7(1)(c) EUTMR is applicable where the contested mark is descriptive for a substantial part of the relevant public. It is not necessary to examine whether the other consumers belonging to that public will also perceive that sign as descriptive (§ 53, 56).

[28/02/2024, T-746/22, COMPTON, EU:T:2024:134](#)

[28/02/2024, T-747/22, Compton \(fig.\), EU:T:2024:135](#)

## **4.3 DESCRIPTIVE CHARACTER IF THE SIGN IN QUESTION: EXAMPLES**

### **4.3.1 Word marks**

#### **4.3.1.1 One word**

##### **Descriptive**

The term ‘theatre’ may be understood by the relevant public beyond its traditional meaning, as a general reference to the experience of being the audience in a theatre, cinema or auditorium, and therefore as being connected with various types of visual and acoustic performances for entertainment purposes, whether in a cinema or public theatre or at home. The sign is therefore also descriptive for private installations, such as home cinema (§ 24-26), and has a clear link with the goods and services (§ 53).

[17/09/2019, T-399/18, Theatre, EU:T:2019:612, § 24-26, 53](#)

##### **Descriptive – Type and nature of the goods**

The applicant does not raise any argument such as to establish that the BoA erred in considering that the sign would be immediately understood by the relevant public as describing the type and nature of the goods concerned (*electric dental hygiene appliances* in Class 10), namely that they produce a flow of air (§ 31).

[16/12/2022, T-751/21, Airflow](#)

##### **Descriptive character – Material of the goods**

Given that the goods at issue are generally designed in materials other than bamboo, the relevant public would not immediately perceive that the goods are partly made from bamboo. Consequently, the material from which the goods in question are partly made does not constitute an easily recognisable characteristic of those goods as such. (§ 31).

[15/02/2023, T-82/22, Bambu, EU:T:2023:75](#)

### **Descriptive word marks (one word)**

30/01/2019, T-256/18, [SCHUTZ](#), EU:T:2019:38  
31/01/2019, T-97/18, [STREAMS](#), EU:T:2019:43  
29/01/2020, T-42/19, [CROSS](#), EU:T:2020:15  
02/12/2020, T-26/20, [Forex](#), EU:T:2020:583  
28/04/2021, T-872/16, [REPOWER](#), EU:T:2021:230  
21/04/2021, T-282/20, [Apo](#), EU:T:2021:212  
28/04/2021, T-348/20, [Gewürzsommelier](#), EU:T:2021:228  
16/06/2021, T-215/20, [HYAL](#), EU:T:2021:371  
14/07/2021, T-622/20, [Cachet](#), EU:T:2021:446  
15/12/2021, T-205/21, [Liftbot](#), EU:T:2021:953  
02/02/2022, T-116/21, [Wild](#), EU:T:2022:47  
[14/09/2022, T-706/21, Stahlwerkstatt, EU:T:2022:548](#)

#### **4.3.1.2 Several words or word elements**

##### **Descriptive – Neologism**

A trade mark consisting of a neologism composed of descriptive verbal elements in respect of the goods or services is not descriptive only if there is a perceptible difference between the neologism and the mere sum of its elements. Such a perceptible difference assumes an unusual nature of the combination of the descriptive elements (§ 21). Furthermore, the neologism itself must be qualified as descriptive (§ 31). Therefore, a sufficiently direct and specific link between the word sign and the products must be established (§ 33).

04/04/2019, T-373/18, [FLEXLOADER](#), EU:T:2019:219, § 21, 31, 33

##### **Descriptive – Neologism**

A trade mark consisting of a neologism or a word composed of elements, each of which is descriptive of characteristics of the goods or services, is itself descriptive of those characteristics, unless there is a perceptible difference between the neologism or the word and the mere sum of its parts (§ 18).

There is no perceptible difference between the meaning of the sign and that of the mere sum of its two components, 'micro' and 'garden'. Therefore the sign does not, in itself, constitute a neologism that is suggestive or allusive for the goods in question (§ 22-26).

23/05/2019, T-364/18, [MicroGarden](#), EU:T:2019:355, § 18, 22-26

##### **Descriptive – Word mark composed of two word elements**

The English-speaking public, including end consumers in the general public, will perceive the combination of the two nouns 'Lightyoga' as designating a yoga style featuring characteristics of light (§ 46-48, 51-52, 56). The fact that the term could also be understood as 'a light form of yoga' is irrelevant, as one descriptive meaning is sufficient (§ 54-55). The trade mark applied for directly describes the subject, function, use or intended purpose in relation to a wide variety of goods and services in Classes 9, 16, 25 and 41 (§ 59-72).

10/02/2021, T-153/20, [Lightyoga](#), EU:T:2021:70, § 46-48, 51-52, 54-55, 59-72

##### **Descriptive – Word mark composed of two word elements**

The German-speaking public, including end consumers in the general public, will perceive the combination of the two nouns 'Lichtyoga' as designating a yoga style featuring characteristics of

light (§ 46-48, 50-51, 54). The trade mark applied for directly describes the subject, function, use or intended purpose in relation to a wide variety of goods and services in Classes 9, 16 and 41 (§ 57-69).

10/02/2021, T-157/20, [Lichtyoga](#), EU:T:2021:71, § 46-48, 50-51, 54, 57-69

### **Descriptive – Word mark composed of two word elements**

Not only the individual words 'Glue' and 'Pro', but also their combination 'GluePro', are descriptive of all of the contested goods in Classes 1, 7 and 16 (§ 25, 26, 33, 36, 51). This assessment is not affected by the grammatically erroneous syntax of the mark (i.e. that it should have been structured inversely as 'pro glue' according to English linguistic rules) (§ 34-35).

19/05/2021, T-256/20, [Gluepro](#), EU:T:2021:279, § 25-26, 33, 36, 51, 34-35

### **Descriptive – Misspelled word mark – Descriptive character for software**

One of the definitions of the word 'explorer' given by the Oxford English Dictionary is 'a vessel, vehicle, etc., used for exploration, esp. underwater or (in later use) in space'. That definition is accompanied by examples, dating from 1830 to 1992, of the use of the word 'explorer' in ways that illustrate that definition, such as 'submarine explorer', 'lunar explorer' and 'robotic mobile explorer' (§ 20-21). The element 'xplorer' will be perceived as an alternative spelling of the noun 'explorer', derived from the verb 'to explore'. For that reason, it will be easily associated with notions like 'searching', 'examining', 'investigating' or 'inspecting'. This was not disputed in the case. The relevant public with a high level of attention will understand the mark applied for as meaning 'soil explorer' without making any particular mental effort. Therefore, the sign is descriptive in respect of *agricultural implements* and computer software for analysing plants in Classes 7 and 9 (§ 26-27, 34-38).

26/01/2022, T-300/21, [Soilxplorer](#), EU:T:2022:21, § 20-21, 26-27, 34-38

### **Descriptive – Misspelled word mark – Descriptive character for software**

One of the definitions of the word 'explorer' given by the Oxford English Dictionary is 'a vessel, vehicle, etc., used for exploration, esp. underwater or (in later use) in space'. That definition is accompanied by examples, dating from 1830 to 1992, of the use of the word 'explorer' in ways that illustrate that definition, such as 'submarine explorer', 'lunar explorer' and 'robotic mobile explorer' (§ 20-21). The element 'xplorer' will be perceived as an alternative spelling of the noun 'explorer', derived from the verb 'to explore'. For that reason, it will be easily associated with notions such as 'searching', 'examining', 'investigating' or 'inspecting'. This was not disputed in the case. The relevant public with a high level of attention will understand the mark applied for as meaning 'crop explorer' without making any particular mental effort. Therefore, the sign is descriptive in respect of *agricultural implements* and computer software for analysing plants in Classes 7 and 9 (§ 26-27, 34-38).

26/01/2022, T-301/21, [Cropxplorer](#), EU:T:2022:22, § 20-21, 26-27, 34-38

### **Descriptive – Word mark composed of two word elements**

The use of the short form 'max' for 'maximum' is very common in English (§ 21, 22). The term 'MAXFLOW' would be perceived by the relevant English-speaking public as referring to the maximum amount of flow. It is descriptive for the goods 'breast pumps and their accessories; breast pump diaphragms; breast pump valves; baby bottles; feeding bottles; bottle teats; bottle teats for medical purposes; apparatus, instruments and appliances for receiving food or medicine, in particular for premature babies, infants and children for medical purposes' in Class 10 (§ 39).

[08/06/2022, T-744/21, Maxflow, EU:T:2022:347](#)

#### **Descriptive – Word mark composed of two word elements**

The term 'ECO' refers to the word 'ecological'. This meaning is already confirmed by several judgments (§ 30). The term 'ECODOWN' will be perceived by the relevant English-speaking public as a combination of the terms 'ECO' and 'DOWN' and is descriptive for 'raw fibrous textile materials; stuffing material with the exception of feathers; wadding for padding and stuffing; horsehair; kapok' in Class 22 since it directly and immediately informs about their qualities (§ 38).

[15/06/2022, T-338/21, ECODOWN, EU:T:2022:360](#)

#### **Descriptive – Word mark composed of two word elements – Adjective and noun**

The contested sign is composed of two English words. The term 'guard' may be understood by the relevant public and the English-speaking professional public as referring to something that protects or the action to protect. Since the word 'rapid' is an adjective, it describes the noun 'guard'. As the two words are easily recognisable and as the expression complies with the grammatical rules of the English language, the expression 'rapidguard' does not create an expression sufficiently different from that produced by the mere juxtaposition of its components. It is irrelevant that 'rapidguard' does not appear in dictionaries. Therefore, this expression will be understood by the relevant public as indicating that the protection offered by the goods and services at issue (i.a. 'materials for construction; fall arresting equipment; building services' in Classes 6, 9, 19 and 37), will be offered quickly, in the sense that those goods will be installed quickly and that those services, which consist of, or are linked to, the installation of the goods at issue, will be provided quickly (§ 28, 34, 38-41).

[13/07/2022, T-573/21, Rapidguard, EU:T:2022:450](#)

#### **Descriptive – Overall perception of the sign – Use of a hyphen**

The mere addition of a hyphen between two words whose meaning is immediately understood by the relevant public does not alter the overall perception of the sign. The presence of the hyphen or the originality of the spelling used to represent the word 'vitamin' or of the abbreviations of the words 'vitamins' and 'minerals' cannot suffice to confer on the element concerned an entirely new meaning (§ 27).

[07/09/2022, T-9/22, Vita-min multiple sport, EU:T:2022:52](#)

#### **Descriptive – Word mark composed of two word elements – Well-known facts**

It is a well-known fact that the English word 'energy' is used in connection with beverages and foodstuffs to indicate that they provide the body with a particularly high level of energy (§ 46, 47). It is a well-known fact that one of the synonyms of the word 'cake' in English is the word 'bar' as evidenced, among others, by the Dictionary of Synonyms of the English Language Collins (§ 58). Also the word 'cake' refers to one of the essential characteristics of the goods concerned (§ 61). The word mark 'Energy cake' is nothing more than the mere sum of its parts. Even if the term in question is not listed in dictionaries, this circumstance is irrelevant for the examination of descriptiveness (§ 74).

[14/09/2022, T-686/21, Energy cake, EU:T:2022:545](#)

#### **Descriptive – Neologism**

The word marks 'HYPERLIGHTOPTICS' and 'HYPERLIGHTEYEWEAR' are not more than the combinations of meanings arising from their constituent elements, with the result that there is no perceptible difference between the alleged neologism or word and the mere sequence of its parts (§ 26). The absence of a hyphen or a space between the three words composing these marks does not constitute a creative aspect which can make them, taken as a whole, capable of distinguishing the goods of one undertaking from those of other undertakings (§ 27).

[22/11/2022, T-801/21, Hyperlighteyewear](#)

[22/11/2022, T-800/21, Hyperlightoptics](#)

### **Descriptive – Word mark composed of two word elements – Intended purpose of the goods**

There is a direct, immediate and objective link between the expression 'jet stream' which, taken as a whole, means 'jet, current, flow of water, air or gas which is very rapid and continuous' and the goods at issue ('water circulation apparatus for creating a counter-current in swimming pools' in Class 7), in that this expression gives direct and precise information about the functionality and purpose of those goods which are designed to generate a strong current of water in swimming pools. Therefore, that expression is descriptive according to Article 7(1)(c) EUTMR for the relevant English-speaking public in the EU (§ 25, 31, 40).

[23/11/2022, T-14/22, Jet stream, EU:T:2022:719](#)

### **Descriptive – Essential characteristic of the goods**

The sign 'GENERAL PIPE CLEANERS' has a sufficiently direct and specific relationship with the goods at issue in Class 7 (e.g. 'machines for cleaning drains and pressure washing') and Class 9 (e.g. 'video inspection system for use in pipe and conduits') to enable the relevant English-speaking public to immediately perceive a description of one of the essential characteristics of those goods, which are devices for cleaning drains, parts of those devices or goods whose primary purpose is to be used in that context (§ 40, 41, 43).

[23/11/2022, T-151/22, General pipe cleaners, EU:T:2022:721](#)

### **Not descriptive – Sum of two abbreviations – Impression sufficiently far removed from that produced by each component in isolation**

Although the terms 'deco' and 'tec', taken separately, are capable of being perceived as referring to the concepts of 'decoration' and 'technology', the sign 'decotec', taken as a whole, does not have any specific meaning and creates an impression which is sufficiently far removed from that produced by each of its two constituent abbreviations (§ 44-46).

[29/03/2023, T-308/22, Decotec, EU:T:2023:165](#)

### **Descriptive – Misspellings**

Under Article 7(1)(b) and (c) EUTMR, misspellings do not generally contribute to overcoming the ground for refusal resulting from a sign being understood as laudatory or descriptive. Moreover, if the misspelling is not perceived phonetically, it has no bearing on the meaning attributed to that mark by the relevant public (§ 26).

[23/08/2023, T-610/22, BoneKare](#)

See also, [23/08/2023, T-609/22, BoneKare, § 35](#)

### **Descriptive for part of the goods and services**

The combination of the German words 'Haus' and 'Grund' is directly understood by the German-speaking public as providing information that the goods and services in Classes 9, 36 and 42 relating to real estate are specifically intended for built and unbuilt real estate (§ 59-60).

[20/12/2023, T-779/22, Haus & Grund, EU:T:2023:854](#)

### **Descriptive**

The combination 'beautybio science' is understood by the English-speaking relevant public and in relation to beauty products or cosmetics as providing information on the fact that those goods are manufactured in a natural way, from natural materials, under conditions which respect nature and the environment, and that they are developed on the basis of scientific research (§ 46).

[07/02/2024, T-81/23, BEAUTYBIO SCIENCE \(fig.\), EU:T:2024:59](#)

### **Descriptive word marks (several word elements)**

17/01/2019, T-40/18, [SOLIDPOWER](#), EU:T:2019:18  
13/02/2019, T-278/18, [DENTALDISK](#), EU:T:2019:86  
06/02/2019, T-332/18, [MARRY ME](#), EU:T:2019:61  
12/03/2019, T-463/18, [SMARTSURFACE](#), EU:T:2019:152  
26/03/2019, T-787/17, [GlamHair](#), EU:T:2019:192  
04/04/2019, T-373/18, [FLEXLOADER](#), EU:T:2019:219  
11/04/2019, T-226/17, [Rustproof System ADAPTA](#), EU:T:2019:246  
08/05/2019, T-469/18, [HEATCOAT](#), EU:T:2019:302  
23/05/2019, T-364/18, [MicroGarden](#), EU:T:2019:355  
04/07/2019, T-662/18, [Twistpac](#), EU:T:2019:483  
07/06/2019, T-719/18, [TELEMARKFEST](#), EU:T:2019:401  
12/06/2019, T-291/18, [Compliant Constructs](#), EU:T:2019:407  
13/06/2019, T-652/18, [oral Dialysis](#), EU:T:2019:412  
26/06/2019, T-117/18 to T-121/18, [200 PANORAMICZNYCH](#), EU:T:2019:447  
17/09/2019, T-634/18, [revolutionary air pulse technology](#), EU:T:2019:611  
20/09/2019, T-458/18, [real nature](#), EU:T:2019:634  
19/12/2019, T-175/19, [eVoter](#), EU:T:2019:874  
11/02/2020, T-487/18, [VirusProtect](#), EU:T:2020:44  
02/04/2020, T-307/19, [Innerbarend](#), EU:T:2020:144  
11/06/2020, T-553/19, [PERFECT BAR](#), EU:T:2020:268  
09/09/2020, T-626/19, [Loch- und Rissfüller](#), EU:T:2020:399  
02/09/2020, T-801/19, [PedalBox ±](#), EU:T:2020:383  
18/12/2020, T-289/20, [Facegym](#), EU:T:2020:646  
09/12/2020, T-858/19, [easycosmetic](#), EU:T:2020:598  
26/02/2021, T-809/19, [EL CLASICO](#), EU:T:2021:100  
10/02/2021, T-98/20, [Medical beauty research](#), EU:T:2021:69  
07/07/2021, T-386/20, [Intelligence, accelerated](#), EU:T:2021:422  
14/07/2021, T-562/20, [Everlasting Comfort](#), EU:T:2021:464  
02/06/2021, T-183/20, [Teslaplatte](#), EU:T:2021:314  
15/09/2021, T-702/20, [Made of wood](#), EU:T:2021:589  
20/10/2021, T-617/20, [Standardkessel](#), EU:T:2021:708  
26/01/2022, T-233/21, [Clustermedizin](#), EU:T:2022:27  
[08/06/2022, T-433/21, Enforcement trailer, EU:T:2022:344](#)  
[31/03/2023, T-482/22, Mate mate](#)  
[31/03/2023, T-472/22, Near-to-Prime](#)  
[06/12/2023, T-85/23, cyberscan, EU:T:2023:784](#)

### 4.3.1.3 Geographical names

#### **Descriptive**

The sign is descriptive for goods and services in Classes 16, 34, 36, 39, 41 and 44, such as photographs; tobacco; financial, monetary and real estate services; travel organisation services; education and training; and beauty treatments. The relevant public consists of the Spanish-speaking general public and professionals with a level of attention varying from average to high. It perceives the sign as designating the geographical origin of the goods and services or indicating the place where those services are provided. The slight stylisation of the word 'Andorra' is insignificant and does not make it possible to offset its descriptive character (§ 25-27, 35, 55).

23/02/2022, T-806/19, [Andorra \(fig.\)](#), EU:T:2022:87, § 25-27, 35, 55

#### **Descriptive**

Even if the city of Amsterdam might also be associated with its quality of life and environment and its cultural influence, the relevant highly attentive consumer of aphrodisiac or euphoric stimulant products (poppers) knows and associates the city of Amsterdam with an environment of festivity and pleasure and also knows that it is an environment conducive to the use of those goods at hand. It is reasonable to consider that, the relevant public believes – or could believe in the future – that those goods originate in Amsterdam (§ 49-50).

06/04/2022, T-680/21, [Amsterdam poppers](#), EU:T:2022:216, § 49-50

#### **Assessment of descriptiveness – Sign including geographical name – Evidential value of excerpts or screenshots of websites**

The use of a term in website excerpts cannot be sufficient to prove the frequency of its use, including its use in professional circles. Screenshots of websites that do not give any indication of the user community of that website are not sufficient to prove the awareness of the name in question both among the general public and among a professional audience throughout Germany (§ 68, 69).

23/11/2022, T-701/21, [Cassellapark](#), EU:T:2022:724

#### **Assessment of descriptiveness – Sign including geographical name – Non-negligible part of the relevant public**

The applicant has not succeeded in proving that the relevant public in Frankfurt am Main constitutes a non-negligible part of the relevant public in Germany. Even if the applicant claims that the metropolitan region of Frankfurt am Main has almost six million inhabitants, it has failed to prove that, measured against the number of inhabitants in Germany, the public to which the trade mark applied for is familiar ultimately constitutes a non-negligible part of the relevant public. According to the case-law, a sign is caught by the prohibition laid down in Article 7(1)(c) EUTMR only if the ground for refusal in question is present in relation to a non-negligible part of the relevant public (§ 70, 71).

23/11/2022, T-701/21, [Cassellapark](#), EU:T:2022:724

#### **Not descriptive – Assessment of descriptiveness – Sign including geographical name**

The mere fact that the relevant services may be provided at a certain location is not sufficient to assume that that name of that location is descriptive of the geographical origin of these services. In assessing the descriptive character of signs which may serve, in trade, to designate the place of supply of the categories of services in respect of which registration of an EU trade mark is

sought, it is necessary to consider whether they are currently associated by the relevant public with the category of services in question or whether, in the view of that public, it is reasonable to expect that they may be perceived by that public as designating the geographical origin of that type of services. In making that assessment, particular consideration should be given to the relevant public's degree of familiarity with the geographical name in question, the characteristics of the place and the type of goods or services which it designates (§ 88). Considering all the circumstances, it cannot be considered that the term 'Cassellapark' is associated by the relevant public with the services covered by the contested mark, nor is it reasonable to expect that it may in future identify the geographical origin of those services (§ 89).

[23/11/2022, T-701/21, Cassellapark, EU:T:2022:724](#)

### **Descriptive – Geographical origin**

The mark is descriptive for services related to the planning or implementation of a local project (Classes 35, 36, 37, 42 and 45). The relevant public would understand it as designating the geographical origin of the services at issue, namely the port of Cologne Deutz (§ 36).

[17/05/2023, T-657/22, DEUTZER HAFEN KÖLN, EU:T:2023:255](#)

[17/05/2023, T-656/22, DEUTZER HAFEN, EU:T:2023:254](#)

### **Descriptive – Geographical origin**

The Amazon region constitutes a well-defined geographical area, despite the fact that it extends over several countries (§ 37). The term 'amazonian' may describe not only the geographical origin of the goods at issue (*gin*) but also their quality considering that is capable of conveying a positive image of the botanicals used to produce or flavour gin, which could potentially originate from the Amazon region (§ 40).

Although the description of the goods covered by an EUTM used for marketing purposes is not capable of rendering a mark descriptive, it may contribute to its descriptiveness. It is contradictory to present the goods at issue to consumers as being manufactured with botanicals from the Amazon region, or even as being distilled in that region, and to submit simultaneously that 'AMAZONIAN GIN COMPANY' is not descriptive of the geographical origin of those goods (§ 41).

[21/02/2024, T-756/22, AMAZONIAN GIN COMPANY, EU:T:2024:101](#)

### **Not descriptive – Geographical name not known to a non-negligible part of the public – Burden of proof in invalidity proceedings**

Since the validity of the registered EUTM is presumed, it is for the applicant for a declaration of invalidity to present the specific elements that are intended to call into question the validity of the trade mark. The invalidity applicant has not shown that a non-negligible part of the entire relevant public was aware of the city of Compton at the time the contested mark was applied for (§ 30, 72).

[28/02/2024, T-746/22, COMPTON, EU:T:2024:134](#)

[28/02/2024, T-747/22, Compton \(fig.\), EU:T:2024:135](#)

#### **4.3.1.4 Numbers**

##### **Descriptive – Number 4 understood as 'for'**

The number 4, if associated with an English word, will itself generally be read in English and understood as referring to the English preposition 'for' (§ 31). The sign 'Cash4Life' is understood

as meaning 'cash for life', which is translated as 'cash for all of your life' or 'cash for the rest of your life' (§ 32).

[21/12/2022, T-554/21, Cash4life, EU:T:2022:841](#)

#### 4.3.1.5 Abbreviations

##### **Descriptive**

The term 'bio' has acquired a broad meaning in everyday language. It refers to the ideas of respecting the environment, using natural materials or being manufactured in an ecological way (§ 20-23).

[12/12/2019, T-255/19, BIOTON, EU:T:2019:853, § 20-23](#)

##### **Descriptive – Specialised public – Understanding of chemical element's abbreviation**

The specialized part of the relevant public, comprised of professionals trading lithium, which has a basic understanding of English technical vocabulary, will understand the abbreviation 'Li' as designating the chemical element lithium (§ 29). A sign already falls under the prohibition of Article 7(1)(b) or (c) EUTMR if there is a ground for refusal in relation to part of the relevant public (§ 31). Since the applicant does not dispute the descriptiveness of the element 'SAFE' of the mark applied for, the BoA rightly concluded that that mark is descriptive in its entirety for 'batteries' (Class 9) and 'containers for storing of batteries' (Classes 6 and 20) (§ 42, 43).

[14/09/2022, T-795/21, Li-SAFE, EU:T:2022:550](#)

##### **Descriptive – Intrinsic, inherent and objective characteristics of the goods**

The letter 'v' combined with the number 10 could immediately be perceived, without further thought, by the relevant public as a reference to one of the intrinsic, inherent and objective characteristics of *smart phones* in Class 9, namely a tenth version, which is likely to incorporate new updates or new functionality as compared with the earlier versions (§ 44).

[15/02/2023, T-741/21, V10, EU:T:2023:78](#)

##### **Descriptive – Acronym of a descriptive expression**

A group of letters that is not in itself descriptive, but which may be perceived by the relevant public as an acronym or abbreviation of the terms making up a descriptive main expression, although non-descriptive when taken in isolation, is likely to be descriptive as a result of its combination with the main expression (§ 39).

Case-law neither establishes nor recognises specific rules on the formation of acronyms or abbreviations, but confines itself to noting certain customary practices in this area (§ 34). In the absence of clear rules applicable to the creation of abbreviations or acronyms, certain terms are not necessarily abbreviated in a single format (§ 36). The fact that other acronyms or abbreviations are also conceivable, or even better known, for the descriptive expression, or for some of its component parts, is not decisive. It is sufficient that the group of letters in question can constitute, in at least one of its potential meanings, an acronym or abbreviation of the descriptive expression and, as such, designate a characteristic of the services concerned (§ 38).

[31/01/2024, T-188/23, IU International University of Applied Sciences, EU:T:2024:46](#)

##### **Descriptive word marks (Abbreviations)**

11/04/2019, T-225/17, [BIO Proof ADAPTA](#), EU:T:2019:247  
12/12/2019, T-255/19, [BIOTON](#), EU:T:2019:853  
12/03/2019, T-220/16, [PRO PLAYER](#), EU:T:2019:159  
09/09/2020, T-625/19, [SOS Innenfarbe](#), EU:T:2020:398

#### 4.3.1.6 Names of products

##### **EU word mark PLOMBIR – Descriptive character – Relevant public – Level of command of the non-EU languages**

The GC did not distort the evidence or fail to reason its assessment of the relevant public and the descriptiveness of the term ‘PLOMBIR’ for ice cream (as the transliteration into Latin characters of the word ‘Пломбир’, meaning ‘ice cream’ in Russian). The relevant public was the Russian-speaking public, which included that part of the general public within the EU that understood or spoke Russian in Germany and the Baltic States. Whether or not Russian was understood in Germany, or whether the GC had committed an error in finding that Russian was understood in Germany, was irrelevant, as the judgment would still stand on the basis of the well-known fact established by the GC that Russian was understood in the Baltic States (§ 41-43). Although the GC had not stated whether the level of command of Russian in the Baltic States was that of a native speaker, it had adequately reasoned that it had been proven that ‘Plombir’ was used in everyday Russian (§ 68-74).

18/06/2020, C-142/19 P, [PLOMBIR](#), EU:C:2020:487, § 41-43, 68-74

##### **Generic – Descriptive – Type of the goods – Relevant factors for the assessment**

The factors for assessing the generic character of a mark are also relevant for assessing its descriptiveness (§ 50). The fact that a significant quantity of cheese is produced in Germany and is marketed in that Member State by a number of economic operators under the name Emmentaler (§ 45-48) is a relevant indication that that name has become generic (§ 49), a valid indication that the relevant public perceives that term as designating a characteristic of those goods and, therefore, as being descriptive (§ 50-51). The question of whether this market practice is compatible with international agreements is irrelevant, since the perception of the relevant public is formed, inter alia, by its exposure to that sign as placed on the market (§ 52, 53, 59,75). This finding is, in the present case, also confirmed by dictionary evidence (§ 31-35), national food regulations (§ 57-58), the absence of protection as a geographical indication in an international agreement concluded by the EU (§ 64-65) and the EU’s position in the negotiations which led to that agreement (§ 67-69), as well as previous factual findings in case-law as to the legality of production and marketing of Emmentaler cheese under that denomination in the EU (§ 78-80).

[24/05/2023, T-2/21, Emmentaler, EU:T:2023:278](#)

#### 4.3.2 Figurative marks

##### **Descriptive – Combination of verbal and figurative elements**

A trade mark whose word element is descriptive is overall descriptive insofar as its graphic elements do not divert the relevant public’s attention from the descriptive message conveyed by the word component. In the present case the stylisation of the word elements — i.e. the typeface used, the difference in the font size of the elements and the use of the colours green and brown — is relatively banal, with the result that it is not capable of diverting consumers’ attention away from the descriptive elements of the trade mark applied for (§ 41, 42).

The figurative elements represented above the letters ‘i’ and ‘o’, which may be associated with leaves by the relevant public, and the use of the colour green, which are frequently used to

indicate the biological or ecological origin of the goods and services, are even capable of strengthening the descriptive character of the word element 'Biomarkt' (§ 44).



[13/07/2022, T-641/21, BioMarkt \(fig.\), EU:T:2022:446](#)

### **Not descriptive – Figurative trade mark consisting of word combination and simple geometric shape**

The word combination 'airframe' does not exist in English to describe the goods or services in question such as blowing machines, recording apparatus, various types of screens in Classes 7, 9, goods made of rubber or plastic, including pipes, hoses, frames to be filled with air in Class 17, transportable buildings, structural frameworks for buildings, screen frames in Class 19, advertising, telecommunication services, services concerning leasing of projectors in Classes 35, 38, 41 (§ 31-33).

The evidence submitted by the applicant lacks any indication that the term 'airframe' refers to the concept of a frame filled with air or an inflatable frame or other terms in which could be used to describe the contested goods and services (§ 34). Although for certain goods the term 'air' in English may be equated with the term 'inflatable' because they are usually filled with air, such as air mattress this does not apply to the goods and services in question, in relation to which it has not been established that the relevant public would immediately associate the term 'airframe' with an inflatable or air-filled frame or rack (§ 36).

The figurative element represents a simple geometric shape. It is not excluded that certain consumers may perceive it *i.a.* as a cinema screen as the applicant claims. However, the applicant has not provided any evidence in support of that perception. Since the word combination 'airframe' does not evoke the idea of a cinema screen, such an interpretation is even less plausible. Therefore, the figurative element does not transmit any clear concept (§ 39).

When confronted with the contested trade mark, the relevant public will not recognise immediately and without further reflection its descriptive meaning in relation to the goods and services concerned (§ 40).



[05/10/2022, T-539/21, airframe \(fig.\), EU:T:2022:597](#)

### **Descriptive – Combination of descriptive verbal elements and banal figurative elements**

The figurative elements at issue are perceived as enhancing, and not diminishing, the meaning 'gaming tournaments or competitions' of the sign applied for. Given the banal character and the sobriety of the graphical elements used, it must be held that those elements cannot divert the attention of the relevant public from the descriptive message conveyed by the word element 'game tournaments' (§ 50). Therefore, the figurative elements cannot diminish the descriptive character of the sign GAME TOURNAMENTS in relation to the goods and services at issue, for the purposes of Article 7(1)(c) EUTMR (§ 51).



[26/10/2022, T-776/21, GAME TOURNAMENTS \(fig.\), EU:T:2022:673](#)

### **Descriptive – Place of provision of a service or of use of a product**

The BoA was right to hold that the meaning of the mark applied for, namely 'city bath', related to the place or location where the goods or services in question could be used or provided. The consumer could perceive as descriptive any indication that a service is provided in a particular

place or location or that the goods are suitable for that purpose, provided that those characteristics are relevant to the goods or services concerned (§ 37).



[09/11/2022, T-13/22, POLIS LOUTRON \(fig.\), EU:T:2022:688](#)

### Assessment of descriptive character

For the assessment of the descriptive character of a figurative sign, the decisive factor is whether, from the point of view of the relevant public, the figurative elements alter the meaning of the mark applied for in relation to the goods concerned. If the verbal element of a mark is descriptive, the mark as a whole is descriptive, provided that the figurative elements of the mark do not enable the relevant public to be distracted from the descriptive message conveyed by the verbal element (§ 31).

CHRØME

[14/06/2023, T-446/22, CHRØME \(fig.\), EU:T:2023:329](#)

### Descriptive – Material of the goods

The word ‘chrome’ is not understood as a mere indication of the colour of the goods at issue, but as an indication of the nature of the materials of which, or with which, those goods are wholly or partly composed or coated for the purposes of corrosion resistance, stability or decoration (§ 48).

[14/06/2023, T-446/22, CHRØME \(fig.\), EU:T:2023:329](#)

### Descriptive of part of the goods and services

The relationship between the number ‘365’ and the days in the year is a well-known fact, generally known by the public concerned (§ 34). Moreover, the colours will only be perceived by the relevant public as being aesthetic elements (§ 47). The mark applied for would be perceived by the relevant public as conveying the idea that the goods and services enabled, or related to, betting every day of the year (§ 62). Therefore, it will be immediately, and without further thought perceived as designating the goods and services in Classes 9, 28, 36, 38 and 41, and there is a sufficiently direct and specific relationship between betting every day, the meaning of the sign bet365, and the service of ‘sponsorship search’ covered by Class 35 (§ 63-64). However, the contested sign is descriptive only of the goods and services for which gambling and betting constitute an intrinsic characteristic inherent to their nature (§ 70).



[06/12/2023, T-764/22, Bet365 \(fig.\), EU:T:2023:783](#)

### Descriptive figurative marks



[06/02/2019, T-333/18, marry me \(fig.\), EU:T:2019:60](#)



[31/01/2019, T-427/18, SATISFYERMEN \(fig.\), EU:T:2019:41](#)



[11/04/2019, T-223/17, ADAPTA POWDER COATINGS \(fig.\), EU:T:2019:245](#)



[11/04/2019, T-224/17, Bio proof ADAPTA \(fig.\), EU:T:2019:242](#)

LIEB  
LINGS  
WEIN

08/05/2019, T-55/18, [LIEBLINGSWEIN \(fig.\)](#), EU:T:2019:311  
07/05/2019, T-423/18, [vita](#), EU:T:2019:291

WEIN FÜR  
PROFIS

08/05/2019, T-56/18, [WEIN FÜR PROFIS \(fig.\)](#), EU:T:2019:312

WEIN FÜR  
PROFIS

08/05/2019, T-57/18, [WEIN FÜR PROFIS \(fig.\)](#), EU:T:2019:313

EXECUTIVE SELLING 09/09/2019, T-689/18, [EXECUTIVE SELLING \(fig.\)](#), EU:T:2019:564

LEGAL CAREERS

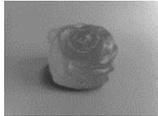
03/10/2019, T-686/18, [LEGAL CAREERS \(fig.\)](#), EU:T:2019:722

Alpensaline

19/12/2019, T-69/19, [Bad Reichenhaller Alpsaline \(fig.\)](#), EU:T:2019:895

ring

19/12/2019, T-270/19, [ring \(fig.\)](#), EU:T:2019:871



12/12/2019, T-747/18, [SHAPE OF A FLOWER \(3D\)](#), EU:T:2019:849

PROFI CARE

13/05/2020, T-5/19, [PROFI CARE \(fig.\)](#), EU:T:2020:191

PERFECT BAR

11/06/2020, T-563/19, [PERFECT BAR \(fig.\)](#), EU:T:2020:271, § 18

Credit24

25/06/2020, T-651/19, [Credit24 \(fig.\)](#), EU:T:2020:288

LOTTO  
24

15/10/2020, T-38/20, [LOTTO24 \(fig.\)](#), EU:T:2020:496

BBQ  
BARBECUE SEASON

23/09/2020, T-522/19, [BBQ BARBECUE SEASON \(fig.\)](#), EU:T:2020:443

FAKE  
DUCK

15/10/2020, T-607/19, [FAKE DUCK \(fig.\)](#), EU:T:2020:491

ultrasun

20/10/2020, T-805/19, [ultrasun \(fig.\)](#), EU:T:2020:507

smart:)things

15/10/2020, T-48/19, [smart:\)things \(fig.\)](#), EU:T:2020:483

Home Connect

02/12/2020, T-152/20, [Home Connect \(fig.\)](#), EU:T:2020:584

Heartfulness

03/03/2021, T-48/20, [Heartfulness \(fig.\)](#), EU:T:2021:112

EGGY  
FOOD

27/01/2021, T-287/20, [EGGY FOOD \(fig.\)](#), EU:T:2021:46

imot .bg

16/06/2021, T-487/20, [imot.bg \(fig.\)](#), EU:T:2021:366

NASHE  
MAKEDONSKO  
PILSNER  
BEER  
MACEDONIAN  
PREMIUM  
BEER

09/07/2021, T-357/20, [NASHE MAKEDONSKO PILSNER BEER MACEDONIAN PREMIUM BEER \(fig.\)](#), EU:T:2021:467



14/07/2021, T-527/20, [CUCINA \(fig.\)](#), EU:T:2021:433



02/03/2022, T-669/20, [PLUSCARD \(fig.\)](#), EU:T:2022:106, § 59, 62



22/06/2022, T-602/21, [good calories \(fig.\)](#), EU:T:2022:382



28/09/2022, T-58/22, [FRESH \(fig.\)](#), EU:T:2022:595

### 4.3.3 Complex marks – figurative threshold

#### Descriptive – Descriptive verbal elements – Reinforcing figurative element

The verbal element ‘TurboPerformance’ will be perceived as ‘performance aided by a turbo engine’ and is therefore descriptive for *vehicle electronic goods* and *vehicle maintenance services; vehicle ‘tuning’* (§ 58). This is reinforced by the mark’s inclusion of a figurative element depicting a speedometer with a needle pointing towards the right (§ 62).



TurboPerformance 11/07/2019, T-349/18, [TurboPerformance](#), EU:T:2019:495, § 62

#### Descriptive – Descriptive verbal elements – Various ‘usual or decorative’ figurative elements

The relevant public is perfectly capable of understanding the word ‘basmati’ as referring to a specific variety of popular long-grain rice used in savoury dishes (§ 52). ‘Basmati’ and ‘rice’ are directly descriptive of the nature of the goods designated by the mark, which are, or contain, rice (§ 53). The word ‘sir’ does not confer any notable degree of distinctive character on the mark at issue, either in isolation or considered in the overall impression created by that mark (§ 67). The combination of the word and figurative elements of the mark does not preclude the finding that the mark is perceived immediately and without further thought as being not only non-distinctive, but also descriptive of the goods in question (§ 61). The alleged ‘complexity’ of the mark is the result of various ‘usual or decorative’ elements that were wrongly found to confer the required degree of distinctive character on the mark (§ 63).



05/11/2019, T-361/18, [SIR BASMATI RICE \(fig.\)](#), EU:T:2019:777, § 52-53, 67, 61, 63

#### Descriptive – Descriptive verbal elements – Non-distinctive figurative elements

The graphic element of the contested mark is neither unusual nor special and does not possess any features that would allow the contested mark to be remembered (§ 45). Overall, the graphic elements of the contested mark do not alter the purely descriptive message of the word elements (§ 46). Therefore, the contested mark is descriptive as a whole (§ 47).



07/07/2021, T-464/20, [YOUR DAILY PROTEIN \(fig.\)](#), EU:T:2021:421, § 45-47

### **Descriptive – Figurative element consisting of a not-corresponding shape of a map**

The presence of the shape of a map that is not of the United States does not change the meaning of the descriptive message of the remaining elements of the sign and, notably, does not prevent the relevant public from perceiving the verbal element as referring to foodstuffs from the sea in the United States (§ 19-22, 32).



17/10/2019, T-10/19, [UNITED STATES SEAFOODS \(fig.\)](#), EU:T:2019:751, § 19-22, 32

### **Descriptive – Misspelled word element**

The verbal element 'pantys' does not differ from everyday language in such a way that the relevant public would regard it as more than a mere misspelling of the English word 'panties' (§ 27). The sign is descriptive for all sanitary products, especially for women (§ 21).

**pantys**

13/05/2020, T-532/19, [Pantys \(fig.\)](#), EU:T:2020:193, § 21, 27

### **Descriptive – Descriptive verbal element – Basic geometric figurative element**

The black circular frame of an initial letter corresponds to a basic geometric shape that is common in advertising, so this frame will be perceived only as a purely decorative element (§ 29). For the purposes of assessing the descriptive character of the sign at issue, the decisive factor is whether, from the point of view of the relevant public, the figurative elements alter the meaning of the mark applied for in relation to the goods concerned. Where the word element of a mark is descriptive, the mark as a whole is descriptive, provided that its graphic elements do not enable the relevant public to be diverted from the descriptive message conveyed by the word element (§ 27).

**essence** [07/12/2022, T-738/21, essence \(fig.\)](#), EU:T:2022:779

### **Assessment of descriptiveness – Figurative elements of decorative nature – Descriptive verbal element**

The basic square background, banal stylisation of the letters and basic colours used, taken together or individually, do not divert the attention of the relevant public from the clear descriptive message conveyed by the word element (§ 51, 52).

[22/03/2023, T-650/21, casa \(fig.\)](#), EU:T:2023:155

### **Descriptive – Customary font**

A graphic style or font cannot be regarded as a distinctive figurative element if it is customary in the eyes of the relevant public or if the figurative element merely serves to highlight the information conveyed by the verbal elements (§ 60).



[06/09/2023, T-786/21, TEAM BUSINESS IT DATEN - PROZESSE - SYSTEME \(fig.\)](#), EU:T:2023:507

### **Descriptive – Decorative figurative element**

The figurative elements have a background function, highlighting the word element and accentuating the descriptive message of the term 'safeguard' for goods in Class 3 (allergen-free, antiviral and antibacterial products). They are decorative in nature and are not likely to convey an immediate and lasting impression on the relevant public (§ 60).



[20/09/2023, T-210/22, Safeguard \(fig.\), EU:T:2023:574](#)

#### **Descriptive – Figurative element reinforcing descriptive verbal element**

A graphic style, even if it has a certain particularity, can only be considered distinctive if it makes an immediate and lasting impression on the relevant public. This is not the case if it remains largely common in the eyes of the relevant public, or if the figurative element only has the function of highlighting the information conveyed by the verbal elements (§ 38). A figurative element does not prevent the sign from being considered descriptive where that element repeats, without any noticeable originality, one of the forms used for marketing the goods at issue and, consequently, only reinforces the descriptive character of the verbal element (§ 40-41).



[11/10/2023, T-87/23, THE GOOD GUMS \(fig.\), EU:T:2023:617](#)

## **4.4 DIRECT AND SPECIFIC LINK WITH THE GOODS/ SERVICES AT ISSUE**

#### **Descriptive – Actual or potential characteristic of the goods**

The fact that a sign describes a characteristic which does not, at the current stage of the technology, exist does not preclude it being perceived as descriptive by the relevant public. It is sufficient, to justify refusal of the mark applied for, that, in the perception of the relevant public, it is able to be used for the purposes of designating an actual or potential characteristic of the goods, even if that characteristic does not yet pertain at the current stage of technology (§ 24).

The word mark 'oral Dialysis' is descriptive for goods such as oral preparations for dialysis since the consumer perceives it as an indication of a medicine taken orally for dialysis. The fact that, from a scientific perspective, oral dialysis does not exist and the word sign has no concrete meaning when considered technically, has no influence on the descriptive character (§ 20, 24, 27).

[13/06/2019, T-652/18, oral Dialysis, EU:T:2019:412, § 20, 24, 27](#)

#### **Descriptive – Descriptiveness in relation to a general category of goods or services**

The relevant public (English-speaking, specialist public of orthopaedic surgeons) will immediately perceive the words 'Compliant Constructs', in relation to surgical implants or orthopaedic articles, as descriptive for those goods, especially those that consist of an elastic or flexible material (§ 41-46).

The finding of the descriptive character of a mark applies not only to the goods for which it is directly descriptive but also, in the absence of a suitable restriction of the trade mark by the applicant, to the general category of goods to which they belong (§ 50). Therefore, the descriptive character is not only applicable to *surgical instruments and apparatus*, but also to *surgical, medical, dental and veterinary apparatus and instruments* (§ 52).

[12/06/2019, T-291/18, Compliant Constructs, EU:T:2019:407, § 41-46, 50, 52](#)

### **Descriptive character – Non-descriptive sub-category within a broad descriptive category of goods**

The goods applied for in Class 7 comprise broad categories of goods, for which the contested mark was found to be descriptive. Even though the mark may not be descriptive for certain sub-categories falling under those broad categories of goods, it must nevertheless be refused for the entire broad descriptive categories applied for (§ 39).

17/03/2021, T-226/20, [MobileHeat](#), EU:T:2021:148, § 39

### **Descriptive – Descriptiveness in relation to only some of the goods or services within the category**

The fact that a sign is descriptive in relation to only some of the goods or services within a category does not preclude that sign being refused registration if the application is not confined to the goods for which the sign is not descriptive. Otherwise, if the sign were to be registered, there would be nothing to preclude the applicant from also using it for the goods covered by the registration for which it is descriptive (§ 32).

The sign is descriptive for all the goods applied for (i.e. *clothing, footwear and headgear* in Class 25), which, in the absence of any specific limitation, include *goods relating to sport* (§ 32-33, 35).

12/03/2019, T-220/16, [PRO PLAYER](#), EU:T:2019:159, § 32-33, 35

### **Descriptive – Descriptiveness in relation to only some of the goods or services**

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

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

For these services, the sign even has a certain originality, since they have no direct and specific link with nature, and the sign could be perceived as surprising, unexpected and therefore memorable. The sign is therefore not only not descriptive but also not devoid of distinctive character (§ 52).

20/09/2019, T-458/18, [real nature](#), EU:T:2019:634, § 25-27, 30-31, 52

### **Descriptive character – Sufficient direct and concrete link with the goods**

One of the possible meanings of the term ‘cachet’ in French or English is ‘tablet’ (§ 20, 21). The term ‘cachet’, when meaning ‘tablet’, signifies one of the usual pharmaceutical forms of medicinal products. It is therefore descriptive for goods generally available in tablet form (§ 25). However, regarding *sanitary preparations for medical purposes*, although these may be available in the form of ‘water-soluble tablets’, the relevant public will not perceive a direct link with the term ‘cachet’ in respect of these goods, since it perceives the term ‘cachet’ as referring to a tablet or medicinal capsule which is swallowed and not to a pastille or disinfection tablet which must be dissolved in water for purification purposes (§ 28, 40).

14/07/2021, T-622/20, [Cachet](#), EU:T:2021:446, § 28, 40

### **Lack of establishment of a direct and specific link between the sign and the goods**

The BoA did not rule on whether the word sign Hell (an adjective meaning ‘clear’ in German) in the absence of the German word ‘Röstung’ (a noun meaning ‘roasting’) is perceived by the German-speaking public without further reflection as referring to a characteristic of the goods, namely coffee preparations. The clear roasting is not established as a well-known fact for the relevant public (§ 39, 44-45). Therefore, the transition made by the BoA from the adjective ‘clear’ to ‘clear roasting’ does not establish a sufficiently direct and specific link between the sign and the goods to fall under the prohibition in Article 7(1)(c) EUTMR (§ 49-50).

21/04/2021, T-323/20, [Hell](#), EU:T:2021:205, 39, 44-45, 49-50

### **Not descriptive – Absence of ‘intrinsic’ characteristic that is ‘inherent to the nature’ of the goods**

Within the meaning of Article 7(1)(c) CTMR [now Article 7(1)(c) EUTMR], a characteristic must be ‘objective’ and ‘inherent to the nature of the good or service and ‘intrinsic and permanent’ with regard to that good or service. In Swedish, the word ‘vita’ as the plural form of ‘vit’ means ‘white’. The colour white does not constitute an ‘intrinsic’ characteristic that is ‘inherent to the nature’ of the goods, but, rather, is a purely random and incidental aspect which only some of the goods may have and which does not have any direct and immediate link with their nature (§ 44-48).

07/05/2019, T-423/18, [vita](#), EU:T:2019:291, § 44-48

### **Not descriptive – Absence of ‘intrinsic’ characteristic that is ‘inherent to the nature’ of the goods**

The elegant and discreet character of the colour off-white and the improved visual impression that that colour produces in relation to certain goods (such as protective helmets), do not make it possible to establish that it constitutes a characteristic which is ‘objective’ and ‘inherent to the nature of the goods in question’. These considerations, when referring to the aesthetic value and contribution of that colour, involve an element of subjective assessment, likely to vary greatly according to the individual preferences of each consumer and, therefore, cannot be used to determine how a sign may be perceived by the public as a whole (13/12/2018, T-98/18, MULTIFIT, EU:T:2018:936, § 31) (§ 44).



25/06/2020, T-133/19, [OFF-WHITE \(fig.\)](#), EU:T:2020:293, § 44

### **Descriptive – ‘Characteristic’ under Article 7(1)(c) EUTMR – No absence of ‘Intrinsic’ characteristic that is ‘inherent to the nature’ of the goods**

The English-speaking general public of the EU will perceive the element ‘arch’ as relating to the ‘raised part of the foot formed by a curved section of bones’. In the context of footwear, the relevant public will associate the word with the human foot (§ 39). It will understand the element ‘fit’ as a verb meaning ‘to be the right shape and size for somebody/something’ (§ 40).

The combination of the words ‘arch’ and ‘fit’ will be understood as an indication that the footwear designated by the mark is designed specifically to fit the arch of the user’s foot (§ 41). Not only are the terms ‘arch’ and ‘fit’ capable, in themselves, of communicating a descriptive message relating to footwear, but so is their combined use. Taken as a whole, the grammatical structure of the expression ‘arch fit’ is not so unusual that it modifies the message communicated by each of the elements by themselves in the context of footwear (§ 44).

The link is sufficiently direct and specific for the relevant public to immediately perceive the mark, without any particular mental effort, as describing one of the characteristics of footwear (§ 45). The applicant’s argument alleging inconsistency between the case-law in Cases T-423/18

(07/05/2019, T-423/18, *vita*, EU:T:2019:291) and T-133/19 (25/06/2020, T-133/19, OFF-WHITE (fig.), EU:T:2020:293) and the BoA's conclusion that there is a direct link between the mark applied for and the goods it covers is rejected as unfounded. Unlike a colour, which is a random and incidental aspect not only as regards the goods in question in Cases T-423/18 and T-133/19 but also as regards footwear, the fact that a shoe must fit the arch of a foot is one of the characteristics of those goods. It is an objective characteristic, since it is usual and expected and inherent to the nature of footwear (§ 19, 61).

21/12/2021, T-598/20, [Arch fit](#), EU:T:2021:922, § 19, 40, 44, 61

#### **Not descriptive – Descriptive character of vague terms**

The connection between the term 'team' and the services in question (i.e. insurance services) is too vague and indeterminate to give the term a descriptive character with regard to those services. While the teamwork suggested may benefit potential customers, this does not expressly apply to insurance services. The fact that a company advertises that the services are provided as a team is too vague and indeterminate to render that sign descriptive of the services in question (§ 84).

01/12/2021, T-359/20, [Team Beverage](#), EU:T:2021:841, § 84

#### **Not descriptive – Subjective feeling – Lack of an objective characteristic inherent in the nature of the goods**

A characteristic within the meaning of Article 7(1)(c) EUTMR, even if it is irrelevant whether that characteristic is essential or ancillary in economic terms, must nevertheless be objective and inherent in the nature of the goods or services or an intrinsic and enduring feature of those goods or services (§ 63). The feeling of being 'unstoppable' is, by its very nature, subjective. It cannot therefore be an objective characteristic inherent in the nature of the energy drinks and nutritional supplements covered by the contested mark (§ 64). The contested mark does not have a sufficiently direct and specific relationship with the goods in question to enable the relevant public to perceive, immediately and without further reflection, a description of the intended purpose or of any other characteristic of those goods (§ 65).

06/10/2021, T-3/21, [Unstoppable](#), EU:T:2021:659, § 63-65

#### **Not descriptive – Lawful currency exchange services**

The sign 'CINKCIARZ', consisting of a term that originally, under the Polish People's Republic, designated persons who were engaged in the illegal trade of foreign exchange, is not perceived as descriptive by the relevant public for lawful currency exchange services. The relevant public is aware of the fact that the services cannot contain illegal foreign exchange activities. Therefore, from the point of view of the relevant public, the term designating such activities as illegal cannot serve in normal usage to designate lawful currency exchange services (§ 52-53).

19/12/2019, T-501/18, [Cinkciarz](#), EU:T:2019:879, § 52-53

#### **No sufficiently direct and specific link between the contested mark and the goods concerned**

The contested mark does not convey a clear message and at best contains a general and suggestive reference to the world of construction activities. Therefore, there is no sufficiently direct and specific link between the contested mark and the goods concerned. Consequently, the relevant public will not immediately perceive, without further thought, a description of the goods concerned (§ 55).

**Descriptive – Descriptiveness in relation to only some of the goods or services within the category – Software and computer services**

The term ‘analytics’ refers to software intended, in particular, for ‘the collection and analysis of data or statistics, typically for financial or commercial purposes’. Since that software may also be intended for analysing the beverage market, the relevant public will immediately perceive the sign ‘Beverage Analytics’ as referring to the analysis of the beverage market (§ 47).

Registration of a sign may be refused even if it is descriptive for only some of the goods or services within a category listed as such in the application for registration. This is because if a sign at issue was registered as an EU trade mark for that category, there would be nothing to prevent its proprietor from using it also for the goods or services for which it is descriptive (§ 48). Where registration of a sign as an EU trade mark is sought indiscriminately for the category of services for which it is descriptive, it is irrelevant whether it is descriptive for the other sectors of the market in which those services might be supplied (§ 51).

‘Beverage analytics’ is descriptive among others for ‘computer software’ in Class 9 and ‘design and development of computer hardware’ in Class 42 (§ 50, 59).

23/03/2022, T-113/21, [Beverage analytics](#), EU:T:2022:152, § 47-48, 50, 51, 59

**Descriptive – Purpose of the goods**

The term ‘Stahlwerk’ is a word commonly used in the German language, meaning a plant which produces steel, but also, in a broader sense, a plant in which steel is processed. All the contested goods in Classes 7, 8, 9 and 12, including hammers, drilling machines, electric sharpeners human-powered trolleys and carts, non-medical respiratory mask filters, can be used in a steel plant in the production or processing of steel. Thus, ‘Stahlwerk’ clearly designates a purpose of those goods, and the said goods have a clear connection with the meaning of the mark applied for. The term ‘Stahlwerk’ therefore does not only designate a steel plant, but also the goods which can be used there for the production or processing of steel (§ 24-28).

[14/09/2022, T-705/21, Stahlwerk, EU:T:2022:546](#)

**Descriptive – ‘Characteristic’ under Article 7(1)(c) EUTMR – Colour of a product – Beverages – Sufficient direct and concrete link with the goods**

It cannot be ruled out a priori that the colour of a product may be one of the characteristics referred to in Article 7(1)(c) EUTMR (§ 43). The assessment of whether the colour of a product is a characteristic of that product will depend on the circumstances of the case, namely the colour described by the sign at issue, the nature of the goods at issue, and the specific manner in which reference is made to the colour in question (§ 44).

It is common knowledge that in the beverages sector the goods may be designated by terms referring to a colour. The colour concerned, which is very dark or black, is not particularly original in the beverages sector because there are many examples of beverages which have that characteristic (§ 45, 46). The colour designated by the word element ‘black’ will be understood as information regarding the chocolate content, as an indication of the colour of the coffee and of the lack of any additional substance in that coffee, as a type of tea (black tea) or even as an indication of the very dark colour of the alcoholic beverages – in particular because of the presence of coffee or chocolate in those beverages or because they are prepared using foodstuffs. Thus, the term ‘black’ refers to a characteristic which is objective and inherent to the nature of the goods at issue and intrinsic and permanent with regard to those goods. Lastly, the manner in which reference is

made to the colour 'black', namely in combination with another descriptive adjective, makes it more likely that the relevant public will perceive that element as a descriptive indication of the colour of the relevant goods (§ 47, 48).

[14/09/2022, T-498/21, Black Irish, EU:T:2022:543](#)

### **Descriptive – Name of a colour – Intrinsic characteristic inherent to the nature of the goods concerned – Use of the expression 'including' in the list of goods**

Colour is not an irrelevant or arbitrary factor in the field of cosmetics and, more specifically, nail care. The word 'lilac' will be immediately recognised by the English-speaking part of the relevant public as the name of the colour. It is thus reasonable to assume that that part of the relevant public will perceive it as a description of a characteristic which is intrinsic and inherent to the nature of the goods (§ 48). The finding of the descriptive character of a mark applies not only to goods for which it is directly descriptive, but also to the more general category to which those goods belong in the absence of a suitable restriction by the trade mark applicant, in particular in the context of an enumeration in the relevant class of a number of exemplary goods introduced by the expression 'in particular' or 'including' (§ 50-52).

[30/11/2022, T-780/21, LiLAC \(fig.\), EU:T:2022:732](#)

### **Descriptive – Sufficiently direct and concrete link with the services**

There is a clear link between winning money for life and *advertising* (Classes 35), *entertainment* (Class 41) and *IT services* (Class 42), where those services are provided in the context of gambling or games of chance and lotteries, with the result that the word element 'Cash4Life' is descriptive of those services (§ 40). The fact that no indication as to the nature or frequency of the winnings can be inferred from the contested mark is irrelevant (§ 41).

[21/12/2022, T-554/21, Cash4life, EU:T:2022:841](#)

### **Assessment of descriptiveness – Sign protected as a GI – Obligation to assess the link between sign and the goods**

The mere fact that a sign is protected as geographical indication according to national law and international agreements does not of its own and automatically imply a descriptive link between the sign and the designated goods (§ 44, 51). By omitting to examine the link between the geographical name Devin constituting the contested mark and part of the contested goods covered by that mark, namely those other than 'mineral water complying with the specifications of [the PGI]', the BoA infringed Article 7(1)(c) CTMR (§ 53).

[14/12/2022, T-526/20, DEVIN, EU:T:2022:816](#)

### **Not descriptive – Absence of objective, inherent, intrinsic and permanent characteristic of the goods**

The word 'casa', which refers to the house, does not constitute a description of the intended purpose of goods such as the different packing materials, office requisites or painting articles in Class 16. The reasoning of the BoA, according to which typewriters are collector goods or even decorative goods nowadays, is particularly illustrative of the fact that the word house does not describe a characteristic that is objective and inherent to the nature of those goods and intrinsic and permanent with regard to those goods (§ 65)

[22/03/2023, T-650/21, casa \(fig.\), EU:T:2023:155](#)

## 5 ARTICLES 7(1)(d), 59(1)(a) EUTMR – CUSTOMARY SIGNS OR INDICATIONS

### Invalidity proceedings – Article 7(1)(d) EUTMR – No signs which have become customary – Relevant territory – Non-EU evidence – Nature of use

The invalidity applicant did not establish, according to Article 59(1)(a) EUTMR, that the contested mark had become customary in the current language or in the bona fide and established practices of the trade to designate the goods, such as *harness leather leads, footwear clothing and headgear, sporting articles* in Classes 18, 25 and 28 and that, therefore, at the time of the application for registration, it fell foul of the ground for refusal laid down in Article 7(1)(d) EUTMR (§ 28, 30-32, 38-39, 43, 48, 50, 52).

Such demonstration cannot be limited to isolated cases or sporadic examples (16/03/2006, T-322/03, *Weisse Seiten*, EU:T:2006:87) but must establish, in particular, the existence of 'established' practices of trade known by a significant part of the relevant public in a substantial part of the territory of the EU (11/06/2020, C-115/19 P, *CCB (fig.) / CB (fig.) et al*, EU:C:2020:469, § 57) (§ 50).

Documents originating from outside the EU can be taken into account only if they are capable of proving circumstances having a bearing on the perception of the sign by the relevant public of the EU (05/10/2004, C-192/03 P, *BSS*, EU:C:2004:587, § 42) (§ 34-35).

The fact that an undertaking uses the term 'k9' in its company name does not mean either that that undertaking uses the term 'k9' as a generic and usual term to designate the goods and services which it provides, or a fortiori that that term has become customary in the bona fide and established practices of the trade to designate the goods and services (23/10/2008, T-133/06, *Past Perfect*, EU:T:2008:459, § 55) (§ 38-39).

17/03/2021, T-878/19, [K-9](#), EU:T:2021:146, § 28, 30-32, 38-39, 43, 48, 50, 52

## 6 ARTICLE 7(3) EUTMR – ACQUIRED DISTINCTIVENESS THROUGH USE

### 6.1 THE POINT IN TIME FOR WHICH ACQUIRED DISTINCTIVENESS HAS TO BE ESTABLISHED

[No key points available yet.]

### 6.2 CONSUMERS

#### Awareness of luxury brands

Awareness by the relevant public of a luxury brand is not necessarily proportionate to the volume of sales of goods bearing that mark. Even consumers in the general public who are unable to purchase luxury branded goods are often exposed to them and are familiar with them. The fact that a trade mark is among the best-known luxury brands may therefore, in principle, be relevant for the purposes of assessing the general public's perception of that mark (§ 47, 60, 126).



[19/10/2022, T-275/21, DEVICE OF A CHEQUERBOARD PATTERN \(fig.\)](#)

## 6.3 GOODS AND SERVICES

[No key points available yet.]

## 6.4 TERRITORIAL ASPECTS

### **Distinctive character acquired through use – Territorial aspects – Assessment**

The distinctive character acquired by the use of a trade mark must be demonstrated in the part of the European Union where it was devoid of such character (§ 51). It is also apparent from case-law that the acquisition of distinctive character through the use of a mark requires that at least a significant proportion of the relevant public identify the goods or services concerned as originating from a particular undertaking because of the mark, and therefore distinguishes those goods or services from those of other undertakings (§ 52).

As the mark applied for was devoid of distinctive character for the English-speaking public of the European Union, including Member States where English is an official language, namely Ireland, Malta and the United Kingdom, distinctiveness acquired through use needed to be proved, in particular for this public (§ 54-55). The evidence provided mostly targeted Greece and, marginally, other Member States where English is understood (Cyprus, the Netherlands, Sweden) for a period of less than three years (§ 58-62). Therefore, there is not sufficient proof of distinctiveness acquired through use (§ 66).

14/05/2019, T-465/18, [EUROLAMP pioneers in new technology](#), EU:T:2019:327, § 52, 58-62, 66

### **Distinctive character acquired through use – Territorial aspects – Assessment**

In the case of a mark that does not have inherent distinctive character throughout the European Union, the distinctive character acquired through the use of that mark must be shown throughout that territory, and not only in a substantial part or the majority of it. Consequently, although such proof may be produced globally for all the Member States concerned, or separately for different Member States or groups of Member States, it is not, however, sufficient that the party with the burden of providing such evidence merely produces evidence of such acquisition that does not cover part of the European Union, even a part consisting of only one Member State (25/07/2018, C-84/17 P, C-85/17 P and C-95/17 P, *SHAPE OF A 4-FINGER CHOCOLATE BAR (3D)*, EU:C:2018:596, § 87) (§ 75).

In this case, an extrapolation of the global data concerning the EU market could not be made with regard to Cyprus and Slovenia, since the applicant had not previously demonstrated use of the challenged mark on their territory (§ 76).

28/06/2019, T-340/18, [SHAPE OF A FLYING V GUITAR \(3D\)](#), EU:T:2019:455, § 75-76

### **Distinctive character acquired through use – Territorial aspects – Assessment**

Evidence of distinctive character acquired through use may relate globally to all the Member States or to a group of Member States. Certain evidence may therefore be relevant as regards a number of Member States or even the entire European Union. No provision of the EUTM Regulation requires that the acquisition of distinctive character through use be established by separate evidence in each individual Member State and it would be unreasonable to require proof of such acquisition for each Member State separately (25/07/2018, C-84/17 P, C-85/17 P & C-95/17 P, *Shape of a 4-Finger Chocolate Bar (3D)*, EU:C:2018:596, § 79-80, 87) (§ 82-83).

Nowadays, the fact that there are no physical shops in a Member State does not necessarily prevent the relevant public of that Member State from becoming familiar with and recognising the mark as originating from its proprietor by seeing it on websites, social media, in electronic catalogues and brochures, through online advertising by globally or locally known celebrities or influencers, or in shops in the most central and popular tourist areas of major cities and airports (§ 88).

10/06/2020, T-105/19, [DEVICE OF A CHEQUERBOARD PATTERN \(fig.\)](#), EU:T:2020:258, § 82-83, 88

### **Distinctive character acquired through use – Territorial aspects – Assessment**

Although the proprietor submitted extensive evidence of use, only the market surveys concerning five Member States are actually relevant to some extent for establishing that the mark has acquired distinctive character through use (§ 117, 151, 152). The proprietor did not demonstrate that the markets of the remaining 23 Member States are comparable to the domestic markets of the 5 Member States where the surveys were carried out. The results of the surveys cannot, consequently, be extrapolated to all the Member States (§ 156-157).

19/06/2019, T-307/17, [DEVICE OF THREE PARALLEL STRIPES \(fig.\)](#), EU:T:2019:427, § 117, 151-152, 156-157

### **Absolute grounds – Article 7(1)(b) and (c) EUTMR – Article 7(3) EUTMR – Identification of the territory in which the mark is inherently non-distinctive or descriptive**

In order to refuse registration of a sign as provided for in Article 7(1)(b) and (c) EUTMR, it is not necessary to identify all of the relevant territory in which the grounds for refusal took effect, since it is sufficient to observe that those grounds exist in only part of the European Union (§ 27).

The examination of Article 7(3) EUTMR requires the identification of the part of the European Union in which the sign was, *ab initio*, devoid of distinctive character. Therefore, it requires the identification of the whole of the relevant territory in which one of the absolute grounds for refusal laid down in Article 7(1)(b) and (c) EUTMR took effect (§ 31).

09/03/2022, T-204/21, [Rugged](#), EU:T:2022:116, § 27, 31

### **No distinctive character acquired through use – Figurative mark representing a pattern – Territorial aspects – Assessment**

It is possible that for certain goods or services, the economic operators group several Member States together in the same distribution network and treated those Member States, especially for marketing strategy purposes, as if they were one and the same national market. In such circumstances, the evidence for the use of a sign within such a cross-border market is likely to be relevant for all Member States concerned. The same is true when, due to a geographic, cultural or linguistic proximity between two Member States, the relevant public of the first has a sufficient knowledge of the products and services that are present on the national market of the second (§ 27).

For example, advertising campaigns may target several Member States or be broadcast simultaneously in the media zone of those Member States (§ 65). However, the mere possibility that the relevant public in the Member States concerned may have been exposed to those advertising campaigns or exposed to the magazines published elsewhere, for example during travel to Member States where they had been distributed, cannot suffice to demonstrate the relevance of that evidence for assessing the relevant public's perception in the Member States concerned (§ 70).

[19/10/2022, T-275/21, DEVICE OF A CHEQUERBOARD PATTERN \(fig.\)](#)

### **No distinctive character acquired through use – Colour mark – Territorial aspects – Assessment**

Albeit, due to the unitary character of the EU trade mark, in order to be allowed to proceed to registration, a sign must have original or acquired distinctive character throughout the EU, it may not be demanded that proof of distinctive character acquired through use of a trade mark shall be provided in respect of each individual Member State. Such evidence can be produced altogether for all Member States concerned or separately for different Member States or groups of Member States (§ 81, 82).

In the event that the evidence submitted does not cover a part of the EU, even irrelevant or consisting only of a single Member State, it cannot be concluded that the mark has acquired distinctive character through use throughout the EU (§ 82).



[26/10/2022, T-621/21, BLAU, EU:T:2022:676](#)

### **No distinctive character acquired through use – Territorial aspects – Assessment**

Because the EUTM applicant did not provide evidence or arguments in relation to twenty of the Member States in which the contested sign lacks distinctive character or provide convincing reasoning which would allow for extrapolation of the evidence submitted to the facts present in those twenty Member States, it is not proven that the sign has acquired distinctiveness through use (§ 84, 99).

[25/01/2023, T-320/22, V8 \(fig.\), EU:T:2023:21](#)

### **No distinctive character acquired through use – Territorial aspects – Assessment of linguistic proximity**

Even if the Spanish, Portuguese and Italian languages may be regarded as being close, they do not belong to the same language area. Similarly, it cannot be argued that there is a geographic proximity between Spain and Portugal, on the one hand, and Italy, on the other (§ 111). It has not been demonstrated that, due to a geographic, cultural or linguistic proximity between Italy, on the one hand, and Portugal or Spain, on the other, the Italian public has a sufficient knowledge of the goods and services that are present on the Spanish or Portuguese market (§ 112).

The mere fact that similar evidence in the form of brochures and lists of shops was submitted in respect of the three countries was clearly insufficient for extrapolation purposes (§ 115).

[22/03/2023, T-650/21, casa \(fig.\), EU:T:2023:155](#)

### **Distinctive character acquired through use – Territorial aspects – Means of evidence**

In the case of a trade mark that does not have inherent distinctive character throughout the EU, the distinctive character acquired through use of that trade mark must be demonstrated throughout that territory, and not only in a substantial part or the majority of that territory. This proof may be adduced globally for all the Member States concerned or separately for different Member States or groups of Member States, but there is no requirement that the same types of evidence be adduced for each Member State. The absence of surveys for some of the Member States does not rule out the possibility of proving acquired distinctive character through use, which may be demonstrated by other evidence (§ 88, 115).

[29/11/2023, T-19/22, Scooter \(3D\), EU:T:2023:763](#)

## **Distinctive character acquired through use – Territorial aspects – Requirements for extrapolation – Portugal and Greece; direct evidence on file insufficient / requirements for extrapolation not met**

It is possible that evidence of acquired distinctive character through use by a particular sign is relevant with regard to several Member States. However, extrapolation must be reasoned. In the present case, the contested decision does not contain sufficient considerations explaining how the findings of the national courts are relevant for the other Member States (§ 111). The Belgium Court decision acknowledging the acquired distinctive character of two colour marks, one from Benelux and the other from the EU, was not necessarily referring to the contested EUTM when it made that finding. Nor does it state what the territorial scope of its conclusion is. Therefore, it cannot be held that those findings apply to the entire territory of the EU (§ 112).

The evidence relating to Greece and Portugal is not direct evidence of the acquisition of distinctive character through use and, assessed as a whole, it is not capable of demonstrating that the public targeted by the goods at issue perceives the mark at issue as an indication of the commercial origin in those territories (§ 134). Although proof of acquired distinctive character may be adduced globally, it is not sufficient that the EUTM proprietor produces evidence of such acquisition that does not cover part of the EU, even if that part consists of a single Member State (§ 139-140).

 [06/03/2024, T-652/22, ORANGE, EU:T:2024:152](#)

## **6.5 EVIDENCE**

### **6.5.1 Means of evidence**

#### **Probative value of the evidence – Declarations made by professionals**

The Office is under no obligation to explain to the EUTM proprietor what type of evidence it needs to submit in order to show that the mark has distinctive character acquired through use (§ 142-143). The declarations made by professionals are indirect evidence and do not reflect on the perception of the general public (§ 148-149). Declarations featuring largely general assertions and lacking reference to supporting figures or to the perception of the mark by the average consumer in various markets in the EU lack sufficient credibility to identify the sole covered by the mark as an indication of origin (§ 154). Pursuant to Article 52(2) CTMR [now Article 59(1)(a) EUTMR], it is up to the EUTM proprietor to submit appropriate and sufficient evidence to demonstrate acquired distinctive character (§ 157)

*29/03/2019, T-611/17, [REPRESENTATION D'UNE SEMELLE DE CHAUSSURE \(3D\)](#), EU:T:2019:210, § 142-143, 148-149, 154, 157*

#### **Secondary evidence – Sales figures**

Sales figures are not sufficient to show distinctiveness acquired by use if they are not accompanied by information relating to the market share that they represent in respect of both the global market for the goods and services in question and the global amount of advertising costs in that market in the relevant territory (§ 118).

*11/04/2019, T-223/17, [ADAPTA POWDER COATINGS \(fig.\)](#), EU:T:2019:245, § 118*

#### **Secondary evidence – Sales figures**

The acquisition of distinctive character through use of a mark requires that at least a significant proportion of the relevant section of the public identify products or services as originating from a particular undertaking because of the mark. Sales figures only constitute secondary evidence

which may support, if necessary, direct evidence of distinctive character acquired through use, such as declarations from professional associations or market studies. The sales figures in themselves do not show that the public targeted by the goods concerned perceives the trade mark as an indication of their commercial origin (§ 74-82).

26/06/2019, T-117/18 to T-121/18, [200 PANORAMICZNYCH](#), EU:T:2019:447, § 74-82

### **Secondary evidence – Advertising materials**

Advertising materials can be regarded only as secondary evidence which may support direct evidence of distinctive character acquired through use. However, advertising material, as such, does not demonstrate that the public targeted by the goods or services perceives the sign as an indication of commercial origin (§ 36).

24/09/2019, T-404/18, [PDF Expert](#), EU:T:2019:666, § 36

### **Evidence – Market share held by the mark**

There is no requirement that the evidence submitted to prove distinctiveness acquired through use must relate directly to the market share held by the mark or the proportion of the relevant section of the public that identifies the goods or services as originating from a particular undertaking. It is sufficient for that evidence to enable conclusions to be drawn regarding that market share or proportion of the public (§ 62-65).

14/05/2019, T-12/18, [Triumph / TRIUMPH](#), EU:T:2019:328, § 62-65

### **Evidence – Use of a verbal element in combination with the icon of an app**

The use of the verbal element 'pdf expert' in combination with the icon of the app, that was not a registered trade mark, as a figurative element, is not sufficient to establish that the verbal element 'pdf expert' has acquired distinctiveness through use (§ 27). The icon is predominant and most often used completely separately from the verbal element 'pdf expert'. Therefore, it does not confer distinctiveness on that element in itself, but rather, given its descriptive nature, renders it explanatory of the icon (§ 28).

Statistics on internet searches for the keyword 'pdf expert' could be capable of demonstrating that a mark has acquired distinctive character through use. However, that possibility is only accepted in special circumstances, such as where the majority of the marks in the sector are inherently descriptive or clients were generally regular customers, permitting the inference that clients used the mark to identify the applicant's goods or services, as opposed to goods or services offered by its competitors (14/12/2017, T-304/16, BET365, EU:T:2017:912) (§ 37).

24/09/2019, T-404/18, [PDF Expert](#), EU:T:2019:666, § 27, 28, 37

### **Evidence – Use of verbal element in combination with the icon of an app**

The evidence submitted to prove the acquired distinctiveness of the sign, showing the verbal elements 'Scanner' and 'pro' sometimes combined with the icon depicted in the app store, is not sufficient. This is because the icon is predominant and most often used completely separately from the verbal element 'scanner pro'. Therefore, it does not confer distinctiveness on that element in itself, but rather, given its descriptive nature, renders it explanatory of the icon (§ 43-45).

24/09/2019, T-492/18, [Scanner Pro](#), EU:T:2019:667, § 43-45

### **Evidence – Colour marks – Colour per se**

The surveys to demonstrate that a sign consisting of a colour per se had acquired distinctive character through use must provide information that makes it possible to assess how representative the sample chosen was. Small samples (100-200 people) are not reliable. In addition, the colour samples should include the Pantone code used. The interviewees should be asked to choose from several images or even shades which one could spontaneously be associated with a particular undertaking (§ 101-102). Sales figures and advertising material may support surveys but, as such, they do not demonstrate that the public targeted by the goods perceives the mark as an indication of commercial origin (§ 107).



09/09/2020, T-187/19, [Colour Purple -2587C \(col\)](#), EU:T:2020:405, § 107

### **Evidence – Burden of proof – Certificates from the UK IP Office referring to the earlier UK marks as having acquired distinctive character through use**

Enhanced distinctiveness as a result of extensive use or reputation cannot be presumed and must therefore be demonstrated by the party seeking to rely on it. In that regard, the mere fact that the certificates from the UK IP Office refer to the earlier UK marks as having acquired distinctive character as a result of use does not suffice to demonstrate that the distinctiveness of the earlier word marks has been enhanced as a result of extensive use or reputation (§ 74).

28/05/2020, T-506/19, [Uma workspace / WORKSPACE \(fig.\) et al.](#), EU:T:2020:220, § 74

### **Internet evidence in assessing distinctive character acquired through use**

With the growing importance of the internet in the course of trade, the relevant public's perception may, nowadays, be largely influenced by the presence and promotion of a brand in the virtual realm. Such evidence, for example the internet pages on which a mark concerned is displayed, promoted or marketed, may thus be likely to play an increasingly important role in assessing distinctive character acquired through use of a trade mark. However, in order to be relevant for that purpose, that type of evidence must demonstrate that it targets or is consulted by a significant part of the relevant public in the Member States in which the mark is, *ab initio*, devoid of inherent distinctiveness (§ 80). To that end, account should be taken, in particular, of the top-level domains of the websites in question, their language and their content (§ 81), traffic analysis reports (§ 82).

The mere fact that a website on which the mark at issue was promoted is accessible in certain Member States is not sufficient to demonstrate that a significant part of the relevant public in those Member States has been exposed to that mark (§ 84).

[19/10/2022, T-275/21, DEVICE OF A CHEQUERBOARD PATTERN \(fig.\)](#)

### **Market shares as evidence in assessing distinctive character acquired through use**

Market shares merely constitute secondary evidence which may reinforce direct evidence such as, in the present case, the market surveys. However, the surveys cannot be used to infer the existence of distinctive character acquired through use in those Member States where the market shares are very low (§ 95).



[26/10/2022, T-621/21, BLAU, EU:T:2022:676](#)

### **Evidence – Non-representative market surveys**

Where a survey does not relate to the perception of the specific relevant public in question, it cannot be used to prove acquired distinctiveness through use (§ 65-69).

[25/01/2023, T-320/22, V8 \(fig.\), EU:T:2023:21](#)

### **Evidence in assessing distinctive character acquired through use – Promotional brochures – Invoices – List of shops – Evidence relating to the applicant’s established position on the market**

Evidence consisting of promotional brochures, information on the shops in the company’s retail chain, various invoices showing sales and evidence relating to the applicant’s established position on the market might be sufficient to demonstrate genuine use of a mark, such evidence, however, is not sufficient, in itself, to demonstrate the acquisition of distinctive character through use. That evidence does not contain any indication that the relevant public would perceive the contested mark as indicative of the commercial origin of the goods and services at issue (§ 95-96).

[22/03/2023, T-650/21, casa \(fig.\), EU:T:2023:155](#)

### **Distinctive character acquired through use – Burden of proof**

It is not for the invalidity applicant to prove the absence of distinctive character acquired through use, but it is for the proprietor of the contested EUTM to adduce appropriate and sufficient evidence to show that it has acquired distinctive character (§ 70).

[29/11/2023, T-19/22, Scooter \(3D\), EU:T:2023:763](#)

### **Distinctive character acquired through use – Necessity to submit direct evidence – Distinction between direct and secondary evidence**

Certain elements of evidence are considered to be of greater probative value than others. Sales figures and advertising material can be regarded only as secondary evidence, which may support, where relevant, direct evidence of distinctive character acquired through use, such as surveys or market studies as well as statements from professional bodies or statements from the specialised public. Proof of distinctive character acquired through use cannot be furnished by the mere production of sales volumes and advertising material. Direct evidence is necessary in order to demonstrate that a mark has acquired distinctive character through use (§ 100-102).

The statements from the *Comité interprofessionnel du vin de Champagne* (CIVC), indicating that the EUTM proprietor was the only producer of Champagne wines to use the shade of orange in question, are merely potentially supporting evidence (§ 107). The statements coming from the EUTM proprietor’s employees cannot be regarded as credible direct evidence (§ 108).

Decisions of national courts acknowledging the perception of the contested EUTM by the consumers may be regarded as direct evidence (§ 109). Although it cannot be ruled out that press articles or other publications may be regarded as direct evidence, that evidence must nevertheless actually contain indications that the mark in question has become such that it can identify the goods concerned as originating from a particular undertaking on the territory concerned (§ 136). The newspaper extracts submitted do not relate to the perception of the mark at issue by the public of those countries. Promotional magazines cannot be regarded as objective evidence since they originate from the EUTM proprietor (§ 138).



[06/03/2024, T-652/22, ORANGE, EU:T:2024:152](#)

## **6.5.2 Use as a trade mark**

### **Use in forms which differ from the form by insignificant variations – Reversed colour scheme**

The concept of use of a trade mark, within the meaning of Article 7(3) CTMR [now Article 7(3) EUTMR] and Article 52(2) CTMR [now Article 59(2) EUTMR], must be interpreted as referring not only to use of the mark in the form in which it was submitted for registration but also to the use of the trade mark in forms which differ from that form solely by insignificant variations and that are able to be regarded as broadly equivalent to that form (§ 62).

The act of reversing the colour scheme, even if a sharp contrast between the three stripes and the background is preserved, is a significant variation compared to the registered form of the mark (§ 77).

Numerous pieces of evidence were correctly dismissed on the grounds of showing forms of use not broadly equivalent to the registered form (sloping lines, reversed colour scheme) (§ 78, 97, 103).



19/06/2019, T-307/17, [DEVICE OF THREE PARALLEL STRIPES \(fig.\)](#), EU:T:2019:427, § 62, 77, 78, 97, 103

### **Use in combination with another registered trade mark**

A three-dimensional mark can acquire distinctive character through use, even if it is used in conjunction with a word mark or a figurative mark, provided the mark embodies the shape of the product or its packaging and that they systematically bear the word mark under which they are marketed (§ 129).

The acquisition of the distinctive character of a mark could result from its use in combination with another registered trade mark, provided that the public concerned continue to perceive the products as coming from a specified undertaking (§ 130).

The proprietor of a registered trade mark may, for the purpose of establishing the particular distinctive character and reputation of that trade mark, avail itself of evidence of its use in combination with another registered and reputed mark, provided that the public concerned continue to perceive the products as coming from the same undertaking (§ 131).

28/02/2019, T-459/18, [PEPERO original \(fig.\) / REPRÉSENTATION D'UN BATÔNNET \(fig.\)](#), EU:T:2019:119, § 129-131

### **Use of a three-dimensional mark in combination with another trade mark**

A three-dimensional mark may acquire distinctive character through use, even if it is used in conjunction with a word mark or a figurative mark. Evidence of use of a three-dimensional mark in conjunction with another registered and well-known mark may serve to establish its distinctive character and its reputation, provided that the relevant public continue to perceive the goods as originating from the same undertaking (§ 80-82). The fact that the three-dimensional representation of the shape of the biscuit, protected by the earlier trade mark, has been used together with the word mark OREO, and that the biscuit is known to be an 'Oreo', does not permit the conclusion that the reputation is based solely on the word mark OREO and not on the earlier mark itself (§ 94).

28/05/2020, T-677/18, [GULLÓN TWINS COOKIE SANDWICH \(fig.\) / OREO \(fig.\) et al.](#), EU:T:2020:229, § 80-82, 94

### **Use in combination with other marks with distinctive character – Use in a directly descriptive manner – No distinctiveness acquired by use**

The acquisition of distinctive character may result both from the use as part of a registered trade mark of an element of the mark, and from the use of another mark in combination with a registered trade mark. In both cases, it is sufficient that, as a result of this use, the interested parties actually perceive the product or service, designated by the only mark whose registration is requested, as coming from a specific company (17/07/2008, C-488/06 P, Aire limpio, EU:C:2008:420, § 49; 07/07/2005, C-353/03, Have a break, EU:C:2005:432, § 30) (§ 94).

The relevant consumers will not perceive the product designated by the sign applied for to come from a particular undertaking where the sign is either used in a directly descriptive manner of the type of product, or is always accompanied, in the evidence produced, by other marks of the applicant that themselves have distinctive character (28/01/2009, T-174/07, TDI, EU:T:2009:21, § 78; 13/09/2012, T-72/11, Espetec, EU:T:2012:424, § 57 and 78) (§ 98).

26/02/2021, T-809/19, [EL CLASICO](#), EU:T:2021:100, § 94, 98

### **Distinctive character acquired through the use of an individual mark following collective use**

The fact that the use of the terms 'crédit mutuel' is regulated or reserved to a single economic actor is irrelevant to assess its inherent descriptive character since it does not affect the perception of the relevant public. However, it may be a relevant element when assessing the distinctive character acquired through use (§ 63, 102-105).

Terms designating a regulated activity can acquire distinctive character through use under Article 7(3) EUTMR (§ 104).

To establish if an individual mark has acquired distinctive character through use following collective use, it must be determined if consumers perceive that the goods and services originate from a single undertaking under whose control they are manufactured or provided and who is liable for the quality of the goods and services (§ 143).

24/09/2019, T-13/18, [Crédit Mutuel](#), EU:T:2019:673, § 63, 102-105, 104, 143

### **No distinctiveness acquired through use – Use of a word mark with graphical elements – Use in combination with other marks with distinctive character**

The evidence submitted presenting, on the one hand, the sign applied for in a specific graphic form and, on the other hand, a sign which includes the word element 'olimp' and a graphic element representing three hexagons, shows that the expression 'vita-min multiple sport' corresponding to the sign applied for constitutes a description of the product, while the commercial origin is indicated by the term 'olimp'. Other evidence shows the sign applied for used as a name for a product, describing its ingredients and purpose, and the sign 'OLIMP' used as a trade mark. Thus, the evidence submitted does not show that the word mark applied for has acquired distinctive character through use (§ 49).

[07/09/2022, T-9/22, Vita-min multiple sport, EU:T:2022:52](#)

### **No distinctive character acquired through use – Colour mark – Evidence – Assessment**

Irrespective of whether the use concerns a sign as part of a registered trade mark or in combination therewith, the essential condition is that, as a result of that use, the sign in respect of which registration as a trade mark is sought is capable, in the minds of the relevant public, of identifying the goods to which it relates as originating from a particular undertaking (§ 100).

When the evidence shows goods for which the trade mark is applied for in the colour of that mark but in connection with another sign systematically affixed to those goods, the evidence does not demonstrate use of the colour mark applied for as such. The applicant must prove that the trade

mark applied for alone, and not any other trade mark that may exist, indicates the origin of the goods as coming from a particular undertaking. (§ 101).

[26/10/2022, T-621/21, BLAU, EU:T:2022:676](#)

## 7 ARTICLES 7(1)(e), 59(1)(a) EUTMR – SHAPE

### 7.1 SHAPE OR OTHER CHARACTERISTICS RESULTING FROM THE NATURE OF THE GOODS

#### Article 7(1)(e)(i) to (iii) – Application *ratione temporis*

Article 7(1)(e) CTMR [now Article 7(1)(e) EUTMR], *after* amendment, cannot be applied retroactively to trade marks registered before 23 March 2016 (§ 33).

14/03/2019, C-21/18; [Textilis](#), EU:C:2019:199, 33

08/05/2019, T-324/18, [BOTTIGLIA DORATA \(3D\)](#), EU:T:2019:297, § 16-18

#### Article 7(1)(e)(i) to (iii) – Shape commonly used by most of the producers – Concept of ‘shape’ – Colours

The fact that a shape is commonly used by most of the producers of a certain type of goods does not imply that this shape results from the nature of the product, since that fact is the result of a marketing choice driven by what is customary for that type of product (§ 46).

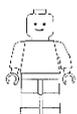
The concept of ‘shape’ is usually understood as a set of lines or contours that outline the product concerned. Colour per se could not constitute a shape (§ 54-55).



08/05/2019, T-324/18, [BOTTIGLIA DORATA \(3D\)](#), EU:T:2019:297, § 46, 54-55

#### Shape not resulting from the nature of the goods – Determination of the nature of the goods – Dual nature of the goods

The goods in question have a dual nature, namely as ‘toy figures’ with human features and as an ‘interlocking toy figure’, which has a technical effect in the sense that it can be assembled with a modular system. The goods therefore consist of an ‘interlocking toy figure’ with two purposes in mind, namely to be played with, which is a purpose of a non-technical nature, and the possibility of assembling them or fitting them together, which is a technical purpose (§ 53, 60).



[06/12/2023, T-297/22, FORM EINER SPIELZEUGFIGUR MIT NOPPE AUF DEM KOPF \(3D\), EU:T:2023:780](#)

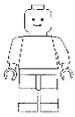
[06/12/2023, T-298/22, FORM EINER SPIELZEUGFIGUR \(3D\), EU:T:2023:781](#)

#### Shape not resulting from the nature of the goods – Identification of essential characteristics – Relevant additional elements – Well-known facts

In order to examine a shape that results from the nature of the goods themselves within the meaning of Article 7(1)(e)(i) CTMR, the essential characteristics of the sign must be assessed

with regard to the nature of the specific goods represented in the sign at issue. Such an examination cannot be made without taking into account, where appropriate, the additional elements relating to the nature of these specific goods, even if they are not visible in the graphic representation (§ 41). The case-law related to Article 7(1)(e)(ii) CTMR according to which, apart from the mere graphic representation of the sign, other information can be considered to determine the essential characteristics of the sign in question, is applicable by analogy to Article 7(1)(e)(i) CTMR (§ 68).

Characteristics that prove to be important for the generic functions of the goods constitute essential characteristics. Such essential characteristics may be inferred from the trade mark in the light of its graphic representation and other information, in particular the public's knowledge of the generic functions of the goods concerned, which may be a well-known fact, such as the public's knowledge of Lego's modular building-block systems, and/or shown by the submitted evidence. Decorative and fanciful elements of the contested mark, such as a rectangular and compact design as well as the general proportions, can also constitute essential characteristics where they are also important graphic elements of the shape at issue (§ 55, 70, 72-73).

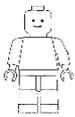


[06/12/2023, T-297/22, FORM EINER SPIELZEUGFIGUR MIT NOPPE AUF DEM KOPF \(3D\), EU:T:2023:780](#)  
[06/12/2023, T-298/22, FORM EINER SPIELZEUGFIGUR \(3D\), EU:T:2023:781](#)

### **Shape not resulting from the nature of the goods – At least one essential characteristic not resulting from the nature of the goods**

Article 7(1)(e)(i) CTMR is not applicable where at least one essential characteristic of the shape does not result from the nature of the goods themselves (§ 45, 84).

Where the concrete design of an essential characteristic of the shape in question (eg. the cylindrical shape of the head) is only one possible expression of the concrete application of the typical function of the goods, that characteristic results from the creative freedom available to the designer of such goods. Therefore, it is not inherent to the generic functions of these goods. Although the presence of an essential characteristic may be fundamentally necessary due to the (dual) nature of the product, there can still be a wide degree of freedom in the design of this element, which can then take on many other forms than just those of the contested trade mark (§ 86-88).



[06/12/2023, T-297/22, FORM EINER SPIELZEUGFIGUR MIT NOPPE AUF DEM KOPF \(3D\), EU:T:2023:780](#)  
[06/12/2023, T-298/22, FORM EINER SPIELZEUGFIGUR \(3D\), EU:T:2023:781](#)

## **7.2 SHAPE OR OTHER CHARACTERISTICS OF GOODS NECESSARY TO OBTAIN A TECHNICAL RESULT**

### **Article 7(1)(e)(ii) EUTMR – Essential characteristics**

Neither the distinctive character of the elements of a sign nor their distinctive character acquired through use is relevant in determining the sign's essential characteristics for the purposes of Article 7(1)(e)(ii) EUTMR (§ 51-55, 59-61, 64).

Article 7(1)(e)(ii) EUTMR applies to a sign that does not include every detailed characteristic of the product, provided that it is demonstrated that the essential characteristics of that sign combine

at least the characteristics which are technically causal of, and sufficient to obtain, the intended technical results (§ 77).



24/09/2019, T-261/18, [DEVICE OF A BLACK SQUARE CONTAINING SEVEN CONCENTRIC BLUE CIRCLES \(fig.\)](#), EU:T:2019:674 § 51-55, 59-61, 64, 77

### **Article 7(1)(e)(ii) EUTMR – Essential characteristics – Functionality**

The BoA was correct to conclude that the concentric circles were the only essential characteristic of the contested mark (§ 50). The colour combination serves only to enable the series of concentric circles in that mark to stand out as a result of the contrast created between the colours black and orange. It is not therefore the colour combination that is the most important element of the contested mark, but rather the series of concentric circles (§ 51).

As regards the colour orange per se, detailed examination shows that other marks filed by the applicant all contained the same series of concentric circles, but with different colour combinations. The BoA was therefore correct to note that the existence of those other marks with different colour combinations weakened the applicant's argument that the colours were an important characteristic of the contested mark (§ 52).

Moreover, the presumed perception of the contested mark by the 'independent observer unaware of the product and its function' or by 'specialised consumers', as referred to by the applicant, is not a decisive element when applying the ground for refusal set out in Article 7(1)(e)(ii) EUTMR (§ 55). The identification of the essential characteristics of a sign in the context of Article 7(1)(e)(ii) EUTMR should not necessarily be performed from the perspective of the relevant public (§ 58-60).

Since the essential characteristic of the contested mark, namely the concentric circles, is necessary to obtain the technical result sought by the product concerned, the mark falls within the scope of the ground referred to in Article 7(1)(e)(ii) EUTMR (§ 79).



15/07/2021, T-455/20, [DEVICE OF BLACK CIRCLES PLACED OVER AN ORANGE SQUARE \(fig.\)](#), EU:T:2021:483, § 52, 58-60, 79

### **Functionality – Reliance on the possibility of using the sign in a non-functional way – Irrelevant under Article 7(1)(e)(ii)**

When applying Article 7(1)(b) EUTMR, the competent authority must take into consideration the various ways in which a mark is likely, if registered, to be presented to the relevant public to determine whether that public will perceive the sign at issue as an indication of the commercial origin of the goods or services concerned. No such obligation may be imposed however when applying the ground for refusal set out in Article 7(1)(e)(ii) EUTMR (§ 85).

For the purposes of applying Article 7(1)(e)(ii) EUTMR, the competent authority needs only to determine, on an objective basis, whether the sign at issue consists exclusively of the shape of the product concerned which is necessary to obtain a technical result (§ 86). Accordingly, even if the applicant were to use the contested mark as a logo and that mark were to fulfil the function of identifying the origin of the goods concerned, those circumstances are irrelevant since it has been

established that the contested mark fell within the scope of the ground for refusal set out in Article 7(1)(e)(ii) EUTMR (§ 87).



15/07/2021, T-455/20, [DEVICE OF BLACK CIRCLES PLACED OVER AN ORANGE SQUARE \(fig.\)](#), EU:T:2021:483, § 85-87

### Article 7(1)(e)(ii) EUTMR – Essential characteristics

The examination, under Article 7(1)(e)(ii) EUTMR, consists of two steps: first, the identification of the essential characteristics of the sign as represented (without taking into account the actual product) (§ 49), and second, the analysis of the functionality of the essential characteristics of the sign, which must be carried out in the light of the actual goods and the intended technical result of those goods (§ 84).

The BoA made an error of assessment in identifying the essential characteristics of the contested mark by including ‘the differences in the colours on the six faces of the cube’ as one of the essential characteristics (§ 65-70, 92). However, that error does not affect the legality of the contested decision (§ 71, 93).



24/10/2019, T-601/17, [Cubes \(3D\)](#), EU:T:2019:765, § 49, 65-70, 71, 84, 92-93

### Preliminary ruling – Article 3(1)(e)(ii) of Directive 2008/95 – Essential characteristics – Technical result

Article 3(1)(e)(ii) of Directive 2008/95 may be applied when the graphic representation of the shape of the product allows only part of the shape to be seen, provided that the visible part of the shape is necessary to obtain the technical result sought by that product, even if it is not sufficient, on its own, to obtain that result. Therefore, that ground for refusal is applicable to a sign consisting of the shape of the product concerned which does not show all the essential characteristics required to obtain the technical result sought, provided that at least one of the essential characteristics required to obtain that technical result is visible in the graphic representation of the shape of that product (§ 32).



23/04/2020, C-237/19, [Gömböc Kutató](#), EU:C:2020:296, § 32

### Preliminary ruling – Article 3(1)(e)(ii) of Directive 2008/95 – Essential characteristics – Functionality and the public’s knowledge

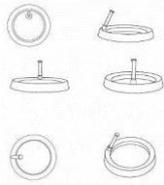
Article 3(1)(e)(ii) of Directive 2008/95/EC must be interpreted as meaning that, in order to establish whether a sign consists exclusively of the shape of goods which is necessary to obtain a technical result, the assessment does not have to be limited to the graphic representation of that sign (§ 37). The first step of the analysis is to identify the essential characteristics of the sign. For that step, information other than that relating to the graphic representation alone, such as the relevant public’s perception, may be used (§ 29-31, 37). The second step of the analysis is to establish if the essential characteristics perform a technical result. For that step, information which is not apparent from the graphic representation of the sign must originate from objective and reliable sources and may not include the relevant public’s perception (§ 32-36, 37).



23/04/2020, C-237/19, [Gömböc](#) Kutató, EU:C:2020:296, § 29-32, 36-37

### Article 7(1)(e)(ii) EUTMR – Sign consisting exclusively of the shape of the product

The sign applied for coincides with the shape of the product necessary to obtain a technical result (§ 24-27). The existence of other shapes that could achieve the same technical result does not impede the application of Article 7(1)(e)(ii) CTMR [now Article 7(1)(e)(ii) EUTMR] (§ 32-33). The shape of the product does not incorporate a major non-functional element, such as a decorative or imaginative element that plays an autonomous role in that shape (§ 41-44).



26/03/2020, T-752/18, [3D](#), EU:T:2020:130, § 41-44

### Article 7(1)(e)(ii) EUTMR – Essential characteristics – Technical result – Sign consisting of a shape which does not represent a significant part of the good – Scope of protection of the mark

The GC did not err in law by holding that the BoA had unlawfully added to the shape of the mark elements which do not form part of it and which accordingly allowed it to qualify the mark as a 'representation of a tyre tread' (§ 65-66).

Since the protection of the mark is limited to the shape that it represents, it cannot prevent the use of identical or similar shapes that, combined with other elements, create a different shape (§ 77).



03/06/2021, C-818/18P, [DEVICE OF PIRELLI TYRE TREAD \(fig.\)](#), EU:C:2021:431, § 65-66, 77

### Identification of the essential characteristics under Article 7(1)(e)(ii) EUTMR

For the purpose of applying Article 7(1)(e)(ii) EUTMR, the essential characteristics of a shape must be identified objectively, on the basis of its graphic representation and any descriptions filed at the time of the application for the trade mark (§ 41).

In accordance with the case-law, the technical elements of which the mark is composed must be regarded as essential, since they perform a necessary function for obtaining a technical result by means of the product concerned. They are therefore inseparable and indispensable elements of the product whose shape constitutes the mark. Therefore, those technical elements correspond to the definition established by the case-law, according to which the expression 'essential characteristics' is to be understood as referring to the most important elements of the sign (§ 51).



30/03/2022, T-264/21, [FORMA DE BOTA DE REBOTE CON ELEMENTOS DENOMINATIVOS "AEROWER JUMPER1 M" \(3D\)](#), EU:T:2022:193, § 40-42, 44, 51, 63

### **Relevance of the perception of the relevant public and the distinctive character of the elements of the sign in the identification of the essential characteristics under Article 7(1)(e)(ii) EUTMR**

The perception of the sign by the average consumer is not a decisive element, but, at most, can constitute a useful criterion for the competent authority when it identifies the essential characteristics of the sign (§ 40).

The concept of 'essential characteristics' does not refer to the concept of 'distinctive elements' of a sign, but only to the 'most important elements of the sign', which, according to the case-law, must be identified on a case-by-case basis (§ 42).

The perception of the relevant public within the framework of Article 7(1)(b) EUTMR and under Article 7(1)(e)(ii) EUTMR do not coincide in object and purpose. It follows that the distinctive character of the elements of a sign is not relevant when identifying its essential characteristics in the context of Article 7(1)(e)(ii) EUTMR (§ 44).



30/03/2022, T-264/21, [FORMA DE BOTA DE REBOTE CON ELEMENTOS DENOMINATIVOS "AEROWER JUMPER1 M" \(3D\)](#), EU:T:2022:193, § 40-42, 44, 51, 63

### **Relevance of the type of mark for which protection is sought in the identification of the essential characteristics under Article 7(1)(e)(ii) EUTMR**

In the light of the specific circumstances of the present case, as well as the type of mark for which protection is sought and the specific representation of the word and figurative elements on the rebound boot, the shape which is the subject of the application for protection is the most important part of the overall impression produced by the sign (§ 63).



30/03/2022, T-264/21, [FORMA DE BOTA DE REBOTE CON ELEMENTOS DENOMINATIVOS "AEROWER JUMPER1 M" \(3D\)](#), EU:T:2022:193, § 40-42, 44, 51, 63

### **Technical functionality – Separate assessment for each of the goods concerned**

The examination of the absolute ground for invalidity referred to in Article 7(1)(e)(ii) CTMR must be carried out in relation to each of the goods for which the contested mark was registered. The underlying rationale of that provision is to prevent trade mark law from granting an undertaking a monopoly on technical solutions. For there to be a risk that an undertaking may monopolise, through trade mark law, technical solutions or functional characteristics of a product, that product must be covered by the trade mark concerned (§ 27-32).

[07/06/2023, T-218/22 & T-219/22, DEVICE OF SEALING MODULES FOR PIPES OR CABLES \(fig.\), EU:T:2023:317](#)

### **Technical functionality – Irrelevance of LOC**

It follows from a reading of the various provisions of Article 7(1) CTMR as a whole that they refer to the intrinsic qualities of the contested mark and not to circumstances relating to a possible LOC. There is, therefore, no need to review the lawfulness of the contested decision based on Article 7(1)(e)(ii) CTMR in respect of a possible LOC, on the basis of the contested trade mark,

against the goods for which protection is sought, produced and marketed by competitors of the EUTM proprietor (§ 50).

[07/06/2023, T-218/22 & T-219/22, DEVICE OF SEALING MODULES FOR PIPES OR CABLES \(fig.\), EU:T:2023:317](#)

#### **Shape necessary to obtain a technical result – Irrelevance of the additional aesthetic value of a functional essential characteristic**

The application of Article 7(1)(e)(ii) CTMR is not excluded only because an essential characteristic of the contested mark, which is necessary for obtaining a technical result, at the same time also has an aesthetic value or is unusual (§ 45).

[05/07/2023, T-10/22, FORM EINER FLASCHE \(3D\), EU:T:2023:377](#)

#### **Shape necessary to obtain a technical result – Irrelevance of the effect of the sum of functional elements**

The fact that the sum of functional elements contributes to creating a decorative image of the contested mark is irrelevant for the assessment of Article 7(1)(e)(ii) CTMR (§ 49).

[05/07/2023, T-10/22, FORM EINER FLASCHE \(3D\), EU:T:2023:377](#)

#### **Shape necessary to obtain a technical result – Functionality of the essential characteristics of the sign – Incorporation of a technical solution into the sign**

The 'luminous yellow' coloured bands are intended to ensure their visibility during the day and the 'silver grey' retro-reflective band can reflect light emitted by a vehicle or a lamp during the night. Moreover, the contrast resulting from the succession of those two colours enhances their perceptibility. Since the horizontal arrangement of the three bands allows the colours to alternate, further enhancing visibility, the argument that there are other ways of arranging those three bands in order to achieve the desired result is ineffective (§ 31-32).

The slanted lines correspond to a fire-resistant segmented reflective transfer film intended to enhance the night-time visibility of those goods, as demonstrated by the EUTM applicant's patent. Therefore, the transparent slanted lines incorporate a technical solution into the sign applied for, irrespective of the fact that they do not have a reflective property (§ 37-39).



[14/11/2023, T-801/22, Device of two luminous yellow bands with a silver grey band between \(fig.\)](#)

#### **Shape necessary to obtain a technical result – Essential characteristics not sufficient to achieve the technical result**

Where the essential characteristics of the sign applied for are necessary in order to obtain the technical result sought by the product concerned, that sign infringes the ground laid down in Article 7(1)(e)(ii) EUTMR, although those characteristics are not sufficient, on their own, to achieve that result (§ 47).

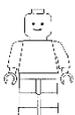


[14/11/2023, T-801/22, Device of two luminous yellow bands with a silver grey band between \(fig.\)](#)

#### **Shape not necessary to obtain a technical result – Determination of the function – Dual purpose and function of the goods**

The functions to which the essential characteristics of the shape in question correspond must, as far as possible, be assessed in relation to the nature of the goods specifically represented. When examining the functionality of a sign within the meaning of Article 7(1)(e)(ii) CTMR, the relevant authority is therefore not bound solely by the functions apparent from the graphic representation of the trade mark, but must take account of other factors relating to the specific goods in question (§ 111-112, 127).

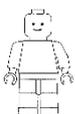
The goods in question have a dual purpose, both as ‘toy figures’ with human features and as ‘interlocking toy figures’, which have a technical effect in the sense that they can be assembled and are modular, inter alia, with the Lego building block system. The non-technical effect of the goods consists in its suitability for play and in the embodiment of a ‘little man’ with human features. The technical effect of the goods also includes their buildability and modularity (§ 131, 137-138).



[06/12/2023, T-297/22, FORM EINER SPIELZEUGFIGUR MIT NOPPE AUF DEM KOPF \(3D\), EU:T:2023:780](#)  
[06/12/2023, T-298/22, FORM EINER SPIELZEUGFIGUR \(3D\), EU:T:2023:781](#)

### **Shape not necessary to obtain a technical result – Identification of essential characteristics**

The identification of the essential characteristics of the shape in question in the context of Article 7(1)(e)(ii) CTMR is carried out with the specific aim of enabling the functionality of that shape to be examined (§ 109). Characteristics that prove to be important for the technical functions of the goods represented constitute essential characteristics of the sign in question. Such essential characteristics may be inferred from the trade mark in the light of its graphic representation and other information, in particular the public’s knowledge of the functions of the goods concerned, as shown by the submitted evidence and which is also a well-known fact. Decorative and fanciful elements of the contested mark, such as a rectangular and compact design as well as the general proportions, can also constitute essential characteristics where they are also important graphic elements of the shape at issue (§ 144, 146-147).



[06/12/2023, T-297/22, FORM EINER SPIELZEUGFIGUR MIT NOPPE AUF DEM KOPF \(3D\), EU:T:2023:780](#)  
[06/12/2023, T-298/22, FORM EINER SPIELZEUGFIGUR \(3D\), EU:T:2023:781](#)

## **7.3 SHAPE OR OTHER CHARACTERISTICS GIVING SUBSTANTIAL VALUE TO THE GOODS**

### **Preliminary ruling – Concept of ‘shape’ – Shape giving substantial value to the goods**

Article 7(1)(e)(iii) CTMR must be interpreted as meaning that a sign consisting of two-dimensional decorative motifs, which are affixed to goods, such as fabric or paper, does not ‘consist exclusively of the shape’, within the meaning of that provision (§ 48). The notion of ‘shape’ within the meaning of Article 3(1)(e)(iii) of Directive 2008/95/EC is limited to the contours of a product, to the exclusion of all other characteristics which may contribute to the appearance of this product, such as a pattern applied to the entirety or a specific part of a product without being delineated in a fixed manner (§ 33, 36-41). It cannot be held that a sign consisting of two-dimensional decorative motifs is indissociable from the shape of the goods where that sign is affixed to goods, such as fabric or paper, the form of which differs from those decorative motifs (§ 42). Such a sign

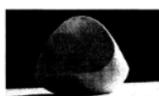
cannot be regarded as consisting ‘exclusively of the shape’ within the meaning of Article 7(1)(e)(iii) CTMR (§ 43).



14/03/2019, C-21/18; [Textilis](#), EU:C:2019:199, § 33, 36-41, 42-43

### **Preliminary ruling – Shape giving substantial value to the goods – The relevant public’s perception or knowledge – Decision on purchase – Article 3(1)(e)(iii) of Directive 2008/95**

Article 3(1)(e)(iii) of Directive 2008/95 must be interpreted as meaning that the relevant public’s perception or knowledge of the product represented graphically by a sign that consists exclusively of the shape of that product may be taken into consideration in order to identify an essential characteristic of that shape. The ground for refusal may be applied if it is apparent from objective and reliable evidence that the consumer’s decision to purchase the product in question is to a large extent determined by that characteristic (§ 39-46, 47).



23/04/2020, C-237/19, [Gömböc Kutató](#), EU:C:2020:296, § 39-46, 47

### **Preliminary ruling – Shape giving substantial value to the goods – Cumulative protection – Designs – Decorative items – Article 3(1)(e)(iii) of Directive 2008/95**

Article 3(1)(e)(iii) of Directive 2008/95 must be interpreted as meaning that that ground for refusal must not be applied systematically to a sign which consists exclusively of the shape of the goods where that sign enjoys protection under the law relating to designs or where the sign consists exclusively of the shape of a decorative item (§ 50, 53, 58-59, 62).



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23/04/2020, C-237/19, [Gömböc Kutató](#), EU:C:2020:296, § 39-46, 47, 50, 53, 58-59,

### **Article 7(1)(e)(iii) CTMR not applicable – Sign not consisting of the shape of the goods**

The goods (jewellery) are likely to bear the sign of which the mark consists, but not to take the shape thereof. Consequently, the contested mark consists of a sign unrelated to the appearance of the goods it covers and not of a sign that consists exclusively of their shape (§ 90, 91).



[26/07/2023, T-591/21, DEVICE OF THE OUTLINE OF A BEAR \(fig.\), EU:T:2023:433](#)

## **8 ARTICLES 7(1)(f), 59(1)(a) EUTMR – PUBLIC POLICY / MORALITY**

### **Contrary to public policy or principles of morality**

The combination of the verbal element ‘store’, which normally means ‘shop’, with the dominant verbal element ‘cannabis’ will be perceived by the relevant English-speaking public as meaning ‘cannabis shop in Amsterdam’, and by the relevant non-English-speaking public as ‘cannabis in Amsterdam’. In both cases, coupled with the image of the cannabis leaves, which is a commonly used symbol for marijuana, it is a clear and unequivocal reference to the narcotic substance (§ 65). A sign referring to cannabis may not, as the law currently stands, be registered as an EU trade mark since it is contrary to the fundamental interest of Member States and is therefore

against public policy for all the consumers in the European Union who can understand its meaning (§ 74-77).



12/12/2019, T-683/18, [CANNABIS STORE AMSTERDAM](#), EU:T:2019:855, § 65, 74-77

### **Not contrary to public policy or principles of morality – Accepted principles of morality**

The concept of ‘accepted principles of morality’ is determined by taking into account the fundamental moral values and standards that society adheres to at a given time. Those values and norms, which are likely to change over time and vary geographically, should be determined according to the social consensus prevailing in that society at the time of the assessment, taking into account the social context (including cultural, religious or philosophical diversities) to assess objectively what that society considers to be morally acceptable at that time (§ 39).

27/02/2020, C-240/18 P, [Fack Ju Göhte](#), EU:C:2020:118, § 39

### **Contrary to public policy – Definition of public policy – Legality of the services**

EU law does not impose a uniform scale of values and acknowledges that the requirements of public policy may vary from one country to another and from one era to another. The requirements of public policy may cover protection of the various interests that the Member State concerned considers to be fundamental in accordance with its own system of values. However, account must be taken, where appropriate, not only of the particular circumstances in the individual Member State, but also of circumstances common to all Member States. The protection of health and prohibition of drugs is of fundamental interest in the EU, see Article 83 and Article 168(1), third subparagraph TFEU (12/12/2019, T-683/18, CANNABIS STORE AMSTERDAM, EU:T:2019:855, § 71, 73, 75) (§ 40-41, 44).

The word ‘weed’ is used colloquially to refer to drugs (§ 29). The legality of the services covered by the sign cannot be of any relevance to the perception of the relevant public (§ 31). The association of the term ‘weed’ with services of a therapeutic nature involves the risk that the general public gets the impression that the consumption and production of the narcotics to which the sign alludes will be tolerated or even promoted (§ 35). The BoA correctly found that the sign is contrary to public policy within the meaning of Article 7 (1) (f) EUTMR (§ 45).



12/05/2021, T-178/20, [Bavaria Weed \(fig.\)](#), EU:T:2021:259, § 29, 31, 35, 40-41, 44-45

### **Not contrary to public policy – Sign protected as a GI – No infringement of public policy provisions at the date of filing**

Where the invalidity applicant claims that the contested mark has been registered contrary to public policy, it must in the first place establish the infringement of a public policy provision. It has not been demonstrated that the contested mark was, on its filing date, capable of infringing the Bulgarian provisions relating to ‘the corresponding provisions of the PGI’ (§ 103).

[14/12/2022, T-526/20, DEVIN, EU:T:2022:816](#)

## 9 ARTICLES 7(1)(g), 59(1)(a) EUTMR – DECEPTIVE TRADE MARK

### 9.1 ASSESSMENT OF DECEPTIVE CHARACTER

#### Scope of Article 7(1)(g) EUTMR – Possibility of non-misleading use of a mark

The term 'bio', generally speaking, refers to the idea of respect for the environment, the use of natural materials, or organic products (§ 80-81).

Use of the term 'bio' on biocidal goods (§ 75) establishes a sufficiently serious risk of misleading the consumer as to the purpose of those goods, namely that they serve to destroy or prevent pests (§ 83).

Article 7(1)(g) CTMR [now Article 7(1)(g) EUTMR] applies even where non-misleading use of the mark at issue is possible (§ 84-85).

*13/05/2020, T-86/19, [BIO-INSECT Shocker](#), EU:T:2020:199, § 80-81, 83, 84-85*

#### Deceptiveness – Difference between invalidity [Article 7(1)(g) CTMR] and revocation [Article 51(1)(c) CTMR]

Articles 52 to 54 CTMR [now Articles 59 to 61 EUTMR] govern the grounds for invalidity of an EUTM, whereas a separate provision, Article 51 CTMR [now Article 59 EUTMR], concerns grounds for revocation. The misleading nature of a mark constitutes an absolute ground for invalidity of that mark under the provisions of Article 52(1)(a) CTMR, in conjunction with Article 7(1)(g) CTMR, and, in addition, a ground for revocation under Article 51(1)(c) CTMR. Article 51(1)(c) CTMR provides expressly that the misleading nature of a registered trade mark, which justifies a declaration that the rights of its proprietor are revoked, arises from the use made of that mark, whereas the provisions of Article 52(1)(a) CTMR, in conjunction with Article 7(1)(g) CTMR, which render invalid a mark that has been registered in spite of its deceptive nature, do not contain any reference to such use (§ 63-65).

In principle, the examination of an application for revocation within the meaning of Article 51(1)(c) CTMR requires that account be taken of the actual use of the mark and thus of evidence subsequent to its filing, whereas that is not the case for the purpose of examining an application for a declaration of invalidity brought under the provisions of Article 52(1)(a) CTMR, in conjunction with Article 7(1)(g) CTMR. The examination of such an application for a declaration of invalidity requires that it be established that the sign filed for the purposes of registration as a mark was per se of such a nature as to deceive the consumer at the time of filing of the application for registration, since the subsequent management of that sign is irrelevant (§ 66).

The only date relevant for the purposes of the assessment of an application for a declaration of invalidity is the date of filing of the application for the mark at issue and material subsequent to the date of filing of the trade mark application may be taken into account only if it relates to the situation on that date. In the case of invalidity, the question which arises is whether the mark should not have been registered ab initio for reasons already existing on the date of the trade mark application, since the consideration of subsequent evidence can serve only to clarify the circumstances as they were on that date (§ 67, 68).

*29/06/2022, T-306/20, [LA IRLANDESA 1943 \(fig.\)](#), EU:T:2022:404*

#### The possibility of non-deceptive use rules out deceptiveness as a ground for invalidity

For the purpose of applying Article 7(1)(g) CTMR, the BoA should ascertain whether, on the date of the application for registration of the mark, there was any inconsistency between the information which the contested mark conveyed and the characteristics of the goods designated in that application. 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 on the date of the application (§ 71).

[29/06/2022, T-306/20, LA IRLANDESA 1943 \(fig.\), EU:T:2022:404](#)

### **Deceptiveness – No mandatory geographical origin limitations**

The insertion of a geographical origin limitation into the list of goods is not required by Article 7(1)(g) CTMR. The BoA erred in criticising the applicant for not having limited the list of goods to goods originating from Ireland (§ 72).

[29/06/2022, T-306/20, LA IRLANDESA 1943 \(fig.\), EU:T:2022:404](#)

### **Assessment criteria – Deceptiveness**

Article 7(1)(g) EUTMR presupposes the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived. In order for the trade mark to play its role as an essential element of the system of undistorted competition, it must offer a guarantee that all the goods or services bearing it have been manufactured or supplied under the control of a single undertaking which is responsible for their quality. A trade mark loses that role of guarantee if the relevant public can be deceived by the information it contains. In this case, none of the evidence or arguments permits the inference that the significant part of the relevant public will link the trade mark applied for to a geographical location. Therefore, it cannot be misled by the geographical origin of the services concerned (§ 107-110).

[23/11/2022, T-701/21, Cassellapark, EU:T:2022:724](#)

### **Deceptive – Etymological evolution of a term**

Although the word ‘bacon’ may have evolved and may be used to refer to bacon from other meat or plant sources, this is irrelevant since that word continues to refer to pork meat products (§ 56). The examples ‘turkey bacon’ or ‘vegan bacon’ do not establish that the word ‘bacon’ alone has lost its original meaning and no longer refers to pork meat products (§ 57).

[29/11/2023, T-107/23, MYBACON, EU:T:2023:769](#)

### **Deceptive – Relevance of political debates**

The debates in the European Parliament, in the context of the common agricultural policy, relating to the provision of food information to consumers and, in particular, the use of certain terms, do not relate to the EU system for the protection of trade marks. Moreover, the Parliament’s rejection of an amendment intended to restrict the use of certain terms to meat products cannot be interpreted as implying a contrario that their use for other goods would not be liable to deceive consumers, within the meaning of Article 7(1)(g) EUTMR (§ 62).

[29/11/2023, T-107/23, MYBACON, EU:T:2023:769](#)

## **9.2 RELEVANT PUBLIC AND LEVEL OF ATTENTION**

### **Deceptive – Relevant public – Level of attention – Meat substitutes**

The relevant public for *meat substitutes* is the general public. These goods are food products for everyday consumption by consumers as a whole. They are intended for general consumption and not only for vegetarians or vegans, since anyone is likely at some time or another to acquire such goods either regularly or occasionally (§ 35-37).

They are inexpensive goods, generally sold in supermarkets, the purchase of which is not preceded by a long period of reflection. Therefore, the relevant public displays at most an average degree of attention and places little cognitive effort into their purchase (§ 39-40).

[29/11/2023, T-107/23, MYBACON, EU:T:2023:769](#)

### 9.3 DECEPTIVE CHARACTER OF THE SIGN IN QUESTION

#### Not deceptive – Sign protected as a GI

The mere fact that a sign is protected as geographical indication according to national law and international agreements does not of its own and automatically imply the deceptive nature of the mark (§ 116). It cannot be presumed that the average consumer has an extremely high degree of knowledge, which it clearly does not possess, including international treaties and the list of geographical indications protected in its country (§ 118). There is no actual deceit or a sufficiently serious risk of the consumer being deceived as to the nature of a part of the contested goods, namely goods other than ‘mineral water complying with [the specifications of the PGI]’, in the absence of any association of the word ‘devin’ with mineral water that has specific properties by virtue of its geographical origin (§ 119).

[14/12/2022, T-526/20, DEVIN, EU:T:2022:816](#)

#### Deceptive

Use of ‘MATE MATE’ for *coffee* and *cocoa* would be deceptive because the consumer would be led to believe that those goods contain mate, although this is not the case (§ 62). Article 7(1)(g) EUTMR does not require an intention to deceive consumers (§ 64).

[31/03/2023, T-482/22, Mate mate](#)

#### Deceptive – Several possible meanings

The application of Article 7(1)(g) EUTMR only requires that the sign is deceptive in one of its possible perceptions (§ 59). Since there is a contradiction between one of the possible meanings of the sign ‘MYBACON’ and the goods for which protection is sought (meat substitutes), the fact that the word ‘my’ could also be perceived by some consumers as a reference to mycelium or the applicant’s company name is ineffective (§ 71, 77).

[29/11/2023, T-107/23, MYBACON, EU:T:2023:769](#)

## 10 ARTICLES 7(1)(h), 59(1)(a) EUTMR – FLAGS AND OTHER SYMBOLS EMBLEMS, etc.

[No key points available yet.]

## 11 ARTICLES 7(1)(i), 59(1)(a) EUTMR – EMBLEMS NOT PROTECTED UNDER ARTICLE 6ter PC

#### Protected geographical indications – Requirement of a misleading connection with the authority to which a badge, emblem or escutcheon of particular public interest refers

A trade mark which includes, without the competent authority’s consent to that effect, a badge, emblem or escutcheon of particular public interest can only be refused pursuant to Article 7(1)(i)

EUTMR for registration, or invalidated after registration, where that mark, taken as a whole, suggests to the relevant public – and thus misleads it as to – the existence of a connection between its proprietor or user and the authority to which the sign of particular public interest refers. This is, in particular, the case where the relevant public may believe that the marked goods or services originate from that authority, are approved, or certified by it, or are otherwise connected with that authority (§ 22-26, 28).

The misleading connection with the authority to which the badge, emblem or escutcheon of particular public interest refers cannot be established on the sole basis of the fact that it is included into the trade mark without the competent authority's consent. It needs to be specifically and concretely established with respect to the trade mark at hand, inter alia, in view of its size and position within that mark (§ 40, 41, 42).



01/12/2021, T-700/20, [Steirisches Kürbiskernöl g.g.A GESCHÜTZTE GEOGRAFISCHE ANGABE \(fig.\)](#), EU:T:2021:851, § 22-26, 28, 40, 41, 42

### Granting of trade mark protection to the EU's PGI symbols

Granting trade mark protection to an EU symbol such as the PGI symbol is, as a general rule, such as to adversely affect the system of protected geographical indications established by the European Union and to undermine its proper functioning. Indeed, such a grant is liable to confer on the proprietor of a trade mark including the PGI symbol a monopoly on the use of that symbol allowing him or her to prohibit the use of that symbol by any other person, contrary to Article 12 of Regulation No 1151/2012 which allows any producer to use that symbol provided that they meet the requirements for being covered by a protected geographical indication (§ 39, 45).

However, the misleading connection required for the application of Article 7(1)(i) EUTMR needs to be specifically and concretely established with respect to the trade mark at hand, inter alia, in view of its size and position within that mark (§ 40, 41, 42).



01/12/2021, T-700/20, [Steirisches Kürbiskernöl g.g.A GESCHÜTZTE GEOGRAFISCHE ANGABE \(fig.\)](#), EU:T:2021:851, § 39, 40-42, 45

## 12 ARTICLE 7(1)(j) EUTMR – GEOGRAPHICAL INDICATIONS

### Preliminary ruling – Geographical origin – Article 2(1)(a) of Regulation (EC) No 510/2006 – Article 13(1) Regulation (EC) No 510/2006

Geographical indications (GIs) are protected against any evocation, including by figurative signs (§ 18). A producer established in a geographical area corresponding to a Protected Designation of Origin (PDO), whose products are not protected by the PDO but are similar or comparable to those protected by it, is not excluded from the application of Article 13(1)(b) Regulation (EC) No 510/2006 (§ 34).

02/05/2019, C-614/17; [Fundación Consejo Regulador de la Denominación de Origen Protegida Queso Manchego](#), EU:C:2019:344, § 18, 34

### Preliminary ruling – Article 13(1)(d) Regulation No 510/2006 – Article 13(1)(d) Regulation No 1151/2012 — Practice liable to mislead the consumer as to the true origin of the product – Reproduction of the shape or appearance of a product which has a protected name

EU law prohibits, in certain circumstances, the reproduction of the shape or appearance of a product protected by a protected designation of origin (PDO). It is necessary to determine whether that reproduction may mislead consumers considering all the relevant factors, including the way in which the product is presented and marketed to the public and the factual context (§ 39, 41).

17/12/2020, C-490/19, [Morbier](#), EU:C:2020:1043, § 39, 41

### 13 ARTICLE 7(1)(k) EUTMR – TRADE MARKS IN CONFLICT WITH TRADITIONAL TERMS FOR WINES

[No key points available yet.]

### 14 ARTICLE 7(1)(l) EUTMR – TRADE MARKS IN CONFLICT WITH TRADITIONAL SPECIALITIES GUARANTEED

[No key points available yet.]

### 15 ARTICLE 7(1)(m) EUTMR – TRADE MARKS IN CONFLICT WITH EARLIER PLANT VARIETY DENOMINATIONS

#### Criteria for assessment – Article 7(1)(m) EUTMR

Article 7(1)(m) EUTMR must be interpreted in the light of its objective, which is to determine whether the registration of the trade mark applied for hinders the free use of the plant variety denomination included in the trade mark (§ 29-30).

For this purpose, it must be established whether the plant variety denomination holds an essential position within the complex trade mark applied for. If so, the free use of this variety denomination would be hindered. In contrast, if its original essential function is not based on the variety denomination, but on other components of the trade mark, the availability requirement for variety denominations is maintained (§ 31).

In order to determine whether the essential function of the mark applied for is based on the variety denomination or on other elements, the criteria to be assessed are, in particular, the distinctive character of the other elements, the message conveyed as a whole by the mark applied for, the visual dominance of the various elements by reason of their size and position, or the number of elements of which the mark is composed (§ 32).

18/06/2019, T-569/18, [Kordes' Rose Monique](#), EU:T:2019:421, § 29-32

### 16 EUROPEAN UNION COLLECTIVE MARKS

#### Descriptive – Collective mark

The scope of the derogation from Article 7(1)(c) EUTMR, which is provided for in Article 74(2) EUTMR, only covers signs that will be regarded as an indication of the geographical origin of the designated goods, not of its other characteristics (§ 10, 11, 87).

[24/05/2023, T-2/21, Emmentaler, EU:T:2023:278](#)

## 17 EUROPEAN UNION CERTIFICATION MARKS

[No key points available yet.]

## 18 SPECIFIC ABSOLUTE GROUNDS FOR INVALIDITY – ARTICLE 59(1)(b) EUTMR – BAD FAITH

### 18.1 RELEVANT POINT IN TIME

#### Relevant point in time for bad faith – Time of the filing of the application

The fact that, for a certain period, the proprietor paid the profits obtained from the exploitation of the trade mark into the accounts of Can Ganguil is not relevant. This is because bad faith must be proven at the time of filing the application and the profits were paid later (§ 55).

12/07/2019, T-772/17, [Café del Mar \(fig.\)](#), EU:T:2019:538, § 55

### 18.2 CONCEPT OF BAD FAITH

#### 18.2.1 Assessment of bad faith

##### Concept of bad faith – LOC not a prerequisite of bad faith

Bad faith presupposes a dishonest state of mind or intention (§ 45). It applies where it is apparent from relevant and consistent indicia that the proprietor of an EUTM filed its application for registration, not with the aim of engaging fairly in competition, but with the intention of undermining the interests of third parties in a manner inconsistent with honest practices, or with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, in particular the essential function of indicating origin (§ 46).

LOC is not a prerequisite of bad faith. In the absence of any LOC between the sign used by a third party and the contested EUTM, other factual circumstances may constitute relevant and consistent indicia establishing the bad faith of the EUTM applicant (§ 56).



12/09/2019, C-104/18 P, [STYLO & KOTON \(fig.\)](#), EU:C:2019:724, § 45, 46, 56

##### Concept of bad faith – No need for LOC – No need for identical similar signs – No need for reputation

To prove bad faith, it is not necessary to systematically establish the existence of a LOC between an earlier trade mark and the contested mark (§ 56-57). In particular, it is not mandatory to show the presence in the European Union of a sign identical or similar to the sign for which registration is sought for identical or similar goods or services, giving rise to a LOC (§ 52-57). A correlation between the goods or services (i.e. between watches and clothing) is sufficient (§ 58, 64-65, 69-72). Furthermore, it is not necessary to systematically establish a reputation of the earlier mark in the European Union (§ 59-61).



**ANN TAYLOR** 23/05/2019, T-3/18 and T-4/18, [ANN TAYLOR / ANNTAYLOR et al.](#),  
EU:T:2019:357, § 52-58, 64-65, 69-72

### **Concept of bad faith – Potentially descriptive character of a common element**

Where certain objective circumstances show that the EUTM proprietor filed the mark in bad faith, the potentially descriptive character of the element common to both signs cannot prevail over the finding of bad faith (§ 69).

The proprietor acted in bad faith when, shortly after the invalidity applicant refused cooperation, it requested registration of the EUTM specifically containing the element 'outsource2india', used by the invalidity applicant in its commercial activities (§ 70).



**Outsource2india** 13/11/2019, C-528/18 P, [Outsource 2 India \(fig.\)](#),  
EU:C:2019:961, § 69-70  
16/12/2020, T-438/18, [BIKOR EGYPTIAN EARTH](#), EU:T:2020:630, § 28

### **Concept of bad faith – Use of an earlier right not a necessary condition**

The use of an earlier right by a third party on the internal market, at the time of application for registration of a mark, is not a necessary condition in order to rely on bad faith (12/09/2019, C-104/18 P, *STYLO & KOTON* (fig.), EU:C:2019:724, § 52) (§ 42).



09/06/2021, T-396/20, [RIVIERA AIRPORTS \(fig.\)](#), EU:T:2021:326, § 42



09/06/2021, T-398/20, [RIVIERA AIRPORT \(fig.\)](#), EU:T:2021:327, § 42

### **Irrelevance of cancellation applicant's alleged bad faith**

The argument as regards the alleged bad faith on the part of the applicants for a declaration of invalidity is ineffective. Even if bad faith on the part of the applicants for a declaration of invalidity were proved, that fact alone could not call into question the finding that the applicant of the EUTMs was acting in bad faith when it filed its applications for registration, as the assessment of whether there has been bad faith on the part of the applicants for a declaration of invalidity, as alleged, is totally independent of the bad faith on the part of the EUTM applicant (§ 74).

[18/01/2023, T-528/21, MORFAT, EU:T:2023:4](#)

### **Irrelevance of cancellation applicant's alleged bad faith**

The ground for invalidity for bad faith is based on public interest and cannot therefore depend on the possible bad faith of the applicant for a declaration of invalidity (§ 45).

[25/01/2023, T-703/21, Falubaz, EU:T:2023:19](#)

### **Concept of bad faith – Legal protection of the earlier sign**

The determination of the legal rules conferring legal protection on the earlier sign is a decisive factor in ascertaining, first, whether the applicant had knowledge thereof at the time of filing the

contested trade mark and, secondly, whether, when filing that trade mark, the applicant was not, in fact, in possession of all the rights relating to the earlier sign through the national marks of which it is the proprietor, including the reputation of the earlier sign (§ 38).

[15/02/2023, T-684/21, Mostostal, EU:T:2023:68](#)

### **Assessment of bad faith – Relevant factors to take into consideration – Goods and services out of the scope of appeal**

In order to take into consideration all the relevant factors specific to the particular case when assessing bad faith, all the goods and services for which protection was sought under the contested mark at the date of filing should be taken into consideration, even if the extent of the appeal is limited to some of the goods and services (§ 38).

[22/03/2023, T-366/21, Coinbase / Coinbase et al., EU:T:2023:156](#)

### **Bad faith – Irrelevance of the lack of prior registration of the sign by a third party**

The fact that the invalidity applicant did not apply for registration of a trade mark similar to the contested mark does not establish that the application was made in good faith, since prior use of the sign in question by a third party is not a condition required by Article 59(1)(b) CTMR (§ 55).

[13/12/2023, T-382/22, El rosco / El rosco, EU:T:2023:800](#)

[13/12/2023, T-383/22, EL ROSCO \(fig.\) / El rosco, EU:T:2023:801](#)

See also, [13/12/2023, T-381/22, El rosco / El rosco, EU:T:2023:799](#), § 53

### **Assessment of bad faith – Knowledge of the use of the earlier mark as used on the market**

When the identity or similarity with a prior sign is invoked to establish that the registration of the contested trade mark was applied for in bad faith, the manner in which this prior sign has been used on the market from its inception cannot be overlooked in the assessment of bad faith, regardless of whether this sign has been registered as a trade mark. In the present case, the use of the Norwegian flag as well as the graphical elements of the signs in question should be taken into account in the analysis of the similarities between the figurative sign NAPAPIJRI geographic and the contested mark (§ 48-54).



[06/03/2024, T-639/22, GEOGRAPHICAL NORWAY EXPEDITION \(fig.\) / NAPAPIJRI geographic \(fig.\) et al., EU:T:2024:149](#)

### **Assessment of bad faith – Chronology of the events – Commercial logic – Extension of geographical scope of protection**

Although the EUTM proprietor has an earlier French word mark 'GEOGRAPHICAL NØRWAY' registered prior to the filing of the invalidity applicant's figurative EUTM 'NAPAPIJRI geographic', the filing of the contested EUTM does not align with a commercial logic aimed at securing protection across the EU for the said French mark. Firstly, the EUTM proprietor had already applied for an IR designating the EU based on that French mark. Secondly, the contested mark cannot be regarded as a mere variant of the French word mark 'GEOGRAPHICAL NØRWAY', due to the figurative nature of the contested trade mark, the addition of the term 'expedition', the composition of its elements, and the claimed colours. In any event, even if the contested EUTM were considered a simple variant of the French mark, this would not automatically exclude the bad faith of the EUTM proprietor (§ 69-72).

[06/03/2024, T-639/22, GEOGRAPHICAL NORWAY EXPEDITION \(fig.\) / NAPAPIJRI geographic \(fig.\) et al., EU:T:2024:149](#)

### **Assessment of bad faith – Chronology of the events – Relevance of prior conflicts between the parties concerning different marks**

While no contractual relationship between the parties to the dispute has been established, the evidence submitted demonstrates that the market relationship between the parties was fraught with tension. From at least 2002, the parties were well aware of each other, with their legal predecessors engaging in multiple oppositions. These past conflicts, albeit involving different trade marks than those in the current dispute, have to be taken into account. They are integral to the sequence of events leading up to the filing of the contested EUTM, providing valuable context for evaluating the EUTM proprietor's intentions (§ 77-80).

[06/03/2024, T-639/22, GEOGRAPHICAL NORWAY EXPEDITION \(fig.\) / NAPAPIJRI geographic \(fig.\) et al., EU:T:2024:149](#)

### **Assessment of bad faith – Chronology of the events – Relevance of parasitic behaviour towards third parties**

The invalidity applicant provided several examples of trade marks that the legal predecessor of the EUTM proprietor attempted to register, either in France or with the EUIPO, consisting of signs very similar to marks of other companies, also aiming to ride on their coattails. That evidence, regardless of it concerning different trade marks from the signs in question, is relevant for assessing bad faith (§ 87-90).

[06/03/2024, T-639/22, GEOGRAPHICAL NORWAY EXPEDITION \(fig.\) / NAPAPIJRI geographic \(fig.\) et al., EU:T:2024:149](#)

## **18.2.2 Factors likely to indicate the existence of bad faith**

### **Bad faith of a distributor – Deterioration of the distribution agreement with the manufacturer**

The factors to be taken into consideration are: (i) whether the EUTM proprietor knew, at the date of filing of the EUTM, that the invalidity applicant had previously been using the sign corresponding to the EUTM, (ii) the nature of the contractual relationship between the parties, (iii) the origin of the sign corresponding to the EUTM, (iv) the degree of legal protection of the sign corresponding to the EUTM, and (v) the EUTM proprietor's intention at the time of filing of the EUTM (§ 46).

The distributor acted in bad faith, since the application for the EUTM was filed, without genuine intention to use it, for the sole purpose of preventing the marketing of competing products (§ 82-83). The lack of intention to use the sign corresponding to the EUTM is of particular importance because it goes against the essential function of a mark, which is to guarantee the identity of the origin of the goods and services it protects (§ 85).

[30/04/2019, T-136/18, K \(fig.\), EU:T:2019:265, § 46, 82-83, 85](#)

### **Bad faith – Intention to free-ride on a person's reputation**

The concept of bad faith relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct that departs from accepted principles of ethical behaviour or honest commercial and business practices (§ 23).

The existence of bad faith on the part of the applicant for registration at the time of filing the application for registration of an EU trade mark must be assessed, inter alia, in the light of his intention. The intention of the applicant for registration at the relevant time is a subjective factor, which must be determined by reference to the objective circumstances of the particular case (§ 49).

Neymar was already recognised as a very promising football player on the relevant date (§ 30-33). It can be deduced from this objective fact, proved by evidence, and from the other objective fact that the EUTM proprietor had filed an application for registration of the word mark IKER CASILLAS on the same day, that the EUTM proprietor possessed more than a little knowledge of the world of football (§ 36). In the light of only those factors and the particular circumstances of the case, the real purpose of the commercial logic behind the application for registration of the EUTM was to 'free-ride' on Neymar's reputation and take advantage of that reputation (§ 50-51).

14/05/2019, T-795/17, [NEYMAR](#), EU:T:2019:329, § 23, 30-33, 36, 49-51

### **Bad faith – Attempt to obtain the right to market goods under an identical trade mark**

The attempt to obtain the right to market goods under an identical trade mark owned by the invalidity applicant, that the latter had refused to follow up, constitutes an indication of bad faith (§ 124, 125).

The use of the contested sign may constitute a factor to be taken into account when establishing the intention underlying the application for registration of the sign, including use after the date of that application (§ 118, 119, 126).



**ANN TAYLOR** 23/05/2019, T-3/18 and T-4/18, [ANN TAYLOR / ANNTAYLOR et al.](#), EU:T:2019:357, § 118-119, 124-125, 126

### **Bad faith of a partner – Power of representation**

One of the three partners in the company that owned 'Café del Mar' applied for the registration of this EUTM figurative mark. An invalidity application was filed by the two other partners in the company that owned 'Café del Mar'. All the companies incorporated by the invalidity applicants and the EUTM proprietor belonged to the three partners equally. One of these companies, Can Ganguil, granted a power of representation to the EUTM proprietor to act on behalf of the company and to represent it (§ 39).

The power of attorney granted to act on behalf of the company and to represent it cannot be considered as an acknowledgement of the supremacy of the representative regards the other partners as to rights in the sign 'Café del Mar'. Furthermore, even if the company's representative plays an outstanding role in the promotion and development of the sign, he is not entitled to use its power in his own name (§ 53).

By registering in his own name a trade mark generating confusion with the earlier sign 'Café del Mar' while he was the representative of one of the companies exploiting that sign, and by paying the registration costs with funds from that company, he departed from accepted principles of ethical behaviour or honest commercial and business practices and therefore acted in bad faith (§ 54).

The fact that, for a certain period, the proprietor paid the profits obtained from the exploitation of the trade mark into the accounts of Can Ganguil is not relevant. This is because bad faith must be proven at the time of filing the application and the profits were paid later (§ 55).



12/07/2019, T-772/17, [Café del Mar \(fig.\)](#), EU:T:2019:538, § 39, 53-55



12/07/2019, T-773/17, [Café del Mar \(fig.\)](#), EU:T:2019:536, § 39, 53-55

### **Bad faith – Same overall impression of the signs**

The invalidity applicants and the proprietor had used the figurative sign 'Café del Mar' since 1980 when they opened the music bar 'Café del Mar' in Ibiza (Spain). The sign was also used to distinguish the goods and services provided by various companies that the individual invalidity applicants and the proprietor had incorporated since 1987 (§ 35, 37).

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

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

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



12/07/2019, T-774/17, [C del M \(fig.\)](#), EU:T:2019:535, § 35, 37, 49, 52-53

### **Bad faith – No intention to use**

To hold that bad faith involves conduct that departs from accepted principles of ethical behaviour or honest commercial and business practices, and presupposes a dishonest intention or other sinister motive, would be to interpret bad faith too restrictively. In fact, the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, in particular the essential function of indicating origin, may be sufficient for finding bad faith by the trade mark applicant (12/09/2019, C-104/18 P, STYLO & KOTON (fig.), EU:C:2019:724, § 45-46; 29/01/2020, C-371/18, SKY, EU:C:2020:45, § 74-75) (§ 27).

Accordingly, registration of the contested mark 'TARGET VENTURES' not with the intention to use it but with the sole purpose of strengthening the scope of protection of the proprietor's actually used mark 'TARGET PARTNERS', was inconsistent with the essential function of a trade mark to indicate to consumers the commercial origin of goods and services (§ 25-27, 35-44). In this context, it was irrelevant whether or not the proprietor knew or ought to have known about someone else's prior use of an identical sign, so lack of proof of that knowledge could not have been a reason for dismissing the bad faith claim (§ 28-30, 46).

28/10/2020, T-273/19, [TARGET VENTURES](#), EU:T:2020:510, § 25-30, 35-44, 46

### **Bad faith – Criterion of dishonesty**

The BoA was entitled to rely on the criterion of dishonesty in order to assess the alleged proprietor's bad faith of the contested mark (§ 117).



24/03/2021, T-282/19, [Halloumi χαλλούμι Vermion grill cheese/grill est/grill kase m BELAS PREMIUM GREEK DAIRY SINCE 1927 \(fig.\) / HALLOUMI](#), EU:T:2021:154, § 117

**Bad faith – Repeat filings of a mark – Intention at the time of filing the application – Circumstances of the concrete case – Length of obtained extension of a grace period**

There is no provision in the legislation relating to EU trade marks that prohibits the refiling of an application for registration of a trade mark. Consequently, such a filing cannot, in itself, establish that there was bad faith on the part of the trade mark applicant, unless it is coupled with other relevant evidence which is put forward by the applicant for a declaration of invalidity or by the Office. However, where the applicant admitted, and even submitted, that one of the advantages justifying the filing of the contested mark was based on the fact that it would not have to furnish proof of genuine use of that mark, such conduct cannot be held to be lawful. Rather, it must be held to be contrary to the objectives of Trade mark Regulation, to the principles governing EU trade mark law, and to the rules relating to proof of use (§ 49-55, 70).

Regardless of the length of the extension of a grace period, what matters is the trade mark applicant's intention at the time of filing the application for registration. Although the extensions of the grace periods in respect of the earlier marks are not particularly long, the fact remains that the applicant obtained the desired advantage of not having to prove use of the mark for additional periods of 2 years and 2 months and of almost 8 months in connection with the goods and services covered by the earlier marks (§ 89).

Although there is nothing to prohibit the proprietor of an EU trade mark from refiling that mark, the simple fact that other companies may be using a specific filing strategy does not necessarily make that strategy legal and acceptable. Whether or not such a strategy complies with the Trade mark regulation must be assessed on the basis of the circumstances of the particular case. It depends on whether the applicant intentionally sought to circumvent a fundamental rule of EU trade mark law, namely that relating to proof of use, in order to derive an advantage therefrom to the detriment of the balance of the system resulting from that law, as established by the EU legislature (§ 94).

*21/04/2021, T-663/19, [Monopoly](#), EU:T:2021:211, § 49-55, 70, 89, 94*

**Bad faith – Contractual relationships – Interpretation of agreements – Transfer of rights – Chronology of events – Unregistered earlier right – Concealed act**

The case concerns the bad faith underlying the application for the EUTM 'TORNADO' for boats by one of the parties to an informal partnership. The other party (the invalidity applicant) is the proprietor of a corresponding unregistered sign which he had used and popularised. The EUTM proprietor claimed that the invalidity applicant had transferred his rights in the sign 'TORNADO' to the EUTM proprietor when forming the partnership. The BoA annulled the EUTM registration and the GC dismissed the appeal.

Examining the parties' correspondence, the GC found that use of the sign by the partnership was subject to the payment of royalties to the invalidity applicant, who was therefore considered the proprietor of the rights in that sign. If a transfer of rights was envisaged, it was never formalised (§ 57-64, 68). Moreover, the invalidity applicant was still monitoring the activity of the partnership (§ 65). The chronology of events supported a finding of bad faith since the contested EUTM application was filed shortly before the cessation of the relationship between the parties (§ 69). The fact that the filing of the EUTM was concealed from the invalidity applicant further supports the conclusion that the application for the contested EUTM essentially aimed to 'put up obstacles to the [invalidity applicant's] activities by preventing him from using that mark which, over time, he had made popular in the inflatable boats sector' (§ 71, 73). The fact that the invalidity applicant's rights concerned an unregistered mark is irrelevant to the extent that bad faith does not require the invalidity applicant to be the proprietor of a registered earlier mark (§ 77). The fact that use of this unregistered mark may have stopped after the establishment of the partnership is equally irrelevant: 'Even assuming that the [invalidity applicant] no longer used that sign for the purposes of marketing inflatable boats with his own company, the fact remains that that sign remained his, as he had consented to the use thereof by the [contested EUTM proprietor], in

exchange for royalties paid by the latter, during the period preceding the application for the trade mark' (§ 79).



12/05/2021, T-167/20, [TORNADO \(fig.\)](#), EU:T:2021:257, § 57-65, 68-69, 71, 73, 77, 79

### **Bad faith – Contractual acknowledgement of pre-existing right in the contested sign**

An explicit acknowledgement, in a distribution agreement, of a pre-existing right in the sign shows the EUTM proprietor's knowledge of the existence of such a right (§ 30) and deprives of any logical explanation the EUTM proprietor's claimed belief that he himself had such rights in the sign (§ 38). Such a contractual acknowledgement constitutes – as confirmed by the chronology of events and the commercial logic underlying the filing of the contested mark (§ 62-71) – an absolute indication that the EUTM proprietor made that filing in bad faith (§ 46, 51). The existence of bad faith is not excluded by the fact that the sign has not been used in the EU (§ 39, 40).

17/03/2021, T-853/19, [Earnest Sewn](#), EU:T:2021:145, § 30, 38-40, 46, 62-71

### **Bad faith – Nature of the market – Period of use of identical or similar mark – Chronology of events constitute relevant factors for assessing the presumption of knowledge – Absence of use may be relevant when assessing the existence of dishonest intention**

Given the relatively limited nature of the market for the sale of automobile tyres in Bulgaria and the common origin in China of the tyres, the BoA was entitled to presume that, at the time of filing the application for registration, the applicant had knowledge of the activities of its direct competitor in Bulgaria and, in particular the marketing of tyres made in China under a mark highly similar to the contested mark (§ 45). The evidence provided by the intervener shows only use of the Chinese mark 'Agate' in Bulgaria between 2014 and 2017, that is to say during a period which may appear relatively short. However, the duration of use of a sign is only one of the considerations which may be taken into account to presume knowledge of it for the purposes of assessing bad faith (§ 46). Knowledge can also be established considering the chronology of the events, namely the short period between the filing of the contested mark and its registration on 7 March and 21 June 2017 respectively on the one hand, and the application for coercive measures lodged by the applicant with the Bulgarian customs authorities against the intervener and its distributor on 5 July 2017 and the infringement action filed on 6 July 2017 before the Bulgarian Patent Office against that distributor, on the other (§ 61, 63).

In the context of the assessment of bad faith, it is not the use of the contested mark that is examined, but rather whether the proprietor, at the time of filing the application for registration, intended to make use of the mark (§ 68). The absence of such an intention may be inferred from the complete absence of evidence relating to the commercial activities of the proprietor of the contested mark. Such evidence may be relevant in assessing the commercial logic underlying the filing of the application for registration of the contested mark (§ 69). Considering the circumstances of the case 'there was no commercial logic underlying the application for registration of the contested mark'; the applicant's only activity related to that mark was that of 'hindering others'. Therefore, the applicant 'pursued dishonest purposes' (§ 72-74).

29/09/2021, T-592/20, [Agate / Agate](#), EU:T:2021:633, § 45-46, 61, 63, 68, 72-74

### **Bad faith – Self-contradictory behaviour of the EUTM proprietor over time – Misleading use of the mark – Geographical origin of the goods**

Once the applicant had extended the use of the mark LA IRLANDESA to goods other than butter of Irish origin, Spanish-speaking consumers, who constitute the relevant public, were likely to be

misled as to the geographical origin of those goods, since they had become accustomed over the course of several decades to the contested mark being affixed to butter originating from Ireland. Such conduct is evidence of bad faith inasmuch as it shows that, when filing the application for the contested mark, the applicant intended unfairly to transfer the advantage derived from the association with Ireland to goods not having that geographical origin, in particular after the end of its business relationship with the intervener which supplied it with Irish butter (§ 98).

Judgments and decisions of the Spanish judicial and administrative authorities confirm that the contested mark could be perceived by the relevant public as indicating that the goods to which that mark was affixed were of Irish origin. They also indicate that the use of the contested mark for goods not of Irish origin was controversial as regards its potential deceptive nature; a fact of which the applicant was necessarily aware on the date of the application for registration of that mark and which is therefore capable of supporting the existence of bad faith on the part of the applicant on that date (§ 100).

The Grand Board of Appeal was entitled to rely on the evidence submitted to it, which makes it possible in particular to establish a chronology of events characterising the filing of the application for registration of the contested mark, in order to find that the applicant had adopted a commercial strategy of association with the marks containing the element 'LA IRLANDESA' which were linked to the applicant's former business relationship with the intervener, in order to continue to take advantage of that relationship, which has been terminated, and the marks which were linked to it (§ 101).

[29/06/2022, T-306/20, LA IRLANDESA 1943 \(fig.\), EU:T:2022:404](#)

#### **Bad faith – Decrease in the value of the earlier marks – Pledge marks**

Where the contested mark is similar to earlier pledge marks, the potential effect which the registration of the contested mark might have on the value of the earlier marks and on their attractiveness to potential purchasers of the pledge marks may be an indication of dishonest intentions (§ 63).

From the point of view of a potential purchaser of the earlier pledged marks, the contested mark, which is similar to the earlier marks, might be perceived as being capable of exploiting their distinctive character or their reputation. The value of the pledged marks might thus be reduced by the mere fact of there being another mark in existence which does not form part of the group of pledged marks, but which is similar to those marks. Moreover, the existence of the contested mark risks jeopardising the essential function of the earlier marks, which may have an effect on their value and the intention and readiness of a potential purchaser to purchase them (§ 50-53).

[13/07/2022, T-283/21, Talis / Talis et al., EU:T:2022:438](#)

[13/07/2022, T-284/21, RENČKI HRAM / RENŠKI HRAM \(fig.\) et al., EU:T:2022:439](#)

[13/07/2022, T-286/21, Renški hram / RENŠKI HRAM \(fig.\) et al., EU:T:2022:440](#)

[13/07/2022, T-287/21, Salatina / Salatina \(fig.\) et al., EU:T:2022:441](#)

#### **Bad faith – Links between the parties involved**

The links between all the parties involved, in particular their contractual relationships and their potential economic interdependence, are relevant when assessing the context in which the contested mark was filed (§ 69).

[13/07/2022, T-283/21, Talis / Talis et al., EU:T:2022:438](#)

[13/07/2022, T-284/21, RENČKI HRAM / RENŠKI HRAM \(fig.\) et al., EU:T:2022:439](#)

[13/07/2022, T-286/21, Renški hram / RENŠKI HRAM \(fig.\) et al., EU:T:2022:440](#)

[13/07/2022, T-287/21, Salatina / Salatina \(fig.\) et al., EU:T:2022:441](#)

### **Bad faith – Normal business practice**

Even if filing of the contested mark were part of a normal business practice, this would not be sufficient to rule out the existence of bad faith without an assessment of all the relevant factors specific to the particular case (§ 76).

[13/07/2022, T-283/21, Talis / Talis et al., EU:T:2022:438](#)

[13/07/2022, T-284/21, RENČKI HRAM / RENŠKI HRAM \(fig.\) et al., EU:T:2022:439](#)

[13/07/2022, T-286/21, Renški hram / RENŠKI HRAM \(fig.\) et al., EU:T:2022:440](#)

[13/07/2022, T-287/21, Salatina / Salatina \(fig.\) et al., EU:T:2022:441](#)

### **Bad faith – No legitimate business activity – Successive filings of national trade mark applications every six months – Abusive filing strategy**

The GC confirms [07/07/2016, T-82/14, LUCEO, EU:T:2016:396](#), according to which the concept of bad faith involves conduct which departs from accepted principles of ethical behaviour or honest commercial and business practices. In order to assess whether an applicant is acting in bad faith, it is necessary inter alia to examine whether he intends to use the mark applied for. The intention to prevent the marketing of a product may, in certain circumstances, be an element of bad faith on the part of the applicant. That is in particular the case when it becomes apparent, subsequently, that the latter applied for registration of a EUTM without intending to use it, solely with a view to preventing a third party from entering the market (§ 25-27).

By filing successive applications for registration of national trade marks before the expiry of the six-month period provided for by Article 34(1) EUTMR, which were held to be withdrawn for non-payment of the application fees, the applicant artificially extended the six-month period during which it could claim the priority of the contested mark. Such conduct was part of an abusive filing strategy and cannot be regarded as legitimate business activity. It is contrary to the objectives of the EUTMR (§ 35-37).

[07/09/2022, T-627/21, Monsoon, EU:T:2022:530](#)

### **Bad faith – Intention of the applicant when filing the contested mark – Lack of honest commercial logic – Existence of undue pressure stemming from the sales offers of the contested mark**

The concept of bad faith relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted principles of ethical behaviour or honest commercial and business practices (§ 29).

There is bad faith: if it is apparent from the overall analysis of the case that the applicant knew about the invalidity applicant's business activities and virtually identical sign used by the invalidity applicant, on the day on which the contested mark was filed; if the applicant's intention at the time of filing the application for registration of the contested mark is clear from the content of its sales offers and if from those offers it is possible to identify aspects of undue pressure, in particular due to the unsolicited and repeated nature of those offers, the high prices charged, the unexplained increase in the sales price upon the involvement of a new investor in the invalidity applicant's activities, the reference to short periods of validity of the offers and items already on sale experiencing success; if the evidence of a commercial activity consistent with honest commercial logic has not been adduced (§ 81).

The use of the same stylisation of the mark applied for and invalidity applicant's mark cannot be attributed to chance, when the applicant has acknowledged that the sign constituting the contested mark was inspired by the sign used by the invalidity applicant in its business activities (§ 82).

From the particular circumstances of this case, it is clear that by applying for registration of the contested trade mark, the commercial logic of the applicant seeking that registration was to 'free-ride' on the invalidity applicant's sign's reputation and take advantage of thereof, in particular by selling the contested mark to the invalidity applicant for a significant amount (§ 83).

[19/10/2022, T-466/21, Lio \(fig.\) / El Lio \(fig.\) et al., EU:T:2022:644](#)

See also: [19/10/2022, T-467/21, Lio \(fig.\) / El Lio \(fig.\) et al., EU:T:2022:645](#), § 28, 80-82

### **Bad faith – Chronology of events – No commercial logic – Aim of undermining the interests of third parties – Collusion in *fraudem creditorum***

Bad faith can be characterised by, inter alia, the intention of obtaining an exclusive right for purposes other than those falling within the functions of a trade mark, in particular the essential function of indicating origin. Where it is apparent from the chronology of events that the filings of the contested EUTMs were a key part of a coordinated strategy, between their applicant and the proprietor of earlier national trade marks, to remove those of some value from the proprietor's assets before applying for declaration of insolvency, while ensuring that these trade marks were registered by means of equivalent EUTMs covering the same goods, the contested EUTMs have been filed with the aim of undermining the interests of third parties and not with the aim of supplying the goods concerned to the European market in a climate of fair competition (§ 49-52).

The intention of the proprietor of the EUTMs is dishonest where its aim was to 'hollow out' the earlier national trade mark rights belonging to a company under special administration, prior to any claim by its creditors, while ensuring, by means of equivalent EU trade marks, that they were protected. As that dishonest scheme is incompatible with honest practices and does not show that the applicant had the intention of engaging fairly in competition, it constitutes bad faith (§ 78).

[18/01/2023, T-528/21, MORFAT, EU:T:2023:4](#)

### **Bad faith – Chronology of events – Contractual relationships – Aim of undermining the interests of third parties**

The contractual relationships between the parties prior to the filing of the contested mark, such as a long-standing commercial and contractual relationship, including sponsorship and licence agreements, constitutes an indication of the EUTM applicant's bad faith (§ 65, 77). There is bad faith where, at the date of filing, the EUTM applicant was seeking to prevent the cancellation applicant from carrying on its normal sponsorship activities with the third parties (§ 86).

The fact that the applicant is aware that a third party is using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the contested EUTM is not 'one of the most important' factors to take into consideration when assessing bad faith (§ 81). Dissimilarity of the goods and services does not exclude bad faith (§ 82).

[25/01/2023, T-703/21, Falubaz, EU:T:2023:19](#)

### **Bad faith – No intention of use – Abusive filing strategy**

A strategy that consists of filing successive national trade mark applications for the same sign in order to obtain a blocking position beyond the six-month priority period and to monopolise the sign applied for, is not to be regarded as legitimate commercial conduct, but rather as conduct that runs counter to honest practices in industrial and commercial matters and which is contrary to the objectives of the CTMR; therefore, this strategy is regarded as being in bad faith. Bad faith particularly follows from the fact that there was no intention to use the contested mark. The fact that the applicant was not aware of any identical or similar sign on the priority date or at the time of filing of the contested trade mark cannot call into question the finding of bad faith, where the

existence of an abusive strategy of repeated applications to monopolise a contested sign without any intention to use it has been sufficiently established (§ 50, 55, 58, 74).

[17/01/2024, T-650/22, Athlet, EU:T:2024:11](#)

### **Bad faith – Reputation of the earlier mark outside the EU – No reputation of the earlier mark in the EU**

Reputation of the earlier mark outside the EU may be taken into consideration for the purposes of assessing bad faith. The absence of such reputation in the EU is not relevant to that assessment (§ 40).

[21/02/2024, T-172/23, Hepsiburada, EU:T:2024:105](#)

### **Bad faith – No link between the parties – Knowledge of the earlier marks**

Although the existence of a link or commercial relationship between the parties could have shown that the EUTM proprietor knew of the other party's earlier marks, the absence of such a link or relationship does not mean that there was no such knowledge (§ 55).

[21/02/2024, T-172/23, Hepsiburada, EU:T:2024:105](#)

### **Bad faith – Duty of fair play – Similarity of the signs**

The contested mark was filed in bad faith because (i) there was a reciprocal duty of fair play between the EUTM applicant and the invalidity applicant due to their long-standing and intense commercial cooperation; (ii) the invalidity applicant was the first to use a sign that was similar to the contested mark; and (iii) the EUTM applicant had knowledge of that use (§ 29, 55, 60).

The fact that the word elements in the contested mark and the sign used by the invalidity applicant are different does not alter the similarity arising out of the coincidence in the figurative element, since those word elements are arranged in a very similar way around the figurative element in each of those signs (§ 58).



[06/03/2024, T-59/23 & T-68/23, DEC FLEXIBLE TECHNOLOGIES \(fig.\), EU:T:2024:148](#)

### **Bad faith – Filing of trade mark in third country**

The fact that the EUTM proprietor was the first to file a trade mark that was identical to the contested mark in a third country is not relevant to establish its good faith since these filings were subsequent to the use of a similar sign by the invalidity applicant (§ 51).



[06/03/2024, T-59/23 & T-68/23, DEC FLEXIBLE TECHNOLOGIES \(fig.\), EU:T:2024:148](#)

## **18.2.3 Factors unlikely to indicate the existence of bad faith**

### **No bad faith – Existence of cooperation, correspondence or a distribution agreement**

The existence of cooperation, correspondence or a distribution agreement with the director of the EUTM proprietor does not, on its own, prove bad faith. The mark was not mentioned in the emails, nor is there any information relating to its use with respect to the specific goods or services (§ 90-93, 96). The mention of the company name without any relation to identical or similar goods does

not lead to a contrary conclusion (§ 91). Knowledge of the use of the earlier mark cannot be presumed since use, if any, was limited to a maximum of 16 months (§ 94-95). Nor can there be any assumption of such knowledge inferred from the fact that the directors of the parties knew each other and that a degree of collaboration existed between them when different companies, marks and goods were concerned (§ 97). The identity of the signs does not suffice on its own to prove such knowledge. The sign is a relatively simple combination, consisting of a reference to the moulding sector and the suffix 'pro', a common abbreviation of the word 'professional' (§ 98). Mere knowledge that the sign was used as a company name does not point to a dishonest intention (§ 104). Nor did the invalidity applicant prove that the EUTM proprietor sought to keep it out of the German market (§ 103). The fact that the EUTM proprietor used its mark supports the conclusion that the filing was made in good faith (§ 105).

14/02/2019, T-796/17, [MOULDPRO](#), EU:T:2019:88, § 90-93, 96, 94-95, 97, 98, 103, 104, 105

### **No bad faith – Business relationship with an intermediary who knew of the existence of the mark – Other negligible factors**

The EUTM proprietors were not linked to the applicant and bad faith on the part of the EUTM proprietors cannot be presumed based merely on their business relationship with an intermediary who knew of the existence of the mark EGYPTIAN EARTH (§ 35-36).

The fact that the EUTM proprietors are also proprietors of other marks using the same term in different language versions suggests that the registration of that mark is not artificial in nature or devoid of logic in commercial terms and had a legitimate aim (§ 39-41).

The addition of the distinctive term 'bikor' also suggests a lack of bad faith on the part of the EUTM proprietors when filing the application for the mark (§ 42-43).

16/12/2020, T-438/18, [BIKOR EGYPTIAN EARTH](#), EU:T:2020:630, § 35-36, 42-43

### **No bad faith – Contractual relations – Concealed act**

In the present case, the mere fact that the proprietor of the contested mark has interpreted the provisions of an agreement concluded with the invalidity applicant in its own favour, this does not constitute an indication of bad faith (§ 61).

Although the proprietor had not informed the invalidity applicant that it had filed the contested mark in advance, this was not a concealed act carried out to prevent the invalidity applicant from using the sign. The agreements between the parties had been terminated and were the subject of litigation long before the contested mark was filed. Indeed, the invalidity applicant knew that the proprietor of the contested mark was seeking to protect its interests by any available legal means (§ 73).

14/07/2021, T-75/20, [Nova](#), EU:T:2021:431, § 61, 73

### **No bad faith – 'First-to-file' principle**

The EU trade mark registration system is based on the 'first-to-file' principle, laid down in Article 8(2) EUTMR, according to which a sign may be registered as an EUTM only in so far as this is not precluded by an earlier mark. On the other hand, without prejudice to the possible application of Article 8(4) EUTMR the mere use by a third party of a non-registered mark does not preclude an identical or similar mark from being registered as an EU trade mark for identical or similar goods or services. This rule is qualified, in particular, by Article 52(1)(b) EUTMR, under which an EU trade mark is to be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings, where the applicant acted in bad faith when it filed the application for the trade mark (§ 26-27).

### **No bad faith – Commercial logic of expansion**

Extending the protection of a sign by having it registered as an EUTM is part of the normal business strategy of an undertaking. In that regard, the applicant's argument that the commercial logic underlying the filing of the application for registration is undermined by the fact that the name Gugler was not used as a mark before the date of filing is irrelevant. There is no obligation to use a mark before filing it (§ 44, 45).

The fact of informing or not informing the other party of the application for registration of the contested mark is not capable of altering the EUTM applicant's intention when it filed that application and of calling into question the fact that commercial logic underlay that filing and that it was not carried out in bad faith (§ 40).

The applicant does not put forward any argument capable of establishing that the application for registration of the contested mark did not have any underlying commercial logic for Gugler GmbH or that that application had been made with the intention of obtaining an exclusive right for purposes other than falling within the functions of a trade mark (§ 48).

[13/07/2022, T-147/21, GUGLER \(fig.\) / GUGLER FRANCE, EU:T:2022:444](#)

### **No bad faith – Infringement proceedings**

The bringing of infringement proceedings by the proprietor of a trade mark cannot constitute an act of bad faith or 'bad use' of the contested mark. Furthermore, the invalidity applicant cannot maintain that infringement actions brought six years after the date on which the application for registration of the contested EUTM was filed would be capable of establishing its bad faith at the time the application was filed (§ 70, 71).

[13/07/2022, T-147/21, GUGLER \(fig.\) / GUGLER FRANCE, EU:T:2022:444](#)

### **No bad faith – Knowledge of the previously reputed former mark**

In the absence of surviving reputation in respect of the former trade mark and of current celebrity status in respect of that trade mark's owner (in case the trade mark consists of his name) when the application for registration of the contested mark is filed, the subsequent use of that mark by the applicant is not, in principle, capable of constituting free-riding behaviour indicating bad faith on the part of the applicant (§ 59). That finding cannot be called into question by the fact that the applicant was aware of the past existence and reputation of the former trade mark and its owner. The mere fact that the trade mark applicant knows or ought to know that a third party has, in the past, used a mark identical or similar to the mark applied for is not sufficient to establish the existence of bad faith on the part of that applicant (§ 60).

[06/07/2022, T-250/21, nehera \(fig.\), EU:T:2022:430](#)

### **No bad faith – Lost of right to the former renowned mark**

The applicant cannot be held responsible for the nationalisation of the former trade mark business. The same is true of the lack of protection and use of the former trade mark for almost seven decades as well as the disappearance of that mark's reputation and of its creator's fame. In those circumstances, the fact that the former trade mark's owner was unlawfully or unfairly deprived of his assets is not capable of establishing bad faith on the part of the applicant (§ 76).

[06/07/2022, T-250/21, nehera \(fig.\), EU:T:2022:430](#)

### **Revival and reuse of a previously renowned former mark by a third party – Not an act of bad faith in specific circumstances**

When the contested mark was filed, the earlier trade mark and the name of its owner (the same as the trade mark) were forgotten by the relevant public, and the applicant himself devoted considerable effort, time and money to revive the mark and to make known the history of its owner and of his business. Far from merely having exploited in a parasitic way the past reputation of the former trade mark and the name of its owner, the applicant made his own commercial efforts in order to revive the image of the former trade mark and thus, at his own expense, to restore that reputation. In those circumstances, the mere fact of having referred, for the purposes of promoting the contested mark, to the historic image of the owner of the former trade mark and to the former trade mark as such does not appear to be contrary to honest practices in industrial or commercial matters (§ 66).

It cannot be ruled out that, in certain specific circumstances, reuse by a third party of a previously renowned former mark or of the name of a previously famous person may give a false impression of continuity or of inheritance with that former mark or with that person. That could be the case, in particular, where the trade mark applicant presents itself to the relevant public as the legal or economic successor of the holder of the former mark, whereas there is no continuity or inheritance relationship between the holder of the former mark and the trade mark applicant. Such a circumstance could be taken into account in order to establish, where appropriate, bad faith on the part of the trade mark applicant (§ 68). The applicant did not claim a family tie with the owner of the former trade mark nor he presented himself as his heir and the legal successor or of his business. Moreover, 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. Therefore, it does not appear that the applicant deliberately sought to establish a false impression of continuity or inheritance between his undertaking and that of the owner of the former reputed trade mark (§ 70).

[06/07/2022, T-250/21, \*nehera \(fig.\)\*, EU:T:2022:430](#)

### **No bad faith – Opposition proceedings launched by the EUTM proprietor**

Opposing the registration of a later trade mark is a mere exercising of the exclusive right arising from the EUTM. Such conduct cannot, in itself, prove dishonest intention on the part of the EUTM proprietor (§ 49).

[13/09/2023, T-552/22, \*SpaClubMatahari / salon matahari \(fig.\) et al.\*, EU:T:2023:544](#)

### **No bad faith – No surviving reputation of the former renowned mark**

Evidence filed by the invalidity applicants admittedly tends to confirm that the former Czechoslovak trade mark and the name of Mr Jan Nehera enjoyed a certain reputation or celebrity status in Czechoslovakia in the 1930s and 1940s, which is, however, insufficient to prove that seven decades later, on the date of filing of the contested mark, such reputation or celebrity status persisted (§ 30-31).

[20/03/2024, T-334/23, T-335/23, T-336/23 & T-337/23, \*nehera \(fig.\)\*, EU:T:2024:192](#)

## **18.3 PROOF OF BAD FAITH**

### **Bad faith – Means of evidence**

Bad faith can be proved on the basis of sworn written statements of the invalidity applicant's lawyers, acting as independent third parties (§ 94-99), or an email exchange between the lawyers of both parties establishing an attempt to obtain a licence agreement prior to the application of

registration (§ 84-88). The use of these communications in the context of invalidity proceedings is not precluded, since they do not constitute a correspondence between lawyer and client that might be qualified as confidential (§ 102-103).

23/05/2019, T-3/18 and T-4/18, [ANN TAYLOR / ANNTAYLOR et al.](#), EU:T:2019:357, § 84-88, 102-103

#### **Bad faith – Burden of proof**

It is for the applicant of a declaration of invalidity under Article 59(1)(b) EUTMR to establish the circumstances indicating that the proprietor of an EU trade mark was acting in bad faith. There is a presumption of good faith until proof to the contrary is adduced (§ 33).

It was not mandatory for the invalidity applicant to invoke and substantiate any prior right in the contested mark. Given that the invalidity applicant had based its arguments relating to bad faith on the alleged existence of prior exclusive interests and rights in the contested sign, the Office correctly examined whether or not those arguments were well-founded (§ 73).

16/06/2021, T-678/19, [Enterosgel \(fig.\)](#), EU:T:2021:364, § 33, 73

#### **No bad faith – Burden of proof**

It is for the invalidity applicant to prove the legal basis for the parties' business relationship, in particular by specifying the legal grounds that qualify their business relationship and establish the rights and obligations of the parties, including a duty of loyalty and the right to use the contested mark (§ 35, 37).

[06/09/2023, T-312/22, RED BRAND CHICKEN \(fig.\), EU:T:2023:514](#)

[06/09/2023, T-316/22, BLUE BRAND CHICKEN \(fig.\), EU:T:2023:515](#)

## **18.4 RELATION TO OTHER EUTMR PROVISIONS**

[No key points available yet.]

## **18.5 EXTENT OF INVALIDITY**

#### **Bad faith – Extent of invalidity**

Knowledge on the part of an EUTM applicant of the prior use made of a similar sign, corresponding to a rare first name of Arabic origin, can be deduced from the reputation acquired by this sign in a third country in adjacent economic fields. Bad faith does not require use, by a third party, of an identical or similar sign within the EU (§ 31-35, 43-44).

The scope of the invalidity (for all goods and services or parts of them) may depend on whether the EUTM applicant's intention was: to harm a particular third party, in which case it is not possible to distinguish between the EUTM applicant's motives and the registration should therefore be cancelled as a whole, or to misuse the registration system otherwise than by harming one specific operator, in which case the EUTM applicant's intention may be partly legitimate and partly abusive, therefore justifying the conclusion that the ground for invalidity exists only in respect of some of the goods or services for which the EUTM has been registered (§ 51, 54-55).

28/04/2021, T-311/20, [Choumicha Saveurs \(fig.\)](#), EU:T:2021:219, 31-38, 43-44, 51, 54-55

#### **Bad faith – Extent of invalidity**

Where the ground for invalidity exists in respect of only some of the goods or services for which the contested mark is sought to be registered, the trade mark is to be declared invalid as regards those goods or services only (29/01/2020, C-371/18, SKY, EU:C:2020:45, § 80). Therefore, upholding the action on the basis of bad faith does not automatically mean that the mark is invalid in its entirety (§ 71).



09/06/2021, T-396/20, [RIVIERA AIRPORTS \(fig.\)](#), EU:T:2021:326, § 71



09/06/2021, T-398/20, [RIVIERA AIRPORT \(fig.\)](#), EU:T:2021:327, § 71

## CHAPTER III – RELATIVE GROUNDS FOR REFUSAL / INVALIDITY

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### 1 ARTICLES 8(1)(a), 60(1)(a) EUTMR – IDENTICAL SIGNS / G&S

#### Identical signs – Identical goods and services in part – Action manifestly lacking any foundation in law

As the identity of the signs is not disputed, the BoA was right to find that the opposition had to be upheld in respect of the goods that it had found to be identical (§ 33).

The whole action is dismissed as manifestly lacking any foundation in law (§ 83).

*21/05/2021, T-158/20, [Breeze / Breeze](#), EU:T:2021:288, § 33, 83*

#### Interrelation between Articles 8(1)(a) and 8(1)(b) EUTMR

Article 8(1) EUTMR refers to two distinct sets of conditions. Although the conditions for the application of Article 8(1)(b) EUTMR – inasmuch as they relate both to the identity and to the similarity of the marks at issue – include the conditions for the application of Article 8(1)(a) EUTMR (which relates only to the identity of those marks), the reverse is not true. The fact that Article 46(1) EUTMR and Article 2(2)(c) EUTMDR refer to paragraph 1 of Article 8 EUTMR, without distinguishing the conditions of that paragraph, which are set out in subparagraphs (a) and (b) thereof respectively, cannot be interpreted as demonstrating the existence of a single ground of opposition (§ 35, 36).

*01/02/2023, T-349/22, [Hacker space / Hacker-pschorr et al.](#), EU:T:2023:31*

### 2 ARTICLES 8(1)(b), 60(1)(a) EUTMR – LIKELIHOOD OF CONFUSION

#### 2.1 RELEVANT PUBLIC AND DEGREE OF ATTENTION

##### 2.1.1 Relevant part of the public

#### Consideration of the list of goods and services as protected by the mark, not as marketed for the determination of the relevant public

The rights conferred by the mark extend to the goods and services for which it is protected. When determining the relevant public, the list of goods and services protected by the mark has to be taken into account rather than products that are actually marketed under the mark in question. As long as the list has not been amended, the commercial decisions taken by the proprietor of the mark do not influence the definition of the relevant public (§ 39, 40).

*20/06/2019, T-389/18, [WKU / WKA et al.](#), EU:T:2019:438, § 39, 40*

#### Limitation of the assessment to part of the relevant public

The BoA may take only part of the public in the EU into account insofar as it is sufficient to refuse a trade mark registration on a relative ground under Article 8(1)(b) EUTMR (§ 21).

*11/02/2020, T-732/18, [charantea / CHARITÉ \(fig.\)](#), EU:T:2020:43, § 21*

*11/02/2020, T-733/18, [charantea \(fig.\) / CHARITÉ \(fig.\)](#), EU:T:2020:42, § 21*

#### Consideration of the part of the public with the lowest level of attention

When a section of the relevant public consists of professionals with a higher level of attention and another section of the relevant public consists of reasonably observant and circumspect average consumers, the public with the lowest level of attention must be taken into consideration for assessing LOC (§ 36).

*25/06/2020, T-114/19, [B \(fig.\) / b \(fig.\)](#), EU:T:2020:286, § 36.*

### **Necessity to base the assessment of LOC on the perception of the relevant public – Action manifestly well founded**

The assessment of the LOC must be based on the perception of the relevant public and the principles governing the definition of the relevant public must be applied to the concrete case (24/05/2011, T-408/09, *ancotel*, EU:T:2011:241, § 29) (§ 34, 39, 43). The BoA was wrong to assess the LOC on the basis of a comparison of the signs in the abstract without identifying the relevant public, on the ground that that information did not influence the decision (§ 39-41). The action is manifestly well founded since the BoA did not identify in the contested decision the relevant public and its level of attention for the purposes of assessing the LOC (§ 43-45).

*16/06/2021, T-420/20, [Gt8 / GT \(fig.\)](#), EU:T:2021:379, § 43, 39-41, 43-45*

*16/06/2021, T-421/20, [Gt3 / GT \(fig.\)](#), EU:T:2021:377, § 43, 39-41, 43-45*

*16/06/2021, T-422/20, [Gt5 / GT \(fig.\)](#), EU:T:2021:378, § 43, 39-41, 43-45*

*16/06/2021, T-423/20, [Gt9 / GT \(fig.\)](#), EU:T:2021:376, § 43, 39-41, 43-45*

*16/06/2021, T-558/20, [Gt10 / GT \(fig.\)](#), EU:T:2021:38, § 43, 39-41, 43-45*

### **Relevant public – Financial services – Software**

In view of the goods and services of the contested sign (software in the field of banking and financial services in Class 9 and specific financial services in Class 36), the BoA erred in finding that the goods and services concerned were directed at the ‘public at large’ for the purposes of assessing a likelihood for confusion (§ 22). Although the services of the earlier mark (Class 36) are worded in more general terms and are intended for both the public at large and a professional public, the public likely to use both the services covered by the earlier mark and the goods or services covered by the mark applied for is solely the public composed of specialised professionals. Nevertheless, because the BoA also assessed a likelihood of confusion by reference to a professional public with a high degree of attention, that examination is not vitiated by any defect (§ 25).

*04/05/2022, T-237/21, [FIS \(fig.\) / Ifis et al.](#), EU:T:2022:267, § 22, 25*

### **Relevant public – Definition of the average consumer**

‘Average consumer’ cannot be understood as only the consumer who is part of the ‘general public’, but the consumer who is part of the public typically targeted by the goods and services in question. Thus, the ‘average consumer’ may be a professional, if the goods and services in question are typically intended for such a public (§ 24).

*[13/07/2022, T-251/21, \[Tigercat / CAT \\(fig.\\) et al.\]\(#\), EU:T:2022:437](#)*

### **No LOC – Limitation of the assessment to part of the relevant public**

Although the opposition is based on an EUTM, the BoA could, for reasons of procedural economy, restrict the assessment of LOC to the relevant public in Spain (§ 23).

*[14/12/2022, T-18/22, \[NEMPORT LIMAN İŞLETMELERİ \\(fig.\\) / Newport et al.\]\(#\), EU:T:2022:815](#)*

### **Relevant public – Level of attention – Persons taking decisions when purchasing goods and services**

In respect of the goods and services related to cyber security, it cannot be ruled out that persons other than IT professionals or IT experts may be led to take decisions when purchasing them, such as the financial directors or managing directors of the respective undertakings. That public's level of attention as regards those goods and services will necessarily be higher than that of the general public, without being as high as possible (§ 26-27, 36).

[07/06/2023, T-227/22, Cylus / Cylance, EU:T:2023:306](#)

### **Relevant public – Demonstration of the perception of a sign**

No analysis intended to describe the relevant public's approach to a sign can claim to be exhaustive in the sense that all members of that public will adopt an identical approach, without exception. Nevertheless, it can be demonstrated, with supporting evidence, that at least a large majority of them would perceive a sign in a certain manner. This accordingly means that the remaining part of that relevant public, which would perceive that sign differently, would be negligible (§ 41-44).

[07/06/2023, T-227/22, Cylus / Cylance, EU:T:2023:306](#)

### **Perception of the sign – Irrelevance of the sign's transcription within EUIPO's services**

The transcription of the mark applied for within EUIPO's services in the context of the application for registration and the proceedings before the OD and the BoA are irrelevant for the purposes of determining the perception of the signs at issue by the relevant public (§ 52). The similarity of the marks at issue must be assessed in relation to how the relevant public perceives those marks (§ 53).

[12/07/2023, T-487/22, Device of two black interrelated geometrical shapes \(fig.\) / mó \(fig.\) et al., EU:T:2023:391](#)

### **Irrelevance of actual use of the mark for the determination of the relevant public and the comparison of goods and services.**

For the purposes of assessing the existence of a LOC and, in particular, defining the relevant public and comparing the goods and services, only the description of the goods for which registration of the mark has been requested is relevant, the use, actual or intended, of this mark cannot be taken into account (§ 24).

[29/11/2023, T-12/23, DEVICE OF LIGHTNING \(fig.\) / DEVICE OF LIGHTNING \(fig.\) et al., EU:T:2023:768](#)

### **LOC – Relevant part of the public**

It is not necessary for the LOC to be found in a significant or representative part of the EU. It is sufficient that the part of the relevant public taken into account in order to assess whether there is LOC is not minimal or negligible (§ 40).

[20/03/2024, T-540/23, PATAPOUF / PATA NEGRA et al., EU:T:2024:193](#)

## **2.1.2 Knowledge of languages**

### **Limitation of the assessment to part of the relevant public with a specific linguistic profile**

It is only appropriate to limit the assessment of the LOC to part of the relevant public with a specific linguistic profile where the word elements of the marks belong to the vocabulary of a particular language or where only part of the relevant public, defined by reference to the spoken language, attributes a particular meaning to it (§ 29).



**zümex**

28/04/2021, T-310/20, [JUMEX \(fig.\)-Zumex \(fig.\) et al.](#), EU:T:2021:227, § 29

### Relevant public – Bulgarian consumers – Capacity of reading Latin characters

At least a large proportion of Bulgarian consumers are capable of reading Latin characters (23/10/2017, T-441/16, *SeboCalm / Sebotherm*, EU:T:2017:747, § 67; 07/02/2018, T-793/16, *Boxes [packaging]*, EU:T:2018:72, § 53-56) (§ 53).

25/11/2020, T-874/19, [Flaming forties / 40 FLAMING FRUITS \(fig.\)](#), EU:T:2020:563, § 36-38, 40, 42, § 53

### Relevant public – International registration of the earlier trade mark that covers the EU

The relevant territory for assessing the linguistic profile of the relevant public is the entire EU because the international registration of the earlier trade mark covers the EU. Therefore, it is not appropriate to restrict the relevant public to the Turkish-speaking public located in the EU. The absence of a LOC on the part of that public cannot rule out the possibility that a LOC may exist for the non-Turkish speaking public in the EU (§ 23).



20/10/2021, T-559/20, [PINAR Süzme Peynir \(fig.\) / Süzme Peynir \(fig.\)](#), EU:T:2021:713, § 23



20/10/2021, T-560/20, [PINAR Tam kıvamında Süzme Peynir Yumusacık ve Leziz \(fig.\) / Süzme Peynir \(fig.\)](#), EU:T:2021:714, § 23

### Relevant public's knowledge of a language other than its mother tongue – Burden of proof

Regarding the applicant's claim that the word 'skin' is a basic English word understood by the relevant public that should be excluded from the comparison of the signs on account of its descriptive (and therefore not distinctive) character, it is clear that no analysis intended to describe the relevant public's approach to a sign can be exhaustive to the effect that all the members of that public will adopt an identical approach without exception. In those circumstances, it is for the applicant to demonstrate, with corroborating evidence, that the analysis carried out by the BoA is incorrect in respect of a significant part of that public (19/04/2013, T-537/11, *Snickers*, EU:T:2013:207, § 26) (§ 65).

02/03/2022, T-715/20, [Skinovea / Skinoren et al.](#), EU:T:2022:101, § 65

### Relevant public – Likelihood of confusion

The applicant's general assertion that, in essence, the goods in question are neither identical nor partially similar to the goods covered by the earlier mark is a blanket statement that has not been substantiated or proved (§ 42). The overall impression of each of the conflicting signs is dominated by the fact that the first four letters of the contested mark, representing the sequence

of letters 'х', 'о', 'з' and 'я' in standard letters of the Cyrillic script, are identical to those of the earlier mark and appear at the beginning of both signs in the same order (§ 54). There is a LOC for the Russian-speaking public in Germany (§ 32, 105).

**ХОЗЯЮШКА** [23/02/2022, T-184/21, Хозяин / Хозяюшка \(fig.\), EU:T:2022:88, § 32, 42, 54, 105](#)

**ХОЗЯЮШКА** [23/02/2022, T-185/21, Хозяйка / Хозяюшка, EU:T:2022:89, § 30, 40, 52, 101](#)

### **Relevant public's knowledge of a language other than its mother tongue – Basic English words**

Knowledge of a foreign language cannot, in general, be assumed. However, it is apparent from the case-law that many consumers in the European Union know basic English vocabulary, but not other terms or meanings of terms which cannot be considered part of that basic vocabulary. It is not obvious in the present case that the word 'quest' is part of basic English vocabulary. Moreover, the applicant has not provided any evidence to establish that this is the case (§ 49).

It is difficult to establish with certainty how the average consumer will pronounce a word from a foreign language in his or her own language, moreover as it is in the present case, when the element does not have any specific meaning for the relevant public with regard to the goods at issue (§ 94).

[06/04/2022, T-516/20, Quest 9 / Quex, EU:T:2022:227, § 49, 94](#)

### **Relevant public's knowledge of a language other than its mother tongue – Basic English words**

The fact that 'nutrition' is an English word does not give rise to a presumption that the meaning of its abbreviation 'nutri' will be understood by the Polish-speaking general public, since the Polish consumer's knowledge of English is not a well-known fact (§ 82). Similarly, although it has also been accepted that many consumers in the European Union know basic English vocabulary, the term 'nutrition', to which the abbreviation 'nutri' refers, cannot be considered to be part of the basic vocabulary in English (§ 84).

[06/04/2022, T-370/21, Nutrifem agnubalance / Nutriben, EU:T:2022:215, § 82, 84](#)

### **Basic English words – Understanding of the word 'well'**

The relevant public consisting of health professionals is able to understand the meaning of the word 'well' since those professionals have, in general, a good knowledge of English and can, in any event, easily understand the meaning of certain words which are very common in everyday language. Consumers who are part of the general public and have a basic linguistic knowledge of English would understand the word 'well' as referring to the concept of 'well-being' in relation to goods concerning a person's physical well-being (§ 30, 31).

[21/12/2022, T-644/21, WellBe PHARMACEUTICALS \(fig.\) / Well and well, EU:T:2022:847](#)

### **Relevant public's knowledge of a language other than its mother tongue**

As knowledge of a foreign language cannot, in general, be assumed, the Applicant cannot rely, in the absence of evidence establishing a certain language proficiency, on the fact that the relevant public will understand a foreign language (§ 29, 51).

[08/02/2023, T-24/22, Loulou studio / Lulu's et al., EU:T:2023:54](#)

## **LOC – Distinctive character of the elements – Relevant public’s knowledge of English**

Taken as a whole, the term ‘unicskin’ is a fanciful term which does not exist as such either in English or in Spanish. This would be the case even if the word ‘skin’ in English were understood by the relevant public, in the present case in the territory of Spain, as meaning ‘skin’, and the element ‘unic’ were understood by that same public as referring to the term ‘unique’. The segmentation of that word into two separate elements, namely ‘unic’ and ‘skin’, and the association of that first element with the word ‘unique’ and the translation of that second element from English into Spanish requires some reflection. It has a normal degree of distinctiveness (§ 41, 43).

The Spanish public has a low degree of understanding of English. Therefore, a non-negligible part of the relevant Spanish-speaking public will not understand the meaning of the word ‘skin’ or, at the very least, will not identify that word within the signs at issue (§ 62). A part of the relevant Spanish-speaking public will understand the term ‘unic’ in the earlier mark as referring to the word ‘unique’ on account of the similarity between that term and its Spanish translation (‘único’). For the same reason, that part of the relevant public will also understand the term ‘uni’ in the mark applied for as referring to the word ‘one’ (‘un’ or ‘uno’ in Spanish). Unlike the element ‘uni’, which refers to the concept of oneness, the element ‘unic’ could also refer to the concept of uniqueness. However, the fact remains that those two concepts are similar (§ 64).



[08/02/2023, T-787/21, UNISKIN by Dr. Søren Frankild \(fig.\) / UNICSKIN YOUR EFFECTIVE SOLUTION \(fig.\) et al., EU:T:2023:56](#)

## **Relevant public’s knowledge of a language other than its mother tongue**

Understanding of a foreign language by the relevant public may not, in general, be presumed, but must be proven with evidence (§ 49).

[26/07/2023, T-109/22, frutania \(fig.\) / Frutaria. \(fig.\) et al., EU:T:2023:423](#)

## **Relevant public’s knowledge of a language other than its mother tongue**

Insofar as the applicant does not provide any argument or evidence of its own to demonstrate the allegedly descriptive character of a word element, it cannot be presumed that English words, apart from certain words forming part of the basic vocabulary of that language, are widely known in the EU (§ 79-80).

[13/09/2023, T-488/22, KAUFDAAS ONLINE \(fig.\) / KAUFDAAS et al., EU:T:2023:537](#)

## **Understanding of a term – Scientific term – Inclusion in a dictionary**

Even though the inclusion of a word in a dictionary is the expression of a fair amount of recognition on the part of the public, the mere presence of a term in a general and non-specialised French dictionary does not mean that the relevant public can be assumed to automatically recognise that term. Accordingly, given that the parties do not dispute that the word ‘biome’ is a specific scientific term, a significant part of the general public will not understand the meaning of that term (§ 64).

[13/09/2023, T-328/22, EST. KORRES 1996 HYDRA-BIOME \(fig.\) / Hydrabio et al., EU:T:2023:533](#)

## **Knowledge of the Greek alphabet in the EU**

Except for Greece and Cyprus, most of the consumers in the EU do not know the Greek alphabet and only a category of erudite consumers knows it (§ 40).

[13/09/2023, T-473/22, LAAVA \(fig.\) / Lav \(fig.\) et al., EU:T:2023:543](#)

### **Relevant public's knowledge of English – Burden of proof**

The understanding of a foreign language may not, in general, be presumed. The Spanish and French public's knowledge of English is not a well-known fact. Therefore, it was for the EUTM applicant to provide evidence of the relevant public's knowledge of a language other than its mother tongue (§ 45-46).

[15/11/2023, T-321/22, TIFFANY CRUNCH N CREAM / CRUNCH \(fig.\) et al., EU:T:2023:715](#)

### **LOC – Comparison of the signs – Non-basic English term**

If the comparison of the marks carried out by the Board of Appeal in relation to the non-English-speaking public does not show an error of assessment, the GC does not have to compare the marks in relation to the relevant English-speaking public (§ 19).

The mere fact that the term 'dream' is used in countless English songs and also in advertising campaigns or English speeches does not in itself mean that the relevant non-English-speaking public understands its meaning (§ 51).

 Dreamer

[13/12/2023, T-608/22, Dreamer \(fig.\) / DREAMS et al., EU:T:2023:797](#)

### **Relevant public's knowledge of a language other than its mother tongue – Non-basic French term**

It cannot be presumed that French terms are widely known in the EU, with the exception of certain words belonging to the elementary vocabulary of that language. This is not the case of the French word 'pôle', which is seen as a fantasy term by the Spanish public (§ 71-72, 77).

[17/01/2024, T-61/23, BIOPÔLE / AGUA BIOPOLAR et al., EU:T:2024:10](#)

### **Relevant public's knowledge of a language other than its mother tongue – Non-basic English term**

Knowledge of a foreign language may exceptionally be regarded as a well-known fact and must, as to the remainder, be claimed and proved by the interested party. While it is true that the German public has a command of basic English vocabulary, it has not been demonstrated that the relevant German public would recognise the English term 'savage' in the Spanish word 'salvaje' nor that 'savage' is part of basic English vocabulary (§ 111-115).

[24/01/2024, T-55/23, SALVAJE \(fig.\) / SALVANA, EU:T:2024:30](#)

### **LOC – Knowledge of foreign languages**

As regards the argument that more than half of the EU population speaks foreign languages, including principally English, French, German, Spanish and Italian, it should be borne in mind that knowledge of a foreign language cannot be presumed (§ 64). The argument according to which a word is ubiquitous in the EU and that its equivalent in each language has an identical or similar phonetic appearance must be substantiated, as this fact is not a well-known fact (§ 66).

[07/02/2024, T-101/23, Buffet \(fig.\) / Buff et al., EU:T:2024:65](#)

## 2.1.3 Level of attention

### 2.1.3.1 Level of attention – average (examples)

#### Mass consumption goods – Average degree of attention

The goods in Classes 18 and 25 are mass consumption goods, frequently purchased and used by the average consumer. The degree of attention of the relevant public is not higher than average since the goods in question are not costly or rare and no specific knowledge is required for their purchase (20/10/2009, T-307/08, 4 OUT Living, EU:T:2009:409, § 21) (§ 26-28).

15/07/2020, T-371/19, [FAKEDUCK \(fig.\) / Save the duck \(fig.\) et al.](#), EU:T:2020:339, § 26-28

#### Average level of attention – Non-alcoholic beverages

The level of attention for *non-alcoholic beverages* in Class 32 is average, as it is neither particularly low nor particularly high (§ 22).

23/02/2022, T-198/21, [Code-x / Cody's \(fig.\) et al.](#), EU:T:2022:83, § 22

#### Retail and wholesale services – Relevant public – Average level of attention

The retail and wholesale services, which relate to a wide variety of goods, primarily target manufacturers of goods whose sales are to be promoted in this way. The level of attention of that specialised public is average. In addition to the specialised public, the relevant public also includes the recipients of those services, who are intended to be encouraged by those services to consume the goods in question; that is to say, ordinary consumers, who form part of the general public and whose level of attention is, as a general rule, average (§ 28).

13/09/2023, T-488/22, [KAUFDAS ONLINE \(fig.\) / KAUFLAND et al.](#), EU:T:2023:537

#### Fibre-optic cables – Average level of attention

The relevant public with regard to some types of cables, including *fibre-optic cables* in Class 9, consists both of the general public and of professionals, that will have an average level of attention. These goods are rather basic items of equipment that may also be purchased by the general public, in particular, for domestic purposes at relatively cheap prices, unlike installations and apparatus of a highly specialised nature. That is *a fortiori* the case in respect of the part of that public that consists of professionals, since professionals are likely to use the goods in question frequently, even daily (§ 33-35).

24/01/2024, T-636/22, [labkable Solutions for cables \(fig.\) / LAPP KABEL STUTTGART \(fig.\) et al.](#), EU:T:2024:24

### 2.1.3.2 Level of attention – high (examples)

#### Computer including various software goods – Smart phones – High level of attention

The level of attention of the average consumer from the general public in relation to *computers*, including various software goods and computer hardware goods, and *smart phones; mobile phones; wearable smart phones* in Class 9, is higher than in relation to everyday consumer goods, without, however, being particularly high (§ 35-36, 38).

18/11/2020, T-21/20, [K7 / K7](#), EU:T:2020:550, § 35-36, 38

#### Advertising; business management; business administration – Higher level of attention

*Advertising; business management; business administration* services in Class 35 are aimed at a professional public displaying a higher level of attentiveness (19/05/2015, T-607/13, 42 VODKA JEMNÁ VODKA VYRÁBĚNÁ JEDINEČNOU TECHNOLOGIÍ 42 % vol. (fig.) / 42 BELOW et al., EU:T:2015:292, § 33) (§ 38-40).

09/06/2021, T-266/20, [CCA CHARTERED CONTROLLER ANALYST CERTIFICATE \(fig.\) / CFA institute \(fig.\) et al.](#), EU:T:2021:342, § 38-40

### **Training services – High level of attention**

The level of attention of the relevant public with regard to *training services* in Class 41 is high: these services are aimed at expanding knowledge and developing skills, usually through a commitment in terms of time and resources on the part of the relevant public; they do not satisfy a current or recurring need, but a personal or leisure interest (§ 35).

09/12/2020, T-819/19, [BIM READY \(fig.\) / BIM freelance \(fig.\)](#), EU:T:2020:596, § 35

### **Education and training services – High level of attention**

Although the education and training services in Class 41, in general, are sometimes expensive, they may also be offered at lower prices. Furthermore, those services do not necessarily entail long-term commitments. Likewise, even though the services are not everyday consumer services, the acquisition of those services is not, as a matter of course, preceded by a long process of reflection. For those reasons, the Court has held that a 'heightened' level of attention on the part of the general public cannot be presumed for those services (24/09/2019, T-497/18, IAK (fig.) / IAK - Institut für angewandte Kreativität, EU:T:2019:689, § 32-33) (§ 28).

On the other hand, training services in Class 41 are generally aimed at expanding knowledge and developing skills, usually through a commitment of time and resources on the part of the relevant public. According to that part of the case-law, those services do not satisfy a current or recurring need but a personal or leisure interest. In principle, the general public will use them to acquire knowledge and skills for professional and functional retraining or to develop specific technical expertise. For those reasons, the Court has held that the level of attention of the average consumer in the relevant public is 'high' for those services (09/12/2020, T-819/19, [bim ready \(fig.\) / BIM freelance \(fig.\)](#), EU:T:2020:596, § 35) (§ 29).

21/12/2021, T-369/20, [Cefa certified european financial analyst / Cfa et al.](#), EU:T:2021:921, § 29

### **Education/training services addressed to a specific field – High level of attention**

Where *education/training services* are addressed to a specific field, the level of attention must be considered high for both the general public and professionals (13/10/2009, T-146/08, Redrock, EU:T:2009:398, § 45) (§ 33-35, 45-48, 50).

09/06/2021, T-266/20, [CCA CHARTERED CONTROLLER ANALYST CERTIFICATE \(fig.\) / CFA institute \(fig.\) et al.](#), EU:T:2021:342, § 33-35, 45-48, 50

### **Education and training services relating to financial analysis – High level of attention**

As regards training services in Class 41 that are specific in nature since they concern the field of financial analysis, consumers interested in those services, even if they are part of the general public, will pay particular attention to them when choosing which programmes they prefer, usually after examining and comparing the educational offers available (09/06/2021, T-266/20, [CCA CHARTERED CONTROLLER ANALYST CERTIFICATE \(fig.\) / CFA institute \(fig.\) et al.](#), EU:T:2021:342). Since consumers do not use financial training services on a daily basis, their level of attention cannot be equivalent to that which they display with regard to everyday

consumer services. It must be considered to be higher (09/06/2021, T-266/20, CCA CHARTERED CONTROLLER ANALYST CERTIFICATE (fig.) / CFA institute (fig.) et al., EU:T:2021:342, § 47-48) (§ 30-31).

For those reasons, the general public's level of attention is high (and not average as stated by the BoA) for the education and training services in Class 41 at issue (§ 32-35). That error vitiated all of the BoA's reasoning relating to the global assessment of any LOC (§ 36). Therefore, the contested decision is annulled (§ 49).

21/12/2021, T-369/20, [Cefa certified european financial analyst / Cfa et al.](#), EU:T:2021:921, § 30-31, 49

### **Air, rail transport or maritime services – Above-average level of attention**

Although it is true that the general public does not necessarily pay an above-average level of attention to the purchase of certain air, rail transport or maritime services, in relation to the chartering of merchant ships, chartering [brokerage of ship cargoes], transport and freight brokerage services, (transport of goods by ship), the general public will pay an enhanced level of attention comparable to that of professionals (§ 23).

03/04/2019, T-468/18, [CONDOR SERVICE, NSC \(fig.\) / ibercóndor transportes internacionales y aduanas \(fig.\) et al.](#), EU:T:2019:214, § 23

### **Pharmaceutical, medical and veterinary fields – Above-average level of attention**

In the pharmaceutical, medical and veterinary fields, the general public, much like specialists, display a heightened degree of attentiveness, even in respect of goods without a prescription, since they affect, to a greater or lesser degree, health. Similarly, dietetic substances adapted for medical use may be regarded as products to which a higher than average level of attention is paid (§ 26).

28/11/2019, T-642/18, [DermoFaes Atopimed / Dermowas](#), EU:T:2019:819, § 26

28/11/2019, T-643/18, [DermoFaes / Dermowas](#), EU:T:2019:818, § 26

28/11/2019, T-644/18, [DermoFaes AtopiDerm / Dermowas](#), EU:T:2019:817, § 26

### **Degree of attention of the relevant public – Goods that may have important consequences on consumers' health – Above-average level of attention**

The general public's degree of attention in respect of the goods that may have important consequences on consumers' health is above average (§ 26).

02/03/2022, T-192/21, [Meta / Metalgial](#), EU:T:2022:105, § 26

### **Degree of attention of the relevant public – Goods and services of financial nature – High level of attention**

Consumers of financial and banking services and of related goods select their banking institution carefully and after first carrying out research of the market and the offers available on it. Therefore, their level of attention will be above average. Moreover, it is the level of attention that is paid by consumers when purchasing the goods and services that is relevant for the assessment of a likelihood of confusion and not the level of attention when using them on a daily basis (§ 66-67).

02/03/2022, T-125/21, [Eurobic / BANCO BiG BANCO DE INVESTIMENTO GLOBAL \(fig.\) et al.](#), EU:T:2022:102, § 66-67

### **Foods for babies – Above-average level of attention**

Although *foods for babies especially milk powder for babies* and *mineral nutritional additives* do not, as such, constitute pharmaceutical products, they fall within the 'paramedical' field, i.e. they are linked, in the broad sense, to health. The purchase of *mineral nutritional additives* differs from that of other foods, since it is driven by an effort to improve health and the consumer's level of attention will be higher than average. *Foods for babies especially milk powder for babies* is necessary for the well-being and health of children, and moreover those of a young age and the level of attention is at least above average, even if it is an everyday consumer product marketed by large retailers (§ 53-55).

06/04/2022, T-370/21, [Nutrifem agnubalance / Nutriben](#), EU:T:2022:215, § 53-55

### **Level of attention – Forestry equipment – High level of attention**

The relevant public, composed of professionals in the area concerned by the goods in question ('forestry equipment' in Class 7), is likely to evince a high degree of attentiveness when selecting those goods. In addition, as regards the degree of attention of the relevant public at the time of purchase, the high price and the highly technological character of the goods concerned should be taken into account. Bearing in mind the specialised nature of the goods concerned in this case and their high cost, the choice of such goods involves a scrupulous selection process during which the consumer concerned will examine various goods on the market (§ 28).

However, the fact that the public with a high level of attention will be more aware of the differences between the marks does not mean that that public will examine the mark before it down to the smallest detail, or that it will compare that mark in minute detail to another mark. Even a public displaying a high level of attention must rely on its imperfect recollection of the marks (§ 29).

[13/07/2022, T-251/21, Tigercat / CAT \(fig.\) et al.](#), EU:T:2022:437

### **Unusual purchases – High level of attention**

The mere fact that the consumer does not regularly purchase a certain type of goods indicates that his attention is rather higher. Neither the goods covered by the earlier mark nor the goods covered by the contested mark are intended to be used under all circumstances by the average consumer. Their special nature requires a precise and well-considered selection (§ 39, 40).

[07/09/2022, T-155/21, Völkl \(fig.\) / Völkl et al.](#), EU:T:2022:518

See also, [07/09/2022, T-156/21, Marker Völkl / Völkl et al.](#), EU:T:2022:519, § 40, 41

### **Pharmaceutical products – Higher level of attention**

Given that the pharmaceutical products or substances for medical use (Class 5) may affect the health of end consumers, their level of attention is likely to be higher than average or high, that is to say heightened, in accordance with settled case-law, even with regard to pharmaceutical products that can be purchased without prescription (§ 26, 27).

[30/11/2022, T-678/21, Vsl3total / Vsl#3](#), EU:T:2022:738

### **Heating – Infrequent purchase – High level of attention**

Goods in Class 11, such as *central heating radiators*, *air conditioners* and *heating systems* target the general public and the specialised public (§ 29, 30). The level of attention must be regarded as high for these goods, which are purchased infrequently since, firstly, they are not everyday consumer goods and, secondly, they are expensive (§ 32-33).

[08/03/2023, T-172/22, termorad ALUMINIUM PANEL RADIATOR \(fig.\) / Thermrad](#), EU:T:2023:112

### **Pharmaceutical products – High level of attention in different groups of the relevant public**

Irrespective of their training and professional activity, average consumers of *pharmaceutical preparations* (Class 5), which have in common the essential purpose of being marketed on the recommendation of or through a medical professional and have a direct impact on health, have a high level of attention, whether they are members of the general public or professionals (§ 22).

Since the description of the goods at issue does not show that they are intended exclusively for elderly people or children, it is not appropriate to define the relevant public as being limited to those end consumers alone. Moreover, there is no specific argument raised capable of showing that the level of attention of elderly persons is lower than that of other consumers. As regards children, adults purchase pharmaceutical preparations for the needs of children, with the result that, in any event, it is the level of attention of adults that remains relevant (§ 23).

[15/03/2023, T-174/22, Breztrev / Brezilizer et al., EU:T:2023:134](#)

[15/03/2023, T-175/22, Breztri / Breezhaler et al., EU:T:2023:135](#)

### **Retail services in relation to vehicles, batteries and accumulators – High level of attention**

The attention of the relevant public with regard to ‘retail services in relation to vehicles’ is high regardless of whether the cars purchased are new or second-hand (§ 21). The public will pay particular attention with regard to ‘retail services relating to batteries and accumulators’ (§ 22-26).

[26/04/2023, T-153/22, XTG \(fig.\) / Gtx, EU:T:2023:217](#)

[26/04/2023, T-154/22, Xtq / Gtx, EU:T:2023:218](#)

### **Milk for infants – High level of attention**

The case-law according to which parents of babies and young children pay a higher level of attention when purchasing products for babies, given the importance they attach to the feeding and health of babies, applies *a fortiori* to goods such as *milk for infants*, even assuming that these goods are freely available in supermarkets (§ 29).

[06/09/2023, T-728/22, Namlac / Analac \(fig.\), EU:T:2023:511](#)

### **Specific nature of goods – Unusual purchase – Higher than average level of attention**

‘Glass bottles containing mineral stones’ are not purchased on a daily basis, but, rather, occasionally. Moreover, those goods are rather specific and are often used for decorative purposes or to obtain certain positive effects that may be attributed to the mineral stones they contain. Therefore, a person who purchases such goods will be particularly attentive when making their purchase, notwithstanding that that purchase may be easy or inexpensive (§ 30, 32).

[13/09/2023, T-473/22, LAAVA \(fig.\) / Lav \(fig.\) et al., EU:T:2023:543](#)

### **Financial services – High level of attention**

The level of attention of the specialised public and of the general public for ‘financial services’ is high since they are liable to have a direct impact on the economic and financial assets of consumers, they generally involve substantial sums of money, and they may have a significant financial impact (§ 21).

[22/11/2023, T-32/23, Tradias / TRIODOS, EU:T:2023:740](#)

### **No LOC – Energy supply and distribution services – High level of attention of the general public**

Both the public at large and the professional public display a high level of attention with regard to energy-related goods and services. When consumers belonging to the public at large have to choose energy-related goods and services, their choice will necessarily entail a careful and in-depth analysis of the specific technical features of those goods and services. Even though the need for an energy supply and the associated energy sources are a fact of daily life for the public at large, that public does not conclude new energy supply contracts on a regular basis. The choice of supplier will normally be preceded by a detailed analysis of the features of the proposed offer (§ 18, 20-21).

[20/03/2024, T-245/23, BF energy \(fig.\) / BS Energy et al., EU:T:2024:190](#)

### 2.1.3.3 Level of attention – low (examples)

#### **Confectionery – Level of attention – Low to average**

The level of attention of the relevant public is at most average, if not relatively low, in respect of ‘confectionery; candy; fudge’ in Class 30, since those goods are mostly inexpensive foodstuffs intended for mass consumption (§ 31, 32).

[01/06/2022, T-355/20, Pokój TRADYCJA JAKOŚĆ KRÓWKA SŁODKIE CHWILE Z DZIECIŃSTWA TRADYCYJNA RECEPTURA \(fig.\) / KOPOBKA KOROVKA \(fig.\), EU:T:2022:320](#)

## 2.2 COMPARISON OF THE GOODS AND SERVICES

### 2.2.1 Scope of the list of goods and services

#### **Irrelevance of actual use of the mark for the comparison of goods and services**

For the purposes of assessing whether there is a LOC, only the description of the goods in respect of which registration of the mark is sought is relevant; the intended or actual use of that mark cannot be taken into account, since the registration does not contain a restriction to that effect (§ 36).

[27/01/2021, T-382/19, Skylife \(fig.\) / SKY, EU:T:2021:45, § 36](#)

#### **Declaration under Article 28(8) CTMR [now Article 33(8) EUTMR] – Decision of declaration of invalidity**

The declaration under Article 28(8) CMTR (2016) [now Article 33(8) EUTMR] has retrospective effect. However, it is not intended to allow the addition of new goods or services to the protection enjoyed by the contested mark, but to ensure that, following the expiry of the period referred to in the third subparagraph of Article 28(8) CTMR, the goods or services covered by that declaration continue to enjoy protection even though they are not clearly covered by the literal meaning of the indications included in the class headings (§ 50). Therefore, a decision, by which a mark is declared invalid, although adopted before a declaration under Article 28(8) CTMR, concerns all the goods and services for which the contested mark was registered, including those covered by the declaration under Article 28(2) CTMR (§ 51).

[15/05/2019, C-653/17 P, Vermögensmanufaktur, EU:C:2019:406, § 50-51](#)

#### **Application *ratione temporis* of the Praktiker judgment’s requirements – Registration date – Right of priority – International registrations designating the EU**

The right of priority has effect only when it is necessary to determine the priority of conflicting signs and therefore has no effect on the date of registration of a trade mark if this is not the same as its priority date (§ 36).

For the application of the requirements resulting from the judgment of 07/07/2005, C-418/02, Praktiker, EU:C:2005:425, the relevant date is the date of registration of the EU trade mark concerned, namely the date of its final registration, which must be after the delivery of that judgment (§ 38). Such requirements are intended to apply to international registrations designating the EU for which registration was granted after the judgment was delivered, even if the filing date of the application was earlier than that judgment, and even if the protection conferred by the registration is retroactive to the date of the application (§ 44).

29/01/2020, T-697/18, [ALTISPORT \(fig.\) / ALDI et al.](#), EU:T:2020:14, § 36, 44

### **Registration for general indications of the class headings – Literal meaning**

If an earlier mark is registered for one of the general indications of the class heading, for example *hand tools (hand operated)* in Class 8, it is then protected for all products included in the literal meaning of that indication (07/04/2016, T-613/14, Polycart A Whole Cart Full of Benefits / POLICAR, EU:T:2016:198, § 23) (§ 43, 59)

05/10/2020, T-847/19, [Pax-SPAX \(fig.\) et al.](#), EU:T:2020:472, § 43, 59

### **Vaguely defined terms – Complex goods – ‘Parts’ and ‘accessories’**

An EUTM proprietor cannot gain from the vague wording of the goods covered by its marks. In particular, in the event of complex goods (in the case at issue *head ends for cable networks*), the terms ‘parts’ and ‘accessories’ used in the wording of the goods are vaguely defined terms and cannot be taken into account when assessing the similarity or complementarity of goods and services (§ 30).

26/03/2020, T-312/19, [Chameleon / Chameleon](#), EU:T:2020:125, § 30

### **Vaguely defined terms followed by the expression ‘in particular’**

Since the goods covered by the earlier mark are not described solely as goods made of leather and imitations of leather, but have been listed more precisely (in particular bags, trunks and travelling bags; suit bags, wallets, purses, key cases, cases for writing utensils, cases for cutlery; umbrellas, parasols and walking sticks), the protection of the earlier mark extends only to those finished goods made of leather and imitations of leather primarily used to carry, bring and contain small items (§ 51-53).

25/06/2020, T-114/19, [B \(fig.\)-B \(fig.\)](#), EU:T:2020:286, § 51-53.

### **Clarity and precision of product indication (earlier mark) – Identical products – Absence of relevance of the parties’ current fields of activity**

Even if it were assumed that the product indication *software* in the earlier mark were vague, this would not affect the possibility of a comparison with the contested goods. Since the specific *software for education purposes* designated by the mark applied for is included in the general indication of *software*, the goods are found to be identical. The specific field of application of the general indication *software* cannot be inferred either from the other goods and services covered by the earlier mark or from the actual fields of activity of the parties (§ 29-33).

24/02/2021, T-56/20, [Vroom / Pop & Vroom](#), EU:T:2021:103, § 29-33

### **Consideration of the Nice classification for the purposes of interpretation**

Although the classification of goods and services under the Nice Agreement is intended to serve exclusively administrative purposes, the class which the applicant has chosen in that classification may be taken into account for the purposes of interpretation or as an indication of the precision of the designation of the goods (25/01/2018, T-367/16, H HOLY HAFERL HAFERL SHOE COUTURE (fig.) / HOLY et al., EU:T:2018:28, § 50) (§ 35).

[01/09/2021, T-697/20, \*Donas dulcesol / Dulcesol\*, EU:T:2021:526, § 35](#)

### **Explanatory notes of the Nice Classification**

Notwithstanding the fact that the Nice Classification was adopted for exclusively administrative purposes, the explanatory notes on the different classes of that classification are relevant in determining the nature and purpose of the goods and services under comparison (§ 38).

[09/09/2019, T-575/18, \*The Inner Circle / InnerCircle\*, EU:T:2019:580, § 38](#)

### **Vague defined terms followed by the expression ‘especially’**

If a vague term in the earlier mark’s specification is followed by another term which expressly identifies the goods or services by way of example, it is then possible to carry out a comparison with that specific term. The word ‘especially’ is synonymous with the expression ‘in particular’, it shows the intention on the part of the proprietor of the earlier mark to seek to obtain protection in respect of goods following this expression (§ 37, 38).

[08/06/2022, T-738/20, \*Holux / Holux et al.\*, EU:T:2022:343](#)

### **Scope of the list of goods and services – Use of brackets**

The use of brackets in the list of goods and services has the effect of limiting the scope of the protection sought only to the goods between the brackets which are included in the more general category indicated before the brackets (§ 17).

[07/09/2022, T-155/21, \*Völkl \(fig.\) / Völkl et al.\*, EU:T:2022:518](#)

[07/09/2022, T-156/21, \*Marker Völkl / Völkl et al.\*, EU:T:2022:519](#)

### **Interpretation of the list of goods and services**

The scope of trade mark’s protection is determined by the usual meaning of a term contained in the list of goods and services and not by the term’s inclusion in the Nice Classification’s taxonomic information structure (§ 24).

[01/02/2023, T-671/21, \*Duuuval / GROUPE DUVAL \(fig.\) et al.\*, EU:T:2023:33](#)

### **Scope of the list of goods and services**

It cannot be inferred from the judgment ([19/06/2012, C-307/10, \*IP Translator\*, EU:C:2012:361](#)), that an opposition may be rejected from the outset, simply by invoking the absence of any precise statement of the goods covered by the earlier mark (§ 30).

[01/03/2023, T-295/22, \*The Crush Series \(fig.\) / Crush \(fig.\)\*, EU:T:2023:97](#)

### **Scope of the list of goods – Broad specification – Software**

For the assessment of the degree of similarity between types of software, the criterion of function, and thus of intended purpose, is extremely important among the relevant factors (§ 33). Although

the intended purpose of the goods and services of the earlier mark is specified with a degree of precision, that is not the case with the goods and services covered by the mark applied for (§ 35). The particular use of the goods and services covered by the mark applied for may vary over time and according to the applicant's intention. Therefore, the examination of similarity of the goods and services in question must be carried out on the basis of the wording of the list of goods and services as applied for. In view of their broad wording and in the absence of further clarification as to their use, they may cover goods and services provided in the same field as those covered by the earlier mark (§ 36).

[03/05/2023, T-7/22, Financery / financify, EU:T:2023:234](#)

### **Comparison of the goods – PDO status of the goods irrelevant**

The fact that Port wine has PDO status and therefore complies with a precise specification, of which the geographical origin is an essential element, does not call into question the fact that it is a wine. Consequently, that circumstance must be regarded as irrelevant in the context of the examination of the similarity or identity of the goods at issue (§ 27).

[07/06/2023, T-33/22, Porto insígnia / Insignia et al., EU:T:2023:316](#)

### **Irrelevance of actual use of the mark for the comparison of the goods and services – Irrelevance of the specific goods shown in the proof of use**

The argument that the goods marketed under the earlier mark relate to a narrower sub-category of goods, that of 'wines originating in California', is not convincing, given that, according to its registration, that mark designated 'wines' in Class 33, without an indication of geographical origin, and genuine use of the earlier mark was demonstrated in respect of goods in the category 'wines', which the applicant did not dispute (§ 28, 29).

[07/06/2023, T-33/22, Porto insígnia / Insignia et al., EU:T:2023:316](#)

### **Irrelevance of actual use of the mark for the comparison of goods and services**

The comparison of the goods and services must be based on the description of the goods and services covered by the marks at issue and not the goods and services for which the marks are actually used (§ 28).

[29/06/2023, T-719/22, HERZO / HERNO \(fig.\) et al.](#)

### **Comparison of goods and services – Irrelevance of actual use of the mark – Irrelevance of the representation of the sign**

The intended or actual use of the mark and the fact that the mark applied for contains the word element 'wine' and the representation of a glass of wine has no impact on the comparison of the goods and services if the registration does not contain a restriction to that effect (§ 30, 34, 35).

[20/12/2023, T-655/22, WINE TALES RACCONTI DI VINO \(fig.\) / WT WINE TALES \(fig.\) et al., EU:T:2023:859](#)

## **2.2.2 Identity**

[No key points available yet.]

## 2.2.3 Similarity

### **Irrelevance of marketing issues for the comparison of goods and services**

When carrying out the comparison to assess whether there is a LOC, it is necessary to take into account the services covered by the marks, not the services actually marketed under those marks (21/09/2017, T-620/16, *Idealogistic (fig.) / IDEA et al.*, EU:T:2017:635, § 35) (§ 48).

08/07/2020, T-328/19, [\*SCORIFY \(fig.\) / Scor et al.\*](#), EU:T:2020:311, § 48

### **Relevance of the ‘market practice criterion’ for the comparison of goods and services – Criteria relating to the fact that the producers and distribution channels are the same – Lack of reasoning**

In order to compare the goods or services, all the relevant factors relating to those goods and services should be taken into account (29/09/1998, C-39/97, *Canon*, EU:C:1998:442, § 23). Those factors include, *inter alia*, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary. Other factors may also be taken into account, such as the distribution channels of the goods or services concerned or the fact that those goods or services are often sold in the same specialist sales outlets, which is likely to facilitate the perception by the relevant consumer of the close connections between them and strengthen the impression that the same undertaking is responsible for the production of those goods or provision of those services (21/01/2016, C-50/15 P, *Carrera / CARRERA*, EU:C:2016:34, § 21-23) (§ 44). The list of criteria is not exhaustive (§ 45).

The existence of a certain market practice may constitute a relevant criterion for the purpose of examining the similarity between goods or services in the context of Article 8(1)(b) CTMR [now EUTMR] (§ 51-54, 55).

The BoA erred in law, by ruling out, as a matter of principle, an assessment of the similarity of the goods in light of the market practices criterion put forward by the applicant. It cannot be ruled out that other criteria, besides the Canon criteria, the distribution channels and the fact that the sales outlets are the same, may be relevant in assessing the similarity between goods or services in general and between the goods at issue in particular (§ 46-48). Since, owing to its error, the BoA did not specifically examine the relevance and then, if necessary, the impact of that criterion on its assessment of the similarity between the goods at issue, the Court cannot itself give a ruling on that issue (§ 56).

Furthermore, the BoA did not take into consideration criteria relating to the usual origin of the goods or the fact that the producers and distribution channels are the same in the analysis that led to the adoption of the contested decision (§ 59). By not stating the reasons why criteria relating to the usual origin of the goods or the fact that the producers and distribution channels are the same were not taken into account, the BoA failed to set out all the facts and legal considerations that are crucial for finding that the goods are not similar, with the result that the contested decision is vitiated by a failure to state reasons (21/07/2016, T-804/14, *Tropical*, EU:T:2016:431, § 178) (§ 62).

It is not for the Court, in its review of the legality of the contested decision, to carry out an assessment of something on which the BoA has not adopted a position, and the Office cannot substantiate the contested decision before the Court with evidence that was not taken into account for the purposes of that decision (08/09/2017, T-572/15, *GOURMET (fig.) / ORIGINE GOURMET (fig.)*, EU:T:2017:591, § 36) (§ 64). The Office’s line of argument, that the application of the additional criteria would not lead, in the present case, to a finding that the goods at issue are similar, is therefore inadmissible (24/09/2019, T-356/18, *V V-WHEELS (fig.) / VOLVO (fig.) et al.*, EU:T:2019:690, § 49) (§ 65).

02/06/2021, T-177/20, [Hispano Suiza / Hispano Suiza](#), EU:T:2021:312, 44-45, § 51-54, 55-56, 62, 65

### **No need for evidence regarding the similarity of the goods and services**

The opposing party is not obliged, in opposition proceedings, to adduce evidence as to the similarity of the services at issue (09/02/2011, T-222/09, Alpharen, EU:T:2011:36, § 22) (§ 51).

08/07/2020, T-328/19, [SCORIFY \(fig.\) / Scor et al.](#), EU:T:2020:311, § 51

### **No similarity of the goods – Comparison of general categories – Same material – Overlap in intended purposes**

It is not for EUIPO, when comparing general categories of goods covered by the signs at issue, to rule on certain specific goods which they contain (§ 38). 'Games, toys' and 'Gymnastic and sporting articles' are different (§ 35). The same material can be used to manufacture a wide range of totally different goods, with the result that that fact is not sufficient to establish that the goods at issue are similar (§ 39). The fact that several intended purposes may overlap in the same product does not rule out the possibility of identifying a dominant, or in other words 'primary', purpose of a product. The term 'use' means the generally intended use of the product and not any misuse or occasional use (§ 43).

[21/12/2022, T-129/22, BIMBA TOYS \(fig.\) / Simba \(fig.\) et al.](#), EU:T:2022:845

### **Comparison of goods – Level of attention is not a relevant factor**

The level of attention of the relevant public does not constitute a relevant factor when assessing the similarity of the goods but must be taken into account when carrying out the global assessment of LOC (§ 41).

[07/06/2023, T-543/22, BIOPLAN / BIOPLAK](#), EU:T:2023:320

### **Similarity of the goods and services – Irrelevance of the different legal provisions regulating the sales of the goods**

Although the sale of the goods covered by the earlier mark and that of the goods covered by the contested mark may be regulated by different legal provisions, this does not affect the relevant public's perception, given that, when choosing goods, that public is very rarely aware of the applicable legal provisions (§ 39).

[28/06/2023, T-495/22, Omegor / OMACOR \(fig.\) et al.](#), EU:T:2023:359

See also, [28/06/2023, T-496/22, Omegor vitality / OMACOR \(fig.\) et al.](#), EU:T:2023:360, § 42

### **Comparison of goods – Factor of common commercial practice**

In examining the similarity between goods, consumers must consider it usual that the goods are sold under the same trade mark, which normally implies that a large number of the producers or distributors of the goods are the same. Even in cases where some manufacturers and some stores, respectively, do produce and offer all the goods in conflict, if this is not a common commercial practice, rather than a marginal phenomenon, this coincidence, without any other supporting evidence, cannot lead to the conclusion that those goods are manufactured by the same undertakings and share the same distribution channels (§ 57-59, 85).

[26/07/2023, T-562/21 & T-590/21, Camel crown / camel active \(fig.\)](#), EU:T:2023:440

## **Comparison of goods and services – Irrelevance of the reputation of the contested mark**

Questions related to the alleged reputation of the EUTM application or the history of the company applying for it are irrelevant when carrying out the comparison of goods in the context of Article 8(1)(b) EUTMR (§ 72).

[13/09/2023, T-167/22, Tmc transformers / TMC \(fig.\) et al., EU:T:2023:535](#)

See also, [13/09/2023, T-163/22, TMC TRANSFORMERS \(fig.\) / TMC \(fig.\) et al., EU:T:2023:534](#), § 74

## **Comparison of goods and services – Irrelevance of classification of goods according to other EU instruments**

Although all the contested goods (perfumes and make-up preparations) consist of cosmetic products according to other rules of EU law, this is not, in principle, decisive with regard to their classification in the context of EU trade mark law (§ 30).

[11/10/2023, T-490/22, ayuna LESS IS BEAUTY \(fig.\) / Ajona, EU:T:2023:616](#)

## **Dissimilarity of the goods and services – No complementarity**

By definition, goods or services intended for different publics cannot be complementary. The goods and services covered by the mark applied for (such as kitchenware, connected items, decorations, toys as well as retail services thereof in Classes 4, 6, 8, 11, 16, 20, 21, 24, 28 and 35) are all intended for the general public. By contrast, the services in Class 35 covered by the earlier mark, relating to shopping centre management, target professionals (§ 34-35, 47). The goods and services under comparison are not similar and therefore the existence of a LOC can be ruled out (§ 49).

[31/01/2024, T-581/22, ECE QUALITY OF LIFE \(fig.\) / ECE \(fig.\), EU:T:2024:47](#)

## **Goods and dispensers of such goods – Complementarity – High similarity**

*Hearing protections* and *dispensers for hearing protections* are complementary goods due to an obvious functional connection. Therefore, they are highly similar (§ 43-44).

[21/02/2024, T-767/22, Horex / MOLDEX \(fig.\), EU:T:2024:108](#)

## **2.2.4 Particular industries**

### **2.2.4.1 Chemicals, pharmaceuticals and cosmetics**

#### **Food, nutritional, dietary and vitamin supplements – Creams for medical use – Similarity**

*Food, nutritional, dietary and vitamin supplements* and *creams for medical use* in Class 5 are similar, to at least a low degree, due to their common general intended purpose, their several specific intended purposes, their possible joint use and the identity of their distribution channels (§ 75).

28/05/2020, T-724/18 & T-184/19, [AUREA BIOLABS \(fig.\) / Aurea et al., EU:T:2020:227](#), § 75

#### **Health food supplements – Pharmaceutical preparations – Similarity**

Health food supplements made principally of vitamins; nutritional supplements; food supplements; dietary supplements consisting of vitamins are similar to pharmaceutical preparations (§ 40-43).

16/12/2020, T-883/19, [Helix elixir / Helixor et al., EU:T:2020:617](#), § 40-43

### **Sanitary products [...] and Capsules (filled) for medical purposes in Class 5 – Pharmaceutical preparations – Similarity**

Sanitary products..., excluding pharmaceutical and veterinary products included in Class 5 and the pharmaceutical preparations are similar to a low degree. Capsules (filled) for medical purposes (included in Class 5), excluding pharmaceutical and veterinary products and pharmaceutical preparations are similar (§ 36).

15/10/2020, T-2/20, [BIOPLAST BIOPLASTICS FOR A BETTER LIFE \(fig.\) / Bioplak](#), EU:T:2020:493, § 36

### **Chemical reagents for pharmaceutical and veterinary purposes, dietary supplements, Sanitary preparations for medical use – Antipyretics – Similarity**

Chemical reagents for pharmaceutical and veterinary purposes in Class 5 are similar to antipyretics in the same class (§ 71).

Dietary supplements for pharmaceutical and veterinary purposes; dietary supplements; nutritional supplements; medical preparations for slimming purposes; food for babies; herbs and herbal beverages adapted for medicinal purposes; herbal supplements; herbal creams for medical purposes; herbal creams for medical use; herbal teas for medicinal purposes; liquid herbal supplements in Class 5 have a lower-than-average degree of similarity to antipyretics, also included in Class 5 (§ 56).

Sanitary preparations for medical use; hygienic pads; hygienic tampons; plasters; materials for dressings; diapers, including those made of paper and textiles; fungicides, disinfectants; antiseptics; detergents for medical purposes in Class 5 have a lower-than-average degree of similarity to the antipyretics (§ 72).

*Bee glue for human consumption, propolis, propolis for human consumption* in Class 30 have a slightly lower-than-average degree of similarity to *antipyretics* in Class 5 (§ 55).

Teeth filling material, dental impression material, dental adhesives and material for repairing teeth in Class 5 are dissimilar to antipyretics (§ 70).

05/10/2020, T-53/19, [apiheal \(fig.\) / APIRETAL](#), EU:T:2020:469

### **Cosmetic services – Sterile implantable products for filling wrinkles – Similarity**

Cosmetic services, hygienic and beauty care for human beings in Class 44 and sterile implantable products for filling wrinkles, fine lines, cutaneous depressions and for adding volume to the lips in Class 5 have an average degree of similarity (§ 33, 48). They share the same purpose, rendering the face more beautiful, they are both used within the same therapeutic beauty treatment and they can be found in the same beauty institutions (§ 40-41). They are complementary since the beauty institutions use these implantable cosmetics (§ 42). Even if some of the cosmetics were only offered in specialised clinics, these hospitals provide cosmetic treatments (§ 45). Therefore, they also share the same distribution channels (§ 47).

25/11/2020, T-802/19, [KISS COLOR \(fig.\)-Kiss et al](#), EU:T:2020:568, § 47

### **Cosmetics in Class 3 and pharmaceuticals in Class 5 – Similarity to a low degree**

*Pharmaceuticals* and *cosmetics* share the same distribution channels and target in large part the same public, namely the general consumer. Although *pharmaceuticals* are different in nature on account of their therapeutic indication, they may nevertheless include, like the *cosmetics*, products intended to be applied to the skin, in particular in form of creams, lotions and oils. Therefore, the goods are similar to a low degree (§ 42-44).

24/03/2021, T-175/20, [Sanolie / Sanodin](#), EU:T:2021:165, § 42-44

### **Pharmaceuticals – Cosmetics – Similarity to a low degree**

*Pharmaceuticals* are similar to a low degree to *cosmetics* since: (i) the purpose of certain pharmaceuticals, such as skincare or haircare preparations with medical properties, medicated dentifrices and medicated soaps, coincides with the purpose of cosmetic creams or lotions, dentifrices and soaps not for medical use and (ii) both of these types of goods are sold in pharmacies (§ 32-33). A partial overlap between the points of sale is sufficient where there are numerous points of sale (§ 34).

30/06/2021, T-501/20, [Panta rhei / Panta rhei](#), EU:T:2021:402, § 34

### **Dietetic food supplements for medicinal use and nutritional supplements – Cosmetics – Similarity to a low degree**

*Dietetic food supplements for medicinal use and nutritional supplements* and *cosmetics* are similar to a low degree as they both have the common objective of skincare and beauty (§ 39-40, 42).

30/06/2021, T-501/20, [Panta rhei / Panta rhei](#), EU:T:2021:402, § 39-40, 42

### **Medicated nasal sprays – Medicated dental rinses – Similarity to a low degree**

*Medicated nasal sprays* and *medicated dental rinses* are similar to a low degree. They are medicinal products which are aimed at treating infections, in particular those of the respiratory system. Furthermore, it is conceivable that nasal sprays may be used to treat infections of the respiratory tract and the pharynx and that those goods may be combined. Also they share the same distribution channels (§ 28-29).

20/01/2021, T-261/19, [OptiMar \(fig.\)](#), EU:T:2021:24, § 28-29

### **Non-alcoholic dietetic beverages for medical purposes – Cosmetics – Similarity to a low degree**

*Non-alcoholic dietetic beverages for medical purposes* and *cosmetics* are similar to a low degree since the purpose of both can be to improve the physical appearance of the user. The difference in the method of use is not sufficient to prevent a finding of similarity (§ 44-45).

30/06/2021, T-501/20, [Panta rhei / Panta rhei](#), EU:T:2021:402, § 44-45

### **Non-alcoholic beverages adapted for the prevention and curative treatment of eye diseases – Cosmetics – Similarity to a low degree**

*Non-alcoholic beverages adapted for the prevention and curative treatment of eye diseases* and *cosmetics* are similar to a low degree even if the goods differ in purpose because of the similarity of their distribution channels (§ 52-53).

30/06/2021, T-501/20, [Panta rhei / Panta rhei](#), EU:T:2021:402, § 52-53

### **Perfumery, cosmetics, herbicides – Antipyretics – Dissimilarity**

Perfumery; cosmetics; fragrances; deodorants for personal use and animals; soaps; bath herbs, not for medical purposes; dental care preparations, dentifrices, denture polishes, tooth whitening preparations, mouth washes, not for medical purposes in Class 3 are dissimilar to antipyretics in Class 5 (§ 43-44).

Preparations for destroying vermin; herbicides in Class 5 are different to antipyretics in Class 5 (§ 53-54).

05/10/2020, T-51/19, [apiheal \(fig.\) / APIRETAL](#), EU:T:2020:468, § 43-44, 53-54

#### **Perfumery, fragrances for personal use, perfume oils for the manufacture of cosmetic preparations – Perfume oils for the manufacture of cosmetic preparations – Dissimilarity**

There is no similarity between, on the one hand, the *perfumery, fragrances for personal use and perfume oils for the manufacture of cosmetic preparations* in Class 3 covered by the mark applied for and, on the other hand, the pharmaceutical and sanitary preparations intended for medical treatment or healthcare in Class 5 covered by the earlier mark. The goods have different purposes, different distribution channels and not the same usual origin and they are neither in competition nor complementary (§ 24-35).

15/09/2021, T-331/20, [Le-vel / Level](#), EU:T:2021:571, § 24-35

#### **Polishing, scouring and abrasive preparations – Preparations for destroying vermin; fungicides, herbicides – Dissimilarity**

There is no similarity between, on the one hand, the *polishing, scouring and abrasive preparations* in Class 3 covered by the mark applied for and, on the other hand, the goods in Class 5 protected by the earlier mark, in particular the *preparations for destroying vermin; fungicides, herbicides* (§ 39-45).

15/09/2021, T-331/20, [Le-vel / Level](#), EU:T:2021:571, § 39-45

#### **Flavourings for beverages [essential oils]; food flavourings prepared from essential oils – Dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals – Dissimilarity**

Flavourings for beverages [essential oils]; food flavourings prepared from essential oils in Class 3 and covered by the mark applied for are dissimilar to the dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals in Class 5 and covered by the earlier mark. The nature, intended purpose and consumers of those goods are different and the goods are neither in competition nor complementary (§ 46-51).

15/09/2021, T-331/20, [Le-vel / Level](#), EU:T:2021:571, § 46-51

#### **Goods and services in Classes 1 and 42 – Pharmaceutical preparations – Dissimilarity**

The goods and services in Classes 1 (such as chemicals used in industry, in particular pre-processed products and auxiliary agents for the manufacture of plastics; chemicals used in form of thermoplastically processable granules for pharmaceutical purposes) and 42 (such as scientific and technological services and research and design relating thereto in particular in the field of biodegradable plastics) on one hand and pharmaceutical preparations in Class 5 on the other are dissimilar (§ 25-30, 31-35). The mere fact that one product is used for the manufacture of another is not sufficient in itself to show that the goods are similar, as their nature, purpose, relevant public and distribution channels may be quite distinct (§ 27). The goods cannot be regarded as complementary on the sole ground that one is manufactured with the other (09/04/2014, T-288/12, Zytel, EU:T:2014:196, § 39) (§ 29). The services in Class 42 have a different nature and purpose to those of the goods in Class 5. They are neither complementary to nor in competition with each other and their respective distribution channels and methods of use are different (§ 31).

15/10/2020, T-2/20, [BIOPLAST BIOPLASTICS FOR A BETTER LIFE \(fig.\) / Bioplak](#), EU:T:2020:493, § 25-30, 31-35

### **Stem cells for scientific purposes and stem cells for research purposes (...) and – Veterinary preparations; stem cells for medical purposes – Hospitals services – Dissimilarity**

*Stem cells for scientific purposes* and *stem cells for research purposes* in Class 1 covered by the mark applied for are different from the services *hospitals* in Class 44 covered by the earlier mark. Given the wide variety of goods capable of having a medical purpose, this factor is not sufficient to establish similarity of the goods and services (§ 70-71).

Veterinary preparations; stem cells for medical purposes; cellular function activating agents for medical purposes; stem cells for veterinary purposes and surgical implants grown from stem cells in Class 5 covered by the mark applied for, are not similar to the services *hospitals* in Class 44 covered by the earlier mark since they are different in nature, purpose and method of use and it is not sufficiently apparent from the evidence that the goods have the same origin and use the same distribution channels as the services *hospitals* (§ 72-73, 75-77).

22/09/2021, T-591/19, [Healios \(fig.\) / HELIOS](#), EU:T:2021:606, § 70-71, 72-73, 75-77

### **Medical services relating to the removal, treatment and processing of stem cells – Medical services relating to the removal, treatment and processing of human blood – Dissimilarity**

Medical services relating to the removal, treatment and processing of stem cells; and medical services relating to the removal, treatment and processing of human blood, umbilical cord blood, human cells, stem cells and bone marrow in Class 44 covered by the mark applied for, have a particular nature and purpose in that they concern the transformation of the raw materials human blood, umbilical cord blood, human cells, stem cells and bone marrow. Given such characteristics, these services are normally offered by institutes or laboratories specialising in those fields and are not marketed via the same distribution channels as the services *hospitals* covered by the earlier mark (§ 82). These services are different (§ 84).

22/09/2021, T-591/19, [Healios \(fig.\) / HELIOS](#), EU:T:2021:606, § 82, 84

### **Importance of visual similarity for goods in Class 3**

The BoA took account of the fact that the goods at issue (*make-up preparations, fragrances*) are generally purchased on a self-service basis and that consumers will have the opportunity to inspect the goods visually. Therefore, the BoA was right to point out the importance of the visual similarity found (§ 75, 76).

30/03/2022, T-30/21, [SO COUTURE / SO...? et al.](#), EU:T:2022:190, § 75, 76

### **Pharmaceuticals – Cosmetics – Similarity**

The '*pharmaceutical products for skin protection and cleansing for the purposes of personal hygiene*' in Class 5 covered by the earlier German mark are similar to a wide range of cosmetic products in Class 3 of the EUTM application. The goods under comparison have the same nature in part and the same purpose, they are marketed through the same distribution channels and are complementary (§ 56).

11/05/2022, T-93/21, [SK SKINTEGRA THE RARE MOLECULE \(fig.\) / Skintegrity et al.](#), EU:T:2022:280

### **Pharmaceuticals – Cosmetics – Dissimilarity**

The possibility that the same consumer might use several products sold in a pharmacy simultaneously or by administering them in the same manner is only of minor importance to the assessment of the similarity of the goods at issue, namely 'gels for cosmetic use' or

'dermatological creams' (Class 3) and 'pharmaceutical and veterinary substances, namely for the treatment of pain, injuries and other disorders and prevention of degeneration of the musculoskeletal system' (Class 5). The fact that 'gels for cosmetic use' or 'dermatological creams' can be applied via the skin simultaneously with pharmaceutical substances for the musculoskeletal system without any contraindication is not sufficient for them to be regarded as complementary. There is nothing in the description of the goods at issue to suggest that they might be interchangeable or that the use of one of them would depend in any way on that of the others, given the difference in the specific purpose of the latter. The mere fact that the goods at issue may be sold in pharmacies or have an effect on health or on bodily well-being is not sufficient to establish similarity with regard to the undisputed difference, in the present case, between the medical purpose of some and the cosmetic purpose of the others (§ 37, 38, 47, 48).

[12/09/2022, T-130/22, TRAUMGEL \(fig.\) / Traumeel](#)

### **Level of attention – Cosmetics**

It is apparent from the case-law that cosmetic preparations are generally inexpensive everyday consumer goods and that the relevant public's level of attention when purchasing those goods must be described as average, despite the fact that cosmetics are applied to the human body (§ 27-28).

[19/10/2022, T-718/21, Maeselle / MARCELLE \(fig.\), EU:T:2022:647](#)

### **Pharmaceutical preparations for skin care – Cosmetic preparations for skin care – Similarity to an average degree**

The 'pharmaceutical preparations for skin care' in Class 5 and the 'cosmetic preparations for skin care' in Class 3 often share the same distribution channels and, to a large extent they are aimed at the same public, namely the general public. Regarding their purpose, the pharmaceutical preparations for skin care treat health problems pertaining to the skin whereas the cosmetic preparations covered by the earlier mark are intended to improve the physical appearance of the skin. These goods can be used together or one after the other, which creates a close connection between them. Although the pharmaceutical preparations have a different nature from that of the cosmetic preparations, on account of their therapeutic indication, they are both intended to be applied to the skin in order to care for it. Therefore, these goods are similar to an average degree (§ 27, 28).



[08/02/2023, T-787/21, UNISKIN by Dr. Søren Frankild \(fig.\) / UNICSKIN YOUR EFFECTIVE SOLUTION \(fig.\) et al., EU:T:2023:56](#)

### **Pharmaceuticals – Cosmetics – Similarity**

Some goods in Class 3 (e.g. *cosmetics*) and in Class 5 (e.g. *pharmaceuticals*) may share the same purpose, the same distribution channels, such as pharmacies or other specialised shops, the same manufacturing companies, and the same end users (§ 32).

[26/04/2023, T-681/21, mccosmetics NY \(fig.\) / MAC MAKE-UP ART COSMETICS \(fig.\) et al., EU:T:2023:215](#)

### **Pharmaceuticals – Cosmetics – Low similarity**

*Creams, lotions, gels; cleansing preparations for personal use; non-medicinal cosmetics* (Class 3) are similar to a low degree to *pharmaceutical products* (Class 5) (§ 39).

[03/05/2023, T-303/22, Vitis pharma \(fig.\) / viti DREN \(fig.\), EU:T:2023:232](#)

### **Pharmaceuticals – Pharmaceutical research – Similarity**

*Scientific, biological, pharmaceutical research; scientific research consultancy services; chemical analysis; genetic research and analysis; product research and development; scientific and technological services; hardware and software design and development* in Class 42 are similar at least to a limited degree to *pharmaceutical products* (Class 5). Pharmaceutical companies often engage in scientific research and development in order to improve pharmaceutical products, therefore these goods and services have a close relationship (§ 43).

[03/05/2023, T-303/22, Vitis pharma \(fig.\) / viti DREN \(fig.\), EU:T:2023:232](#)

### **No similarity of the goods – Purpose of therapeutic products**

For the purposes of the comparison of therapeutic products, it is their therapeutic indication and not their general intended use to improve and protect one's health that is of decisive importance (§ 27).

[07/06/2023, T-543/22, BIOPLAN / BIOPLAK, EU:T:2023:320](#)

### **Pharmaceuticals – Vitamin preparations – Purpose or intended use – Similarity**

The treatment of human health problems is regarded as a common purpose or intended use that can validly be taken into account for the similarity of goods in Class 5. Although the goods covered by the earlier mark (pharmaceutical products in the form of Omega-3 fatty acids for the treatment of post myocardial infarction and hypertriglyceridaemia) have a more specific purpose than the contested vitamin preparations, the view must nevertheless be taken that the similarities between the goods covered by the marks at issue outweigh the differences (§ 52-53).

[28/06/2023, T-495/22, Omegor / OMACOR \(fig.\) et al., EU:T:2023:359](#)

### **Pharmaceuticals – Food for babies – Complementarity of the goods – Similarity**

Some food for babies may be complementary to medicines that are administered to them, in the sense that one is indispensable or important for the use of the other (§ 66).

[28/06/2023, T-495/22, Omegor / OMACOR \(fig.\) et al., EU:T:2023:359](#)

### **Pharmaceuticals – Dietary supplements – Purpose or intended use – Similarity**

In the present case, although the goods covered by the earlier mark (pharmaceutical products in the form of Omega-3 fatty acids for the treatment of post myocardial infarction and hypertriglyceridaemia) have a specific purpose, the goods in question are intended, in general, to improve consumers' state of health. The contested 'dietary supplements and dietetic preparations' are aimed at overcoming deficiencies by supplementing a diet with vitamins, minerals and acids (including omega-3 fatty acids) and are intended to prevent or treat certain health problems (§ 39).

[28/06/2023, T-496/22, Omegor vitality / OMACOR \(fig.\) et al., EU:T:2023:360](#)

### **Perfumes and make-up preparations – Dentifrices – Dissimilarity – No particular importance given to the distribution channels**

Although the goods in question (perfumes and dentifrices) may be sold in the same commercial establishments, such as drugstores, pharmacies or supermarkets, this is of no particular

importance, since very different kinds of goods may be found in such sales outlets, without consumers automatically believing that they have the same commercial origin (§ 29).

[11/10/2023, T-490/22, ayuna LESS IS BEAUTY \(fig.\) / Ajona, EU:T:2023:616](#)

### **Cosmetics – Cosmetics utensils – Complementarity – Low similarity**

*Cosmetic utensils; toilet cases; powder puffs; toilet sponges; make-up sponges; pots for cosmetic purposes* in Class 21 of the contested mark have a complementary function to *scented body lotions and creams* in Class 3 covered by the earlier mark in that they cannot be used without the latter (§ 43).

[21/02/2024, T-765/22, LA CREME LIBRE \(fig.\) / LIBRE, EU:T:2024:106](#)

### **Cleaning products – Disinfectants – Similarity**

The purpose of the contested goods in Class 3 (cleaning products) is to wash, bleach, clean or add fragrance. Those goods contain chemicals for killing germs, similarly to the ‘disinfectants’ in Class 5 covered by the earlier mark. Their use and intended purpose therefore overlap to a certain extent, given that they are related to cleaning and hygiene. They may also have the same manufacturers and distribution channels and target the same public. As a result, similarity between them cannot be ruled out (§ 44).

[28/02/2024, T-164/23, IGISAN \(fig.\) / IGNISAN, EU:T:2024:132](#)

### **Beverages in Class 32 – Specific pharmaceuticals in Class 5 – Dissimilarity – Application by analogy of the case-law relating to pharmaceuticals**

The lack of similarity between beverages in Class 32 and pharmaceutical products for the treatment of mouth inflammations in Class 5 is not undermined by the fact that those goods are intended directly for human health, or that they may be marketed in the same type of shops and are aimed at the same type of consumers. By analogy with the case-law in relation to pharmaceutical products, the mere fact that certain goods may be sold in the same type of shops and to the same type of consumers is not sufficient for the conclusion to be drawn that they are similar (§ 58).

[13/03/2024, T-206/23, Sanoid \(fig.\) / SANODIN, EU:T:2024:164](#)

## **2.2.4.2 Automobile industry**

### **Accessories – Caravans, and spare parts therefor in Class 12 – Identity**

Accessories (included in Class 12); car accessories, namely trailer couplings, luggage racks, ski racks, mudguards, snow chains, wind deflectors are identical to caravans, and spare parts therefor in Class 12, since accessories are parts intended to supplement a main object and fall under the broader category of parts (§ 36-37).

[27/02/2020, T-202/19, Caratour / Carado et al., EU:T:2020:75, § 36-37](#)

[27/02/2020, T-203/19, Caratwo / Carado et al., EU:T:2020:76, § 36-37](#)

### **Bicycles and motorcycles – Parts and accessories of bicycles and motorcycles – Similarity**

Bicycles and motorcycles in Class 12 are similar to a low degree (§ 28-30 and 33). The same applies to parts and accessories of bicycles and parts and accessories of motorcycles in Class 12 (§ 37), and bicycle sports helmets and protective clothing for motorcyclists in Class 9 (§ 41-42).

14/05/2019, T-12/18, [Triumph / TRIUMPH](#), EU:T:2019:328, § 28-30, 33, 37, 41-42

#### **Various bicycles and moving vehicles for children – Vehicles – Apparatus for locomotion by land – Weak similarity**

*Various bicycles and moving vehicles for children* in Class 12 cannot be considered identical. There is only a weak similarity between these goods (§ 86).

The various vehicles and apparatus for locomotion by land in Class 12 are in part identical (cars; motorcycles; scooters), in part similar to a low degree (e-bicycles; e-bikes; bicycles; bicycles for grown-ups; trekkingbikes; citybikes; BMX-bikes; racingbikes; foldingbikes; crossbikes; mountainbikes; bicycles for adolescent; bicycles for children), and in part similar to an average degree (buggies) to means of transport, excluding bicycles and children's bicycles; moving vehicles for children in Class 12 (§ 88).

28/11/2019, T-736/18, [Bergsteiger / BERG \(fig.\) et al.](#), EU:T:2019:826, § 88

#### **Comparison of goods in Class 12 – Electrically-powered motor scooters; mopeds; motorcycles – Bicycles – Low similarity**

The degree of similarity between *electrically-powered motor scooters; mopeds; motorcycles and bicycles* is low and not just below average (14/05/2019, T-12/18, Triumph, EU:T:2019:328, § 30-34) (§ 44-46, 48).

In the same vein, the degree of similarity between *non-motorised push scooters and bicycles* is not average but low (28/11/2019, T-736/18, Bergsteiger, EU:T:2019:826, § 86) (§ 49-52).



21/12/2021, T-159/21, [motwi \(fig.\) / Monty et al.](#), EU:T:2021:924, § 44-46, 48

#### **2.2.4.3 Electric apparatus/ instruments**

##### **Lighting apparatus for industrial use – Electric lights and decorations – Dissimilarity**

The goods under comparison have different purposes, namely practical and industrial purposes for the IR's goods, whereas the goods covered by the earlier marks are exclusively intended for decorative and aesthetic purposes for Christmas trees (§ 43). *Lighting apparatus for industrial use*, on the one hand, and *electric lights and decorations*, on the other hand, cannot be deemed to be similar on the mere basis that they are both *light sources* or *electrical lighting apparatus*. The fact that they might have the same distribution channels, are sold through the same commercial establishments and are used by the same customers is not sufficient for similarity. Finally, the goods covered by the IR are purchased mainly by professionals, while the relevant goods of the earlier marks are, as a rule, intended for the general public (§ 47-51).

19/03/2019, T-133/18, [Lumiqs \(fig.\) / Lumix et al.](#), EU:T:2019:169, § 43, 47-51

##### **Electric lights; electric lighting fixtures – Lighting mixers – Similarity**

There is a low degree of similarity between goods in Class 11, such as *electric lights; electric lighting fixtures; flashing strobe light apparatus* and *lighting mixers* in Class 9 (§ 50-53).

02/12/2020, T-687/19, [Marq / MARK \(fig.\) et al.](#), EU:T:2020:582, § 50-53

#### **Comparison of goods and services – Electric kitchen appliances – Containers for kitchen and household use – Similarity to a low degree**

Bread slicers; vegetable graters; non-hand operated coffee grinders; electric kitchen machines in Class 7 and containers for kitchen and household use in Class 21 are similar to a low degree. They are complementary and are used in the same operations. They also target the same consumers (§ 30).

There is a very low degree of similarity as regards *electric food choppers for household use*. It is implicit from the wording of the contested decision that the Board of Appeal compared it with 'containers for household and kitchen use' in Class 21 covered by the earlier mark. The goods have the same purpose (§ 32-35).

30/03/2022, T-451/21, [Testa Rossa / TESTA ROSSA \(fig.\)](#), EU:T:2022:172, § 30, 32-35

#### **Electric motors for vehicles (spare parts) – Retail of apparatus for accumulating electricity – No similarity**

There is no similarity between, on the one hand, rechargeable batteries intended, as spare, replacement or emergency parts, to be incorporated in specific electronically motorised vehicles, and, on the other hand, apparatuses for accumulating electricity (§ 43, 46).

The former are generally produced either directly by the producer of electronically motorised vehicles of which they form an integral part, or by an undertaking closely linked to it. They are aimed at a specific public, made up of producers and purchasers of these vehicles. Services for the retail of that type of battery are closely linked to after-sales services relating to the said vehicles (§ 42).

The latter are, rather, goods in their own right, which are intended to operate, indiscriminately, any type of electrical apparatus and may thus serve for multiple uses. Those standard products are available in all types of stores and are aimed at a wide and indeterminate group of professional consumers or consumers from the general public (§ 43, 44).

[22/06/2022, T-356/21, Hypercore / HIPERCOR \(fig.\) et al.](#), EU:T:2022:380

#### **2.2.4.4 Fashion and textile industries**

##### **Luggage and bags (especially sport bags) – Golf bags – Clothing – Similarity**

*Luggage and bags* (especially sport bags) share their nature and intended purpose with *golf bags and caddy bags* namely to transport items necessary for sport (§ 57). *Clothing* includes *sport clothing* and therefore *golf gloves*. Both may be sold in the same retail outlets, specifically sport shops. The goods are similar at least to a low degree (§ 61-63).

26/03/2019, T-105/18, [LILI LA TIGRESSE / TIGRESS](#), EU:T:2019:194, § 57, 61-63

##### **Clothing, footwear and headgear – Leather and imitations of leather and animal skins – Similarity**

Goods cannot be regarded as complementary on the ground that one is manufactured with the other (§ 36). There is no similarity between *clothing, footwear and headgear* and *leather and imitations of leather and animal skins* (§ 37).

Such complementarity not being a well-known fact, the similarity between *clothing, footwear, headgear* in Class 25 and *trunks and travelling bags, umbrellas, walking sticks, whips, harness and saddlery* in Class 18 needs to be proven by the party claiming it (§ 38).

*Clothing, footwear and headgear* of Class 25 and *jewellery, horological and chronometric instruments* in Class 14, are in general not associated with one another and are generally not produced by the same undertakings. Since it is not a matter of generally well-known facts, it is up to the party alleging similarity to prove the reality and alleged complementarity between the goods (§ 50-51).

27/06/2019, T-385/18, [CRONE \(fig.\) / crane \(fig.\) et al.](#), EU:T:2019:449, § 36-38, 50-51

### **Woven fabrics; knitted elastic fabrics for sportswear; textile goods – Clothing – Towels – Dissimilarity**

Woven fabrics; knitted elastic fabrics for sportswear; textile goods, and substitutes for textile goods; towels of textile; face towels; bath towels; hand towels; wash cloths in Class 24 are dissimilar to clothing in Class 25 (§ 40 and 44).

Woven fabrics; knitted elastic fabrics for sportswear (Class 24) are dissimilar to towels (Class 24) (§ 49).

15/10/2020, T-851/19, [SAKKATTACK \(fig.\) / Body attack et al.](#), EU:T:2020:485, § 40, 44, 49  
15/10/2020, T-788/19, [Sakkattack \(fig.\) / Attack et al.](#), EU:T:2020:484, § 46-50, 55

### **Goggles for sports – Bath towels – Clothing – Similarity – Textile goods, and substitutes for textile goods – Leather and imitations of leather – Similarity**

Goggles for sports (snow goggles, cyclists' glasses, swim goggles) in Class 9 are similar to a low degree to clothing in Class 25 (§ 100).

*Bath towels* in Class 24 are similar to an average degree to *clothing items* in Class 25 because the latter goods include bath robes (§ 128).

Textile goods, and substitutes for textile goods; fabrics; textiles, not included in other classes in Class 24 are similar to leather and imitations of leather in Class 18 on the basis that they are competing in primary materials and destined to same end users (§ 130).

09/09/2020, T-50/19, [Dayaday \(fig.\) - DAYADAY et al. \(fig.\)](#), EU:T:2020:407, § 100, 128, 130

### **Leather and imitations of leather – Goods made of leather and imitations of leather – Animal skins, hides – Home textiles – Dissimilarity**

Leather and imitations of leather in Class 18 are not similar to goods made of leather and imitations of leather in Class 18 (§ 54-59).

*Animal skins, hides* in Class 18 and *home textiles* in Class 24 are dissimilar (§ 60-61).

25/06/2020, T-114/19, [B \(fig.\) / b \(fig.\)](#), EU:T:2020:286, § 54-59, 60-61.

### **Wallets, purses, briefbags, handbags (...) and clothing for women, men, young people and children (...) – Textiles and textile goods, not included in other classes; bed covers; table covers – Dissimilarity**

The goods in Class 18 (wallets, purses, briefbags, handbags, casual bags, shopping bags, net bags for shopping, beach bags, holdalls, wheeled bags, bags (game -) [hunting accessories], bags for campers, bags for climbers, chests, backpacks, bookbags, suitcases, pouches,

keycases, cases of leather or leatherboard, boxes of leather or leatherboard, waistpacks, leather straps, straps for soldiers' equipment) and the goods of the earlier mark in Class 24 (textiles and textile goods, not included in other classes; bed covers; table covers) do not have the same intended purpose (the goods in Class 18 are intended to contain, collect, transport or store things, and the goods in Class 24 are fabrics for household use; functional and decorative goods able to serve both practical and ornamental purposes). Neither do they have the same distribution channels (the goods of the earlier mark are most often displayed near or on shelving units, whereas the contested goods are often displayed on shelves or in shops specialising in luggage or in clothing accessories). Furthermore, the manufacturers of those goods are not generally the same and the use of one is not necessary or important to the use of others. The goods are not therefore complementary or in competition (§ 45).

The goods in Class 25 (clothing for women, men, young people and children, clothing of natural and synthetic materials, knitwear (clothing), work clothing, protective clothing, waterproof clothing, beach clothing, sports clothing, gymnastics clothing; underwear for women, men, young people and children, women's suits, jackets, dresses, evening dresses, skirts, blouses, sweatshirts, clothing, costumes, uniforms, togas, cassocks, chasubles, suits, tailcoats, waistcoats, shirts, polo shirts, short-sleeve shirts (t-shirts), corsets, vests, jumpers, pullovers; trousers, trousers shorts, bermuda shorts, shorts, astronaut flight suits, tracksuits, overalls, coats, topcoats, coats, trench coats, coats, pelerines, windshirts, socks, leg warmers, stockings, body garments, tights, tights, leggings, pyjamas; robes, swimming costumes, swimming trunks, suspenders, ties, bowties, scarfs, scarves, shawls, neckerchiefs; caps (headwear), berets; veils; gloves; baby sleepsuits, layettes) and the goods of the earlier mark in Class 24 (textiles and textile goods, not included in other classes; bed covers; table covers), differ in many respects, such as in their nature, intended purpose, origin and distribution channels. The fact that these goods can be made from the same materials does not call those differences into question (§ 46).

08/09/2021, T-493/20, [Sfora wear / Sfera \(fig.\) et al.](#), EU:T:2021:540, § 45-46

### **Orthopaedic footwear and boots for medical purposes – Health shoes – Similarity**

*Orthopaedic footwear* and *boots for medical purposes* in Class 10, and *health shoes* in Class 25 are similar to a low degree (§ 53). They target a public composed of professionals and consumers who suffer from orthopaedic problems, whose level of attention is high (§ 41, 45).

The explanatory notes of the Nice Classification have to be taken into account since they are relevant in determining the nature and purpose of the goods and services under comparison. The explanatory note relating to Class 25 excludes *orthopaedic footwear*, which falls in Class 10. This leads to the conclusion that *orthopaedic footwear* or *footwear for medical purposes* must primarily be regarded as medical apparatus since their primary function is correcting physical handicaps of an orthopaedic nature (§ 55).

Contrary to *footwear*, *orthopaedic footwear* is directly prescribed by a physician or sold in specialised shops (§ 56). It is not produced industrially or in a standardised manner, but is tailored to each patient's needs (§ 57).

08/07/2020, T-20/19, [Mediflex easystep / Stepeasy \(fig.\)](#), EU:T:2020:309, § 41, 45, 53, 55, 57

08/07/2020, T-21/19, [mediFLEX easySTEP \(fig.\) / Stepeasy \(fig.\)](#), EU:T:2020:310, § 41, 45, 53, 55, 57

### **Gymnastic and sports articles – Games and toys – Difficult delimitation**

In certain cases, an exact delimitation between *gymnastic and sports articles* and *games and toys* is difficult (§ 50).

A 'continuous shift' is not entirely excluded between the clothing industry and the games industry on the basis that there is a tendency for game and toy manufacturers to also manufacture sports clothing, for example, which is particularly suitable for games, and vice versa (§ 51).

29/01/2020, T-697/18, [ALTISPORT \(fig.\) / ALDI et al.](#), EU:T:2020:14, § 50-51

### **Watches and sunglasses – Clothing – Dissimilarity – No aesthetic complementarity**

Aesthetic complementarity between goods may give rise to a degree of similarity. Such aesthetic complementarity must involve a genuine aesthetic necessity, in the sense that one product is indispensable or important for the use of the other and consumers consider it ordinary and natural to use those products together. That aesthetic complementarity is subjective and is determined by the habits and preferences of consumers, to which producers' marketing strategies or even simple fashion trends may give rise. However, the mere existence of aesthetic complementarity between the goods is not sufficient to conclude that there is a similarity between them. For that, the consumers must consider it usual that the goods are sold under the same trade mark, which normally implies that a large number of the producers or distributors of the goods are the same (§ 69).

Although the search for a certain aesthetic harmony in clothing is a common feature of the entire fashion and clothing sector, it is, nevertheless, too general a factor to justify, by itself, a finding that goods such as sunglasses and watches, on the one hand, and items of clothing, on the other, are complementary (§ 77).

[22/06/2022, T-502/20, Munich10A.T.M. / MUNICH X \(fig.\) et al.](#), EU:T:2022:387

### **Luggage – Clothing – Dissimilarity**

*Luggage* in Class 18 does not include *handbags*. *Luggage* has an essentially utilitarian function, designed to transport goods for the specific purpose of travel. Although *handbags* also have an essentially utilitarian function, being designed to carry items in the same way as *luggage*, they are distinguished by the fact that they also constitute a fashion accessory with an additional aesthetic function. *Luggage* and *handbags* have different functions and meet different needs of consumers. *Handbags* are not, in principle, regarded as *hand luggage* (§ 33-38).

*Luggage* in Class 18 and *clothing* in Class 25 are dissimilar. *Luggage* is generally sold in specialised sales outlets, which do not offer clothing. Unlike *clothing*, *luggage* has an essentially utilitarian function, and not an essentially aesthetic function. There is no reason for consumers to coordinate *luggage* with *clothing*. The decision to buy *clothing* is generally not influenced by, or subject to, the purchase or possession of *luggage*. The fact that *luggage* can be used to carry *clothing* does not allow the conclusion that the use or purchase of 'clothing' is indispensable for the use of *luggage* (§ 58, 65, 66, 69, 75, 77).

[01/03/2023, T-217/22, GREENWICH POLO CLUB GPC 2002 \(fig.\) / BEVERLY HILLS POLO CLUB \(fig.\) et al.](#), EU:T:2023:92

### **Bags for cyclists – Athletically-related footwear – Similarity to a low degree**

There is nothing to preclude the bags for cyclists from being used for activities other than cycling, since they serve to carry all kinds of objects, such as clothing and sports shoes. Likewise, 'athletically-related footwear' may be used to engage in all kinds of sports activities and includes sports shoes in general, including shoes for cyclists. Since the goods concerned may be manufactured by the same undertakings and sold in the same sales outlets, in particular in sports shops, they are similar to at least a low degree (§ 92).

[07/06/2023, T-63/22, BROOKS ENGLAND \(fig.\) / Brooks](#), EU:T:2023:312

### **Clothing, headgear and footwear – Gymnastic and sporting apparatus and articles – Similarity to a low degree**

*Clothing, headgear and footwear* in Class 25 may also include articles that are used for various sporting disciplines. Accordingly, these goods may be produced by the same manufacturers and marketed under the same mark as *gymnastic and sporting apparatus and articles* in Class 28. Furthermore, the goods in question may share the same distribution channels and may, in particular, be sold in the same specialist shops. In addition, they are complementary goods for certain sporting disciplines, the practice of which requires sporting articles, articles for protecting the body, and specific clothing to be used together (§ 38-39).

[29/06/2023, T-719/22, HERZO / HERNO \(fig.\) et al.](#)

### **Footwear parts such as soles – Footwear – Complementarity – Similar to average degree**

*Non slip soles for footwear; tips for footwear; boot uppers; footwear uppers; heelpieces for footwear; welts for footwear; soles for footwear; heels* are semi-finished goods used in making 'footwear' or parts used in the repair of 'footwear', and they have, a complementary relationship. Those goods serve no other purpose than to be integrated into the 'footwear' covered by the earlier mark. They are therefore essential for the use of the 'footwear' covered by the earlier mark, which makes it possible to conclude that all of the goods in question have a functional complementarity (§ 64, 69-71).

[26/07/2023, T-562/21 & T-590/21, Camel crown / camel active \(fig.\), EU:T:2023:440](#)

### **Blankets – Printers' blankets – Dissimilarity**

*Printers' blankets of textile* in Class 24 are parts made of textile material that are used in machines for printing. However, such goods are not similar to *blankets*, and the mere fact that both are made of textile material is not sufficient in this respect (§ 43).

[13/12/2023, T-608/22, Dreamer \(fig.\) / DREAMS et al., EU:T:2023:797](#)

### **Scope of protection of *retail of clothing and footwear* limited to items for human beings**

*Retail services of clothing and footwear* does not include the sale of footwear for animals and clothing for animals. It is not clear from the literal meaning of the terms 'footwear' and 'clothing', that those terms refer, respectively, to *footwear for animals* and *clothing for animals*. Moreover, it follows from the headings of Classes 18 and 25 of the Nice Classification, that those terms refer to 'clothing, footwear and headwear for human beings', unless it is expressly stated that those items are for animals (§ 24-25).

[17/01/2024, T-47/23, WILD INSPIRED / INSPIRED, EU:T:2024:12](#)

## **2.2.4.5 Food, beverages and restaurant services**

### **Chips – Tortillas, tacos, cereal preparations, bread – Similarity**

*Chips* and the contested goods (inter alia, *tortillas, tacos, cereal preparations, bread, snack foods products made from wheat, popcorn*) are distributed through the same channels and they may be manufactured by the same undertakings (§ 47-48, 54, 60, 65).

The contested goods can be consumed at any time of the day to satisfy a nutritional need, or as appetisers. Furthermore, some can be used as side dishes like the opponent's *chips* (§ 43, 53, 57, 59, 64). Therefore, they were considered similar or similar to a low degree (§ 49, 55, 61, 66).

17/09/2019, T-464/18, [Tia Rosa \(fig.\) / TÍA ROSA \(fig.\)](#), EU:T:2019:607, § 43, 47-49, 53-55, 57, 59-60, 64-66

### **Alcoholic drinks – Non-alcoholic drinks – Dissimilarity**

There is no similarity between alcoholic drinks such as *beers* and non-alcoholic drinks such as *coffee*, although they can be consumed together. The goods are dissimilar in that their nature, intended purpose and method of use are different. The beverages are consumed on different occasions and serve to satisfy different needs on the part of the consumer (§ 25-43).

12/12/2019, T-648/18, [Crystal / CRISTAL](#), EU:T:2019:857, § 25-43

### **Bottled drinking water; mineral water (non-medicated -); mineral water [beverages] – Alcoholic beverages (except beer); wine; sparkling wines; liqueurs; spirits [beverages]; brandy – Dissimilarity**

Due to the absence of alcohol in their composition, the nature of the goods referred to as *bottled drinking water; mineral water (non-medicated -); mineral water [beverages]* covered by the mark applied for, is different to the nature of the goods covered by the earlier mark, namely *alcoholic beverages (except beer); wine; sparkling wines; liqueurs; spirits [beverages]; brandy* (§ 40). The effects of alcohol consumption do not occur in the consumption of bottled water or mineral waters (§ 42). Moreover, for a non-negligible part of the EU public, alcohol consumption is likely to pose a genuine health problem (§ 42). The purpose and method of use of the goods in question are different. In contrast to the beverages referred to as *bottled drinking water; mineral water (non-medicated -); mineral water [beverages]*, alcoholic beverages are not generally intended to quench thirst and do not correspond to a vital need (§ 43-44). The goods in question are not complementary; they are not closely connected in the sense that the purchase of one is indispensable or important for the use of the other (§ 46-47). They are not in competition with each other (§ 56-64). In relation to the distribution channels, the fact that these goods may be sold 'in the same establishments' does not support the conclusion that the goods are similar (§ 66-68).

22/09/2021, T-195/20, [chic ÁGUA ALCALINA 9,5 PH \(fig.\) / Chic Barcelona et al.](#), EU:T:2021:601, § 40, 42-44, 45-47, 66-68

### **Beer and brewery products – Wines – Similarity to a low degree**

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

23/09/2020, T-601/19, [in.fi.ni.tu.de \(fig.\) / infinite](#), EU:T:2020:422, § 102-103

15/09/2021, T-673/20, [CÍCLIC \(fig.\) / Cyclic](#), EU:T:2021:591, § 50

### **Liqueurs – Beer and other alcoholic beverages – Similarity**

Liqueurs and beers are similar in nature since they contain a certain degree of alcohol. Their method of use and method of consumption are similar, since they may, inter alia, be served at events, their intended purpose coincides in that they are aimed at the adult public, since alcohol is normally consumed by persons over 18 years old, and their distribution channels are the same, since they are sold in the same way. Moreover, it is a well-known fact that many undertakings produce both beer and liqueurs, which are often based on beer. Admittedly, it is apparent from the case-law that mixing beer with certain alcohols, in particular tequila, does not remove the differences between those goods (03/10/2012, T-584/10, Tequila Matador hecho en Mexico EU:T:2012:518, § 55). However, as regards liqueurs, the exact purpose of some of them is to be

mixed, in particular with beer or wine. The difference in composition and method of production does not affect the consumer's perception (§ 67-73).

28/04/2021, T-31/20, [THE KING OF SOHO \(fig.\) / SOHO](#), EU:T:2021:217, § 67-73

### **Liqueurs – Preparations for the manufacture of liqueurs – Similarity**

Liqueurs and preparations for the manufacture of liqueurs are complementary. They may coincide in producers and distribution channels and may be aimed at the same public. Therefore, they are similar to an average degree (§ 75).

28/04/2021, T-31/20, [THE KING OF SOHO \(fig.\) / SOHO](#), EU:T:2021:217, § 75

### **Liqueurs – Alcoholic essences and alcoholic extracts – Similarity**

Liqueurs, on the one hand, and alcoholic essences and alcoholic extracts, on the other, could coincide in producers and distribution channels and may be aimed at the same public. They are therefore similar to a low degree (§ 74).

28/04/2021, T-31/20, [THE KING OF SOHO \(fig.\) / SOHO](#), EU:T:2021:217, § 74

### **Services for providing food and drink; coffee-shop services; restaurants – Cheese – Similarity**

The goods in Class 29, inter alia, *cheese*, are necessarily used in the serving of food and drink, with the result that those goods and those services are complementary. Firstly, cheese may be offered to the clientele of many restaurants, or even of coffee shops, by being incorporated as an ingredient in dishes which are intended to be sold on the premises or to be taken away. Secondly, cheese, without being processed as an ingredient, may be sold as it is to consumers, in particular in restaurants in which the activity is not confined to the preparation and serving of cooked dishes, but also consists of selling food which is intended to be consumed away from the place in which it is sold. Such goods are therefore used in and offered by means of *services for providing food and drink, restaurant services* or *coffee-shop services*. Those goods are consequently closely connected with those services (§ 45).

The complementary connection between cheese and services for providing food and drink, restaurant services and coffee-shop services must lead to the finding that there is a certain degree of similarity between, on the one hand, *services for providing food and drink; coffee-shop services; restaurants* in Class 43 and, on the other hand, *cheese* in Class 29. The possibility that the relevant public might be led to think that the services and the goods at issue have the same commercial origin cannot, from the outset, be excluded (§ 50, 51).

21/04/2021, T-555/19, [Grilloumi / Halloumi](#), EU:T:2021:204, § 45, 50, 51

08/12/2021, T-556/19, [GRILLOUMI / HALLOUMI et al](#), EU:T:2021:864, § 42-44

### **Restaurant services (food), self-service restaurants, cafeterias – Dry pasta of Italian origin – Low degree of similarity**

Despite their differences, foodstuffs, including goods in Classes 29 and 30, and restaurant services have a certain degree of similarity for a number of reasons. Firstly, the foodstuffs concerned are used and offered in the context of restaurant services, so there is complementarity between those goods and services. Secondly, the restaurant services can be offered in the same places as those in which the foodstuffs concerned are sold. Lastly, the foodstuffs concerned may originate from the same undertakings or from economically linked undertakings that market packaged goods, or from restaurants that sell ready-made food to take away (05/07/2016, T-518/13, MACCOFFEE, EU:T:2016:389, § 80) (§ 128).

Having regard to the complementarity between the goods and services, the BoA was fully entitled to conclude that there was a low degree of similarity between the *restaurant services (food), self-service restaurants* and *cafeterias* covered by the mark applied for and the *dry pasta of Italian origin* covered by the earlier Italian figurative mark 'ZARA' (§ 132).

01/12/2021, T-467/20, [ZARA / ZARA \(fig.\) et al.](#), EU:T:2021:842, § 128, 132

### **Prepared meals, snacks, flour, pastry, rice – Couscous (semolina) – Similarity**

Prepared meals, snacks; ready meals primarily with meat, fish, seafood or vegetables in Class 29 are similar at least to a very low degree to couscous (semolina) in Class 30 (§ 78).

Flour; pastry; prepared meals excluding meals which contain couscous; pastry dishes and pasta dishes excluding couscous; convenience food (excluding couscous) and savoury snacks; canned pasta foods excluding couscous; baked foodstuffs in Class 30 are similar at least to a very low degree to couscous (semolina) in Class 30 (§ 93-119). A limitation in the list of goods – in this case, the exclusion of couscous – does not, on its own, preclude a finding of similarity between the goods (16/05/2017, T-85/15, YLOELIS / YONDELIS et al., EU:T:2017:336, § 31) (§ 109).

Rice in Class 30 is similar to an average degree to the opponent's *couscous (semolina)* in the same class (§ 120,127).

25/11/2020, T-309/19, [Sadia \(fig.\) / SAIDA](#), EU:T:2020:565, § 78, 109, 120, 127

### **Eggs – Meat – Similarity**

The goods *eggs* and *meat* in Class 29 are similar to at least a low degree on account of their nature, purpose, use, distribution channels and business origin (§ 63-67, 70). The goods are not however complementary (§ 67-69).

23/09/2020, T-737/19, [MONTISIERRA huevos con sabor a campo \(fig.\) / MONTESIERRA](#), EU:T:2020:428, § 67-69

### **Infusions and tea – Dietetic beverages for medical use – Low similarity**

*Pollen prepared for human food use* in Class 29 and *propolis; royal jelly for human food use, not for medicinal use; herbal infusions not for medicinal use; infusions not for medicinal use* in Class 30 are similar to a low degree to *food and dietetic substances for medical use, food supplements, dietetic beverages for medical use* in Class 5. Similarly, *extracts of tea, tea, honey* in Class 30 are similar to a low degree to *dietetic beverages for medical use* in Class 5. It is difficult to identify a clear dividing line between products for medical and non-medical use, since they can all have a beneficial effect on human health, their purpose often overlaps, and they are used in parallel. In addition, some of them may share the same distribution channels, target audience and method of use (§ 41).

[03/05/2023, T-303/22, Vitis pharma \(fig.\) / viti DREN \(fig.\)](#), EU:T:2023:232

### **Alcoholic drinks – Non-alcoholic drinks – Relevant factors to take into account in the comparison of the goods**

The assessment of the similarity of the goods has to be carried out on the basis of the specific goods (in this case beverages) as included in the lists of goods covered by the marks at issue, taking into account all the relevant factors. Therefore, the conclusions regarding the similarity should not be based on general considerations relating to the differences between general categories of the goods (in this case alcoholic beverages, on the one hand, and non-alcoholic beverages or 'waters' and 'mineral waters', on the other) (§ 20, 23).

The distinction between alcoholic and non-alcoholic beverages is necessary, however it does not waive the obligation to make an assessment on the basis of the specific goods as included in the list of goods (§ 24). An approach limiting the comparison to the general categories of alcoholic and non-alcoholic beverages would essentially amount to establishing a general presumption that all beverages belonging to one of the two mentioned categories are not similar in composition solely on the basis of the characteristic of the presence or absence of alcohol. Such an approach would base the lack of similarity on only one factor (i.e. the nature of the goods), whereas the case-law does not establish that the nature of the goods generally takes precedence over the other factors (§ 25).

[24/05/2023, T-68/22, Joro / Joko, EU:T:2023:287](#)

### **Wine – Vodka – Similarity to a low degree**

Vodka and wine belong to the same broad category of alcoholic beverages. They share the same general purpose, that is, they are consumed for recreational or relaxation purposes. While the alcohol content in wine and vodka differs significantly, the alcohol content in both types of beverages exceeds a certain threshold, triggering the applicability of a regulation which subjects the consumer to the same rules, particularly regarding the minimum age for consumption. It is also because of their alcohol content that both products are consumed for relaxation rather than for quenching thirst (§ 58-59).

Moreover, spirits and wines are offered in the same sections, or adjacent sections, in supermarkets and grocery stores. They can also be purchased in the same specialised stores, especially in Member States of the EU where alcoholic beverages are sold exclusively through state-owned specialised stores. Like wine, vodka can also be consumed as an accompaniment to a meal. Furthermore, just like vodka, wine can also be used to cook dishes, sauces, desserts, and can be used in cocktails. There is also some competition between the products in question. It is also possible for wine and vodka to be manufactured or distributed under the same brand if it is the company's name (§ 60-68).

All in all, despite the differences between the products in question, particularly in terms of colour, aroma, taste, alcohol content, and organoleptic characteristics, vodka and wine are alcoholic beverages that meet, to some extent, the same need and are distributed in the same outlets, with the result that they are similar to a low degree (§ 69).

[12/07/2023, T-662/22, AURUS \(fig.\) / AUDUS, EU:T:2023:393](#)

### **Similarity of foodstuffs – Processed durable goods**

In the case of foodstuffs, the fact that the manufacturing process is different does not, in principle, constitute a decisive criterion for the comparison of the goods. Regardless of the differences between the manufacturing processes of 'fried onions' and 'processed olives', it cannot be excluded that these 'durable goods' are produced by the same companies or have the same distribution channels (§ 51).

[11/10/2023, T-52/23, SANTARRITA / Santa Rita \(fig.\), EU:T:2023:614](#)

### **Wines – Advertising – No complementarity – Dissimilarity**

The fact that the services of *advertising; business management; business administration; office functions* in Class 35 may be provided, inter alia, for the purpose of promoting, advertising, managing or administering undertakings that manufacture *wines* in Class 33, does not mean there is necessarily a link between them, because the services in Class 35 covered by the mark applied for may be provided for a vast range of goods of very different kinds (§ 37).

When examining whether the consumer generally expects there to be a link between the goods or services, account must be taken of the economic reality on the market as it currently exists. The fact that a service may be used at a stage in the production or packaging of a final product does not mean that the relevant public will assume that the contested service and the final product are offered by the same undertaking and are therefore complementary (§ 42-43).

[20/12/2023, T-655/22, WINE TALES RACCONTI DI VINO \(fig.\) / WT WINE TALES \(fig.\) et al., EU:T:2023:859](#)

#### **Relevant public – Food supplements for animals in Class 5**

'Food supplements and food additives for animals to enhance feeding effect' in Class 5 are not aimed solely at farmers or even solely at breeders, but also at the general public (e.g., pet owners) (§ 70).

[24/01/2024, T-55/23, SALVAJE \(fig.\) / SALVANA, EU:T:2024:30](#)

#### **2.2.4.6 Maintenance and repair services**

##### **Maintenance services – Repair services – Similarity**

The applicant's '*maintenance of doors (...), door frames, door locks and entrance areas*', and '*repair of doors*' covered by the earlier mark, both in class 37, are similar to a high degree, but not identical as found by the BoA (§ 77, 78).

[08/06/2022, T-738/20, Holux / Holux et al., EU:T:2022:343](#)

#### **2.2.4.7 Retail services**

##### **Retail services and related goods – Similarity**

There is a similarity between goods and the retail services which relate to those goods (16/10/2013, T-282/12, Free your style., EU:T:2013:533, § 37) (§ 29).

[28/05/2020, T-333/19, GN Genetic Nutrition Laboratories \(fig.\) / GNC GENERAL NUTRITION CENTERS et al., EU:T:2020:232, § 29](#)

##### **Similarity between goods and retail services only where the former are identical or similar to the goods to which the retail services relate**

*Retail and online retail store services* in Class 35 relating to goods in Class 3 and the *advertising; business management; business administration; office functions* services, are different from the goods in Class 5 covered by the earlier mark. More specifically, those goods and services are not complementary since the retail and online retail services relate to goods in Class 3. However, none of those goods is similar or identical to the goods in Class 5 covered by the earlier mark. Therefore, there is no close relationship between the services in Class 35 covered by the mark applied for and the goods in Class 5 protected by the earlier mark such as to establish that those goods and services were complementary (§ 52-58).

[15/09/2021, T-331/20, Le-vel / Level, EU:T:2021:571, § 52-58, 63](#)

##### **Food retail services – Couscous (semolina) – Similarity**

Food retail services; retail services relating to foodstuffs in Class 35 are similar to an average degree to couscous (semolina) in Class 30 (§ 136).

Similarity can be found between retail services of certain goods and goods which are not strictly identical to the goods subject to retail (09/06/2010, T-138/09, Riojavina, EU:T:2010:226, § 41-44, and 05/05/2015, T-715/13, Castello (fig.) / Castelló y Juan S.A. (fig.) et al., EU:T:2015:256, § 29-35) (§ 141).

Information, advisory and consultancy services in relation to food retail services; retail services relating to foodstuffs in Class 35 have a very low degree of similarity with couscous in Class 30 (§ 143-145).

25/11/2020, T-309/19, [Sadia \(fig.\) / SAIDA](#), EU:T:2020:565, § 136, 141, 143-145

### **Spectacles – Retail store services for sunglasses – Robes – Household textiles and linen – Similarity**

*Spectacles* is a broad term including *sunglasses*. Consequently, *spectacles* and *retail store services for sunglasses* have an average degree of similarity (§ 69, 71). *Robes* include bathrobes which are often absorbent robes worn before or after bathing and *household textiles and linen* include towels used to absorb moisture. They also have an average degree of similarity (§ 72-73).

12/07/2019, T-54/18, [1st AMERICAN \(fig.\) / DEVICE OF A BIRD \(fig.\)](#), EU:T:2019:518, § 69, 71, 72-73

### **Games – Service of retailing of sporting goods – Dissimilarity**

The goods *games* in Class 28 covered by the mark applied for are dissimilar to the *service of retailing of sporting goods* in Class 35 (§ 47). There is no complementarity between them and it has not been shown that they have the same distribution channels. The mere fact that the goods and services might be targeted at the same public is not sufficient to find similarity between them (§ 44-47, 50-51).

04/12/2019, T-524/18, [Billa / BILLABONG et al.](#), EU:T:2019:838

### **Health products – Wholesale and retail services – Similarity**

There exists a complementary relationship, and thus similarity, between goods which can be grouped under a relatively broad category, such as *health products*, and services such as *wholesale and retail services* which cover the same broad category, for example 'wholesale and retail services relating to health products'. The goods and services are closely connected since the goods are indispensable, or at least important, for the provision of the services in question (§ 29-30).

24/01/2019, T-800/17, [FIGHT LIFE / FIGHT FOR LIFE](#), EU:T:2019:31, § 29-30

### **Scope of protection of 'retail services' – Precise statement of the goods to which the retail services relate**

The concept of 'retail services' covers services, offered to consumers, consisting of bringing together, on behalf of the businesses occupying a shopping arcade's stores, a variety of goods in a range of stores to enable the consumer to conveniently view and purchase those goods, and offering a variety of services separate from the act of sale that seek to ensure that that consumer purchases the goods sold in those stores (§ 127).

The concept of 'retail services' includes a shopping arcade's services for consumers with a view to enabling them to conveniently view and purchase the goods (§ 130).

The case-law precedent set by the Praktiker judgment (07/07/2005, C-418/02, , EU:C:2005:425) only concerns applications for registration and does not concern trade marks registered at the date of that judgment's delivery (§ 133).

If an opposition is based on Article 8(1)(b) EUTMR and an earlier trade mark covering retail services that was registered after the Praktiker judgment's delivery, that ground of opposition may not be rejected simply because of the absence of a precise statement of the goods to which the retail services relate (§ 134).

04/03/2020, C-155/18 P to C-158/18 P, [BURLINGTON /BURLINGTON ARCADE et al.](#), EU:C:2020:151, § 127, 130, 133, 134

### **Scope of protection of *retail sales services* – Retail sales services' is not a vague term**

The earlier Spanish mark was registered for *retail sales services* before the Praktiker judgment (07/07/2005, C-418/02, Praktiker, EU:C:2005:425), which required further clarification of the services but did not apply retroactively. There had been a request for proof of use and the BoA found use for *retail services for handbags, purses and wallets made from leather, ready-made clothing and footwear*.

The GC stated that the term 'retail sales services' is not a vague term and covers the retail sale of any goods (§ 39) and endorsed the BoA's finding of proof of use for *retail services for handbags, purses and wallets made from leather, ready-made clothing and footwear* (§ 40-41).

26/03/2020, T-653/18, [GIORGIO ARMANI le Sac 11 \(fig.\) / LESAC et al.](#), EU:T:2020:121, § 39, 40-41

26/03/2020, T-654/18, [le Sac 11 \(fig.\) / LESAC et al.](#), EU:T:2020:122, § 39, 40-41

### **Retail services of vinegars – Wine – Low similarity**

"Wholesaling and retailing of vinegars" are lowly similar "wine". This conclusion was based on the BoA's finding that vinegars and wine were lowly similar and the consideration that the same degree of similarity is applicable regarding the commercialization services of one of them (§ 42). The reasoning in 05/05/2015, T-715/13, *Castello (fig.) / Castelló CASTELLÓ Y JUAN S.A. (fig.) et al.*, EU:T:2015:256 is not applicable to this case (§ 45).

[21/12/2022, T-250/19, Tradicion cz s.l. / Rivero cz et al.](#), EU:T:2022:838

### **Retail services of cosmetics – Perfumes – Similarity**

The relationship between the services provided in connection with the wholesaling, retailing and mail order sales and the goods covered by the earlier mark is close in the sense that the goods are indispensable to or, at the very least, important for the provision of those services, which are specifically provided when those goods are sold (§ 46). Therefore, such services are also similar, at least to a low degree, insofar as goods concerned by those services are commonly sold in the same places as the goods covered by the earlier mark (§ 47).

[11/10/2023, T-542/22, CALIFORNIA Dreaming by Made in California \(fig.\) / CALIFORNIA DREAM et al.](#), EU:T:2023:611

### **Retail of clothing and footwear – Retail of foodstuffs for animals – Dissimilarity**

If the list of services specifies the goods to which the retailing/wholesaling services relate, that specification must be taken into account as a relevant factor in the comparative assessment of the nature, the intended purpose and the method of use of those services. As the retailing/wholesaling services covered by the earlier mark relate to clothing for humans (and not

for animals), whereas the retailing services covered by the mark applied for concern food for animals, the retailing/wholesaling services at issue have a different subject matter and intended purpose and, therefore, are not in direct competition with each other (§ 35, 45).

[17/01/2024, T-47/23, WILD INSPIRED / INSPIRED, EU:T:2024:12](#)

### **Retail services of goods – Similar goods – Similarity**

The retail services, for the goods covered by the EUTM application that are identical and similar to an average degree to the goods covered by the earlier mark, must be regarded as similar to an average degree to the respective goods covered by the earlier mark. Retail services, for the goods covered by the EUTM application that are similar to a low degree to the goods covered by the earlier mark, must be regarded as similar to a low degree to the earlier mark's goods (§ 51).

[21/02/2024, T-765/22, LA CREME LIBRE \(fig.\) / LIBRE, EU:T:2024:106](#)

### **2.2.4.8 Financial services**

#### **Financial services – Software – Well-known facts – Similarity**

It is a well-known fact that most financial institutions develop and maintain their own software platforms (§ 40). Software specifically designed to be used in the context of financial affairs has a close connection with financial affairs, monetary affairs, financial advice, financial information and financial sponsorship and are similar to an average degree (§ 44, 45, 52).

[04/05/2022, T-237/21, FIS \(fig.\) / Ifis et al., EU:T:2022:267, § 44, 45, 52](#)

### **2.2.4.9 Transport, packaging and storage**

#### **Plastic safety boxes and closures therefor – Diverse toolboxes – Identity**

Plastic safety boxes and closures therefor are identical to boxes made of plastics materials for packaging of tools and machines as well as their parts and accessories; plastics components for packaging containers for tools and machines as well as their parts and accessories; boxes (packaging -) in made-up form [plastic] for tools and machines as well as their parts and accessories; sales containers of plastic for tools and machines as well as their parts and accessories; electric boxes of plastic for tools and machines as well as their parts and accessories; tool storage containers (non-metallic -) [empty], in Class 20, which are in essence toolboxes (§ 42, 53).

[15/10/2020, T-49/20, ROBOX / OROBOX, EU:T:2020:492, § 42, 53](#)

#### **Plastic safety boxes and closures therefor – Plastic inserts [trays] for tool boxes – Similarity**

Plastic safety boxes and closures therefor are similar to plastic inserts [trays] for tool boxes; organisation systems of plastic for toolboxes; sales packaging of plastic which also services as an organisation system for toolboxes in Class 20, which are in essence plastic accessories for toolboxes (§ 43, 53).

[15/10/2020, T-49/20, ROBOX / OROBOX, EU:T:2020:492, § 42, 53](#)

#### **Transport services – Similarity**

'Transport services of vehicles and their components by road or ship' and 'transport services of construction materials' are highly similar (§ 88-92).

The comparison of the services does not include the comparison of the undertakings which provide them. Only the description of the services in respect of which registration of the mark was sought and those in respect of which proof of use of the earlier mark has been proven is relevant. In the present case, the transport undertakings, in an abstract manner, could offer their services to different sectors and in relation to a wide range of goods including, for example, vehicles and their parts and components or building materials. Therefore, it follows from the foregoing that the relevant public, faced with those transport services, is likely to perceive them as originating from the same undertaking (§ 91).

06/04/2022, [T-219/21, TRAMOSA \(fig.\) / TRAMO,SA TRANSPORTE MAQUINARIA Y OBRAS,S.A. \(fig.\)](#), EU:T:2022:219, § 88-92

#### 2.2.4.10 Information technology

##### **Head ends for cable networks – ‘Parts’ and ‘accessories’ – Vaguely defined terms**

An EUTM proprietor cannot gain from the vague wording of the goods covered by its marks. In particular, in the event of complex goods, the terms ‘parts’ and ‘accessories’ used in the wording of the goods are vaguely defined terms and cannot be taken into account for assessing the similarity or complementarity of goods and services (§ 30).

26/03/2020, T-312/19, [Chameleon / Chameleon](#), EU:T:2020:125, § 30

##### **Computers – Smart phones – Similarity**

*Computers and smart phones; mobile phones; wearable smart phones* in Class 9 have at least an average degree of similarity (§ 50-53, 55).

18/11/2020, T-21/20, [K7 / K7](#), EU:T:2020:550, 50-53, 55

##### **Downloadable computer programs, being intended for use in connection with musical instruments and sound recording apparatus – Security software that allows users to secure and access their mobile devices through multi-dimensional facial recognition identification – Low degree of similarity between software due to different function**

Software must be understood in relation to the operations it performs and therefore in relation to its function. As such, the consumer will be guided primarily by the specific function of the product rather than by its nature (§ 51). Almost no electronic or digital equipment works without the use of computers. As a result, there exists a multitude of software with radically different functions (§ 52).

The function criterion, and therefore the criterion of intended use, assumes overriding importance among the relevant factors to be taken into account (software to be used with musical instruments and sound recording apparatus / security software to secure and access mobile devices through multi-dimensional facial recognition identification) (§ 53).

Where the intended purpose of the goods is specified with a certain degree of precision, it helps to differentiate them beyond their common nature as software (§ 57). They are not complementary (§ 58). The same distribution channels (App Store / Google Play Store) are a factor to be taken into account, but a multitude of software with radically different functions can be found in physical/virtual stores. Consumers will not automatically believe they have the same origin (§ 60). Users generally identify the desired function and then launch a search for all the applications available that perform that function. Even if a consumer searches for the desired application by name, the search will ultimately be guided by the desired function (§ 61).

In the present case, although software is involved for both signs, the intended purpose of the goods covered by the earlier figurative mark is to edit and alter sounds while recording, whereas

the intended purpose of the goods covered by the contested mark is to enable users to secure and access mobile devices through multidimensional facial recognition identification (§ 49). There is only a low degree of similarity between the goods (§ 62).

30/06/2021, T-204/20, [ZOOM / ZOOM \(fig.\) et al.](#), EU:T:2021:391, 51-53, 61-62

#### **Software products – Overlap between the intended purposes – Complementarity – Competitive relationship – Similarity**

The software products under comparison are similar to an average degree. Data processing concerning real estate covered by the earlier mark requires the features of organisation and management of internal data, which are also present in the data governance software products covered by the marks applied for. The facilities management or house and/or real estate administration software products covered by the earlier mark generate a large volume of data and incorporate certain functionalities for the organisation and management of that data, functionalities which they share with data governance software products. Therefore, there is an overlap between the intended purposes of the software products (§ 93-95).

The software products covered by the earlier mark, namely real estate management and facilities management software products, and the services covered by the word mark applied for in Class 42 concerning data governance software products, are similar. All these software products may be designed and developed by the same companies and, in the field of information technology, software manufacturers will also commonly provide software services. In addition, the end users and the manufacturers of the goods and services coincide (§ 121).

22/09/2021, T-128/20 & T-129/20, [Collibra / Kolibri et al.](#), EU:T:2021:603, § 93-95, 121

#### **Application software – Social services, namely arranging groups sharing interests and dating via social networks – Dissimilarity**

Application software in Class 9 (without an indication of the nature of the application) and providing use of software applications through a website in Class 41 are dissimilar to social services, namely arranging groups sharing interests and dating via social networks in Class 45 (§ 81-83).

23/09/2020, T-421/18, [MUSIKISS / KISS \(fig.\) et al.](#), EU:T:2020:433, § 81-83

#### **Entertainment services provided via a website – Social services, namely arranging groups sharing interests and dating via social networks – Dissimilarity**

Entertainment services provided via a website in Class 41 are dissimilar to social services, namely arranging groups sharing interests and dating via social networks in Class 45. They differ in nature and immediate purpose and there is no close complementary or competitive relationship between them (§ 75-76).

23/09/2020, T-421/18, [MUSIKISS / KISS \(fig.\) et al.](#), EU:T:2020:433, § 75-76

#### **Radio broadcasting services – Advertising, including online – Dissimilarity**

Radio broadcasting services in Class 38 are dissimilar to advertising, including online, in particular advertisements, for others (§ 86-87) and to employment agencies, in particular in connection with music or for those interested in music in Class 35 (§ 94-96), due to, inter alia, the different nature and purpose of these services.

23/09/2020, T-421/18, [MUSIKISS / KISS \(fig.\) et al.](#), EU:T:2020:433, § 86-87, 94-96

### **Games and toys – Interactive television and/or audiovisual games – Similarity**

*Games; toys* in Class 28 are similar to *interactive television and/or audiovisual games* in Class 9 (§ 64). In the past, the Court has already found similarity between games in Class 28 and games in Class 9 (19/04/2016, T-326/14, HOT JOKER / JOKER et al., EU:T:2016:221, § 59) (§ 61).

16/12/2020, T-863/19, [PCG CALLIGRAM CHRISTIAN GALLIMARD / GALLIMARD et al.](#), EU:T:2020:632, § 61

### **Comparison of goods and services – Games software, apparatus for electronics games and teaching materials in form of games – Computers – Similarity**

*Games software* in Class 9 covered by the mark applied for and *computers* in the same class covered by the earlier mark are similar (§ 47-53).

Apparatus for electronic games (other than those adapted for use with television receivers only; audio visual games on computer hardware platforms', automatic games apparatus, other than coin-operated and those adapted for use with television receivers only; electronic game consoles; game apparatus for use with television receivers only in Class 28 covered by the mark applied for and computers in Class 9 covered by the earlier mark are similar. The same applies to teaching materials in the form of games, which may also consist of video games that can be used on computers. They share the same manufacturers, the same public and the same distribution channels as computers. The goods are similar (§ 59, 62-66).

Games via cellular telephones; games via cellular telephones or for use on the aforesaid telephones, providing games by mobile telephone communication; provision of games by or for use on cellular telephones in Class 41 are complementary to telecommunications devices in Class 9 covered by the earlier mark. Those services are provided by telephone or are intended to be used on telephones. They are similar (§ 68, 71-72).

Providing computer and telecommunications technology training, information on on-line computer games and other on-line entertainment; games offered online (on a computer network) are similar, at least to a low degree, to computers in Class 9 (§ 75).

02/03/2022, T-171/21, [FOR HONOR \(fig.\) / Honor et al.](#), EU:T:2022:104, § 47-53, 59, 62-66, 68, 71-72, 75

### **Software – Printers and laser printer accessories – Similarity**

Printers and software are similar to a low degree in that software is important or indispensable for the use and proper functioning of printers. Printers are devices used to print the result of processing with a computer on paper, so there is a close relationship between software and printers (§ 27).

As regards laser printer accessories, those are, for example, printer cartridges and print heads. In particular, the printer's software detects whether the printer cartridge is properly inserted and filled or whether the printhead is defective or incompatible. Consequently, laser printer accessories and software are complementary goods. Moreover, these goods are sold in the same computer stores and thus share the same distribution channels (§ 28).

[15/02/2023, T-8/22, TCTC CARL \(fig.\) / carl touch \(fig.\)](#), EU:T:2023:70

### **Gaming software – Recorded content and data recorded electronically – Identity**

The contested goods *computer game software* in Class 9 are included in the broad categories of *recorded content* and *data recorded electronically* in the same class. Even if the goods covered by the trade mark applied for were to be sold exclusively on the internet, the EUTM applicant does not establish that the goods covered by the earlier trade mark are not also sold online (§ 48-50).

#### 2.2.4.11 Education

##### **Teaching and instructional and teaching material – Teaching and CDs, CD-ROMs, DVDs, computer software – Similarity**

Teaching and instructional and teaching material (except apparatus) are similar (§ 45).

Teaching and CDs, CD-ROMs, DVDs; computer software; electronic publications (downloadable); audio and video files (downloadable) are similar since these goods are commonly used for offering teaching services (§ 46).

24/09/2019, T-497/18, [IAK / IAK - Institut für angewandte Kreativität](#), EU:T:2019:689, § 45-46

##### **Arranging of conferences – Training services – Similarity to a low degree**

'Arranging and conducting of symposiums, congresses, conferences, seminars and colloquiums' (Class 41) of the contested mark are similar to the 'training' services in the field of music (Class 41) covered by the earlier mark. They can have the same purpose as they can be provided for the purpose of sharing knowledge and experience as well as for teaching and exchange purposes. Moreover, they may be offered by the same service providers and targeted at the same public (§ 53).

[07/09/2022, T-730/21, KOMBI / kombii, EU:T:2022:521](#)

##### **Education services related to cannabis – Pharmaceuticals for mouth inflammations – Low similarity – Application by analogy of the case-law related to retail services**

In light of the principles of case-law in relation to retail services, the education services related to marijuana in Class 41 covered by the contested mark were different from the goods covered by the earlier mark (pharmaceuticals for mouth inflammations). As with the services in Class 35, the goods in Class 5 (cannabis products) to which the services in question relate are at most similar to a low degree to the goods covered by the earlier mark. Such a degree of similarity is not sufficient to establish a complementary relationship between the services in Class 41 covered by the mark applied for and the goods covered by the earlier mark, so there can be no similarity between those services and the goods covered by the earlier mark (§ 71).

[13/03/2024, T-206/23, Sanoid \(fig.\) / SANODIN, EU:T:2024:164](#)

#### 2.2.4.12 Other

##### **Products and preparations for the breeding of birds, reptiles and amphibians – Food for fish – Dissimilarity**

Products and preparations for the breeding of birds, reptiles and amphibians in Class 31 and veterinary, therapeutic, disinfecting and sanitary products and preparations for use in terraristics in Class 5, on the one hand, and food for fish, on the other, are dissimilar because it is unlikely that 'a consumer who wishes to set up an aquarium or breed fish will also buy goods intended for birds, reptiles or amphibians' (§ 57). The mere fact that these goods fall within the same market segment and use the same distribution channels is insufficient for finding them similar (§ 41, 61).

12/07/2019, T-276/17, [Tropical \(fig.\) / TROPICAL](#), EU:T:2019:525, § 41, 57, 61

### **Figurines for ornamental purposes – Lamp shades, lampshade holders, lighting lamps – candlesticks – Perfume vaporizers – Similarity**

Figurines for ornamental purposes in Classes 6, 19, 20 and 21 and lamp shades, lampshade holders, lighting lamps, standard lamps, electric lamps chandeliers, ceiling lights in Class 11, picture frames; mirrors (looking glass); decorative panels; decorative wall plaques (not of textile) in Class 20, candlesticks; candelabras (candle holders); decanters; candlesticks; fruit cups; crystal (glassware); enamelled glass; signboards of porcelain or glass; candle extinguishers; earthenware, flasks, perfume vaporizers; vases in Class 21 are similar to a low degree (§ 51).

23/09/2020, T-608/19, [Veronese \(fig.\) / VERONESE](#), EU:T:2020:423, § 51

### **Sporting activities – Gambling and gaming services – Similarity – Cultural activities – Services of editing or recording of sounds and images – Similarity**

*Sporting activities* in Class 41 are similar to a low degree to *gambling and gaming services* in the same class, since the services under comparison are complementary and coincide in their purpose and their marketing channels (§ 36-38, 40). *Cultural activities* in Class 41 are also similar to a low degree to the *services of editing or recording of sounds and images, sound recording services, and video entertainment and gaming services* in the same class (§ 42).

25/11/2020, T-874/19, [Flaming forties / 40 FLAMING FRUITS \(fig.\)](#), EU:T:2020:563, § 36-38, 40, 42

### **Advertising – Rental of advertising equipment – Similarity**

The services of rental of advertising equipment and materials are indispensable or, at the very least, important for the provision of advertising services and vice versa, so that consumers may think that responsibility for the provision of those services lies with the same undertaking. Consequently, there is a close link between those services, in that one is indispensable or important for the use of the other (§ 34). They also share the same purpose (§ 38).

08/11/2023, T-592/22, [Liquid+Arcade / LIQUIDO \(fig.\)](#), EU:T:2023:708

## **2.3 COMPARISON OF THE SIGNS**

### **2.3.1 Distinctive and dominant elements**

#### **2.3.1.1 Banal elements**

[No key points available yet.]

#### **2.3.1.2 Negligible elements**

### **Illegible trademarks – Illegibles word elements**

Not only must a sign which is actually impossible to read or decipher be regarded as illegible, but also a sign which is so difficult to decipher, understand or read that a reasonably observant and circumspect consumer cannot manage to do so without making an analysis that goes beyond what may reasonably be expected of him in a purchasing situation (02/07/2008, T-340/06, Stradivari 1715, EU:T:2008:241, § 34).

That is so in the present case with respect to the word element 'ac' [in the sign applied for] in view of its very small size and less prominent position in the sign applied for, which make it hardly noticeable at first sight. Moreover, the average consumer will have even greater difficulty reading

it because he does not proceed to analyse the various details of a mark when making a purchase (§ 41).



19/06/2019, T-28/18, [AC MILAN \(fig.\) / AC et al.](#), EU:T:2019:436, § 41, 116

### **Assessment of the similarity between the signs – Irrelevance of the distinctive character (inherent or through reputation)**

The distinctive character (inherent or through reputation) of the earlier mark is not relevant for the assessment of the similarity between the signs (11/06/2020, C-115/19 P, CCB (fig.) / CB (fig.) et al, EU:C:2020:469, § 56-59) (§ 42, 44).

16/06/2021, T-196/20, [Incoco / Coco et al.](#), EU:T:2021:365, § 42, 44

#### **2.3.1.3 Weak or descriptive elements**

### **No LOC – Low distinctive character of common verbal element – Respective weight of the word and figurative elements**

Where a sign consists of both figurative and word elements, it does not automatically follow that the word elements must always be considered to be more distinctive than the figurative elements. In the case of a composite mark, the figurative element may, in particular on account of its shape, size, colour or position in the sign, rank equally to the word element (23/11/2010, T-35/08, Artesa Napa Valley, EU:T:2010:476, § 37, 39) (§ 68, 74, 79, 95).



23/09/2020, T-608/19, [Veronese \(fig.\) / VERONESE](#), EU:T:2020:423, § 68, 74, 79,

95

### **No LOC – Respective weight of word elements and figurative elements – Descriptive element as part of a composite mark**

The public will not generally consider a descriptive or weakly-distinctive element forming part of a composite mark to be the distinctive and dominant element in the overall impression conveyed by that mark (§ 57). In a composite sign, the figurative element may therefore rank at least equally with the word element (24/10/2018, T-63/17, Bingo VIVA! Slots (fig.) / vive bingo (fig.), EU:T:2018:716, § 43 and the case-law cited) (§ 58).

The relevant Greek public's knowledge of English as a foreign language cannot, in general, be assumed. According to the submitted evidence, the Greek public has different levels of knowledge of English. The relevant Greek public will understand the word 'museum' (not disputed), however a non-negligible part of the relevant Greek public will not understand the word 'illusions' (§ 52). The existence of the 'museum of illusions' in Athens does not make it possible to conclude that the whole of the relevant Greek public knows the term 'illusions' (§ 53).

The part of the relevant Greek public that does not understand the word 'illusions' will perceive the expression which is common to the signs, namely 'museum of illusions', as referring to a museum of the same type or relating to the same theme, even though it will remain unaware of the specific type or theme of that museum (§ 54-55). Consequently, even for the part of the relevant Greek public that does not understand the word 'illusions', the expression will be perceived as being descriptive of the services, namely museum services. The expression 'museum of illusions' contained in the signs is therefore of weak inherent distinctive character (§ 56-58). Accordingly, the expression 'museum of illusions', considered as a whole, does not

constitute the dominant element in the signs (as the BoA incorrectly concluded), but contributes in the same way as the figurative elements of those signs to the overall impression created by those signs (§ 59-60).



12/05/2021, T-70/20, [MUSEUM OF ILLUSIONS \(fig.\) / MUSEUM OF ILLUSIONS \(fig.\)](#), EU:T:2021:253, § 52-60

#### **No LOC – Weakly distinctive elements – Degree of distinctive character to be taken into account in the comparison of the signs – Impacts of the endings of word marks**

Where the endings of word marks composed of two elements possess no visual, phonetic or even conceptual similarity, they are able to compensate for the visual, phonetic and even conceptual similarities that result from the presence of the weakly-distinctive beginning component, 'natura', common to both signs (§ 43, 44, 50). Since the inherent distinctiveness of the earlier mark in the light of the two components of the word sign is weak (§ 75), the signs are globally different in the overall impression they produce in the mind of the relevant public (§ 76). There is no LOC, notwithstanding the identity of the goods (§ 77).

For a trade mark of weak distinctive character, the degree of similarity between the signs should be high to justify a LOC, otherwise there would be a risk of granting excessive protection to that trade mark and its proprietor (§ 56).

05/10/2020, T-602/19, [Naturanove-Naturalium](#), EU:T:2020:463, § 43, 44, 50, 56, 55-77

#### **No LOC – Common descriptive element – Degree of distinctive character to be taken into account in the comparison of the signs – Weak distinctiveness of the earlier mark**

Where the elements of similarity between two signs relate to the fact that they share a weakly distinctive component, the impact of such elements of similarity in the global assessment of the LOC is itself weak (22/02/2018, T-210/17, TRIPLE TURBO (fig.) / ZITRO TURBO 2 (fig.), EU:T:2018:91, § 73; 13/12/2007, T-242/06, El charcutero artesano, EU:T:2007:391, § 85, and 04/03/2015, T-558/13, FSA K-FORCE, EU:T:2015:135, § 49-52).

Bearing in mind the, at best, weak visual, phonetic and conceptual similarity between the signs, the fact that they share a descriptive element, the weak distinctiveness of the earlier EU trade mark and the high level of attention of the professional public, there is no LOC, even though the services in question are identical. This finding also applies to the earlier UK trade marks (§ 59).



WORKSPACE

28/05/2020, T-506/19, [Uma workspace / WORKSPACE \(fig.\) et al.](#), EU:T:2020:220, § 49-52, 59

#### **No LOC – Weak distinctive character of elements of the earlier mark – Shape marks – Application of 12/01/2006, C-173/04 P, Standbeutel, EU:C:2006:20, § 34 to relative grounds**

The BoA was right in taking into account a sector wider than that of mineral water. The earlier mark represents a transparent bottle of a common shape in the wide sector of beverage packaging and does not have any particular appearance that differentiates it from the conventional presentation of bottles on the market. Therefore, such a shape does not constitute an indication of origin, as it is not capable of individualising the relevant goods and services and

distinguishing them from those having another commercial origin. It has, at most, a weak inherent distinctive character (§ 66-67).



12/05/2021, T-637/19, [Aqua Carpatica \(3D\) / VODAVODA \(3D\)](#), EU:T:2021:222, § 66-67



12/05/2021, T-638/19, [AC Aqua AC \(3D\) / VODAVODA \(3D\)](#), EU:T:2021:256, § 66-67

### **LOC – Distinctive and dominant elements – Abbreviations – Distinctive element not perceived as descriptive for a significant portion of the relevant public – Weak elements**

The element ‘hylo’ of the earlier mark is a Greek-language prefix used in relation to wood or materials. In German, it is used in the word ‘hylotrop’, which, according to the Duden online dictionary ([www.duden.de](http://www.duden.de)), relates to ‘chemical compositions that can be converted into other forms’. The use of a term in extracts from Internet sites cannot suffice to establish the frequency with which that term is used, even by a specialist public (16/12/2010, T-286/08, Hallux, EU:T:2010:528, § 47) (§ 58). For a significant portion of the relevant public, that term, which is not frequently used in German, does not have any meaning. Therefore, it is not perceived by a significant portion of that public as being descriptive of the goods of the earlier mark (§ 57, 60).

The element ‘vision’ common to the marks has a weak distinctive character (§ 66). The ‘hydro’ of the mark applied for will be perceived by the relevant public as referring to water and therefore has a weak distinctive character (§ 67). Also, the figurative element is of weak distinctive character (§ 69). All the elements of the signs have to be considered in the context of their comparison (§ 73).

The signs have an average degree of visual similarity (§ 82) and a high degree of phonetic similarity (§ 89), and are conceptually similar in part for the part of the relevant public that understands the term ‘vision’ (§ 95). Even if the earlier mark has an average degree of distinctiveness (§ 108), the identity of the goods and the similarities between the signs are sufficient to conclude that there is a LOC for the German-speaking part of the relevant public (§ 118).

**Hydrovision**

27/01/2021, T-817/19, [Hydrovision \(fig.\) / Hylō vision](#), EU:T:2021:41, § 57-60, 67, 73, 82, 95, 108, 118

### **No LOC – Distinctive and dominant elements – Terms considered as basic English – No negligible elements**

The English word ‘big’ forms part of basic English vocabulary (§ 85).

The weak distinctive character of the word element does not suffice to make it negligible and therefore it has to be taken into account. The weak distinctive character of an element of a mark does not necessarily mean that that element will not be taken into consideration by the relevant public by reason in particular of its position in the sign or its size or its length (§ 86-87, 89).

02/03/2022, T-125/21, [Eurobic / BANCO BiG BANCO DE INVESTIMENTO GLOBAL \(fig.\) et al.](#), EU:T:2022:102, § 86-87, 89

### **LOC – Weak distinctive common element – Visual comparison of signs – Earlier mark entirely contained in the mark applied for**

As regards the distinctive character of the element ‘delta’, which is common to the signs at issue, neither the potential meanings of that term, nor the argument that the term ‘delta’ is frequently used in many fields, can establish that that element is weakly distinctive with regard to the goods at issue (§ 101).

The fact that the earlier mark is entirely contained in the mark applied for is an indication that the two marks are visually similar (§ 105).

23/03/2022, T-146/21, [Deltatic / Delta](#), EU:T:2022:159, § 105, 101

### **LOC – Weak elements – Acronyms – Slogans – Phonetic comparison – Conceptual comparison – Impact of weak elements on the global assessment**

The word elements ‘ALL’ and ‘MAX’ present in the earlier marks correspond to basic English words, and both have definite laudatory connotations. When used in relation to nutritional goods and related services, they will be understood as alluding to the total or greatest possible capacity to satisfy specific nutritional needs. Therefore, they have only a weak distinctive character. The word element ‘NUTRITION’, which will be understood as referring to the purpose of the goods and services concerned, is also distinctive to a low degree (§ 41-43).

The weak distinctive character of an element of a mark, owing in particular to its descriptive character, does not necessarily imply that that element will not be taken into consideration by the relevant public. Thus, it cannot be ruled out that, in particular because of its position in the mark or its length, such an element holds an autonomous position in the overall impression conveyed by the mark in question in the relevant public’s perception. Likewise, despite its weak distinctive character, a descriptive element of a mark is likely to attract the attention of the relevant public because of its length and position at the beginning of that mark (§ 47).

It is not disputed that a significant part of the English-speaking part of the relevant public is likely to perceive the figurative element present in the contested mark as the stylised acronym ‘an’ of its two word elements ‘all’ and ‘nutrition’, in particular because the two shades of blue in which those two word elements are represented are reproduced in that figurative element. Since there is a semantic link between the contested mark’s figurative element and its word elements, it cannot be concluded that the figurative element has greater weight than the word elements. As an acronym, the figurative element occupies only an ancillary position in relation to the two word elements (§ 59).

As an advertising slogan, the verbal element ‘designed for motivation’, present in the contested mark, has only a weak distinctive character. Therefore, considering its smaller size, it plays only a secondary role and has hardly any impact on the overall impression produced by that mark (§ 62-64).

Because of its size and position, the relevant public will not verbalise the advertising slogan ‘designed for motivation’, which is present in the contested mark (§ 75).

The common word element ‘nutrition’ is relevant to the conceptual comparison of the conflicting marks (§ 79).

Where the elements of similarity between two marks result from the fact that they share a component with a weak distinctive character, the impact of those similar elements on the global assessment of the LOC is itself low. However, if the other components of the marks at issue which are not shared have an even weaker distinctive character, the impact of shared elements with a weak distinctive character on the global assessment of the LOC is not, in fact, reduced (§ 86-87).

30/03/2022, T-35/21, [ALLNUTRITION DESIGNED FOR MOTIVATION \(fig.\) / Allmax nutrition et al.](#), EU:T:2022:173, § 41-43, 47, 59, 62-64, 79, 86-87

### **Distinctive and dominant elements – Weak common element**

The weak distinctive character of an element of a composite mark does not necessarily imply that that element cannot constitute a dominant element, since it may, on account, in particular, of its position in the sign or its size, make an impression on consumers and be remembered by them. That is the case here with regard to the figurative element representing a diamond which the marks at issue have in common, an element which is not negligible in relation to the respective word elements 'ADI' and 'ASI' and is likely to be remembered by the relevant public (§ 43, 44).

The marks at issue have in common a large figurative element representing a diamond. In spite of the weak distinctive character of that element, the high degree of similarity between those two figurative elements in common accentuates the fact that there is an average degree of visual similarity between the marks at issue which goes beyond a low degree of visual similarity, it being, however, understood that that similarity is mainly due to the distinctive word elements in those marks, namely 'ADI' and 'ASI' (§ 50).

As regards conceptual comparison, the diamond figurative element cannot be disregarded on account of its size and position. The marks are conceptually identical. However, where a conceptual similarity is based on a weakly distinctive, or even descriptive, element, it plays a limited role and has less impact on the assessment of the likelihood of confusion (§ 54-57).



04/05/2022, T-4/21, [ASI ADVANCED SUPERABRASIVES \(fig.\) / ADI \(fig.\) et al.](#), EU:T:2022:274, § 43, 44, 50, 54-57

### **LOC – Descriptive elements – Basic English words**

The element 'skintegra' dominates the overall impression created by the mark applied for and the element 'skin', although descriptive, must be taken into account in the analysis of the similarity of the signs. (§ 70, 82).

The term 'skin' is part of basic English vocabulary and it is likely to be understood by a large part of the general public, even non-English-speaking, including the relevant German public, as referring to the skin, particularly in view of the nature of the goods at issue, which are body and skin care products (§ 89, 90).



11/05/2022, T-93/21, [SK SKINTEGRA THE RARE MOLECULE \(fig.\) / Skintegrity et al.](#), EU:T:2022:280, § 70, 82, 89, 90

### **LOC – Descriptive elements – Overall impression**

To accept that a word element in the earlier mark is descriptive, does not mean that there is no longer any need to take that element into consideration when comparing the contested mark with the earlier mark (§ 116).



27/04/2022, T-181/21, [SmartThinQ \(fig.\) / SMARTTHING \(fig.\)](#), EU:T:2022:247, § 116

### **No LOC – Weak earlier mark – Common descriptive element – Low visual similarity – Low conceptual similarity**

Before assessing the similarity of the signs, it is necessary to examine the distinctive and dominant elements of the signs (§ 41). Descriptiveness of an element which is common to two signs ('Shop') considerably reduces the relative weight of such an element in the comparison of

those signs, including the visual and phonetic comparison, even though its presence must be taken into account (05/10/2020, T-602/19, NATURANOVE / Naturalium et al., EU:T:2020:463, § 51) (§ 60).

Where the signs at issue have only a descriptive term in common, the conceptual similarity must be regarded as low (§ 72). It is also apparent the case-law (15/10/2020, T-49/20, ROBOX / Orobox, EU:T:2020:492, § 92) that, where conceptual similarity is based on a weakly distinctive – or even descriptive – element, it plays a limited role and has less impact on the assessment of LOC (§ 73).

[12/10/2022, T-222/21, Shoppi \(fig.\) / Shopify, EU:T:2022:633](#)

### **Distinctive character of the symbol ‘#’**

The symbol ‘#’ is non-distinctive as it is perceived by the majority of EU consumers as meaning the word ‘number’, being placed before a number. It is apparent from the case-law that the symbol ‘#’ may be likened to the exclamation mark or to the symbol ‘@’ and it is not capable of rendering a trade mark distinctive (§ 49, 50).

[30/11/2022, T-678/21, Vsl3total / Vsl#3, EU:T:2022:738](#)

### **Distinctive character of the elements of the mark – Mere laudatory message**

The word ‘TOTAL’ in capital letters will be associated with the concept of ‘complete [and] absolute’ by the vast majority of the target public in the EU and, as such, would be perceived as conveying a mere laudatory message as regards the relevant goods (Class 5), in particular that they are dietary supplements which consist of a complete formula or which can provide a complete or total benefit to consumers’ health. Therefore, it is non-distinctive (§ 49, 50).

[30/11/2022, T-678/21, Vsl3total / Vsl#3, EU:T:2022:738](#)

### **Distinctiveness of the elements of the marks at issue**

In the word element ‘HE&ME’, the distinctive character of the element ‘he’ is, at most, weak and, in any event, not higher than that of the element ‘me’, for *clothing* targeting male customers (§ 35, 37).

The coinciding element ‘me’ has some distinctive value for these goods, although it could be held to be weak, particularly where that term is regarded as highly allusive to the personality of the user of the goods in question (§ 38).

[01/03/2023, T-25/22, HE&ME \(fig.\) / Me, EU:T:2023:99](#)

### **LOC – Non-distinctive figurative element – Heart symbol**

An element depicting a heart is commonly used in advertising language to express a particular attachment and it is devoid of distinctive character. It will be understood by consumers as merely a decoration or, at most, as an allusion to love or affectionate appreciation showing that that element is laudatory in relation to the goods at issue (*soap* and *bath salts*). It is not dominant even if it is placed in the middle of the mark and it is the only figurative element, since it is of the same size and colour as the word elements and occupies less space (§ 68-69).

ALMARA♥SOAP

[29/03/2023, T-436/22, ALMARA SOAP \(fig.\) / ALMENARA, EU:T:2023:167](#)

### **Non-negligible weak element – Length and position of the weak element**

A weak element can still be impactful and attract the attention due to its size and position in a sign (§ 58). In this case, the common element 'financ', which represents six of the nine letters of the signs, contributes to a non-negligible extent to the overall impression created by those signs (§ 60).

[03/05/2023, T-7/22, \*Financery / financify\*, EU:T:2023:234](#)

### **LOC – Distinctive and dominant elements – Potential future descriptive element**

Although an element constituting a mark might, in the future, be perceived as being descriptive of the goods covered by that mark, this is not sufficient for it to be held, in opposition proceedings pursuant to Article 8(1)(b) EUTMR, that it is weakly distinctive at the time when LOC is assessed. The case-law relating to the application of Article 7(1)(c) EUTMR cannot be applied in the present case (§ 103).

[10/05/2023, T-437/22, \*bistro Régent \(fig.\) / Regent\*, EU:T:2023:246](#)

### **LOC – Weak elements – Font, colour and arrangement of the verbal element**

The distinctive character of the font, colour and horizontal arrangement of the verbal element are characteristics that are merely related to the layout of the verbal element of a mark. Since they are not distinguished by any particular or original stylisation, they are only weakly distinctive (§ 32).

[17/05/2023, T-480/22, \*panidor \(fig.\) / ANIDOR Toute la tendresse du chocolat \(fig.\) et al.\*, EU:T:2023:266](#)

### **Weakly distinctive elements – Degree of distinctive character to be taken into account in the comparison of the signs – Common descriptive element**

Since the public will understand each of the compared marks as an indivisible whole and not as being made up of two separate units, one having descriptive character and the other distinctive, the assessment of their similarity must be based on those elements considered as a whole (§ 52).

[07/06/2023, T-368/22, \*Banqui / Bankia \(fig.\) et al.\*, EU:T:2023:309](#)

### **Impact of weak elements in the comparison of the signs**

Trade mark elements that are descriptive, non-distinctive or have a weak distinctive character generally have less weight in the analysis of the similarity between the signs than the elements of greater distinctiveness, which are also more able to dominate the overall impression given by the mark (§ 52).

[28/06/2023, T-496/22, \*Omegor vitality / OMACOR \(fig.\) et al.\*, EU:T:2023:360](#)

### **No LOC – Weakly distinctive element**

The Spanish public would perceive the element 'LAC' as a reference to 'milk' in relation to the relevant goods (*milk for infants*) and, thus, as having a weak distinctive character (§ 47, 48).

[06/09/2023, T-728/22, \*Namlac / Analac \(fig.\)\*, EU:T:2023:511](#)

### **LOC – Distinctiveness of a common element – Use of a term on the market**

To establish that use of the element ‘tmc’ is widespread in all market sectors and that it is, therefore, not distinctive, it should be proven that this element is actually present on the market (§ 85).

[13/09/2023, T-167/22, Tmc transformers / TMC \(fig.\) et al., EU:T:2023:535](#)

See also, [13/09/2023, T-163/22, TMC TRANSFORMERS \(fig.\) / TMC \(fig.\) et al., EU:T:2023:534, § 86](#)

### Decorative figurative element

The figurative element in the EUTM application will not be perceived as the symbol ‘+’, but rather as a purely decorative element. Moreover, that figurative element in yellow is not easily perceptible on the white background, the colour white having been claimed for the background (§ 36-38).

POLLEN ⊕ GRACE  [08/11/2023, T-41/23, POLLEN + GRACE \(fig.\) / Grace \(fig.\) et al., EU:T:2023:705](#)

### No LOC – Banal decorative elements – Fashion sector

Where it is common for consumers of goods in a particular sector to be faced regularly with certain types of figurative elements in the context of the commercial presentation or the decoration of those goods and those consumers are, consequently, accustomed to seeing them in that decorative function, those elements lose their ability to identify the commercial origin of those goods and will therefore generally have a weak distinctive character with regard to those goods (§ 47).

In the fashion sector, it is a banal or common practice to use representations of lions or lions’ heads or, more generally, of wild, strong and exotic animals in the commercial presentation or the decoration of goods, such as those in Classes 14 and 25 (§ 48, 49). Because the earlier mark is based on a concept which is commonly used for the commercial presentation or the decoration of those goods, its proprietor cannot claim excessive protection for that mark, which would be liable, in practice, to give them a quasi-monopoly over that commonly used concept (§ 73). Therefore, the degree of inherent distinctiveness of the earlier mark must be regarded as low (§ 74).



[20/12/2023, T-564/22, DEVICE OF A LION HEAD \(fig.\) / DEVICE OF A LION HEAD \(fig.\), EU:T:2023:851](#)

### LOC – Weak element – Definite article ‘the’

The word ‘the’ will be recognised by the relevant public as the definite article commonly used in English that simply announces the word that follows, with the result that that element can have only weak distinctive character (§ 50).

[31/01/2024, T-26/23, Feed. \(fig.\) / The Feed. \(fig.\) et al., EU:T:2024:48](#)

### LOC – Weak elements – Geographic terms for hotel services

The common word element ‘FANTASIA’ is distinctive because there is not a sufficiently direct link with the hotel services concerned (§ 94-95). The geographical expression ‘BAHIA PRINCIPLE’ has limited distinctive character. The alleged practice in the hotel services sector of using geographic terms without descriptive meaning – albeit recognised in the EUIPO’s guidelines – does not

prevent a significant part of the public perceiving that geographical expression as an indication of the place where the service is rendered (§ 98-99).



FANTASIA  
HOTELS

[10/01/2024, T-504/22, Fantasia BAHIA PRINCIPE HOTELS & RESORTS \(fig.\) / FANTASIA HOTELES \(fig.\) et al., EU:T:2024:2](#)

See also, [10/01/2024, T-505/22, LUXURY BAHIA PRINCIPE FANTASIA Don Pablo Collection \(fig.\) / FANTASIA HOTELES \(fig.\) et al., EU:T:2024:3](#), § 98-99, 102-103

### **LOC – Allusive terms not considered descriptive**

Even if the element ‘sept’ is linked to the English words ‘antiseptic’ or ‘septic’, that element would, at most, allude to certain characteristics of the goods in Classes 3 and 5, namely their purpose, which is to combat microbial germs or the infections they cause. Nevertheless, that element cannot be regarded as descriptive of those goods (§ 43-44).

[06/03/2024, T-796/22, +VIVIASEPT \(fig.\) / VIBASEPT et al., EU:T:2024:153](#)

### **No LOC – Weak elements – Well-known facts – Graphic stylisation**

The worldwide reputation of a capital city located in Europe necessarily implies that it is known to the public in a Member State (§ 39).

If the graphic stylisation of the word elements fulfils more of a decorative or aesthetic function, it cannot significantly enhance the distinctive character of these elements (§ 43).



PARIS BAR

[13/03/2024, T-117/23, BAR PARIS \(fig.\) / PARIS BAR \(fig.\), EU:T:2024:163](#)

### **No LOC – Distinctive and dominant element – Descriptive element in the beginning of signs – Breaking down of verbal element – Focus on more distinctive endings**

Where the element in the beginning of the signs has a low degree of distinctiveness in relation to the goods covered by the conflicting marks, the relevant public will indeed attach more importance to the ending of the signs, which is the more distinctive part (§ 94). As the relevant Spanish public will grasp the prefix ‘sano’ as meaning ‘which is good for health’ and understand it as being descriptive of the goods and services covered, it will break down the marks at issue and focus its attention on the suffixes ‘din’ and ‘id’, located at the end of the earlier mark and the mark applied for respectively (§ 96-99).

**Sanoid** [13/03/2024, T-206/23, Sanoid \(fig.\) / SANODIN, EU:T:2024:164](#)

#### **2.3.1.4 Disclaimers**

##### **Preliminary ruling – Disclaimer – Article 4(1)(b) Directive 2008/95**

A disclaimer provided for by national law whose effect was to exclude an element of a complex trade mark, mentioned in the disclaimer, from the analysis of the relevant factors for establishing the existence of a LOC within the meaning of Article 4(1)(b) of Directive 2008/95 because that element is descriptive or not distinctive, would not be compatible with the requirements of that provision (§ 46).

A disclaimer provided for in national law whose effect were to attribute, in advance and permanently, a lack of distinctiveness to the element of a complex trade mark mentioned by it, so that that element has only limited importance in the analysis of the LOC within the meaning of Article 4(1)(b) of Directive 2008/95, would also be incompatible with the requirements of that provision (§ 52).

12/06/2019, C-705/17, [Mats Hansson](#), EU:C:2019:481, § 46, 52

### 2.3.1.5 Composite marks

#### Distinctive verbal elements

The prefix 'trico', in Italian, belongs to scientific terminology and not to common or current language (§ 111). The documents submitted in the proceedings before the Office did not allow the conclusion that the general Italian public, without having studied ancient Greek or without having any particular technical knowledge, would recognise the term 'trico' as a prefix meaning 'hair' (§ 112-113).



19/09/2019, T-359/18, [TRICOPID / TRICODIN \(fig.\)](#), EU:T:2019:626, § 112-113

#### Simple figurative element and verbal element

Although it cannot be ruled out that the figurative element in the EUTM application may attract the consumer's attention, it is unlikely that the consumer will refer to the mark applied for by describing that element which represents a simple geometric form (§ 59).

Where the verbal element of a mark is substantially longer than the figurative element of that mark, it attracts more attention on the part of the average consumer because of its larger size (06/09/2013, T-349/12, Revaro, EU:T:2013:412, § 19, 24) (§ 60).



08/07/2020, T-328/19, [SCORIFY \(fig.\) / Scor et al.](#), EU:T:2020:311, § 59, 60

#### Perception of a figurative element in a composite mark

Depending on the specific circumstances of a particular case, a figurative element may play the same role in the perception of a composite mark as its word elements (§ 59).



12/01/2022, T-366/20, [DEVICE OF ROUND ELEMENT RESEMBLING A BRUSHSTROKE \(fig.\) / ORIGIUM 1944 \(fig.\)](#), EU:T:2022:4, § 59

#### Figurative element and verbal element – Low distinctive character of common verbal element

Where a sign consists of both figurative and word elements, it does not automatically follow that the word elements must always be considered to be more distinctive than the figurative elements. In the case of a composite mark, the figurative element may, in particular on account of its shape, size, colour or position in the sign, rank equally to the word element (23/11/2010, T-35/08, Artesa Napa Valley, EU:T:2010:476, § 37, 39) (§ 68, 74, 79, 95).



23/09/2020, T-608/19, [Veronese \(fig.\) / VERONESE](#), EU:T:2020:423, § 68

### **Examination of the intrinsic qualities of the figurative and word elements and their position**

It is appropriate to examine the intrinsic qualities of the figurative and word elements of the mark applied for, as well as their respective positions, in order to identify, where appropriate, whether one of those elements is dominant (09/02/2017, T-82/16, TRIPLE EVOLUTION (fig.) / Evolution, EU:T:2017:66, § 35) (§ 37).



15/10/2020, T-349/19, [athlon custom sportswear \(fig.\) / Decathlon](#), EU:T:2020:488, § 37

### **Words with meaning in foreign languages**

Since a knowledge of a foreign language may not, in general, be presumed (§ 48), the fact that it had been stated that the verbal element 'Bimbo' (meaning 'child') is descriptive for the Italian public in connection with goods in Class 30 does not have any impact on the distinctive character of that element for the Spanish public, i.e. the public whose perception was taken into account in this case, which is not expected to know the meaning of the word 'Bimbo' in Italian (§ 49).



17/01/2019, T-368/18, [ETI Bumbo / BIMBO \(fig.\)](#), EU:T:2019:15, § 48-49

### **Relevant public's knowledge of a language other than its mother tongue – Burden of proof**

Since knowledge of English on the part of the Polish and Spanish public is not a well-known fact (in contrast to the knowledge of English on the part of, inter alia, the Swedish public) and since the sector in question (additives in the manufacture of foods and beverages) is not one of those in which English is frequently or normally used (in contrast to the technology or computing sectors), it was for the applicant to provide, in the course of the administrative proceedings, evidence to highlight the relevant public's knowledge of a language other than its mother tongue (§ 63).

29/04/2020, T-108/19, [TasteSense By Kerry \(fig.\) / Multisense et al.](#), EU:T:2020:161, § 63  
29/04/2020, T-109/19, [TasteSense \(fig.\) / Multisense et al.](#), EU:T:2020:162, § 63

### **Relevant public's knowledge of a language other than its mother tongue – Burden of proof**

The understanding of a word sign may be assumed for a territory in which the language of the sign is the native language of that territory's population. It must be proved in territories in which the relevant language is not the population's native language, unless a sufficient knowledge of the language of the sign on the part of the target public in those territories is a well-known fact (26/11/2008, T-435/07, New Look, EU:T:2008:534, § 22 (§ 63)).

Basic English words are understood by a large part of the EU public. In this case there is no need to decide whether the Polish-speaking public's knowledge of basic English vocabulary is a well-known fact since the term 'impress' is not basic English vocabulary. This public cannot be presumed to have an understanding of this term and it must therefore be proved (§ 64, 70).

29/04/2020, T-37/19, [cimpres / p impress \(fig.\) et al.](#), EU:T:2020:164, § 63-64, 70

### **Relevant public's knowledge of a language other than its mother tongue – Burden of proof – Breaking down of verbal elements – Common element**

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

A word sequence in a foreign language may still be remembered even though it is not easy to pronounce for the majority of the relevant public in the EU, who do not understand the language. The average consumer, perceiving a word sign, will break it down into word elements that have a concrete meaning for them, or that resemble words known to them (19/05/2011, T-580/08, *Pepequillo*, EU:T:2011:227, § 74) (§ 61).

23/09/2020, T-401/19, [Freude an Farbe \(fig.\) / Glemadur Freude an Farbe \(fig.\)](#), EU:T:2020:427, § 29-30

23/09/2020, T-402/19, [Freude an Farbe \(fig.\) / Glemadur Freude an Farbe \(fig.\)](#), EU:T:2020:429, § 61

### **Breaking down of verbal elements – Common element**

Faced with a basic verbal element that is easily understood throughout the EU, the relevant public will break down the sign into two parts, one corresponding to a word that it understands as part of everyday language and the other consisting of the rest of the sign, even if the other part does not suggest a specific meaning or does not resemble words that the relevant public knows (§ 59). Therefore, the English-speaking relevant public will immediately understand the sign applied for as a combination of ‘meat’ and ‘love’, and will break down the earlier sign into two verbal elements, ‘carni’ and ‘love’ (§ 60). Although the concepts of ‘love of carnivores/meat eaters’ and ‘love of meat’ are not identical, they both refer to a feeling of affection for or great pleasure in something connected with meat. At least for the English-speaking relevant public, there is a conceptual low degree of similarity despite the low distinctive character of the common element ‘love’ (§ 61-72).

03/10/2019, T-491/18, [Meatlove / carnilove](#), EU:T:2019:726, § 59, 60, 61-72

### **Breaking down of verbal elements – Common element**

There is no evidence that, for a significant part of the relevant public, in particular for German-speaking consumers, the prefix ‘noc[u]’ would be perceived as referring to the terms ‘nocturia’ or ‘nocturnal’ (night) and therefore as being descriptive of the goods in question. Therefore, for this part of the public, the coincidence in the first four letters renders the marks visually and phonetically similar to an average degree (§ 72-73). No conceptual comparison can be made as the words in question have no meaning for the consumers (§ 74). The signs are similar to an average degree (§ 75).

06/03/2019, T-321/18, [NOCUVANT/ NOCUTIL et al.](#), EU:T:2019:139, § 72-75

### **Breaking down of verbal elements – Common element**

In view of the different endings of the words ‘aquaprint’ and ‘aquacem’ and the weak distinctive character of the common element ‘aqua’, the existence of misrepresentation in this case is excluded, since the offer of the goods in the UK under the trade mark applied for, AQUAPRINT, is not likely to lead the public to attribute the commercial origin of these goods to the applicant, which markets its goods under the signs AQUACEM and AQUASIL (§ 107-108).

23/05/2019, T-312/18, [AQUAPRINT / AQUACEM et al.](#), EU:T:2019:358, § 107-108

### **Breaking down of verbal elements – Meaning by regrouping elements**

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

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

*in · fi · ni · tu · de* 23/09/2020, T-601/19, [in.fi.ni.tu.de \(fig.\) / infinite](#), EU:T:2020:422, § 101-112

### Distinctive and non-distinctive figurative elements

Flags are often used for decoration in the maritime sector and therefore have a low degree of distinctiveness (§ 56).



03/04/2019, T-468/18, [CONDOR SERVICE, NSC \(fig.\) / ibercóndor transportes internacionales y aduanas \(fig.\) et al.](#), EU:T:2019:214, § 56

### Verbal elements and figurative elements

The verbal element 'OOF' of the mark applied for, which is easily recognisable and identifiable, is the distinctive and, compared with the figurative elements, dominant element. The bar above each letter 'O' and the use of the colours red and white for the letters 'OO' and 'F' are perceived as secondary decorative elements (§ 26).



10/10/2019, T-453/18, [OOF \(fig.\) / OO \(fig.\) et al.](#), EU:T:2019:733, § 26

### Common verbal element in different positions

The letters 'mg' are the most distinctive element of the earlier mark (§ 35). The fact that the letters 'mg' are present in both marks is sufficient to establish the existence of phonetic and visual similarity between them, even though the position of these letters differs in the marks (§ 36). Therefore, there is a LOC (§ 44).



03/10/2019, T-500/18, [MG PUMA / GINMG \(fig.\)](#), EU:T:2019:721, § 35-36, 44

### Descriptive but dominant element

Although the relevant consumer generally does not consider a descriptive element forming part of a complex trade mark as a distinctive and dominant element, there may be special circumstances that justify the dominance of a descriptive element. This is the case, in particular, because of its position in the sign or its size, so that it may make an impression on consumers and be remembered by them, or the fact that the respective verbal elements occupy a central position in the marks at issue and dominate their overall image (29/06/2017, T-448/16, Mr. KEBAB (fig.) / MISTER K MR. KEBAP (fig.), EU:T:2017:459, § 28) (§ 128-135, 137).



13/06/2019, T-398/18, [DERMAEPIL SUGAR EPIL SYSTEM \(fig.\) / dermépil Perron Rigot \(fig.\)](#), EU:T:2019:415, § 128-135, 137

### **Weakly distinctive or descriptive but dominant element**

That an element of a composite mark has weak distinctive character does not necessarily preclude it from constituting a dominant element, since it may, on account, in particular, of its position in the sign or its size, make an impression on consumers and be remembered by them (§ 46).

13/05/2020, T-63/19, [ПОШЕИ \(fig.\) / ПОМАШКИ \(fig.\)](#), EU:T:2020:195, § 46

### **Distinctive and dominant elements – Mark consisting of a combination of a first name and surname**

The BoA was mistaken in automatically applying, without taking due account of the specific features of the present case, the rule that in certain Member States consumers remember surnames rather than first names (§ 35). MILEY CYRUS refers to the first name and surname of the famous singer and actress, who is known by that first name and that surname together, and not by her first name or surname separately (§ 37). The two elements are equally distinctive, and one cannot therefore be considered dominant in relation to the other (§ 38).



16/06/2021, T-368/20, [Miley cyrus / Cyrus \(fig.\) et al.](#), EU:T:2021:372, § 35, 37-38

### **Abbreviations**

The verbal element 'Institut für angewandte Kreativität' of the earlier mark is, as a general reference to the proprietor's field of business, perceived as less distinctive than the inherently distinctive verbal element 'IAK'. The element 'IAK' does not in itself describe the services, so it possesses distinctive character. Even if it were perceived by the relevant public as an acronym of 'Institut für angewandte Kreativität', this circumstance, on its own, cannot prove that the distinctive character of the element 'IAK' is reduced in the perception of the sign as a whole (§ 65-66). The relevant public will perceive and remember the element 'IAK', irrespective of the element that follows it (§ 73).



24/09/2019, T-497/18, [IAK \(fig.\) / IAK - Institut für angewandte Kreativität](#), EU:T:2019:689, § 73

### **Distinctiveness of a frequently used placeholder – Distinctiveness of punctuation marks**

The fact that an element is frequently used as a placeholder in everyday language, in particular to start a sentence, does not mean that its ability to indicate commercial origin is weak in relation to the goods at issue (§ 41).

Although the Court has already held that certain punctuation marks are not distinctive, that finding does not preclude punctuation marks from being recognised as possessing a certain distinctive character, with regard to the particularities of each case (§ 45).

30/03/2022, T-30/21, [SO COUTURE / SO...? et al.](#), EU:T:2022:190, § 41, 45

### **Distinctive and dominant elements – Breaking down of word elements – Common element**

Although the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, the fact remains that, while perceiving a word sign, they will identify the elements which, for them, suggest a concrete meaning or resemble words known to them. Moreover, the consumer will break the word sign down into elements even if only one of its

elements is familiar to them (23/05/2019, T-312/18, AQUAPRINT / AQUACEM et al., EU:T:2019:358, § 28 and case-law cited) (§ 67).

The word 'vita' will be understood by the Spanish general public as an allusion to 'vitality' or a reference to the concept of 'life'. The word 'vita' generally evokes a positive quality attributable to a large range of different goods or services. The word, of Latin origin, is familiar to a Spanish consumer, giving the word containing it a connotation of 'life' or 'vitality' (§ 72). Considering that the goods are related to health, Spanish consumers are also likely to understand the element 'vita' as a reference to the Spanish words 'vitalidad' or 'vitamina'. (§ 73). Consequently, the Spanish general public, or at least a non-negligible part of that public, will understand the element 'vita' that the signs have in common. As the public will identify the element 'vita', they will therefore divide the trade marks VITADHA and VITANADH into two elements, namely, 'vita' and 'dha' and, 'vita' and 'nadh' (§ 74).

Word marks do not have a dominant element since, by their nature, none of the constituent elements has a particular graphic or stylistic aspect capable of giving it this dominant character (§ 79). The common element 'vita' appears in the initial part of the signs. It is identical in length to the element 'nadh' in the earlier mark and slightly longer than the element 'dha' in the mark applied for. However, this does not mean that the element 'vita' can be regarded as negligible in the overall impression conveyed by the signs (§ 80-81). Even though the element 'vita' is allusive, it must nevertheless be taken into account in the assessment of the visual, phonetic and conceptual similarity of the signs (§ 80-82).

02/03/2022, T-149/21, [Vitadha/ Vitanadh et al.](#), EU:T:2022:103, § 67, 72-74, 79-82

### **Distinctive elements – Wine sector – Second part of a word mark**

The fact that an element which differentiates the word marks under comparison and which is not 'secondary' contains more letters and syllables than the element shared by both marks can reduce the degree of visual and phonetic similarity (§ 37). The terms 'DE BERONIA' in the EUTM applied for, which are not descriptive, significantly diminish the visual and aural similarity between the conflicting marks (§ 42, 55).

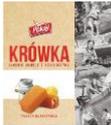
Average consumers will not systematically ignore the second part of word mark and memorise only the first part, in particular in the sector of alcoholic beverages, where consumers are accustomed to products being designated by trade marks consisting of several verbal elements (§ 47).

In the wine-growing world, names carry great weight, whether surnames or names of vineyards, since they are used to reference and designate wines. Consumers usually describe and recognise wines by reference to the word element which identifies them and that this element designates, in particular, the grower or the estate on which a wine is produced. Thus, the terms 'DE BERONIA' can contribute significantly to the identification of the applicant's wines (§ 63).

04/05/2022, T-298/21, [Alegria de beronia / Alegro](#), EU:T:2022:275, § 37, 42, 47, 55, 63

### **Mark consisting in an element in Cyrillic characters and its Latin transliteration**

In Spain, Germany and Greece, the element 'КОРОВА', admittedly written in Cyrillic characters, and its Latin transliteration, the element 'KOROVKA', will be perceived as two different words in Latin characters, at least by a large majority of the relevant public, which is not familiar with Cyrillic characters (§ 37).



KOPOBKA  
KOROUKA

[01/06/2022, T-355/20, Pokój TRADYCJA JAKOŚĆ KRÓWKA SŁODKIE CHWILE Z DZIECIŃSTWA TRADYCYJNA RECEPTURA \(fig.\) / KOPOBKA KOROVKA \(fig.\), EU:T:2022:320](#)

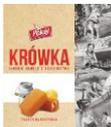


KOPOBKA  
KOROUKA

See also, [01/06/2022, T-363/20, KRÓWKA MLECZNA Milk FUDGE \(fig.\) / KOPOBKA KOROVKA \(fig.\), EU:T:2022:321, § 44](#)

### House mark

The 'device' and the element 'POKÓJ' which it features will be perceived as constituting a 'house mark'. That is apparent from its position above the element 'KRÓWKA' in the upper part of the contested mark, which clearly represents the front of the packaging of the goods to which it refers. Therefore, it has normal distinctiveness (§ 58).



KOPOBKA  
KOROUKA

[01/06/2022, T-355/20, Pokój TRADYCJA JAKOŚĆ KRÓWKA SŁODKIE CHWILE Z DZIECIŃSTWA TRADYCYJNA RECEPTURA \(fig.\) / KOPOBKA KOROVKA \(fig.\), EU:T:2022:320](#)

### Verbal element represented upside down

The element represented upside down in the contested mark, even if it cannot be described as illegible, will not be immediately identified by the relevant public, that is to say, without a certain mental effort on its part (§ 57).



KOPOBKA  
KOROUKA

[01/06/2022, T-363/20, KRÓWKA MLECZNA Milk FUDGE \(fig.\) / KOPOBKA KOROVKA \(fig.\), EU:T:2022:321](#)

### Dominant element

In the present case, in the mark applied for, since the word 'love' has a concrete and well-known meaning, breaking it down will occur naturally, despite the difference resulting from the use of upper case for the group of letters 'alo' and of lower case for the group of letters 've' (§ 47). The heart-shaped outline of the letter 'o' in the mark applied for, conveying the same concept as the word 'love', reinforces the dominant character of the element 'love' in that mark (§ 48).

[ALove L@VE 06/07/2022, T-288/21, ALOve \(fig.\) / LOVE \(fig.\), EU:T:2022:420](#)

### Distinctive expression including a descriptive element

Although the verbal element 'mare', considered in isolation, is descriptive of 'fish' (Class 29) and 'fish processing' (Class 40) for the relevant Italian speaking public, the expression 'MARE GIOIOSO' is a metaphor that transforms the emotion of joy into a personification of the sea. The expression is therefore neither descriptive nor allusive for the contested goods and services and its distinctiveness is average. Similarly, the expression 'GIOIA DI MARE' is also associated with a feeling of cheerfulness and joy connected with the sea. As such, it does not contain any direct

reference to the earlier goods and services. Both expressions, which are dominant in the marks under comparison, have a normal distinctive character (§ 74-77).



[14/09/2022, T-423/21, MARE GIOIOSO di Sebastiano IMPORT . EXPORT \(fig.\) / GIOIA DI MARE \(fig.\), EU:T:2022:562](#)

### Dominant figurative element in a composite mark

Due to its size, position in the sign and colour, the representation of the duck is the dominant element of the contested EUTM application and the word element is not such as to divert the relevant public's attention away from it (§ 49-51).



[14/09/2022, T-416/21, ITINERANT \(fig.\) / RAPPRESENTAZIONE DI UN PAPERINO CANTANDO \(fig.\) et al., EU:T:2022:560](#)

See also, [14/09/2022, T-417/21, ITINERANT \(fig.\) / RAPPRESENTAZIONE DI UN PAPERINO \(fig.\), EU:T:2022:561](#)

### Meaning of a single element in a composite mark

It is apparent from the case-law that, when perceiving a word sign, the average consumer will break it down into word elements which, for him or her, suggest a concrete meaning. That case-law, however, does not imply that each single element of a word element must have a concrete meaning (§ 62, 63). When only one word element of a mark has a meaning, however, its first letter is written in capital, preceding by another capital letter, the relevant public will notice the unusual presence of two upper-case letters at the beginning of that element, suggesting that the first capital letter could be the initial letter of another word (§ 65).

 [12/10/2022, T-656/21, H/2 capital partners / HCapital \(fig.\) et al., EU:T:2022:625](#)

### Breaking down of a verbal element into elements which suggest a particular meaning or resemble known words

The relevant public will break down the word element 'lezebra' into two elements, namely 'le' and 'zebra', since it will perceive that the term 'zebra' resembles the term 'cebra' in Spanish. That perception is all the more plausible given that, in Spanish, the consonants 'z' and 'c' before the vowel 'e' are pronounced in the same way and that the relevant public will simultaneously see that term and the zebra's head contained in the figurative element, which will make the reference to that animal all the more obvious (§ 33).



[07/12/2022, T-159/22, Las Cebbras \(fig.\) / LEZEBRA \(fig.\), EU:T:2022:772](#)

### Distinctive and dominant elements – Co-dominant figurative and verbal elements

Consumers will perceive the figurative representation of a zebra's head in the earlier mark, which is conceptually linked to the word 'lezebra'. Consumers will therefore memorise both the word and the figurative element (§ 36). The elements of the contested mark are the verbal and figurative expression of the same idea. Both the verbal and the figurative elements have an obvious and clearly perceptible meaning, so it is likely that the relevant public will remember them in the same

way. The figurative representation of a zebra's head in the mark applied for is no less dominant and no less distinctive than the words 'Las Cebras' (§ 37).

  **LEZEBRA** [07/12/2022, T-159/22, Las Cebras \(fig.\) / LEZEBRA \(fig.\), EU:T:2022:772](#)

### **Dominant element – Relevance of the length**

The considerable length of the first part of a verbal element does not necessarily lead to conclude its visual predominance (§ 63).

[21/12/2022, T-250/19, Tradicion cz s.l. / Rivero cz et al., EU:T:2022:838](#)

### **Distinctive and dominant elements – Element occupying a secondary position**

The weak distinctive character of an element of a complex mark does not necessarily imply that that element cannot constitute a dominant element since, because, in particular, of its position in the sign or its size, it may make an impression on consumers and be remembered by them. However, that is not true of the element 'marktomi marktomi', which occupies a secondary position within the contested mark (§ 42).

  [21/12/2022, T-264/22, MK MARKTOMI MARKTOMI \(fig.\) / MK MICHAEL KORS \(fig.\) et al., EU:T:2022:861](#)

### **Dominant verbal element – Decorative figurative elements**

The relevant public will not attribute any major significance to the typeface and colours of the earlier mark due to their decorative nature. Its figurative element will be perceived as purely decorative in the context of the sign as a whole (§ 42).

 **D U V A L** [01/02/2023, T-671/21, Duuval / GROUPE DUVAL \(fig.\) et al., EU:T:2023:33](#)

### **Assessment of the similarity between the signs – Respective weight of the distinctive elements of the mark**

The fact that an element of a composite mark has distinctive character does not preclude that that element may still contribute only marginally to the overall impression created by the mark. It is possible that a distinctive element still only plays a minor role in the overall impression in the composite mark due to its design, size or position within the mark. (§ 51).

 **TC CARL**  [15/02/2023, T-8/22, TCTC CARL \(fig.\) / carl touch \(fig.\), EU:T:2023:70](#)

### **LOC – Secondary role of distinctive elements due to their size and position**

Verbal elements that refer to the manufacturer, while having average distinctive character, may only play a secondary role in the perception of the sign at issue on account of their positioning and their small size (§ 47, 49).



[08/03/2023, T-759/21, A 2 \(fig.\) / THE a2 MILK COMPANY a2 THE a2 MILK COMPANY\(fig.\) et al., EU:T:2023:108](#)

### **LOC – Distinctive and dominant elements**

The distinctive character of the elements making up the mark applied for cannot be assessed in the light of elements of which other marks consist, in particular, those cited as examples in the EUIPO's Guidelines (§ 33).

[17/05/2023, T-480/22, panidor \(fig.\) / ANIDOR Toute la tendresse du chocolat \(fig.\) et al., EU:T:2023:266](#)

### **Distinctive character of saints' names**

The criteria for assessment of the distinctive character of trade marks constituted by saints' names are the same as those applicable to other categories of trade mark. More stringent assessment relating to the use of saints' names in the sector concerned cannot, therefore, be applied. Furthermore, the name 'St. George' in English is equivalent to the name 'San Jorge' in Spanish. The relevant public will perceive 'St. George' as that of a saint, unrelated to the goods or services in question (in Classes 16 and 41 and all related to education), and as an allusion to the fact that they are provided by an English-speaking institution. Since the name 'St. George' is neither descriptive nor generic in relation to the goods and services in question, it must be held that it is distinctive (§ 39, 41).

[21/06/2023, T-438/22, IBE ST. GEORGE'S \(fig.\) / ST. GEORGE'S SCHOOL \(fig.\) et al., EU:T:2023:349](#)

### **Low visual and phonetic similarity – Common distinctive element**

The mere fact that the common element is distinctive does not necessarily mean that the signs have a degree of similarity that is more than low, since the assessment of the similarity of those signs must be based on the overall impression produced by them (§ 46).

[26/07/2023, T-745/21, Passo lungo / Doppio passo, EU:T:2023:435](#)

### **Distinctive element – Name of a colour**

A colour or a name of the colour could be distinctive if it does not constitute an 'intrinsic' characteristic that is 'inherent to the nature' of the goods concerned, but it is a purely random and incidental aspect, which only some of them may have and which does not, in any event, have any direct and immediate link with their nature, purpose and method of use (§ 112).

[26/07/2023, T-562/21 & T-590/21, Camel crown / camel active \(fig.\), EU:T:2023:440](#)

### **LOC – Dominant and distinctive elements – Vague meaning of the verbal element**

For the goods and services related to traffic or transport, the term 'flow' is vague and does not convey any clear meaning to the average consumer. It leaves room for the public to interpret the characteristics of the goods or services identified by that term, with the result that their essential characteristics cannot be described in a clear manner. Therefore, the term 'flow' has an average or slightly below average distinctive character (§ 84).



[11/10/2023, T-296/22, FLOWBIRD \(fig.\) / Flow et al., EU:T:2023:613](#)

### **Distinctive and dominant elements – Co-dominant figurative and verbal element – Elements referring to the same concept**

Where the figurative element and the second part of the verbal element refer to the same concept, with the result that they reinforce each other, and in the light of the absence of any link with the goods concerned and the prominent position of the figurative element, the verbal and figurative elements are equally distinctive and co-dominant. Although the consumer's attention is often focused more on the initial verbal elements, the fact remains that, in some cases, the figurative element of a composite mark may, in particular on account of its shape, size, colour or position in the sign, rank equally with the verbal element (§ 37-39).



GILBERT TECKEL

[25/10/2023, T-773/22, GILBERT TECKEL \(fig.\) / DEVICE OF A DACHSHUND IN BLACK \(fig.\) et al., EU:T:2023:674](#)

### **No LOC – Dominant verbal element – Basic geometric figures**

Since the combination of three hexagons in the contested mark comprises simple and basic geometric shapes, that figurative element of the contested sign will be perceived as decorative and of secondary importance (§ 41-40). By contrast, the verbal element has an average degree of distinctive character since it has not been proved that 'hpu' would be immediately perceived as an acronym of a genetic disorder (§ 42-45).



HPU AND YOU

[25/10/2023, T-511/22, HPU AND YOU \(fig.\) / DEVICE OF THREE HEXAGONS \(fig.\) et al., EU:T:2023:673](#)

### **Distinctive and dominant elements – Distinctive character of 'estrella' for beers**

The relevant Spanish public will perceive the term 'estrella' as meaning 'each of the celestial bodies that shine in the night with their own light', and no connection has been established between 'estrella' and *beer*. Consequently, the verbal element 'estrella' has an average degree of distinctiveness in relation to these goods (§ 53-54, 58).



[25/10/2023, T-384/22, ESTRELLA DE CASTILLA \(fig.\) / Estrella Galicia \(fig.\) et al., EU:T:2023:672](#)

### **LOC – Dominant element – Beginning of the sign**

The mere fact that a term is located at the beginning of a mark cannot, even if that term is more likely than the terms that follow it to attract the relevant public's attention, result in that term dominating the overall impression conveyed by a trade mark. There is no indication that the first word of the contested sign, despite its distinctive character, must be regarded as being the dominant element (§ 53).



[15/11/2023, T-321/22, TIFFANY CRUNCH N CREAM / CRUNCH \(fig.\) et al., EU:T:2023:715](#)

### **Methodology for the comparison of the signs**

Before addressing the question of the visual, phonetic and conceptual similarity of the marks at issue, it is necessary to examine the distinctive and dominant elements of the marks at issue (§ 36).

[20/12/2023, T-736/22, SNACK MI \(fig.\) / SNACK'IN \(fig.\) et al., EU:T:2023:852](#)

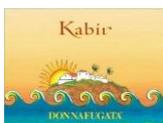
### **No LOC – Low visual similarity – Breaking down of verbal elements – Apostrophe**

Apart from the first common letter 'a', the other letters common to the signs 'A'PEAL' and 'APIRETAL' do not occupy the same position. Furthermore, the apostrophe, which it is not disputed, is a rare sign in Spanish and will probably be noticed by the relevant public. Its presence will visually break down the sign A'PEAL into two parts ('a' and 'peal'), whereas the sign APIRETAL will be perceived as a single word. Therefore, the signs at issue have a very low degree of visual similarity (§ 23).

[13/12/2023, T-56/23, A'PEAL / APIRETAL et al., EU:T:2023:798](#)

### **LOC – Tendency to shorten long marks**

Consumers naturally tend to shorten long marks. When the second word element is shown in a font of a smaller size in the lower part of the mark and it is not particularly striking on account of its colour, the relevant public would pay more attention to the first word element and a substantial part of that public would pronounce only that first element when referring to the mark (§ 40, 41).



[07/02/2024, T-302/23, KABI / KABIR DONNAFUGATA \(fig.\) et al., EU:T:2024:62](#)

### **Dominant elements of the signs**

The graphic stylisation and additional graphic elements of the signs, the colours, as well as the barely intelligible (due to its size) element in the contested sign, will either be disregarded or perceived as decorative. Consequently, their impact on the overall impression of the signs is very limited (§ 25-26, 64).



[07/02/2024, T-318/23, J&B BRO \(fig.\) / 4BRO \(fig.\) et al., EU:T:2024:70](#)

### **LOC – Breaking down of verbal elements**

For a consumer to be able to break a word mark into separate elements, at least one of those elements must have a clear and obvious meaning, in such a way that it is distinguished within that mark (§ 41-42).

[06/03/2024, T-796/22, +VIVIASEPT \(fig.\) / VIBASEPT et al., EU:T:2024:153](#)

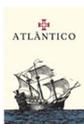
### **Distinctive and dominant element within a single word element**

A word mark composed of a single word may contain a syllable or suffix that may be regarded as the most distinctive and dominant element of that mark (§ 58).

[06/03/2024, T-796/22, +VIVIASEPT \(fig.\) / VIBASEPT et al., EU:T:2024:153](#)

## LOC – Distinctive broad geographical reference

Although multiple wine-producing regions are situated along the Atlantic coast, the word elements 'atlântico' or 'atlántica' refer to thousands of kilometres of European, American and African coasts. Such a broad and general geographical reference does not enable the relevant public to identify precisely the geographical origin of the wines or their specific characteristics. Therefore, the elements 'atlântico' or 'atlántica' are distinctive for wines (§ 33-36).



[06/03/2024, T-301/23, VIA ATLÁNTICA / ATLANTICO \(fig.\) et al., EU:T:2024:154](#)

### 2.3.2 Visual comparison

#### Colours

The visual comparison of the signs must be carried out on the basis of all of their various constituent elements. The colours of the signs are constituent elements that must be taken into account. By failing to take into account the marks' colours, even though these might constitute additional similarities, the BoA did not compare the marks in their entirety (§ 34).



[07/02/2019, T-656/17, Dr. Jacob's essentials \(fig.\) / COMPAL essential \(fig.\) et al., EU:T:2019:71, § 34](#)

#### Sole difference between the first letters of word marks

The difference between the first letters is not sufficient to counterbalance the identity of all the remaining letters which are also placed in the same order. The signs are visually (§ 43-48) and phonetically similar to an average degree (§ 49, 51-53).

[25/06/2020, T-550/19, Noster / Foster, EU:T:2020:290, § 49, 51-53](#)

#### 2.3.2.1 Word mark v figurative mark

##### Irrelevance of graphical or stylistic elements – Word mark

The graphical or stylistic elements of the mark applied for are irrelevant when it is a word mark (§ 60-61)



[17/01/2019, T-368/18, ETI Bumbo / BIMBO \(fig.\), EU:T:2019:15, § 60-61](#)

##### Sole component of the earlier mark included in its entirety within the mark applied for

When the sole component making up the earlier mark is included in its entirety within the mark applied for, the signs at issue are partially identical in such a manner as to create a certain impression of similarity in the mind of the relevant public (11/07/2018, T-694/17, SAVORY DELICIOUS ARTISTS & EVENTS (fig.) / AVORY, EU:T:2018:432, § 43 and case-law cited) (§ 78).



[25/11/2020, T-802/19, KISS COLOR \(fig.\)-Kiss et al, EU:T:2020:568, § 78](#)

### Visual comparison – Difference between alphabetic characters separated by different punctuation

The difference created by the alphabetic characters separated by different punctuation marks is visually perceptible (§ 35).



23/02/2022, T-198/21, [Code-x / Cody's \(fig.\) et al.](#), EU:T:2022:83, § 35

### No LOC – Verbal element not discernible due to its high stylisation – Dissimilarity of the signs

The average consumer will not spend time, in a purchasing situation, trying to analyse whether there are any letters or words hidden in the representation of a fish. Where the term ('blink') has no meaning for the relevant (German) public, it is even less likely that an average consumer will identify that word in the contested mark (§ 51).

The contested mark is perceived as the representation of a stylised fish and the relevant public does not associate that figurative element with any particular meaning other than that of a fish (§ 52). The signs are visually dissimilar and cannot be compared phonetically because it is not possible to pronounce the contested mark (§ 68). A conceptual comparison is not possible since the earlier mark has no meaning (§ 69). Therefore, there is no LOC (§ 70).



24/03/2021, T-354/20, [Representation of a fish \(fig.\) / Blinka](#), EU:T:2021:156, § 51-52, 68-70

### No LOC – Verbal element not discernible due to its high stylisation

The stylisation of the letters neutralises the allegation that both signs contain the letters 'GT' (§ 67-69). It is for the opponent to prove that consumers would perceive the earlier sign as reading 'GT' (19/12/2019, T-743/18, IJTI. J. TOBACCO INDUSTRY (fig.) / JTi (fig.), EU:T:2019:872) (§ 70) and proof of reputation is irrelevant in this respect (§ 71).



01/09/2021, T-463/20, [Gt racing / GT \(fig.\) et al.](#), EU:T:2021:530, § 70-71

### LOC – Average visual similarity

The contested mark has a fairly stylised gold font. The lower leg of the letter 'g' of the word 'king' constitutes the final letter 'o' of the word 'Soho'. The word element 'king', even written in lower-case letters, is as large as the word element 'Soho'. Placed above that word element, it is therefore read first. On account of those differences, there is only an average visual similarity. The fact that the word element 'king' has a weak distinctive character is not sufficient to call that conclusion into question (§ 98).



28/04/2021, T-31/20, [THE KING OF SOHO \(fig.\) / SOHO](#), EU:T:2021:217, § 98

### LOC – Earlier word mark – Possible use – Visual similarity to a high degree

Since the earlier mark is a word mark, it may be used by its owner in different graphic representations. In particular, there is nothing to prevent it from being presented in the same font as the mark applied for (§ 95).

### **Dominant and distinctive elements – Distinctiveness of geographical names – Dominant element**

The word element 'kerrygold' is the dominant element of the earlier mark, rather than its figurative elements, on account of its size and position (§ 50, 84-86, 89-94).

The word 'kerry', in relation to dairy products such as butter, milk or cheese, is likely to be understood as a reference to the geographical location of County Kerry, Ireland, by members of the European public who live in Ireland, who have visited Ireland or, possibly, who live in the UK, because of its proximity to Ireland (§ 61). However, the applicant adduced no evidence capable of establishing that the term 'kerry', associated with the goods, will be understood by the relevant European public as a whole, as a geographical indication (§ 65-69, 75, 82-83). Accordingly, there is no clear indication that the non-English-speaking public of mainland Europe would understand the term 'kerry' as a geographical indication of the goods (§ 76, 83). Therefore, the term 'kerry' included in the earlier mark has, for the majority of the relevant public, except the Irish public and possibly the UK public, distinctive character in relation to the goods for which the earlier mark was registered (§ 83).

Within the overall assessment of LOC, the combined term 'Kerrygold', which, as a whole, has no relevant meaning for a large part of the relevant public of the EU, confers an average degree of distinctiveness on the earlier mark (§ 137). The signs are visually and phonetically similar to an average degree (§ 101-107, 113-116, 138). Conceptually, the signs are not similar for the part of the relevant public that is unaware of the geographical reference contained in the term 'kerry' (§ 125). Therefore, there may be a LOC in respect of the identical or similar goods for the part of the relevant public which is not aware of the geographical reference contained in the word 'kerry' and which corresponds to a large part of the relevant public. The element 'kerry', which is common to the signs, could lead consumers to think that the mark applied for is an additional version of the earlier mark (§ 130, 137-139).

A LOC is however excluded, as the BoA correctly stated, for the dissimilar goods, namely *meat, fish, poultry and game and preserved, dried and cooked fruits and vegetables* in Class 29 (not disputed) (§ 47).



10/03/2021, T-693/19, [KERRYMAID / Kerrygold \(fig.\)](#), EU:T:2021:124, § 47, 50, 65-69, 75-76, 82-86, 89-94, 101-107, 113-116, 125, 130, 137-139

### **Assessment of the visual similarity – Irrelevance of analysis of possible meanings of the signs**

The assessment of the visual similarity does not presuppose, in principle, a prior intellectual effort to understand the meaning of the signs in conflict (§ 44, 56).

16/06/2021, T-196/20, [Incoco / Coco et al.](#), EU:T:2021:365, § 44, 56

### **Visual comparison of word marks – Differences in the initial parts of word marks – Different number of syllables – Syllables composed of a single vowel**

The presence in each of the word marks of several letters in the same order may be of some importance in the assessment of the visual similarities between the signs (§ 27).

Since all letters except for the first are identical and four letters are in the same order, the difference created by the differing first letters of the signs is not sufficient to offset the visual similarity resulting from the common presence of the other letters (§ 29).

Although the signs contain a different number of syllables, four and three respectively, this cannot automatically preclude the finding that there is an average degree of similarity between them. The first syllable in the earlier mark is limited to a single vowel, 'a', and thus has less of an impact on the phonetic impression created by that mark than the other syllables in the mark (§ 35).

08/09/2021, T-584/20, [Korsuva / Arosuva](#), EU:T:2021:541, § 27-29, 35

### **Low visual similarity – Similarities at the beginning of the signs offset by the differences in the middle and at the end – Short word elements – Descriptive figurative element**

The similarities at the beginning of the signs are offset by the differences in the middle and at the end, which are more significant because the word elements are short (only five letters) (§ 71).

The letter 'w' is unusual in Spanish and this confers an original character on the mark applied for, which is likely to attract the attention of the relevant public (§ 71).

Although the figurative element is descriptive, the fact that it is almost half the size of the mark means it is far from insignificant (§ 71).



21/12/2021, T-159/21, [motwi \(fig.\) / Monty et al.](#), EU:T:2021:924, § 71

### **Similarity of the signs – Earlier mark included in contested mark**

Where, as in the present case, the earlier mark is wholly included in the mark applied for, the fact that a group of identical letters is preceded by different letters is not sufficient to conclude that there is no similarity between the signs at issue (§ 66). On the contrary, the fact that the earlier mark is wholly included in the mark applied for is liable to create both a strong visual and phonetic similarity between the marks at issue (§ 73).



13/07/2022, T-251/21, [Tigercat / CAT \(fig.\) et al.](#), EU:T:2022:437

### **Central parts of word elements**

The word elements 'REJEUNESSE' and 'REVANESSE' are not sufficiently short for their central parts to create a significant visual difference (§ 53).

Where a figurative mark containing word elements is visually compared to a word mark, the marks are considered to be visually similar if they have in common a significant number of letters in the same position and if the word element of the figurative sign is not highly stylised, notwithstanding the graphic representation of the letters in different type fonts, in italics or bold, in lowercase or uppercase, or in colour (§ 55).



13/07/2022, T-543/21, [Rejeunesse \(fig.\) / Revanesse et al.](#), EU:T:2022:445

### **Visual similarity – Slight difference in the word element shared by the signs**

The fact that the mark applied for consists of the word element of the earlier mark, to which other words have been added, is an indication that those two marks are similar. In addition, even

though, the word 'copal' of the mark applied for is not identical to the word 'compal' of the earlier mark, it must be stated that the former constitutes almost the entirety of the latter, so that there is a clear similarity between the marks at issue as regards those elements (§ 39).



[28/09/2022, T-572/21, Copal tree / COMPAL \(fig.\) et al., EU:T:2022:594](#)

### Visual comparison – Impact of differences in weak but non-negligible verbal and figurative elements

Even in circumstances where two conflicting signs include verbal elements with a significant degree of similarity, that fact alone does not in itself allow a finding of visual similarity. The presence of figurative elements with a particular and original configuration in one of the signs is likely to result in a different overall impression given by each sign. It follows that, compared with the earlier mark consisting of the word element 'laino', the verbal and figurative elements of the mark applied for, which are not negligible, are likely to attract the attention of the relevant public and to be remembered. The signs are therefore visually similar to a low degree (§ 42-45).



[09/11/2022, T-779/21, by L.e.n.o. beauty \(fig.\) / Laino et al., EU:T:2022:693](#)

### Low visual similarity – Impact of smaller verbal element – Impact of figurative elements

The words 'liman işletmeleri' in the mark applied for, which are smaller in size than the word element 'nempört', are clearly visible to the relevant public with the result that they are likely to attract attention and mitigate, in the context of an overall impression, the effect produced by the elements of similarity (§ 35). Even where two trade marks are composed of highly similar word elements that fact does not, by itself, support the conclusion that there is a visual similarity between the signs. The presence, in one of the two signs, of figurative elements set out in a specific and original way can have the effect that the overall impression conveyed by each mark is different (§ 36).



[14/12/2022, T-18/22, NEMPORT LİMAN İŞLETMELERİ \(fig.\) / Newport et al., EU:T:2022:815](#)

### Low visual similarity – Scope of protection of word marks

A word mark is a mark consisting entirely of letters, of words or of groups of words, written in printed characters in normal font, without any specific figurative element. The protection that results from registration of a word mark relates to the word referred to in the application for registration and not the specific figurative or stylistic aspects which that mark might have. The graphic form that the earlier word sign might have in the future must not, therefore, be taken into account for the purposes of the examination of similarity (§ 52).



[11/10/2023, T-490/22, ayuna LESS IS BEAUTY \(fig.\) / Ajona, EU:T:2023:616](#)

### Visual similarity – Importance of the dot in the verbal element

The verbal elements 'liqui.do' in the earlier mark are divided by a full stop into two components, namely 'liqui' and 'do'. This dot is of particular visual importance (§ 60).

LIQUI.DO

[08/11/2023, T-592/22, Liquid+Arcade / LIQUIDO \(fig.\), EU:T:2023:708](#)

### **Visual comparison – Word mark v Figurative mark – Irrelevance of the stylisation of the figurative sign**

Since the mark applied for is a word mark, it can be represented in any font, size or colour, including in a version corresponding to that of the earlier mark. Consequently, where the earlier figurative mark is only slightly stylised, the style in which the verbal element of the earlier mark is presented is irrelevant for the visual comparison (§ 61).

LIQUI.DO

[08/11/2023, T-592/22, Liquid+Arcade / LIQUIDO \(fig.\), EU:T:2023:708](#)

### **No LOC – Low visual similarity – Number of letters**

In the case of marks consisting of five or six letters, the differences between them are more easily perceived by the average consumer (§ 53).

That two word marks have a similar number of letters is of no particular significance for the public addressed by the marks. Since the alphabet consists of a limited number of letters, not all of which are used with the same frequency, it is inevitable that several words will consist of the same number of letters and will also have some in common, without this alone allowing them to be classified as visually similar. Moreover, it follows from settled case-law that the public is generally not aware of the exact number of letters of which a word mark is composed and, consequently, in most cases, does not realise that two opposing marks are composed of a similar number of letters (§ 57).

**MOLDEX** [21/02/2024, T-767/22, Horex / MOLDEX \(fig.\), EU:T:2024:108](#)

### **LOC – Visual similarity – Limited impact of middle letters of word elements**

The differing letters in the central parts of the conflicting word marks have a limited visual impact where the beginning and the ending of those marks are identical (§ 64).

 [06/03/2024, T-796/22, +VIVIASEPT \(fig.\) / VIBASEPT et al., EU:T:2024:153](#)

### **2.3.2.2 Figurative signs**

#### **Font – Pertinent element**

The font is a pertinent element to take into consideration particularly if it is a stylised font that is not commonly used in the course of trade (§ 43-44).



[24/09/2019, T-356/18, V V-WHEELS \(fig.\) / VOLVO \(fig.\) et al., EU:T:2019:690, § 43-44x](#)

#### **Description of the mark contained in the application – No relevance**

The description of a mark that an applicant might file pursuant to Rule 3(3) CTMIR is not relevant for the assessment of the perception of that mark by the relevant public (§ 38).

The way in which the mark applied for is referred to in databases managed by the Office (eSearch plus or TMview) reflects the applicant's perception of the mark applied for and not that of the relevant public (§ 40).



08/07/2020, T-633/19, [\(fig.\) / TOTTO \(fig.\)](#),

EU:T:2020:312, § 38, 40.

### **The earlier mark's reputation and distinctive character – No impact on the comparison between the signs – No impact on the determination of dominant elements**

Unlike the factor of the similarity of the signs, the factor of the earlier mark's reputation and distinctive character does not involve a comparison between signs, but only concerns the sign registered by the opponent. Since those two factors are fundamentally different in scope, examination of one of them does not allow conclusions to be drawn concerning the other. Even where the earlier mark has a high degree of distinctive character by reason of its reputation, that fact does not make it possible to determine whether, or to what extent, that mark is visually, phonetically and conceptually similar to the mark for which registration is sought (§ 58).

The identification of the sign's dominant element may be relevant when comparing the signs, but it does not necessarily mean that the sign's reputation and degree of distinctive character, which concern it as a whole, make it possible to determine which of that sign's components is dominant in the relevant public's perception (§ 61).

The trade mark regulation cannot be understood as meaning that a trade mark's reputation or high level of distinctive character may lead to a finding that one of its constituent elements dominates over another for the purposes of assessing the similarity of signs (§ 62).



11/06/2020, C-115/19 P, [CCB \(fig.\) / CB \(fig.\) et al.](#), EU:T:2020:469, § 58, 61-62

### **Three-dimensional mark – Visual similarity – Phonetic dissimilarity – Conceptual dissimilarity – Necessity to carry out a global assessment of the LOC**

In light of the fact that the marks under comparison are at least visually similar, the BoA should have carried out a global assessment of the LOC, taking into consideration all of the relevant factors (04/03/2020, C-328/18 P, BLACK LABEL BY EQUIVALENZA (fig.) / LABELL (fig.) et al., EU:C:2020:156, § 75-76). The BoA should have also taken the degree of visual similarity between the signs into consideration (§ 64).



09/12/2020, T-620/19, [JC JEAN CALL Champagne ROSÉ Bottle \(3D\)-Bottle \(3D\)](#), EU:T:2020:593, § 64



09/12/2020, T-621/19, [JC JEAN CALL Champagne GRANDE RESERVE bottle \(3D\)-Bottle \(3D\)](#), EU:T:2020:595, § 64



09/12/2020, T-622/19, [JC JEAN CALL Champagne PRESTIGE Bottle \(3D\)-Bottle et al \(3D\)](#), EU:T:2020:594, § 64

### **Visual comparison – Illegible sign**

Not only a sign which is actually impossible to read or decipher is regarded as illegible, but also a sign which is so difficult to decipher, understand or read that a reasonably observant and circumspect consumer could not manage to do so without engaging in an analysis which goes beyond what may reasonably be expected of him or her in a purchasing situation (§ 79).

The graphic representation of the earlier marks is such that the relevant public will not immediately recognise that those marks can also be perceived as consisting of the sequence of the letters 'c' and 'b' (§ 80). Thus, the earlier marks consist of a figurative element composed of two rounded shapes, whereas the mark applied for consists of a word element, 'ccb', the marks are visually dissimilar (§ 106, 109).



[09/11/2022, T-639/21, CCB / CB \(fig.\) et al., EU:T:2022:698](#)

### **Comparison of signs – Description of the mark contained in the application and in the EUIPO database – No relevance on the perception of marks by the relevant public**

The identification of a mark in the EUIPO database, which has an exclusively administrative purpose, cannot be decisive for the purpose of assessing its perception by the relevant public (§ 88).



[09/11/2022, T-639/21, CCB / CB \(fig.\) et al., EU:T:2022:698](#)

### **Perception of a figurative sign – Financial sector**

The average consumer evaluates the sign in a purchasing situation, during which the consumer does not habitually engage in a detailed analysis. This applies also to the process of purchasing financial services, the average consumer will not engage in an analysis which goes beyond what may reasonably be expected of him or her in a purchasing situation (§ 99).



[09/11/2022, T-639/21, CCB / CB \(fig.\) et al., EU:T:2022:698](#)

### **Comparison of signs – Perception of the figurative sign**

It is unlikely that the average consumer, who normally perceives a mark as a whole and does not carry out an analysis of its details at the time of purchase, will be capable of spontaneously associating the contested figurative sign with the head of an animal, or even with the head of a canine, without engaging in an analysis which goes beyond that expected at the time of purchase (§ 38).



[09/11/2022, T-596/21, Figurative mark / Wolf Jardin \(fig.\) et al., EU:T:2022:697](#)

### **Visual similarity – Principle of imperfect recollection**

The relevant public will not memorise the differentiating weak elements of the marks, such as the upper or lower case letters, the fact that the upper part of the earlier mark consists of the head of a zebra and the lower part of the body of a human being, the shape of the stripes of the zebras, or even the configuration of the marks (§ 44, 45).



[07/12/2022, T-159/22, Las Cebras \(fig.\) / LEZEBRA \(fig.\), EU:T:2022:772](#)

## No LOC – No visual similarity

Although the signs share certain features, they are represented differently in each of the signs. The overall impression produced by the signs at issue is so different that the relevant public will not establish a link between those signs on the ground that they share certain features and the same colours (§ 45-47).



[19/04/2023, T-491/22, B \(fig.\) / \\$ \(fig.\) et al., EU:T:2023:203](#)

## Visual similarity – Impact of weak elements due to their size and position

Although the verbal elements could allude to the potentially descriptive term ‘sanitario’, this does not per se prevent a finding of average visual similarity, because the size and the position of these elements must also be taken into account (§ 39, 40).



**SANÝTOL**

[07/06/2023, T-541/22, Sanity Group \(fig.\) / SANYTOL \(fig.\) et al., EU:T:2023:310](#)

## LOC – Similarity of the signs – No monopoly over the representation of a dog breed

By finding at least a low degree of visual similarity between the signs, the BoA did not create a monopoly on the faithful representation of a dachshund. The protection granted to the earlier mark has not been unduly extended, since the proprietor registered the representation, in profile, of a dog belonging to the dachshund breed, in basic monochromatic colours, as a figurative mark (§ 61-62).



GILBERT TECKEL



[25/10/2023, T-773/22, GILBERT TECKEL \(fig.\) / DEVICE OF A DACHSHUND IN BLACK \(fig.\) et al., EU:T:2023:674](#)

## 2.3.3 Phonetic comparison

### 2.3.3.1 Elements to be taken into account

#### Different pronunciation in different languages

The English-speaking and the German-speaking parts of the relevant public pronounce the term ‘wyld’ differently and therefore the latter does not associate that term with ‘wild’ (§ 85).

[26/11/2019, T-711/18, Wyld / Wild Crisp et al., EU:T:2019:812, § 85, 89](#)

#### Number of syllables – Tonic stress – Overall impression by complete pronunciation

The different number of syllables in the word elements ‘FAKEDUCK’ and ‘SAVE THE DUCK’ is not enough to exclude phonetic similarity between the signs since the similarity will be assessed considering the overall impression made by their complete pronunciation (§ 49). Although the public usually gives more importance to the initial part of a mark, the fact that the tonic stress falls on the word ‘duck’ makes the marks highly similar (§ 50).

[15/07/2020, T-371/19, FAKEDUCK \(fig.\) / Save the duck \(fig.\) et al., EU:T:2020:339, § 50](#)

### Identical numbers placed at the beginning of the mark

The degree of phonetic similarity between the signs 5Ms (fig.) and 5J (fig.) is average since they share the number five placed at the beginning of their word elements, to which consumers generally pay greater attention and which plays a decisive part in the phonetic assessment of the mark applied for (12/12/2017, T-815/16, opus AETERNATUM / OPUS, EU:T:2017:888, § 60) (§ 49). This is all the more so when, for a significant part of the relevant public, the pronunciation of the number five is longer than the pronunciation of the second part of the word elements of the signs, i.e. the letter 'j' or the combination of the letters 'M' and 's' respectively (§ 50).



02/12/2020, T-639/19, [5MS MMMMM \(fig.\) / 5J \(fig.\)](#), EU:T:2020:581, 50

### Phonetical comparison of the signs – Stylisation of letters – Illegible signs

Illegible signs cannot be pronounced so no phonetical comparison is possible (§ 72).



01/09/2021, T-463/20, [Gt racing / GT \(fig.\)](#)

[et al.](#), EU:T:2021:530, § 72

### Phonetic similarity – Abbreviation of marks comprising a number of terms

When speaking, the average consumer will tend to abbreviate a mark comprising a number of terms in order to make it easier to pronounce and, moreover, generally take more note of the beginning of a sign than of its end. Consumers tend to omit certain word elements of a mark when pronouncing it, in particular, in order simply to economise on words, if those elements are easily separable (§ 56, 57).

[21/12/2022, T-264/22, MK MARKTOMI MARKTOMI \(fig.\) / MK MICHAEL KORS \(fig.\) et al.](#), EU:T:2022:861

### LOC – Phonetic similarity – Descriptive element in a secondary position

It is highly probable that an element that is descriptive and in a secondary position will be ignored by the relevant public (§ 83).



[08/03/2023, T-172/22, termorad ALUMINIUM PANEL RADIATOR \(fig.\) / Thermrad](#), EU:T:2023:112

### LOC – Phonetic similarity – Difficulty to pronounce a word element

When a verbal element is in a secondary position and it is difficult to pronounce for the relevant public on account of both its length and letters, which do not exist in the relevant public's alphabet, it is likely that that element will not be pronounced (§ 72-73).



[26/04/2023, T-147/22, pinar KURUYEMIS \(fig.\) / Pinar et al.](#), EU:T:2023:213  
[26/04/2023, T-148/22, pinar KURUYEMIS \(fig.\) / Pinar et al.](#), EU:T:2023:214

### Phonetic comparison – Pronunciation of words in Spanish

Since, in Spanish, all letters are pronounced, the Spanish public will pronounce the final letter 'e' in the contested sign 'BIOPÔLE' (§ 57, 58). The principle according to which consumers tend to

shorten long signs consisting of various elements does not mean that consumers will leave out the last letters of words (§ 64)

[17/01/2024, T-61/23, BIOPÔLE / AGUA BIOPOLAR et al., EU:T:2024:10](#)

### Phonetic similarity – Number of syllables

Since the earlier signs have twice the number of syllables as the contested sign, there is an average – albeit not high – degree of phonetic similarity (§ 37).



[07/02/2024, T-318/23, J&B BRO \(fig.\) / 4BRO \(fig.\) et al., EU:T:2024:70](#)

### 2.3.3.2 Figurative signs

#### No phonetic comparison

Since the mark applied for does not contain any verbal elements, there is no need for a phonetic comparison (§ 39)



[12/12/2019, T-266/19, \(fig.\) / gastivo \(fig.\) \(II\), EU:T:2019:854, § 39](#)

#### No phonetic comparison of purely figurative marks

Purely figurative marks that contain no word elements cannot be subject to phonetical comparison (§ 73-76).



[12/01/2022, T-366/20, DEVICE OF ROUND ELEMENT RESEMBLING A BRUSHSTROKE \(fig.\) / ORIGIUM 1944 \(fig.\), EU:T:2022:4, § 73-76](#)

#### Phonetic comparison not possible – Knowledge of the existence of a letter of the alphabet which does not exist in the languages understood by the relevant public

Knowledge of the existence of a letter of the alphabet which does not exist in the languages understood by the relevant public cannot be assumed (§ 39-41). As regards the pronunciation of letters which do not exist in the languages understood by the relevant public, the case-law according to which it is difficult to establish with certainty how the average consumer will pronounce a word from a foreign language in his own language, must be applied. According to that case-law, it is far from certain that the word will be recognised as being foreign and even if it is, it may not be pronounced correctly as it is in the original language. In the assessment of LOC, it will also still be necessary to establish that a majority of the relevant public is able to pronounce the word in question correctly (§ 41-42).



[14/07/2021, T-399/20, Ø \(fig.\) / DEVICE OF A CIRCLE CROSSED BY A VERTICAL LINE \(fig.\) et al., EU:T:2021:442, § 39-42](#)

#### LOC – Phonetical comparison of figurative signs – Semantic content must immediately be associated with a specific, concrete word

A phonetic comparison of the signs is irrelevant in the examination of the similarity of a purely figurative mark with another mark (§ 69). A phonetic comparison between a figurative mark

containing a word element and a purely figurative mark implies that the semantic content of the latter mark can immediately be associated with a specific, concrete term (03/05/2017, T-681/15, REPRÉSENTATION D'UNE TÊTE DE LOUP (fig.) / WOLF Jardin (fig.) et al., EU:T:2017:296, § 52-53; 30/01/2020, T-559/19, DEVICE OF A WHITE DECIDUOUS TREE AGAINST A BLUE BACKGROUND (fig.) / DEVICE OF A FIR TREE SILHOUETTE ON A BASE (fig.) et al., EU:T:2020:19, § 34-36) (§ 71-72, 75, 80-82). In the present case, the figurative mark can be referred to orally in different ways, and it is not possible therefore to attribute a sound to it (§ 75). The BoA correctly found that a phonetic comparison was not possible (§ 83). The signs are conceptually similar to at least an average degree (§ 103).

Considering the particular importance of the visual aspect in the clothing industry (§ 111-113), there is a likelihood of confusion between the signs for the English-speaking public of the EU with an average level of attention for identical or similar goods and services (§ 120).



[21/12/2021, T-699/20, 1st AMERICAN \(fig.\) / DEVICE OF A BIRD \(fig.\), EU:T:2021:928, § 48, 51, 60, 63, 69, 71-72, 75, 80-82, 83, 103, 120](#)

### Phonetic assessment of a purely figurative mark

A phonetic comparison of signs is irrelevant in the context of examining the similarity of a purely figurative mark with another mark. A purely figurative mark cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. However, such a description necessarily coincides with either the visual perception or the conceptual perception of the mark concerned. Consequently, it is not necessary to examine separately the phonetic perception of a purely figurative mark and to compare it with the phonetic perception of other marks (§ 47).



[05/10/2022, T-696/21, LES BORDES \(fig.\) / DEVICE OF A STAG'S HEAD \(fig.\) et al., EU:T:2022:602](#)

### No phonetic comparison – Purely figurative mark

A phonetic comparison of the signs at issue is irrelevant in the examination of the similarity of a purely figurative mark with another mark. A figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Consequently, it is not necessary to separately examine the phonetic perception of a figurative mark lacking word elements and to compare it with the phonetic perception of other marks. Where a purely figurative mark represents a shape that the relevant public is easily able to recognise and associate with a specific, concrete word, they will use that word to refer to the mark, whereas if a figurative mark also includes a word element, in general it will be through the use of that word element that the relevant public will refer to the mark. However, that is contingent on the semantic content of the purely figurative mark being immediately identifiable, and that it can be associated with a specific, concrete word (§ 56-58).



[19/04/2023, T-491/22, B \(fig.\) / \\$ \(fig.\) et al., EU:T:2023:203](#)

## Dissimilarity of the signs – Purely figurative mark – No phonetic comparison

A figurative mark without verbal elements cannot, by definition, be pronounced. At most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual or conceptual perception of the mark in question. Consequently, it is not necessary to examine separately the phonetic perception of a figurative mark lacking verbal elements and to compare it with the phonetic perception of other marks (§ 50).



[12/07/2023, T-487/22, Device of two black interrelated geometrical shapes \(fig.\) / mó \(fig.\) et al., EU:T:2023:391](#)

### 2.3.4 Conceptual comparison

#### 2.3.4.1 Words

##### Possibility of a conceptual comparison

It is apparent from case-law that, in the conceptual comparison of the signs, where at least one of the signs conveys a concept that is understood by a significant part of the relevant public, a conceptual comparison is possible and cannot be qualified as neutral (§ 57-60, 66).

[08/05/2019, T-37/18, Brave Paper / BRAVO, EU:T:2019:300, § 57-60, 66](#)

##### Possibility of a conceptual comparison

Conceptual differences can exist even if only one of the two compared signs has a clear meaning (§ 75-76).

[12/07/2019, T-698/17, MANDO / MAN \(fig.\) et al., EU:T:2019:524, § 75-76](#)  
[19/09/2019, T-176/17, VEGA ONE \(fig.\) / Vegas et al., EU:T:2019:625, § 82](#)

##### Limited role of the conceptual comparison – Common weakly distinctive word element

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



[09/09/2020, T-589/19, Fair Zone / FAIR \(fig.\), EU:T:2020:397, § 62](#)

##### Limited role of the conceptual comparison – Common weakly distinctive word element

Even though the relative weight of a shared descriptive element is considerably reduced in the visual or phonetic comparison of the signs, its presence must still be taken into account in the comparison (26/11/2015, T-262/14, BIONECS / BIONECT, EU:T:2015:888, § 49 and 56) and cannot be disregarded (§ 72) (07/11/2017, T-144/16, MULTIPHARMA / MUNDIPHARMA, EU:T:2017:783, § 42 and 49) (§ 72-74).

[15/10/2020, T-49/20, ROBOX / OROBOX, EU:T:2020:492, § 72-74](#)

##### Different pronunciation in different languages – Consequence for conceptual comparison

The English-speaking and the German-speaking parts of the relevant public pronounce the term 'wyld' differently and therefore the latter does not associate that term with 'wild' (§ 85). As a

consequence of this phonetical assessment, the signs **wyld** and **WILD CRISP** are conceptually very similar only for the English-speaking part of the relevant public. For the German-speaking part of the relevant public, the mark **wyld** is void of any meaning (§ 89).

26/11/2019, T-711/18, [Wyld / Wild Crisp et al.](#), EU:T:2019:812, § 85, 89

### **Lack of knowledge of the existence of a letter of the alphabet which does not exist in the languages understood by the relevant public – Consequence for conceptual comparison**

Knowledge of the existence of a letter of the alphabet which does not exist in the languages understood by the relevant public cannot be assumed (§ 39-41). As regards the pronunciation of letters which do not exist in the languages understood by the relevant public, the case-law according to which it is difficult to establish with certainty how the average consumer will pronounce a word from a foreign language in his own language, must be applied. According to that case-law, it is far from certain that the word will be recognised as being foreign and even if it is, it may not be pronounced correctly as it is in the original language. In the assessment of LOC, it will also still be necessary to establish that a majority of the relevant public is able to pronounce the word in question correctly (§ 41-42).

A conceptual comparison is likewise not possible where no evidence is produced capable of demonstrating, that the relevant public would identify the marks for as a representation of a letter used in a foreign language and that that public would understand the meaning of the mark (§ 54).



14/07/2021, T-399/20, [Ø \(fig.\) / DEVICE OF A CIRCLE CROSSED BY A VERTICAL LINE \(fig.\) et al.](#), EU:T:2021:442, § 39-42, 54

### **Conceptual Dissimilarity – Specific meaning – No meaning**

The signs are conceptually different, since the earlier mark has a specific meaning, whereas the contested mark has no meaning (19/09/2017, T-768/15, RP ROYAL PALLADIUM (fig.) / RP, EU:T:2017:630, § 88-89) (§ 87).



02/12/2020, T-687/19, [Marq / MARK \(fig.\) et al.](#), EU:T:2020:582, § 87

### **Conceptual similarity – Common element having a very low degree of distinctiveness**

Where the common concept to which the signs refer is conveyed by a term which, at most, has a very low degree of distinctiveness, this does not preclude a finding that there is – to varying degrees – a conceptual similarity (§ 61).

24/03/2021, T-168/20, [Creatherm / Ceretherm](#), EU:T:2021:160, § 61

### **Conceptual similarity – Imperfect recollection – No necessity of relation between concept and goods and services**

From a conceptual point of view, the earlier mark 'KOLIBRI' may, in German, refer to a hummingbird. A significant part of the relevant German public may also perceive in the marks applied for, 'COLLIBRA' and 'collibra', an allusion to the concept of a hummingbird, given the similarity in the pronunciation of the words 'collibra' and 'kolibri'. The average consumer normally perceives a mark as a whole and does not engage in an analysis of its details. When perceiving a word sign however, he or she will recognise word elements which, for him or her, suggest a specific meaning or which resemble words known to him or her. The fact that the concept of a hummingbird bears no relation to the goods and services covered by the marks applied for is irrelevant given that these marks resemble the German word 'kolibri', which is known by a non-

negligible part of the German public. Consequently, there is a high degree of conceptual similarity between the signs (§ 69).



22/09/2021, T-128/20 & T-129/20, [Collibra / Kolibri et al.](#), EU:T:2021:603, § 69

### Conceptual comparison requiring prior translation

'AQUA' is a common Latin term, meaning 'water', which the EU consumer may be assumed to know (28/11/2013, T-410/12, *vitaminaqua*, EU:T:2013:615, § 57). Furthermore, the meaning of 'aqua' will be understood by Romanian, Portuguese, Spanish, Italian and French consumers. As for the term 'VODA', it means 'water' and is understood by the part of the relevant public that understands Slovenian, Czech, Bulgarian, Polish or Slovak (§ 84-85).

For a significant part of the relevant public (namely EU consumers to whom the Latin term 'aqua' is well-known and those who understand the term 'voda') there will be a certain conceptual similarity requiring prior translation, given the identical meaning of those two terms. However, that similarity results solely from the descriptive elements 'aqua' and 'voda' which convey the same concept of 'water' in two different languages. Due to the weak distinctive character of the common concept of 'water', a conceptual comparison, requiring prior translation, is possible in these circumstances. The signs at issue have, at most, an average degree of conceptual similarity in that they refer to the same concept of 'water' (§ 87-88).



12/05/2021, T-637/19, [Aqua Carpatica \(3D\) / VODAVODA \(3D\)](#), EU:T:2021:222, § 84-85, 87-88



12/05/2021, T-638/19, [AC Aqua AC \(3D\) / VODAVODA \(3D\)](#), EU:T:2021:256, § 84-85, 87-88

### Conceptual comparison – No consideration of evidence of use

In the context of the assessment under Article 8(1)(b) EUTMR, the conceptual analysis of the earlier mark must be limited to the mark as such and cannot be derived from the analysis of the evidence of use (§ 110).



01/09/2021, T-23/20, [the DoubleF \(fig.\) / The double](#), EU:T:2021:523, § 110

### Conceptual similarity – Relevant public's knowledge of a language other than its mother tongue – Basic English words

Basic English words, such as 'tree', will be understood by the majority of the Portuguese public (§ 51).

[28/09/2022, T-572/21, Copal tree / COMPAL \(fig.\) et al.](#), EU:T:2022:594

### No conceptual comparison – No meaning of the sign as a whole

Despite of the meaning of a component, conceptual comparison is not possible when the signs as a whole do not have a meaning (§ 83-85).

[21/12/2022, T-250/19, Tradicion cz s.l. / Rivero cz et al., EU:T:2022:838](#)

### **No conceptual comparison – Fanciful word**

Even for the part of the public, which is likely to perceive a link with the concept of ‘character’ in both marks, the conceptual comparison remains neutral since the mark applied for is a fanciful word combination with no meaning (§ 76-77).

[21/12/2022, T-43/22, Sanrio characters / Caractère, EU:T:2022:844](#)

### **No conceptual similarity**

The assessment of the conceptual similarity must be based on the overall impression conveyed by the marks. Accordingly, the relevant Spanish public will not perceive the word ‘AVANZA’ independently in both marks and, in particular, in the expression ‘AVANZA TU NEGOCIO’ contained in the mark applied for (§ 90).



Avanza Credit de Deutsche Bank

[15/02/2023, T-341/22, avanza Tu negocio \(fig.\) / Avanza Credit de Deutsche Bank \(fig.\), EU:T:2023:73](#)

### **Low conceptual similarity – Partly different concepts**

The term ‘me’ in the earlier mark means ‘myself’ and thus refers to a single person, whose gender is not specified, whereas the mark applied for refers to two persons, one of whom is male. The marks at issue may therefore be perceived as referring to concepts that are partly different, which is likely to reduce the conceptual similarity between them (§ 63).

[01/03/2023, T-25/22, HE&ME \(fig.\) / Me, EU:T:2023:99](#)

### **Conceptual similarity – Weak common element**

A certain conceptual similarity can be found in the clearly defined and limited situation where the relevant public would perceive the elements common to the signs as alluding the potentially descriptive term ‘sanitario’ (§ 53-56).

[07/06/2023, T-541/22, Sanity Group \(fig.\) / SANYTOL \(fig.\) et al., EU:T:2023:310](#)

### **Conceptual dissimilarity**

The signs are conceptually different even where the element of conceptual difference has a low degree of distinctiveness, or none at all (§ 67).



[06/09/2023, T-576/22, TRUE SKIN / TRUE \(fig.\), EU:T:2023:509](#)

### **No LOC – Low conceptual similarity – Weak common element**

Where the concept evoked by a common element is related to the relevant goods, it will only give rise to a low degree of conceptual similarity (§ 56).

[06/09/2023, T-728/22, Namlac / Analac \(fig.\), EU:T:2023:511](#)

### **High conceptual similarity**

The signs at issue refer to the concept of 'dream' or to the fact of 'dreaming of California' (§ 73). It has not been shown that the perception of the EUTM application as a reference to a song or a film will be so strong that any conceptual similarity can be ruled out (§ 76).

[11/10/2023, T-542/22, CALIFORNIA Dreaming by Made in California \(fig.\) / CALIFORNIA DREAM et al., EU:T:2023:611](#)

### **LOC – Conceptual similarity**

Even assuming that the word 'after' is understood by the relevant public as a whole, the difference between the signs arising from the presence of the word element 'after' is not sufficient to call into question the similarity at conceptual level which is based on the fact that the signs at issue share the word element 'life' (§ 82).

[21/02/2024, T-175/23, LifeAfter / life et al., EU:T:2024:109](#)

### **2.3.4.2 Names**

#### **Conceptual comparison of signs referring to surnames or first names of persons**

As regards the conceptual comparison in the case of signs referring to surnames or first names of persons, according to one line of case-law the fact that marks contain surnames or first names raises the possibility of a conceptual comparison, but does not necessarily imply that there is a conceptual similarity, which can result only from an examination of each individual case. According to a second line of case-law, a conceptual comparison between trade marks composed of surnames or first names of persons is in principle impossible and neutral, unless there are special circumstances which make such a comparison possible, for example, the celebrity of the person concerned or the semantic content of a name (16/12/2020, T-863/19, Pcg Calligram Christian Gallimard / Gallimard, EU:T:2020:632, § 101-106 and the case-law cited, under appeal) (§ 63).

**EROLF**

[30/06/2021, T-531/20, ROLF \(fig.\) / Wolf et al., EU:T:2021:406, § 63](#)

#### **No LOC – Conceptual Dissimilarity – Personal name mark – Reputation of the earlier mark**

Within the global assessment of LOC, the reputation or recognition enjoyed by the earlier mark must be taken into account. However, account must also be taken of whether the person who requests that their first name and surname, taken together, be registered as a trade mark is well known, since that factor may obviously influence the perception of the mark by the relevant public (24/06/2010, C-51/09 P, Barbara Becker, EU:C:2010:368, § 37) (§ 46-48).

[17/09/2020, C-449/18 P & C-474/18 P, MESSI \(fig.\) / MASSI et al., EU:C:2020:722, § 46-48](#)

#### **No LOC – Common first name less distinctive than family name**

When comparing signs that have in common a first name and differ in that only one of them includes a surname, it is to be considered, inter alia, how common in the relevant territory the surname is compared to the first name (§ 69-70).

The element 'ferragni' will be memorised by the consumer as a more distinctive element than the first name, taking into account that Ferragni is an uncommon surname in the Benelux territory, and rarer than the name Chiara (perceived as an Italian common name insofar as this name is known in the local language versions, i.e. the French ('Claire') and German ('Klara') versions

(§ 70). The mark applied for also includes a figurative element with clear semantic content (§ 73). Taking into account the visual differences between the signs, there is no LOC (§ 84-86).



CHIARA FERRAGNI 08/02/2019, T-647/17, [CHIARA FERRAGNI \(fig.\) / Chiara](#), EU:T:2019:73, § 69-70, 73, 84-86

### **Distinctive and dominant elements – Mark consisting of a combination of a first name and surname**

The BoA was mistaken in automatically applying, without taking due account of the specific features of the present case, the rule that in certain Member States consumers remember surnames rather than first names (§ 35). MILEY CYRUS refers to the first name and surname of the famous singer and actress, who is known by that first name and that surname together, and not by her first name or surname separately (§ 37). The two elements are equally distinctive, and one cannot therefore be considered dominant in relation to the other (§ 38).



16/06/2021, T-368/20, [Miley cyrus / Cyrus \(fig.\) et al.](#), EU:T:2021:372, § 35, 37-38

### **Conceptual comparison – Mark consisting of a combination of a first name and surname – Conceptual neutralisation**

Since Miley Cyrus is a public figure of international reputation known to most well-informed, reasonably observant and circumspect people who read the press, watch television, go to the cinema or listen to the radio, where they can see her or listen to her sing, or where she is regularly spoken of, the relevant public will understand the mark applied for to be the name of the famous American singer and actress (§ 51).

A conceptual comparison is possible where the first name or the surname in question has become the symbol of a concept, due, for example, to the celebrity of the person with that first name or surname, or where that first name or surname has a clear and immediately recognisable semantic content (§ 54). This is the case here. The BoA should have concluded, on the basis of its own findings, that the relevant public was likely to make a conceptual association between the group of words 'miley cyrus' and the name of the famous American singer and actress. Miley Cyrus has become the symbol of a concept, due to the celebrity of the person with that name (§ 56).

The mere fact that the surname Cyrus is not common, does not mean that the relevant public will perceive that word, taken alone, as referring to the famous singer and actress Miley Cyrus, who, according to the evidence, has never specifically used the name Cyrus in isolation during her career. It must therefore be held that the earlier mark has no particular semantic meaning for the relevant public (§ 58). The signs in question are therefore conceptually different (§ 59).

According to case-law, such conceptual differences may counteract, in certain circumstances, phonetic and visual similarities between the signs in question. For this to be the case, at least one of the signs must have a clear and specific meaning for the relevant public allowing them to grasp the meaning immediately (§ 60). This is the case here. The mark applied for, 'MILEY CYRUS', has a clear and specific semantic content for the relevant public given that it refers to a public figure of international reputation, known by most well-informed, reasonably observant and circumspect people, whereas the earlier mark has no particular semantic meaning. Furthermore, the reputation of the singer and actress Miley Cyrus is such that it is not plausible, in the absence of specific evidence to the contrary, that the average consumer when confronted with the mark MILEY CYRUS designating the goods and services in question, will disregard the meaning of that sign as the name of the famous singer and actress and perceive it principally as a mark, among

other marks, of such goods and services (§ 61). It follows that the conceptual differences existing in the present case between the marks at issue counteract their visual and phonetic similarities, resulting in the signs being different (§ 62-63).

The logo for 'CYRUS' features the word in a bold, sans-serif font. The letter 'Y' is stylized with three diagonal lines extending from its top left corner.

16/06/2021, T-368/20, [Miley cyrus / Cyrus \(fig.\) et al.](#), EU:T:2021:372, § 51, 54, 56, 58-60, 62-63

#### **LOC – Case-law that first name less distinctive than family name – Applicability only for signs composed of name and surname – Conceptual similarity due to common first name**

The case-law according to which the first name is less distinctive than the family name (20/02/2013, T-631/11, B Berg, EU:T:2013:85, § 48; 08/02/2019, T-647/17, CHIARA FERRAGNI (fig.) / Chiara, EU:T:2019:73, § 60) concerns only signs formed by the first name and surname of a person and is not applicable where the marks under comparison merely comprise a first name (§ 39).

The existence of a similarity between two marks does not presuppose that their common component forms the dominant element within the overall impression created by the mark applied for. In order to assess the similarity of two marks, it is necessary to consider each of the marks as a whole, although that does not rule out the possibility that the overall impression created in the mind of the relevant public by a complex trade mark may, in certain circumstances, be dominated by one or more of its components. It is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element. It is sufficient in that regard for the common component not to be negligible (27/09/2018, T-449/17, SEVENFRIDAY / SEVEN et al., EU:T:2018:612, § 28) (§ 44).

The greater or lesser degree of distinctiveness of the elements common to the mark applied for and an earlier mark is one of the relevant factors in assessing the similarity of those signs (10/11/2016, T-67/15, POLO CLUB SAINT TROPEZ HARAS DE GASSIN (fig.) / BEVERLY HILLS POLO CLUB (fig.) et al., EU:T:2016:657, § 49) (§ 60).

The signs are visually (§ 61-67) and phonetically (§ 68-70) similar to an average degree, and show some conceptual similarity (§ 71-72). The distinctive character of the earlier trade mark being normal, there is a LOC (§ 79, 89).

The logo for 'CARL touch' features the word 'CARL' in a bold, sans-serif font above the word 'touch' in a smaller, lowercase sans-serif font. A small circular icon with a stylized 't' is positioned to the right of 'touch'.

18/11/2020, T-377/19, [Tc carl / carl touc \(fig.\) et al.](#), EU:T:2020:546, 39, 44, 60, 79, 89

#### **LOC – Signs composed of an identical surnames – Addition of a first name – Conceptual similarity due to common surname**

Where marks are composed of an identical element understood as a surname, the mere addition in one of the marks of a first name, in this case 'Christian', cannot create a conceptual difference between those marks. On the contrary, those marks will be understood by the relevant public as designating the names of people and, more particularly, of people having the same surname (08/11/2017, T-271/16, Thomas Marshall Garments of legends (fig.) / MARSHALL et al., EU:T:2017:787, § 78) (§ 109).

16/12/2020, T-863/19, [PCG CALLIGRAM CHRISTIAN GALLIMARD / GALLIMARD et al.](#), EU:T:2020:632, § 109

#### **Sign comprising a surname and/or first name – Assessment of distinctive and dominant character**

The assessment of the distinctive and dominant character of the sign's elements comprising a surname and/or first name must be conducted with an examination of all relevant factors, including their rarity or commonness in the Member States concerned (§ 44-45, 47).

22/05/2019, T-197/16, [ANDREA INCONTRI / ANDREIA et al.](#), EU:T:2019:347, § 44-45, 47

### **Distinctive character of a first name and a surname – Wine and alcoholic beverages**

In the wine and alcoholic beverages sector, the use of a sign containing a combination of a first name and surname is a common practice. Therefore, even if the public is not familiar with a first name (e.g. 'Jaume'), given the context, it could perceive it as such (§ 45). Depending on the circumstances of the case, the fact that a surname is unusual or very common may affect the distinctive character of the mark (§ 50). In the wine sector, when the conflicting signs consist of a first name that is not particularly rare or unusual and of surnames that are not particularly common in the relevant territory, the surnames are more distinctive than the first name (§ 53, 55).

The evidence submitted in relation to the earlier mark's reputation concerns the mark as a whole (i.e. first name and surname) and cannot be attributed only to one of the elements (i.e. 'Jaume') (§ 60).

Conceptual similarity has no bearing on the degree of similarity between signs where both signs represent a combination of first name and surname since they will be perceived as identifying two separate individuals coming from different families (§ 77-81).

The protection conferred by the registration is granted to the mark as a whole and not to each element separately (§ 86). Where it has not been proved that one of the elements (e.g. 'Jaume') is perceived separately in the earlier mark, the EUTM applied for cannot be considered as a sub-brand derived from the earlier mark (§ 87).

08/05/2019, T-358/18, [JAUME CODORNÍU / JAUME SERRA et al.](#), EU:T:2019:304, § 86-87

### **Signs consisting of first names and surnames – Wine sector – Conceptual comparison**

A conceptual comparison between two signs consisting solely of first names and surnames is possible where the first name and surname in question have become the symbol of a concept, due, for example, to the celebrity of the person carrying that first name or surname, or where that first name or that surname has a clear and immediately recognisable semantic content (§ 86).

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

27/06/2019, T-268/18, [Luciano Sandrone / DON LUCIANO](#), EU:T:2019:452, § 86, 98-99

### **Personal name mark – Wine sector – Conceptual similarity**

In the wine-growing world, names carry great weight, whether surnames or names of vineyards, since they are used to reference and designate wines. In general, consumers usually describe and recognise wines by reference to the word element which identifies them and that this element designates, in particular, the grower or the estate on which the wine is produced (§ 44).

The verbal element 'LOPEZ' will be understood as a surname by the relevant public, both Spanish- and non-Spanish-speaking part. The latter part will recognize it as a surname since it is borne by famous people. However, this part of the relevant public is not aware of the frequency

of its use and therefore will not perceive it as a common surname. Thus, the non-Spanish-speaking part of the relevant public will be likely to think that different people with that name belong to the same family. The verbal elements 'HEREDIA' and 'HARO' will not have a concrete semantic meaning for this part of the relevant public. The word 'DE' will be understood, at most, as a preposition that can be used to designate the geographical origin of someone or something. The non-Spanish-speaking part of the relevant public will associate the conflicting marks with persons belonging to the same family of wine producers who market, under their own names, wines from different vineyards. Therefore, there is a high degree of conceptual similarity (§ 44-47).

**LOPEZ DE HARO** 27/04/2022, T-210/21, [LOPEZ DE HARO \(fig.\) / Lopez de Heredia et al., EU:T:2022:244, § 44](#)

### **Conceptual comparison of names**

It is not completely settled on how to carry out a conceptual comparison in the case of signs referring to surnames or first names (§ 65). According to one line of case-law, the fact that marks contain surnames or first names opens up the possibility of a conceptual comparison, but does not necessarily imply that there is a conceptual similarity between the sign (§ 66). According to the other case law line, names do not have any specific conceptual meaning, unless the first name or surname is particularly well known, and thus the comparison is usually neutral (§ 67). In this case, any possible conceptual difference resulting from the first name at issue cannot offset the visual and phonetic similarities which have been held to exist (§ 80).

[19/10/2022, T-718/21, Maeselle / MARCELLE \(fig.\), EU:T:2022:647](#)

See also, [19/10/2022, T-716/21, MAESELLE \(fig.\) / MARCELLE \(fig.\), EU:T:2022:646, § 27, 28, 68, 69, 70, 83](#)

### **Surnames – Average degree of distinctiveness**

The degree of distinctiveness of an element identified as a surname is not high but average (§ 61).

[21/12/2022, T-250/19, Tradicion cz s.l. / Rivero cz et al., EU:T:2022:838](#)

### **Conceptual similarity – Common surname**

Since the marks at issue will be perceived as referring to the same common French surname, they may be regarded as conceptually similar (§ 58).

[01/02/2023, T-671/21, Duuval / GROUPE DUVAL \(fig.\) et al., EU:T:2023:33](#)

### **LOC – No conceptual comparison – First names**

For the purposes of a conceptual comparison, first names, in general, do not convey any concept (§ 55, 62).

[08/02/2023, T-24/22, Loulou studio / Lulu's et al., EU:T:2023:54](#)

### **Perception of a name**

Although in principle any given name can also be a surname, a common or well-known given name will initially be recognised as such by the relevant public (§ 50).



TC CARL



[15/02/2023, T-8/22, TCTC CARL \(fig.\) / carl touch \(fig.\), EU:T:2023:70](#)

### **No LOC – Conceptual dissimilarity – Surname**

The signs have different concepts. Despite the fact that both marks share the element ‘GRUND’ it will be associated with different meanings in the signs: in the earlier mark it will be associated with ‘soil’ whereas in the contested sign the relevant public will grasp the meaning of a family name due to the addition of the given name ‘Josef’ (§ 47-50).

 [19/04/2023, T-749/21, Josef grund gerüstbau / grund \(fig.\), EU:T:2023:200](#)

### **LOC – Conceptual similarity – Surnames**

The verbal elements ‘mac’ and ‘mc’ are perceived by at least a substantial part of English-speaking consumers as a concept referring to a Gaelic surname; therefore, they are conceptually similar to an average degree (§ 46).

 [26/04/2023, T-681/21, mccosmetics NY \(fig.\) / MAC MAKE-UP ART COSMETICS \(fig.\) et al., EU:T:2023:215](#)

### **Conceptual comparison – First names – No neutralisation – Conceptual differences irrespective of various meanings**

The word ‘eva’, as a female first name, conveys semantic content, whereas the sign ‘EVAX’, being merely a fanciful name, is devoid of such content. According to case-law, where one of the marks at issue has a meaning from the perspective of the relevant public and the other mark has no meaning, it must be found that the marks in question are conceptually dissimilar (§ 88-91).

However, the relevant public does not understand the word ‘eva’ only as a first name and as such in a clear and uniform manner. Therefore, the only conceptual difference between the signs is not such that the signs at issue produce a different overall impression (§ 98, 99). The conceptual difference must nonetheless be taken into account in the global assessment of LOC (§ 100).

[21/06/2023, T-197/22 & T-198/22, InterMed Pharmaceutical Laboratories eva intima \(fig.\) / Evax et al., EU:T:2023:345](#)

### **Conceptual comparison – Perception of a name – Burden of proof**

It is incumbent on the party relying on a certain perception of a name to provide evidence to that effect (§ 52-53).

[26/07/2023, T-439/22, RADA PERFUMES \(fig.\) / PRADA \(fig.\) et al., EU:T:2023:441](#)

### **2.3.4.3 Figurative signs, colours and shapes**

#### **Different overall impression**

As regards the conceptual comparison, the signs are not similar to an average degree, as stated by the BoA, but different (§ 51). For part of the relevant public the term ‘imagin’ is likely to evoke the Spanish notion of ‘imagen’ or the Spanish verb ‘imaginar’, while the term ‘imagic’ is likely to evoke the Spanish term ‘mágico’ (§ 49). The overall impression produced by the signs is thus different. While the verbal element of the trade mark applied for is likely to evoke what is covered by image, imagination or imagination, the verbal element in the earlier trade mark will rather evoke the idea of magic (§ 50).



19/09/2019, T-761/18, [imagin bank \(fig.\) / imagic \(fig.\)](#), EU:T:2019:627, § 49-51

### Different overall impression

The figurative element of the mark applied for is the dominant part since it is in a more visible position and is thus likely to occupy a position of greater importance, even if imperfectly, in the mind of the consumers. That element will not be perceived by the relevant public as the group of upper-case letters 'IJTI'. The close interconnection of the lines forming the element concerned will lead the consumer who forms part of the relevant public to perceive that element as an abstract and unitary shape rather than as a combination of four upper-case letters forming a group (§ 29). The verbal element 'i.j. tobacco industry' is not totally negligible but has a visually secondary position. It does not alter the assessment (§ 31). The overall impression created by the marks is different, as they do not display sufficient visual, phonetic or conceptual similarities (§ 45).



19/12/2019, T-743/18, [I.J. TOBACCO INDUSTRY \(fig.\) / JTi \(fig.\)](#), EU:T:2019:872, § 29, 31, 45

### Conceptual dissimilarity – Differences in semantic content

The signs convey clear differences in their semantic content (§ 37-38). The mere fact that there is a generic word 'tree' which serves to describe the semantic content of the signs is not such as to establish conceptual similarity. The conflicting marks evoke the concept of 'tree' only in an indirect manner. Thus, the signs will not be perceived as representing an unidentifiable tree, but rather as evoking: (i) the silhouette of a fir tree, or an 'arbre magique' in the case of the international registration, and (ii) a deciduous tree, or the symbol of 'the tree of life' (§ 39).



30/01/2020, T-559/19, [Device of a white deciduous tree \(fig.\) / Device of a fir tree silhouette on a base \(fig.\)](#), EU:T:2020:19

### Conceptual similarity – Low impact of a weakly distinctive part of the figurative element

The relevant public will understand the word element of both marks as referring to a zebra. This perception is reinforced by the figurative element in the marks. In the earlier mark, the public's perception of the figurative element as a zebra is not disturbed by it having a human body, as it characterises a waiter and therefore has, at most, a very weak distinctive character with respect to the services at issue (§ 55, 57).



07/12/2022, T-159/22, [Las Cebra \(fig.\) / LEZEBRA \(fig.\)](#), EU:T:2022:772

### No conceptual comparison

Conceptual similarity arises where two marks use images with analogous semantic content, in the sense that those images convey the same idea or the same concept. The signs at issue, as

different abstract fantasy figures, do not convey any clear meaning. The mere fact that there is a generic phrase 'fantasy figure' which serves to describe the semantic content of the signs at issue is not such as to establish conceptual similarity (§ 65-66).



[19/04/2023, T-491/22, B \(fig.\) / \\$ \(fig.\) et al., EU:T:2023:203](#)

#### 2.3.4.4 Numbers, letters

##### Signs consisting of a single letter – Conceptual comparison

Single letters of the alphabet might have their own conceptual content, so there may be conceptual identity where the signs refer to the same letter of the alphabet (§ 82-84).



[25/06/2020, T-114/19, B \(fig.\) / b \(fig.\), EU:T:2020:286, § 82-84](#)

##### Combination of number and letters – High conceptual similarity

The degree of phonetic similarity between the signs 5Ms (fig.) and 5J (fig.) is average since they share the number five placed at the beginning of their word elements, to which consumers generally pay greater attention and which plays a decisive part in the phonetic assessment of the mark applied for (12/12/2017, T-815/16, opus AETERNATUM / OPUS, EU:T:2017:888, § 60) (§ 49). This is all the more so when, for a significant part of the relevant public, the pronunciation of the number five is longer than the pronunciation of the second part of the word elements of the signs, i.e. the letter 'j' or the combination of the letters 'M' and 's' respectively (§ 50).

The signs also have a high degree of conceptual similarity since they both convey a common concept, namely that of the combination of a number and a letter, which is a consonant represented in capital letter (§ 54).



[02/12/2020, T-639/19, SMS MMMMM \(fig.\) / 5J \(fig.\), EU:T:2020:581, § 50, 54](#)

##### Dominant element due to its size and position – Conceptual similarity to an average degree because of common number – The number '42' is the most distinctive element in the earlier mark, even in respect of *alcoholic beverages* in Class 33

The number '42' dominates the overall impression of the marks, in that, first, it was significantly larger than all the other word elements that appeared in those marks and, second, it occupied a prominent position in the centre of those marks (§ 49, 83).

The signs have in common the reference to the number '42', which results in them having an average degree of conceptual similarity (§ 56, 92).

Although it might be considered that the number '42' of the earlier mark has only a weak distinctive character with regard to some of the goods in Class 33 for part of the relevant public, it nevertheless constitutes the most distinctive element of that mark. The word 'below', as an English adverb placed directly after the number '42', can play only a secondary role in that it is intended to provide additional information in relation to that number. Therefore, consumers would pay closer attention to the number '42' (§ 89).



83, 89, 92

20/01/2021, T-829/19, [Blend 42 Vodka \(fig.\) / 42 below \(fig.\)](#), EU:T:2021:18, 49, 56,



§ 49, 56, 83, 89, 92, 92

20/01/2021, T-830/19, [Blend 42 Vodka \(fig.\) / 42 below \(fig.\)](#), EU:T:2021:19,



EU:T:2021:20, § 50, 59, 86, 92, 95

20/01/2021, T-831/19, [Blend 42 First Czech Blended Vodka \(fig.\) / 42 below \(fig.\)](#),

### Conceptual comparison – Perception of acronyms

Even if part of the relevant public understands the word element ‘euro’ as referring to the currency of the same name, the link between that element and the word element ‘banco’ is not sufficient for it to be possible to conclude that the signs are conceptually similar. The fact that a bank’s activities relate in particular to the management of money does not lead to the conclusion that the relevant public will directly establish a link between those two concepts (§ 102).

The Board of Appeal did not err in finding that consumers were more attentive when confronted with marks that they perceive as acronyms. In such a situation, they will tend to look for the meaning of such marks (§ 109).

02/03/2022, T-125/21, [Eurobic / BANCO BiG BANCO DE INVESTIMENTO GLOBAL \(fig.\) et al.](#), EU:T:2022:102, § 102, 109

### No conceptual comparison

Conceptual comparison of the marks at issue is not possible. Even if the relevant public was to perceive the marks at issue as being abbreviations, that fact could not, in itself, make a conceptual comparison of the marks at issue possible (§ 108, 109).

 [14/12/2022, T-530/21, PL \(fig.\) / PL \(fig\) et al.](#), EU:T:2022:818

### Visual and conceptual similarity – Abbreviation

The public is accustomed to perceiving and interpreting commercial signs combining an expression and an abbreviation of the initials of that expression (§ 34). The addition of an acronym representing the initials of the other word elements of the mark can even support the relevant public’s perception of the word combination of those elements by simplifying its use and by making it easier to remember (§ 37).



[01/02/2023, T-568/21, GC GOOGLE CAR \(fig.\) / Google et al.](#), EU:T:2023:37

### Signs consisting of a single letter – No conceptual comparison

It is not possible to carry out a conceptual comparison between two single letters that have no meaning for the relevant public (§ 58).

[25/10/2023, T-458/21, Q \(fig.\) / Q \(fig.\), EU:T:2023:671](#)

#### 2.3.4.5 Geographical places

[No key points available yet.]

### 2.3.5 Conclusion / Other principles (can also appear in the global assessment)

#### 2.3.5.1 Short signs / Single letters

##### Short signs – Differences in one letter

Regarding the question as to whether a difference in one letter can exclude the similarity of the marks consisting of three letters each, no general rule can be derived from case-law (§ 56-58). Even if the relevant public may perceive differences more clearly in the case of abbreviations, whether the difference in one letter can lead to a different overall impression must be assessed on a case-by-case basis (§ 59).

20/06/2019, T-389/18, [WKU / WKA et al.](#), EU:T:2019:438, § 56-58, 59



20/06/2019, T-390/18, [WKU WORLD KICKBOXING AND KARATE UNION \(fig.\) / WKA et al.](#), EU:T:2019:439, § 56-58, 59, 73

##### Similarity between the signs – Acronyms

Similarity between the signs, which might be perceived as acronyms, must be based on their intrinsic characteristics in the absence of evidence demonstrating a particular perception by the relevant public (§ 73).

04/05/2022, T-237/21, [FIS \(fig.\) / Ifis et al.](#), EU:T:2022:267, § 73

##### No LOC – Signs consisting of stylized single letters

In case of very short elements, consisting of single letters, it is more likely that the relevant public will perceive graphic and stylistic differences (§ 36). If a specific single letter has no particular meaning no concept can be associated with that letter (§ 49). A finding that amounts to recognizing a likelihood of confusion between two signs, one consisting primarily of a highly stylized, single capital letter and the other consisting of the same capital letter but written with very different stylization and combined with other word elements, would de facto amount to granting a monopoly over one capital letter of the alphabet for a specific range of goods (§ 68).



09/11/2022, T-610/21, [K K WATER \(fig.\) / K \(fig.\)](#), EU:T:2022:700

##### LOC – Short signs – Instinctive dissection of signs into recognisable elements

Although the capital letters 'P' and 'L' are less easily recognisable in the earlier mark than in the mark applied for, the vast majority of the relevant public will recognise them as such (§ 87). Even if the relevant public normally perceives a mark as a whole and does not engage in an analysis of its various details, the fact remains that, when perceiving the marks at issue, the relevant public will instinctively break the marks down into elements which it recognises (§ 88).

As regards the earlier mark, it is unlikely that the letters ‘p’ and ‘l’ will be pronounced twice. In the perception of the relevant public, the earlier mark is a combination of the capital letters ‘P’ and ‘L’. The relevant public will therefore focus on those letters depicted the right way round, in the direction of reading, which it can read normally. It will not, on the other hand, pronounce the letters depicted the other way round, which it will perceive as being solely a mirror effect (§ 100).

 [14/12/2022, T-530/21, PL \(fig.\) / PL \(fig\) et al., EU:T:2022:818](#)

### **Dissimilarity of the signs – Reversed letters**

The fact that the signs consist of the same letters or that they are words each of which constitutes the other when reversed, is not decisive in either the visual or the aural comparison (§ 41, 51).

[26/04/2023, T-153/22, XTG \(fig.\) / Gtx, EU:T:2023:217](#)

See also, [26/04/2023, T-154/22, Xtq / Gtx, EU:T:2023:218](#), § 41, 49

### **Abbreviations – Market practice in the motor vehicle sector**

In the motor vehicle sector, marks consisting of abbreviations or acronyms are widespread, with the result that the relevant public is generally used to paying particular attention to the differences between such abbreviations or acronyms (§ 72).

[26/04/2023, T-153/22, XTG \(fig.\) / Gtx, EU:T:2023:217](#)

See also, [26/04/2023, T-154/22, Xtq / Gtx, EU:T:2023:218](#), § 69

### **No LOC – Impact of non-distinctive elements or a single letter on the global assessment LOC**

The signs at issue have in common the element ‘bank’, which is descriptive of the services at issue and is therefore not distinctive. Therefore, the impact resulting from the presence of the common descriptive element ‘bank’ on the assessment of LOC will be particularly low. Moreover, the only other component common to the signs at issue is linked to the presence of the single letter ‘m’, which will also have little impact on the global assessment of LOC in view of the other elements differentiating the signs at issue (§ 126).



**EMBANK**  
European Merchant Bank

[12/07/2023, T-261/22, EM BANK European Merchant Bank \(fig.\) / Mbank et al., EU:T:2023:396](#)

### **No LOC – Distinctiveness of an element of the sign – Signs comprising a single letter and a distinctive word element with the same initial letter**

Where the sign comprises a single letter as a logo and a distinctive verbal element with the same initial letter, the distinctiveness of that single letter is low, even though that letter may be considered the dominant element of the sign (§ 33-37).

 Pontec da Boga

[06/09/2023, T-107/22, P3 DOMINIO DE TARES \(fig.\) / 1 Ponte da Boga \(fig.\), EU:T:2023:494](#)

### **Sign consisting of a single element – Impossibility of identifying dominant or distinctive elements**

It is common ground that if the sign consists of a single element it is not possible to identify a dominant element. The same is true of the distinctive element, which can be ascertained only where the mark is a composite mark (§ 43).

 [Q 25/10/2023, T-458/21, Q \(fig.\) / Q \(fig.\), EU:T:2023:671](#)

### **Signs consisting of a single letter – Low visual similarity**

Although the signs at issue are similar insofar as they consist of a single letter, their graphic stylisation is very different. Since single letters are short elements, the relevant public is more capable of perceiving such differences easily (§ 50). In those circumstances, the degree of visual similarity between the signs at issue must be categorised as low (§ 51).

 [Q 25/10/2023, T-458/21, Q \(fig.\) / Q \(fig.\), EU:T:2023:671](#)

### **Distinctiveness of a single letter**

A sign consisting of a single letter has, in principle, a minimum degree of distinctive character or a weak, or even very weak, distinctive character, where that letter is not stylised or is only slightly stylised or where the other figurative elements of the sign in question are not striking. A sign consisting of a single letter must be stylised or accompanied by other relatively elaborate figurative elements in order for that sign to be recognised as having a normal degree of distinctive character (§ 66-67). An earlier mark represented in a standard font and in red, with the result that it is only very slightly stylised, must be regarded as weak, even though the letter has no meaning with regard to the goods and services covered by that mark (§ 68).

 [Q 25/10/2023, T-458/21, Q \(fig.\) / Q \(fig.\), EU:T:2023:671](#)

### **High visual and phonetic similarity – Abbreviations – Limited impact of the expanded expression**

The signs are visually highly similar due to the coincidences in letters and order of the letters between the groups of capital letters 'CFA' and 'CEFA'. In the contested mark, the acronym will be perceived as the most distinctive element and will be memorised independently. Therefore, the presence of the elements 'Certified European Financial Analyst' in that mark has only a very limited impact on its overall visual impression (§ 39-40).

Phonetically, only the element 'CEFA' in the mark applied for would be pronounced by the relevant public and not the elements 'Certified European Financial Analyst'. For the part of the relevant public that pronounces the element 'CEFA' letter by letter, the degree of phonetic similarity with the earlier mark 'CFA' is high (§ 45-50).

[20/03/2024, T-213/23, CEFA Certified European Financial Analyst / CFA et al., EU:T:2024:189](#)

#### **2.3.5.2 Beginning of the marks**

##### **Trade marks composed of words from two different languages**

In general, the relevant public does not assume that trade marks are composed of words from two different languages (§ 51). The mere fact that one element is placed at the beginning of the mark is not sufficient to confer on it dominant character (§ 57).

[07/03/2019, T-106/18, VERA GREEN / Lavera et al., EU:T:2019:143, § 51, 57](#)

##### **LOC – Different beginnings of the mark – Identical parts lacking meaning**

Although the first component of word marks may be more likely to catch the consumer's attention than the components which follow, that does not apply in all cases (23/10/2015, T-96/14, VIMEO / MEO (fig.) et al., EU:T:2015:799, § 35 and the case-law cited). The additional letters 'A' and 'L' in the first part of the sign applied for ('ALMEA') do not prevent consumers from perceiving the element 'MEA' contained in both the EUTM application and the earlier mark 'MEA' (§ 35).

There are many cases in which the similarity of the signs and the LOC have been confirmed, despite the identical part of the signs lacking meaning and despite the fact that the beginnings of the signs were different (see, for example, 15/06/2011, T-229/10, Syteco, EU:T:2011:273, which compared the signs 'SYTECO' and 'TECO'; 22/05/2012, T-546/10, Milram, EU:T:2012:249, which compared the signs 'MILRAM' and 'RAM'; or 23/10/2015, T-96/14, VIMEO / MEO (fig.) et al., EU:T:2015:799, § 68, which compared the signs 'VIMEO' and 'MEO') (§ 47).



09/12/2020, T-190/20, [ALMEA \(fig.\) / MEA](#), EU:T:2020:597, § 35, 47

### **Importance of the beginning of marks – Short marks**

In principle, even in the case of short marks, the consumer normally attaches more importance to the first part of words (§ 53).

[13/07/2022, T-176/21, Ccty / CCVI BEARING INDUSTRIES \(fig.\) et al., EU:T:2022:449](#)

### **Different beginnings of the mark – Low visual similarity – Low phonetic similarity**

In so far as the signs at issue share eight letters in the same order, it cannot be held that they are different. There is a degree of visual similarity, which, however, is low and not lower than average as found by the contested decision (§ 62). Regarding the phonetic comparison, the presence of the element 'sanrio' only in the mark applied for and the relatively different pronunciation of the elements 'caractère' and 'characters' mean that there is only a low (and not average) degree of phonetic similarity (§ 69).

[21/12/2022, T-43/22, Sanrio characters / Caractère, EU:T:2022:844](#)

### **No LOC – Distinctive and dominant elements – Common prefix not dominant**

The fact that an element is at the beginning of a mark cannot, even if that element is more likely than the elements which follow it to attract the relevant public's attention, result in that term dominating the overall impression conveyed to that public by a trade mark by virtue of that fact alone (§ 38).

[15/03/2023, T-174/22, Breztrev / Brezilizer et al., EU:T:2023:134](#)

[15/03/2023, T-175/22, Breztri / Breezhaler et al., EU:T:2023:135](#)

### **LOC – Different beginnings of the signs – Ends of the signs not systematically disregarded in the alcoholic beverage sector**

The consideration that the consumer normally attaches more importance to the initial part of a trade mark cannot apply in all cases and call into question the principle that the examination of the similarity of trade marks must be based on the overall impression produced by them. There is no reason to believe that average consumers, who are reasonably well informed, observant and circumspect, will systematically disregard the second part of the verbal element of a trade mark to the extent that they only remember the first part. This is particularly true in the alcoholic beverages sector, where consumers are accustomed to goods frequently being designated by marks comprising several verbal elements (§ 56, 57).

[07/06/2023, T-33/22, Porto insígnia / Insignia et al., EU:T:2023:316](#)

### **LOC – Different beginnings of the signs – Weak differentiating element**

Where the beginning of the sign is a weakly distinctive verbal element, the rule that consumers generally pay greater attention to the beginning of the sign than to the end does not necessarily apply (§ 49-51).

[08/11/2023, T-41/23, POLLEN + GRACE \(fig.\) / Grace \(fig.\) et al., EU:T:2023:705](#)

### **LOC – Average visual similarity – Different endings of the marks**

There is no rationale for the relevant public to focus more on the different final two letters of each of the marks at issue rather than on the first five identical letters. 'SALVAJE' and 'SALVANA' are, moreover, meaningless and will not be broken down by the relevant public (§ 99).

[24/01/2024, T-55/23, SALVAJE \(fig.\) / SALVANA, EU:T:2024:30](#)

#### **2.3.5.3 Impact of a verbal element**

##### **Signs composed of both verbal and figurative elements**

Where signs are composed of both verbal and figurative elements, the verbal element of the sign, in principle, has a greater impact on the consumer than the figurative element (§ 65).



[20/06/2019, T-390/18, WKU WORLD KICKBOXING AND KARATE UNION \(fig.\) / WKA et al., EU:T:2019:439, § 65](#)

##### **No LOC – No likelihood of association**

There is no LOC, considering the low visual and aural similarities between the signs (§ 109, 112) for goods directed at a different public, namely the general public with an average level of attention in relation to the contested goods, on the one hand, and the professional public with a high level of attention in relation to the earlier goods, on the other (§ 114).

The likelihood of association may be invoked only if two conditions are cumulatively satisfied. Firstly, the proprietor of a series of earlier registrations must furnish proof of use of all the marks belonging to the series or, at the very least, of a number of marks capable of constituting a 'series'. For there to be a likelihood of the public being mistaken as to whether the trade mark applied for belongs to the series, the earlier marks forming part of that series must necessarily be present in the market (§ 125).



[Harley Benton 28/04/2021, T-284/20, Harley Benton \(fig.\)-HB et al, EU:T:2021:218, § 109, 112, 114, 125](#)

##### **Distinctive figurative element in a complex mark**

The principle that in complex marks, verbal elements are usually more distinctive than figurative elements because the consumer will more readily refer to the goods by citing the name of the mark than by describing the figurative element, cannot be applied automatically, without taking into account the specific inherent characteristics of the verbal and figurative elements constituting a mark (§ 88-89).

A figurative element which, although abstract, has a specific and original arrangement as a result of its stylised and unusual representation is not merely decorative, but is capable of being

remembered by the public and can be just as distinctive as the verbal element in the mark (§ 90-93).



[07/06/2023, T-47/22, THE PLANET \(fig.\) / PLANETE+ \(fig.\),](#)

[EU:T:2023:311](#)

#### 2.3.5.4 Other

##### Mark must be compared as applied for

The marks must be compared in their forms as applied for and registered, regardless of any possible rotation in their use on the market (§ 24-30, 32, 53).



[21/04/2021, T-44/20, DEVICE OF TWO INTERLOCKING ELEMENTS \(fig.\) / DEVICE OF TWO BOLD BLACK CIRCLES OVERLAPPING \(fig.\), EU:T:2021:207, § 24-30, 32, 53](#)

##### Reputation is not a factor to be considered when assessing the similarity of the signs

Although the differences in the font and characters of the word elements of the signs in comparison as well as their configuration and positioning contribute to their visual differentiation, this is not sufficient to find the signs dissimilar, in particular if the earlier mark is reproduced, almost identically at the initial part of the mark applied for (§ 44).

As to the argument that the relevant public will recognise the visual differences between the signs at issue on account of the reputation of the earlier mark it must be recalled that the existence of such a reputation does not allow conclusions to be drawn concerning the similarity of the signs (§ 45).

The figurative element of the sign will not confer a meaning on a term which does not have a meaning for the relevant public (§ 63).



[29/06/2022, T-357/21, PLUMAflex by Roal \(fig.\) / PUMA \(fig.\) et al.,](#)

[EU:T:2022:405](#)

##### LOC – Contested mark entirely included in the earlier mark

The fact that the sole verbal element of the contested mark is entirely included in the earlier mark is, in principle, liable to create both a strong visual and phonetic similarity between the marks at issue (§ 33).

[06/06/2023, T-433/22, STORK / GOLDEN STORK et al., EU:T:2023:341](#)

##### Low similarity of the signs – Double letters – Unusual use in part of the EU

The use of a double letter 'a' is rather unusual in part of the EU, whereas it will clearly be perceived as being different from a single letter 'a' by the speakers of a language in which such a double vowel is known (§ 54).

[13/09/2023, T-473/22, LAAVA \(fig.\) / Lav \(fig.\) et al., EU:T:2023:543](#)

##### Similarity of the signs – 'Below average' synonym for low degree

When the BoA categorised the degree of visual similarity between the signs at issue as, 'at most, below average' and the degree of phonetic and conceptual similarity between them as 'below average', it must be held that it was referring to the fact that there was, between those signs, a degree of similarity which must be categorised as low (§ 33).

[11/10/2023, T-415/22, GRILLOUMI / HALLOUMI et al., EU:T:2023:615](#)

### **Comparison of signs – Irrelevance of the description**

The description of the sign provides information regarding the perception of the sign by the EUTM applicant but does not in any way provide information regarding its perception by the relevant public. Therefore, it is not relevant for the comparison of the signs (§ 33).

[08/11/2023, T-41/23, POLLEN + GRACE \(fig.\) / Grace \(fig.\) et al., EU:T:2023:705](#)

### **LOC – Irrelevance of actual use of the mark for the comparison of the signs**

The signs must be compared in the form in which they are protected, that is, as they were registered or as they appear in the application for registration. The actual or possible use of the registered marks in another form is irrelevant when comparing signs (§ 43).



[29/11/2023, T-12/23, DEVICE OF LIGHTNING \(fig.\) / DEVICE OF LIGHTNING \(fig.\) et al., EU:T:2023:768](#)

### **No LOC – Perception of the signs – No dissection**

Since English-speaking consumers are accustomed to seeing words beginning with the letters 'we', there is no reason why these consumers should divide the sign 'wetoper' into two parts, 'we' and 'toper', merely because the first two letters of that sign coincide with the English personal pronoun 'we' (§ 36).

[07/02/2024, T-630/22, wetoper / TOPPER et al., EU:T:2024:67](#)

### **No LOC – Inversion of word elements – Low visual similarity – High phonetic similarity**

Merely inverting the word elements in the compared marks that are recognisable to the relevant public, does not allow the conclusion that there is no visual similarity between these marks. Nevertheless, this inversion contributes to the visual differences between the conflicting signs (§ 56-57).

Even if the constituent word elements are pronounced in reverse order in the two opposing signs, it should be noted that the signs consist of the same syllables, have the same number of syllables and have the same phonetic length. The fact that the syllables are pronounced in reverse order cannot prevent the signs from being similar overall (§ 65). The reversal of the components of the compared signs does not change the message conveyed. It is very likely that the imperfect phonetic impression retained by the consumer will remind him of the combination of two words in relation to these signs, without any particular significance being attached to their order (§ 66).



PARIS BAR

[13/03/2024, T-117/23, BAR PARIS \(fig.\) / PARIS BAR \(fig.\), EU:T:2024:163](#)

## 2.4 DISTINCTIVENESS OF THE EARLIER MARK

### 2.4.1 Inherent distinctiveness

#### 2.4.1.1 General principles and average distinctiveness of the earlier mark

##### **Assessment of the similarity of the signs – No consideration of marketing circumstances – No consideration of the reputation or enhanced distinctiveness of the earlier mark**

Although the marketing circumstances are a relevant factor in the application of Article 8(1)(b) EUTMR, they are to be considered at the stage of the global assessment of the likelihood of confusion (LOC) and not at the stage of the assessment of the similarity of the signs. This assessment, which is only one of the stages in examination of the LOC, involves comparing the signs to determine whether they are visually, phonetically and conceptually similar. Although this comparison must be based on the overall impression made by the signs on the relevant public, account must nevertheless be taken of the intrinsic qualities of the signs (04/03/2020, C-328/18 P, BLACK LABEL BY EQUIVALENZA (fig.) / LABELL (fig.) et al., EU:C:2020:156, § 71-72 and the case-law cited) (§ 58).

The reputation of an earlier mark or its particular distinctive character must be taken into consideration for the purposes of assessing the LOC, and not for the purposes of assessing the similarity of the marks, which is an assessment made prior to that of the LOC (11/12/2014, T-480/12, MASTER, EU:T:2014:1062, § 54 and the case-law cited) (§ 59).

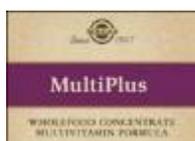
The BoA's analysis is not vitiated by an error of law because it compared the signs on the basis of the perception of the 'uneducated' consumer with regard to the earlier EU figurative mark and did not take into account the applicant's use of its mark (§ 60).

01/09/2021, T-463/20, [Gt racing / GT \(fig.\) et al.](#), EU:T:2021:530, § 58-60

##### **Principle of coexistence of EU trade marks and national trade marks – Certain degree of distinctiveness of earlier national marks**

A national mark on which an opposition is based is to be recognised as having a certain degree of distinctiveness (§ 40), referring to 24/05/2012, C-196/11 P, F1-Live, EU:C:2012:314, although this does not give rise to an unconditional right to oppose the registration of every later trade mark in which the term constituting the national mark appears (§ 40), referring to 13/05/2015, T-102/14, TPG POST / DP et al., EU:T:2015:279.

It follows that an element (in the EUTM applied for) that is identical to an earlier mark, which has been registered in a Member State, cannot be considered devoid of distinctive character when it is included in a later composite EUTM (§ 43, 45). Such a finding would be incompatible with the coexistence of EU trade marks and national trade marks (§ 43-44). Consequently, such an element (of the EUTM applied for) is to be accorded at least a very low degree of distinctiveness (§ 46).



07/05/2019, T-152/18 and T-155/18, [SOLGAR Since 1947 MultiPlus WHOLEFOOD CONCENTRATE MULTIVITAMIN FORMULA \(fig.\) / MULTIPLUS](#), EU:T:2019:294, § 43-44, 46

##### **Certain degree of distinctiveness of earlier national marks**

In order to avoid infringing Article 8(1)(b) CTMR [now Article 8(1)(b) EUTMR], it is necessary to acknowledge a certain degree of distinctiveness of a national mark relied on in support of an opposition to the registration of a trade mark (24/05/2012, C-196/11 P, F1-Live, EU:C:2012:314, § 47) (§ 139-142).



13/06/2019, T-398/18, [DERMAEPIL SUGAR EPIL SYSTEM \(fig.\) / dermépil Perron Rigot \(fig.\)](#), EU:T:2019:415, § 139-142

### Certain degree of distinctiveness of earlier national marks

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



10/09/2019, T-744/18, [Silueta en forma de elipse discontinua \(fig.\) / Silueta en forma de elipse \(fig.\)](#), EU:T:2019:568, § 53, 65-66

### Laudatory connotation and distinctiveness

The laudatory nature of a mark is capable of weakening its distinctive character. However that does not mean that the mark would thereby be entirely devoid of distinctive character (§ 57-58).

14/05/2019, T-12/18, [Triumph / TRIUMPH](#), EU:T:2019:328, § 57-58

### Average intrinsic distinctive character of the earlier mark

The Spanish general public, when faced with the word 'prima', certainly sees the word in its regular meaning of 'female cousin' or 'bonus payment', and does not regard that word as an adjective having a simple laudatory connotation. Since the earlier mark has no meaning as regards the goods, the inherent distinctive character of that mark is average (§ 84-86).

There is a LOC considering that the marks are visually similar to an average degree and phonetically similar to a higher-than-average degree, and that the level of attention of the relevant general public in Spain is average at most, as well as that the intrinsic distinctive character of the earlier mark is average for the similar and identical goods (§ 25, 34, 51, 60-62, 107).



28/04/2021, T-584/17 RENV, [PRIMART Marek Łukasiewicz \(fig.\) / PRIMA](#), EU:T:2021:231, § 25, 34, 51, 60-62, 84-86, 107

### Average intrinsic distinctive character of the earlier mark

The verbal elements 'polo club', the meaning of which will be understood by the relevant Spanish-speaking public as referring to a club dedicated to playing polo, have an average distinctive character in respect of the goods at issue in Classes 18 and 25. Although some of these goods may be used to play polo, they are not specially designed for playing that sport (§ 37).



[08/06/2022, T-355/21, Polo Club Düsseldorf Est. 1976 / POLO CLUB \(fig.\), EU:T:2022:348](#)

### **Distinctive character – Commonly used words**

The fact that a sign is composed of words in common use does not automatically lead to the conclusion that the mark in question has a weak distinctive character (§ 122).



[01/09/2021, T-23/20, the DoubleF \(fig.\) / The double, EU:T:2021:523, § 122](#)

### **Distinctive character of an earlier collective mark – Criteria for assessment**

Distinctiveness of an earlier EU collective mark cannot be assessed in a specific way on the ground that it is a collective mark (§ 67).



[20/01/2021, T-328/17 RENV, BBQLOUMI \(fig.\) / HALLOUMI et al., EU:T:2021:16, § 67](#)

### **Distinctive character of an earlier collective mark – Criteria for assessment**

When the earlier mark is a collective mark, the LOC must be understood as the risk that the public might believe that the goods or services covered by the earlier mark and those covered by the contested sign all originate from members of the association that is the proprietor of the earlier trade mark, or from undertakings economically linked to those members or to that association (§ 64).

In the event of an opposition by the proprietor of a collective mark, the essential function of that mark must be taken into account to understand what LOC means (§ 65). However, the case-law establishing the criteria for assessing a LOC is applicable to cases concerning an earlier collective mark. None of the characteristics of this type of mark justifies a derogation from those assessment criteria (§ 65-66).

Having regard, in particular, to Article 66(2) EUTMR, which is not an exception to the requirement of distinctiveness (§ 73), the distinctiveness of the earlier mark must not be assessed differently if it is an EU collective mark (§ 71). Therefore, in the absence of any contrary provision, Article 7(1)(b) EUTMR and Article 7(3) EUTMR apply to EU collective marks that must, intrinsically or through use, be distinctive (§ 72).

It is an incorrect premise to consider that, when the earlier mark is weak, the existence of a LOC must be ruled out as soon as it is established that the similarity of the marks does not allow a LOC to be established. To determine the existence of a LOC, bearing in mind the criterion of interdependence established in case-law, it is necessary to examine whether the low degree of similarity of the marks is offset by the higher degree of similarity, or even identity, of the goods they cover them (§ 85-86).



05/03/2020, C-766/18 P, [BBQLOUMI \(fig.\) / HALLOUMI.](#), EU:C:2020:170, § 64-66, 72, 85-86

### **Distinctive character of the earlier mark – Lack of meaning – Average distinctiveness only**

The applicant does not claim a high degree of distinctiveness on account of the increased use or reputation of the earlier mark but relies solely on the lack of meaning of the word 'laino' in the context of the goods at issue. However, such a circumstance is not such as to confer on the earlier mark a high degree of intrinsic distinctiveness capable of granting it extensive protection (§ 61).

[09/11/2022, T-779/21, by L.e.n.o. beauty \(fig.\) / Laino et al., EU:T:2022:693](#)

### **Distinctive character of an earlier trade mark – Single letter**

Where a sign consists of a highly stylised single letter or is accompanied by other relatively elaborate figurative elements, that sign may be recognised as having a normal degree of distinctive character. In particular if it lacks meaning in relation to the goods concerned (§ 55, 57).



[09/11/2022, T-610/21, K K WATER \(fig.\) / K \(fig.\), EU:T:2022:700](#)

### **Distinctive character of the earlier marks**

The absence of any conceptual link between the mark and the goods or services covered by that mark does not automatically confer a high degree of inherent distinctiveness on the mark capable of providing broader protection (§ 58).



[09/11/2022, T-596/21, Figurative mark / Wolf Jardin \(fig.\) et al., EU:T:2022:697](#)

### **Assessment of distinctive character of the earlier mark – Evidence**

Evidence which consists of specialised scientific documents which do not target end consumers is not sufficient to establish the distinctive character of the earlier mark (§ 41, 42).

[30/11/2022, T-678/21, Vsl3total / Vsl#3, EU:T:2022:738](#)

### **Average distinctive character of the earlier mark despite a non-distinctive element**

The prefix 'bio' in the earlier mark has little or no distinctive character. By contrast, the suffix 'plak' has a normal distinctive character. Accordingly, the inherent distinctive character of the earlier mark must be regarded as average (§ 90, 91).

[03/05/2023, T-459/22, BIOLARK \(fig.\) / Bioplak, EU:T:2023:237](#)

### **Distinctive character of the earlier mark – Burden of proof**

In the case of an earlier EU collective mark that is weak per se on account of the descriptiveness of its only element, any distinctiveness beyond the minimum level of distinctiveness must be proven by the EUTM's proprietor (§ 48).

[03/05/2023, T-106/22, Bbqloumi / Halloumi, EU:T:2023:230](#)

#### **LOC – Distinctive character of the earlier mark – Name of a colour**

The earlier mark 'BLUE' has a normal degree of distinctiveness. 'Blue' has no direct meaning in the context of the goods and services in Classes 9, 35, 38 and 42, such as data carriers and telecommunication services (§ 33). Although the goods at issue may be available in that colour, just as they may be available in other colours, this is irrelevant, since it is not reasonable to believe that, for that reason alone, that colour will immediately and directly be recognised by the relevant public as descriptive of an intrinsic characteristic that is inherent to the nature of those goods (§ 34).

[11/10/2023, T-516/22, brightblue \(fig.\) / BLUE et al, EU:T:2023:619](#)

#### **Certain degree of distinctiveness of earlier EUTM**

The argument that the earlier signs are non-distinctive and should therefore not have been registered by the EUIPO cannot be raised in the context of an opposition. The validity of a registered EUTM can only be called into question by filing an application for a declaration of invalidity (§ 51).

[07/02/2024, T-318/23, J&B BRO \(fig.\) / 4BRO \(fig.\) et al., EU:T:2024:70](#)

#### **LOC – Normal distinctive character of the earlier mark – 'life' for video games**

It is not established that the average Spanish-speaking consumer who occasionally buys video games would be able to understand the particular meaning of the word 'life' in the context of video games. The fact that the word 'life' is used to refer to a player's 'life' in the context of the use of certain video games does not establish that it would be used to designate the goods and services at issue or one of their characteristics. Even if the relevant public as a whole was able to establish a connection between the word 'life' and video games, that connection must be considered to be non-descriptive insofar as it does not describe a type of game or one of its characteristics (§ 67-68).

[21/02/2024, T-175/23, LifeAfter / life et al., EU:T:2024:109](#)

#### **2.4.1.2 Weak earlier mark**

##### **No LOC – Low inherent distinctiveness of the earlier mark**

The earlier mark consists exclusively of a word sign, which itself consists of only two components. Although the first word component, 'natura', accounts for 60 % of the length of the sign and appears at the beginning, it is nonetheless weakly distinctive. As for the second word component, the ending 'lium', although it has a significant distinctive role in relation to the word component 'natura', neither its length, which is shorter than that of the first component, nor its visual, phonetic and conceptual characteristics are capable of strengthening the distinctiveness of the earlier mark, taken as a whole, beyond the minimum level which it necessarily has by virtue of its registration (§ 68). Therefore, taken as a whole, the inherent distinctiveness of the earlier mark is low (§ 69).

[05/10/2020, T-602/19, \*Naturanove-Naturalium\*, EU:T:2020:463, § 68-69](#)

##### **No LOC – Weak inherent distinctiveness of the earlier mark**

The expression 'museum of illusions' is descriptive for the relevant Greek public, because it refers directly to the museum services and the figurative elements of the earlier mark only highlight the descriptive concept conveyed by that expression. The earlier mark has a low degree of inherent distinctiveness (and not an inherently normal degree of distinctive character as the BoA concluded based on its incorrect premise that the word 'illusion' has no meaning with regard to museum services for the relevant Greek public) (§ 75, 77, 80-81).



12/05/2021, T-70/20, [MUSEUM OF ILLUSIONS \(fig.\) / MUSEUM OF ILLUSIONS \(fig.\)](#), EU:T:2021:253, § 75, 77, 80-81

### **No LOC – Earlier collective mark – Assessment of distinctiveness – Reliance on earlier case-law concerning individual or certification marks – Weak earlier mark**

It is for the proprietor of an earlier collective mark to show what level of distinctiveness it has beyond the minimum level, since he intends to rely on it in support of opposition proceedings or even cancellation proceedings (§ 50).

The finding of a weak degree of distinctiveness of the earlier mark does not amount to denying the very existence of the distinctive character of a validly registered trade mark, or to depriving that mark of the rights which it confers on its proprietor, but simply to finding that it cannot confer more rights than those it draws objectively from its distinctive character (§ 54). Even supposing that the EU collective mark 'HALLOUMI' implicitly refers to the Cypriot geographical origin of the goods covered, that mark must still fulfil its essential distinctive function. The generic nature of the word 'halloumi', since that word alone constitutes the earlier mark, necessarily limits the effects of that mark in light of that function (§ 57). The need for more extensive protection on the basis of EU trade mark law does not exist in the present case, since the rules governing protected designations of origin and protected geographical indications, as laid down in Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs (OJ 2012 L 343, p. 1), could provide sufficient protection outside the scope of trade mark law (§ 58).

The BoA cannot be criticised, when assessing the inherent distinctiveness of the earlier mark, for having referred to decisions of the Court which concerned earlier rights also composed of the single word 'halloumi', as individual marks or certification, in proceedings relating to applications for registration or oppositions, since the assessment of the distinctiveness of the rights in question met criteria which could be perfectly transposed to the present case (§ 53).

Where the elements of similarity between two signs arise from the fact that, as in the present case, they share a component that has a weak inherent distinctive character, the impact of such elements of similarity on the global assessment of the LOC is itself low (§ 87). The rights which the applicant derives from the registration of the earlier mark cannot, in all circumstances, confer on it an exclusive right to use the word 'halloumi', when, moreover, the extent of its rights under that mark is determined by the distinctiveness of that mark, whether inherent or acquired through use, which is weak (§ 115).



24/03/2021, T-282/19, [Halloumi χαλλούμι Vermion grill cheese/grill est/grill kase m BELAS PREMIUM GREEK DAIRY SINCE 1927 \(fig.\) / HALLOUMI](#), EU:T:2021:154, § 50, 53-54, 57-58, 115

### **Earlier certification mark – Assessment of the likelihood of confusion**

Where the earlier marks relied on in the opposition are national certification marks, the LOC must be understood, in accordance with the rules governing collective marks, as the risk that the public might believe that the goods or services covered by the earlier trade marks and those for which protection is sought originate from persons authorised to use the earlier marks by the proprietor, or from undertakings economically linked to those persons or that proprietor (§ 29).

However, in the event of opposition by the proprietor of a certification mark, the essential function of that type of mark must be taken into account to understand what is meant by LOC within the meaning of Article 8(1)(b) Article 8(1)(b) CTMR [now EUTMR]. The fact remains that the case-law establishing the criteria for assessing the existence of such a LOC is applicable to cases concerning an earlier certification mark (§ 30).

08/12/2021, T-556/19, [GRILLOUMI BURGER / HALLOUMI et al](#), EU:T:2021:864, § 29-30  
8/12/2021, T-593/19, [GRILLOUMI BURGER / HALLOUMI et al.](#), EU:T:2021:865, § 29-30

### **Earlier EU collective mark – Assessment of the likelihood of confusion**

Where the earlier mark is an EU collective mark, the LOC must be understood, as being the risk that the public might believe that the goods or services covered by that mark and those covered by the trade mark applied for all originate from members of the association which is the proprietor of the earlier trade mark or, as the case may be, from undertakings economically linked to those members or to that association (§ 30).

Where the proprietor of a collective mark brings opposition proceedings, although account must be taken of the essential function of that type of marks, as set out in Article 66(1) CTMR [now Article 74(1) EUTMR], in order to understand what is meant by LOC, within the meaning of Article 8(1)(b) CTMR [now EUTMR], the fact remains that the case-law establishing the criteria with regard to which the existence of such a LOC must be assessed in practice is applicable to cases concerning an earlier collective mark (§ 31).

08/12/2021, T-595/19, [GRILLOUMI BURGER / HALLOUMI et al.](#), EU:T:2021:866, § 30-31

### **Weak distinctive character of the earlier mark**

The human figures constitute the dominant element of each of the marks (not disputed). These figures are likely to represent strong or healthy people. Since the goods in question are foodstuffs, these figures are likely to indicate that those goods contribute to making people who consume them strong or healthy. To the extent that many foodstuffs may be regarded as having such attributes, these figures are not necessarily perceived as indicating the commercial origin of those goods. Consequently, the distinctive character of these figures and the distinctive character of the earlier mark as a whole is weak, taking into consideration that the rest of the figurative elements of the earlier mark also have weak distinctive character (while the BoA found it to be average) (§ 29-30, 41).

In view of the weak distinctive character of the earlier mark and the lack of visual similarity, a LOC would not be established even if the goods were identical (§ 47).



14/11/2019, T-149/19, [DEVICE OF A HUMAN FIGURE CENTERED OVER A BLUE ESCUTCHEON \(fig.\) / DEVICE OF A HUMAN FIGURE WITH A SEMICIRCLE \(fig.\)](#), EU:T:2019:789, § 29-30, 41, 47

### **Proof of the weak distinctive character of the earlier mark**

A list of registered marks which contain the element 'scor' is insufficient to show that the element is not distinctive or has only a weak distinctive character. The mere presence of marks containing

a certain term in the Register of EU trade marks without any reference to their use on the market or to any challenge to those marks on account of the existence of a LOC, cannot prove that the distinctive character of that term has been reduced (06/07/2016, T-97/15, Alfredo alla Scrofa, EU:T:2016:393, § 39 and case-law cited) (§ 84).

 08/07/2020, T-328/19, [SCORIFY \(fig.\) / Scor et al.](#), EU:T:2020:311, § 84

### **No LOC – Weak distinctive character of the earlier mark – Shape marks – Application of 12/01/2006, C-173/04 P, Standbeutel, EU:C:2006:20, § 34 to relative grounds**

The BoA was right in taking into account a sector wider than that of mineral water. The earlier mark represents a transparent bottle of a common shape in the wide sector of beverage packaging and does not have any particular appearance that differentiates it from the conventional presentation of bottles on the market. Therefore, such a shape does not constitute an indication of origin, as it is not capable of individualising the relevant goods and services and distinguishing them from those having another commercial origin. It has, at most, a weak inherent distinctive character (§ 66-67).



12/05/2021, T-637/19, [Aqua Carpatica \(3D\) / VODAVODA \(3D\)](#), EU:T:2021:222, § 66-67



12/05/2021, T-638/19, [AC Aqua AC \(3D\) / VODAVODA \(3D\)](#), EU:T:2021:256, § 66-67

### **Earlier mark considered descriptive – Inacceptable challenge of the validity of the earlier mark**

The characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character. Where the term that constitutes the earlier word mark is characterised as descriptive, this amounts to denying the earlier mark's distinctive character and constitutes an infringement of Article 8(1)(b) EUTMR, even if it is explicitly stated that the validity of a mark is not being called into question (§ 25-28).

[01/03/2023, T-102/22, Gourmet \(fig.\) / Gourmet, EU:T:2023:100](#)

### **No LOC – Weak distinctive character of the earlier collective mark**

EU collective marks falling under Article 74(2) EUTMR must nevertheless fulfil their essential function, namely, to distinguish the goods or services of the members of the association that owns it from those of other undertakings. Where the only element of the mark has a generic nature, this necessarily limits the effects of such marks as regards that function (§ 46).

[03/05/2023, T-168/22, Grilloumi / Halloumi, EU:T:2023:231](#)

## **2.4.2 Enhanced distinctiveness through use**

### **Low evidential value for enhanced distinctiveness through use – Statements of distributors – Screenshots published on Facebook or Instagram**

The evidential value of the statements provided by distributors contractually tied to the applicant is lower than that of declarations provided by third parties. Where distributors are tied to the applicant as clients and performed tasks, including the marketing and promotion of the earlier mark, they cannot be regarded as independent sources (§ 31).

Screenshots published as newsletters on Facebook or Instagram do not constitute conclusive evidence that the earlier mark has acquired enhanced distinctiveness through use. What matters in this regard is the effect of such activities on the recognition of the mark by the public, which is not quantifiable in the absence of data on the degree of exposure of the public to the advertising (§ 37).

*19/09/2019, T-378/18, [CRUZADE / SANTA CRUZ et al.](#), EU:T:2019:620, § 31, 37*

### **No enhanced distinctiveness of the earlier mark**

In order to demonstrate the strong distinctive character of the earlier mark by virtue of the relevant public's knowledge of it, the proprietor of the earlier mark should have shown that a large number of consumers have been exposed to that mark. In the absence of data demonstrating the extent of the dissemination of the magazine bearing its trade mark, including market shares, number of its readers or the media impact of the events referred to in the evidence submitted, the claim of enhanced distinctive character is rejected (§ 59).

The fact that the earlier trade mark is disclosed electronically or through well-known events did not prevent its proprietor from providing evidence, such as opinion polls, the number of subscribers, the percentage of readers or visitors to the information portals, the advertisement expenditure, the ranking of digital magazines and the number of advertisements for the event or portals on which it was promoted (§ 61).

*[16/11/2022, T-796/21, FORO16 \(fig.\) / Cambio 16 \(fig.\) et al.](#), EU:T:2022:711*

### **Enhanced distinctiveness of the earlier mark – Market surveys – Joint use with other elements**

Surveys conducted 10 years before the filing date of the contested mark may have probative value when combined with more recent surveys, insofar as they established continuous awareness of the earlier mark by the relevant public. A document drawn up some time before or after the relevant date might contain useful information in view of the fact that the reputation of a mark was in general acquired progressively (§ 22).

A trade mark may have enhanced distinctiveness acquired through use even if it was used as part of, or in conjunction with, other signs, without it necessarily having to be used on its own as a standalone trade mark. To the extent that the earlier mark is frequently used in conjunction with other elements, it is that mark which serves as the common element between the marks used, such that the overlap and repetition observed facilitate the recognition of the origin of the goods and services. Moreover, the earlier mark appears to be even more decisive for the purposes of recognising the origin of the goods or services given that the element accompanying it is descriptive (§ 25).



*[29/03/2023, T-344/21, +music \(fig.\) / DEVICE OF A WHITE CROSS WITHIN A BLACK SQUARE \(fig.\) et al.](#), EU:T:2023:166*

### **No enhanced distinctiveness of the earlier mark – Opinion polls – Probative value weakened by lack of spontaneous answers**

The probative value of the opinion survey is weakened by the fact that the interviewees did not answer spontaneously, since the questionnaire used showed them the sign at issue and indicated the goods covered by the earlier mark (§ 77).

[11/10/2023, T-490/22, ayuna LESS IS BEAUTY \(fig.\) / Ajona, EU:T:2023:616](#)

## 2.5 OTHER FACTORS

### 2.5.1 Family of marks

#### Prefix ‘mc’

The prefix ‘mc’ of the opponent’s family of names (such as McDONALD’S) has acquired a high degree of distinctiveness through its use on the fast-food market (§ 71).

[10/10/2019, T-428/18, mc dreams hotels Träumen zum kleinen Preis! \(fig.\) / McDONALD’S et al., EU:T:2019:738, § 71](#)

#### Family of marks – Proof of use on the market

The applicant claiming that the mark applied for is part of a family of marks must provide proof of use on the market of a sufficient number of marks capable of constituting such a family and therefore demonstrating the actual existence of that family (§ 28).

[04/05/2022, T-298/21, Alegria de beronia / Alegro, EU:T:2022:275, § 28](#)

#### Family of marks – Irrelevance for comparison of the signs

The existence of a ‘family’ or a ‘series’ of trade marks is an element which must be taken into account when assessing LOC, but it is irrelevant for the purposes of assessing the existence of a similarity between the marks (§ 18, 43).

[16/11/2022, T-796/21, FORO16 \(fig.\) / Cambio 16 \(fig.\) et al., EU:T:2022:711](#)

#### Family of marks – Marks sharing common characteristics – Proof of use on the market

To rely on the existence of a family of marks, the marks must display common characteristics. The condition of common element cannot be met if the claimed common word element does not share the same sequence of letters or it is situated in different positions in the marks. In order to support the claim that the mark applied for might be perceived as belonging to a family of earlier marks, the person relying on the existence of a family of marks must provide evidence of use of those earlier marks on the market (§ 83-84).

[15/03/2023, T-174/22, Breztrev / Brezilizer et al., EU:T:2023:134](#)

See also, [15/03/2023, T-175/22, Breztri / Breezhaler et al., EU:T:2023:135, § 99, 100](#)

### 2.5.2 Coexistence

#### Coexistence – Proof of peaceful coexistence based on absence of any LOC

The EUTM proprietor is obliged to prove that the peaceful coexistence of the marks was based on the absence of any LOC, at least during the proceedings before the Office concerning relative grounds for refusal (§ 80-81).

The absence of any LOC cannot be inferred from the mere fact that the applicant for a declaration of invalidity did not oppose the registration of the contested national mark or apply for a declaration

that it was invalid at an earlier stage, even where there has been significant use of the marks, 05/07/2016, T-518/13, MACCOFFEE, EU:T:2016:389, § 110 (§ 84).

12/07/2019, T-276/17, [Tropical \(fig.\) / TROPICAL](#), EU:T:2019:525, § 80-81, 84

### **Coexistence – Territorial aspect**

Coexistence must be demonstrated in the territory in which the earlier trade mark is protected. When the earlier mark is a European Union trade mark, coexistence limited to a single Member State is inadequate (§ 59).

03/10/2019, T-533/18, [WANDA FILMS / WANDA et al.](#), EU:T:2019:727, § 59

03/10/2019, T-542/18, [wanda films \(fig.\) / WANDA et al.](#), EU:T:2019:728, § 59

### **Peaceful coexistence – Burden of proof – Extent**

The fact that, in part of the EU (Ireland and the UK), an EU trade mark and a national mark peacefully coexist, does not allow the conclusion that, in another part of the EU, where peaceful coexistence between that EU trade mark and the sign identical to that national mark is absent, there is no LOC between that EU trade mark and that sign (20/07/2017, C-93/16, kerrygold, EU:C:2017:571, § 38) (§ 130, 134).

The burden of proof lies with the party claiming the existence of peaceful coexistence. Moreover, where the opposition to the registration of an EU trade mark is based on an earlier EU trade mark, coexistence must be proved for the entire territory of the EU (10/04/2013, T-505/10, Astaloy, EU:T:2013:160, § 49; 20/07/2017, C-93/16, kerrygold, EU:C:2017:571, § 38) (§ 159-161).



10/03/2021, T-693/19, [KERRYMAID / Kerrygold \(fig.\)](#), EU:T:2021:124, § 130, 134, 159-161

### **Coexistence of marks**

The mere submission of a marketing authorisation from the Spanish Health administration does not on its own prove peaceful coexistence in Spain (§ 117).

02/03/2022, T-149/21, [Vitadha/ Vitanadh et al.](#), EU:T:2022:103, § 117

### **Peaceful coexistence – Burden of proof**

The burden of proof lies with the party claiming the existence of peaceful coexistence and, moreover, where the opposition to the registration of an EUTM is based on an earlier EUTM, coexistence must be proved for the entire territory of the European Union (§ 106).

[13/07/2022, T-251/21, Tigercat / CAT \(fig.\) et al.](#), EU:T:2022:437

### **Coexistence – Burden of proof**

The party invoking a coexistence must demonstrate that that coexistence is based on the absence of LOC on the part of the relevant public (§ 52). Evidence demonstrating that the relevant public recognised each of the trade marks at issue before the time of filing the application for registration of the contested mark is particularly relevant (§ 55).

[13/09/2023, T-549/22, PROLACTAL / Proláctea \(fig.\) et al.](#), EU:T:2023:538

## **No peaceful coexistence**

The EUTM proprietor invoking a peaceful coexistence has to demonstrate that the said coexistence is based on the absence of any LOC on the part of the relevant public; that demonstration may be made by way of a body of evidence. The existence of opposition proceedings between some of its marks and the invalidity applicant's EUTM 'NOMOR' demonstrate the absence of peaceful coexistence (§ 51).

[15/11/2023, T-19/23, NORMOCARE / NOMOR, EU:T:2023:717](#)

## **Necessity to assess the claim of peaceful coexistence**

The peaceful coexistence of two marks on a particular market is a relevant factor for the purposes of the global assessment of LOC. Therefore, the EUTM applicant's arguments relating to the coexistence of the marks and the evidence relied on in support must be examined (§ 72-74).

[20/03/2024, T-213/23, CEFA Certified European Financial Analyst / CFA et al., EU:T:2024:189](#)

## **2.5.3 Other**

### **Irrelevance of bad faith in opposition proceedings**

The question whether the earlier mark was filed in bad faith is irrelevant. Bad faith is a significant factor in the context of an application for a declaration of invalidity under Article 59(1)(b) EUTMR. It is not, however, a factor that must be taken into account in opposition proceedings brought under Article 8 EUTMR (§ 16).

[12/02/2019, T-231/18, Djili \(fig.\) / GILLY, EU:T:2019:82, § 16](#)

### **Earlier certification mark – Criteria for the assessment of LOC – Scope of protection afforded by Article 8(1)(b) EUTMR in case of earlier certification marks**

Where the earlier marks relied on in support of the application for a declaration of invalidity are national certification marks, the LOC within the meaning of Article 8(1)(b) EUTMR must be understood as being the risk that the public might believe that the goods or services covered by the mark applied for and those covered by the earlier marks all originate from persons authorised by the proprietor of those earlier marks to use them in the context of the certification scheme of which they are part or, where appropriate, from undertakings economically linked to those persons or to that proprietor (§ 35).

In the event of an application for a declaration of invalidity by the proprietor of a certification mark, although the essential function of that type of mark must be taken into account in order to understand what is meant by LOC, within the meaning of Article 8(1)(b) EUTMR, the fact remains that the case-law establishing the criteria with regard to which the existence of such a likelihood must be assessed in practice is applicable to cases concerning an earlier certification mark (§ 36).

The question whether the effective compliance by the proprietor of the contested mark with the characteristics guaranteed by the proprietor of the earlier certification marks forms part of the essential function of those marks is outside the scope of the protection afforded by Article 8(1)(b) EUTMR. That question concerns, at most, the use of a mark, insofar as it could harm the essential function of a certification mark and mislead the public regarding the certification of the characteristics of the goods (§ 69).



16/06/2021, T-281/19 and T-351/19, [Halloumi χαλλούμι Vermion grill cheese/grill est/grill kase m BELAS PREMIUM GREEK DAIRY SINCE 1927 \(fig.\) / HALLOUMI](#), EU:T:2021:362, § 35-36, 69

### **Dominant element – Distinctive element – Secondary role in the overall impression**

If a trade mark has multiple dominant elements, some of which are distinctive and others of which are weak, the weak ones can be considered secondary in the overall impression of the sign (§ 81).

16/06/2021, T-281/19 and T-351/19, [Halloumi χαλλούμι Vermion grill cheese/grill est/grill kase m BELAS PREMIUM GREEK DAIRY SINCE 1927 \(fig.\) / HALLOUMI](#), EU:T:2021:362, § 81

### **Irrelevance of other marks used by the parties for the assessment of a likelihood of confusion**

The assessment of the likelihood of confusion must be carried out by reference to the intrinsic qualities of the mark applied for and not to circumstances relating to the earlier use of other different marks (§ 23-25).

02/03/2022, T-125/21, [Eurobic / BANCO BiG BANCO DE INVESTIMENTO GLOBAL \(fig.\) et al.](#), EU:T:2022:102, § 23-25

### **Earlier collective mark – Criteria for the assessment of LOC**

When assessing LOC in conflicts based on collective marks, there is no need to add additional criteria to those applicable to individual marks. The CJ has expressly observed, first, that the case-law establishing the criteria with regard to which the existence of such LOC had to be assessed in practice, was applicable to cases concerning an earlier collective mark and, second, that, when assessing the distinctiveness of an EU collective mark, that distinctiveness did not have to be assessed in a particular way on the ground that it was a collective mark (§ 32-37).

01/02/2023, T-565/21, [Papouis Halloumi Papouis Dairies LTD PAP since 1967 \(fig.\) / HALLOUMI](#), EU:T:2023:28

01/02/2023, T-558/21, [fino Cyprus Halloumi Cheese \(fig.\) / HALLOUMIk](#), EU:T:2023:27

### **LOC – No unconditional right to register a name**

Although under Article 4 EUTMR, an EUTM may consist of any signs, in particular words, including personal names, provided, inter alia, that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings, neither the EUTMR nor the case-law provide for any unconditional right to register a surname or first name as an EUTM (§ 66-67).

Article 14 EUTMR is specifically intended to ensure that a trade mark cannot serve as a basis for prohibiting a natural person from using their name. It is clear from the wording of that provision, entitled 'Limitation of the effects of an EU trade mark', that it is intended only to enable, under certain conditions, the use by a third party of their family name, and not the registration of that family name as an EUTM (§ 68-69).

26/07/2023, T-439/22, [RADA PERFUMES \(fig.\) / PRADA \(fig.\) et al.](#), EU:T:2023:441

### **No LOC – Earlier certification mark – Irrelevant factors for the assessment of LOC**

Whether the EUTM applicant's actual compliance with the characteristics guaranteed by the Member State as proprietor of the earlier certification marks forms part of the essential function of those marks is outside the scope of protection afforded by Article 8(1)(b) EUTMR. That question concerns, at most, the use of a mark that could harm the essential function of a certification mark and mislead the public regarding the certification of the characteristics of the goods (§ 49).

[11/10/2023, T-415/22, GRILLOUMI / HALLOUMI et al., EU:T:2023:615](#)

## 2.6 GLOBAL ASSESSMENT

### 2.6.1 Interdependence

#### **LOC – Identical goods – High level of attention of the relevant public – Phonetic identity – Low degree of visual similarity**

As the goods are identical, the phonetic identity and the low degree of visual similarity of the marks serve to establish that there is a LOC, notwithstanding the high level of attention of the relevant public (§ 52-53).

 14/02/2019, T-34/18, [KALON AL CENTRO DELLA FAMIGLIA \(fig.\) / CALOON](#), EU:T:2019:94, § 52-53

#### **No LOC – Identical services – Normal distinctiveness of the earlier mark – Low degree of similarity of the signs – Services directed solely at professionals**

Even if the services were identical, taking into account the normal distinctiveness of the earlier mark and the low degree of similarity between the signs, the BoA should have ruled out any LOC, at least with regard to the services aimed solely at the professional public displaying a high level of attention (§ 65-66). Since the BoA did not exhaustively identify which services were directed solely at professionals, the decision is annulled in its entirety (§ 65-66, 70).



20/09/2019, T-716/18, [Idealogistic Compass Greatest care in getting it there \(fig.\) / iDĒA \(fig.\) et al.](#), EU:T:2019:642, § 70

#### **LOC – Identical goods – Simple reversion of almost identical elements**

When the goods are identical or similar and the signs consist of two almost identical elements, such as 'med' or 'medi' and 'flora' or 'flor', reversing the order of the elements is not sufficient to exclude a LOC (§ 52).



20/11/2019, T-695/18, [fLORAMED \(fig.\) / MEDIFLOR et al.](#), EU:T:2019:794, § 52

#### **LOC – Identical services – Low distinctiveness of the earlier mark**

Having regard to the identity of the services, the signs' above-average degree of visual similarity, their phonetic identity and the distinctive character, albeit low, of the earlier trade mark and the relevant public's average level of attention, there is a LOC (§ 81-82).



07/11/2019, T-568/18, [WE \(fig.\) / WE](#), EU:T:2019:783, § 81-82

### **Collective mark – Interdependence between the similarity of the trade marks and the similarity of the goods or services**

It is an incorrect premise to consider that, when the earlier mark is weak, a LOC must be ruled out as soon as it is established that the similarity of the marks does not allow a LOC to be established. Bearing in mind the criterion of interdependence established in case-law, to determine the existence of a LOC, it is necessary to examine whether the low degree of similarity of the marks is offset by the higher degree of similarity, or even identity, of the goods they cover (§ 85-86).



05/03/2020, C-766/18 P, [BBQLOUMI \(fig.\) / HALLOUMI.](#), EU:C:2020:170, § 85-86

### **LOC – Personal name mark – Wine sector – Relevant public**

The relevant public consists of the general public, which is not necessarily a connoisseur of wines or designations of origin. The existence of compound wine names does not exclude the possibility that the public may refer to them in a simplified form, especially if the name is partly incomprehensible. In that case, the relevant public may remember a simplified version of the name of the wine rather than its full name. Therefore, there is a likelihood of confusion (§ 54-56).



27/04/2022, T-210/21, [LOPEZ DE HARO \(fig.\) / Lopez de Heredia et al.](#), EU:T:2022:244, § 54-56

### **No LOC – Confectionery – Importance of visual similarity**

In view of the nature of the goods at issue ('Confectionery; Candy; Fudge' in Class 30), the visual aspect plays a more important role in the global assessment of the likelihood of confusion. Those goods are everyday consumer goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives the mark which designates them visually (§ 97-101).



KOPOBKA  
KOROUKA

01/06/2022, T-355/20, [Pokój TRADYCJA JAKOŚĆ KRÓWKA SŁODKIE CHWILE Z DZIECIŃSTWA TRADYCYJNA RECEPTURA \(fig.\) / KOPOBKA KOROVKA \(fig.\)](#), EU:T:2022:320

### **LOC – Importance of visual similarity**

In the light of the conditions under which the goods at issue, namely various types of bearings such as ball and roller bearings and bushings in Class 7, are marketed, the visual aspect of the signs in comparison will be of greater importance than the phonetic and conceptual aspects. However, it cannot entirely be ruled out that, owing to the nature of those goods, the phonetic aspect of those signs may, in certain circumstances, be of at least moderate importance for the purposes of identifying the commercial origin of the goods covered. Accordingly, it cannot be held

that the degree of phonetic similarity of the signs in question must be entirely disregarded for the purposes of assessing a likelihood of confusion (§ 66).



[13/07/2022, T-176/21, Ccty / CCVI BEARING INDUSTRIES \(fig.\) et al., EU:T:2022:449](#)

### **LOC – Impact of conceptual similarity**

The high degree of conceptual similarity of the signs outweighs their low degree of visual and phonetic similarity. The signs under comparison must be considered similar overall to an average degree. LOC is established on account of the identity or similarity of the goods and services in question (§ 107-108).



[14/09/2022, T-423/21, MARE GIOIOSO di Sebastiano IMPORT . EXPORT \(fig.\) / GIOIA DI MARE \(fig.\), EU:T:2022:562](#)

### **LOC – Interdependence**

The GC confirms the application of the principles settled in 29/09/1998, C-39/97, Canon, EU:C:1998:442, that is, the interdependence of the factors is to be taken into account (a low degree of similarity of one of the factors can be outweighed by the higher degree of similarity of another factor). The application of these principles according to which the interdependence of factors must be taken into account, does not require the existence of an enhanced distinctiveness of the earlier mark or a high degree of similarity between the signs to find LOC (§ 51).

[12/10/2022, T-460/21, C2 CYPRUS CASINOS \(fig.\) / C8 \(fig.\), EU:T:2022:623](#)

See also, [12/10/2022, T-461/21, C2 \(fig.\) / C8 \(fig.\), EU:T:2022:624, § 50](#)

### **LOC – Importance of visual and phonetical similarity for services in Class 36**

The phonetic similarity is of at least the same importance as the visual similarity when comparing marks which are registered for or seeking protection for services in the financial sector, given that the public will discuss the different service providers before contacting them (§ 84).



[12/10/2022, T-656/21, H/2 capital partners / HCapital \(fig.\) et al., EU:T:2022:625](#)

### **No LOC for goods and services similar to a low degree**

There is LOC only for the goods and services found to be identical or similar, not for those found similar to a low degree (§ 84). Although it does not have a low degree of distinctiveness, the earlier mark does not have a high degree of distinctiveness capable of giving it broader protection that might justify a finding that there is LOC in a configuration marked both by the low degree of similarity between the signs at issue and the goods and services in question (§ 86).

[21/12/2022, T-43/22, Sanrio characters / Caractère, EU:T:2022:844](#)

### **No LOC – Interdependence principle – Conceptual comparison**

Although the BoA relied on the lack of conceptual similarity for the purposes of assessing LOC, whereas it had previously found that a conceptual comparison was not possible, that fact alone is not sufficient to call the assessment of LOC into question (§ 53).

[26/07/2023, T-745/21, Passo lungo / Doppio passo, EU:T:2023:435](#)

### **LOC – Clothing and footwear – Importance of visual similarity – Relevance of phonetic and conceptual similarity**

Although it is true that, with regards to clothing and footwear in Class 25, the visual similarity plays a greater role in the assessment of LOC, the paying of particular attention to the visual perception does not, however, mean that the phonetic and conceptual impression could be overlooked. In the present case, the below-average degree of visual similarity between the signs is offset by the high degree of phonetic and conceptual similarities between them (§ 70-71).



[29/11/2023, T-427/22, Barbarian fashion \(fig.\) / Barbarian et al., EU:T:2023:759](#)

### **No LOC – Interdependence principle – Identical goods**

The principle of interdependence cannot be applied mechanically. Whilst it is true that, by virtue of the principle of interdependence, a lesser degree of similarity between the goods or services covered may be offset by a greater degree of similarity between the marks, conversely there is nothing to prevent a finding that, in view of the circumstances of a particular case, there is no likelihood of confusion, even where identical goods are involved, given the low degree of visual and phonetic similarity between the marks and the average degree of distinctiveness of the earlier mark (§ 111, 113, 117-118).



[06/12/2023, T-627/22, agricolavinica. Le Colline di Ripa \(fig.\) / VENICA, EU:T:2023:782](#)

### **LOC – High degree of phonetic similarity – Identical and highly similar goods – Interdependence and imperfect recollection**

Although the signs at issue are visually and conceptually similar only to a low degree and are even conceptually different for a part of the public, the mark applied for has, for the whole of the relevant public, a high degree of phonetic similarity with one of the earlier marks. Given the identity or the high degree of similarity of the goods, and the average level of attention, their phonetic similarities are sufficient to entail a LOC (§ 103-105).

[24/01/2024, T-636/22, labkable Solutions for cables \(fig.\) / LAPP KABEL STUTTGART \(fig.\) et al., EU:T:2024:24](#)

### **LOC – No mechanical application of the principle of interdependence**

A mechanical application of the principle of interdependence does not ensure a correct global assessment of LOC. However, it cannot be inferred from this, that, in order to exclude LOC in the case of identical cosmetic and hair care goods, the marks must necessarily have a greater similarity than being visually and aurally below-average and conceptually similar to a low degree (§ 65).



[21/02/2024, T-180/23, Bi blue pigment \(fig.\) / Bi.cell \(fig.\), EU:T:2024:103](#)

### **No LOC – Principle of interdependence**

If the goods at issue are identical and the earlier mark has an enhanced distinctive character, the degree of similarities between the signs must be sufficiently low to make it possible to rule out any LOC (§ 24).



[28/02/2024, T-279/23, smål \(fig.\) / SUMOL \(fig.\) et al., EU:T:2024:130](#)

## 2.6.2 Imperfect recollection

### LOC – Low degree of distinctiveness of the earlier mark – Principles of imperfect recollection

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



[10/09/2019, T-744/18, Silueta en forma de elipse discontinua \(fig.\) / Silueta en forma de elipse \(fig.\), EU:T:2019:568, § 67-68](#)

### LOC – Distinctive and dominant elements – Principles of interdependence and imperfect recollection

The verbal element 'OOF' of the mark applied for, which is easily recognisable and identifiable, is the distinctive and, compared with the figurative elements, dominant element. The bar above each letter 'O' and the use of the colours red and white for the letters 'OO' and 'F' are perceived as secondary decorative elements (§ 26).

Given the average degree of visual and phonetic similarity and the similarity of the goods, which is average at the very least, and in light of the principles of interdependence and imperfect recollection, there is a LOC on the part of the relevant public (§ 58).



[10/10/2019, T-453/18, OOF \(fig.\) / OO \(fig.\) et al., EU:T:2019:733, § 26, 58](#)



[10/10/2019, T-454/18, OO \(fig.\) / OO \(fig.\), EU:T:2019:735, § 26, 58](#)

### Public with a high level of attention – Perception of differences between the marks

The fact that the public has a high level of attention does not mean that it will examine the mark before it in the smallest detail or that it will compare it in minute detail to another mark (21/11/2013, T-443/12, ancotel, EU:T:2013:605, § 52-54; 13/03/2018, T-824/16, K (fig.) / K (fig.) et al., EU:T:2018:133, § 72, 73 (§ 59).

[28/05/2020, T-333/19, GN Genetic Nutrition Laboratories \(fig.\) / GNC GENERAL NUTRITION CENTERS et al., EU:T:2020:232, § 59](#)

### LOC – Public with high level of attention – Principle of imperfect recollection – Common descriptive word element – Limited role of the conceptual similarity

In the assessment of the LOC, the role played by conceptual similarity in the comparison of two signs is of lesser importance when that similarity is due to a descriptive element shared by both of the marks (26/11/2015, T-262/14, BIONECS / BIONECT, EU:T:2015:888, § 67 and the case law cited) (§ 92).

Even a public displaying a high level of attention must rely on imperfect recollection of the signs and will not examine the mark before it down to the smallest detail, or compare that mark in minute detail to another mark (16/07/2014, T-324/13, Femivia, EU:T:2014:672, § 48) (§ 99).

15/10/2020, T-49/20, [ROBOX / OROBOX](#), EU:T:2020:492, § 92, 99

### **LOC – Public with high level of attention – Principle of imperfect recollection**

The fact that the relevant public will be more aware of the identity of the producer or supplier of the product or service that it wishes to purchase does not mean that that public will examine the mark to the smallest detail, or that it will compare that mark to another mark in minute detail. Even for a public displaying a high level of attention, the average consumer only rarely has the opportunity to compare the different marks directly, and instead must rely on their imperfect recollection of them (§ 57).

10/11/2021, T-239/20, [Ruxximera / Ruximera](#), EU:T:2021:771, § 57

10/11/2021, T-542/20, [Ruximblis / Ruximera et al.](#), EU:T:2021:775, § 57

10/11/2021, T-248/20, [Ruxymla / Ruximera](#), EU:T:2021:772, § 57

### **LOC – Principle of imperfect recollection – Composite marks**

There is a LOC between the signs. Consumers who have to rely on the imperfect impression kept in their mind do not recall the differences between the marks. The marks share undeniable similarities in terms of their form, the positioning of the various elements and their outlines, from the point of view of the general concept conveyed. The goods are identical. The general public and professional consumers with a level of attention that varies from average to higher than average might perceive the contested mark as a variation of the earlier mark (§ 35, 37, 43-44, 50, 52, 59, 60, 69).



28/04/2021, T-615/19, [DEVICE OF STYLISED EXTENDED WINGS \(fig.\)-DEVICE OF STYLISED EXTENDED WINGS \(fig.\)](#), EU:T:2021:224, § 35, 37, 43-44, 50, 52, 59, 60, 69

### **LOC – Principle of imperfect recollection – Level of attention**

In so far as there is both a low degree of similarity between the signs and the goods and the earlier mark does not have highly distinctive character, which might give it greater protection, a likelihood of confusion could not be found (§ 106).

Although the relevant public only rarely has the chance to make a direct comparison between the different marks, but must rely on 'an imperfect recollection of them', a high level of attention on the part of the relevant public may lead to the conclusion that it will not confuse the marks in question despite the lack of direct comparison between the different marks (§ 108).

06/04/2022, T-370/21, [Nutrifem agnubalance / Nutriben](#), EU:T:2022:215, § 106, 108

### **LOC – Public with high level of attention – Principle of imperfect recollection**

The fact that the relevant public is more attentive does not mean that it will examine the mark before it in the smallest detail or that it will compare it in minute detail to another mark. The fact

remains that the members of the relevant public only rarely have the chance to compare the various marks directly and must therefore rely on their imperfect recollection of them (§ 88).

[01/03/2023, T-295/22, The Crush Series \(fig.\) / Crush \(fig.\), EU:T:2023:97](#)

### **No LOC – Principle of imperfect recollection – Specificity of the goods and services**

A careful selection of services (financial and banking services) which might result in a long-term contract can leave little, if any, room for the 'imperfect recollection' of a certain earlier mark (§ 131).



[12/07/2023, T-261/22, EM BANK European Merchant Bank \(fig.\) / Mbank et al., EU:T:2023:396](#)

### **Principle of imperfect recollection – Imperfect recollection of both similarities and differences**

The concept of imperfect recollection means that the consumer, who has been confronted with the earlier mark, could not remember all of the elements of that mark and, for that reason, takes the view that the goods and services relating to a similar mark come from the same or economically linked undertakings. However, it does not mean that the relevant public is more likely to remember the similarities rather than the differences between the marks as it is not possible to determine *in abstracto*, which elements of the earlier mark consumers will retain in their minds (§ 51-52).

[22/11/2023, T-32/23, Tradias / TRIODOS, EU:T:2023:740](#)

### **LOC – Principle of imperfect recollection**

Even if there is a low degree of similarity between the services, the level of attention of the relevant public is high and the earlier mark is weakly distinctive, it must be held that, in so far as the mark applied for reproduces almost exactly two elements of the earlier mark, there will be LOC on the part of that public, which will have to rely on its imperfect recollection (§ 83).

**Feed. The Feed.** [31/01/2024, T-26/23, Feed. \(fig.\) / The Feed. \(fig.\) et al., EU:T:2024:48](#)

## **2.6.3 Independent distinctive role**

### **No LOC – Notion of independent distinctive role – No independent distinctive role**

The application of the notion of independent distinctive role deriving from the Medion judgment (06/10/2005, C-120/04, Thomson Life, EU:C:2005:594, § 37) presupposes that the earlier mark is contained in the mark applied for (28/09/2016, T-574/15, KOZMETIKA AFRODITA (fig.) / EXOTIC AFRODITA MYSTIC MUSK OIL et al., EU:T:2016:574, § 45) (§ 40). Where the earlier mark is not fully contained in the mark applied for, the element in common cannot have any independent distinctive role (§ 40-42). In this case, the common verbal element 'caprice' is not sufficient to counterbalance the very limited similarity of the signs (§ 55).



[17/10/2019, T-628/18, FRIPAN VIENNOISERIE CAPRICE PUR BEURRE \(fig.\) / Caprice \(fig.\), EU:T:2019:750, § 40-42, 55](#)

### **No LOC – Common weakly distinctive verbal elements – Notion of independent distinctive role – No independent distinctive role**

Where a sign contains a weakly distinctive verbal element common to that sign and to the sign with which it is to be compared, and another element more likely to attract the attention of consumers, the presence of the identical element in the conflicting signs cannot, by itself, render them similar (§ 41). The BoA erred in law in two aspects. First, it did not take sufficient account of the fact that the element 'Sedus', by reason of its initial position in the mark applied for, is more likely to attract the attention of consumers than the element 'ergo+'. Second, it did not take due account of the difference between the respective degrees of distinctiveness of the elements 'Sedus' and 'ergo+' (§ 57).

In order for an element with weak distinctive character in a composite mark to have an independent distinctive role within the meaning of the Thomson Life judgment (06/10/2005, C-120/04, Thomson Life, EU:C:2005:594), it must be capable of influencing the consumer's perception, in particular by virtue of its position within the sign or its size, and of being retained in the consumer's memory (see also 22/10/2015, C-20/14, BGW/BGW, EU:C:2015:714, § 40). In the present case, the element 'ergo+' of the mark applied for is not capable of influencing the consumer's perception either by virtue of its position or its size (§ 83).

13/10/2021, T-429/20, [Sedus ergo+ / Ergoplus](#), EU:T:2021:698, § 41, 57, 83

13/10/2021, T-436/20, [Sedus ergo+ / Ergoplus et al.](#), EU:T:2021:699, § 44, 60, 86

### **No LOC – Impact of weak distinctive character of the earlier mark – Impact of common weak elements – No independent distinctive position**

The element 'e-power' refers to electric vehicles, electric motors and systems enabling vehicles or their components to run on electricity, which the parties do not dispute. Therefore, due to its connection to the goods in question, inter alia, vehicles, accessories or parts making up those vehicles, it has, at most, a low degree of distinctiveness (§ 44).

It is apparent from the *Medium* judgment (06/10/2005, C-120/04, Thomson Life, EU:C:2005:594), that 'where the goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another and a registered mark which has a normal degree of distinctiveness and which, although it does not determine by itself the overall impression conveyed by the composite sign in question, retains an independent distinctive role therein.' However, in the present case, the distinctive character of the element 'e-power' cannot be regarded as normal but is, at most, low, in so far as it is clear that that term alludes to the type of energy ensuring the functioning of the goods in question or related to those goods (§ 53). Accordingly, the applicant's argument based on the *Medion* judgement must be rejected.

It follows that the visual and phonetic similarity of the conflicting signs and their low degree of conceptual similarity, on account of an element whose distinctiveness is merely low, are likely to be offset by the visual, phonetic and conceptual difference. That difference therefore carries more weight in the global assessment of the likelihood of confusion, as the relevant public will have a higher than average level of attention. The BoA correctly took into consideration the low degree of distinctiveness of that element, the differences between the conflicting signs, the identity of or degree of similarity between the goods in question and the level of attention of the relevant public in order to find that there was no likelihood of confusion on the part of that public (§ 79-80).

**e-POWER** 10/11/2021, T-755/20, [Vdl e-power / e-POWER \(fig.\) et al.](#), EU:T:2021:769, § 44, 53, 79-80

**e-POWER** 10/11/2021, T-756/20, [Vdl e-powered / e-POWER \(fig.\) et al.](#), EU:T:2021:769, § 44, 53, 79-80

### **LOC – Distinctive and dominant elements of the signs – Addition of an element that will be recognised as a surname or business identifier – No independent distinctive position**

The earlier mark consists of only one element, namely 'RAUSCH'. Therefore, the examination of the most distinctive elements is not relevant for this mark (§ 104). The element 'rausch' of the mark applied for has an enhanced inherent distinctive character for the non-German-speaking part of the general public. This part of the relevant general public will not be familiar with that surname or that word. The element 'rausch', alone or in conjunction with another element referring to the Alps, will have no meaning and will be perceived as a purely fanciful term (§ 108, 122-123).

The conflicting signs are visually and phonetically similar to an average degree (§ 137-139). The conceptual comparison is neutral since the element 'rausch' is not understood by the non-German speaking part of the relevant public (§ 140).

The applicant cannot claim that there is no likelihood of confusion relying on the Medion judgment (06/10/2005, C-120/04, Thomson Life, EU:C:2005:594). It is apparent from this judgment that, where the goods or services are identical, there may be a likelihood of confusion on the part of the public if the contested sign is formed by juxtaposing the applicant's company name and a registered mark which has a normal degree of distinctiveness and which, although it does not determine by itself the overall impression conveyed by the composite sign, retains an independent distinctive role therein (§ 172). However, the Court has also stated that a component of a composite sign does not retain an independent distinctive role if, together with the other component or components of the sign, that component forms a unit with a different meaning from that of the components individually (22/10/2015, C-20/14, BGW/BGW, EU:C:2015:714, § 39) (§ 173).

There is a likelihood of confusion for the non-German-speaking part of the relevant general public since, for that part, the element 'rausch' – which is common to the marks – has no meaning whether it stands alone, as in the earlier mark, or is considered together with the other elements of the mark applied for. The element 'rausch' of the mark applied for retains an independent distinctive role in that mark (§ 96, 122, 174).

21/12/2021, T-6/20, [Alpenrausch Dr. Spiller / RAUSCH](#), EU:T:2021:920, § 96, 104, 108, 122-123, 122, 140, 172-174

### **LOC – Independent distinctive role**

The word element 'SOHO' is not the dominant element in the contested mark, but it is completely reproduced in the contested mark. Its distinctive character is normal. It therefore meets the criteria laid down in the case-law to conclude that it has an independent distinctive role within the contested mark. The combination of the word elements 'the king of' and 'Soho' does not create a concept and a logical unit that is distinct from those of its components.

Given the average or weak similarity of the goods, the high degree of phonetic and conceptual similarities and average degree of visual similarity of the signs, and the independent distinctive role played by the common word element 'Soho', it must be concluded that the BoA was entitled to find a LOC between the marks at issue (§ 118-124).



28/04/2021, T-31/20, [THE KING OF SOHO \(fig.\) / SOHO](#), EU:T:2021:217, § 118-124

### **No LOC – No independent distinctive role**

The verbal element 'unit' of the mark applied for does not have an 'independent distinctive role'. The other verbal element 'k9' and the figurative elements are clearly dominant compared to the verbal element 'unit' which is written in a much smaller font. Moreover, the verbal element 'k9' is part of the applicant's name, Julius-K9, which manufactures the goods. So, from the perspective

of the relevant public, the word 'unit' cannot be regarded as independent from the element 'k9' (§ 62). The signs have significant visual and phonetic differences that cancel out the similarity resulting from the common verbal element 'unit' (§ 63).



28/03/2019, T-276/18, [K9 Unit \(fig.\) / unit \(fig.\) et al.](#), EU:T:2019:200, § 62-

63

### **No LOC – No independent distinctive role – Weak distinctiveness of the earlier mark**

At no time has the applicant demonstrated that the conditions for applying the case-law stemming from the 'Thomson Life' judgment (06/10/2005, C-120/04, Thomson Life, EU:C:2005:594) were satisfied in the present case. Moreover, it must be held that the principle established by the CJ in that judgment cannot be applied in the present case, since the word 'workspace' does not have normal distinctiveness but is, at most, weakly distinctive (§ 56).

Bearing in mind the, at best, weak visual, phonetic and conceptual similarities between the signs, the fact that they share a descriptive element, the weak distinctiveness of the earlier EU trade mark and the high level of attention of the professional public, there is no LOC, even though the services in question are identical. This finding also applies to the earlier UK trade marks (§ 59).



**WORKSPACE**

28/05/2020, T-506/19, [Uma workspace / WORKSPACE \(fig.\) et al.](#), EU:T:2020:220, § 49-52, 56, 59

### **LOC – Composite sign – Notion of independent distinctive role**

It follows from the *Medion* judgment (06/10/2005, C-120/04, Thomson Life, EU:C:2005:594, § 32) that a finding that there is a likelihood of confusion cannot be subject to the condition that the overall impression produced by the composite sign must be dominated by the part of it which is represented by the earlier mark (§ 56). The Board of Appeal correctly took into consideration that 'the earlier mark and one of the verbal elements of the international registration at issue are almost identical, in respect of which it had already found that it was no less visible or visually eye-catching because it was located in the middle of that mark, in the absence of a composite element in which the word at issue may somehow not be as immediately perceived (§ 58). Consequently a likelihood of confusion exists (§ 59-60).

[02/02/2022, T-202/21, Vitablocs triluxe forte / Trilux, EU:T:2022:42](#), § 56, 58-60

### **No LOC – No independent distinctive role – Earlier mark not reproduced identically**

It does not follow from the Thomson Life judgment (06/10/2005, C-120/04, Thomson Life, EU:C:2005:594) that the CJ would have held that there was LOC where, as in the present case, the earlier mark was incorporated into the contested sign in a 'modified' form and retained an independent distinctive role in the sign thus composed. The approach followed in the judgment (10/10/2012, T-569/10, BIMBO DOUGHNUTS / DONUT et al., EU:T:2012:535), according to which there could be LOC even if the earlier mark was not reproduced identically in the later mark, was not expressly confirmed by the CJ. Since the element 'skin-identical' does not in itself correspond to any of the earlier marks, it is irrelevant that a well-known sign (NIVEA), dominating the overall impression created by the mark applied for, may be regarded as having an independent distinctive role within the meaning of the Thomson Life case-law (§ 39-51).

[08/11/2023, T-665/22, NIVEA SKIN-IDENTICAL Q10 / SKINIDENT et al., EU:T:2023:704](#)

## LOC – Independent distinctive role

The element 'Bi', separated from 'cell' by a full stop, retains an independent role in the earlier mark (§ 36). The fact that an element of the sign applied for does not in itself constitute the earlier sign does not prevent it from retaining an independent distinctive role in the sign applied for (§ 64).



**Bi.cell**

[21/02/2024, T-180/23, \*Bi blue pigment \(fig.\) / Bi.cell \(fig.\)\*, EU:T:2024:103](#)

## 2.6.4 Method of purchase

### Consideration of marketing circumstances – Global assessment

Marketing circumstances are to be taken into account at the stage of the global assessment of the LOC and not in the assessment of the similarity of the signs (§ 70).

04/03/2020, C-328/18 P, [BLACK LABEL BY EQUIVALENZA \(fig.\) / LABELL \(fig.\) et al.](#), EU:C:2020:156, § 70

### Items of decoration

*Figurines for ornamental purposes* (in Classes 6, 19, 20 and 21) are marketed in such a way that the visual aspect has greater importance than the phonetic and conceptual aspects (§ 93).



23/09/2020, T-608/19, [Veronese \(fig.\) / VERONESE](#), EU:T:2020:423, § 93

### Items of furniture

Concerning items of furniture particular importance must be attached to the visual perception of the marks. The phonetic similarity is less important (§ 75-76).

27/02/2019, T-107/18, [Dienne \(fig.\) / ENNE \(fig.\)](#), EU:T:2019:114, § 75-76

### Alcoholic beverages

Phonetic similarity is particularly important with regard to *alcoholic beverages* because those goods are often consumed after being ordered orally (§ 68).

19/12/2019, [T-589/18, MIM NATURA \(fig.\) / MM et al.](#), EU:T:2019:887

### Wine sector

In the wine sector, particular importance must be attached to the phonetic aspect and the fact that consumers usually describe and recognise wine by reference to the verbal element of the sign, since this element designates in particular the grower or the estate on which the wine is produced. The element 'DE' is just a preposition before 'GIUSTI' which will be perceived as the core element of the family name (§ 54-56).

19/09/2019, T-678/18, [GIUSTI WINE / DG DeGIUSTI \(fig.\) et al.](#), EU:T:2019:616, § 54-56

### Wine – Designations of origin

The fact that the labels of wines marketed under different marks indicate different designations of origin is irrelevant, since it cannot be ruled out that the same undertaking produces several wines bearing different designations of origin (§ 68).

17/01/2019, T-576/17, [EL SEÑORITO / SEÑORITA](#), EU:T:2019:16, § 68

### **Clothes shops – Impact of the visual perception**

In clothes shops, customers can either choose the clothes they wish to buy themselves or be assisted by the sales staff. Whilst oral communication is not excluded, the choice of the item of clothing is generally made visually. The visual perception of the marks in question will generally take place prior to purchase and, therefore, the visual aspect plays an important role in the global assessment of the LOC (06/10/2004, T-117/03 - T-119/03 & T-171/03, NL, EU:T:2004:293, § 50] (§ 66).

15/07/2020, T-371/19, [FAKEDUCK \(fig.\) / Save the duck \(fig.\) et al.](#), EU:T:2020:339, § 66

### **Clothing manufacturer – Sub-brands**

It is common for a single clothing manufacturer to use sub-brands (signs that derive from a principal mark and which share with it a common dominant element) to distinguish its various lines from one another. The relevant public is likely to wrongly identify the contested mark as a sub-brand of the earlier mark and wrongly conclude that the conflicting marks are marketed by the same undertaking (§ 80-82).

24/01/2019, T-785/17, [BIG SAM SPORTSWEAR COMPANY \(fig.\) / SAM et al.](#), EU:T:2019:29, § 80-82

### **Goods chosen in shops, catalogues or on the internet or prescribed or recommended orally – Particular importance of visual and phonetic aspects**

Since *clothing, headgear* and *footwear* will generally be chosen when viewed in shops, catalogues or on the internet or prescribed or recommended orally, the visual and phonetic aspects are the most important (06/10/2004, T-117/03 - T-119/03 & T-171/03, NL, EU:T:2004:293, § 50; 08/02/2007, T-88/05, Nars, EU:T:2007:45, § 69; 18/05/2011, T-502/07, McKenzie, EU:T:2011:223, § 50-51) (§ 106).

08/07/2020, T-21/19, [mediFLEX easySTEP \(fig.\) / Stepeasy \(fig.\)](#), EU:T:2020:310, § 106

### **Irrelevance of elements based on subjective commercial intentions – Use of the mark**

The prospective analysis of the LOC cannot be dependent on the subjective commercial intentions, whether carried out or not, of the trade mark proprietors. Accordingly, the comparison of the marks cannot be made on the basis of an element which depends on the intentions of the proprietor of one of the marks (for example, the size in which a mark can be used in practice, which cannot be objectively determined by reference to the size of the goods that it designates). The use of a trade mark is not limited to affixing it to the goods themselves, since the trade mark may also be affixed, in particular, to labels attached to the goods, to their packaging or even independently of the goods, on shop signs or advertising documents (08/11/2017, T-754/16, CC (fig.)/ O (fig.), EU:T:2017:786, § 53) (§ 92).



23/09/2020, T-608/19, [Veronese \(fig.\) / VERONESE](#), EU:T:2020:423, § 92

### **LOC – Professional public – Marketing strategies of the goods concerned**

The term 'professional public' refers to the idea of a restricted and specialist category of public which is likely to have specific knowledge relating to the goods at issue and generally display a high level of attention. It is not apparent either from the EUTMR or from the case-law that it is

required to specify the qualifications of the persons who are specifically concerned by the identification of a category of relevant public, whether what is concerned is the general public or the professional public. A distinction is drawn solely between the general public and the professional or specialist public, since the global assessment of the likelihood of confusion must be carried out having regard to the average consumer who has the lowest level of attention (§ 33-34).

The LOC is assessed by reference to the consumers' perception of the goods at issue and not on the basis of particular marketing strategies for those goods, which may vary over time and depend on the wishes of the proprietor of the mark (§ 35).

*06/04/2022, T-516/20, [Quest 9 / Quex](#), EU:T:2022:227, § 33-35*

### **LOC – Method of purchase of goods**

The fact that goods may be sold online or in self-service shops without specialised help is not sufficient to rule out any LOC in the event of a below-average degree of visual similarity (§ 89).

*[01/03/2023, T-295/22, \[The Crush Series \\(fig.\\) / Crush \\(fig.\\)\]\(#\), EU:T:2023:97](#)*

### **No LOC – Services in the field of publishing and entertainment – Importance of visual comparison**

Visual perception of the marks plays a particularly important role in the fields of publishing and entertainment services, the choice of which is, above all, made visually (§ 157).

*[07/06/2023, T-47/22, \[THE PLANET \\(fig.\\) / PLANETE+ \\(fig.\\)\]\(#\), EU:T:2023:311](#)*

### **Phonetic comparison – Marketing conditions**

In the absence of prior identification of the marketing conditions, particular relevance to the phonetic comparison in the global assessment of the likelihood of confusion cannot be given (§ 119).

*[21/06/2023, T-197/22 & T-198/22, \[InterMed Pharmaceutical Laboratories eva intima \\(fig.\\) / Evax et al.\]\(#\), EU:T:2023:345](#)*

### **No LOC – Financial services – Importance of the visual comparison**

For financial services in Class 36, the visual aspect predominates, since the relevant public will perceive signs on business signs, papers and prospectuses when choosing a financial institution for its services and for the accompanying goods. In such a context, the visual aspect and, therefore, also the perception of graphic elements, in addition to word elements, is more important than the phonetic aspect. A contract with a bank is concluded in writing, not orally (§ 138).



*[12/07/2023, T-261/22, \[EM BANK European Merchant Bank \\(fig.\\) / Mbank et al.\]\(#\), EU:T:2023:396](#)*

### **No LOC – Cosmetics and body care products – Importance of visual comparison**

The goods used for body care and beauty are generally purchased on a self-service basis and the relevant public will have the opportunity to inspect the goods visually. Even if pharmacies could constitute marketing channels for the goods in question, they are chosen from self-service displays by customers and are only taken to the till subsequently. Even if it is conceivable that in some cases the goods in question may also be sold in response to an oral order or that the

selection of goods may be accompanied by a process of communication with the seller, that method cannot be regarded as the usual method of marketing those goods. The same is true for specialist shops (§ 95-97).

[11/10/2023, T-490/22, ayuna LESS IS BEAUTY \(fig.\) / Ajona, EU:T:2023:616](#)

### **LOC – Impact of weak elements – Method of purchase – Importance of visual comparison – Imperfect recollection**

Although the verbal elements and the parts of the figurative elements that refer to a cherry have only limited distinctive character, the specific reproduction and arrangement of the figurative elements and the colour palette used in the marks at issue, which are visually similar, have a certain distinctive character. For the goods concerned (confectionery and non-alcoholic beverages), the visual aspect is particularly important. The imperfect recollection gives more weight to the elements that are particularly visible and easy to apprehend such as, in this case, the figurative elements of the marks at issue. In such circumstances, where the marks are examined at the distance and speed at which the consumer, in a supermarket, selects the goods they are looking for, the differences between the signs are more difficult to distinguish and the similarities are more apparent. Since the contested mark reproduces the visual essence of the earlier mark, namely the overall composition and structure and the colour palette, there is LOC, without it being decisive whether the earlier mark has enhanced distinctiveness (§ 87-100).



[29/11/2023, T-29/23, CHERRY Passion \(fig.\) / MIESZKO PRALINES CHERRISSIMO \(fig.\) et al., EU:T:2023:765](#)

### **No LOC – Alcoholic beverages – Importance of phonetic comparison**

The relevant public will attach particular importance to phonetic similarity, which in this case is low, since alcoholic beverages are often ordered orally in restaurants and bars. This circumstance reduces the likelihood that the relevant public will confuse the signs (§ 116).

[06/12/2023, T-627/22, agricolavinica. Le Colline di Ripa \(fig.\) / VENICA, EU:T:2023:782](#)

### **No LOC – Fashion sector – Importance of visual comparison**

The purchase of goods in Classes 14 and 25 related to the fashion sector is based, in principle, particularly on their visual aspect (§ 84). Where the choice of the goods is based mainly on their visual aspect and the concept represented is banal in the fashion sector, the BoA was found to have erred in attaching more importance to the conceptual identity between the marks at issue (§ 85-86).



[20/12/2023, T-564/22, DEVICE OF A LION HEAD \(fig.\) / DEVICE OF A LION HEAD \(fig.\), EU:T:2023:851](#)

### **No LOC – Importance of visual comparison**

For respiratory masks and earplugs, the phonetic perception is not as important as the visual perception. While these goods can be ordered orally from pharmacies, they are generally available on a self-service basis (§ 77-78).

[MOLDEX 21/02/2024, T-767/22, Horex / MOLDEX \(fig.\), EU:T:2024:108](#)

## **No LOC – Beverages – Importance of visual comparison**

Since *alcohol free beverages* in Class 32 and *alcoholic beverages, except beer* in Class 33 are above all sold in self-service shops, the phonetic aspect of the marks at issue is generally of less importance than the visual aspect of those marks (§ 40).

[28/02/2024, T-279/23, smål \(fig.\) / SUMOL \(fig.\) et al., EU:T:2024:130](#)

## **2.6.5 Neutralisation of visual and phonetic similarities by conceptual dissimilarity**

### **Counteraction of a phonetic similarity through visual and conceptual differences – Conditions for counteraction**

Conceptual differences between two signs may exceptionally counteract their phonetic and visual similarities, provided that at least one of those signs has a clear and specific meaning that the relevant public can grasp immediately (§ 74). The assessment of the conditions of this counteraction forms part of the assessment of the similarity of the signs that follows the assessment of their visual, phonetic and conceptual similarities (05/10/2017, C-437/16 P, CHEMPIOIL / CHAMPION et al., EU:C:2017:737, § 43) (§ 75).

[04/03/2020, C-328/18 P, BLACK LABEL BY EQUIVALENZA \(fig.\) / LABELL \(fig.\) et al., EU:C:2020:156, § 74-75](#)

### **No LOC – Neutralisation of visual and phonetic similarities by conceptual dissimilarity – Conditions for counteraction**

Within the global assessment of the LOC, the conceptual differences between the signs may counteract phonetic and visual similarities between them, provided that at least one of those signs has, from the point of view of the relevant public, a clear and specific meaning so that that public is capable of grasping it immediately (04/03/2020, C-328/18 P, BLACK LABEL BY EQUIVALENZA (fig.) / LABELL (fig.) et al., EU:C:2020:156, § 74-75) (§ 77-79) (§ 77).

The relevant public will immediately understand the word ‘panda’ of the earlier marks as referring to a black and white bear native of south-east China. That meaning is, from the point of view of the relevant public, a clear, specific meaning which can be grasped immediately by that public, whereas the sign applied for has no meaning (§ 59-60). Accordingly, the signs are conceptually dissimilar (§ 64, 78). The conceptual difference between the signs counteracts the phonetic and visual similarities between them. On account of the conceptual difference and despite the lower-than-average degree of phonetic similarity (§ 49, 52) and the average degree of visual similarity (§ 39, 45), the relevant public, which has a high level of attention, is not likely to consider that the signs originate from the same undertaking or from economically-linked undertakings, despite the enhanced distinctiveness of the earlier marks.

[28/04/2021, T-191/20, Pandem / Panda et al., EU:T:2017:90, § 39, 45, 49, 52, 59-60, 64, 77-78](#)

### **Lack of consideration of possible counteraction of visual and phonetic similarities through conceptual differences – Conditions for counteraction**

The word ‘amen’ has a clear and specific meaning which the relevant public will grasp directly (§ 56). This meaning will not be disregarded by the relevant public in the clothing sector (§ 59). The BoA erred in finding that it was not possible to carry out a conceptual comparison because the marks did not convey any clear concept capable of being grasped directly and immediately by the average consumer (§ 60, 73, 78). Consequently, the assessment of the LOC is vitiated by an erroneous examination of the conceptual similarity and by not having considered the possible application of the conceptual neutralisation (§ 78).

**.A.M.E.N.** 05/05/2021, T-442/20, [Âme / .A.M.E.N. \(fig.\)](#), EU:T:2021:237, § 56, 59-60, 73, 78

### **No LOC – Phonetic perception of marks for beverages – Conceptual neutralisation**

There is no likelihood of confusion between the signs. The BoA was wrong to take into account a relevant public with a lower than average level of attention for *non-alcoholic beverages* in Class 32. The level of attention is average, as it is neither particularly low nor particularly high (§ 22). The difference created by the alphabetic characters separated by different punctuation marks is visually perceptible (§ 35). The signs are visually similar to a low or average degree (§ 36) and phonetically similar to an average degree (§ 45). They are conceptually different (not disputed) (§ 47). The particular importance accorded to the oral perception for beverages which can be ordered orally doesn't mean that this is the only means by which a purchase will be made (§ 59-61). Although preponderant importance has sometimes been accorded to the phonetic perception of marks in relation to beverages, that will not be appropriate in all cases (§ 62). The conceptual differences neutralises the moderate similarities on the visual and phonetical levels (§ 72). The earlier mark's figurative elements further differentiate the signs (§ 76). The GC alters the BoA's decision (§ 81)



23/02/2022, T-198/21, [Code-x / Cody's \(fig.\) et al.](#), EU:T:2022:83, § 22, 35-36, 45, 47, 59-62, 72, 76

### **No LOC – Degree of attention of the relevant public – Dissection of the earlier sign – Visual comparison – Phonetic comparison – Conceptual comparison – Neutralization of visual and phonetic similarities**

The general public's degree of attention in respect of the goods that may have important consequences on consumers' health is above average (§ 26). The relevant public will normally dissect the mark into the elements that for them suggest a concrete meaning or remind them of known words. In the present case, although the earlier sign has no meaning in Spanish, part of the Spanish-speaking consumers may dissect it into two elements, namely 'METAL', which will be seen as a reference to the chemical element, and 'GIAL', which will be seen as a meaningless term (§ 37-40).

The conflicting signs are visually similar only to a low degree irrespective of the fact that the contested sign is fully included in the beginning of the earlier sign (§ 46-52). From the phonetic perspective, the signs only coincide in their first syllable 'ME'. Moreover, since their accent lies on distinct syllables, they differ significantly in their rhythm and intonation. Therefore, there is only a low degree of phonetic similarity between the conflicting signs (§ 53-55).

Neither for the part of the relevant public who will perceive it as a meaningless term, nor for the other part of the public who will be able to dissect it, is the contested sign conceptually similar to the earlier sign (§ 56-61). Given that the earlier sign has a clear meaning that will be grasped immediately by the relevant public, the existing conceptual differences between the conflicting signs are sufficient to outweigh the low degree of visual and phonetic similarities between them.

02/03/2022, T-192/21, [Meta / Metalqial](#), EU:T:2022:105, § 26, 37-40, 46-53-56-61

### **No LOC – Conceptual dissimilarity – Conditions for counteraction not met**

The 'counteraction theory' refers to the situation where a particularly pronounced and obvious conceptual difference between the signs at issue may counteract any visual and phonetic similarity found between them (§ 98). In this case, although the signs under comparison, as a whole, convey different concepts and are different from the conceptual point of view, that

difference is not particularly pronounced and obvious. Therefore, it cannot counteract the visual and phonetic similarities (§ 99).

However, in view of the low degree of visual and phonetic similarity of the signs and the conceptual differences between them, as well as the high level of attention of the relevant public, the BoA rightly found no LOC (§ 100, 101).



Avanza Credit de Deutsche Bank

[15/02/2023, T-341/22, \*avanza Tu negocio \(fig.\) / Avanza Credit de Deutsche Bank \(fig.\)\*, EU:T:2023:73](#)

### **No LOC – Conceptual dissimilarity – Neutralisation at the stage of the comparison of signs**

The conflicting signs convey different semantic concepts capable of neutralising the marginal visual and phonetic similarities so that the conflicting signs produce a different overall impression (§ 53).

[grund 19/04/2023, T-749/21, \*Josef grund gerüstbau / grund \(fig.\)\*, EU:T:2023:200](#)

## **2.6.6 Impact of weak elements / weak earlier mark**

### **Common weakly distinctive elements – Impact on finding the existence of a LOC**

Where the earlier trade mark and the sign whose registration is sought coincide in an element that is weakly distinctive with regard to the goods at issue, the global assessment of the LOC within the meaning of Article 8(1)(b) CTMR [now EUTMR] does not often lead to a finding that such likelihood exists (12/06/2019, C-705/17; Mats Hansson, EU:C:2019:481, § 55).



[18/06/2020, C-702/18 P, \*PRIMART Marek Łukasiewicz \(fig.\) / PRIMAet al.\*, EU:C:2020:489, § 53](#)

### **No LOC – Weakly distinctive elements – Endings of word marks composed of two elements that possess no visual, phonetic or even conceptual similarities**

Where the endings of word marks composed of two elements possess no visual, phonetic or even conceptual similarities, they are able to compensate for the visual, phonetic and even conceptual similarities that result from the presence of the weakly-distinctive beginning component, 'natura', common to both signs (§ 43, 44, 50). Since the inherent distinctiveness of the earlier mark in light of the two components of the word sign is weak (§ 75), the signs are globally different in the overall impression they produce in the minds of the relevant public (§ 76). There is no LOC, notwithstanding the identity of the goods (§ 77).

For a trade mark of a weak distinctive character, the degree of similarity between the signs should be high to justify a LOC, otherwise there would be a risk of granting excessive protection to that trade mark and its proprietor (§ 56).

[05/10/2020, T-602/19, \*Naturanove-Naturalium\*, EU:T:2020:463, § 43, 44, 50, 56, 55-77](#)

### **No LOC – Impact of a common weakly-distinctive component or common component with no distinctive character – Low distinctive character of the earlier mark**

Where the elements of similarity between two signs are the result of the fact that they have a common weakly-distinctive component or a common component that has no distinctive character, the impact of those elements of similarity on the global assessment of the LOC is itself low

(05/03/2020, T-688/18, CORNEREYE / BACKEYE et al., EU:T:2020:80, § 38 and the case-law cited) (§ 91).

There is no LOC between the phonetically and conceptually identical signs, which are visually similar to a degree ranging from low to average (§ 66-72), considering that the visual similarity between the signs and their phonetic and conceptual identity arise solely out of the presence, in those signs, of the expression 'museum of illusions', which, on account of its descriptive nature, will only slightly attract the attention of the relevant Greek public with a level of attention that varies from average to high for identical or similar services and the low degree of inherent distinctiveness of the earlier mark (§ 91-97).



12/05/2021, T-70/20, [MUSEUM OF ILLUSIONS \(fig.\) / MUSEUM OF ILLUSIONS \(fig.\)](#), EU:T:2021:253, § 91-97

### **No LOC – Weak distinctive character of the common element – Tradition in the sector**

Because of its historical connection with the delivery of mail, the stylised device of a post horn has been used by several postal operators throughout the EU and the public will not necessarily see it as an indication of the origin of the postal services (§ 46).

The degree of distinctiveness of the earlier mark determines the extent of the protection conferred by it. Where its distinctiveness is significant, this is likely to increase the LOC ([05/03/2020, C-766/18 P, BBQLOUMI \(fig.\) / HALLOUMI](#), EU:C:2020:170, § 70 and the case-law cited). Where the distinctiveness of the earlier mark is low, the extent of the protection conferred by that mark is also low, even if the existence of a LOC is not precluded (§ 49).

Where the signs coincide in an element that is weakly distinctive regarding the goods and services, the global assessment of the LOC does not often lead to a finding that such a likelihood exists (18/06/2020, C-702/18 P, PRIMART Marek Łukasiewicz (fig.) / PRIMA et al., EU:C:2020:489, § 53) (§ 50).

In view of that tradition in the sector concerned, which explains why signs which have similarities have coexisted for a long time, and of the low distinctiveness of the earlier mark, the BoA rightly found that there was no LOC between the signs, despite the fact that they have an average degree of similarity and despite the identity or similarity of the goods and services concerned (§ 55).



11/11/2020, T-25/20, [DEVICE OF A HORN \(fig.\) / DEVICE OF A HORN \(fig.\)](#), EU:T:2020:537, § 46, 49-50, 55

### **No LOC – Weak distinctiveness of the earlier mark – No independent distinctive role**

Where the elements of similarity between two signs relate to the fact that they share a weakly distinctive component, the impact of such elements of similarity in the global assessment of the LOC is itself weak (22/02/2018, T-210/17, TRIPLE TURBO (fig.) / ZITRO TURBO 2 (fig.), EU:T:2018:91, § 73; 13/12/2007, T-242/06, El charcutero artesano, EU:T:2007:391, § 85; 04/03/2015, T-558/13, FSA K-FORCE, EU:T:2015:135, § 49-52).

At no time has the applicant demonstrated that the conditions for applying the case-law stemming from the 'Thomson Life' judgment (06/10/2005, C-120/04, Thomson Life, EU:C:2005:594) were satisfied in the present case. Moreover, it must be held that the principle established by the CJ in that judgment cannot be applied in the present case, since the word 'workspace' does not have normal distinctiveness but is, at most, weakly distinctive (§ 56).

Bearing in mind the, at best, weak visual, phonetic and conceptual similarities between the signs, the fact that they share a descriptive element, the weak distinctiveness of the earlier EU trade mark and the high level of attention of the professional public, there is no LOC, even though the services in question are identical. This finding also applies to the earlier UK trade marks (§ 59).



**WORKSPACE** 28/05/2020, T-506/19, [Uma workspace / WORKSPACE \(fig.\) et al.](#), EU:T:2020:220, § 49-52, 56, 59

### **LOC – Weak distinctiveness of the earlier mark – Consideration of other factors such as position structure and dimension and global meaning**

It had not been established that the earlier mark was particularly distinctive due to its intensive use or reputation. Its distinctiveness therefore rested on its distinctiveness per se (§ 118). As the earlier mark consists of the element ‘touring club’, which is weakly distinctive with regard to the services, and of the element ‘italiano’, which is directly descriptive, the distinctive character of the earlier mark is weak. However, there is a LOC even in a case involving an earlier mark with a weak distinctive character since the services are identical and the signs are visually similar to an average degree, phonetically similar to at least an average degree, and conceptually similar to a high degree (§ 119-121).



05/02/2019, T-44/19; [TC Touring Club \(fig.\) / TOURING CLUB ITALIANO et al.](#), EU:T:2020:31, 119-121

### **LOC – Impact of weak distinctive character of the earlier mark – Impact of common weak elements**

A finding that the earlier mark has a weak distinctive character does not preclude a finding that there is a likelihood of confusion (LOC). Although the distinctive character of the earlier mark must be taken into account in assessing the LOC, it is only one factor among others involved in that assessment. Consequently, even in a case involving an earlier mark with a weak distinctive character, there may be a LOC on account, in particular, of a similarity between the signs and the goods or services covered (13/12/2007, T-134/06, Pagesjaunes.com, EU:T:2007:387, § 70 (§ 64).

Where the earlier trade mark and the sign for which registration is sought coincide as a result of an element that is weakly distinctive or descriptive with regard to the goods or services, the global assessment of the LOC will often lead to a finding that that likelihood does not exist. However, it follows from the case-law of the Court of Justice that a finding that there is such a LOC cannot, because of the interdependence of the relevant factors in that regard, be ruled out in advance and in any event (12/06/2019, C-705/17, ROSLAGSÖL, EU:C:2019:481, § 55) (§ 65). Considering the principle of interdependence despite the weak distinctive character of the earlier mark for the English-speaking public, the BoA was right to find that there was a LOC as to the origin of the goods on the part of the relevant public (§ 74).



20/10/2021, T-351/20, [Vital like nature \(fig.\) / VITAL \(fig.\)](#), EU:T:2021:719, § 64-65, 74

### **LOC – Distinctive and dominant elements – Impact of common weak distinctive element**

The verbal element 'STEP' has a weak distinctive character insofar as it can indicate goods that make up a surface to step on or related services (§ 57, 58, 76). The protection that results from the registration of a word mark applies to the word mentioned in the application for registration and not to the specific graphic or stylistic characteristics that mark might have (§ 68). Because the sole element of the earlier mark, 'step', was contained in its entirety in the mark applied for and the other elements of the mark applied for had an extremely weak distinctive character, a LOC existed (§ 99).



26/01/2022, T-498/20, [WOOD STEP LAMINATE FLOORING \(fig.\) / Step](#), EU:T:2022:26, § 57-58, 68, 76, 99

### LOC – Weak distinctive and dominant elements – Consideration of their position and their size

The figurative elements depicting symbols of an arrow and a bottle are used throughout the whole of the European Union to denote the recycling process or recycling services. Therefore, these figurative elements, as the distinctive and dominant elements of the signs, have weak distinctive character in respect of the goods and services, which all relate to the recycling of packaging (not disputed). However, on account of their position and size, the arrow and the bottle will make an impression on consumers and are likely to be remembered by them, while the can and the frame are not insignificant (§ 34-35). In view of the average degree of visual and conceptual similarity between the signs, a LOC could not be excluded on the basis that the signs produced a different overall impression (§ 54-57).



11/04/2019, T-477/18, [DEVICE OF A BOTTLE SILHOUETTE AND AN ARROW \(fig.\) / DEVICE OF A CAN AND A BOTTLE SILHOUETTE AND AN ARROW \(fig.\)](#), EU:T:2019:240, § 34-35, 54-57

### No LOC in relation to the goods and services for which the common element is weak – LOC in relation to the goods and services for which the common element is distinctive

The similarity between the signs is due to the coincidence in the term 'carajillo'. There is no LOC for the goods and services in relation to which this term is weak. The term 'carajillo' designates 'a beverage that is generally prepared by adding a strong alcoholic beverage to hot coffee'. This definition renders 'carajillo' as descriptive in relation to *liqueurs and other alcoholic beverages (except beer)* in Class 33 and *retail and wholesale services regarding liqueurs and other alcoholic beverages* in Class 35 (§ 57). There is a LOC for the remaining goods and services, in relation to which this term is fully distinctive (§ 50-76).



08/03/2019, T-326/18, [CARAJILLO LICOR 43 CUARENTA Y TRES \(fig.\) / Carajillo \(fig.\)](#), EU:T:2019:149, § 50-76

### No LOC – Weak distinctive character of the common element

The word 'aqua' has a certain descriptive dimension insofar as it will be perceived by the relevant public, composed of specialists in the dental field with a high degree of attention, as alluding to a certain characteristic of the goods, namely that they are suitable for functioning in a wet environment, whether that be the mouth of a patient, or a clinical or laboratory environment where

contact with water is to be expected (§ 38-39). Therefore, the inherent distinctive character of the element 'aqua' of the marks is weak (§ 40). It is not necessary for the two elements 'aqua' and 'cem' to have a concrete meaning for the relevant public to break down the word 'aquacem' into the two elements 'aqua' and 'cem'. (§ 55).

The signs are restricted to the presence of the element 'aqua', which has a weak distinctive character, and are offset to a large extent by the presence of the words 'cem' and 'print'. Although those elements can also have a weak distinctive character with respect to certain goods and for certain parts of the relevant public, they give rise to a clear difference between the signs, taken together. The circumstances of the case are therefore such that the relevant public will clearly distinguish the signs, even if they have a weak degree of similarity due to the element 'aqua' (§ 90).

23/05/2019, T-312/18, [AQUAPRINT / AQUACEM et al.](#), EU:T:2019:358, § 38-39, 40, 55, 90

### **No LOC – Weak distinctive character of the common element**

The similarities between the signs are restricted to the presence of the element 'city', which has a weak distinctive character, and are offset to a large extent by the endings 'mania' and 'lights'. Although the elements 'mania' and 'lights' may also have a weak distinctive character for certain goods and for certain parts of the relevant public, they give rise to a difference between the signs when taken as a whole. The relevant public will therefore clearly distinguish the signs, even though they have a low degree of similarity due to the presence of the common element 'city' (§ 60-62).

13/05/2020, T-381/19, [City Mania / City Lights](#), EU:T:2020:190, § 60-62

### **No LOC – Weak distinctive character of the common element – Common elements in almost identical fonts**

The fact that the common elements of the conflicting signs are written in an almost identical font is not decisive, but must be taken into account in the overall assessment of visual similarity. If those elements are also represented in commonly used typefaces, without any particular stylisation or decoration, this factor is unlikely to be relevant (§ 48). Considering also the different colours, the degree of visual similarity between the signs is low (§ 50).

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

 09/09/2020, T-879/19, [Dr. Jacob's essentials \(fig.\) / Compal Essencial et al.](#), EU:T:2020:401, § 48, 50, 52

### **No LOC – Weak distinctive character of the common element**

Where the elements of similarity between two signs arise from the fact that they share a component which has weak inherent distinctiveness, the impact of such elements on the global assessment of the LOC is itself low (§ 64)



20/01/2021, T-328/17 RENV, [BBQLOUMI \(fig.\) / HALLOUMI et al.](#), EU:T:2021:16, § 64

### **No LOC – Weak distinctive character of the common element**

Where the elements of similarity between two signs are the result of the fact that they have a weakly distinctive component in common, the impact of those elements of similarity on the global assessment of the LOC is itself low (22/02/2018, T-210/17, TRIPLE TURBO (fig.) / ZITRO TURBO 2 (fig.), EU:T:2018:91, § 73) (§ 90).

 15/10/2020, T-349/19, [athlon custom sportswear \(fig.\) / Decathlon](#), EU:T:2020:488, § 90

### LOC – Weak elements

It is only if all the other components of the signs are negligible that the assessment of their similarity can be carried out solely on the basis of their dominant elements (§ 32).

Where some elements of a trade mark are descriptive of the goods and services in respect of which that mark is protected or of the goods and services covered by the application for registration, those elements are recognised as having only a weak, or even very weak, distinctive character (§ 48).

  12/06/2019, T-583/17, [IOS FINANCE \(fig.\) / EOS \(fig.\)](#), EU:T:2019:403, § 32, 48

### LOC – Weak distinctive character of the verbal element

As regards the conceptual comparison, the signs are similar to an average degree since the words 'show' and 'room', present in both signs, have the same meaning. The presence of the numerical and figurative element '86' in the earlier trade mark conveys no specific and distinct concept (§ 67-77).

The BoA concluded, without committing any error of assessment, that there was a LOC despite the weak distinctive character of the verbal element 'showroom' (§ 84-89).

 19/09/2019, T-679/18, [SHOWROOM \(fig.\) / SHOWROOM 86 \(fig.\)](#), EU:T:2019:631, § 67-77, 84-89

### No LOC – Common descriptive element

The mere presence of a descriptive element in both signs does not automatically imply that the signs are visually, phonetically, or conceptually similar (§ 68).

05/03/2020, T-688/18, [CORNEREYE / BACKEYE et al.](#), EU:T:2020:80, § 68

### No LOC – Weak distinctive character of the earlier mark

Where the earlier mark does not have a high degree of distinctiveness, the mere association that the relevant public might make between two trade marks as a result of their analogous semantic content is not in itself a sufficient ground for finding a LOC (§ 46). As the marks are not visually similar, a phonetic comparison between them is irrelevant and, conceptually, they are similar to only a low degree, there is no LOC (§ 46).

 12/12/2019, T-266/19, [\(fig.\) / gastivo \(fig.\) \(II\)](#), EU:T:2019:854, § 46

### LOC – Common elements – Weak distinctive character – Applicability for laudatory elements

Where the elements of similarity between two signs arise from the fact that they share a component which has a weak distinctive character, the impact of such elements of similarity on the global assessment of the LOC is itself low (22/02/2018, T-210/17, TRIPLE TURBO (fig.) / TURBO 2, EU:T:2018:91, § 73 and 20/09/2018, T-266/17, UROAKUT / UroCys (fig.) et al., EU:T:2018:569, § 79) (§ 84).

However, the case-law has so far not been applied in situations where the common element is laudatory in relation to the goods. That case-law cannot apply in all cases and must be read in the light of the circumstances prevailing in each case, in particular where the conflicting signs differ in their most distinctive elements. Even assuming that a significant part of the relevant public would consider that the elements ‘master’ or ‘masters’ of the conflicting signs share the concept of ‘mastery’ or ‘expertise’ and give them a laudatory connotation, the signs differ in terms that are not more distinctive or dominant than the one on which they converge. The reasoning underlying the abovementioned case-law is therefore not applicable (§ 85).



19/06/2019, T-179/16 RENV, [MASTER SMOKY / MASTERS COLORS PARIS \(fig.\)](#), EU:T:2019:433, § 84-85

19/06/2019, T-180/16 RENV, [MASTER SHAPE / MASTERS COLORS PARIS \(fig.\)](#), EU:T:2019:431, § 84-85

19/06/2019, T-181/16 RENV, [MASTER PRECISE / MASTERS COLORS PARIS \(MARQUE FIGURATIVE\)](#), EU:T:2019:429, § § 84-85

19/06/2019, T-182/16 RENV, [MASTER DUO / MASTERS COLORS PARIS \(MARQUE FIGURATIVE\)](#), EU:T:2019:426, § 84-85

19/06/2019, T-183/16 RENV, [MASTER DRAMA / MASTERS COLORS PARIS \(fig.\)](#), EU:T:2019:428, § 84-85

### Overall perception of the relevant public – Elements with weak distinctive character individually – Distinctive character when combined

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



EU:T:2019:518

12/07/2019, T-54/18, [1st AMERICAN \(fig.\) / DEVICE OF A BIRD \(fig.\)](#),

### **Impact of weak elements**

The fact that certain elements of similarity in the signs may be perceived as alluding to the characteristics of the goods in question (and thus as being descriptive or only weakly distinctive) this is not in itself sufficient to rule out LOC between the marks, since they remain visually, aurally and conceptually similar as a whole (§ 90).

*13/05/2020, T-63/19, [ΡΟΪΕΗ \(fig.\) / ΠΟΜΑΪΚΗ \(fig.\)](#), EU:T:2020:195, § 90*

### **Impact of multiple dominant element – Distinctive element – Weak elements – Secondary role in the overall impression**

If a trade mark has multiple dominant elements, some of which are distinctive and others of which are weak, the weak ones can be considered secondary in the overall impression of the sign (§ 81).



*16/06/2021, T-281/19 and T-351/19, [Halloumi χαλλούμι Vermion grill cheese/grill est/grill kase m BELAS PREMIUM GREEK DAIRY SINCE 1927 \(fig.\) / HALLOUMI](#), EU:T:2021:362, § 81*

### **No LOC – Weak earlier mark – Common descriptive element – Low impact of the common element on assessment of LOC**

Where the earlier trade mark and the contested mark coincide in an element that is weakly distinctive with regard to the goods at issue, the global assessment of LOC does not often lead to a finding that such likelihood exists (12/06/2019, C-705/17, Hansson, EU:T:2019:481 and 18/06/2020, C-702/18 P, Primart, EU:T:2020:489) (§ 120).

While the finding of a weak distinctive character does not in itself prevent a finding that there is LOC (27/04/2006, C-235/05, FLEXI AIR / FLEX, EU:C:2006:271, § 42-45), on account, in particular, of a similarity between the signs and between the goods or services covered (08/11/2016, C-43/15, compressor technology (fig.) / KOMPRESSOR et al., EU:C:2016:837, § 63), it appears, however, that where the elements of similarity between two signs are the result of the fact that, like in this case, they have a weakly distinctive component in common, the impact of those elements of similarity on the global assessment of the likelihood of confusion is itself low (§ 123). The common presence of the weakly distinctive and non-dominant element of similarity 'shop' is not decisive and has only a minor impact on the assessment of LOC (§ 124). The more distinctive the earlier mark, the greater will be the LOC, the opposite is also true. With regard to a trade mark with a weak distinctive character, and which thus has a lesser capacity to identify the goods or services for which it has been registered as coming from a particular undertaking, the degree of similarity between the signs should, in principle, be high to justify a LOC, or this would risk granting excessive protection to that trade mark and its proprietor (§ 125).

Having regard to the low visual, average phonetic and conceptual similarity, essentially of low impact between the signs at issue, to the weak distinctive character of the earlier mark and to the relatively high or higher than average level of attention of the relevant public, notwithstanding its imperfect memory and the identity or similarity of the goods and services at issue, no LOC can exist (§ 127).

*12/10/2022, T-222/21, [Shoppi \(fig.\) / Shopify](#), EU:T:2022:633*

### **No LOC – Weak distinctive character of the common element**

The signs at issue coincide only in the word element 'well' that has, for the significant part of the relevant French public which understand basic English, a weak distinctive character in respect of the goods and services related to health. Similarly, for the part of the relevant public which does not understand the meaning of that word, the overall impression created by the signs at issue is markedly different owing to the presence of the element 'monde' in the sign applied for and the repetition of the word 'well' and the word element 'and' in the earlier mark (§ 56). In the light of the visual, phonetic and conceptual differences between the signs at issue, the relevant public, displaying a level of attention varying from above average to high in relation to the goods at issue, is not likely to associate the sign applied for with the earlier sign in such a way that the sign applied for would be perceived as a sub-brand of the earlier mark (§ 58).

[09/11/2022, T-601/21, WELLMONDE / WELL AND WELL, EU:T:2022:68](#)

#### **No LOC – Weak earlier mark – Basic English words**

The relevant public in Spain will understand the words 'new' and 'port' in the earlier mark, which are basic English words known throughout the EU. These words refer to 'port services' as part of the services at issue, at least for a non-negligible part of the relevant public. Therefore, the signs are conceptually different, and the distinctive character of the earlier mark is weak (§ 50, 58). In accordance with the principle of interdependence between the factors to be taken into consideration, there is no LOC (§ 66).

[14/12/2022, T-18/22, NEMPORT LIMAN İŞLETMELERİ \(fig.\) / Newport et al., EU:T:2022:815](#)

#### **No LOC – Weak distinctive character of the common element**

The earlier mark draws its distinctive character principally from the specific combination of the word elements, namely the repetition of the word 'well' with the central element 'and', which does not appear in the mark applied for (§ 55). In the light of the low degree of distinctiveness of the term 'well' for goods and services related to health and well-being and the low degree of inherent distinctiveness of the earlier mark, there is no LOC, even for the part of the relevant French public which understands English and for which there is likely to be a conceptual similarity between the signs. A similarity which relates to elements which have a weak distinctive character can play only a limited role when assessing the LOC (§ 58).



[21/12/2022, T-644/21, WellBe PHARMACEUTICALS \(fig.\) / Well and well, EU:T:2022:847](#)

#### **No LOC – Weak distinctive character of the common element – Overprotection of weak marks contrary to *ratio legis* of trade mark law**

The *ratio legis* of trade mark law is to strike a balance between the interests of the proprietor of a trade mark and the interests of other economic operators (§ 117). Excessive protection of marks consisting of elements which have a very weak distinctive character, by finding a LOC based on the mere coinciding presence of such elements, could therefore adversely affect the attainment of the objectives pursued by trade mark law (§ 118).

Having regard to the weak distinctive character of the common element 'yoga alliance', the presence of visually very different figurative elements enables the relevant public to make a clear distinction between the signs (§ 122).



[18/01/2023, T-443/21, YOGA ALLIANCE INDIA INTERNATIONAL \(fig.\) / yoga ALLIANCE \(fig.\), EU:T:2023:7](#)

### **LOC – Common element not being the most distinctive element**

To find LOC, it is not necessary for the common element of the marks at issue to be more distinctive than the other elements of the mark applied for (§ 40). The fact that the element ‘me’, as the only element of the earlier mark, was fully contained in the mark applied for, with the result that it was sufficiently recognisable within that mark, is a relevant factor for establishing LOC (§ 41).

[01/03/2023, T-25/22, HE&ME \(fig.\) / Me, EU:T:2023:99](#)

### **LOC – Weak distinctive character of the common element – Dominant weak element – Structure of the signs – Similarity of the signs**

The coinciding word element ‘love you’ gives rise to an average degree of similarity between the signs. While the relevant public will attribute to this word element a weak function as an indication of the commercial origin, it is dominant in each of the marks at issue. The marks’ additional word elements ‘since forever’ and ‘so much’ are secondary and both serve to reinforce the coinciding word element ‘love you’. Therefore, the marks have the same structure in their respective first and second parts and give the relevant public an overall impression of similarity (§ 56).

Despite the weak distinctive character of the coinciding elements, the weak inherent distinctiveness of the earlier mark and the high level of attention of the relevant public, there is LOC between the signs on account of the other relevant factors, in particular the identity of the goods at issue, the visually and phonetically dominant character of the coinciding elements of the signs and their overall level of similarity (§ 60).



[22/03/2023, T-306/22, love you so much / I LOVE YOU SINCE FOREVER \(fig.\), EU:T:2023:151](#)

### **No LOC – Non-distinctive character of the common element**

The similarity of the marks created by their prefix ‘bio’ carries very limited weight, if any, in the global assessment. Due to the lack of distinctive character of that prefix it cannot be perceived as an indication of commercial origin. The relevant public’s attention will naturally focus more on the elements which differentiate the signs at issue (i.e. the suffixes ‘plak’ in the earlier mark and ‘lark’ in the mark applied for and on the figurative elements in that mark) (§ 101).

[03/05/2023, T-459/22, BIOLARK \(fig.\) / Bioplak, EU:T:2023:237](#)

### **LOC – Weak distinctive character of the common element**

Despite the weak or descriptive character of the common initial element of the signs for goods and services related to finance, that element brings the signs closer visually, phonetically and conceptually (§ 88).

[03/05/2023, T-7/22, Financery / financify, EU:T:2023:234](#)

### **LOC – Weak distinctive character of the differentiating element**

The earlier mark's verbal element 'golden' is likely to convey a laudatory message in respect of the goods at issue and, therefore, has a low degree of distinctiveness, if any, for the part of the relevant public that will be able to understand its English meaning (§ 32, 42).

[06/06/2023, T-433/22, STORK / GOLDEN STORK et al., EU:T:2023:341](#)

#### **No LOC – Weak distinctive character of the common element**

For a trade mark with a weak distinctive character, which thus has a lesser capacity to identify the goods or services for which it has been registered as coming from a particular undertaking, the degree of similarity between the signs should be high to justify a likelihood of confusion, or this would risk granting excessive protection to that trade mark and its proprietor (§ 69).

Where the elements of similarity between two signs arise from the fact that they share a component that has a weak inherent distinctive character, the impact of these elements of similarity on the global assessment of the likelihood of confusion is itself low (§ 70).



[07/06/2023, T-368/22, Banqui / Bankia \(fig.\) et al., EU:T:2023:309](#)

#### **No LOC – Weak distinctive character of the common element**

The common verbal element 'mood', known to the non-English-speaking part of the relevant public, has a rather weak distinctive character and cannot be regarded as the distinctive element of the marks at issue (§ 57).

Where marks coincide in a weakly distinctive element, this does not often lead to a likelihood of confusion (§ 72). Moreover, the *ratio legis* of trade mark law is to strike a balance between the proprietor of a trade mark and other economic operators, and excessive protection of weak marks could adversely affect the attainment of that objective (§ 73-74). The fact that the only similarity between the composite marks at issue was the weakly distinctive common element 'mood' could be taken into account in the global assessment of LOC (§ 75).

[26/07/2023, T-663/22, radioMOOD In-store radio, made easy \(fig.\) / Mood mix \(fig.\), EU:T:2023:430](#)

[26/07/2023, T-664/22, videoMOOD Digital Signage, made easy \(fig.\) / Mood mix \(fig.\), EU:T:2023:431](#)

#### **No LOC – Weak distinctive character of the common element**

The marks have a low degree of overall similarity because the elements 'végé' and 'vege' are weakly distinctive and therefore only weakly attract the attention of the relevant public (§ 57). Moreover, the English word 'story' may not be understood by part of the non-English speaking part of the public and in any case has an average degree of distinctiveness because the foodstuffs at issue do not function as a medium to reproduce a message or convey a story (§ 40-42).

[26/07/2023, T-434/22, VEGE STORY / végé', EU:T:2023:426](#)

#### **LOC – Weak distinctive character of the common element**

Where the earlier mark and the mark applied for coincide in an element that has a weak distinctive character with regard to the goods and services at issue, the global assessment of the LOC does not often lead to a finding that such likelihood exists. Notwithstanding, in the present case, it follows from all the relevant factors that the finding of LOC was not erroneous. In particular, the visual differences of the signs at issue are not sufficiently striking or of such significance that they enable the relevant public to clearly distinguish the marks at issue (§ 72-74).

### **No LOC – Weak earlier mark – Weak distinctive character of the common element**

Where the earlier trade mark and the mark applied for coincide in an element that has a weak distinctive character with regard to the goods at issue, the global assessment of LOC does not often lead to a finding that such likelihood exists (§ 96). Where the elements of similarity between two signs arise from the fact that they share a component which has a weak inherent distinctive character, the impact of such elements of similarity on the global assessment of the likelihood of confusion is itself low (§ 97).



[13/09/2023, T-328/22, EST. KORRES 1996 HYDRA-BIOME \(fig.\) / Hydrabio et al., EU:T:2023:533](#)

### **Visual similarity – Weak differentiating elements**

The common verbal element 'master', which was correctly classified as weak, leads to a visual similarity between the signs at issue. The differing elements are too weak to differentiate between the signs at issue to such an extent as to entirely exclude a similarity between them. The additional verbal elements 'i' and 'golf', taking account of the weak distinctive character of the first and the descriptiveness of the goods and services of the second, are not more distinctive than the common verbal element 'master'. The figurative element, consisting in a mere circle with a multi-coloured contour, is not capable of distracting attention from the verbal elements (§ 87-92).



[15/11/2023, T-677/22, imaster.golf \(fig.\) / MASTERS et al., EU:T:2023:720](#)

### **LOC – Weak differentiating element**

Insofar as the verbal element 'NORMO' of the contested mark constitutes an anagram of the earlier mark 'NOMOR', where their first two letters coincide and where the verbal element 'CARE' in the contested mark has only a weak distinctive character, the signs are visually similar to an average degree (§ 36).

[15/11/2023, T-19/23, NORMOCARE / NOMOR, EU:T:2023:717](#)

### **No LOC regardless of enhanced distinctive character – Weak distinctive character of the common element**

In the context of the goods and services in relation to sports and fitness and taking into account the international character of sporting activities and competitions, the elements 'cross' and 'fit', and 'crossfit' as a whole have a weak distinctive character since they will be understood throughout the EU as types of sporting disciplines or training programmes (§ 33-34).

For a trade mark with a weak distinctive character, and which thus has a lesser capacity to identify the goods or services for which it has been registered as coming from a particular undertaking, the degree of similarity between the signs should, as a rule, be high to justify LOC, or this would risk granting excessive protection to that trade mark and its proprietor (§ 51).

Even assuming that the earlier marks have an enhanced distinctiveness acquired through use and, therefore, enjoy more extensive protection, there is no LOC. Therefore, even if the BoA had erred in not recognising the enhanced distinctiveness of the earlier marks, that error would not be capable of calling into question the validity of its conclusion regarding the absence of LOC (§ 52). Consequently, it is not necessary to analyse the evidence related to the alleged enhanced distinctiveness of the earlier marks (§ 53).



[29/11/2023, T-506/22, CROSS WOD EQUIPMENT \(fig.\) / Crossfit et al., EU:T:2023:760](#)

### **No LOC – Conceptual identity – Weak distinctive character of the common concept**

Even though the marks at issue are conceptually identical, that can be of only limited importance in the global assessment of LOC, since the concept in common to which those marks refer is only weakly distinctive in relation to the goods at issue and can therefore contribute only to a very limited extent towards the function of a mark, which is to identify the origin of those goods and to distinguish them from those with a different origin. (§ 88)



[20/12/2023, T-564/22, DEVICE OF A LION HEAD \(fig.\) / DEVICE OF A LION HEAD \(fig.\), EU:T:2023:851](#)

### **No LOC – Weak distinctive character of the common element**

Where the earlier trade mark and the sign whose registration is sought coincide in an element that is weakly distinctive with regard to the goods at issue, the global assessment of LOC within the meaning of Article 8(1)(b) EUTMR often does not lead to a finding that such likelihood exists (§ 94).



[20/12/2023, T-736/22, SNACK MI \(fig.\) / SNACK'IN \(fig.\) et al., EU:T:2023:852](#)

### **No LOC – Weak distinctive character of the common element – Weak element 'BIO'**

The relevant Spanish public will recognise the common verbal element 'bio' which, in trade, has acquired a very evocative meaning, generally referring to the idea of respect for the environment, the use of natural materials and even of environmentally friendly manufacturing processes. This verbal element has only a very reduced or no distinctive character in relation to cosmetics and pharmaceuticals (§ 37, 40, 41).

The presence of the common weak element 'bio' reduces the visual and phonetic similarity caused by it (§ 50, 60) and has a low impact on the assessment of LOC (§ 91).

[17/01/2024, T-61/23, BIOPÔLE / AGUA BIOPOLAR et al., EU:T:2024:10](#)

### **LOC – Impact of weak distinctive character of the earlier sign**

The distinctiveness of the earlier sign is only one element amongst many which must be assessed in order to establish whether there is LOC. Even if the earlier sign has limited distinctive character, there could nevertheless be LOC due to the similarity of the signs and of the relevant goods and services (§ 56, 63).

**No LOC – Weak distinctive character of the common element – Limited impact of the conceptual similarity**

Where a conceptual similarity is based on weakly distinctive, or even descriptive, elements, this similarity plays a limited role and has less impact on the assessment of LOC (§ 73).

**PARIS BAR**[13/03/2024, T-117/23, BAR PARIS \(fig.\) / PARIS BAR \(fig.\), EU:T:2024:163](#)**No LOC – Weak distinctive character of the common element – No likelihood of association**

As the relevant public is very likely to perceive the common element 'sano' as descriptive of the goods and services in question, the impact of the similarity resulting from the presence of that common prefix in the marks at issue is low and is therefore not decisive for the global assessment of LOC. The attention of the relevant public will therefore be focused on the differences between these marks (§ 130). A likelihood of association does not exist for the relevant public where a common prefix is descriptive. In the present case, the common component of the two marks at issue, namely the prefix 'sano', is descriptive of the goods and services in question. There is therefore no likelihood of association (§ 136).

**Sanoid**[13/03/2024, T-206/23, Sanoid \(fig.\) / SANODIN, EU:T:2024:164](#)**2.6.7 Impact of enhanced distinctiveness of the earlier mark****LOC – Enhanced distinctiveness of the earlier mark**

Since the more distinctive the earlier mark is, the greater the LOC will be, marks with a high degree of distinctiveness enjoy more extensive protection than those with a lower degree of distinctiveness (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 24; 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 20). Therefore, the enhanced distinctiveness of the earlier mark increases LOC (§ 67).

[15/07/2020, T-371/19, FAKEDUCK \(fig.\) / Save the duck \(fig.\) et al., EU:T:2020:339, § 67](#)**LOC – Common weakly-distinctive element – Enhanced distinctiveness through use of the earlier trade mark**

Although the marks include different terms, 'loft' and 'land' respectively, they are visually and conceptually similar to an average degree and phonetically similar to an above-average degree (§ 69-70, 75-76, 83). The fact that the common word element 'game' of the signs is weakly distinctive will be offset by the enhanced distinctiveness acquired through the use of the earlier mark (§ 83). At least a non-negligible part of the relevant public, made up of average English-speaking consumers, could take the view that the identical and similar services came from the same undertaking or, as the case may be, from economically-linked undertakings (§ 78, 81-85).



02/06/2021, T-17/20, [GAMELAND \(fig.\) / Gameloft](#), EU:T:2021:313, § 78, 81-85

### **Global assessment of LOC – Consideration of the reputation of the earlier mark and not of the contested mark**

Only the reputation of the earlier mark, and not that of the mark applied for, must be taken into account to assess whether the similarity of the goods covered by the two marks is sufficient to give rise to a LOC (03/09/2009, C-498/07 P, La Española, EU:C:2009:503, § 84 and case-law cited). That case-law is in line with the objective of Article 8(1)(b) CTMR (now EUTMR), which is to provide adequate protection for the proprietors of earlier rights against subsequent applications for identical or similar European Union trade marks (29/01/2019, T-336/17, YATEKOMMO / YA TE COMERE EL VACIO QUE TE LLENA (fig.), EU:T:2019:36, § 49) (§ 113).

10/11/2021, T-353/20, [ACM 1899 AC MILAN \(fig.\) / Milan et al.](#), EU:T:2021:773, § 113

### **LOC – Comparison of figurative signs – Enhanced distinctiveness**

In assessing the visual similarity of the conflicting signs according to Article 8(1)(b) EUTMR each of them must be assessed as a whole (§ 41). The BoA did not take account of a non-negligible element in the earlier sign which helps to differentiate the conflicting signs (§ 38-39). Thus it erred in law in finding a high degree of visual similarity between the conflicting signs (§ 43, 98).

The proprietor of a registered trade mark may rely on evidence of use of that mark in another form – in particular, in the form of another registered trade mark – to prove the reputation of that mark, provided the public concerned continues to perceive the goods concerned as originating from the same undertaking. To determine whether that is the case, it must be ascertained whether the elements distinguishing the two marks do not prevent the public concerned from continuing to perceive the relevant goods as originating from a particular undertaking (§ 67).

For the assessment of evidence related to the reputation of the earlier mark, the BoA essentially relied on evidence relating to other signs. It did not examine whether the elements distinguishing the opponent's marks prevented the relevant public from continuing to perceive the goods and services concerned as originating from the opponent (§ 69-71).

Even if the opponent relies on enhanced distinctiveness, the degree of inherent distinctiveness of the earlier mark must be assessed first (§ 101).



30/03/2021, T-206/21, [DARSTELLUNG VON ZWEI TIEREN \(fig.\) - DARSTELLUNG EINES TIERES \(fig.\) et al.](#), EU:T:2022:191

### **Contradictory assessment of the degree of distinctive character of the earlier mark**

The earlier mark's enhanced distinctiveness is one of the relevant factors in assessing the LOC. In particular, marks with a highly distinctive character, inter alia on account of their use, enjoy broader protection than marks with less distinctive character. Consequently, unless it disregards the appropriate level of protection that a mark ought to enjoy, the BoA cannot, after finding that there is a high degree of distinctive character acquired through use, alter the extent of that distinctive character by reducing it from high to normal in the context of its global assessment of LOC (§ 41).

08/02/2023, T-141/22, [SFR SPORT 1 \(fig.\) / sport 1 \(fig.\) et al.](#), EU:T:2023:55

## Impact of enhanced distinctiveness of the earlier mark – Impact limited to goods and services concerned by enhanced distinctiveness

The protection of a mark which has an enhanced level of distinctiveness acquired through use vis-à-vis certain goods and services should not be extended to all the goods and services for which it has been registered. It follows from the distinction between reputation within the meaning of Article 8(5) EUTMR and enhanced distinctiveness in the context of Article 8(1)(b) EUTMR that the distinctive character of a mark, including that acquired through use, must always be assessed in relation to the goods or services concerned (§ 62).

[29/03/2023, T-344/21, +music \(fig.\) / DEVICE OF A WHITE CROSS WITHIN A BLACK SQUARE \(fig.\) et al., EU:T:2023:166](#)

## 2.7 CONCLUSION ON ARTICLE 8(1)(B) EUTMR

### 2.7.1 LOC



**ME<T IN STYLE** 14/02/2019, T-63/18, [TORRO Grande Meat in Style \(fig.\) / TORO et al.](#), EU:T:2019:89

**ARBET** 30/01/2019, T-79/18, [ARBET \(fig.\) / BORBET](#), EU:T:2019:39



29/01/2019, T-336/17, [YATEKOMO / YA TE COMER EL VACIO QUE TE LLENA \(fig.\)](#), EU:T:2019:36

26/03/2019, T-105/18, [LILI LA TIGRESSE / TIGRESS](#), EU:T:2019:194

28/03/2019, T-259/18, [Unifoska / NITROFOSKA et al.](#), EU:T:2019:198

06/03/2019, T-321/18, [NOCUVANT/ NOCUTIL et al.](#), EU:T:2019:139



28/03/2019, T-562/17, [ALBÉA \(fig.\) / Balea](#), EU:T:2019:204



23/05/2019, T-837/17, [SkyPrivate \(fig.\) / SKY et al.](#), EU:T:2019:351



**AUDIMAS** 12/07/2019, T-467/18, [AUDIMAS \(fig.\) / Audi et al.](#), EU:T:2019:513



09/07/2019, T-397/18, [Hugo's Burger Bar \(fig.\) / H'ugo's et al.](#), EU:T:2019:489



13/06/2019, T-357/18, [HOSPITAL DA LUZ \(fig.\) / clínica LA LUZ \(fig.\) et al.](#), EU:T:2019:416



20/09/2019, T-287/18, [Nature's Variety Instinct \(fig.\) / Natural Instinct Dog and Cat food as nature intended \(fig.\) et al.](#), EU:T:2019:641

20/09/2019, T-288/18, [NATURE'S VARIETY INSTINCT / NATURAL INSTINCT Dog and Cat food as nature intended \(fig.\) et al.](#), EU:T:2019:640

**LUMIN8 LUMI**  
Endless possibilities

09/09/2019, T-680/18, [LUMIN8 \(fig.\) / LUMI et al.](#),

EU:T:2019:565



[DeGIUSTI](#) 19/09/2019, T-678/18, [GIUSTI WINE / DG DeGIUSTI \(fig.\) et al.](#), EU:T:2019:616

28/11/2019, T-665/18, [Vibble / Vybe et al.](#), EU:T:2019:825



20/11/2019, T-695/18, [fLORAMED \(fig.\) / MEDIFLOR et al.](#), EU:T:2019:794

19/12/2019, T-28/19, [VERITEA / VERI - AGUA PURA DEL PIRINEO et al.](#), EU:T:2019:870



19/12/2019, T-589/18, [MIM NATURA \(fig.\) / MM et al.](#), EU:T:2019:887

07/02/20, T-214/19, [Fleximed / MediFlex](#), EU:T:2020:40



26/03/2020, T-77/19, [alcar.se \(fig.\) / Alcar](#), EU:T:2020:126



**King**

12/03/2020, T-85/19, [KinGirls \(fig.\) / King et al.](#), EU:T:2020:100



29/01/2020, T-239/19, [ENCANTO \(fig.\) / Belcanto](#), EU:T:2020:12



13/02/2020, T-387/18; [DELTA SPORT \(fig.\) / DELTA \(fig.\) et al.](#);

EU:T:2020:65

27/02/2020, T-202/19, [Caratour / Carado et al.](#), EU:T:2020:75, § 36-37

27/02/2020, T-203/19; [Caratwo / Carado et al.](#), EU:T:2020:76, § 36-37



26/03/2020, T-653/18, [GIORGIO ARMANI le Sac 11 \(fig.\) / LESAC et al.](#), EU:T:2020:121



26/03/2020, T-654/18, [le Sac 11 \(fig.\) / LESAC et al.](#), EU:T:2020:122



29/04/2020, T-106/19, [ABARCA SEGUROS \(fig.\) / Abanca](#), EU:T:2020:158



29/04/2020, T-108/19; [TasteSense By Kerry \(fig.\) / Multisense et al.](#), EU:T:2020:161



29/04/2020, T-109/19; [TasteSense \(fig.\) / Multisense et al.](#), EU:T:2020:162



28/05/2020, T-341/19, [TASER \(fig.\) / Taser et al.](#), EU:T:2020:233



28/05/2020, T-342/19, [TASER \(fig.\) / Taser et al.](#), EU:T:2020:234



13/05/2020, T-76/19, [pontinova \(fig.\) / Ponti et al.](#), EU:T:2020:198

13/05/2020, T-284/19, [Kenwell / Kenwood et al.](#), EU:T:2020:192



28/05/2020, T-333/19, [GN Genetic Nutrition Laboratories \(fig.\) / GNC GENERAL NUTRITION CENTERS et al.](#), EU:T:2020:232



28/05/2020, T-724/18 & T-184/19, [AUREA BIOLABS \(fig.\) / Aurea et al.](#), EU:T:2020:227,

§ 75



16/06/2020, T-558/19, [HOSPITAL DA LUZ LEARNING HEALTH TRAINING, RESEARCH & INNOVATION CENTER \(fig.\) / C LUZCLINICA LA LUZ \(fig.\) et al.](#), EU:T:2020:274, § 18

25/06/2020, T-550/19, [Noster / Foster](#), EU:T:2020:290



10/06/2020, T-646/19, [e \(fig.\) / e \(fig.\)](#), EU:T:2020:253



25/06/2020, T-114/19, [B \(fig.\) / b \(fig.\)](#), EU:T:2020:286



15/07/2020, T-371/19, [FAKEDUCK \(fig.\) / Save the duck \(fig.\) et al.](#),

EU:T:2020:339

16/12/2020, T-859/19, [Alkemie / Alkmene](#), EU:T:2020:615



ALKEMIE

16/12/2020, T-860/19, [ALKEMIE \(fig.\) / Alkmene](#), EU:T:2020:616



02/12/2020, T-639/19, [5MS MMMMM \(fig.\) / 5J \(fig.\)](#), EU:T:2020:581

17/03/2021, T-186/20, [The time / Timehouse](#), EU:T:2021:147

Δ BE EDGY ∇

BERLIN

20/01/2021, T-329/19, [BE EDGY BERLIN \(fig.\) / Edji et al.](#), EU:T:2021:22



24/02/2021, T-61/20, [B-direct / bizdirect \(fig.\)](#), EU:T:2021:101



10/03/2021, T-66/20, [HAUZ LONDON \(fig.\) / Houzz](#), EU:T:2021:125



10/03/2021, T-67/20, [HAUZ NEW YORK \(fig.\) / Houzz](#), EU:T:2021:126



10/03/2021, T-68/20, [HAUZ EST 1929 \(fig.\) / Houzz](#), EU:T:2021:127



20/01/2021, T-811/19, [CABEÇA DE TOIRO \(fig.\) / Sangre de toro](#), EU:T:2021:23

BLEND



VODKA

20/01/2021, T-829/19, [Blend 42 Vodka \(fig.\) / 42 below \(fig.\)](#), EU:T:2021:18

BLEND



VODKA

20/01/2021, T-830/19, [Blend 42 Vodka \(fig.\) / 42 below \(fig.\)](#), EU:T:2021:19



20/01/2021, T-831/19, [Blend 42 First Czech Blended Vodka \(fig.\) / 42 below \(fig.\)](#),  
EU:T:2021:20



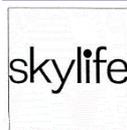
20/01/2021, T-261/19, [OptiMar \(fig.\)](#), EU:T:2021:24  
10/02/2021, T-821/19, [B.home / B-Wohnen](#), EU:T:2021:80



27/01/2021, T-817/19, [Hydrovision \(fig.\) / Hylo vision](#), EU:T:2021:41



28/04/2021, T-310/20, [JUMEX \(fig.\)-Zumex \(fig.\) et al.](#), EU:T:2021:227



27/01/2021, T-382/19, [Skylife \(fig.\) / SKY](#), EU:T:2021:45



28/04/2021, T-615/19, [DEVICE OF STYLISED EXTENDED WINGS \(fig.\)-DEVICE OF STYLISED EXTENDED WINGS \(fig.\)](#), EU:T:2021:224



28/04/2021, T-584/17 RENV, [PRIMART Marek Łukasiewicz \(fig.\) / PRIMA](#),  
EU:T:2021:231

21/05/2021, T-158/20, [Breeze / Breeze](#), EU:T:2021:288



30/06/2021, T-227/20, [BIOVÈNE BARCELONA \(fig.\) / Biorene](#), EU:T:2021:395,  
§ 18, 69, 77, 86, 89

30/06/2021, T-232/20, [Biovène / Biorene](#), EU:T:2021:396, § 18, 69, 77, 86, 89



15/09/2021, T-688/20, [IDENTY BEAUTY \(fig.\) / IDENTITY THE IMAGE CLUB \(fig.\)](#), EU:T:2021:567



10/11/2021, T-73/21, [P.I.C. Co. \(fig.\) / PIK \(fig.\)](#), EU:T:2021:777



10/11/2021, T-532/20, [Redello / CADELLO \(fig.\) et al.](#), EU:T:2021:774

17/11/2021, T-504/20, [Manòu / Manou et al.](#), EU:T:2021:789



21/12/2021, T-549/20, [Superzings / ZING \(fig.\) et al.](#), EU:T:2021:935



21/12/2021, T-571/20, [LUNA SPLENDIDA \(fig.\) / Luna \(fig.\) et al.](#),  
EU:T:2021:956



15/12/2021, T-69/21, [COLLINI \(fig.\) / Pollini et al.](#), EU:T:2021:893



21/12/2021, T-159/21, [motwi \(fig.\) / Monty et al.](#), EU:T:2021:924



19/01/2022, T-99/21, [Heras Bareche \(fig.\) / MAGDALENAS DeLasHeras \(fig.\)](#), EU:T:2022:14



12/01/2022, T-366/20, [DEVICE OF ROUND ELEMENT RESEMBLING A BRUSHSTROKE \(fig.\) / ORIGIUM 1944 \(fig.\)](#), EU:T:2022:4

**IDENTY**  
BEAUTY



15/09/2021, T-688/20, [IDENTY BEAUTY \(fig.\) / IDENTITY THE IMAGE CLUB \(fig.\)](#), EU:T:2021:567



26/01/2022, T-498/20, [WOOD STEP LAMINATE FLOORING \(fig.\) / Step](#), EU:T:2022:26



23/02/2022, T-209/21, [La Hoja del Carrasco \(fig.\) / CG CARRASCO, Guijuelo \(fig.\) et al.](#), EU:T:2022:90



11/02/2022, T-459/21, [Sunwhite \(fig.\) - Sunwhite \(fig.\)](#), EU:T:2022:59  
09/02/2022, T-589/20, [Maimai made in Italy / Yamamay](#), EU:T:2022:59



02/02/2022, T-694/20, [LABELLE VIENNA \(fig.\) / Labello et al.](#), EU:T:2022:45

02/03/2022, T-715/20, [Skinovea / Skinoren et al.](#), EU:T:2022:101, § 21-23, 65, 79, 85, 91, 97-98

02/03/2022, T-171/21, [FOR HONOR \(fig.\) / Honor et al.](#), EU:T:2022:104, § 76, 109-111, 116

30/03/2022, T-451/21, [Testa Rossa / TESTA ROSSA \(fig.\)](#), EU:T:2022:172, § 46, 47, 56, 57

02/03/2022, T-149/21, [Vitadha/ Vitanadh et al.](#), EU:T:2022:103, § 77-93, 107-112

 06/04/2022, T-276/21, [moio.care \(fig.\) / Molicare et al.](#), EU:T:2022:221, § 28, 29, 31-34, 68



G CORELABS

**CORE**<sup>®</sup>

28/09/2022, T-454/21, [G CORELABS \(fig.\) / CORE \(fig.\) et al.](#), EU:T:2022:591



29/11/2023, T-661/22, [Claro \(fig.\) / CLARANET et al.](#), EU:T:2023:762

## 2.7.2 No LOC

**Dienne ENNE**

27/02/2019, T-107/18, [Dienne \(fig.\) / ENNE \(fig.\)](#), EU:T:2019:114



07/03/2019, T-106/18, [VERA GREEN / Lavera et al.](#), EU:T:2019:143

 19/03/2019, T-133/18, [Lumiqs \(fig.\) / Lumix et al.](#), EU:T:2019:169



20/09/2019, T-67/19, [Dokio / <IO \(fig.\)](#), EU:T:2019:648

17/09/2019, T-502/18, [MediWell \(fig.\) / Well and well et al.](#), EU:T:2019:614



11/04/2019, T-403/18, [W S WELLPHARMA SHOP \(fig.\) / WELL AND WELL](#), EU:T:2019:248



19/06/2019, T-28/18, [AC MILAN \(fig.\) / AC et al.](#), EU:T:2019:436



19/12/2019, T-40/19, [THE ONLY ONE by alphaspirit wild and perfect \(fig.\) / ONE](#), EU:T:2019:890



12/12/2019, T-266/19; [\(fig.\) / gastivo \(fig.\) \(II\)](#), EU:T:2019:854



12/12/2019, T-267/19; [\(fig.\) / gastivo \(fig.\) \(I\)](#), EU:T:2019:852



19/12/2019, T-743/18, [I.J. TOBACCO INDUSTRY \(fig.\) / JTi \(fig.\)](#), EU:T:2019:872



05/12/2019, T-29/19, [Idealogistic Verhoeven Greatest care in getting it there \(fig.\) / iDÉA \(fig.\) et al.](#), EU:T:2019:841



05/02/2019, T-44/19; [TC Touring Club \(fig.\) / TOURING CLUB ITALIANO et al.](#), EU:T:2020:31

26/03/2020, T-343/19, [Sonance / Conlance](#), EU:T:2020:124



30/01/2020, T-559/19, [DEVICE OF A WHITE DECIDUOUS TREE AGAINST A BLUE BACKGROUND \(fig.\) / DEVICE OF A FIR TREE SILHOUETTE ON A BASE \(fig.\) et al.](#), EU:T:2020:19

05/03/2020, T-688/18, [CORNEREYE / BACKEYE et al.](#), EU:T:2020:80



28/05/2020, T-696/18, [AIREASANO BLACK El ibérico de Teruel \(fig.\) / JAMON DE TERUEL CONSEJO REGULADOR DE LA DENOMINACION DE ORIGEN \(fig.\)](#), EU:T:2020:219



EU:T:2020:312

08/07/2020, T-633/19, [\(fig.\) / TOTTO \(fig.\)](#),



EU:T:2021:81

21/02/2021, T-117/20, [PANTHÉ \(fig.\) / P PANTHER \(fig.\) et al.](#),



28/04/2021, T-284/20, [Harley Benton \(fig.\)-HB et al.](#), EU:T:2021:218



(fig.) / [APODISCOUNTER et al.](#), EU:T:2021:25

20/01/2020, T-844/19, [discount apotheke.de](#)



05/05/2021, T-286/20, [Gobi-COBI \(fig.\)](#), EU:T:2021:239



19/05/2021, T-324/20, [kugoo \(fig.\) / Kuga et al.](#), EU:T:2021:280



13/10/2021, T-591/20, [UNI-MAX \(fig.\) / uni \(fig.\) et al.](#), EU:T:2021:694



06/10/2021, T-505/20, [sandriver \(fig.\) / SAND et al.](#), EU:T:2021:655



20/10/2021, T-596/20, [DORMILLO \(fig.\) / DORMILON El placer de dormir \(fig.\) et al.](#), EU:T:2021:721



20/10/2021, T-597/20, [Dormillo / DORMILON El placer de dormir \(fig.\) et al.](#), EU:T:2021:722



like nature

20/10/2021, T-352/20, [Strong like nature \(fig.\) / STRONG NATURE](#), EU:T:2021:720



20/10/2021, T-559/20, [PINAR Süzme Peynir \(fig.\) / Süzme Peynir \(fig.\)](#), EU:T:2021:713



20/10/2021, T-560/20, [PINAR Tam kıvamında Süzme Peynir Yumusacık ve Leziz \(fig.\) / Süzme Peynir \(fig.\)](#), EU:T:2021:714

20/10/2021, T-112/20, [Televend / Televes et al.](#), EU:T:2021:710

23/03/2022, T-465/21, [Aion / Ionfarma et al.](#), EU:T:2022:153, § 35, 41, 47

02/03/2022, T-333/20, [lalo tsp / Hyalo](#), EU:T:2022:113, § 62, 106

16/03/2022, T-315/21, [Apial / Apiretal](#), EU:T:2022:141, § 27-29, 31-32, 33-35, 43

### 3 ARTICLE 8(2)(c) EUTMR – EARLIER WELL-KNOWN MARKS

#### Invalidity proceedings – Well-known trade mark within the meaning of Article 6bis of the Paris Convention

The invalidity applicant had demonstrated to the requisite legal standard that the earlier word mark and the earlier figurative mark were well known in Bulgaria in the sense of Article 6bis of the Paris Convention for the goods in Classes 29 and 32 (§ 95).

10/06/2020, T-717/18, [Philibon / PHILICON \(fig.\) et al](#), EU:T:2020:256, § 95

10/06/2020, T-718/18, [PHILIBON DEPUIS 1957 www.philibon.com / PHILICON \(fig.\) et al](#), EU:T:2020:257, § 94

#### Opposition proceedings – Competence of the BoA – Well-known trade mark within the meaning of Article 6bis of the Paris Convention

In opposition proceedings, the existence of relative grounds for refusal within the meaning of Article 8 CTMR [now EUTMR] presupposes that the mark on which the opposition is based exists and pre-dates the mark applied for. These are factors that must therefore be examined by the Office of its own motion and cannot be left to the free assessment of the parties (25/06/2015, T-186/12, LUCEA LED / LUCEO, EU:T:2015:436, § 39) (§ 57).

Pursuant to Article 19(2) CTMIR [now Article 7(2) EUTMDR] the opposing party must file proof of the existence, validity and scope of protection of his earlier mark, as well as evidence proving his entitlement to file the opposition. If the opposition is based on a well-known mark, the opponent must submit evidence showing that this mark is well-known in the relevant territory (Article 19(2)(b) CTMIR [now Article 7(2)(b) EUTMDR]) (§ 60).

Accordingly, the well-known character of the earlier mark constitutes a point of law necessary to ensure the correct application of the trade mark regulation and the BoA is entitled to examine the evidence proving its existence of its own motion (§ 61).

The public's degree of knowledge of a well-known mark is higher than for a mark that has a reputation, with the result that the standard of proof required to establish that a mark is 'well known' for the purposes of Article 6bis of the Paris Convention is higher than that applicable to marks that have a reputation within the meaning of Article 8(5) CTMR (03/05/2018, T-2/17, MASSI / MASI et al., EU:T:2018:243, § 75) (§ 80).



14/07/2021, T-197/20, [QUILAPAYUN \(fig.\) / QUILAPAYUN \(fig.\) et al.](#), EU:T:2021:429, § 57, 60-61, 80

### 4 ARTICLE 8(3) EUTMR, ARTICLE 60(1)(b) EUTMR – TRADE MARK FILED BY AGENT

#### Pre-contractual negotiations – 'Agent-principal' relationship

Article 8(3) EUTMR requires an agreement of commercial cooperation between the parties of a kind that gives rise to a fiduciary relationship by imposing on the trade mark applicant, whether expressly or implicitly, a general duty of trust and loyalty as regards the interests of the trade mark proprietor. Article 8(3) EUTMR can apply to agreements that have expired before the date of filing of the EUTM application, provided that the duty of trust and confidentiality still existed on the filing date (§ 35). After five years, it cannot be assumed that post-contractual obligations still exist. The mere existence of pre-contractual negotiations concerning commercial cooperation does not justify the application of Article 8(3) EUTMR (§ 36). An 'agent-principal' relationship between the

EUTM proprietor and the invalidity applicant cannot be based on the fact that their directors were acquainted with each other in the context of a professional relationship which, itself, cannot be characterised as an ‘agent-principal’ relationship and which, moreover, involves different companies, marks and times (§ 37).

14/02/2019, T-796/17, [MOULDPRO](#), EU:T:2019:88, § 35-37

### **Scope of application of Article 8(3) EUTMR – Identity or similarity of the signs – Similarity of the goods and services**

Article 8(3) CTMR applies to applications for registration by the agent or representative of the proprietor of the earlier mark, both where the mark applied for is identical to that earlier mark and where it is similar to it (§ 54-74, 91). For the purposes of applying Article 8(3) CTMR, similarity between the marks is not determined on the basis of the existence of a LOC (§ 92).

The application of Article 8(3) CTMR is not precluded where the goods or services covered by the mark applied for and those covered by the earlier mark are similar, and not identical (§ 99).

11/11/2020, C-809/18 P, [MINERAL MAGIC / MAGIC MINERALS BY JEROME ALEXANDER et al.](#), EU:C:2020:902, § 92, 99

### **Scope of application of Article 8(3) CTMR [now EUTMR] – Broad interpretation of the term ‘trade marks’**

Effective protection of the legitimate interests of the real proprietor pursuant to Article 8(3) requires interpreting broadly the term ‘**trade marks**’, which therefore includes pending applications, non-registered marks or well-known marks within the meaning of Article 6bis of the Paris Convention (§ 38). Consequently, the applicant’s contention that the earlier mark was also well-known does not constitute a new ground for invalidity based on Article 3(1)(a) CTMR [now EUTMR] (§ 63)

08/09/2021, T-84/20, [Eductor / Eductor](#), EU:T:2021:555, § 38, 68

08/09/2021, T-85/20, [Eductor / Eductor](#), EU:T:2021:556, § 38, 68

08/09/2021, T-86/20, [Scio / Scio](#), EU:T:2021:557, § 38, 68

### **Scope of application of Article 8(3) EUTMR – Proprietorship of a trade mark**

The concept of ‘trade mark’ within the meaning of Article 8(3) EUTMR covers, in addition to registered trade marks, non-registered trade marks, but only to the extent that the law of the country of origin acknowledges rights of that type (§ 42). Regarding the origin of the earlier mark, since the wording of Article 8(3) CTMR [now EUTMR] does not contain any reference to a ‘territory’ concerned, unlike Article 8(1)(b) CTMR [now EUTMR], it is irrelevant whether or not the rights relating to the earlier mark apply in the EU (§ 43). Article 8(3) EUTMR is intended to implement Article 6 *septies* of the Paris Convention and the term ‘proprietor’ must be interpreted accordingly, which means that the proprietor of an earlier mark in any Contracting State to the Paris Convention may rely on Article 8(3) EUTMR if their agent or representative applies for registration of the mark in the EU without their consent (§ 45-46).

[28/06/2023, T-145/22, GRASS IN BOTTLE \(other\) / Bottle with strand of grass \(3D\) et al.](#), EU:T:2023:365

### **Scope of application of Article 8(3) EUTMR – ‘Agent-principal’ relationship – Requirement for a direct contractual agreement**

The concepts of ‘agent’ and ‘representative’ must be interpreted broadly, in such a way as to cover all forms of relationships based on a contractual agreement under which one of the parties

represents the interests of the other, regardless of how the contractual relationship between the proprietor or principal, on the one hand, and the EUTM applicant, on the other hand, is legally categorised. It is therefore sufficient, for the purposes of the application of that provision, that there is some agreement of commercial cooperation between the parties of a kind that gives rise to a ‘fiduciary’ relationship, by imposing on the trade mark applicant, whether expressly or implicitly, a general duty of trust and loyalty as regards the interests of the proprietor of the earlier mark. Nevertheless, some kind of contractual agreement, whether written or not, of commercial cooperation must exist between the parties. The contractual agency or representation agreement must be entered into directly by the parties, and not through third parties. The fact that an ‘implicit’ relationship may suffice for the application of Article 8(3) EUTMR means only that the decisive criterion is the existence and nature of a contractual agreement of commercial cooperation established in substance, and not its formal classification (§ 51-53). The protection conferred by that provision subsists even after the cessation of the contractual relationship from which an obligation of trust derives, provided that sufficient time has elapsed for there to be good reason to assume that the obligation of trust and confidentiality still existed at the time of filing of the trade mark application (§ 54).

[28/06/2023, T-145/22, GRASS IN BOTTLE \(other\) / Bottle with strand of grass \(3D\) et al., EU:T:2023:365](#)

#### **Trade mark filed by agent – Burden of proof**

The opponent is free, in principle, to choose the form of evidence that it considers useful to submit to the EUIPO in opposition proceedings based on an earlier right. However, the existence of a contractual relationship cannot be proved by means of probabilities or presumptions, but must be demonstrated by solid and objective evidence (§ 53). The burden of proof regarding the existence of a contractual agency or representation relationship lies with the opponent, namely the proprietor of the earlier mark (§ 55).

[28/06/2023, T-145/22, GRASS IN BOTTLE \(other\) / Bottle with strand of grass \(3D\) et al., EU:T:2023:365](#)

## **5 ARTICLE 8(4) EUTMR, ARTICLE 60(1)(c) EUTMR – NON-REGISTERED MARKS / OTHER SIGNS USED IN THE COURSE OF TRADE**

### **5.1 PROOF OF THE APPLICABLE LAW GOVERNING THE SIGN**

#### **5.1.1 The burden of proof**

**Company name – Sign of mere local significance – Coexistence of trade marks – Right to prohibit use – Scope of examination – Exhaustive examination under national law – Burden of proof for ‘substantive exceptions’ – Suspension of the proceedings**

The GC confirms that the scope of examination that the Office is required to carry out, due to the full reference to Article 8(4) EUTMR and the law of the Member State governing the sign, includes all the conditions which, according to the law concerned, determine whether ‘this sign gives its proprietor the right to prohibit the use of a more recent trade mark’ (24/10/2018, T-435/12, 42 BELOW (fig.) / VODKA 42 (fig.), EU:T:2018:715, § 45) (§ 53, 66). It clarifies that the examination under national law must be exhaustive and must also include the substantive exceptions which, under national law, allow excluding the right to prohibit use (§ 69).

However, regarding the burden of proof, the GC recalls the case-law on the opponent/invalidity applicant’s duty to establish existence of the right to prohibit use (the legislation and its

interpretation by the competent national courts) (§ 72, 77, 78, 80). That duty exists regardless of the Office's duty to check the correctness of the 'legal facts', if needs be, *ex officio* (§ 73-76, 79). The GC confirms that this duty also applies to the 'substantive exceptions' (§ 80, 82, 83) and that the burden of proof in this regard is on the EUTM applicant/owner: the existence of the national right is a matter of fact (07/05/2013, T-579/10, makro, EU:T:2013:232, § 62 (§ 80) and each party has to establish the rights upon which it relies (24/10/2018, T-435/12, 42 BELOW (fig.) / VODKA 42 (fig.), EU:T:2018:715, § 83, 92) (§ 82, 83).

The BoA did not commit a manifest error of assessment or misuse of powers in rejecting the request for suspension of the appeal proceedings (§ 134). Taking into account the case-law in the pilot proceedings before the GC and the CJ and also the case-law in the parallel cases before the German courts (Oberlandesgericht Düsseldorf and the Bundesgerichtshof), the BoA did not err in finding that the applicant had not proved that the demarcation agreement conferred on it the right to have EU trade marks registered (§ 131, 132). It was therefore possible to conclude the *prima facie* analysis of the likelihood of success of the counterclaim for a declaratory judgment by asserting that this likelihood had not been established (§ 133).

13/05/2020, T-443/18, [Vogue Peek & Cloppenburg / Peek & Cloppenburg](#), EU:T:2020:184, § 53, 66, 69, 72, 77-78, 80, 82-83, 117-120

13/05/2020, T-444/18, [Peek & Cloppenburg](#), EU:T:2020:185, § 53, 66, 69, 76-79, 82-83, 85-86, 124-127

13/05/2020, T-445/18, [Peek & Cloppenburg / Peek & Cloppenburg](#), EU:T:2020:186, § 53, 66, 69, 75-80, 82-83, 85-86, 120-123

13/05/2020, T-446/18, [Peek & Cloppenburg / Peek & Cloppenburg](#), EU:T:2020:187, § 55, 68, 71, 77, 82-83, 85, 78-81, 84, 87-88, 122-125

13/05/2020, T-534/18, [Peek / Peek & Cloppenburg](#), EU:T:2020:188, § 53, 85, 88, 67-70, 73-74, 94-95, 129-131

13/05/2020, T-535/18 [Peek's / Peek & Cloppenburg](#), EU:T:2020:189, § 53, 68-71, 74-75, 87, 96-97, 131-134

### **Scope of examination – Burden of proof for providing information about national law – Examination of facts *ex officio***

The opposition is based on an earlier right within the meaning of Article 8(4) EUTMR, invoked pursuant to the law of a Member State. However, according to Article 7(2)(d) EUTMDR, the opponent must provide a clear identification of the content of the national law relied on by adducing publications of the relevant provisions or case-law (§ 80). To that end, a mere reference in a footnote to the case-law on which the applicant intends to rely, does not suffice to fulfil the obligations arising from Article 7(2)(d) EUTMDR (§ 81).

The Office is not required to supplement the missing information on national law on its own motion, because its power of verification can be exercised only where the Office already has information relating to national law, either in the form of claims as to its meaning, or in the form of evidence submitted and whose probative value has been adduced (20/03/2013, T-571/11, Club Gourmet, EU:T:2013:145, § 41), which is not the case here (§ 83).

02/12/2020, T-35/20, [DEVICE OF CLAW-LIKE SCRATCH \(fig.\) / DEVICE OF CLAW-LIKE SCRATCH \(fig.\) et al](#), EU:T:2020:579, § 81-83

### **Burden of proof for providing information about national law**

Apart from the fact that the opponent did not submit the wording of § 5 German Trade Mark Law, it did not provide any further details as to its content, nor as to the precise nature of the basis of the claim or earlier right which it wished to rely on, or as to the grounds which would have entitled it to prohibit the use of the mark applied for, whereas, according to the BoA, § 5 German Trade Mark Law governs four different types of earlier right (§ 63).

06/04/2022, T-118/21, [Halix records / HALIX RECORDS Edition of CILEM RECORDS INTERNATIONAL et al.](#), EU:T:2022:214, § 63

### **Burden of proof for providing information about national law – Wrong provision invoked – No duty to obtain information *ex officio***

Pursuant to Article 16(1)(b) and Article 7(2)(d) EUTMDR, the burden to prove the content of the national law is on the party invoking Article 8(4) EUTMR (§ 29). The EUIPO's obligation to obtain of its own motion information about the national law only applies if it already has information on the national law, either in the form of claims as to its content, or in the form of evidence submitted, and whose probative value has been adduced (§ 57). Merely invoking one provision of the national law does not trigger an obligation to investigate the entire content of the national law, including not explicitly invoked provisions of that law (§ 51-53, 58).

[01/03/2023, T-36/22, PERFECT FARMA CERVIRON \(fig.\) / Cerviron, EU:T:2023:94](#)

See also, [01/03/2023, T-37/22, Cerviron / Cerviron, EU:T:2023:95](#), § 26, 48-50, 54-55

See also, [01/03/2023, T-38/22, CERVIRON perfect care \(fig.\) / Cerviron, EU:T:2023:96](#), § 26, 48-50, 54-55

### **Burden of proof of the content of national law**

It does not follow from Article 95(1) EUTMR that the EUIPO must treat as proven the circumstances relied on by one party to the proceedings to which the other party has not objected. This provision binds the EUIPO only with regard to the facts, evidence and arguments on which it bases its decision (§ 25).

The conditions of application of a relative ground for refusal or any other provision relied on by the parties in support of their claims are, by their very nature, part of the points of law subject to examination by the EUIPO. The EUIPO may be obliged to rule on a point of law, even though it has not been raised by the parties, if a correct application of the EUTMR in the light of the parties' submissions or requests so requires (§ 26).

Moreover, since decisions of the competent bodies of the EUIPO may have the effect of depriving the trade mark proprietor of a right granted to him, the scope of such a decision necessarily implies that the body that adopts it is not confined to the role of merely confirming the national law as represented by the person seeking a declaration of invalidity (§ 64).

[12/07/2023, T-694/21, Atmos / Atmos, EU:T:2023:395](#)

### **Article 8(4) EUTMR – Cumulative conditions**

Pursuant to Article 8(4) EUTMR, first, the sign must be used in the course of trade; second, it must be of more than mere local significance; third, the sign must have been acquired under EU law or the law of the Member State in which the sign was used before the date of application for the EU trade mark; and fourth, the sign must confer on its proprietor the right to prohibit the use of a later trade mark. These four conditions of Article 8(4) EUTMR must be met cumulatively. Insofar as the BoA found that two conditions were not met and the opponent's action before the GC relates to only one condition, that action cannot succeed (§ 20, 21, 27).

[11/12/2023, T-753/22, Gartenlux / GARTENLUX et al.](#)

See also, [11/12/2023, T-754/22, GARTENLUX / GARTENLUX et al.](#), § 21, 22, 28

## 5.1.2 Means of evidence and standard of proof

### 5.1.2.1 National law

#### **Proof of the content of national law – Submission of legislation and earlier BoA decision**

The opponent discharged its burden of proof under Article 7(2)(d) EUTMDR, since it set out, during the administrative procedure before EUIPO, the content of the relevant German legislation by providing publications of that content. In that regard, although that national legislation does not specify the requirements relating to the assessment of the proximity of the economic sectors, the opponent referred, inter alia, to an earlier BoA decision, which contained information on those requirements by reference to legal literature (§ 82).

[21/12/2022, T-129/22, BIMBA TOYS \(fig.\) / Simba \(fig.\) et al., EU:T:2022:845](#)

#### **No proof of the content of national law – Submission of legislation**

The provisions of national law submitted by the party invoking Article 8(4) EUTMR must, in accordance with that Article and Article 7(2)(d) EUTMDR, clearly specify the conditions to be met to prohibit the use of a subsequent trade mark (§ 34).

Where the provision of the national legislation merely corresponds to the content of Article 8(4) EUTMR, it is not possible to deduce from it the conditions governing the acquisition and scope of protection of the earlier right invoked, in particular as regards the possibility of prohibiting the use of a subsequent trade mark (§ 35).

[08/06/2023, T-568/22, Exane / Exante](#)

### 5.1.2.2 European Union law

[No key points available yet.]

## 5.2 ENTITLEMENT: DIRECT RIGHT CONFERRED ON THE OPPONENT / INVALIDITY APPLICANT

#### **No right to prohibit use of the contested mark – German law – No proximity of the economic sectors**

Within the meaning of German law, the proximity of the relevant economic sectors, which is the first factor for assessing LOC, is established if the spheres of activity, despite the fact that they are distant, are objectively linked, so that, despite the difference between the goods covered by the signs at issue, consumers may consider that those goods, which have a similar designation, come from commercially linked undertakings (§ 85). It is to the opponent to demonstrate that there is proximity or identity of the economic sectors for which the signs are used (§ 94).

[21/12/2022, T-129/22, BIMBA TOYS \(fig.\) / Simba \(fig.\) et al., EU:T:2022:845](#)

## 5.3 TYPES OF RIGHTS FALLING UNDER ARTICLE 8(4) EUTMR

### 5.3.1 Non-registered trade marks

[No key points available yet.]

## 5.3.2 Other signs used in the course of trade

### 5.3.2.1 Trade names

[No key points available yet.]

### 5.3.2.2 Corporate names

#### **Company name – Use by another undertaking – Examination of economic link**

The existence of an economic link does not presuppose a particular order between the undertakings concerned. On the contrary, it may be sufficient in that regard that there is a single point of control within a group of operators in respect of the goods manufactured by one of them and distributed by another, thus ruling out any LOC as to the commercial origin of those goods (§ 36)

Furthermore, the methodological approach adopted by the GC (§ 29-30) complies with the requirement that the examination of whether an economic link exists must be conducted globally, taking into account all the relevant circumstances (20/12/2017, C-291/16, Schweppes S.A., EU:C:2017:990, § 51) (§ 37).

23/04/2020, C-736/18 P, [GUGLER \(fig.\) / GUGLER FRANCE](#), EU:C:2020:308, § 37-38

#### **Sign used in the course of trade – Company name**

As grounds of its application for a declaration of invalidity, the plaintiff referred to the companies 'DORIT Fleischereimaschinen GmbH' and 'DORIT-DFT Fleischereimaschinen GmbH', both registered in Germany. The cancellation applicant did not claim any other sign than these two companies. Consequently, the applicant cannot successfully rely on the company sign 'DORIT' and thus on the fact that the earlier right to this company sign and its use continued to exist after the change of the company name as a result of the merger that took place in 2009 (§ 43).

The cancellation applicant claimed the use of the earlier company name 'DORIT Fleischereimaschinen GmbH' for the manufacture and sale of butchery machines as well as the development and manufacture of all kinds of related equipment and apparatus and the trade therein but the documents provided are insufficient to prove it (§ 67, 69). This consideration is not called into question by the cancellation applicant's argument that use must be assumed at least for machine parts, spare parts and maintenance of meat processing machinery. The cancellation applicant did not expressly claim the use of its sign for such goods and services. It is not clear from the description of the goods and services of the earlier sign as relied on by the applicant that it also covers 'machine parts, spare parts and maintenance of meat processing machinery'. The terms 'equipment' or 'related apparatus' cannot be readily understood as referring to machine or spare parts. (§ 70, 71).

06/04/2022, T-208/21, [DORIT](#), EU:T:2022:228, § 43, 67, 69, 70, 71

#### **Use in relation to goods and services – Use of a company, trade or shop name**

Where the use of a company name, trade name or shop name is limited to identifying a company or designating a business that is being run, this use cannot be regarded as being 'in relation to goods or services'. However, the sign that constitutes the company name could be used in such a manner that a link is established between the sign and the goods marketed or the services provided. To the extent that that condition is satisfied, the fact that a verbal element is used as the company's trade name does not preclude its use as a mark and fulfilment of its essential

function to designate goods or services or its use as a sign conferring on its proprietor the right to prohibit the use of a mark, within the meaning of Article 8(4) EUTMR (§ 54).

[26/07/2023, T-67/22, XTRADE \(fig.\) / X-trade brokers \(trade name\), EU:T:2023:436](#)

### 5.3.2.3 Domain names

[No key points available yet.]

### 5.3.2.4 Copyright

[No key points available yet.]

## 5.4 USE REQUIREMENTS

### 5.4.1 National standard

#### Action for passing off – Goodwill

Genuine trading activities, which result in acquiring reputation and gaining customers, are usually sufficient to establish goodwill (§ 58).

From national case-law, the claimant in an action for passing off is not required to demonstrate that it is the sole owner of the goodwill. In certain circumstances, the goodwill may be shared by multiple entities such as unincorporated business associations (§ 69).

The defendant of an action for passing off can furnish proof of use of the mark on the basis of its own goodwill acquired independently of the applicant, by an honest concurrent use of that mark (§ 79).

[17/01/2019, T-671/17, TURBO-K / TURBO-K \(fig.\), EU:T:2019:13, § 58, 69, 79](#)

#### Action for passing off – Goodwill

According to Section 5(4) of the United Kingdom Law on Trade Marks, the party invoking that provision must establish that three conditions are satisfied: first, the goodwill acquired by the sign at issue; second, misrepresentation by the proprietor of the subsequent mark; and, third, damage caused to that goodwill (06/12/2018, T-459/17, THE COMMODORES / Commodores et al., EU:T:2018:886, § 32) (§ 102).

Misrepresentation by a defendant in an action for passing off, whether or not it is intentional, is a representation which is likely to lead the claimant's customers to attribute the commercial origin of the goods and services offered by the defendant to it (§ 103).

In view of the different endings of the words 'aquaprint' and 'aquacem' and the weak distinctive character of the common element 'aqua', the existence of misrepresentation in this case is excluded, since the offer of the goods in the UK under the trade mark applied for, AQUAPRINT, is not likely to lead the public to attribute the commercial origin of these goods to the applicant, which markets its goods under the signs AQUACEM and AQUASIL (§ 107-108).

[23/05/2019, T-312/18, AQUAPRINT / AQUACEM et al., EU:T:2019:358, § 102-103, 107-108](#)

#### Action for passing off – Goodwill – Misrepresentation

Goodwill is normally proved by evidence of, inter alia, trading activities, advertising, and customers' accounts. Genuine trading activities, which result in acquiring reputation and gaining customers, are usually sufficient to establish goodwill (18/07/2017, T-45/16, Byron (fig.) / BYRON, EU:T:2017:518, § 49 and the case-law cited) (§ 94). The mere fact that the business of the claimant seeking to maintain an action for passing-off is very small does not of itself prevent it having goodwill since a very slight trading activity has been held to be sufficient to create goodwill (§ 95).

According to section 5(4) of the UK Trade Marks Act, as interpreted by the national courts (decision of the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc.* [1990] R.P.C. 341, 406 HL ('the Reckitt decision')), the opponent must establish, in accordance with the legal rules governing actions for passing-off, as laid down by the law of the United Kingdom, that three conditions are satisfied: namely, first, the goodwill acquired by the non-registered trade mark or the sign, second, misrepresentation by the proprietor of the subsequent mark and, third, damage caused to that goodwill (18/07/2017, T-45/16, Byron (fig.) / BYRON, EU:T:2017:518, § 43 and the case-law cited) (§ 81).

According to the national case-law (the Reckitt decision), misrepresentation must be proved by taking into account the customer base which is interested in the services provided both by the claimant in an action for passing-off and those of the defendant (11/06/2009, T-114/07 & T-115/07, Last Minute Tour, EU:T:2009:196, § 60, 92) (§ 122-124).

16/12/2019, T-535/19, [JCE HOTTINGER-HOTTINGER](#), EU:T:2020:614, § 81, 95, 122-124

## 5.4.2 European standard – Use in the course of trade of more than mere local significance

### 5.4.2.1 Use in the course of trade

#### Use in the course of trade – Evidence of use – Relevant date

In the context of Article 8(4) EUTMR, it is necessary to apply to the requirement for use in the course of trade of the sign other than a mark relied on in opposition the same temporal condition as that expressly laid down in Article 8(4)(a) EUTMR with regard to acquisition of the right to the sign, that is to say, that of the date of application for registration of the EU trade mark or, where applicable, the date of the priority claimed for the application for registration of the EU trade mark (§ 30).

In principle, in order to establish use of the earlier sign in the course of trade, within the meaning of Article 8(4) EUTMR, account must be taken of the evidence submitted by the opponent relating to the period prior to the relevant date (§ 44). It follows, a contrario, that the evidence concerning facts relating to the period after the relevant date are irrelevant for the examination of the condition of use of the earlier sign in the course of trade (§ 45). Exceptionally, the evidence concerning facts relating to the period after the relevant date could be taken into account to corroborate evidence predating the relevant date, in particular because of the proximity in time between the promotional activities and the sales (§ 46).

[28/06/2023, T-452/22, Hofmag / Hofmag, EU:T:2023:362](#)

#### Use in the course of trade – Characteristics of the relevant market – Burden of proof

Pursuant to Article 95(1) EUTMR, in proceedings relating to relative grounds for refusal, it is for the parties to prove the characteristics of a relevant market, such as its narrowness (§ 34). It is not for EUIPO to speculate about the characteristics of a relevant market in the absence of evidence submitted in that regard (§ 39).

[28/06/2023, T-452/22, Hofmag / Hofmag, EU:T:2023:362](#)

### **Use in the course of trade – Evidence of use – Lack of probative value of the opponent’s extrapolation calculations**

The use of an earlier sign cannot be proved by means of probabilities or suppositions but must be demonstrated by solid and objective evidence of actual and sufficient use of the sign. The opponent’s calculations based on extrapolation of its own sales to calculate hypothetical annual sales cannot be regarded as probative. That is particularly so, since there is no information from which it is possible to measure or assess what those estimates represent in relation to the market in question at the relevant date (§ 49-50).

[28/06/2023, T-452/22, Hofmag / Hofmag, EU:T:2023:362](#)

### **Use in the course of trade – Quantitative threshold for assessing the actual sales**

Regarding the opponent’s actual sales, since it is not possible to rely on evidence proving that those sales are sufficient because of the characteristics specific to the market in question, the 31 sales of the device during the last 4 months of the relevant year and the first 3 months of the subsequent year cannot be considered to be quantitatively sufficient to prove that (i) the earlier sign was used in the course of trade and (ii) such use was of more than mere local significance (§ 51).

[28/06/2023, T-452/22, Hofmag / Hofmag, EU:T:2023:362](#)

#### **5.4.2.2 Use of more than mere local significance**

##### **Undated documents – Annual financial statements**

Undated documents may, in certain cases, be used to establish use of a mark to the extent to which they serve to confirm facts inferred from other items of evidence (19/12/2019, T-383/18, businessNavi (fig.), EU:T:2019:877, § 72) (§ 46).

Annual financial statements are highly reliable and have a high evidential value because they have been audited by an independent audit firm (§ 61).

[16/12/2019, T-535/19, JCE HOTTINGER-HOTTINGER, EU:T:2020:614, § 46, 61](#)

##### **Use of more than mere local significance – Overall assessment of the evidence**

Despite the absence of invoices for hotel services, the global assessment of other means of evidence (such as pictures of a hotel, supplier invoices, contracts with tourism promoters in different provinces of Spain, travel catalogues, invoices for radio advertising services, supplier declarations, etc.) has established the use of the Spanish trade name of more than local significance in the course of trade (§ 67).

[10/01/2024, T-504/22, Fantasia BAHIA PRINCIPE HOTELS & RESORTS \(fig.\) / FANTASIA HOTELES \(fig.\) et al., EU:T:2024:2](#)

[See also, 10/01/2024, T-505/22, LUXURY BAHIA PRINCIPE FANTASIA Don Pablo Collection \(fig.\) / FANTASIA HOTELES \(fig.\) et al., EU:T:2024:3, § 70](#)

#### **5.4.2.3 Nature of the use**

**Invalidity proceedings – Article 8(4) CTMR [now EUTMR] – Relevant public’s perception of a composite sign – No independent use in the course of trade of a sign of more than mere local significance**

The relevant public, faced with the composite sign 'NAPAPIJRI GEOGRAPHIC', will not perceive the non-registered sign 'geographic' as an independent sign under Article 8(4) CTMR [now EUTMR] (§ 26).

The non-registered sign 'geographic' has no actual and real independent presence on the relevant market. Only together with the sign 'napapijri', which is dominant, and with the Norwegian flag does it have such presence. It has not been proved that a substantial part of the relevant public would know the non-registered sign 'geographic' and would associate it with the goods without any effort. Therefore, the BoA was fully entitled to find that that word did not constitute an independent sign used in the course of trade (§ 38).



10/11/2021, T-517/20, [National geographic / Geographic](#),

EU:T:2021:783, § 26, 38



10/11/2021, T-518/20, [NATIONAL](#)

[GEOGRAPHIC \(fig.\) / Geographic](#), EU:T:2021:784, § 26, 38

### **Use in relation to goods and services – Probative value of independently audited financial statements**

The submitted financial statements indicate the company name, the services supplied by that company, the turnover value and its geographic distribution. As they are audited by an independent audit firm, they are a very reliable indication of the significant use of the sign for the marketing of the services that it covers (§ 61).

[26/07/2023, T-67/22, XTRADE \(fig.\) / X-trade brokers \(trade name\), EU:T:2023:436](#)

### **Use online of acronyms or abbreviations of the sign**

It is customary to use acronyms or abbreviations of the whole sign for the services offered online. Therefore, such evidence may be taken into account, among other factors, in the overall assessment of all of the evidence (§ 63).

[26/07/2023, T-67/22, XTRADE \(fig.\) / X-trade brokers \(trade name\), EU:T:2023:436](#)

## **5.5 PRECEDENCE IN TIME**

[No key points available yet.]

## **5.6 RIGHT TO PROHIBIT THE USE OF A SUBSEQUENT TRADE MARK UNDER THE APPLICABLE LAW**

### **Scope of protection – Other earlier national rights of the EUTM proprietor**

It is neither for the Office nor for the GC to settle a conflict between the earlier sign and another company name or non-registered national trade mark in invalidity proceedings against an EUTM (§ 50-57). This conflict falls within the competence of the national authorities (§ 54). The issue of the earlier right is examined by reference to the registration of the contested EUTM, and not by reference to the alleged earlier rights that the EUTM proprietor may have (§ 58).

07/02/2019, T-287/17, [SWEMAC](#), EU:T:2019:69, § 50-58

## 6 ARTICLE 8(5) EUTMR, ARTICLE 60(1)(a) EUTMR – MARKS WITH A REPUTATION

### 6.1 APPLICABILITY TO REGISTERED MARKS

[No key points available yet.]

### 6.2 APPLICABILITY TO SIMILAR AND IDENTICAL GOODS AND SERVICES

#### Proximity between the goods for the purposes of Article 8(5) EUTMR

Article 8(5) EUTMR expressly refers to the situation where the goods are not similar and the dissimilarity between the goods designated respectively by the marks at issue is therefore not a sufficient factor in excluding the existence of a link between those marks (26/09/2018, T-62/16, PUMA (fig.) / PUMA (fig.) et al., EU:T:2018:604, § 99-100 and case-law cited) (§ 111).

There is proximity between energy drinks and alcoholic drinks since they are frequently mixed in the relevant Austrian market, especially by young members of the public, are sold in the same supermarkets, and are often mentioned on menus of bars alongside each other (§ 113-115).

28/04/2021, T-509/19, [Flügel / ... Verleiht Flügel et al.](#), EU:T:2021:225, § 111, 115

#### The concepts of 'similarity' vs. 'proximity' in the application of Article 8(5) EUTMR

The concepts of 'similarity' and 'proximity' between the goods in question should not be confused. Where the former is a prerequisite for the application of Article 8(1)(b) EUTMR, the concept of 'proximity' between the goods, for the purposes of the application of Article 8(5) EUTMR, must be understood as the existence of a simple connection between those goods. (§ 45, 48, 50)

30/03/2022, T-445/21, [COMPAL](#), EU:T:2022:198, § 45, 48, 50

### 6.3 CONDITIONS OF APPLICATION:

#### 6.3.1 Earlier mark with reputation

##### 6.3.1.1 Nature of recognition

#### Trade mark functions protected by Article 8(5) EUTMR

Apart from an 'indication of origin', a mark also acts as a means of conveying other messages concerning, inter alia, the qualities or particular characteristics of the goods or services it covers or the images and feelings it conveys, such as, luxury, lifestyle, exclusivity, adventure and youth. To that effect, the mark has an inherent economic value that is independent of and separate from that of the goods and services for which it is registered. The messages in question which are conveyed, inter alia, by or associated with a mark with a reputation confer a significant value on that mark, which deserves protection. This is the case, in particular, because usually the reputation of a mark is the result of considerable effort and investment on the part of its proprietor (§ 43).

30/03/2022, T-445/21, [COMPAL](#), EU:T:2022:198, § 43

### 6.3.1.2 Scope of reputation

- Degree of reputation

#### **No exceptional reputation – No link between the marks for goods with no connection**

When reputation of the mark goes beyond the public of the goods or services for which the mark is registered, this mark can be considered to have an exceptional reputation within the meaning of the GC case-law (§ 37).

In the absence of exceptional reputation of the earlier mark, it cannot be concluded that there is a link between the marks in respect of goods in Classes 3, 14 and 18, which have no connection with those for which the earlier mark has reputation (chocolate coated peanuts) (§ 62).

[07/06/2023, T-339/22, Conquitos \(fig.\) / Conquitos LA CASA \(fig.\) et al., EU:T:2023:308](#)

- Relevant public

#### **Earlier mark reputed for goods aimed at the general public – Relevant public composed of professional and general public – Overlap – Error had no bearing on the outcome**

The mere fact that professionals in their capacity as private persons are also members of the public at large does not automatically mean that the public at large forms part of the relevant public addressed by the goods and services of the contested mark (§ 37). Regarding the contested mark, some of the goods are intended for the professional public and others for both the professional and general public (§ 38). Therefore, the BoA erred in finding no overlap (§ 40). However, the error in the definition of the relevant public had no bearing on the outcome of the contested decision (§ 42, 100).

[07/12/2022, T-623/21, Puma / Puma \(fig.\), EU:T:2022:776](#)

#### **Earlier mark reputed for goods aimed at the general public – Relevant public composed of professionals only – No overlap**

The public in the territory of a given mark cannot merely be defined as consisting of a part of the population of that territory, rather it involves defining the relevant consumer of the goods or services covered by that mark. It follows that the fact that the professional public of the goods covered by the contested mark (*machine tools* in Class 7) is part of the population in general, as composed of natural persons, does not mean that it also forms part, on that ground alone, of the public for which the goods covered by the earlier mark are intended (*clothing and shoes* in Class 25). The same applies to the fact, which is not disputed, that the professional public will be aware of the earlier mark (§ 32-33).

[21/12/2022, T-4/22, PUMA \(fig.\) / PUMA \(fig.\) et al., EU:T:2022:850](#)

- Goods and services covered

#### **Consideration of goods and services for which registration of the mark is sought and not those for which it is used**

In assessing the degree of proximity between the goods in the context of the assessment of the existence of a link in the minds of the relevant public between the conflicting marks within the meaning of Article 8(5) CTMR [now EUTMR], account must be taken of the goods for which registration of the mark is sought and not those for which it is actually used (§ 53).



14/04/2021, T-201/20, [GHISU \(fig.\) / CHIANTI CLASSICO DAL 17 \(fig.\) et al.](#), EU:T:2021:192, § 53

- Relevant territory

[No key points available yet.]

- Relevant point in time

#### **Evidence to prove the reputation of the earlier mark – Relevant date**

Even if some documents submitted to prove the reputation of the earlier mark bear a date which is five years earlier than the filing date of the contested EUTM (the relevant date), this fact does not deprive such documents of their evidential value. It cannot automatically be ruled out that a document drawn up some time before or after the relevant date may contain useful information since the reputation of a trade mark is, in general, acquired progressively (16/10/2018, T-548/17, ANOKHI (fig.) / Kipling (fig.) et al., EU:T:2018:686, § 103-104) (§ 112).

05/10/2020, T-51/19, [apiheal \(fig.\) / APIRETAL](#), EU:T:2020:468, § 112

#### **Relevant date and posterior documents to prove reputation**

The reputation of an earlier mark must be established as at the filing date of the application for the contested mark, but documents bearing a date later than that cannot be denied evidential value if they enable conclusions to be drawn about the situation as it was on that date. However, a survey carried out more than 13 years after the date of registration of the earlier mark, the results of which merely make it possible to draw conclusions on the situation as it appeared several years after that date, does not substantiate the reputation of the earlier mark at the date of registration (§ 75-77).

28/04/2021, T-509/19, [Flügel / ... Verleiht Flügel et al.](#), EU:T:2021:225, § 75-77

- Reputation acquired as part of another mark

#### **Acquisition of reputation of a mark as result of its use under a different form**

The submitted documents essentially show the words 'ANNA DE CODORNIU', sometimes accompanied by the bust of a woman. The GC considered that the submitted evidence proved reputation of the earlier word mark 'ANNA DE CODORNIU', but did not prove that the earlier figurative mark 'ANNA' is reputed on its own, i.e. independently from the expression 'DE CODORNIU' (§ 39-40, 58).

The acquisition of reputation of a mark may also be as a result of its use under a different form, in particular under the form of another registered mark, provided that the relevant public continues to perceive the goods as originating from the same undertaking (05/05/2015, T 131/12, SPARITUAL / SPA et al., EU:T:2015:257, § 33). In order to determine whether that is the case, it should be ascertained that the components which differentiate the two marks do not prevent the relevant public from continuing to perceive the goods as originating from a particular undertaking (01/03/2018, T-629/16, DEVICE OF TWO PARALLEL STRIPES (other) / DEVICE OF THREE PARALLEL STRIPES (fig.) et al., EU:T:2018:108, § 28) (§ 45). That the sign used on the market

includes all the elements of the mark as registered is not in itself sufficient to apply that jurisprudence (§ 46-48).

27/06/2019, T-334/18, [ANA DE ALTUN \(fig.\) / ANNA \(fig.\) et al.](#), EU:T:2019:451, § 33, 39-40, 46-48, 58

### 6.3.1.3 Assessment of reputation-relevant factors

#### Assessment of reputation

When assessing whether an earlier mark has a reputation, EUIPO is required to examine only the evidence which clearly and specifically relates to the reputation of that particular mark, but not other evidence which relates to other marks, whether or not they are similar, to various degrees, to the earlier mark relied on (§ 93). The proprietor of a registered trade mark may, in order to prove the particular distinctive character and reputation of that mark, rely on evidence of its use in a different form, but only as part of another registered trade mark which has a reputation and provided that the relevant public continues to perceive the goods at issue as originating from the same undertaking (§ 95).

[05/10/2022, T-711/20, CMS Italy \(fig.\) / PUMA \(fig.\) et al.](#), EU:T:2022:604

### 6.3.1.4 Proof of reputation

#### Forms of evidence to prove reputation

The relevant factors to assess the existence of repute, that is to say, in particular, the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it, being merely illustrative, it cannot be required that proof of the reputation of a mark be based on all those elements (§ 23, 24).

The evidence to establish the presence of the earlier trade mark on the internet is an additional element making it possible to establish the reputation of that trade mark. A significant presence of the earlier trade mark on the internet, given the number of subscribers to accounts dedicated to this trade mark on social networks, or the number of visitors to blogs mentioning this trade mark, constitutes an element making it possible to establish the knowledge of the trade mark by the public concerned and therefore its reputation (§ 33).

Since the EUTMR and the EUTMDR do not list the forms of evidence which the opponent may present in order to demonstrate the existence of the earlier mark's reputation, the opponent is free, in principle, to choose the form of evidence which it considers useful to submit (§ 35).

26/06/2019, T-651/18, [HAWKERS \(fig.\) / HAWKERS \(fig.\) et al.](#), EU:T:2019:444, § 23-24, 33, 35

#### Forms of evidence to prove reputation – Seasonal products

When assessing evidence related to the reputation of an earlier mark for *sandals* and *bathing shoes*, it must be taken into account that the sales volumes are influenced by the fact that they are seasonal products mainly sold during the summer (§ 34).

13/05/2020, T-288/19, [IPANEMA \(fig.\) / iPANEMA \(fig.\) et al.](#), EU:T:2020:201, § 34

#### Previous decisions recognising the reputation of the earlier marks

Where an opposition is based on Article 8(5) CTMR [now Article 8(5) EUTMR], the opponent is free, in principle, to choose the form of evidence it considers useful to submit to the Office, pursuant to Rule 19(2)(c) CTMIR [now Article 7(2)(f) EUTMDR]. Therefore, the opponent is free to rely on, as evidence of the reputation of the earlier mark relied upon, one or several previous

decisions of the Office finding that that mark enjoys a reputation. The Office is required to take into account those decisions, when they are identified in a precise manner in the notice of opposition (28/06/2018, C-564/16 P, DEVICE OF A JUMPING ANIMAL (FIG. MARK) / PUMA (FIG. MARK) et al., EU:C:2018:509, § 69) and to consider whether or not it should decide in the same way and, if not, to provide an explicit statement of its reasoning for departing from those decisions, stating why they are no longer relevant (§ 30-31, 35, 44, 46, 50). When under such circumstances, additional evidence filed with the statement setting out the grounds of appeal cannot be excluded as inadmissible new evidence submitted out of time (§ 51, 62).

22/05/2019, T-161/16, [CMS Italy \(fig.\) / PUMA \(fig.\) et al.](#), EU:T:2019:350, § 30-31, 35, 44, 46, 50, 51, 62.

### **Article 8(5) EUTMR – No proof of the reputation of the earlier mark – Decreasing evidential value of proof of reputation in proportion to the time elapsed since the EUTM application’s filing date – No reputation in spite of earlier decisions, confirmed by GC**

The opposition was rejected on the basis of Article 8(5) EUTMR, on the ground that there was no proof of the reputation of the earlier mark. The evidential value of proof of reputation decreases in proportion to the amount of time that has passed since the EUTM application’s filing date (§ 52). Invoices issued between 10 January 2014 and 19 July 2018 showed intensive use of the earlier mark for antipyretic pharmaceutical preparations. However, the invoices were insufficient to demonstrate that the situation established by the 2010 evidence was still valid as at 20 September 2018, in the absence of any evidence submitted by the applicant relating specifically to the market share held by that mark or to the amounts invested in promoting it (§ 52). The OD and the BoA can deny the existence of a reputation in spite of earlier decisions. This was confirmed by the GC, which had established reputation from 2015, 3 years before the relevant date (§ 54-55).

16/03/2022, T-315/21, [Apial / Apiretal](#), EU:T:2022:141, § 52 ; 54-55

### **Proof of reputation – Use of the earlier mark as part of another reputed mark**

The proprietor of a trade mark may, for the purpose of establishing its distinctive character and reputation, rely on evidence of its use as part of another registered trade mark with a reputation, provided that the relevant public continues to perceive the goods at issue as coming from the same undertaking. The fact that numerous items of evidence show the earlier mark, either combined with the word element 'save the duck' or under that word element alone, does not prevent the BoA from finding, on the basis of those items of evidence, that the earlier mark has a reputation (§ 83). The fact that the proprietor did not provide any figures for the market share of the earlier mark for the goods at issue does not in itself call into question the conclusion on the reputation of that mark (§ 86).



[14/09/2022, T-416/21, ITINERANT \(fig.\) / RAPPRESENTAZIONE DI UN PAPERINO CANTANDO \(fig.\) et al.](#), EU:T:2022:560

See also, [14/09/2022, T-417/21, ITINERANT \(fig.\) / RAPPRESENTAZIONE DI UN PAPERINO \(fig.\)](#), EU:T:2022:561

### **Proof of reputation – Use of the word corresponding to the mark**

The presence in the evidence of the word relating to the earlier mark does not necessarily mean that that word corresponds to the use of the mark (§ 87).

[03/05/2023, T-106/22, Bbqloumi / Halloumi](#), EU:T:2023:230

### **No proof of reputation – Forms of evidence to prove reputation – Awards**

The mere fact of having won an award, in itself, does not provide any information on the reputation of a trade mark. The evidential value of the assessment of reputation depends on the details, in particular, as regards the criteria for granting the award, the number and qualification of competing candidates and whether the award was publicised among the relevant public at the relevant date (§ 72).

[28/02/2024, T-98/23, \*atomic fund \(fig.\) / ATOMICO et al.\*, EU:T:2024:129](#)

### **No proof of reputation – EUIPO decision taken after the end of the transition period provided for in the Withdrawal agreement (Brexit) – Irrelevance of reputation in the UK**

Where the EUIPO decision post-dates the United Kingdom's withdrawal from the EU, the evidence relating to the use of the earlier EUTM in the UK must be disregarded. As the evidence submitted to prove the reputation of the earlier mark uses the term 'Europe' as a geographical name, designating the continent that includes in particular the UK, and the opponent does not draw a clear distinction between Europe and the EU, the reputation of the earlier mark in the EU is not proved (§ 80-82).

[28/02/2024, T-98/23, \*atomic fund \(fig.\) / ATOMICO et al.\*, EU:T:2024:129](#)

## **6.3.2 Similarity of the signs**

### **Concept of similarity**

The concept of similarity is equally valid for the application of both Article 8(1)(b) CTMR [now Article 8(1)(b) EUTMR] and Article 8(5) CTMR [now Article 8(5) EUTMR] (§ 76).

[28/02/2019, C-505/17 P, \*SO' BiO etic \(FIG. MARK\) / SO...? et al.\*, EU:C:2019:157, § 76](#)

### **Comparison of the conflicting marks**

Since food products in Classes 29 and 30 are normally purchased in supermarkets or similar establishments and selected directly by the consumer, rather than requested orally, for the assessment of the existence of a possible LOC or link between the signs, the figurative elements of a trade mark may play a more important role than its verbal elements in the perception of the relevant consumer (§ 155).

A phonetic comparison is irrelevant in the context of examining the similarity of a three-dimensional mark devoid of verbal elements with another mark. At most, its visual or conceptual content can be described orally, though a description like this would necessarily coincide with either its visual or conceptual perception. Consequently, it is not necessary to examine the phonetic perception of a three-dimensional mark devoid of verbal elements autonomously and to compare it with the phonetic perception of other marks (§ 166).

[28/02/2019, T-459/18, \*PEPERO original \(fig.\) / REPRÉSENTATION D'UN BATÔNNET \(fig.\)\*, EU:T:2019:119, § 155, 156](#)

### **Comparison of signs – Assessment of similarity between the signs – Link between the signs – Collective mark vs. individual mark**

In the context of the comparison of the signs for the purposes of Article 8(5) CTMR [now EUTMR], it is not contradictory to conclude that there is an overall similarity between the conflicting signs without taking a definitive position on that similarity in phonetic terms, provided that the overall similarity is sufficient for the public concerned to establish a link between them. Therefore, a

degree of similarity, even a slight one, and even on a single level, does not, on its own, preclude the application of Article 8(5) CTMR [now EUTMR] (20/11/2014, C-581/13 P & C-582/13 P, Golden balls, EU:C:2014:2387, § 72-77) (§ 32).

The comparison of the conflicting signs, one of which constitutes a collective mark and the other an individual mark, is based on the same criteria as those applicable to the comparison of the signs constituting two individual marks ([05/03/2020, C-766/18 P, BBQLOUMI \(fig.\) / HALLOUMI, EU:C:2020:170](#), § 59). Consequently, there is nothing to prevent the conclusion that the sign making up an individual mark and that making up a collective mark convey the same or, as in the present case, a similar concept (§ 34).



14/04/2021, T-201/20, [GHISU \(fig.\) / CHIANTI CLASSICO DAL 17 \(fig.\) et al.](#), EU:T:2021:192, § 32, 34

### **Lack of similarity at visual and conceptual level – Article 8(5) CTMR [now Article 8(5) EUTMR] not applicable**

The conflicting marks, each considered as a whole, produce different overall impressions on a visual level (§ 54). There are clear differences between the marks on a conceptual level (§ 79).



§ 54, 79

31/01/2019, T-215/17, [PEAR \(fig.\) / APPLE BITE \(fig.\) et al.](#), EU:T:2019:45,

### **Lack of similarity of the signs – No damage to reputation**

The marks must be compared in their forms as applied for and registered, regardless of any possible rotation in their use on the market (§ 24-30, 32, 53).



[21/04/2021, T-44/20, DEVICE OF TWO INTERLOCKING ELEMENTS \(fig.\) / DEVICE OF TWO BOLD BLACK CIRCLES OVERLAPPING \(fig.\)](#), EU:T:2021:207, § 24-30, 32, 53

### **Similarity of the signs**

The similarity of the signs must be assessed from the point of view of the average consumer, by reference to the intrinsic qualities of those signs, as registered or as applied for (§ 41).

[06/07/2022, T-288/21, ALOve \(fig.\) / LOVE \(fig.\)](#), EU:T:2022:420

### **Similarity of signs – Distinctive character of a figurative element representing a feline**

The figurative element present in the contested sign representing a bounding feline is of lower distinctiveness, because it alludes to certain characteristics of those goods and services, in particular the strength and endurance which are typical of the big cats, and, as it was established in the course of the administrative proceeding, such an element is frequently used in registered trade marks in order to designate such goods or services (§ 43).



[05/10/2022, T-711/20, CMS Italy \(fig.\) / PUMA \(fig.\) et al., EU:T:2022:604](#)

### Visual similarity of the signs – Illegible word elements

The sign applied for is purely figurative given that its word elements are illegible (§ 39). The signs at issue have a common dominant element in the form of a coloured polygon in the upper part which, despite their differences, produce a similar visual impression, namely that of a white triangle. Consequently, the signs, taken as a whole, are visually similar to a low degree (§ 43). A phonetic and a conceptual comparison is not possible (§ 44, 45). The description of the sign applied for that is provided in the application and refers to a mountain range does not, as such, affect the assessment of the conceptual similarity of the two signs at issue (§ 46).



[21/12/2022, T-44/22, DEVICE OF A PACK OF CIGARETTES \(fig.\) / Marlboro \(fig.\) et al., EU:T:2022:843](#)

### Concept of similarity under Article 8(5) EUTMR

The concept of similarity between the marks at issue and the criteria to be taken into consideration when assessing the similarity between the marks are the same in the case of a refusal to register a mark applied for because of LOC, pursuant to Article 8(1)(b) EUTMR, and in the case of refusal because of damage to the reputation of an earlier mark, under Article 8(5) EUTMR (§ 24, 59).

[12/07/2023, T-487/22, Device of two black interrelated geometrical shapes \(fig.\) / mó \(fig.\) et al., EU:T:2023:391](#)

### Concept of similarity under Article 8(5) EUTMR

Although the application of the protection provided by Article 8(5) EUTMR may result from a lesser degree of similarity between the marks than that required by Article 8(1)(b) EUTMR, it does not follow from the wording of those provisions, or from the case-law, that the similarity between the conflicting marks must be assessed differently according to whether it is assessed in the light of one provision or the other (§ 39).

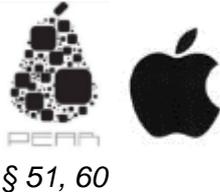
[25/10/2023, T-384/22, ESTRELLA DE CASTILLA \(fig.\) / Estrella Galicia \(fig.\) et al., EU:T:2023:672](#)

### 6.3.3 Link between the signs

#### Reputation of the earlier mark – Distinctive character of the earlier mark

The reputation of the earlier mark is a relevant factor for the assessment, not of the similarity of the conflicting marks, but of the existence of a link between them in the mind of the relevant public. Moreover, it is only if the conflicting marks have a certain similarity that it is necessary to make an overall assessment in order to determine whether there is a link between those marks in the mind of the relevant public (§ 51).

The distinctive character of the earlier mark is a relevant factor for the assessment, not of the similarity of the conflicting marks, but of the existence of a link between them in the mind of the public concerned (§ 60).



31/01/2019, T-215/17, [PEAR \(fig.\) / APPLE BITE \(fig.\) et al.](#), EU:T:2019:45,

§ 51, 60

### Overall assessment of the link between the marks

The overall assessment of the link between the marks is to be carried out considering the degree of closeness or dissimilarity between the goods or services for which the marks were registered, and the strength of the earlier mark's reputation (§ 84).

28/02/2019, C-505/17 P, [SO' BiO etic \(FIG. MARK\) / SO...? et al.](#), EU:C:2019:157, § 84

### Nature and degree of proximity of the goods or services

The nature and degree of proximity of the goods or services concerned are relevant factors for the purpose of determining whether the use of a trade mark takes unfair advantage of the distinctive character or reputation of another trade mark. However, the existence of a similarity between the goods and services concerned does not constitute a condition for the application of Article 8(5) EUTMR (§ 182).

28/02/2019, T-459/18, [PEPERO original \(fig.\) / REPRÉSENTATION D'UN BATÔNNET \(fig.\)](#), EU:T:2019:119, § 182

### Nature and degree of proximity of the goods or services – Seasonal products

There is a link between *(optical) spectacles, rims for the latter (for sunglasses)* and *sandals and bathing shoes*. This is because they belong to the field of fashion accessories and are mainly sold and used in summer (§ 61). Although *(optical) spectacles, rims for the latter (for sunglasses)* and *sandals and bathing shoes* do not share sufficient criteria to be found similar, a valid application of Article 8(5) CTMR [now Article 8(5) EUTMR] does not require the products to be identical or similar to the point of causing a risk of confusion within the meaning of Article 8(1)(b) CTMR [now Article 8(5) EUTMR] (§ 62).

*Protective goggles* are not similar to *sunglasses*. *Protective goggles* constitute personal protective equipment intended for the world of work. Even though they can be used as protection against intense light, they are sufficiently different from *sunglasses*, in particular as regards their purpose and their distribution channels, namely shops dedicated to manual and industrial work. Furthermore, *protective goggles* are not used during just one season of the year, particularly in the summer (§ 63-64).

13/05/2020, T-288/19, [IPANEMA \(fig.\) / iPANEMA \(fig.\) et al.](#), EU:T:2020:201, § 62-64

### Link between the signs – Nature and degree of proximity of the goods or services

There is a certain proximity between the contested goods in Classes 9, 11 and 17, *sanitary installations and parts and accessories of the same, bath accessories*, and the earlier right's *hotels and restaurants services* in Class 43 on account of their complementary character (§ 159-162).

In view of the identity of the signs, the proximity of the goods and services, and the higher level of attention paid by the relevant public to the contested products, there is a risk that an association may be made between the two signs (§ 171-172).

09/09/2020, T-144/19, [ADLON / ADLON](#), EU:T:2020:404, § 159-162, 171-172

### **Link between the signs – Nature and degree of proximity of the goods or services**

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

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

09/09/2020, T-669/19, [Primus / Primus et al.](#), EU:T:2020:408, § 99, 104, 107-108

### **Link between the signs – Assessment of the link according to the strength of the reputation and the distinctive character of the earlier mark**

The assessment of the link in the minds of the relevant public is likely to vary according to the strength of the reputation and the distinctive character of the earlier mark. In the present case, although the earlier mark enjoys a certain reputation, no evidence has been adduced supporting the fact that this reputation goes beyond the public concerned with the services for which it was registered (§ 98-99).

In the context of an average degree of repute of the earlier mark and having regard to the average degree of similarity between the marks, the different nature of the goods and services, the high level of attention of the public targeted by the mark applied for and the average distinctiveness of the earlier mark, it cannot be concluded that the relevant public would establish a link between the marks at issue (§ 101). In these circumstances, the fact that the earlier mark consists of an invented word and that the mark applied for reproduces it verbatim, by simply adding a descriptive word after it, is not a crucial factor in creating a link in the minds of the relevant public (§ 105).

28/04/2021, T-644/19, [VertiLight / VERTI](#), EU:T:2021:222, § 98-99, 101, 105

### **Absence of link between the signs – Lack of link between the services – Different public**

Services intended for different publics are neither complementary (22/01/2009, T-316/07, *easyHotel*, EU:T:2009:14, § 57-58 and the case-law cited) nor in competition with each other (18/02/2011, T-118/07, *PPT*, EU:T:2011:58, § 39 and 40 and the case-law cited) (§ 64).

Notwithstanding the strong reputation of the earlier figurative marks and the above-average degree of similarity between the marks, the lack of any link between the services (relating to the gambling sector in Class 41 for the earlier marks and the scientific and technological sector in Class 42 for the contested mark) and the difference between the relevant publics, one of which is a specialist public with a high level of attention, are such that the existence of a link between the marks, this being a condition for the application of Article 8(5) EUTMR, can be ruled out (§ 66).



11/11/2020, T-820/19, [Lottoland-LOTTO \(fig.\) e.a.](#), EU:T:2020:538, § 64, 66

### **Absence of a link between the signs – First name and a surname – Wine and alcoholic beverages**

The fact that the relevant public will identify the two signs *Jaume Codorniu* and *Jaume Serra et al.* as a combination of the first name 'JAUME' followed by the surnames 'SERRA' and 'Codorniu' is not sufficient to generate the necessary link between the signs, even if the earlier mark has a high reputation. This is because in the wine sector, when the conflicting signs consist of a first

name that is not particularly rare or unusual and of surnames that are not particularly common in the relevant territory, the surnames are more distinctive than the first name (§ 53, 55, 97).

08/05/2019, T-358/18, [JAUME CODORNÍU / JAUME SERRA et al.](#), EU:T:2019:304, § 53, 55, 97

### **Link between the marks – Exceptional reputation**

The fact that the marks are similar and that the earlier mark has an exceptional reputation cannot automatically be sufficient for a link between those marks to be found (§ 71). This is the case even if it is established that the specialised public targeted by the goods protected by the contested mark is aware of the earlier mark, whose reputation goes beyond the public of the goods covered by the earlier mark (§ 85).

 10/03/2021, T-71/20, [Puma-system / PUMA \(fig.\)](#), EU:T:2021:121, § 71, 85

### **No obligation to exam *ex officio* the exceptionally strong reputation of a mark**

The BoA is not required to rule on the exceptionally strong reputation of a mark on its own motion where no evidence or arguments in this regard are provided by the party (§ 38-39).

In the context of the application of Article 8(5) CTMR [now Article 8(5) EUTMR], the applicant is required to provide prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or detriment, when indicated on the basis of logical deductions (§ 47-48).



11/04/2019, T-655/17, [ZARA TANZANIA ADVENTURES \(FIG. MARK\) / ZARA et al.](#), EU:T:2019:241, § 38-39, 47-48

### **Link between the signs**

When a mark has acquired a particularly distinctive character because of its reputation, an argument alleging that it has only a very weak intrinsic distinctive character is ineffective in the context of the assessment as to whether there is a link between the marks at issue and, therefore, as to whether there is injury within the meaning of Article 8(5) EUTMR (§ 69).

[06/07/2022, T-288/21, ALove \(fig.\) / LOVE \(fig.\)](#), EU:T:2022:420

### **Overall assessment of the link between the marks**

Whether there is a link between the marks at issue for the purposes of Article 8(5) EUTMR must be assessed globally, taking into account all factors relevant to the circumstances of the case, including, inter alia, the strength of the earlier mark's reputation. Consequently, the degree of similarity between the marks at issue is by no means the only relevant factor in assessing whether there is a link between those marks (§ 103).

[05/10/2022, T-711/20, CMS Italy \(fig.\) / PUMA \(fig.\) et al.](#), EU:T:2022:604

### **No link between the signs – Nature and degree of proximity of the goods**

Even if there is an overlap in the relevant public, the relevant goods or services can be so different that the consumers will not establish any link between the marks in conflict (§ 82). The goods at issue essentially belong to different economic sectors and markets (§ 100). There is no evidence that, irrespective of the commercial context, the consumers always think of the applicant when

confronted with the word 'Puma' (§ 96). There is also no evidence that the goods at issue have certain characteristics leading to an image transfer between the marks in conflict (§ 97).

**PUMA** [07/12/2022, T-623/21, Puma / Puma \(fig.\), EU:T:2022:776](#)

### **No link between the signs – Nature and degree of proximity of the goods**

The fact that the signs at issue are almost identical, the distinctive character of the earlier mark is high, and its reputation goes beyond the relevant public for the goods covered do not necessarily mean that there is a link between the marks at issue, such a link having to be assessed in the light of the relationship between all of the factors which are relevant in each case. The goods are entirely different, the contested goods are aimed at a specific public radically different from that of the goods covered by the earlier mark and the applicant has not demonstrated that the earlier mark will be brought to mind of the consumer of the contested goods; there is therefore no link between the marks (§ 65-67).

**PUMA PUMA** [21/12/2022, T-4/22, PUMA \(fig.\) / PUMA \(fig.\) et al., EU:T:2022:850](#)

### **Assessment of the link between the signs – Earlier reputed mark composed of a meaningful name**

The standard of proof required for demonstrating a link between the marks is higher where the earlier mark is composed not of a fanciful name, but of a common noun which primarily designates an animal (§ 66).

[21/12/2022, T-4/22, PUMA \(fig.\) / PUMA \(fig.\) et al., EU:T:2022:850](#)

### **Link between the signs**

Taking into account the low visual similarity between the signs, the substantial reputation and enhanced distinctiveness acquired through use of the earlier mark, the identity or similarity of the goods at issue and the identity of the public concerned, there is a link between the marks (§ 54, 55). The visual aspects are significant, since the goods at issue are not only named aloud, but also need to be inspected visually during a purchase (§ 55).



[21/12/2022, T-44/22, DEVICE OF A PACK OF CIGARETTES \(fig.\) / Marlboro \(fig.\) et al., EU:T:2022:843](#)

### **Link between the signs**

The fact that the mark applied for covers 'vehicles and conveyances' in Class 12 while the earlier mark covers goods and services in Classes 9, 35, 38 and 42 is not, in itself, sufficient to preclude a certain proximity between the goods and services for the purposes of Article 8(5) EUTMR; a direct and immediate link between the goods and services is not necessary (§ 22).

The mere existence of a separate mark used by the opponent – WAYMO – in connection with its cars does not in any way change the fact that consumers will establish a link between the signs 'GOOGLE CAR' and 'GOOGLE' (§ 35).

[01/02/2023, T-569/21, Google car / Google et al., EU:T:2023:38](#)

See also, [01/02/2023, T-568/21, GC GOOGLE CAR \(fig.\) / Google et al., EU:T:2023:37](#), § 50, 53

### **Link between the signs – Nature and degree of proximity of the goods**

The similarity of the goods is only one factor among others for the purposes of establishing a link, but not a condition for the application of Article 8(5) EUTMR. The very wording of that article explicitly states that it applies to conflicts between marks covering different goods and services (§ 66).

Even if the sections of the public targeted by the marks do not overlap completely, a connection between the marks can be established (§ 70).

[26/04/2023, T-681/21, mccosmetics NY \(fig.\) / MAC MAKE-UP ART COSMETICS \(fig.\) et al., EU:T:2023:215](#)

### **No link between the signs – Nature and degree of proximity of the goods**

Where the reputation of the earlier mark does not go beyond the class of goods for which it is registered and the goods at issue (in this case *bread* and *goods in the field of cycling*) are far removed from each other since they belong to two distinct worlds, the relevant public is not likely to establish a link between the marks (§ 46, 51, 53).

[24/05/2023, T-509/22, BimboBIKE \(fig.\) / BIMBO et al., EU:T:2023:281](#)

### **Link between the signs – Nature and degree of proximity of the goods or services – Beer – Meat and retail services in relation to meat**

*Ham, meat, meat extracts, meat products, charcuterie products* in Class 29 and *beer* in Class 32 are all intended for human consumption. Furthermore, they may be consumed in the same establishments, purchased in the same shops and consumed together. It must therefore be held that there is a certain proximity between them. *Retailing, wholesaling and sale via global computer networks of ham, meat, meat extracts, charcuterie* in Class 35 are sales services relating to the same goods as those in Class 29 covered by the mark applied for (which have a certain proximity to *beer*) insofar as they relate to the sector of foodstuffs for human consumption (§ 123-124).



[25/10/2023, T-384/22, ESTRELLA DE CASTILLA \(fig.\) / Estrella Galicia \(fig.\) et al., EU:T:2023:672](#)

### **No link between the signs – Nature and degree of proximity of the goods**

Despite the reputation of the earlier mark as regards antipyretic pharmaceutical preparations, the relevant public will not establish a link between the marks at issue. The signs at issue have a very low degree of similarity between them. The contested goods in Class 5 (sanitary preparations; disinfectants and antiseptics) have, at most, a tenuous link with antipyretic pharmaceutical preparations, the only goods for which the reputation of the earlier mark has been established. As regards the contested goods in Class 3, they were found not to be identical, but to be similar, or similar to a low degree, to the pharmaceutical and veterinary preparations covered by the earlier mark, a concept that is more general than that of antipyretic pharmaceutical preparations, and for which the reputation of the earlier mark has not been established (§ 48).

[13/12/2023, T-56/23, A'PEAL / APIRETAL et al., EU:T:2023:798](#)

### **No link between the signs – Nature and degree of proximity of the goods**

Proximity of goods and services is not a condition for finding a link between the marks, but it is a relevant criterion in its assessment (§ 32).

[25/01/2024, T-266/23, puma soundproofing \(fig.\) / PUMA \(fig.\) et al.](#)

### **No link between the signs – Assessment of the link – Proof of the link**

Link between the marks must be proven even where the earlier mark enjoys a very high degree of reputation (§ 35).

[25/01/2024, T-266/23, puma soundproofing \(fig.\) / PUMA \(fig.\) et al.](#)

### **No link between the marks – No arguments on the types of injury**

Where the applicant before the GC does not put forward any argument, apart from general statements, calling into question the BoA's findings regarding the absence of a link between the marks and does not explain how one of the three types of injury could occur in the present case, its arguments must be rejected as unfounded. In particular, it is not sufficient to allege, without providing further details, that it is 'clear' that the relevant public would establish a link between the marks at issue (§ 58-60).

[31/01/2024, T-581/22, ECE QUALITY OF LIFE \(fig.\) / ECE \(fig.\), EU:T:2024:47](#)

### **No link between the marks – Exceptional reputation**

The mere fact that the earlier mark has a high degree of reputation for certain specific categories of goods or services does not necessarily imply that there is a link between the marks at issue. There is no provision in the EUTMR that provides for any presumption with regard to trade marks that have an exceptional reputation, and the EU legislature has not made these subject to special treatment (§ 58).

Judgment [27/11/2008, C-252/07, Intel, EU:C:2008:655](#) does not establish that marks with exceptional reputation cannot be concerned by § 49 of that judgment, which states that the goods or services at issue may be so dissimilar that the contested mark will be unlikely to bring the earlier mark to the minds of the relevant public. A link cannot be presumed just because the earlier mark has an exceptional reputation (§ 59-60).



[28/02/2024, T-184/23, BERTRAND PUMA La griffe boulangère \(fig.\) / PUMA \(fig.\) et al., EU:T:2024:133](#)

### **Reputation of the earlier mark – Assessment of the link between the signs –Necessity to carry out a global assessment**

Where trade marks present some similarity, even if faint, a comprehensive assessment must be carried out to determine whether, notwithstanding the low degree of similarity between them, there exists, due to the presence of other relevant factors such as the reputation of the earlier trade mark, a likelihood of confusion or a link between these trade marks in the mind of the relevant public. Having concluded the absence of a link 'even if the other criteria were met', the BoA did not undertake any examination of these other factors, particularly regarding whether they would allow the relevant public to establish such a link despite certain differences between the conflicting marks (§ 116-118).

[06/03/2024, T-639/22, GEOGRAPHICAL NORWAY EXPEDITION \(fig.\) / NAPAPIJRI geographic \(fig.\) et al., EU:T:2024:149](#)

## **6.3.4 Risk of injury**

### **6.3.4.1 Assessment of the risk of injury**

#### **Requirement to establish one of the harms referred to in Article 8(5) EUTMR**

In the absence of exceptional reputation of the earlier trade mark, serious risk of one of the harms referred to in Article 8(5) EUTMR must be shown (§ 124-127).



19/05/2021, T-510/19, [DEVICE OF A JUMPING ANIMAL \(fig.\) / PUMA \(fig.\) et al.](#), EU:T:2021:281, § 124-127

### Degree of reputation – Necessity to prove risk of injury

As far as the principles are concerned, it is possible, particularly in the case of an opposition where the earlier mark enjoys an exceptionally high reputation, that the probability of a future, non-hypothetical risk of injury to the earlier mark is so obvious that the earlier mark's proprietor does not need to put forward and prove any other fact to that end (§ 30). Where the evidence is not capable of showing that the earlier mark is inherently very distinctive and recognised in practically every context, as it is in this case where the evidence submitted relates either to bread or the food sector and not to other sectors, and therefore it remains too general or too temporally limited to make it possible to establish a perception of the earlier mark in contexts other than that of food, the BoA must assess the existence of a risk of injury in the light of all the relevant factors, and not only on the strength of the earlier mark's reputation (§ 33-34).

[24/05/2023, T-509/22, BimboBIKE \(fig.\) / BIMBO et al.](#), EU:T:2023:281

#### 6.3.4.2 Types of injury

- Taking unfair advantage of distinctiveness or repute

#### Taking unfair advantage of repute (free-riding) – Relevant factors

The nature and degree of proximity of the goods or services are relevant factors in determining whether the use of one trade mark takes unfair advantage of the distinctive character or reputation of another trade mark. However, the existence of similarity between the goods and services concerned by the conflicting trade marks not being a condition for the application of Article 8(5) EUTMR, arguments to establish that the goods covered by the conflicting marks are different are not relevant (§ 55-56).

HAWKERS **H A W K E R S** 26/06/2019, T-651/18, [HAWKERS \(fig.\) / HAWKERS \(fig.\) et al.](#), EU:T:2019:444, § 55-56

#### Taking unfair advantage of repute (free-riding) – Nature and degree of proximity of the goods or services

The nature and degree of proximity of the goods or services concerned are relevant factors for the purposes of determining whether the use of a trade mark takes unfair advantage of the distinctive character or reputation of another trade mark. However, the existence of a similarity between the goods and services concerned does not constitute a condition for the application of Article 8(5) EUTMR (§ 182).

28/02/2019, T-459/18, [PEPERO original \(fig.\) / REPRÉSENTATION D'UN BATÔNNET \(fig.\)](#), EU:T:2019:119, § 182

#### Taking unfair advantage of repute (free-riding)

The prefix 'mc' of the opponent's family of marks (such as McDONALD'S) has acquired a high degree of distinctiveness through its use on the fast-food market (§ 71).

Having regard to the exceptional nature of the reputation of the earlier mark, the average level of attention of the relevant public, the existence of a degree of similarity between the marks and the significant degree of similarity between the services, as well as the existence of a family of marks, the structure of which is reproduced, at least in part, by the mark applied for, the relevant public would establish a link between the marks, even though the opponent did not offer any form of accommodation or hotel services (§ 85).

The relevant public would associate the mark applied for with the image of reliability, efficiency, low-cost services and, on that account, choose it instead of the services provided by its competitors. The mark applied for would therefore ride on the coat-tails of the earlier mark to benefit from the power of attraction, the reputation and the prestige of that mark. The economic advantage would consist, for the applicant, of exploiting the effort expended by the opponent to establish the reputation and the image of its earlier mark, without paying any compensation in exchange (§ 90, 98).

10/10/2019, T-428/18, [mc dreams hotels Träumen zum kleinen Preis! \(fig.\) / McDONALD'S et al.](#), EU:T:2019:738, § 71, 85, 90, 98

### **Taking unfair advantage of repute (free-riding)**

In the context of the application of Article 8(5) CTMR [now Article 8(5) EUTMR], the opponent is required to provide prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or detriment, when indicated on the basis of logical deductions (§ 47-48). The BoA erred in finding that the opponent confined itself to making general allegations regarding the existence of a risk of unfair advantage being taken of the distinctive character and the repute of the earlier marks (§ 49). The opponent made a number of allegations based on the specific circumstances of the case during the administrative procedures, inter alia the tendency of fashion brand owners to expand their activities to other sectors, including possibly services of hotels and travel agency (§ 49).



11/04/2019, T-655/17, [ZARA TANZANIA ADVENTURES \(FIG. MARK\) / ZARA et al.](#), EU:T:2019:241, § 47-49

### **Risk of unfair advantage of the distinctive character or the repute – Irrelevance of intent**

The absence of any intent on the part of the proprietor of the contested mark to free-ride, even if established, is not in itself sufficient to rule out the possibility of unfair advantage being gained from the use of that mark, since subjective factors such as the commercial intentions, real or supposed, of the proprietor of the contested mark do not have to be taken into account (§ 134).

28/04/2021, T-509/19, [Flügel / ... Verleiht Flügel et al.](#), EU:T:2021:225, § 134

### **Unfair advantage of enhanced distinctive character and repute**

There is a risk that the mark applied for takes unfair advantage of the enhanced distinctive character and the repute of the earlier mark (§ 68). In view of the evidence produced by the intervener before the BoA, the BoA was entitled to find that the rooftop-shaped polygonal element of the earlier mark had been widely used, in different colours and for different ranges of cigarettes, so that consumers could be led to believe that the polygonal element of the mark applied for was merely a variant of that element of the earlier mark (§ 67).



[21/12/2022, T-44/22, DEVICE OF A PACK OF CIGARETTES \(fig.\) / Marlboro \(fig.\) et al., EU:T:2022:843](#)

### **Taking unfair advantage of repute (free-riding)**

The stronger the earlier mark's distinctive character and reputation are, the easier it will be to accept that detriment has been caused to it. The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that the current or future use of the later mark is taking unfair advantage of, or is detrimental to, the distinctive character or the repute of the earlier mark (§ 39).

The risk of free-riding is obvious given that one of the two elements constituting the mark applied for is identical to the earlier mark, the reputation of which is extremely strong, and that the other element is descriptive of the goods covered by the mark applied for (§ 42). The mere existence of an additional mark owned by the proprietor of the earlier mark cannot have the effect of reducing or even eliminating the risk of free-riding to the detriment of the earlier mark, where the relevant public will establish a link between the marks at issue (§ 43).

[01/02/2023, T-569/21, Google car / Google et al., EU:T:2023:38](#)

See also, [01/02/2023, T-568/21, GC GOOGLE CAR \(fig.\) / Google et al., EU:T:2023:37](#), § 60, 63, 64

### **Unfair advantage**

Given the circumstances, the BoA was entitled to find that consumers were likely to buy the contested goods and services believing they might be linked to the earlier mark, thus resulting in a misappropriation of its power of attraction and its advertising value (§ 70, 71).



[07/06/2023, T-541/22, Sanity Group \(fig.\) / SANYTOL \(fig.\) et al., EU:T:2023:310](#)

- [Detriment to distinctiveness](#)

[No key points available yet.]

- [Detriment to repute](#)

[No key points available yet.]

### **6.3.5 Use without due cause**

#### **No due cause – Irrelevance of evidence related to third countries**

Pursuant to the concept of 'due cause', the proprietor of a trade mark with a reputation may be obliged to tolerate the use by a third party of a sign similar to that mark in relation to a product which is identical to that for which that mark was registered, if it is demonstrated that that sign was being used before the mark with a reputation was filed and that the use of that sign in relation to the identical product is in good faith (§ 74). The assessment of due cause requires a determination as to how the mark applied for has been accepted by, and what its reputation is

with, the relevant public (§ 80). The evidence produced by the applicant, which relates to territories outside the EU, is irrelevant by virtue of the principle of territoriality, given that the protection of the mark applied for is claimed within the EU (§ 78).

[21/12/2022, T-44/22, DEVICE OF A PACK OF CIGARETTES \(fig.\)/ Marlboro \(fig.\) et al., EU:T:2022:843](#)

#### **No due cause – Coexistence agreement with third parties**

Due cause for the use of a sign that is similar to a mark with reputation is an expression of the general objective of the EUTMR, which is to reconcile the interests of the proprietor of a trade mark in protecting the essential function of that mark and the interests of a third party in using, in the course of trade, such a sign to designate the goods and services it markets. In the context of the examination of due cause, the BoA must reconcile the interests of the proprietor of the earlier trade mark and those of the EUTM applicant. In this regard, the EUTM applicant cannot validly rely on the fact that the proprietor of the earlier mark had entered into a coexistence agreement with other third parties in that regard (§ 164).

[25/10/2023, T-384/22, ESTRELLA DE CASTILLA \(fig.\) / Estrella Galicia \(fig.\) et al., EU:T:2023:672](#)

#### **No due cause – No relevance of the common use of a term**

The fact that a term is very common and frequently used because of a meaning inherent in it, is relevant in the context of the assessment of the risk of dilution, but does not allow a finding of due cause (§ 166).

[25/10/2023, T-384/22, ESTRELLA DE CASTILLA \(fig.\) / Estrella Galicia \(fig.\) et al., EU:T:2023:672](#)

## **7 ARTICLE 8(6) EUTMR – GEOGRAPHICAL INDICATIONS**

#### **Preliminary ruling – Geographical origin – Article 2(1)(a) Regulation No 510/2006 – Article 13(1) Regulation No 510/2006**

Geographical indications (GIs) are protected against any evocation, including by figurative signs (§ 18). A producer established in a geographical area corresponding to a Protected Designation of Origin (PDO), whose products are not protected by the PDO but are similar or comparable to those protected by it, is not excluded from the application of Article 13(1)(b) Regulation No 510/2006 (§ 34).

[02/05/2019, C-614/17, \*Fundación Consejo Regulador de la Denominación de Origen Protegida Queso Manchego\*, EU:C:2019:344, § 18, 34](#)

#### **Preliminary ruling – Article 13(1)(d) Regulation No 510/2006 – Article 13(1)(d) Regulation No 1151/2012 – Practice liable to mislead the consumer as to the true origin of the product – Reproduction of the shape or appearance of a product which has a protected name**

EU law prohibits, in certain circumstances, the reproduction of the shape or appearance of a product protected by a protected designation of origin (PDO). It is necessary to determine whether that reproduction may mislead consumers considering all the relevant factors, including the way in which the product is presented and marketed to the public and the factual context (§ 39, 41).

[17/12/2020, C-490/19, \*Morbier\*, EU:C:2020:1043, § 39, 41](#)

## **Use of a protected designation of origin (PDO) pursuant to Article 103(2)(a)(ii) of Regulation (EU) No 1308/2013**

The mark applied for has a high degree of visual similarity and is phonetically identical in its initial element, at least in French, to the earlier protected designation of origin (PDO). The conditions for allowing a finding of 'use' of the PDO 'Porto' in the mark applied for are satisfied in that, in accordance with the case-law, the signs are visually and phonetically similar to such a degree that the sign whose registration is contested is clearly indissociable from the earlier PDO (§ 39-44).

06/10/2021, T-417/20, [Portwo gin / Porto](#), EU:T:2021:663, § 39-44

### **Association between the trade mark applied for and the earlier PDO**

The incorporation of a PDO in a trade mark cannot be held to be capable of exploiting the reputation of that designation of origin if that incorporation does not lead the relevant public to associate that mark or the goods for which it is registered with the designation of origin or the wine product for which it is protected. In light of the strong similarities between the mark applied for and the PDO 'Porto', the degree of proximity of the goods and the exceptional reputation of the PDO, the BoA did not err in finding it probable that the relevant consumer would associate the mark applied for with that PDO (§ 45-48).

06/10/2021, T-417/20, [Portwo gin / Porto](#), EU:T:2021:663, § 45-48

### **Exploitation of the reputation of the earlier PDO**

Exploitation of the reputation of a PDO refers to any use of the PDO that seeks to take undue advantage of its reputation. The particular image and distinctive qualities that the PDO 'Porto' enjoys for wines in the eyes of the relevant public are transferable to the goods – *spirits* – covered by the mark applied for (§ 49-54).

06/10/2021, T-417/20, [Portwo gin / Porto](#), EU:T:2021:663, § 49-54

### **Evocation of an earlier PDO – Alcoholic beverages**

The contested mark is visually and phonetically similar to the earlier Protected Designation of Origin (PDO). The goods are all characterised by the fact that they are alcoholic beverages. In those circumstances, the contested mark evokes the earlier PDO (§ 39-42).

**BOLGARÉ** [23/03/2023, T-300/22, BOLGARÉ \(fig.\) / Bolgheri et al., EU:T:2023:159](#)

## **8 SPECIFIC RELATIVE GROUNDS FOR INVALIDITY: ARTICLE 60(2) EUTMR**

### **8.1 PROOF OF THE APPLICABLE LAW GOVERNING THE SIGN**

#### **8.1.1 The burden of proof**

[No key points available yet.]

## **8.1.2 Means of evidence and standard of proof**

### **8.1.2.1 National law**

[No key points available yet.]

### **8.1.2.2 European Union law**

[No key points available yet.]

## **8.2 ENTITLEMENT: DIRECT RIGHT CONFERRED ON THE INVALIDITY APPLICANT**

[No key points available yet.]

## **8.3 TYPES OF RIGHTS FALLING UNDER ARTICLE 60(2) EUTMR:**

### **8.3.1 A right to a name/right of personal portrayal**

[No key points available yet.]

### **8.3.2 Copyright**

[No key points available yet.]

### **8.3.3 Other industrial property rights**

[No key points available yet.]

## **8.4 PRECEDENCE IN TIME**

[No key points available yet.]

## **8.5 RIGHT TO PROHIBIT THE USE OF A SUBSEQUENT TRADE MARK UNDER THE APPLICABLE LAW**

**Invalidity proceedings – Article 52(2)(d) CTMR [now Article 60(2)(d) EUTMR] – Earlier industrial right – Relevant date for the establishment of the right to prohibit the use of the contested mark**

It follows from the broad logic of the other provisions of the regulation concerning relative grounds for refusal that an application for a declaration of invalidity must be rejected where the cancellation applicant is unable to prove that its earlier mark continues to enjoy protection on the date on which the Office takes its decision and it is established, with certainty, that the conflict with the earlier trade mark no longer exists (§ 27-29).

In the context of Article 52(2)(d) CTMR [now Article 60(2)(d) EUTMR] the proprietor of an earlier industrial property right must therefore establish that he may prohibit the use of the contested EU trade mark not only on the date of filing or priority of that mark, but also on the date on which the Office gives a ruling on the application for a declaration of invalidity (§ 30).



02/06/2021, T-169/19, [DEVICE OF A POLO PLAYER \(fig.\) / DEVICE OF A POLO PLAYER \(fig.\) et al.](#), EU:T:2021:318, § 27-30

# CHAPTER IV – PROOF OF USE IN OPPOSITION, INVALIDITY PROCEEDINGS AND REVOCATION FOR NON-USE PROCEEDINGS (PoU)

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## 1 PROCEDURAL ASPECTS

### 1.1 REQUEST FOR POU IN OPPOSITION AND INVALIDITY PROCEEDINGS

#### **Request for proof of use – Formal requirements – Expressly and timeously**

Article 47(2) EUTMR and Rule 22 EUTMIR do not lay down any specific requirements as to the form and content of the applicant's request of proof of genuine use (§ 44-46). According to case-law, such a request must be made expressly and timeously to the Office. The expression 'timeously' not only concerns the observance of any period laid down, but also implies the requirement to present that request before the OD, not for the first time before the BoA (§ 47). By the sentence 'Furthermore, we raise the objection of non-use (Art. 15)' inserted in a separate paragraph of its reply to the opposition, the applicant explicitly and unambiguously contested the genuine use of the earlier marks (§ 49-50).

28/11/2019, T-736/18, [Bergsteiger / BERG \(fig.\) et al.](#), EU:T:2019:826, § 44-47, § 49-50  
01/12/2021, T-359/20, [Team Beverage](#), EU:T:2021:841, § 40

#### **Request for proof of use – Formal requirements – Unconditional request for proof of use in a separate document – Article 19(2) EUTMDR**

The applicant did not file an unconditional request for proof of use of the earlier mark in a separate document pursuant to Article 19(2) EUTMDR (§ 19, 21).

23/02/2022, T-184/21, [Хозяин / Хозяюшка \(fig.\)](#), EU:T:2022:88, § 19, 21  
23/02/2022, T-185/21, [Хозяйка / Хозяюшка](#), EU:T:2022:89, § 19

#### **Invalidity proceedings – Article 15 and Article 57 CTMR [now Article 18 and Article 64 EUTMR] – No obligation for proof of genuine use of the earlier mark – Declaration of invalidity**

The BoA correctly found that the conditions for requesting proof of use of the earlier mark were not satisfied since the earlier mark had been registered less than five years before the date of the application for a declaration of invalidity (§ 34).

Article 15 CTMR does not provide that a trade mark that has not been put to genuine use within a period of five years following registration can be subject to 'revocation'. For a trade mark proprietor's rights to a mark to be revoked, there are also conditions that need to be satisfied that are not laid down in Article 15 CTMR (but in Article 51(1) CTMR, which relates to the specific procedure that deals with the revocation of a mark) (§ 20-33).

21/12/2021, T-870/19, [CLEOPATRA QUEEN \(fig.\) / Cleopatra melfinco et al.](#), EU:T:2021:919, § 20-34

#### **Formal requirements – Request for proof of use in a separate document**

A request for proof of use is admissible according to Article 10(1) EUTMDR only if it is filed as an unconditional application in a separate document (§ 47-50).

## 1.2 BURDEN OF PROOF

### No examination of genuine use *ex officio* in the proceedings before the BoA

When the issue of genuine use of the earlier mark is not specifically raised before the BoA, it does not constitute a question of law which must necessarily be examined by the BoA in order for the dispute before it to be settled. Consequently, it must not be regarded as the subject matter of the proceedings before the BoA (05/10/2017, T-36/17, COLINEB / Colina (fig.), EU:T:2017:690, § 21) (§ 39).

08/07/2020, T-659/19, [kix \(fig.\) / kik](#), EU:T:2020:328, § 39

### No obligation on the BoA to perform an *ex officio* search of evidence

In so far as the applicant asserts that the addresses of the clients referred to in evidence could easily be found via an internet search and that the BoA failed to carry out such a search, it must be held that the burden of proving genuine use of the mark in the context of revocation proceedings rests with the proprietor of the mark (§ 77).

07/07/2021, T-205/20, [l-cosmetics](#), EU:T:2021:414, § 77

### Genuine use to be proven for EUTMs and earlier national marks relied on in an application for a declaration of invalidity – Article 15 CTMR [now Article 18 EUTMR]

Where the proprietor of an EUTM requests proof of genuine use to be submitted, that use constitutes a condition which must be met, under Regulation No 40/94, not only by EUTMs but also by earlier national marks relied on in support of an application for a declaration of invalidity of that EUTM. Therefore, the application of Article 43(2) of Regulation No 40/94 to earlier national marks under paragraph 3 of that article means that genuine use is to be defined according to Article 15 CTMR and not by national law (§ 98) (see, by analogy, in relation to invalidity proceedings, 12/07/2019, T-412/18, mobile.ro (fig.) / mobile (fig.), EU:T:2019:516, § 23) (§ 98).



23/09/2020, T-796/16, [Grass in bottle / Bottle with strand of grass et al.](#), EU:T:2020:439, § 98

### Generally disputing the PoU assessment – Lack of specific arguments

The applicant confines itself to disputing generally the BoA's finding that genuine use of the contested mark had been proved in relation to [certain] services. It does not put forward any specific argument for the purposes of showing how exactly that finding on the part of the BoA is incorrect. In those circumstances, the [...] plea must be rejected in so far as the applicant disputes that there has been genuine use of the contested mark in connection with th[ose] services (§ 56, 58).

[16/11/2022, T-512/21, EPSILON TECHNOLOGIES \(fig.\), EU:T:2022:710](#)

### Revocation proceedings – No examination of genuine use *ex officio* – Burden of proof with the EUTM proprietor to clearly indicate the goods and services concerned by the PoU

The owner of the contested mark, who has the onus of proof for establishing genuine use in revocation proceedings (§ 17-20), is under the duty to clearly indicate, in response to the application for revocation, for which goods and services it had provided evidence before the CD to show genuine use of the contested mark (§ 28). As regards the contested goods and services not indicated by the EUTM proprietor, it is not the task of the CD to examine of its own motion, within all the evidence produced before it, whether that evidence could establish genuine use (§ 30).

[01/02/2023, T-772/21, efbet \(fig.\), EU:T:2023:36](#)

### **Proof of use – Burden of proof regarding use in accordance with its function**

According to Article 47(2) EUTMR, it is for the proprietor of the earlier mark to prove genuine use of that mark in accordance with its essential function (§ 32, 57).

[06/09/2023, T-774/21, DEVICE OF A BOTTLE SILHOUETTE AND AN ARROW \(fig.\) / DEVICE OF A CAN AND A BOTTLE SILHOUETTES AND AN ARROW \(fig.\), EU:T:2023:518](#)

## **1.3 ACQUIESCENCE – ARTICLE 61 EUTMR**

### **Conditions of acquiescence**

Four conditions must be satisfied to cause the start of the limitation period in consequence of acquiescence: (i) the later trade mark must be registered; (ii) the application must have been made in good faith by its proprietor; (iii) it must be used in the Member State where the earlier trade mark is protected; and, (iv) the proprietor of the earlier trade mark must be aware of the use of that trade mark after its registration (§ 20 and case-law cited).

[24/01/2019, T-785/17, BIG SAM SPORTSWEAR COMPANY \(fig.\) / SAM et al., EU:T:2019:29, § 20](#)

### **Relevant point in time**

The plea of inadmissibility resulting from acquiescence requires demonstration of *actual awareness* of the use made of the more recent mark during a five-year period after its registration. The registration of the contested mark is one of the conditions which must be satisfied before the period of limitation in consequence of acquiescence pursuant to Article 61(1) EUTMR starts running. The questions of whether the contested mark was used before its registration, and whether the proprietor of the earlier trade mark was aware of such a use before registration, are irrelevant for the calculation of the time period pursuant to this provision (§ 17-18).

[20/06/2019, T-389/18, WKU / WKA et al., EU:T:2019:438, § 17-18](#)

### **Relevant point in time**

The fact that an earlier right holder had filed an opposition against the contested mark does not imply that this earlier right holder was necessarily aware of the subsequent use made of the contested mark. The date of filing of the opposition can therefore not constitute the starting point of the 5-year period for acquiescence (§ 36).

[24/01/2019, T-785/17, BIG SAM SPORTSWEAR COMPANY \(fig.\) / SAM et al., EU:T:2019:29, § 36](#)

## 2 NATURE OF USE

### 2.1 USE OF A MARK IN ACCORDANCE WITH ITS FUNCTION: INDIVIDUAL, COLLECTIVE AND CERTIFICATION MARKS

#### No genuine use – Descriptive use of a trade mark for specific goods

A trade mark is to be used in accordance with its essential function, guaranteeing the identity of the origin of the goods or services for which it is registered. This condition is not fulfilled where the mark affixed to an item does not contribute to creating an outlet or to distinguishing the item from the goods of other undertakings, but rather serves as a descriptive indication for the goods' ingredients (§ 83).

31/01/2019, C-194/17 P, [Cystus](#), EU:C:2019:80, § 83

#### No genuine use – Use for promotional purposes

The free distribution of the CDs, DVDs and software on which the contested trade mark is affixed, exclusively in the context of the marketing of goods (photobooks and calendars) – although it is indispensable for the order and design of these goods – does not constitute genuine use of the trade mark according to its essential function. The items are not distributed with the aim of penetrating the market for goods in the same class. Affixing the EUTM on such products does not aim at creating an outlet for them (§ 38-39).

11/04/2019, T-323/18, [DARSTELLUNG EINES SCHMETTERLINGS \(fig.\)](#), EU:T:2019:243, § 38-39

#### Genuine use – Irrelevance of the classification of a mark for the assessment of genuine use

When assessing the distinctiveness of a mark, the classification of a 'position mark' as a figurative or three-dimensional mark, or as a specific category of marks, is irrelevant (§ 42). This classification is also irrelevant in assessing the genuine use of such a mark (§ 43).

The GC correctly relied on the graphic representation of the mark, regardless of its classification, for the purpose of assessing whether there is genuine use, stating that it could be inferred directly from the graphic representation of the mark, and with sufficient precision, that the protection sought covered only a cross, consisting of two black intersecting lines, represented in solid lines (§ 41, 46-47).



06/06/2019, C-223/18 P, [DEVICE OF A CROSS ON A SPORT SHOE SIDE \(fig.\)](#), EU:C:2019:471, § 41-43, 46-47

#### No genuine use – No use in accordance with the function of indicating origin

Where the use of an individual mark, despite certifying the geographical origin of the mark and the qualities attributable to the origin of the goods from different producers, does not guarantee to consumers that those goods or services come from a single undertaking under the control of which they are manufactured or supplied and which, consequently, is responsible for the quality of those goods or services, such use is not made in accordance with the function of indicating origin (§ 39).



17/10/2019, C-514/18P, [Steirisches Kürbiskernöl \(fig.\)](#), EU:C:2019:878,

§ 39

### **No genuine use – No use in accordance with the function of indicating origin**

The evidence submitted only shows the contested marks placed under a long list describing technical specifications, just above the barcode in relatively small character size and accompanied by another mark in the same size and font. The way in which the contested marks are used, therefore, is not in accordance with their essential function of giving an indication of the commercial origin of the goods concerned (§ 93, 94).

[08/06/2022, Joined Cases T-26/2, T-27/21 and T-28/21, Think different, EU:T:2022:350](#)

### **Genuine use – Indication of the company name combined with the sign**

Where the trade mark is systematically placed in invoice headers as the first element above the company name 'ad Pepper media GmbH', use of the sign **ad pepper** goes beyond merely identifying the company and refers to the commercial origin of the services provided. The design of the invoices therefore allows a close connection to be made between the sign **ad pepper** and the invoiced services (§ 82).

03/10/2019, T-666/18, [ad pepper \(fig.\)](#), EU:T:2019:720, § 82

### **Genuine use – Trade mark identical with company name**

When a word mark is also a company name, it is possible for the company name to be used as a trade mark (15/07/2015, T-24/13, CACTUS OF PEACE CACTUS DE LA PAZ (fig.) / CACTUS, EU:T:2015:494, § 62). However, the purpose of a company name is to identify a company and is not, of itself, to distinguish goods or services. Accordingly, there is use in relation to goods or services where a third party affixes the sign constituting its company name to the goods that it markets or, even where the sign is not affixed, where the third party uses that sign in such a way that a link is established between the sign which constitutes the company of the third party and the goods marketed or the services provided by the third party (11/09/2007, C-17/06, Céline, EU:C:2007:497, § 21-23) (§ 32-33).

02/06/2021, T-17/20, [GAMELAND \(fig.\) / Gameloft](#), EU:T:2021:313, § 32-33

### **Genuine use – Company, trade or shop name**

Use of a company, trade or shop name may be regarded as trade mark use, that is 'in relation to goods' provided that the EUTM proprietor affixes the sign to the goods or, even though the sign is not affixed, the EUTM proprietor uses that sign in such a way that a link is established between the company, trade or shop name and the goods or services. If either of those two conditions is fulfilled, the fact that a word element is used as a trade name does not preclude its use as a trade mark to designate goods or services (§ 76).

[22/06/2022, T-329/21, Fraas, EU:T:2022:379](#)

### **Genuine use of collective marks**

The essential function of a collective mark is to distinguish the goods or services of the members of the association which is the proprietor of that mark from those of other undertakings (§ 52). Therefore, unlike an individual mark, a collective mark does not have the function of indicating to

the consumer 'the identity of origin' of goods or services in respect of which it is registered (§ 53). Article 66 CTMR [now Article 74(1) EUTMR] by no means requires that manufacturers, producers, suppliers or traders that are affiliated with the association which is the proprietor of a collective mark, form part of the same group of companies which manufacture or supply the goods or services under unitary control (§ 54). Collective marks are, like individual marks, part of the course of trade (§ 56). Their use must therefore, in order to be classified as 'genuine' within the meaning of Article 15(1) CTMR [[now Article 18(1) EUTMR], be part of the objective of the undertakings concerned to create or preserve an outlet for their goods or services (§ 56).

A collective mark is used in accordance with its essential function from the moment it enables the consumer to understand that the goods or services covered originate from undertakings that are affiliated with the association, the proprietor of the mark, and to thereby distinguish those goods or services from those originating from undertakings that are not affiliated (§ 58).

The assessment of genuine use of the mark should be carried out by evaluating, particularly, whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (§ 62).



12/12/2019, C-143/19P, [EIN KREIS MIT ZWEI PFEILEN \(fig.\)](#), EU:C:2019:1076, § 52-54, 56, 58, 62

### **Evidence concerning proof of genuine use**

As an accumulation of items of evidence may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (17/04/2008, C-108/07 P, *Ferro*, EU:C:2008:234, § 36), all the evidence submitted to the BoA must make it possible to establish proof of use and each piece of evidence therefore does not necessarily have to relate to the place, duration, nature and extent of use (§ 61-63)

13/06/2019, T-398/18, [DERMAEPIL SUGAR EPIL SYSTEM \(fig.\) / dermépil Perron Rigot \(fig.\)](#), EU:T:2019:415, § 61-63

### **Evidence concerning proof of genuine use**

Statutory declarations by the managing director and the head of the HR department cannot in themselves constitute sufficient evidence of genuine use of the contested trade mark. However, they can be taken into consideration if they are supported by other evidence, without their impartiality or credibility having to be questioned (§ 89-90, 92).

03/10/2019, T-666/18, [ad pepper \(fig.\)](#), EU:T:2019:720, § 89-90, 92

### **Proof of genuine use of earlier national marks**

When the proprietor of an EU trade mark requests proof of genuine use to be provided, that use constitutes a condition which must be met, not only by EU trade marks but also by earlier national marks relied on in support of an application for a declaration of invalidity of that EU trade mark. The application of Article 64(2) EUTMR to earlier national marks under paragraph 3 of that Article means that genuine use is to be defined according to Article 18 EUTMR, and not assessed according to the relevant national law (§ 23).

The use of the sign did not alter the distinctive character of the earlier national mark (§ 28-34).

12/07/2019, T-412/18, [mobile.ro \(fig.\) / mobile \(fig.\)](#), EU:T:2019:516, § 23, 28-34

### **Proof of genuine use – Nature of use – Use as a trade name – Use as a domain name to be considered under certain circumstances as use as a mark**

The BoA failed to consider evidence of the sign being used as a corporate name or a domain name and a mark (§ 62). Some items of evidence show use only as a corporate name (§ 78) or trade name (§ 82). Use in the press or on YouTube can constitute use as a mark (§ 83, 86), as can use in contracts (§ 84) or in apps for mobile devices (§ 85).

Proof of genuine use of a mark may be furnished by means of information provided by a website or by the use of the mark as a domain name or as an element of the domain name if that website fulfils a commercial or advertising function with regard to the goods covered by the mark in question (§ 89). In the present case, the websites present the goods and services concerned, and the sign 'MOOD MEDIA' separated by a colon appears at the top left on each page on the websites (§ 90). It is possible, on those websites, to contact 'Mood Media' in order to obtain more information and to buy the goods and services concerned. Therefore, those websites fulfil a commercial and advertising function, because they present all the goods and services concerned and offer the possibility of obtaining them (§ 90-91).

*02/03/2022, T-615/20, [Mood media](#), EU:T:2022:109, § 62, 78, 82-86, 89-91*

### **Nature of use – Use as a trade mark and as a trade name**

A company, trade or shop name does not in itself have the purpose of distinguishing goods or services. A company name is intended to identify a company, whereas a trade or shop name is intended to identify a business. Therefore, where a company, trade or shop name is used only for the purpose of further identifying a company or designating a business, that use cannot be regarded as being 'in relation to goods or services' (§ 88).

However, there is use 'in relation to goods' if the trade mark proprietor affixes the sign constituting his company name, trade name or logo to the goods which he markets. In addition, use 'in relation to goods or services' also occurs without affixing, if the sign is used in such a way that a connection is established between the sign constituting the company, trade or shop name and the goods distributed or the services provided. To the extent that this condition is met, the fact that a word element is used as the trade name of the company does not preclude it from being used as a trade mark to designate goods or services (§ 89).

There is no rule requiring proof that the trade mark has been used in isolation and independently of any other trade mark or sign. It is therefore possible for two or more trade marks to be used jointly and autonomously, with or without the name of the manufacturing company (§ 90).

The contested mark is used on the invoices not only to identify the business of the intervener, but also to indicate the commercial origin of the services provided. On the basis of these invoices, a link can be established between the contested mark and the services in question (§ 91). The fact that other trade marks of the proprietor are sometimes used in connection with the services concerned, including on the invoices, cannot call that finding into question (§ 93). In the present case, the simultaneous use of several trade marks is still suitable for ensuring the preservation of the rights to the contested mark. The contested mark designates a range of services in Classes 35, 38 and 42. The possible concurrent presence of other trade marks of the proprietor, which would themselves designate only a narrower range of services, cannot in any way prevent or alter the fact that the relevant public identifies the range of services associated with the contested mark - which occupies neither a subordinate nor an insubstantial position in the evidence submitted (§ 94).

*[07/09/2022, T-521/21, ad pepper the e-advertising network \(fig.\), EU:T:2022:520](#)*

### **Assessment criteria – Proof of use**

The fact that the cancellation applicant is the proprietor of a mark which is identical to the sign used must be held to be irrelevant for the purposes of assessing whether the contested mark has been put to genuine use (§ 51).

[16/11/2022, T-512/21, EPSILON TECHNOLOGIES \(fig.\), EU:T:2022:710](#)

### **Use in accordance with its function – Level of distinctiveness not decisive**

Whether the inherent distinctiveness of the contested mark is average or low is not decisive for the assessment of the use of the contested mark as a trade mark. For a finding that the contested mark has been used in accordance with its main function, it must come from the evidence that the consumer is able to perceive the three-dimensional shape of the goods as an indication of commercial origin (§ 24, 28).



[14/12/2022, T-553/21, FORM EINES SMILEYS \(3D\), EU:T:2022:813](#)

### **Use in accordance with its function – Relevance of advertising material**

A body of evidence consisting of advertising material is capable of proving the use of a contested mark in accordance with its essential function to guarantee the identity of origin of the goods for which that mark was registered (§ 33). It can be presumed that the relevant consumer had been so intensively exposed to the contested mark that he could easily infer a link with the manufacturer on the basis of the three-dimensional shape (§ 35), as the three-dimensional shape represented by the contested mark is (i) either fully visible on the packaging where it is placed in the foreground and depicted at an impressive size or (ii) directly visible through the transparent packaging (§ 31-32). Moreover, the product shape which corresponds to the contested mark is clearly emphasised in the TV ads and heavily used through pictures from social media (§ 34).



[14/12/2022, T-553/21, FORM EINES SMILEYS \(3D\), EU:T:2022:813](#)

### **Use in accordance with its function – 3D mark – Significant departure from the customs or norms of the sector – Well-known facts – Variety of shapes – Burden of proof**

It is well-known that frozen potato products on the relevant market are usually marketed in the form of sticks, flat biscuits or wedges, not faces or other human-like shapes (§ 37). While the GC has found that there is a wide variety of shapes in the sectors from which cereal preparations, bakery and confectionery products originate, the variety of shapes associated with certain foodstuffs is not necessarily transferable to similar foodstuffs (§ 38).

The fact that consumers encounter a significant number of shapes on the market makes it unlikely that they will regard a particular shape as an indication of a particular manufacturer rather than as an expression of the diversity of that market. However, there is no evidence that the relevant industry is characterised by a wide variety of shapes and that the contested mark is merely regarded as a variant of these shapes (§ 41).



[14/12/2022, T-553/21, FORM EINES SMILEYS \(3D\), EU:T:2022:813](#)

### **Nature of use – Relevance of market surveys**

The BoA merely considered the two market studies after finding genuine use and only to support its conclusions as to the nature of the use of the contested mark (§ 71, 73).

[14/12/2022, T-553/21, FORM EINES SMILEYS \(3D\), EU:T:2022:813](#)

### **Genuine use – Trade mark constituting a company name**

There is use ‘in relation to goods’ where the EUTM proprietor affixes the sign constituting its company or trade name or logo to the goods it markets or to the packaging. Furthermore, even where the sign is not affixed, there is use ‘in relation to goods’ where the sign is used in such a way that a link is established between the sign that constitutes the company, trade or shop name and the goods marketed (§ 72).

[11/01/2023, T-346/21, Gufic, EU:T:2023:2](#)

### **No genuine use – Use as a company name**

There was use ‘in relation to goods or services’ where the sign constituting the company name was used in such a way that a link was established between that sign and the goods marketed or the services provided. Therefore, the fact that a word element is used as the company’s trade name does not preclude its use as a mark to designate goods or services (§ 57).

[15/03/2023, T-194/22, zelmotor \(fig.\), EU:T:2023:130](#)

### **Proof of use – Use as a trade mark – Weak earlier mark**

When assessing whether the earlier mark is used as registered, it is incorrect to examine its distinctive character. Article 64 EUTMR and the case-law relating to genuine use do not expressly require an assessment of the distinctive character (§ 44).

[01/03/2023, T-102/22, Gourmet \(fig.\) / Gourmet, EU:T:2023:100](#)

### **Genuine use – Nature of use – Trade mark constituting a company name**

Where a trade mark is also a company name, it does not preclude the company name from being used as a trade mark. The earlier mark is displayed, in large letters, in the upper right-hand corner of most of the invoices. Those invoices therefore establish a clearly perceptible link between the earlier mark and the goods mentioned in the invoices (§ 61-62).

It is not necessary for the earlier mark to be affixed to goods in order for it to be put to genuine use in relation to those goods. It is sufficient that the use of the earlier mark establishes a link between the mark and the marketing of those goods. The presence of the earlier mark in the invoices, technical sheets and the installation manual establishes such a link in the present case (§ 63).

[26/04/2023, T-546/21, R.T.S. ROCHEM Technical Services \(fig.\) / ROCHEM MARINE \(fig.\), EU:T:2023:221](#)

See also [26/04/2023, T-547/21, R.t.s. rochem technical services / ROCHEM MARINE \(fig.\), EU:T:2023:222, § 60-62](#); [26/04/2023, T-548/21, Rochem / ROCHEM MARINE \(fig.\), EU:T:2023:223, § 59-61](#); [26/04/2023, T-549/21, ROCHEM \(fig.\) / ROCHEM MARINE \(fig.\), EU:T:2023:224, § 60-62](#)

### **Genuine use – Use of the contested figurative mark together with a word mark**

Although the word mark ‘TOUS’ is used together with the contested figurative sign in various forms of advertising, that does not prevent the consumer from recognising and identifying the goods concerned solely by means of the contested figurative sign (§ 84, 85).

[26/07/2023, T-638/21, DEVICE OF THE OUTLINE OF A BEAR \(fig.\), EU:T:2023:434](#)

### **Use as a trade mark – Use in form of the shape of the goods**

Insofar as some of the goods are capable of taking the shape of the contested sign, in particular items of jewellery, that sign departs significantly from the shape most likely to be taken by the goods (jewellery). Accordingly, the contested mark departs significantly from the customs of the sector (§ 122).



[26/07/2023, T-638/21, DEVICE OF THE OUTLINE OF A BEAR \(fig.\), EU:T:2023:434](#)

### **No genuine use – No use in accordance with the function of an individual mark**

Where the relevant public perceives an individual mark as a sign intended to certify the composition or quality of the goods or services, without, however, guaranteeing consumers that the goods or services come from a single undertaking – under the control of which they are manufactured or supplied and which, consequently, is responsible for the quality of those goods or services – use of that sign is not made in accordance with the function of indicating commercial origin (§ 31).

When a sign comprising symbols used throughout the EU to denote the recycling process or recycling services is placed on items to be recycled, and is affixed to a legal document such as the terms and conditions of participation in a recycling system, it will be understood by business consumers to refer to the recycling process in itself and to the fact that certain goods are subject to a specific recycling system. It will not be perceived as indicating the commercial origin of the services covered by the earlier sign (§ 45, 46). That perception is borne out by the wording of those terms and conditions, which present the sign systematically as marking disposable packaging for the purposes of certifying that those goods are covered by a specific recycling system (§ 47-50).



[06/09/2023, T-774/21, DEVICE OF A BOTTLE SILHOUETTE AND AN ARROW \(fig.\) / DEVICE OF A CAN AND A BOTTLE SILHOUETTES AND AN ARROW \(fig.\), EU:T:2023:518](#)

### **No genuine use – No independent use**

The variety of marketing strategies among the companies in the relevant sector cannot change the criteria for assessing the evidence. The registered sign must be used as a trade mark so as to enable consumers to identify the origin of the goods concerned (§ 33).

When the signs are not used independently, but form part of a package comprising more than a hundred other signs, this prevents the relevant public from perceiving it as a separate, independent mark (§ 40).

[06/09/2023, T-350/22, Game of gladiators / Gladiator, EU:T:2023:501](#)

## **2.2 PUBLIC USE IN THE COURSE OF TRADE**

### **Outward use of a mark – Relevant public**

Genuine use of a mark depends on the market in which the EUTM proprietor pursues its commercial activities and in which it hopes to put its mark to use. Accordingly, for assessing outward use of a mark, the relevant public to which marks are addressed comprises not only end consumers, but also specialists, industrial customers and other professional users (§ 80).

[03/10/2019, T-666/18, \*ad pepper\* \(fig.\), EU:T:2019:720, § 80](#)

### **Outward use of a mark – Relevant public**

Outward use does not necessarily mean use aimed at end consumers. The relevant public does not comprise only the end consumer, but also specialists, industrial customers and other professional users. Genuine use of the mark relates to the market in which its proprietor pursues its commercial activities (§ 38, 39)

04/04/2019, T-910/16 and T-911/16, [TESTA ROSSA \(fig.\)](#), EU:T:2019:221, § 38-39

### **Genuine use for goods or services already marketed or about to be marketed**

Genuine use of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way.

03/07/2019, C-668/17 P, [Boswelan](#), EU:C:2019:557, § 39, 51, 53

### **Genuine use for high-end sports cars about to be marketed – Preparatory tasks and advertising efforts**

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

23/09/2020, T-677/19, [SYRENA](#), EU:T:2020:424, § 70-71

### **Proof of genuine use – Public use in the course of the trade – Relevance of invoices to retailers – External use not restricted to final consumers**

Genuine use of the trade mark presupposes that it is used publicly and externally, and not only within the undertaking concerned. However, external use of a trade mark is not necessarily equivalent to use that is directed towards final consumers. Actual use of the mark relates to the market in which the proprietor of the mark carries on business and in which they hope to exploit their mark. To consider that external use of a trade mark, within the meaning of the case-law, necessarily consists of use that is directed towards final consumers would effectively exclude trade marks used solely in business-to-business relationships from protection. The relevant public to which trade marks are intended to be directed not only includes final consumers but also specialists, industrial customers and other professional users (07/07/2016, T-431/15, FRUIT, EU:T:2016:395, § 49 and case-law cited) (§ 26, 32, 36).

10/11/2021, T-353/20, [ACM 1899 AC MILAN \(fig.\) / Milan et al.](#), EU:T:2021:773, § 26, 32, 36

### **No genuine use – Preparatory acts**

Mere preparatory acts carried out within an undertaking cannot suffice to establish genuine use of a trade mark of which it is the proprietor if they are not accompanied by sufficient marketing of the product concerned, under that trade mark, during the relevant period, carried out by means of external acts directed towards potential consumers. The design and development of models during the relevant period, without those internal preparatory acts being accompanied by external acts on the market (promotional campaigns and/or orders for goods) during that period, cannot, in themselves, be regarded as genuine use of the contested mark (§ 46).

[07/09/2022, T-353/21, R2R, EU:T:2022:527](#)

### **Outward use of a mark – Relevant public**

Although genuine use of a mark requires that it be used publicly and outwardly, the outward use of a mark does not necessarily mean use directed at end users. Genuine use of the mark relates to the market on which the proprietor of the EU trade mark pursues its commercial activities and on which it hopes to put its mark to use. Accordingly, taking the view that outward use of a mark, within the meaning of the case-law, must consist of use directed at end users would effectively exclude marks used only in business-to-business relationships from the protection of EUTMR. The relevant public to which marks are addressed does not consist solely of end users but also of specialists, industrial clients and other professional users (§ 84).

[14/09/2022, T-609/21, Steam, EU:T:2022:563](#)

### **Genuine use – Irrelevance of the lawfulness of the use**

The alleged illegality of the EUTM holder's distribution system does not preclude genuine use of the mark. The EUIPO is not competent to rule on the compliance of the use with the German Medicinal Product Act (AMG). Moreover, Article 18 EUTMR does not stipulate that the goods on which the mark is used have to be lawful or that the use must be made in good faith. Even illegal sales can be qualified as genuine use (§ 39).

[11/01/2023, T-346/21, Gufic, EU:T:2023:2](#)

### **Genuine use – Public and outward use**

Outward use does not necessarily mean that it is use aimed at end consumers. Genuine use of the mark relates to the market on which the proprietor of the EUTM pursues its commercial activities and on which it hopes to put its mark to use. Marks can also be genuinely used in inter-organizational relations. The relevant public to which marks are addressed does not comprise only end consumers, but also specialists, industrial clients and other professional users (§ 41-43).

[11/01/2023, T-346/21, Gufic, EU:T:2023:2](#)

### **Outward use of a mark – Relevance of invoices to retailers – External use not restricted to final consumers**

Outward use of a mark does not necessarily mean use aimed at end consumers. In a market such as that of the European Union, in order to create or preserve an outlet for goods such as *shirts* in Class 25, it is common to direct commercial acts at professionals in the sector concerned and particularly at resellers. Therefore, it cannot be ruled out that use of a mark proved by commercial acts targeting only professionals in the sector concerned may be considered to be genuine use of the mark (§ 88-89).

[01/03/2023, T-552/21, Camel, EU:T:2023:98](#)

### **Internal use of the mark by a group of companies**

Invoices submitted as evidence of use of the contested mark that are addressed to an undertaking that forms part of the group of companies of the EUTM proprietor, do not serve to prove genuine use of the mark, without evidence that the goods at issue were actually sold on the market (§ 94-97).

[01/03/2023, T-552/21, Camel, EU:T:2023:98](#)

## 2.3 MANNER IN WHICH THE TRADE MARK IS USED IN RELATION TO THE GOODS OR SERVICES

### Requirements of nature of use for the relevant goods

Use of the sign Jones to designate shops located in Austria is relevant for determining the place of use, but does not meet the requirements of nature of use for the relevant goods (§ 86). Although evidence providing indications of the time of use of the sign **Jones** was submitted, such use does not meet the relevant requirements as to the nature either since, in the catalogues and magazine submitted, the sign does not appear on the clothing, but in the page margins (§ 70), and is therefore open to multiple interpretations (§ 87).

17/09/2019, T-633/18, [TON JONES / Jones \(fig.\) et al.](#), EU:T:2019:608, § 70, 86-87

### Use of the mark for services cannot be shown through its use on goods – Proof of genuine use of the sign that is not affixed to the product only when a link is established

The mere fact that the mark was used in connection with the goods offered also for professionals (i.e. cosmetics) is not sufficient to establish the mark's use in respect of the services that entail the use of those goods (i.e. cosmetic services) (§ 38).

Where the sign is not affixed to a product, there is only genuine use where it is used in such a way that a link is established between that sign and the goods marketed (§ 89).

07/07/2021, T-205/20, [L-cosmetics](#), EU:T:2021:414, § 38, 89

### Assessment of proof of use for goods and services – Notion of partial use – Coherent subcategories of goods – Criterion of the purpose and intended use of the goods

From the wording of the last sentence of Article 42(2) CTMR [now Article 47(2) EUTMR] and the principles established by case-law (11/12/2014, C-31/14 P, Premeno, EU:C:2014:2436, § 37, 39) (§ 39-42), it follows that it is important to assess in a concrete manner – principally in relation to the goods for which the proprietor of the earlier mark has submitted proof of use of the earlier mark – whether those goods constitute an independent subcategory in relation to the goods falling within the class of goods concerned, so as to link the goods for which genuine use of the earlier mark has been proved to the category of goods covered by the application for registration of that trade mark (§ 46).

The aim of the criterion of the purpose and intended use of the goods is not to provide an abstract or artificial definition of independent subcategories of goods; it must be applied coherently and specifically (11/12/2014, C-31/14 P, Premeno, EU:C:2014:2436, § 37, 39, 41) (§ 50). Accordingly, if the goods concerned have several purposes and intended uses, determining whether a separate subcategory of goods exists, by considering in isolation each of the purposes that those goods may have, will not be possible. Indeed, such an approach would not enable independent subcategories to be identified coherently and would excessively limit the rights of the proprietor of the earlier mark, inter alia, in that their legitimate interest in expanding their range of goods or services for which their trade mark is registered would not be sufficiently taken into consideration (§ 51).

16/07/2020, C-714/18 P, [tigha / TAIGA](#), EU:C:2019:1139, § 46, 51

### Use as a trade mark versus use as a company name – Definition of a subcategory of goods or services – Purpose or intended use of the product or service – Partial use

Where the use of a company name, trade name or shop name is limited to identifying a company or indicating a business, this use cannot be considered to be 'in relation to goods or services'. By

contrast, there is use 'in relation to goods' where the proprietor of the mark or a third party affixes the sign constituting its company, trade or shop name to the goods that it markets. Even where the sign is not affixed, there is use 'in relation to goods or services' where the sign is used in such a way that a link is established between the sign constituting the company, trade or shop name and the goods marketed or the services provided (§ 41-42).

Since consumers primarily search for products or services that meet their specific needs, the purpose or intended use of the product or service in question is vital in directing their choices. Therefore, the purpose or intended use of a product or service is of fundamental importance in the definition of a subcategory of goods or services (§ 79). Consequently, the BoA was right to find that the trade mark use for dried plums falls within the category of 'dried fruits' (§ 82) and use for tomatoes and broccoli falls within the category of 'fresh vegetables' (§ 84, 86).

13/10/2021, T-12/20, [Frutaria \(fig.\)](#), EU:T:2021:702, § 41-42, 79, 82, 84, 86

### **Most plausible and predictable interpretation of the specification of a trade mark**

When determining the extent of the protection of an earlier EU trade mark and assessing the evidence of genuine use of that mark in the context of Article 47(2) EUTMR, if two possible literal interpretations of the specification of that mark exist, but one of them would lead to an absurd result as regards the extent of the protection of the mark, the BoA must opt for the most plausible and predictable interpretation of that specification. It would be absurd to adopt an interpretation of the specification that would have the effect of excluding all of the opponent's goods, leaving only goods for which it has not sought trade mark protection as the goods protected by the earlier EU trade mark (§ 51).

Only when both possible literal interpretations of the list of goods and services designated by an earlier EU trade mark are each equally plausible and predictable, is it appropriate to apply the principle derived from the judgment of 06/04/2017, T-39/16, NANA FINK (fig.) / NANA, EU:T:2017:263, § 48, that the proprietor of an EU trade mark should not gain from the infringement of its obligation to indicate the goods and services with clarity and precision (§ 60).

17/10/2019, T-279/18, [AXICORP ALLIANCE / ALLIANCE et al.](#), EU:T:2019:752, § 51, 60

### **Means of evidence – Undated evidence – Scope of protection**

Undated evidence of use such as labels, photographs of shop windows and posts on social media may be intended to show the range of goods in respect of which the registered mark was used and how that mark was displayed on the contested goods, and therefore do not need to be dated (§ 45).

08/07/2020, T-686/19, [Gnc live well](#), EU:T:2020:320, § 45

### **Proof of use – Scope of protection of *retail sales services***

The earlier Spanish mark was registered for *retail sales services* before the Praktiker judgment (07/07/2005, C-418/02, Praktiker, EU:C:2005:425), which required clarification of the services but did not apply retroactively. There had been a request for proof of use and the BoA found use for *retail services for handbags, purses and wallets made from leather, ready-made clothing and footwear*.

The GC stated that the term 'retail sales services' is not a vague term and covers the retail sale of any goods (§ 39) and endorsed the BoA's finding of proof of use for *retail services for handbags, purses and wallets made from leather, ready-made clothing and footwear* (§ 40-41).

26/03/2020, T-653/18, [GIORGIO ARMANI le Sac 11 \(fig.\) / LESAC et al.](#), EU:T:2020:121, § 39, 40-41

26/03/2020, T-654/18, [le Sac 11 \(fig.\) / LESAC et al.](#), EU:T:2020:122, § 39, 40-41

### **Proof of use for accessories of goods classified in different classes of the Nice Classification**

The proprietor is not required to prove genuine use of the trade mark based only on the formal interpretation of the Nice Classification for accessories of goods that are classified in different classes but, in reality, concern the same goods (§ 34). The Nice Classification is, in essence, designed to reflect the needs of the market and not to impose an artificial segmentation of the goods (§ 40).

28/05/2020, T-681/18, [Stayer \(fig.\)](#), EU:T:2020:222, § 40

### **Proof of use – Irrelevance of the classification of goods according to other rules of EU law**

The contested mark has been put to genuine use in connection with the goods for which it was registered, namely *pharmaceutical products administered by injection for use in moisturising skin and reducing wrinkles* in Class 5 (§ 29-32). The fact that these goods are not classified as *pharmaceuticals*, that is to say *medicines*, registered and authorised in accordance with Directive 2001/83/EC on the Community code relating to medicinal products for human use, but rather as *other preparations for medical use*, within the meaning of that class, namely *injectable dermal fillers*, regulated by Directive 93/94 is irrelevant. The classification of goods according to other rules of EU law, such as that of guaranteeing the quality of the goods, is not in principle decisive with regard to their classification for the purposes of the registration of an EU trade mark (§ 27-28).

25/06/2020, T-104/19, [Juvéderm](#), EU:T:2020:283, § 27-32

18/11/2020, T-643/19, [JUVEDERM ULTRA](#), EU:T:2020:549, § 28

### **Proof of use – Affixing of a trade mark in publications – Scope of protection**

The affixing of a trade mark to a magazine, periodical, review, journal or catalogue is, in principle, capable of constituting ‘valid use of the sign’ as a trade mark for the goods and services designated by that mark if the content of the publications confirms use of the sign for goods and services covered by it (05/02/2020, T-44/19, [TC Touring Club \(fig.\) / TOURING CLUB ITALIANO et al.](#), EU:T:2020:31, § 67) (§ 51).

08/07/2020, T-533/19, [sflooring \(fig.\) / T-flooring](#), EU:T:2020:323, § 51

### **Proof of use – Catalogues – Scope of protection – Homogenous subcategories of goods**

Unlike the catalogues in the present case, the catalogues submitted in ‘peerstorm’ (08/07/2010, T-30/09, [Peerstorm](#), EU:T:2010:298) were intended for end consumers, contained clear and precise information on the items available, their prices, the shops in which they were sold, and how they were marketed. Therefore, those catalogues alone provided sufficient information as to the place, time, nature and extent of the use of the earlier mark (§ 45-46).

The goods *leather and imitation of leather; animal skins, hides* designate raw or semi-finished goods: photographs of bags, which are finished goods, cannot constitute evidence of use in that regard (§ 53).

Men and women’s denim jeans were the only items of clothing in Class 25 for which there were invoices and evidence of use showing the goods with the signs at issue affixed: insofar as those goods constitute a consistent and homogenous subcategory, the BoA rightly carried out its examination for that specific subcategory (§ 90).

28/05/2020, T-615/18, [D \(fig.\) / D \(fig.\) et al.](#), EU:T:2020:223, § 45-46, 53, 90

### **Proof of use – Affixing of a trade mark on a magazine, periodical, review, journal or catalogue – Irrelevance of criteria linked to commercial success or economic strategy – Territorial scope**

The affixing of a trade mark to a magazine, periodical, review, journal or catalogue is, in principle, capable of constituting ‘valid use of the sign’ as a trade mark for the goods and services designated by that mark if the contents of those publications confirm the use of the sign for the goods and services covered (§ 94). The requirement of genuine use does not seek to assess commercial success or to review the economic strategy of an undertaking. Likewise, it is not intended to restrict trade mark protection to cases where large-scale commercial use has been made of the marks (§ 96-99). For use of an EUTM to be deemed genuine, it is not required that that mark be used in a substantial part of the EU (§ 100).

09/02/2022, T-589/20, [Maimai made in Italy / Yamamay](#), EU:T:2022:59, § 94, 96-100

### **Proof of use – Purchasing process**

While it is true that the consumers will display a high level of attention when purchasing computers and computer accessories in Class 9, which are highly technical and innovative goods, the applicant has not demonstrated that such consideration would have led to find that the consumers would examine the packaging in any detail and that they would pay particular attention to the contested marks (§ 71, 72).

The goods in Class 9, in particular computers and computer accessories, may be purchased in various ways, including ways in which the relevant public will not be able to inspect their packaging prior to purchase (§ 73, 74).

08/06/2022, [Joined Cases T-26/21, T-27/21 and T-28/21, Think different](#), EU:T:2022:350

### **Means of evidence – Invoices**

It is a common commercial practice that invoices do not contain graphical elements of the trade marks and that the identification of the goods are limited to verbal indications. In case that the evidence of proof of use contain invoices and depictions of the goods, it suffices that the whole mark, with its figurative element and its word element, appears on the packaging and goods and that, with the aid of the codes appearing on the invoices, it is possible to link those invoices to that packaging and those goods (§ 91).

27/04/2022, T-181/21, [SmartThinQ \(fig.\) / SMARTTHING \(fig.\)](#), EU:T:2022:247, § 91

### **Genuine use in relation to goods and services – Advertisement and offer for sale**

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

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

### **Proof of use – Broadcasting services – Production of television programmes, production of shows and film production – Publication**

The fact that an undertaking is responsible for the content of its television channels (for how its logo and trade marks appear on those channels and for the advertising which is broadcast there) does not lead to the conclusion that it provides television and radio broadcasting services in Class 38 (§ 41). While the broadcasting of television programmes on the internet has become

commonplace and a trade mark could, for example, be used as an internet domain name to provide access to various television content on the internet, as a service in Class 38, there is no evidence in the file to demonstrate that the applicant provides such a service under the contested mark. Conversely, it is apparent that the BALLON D'OR sign is used as the name of the television programme broadcast on the internet, by means of a broadcasting service provided not by the applicant but by a third party. (§ 43)

The fact that a service intended to entertain the public is provided in the form of a competition, which includes the award of a trophy to reward a person's sporting performance, does not deprive it of its basic recreational and entertaining nature (§ 58).

Production of television programmes, production of shows and film production in Class 41 are services consisting in the editing of television programmes. These services are directed at professionals in the audio-visual sector (in particular, writers and directors of films) (§ 66). The applicant's production of the 'Ballon d'Or' event with a view to it being broadcast on television and on the internet is an act of exploitation of the service rendered by the applicant, which consists in organising that competition and is not, as such, trade mark use for production services (§ 68).

A mark used in connection with publication of books, magazines and newspapers does not concern the content of the publication, but the production and promotion of any book or content in order to create or preserve outlets on the market for those services. The recipients of those services are the authors or agents who want their work to be published (§ 74).

[06/07/2022, T-478/21, Ballon d'or, EU:T:2022:419](#)

#### **Nature of use – Affixing of trade mark on transport cases**

The affixing of a mark on the packaging containing the goods covered by that mark may constitute proof of genuine use of that mark. The case-law does not distinguish between the different types of packaging (§ 80, 82). The relevant public here consists not only of end users but also of distributors of the goods covered by that mark, who are among those in contact with those cases (§ 83).

[14/09/2022, T-609/21, Steam, EU:T:2022:563](#)

#### **Use in relation to goods – Means of evidence – Invoices**

Where, in addition to invoices that show the goods immediately followed by a (weak) word element constituting the earlier mark, without clearly identifying it as a trade mark, there is also other evidence, on which that word element is clearly identifiable as a trade mark, these invoices can be considered to refer to the goods covered by the mark (§ 53).

[01/03/2023, T-102/22, Gourmet \(fig.\) / Gourmet, EU:T:2023:100](#)

#### **Use in relation to goods – Assessment of descriptive use**

The CJ judgment ([31/01/2019, C-194/17 P, Cystus, EU:C:2019:80](#)), according to which an element of a mark could be used as descriptive, is not applicable in a case where it has been assumed that the earlier mark was descriptive before examining the evidence (§ 55, 56).

[01/03/2023, T-102/22, Gourmet \(fig.\) / Gourmet, EU:T:2023:100](#)

#### **Proof of use – Probative value – No hierarchy of the evidence**

Greater importance, or even greater probative value should not be given to the evidence concerning the goods and their packaging, to the detriment of the other evidence submitted.

Article 10(4) EUTMDR does not provide for any hierarchy between the various items of evidence (§ 61, 62).

[01/03/2023, T-102/22, Gourmet \(fig.\) / Gourmet, EU:T:2023:100](#)

### **No genuine use – Means of evidence – Reference to the mark in invoices**

The invoices, which do not contain the earlier word mark, but only mention serial numbers and indications that cannot be cross-referenced to other evidence such as a catalogue, do not enable the identification of goods bearing the earlier mark and, therefore, do not prove genuine use of that mark (§ 29-30, 33).

[22/03/2023, T-408/22, SEVEN SEVEN 7 \(fig.\) / Seven, EU:T:2023:157](#)

### **Proof of use – Reference to the mark in invoices**

Although the invoices do not include the mark at issue next to the name of each of the goods listed therein, this is not sufficient to deprive them of all relevance. However, for constituting relevant evidence of use of the contested mark, the invoices must actually concern the goods for which the mark has been registered, and it must be established that those goods bore the contested mark or, at least, that that mark was used publicly and outwardly, for the purpose of selling those goods to consumers (§ 78-79). Article 10 EUTMDR gives examples of acceptable evidence by referring to packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements and statements in writing. The proprietor of the contested mark cannot be required, in all cases, to submit each of the items of evidence that are referred to as examples in that provision (§ 83).

[01/03/2023, T-552/21, Camel, EU:T:2023:98](#)

### **Genuine use – Mark not affixed to the goods – Affixing on invoices and promotional materials**

Although the earlier mark is not affixed to the goods or their packaging, its use on price lists, promotional material, and invoices, might be sufficient to demonstrate genuine use of that mark (§ 31-34).

[12/07/2023, T-27/22, th pharma \(fig.\) / Th \(fig.\), EU:T:2023:390](#)

### **No genuine use – Broad category of goods and services – IT services**

To maintain the contested mark for *IT services; design and development of computer software* in Class 42, which are extremely broad terms, the trade mark proprietor needed to show that it offered a wide range of IT and software services for all imaginable types of undertakings. Otherwise, the proof of use would need to be sufficiently specific to be able to build appropriate subcategories for those broad terms (§ 47).

Mere indications like 'Yomvi', 'JavaScript Engineer Volia' or 'software' on only five invoices are insufficient in that regard. Additionally, the commercial offers filed are unsigned and confidential and no contract resulting from them has been annexed or even mentioned. Photographs of international trade fairs and an extract of a search made thorough a search engine do not provide sufficient information to prove that the services invoiced may be regarded as IT services or computer software design and development services (§ 48).

[06/09/2023, T-601/22, OPTIVA MEDIA \(fig.\), EU:T:2023:510](#)

### **Genuine use – Stand-alone use of the sign**

Where the earlier mark has been affixed independently on the top of the cap or lid of cosmetic products in order to display the identity of the origin of those goods to consumers who could see only that cap or that lid, the mark has been used as a stand-alone mark, and not only in combination with other elements. Therefore, the intended commercial use of that mark could be regarded as having been made in the course of trade (§ 33-41).



[07/02/2024, T-74/23, DEVICE OF A STYLISED O \(fig.\) / DEVICE OF A STYLISED O \(fig.\) et al., EU:T:2024:60](#)

### **Genuine use – Use on social media**

The earlier mark was used as such on social media in a way that was particularly visible not only to subscribers, but also to visitors. The accounts that referred to the earlier mark on social media were often viewed on small screens, such as those of smartphones, on which there was not much space, and therefore the accounts favoured the stand-alone use of that mark, without verbal elements (§ 44-45). In the context of the analysis of genuine use, the presence on social media constitutes a relevant factor, since it is a means that is commonly used in order to promote and even sell cosmetic products in the economic sector concerned (§ 46). It is necessary to assess the scope of the use of the earlier mark on social media, in particular in order to determine whether that use made it possible to associate the goods that appeared on those media with the undertaking that marketed them (§ 47).

[07/02/2024, T-74/23, DEVICE OF A STYLISED O \(fig.\) / DEVICE OF A STYLISED O \(fig.\) et al., EU:T:2024:60](#)

## **3 PLACE OF USE**

### **Territorial scope of use**

Article 42(2) and (3) CTMR [now Article 47(2) and (3) EUTMR] and Rule 22 CTMIR [now Article 10(3) EUTMDR] do not require proof of genuine use in a substantial part of the relevant territory (§ 37, 41).

[04/04/2019, T-779/17, VIÑA ALARDE / ALARDE, EU:T:2019:220, § 37, 41](#)

### **Territorial scope of use**

In certain circumstances, the proof of genuine use can be restricted to the territory of a single Member State. That may, in particular, be the case for the pharmaceutical market, which is characterised by a system of marketing authorisation and certification of protection which may be issued on a national basis (§ 43).

[06/03/2019, T-321/18, NOCUVANT/ NOCUTIL et al., EU:T:2019:139, § 43](#)

### **Territorial scope of use**

The territorial scope is only one of several factors that have to be taken into account in assessing whether use of an EU trade mark is genuine. A *de minimis* rule for establishing whether that factor is satisfied cannot be laid down. It is not necessary that an EU trade mark be used in an extensive geographic area for the use to be deemed genuine, since such a qualification will depend on the characteristics of the goods or services concerned on the corresponding market and, more generally, on all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered (19/12/2012, C-149/11, Onel / Omel, EU:C:2012:816, § 55) (§ 80).

It is not required either that the EUTM be used in a substantial part of the European Union. The possibility that the mark may have been used in the territory of a single Member State must not be ruled out, since the borders of the Member States must be disregarded and the characteristics of the goods or services concerned must be taken into account (§ 80).

07/11/2019, T-380/18, [INTAS / INDAS \(fig.\) et al.](#), EU:T:2019:782, § 80

#### **Territorial scope of use – US Department of Defense and US military bases in the EU**

Sales of goods to the US Department of Defense and the US State Department for military bases located in Belgium and Germany, which are not impressive and are likely to merely reflect the needs of the soldiers living on those military bases, are not capable of establishing the proprietor's intention to create a commercial outlet in the EU for the goods in question (§ 37).

28/10/2020, T-583/19, [Frigidaire](#), EU:T:2020:511, § 37

#### **Territorial scope of use – Small territory counterbalanced by length, periodicity and extent of use**

The fact that use of the earlier mark has been proved only in connection with small parts of Germany and France does not preclude that use from being genuine. This is particularly true because that use has been proved, not in a sporadic manner, but throughout almost the whole of the relevant period and to sufficiently significant quantities (§ 38).

24/11/2021, T-551/20; [Riviva / Rivella](#), EU:T:2021:816, § 38

#### **Place of use – Use of the trade mark 'in the Union' following 'Brexit'**

The use of an EU trade mark in the UK before its effective withdrawal from the EU constitutes use 'in the Union' for the purpose of establishing genuine use of that mark (§ 21-31).

09/03/2022, T-766/20, [Stones](#), EU:T:2022:123, § 21-31

#### **Territorial scope of use – Single Member State**

Use of an EUTM in a single Member State can be regarded as sufficient to constitute genuine use. Thus finding that there has been genuine use of a mark in a single Member State cannot be limited to cases in which the market for the goods or services for which a contested mark has been registered is restricted to the territory of that single Member State (§ 76).

In the context of an overall assessment of evidence and of the relevant factors, use of a trademark in a single Member State can be sufficient to be deemed to be genuine use in the EU (§ 78). In the present case, the relevant goods are not basic items but highly specialised goods aimed at a specialist professional public and are part of a small market segment. Consequently, the assessment of the criterion of territoriality of use cannot be applied (§ 81).

[01/06/2022, T-316/21, SUPERIOR MANUFACTURING \(fig.\), EU:T:2022:310](#)

#### **Territorial scope of use – No genuine use**

A large part of the evidence submitted relates to territories outside the EU (§ 65). It is not demonstrated that the evidence submitted concerning websites and social networks specifically targeted the EU market (§ 66). The sale of a few hundred bottles of tequila in the EU cannot be regarded as sufficient to prove genuine use of the earlier mark, given the size of the EU market and the nature of the goods at issue, which are relatively everyday consumer goods (§ 71).

Therefore, the use of the earlier mark, which can be qualified as symbolic or minimal, is insufficient to constitute genuine use (§ 74).

[22/06/2022, T-628/21, Revolution vodka /Tequila Revolucion, EU:T:2022:384](#)

### **Territorial scope of use – Use of the mark in the EU for services provided outside of the EU**

It cannot be inferred from the case-law of the Court that, given the fact that the services at issue (hotel services and ancillary services) are provided outside the relevant territory of the EU, the acts of use of the contested mark seeking to promote and to offer for sale such services are necessarily taking place outside that territory. A distinction shall be made between the place of those provisions of services and the place of use of the mark. Only the latter is relevant to examination of the genuine use of an EUTM. 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 (§ 34, 37, 38).

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

### **Genuine use in the UK prior to the UK's withdrawal from the EU**

No manifest error in finding that the suspension request (Rule 20(7)(c) CTMIR, now Article 71 EUTMD) was unfounded, in view of the fact that the UK was still a Member State of the EU during the relevant period for establishing genuine use of the earlier EUTM, with the result that the opponent was entitled to rely on its earlier EUTM and that its use in that country constituted use in a Member State of the EU (§ 36-41).

Use shown of the EUTM only in the UK qualifies as genuine use in the EU given that i) the UK was part of the EU throughout the relevant period and that ii) the territorial scope of the use is only one of several factors to be taken into account in the determination of whether it is genuine or not, a question which must be assessed globally taking account of all the relevant factors in the particular case, which implies some interdependence between the factors taken into account (§ 73).

[14/06/2023, T-200/20, Stone brewing / Stones et al., EU:T:2023:330](#)

## **4 TIME OF USE**

### **4.1 PERIOD OF TIME TO BE CONSIDERED IN OPPOSITION / INVALIDITY PROCEEDINGS**

#### **Application *ratione temporis* – Definition of relevant periods for proof of use in invalidity proceedings – Substantive rules – Date of filing of the contested EUTM**

In cancellation proceedings, the applicable substantial law is the law which was in force at the time of filing of the contested EUTM (§ 37). The provisions defining the relevant periods for which the genuine use of the earlier mark shall be proven must be considered as substantive rules (§ 39). Since the contested EUTM was applied for in 2007, the provisions applicable *ratione temporis* are Articles 56(2) and 43(2) Regulation no 40/94. Therefore, the first relevant period for which genuine use of the earlier mark must be proven is the period of 5 years preceding the date on which the contested EUTM application was published (§ 47-49).

[23/11/2022, T-515/21, Euphytos / EuPhidra \(fig.\), EU:T:2022:722](#)

See also, [01/03/2023, T-102/22, Gourmet \(fig.\) / Gourmet, EU:T:2023:100](#), § 16-20

### **Application *ratione temporis* – Definition of relevant period for proof of use in opposition proceedings – Substantive rules – Date of filing of the contested EUTM application**

In opposition proceedings, the applicable substantial law is the law which was in force at the time of filing of the contested EUTM application. Since the contested EUTM application was applied for in 2015, the provisions applicable *ratione temporis* are Article 8(1)(b) and Articles 42(2) and (3) Regulation No 207/2009 (§ 18-19). Therefore, the relevant period for which genuine use of the earlier mark must be proven is the period of 5 years preceding the date on which the contested EUTM application was published, and not from the filing date (§ 43-44).

[24/01/2024, T-55/23, SALVAJE \(fig.\) / SALVANA, EU:T:2024:30](#)

## **4.2 PERIOD OF TIME TO BE CONSIDERED IN REVOCATION PROCEEDINGS**

### **Definition of relevant periods – Article 57(2) and (3) CTMR [now Article 64(2) and (3) EUTMR]**

In the context of invalidity actions, the contested mark holder may request the applicant for invalidity to submit proof that an earlier mark had been genuinely used during two distinct periods (although they may overlap), that is, firstly, 'during the period of five years preceding the date of the application for a declaration of invalidity', and secondly, during the period of five years preceding the *date of filing* or the priority date of the contested mark, provided the earlier mark was already registered for more than five years on this date, Article 57(2) and (3) CTMR [now Article 64(2) and (3) EUTMR]. The Office is not required to determine the relevant periods for the proof of use and to inform the invalidity applicant of them. It is therefore the invalidity applicant's responsibility to determine the relevant period(s) during which genuine use must be proved (§ 33). If the BoA finds an error by the CD in calculating the relevant periods, it cannot base its decision on a lack of genuine use of the earlier marks for a period that was never discussed by the parties and on which they had no opportunity to comment or to submit evidence at any stage of the proceedings before the Office (§ 39).

[20/03/2019, T-138/17, PRIMED / GRUPO PRIM \(fig\) et al., EU:T:2019:174, § 33, 39](#)

### **Definition of relevant periods**

Article 57(2) CTMR [now Article 64(2) EUTMR], must be considered a substance provision as regards the definition of periods where genuine use must be proven (§ 20). The second relevant period must be calculated from the date of the first publication of the international registration (§ 40).

[06/06/2019, T-220/18, Battistino \(fig.\) / BATTISTA et al., EU:T:2019:383, § 40](#)

[06/06/2019, T-221/18, BATTISTINO / BATTISTA et al., EU:T:2019:382, § 40](#)

### **Preliminary ruling – Article 51(1)(a) CTMR [now Article 58(1)(a) EUTMR] – Counterclaim – Revocation for non-use – Expiry of the period of five years – Date of assessment**

Article 51(1)(a) CTMR must be interpreted as meaning that, in the case of a counterclaim for the revocation of rights in an EU trade mark, the relevant date for the purposes of determining whether the continuous five-year period referred to in that provision has ended is the date on which that counterclaim was filed (§ 51).

[17/12/2020, C-607/19, Husqvarna, EU:C:2021:61, § 51](#)

## 4.3 USE OUTSIDE THE RELEVANT PERIOD

### Consideration of circumstances after the relevant period

For assessing genuine use during the relevant period, it is not ruled out that account may be taken of circumstances after that period. Such circumstances may make it possible to confirm or better assess the extent to which the trade mark was used during the relevant period (§ 65-69).

*03/10/2019, T-666/18, [ad pepper \(fig.\)](#), EU:T:2019:720, § 65-69*

### Means of evidence – Consideration of documents from just outside the relevant period

The commercial life of a product generally extends over a period of time, and continuity of use is one of the indications to be taken into account to establish that the use was objectively intended to create or maintain a market share. Therefore, documents from outside the relevant period must be taken into account and assessed together with the other evidence, as they may provide evidence of real and genuine commercial exploitation of the mark (16/06/2015, T-660/11, POLYTETRAFLON / TEFLON, EU:T:2015:387, § 54 and case-law cited) (§ 36).

*10/11/2021, T-353/20, [ACM 1899 AC MILAN \(fig.\) / Milan et al.](#), EU:T:2021:773, § 36*

### Means of evidence – Documents from just outside the relevant period – Consideration in combination with other evidence for extent of use

Provided that there is proof of use which relates to the relevant period, the documents from just outside that period, far from being irrelevant, can be taken into account and evaluated together with the rest of the evidence, since they can offer proof of real and genuine commercial exploitation of the mark (§ 46).

*08/07/2020, T-686/19, [Gnc live well](#), EU:T:2020:320, § 46*

### Means of evidence – Documents from outside the relevant period – No consideration for extent of use

When assessing genuine use of an earlier mark, account may be taken, where appropriate, of evidence produced after the relevant date, in order to better assess the extent of use of the earlier mark during the relevant period (28/02/2019, T-459/18, PEPERO original (fig.) / REPRÉSENTATION D'UN BATÔNNET (fig.), EU:T:2019:119, § 63). However, a sales volume assessment cannot be called into question by taking into account invoices that postdate the relevant period by 3 months (§ 56).

*08/07/2020, T-533/19, [sflooring \(fig.\) / T-flooring](#), EU:T:2020:323, § 56*

### Means of evidence – Consideration of proof of use outside the relevant period

The consideration of evidence relating to use made before or after the relevant period is possible, insofar as it makes it possible to confirm or better assess the extent to which the contested mark was used and the actual intentions of the proprietor during that period. However, this evidence can be taken into consideration only if other evidence relating to the relevant period has been produced (§ 27).

*15/03/2023, T-194/22, [zelmotor \(fig.\)](#), EU:T:2023:130*

## 5 EXTENT OF USE

### Extent of use – Pharmaceutical market

The requirement of genuine use is not intended to assess commercial success or to review the economic strategy of an undertaking (§ 49). The use of the earlier mark need not always be quantitatively significant in order to be deemed genuine. A low turnover attained in the EU pharmaceutical market can be considered sufficient for proof of genuine use (§ 51).

06/03/2019, T-321/18, [NOCUVANT / NOCUTIL et al.](#), EU:T:2019:139, § 51

#### **Extent of use – Pharmaceutical market**

With regard to the proof of use submitted for the earlier mark, 74 invoices issued to more than 20 different companies located across Italy during the relevant period of 5 years for the sale of 'hair care lotions' for a total amount of approximately EUR 2 450, are considered sufficient, particularly taking into account that most of the invoices are addressed to companies operating pharmacies, which usually order goods on a regular basis in limited quantities (§ 52-54).

19/09/2019, T-359/18, [TRICOPID / TRICODIN \(fig.\)](#), EU:T:2019:626, § 52-54

#### **Extent of use – Means of evidence – Different types of evidence**

No rule of law requires that the proof of genuine use must consist of different types of evidence (§ 26). Genuine use can be proved by invoices only, provided they contain all the relevant indications required by Rule 22(3) CTMIR [now Article 10(3) EUTMDR], notably place, time, extent and nature of use (§ 27).

The differences between the volume of capsules and labels purchased and the number of bottles sold reinforces the assumption that the evidence submitted represents only a sample of invoices (§ 54).

A small volume of products marketed, notably 1 200 bottles of wine for a total value of EUR 4 200 can be considered sufficient to prove actual commercial activity (§ 55, 58-59).

04/04/2019, T-779/17, [VIÑA ALARDE / ALARDE](#), EU:T:2019:220, § 27, 54, 55, 58-59

#### **Extent of use – Means of evidence – Catalogue**

While a catalogue is not evidence of sales, it is, however, proof that the goods in question have been placed on the market and that those goods have actually been offered for sale to consumers (§ 31).

27/06/2019, T-268/18, [Luciano Sandrone / DON LUCIANO](#), EU:T:2019:452, § 31

#### **Extent of use – Means of evidence – Catalogues**

It does not follow from the judgment Peerstorm (08/07/2010, T-30/09, Peerstorm, EU:T:2010:298), that the mere production of evidence such as catalogues is sufficient per se to establish a certain extent of use of an earlier right. As is apparent from paragraphs 41 to 44 of that judgment, the evidence produced in connection with that case, which consisted essentially of catalogues, was plentiful, displayed the mark concerned on the goods it covered, referred to a large number of items and demonstrated that they were available in 240 stores in the United Kingdom during a significant part of the relevant period. In addition, those catalogues contained specific information about the goods offered for sale under that mark, such as their price and the way in which they were marketed. It was on the basis of that evidence that the GC found in that case that the abovementioned catalogues sufficiently demonstrated the use of the earlier right for the goods covered by it (§ 33).

08/09/2021, T-493/20, [Sfora wear / Sfera \(fig.\) et al.](#), EU:T:2021:540, § 33

#### **Extent of use – Means of evidence – Affidavit**

Genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark in the market concerned. An affidavit must be corroborated by other credible and objective evidence (§ 32, 41, 47, 53-54, 61).

22/09/2021, T-591/19, [Healios \(fig.\) / HELIOS](#), EU:T:2021:606, § 32, 41, 47, 53-54, 61

#### **Extent of use – Means of evidence – Market for high-end sports cars with technical specifications**

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

23/09/2020, T-677/19, [SYRENA](#), EU:T:2020:424, § 70-71

#### **Extent of use – Expensive luxury products – Restricted market**

Coffee is a widely consumed product that can be sold in the entire territory of the EU and is not, in principle, an expensive, luxury product, or a product sold in limited quantities in a restricted market (§ 60).

06/06/2019, T-220/18, [Battistino \(fig.\) / BATTISTA et al.](#), EU:T:2019:383, § 60

#### **Extent of use – Means of evidence – Sufficient overall volume of income provided by the invoices in relation to the unit price of the goods**

The overall volume of income proved by the invoices, namely USD 34 733.82, cannot be regarded as token, considering the unit price of between USD 2.57 to USD 34.37 at which the contested goods are sold (§ 71).

08/07/2020, T-686/19, [Gnc live well](#), EU:T:2020:320, § 71

#### **Extent of use – Means of evidence – Use for *meet* which is not merely token**

The issuing of 17 invoices for a total amount of EUR 44 988.94, concerning various clients established in different EU countries (Germany, Spain and Sweden) and different Spanish regions (such as Andalusia and Catalonia), show use of the earlier mark which is not merely token for *meat* in Class 29 (§ 38-41).

23/09/2020, T-737/19, [MONTISIERRA huevos con sabor a campo \(fig.\) / MONTESIERRA](#), EU:T:2020:428, § 38-41

#### **Extent of use – Means of evidence – Genuine use of the mark**

The sale of approximately 2 700 timers over the entirety of the relevant period in 23 Member States may be considered sufficient as a means of maintaining or creating a market share for those goods. The fact that those sales were very regular and covered a broad territorial range offset the low volume of timers sold (§ 70-75 and case-law cited).

A sample of 100 application download requests submitted by the EUTM owner was considered sufficiently large and reliable to prove 1621 application download requests. This is not a token

volume and can be viewed as a means of maintaining or creating market shares for downloadable software applications (§ 79-80, 84-85).

19/01/2022, T-76/21, [Pomodoro](#), EU:T:2022:16, § 70-75, 79-80, 84-85

#### **Extent of use – Means of evidence – Lack of proof of genuine use**

The proprietor did not demonstrate genuine use of the contested mark for *sport bags* in Class 18 and *clothing items* in Class 25. In particular, for *ski bags*, most of the evidence was undated and turnover figures were not provided for specific goods but in an overall manner. For *tennis bags*, proven sales of only 34 bags for a total of EUR 675 to two customers in two Member States were considered too low, particularly for mass consumption products, with no advertisement expenditure provided, undated photos and turnover unspecified for the goods. As for *clothing items*, there was just a single sale of one leather jacket for a total of EUR 200, with undated photos and an unspecified turnover for the goods (§ 55, 41-50, 68-69).

14/07/2021, T-65/20, [Kneissl](#), EU:T:2021:462, § 55, 41-50, 68-69

#### **Extent of use – Means of evidence – Seasonal products – Lack of proof of genuine use**

The evidence submitted is not sufficient to prove that the contested trade mark was put to genuine use in respect of the goods during the relevant period (§ 46). This is not called into question by the applicant's argument that less stringent requirements must be placed on the proof of genuine use of the contested trade mark due to the seasonal nature of its use, because the sausages for which the trade mark is used are sold only as seasonal products during Halloween. Even assuming that the seasonal use of the contested trade mark affects the duration of its use and the duration of the periods to be taken into account, no less stringent requirements are to be established with regard to the extent of use. The applicant did not submit pertinent evidence to prove genuine use of its trade mark at least from September to November each year during the relevant period (§ 47).

10/11/2021, T-500/20, [Hallowiener](#), EU:T:2021:768, § 46-47

#### **Extent of use – Means of evidence – Evidence outside the relevant period – Proof of actual sales – Nature of goods – Lack of proof of genuine use**

It is possible to consider evidence that relates to use of the mark made before or after the relevant period, where this information makes it possible to confirm or better assess the extent to which the mark was used and the actual intentions of the proprietor during that period. However, this evidence can only be taken into consideration if other evidence relating to the relevant period has been produced (§ 44-45). Although evidence that does not relate to the relevant period may be taken into account and assessed in conjunction with other evidence to further substantiate proof of real and genuine commercial use of the mark, this does not mean that proof of genuine use of the mark can be based solely on evidence that does not relate to the relevant period (§ 49).

The extracts from the website 'Amazon.co.uk' merely show that the goods in question were offered for sale, but do not prove that they were actually sold and do not provide any information regarding the volume of sales. Even assuming that some of the goods were actually sold on the internet during the relevant period, since the extracts from the website 'Amazon.co.uk' do not quantify the volume of sales, they do not prove that there was a sufficient volume of sales (§ 57-58).

In light of the nature of the goods, which are everyday consumer goods, and of their modest price, the sale of only 18 items bearing the contested mark at the end of the relevant period cannot be considered to be sufficient to prove genuine use of the mark (§ 59). The smaller the commercial

volume of the use of the mark, the greater the necessity for the proprietor of the mark to produce additional evidence to dispel any doubts as to the genuineness of its use (§ 64).

13/10/2021, T-1/20, [Instinct](#), EU:T:2021:695, § 44-45, 49, 57-59, 64

### **Proof of use in the case of trade mark transfer**

The transfer of a mark cannot lead to its new proprietor being deprived of the opportunity to adduce proof of genuine use of the mark in the course of the relevant period during which they were not the proprietor of the mark. Any contrary finding would expose the new proprietor to the risk of revocation of their acquired rights without being able to benefit from the legitimate protection derived from the use of that mark by the former proprietor, or a third party with their consent, during the earlier relevant period prior to acquisition of the rights by the new proprietor (§ 30).

13/10/2021, T-12/20, [Frutaria \(fig.\)](#), EU:T:2021:702, § 30

### **Extent of use – Low volumes of sales in a mass consumption sector**

Modest volumes of sales made under the mark in a mass consumption 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 (§ 66, 67).

09/03/2022, T-766/20, [Stones](#), EU:T:2022:123, § 66-67

### **Extent of use**

The alleged descriptiveness of the earlier trade mark is not relevant when determining whether that mark has been put to genuine use (§ 53).

The goods which have the entry 'bonus' and a price of zero euros in the invoices submitted as evidence of use are not irrelevant (§ 77).

Unless established by the parties it is not necessary to prove that the earlier mark appears on specific places of the goods concerned, in this case on the doors of the three models of refrigerator referred to in the invoices. It is sufficient for it to be proved that the earlier mark was actually used on the goods as such (§ 79).

27/04/2022, T-181/21, [SmartThinQ \(fig.\) / SMARTTHING \(fig.\)](#), EU:T:2022:247, § 53, 77, 79

### **Extent of use – No invoices**

Submission of catalogues, brochures and other documents may be sufficient to prove genuine use, even where direct sales have not been established by invoices (§ 90).

[22/06/2022, T-329/21, Fraas, EU:T:2022:379](#)

### **Extent of the use – Frequency of the use**

The frequency of use is an essential factor to be taken into account when assessing the extent of use of a trade mark. The trade mark proprietor has neither argued nor established that the services provided had any special characteristics, for example that they were intended for a limited public, so that the small number of acts of use can be justified. Therefore, the limited number of acts of use cannot be justified as being sufficient to be classified as genuine in the economic sector concerned (§ 43).

[07/09/2022, T-699/21, My boyfriend is out of town, EU:T:2022:528](#)

### **Extent of the use – Vague and general economic data**

The figures provided by the trade mark proprietor are particularly vague and general and do not allow for an assessment of the extent of the use of the contested mark. No verifiable information nor concrete evidence has been provided to justify the use of its mark during the relevant period. In these circumstances, it cannot be inferred from the evidence that the mark has been put to genuine use (§ 46).

[07/09/2022, T-754/21, bâoli \(fig.\), EU:T:2022:529](#)

### **Proof of use – Extent of use – Affidavit – Supplying invoices – Examination of evidence of use – Retail services**

Evidence other than the affidavit shall not be considered on its own, without that affidavit, when establishing the extent of use of the earlier mark. The affidavit has to be examined in conjunction with other evidence. Otherwise, the affidavit is deprived of any evidential value (§ 60).

Supplying invoices do not generally contain information relating to the appearance of the product. Furthermore, it is common ground that such invoices cannot, on their own, demonstrate that the goods ordered were actually distributed to end consumers. However, when the references in such type of invoices correspond to the products which appear both on the advertisement magazines and on the test packaging copies, with the result that a link between those items can easily be established, they could be seen as confirmation of products being ordered (§ 75, 76).

In case of an earlier trade mark registered for retail services, proof of genuine use is one of the ways to determine the precise goods covered by the retail services (§ 113).

[05/10/2022, T-429/21, Aldiano / Aldi et al., EU:T:2022:601](#)

### **No genuine use – Very low sales volumes – Non-profit organisation**

The sales figures attested by the invoices are too low and insufficient to exclude the use of the mark being merely token (§ 31). This conclusion cannot be called into question by the fact that the owner is a non-profit association and is not obliged to issue invoices (§ 36). Although not obliged to present evidence of every transaction occurred within the relevant period, the owner relying on invoices as evidence must submit invoices in such a quantity as to exclude the possibility of mere token use of the mark (§ 37). Moreover, the mere existence of licenses of the mark cannot per se confirm that there is genuine use of it in relation to the relevant goods, without further evidence (§ 45).

[12/10/2022, T-752/21, quis ut Deus \(fig.\), EU:T:2022:630](#)

### **Extent of use – Means of evidence – Catalogues – Well-known fact**

The EUTM proprietor owns a famous football team. It is a well-known fact in this field that the big clubs engage in merchandising, which usually contributes significantly to their income. In this context and even in the absence of any evidence of widespread use of catalogues, use of the contested mark for the goods which regularly appear in the 7 provided catalogues, which cover a considerable part of the relevant time period, can be deduced from an overall assessment of all the relevant aspects of the present case. While the submitted invoices do not refer to all of these goods regularly appearing in the catalogues, they are considered as merely exemplary. Moreover, the catalogues mention the EUTM proprietor's website, where these the goods can be purchased, and the various sales outlets, one of which is located directly in the EUTM proprietor's football

stadium (§ 40-45, 49). However, genuine use is not proven for the goods mentioned in less than 4 catalogues and covering at best a two-year period (§ 50).

[07/12/2022, T-747/21, Fohlenelf, EU:T:2022:773](#)

#### **Extent of use – Means of evidence – Seasonal products**

The fact that a product (*beach towels*) is mainly used in summer explains why it is not included in the catalogues for the autumn and winter seasons. In such a case, mention of the goods only in catalogues for the summer season which cover a large part of the relevant period is sufficient to prove genuine use of the contested mark (§ 61).

[07/12/2022, T-747/21, Fohlenelf, EU:T:2022:773](#)

#### **No genuine use – Limited editions**

Evidence that relates to a limited and therefore only temporary edition cannot prove genuine use for goods of daily consumption where there is no indication that the marketing of these goods under the contested mark is part of a broader economic strategy aiming at establishing or maintaining a market share (§ 71).

[07/12/2022, T-747/21, Fohlenelf, EU:T:2022:773](#)

#### **Genuine use – Extent of use – Mass consumption sector**

Even though it is true that lubricants are inexpensive goods of mass consumption, it is sufficient, in order to conclude that there has been genuine use of the earlier mark, to point out that its proprietor provided, by way of examples, proof of actual sales under the earlier mark covering most of the relevant periods and other evidence showing that he made significant efforts to market lubricants under that mark (§ 96).

[14/12/2022, T-636/21, eurol LUBRICANTS \(fig.\) / Eurollubricants, EU:T:2022:804](#)

#### **Genuine use – Extent of use – Mass consumption sector**

The characteristics of the market in question are among the factors which must be taken into account and where they are everyday consumer goods, it is necessary to assess the commercial volume of sales under the contested mark in the light of the size of the market in question. However, those factors also include the length of the period during which the acts of use occurred and the frequency of those acts. In the present case, while there is no doubt that the market for foodstuffs is a significant market in the European Union, it must also be stated that the intervener submitted a considerable number of invoices showing the sale of the goods at issue under the contested mark continuously throughout the relevant period to multiple retailers located in 16 Member States of the European Union with a sustained frequency. Therefore, it must be concluded that, first, the Board of Appeal took account of the various criteria designed to establish the extent of use of a mark, including the characteristics of the market for the goods at issue, and, secondly, it correctly applied those criteria in the present case (§ 111-114).

[14/12/2022, T-358/21, CIPRIANI FOOD \(fig.\), EU:T:2022:817](#)

#### **Proof of use – Means of evidence – Probative value of affidavits**

The existence of contractual links between two distinct entities does not, on its own, mean that the affidavit from one of those entities is not that of a third party, but that of a person having close links with the party concerned, such that it would diminish the probative value of that statement (§ 50).

[11/01/2023, T-346/21, Gufic, EU:T:2023:2](#)

### **Probative value of sworn statements subjects to possible criminal liability**

Although a statement may entail, in the case of a false statement, consequences in criminal law for its author under national law, as is the case for a sworn statement, this is not sufficient in itself to attribute it evidential value and is merely an indication that needs to be supported by further evidence (§ 39).

[15/03/2023, T-194/22, zelmotor \(fig.\), EU:T:2023:130](#)

### **No genuine use – Means of evidence – Affidavits**

The affidavits of the applicant's commercial director cannot have the same reliability and credibility as statements made by a third party or a person independent from the company in question. These affidavits are, therefore, not sufficient on their own and are merely an indication that must be confirmed by other evidence (§ 35).

[22/03/2023, T-408/22, SEVEN SEVEN 7 \(fig.\) / Seven, EU:T:2023:157](#)

### **Genuine use – Extent of use – Number of invoices provided**

Due to the high unit cost, a low number of invoices (five) constitutes use which, objectively, is such as to create or preserve an outlet for the goods at issue and entails a volume of sales which, in relation to the period and frequency of use, is not so low that it may be concluded that the use is merely token, minimal or notional for the sole purpose of preserving the rights conferred by the mark (§ 55).

[26/04/2023, T-546/21, R.T.S. ROCHEM Technical Services \(fig.\) / ROCHEM MARINE \(fig.\), EU:T:2023:221](#)

See also [26/04/2023, T-547/21, R.t.s. rochem technical services / ROCHEM MARINE \(fig.\), EU:T:2023:222, § 54](#); [26/04/2023, T-548/21, Rochem / ROCHEM MARINE \(fig.\), EU:T:2023:223, § 53](#); [26/04/2023, T-549/21, ROCHEM \(fig.\) / ROCHEM MARINE \(fig.\), EU:T:2023:224, § 54](#)

### **Proof of use – Probative value of affidavits**

When the BoA examines whether the information contained in an affidavit that comes from a manager of the party concerned is supported by other evidence, it must not confine itself to examining whether that evidence, on its own, without that affidavit, proves genuine use of the mark at issue. Proceeding in such a way would deprive the affidavit of any evidential value (§ 35). The fact that the affidavit did not come from the legal director and was not accompanied by an identity document is irrelevant if the applicant does not explain why those circumstances were relevant (§ 41).

[10/05/2023, T-437/22, bistro Régent \(fig.\) / Regent, EU:T:2023:246](#)

### **Proof of use – Invoices**

Invoices issued to the trade mark proprietor's sales companies cannot, on their own, demonstrate that the goods ordered were actually distributed to end consumers (§ 54).

[10/05/2023, T-437/22, bistro Régent \(fig.\) / Regent, EU:T:2023:246](#)

### **Proof of use – Invoices – Circumstance of the relevant business field – Supermarket retail**

Regarding the suppliers' invoices, in the supermarket retail business, it is a well-known fact that private label products are commonly manufactured by a third-party manufacturer and sold under the brand name of a retailer in the context of a contractual relationship. In such a situation, the retailer specifies the product, how it is packaged and the label, and pays to have it produced and delivered to its stores (§ 55).

[10/05/2023, T-437/22, \*bistro Régent \(fig.\) / Regent, EU:T:2023:246\*](#)

#### **Extent of use – No need to compare sales volumes with sales volumes throughout the EU**

A comparison of sales of footwear with the volume of the market for footwear throughout the EU would tend to underestimate the relative scale of the sales, without providing any specific justification as to the necessity of assessing the genuine use of the earlier mark in relation to all sales of footwear in the EU (§ 70).

[07/06/2023, T-63/22, \*BROOKS ENGLAND \(fig.\) / Brooks, EU:T:2023:312\*](#)

#### **Proof of use – Probative value of affidavits**

Where the probative value of the affidavit of the intervener's managing director is supported by other documents, the arguments based on the case-law finding that such a declaration could not, on its own, constitute sufficient proof of genuine use cannot succeed (§ 48).

[12/07/2023, T-325/22, \*Terylene / Terralene, EU:T:2023:397\*](#)

#### **Proof of use – Probative value of evidence – Irrelevance of the confidentiality status**

Whether or not evidence is confidential has no bearing on whether it contributes towards proving genuine use of the mark on the market concerned (§ 49).

[12/07/2023, T-585/22, \*Artresan, EU:T:2023:392\*](#)

#### **Proof of use – Overall assessment of evidence**

Although the evidential value of invoices concerning trade fairs issued by the EUTM proprietor and of photographs of the trade fairs is limited, the fact remains that they are additional relevant items of evidence that may be taken into account in the context of the overall assessment of whether the use of the earlier mark is genuine, since those items of evidence are accompanied by the relevant sales invoices (§ 41). It is not necessary for each item of evidence to give information about all four elements to which proof of genuine use must relate, namely the place, time, nature and extent of use (§ 49).

[06/09/2023, T-45/22, \*Yippie! / Yuppie et al., EU:T:2023:513\*](#)

#### **Proof of use – Probative value of undated evidence**

Undated evidence can be taken into account as part of the overall assessment of documents, in combination with other evidence dated from the relevant period (§ 44).

[20/12/2023, T-27/23, \*THE FEED, EU:T:2023:856\*](#)

#### **Proof of use – Probative value of evidence**

Evidence consisting of excerpts and photos assembled by the party for the purpose of the proceedings does not lack probative value on the grounds that it would be a 'montage' created by that party, unless these documents were found to have been modified (§ 44).

[20/12/2023, T-27/23, THE FEED, EU:T:2023:856](#)

#### **Genuine use – Means of evidence – Goods depicted in drawings – Invoices**

The fact that the evidence depicting the product in question is undated does not preclude the possibility of cross-referencing the invoices produced with the article numbers or the description of the goods in question in order to establish the sales figures for those goods during the relevant period. Moreover, the fact that the product is represented graphically and not photographically is not sufficient to invalidate the assessment of the proof of use based on the description of the product or on its article number (§ 90-91).

[24/01/2024, T-562/22, NOAH \(fig.\), EU:T:2024:23](#)

#### **Extent of use – Low volumes of sales in the clothing sector – Marketing strategy**

In light of the relatively constant marketing of the goods over a period of three years and the marketing strategy consisting of a limited edition of clothing, the relatively low volume of sales of the goods (127 sweaters) does not prove that the use is merely token (§ 106).

[24/01/2024, T-562/22, NOAH \(fig.\), EU:T:2024:23](#)

#### **Unfounded argument on the lack of a piece of evidence – Principle of unfettered adduction of evidence**

It follows from the principle of the unfettered adduction of evidence that the EU judicature must rule on the merits of the action on the basis of evidence that is freely and actually produced by the parties and not by drawing conclusions from the failure to produce a specific piece of evidence, such as information on the royalties received by a trade mark proprietor from its licensee (§ 107).

[24/01/2024, T-562/22, NOAH \(fig.\), EU:T:2024:23](#)

#### **Genuine use – Means of evidence – Invoices**

The relevance of invoices cannot be questioned only on the ground that they were issued by the proprietor of the mark (§ 48).

[07/02/2024, T-792/22, WOXTER \(fig.\), EU:T:2024:69](#)

## **6 USE OF THE MARK IN FORMS DIFFERENT FROM THE ONE REGISTERED**

### **6.1 ADDITIONS**

#### **Use as registered – Joint use with another trade mark**

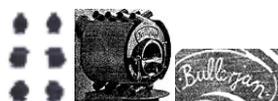
The fact that the relevant public acknowledges the earlier mark, by referring to another mark designating the same products, and which is used jointly, does not mean that the earlier mark itself is not used as a source of identification (§ 74).

The condition of genuine use of a trade mark may be fulfilled when it is used in conjunction with another trade mark, provided that the mark continues to be regarded as an indication of the origin of the product in question (§ 97).

[28/02/2019, T-459/18, PEPERO original \(fig.\) / REPRÉSENTATION D'UN BATÔNNET \(fig.\), EU:T:2019:119, § 74, 97](#)

### Use not as registered – Joint use of a shape mark with a word mark

The use of a three-dimensional mark consisting of the shape of an oven together with the word mark Bullerjan is liable to alter the distinctive character of the shape mark unless the word part of the mark is comparatively less distinctive. This was not the case because it was found that the shape was particularly unusual, partly due to functional characteristics which contributed to its distinctive character (§ 31-34, 40-45).



23/01/2019, C-698/17P, [SHAPE OF AN OVEN \(3D MARK\)](#), EU:C:2019:48, § 31-34, 40-45

### Use as registered – Graphic additions for words marks

Word marks are considered to be used as registered insofar as the graphic additions do not alter the general impression that they produce (§ 42).

27/06/2019, T-268/18, [Luciano Sandrone / DON LUCIANO](#), EU:T:2019:452, § 42

### Use as registered – Use of the word mark in a figurative form

Use of the earlier mark in the figurative form complies with Article 18(1)(a) EUTMR. The graphic characteristics are not able to significantly alter the distinctive character of the word 'YAMAMAY' (§ 82-86).

09/02/2022, T-589/20, [Maimai made in Italy / Yamamay](#), EU:T:2022:59, § 82-86

### Use as registered – Addition of the company name

The fact that the company name or the trade name of the proprietor of the earlier mark is also depicted in the representation of that mark is not such as to alter its distinctive character, since the earlier mark may clearly be perceived independently in a form that does not differ from that in which it is registered (§ 34).

21/11/2019, T-527/18, [tec.nicum \(fig.\) / T TECNIUM \(fig.\)](#), EU:T:2019:798, § 34

### Use as registered – Registration without colour claim – Modification of banal colours – No alteration of the distinctive character of the mark

Since the earlier mark was registered without any colour claim, its representation in colour does not alter the distinctive character of the mark as registered, because the registration covers all possible colour combinations (§ 44).

15/10/2019, T-582/18, [X BOXER BARCELONA \(fig.\) / X \(fig.\) et al.](#), EU:T:2019:747, § 44

### Use as registered – Modification of colours – No alteration of the distinctive character of the mark

The use of different colours that are not particularly original is neither distinctive nor dominant and does not have the effect of altering a mark as registered (§ 45-46).



03/10/2019, T-666/18, [ad pepper \(fig.\)](#), EU:T:2019:720, § 45-46

### **Use as registered – No alteration of the distinctive character of the mark**

The fact that the signs as used contain two separate word components ('ad' and 'pepper') is not in itself capable of affecting the distinctive character of the contested trade mark, since the relevant public will break the word down into elements that have a concrete meaning for it or that resemble words it knows (§ 39-40).

The figurative element of three crooked chilli peppers plays only a secondary role in the signs used by the proprietor (§ 46-50).

Whether the signs are written in upper or lower case is irrelevant, since word marks that differ only in this respect are considered to be identical (§ 55).

The additional verbal elements 'Germany', 'digital pioneers since 1999' and 'the e-advertising network' do not affect the distinctive character of the trade mark since they are placed underneath the actual sign and will be perceived by the public as descriptive additions (§ 60-68). Therefore, overall, these forms of use differ only in negligible elements from the form of the trade mark as registered (§ 69).

03/10/2019, T-668/18, [ADPepper](#), EU:T:2019:719, § 39-40, 46-50, 55, 60-68, 69

### **Use as registered – No alteration of the distinctive character of the mark**

The figurative elements in the earlier mark are limited to the presentation of the word 'brownies' in a yellow stylised font, the dot on the letter 'i' in the form of a flower and, sometimes, an uneven border (§ 66). The word 'brownies' remains the distinctive element in the sign thus stylised and, consequently, its use in that form is to be considered use of the earlier mark (§ 68).

The fact that a figurative mark, while having a certain distinctive character, may also be used to decorate the product bearing it does not affect its ability to fulfil the essential function of a mark. That is especially true in the clothing sector, where it is not unusual for products to bear a stylised form of a mark (§ 69).



30/01/2020, T-598/18, [BROWNIE / BROWNIE, Brownie \(series mark\)](#); EU:T:2020:22, § 66, 68-69

### **Use not as registered – Addition of distinctive elements – Addition of a 'house mark' – Alteration of the distinctive character**

The way in which the combination 'air blue' or 'air blue 100' is used in the evidence submitted alters the distinctive character of the contested mark AIR as registered (§ 32). While the word 'blue' is often used on the tobacco market by various manufacturers, there is no evidence that the relevant public would perceive that word or the colour blue as having a descriptive purpose indicating a milder taste. The fact that the word 'blue' appears on invoices in the abbreviated form 'bl' does not demonstrate any descriptiveness in relation to the contested goods since the descriptive character must be assessed in relation to the goods and not the details on the invoices. Moreover, the recipients of invoices are professionals and not the general public in relation to which the genuine use of the contested mark must be assessed (§ 30).

The element 'memphis' is always clearly visible in a dominant position in the overall impression produced by the trade mark as used. Even if that element were a 'house mark', it would not call into question the fact that that word alters the distinctive character of the contested mark AIR, since the relevant public no longer perceives the element 'air' as an indication of the origin of the goods in question (18/07/2013, C-252/12, Specsavers, EU:C:2013:497, § 26) (§ 35).



08/07/2020, T-800/19, [Air](#), EU:T:2020:324, § 30, 32, 35

### **Use not as registered – Weak distinctive character – Three-dimensional mark – Mark used only as part of a composite mark or in conjunction with another mark – Alteration of the distinctive character**

If the distinctive character of a mark is weak, its scope of protection, as defined by its graphic representation, is narrow. Moreover, where it is used solely as part of a complex trade mark or jointly with another mark, its distinctive character is easily altered by adding a component that is itself distinctive. This is all the more true in cases of 3D marks (24/09/2015, T-317/14, Shape of a cooking stove, EU:T:2015:689, § 33, 37) (§ 140, 155-156).

23/09/2020, T-796/16, [Grass in bottle / Bottle with strand of grass et al.](#), EU:T:2020:439, § 140, 155-156

### **Use as registered – Graphic additions for words marks**

The BoA should have examined whether or not the use as MOOD MEDIA with two red dots alters its distinctive character and it should have considered that the use with an M logo does not alter the distinctive character of the word mark (§ 48-49). The addition of the figurative element does not alter the distinctive character of the mark as registered. Although it has been accepted that it is possible for a figurative element to prevail over the word element, this figurative element cannot significantly influence the overall impression that the sign creates in the mind of the relevant public, because the figurative element is not easily and immediately identifiable (05/10/2011, T-118/09, Bloomclothes, EU:T:2011:563, § 32) (§ 55-56).

02/03/2022, T-615/20, [Mood media](#), EU:T:2022:109, § 48-49, 55-56

### **Use as registered – Graphic additions for words marks**

The word element 'delta', which is written in white letters in a slightly stylised font and to which the smaller symbol '®' has been added, appears on a light green background which consists of a rectangle with rounded corners. The graphic elements, namely the green background and the stylisation of the word element 'delta', are not capable of altering its distinctive character. Consequently, the use of that sign could validly be regarded as use of the earlier mark (§ 55).

The protection offered by the registration of a word mark applies to the word in the application for registration and not to the specific figurative or stylistic characteristics which that mark might have. As a result, the font which the word sign might be presented in must not be considered. It follows that a word mark may be used in any form, in any colour or font type (§ 56).

The specific representation of a word mark is not generally of such nature as to alter the distinctive character of that mark as registered (§ 57).

The elements used together with the earlier mark that refer to the components or properties of the goods at issue, with the result that their distinctive character regarding those goods is limited on account of their descriptiveness, are not capable of altering the distinctive character of that mark (§ 70).

23/03/2022, T-146/21, [Deltatic / Delta](#), EU:T:2022:159, § 55-57, 70

### **Use as registered – No alteration of the distinctive character of the mark**

The distinctive character of the earlier mark could not be regarded as having been altered on the sole ground that the figurative element of that mark was situated on the left-hand side of the word element of that mark on the packaging and goods, whereas in the registered form of that mark, the figurative element was above the word element (§ 90).

27/04/2022, T-181/21, [SmartThinQ \(fig.\) / SMARTTHING \(fig.\)](#), EU:T:2022:247, § 90, 91

### **Use as registered – Addition of informative indication**

All the word elements other than the word 'Fraas' are considerably smaller and they are not capable of impregnating the public's recollection. The English expression 'the SCARF company' merely describes the main activity of the company, namely the manufacture of scarves, whereas the addition 'Sonja Kiefer Collection' or 'designated by Sonja Kiefer' is an informative indication referring to the creator of the goods so designated. None of these expressions has an influence on the distinctive character of the word 'Fraas' (§ 85).

[22/06/2022, T-329/21, Fraas, EU:T:2022:379](#)

### **Use as registered – Addition of informative indication**

The elements 'ron', 'mojito', 'mojito concentrates' used on the bottles containing those goods are descriptive. The same applies to the elements 'dominicano', 'añejo' as those refer to the characteristics of the goods concerned. Therefore, those elements do not alter the distinctive character of the mark as registered, namely the word mark 'BUCANERO' (§ 47-51). Consequently, the evidence showing the goods bearing the signs 'RON BUCANERO', 'MOJITOS BUCANERO', 'BUCANERO RON AÑEJO', 'RON BUCANERO' and 'concentrates DE MOJITO BUCANERO' was correctly accepted as the evidence of use of the trade mark 'BUCANERO' in relation to the 'preparations for making mojitos' in Class 32, and 'rum' and 'mojitos' in Class 33 (§ 51, 54, 66).

[22/06/2022, T-29/21, Bucanero, EU:T:2022:388](#)

### **Use as registered – Addition of descriptive element**

The element added to the contested mark, namely 'beer', is purely descriptive of the goods at issue, that is to say devoid of any distinctive character, with the result that it cannot alter the distinctive character of the contested mark, even if it were assumed that the latter is weak (§ 97).

[14/09/2022, T-609/21, Steam, EU:T:2022:563](#)

### **Trade mark representing Chinese characters – Definition of the relevant public – Non-Chinese-speaking general public**

For the purpose of assessing whether the contested mark, registered for 'still wines' in Class 33, was use as registered [Article 18(1) EUTMR], the relevant public consists of the general public, who would be unable to verbalise or to memorise the Chinese characters forming the contested mark (§ 34).

There is nothing in the wording of the trade mark application to suggest that 'still wines' are intended exclusively for customers of Chinese and Chinese-speaking origin. The mere fact that these Chinese characters may be identified by the Chinese-speaking public is not in itself sufficient to establish and define a particular category of consumers. (§ 29).

Although the EUTM proprietor's commercial strategy consists of selling its goods mainly to Chinese restaurants in France, the fact remains that its goods are sold through other commercial channels (§ 30). Moreover, the goods are also targeted at non-Chinese-speaking consumers who frequented Chinese restaurants (§ 31).

It does not follow from the judgment of 25/06/2015, C-147/14, Loutfi Management Propriété intellectuelle, EU:C:2015:420, that, where a mark contained characters from a foreign language, the relevant public would systematically include consumers with a knowledge of that language (§ 38).

卡斯特 [19/10/2022, T-323/21, Kasite \(fig.\), EU:T:2022:650](#)

### **Use not as registered – Trade mark representing Chinese characters – Joint use with verbal elements in Latin alphabet and figurative elements**

Since the relevant public will not be able to verbalise or to memorise the Chinese characters represented in the contested mark, the said characters will be perceived as meaningless, abstract signs or as decorative elements referring to China or to Asia (§ 47). Moreover, the contested mark appears on the product packaging or in the advertisements in a very small size and accompanied by the verbal elements 'DRAGON DE CHINE' and by the representation of a dragon. Those added elements dominate the overall impression (§ 51). Therefore, the Chinese characters will be perceived as a decorative element and not as an indication of origin (§ 52). As a result, the added elements alter the distinctive character of the contested mark as registered (§ 55).

卡斯特 [19/10/2022, T-323/21, Kasite \(fig.\), EU:T:2022:650](#)

### **Use as registered – Inherent distinctiveness of a shape mark – Unusual shape in the relevant sector**

A weak distinctive character shall not be attributed to the contested mark on the sole ground that it consists of a shape which is common in another sector. The goods protected by that mark, such as candy and sugar confectionery, are entirely unrelated to babies' bottles. Furthermore, it is apparent from the documents submitted in the course of the proceedings before EUIPO that that mark is sometimes described as candy in the shape of a baby's bottle, whereas it is unusual in the relevant sector to designate candy by its shape. Therefore, the contested mark has an average distinctive character (§ 61).

[26/10/2022, T-273/21, SHAPE OF A BABY'S BOTTLE \(3D MARK\), EU:T:2022:675](#)

### **Use as registered – Joint use of a shape mark with a word mark**

In case of the joint use of a shape mark with a word mark, it is necessary to examine whether the form of which the contested mark as used consists, that is to say, the three-dimensional 'shape', differs from the form in which the contested mark is registered. Next, it must be determined whether the addition of word and figurative elements may have led to use in a 'form' differing from the contested mark as registered only in elements which do not alter the distinctive character of that mark (§ 39).

A registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 18(1)(a) EUTMR (§ 75).

The addition of a word mark and few other figurative and verbal elements to the surface of the contested mark as used does not alter the form of that mark since the consumer can still distinguish the form of the three-dimensional mark, which remains identical in the eyes of that consumer (§ 80). It is inconceivable from a commercial and regulatory point of view to sell the goods at issue solely in the form of which the contested mark consists and without any label on its surface (§ 83).

[26/10/2022, T-273/21, SHAPE OF A BABY'S BOTTLE \(3D MARK\), EU:T:2022:675](#)

### **Use not as registered – Use in a slogan**

The slogan 'Älteste Fohlenelf der Welt' alters the distinctive character of the contested mark 'Fohlenelf'. 'Fohlenelf' is a German word that consists of 2 word elements which are easily understood. The slogan 'Älteste Fohlenelf der Welt' can therefore easily be understood as 'the oldest team of eleven foals (young players) in the world'. It is not clearly related to the particular

football team. The meaning of the slogan implies that there might be several 'Fohlenelf' team (teams of eleven young players) and not only one to which the mark as registered refers. The consumer will not systematically perceive 'Fohlenelf' as a reference to the EUTM proprietor (§ 83-85).

[07/12/2022, T-747/21, Fohlenelf, EU:T:2022:773](#)

### **Use as registered – Joint use of a shape mark with a word mark**

The condition of genuine use of a trade mark may be satisfied where a trade mark is used in conjunction with another trade mark, provided that the trade mark continues to be perceived as an indication of the origin of the product concerned (§ 57). In line with Judgment [26/10/2022, T-273/21, SHAPE OF A BABY'S BOTTLE \(3D MARK\), EU:T:2022:675](#), the additional use of a word mark is found not to prevent the relevant public from perceiving the shape of the three-dimensional mark as an indication of the origin of the goods in question as (i) the shape remains unchanged, (ii) the word mark is used independently and does not form a whole with the contested three-dimensional mark and (iii) the shape forming the contested mark remains clearly recognisable even if the word mark is clearly visible on the product packaging (§ 58).



[14/12/2022, T-553/21, FORM EINES SMILEYS \(3D\), EU:T:2022:813](#)

### **Use as registered – Two-dimensional representation of a 3D mark – Impact of additional elements**

The two-dimensional representation of a three-dimensional mark may, where appropriate, promote its recognition by the relevant public, provided that the essential elements of the three-dimensional shape of the product are discernible from it. Therefore, evidence which reproduces the two-dimensional image on packaging is capable of establishing genuine use of the contested three-dimensional mark, as the shape (i) is clearly perceptible on the packaging and (ii) remains easily recognisable to the relevant public, even if it is supplemented by other elements which have a clearly playful or promotional effect without, however, deviating significantly from the mark in its registered form (§ 59-61).



[14/12/2022, T-553/21, FORM EINES SMILEYS \(3D\), EU:T:2022:813](#)

### **Use as registered – Graphic additions for word mark – Weak figurative elements**

Although the word element was weak, its distinctive character was not altered as (i) it remained clearly identifiable, (ii) due to its size and position it was dominant and would hold the public's attention, and (iii) the additional figurative elements were also weak and thus, as a rule, less distinctive (§ 81-83).

Moreover, a chef's hat is a banal and commonplace element in the field of food products, insofar as it indicates that the goods are made by a chef. This also applies to raw foodstuffs that can be used by a chef in their preparations (§ 84).

[01/03/2023, T-102/22, Gourmet \(fig.\) / Gourmet, EU:T:2023:100](#)

### **Use as registered – Graphic additions for word marks**

The specific representation of a word mark is not generally of such a nature as to alter the distinctive character of that mark as registered. The graphic representations used in respect of the registered mark may be taken into consideration for the purposes of proving its use, provided that they do not alter the distinctive character of that mark as registered (§ 33, 34).

[08/03/2023, T-372/21, Sympathy Inside / Inside., EU:T:2023:111](#)

### **Use as registered – Addition of a non-distinctive element**

The addition of a non-distinctive element, even where that element is dominant, cannot alter the distinctive character of the earlier mark as registered (§ 78).

[12/07/2023, T-27/22, th pharma \(fig.\) / Th \(fig.\), EU:T:2023:390](#)

### **Use as registered – Addition of a letter – Repetition of the first letter of a word mark**

The graphic representation given to the earlier word mark 'SALVANA', namely , does not constitute an alteration of its distinctive character. The additional letter 'S' may be perceived as an abbreviation of that term (§ 48-51).

[24/01/2024, T-55/23, SALVAJE \(fig.\) / SALVANA, EU:T:2024:30](#)

### **Use as registered – Addition of a letter – Surnames in the clothing sector**

The addition of the letter 'Y.' before the word element 'NOAH' when used in trade does not alter the distinctive character of the earlier mark as registered because, first, that letter was already present in the figurative element of the mark and, second, it occupies a secondary position in the perception of the mark (§ 61, 67).

Since the use of signs consisting of surnames is common in the clothing sector, the word element 'NOAH' may be perceived, both in the registered form and the modified form, as a surname that refers to Yannick Noah. The addition of the first letter of his given name merely reinforces that reference (§ 62, 66).



[24/01/2024, T-562/22, NOAH \(fig.\), EU:T:2024:23](#)

## **6.2 OMISSIONS**

### **No use as registered – Omissions – Inherent weakly distinctive trade mark**

Use of the word mark 'MOOD MEDIA' as 'MOOD:' alters the distinctive character of the mark because the distinctive character of the contested mark has a weak distinctive character on account of the descriptiveness of the term 'media' and the (at most) weak distinctive character of the term 'mood' (§ 36, 61-62). Therefore, the BoA was right in deciding that the omission of the term 'media' did indeed alter the distinctive character of the contested mark on account of its weak distinctive character and that, consequently, the evidence of use was not to be taken into consideration when assessing whether there had been genuine use of the contested mark (§ 62).

[02/03/2022, T-615/20, Mood media, EU:T:2022:109, § 36, 61-62](#)

### **Use as registered – Complex mark – Omission of simple figurative elements – Omission of descriptive elements**

When assessing a graphic element of a composite mark with regard to its distinctive character, a basic geometrical figure, such as a rectangle, is not particularly distinctive (§ 33-35).

The omission of the expression 'TRANSPORTE MAQUINARIA Y OBRAS,S.A.' is irrelevant due to its small size, secondary position and descriptive character for part of the relevant public (§ 44).

  06/04/2022, [T-219/21, TRAMOSA \(fig.\) / TRAMO,SA TRANSPORTE MAQUINARIA Y OBRAS,S.A. \(fig.\)](#), EU:T:2022:219, § 33-35, § 44

### **Use as registered – Complex mark – Omission of simple figurative elements – Omission of descriptive elements**

The representation of the heart between two square brackets and the horizontal lines is purely decorative (§ 28). In addition, it is apparent from the case-law that an element representing a heart is commonly used in advertising language to express a particular attachment and that it is devoid of distinctive character (§ 31). Therefore, the omission of the figurative elements representing the heart between two square brackets and the horizontal lines in the sign used is not such as to alter the distinctive character of that trade mark as a whole (§ 38, 42).

[16/11/2022, T-512/21, EPSILON TECHNOLOGIES \(fig.\)](#), EU:T:2022:710

### **Use as registered – Omission of negligible element**

Where the element of the earlier mark as registered, which is omitted in the signs as used, is in a secondary and non-distinctive position, its omission does not alter the distinctive character of the earlier mark. The absence of a full stop at the end of the earlier mark in the proof of use constitutes a minor difference, which does not deprive the earlier mark of its distinctive character (§ 27).

[08/03/2023, T-372/21, Sympathy Inside / Inside.](#), EU:T:2023:111

### **Use not as registered – Omission of distinctive figurative element**

Where, due to the specific stylisation of the letters and the combination of colours, the earlier mark is not dominated in its entirety by its verbal element, the use of that verbal element without those figurative elements alters the distinctive character of the earlier mark (§ 41-43).

 [03/05/2023, T-52/22, TEHA \(fig.\) / tema \(fig.\)](#), EU:T:2023:235  
See also, [03/05/2023, T-60/22, Teha / tema \(fig.\)](#), EU:T:2023:236, § 40-42

### **Use not as registered – Omission of a weakly distinctive element**

In the circumstances of the present case, the figurative element depicting the group of upper-case letters 'CS' cannot influence the overall impression created by the sign in the minds of the relevant public so significantly that the view can be taken that the verbal element 'jeans' is negligible in the overall impression that the contested mark creates. The omission of the weakly distinctive element 'jeans' is sufficient to alter the distinctive character of the contested mark (§ 66-67).



[28/06/2023, T-645/22, CS jeans your best fashion partner](#), EU:T:2023:363

## **6.3 OTHER ALTERATIONS**

### **Use of a three-dimensional mark**

The three-dimensional character of a mark precludes a static vision, in two dimensions, and commands a dynamic perception, in three dimensions. Therefore, the representations in perspective, and in any position, of the product (the shape of which embodies the earlier mark) are of real relevance for the purpose of appreciating its serious use and cannot be disregarded simply because they do not constitute two-dimensional reproductions of the shape (§ 93).

28/02/2019, T-459/18, [PEPERO original \(fig.\) / REPRÉSENTATION D'UN BATÔNNET \(fig.\)](#), EU:T:2019:119, § 93

### **Use not as registered – Use of the different elements of the mark on different parts of the goods**

The proprietor has not demonstrated genuine use of the contested mark in the form in which it was registered since the evidence submitted concerned use of the contested mark in a form differing in elements, which altered the distinctive character of that mark from the form in which it had been registered (§ 8, 66). In particular, the use of the elements 'rich' and 'richmond' together but on different parts of the goods cannot constitute genuine use of the contested mark which does not alter its distinctive character (§ 48). The presentation of a product bearing the element 'rich' in the rather broad context of a RICHMOND catalogue or in a RICHMOND store does not permit the inference that the trade mark used on such a product consists not only of the element 'rich', but also of the element 'richmond' (§ 52).

**RICH**

JOHN RICHMOND 14/07/2021, T-297/20, [RICH JOHN RICHMOND \(fig.\)](#), EU:T:2021:432, § 8, 48, 52, 66

### **Use as registered – Word element split into two elements**

The fact that the word elements in the forms in which the earlier mark has been used are separated and positioned one above the other and the fact that the word 'lubricants' is represented in smaller letters cannot, in the present case, alter the distinctive character of the earlier word mark 'EUROLLUBRICANTS', which consists of the same two words (§ 72).

[14/12/2022, T-636/21, eurol LUBRICANTS \(fig.\) / Eurollubricants](#), EU:T:2022:804

### **Use as registered – Use in colour**

Use in colour does not alter the distinctive character of the contested three-dimensional mark which is registered in black and white, where the shape and size correspond to the mark as registered. A colour which corresponds to the natural colour of the goods cannot be considered as one of the main factors conferring distinctiveness to the contested mark consisting of the product shape (§ 53).



[14/12/2022, T-553/21, FORM EINES SMILEYS \(3D\)](#), EU:T:2022:813

### **Use not as registered – Different colours – Verbal element in a different font**

Where the distinctive character of the mark derives from the specific stylisation of the verbal element and the contrast of the colour combination, the use of a sign in different colours and with the verbal element written in a different font alters its distinctive character (§ 48-51).

**te<sup>ma</sup>**

[03/05/2023, T-52/22, TEHA \(fig.\) / tema \(fig.\)](#), EU:T:2023:235

See also, [03/05/2023, T-60/22, Teha / tema \(fig.\)](#), EU:T:2023:236, § 47-50

## **Use as registered – Use in colour – Variation of the outline – Addition of decorative elements**

The contested sign is not so simple that the changes in question would prevent the relevant public from perceiving the contested mark clearly (§ 112).

Regarding the variation in colour, the contested sign as registered does not have a colour claim and the variations in that regard do not support the conclusion that the distinctive character has been altered. Regarding the outline, although it appears in multiple variants, it remains sufficiently clear and distinctive to have no impact on consumer perception. The sharpness of the outline cannot affect the perception of the sign, which remains visible irrespective of its sharpness. Furthermore, the addition of decorative precious stones, when the sign takes the form of certain goods, does not alter the distinctive character because the characteristic outline can still be seen. The various changes made to the contested sign as used, relating to its shape, colour, outline, sharpness and background, represent insignificant changes, which are decorative in nature and do not alter its distinctive character (§ 115, 116).



[26/07/2023, T-638/21, DEVICE OF THE OUTLINE OF A BEAR \(fig.\), EU:T:2023:434](#)

## **7 USE FOR THE GOODS OR SERVICES FOR WHICH THE MARK IS REGISTERED, CATEGORIES AND SUBCATEGORIES**

### **7.1 USE IN CONNECTION WITH THE REGISTERED GOODS AND SERVICES**

#### **Revocation proceedings – Genuine use of the mark in connection with the goods – Irrelevance of incorrect classification considering that the Nice Classification exclusively serves administrative purposes**

The BoA correctly found that the contested mark has been used for *biocompatible substances for medical purposes for reducing wrinkles* and that the incorrect registration of that mark in respect of such substances as goods in Class 10 instead of Class 5 was not a reason for granting the application for revocation in respect of those goods (§ 62).

According to Rule 2(2) CTMIR [reproduced, in essence, in Article 33(2) EUTMR], the list of goods and services must be worded in such a way as to indicate clearly the nature of the goods and services and to allow each item to be classified in only one class of the Nice Classification. According to Rule 2(4) CTMIR [now Article 33(7) EUTMR], the classification of goods and services exclusively serves administrative purposes. This means that goods and services may not be regarded as being similar to each other based on the fact that they appear in the same class under the Nice Classification, and may not be regarded as being dissimilar from each other based on the fact that they appear in different classes under the Nice Classification. The purpose of the Nice Classification is only to facilitate the drafting and processing of trade mark applications by suggesting certain classes and categories of goods and services. Moreover, the Nice Classification cannot determine, in itself, the nature and characteristics of the goods (see 28/05/2020, T-681/18, *Stayer* (fig.), EU:T:2020:222, § 40 and the case-law cited) (§ 54).

In these circumstances, particularly considering the aims pursued by the Nice Classification, the mere fact that the contested mark was registered for *biocompatible substances for medical purposes for reducing wrinkles* designated incorrectly as goods in Class 10 instead of Class 5 cannot lead to the revocation of that mark for such goods if that mark has actually been used for those goods (§ 55).

[06/10/2021, T-372/20, \*Juvederm\*, EU:T:2021:652, § 54, 55, 62](#)

### **Revocation proceedings – Lack of genuine use in connection with the goods – Possible classification of the goods in different classes of the Nice Classification – Interpretation in the light of the Nice Classification**

The BoA correctly confirmed the revocation of the contested mark as regards *dermal implants* (Class 10) (§ 32, 49-50). By choosing to register the contested mark in respect of *dermal implants* in that class, the applicant gave the description of those goods a specific meaning, which cannot be extended to *injectable dermal fillers* in Class 5 for which the mark is being used (§ 57).

Since goods described by the term *dermal implants* can be classified, according to the characteristics of the goods covered, either in Class 5 or Class 10, the BoA was required to interpret the term in the light of the class chosen by the applicant when the application for registration was lodged (§ 39).

In addition, the alphabetical list for Class 10 in force at the time when the application for registration of the contested mark was lodged already included *surgical implants*. There is nothing to indicate that the meaning of this term has evolved significantly over time. Furthermore, the addition of the words ‘artificial materials’ to the term *surgical implants* in 2001, and therefore before the contested mark was registered, merely confirms the underlying reason for the distinction between *implants* in Class 10 and those composed of living tissues in Class 5 (§ 42).

06/10/2021, T-397/20, [Juvederm](#), EU:T:2021:653, § 39, 42, 57

### **Revocation proceedings – Genuine use of the marks – Use in connection with the goods in respect of which the marks were registered – Principle that a finished product is classified in one class according to its function or purpose – Multipurpose objects**

As regards a finished product (i.e. a product ready to be marketed), the applicable General Remarks of the ninth edition of the Nice Classification first set out a principle before envisaging a specific situation (§ 37). The principle is the classification of a finished product in one class according to its function or purpose. The specific situation is that of ‘a multipurpose composite object’ which, by way of exception to the aforementioned principle, is capable of being classified in a number of classes because of its various functions or intended purposes. A dual classification of the same product is not normally possible in light of the wording of Rule 2(2) CTMIR (applicable *ratione temporis*) (§ 38).

The BoA, therefore, correctly found, in the context of the assessment of the evidence of use (in particular relating to the ‘x-presso monster’ goods), that it was necessary to refer to the principle set out in the General Remarks rather than the specific situation relating to multipurpose composite objects (§ 39).

*Energy drinks* in Class 32 are distinguished, with regard to the Nice Classification, from *coffee-based beverages* in Class 30. Notwithstanding the fact that the Nice Classification was adopted for exclusively administrative purposes, the explanatory notes on the different classes of that classification are relevant in determining the nature and purpose of the goods at issue. According to the explanatory notes of the Nice Classification, non-alcoholic beverages generally fall within Class 32, whereas beverages with a coffee base which are included in Class 30 and expressly excluded from Class 32 refer to beverages in which coffee constitutes the predominant and characteristic element (§ 49). Therefore, a beverage that is merely ‘flavoured with coffee’ and not ‘coffee-based’ falls within Class 32 and not Class 30 (§ 50).

Multipurpose composite objects are goods which are sold as a whole, but in which each of the components has an independent and distinct market value and could be marketed without the other specific components sold with it. By contrast, the proprietor’s canned beverages constitute an inseparable, homogeneous product that fulfils the single main function of being a stimulating energy drink, in the present case one that is flavoured with coffee (§ 51).

Coffee-based beverages and energy drinks have different natures and do not fulfil the same main function. Coffee-based beverages are characterised by the presence of coffee, whereas energy drinks include and combine a number of ingredients, and coffee (or coffee flavouring) is given only a secondary role. Consumers are aware of those differences, which are reinforced by the proprietor's communications and promotion with regard to the 'xpresso monster' goods, which highlight the energy content of those goods (§ 52). The proprietor has not proved that the goods concerned fall within both Class 30 (*coffee-based beverages*) and Class 32 (*energy drinks*) by virtue of the exception (§ 53). The BoA correctly analysed the various items of evidence by applying the principle that a finished product is classified in one class according to its function or purpose (§ 53).

It is established, as regards the 'current market conditions for energy drinks' referred to by the BoA, that energy drinks flavoured with coffee are usually found on the same shelves as energy drinks with other flavours, whether they are the applicant's or those of other manufacturers. Consumers do not perceive any difference in function or purpose between the various flavours of energy drinks. All of those drinks fulfil the same function, which is to provide an energy boost (§ 64).

*10/11/2021, T-758/20, [Monster](#) and T-759/20, [Monster energy](#), EU:T:2021:776, § 37-39, 49-53, 64*

#### **No genuine use of the mark in connection with the services – *Merchandising, advertisement, sponsoring***

The promotion and sales of the EUTM proprietor's own goods do not qualify as external use of the contested mark for merchandising, advertisement or sponsoring services (Class 35) that are offered to third parties, usually in return for economic compensation (§ 90-91).

*[07/12/2022, T-747/21, \[Fohlenelf\]\(#\), EU:T:2022:773](#)*

#### **Genuine use – Use for registered goods, in particular definition of 'medical products'**

The classification of a product pursuant to other rules of EU law is, in principle, not decisive for the assessment whether the goods for which the mark was used are the same as the goods for which the mark is registered (§ 98). The decisive factor for this assessment is how the goods are perceived by the relevant public (§ 100). Although the – even exclusive – sale of goods in pharmacies does not mean they are necessarily medicinal products, the circumstance that a product is only dispensed in pharmacies upon presentation of a doctor's prescription still constitutes a relevant factor that must be taken into account (§ 104). Taking into account that factor, the importance of the appearance of the goods at issue for their perception by the relevant public, and the information and indications on their packaging, they can be classified as medical products in the sense of Class 5 of the Nice Classification (§ 106).

*[11/01/2023, T-346/21, \[Gufic\]\(#\), EU:T:2023:2](#)*

#### **No genuine use of the mark in connection with the goods – Interpretation of the list of goods in the light of the Nice classification – Class headings and explanatory notes**

Although the Nice Classification is purely administrative, reference should be made to it in order to determine, where necessary, the range or the meaning of the goods in respect of which a mark has been registered. In particular, where the description of the goods for which a mark is registered is so general that it may cover very different goods, it is possible to take into account, for the purposes of interpretation or as a precise indication of the designation of the goods, the classes in that classification that the trade mark applicant has chosen (§ 23).

The goods covered by the contested mark must be interpreted from a systematic point of view, having regard to the logic and the system inherent in the Nice Classification, while taking into account the class headings and explanatory notes, which are relevant in determining the nature and purpose of the goods in question (§ 25). Consequently, the meaning of the goods at issue and their scope of protection should be interpreted with regard to the class in which they were classified (§ 28, 36).

[26/04/2023, T-794/21, Mouldpro, EU:T:2023:211](#)

### **No genuine use in connection of the goods and services – Use for similar goods and services**

It is apparent from Article 18(1) and Article 58(1)(a) EUTMR that the requirement that there be genuine use of the contested EUTM must concern the goods or services ‘in respect of which it is registered’. Those provisions do not indicate that use of a mark in connection with goods or services similar to those in respect of which it is registered can be regarded as genuine use of the mark at issue (§ 37-39).

[28/06/2023, T-645/22, CS jeans your best fashion partner, EU:T:2023:363](#)

### **Classification – Medicinal products**

It is not sufficient that a product has properties beneficial to health in general in order to be classified as a ‘medicinal product’, but it must, strictly speaking, have the function of treating or preventing disease. Medicinal products are, by their nature, intended to be used exclusively for medical purposes, to the exclusion of products that may be used independently from any medical treatment, although they may be intended to improve the consumer’s state of health and therefore serve a therapeutic purpose (§ 38).

[07/06/2023, T-419/22, medex \(fig.\), EU:T:2023:318](#)

### **Genuine use in connection with the services**

The evidence showing that the earlier mark has been used for guest transportation, city tours, shore excursions and transfer services is sufficient to prove use of the earlier mark for *services of a travel agency* in Class 38 (§ 37-43).

[15/11/2023, T-780/22, INCRUISES / INTERCRUISES SHORESIDE & PORT SERVICES \(fig.\), EU:T:2023:722](#)

### **Genuine use in connection with registered goods – Relevance of provisions of EU law to determine the nature of the goods**

In accordance with the case-law, it is not appropriate generally to exclude from the assessment of genuine use of a trade mark, the taking into consideration of provisions of EU law concerning both the goods in respect of which that mark was registered and the goods in respect of which it is actually used, for the purposes of ascertaining whether these are the same. Although the norms of EU law do not necessarily have an influence on how the good is classified in the Nice Classification, those norms may be relevant, or even decisive, when determining the type of goods actually used in connection with the contested mark (§ 39-47).

[20/12/2023, T-221/22 & T-242/22, Lutamax, EU:T:2023:858](#)

### **Use in connection with the registered goods – Scope of protection of a mark registered for goods in Class 29**

The explanatory notes to the Nice Classification expressly exclude dietetic food and substances adapted for medical use and foodstuffs for animals from Class 29. Where the contested mark is only registered for goods in Class 29, the use for milk powder can only prove genuine use for milk powder for food purposes (§ 43).

[24/01/2024, T-603/22, ROYAL MILK \(fig.\), EU:T:2024:29](#)

## **7.2 USE AND REGISTRATION FOR GENERAL INDICATIONS IN ‘CLASS HEADINGS’**

### **Use for general indication in ‘class headings’ – Determination of an independent subcategory – Prior version of the Nice Classification**

‘Pasta’ did not constitute a separate class heading of the Nice Classification at the time the contested mark was applied for (1997). However, the fact that new editions of the Nice Classification that contain ‘pasta’ as a separate class heading have been published since the date of registration of the contested mark is irrelevant, since they cannot retrospectively alter the list of goods designated by a registered mark. Thus, the fact that, in contrast to the situation existing on the date of registration of the contested mark, there is a new entry entitled ‘pasta’ in Class 30 of the Nice Classification on the day of the application for revocation, has no bearing on the determination of an independent subcategory of ‘pasta’ in relation to ‘preparations made from cereals’ (§ 141-143).

[14/12/2022, T-358/21, CIPRIANI FOOD \(fig.\), EU:T:2022:817](#)

### **Subcategories of goods and services for proof of genuine use**

Food supplements for medical purposes constitute, in themselves, a sufficiently clear category, which does not require division into subcategories. Consequently, the BoA’s finding that genuine use of the contested mark had been proved for the whole of the category ‘food supplements for medical purposes’ is correct (§ 75).

[12/07/2023, T-585/22, Artresan, EU:T:2023:392](#)

## **7.3 USE FOR SUBCATEGORIES OF GOODS/SERVICES AND SIMILAR GOODS/SERVICES**

### **Subcategories of goods and services for proof of genuine use**

When defining subcategories for which genuine use of the mark was shown, the purpose of the goods and services is a relevant factor (§ 44). The goods are dissimilar when the relevant consumers do not overlap (§ 55).

[07/02/2019, T-789/17, TecDocPower / TecDoc \(fig.\) et al., EU:T:2019:70, § 44, 55](#)

### **Subcategories of goods and services for proof of genuine use – Wine – Designation of origin of a wine**

The designation of origin of a wine cannot be considered to be of systemic importance in determining whether wines with different designations of origin may constitute sufficiently defined and independent subcategories within the category ‘wines’ (30/06/2015, T-489/13, VIÑA ALBERDI / VILLA ALBERTI, EU:T:2015:446, § 37 (§ 45-46).

[17/01/2019, T-576/17, EL SEÑORITO / SEÑORITA, EU:T:2019:16, § 45-46](#)

### **Subcategories of goods and services for proof of genuine use – Partial genuine use**

If a trade mark has been registered for a category of goods or services which is sufficiently broad to be divided into subcategories capable of being viewed independently, proof that the mark has been genuinely used in relation to a part of those goods or services affords protection only for the subcategory or subcategories to which the goods or services for which the trade mark has actually been used belong (§ 47). The category of printed matter is broad enough to be subdivided (§ 52). The subcategory of printed matter printed with individual photos is sufficiently homogeneous (§ 53). Therefore, the protection of the contested trade mark is restricted to the subcategory printed matter printed with individual photos (§ 55).

11/04/2019, T-323/18, [DARSTELLUNG EINES SCHMETTERLINGS \(fig.\)](#), EU:T:2019:243, § 47, 52-53, 55

### **Subcategories of goods and services for proof of genuine use – Delimitation of *real estate affairs* and *financial affairs* in Class 36**

The BoA correctly considered that, irrespective of whether or not the EUTM proprietor is a building promoter, it proved genuine use for services related exclusively to 'real estate affairs' and not to 'financial affairs' in Class 36, although the services fall within the field of real estate investment (§ 60-61). Whereas financial services are provided by financial institutions for the purposes of managing their clients' funds and consist of, inter alia, the holding of deposited funds, the remittance of funds, the granting of loans or the performance of various financial operations, real estate services are services connected with a property, namely, in particular, the lease, the purchase, the sale or the management of such a property (17/09/2015, T-323/14, Bankia / BANKY, EU:T:2015:642, § 35) (§ 35-37).

17/03/2021, T-114/20, [URSUS Kapital \(fig.\)](#), EU:T:2021:144, § 35-37, 60-61

### **Subcategories of goods and services for proof of genuine use – *Virtual games* do not fall under *casino games***

Virtual games do not fall under *casino games* in Class 28 (§ 37). The EUTM is used to designate a type of software containing casino games, which are presented on the screens of casino apparatus. The owner of the EUTM has not proven use for any virtual games other than this software for casino games, which is protected in Class 9 (§ 40-41).

24/03/2021, T-588/19, [Power Stars](#), EU:T:2021:157, § 37, 40-41

### **Necessity to break down wide range of goods and services into subcategories for proof of genuine use – Reference to the explanatory note to the Nice Agreement – Partial genuine use**

The evidence provided in the context of revocation proceedings is valid insofar as it allows clear inferences to be drawn as to the criteria provided for in Article 10(3) EUTMDR (§ 40).

The explanatory note to the Nice Agreement states that Class 20 'includes mainly ... plastic goods, not included in other classes' (§ 55). With respect to the plastic goods that are not included in other classes, as is the case with 'urns', the sale of those goods cannot constitute proof of genuine use with respect to a category as broad as 'articles made of plastics' or 'goods of water-soluble, biodegradable and compostable plastic' (§ 56). The requirement for proof of genuine use seeks to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services (§ 57).

The contested mark's goods in Class 20 should have been divided into subcategories and a separate analysis of the evidence provided in relation to each of those subcategories should have been carried out (§ 58).

29/04/2020, T-78/19, [green cycles \(fig.\)](#), EU:T:2020:166, § 40, 57, 58

### **Partial use – Criteria for defining independent sub-categories of goods**

Purpose and intended use are the relevant criteria for establishing the independent sub-categories of goods for which a mark has been used. Goods for which use has been shown can only form a separate category if there is a sufficiently clear delimitation from the broader category of registered goods to which they belong (§ 68).

09/03/2022, T-766/20, [Stones](#), EU:T:2022:123, § 68

### **Revocation proceeding – Proof of genuine use – Broad category of goods or services – Retail services – Definition of independent sub-categories**

If an EUTM has been registered for a category of goods or services that is sufficiently broad for it to be possible to identify within it a number of subcategories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection only for the subcategory or subcategories to which the goods or services, for which the EUTM has actually been used, belong (14/07/2005, T-126/03, Aladin, EU:T:2005:288, § 45) (§ 21).

With regard to goods or services in a broad category of goods, which may be subdivided into several independent subcategories, the proprietor of the contested mark needs to adduce proof of genuine use of that mark for each of those autonomous subcategories. In that connection, the breadth of the categories of goods or services for which the contested mark was registered is a key element of the balance between, on the one hand, the maintenance and preservation of the exclusive rights conferred on the proprietor of the contested mark and, on the other hand, the limitation of those rights in order to prevent an EUTM that has been used in relation to part of the goods or services being afforded extensive protection, merely because it has been registered for a wide range of goods or services (16/07/2020, C-714/18 P, tigha / TAIGA, EU:C:2020:573, § 39, 43) (§ 22). The purpose or intended use is fundamental when defining a subcategory of goods or services since consumers are searching primarily for a product or service that meets their specific needs (13/02/2007, T-256/04, Respicur, EU:T:2007:46, § 29) (§ 23).

However, if an EUTM has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant subdivisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category (14/07/2005, T-126/03, Aladin, EU:T:2005:288, § 45) (§ 24).

In the present case, considering the definition of the concept of chemical (not disputed), the category of chemicals to which the retail services for which the contested mark was registered relate, is sufficiently broad for it to be possible to identify within it a number of subcategories capable of being viewed independently, in addition to the subcategory of pharmaceuticals. Chemicals may have different purposes and, in particular, be used in industry, science, photography or agriculture (§ 33). Proof of use of the contested mark for retail services in relation to goods such as cosmetics that stimulate hair growth in men, toothpastes, body lotions, lip repair creams, washing lotions, lactase-based foodstuffs, magnesium supplements or nutritional supplements, cannot extend the protection afforded by the contested mark to the entire broader category of chemicals to which the retail services relate, on the sole ground that the products listed above are chemicals (§ 34-38).

The category of household goods to which the retail services relate constitutes a broad category and may therefore be subdivided into several subcategories capable of being viewed

independently. Accordingly, the proof of use of the contested mark in connection with the single product 'Frontline' is not capable of extending the protection conferred by that mark to the entire broader category of household goods to which the retail services relate (§ 43).

The two categories consisting of pharmacy products and goods for the health sector to which, inter alia, the retail services for which the contested mark was registered relate, namely retail services in relation to pharmacy products and goods for the health sector, are sufficiently broad for it to be possible to identify within them several subcategories. As regards the scope of the categories of goods to which the retail services relate, the applicant has not succeeded in demonstrating that the use of the contested mark in connection with retail services relates to the subcategories of pharmacy products and goods for the health sector (not including the services that the BoA found where such use had been established). Therefore, the proof of genuine use of the contested mark in connection with retail services in relation to cosmetics and pharmaceuticals does not allow the protection afforded by that mark to be maintained for the entire category of pharmacy products and goods for the health sector to which the retail services relate. The sale, even the exclusive sale, of certain goods in pharmacies, drugstores and parapharmacies does not mean that they are necessarily pharmacy products (17/11/2017, T-802/16, FEMIBION, EU:T:2017:818, § 38) (§ 55).

02/03/2022, T-140/21, [apo-discounter.de \(fig.\)](#), EU:T:2022:110, § 21-24, 34-38, 43, 55

#### **Scope of the list of goods and services – Use of brackets**

The contested mark covers 'abrading instruments (hand instruments)', which terms are immediately followed by the words 'discs and wheels' in brackets. The use of those brackets has the effect here of restricting the scope of the protection sought solely to 'wheels and grinding wheels' which are included in the category of 'abrading instruments (hand instruments)'. Following its specification 'abrading instruments (hand instruments) (discs and wheels)' in Class 8, the contested mark has been registered in respect of 'discs and wheels' as such and not in respect of all or only some types of hand instruments to which those wheels and grinding wheels may be connected (§ 20).

[30/11/2022, T-155/22, Stayer \(fig.\), EU:T:2022:735](#)  
[30/11/2022, T-85/22, STAYER, EU:T:2022:734](#)

#### **Proof of use – No overlap between categories**

The category of 'pharmaceutical products' covers goods resulting from pharmacy, that is to say the art of creating, preparing, preserving and dispensing or administering medicinal products, intended for the treatment or prevention of illnesses. Food supplements are goods which are concentrated sources of nutrients. According to a literal meaning, their purpose is to supplement the nutritional value of the normal diet of a human being and their main purpose is not the treatment or prevention of illnesses, although they are generally also used to improve the health of a patient. Therefore, food supplements do not come under the 'pharmaceutical products' category in Class 5 (§ 31, 32).

[30/11/2022, T-12/22, Naturcaps / Naturkaps, EU:T:2022:733](#)

#### **Proof of use – Irrelevance of the classification of goods according to other rules of EU law**

National and EU legislative acts relating to pharmaceutical products or food supplements do not affect the way in which goods and services are classified in the Nice Classification (§ 35).

[30/11/2022, T-12/22, Naturcaps / Naturkaps, EU:T:2022:733](#)

### **Identification of goods and services**

It is for the proprietor of the mark to ensure that the definition of the goods in respect of which it claims protection of its mark is clear; furthermore, it cannot rely in its favour on any doubt or any overlap between the headings of the Nice Classification (§ 36).

[30/11/2022, T-12/22, Naturcaps / Naturkaps, EU:T:2022:733](#)

### **Genuine use of the mark in connection with the goods – Use for more than one category in the same class**

Hair-and-body shampoos are intended to clean both hair and body and therefore not only qualify as shampoos, but also as soaps (Class 3) (§ 100). The use for cards and card games qualifies as use for 'games, toys' (Class 28). The use for 'stickers' qualifies as use for 'self-adhesive films of paper or plastic' (Class 16) (§ 101).

[07/12/2022, T-747/21, Fohlenelf, EU:T:2022:773](#)

### **Genuine use of the mark in connection with the goods – No independent subcategory**

Pasta, panetonne and foccacia are, like 'preparations made from cereals', intended to be consumed by an individual in order to satisfy his or her nutritional needs. The differences concerning their nature, characteristics or place of sale are not relevant to the definition of a subcategory. Therefore, in view of the use of the contested mark for pasta, panettone and foccacia, it is impossible to consider that those products form independent subcategories in relation to the category 'preparations made from cereals' for which that mark is registered (§ 146-148).

[14/12/2022, T-358/21, CIPRIANI FOOD \(fig.\), EU:T:2022:817](#)

### **Genuine use of the mark in connection with the goods – Use for more than one category in the same class**

The class headings of the Nice Classification do not constitute a system in which goods or services included in one class or category are precluded from also forming part of another class or category. In order to establish that a product contributes to genuine use of a mark for a general category of goods covered by that mark, it is sufficient to determine whether that product can correspond to the usual meaning of that category. Thus, a product may help to demonstrate genuine use for two categories of goods in the same class covered by a trade mark. As a result, the BoA did not err in finding that panettone and foccacia could be classified both as 'preparations made from cereals' and as 'bread', both in Class 30 (§ 157-159).

[14/12/2022, T-358/21, CIPRIANI FOOD \(fig.\), EU:T:2022:817](#)

### **Partial use – Criteria for defining independent sub-categories of goods**

The BoA is not required to define – within a general indication – other subcategories to which the services in respect of which genuine use of the contested mark was proved did not belong. It is enough for it to distinguish, within those general indications, a coherent subcategory of services that all relate to the same purpose and to which the services at issue belong (§ 68).

Categories of *entertainment* and *gaming* are capable of comprising a wide range of services with a different purpose and intended use. Within those categories, the BoA was entitled to distinguish an independent subcategory of *gambling* in respect of which use of the contested mark was demonstrated (§ 66, 69, 72).

[01/02/2023, T-772/21, efbet \(fig.\), EU:T:2023:36](#)

### **Subcategories of goods and services for proof of genuine use**

The goods ‘cookies’ constitutes an autonomous subcategory of goods belonging to the broader category of ‘pastry’, on the ground that the intended use and purpose of ‘cookies’ could differ from those of other types of ‘pastry’ (§ 51).

The EUIPO’s Harmonised Database is a purely practical and administrative tool, providing the names of products already accepted by the competent authorities of the Member States and allowing for the acceleration of the procedure of applying for registration of a trade mark. That tool is of no relevance to the issue of whether the product ‘cookies’ constitutes a subcategory of the category ‘pastry’ (§ 56).

[07/06/2023, T-419/22, medex \(fig.\), EU:T:2023:318](#)

### **No independent subcategories within ‘athletically related footwear’**

Running shoes and racing shoes have the same intended use and purpose as ‘athletically-related footwear’ in Class 25. Consequently, it cannot be held that running or racing shoes constitute an independent subcategory in relation to ‘athletically-related footwear’ since such a division of the latter category would be arbitrary (§ 55).

[07/06/2023, T-63/22, BROOKS ENGLAND \(fig.\) / Brooks, EU:T:2023:312](#)

### **No independent subcategories within dietary supplements for medical use**

*Dietary supplements adapted for medical or dietetic use* already constitute a subcategory in Class 5 of the Nice Agreement, a class which includes mainly pharmaceuticals and other preparations for medical or veterinary purposes. Accordingly, *dietary supplements adapted for medical or dietetic use* constitute in itself a sufficiently clear category, which does not require division into subcategories. Unlike pharmaceutical preparations, *dietary supplements adapted for medical or dietetic use* do not necessarily have a precise and specific therapeutic indication. The systematic identification of coherent subcategories within this category of goods based on their therapeutic indication must therefore be ruled out (§ 62-74).

[20/12/2023, T-221/22 & T-242/22, Lutamax, EU:T:2023:858](#)

### **Independent subcategories within *milk and milk products* – *Milk powder* – *Characteristics of the goods***

Although the nature of the goods at issue and their characteristics are not, in principle, relevant with regard to the definition of subcategories of goods or services, it cannot be ruled out that, from the point of view of the relevant consumer, some of the characteristics of the goods at issue are of significant importance in directing their choice and that they therefore have a bearing on the purpose and intended use of those goods (§ 33, 42).

Since the characteristics of milk powder are so different from those of liquid milk, those goods do not have the same purpose or intended use. Therefore, *milk powder* constitutes an independent subcategory of the broader category of goods *milk and milk products with the exception of ice creams and milk desserts* (§ 34-35). The category of goods *milk and milk products* is not sufficiently narrow, since it contains rather heterogeneous goods (e.g. cheese, butter, yoghurt, crème fraiche) that meet very different consumer needs (§ 38-39).

The subcategory *milk powder for food purposes* is sufficiently homogeneous in terms of purpose and intended use, as they could be capable of meeting similar consumer needs, in particular as regards their use as additives in the preparation of other dishes (§ 41).

[24/01/2024, T-603/22, ROYAL MILK \(fig.\), EU:T:2024:29](#)

## 7.4 USE OF THE MARK AS REGARDS INTEGRAL PARTS AND AFTER-SALES SERVICES OF THE REGISTERED GOODS

[No key points available yet.]

## 8 USE BY THE PROPRIETOR OR ON ITS BEHALF

### Use with the consent of the proprietor

Consent must, in view of the importance of its effect - the extinction of the exclusive right of the proprietor of an EUTM to use that trade mark - be expressed in such a way as to indicate with certainty an intention to surrender that right. Such an intention usually results from an express grant of consent. However, it cannot be excluded that in certain cases consent may be implied from circumstances and indications prior to, at the time of or after the use of the trade mark in question by a third party which also indicate with certainty that the proprietor has renounced his right (§ 71).

[08/06/2022, T-293/21, Um, EU:T:2022:345](#)

### Use with the consent of the proprietor – Use by subsidiaries

Where the trade mark is used by an undertaking economically linked to the proprietor of the trade mark, it is presumed that the trade mark is used with the proprietor's consent and must therefore be regarded as use by the proprietor (§ 28).

[07/09/2022, T-521/21, ad pepper the e-advertising network \(fig.\), EU:T:2022:520](#)

### Use with the consent of the proprietor – Economically linked companies

Use of a trade mark with the consent of the proprietor is deemed to constitute use by the proprietor. The mere fact that, during the course of the proceedings before EUIPO, the applicant expressly disputed the use of the earlier mark by third parties is not sufficient to call into question the aforesaid principle. Moreover, where the proprietor of an earlier mark maintains that the use of that mark by a third party constitutes genuine use of that mark, it is implicit that the proprietor consented to that use, unless there is evidence to the contrary (§ 39-46).

The use of a trade mark by a company which is economically linked to the proprietor of the mark is presumed to be use of that mark with the consent of the proprietor and is therefore to be deemed to constitute use by the proprietor (§ 48).

[14/12/2022, T-636/21, eurol LUBRICANTS \(fig.\) / Eurollubricants, EU:T:2022:804](#)

### Use with the consent of the proprietor – Use by a third party

Where the EUTM proprietor maintains that the use of an earlier trade mark by a third party constitutes genuine use, they claim, by implication, that they consented to that use (§ 33).

[06/09/2023, T-45/22, Yippie! / Yuppie et al., EU:T:2023:513](#)

## 9 PROPER REASONS FOR NON-USE

**Proper reasons for non-use – Obstacles in sufficiently direct relationship with the trade mark**

Only obstacles having a sufficiently direct relationship with a trade mark making its use impossible or unreasonable, and which arise independently of the will of the proprietor of that mark, may be described as ‘proper reasons for non-use’ of that mark. It must be assessed on a case-by-case basis whether a change in the strategy of the undertaking to circumvent the obstacle under consideration would make the use of that mark unreasonable (§ 66-73).

03/07/2019, C-668/17 P, [Boswelan](#), EU:C:2019:557, § 66-73

### **Proper reasons for non-use pursuant to Article 51(1)(a) CTMR**

In order to be classified as ‘proper reasons’, obstacles to the use of a trade mark must satisfy three cumulative conditions: (i) have a sufficiently direct link with the trade mark, (ii) make the use of the mark impossible or unreasonable and (iii) be independent of the will of the proprietor of the trade mark (§ 40).

The BoA erred in holding that the existence of national infringement proceedings against the proprietor of the contested mark was not independent of its will (§ 44). However, this error does not justify the annulment of the contested decision.

In the national court proceedings, the applicant was charged the sum of EUR 60 000 by way of damages. Therefore, the applicant’s assertion that it might be ordered to pay compensation of EUR 72 million has no factual basis and is not supported by any evidence (§ 62-65).

The applicant has not adduced proof of particular circumstances showing that the existence of the national court proceedings made it unreasonable to use the mark at issue during the relevant period (§ 76).

30/06/2021, T-362/20, [Reaccion](#), EU:T:2021:399, § 40, 44, 62-65, 76

### **Proof of genuine use – Concept of proper reasons for non-use – Requirement to comply with legislation – No proper reasons for non-use**

Genuine use of a trade mark for a pharmaceutical product for human use, namely a pediatric antipyretic and analgesic in Class 5, cannot extend to genuine use of the goods veterinary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; mouthwashes for medical purposes, material for stopping teeth, dental wax; disinfectants for medical purposes; preparations for destroying vermin; fungicides and herbicides in the same class (§ 23-27).

The mere fact that an obstacle to the use of a trade mark exists, such as the requirement to comply with legislation in order to market the goods covered by that mark, does not justify the non-use of that mark. Complying with legislation is within the trade mark proprietor’s sphere of influence and responsibility, and does not constitute an obstacle independent of its will. The applicant cannot therefore invoke the existence of a specific regulatory framework, the purpose of which is to protect consumers, to justify the non-use of a trade mark which it has consciously registered for a wide range of goods.

In addition, the applicant has not shown that there was any obstacle to use of the mark in connection with the goods covered by the application for revocation in Member States of the EU other than Spain. It has not proved that the prohibition on marketing applies to the entire territory of the EU or even to that of other Member States in view of the applicable regulations and the potential marketing of its pharmaceutical product in those States (§ 31-35).

[12/01/2022, T-160/21, Apiretal](#), EU:T:2022:2, § 23-27, 31-35

### **No proper reasons for non-use – Seasonal nature of the market**

Only obstacles having a sufficiently direct relationship with a trade mark making its use impossible or unreasonable, and which arise independently of the will of the proprietor of that mark, may be described as ‘proper reasons for non-use’. It is sufficient that there are proper reasons for non-use during a part of the relevant period in order for the proprietor to avoid revocation. However, the seasonal nature of the bicycle market and its alleged influence on the functioning of that market has not been substantiated by the EUTM proprietor. Furthermore, the general conditions of the relevant market, according to which demand and sales of the products concerned are significantly higher during certain periods of the year, apply to all operators in the sector and are normal market characteristics. Consequently, they do not bear a sufficiently direct relationship to a registered trade mark, so that they cannot be regarded as proper reasons for non-use during other periods of the year. Thus, the commercial importance of the major bicycle shows during the summer is not such as to demonstrate the existence of proper reason for non-use of the contested mark during the preceding months (§ 57-61).

[07/09/2022, T-353/21, R2R, EU:T:2022:527](#)

### **No proper reasons for non-use – Car approval and certification process – Actions of other parties allegedly justifying non-use**

Financial, technical and organisational actions necessary to ‘bring a car into life’ relied on by the EUTM proprietor do not constitute proper reasons for non-use, if they are under the EUTM proprietor’s control and depend entirely on his will (§ 63).

The length of the process intended to ‘bring a car into life’ is not a proper reason for non-use. It is incumbent on the EUTM proprietor to assess the time necessary for the process of approval or certification of the goods and to file an application for registration of that mark where it was foreseeable that that process would have a positive outcome (§ 64-65).

The mere fact that the contested mark was used by other companies is not sufficient to demonstrate that there were proper reasons for non-use (§ 67).

[26/04/2023, T-35/22, Syrena, EU:T:2023:212](#)

### **No proper reasons for non-use – Infringement of the mark by third parties**

Proper reasons for non-use, which must be established by the trade mark proprietor (§ 57, 84-86), must not be interpreted broadly and are, in principle, limited to circumstances that are external to the trade mark proprietor and where the obstacle would make the use of the mark unreasonable in the sense that it seriously jeopardises the appropriate use of the mark (§ 53-56). In that regard, acts of infringement of the mark, even if established, do not prevent the use of it (§ 60), unless exceptional circumstances have been shown (§ 62-66).

[07/06/2023, T-239/22, Rialto, EU:T:2023:319](#)

## CHAPTER V – OTHER GROUNDS FOR REVOCATION

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### 1 EUTM BECOMING A COMMON NAME (GENERIC TERM) – ARTICLE 58(1)(b) EUTMR

#### 1.1 BURDEN OF PROOF

[No key points available yet.]

#### 1.2 RELEVANT PUBLIC

##### **Evidence – Trade mark becoming a common name – Relevant public**

The relevant circles, whose point of view must be taken into account when it is assessed whether the contested mark has become, in the trade, the common name of the product marketed under that mark, must be defined in the light of the characteristics of the market for that product. 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 (§ 37, 38). Considering the characteristics of the market for ‘exercise equipment’ (Class 28) and ‘exercise training’ (Class 41) the relevant public could consist of professionals, such as, inter alia, operators of gyms, sporting facilities and rehabilitation facilities as those are playing a central role on the market for these goods and have a decisive influence on the selections of end consumers, as regards the services concerning exercise training (§ 47, 49).

[06/07/2022, T-246/20, SPINNING, EU:T:2022:428](#)

#### 1.3 POINT IN TIME TO BE CONSIDERED

[No key points available yet.]

#### 1.4 COMMON NAME

##### **Factors of assessment – Trade mark becoming a common name**

The arguments concerning the inherent distinctiveness of the contested mark, any good faith on the part of the applicant for revocation, the objective of its action, the interest which the relevant market has for the proprietor of the contested mark or even the consequences which any revocation could have for that proprietor, relate to factors which are not among those which must be taken into account in the context of the assessment of an application for revocation pursuant to Article 58(1)(b) EUTMR (§ 84).

[06/07/2022, T-246/20, SPINNING, EU:T:2022:428](#)

##### **Trade mark becoming a common name – Use as a generic expression**

The use by the relevant public or toward the relevant public of the expression ‘city stade’ in singular and plural forms, with determiner or possessive pronouns, shows that the mark has ceased to fulfil its essential function as an indication of origin (§ 38-39). The fact that the expression might be used in quotation marks, in bold or with capital letters is not sufficient to call this conclusion into question (§ 43).

[07/02/2024, T-220/23, CITY STADE \(fig.\), EU:T:2024:61](#)

## 1.5 DEFENCE FOR THE PROPRIETOR

### **Trade mark becoming a common name – Notions of acts and inactivity of the proprietor**

The notion of ‘acts’ pursuant to Article 58(1)(b) EUTMR may be understood as the use by the EUTM proprietor of its trade mark as a common name. The notion of ‘inactivity’ includes all the omissions by which the proprietor of a trade mark shows that it is not sufficiently vigilant as regards the preservation of the distinctive character of its trade mark (§ 49).

[07/02/2024, T-220/23, CITY STADE \(fig.\), EU:T:2024:61](#)

### **Trade mark becoming a common name – Acts and inactivity of the proprietor – Use of the symbol ®**

Although the use of the symbol ® (registered trade mark) by the EUTM proprietor might show that certain efforts have been made to preserve the distinctive character, its effects are very limited. Such activity is clearly of little legal significance and cannot be considered as an activity capable of being decisive in terms of preserving the rights conferred by an EUTM (§ 52-53).

[07/02/2024, T-220/23, CITY STADE \(fig.\), EU:T:2024:61](#)

### **Trade mark becoming a common name – Inactivity of the proprietor – Cease-and-desist letters – Use in a dictionary**

During the relevant period of eight years, the EUTM proprietor has sent three cease-and-desist letters to competitors, which appears to be a very weak reaction. Moreover, it did not react to the generic use of its mark in dictionaries, online encyclopaedias and social networks, even though the generic use of an EUTM in an encyclopaedia could be remedied at the request of the proprietor according to Article 12 EUTMR. Therefore, the contested mark has become a common name in consequence of the ‘inactivity’ of the proprietor, characterised by a low level of vigilance, as well as a form of passivity (§ 58-62).

[07/02/2024, T-220/23, CITY STADE \(fig.\), EU:T:2024:61](#)

## 2 EUTM BECOMING MISLEADING – ARTICLE 58(1)(c) EUTMR

### 2.1 BURDEN OF PROOF

#### **EUTM becoming misleading – Burden of proof**

Revocation referred to in Article 58(1)(c) EUTMR presupposes the existence of actual deception or a sufficiently serious risk of deception of the consumer. The applicability of this is conditional on the misleading use of the mark after its registration. Such misleading use must be duly proved by the applicant (§ 50, 51).

[22/06/2022, T-739/20, Waterford, EU:T:2022:381](#)

#### **Probative value of surveys**

Probative value of surveys depends on the survey method used. Thus, the results of an investigation may lack probative value where the investigation in question is not accompanied by sufficient evidence to ensure its reliability. It may be the case where the survey participants have not been chosen as constituting a representative sample of the population (§ 57, 61).

## **2.2 POINT IN TIME TO BE CONSIDERED**

[No key points available yet.]

## **3 ADDITIONAL GROUNDS FOR REVOCATION OF EU COLLECTIVE MARKS (ARTICLE 81 EUTMR)**

[No key points available yet.]

## **4 ADDITIONAL GROUNDS FOR REVOCATION OF EU CERTIFICATION MARKS (ARTICLE 91 EUTMR)**

[No key points available yet.]

## CHAPTER VI – JURISDICTION

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### **Preliminary ruling – Article 97(5) CTMR [now Article 125(5) EUTMR] – International jurisdiction**

Article 97(5) CTMR must be interpreted as meaning that the proprietor of an EU trade mark, who considers that his rights have been infringed by the use without his consent, by a third party, of a sign identical to that mark in advertising and offers for sale displayed electronically in relation to products that are identical or similar to the goods for which that mark is registered, may bring an infringement action against that third party before an EU trade mark court of the Member State within which the consumers or traders to whom that advertising and those offers for sale are directed are located, notwithstanding that that third party took decisions and steps in another Member State to bring about that electronic display (§ 65).

05/09/2019, C-172/18, [AMS Neve e.a.](#), EU:C:2019:674, § 65

### **Preliminary ruling – Community designs – Article 82(5) CDR – Action brought before the courts of the Member State in which an act of infringement has been committed or threatened – Claims supplementary to the action for infringement – Applicable law – Article 88(2) CDR – Article 89(1)(d) CDR – Article 8(2) Regulation (EC) No 864/2007 of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations (Rome II) – Country in which the intellectual property right was infringed**

Article 88(2) and Article 89(1)(d) CDR and Article 8(2) of Regulation (EC) No 864/2007 on the law applicable to non-contractual obligations (Rome II) must be interpreted as follows. The Community design courts before which an action for infringement pursuant to Article 82(5) CDR is brought for acts of infringement committed or threatened within a single Member State must examine the claims supplementary to that action, seeking the award of damages, the submission of information, documents and accounts and the handing over of the infringing products with a view to their being destroyed, on the basis of the law of the Member State in which the acts allegedly infringing the Community design are committed or threatened. This is the same, in the circumstances of an action brought pursuant to Article 82(5) CDR, as the law of the Member State in which those courts are situated (§ 52).

03/03/2021, C-421/20, [Bayrische Motoren Werke](#), EU:C:2022:152, § 52

### **Transfer of rights – Credibility of transfer agreements**

Transfer agreements are governed by national law. In the event of uncertainty as to the genuine nature of the transfer of the property rights in the design, it is for the national courts to rule on the validity of the transfer agreements in which that transfer is set out (§ 43).

26/04/2023, T-757/21, [Grilling apparatus](#), EU:T:2023:216

### **Preliminary ruling – Rules governing the decision to license a trade mark held in joint proprietorship – Applicable law**

While Union law implicitly (§ 34) and explicitly (§ 36) recognises that a national trade mark and an EU trade mark can be in joint proprietorship, it does not contain any rules governing the question as to whether the decision to grant or to terminate a license of the mark requires a unanimous or a majority decision of the joint proprietors, which therefore brings it within the scope of the applicable national law (§ 34, 36, 37).

27/04/2023, C-686/21, [Legea](#), EU:C:2023:357

**Preliminary ruling – Scope of the counterclaim for a declaration of invalidity – Article 124(d) EUTMR – Article 128(1) EUTMR – Article 59 EUTMR**

The scope of a counterclaim for a declaration of invalidity of an EUTM may relate to the entirety of the contested EUTM and is not restricted by the scope of the dispute as defined by the action for infringement (§ 55). This follows, in particular, from the fact the EUTMR equates the application for a declaration of invalidity submitted to the EUIPO with the counterclaim for a declaration of invalidity filed in connection with infringement proceedings pending before an EU trade mark court (§ 39, 58-79, 50-54) and from the principle of procedural economy (§ 44).

[08/06/2023, C-654/21, LM, EU:C:2023:462](#)

## CHAPTER VII – DESIGN MATTERS

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### 1 REGISTRATION PROCEEDINGS

#### 1.1 CONTENTS OF THE APPLICATION

[No key points available yet.]

#### 1.2 LANGUAGE OF THE APPLICATION

[No key points available yet.]

#### 1.3 DATE OF RECEIPT

[No key points available yet.]

#### 1.4 ALLOCATION OF A FILING DATE

[No key points available yet.]

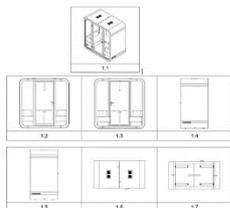
#### 1.5 REPRESENTATION OF THE DESIGN

**No requirement for the representation of the earlier design to include views reproducing it from all possible angles – Features of the earlier design must be apparent from the submitted representation**

It is not apparent from the regulation that the representation of the earlier design must include views reproducing it from all possible angles, so long as that representation allows the shape and the features of the design to be identified (§ 23).

A design may be regarded as having been disclosed when only some of its features are visible in the documents put forward to establish its disclosure (§ 39).

An infringement resulting from an improper extension of the protection of an earlier design takes place only where the BoA, in assessing the overall impression produced by the earlier design, takes into consideration features that are not apparent from the view submitted when that design was registered (§ 31).



30/06/2021, T-373/20, [Buildings \[transportable\]](#), EU:T:2021:400, § 23, 39, 31

## 1.6 COMPLIANCE WITH THE DEFINITION OF A DESIGN

[No key points available yet.]

## 1.7 PUBLIC POLICY AND MORALITY

[No key points available yet.]

## 1.8 INDICATION OF PRODUCTS

### Consideration of the design for the nature, intended use or function of the product

To determine the products in which a design is intended to be incorporated or applied, account should be taken not only of the relevant indication in the application for registration (06/06/2019, T-209/18, Kraftfahrzeuge / Kraftfahrzeuge, EU:T:2019:377, § 33), but also of the design itself, insofar as it makes clear the nature, intended use or the function of product (§ 31).



15/10/2020, T-818/19, [Support pillow](#), EU:T:2020:486, § 31

## 1.9 PRIORITY

### Scope of Article 41(1) CDR – Interpretation of Article 41(1) CDR – Time limit for priority

Although the wording of Article 41(1) CDR does not expressly refer to the claiming of a priority right under a patent, the international patent applications follow the scope of that provision. The broad interpretation of this provision corresponds to the direction of protection of the Patent Cooperation Treaty (PCT), according to which utility models and patents are to be granted equivalent protection in the case of an international application. Pursuant to Article 3(1) PCT, applications for the protection of inventions may be filed in any of the contracting states as international applications within the meaning of this treaty. Furthermore, according to Article 2(i) PCT, 'references to an "application" ... shall be understood as references to applications for patents for invention, for inventors' certificates, for utility certificates, for utility models, for supplementary patents or certificates, for supplementary inventors' certificates and for supplementary utility certificates'. The PCT therefore does not distinguish between the various rights with which the various states mentioned grant protection to the invention (§ 47, 49).

Article 41(1) CDR does not regulate the case of an application for registration of a design by invoking a right of priority based on a patent application and therefore does not provide for a time limit for claiming priority in that situation. It does not exhaustively regulate the time limit within which priority may be claimed in the context of a subsequent application for a design. Therefore, the provisions of the Paris Convention must be taken into account in its interpretation (§ 56-57, 63).

It follows from the logic inherent in the priority system that the duration of the priority period is generally determined by the nature of the prior right (§ 77-80). It is already clear from the wording of Article 4(E)(1) of the Paris Convention that it constitutes a special rule, namely an exception to the principle that the nature of the earlier right is decisive for determining the duration of the priority period (§ 81).

14/04/2021, T-579/19, [Turn- oder Sportgeräte und -artikel](#), EU:T:2021:186, § 47, 49, 56-57, 63, 81 annulled by judgment [27/02/2024, C-382/21 P, Turn- oder Sportgeräte und -artikel, EU:C:2023:576](#) stating in particular the following:

## **Priority right for a design – No direct applicability of Article 4 of the Paris Convention**

The right of priority to file an application for an RCD is governed by Article 41 CDR, without economic operators being able to rely directly on Article 4 of the Paris Convention (§ 69).

[27/02/2024, C-382/21 P, Turn- oder Sportgeräte und -artikel, EU:C:2023:576](#)

## **Priority right for a design – Priority based on an international application filed under the PCT – No priority right based on patent application – Six-months priority right based on utility model**

An international application filed under the PCT can form the basis of a right of priority, pursuant to Article 41(1) CDR, solely provided that firstly (i) the subject of the international application in question is a utility model and, secondly (ii) the time period in which to claim that right on the basis of such an application is that of six months, expressly fixed in Article 41(1) CDR (§ 78).

Article 4 of the Paris Convention does not allow priority to be claimed in respect of an earlier patent application when filing a subsequent design application, and therefore, *a fortiori*, it does not lay down any rules on the time period prescribed to the applicant to that end. Therefore, only an international application filed under the PCT relating to a utility model can give rise to a right of priority for a design application by virtue of that Article 4, within the period of six months referred to in section E, paragraph 1, thereof (§ 85).

Neither Article 41(1) CDR nor Article 4 of the Paris Convention – which, moreover, does not have direct effect in the EU legal order – makes it possible to claim priority for an international application filed under the PCT when filing a subsequent design application within a period of 12 months, irrespective of whether that international application concerns a utility model or a patent. Therefore, when the international application concerns a utility model, the period for claiming a right of priority on the basis of that international application is set at six months whereas, when the international application concerns a patent, the existence of such a right is precluded from the outset (§ 98).

[27/02/2024, C-382/21 P, Turn- oder Sportgeräte und -artikel, EU:C:2023:576](#)

### **1.10 DESCRIPTION**

[No key points available yet.]

### **1.11 MULTIPLE APPLICATIONS**

[No key points available yet.]

## **2 INVALIDITY PROCEEDINGS**

### **2.1 SCOPE OF THE EXAMINATION**

#### **Article 25(1)(b) CDR as ground for invalidity – Scope of the examination**

When the ground for invalidity relied on is Article 25(1)(b) CDR, it does not mean that the Office has to automatically examine all the requirements set out in Articles 4 to 9 EUTMR (§ 51), since those requirements are cumulative and the non-fulfilment of one of them can lead to the invalidity of the design (§ 54, 67).

The requirements set out in Articles 4 to 9 CDR relate to different legal criteria and, therefore, the facts and evidence submitted to prove the infringement of one are not necessarily relevant to the others (§ 68).

10/06/2020, T-100/19, [Acoplamientos para vehículos](#), EU:T:2020:255, § 54, 67-68

### **Earlier design produced after filing of RCD invalidity application – Alteration of the subject matter – No belated evidence**

The earlier design must be identified when the application for a declaration of invalidity is submitted, because the subject matter of the dispute is defined in the application. Only the earlier designs identified in the application for a declaration of invalidity must be examined (§ 53-56).

The discretion conferred on EUIPO to take into account facts or evidence which are not submitted in due time is applicable only to facts and evidence, and not to the indication and the reproduction of the earlier designs. Although further evidence may be taken into account, in addition to the earlier designs already relied on, to expand the factual context of the application for a declaration of invalidity, it may not however be used to extend the legal context of that application, since the scope of that application was definitively determined when the application was submitted, by identifying the earlier design relied on (§ 59, 60).



27/04/2022, T-327/20, [Shower drains](#), EU:T:2022:263, § 53-56, 59, 60

### **Articles 4 to 9 CDR ticked in the RCD invalidity application – Scope of the examination limited to the grounds invoked in the statement of grounds**

The grounds for invalidity referred to in Article 4(2) and (3) CDR and Article 8 CDR cannot be considered validly invoked by the sole fact that, in the application for a declaration of invalidity, the box related to the non-compliance with the requirements laid down in Articles 4 to 9 CDR was ticked. The scope of examination is limited to the grounds invoked in the statement of the grounds on which the application for a declaration of invalidity is based (§ 29, 30, 32, 35, 40). New grounds cannot be invoked at a later stage of the proceedings (§ 33).

[12/10/2022, T-652/21, Acoplamientos para vehículos, EU:T:2022:634](#)

### **Earlier design produced after filing of RCD invalidity application – Out of the scope of examination**

Only the earlier designs identified in the application for a declaration of invalidity must be examined. The earlier design invoked for the first time before the Board of Appeal is out of the scope of examination (§ 65, 66).

[12/10/2022, T-652/21, Acoplamientos para vehículos, EU:T:2022:634](#)

### **Scope of examination limited to prior designs explicitly invoked in relation to the ground under examination**

Where a prior design has only been clearly invoked in support of the ground of lack of novelty (Article 5), examining that earlier design *ex officio* also under Article 6 (lack of individual character) exceeds the competencies of the BoA and thus infringes Article 63(1) CDR. Allowing such an *ex officio* examination of grounds for invalidity that have not been invoked would deprive the design holder of the possibility to put forward its arguments against such ground for invalidity, particularly bearing in mind that in the present case the examination of Article 6 CDR required the application of different criteria (§ 69, 71).

[15/03/2023, T-89/22, Chairs, EU:T:2023:132](#)

### **Earlier design produced after filing of RCD invalidity application – Out of the scope of examination**

Only the earlier designs validly invoked at the time of filing of the application for a declaration of invalidity can be taken into consideration (§ 27-32). The discretion conferred on the EUIPO to take into account belated evidence is not applicable to the indication and reproduction of earlier designs required by Article 28(1)(b)(v) CDIR (§ 47).

[13/12/2023, T-10/23, Lampenschirme, EU:T:2023:804](#)

### **Earlier design produced after filing of RCD invalidity application – Out of the scope of examination**

The discretion conferred on the EUIPO to take into account belated evidence pursuant to Article 63(2) CDR is not applicable to the indication and reproduction of earlier designs required under Article 28(1)(b)(v) CDIR. The proper conduct of the proceedings and the preservation of the legitimate interest of that RCD holder in not being exposed to a dispute the subject matter of which is in constant change preclude the introduction of new grounds for invalidity or new earlier designs during the course of the invalidity proceedings (§ 30, 32).

[21/02/2024, T-82/23, Toilet units \(part of -\), EU:T:2024:102](#)

## **2.2 BELATED EVIDENCE**

### **Admissibility of facts and evidence submitted for the first time before the BoA**

In accordance with Article 63(2) CDR, the BoA may exercise its discretionary power to accept facts or evidence submitted for the first time before it only where those facts or evidence meet the requirements established in Article 27(4) EUTMDR (§ 31, 35).

[30/11/2022, T-611/21, Remote controls \[wireless\] \(Accessories for -\), EU:T:2022:739](#)

[30/11/2022, T-612/21, Remote controls \[wireless\] \(Accessories for -\), EU:T:2022:731](#)

## **2.3 LOCUS STANDI OF THE APPLICANT**

### **Community design – No res judicata**

According to Article 52(3) CDR, an application for a declaration of invalidity shall not be admissible if an application relating to the same subject matter and cause of action, and involving the same parties, has been adjudicated on by a Community design court and has acquired the authority of a final decision.

The identity of the cause of action with that of the prior case implies not only the same legal basis (i.e. reliance on the same legal provisions in support of the applications), but also the same facts and, in particular, the same designs (§ 19-20). In the present circumstances, the parties and the subject matter of the cases are identical, since both proceedings concern an application for a declaration of invalidity of the same design. However, the cause of action differs as the invalidity of the contested design is sought in the proceedings before the Office in relation to a design that was not relied on before (nor ruled upon by) the national court (§ 21-23).

[17/11/2021, T-538/20, Paños de limpieza, Ropa de mesa, EU:T:2021:793, § 19-23](#)

## 2.4 STATEMENT OF GROUNDS

[No key points available yet.]

## 2.5 FACTS, EVIDENCE AND ARGUMENTS

### Application for a declaration of invalidity

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

Making reference to previous decisions, without elaborating further, does not satisfy the requirement to demonstrate the existence of a prior design identical to the contested design (§ 29).

It is for the applicant to make sure that all prior designs relied on are clearly identified and reproduced, given that invalidity proceedings are *inter partes* proceedings (§ 30).

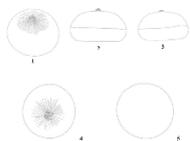
17/09/2019, T-532/18, [Washing sponges](#), EU:T:2019:609, § 24, 29-30

### Burden of proof – Aesthetic quality – Aesthetic considerations – Visual aspect – Alternative designs – Identification of the features of appearance

When an applicant for a declaration of invalidity refers to the ground of invalidity set out in Article 25(1)(b) CDR in conjunction with Article 8(1) CDR, it is for him or her to provide evidence to demonstrate that the respective features of appearance of the product to which the contested design is applied or in which it is incorporated are solely dictated by its technical function. In those circumstances, it is for the holder of that design to adduce evidence to the contrary (§ 35-44).

For assessing whether the features of appearance of the product at issue are not solely dictated by its technical function it is not required to prove that those features have an aesthetic quality. In this respect, the requirement to prove ‘aesthetic considerations’, which are linked to the visual aspect of the appearance of the product, cannot be interpreted as the requirement to prove an aesthetic quality (§ 46-56).

The argument presented for the first time before the GC that the product in question contains additional features of appearance, which were not relied on during the proceedings before the Office, is inadmissible (§ 88-93).



26/01/2022, T-325/20, [Water purifiers](#), EU:T:2022:23, § 35-44, 46-56, 88-93

## 2.6 SCOPE OF DEFENCE

[No key points available yet.]

## 2.7 REPLY BY THE APPLICANT

[No key points available yet.]

## 2.8 EXAMINATION OF THE GROUNDS FOR INVALIDITY

### Lack of reasoning – Article 63 CDR – Scope of the examination in invalidity proceedings

The interpretation of Article 95 EUTMR is applicable, *mutatis mutandis*, to the examination to be carried out by the Office in invalidity proceedings pursuant to Article 63 CDR: the applicant for a declaration of invalidity must provide elements to show that the contested design does not fulfil the requirements set out in Articles 4 to 9 CDR (§ 70-71).

The dismissal of the appeal reflects a complete turnabout in the BoA's position on the application of Article 4(2) and (3) CDR to the contested RCD, as compared to the position indicated in its communication to the parties during the appeal proceedings. The BoA was obliged to clearly state the reasons for that change (§ 114), since that communication, and the subsequent observations submitted by the parties, were part of the context in which it adopted the contested decision (§ 124). Without those reasons, the applicant is not in a position to meaningfully challenge the BoA's departure from the conclusions in its communication (§ 116) and the GC is not in a position to verify the merits of those reasons or to carry out its review properly (§ 117).

10/06/2020, T-100/19, [Acoplamientos para vehículos](#), EU:T:2020:255, § 70-71, 114, 116-117, 124

## 2.9 MAINTENANCE IN AN AMENDED FORM

### Community design – Standing to challenge a decision to maintain a design in an amended form

The ground for invalidity laid down in Article 25(1)(e) CDR provides for a right to prohibit the use of the contested design on the basis of an earlier distinctive sign. Where the applicant has challenged the contested design on this ground and the Office invalidates the design, the design owner may apply to maintain the registration of the contested design in an amended form pursuant to Article 25(6) CDR. Where that amendment consists of removing the earlier distinctive sign from the contested design, the applicant has no standing to challenge the Office's decision to grant the amendment (§ 49, 52, 57, 58, 60, 61).

The design owner has standing to challenge a decision of the Office rejecting its application to maintain the registration of the contested design in an amended form pursuant to Article 25(6) CDR (§ 53).



25/10/2021, T-329/20, [Pendenti](#), EU:T:2021:732, § 49, 52-53, 57, 58, 60, 61

### Maintenance in the amended form – Design declared invalid – Partial disclaimer

According to Article 25(6) CDR, an RCD that has been declared invalid pursuant to Article 25(1)(b), (e), (f) or (g) CDR may be maintained in an amended form. This may include registration accompanied by a partial disclaimer by the holder of the right to the RCD or entry in the Register of a court decision or a decision by the EUIPO declaring the partial invalidity of the RCD (§ 48).

[06/09/2023, T-492/22, Socks \(Set of -\), Packaging boxes, EU:T:2023:516](#)

## 2.10 JURISDICTION

### **Preliminary ruling – Design – Article 90(1) CDR – Jurisdiction of national courts of first instance**

Article 90(1) CDR must be interpreted as meaning that the courts and tribunals of the Member States with jurisdiction to order provisional measures, including protective measures, in respect of a national design also have jurisdiction to order such measures in respect of a Community design (§ 44).

21/11/2019, C-678/18, [Procureur-Generaal bij de Hoge Raad der Nederlanden](#), EU:C:2019:998, § 44

## 3 THE DIFFERENT GROUNDS FOR INVALIDITY

### 3.1 NOT A DESIGN

#### 3.1.1 Living organisms

[No key points available yet.]

#### 3.1.2 Ideas and methods of use

[No key points available yet.]

### 3.2 LACK OF ENTITLEMENT

[No key points available yet.]

### 3.3 COMPONENT PART OF A COMPLEX PRODUCT

#### **Not a component part of a complex product – Relevant factors to taken to take into account**

(i) The consumable nature of the product; (ii) the absence of disassembly and re-assembly of the complex product; (iii) the completeness of the complex product; and (iv) the interchangeability of the product in respect of the complex product are among the factors relevant for finding that that product is not 'a component part of a complex product' in the sense of Article 4(2) CDR (§ 39, 49, 62, 70).

[22/03/2023, T-617/21, \*Welding torches \(part of -\)\*, EU:T:2023:152](#)

#### **Not a component part of a complex product – Consumable nature – Visibility of a consumable**

The absence of a firm and durable connection with the complex product and the regular purchase and replacement on account of its short lifespan are standard characteristics of a consumable (§ 35).

The end user, who regularly purchases and replaces consumables, is able to perceive and assess their characteristics, irrespective of whether they remain visible once inserted into the complex product (§ 37).

[22/03/2023, T-617/21, Welding torches \(part of -\), EU:T:2023:152](#)

### **Not a component part of a complex product – Disassembly and re-assembly of a complex product**

The replacement of a product that is specifically designed to be replaced regularly and in a straightforward manner by end users is less likely to be considered as disassembly and re-assembly of a complex product, within the meaning of Article 3(c) CDR, than the replacement requiring the intervention of professionals with specific expertise (§ 47).

[22/03/2023, T-617/21, Welding torches \(part of -\), EU:T:2023:152](#)

### **Not a component part of a complex product – Completeness of a complex product**

Without its component parts, a complex product will not, in principle, be perceived by the end user as a complete product capable of being subject to normal use or as a product in good condition. However, the mere fact that the complex product cannot function without a particular element, does not in itself mean that that element constitutes its component part in the sense of Article 4(2) CDR (§ 56, 57).

The fact that the product is commonly advertised and sold separately from the complex product is a relevant factor to determine whether the product is a component part of a complex product (§ 59).

[22/03/2023, T-617/21, Welding torches \(part of -\), EU:T:2023:152](#)

### **Not a component part of a complex product – No need to assess the effect on competition**

The BoA is not required to carry out an analysis of the possible adverse effects on competition on the relevant markets in order to determine whether a product constitutes a component part of a complex product within the meaning of Article 4(2) CDR (§ 73-74).

[22/03/2023, T-617/21, Welding torches \(part of -\), EU:T:2023:152](#)

## **3.4 TECHNICAL FUNCTION**

### **Non-compliance with requirements for protection – Features of appearance of a product solely dictated by its technical function**

To assess whether features of the appearance of a product are solely dictated by its technical function, it has to be established that the technical function is the only factor that has determined those features, the existence of alternative designs not being decisive in that regard (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 32) (§ 16).

When the design is applied to a complex product, the answer to the question of whether those features are 'solely dictated by the technical function of the product' pursuant to Article 8(1) CDR, requires, at the outset, an examination of the technical function of each of those features and an examination of the causal link between the technical function of each of those features and the technical function of the product concerned. When there is a causal link between the technical function of the feature and the technical function of the product, that is to say where that feature does contribute to the technical function of the product, that feature is 'solely dictated' by the technical function of the product (§ 54).

The fact that the product concerned contains several features, each of which fulfils a different function, does not exclude the application of Article 8(1) CDR: that provision does not require the features of the appearance to refer to one single technical result, and the features may produce

several technical results, as long as they contribute to achieving the technical result intended by the product (§ 56).

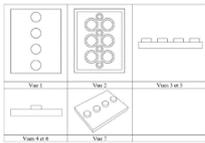


18/11/2020, T-574/19, [fluid distribution equipment](#), EU:T:2020:543, § 16, 54,

56

### **Exception of Article 8(3) CDR – Protection of modular systems – Burden of proof – Reliance on Article 8(3) CDR for the first time before the BoA**

It is for the holder of the contested design to rely on the benefit of Article 8(3) CDR (§ 39). Neither the Regulation on Community designs nor the Rules of procedure of the BoA preclude the benefit of the exception in Article 8(3) CDR from being relied on, for the first time, before the BoA (§ 45-47, 50, 83). According to Article 60(1) CDR, the BoA has jurisdiction, inter alia, to rule on the claims of the proprietor of the contested design relating to the benefit of Article 8(3) CDR (§ 48-49).



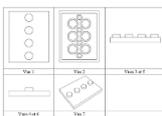
24/03/2021, T-515/19, [Building blocks from a toy building set](#), EU:T:2021:156, 45-

50, 83

### **Features solely dictated by the technical function in Article 8(1) CDR and features of interconnection in Article 8(2) CDR – Applicability of Article 8(3) CDR to both features**

Article 8(1) CDR excludes protection under the law on Community designs for features of the appearance of a product where considerations other than the need for that product to fulfil its technical function, in particular those related to the visual aspect, have not played any role in the choice of those features, even if other designs fulfilling the same function exist (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 31). Features of appearance of the product covered by a design may fall within both Article 8(1) CDR and Article 8(2) CDR since they may both be solely dictated by the technical function of that product, namely to allow the connection and disconnection of that product, and constitute features of interconnection (§ 59-61, 68). However, all features of interconnection for the purposes of Article 8(2) CDR are not necessarily solely dictated by the technical function of the product covered by a design for the purposes of Article 8(1) CDR, since the interconnection of that product may not be the only factor which determined the appearance of those features (§ 62-67).

In order to preserve the effectiveness of Article 8(3) CDR, where the Office finds that the features of appearance of the product covered by the contested design fall within both Article 8(1) and Article 8(2) CDR, and where the holder of the contested design relies on the benefit of Article 8(3) CDR, it must examine whether those features are capable of benefiting from the protection of modular systems, including when the applicant for a declaration of invalidity did not rely on Article 8(2) of that regulation (§ 69-79, 80).



24/03/2021, T-515/19, [Building blocks from a toy building set](#), EU:T:2021:156, 59-

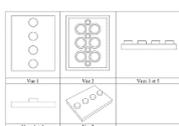
62, 67-80

### **Article 8(1) DCR – Features of the appearance of a product solely dictated by its technical function – Burden of proof**

If at least one of the features of appearance of the product covered by a contested design is not solely dictated by the technical function of that product, the design cannot be declared invalid under Article 8(1) CDR (§ 96, 97-98).

It is for the applicant of a declaration of invalidity to demonstrate and for the Office to find that all the features of appearance of the product covered by the contested design are solely dictated by the technical function of that product (§ 99, 109).

Where the smooth surface of the upper face of a toy brick is a feature of the specific appearance of the product covered by the contested design and is not limited to a mere 'absence of studs on the upper surface of the brick' it must be taken into account (§ 105, 107).



24/03/2021, T-515/19, [Building blocks from a toy building set](#), EU:T:2021:156, 96, 97-99, 105, 107, 109

### **Features solely dictated by the technical function – Identification of the product concerned**

In order to ascertain the product to which a RCD is intended to be applied, the indication which relates to that product in the application for registration of that design should be taken into account, but also, where necessary, the design itself, in so far as it makes clear the nature of the product, its intended purpose or its function. Moreover, EUIPO may rely, in the light of the degree of difficulty of the design at issue, on other relevant material, and, inter alia, on data relating to intellectual property rights conferred previously in respect of the product concerned, such as patents (§ 28-30).

[19/10/2022, T-231/21, Posts, EU:T:2022:649](#)

### **Features solely dictated by the technical function – Means of evidence – Patent application not sufficient in itself to prove exclusive functionality**

A patent application, on account of its exclusively technical purpose, cannot serve automatically to rule out the possibility that considerations other than technical considerations, for example considerations of a visual nature, might also have been taken into account in the creation of a design which is, moreover, represented in that document (§ 32).

[19/10/2022, T-231/21, Posts, EU:T:2022:649](#)

### **Features solely dictated by the technical function – Means of evidence – Expert opinions referring to visual considerations**

All the expert opinions provided confirm the important, or even preponderant, role which technical considerations played in the design process, but, at the same time, they refer to visual considerations having been taken into account in the creation of at least two of the three features of the contested design (§ 40).

[19/10/2022, T-231/21, Posts, EU:T:2022:649](#)

### **Exclusion of Article 8(1) CDR by one non-exclusively functional feature**

If at least one of the features of appearance of the product concerned by a RCD is not solely dictated by the technical function of that product, the design at issue cannot be declared invalid under Article 8(1) CDR (§ 43).

[19/10/2022, T-231/21, Posts, EU:T:2022:649](#)

#### **Features solely dictated by the technical function – Means of evidence – Alternative designs to be taken into account**

The existence of alternative designs, although it does not constitute evidence which makes it possible, on its own and in all cases, to prove that considerations other than technical considerations were taken into account in the creation of the design at issue, constitutes a relevant factor which may be taken into account. The existence of alternative designs may substantiate other items of evidence which have been provided, such as, for example, expert opinions (§ 45).

[19/10/2022, T-231/21, Posts, EU:T:2022:649](#)

#### **Features solely dictated by the technical function – Objective circumstances to be taken into account – Visibility of the product**

The fact that the product concerned is visible to the public is one of the objective circumstances which make it possible to prove that the features of appearance of the product concerned have not been solely dictated by the technical function of that product, although, like the existence of alternative designs, that circumstance cannot, on its own, suffice to prove that (§ 49, 53).

[19/10/2022, T-231/21, Posts, EU:T:2022:649](#)

#### **Features solely dictated by the technical function – Identification of the features of appearance of a product – Usual features**

Features of appearance that are usually present in the product concerned would not usually be considered to be the result of a specific choice made by the designer. Therefore, they do not have to be referred to explicitly when identifying the features of appearance of the product concerned (§ 33-35, 38).



[29/03/2023, T-505/21, Fluid distribution equipment, EU:T:2023:174](#)

[29/03/2023, T-535/21, Fluid distribution equipment, EU:T:2023:175](#)

See also, [29/03/2023, T-545/21, Fluid distribution equipment, EU:T:2023:176](#), § 33-35, 45

[29/03/2023, T-555/21, Fluid distribution equipment, EU:T:2023:177](#), § 33-35, 46-47

[29/03/2023, T-575/21, Fluid distribution equipment, EU:T:2023:178](#), § 34-36, 45

[29/03/2023, T-576/21, Fluid distribution equipment, EU:T:2023:179](#), § 34-36

[29/03/2023, T-577/21, Fluid distribution equipment, EU:T:2023:180](#), § 34-36

[29/03/2023, T-578/21, Fluid distribution equipment, EU:T:2023:181](#), § 34-36, 43

[29/03/2023, T-588/21, Fluid distribution equipment, EU:T:2023:182](#), § 34-36

#### **Features solely dictated by the technical function – Identification of the features of appearance of a product – Subjective perception**

An effect resulting from a subjective description of the design concerned does not constitute a feature of appearance of the product concerned (§ 37, 42).

[29/03/2023, T-545/21, Fluid distribution equipment, EU:T:2023:176](#)

[29/03/2023, T-555/21, Fluid distribution equipment, EU:T:2023:177](#)

See also, [29/03/2023, T-575/21, Fluid distribution equipment, EU:T:2023:178](#), § 38, 43, 46  
[29/03/2023, T-588/21, Fluid distribution equipment, EU:T:2023:182](#), § 38-39

### **Features solely dictated by the technical function – Identification of the features of appearance of a product – Invisible elements**

Elements that will not be noticed by the user when the product concerned is in use do not have a real visual impact capable of classifying them as a 'feature of appearance' (§ 46).

[29/03/2023, T-505/21, Fluid distribution equipment, EU:T:2023:174](#)

See also, [29/03/2023, T-535/21, Fluid distribution equipment, EU:T:2023:175](#), § 47

[29/03/2023, T-545/21, Fluid distribution equipment, EU:T:2023:176](#), § 43

[29/03/2023, T-555/21, Fluid distribution equipment, EU:T:2023:177](#), § 43

[29/03/2023, T-575/21, Fluid distribution equipment, EU:T:2023:178](#), § 44

[29/03/2023, T-576/21, Fluid distribution equipment, EU:T:2023:179](#), § 42

[29/03/2023, T-577/21, Fluid distribution equipment, EU:T:2023:180](#), § 41

[29/03/2023, T-578/21, Fluid distribution equipment, EU:T:2023:181](#), § 41

### **Features solely dictated by the technical function – Burden of proof**

It is for the applicant for a declaration of invalidity to provide reliable and solid arguments and evidence in support of its claim that all the features of appearance of the product concerned are dictated by its technical function. Once that obligation has been fulfilled, it is for the holder of the contested design to produce arguments and evidence to the contrary, since it is best placed to provide information as to the creation of the contested design and the features of appearance of the product to which that design applies (§ 48-49).

[29/03/2023, T-505/21, Fluid distribution equipment, EU:T:2023:174](#)

[29/03/2023, T-578/21, Fluid distribution equipment, EU:T:2023:181](#)

See also, [29/03/2023, T-535/21, Fluid distribution equipment, EU:T:2023:175](#), § 49-50

[29/03/2023, T-545/21, Fluid distribution equipment, EU:T:2023:176](#), § 49-50

[29/03/2023, T-555/21, Fluid distribution equipment, EU:T:2023:177](#), § 51-52

[29/03/2023, T-575/21, Fluid distribution equipment, EU:T:2023:178](#), § 50-51

[29/03/2023, T-576/21, Fluid distribution equipment, EU:T:2023:179](#), § 51-52

[29/03/2023, T-577/21, Fluid distribution equipment, EU:T:2023:180](#), § 50-51

[29/03/2023, T-588/21, Fluid distribution equipment, EU:T:2023:182](#), § 42-43

### **Features solely dictated by the technical function – Alternative designs – Multiple application**

Various alternative configurations of the tubes and balloons, which appear on the designs included in the multiple application for registration, are different ways of enabling a large number of balloons to be filled with water at the same time. This is an indication of the holder's intention to enjoy exclusive protection, equivalent to that conferred by a patent, in respect of the technical solution that is the basis of the product concerned (§ 90).

[29/03/2023, T-505/21, Fluid distribution equipment, EU:T:2023:174](#)

[29/03/2023, T-578/21, Fluid distribution equipment, EU:T:2023:181](#)

See also, [29/03/2023, T-535/21, Fluid distribution equipment, EU:T:2023:175](#), § 91

[29/03/2023, T-545/21, Fluid distribution equipment, EU:T:2023:176](#), § 91

[29/03/2023, T-555/21, Fluid distribution equipment, EU:T:2023:177](#), § 93

[29/03/2023, T-575/21, Fluid distribution equipment, EU:T:2023:178](#), § 92

[29/03/2023, T-576/21, Fluid distribution equipment, EU:T:2023:179](#), § 93

[29/03/2023, T-577/21, Fluid distribution equipment, EU:T:2023:180](#), § 92

## 3.5 DESIGNS OF INTERCONNECTIONS

### **Design of interconnections in a modular system – Examination of the claim under Article 8(3) CDR regardless of the existence of a claim under Article 8(2) CDR**

Where the EUIPO, when examining an application for a declaration of invalidity based on Article 25(1)(b) CDR, read in conjunction with Article 8(1) CDR, finds that the characteristics of the appearance of the product concerned by the contested design fall within both Article 8(1) CDR and Article 8(2) CDR, and where the proprietor of the contested design relies on the benefit of Article 8(3) CDR, the EUIPO must examine whether those features are capable of falling within the protection of modular systems for the purposes of that latter provision, including where the invalidity applicant has not relied on Article 8(2) CDR (§ 31).

[24/01/2024, T-537/22, Building blocks from a toy building set, EU:T:2024:22](#)

### **Designs of interconnection – Exclusion of Article 8(2) CDR by one non-interconnecting feature**

By analogy to Article 8(1) CDR, a design shall be declared invalid pursuant to Article 8(2) CDR only in the case where all its features are excluded from protection under that provision (§ 36).

[24/01/2024, T-537/22, Building blocks from a toy building set, EU:T:2024:22](#)

### **Design of interconnections in a modular system – Lack of novelty or individual character – Burden of proof on the invalidity applicant**

As long as an RCD is not declared invalid, it enjoys the presumption that the conditions of novelty and individual character are met (§ 57-58).

It is for the invalidity applicant disputing the application of Article 8(3) CDR to establish that the contested design cannot be considered as being new and having an individual character. This includes proving the disclosure of an earlier design (§ 72).

[24/01/2024, T-537/22, Building blocks from a toy building set, EU:T:2024:22](#)

## 3.6 LACK OF NOVELTY AND INDIVIDUAL CHARACTER

### 3.6.1 Disclosure of earlier design

#### 3.6.1.1 General principles

### **Preliminary ruling – Articles 4, 6 and 11 CDR – Unregistered Community designs in a (component) part of a (complex) product arising from disclosure of the overall design of the (complex) product – Requirements for the assessment of individual character**

The material conditions required for the protection of a Community design to arise, whether registered or not, namely novelty and individual character, within the meaning of Articles 4 to 6 CDR are the same for both products and parts of a product (§ 33). Provided that those material conditions are satisfied, the formal condition for giving rise to an unregistered Community design is that of making available to the public within the meaning of Article 11(2) CDR (§ 36). In order for the making available to the public of the design of a product taken as a whole to entail the making available of the design of a part of that product, it is essential that the appearance of that part is clearly identifiable when the design is made available (§ 38). However, that does not imply an obligation for designers to make available separately each of the parts of their products in respect of which they seek to benefit from unregistered Community design protection (§ 40).

The concept of 'individual character', within the meaning of Article 6 CDR, governs not the relationship between the design of a product and the designs of its component parts, but rather the relationship between those designs and other earlier designs (§ 47). In order for it to be possible to examine whether the appearance of a part of a product or a component part of a complex product satisfies the condition of individual character, it is necessary for that part or component part to constitute a visible section of the product or complex product, clearly defined by particular lines, contours, colours, shapes or texture. That presupposes that the appearance of that part or component part is capable, in itself, of producing an overall impression and cannot be completely lost in the product as a whole (§ 50).

Consequently, Article 11(2) CDR must be interpreted as meaning that the making available to the public of images of a product, such as the publication of photographs of a car, entails the making available to the public of a design of a part of that product, within the meaning of Article 3(a) CDR, or of a component part of that product, as a complex product, within the meaning of Article 3(c) and Article 4(2) CDR, provided that the appearance of that part or component part is clearly identifiable at the time the design is made available.

In order for it to be possible to examine whether that appearance satisfies the condition of individual character referred to in Article 6(1) of that regulation, it is necessary that the part or component part in question constitute a visible section of the product or complex product, clearly defined by particular lines, contours, colours, shapes or texture (§ 52).



28/10/2021, C-123/20, [Ferrari](#), EU:C:2021:889, § 33, 38, 40, 47, 50,

52

### **Public availability (disclosure) of an earlier design – Article 7 CDR**

A disclosure cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient disclosure of the earlier design, 09/03/2012, T-450/08, *Phials*, EU:T:2012:117 (§ 21-24).

13/06/2019, T-74/18, [Informationstafeln für Fahrzeuge](#), EU:T:2019:417, § 21-24

### **Disclosure**

Under Article 25(1)(a) and (b) CDR, a Community design may be declared invalid only in the cases set out in that provision, in particular if it does not fulfil the requirements of Articles 4 to 9 CDR. The logic underlying Article 25(1)(a) and (b) CDR is, firstly, to prevent the registration of designs that do not satisfy the conditions for protection, in particular those relating to their 'novelty' and their 'individual character' within the meaning of Article 5 and Article 6 of that regulation respectively, and not to protect an earlier design (§ 22-26). Consequently, what matters is the fact that the earlier design was disclosed, and not the extent of the protection granted to that design, which results from the validity of its registration (§ 27).

16/06/2021, T-187/20, [Lampade](#), EU:T:2021:363, § 22-27

### **Disclosure**

Disclosure does not impose any requirement that the earlier design must have been used for the manufacture or marketing of a product (§ 44).



10/11/2021, T-443/20, [Labels](#), EU:T:2021:767, § 44

### Community design – Res judicata

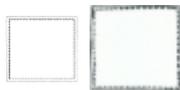
According to Article 52(3) CDR, an application for a declaration of invalidity shall not be admissible if an application relating to the same subject matter and cause of action, and involving the same parties, has been adjudicated on by a Community design court and has acquired the authority of a final decision.

The identity of the cause of action with that of the prior case implies not only the same legal basis (i.e. reliance on the same legal provisions in support of the applications), but also the same facts and, in particular, the same designs (§ 19-20). In the present circumstances, the parties and the subject matter of the cases are identical, since both proceedings concern an application for a declaration of invalidity of the same design. However, the cause of action differs as the invalidity of the contested design is sought in the proceedings before the Office in relation to a design that was not relied on before (nor ruled upon by) the national court (§ 21-23).

17/11/2021, T-538/20, [Paños de limpieza, Ropa de mesa](#), EU:T:2021:793, § 19-23

### Disclosure outside of the EU – Overall impression

The BoA correctly found that previous disclosure in the United States is proven and that the earlier design could reasonably have become known in the circles specialised in the relevant sector operating within the European Union prior to the date of registration of the contested design (§ 34-40). The two designs produce an identical overall impression on the informed user, namely the average consumer, who is reasonably well informed and reasonably observant and circumspect regarding towels and table linen. The contested design does not satisfy the requirements of Article 6 CDR and, therefore, had to be declared invalid pursuant to Article 25(1)(b) CDR (§ 49-59).



17/11/2021, T-538/20, [Paños de limpieza, Ropa de mesa](#), EU:T:2021:793, § 34-40, 49-59

### Evidential burden of disclosure – Implicit consideration of evidence – Form in which products are sold

In the light of the proven existence of events constituting disclosure of the earlier design, the design holder had to establish that the circumstances of the case reasonably prevented such events from becoming known to the circles specialised in the sector concerned in the normal course of business, in accordance with Article 7(1) CDR (§ 43).

The absence of an express reference to the items of evidence in the Board's decision cannot in itself provide a ground for the conclusion that the Board failed to take them into consideration (§ 54).

The fact that the product to which the earlier design was applied is sold disassembled has no bearing on the disclosure of that design within the meaning of Article 7(1) CDR (§ 55).

02/03/2022, T-1/21, [Furniture](#), EU:T:2022:108, § 43, 54-55

### Disclosure outside the EU

It is not required for the events constituting disclosure of the prior design to take place in the territory of the European Union. The mere fact that the website may be intended for customers outside the European Union is therefore not sufficient to prove that the specialised circles operating within the Union had no knowledge of the disclosure of the prior design (§ 35).

18/05/2022, T-256/21, [Armchairs](#), EU:T:2022:297, § 35

### **Proof of disclosure – No presumption of disclosure – Not a well-known fact**

The disclosure of an earlier design does not, as such, constitute a fact within the meaning of Article 63(1) CDR, but is instead the ‘result of a factual assessment’. Therefore, the disclosure cannot be considered a well-known fact that does not need to be demonstrated, even where the products in which that design is incorporated, or to which it applies, have been present on the market for a long time and are therefore generally known to the public (§ 87-88).

[24/01/2024, T-537/22, Building blocks from a toy building set, EU:T:2024:22](#)

### **Disclosure of the prior design as a ‘whole’**

A prior design must be a design which is ‘whole’ or comprises ‘all the component parts’ and which cannot be the result of a combination of features (§ 25).

[06/03/2024, T-647/22, Shoes, EU:T:2024:147](#)

### **Disclosure of the prior design to a not insignificant proportion of the public**

Simply on account of the [well-known] fact that Rihanna was a world-famous pop star, both her fans and the circles specialised in the fashion sector developed a particular interest in the shoes that she wore on the day she became the RCD holder’s creative director. Therefore, a not insignificant proportion of the people who were interested in music or in Rihanna herself, including her clothing, viewed the photos posted by Rihanna closely in order to discern from those photos the appearance of the shoes that the star wore, thus recognising the features of the prior design (§ 53).

[06/03/2024, T-647/22, Shoes, EU:T:2024:147](#)

### **Disclosure – Events known to the specialised circles**

It is sufficient that a single one of the disclosure events became known to the circles specialised in the sector concerned, operating within the EU, for the exception in Article 7(1) RCD not to apply (§ 60).

[06/03/2024, T-647/22, Shoes, EU:T:2024:147](#)

## **3.6.1.2 Establishing the event of disclosure**

### **Means of evidence – Proof of disclosure**

To establish that there has been disclosure of an earlier design, it is necessary to carry out a two-stage analysis to examine: 1) whether the evidence submitted in the application for a declaration of invalidity shows, firstly, that there have been events constituting disclosure of a design and, secondly, that that disclosure occurred before the date of filing or priority of the contested design; 2) if the holder of the contested design has claimed the contrary, whether those events could reasonably have become known in the normal course of business to the specialised circles of the sector concerned operating within the EU, failing which, a disclosure will be considered to have no effect and will not be taken into account (§ 20).

The disclosure of an earlier design cannot be proved by means of probabilities or presumptions but must be demonstrated by solid objective evidence of actual disclosure of the earlier design on the market. In addition, the items of evidence provided by the applicant for a declaration of invalidity must be assessed in relation to each other. Although some of the items of evidence might be insufficient on their own, when combined or read in conjunction with other documents or information, they may contribute to establishing disclosure. Lastly, in order to assess the

evidential value of a document, it is necessary to verify the plausibility and the accuracy of the information contained in that document (§ 22).

27/02/2020, T-159/19, [Furniture](#), EU:T:2020:77, § 20, 22

### **Means of evidence – Proof of disclosure**

The disclosure of an earlier design cannot be proved by means of probabilities or suppositions but must be demonstrated by precise and objective evidence of an effective disclosure in the market (§ 28).

A publication of a patent application by the German Patent Office is proof of a disclosure of a design contained in it (§ 30).

Technical drawings submitted without complementing documents (affidavits, catalogues etc.) are not sufficient as proof of disclosure. They are typically made for internal use (§ 33-35).

24/10/2019, T-559/18, [Medizinische Pflaster](#), EU:T:2019:758, § 28, 30, 33-35

24/10/2019, T-560/18, [Medizinische Pflaster](#), EU:T:2019:767, § 30, 33-35

### **Means of evidence – Disclosure – Burden of proof of disclosure**

As regards the distribution of the burden of proof, where the applicant for invalidity produces evidence from the internet which proves the disclosure of the earlier designs, the proprietor is obliged to prove the lack of credibility of that evidence (§ 73). In this respect, it is not required to prove the manipulation of a website, but to specify credible indications of malware, such as clear references to falsification, indisputable contradictions in the information given or obvious inconsistencies that justify doubts as to the authenticity of the screenshots (§ 75).

20/10/2021, T-823/19, [Bobby pins](#), EU:T:2021:718, § 73, 75

### **Proof of disclosure – Disclosure of the earlier design**

The BoA correctly found that the holder of the contested design had not demonstrated that the circles specialised in the sector concerned, namely the food industry, had been prevented from learning of the publication of the European patent containing a representation of the earlier design. Accordingly, the patent had to be considered as having been disclosed to the public (§ 33-38).

01/12/2021, T-662/20, [Triple helicoid cheese](#), EU:T:2021:843, § 33-38

### **Proof of disclosure – Disclosure of an earlier design in China – Obligations of the Office**

Regarding the alleged obligation of the BoA to carry out *ex officio* a check with the Chinese Intellectual Property Office, it is clear from the case-law that, firstly, it is for the party that filed the application for a declaration of invalidity to provide the Office with the necessary information and, in particular, the precise and complete identification and reproduction of the design alleged to be prior art, to demonstrate that the contested design cannot validly be registered. Secondly, it is not for the Office, but for the applicant of a declaration of invalidity to provide evidence of the application of the invalidity ground. In these circumstances, the applicant cannot criticise the BoA for not having carried out, on its own initiative, checks with the Chinese Intellectual Property Office (§ 28-29).

The BoA was not obliged to invite the parties *ex officio* to supplement their own pleadings and documents before it. This applies in circumstances such as those of the present case where it is apparent from the file that the intervener, which is the other party concerned in the *inter partes* proceedings, argued in the proceedings before the Office that the applicant had not established

to the required legal standard that an earlier disclosure of the Chinese design had taken place. However, despite this argument, the applicant failed to provide any further evidence concerning the disclosure. In these circumstances, there was no reason for the Office to invite the applicant to provide additional evidence in support of its application for a declaration of invalidity (§ 32-34).

*22/09/2021, T-685/20, [Roller](#), EU:T:2021:614, § 28-29, 32-34*

*22/09/2021, T-686/20, [Roller](#), EU:T:2021:615, § 28-29, 32-34*

### **Conflict of design with prior design – Irrelevance of the declaration of invalidity of the earlier design – Disclosure within the EU**

It is irrelevant that the earlier RCD was declared invalid. Neither Article 28(1)(b)(v) CDIR nor Articles 5 and 6 CDR refer to the registration of the earlier design. On the contrary, Article 6 CDR refers to ‘any design which has been made available to the public’ without in any way requiring that that design be ‘registered’ (§ 21-30). Publication of an earlier design in the bulletin of any intellectual property office constitutes an event of disclosure under Article 7(1) CDR (§ 35-36).

*22/09/2021, T-503/20, [Signalling apparatus and devices](#), EU:T:2021:613, § 21-30*

### **Probative value of written statements – Affidavit**

The particulars in an affidavit made by a person linked, in any manner whatsoever, to the company relying on it must, in any event, be supported by other evidence (§ 57).

*02/03/2022, T-1/21, [Furniture](#), EU:T:2022:108, § 57*

### **Proof of disclosure – Technical drawings**

The production of a technical drawing does not in itself generally prove that the drawing has actually been brought to the attention of the public, but it may be capable of corroborating other evidence showing that products conforming to the specifications of that drawing and bearing the same references have been placed on the market (§ 62).

*[21/06/2023, T-347/22, Schmelztiegel II, EU:T:2023:344](#)*

### **Proof of disclosure – Circumstantial evidence**

Where the context in which photographs showing images of products corresponding to the earlier design were taken is known only from the intervener’s own statements, the BoA may be able to take those aspects into account in so far as they corroborate a body of consistent circumstantial evidence capable of establishing the disclosure of the earlier design (§ 67).

*[21/06/2023, T-347/22, Schmelztiegel II, EU:T:2023:344](#)*

#### **3.6.1.3 Official publications**

[No key points available yet.]

#### **3.6.1.4 Exhibitions and use in trade**

[No key points available yet.]

### 3.6.1.5 Disclosures derived from the internet

#### Means of evidence – Disclosure – Credibility of online evidence

The applicant for a declaration of invalidity is free to choose the evidence that they wish to present. The appearance of an image of a design on the internet constitutes an event that can be classed as 'publication' and, therefore, as 'disclosure'. The probative value of screenshots as evidence is not limited (§ 26, 32, 41).

In the present case, the screenshots of the websites clearly show the designs that are identical to the contested design, the full uniform resource locator (URL) addresses of those websites and the dates of disclosure prior to the date of filing of the contested design. In addition, one screenshot contains further information provided with a time stamp. This consists of comments from internet users that prove disclosure on 1 November 2009 (§ 33-34, 37, 39-40, 42-44).

The purely abstract possibility of the content of a website or a date being manipulated does not constitute a sufficient reason to call the credibility of the evidence into question. This credibility can only be called into question by referring to facts that specifically suggest a manipulation (§ 49). Even though the screenshot obtained from the Wayback Machine does not contain an image of the product, it is a relevant source of information that confirms the reliability of the screenshot of one of the websites in question (§ 57-58).

*20/10/2021, T-823/19, [Bobby pins](#), EU:T:2021:718, § 26, 32-34, 37, 39-40, 41-44, 57-58*

#### Proof of disclosure – Credibility of printouts of websites

The mere abstract possibility to manipulate the content or date of a website does not constitute sufficient grounds for calling into question the credibility of the evidence constituted by the screenshot of a website. This credibility can only be challenged by facts that concretely suggest manipulation. Such facts may include clear signs of falsification, indisputable contradictions in the information presented or obvious inconsistencies which may reasonably justify the existence of doubts as to the authenticity of the impressions from the website in question. In that regard, the mere fact that a website is no longer accessible because it has ceased to be updated or has been replaced does not mean that it never existed and its impressions were manipulated (§ 31, 32).

*18/05/2022, T-256/21, [Armchairs](#), EU:T:2022:297, § 31, 32*

#### Disclosure – Credibility of online evidence – Amazon screenshots

The mere abstract possibility that the content or date of a website may be manipulated is not a sufficient ground to undermine the credibility of evidence constituted by a screenshot of that website. That credibility may be undermined only by invoking facts that concretely suggest a manipulation, such as clear indications of falsifications, indisputable contradictions in the information provided or obvious inconsistencies that may reasonably justify doubts about the authenticity of the screenshots of the website in question ([20/10/2021, T-823/19, Bobby pins, EU:T:2021:718](#), § 49) (§ 40).

*[15/03/2023, T-89/22, Chairs, EU:T:2023:132](#)*

#### Proof of disclosure – Posting on the internet

Posting on the internet is, in principle, a circumstance that may constitute a disclosure within the meaning of Article 7 CDR (§ 62).

*[21/06/2023, T-347/22, Schmelztiegel II, EU:T:2023:344](#)*

#### Proof of disclosure – Instagram posts – Discernability of the features

The disclosure of an earlier design cannot be proved by means of probabilities or suppositions but must be demonstrated by solid and objective evidence that proves effective disclosure of the earlier design on the market (§ 34).

In the present case, the photos posted on Instagram are of sufficient quality to allow all the features of the prior design to be recognised, bearing in mind that what counts in that regard is the appearance and quality of those photos as contained in the EUIPO's file (§ 46).

Even if some of the images do not focus on the shoes, they nevertheless make it possible to perceive the overwhelming majority of the elements making up those shoes and, more importantly, all the features of the prior design (§ 47).

The photos in question are not so blurred or small that the details in those photos cannot be discerned. In addition, it is common knowledge that a photo shown on Instagram could be zoomed in on (§ 51). These photos are sufficient in themselves, in terms of the number of details they show, as well as in terms of their visual quality, for it to be concluded that, on the date on which the contested decision was adopted, the features of the prior design were discernible (§ 54).

[06/03/2024, T-647/22, Shoes, EU:T:2024:147](#)

#### **3.6.1.6 Disclosure to a third person under explicit or implicit conditions of confidentiality**

[No key points available yet.]

#### **3.6.1.7 Disclosure within the priority period**

[No key points available yet.]

#### **3.6.1.8 Grace period**

##### **Grace period – Contractual freedom – Transfer with retroactive effect**

Contractual freedom to transfer intellectual property rights cannot be limited in the absence of EU rules imposing specific restrictions in that regard. Provided that a contractual clause of a transfer agreement is not contrary to the objective pursued by the applicable EU rules and does not involve any risk of fraud, such clause cannot be regarded as unlawful (§ 25).

No provision in EU rules prohibits contracts retroactively transferring intellectual property rights (§ 26). The aim of the exception provided for in Article 7(2) CDR is to protect the interests of the designer and his or her successor in title (§ 28). A prior business relationship between the parties does not indicate any risk of fraud (§ 30). There is nothing in Article 7(2) CDR which prohibits a registered design that is subject to the 'grace period' from being acquired and that exception from being benefited from (§ 36). The fact that the transfer agreements were signed after the filing date of the contested design is, in itself, irrelevant since it is clear from the content of those agreements that the transfer of the rights was already effective earlier and no risk of fraud or of circumvention of the objective of Article 7(2) CDR has been established (§ 35).

[26/04/2023, T-757/21, Grilling apparatus, EU:T:2023:216](#)

#### **3.6.2 Assessment of novelty**

##### **Individual character – No need to assess novelty**

Where the contested design has individual character, it is not necessary to examine the requirement of novelty because the novelty of a design may be inferred from the fact that it has individual character (§ 170-173).

27/04/2022, T-327/20, [Shower drains](#), EU:T:2022:263, § 170-173

### **Invalidity action based solely on lack of novelty – Irrelevance of lack of individual character**

The lack of novelty of the design within the meaning of Article 5 CDR and the lack of individual character of that design within the meaning of Article 6 CDR are two separate grounds for invalidity that require application of different legal criteria. Lack of novelty and lack of individual character must be claimed separately (§ 32-33).

[06/09/2023, T-492/22, Socks \(Set of -\), Packaging boxes, EU:T:2023:516](#)

### **3.6.3 Assessment of individual character**

#### **Freedom of designer – Individual character – Overall impression – Technical function of design**

The saturation of the state of the art is not a restriction of the designer's freedom of design. It is up to the invalidity applicant to prove that the freedom of the designer is not restricted by regulations or technical function (§ 29). The impression created by a design is also determined by the way in which the product is used (§ 43). It is irrelevant that not all of the contested design's elements are shown in all graphical representations since all elements are shown together in at least one of the graphical representations (§ 51). Although the earlier design does not show certain parts of the contested design, the assessment of the overall impression is not limited to those elements. All elements are to be taken into account when assessing whether the overall impression of the contested design is different from that produced by the earlier design (§ 54-56).



07/02/2019, T-766/17, [Leuchten](#), EU:T:2019:68, § 29, 43, 51, 54-56



07/02/2019, T-767/17, [Leuchten](#), EU:T:2019:67, § 29, 43, 51, 54-56

#### **Freedom of designer – No Individual character – No different overall impression**

When assessing the individual character of a design, any differences that are insufficiently significant to affect the overall impression are not to be taken into account, even though they may be more than insignificant details (§ 25, 40).

The comparison of the overall impressions produced by the designs must be synthetic in nature and cannot be confined to the analytical comparison of a list of similarities and differences (§ 49).



10/05/2019, T-517/18, [Backwaren](#), EU:T:2019:323, § 25, 40, 49

#### **Freedom of the designer – No individual character – No different overall impression**

The freedom of the designer is restricted, inter alia, by the constraints of the features imposed by the technical function of the product or an element thereof, or by statutory requirements applicable

to the product. Marketing trends are irrelevant. The greater the designer's freedom in developing a design, the less likely it is that minor differences between the designs will be sufficient to produce different overall impressions on an informed user. Indeed, this only moderates the individual character assessment, but does not determine how different the two designs have to be in order for one of them to have individual character, 10/09/2015, T-525/13, Sacs à main, EU:T:2015:617 (§ 35).



13/06/2019, T-74/18, [Informationstafeln für Fahrzeuge](#), EU:T:2019:417, § 35

### Minor differences – No individual character – No different overall impression

Despite the relatively high level of attention, the informed user does not notice minor differences that may exist between the designs (13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 90) (§ 62).



08/07/2020, T-748/18, [Pneumatic power tools](#), EU:T:2020:321, § 62

### Freedom of designer – Informed user – Different overall impression

The informed user of vehicles is aware that manufacturers regularly submit their models to technical and visual restyling (§ 28).

If differences are sufficiently clear to conclude that the design produces a different overall impression on the informed user, a weighting of each of the characteristics and an analysis of common points is not required (§ 43).

The freedom of motor vehicle designers is limited to the extent that a motor vehicle's purpose is to transport people or products and is subject to certain legal requirements which oblige it to include elements such as headlights, stop lights, indicators and mirrors (§ 46).

Potential market expectations or certain design trends do not constitute relevant limitations on the freedom of the designer (§ 50).



06/06/2019, T-43/18, [Fahrzeuge](#), EU:T:2019:376, § 28, 43, 46, 50

### Informed user – Individual character – Different overall impression

The informed user of vehicles is aware that manufacturers regularly submit their models to technical and visual restyling (§ 28).

If differences are sufficiently clear to conclude that the design produces a different overall impression on the informed user, a weighting of each of the characteristics and an analysis of common points is not required (§ 45).

The freedom of motor vehicle designers is limited to the extent that a motor vehicle's purpose is to transport people or products and is subject to certain legal requirements which oblige it to include elements such as headlights, stop lights, indicators and mirrors (§ 48).

Potential market expectations or certain design trends do not constitute relevant limitations on the freedom of the designer (§ 52).



06/06/2019, T-191/18, [Kraftfahrzeuge](#), EU:T:2019:378, § 28, 45, 48, 52



06/06/2019, T-192/18, [Kraftfahrzeuge](#), EU:T:2019:379, § 28, 45, 48, 52

### **Freedom of designer – Informed user – No individual character**

**Informed user.** In order to ascertain the product in which the contested design is intended to be incorporated or to which it is intended to be applied, the relevant indication in the application for registration of that design should be taken into account, and also, where necessary, the design itself, insofar as it clarifies the nature of the product, its intended purpose or its function. Such consideration may enable the identification of the product within a broader category of goods indicated at the time of registration and therefore to determine the informed user and the degree of freedom of the designer in developing its design (§ 33-34).

There are no special categories in the current International Classification for Industrial Designs designating 'sports cars', 'limousines' or 'Porsche 911', and the RCD proprietor itself requested and obtained the registration of the contested design for goods in Class 12-08 *motor cars, buses and lorries* (§ 36). Thus, the informed user of the products is not a user of 'Porsche 911' cars, but of cars in general, who is familiar with the models available on the market and whose level of attention and interest is high (§ 28, 33-35, 37).

**Freedom of designer.** The freedom of motor vehicle designers is limited to the extent that a motor vehicle's purpose is to transport people or products and is subject to certain legal requirements which oblige it to include elements such as headlights, stop lights, indicators and mirrors. However, it is not restricted in relation to the design of these components (§ 50).

Potential market expectations or certain design trends (namely the expectations of consumers, to find the 'design concept' of the 'Porsche 911' in the following series) do not constitute relevant limitations on the freedom of the designer (§ 51, 56-57, 61).

Minor changes, such as the rearrangement of the bumper, the different air intake openings or the removal of the tailboard are not sufficient, in the eyes of the informed user, to cause a different global impression with regards to the earlier model. Therefore, the contested designs lack novelty and individual character (§ 94).



06/06/2019, T-209/18, [Kraftfahrzeuge](#), EU: T:2019:377, 28, 33-35, 37, 50-51, 56-57, 61



06/06/2019, T-210/18, [Personenkraftwagen](#), EU:T:2019:380, § 28, 33-35, 37, 50-51, 56-57, 61

### **Conflict of design with prior design – No individual character – No different overall impression**

The classification of the products may contribute to establishing the overall impression produced by that design on the informed user for the purpose of assessing whether it has individual character in relation to an earlier design (§ 28).

The presence of visible foodstuffs inside the products in which the contested design is intended to be incorporated merely provides a better illustration of their purpose, namely as packaging for foodstuffs, as well as one of their components, specifically the transparent lid (§ 31).

The comparison of the overall impressions produced by the designs must relate solely to the elements actually protected (13/06/2017, T-9/15, Dosen [für Getränke], EU:T:2017:386, § 79). The protection conferred by the contested design relates to its appearance in that it is intended to be incorporated into packaging for foodstuffs having certain components with specific characteristics, namely a metal container that has a transparent lid with a translucent tab. The foodstuffs inside the container must not therefore be taken into consideration for the purpose of assessing the 'overall impression' (§ 33).

The assessment of the overall impression produced on the informed user by a design includes the manner in which the product represented by that design is used (21/11/2013, T-337/12, Sacacorchos, EU:T:2013:601, § 46). Accordingly, the informed user of the contested design, whether a consumer of the preserves or a professional of the food processing industry, will assess that design according to the purpose of the products, namely as packaging for foodstuffs, and will be able to differentiate between that packaging and its contents. Therefore, the appearance of the foodstuffs contained in the packaging in which the contested design is intended to be incorporated, as well as their specific arrangement inside that packaging, is not relevant for the purpose of assessing the overall impression produced on the informed user by the contested design (§ 40).



12/03/2019, T-352/19; [Packaging for](#)

[foodstuffs](#), EU:T:2020:94, § 28, 31, 33, 40



12/03/2019, T-353/19; [Packaging for foodstuffs](#),

EU:T:2020:95, § 28, 31, 33, 40

### **Conflict of design with prior design – No individual character – No different overall impression**

The assessment of the earlier design's overall impression on the informed user must include the way in which the product represented by that design is used (07/11/2013, T-666/11, Gatto domestico, EU:T:2013:584, § 31). The fact that the representation of the earlier design is limited to a single view, representing the tool in question in an open position, does not exclude the possibility of comparing it with the contested design insofar as the visual representation of the tool in question in a closed position may be deduced from the representation of the earlier design (21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 80) (§ 41).



29/04/2020, T-73/19, [wood splitting tools](#), EU:T:2020:157, § 41

**Article 6(1) CDR – Different linguistic versions – Uniform interpretation – Individual character – Different overall impression**

The Italian version of Article 6(1) CDR states that the RCD is deemed to have individual character if the overall impression it produces on informed users differs ‘significantly’ from that produced by any design which has been made available to the public. That Article, however, must be applied in accordance with the uniform interpretation in case-law and taking into consideration the other linguistic versions where the qualifier ‘significantly’ does not appear (§ 29, 32, 34).

The perspective during the use of scooters does not prevail since the purchase choice is also based on design (§ 57).



24/09/2019, T-219/18, [Ciclomotori](#),

EU:T:2019:681, § 29, 32, 34, 57

**Article 6 CDR – Different overall impression – Unprecedented character or originality of the appearance of the prior design – Individual character – Informed user**

The wording of Article 6 CDR is clear and unambiguous: For the purposes of applying Article 25(1)(d) CDR and assessing whether there is a conflict between the designs, a design is eligible for the protection afforded by the Community design if it produces on the informed user a different overall impression from that produced by a prior design (§ 37).

Neither a claimed particular ‘broad protection’ of the prior design nor the reference in Recital 14 of the CDR to the existence of a ‘clear’ difference between the overall impressions can change the assessment criteria (§ 37). The allegedly unprecedented character or originality of its appearance does not have any influence whatsoever on the assessment of the individual character of the contested design. Even if it were established that, at the date of its registration, the shape resembling the structure of a dumbbell applied to a beverage bottle would have been entirely new in the industrial sector concerned, the uniqueness of such a shape does not confer on the prior design broader protection than that which it enjoys under the CDR (§ 40).

A design has individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by the prior design. The assessment of the individual character involves taking into account all the elements that distinguish the designs, other than those which remain insufficiently significant to affect that overall impression (§ 31, 64). Even without a label, the designs have significant differences (§ 66-70). The contested design and the prior design produced different overall impressions on the informed user (§ 71).



21/04/2021, T-326/20, [Beverage bottles](#), EU:T:2021:208, 31, 37, 40, 64,

66-71

## Article 6 CDR – Conflict of design with prior design – Informed user – Lack of individual character

The BoA correctly reasoned that the main assessment of the overall impressions of the designs had to be made with regard to the front view. This section remains visible during normal use of the device and determines the overall impression produced by the device. The general appearance of the front panel is not determined by technical constraints. The designer is free to choose the shape of the panel, the configuration and position of the alert indicators, and the position of the remaining verbal and figurative elements (§ 53-59). The BoA was right to conclude that the contested design has no individual character within the meaning of Article 6(1)(b) CDR (§ 99).



22/09/2021, T-503/20, [Signalling apparatus and devices](#), EU:T:2021:613, § 53-5, 99.

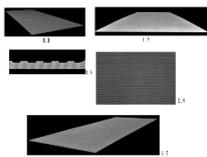
## Only the contested design is relevant in determining the sector concerned, the informed user and the designer's degree of freedom – The goods actually marketed may be taken into account, albeit only for illustrative purposes – Colours are irrelevant when the contested design is registered in black and white – Lack of individual character

The determination of the sector of the products in which the design is intended to be incorporated or applied is a necessary precondition for defining the informed user and the freedom of the designer (§ 22).

The determination of the relevant sector, the informed user and the designer's degree of freedom must be carried out only in relation to the design that's individual character is being assessed (§ 24).

The goods actually marketed that apply or incorporate the designs can only be taken into consideration for illustrative purposes to determine the visual aspects of those designs. However, this consideration is only permitted on the condition that the products actually marketed correspond to the designs as registered (§ 28-33).

When the contested design is registered in black and white, any colour used in the earlier design is not relevant to their comparison, given that no colour has been claimed for the contested design (§ 82).

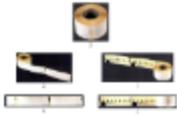


10/11/2021, T-193/20, [Panels](#), EU:T:2021:782, § 22, 24, 28-33, 82

## Overall impression – Technical features – Trade marks present on designs – Lack of individual character

Regardless of whether the feature is solely or primarily dictated by the technical function of the product, it will not contribute to the appearance of the contested design where the informed user will not focus their attention on that feature (§ 74).

The signs were composed of word and figurative elements affixed on the product to indicate its origin and did not have an ornamental or decorative function. Therefore, they were not among the features of the product that gave the goods their appearance. Those word and figurative elements were irrelevant in the comparison of the overall impressions for the purposes of establishing the individual character of the contested design (§ 80).



10/11/2021, T-443/20, [Labels](#), EU:T:2021:767, § 74, 80

**Community design – Degree of freedom of the designer – Article 7 CDR – No individual character – No different overall impression – Article 6 CDR**

The BoA correctly found that the contested design lacked individual character and that the overall impressions produced on the informed user by the two designs were the same. The designer's degree of freedom in developing dolls' heads is wide and that freedom is restricted only in so far as those heads must follow the basic characteristics of a human being. However, this freedom is not restricted by market preferences as regards the appearance of 'fashion dolls' (§ 39-41). What will strike the attention of the informed user is that both designs show a doll's head with an oval-shaped face, the same facial characteristics and proportions, very similar make-up, and the same expression. Considering the wide degree of freedom enjoyed by the designer, the differences between the designs are insufficiently pronounced to produce different overall impressions (§ 53-65).

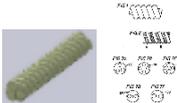


01/12/2021, T-84/21, [Doll's heads](#), EU:T:2021:844, § 53-65

**Article 7 CDR – Individual character – Different overall impression – Article 6 CDR**

The degree of freedom of the designer of the cheeses is relatively high. The informed user to be taken into account is a consumer from the general public who shops for foodstuffs and has a certain degree of knowledge as to the shapes and sizes that cheeses may have (§ 49, 51-54).

The contested design and the earlier design produced the same overall impression on the informed user. The contested design does not have the individual character required by Article 6(1) CDR. The BoA correctly concluded that the application for a declaration of invalidity had to be upheld, without it being necessary to assess the other grounds relied on in that application (§ 57-63).



01/12/2021, T-662/20, [Triple helicoid cheese](#), EU:T:2021:843, § 49, 51-54, 57-63

**No individual character – Lack of novelty – Different overall impression**

The BoA was fully entitled to find that the application for a declaration of invalidity under Article 25(1)(b) CDR in conjunction with Articles 5 and 6 CDR for a lack of novelty and individual character, had to be refused due to the conflicting designs' different overall impression resulting from, among other things, the diverging features of the soles and the stitches (§ 46, 62, 108, 120-121).



15/12/2021, T-682/20, [Schuhwaren](#), EU:T:2021:907, § 46, 62, 108, 120-121



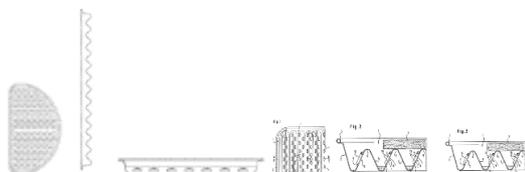
15/12/2021, T-683/20, [Schuhwaren](#), EU:T:2021:909, § 46, 62, 108, 120-121



15/12/2021, T-684/20, [Schuhwaren](#), EU:T:2021:912, § 46, 62, 108, 120-121

### **Article 6(1)(b) CDR – Assessment of individual character when the earlier design represents the appearance of a ‘part’ of the product**

The BoA has the possibility to take into consideration, for the purposes of assessing the individual character of the contested design, an earlier design that represents the appearance of a ‘part’ of the product at issue, within the meaning of Article 3(a) CDR (§ 27). Such representation of the earlier design must be sufficiently precise and specific to enable the BoA to assess the individual character of the contested design (§ 35). Even if the earlier design does not show the entirety of the appearance of the product at issue, the BoA is called upon to assess the submitted evidence as a whole. Therefore, the BoA is entitled to validly take into account all the illustrative figures and the claims of the patent specification in which the earlier design was disclosed (§ 39).



02/02/2022, T-173/21, [Grillschalen](#), EU:T:2022:41, § 35,

39

### **Influence of some parts of the product on its overall impression**

The designs represent wardrobes, which are, most often, handled by opening their doors and are intended to be placed on the ground and against a wall. Therefore, their rear, lower and upper surfaces will be, at the very least, not very visible, and are liable to have little influence on the overall impression produced on the informed user (§ 77).



02/03/2022, T-1/21, [Furniture](#), EU:T:2022:108, § 77

### **Relevancy of an earlier design incorporated into a different product**

An earlier design incorporated into a product other than the one to which the contested design relates is, in principle, relevant for the purposes of assessing individual character (§ 111).

27/04/2022, T-327/20, [Shower drains](#), EU:T:2022:263, § 111

### **Features of the contested design**

The contested design must be compared with the earlier designs as it was registered. Conclusions as to the subject matter and features of the contested design cannot be left to the discretion of the parties (§ 102-104).

27/04/2022, T-327/20, [Shower drains](#), EU:T:2022:263, § 102-104

### **Sector concerned – Identification of product category – Impact on designer’s degree of freedom**

The applicant merely argues that there is a special category of ‘racing-style gaming chairs’ where bucket-shape seat is generic for that type of product. However, the applicant’s arguments or evidence cannot establish how such products constitute a special category which is distinct from ‘gaming chairs’ in general, by virtue of their nature, purpose or function. Therefore, there are no objective reasons to distinguish a narrower subcategory. It follows that the Board of Appeal was right to consider that the sector concerned was that of ‘armchairs’ and, more specifically, ‘gaming chairs’ (§ 48-50).

Since the relevant sector is that of 'gaming chairs', the Board of Appeal correctly considered, that the bucket shape of the seat or the insertion of lumbar and cervical cushions were not features imposed by the technical function of the product. Furthermore, the applicant did not show how those features were necessary to satisfy ergonomic, durability, stability, comfort or safety requirements (§ 55, 56).



18/05/2022, T-256/21, [Armchairs](#), EU:T:2022:297, § 48-50, 55, 56

### **Informed user's perception – Marginal influence of technical documentation**

The informed user of heating radiators, without being an expert in industrial design as would be an architect or interior designer, is aware of what is available on the market, fashion trends and the basic characteristics of the product (§ 34). However, he is not an expert or a technician in the sanitary ware sector and his knowledge derives mainly from the experience he has gained by using the product and from his interest in it, which leads him to consult design and furnishing magazines, by visiting specialized stores and by surfing the internet. Purely technical documentation, not accompanied by the representation of the products concerned on the market, will have a very marginal influence on the perception of the informed user (§ 94).

[15/06/2022, T-380/20, Radiatori per riscaldamento, EU:T:2022:359](#)

### **Saturation of the state of art – No impact on designer's degree of freedom**

A general design trend cannot be regarded as a factor which restricts the designer's freedom (§ 43). Saturation of the state of the art cannot be said to limit the freedom of the designer. Such a saturation of the state of art, resulting from the existence of other designs which have the same overall features as the designs at issue, cannot constitute a constraint linked to the characteristics imposed by the technical function of a product and does not respond to legal requirements applicable to the product (§ 47).

[15/06/2022, T-380/20, Radiatori per riscaldamento, EU:T:2022:359](#)

### **Identification of the product – Use of the product**

In order to ascertain the product in which the contested design is intended to be incorporated or to which it is intended to be applied, the relevant indication in the application for registration of that design should be taken into account, but also, where necessary, the design itself, in so far as it makes clear the nature of the product, its intended purpose or its function (§ 59). In assessing the individual character, account should be taken of the manner in which the product in question is used, especially in relation to the handling to which it is normally subjected (§ 126).

[15/06/2022, T-380/20, Radiatori per riscaldamento, EU:T:2022:359](#)

### **Saturation of the state of art – Impact on individual character**

Saturation of the state of the art, while not to be considered as limiting the freedom of the designer, may be such as to render the user more sensitive to differences in detail of conflicting designs. Therefore, a design, because of a saturation of the state of the art, may have individual character because of features which, in the absence of such saturation, would not be likely to create a difference in overall impression on the informed user (§ 67). The coexistence of a dozen models of radiators produced by five companies is not sufficient to demonstrate saturation of the state of the art (§ 105).

[15/06/2022, T-380/20, Radiatori per riscaldamento, EU:T:2022:359](#)

### **Overall impression – Absence of ornamental elements**

The existence or absence of ornamental or decorative elements in the designs plays a role in the comparison of overall impressions (§ 122).

[15/06/2022, T-380/20, Radiatori per riscaldamento, EU:T:2022:359](#)

### **Individual character – Assessment of overall impression – Comfort of use of the product**

Apart from the visual aspects, the differences between the designs under comparison related to the comfort of use of the products in question can also be relevant when assessing the overall impression produced on the informed user (§ 54).

[06/09/2023, T-377/22, Motos acuáticas, Embarcaciones a motor, EU:T:2023:504](#)

### **Assessment of individual character – Irrelevance of expert’s legal opinion**

Although expert opinions are admissible means of evidence, it is not for the expert to make legal assessments, particularly as regards the individual character of the contested design (§ 65-68).

[06/09/2023, T-377/22, Motos acuáticas, Embarcaciones a motor, EU:T:2023:504](#)

### **Knowledge of the informed user**

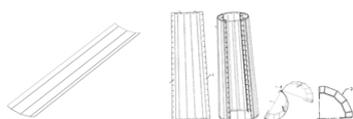
It cannot be held that the informed user is fully aware of the details of all the designs available on the market, even if the number of customers in the particular sector is small and those customers are highly specialised (§ 39).

[24/01/2024, T-201/22, Building materials, EU:T:2024:27](#)

[24/01/2024, T-202/22, Building materials, EU:T:2024:28](#)

### **No individual character – Knowledge of the informed user of the shape of the final product**

In the case of a design incorporating a segment of a tower, the informed user will be aware of the shape of the final product. It will notice that the final towers, once assembled, will not have the same shape because of the different shapes of the sheets (§ 58-59).



[24/01/2024, T-201/22, Building materials, EU:T:2024:27](#)

[24/01/2024, T-202/22, Building materials, EU:T:2024:28](#)

### **Freedom of designer – Limited freedom despite the existence of extravagant shapes**

The degree of freedom of a designer of a toilet lid is limited by the constraints of the overall shape and dimensions of the toilet bowl as well as by the technical function, namely to cover the seat of the bowl. The fact that there may be variants of lids of asymmetrical or extravagant shape does not preclude these findings (§ 50-51).

[21/02/2024, T-82/23, Toilet units \(part of -\), EU:T:2024:102](#)

## **3.7 CONFLICT WITH A PRIOR DESIGN RIGHT**

[No key points available yet.]

## 3.8 USE OF AN EARLIER DISTINCTIVE SIGN

### 3.8.1 Distinctive sign and right to prohibit use

[No key points available yet.]

### 3.8.2 Use in a subsequent design

[No key points available yet.]

### 3.8.3 Substantiation of the application under Article 25(1)(e) CDR (earlier distinctive signs)

[No key points available yet.]

## 3.9 UNAUTHORISED USE OF A WORK PROTECTED UNDER THE COPYRIGHT LAW OF A MEMBER STATE

### Works for the purposes of applying Article 25(1)(f) CDR

The works invoked for the purposes of applying Article 25(1)(f) CDR cannot be an accumulation of the stylised versions of a product during various decades (§ 101).

The characteristics listed by the French and Italian judgments, recognising that the work corresponding to the earlier design deserves protection as copyright, are not present in the contested design (§ 94, 104-105).

24/09/2019, T-219/18, [Ciclomotori](#), EU:T:2019:681, § 94, 101, 104-105

### Article 25(1)(f) CDR – Request that witnesses be heard – Action manifestly lacking any foundation in law

The BoA correctly stated that the applicant had not shown that there was a work protected by copyright and that, regarding the applicable national law, the work enjoyed protection under German copyright law. The date and place of the first publication of the work were not stated and it was not possible to identify the holder of the alleged copyright. The BoA was right in rejecting the request that witnesses be heard because the applicant had not provided an explanation as to why it had been unable to submit written witness statements or the missing documents during the procedure before the Office (§ 10, 35-38).

14/06/2021, T-512/20, [Protective covers for computer hardware](#), EU:T:2021:359, § 10, 35-38

14/06/2021, T-564/20, [Protective covers for computer hardware](#), EU:T:2021:358, § 10, 35-38

14/06/2021, T-565/20, [Protective covers for computer hardware](#), EU:T:2021:357, § 10, 35-38

## 3.10 IMPROPER USE OF FLAGS AND OTHER SYMBOLS

[No key points available yet.]

### **3.11 PARTIAL INVALIDITY**

[No key points available yet.]

## **4 OTHERS**

[No key points available yet.]

## CHAPTER VIII – REGISTER OPERATIONS

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### **Cancellation of an entry in the register that contains an obvious error attributable to the Office – No proof of transfer of the EUTM**

Authorisations to exploit commercially a trade mark do not formally prove a transfer of ownership of the mark pursuant to Article 20(5) EUTMR and Article 13(1)(d) EUTMIR (§ 39-40).

[07/11/2023, T-299/22, Diego maradona](#)

### **Recordal of a licence – Formalised EU law conditions not met – No consent of the EUTM proprietor – Licence granted by the predecessor in law**

Article 25(5), Article 26(1) and Article 20(5) EUTMR require, for reasons of legal certainty, the registered EUTM proprietor – at the time of the application for and registration of the licence – to state actively that they wish to grant a licence, namely either (i) by lodging directly with the EUIPO the licence registration request under Article 26(1)(b) EUTMR and Article 13(3)(a) and (b) EUTMIR, or (ii) by placing their signature on a declaration, agreement or standard form in accordance with Article 13(3)(c) and (d) EUTMIR. The EUTM proprietor's predecessor in law is not empowered to give the agreement required by the relevant provisions (§ 23-24).

Even assuming that the licence granted by a predecessor in law has effects vis-à-vis the licensee under the second sentence of Article 27(1) EUTMR, this does not, however, mean that the EUIPO has an obligation to register that licence. The recordal of a licence is dependent only on the formalised EU conditions provided for by the applicable provisions (§ 26). It remains open to the contracting parties to rely on their rights deriving from substantive law before the national courts. In that connection, a breach of that licence agreement and its clause applicable to successors could trigger contractual liability vis-à-vis the other contracting party, without, however, that contractual aspect having any effect on the examination of the registration request (§ 27).

Article 19(1) EUTMR, which refers to the law of the Member State in which the EUTM proprietor has its seat, applies only '... unless Articles 20 to 28 provide otherwise'. However, the recordal in the EU trade mark register of a licence relating to an EU trade mark is governed autonomously by EU law in Articles 25 to 28 EUTMR and Article 13 EUTMIR. Therefore, the EUIPO is not required to apply national law (§ 33, 41).

When dealing with a request for recordal of a licence, which follow the same rules as the registration of a transfer, the EUIPO's competence is, in principle, confined to examining the formal requirements set out in the EUTM regulations and does not imply an assessment of substantive issues that may arise under the applicable national law (§ 43).

[22/11/2023, T-679/22, LAPLANDIA Land of purity et al., EU:T:2023:738](#)

## **CHAPTER IX – PROFESSIONAL REPRESENTATION**

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[No key points available yet.]

## CHAPTER X – DIRECTIVES

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### 1 DIRECTIVE 2008/95/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL OF 22 OCTOBER 2008 TO APPROXIMATE THE LAWS OF THE MEMBER STATES RELATING TO TRADE MARKS

#### **Preliminary ruling – Article 2 and Article 3(1)(b) Directive 2008/95 – Colour mark or figurative mark – Graphical representation of a mark submitted as a figurative mark**

Article 2 and Article 3(1)(b) Directive 2008/95/EC must be interpreted as meaning that the classification as a ‘colour mark’ or ‘figurative mark’ given to a sign by the applicant on registration is a relevant factor among others for establishing whether that sign can constitute a trade mark within the meaning of Article 2 of the Directive and, if so, whether it is distinctive within the meaning of Article 3(1)(b) of that Directive, but does not release the competent trade mark authority from its obligation to carry out a global assessment of distinctive character by reference to the actual situation of the mark considered, which means that that authority cannot refuse registration of a sign as a mark on the sole ground that that sign has not acquired distinctive character through use in relation to the goods or services claimed.

Article 2 Directive 2008/95/EC must be interpreted as precluding, in circumstances such as those in the main proceedings, the registration of a sign as a mark due to an inconsistency in the application for registration, which it is for the referring court to ascertain (§ 45).

When the trade mark application contains an inconsistency between the sign’s representation in the form of a drawing and the classification given to the mark by the applicant, so that it is impossible to determine exactly the subject matter and scope of the protection, the trade mark registration must be refused on account of the lack of clarity and precision of the application (§ 40).



27/03/2019, C-578/17, [Oy Hartwall Ab](#), EU:C:2019:261, § 40, 45

#### **Preliminary ruling – Article 3(1)(b) Directive 2008/95/EC – Distinctive character – Criteria for assessment**

Article 3(1)(b) Directive 2008/95/EC must be interpreted as meaning that, in examining the distinctive character of a sign, all the relevant facts and circumstances must be taken into account, including all the likely types of use of the mark applied for. The latter correspond, in the absence of other indications, to the types of use that, in the light of the customs in the economic sector concerned, can be practically significant (§ 34).

The examination of the distinguishing capacity of a sign cannot be limited to the ‘most likely’ use unless ‘solely one type of use is practically significant in the economic sector concerned’. This examination must take into account all practically significant conceivable uses of the sign in the economic sector concerned by the goods. Where a sign consists of a slogan which can be placed either on the front of T-shirts or on a label, the mark will be found distinctive if the consumers perceives it as a badge of origin according to *at least one* of the alternative types of placement of the sign (§ 25-30).

12/09/2019, C-541/18, [Deutsches Patent-und Markenamt](#), EU:C:2019:725, § 25-30, 34

#### **Preliminary ruling – Article 3(1)(b) Directive 2008/95/EC – Distinctive character – EUTM application for a sign for a service, consisting of motifs of colour and intended to be affixed to goods used to provide that service – Criteria for assessment**

The preliminary ruling concerns the interpretation of Article 3(1)(b) of Directive 2008/95/EC. The distinctive character of a sign for which registration as a trade mark in respect of a service is sought, where that sign is composed of coloured motifs and is intended to be affixed exclusively and systematically in a specific manner to a large part of the goods used for the provision of that service, must be assessed by considering the relevant public's perception of the affixing of that sign to those goods. It is not necessary to examine whether that sign departs significantly from the norm or customs of the economic sector concerned (§ 45).



EU:C:2020:813, § 45

08/10/2020, C-456/19, [Aktiebolaget Östgötatrafiken](#),

### **Preliminary ruling – Disclaimer – Article 4(1)(b) Directive 2008/95**

A disclaimer provided for by national law whose effect was to exclude an element of a complex trade mark, mentioned in the disclaimer, from the analysis of the relevant factors for establishing the existence of a LOC within the meaning of Article 4(1)(b) of Directive 2008/95 because that element is descriptive or not distinctive, would not be compatible with the requirements of that provision (§ 46).

A disclaimer provided for in national law whose effect were to attribute, in advance and permanently, a lack of distinctiveness to the element of a complex trade mark mentioned by it, so that that element has only limited importance in the analysis of the LOC within the meaning of Article 4(1)(b) of Directive 2008/95, would also be incompatible with the requirements of that provision (§ 52).

12/06/2019, C-705/17, [Mats Hansson](#), EU:C:2019:481, § 46, 52

### **Preliminary ruling – Article 3 and Article 13 First Council Directive 89/104/EEC – Article 7 and Article 51 Regulation (EC) No 40/94 – Failure to comply with the requirements of clarity and precision – Bad faith – No intention to use the trade mark for the goods or services covered by the registration – Effects**

An EUTM or a national trade mark cannot be declared wholly or partially invalid on the ground that the terms used to designate the goods and services for which that trade mark was registered lack clarity and precision (§ 71).

A trade mark application that is filed without any intention to use the trade mark for the goods and services covered by the registration may constitute bad faith if the applicant for registration of that mark had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (§ 77, 81). Such bad faith cannot be presumed; it is established only if there is objective, relevant and consistent indicia to support this (§ 77, 78).

When the absence of the intention to use the trade mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that application constitutes bad faith only insofar as it relates to those goods or services (§ 81).

First Directive 89/104 must be interpreted as not precluding a provision of national law under which an applicant for registration of a trade mark must state that the trade mark is being used in relation to the goods and services for which registration is sought, or that he or she has a bona fide intention that it should be so used, insofar as the infringement of such an obligation does not constitute, in itself, a ground for invalidity of a trade mark already registered (§ 86-87).

**Preliminary ruling – Article 5(1)(a) and (b) Directive 2008/95/EC – Individual trade mark consisting of a test label**

Article 9(1)(a) and (b) CTMR and Article 5(1)(a) and (b) Directive 2008/95/EC must be interpreted as meaning that they do not entitle the proprietor of an individual trade mark consisting of a quality label to oppose the affixing, by a third party, of a sign identical with, or similar to, that mark to products that are neither identical with, nor similar to, the goods or services for which that mark is registered.

Article 9(1)(c) CTMR and Article 5(2) Directive 2008/95/EC must be interpreted as meaning that they entitle the proprietor of an individual trade mark with a reputation, consisting of a quality label, to oppose the affixing, by a third party, of a sign identical with, or similar to, that mark to products that are neither identical with, nor similar to, the goods or services for which that mark is registered, provided that it is established that, by that affixing, the third party takes unfair advantage of the distinctive character or the reputation of the mark concerned or causes detriment to that distinctive character or reputation and provided that, in that case, the third party has not established the existence of a ‘due cause’, within the meaning of those provisions, in support of such affixing (§ 54).

The CJ ruled out any infringement under Article 5(1)(a) Directive 2008/95/EC because the defendant did not ‘present itself to the public as specialist in the field of product testing’ and because there is no ‘specific and indissociable link’ between toothpaste, on the one hand, and the activity of product testing, on the other hand. This circumstance must be distinguished from the case where a third party uses, for its own services (for example, car repair services), a trade mark registered for the goods which constitute the actual subject matter of the services (for example, cars), which may ‘exceptionally’ justify a double identity within the meaning of Article 5(1)(a) Directive 2008/95/EC (§ 31-33).



11/04/2019, C-690/17; [ÖKO-Test](#), EU:C:2019:317, § 31-33, 54

**Preliminary ruling – Article 5(1)(b) Directive 2008/95/EC – Article 10(1) Directive 2008/95/EC – Article 12(1) Directive 2008/95/EC – Revocation of a trade mark for lack of genuine use – Right to protection against infringement of exclusive rights before the date on which the revocation took effect**

Article 5(1)(b), the first subparagraph of Article 10(1) and the first subparagraph of Article 12(1) of Directive 2008/95/EC must be interpreted as leaving Member States the option of allowing the proprietor of a trade mark, whose rights have been revoked due to lack of genuine use on expiry of the 5-year period from its registration, to retain the right to claim compensation for damage resulting from use by a third party before the date of revocation (§ 49).

Although the fact that a trade mark has not been used does not in itself preclude compensation for acts of infringement, it is an important factor when determining the existence and extent of the damage sustained by the proprietor, and the amount of compensation that they might claim (§ 47).

26/03/2020, C-622/18, [SAINT GERMAIN](#), EU:C:2020:241, § 47, 49

**Preliminary ruling – Article 3(1)(e)(ii) Directive 2008/95 – Sign consisting exclusively of the shape of goods which is necessary to obtain a technical result – Article 3(1)(e)(iii) Directive 2008/95 – Sign consisting of the shape which gives substantial value to the goods – Consideration of the perception of the relevant public – Cumulative protection**

Article 3(1)(e)(ii) of Directive 2008/95/EC must be interpreted as meaning that, in order to establish whether a sign consists exclusively of the shape of goods which is necessary to obtain a technical result, assessment does not have to be limited to the graphic representation of that sign (§ 37). The first step of the analysis is to identify the essential characteristics of the sign. For that step, information other than that relating to the graphic representation alone, such as the relevant public's perception, may be used (§ 29-31, 37). The second step of the analysis is to establish if the essential characteristics perform a technical result. For that step, information which is not apparent from the graphic representation of the sign must originate from objective and reliable sources and may not include the relevant public's perception (§ 32-36, 37).

Article 3(1)(e)(iii) of Directive 2008/95 must be interpreted as meaning that the relevant public's perception or knowledge of the product represented graphically by a sign that consists exclusively of the shape of that product may be taken into consideration in order to identify an essential characteristic of that shape. The ground for refusal may be applied if it is apparent from objective and reliable evidence that the consumer's decision to purchase the product in question is to a large extent determined by that characteristic (§ 39-46, 47).

Article 3(1)(e)(iii) of Directive 2008/95 must be interpreted as meaning that that ground for refusal must not be applied systematically to a sign which consists exclusively of the shape of the goods where that sign enjoys protection under the law relating to designs or where the sign consists exclusively of the shape of a decorative item (§ 50, 53, 58-59, 62).



23/04/2020, C-237/19, [Gömböc Kutató](#), EU:C:2020:296, § 29-32, 36-37, 39-46, 47, 50, 53, 58-59, 62

#### **Preliminary ruling – Article 5(1) Directive 2008/95/EC – Article 5(3)(b) Directive 2008/95/EC – Article 5(3)(c) Directive 2008/95/EC – Concept of ‘use in the course of trade’**

Article 5(1) of Directive 2008/95/EC, read in conjunction with Article 5(3)(b) and (c) of that directive, must be interpreted as meaning that a person who does not engage in trade as an occupation, who takes delivery of, releases for free circulation in a Member State and retains goods that are manifestly not intended for private use, where those goods were sent to their address from a third country and where a trade mark, without the consent of the proprietor of that trade mark, is affixed to those goods, must be regarded as using that trade mark in the course of trade, within the meaning of Article 5(1) of that directive (§ 31).

30/04/2020, C-772/18, [Korkein oikeus](#), EU:C:2020:341, § 31

#### **Preliminary ruling – Article 5(1) Directive 2008/95/EC – Advertising – Infringement**

Article 5(1) of Directive 2008/95/EC must be interpreted as meaning that a person operating in the course of trade that has arranged for an advertisement (which infringes another person's trade mark) to be placed on a website, is not using a sign which is identical to that trade mark where the operators of other websites reproduce that advertisement by placing it online, on their own initiative and in their own name, on other websites (§ 31).

The term ‘using’ in Article 5(1) of Directive 2009/95/EC involves active conduct and direct or indirect control of the act constituting the use. However, that is not the case if that act is carried out by an independent operator without the consent of the advertiser (03/03/2016, C-179/15, Mercedes Benz, EU:C:2016:134, § 39) (§ 23).

02/07/2020, C-684/19, [mk advokaten](#), EU:C:2020:519, § 31, 23

## **Limitation of the effects of the trade mark – Use to refer to goods or services – Use to indicate the intended purpose of goods and services – Scope of application**

Article 6(1)(c) TMD 2008/95 [Article 12(c) CTMR] covers only the use made in the course of trade of the mark, which is necessary to indicate the intended purpose of a product or service. It covers only one of the situations that are now encompassed by Article 14(1)(c) of Directive 2015/2436 [Article 14(1)(c) EUTMR] which consequently extended the scope of the limitation as defined in Article 6(1)(c) TMD 2008/95 (§ 52-56).

[11/01/2024, C-361/22, Inditex, EU:C:2024:17](#)

## **2 DIRECTIVE 98/71/EC OF THE EUROPEAN PARLIAMENT AND THE COUNCIL OF 13 OCTOBER 1998 ON THE LEGAL PROTECTION OF DESIGNS**

[No key points available yet.]

## **3 DIRECTIVES ON COPYRIGHTS**

### **3.1 DIRECTIVE (EU) 2019/790 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL 17 APRIL 2019 ON COPYRIGHT AND RELATED RIGHTS IN THE DIGITAL SINGLE MARKET**

[No key points available yet.]

### **3.2 DIRECTIVE 2001/29/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL OF 22 MAY 2001 ON THE HARMONISATION OF CERTAIN ASPECTS OF COPYRIGHT AND RELATED RIGHTS IN THE INFORMATION SOCIETY**

#### **Preliminary ruling – Article 2(a) Directive 2001/29/EC – Concept of ‘work’ – Protection of works by copyright – Connection with the protection of designs**

Article 2(a) Directive 2001/29/EC must be interpreted as precluding national legislation from conferring protection, under copyright, to designs such as the clothing designs at issue in the main proceedings, on the ground that, over and above their practical purpose, they generate a specific, aesthetically significant visual effect (§ 58).

The subject matter protected as a design was not as a general rule capable of being treated in the same way as a subject matter constituting works protected by Directive 2001/29/EC. The principle of the system laid down in the EU is that the protection reserved for designs and the protection ensured by copyright are not mutually exclusive (§ 40, 43). Such cumulative and concurrent protection of the same subject matter can be envisaged only in certain situations (§ 52).

*12/09/2019, C-683/17, [Cofemel](#), EU:C:2019:721, § 40, 43, 52, 58*

#### **Preliminary ruling – Article 3(1) Directive 2001/29/EC – Article 8(2) Directive 2006/115/EC Copyright and related rights – Concept of ‘communication to the public’**

Article 3(1) of Directive 2001/29/EC on the harmonisation of certain aspects of copyright and related rights in the information society and Article 8(2) of Directive 2006/115/EC on rental right

and lending right and on certain rights related to copyright in the field of intellectual property must be interpreted as meaning that the hiring out of motor vehicles equipped with radio receivers does not constitute a communication to the public within the meaning of those provisions (§ 41).

02/04/2020, C-753/18, [Stim and SAMI](#), EU:C:2020:268, § 41

**Preliminary ruling – Article 3(1) Directive 2001/29/EC – Article 3(1) Directive 2001/29/EC – Concept of ‘communication to the public’ – Embedding, in a third party’s website, of a copyright-protected work by means of the process of framing – Work freely accessible with the authorisation of the copyright holder on the licensee’s website**

Article 3(1) of Directive 2001/29/EC must be interpreted as meaning that the embedding, by means of the technique of framing, in a third party website page, of works that are protected by copyright and that are freely accessible to the public with the authorisation of the copyright holder on another website, where that embedding circumvents measures adopted or imposed by that copyright holder to provide protection from framing, constitutes a communication to the public within the meaning of that provision (§ 55).

In this case which take place in the wake of Svensson and GS Media decisions, the CJ clarifies when embedding of a work by way of framing on the internet constitutes a communication to the public within the meaning of Directive 2001/29/EC.

According to the Court, where the copyright holder has imposed measures to restrict framing, the embedding of a work in a website page of a third party, by means of that (framing) technique, constitutes an act of ‘making available that work to a new public’. That act must, therefore, be authorised by the right holders concerned (such as through a new licence).

The Court further ruled that copyright holder can restrict linking (framing) by contract provided that such restriction is imposed or implemented through effective technological measures within the meaning of Article 6(1) and (3) of Directive 2001/29/EC.

09/03/2021, C-392/19, [VG Bild Kunst](#), EU:C:2021:181, § 55

**Preliminary ruling – Article 2 to Article 5 Directive 2001/29/EC – Scope – Copyright and related rights – Concept of ‘work’ – Copyright protection of works – Shape of the product which is necessary to obtain a technical result – Folding bicycle**

Articles 2 to 5 of Directive 2001/29/EC must be interpreted as meaning that the copyright protection provided for therein applies to a product whose shape is necessary (at least in part) to obtain a technical result, but where that product is also an original work resulting from intellectual creation because, through its shape, its author expresses their creative ability in an original manner by making free and creative choices so that the shape reflects their personality. It is for the national court to verify this, bearing in mind all the relevant aspects of the dispute in the main proceedings (§ 39).

11/06/2020, C-833/18, [Folding bicycle](#), EU:C:2020:461, § 39

**Preliminary ruling – Copyright and related rights – Making available and management of a video-sharing platform or a file-hosting and -sharing platform – Liability of the operator for infringements of intellectual property rights by users of its platform – Directive 2001/29/EC – Article 3 and Article 8(3) – Concept of ‘communication to the public’ – Directive 2000/31/EC – Articles 14 and 15 – Conditions for exemption from liability – No knowledge of specific infringements – Notification of such infringements as a condition for obtaining an injunction**

In principle, operators of online platforms do not themselves make a communication to the public of copyright-protected content illegally posted online by users of those platforms, unless those

operators contribute, beyond merely making the platforms available, to giving the public access to such content in breach of copyright. This is the case, inter alia, (i) where the operator has specific knowledge that illegal content is available on its platform and does not expeditiously remove it, (ii) where the operator, despite knowing that users are making illegal content available, does not put in place appropriate technological measures to counter copyright infringement on its platform, or (iii) where the operator participates in selecting protected content illegally communicated to the public, provides tools intended for the illegal sharing of such content, or knowingly promotes such sharing (§ 63-78, 89, 102).

Operators of platforms (such as YouTube and Cyando) can benefit from exemption from liability under Directive 2000/31/EC (Electronic Commerce Directive) provided that they do not play an 'active role' that gives them knowledge of, or control over, the content uploaded to their platform (§ 106, 111-118).

Directive 2001/29/EC (Information Society Directive) does not preclude a situation under national law whereby a copyright holder cannot obtain an injunction against an operator whose service has been used by a third party to infringe its rights, where that operator has no knowledge of the infringement (within the meaning of Article 14 of the Electronic Commerce Directive), unless, before court proceedings are begun, that infringement was notified to the operator who has failed to intervene expeditiously to remove the content or block access to it. It is, however, for the national courts to ensure that that condition does not result in a delay to the actual cessation of the infringement that causes disproportionate damage to the rights holder. This means that, for the Court, imposing the notification of an infringement as a condition for obtaining an injunction must conform with Article 8(3) of the Information Society Directive (§ 119, 124, 141-142).

22/06/2021, C-682/18 and C-683/18, [YouTube and Cyando](#), EU:T:2021:503, § 63-78, 89, 102, 106, 111-119, 124, 141-142

### **3.3 DIRECTIVE 96/9/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL OF 11 MARCH 1996 ON THE LEGAL PROTECTION OF DATABASES**

**Preliminary ruling – Legal protection of databases – Directive 96/9/EC – Article 7 – Sui generis right of makers of databases – Prohibition on any third party to 'extract' or 're-utilise', without the maker's permission, the whole or a substantial part of the contents of the database – Database freely accessible on the internet**

Article 7(1) and (2) of Directive 96/9/EC must be interpreted as meaning that an internet search engine specialising in searching the contents of databases, which copies and indexes the whole or a substantial part of a database freely accessible on the internet and then allows its users to search that database on its own website according to criteria relevant to its content, is 'extracting' and 're-utilising' that content within the meaning of that provision, which may be prohibited by the maker of such a database where those acts adversely affect its investment in the obtaining, verification or presentation of that content, namely that they constitute a risk to the possibility of redeeming that investment through the normal operation of the database in question, which it is for the referring court to verify (§ 47).

03/06/2021, C-762/19, [CV-Online Latvia](#), EU:C:2021:434, § 47

### 3.4 DIRECTIVE 2004/48/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL OF 29 APRIL 2004 ON THE ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS

#### **Preliminary ruling – Article 9(7) Directive 2004/48/EC – Patent – Appropriate compensation – Compensation for losses – Preliminary injunction – Patent revocation**

Article 9(7) Directive 2004/48/EC, and in particular the concept of ‘appropriate compensation’ referred to in that provision, must be interpreted as not precluding national legislation which provides that a party will not be compensated for losses which he has suffered due to his not having acted as may generally be expected in order to avoid or mitigate his loss and which, in circumstances such as those in the main proceedings, results in the court not making an order for provisional measures against the applicant obliging him to provide compensation for losses caused by those measures even though the patent on the basis of which those had been requested and granted has subsequently been found to be invalid, to the extent that that legislation permits the court to take due account of all the objective circumstances of the case, including the conduct of the parties, in order, *inter alia*, to determine that the applicant has not abused those measures (§ 72).

‘Appropriate compensation’ is an autonomous concept of EU law which must be given an independent and uniform meaning (§ 49). National courts must decide, on a case-by-case basis, whether compensation is appropriate, that is to say ‘justified in light of the circumstances’ (§ 50).

Article 9(7) Directive 2004/48/EC establishes as a pre-condition that the preliminary injunction is repealed or that no infringement or threat of infringement is found. However, that does not mean that compensation for losses will be automatically ordered (§ 52). Recital 22 of the Enforcement Directive which considers compensation to be ‘appropriate’ to the extent that it repairs the cost and injury suffered because of ‘unjustified’ provisional measures (§ 60). Provisional measures would be unjustified when there is no risk of delays causing irreparable harm to the rights holder (§ 61). When a generic product is marketed although a patent has been granted, there may, in principle, be such a risk. The fact that the provisional measures have already been repealed is not a decisive factor to prove that the measures were unjustified (§ 63). Otherwise rights holders could be discouraged from applying for these types of measures (§ 65). National courts must check that an applicant has not abused provisional measures (§ 70).

12/09/2019, C-688/17, [Bayer Pharma](#), EU:C:2019:722, § 49-50, 52, 60-61, 63, 65, 72

#### **Preliminary ruling – Article 8(2)(a) Directive 2004/48/EC – Internet video platform – Uploading of a film without the consent of the rights holder – Proceedings concerning an infringement of an intellectual property right – Applicant’s right of information**

Where a film is uploaded onto an online video platform, such as YouTube, without the copyright holder’s consent, Directive 2004/48/EC does not oblige the judicial authorities to order the operator of the video platform to provide the email address, IP address or telephone number of the user who uploaded the film concerned. The directive, under Article 8, provides for disclosure of the ‘addresses’ of persons who have infringed an intellectual property right, but this only covers the postal address of the user concerned, not their email, IP address or telephone number (§ 38-40).

09/07/2020, C-264/19, [Constantin Film Verleih](#), EU:C:2020:542, § 38-40

#### **Preliminary ruling – Copyright and related rights – Directive 2001/29/EC – Article 3(1) and (2) – Concept of ‘making available to the public’ – Downloading a file containing a protected work via a peer-to-peer network and the simultaneous provision for uploading pieces of that file – Directive 2004/48/EC – Article 3(2) – Misuse of measures, procedures**

**and remedies – Article 4 – Persons entitled to apply for the application of measures, procedures and remedies – Article 8 – Right of information — Article 13 – Concept of ‘prejudice’**

Uploading pieces of a media file to a peer-to-peer network, such as the one at issue, constitutes ‘making available to the public’ within the meaning of EU law (§ 43-59).

A holder of intellectual property rights (IPR) such as Mircom may benefit from the system of protection of those rights, but its request for information, in particular, must be non-abusive, justified and proportionate (§ 66-96).

Systematically registering users’ IP addresses and communicating their names and postal addresses to the IPR holder, or to a third party, to enable an action for damages to be brought, is permissible under certain conditions (§ 102-132).

*17/06/2021, C-597/19, [MICM](#), EU:C:2021:492, § 43-59, 66-96, 102-132*

**Preliminary ruling – Enforcement Directive – Right of information – Standard of proof for establishing the ownership of an IP right for purposes of information request**

While the specific, different and autonomous function of the information procedure provided for in Article 8 Directive 2004/48 does not justify applying the same standard of proof as for proceedings to establish an infringement of an IP right (§ 44-45), and due account must in particular be given to the nature of the IP right in issue (§ 46-51), the applicant must, for the purpose of a request for information, provide any reasonably available evidence enabling the court seized of that request to satisfy itself with a sufficient degree of certainty that the applicant is the rights holder, by submitting evidence appropriate to the nature of that right and any special applicable formalities (§ 51, 55). In any event, an information request pursuant to Article 3(1) Directive 2004/48 must always be justified, proportionate and not be abusive (§ 52-53).

*[27/04/2023, C-628/21, Castorama Polska and Knor, EU:C:2023:342](#)*