

Boards of Appeal Decisions Overview 2019 – Part II

This overview includes a selection of decisions of the Boards of Appeal notified by the Registry between 01/08/2019 and 31/12/2019. Only final decisions are included into this overview.

Please note that the summaries are provided for information purpose only and do not necessarily reproduce the exact wording of the decisions.

CTRL + click on the case citation to access the decision or its unofficial translations in eSearch Case Law.

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I. GRAND BOARD CASES

[21/01/2019, R 1720/2017-G, ICEBERG \(fig.\) / ICEBERG et al.](#)

Earlier trade mark	Contested EUTM
ICEBERG	ICEBERG

Outcome: Decision annulled.

Norms: Article 8(1)(b) EUTMR, Article 37 EUTMDR.

Keywords: Complementary goods and services, Dissimilarity of the goods and services, Figurative trade mark, Identity of the signs, Purpose of the goods and services.

Summary: The case concerns the examination of similarity between ‘vodka’ in Class 33 covered by the earlier trade marks and ‘mineral water and aerated water; non-alcoholic beverages; fruit beverages and fruit juices’ in Class 32 for which the contested mark sought protection. Diverging decisions had been issued by the Boards of Appeal on this issue. The Grand Board (GB) pointed out that the goods were directed at the public at large in the Czech Republic and Germany, whose degree of attention would vary from average to low. The GB found ‘vodka’ and ‘mineral water’ to be dissimilar: they differed in nature (presence or absence of alcohol in their composition), they were not complementary and they were sold in different sections of supermarkets. ‘Vodka’ was also dissimilar to ‘non-alcoholic beverages’, as they were not produced using the same manufacturing process and they were not offered in the same parts of a store. The GB also reached an outcome of dissimilarity when comparing ‘vodka’ and ‘fruit juices’. These goods were not manufactured in the same way, they did not contain the same ingredients and were not subject to the same regulations. As regards the possibility of mixing drinks, the GB reiterated that this was not an argument advocating in favour of similarity pursuant to the case-law ([T-150/17](#), FLÜGEL); otherwise, a large number of goods described as ‘drinks’ would fall into one and the same category for the purposes of Article 8(1)(b) EUTMR. The conflicting goods were considered dissimilar and the opposition was rejected in its entirety. The appeal was upheld.

[09/11/2018, R 1801/2017-G, easyBank \(fig.\)](#)



Outcome: Decision confirmed.

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

Keywords: Figurative element, Principle of legality, Descriptive.

Summary: The case concerns the registrability of the figurative sign 'easyBank' for goods and services in Classes 9, 36 and 42. As regards the applicability of Article 7(1)(c) EUTMR, the GB pointed out that the relevant public consisted of the English-speaking public of the EU (as well as the public in Germany and Austria), comprising both professionals and the public at large. The word elements denoted an institution offering a range of financial goods or services that were straightforward and simple to use. There was nothing unusual about the juxtaposed terms 'easy' and 'bank' and it was irrelevant whether or not they might be qualified as a neologism. The combination, encompassing the typeface and the orange background, did not go beyond a merely descriptive sign. There was a clear and direct link to all of the goods and services (e.g. money dispensing machines in Class 9 rendering financial transactions easier, bank services can make the financing of real estate purchases in Class 36 easier). The assessment made confirmed the Common Communication on Distinctiveness of figurative marks containing descriptive or non-distinctive words. Examination standards (including those of the General Court) developed over time and the case-law cited by the applicant ([T-87/00 'Easybank'](#) and [T-346/07 'Easycover'](#)) reinforced the arguments in favour of refusing the mark applied for. As regards the applicability of Article 7(1)(b) EUTMR, the GB found that there was nothing in the sign as a whole that might, beyond the obvious laudatory meaning of 'easyBank', enable the relevant public to perceive it as denoting a trade origin. The appeal was dismissed and the application was refused for all the goods and services.

[30/01/2019, R 958/2017-G, BREXit \(fig.\)](#)



Outcome: Decision confirmed.

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

Keywords: Distinctive element, Figurative element, Figurative trade mark.

Summary: The case concerns the eligibility for registration of the figurative sign 'BREXit' for 'energy drinks containing caffeine; beer' in Class 32. The application was refused by the examiner on the basis of Article 7(1)(f) and Article 7(1)(b) EUTMR. The GB pointed out that the relevant public included all consumers in the EU as they would frequently encounter the term through the mass media and the internet. As regards Article 7(1)(f) EUTMR, the GB found that 'BREXit' denoted a sovereign political

decision, that was taken legally and had no negative moral connotations; it was neither an incitement to crime, nor an emblem for terrorism or a byword for sexism or racism. The word alone did not express an opinion. The fact that part of the UK public may have been upset by a controversial decision taken democratically did not constitute an offence. The GB therefore concluded that the sign could not be deemed to be contrary to the accepted principles of morality, in and of itself, nor when used as a brand for the goods applied for. Nevertheless, the term was, already at its filing date, so well known to consumers as the name of an event of a historical and political nature that it would not be associated, prima facie, with specific goods originating from a specific trader. It would only acquire distinctiveness if consumers were sufficiently exposed to it in a trade context. Moreover, the colours and font were unable to divert the public's attention away from the non-distinctive message conveyed by the word. The background evoking the Union jack accentuated this message. For the above reasons, the GB refused the mark applied for pursuant to Article 7(1)(b) EUTMR and dismissed the appeal.

[07/08/2019, R 912/2016-G, PANOTEC / PlanoTek et al.](#)

Outcome: Proceedings terminated.

Norms: Article 49(1) EUTMR, Article 109(3) EUTMR, Article 109(4) EUTMR.

Keywords: Costs, Reasons of equity, Withdrawal.

Summary: As a consequence of the withdrawal of the opposition, both the opposition and appeal proceedings lost their purpose and were closed by the Grand Board.

II. PROCEDURAL MATTERS

1. ADMISSIBILITY BEFORE EUIPO

[no entry]

2. ESSENTIAL PROCEDURAL REQUIREMENTS

[no entry]

3. GENERAL PRINCIPLES OF EU LAW

[no entry]

III. TRADE MARKS

1. ABSOLUTE GROUNDS (ARTICLE 7 EUTMR) / INVALIDITY (ARTICLE 59 EUTMR)

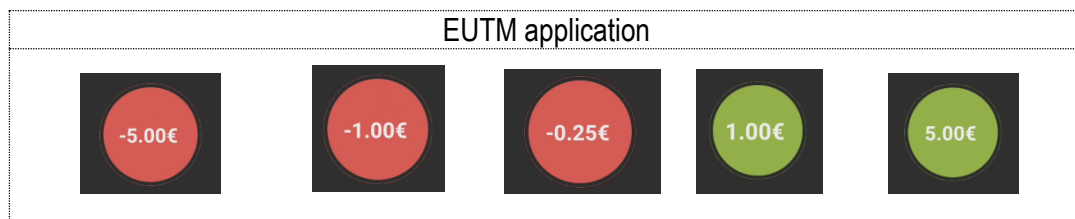
A. ARTICLE 7(1)(a) / 59(1)(a) EUTMR – SIGN OF WHICH AN EUTM MAY CONSIST

[no entry]

B. ARTICLE 7(1)(b) / 59(1)(a) EUTMR – NON-DISTINCTIVE SIGN

Distinctive (no)

[29/08/2019, R 2024/2018-5, EINE BLASE MIT EINEM FARBWECHSEL VON ROT ZU GRÜN](#)



Outcome: Decision confirmed.

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

Keywords: Multimedia mark, Laudatory mark, Non-distinctive.

Summary: The applicant sought to register a [multimedia mark](#) for goods and services in Classes 9, 36, 38, 41 and 42. The sign showed various sequences of monetary amounts and three short strokes of a bell rang at the end. In addition, the negative amounts were highlighted in red, whereas the positive amounts were highlighted in green. The sign applied for was rejected under Article 7(1)(b) EUTMR in respect of all the goods and services applied for as it would merely be perceived as an advertising message of a trading platform. There was a clear reference to financial services and goods which supported such services, such as apps. Nevertheless the amounts could also be used in connection with any goods and services. The sign applied for was also devoid of distinctive character in connection with the sound element.

The Board points out that, despite the fact that a public composed of experts generally pays an increased level of attention, this level of attention is liable to be relatively low when it comes to factual or promotional indications, which well-informed consumers do not see as decisive. Following the criteria laid down by the Court for sound marks (13/09/2016, [T-408/15](#), SON D'UN JINGLE SONORE PLIM (sound mark), EU:T:2016:468) the Board indicates that the decisive factor is whether the sign applied for is capable of attracting the consumer's attention to the extent that the sign is not perceived as a banal, simple or purely informative or purely promotional combination of sounds, but as a distinctive sign.

The Board considers that the sign is a banal and obvious combination of elementary components which are not distinctive. The overall impression is nothing more than the simple sum of the individual components which can all be related to the goods and services at stake. The sign applied for will only be perceived as a statement in relation to goods and services linked to trade in financial products (with an insignificant change of profit and loss). In addition, the sign as a whole also has a purely laudatory character as the public will immediately understand the transformation of a loss into a profit within seconds. The sign possesses nothing striking so that it could convey any message which would remain in the consumer's memory in relation to the goods and services and so allow consumers to distinguish them from those of other competitors. Consequently, the application is rejected.

The appeal is dismissed.

[03/10/2019, R 279/2019-2, Simple](#)

Outcome: Decision confirmed.

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

Keywords: Laudatory mark, Slogan mark, Non-distinctive.

Summary: The examiner refused the IR designating the European Union for the word mark 'Simple' in Classes 2, 3 and 19 pursuant to Article 7(1)(b), combined with Article 7(2), EUTMR. The mark would be perceived by the relevant public as a laudatory slogan, which merely served as an indication regarding positive aspects of the goods, and not their commercial origin.

The Board also finds that the mark is devoid of distinctive character as its significance serves as promotional information, rather than indicating commercial origin namely that the paints, varnishes, lacquers, preservatives, colorants, mordants, thinners, resins, etc. in Class 2; the bleaching, cleaning, polishing, scouring and abrasive preparations for painting and plastering, scouring solutions etc. in Class 3 and the building materials, mortars, plasters, etc. in Class 19 are easy to use or apply (for instance, they do not need mixing, pre-preparation, multiple coats i.e. paints) and/or, for some of the goods, that they are pure, unalloyed or non-mixed. The fact that the word 'Simple' neither describes any (typical) characteristics of the goods nor is a synonym for any of them is irrelevant in relation to Article 7(1)(b) EUTMR. Under this legal ground it suffices to note that the semantic content of the sign applied for indicates to the consumer a characteristic of the product relating to its market value which, whilst not specific and not directly descriptive, will be seen as promotional or advertising information which the relevant public will perceive first and foremost as such, rather than as an indication of the commercial origin of the goods. Furthermore, the fact that the word 'Simple' is not regularly used for building materials is not sufficient for providing distinctive character to the sign. Finally, the IR holder's claim that the mark 'Simple' is affiliated with art and not the goods applied for is dismissed as unfounded, on the premise that the assessment of the meaning of the sign should be in relation to the goods applied for and not in the abstract.

Consequently, the appeal is dismissed and the decision refusing protection with regard to the designation of the European Union must be confirmed.

Distinctive (yes)

[08/07/2019, R 889/2019-5, 1742](#)

EUTM application
1742

Outcome: Decision annulled.

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

Keywords: Numerical mark, Distinctiveness (yes).

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

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

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

As regards Article 7(1)(g) EUTMR the Board considers that the mark is not misleading and that there is no serious risk of deception in relation to the relevant public.

The appeal is upheld.

[02/10/2019, R 701/2019-4, Marvel](#)

Outcome: Decision annulled.

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

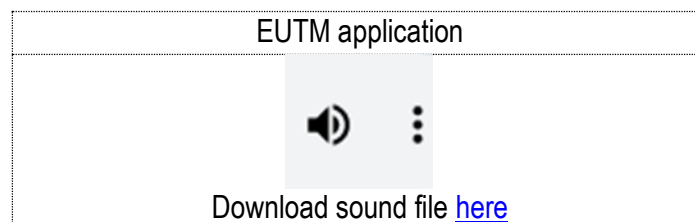
Keywords: Laudatory mark, Slogan mark, Minimum degree of distinctiveness.

Summary: The examiner refused the IR designating the European Union for the word mark 'MARVEL' in Classes 9 and 10 pursuant to Article 7(1)(b) EUTMR on the premise that it was devoid of distinctive character for the English-speaking public. Indeed, that public would attribute the meaning of a wonderful or surprising thing to the sign applied for, and would thus perceive it as a laudatory promotional slogan, the function of which was to communicate a value statement.

However, the Board considers that the expression 'MARVEL' is distinctive as it is unclear whether it relates to the goods themselves. A trade mark consisting of an advertising slogan must be regarded as being devoid of distinctive character if it is likely to be perceived by the relevant public as a mere promotional formula. On the other hand, such a sign must be recognised as having distinctive character if apart from its promotional function, it may be perceived immediately by the public as an indication of the commercial origin of the goods and services concerned. In the present case, the relevant public with a high level of attention will not immediately, without any mental effort, perceive the inherent characteristic of the goods at issue as referring to the word 'MARVEL'. In fact there is no indication that 'MARVEL' is used on the market as a general advertising slogan, in the sense that it refers to any sort of product.

Consequently, the Board annuls the contested decision and the examiner's refusal of protection with regard to the designation of the European Union must be withdrawn.

[19/09/2019, R 620/2019-4, KLANG EINER TONFOLGE \(sonit.\)](#)



Outcome(s): Decision annulled.

Norms: Article 7(1)(b) EUTMR; Article 94(1) EUTMR.

Keywords: Lack of reasoning; Sound mark; Distinctive (yes).

Summary: The applicant sought to register a sound mark consisting of an electronically produced (synthetic) sound sequence lasting approximately three seconds. The examiner refused it pursuant to Article 7(1)(b) EUTMR, because the sign contained no components which would enable the relevant public to remember it easily and instantly as a distinctive trade mark for the goods and services concerned in Classes 7, 9, 11, 35, 36, 37, 38, 39, 40 and 42.

However, the Board notes that the contested decision does not explain why the sound sequence lacks any distinctive character for the various goods and services. A general assumption regarding the behaviour of the relevant public in relation to the heterogeneous group of [goods and services](#), which are also aimed at different consumer groups and serve different purposes, is not sufficient reasoning.

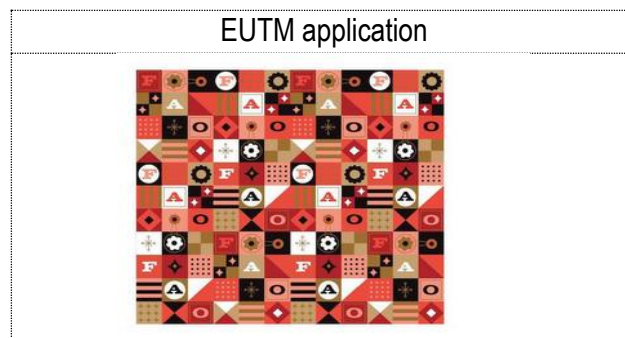
There is no evidence that the sequence of tones (jingle) is currently being used. It differs from other tone sequences. Individual tones, just as letters, can be combined infinitely. Even if some consumers

have a low degree of perception with respect to jingles, this does not mean that this part has to be taken into account exclusively.

In addition, the jingle is not related to the goods and services applied for; it is neither an engine sound nor a natural sound. Whether the sound sequence is an ‘inspirational or motivational noise’ is open for discussion, but it is more than likely that this ‘noisiness’ will be consciously perceived and relevant consumers will also be able to remember the trade mark at a later point.

Consequently, the contested decision is annulled and the application is allowed to proceed to publication.

03/10/2019, R 2368/2018-1, PATTERN CONSISTING OF A VARIETY OF SHAPES, DESIGNS, COLOUR AND REPEATED LETTERS F, A, O



Outcome: Application allowed.

Norms: Article 7(1)(b) EUTMR; Article 7(1)(c) EUTMR.

Keywords: Pattern mark; Distinctive (yes).

Summary: The applicant sought to register a figurative mark containing the word element ‘FAO FAO’ for goods and services in Classes 16 and 28. The examiner partially refused the mark applied for on the grounds of Article 7(1)(b) and (c), in conjunction with Article 7(2), EUTMR. She stated that even if the pattern consisted of a variety of geometric shapes, designs and colours, it was not ‘sufficiently complex’ to provide it with distinctive character. The sign would give the impression of it being for a decorative purpose as regards the goods applied for, as a typical pattern that can be found on a variety of products for decorative purposes. Moreover, the repeated letters ‘F’, ‘O’, ‘A’ would not be perceived as a verbal element, but simply as random letters of the alphabet.

However, the Board recalls that recognition that a mark has distinctive character, within the meaning of Article 7(1)(b) EUTMR, is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark would enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings. First it notes that the sign’s ‘complexity’ may not be a sufficient reason to decline the distinctiveness of the mark. Secondly, in relation to the fact that the sign gives the impression that it is primarily intended for a decorative purpose, the Board notes that a decorative function is not incompatible with a distinctive function. The Board underlines that as regards

pattern marks there is no clear practice and that these kinds of marks should be assessed on a case-by-case basis.

The Board considers that the sign at hand does not have a ‘special level of artistic creativity or imaginativeness’, nevertheless it would be excessive to declare that it is ‘devoid’ of any distinctive character in relation to the goods specified.

The contested decision is annulled and the application is allowed to proceed to publication.

C. ARTICLE 7(1)(c) / 59(1)(a) EUTMR – DESCRIPTIVE SIGN

Descriptive (yes)

[19/07/2019, R 2191/2018-2, Grana Padano](#)

Outcome(s): Decision confirmed.

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

Keywords: Descriptive (yes).

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

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

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

The appeal is dismissed.

[19/11/2019, R 856/2019-5, Bluewater](#)

Outcome: EUTM cancelled.

Norms: Article 7(1)(b) EUTMR; Article 7(1)(c) EUTMR; Article 59(1)(a) EUTMR.

Keywords: Word mark; Descriptive; Non-distinctive.

Summary: The EUTM covering different kinds of water was cancelled, because for the average English-speaking public the sign described the kind and quality of the goods.

The Board points out that the meaning of the terms ‘blue’ and ‘water’ is a well-known fact. It is further common knowledge that terms referring to a colour may be used in order to designate certain characteristics of beverages, including non-alcoholic beverages (28/04/2016, T-803/14, B’lue (fig.) / BLU DE SAN MIGUEL, EU:T:2016:251, § 28; 12/06/2018, [T-375/17](#), BLUE, EU:T:2018:340, § 31).

The goods at issue are water drinks and the sign includes the word 'water'. With regard to the element 'Blue', the first association that springs to mind in the context of water is its colour. Moreover 'Blue' is the natural colour which comes to mind when thinking of large expanses of water. Thus, being confronted with the term 'BLUEWATER', the English-speaking public will simply assume that the water comes from a blue water source.

The Board upholds the Cancellation Division's finding in that the colour 'blue' in relation to water is immediately associated with positive characteristics such as 'freshness', 'pureness', 'coolness' or 'clarity'. It is the same image of natural water as found in lakes, waterfalls or springs which is the reason why the colour blue is associated with water regarding its purity, clarity and coolness (14/01/2015, T-69/14, MELT WATER Original, EU:T:2015:8, § 36).

It is also a well-known fact that water and water-based beverages have been, and are commercialised, in blue-coloured vessels. Thus, together with a blue-coloured water bottle, the sign 'BLUEWATER' simply underlines the message conveyed by the water producer, namely that the water is from a large blue water source (lake, river, spring) and has the aforementioned positive characteristics.

Finally, it is also a well-known fact that water producers have been offering water in different flavours for many years. These flavours are often directly linked to, and advertised in, their respective colours. Consequently, English-speaking consumers may also understand the mark 'BLUEWATER' as a direct reference to the typical colour of a specific flavour or taste (e.g. 'water with a blueberry flavour') or to the 'classic water' version 'blue' without taste.

As regards inherent distinctiveness, the Board indicates that the sign contains a purely laudatory message and merely advertises the waters covered by the registration to be as pure, natural and cool as the blue waters from a fresh spring, lake or alpine river. With regard to beverages, their coolness and freshness, but also their health-improving or maintaining qualities are of high importance to the consumer. As foodstuffs and beverages are often genetically modified or otherwise chemically treated, the evocation of purity and naturalness, with the adjective 'BLUE', is bound to raise expectations as to the high quality of the goods thus characterised.

The appeal is dismissed.

[08/10/2019, R 1124/2019-4, THE GOOD CIDER OF SAN SEBASTIAN Since 1918 \(fig.\)](#)



Outcome: Decision confirmed.

Norms: Article 7(1)(b) EUTMR; Article 7(1)(c) EUTMR; Article 7(2) EUTMR.

Keywords: Figurative trade mark; Function of trade mark; Quality of the goods and services; Descriptive (yes).

Summary: The examiner refused the application for the figurative mark 'THE GOOD CIDER OF SAN SEBASTIÁN Since 1918' intended for ciders pursuant to Article 7(1)(b) and (c) EUTMR. She stated that the relevant English-speaking consumer would perceive that the sign provided information about the goods. Moreover, the different sizes and positions of the letters, the rhombus and the grey box, were fairly common and banal, as they were usually used on labels and did not add any distinctive element to the descriptive message of the word elements.

The Board agrees with the examiner. The combination of the terms complies with English grammar rules and is easy and immediately comprehensible and conveys obvious and direct information about the goods in question for the English-speaking public, namely a message indicating that the goods comprise good quality ciders originating from San Sebastián, which have been prepared and sold since 1918. The word 'from' accompanied by a year is a frequently used expression to designate the creation of an industrial or commercial establishment or of a specific product or service. As a marketing element it connotes an indication of quality that it is associated with a long existence or history, and therefore it is descriptive as regards the year in which the establishment was founded or the first time that the goods applied for were manufactured.

The figurative elements do not alter this conclusion. The type face for the letters used is not particularly striking or incorporate any characteristic requiring the relevant consumer to make an intellectual effort in order to identify the meaning of the word elements in relation to the goods applied for (28/6/2011, [T-487/09](#), ReValue, EU:T:2011:317, § 39, 44; 15/5/2014, [T-366/12](#), Yoghurt-Gums, EU:T:2014:256, § 31). The fact that the word elements appear on various levels and in different sizes does not change this assessment as they are stylistic elements which are commonly used on the market and therefore will not divert the public's attention away from the purely descriptive message of the sign (29/10/2018, R 2713/2017-4, FOODS & WINES from SPAIN (fig.), § 26).

In addition, the rhombus will not attract the relevant consumer's attention either, since such structures usually have the secondary function of being an image background and usually serve to highlight word elements (15/03/2006, [T-35/04](#), Ferró, EU:T:2006:82, § 52, confirmed by [C-225/06 P](#); 15/12/2009, [T-476/08](#), Best Buy, EU:T:2009:508, § 27; 27/10/2016, [T-37/16](#), Caffè Nero, EU:T:2016:634, § 42).

Therefore the visual elements do not have sufficient weight in the overall impression for the public. As a whole the sign is descriptive and it also lacks distinctiveness.

The appeal is dismissed and the application is rejected.

[28/11/2019, R 86/2019-1, LT \(fig.\)](#)



Outcome: Application rejected.

Norms: Article 7(1)(b) EUTMR; Article 7(1)(c) EUTMR.

Keywords: Figurative trade mark; Abbreviation; Figurative element; Geographical origin; Descriptive; Non-distinctive.

Summary: The application for the figurative mark 'LT' intended for goods in Class 28 (such as fishing tackle) was rejected on the grounds of Article 7(1)(b) and (c) EUTMR. The decision was based on the findings that 'LT' was the ISO identifier for Lithuania and since fishing and angling were very popular in the Baltic countries, including Lithuania, the contested sign reflected that the goods originated from Lithuania.

The Board shares the examiner's finding that the figurative aspects of the mark applied for are so commonplace and banal that the mark applied for will be perceived as consisting essentially of the letters 'LT'.

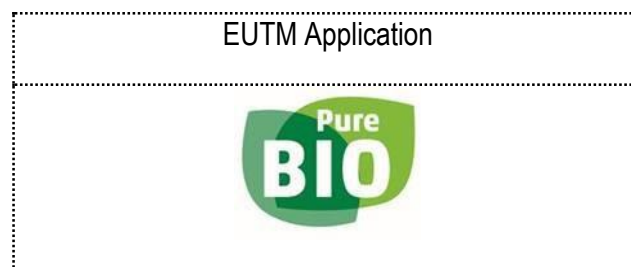
The letters 'LT' are the ISO 3166-1 alpha-2 code for Lithuania. This abbreviation, in the same way as other letter country codes, will be familiar to the relevant public consisting of fishing enthusiasts located in the EU from its use in domain names and as an abbreviation on packaging and information leaflets as regards consumer products generally.

Lithuania is one of the Baltic States and has numerous lakes and rivers. Clearly, fishing enthusiasts could expect that the lakes and rivers of Lithuania are ideal places for catching freshwater fish. It is, therefore, likely that the relevant public with an interest in fishing may think that the fishing gear designated by the mark applied for, in which the most striking element is 'LT', originates from Lithuania. Moreover, the Board indicates that it is implausible that consumers will attribute another purpose to the abbreviation when viewed on the products or on their packaging. As the examiner pointed out, the sign provides information on the kind and geographical origin of the goods applied for.

As regards inherent distinctiveness, the Board indicates that it suffices if consumers do not attribute a distinctive function to this sign. Since such consumers are already familiar with ISO two-letter country codes, and LT as the country code for Lithuania, it is inconceivable that the relevant public for fishing gear would regard a sign consisting of the two letters 'LT' as the trade mark of an entrepreneur.

The appeal is dismissed.

[28/11/2019, 1179/2019-4, Pure BIO \(fig.\)](#)



Outcome: Application rejected.

Norms: Article 7(1)(b) EUTMR; Article 7(1)(c) EUTMR.

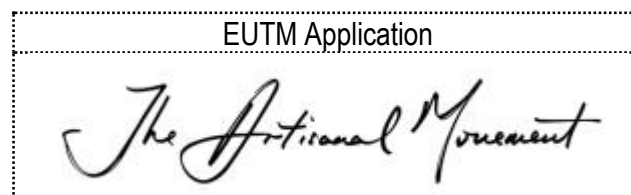
Keywords: Descriptive element, Figurative element, Figurative trade mark.

Summary: The appellant sought to register the figurative mark represented above for goods in Classes 5, 29, 30, 31 and 32. The examiner refused the application in respect of all the goods by decision of 4 April 2019 pursuant to Article 7(1)(b) and (c) EUTMR, because 'Pure BIO' would be immediately understood by relevant English-speaking average consumers in connection with the goods claimed in the sense that the foodstuffs, dietetic preparations, dietary supplements or baby food were pure, i.e. free of harmful elements or amounts, and came from biological production. On account of the descriptive meaning, the sign was also devoid of distinctive character. The graphic design was not sufficient to establish distinctive character. Stylised leaves were used extensively in trade as a reference to organic origin or plant ingredients. The colour used, including the colour green, was a colour that was connected to nature. The font was a standard font.

The Board confirms the examiner's approach and notes that the composition of these two words is no more than the sum of their individual components. As a linguistically common combination of two known terms, the expression 'Pure BIO' contains nothing more than the meaning of the two components. The word components amount to nothing more than a linguistically usual combination of descriptive terms, which convey direct information about the nature and quality of the goods in a linguistically customary manner. The graphic design does not change this descriptive meaning of the word component 'Pure BIO' in any way. The stylisation of the leaves and the use of different shades of green are also not striking in such a way that they could divert attention away from the descriptive meaning of the word elements.

The appeal is dismissed.

[13/11/2019, R 1061/2019-2, The Artisanal Movement \(fig.\)](#)



Outcome: Application partially rejected.

Norms: Article 7(1)(b) EUTMR; Article 7(1)(c) EUTMR.

Keywords: Figurative trade mark; Descriptive; Non-distinctive.

Summary: The applicant sought to register the figurative sign 'The Artisanal Movement' for various goods and services. It was found that the relevant English-speaking consumer would understand the meaning of the sign, namely a movement campaigning for, or activities relating to, goods produced on a small scale (e.g. furniture, decorative arts, sculptures, clothing, jewellery, food items, household items, tools or mechanisms for handmade clocks/watches) using traditional methods to achieve a goal, or a group of people aiming to produce goods on a small scale using traditional methods.

The Board takes the view that the examiner correctly refused the registration of the contested sign. Seen as a whole, the sign 'The Artisanal Movement' follows the standard rules of English grammar and is not in any way unexpected or surprising. The consumers targeted will immediately understand the

mark in its literal sense, namely as a movement that focuses on the revival of old, handcrafted and small-scale ways of doing things and the products that are manufactured in that way.

Article 7(1)(c) EUTMR does not require actual descriptive use. As evidenced by the listed dictionary definitions, the sign can be used to describe the fact that the relevant goods and services are a part of (or contribute to creating) an artisanal movement that focuses on handmade products, traditional techniques and small-scale production. In addition, the services objected to may very well be offered by using traditional techniques, using handmade products or advertising, commercialising and organising activities concerning traditional techniques and handmade products.

The font used in the sign imitating handwriting and the use of title-case letters do not change or impact on the message conveyed by the sign. Moreover, the Board endorses the examiner's arguments concerning a comparison with an example from Convergence Programme 3 Common Practice regarding stylised 'handwritten lettering', to the extent that in the current case the words 'The Artisanal Movement' are readily intelligible and consumers, without any mental steps, will understand the message conveyed by the words.

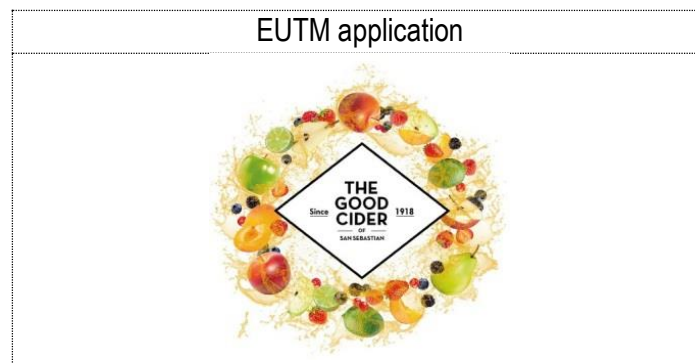
As regards inherent distinctiveness, the Board indicates that the contested sign conveys a clearly laudatory message that the goods and services offered under the contested trade mark are special because they belong to 'The Artisanal Movement' and thus have been produced (or are offered) with greater care and skill than comparable competing goods and services.

Furthermore, in relation to the remaining goods and services, the Board recommends that the examiner reopen the examination pursuant to Article 30(1) EUTMDR and Article 45(3) EUTMR as they can also be obtained using traditional methods and can be produced on a small scale. The Board also notes that for those goods or services which could have no relationship at all with artisanal production, the sign applied for could be deceptive.

The appeal is dismissed and the application is to be partially rejected.

Descriptive (no)

[08/10/2019, R 1125/2019-4, THE GOOD CIDER OF SAN SEBASTIAN SINCE 1918 \(fig.\)](#)



Outcome: Decision annulled.

Norms: Article 7(1)(b) EUTMR; Article 7(1)(c) EUTMR; Article 7(2) EUTMR.

Keywords: Figurative element; Function of trade mark; Quality of the goods and services; Descriptive

(no); Minimum degree of distinctiveness (yes).

Summary: The examiner refused the application for the figurative mark ‘THE GOOD CIDER OF SAN SEBASTIÁN Since 1918’ intended for ciders pursuant to Article 7(1)(b) and (c) EUTMR. She stated that the relevant English-speaking consumer would perceive that the sign provided information about the goods. Moreover, the figurative elements did not add any distinctive element to the descriptive message of the word elements and rather increased its descriptiveness.

As in case [R1124/2019-4](#), the Board agrees with the examiner that the combination of the terms is easy and immediately comprehensible and conveys obvious and direct information regarding the goods in question, further a rhombus usually serves to highlight the word elements.

Although it is true that nowadays ciders exist that taste of other fruits such as pears, limes, peaches, strawberries, etc., fruits other than apples do not have a direct link with ciders, so the link that may eventually be established between other fruits and ciders is indirect and at best evocative of said goods. Furthermore, the configuration of the graphic element in the shape of a circle consisting of fruits with a very varied colour combination will not simply be perceived as a simple ‘decoration’ of the goods applied for, but as a drawing which consists of various elements with intrinsic distinctive character.

Although the existence of a certain level of creativity is not indicative of distinctive character, the particular composition of the fruit in a circle is eye-catching and in the present case allows the relevant public to identify easily and immediately the origin of the goods in question as the fruit circle design will create an immediate, lasting impression. Taking into account the wide variety of fruit represented, the consumer will not analyse what kind of fruit is involved.

The figurative element in the overall impression of the sign is therefore sufficient to divert the relevant public’s attention away from the descriptive nature of the word combination.

The contested decision is annulled and the application is allowed to proceed to publication.

D. ARTICLE 7(1)(d) / 59(1)(a) EUTMR – CUSTOMARY SIGN

[no entry]

E. ARTICLE 7(1)(e) / 59(1)(a) EUTMR – SHAPE

[no entry]

F. ARTICLE 7(1)(f) / 59(1)(a) EUTMR – PUBLIC POLICY / MORALITY

[no entry]

G. ARTICLE 7(1)(g) / 59(1)(a) EUTMR – DECEPTIVE SIGN

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



Outcome(s): Decision confirmed.

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

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

Summary: In relation to distinctiveness the IR holder essentially argued that the four-tipped crown device was highly stylised, original and unique. It was also the main figurative element of several of the IR holder's EUTMs. This was sufficient, it claimed, to render the mark distinctive.

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

Moreover, not only signs with 'negative' connotations can be objected to on public policy grounds. The use of symbols with strong positive connotations may also need to be regulated on public policy grounds. The regulation of their use in trade marks is justified in order to protect and preserve their positive connotations. By regulating the availability of these signs to traders, it can be ensured that these signs are not abused, that their positive connotations are not taken advantage of and that consumers are not misled into believing that a connection exists with a particular institution or entity when it does not. The symbols and names of political institutions fall within the category of signs that can have strong positive connotations for a significant part of the public and which require protection on the basis of public policy. Intrinsically the contested mark makes reference to being of Danish origin and contains a reference to the Danish monarchy or government. The public will perceive the element 'BY DANISH

CROWN' in its intrinsic meaning when it is used in relation to the goods and services claimed. The Board notes that avoiding disappointment or deception is not the goal of Article 7(1)(f) EUTMR. Rather, the provision aims to ensure, on the one hand, the avoidance of offense through the use of signs with strong negative connotations, and on the other hand, the regulated use, not restricted by trade marks, of certain signs with strong positive connotations, in order to protect and preserve those positive connotations.

In addition, the element 'BY DANISH CROWN', and the white crown combined with 'DANISH', can imply that the goods sold under the mark would be provided by a company under the ownership of the Danish monarchy or government. The Board finds there is a serious risk that the element 'by Danish Crown' is of such a nature as to mislead a part of the relevant public to believe that the goods in question have been subjected to an authorisation, official approval, or quality control by the Danish monarchy or government.

Consequently, the contested sign is deceptive within the meaning of Article 7(1)(g) EUTMR.

The appeal is dismissed.

[19/11/2019, R 586/2019-4, global star registry since 2002](#)



Outcome: Application partially rejected.

Norms: Article 7(1)(g) EUTMR.

Keywords: Figurative trade mark, Deceptive element.

Summary: The applicant sought to register the above figurative mark in black and white for goods and services in Classes 14, 16 and 35. The examiner partially refused the mark applied for on the grounds of Article 7(1)(b) and (c) EUTMR, since the mark lacked any distinctive character for the goods in Classes 16 and 35. It was stated that consumers would consider the sign applied for as an informative message that pointed out the characteristics of the goods and services in relation to a worldwide star registry, but not as an indication of commercial origin. The application was allowed to proceed for the goods in Class 14 (inter alia, precious metal and their alloys, goods in precious metal, etc.).

The Board, however, points out that the sign applied for could be rejected based on Article 7(1)(g) EUTMR, which excludes from registration signs that have a deceiving purpose towards the public. For the application of Article 7(1)(g) EUTMR, it suffices that the sign applied for contains word elements that are deceptive, notwithstanding the other elements in the sign. In this view, the Board notes that the sign 'Global Star Registry' promotes the fact that the consumer would be able to give official names to stars and that the applicant controls a worldwide registry for that purpose. The Board refers to the decision of [04/04/2001, R 468/1999-1, INTERNATIONAL STAR REGISTRY](#), where the same reasoning applied

and the application for the mark was rejected. Furthermore, reference is made to the site of the International Astronomic Union, where it is made clear that private star registries are devoid of any connection with it.

Regarding the applicant's argument concerning the fact that a mark can have both legal or illegal use, the presumption should be that the use would be the legal one, the Board notes that it is not applicable to the case at hand. Firstly, it underlines that the analysis of such a principle should be done by way of a prognosis, since there has been no use of the mark yet. Secondly, the deceptive character of the mark comes before the legal or illegal use of the mark. Lastly, the Board underlines that this principle refers to a specific circumstance where the goods and services are written in a generic way and the meaning of the sign is deceptive for part of the goods. It emphasises that this is not the case here, as all the goods and services in Classes 16 and 35 applied for (printed matter) are related to the naming of stars.

Consequently the appeal is dismissed and the application is partially rejected for goods and services in Classes 16 and 35.

See also [19/11/2019, R 588/2019-4, MYSTAR GLOBAL STAR REGISTRY](#).

H. ARTICLE 7(1)(h) / 59(1)(a) EUTMR – ARTICLE 6TER PARIS

[no entry]

I. ARTICLE 7(1)(i) / 59(1)(a) EUTMR – OTHER EMBLEMS

[no entry]

J. ARTICLE 7(1)(j) / 59(1)(a) EUTMR – GEOGRAPHICAL INDICATIONS

[19/09/2019, R 1223/2019-5, Mappa di Imola](#)

Outcome: Decision confirmed.

Norms: Article 7(1)(j) EUTMR.

Keywords: Word mark; Geographical origin.

Summary: The applicant sought to register the sign 'MAPPA DI IMOLA' for wines. The examiner raised a provisional refusal of the trade mark registration on the ground of Article 7(1)(j) EUTMR, indicating that this could be overcome by limiting the abovementioned goods affected by the designation of origin in Class 33 as followed: wines complying with the specifications of the protected designation of origin (PDO) 'Colli d'Imola'. The applicant did not withdraw its application for registration, nor did it propose a restriction as regards the list of goods and the examiner considered that the sign 'MAPPA DI IMOLA' for 'wine' evoked the PDO 'Colli d'Imola'.

The Board indicates that the applicant's approach concerning its reasoning based on the concept of a likelihood of confusion is incorrect and cannot be followed. For geographical indications the relevant legal concept is 'evocation' which, according to the Court of Justice, refers to 'the fact that the word used to designate a product incorporates part of a protected designation, so that when the consumer is confronted with the name of the product, the image triggered in his or her mind is that of the product whose designation is protected'. Therefore there is no obligation to establish a degree of similarity. The Board notes that in the present case, the applicant's sign incorporates the most significant part of the protected designation of origin and indicates the same geographical origin. The consumer will therefore

establish a link between the trade mark applied for and the PDO in question. In any case, for the absolute ground for refusal set out in Article 7(j) EUTMR to apply, it suffices that a trade mark contains or consists of elements which enable the geographical indication in question to be identified with certainty.

The appeal is dismissed.

[PDO-IT-A0290 - Colli d'Imola](#)

[10/10/2019, R 1143/2019-5, FÉLIX de Múrtiga JABUGO \(fig.\)](#)



Outcome: Decision confirmed.

Norms: Article 7(1)(j) EUTMR.

Keywords: Right to be heard; Word mark; Geographical origin.

Summary: The applicant sought to register the figurative sign 'FÉLIX de Múrtiga JABUGO' for goods and services in Classes 29, 35 and 43. The examiner proposed, as a limitation to circumvent the ground for refusal, the wording: 'Ham de Jabugo conforming to the specifications of the Protected Designation of Origin Jabugo; Jabugo palettes conforming with the specifications of the Protected Designation of Origin Jabugo'. However, the applicant did not submit observations in respect of the examiner's provisional partial refusal and, therefore, did not limit its specification in Class 29 to the suggestion in its first submission. Finally, the examiner partially refused the trade mark applied for pursuant to Article 7(1)(j) EUTMR in respect of all the goods in Class 29, namely: Jabugo Ham granted under the Protected Designation of Origin 'Jamón de Huelva'/'Jabugo'; Jabugo palettes granted under the Protected Designation of Origin 'Jamón de Huelva'/'Jabugo'.

The Board notes that 'JABUGO' is a Protected Designation of Origin in the European Union under Regulation No 1151/2012 of the European Parliament and of the Council of 21/11/2012 on quality schemes for agricultural products and foodstuffs. The objections made pursuant to Article 7(1)(j) EUTMR may be rejected if the relevant goods are restricted in order to comply with the specification for the PDO in question. In the case of agricultural products and foodstuffs, as in the present case, the category of goods that includes those covered by the PDO must be restricted to designating exactly the goods covered by the PDO that comply with the specification. The application must be rejected since there is a direct use of the PDO 'Jabugo' through its reproduction together with other elements in the sign applied for (see also [03/10/2019, R1142/2019-5, Romeral de jabugo](#)).

The appeal is dismissed.

K. ARTICLE 7(1)(k) / 59(1)(a) EUTMR – TRADITIONAL TERMS FOR WINE

[no entry]

L. ARTICLE 7(1)(l) / 59(1)(a) EUTMR – TRADITIONAL SPECIALITIES GUARANTEED

[no entry]

M. ARTICLE 7(1)(m) / 59(1)(a) EUTMR – PLANT VARIETY DENOMINATIONS

[no entry]

N. ARTICLE 59(1)(b) EUTMR – BAD FAITH

[no entry]

O. ARTICLES 7(3) / 59(2) EUTMR– ACQUIRED DISTINCTIVENESS

[02/10/2019, R 1550/2019-4, WINDSURFER \(fig.\)](#)



Outcome: Decision confirmed.

Norms: Article 7(1)(c) EUTMR, Article 7(3) EUTMR.

Keywords: Figurative trade mark, Descriptive element, Descriptive (yes), Distinctiveness acquired by use (no).

Summary: The examiner refused the sign applied for on the basis of Article 7(1)(b), (c) and Article 7(3) EUTMR for goods in Classes 25 (athletic clothing) and 28 (sports equipment) as the average English-speaking consumer would understand the word 'WINDSURFER' as a long narrow board with a sail attached to it or a person who rode on a windsurfer. The figurative element of a windsurfer merely reinforced the semantic meaning of the word element. The word and figurative elements of the sign conveyed obvious and direct information that the goods applied for were clothing and sports equipment intended for windsurfers.

The Board finds that in relation to the inherent distinctiveness of the sign applied for, no argument has been brought on appeal to challenge the examiner's finding that the sign applied for is descriptive and lacks distinctive character.

As regards acquired distinctiveness, the evidence provided consists of a product overview showing a sailboard, sails, components and accessories for windsurfing; advertisements for windsurfing events

and competitions in particular in Italy, Poland, France, the Netherlands and Switzerland; links to videos on the applicant's YouTube channel, its website www.windsurferclass.com and Facebook page; a printout from the UK association and an excerpt from the commercial register from the Chamber of Commerce of Rome. This evidence does not constitute proof that the relevant public in the English-speaking part of the European Union has been extensively exposed to the sign in relation to the goods in question. It fails to demonstrate to what extent the applicant sold the goods and to what extent it has gained market recognition in respect of them. No information has been provided concerning the investments made by the applicant to promote the trade mark, neither have any statements from chambers of commerce and industry or from other professional associations nor any surveys conducted with respect to the relevant public been furnished. The only evidence relating to the UK does not say anything about the acquired distinctiveness of the mark and does not even refer to the sign. In general, the evidence does not even refer to the goods at stake but only concerns the organisation of windsurfing events and competitions.

Overall, the evidence is insufficient to conclude that acquired distinctiveness has been proven for the relevant territories where the mark was devoid of distinctive character, i.e. in the United Kingdom, Ireland and Malta as well as in the Member States where English is widely understood, such as in Germany, the Nordic countries or the Netherlands. Consequently, the application is rejected.

The appeal is dismissed

2. GROUNDS FOR REVOCATION (ARTICLE 58 EUTMR)

[no entry]

A. ARTICLE 58(1)(a) EUTMR – REVOCATION FOR NON-USE

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



Outcome(s): Decision annulled.

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

Keywords: Used in the course of trade.

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

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

The appeal is upheld.

B. ARTICLE 58(1)(b) EUTMR – COMMON NAME FOR A PRODUCT OR SERVICE

[no entry]

C. ARTICLE 58(1)(c) EUTMR – USE LIABLE TO MISLEAD THE PUBLIC

[no entry]

3. RELATIVE GROUNDS FOR REFUSAL (ARTICLE 8 EUTMR) / INVALIDITY (ARTICLE 60 EUTMR)

[no entry]

A. ARTICLE 8(1)(a) / 60(1)(a) EUTMR – IDENTICAL SIGNS / G&S

[no entry]

B. ARTICLE 8(1)(b) / 60(1)(a) EUTMR – LIKELIHOOD OF CONFUSION

[11/07/2019, R 2557/2018-4, Kylie / Kylie et al.](#)

Earlier signs	Contested EUTM
KYLIE KYLIE MINOGUE	Kylie

Outcome(s): Decision confirmed.

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

Keywords: Admissibility, Dissimilarity of the goods and services, Likelihood of confusion (no), Reputation, Substantiation of earlier right.

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



The Board confirms the contested decision. The earlier international registrations and French mark were not substantiated. Article 7(2)(a)(ii) EUTMDR requires evidence of the registration in the form of a copy of the relevant registration certificate and, as the case may be, of the latest renewal certificate. The

Board emphasises that nothing in the regulations relieves holders of international registrations from the obligation of substantiation from the competent administration (i.e. WIPO) by which the trade marks are registered or making reference to a source from which this evidence is accessible. The extracts from the WIPO's register submitted for the first time on appeal are rejected as belated and hence are inadmissible. In addition, none of the extracts indicates a specification of the goods and services which are protected by the registrations; the evidence is manifestly insufficient to prove the scope of protection of the earlier rights.

On the basis of the earlier German trade mark and the earlier UK trade mark, the Board concludes that the opposition must fail on the ground of Article 8(1)(b) EUTMR taking into account that the conflicting goods or services are dissimilar. Moreover the opposition on Article 8(5) EUTMR is unfounded as the opponent failed to submit a coherent line of reasoning demonstrating what the detriment or unfair advantage would consist of and how it would occur.

The appeal is dismissed.

[26/08/2019, R 12/2019-2, 4Horses \(fig.\) / HORSE \(fig.\)](#)

Earlier trade mark	Contested EUTM
	

Outcome: Decision annulled.

Norms: Article 8(1)(b) EUTMR, Article 10(1) EUTMDR.

Keywords: Identity of the goods and services, Dissimilarity of signs, Complex mark, Common element, Descriptive element, Conceptual similarity, Phonetic dissimilarity, Visual dissimilarity, Weak element, Likelihood of confusion (no).

Summary: The Opposition Division partially upheld the opposition for all the contested goods in Class 18 and rejected the contested mark for these goods.

The Board notes that it is common ground that the goods are identical, essentially harnesses, saddlery and parts of saddles used for horse riding (equestrian sport). Such goods are not cheap and they play an important role in the safety and comfort of riders, therefore, they are expected to be selected with care; with an attention level that is above average.

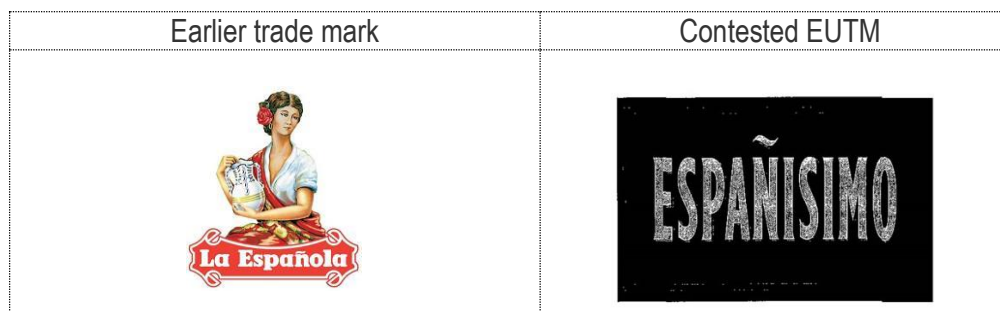
In relation to the comparison of the signs the Board finds that both complex marks contain verbal and prominent figurative elements. Due to the arrangement of the signs and the size of their word and figurative elements, both the figurative elements and the word elements are co-dominant within the respective signs. Visually, the signs are similar only to a very low degree. Their visually significant figurative elements are entirely different; the word elements 'HORSE' and '4Horses' are also not identical, and the differentiating element, the number '4' is at the beginning of the contested sign. The single common word 'HORSE' must not be overrated as it is descriptive in both signs and merely communicates to the relevant Portuguese public that the goods at issue are all horse accessories.

Phonetically, the similarity is also low. The English pronunciation of the verbal elements will result in the coincidence of one syllable out of three, and the semi-Portuguese pronunciation leads to the coincidence of one syllable out of four. Conceptually, the marks refer to the concept of ‘a horse’ and ‘four horses’, respectively, which means that there is a certain degree of conceptual similarity. Nevertheless, that similarity is weak in the context of the overall impression created by the marks, having regard to the very weak distinctive character of the term ‘horse’ in question. Consequently, the impression created by the marks compared is different, as they do not display sufficient visual, phonetic or conceptual similarities to be regarded as being similar. The distinctive elements of the mark applied for are the ones that will be remembered by the relevant public.

Overall, the general impression, caused by the absence of common distinctive elements, will prevent consumers from perceiving one mark as a new line of the other. Despite the identity between the goods there can be no likelihood of confusion between the marks in dispute, recalling also the public’s higher than average level of attention. Consequently, the opposition must be rejected in its entirety.

The appeal is allowed.

[03/10/2019, R 1952/2018-1, ESPAÑISIMO \(fig.\) / La Española \(fig.\) et al.](#)



Outcome: Opposition allowed.

Norms: Article 8(1)(b) EUTMR.

Keywords: Enhanced distinctiveness; Identity of the goods and services; Similarity of the signs; Likelihood of confusion (yes).

Summary: The Opposition Division upheld the opposition for all the contested goods in Class 29 because it found that there was a likelihood of confusion under Article 8(1)(b) EUTMR with earlier EUTM No 5 773 957 which was not yet subject to the use obligation.

The Board, confirming the Opposition’s Division findings, notes that the goods covered by the contested mark are identical to those of the earlier mark since they are all ‘edible oils and fats’, which are precisely the goods covered by the earlier mark.

Regarding the comparison of the two signs, the Board indicates that where a mark is composed of word elements and figurative elements, the former are, as a rule, more distinctive than the latter, since the average consumer will more easily refer to the goods in question by citing the name rather than describing the figurative element of the mark ([18/09/2012, T-460/11, Bürger, EU:T:2012:432, § 35](#)). Consumers will therefore in both marks, note the word elements ‘La Española’ and ‘ESPAÑISIMO’,

respectively. Firstly, from a visual perspective, the contested mark's word element has the same beginning as the earlier mark's verbal element 'Espanola', which is the part to which consumers attach more attention. Secondly, in regard to the aural comparison of the signs, the two signs produce a similar sound, since their respective first five letters are the same. Lastly, from a conceptual comparison the consumer will, in both signs, recognise a connotation in relation to Spain. Therefore, there is also a degree of conceptual similarity between the marks. Overall, the signs are similar to a certain degree.

Moreover, the opponent claimed the enhanced distinctiveness of its earlier mark. The Board, after assessing the documents submitted as a whole, notes that the use of the earlier mark is substantiated, geographically widespread and long-standing for a wide proportion of the relevant public – notably in Spain and Germany.

The conflicting goods are identical and the two signs have at least a low level of similarity. Taking into account the fact that the public will more easily refer to the signs in question by their words than by describing their figurative elements and the earlier mark's enhanced distinctiveness, the Boards confirms the likelihood of confusion between the two signs. Last, but not least, the Board emphasises that consumers may assume that the products originate from the same or economically-linked enterprises as consumers may see in the later mark a new line of oil or edible fat products from 'La Española'.

The appeal is dismissed and the opposition is allowed.

C. ARTICLE 8(3) / 60(1)(b) EUTMR – TM FILED BY AGENT OR REPRESENTATIVE

[no entry]

D. ARTICLE 8(4) / 60(1)(c) EUTMR – NON REGISTERED MARKS / OTHER SIGNS

[no entry]

E. ARTICLE 8(5) / 60(1)(a) EUTMR – MARKS WITH A REPUTATION

[no entry]

F. ARTICLE 8(6) / 60(1)(d) EUTMR – GEOGRAPHICAL INDICATIONS

[no entry]

G. ARTICLE 60(2)(a) EUTMR – RIGHT TO A NAME

[no entry]

H. ARTICLE 60(2)(b) EUTMR – RIGHT OF PERSONAL PORTRAYAL

[no entry]

I. ARTICLE 60(2)(c) EUTMR – COPYRIGHT

[no entry]

J. ARTICLE 60(2)(d) EUTMR – INDUSTRIAL PROPERTY RIGHT

[no entry]

4. PROOF OF USE AND ASSESSMENT OF EVIDENCE

[no entry]

5. OTHER ISSUES

[no entry]

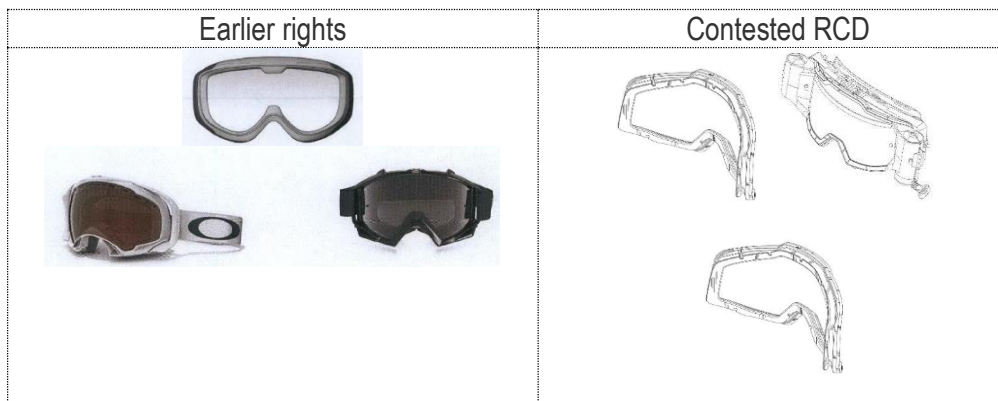
IV. DESIGNS

A. ARTICLES 3(a) AND 9 CDR – REGISTRATION PROCEEDINGS

[no entry]

B. ARTICLE 25(1)(b) CDR – INVALIDITY PROCEEDINGS

[22/03/2019, R 1283/2018-3, Goggles \(part of -\)](#)



Outcome: Invalidity application rejected.

Norms: Article 6(1)(b) CDR, Article 25(1)(b) CDR, Article 63(2) CDR, Article 28 CDIR.

Keywords: Complementary evidence, Conflict of design with prior design, Novelty, Overall impression, Technical function of design, Visual dissimilarity.

Summary: It is no longer possible to introduce other earlier designs that could form an obstacle to the RCD's novelty or individual character into the proceedings once the application has been made. The late evidence is also not into account in the appeal proceedings. The contested RCD differs greatly from the rest of the designs invoked.

C. OTHER ISSUES

[no entry]