

# Boards of Appeal Decisions Overview 2020 – Part I

This overview includes a selection of final decisions of the Boards of Appeal notified by the Registry between 01/01/2020 and 30/07/2020 as well as information on referrals to the Grand Board.

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.

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## I. GRAND BOARD CASES

### 1. DECISIONS

[11/02/2020, R 2445/2017-G, Sandra Pabst](#)

**Bad faith – Legal certainty – Proof of use – Article 58(1)(a) EUTMR – Article 107 EUTMR – Decision confirmed – Cancellation rejected**

The Grand Board confirmed the decision of the Cancellation Division, namely that the revocation request had been filed as an abuse of rights and process.

These findings were reached taking into account the number of revocation requests (37) filed against the same company practically simultaneously, together with the attempt to acquire one of those trade marks (exerting disproportionate pressure on the EUTM proprietor which was done in a retaliatory manner), the nature of the company which filed the revocation request and the number of other cases launched by the same or economically linked companies, concerning their hundreds of revocation actions and thousands of trade mark filings and trade name registrations.

[29/06/2020, R 0379/2017-G, VICHY SPA \(fig.\) / SPA et al. \[will be final on 04/11/2020\]](#)



**Common element – Conceptual dissimilarity – Likelihood of confusion – Due cause – Unfair advantage – Article 8(1)(b) EUTMR – Article 8(5) EUTMR – Decision annulled – Opposition rejected**

Bearing in mind the context in which the contested trade mark is intended to be used (hotel and restaurant services), the consumer will attribute to the element 'SPA' the meaning of 'spa' (wellness centre). As a result, the presence of this word in the contested mark – moreover as a secondary element underneath the word 'VICHY' – will fulfil a merely informative purpose and will not generate any likelihood of confusion with the earlier marks 'SPA' and 'LES THERMES DE SPA', in which the same element fulfils different purposes (designating a brand of mineral water and a geographical location in Belgium, respectively).

Use of the generic word 'SPA' in the contested mark is supported by due cause (informing the public of spa facilities in restaurants and hotels) and will not take any undue advantage of the reputation of the earlier marks.

It follows that the opposition fails as regards the two earlier marks and the two relative grounds for refusal.

## 2. REFERRALS

### [22/06/2020, R 0400/2018-2, RECIOJITO / RECIOTO DI SOAVE et al.](#)

**Collective mark – Likelihood of confusion – Article 8(1)(b) EUTMR – Article 8(4) EUTMR – Article 8(5) EUTMR – No decision on opposition**

On 22 June 2020, the Second Board of Appeal decided to refer case R 0400/2018-2, RECIOJITO / RECIOTO DI SOAVE et al. to the Grand Board.

This case concerns the sensitive issue of genuine use of an earlier collective mark coinciding with a Protected Denomination of Origin for wines (inter alia, [RECIOTO DI SOAVE](#)). The decision is expected to touch upon the legal issues of scope of protection and functions of those distinct IP rights in light of the recent case-law of the Court of Justice.

### [29/06/2020, R 1719/2019-5, ANIMAL FARM](#)

### [02/07/2020, R 1922/2019-5, 1984](#)

**Descriptive – Non-distinctive – Word mark – Article 7(1)(b) EUTMR – Article 7(1)(c) EUTMR – Article 37(1) EUTMDR – No decision on application**

On 29 June 2020 and 2 July 2020, the Fifth Board of Appeal decided to refer respectively cases R 1719/2019-5, ANIMAL FARM and R 1922/2019-5, 1984 to the Grand Board.

These cases concern the assessment of whether the title of a famous and well-known book – as such – will merely be perceived as indicating the content or subject matter of books, films, games or entertainment services in Classes 9, 16, or 41, being thus descriptive and devoid of distinctive character pursuant to Article 7(1)(b) and (c) EUTMR or to the contrary that additional factors must be present in order to reach the aforesaid conclusion. The Boards of Appeal have issued diverging decisions on this issue.

### [02/07/2020, R 2248/2019-5, GEORGE ORWELL](#)

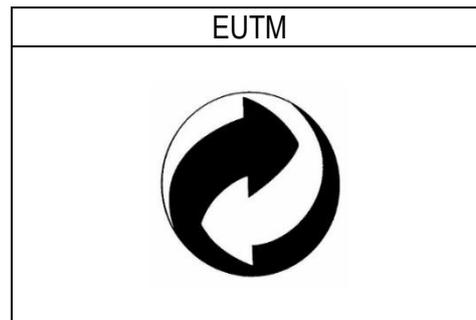
**Personal name mark – Descriptive – Non-distinctive – Word mark – Article 7(1)(b) EUTMR – Article 7(1)(c) EUTMR – No decision on application**

On 2 July 2020, the Fifth Board of Appeal decided to refer case R 2248/2019-5, GEORGE ORWELL to the Grand Board.

This case concerns the assessment of whether the name of a famous person will be merely perceived as indicating the content or subject matter of books, films, or entertainment, cultural or educational services in Classes 9, 16 or 41, being thus descriptive and devoid of distinctive character pursuant to

Article 7(1)(b) and (c) EUTMR or to the contrary that it may still serve as an indicator of the origin of those goods and services. The Boards of Appeal have issued diverging decisions on this issue.

[02/07/2020, Presidium Decision 2020-6., EIN KREIS MIT ZWEI PFEILEN \(fig.\)](#)



**Revocation action – Non-use – Collective mark – Article 18(1) EUTMR – Article 58(1)(a) EUTMR – Article 74 EUTMR**

On 2 July 2020, the Presidium of the Boards of Appeal decided to refer R 1357/2015-5, EIN KREIS MIT ZWEI PFEILEN (fig.) to the Grand Board as case number R 1304/2020-G.

This case concerns the requirements applicable for proving use of an EU collective mark. Furthermore, it concerns the link between, on the one hand, the indication of a producer's membership in an association that owns a collective mark and, on the other hand, the ensuing consumer's choice for purchasing the goods and/or services bearing the collective trade mark.

## 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)**

[27/11/2019, R166/2019-1, 3D BLACKLIGHT MINIGOLF \(fig.\)](#)



**Figurative mark – Figurative element – Non-distinctive – Article 7(1)(b) EUTMR – Decision confirmed – Application rejected**

The applicant sought to register the figurative sign '3D BLACKLIGHT MINIGOLF', covering services in Class 41 (such as golf) and Class 43 (food and beverages). The examiner found that the relevant

English-speaking consumer would immediately understand it as an indication of a black-lit 3D miniature golf. The sign was accordingly rejected as descriptive in respect of all the services applied for.

The trade mark applied for contains the English word 'BLACKLIGHT' and the internationally recognised terms '3D' and 'MINIGOLF'. A black light is mainly used for show effects, as this effect is mainly used in darkened rooms, where its radiation causes neon colors and other fluorescent substances to glow. Neither a minimum degree of interpretation by the relevant public is necessary in order to understand it, nor does it trigger a thought process. The relevant public, who has the most basic knowledge of English, will therefore recognise the meaning of the sign applied for easily and without the need for further reflection.

The statement '3D BLACKLIGHT MINIGOLF' is devoid of distinctive character with regard to all the services applied for, since it provides information about the subject or thematic content of these services and the place where they are offered. The Board notes that the applicant's statement that there are no restaurants or bars for use at minigolf courses was not proved in any way. On the contrary, as the examiner rightly indicated, it is customary for these installations to offer refreshments or snacks and the courses (§ 20).

The graphic representation of the trade mark applied for is not capable of offsetting the mark's lack of distinctive character. The figurative element of the purple golf ball merely emphasises the message of the word elements.

Consequently, the appeal is dismissed and the application is rejected.

[17/12/2019, R1866/2019-4, EASY TO CHOOSE, EASY TO USE](#)

**Word mark – Laudatory mark – Slogan mark – Non-distinctive – Article 7(1)(b) EUTMR – Decision confirmed – Application rejected**

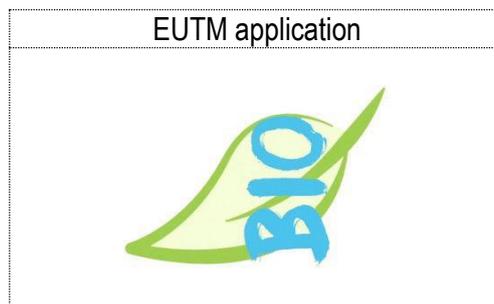
The applicant sought to register the word mark 'EASY TO CHOOSE, EASY TO USE' for goods and services in Classes 3, 35 and 44. The examiner refused the EUTM application on the basis of Article 7(1)(b) EUTMR, for all the goods and services, because the words would be perceived by the relevant public as a laudatory promotional slogan, which served as an indication of positive aspects and they would not indicate their commercial origin. The consumer would understand the sign as an option to choose from several options with no difficulty. Moreover, the examiner argued that although the words 'choose' and 'use' rhymed, this would not change the meaning of the slogan, hence, the perception of the consumer in relation to the goods and services.

The Board also finds that the mark is devoid of distinctive character as it serves as a laudatory and promotional statement rather than indicating the commercial origin of the goods and services specified, namely that they are easy to choose or use. The Board notes that the slogan applied for must be assessed as a whole. Therefore, the expression 'EASY TO CHOOSE, EASY TO USE' conveys a clear laudatory and promotional message which the relevant public will perceive first and foremost as such, rather than an indication as to their trade origin. In relation to the words which rhyme in the mark applied for, the Board cannot find any innovative or surprising element in order for the sign to be found

distinctive. Furthermore, the fact that some of the goods in Class 3 are not cosmetics bears no merit in the decision, since what matters in the case at hand is the meaning of the slogan in connection with the goods and services applied for.

Consequently, the appeal is dismissed and the application is rejected.

[17/12/2019, R1507/2019-2, BIO \(fig.\)](#)



**Figurative mark – Descriptive – Non-distinctive – Article 7(1)(b) EUTMR – IR designating the EU rejected.**

The applicant sought to register the figurative sign 'BIO' for goods in Class 3 (such as cosmetics) and 5 (inter alia, sanitary and hygienic preparations and dietetic substances). The examiner found that the relevant public, even with a high level of attention, would perceive that the sign clearly conveyed obvious and direct information about the nature and quality of the contested goods. The word 'BIO' means 'biological, organic' in English.

The Board endorses the examiner's finding that the relevant public will understand this word as conveying the message that all the contested goods consist of, or contain, biological, organic ingredients. There is a huge market for Class 3 and Class 5 goods just as those at issue, which are promoted as being natural or organic.

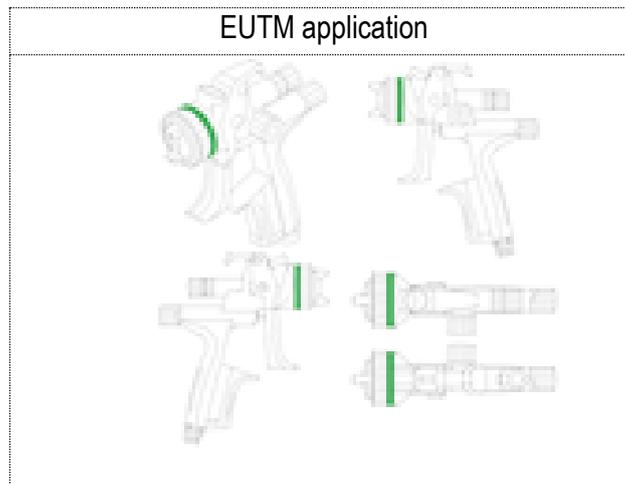
Even though the contested goods may also contain goods that do not consist or contain biological, organic ingredients, if the contested mark is descriptive or devoid of distinctive character for specific goods within the category of the goods applied for, the finding of descriptiveness or non-distinctiveness applies to the entire category.

Moreover the letters in the sign are depicted in a rather standard font. Their vertical depiction as well as the blue colour and stylisation of the word 'BIO' are rather banal. The figurative element of the mark, which depicts a green leaf (a commonplace symbol including its colour for biological/organic products) only reinforces, in the perception of the public at large and the professional public, the descriptive and non-distinctive message conveyed by the verbal element 'BIO' (10/09/2015, T-610/14, BIO organic, EU:T:2015:613, § 20).

Overall, the figurative elements used and the fact that the text is written vertically do not make the expression 'BIO' hard to read, nor do they detract from the descriptive message conveyed to relevant consumers.

Consequently, the appeal is dismissed and the protection of the IR designating EU is rejected.

**[02/03/2020, R 1161/2019-4, POSITION OF A GREEN BAND ON SPRAY PAINT GUN](#)**



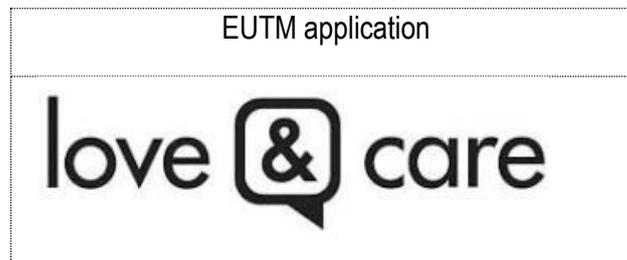
**Position mark –Non-distinctive – Decision confirmed – Application rejected**

The sign intended for 'paint spray guns' would be perceived as a banal decorative element or functioning as a connector ring rather than as an indication of commercial origin. The position mark applied for lacks distinctive character and shall be refused in accordance with Article 7(1)(b) EUTMR.

The Board considers that the sign merely combines a basic geometric shape corresponding to a band with green colour. There are no eye-catching features which may allow the relevant public to immediately perceive the contested sign as an indicator of the commercial origin of the claimed goods, even assuming a higher degree of attention of part of the relevant consumers.

In addition the 'particular' position of the sign applied for which is located at the rear part of the air cap ring in a paint spray gun and that extends around the circumference does not endow the contested sign with any distinctive character either. In fact, it could have been positioned in any other place of the spray gun with the same result, namely, that even an attentive consumer perceives this element as purely decorative or even as having a certain functionality.

[11/03/2020, R 1096/2019-1, love & care \(fig.\)](#)



**Slogan mark – Non-distinctive – Decision confirmed – Application rejected**

At the present case the sign is to be rejected because it is a banal slogan, which merely aims to promote the goods in Class 5 ‘food for infants; infants formula’ by appealing on the relevant consumer’s strongest innate feelings towards infants.

Both of the word elements ‘love’ and ‘care’ are basic English terms commonly used in trade for goods and services addressed to parents of infants, in particular in the field of infant nutrition. Indeed, they refer to the more powerful and innate feelings of a parent towards its infant.

In this sense, the sign ‘Love and care’ conveys the idea that these goods were prepared by the producer with love and care, in accordance with highest quality standards and with all the elements that a loving and caring parent would wish to provide to its infants. Moreover, in the context of commercial communications, the banal framing of the ampersand symbol ‘&’ in a dialogue box, would be at most perceived as a means to stress the importance of the second element ‘care’ of the merely promotional expression ‘love AND care’ coupled with an indication that the applicant would provide further help and advice through an online chat application.

[24/02/2020, R 1991/2019-4, Neo](#)

**Word mark – Laudatory mark – Non-distinctive – Decision Confirmed – Application rejected**

The word mark “NEO” in Classes 9 and 38 had to be rejected pursuant to Article 7(1)(b) and (c), combined with Article 7(1)(c), EUTMR on the premise that the mark was descriptive and would be perceived by Greek and Cypriot consumers as a descriptive message for the goods at hand such as “Communication equipment and Telecommunications. In relation to its descriptive meaning, the mark would necessarily be devoid of distinctive character.

The Boards confirms the contested decision. The mark applied for is the Latin transcription of the Greek word ‘neo’, in modern Greek written as ‘νεο’ or ‘νεος’. “NEO” is understood by the aforementioned consumer as something new or innovative. Furthermore, the Board notes that although the word “NEO” derives from Greek, nowadays it is understood with the meaning of ‘new’ by many more languages. Regarding the goods in Class 9, namely ‘communications equipment, communication devices e.t.c.’ the mark applied for indicates that the good are either new or innovative in terms of technology. As such,

the sign is considered descriptive. The same reasoning applies for the goods in Class 38 namely 'telecommunications, telephone and telecommunications services'. Furthermore, the Board indicates that the promotional character of the mark applied for, makes it devoid of any distinctive character on the basis of 7(1)(b) EUTMR. As a result, on the basis that the sign 'NEO' is perceived by the relevant consumer as advertising information on the positive qualities of the goods applied for, the trade mark applied for acts as a promotional message and not as an indication to commercial origin.

[08/04/2020, R 1791/2019-1, SWISS ARMED FORCES \(fig.\)](#)



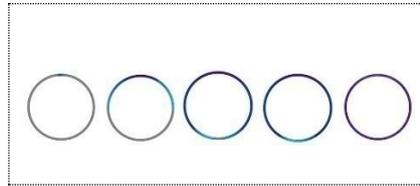
**Figurative mark – Non-distinctive – IR designating the EU – Article 7(1)(b) EUTMR – Decision confirmed – IR designating EU rejected**

The figurative mark designating the EU was refused on the basis of Article 7(1)(b) EUTMR, for goods and services in Classes 24 and 25. In the examiner's view, the shape of the sign did not differ from other similar shapes for the relevant goods but it appeared to be a variant of those. The non-existence of any unusual combination or of a striking element, resulted in the rejection of the application.

The Board confirms that the sign is devoid of distinctive character. Firstly, the word element of the sign 'SWISS armoured forces' is not clearly visible and occupies a limited position on the surface of the pattern at hand. As such, it cannot constitute an essential characteristic because of its minor impact in the sign. Secondly, the specific camouflage pattern of the sign at hand, will be understood by the relevant public as being used for aesthetic purposes and not in order to distinguish the goods and services of the undertaking from those of other undertakings. Lastly, in relation to the applicant's claim that similar marks have been granted registration by the Office and similar signs have been granted registration in other countries such as the United States and China, the Board notes, on the one hand, that it is not bound by decisions of the EUIPO's lower instances and, on the other hand, the registrability of an EU trade mark is based solely on the EU trade mark regime.

[28/04/2020, R 1636/2019-2, MOTION OF A FLOWING CIRCULAR BLUE RING \(Motion Mark\)](#)





**Motion mark – Distinctive element – Article 7(1)(b) EUTMR – Decision confirmed –Application rejected**

The applicant sought to register the sign as a motion mark consisting of a flowing circular blue ring element, claiming the colour blue. However, in light of the fact that the movement represented by the mark was unremarkable and of a banal nature, the examiner rejected the application on the basis of Article 7(1)(b) EUTMR.

The Board confirms that the sign does not contain the required level of distinctiveness in order for it to function as a trade mark. The sign applied for consists of two colours ascending synchronously, both clockwise and counter clockwise, from the 6 o'clock position up to a full circle. Firstly, the Board notes that the motion mark is treated with the same principles as a figurative mark, as basically it is a fluent sequence of two-dimensional pictures. Also, the sign is not a mere circle, since its nature refers to the flowing motion. From this perspective, the Board indicates that the motion itself, in comparison to the resulting shape, impacts only to a limited degree on the perception of the public and, at any rate, cannot be considered distinctive. Moreover, in light of the fact that most of the goods and services applied for, relate to electronic devices or software, the flowing motion of the sign does not provide the mark with distinctiveness, as similar motions in marks are immediately perceived by the public as being associated with such a function.

**[21/05/2020, R 2721/2019-4, SONIDO](#)**

**Sound mark – Non-distinctive – Article 7(1)(b) EUTMR – Decision confirmed –Application rejected**

The applicant sought to register a sound mark by submitting an MP3 file to the Office. Its sound was found to be too short and non-distinctive by the examiner who rejected the application on the basis of Article 7(1)(b) EUTMR.

[Download sound file](#)

The Board agrees with the examiner's opinion and confirms the decision. The goods specified in Classes 9, 16, 35, 41 deal with education and training. The sign applied for consists of a sequence of electronically generated (synthetic) sounds that last 2-3 seconds. It is a sequence of different tones merged within a chord, that starts with several short tones which change into a longer and louder one. The Board notes that the sound is short, has no recognisable structure and, as such, cannot be perceived by the public as an identification of origin. Moreover, regarding the scientific and technical report submitted by the applicant, the Board notes that the small number, and the young age, of the

participants on whom the report is based, cannot represent the EU's population. However, there is little scientific evidence to support the idea that the sound mark at hand when continuously associated with goods and services of the applicant (a university), such as teaching videos, could acquire distinctiveness; in other words, acquire distinctiveness through use. However, a claim based on Article 7(3) EUTMR was not submitted by the applicant, and as a result the decision is confirmed and the application is rejected.

[03/07/2020, R 2308/2019-1, YOUNGStYle \(fig.\)](#)



**Figurative Mark – Non-Distinctive – Article 7(1)(b) and (c) EUTMR – Decision confirmed – EUTM Application rejected**

The applicant sought to register the figurative mark consisting of several elements. The examiner rejected the application on the basis of Article 7(1)(b) and (c) EUTMR for goods in Classes 18, 20, 24 and 25.

The Board agrees with the examiner's conclusions and rejects the appeal. The mark consists of two words 'YOUNG' and 'STYLE' which means, in English, youthful and elegance, respectively, and thus should be assessed in relation to the English-speaking public. The Board indicates that the sign as a whole means a style specific to young people and will be related to the purpose and the characteristics of the goods, i.e. clothing and accessories for young people and thus should be considered as being descriptive. Furthermore, the Board notes that the mark emphasises the advantages of the goods since the sign 'YOUNGSTYLE' on goods such as clothing and accessories will be seen as a promotional message by relevant consumers. In relation to the graphic representation of the mark, the Board notes that the sign lacks distinctive character since the stylisation does not contain any elements that would divert the public's attention away from the non-distinctive message of the word element (paragraph 38). Consequently, the application is rejected.

**Distinctive (yes)**

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

[30/06/2020, R 1688/2019-2, Beaches Jamaica Bloody Bay](#)

**Word mark – Descriptive element – Geographical Origin – Article 7(1)(b) and (c) EUTMR – Decision partially rejected – EUTM partially accepted.**

The applicant sought to register the words 'Beaches Jamaica Bloody Bay' for several goods and

services in Classes 16, 25, 35, 36, 39, 43, 41, 44 and 45. The examiner partially rejected the application on the basis of Article 7(1)(b) and (c) EUTMR, in particular for goods and services in Classes 16, 35, 39, 41, 43, 44 and 45, as consumers would perceive the sign applied for as providing information that the goods in Class 16 and the services in Class 35 were about, or related to, Bloody Bay Beach in Jamaica. In relation to the rest of the classes applied for such as Classes 39, 41, 43, 44 and 45 the sign would be understood as an indication of the destination of the services.

The Board confirms the contested decision. The word combination 'Beaches Jamaica Bloody Bay' will be understood as the resort of Negril in Jamaica, where 'Bloody Bay' is one of the favorite Jamaican beaches. The Board notes that, for the services in Class 39 such as transport, the sign indicates the content of the services in the sense of transport to 'Bloody Bay' and hence should be counted as being descriptive. Furthermore, in relation to goods and services in Classes 31, 41, 43 and 45, the Board confirms that the sign is understood as an indication of origin within the meaning of Article 7(1)(c) EUTMR. The sign will be understood by the relevant public as descriptive in the sense of the destination of the journey, the place where the provision of the services takes place or the subject matter of advertising services or goods. Moreover, the sign conveys a positive message in relation to the goods and services applied for in order to highlight their quality and their positive aspects. Hence, the sign does not possess the required level of distinctiveness within the sense of Article 7(1)(b) EUTMR. Consequently, the decision is confirmed and the application is partially rejected.

### **Descriptive (yes)**

[08/04/2020, R 2409/2019-5, black FOREST](#)



### **Word Mark – Geographical Origin – Article 7(1)(c) EUTMR – Decision Confirmed – EUTM Cancelled**

The application for a declaration of invalidity was accepted for all the goods applied for in Class 25 (clothing). The Cancellation Division found that the relevant public would establish a link between the goods in Class 25 and the term 'black FOREST' which would be perceived as a descriptive indication of geographical origin.

The Board confirms the decision. The contested mark consists of the words 'black FOREST', which are associated with the popular region of the Black Forest in south-west Germany. Based on the documents submitted, it is a large German mountain range which extends over a wide area. The Board notes that Article 7(1)(c)EUTMR does not, in principle, preclude the registration of geographical names that are not known in the trade circles involved and that not every geographical indication acts as an indication of origin. However, it is emphasised that the relevant English-speaking public will associate the mark with the region of the Black Forest. In light of the above, after examining if the specific geographical indication could be associated with the goods applied for (clothing), the Board concludes that there is a sufficient

connection between the geographical region of the Black Forest and the goods, based on the fact that the relevant public will perceive the term 'black FOREST' as a descriptive indication of geographical origin, the decision is confirmed and the EUTM is cancelled.

[05/06/2020, R 176/2020-2, KÖLNER DOM](#)

**Word mark – Descriptive element – Article 7(1)(b) and (c) EUTMR – Decision partially rejected – EUTM partially accepted**

The applicant sought to register the sign as a word mark consisting of two German words 'KÖLNER' and 'DOM', which in English means Cologne Cathedral, an UNESCO World Heritage Site. The examiner partially rejected the application on the basis of Article 7(1)(b) and (c), in connection with Article 7(2), EUTMR. The application was rejected, among others, for goods and services in Classes 16, 19, 35, 41 and 42.

The Board partially annuls the examiner's decision for some of the goods and services in Classes 19, 41 and 42. Firstly the Board notes that Cologne Cathedral is one of the five most visited tourist attractions in Germany. For this reason, the relevant public in Germany and Austria will create a direct link to Cologne Cathedral for most of the goods and services applied for. Nevertheless, goods applied for in Class 19 'Marble; Clay', which are considered to be mineral materials, the sign will not be perceived by the public as a source of origin of the goods, as well as for the following services applied for in Class 41 'Providing nurseries, schools, boarding schools, and colleges' and in Class 42 'Land surveys; Urban planning'. For the services rejected in Class 42, the Board also notes that it is not obvious that the words 'KÖLNER DOM' will be perceived as a reference to an earlier project.

**Descriptive (no)**

[18/06/2020, R 21/2020-4, E \(fig.\)](#)



**Figurative Mark – Non – descriptive – Article 7(1)(b) and (c) EUTMR – Decision partially annulled – EUTM application accepted**

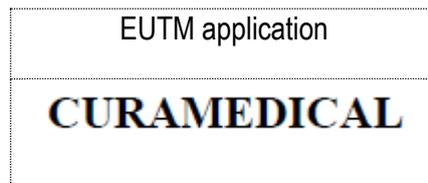
The applicant sought to register the figurative mark consisting of the letter 'E' within a circle. The examiner rejected the application on the basis of Article 7(1)(b) and (c), in connection with Article 7(2), EUTMR. The application was rejected for the services in Class 35.

The Board disagrees with the examiner's opinion and confirms that the sign can proceed to registration for all goods and services in Classes: 8, 22, 24 and 35. There is no specific 'electronic' advertising. "Advertising" is aimed at companies that want to advertise their goods and services, not at the

addressee of an advertising measure. The Board cannot see what characteristic the letter 'E' could describe in the sense that competing advertising services or business management services would not have that characteristic. If the letter "E" cannot be attributed a clear meaning relevant to the services in class 35, then the inherent distinctiveness even with a minimum degree can be retained. Furthermore, the sign applied for consists, in addition to the letter 'E', of another element, the circle in which the 'E' is located. Even if that circle is in itself a simple geometric representation which cannot be protected, the fact remains that the distinctive character of the sign applied for must be taken into account as a whole and may also result from the combination of the two elements.

Consequently, the application must also be allowed to proceed to publication pursuant to for the services applied for in Class 35.

[28/05/2020, R 2613/2019-5, Curamedical](#)



**Word Mark – Descriptive – Non-distinctive – Article 7(1)(b) EUTMR – Decision confirmed – Application rejected**

The applicant sought to register the word mark for goods and services in Classes 5, 35, 42 and 44 which were mainly connected to the pharmaceutical sector. However, in light of the fact that the relevant public would perceive the sign as providing information as regards the quality of the goods and that the elements making up the sign 'CURA' and 'MEDICAL' were descriptive, the examiner rejected the application on the basis of Article 7(1)(b) and (c) EUTMR.

The Board confirms that the sign does not contain the required level of distinctiveness in order for it to function as a trade mark. It is noted that in order for a combination of words to be regarded as descriptive under Article 7(1)(c) EUTMR, not only do each of the components have to be descriptive but also the combination itself. The Board confirms the examiner's conclusion that the word 'CURA' will be understood by Spanish, Italian and Portuguese consumers as having the meaning of 'cure' or 'therapy'. As far as word 'MEDICAL' is concerned, it will be understood as medical in the aforementioned countries of relevance. The Board confirms that as a combination the sign will be perceived as a sign providing information on the nature of the goods and services applied for. In other words, the relevant public will see it as a description of the characteristics of the goods and services applied for.

[30/06/2020, R 1688/2019-2, Beaches Jamaica Bloody Bay](#)

**Word mark – Descriptive element – Geographical Origin – Article 7(1)(b) and (c) EUTMR – Decision partially rejected – EUTM partially accepted**

The applicant sought to register the words ‘Beaches Jamaica Bloody Bay’ for several goods and services in Classes 16, 25, 35, 36, 39, 43, 41, 44 and 45. The examiner partially rejected the application on the basis of Article 7(1)(b) and (c) EUTMR, in particular for goods and services in Classes 16, 35, 39, 41, 43, 44 and 45, as consumers would perceive the sign applied for as providing information that the goods in Class 16 and the services in Class 35 were about, or related to, Bloody Bay Beach in Jamaica. In relation to the rest of the classes applied for such as Classes 39, 41, 43, 44 and 45 the sign would be understood as an indication of the destination of the services.

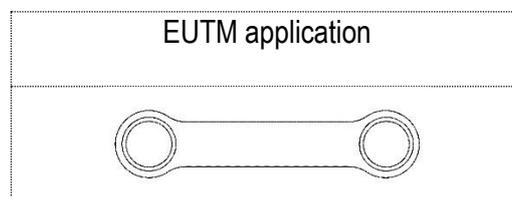
The Board confirms the contested decision. The word combination ‘Beaches Jamaica Bloody Bay’ will be understood as the resort of Negril in Jamaica, where ‘Bloody Bay’ is one of the favorite Jamaican beaches. The Board notes that, for the services in Class 39 such as transport, the sign indicates the content of the services in the sense of transport to ‘Bloody Bay’ and hence should be counted as being descriptive. Furthermore, in relation to goods and services in Classes 31, 41, 43 and 45, the Board confirms that the sign is understood as an indication of origin within the meaning of Article 7(1)(c) EUTMR. The sign will be understood by the relevant public as descriptive in the sense of the destination of the journey, the place where the provision of the services takes place or the subject matter of advertising services or goods. Moreover, the sign conveys a positive message in relation to the goods and services applied for in order to highlight their quality and their positive aspects. Hence, the sign does not possess the required level of distinctiveness within the sense of Article 7(1)(b) EUTMR. Consequently, the decision is confirmed and the application is partially rejected.

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

[no entry]

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

[16/03/2020, R 757/2019-5, DEVICE OF TWO CIRCLES WITHING AN ELONGATED BAND \(fig.\)](#)



#### **Figurative mark – Functional element – Article 7(1)(e)(ii) EUTMR – Decision confirmed – Application rejected**

The applicant sought to register the figurative mark at hand for goods and services in Class 25. The application was rejected pursuant to Article 7(1)(b), combined with Article 7(2), EUTMR on the premise that the mark was devoid of any distinctive character.

The Board endorses the examiner's opinion that the mark at hand is devoid of distinctive character. The sign applied for falls within the provision of Article 7(1)(e)(ii) EUTMR, the essential characteristics of the sign serve a technical function, specifically in the hanging of an item of clothing such as a jacket. As a result, the possibility of hanging a piece of clothing in a secure way on a hook performs a technical function of the goods at hand. Moreover, even if there are technical alternatives for relevant competitors it does not preclude the application of Article 7(1)(e)(ii) EUTMR since if such a sign were registered, there would be an impairment in relation to the goods that serve the same technical function. The fact, that the sign consists of two decorative elements i.e. the two smaller inner circles, does not alter the fact that the sign serves a technical function since those inner circles are arbitrary minor elements in the mark applied for.

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

[07/07/2020, R 2387/2019-4, SULA](#)



#### **Figurative mark – Public policy or accepted principles of morality – Article 7(1)(f) EUTMR and Article 7(2) EUTMR – Decision confirmed – Application rejected**

The applicant sought to register the figurative trade mark in the European Union for goods in Classes 29 and 32. The examiner rejected all the goods applied for on the basis of Article 7(1)(f) EUTMR.

The Board dismisses the appeal. Firstly, the Board notes that the verbal element 'SULA' is a word in Romanian and, therefore, the Romanian relevant public must be considered in order to assess the applicability of this absolute ground. The contested sign is composed of the verbal element 'SULA' and a figurative element of a red and yellow medal. The Board confirms that 'SULA' is a colloquial word which means 'male organ, penis, cock' in Romanian and declares the sign contrary to public policy and accepted principles of morality. The Board also confirms that the word 'SULA' can have two other definitions in Romanian 'tool' and 'a kind of fish', however, the word will be understood by the relevant public with the abovementioned definition.

Regarding the goods in Classes 29 and 32, even if they do not have a direct connection with a 'male organ', the Board notes that signs which are particularly offensive may be considered contrary to public policy and accepted principles of morality, without taking into consideration the contested goods.

(see also [07/07/2020, R 2388/2019-4, SULA](#))

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

**H. ARTICLE 7(1)(h) / 59(1)(a) EUTMR – ARTICLE 6<sup>TER</sup> 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**

[no entry]

**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**

## 2. GROUNDS FOR REVOCATION (ARTICLE 58 EUTMR)

[no entry]

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

[18/05/2020, R 2254/2019-1, KOROVKA \(fig.\)](#)



#### **Figurative Mark – Revocation Grounds – Article 58(1)(a) EUTMR – Decision confirmed – EUTM Partially revoked**

The application for a declaration of revocation was partially accepted for all the goods applied for, except for some goods in Class 30. After reviewing all the documents submitted by the EUTM proprietor, as regards the time of use, the place of use, the commercial volume and the nature of the use in relation to the registered goods, the Cancellation Division revoked the EUTM only partially.

The Board confirms the decision. In relation to the time of use of the registered mark, the Board notes that the evidence submitted which deals with use outside of the relevant time period, confirms the use of the mark in the relevant time period. Secondly, since the mark is an EUTM, the use of it in Germany and Bulgaria as derives from the evidence is found sufficient by the Board. In relation to the extent of use, the Board indicates that the goods under the sign 'KOROVKA' have been continuously used in Germany and Bulgaria, where they were imported and offered for sale. Moreover, the volume of sales is sufficient to establish the fact that the EUTM proprietor tried to acquire a commercial position on the market. Thirdly, it is emphasised that even if the contested mark were used in two different ways on the market 'KOPOBKA' (in Cyrillic) and 'KOROVKA' (in Latin characters), five out of the seven letters coincide and are placed in the same order. As a result, the distinctiveness of the EUTM as registered is not altered as the variation in the mark is acceptable. From a global assessment of all the relevant factors, the Board therefore concludes that the use shown by the EUTM proprietor in relation to the contested goods is sufficient to maintain or create a market share on the specific market. The revocation applicant's approach of splitting up the evidence into individual items in order to find some missing information in relation to each requirement of use remains unsuccessful. Constant case-law, as that cited above, confirms that the evidence must be assessed as a whole and that there is no obligation for the EUTM proprietor to produce individual pieces of evidence each complying with all the requirements of use. The proof of use does not require at all that each item of evidence must necessarily contain information on each of the four elements to which the proof of use must refer. In the present case, the evidence considered as a whole allows for the finding of genuine use of the mark in accordance with the requirements set out by the Regulations and the relevant case-law. Consequently, the contested

decision correctly rejected the application for a declaration of revocation for all the contested goods at issue in the appeal.

**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**

[03/03/2020, R 1115/2019-4, Bucocalma/ Mucocalm](#)

Earlier trade mark	Contested sign
<b>MUCOCALM</b>	<b>BUCOCALMA</b>

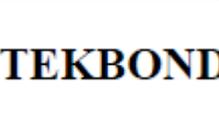
**Word Mark – Conceptual similarity – Likelihood of confusion – Decision confirmed – Opposition allowed**

The opposition based on article 8(1)(b) EUTMR was upheld in its entirety, namely for goods in Class 5, specifically pharmaceuticals, hence rejecting the applicant's trade mark application. With the exception of their first letter, the contested sign identically reproduced the earlier sign, resulting in a likelihood of confusion between the two marks.

The Board confirms the contested decision. The comparison between the two marks and the overall impression given by them, is considered from the perception of the Dutch-speaking public. Visually, the marks are similar to an average degree since, since the contested sign reproduces seven of the eight letters the earlier mark is composed of. The different starting letters and the additional last letter "A" are not sufficient outweigh the visual similarity. Phonetically, the similar length and the identical pronunciation of "UCOCALM", result in an average degree of similarity. The Board notes, that the

difference in the starting and ending letter cannot change their aural similarities. Conceptually, neither of the signs have a clear meaning. The Dutch public will only perceive the sequence “CALM(A)” in both word marks as something to “reduce pain” while “BUCO” or “MUCO” will be perceived only by the professional public in the medical field as something relating to mouth cavity. As such, the conceptual similarity between the marks is neutral. In light of the above, the Board confirms that based on the similar overall impression produced by the two signs and bearing in mind the normal inherent distinctiveness of the earlier mark, there is likelihood of confusion.

[30/03/2020, R 81/2019-4, Tekbond / TECHNOBOND \(fig.\)](#)

Earlier trade mark	Contested sign
	

**Word mark – Visual similarity – Similarity of the goods and services – Likelihood of Confusion – Article 8(1)(b) EUTMR – Decision confirmed – Opposition allowed**

The opposition based on Article 8(1)(b) EUTMR was upheld in its entirety, namely for goods in Classes 1, 16 and 17, thus, rejecting the application for the contested sign. Due to the visual and aural similarities, as well as the goods at hand, such as ‘plastic substances’, a likelihood of confusion between the two marks was established.

The Board endorses the Opposition’s Division opinion. The comparison between the two marks and the overall impression given by them, is considered from the perception of the Spanish public. The word element ‘TECHNO’ of the earlier mark is understood by the relevant public as referring to ‘technology’, while ‘BOND’ is not associated with a specific meaning. Visually, the two signs share the letters ‘TE’ and ‘BOND’, which comprise the initial and end elements of both signs. The contested sign thus includes six out of the ten letters of the earlier mark. Their differences, in the letters ‘NO’ as well as in the graphic elements and colours of the earlier trade mark, do not alter the visual similarity between the two marks. Aurally, the signs are similar to an average degree since the pronunciation of the signs only differs in the middle letters ‘NO’ which do not have the same impact as the initial and end letters of the two words. Moreover, the Board notes that the Spanish public will not associate either mark as a whole with a specific concept thus resulting in a neutral conceptual comparison between the two marks. Therefore, in light of the overall similarity between the signs and the goods at hand, a likelihood of confusion is established and the contested decision is confirmed.

[12/05/2020, R 2210/2019-5, XI FENG \(fig.\) / DEVICE OF THREE CHINESE CHARACTERS \(fig.\)](#)

Earlier trade mark	Contested sign
	

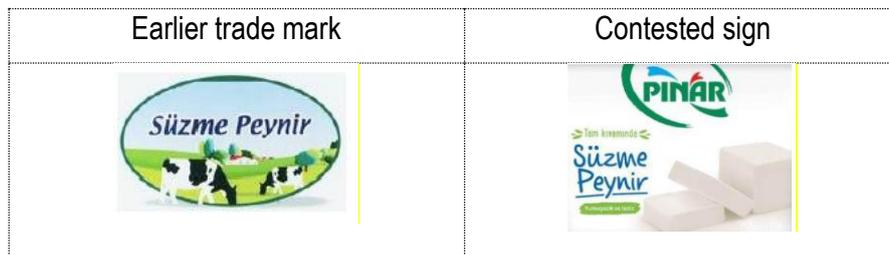
**Figurative Mark – Dominant Element – Article 8(1)(b) EUTMR – Decision annulled – EUTM cancelled**

The application for a declaration of invalidity, based on Article 60(1)(a) EUTMR, was rejected, namely for goods in Class 33 (alcoholic beverages etc.), because no likelihood of confusion was found between the two marks.

The Board notes that the contested goods must be considered identical to the earlier goods, as both lists contain similar goods such as 'alcoholic beverages'. As far as the signs are concerned, they are both figurative. The Chinese elements in both marks possess a lower than average level of distinctive character, since the relevant public will not be able to verbalise them. Hence, the Board focuses on the circular element, comprising a highly stylised phoenix, depicted in both signs. Visually, the marks are considered similar to an average degree as the circular element differs only in colour, while the first two Chinese characters of the contested sign are also present in the earlier mark. A phonetic comparison cannot be carried out since the earlier mark does not contain any word elements. The Board also notes that considering the many visual similarities, the two marks should be considered similar at least to an averagedegree. As such, due to the fact that the circular figurative element of the earlier mark is clearly depicted in the contested sign, only differing in colour, the Board cannot exclude the possibility of the relevant public perceiving the two marks as originating from the same undertaking. As a result, the decision is annulled and the EUTM is cancelled.

[02/07/2020, R 2126/2019-1, PINAR Tam kıvamında Süzme Peynir Yumusacık ve Leziz \(fig.\) / Süzme Peynir \(fig.\)](#)

**Figurative Mark – Common element – Similarity of the signs – Likelihood of confusion – Article 8(1)(b) EUTMR – Decision confirmed – IR designating the EU rejected – Opposition allowed**



The applicant sought to register the figurative mark 'PINAR' for goods in Class 29 such as butter, yoghurt and dairy products. The Opposition Division rejected the IR designating the European Union on the basis of Article 8(1)(b) EUTMR.

The Board dismisses the appeal. The two signs coincide in the word element 'Süzme Peynir' and differ as regards the rest. However, the figurative elements in both signs are descriptive or secondary in nature and therefore do not affect the visual comparison. As such, the signs are similar at least to a below average degree visually. Aurally, the sound of the words 'Süzme Peynir' are the same while the extra words 'Tam kıvamında' and 'Yumusacık ve Leziz' are not likely to be pronounced and do not impact on the aural comparison. Therefore, the signs are aurally similar to an average degree. Conceptually, the Board notes that the two marks convey two different concepts. The earlier mark presents the concept of a farm while the contested sign contains a concept of a block of white cheese. The fact that these concepts cannot indicate commercial origin as well as their differences, makes the marks conceptually dissimilar. The Board concludes that the signs are similar overall from the perspective of a substantial part of the relevant public. Furthermore, the Board indicates that the similarities primarily result from the fact the most distinctive element of the earlier mark is entirely reproduced in the contested sign. The different concepts depicted in the signs do not impact on the comparison, and hence they cannot counterbalance the aural and visual similarities. Consequently, the Opposition Division correctly took the view that a likelihood of confusion between the marks could not be excluded and upheld the opposition on the grounds of Article 8(1)(b) EUTMR for all of the contested goods.

**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**

[17/04/2020, R 1132/2019-4, Champagnola / Champagne](#)

Earlier protected sign	Contested sign
<b>CHAMPAGNE</b>	<b>Champagnola</b>

**Word mark – Geographical origin – Article 8(6) EUTMR – Decision annulled – Opposition allowed**

The opposition based on Article 8(6) EUTMR, in conjunction with various provisions of other EU Regulations relating to the ‘Protected Designation of Origin’ (PDO) and French law, for goods in Classes 30 and 40 was rejected. The Opposition Division found that the contested goods which were ‘foodstuffs’ or related to ‘foodstuffs’ could not be compared to the earlier mark’s goods which were ‘wines’ because of their different natures. Moreover, the fact that the two marks coincided in the letters ‘Champagn(...)’ was considered insufficient in order to establish the connection between the contested goods and services with the protected product ‘wine coming from the Champagne region’.

The Board disagrees with the contested decision. Regulation No 1308/2013 provides protection against identical use or evocation either against comparable products or against other goods and services, only if the contested sign ‘exploits the reputation of the PDO’. The essential function of a geographical indication is to protect the geographical name against products that do not have the specific geographical origin. Furthermore, the contested sign begins with ‘Champagn’ and can be seen as a derivative form of the word ‘Champagne’. This would fall under the concept of ‘evocation’ in the sense that use of the term ‘Champagn’ is used in order for the consumer to make the connection with the specific geographical designation. The evocation principle should be assessed for both comparable and different goods. Even though, the contested goods are mainly breakfast food items they can all be consumed with sparkling wine in order for them to taste better, and will be associated as such by the relevant consumer. On the basis of the aforementioned, the Board concludes that since the exploitation of the reputation of ‘Champagne’ is evident as regards the contested sign, it annuls the contested decision and upholds the opposition.

**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]

[11/03/2020, R 1364/2019-2, Ism ATEX INERIS EX Installation Service Maintenance \(fig.\)](#)



**Certification mark – Decision confirmed – Application rejected**

The Board confirms that refusal of the EU certification mark since the deficiencies of the regulations governing use of the mark have not been remedied. The information to be mentioned in the regulations of use required by Article 17 EUTMIR is compulsory.

Unlike the Examiner, the Board finds that the representation of the mark in colour and in black and white in the Annex of the regulation of use, indicating how the mark should be used in commerce, is not contrary to Article 17(c) EUTMIR. However, the Board confirms that the conditions required by Article 17(d), (e), (f), (g) EUTMIR are not fulfilled. In particular, as to the characteristics of the services to be certified, the fact that the applicant certifies that the services offered in Class 37 are done by persons trained and certified by the applicant itself does not guarantee the objective quality of the services. As to the evaluation, training and audit services applied for, the certification mark is contrary to Article 83(2) EUTMR.

[26/05/2020, R 156/2020-2, Plus screen / PLUSSCREEN \(fig.\) et al.](#)

Earlier trade marks	Contested sign
 <b>PLUSCREEN</b>	<p><b>Plus Screen</b></p>

**Descriptive – Non-distinctive – Article 31(2) EUTMR – Case suspended**

The applicant sought to register the word mark 'Plus Screen' for 'smartphones; display for smartphones; cellular phones, wearable smartphones' in Class 9. The Opposition Division rejected the opposition in its entirety.

The Boards of Appeal, in opposition proceedings, do not have the competence to examine absolute grounds for refusal. However, pursuant to Article 45(3) EUTMR, in conjunction with Article 30(2) EUTMDR, they may, by means of a reasoned interim decision, suspend the appeal proceedings and remit the contested application to the examiner competent for examining that application with a recommendation to reopen the examination, where it considers that an absolute ground for refusal should apply to some or all of the goods or services listed in the trade mark application.

In the present case, the Board indicates that it is appropriate to recommend a reopening of the examination of absolute grounds for refusal of the trade mark applied for. The mark applied for consists of the word 'Plus' followed by the word 'screen'. 'Plus' as an adjective means 'additional, extra; more than what is normally required or expected' or 'of a superior quality or class; excellent of its kind, elite' as also confirmed in various judgments of the General Court and decisions of the Boards that defined 'PLUS' as 'additional, extra, of superior quality, excellent of its kind'. The word 'PLUS' constitutes a laudatory statement and indicates that the goods are of a particularly good quality or have additional useful characteristics. It is a sign which, as a pure indication of quality, is both descriptive and also devoid of any distinctive character. A 'screen' is a flat vertical surface on which pictures or words are shown. It refers to any contrivance for 'affording an upright surface for display'. The goods covered by the mark applied for, that is 'smartphones; cellular phones, wearable smartphones' have a screen. In addition, a 'display for smartphones' is a screen. The sign 'Plus screen', as a whole, will be understood according to the natural meaning of its component parts, as referring to a screen which is of particularly good quality or has additional useful characteristics. For the English-speaking public, there is nothing unusual about the structure of the mark applied for. The combination of words simply indicates that the applicant's smartphones, etc., have a 'better screen'. No analysis or mental leap is required to ascertain the possible meaning of the expression, taken as a whole. Consequently, it seems that the mark applied for may fall within the scope of the grounds for refusal set out in Article 7(1)(b) and (c) EUTMR in relation to all of the goods for which registration is sought.

The appeal proceedings are suspended and the case is remitted to the examiner for further consideration regarding the registrability of the contested EUTM application.

[12/06/2020, R 2674/2019-5, Arctic Wines / Artic \(fig.\) et al.](#)

Earlier trade marks	Contested sign
	<p data-bbox="903 613 1062 645">Arctic Wines</p>

**Figurative mark – Deceptive element – Descriptive element – Non-distinctive – Article 31(2) EUTMR – Case suspended**

The applicant sought to register the word mark ‘Arctic Wines’ for beverages in Classes 32 and 33. The Opposition Division partially upheld the opposition on the grounds that there was a likelihood of confusion, on the basis of the earlier rights, namely for beer in Class 32 and alcoholic beverages and cider in Class 33.

The Boards of Appeal, in opposition proceedings, do not have the competence to examine absolute grounds for refusal. However, pursuant to Article 45(3) EUTMR, in conjunction with Article 30(2) EUTMDR, they may, by means of a reasoned interim decision, suspend the appeal proceedings and remit the contested application to the examiner competent for examining that application with a recommendation to reopen the examination, where it considers that an absolute ground for refusal should apply to some or all of the goods or services listed in the trade mark application.

In the present case, the Board has serious doubts about the registrability of the contested word mark for all the goods that have been applied for. It is a well-known fact that there is no wine production in the Arctic area, however it is not excluded, as the scientific community has pointed out, that with climate change rapidly heating and bringing warm air to this region in the future there could be vineyards planted and producing wine in the Arctic regions. Therefore in relation to the goods in Class 33, ‘Alcoholic beverages (except beer); Preparations for making alcoholic beverages’, the mark could be considered descriptive of a geographical origin, and therefore could be prevented from being registered on the basis of Article 7(1)(c) EUTMR.

Moreover, the word ‘wines’ for goods such as those in Class 32, ‘Soft drinks; Preparations for making beverages; Beer and brewery products; Waters; Alcohol free wine’; or ‘cider’ in Class 33, could be considered misleading as it gives a wrong message about the type and nature of the product. The Board is of the opinion that the sign applied for could also be barred from registration on the basis of Article 7(1)(g) EUTMR.

The appeal proceedings are suspended and the case is remitted to the examiner for further consideration regarding the registrability of the contested EUTM application.

## IV. DESIGNS

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

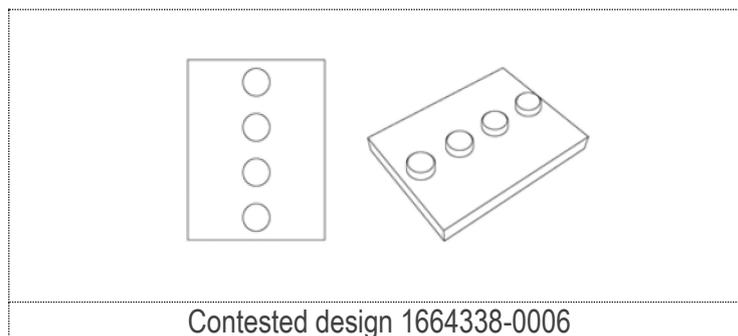
[no entry]

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

[no entry]

### C. OTHER ISSUES

[10/04/2020, R 31/2018-3, Building blocks from a toy building set](#)



#### Technical function of the design – Article 8(1) CDR – Decision annulled – RCD invalidated

The Design Division rejected the application for a declaration of invalidity as unfounded. It was noted that the features of the appearance of the RCD, such as the shape of the block showed the creativity of the designer.

The Board does not endorse the contested decision. In the present case the appointment of an expert is not necessary because the technical information that the expert would provide is already known by both parties and the Board. The applicability of Article 8(1) CDR is based on several factors, specifically (i) the identification of the product in which the design is incorporated, (ii) its technical function, (iii) the features of the appearance of the product, (iv) determine that considerations other than the need for that product to fulfil its technical function. Firstly, the product 'building block from a toy building set' clearly identifies the product i.e. a brick and shows its purpose, which is to build objects with those bricks. Secondly, the technical function that must be fulfilled is the capability of the bricks to be assembled with each other in order to form a larger toy building. Thirdly, all the features of the appearance of the contested RCD such as the row of studs on the upper face of the brick or the thickness of the wall of the brick are solely dictated by the technical function of the brick, which is to assemble and disassemble them from the rest of the bricks of the set. As a result, the contested decision

is annulled and the contested design is declared invalid.

[11/03/2020, R 437/2019-3, Heating boilers\(part of - \)](#)



**Complementary evidence – Conflict of design with prior design – Overall impression**

The evidence produced on appeal was taken into consideration. The international registration designating the EU is a prior design in the sense of Article 25(1)(d)(iii)CDR. The conflicting designs are identical in all aspects and thus produce the same overall impression.