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OVERVIEW OF GC/CJ CASE-LAW 2016

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The Legal Practice Service of the International Cooperation and Legal Affairs Department prepares a yearly overview of the General Court (GC)/Court of Justice (CJ) case-law as regards trade mark and design matters. The judgments and orders are arranged in categories to be browsed more easily according to their content.

This overview includes judgments, preliminary rulings and important orders rendered by the GC and the CJ.

Cases in which the GC or CJ have decided differently from the EUIPO are indicated by the symbol ♦ before the case number.

Cases which are cited in more than one category in the present report are indicated by the symbol ♦ before the case number.

While the annual summary is published after the entry into force of the Amending Regulation (EU) 2015/2424 in March 2016, all of the summaries and citations that were compiled during the first months of 2016 (prior to 23/03/2016) are cited in this compilation using 'OHIM' in the case-law reference. As from 23/03/2016 the new name, EUIPO, is used. For all cases, the new terminology such as an EUTM application or registration is used (instead of the previous CTM application or registration), and the legal texts will always be referred to as EUTMR and EUTMIR respectively.

Preliminary Rulings are integrated alongside the judgments. References to the EUTMR in the chapter headings should be read as extending to the equivalent rules in Directive 2008/95/EC (TMD), where they exist.

Each reference to a case contains an abstract of the relevant issues together with an indication of the language of the proceedings. For internal users (EUIPO staff) the original and its available translations can be accessed by CTRL + click on the respective case number. For external users, or more detailed information, please see the GC/CJ Database, which can be accessed online at <http://curia.europa.eu/> which contains keywords, relevant legal norms, facts in brief and headnotes of each judgment, including the official translations or the eSearch Case Law database, which can be accessed online at <https://euipo.europa.eu/eSearchCLW/>.

Please note that the document does not necessarily reproduce the exact wording of the judgments, preliminary rulings or orders.



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I. Procedural Matters

A. Procedures before the GC/CJ

1. Admissibility

1.1 Right to appeal, form, deadline

[C-500/15 P](#); **TVR ITALIA / TVR et al.**; Order of 14 January 2016; *TVR Italia Srl v OHIM*; Language of the case: EN.

EUTM application	Earlier mark
	TVR

An appeal drafted in Italian against a judgment of the GC in English. Pursuant to Article 37(2)(a) of the Rules of Procedure of the Court of Justice (RPCJ), the language of the proceedings is the language of the judgment of the GC under appeal. The language of the proceedings before the GC was English. The appeal was filed in Italian without a translation into English. The appellant stated that it chose Italian as language of the proceedings. Although Article 37(1)(b) and (c) of the RPCJ allows a party to ask for the language of the proceedings to be changed, having heard the other parties and the Advocate General, the appellant did not file such a request. Filing an appeal in a language other than the language of the proceedings cannot be put in order pursuant to Article 168(4) RPCJ. The appeal is manifestly inadmissible.

♦ [T-711/13](#) and [T-716/13](#) (joined cases); **HARRY'S BAR** and **PUB CASINO Harrys RESTAURANG et al.**; Judgments of 18 February 2016; *Harrys Pubar AB v OHIM* and *Harry's New York Bar SA v OHIM*; Language of the cases: EN. The EUTM applicant sought to register the word mark **HARRY'S BAR** as an EUTM for goods and services in Classes 25, 29, 30, 32, 33 and 43. The opponent filed an opposition, inter alia, on the grounds of Article 8(1)(b) EUTMR for those goods and services based on, inter alia, the earlier Swedish figurative EUTM, **PUB CASINO Harrys RESTAURANG**, registered for goods and services in Classes 29 and 42. The Opposition Division (OD) upheld the opposition for all the goods and services in Classes 25, 32, 33, 43 and for part of the goods in Classes 29 and 30. The EUTM applicant filed an appeal seeking for the annulment of the decision of the OD insofar as it upheld the opposition. The opponent filed an appeal for the annulment of the same decision insofar as it rejected the opposition. The Board of Appeal (BoA) partially upheld the EUTM applicant's appeal and dismissed the opponent's appeal in its entirety. As a result, registration was refused for all the goods and services in Classes 25, 33 and 43 and was allowed for part of the goods in Classes 29 and 32 and for all the goods in Class 30. Both the EUTM applicant and the opponent filed an application before the GC for the annulment of the decision of the BoA. A claim was submitted for the first time before the GC, which constitutes a new argument and which was not submitted in the appeal before the Office. The EUTM applicant's claim that the requirement of clarity and precision for describing the earlier mark's goods was not fulfilled was dismissed as inadmissible since it had been submitted for the first time before the GC (paras 29 to 32).



♦ [T-84/14](#) and [T-97/14](#) (joined cases); **HARRY'S NEW YORK BAR / PUB CASINO Harrys RESTAURANG et al.**; Judgments of 18 February 2016; *Harrys Pubar AB v OHIM* and *Harry's New York Bar SA v OHIM*; Language of the cases: EN. The EUTM applicant sought to register the word mark **HARRY'S NEW YORK BAR** as an EUTM for goods and services in Classes 25, 30, 32 and 43. The opponent filed an opposition, inter alia, on the grounds of Article 8(1)(b) EUTMR for those goods and services based on, inter alia, the earlier Swedish figurative EUTM, **PUB CASINO Harrys RESTAURANG**, registered for goods and services in Classes 29 and 42. The OD upheld the opposition for all the goods and services in Classes 25, 32, 43 and for part of the goods in Class 30. The EUTM applicant filed an appeal seeking for the annulment of the decision of the OD insofar as it upheld the opposition. The opponent filed an appeal for the annulment of the same decision insofar as it rejected the opposition. The BoA partially upheld the EUTM applicant's appeal and dismissed the opponent's appeal in its entirety. As a result, registration was refused for all the goods and services in Classes 25 and 43 and was allowed for all the goods in Class 30 and 32 (with the exception of 'beers' in Class 32). Both the EUTM applicant and the opponent filed an application before the GC for the annulment of the decision of the BoA. A claim was submitted for the first time before the GC, which constitutes a new argument and which was not submitted in the appeal before the Office. The EUTM applicant's claim that the requirement of clarity and precision for describing the earlier mark's goods was not fulfilled was dismissed as inadmissible since it had been submitted for the first time before the GC (paras 30 to 33).

♦ [T-805/14](#); **MEGABUS.COM**; Order of 25 May 2016; *Stagecoach Group plc v EUIPO*; Language of the case: EN. The EUTM applicant sought to register the word mark **MEGABUS.COM** for goods and services in, inter alia, Classes 16, 35 and 39. The examiner rejected the application for all the goods and the services mentioned on the basis of Article 7(1)(b) and (c) EUTMR. The BoA dismissed the appeal. The applicant filed an application before the GC for the annulment of the decision of the BoA. In support of its action, the applicant relies, in essence, on four pleas in law, alleging: (i) infringement of Article 7(1)(c) EUTMR; (ii) infringement of Article 7(1)(b) EUTMR; (iii) infringement of Article 75 EUTMR; and (iv) infringement of Article 7(3) EUTMR. The GC found that the second, third and fourth pleas in law raised by the applicant were manifestly inadmissible on the ground that they are devoid of clarity and consistency and that, consequently, they do not meet the minimum requirements of Article 44(1)(c) of the Rules of Procedure of the General Court (RPGC) (paras 16 to 22).

♦ [C-309/15 P](#); **real,- / Real mark et al.**; Order of 8 September 2016; *Real Express SRL v EUIPO — MIP METRO Group Intellectual Property GmbH & Co. KG*; Language of the case: EN.

EUTM application	Earlier marks
	

The applicant sought to register the figurative mark **real,-** represented above as an EUTM for goods and services, amongst others, in Classes 3 and 35. An opposition based on the earlier



figurative marks **Real mark** and **Real lichid** represented above, registered for goods and services in Classes 3 and 35, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition as unfounded. The BoA dismissed the opponent’s appeal. The opponent filed an action before the GC who dismissed the appellant’s action as partly inadmissible (for lack of clarity and coherence and therefore for failure to satisfy the minimum requirements of Article 44(1)(c) RPGC (1991)) and as partly manifestly unfounded. The opponent filed an action before the Court of Justice of the European Union (CJEU) requesting the annulment of the GC’s order claiming, in substance, an erroneous application of Article 44(1)(c) RPGC, a violation of the duty to state reasons, violations of Rule 15(2)(h)(iii), Rule 17(1) and (4) and Rules 19 and 20 EUTMIR as well as of the principle of legal certainty. The CJ dismissed the first plea (violation of Article 44(1)(c) RPGC (1991)) as partly inadmissible and partly manifestly unfounded. It found that appellant failed to identify clearly and coherently the arguments, which the GC allegedly had incorrectly rejected as inadmissible.

♦[C-482/15 P](#); **bambinoLÜK / BAMBINO**; Judgment of 26 October 2016; *Westermann Lernspielverlage GmbH v EUIPO*; Language of the case: EN.

EUTM application	Earlier marks
	

The EUTM applicant sought to register the figurative sign **bambinoLÜK** for goods in Classes 9, 16 and 28. An opposition based, among others, on an earlier figurative EUTM **BAMBINO**, covering goods and services in Classes 16, 28 and 41, was filed on the grounds of Article 8(1)(b) EUTMR. The OD upheld the opposition for some goods and services. The BoA partially upheld the appeal. The opponent brought an action before the GC, alleging infringement of Article 8(1)(b) EUTMR because of (i) the lack of distinctive character of the word element ‘bambino’ of the earlier trade mark, (ii) the lack of similarity between the signs at issue and (iii) the absence of a likelihood of confusion (LOC). The GC dismissed the action. The applicant filed an appeal before the CJEU on the basis of two grounds: (i) breach of the right to be heard and the right to a fair trial and (ii) the infringement of Article 8(1)(b) EUTMR. The CJ dismissed the appeal. Regarding the first plea, as to the alleged breach of the right of property, the CJ found it inadmissible because it was raised for the first time at the reply stage. Furthermore, the CJ found ineffective the applicant’s arguments related to the breach of the right to be heard and the right to a fair trial because the GC was not required, in its review of the legality of the decision, to take in consideration the Office’s decision revoking an earlier mark, as the revocation took effect after the adoption of the BoA’s decision and could not affect its legality.

♦♦[T-735/15](#); **SHOP ART / art**; Judgment of 6 December 2016; *The Art Company B & S, SA v EUIPO*; Language of the case: EN. The applicant sought to register the figurative mark **SHOP★ART** as an EUTM for goods in Classes 18 and 25. An opposition based on, inter alia, the earlier figurative mark ***art**, registered for goods and services in Classes 18, 25 and 35, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition for all of the contested goods. The BoA upheld the applicant’s appeal. It found that, in view of the importance of the visual appearance of the marks at issue, and of the facts that the relevant public had a normal degree of attentiveness and that the distinctive and dominant element of the earlier mark lay in the high degree of stylisation of the letters, there was no likelihood of confusion, even if the goods in question were identical. The opponent filed an action before



the GC relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC upheld the appeal. It found that the BoA had erred in concluding that there was no likelihood of confusion on the part of the relevant public. **As regards the statement of intervention:** although the change of ownership had entered in the EUIPO register and the GC was informed accordingly, the GC considered that the statement of intervention had been filed by the previous owner only, since the application for substitution of the intervening party had not been made by way of a separate document (paras 13 to 14).

1.2 Claims

1.2.1 Claims to issue directions to EUIPO

[no entry]

1.2.2 Claims to change an EUIPO decision

♦[T-674/13](#); **GUGLER**; Judgment of 28 January 2016; *Gugler France v OHIM*; Language of the case: EN. The EUTM proprietor was granted the registration of the figurative mark **GUGLER** as an EUTM for goods and services in Classes 6, 17, 19, 22, 37, 39, 42. An application for invalidity was filed pursuant to Article 52(1)(b), and to Article 53(1)(c) in conjunction with Article 8(4) EUTMR. The CD upheld the application for invalidity. The BoA upheld the EUTM proprietor’s appeal. The invalidity applicant filed an action before the GC relying on two pleas in law: (i) infringement of Article 53(1)(c), read in conjunction with Article 8(4) EUTMR (ii) infringement of Article 52(1)(b) EUTMR. The GC upheld the appeal. **On the request to alter the contested decision:** the GC is not in a position to determine, on the basis of the matters of fact and of law examined by the BoA, what decision the BoA was required to take and cannot therefore exercise its power to alter decisions (paras 95 to 105).

[T-295/15](#); **Anna Smith / SMITH**; Order of 18 April 2016; *Yongyu Zhang v EUIPO*; Language of the case: DE.

EUTM application	Earlier mark
Anna Smith	SMITH

The applicant sought to register the word mark **Anna Smith** for goods within Classes 18 and 25. An opposition based on the earlier trade mark, **SMITH**, registered for goods in Classes 18 and 25, was filed on the grounds of Article 8(1)(b) EUTMR. The OD rejected the opposition. The BoA annulled the decision, upholding the opposition. The applicant filed an action before the GC. The GC rejected the action. The action is rejected under Article 126 of the RPGC. The applicant’s request that the GC accepts its application is evidently inadmissible since the GC cannot give orders to the Office (para. 15). When assessing the similarity between names, the same criteria as for other categories of marks apply (para. 20). Therefore, the fact that the earlier mark is identically contained in the EUTM application indicates that the signs are similar (para. 21). The applicant’s argument that in the fashion sector a minor difference such as an additional first name may exclude a likelihood of confusion is ineffective because trade marks are often derived from the same family name in



said sector (para. 26 to 27). The applicant cannot contest the genuine use of the earlier mark before the GC in the absence of timely request on its part before the OD. Moreover, the earlier mark was not registered for more than 5 years at the relevant point in time (paras 31 to 33). The appeal is dismissed, partly as manifestly inadmissible, and partly lacking any foundation in law.

♦[C-226/15 P](#); **ENGLISH PINK / PINK LADY et al.**; Judgment of 21 July 2016; *Apple and Pear Australia, Star Fruits Diffusion v EUIPO*; Language of the case: FR.

EUTM application	Earlier mark
ENGLISH PINK	PINK LADY

The applicant sought to register the word mark **ENGLISH PINK** as an EUTM for goods in Class 31. An opposition based on the earlier word mark **PINK LADY**, and other figurative marks, all registered for goods in Class 31, was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The OD dismissed the opposition. The opponent appealed this decision. One year before adopting the contested decision, the BoA was notified of a final judgment of the Belgian EUTM Court —*Tribunal de Commerce de Bruxelles* (TCB) — cancelling the Benelux mark **ENGLISH PINK** (which had been applied for at the same time as the identical contested **ENGLISH PINK** EUTM) because of likelihood of confusion with the earlier trade mark registration for the word mark **PINK LADY** and earlier Benelux trade marks. The TCB found that the Benelux mark **ENGLISH PINK** infringes the **PINK LADY** marks (both EUTMs and Benelux marks) and prohibited the other party from using the sign **PINK LADY** within the EU. The TCB ruled that the **PINK LADY** trade marks enjoy a high degree of protection and that there is a significant likelihood of confusion between **PINK LADY** and **ENGLISH PINK**. The BoA transmitted the judgment and its translation to the other party, but the contested decision did not even mention it in the summary of the facts. The BoA dismissed the opponent’s appeal, thereby taking the opposite view to the TCB: no enhanced distinctiveness, no Article 8(5) EUTMR, no likelihood of confusion. The opponent filed an action before the GC relying on seven pleas in law. The GC annulled the BoA’s decision based on the first plea, because it had not taken account of the judgment of the TCB and had not assessed the potential impact that that judgment could have on the outcome of the opposition proceedings. The GC rejected the action as to the remainder. The opponent filed an action before the CJEU raising three grounds of appeal: (i) alleged infringement of the principle of *res judicata*; (ii) alleged infringement of the general principles of legal certainty, sound administration and the protection of legitimate expectations; (iii) alleged infringement of the GC of Article 65(3) EUTMR by refusing to alter the contested decision. The CJ dismissed the third ground of appeal as unfounded, as the GC had noted in para. 56 of the judgment under appeal (T-378/13) that its power to alter decisions does not have the effect of conferring on it the power to substitute its own assessment for that of a BoA, or of carrying out an assessment on which that BoA has not yet adopted a position.

♦[T-250/15](#); **CLAN / CLAN MACGREGOR**; Judgment of 24 November 2016; *Speciality Drinks Ltd v EUIPO*; Language of the case: EN. The EUTM applicant sought to register the word mark **CLAN** for goods in Class 33. An opposition based, inter alia, on the earlier word mark **CLAN MACGREGOR**, registered for goods in Class 33 was filed on the grounds of Article 8(1)(b) EUTMR. The OD dismissed the opposition: genuine use of the aforesaid earlier mark was proven for ‘Scotch whisky’ and there was a likelihood of confusion between



the marks at issue. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC raising one plea in law, namely breach of Article 8(1)(b) EUTMR, claiming firstly that the contested decision should be annulled and, secondly, that the opposition should be rejected. The GC dismissed the appeal. **The claim for alteration:** no grounds for annulment or alteration as set out in Article 65(2) EUTMR have been found in the course of the examination of the application for annulment made by the applicant, and this claim is therefore rejected.

♦[T-745/15](#); **YO! / YO**; Judgment of 14 December 2016; *Scorpio Poland v EUIPO*; Language of the case: PL. The applicant sought to register the figurative sign YO! as an EUTM for goods and services in Class 25. An opposition based on the earlier German word mark YO, registered for goods and services in Class 25, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition in its entirety. The opponent filed an appeal. The BoA upheld the opponent's appeal. It found that both signs would be perceived by a large part of the German-speaking public as consisting of the verbal element 'YO'. The signs were therefore aurally identical and visually similar to a low or average degree. Since none of the signs had a meaning, the signs were neither similar nor identical conceptually. The goods were identical. Considering the above BoA found that there was a likelihood of confusion between the signs. The applicant filed an action before the GC relying on a single plea in law: an infringement of Article 8(1)(b) EUTMR. The application sought, inter alia, to have the decision of BoA altered and EUTM application registered. The GC found the latter claim to be inadmissible. As to the remaining claim the GC dismissed the appeal. It found that there was a likelihood of confusion between the signs at issue. **The claim for alteration of the Office decision:** as to applicant's plea to alter the Office decision and allow the registration of the EUTM application, the GC found it inadmissible, it explained the meaning of Article 65(3) EUTMR and referred to the relevant case-law (para. 14).

1.2.3 *Claim by applicant to confirm decision*

[no entry]

1.2.4 *Claim in excess of what is appealable*

[no entry]

1.2.5 *Clarification of claim by applicant*

[no entry]

1.2.6 *Interpretation of claim by Court*

♦[T-301/15](#); **Du bist, was du erlebst.**; Judgment of 31 May 2016; *Jochen Schweizer GmbH v EUIPO*; Language of the case: DE. ADMISSIBILITY: even though the appeal addresses an infringement of Article 7(1)(c) EUTMR, it is clear from the writ's further reasoning that indeed the appeal claims an infringement of Article 7(1)(b) EUTMR. Therefore Article 44(1)(c) RPGC is complied with and the appeal is admissible.

♦♦[T-742/14](#); **CALCILITE**; Judgment of 19 July 2016; *Alpha Calcit Füllstoffgesellschaft mbH v EUIPO*; Language of the case: EN. The EUTM proprietor was granted the registration of the



figurative mark **CALCILITE** as an EUTM for goods in Classes 2 and 19. An application for invalidity was filed pursuant to Article 53(1)(a) EUTMR in conjunction with, inter alia, Article 8(1)(b) EUTMR. The CD dismissed the application for invalidity as it considered that the goods at issue were dissimilar. The BoA dismissed the invalidity applicant's appeal. It found that the opponent's goods for which genuine use had been proven (*crystalline calcium carbonate filler* (CCCF)) were not similar to the contested goods. The invalidity applicant filed an action before the GC relying on a single plea in law: infringement of Article 53(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR. The GC partly upheld the appeal. **Clarification of the scope of the action:** the GC clarifies the scope of the appeal before it since part of the BoA's findings were not contested (paras 33 to 36) and points out that the applicant's arguments suggesting the earlier trade mark is reputed are inadmissible, as the subject matter of the proceedings before the BoA may not be changed (paras 37 to 39).

♦[T-400/15](#); **CITRUS SATURDAY / CITRUS**; Judgment of 28 September 2016; *Ana Isabel Pinto Eliseu Baptista Lopes Canhoto v EUIPO*; Language of the case: EN. The applicant sought to register the word mark **CITRUS SATURDAY** as an EUTM for goods in, inter alia, Class 25. An opposition based on the earlier word mark **CITRUS** registered for goods in Class 25, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition as unsubstantiated as the opponent had not submitted a translation of the certificate of registration of the earlier mark into the language of the proceedings within the period prescribed for that purpose. The translation reached the Office on 21 May 2014 although the time limit expired on 12 May 2014. The BoA dismissed the opponent's appeal. It found that the OD had correctly rejected the opposition as unfounded pursuant to Rule 20(1) EUTMR. The opponent filed an action before the GC relying on two pleas in law: (i) infringement of Rules 19 and 20 EUTMR and of Article 76 EUTMR and (ii) infringement of Article 21, Article 41(1) and Article 47 of the Charter of Fundamental Rights of the European Union and of Article 18 TFEU. Regarding the **infringement of Article 21, Article 41(1) and Article 47 of the Charter of Fundamental Rights and of Article 18 TFEU**: the GC interpreted the opponent's submission under this plea to be, in essence, first, that the BoA disregarded her right to an effective remedy and a fair hearing and, second, that the Office infringed the principle of non-discrimination on grounds of nationality (para. 44). First of all, the GC emphasised that the Court has excluded the possibility of relying on the right to a fair 'trial' in proceedings before the BoAs of the Office, since proceedings before the BoAs are administrative and not judicial in nature. Next, regarding the right to an effective remedy, the OD's decision may be either revoked under the conditions laid down in Article 80 EUTMR or annulled in the context of an appeal brought under Article 58 EUTMR. Thus, it is evident that the opponent's right to an effective remedy is protected (paras 48 to 50). Regarding discrimination on grounds of nationality, the Office rejected the opposition purely on the ground that the documents had been submitted late. As that fact is entirely unrelated to the opponent's nationality or her place of establishment, The Office cannot be accused of having treated the opponent differently on the basis of her nationality (para. 51). In any event, it should be borne in mind that the opponent also had the possibility of sending the Office the proof in question by personal delivery, by fax or by any other means, including electronically, so that an alleged discrimination on grounds of nationality, connected with the delivery times for communications sent by post, is excluded (para. 52).

♦[T-769/15](#); **Dolokorn / DOLOPUR**; Judgment of 24 November 2016; *SeNaPro GmbH v EUIPO*; Language of the case: DE. The applicant sought to register the word mark **Dolokorn** as an EUTM for goods in Class 1, among which *manures; fertilisers for soil and Inorganic fertilisers*. An opposition based on the earlier trade mark **DOLOPUR**, registered for goods



and services in Classes 1, 3, 5, 19 and 40 was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition insofar as the signs were considered to be similar and the goods identical. The BoA dismissed the applicant's appeal. It did not take into account the applicant's argument, according to which the prefix 'DOLO' makes express reference to 'dolomite' rock, on the ground that it had been put forward for the first time right before the BoA. The applicant filed an action before the GC relying on a single plea in law: infringement of Article 75 and Article 76(1) and (2) EUTMR. The GC dismissed the appeal. The GC found that the applicant was substantially claiming an infringement of Article 8(1)(b) EUTMR (para. 14).

1.2.7 *Claim that the case has become devoid of purpose*
[no entry]

1.3 **Undisputed facts, arguments, grounds or evidence**

♦[C-43/15 P](#); **compressor technology / KOMPRESSOR et al.**; Judgment of 8 November 2016; *BSH Bosch und Siemens Hausgeräte GmbH v EUIPO*; Language of the case: DE. The EUTM applicant sought to register the figurative mark **compressor technology** for goods and in Classes 7, 9 and 11. An opposition based, among others, on the earlier word mark **KOMPRESSOR**, registered for similar and identical goods in Classes 7, 9 and 11, was filed on the grounds of Article 8(1)(b) EUTMR. The OD upheld the opposition for the goods found to be similar and identical. The EUTM applicant appealed the decision; the owner of the earlier trade marks, in its observations, stated that the EUTM application should have been refused for even more goods. The BoA, which qualified these observations as 'ancillary appeal' (Article 8(3) Rules of Procedure of the BoA (RPBoA)), dismissed the applicant's appeal and rejected the EUTM application for more goods than OD. The applicant filed an action before the GC. The appeal — based solely on Article 8(1)(b) EUTMR — was dismissed by the GC. It emphasised that a certain degree of distinctiveness has to be attributed to national marks and that the distinctiveness of the earlier mark(s) is just one element of the assessment of likelihood of confusion. In light of the decorative figurative element and the secondary position of the element 'technology' within the EUTM application, the BoA was right in its assessment that the differences in the first letters 'C/K' are not sufficient to compensate for the similarity between the word elements **KOMPRESSOR/compressor**. The EUTM applicant lodged an application before the CJ, relying on two pleas in law: first, the GC violated Article 60 EUTMR by giving its approval, without the slightest examination, to the BoA's qualification of the observations of the owner of the earlier marks as 'ancillary appeal' and by giving its approval to the BoA's rejection of the EUTM application for even more goods than OD. Second, the GC violated Article 8(1)(b) EUTMR by relying on an erroneous concept of likelihood of confusion, with the effect that, if two trade marks coincide as regard a purely descriptive element, it is deemed sufficient to give rise to such a likelihood of confusion, thereby leading to a monopolisation of a purely descriptive indication. The CJ dismissed the appeal. As regards the claimed violation of Article 60 EUTMR, the CJ noted that the applicant — undisputedly — did not claim at any stage of the proceedings before the GC that the BoA's interpretation (ancillary appeal) was incompatible with Article 60 EUTMR or any other provision of EU law. In an appeal, the jurisdiction of the CJ is confined to review of the findings of law on the pleas and arguments debated before the GC. While the BoA infringed the adversarial principle (Article 63, Article 75, second sentence EUTMR) by not giving the applicant an opportunity to comment on the 'ancillary appeal', the fact remains that, in the absence of any challenge by the



applicant relating to that matter before the GC and in the absence of the slightest criticism on its part of the analysis, which led the BoA to uphold the ‘ancillary’ appeal, the GC cannot be criticised for having failed to raise that infringement on its own motion (paras 42 to 45). Accordingly, the CJ dismissed the first plea as inadmissible.

1.4 ***New facts, arguments, grounds or evidence***

♦ [T-802/14](#); **Lenah.C / LEMA**; Judgment of 21 January 2016; *Laboratorios Ern, S.A. v OHIM*; Language of the case: EN. The applicant sought to register the word mark **Lenah.C** as an EUTM for goods within Classes 3 and 5. An opposition based on the earlier mark **LEMA**, registered in Spain for goods in Class 5, was filed on the grounds of Article 8(1)(b) EUTMR. The OD rejected the opposition. The BoA dismissed the opponent’s appeal. The opponent filed an action before the GC. On the admissibility of the evidence adduced for the first time before the GC, the GC stated that the documents that were produced for the first time before the GC, they are inadmissible and cannot be taken into account, without it being necessary to examine their probative value (para. 16).

♦ [T-557/14](#); **SPEZOOMIX / Spezi**; Judgment of 1 March 2016; *BrandGroup GmbH v OHIM*; Language of the case: DE. The sign **SPEZOOMIX** was applied for registration as an EUTM for goods in Classes 32 and 33. The OD dismissed the opposition based on the earlier mark **Spezi**. The BoA reversed the decision and found that both the marks and the goods were identical or similar so that there would be a likelihood of confusion. The applicant based its application for annulment on two pleas in law: (i) infringement of Article 8(1)(b) EUTMR and (ii) infringement of Article 8(5) EUTMR. The GC rejected the second plea as inadmissible, as the BoA had based its decision to reject the EUTM application on Article 8(1)(b) EUTMR only. A reminder was given that the parties before the GC may not change the subject-matter of the proceedings before the BoA.

♦ [T-198/14](#); **100% Capri / CAPRI**; Judgment of 19 April 2016; *100% Capri Italia Srl v EUIPO*; Language of the case: IT. The applicant sought to register the figurative mark **100% CAPRI** as an EUTM for goods in Classes 18 and 25. An opposition based on the earlier EU figurative mark **CAPRI** was filed on the grounds of Article 8(1)(b) EUTMR. The goods on which the opposition was based are *items of outer clothing* in Class 25. The BoA upheld the OD’s finding that there was a likelihood of confusion between the conflicting marks and dismissed the appeal. The applicant filed an action before the GC. As far as the procedural issues are concerned, the applicant argued that the word ‘CAPRI’ would be associated by the relevant public to a particular style of clothing. Furthermore, the applicant claimed, with its observations before the BoA, that ‘no consumer would associate the word ‘CAPRI’ to shirts or other clothing but rather to a kind of cigarettes’ (paras 29 to 31). The GC declared that the arguments and the supporting evidence were inadmissible as they had been raised for the first time before the GC (para. 34).

♦ [T-217/15](#); **PALLADIUM PALACE IBIZA RESORT & SPA**; Judgment of 30 November 2016; *Fiesta Hotels & Resorts, S.L. v EUIPO and Residencial Palladium, S.L.*; Language of the case: ES. An application for invalidity pursuant to Article 53(1) in conjunction with Article 8(4) EUTMR was filed against the figurative EUTM **PALLADIUM PALACE IBIZA RESORT &**



SPA (represented above), registered for *education; providing of training; entertainment; sporting and cultural activities* in Class 41 and *services for providing food and drink; temporary accommodation* in Class 43. The application for invalidity was based on the unregistered name **GRAND HOTEL PALLADIUM**, used in Spain for restaurant and temporary accommodation services. The CD dismissed the application as regards services in Class 41 and upheld it for services in Class 43. It found that, according to Spanish law, the applicant was entitled to prohibit the use of a later mark similar to its trade name if there is a likelihood of confusion between the signs. The BoA dismissed the EUTM proprietor's appeal. The applicant brought an action before the GC relying on two pleas alleging: (i) infringement of Article 53(1) in conjunction with Article 8(4) EUTMR and (ii) infringement of Article 8(1)(b) EUTMR. Regarding the second plea, based on Article 8(1)(b) EUTMR, the GC found that the applicant brought for the first time before the GC the Spanish case-law on 'intermediate marks', which had never been invoked before the Office (para. 81). Furthermore, the GC stressed that the existence of such national rights suitable to prevent the contested mark from being invalidated was a matter of fact that should have been raised and examined during the administrative proceedings before the Office (para. 82). According to Article 65 EUTMR, the GC is not entitled to re-examine factual circumstances under the light of evidence submitted for the first time before it (para. 83), for this reason also the second plea, alleging infringement of Article 8(1)(b) EUTMR was dismissed.

♦[T-561/15](#); **UNIVERSIDAD INTERNACIONAL DE LA RIOJA UNIR / UNIRIOJA et al.**; Judgment of 1 December 2016; *Universidad Internacional de La Rioja, S.A. v EUIPO*; Language of the case: ES. The EUTM applicant (applicant before the GC) sought to register the figurative mark **UNIVERSIDAD INTERNACIONAL DE LA RIOJA UNIR** for goods and services in Classes 16 and 41. The opponent (intervener before the GC) based its opposition on Article 8(1)(b) EUTMR using, inter alia, the earlier trade mark **UNIRIOJA**, registered for goods and services in Classes 16 and 41. The OD upheld the opposition for all the contested goods and services. The BoA confirmed the First Instance. The applicant appealed to the GC alleging infringement of Article 8(1)(b) EUTMR. The GC stated first that the documents produced by the intervener for the first time before the GC intended to show that there would be in fact a confusion between the marks on the market are inadmissible. They would alter the subject matter of the case as it was before the BoA (see Article 188 RPGC) (paras 14 to 16). The applicant made some statements concerning the relevant public, namely that it would be only the Spanish consumers, since the parties are both universities from La Rioja (Spain) being highly attentive because of the kind of the goods and services. Those observations have been produced for the first time before the GC. As to these statements the GC rebutted the Office's conclusion of inadmissibility. The examination of the relevant public is an aspect which falls within the obligation of the BoA to make an overall review of the case. The BoA necessarily based, or should have based, its decision on this issue and therefore such matter may therefore be debated as to their merits before the GC (paras 26 to 34).



1.5 Limitation, including restriction of goods and services

[T-840/14](#); **SKY BONUS / SKY**; Order of 11 March 2016; *International Gaming Projects Ltd v OHIM*; Language of the case: EN.

EUTM application	Earlier mark
	<p style="text-align: center;">SKY</p>

The applicant sought to register the figurative mark **SKY BONUS** represented above as an EUTM for goods in Classes 9 and 28. An opposition based on an earlier UK word mark **SKY**, registered, inter alia, for goods in Classes 9 and 28 was filed pursuant to Article 8 EUTMR. The OD upheld the opposition. The BoA dismissed the applicant’s appeal by affirming the likelihood of confusion pursuant to Article 8(1)(b) EUTMR. The applicant filed an action before the GC in which it limited the goods. The GC dismissed the action as inadmissible, as the limitation of the goods that took place after the decision of the BoA was rendered changed the subject matter of the dispute before the BoA and was therefore against Article 65(2) EUTMR and Article 188 RPGC. The case-law established rules for the admissibility of the limitation of the goods or services during the GC proceedings. Where the applicant was withdrawing its application solely for certain goods covered by the initial application, this was treated either as a declaration that the contested decision was being challenged only insofar as it referred to the remainder of the goods concerned, or, if such a declaration was made at an advanced stage of the proceedings before the GC, as a partial withdrawal of the action. If, however, by its restriction of the list of goods, the trade mark applicant is not seeking to withdraw one or more goods from that list, but to alter a characteristic of those goods, such as their purpose or their description, it is possible that that alteration may affect the examination carried out by the bodies of the Office during the administrative procedure. In those circumstances, to allow that alteration at the stage of the action before the GC would amount to changing the subject matter of the proceedings pending, which is prohibited by Article 188 RPGC. Such an alteration therefore cannot affect the legality of the contested decision or be taken into account by the GC when it examines the merits of the case (para. 22). In the present case, it is clear both from the sole head of claim for annulment and from the arguments set out in support of it in the application that the applicant is not withdrawing any of the goods, but is merely specifying their purpose as relating *exclusively to Video Bingo games for recreational machines for casinos and amusement arcades*. The applicant itself confirms, at paragraph 16 of the application, that it is no longer trying to protect the goods contained ‘in general as a broader category’ but only insofar as they serve that particular purpose (para. 23). By its application, the applicant cannot obtain a partial annulment of the contested decision on the ground that it is based on an assessment — not made by the BoA — of a likelihood of confusion between the marks in question by including in that assessment goods with a specific purpose on which the BoA had not been asked to rule (para. 25).



1.6 Matters of fact appealed to CJ

♦[C-252/15 P](#); **SMART WATER**; Judgment of 17 March 2016; *Naanzen Investments Ltd v OHIM*; Language of the case: EN. The EUTM proprietor was granted the registration of the word mark **SMART WATER** for goods in Class 32. An application for revocation was filed pursuant to Article 51 EUTMR. The Cancellation Division (CD) upheld the application for revocation and revoked the EUTM due to non-use. This decision was confirmed by the BoA and the GC. The EUTM proprietor filed an appeal before the CJEU. The CJ holds that the appellant contests the GC's assessment of evidential value of affidavits and is thereby asking the CJ to substitute its own assessment of the facts and evidence for that of the GC. That line of argument is inadmissible (paras 59 to 60). Findings regarding facts found by the GC, which suggested that the use was not sufficient cannot be contested before the CJ (para. 63). The same applies for the argument that the GC did not regard certain evidence as sufficient to dispel doubts as to the genuineness of use, as well as to the argument that the GC did not give proper value to the existence of non-disclosure agreements (para. 66). Regarding the claimed distortion of facts, the appellant must indicate precisely the evidence alleged to have been distorted by the GC and show the errors of appraisal, which led to that distortion; such distortion must be obvious from the documents on the Court's file, without need to carry out a new assessment of the facts and evidence (para. 69). In the present case, the appellant merely alleges distortion of facts, without explaining how this might affect the GC's assessment of genuine use in circumstances where that conclusion follows from an overall assessment of all the evidence produced before it (para. 71). The reasons why the mark was not used more extensively are taken into account in the assessment of proper reasons for non-use but not as a relevant justification of modest commercial volume; assessment of genuine use takes into account evidence of the existence of use and not evidence explaining non-use, the latter being taken into account in the assessment of the reasons for non-use (para. 74). Non-use referred to in the first subparagraph of Article 15(1) and Article 51(1)(a) EUTMR must necessarily be understood as referring to a failure to put the trade mark to genuine use within the meaning of the first part of those provisions, including, therefore, both a complete failure to use a mark and limited use of a mark (para. 78). The appellant complained that the GC set the requirement of 'impossible' use; the CJ clarifies that the GC did not examine whether the alleged obstacles made the use impossible, but whether it made it unreasonable (para. 95). It is not sufficient that an obstacle is independent of the will of the trade mark proprietor; it must have a sufficiently direct relationship with the mark making its use impossible or unreasonable (para. 97). The GC stated that revocation proceedings brought against the mark does not prevent the proprietor of that mark from using it and a possible order to pay damages is not a direct consequence of the revocation proceedings. In this regard, the appellant is in fact seeking review of the GC's appraisal of facts, such review is outside the jurisdiction of the CJ (paras 96 to 99).

[C-232/15 P](#); **ultra.air ultrafilter**; Order of 21 April 2016; *ultra air GmbH v EUIPO*; Language of the case: DE. The EUTM proprietor was granted the registration of the word mark **ultra.air ultrafilter** for goods and services in Classes 7, 9, 11, 37 and 42 mostly related to filters and other technical devices containing them. An application of invalidity was filed pursuant to Article 52 EUTMR in conjunction with Article 7 EUTMR. The CD dismissed the application for invalidity. The BoA upheld the invalidity applicant's appeal and invalidated the contested mark on the ground of Article 7(1)(b) and (c) EUTMR. The GC partly annulled the BoA decision with respect to *time control systems* for a lack of reasoning but confirmed it for the remaining goods and services, holding in essence that the mark refers to air of excellent quality and thus designates kind and purpose of the goods and services. The EUTM



proprietor filed an appeal before the CJEU. The CJ rejected the appeal. **Matters of fact (Article 7(1)(c) EUTMR):** the GC findings concerning the relevant public and its attentiveness, perception or attitude are matters of fact. The same applies for the comprehension of word marks (para. 41). Therefore, these are matters outside the scope of the appeal proceedings before the CJ, which is confined to matters of law (para. 42). **Distortion of facts:** the applicant formally invokes a distortion of fact, claiming that the GC disregarded the term ‘air’, but on substance attempts to challenge the assessment of facts by the GC. Moreover, the GC addressed the mark in its entirety. Hence, the plea is manifestly inadmissible (paras 52 to 54). **Article 7(1)(b) EUTMR:** as the plea under Article 7(1)(c) EUTMR was rejected, it is not necessary to rule on Article 7(1)(b) EUTMR.

♦[C-224/14 P](#); **LIDL / LIDL MUSIC et al.**; Order of 6 September 2016; *Lidl Stiftung & Co. KG v EUIPO — Lidl Music spol. s r.o.*; Language of the case: EN. The GC had dismissed the appellant’s claims based on Article 8(1)(b), Article 15(1), Article 15(1)(a) and Article 42(2) and (3) EUTMR. The appellant requested the annulment of the GC’s judgment putting forward three pleas in law, alleging, in essence, first, infringement of the combined provisions of Article 42(2) and (3) EUTMR and Rule 22(3) and (4) EUTMR, in conjunction with Article 15(1) EUTMR that there was genuine use of the earlier mark; secondly, infringement of Article 15(1)(a) EUTMR in conjunction with Article 42(2) and (3) EUTMR, on the ground that the BoA had erred in finding that the use of the earlier mark in a form that differed from the form in which it was registered constituted genuine use for the purposes of Article 15(1) EUTMR; and, thirdly, infringement of Article 8(1)(b) EUTMR, on the ground that the BoA had erred in finding that there was a likelihood of confusion between the marks at issue. The CJ dismissed the appeal. **Article 15(1), Article 42(2) and (3) EUTMR:** the appellant claimed, in particular, that the GC erred in law in holding that the BoA was right in finding that the invoices and the evidence (three undated photographs) submitted by Lidl Music were sufficient to prove the nature of use of the earlier mark. The CJ held that, under the pretext of infringement of certain provisions of Regulation, the appellant seeks, in actual fact, to call into question the assessment of the evidence, which the GC carried out during its examination of the nature of use of the earlier mark, without alleging that there was any distortion of that evidence. Therefore, the CJ rejected the first ground of appeal as manifestly inadmissible, according to Article 256 TFEU and Article 58(1) of the Statute of the Court of Justice of the European Union (paras 26 to 28). **Article 8(1)(b) EUTMR:** the CJ held that, under the guise of arguments relating to errors of law allegedly made by the GC, the appellant is requesting that the Court carry out a new assessment of the facts with a view to substituting that assessment for that carried out by the GC. The CJ precised that the errors alleged by the appellant could be confirmed only by means of an assessment of the distinctive character of the various elements of the signs at issue. Such an assessment is manifestly part of the assessment of the facts made by the GC (paras 52 to 53). Therefore, the third ground of appeal must therefore be rejected as manifestly inadmissible.

♦[C-237/14 P](#); **LIDL express / LIDL MUSIC et al.**; Order of 6 September 2016; *Lidl Stiftung & Co. KG v EUIPO — Lidl Music spol. s r.o.*; Language of the case: EN. The GC had dismissed the appellant’s claims based on Article 8(1)(b), Article 15(1), Article 15(1)(a), Article 42(2) and (3) EUTMR. The appellant requested the annulment of the GC’s judgment putting forward three pleas in law, alleging, in essence, first, infringement of the combined provisions of Article 42(2) and (3) EUTMR and Rule 22(3) and (4) EUTMR, in conjunction with Article 15(1) EUTMR that there was genuine use of the earlier mark; secondly, infringement of Article 15(1)(a) EUTMR in conjunction with Article 42(2) and (3) EUTMR, on the ground that the BoA had erred in finding that the use of the earlier mark in a form that



differed from the form in which it was registered constituted genuine use for the purposes of Article 15(1) EUTMR; and, thirdly, infringement of Article 8(1)(b) EUTMR, on the ground that the BoA had erred in finding that there was a likelihood of confusion between the marks at issue. The CJ dismissed the appeal. **Article 15(1), Article 42(2) and (3) EUTMR:** the appellant claimed, in particular, that the GC erred in law in holding that the invoices and the evidence (three undated photographs) submitted by Lidl Music were sufficient to prove the nature of use of the earlier mark. The CJ held that, under the pretext of infringement of certain provisions of Regulation, the appellant seeks, in actual fact, to call into question the assessment of the evidence, which the GC carried out during its examination of the nature of use of the earlier mark, without alleging that there was any distortion of that evidence. Therefore, the CJ rejected the first ground of appeal as manifestly inadmissible, according to Article 256 TFEU and Article 58(1) of the Statute of the CJ (paras 26 to 28). **Article 8(1)(b) EUTMR:** the appellant submits that the GC misinterpreted Article 8(1)(b) EUTMR by confirming the finding that there was a similarity between the marks at issue because the dominant element in both of them was the word 'lidl', because that finding did not adequately take into account the other elements of the earlier mark. The CJ rejected that argument as manifestly unfounded. It stated that, although it is true that the GC referred, as regards the figurative mark applied for **Lidl express**, to the word 'music', rather than to the word 'express', that is obviously a clerical mistake that cannot under any circumstances result in the setting aside of the judgment under appeal. In that regard, the CJ pointed out that it is apparent from a reading of that judgment as a whole and, in particular, from paragraph 80 thereof, that the GC was perfectly aware of the various components of the marks at issue (para. 56). In relation to the remaining arguments of the appellant, the CJ held that, under the guise of arguments relating to errors of law allegedly made by the GC, the appellant is requesting that the Court carry out a new assessment of the facts with a view to substituting that assessment for that carried out by the GC. The CJ specified that the errors alleged by the appellant could be confirmed only by means of an assessment of the distinctive character of the various elements of the signs at issue. Such an assessment is manifestly part of the assessment of the facts made by the GC and, therefore, the applicant's ground must therefore be rejected as manifestly inadmissible (paras 57 to 60).

♦[C-586/15 P](#); **LOTTE / SCHÖLLER KOALA**; Order of 7 September 2016; *Lotte Co. Ltd GmbH v EUIPO*; Language of the case: DE. In the case under appeal (T-483/12) the GC had upheld the opponent's action. It decided that some of the examples provided by the opponent showed the use of the earlier mark in a form different from registered, which, however, does not alter its distinctive character. These examples show the elements that produce the distinctive character of the earlier mark: the hexagonal form, the word element 'KOALA' and the picture of koalas in their environment. The lack of the word element 'Bären' [bears] will not change the distinctive character of the earlier mark as this word can be omitted. The scope of use of this trade mark was proven by the invoices and price lists. The applicant filed an appeal before the CJ claiming the infringement of Article 15(1)(a) EUTMR. The CJ dismissed the appeal. There was no error in law by the GC when applying the criteria, that were developed in the case-law for a comparison of the trade marks, to the assessment of whether the differences between the form used and the form registered alter the distinctiveness pursuant to Article 15(1)(a) EUTMR, as that case-law defines the general issue of consumer's perception of the mark (para. 31). The claims related to the assessment of the distinctive and dominant elements of the mark were question of facts (para. 33). Also several further arguments of the applicant are of factual nature (para. 39).



♦[C-482/15 P](#); **bambinoLÜK / BAMBINO**; Judgment of 26 October 2016; *Westermann Lernspielverlage GmbH v EUIPO*; Language of the case: EN. The EUTM applicant sought to register the figurative sign **bambinoLÜK** for goods in Classes 9, 16 and 28. An opposition based, among others, on an earlier figurative EUTM, **BAMBINO**, covering goods and services in Classes 16, 28 and 41, was filed on the grounds of Article 8(1)(b) EUTMR. The OD upheld the opposition for some goods and services. The BoA partially upheld the appeal. The opponent brought an action before the GC, alleging infringement of Article 8(1)(b) EUTMR because of (i) the lack of distinctive character of the word element ‘bambino’ of the earlier trade mark, (ii) the lack of similarity between the signs at issue and (iii) the absence of a likelihood of confusion. The GC dismissed the action. The applicant filed an appeal before the CJEU on the basis of two grounds: (i) breach of the right to be heard and the right to a fair trial and (ii) the infringement of Article 8(1)(b) EUTMR. The CJ dismissed the appeal. Regarding the second plea, the CJ found that the GC did not err in law in reviewing the BoA’s decision because the earlier mark on which the opposition is based was producing its effects at that time, since the date of its revocation is subsequent to the BoA’s decision. Furthermore, the applicant’s argument related to the assessment of the similarity between the signs seeks to contest the GC’s factual assessment and is therefore inadmissible.

♦[C-295/15](#); **ARKTIS**; Order of 22 June 2016; *Matratzen Concord GmbH v EUIPO*; Language of the case: DE. The applicant before the GC requested the revocation for non-use according to Article 51(1)(a) EUTMR of the EUTM, **ARKTIS**, registered for goods in Classes 20 and 24. The CD revoked the mark partially for the goods in Class 20. It found that for the goods in Class 24 the EUTM had been used. The BoA confirmed the First Instance decision. The GC examined if the use is to be considered as genuine and stated that the volume of 3 490 *pillows and sleeping bags* (Class 20) confirms the position of the BoA that this constitutes a sufficient volume of use and cannot be considered as token use. The claim that the addition of the term ‘line’ would alter the distinctive character of the sign as used was rejected by the GC. This expression will also be understood in Germany, where the mark has been used, in the sense as product line. The GC also quoted the case-law (case: T-19/99 *Companyline*; T-273/10 *O-live*). The addition is subordinated and the term ‘ARKTIS’ is dominant. The statement that the mark has been used by another company without consent of the proprietor was dismissed. The GC confirmed the case-law that from the fact that the proprietor has the information referring to the use of another company it may be inferred that such use has been done with its consent. Procedure before the CJ: the CJ applied Article 181 RPCJ, according to which a manifestly inadmissible or manifestly unfounded appeal may be dismissed by reasoned order (paras 16 and 17). **Matters of fact:** the plea of the appellant that the GC committed an error in the assessment on the proof of use by not examining the size of the affected market is a matter of fact that may not be brought before the CJ. The same applies to the plea according to which the goods *bedding* had not been taken into account in the assessment of the proof of use, because it is also a matter of fact (para. 28).

1.7 Other, including general reference to previous statements

♦♦[T-135/14](#); **kicktipp / KICKERS et al.**; Judgment of 5 February 2016; *Kicktipp GmbH v OHIM*; Language of the case: EN. The GC found regarding the reference, in general terms, to pleadings submitted before the Office, that previous case-law can be transposed to the response of the party and held that a general reference to other documents cannot



compensate for the failure to set out the essential elements of the legal argument, as it is not for the GC to take on the role of the parties by seeking to identify the relevant pleas and arguments in the documents to which they refer (paras 21 to 22). The general reference to the pleadings submitted before the Office was inadmissible (para. 23).

2. *Essential procedural requirements*

2.1 *Right to be heard*

[T-750/14](#); **ELGO / ERGO**; Judgment of 12 May 2016; *Ivo-Kermartin GmbH v EUIPO*; Language of the case: DE.

EUTM application	Earlier mark
ELGO	ERGO

The applicant consecutively declared (minor) restrictions of its goods/services in the course of the opposition proceedings, which were communicated to the opponent (Rules 18(3) and 20(5) EUTMIR). The opponent stated that the applicant merely seeks to extend the opposition proceedings and that it maintains its opposition regardless of any further restrictions. Following the fifth restriction, the OD notified its decision (opposition upheld) without communicating to the applicant beforehand the opponent’s statement to maintain the opposition. The applicant appealed claiming that the lack of communication of said statement before rendering the opposition decision amounts to a serious procedural error. The BoA dismissed the appeal as inadmissible reasoning that the appeal does not contain any admissible grounds of appeal (Article 60 EUTMR) and that the plaintiff is not adversely affected by the circumstances claimed (Article 59 EUTMR). The Office complied with Rules 18(3) and 20(5) EUTMIR when informing the opponent about the applicant’s last restriction. In the circumstances of the present case, it does not amount to an infringement of the applicant’s right to be heard or right of defence under Article 75 EUTMR that the applicant was not informed about the opponent’s reaction before rendering the opposition decision. As follows from Rules 18(3) and 20(5) EUTMIR, the proceedings continue when an opponent maintains its opposition following a restriction. Article 43 EUTMR enables an applicant to restrict the specification of the mark applied for at any time but does not oblige the Office to postpone the opposition decision until the applicant declares a further restriction (paras 32 to 41). Besides, the applicant could have made such declaration even after the decision was rendered (paras 42 to 43). Furthermore, the applicant was aware of the opponent’s prior statement to maintain the opposition regardless of any further restriction (para. 44). In any event, Article 75 EUTMR was not infringed since it cannot be found that the proceedings would have resulted in a different decision on substance (paras 47 to 48).

◆[T-159/15](#); **DEVICE OF A JUMPING ANIMAL / PUMA et al.**; Judgment of 9 September 2016; *Puma SE v EUIPO*; Language of the case: EN. The opponent invoked Article 8(5) EUTM and provided, for the purpose of substantiating the reputation of its earlier mark, inter alia (i) references to earlier decisions of the Office recognising the reputation of the earlier mark (i.e. number and date of decision) and short extracts of these decisions, (ii) copies of earlier decisions taken by different national offices/courts as well as (iii) a — non



translated — market survey. The OD rejected the appeal without examining the reputation for the opponent's lack of having established a link between the opposing mark protecting very different goods *specialised machines for treating wood, aluminium and PVC* in Class 7 v goods in Classes 18, 25 and 28 and one of the infringements of Article 8(5) EUTMR. The BoA dismissed the appeal on the basis of the finding that reputation had not been established, confirming furthermore in an *obiter dictum* the OD's finding as regards the remaining conditions of Article 8(5) EUTMR. It found, in particular, that (i) the Office's previous decisions invoked by the opponent were not binding, (ii) that the national decisions were not relevant as it was unclear on which evidence these had been adopted and that (iii) the non-translated evidence was to be disregarded in application of Rule 19(3) EUTMIR. Before the GC, the opponent claimed, inter alia, a breach of the principles of legal certainty and sound administration in that the BoA had (i) rejected the non-translated evidence and (ii) concluded that the earlier mark's reputation had not been established despite the fact that the opponent had, in particular, referred to earlier Office decisions recognising such reputation. The GC upheld the appeal. The GC rejects the claim that the BoA's refusal to accept non-translated evidence constitutes a breach of principle of sound administration on the grounds that Rule 19(3) EUTMIR is sufficiently clear (para. 24) and the translation requirement justified by the principles of right to be heard and equality of arms (para. 25).

[C-575/15 P](#); **ZARA**; Order of 26 October 2016; *Industria de Diseño Textil, S.A. (Inditex) v EUIPO*; Language of the case: ES. The trade mark **ZARA** was registered in a number of classes of the Nice Classification on 3 January 2001. An application for revocation of the EUTM for the goods and services in Classes 39 and 42 was filed pursuant to Article 51(1)(a) EUTMR. The CD upheld the application for revocation in both classes, but the BoA confirmed the revocation only for the services in Class 39, insofar as the applicant had not provided enough evidence to demonstrate the genuine use of the mark. The applicant filed an application for annulment before the GC, which dismissed the action. The applicant filed an appeal before the CJEU on the basis of six grounds. The CJ dismissed all the grounds. It found that the action was partly manifestly inadmissible and partly manifestly unfounded, due to misinterpretation of the judgment by the applicant and the lack of precision in indicating the contested elements of the judgment for which annulment is sought and the legal arguments supporting his claims (paras 30 to 31). The CJ also found that distortion of evidence was not manifested in the proceedings since the quantified data provided couldn't prove the genuine use of the mark for services in Class 39 (paras 20 to 21). The CJ did not find any evidence of an infringement of the right of defence (paras 38 to 39).

◆ [T-548/15](#); **Café del Sol / CAFE DEL SOL et al.**; Judgment of 13 December 2016; *Ramón Guiral Broto v EUIPO*; Language of the case: EN. The applicant sought to register the word mark **Café del Sol** as an EUTM for goods and services in Classes 30, 35, 41, 43 and 45. An opposition based on earlier figurative marks registered variously for goods and services in Classes 9, 25, 42 and 43 was filed pursuant to Article 8(1)(a) and (b) EUTMR. The OD partly upheld the opposition insofar as it related to *services for providing of food and drink, temporary accommodation, outside catering* in Class 43. Only one of the earlier marks was valid and substantiated, namely, Spanish trade mark registration No 2 348 110. The BoA upheld the applicant's appeal. It found that the only earlier mark upon which the OD had based its decision was not substantiated because the translations provided by the opponent left out indications of the colour of the mark. The BoA also confirmed that the other earlier marks were either no longer valid at the operative time or that they were not properly substantiated. Consequently, as all the earlier marks were either invalid or not substantiated,



the opposition was dismissed as unfounded. The opponent filed an action before the GC relying on three pleas in law: (i) the contested decision is *ultra petita*; (ii) the documents submitted in order to prove the existence of the earlier mark were sufficiently probative and (iii) failure to respect the subordinate, instrumental and auxiliary nature of the procedural rules at issue and the possibility of remedying procedural irregularities. The GC upheld the appeal. It found that the contested decision was adopted in infringement of the principle that the parties should be heard and that the contested decision must be annulled owing to infringement of the applicant's rights of defence. The crux of the matter is that the BoA found that the earlier Spanish trade mark was not substantiated because the relevant translations left out indications of colour. The translation of the registration certificate omitted (i) 'azul' and 'blanco' (blue and white respectively) in the arrows shown above and (ii) the words 'y color azul' (and coloured blue) in the description field. ***Audiatur et altera pars (audi alteram partem)***: the second sentence of Article 75 EUTMR provides that decisions of the Office are to be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments. It was not disputed that the BoA declared the opposition unfounded pursuant to Rule 19 and Rule 20(1) EUTMR without having heard the opponent on the incompleteness of the translation. The fact that the opponent was not heard on that issue constitutes a procedural irregularity (para. 31). The latter procedural irregularity constitutes an infringement of the rights of defence only provided that the failure to take into account the view of an interested party has had a concrete effect on the ability of that party to defend himself (para. 32). In the present case, considering the BoA's discretion to admit evidence not presented within the time limits, if the opponent had been heard on the absence of a translation of the indications of colour for his earlier mark, he would have submitted a translation of those indications, which might have been accepted by the BoA and might therefore have led to the opposition proceedings resulting in a different outcome (para. 39). Consequently, the contested decision was adopted in infringement of the principle that the parties should be heard (para. 40).

2.2 Adequate reasoning

♦[T-674/13](#); **GUGLER**; Judgment of 28 January 2016; *Gugler France v OHIM*; Language of the case: EN. The EUTM proprietor was granted the registration of the figurative mark **GUGLER** as an EUTM for goods and services in Classes 6, 17, 19, 22, 37, 39 and 42. An application for invalidity was filed pursuant to Article 52(1)(b), and to Article 53(1)(c) in conjunction with Article 8(4) EUTMR. The CD upheld the application for invalidity. The BoA upheld the EUTM proprietor's appeal. The invalidity applicant filed an action before the GC relying on two pleas in law: (i) infringement of Article 53(1)(c), read in conjunction with Article 8(4) EUTMR (ii) infringement of Article 52(1)(b) EUTMR. The GC upheld the appeal. **On the infringement of Article 53(1)(c), read in conjunction with Article 8(4) EUTMR**: first, although the fourth condition set out in Article 8(4) EUTMR — that is to say that an earlier sign must confer on its proprietor the right to prohibit the use of a subsequent trade mark — must be assessed in the light of the criteria set by national law, the BoA's analysis does not include any reference to the national law applicable, whether that reference is to legislation or to the case-law. Secondly, the BoA based its reasoning on the existence of an earlier company name and an earlier trade name and on a 'trade mark **GUGLER**' belonging to the EUTM proprietor (who was producing the products that were sold and installed by the invalidity applicant), which, in its view, prevented the invalidity applicant from acquiring a right in the name 'GUGLER'. However, it is not sufficiently clear on what evidence the BoA based its assessment. Furthermore, the contested decision does not contain any mention of, or



reference to, the right to the protection of a company name conferred by French law, or, a *fortiori*, the conditions laid down by French law, which define the invalidity applicant's rights relating to the protection of its company name. The Office's explanations, according to which allowing the invalidity applicant to prohibit the use by the EUTM proprietor of the contested mark in France would have been contrary to Article 34 TFEU, cannot be regarded as supplementing a statement of reasons, which is already self-sufficient, since they constitute a completely new statement of reasons. Hence, the BoA infringed the obligation to state reason imposed upon by Article 75 EUTMR (paras 31 to 62).

◆[T-590/14](#); **ULTIMATE FIGHTING CHAMPIONSHIP**; Judgment of 12 May 2016; *Zuffa, LLC v EUIPO*; Language of the case: EN. The applicant sought to register the word sign **ULTIMATE FIGHTING CHAMPIONSHIP** for goods in Classes 9, 16, 28 and 41. The Office rejected the application for all the goods (with the exception of *playing cards and computer game controllers* in Class 28). The BoA dismissed the appeal. The applicant filed an application before the GC for the annulment of the decision of the BoA relying on three pleas in law: (i) infringement of the obligation to state reasons; (ii) infringement of Article 7(1)(b) and (c) EUTMR; and (iii) infringement of Article 7(3) EUTMR. Concerning the first plea, the applicant maintains that, in adopting general reasoning in relation to each class of goods or services, the BoA did not provide an adequate statement of reasons for the contested decision. The GC found that the decision was duly motivated. In particular, the finding that all the goods in Class 9 are *data support media* that, in conjunction with the contested mark, would be perceived as containing, involving or relating to the highest, best of most extreme combat is sufficient to understand the BoA's reasoning for all of the goods in that class. The same is true for the reasoning in relation to the *printed media* in Class 16, the *toys* in Class 28 and the *various forms of shows, entertainment, performances, programs, productions of recording, news and information* in Class 41 (paras 25 to 34). As for the assessment of the evidence, admittedly the BoA did not take an express view on some of the exhibits. It did however adopt the findings of the Office, who adopted a general statement of reasons in which it stated that it had carefully analysed each of the documents provided. The decision of the BoA was therefore duly motivated (paras 35 to 43).

◆[T-454/14](#); **STONE**; Judgment of 31 May 2016; *Warimex Waren-Import Export Handels-GmbH v EUIPO*; Language of the case: DE. The applicant sought to register figurative mark **STONE** as an EUTM for goods and services in Classes 1, 3, 7, 8, 9, 11, 12, 16, 21, 24 and 25. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR, as it was found to be descriptive and devoid of distinctive character. The BoA confirmed this refusal. The EUTM applicant filed an action before the GC, claiming the infringement of Article 7(1)(b) and (c), Article 75 and Article 76 EUTMR. The GC dismissed all claims. It emphasised that the examination of the case and the reasoning of the decision follows the requirements of Articles 75 and 76 EUTMR. The reasoning is specific for different groups of goods. The alleged infringement of the duty to state the reasons results from a wrong understanding of the decision (para. 49).

◆[T-34/15](#); **CHEMPIOIL / CHAMPION**; Judgment of 1 June 2016; *Wolf Oil Corp. v EUIPO / UAB SCT Lubricants*; Language of the case: EN. The applicant obtained the international registration designating the European Union of the word mark **CHEMPIOIL** for goods covering, inter alia, *hydraulic and brake fluids* (Class 1), *cleaning and washing preparations for oil-soiled engines and other soiled industrial objects* (Class 3), *lubricants; fuels, industrial greases and industrial oils* (Class 4). An opposition based on the earlier



figurative mark **CHAMPION**, also registered for goods in Classes 1, 3 and 4, was filed pursuant to Article 8(1)(b) EUTMR. The OD partly upheld the opposition. The BoA annulled the OD's decision and upheld the appeal. It found that there was no likelihood of confusion between the marks at issue because the signs were different due, in particular, to the fact that the earlier mark had a fixed meaning for all the public in the EU, whereas the earlier mark had no meaning or different ones. The opponent filed an action before the GC relying on two pleas in law: (i) infringement of Article 75 and Article 76(1) EUTMR; and (ii) infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. Regarding the infringement of Article 75 and Article 76(1) EUTMR, the GC noted that, in confirming that the word 'champion', which is part of the earlier mark, would be understood by a large majority of the relevant public, the BoA relied on the one hand, on the arguments submitted by the intervener during the administrative procedure, which the applicant, moreover, acknowledged and, on the other, on well-known facts (paras 63 and 64). Therefore, there was no infringement of Article 75 EUTMR. The BoA clearly and unequivocally set out the reasoning which led it to find that the word 'champion' would be understood by a large majority of the relevant public, which enabled, in particular, the applicant to ascertain the reasons for that conclusion (paras 72 to 75).

◆[C-309/15 P](#); **real,- / Real mark et al.**; Order of 8 September 2016; *Real Express SRL v EUIPO — MIP METRO Group Intellectual Property GmbH & Co. KG*; Language of the case: EN. The applicant sought to register the figurative mark **real,-** as an EUTM for goods and services, amongst others, in Classes 3 and 35. An opposition based on the earlier figurative marks **Real mark** and **Real lichid**, registered for goods and services in Classes 3 and 35, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition as unfounded. The BoA dismissed the opponent's appeal. The opponent filed an action before the GC who dismissed the appellant's action as partly inadmissible (for lack of clarity and coherence and therefore for failure to satisfy the minimum requirements of Article 44(1)(c) RPGC (1991)) and as partly manifestly unfounded. The opponent filed an action before the CJEU requesting the annulment of the GC's order claiming, in substance, an erroneous application of Article 44(1)(c) RPGC, a violation of the duty to state reasons, violations of Rule 15(2)(h)(iii), Rule 17(1) and (4) and Rules 19 and 20 EUTMR as well as of the principle of legal certainty. The CJ found no distortion made by the GC of the facts of the case which led the GC to consider that the BoA had not erred in considering that the appellant had not properly established the change of the name necessary for substantiating its entitlement to the earlier right on which the opposition was based.

◆◆[T-159/15](#); **DEVICE OF A JUMPING ANIMAL / PUMA et al.**; Judgment of 9 September 2016; *Puma SE v EUIPO*; Language of the case: EN. The opponent invoked Article 8(5) EUTM and provided, for the purpose of substantiating the reputation of its earlier mark, inter alia (i) references to earlier decisions of the Office recognising the reputation of the earlier mark (i.e. number and date of decision) and short extracts of these decisions, (ii) copies of earlier decisions taken by different national offices/courts as well as (iii) a — non translated — market survey. The OD rejected the appeal without examining the reputation for the opponent's lack of having established a link between the opposing mark protecting very different goods *specialised machines for treating wood, aluminium and PVC* in Class 7 v goods in Classes 18, 25 and 28 and one of the infringements of Article 8(5) EUTMR. The BoA dismissed the appeal on the basis of the finding that reputation had not been established, confirming furthermore in an *obiter dictum* the OD's finding as regards the remaining conditions of Article 8(5) EUTMR. It found, in particular, that (i) the Office's previous decisions invoked by the opponent were not binding, (ii) that the national decisions



were not relevant as it was unclear on which evidence these had been adopted and that (iii) the non-translated evidence was to be disregarded in application of Rule 19(3) EUTMIR. Before the GC, the opponent claimed, inter alia, a breach of the principles of legal certainty and sound administration in that the BoA had (i) rejected the non-translated evidence and (ii) concluded that the earlier mark's reputation had not been established despite the fact that the opponent had, in particular, referred to earlier Office decisions recognising such reputation. The GC upheld the appeal. The GC found in application of the CJ's Technopol judgment (C-51/10 P, paras 74 to 77) that the BoA breached the principle of sound administration in departing — without giving any reasons in this respect or even mentioning them (para. 31) — from the Office's previous (relatively recent) decisions in which the Office had recognised (on the basis of a detailed analysis of voluminous evidence) the earlier mark's high degree of distinctiveness as a result of its long standing and intensive use and high degree of recognition (paras 20 and 34). This would be all the more the case as the national decisions invoked by the applicant did confirm the Office's previous findings as well as in a recent judgment of the GC (para. 32). The GC refused to accept the BoA's 'even if' reasoning according to which none of the infringements under Article 8(5) EUTMR had been established even assuming that the earlier mark had reputation (paras 41 to 42) on the ground that the application of Article 8(5) EUTMR always requires to establish — expressly — the earlier mark's exact degree of reputation.

♦[T-563/15](#); **APOTEKE**; Judgment of 13 September 2016; *Pagliari Sell System Sp.A v EUIPO*; Language of the case: IT. The EUTM applicant sought to register the figurative mark **APOTEKE** for an extensive range of goods in Classes 3, 5, 29 and 30. The examiner refused the registration of the EUTM application and the BoA confirmed the refusal for all of the goods. The applicant filed an action before the GC relying on three pleas in law: (i) infringement of Article 75 EUTMR, (ii) infringement of Article 7(1)(c) and (iii) infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal. Regarding the first plea in law, it found that the decision of the BoA was sufficiently reasoned in accordance with the requirements set out under Article 75 EUTMR (para. 14). The GC recalled the case-law according to which the Office has in principle to motivate the refusal in relation to each of the relevant goods. However, a global reasoning is permitted when it refers to goods that show a sufficiently direct and objective link to the extent that they form a homogeneous category or group (para. 15). The GC emphasised that the BoA indicated the nature of the connection between the goods and the mark in a precise manner and gave explicit reasons for its findings in relation to all of the specified goods (paras 18 and 19).

♦[T-574/15](#); **KOZMETIKA AFRODITA / EXOTIC AFRODITA MYSTIC MUSK OIL et al.**; Judgment of 28 September 2016; *Kozmetika Afrodita d. o. o. v EUIPO*; Language of the case: SL. The applicant sought to register the figurative mark **KOZMETIKA AFRODITA** as an EUTM for goods and services in Classes 3, 42 and 44. An opposition based on the earlier Spanish word mark **EXOTIC AFRODITA MYSTIC MUSK OIL**, inter alia, and registered for goods in Class 3, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition in part. The BoA dismissed the appeal. The applicant filed an action before the GC relying on two pleas in law: (i) a violation of Article 8(1)(b) EUTMR and (ii) a violation of Rule 50(2)(h) EUTMIR. The GC dismissed the appeal. **Duty to state reasons:** the GC confirmed that it was not necessary to compare the remaining earlier mark because the outcome would be the same since the remaining mark covers the same goods and services and the signs are less similar than those compare. The principle of the duty to state reasons was not violated (paras 65 to 67).



♦[T-575/15](#); **AFRODITA COSMETICS / EXOTIC AFRODITA MYSTIC MUSK OIL et al.**; Judgment of 28 September 2016; *Kozmetika Afrodita d. o. o. v EUIPO*; Language of the case: SL. The applicant sought to register the figurative mark **AFRODITA COSMETICS** as an EUTM for goods and services in Classes 3, 42 and 44. An opposition based on the earlier Spanish word mark **EXOTIC AFRODITA MYSTIC MUSK OIL**, inter alia, and registered for goods in Class 3, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition in part. The BoA dismissed the appeal. The applicant filed an action before the GC relying on two pleas in law: (i) a violation of Article 8(1)(b) EUTMR and (ii) a violation of Rule 50(2)(h) EUTMIR. The GC dismissed the appeal. **Duty to state reasons:** the GC confirmed that it was not necessary to compare the remaining earlier mark because the outcome would be the same since the remaining mark covers the same goods and services and the signs are less similar than those compared. The principle of the duty to state reasons was not violated (paras 67 to 69).

♦[T-355/15](#); **ASTEX / ALPEX**; Judgment of 30 September 2016; *Alpex Pharma SA v EUIPO*; Language of the case: EN. The applicant sought to register the word mark **ASTEX** as an EUTM for goods and services in Classes 1, 5, 9, 42 and 44. An opposition was directed against all services in Class 42. It was based on the earlier word mark **ALPEX**, registered for services in Class 42, inter alia, and was filed pursuant to Article 8(1)(b) EUTMR. The OD rejected the opposition in its entirety. The BoA dismissed the appeal. The applicant filed an action before the GC relying on four pleas in law. The first two pleas allege infringement of Article 15 and Article 42(2) EUTMR and of Rule 22(3) and (4) EUTMIR for proof of use and genuine use. The third plea alleges infringement of Article 75 EUTMR and the fourth plea alleges infringement of Article 76(1) EUTMR. The GC dismissed the appeal. **Obligation to state reasons:** the GC confirmed that the BoA provided reasoning why clinical trials for obtaining marketing authorisation for pharmaceuticals could not serve as evidence of provision of services to third parties. Marketing authorisation is merely part of the process of placing pharmaceuticals on the market. The BoA demonstrated to the required legal standard the reasons why genuine use for services in Class 42 was not proven (para. 47).

[C-537/14 P](#); **SO'BiO etic / SO...? et al.**; Judgment of 27 October; *Debonair Trading International Lda v EUIPO*; Language of the case: EN.

EUTM application	Earlier marks
	<p>SO...? <i>et al</i></p>

The applicant sought to register the figurative mark represented above for, inter alia, goods in Classes 3 and 25. An opposition based, inter alia, on the European and UK earlier word marks **SO...?**, registered for goods in Classes 3 and 25, was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The OD dismissed the opposition. The BoA partly upheld the opponent's appeal. It found that that there was a likelihood of confusion for the identical and similar goods and for the dissimilar goods, there was risk of the contested trade mark being detrimental to the reputation of the earlier marks. The applicant filed an action before the GC relying on, inter alia, the alleged infringement of Article 8(1)(b) and Article 8(5) EUTMR. The



GC upheld the appeal. It found that the element 'SO', common to both signs, was laudatory. It found that the BoA erred in finding that that element was dominant in both signs. The GC concluded that the signs at issue were not similar (para. 91 of the judgment of the GC). The opponent filed an action before the CJEU seeking the annulment of the GC judgment. The Office filed a cross-appeal seeking the same relief. The CJ upheld the appeal and the cross-appeal and annulled the judgment of the GC. **Duty to state reasons:** in paragraph 87 of the judgment under appeal the GC stated that a laudatory function of the word 'so' exists when it is accompanied by another word, whereas it might be understood, out of context, as meaning 'then', 'thus' or 'therefore' (implying that it would be not laudatory in such a case). However, in paragraph 73 of the judgment under appeal, the GC stated that the word 'so' has a laudatory function in the earlier trade marks 'SO...?' (where it is obviously not accompanied by any other word). The CJ found a contradiction in the reasoning of the GC; the parties and the CJ are unable to ascertain whether, in the GC's analysis, the word element 'so' has a laudatory function only when it is used with another word or also when it is used on its own (paras 32 to 37). The GC did not comply with its obligation to state reasons, the GC judgment is set aside and the case is referred back to the GC.

♦♦[C-642/15 P](#); **SHAPE OF AN OVEN**; Judgment of 1 December 2016; *Toni Klement v EUIPO*; Language of the case: DE. The applicant for cancellation requested the revocation for non-use of the shape of an oven registered as an EUTM (3D mark) for *ovens* in Class 11. The proprietor of the EUTM filed evidence of use which contained the shape of the EUTM with the additional word element 'Bullerjan' on it. The instances in the Office found that the use requirements had been satisfied and rejected the request for declaration of revocation for non-use. The applicant for cancellation appealed to the GC alleging infringement of Article 15(1)(a) EUTMR. The GC concluded that the shape is unusual and is reminiscent of an engine of an aeroplane rather than an oven. The distinctive character would therefore be high (para. 38 of the contested judgment) whereas the distinctive character of the term 'Bullerjan' is average (para. 40 of the contested judgment). Overall the GC held that the addition of the term 'Bullerjan' would not alter the distinctive character in a way that would infringe Article 15(1)(a) EUTMR and dismissed the application. The CJ found that the contested judgment contained a contradictory reasoning in a sensitive point. First of all it clarified that the question if the reasoning in a judgment is contradictory or insufficient is a matter of law, which may be brought before the CJ (para. 25). The GC found on one hand that the shape of the oven would be fanciful and highly distinctive independently of its functionality. It went on by stating that such conclusion would not be questionable due to the fact that other producers use very similar shapes, which might be a consequence of the technical function of the shape (para. 26). The CJ notes that the contested judgment does not explain why the relevant consumers would consider the shape of the oven as a strong indicator of its origin for the case in question, whereas a very similar shape used by the competitors would have a functional nature (para. 27). In the framework of the examination, if a mark used in the market is still to be considered as use of the mark as registered because it does not alter the distinctive character of the mark as registered according to Article 15(1)(a) EUTMR, the distinctive character of the registered mark and in particular its degree must be assessed previously (para. 29). Consequently, the reasoning in the contested judgment given in an aspect that is relevant for the examination of the conditions for the application of Article 15(1)(a) EUTMR is not clear and comprehensive (para. 30). For that reason, the contested judgment is to be annulled and the case referred back to the GC because the case may not be finally decided yet (paras 32 and 33).



2.3 *Ultra petita*

[C-280/15](#); **HolzProf**; Preliminary ruling of 22 June 2016; *Irina Nikolajeva v Multi Protect OÜ*; Language of the case: ET.

EUTM
HolzProf

The EUTM proprietor was granted the registration of the word mark **HolzProf**. The application of that trade mark was filed on 24 April 2010 and then published on 31 May 2010. The mark was registered on 14 September 2010 and the registration was published on 16 September 2010. On 24 April 2010, the applicant licensed the EUTM application to a third party for a monthly licensing fee. The EUTM proprietor brought an action against *Multi Protect* alleging unlawful use of its trade mark in the period of 3 May 2010 to 28 October 2011, applying for a declaration that an act of infringement had occurred, for damages based on unjust enrichment, and compensation for non-material harm. The questions referred to the CJEU:

1. Is an EUTM court required to issue the order provided for in Article 102(1) EUTMR [prohibiting the acts of infringement], if the applicant does not seek such an order in his claims and the parties do not allege that the defendant has infringed or threatened to infringe an EUTM after a specific date in the past, or does failure to make an application to that effect and to refer to this fact represent a ‘special reason’ within the meaning of the first sentence of this provision?
2. Is Article 9(3) EUTMR to be interpreted as meaning that the proprietor of an EUTM may demand only reasonable compensation from a third party on the basis of the second sentence of Article 9(3) EUTMR for use of a sign identical with the trade mark in the period from the publication of the application for registration of the trade mark until the publication of the registration of the trade mark, but not compensation for the fair market value of what has been gained as a result of the infringement and for damage, and that there is also no right to reasonable compensation for the period prior to publication of the application for registration of the trade mark?
3. What type of costs and other forms of compensation are included in reasonable compensation under Article 9(3) EUTMR, second sentence, and can this also encompass in certain circumstances (and if so, in which circumstances) compensation for non-material harm caused to the proprietor of the trade mark?

Findings of CJ: the CJ found that Article 102(1) EUTMR does not preclude an EUTM court from refraining, pursuant to certain principles of national procedural law, from issuing an order which prohibits a third party from proceeding with acts of infringement on the ground that the proprietor of the trade mark concerned has not applied for such an order before that court. Furthermore, the CJ concluded that the second sentence of Article 9(3) EUTMR must be interpreted as precluding the proprietor of an EUTM from being able to claim compensation for acts of third parties occurring before publication of an application for registration of a trade mark. In the case of acts of third parties committed during the period after publication of the application for registration of the mark concerned but before publication of its registration, the concept of ‘reasonable compensation’ in that provision refers to recovery of the profits actually derived by third parties from use of the mark during that period and excludes compensation for the wider harm such as, for example, moral prejudice.



◆[T-548/15](#); **Café del Sol / CAFE DEL SOL et al.**; Judgment of 13 December 2016; *Ramón Guiral Broto v EUIPO*; Language of the case: EN. The applicant sought to register the word mark **Café del Sol** as an EUTM for goods and services in Classes 30, 35, 41, 43 and 45. An opposition based on earlier figurative marks registered variously for goods and services in Classes 9, 25, 42 and 43 was filed pursuant to Article 8(1)(a) and (b) EUTMR. The OD partly upheld the opposition insofar as it related to *services for providing of food and drink, temporary accommodation, outside catering* in Class 43. Only one of the earlier marks was valid and substantiated, namely, Spanish trade mark registration No 2 348 110. The BoA upheld the applicant's appeal. It found that the only earlier mark upon which the OD had based its decision was not substantiated because the translations provided by the opponent left out indications of the colour of the mark. The BoA also confirmed that the other earlier marks were either no longer valid at the operative time or that they were not properly substantiated. Consequently, as all the earlier marks were either invalid or not substantiated, the opposition was dismissed as unfounded. The opponent filed an action before the GC relying on three pleas in law: (i) the contested decision is *ultra petita*; (ii) the documents submitted in order to prove the existence of the earlier mark were sufficiently probative and (iii) failure to respect the subordinate, instrumental and auxiliary nature of the procedural rules at issue and the possibility of remedying procedural irregularities. The GC upheld the appeal. It found that the contested decision was adopted in infringement of the principle that the parties should be heard and that the contested decision must be annulled owing to infringement of the applicant's rights of defence. The crux of the matter is that the BoA found that the earlier Spanish trade mark was not substantiated because the relevant translations left out indications of colour. The translation of the registration certificate omitted (i) 'azul' and 'blanco' (blue and white respectively) in the arrows shown above and (ii) the words 'y color azul' (and coloured blue) in the description field. **Ultra petita**: it was common ground that the BoA raised the absence of a translation of the colour claims of its own motion (para. 26). The opponent complained that, in doing so, the BoA overstepped its appellate function. The GC held that, in rejecting the opposition on that basis, the BoA did not exceed the scope of the appeal that had been brought before it (paras 21 to 26). The GC cited the settled principle that the effect of the appeal before the BoA was that the BoA is called upon to carry out a new, full examination of the merits of the opposition, in terms of both law and fact (para. 21). Furthermore, the matters of law put forward before the BoA include any question of law, which must necessarily be examined for the purpose of assessing the facts, evidence and arguments relied on by the parties and for the purpose of allowing or dismissing the claims, even if the parties have not put forward a view on that question and even if the Office has omitted to rule on that aspect (para. 25). The colour claims for the earlier mark at issue are amongst the facts which were submitted to the OD for the purpose of assessing whether there was a likelihood of confusion. They could therefore be taken into account by the BoA (para. 27). In addition, the obligation to translate those claims into the language of the proceedings is a matter of law. Compliance with that obligation is necessary in order to ensure a correct application of the EUTMR in the light of the facts, evidence and arguments provided by the parties and the relief sought since those claims may affect the assessment of whether there is a likelihood of confusion between the marks at issue. Furthermore, in the absence of a translation of those claims, the trade mark applicant may not have been able to defend itself adequately (para. 28).



2.4 Other

♦[T-816/14](#); **REAL HANDCOOKED / real; QUALITY**; Judgment of 24 February 2016; *Tayto Group Ltd. v OHIM*; Language of the case: EN. Both the OD and the BoA upheld the opposition. The EUTM applicant filed an action before the GC relying on three pleas in law. The GC dismissed as inadmissible and/or lacking any basis in fact or in law the first and the second pleas alleging infringement of general principles and misuse of power and infringement of Articles 76 and 83 of Regulation 207/2009 (paras 21 to 42).

3. General principles of Union Law

♦[T-237/15](#); **NANO**; Judgment of 22 September 2016; *Edward Labowicz v EUIPO, Pure Fishing, Inc.*; Language of the case: EN. The EUTM proprietor was granted the registration of the figurative mark **NANO** for a range of goods in Class 28 (in short, *fishing equipment*). An application for a declaration of invalidity was filed against the abovementioned mark for all of the goods. The CD declared the contested mark invalid for all the goods on the basis of Article 7(1)(b) and (c) EUTMR. The First BoA dismissed the appeal. The EUTM proprietor filed an application before the GC for the annulment of the decision of the BoA relying on three pleas in law: (i) infringement of Article 7(1)(c) EUTMR; (ii) infringement of Article 7(1)(b) EUTMR; and (iii) infringement of Articles 76 and 83 EUTMR and of Articles 6 and 14 of the Convention for the Protection of Human Rights and Fundamental Freedoms. **Article 76 EUTMR and Articles 6 and 14 ECHR**: the GC dismissed the claim of the applicant that the BoA erred in refusing to take into account the NANOFIL decision, which relates to the distinctive character of the element ‘NANO’ and was based on the same main items of evidence as those at issue in the present case. The GC found that, firstly, the applicant does not dispute that the NANOFIL decision was not final at the time when the contested decision was adopted and that the proceedings had been stayed specifically pending the outcome of the invalidity proceedings relating to the contested mark. Accordingly, the BoA could decide, as a precaution, to disregard the NANOFIL decision and the other evidence relating to it as precedents to be taken into consideration pursuant to the case-law cited above (paras 62 to 69). In the second place, it is, in any event, apparent the BoA’s finding that the contested mark came within the scope of the ground for refusal set out in Article 7(1)(c) EUTMR is not marred by error and is, in particular, consistent with the relevant case-law of the GC. For the same reasons, the applicant cannot rely on the allegedly established decision-making practice of the Office, the existence of which he has not, moreover, established (paras 71 and 72). In relation to the right to a fair hearing guaranteed by Article 6 of the Articles 6 and 14 ECHR, the GC noted that proceedings before the BoAs are administrative and not judicial in nature and rejected that claim.

♦[C-295/15](#); **ARKTIS**; Order of 22 June 2016; *Matratzen Concord GmbH v EUIPO*; Language of the case: DE. The applicant before the GC requested the revocation for non-use according to Article 51(1)(a) EUTMR of the EUTM **ARKTIS**, registered for goods in Classes 20 and 24. The CD revoked the mark partially for the goods in Class 20. It found that for the goods in Class 24 the EUTM had been used. The BoA confirmed the First Instance decision. The GC examined if the use is to be considered as genuine and stated that the volume of 3 490 *pillows and sleeping bags* (Class 20) confirms the position of the BoA that this constitutes a sufficient volume of use and cannot be considered as token use. The claim that the addition of the term ‘line’ would alter the distinctive character of the sign as used was rejected by the GC. This expression will also be understood in Germany, where the mark has been used, in



the sense as product line. The GC also quoted the case-law (case: T-19/99 Companyline; T-273/10 O-live). The addition is subordinated and the term 'ARKTIS' is dominant. The statement that the mark has been used by another company without consent of the proprietor was dismissed. The GC confirmed the case-law that from the fact that the proprietor has the information referring to the use of another company it may be inferred that such use has been done with its consent. Procedure before the CJ: the CJ applied Article 181 RPCJ according to which a manifestly inadmissible or manifestly unfounded appeal may be dismissed by reasoned order (paras 16 and 17). **Errors in additional reasoning:** the appellant puts forward that the GC erred when it stated in paragraph 44 that the appellant failed to contest the consent by the trade mark owner to use the mark by a third party. The CJ states that this reasoning is just an additional reason. Possible errors in additional reasoning do not have any impact in the operative part of the judgment and may not lead to its annulment. In any event, the GC was fully right to uphold the genuine use of the trade mark. According to constant case-law the proprietor would not be in possession of the evidence of use by a third party, unless it consented to it. Consequently, the proprietor's consent is implicit (paras 32 to 35).

B. Procedure before the EUIPO

1. Admissibility

1.1 Right to appeal, form, deadline

[T-277/15](#); **Terraway / TERRAWAY**; Order of 26 January 2016; *Permapore Ltd. v OHIM*; Language of the case: PT.

EUTM application	Earlier mark
	TERRAWAY

The applicant sought to register a figurative trade mark for goods in Classes 17 and 27 (represented above). An opposition based on Article 8(1)(a) and (b) EUTMR, was filed for part of the goods, namely those in Class 19, based on the earlier Portuguese and international trade mark **TERRAWAY**. On the 23/07/2014, the OD partly upheld the opposition as it found that there was a likelihood of confusion with the earlier mark for some goods of Class 19. The applicant filed the notice of appeal on the 23/09/2014, but did not pay the appeal fee at that time. The appeal fee was paid later on the 20/11/2014, when the applicant filed the written statements setting out the grounds of the appeal. The BoA found that the appeal had not been filed since the appeal fee had been paid outside the time limit, infringing Article 60 EUTMR and Rule 49(3) EUTMIR. The applicant filed an action before the GC. The GC referred to Article 60 EUTMR, which states that the notice for appeal should be filed within 2 months after the notification of the decision and the written statement setting out the grounds of the appeal must be filed within 4 months after the notification (para. 21). Rule 49(3) EUTMIR states that if the appeal fee is paid after the limit established in Article 60 EUTMR, the appeal should be deemed as not filed and the appeal fee will be



refunded to the applicant (para. 22). The GC stated that the appeal fee has to be paid within the time limit of 2 months established to file the notice of appeal in order for it to be deemed as filed, and not within the 4-month time limit to present the written statements of the appeal (para. 23). The GC further mentioned that the respect for the procedural time limits is of a public order nature and therefore, any other interpretation that lacks uniformity would harm legal certainty (para. 24). The GC dismissed the appeal as manifestly inadmissible (para. 27).

♦ [T-247/14](#); **STICK MiniMINI Fratelli Beretta 1812 GLI ORIGINALI / MINI WINI**; Judgment of 4 February 2016; *Meica Ammerländische Fleischwarenfabrik Fritz Meinen GmbH & Co. KG v OHIM*; Language of the case: EN. ‘Requests’ pursuant to Article 8(3) RPBoA should not be interpreted as consisting only of requests for proof of use, suspension or an oral hearing, as the wording of the provision makes no mention of this. Indeed, pursuant to Article 8(3) RPBoA, it is possible for the respondent before the BoA to seek a decision annulling or altering the contested decision on a point not raised in the appeal, this right not being limited to the pleas in law already raised by the appellant. However, such a possibility is limited to responses in inter partes proceedings. That is why the respondent’s submissions are to cease to have effect should the appellant discontinue the proceedings before the BoA. Thus separate proceedings pursuant to Article 60 EUTMR are the only legal remedy by which it is certain that the appellant’s objections may be asserted. It follows that the two provisions differ and that the conditions laid down in Article 60 EUTMR do not apply to submissions pursuant to Article 8(3) RPBoA. Consequently, the BoA erred when it rejected as inadmissible the opponent’s submissions seeking for an alteration of the decision of the OD because of the opponent’s failure to comply with the time limit or pay the fee for appeal provided for in Article 60 EUTMR. Those submissions were indeed admissible under Article 8(3) RPBoA (paras 17 to 28).

[T-703/15](#); **GO SPORT / GO**; Judgment of 6 December 2016; *Groupe Go Sport v EUIPO*; Language of the case: EN.

EUTM application	Earlier mark
GO SPORT	GO

The applicant filed an appeal against the decision of the OD, using the Office’s eComm system. On 19 May 2015, the applicant sent two electronic communications to the Office relating to the filing of the statement setting out the grounds of appeal. On 26 May 2015, the Office sent the applicant a letter informing it that its appeal was likely to be declared inadmissible because no statement of grounds of appeal had been filed, as only two cover sheets dated 19 May 2015, **with no attachments**, had been filed. On 18 June 2015, the applicant submitted its observations in reply to the letter of the Office of 26 May 2015 and attached a copy of a statement of grounds of appeal as well as English translations of two Office decisions. The BoA declared the appeal inadmissible. It was unable to conclude that a statement of grounds of appeal had been, or should be considered to have been, received within the set time limit and that the Office did not have any solid and objective evidence that the applicant had sent it any attachments with its communications of 19 May 2015. The BoA concluded that the applicant had failed to comply with Article 60 EUTMR. The applicant filed an action before the GC relying on a single plea in law, namely infringement of Article 60 EUTMR and Rule 49(1) EUTMIR by wrongly rejecting the appeal of the applicant. The GC dismissed the action. The applicant did not prove that the Office did not receive the



statement of grounds due to a technical failure of the Office's system (paras 34 to 47). When using the electronic communication system, the fact that there was no mention of there being no attachments was not such as to allow the applicant to take the view that attachments had been added to the message (para. 52). The applicant's argument that by filing the statement of grounds in good faith after the deadline expired cannot be accepted either (paras 55 to 74).

1.2 ***New facts, arguments, grounds or evidence***

♦[T-335/14](#); **DoggiS / DoggiS et al.**; Judgment of 28 January 2016; *José-Manuel Davó Lledó v OHIM*; Language of the case: ES. The EUTM proprietor was granted the registration of the figurative sign **DoggiS** as an EUTM for goods and services within Classes 29, 30 and 43. An application for invalidity was filed pursuant to Article 52(1)(b) EUTMR, based, inter alia, on the ownership of several earlier Brazilian, Chilean, Peruvian and Uruguayan figurative marks **DoggiS**, registered for goods in Classes 16, 25, 28, 29, 30, 32, 38, 39, 42, 43 and 60. The invalidity applicants alleged that the EUTM proprietor was acting in bad faith when applying for the contested mark and that the proprietor was aware of the existence of the earlier marks and the activities of the applicants at the time of filing. The CD rejected the application for a declaration of invalidity in its entirety. The BoA upheld the appeal, annulled the decision of the CD and declared the registration of the contested mark invalid. The invalidity applicants filed an action before the GC relying on two pleas in law: i) infringement of Article 76 EUTMR; ii) infringement of Article 52(1)(b) EUTMR. The GC rejected the first plea emphasising that the evidence adduced for the first time before the BoA by the invalidity applicants was actually relevant for the outcome of the dispute (para. 39) and that in fact such late production was mainly intended to address the CD's finding that they had not furnished sufficient proof (para. 38). The BoA was able to exercise its discretion objectively.

♦[T-169/13](#); **MOTO B / B MOTOB** **et al.**; Judgment of 2 February 2016; *Benelli Q.J. Srl v OHIM*; Language of the case: EN. The EUTM applicant sought to register the figurative mark **MOTO B** as an EUTM for goods in Classes 9, 12 and 25. An opposition in respect of these goods, based on the earlier Italian non-registered mark **B MOTOB**, among others, was filed on the grounds of, inter alia, Article 8(2)(c) EUTMR. The OD dismissed the opposition. The opponent appealed the decision before the BoA. The BoA dismissed the appeal. The opponent filed an application before the GC for the annulment of the decision of the BoA. The GC found that contrary to the BoA's conclusions based on the interpretation of Rules 19(4) and 20(1) EUTMR, it results from the wording of Article 76(2) EUTMR that the Office is not prohibited from taking account of facts and evidence that are submitted or produced late, but has discretion in this respect. It is clear however that the BoA also examined the relevance of all the material produced by the opponent, so that the latter cannot claim that the documents it submitted had not been regarded as additional evidence within the meaning of Rule 50(1) EUTMR (paras 37 to 51).

♦[T-171/13](#); **MOTOB B PESARO**; Judgment of 2 February 2016; *Benelli Q.J. Srl v OHIM*; Language of the case: EN. In 2001 The EUTM proprietor registered the figurative mark **MOTOB PESARO B** as an EUTM for goods in Classes 9, 12 and 25. In 2009, an application for revocation of the EUTM for these goods was filed on the grounds of Article 51(1)(a) EUTMR. The CD revoked the EUTM. The BoA dismissed the appeal. The EUTM proprietor



filed an application before the GC for the alteration or annulment of the decision of the BoA. The GC held, that as for goods falling within Classes 9 and 25, it is apparent from the various language versions that the additional or supplementary facts or evidence (Article 50(1) and Article 76(2) EUTMR), must supplement facts or evidence already submitted. In the present case, the evidence filed before the CD relating to the Class 25 clothing items was obviously irrelevant since it did not concern the trade mark at issue, the figurative aspects shown being moreover scarcely legible, and no evidence at all had been submitted as regards the Class 9 goods, with the result that the evidence produced for the first time before the BoA had to be declared inadmissible (paras 35 to 62).

◆ [T-322/14](#) and [T-325/14](#) (joined cases); **mobile.de / mobile**; Judgments of 12 May 2016; *mobile.international GmbH v EUIPO*; Language of the cases: DE. The owner of the earlier figurative Bulgarian trade mark **mobile** (Classes 35 and 42) filed a request for invalidity against the EUTMs **mobile.de** (word mark/figurative mark, Class 35 et al.) pursuant to Article 53(1)(a) in conjunction with Article 8(1)(b) EUTMR. Upon request from the EUTM proprietor, the invalidity applicant provided evidence of genuine use of its mark. The CD rejected the invalidity request in its entirety as it deemed genuine use of the earlier mark not proven, particularly regarding the extent of use. The invalidity applicant, before the BoA filed further evidence of use (81 invoices). The BoA considered the further evidence as ‘additional’, took it into account and accepted genuine use of the earlier mark for *advertising in connection with vehicles*. Consequently, the BoA annulled the CD decision and referred the case back to CD for further examination as regards likelihood of confusion. The EUTM proprietor filed an application before the GC, requesting the annulment of the BoA’s decision. It raised a total of seven pleas in law, amongst which the following: i) The evidence filed before the BoA was not ‘additional’, but ‘new’ (Rule 22(2)/Rule 40(6) EUTMR); ii) The BoA misapplied its discretion to take into account the further evidence (Article 76(2) EUTMR); iii) The BoA should have examined whether the ‘Declarations’ the invalidity applicant submitted — amongst others — for proving genuine use, have a ‘similar effect under National (Bulgarian) law’ as sworn/affirmed statements (Article 78(1)(f) EUTMR); iv) The use of the earlier mark alters the distinctive character of the registration (Article 15(1)(a) EUTMR). Concerning i) and (ii) as regards the claimed violation of Rule 22(2) EUTMR the GC reiterated its position — taken in C-610/11 ‘Centrotherm’ — that this Rule must be read as not precluding the invalidity applicant to submit relevant proof of use (POU) evidence, which is not completely new, but rather ‘additional’, supplementing the evidence already submitted before the CD. The Office has discretion (Article 76(2) EUTMR) to take belated evidence into account, if it is, *prima facie*, of real relevance for the outcome of the case and the circumstances do not speak against it (paras 23 to 30). In the present case, the invoices submitted for the first time before the BoA complement the (untranslated) lists of invoices submitted before the CD. The reference numbers of the invoices do — in their majority — appear in the lists and, thus, clarify the lists’ content. The particular circumstances of the case do not speak against taking into account the belated evidence. In light of a vast amount of evidence submitted before CD, it cannot be inferred that the invalidity applicant applied delaying tactics (paras 31 to 44).

◆ [T-567/14](#); **GROUP Company TOURISM & TRAVEL / GROUP Company TOURISM & TRAVEL**; Judgment of 29 June 2016; *Group OOD v EUIPO* and *Kosta Lliev*; Language of the case: BG. The applicant, sought to register the figurative trade mark **GROUP Company TOURISM & TRAVEL** for goods and services in Classes 35, 39 and 43. An opposition based on a non-registered figurative mark used in Bulgaria, Czech Republic, Hungary, Poland and Slovakia for services in Class 39 was filed pursuant to Article 41 EUTMR. The OD dismissed



the opposition insofar as the opponent had not provided any evidence of the applicable national law on which it was relying and under which the use of the mark sought might have been prohibited in the Member States concerned (para. 8). The BoA dismissed the appeal. It found that in the opposition proceedings the opponent had failed to make out proof of which national law was applicable. The opponent filed an action before the GC claiming the infringement of Article 8(4) EUTMR, Article 76(1) and (2) EUTMR. The GC annulled the decision of the BoA. The GC held that the particulars of the national legislation supplemented the initial evidence, which concerned the use in the course of trade of an unregistered sign, both sets of evidence being regarded altogether as ‘one piece of evidence proving the acquisition, permanence and the scope of the protection of an earlier right’ (para. 38). The BoA could therefore not rule out the admissibility of the content of the national law, submitted for the first time before it, without exercising its discretion under Article 76(2) EUTMR (paras 53 to 58). The GC also annulled the BoA’s decision in that the BoA had required the particulars of the national law to be submitted in the form of a document having an official source, drafted in its original language, together with a translation in the language of the proceedings. According to the GC, the production of the content of the national law is not subject to compliance with any specific formality. The mere citation of the national law in the notice of opposition and in the language of the proceedings satisfies the formal requirements set out under Rule 19(2)(d) EUTMIR. The Office must verify that the information provided by the parties regarding the content of the national legislation relied on is correct (paras 69 to 70 and 77 to 81). Furthermore, the GC stated that the BoA did err in concluding that the national provision, namely Article 12(6) of the Law on trade marks and geographical indications, applied only to well-known marks (para. 63). By examining the national law of its own motion, the BoA drew incorrect conclusions as to their content, thereby, infringing the obligation to make findings of its own motion and to apply strictly the law of the Member States, laid down in Article 76(1) EUTMR (para. 64). As a consequence, the BoA, on the one hand, failed to ascertain the relevance of the evidence about national law adduced by the applicant and, on the other hand, it disregarded the evidence, referring to a source of information that turned out to be inaccurate (para. 80).

♦ [C-597/14 P](#); **Bugui va / BUGUI et al.**; Judgment of 21 July 2016; *Xavier Grau Ferrer v EUIPO*; Language of the case: ES. The applicant sought to register the figurative mark **Bugui va** as an EUTM for goods and services in Classes 31, 35 and 39. An opposition based on earlier figurative marks registered for goods and services in Classes 31, 32 and 39 was filed pursuant to Article 8(1)(b) EUTMR. The OD partly upheld the opposition insofar as some of the contested goods in Class 31 and on the basis of the sole mark that had been substantiated, that is, the EUTM. The BoA upheld the applicant’s appeal and dismissed the opponent’s appeal. It confirmed that the existence of the earlier Spanish mark has not been proven and that the submitted documents did not prove genuine use of the earlier trade mark as registered. Thus, the opposition was rejected in its entirety. The opponent filed an action before the GC relying on three pleas in law: infringement of Article 75 and Article 76(2) EUTMR and Rule 50 EUTMIR; the genuine use of the earlier trade mark; and infringement of Article 8(1)(b) EUTMR. The GC dismissed the action. It found that the Office failed to exercise its discretion or to give reasons for its refusal to take account of the earlier Spanish mark and that the submitted documents proved genuine use of the marks. The GC annulled BoA decision. The Office filed an action before the CJEU. The CJ dismissed the appeal. The GC held essentially that the BoA had discretion and had an obligation to give reasons for its refusal without distinguishing between ‘additional’ evidence and ‘supplementary’ evidence (para. 21). The CJ recalls that where there is divergence between the various language versions of an EU legislative text, as it happens concerning the wording of Rule 50(1), third paragraph, of the EUTMIR, the provision in question must be interpreted by reference to the



purpose and general scheme of the rules of which it forms part (paras 23 to 24). The CJ confirmed that Article 76(2) EUTMR should be interpreted in relation to proof of the existence, validity and scope of protection of a trade mark as it has been interpreted in relation to proof of use, since that provision contains a rule which applies horizontally within the scheme of that regulation, inasmuch as it applies irrespective of the nature of the proceedings concerned. As a consequence, Rule 50 EUTMIR cannot be interpreted as meaning that it extends the discretion of the BoAs to new evidence. Thus, the GC erred in law by holding that the BoA had failed to exercise the discretion conferred on it to decide whether or not it was appropriate to take additional evidence into consideration (paras 25 to 28). However, since the BoA rejected the evidence at issue without examining whether it could be regarded as being ‘supplementary’, by failing to undertake that examination, it infringed Article 76(2) EUTMR as the GC held. Consequently, the appeal is dismissed in its entirety.

♦[T-400/15](#); **CITRUS SATURDAY / CITRUS**; Judgment of 28 September 2016; *Ana Isabel Pinto Eliseu Baptista Lopes Canhoto v EUIPO*; Language of the case: EN. The applicant sought to register the word mark **CITRUS SATURDAY** as an EUTM for goods in, inter alia, Class 25. An opposition based on the earlier word mark **CITRUS** registered for goods in Class 25, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition as unsubstantiated as the opponent had not submitted a translation of the certificate of registration of the earlier mark into the language of the proceedings within the period prescribed for that purpose. The translation reached the Office on 21 May 2014 although the time limit expired on 12 May 2014. The BoA dismissed the opponent’s appeal. It found that the OD had correctly rejected the opposition as unfounded pursuant to Rule 20(1) EUTMIR. The opponent filed an action before the GC relying on two pleas in law: (i) infringement of Rules 19 and 20 EUTMIR and of Article 76 EUTMR and (ii) infringement of Article 21, Article 41(1) and Article 47 of the Charter of Fundamental Rights of the European Union and of Article 18 TFEU. **Regarding the infringement of Rules 19 and 20 EUTMIR and of Article 76 EUTMR:** the opponent argued that the translations in question, that is, certificate of registration of the earlier mark should have been regarded as admissible evidence, given that (i) they had been sent before the expiry of that period, (ii) the context in which they had been submitted [a delay on the part of the postal services] justified the delay in their being received by the Office and (iii) the BoA should, in any event, have proceeded to examine those documents of its own motion pursuant to Article 76 EUTMR. Firstly, the GC found that the fact that the translations were sent within the prescribed period, is irrelevant, given that only the receipt of those documents by the Office is to be taken into account (para. 22). The interpretation that it is the date on which a document is filed with the Office which is to be taken into account is consistent with the general scheme of the EUTMR and EUTMIR (para. 25). Secondly, the submission of facts and evidence by the parties in relation to substantiation remains possible after the expiry of the relevant time limits under EUTMR and the Office is in no way prohibited from taking account of facts and evidence that are submitted late (paras 29 to 30). Nevertheless, where an opposition is based on an earlier national registered trade mark, the evidence of the existence, validity and scope of protection of that mark which must be submitted during the opposition proceedings is set out precisely and exhaustively in Rule 19(2)(a)(ii) and Rule 19(3) EUTMIR, so that an opponent is in a position to be aware of the specific documents which it must produce in support of that opposition. Consequently, the BoA must, in those circumstances, exercise its discretion restrictively and may allow the late submission of such documents only if the surrounding circumstances are likely to justify the delay that has occurred in the submission of proof (para. 33). The circumstances surrounding the late receipt of the documents in question — even considering postal delays — did not constitute a legitimate reason capable of justifying



the submission of the documents after the expiry of the period prescribed for that purpose. In particular, the circumstances did not constitute exceptional circumstances capable of interrupting or disrupting the proper functioning of the Office for the purposes of Rule 72 EUTMIR (para. 34). Thirdly, as regards the opponent's assertion that the BoA infringed Article 76(1) EUTMR by refusing to examine the facts of its own motion. In that regard, it is sufficient to note that it is apparent from that provision that the obligation for the Office to examine facts of its own motion is restricted to relevant facts that could lead to it applying absolute grounds for refusal to the examination of an EUTM application carried out by the examiners and, on appeal, by the BoA during the procedure for the registration of that mark. However, in the context of opposition proceedings, it is for the proprietor of the earlier trade mark to prove the existence, validity and scope of protection of that mark (para. 38). In any event, it should be borne in mind that the opponent also had the possibility of sending the Office the proof in question by personal delivery, by fax or by any other means, including electronically, so that an alleged discrimination on grounds of nationality, connected with the delivery times for communications sent by post, is excluded (para. 52).

♦ [T-476/15](#); **FITNESS**; Judgment of 28 September 2016; *European Food S.A. v EUIPO*; Language of the case: EN. The cancellation applicant sought to invalidate the EUTM registration of the word mark **FITNESS** in relation to all the registered goods in Classes 29, 30 and 32 on the basis of Article 7(1)(b) and (c) EUTMR in conjunction with Article 52(1)(a) EUTMR. The CD dismissed the application for invalidity since the applicant failed to prove the descriptive and non-distinctive character of the mark at the relevant point in time. The BoA dismissed the appeal and disregarded the evidence filed for the first time before the BoA since it was belated and new (for the first time it related to the relevant point in time); therefore it was not considered as complementary evidence. The applicant filed an action before the GC relying on three pleas in law, (i) an infringement of Article 76 EUTMR, read in conjunction with Rule 37(b)(iv) and Rule 50(1) EUTMIR, (ii) an infringement of Article 7(1)(b) EUTMR and (iii) an infringement of Article 7(1)(c) EUTMR. The applicant claimed, inter alia, that (i) the Office should have carried out an examination of its own motion and should have taken into consideration the evidence filed for the first time before the BoA, (ii) Rule 37(b)(iv) EUTMIR does not preclude the applicant for a declaration of invalidity filing additional evidence before the BoA and (iii) the third subparagraph of Rule 50(1) EUTMIR clearly refers to opposition and not to invalidity proceedings. **Belated evidence**: the GC confirmed that contrary to what the applicant claimed, in the invalidity proceedings, the BoA is not required to examine of its own motion the relevant facts which might have led it to apply the absolute grounds for refusal (para. 49). However, it is in no way apparent from Rule 37(b)(iv) EUTMIR that the BoA is required to regard any evidence submitted after the filing of the application for a declaration of invalidity, either before the CD or before the BoA as belated. That rule states merely that the application for a declaration of invalidity must include the evidence on which it is based (para. 55). Neither EUTMR nor EUTMIR contain any provisions setting a time limit for the production of evidence in relation to an application for a declaration of invalidity based on an absolute ground for refusal (para. 56). Article 76 EUTMR read in conjunction with Rule 37(b)(iv) EUTMIR does not imply that evidence submitted for the first time before the BoA must be regarded as belated in invalidity proceedings based on an absolute ground for refusal (para. 58). Contrary to the position of the Office, the third subparagraph of Rule 50(1) EUTMIR should not have been applied by analogy by the BoA for two reasons. First, the relevant provision expressly refers to appeal proceedings against a decision of the OD and not to appeal proceedings against a decision of the CD concerning an absolute ground for refusal. The wording of the provision reflects the express intention of the EU legislature (paras 61 to 62). Second, the nature and purpose of invalidity proceedings based on absolute grounds for refusal do not permit the application by analogy of the third



subparagraph of Rule 50(1) EUTMIR to an appeal against a decision of the CD concerning an absolute ground for refusal. To apply this provision by analogy would run counter to the public interest pursued by the absolute grounds for refusal, and therefore it was wrong to invoke that provision (paras 64 to 65). From the above, the GC found that the BoA erred in holding that the evidence produced before the BoA for the first time was not to be taken into consideration because of its late submission (para. 66). The GC noted that it is not inconceivable that the evidence wrongly refused by the BoA may be such as to modify the substance of the contested decision and that it is not for the GC to replace the Office in assessing the evidence in question (para. 68). The GC upheld the appeal under the first plea in law and stated that there was no need to rule on the second and third pleas in law.

♦T-67/15; POLO CLUB SAINT-TROPEZ HARAS DE GASSIN / BEVERLY HILLS POLO CLUB et al.; Judgment of 10 November 2016; *Polo Club, established in Gassin (France) v EUIPO*; Language of the case: EN. The applicant sought to register the figurative mark **POLO CLUB SAINT-TROPEZ HARAS DE GASSIN** as an EUTM for goods and services, inter alia, in Classes 3 and 41. An opposition based on, inter alia, an earlier EU figurative mark, registered for goods and services, inter alia, in Classes 3 and 41, was filed pursuant to Article 8(1)(b) EUTMR. The opponent opposed all goods and services and claimed enhanced distinctiveness for the earlier marks. The OD dismissed the opposition in its entirety finding that there was no likelihood of confusion. The OD refused to take into account additional evidence of enhanced distinctiveness filed by the opponent in reply to the request for proof of use of the earlier marks because it was filed outside the time limit to substantiate the opposition. The OD then found insufficient evidence to demonstrate that the earlier marks had enhanced distinctive character as a result of use. In the absence of sufficient admissible evidence to establish enhanced distinctive character, the signs at issue were insufficiently similar to find that there was a likelihood of confusion, even if the goods and services concerned were identical. The BoA annulled the decision of the OD. It allowed the opposition insofar as it is directed against goods and services in Classes 3 and 41 and remitted the case to the OD as to the remainder. The BoA found that the OD could not rely on the mere failure to observe the time limit as a ground for refusing to take the additional evidence on enhanced distinctiveness into account and noted that it would be artificial and over formalistic to divide the whole body of evidence into the evidence that is admissible only for the purpose of showing genuine use of the earlier mark but is then ignored for the purpose of assessing the enhanced distinctive character of the earlier mark. The BoA accepted the additional evidence. The opponent filed an action before the GC relying on two pleas in law alleging (i) an infringement of Article 8(1)(b) EUTMR and (ii) infringement of the procedural rules governing opposition proceedings relating to the BoA's acceptance of belated evidence relating to enhanced distinctiveness of the earlier mark. The GC dismissed the appeal. It found that there was a likelihood of confusion for the goods and services in Classes 3 and 41 under Article 8(1)(b) EUTMR. As regards the second plea, the GC cited case-law establishing that Article 76(2) EUTMR grants the Office broad discretion to decide, while giving reasons for its decision in that regard, whether or not to take belated evidence into account (para. 99). It held that Rule 20(1) EUTMIR does not constitute a provision to the contrary, within the meaning of said case-law, precluding the Office from using its discretion under Article 76(2) EUTMR for the purposes of taking into account facts and evidence relied on or produced late (para. 100). The GC found that the BoA had been incorrect to find that the discretion in question stemmed from the third subparagraph of Rule 50(1) EUTMIR because the latter does not apply to the OD (para. 101). Nevertheless, considering that Rule 20(1) EUTMIR does not constitute a 'provision to the contrary', the BoA was entitled to consider the belated evidence especially considering the following: The opponent had proven the existence, validity and scope of the earlier marks' protection within the substantiation



period (para. 103); the opponent had filed evidence on the highly distinctive character of the earlier marks within the time limit initially set. Consequently, the evidence submitted outside that time limit was additional evidence that complemented evidence already filed (para. 105); it is apparent from the case-law that, where a party disputes evidence filed by another party within a time limit, this can justify production of additional complementary evidence (para. 106); the material produced late is, on the face of it, likely to be genuinely relevant to the outcome of the opposition and the stage of the proceedings at which that late submission takes place and the circumstances surrounding it do not argue against such matters being taken into account (paras 108 to 114); as to the lack of an explanation as to why the opponent was unable to submit the evidence in question at an earlier stage of the proceedings, even if the lack of such an explanation were relevant to the production of additional evidence concerning the enhanced distinctive character of the earlier marks — not the existence, validity and scope of their protection — it is sufficient to note that the intervener produced that evidence at the first opportunity open to it in order to respond to the applicant's criticisms of the initial evidence. In light of the foregoing considerations, the second plea was also rejected.

♦[T-769/15](#); **Dolokorn / DOLOPUR**; Judgment of 24 November 2016; *SeNaPro GmbH v EUIPO*; Language of the case: DE. The applicant sought to register the word mark **Dolokorn** as an EUTM for goods in Class 1, among which *manures; fertilisers for soil and Inorganic fertilisers*. An opposition based on the earlier trade mark **DOLOPUR**, registered for goods and services in Classes 1, 3, 5, 19 and 40 was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition insofar as the signs were considered to be similar and the goods identical. The BoA dismissed the applicant's appeal. It did not take into account the applicant's argument, according to which the prefix 'DOLO' would make express reference to 'dolomite' rock, on the ground that it had been put forward for the first time right before the BoA. The applicant filed an action before the GC relying on a single plea in law: infringement of Article 75 and Article 76(1) and (2) EUTMR. The GC dismissed the appeal. The GC found that the applicant was substantially claiming an infringement of Article 8(1)(b) EUTMR (para. 14). In light of the two hypotheses taken into account by the BoA, the GC concluded that rightly the signs in conflict have been considered similar, regardless how the term 'DOLO' will be understood by the public. On the other side, the GC stated that the BoA wrongly ignored the new argument concerning the meaning of the term 'DOLO', which the applicant put forward for the first time within the appeal (para. 25). Nevertheless, the GC concluded that even if the BoA had accepted and taken into account that argument, its final decision on the existence of the likelihood of confusion would have not been different (para. 26).

2. **Essential procedural requirements**

2.1 **Right to be heard**

♦[T-240/15](#); **SHAPE OF A BAR WITH FOUR CIRCLES (3D MARK)**; Judgment of 1 June 2016; *Grupo Bimbo, S.A.B. v EUIPO*; Language of the case: ES. The applicant sought to register the shape of a bar with four circles as a three-dimensional mark for goods in Classes 5, 29 and 30. The Office refused the registration of the EUTM application for all of the goods pursuant to Article 7(1)(b) EUTMR. The BoA dismissed the appeal. The BoA considered that the mark applied for was not substantially different from certain basic forms of those products but was rather a variant of them or which had a utilitarian function. The



applicant filed an action before the GC claiming an infringement of Article 7(1)(b) EUTMR, a violation of its right of defence and an infringement of the obligation to state reasons. The action was dismissed in its entirety by the GC. The GC did not find any evidence of an infringement of the right of defence (paras 62 to 63).

♦ [T-549/15](#); **CAFE DEL SOL / Café del Sol et al.**; Judgment of 13 December 2016; *Ramón Guiral Broto v EUIPO*; Language of the case: EN. The applicant sought to register the figurative mark **CAFE DEL SOL** as an EUTM for goods and services in Classes 30, 35, 41, 42, 43 and 45. An opposition based, among others, on the earlier figurative mark represented above, registered for various goods and services in Classes 9, 25, 42 and 43 was filed pursuant to Article 8(1)(a) and (b) EUTMR. The OD partly upheld the opposition insofar as it related to *services for providing of food and drink, temporary accommodation, outside catering* in Class 43. Only one of the earlier marks was valid and substantiated, namely, Spanish trade mark registration No 2 348 110. The BoA upheld the applicant's appeal. It found that the only earlier mark upon which the OD had based its decision was not substantiated because the translations provided by the opponent left out indications of the colour of the mark. The BoA also confirmed that the other earlier marks were either no longer valid at the operative time or that they were not properly substantiated. Consequently, as all the earlier marks were either invalid or not substantiated, the opposition was dismissed as unfounded. The opponent filed an action before the GC relying on three pleas in law: (i) the contested decision is *ultra petita*; (ii) the documents submitted in order to prove the existence of the earlier mark were sufficiently probative and (iii) failure to respect the subordinate, instrumental and auxiliary nature of the procedural rules at issue and the possibility of remedying procedural irregularities. The GC upheld the appeal. It found that the contested decision was adopted in infringement of the principle that the parties should be heard and that the contested decision must be annulled owing to infringement of the applicant's rights of defence. The crux of the matter is that the BoA found that the earlier Spanish trade mark was not substantiated because the relevant translations left out indications of colour. The translation of the registration certificate omitted (i) 'azul' and 'blanco' (blue and white respectively) in the arrows shown above and (ii) the words 'y color azul' (and coloured blue) in the description field. *Audiat et altera pars (audi alteram partem)*: the second sentence of Article 75 EUTMR provides that decisions of the Office are to be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments. It was not disputed that the BoA declared the opposition unfounded pursuant to Rule 19 and Rule 20(1) EUTMIR without having heard the opponent on the incompleteness of the translation. The fact that the opponent was not heard on that issue constitutes a procedural irregularity (para. 31). The latter procedural irregularity constitutes an infringement of the rights of defence only provided that the failure to take into account the view of an interested party has had a concrete effect on the ability of that party to defend himself (para. 32). In the present case, considering the BoA's discretion to admit evidence not presented within the time limits, if the opponent had been heard on the absence of a translation of the indications of colour for his earlier mark, he would have submitted a translation of those indications, which might have been accepted by the BoA and might therefore have led to the opposition proceedings resulting in a different outcome (para. 39). Consequently, the contested decision was adopted in infringement of the principle that the parties should be heard (para. 40). As regards the other heads of claim that the GC should declare or order the opposition admissible, confirm the decision of the OD and allow the evidence submitted in the course of the administrative proceedings, in view of the BoA's infringement of the opponent's rights of defence, the GC is not in a position to determine, on the basis of the matters of fact and of law as established, what decision the BoA was required to take. Consequently, those heads of claim must be rejected.



2.2 Adequate reasoning

♦[T-687/14](#); **AFRICAN SIMBA / SIMBA et al.**; Judgment of 28 January 2016; *Novomatic AG, v OHIM*; Language of the case: DE. The EUTM applicant sought to register a figurative mark with the verbal elements ‘AFRICAN SIMBA’ for goods in Class 28. The opponent based its opposition, inter alia, on Article 8(1)(b) EUTMR using, inter alia, an earlier German figurative mark registered for goods in Class 28. The opposition was directed against all the goods covered by the EUTM application. The OD upheld the opposition. The BoA dismissed the applicant’s appeal, finding that there was a likelihood of confusion, taking into account, the identity of the goods and the similarity between the signs. The applicant appealed to the GC, putting forward two pleas in law: (i) an alleged infringement of Article 75 EUTMR and (ii) an alleged infringement of Article 8(1)(b) EUTMR. **Infringement of Article 75 EUTMR:** concerning the duty to state reasons, the GC confirms the constant case-law that the reason behind this procedural requirement lies in two main aspects. One is to explain to the parties the reasons for the decision and the measure taken in it and secondly to enable the control of legality by the higher instances (para. 21). However, lack of reasoning has to be distinguished from wrong reasoning. A wrong reasoning is not equivalent to the lack of any reasoning and does not lead automatically to the annulment of the contested decision (para. 22). The GC stated that the BoA explained why it deemed the goods to be identical. Also concerning the conceptual comparison, the decision explains why none of the marks have any concept (para. 23 to 27). The GC concluded that the claim of lack of reasoning is to be dismissed (para. 28).

♦[T-169/13](#); **MOTO B / B MOTOBİ et al.**; Judgment of 2 February 2016; *Benelli Q.J. Srl v OHIM*; Language of the case: EN. The EUTM applicant sought to register the figurative mark **MOTO B** as an EUTM for goods in Classes 9, 12 and 25. An opposition in respect of these goods, based on the earlier Italian non-registered mark **B MOTOBİ**, among others, was filed on the grounds of, inter alia, Article 8(2)(c) EUTMR. The OD dismissed the opposition. The opponent appealed the decision before the BoA. The BoA dismissed the appeal. The opponent filed an application before the GC for the annulment of the decision of the BoA. The GC found that the BoA duly motivated its decision when it held, first, that the additional evidence did not provide any information on the market share held by the marks at issue or the proportion of the relevant section of the public who, because of the marks, identified the goods at issue as originating from the applicant’s undertaking before the filing date of the contested trade mark application, next, that no turnover or advertising figures were given and, lastly, that the evidence submitted contained no indication regarding the degree of knowledge or recognition of the mark in the relevant sector of the public (paras 34 to 36).

♦[C-252/15 P](#); **SMART WATER**; Judgment of 17 March 2016; *Naanzeen Investments Ltd v OHIM*; Language of the case: EN. The EUTM proprietor was granted the registration of the word mark **SMART WATER** for goods in Class 32. An application for revocation was filed pursuant to Article 51 EUTMR. The CD upheld the application for revocation and revoked the EUTM due to non-use. This decision was confirmed by the BoA and the GC. The EUTM proprietor filed an appeal before the CJEU. The CJ confirms that where the first instance decision is confirmed, it forms part of the context known to the parties (para. 31). The appellant has not disputed the sufficiency of the reasoning of the adjudicating bodies of the EUIPO (para. 32). The CJ further confirms that the Office’s obligation to state reasons may



be discharged without explicitly and exhaustively addressing all its arguments; moreover, the appellant did not identify the specific arguments, which the BoA did not address, nor has it shown how the alleged failure to state reasons affected the exercise of its right of appeal (para. 34).

♦♦[T-501/13](#); **WINNETOU**; Judgment of 18 March 2016; *Karl-May-Verlag GmbH v OHIM*; Language of the case: DE. Although it had not been invoked by the applicant, the GC, on its own motion, went on discussing whether the BoA's reasoning as to the descriptiveness of **WINNETOU** for all the goods and services [being perceived by the relevant public as connected with concepts of 'Native American' and 'Native American Chieftain'] was sufficient or rather constituted an infringement of the obligation to state reasons (Article 75 EUTMR). The GC criticised, first, that the BoA did not carry out any specific analysis that the sign **WINNETOU**, beyond its concrete meaning as an evocation of a fictional character, was indeed perceived as connected with the concepts of 'Native American' and 'Native American Chieftain' (para. 59). Second, the BoA gave only a general statement of reasons, particularly for 'merchandising' goods. A general reasoning can only extend to goods and services that have a sufficiently direct and specific link to each other to the point that they form a sufficiently homogenous category. The goods qualified as 'merchandising' articles by the BoA [e.g. *perfumery, jewellery, walking sticks, calculating machines, kitchen containers, meat, confectionery*] do not show such a sufficiently direct and specific link as to consider them a homogeneous category of goods, for which an overall general statement would suffice. The goods rather display obvious differences as regards their nature, characteristics, intended purpose and methods of marketing (paras 70 to 72). Moreover, the BoA's reasoning as to the direct and specific link between those goods and the sign **WINNETOU** [BoA: 'goods are connected to films or the book character with regard to which the consumer will assume that they are merely 'Winnetou' advertising goods and will not deduce the origin of the goods'] is excessively general and abstract. Such general assertions, devoid of any specific analysis in relation to the nature and characteristics of the goods in question, are inadequate and do not make it possible to understand why the BoA found a sufficiently direct and specific link of **WINNETOU** with the goods concerned (paras 73 to 75). The assertions that goods such as *clothing, nutcrackers* or *foodstuff* are sold in souvenir shops or festivals do not make it possible to understand more precisely, clearly and unequivocally, the reasoning of the BoA, which led it to the conclusion that the contested mark, which, moreover, is a word mark and not a figurative mark representing a 'Native American', is descriptive of those goods (para. 79). It must therefore be held that the contested decision is also vitiated by an inadequate statement of reasons (para. 80). Based on the foregoing, the GC annulled the contested decision insofar as it rejected the application for a declaration of invalidity.

♦♦[T-331/15](#); **THE SNACK COMPANY**; Judgment of 26 May 2016; *Bimbo, S.A. v EUIPO*; Language of the case: ES. The sign THE SNACK COMPANY was applied for under the general headings in Classes 29 and 30. It was rejected by the examiner as being descriptive for the goods for which protection was sought and devoid of distinctiveness for the relevant English-speaking consumer in the European Union. The BoA confirmed the examiner's decision except as regards 'coffee', 'tea' and 'ice' in Class 30 for which it found that this decision was lacking of reasoning and gave the case back to the first instance. The GC found that there is no infringement of Article 75 EUTMR because the BoA was not obliged to reply to the applicant's argument on registration at national level of other equivalent signs (paras 58 to 60).



♦[T-240/15](#); **SHAPE OF A BAR WITH FOUR CIRCLES (3D MARK)**; Judgment of 1 June 2016; *Grupo Bimbo, S.A.B. v EUIPO*; Language of the case: ES. The applicant sought to register the shape of a bar with four circles as a three-dimensional mark for goods in Classes 5, 29 and 30. The Office refused the registration of the EUTM application for all of the goods pursuant to Article 7(1)(b) EUTMR. The BoA dismissed the appeal. The BoA considered that the mark applied for was not substantially different from certain basic forms of those products but was rather a variant of them or which had a utilitarian function. The applicant filed an action before the GC claiming an infringement of Article 7(1)(b) EUTMR, a violation of its right of defence and an infringement of the obligation to state reasons. The action was dismissed in its entirety by the GC. The GC did not find any evidence of an infringement of the obligation to state reasons (para. 67).

♦[T-510/14](#) and [T-536/14](#) (joined cases); **PARK REGIS / ST. REGIS et al.**; Judgments of 2 June 2016; *Staywell Hospitality Group Pty Ltd v EUIPO* and *Sheraton International IP, LLC v EUIPO*; Language of the cases: EN. The EUTM applicant sought to register the figurative mark **PARK REGIS** as an EUTM for services in Classes 35, 36 and 43. The opponent filed an opposition based on the earlier figurative and word marks **ST. REGIS** on the grounds of Article 8(1)(b) EUTMR. The OD upheld the opposition for a part of the relevant services. Both the applicant and the opponent filed an appeal. The BoA joined the appeals and dismissed them. The applicant filed an action before the GC in Case T-510/14. The opponent filed an action before the GC in Case T-536/14. In Case T-536/14, concerning the first plea alleging the infringement of Article 64(1) EUTMR (before amendment), the claim in essence was that the BoA failed to examine the similarity between some services. The GC recalled that, following the examination as to the allowability of the appeal, the BoA is to decide on the appeal, and that it may either exercise any power within the competence of the OD or refer the case back to that division for further action. Therefore, when, as in the present case, the BoA confirms a lower-level decision of the Office in its entirety, that decision, together with its statement of reasons, forms part of the context in which the BoA decision was adopted, which is known to the parties and enables the GC to carry out fully its judicial review as to whether the BoA's assessment was well founded. By endorsing the ODs analysis of the comparison of the services, the BoA did examine the action and ruled on it pursuant to Article 64(1) EUTMR (para. 30). This plea was rejected.

♦[T-654/14](#); **REVOLUTION**; Judgment of 2 June 2016; *Revolution LLC v EUIPO*; Language of the case: EN. The applicant sought to register the word mark **REVOLUTION** as an EUTM for services in Class 36. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b) EUTMR, as it was found to be devoid of distinctive character. The BoA dismissed the applicant's appeal. It found that the mark was not distinctive for the services applied for. The applicant filed an action before the GC relying on infringement of Article 7(1)(b) EUTMR as well as on the breach of the general principles of equal treatment, good administration and legal certainty and infringement of Article 75 EUTMR. The GC dismissed the appeal. **Second plea: Breach of the general principles of equal treatment, good administration and legal certainty and infringement of Article 75 EUTMR.** The GC confirmed the standard case-law according to which the legality of the decisions of the BoA must be assessed solely on the basis of the EUTMR, as interpreted by the Union judicature. Article 75 EUTMR was not breached either, as the statement of reasons discloses clearly and unequivocally the reasoning adopted by the BoA in rejecting the registration of the mark applied for and enables the applicant to have knowledge of the reasons leading the BoA to take that decision and the GC to review it (paras 54 to 66).



♦ [T-129/15](#) and [T-130/15](#) (joined cases); **WAVE 2 PAY** and **WAVE TO PAY**; Judgments of 28 September 2016; *Intesa Sanpaolo SpA v EUIPO*; Language of the cases: IT. An application for registration of the word marks **WAVE 2 PAY** and **WAVE TO PAY** as EUTMs was filed for a range of goods and services in Classes 9, 16, 36 and 38. The BoA confirmed the partial refusal of the marks applied for, due to their descriptive nature and also due to their lack of distinctiveness in relation to a part of the goods and services. The applicant put forward three pleas in law, alleging (i) an infringement of Article 7(1)(c) EUTMR, (ii) an infringement of Article 7(1)(b) EUTMR, (iii) an infringement of Article 75 EUTMR. **Article 75 EUTMR**: the GC noted that it was explained in the contested decision that all the relevant goods and services can be used to make the payment operating or that they may be accessible by means of that method of payment. Therefore, the GC concluded that the BoA did provide a global motivation applicable to all the goods and services at issue and dismissed also the third and last plea of the applicant (paras 42 to 44).

♦ [T-461/15](#); **DEVICE OF FOUR INTERLOCKING Gs / GG**; Judgment of 11 October 2016; *Guccio Gucci SpA v EUIPO and Guess? IP Holder LP*; Language of the case: EN. The applicant for invalidity, the owner of the earlier rights, sought to invalidate the mark of the EUTM proprietor, registered for goods within Classes 3, 9, 14, 16, 18, 25 and 35. The action for invalidity was based on the earlier marks, registered in the European Union for goods in, inter alia, Classes 3, 9, 16, 18 and 25, and was filed on the grounds of 8(1)(b) EUTMR and Article 8(5) EUTMR. The CD rejected the application for invalidity. The BoA dismissed the applicant for invalidity's appeal. The applicant for invalidity filed an action before the GC based on three pleas in law: (i) infringement of Article 75 EUTMR, (ii) infringement of Article 8(1)(b) EUTMR and (iii) infringement of Article 8(5) EUTMR. As regards the first plea, the GC held that the BoA did not infringe its duty to state reasons, as it duly explained why the signs are to be considered as different, without being obliged to answer to all the arguments of the applicant for invalidity.

♦ [T-753/15](#); **DEVICE OF FOUR INTERLOCKING Gs / GG**; Judgment of 11 October 2016; *Guccio Gucci SpA v EUIPO and Guess? IP Holder LP*; Language of the case: EN. The applicant, sought to register a figurative mark as an EUTM for goods within Class 9. The opposition was based on earlier figurative marks, registered in the EU for goods in, inter alia, Classes 9, 18 and 25, and was filed on the grounds of Article 8(1)(b) EUTMR and Article 8(5) EUTMR. The OD upheld the opposition in its entirety. The BoA upheld the applicant's appeal. The opponent filed an action before the GC based on three pleas in law: (i) infringement of Article 75 EUTMR, (ii) infringement of Article 8(1)(b) EUTMR and (iii) infringement of Article 8(5) EUTMR. As regards the first plea, the GC held that the BoA did not infringe its duty to state reasons, as it duly explained why the signs are to be considered as different, without being obliged to answer to all the arguments of the applicant for invalidity.

♦ [T-617/15](#); **eSMOKINGWORLD**; Judgment of 29 November 2016; *Chic Investments sp. z o.o., v EUIPO*; Language of the case: PL. The BoA confirmed the refusal of the registration for the EUTM application **eSMOKINGWORLD** (figurative mark) for goods in Classes 35 and 41 pursuant to Article 7(1)(b) and (c) EUTMR. The trade mark applied for informs the target public about the nature and purpose of the contested services, namely the relation to electronic cigarettes. The figurative elements are too simple to divert the consumer's attention from the descriptive message of the word element and may even be associated with a cigarette. The EUTM applicant filed an action before the GC based on two pleas in



law: (i) an infringement of Article 75 EUTMR in conjunction with Article 41(2)(c) of the EU Charter of Fundamental Rights and (ii) an infringement of Article 7(1)(b) EUTMR. As regards the alleged infringement of Article 75 EUTMR in conjunction with Article 41(2)(c) of the EU Charter of Fundamental Rights the GC decided that the reasoning of the contested decision applies, at least implicitly, to all services (para. 87) which form a sufficiently homogenous category (para. 95). The reasoning does not need to mention all arguments of the party if they are not relevant for the outcome (para. 102).

♦[T-529/15](#); **START UP INITIATIVE**; Judgment of 15 December 2016; *Intesa Sanpaolo v EUIPO*; Language of the case: IT. The EUTM applicant sought to register the figurative mark **START UP INITIATIVE** as an EUTM for services in Classes 35, 36, 41 and 42. The examiner refused the application for all the services on the basis of lack of distinctive character. The First BoA dismissed the appeal. The EUTM applicant filed an application before the GC for the annulment of the decision of the BoA relying on two pleas in law: (i) infringement of Article 75 EUTMR, and (ii) infringement of Article 7(1)(b) EUTMR. As regards the first plea, the GC found that the decision of the BoA was sufficiently reasoned in accordance with the requirements set out under Article 75. The GC recalled the case-law according to which the Office has in principle to motivate the refusal in relation to each of the relevant goods and services. However, a global reasoning is permitted when it refers to goods and services that show a sufficiently direct and specific link to the extent that they form a homogeneous category or group (paras 14 to 18). The GC confirmed the finding of the BoA that all the services at issue have a sufficiently direct and specific link to the extent that each of those services may be a service intended for a start-up, or that can be a benefit of start-up, or that may be of interest to start-ups (paras 27 to 42). In addition, start ups may be present in a large number of sectors and therefore thus may offer or may need services of a very different nature. Therefore, the reason can be identical for the different services that may be offered to a start up and that correspond to activities made in favour of a start up, or provided by a start up, irrespective if those services are homogeneous or not between them. It is not necessary, in that context, to repeat the same reasoning for each of the services (para. 42).

2.3 *Ultra petita*

♦[T-549/15](#); **CAFE DEL SOL / Café del Sol et al.**; Judgment of 13 December 2016; *Ramón Guiral Broto v EUIPO*; Language of the case: EN. The applicant sought to register the figurative mark **CAFE DEL SOL** as an EUTM for goods and services in Classes 30, 35, 41, 42, 43 and 45. An opposition based on, among others, the earlier figurative mark **Café del Sol**, registered for various goods and services in Classes 9, 25, 42 and 43 was filed pursuant to Article 8(1)(a) and (b) EUTMR. The OD partly upheld the opposition insofar as it related to *services for providing of food and drink, temporary accommodation, outside catering* in Class 43. Only one of the earlier marks was valid and substantiated, namely, Spanish trade mark registration No 2 348 110. The BoA upheld the applicant's appeal. It found that the only earlier mark upon which the OD had based its decision was not substantiated because the translations provided by the opponent left out indications of the colour of the mark. The BoA also confirmed that the other earlier marks were either no longer valid at the operative time or that they were not properly substantiated. Consequently, as all the earlier marks were either invalid or not substantiated, the opposition was dismissed as unfounded. The opponent filed an action before the GC relying on three pleas in law: (i) the contested



decision is *ultra petita*; (ii) the documents submitted in order to prove the existence of the earlier mark were sufficiently probative and (iii) failure to respect the subordinate, instrumental and auxiliary nature of the procedural rules at issue and the possibility of remedying procedural irregularities. The GC upheld the appeal. It found that the contested decision was adopted in infringement of the principle that the parties should be heard and that the contested decision must be annulled owing to infringement of the applicant's rights of defence. The crux of the matter is that the BoA found that the earlier Spanish trade mark was not substantiated because the relevant translations left out indications of colour. The translation of the registration certificate omitted (i) 'azul' and 'blanco' (blue and white respectively) in the arrows shown above and (ii) the words 'y color azul' (and coloured blue) in the description field. ***Ultra petita***: it was common ground that the BoA raised the absence of a translation of the colour claims of its own motion (para. 26). The opponent complained that, in doing so, the BoA overstepped its appellate function. The GC held that, in rejecting the opposition on that basis, the BoA did not exceed the scope of the appeal that had been brought before it (paras 21 to 26). The GC cited the settled principle that the effect of the appeal before the BoA was that the BoA is called upon to carry out a new, full examination of the merits of the opposition, in terms of both law and fact (para. 21). Furthermore, the matters of law put forward before the BoA include any question of law, which must necessarily be examined for the purpose of assessing the facts, evidence and arguments relied on by the parties and for the purpose of allowing or dismissing the claims, even if the parties have not put forward a view on that question and even if the Office has omitted to rule on that aspect (para. 25). The colour claims for the earlier mark at issue are amongst the facts, which were submitted to the OD for the purpose of assessing whether there was a likelihood of confusion. They could therefore be taken into account by the BoA (para. 27). In addition, the obligation to translate those claims into the language of the proceedings is a matter of law. Compliance with that obligation is necessary in order to ensure a correct application of the EUTMR in the light of the facts, evidence and arguments provided by the parties and the relief sought since those claims may affect the assessment of whether there is a likelihood of confusion between the marks at issue. Furthermore, in the absence of a translation of those claims, the trade mark applicant may not have been able to defend itself adequately (para. 28).

3. ***General principles of Union Law***

◆ [T-290/15](#); **SMARTER TRAVEL**; Judgment of 9 November 2016; *Smarter Travel Media LLC v EUIPO*; Language of the case: EN. An application for registration of the figurative mark SMARTER TRAVEL as an EUTM was filed for a range of services in Classes 35, 38, 39 and 42. The examiner rejected the application on the ground that the mark applied for was descriptive and devoid of any distinctive character within the meaning of Article 7(1)(b) and (c) and Article 7(2) EUTMR. The Second BoA dismissed the appeal filed against the examiner's decision and confirmed that the mark applied for fell into the prohibitions of Article 7(1)(b) and (c) and Article 7(2) EUTMR. The GC grouped all of the arguments presented by the applicant into three pleas in law, alleging (i) an infringement of Article 7(1)(c) EUTMR, (ii) an infringement of Article 7(1)(b) EUTMR, (iii) an infringement of the principles of equal treatment and sound administration. As regards the third plea, the GC noted that, according to the case-law of the CJEU, the reasons on which the contested decision is based apply even if the sign for which registration is sought as an EUTM is composed in a manner identical to that of a mark for which the Office has already approved registration as an EUTM and which relates to goods or services identical or similar to those for which registration of the sign in question is sought (paras 70 to 72). Attribution to a single



member: the argument that the applicant's appeal should not have been decided by a single member of the BoA, was dismissed by the GC because, firstly, for the lack of clarity and precision flowing from Article 76(d) of the Rules of Procedure. Secondly, the present case does not raise any factual or legal difficulty. Thirdly, the applicant does not in any way show that the present case is important from the point of view of the development of the law of the European Union, or even from the point of view of its financial interests. Lastly, the applicant does not advance any matter that could lead to the conclusion that there are particular circumstances which justify the attribution of this case to a BoA composed of three members (paras 89 to 96).



II. Absolute Grounds for Refusal/Invalidity

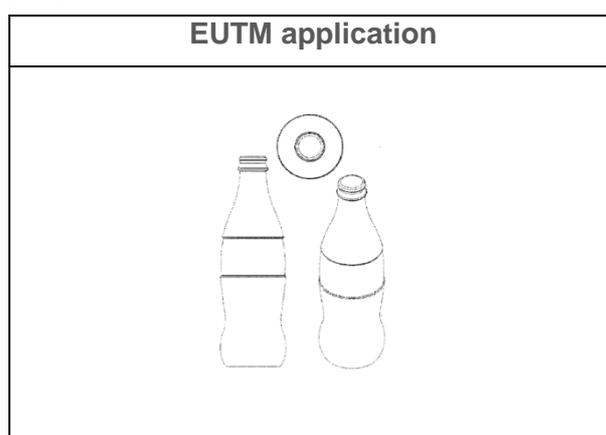
A. Article 7(1)(a) and Article 52(1)(a) EUTMR — sign of which an EUTM may consist

[no entry]

B. Article 7(1)(b), (c) and (d) and Article 52(1)(a) EUTMR — non-distinctive, descriptive, customary

1. Non-distinctive (Article 7(1)(b) EUTMR)

♦[T-411/14](#); **SHAPE OF A BOTTLE (3D MARK)**; Judgment of 24 February 2016; *Coca-Cola Company v OHIM*; Language of the case: EN.



The applicant sought to register the three-dimensional sign reproduced above as an EUTM for goods and services in Class 6, 21 and 32. The Office refused the registration for some of the goods for which protection was sought on the basis of Article 7(1)(b) EUTMR and informed the applicant. The applicant decided to maintain its application for all the goods concerned, claiming that the sign had acquired a distinctive character under Article 7(3) EUTM and having obtained extensions on the deadline for gathering and lodging all documents in support of its claims, the applicant submitted its arguments against the initial position adopted by the Office. The Office dismissed the application for registration and also dismissed the application under Article 7(3) EUTMR. The Boards of Appeal (BoA) dismissed the applicant's appeal. The applicant filed an action before the GC. **On the infringement of Article 7(1)(b) EUTMR:** the goods covered by the mark applied for are aimed at the general public with an average level of attention (para. 41). The mark applied for is made up of a combination of elements, each of which is likely to be commonly used in the trade of the goods covered by the trade mark application and is therefore devoid of any distinctive character in relation to those goods. The mark is mere variation of the shape and packaging of the goods concerned, which will not enable the average consumer to distinguish the goods in question from those of the other undertakings (paras 42 to 51). Regarding the argument of the applicant that the relevant sector is highly competitive and that it is common for players on such market to try to make their products stand out by means of their packaging, the GC



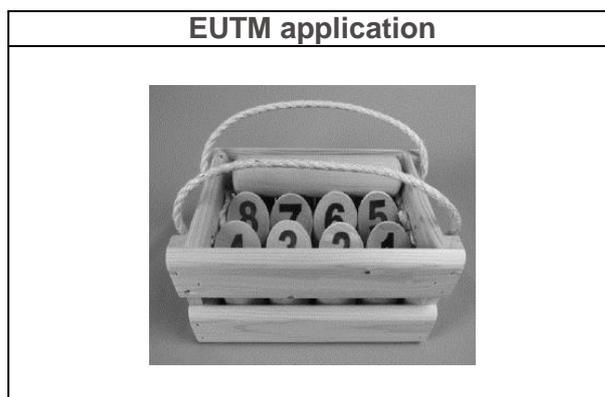
held that those circumstances do not suffice in themselves to render the mark applied for distinctive (para. 54).

♦[T-543/14](#); **HOT SOX**; Judgment of 26 February 2016; *provima Warenhandels GmbH v OHIM*; Language of the case: EN.

IR designating the EU
HOT SOX

The applicant sought to cancel the international registration designating the EU of the word mark **HOT SOX** for *hosiery* in Class 25. The CD's decision, rejecting the application for invalidity pursuant to Article 158 EUTMR in conjunction with Article 52(1)(a) and Article 7(1)(b) and (c) EUTMR, was upheld by the BoA. The applicant put forward two pleas in law before the GC. The word 'hot', unusual for articles of hosiery, and an incorrect spelling of the word 'socks' form a sufficiently original whole to have a minimal distinctive character to avoid the absolute ground for refusal under Article 7(1)(b) EUTMR (para. 64).

♦[T-363/15](#); **SHAPE OF TOY CRATE CONTAINING WOOD BLOCKS (3D MARK)**; Judgment of 16 March 2016; *Työhönvalmennus Valma Oy v OHIM*; Language of the case: FI.



The applicant sought to register a 3D mark reproduced above for goods in Class 28: *games*. It further claimed acquired distinctiveness through use. The Office's decision, rejecting the application pursuant to Article 7(1)(b) and Article 7(3) EUTMR, was upheld by the BoA. The applicant appealed to the GC and put forward two pleas in law. For a 3D mark to be registered, it does not suffice that it is original, but it must differ substantially from the basic shapes of the goods in question, commonly used in the trade, and not look like a mere variant of those shapes (para. 21). The type of wood used (Finnish birch) and the fact that the wood blocks are numbered by burning and bevelled at one end are details that are hardly noticeable on the reproduction of the sign (para. 23). It is common that with outdoor games, the goods in question are usually sold in packaging made from different materials, including wood (para. 24). While it is true that the fact that a mark may serve several purposes (including a carrying purpose) at the same time it is immaterial to its distinctive character. Such a mark must nonetheless be able to function as an indicator of commercial origin (para. 26). The fact that the BoA relied on case-law dating back more than ten years is irrelevant to the outcome of the case, contrary to the allegation of the applicant (paras 27 and 28). The applicant failed to demonstrate that the relevant public was used to seeing the



shape of the goods concerned as an indication of commercial origin at the time of the application of the mark (para. 29).

♦♦[T-90/15](#); **SCOPE**; Judgment of 16 March 2016; *Schoeller Corporation GmbH v OHIM*; Language of the case: DE.

EUTM
SCOPE

An application for invalidity was filed pursuant to Article 52(1)(a) in conjunction with Article 7(1)(c) EUTMR. The CD dismissed the application for invalidity. The BoA upheld the invalidity applicant’s appeal and invalidated the word mark **SCOPE**, registered for *insurance and financial related services* in Class 36, holding that it is frequently used in the fields of finance, investment and insurance to define the meaning, content and character of the services, such as in the specialist terms ‘scope of insurance’, ‘investment scope’, ‘financial scope’, or ‘desirable target for investment’ or ‘desired financial objective’. It refers to the desired scope or potential for development of the various financial, insurance and investment services or it expresses, in relation to those services, that financial opportunities are involved. Thus, it is descriptive within the meaning of Article 7(1)(c) EUTMR and lacks distinctive character under Article 7(1)(b) EUTMR. The GC annulled the BoA decision. **Infringement of Article 7(1)(b) EUTMR:** the BoA did not show that **SCOPE** lacks the distinctive character since it referred to combinations of **SCOPE** with other terms. On its own, **SCOPE** is neither promotional in character nor commonly used in the financial sector concerned (paras 46 to 48).

[T-326/15](#); **SHAPE OF A BOX COMPOSED OF TWO OPEN CUBES (3D MARK)**; Order of 20 April 2016; *Dima VerwaltungsGmbH v EUIPO*; Language of the case: DE.



The EUTM applicant sought to register a three-dimensional sign consisting of the shape of a box composed of two open cubes, represented above, for goods in Classes 16, 20 and 21. The Office refused the application on the basis of lack of distinctive character for all the goods. The BoA dismissed the applicant’s appeal. The EUTM applicant filed an application before the GC for the annulment of the decision of the BoA. The goods covered by the mark applied for are containers and boxes for transport and storage purposes. The GC found that the mark applied for is a simple geometrical body and does not depart from the common



cubical-shaped containers and boxes on the market. The cut outs facilitate the transportation of the box and will be perceived as purely functional elements. The dark stripes represent minimum decorative embellishments or serve for stability of the container. The fact that two side walls are higher than the transverse walls is not a distinctive feature. Also the fact that the box is not capable of being stacked is just a mere variation of the common shape of boxes or containers (para. 22). The applicant’s argumentation is confined to the allegation that the shape applied for departs significantly from the norm or custom of storage boxes or boxes for transportation as typical boxes neither have heightened parts with handles nor decorative ornaments. The GC held that it is not unusual that boxes for transportation have handles and that the decorative ornaments are minimal (para. 25). Regarding the applicant’s argument that for boxes for transportation usually aspects of practicability, stability and stackability are relevant whereas the mark applied for is characterised by aesthetic aspects, the GC points out that the shape of a non-stackable box represents a mere variation of the common shapes and does not suffice to render the mark applied for distinctive (para. 25).

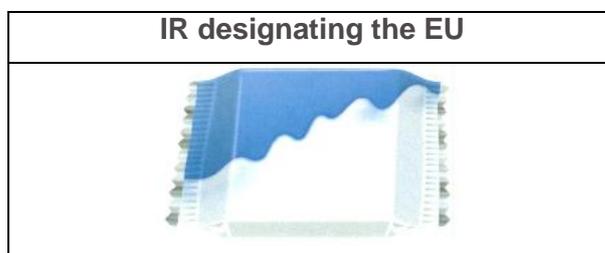
T-383/15: SHAPE OF A BOX COMPOSED OF TWO OPEN CUBES (3D MARK); Order of 20 April 2016; *Dima Verwaltungs GmbH v EUIPO*; Language of the case: DE.



The applicant sought to register the 3D mark depicted above for goods in Classes 16, 20 and 21. Both instances of the Office refused the registration of the mark due to lack of distinctive character in the sense of Article 7(1)(b) EUTMR. The applicant filed an appeal before the GC claiming an infringement of Article 7(1)(b) EUTMR. The GC applied in this case Article 126 RPGC, since the case is manifestly lacking any foundation in law (paras 10 and 11). The GC confirms the assessment of the BoA as to the relevant consumers, which are the general public with an average grade of attentiveness (para. 19). The GC further states that the goods in question are: ‘*containers, boxes and cases all for transport and storing purposes*’. The sign applied for is the shape of a cubical box being open at its upper side. This shape is quite commonplace in the market, which in any event does not depart significantly from the usual shapes for such kind of goods. None of the arguments of the applicant may put this conclusion in doubts (paras 20 and 21). The applicant just argued that it is not correct that the shape would be a mere variant of the current shapes available in the market but that it is unusual and bears aesthetic features, which would make the shape distinctive. However the GC clarifies that this mere repetition of the arguments brought before the BoA must be dismissed. It is not unusual that a box has handles and moreover the decorative elements are minimalistic. Consequently, as a whole, the shape is devoid of distinctive character (paras 22 to 25).



[T-806/14](#); **DEVICE OF WHITE AND BLUE SQUARE-SHAPED PACKAGING**; Judgment of 10 May 2016; August *Storck KG v EUIPO*; Language of the case: EN.



The applicant sought to register the figurative mark represented above as an international registration (IR) designating the EU for goods within Class 30. The Office refused to register the sign on the ground that it was devoid of any distinctive character pursuant to Article 7(1)(b) EUTMR. The BoA dismissed the applicant’s appeal. The applicant filed an action before the GC. The GC dismissed the appeal. It found that the case-law for three-dimensional marks is applicable, although the mark applied for is a figurative mark. The relevant public has a low level of attention for the goods in question, *confectionary goods*. Given that the mark applied for did not differ significantly from the usual shape of the goods concerned, it cannot fulfil its essential function, namely to identify the origin of the goods. The square shape is evidently essential for the goods concerned. Furthermore, the GC found the colour combination used in the mark is incapable of distinguishing the applicant’s goods from those of others. In this regard, the Office may not take into account any characteristics of the mark applied for that are not set out in the application for registration and the accompanying documents. The image affixed to the mark as well as the grey edges do not confer a distinctive character of the mark. The GC found that the submitted survey was not appropriate to establish, *ab initio*, the distinctive character of the mark. The survey, which was restricted to Germany, was not appropriate to establish distinctiveness for the European Union. The GC confirmed that the Office is not under the obligation to follow the assessment of national trade mark authorities in the Member States. Finally, the GC found that the legality of decisions of the BoA must be assessed solely on the basis of the EUTMR and not on the basis of any previous decision-making practice of the Office.

♦[T-590/14](#); **ULTIMATE FIGHTING CHAMPIONSHIP**; Judgment of 12 May 2016; *Zuffa, LLC v EUIPO*; Language of the case: EN.



The applicant sought to register the word sign **ULTIMATE FIGHTING CHAMPIONSHIP** for goods in Classes 9, 16, 28 and 41. The Office rejected the application for all the goods (with the exception of *playing cards and computer game controllers* in Class 28). The BoA dismissed the appeal. The applicant filed an application before the GC for the annulment of the decision of the BoA relying on three pleas in law: (i) infringement of the obligation to state reasons; (ii) infringement of Article 7(1)(b) and (c) EUTMR; and (iii) infringement of Article 7(3) EUTMR. Concerning the second plea, specifically regarding the distinctive character of the mark pursuant to Article 7(1)(b) EUTMR, the GC held that the BoA erred in deducing that the absolute ground for refusal of registration provided for in Article 7(1)(b) EUTMR was applicable solely because the mark applied for was descriptive. That error does not, however, affect the legality of the contested decision, since it is sufficient that one of the



absolute grounds for refusal applies for the sign at issue not to be registrable (paras 66 to 68).

[T-844/14](#); **Mark1**; Judgment of 12 May 2016; *GRE Grand River Enterprises Deutschland GmbH v EUIPO*; Language of the case: DE.

EUTM application
Mark1

The BoA confirmed the refusal of an EUTM application for a word mark **Mark1** for goods in Class 9 and Class 34 pursuant to Article 7(1)(b) EUTMR. The applicant filed an action before the GC claiming an infringement of 7(1)(b) EUTMR. The GC dismissed the action. The word elements of the mark will be understood as ‘trade mark number 1’ and have therefore a laudatory meaning. This will be directly perceived by the public, which will not see the signs as an indication of commercial origin (para. 36). The fact that it can have different meaning does not endow it with a distinctive character (further in para. 37). The argument of the applicant that several similar signs were registered before must be refused due to the principle of legality (paras 41 et seq.) The application of an EUTM must be examined strictly in each case, bearing in mind its particularities (para. 46).

[T-32/15](#); **Mark1**; Judgment of 12 May 2016; *GRE Grand River Enterprises Deutschland GmbH v EUIPO*; Language of the case: DE.

EUTM application


The BoA confirmed the refusal of an EUTM application represented above for goods in Class 9 and Class 34 pursuant to Article 7(1)(b) EUTMR. The applicant filed an action before the GC claiming an infringement of 7(1)(b) EUTMR. The GC dismissed the action. The word elements of the mark will be understood as ‘trade mark number 1’ and have therefore a laudatory meaning. This will be directly perceived by the public, which will not see the signs as an indication of commercial origin (para. 41). The fact that it can have different meaning does not endow it with a distinctive character (further in para. 41). The graphical elements are simple and cannot change the meaning of the word element (para. 43). The argument of the applicant that several similar signs were registered before must be refused due to the principle of legality (paras 45 et seq.) The application of an EUTM must be examined strictly in each case, bearing in mind its particularities (para. 50).



Cases [T-422/15](#) and [T-423/15](#); **THE DINING EXPERIENCE**; Judgment of 25 May 2016; *U-R LAB v EUIPO*; Language of the case: FR.

EUTM applications
 1. 2. THE DINING EXPERIENCE

The EUTM applicant sought to register the abovementioned figurative mark and the word mark **THE DINING EXPERIENCE** for a number of goods and services. The Office rejected both EUTM applications for several goods and services related to a special dinner in Classes 16, 35, 39, 41, 42 and 43, pursuant to Article 7(1)(b) EUTMR, as **THE DINING EXPERIENCE** is a laudatory promotional message that does not allow the relevant public to recognise the sign as an indication of origin. The BoA dismissed the appeals. The GC accepts the global motivation for categories of products or services, as it complies with the requirements established by the case-law (paras 32 to 33). The signs refer to a positive experience related to a refined meal (para. 63). They are devoid of distinctive character for the relevant goods and services as they indicate a characteristic of the goods and services (para. 76). The BoA implicitly accepted the motivation of the examiner, which is taken into account by the GC (as from para. 69).

♦ [T-301/15](#); **Du bist, was du erlebst.**; Judgment of 31 May 2016; *Jochen Schweizer GmbH v EUIPO*; Language of the case: DE.

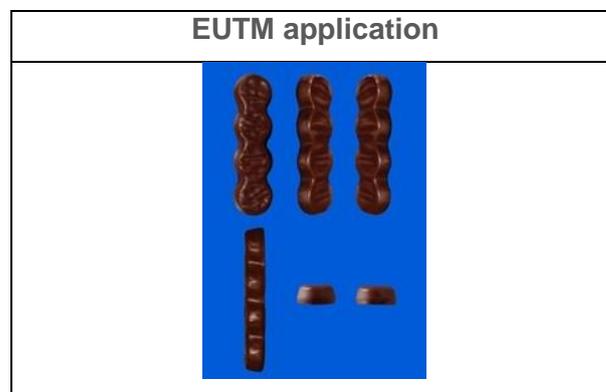
EUTM application
Du bist, was du erlebst.

The trade mark **Du bist, was Du erlebst.** had been applied for as an EUTM for goods and services in Classes 9, 16, 35, 36, 39 and 41. The Office refused the application under Article 7(1)(b) EUTMR. Upon appeal the BoA confirmed the decision and rejected the appeal. The EUTM applicant filed an action before the GC, claiming a violation of Article 7(1)(b) EUTMR. The Office correctly and in line with the case-law of the GC assessed whether the slogan indeed possessed distinctive character beyond its advertising and promotional function. It came to the conclusion that the slogan applied for did not primarily serve the relevant public as an indicator of commercial origin. Where slogans transmit a simple promotional message, a certain originality is required to allow for the conclusion that the advertising slogan aside its laudatory message primarily also transmits a message of commercial origin. The Office therefore rightly assessed whether the EUTM incorporated any unusual, opaque or surprising elements, which could help confer it with distinctive character (paras 23 to 30). The Office did not dissect the EUTM, but moreover did assess it in its entirety. The reference made to the beginning ‘Du’ merely served to underline the overall interpretation (para. 36). The slogan is built as a simple, readily understandable sentence, which does not include any unusual elements. More specifically, it is incorrect to say that the sequence ‘Du bist...’, necessarily has to be followed by an adjective in German. The slogan transmits the laudatory message that experience is the foundation for a rich life and that consumption of the advertised products furthers the creation of such experiences. This



message applies to all goods and services of the application. The Office may in its assessment globally address goods and services, where the message is generic enough to apply to categories of goods and services globally (paras 43 and 48). Contrary to what the appellant claims, the reasoning of this global assessment applies also to *paper* and *scientific apparatus and instruments*. Finally, there is no discrepancy in the assessment of the first instance examination and the BoA. In any event, the BoA has jurisdiction to assess a case both legally and factually anew and would therefore be entitled to replace a first instance reasoning by their own and still uphold the first instance decision by rejecting the appeal (paras 53 and 54). Based on the foregoing, the decision of the Office was confirmed.

♦[T-240/15](#); **SHAPE OF A BAR WITH FOUR CIRCLES (3D MARK)**; Judgment of 1 June 2016; *Grupo Bimbo, S.A.B. v EUIPO*; Language of the case: ES.



The applicant sought to register the three-dimensional mark represented above for goods in Classes 5, 29 and 30. The Office refused the registration of the EUTM application for all the goods pursuant to Article 7(1)(b) EUTMR. The BoA dismissed the appeal. The BoA considered that the mark applied for was not substantially different from certain basic forms of those products but was rather a variant of them or which had a utilitarian function. The applicant filed an action before the GC claiming an infringement of Article 7(1)(b) EUTMR, a violation of its right of defence and an infringement of the obligation to state reasons. The action was dismissed in its entirety by the GC. The GC confirmed the decision of the BoA. The GC pointed out that when a three-dimensional mark is constituted by the shape of the product for which registration is sought, the mere fact that that shape is a ‘variant’ of one of the usual forms of that type of product is not sufficient to show that that mark is not devoid of distinctive character within the meaning of Article 7(1)(b) EUTMR (para. 24). In this sense, the wavy outline of lateral curved lines that form four juxtaped circles in the mark applied does not constitute a form capable of allowing the relevant public to distinguish the products in question (para. 41). Furthermore, it is well-known that chocolate bars may have rounded side edges which are a common shape among the confectionery products. In the same way, these products are usually in the form of tablets and may have rounded edges (para. 42). For the goods in Class 5 (pharmaceutical and veterinary products, foods and dietary substances for medical or veterinary use, baby food, nutritional supplements for humans and animals) the GC considered that the consumer of those products does not pay much attention to their form but rather to the specific characteristics of the product, the label placed on it or its packaging and the name, image or graphic design contained therein (para. 43).



♦[T-654/14](#); **REVOLUTION**; Judgment of 2 June 2016; *Revolution LLC v EUIPO*; Language of the case: EN. The applicant sought to register the word mark **REVOLUTION** as an EUTM for services in Class 36. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b) EUTMR, as it was found to be devoid of distinctive character. The BoA dismissed the applicant’s appeal. It found that the mark was not distinctive for the services applied for. The applicant filed an action before the GC relying on infringement of Article 7(1)(b) EUTMR as well as on the breach of the general principles of equal treatment, good administration and legal certainty and infringement of Article 75 EUTMR. The GC dismissed the appeal. **First plea: Infringement of Article 7(1)(b) EUTMR:** the GC found that the term **REVOLUTION** is a laudatory term in the nature of an advertisement, the purpose being to highlight the positive qualities of the services covered, it conveys a clear and unequivocal message, it is immediately apparent, no interpretative effort is needed, the sign will be seen as a promotional message (paras 29 to 30). The fact that the sign is (even primarily) a promotional formula is not enough for a finding of lack of distinctiveness (C-398/08 *Vorsprung durch Technik*, para. 45), but in that case, it was demonstrated that the slogan required a certain interpretative effort and exhibited certain originality and resonance, which made it easy to remember. In the case of the word mark **REVOLUTION**, there is no interpretative effort required, there is no originality or resonance (paras 32 to 49). The applicant’s argument regarding family of marks: the GC found that the concept of family of marks only comes into play in relative grounds and that the BoA had to assess the distinctive character of the mark applied for in the light of its inherent characteristics, without taking into consideration the other allegedly similar marks of which the applicant was the proprietor (para. 51).

[T-220/15](#); **WE CARE**; Order of 7 June 2016; *Beele Engineering BV v EUIPO*; Language of the case: EN.



The applicant sought to register the figurative mark represented above as an EUTM for goods and services within Classes 1, 6, 9, 17, 19, 25, 28, 37 and 41. The Office refused to register the word as an EUTM pursuant to Article 7(1)(b) EUTMR on the ground that it lacked distinctiveness and as it will be perceived as no more than as a promotional slogan informing the relevant public that the goods at issue are manufactured with particular care and that the services are provided likewise. Considering the nature of these goods and the green colour used in the mark, consumers might also perceive it as a reference to environmental concerns. The BoA dismissed the applicant’s appeal. The applicant filed an action before the GC. The GC found that the pleas raised by the applicant in support of its action are manifestly lacking any foundation in law and that the action must be dismissed. The GC rejected the arguments put forward by the applicant in holding: **WE CARE** informs the relevant consumers of a characteristic of the undertaking and of its goods and services, namely that it is attentive and that its goods and services are manufactured or provided with care. Accordingly, the element ‘we care’ is laudatory (para. 33). The colour green could lead the relevant public to see in the expression **WE CARE** a reference to environmental



concerns (para. 34). There is no tension between the character of the goods and services covered, on account of their blocking nature, and the meaning of the **WE CARE** element as argued by the applicant (para. 37). Contrary to what the applicant claims, there is nothing to show that the relevant public will perceive the colour green as having the meaning of letting of things come through and as, therefore, being in contradiction with the goods and services concerned (para. 40). Given its excessive simplicity, the circle at issue is not inherently capable of conveying a message that consumers will be able to remember (para. 43). As regards the overall composition of the mark applied for, the word element and figurative element, as the BoA correctly observed in point 19 of the contested decision, are simply placed one below the other. The BoA's analysis, according to which there is nothing striking in that composition that could make the mark as a whole more than the sum of its parts, must be confirmed (para. 46).

[T-222/15](#); **WE CARE**; Order of 7 June 2016; *Beele Engineering BV v EUIPO*; Language of the case: EN.

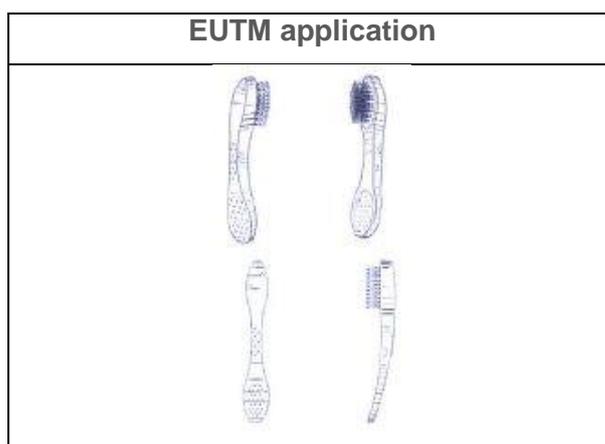


The applicant sought to register the figurative mark represented above as an EUTM for goods and services within Classes 1, 6, 9, 17, 19, 25, 28, 37 and 41. The Office refused to register the word as an EUTM pursuant to Article 7(1)(b) EUTMR on the ground that it lacked distinctiveness and as it will be perceived as no more than as a promotional slogan informing the relevant public that the goods at issue are manufactured with particular care and that the services are provided likewise. Considering the nature of these goods and the green colour used in the mark, consumers might also perceive it as a reference to environmental concerns. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. The GC found that the pleas raised by the applicant in support of its action is manifestly lacking any foundation in law and that the action must be dismissed. The GC rejected the arguments put forward by the applicant in holding: **WE CARE** informs the relevant consumers of a characteristic of the undertaking and of its goods and services, namely that it is attentive and that its goods and services are manufactured or provided with care. Accordingly, the element **WE CARE** is laudatory (para. 33). The colour green could lead the relevant public to see in the expression **WE CARE** a reference to environmental concerns (para. 34). There is no tension between the character of the goods and services covered, on account of their blocking nature, and the meaning of **WE CARE** as argued by the applicant (para. 37). Contrary to what the applicant claims, there is nothing to show that the relevant public will perceive the colour green as having the meaning of letting things come through and as, therefore, being in contradiction with the goods and services concerned (para. 40). Given its excessive simplicity, the circle at issue is not inherently capable of conveying a message that consumers will be able to remember (para. 43). The mark applied for is composed of the word element **WE CARE**, to which the figurative element, representing a green circle, has been added on the left. The BoA's analysis according to which that combination does not present anything allowing the relevant consumers to see or remember it as an indication of the commercial origin of the goods and services concerned, must be endorsed. The mark applied for, viewed as a whole, does not have any peculiarity that could



create an overall impression sufficiently far removed from that produced by the mere combination of the elements of which it is composed to confer on them added value (para. 46).

[T-385/15](#); **SHAPE OF A TOOTHBRUSH**; Judgment of 14 June 2016; *Loops LLC v EUIPO*; Language of the case: EN.



The applicant sought to register the 3D mark of a tooth brush represented above as an EUTM for goods and services in Class 21. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b) EUTMR, as it was found to be devoid of distinctive character. The BoA dismissed the applicant’s appeal. It found that the shape was commonplace and not markedly different from other shapes. The applicant filed an action before the GC relying on a single plea in law alleging infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal. It found that only marks departing significantly from the norm or customs of the sector are able to fulfil the essential function of indicating origin (para. 18). Overall the mark applied for is in the form of a toothbrush, the characteristics of which are similar to variations of toothbrushes usually available on the market (para. 28). Earlier precedents could not alter this result (paras 31 to 35). The BoA undertook a full and specific examination and the applicant could therefore not rely on previous Office decisions in order to cast doubt on the conclusion that the registration of the mark applied for is incompatible with the EUTMR.

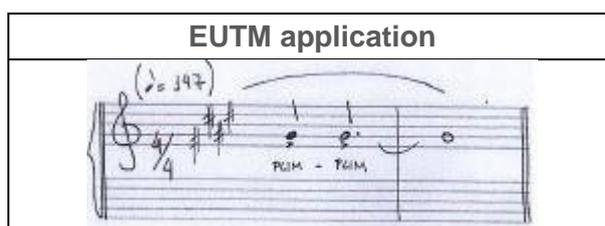
♦[T-491/15](#); **ConnectedWork**; Judgment of 14 July 2016; *Volkswagen AG v EUIPO*; Language of the case: DE. The applicant sought to register the word mark **ConnectedWork** as an EUTM for goods and services in Classes 9, 12, 38 and 42. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b) EUTMR in conjunction with Article 7(2) EUTMR for all goods and services in Classes 9, 38 and 42 as it was found to be devoid of distinctive character. The BoA dismissed the applicant’s appeal and confirmed the examiner’s decision. The applicant filed an action before the GC relying on two pleas in law: (i) infringement of Article 7(1)(b) EUTMR and (ii) infringement of the obligation to state reasons (Article 75 EUTMR). The GC dismissed the appeal. Concerning the first plea, based on an infringement of Article 7(1)(b) EUTMR, the GC confirmed that the relevant public is composed of the English-speaking public and professionals in the field of IT (para. 21). Considering English grammar rules, it is common to combine two words and the very fact that there are no spaces between the words ‘Connected’ and ‘work’ will not prevent consumers from distinguishing these two words (para. 31). The GC found that the term



‘ConnectedWork’ could be understood as an indication that the goods and services applied for can be connected for work or that the goods and services can be connected with a network in order to enable work (para. 28). The GC confirms the BoA’s finding that the sign has no additional meaning other than the sum of the two words used (para. 33).

T-308/15; keep it easy; Judgment of 20 July 2016; *Peter Reisenhel v EUIPO*; Language of the case: DE. The applicant sought to register the word mark **keep it easy** for goods in Classes 12, 16, 18, 20 and 21. Both instances of the Office refused the registration of the mark due to lack of distinctive character in the sense of Article 7(1)(b) EUTMR. The applicant filed an appeal before the GC claiming an infringement of Article 7(1)(b) EUTMR. The GC confirms the assessment of the BoA as to the relevant consumers, which are the general public and the professional public. The attentiveness will be average or high (para. 18). The applicant agrees that the sign is a slogan. He contends that the refusal of the BoA applied criteria that were too strict and the assessment it made of the sign was too analytical and consequently unlawful. The GC refuses to accept that argument. The BoA correctly applied the case-law for slogans according to which a slogan has to be refused if it is a pure promotional and laudatory message (paras 19 to 22). The BoA correctly analysed the meaning of the single elements and then interpreted the meaning of the sign as a whole in the context of the goods. Thus the BoA was right in concluding that the sign will be understood as referring to the easy handling of the goods or that the goods provide for an easy life. Thus the sign has a merely banal message (para. 24). The GC further dismisses the applicant’s statement that the sign would be fanciful and require some mental steps because it would strongly remind the public of the phrase ‘take it easy’ and thus confuse them. The sign is grammatically correct and has a straight forward meaning, which the English-speaking consumers will immediately understand (paras 25 and 26). Although the First Instance interpreted the sign in a slightly different way than the BoA, those differences are small and both instances concluded that the sign is a promotional message (para. 27). The conclusion of the BoA that the sign conveys a laudatory message in the sense that the goods are easy to handle or help to have an easy life is reinforced by the existing case-law for the word ‘easy’. The GC quoted also the cases T-707/13 and T-709/13 (*Be Happy*) which confirm that general messages promising an easy or happy life will normally not be seen as an origin indicator (para. 30). Finally, the conclusions of case C-398/08 (*Vorsprung durch Technik*), to which the applicant referred, are not applicable. The factual situation is not comparable; in particular the reputation for specific goods (cars) is not present in the case in question (para. 33).

♦ **T-408/15; SOUND OF A JINGLE PLIM PLIM**; Judgment of 13 September 2016; *Globo Comunicação e Participações S/A v EUIPO*; Language of the case: FR.



The examiner had rejected the application for registration of the sound sign represented above (which was accompanied by an MP3 file). The registration had been sought for several goods and services in Classes 9, 16, 38 and 41, all of them representing goods and



services intended for the spreading of information. The refusal was grounded in Article 7(1)(b) EUTMR, since the sign was deemed as devoid of any distinctive character. It consisted, indeed, of a simple and banal ringing sound. The BoA confirmed the examiner's decision, upholding the refusal based on Article 7(1)(b) EUTMR. The BoA took the view that the mark applied for represented a banal and commonplace ringing sound, which would generally go unnoticed and would not be remembered by the consumer. The BoA referred back to the first examiner the question whether the mark applied for had acquired distinctive character in relation to television broadcasting services (Class 38) and entertainment services (Class 41), as requested by the appellant/applicant. The GC dismissed the EUTM applicant's action and set out that the BoA had correctly upheld the OD's decision to refuse the registration of the mark on the basis of Article 7(1)(b) EUTMR. The applicant had put forward two pleas in law, alleging (i) infringement of the obligation to state reasons (Article 75 EUTMR) and (ii) infringement of Article 7(1)(b) EUTMR. Concerning the second plea, claiming an infringement of Article 7(1)(b) EUTMR, the GC was called upon to rule whether the BoA was right in finding that the mark applied for was so banal as to be devoid of any distinctive character. The GC explained that a very simple sound is not capable of conveying a message that can be remembered by consumers, as a consequence it is unlikely to be intended as an indication of the commercial origin of the products or services for which it is used (para. 51). Despite the applicant's assertions to the contrary, the GC concluded that the mark amounted to the repetition of two identical notes and that no nuances or other distinguishing elements may be heard (para. 56). A mark consisting of just a ringing sound, deprived of other distinctive elements, cannot perform the typical identifying function of a trade mark (para. 58). As regards the goods designated in Class 16, paper, cardboard, printed matter and others, and the services in Class 41, education, providing of training and others, the GC upheld the BoA's assertion according to which the consumer is not used to recognising the origin of these goods on the basis of a sound or melody (para. 65). Concerning the goods in Class 9, computer software and others, the GC support the assertion that the mark applied for will be understood as indicating merely that a computer program is being started (para. 67) and as regards the broadcasting services in Class 38, the GC concluded that the mark will be perceived by the public as indicating the beginning or end of the program (following paragraph). Finally, taking into account the banality of the mark applied for, together with the characteristics of the goods and services designated and the relevant public, the GC concluded that the BoA did not err as regards the examination of the (lacking of) distinctive character of the sign (para. 69). The applicant had also claimed that the mark was to be accepted since the Office had accepted other very simple sound marks in the past. The GC explained that, even though the principle of equal treatment is binding for the Office, a person can never take advantage of an unlawful act committed to the benefit of someone else (para. 73). Therefore the alleged previous registrations of marks lacking of distinctive character are not to be taken into account. Indeed, the GC concluded that the BoA carried out a full and specific examination of the mark before refusing it, therefore the applicant cannot rely on such previous decisions in order to raise doubts on the lawfulness of the BoA's conclusions (para. 75). The applicant's documents submitted before the GC were deemed inadmissible on the ground that they were not produced during the administrative proceedings before the Office (para. 20).

♦[T-237/15](#); **NANO**; Judgment of 22 September 2016; *Edward Labowicz v EUIPO, Pure Fishing, Inc.*; Language of the case: EN. The EUTM proprietor was granted the registration of the figurative mark **NANO** for a range of goods in Class 28 (in short, *fishing equipment*). An application for a declaration of invalidity was filed against the abovementioned mark for all of the goods. The CD declared the contested mark invalid for all the goods on the basis of Article 7(1)(b) and (c) EUTMR. The First BoA dismissed the appeal. The EUTM proprietor



filed an application before the GC for the annulment of the decision of the BoA relying on three pleas in law: (i) infringement of Article 7(1)(c) EUTMR; (ii) infringement of Article 7(1)(b) EUTMR; and (iii) infringement of Articles 76 and 83 EUTMR and of Articles 6 and 14 of the Convention for the Protection of Human Rights and Fundamental Freedoms. As regards the second plea, based on an alleged infringement of Article 7(1)(b) EUTMR, the GC found that since the contested mark is, for the purposes of Article 7(1)(c) EUTMR, descriptive of the goods covered, there is no need to examine the second plea, alleging infringement of Article 7(1)(b) EUTMR (para. 60).

♦[T-129/15](#) and [T-130/15](#) (joined cases); **WAVE 2 PAY** and **WAVE TO PAY**; Judgments of 28 September 2016; *Intesa Sanpaolo SpA v EUIPO*; Language of the cases: IT. An application for registration of the word marks **WAVE 2 PAY** and **WAVE TO PAY** as EUTMs was filed for a range of goods and services in Classes 9, 16, 36 and 38. The BoA confirmed the partial refusal of the marks applied for, due to its descriptive nature and also due to its lack of distinctiveness in relation to a part of the goods and services. The applicant put forward three pleas in law, alleging (i) an infringement of Article 7(1)(c) EUTMR, (ii) an infringement of Article 7(1)(b) EUTMR, (iii) an infringement of Article 75 EUTMR. **Article 7(1)(b) EUTMR:** the GC recalled that it is sufficient that one of the absolute grounds for refusal enumerated in Article 7(1) EUTMR applies for a sign to be ineligible for registration as an EUTM. Therefore, the GC found it unnecessary to examine the second plea of the applicant (para. 37).

♦[T-56/15](#); **BRAUWELT**; Judgment of 18 October 2016; *Raimund Schmitt Verpachtungsgesellschaft mbH & Co.KG v EUIPO*; Language of the case: DE. The applicant sought to register the word mark **BRAUWELT** for goods and services in Classes 9, 16, 32, 35, 38, 41, 42 and 43. Both instances of the Office refused the registration of the mark due to lack of distinctive character and descriptiveness in the sense of Article 7(1)(b) and (c) EUTMR. The applicant filed an appeal before the GC claiming an infringement of Article 7(1)(b) and (c), Article 7(3) and Article 75 EUTMR. The applicant's claim to alter the contested decision to the effect of registering the mark applied for was dismissed by the GC as inadmissible. Since the BoA does not have this power, the GC does not have it either (paras 9 to 14). The GC further declared the documents produced for the first time before it as inadmissible. The purpose of actions brought before the GC is to review the legality of decisions of the BoAs of the Office within the meaning of Article 65 EUTMR. It is not therefore the GC's function to review the facts in the light of documents produced for the first time before it (paras 15 and 16). **Infringement of Article 7(1)(b) EUTMR:** as the mark **BRAUWELT** is descriptive of the goods and services in question within the meaning of Article 7(1)(c) EUTMR, it can be inferred, on the basis of the applicable case-law, that registration is also to be refused on the basis of Article 7(1)(b) EUTMR, without it being necessary to provide a fuller statement of reasons on the point (paras 91 to 93).

♦[T-29/16](#); **CAFFÈ NERO**; Judgment of 27 October 2016; *Caffè Nero Group Ltd v EUIPO*; Language of the case: EN. The EUTM applicant sought to register the word mark **CAFFÈ NERO** as an EUTM for goods and services in Classes 25, 30 and 35. The examiner refused the application for all the goods and services in Classes 30 and 35 on the basis of descriptiveness, lack of distinctive character and deceptiveness. The First BoA dismissed the appeal. The EUTM applicant filed an application before the GC for the annulment of the decision of the BoA raising four pleas in law: (i) infringement of Article 7(1)(c) EUTMR; (ii) infringement of Article 7(1)(b) EUTMR; (iii) infringement of Article 7(1)(g) EUTMR; and (iv)



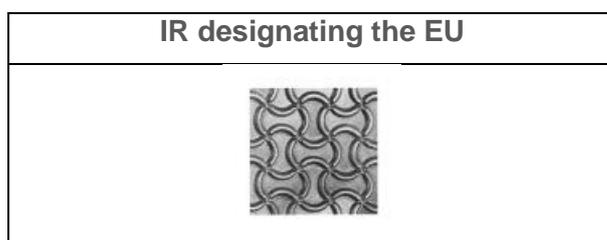
infringement of the principles of equal treatment and sound administration. Regarding the second plea in law, namely infringement of Article 7(1)(b) EUTMR, since it is sufficient for the mark to be refused registration if one of the absolute grounds is applicable, the GC did not adjudicate on the plea pursuant to Article 7(1)(b) EUTMR in relation to the goods and services that were found descriptive pursuant to Article 7(1)(c) EUTMR (para. 41).

♦[T-37/16](#); **CAFFÈ NERO**; Judgment of 27 October 2016; *Caffè Nero Group Ltd v EUIPO*; Language of the case: EN.



The EUTM applicant sought to register the figurative mark **CAFFÈ NERO** as an EUTM for goods and services in Classes 25, 30 and 35. The examiner refused the application for all the goods and services in Classes 30 and 35 on the basis of descriptiveness, lack of distinctive character and deceptiveness. The First BoA dismissed the appeal. The EUTM applicant filed an application before the GC for the annulment of the decision of the BoA raising four pleas in law: (i) infringement of Article 7(1)(c) EUTMR; (ii) infringement of Article 7(1)(b) EUTMR; (iii) infringement of Article 7(1)(g) EUTMR; and (iv) infringement of the principles of equal treatment and sound administration. Regarding the second plea in law, namely infringement of Article 7(1)(b) EUTMR, since it is sufficient for the mark to be refused registration if one of the absolute grounds is applicable, the GC did not adjudicate on the plea pursuant to Article 7(1)(b) EUTMR in relation to the goods and services that were found descriptive pursuant to Article 7(1)(c) EUTMR (para. 46).

♦♦[T-579/14](#); **DEVICE OF A PATTERN**; Judgment of 9 November 2016; *Birkenstock Sales GmbH v EUIPO*; Language of the case: DE.



The BoA confirmed the refusal of protection of the international mark represented above (IR) for goods in Classes 10, 18 and 25 in the European Union pursuant to Article 7(1)(b) EUTMR on the ground that the trade mark applied for was devoid of any distinctive character for the products at issue. The BoA found, inter alia, that the sign at issue presented wavy lines crisscrossing at right angles in a repetitive sequence that could extend in all four directions of the square and therefore be used on any two- or three-dimensional surface. The sign at issue would thus be perceived immediately as representing a surface pattern. The BoA also observed that it was well-known that the surfaces of goods or their packaging are decorated with patterns for a variety of reasons, including enhancing their aesthetic appearance and/or for technical reasons. It observed that, according to the case-law, as the average consumers



do not usually presume the commercial origin of goods on the basis of the signs that are indissociable from the goods themselves, those signs will have distinctive character within the meaning of Article 7(1)(b) EUTMR only if they depart significantly from the sectoral standards or usual practices. It considered that case-law to be applicable in the present case, as the sign at issue was indissociable from the appearance of the goods in question. The IR owner filed an action before the GC claiming an infringement of Article 7(1)(b) in conjunction with Article 154(1) EUTMR. The GC confirmed the decision of the BoA for the majority of the contested goods except for *artificial limbs, eyes and teeth, suture materials; suture materials for operations* and *animal skins, hides*, for which the decision was annulled. The GC confirmed the assessment of the BoA that the trade mark in question is indissociable from the appearance of the goods and therefore the relevant case-law applies to this case (paras 33 et seq.). The repetitive sequence can extend infinitely in all four directions of the square and therefore be applied to any two- or three-dimensional surface. It is therefore a sign composed of a series of components that repeat themselves regularly and lends itself particularly well to being used as a surface pattern (paras 38 and 39). The GC found, however, that the trade mark in question will not be perceived as indissociable from the appearance of the following goods *artificial limbs, eyes and teeth* (para. 97 et seq.), *suture materials; suture materials for operations* (para. 109 et seq.) and *animal skins, hides* (para. 126).

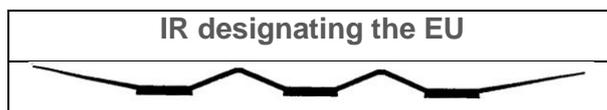
♦[T-290/15](#); **SMARTER TRAVEL**; Judgment of 9 November 2016; *Smarter Travel Media LLC v EUIPO*; Language of the case: EN. An application for registration of the figurative mark SMARTER TRAVEL as an EUTM was filed for a range of services in Classes 35, 38, 39 and 42. The examiner rejected the application on the ground that the mark applied for was descriptive and devoid of any distinctive character within the meaning of Article 7(1)(b) and (c) and Article 7(2) EUTMR. The Second BoA dismissed the appeal filed against the examiner's decision and confirmed that the mark applied for fell into the prohibitions of Article 7(1)(b) and (c) and Article 7(2) EUTMR. The GC grouped all of the arguments presented by the applicant into three pleas in law, alleging (i) an infringement of Article 7(1)(c) EUTMR, (ii) an infringement of Article 7(1)(b) EUTMR, (iii) an infringement of the principles of equal treatment and sound administration. As regards the second plea, based on an infringement of Article 7(1)(b) EUTMR, the GC recalled that it is sufficient that one of the absolute grounds for refusal enumerated in Article 7(1) EUTMR applies for a sign to be ineligible for registration as an EUTM. In any case, the GC confirmed that the finding made by the BoA, that the mark applied for is devoid of any distinctive character, not only because a descriptive word mark necessarily lacks distinctiveness but also because, in the present case, it is incapable of performing the essential function of a trade mark, namely that of identifying the origin of the services concerned (paras 57 to 60).

♦[T-315/15](#); **ELECTRIC HIGHWAY**; Judgment of 17 November 2016; *Dale Vince v EUIPO*; Language of the case: EN. The applicant sought to register the word mark **ELECTRIC HIGHWAY** for various goods and services in Classes 9, 12, 39. The examiner refused this EUTM under Article 7(1)(b) and (c) and Article 7(2) EUTMR for the services in Class 39. The BoA dismissed the appeal on the basis of Article 7(1)(b) and (c) EUTMR holding that 'ELECTRIC HIGHWAY' in relation to the services applied for was referring to a public road equipped with charging stations positioned at regular intervals and intended for electric vehicles. The mark applied for would therefore only be seen as a description of the kind and the intended purpose of the services concerned. The GC confirmed the BoA decision. The plea claiming infringement of Article 7(1)(b) EUTMR was dismissed as the BoA found that the sign was descriptive under Article 7(1)(c) EUTMR and it did not need to examine as the



existence of the absolute ground for refusal under Article 7(1)(b) EUTMR. It is sufficient that one of the grounds contained in Article 7(1) EUTMR applies (paras 35 to 36).

T-614/15; DEVICE OF BLACK LINES; Judgment of 24 November 2016; *Azur Space Solar Power GmbH v EUIPO*; Language of the case: EN.



The IR holder filed an application for an IR designating the European Union (EU) for the figurative trade mark represented above for goods in Class 9. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b) EUTMR. The BoA dismissed the appeal and confirmed the examiner’s decision. The applicant filed an action before the GC. The action was dismissed in its entirety by the GC. The GC pointed out that the case-law relating to three-dimensional trade marks consisting of the appearance of the goods themselves also applies where, as in the present case, the mark applied for is a figurative trade mark, since that mark is the two-dimensional representation of those goods. In such case, the mark likewise does not consist of a sign unrelated to the appearance of the goods it covers (para. 13). The BoA was right in finding that the goods concerned in Class 9 were all for solar cells and modules and goods closely related to those goods (para. 20). The two pairs of sloping black lines in the centre of the sign appear to depict roofs and each roof ends with a black brick. On each side of the outer two bricks there is a tapering and upward tilting black line, the one on the left pointing left and the one on the right pointing right. Moreover, the GC considered that the way in which they are combined and slope would be immediately perceived by the relevant public, which consist of specialists, as a very simple schematic representation of solar panels and thus perceive the sign at issue as a whole as an array of solar panels, resulting sufficient to hold that the mark applied for has no distinctive character (paras 23 and 24). The BoA was also right in finding that the fact that the two lines on each side of the outer two bricks are tapered does not depart significantly from the normal way of representing solar panels on sketch by way of a single straight line. In spite of that slight difference, the relevant public, having regard to the sign at issue as a whole, will perceive those tapering lines, in the same way as it will perceive the other lines of which that sign consist, as a very simple schematic representation of solar panels (para. 28). The GC concluded that the relationship between the solar modules and the mark applied for is sufficient for the lack of distinctive character of that mark to be extended to the goods concerned, which are closely related to solar panels (para. 31).

T-578/15; DEVICE OF A SOLAR CELL; Judgment of 24 November 2016; *Azur Space Solar Power GmbH v EUIPO*; Language of the case: EN.



The IR holder filed an application for an IR designating the European Union for the figurative trade mark represented above for goods in Class 9. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b) EUTMR. The BoA dismissed the appeal and



confirmed the examiner's decision. The applicant filed an action before the GC. The action was dismissed in its entirety by the GC. The GC pointed out that the case-law relating to three-dimensional trade marks consisting of the appearance of the goods themselves also applies where, as in the present case, the mark applied for is a figurative trade mark, since that mark is the two-dimensional representation of those goods. In such case, the mark likewise does not consist of a sign unrelated to the appearance of the goods it covers (para. 13). The BoA was right in finding that the goods concerned in Class 9 were all for solar cells and modules and goods closely related to those goods (para. 20). The two pairs of sloping black lines in the centre of the sign appear to depict roofs and each roof ends with a black brick. On each side of the outer two bricks there is a tapering and upward tilting black line, the one on the left pointing left and the one on the right pointing right. Moreover, the GC considered that the way in which they are combined and slope would be immediately perceived by the relevant public, which consist of specialists, as a very simple schematic representation of solar panels and thus perceive the sign at issue as a whole as an array of solar panels, resulting sufficient to hold that the mark applied for has no distinctive character (paras 23 and 24). The BoA was also right in finding that the fact that the two lines on each side of the outer two bricks are tapered does not depart significantly from the normal way of representing solar panels on sketch by way of a single straight line. In spite of that slight difference, the relevant public, having regard to the sign at issue as a whole, will perceive those tapering lines, in the same way as it will perceive the other lines of which that sign consist, as a very simple schematic representation of solar panels (para. 28). The GC concluded that the relationship between the solar modules and the mark applied for is sufficient for the lack of distinctive character of that mark to be extended to the goods concerned, which are closely related to solar panels (para. 31).

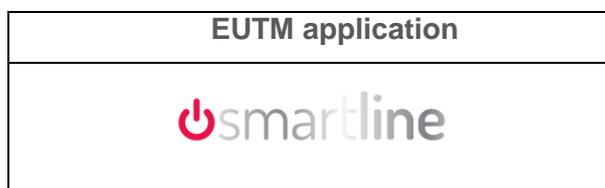
♦[T-617/15](#); **eSMOKINGWORLD**; Judgment of 29 November 2016; *Chic Investments sp. z o.o., v EUIPO*; Language of the case: PL.



The BoA confirmed the refusal of the registration for the EUTM application for goods in Classes 35 and 41, pursuant to Article 7(1)(b) and (c) EUTMR. The trade mark applied for informs the target public about the nature and purpose of the contested services, namely the relation to electronic cigarettes. The figurative elements are too simple to divert the consumer's attention from the descriptive message of the word element and may even be associated with a cigarette. The EUTM applicant filed an action before the GC based on two pleas in law: (i) an infringement of Article 75 EUTMR in conjunction with Article 41(2)(c) of the EU Charter of Fundamental Rights and (ii) an infringement of Article 7(1)(b) EUTMR. As regards the alleged infringement of Article 7(1)(b) EUTMR, the GC confirmed the assessment of the BoA and decided that the EUTM application is to be rejected. The word element has a clear meaning as 'everything related to electronic smoking', since the abbreviation 'e' is commonly used for 'electronic' and 'World' is defined as a set of similar things or persons related to each other or forming a paradigm (paras 36 and 37). The contested services are directly or indirectly related to electronic cigarettes (paras 40 and 41). The word element is therefore descriptive of all contested services (para. 45), whereas the figurative element emphasises its meaning (para. 56).



[T-744/15](#); **smartline**; Judgment of 11 December 2016; *Puro Italian Style SpA v EUIPO*; Language of the case: EN.



An application for registration of the figurative mark represented above as an EUTM was filed for a range of goods in Class 9, including *cases for mobile phones and smartphones; screensavers for mobile phones, smartphones, and tablet computers; chargers for mobile phones*. The examiner rejected the application on the ground that the mark applied for was devoid of any distinctive character within the meaning of Article 7(1)(b) EUTMR. The First BoA dismissed the appeal filed against the examiner’s decision and confirmed that the mark applied for fell into the prohibitions of Article 7(1)(b) EUTMR. The applicant filed an appeal before the GC. The applicant presented one single plea in law, alleging an infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal. The GC confirmed the finding of the contested decision that the English word ‘SMARTLINE’, composed of the words ‘SMART’ and ‘LINE’, may be perceived with two meanings: as ‘intelligent line’, namely a line of goods capable to perform some operation independently, or as ‘elegant line’ (para. 26). The GC added that, in the case at issue, the fact that the word ‘SMARTLINE’ may have different meanings is not decisive, since that word has manifestly and essentially a laudatory and promotional meaning in relation to the goods in question. That finding is reinforced by the fact that the concepts of intelligence and elegance are closely linked in the reality of the current market since producers try to offer a product that is as practical as it is attractive at the same time. This fact is particularly apparent as far as goods such as *smartphones* are concerned (paras 28 to 29). The GC also endorsed the finding of the contested decision that the figurative elements of the sign are incapable of conferring any distinctiveness to the mark applied for. The red device is the most commonly used symbol for the ignition of electronic devices, which is one essential function of the goods at issue (paras 32 to 34). The GC dismissed the applicant’s argument that the mark applied for was not descriptive in relation to those goods, which do not need to be started by ignition. The GC confirmed to that regard that, nowadays, electronic devices and their cases represent a sole inseparable package in the consumer’s perception. For example, there exist several smartphones or PCs on the market with cases that allow the user to switch on or off the device without the need to take it out from its case (para. 35). The GC therefore found that the BoA did not err in concluding that the mark applied for was devoid of any distinctive character within the sense of Article 7(1)(b) EUTMR.

♦[T-529/15](#); **START UP INITIATIVE**; Judgment of 15 December 2016; *Intesa Sanpaolo v EUIPO*; Language of the case: IT.





The EUTM applicant sought to register the figurative mark shown above as an EUTM for services in Classes 35, 36, 41 and 42. The examiner refused the application for all the services on the basis of lack of distinctive character. The First BoA dismissed the appeal. The EUTM applicant filed an application before the GC for the annulment of the decision of the BoA relying on two pleas in law: (i) infringement of Article 75 EUTMR, and (ii) infringement of Article 7(1)(b) EUTMR. As regards the second plea, the GC confirmed that the relevant services are directed to all consumers in the European Union, professional or not, that may need a provision of services in the fields of advertising, business, finance, insurance, real property promotion, education, culture, sports, entertainment, scientific research, technology, industrial design, engineering (para. 52). The GC further endorsed the finding of the BoA that the mark applied for will be easily understood as a whole also by a non-English speaking public since the expression ‘start up’ is entered in the languages of Italy and of other Member States and it is associated to ‘enterprises initiatives focused on new technologies and the Internet’ (paras 54 to 55). Contrary to the applicant’s opinion, consumers would not read the mark applied for as ‘start initiative up’ instead of ‘start up initiative’. This is because, notwithstanding the word ‘up’ is depicted in a different size and typeface and is inserted in a frame, the public will still perceive it as ‘start up initiative’ because this latter, and not the other, is an expression with a clear understandable meaning (para. 59). The GC confirmed the BoA’s finding that the figurative elements have little impact on the public’s perception and are not capable of diverting the consumer’s attention from the pure promotional message of the verbal elements. In particular, the shape in which the words ‘Start up’ are inserted will be perceived as a simple frame and not as a comic’s speech bubble. In addition, comic language is very common in advertising. Therefore, since consumers will recall principally the mark at issue in force of the expression ‘start up initiative’, the BoA’s finding has to be confirmed that the mark applied for is devoid of distinctive character in relation to the services requested (paras 59 to 63).

2. ***Distinctive (Article 7(1)(b) EUTMR)***

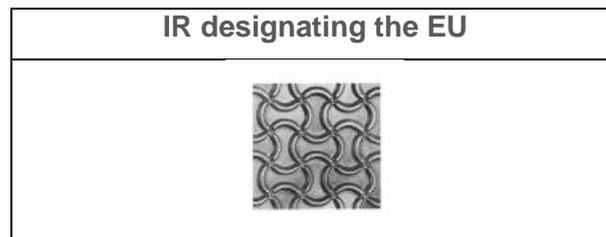
♦ [T-749/14](#); **AROMA**; Judgment of 12 May 2016; *Peter Chung-Yuan Chang v EUIPO*; Language of the case: EN. The EUTM proprietor was granted the registration of the word mark **AROMA** as an EUTM for, inter alia, goods in Classes 7 and 11. An application for invalidity was filed pursuant to Article 52(1)(a) in conjunction with Article 7(1)(b) and (c) EUTMR. The CD dismissed the application for invalidity. The BoA upheld the invalidity applicant’s appeal. The EUTM proprietor filed an action before the GC relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR (ii) infringement of Article 7(1)(b). The GC upheld the appeal. **On the distinctiveness of the mark:** despite the lack of evidence for establishing the origin of the word in its context, the concept of ‘aroma’ is not commonly used in the context of electrical cooking appliances and that the mere fact that a mark is perceived by the relevant public as a promotional formula capable in principle of being used by other undertakings, is not in itself sufficient to support the conclusion that that mark is devoid of distinctive character. It requires a certain degree of interpretation on the part of consumers, who will be unable to associate the mark directly with the goods at issue because the intended use of the goods at issue is not to preserve or accentuate the taste of foodstuffs and beverages, but to prepare, cook, transform, process, heat, mix, blend, toast or roast foodstuffs and beverages. That mark could even be regarded as demonstrating a certain degree of originality, since the term ‘aroma’ is not normally used in such a context and requires interpretation by the relevant public or a cognitive process to be set off in their minds to enable them to arrive at a conclusion as to the relationship, which is only remotely



evocative, between the mark and the goods. Hence, the contested Mark is not devoid of distinctive character within the meaning of Article 7(1)(b) EUTMR (paras 61 to 64).

♦[T-167/15](#); **NEUSCHWANSTEIN**; Judgment of 5 July 2016; *Bundesverband Souvenir — Geschenke — Ehrenpreise e.V. v EUIPO*; Language of the case: DE. The applicant for invalidity (applicant before the GC) requested the invalidity of the EUTM **NEUSCHWANSTEIN** for goods and services in Classes 3, 8, 14, 15, 16, 18, 21, 25, 28, 30, 32, 33, 34, 35, 36, 38 and 44 for lack of distinctive character and descriptiveness according to Article 52(1)(a) EUTMR in conjunction with Article 7(1)(b) and (c) EUTMR and for bad faith according to Article 52(1)(b) EUTMR. Both the CD as well as the BoA dismissed the action. The applicant filed an application before the GC based on three pleas in law: (i) infringement of Article 7(1)(b) EUTMR, (ii) infringement of Article 7(1)(c) EUTMR and (iii) infringement of Article 52(1)(b) EUTMR. The GC confirms the BoA as to the attention of the general public, which will be average except for the goods in Class 14 and the services in Class 36, where the attention will be above average (para. 22). As regards the first plea, as to the alleged lack of distinctive character, the GC underlines that ‘Neuschwanstein’ is an invented word without descriptive meaning and consequently may distinguish the goods and services at issue from those of other undertakings (para. 42). The mark is neither a slogan nor a laudatory expression. The consumers will be able to identify the origin of the goods and services. Therefore the mark is distinctive (para. 43). The previous decision in Germany by the *Bundespatentgericht* by which the German mark ‘Neuschwanstein’ has been partially declared invalid, is not relevant. The EUTM system is an autonomous system independent from national law (para. 44).

♦[T-579/14](#); **DEVICE OF A PATTERN**; Judgment of 9 November 2016; *Birkenstock Sales GmbH v EUIPO*; Language of the case: DE.

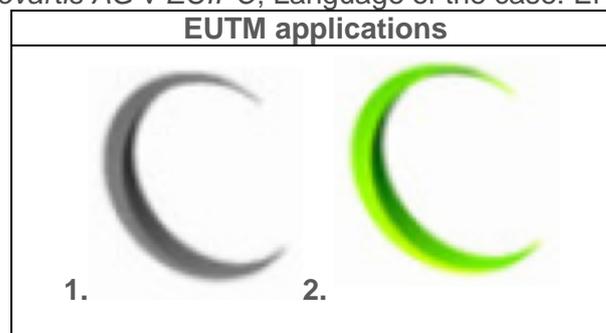


The BoA confirmed the refusal of protection of the international mark represented above (IR) for goods in Classes 10, 18 and 25 in the European Union pursuant to Article 7(1)(b) EUTMR on the ground that the trade mark applied for was devoid of any distinctive character for the products at issue. The BoA found inter alia that the sign at issue presented wavy lines crisscrossing at right angles in a repetitive sequence that could extend in all four directions of the square and therefore be used on any two- or three-dimensional surface. The sign at issue would thus be perceived immediately as representing a surface pattern. The BoA also observed that it was well known that the surfaces of goods or their packaging are decorated with patterns for a variety of reasons, including enhancing their aesthetic appearance and/or for technical reasons. It observed that, according to the case-law, as the average consumers do not usually presume the commercial origin of goods on the basis of the signs that are indissociable from the goods themselves, those signs will have distinctive character within the meaning of Article 7(1)(b) EUTMR only if they depart significantly from the sectoral standards or usual practices. It considered that case-law to be applicable in the present case, as the sign at issue was indissociable from the appearance of the goods in question.



The IR owner filed an action before the GC claiming an infringement of Article 7(1)(b) in conjunction with Article 154(1) EUTMR. The GC confirmed the decision of the BoA for the majority of the contested goods except for *artificial limbs, eyes and teeth, suture materials; suture materials for operations* and *animal skins, hides*, for which the decision was annulled. The GC confirmed the assessment of the BoA that the trade mark in question is indissociable from the appearance of the goods and therefore the relevant case-law applies to this case (paras 33 et seq.). The repetitive sequence can extend infinitely in all four directions of the square and therefore be applied to any two- or three-dimensional surface. It is therefore a sign composed of a series of components that repeat themselves regularly and lends itself particularly well to being used as a surface pattern (paras 38 and 39). The GC found, however, that the trade mark in question will not be perceived as indissociable from the appearance of the following goods *artificial limbs, eyes and teeth* (para. 97 et seq.), *suture materials; suture materials for operations* (para. 109 et seq.) and *animal skins, hides* (para. 126).

♦ [T-678/15](#) and [T-679/15](#) (joint cases); **DEVICE OF A CRESCENT**; Judgment of 15 December 2016; *Novartis AG v EUIPO*; Language of the case: EN.



The applicant sought to register the figurative marks represented above as EUTMs for goods in Class 5. The Office refused the registration of the EUTM applications pursuant to Article 7(1)(b) EUTMR, as the marks were found to be devoid of distinctiveness. The BoA dismissed the applicant's appeals. It found that the signs are devoid of distinctive character as they merely represent the outline of a lozenge or pill. The applicant filed an action before the GC. The GC upheld the appeals. It found that the curves making up the signs at issue are not closed, they are more like crescents or the letter 'C'. Furthermore, there is a slight twist in the signs and a play of light and shadow. It is therefore very unlikely that the relevant public will distinguish the shape of a pill, even once the signs at issue have been affixed to the packaging of pharmaceutical products. The signs are perceived as shapes with no link to any pharmaceutical products and cannot be regarded as being devoid of distinctive character on the ground that that they give rise to a two-dimensional representation of those goods. The GC furthermore concluded that the signs at issue do not represent a geometrical figure and that they display characteristics that are such as to distinguish them in the eyes of the public. Thus the signs satisfy the requirements as set out in the case-law and are endowed with the minimum distinctive character necessary for registration.



3. Descriptive (Article 7(1)(c) EUTMR)

[T-318/15](#); **TRIPLE BONUS**; Judgment of 14 January 2016; *Zitro IP Sàrl v OHIM*; Language of the case: ES.



The EUTM applicant sought to register the figurative sign above for goods in Classes 9, 28 and 41. The Office rejected the application. The BoA dismissed the appeal. The EUTM applicant filed an application before the GC for the annulment of the decision of the BoA. The goods and services at issue can be related to games of chance as they are machines, apparatus and facilities that can be used in order to play these games. They are in fact goods that can be used as support for games (Class 9), games themselves (Class 28) and services related to them (Class 41) (para. 22). The relevant public is composed of average consumers and professional consumers (para. 22). The analysis of the absolute grounds should be made with respect to the English-speaking consumers of the EU (para. 24). Consumers will perceive the expression ‘triple bonus’ as indicating that the goods and services for which registration is sought allow the tripling of the winnings usually gained at an equivalent game of chances. The term ‘bonus’ will be understood by the relevant public, particularly the English-speaking one, as extra winnings. Hence **TRIPLE BONUS** describes in an unequivocal and direct way one of the characteristics of the goods and services at issue. Even if the expression were to be interpreted as a promise or guarantee of triple winnings, it would still be promotional and, as such, descriptive of the objective of the goods and services or of the desire of the consumers to obtain high winnings (paras 27 to 29). The slightly stylised white letters with a black, blue and yellow border, displayed on two lines, will be perceived, because of their simplicity, as merely decorative elements of the sign, simply highlighting and strengthening on the descriptive character of the expression. They are not important enough to impel the relevant public make an effort to perceive the link between the word elements and the goods and services (paras 30 to 32). As the trade mark is descriptive, there is no need to rule on the distinctiveness of the signs (para. 36). The action is therefore dismissed in its entirety (para. 37).

[T-663/14](#); **BIG BINGO**; Judgment of 14 January 2016; *International Gaming Projects Ltd v OHIM*; Language of the case: ES.



The EUTM applicant sought to register the figurative sign above for goods in Classes 9, 28 and 41. The Office rejected the application for almost all of the goods and services. The BoA



dismissed the appeal. The EUTM applicant filed an application before the GC for the annulment of the decision of the BoA. The GC found that the BoA correctly held that the public targeted by the contested mark consists of the general European public and of professionals, and that the public to be considered when analysing the descriptive character of the sign is the English-speaking European public (para. 21). In light of the GC's case-law (T-564/08), the word element 'bingo' is descriptive of all the goods and services at issue, as it refers to the bingo-type game of chance that consumers can play thanks to the contested goods or thanks to the contested services (para. 23). The term 'big' can refer to the dimensions of the game, of the apparatus or game machines or even the game rooms where the contested services are provided, to the prizes that can be won with this game or also to the many participants, in particular with respect to bingo games that can be played online thanks to a software that allows access to them. The BoA therefore correctly found that the term 'big' was descriptive (para. 28). The combination of the two terms is not an unusual or arbitrary combination of words whose meaning differs from the mere sum of its elements. The expression **BIG BINGO** should therefore be considered descriptive (para. 30). The graphic elements are purely ornamental and decorative; they only channel the consumer's attention to the words **BIG BINGO** and to the information it conveys. Moreover, it is common in the game of chance sector to resort to a letter stylisation made by bright colors and giving the impression of being animated, often with contours and reliefs that produce three-dimensional effects similar to those of the sign (paras 43 to 44). The EUTM applicant cannot successfully claim that the expression **BIG BINGO** is not commonly used in the game of chance sector, as according to the case-law, for a sign to be descriptive it is sufficient that the signs and indications that compose the sign could be used to describe the contested goods and services (para. 54). The trade mark is therefore descriptive and there is no need to rule on the distinctiveness of the signs (para. 58). The action is therefore dismissed in its entirety (para. 59).

[T-842/14](#); **SLIM LEGS BY AIRPRESSURE BODYFORMING**; Judgment of 05 February 2016; *Airpressure Bodyforming v OHIM*; Language of the case: DE. The applicant sought to register the word mark **SLIM LEGS BY AIRPRESSURE BODYFORMING** as an EUTM for goods and services in Classes 28, 35 and 41. The Office refused the application in its entirety, based on Article 7(1)(b) and (c) EUTMR. The BoA dismissed the appeal on account of Article 7(1)(b) and (c) EUTMR and stated that the EUTM application lacked distinctiveness due to its descriptive character. The EUTM applicant filed an action before the GC, claiming a violation of Article 7(1)(b) and (c) EUTMR. The GC confirmed that the goods and services in question are addressed to general consumers as well as to a specialised public. As the BoA referred explicitly to the assessment of the examiner, there is no lack of reasoning in the decision of the BoA. Even if the combination 'airpressure' should be seen as a new word as it is written without hyphen, according to settled case-law the meaning of the word doesn't change (para. 27). The word element 'bodyforming' will also be recognised as an equivalent of the word 'bodyshaping'. The fact that the word as such is not listed in the dictionary does not mean that the term is able to distinguish the goods and services from those of another company (para. 28). Even if the terms 'airpressure' and 'bodyforming' would be grammatically or linguistically wrong and considered as new terms, both terms would be understood by the relevant public together with the word elements 'slim legs by'. As such, the trade mark is not considered as an unusual combination of words (para. 30). The BoA found that the trade mark describes equipment, clothing, etc. that is used to slim legs by using air-pressure. Thus, also in relation to the services applied for, it would be understood that the specialist public provides the services using equipment and devices as well as clothing with air-pressure technology. The GC confirms the statement of the BoA that the term is descriptive for all the goods and services applied for as the relevant public would directly



associate the goods and services with the meaning of the term. Based on the foregoing, the action was dismissed.

♦[T-543/14](#); **HOT SOX**; Judgment of 26 February 2016; *provima Warenhandels GmbH v OHIM*; Language of the case: EN. The applicant sought to cancel the international registration designating the EU of the word mark **HOT SOX** for *hosiery* in Class 25. The CD's decision, rejecting the application for invalidity pursuant to Article 158 EUTMR in conjunction with Article 52(1)(a) and Article 7(1)(b) and (c) EUTMR, was upheld by the BoA. The applicant put forward two pleas in law before the GC. Although the element 'sox' is not an English term for socks but is rather used in the US, it cannot be excluded that the word be understood as referring to socks. 'Sox' and 'socks' are phonetically identical (para. 27). In the evidence, 'sox' is not used in isolation, and it does not replace the word 'socks' (para. 28). It is not enough that one of the elements of a sign is descriptive; the descriptive character must be established for the sign as a whole (para. 29). 'Hot' in its meaning of 'extremely warm' or 'very high temperature' is not descriptive of the goods at issue, *socks*, since it does not describe their characteristics. 'Hot' is not a synonym of 'warm'. Socks are worn to keep feet warm or to warm them, but not to make them hot (para. 33). **HOT SOX** does not mean 'warming socks' (para. 34). In stating that the definition of the word 'hot' as 'fashionable' was one of its least recognised meanings and that that word had too many definitions to give the word 'socks' a clearly definable meaning, the BoA failed to apply settled case-law according to which a word sign must be excluded from registration under Article 7(1)(c) EUTMR if by at least one of its possible meanings it described a characteristic of the goods (paras 39 and 41). However, as there is no evidence on file that English-speaking consumers in the EU will immediately perceive **HOT SOX** as meaning 'fashionable socks' or 'currently popular socks', it is unlikely that the contested mark, taken as a whole, serves, in normal usage from the point of view of the relevant public, to designate 'socks currently popular or in demand' (para. 43). It had not been established that **HOT SOX** could be interpreted in the sense of 'fashionable socks' or 'currently popular socks' on the date of filing of the contested mark (paras 45 and 46). It is further highly unlikely that the average consumer interprets **HOT SOX** as referring to 'erotic or sexy socks', since a pair of socks is not generally perceived as being sexually provocative (para. 49). The fact that **HOT SOX** was registered in the UK and Ireland is more relevant than its alleged descriptiveness in Germany. The sole fact of a widespread knowledge of English on the part of the relevant public is not sufficient if English was not actually used in that context to address that public.

[T-538/14](#); **Multiprop**; Judgment of 1 March 2016; *Peri GmbH v OHIM*; Language of the case: DE. The applicant sought to register the word mark **Multiprop** for various goods and services in Classes 6, 19 and 37, all related to 'props'. The Office refused the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR. The BoA dismissed the appeal holding that **Multiprop** designates props that carry many times more. The GC confirmed the BoA decision. It found that the BoA erred in holding that **Multiprop** designates props that carry many times more and which are therefore particularly solid. A prop supports only one ceiling and for the relevant public, namely professionals of the building sector, the supporting capacity is indicated by precise measurement units such as newtons rather than the vague indication of many times more (para. 41). However, the BoA alternatively referred to the examiner's reasoning who stated that **Multiprop** designates multifunctional props. This reasoning holds true as the props may be adaptable in relation to all types of ceilings as regards their height, weight or material. The English prefix 'multi' in combination with the indication of an object indicates the versatility of that object (paras 42 to 44). Therefore, **Multiprop** designates characteristics of the goods and services within the meaning of



Article 7(1)(c) EUTMR (para. 48). Due to its descriptiveness the EUTM application also lacks the required distinctive character (para. 54).

♦[T-90/15](#); **SCOPE**; Judgment of 16 March 2016; *Schoeller Corporation GmbH v OHIM*; Language of the case: DE. An application for invalidity was filed pursuant to Article 52(1)(a) in conjunction with Article 7(1)(c) EUTMR. The CD dismissed the application for invalidity. The BoA upheld the invalidity applicant's appeal and invalidated the word mark **SCOPE**, registered for *insurance and financial related services* in Class 36, holding that it is frequently used in the fields of finance, investment and insurance to define the meaning, content and character of the services, such as in the specialist terms 'scope of insurance', 'investment scope', 'financial scope', or 'desirable target for investment' or 'desired financial objective'. It refers to the desired scope or potential for development of the various financial, insurance and investment services or it expresses, in relation to those services, that financial opportunities are involved. Thus, it is descriptive within the meaning of Article 7(1)(c) EUTMR and lacks distinctive character under Article 7(1)(b) EUTMR. The GC annulled the BoA decision. **Infringement of Article 7(1)(c) EUTMR: SCOPE** is a vague and general term, which may be allusive, but it lacks a sufficiently direct and specific link and thus is not descriptive on its own for the services in question. The fact that it can be used as a noun in the context of the services is insufficient for a descriptive character. The BoA based its findings on combinations of **SCOPE** with other terms (paras 32 to 35).

[T-78/15](#); **IPVanish**; Judgment of 17 March 2016; *Mudhook Marketing, Inc. v OHIM*; Language of the case: EN. The EUTM applicant sought to register the word mark **IPVanish** for the goods *virtual private network (VPN) operating software* in Class 9 and the services *providing virtual private network (VPN) services* in Class 38. The examiner rejected the application for all the goods and the services mentioned on the ground that the mark was descriptive on the basis of Article 7(1)(b) and Article 2 EUTMR. The BoA dismissed the appeal. The applicant filed an application before the GC for the annulment of the decision of the BoA. The GC confirmed that the meaning of the term 'IP' was 'Internet Protocol' and that that of the element 'VANISH' was 'to disappear, especially suddenly or mysteriously, to cease to exist, fade away or to become zero' and that 'VPN' is an 'Internet encryption and privacy tool' (para. 32). The GC upheld the finding of the BoA that, in view of the meaning of the elements forming the term **IPVanish**, the sign may evoke the idea that the goods and services covered by it will somehow achieve or contribute to the disappearance or continuing confidentiality of the user's internet address. Therefore, the sign applied for describes the purpose as well as a desirable quality of the goods and services at issue. Consequently, the sign applied for will be perceived by the relevant public as a promotional or advertising information, rather than as an indication of the commercial origin of the goods or services covered by the sign (paras 35 to 40). To that regard the GC also found that the BoA did not base its assessment solely on the lack of imaginativeness. The finding of lack of imaginativeness constitutes only one of the elements which the BoA took into account. It conducted a detailed assessment of the constituent elements of the mark applied for, as well as of the mark as a whole, in order to correctly conclude that the word element **IPVanish** was not capable of constituting an indication of the commercial origin of the goods and services that it covers (paras 43 to 46). As regards the level of attention of the relevant public, the GC found that, firstly, the level of attention of the relevant public may be relatively low as regards statements of a promotional nature, whether an average end consumer is at issue or a generally more attentive public consisting of specialists or informed consumers. Secondly, since the promotional message was clear to everyone, the relevant public will



immediately understand it, even if it were the case that, contrary to the assertion of the BoA, that public, as a whole, had a relatively low level of attention (paras 50 to 53).

♦♦[T-501/13](#); **WINNETOU**; Judgment of 18 March 2016; *Karl-May-Verlag GmbH v OHIM*; Language of the case: DE. The CD rejected a cancellation request filed pursuant to Article 52(1)(a) EUTMR in conjunction with Article 7(1)(b) and (c) EUTMR, inter alia, which had been filed against the trade mark **WINNETOU**, registered for a wide range of goods and services in Classes 3, 9, 14, 16, 18, 21, 24, 25, 28, 29, 30, 39, 41, 42 and 43. The BoA annulled the CD's decision and declared the EUTM invalid for almost all goods and services (with the exception of *printers' type; printing blocks* in Class 16). As regards the descriptive character, the BoA stated that **WINNETOU** is the main character in a series of (19th century) novels by the German author Karl May, and the protagonist of films, radio and theatre plays. The average German consumer understands the term as a reference to a fictional, noble and good Native American Chieftain. According to the German Bundesgerichtshof **WINNETOU** is descriptive for film productions, publishing of books and magazines. Although the BoA is not bound by these findings, in this case, insofar as a higher national court has ruled that **WINNETOU** is descriptive in Germany, the contested mark had to be also regarded as ineligible for protection connected to books, radio and television, as they all (can) relate to Winnetou or have a Winnetou theme. The vast majority of remaining goods can be classified as 'merchandising' goods with a direct link to 'Winnetou'; certain services (e.g. *transport, accommodation*) have a direct link with 'Winnetou' festivals. Consequently, the BoA found the EUTM to be descriptive for the rejected goods and services. The BoA found the EUTM also devoid of distinctive character for goods and services related to a magnanimous Native American Chieftain or the book character, since the consumer will believe that the mark describes the contents or purpose of the goods and services. The applicant filed an action before the GC, asking the GC to annul the contested decision (insofar as the BoA had upheld the declaration of invalidity). Amongst other pleas, the applicant claimed a breach of Article 7(1)(c) and (b) EUTMR, as well as a breach of the principles of autonomy and independence of the EUTM system. The applicant claimed that the BoA infringed the autonomy of the EUTM system by basing the contested decision exclusively on decisions of the German Courts on the descriptiveness of 'Winnetou', without an independent assessment applying the EUTM law criteria. The GC emphasised at the outset that the registrability of a sign as an EUTM is to be assessed solely on the basis of the relevant EU rules. The EUTMR does not require the Office or, on appeal, the GC to come to the same conclusions as those arrived at by national administrative bodies or courts in similar circumstances. The Office may nevertheless take those decisions into consideration — without them being binding or even determinative — as indicia in the assessment of the facts of the case (paras 35 and 36). Although in the present case, the BoA has rightly pointed out that it was not bound by case-law of national courts, it however added in the same paragraph that, in the case at issue, insofar as a national Supreme Court had ruled that the term 'Winnetou' was descriptive in Germany, the EUTM had also to be regarded as ineligible for protection for goods and services connected to books, radio and television. Thus, the BoA accepted the findings of the German Court without carrying out an independent, autonomous assessment. Consequently, the BoA treated the decisions of the German Court not as possessing an indicative value as evidence in the context of the assessment of the facts of the case, but — erroneously — as binding as to the registrability of the contested mark (paras 41 and 42). Consequently, the contested decision must be annulled insofar as it upheld the application for a declaration of invalidity to the extent that the error of law vitiates both the BoA's assessment of the application of Articles 7(1)(b) and (c) EUTMR (para. 46). It must therefore be held that the contested decision is also vitiated by an inadequate



statement of reasons (para. 80). Based on the foregoing, the GC annulled the contested decision insofar as it rejected the application for a declaration of invalidity.

[T-54/15; Liiga](#); Judgment of 28 April 2016; *Jaakiekon SM-liiga Oy v EUIPO*; Language of the case: EN.



The EUTM applicant sought to register the figurative sign represented above as an EUTM for goods and services in, inter alia, Classes 28 and 41. The Office refused the registration of the EUTM application as regards these goods and services pursuant to Articles 7(1)(b), (c) and 7(2) EUTMR, as it was found to be descriptive and devoid of distinctive character. The BoA dismissed applicant's appeal. It found that the mark was descriptive and devoid of any distinctive character, because the verbal element of the sign would be perceived as 'Liiga', a Finnish word that means 'league'. The word should inform the consumers directly that the goods and services in question are related to sports leagues/leagues, and is therefore descriptive. The figurative elements were found to be banal and not presenting any striking originality, which could add to the distinctive character of the mark. Both the figurative and word elements of the sign were devoid of distinctive character and there was no interaction between them that would endow upon the sign applied for the minimum distinctiveness. Since the trade mark had a clearly descriptive meaning as regards the goods and services in question, it was necessarily also devoid of distinctive character under Article 7(1)(b) EUTMR. The applicant filed an action before the GC relying on a single plea in law: infringement of Article 7(1)(b) and (c) EUTMR. The GC dismissed the appeal. The GC confirmed the finding of BoA that the average consumer in this case was Finnish, and that the verbal element of the sign would be perceived as 'liiga' and not 'Lüga' because 'ü' is not used in the Finnish language (paras 19 to 20). The GC found that the relevant consumer would be more likely to interpret the verbal element of the sign as a competitive sports league, namely a championship, which is the meaning of the word 'Liiga' in Finnish. It found it much less likely that the same consumer would read the word in such a way that it would make no sense. Consequently this word would convey a clear and direct message relating at least to the intended purpose of the goods and services at issue. The GC observed that both games and playthings and, even more so, gymnastic and sporting articles could directly relate to a competitive sports division or championship, so as do services relating to sporting activities (para. 21). The GC found the stylisation of the word element of the mark to be limited to giving a handwritten appearance to the word 'Liiga', which however remained easily legible. Furthermore, given its simple and abstract configuration, the black circle placed behind the word element of the mark would be seen as a background for the latter. Even if the consumer would see it as a ball or hockey puck, it would serve to reinforce the link between the word element of the mark applied for and a particular sport. The GC confirmed the finding of BoA and observed that various elements, which compose the mark applied for, did not interact in such a way as to eclipse the relationship between the mark and the characteristics of the goods and services for which the registration was refused. Thus, assessed as a whole, the mark applied for had a sufficiently direct and specific relationship with games, playthings,



gymnastic and sporting articles, as well as services relating to sporting activities, to enable the public concerned to immediately perceive the intended purpose, at the very least, of these goods and services when they are marketed under this sign (paras 22 to 23). The mark applied for was therefore, given its descriptive character, devoid of distinctive character.

[T-361/15](#); **CHOICE CHOCOLATE & ICE CREAM**; Judgment of 12 April 2016; *Choice sp. z o.o., v EUIPO*; Language of the case: PL.



The BoA confirmed the refusal of the EUTM application represented above for goods in Class 30 and services in Class 43 pursuant to Article 7(1)(c) EUTMR. The applicant filed an action before the GC claiming an infringement of Article 7(1)(b) and (c) EUTMR. The GC dismissed both claims. As regards Article 7(1)(c) EUTMR, the concerned goods are *chocolate, ice-cream and desserts*, whereas the services are related to the production thereof (para. 17). The relevant public is the general one and does not have an enhanced level of attention (para. 21). The word elements of the sign are related to the goods (chocolate and ice cream) or are laudatory (choice), the combination thereof follows grammar rules and has a clear meaning (paras 24 to 25). The graphical element is not capable of distracting the public from the descriptive message of the word element (para. 28 et seq.). As regards Article 7(1)(b) EUTMR, there is no need to examine this ground for refusal because the ground mentioned in Article 7(1) EUTMR is sufficient.

[T-261/15](#); **Daylong**; Judgment of 19 April 2016; *Spirig Pharma AG v EUIPO*; Language of the case: FR.



The EUTM applicant sought to register the abovementioned figurative mark for *cosmetic preparations* in Class 3 and *medical devices* in Class 10. The Office rejected the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR, as ‘daylong’ means ‘lasting the entire day’ and is descriptive of the relevant products. The BoA dismissed the appeal and took the view that the evidence filed did not prove the acquisition of distinctive character through use. The applicant did not appeal against the BoA’s finding regarding Article 7(3) EUTMR. The GC confirmed that the clear and evident meaning of the EUTM application will be immediately and directly perceived by the relevant public (para. 33). The figurative element is immediately recognised as the letter O (para. 37). For both *cosmetic products* and *medical devices*, the fact that they can be used and/or that their effects last the entire day is an important quality.



[T-89/15](#); **NIAGARA**; Judgment of 27 April 2016; *Niagara Bottling LLC v EUIPO*; Language of the case: EN. The BoA confirmed the refusal of the word mark **NIAGARA** for goods in Class 32 pursuant to Article 7(1)(b) and (c) EUTMR with the reasoning that the mark can be perceived as an indication of the geographical origin of the goods. The applicant filed an action before the GC claiming an infringement of Articles 7(1)(c) EUTMR, 7(1)(b) EUTMR and failure to state the reasons. The GC confirmed the decision of the BoA. As regards signs or indications that may serve to designate the geographical origin or destination of the categories of goods, or the place of performance of the categories of services, for which the protection of an international registration designating the European Union is sought, especially geographical names, pursuant to Article 7(1)(c) EUTMR it is in the public interest that they remain available, not least because they may be an indication of the quality and other characteristics of the categories of goods or services concerned, and may also, in various ways, influence consumer preferences by, for instance, associating the goods or services with a place that may evoke positive feelings. Registration is not permitted of geographical names as trade marks if they designate specified geographical locations that are already famous, or are known for the category of goods or services concerned, and are therefore associated with those goods or services in the mind of the relevant class of persons, on the one hand, and nor is the registration of geographical names, liable to be used by undertakings, that must also remain available to such undertakings as indications of the geographical origin of the category of goods or services concerned, on the other (paras 15 to 16 with a reference to settled case-law). It is not disputed that the word ‘Niagara’ is a geographical term that refers to the River Niagara and, above all, to the waterfalls of the same name known to the relevant public. As the BoA correctly stated, it must be noted that the most important characteristic of a waterfall is its abundance of water. The parties agree that the goods covered by the mark applied for are water-based drinks and include the word ‘water’ in their name. Regarding the nature of the relationship between the sign **NIAGARA** and the goods at issue, the BoA rightly held that the relevant public will perceive that the goods concerned originate from a geographical area in which the Niagara falls are situated (paras 23 to 25).

[T-298/15](#); **EFEKT PERLENIA**; Judgment of 12 May 2016; *Atlas sp. z o.o., v EUIPO*; Language of the case: PL.



The BoA confirmed the refusal of the registration for the EUTM application represented above for goods in Classes 1, 2, 17 and 19 pursuant to Article 7(1)(c) EUTMR, as it was found to be descriptive of a hydrophobic characteristic of all contested goods. The words ‘efekt perlenia’ mean in Polish ‘drop effect’ used for the phenomenon of building of drops of water on a hydrophobic surface. The figurative elements show water drops on a surface and only underline the descriptive message. The EUTM applicant filed an action before the GC claiming the infringement of Article 7(1)(c) EUTMR. The GC confirmed the assessment of the BoA. It emphasised that the figurative elements of the EUTM application were duly assessed in the contested decision but only illustrate the descriptive meaning of the word element



(para. 24). The reasoning in the contested decision was considered sufficient, as it addressed all homogenous groups of goods (para. 25). Finally the GC emphasised that even if the word mark **EFEKT PERLENIA** was previously registered, this fact does not entitle the EUTM applicant to the registration of the contested mark. Only the EUTMR in its interpretation by the GC of the EU — and not the previous decisions of the Office — define what can be registered as an EUTM.

◆ [T-590/14](#); **ULTIMATE FIGHTING CHAMPIONSHIP**; Judgment of 12 May 2016; *Zuffa, LLC v EUIPO*; Language of the case: EN. The applicant sought to register the word sign **ULTIMATE FIGHTING CHAMPIONSHIP** for goods in Classes 9, 16, 28 and 41. The Office rejected the application for all the goods (with the exception of *playing cards and computer game controllers* in Class 28). The BoA dismissed the appeal. The applicant filed an application before the GC for the annulment of the decision of the BoA relying on three pleas in law: (i) infringement of the obligation to state reasons; (ii) infringement of Article 7(1)(b) and (c) EUTMR; and (iii) infringement of Article 7(3) EUTMR. Concerning the second plea, specifically regarding the descriptiveness of the mark pursuant to Article 7(1)(c) EUTMR, the GC held that the contested mark will be perceived by the relevant public as denoting ‘the highest, best or most extreme combat in the form of a contest or a series of contests held to determine a champion’ and the expression, taken as a whole, is not capable of having a meaning that is different from the sum of the word elements of which it consists. Each of the goods and services at issue could relate to an ultimate fighting championship, which is sufficient to establish that the mark applied for is descriptive even in the eyes of the specialist public with a particular interest in mixed martial arts. Moreover, even assuming that the applicant is justified in maintaining that the general public is accustomed to the use of the names of sporting competitions as trade marks, it must be held that all the competitions to which it refers (the World Cup, the Masters Golf, the Championships (Wimbledon)) are unquestionably well-known, which is likely to render them distinctive. That argument therefore, in actual fact, relates to whether the mark applied for has acquired distinctive character through its use, and not to whether it has inherent distinctiveness (paras 56 to 65).

◆ [T-805/14](#); **MEGABUS.COM**; Order of 25 May 2016; *Stagecoach Group plc v EUIPO*; Language of the case: EN. The EUTM applicant sought to register the word mark **MEGABUS.COM** for goods and services in, inter alia, Classes 16, 35 and 39. The examiner rejected the application for all the goods and the services mentioned on the basis of Article 7(1)(b) and (c) EUTMR. The BoA dismissed the appeal. The applicant filed an application before the GC for the annulment of the decision of the BoA. In support of its action, the applicant relies, in essence, on four pleas in law, alleging: (i) infringement of Article 7(1)(c) EUTMR; (ii) infringement of Article 7(1)(b) EUTMR; (iii) infringement of Article 75 EUTMR; and (iv) infringement of Article 7(3) EUTMR. The GC found that the first plea based on Article 7(1)(c) EUTMR, though admissible, was manifestly unfounded. The GC upheld the finding of the BoA that the word ‘mega’ meant ‘very large, great, excellent’, that the word ‘bus’ designated a ‘large motor vehicle carrying passengers by road’ and that those two words, which are part of basic English vocabulary and exist in other languages of the European Union, would be immediately perceived by the relevant public as a reference to a very large or excellent bus. Furthermore, as correctly stated by the BoA, the element ‘.com’ is a common domain name denoting commercial entities, widely used and known throughout the entire European Union. The BoA was therefore correct in finding that that the sign would be immediately perceived by the relevant public as being directly descriptive of the services in Class 39 and as describing the subject matter and intended purpose of the goods in Class 16 and services in Class 35 (paras 31 to 33). The only argument put forward by the



applicant is that the fact that the BoA used forty words to explain the descriptive character of the sign cannot be directly descriptive of the kind or quality of the relevant goods and services. That argument is clearly not capable of invalidating that conclusion: firstly, the BoA by no means used forty words to describe the meaning of the mark applied for; secondly, the fact that the explanation of that meaning requires more than just a few words does not mean that such a meaning will not be grasped immediately, without further reflection, by the relevant public (paras 34 to 38).

♦[T-331/15](#); **THE SNACK COMPANY**; Judgment of 26 May 2016; *Bimbo, S.A. v EUIPO*; Language of the case: ES.



The sign **THE SNACK COMPANY** was applied for under the general headings in Classes 29 and 30. It was rejected by the examiner as being descriptive for the goods for which protection was sought and devoid of distinctiveness for the relevant English-speaking consumer in the European Union. The BoA confirmed the examiner’s decision except as regards *coffee, tea* and *ice* in Class 30 for which it found that this decision lacked reasoning and gave the case back to the first instance. The GC emphasised that the BoA made a global assessment of the sign applied for and not only of the verbal elements when it considered the sign descriptive. Figurative elements are purely ornamental and do not serve to detract consumer’s attention from the descriptive part of the sign (paras 25 and 26). It is sufficient that one of the potential meanings of the sign applied for has a descriptive character in order that Article 7(1)(c) EUTMR is applicable therefore, it is not necessary that the sign is in use or that it might also have other meanings (para. 29). ‘The snack company’ describes the goods produced by a snack company or used as ingredients for producing snacks (paras 32 to 33). The two categories made by the BoA are sufficiently homogeneous so the BoA was not compelled to pronounce itself on the descriptive character of each of goods involved, not even as regards more defined subcategories (para. 41). The trade mark system of the European Union is autonomous and has specific objectives. The Office is not bound by a decision taken at national level, even if it refers to a Member State with the same linguistic regime as the one provoking the refusal of the application (para. 49). As regards the applicant’s submission that other signs similar to the contested mark have been registered as Community trade marks, the GC recalled the established case-law to the effect that the principles of equal treatment and sound administration must be consistent with respect for legality (paras 53 to 56).

♦[T-454/14](#); **STONE**; Judgment of 31 May 2016; *Warimex Waren-Import Export Handels-GmbH v EUIPO*; Language of the case: DE.





The applicant sought to register figurative mark represented above as an EUTM for goods and services in Classes 1, 3, 7, 8, 9, 11, 12, 16, 21, 24 and 25. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR, as it was found to be descriptive and devoid of distinctive character. The BoA confirmed this refusal. The EUTM applicant filed an action before the GC, claiming the infringement of Article 7(1)(b) and (c), Articles 75 and 76 EUTMR. The GC dismissed all claims. As regards the alleged infringement of Article 7(1)(c) EUTMR, the GC confirmed the findings of the BoA that the relevant consumers belong to the English-speaking general as well as professional public (para. 60). It confirmed the descriptive character of the sign in connection with all contested goods (para. 92). As the existence of one ground quoted in Article 7(1) EUTMR is sufficient for the refusal, the GC did not examine the alleged infringement of Article 7(1)(b) EUTMR (para. 94).

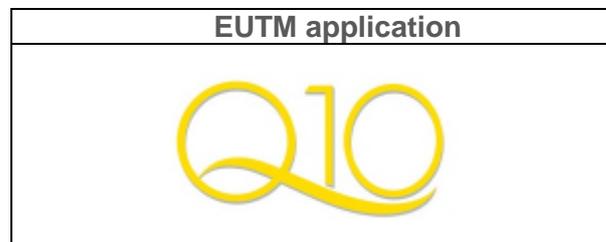
[T-629/15](#); **SCRUBMASTER**; Order of 17 June 2016; *Hako GmbH v EUIPO*; Language of the case: DE. The Office rejected the EUTM application **SCRUBMASTER** for various cleaning-related apparatus (in Class 7) on the basis of Articles 7(1)(b) and (c) EUTMR. The BoA dismissed the appeal as the sign would provide to the relevant public clear information of the purpose and quality of the cleaning machines applied for. The applicant claimed the breach of Articles 7(1)(b) and (c) EUTMR due to the fact that (i) the BoA did not explicitly define the relevant public, (ii) did not consider the grammatical incorrectness and the alternative meanings of the terms ‘scrubmaster’ and ‘master’, and (iii) did not consider the existence of previous similar registrations. The GC dismissed the action by a reasoned order. As to claim (i), it found that it was based on a misreading of the contested decision. The remaining claims were rejected on the basis of the well-established principles set out in the case-law.

♦[T-11/15](#); **SUEDTIROL**; Judgment of 20 July 2016; *Internet Consulting GmbH v EUIPO*; Language of the case: DE. The request for declaration of invalidity of the EUTM **SUEDTIROL** (word mark) for Classes 35, 39 and 42 based on Article 7(1)(c) EUTMR was rejected by the CD. However, the Grand Board reversed that decision and declared the mark invalid as a descriptive indication. The applicant filed an application before the GC based on two pleas in law: (i) an alleged infringement of Article 5 EUTMR in conjunction with Article 56 EUTMR and (ii) an alleged infringement of Article 7(1)(c) EUTMR in conjunction with Article 12 EUTMR and Article 52 EUTMR. **Article 7(1)(c) EUTMR**: the GC recalls the case-law with respect to geographical denomination according to which for such signs there is a public interest that they remain available, not only because they may be an indication of the quality and other characteristics of the categories of goods concerned, but also because they may influence consumer tastes by associating the goods or services with a place that may give rise to a favourable response (para. 30). The relevant public are business consumers with an above-average attention. As to the meaning of the sign, the Italians and German-speaking consumers in Italy, Austria and Germany will know **SUEDTIROL** (equivalent of ‘Südtirol’) as referring to the northern region in Italy (paras 36 to 38). As to the understanding of the sign by the relevant consumers, the GC confirms the findings of the Grand Board that the public will immediately perceive the denomination as a geographical indication of an important region, which is very well known because of its historical, cultural and economic background. This is a well-known fact (para. 40). Thus, the sign indicates that the services in question are adapted to the specific needs of the economic, linguistic and political conditions in that area. The sign conveys a positive image and that the services are of a high quality. The public might also believe that the services are provided in ‘Südtirol’. Indeed, the intervener has shown in the administrative proceedings that there are many providers of these services in that region (paras 42 and 43). The GC further states that the examination of



the specific link between a geographical indication of origin and the goods or services may vary from case to case depending on the extent, the reputation or the nature of the geographical indication in question. The more important the region, the less need there is to show how this link is to be established. In the case in question it is enough to determine the reputation and importance of the geographical indication in order to conclude that there is a link between the services and the region. In any event, the Grand Board established in more detail the link between the sign and the services, which cover broad categories and have no further particularities that would make the consumers believe that the services do not come from that region. Consequently, the consumers will assume that the sign merely indicates the geographical origin of the services in the sense of Article 7(1)(c) EUTMR (paras 44 to 49). The GC confirms that the indication of the place of business of the service provider is a relevant criterion, which enables to establish a descriptive character (para. 51). **Article 12 EUTMR in conjunction with Article 52 EUTMR:** the GC confirms the case-law (T-295/01 OLDENBURGER) that Article 12 EUTMR, which refers to limitations of the rights of a owner of an EUTM, is not applicable in the examination if a mark is descriptive in the sense of Article 7(1)(c) EUTMR. Article 12 EUTMR does not confer on third parties the right to use an indication that forms part of an EUTM as a trade mark but merely to use it in a descriptive way to the extent that such use is in accordance with honest practise in industrial or commercial matters (paras 52 to 55). Consequently, the applicant's claim that Article 12 EUTMR would satisfy the needs of the market to freely use the term **SUEDTIROL** is dismissed by the GC (para. 56).

[T-4/15](#); **Q10**; Judgment of 7 September 2016; *Beiersdorf AG v EUIPO*; Language of the case: DE.



The applicant sought to register the figurative mark represented above as an EUTM for *soaps, perfumery, essential oils, cosmetics, hair lotions* in Class 3, adding a disclaimer to the effect that it does not claim any exclusive right as regards the sign 'Q10' as such. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR, as it was found to be devoid of distinctive character and to be descriptive in relation to the goods in question. The BoA dismissed the applicant's appeal. It held that the disclaimer cannot be accepted as it seeks to exclude the principal, if not only, component so that nothing remains in the application that can be subject to an exclusive trade mark right. The EUTM application describes within the meaning of Article 7(1)(c) EUTMR that the goods contain the active component 'Q10'. For this reason, the EUTM application also lacks the required distinctiveness under Article 7(1)(b) EUTMR. The applicant filed an action before the GC relying on three pleas in law, namely: (i) infringement of Article 37(2) EUTMR, (ii) infringement of Article 7(1)(b) EUTMR, and (iii) infringement of Article 7(1)(c) EUTMR. The GC dismissed the appeal. The entry of a disclaimer presupposes a distinctive element of the sign applied for (para. 17). It serves to clarify that the exclusive trade mark right does not extend to the non-distinctive elements, which remain in the public domain (para. 18). As to the sign in question, the figurative elements, namely the yellow colour, the extended stroke of the letter 'Q' and the typeface are too simple and banal to be perceived as distinctive



elements to be separated from the word ‘Q10’ and thus do not determine the public’s perception. Hence, the BoA was entitled to refuse the disclaimer (paras 21 to 26). Furthermore, the figurative elements do not render the sign, which designates the coenzyme ‘Q10’ contained in the goods, distinctive within the meaning of Article 7(1)(b) EUTMR (paras 31 and 36).

[T-360/15](#); **69**; Judgment of 8 September 2016; *Dr Vita sp. z o.o., v EUIPO*; Language of the case: PL.



The BoA confirmed the refusal of registration of the EUTM application represented above for *condoms* in Class 10, pursuant to Article 7(1)(c) EUTMR, as it was found to be descriptive of a characteristic of the contested goods. In relation to the goods for which registration is sought, the trade mark applied for ‘69’ informs the target public (average, reasonably well-informed and reasonably observant and circumspect consumers) that the contested goods are size 69 condoms (69 mm width) or that the condoms are sold in packs of 69 pieces. According to the evidence on file, 69 mm is a typical condom width in the case of penis girths of 17-18 cm. The figurative elements are too simple to divert the consumer’s attention from the descriptive message of the number ‘69’. The EUTM applicant filed an action before the GC claiming the infringement of Article 7(1)(b) and (c) EUTMR. The GC confirmed the assessment of the BoA and decided that the EUTM application is to be rejected pursuant to Article 7(1)(c) EUTMR. It emphasised that the numeral ‘69’ will be perceived first in the EUTM application and that the figurative elements are only of typographic or ornamental nature (para. 21). It emphasised that in the light of the evidence quoted in the contested decision, the width of a condom amounts to its relevant or even essential characteristic from the perspective of the relevant public (para. 27). Finally the GC emphasised that even if marks containing numerals were previously registered, this fact does not entitle the EUTM applicant to the registration of the contested mark. Only the EUTMR in its interpretation by the GC — and not the previous decisions of the Office — defines what can be registered as an EUTM (para. 30). As the rejection based on Article 7(1)(c) EUTMR was confirmed, the GC did not analyse the claim based on Article 7(1)(b) EUTMR.

♦ [T-563/15](#); **APOTEKE**; Judgment of 13 September 2016; *Pagliari Sell System Sp.A v EUIPO*; Language of the case: IT.





The EUTM applicant sought to register the figurative mark represented above for an extensive range of goods in Classes 3, 5, 29 and 30. The examiner refused the registration of the EUTM application and the BoA confirmed the refusal for all of the goods. The applicant filed an action before the GC relying on three pleas in law: (i) infringement of Article 75 EUTMR, (ii) infringement of Article 7(1)(c) and (iii) infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal. Regarding the second plea in law, the GC further endorsed the finding of the BoA that the relevant public is made up of average consumers and professionals (para. 28) who speak German, Danish and Croatian given the similarity between the word **APOTEKE** and its equivalent words in those languages (para. 36). The word **APOTEKE** will be perceived by this public as a misspelling (para. 38), and will immediately be understood as referring to the concept of a pharmacy (para. 44). The GC found that the figurative elements are not capable of diverting the consumer's attention from the descriptive content of the verbal element, as both the colour green and the image of a red cross are used to indicate pharmacies (para. 46). These figurative elements reinforce the descriptive meaning of the mark as affirmed by the BoA (para. 47). The BoA was correct in finding that the relevant public would see the mark as designating a place (pharmacy or parapharmacy) where all of the goods specified may be purchased (para. 49), either actually or potentially within the meaning of Article 7(1)(c) EUTMR (paras 50 to 57). The application was fully examined and rightly found to be concretely descriptive. Therefore, the GC found that the applicant cannot rely on previous decisions of the Office in order to challenge the findings of the present case (para. 62). Since it is sufficient for the mark to be refused registration if one of the absolute grounds is applicable, the GC did not adjudicate on the plea pursuant to Article 7(1)(b) EUTMR (paras 63 to 66).

♦ [T-237/15](#); **NANO**; Judgment of 22 September 2016; *Edward Labowicz v EUIPO, Pure Fishing, Inc.*; Language of the case: EN.



The EUTM proprietor was granted the registration of the figurative mark represented above for a range of goods in Class 28 (in short, *fishing equipment*). An application for a declaration of invalidity was filed against the abovementioned mark for all of the goods. The CD declared the contested mark invalid for all the goods on the basis of Article 7(1)(b) and (c) EUTMR. The First BoA dismissed the appeal. The EUTM proprietor filed an application before the GC for the annulment of the decision of the BoA relying on three pleas in law: (i) infringement of Article 7(1)(c) EUTMR; (ii) infringement of Article 7(1)(b) EUTMR; and (iii) infringement of Articles 76 and 83 EUTMR and of Articles 6 and 14 of the Convention for the Protection of Human Rights and Fundamental Freedoms. As regards the first plea, based on an alleged infringement of Article 7(1)(c) EUTMR, it was not disputed that the relevant public is made up of consumers and of specialist retailers in the field of fishing, who form a well-informed and observant public (para. 10). The GC confirmed that the term 'NANO' is understood as a designation for 'nanotechnology', or 'goods manufactured using nanotechnology' or 'goods which are small in size', as is apparent from the case-law of the GC judgments (cases T-6/07, *Nanolat*, para. 48 and T-379/13, *NANO*, paras 51 and 56), (paras 37 to 38). According to the GC, the evidence filed before the Office (inter alia, extracts from websites,



articles intended for fans of fishing), showed that nanotechnology was used to manufacture fishing equipment such as that at issue and that the public was likely to perceive the use of nanotechnology as an important characteristic of the equipment in question (para. 43). Secondly, in the extracts from websites referred to in the contested decision, the term ‘NANO’ is, on a number of occasions, used in expressions connected with nanotechnology, such as ‘nanotubes’, ‘nano coating’, ‘nano-thin films’, or ‘nanocomposites’, (para. 45). In addition, the existence of the decision-making practice contrary to the findings of the contested decision, invoked by the applicant, was not established, since, with the exception of a not final decision (Case R 1241/2012-2, NANOFIL), he has not identified the decisions or applications for registration that are part of that decision-making practice (paras 34 to 39). The GC stated that the BoA was therefore right to find that the term ‘NANO’ was descriptive of the goods covered, inasmuch as it referred to the fact that they had been manufactured using nanotechnology. Indeed, the contested mark refers in a direct, specific, normal and comprehensible manner to a characteristic that is capable of having an influence on their functional qualities, namely to the fact that they have been manufactured using nanotechnology (paras 49 to 51).

♦ [T-129/15](#) and [T-130/15](#) (joined cases); **WAVE 2 PAY** and **WAVE TO PAY**; Judgments of 28 September 2016; *Intesa Sanpaolo SpA v EUIPO*; Language of the cases: IT.

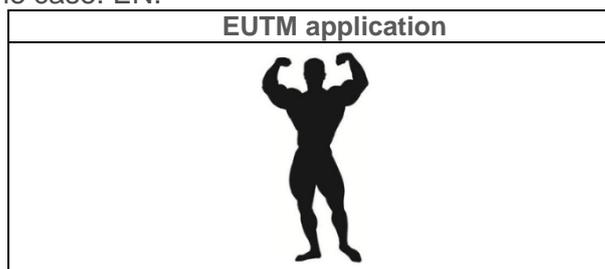
EUTM application T-129/15	EUTM application T-130/15
WAVE 2 PAY	WAVE TO PAY

An application for registration of the word marks **WAVE 2 PAY** and **WAVE TO PAY** as EUTMs was filed for a range of goods and services in Classes 9, 16, 36 and 38. The BoA confirmed the partial refusal of the marks applied for, due to the descriptive nature and also due to the lack of distinctiveness in relation to a part of the goods and services. The applicant put forward three pleas in law, alleging (i) an infringement of Article 7(1)(c) EUTMR, (ii) an infringement of Article 7(1)(b) EUTMR, (iii) an infringement of Article 75 EUTMR. **Article 7(1)(c) EUTMR:** the GC confirmed that the relevant public is made of English-speaking consumers and professionals and the level of attention will be average for the former part of consumers and high for the latter part. The GC endorsed the findings of the contested decision that the expressions ‘WAVE 2 PAY’ and ‘WAVE TO PAY’ will be understood with the meaning of ‘wave for paying’ by the anglophone relevant consumers. In fact, those terms are commonly and currently used on the market and are understandable for any English speaker (para. 25). In relation to the goods and services in question, the GC confirmed the finding that they consist, on the one hand, of apparatus, instruments and data carriers capable to include, for example, motion sensors needed to make the payment and also mechanisms for the registration and the transmission of the payment (Class 9), and also of goods made of paper such as tickets and receipts, which are given to the consumer when the transaction is done (Class 16). On the other hand, the services in question are services necessary to make the payment or the electronic transaction (Class 36), and they are also services used for the transmission of the data related to the payment (Class 38). Those findings were not disputed by the applicant (para. 26). Therefore, the GC confirmed the finding that the mark applied for will be perceived by the relevant public as an indication that the concerned goods and services refer to a payment technology by which it is possible to make payments by simply waving a device before a sensor. Therefore, the marks indicate to



the public, in an immediate and direct way, one of the characteristics of the relevant goods and services (paras 27 to 28). The GC therefore found that the BoA did not err in concluding, that marks applied for fall within the scope of the prohibition laid down in Article 7(1)(c) EUTMR (para. 34).

[T-335/15](#); **DEVICE OF A BODYBUILDER**; Judgment of 29 September 2016; *Universal Protein Supplements Corp., established in New Brunswick, New Jersey (United States) v EUIPO*; Language of the case: EN.



The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 5, 25 and 35. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR, as it was found to be descriptive and devoid of any distinctive character. The BoA dismissed the applicant's appeal. It found that that the mark applied for was caught by the prohibition laid down by Article 7(1)(c) EUTMR. It also found that the mark applied for was devoid of any distinctive character, within the meaning of Article 7(1)(b) EUTMR, on the ground that it is a representation of a bodybuilder, which does not enable the relevant public to perceive it as an indication of the commercial origin of goods or services. The applicant filed an action before the GC relying on two pleas in law: (i) infringement of Article 7(1)(b) EUTMR and (ii) Article 7(1)(c) EUTMR. The GC dismissed the appeal. It found that the sign at issue is a silhouette, represented in black, of a person adopting a typical bodybuilding pose displaying the muscles of his body and it will thus be perceived by the relevant public as the representation of a bodybuilder. Therefore, the message conveyed by that sign is related to bodybuilding. As regards goods in Class 5, namely *nutritional supplements*, they help to build muscles and therefore are part of the diet of bodybuilders, who can purchase them in shops specialised in sports equipment. It must therefore be held that the sign at issue is descriptive of the goods covered by the registration application for Class 5 goods. As for *clothing* and *footwear*, covered by Class 25, the representation of a body-builder is also descriptive of those goods, in that they include clothing items and shoes specifically designed for body-building. Finally, as regards *On-line retail store services featuring nutritional supplements; health and diet-related products; clothing and shoes* in Class 35, to the extent that they relate to the sale of the goods described in paragraph 27 and 28 above, the same considerations are valid. The GC noted that the technique known as 'silhouette', used for the representation of the sign at issue, does not amount to a particularly stylised form of representation. Indeed, the image in question represents in a fairly realistic way the silhouette of a bodybuilder in a typical pose which highlights the body's muscles and, in particular, those of the arms. No detail or characteristic of that image goes beyond the standard representation of a bodybuilder. As regards the argument that the sign at issue has several meanings and conveys a message that goes beyond that related to a 'bodybuilder' or 'bodybuilding', preventing the relevant public from perceiving the mark applied for as merely descriptive, the alleged aesthetic character of the stylised image does not require any mental effort on behalf of the relevant public, the latter being immediately able to perceive the meaning of the sign at issue, which refers to the concept of 'bodybuilder' or 'bodybuilding'. In the third place, the claim that there



is no general interest in requiring that a representation such as that in the present case be available because there are practically unlimited ways of depicting bodybuilders is irrelevant. According to settled case-law, the application of Article 7(1)(c) EUTMR does not depend on the existence of a real, current or serious need to leave a sign free. The GC considered unnecessary to review whether the sign at issue would be distinctive, and concluded that the bodybuilder silhouette could not be registered as a trade mark because of the prohibition in Article 7(1)(c) EUTMR.

♦[T-337/15](#); **RESCUE**; Judgment of 29 September 2016; *Bach Flower Remedies Ltd v EUIPO*; Language of the case: EN. An application for invalidity was filed pursuant to Article 52(1)(a) in conjunction with Article 7(1)(b) and (c) EUTMR against the word mark **RESCUE** registered for goods in Classes 3, 5, 30, 31 and 32. The CD partly upheld the application for invalidity finding the mark descriptive and non-distinctive for some of the goods. The BoA dismissed the appeal. It found that the word ‘RESCUE’ meant, inter alia, the fact of being saved and the fact of providing relief and that there was a direct link between that word and the goods. The mark is descriptive of the properties of the goods. The evidence of acquired distinctiveness was not submitted for the whole of the relevant territory. The GC concurred with the BoA’s definition of the word ‘RESCUE’ quoting the Oxford Dictionary. It refused the EUTM proprietor’s arguments that in common language the word is used only in the meaning of ‘to save’ and not ‘to cure’ or ‘to assist’. The GC quoted the dictionary and stated that in less formal language, it can mean the fact of providing someone with relief, assistance or aid. Further, the GC recalls that the Nice classification serves purely administrative purposes; the fact that some of the goods at issue are classified in classes other than Class 5 does not mean that such goods cannot have the function or intended purpose of providing aid or assistance to consumers. Moreover, it is irrelevant that other words exist that may be used more often to describe some characteristics of the goods. Article 7(1)(c) EUTMR does not require that the mark in question should be the only way of designating the characteristics described. It is also irrelevant whether the characteristics of the goods described by the sign in question are commercially essential or merely ancillary. The mark is descriptive in relation to goods in Class 3: *cosmetics, toiletries, perfumery*; Classes 30 and 32: *beverages*; Class 31: *agricultural, horticultural and forestry products*; and Class 5 *pharmaceuticals* because all these products can have beneficial effects on the consumers’ physical or mental condition. Those goods can thus aid a person and be perceived as ‘coming to the rescue’. The consumers will immediately establish a direct and specific link between these goods and the effect of using them. The BoA was entitled to analyse all categories of goods because they are sufficiently homogenous.

[T-776/15](#); **MEISSEN KERAMIK**; Judgment of 18 October 2016; *Meissen Keramik GmbH v EUIPO*; Language of the case: DE.



The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 11, 19 and 20 such as *sanitary devices, building materials or*



furniture. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR, as it was found to be descriptive and devoid of distinctive character. The BoA dismissed the appeal. It found that the German-speaking public would understand the terms ‘Meissen’ (a place in Germany) and ‘Keramik’ (ceramics) in the sense of ceramics originating from Meissen. The BoA held that the sign is descriptive for goods made of ceramics. For the remaining goods, which did not expressly contain ceramics there exists complementarity to ceramics. The graphical elements or the mark applied for were found to be minimal and not able to detract the attention of the public from the descriptive content of the sign. Furthermore the blue graphical element alludes to waves and thus also to sanitary installations made of ceramics. The applicant filed an action before the GC relying on two pleas in law, namely infringement of Article 7(1)(b) and (c) EUTMR. The GC dismissed the appeal. In paragraph 23 the GC found that the BoA did not necessarily have to take a benevolent or applicant-friendly approach as the applicant claimed, but rather had to perform a full and stringent examination as had been decided in judgments 10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 77; 08/06/2005, T-315/03, Rockbass, EU:T:2005:211, § 20; 13/09/2013, T-320/10, Castel, EU:T:2013:424, § 26 to 29. It dismissed also the argument that the term ‘Meissen Keramik’ is grammatically incorrect or that various mental steps would be necessary to make sense of the sign (para. 24). The graphics are neither characteristic nor striking, but commonplace, and in view of the goods, descriptive (para. 34). The overall impression is not influenced by the graphics as has been held already by the CJ in judgment 15/09/2005, C-37/03 P, BiolD, EU:C:2005:547, § 71, 74). As regards the goods at issue, the GC confirmed that they are in any event complementary to ceramics, which had not been disputed by the applicant. As the sign is descriptive and one absolute ground is fulfilled, the GC did not have to examine Article 7(1)(b) any further.

♦[T-56/15](#); **BRAUWELT**; Judgment of 18 October 2016; *Raimund Schmitt Verpachtungsgesellschaft mbH & Co.KG v EUIPO*; Language of the case: DE. The applicant sought to register the word mark **BRAUWELT** for goods and services in Classes 9, 16, 32, 35, 38, 41, 42 and 43. Both instances of the Office refused the registration of the mark due to lack of distinctive character and descriptiveness in the sense of Article 7(1)(b) and (c) EUTMR. The applicant filed an appeal before the GC claiming an infringement of Article 7(1)(b) and (c), Article 7(3) and Article 75 EUTMR. The applicant’s claim to alter the contested decision to the effect of registering the mark applied for was dismissed by the GC as inadmissible. Since the BoA does not have this power, the GC does not have it either (paras 9 to 14). The GC further declared the documents produced for the first time before it as inadmissible. The purpose of actions brought before the GC is to review the legality of decisions of the BoAs of the Office within the meaning of Article 65 EUTMR. It is not therefore the GC’s function to review the facts in the light of documents produced for the first time before it (paras 15 and 16). **Infringement of Article 7(1)(c) EUTMR in conjunction with Article 75 EUTMR:** the applicant contends that the BoA did not reason sufficiently why the mark would be descriptive for the goods and services. The GC states that the BoA complied with the applicable case-law. It adequately reasoned for each of the goods and services belonging to that category as to why the sign is descriptive. Consequently, the applicant’s claim is to be dismissed (paras 21 to 25). The GC confirms the assessment of the BoA as to the relevant consumers, who are the general public and the professional public. The attentiveness will be average or high (para. 35). As to the meaning of ‘BRAUWELT’ the GC upholds the findings of the BoA. As a whole it refers to ‘brewers’ world’ or ‘world of brewing’ and indicates a sales location or a wide-ranging offer of goods and services linked to brewing activity. The applicant did not produce any substantiated arguments to the contrary showing that the BoA’s assessment would be wrong (paras 37 to 54). Concerning



the link between the meaning of the sign and the goods and services, the GC confirms the findings of the BoA. In particular, it states the following: contrary to the applicant's assertions, the subject matter of the goods and services in Classes 9 and 16 may be brewing activity. In particular when the mark sought is affixed to 'data carriers', by its nature it informs the relevant public immediately of an essential characteristic of those goods, namely their thematic subject matter (para. 62). The mark sought will be understood by the relevant public as referring to a place of sale or performance in which beer and malt extracts in Class 32 or restaurant services in Class 43 were on offer (paras 63 to 65). Concerning the services in Class 35 it is of course possible that the marks referring to specialised fairs and exhibitions are often allusive without being descriptive. That is not so in the case of the mark sought, which informs the relevant public straightforwardly that the fair or exhibition concerns the field of brewing. As to the marketing services the sign informs that they may refer specifically to breweries (paras 66 to 69). As regards the technical services in Classes 38 and 42, the GC understands that the relevant public will see in the sign an indication as to the theme of portals or information relating to the services in question (paras 70 to 72). Regarding 'sporting activities' (Class 41), the BoA was correct in finding that brewing was steeped in tradition and was of cultural importance in Germany and Austria, giving rise to numerous celebrations comprising sporting aspects, such as beer-barrel rolling contests. The concept of sporting activity is not in any way incompatible with the idea of entertainment. Furthermore, the activities in question are competitive in nature and call for a physical effort on the part of the participants (paras 73 to 75). Finally, the services 'organisation and running of recreational musical events' (Class 41) could be related to the world of brewing, with the result that the mark sought was liable to be perceived by the relevant public as referring to that characteristic (para. 76). The earlier decisions accepting the expression 'Brauwelt' as a mark on which the applicant relied, are not an obstacle for the refusal of the mark in question. The principles of equal treatment and sound administration must be consistent with respect for legality. Consequently, the person who seeks registration of a sign as an EUTM cannot rely, to his own benefit, on any unlawful act committed in the past in order to obtain an identical decision. Moreover, for reasons of legal certainty and, indeed, of sound administration, the examination of any trade mark application must be stringent and comprehensive, in order to prevent trade marks being improperly registered. That examination must be undertaken in each individual case. The registration of a sign as a mark depends on specific criteria, which are applicable in the factual circumstances of the particular case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal (paras 77 to 84).

♦ [T-29/16](#); **CAFFÈ NERO**; Judgment of 27 October 2016; *Caffè Nero Group Ltd v EUIPO*; Language of the case: EN. The EUTM applicant sought to register the word mark **CAFFÈ NERO** as an EUTM for goods and services in Classes 25, 30 and 35. The examiner refused the application for all the goods and services in Classes 30 and 35 on the basis of descriptiveness, lack of distinctive character and deceptiveness. The First BoA dismissed the appeal. The EUTM applicant filed an application before the GC for the annulment of the decision of the BoA raising four pleas in law: (i) infringement of Article 7(1)(c) EUTMR; (ii) infringement of Article 7(1)(b) EUTMR; (iii) infringement of Article 7(1)(g) EUTMR; and (iv) infringement of the principles of equal treatment and sound administration. Regarding the first plea in law, namely infringement of Article 7(1)(c) EUTMR, the GC confirmed that the relevant goods and services mainly target the general Italian-speaking public with an average level of attention (para. 21). The GC endorsed the finding of the BoA that the fact that the Italian-speaking consumer will understand the expression 'caffè nero' as meaning 'black coffee', that is to say, coffee served as a beverage without cream, milk or sugar, can be considered to be a well-known fact (para. 28). Even if it were true that the expression



‘caffè nero’ were not a part of the Italian coffee culture, the Italian-speaking public will understand that it refers to coffee served as a beverage without any additions (para. 31). The BoA did not err in finding that the sign at issue is descriptive of coffee-related goods and services (para. 38). The first plea in law was therefore rejected (para. 39).

♦ [T-37/16](#); **CAFFÈ NERO**; Judgment of 27 October 2016; *Caffè Nero Group Ltd v EUIPO*; Language of the case: EN.



The EUTM applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 25, 30 and 35. The examiner refused the application for all the goods and services in Classes 30 and 35 on the basis of descriptiveness, lack of distinctive character and deceptiveness. The First BoA dismissed the appeal. The EUTM applicant filed an application before the GC for the annulment of the decision of the BoA raising four pleas in law: (i) infringement of Article 7(1)(c) EUTMR; (ii) infringement of Article 7(1)(b) EUTMR; (iii) infringement of Article 7(1)(g) EUTMR; and (iv) infringement of the principles of equal treatment and sound administration. Regarding the first plea in law, namely infringement of Article 7(1)(c) EUTMR, the GC confirmed that the relevant goods and services mainly target the general Italian-speaking public with an average level of attention (para. 21). The GC endorsed the finding of the BoA that the fact that the Italian-speaking consumer will understand the expression ‘caffè nero’ as meaning ‘black coffee’, that is to say, coffee served as a beverage without cream, milk or sugar, can be considered to be a well-known fact (para. 28). Even if it were true that the expression ‘caffè nero’ were not a part of the Italian coffee culture, the Italian-speaking public will understand that it refers to coffee served as a beverage without any additions (para. 31). The BoA did not err in confirming the examiner’s assessment that the figurative elements of the sign at issue did not endow the mark applied for, as a whole, with any distinctive character (para. 42). Consequently, the BoA did not err in finding that the sign at issue is descriptive of coffee-related goods and services (para. 43). The first plea in law was therefore rejected (para. 44).

[T-7/16](#); **LA TARTE TROPÉZIENNE 1955. SAINT-TROPEZ**; Judgment of 28 October 2016; *LA TARTE TROPÉZIENNE v EUIPO*; Language of the case: FR.



The applicant sought to register the figurative mark represented above as an IR designating the EU for goods in Class 30. The trade mark was partially rejected by the examiner as being descriptive of the goods for which protection was sought and lacking distinctiveness for the relevant French-speaking consumer in the European Union. The BoA partially annulled the



examiner’s decision (as regards goods that had no relation to cakes) and partly dismissed the appeal (as regards *cakes* and goods that could be used as ingredients for a cake) given that the mark designates a particular kind of cake traditionally produced in Saint-Tropez (France). The applicant based its action for annulment before the GC in essence on the argument that the combination of ‘LA’, ‘TARTE TROPEZIENNE’, ‘1955’ and ‘SAINT-TROPEZ’ would render the sign applied for complex and fanciful. In accordance with established case-law, the GC rejected these arguments and confirmed the BoA’s reasoning according to which neither the article ‘LA’ nor the date ‘1955’, which would be perceived as the date on which the cake had been invented, nor the additional geographical indication ‘SAINT-TROPEZ’ would be capable of diverting the relevant consumer’s from the clearly descriptive meaning of ‘TARTE TROPEZIENNE’.

[T-268/15](#) and [T-272/15](#) (joined cases); **PARKWAY**; Orders of 8 November 2016; *Apcoa parking GmbH v EUIPO*; Language of the cases: DE.



The applicant sought to register the word as well as figurative marks represented above as EUTMs for services in Classes 35, 36, 39, 42 and 45. The Office refused the registration of the EUTM applications (EUTM applications) pursuant to Article 7(1)(b) and (c) and Article 7(2) EUTMR, as being descriptive and devoid of distinctive character in parts of the EU. The BoA dismissed the applicant’s appeals. The applicant filed an action before the GC relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR and (ii) infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal. It concluded that ‘parkway’ is an English term and that it is the English speaking public of the European Union that have to be considered when assessing its descriptive character. The definition of the term ‘parkway’, as taken into account by the BoA, has been confirmed by relevant entries in English language dictionaries. The applicant did not challenge the reliability or reputation of these sources. The GC furthermore found that it is irrelevant that there might be other meanings of the term irrespective of its etymologic origin. In addition, use of ‘parkway’ as part of existing train stations confirms its descriptive character in relation to existing parking facilities of such train stations. As regards the figurative mark, the GC found that neither the colours nor the arrows are suitable to question the overall descriptive character of the mark. All the services covered by the applications, do either directly or indirectly relate to services specifically tailored for parking. In this regard, the BoA correctly concluded that the applications are descriptive and lack distinctive character.

♦[T-315/15](#); **ELECTRIC HIGHWAY**; Judgment of 17 November 2016; *Dale Vince v EUIPO*; Language of the case: EN. The applicant sought to register the word mark **ELECTRIC HIGHWAY** for various goods and services in Classes 9, 12, 39. The examiner refused this



EUTM under Article 7(1)(b) and (c) and Article 7(2) EUTMR for the services in Class 39. The BoA dismissed the appeal on the basis of Article 7(1)(b) and (c) EUTMR holding that ‘ELECTRIC HIGHWAY’ in relation to the services applied for was referring to a public road equipped with charging stations positioned at regular intervals and intended for electric vehicles. The mark applied for would therefore only be seen as a description of the kind and the intended purpose of the services concerned. The GC confirmed the BoA decision. As regards the infringement of Article 7(1)(c) EUTMR, the applicant submits, in essence, that the mark should be understood in a metaphorical sense, and that the BoA also infringed Article 75 EUTMR by using evidence on which the applicant had not had the opportunity to comment (para. 14). The GC found that the BoA was correct in finding that, in the present case, the relevant public was composed of English-speaking professionals working in the field of energy supply and distribution and also the average consumers of electricity who use electrical vehicles (para. 22). The GC confirmed that the relevant public will interpret the expression according to its logical meaning and understand it to refer to a road equipped with charging stations for electric vehicles (para. 23). Given that the circumstances characterising the use of electric vehicles are well known, the BoA is under no obligation to rely on specific evidence in that regard (para. 25). According to the GC, a ‘metaphorical’ sense derived from the mark at issue still conveys the idea of a ‘highway for electricity’, which is also descriptive for the services (para. 28). It adds that the failure of the BoA to communicate just one out of four online reviews to which it made reference in order to establish the actual use of the mark applied for in a way that is descriptive of the relevant services does not constitute an infringement of the right of the defence capable of justifying the annulment of the contested decision (para. 30).

[T-225/16](#); **Ganz schön ausgeschlafen**; Order of 28 November 2016; *Matratzen Concord GmbH v EUIPO*; Language of the case: DE. The EUTM applicant sought to register the word mark **Ganz schön ausgeschlafen** as an EUTM for services in Class 35. The examiner refused the application on the basis of descriptiveness and lack of distinctive character for all the services. The First BoA dismissed the appeal. The EUTM applicant filed an application before the GC for the annulment of the decision of the BoA. The services covered by the mark applied for are retail services in connection with mattresses, beds, cushions, pillows and further bed articles. The GC found that the services target the general public, which perceives the combination of the German words as grammatically correct (para. 24). It has not been contested by the applicant that the slogan will be perceived in the sense of ‘quite well-rested’ as regards the services at issue. The GC endorsed the finding of the BoA that the services consist in a selection of a range of goods that will ensure comfortable and restful sleep (para. 26 to 28). Therefore, the BoA was correct in finding that the slogan designates the purpose of the services, which refer to the sale of goods related to sleep and rest (para. 29). A further meaning of the expression in the sense of ‘particularly clever, intelligent’ does not render the sign distinctive as a sign must be refused registration if at least one of its possible meanings designates a characteristic of the goods and services concerned (para. 31). Since it is sufficient for the mark to be refused registration if one of the absolute grounds is applicable, the GC did not adjudicate on the plea pursuant to Article 7(1)(b) EUTMR (paras 33 to 35).

[T-128/16](#); **SUREID**; Order of 28 November 2016; *SureID Inc. v EUIPO*; Language of the case: EN. The applicant sought to register the word mark **SUREID** as an EUTM for services in Classes 35 and 45. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR, as it was found to be descriptive and therefore also devoid of distinctiveness. The applicant filed a notice of appeal against the examiner’s decision



pursuant to Articles 58 to 64 EUTMR. The BoA dismissed the appeal and confirmed the examiner’s decision. The applicant filed an action before the GC relying on a single plea in law, alleging infringement of Article 7(1)(c) EUTMR. The GC dismissed the action. The GC noted that the descriptiveness of a sign may be assessed only, first, by a reference to the way in which it is understood by the relevant public and, second, by reference to the goods or services concerned (para. 20). As to the relevant public, since the mark applied for is made up of English words, the descriptiveness of the mark has to be evaluated with reference to English-speaking consumers in the EU. The GC confirmed that the BoA was also correct in finding that the services were addressed to a public of professionals (para. 22). Furthermore, the GC noted that the sign is one word that is common in the English language, namely the word ‘sure’, and the abbreviation ‘id’. Therefore the sign is not unusual in its structure but complies with the rules of syntax and grammar in English (para. 24). Indeed, it is common in English to create words by coupling together two words, each of which with a meaning. Consequently, the relevant public will understand that the mark is composed of two words known to it and it will not perceive the mark as a neologism that is devoid of any meaning, notwithstanding that the combination of the vowels ‘e’ and ‘i’ is unusual in English (para. 26). Additionally, as to the nature of the relationship between the sign and the services for which its registration was sought, the GC pointed out that the mark can serve to describe the nature and purpose of all services for which registration has been sought, as well as the quality (paras 31 to 32). For all the above, the GC concluded that the mark applied for is descriptive of the services for which its registration was sought (para. 34).

♦ [T-290/15](#); **SMARTER TRAVEL**; Judgment of 9 November 2016; *Smarter Travel Media LLC v EUIPO*; Language of the case: EN.



An application for registration of the figurative mark represented above as an EUTM was filed for a range of services in Classes 35, 38, 39 and 42. The examiner rejected the application on the ground that the mark applied for was descriptive and devoid of any distinctive character within the meaning of Article 7(1)(b) and (c) and Article 7(2) EUTMR. The Second BoA dismissed the appeal filed against the examiner’s decision and confirmed that the mark applied for fell into the prohibitions of Article 7(1)(b) and (c) and Article 7(2) EUTMR. The GC grouped all of the arguments presented by the applicant into three pleas in law, alleging (i) an infringement of Article 7(1)(c) EUTMR, (ii) an infringement of Article 7(1)(b) EUTMR, (iii) an infringement of the principles of equal treatment and sound administration. As regards the first plea, based on an infringement of Article 7(1)(c) EUTMR, the GC confirmed that the services concerned target the English-speaking part of the general public, which is reasonably well-informed and reasonably observant and circumspect (paras 27 and 28). The GC endorsed the findings of the contested decision as to the meaning of each of the words comprising the mark applied for. The word ‘SMARTER’ is the comparative of the adjective ‘smart’, which means, inter alia, ‘clever’, ‘astute’, ‘intelligent’, ‘knowledgeable’, ‘capable’, and ‘knowing’ or ‘shrewd’. As regards the term ‘TRAVEL’, that word refers to ‘journey’, ‘to move’, ‘to go’. Therefore, in compliance with English syntax rules, the relevant public would immediately and without further thought understand the expression ‘SMARTER TRAVEL’ as



the combination of an adjective and a noun, which taken together means a ‘more intelligent, more astute, more capable, more knowing or shrewder way to journey, go or move’, as found by the contested decision. In the context of the services at issue, namely travel services, relating to travel or facilitating it, the public concerned will immediately understand the expression ‘SMARTER TRAVEL’ to be a reference to one of their possible characteristics, or even their subject matter (paras 31 and 32). The GC also considered that the applicant’s argument that the mark applied for was not descriptive in relation to telecommunication services within Class 38 and IT services within Class 42 (because those services are not within the travel field) was submitted at the hearing for the first time. Therefore, it was new and inadmissible pursuant to Article 84(1) of the Rules of Procedure (paras 33 and 35). The GC endorsed the finding of the contested decision that the figurative elements are incapable of diminishing the descriptive message given by the mark applied for. In particular, the depiction of a stylised suitcase can, at most, merely underline and reinforce the idea of travel conveyed by the expression at issue (paras 36 to 39). The GC therefore found that the Board did not err in concluding, that the mark applied for, presented a sufficiently close link with the services designated by the mark applied for, namely travel services, services related to or facilitating travel, for that mark to fall within the scope of the prohibition laid down in Article 7(1)(c) EUTMR.

[T-154/16](#); **APlan**; Judgment of 14 December 2016; *Grid applications GmbH v EUIPO*; Language of the case: DE. The applicant sought to register the word mark **APlan** as an EUTM for goods and services in Classes 9, 35 and 42. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b) and (c) and Article 7(2) EUTMR, as it was found to be descriptive and devoid of distinctive character. The BoA dismissed the applicant’s appeal. The applicant filed an action before the GC. The GC dismissed the appeal. It found the action to be admissible. The applicant does implicitly claim an infringement of Article 7(1)(c) of the EUTMR. According to the GC, the BoA was right in concluding that the relevant public consists of English-speaking professionals with an increased level of attention. The relevant public will divide the sign and immediately understand it to mean ‘a plan’. Furthermore, there exist a sufficient link between the goods and services. Thus, the BoA was right to conclude that the sign is descriptive. As far as the applicant refers to previous decisions of the Office and similar trade mark registrations in Austria and the UK, the GC found that the Office is neither bound by its previous decisions nor by decisions of other trade mark offices. Due to the descriptive nature of the application it furthermore lacks distinctive character.

[T-330/15](#); **BasenCitrato**; Judgment of 15 December 2016; *Rudolf Keil v EUIPO*; Language of the case: DE. The BoA confirmed the CD’s finding that the term ‘BasenCitrato’ will be understood by the German-speaking public as designating citrates having an alkaline effect. It thus describes the goods in question, namely *pharmaceutical and veterinary preparations; foodstuffs and dietetic substances adapted for medical or veterinary use, food supplements for human beings and animals* in Class 5 and *dietetic food not for medical use* in Class 29, as to their composition and purpose. The EUTMR was thus declared invalid under Article 7(1)(b) and 7(1)(c) in conjunction with Article 52(1)(a) EUTMR. The GC confirmed the BoA’s findings holding that the relevant public will be able to perceive the sign as being composed of the terms ‘Basen’ and ‘Citrato’, as facilitated by the capital letter ‘C’ within the composition (paras 26 to 28). The GC refuted various arguments raised by the applicant concerning the alleged novelty of the composition and its claimed vague meaning (paras 32 to 41). The GC also held that consumers are often advised by professionals and hence put into a position to grasp the sign’s meaning in case they do not understand it (para. 42). On



account of its descriptive meaning, the sign also lacks the required distinctiveness under Article 7(1)(b) EUTMR (paras 49 to 50).

4. **Not descriptive (Article 7(1)(c) EUTMR)**

◆ [T-749/14](#); **AROMA**; Judgment of 12 May 2016; *Peter Chung-Yuan Chang v EUIPO*; Language of the case: EN. The EUTM proprietor was granted the registration of the word mark **AROMA** as an EUTM for, inter alia, goods in Classes 7 and 11. An application for invalidity was filed pursuant to Article 52(1)(a) in conjunction with Article 7(1)(b) and (c) EUTMR. The CD dismissed the application for invalidity. The BoA upheld the invalidity applicant's appeal. The EUTM proprietor filed an action before the GC relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR; (ii) infringement of Article 7(1)(b). The GC upheld the appeal. **On the descriptiveness of the mark:** the term 'aroma' can have several meanings. It is, inter alia in English, Italian and German, in precisely the same way as the term 'arôme' in French, a synonym for 'scent', 'perfume', 'bouquet' and 'fragrance' and is commonly used in cooking to mean a 'distinctive, usually pleasant smell, especially of spices, wines and plants'. It may therefore be synonymous with 'smell', even if 'aroma' appears to be more specific and subtle since it has a positive connotation. Thus, the average consumer will attribute a more laudatory character to term 'aroma'. Furthermore, at least in German, the term 'aroma' may also be treated as similar to the notions of 'flavour' or 'taste' (paras 30 to 32). The contested sign is not descriptive of any characteristics of the contested goods. That is because, first, the contested goods consist, for the main part, of electrical cooking utensils. Those goods do not give off any particular aroma. Secondly, the aroma of a foodstuff depends, most importantly, on the foodstuff used and the way in which it is prepared or cooked. Every foodstuff already has its own natural smell, which may be accentuated or brought out, suppressed, or even hidden, in the course of its preparation, to such an extent that an aroma that may be given off by a foodstuff after having been cooked or prepared with the help of an electrical cooking appliance does not allow for a direct reference to those goods to be created without further thought. The function or intended use of the contested goods is not to obtain beverages or foodstuffs with aroma, since that is rather a desirable characteristic of other goods, that is, the food prepared or cooked with the help of the contested goods. Hence, by contrast to the GC's findings in Case T-188/14, *GentleCare*, the contested sign does not even allude to an ancillary characteristic of the contested goods. The sign in question is therefore not caught by the prohibition laid down in Article 7(1)(c) EUTM (paras 39 to 48).

◆ [T-167/15](#); **NEUSCHWANSTEIN**; Judgment of 5 July 2016; *Bundesverband Souvenir — Geschenke — Ehrenpreise e.V. v EUIPO*; Language of the case: DE. The applicant for invalidity (applicant before the GC) requested the invalidity of the EUTM **NEUSCHWANSTEIN** for goods and services in Classes 3, 8, 14, 15, 16, 18, 21, 25, 28, 30, 32, 33, 34, 35, 36, 38 and 44 for lack of distinctive character and descriptiveness according to Article 52(1)(a) EUTMR in conjunction with Article 7(1)(b) and (c) EUTMR and for bad faith according to Article 52(1)(b) EUTMR. Both the CD as well as the BoA dismissed the action. The applicant filed an application before the GC based on three pleas in law: (i) infringement of Article 7(1)(b) EUTMR, (ii) infringement of Article 7(1)(c) EUTMR and (iii) infringement of Article 52(1)(b) EUTMR. The GC confirms the BoA as to the attention of the general public, which will be average except for the goods in Class 14 and the services in Class 36, where the attention will be above average (para. 22). As regards the second plea, the GC states that 'Neuschwanstein' is an invented name of a famous castle in Bavaria. However, it is not



an indication of the geographical origin of souvenir articles. The castle is a museum, which does not have as principle function the production or marketing of souvenirs. The castle is not known for the production or selling of souvenir goods. Consequently it does not indicate the geographical origin of the goods and services at issue (para. 27). The applicant did not show that the term is known for specific souvenir goods or services. The souvenirs are just an additional income for the castle administration (para. 29). Moreover, the applicant's statement that the name 'Neuschwanstein' would convey a positive message to the consumers, bringing in mind the castle, has been rebutted. The fact that the goods become souvenirs by affixing the mark is not as such a characteristic of those goods. The BoA correctly found that the mark is not descriptive (paras 30 and 31).

♦[T-453/15](#); **VOGUE**; Judgment of 18 September 2016; *Trinity Haircare AG v EUIPO*; Language of the case: EN.



The EUTM proprietor was granted the registration of the figurative mark represented above as an EUTM for goods in Class 3. The Office refused to invalidate the registration of the EUTM pursuant to Article 52(1)(a) EUTMR in conjunction with Article 7(1)(b) or (c) EUTMR, as it was found distinctive, non-descriptive or laudatory for the goods. It also found that no act of bad faith within the meaning of Article 52(1)(b) EUTMR had been proved. The invalidity applicant appealed reiterating his arguments that the term 'vogue' was used as a synonym for 'fashion' or as a shortened form of the expression 'en vogue' and thus was descriptive of the goods. The BoA dismissed the invalidity applicant's appeal. The BoA confirmed that, as in French, 'vogue' in English had the meaning 'popularity, use or general acceptance; popularity with the audience' according to well-known dictionaries. It also asserted that there were expressions such as 'en vogue' (in French) or 'in vogue' (in English), which mean 'fashionable, tendency'. However, the BoA stated that the applicant had not demonstrated that the word 'vogue' was used as a synonym for those expressions (contested decision, paragraph 16). Likewise, it held that nothing indicated that the word 'vogue' was descriptive of the goods at issue. The invalidity applicant filed an action before the GC relying on three pleas in law: i) infringement of Article 7(1)(c) EUTMR; ii) infringement of Article 7(1)(b) EUTMR; and iii) infringement of Article 52(1)(b) EUTMR. The GC dismissed the appeal. The GC found that there is nothing in the definition of the word 'vogue' to indicate that that word has a sufficiently direct concrete link to the goods in question to enable the public concerned immediately, and without further thought, to perceive a description of an essential characteristic of the goods in question or of one of their characteristics. For 'beauty products and baby care' products, it is hard to see how the word 'vogue' is descriptive of those products whose characteristic function is care or beauty care, which does not fall within the area of fashion. In that regard, the Office, supported by Vogue's owner, is entitled to state that beauty and care products are not fashion products, given that consumers buy them for their 'result', that is to say, the fact that the product moisturises well, deodorises well or produces a pleasant scent. In that connection, the Office rightly notes that the notion of fashion is connected with the permanent change linked to every season and every year. That is not the case with the goods at issue, for which change is rarely linked to the change of season or year but rather to innovation, that is to say, the appearance of a new product in a position to satisfy the consumers' unmet needs. Therefore, fashion is not concerned with



care and beauty products. Regarding the list of the results of internet searches submitted as proof by the applicant during the administrative procedure, that list does not prove that the word ‘vogue’ is descriptive of the goods at issue. The results of the searches submitted demonstrate, rather, that there is a reference to the commercial origin of certain services, such as those provided in a beauty salon, or to the intervener’s magazine. The fact that the invalidity applicant’s search displays around 850 million results does not prove by itself that ‘vogue’ is descriptive of the goods at issue. Besides, the applicant does not propose any analysis in support of this. Likewise, as regards the decisions by which the competent German and Swiss authorities refused to register trade marks similar to the contested mark on the grounds that those marks were descriptive, that argument should be dismissed as ineffective, inasmuch as the EUTM system is an independent system.

C. Article 7(1)(e) and Article 52(1)(a) EUTMR — shape

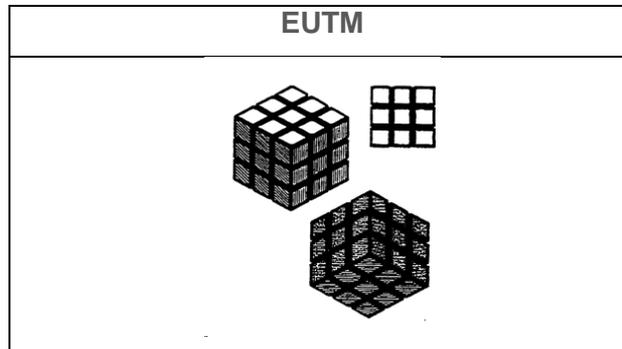
[T-656/14](#); **SHAPE OF A FORMWORK COUPLER**; Judgment of 28 June 2016; *Peri GmbH v EUIPO*; Language of the case: DE.



The Office refused an application for a three-dimensional mark in the shape of a formwork coupler for *formwork systems* in Classes 6 and 19 deciding that the mark applied for (EUTM application) consisted exclusively of the shape of the product required to obtain a technical result. Despite the limitation of the list of goods to ‘*formworks*’ in the appeal proceedings, the BoA confirmed the refusal. The applicant filed an action before the GC claiming the infringement of Article 7(1)(b) and Article 7(1)(e)(ii) EUTMR. The GC confirmed the refusal pursuant to Article 7(1)(e)(ii) EUTMR. The EUTM application consists exclusively of a shape of a formwork coupler. A formwork coupler in the shape as applied for is necessary to obtain technical results of the goods for which protection was sought (formworks) in order to connect them to a formwork system, in a way that was illustrated by a US patent description mentioned in the decision of the Board (para. 22). The GC rejected the applicant’s argument that the mark applied for does not consist of the shape of the goods after the limitation. It is not decisive whether the mark applied for (here: the formwork coupler) corresponds to the goods for which protection is sought or forms their part. What is decisive is the fact that the mark is a shape, which is necessary to obtain a technical result of the goods in question (paras 26 and 27). The GC referred to the established case-law according to which the existence of other shapes, which could achieve the same technical result, is not for the purposes of the application of Article 7(1)(e)(ii) EUTMR such as to exclude the ground for refusal of registration (para. 32 and the case-law quoted therein). Given that the EUTM application was to be refused on ground of Article 7(1)(e)(ii) EUTMR, the GC did not decide on the alleged infringement of Article 7(1)(b) EUTMR.



♦ [C-30/15 P](#); **SHAPE OF A CUBE**; Judgment of 10 November 2016; *Simba Toys GmbH & Co. KG v EUIPO*; Language of the case: EN.



The 3D mark represented above was registered for *three-dimensional puzzles* in Class 28. A cancellation action was based, inter alia, on Article 7(1)(e)(ii) EUTMR. The CD dismissed the application for invalidity. The BoA dismissed the invalidity applicant's appeal, which was confirmed by the GC (T-450/09). The GC found that the essential characteristics of the shape were the cube and the grid structure (para. 45, T-450/09). The GC dismissed the action as it found that the grid structure was not necessary to obtain a technical result. As a result, one of the essential characteristics of the contested mark was not caught by Article 7(1)(e)(ii) EUTMR, which sufficed to rule out this ground for cancellation (para. 61, T-450/09). **First**, GC considered irrelevant the fact that the grid structure might be the consequence of a rotating capability, because functional characteristics are those that perform a function rather than those that are the result of that function (para. 53 to 54, T-450/09). **Second**, GC found that the rotatable capability could not be inferred from the representation itself. Such characteristic 'is essentially based on knowledge of the rotating capability of the vertical and horizontal lattices of the Rubik's Cube' and must for that reason be ignored (para. 56 to 59, T-450/09). The CJ annuls the GC judgment on the second pillar on its reasoning. It considers that GC should have based its examination of the functionality of the grid structure in the light of the rotatable capability, which is illustrated by the **actual product**: 'Thus, and since it is not disputed that the sign at issue consists of the shape of actual goods and not of an abstract shape, the General Court should have defined the technical function of the actual goods at issue, namely a three-dimensional puzzle, and it should have taken this into account when assessing the functionality of the essential characteristics of that sign' (para. 47). Drawing an analogy with its previous judgment in C-337/12 P to C-340/12 P (shape of a knife handle), the CJ goes on to say that the identification of the essential characteristics must be made on the basis of the graphic representation and 'additional information on the actual goods' (para. 49 to 50). The GC should have examined the functionality of the grid structure in the light of the rotating capability of individual elements in a three-dimensional 'Rubik's Cube-type puzzle' (para. 51). The CJ also criticises the GC for having found that this rotatable capability could not be inferred from the general category of three-dimensional puzzles. It is enough that some puzzles have such characteristic (para. 52). The CJ makes use of Article 61 of its Statute and adopts a final ruling on the merits of the case. It concludes that the ground of appeal is well founded and that the BoA decision, the reasoning of which was endorsed by the GC, is vitiated by the same error as the GC judgment and must therefore be annulled on the ground of an infringement of Article 7(1)(e)(ii) EUTMR.



D. Article 7(1)(f) and Article 52(1)(a) EUTMR — public policy/morality

[no entry]

E. Article 7(1)(g) and Article 52(1)(a) EUTMR — deceptive

♦[T-29/16](#); **CAFFÈ NERO**; Judgment of 27 October 2016; *Caffè Nero Group Ltd v EUIPO*; Language of the case: EN. The EUTM applicant sought to register the word mark **CAFFÈ NERO** as an EUTM for goods and services in Classes 25, 30 and 35. The examiner refused the application for all the goods and services in Classes 30 and 35 on the basis of descriptiveness, lack of distinctive character and deceptiveness. The First BoA dismissed the appeal. The EUTM applicant filed an application before the GC for the annulment of the decision of the BoA raising four pleas in law: (i) infringement of Article 7(1)(c) EUTMR; (ii) infringement of Article 7(1)(b) EUTMR; (iii) infringement of Article 7(1)(g) EUTMR; and (iv) infringement of the principles of equal treatment and sound administration. Regarding the third plea in law, namely infringement of Article 7(1)(g) EUTMR, the applicant’s claim that the BoA applied the wrong test since a non-deceptive use of the mark in relation to some goods in Class 30 (such as tea, cocoa, coffee substitutes, powdered chocolate) was possible under the perception a coffee house with the name ‘NERO’, was rejected by the GC. Once the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived has been established, it becomes irrelevant that the mark applied for might also be perceived in a way that is not misleading. The mark is, on any view, of such a nature as to deceive the public and is therefore unable to fulfil its role, which is to guarantee the origin of the goods and services to which it refers (paras 43 to 49).

♦[T-37/16](#); **CAFFÈ NERO**; Judgment of 27 October 2016; *Caffè Nero Group Ltd v EUIPO*; Language of the case: EN.



The EUTM applicant sought to register the figurative mark **CAFFÈ NERO** as an EUTM for goods and services in Classes 25, 30 and 35. The examiner refused the application for all the goods and services in Classes 30 and 35 on the basis of descriptiveness, lack of distinctive character and deceptiveness. The First BoA dismissed the appeal. The EUTM applicant filed an application before the GC for the annulment of the decision of the BoA raising four pleas in law: (i) infringement of Article 7(1)(c) EUTMR; (ii) infringement of Article 7(1)(b) EUTMR; (iii) infringement of Article 7(1)(g) EUTMR; and (iv) infringement of the principles of equal treatment and sound administration. Regarding the third plea in law, namely infringement of Article 7(1)(g) EUTMR, the applicant’s claim that the BoA applied the wrong test, since a non-deceptive use of the mark in relation to some goods in Class 30 (such as tea, cocoa, coffee substitutes, powdered chocolate) was possible under the perception ‘a coffee house with the name ‘NERO’, was rejected by the GC. Once the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived has been established, it becomes irrelevant that the mark applied for might also be perceived in a



way that is not misleading. The mark is, on any view, of such a nature as to deceive the public and is therefore unable to fulfil its role, which is to guarantee the origin of the goods and services to which it refers (paras 48 to 54).

F. Article 7(1)(h) and (i) and Article 52(1)(a) EUTMR — emblems, etc.

[no entry]

G. Article 7(1)(j) and (k) and Article 52(1)(a) EUTMR — geographical indication for wines and spirits — agricultural products and foodstuffs

H. Article 7(3) and Article 52(2) EUTMR — distinctiveness acquired through use

[T-761/14](#); **MANGO**; Judgment of 23 February 2016; *Consolidated Artists BV v OHIM*; Language of the case: FR.

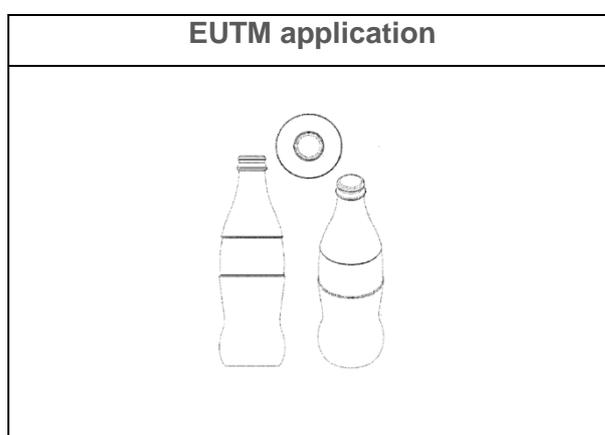
EUTM application
MANGO

The CD rejected a declaration of invalidity based on Article 52(1)(a) EUTMR in conjunction with Article 7(1)(b) and (c) EUTMR against the registration of the figurative mark **MANGO** for *soaps, perfumery, essential oils, cosmetics* in Class 3. The Second BoA (12/03/2012, R 471/2011-2) annulled the decision and remitted the case to the CD to examine the claim of acquired distinctiveness under Article 7(3) EUTMR. The CD found that acquired distinctiveness (territory: EU-15 except France, Greece and Portugal) was not proven and declared the EUTM invalid for the contested goods. The Fourth BoA dismissed the EUTM proprietor’s appeal. The BoA found that there was insufficient proof of acquired distinctiveness, at the time of filing and after registration, as regards the goods in Class 3 for which **MANGO** is descriptive. The EUTM proprietor filed an action before the GC. The EUTM proprietor argued before the GC that the evidence filed was sufficient. The EUTM proprietor, relying on T-405/05 ‘Manpower’, also argued that there was a ‘transfer of distinctiveness’ of the mark reputed for clothing to perfumery. The GC recalls that the evidence of acquired distinctiveness through use had to be submitted for the goods specified in Class 3. Since the rejected goods in Class 3 and those in Class 25 are not similar and not complementary, the EUTM proprietor could not allege that the acquired distinctiveness through use for those goods could have had an impact on the perception of the mark by the relevant public for the relevant goods belonging to Class 3 (paras 26 and 31). The pieces of evidence [extracts from catalogues and one article] do not present sufficient concrete and objective indications in order to determine the relevant public’s perception (para. 27). They refer to two Member States (Germany and the Netherlands) only and therefore do not cover a substantial part of the EU (para. 33). The judgment T-405/05 ‘Manpower’ is not applicable to the present case. The acquired distinctiveness through use of the mark MANPOWER for temporary personnel services, for which it was found descriptive, was extended to some goods and services in



Classes 9, 16, 41 and 42 as they were used in the performance of the temporary personnel services (paras 34 to 35). Allowing the extension of the well-known character of the mark **MANGO** for the goods in Class 25 to those in Class 3 would overcome the dispositions of Article 7(3) EUTMR. There is no reason to extend the well-known character from one class to another (para. 36). **Article 52(2) EUTMR**: the GC confirms that the evidence allows to admit the existence on the market of the products in Germany, Spain and the United Kingdom, as well as a promotional investment, but in view of the lack of precise information and concrete indications, they do not allow to determine that the mark acquired distinctiveness through use after registration, for the goods for which it is registered (para. 46).

♦[T-411/14](#); **SHAPE OF A BOTTLE (3D MARK)**; Judgment of 24 February 2016; *Coca-Cola Company v OHIM*; Language of the case: EN.

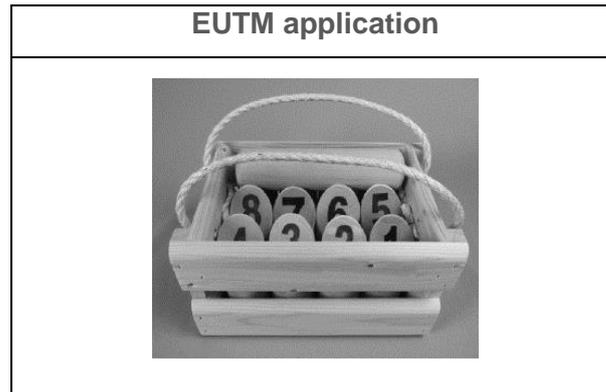


The applicant sought to register the three-dimensional sign reproduced above as an EUTM for goods and services in Class 6, 21 and 32. The examiner refused the registration for some of the goods for which protection was sought on the basis of Article 7(1)(b) EUTMR and informed the applicant. The applicant decided to maintain its application for all the goods concerned, claiming that the sign had acquired a distinctive character under Article 7(3) EUTM and having obtained extensions on the deadline for gathering and lodging all documents in support of its claims, the applicant submitted its arguments against the initial position adopted by the examiner. The examiner dismissed the application for registration and also dismissed the application under Article 7(3) EUTMR. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. **On the infringement of Article 7(3) EUTMR**: it is not clear from the advertising material provided whether the bottle that is shown in them is a representation of the contour bottle with fluting or a representation of the mark applied for. The same is true as regards the items of evidence showing contour bottles without fluting. The mark applied for is not used in combination with the mark it is alleged to be part of but absorbs that mark, or inversely, is itself absorbed by it to the extent that the silhouettes of the mark applied for and the mark it is alleged to be part of overlap (para. 76). The surveys provided are not sufficient, in themselves, to prove to the requisite standard that the mark applied for has acquired distinctive character through use, throughout the EU, for a significant part of the relevant public (para. 81). As regards the investments, which have been made in advertising and communication, the figures provided do not specifically relate to the mark applied for. They are secondary evidence and furthermore they do not show that the public targeted by the goods in question perceives the mark applied for as an indication of commercial origin. In addition, those sales figures are marred by inconsistencies (paras 82 to 85). The rest of the evidence provided also fails to establish that the mark applied for has acquired distinctive character in the EU (para. 88). As a result, none



of the items of evidence, considered in isolation, is sufficient to establish that the mark applied for has acquired distinctive character through use. Likewise, the GC ruled that all the items as a whole also fail to establish that such is the case (paras 90 to 91).

♦[T-363/15](#); **SHAPE OF TOY CRATE CONTAINING WOOD BLOCKS (3D MARK)**; Judgment of 16 March 2016; *Työhönvalmennus Valma Oy v OHIM*; Language of the case: FI.



The applicant sought to register a 3D mark reproduced above for goods in Class 28: *games*. It further claimed acquired distinctiveness through use. The Office’s decision, rejecting the application pursuant to Article 7(1)(b) and Article 7(3) EUTMR, was upheld by the BoA. The applicant appealed to the GC and put forward two pleas in law. In line with the unitary character of an EUTM, it would be paradoxical to admit, first, that a Member State is required to refuse registration as a national mark of a sign that is not distinctive in its territory and, secondly, that that State is required to comply with an EUTM of the same sign for the sole reason that it has acquired a distinctive character in the territory of another Member State (para. 36). In cases of non-word marks, the assessment of the distinctive character will be the same throughout the EU unless there is concrete evidence to the contrary (para. 37). Although the trade mark for which registration is sought may have been used in conjunction with another mark, the fact remains that, for the purposes of the registration of the mark itself, the applicant must prove that that mark alone, as opposed to any other trade mark which may also be present, identifies the particular undertaking from which the goods originate (para. 51). The applicant failed to prove that the 3D mark applied for had acquired distinctiveness through use in the relevant EU territory in its own right, without an addition of the word or figurative mark MÖLLKY, which appeared in the majority of the evidence.

♦♦[T-590/14](#); **ULTIMATE FIGHTING CHAMPIONSHIP**; Judgment of 12 May 2016; *Zuffa, LLC v EUIPO*; Language of the case: EN. The applicant sought to register the word sign **ULTIMATE FIGHTING CHAMPIONSHIP** for goods in Classes 9, 16, 28 and 41. The Office rejected the application for all the goods (with the exception of *playing cards and computer game controllers* in Class 28). The BoA dismissed the appeal. The applicant filed an application before the GC for the annulment of the decision of the BoA relying on three pleas in law: (i) infringement of the obligation to state reasons; (ii) infringement of Article 7(1)(b) and (c) EUTMR; and (iii) infringement of Article 7(3) EUTMR. Concerning the third plea, the applicant claims that, in the light of the requirements laid down by the case-law, the BoA incorrectly assessed or, in certain cases, completely failed to assess the evidence it submitted in order to prove that the mark had acquired distinctive character through use. After analysing every piece of evidence (paras 79 to 99), the GC concluded that the renown



of the contested mark had been proved solely for the specialist public of mixed martial arts fans. As a consequence, the BoA erred insofar as it found that the contested mark had not acquired distinctiveness for the specific goods and services described as ‘featuring/relating to/ in the field(s) of mixed martial arts’ (paras 100 to 102). The GC pointed out, in particular, that the evidence referring to the acronym UFC was not devoid of evidential value, as that acronym frequently appeared in association with the sign **ULTIMATE FIGHTING CHAMPIONSHIP** and such a slightly different use of the mark may be regarded as equivalent by specialists (para. 85). On this ground, the GC partially annulled the BoA decision as regards some goods in Classes 9 and 14, and dismissed the action as to the remainder.

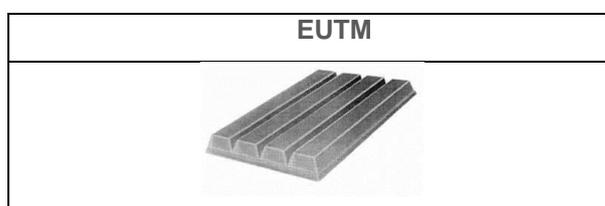
♦[T-337/15](#); **RESCUE**; Judgment of 29 September 2016; *Bach Flower Remedies Ltd v EUIPO*; Language of the case: EN. An application for invalidity was filed pursuant to Article 52(1)(a) in conjunction with Article 7(1)(b) and (c) EUTMR against word mark **RESCUE** registered for goods in Classes 3, 5, 30, 31 and 32. The CD partly upheld the application for invalidity finding the mark descriptive and non-distinctive for some of the goods. The BoA dismissed the appeal. It found that the word ‘RESCUE’ meant, inter alia, being saved and providing relief and that there was a direct link between that word and the goods. The mark is descriptive of the properties of the goods. The evidence of acquired distinctiveness was not submitted for the whole of the relevant territory. As regards acquired distinctiveness, the GC stated that the relevant public consists of English-speaking consumers, which are those of Member States in which English is an official language, namely Ireland, the Republic of Malta and the United Kingdom of Great Britain and Northern Ireland, as well as Member States in which the knowledge of English is regarded as a well-known fact, namely the Kingdom of Denmark, the Republic of Cyprus, the Kingdom of the Netherlands, the Republic of Finland and the Kingdom of Sweden. The EUTM proprietor did not even contest the BoA’s assertion that no proof of distinctive character acquired through use has been produced for Denmark, Cyprus, Malta, Finland or Sweden. Therefore, this claim was dismissed.

♦[T-56/15](#); **BRAUWELT**; Judgment of 18 October 2016; *Raimund Schmitt Verpachtungsgesellschaft mbH & Co.KG v EUIPO*; Language of the case: DE. The applicant sought to register the word mark **BRAUWELT** for goods and services in Classes 9, 16, 32, 35, 38, 41, 42 and 43. Both instances of the Office refused the registration of the mark due to lack of distinctive character and descriptiveness in the sense of Article 7(1)(b) and (c) EUTMR. The applicant filed an appeal before the GC claiming an infringement of Article 7(1)(b) and (c), Article 7(3) and Article 75 EUTMR. The applicant’s claim to alter the contested decision to the effect of registering the mark applied for was dismissed by the GC as inadmissible. Since the BoA does not have this power, the GC does not have it either (paras 9 to 14). The GC further declared the documents produced for the first time before it as inadmissible. The purpose of actions brought before the GC is to review the legality of decisions of the BoAs of the Office within the meaning of Article 65 EUTMR. It is not therefore the GC’s function to review the facts in the light of documents produced for the first time before it (paras 15 and 16). **Infringement of Article 7(3) EUTMR**: the GC confirms the claim that a sign applied for has acquired distinctive character through use according to Article 7(3) EUTMR may be put forward for the first time before the BoA. The BoA has the power to examine such claim for the first time in view of its capacity to carry out a new and full examination of the merits of the application in terms of both law and fact. However, any loss of an instance is attributable to the late submission of the claim by the applicant and may therefore not oblige the BoA to refer the case back to the first instance (paras 116 to



121). The GC clarifies that the limitation of the goods *magazines* (Class 16) to *specialised magazines in the field of brewing* (Class 16) made before the GC and after the contested decision has an influence on the definition of the target public and may have an impact on the decision. This would lead to an alteration of the subject matter of the case as it has been before the BoA and following the constant case-law must not be taken into account by the GC (paras 112 to 115). Consequently, the acquired distinctiveness had to be proven for the general categories as included in the application, in particular ‘magazines’ (Class 16). The evidence produced by the applicant mainly refers to specialised public and not to the target consumers of magazines, which are the general public. Consequently, the BoA correctly refused the claim of acquired distinctiveness through use (paras 133 to 148).

♦**T-112/13; SHAPE OF A FOUR-FINGER CHOCOLATE BAR (3D MARK)**; Judgment of 15 December 2016; *Mondelez UK Holdings & Services Ltd v EUIPO*; Language of the case: EN.



The applicant sought to register the three-dimensional mark represented above as an EUTM for goods in Class 30. The Cancellation action was upheld by the CD on the basis of Article 7(1)(b) EUTMR and the claim regarding the acquisition of distinctive character under Article 52(2) EUTMR in combination with Article 7(3) EUTMR was dismissed. The BoA upheld the appeal and found that the absolute grounds for refusal under Article 7(1)(b) to (d) EUTMR were overcome by the submission of evidence showing that the contested EUTM registration had acquired distinctive character in the EU (15 Member States (MS)), at the latest on 23 March 2007 (date of lodgement of the request for cancellation). The BoA had found that the surveys carried out in ten MS, showing spontaneous recognition by the public in proportions varying from 30 % (Finland) to 88 % (UK), established the acquisition of distinctive character not only in the MS concerned (which represented over 80 % of the overall EU population) but also in the EU as a whole. This was corroborated by additional proof that the shape had been used extensively in four other MS, without the BoA expressly taking position on the acquisition of distinctive character in those four MS. **Partial use:** Drawing an analogy with the case-law relating to partial use in the context of Article 15 EUTMR, the GC found that use of the Kit Kat product was deemed to be used for both categories of *sweets* and *biscuits*, but not of other autonomous sub-categories of confectionery, such as *bakery products*, *pastries*, *cakes* and *waffles* (paras 27 to 43). **Use in combination with other signs.** The CJ held in 2015 that ‘for the purposes of the registration of the mark itself, the trade mark applicant must prove that that mark alone, *as opposed to any other trade mark*, which may also be present, identifies the particular undertaking from which the goods originate’ (*Société des Produits Nestlé SA v Cadbury UK Ltd* (Shape of a chocolate bar), judgment of 16/09/2015, C-215/14, Kit Kat four finger chocolate-coated wafer, EU:C:2015:604, § 66). According to the GC, the phrase ‘as opposed to any other trade mark’ should be construed as meaning ‘independently of any other trade mark’. **Proof of market recognition concerned the ‘naked’ shape of the Kit Kat product.** A spontaneous association in the public’s mind with the name of the famous product was therefore no obstacle to the shape alone performing its function of guaranteeing origin (paras 59 to 63 and 99 to 103). **Territorial extent of the proof of acquisition of distinctive**



character: according to the GC, ‘although, as was held by the Court of Justice in the judgment of 24 May 2012, *Chocoladefabriken Lindt & Sprüngli v OHIM* (C-98/11 P, EU:C:2012:307, paragraph 62), there cannot be a requirement that proof of distinctive character acquired through use of that mark be adduced for each individual Member State concerned, such proof may be adduced globally for all the Member States concerned or separately for different Member States or groups of Member States’. The GC goes on to explain that, where ‘the evidence submitted does not cover part of the European Union, even a part that is not substantial or consists of only one Member State, it cannot be concluded that distinctive character has been acquired through use of the mark throughout the European Union’ (para. 139). The GC noted that the BoA’s conclusion regarding the acquisition of distinctive character in the ten Member States concerned by the surveys was correct. However, in the absence of any concrete conclusion on the acquisition of distinctive character in the remaining MS, the BoA erred in law: ‘the relevant question is not whether it was shown that a substantial proportion of the public in the European Union, merging all the MS and regions, perceived a mark as an indication of the commercial origin of the goods designated by that mark, but whether, throughout the European Union, it was proved that a significant proportion of the relevant public perceived a mark as an indication of the commercial origin of the goods designated by that mark. A lack of recognition of the sign as an indication of commercial origin in one part of the territory of the European Union cannot be offset by a higher level of awareness in another part of the European Union’ (paras 141 to 143). The GC thus annulled the BoA’s decision to the extent that it had failed to take expressly position on the acquisition of distinctive character in the four MS for which no surveys were submitted, but only information concerning the market shares, promotional investments and the length of use (paras 173 to 177).



III. Relative Grounds for Refusal/Invalidity

A. Article 8(1)(a) and Article 53(1)(a) EUTMR — identical signs/G&S

[no entry]

B. Article 8(1)(b) and Article 53(1)(a) EUTMR — likelihood of confusion

1. Likelihood of confusion (LOC)

[T-535/14](#); **VITA+VERDE / VITAVIT**; Judgment of 14 January 2016; *The Cookware Company Ltd v OHIM*; Language of the case: EN.

EUTM application	Earlier mark
	

The applicant sought to register the figurative sign represented above for goods in Class 21. An opposition was filed on the basis of the earlier word mark **VITAVIT**, registered for goods in Class 21. The OD rejected the opposition in its entirety. The BoA upheld the opponent’s appeal and annulled the decision of the OD. The applicant filed an action before the GC. The GC held that the goods covered by the marks at issue are intended both for the general public and for the specialist public. However, the level of attention to be applied is that of the average consumer (paras 26 to 28). The goods concerned covered by the mark applied for are identical to the opponent’s goods (paras 32 and 33). There is a certain degree of visual similarity between the signs at issue. The signs include no elements that could be considered to be clearly more dominant than the others. The word ‘vita’ is a distinctive feature of the marks at issue in view of the absence of any direct relationship between the word in question and the goods covered by the marks at issue. The signs are visually similar insofar as they begin with the identical sequence of letters, namely ‘v’, ‘i’, ‘t’ and ‘a’, followed by the letter ‘v’ placed in the same position, although they differ in their structures, inter alia, on account of their different endings, and notwithstanding the presence, in the mark applied for alone, of a light green ‘+’ sign (paras 36 to 44). The signs are phonetically similar as the pronunciation of the signs coincides in the sounds of the initial sequence of letters ‘v’, ‘i’, ‘t’, ‘a’ and ‘v’. Furthermore, the relevant public will not pause between the two elements of the mark applied for but will tend to pronounce both marks according to the same rhythm, in particular on account of the presence of the consonant ‘v’ after the vowel ‘a’ (paras 45 to 48). The GC further ruled that the BoA was right to draw a distinction between the different public in the view of the conceptual comparison of the signs at issue. For a certain part of the relevant public, the marks at issue would be perceived as meaningless and that, consequently, no conceptual comparison could be carried out between them. The part of the relevant public that understood the element ‘vita’ as a reference to the concept of ‘life’ and/or ‘vitality’ (Italian, Spanish, French, German, Portuguese and Romanian) would perceive the conceptual similarities of the beginnings of the two marks at issue. That part of the relevant public would be also able to perceive the differences between the signs due to the elements



‘+’ and ‘verde’, which are only present in the mark applied for. Consequently there is conceptual similarity for a significant part of the relevant public (paras 49 to 56). In the light of the abovementioned and on account of the decisive influence, in the overall impression created by the signs, of their identical beginnings, ‘vita’, the public could possibly believe that the goods at issue come from the same undertaking or from economically-linked undertakings (para 60). Therefore, there is a likelihood of confusion (paras 57 to 67). Since it had concluded that there was a likelihood of confusion between the marks at issue, there was no need to examine the applicant’s arguments that it owns a family of marks including the term ‘vita’ (para. 68). **LOC**

♦[T-846/14](#); **SPOKEY / SPOOKY**; Judgment of 21 January 2016; *Spokey sp. z o.o. v OHIM*; Language of the case: PL

EUTM	Earlier mark
	<p data-bbox="1023 864 1145 891">SPOOKY</p>

The EUTM proprietor was granted the registration of the figurative mark represented above. An application for invalidity was filed based on the earlier trade mark word mark **SPOOKY**. The CD partly upheld the application for invalidity and declared the contested EUTM partially invalid by finding that there was a likelihood of confusion as regards the goods in Class 18. The BoA confirmed this decision. The applicant filed an action before the GC. It claimed infringement of Articles 75 and 76 and Article 8(1)(b) EUTMR. As regards the applicant’s claim that the reasoning of the contested decision is contradictory in that BoA considered that the relevant territory is the European Union and then focused on the English-speaking public, the GC referred to the unitary character of the EUTM and recalled that the mark has to be invalidated even if there is a likelihood of confusion in one part of the European Union only (para. 19). **LOC**

♦[T-75/15](#); **ROD / RODI et al.**; Judgment of 21 January 2016; *Rod Leichtmetallräder GmbH v OHIM*; Language of the case: EN.

EUTM	Earlier mark
	 <p data-bbox="1273 1697 1331 1724">et al</p>

The EUTM proprietor was granted the registration of the figurative mark represented above as an EUTM for goods and services in Classes 3, 12, 35 and 37. An application for invalidity was filed pursuant to Article 53(1)(a) in conjunction with Article (5) and Article 8(1)(b) EUTMR. The CD upheld the application for invalidity for all goods and services except for those in Class 3, based on an earlier Spanish mark. The BoA dismissed the EUTM proprietor’s appeal. The EUTM proprietor filed an action before the GC based on two pleas in law. Concerning the first plea, namely the alleged infringement of Article 8(1)(b) EUTMR, the



GC confirmed the BoA finding that retail services of trading in motor vehicle rims and motor vehicle accessories, except chains in Class 35 had an average level of similarity to the accessories and spare parts of vehicles in Class 12 covered by the earlier mark (not a low degree of similarity as found by the CD). The BoA found that since the goods at issue could be sold and retailed by the producers themselves, the connection between the goods and services at issue could not be regarded as low (para. 22). A figurative detail animating the letter ‘O’ of the word ‘RODI’ will be perceived as a mere decoration and not as a dominant element of the earlier mark (para. 32). The circular shape in the contested mark is likely to evoke the shape of a tyre, which accentuates the visual resemblance (para. 34). The elements that differentiate the marks, considered as a whole, do not outweigh the common element ‘rod’ (para. 43). It is unlikely that the earlier mark will be pronounced letter by letter since the simplest and shortest possible pronunciation in Spanish is of the whole word (para. 48). In Spanish, when a word ends with a vowel, as in ‘rodi’, the stress is on the penultimate syllable, that is, in the present case, on the sequence of letters ‘ro’ (para. 50). The marks have the stress on the same syllable, namely that involving the vowel ‘O’. The earlier mark will neither be perceived as the English term ‘roadie’ nor as a Catalan term ‘roda’, meaning ‘wheels’ (paras 54 and 55). A conceptual comparison could not be made (para. 57). Due to an average degree of similarity between the marks at issue and given that the earlier Spanish trade mark had a normal distinctive character, the BoA was fully entitled to conclude that there was a likelihood of confusion (paras 63 and 66). **LOC**

[T-202/14](#); **LR nova pure. / NOVA**; Judgment of 26 January 2016; *LR Health & Beauty Systems GmbH v OHIM*; Language of the case: EN.

EUTM application	Earlier mark
	<p data-bbox="1034 1227 1118 1261">NOVA</p>

The applicant sought to register the figurative mark **LR Nova Pure.** represented above as an EUTM for goods and services within Class 3. An opposition based on the earlier word mark **NOVA**, registered for goods in Class 3, was filed on the grounds of Article 8(1)(b) EUTMR. The OD upheld the opposition basing its decision on the earlier international word mark **NOVA** whose international protection was extended to Poland. The BoA dismissed the applicant’s appeal. The applicant filed an action before the GC. The goods at issue are identical and the relevant public is the average Polish consumer (not disputed). Concerning the distinctive character of the word elements ‘nova’ and ‘pure’, as the earlier mark was already registered as an international trade mark, the word ‘nova’ had to be assumed to have at least a minimum degree of distinctiveness. However, it has a low degree of inherent distinctive character since it evokes ‘newness’ (paras 42 to 46). The word elements ‘nova’ and ‘pure’ are the most dominant elements of the EUTM application. The word element ‘LR’ is clearly ancillary, since it is highly stylised and difficult to read, having only a limited impact (para. 55). The presence of a full stop after the word ‘pure’ is not an element capable of attracting the consumer’s attention. Otherwise, the word element ‘nova’ plays an independent distinctive role in the EUTM application, which is not cancelled out by the presence of the word element ‘pure’. Therefore, the marks display a medium degree of visual similarity (paras 70 to 73). Regarding the phonetic comparison, for consumers who pronounce the word element ‘LR’, the marks have a low degree of phonetic similarity, but for



the consumers who do not pronounce the word element 'LR', the level of phonetic similarity is average, given the presence in each of the word 'nova' (para. 81). With respect to the conceptual comparison, the additional concept of 'pure' attached to the EUTM application is not able to supplant the reference to the concept of 'newness', which will not be influenced by the weak distinctive character of the earlier mark and of the word element 'nova' in the EUTM application. Thus, the marks are similar overall (paras 89 to 90). The degree of similarity between the marks, the identity of the goods covered by them and the normal level of attention of the relevant public, considered cumulatively, are sufficient for the conclusion that there is a likelihood of confusion (para. 98). **LOC**

[T-194/14](#); **AEROSTONE / STONE et al.**; Judgment of 28 January 2016; *Bristol Global Co. Ltd v OHIM*; Language of the case: EN.

EUTM application	Earlier marks
	<ol style="list-style-type: none"> 1. STONE 2. BRIDGESTONE et al

The applicant sought to register the figurative sign represented above for goods in Class 12. An opposition was filed inter alia on the basis of the earlier EU word marks **STONE** and **BRIDGESTONE** registered for goods in Class 12. The OD considered that since the EUTM application sought protection for the entire Class 12 heading and the applicant did not clarify its intentions, it will be considered that the applicant's intention is to cover all the goods and services included in the alphabetical list of Class 12. The OD upheld the opposition insofar as it was based on the earlier trade mark **STONE**. The BoA upheld the decision of the OD. The applicant filed an action before the GC. The GC rejected as unfounded the applicant's complaint that the BoA did not address all the arguments that it put forward before it (paras 28 to 45). The relevant public comprises members of the general public and specialised personnel in the European Union (para. 54). Regarding the contested goods *vehicles; apparatus for locomotion by land* and *apparatus for locomotion by air*, on the one hand, and *automobile tyres*, on the other, these are respectively similar and identical to the goods covered by the earlier trade mark **STONE** (para. 14). By contrast the contested *Apparatus for locomotion by water* are dissimilar to the goods covered by the earlier trade mark **STONE** (para. 15). Furthermore, there is similarity or an identity between the goods covered by the earlier trade mark **STONE**, and the rest of the items in the alphabetical list for Class 12 covered by the EUTM application, which did not fall within the natural and usual meaning of those general indications (para. 16). In spite of the fact that the element 'aero' is situated at the beginning of the mark applied for, the element 'stone' in that mark had to have at least equal weight (paras 59 to 69). The mere presence of the word element 'aero' in the mark applied for cannot preclude the relevant public from perceiving the similarity between the marks at issue, which results from the identity of the word element that they have in common, 'stone', which is also longer than the word element 'aero'. Consequently, the marks at issue are visually similar (paras 70 to 77). In the light of the phonetic identity between the second element of the mark applied for and the whole of the earlier mark, those marks are phonetically similar, notwithstanding the particular sound of the element 'aero' (paras 79 to 87). English-speaking consumers will perceive the mark applied for as the association of the prefix 'aero' meaning 'air' with the noun 'stone' meaning 'a solid non-metallic material'. In the light of the ambiguous nature of such an association, the element 'stone' will retain a semi-independent role for English-speaking consumers (para. 92). Therefore, there is a



conceptual similarity between the mark applied for and the earlier mark for part of the relevant public, namely the English-speaking consumers (paras 88 to 97). There is a likelihood of confusion (paras 98 to 110). **LOC**

♦ [T-687/14](#); **AFRICAN SIMBA / SIMBA et al.**; Judgment of 28 January 2016; *Novomatic AG, v OHIM*; Language of the case: DE.

EUTM application	Earlier mark
	

The EUTM applicant sought to register the figurative mark represented above for goods in Class 28. The opponent based its opposition, inter alia, on Article 8(1)(b) EUTMR using, inter alia, the earlier German figurative mark as depicted above, registered for goods in Class 28. The opposition was directed against all the goods covered by the EUTM application. The OD upheld the opposition. The BoA dismissed the applicant's appeal, finding that there was a likelihood of confusion, taking into account, the identity of the goods and the similarity between the signs. The applicant appealed to the GC, putting forward two pleas in law: (i) an alleged infringement of Article 75 EUTMR and (ii) an alleged infringement of Article 8(1)(b) EUTMR. **Infringement of Article 8(1)(b) EUTMR:** concerning the comparison of the goods in Class 28 the contested decision stated that the contested goods, namely *lottery game machines* are encompassed in the broad category of *games and plaything except plush toys* (German: *'Spielwaren, ausgenommen weichgestopfte Spieltiere'*) covered by the earlier German mark. To this extent the GC stated that the contested goods do not fall within the natural meaning of the opponent's goods. Furthermore, the use of some of the headings does not comply with the criteria of IP Translator (IPT) to consider that the earlier mark covers all the goods included in the alphabetical list. This applies even more, taking into account that the opponent's goods contain an exclusion of plush toys. Consequently, the goods in Class 28 are not identical (paras 51 to 55). The GC proceeded with its examination to see if this error has an impact on the outcome of the contested decision (para. 56). The GC concluded that the goods under comparison have the same purpose of entertaining, although the contested goods reach this aim in a different way because of the chance to win money. Secondly there is a certain 'fluid transition' between the slot machines as toys and the real slot machines, so that a clear distinction between these goods cannot be made. Also the material out of which the goods can be made is the same. Consequently the goods are similar to a certain degree (paras 57 to 67). Concerning the comparison of the signs the GC stresses that the figurative elements in both marks are not decorative and have to be taken into account. However the fantasy word SIMBA in both marks has as such certain distinctiveness. All in all the marks are visually similar to a low degree and to this extent the Board erred in saying that there would be an average degree of visual similarity (para. 79 and 104). The contested sign bears the term 'African', which is not descriptive but still evokes an African origin of the latter term 'SIMBA', which is a fantasy term and will attract the consumer's attention more than the first word element. The BoA was right in concluding that the aural similarity is above average. (paras 105 to 109). Conceptually, the term 'Simba' has in German no concept and the applicant has not shown that the relevant public will consider this term as 'lion' (meaning in Swahili) (para. 114). However, the figurative elements of the



signs that have to be taken into account both have a concept, namely a lion and an elephant. This has not been assessed in the contested decision (paras 116 to 119). The GC concluded that the target public for the case in question is the general public, which buys the earlier games and playthings and uses the contested slot machines as well as a professional public in the field of slot machines, which buys and uses playthings. The attentiveness of the general consumers will be average (para. 128 and 129). Since the word element ‘SIMBA’ is not overshadowed by any other element within the contested mark it still has an independent role therein (paras 137 and 138). The conceptual differences cannot neutralise the visual and aural similarities because there is a fantasy term, namely SIMBA, which attracts the attentiveness of the consumers and because aurally the different concepts are unnoticed (paras 139 and 140). Overall, for the general public there is a likelihood of confusion and the errors in the comparison of the goods and of the signs in the contested decision do not affect the outcome and do not lead to its annulment (para. 143). **LOC**

♦ [T-683/13](#); **EUROMARKER / EURIMARK**; Judgment of 2 February 2016; *Brammer GmbH v OHIM*; Language of the case: DE. The applicant sought to register the word mark **EUROMARKER** as an EUTM for, inter alia, services in Class 38 *providing access to database servers(...)* and Class 42 *creation and administration of databases(...)*. The opponent filed an opposition on the grounds of Article 8(1)(b) EUTMR on the basis of the earlier trade mark word mark **EURIMARK**, registered for services in Classes 35, 41, 42 (inter alia: *design and development of computer hardware and software(...)*) and 45. The OD upheld the opposition. The EUTM applicant filed an appeal against the decision. The BoA dismissed the applicant’s appeal. It held that the relevant public are professionals in the entire Union. The services in question are either remotely similar or similar. The signs are similar from a visual, phonetic and conceptual point of view. Although the earlier right is of weak distinctive character this does not exclude, in the present case, a likelihood of confusion. The applicant filed an action before the GC. The GC endorsed the findings of the BoA as regards the relevant public and territory. Furthermore, the GC confirmed the conclusions of the BoA as to a similarity between the services *creation and administration of databases(...)* of the EUTM application and *design and development of computer hardware and software(...)* of the earlier mark. The GC agreed with the BoA as regards the visual, phonetic and conceptual similarities of the signs. Finally, the GC clarified that the signs in dispute have to be considered as a whole rather than its individual elements and confirmed the conclusion of the BoA that likelihood of confusion cannot be excluded solely on the basis that the older right is of weak distinctive character. As regards Class 42 the GC therefore dismissed the appeal of the applicant. **LOC**

[T-541/14](#); **ILLIRIA / CASTILLO DE LIRIA et al.**; Judgment of 2 February 2016; *Antica Azienda Agricola Vitivinicola Dei Conti Leone De Castris Srl v OHIM*; Language of the case: EN.

EUTM application	Earlier mark
	<p style="text-align: center;">CASTILLO DE LIRIA</p>



The applicant sought to register the figurative mark represented above as an EUTM for *wines* in Class 33. An opposition based on the earlier word mark **CASTILLO DE LIRIA**, registered *inter alia* for *wine* in Class 33, was filed on the grounds of Article 8(1)(b) EUTMR. The OD dismissed the opposition. The BoA upheld the opponent’s appeal. It found that it was necessary to attach particular weight to the phonetic aspect, and considering that the elements other than **ILLIRIA** and **LIRIA** had a lower distinctive character, there was a likelihood of confusion between the signs at issue in view of the identical goods. The applicant filed an action before the GC. The GC dismissed the appeal. It found that the relevant territory is the entire Union and that the relevant public consist of the average consumer. The goods at issue are identical (not disputed). As regards the element **CASTILLO DE** of the earlier mark, this element is generic and of weak distinctive character. In addition, the figurative element of the EUTM application is simple. Thus, the GC found that the elements **LIRIA** and **ILLIRIA** are the dominant (and distinctive) elements of the marks. The marks are visually similar to a low and phonetically similar to a medium degree. As regards the conceptual comparison the GC ruled that a substantial number of EU consumers would not associate the elements **ILLIRIA** and **LIRIA** with a particular concept. The conceptual comparison therefore remains neutral. Considering that for *wines* particular importance has to be attached to the phonetic aspect, that the expression **CASTILLO DE** has a low degree of distinctiveness, while **LIRIA** has no meaning for parts of the relevant public, taking into account the degree of similarity between **ILLIRIA** and **LIRIA** and the fact that the other elements of the signs have a less distinctive character, the GC confirmed the existence of a likelihood of confusion. **LOC**

♦♦[T-711/13](#) and [T-716/13](#) (joined cases); **HARRY’S BAR** and **PUB CASINO Harrys RESTAURANG et al.**; Judgments of 18 February 2016; *Harrys Pubar AB v OHIM* and *Harry’s New York Bar SA v OHIM*; Language of the cases: EN.

EUTM application	Earlier marks
HARRY’S BAR	

The EUTM applicant sought to register the word mark **HARRY’S BAR** as an EUTM for goods and services in Classes 25, 29, 30, 32, 33 and 43. The opponent filed an opposition, *inter alia*, on the grounds of Article 8(1)(b) EUTMR for those goods and services based on, *inter alia*, the earlier Swedish figurative EUTM above registered for goods and services in Classes 29 and 42. The OD upheld the opposition for all the goods and services in Classes 25, 32, 33, 43 and for part of the goods in Classes 29 and 30. The EUTM applicant filed an appeal seeking the annulment of the decision of the OD insofar as it upheld the opposition. The opponent filed an appeal for the annulment of the same decision insofar as it rejected the opposition. The BoA partially upheld the EUTM applicant’s appeal and dismissed the opponent’s appeal in its entirety. As a result, registration was refused for all the goods and services in Classes 25, 33 and 43 and was allowed for part of the goods in Classes 29 and 32 and for all the goods in Class 30. Both the EUTM applicant and the opponent filed an application before the GC for the annulment of the decision of the BoA. The relevant public is the average Swedish consumer (paras 45 to 46). The goods and services in Classes 25 and 43 are identical (para. 53). The contested goods in Classes 29,



30, 32 and 33 are similar to *servicing of food and drink through restaurant, pub and café services* in Class 43, as such goods and services are complementary: despite the fact that they have a different nature, intended purpose and method of use, those goods are necessarily used in the serving of food and drink. Furthermore, food may be offered for sale in places in which food and drink are served. Those goods are consequently closely connected with those services (paras 54 to 75). As for the similarity between the signs, the element ‘Harrys’ is dominant in the earlier mark because of its size, stylised nature and central position, whereas the additional elements have no distinctive character (paras 87 to 88). From a visual point of view this results in a similarity that cannot be offset by the graphic element in the earlier mark (paras 91 to 93). From a phonetic standpoint, on account of the natural tendency of consumers to abbreviate long signs and on account of the descriptiveness of the terms ‘pub’, ‘casino’ and ‘restaurant’, in the earlier mark, only the term ‘harrys’ will be pronounced by the relevant public. Although the contested mark will, by contrast, in all likelihood, be pronounced in its entirety, a certain degree of phonetic similarity deriving from the word ‘harry’s’ continues to exist because the word ‘bar’ is descriptive (para. 94). As for the conceptual comparison, although the use of a person’s name as a trade name is a relatively common practice in the catering sector, the marks at issue are conceptually similar inasmuch as the relevant public may think that the goods and services concerned have been produced or are being offered by an undertaking bearing that name. Furthermore, there is also a high degree of conceptual similarity between the word ‘bar’, on the one hand, and the words ‘pub’ and ‘restaurant’, on the other hand, as those words all refer to places in which food and beverages and services relating thereto are sold or consumed. By contrast, the word ‘casino’ refers to games for entertainment and to recreational and betting activities and may thus have a different meaning. However, as the earlier mark is registered for the serving of food and drink and not for entertainment activities, the abovementioned conceptual similarity between the marks at issue will not be affected. Thus, there is a high degree of conceptual similarity between the marks (paras 97 to 99). In light of the above factors, there is a likelihood of confusion for all the goods and services. This finding would not be altered in the event that the distinctive character of the earlier mark was proven to be weak (paras 106 to 108). The opponent’s action was therefore upheld, whereas the EUTM applicant’s action was dismissed (paras 109 to 110). **LOC**

♦♦[T-84/14](#) and [T-97/14](#) (joined cases); **HARRY’S NEW YORK BAR / PUB CASINO Harrys RESTAURANG et al.**; Judgments of 18 February 2016; *Harrys Pubar AB v OHIM* and *Harry’s New York Bar SA v OHIM*; Language of the cases: EN.

EUTM application	Earlier marks
HARRY’S NEW YORK BAR	

The EUTM applicant sought to register the word mark **HARRY’S NEW YORK BAR** as an EUTM for goods and services in Classes 25, 30, 32 and 43. The opponent filed an opposition, inter alia, on the grounds of Article 8(1)(b) EUTMR for those goods and services based on, inter alia, the earlier Swedish figurative EUTM above registered for goods and services in Classes 29 and 42. The OD upheld the opposition for all the goods and services in Classes 25, 32, 43 and for part of the goods in Class 30. The EUTM applicant filed an appeal seeking for the annulment of the decision of the OD insofar as it upheld the opposition. The opponent filed an appeal for the annulment of the same decision insofar as it



rejected the opposition. The BoA partially upheld the EUTM applicant’s appeal and dismissed the opponent’s appeal in its entirety. As a result, registration was refused for all the goods and services in Classes 25 and 43 and was allowed for all the goods in Class 30 and 32 (with the exception of ‘beers’ in Class 32). Both the EUTM applicant and the opponent filed an application before the GC for the annulment of the decision of the BoA. The relevant public is the average Swedish consumer (paras 53 to 54). The goods and services in Classes 25 and 43 are identical (para. 63). The contested goods in Classes 30 and 32 are similar to *servicing of food and drink through restaurant, pub and café services* in Class 43, as such goods and services are complementary: despite the fact that they have a different nature, intended purpose and method of use, those goods are necessarily used in the serving of food and drink. Furthermore, food may be offered for sale in places in which food and drink are served. Those goods are consequently closely connected with those services (paras 64 to 75). As for the similarity between the signs, the element ‘harrys’ is dominant in the earlier mark because of its size, stylised nature and central position, whereas the additional elements have no distinctive character (paras 87 to 88). From a visual point of view, this results in a similarity that cannot be offset by the graphic element in the earlier mark. Likewise, the element ‘new york’ in the mark applied for is of only limited importance, since it will be perceived as evoking a certain style of bar operated by the person named Harry (paras 92 to 95). From a phonetic standpoint, on account of the natural tendency of consumers to abbreviate long signs and on account of the descriptiveness of the terms ‘pub’, ‘casino’ and ‘restaurang’, in the earlier mark, only the term ‘harrys’ will be pronounced by the relevant public. Although the contested mark will, by contrast, in all likelihood, be pronounced in its entirety, a certain degree of phonetic similarity deriving from the word ‘harry’s’ continues to exist because the word ‘bar’ is descriptive (para. 96). As for the conceptual comparison, although the use of a person’s name as a trade name is a relatively common practice in the catering sector, the marks at issue are conceptually similar inasmuch as the relevant public may think that the goods and services concerned have been produced or are being offered by an undertaking bearing that name. Furthermore, there is also a high degree of conceptual similarity between the word ‘bar’, on the one hand, and the words ‘pub’ and ‘restaurang’, on the other hand, as those words all refer to places in which food and beverages and services relating thereto are sold or consumed. By contrast, the word ‘casino’ refers to games for entertainment and to recreational and betting activities and may thus have a different meaning. However, as the earlier mark is registered for the serving of food and drink and not for entertainment activities, the abovementioned conceptual similarity between the marks at issue will not be affected. Thus, there is a high degree of conceptual similarity between the marks (paras 99 to 101). In light of the above factors, there is a likelihood of confusion for all the goods and services. This finding would not be altered in the event that the distinctive character of the earlier mark was proven to be weak (paras 108 to 110). The opponent’s action was therefore upheld, whereas the EUTM applicant’s action was dismissed (paras 111 to 112). **LOC**

[T-364/14](#); **B!O / bo**; Judgment of 18 February 2016; *Penny-Market GmbH v OHIM*; Language of the case: DE.

EUTM	Earlier mark
	bo

The EUTM proprietor was granted the registration of the figurative mark represented above as an EUTM for foodstuff and drinks in Classes 29 to 32. An application for invalidity was



filed pursuant to Article 53(1)(a) in conjunction with Article 8(1)(b) EUTMR. The request was based on, inter alia, the earlier word mark **bo** registered for goods in Classes 29 to 32. The CD dismissed the application for invalidity. The BoA upheld the invalidity applicant’s appeal and cancelled the contested EUTM, since it found that there was a likelihood of confusion in the sense of Article 8(1)(b) EUTMR. The EUTM proprietor filed an appeal before the GC claiming an infringement of Article 53(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR. The GC confirms the assessment of the BoA as to the relevant consumers, who will have a low to medium level of attentiveness. The foodstuff and drinks are goods for everyday consumption and the public will in principle not examine them thoroughly (para. 17). The GC finds that the contested mark contains the combination of the letters ‘b’ and ‘o’ with an exclamation mark in-between, together with a green rectangle (para. 22). The signs coincide in the letters, ‘b’ and ‘o’ because the earlier mark, being a word mark, is protected in all scripts (para. 23). The GC confirms the BoA to the extent that the exclamation mark will not be perceived as an ‘l’ that has been turned around. Furthermore, the exclamation mark is bigger than the letters and has a different script. Therefore, it will not be seen as forming a unity together with the letters ‘b’ and ‘o’. The contested mark will not be read as meaning ‘bio’ (paras 25 and 26). The green rectangle is banal and has no distinctive character (para. 27). The BoA was right in assessing that the marks have important visual similarities. The different assessments on the visual similarity in decisions at national level as well as those from the Office are not binding and refer to different factual situations (paras 31 to 33). Aurally the marks are identical (para. 35) and conceptually none of them has a meaning (para. 38). As to the global assessment on likelihood of confusion the GC states that the earlier mark has an average distinctiveness. Consequently, taking the visual similarity and the aural identity and the identical and similar goods (undisputed by the applicant) into consideration, there is a likelihood of confusion (para. 46). The GC endorses the intervener’s argument that even in short marks, differences that have no consequence in the aural or visual perception in order to distinguish the signs, have no relevance (para. 49). **LOC**

♦[T-816/14](#); **REAL HANDCOOKED / real; QUALITY**; Judgment of 24 February 2016; *Tayto Group Ltd. v OHIM*; Language of the case: EN.

EUTM application	Earlier mark
	

Both the OD and the BoA upheld the opposition. The EUTM applicant filed an action before the GC relying on three pleas in law. Concerning the third plea in law alleging the infringement of Article 8(1)(b) EUTMR, the relevant public is the average German consumer. The GC confirms that the earlier mark has no meaning as regards the goods in question and that it is inherently distinctive in their regard, as it does not evoke the nature of those goods (para. 64). It also confirms that the term ‘REAL’ is the dominant element in both signs. There is an average visual similarity and an above-average phonetic similarity between the signs. The signs are conceptually similar because they share the dominant element ‘REAL’. There is a likelihood of confusion. **LOC**



[T-210/14](#); **Gummi Bear-Rings / GUMMY**; Judgment of 26 February 2016; *Mederer GmbH v OHIM*; Language of the case: EN.

EUTM application	Earlier mark
	

The applicant sought to register the figurative mark represented above as an EUTM for goods within Class 30: mainly *confectionary*. An opposition based on the earlier national Spanish figurative mark represented above, registered for goods in Class 30: *confectionary*, was filed on the grounds of Article 8(1)(b) EUTMR. The OD upheld the opposition. The BoA dismissed the applicant’s appeal. It found that the earlier sign had no meaning in Spain and considering the similarities of the signs and identity of goods that there is a likelihood of confusion. The applicant filed an action before the GC. The GC found that the relevant territory is Spain and that the goods target the general public. The goods are identical. The signs are visually similar to a low degree and phonetically similar. From a conceptual point of view the GC concluded that in general the knowledge of the English language is low for the relevant Spanish public. ‘Gummy’ is not a basic English term and will not be understood by the Spanish public and is thus perceived to be a fanciful term. The signs are therefore not conceptually similar. It does not matter that the Spanish youth may have a better command of English, as the goods *confectionary* are aimed at all consumers. The earlier right is neither devoid of distinctive character nor descriptive. Even if the relevant public, when purchasing the goods at issue, perceived the signs at issue visually, the fact remains that, in the light of the identity of goods and the consumers’ low level of attentiveness, the low degree of visual similarity between the signs at issue is not capable of excluding the existence of a likelihood of confusion between those signs. **LOC**

[T-53/15](#); **Curodont / Eurodont**; Judgment of 10 March 2016; *credentis AG v OHIM*; Language of the case: EN. The applicant sought to register the word mark **Curodont** as an EUTM for, inter alia, goods and services within Classes 3 and 44. An opposition based on the earlier Danish word mark **Eurodont**, registered for goods in Class 3, was filed on the grounds of Article 8(1)(b) EUTMR. The OD rejected the opposition on the ground that there was no likelihood of confusion. The BoA upheld the opponent’s appeal. The applicant filed an action before the GC. The GC confirmed the practice of the Office that when the relevant goods or services target both the general public and professionals, it is the public having the lower level of attention that must be taken into account for the assessment of the likelihood of confusion (para. 22). The contested goods in Class 3 and services in Class 44 are partly identical and partly similar to the opponent’s goods in Class 3. The GC emphasised that contrary to the BoA findings the contested *cosmetics* are not identical but only similar to the earlier *dentifrices and mouth washes* (para. 28). The marks are visually and aurally similar. Since they are meaningless, taken as a whole, the conceptual comparison between them is irrelevant. The GC concluded that the sole difference of one letter between the signs, even if it is their first letter, cannot cancel the overall similarity between them (para. 35). Therefore, there is a likelihood of confusion. **LOC**



♦[T-557/14](#); **SPEZOOMIX / Spezi**; Judgment of 1 March 2016; *BrandGroup GmbH v OHIM*; Language of the case: DE. The word **SPEZOOMIX** was applied for as an EUTM for goods in Classes 32 and 33. The OD dismissed the opposition based on the earlier word mark **Spezi**. The BoA reversed the decision and found that both the marks and the goods were identical or similar so there would be a likelihood of confusion. The applicant based its application for annulment on two pleas in law: (i) infringement of Article 8(1)(b) EUTMR and (ii) infringement of Article 8(5) EUTMR. The GC rejected the second plea as inadmissible. As regards the first plea, as to the attentiveness of the relevant consumers, the GC confirmed the findings of the BoA. Having regard to the goods, namely beverages, the attention of the general public would be average (para. 15-23). The BoA concluded that the goods are partly identical, highly similar and similar in a low degree. The applicant did not contend this assessment, which is upheld by the GC (paras 24 to 27). **Comparison of signs:** the GC confirmed the BoA’s assessment as to the weakness of the ending part ‘MIX’ in the contested mark. It refers to mixture and all the relevant goods may be mixed with other beverages (para. 34 and 35). The fact that ‘MIX’ might have other possible meanings is irrelevant for the purpose of determining the descriptive meaning of an element (para. 36). The consumer, perceiving the contested sign, will break it down into elements, which for him or her suggest a concrete meaning or which resemble words known to him or her. Consequently, the element ‘MIX’ will be perceived by the consumers speaking basic English as descriptive (paras 38 to 40). The coincidence in the first four letters together with the weakness of the ending part ‘MIX’ in the opposed mark render the signs visually and aurally similar. The GC highlighted the fact that the coinciding parts are at the beginning of the marks to which the consumers tend to give more importance (paras 41 to 52). Conceptually no comparison may be done (paras 53 and 54). Having regard to all the relevant factors of the case, the BoA correctly found that there would be likelihood of confusion. The applicant’s argument that the earlier mark would be weak has been dismissed. First, a weak distinctive character would not directly mean that there is no likelihood of confusion because it is only one of the relevant factors in the overall assessment. Second, a weak distinctive character has been shown only for the German-speaking countries and not for the remainder (paras 57 to 65). **LOC**

[T-160/15](#); **MINICARGO / MINI**; Judgment of 10 March 2016; *LG Developpement v OHIM*; Language of the case: EN.

EUTM application	Earlier mark
	<p style="text-align: center;">MINI</p>

The applicant sought to register the figurative mark represented above as an EUTM for goods in Class 12. An opposition based on the earlier word mark **MINI**, registered for goods in Class 12, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition and found that there was no likelihood of confusion. The BoA upheld the opponent’s appeal and found that there was a likelihood of confusion. The EUTM applicant filed an action before the GC. The GC dismissed the appeal. It found that the relevant public consists of specialists such as professionals in the goods transport sector, and of the general public in the EU. The opposition is assessed with respect to the UK. The goods are identical. The BoA did not err in finding that **MINICARGO** would be understood as consisting of ‘mini’ and ‘cargo’ and in comparing the marks on that basis. There is an average degree of visual and aural similarity



and only a low degree of conceptual similarity, lower than that was found to exist by the BoA.
LOC

♦[T-645/13](#); E / E; Judgment of 15 March 2016; *Evcharis Nezi v OHIM*; Language of the case: EL.

EUTM application	Earlier mark
	

The EUTM applicant sought to register the figurative mark above as an EUTM for goods in Classes 14, 16, 18, 25, 26, 35 and 40. An opposition based on the earlier figurative EUTM, registered for goods in Classes 3, 18 and 25 was filed on the grounds of Article 8(1)(b) and Article 8(5) EUTMR. The OD dismissed the opposition. The BoA partly upheld the appeal, allowing the opposition for goods in Class 18 and 25. The EUTM applicant filed an application before the GC for the partial annulment of the decision of the BoA, insofar as it upheld the opposition. The opponent filed an intervention for the partial annulment of the same decision, insofar as it dismissed the opposition. The relevant public consists of the general public and of a specialised one — the latter showing a higher level of attention — in the whole EU; the BoA was thus entitled to take into particular consideration those Member States where Greek is not an official language and where Greek letters are not recognised, in particular when they looked like Latin letters. For ‘festive events with a commercial or advertising purpose’, specialists but also the general public will show a higher level of attention (paras 66 to 67). The goods in Class 18 and 25 are identical. The contested mark’s *lace and embroidery, ribbons, needles* in Class 26 have a certain similarity with the earlier mark’s *clothing* as the first can be used to produce the latter and as they are concurrent and complementary goods. The contested mark’s *festive events with a commercial or advertising purpose* in Class 35 can have a link with the earlier mark’s goods: such services can be provided before or at the time of the sale of goods, which are thus necessary or important for the development of such services; such services are indeed meaningless without these products. The remainder of the contested goods in Classes 14, 16, 26 and 40 are dissimilar from the earlier mark’s goods because of their nature, destination and distribution channels (paras 71 to 92). The signs show an average degree of visual similarity. They will be perceived as a representation of the letter ‘E’, therefore being phonetically identical and conceptually not comparable (as a letter is not a concept) (paras 93 to 102). In view of the above, there is a likelihood of confusion for those goods that were deemed to be identical. For the rest of the goods, the difference between the signs is enough to rule out any likelihood of confusion, given in particular that the public will show a higher level of attention for the earlier mark’s goods in Class 35 (paras 109 to 110). **LOC**



[T-785/14](#); **MOTORTOWN / M MOTOR**; Judgment of 18 March 2016; *El Corte Inglés, S.A v OHIM*; Language of the case: ES.

EUTM application	Earlier mark
	

The applicant sought to register the figurative mark represented above as an EUTM for goods and services within Classes 1 to 4, 6 to 9, 11, 12, 16, 18, 20, 21, 25, 27, 35 and 37. An opposition based on the earlier figurative mark represented above, registered for goods in Classes 16, 18 and 25, was filed on the grounds of Article 8(1)(b) EUTMR. The OD upheld the opposition insofar as the two signs were similar with respect to the visual, phonetic and conceptual levels. For this reason, OD concluded that there was a likelihood of confusion and therefore, the sign could not be registered under the Classes 16, 18, 25 and 35. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. The GC emphasised that the targeted relevant public consists of average consumers who are reasonably well-informed and reasonably observant and circumspect (para. 23). Concerning the comparison of goods and services, the GC expresses that the opposition can be formulated only against the goods and services specified on the trade mark application, it follows that OD was not empowered to reach a decision about all the goods covered under Class 18 but only for the comparison regarding the good *horseshoes*, which are the pertinent goods covered by the contested EUTM application. The marks are visually similar because the first five letters in both marks are the same; so the main part in the two marks is the 'm'. In this sense, it has been held that the relevant public shows a higher level of attention at the beginning of the mark rather than the end (paras 44 to 59). The marks present a medium phonetic similarity, since the initial part of the trade mark is pronounced likewise and only the end of the mark differs in its pronunciation (para. 63). The marks are also conceptually similar because the public, even the specialised public in the EU, will recognise the reference to the term 'motor' expressed at the beginning of both marks (para. 66). The GC confirmed that the graphic and stylistic differences are not enough to determine that the signs are different. There is likelihood of confusion. The appeal is dismissed in its entirety (para. 79).

LOC

[T-613/14](#); **Polycart A Whole Cart Full of Benefits / POLICAR**; Judgment of 7 April 2016; *Industrias Tomás Morcillo, S.L. v EUIPO*; Language of the case: ES.

EUTM application	Earlier mark
	

The applicant sought to register the figurative mark represented above as an EUTM for goods in Classes 12, 17 and 20. An opposition based on the earlier figurative mark represented above, registered, inter alia, for goods in Class 12, was filed pursuant to Article 8(1)(b) EUTMR against part of the goods for which protection was sought. The OD



upheld the opposition in its entirety. The BoA accepted the applicant’s requests for limitation of the list of goods, but dismissed its appeal. It found that there was a likelihood of confusion since some of the contested goods were identical, the remaining ones being highly similar, and the signs were visually similar, phonetically highly similar and meaningless from a conceptual perspective. The applicant filed an action before the GC relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC found that the BoA had not erred in the assessment of similarity between the goods and the signs and dismissed the appeal. The GC rejected as ineffective the applicant’s claim that the contested mark was used in Spain prior to the application for registration of the opponent’s mark (paras 17 to 18). Regarding the comparison of the goods, the applicant only contested the finding of identity between *shopping trolleys* and *apparatus for locomotion by land*. The GC confirmed this finding since the latter is one of the general indications in the heading of Class 12 and therefore the earlier mark is protected for all products included in the wording of said indication. As *apparatus for locomotion by land* are a set of organised parts used for movement by land, *shopping trolleys*, which have that purpose, are covered by that concept (paras 19 to 24). The GC dismissed all the applicant’s arguments. Among other reasons, the GC recalls that it is the group of goods protected by the marks at issue, and not the goods actually marketed, which must be taken into account in order to assess the similarity between the goods, and that the factors for the assessment of similarity between the goods do not apply in the present case since they are identical (paras 26 to 34). The GC remarked that a ‘partial’ identity is not required between the signs to establish their similarity and that the lack of a ‘complete word’ in common does not preclude the finding of a similar overall impression. Since the BoA did not determine a conceptual similarity, the argument that the signs are conceptually different is ineffective (paras 37 to 38). **LOC**

[T-8/15](#); **MR JONES / JONES et al.**; Judgment of 12 April 2016; *Auyantepui Corp., SA v EUIPO*; Language of the case: EN.

EUTM application	Earlier mark
	

The applicant sought to register the figurative mark represented above as an EUTM for goods and services within Classes 18, 25 and 35. An opposition based on the earlier figurative mark represented above, registered for goods in Class 25 was filed on the grounds of Article 8(1)(b) EUTMR. The opposition was directed against some of the goods in Class 18 and all of the goods in Class 25. The OD upheld the opposition in part (for some goods in Classes 18 and 25). The BoA dismissed the applicant’s appeal. The applicant filed an action before the GC. The applicant did not dispute the BoA’s conclusion on the definition of the relevant public and on the conclusion that the goods in question were similar or identical. As the GC indicated, the applicant admitted that the marks are phonetically similar and did not put forward any argument challenging the BoA’s conclusion that the marks are also conceptually similar (paras 22 and 23). As regards the visual comparison, the GC dismissed the applicant’s arguments concerning the weakness of the element ‘jones’ and the differences between the marks at issue. First, regarding the assessment of surnames, the GC reminded that the distinctive character of a trade mark constituted by a surname, even a common one, must be specifically assessed, in accordance with the criteria applicable to any



other sign (para. 28). As a consequence, the fact that the word ‘jones’ is a widespread surname is irrelevant to the assessment of the distinctive character of that word (para. 29). The GC also dismissed the applicant’s arguments on the weakness of ‘jones’ marks due to the presence of other marks including the term ‘jones’ on the Register (para. 38). In conclusion, the GC considers that the applicant has not shown that the element ‘jones’ is descriptive or weakly distinctive. Second, as regards the differences, the GC agreed with the BoA that they are not sufficient in order to call into question the similarity between the marks arising from the presence of the common element ‘jones’ (para. 44). The GC did not address the applicant’s claim that the visual aspect of the trade marks plays a greater role in the global assessment of the likelihood of confusion. In conclusion, there is a likelihood of confusion. **LOC**

♦[T-198/14](#); **100% Capri / CAPRI**; Judgment of 19 April 2016; *100% Capri Italia Srl v EUIPO*; Language of the case: IT.

EUTM application	Earlier mark
	

The applicant sought to register the figurative mark shown above as an EUTM for goods in Classes 18 and 25. An opposition based on the earlier EU figurative mark shown above was filed on the grounds of Article 8(1)(b) EUTMR. The goods on which the opposition was based are *items of outer clothing* in Class 25. The BoA upheld the OD’s finding that there was a likelihood of confusion between the conflicting marks and dismissed the appeal. The applicant filed an action before the GC. On the likelihood of confusion, the GC firstly confirmed the finding of the BoA that the goods at issue are identical or similar. Secondly, the GC rejected the applicant’s argument that ‘CAPRI’ is devoid of distinctive character since it is the name of a known island of the Gulf of Naples. The GC recalled the case-law according to which when the name of a geographical place does not have any link with relevant goods or services it could be registered as a trade mark. Therefore, since the applicant did not show that any connection exists between the word ‘CAPRI’ and goods at issue, the contested decision correctly found that the distinctive character of the word element ‘CAPRI’ is of an average degree (paras 76 to 78). The GC also confirmed the BoA’s finding that ‘CAPRI’ is the dominant element of the earlier mark due to its central position and the space it occupies. The common word ‘CAPRI’ is the dominant element also of the contested mark since the element ‘100%’ is just a semantic addition of the word ‘CAPRI’ (paras 90 to 93). The GC also confirmed that the findings of the BoA that there is an average degree of visual, phonetic and conceptual similarity between the signs at issue (paras 95 to 115). In the light of the normal distinctiveness of the earlier mark, the identity and similarity between the goods, and of the visual, phonetic and conceptual similarity between the conflicting signs, the GC stated that the BoA was correct in finding that there was a likelihood that between the signs at issue (paras 116 to 122). **LOC**



[T-326/14](#); **HOT JOKER / JOKER**; Judgment of 19 April 2016; *Novomatic AG v EUIPO*; Language of the case: EN.

EUTM application	Earlier mark
	

The applicant sought to register the figurative mark **HOT JOKER** represented above as an EUTM for goods and services within Classes 9 and 28. An opposition based on the French earlier figurative mark **JOKER** represented above, registered for goods in Classes 28 and 41, was filed on the grounds of Article 8(1)(b) EUTMR. The OD upheld the opposition insofar as it was not necessary to examine the other ground relied on in support of the opposition. The Second BoA dismissed applicant’s appeal. The applicant filed an action before the GC. The comparison of the goods in Class 9 *hardware and software* are complementary to the goods protected by the earlier mark under Class 28, inasmuch as the software and hardware in Class 9 are essential elements for the functioning of the electronic or online games of chance covered by the earlier mark (para. 54). Concerning the comparison of the signs the GC maintains that the word element ‘joker’ is not devoid of any distinctive character, since the applicant is not able to prove that for the relevant French public it is a descriptive sign for games of chance or lotteries. Regarding the word element ‘hot’, it does not create the unique impression of the mark applied for (paras 75 to 78). **Likelihood of confusion:** the identity or similarity between the goods under comparison and the similarity between the signs at issue reveals the existence of likelihood of confusion, in spite of the high level of attention of professionals in the casinos and amusement arcades sector, who are part of the relevant public (paras 79 to 80). From a probative perspective, the GC expresses that the applicant is not able to establish with accuracy, the relevant French public’s awareness of the character of the Joker who appears in the Batman films and comics, inasmuch as it was entitled to take the view that it was a well-known fact that those films and comics were famous and widely distributed throughout France (para. 93). The applicant confined itself to invoking Article 76 EUTMR in a general abstract manner, but did not provide any evidence to dispute the fame and wide distribution of the Batman films and comics in France and consequently, the relevant French public’s awareness of the character of the Joker. As a result, the GC establishes that the degree of similarity is sufficient to settle that there is a likelihood of confusion (para. 94). **LOC**

♦[T-77/15](#); **SkyTec**; Judgment of 20 April 2016; *Tronios Group International BV v EUIPO*; Language of the case: NL. The EUTM proprietor was granted the registration of the word mark **SkyTec** as an EUTM for goods in Classes 9 and 11. An application for invalidity was filed pursuant to Article 53(1)(a) EUTMR in conjunction with Articles 8(1)(b) and Article 8(5) EUTMR and Article 53(1)(c) in conjunction with Article 8(4) EUTMR with respect to the goods in Class 9. The CD upheld the application for invalidity and dismissed the EUTM proprietor’s defence based on Article 54(2) EUTMR (limitation in consequence of acquiescence). The BoA dismissed the EUTM proprietor’s appeal. It confirmed that the exception of Article 54(2) EUTMR was unfounded. The EUTM proprietor did not prove that the invalidity applicant on the date of the invalidity application had acquiesced, for a period of five successive years, in the use of the contested EUTM while being aware of such use. The BoA also stated that



there is a likelihood of confusion between the contested EUTM and the invalidity applicant's earlier UK trade mark. The EUTM proprietor filed an action before the GC relying on two pleas in law: (i) violation of Article 54(2) EUTMR and (ii) wrong assessment of the likelihood of confusion according to Article 53(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR. The GC dismissed the appeal. The goods at issue are in part identical, in part similar (not disputed). The relevant public is the average consumer and the professional public in the United Kingdom, the level of attention will vary from average to higher than average (not disputed). The marks are visually, phonetically and conceptually similar to an average degree (not disputed). The GC confirmed that the distinctiveness of the earlier UK trade mark **SKY** is not affected by the co-existence of this mark with many other marks that contain the element 'sky', the earlier mark has an inherent average degree of distinctiveness and an enhanced degree of distinctiveness in relation to some of the goods (paras 56 to 59). The element 'Tec' in the contested EUTM is descriptive and plays a subordinate role within the mark (para. 59). There is likelihood of confusion. **LOC**

♦ [T-777/14](#); **Neofon / FON**; Judgment of 26 April 2016; *Fon Wireless Ltd v EUIPO*; Language of the case: DE. The intervener sought to register the word mark **Neofon** as an EUTM for goods within Classes 9 and 18. The EUTM was rejected upon the opposition on the basis of an earlier UK word mark **FON** protected for goods and services in Classes 9, 38, 42. The BoA annulled the decision of the OD and rejected the opposition. The BoA excluded the likelihood of confusion even for identical goods on the basis of the limited distinctive character of the earlier marks. It reasoned that 'fon' is a common misspelling or a reference to the word 'PHONE' whilst all the protected goods are phones or parts of it and the services are related thereto. The opponent filed an action before the GC relying on Article 8(1)(b) EUTMR. The GC affirmed a likelihood of confusion. As regards the comparison of the signs, it emphasised that the EUTM application contains the earlier mark with an addition of the prefix 'Neo', which results in a visual and phonetic similarity (para. 38). The addition of that prefix is not capable of sufficiently differentiating the signs, as the relevant public will perceive it with relation to the word 'fon' as its clarification (para. 43). Moreover, phonetically there is a similarity because of the coincidence in the syllable 'fon' (para. 44). The visual and phonetic similarity is average (para. 45). There is also an average conceptual similarity (para. 50). The distinctiveness of the earlier mark is low because it refers to 'telephones' and is therefore connected with the protected goods in Class 9 and services in Classes 38 and 42. Nevertheless, given the average similarity between the signs and the identity of the products the likelihood of confusion must be confirmed (paras 61 and 62). **LOC**

[T-21/15](#); **Dino / Device of a dinosaur**; Judgment of 26 April 2016; *Franmax UAB v EUIPO*; Language of the case: EN.

EUTM application	Earlier mark
	

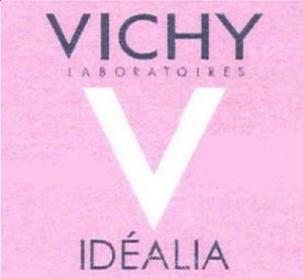


The applicant sought to register the figurative mark represented above for some goods in Classes 29 and 30. An opposition based on the earlier international figurative mark designating the EU represented above, registered for goods in Classes 29 and 30, was filed pursuant to Article 8(1)(b) EUTMR. The OD partly upheld the opposition and rejected the application for some of the goods in Classes 29 and 30. Upon appeal by the applicant, the BoA confirmed partially the refusal of the EUTM application. The applicant filed an action before the GC claiming an infringement of Article 8(1)(b) EUTMR. The GC confirmed the decision of the BoA and concluded the likelihood of confusion in the meaning of Article 8(1)(b) EUTMR. The relevant public consists of a general one with an average level of attention (para. 20). The GC confirmed that some of the contested goods *compotes* in Class 29 and *pastry and confectionery* in Class 30 are similar to the opponent's *milk products* in Class 29 (paras 48 to 58) whereas *coffee, cocoa and artificial coffee and preparations made from cereals* in Class 30 are similar to a low degree to *milk products* (paras 28 to 41). However, the marks are visually similar to an average degree to the extent they contain the representation of a 'cartoon-like image' of a dinosaur giving the impression of a friendly and happy creature (paras 69 to 73). The phonetic comparison of the signs at issue is irrelevant, given that a figurative mark without word elements such as the earlier mark cannot, as such, be pronounced (para. 75). Conceptually the marks are 'highly similar'; insofar as they both refer to the concept of a moving dinosaur giving the impression of a friendly, happy creature (para. 78). **LOC**

[T-267/14](#); **comfotherm / KOMFOTHERM**; Judgment of 28 April 2016; *Zehnder Group International AG v EUIPO*; Language of the case: DE. The applicant registered the word mark **comfotherm** as an EUTM for goods *fuel cells* in Class 9 and *heat pumps, excluding electric heaters* in Class 11. Following an application for a declaration of invalidity pursuant to Article 53(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR based on the German word mark **KOMFOTHERM**, registered for *electric heaters* in Class 11, the CD invalidated the EUTM. The BoA dismissed the EUTM proprietor's appeal. The EUTM proprietor filed an action before the GC. The conflicting goods cover a variety of products, which are also intended for use in private households, including fuel cells, which can be used for heating purposes. Thus, the relevant public consists of professionals and the public at large (paras 24 to 39). Taking into account the required investment when purchasing the goods, the economic and ecological consequences when operating them, as well as their specific nature, the relevant public including the public at large is attentive to a high degree (para. 39). The conflicting goods are producing energy for heating purposes, can be built into heating systems or distribute heat. They are thus similar at least to a low degree despite their different functionality and technical characteristics (paras 51 to 52). On account of the high degree of similarity between the signs and the at least low degree of similarity between the goods, there is a likelihood of confusion despite the relevant public's high degree of attention (paras 71 to 72). **LOC**



[T-144/15](#); **VICHY LABORATOIRES V IDÉALIA / IDEALINA**; Judgment of 28 April 2016; *L'Oréal v EUIPO*; Language of the case: EN.

EUTM application	Earlier mark
	<p>IDEALINA</p>

The applicant sought to register the figurative mark represented above as an EUTM for goods in Class 3. An opposition based on the earlier word mark **IDEALINA** registered for goods in Class 3, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition and rejected the EUTM application in its entirety. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. The GC found that contrary to the applicant's claim the BoA did not limit itself to a comparison of the word 'idéalia', on the one hand, and the word 'idealina', on the other hand, by disregarding the other elements that compose the mark applied for but reasoned its decision by reference to all the elements composing the marks and in particular it considered the words 'vichy' and 'idéalia' to be co-dominant in the mark applied for (para. 22 to 23). The marks have at least a weak degree of visual similarity (para. 24). The earlier mark has an average distinctive character for the relevant goods (para. 26) as it has no meaning because the consumers will not dissect 'ideal' and 'ina' (para. 27). The goods in question are identical (not disputed). There is a likelihood of confusion even if accepting the applicant's claim that phonetic similarity between the marks is of limited importance due to the way in which the goods are marketed. This circumstance would nonetheless lead to at least a weak degree of similarity between the marks and combined with the other elements, and in particular with the identity of the goods covered, this similarity justifies the finding of the BoA that there was a likelihood of confusion (para. 32). The finding of a likelihood of confusion is not affected by the applicant's theory that the proprietor of an earlier mark cannot require operators seeking to register a mark to keep greater distance from the earlier mark than that which the proprietor kept in relation to earlier marks than his own. Opposition proceedings imply the assessment of the existence of a likelihood of confusion between the mark applied for and an earlier mark. This assessment implies in particular an analysis of the visual, phonetic or conceptual similarity between the opposing marks. As a result, the analysis in question cannot be based upon a comparison of the earlier mark and other marks that are not part of the case under consideration (para. 33).

LOC

[T-503/15](#); **Natür-bal / NATURVAL**; Judgment of 3 May 2016; *Aranynektár Termékgyártó és Kereskedelmi KFT v EUIPO*; Language of the case: EN. The applicant sought to register the word mark **Natür-bal** as an EUTM for goods in Class 30. An opposition based on the earlier word mark **NATURVAL**, registered for goods in Classes 29 and 30, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition. The BoA upheld the opponent's appeal and rejected the EUTM application in its entirety. It found the signs were conceptually similar overall, visually similar and phonetically similar, highly similar or identical depending on the part of the relevant public, and held that the slightly lower than average distinctiveness of the earlier mark was offset by the fact that the goods in question were identical. The applicant filed an action before the GC relying on a single plea in law: infringement of



Article 8(1)(b) EUTMR. The GC dismissed the appeal. It found that there was a likelihood of confusion on the part of the relevant public. The GC emphasised that, even if a section of the Turkish ethnic public allegedly targeted by the mark applied for purchases the goods marketed under that mark, the relevant public for the assessment of likelihood of confusion is composed of the general public of the European Union (paras 22 to 24). The goods at issue are identical (not disputed). The signs are visually similar to an average degree. Even if, in certain alphabets, the ‘ü’ were to be considered to be a letter in its own right, the fact remains that the signs at issue coincide in six of their eight letters. Moreover, the letters ‘u’ and ‘ü’ are visually almost identical, the signs begin and end with the same sequence of letters and the presence of a hyphen does not produce a significant difference taking into account, in particular, the not insignificant length of the confronted signs (paras 33 to 34). Examining the marks from the point of view of several languages, the GC held that the signs are phonetically identical for the Spanish part of the relevant public, highly similar for a large part of the relevant public and similar for the part of the relevant public that recognises a difference in pronunciation when an umlaut is placed above the letter ‘u’ (paras 37 to 41). For a large part of the relevant public, both signs refer to the idea of nature or something natural via the word element ‘natur’, whereas the word elements ‘val’ and ‘bal’ are fairly neutral; the signs at issue are thus conceptually identical for a large part of the relevant public (paras 44 to 47). Based on the above considerations plus the average level of attention of the relevant public, the GC confirmed that there is a likelihood of confusion (para. 52). The GC recalls that the greater importance of the visual comparison is an ineffective argument where a visual similarity between the signs at issue has been found to exist (para. 53) and that it is inappropriate to take marketing strategies into account in the prospective analysis of the likelihood of confusion since these may vary over time and depend on the wishes of the proprietors (para. 54). **LOC**

[T-193/15](#); **BOTANIC W & H LONDON DRY GIN / THE BOTANICALS**; Judgment of 4 May 2016; *Bodegas Williams & Humbert, S.A v EUIPO*; Language of the case: ES.

EUTM application	Earlier mark
	<p style="text-align: center;">THE BOTANICALS</p>

The applicant sought to register the figurative mark represented above as an EUTM for goods in Class 33. An opposition based, among others, on the earlier word mark **THE BOTANICALS**, registered for goods in Class 33, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition in its entirety. The BoA dismissed the applicant’s appeal. It found that there was a likelihood of confusion between the contested mark and the earlier trade mark. The applicant filed an action before the GC relying on a single plea in law, namely the infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. It found that there was a likelihood of confusion between the marks. After a deep analysis on the relevant public’s attentiveness in relation to alcoholic beverages, the GC concluded that the BoA did not err in considering the English-speaking part of the general public, who has an average degree of attention (paras 19 to 34). The GC confirmed the BoA’s uncontested finding of identity between the goods (para. 35). Before entering in the visual, phonetic and conceptual comparison of the signs, the GC determined whether there were dominant or negligible elements in the signs. Thus, the GC confirmed the distinctive character of the words ‘botanic’ and ‘botanicals’, since there was no evidence that the general public would



understand a descriptive meaning in relation to ‘gin’ (paras 42 to 46), and their dominant character within the signs (paras 47 to 48). The signs are, considering all the elements of the signs, visually slightly similar (paras 50 to 54), and have, taking into particular account their dominant elements, an overall impression of average phonetic and conceptual similarity (paras 55 to 66). There is a likelihood of confusion (para. 70). **LOC**

♦[T-643/14](#); **ABTRONIC / TRONIC**; Judgment of 12 May 2016; *Red Lemon Inc v EUIPO*; Language of the case: DE. The BoA confirmed the refusal of the EUTM application for a word mark **ABTRONIC** upon an opposition based on the earlier EU word mark **TRONIC** for goods in Class 9 pursuant to Article 8(1)(b) EUTMR. The applicant filed an action before the GC claiming an infringement of Article 8(1)(b) EUTMR. The GC confirmed the decision of the BoA and affirmed the likelihood of confusion in the meaning of Article 8(1)(b) EUTMR. The relevant public consists of both, the general one with average level of attention and the professional one, whose level of attention is higher (para. 25). The goods are identical or similar (para. 27). The marks are visually similar. Contrary to the submissions of the applicant, the common element ‘TRONIC’ leads to a similarity despite of the existence of the additional element ‘AB’ at the beginning of the contested mark (para. 37). The marks are phonetically similar for the same reasons (para. 41). The marks are conceptually similar, as far as the common element, and even if it does not have any clear meaning, it can allude to ‘electronic’ (para. 47). The earlier mark must be attributed a minimum level of distinctiveness due to the fact of its registration. For goods in Class 9 the mark has a low degree of distinctiveness (para. 52). **LOC**

♦[T-775/14](#); **ABTRONIC / TRONIC**; Judgment of 12 May 2016; *Red Lemon Inc v EUIPO*; Language of the case: DE.

EUTM application	Earlier mark
	<p data-bbox="1018 1294 1134 1330">TRONIC</p>

The BoA confirmed the refusal of the EUTM application for a figurative mark represented above upon an opposition based on the earlier word mark represented above for goods in Class 9 pursuant to Article 8(1)(b) EUTMR. The applicant filed an action before the GC claiming an infringement of Article 8(1)(b) EUTMR. The GC confirmed the decision of the BoA and affirmed the likelihood of confusion in the meaning of Article 8(1)(b) EUTMR. The relevant public consists of both, the general one with average level of attention and the professional one, whose level of attention is higher (para. 25). The goods are identical or similar (para. 27). The marks are visually similar. Contrary to the submissions of the applicant, the common element ‘TRONIC’ leads to a similarity despite of the existence of the additional element ‘AB’ in the contested mark and its graphical features (para. 42). The marks are phonetically similar; this finding was not contested by the applicant (para. 44). The marks are conceptually similar; the common element can allude to ‘electronic’, even if it does not have any clear meaning (para. 47). The earlier mark must be attributed a minimum of distinctiveness due to the fact of its registration. For goods in Class 9 the mark has a low degree of distinctiveness (para. 52). **LOC**



♦ [T-776/14](#); **ABTRONICX2 / TRONIC**; Judgment of 12 May 2016; *Red Lemon Inc v EUIPO*; Language of the case: DE.

EUTM application	Earlier mark
	<p data-bbox="1018 495 1134 524">TRONIC</p>

The BoA confirmed the refusal of the EUTM application for a figurative mark represented above upon an opposition based on the earlier word mark represented above for goods in Class 9 pursuant to Article 8(1)(b) EUTMR. The applicant filed an action before the GC claiming an infringement of Article 8(1)(b) EUTMR. The GC confirmed the decision of the BoA and affirmed the likelihood of confusion in the meaning of Article 8(1)(b) EUTMR. The relevant public consists of both, the general one with average level of attention and the professional one, whose level of attention is higher (para. 25). The goods are identical or similar (para. 27). The marks are visually similar. Contrary to the submissions of the applicant, the common element ‘TRONIC’ is visible and will not be overlooked despite the presence of further elements ‘AB’ and ‘X’ in the contested mark (para. 43). The marks are phonetically similar; this finding was not contested by the applicant (para. 45). The marks are conceptually similar; the common element can allude to ‘electronic’, even if it does not have any clear meaning (para. 48). The earlier mark must be attributed a minimum of distinctiveness due to the fact of its registration. For goods in Class 9 the mark has a low degree of distinctiveness (para. 53). **LOC**

[T-312/15](#); **MITOCHRON / MIVACRON**; Judgment of 13 May 2016; *Market Watch Franchise & Consulting Inc. v EUIPO and Glaxo Group Ltd*; Language of the case: EN. The applicant sought to register the word **Mitochron** as an EUTM for goods within Classes 3, 5 and 35. An opposition based on the earlier word mark **Mivacron** and registered in the UK for goods in Class 5 was filed on the grounds of Article 8(1)(b) EUTMR. The OD upheld the opposition for the identical goods in Class 5. The BoA dismissed the applicant’s appeal. The applicant filed an action before the GC. Regarding the relevant public, the GC confirmed the finding of the BoA that concerning the goods in Class 5, *pharmaceuticals*, the relevant public had a high level of attention (para. 22). As to the substance, the GC affirmed that there was a likelihood of confusion for the relevant public in the UK. Regarding the comparison of the goods, the GC found, as it was not disputed by the parties, that the goods covered by the sign sought are identical or similar to the opponent’s goods (para. 25). Regarding the comparison of the signs the GC held that, visually, in view of the fact that they share six letters, at the beginning and at the end, and their almost identical lengths, the signs are similar. Phonetically the GC concluded that the signs are similar. Conceptually the GC concluded that it is not possible to carry out a conceptual comparison as both the EUTM applied for and the earlier trade mark have no specific meaning. As regards the likelihood of confusion, the GC concluded that given the visual and aural similarity between the signs, there is a likelihood of confusion, even if the public was particularly attentive (para. 37). **LOC**



[T-62/15](#); **Mitochron / mito**; Judgment of 13 May 2016; *Market Watch Franchise & Consulting Inc. v EUIPO and El Corte Inglés*; Language of the case: EN.

EUTM application	Earlier mark
MITOCHRON	

The applicant sought to register the word mark **MITOCHRON** as an EUTM for goods within Classes 3, 5 and 35. An opposition based on the earlier mark represented above, registered in the EU for goods and services in Classes 3 and 35 was filed on the grounds of Article 8(1)(b) EUTMR. The OD upheld the opposition for similar and identical goods in Classes 3 and 5. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. Regarding the relevant public, the GC confirmed the finding of the BoA that concerning the goods in Class 5, *pharmaceutical and veterinary preparations and sanitary preparations*, the relevant public was composed of patients and animal owners assisted by doctors or veterinary surgeons and pharmacists and who were generally well-informed and particularly attentive and circumspect. As for the goods in Class 3 'including perfumery or cosmetics', the relevant consumer is the average one who is reasonably well-informed and reasonably observant and circumspect (paras 20 and 22). As to the substance the GC affirmed that there was a likelihood of confusion for the relevant public in Italy. Regarding the comparison of the goods, the GC found, as it was not disputed by the parties, that the goods covered by the sign sought are identical or similar to the opponent's goods (para. 27). Regarding the comparison of the signs the GC held that, visually, in view of the fact that they share the word element 'mito', they are similar. Phonetically the GC concluded that the signs are similar. Conceptually the GC concluded that they are similar as the both contain the element 'mito', which is the Italian for myth, and the element 'chron' relates to time. The specialists in medicine would also be able to understand 'mito' in relation to mitochondrial disorders. As regards the likelihood of confusion, the GC has concluded that given the visual, aural and conceptual similarity between the signs, there is a likelihood of confusion on the part of the Italian-speaking relevant public (para. 49). **LOC**

[T-06/15](#); **ocean ibiza / OC ocean club Ibiza et al.**; Judgment of 25 May 2016; *Ice Mountain Ibiza, S.L. v EUIPO*; Language of the case: ES.

EUTM application	Earlier mark
	

The applicant sought to register the figurative mark represented above as an EUTM for, among others, services in Class 41. An opposition based, among others, on the earlier figurative mark represented above, registered for services in Class 41 was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition with respect to all of the contested services, namely those in Class 41. The BoA dismissed the applicant's appeal. It found that the verbal and the figurative elements had the same value, that the signs had a certain



degree of visual, phonetic and conceptual similarity and that, since the services were identical, the differences between the signs were insufficient to exclude a likelihood of confusion. The applicant filed an action before the GC relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. The applicant does not contest that the relevant public are consumers from the general public as well as professionals in the territory of Spain, or that the services are identical (paras 20 to 25). The GC confirms the inherent distinctiveness of the term 'OCEAN' for the services involved and that the submitted documents do not prove either an intensive use of that term to the point of provoking the loss of such distinctiveness nor that the coexistence of several trade marks including this term is based on the absence of a likelihood of confusion (paras 32 to 41). Despite the fact that the figurative elements in the signs are of certain importance, this is insufficient to consider them predominant over the term 'OCEAN'. The findings that the verbal elements have the same value for the assessment of the similarity between the signs, and that for part of the relevant public said elements may even be more relevant than the figurative ones, are correct (paras 42 to 49). The GC dismisses the applicant's allegation concerning the coexistence of the marks and confirms, bearing in mind the principle of imperfect recollection, that there is a likelihood of confusion due to the similarity between the signs and the identity of the services (paras 68 to 73). **LOC**

[T-254/15](#); **Casale Fresco / FREZCO**; Judgment of 26 May 2016; *Aldi Einkauf GmbH & Co. OHG v EUIPO*; Language of the case: DE. The applicant sought to register the word mark **Casale Fresco** as an EUTM for goods within Class 29. An opposition based on the earlier trade mark (word mark) **FREZCO**, registered for goods in Class 29, was filed on the grounds of Article 8(1)(b) EUTMR. The OD partially upheld the opposition insofar as the goods are identical or similar. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. The GC dismissed the appeal. It found that the relevant public consist of the average consumer in the Union. The BoA was right to conclude that the earlier right is not of a low degree of distinctiveness. It cannot be presumed that a foreign language is understood by the average consumer. Although the elements 'frezco' of the earlier right or 'fresco' of the application might be understood by parts of the public as 'fresh' or 'cool', others will understand them as a reference to a wall painting, while others won't understand them at all. Neither of the elements of the application is of particular dominance. Therefore, the element 'fresco' enjoys an individual distinctive role in the application. The signs are visually as well as phonetically similar to an average degree. Conceptually the signs are similar as far as their elements are understood in the sense of 'fresh', 'cool' or as a reference to a wall painting. However, as far as neither of the elements is understood by parts of the public, no conceptual comparison is possible. Considering the fact that the goods are either identical or similar, the signs are similar to an average degree from a visual as well as an aural point of view, the signs are conceptually similar to parts of the relevant public, the BoA was right to conclude that there is a likelihood of confusion. **LOC**



♦ [T-510/14](#) and [T-536/14](#) (joined cases); **PARK REGIS / ST. REGIS et al.**; Judgments of 2 June 2016; *Staywell Hospitality Group Pty Ltd v EUIPO* and *Sheraton International IP, LLC v EUIPO*; Language of the cases: EN.

EUTM application	Earlier marks
	

The EUTM applicant sought to register the figurative mark above as an EUTM for services in Classes 35, 36 and 43. The opponent filed an opposition based on the earlier figurative and word EUTMs above on the grounds of Article 8(1)(b) EUTMR. The OD upheld the opposition for a part of the relevant services. Both the applicant and the opponent filed an appeal. The BoA joined the appeals and dismissed them. The applicant filed an action before the GC in Case T-510/14. The opponent filed an action before the GC in Case T-536/14. Concerning the pleas alleging the infringement of Article 8(1)(b) EUTMR (before amendment) the GC held that the contested services in Class 35 and the earlier mark’s services in Class 43 are different in nature, provided by different types of undertakings and target other types of users. That finding is supported by the case-law, which found that, although the development and operation of hotels involves typical office functions, it is nevertheless the case that, within hotels, those services are usually performed by the hotel staff, and not by third parties. Furthermore, hotels usually do not offer office services to other undertakings, with the result that the *office functions* and *operation of hotels services* are different on the ground that they generally have different origins and target different publics. Although that case-law refers specifically to the operation of hotels and office tasks, the reasoning is transposable to the present case with respect to the similitude of promotion services or business management of hotels or restaurants, such as those in Class 35 covered by the mark sought, and *services for providing food and drink* and *temporary accommodation* as such included in Class 43 and covered by the earlier figurative mark. Those types of services are therefore not in competition with each other because services that target different publics cannot be considered substitutable nor are the services at issue mutually complementary (paras 53 to 55). As far as the comparison of the signs is concerned, the term ‘regis’ is the most distinctive element in the two marks: the figurative elements of the marks are made up of relatively banal emblems, being perceived as having a decorative function. The element ‘park’ in the contested mark will be perceived as highly evocative and even descriptive of the services at issue. By contrast, the element ‘regis’ will either be perceived as having no meaning for the relevant public or, for a part of it, as a reference to the Latin term meaning ‘of the King, the idea of a place linked to royalty’. However, even when that element was perceived as laudatory in relation to the services covered, it will remain the most distinctive element of the mark at issue. In relation to the earlier figurative mark, the element ‘st.’ will certainly be perceived internationally as referring to the notion of ‘saint’ since it is also usually followed by a name and perceived as a mere attribute of that name (paras 74 to 78). The signs are visually similar insofar as their most distinctive word element is the same and they both contain a sort of heraldic image. They are also phonetically and conceptually similar to a certain extent in that they share the sounds of the identical letters of the term ‘regis’ and its meaning. Therefore the signs are similar overall (paras 81 to 86). There is a likelihood of confusion, even taking account of a level of attention of the relevant public, which is higher



than average. In particular, since the services at issue refer in each case to hotel and real estate services, the mark applied for and the earlier figurative mark could be perceived as sub-brands in order to distinguish the scope of services of one provider from other services of the same provider. Actually, it is not unusual in the hotel and real estate markets for a principal mark to appear in various forms, depending on the type of service offered (paras 82 to 98). **LOC**

♦[T-96/15](#); **Alfredo alla Scrofa / L'ORIGINALE ALFREDO**; Judgment of 6 July 2016; *Mario Mozzetti v EUIPO*; Language of the case: IT.

EUTM	Earlier mark
	<p>L'ORIGINALE ALFREDO</p>

The EUTM proprietor was granted the registration of the figurative mark represented above as an EUTM for goods and services in Classes 30 and 43 (*pasta* and *restaurant services*). An application for invalidity based on the earlier Italian word mark **L'ORIGINALE ALFREDO** for goods and services in Classes 30 and 43 was filed pursuant to Article 53(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR. The CD upheld the application for invalidity. The BoA dismissed the EUTM proprietor's appeal. It found that there was a likelihood of confusion between the conflicting marks. The EUTM proprietor filed an action before the GC claiming firstly that the BoA erred in finding inadmissible the request of proof of use of the earlier mark because it was filed for the first time before the BoA; secondly, the EUTM proprietor claimed that the BoA erred in finding a likelihood of confusion between the marks at issue. **On the likelihood of confusion:** as far as Article 8(1)(b) and Article 53(1)(a) EUTMR are concerned, the GC firstly confirmed the finding of the BoA that the goods at issue are identical or similar to a high degree. Secondly, the GC rejected the EUTM proprietor's argument that the common term 'ALFREDO' is weakly distinctive since it has become generic with reference to a pasta dish named 'fettuccine Alfredo'. The GC held that the evidence submitted could not prove that 'ALFREDO' has become common in relation to the goods and services at issue. In addition, that term is the element to which consumers will pay more attention in both marks in view of its position, size and because the element 'l'originale' in the earlier mark will be seen as an adjective qualifying the word 'ALFREDO' (paras 37 to 41). In relation to the signs, the GC found that the BoA did not err in finding that the signs are visually and phonetically similar to an average degree. From a conceptual point of view, the signs are similar to the extent that they both evoke the same first name of a person. However, since they also include different concepts (originality v a place) the conceptual similarity is not high. The GC held that, overall, the fact that the marks have different beginnings cannot counteract the similarity arising from the presence of the common element 'Alfredo'. Therefore, the GC approved the finding of the BoA that, taking also into account the interdependence between the degree of similarity between the goods and services and that of the signs, there was a risk of confusion between the marks at issue (paras 44 to 55). Finally, according to the GC, the BoA did not err also in rejecting the EUTM proprietor's arguments about the coexistence between the marks about one agreement for the sale of the restaurant 'Alfredo' in Rome stipulated in 1943: the alleged coexistence did not cover all the relevant territory (Italy) and referred only to restaurant services; the



agreement was irrelevant in relation to the assessment of the similarity between the signs and of the goods and services (paras 56 to 59). **LOC**

♦[T-97/15](#); **ALFREDO'S GALLERY alla Scrofa Roma / L'ORIGINALE ALFREDO**; Judgment of 6 July 2016; *Mario Mozzetti v EUIPO*; Language of the case: IT.

EUTM	Earlier mark
	<p>L'ORIGINALE ALFREDO</p>

The EUTM proprietor was granted the registration of the figurative mark represented above as an EUTM for goods and services in Classes 30 and 43 (*pasta* and *restaurant services*). An application for invalidity based on the earlier Italian word mark **L'ORIGINALE ALFREDO** for goods and services in Classes 30 and 43 was filed pursuant to Article 53(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR. The CD upheld the application for invalidity. The BoA dismissed the EUTM proprietor's appeal. It found that there was a likelihood of confusion between the conflicting marks. The EUTM proprietor filed an action before the GC claiming firstly that the BoA erred in finding inadmissible the request of proof of use of the earlier mark because it was filed for the first time before the BoA; secondly, the EUTM proprietor claimed that the BoA erred in finding a likelihood of confusion between the marks at issue. **On the likelihood of confusion:** as far as Article 8(1)(b) and Article 53(1)(a) EUTMR are concerned, the GC firstly confirmed the finding of the BoA that the goods at issue are identical or similar to a high degree. Secondly, the GC rejected the EUTM proprietor's argument that the common term 'ALFREDO' is weakly distinctive since it has become generic with reference to a pasta dish named 'fettuccine Alfredo'. The GC held that the evidence submitted could not prove that 'ALFREDO' has become common in relation to the goods and services at issue. In addition, that term is the element to which consumers will pay more attention in both marks in view of its position, size and because the element 'l'originale' in the earlier mark will be seen as an adjective qualifying the word 'ALFREDO' (paras 35 to 41). In relation to the signs, the GC found that the BoA did not err in finding that the signs are visually and phonetically similar to an average degree. From a conceptual point of view, the signs are similar to the extent that they both evoke the same first name of a person. However, since they also include different concepts (originality v a place) the conceptual similarity is not high. The GC held that, overall, the fact that the marks have different beginnings cannot counteract the similarity arising from the presence of the common element 'Alfredo'. Therefore, the GC approved the finding of the BoA that, taking also into account the interdependence between the degree of similarity between the goods and services and that of the signs, there was a risk of confusion between the marks at issue (paras 44 to 55). Finally, according to the GC, the BoA did not err also in rejecting the EUTM proprietor's arguments about the coexistence between the marks and about one agreement for the sale of the restaurant 'Alfredo' in Rome stipulated in 1943: the alleged coexistence did not cover all the relevant territory (Italy) and referred only to restaurant services; the agreement was irrelevant in relation to the assessment of the similarity between the signs and of the goods and services (paras 56 to 59). **LOC**



[T-371/15](#); **PREFERISCO / I PREFERITI**; Judgment of 14 July 2016; *Preferisco Foods Ltd v EUIPO*; Language of the case: EN.

EUTM application	Earlier mark
	<p>I PREFERITI</p>

The applicant sought to register the figurative mark represented above as an EUTM for goods in Classes 29, 30 and 32. An opposition based on the earlier EU word mark **I PREFERITI**, registered for goods in Classes 29, 30 and 32, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition and rejected the EUTM application in its entirety. The applicant filed an appeal pursuant to Articles 58 to 64 EUTMR. The BoA partially upheld the appeal annulling the OD’s decision as regards only the goods contained in Class 32, in view of the difference between those goods and those covered by the earlier mark. The applicant filed an action before the GC relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the action. The GC emphasised that the applicant does not put forward any argument capable of challenging the BoA’s conclusion that the signs at issue are similar overall (para. 22). As to the visual aspect, the GC stated that the element ‘I’ at the beginning of the earlier mark and the figurative elements in the mark applied for constitute differentiating elements. However, those differences are slight in comparison with the length of the common element ‘prefer’ and the important position occupied by the latter element in the signs at issue and consequently with the overall visual impression that those signs convey to consumers (para. 23). As a consequence, the marks are visually similar. As regards the phonetic aspect, the BoA correctly found that the signs are phonetically similar insofar as, the syllables and letters of the common element ‘preferi’ were identical and appeared in the same order in the two signs. Additionally, the element ‘i’ at the beginning of the earlier mark and the changes of intonation and rhythm, which may result from the pronunciation of the elements ‘ti’ and ‘sco’, are not such as to call into question the existence of a phonetic similarity. As regards the conceptual aspect, it is not possible to make a conceptual comparison because the word elements of the marks do not have any meaning for the relevant public (para. 33). To conclude, the action must be dismissed in its entirety because there is a likelihood of confusion. **LOC**

[T-745/14](#); **e@sy Credit / EasyCredit**; Judgment of 20 July 2016; *TeamBank AG Nürnberg v EUIPO*; Language of the case: EN.

IR designating the EU	Earlier mark
	

The international registration (IR) holder was granted the registration of the figurative mark represented above as an IR designating the EU for services in Classes 36 and 38. An application for invalidity was filed pursuant to Article 53(1)(a) in conjunction with Article 8(1)(b) EUTMR, based on the Bulgarian figurative mark represented above. The CD dismissed the application for invalidity, stating that there was no likelihood of confusion. The



invalidity applicant filed an appeal, which was upheld by the BoA. The IR holder filed an action before the GC relying on one plea in law, namely the infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. It held that there was a likelihood of confusion on the part of the relevant public due to the strong similarity between the signs. There is a strong visual similarity between the signs at issue. They coincide in their word elements, and the figurative elements in the earlier marks are of lower importance due to their size, position and purely decorative shape. The contested sign does not contain any free-standing figurative element other than the word element. In addition, despite the figurative nature of the signs at issue, the fonts used for the word elements of those signs are very common and do not make it possible to detect any particular difference between them (para. 28). In that regard, the GC rejects the applicant’s argument that, due to a lack of distinctiveness, the word elements must be disregarded when comparing the signs at issue (para. 29). The signs are aurally and conceptually identical (paras 33 to 36). Specific circumstances may justify a descriptive element having a dominant character (para. 41). That is the position in the present case. As regards the services in question, while the English term ‘easy credit’ may be of a descriptive nature for the Bulgarian public, the respective word elements still occupy a central position in the signs at issue and dominate the overall picture (para. 42). In addition, as regards the distinctive character of the earlier mark, as recalled by the BoA, the fact that a national mark has been registered implies that that mark has a minimum of inherent distinctiveness (para. 43). It follows that the BoA was right to conclude that there is a likelihood of confusion in the present case (para. 44). **LOC**

♦[T-204/14](#); **VICTOR / victoria et al.**; Judgment of 7 September 2016; *Victor International GmbH v EUIPO and Gregorio Ovejero Jimenez & Maria Luisa Cristina Becerra*; Language of the case: EN.

EUTM application	Earlier marks
VICTOR	victoria

The applicant sought to register the word mark represented above as an EUTM for goods in Class 25 and services in Class 35. An opposition based on a number of Spanish trade marks, including the figurative mark represented above — which was considered as the only mark of relevance for the purpose of the case — for goods in Class 25, was filed pursuant to Article 8(1)(b) EUTMR. The applicant requested the interveners to prove genuine use of the earlier mark. The OD partially upheld the opposition by recognising that the marks at issue were visually, phonetically and conceptually similar and concluding that there was a likelihood of confusion on the part of the public in the relevant territory, which was identified as Spain. However, *footwear* was the only good for which genuine use of the earlier mark was proved. The applicant filed a notice of appeal. The BoA dismissed the appeal on the same grounds as the OD. The applicant filed an action before the GC based on three pleas in law: (i) infringement of Article 15(1) EUTMR, read in conjunction with Article 42(2) and (3) EUTMR and Rule 22(3) and (4) EUTMR, (ii) infringement of Article 15(1) EUTMR, read in conjunction with Article 42(2) and (3) EUTMR and (iii) infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal in its entirety. As regards the third plea, the GC stated that the distinctive character of the figurative element added to the earlier mark, in one of the forms in which it was used on the market, is weaker than the word ‘victoria’. Consequently, its addition to the earlier mark, as registered, cannot be considered to have altered the latter’s distinctive character (para. 37). Neither, the addition of colour is capable of having altered the distinctive character of the earlier mark as registered since the form in which the earlier mark



was used on the market, the presentation and configuration of the word element ‘victoria’ remain identical to those of the earlier mark as registered and will be perceived by the relevant public as nothing more than a purely ornamental addition (paras 38 to 39). The GC confirmed the existence of a likelihood of confusion between the marks at issue since the relevant public is likely to believe the goods and services come from the same undertaking or economically-linked undertakings insofar as the goods and services concerned are partly identical and partly similar, and, moreover, the signs at issue are visually, phonetically and conceptually similar. **LOC**

[T-390/15](#); **3D / 3D’s et al.**; Judgment of 13 September 2016; *Perfetti Van Melle Benelux BV v EUIPO*; Language of the case: EN.

EUTM application	Earlier marks
	<p>1) 3D’S</p>  <p>2)</p> <p>3) 3D’s</p> 

The applicant sought to register the figurative mark represented above as an EUTM for goods in Class 30. An opposition based on the earlier trade marks represented above registered for goods in Classes 29 and 30, was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. After accepting the proof of use of the earlier trade marks for *preparations made for cereals* in Class 30, the OD partly upheld the opposition for the following goods: *chocolate; pastry; confectionery; candies; chew candies; drops; gumdrops; caramel; chewing gum; bubble gums; lollipops; licorice; jellies (confectionery); toffee; mints; sweets*. The BoA dismissed the applicant’s appeal. It endorsed the findings of OD concerning the proof of genuine use of the earlier trade marks and found that there was a likelihood of confusion between the conflicting marks for the goods at issue. The applicant filed an action before the GC relying on a single plea in law: i) a violation of Article 8(1)(b) EUTMR. The GC dismissed the appeal. The GC considered that some of the documents submitted by the parties for the first time before the GC cannot be taken into account (para. 19). The part of the complaint related to the proof of use assessment was found to be inadmissible because the applicant did not put forward any arguments in support of this claim (para. 33). Since the use of the earlier trade marks was proven in Spain and France, the relevant public was that located in those countries. Considering the nature of the goods in question it would show at most the average degree of attention (not disputed). The GC confirmed that the opponent’s goods *preparations made for cereals* in Class 30 cover both sweet and salty snacks. Therefore, it was confirmed that they are similar to a low degree to part of the contested goods, as it was found by the OD and BoA (para. 57). The signs were found to be visually, aurally and conceptually similar to the extent that they have the element ‘3D’ in common. Therefore, the overall similarity between the signs was found to be high. The GC concluded that considering the existing similarities between the signs and between the goods and taking into account the relatively low degree of attention expected from the



relevant public, there would be a likelihood of confusion between the trade marks concerned even if the earlier marks had a weak distinctive character. **LOC**

♦[T-479/15](#); **KOALA LAND / KOALA**; Judgment of 14 September 2016; *Lotte Co. Ltd. v EUIPO*; Language of the case: DE. An opposition based on the earlier German word mark **KOALA**, registered for goods in Class 30, was filed pursuant to Article 8(1)(b) EUTMR against the EUTM application **KOALA LAND**, applied for goods in Class 30. Upon request, the opponent provided proof of genuine use of its earlier mark. The OD deemed the earlier mark to be genuinely used and found a likelihood of confusion for identical and similar goods. The BoA dismissed the applicant’s appeal. It found that the evidence proved genuine use of the earlier mark. The earlier mark’s *pastries* were deemed similar to the contested marks’ *chewing gum, chocolate, caramels, ice cream, edible ices* to a certain degree. In light of a normal degree of consumer attention, an average distinctiveness of the earlier mark, the full incorporation of the earlier sign into the EUTM application and the partial identity of the signs as regards the element ‘KOALA’, the BoA found a likelihood of confusion even for goods similar to a low degree. The applicant filed an action before the GC relying on two pleas in law: i) a violation of Article 42(2) EUTMR and ii) a violation of Article 8(1)(b) EUTMR. The GC dismissed the appeal. As far as the comparison of goods is concerned the GC confirmed the BoA’s reasoning that the producers of pastries often also produce ice cream and chocolate, and that chewing gum and caramels are often used as edible decorations for pastries. Thus, the goods are complementary. In addition, the distribution channels, points of sale and the targeted public hugely overlap. Therefore, the goods at issue are at least similar to a low degree (paras 39 to 43). The GC rejected the applicant’s argument according to which the coinciding element ‘KOALA’ should be deemed weak as it merely describes the possible form of the goods (Koala bear form). The GC stressed that the form of cookies can vary and that, furthermore, the goods at stake were not registered ‘in Koala bear form’. The coinciding element ‘KOALA’ is not descriptive of the goods and, thus, enjoys a normal degree of distinctiveness (para. 48). In light of the degree of similarity between the signs and the normal degree of distinctiveness of the earlier mark the BoA could rightly assume a likelihood of confusion even for goods only similar to a low degree (paras 50 to 57). Based on the foregoing the action was dismissed. **LOC**

♦[T-358/15](#); **Roméo has a Gun by Romano Ricci / NINA RICCI et al.**; Judgment of 15 September 2016; *Arrom Conseil v EUIPO*; Language of the case: EN.

EUTM application	Earlier marks
	<ol style="list-style-type: none"> 1) RICCI 2) NINA RICCI

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 3, 25 and 35. An opposition based on the earlier word marks **RICCI** and **NINA RICCI**, registered for different goods in Class 3, was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The OD rejected the opposition. The BoA partly upheld the opponent’s appeal. It found that the OD wrongly dismissed the opposition against



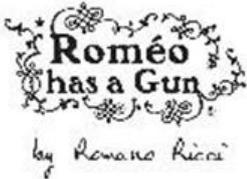
all the contested goods in Classes 3 and 25 and some of the contested services in Class 35. The applicant filed an action before the GC relying on two pleas in law: (i) infringement of Article 8(1)(b) EUTMR, (ii) infringement of Article 8(5) EUTMR. The GC dismissed the appeal. **On the likelihood of confusion:** it is uncontested that the relevant public is composed of the general public, businesses and undertakings and is reasonably well-informed and reasonably observant and circumspect or presenting a higher level of attention; that the relevant territory is that of the European Union; that the goods at issue are either identical, similar to varying degrees, or different from the goods designated by the earlier mark **RICCI** (paras 33 to 34). As for the comparison of the signs, having regard to the position and considerably greater size of the first four words in the contested mark, those words will be read together as the word element ‘roméo has a gun’. That effect is reinforced by the fact that that word element is surrounded by the figurative element, which forms a floral garland. The relevant public would seek to supplement the first word element, in as much as it gave the impression of the title of, or citation from, an artistic work. The word element ‘by romano ricci’ thus has the effect of giving further meaning to the first word element, which confers on it an independent distinctive position. Furthermore, it is usual in the field of fashion as regards personal care items and high fashion clothing to refer to the designer or source of a product, using the same format as that used by the mark applied for. In that field, the designer or source of a product, in particular, is likely to play a more important role for the relevant public than as regards other categories of goods. In view of those considerations, the word element ‘romano ricci’ is of such a nature as to be perceived as the mark of the house, whilst the element ‘roméo has a gun’ will be perceived as the sign identifying a particular line of goods. In light of the above, the marks are visually similar, since the mark applied for reproduces in its entirety the earlier mark **RICCI**. From a phonetic point of view, the marks are also similar. The word element ‘by romano ricci’, having a distinctive independent position at the heart of the contested mark, would be given a certain degree of importance by the relevant public, and they would remember it. Finally, consumers who understand English would perceive the contested mark as containing a reference to the person Romano Ricci, who is the author of the creative work ‘Roméo has a Gun’. It follows that the marks are conceptually similar for the relevant public, who also perceive the earlier mark **RICCI** as a name (paras 41 to 46). Hence, there is a likelihood of confusion for those goods that are identical or very similar; no risk of confusion for similar, similar to a low degree and different goods (paras 50 to 51). **LOC**

[T-633/15](#); **PUSH / PUNCH**; Judgment of 15 September 2016; *JT International SA v EUIPO and Corporación Habanos, SA*; Language of the case: EN. The applicant sought to register the word mark **PUSH** as an EUTM for goods within Class 34. An opposition based on the earlier word mark **PUNCH**, registered in Spain for goods in Class 34, was filed on the grounds of Article 8(1)(b) EUTMR. The OD upheld the opposition for the identical goods in Class 34. The BoA dismissed the applicant’s appeal. The applicant filed an action before the GC. Regarding the relevant public, the GC confirmed the finding of the BoA that concerning the goods in Class 34, *smoking products*, the relevant public was the Spanish-speaking general public, which had a high level of attention (paras 18 to 20). As to the substance, the GC affirmed that there was a likelihood of confusion for the relevant public in Spain. Regarding the comparison of the goods, the GC found, as it was not disputed by the parties, that the goods covered by the sign sought are identical to the opponent’s goods (para. 21). Regarding the comparison of the signs the GC held that, visually, in view of the fact that they share three letters, including the one at the beginning and because of their almost identical lengths, they were similar. Phonetically the GC concluded that the signs are similar. Conceptually the GC concluded that the non-English-speaking public will have knowledge of only one of the two terms, namely push, which precludes the conceptual comparison from



having any effect for the relevant public (para. 41). As regards the likelihood of confusion, the GC concluded that given the visual and aural similarity between the signs, there is a likelihood of confusion, even if the public was particularly attentive (para. 45). **LOC**

♦[T-359/15](#); **Roméo has a Gun by Romano Ricci / NINA RICCI et al.**; Judgment of 15 September 2016; *Arron Conseil v EUIPO*; Language of the case: EN.

EUTM application	Earlier marks
	<p>1) RICCI</p> <p>2) NINA RICCI</p>

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Class 3, 25 and 35. An opposition based on the earlier word marks **RICCI**, and **NINA RICCI**, registered for different goods in Class 25, was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The OD rejected the opposition. The BoA partly upheld the opponent’s appeal. It found that the OD wrongly dismissed the opposition against all the contested goods in Classes 3 and 25 and some of the contested services in Class 35. The applicant filed an action before the GC relying on two pleas in law: (i) infringement of Article 8(1)(b) EUTMR, (ii) infringement of Article 8(5) EUTMR. The GC dismissed the appeal. **On the likelihood of confusion:** it is uncontested that the relevant public is composed of the general public, businesses and undertakings and is reasonably well-informed and reasonably observant and circumspect or presenting a higher level of attention; that the relevant territory is that of the European Union; that the goods at issue are either identical, similar to varying degrees, or different from the goods designated by the earlier mark **RICCI** (paras 36 to 37). As for the comparison of the signs, having regard to the position and considerably greater size of the first four words in the contested mark, those words will be read together as the word element ‘roméo has a gun’. That effect is reinforced by the fact that that word element is surrounded by the figurative element, which forms a floral garland.’ The relevant public would seek to supplement the first word element, inasmuch as it gave the impression of the title of, or citation from, an artistic work. The word element ‘by romano ricci’ thus has the effect of giving further meaning to the first word element, which confers on it an independent distinctive position. Furthermore, it is usual in the field of fashion as regards personal care items and high fashion clothing to refer to the designer or source of a product, using the same format as that used by the mark applied for. In that field, the designer or source of a product, in particular, is likely to play a more important role for the relevant public than as regards other categories of goods. In view of those considerations, the word element ‘romano ricci’ is of such a nature as to be perceived as the mark of the house, whilst the element ‘roméo has a gun’ will be perceived as the sign identifying a particular line of goods. In light of the above, the marks are visually similar, since the mark applied for reproduces in its entirety the earlier mark **RICCI**. From a phonetic point of view, the marks are also similar. The word element ‘by romano ricci’, having a distinctive independent position at the heart of the contested mark, would be given a certain degree of importance by the relevant public, and they would remember it. Finally, consumers who understand English would perceive the contested mark as containing a reference to the person Romano Ricci, who is the author of the creative work ‘Roméo has a Gun’. It follows



that the marks are conceptually similar for the relevant public, who also perceive the earlier mark **RICCI** as a name (paras 44 to 49). Hence, there is a likelihood of confusion for those goods that are identical or very similar; no risk of confusion for similar, similar to a low degree and different goods (paras 53 to 55). **LOC**

♦[T-512/15](#); **SUN CALI**; Judgment of 22 September 2016; *Sun Cali Inc. v EUIPO*; Language of the case: EN.

EUTM	Earlier mark
	

The EUTM proprietor was granted the registration of the figurative mark **SUN CALI** represented above as an EUTM for goods and services in Classes 18, 25, 35 and 45. An application for invalidity was filed pursuant to Article 53(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR. The CD partly upheld the application for invalidity insofar as goods in Classes 18 and 25 were concerned. Both the invalidity applicant and the EUTM proprietor appealed the CD decision. The BoA joined the appeals and (i) dismissed the EUTM proprietor’s appeal as it considered that it was not duly represented before BoA pursuant to Article 92(2) EUTMR (R 1260/2014-5) and (ii) partly upheld the invalidity applicant’s appeal (R 1281/2014-5). It also declared the EUTM invalid for the services in Class 35. It dismissed the appeal insofar the services in Class 45 were concerned. The EUTM proprietor filed an action before the GC relying on two pleas in law: (i) alleged infringement of Article 92(3) EUTMR and (ii) alleged infringement of Article 8(1)(b). The GC dismissed the appeal. It found that the EUTM proprietor did not meet the requirements of Article 92 EUTMR and therefore its appeal before BoA was inadmissible. It also confirmed the existence of likelihood of confusion as regards the services in Class 35. **LOC (R 1281/2014-5)**: the GC considered that the applicant was a party **as of right** to the parallel proceedings R 1281/2014-5 brought by the Other Party, even if it had not been duly represented before the BoA and had not submitted observations. Pursuant to Article 65(4) EUTMR, the applicant was entitled to seek the annulment of the contested decision, which invalidated the EUTM also for services in Class 35 (para. 40). The GC confirms that *retail services for clothing* are connected to *clothing* in the sense that those goods are indispensable or at the very least important for the provision of services (paras 55 to 56). It confirms that the signs coincide partially visually and phonetically on account of the presence of the word element ‘cali’ (paras 69 and 71) and conceptually similar for the part of the public who would associate ‘cali’ with California (para. 74). In view of the similarity between the goods and services to a certain degree, the similarity between the signs and the average level of attention of the public, the GC concludes on the existence of likelihood of confusion (para. 79). **LOC**



[T-228/15](#); **BK PARTNERS / bk. et al.**; Judgment of 22 September 2016; *Grupo de originación y análisis, S.L. v EUIPO*; Language of the case: ES.

EUTM application	Earlier mark
	

The applicant sought to register the figurative mark represented above as an EUTM for services in Class 36. The BoA confirmed the decision of first instance and refused the EUTM application upon opposition based on the earlier Spanish figurative mark represented above. The services were identical and the BoA found that the relevant public in Spain has a high degree of attention for these services and is familiar with basic English terminology. The marks had in common the distinctive and dominant element ‘bk’ and the contested mark could be perceived as a variation of the earlier mark. The applicant filed an action before the GC claiming an infringement of Article 8(1)(b) EUTMR. The GC confirmed the decision of the BoA and concluded the likelihood of confusion in the meaning of Article 8(1)(b) EUTMR. **Relevant public:** the GC confirmed that it consists of the Spanish general and professional public with a high level of attention and who are familiar with basic financial terminology in English (para. 19). The GC acknowledged that in previous cases it was held that the degree of familiarity of the Spanish public with the English language is generally low (para. 23). However, in this case, both the general and the professional public are particularly attentive and have become familiar with basic financial terminology in English (para. 26). The marks have the dominant and distinctive element ‘bk’ in common (para. 40) whereas the rest of the elements are not particularly distinctive (‘PARTNERS’ is descriptive) or play a secondary role (para. 49). Therefore likelihood of confusion between the marks cannot be excluded. **LOC**

[T-449/15](#); **luvo / luvo**; Judgment of 27 September 2016; *Satkirit Holdings Ltd v EUIPO*; Language of the case: EN. The applicant sought to register the word mark **luvo** as an EUTM for goods in Class 9. An opposition based on the earlier word mark **luvo**, registered for services in Class 35 and 42, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition and rejected the EUTM application for all goods in Class 9. A notice of appeal against the decision of the OD was filed pursuant to Articles 58 to 64 EUTMR solely insofar as the OD had upheld the opposition for the following goods in Class 9: *mobile phone; tablets; portable communication devices*. It did not dispute that decision as regards *computers*. The BoA dismissed the appeal, examining the opposition only based on the earlier EU word mark with regard the services *design and development of computer hardware and software* in Class 42. It found that for the goods covered by the mark applied for and the services *design and development of computer software* the relevant public was the general public and the professionals with a level of attention between a normal and a higher than normal level. Considering the services *design and development of computer hardware* covered by the earlier mark, the relevant public was the professional public with a high level of attention. The two signs were identical. The earlier mark had a normal distinctive character for the services. The goods and services were similar and there was a likelihood of confusion. The applicant filed an action before the GC relying on the infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. It found that there was a likelihood of confusion between the signs. Firstly, the GC stated that there was not an obligation on the



opponent, in opposition proceedings, to adduce evidence on the similarity between the goods and services (para. 35). Secondly, rejecting the applicant's submission, the GC stated that the BoA identified correctly the relevant public and then it examined the nature of the goods and services, their intended purpose, method of use, their distribution channels and whether they were complementary (para. 39). Thirdly, the goods and services were complementary but this was not enough to conclude they were similar (para. 46). Fourthly, the distribution channels were the same for the marks (para. 50). As a consequence, the contested goods and the earlier services were similar (para. 51). Regarding the comparison of the signs, the marks were identical (para. 52). In the light of all the above arguments, there was a likelihood of confusion between the signs (para. 55). **LOC**

[T-450/15](#); **luvoworld / luvu**; Judgment of 27 September 2016; *Satkirit Holdings Ltd v EUIPO*; Language of the case: EN. The applicant sought to register the word mark **luvoworld** as an EUTM for goods and services in Classes 9 and 38. An opposition based on the earlier word mark **luvo**, registered for services in Classes 35 and 42, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition and rejected the trade mark application for all goods and services in Class 9 and 38. A notice of appeal against the decision of the OD was filed pursuant to Articles 58 to 64 EUTMR. The BoA dismissed the appeal, examining the opposition only based on the earlier EU word mark as regards the services *design and development of computer hardware and software* in Class 42. It found that for the goods covered by the mark applied for and the services *design and development of computer software* the relevant public was the general public and the professionals with a level of attention between a normal and a higher than normal level. Considering the services *design and development of computer hardware* covered by the earlier mark, the relevant public was the professional public with a high level of attention. The goods and services covered by the mark applied for and the services covered by the earlier mark were similar. The earlier mark had a normal distinctive character for the services. Regarding the comparison of the signs the signs were highly similar. As a consequence, the BoA found a likelihood of confusion. The applicant filed an action before the GC relying on the infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. It found that there was a likelihood of confusion between the signs. Firstly, the GC stated that there was not an obligation on the opponent, in opposition proceedings, to adduce evidence on the similarity between the goods and services (para. 33). Secondly, rejecting the applicant's submission, the GC stated that the BoA identified correctly the relevant public and then it examined the nature of the goods and services, their intended purpose, method of use, their distribution channels and whether they were complementary (para. 37). Thirdly, the goods and services were complementary but this was not enough to conclude they were similar (para. 44). Fourthly, the distribution channels were the same for the marks (para. 48). As a consequence, the contested goods and the earlier services were similar (para. 49). Regarding the comparison of the signs, the marks were highly similar (para. 50). In the light of all the above arguments, there was a likelihood of confusion between the signs (para. 53). **LOC**



[T-539/15](#); **SILICIUM ORGANIQUE G5 LLR / G5 -Silicium Organique ...et al.**; Judgment of 28 September 2016; *LLR-G5 Ltd v EUIPO and GLYCAN FINANCE CORP. Ltd*; Language of the case: EN.

EUTM application	Earlier marks
	<p>Silicium Organique G5- Glycan 5-Si-Glycan-5-Si-G5</p>

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 1, 3, 5 and 32. An opposition based on two earlier international marks and one earlier French mark registered for the same classes was filed pursuant to Article 8(1)(b) EUTMR. The OD refused registration of the mark applied for because there was a likelihood of confusion between that mark and the first earlier international mark covering some goods in Classes 3, 5 and 32. However, the OD dismissed the opposition insofar as there was no likelihood of confusion (NO LOC) between the mark applied for and the first earlier international mark covering all the goods of the mark applied for in Class 1 and *cleaning preparations; perfumery; all containing organic silicon* goods in Class 3. The BoA rejected the applicant's request for annulment of the decision of the OD. However, the BoA partly upheld the opponent's appeal refusing registration of the mark applied for for all the goods covered of the mark applied for in Class 1, and *cleaning preparations; all containing organic silicon* goods in Class 3, with the exception of *perfumery; all containing organic silicon*. The applicant filed an action before the GC. The GC dismissed the appeal. It found that the goods covered by the mark applied for falling within Classes 1, 5 and 32 and the goods covered by the first earlier international mark were identical or similar and were they all acknowledged by the applicant (paras 31 to 41). The GC noticed that the applicant did not have an interest in disputing the exception of *perfumery* goods under Class 3. Indeed, the goods covered by the mark applied for in Class 3 were either identical or similar to an average degree to goods falling within Classes 3 and 5 of the opponent's first international mark (para. 43). The GC stated that when examining the likelihood of confusion under Article 8(1)(b) EUTMR, it's not appropriate to examine which elements of the mark applied for confer a sufficiently distinctive character enabling the mark to be registered, but whether there is a likelihood of confusion between that mark and an earlier mark. Therefore, since the goods at issue were either identical or have an average degree of similarity (para. 64) and the signs at issue, assessed overall, have an average degree of visual similarity, a high degree of phonetic similarity, and were conceptually identical (paras 66 to 78), the GC concluded that there was a likelihood of confusion between the mark applied for and the first earlier international mark for the goods at issue (para. 88). The GC dismissed the second plea in law alleging breach of the BoA's obligation to state reasons as partly ineffective and partly inadmissible (paras 91 to 92). **LOC**



[T-803/14](#); **B'lue / BLU DE SAN MIGUEL**; Judgment of 28 September 2016; *Compagnie Gervais Danone v EUIPO*; Language of the case: EN.

EUTM application	Earlier mark
	<p>BLU DE SAN MIGUEL</p>

The applicant sought to register the figurative mark represented above as an EUTM for goods in Class 32. An opposition based on the earlier word mark **BLU DE SAN MIGUEL** registered for goods and services in Classes 32, 38 and 43, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition for all goods for which protection was sought. The BoA dismissed the appeal and confirmed the rejection of EUTM application in its entirety. The applicant filed an action before the GC relying on a single plea in law: i) a violation of Article 8(1)(b) EUTMR. The GC dismissed the appeal. The GC noted that the element 'blu', although, taken in isolation, has a weak distinctive character as regards *non-alcoholic beverages* (para. 29), is at least as important as 'de san miguel' or even dominant if 'de san miguel' is perceived as indicating the place from which the goods come or the producer of the goods designated by the element 'blu' (para. 34). The position of 'blu' in the contested sign and the non-dominance of the figurative part of the contested mark make the signs visually similar to a low degree (paras 42 to 49). The phonetic similarity is higher than the visual similarity and very high for consumers who will abbreviate the contested mark to 'blu' (paras 50 to 53). The relatively banal conceptual content of the element 'san miguel' for the Spanish-speaking public makes the conceptual identity of the elements 'b'lue and blu' more striking (paras 54 to 59). In the light of the wide range of conditions under which the goods covered by the marks may be sold, there is no factor that makes it possible to attribute a preponderant weight to either the visual or phonetic aspect in the global assessment of the likelihood of confusion (para. 67). In view of the identity of the goods and taking into account in particular the part of the relevant public who will understand all the elements of the earlier mark and might even abbreviate it to the use of the word 'blu' only, likelihood of confusion cannot be discarded (paras 71 and 72). **LOC**

♦[T-574/15](#); **KOZMETIKA AFRODITA / EXOTIC AFRODITA MYSTIC MUSK OIL et al.**; Judgment of 28 September 2016; *Kozmetika Afrodita d. o. o. v EUIPO*; Language of the case: SL.

EUTM application	Earlier mark
	<p>EXOTIC AFRODITA MYSTIC MUSK OIL et al.</p>

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 3, 42 and 44. An opposition based on the earlier Spanish word mark, inter alia, represented above and registered for goods in Class 3, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition in part. The BoA dismissed the appeal. The applicant filed an action before the GC relying on two pleas in law:



(i) a violation of Article 8(1)(b) EUTMR and (ii) a violation of Rule 50(2)(h) EUTMIR. The GC dismissed the appeal. **Likelihood of confusion:** the GC confirmed that a possible allusion of the word ‘AFRODITA’ (perceived as a Greek goddess of love and beauty by the relevant Spanish public) to beauty products/services does not make the mark descriptive. It is also not a generic term used in the area of beauty care (paras 36 and 37). Contrary to the applicant’s view, ‘AFRODITA’ is the dominant and the most distinctive element in the contested sign since ‘KOZMETIKA’ is descriptive and will be understood by the relevant public, whereas the figurative element is a banal representation of ‘AFRODITA’ and merely reinforces its concept (para. 38). ‘AFRODITA’ is also the most distinctive and remembered element of the earlier mark since the much shorter albeit also distinctive word ‘MUSK’ occupies a secondary position (the one before last). The remaining elements ‘EXOTIC’, ‘MYSTIC’ and ‘OIL’ will be understood and are descriptive of the goods and services (para. 41). Due to the common and most distinctive element AFRODITA, the signs are visually, phonetically and conceptually similar to a normal degree (paras 47 to 51). In view of the identity and similarity between the goods and services and similarity between the signs, which share the most distinctive element ‘AFRODITA’, a likelihood of confusion cannot be excluded (para. 57). **LOC**

♦[T-575/15](#); **AFRODITA COSMETICS / EXOTIC AFRODITA MYSTIC MUSK OIL et al.**; Judgment of 28 September 2016; *Kozmetika Afrodita d. o. o. v EUIPO*; Language of the case: SL.

EUTM application	Earlier mark
	EXOTIC AFRODITA MYSTIC MUSK OIL et al

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 3, 42 and 44. An opposition based on the earlier Spanish word mark, inter alia, represented above and registered for goods in Class 3, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition in part. The BoA dismissed the appeal. The applicant filed an action before the GC relying on two pleas in law: (i) a violation of Article 8(1)(b) EUTMR and (ii) a violation of Rule 50(2)(h) EUTMIR. The GC dismissed the appeal. **Likelihood of confusion:** the GC confirmed that a possible allusion of the word ‘AFRODITA’ (perceived as a Greek goddess of love and beauty by the relevant Spanish public) to beauty products/services does not make the mark descriptive. It is also not a generic term used in the area of beauty care (paras 38 and 39). Contrary to the applicant’s view, ‘AFRODITA’ is the dominant and the most distinctive element in the contested sign since ‘COSMETICS’ is descriptive and will be understood by the relevant public, whereas the figurative element is a banal representation of ‘AFRODITA’ and merely reinforces its concept (para. 40). ‘AFRODITA’ is also the most distinctive and remembered element of the earlier mark since the much shorter albeit also distinctive word MUSK occupies a secondary position (the one before last). The remaining elements ‘EXOTIC’, ‘MYSTIC’ and ‘OIL’ will be understood and are descriptive of the goods and services (para. 43). Due to the common and most distinctive element ‘AFRODITA’, the signs are visually, phonetically and conceptually similar to a normal degree (paras 50 to 57). In view of the identity and similarity between the goods and services and similarity between the signs, which share the most distinctive element ‘AFRODITA’, a likelihood of confusion cannot be excluded (para. 59). **LOC**



♦[T-716/15](#); **DEVICE OF A HORSE BIT / DEVICE OF A HORSE BIT et al.**; Judgment of 9 November 2016; *D. Juan Gallardo Blanco v EUIPO*; Language of the case: ES.

EUTM application	Earlier marks
	

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 31, 41 and 44. An opposition based, inter alia, on the earlier figurative marks represented above, registered for goods in Class 31 and services in Class 41 respectively, was filed pursuant to Articles 8(1)(b) and 8(5) EUTMR against part of the goods and services. The OD upheld the opposition in its entirety insofar as it found there was a likelihood of confusion. The BoA dismissed the applicant’s appeal. It found, considering the similarity between the signs and the identity and similarity between the goods and services, that there was a likelihood of confusion for the relevant public, and in particular for the general public. The applicant filed an action before the GC relying on three pleas in law: (i) infringement of Article 4 EUTMR, (ii) infringement of Article 8(1)(b) EUTMR, and (iii) infringement of Article 42(2) EUTMR. The GC dismissed the appeal. It rejected the first plea as inadmissible pursuant to Article 76(d) RPGC. It also confirmed the finding of a likelihood of confusion. The GC confirms that part of the goods in Class 31 are identical, the remaining contested goods in Class 31 and services in Classes 41 and 44 being similar (paras 69 to 72). Concerning the earlier trade mark, the signs are highly similar because they have a dominant element in common, the letter ‘C’ being a secondary element (para. 81). The alleged coexistence of several similar trade marks has not been sufficiently accredited since there is no proof of their use on the market and the mentioned signs, despite of their similarity, cannot be considered valid precedents due to the presence of additional distinctive elements (paras 84 to 87). At least the professional public will recognise a meaning in the element that resembles an ‘H’ (para. 89). Concerning the earlier Spanish mark, the signs are visually, phonetically and conceptually similar since two of the figurative elements in the earlier mark are similar to the sole figurative element that forms the contested mark (paras 92 to 97). The GC confirmed the distinctiveness of the earlier mark and concluded that there is a likelihood of confusion, despite the applicant’s argument regarding the coexistence of several similar marks, which was dismissed (paras 100 to 107). The reference to previous decisions does not have an effect on this case (paras 110 to 112). There is no need to enter in the assessment of the remaining claims (para. 114). **LOC**



♦ [T-549/14](#); **Castello / Castelló et al.**; Judgment of 4 October 2016; *Lidl Stiftung & Co. KG v EUIPO*; Language of the case: EN.

EUTM application	Earlier marks
Castello	<p style="text-align: center;">1) </p> <p style="text-align: center;">2) </p>

The applicant sought to register the word mark **Castello** as an EUTM for goods and services in Classes 29, 30 and 31. An opposition based on, inter alia, the earlier figurative marks represented above (EUTM and Spanish), registered for goods and services in Classes 30, 35 and 39, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition in part with respect to certain goods in Classes 29 and 30 and rejected it for the remainder. Both parties filed an appeal. The BoA of the Office dismissed the appeal brought by the applicant and partially upheld the action brought by the opponent. The BoA found the evidence of use of the earlier Spanish mark sufficient (the earlier trade mark was not subject to proof of use) and the marks in question very similar. The BoA found identity/similarity between all the contested goods in Classes 29 and 30 and concluded that there was a likelihood of confusion for those goods. Goods in Class 31 were considered dissimilar. The applicant filed an action before the GC relying on two pleas in law: (i) infringement of Article 42(2) and (3) EUTMR and of Rule 22(3) and (4) EUTMIR and (ii) infringement of Article 8(1)(b) EUTMR. The GC partly upheld the appeal. It confirmed the BoA's findings regarding proof of use (POU) and regarding the likelihood of confusion for all goods in Classes 29 and 30. However, it found that the contested *frozen fruit and vegetables* in Class 29 were not similar to any of the goods covered by the earlier trade marks and to this extent it upheld the action. **Second plea (LOC):** comparison of goods: *baking ingredients of all kinds, candied fruits, glacier cherries, raisins, sultanas, candied orange peel and candied lemon peel* on the one hand and *industrial confectionery* on the other hand are complementary; there is a similarity between these products. The former are ingredients of the latter; although this is not in itself sufficient to conclude that there is as similarity, it is necessary to take into account that the consumer himself uses the ingredients to make confectionery good or patisserie or baking goods — on that account such goods must be considered interchangeable and in competition (para. 74); thus the average consumer will associate the ingredients with the opponent's final goods, even though the latter are industrial goods (para. 72). Another factor for similarity is that both sets of goods are processed products (para. 73). The same reasoning was applied to a rather broad array of contested goods in Class 29, which can be ingredients of patisserie and bakery goods (paras 77, 79 and 86). Nevertheless, there is no similarity between the contested *frozen fruit and vegetables* and any of the opponent's goods. They are sold in specific departments, they are generally not processed and they are closer to fresh or raw goods (para. 82). As regards the contested goods in Class 30, they are all similar to the goods of the earlier marks (paras 87 to 96). The GC confirmed the BoA's assessment of the similarity between the signs and other factors for a likelihood of confusion and concluded that there was a likelihood of confusion for the identical and similar goods. The second plea is partially upheld, but only for *frozen fruit and vegetables* (paras 97 to 115). **LOC**



[T-350/15](#); **P / P**; Judgment of 11 October 2016; *Perry Ellis International Group Holdings Ltd v EUIPO*; Language of the case: EN.

EUTM application	Earlier mark
	

The applicant sought to register the figurative mark represented above as an EUTM for goods in Class 25. An opposition based on, inter alia, the earlier figurative mark represented above, registered for goods in Class 25, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition. The BoA dismissed the applicant’s appeal. It found that the signs at issue, likely to be perceived as the letter ‘p’, had average visual similarity, were phonetically identical if they were perceived as the letter ‘p’ and that there was no conceptual similarity. The applicant filed an action before the GC relying on one plea in law: Article 8(1)(b) EUTMR. The GC dismissed the appeal. It was not disputed that the goods at issue were identical or highly similar. The GC confirmed the BoA’s assessment that the most distinctive and dominant element of the mark applied for is the element likely to be perceived as the letter ‘p’ (para. 39). The GC confirmed that the BoA was correct in finding the signs visually similar to an average degree (para. 46), phonetically either identical or not comparable (paras 47 to 49) and that there was no conceptual similarity since, even if they were perceived as the letter ‘p’, a letter does not have semantic content (para. 50). Furthermore, the BoA’s conclusion that, irrespective of whether the earlier mark is perceived as the letter ‘p’ or not, that mark has an average degree of inherent distinctive character was confirmed (paras 58 to 62). There is likelihood of confusion. **LOC**

[T-693/15](#); **CLOVER CANYON / CANYON**; Judgment of 20 October 2016; *Clover Canyon, Inc. v EUIPO*; Language of the case: EN. The applicant filed an application for an international registration designating the EU for the word mark **CLOVER CANYON** for the goods in Class 25. An opposition based on the earlier German word mark **CANYON** registered for goods in Class 25 was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition and refused the application for all the goods applied for. The BoA dismissed the applicant’s appeal. It endorsed the findings of the OD concerning the identity between the goods and the similarity between marks and found that there was a likelihood of confusion between them. The applicant filed an action before the GC relying on a single plea in law: i) violation of Article 8(1)(b) EUTMR. The GC dismissed the appeal. The GC endorsed the OD’s findings that the goods of the conflicting trade marks are identical (para. 22) and that they target the general public in Germany who would show an average level of attention (para. 19). The signs were found to be visually, aurally and conceptually similar to an average degree since they have the element ‘CANYON’ in common (para. 41). Moreover, the GC considered that the earlier mark had an average degree of distinctiveness because the applicant did not prove that the relevant public would perceive it as descriptive of the nature of the goods concerned (para. 50). Therefore, the GC concluded that considering the identity between the goods, the existing similarities between the signs and the average degree of distinctiveness of the earlier mark, there is a likelihood of confusion between the trade marks concerned (para. 57). **LOC**



[T-579/15](#); **fortune / FORTUNE-HOTELS**; Judgment of 8 November 2016; *For Tune sp. z o.o. v EUIPO — Gastwerk Hotel Hamburg GmbH & Co. KG*; Language of the case: EN

EUTM application	Earlier mark
	<p>FORTUNE-HOTELS</p>

The applicant Staywell Hospitality Group Pty Ltd sought to register the figurative mark shown above as an EUTM for, inter alia, services in Classes 35 and 41. An opposition based on the earlier German word mark **FORTUNE-HOTELS**, was filed against the EUTM application on the grounds of Article 8(1)(b) EUTMR. The OD upheld the opposition for part of the services designated in the application, some of which were considered identical and some similar to the services covered by the earlier mark. The applicant filed an appeal. The BoA dismissed the appeal. The applicant filed an action before the GC. The GC confirmed that the relevant public are the German professional consumers for *business services* in Class 35, and both the general public and professionals as far as *entertainment services* in Class 41 are concerned. Those findings are not contested by the parties. The GC dismissed the applicant's argument that the BoA erred since, in its assessment, it took into consideration only the average consumer with an average level of attention. The GC noted at that regard that the BoA correctly found that, for the services not bought on a daily basis, the level of attention of the average consumer was, in any event, 'at least' average (paras 20 to 24). The finding that the services at issue were in part identical and in part similar was not disputed by the parties and was upheld by the GC (para. 25). In relation to the comparison of the signs, the GC confirmed the BoA's finding that the word 'fortune' represents the dominant element of the two signs. As the French and English word 'fortune' has entered the German language, it is highly unlikely that the relevant German public will perceive the mark applied for as referring to the play on words relating to 'for tune', even from a visual point of view (paras 37 to 38). The GC endorsed the BoA's assessment that the marks at issue have an average degree of visual and phonetic similarity (paras 37 to 42, paras 48 to 51). It was also confirmed that a certain degree of conceptual similarity between the marks resulting from the dominant common element 'fortune', cannot be ruled out, even though, the relevant public does not associate the mark applied for, composed solely of the element 'fortune', with the hotel sector (para. 58). In the light of the foregoing, the GC found that, having regard to the visual, phonetic and conceptual similarities between the marks at issue, those marks overall showed a normal degree of similarity, resulting from the presence of the word 'fortune' in the mark applied for, which was incorporated in full in the earlier mark and represented in the mark applied for, in a somewhat fanciful style, the dominant element of the earlier mark. The GC therefore confirmed that there was a likelihood of confusion between the marks at issue (para. 64). **LOC**



♦[C-43/15 P](#); **compressor technology / KOMPRESSOR et al.**; Judgment of 8 November 2016; *BSH Bosch und Siemens Hausgeräte GmbH v EUIPO*; Language of the case: DE.

EUTM application	Earlier mark
	<p>KOMPRESSOR et al.</p>

The EUTM applicant sought to register the mark represented above for goods and in Classes 7, 9 and 11. An opposition based, among others, on the earlier mark represented above, registered for similar and identical goods in Classes 7, 9 and 11, was filed on the grounds of Article 8(1)(b) EUTMR. The OD upheld the opposition for the goods found to be similar and identical. The EUTM applicant appealed the decision; the owner of the earlier trade marks, in its observations, stated that the EUTM application should have been refused for even more goods. The BoA, which qualified these observations as ‘ancillary appeal’ (Article 8(3) RPBoA), dismissed the applicant’s appeal and rejected the EUTM application for more goods than the OD. The applicant filed an action before the GC. The appeal — based solely on Article 8(1)(b) EUTMR — was dismissed by the GC. It emphasised that a certain degree of distinctiveness has to be attributed to national marks and that the distinctiveness of the earlier mark(s) is just one element of the assessment of likelihood of confusion. In light of the decorative figurative element and the secondary position of the element ‘technology’ within the EUTM application the BoA was right in its assessment that the differences in the first letters ‘C/K’ are not sufficient to compensate for the similarity between the word elements **KOMPRESSOR/compressor**. The EUTM applicant lodged an application before the CJ, relying on two pleas in law: first, the GC violated Article 60 EUTMR by giving its approval, without the slightest examination, to the BoA’s qualification of the observations of the owner of the earlier marks as ‘ancillary appeal’ and by giving its approval to the BoA’s rejection of the EUTM application for even more goods than OD. Second, the GC violated Article 8(1)(b) EUTMR by relying on an erroneous concept of likelihood of confusion, with the effect that, if two trade marks coincide as regard a purely descriptive element, it is deemed sufficient to give rise to such a likelihood of confusion, thereby leading to a monopolisation of a purely descriptive indication. The CJ dismissed the appeal. As regards the second plea in law, based on Article 8(1)(b) EUTMR, the CJ reiterated its long-standing case-law, according to which the distinctive character of an earlier mark is only one factor among others involved in the assessment of a likelihood of confusion. A likelihood of confusion cannot be precluded only because the distinctive character of the earlier mark is weak (paras 61 to 62). As regards the applicant’s argument that the case-law is wrong given that it allegedly leads to the monopolisation of a purely descriptive indication, it must be stated that it is not Article 8(1)(b) EUTMR, but Article 7(1)(b) and (c) and Article 51 EUTMR, which are intended to avoid such monopolisation. Furthermore, as regards earlier national marks a certain degree of distinctiveness has to be acknowledged (paras 65 to 68). Finally, it cannot be ruled out in advance and in any event that, where a trade mark application reproduces a weakly distinctive earlier national mark, consumers may suppose that those differences reflect a variation in the nature of the products or stem from marketing considerations and do not denote goods from different traders, and that a likelihood of confusion may therefore exist (para. 70). Accordingly, the CJ dismissed the second plea in law as unfounded. **LOC**



♦[T-67/15](#); **POLO CLUB SAINT-TROPEZ HARAS DE GASSIN / BEVERLY HILLS POLO CLUB et al.**; Judgment of 10 November 2016; *Polo Club, established in Gassin (France) v EUIPO*; Language of the case: EN.

EUTM application	Earlier mark
	

The applicant sought to register the figurative mark represented above as an EUTM for goods and services, inter alia, in Classes 3 and 41. An opposition based on, inter alia, the earlier EU figurative mark represented above, registered for goods and services, inter alia, in Classes 3 and 41, was filed pursuant to Article 8(1)(b) EUTMR. The opponent opposed all goods and services and claimed enhanced distinctiveness for the earlier marks. The OD dismissed the opposition in its entirety finding that there was no likelihood of confusion. The OD refused to take into account additional evidence of enhanced distinctiveness filed by the opponent in reply to the request for proof of use of the earlier marks because it was filed outside the time limit to substantiate the opposition. The OD then found insufficient evidence to demonstrate that the earlier marks had enhanced distinctive character as a result of use. In the absence of sufficient admissible evidence to establish enhanced distinctive character, the signs at issue were insufficiently similar to find that there was a likelihood of confusion, even if the goods and services concerned were identical. The BoA annulled the decision of the OD. It allowed the opposition insofar as it is directed against goods and services in Classes 3 and 41 and remitted the case to the OD as to the remainder. The BoA found that the OD could not rely on the mere failure to observe the time limit as a ground for refusing to take the additional evidence on enhanced distinctiveness into account and noted that it would be artificial and over formalistic to divide the whole body of evidence into the evidence that is admissible only for the purpose of showing genuine use of the earlier mark but is then ignored for the purpose of assessing the enhanced distinctive character of the earlier mark. The BoA accepted the additional evidence. The opponent filed an action before the GC relying on two pleas in law alleging (i) an infringement of Article 8(1)(b) EUTMR and (ii) infringement of the procedural rules governing opposition proceedings relating to the BoA's acceptance of belated evidence relating to enhanced distinctiveness of the earlier mark. The GC dismissed the appeal. It found that there was a likelihood of confusion for the goods and services in Classes 3 and 41 under Article 8(1)(b) EUTMR. As to the comparison of goods and services, the GC endorsed most of the BoA's conclusions albeit it found that *arranging and conducting of conferences, colloquiums, workshops, congresses, seminars, competitions (education) and organisation of exhibitions for educational purposes* covered by the mark applied for were identical and not merely similar to *cultural activities, education and providing of training* covered by the earlier mark. The GC emphasised that the image of a polo player and the words 'polo club' have enhanced inherent distinctiveness as regards the goods in Class 3 and normal inherent distinctiveness as regards the services in Class 41, which confirmed the essence of the BoA's assessment (para. 54). It also confirmed the BoA's assessment that the signs, each considered as a whole, are visually and phonetically similar to a low degree and conceptually similar at least to an average degree (para. 78). In assessing likelihood of confusion, the GC stated that a corollary of the fact that the goods



and services are identical is that the scope of any differences between the signs in question is reduced (para. 87) and found a likelihood of confusion as regards the goods and services, which were considered identical. As regards the services that are not identical, but similar, that factor, combined with the signs' similarity — above all their conceptual similarity — and with the normal distinctive character of the earlier marks, is sufficient to confirm that there is a likelihood of confusion (para. 88). **LOC**

♦[T-769/15](#); **Dolokorn / DOLOPUR**; Judgment of 24 November 2016; *SeNaPro GmbH v EUIPO*; Language of the case: DE. The applicant sought to register the word mark **Dolokorn** as an EUTM for goods in Class 1, among which *manures; fertilisers for soil and Inorganic fertilisers*. An opposition based on the earlier trade mark **DOLOPUR**, registered for goods and services in Classes 1, 3, 5, 19 and 40 was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition insofar as the signs were considered to be similar and the goods identical. The BoA dismissed the applicant's appeal. It did not take into account the applicant's argument, according to which the prefix 'DOLO' would make express reference to 'dolomite' rock, on the ground that it had been put forward for the first time right before the BoA. The applicant filed an action before the GC relying on a single plea in law: infringement of Article 75 and Article 76(1) and (2) EUTMR. The GC dismissed the appeal. The GC found that the applicant was substantially claiming an infringement of Article 8(1)(b) EUTMR (para. 14). In the contested decision two different hypotheses were taken into account as regards the effective meaning of the signs' common prefix 'DOLO' (para. 19). First, the BoA stated that if the public interpreted 'DOLO' as a fancy word, the conceptual similarity between the signs would be excluded but the importance of visual and phonetic similarity would be enhanced (para. 20). As a second hypothesis, the BoA set out that if the prefix 'DOLO' was considered as referring to the 'dolomite' rock, it would be necessary to take into account that the second part of the signs under comparison, namely 'KORN' and 'PUR' present a weak distinctive character, because the German speaking public will understand these two suffixes as referring to the nature and texture of the products (para. 21). As a consequence the first part of the signs in conflict would catch the attention of the public just as much as the second part of them (para. 21). In light of the two hypotheses taken into account by the BoA, the GC concluded that rightly the signs in conflict have been considered similar, regardless of how the term 'DOLO' will be understood by the public. On the other side, the GC stated that the BoA wrongly ignored the new argument concerning the meaning of the term 'DOLO', which the applicant put forward for the first time within the appeal (para. 25). Nevertheless, the GC concluded that even if the BoA had accepted and taken into account that argument, its final decision on the existence of the likelihood of confusion would have not been different (para. 26). **LOC**

♦[T-250/15](#); **CLAN / CLAN MACGREGOR**; Judgment of 24 November 2016; *Speciality Drinks Ltd v EUIPO*; Language of the case: EN. The EUTM applicant sought to register the word mark **CLAN** for goods in Class 33. An opposition based, inter alia, on the earlier word mark **CLAN MACGREGOR**, registered for goods in Class 33 was filed on the grounds of Article 8(1)(b) EUTMR. The OD dismissed the opposition: genuine use of the aforesaid earlier mark was proven for 'Scotch whisky' and there was a likelihood of confusion between the marks at issue. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC raising one plea in law, namely breach of Article 8(1)(b) EUTMR, claiming firstly that the contested decision should be annulled and, secondly, that the opposition should be rejected. The GC dismissed the appeal. Insofar the applicant seeks the rejection of the opposition and reversal of the order for costs made by the BoA, this aims to obtain a decision by the GC to replace the decision that the BoA should have taken. The BoA may



annul the decision of the Office adjudicating body, which took the contested decision, and exercise any power within the competence of that body, in the present case to rule on the opposition and reject it, drawing, if it does so, the consequences of that annulment as regards the costs. Consequently, that measure is amongst those that the GC may make in the exercise of its power to alter decisions under Article 65(3) EUTMR (para. 17). **Application for annulment:** the relevant public is made up of the general public (para. 20), which would show an average degree of attention (paras 23 to 31). The goods are identical. The signs have an average degree of conceptual similarity (paras 34 to 50). Having regard to the element ‘macgregor’ within the earlier mark, which the BoA itself refused to classify as ‘secondary’ or ‘marginal’ and which contains more letters and syllables than the element ‘clan’, the signs at issue only have a low degree of visual and phonetic similarity (para. 63). The identity of the goods is sufficient to overcome the differences found between the signs at issue, and justifies the conclusion of a likelihood of confusion. The applicant’s ‘coexistence in the register’ argument is insufficient to affect the outcome (para. 69 et seq.). The earlier marks invoked by the applicant are all composite marks and, consequently, their peaceful coexistence, even if proven, could not exclude, the likelihood of confusion between a mark composed of the element ‘clan’ only, and a composite mark. The application for annulment must be dismissed. **LOC**

[T-545/15](#); **PRESSO / PRESSO**; Judgment of 29 November 2016; *Pi-Design AG v EUIPO*; Language of the case: DE. The appellant — owner of the international registration (IR) **PRESSO** in Classes 7, 11 and 21 — sought to extend the protection of its mark to the territory of the European Union. The owner of the earlier Swedish trade mark **PRESSO** for coffee products in Class 30 filed an opposition based on Article 8(1)(b) EUTMR. The OD upheld the opposition. The BoA dismissed the appellant’s appeal. It found the goods similar to a certain degree and the signs identical and, thus, a likelihood of confusion between the signs at issue. The appellant filed an action before the GC. The GC confirmed the BoA’s finding that the relevant public consists of both highly attentive professionals (restaurant/coffeehouse owners) as well as the general public with an average degree of attentiveness (para. 22). As regards the comparison of goods, they share the same purpose, namely the preparation and adequate serving of coffee-based drinks. The goods are also complementary as coffee machines are important in the preparation of coffee drinks (paras 30 to 33). As can be seen from publicly accessible sources (such as the internet hits submitted by the Office before the GC) it is a well-known fact that the producers of coffee also sell and distribute coffee machines, coffee filters and coffee mills. This finding is not altered by the appellant’s unsubstantiated claim that those goods can be (and in the relevant territory Sweden actually are) also marketed by different companies. In light of the same purpose and their complementary character, the BoA was right to find a certain degree of similarity between the goods at issue (paras 35 to 38). Even if it was assumed that the earlier mark only has a weakly distinctive character, it needs to be recalled that the distinctiveness of the earlier mark is just one factor in the overall assessment of a likelihood of confusion (para. 47). The appellant’s claim of coexistence cannot be proven by merely submitting register excerpts of identical or similar registrations without further information about their actual market presence and concrete information on why a likelihood of confusion between these coexisting marks and the younger mark does not exist (paras 48 to 50). In light of the similarity between goods and the identity of the signs, there is a likelihood of confusion even if the earlier mark possessed only a low degree of distinctiveness. Based on the foregoing, the appeal was dismissed. **LOC**



[T-458/15](#); **e-miglia / MILLE MIGLIA**; Judgment of 30 November 2016; *Rebel Media Ltd, Automobile Club di Brescia v EUIPO Rebel Media Ltd*; Language of the case: EN.

EUTM application	Earlier mark
	MILLE MIGLIA

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 12, 14, 18, 25, 35 and 41. An opposition based, among others, on the earlier word mark represented above, registered for goods and services in Classes 12, 14, 18, 35 and 41, was filed pursuant to Article 8(1)(b) EUTMR. The OD partly upheld the opposition in relation to all the goods and services, which were found to be identical or similar. The applicant (intervener before the GC) filed a notice of appeal with the Office. The BoA partly annulled the OD’s decision. It confirmed that there was a likelihood of confusion but only as regards the goods and services deemed identical. It found that the signs were visually and phonetically similar to a low degree only and that the conceptual difference, limited to the part ‘e-’ of the contested sign and relating to electronics, had little impact on the comparison of the signs. The applicant filed an action for the annulment of the BoA’s decision and the intervener a cross-claim before the GC relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed both the application and the cross-claim and confirmed the finding of likelihood of confusion. The GC confirmed that the relevant territory/public was the general and the professional public in the European Union, and those findings were not disputed by the parties. The GC also confirmed the finding of identity and similarity between the goods and services. As regards the comparison of the signs, the GC found that the marks were visually and phonetically similar to a low degree (paras 71 to 81). Conceptually, the GC endorsed the finding of the BoA that the word ‘miglia’ has no meaning for the non-Italian-speaking public. The GC found that, contrary to the contested decision, there was no conceptual difference between the marks for that part of the public. That finding, however, had no impact on the outcome of the case since the existence of such a conceptual difference was irrelevant to the assessment of the contested decision (para. 94). The GC confirmed the BoA’s finding that the earlier marks must be considered to have an average degree of distinctive character as regards the non-Italian-speaking part of the relevant public (para. 99). In the light of the foregoing, the GC confirmed the contested decision and dismissed both the appeal and the cross-appeal (paras 99 to 105). **LOC**

♦[T-561/15](#); **UNIVERSIDAD INTERNACIONAL DE LA RIOJA UNIR / UNIRIOJA et al.**; Judgment of 1 December 2016; *Universidad Internacional de La Rioja, S.A. v EUIPO*; Language of the case: ES.

EUTM application	Earlier mark
	UNIRIOJA

The EUTM applicant (applicant before the GC) sought to register the figurative mark represented above for goods and services in Classes 16 and 41. The opponent (intervener



before the GC) based its opposition on Article 8(1)(b) EUTMR using, inter alia, the earlier trade mark shown above, registered for goods and services in Classes 16 and 41. The OD upheld the opposition for all the contested goods and services. The BoA confirmed the first instance. The applicant appealed to the GC alleging infringement of Article 8(1)(b) EUTMR. The applicant made some statements concerning the relevant public, namely that it would be only the Spanish consumers, since the parties are both universities from La Rioja (Spain) being highly attentive because of the kind of the goods and services. Those observations have been produced for the first time before the GC. As to these statements, the GC rebutted the Office’s conclusion of inadmissibility. The examination of the relevant public is an aspect that falls within the obligation of the BoA to make an overall review of the case. The BoA necessarily based, or should have based, its decision on this issue and therefore such matter may therefore be debated as to their merits before the GC (paras 26 to 34). The goods and services are identical. This conclusion by the BoA has not been challenged by the applicant (para. 25). The signs show a certain visual similarity because the first four letters are identical and in the same order. The remaining different elements are not able to counteract this common visual impression (para. 58). The same is applicable in the aural comparison, where again the first four letters are responsible for a certain similarity in the pronunciation of the marks (para. 64). In the conceptual comparison, the GC confirms the BoA as to its finding that in the mark applied for the dominant part ‘UNIR’ is explained by the additional word elements in blue ‘UNIVERSIDAD INTERNACIONAL DE LA RIOJA’. This refers not only to the Spanish language but also to the majority of the official languages within the EU (para. 68). As to the earlier sign **UNIRIOJA** in many languages of the EU the element ‘UNI’ refers to university and ‘RIOJA’ to the corresponding region in Spain (para. 69). Consequently, for those who do not understand the Spanish verb ‘unir’ (=put together), the marks are conceptually almost identical (para. 72). In the overall assessment the GC concluded that the BoA was right in finding that in the case in question there is a likelihood of confusion. The goods and services are identical and the signs are similar. Therefore, even for a highly attentive public there is a likelihood of confusion. The alleged low degree of distinctiveness of the earlier mark does not harm, since the distinctive character of the earlier mark is — according to settled case-law — only one factor for the overall assessment on likelihood of confusion (paras 74 to 84). As to the claimed coexistence of the marks, the GC states that such coexistence may reduce the likelihood of confusion (para. 87). However in the case in question the mere fact that the applicant is the owner of similar marks does not show any real coexistence in the market. Additionally, the marks are not identical. Consequently, the GC dismissed this claim (paras 85 to 89). **LOC**

♦[T-735/15](#); **SHOP ART / art**; Judgment of 6 December 2016; *The Art Company B & S, SA v EUIPO*; Language of the case: EN.

EUTM application	Earlier mark
	

The applicant sought to register the figurative mark represented above as an EUTM for goods in Classes 18 and 25. An opposition based on, inter alia, the earlier figurative mark represented above, registered for goods and services in Classes 18, 25 and 35, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition for all of the contested goods. The BoA upheld the applicant’s appeal. It found that, in view of the importance of the visual appearance of the marks at issue, and of the facts that the relevant public had a normal degree of attentiveness and that the distinctive and dominant element of the earlier



mark lay in the high degree of stylisation of the letters, there was no likelihood of confusion, even if the goods in question were identical. The opponent filed an action before the GC relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC upheld the appeal. It found that the BoA had erred in concluding that there was no likelihood of confusion on the part of the relevant public. **As regards likelihood of confusion:** the goods are identical and the relevant public is the public at large in the EU with a normal degree of distinctiveness (not disputed) (paras 22 to 24). The attention of the relevant public will be retained in essence by the words ‘shop’ and ‘art’ and, to a certain extent, by the star. The different figurative elements consisting of the font and colour and the word element ‘shop’ are not capable of offsetting the average visual similarity between the signs resulting from the figurative element, which represents a star, and by the word element ‘art’ (paras 27 to 39). Despite its position, the identical syllable ‘art’ in the marks at issue is such as to attract and retain the attention of the relevant consumer when pronounced on account of the marks at issue being short signs. The signs at issue present an average degree of phonetic similarity in view of the similar elements in them (para. 40) and are conceptually similar to an average degree (paras 41 to 43). In the context of the global assessment of likelihood of confusion, the GC pointed out that even though the word element ‘art’ has a weak distinctive character as regards the goods concerned, the element ‘art’ remains the most distinctive in the contested mark (paras 47 to 49). There is a likelihood of confusion on the part of the relevant public (paras 50 to 52). **LOC**

[T-58/16](#); **APAX / APAX et al.**; Judgment of 13 December 2016; *Apax Partners LLP v EUIPO*; Language of the case: EN. The applicant sought to register the word mark **APAX** for goods and services in Classes 16, 35 and 36. An opposition based on the existence of the international registration of the word mark **APAX** was filed on the grounds of Article 8(1)(a) and (b) EUTMR. The OD partly upheld the opposition for some of the goods and services. The applicant filed a notice of appeal pursuant to Articles 58 to 64 EUTMR against the decision of the OD. The BoA dismissed the appeal. The applicant filed an action before the GC alleging that the BoA made an error of assessment in applying Article 8(1)(a) and (b) EUTMR. The GC dismissed the action. The GC dismissed the plea on the BoA’s error of assessment regarding the similarity between the contested goods and services. As to the relevant public and territory, the GC noted that the BoA was entitled to consider Spain as the relevant territory in order to assess the likelihood of confusion. Furthermore, as the BoA stated, consumers display an average level of attention for the goods in Class 16, aimed at the public at large, and a high level of attention for services in Classes 35 and 36, aimed at a professional public (para. 27). As regards the comparison of the signs, the GC found, as did the BoA, that the marks are identical because both are constituted entirely of the word sign **APAX** (para. 29). As to the comparison of the goods and services, the GC confirmed that they are in part identical and in part similar (paras 31, 40, 46, 50 and 56). For all the above, the GC concluded that the BoA was right in finding that there was a likelihood of confusion between the marks (para. 61). **LOC**



♦ [T-745/15](#); **YO!** / **YO**; Judgment of 14 December 2016; *Scorpio Poland v EUIPO*; Language of the case: PL.

EUTM application	Earlier mark
	<p data-bbox="1034 524 1118 577">YO</p>

The applicant sought to register the figurative sign represented above as an EUTM for goods and services in Class 25. An opposition based on the earlier German word mark **YO**, registered for goods and services in Class 25, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition in its entirety. The opponent filed an appeal. The BoA upheld the opponent’s appeal. It found that both signs would be perceived by a large part of the German-speaking public as consisting of the verbal element ‘YO’. The signs were therefore aurally identical and visually similar to a low or average degree. Since none of the signs had a meaning, the signs were neither similar nor identical conceptually. The goods were identical. Considering the above, the BoA found that there was a likelihood of confusion between the signs. The applicant filed an action before the GC relying on a single plea in law: an infringement of Article 8(1)(b) EUTMR. The application sought, inter alia, to have the decision of the BoA altered and EUTM application registered. The GC found the latter claim to be inadmissible. As to the remaining claim, the GC dismissed the appeal. It found that there was a likelihood of confusion between the signs at issue. **Likelihood of confusion:** as to the comparison of goods, these were found to be identical, but the applicant argued that they belonged to different industries because the opponent’s company was in the foodstuff business. The GC observed that the comparison of goods should be made on the basis of the characteristics relevant to their mutual relationship. It referred to the criteria relevant for the comparison of goods such as the nature, purpose, method of use, whether they are in competition or are complementary, and observed that considering the above, the finding that the goods were identical was correct, since they all belonged to Class 25. The GC further observed that the fact that the goods were used for promotion or merchandising did not change their main characteristics relevant for the comparison of goods; therefore the commercial purpose did not affect that relationship between the goods under comparison (paras 26 to 27 and 31). Moreover the applicant argued that the goods of the opponent were in fact used in merchandising and advertising thus suggesting a lack of genuine use. To this the GC commented that since the earlier sign was registered for less than 5 years, it was not subject to proof of use. The relevant goods were, therefore, the ones for which the trade mark was registered (paras 28 to 30). As to the comparison of signs, the GC referred to the relevant case-law on comparison of signs, on visual, aural and conceptual level and observed that a word mark can be compared with a figurative sign on all these levels. The GC confirmed the BoA’s assessment that the earlier mark was likely to be perceived as the letters ‘YO’ by large part of the relevant public. Even though this element was stylised it was still clearly legible, and the fact that it was followed by an exclamation mark only emphasised it. The GC found the figurative elements not to be negligible, but denied that they should be perceived as dominant within the earlier mark. Consequently the GC confirmed that the visual similarity was between low and average. As to the aural similarity, the GC confirmed the BoA’s conclusion of identity. The GC found that the presence of an exclamation mark, while having some impact on intonation, will not affect the finding of aural identity between



the signs. As to the conceptual similarity, since neither of the signs had a meaning, it was irrelevant. As regards the likelihood of confusion, the GC confirmed that, in view of the identity of the goods, the visual similarity (to a degree between low and average) and aural identity between the signs, there is a likelihood of confusion between the marks at issue. **LOC**

[T-212/15](#); **Gourmet / Gourmet**; Judgment of 15 December 2016; *Aldi GmbH & Co. KG v EUIPO*; Language of the case: DE.

EUTM application	Earlier mark
	

The applicant sought to register to register the figurative trade mark **Gourmet** represented above as an EUTM for goods in Classes 29, 30, 31, 32 and 33. An opposition based on the earlier Spanish figurative mark '**Gourmet**' represented above, registered for goods in Classes 29, 30, 31, 32 and 33 was filed pursuant to Article 8(1)(b) EUTMR. The OD partly upheld the opposition insofar as the goods in Class 31 were concerned and have no relation with food and beverages. The BoA partly upheld the opponent's appeal. It found that there is a likelihood of confusion in conjunction with food or drink related goods in Classes 29, 30, 32 and 33 and for the identical and similar goods in Class 31. The GC dismissed the appeal. The goods at issue are in part identical, in part similar and in part dissimilar (not disputed). The marks are visually and phonetically similar even for a specialised public in the EU. The GC emphasised that the earlier mark is a national Spanish trade mark. Therefore, contrary to the applicant's opinion, the earlier mark does not lack distinctive character (paras 36 to 38). The marks coincide in the verbal element 'gourmet'. The additional, figurative elements are only of subordinate importance and if signs consist both of figurative and verbal elements the consumer will rather refer to the verbal element. While the signs differ only in their typography, typeface, the form and the colour of the designs that constitute the visual background, those are only minor differences that cannot lead to the conclusion that the signs are not similar (para. 57). Therefore, the GC confirmed the result of the BoA that the signs are visually similar to a higher than average degree (paras 56 to 58). Further, the GC confirmed the BoA's finding that the signs are aurally identical and conceptually highly similar. The GC confirmed the reasoning of the BoA that the distinctiveness of the earlier mark is only one of the factors when assessing likelihood of confusion. The BoA did not only take into account the fact that both marks contain the element 'gourmet' but also the visual, aural and conceptual similarity, the average level of attention and the similarity and identity of the goods. The GC confirmed that there is a likelihood of confusion. **LOC**



[T-227/15](#); **Redpur / redwell INFRAROT HEIZUNGEN et al.**; Judgment of 15 December 2016; *Redpur GmbH v EUIPO*; Language of the case: DE.

EUTM application	Earlier mark
Redpur	

The applicant sought to register the word mark **Redpur** as an EUTM for *unit heaters and infrared heating equipment* in Class 11. An opposition based, inter alia, on the earlier figurative mark represented below, registered for goods in Class 11, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition insofar as the goods were deemed to be identical and the signs similar. The BoA dismissed the applicant’s appeal. It found that there was a certain degree of visual similarity between the signs, that they were phonetically highly similar and, with respect to the English-speaking part of the relevant public, conceptually similar as well. Taking into account the identity of the goods and the fact that the earlier mark has normal distinctiveness, the BoA concluded that there was a likelihood of confusion. The applicant filed an action before the GC relying on a single plea in law: an infringement of Article 8(1)(b) EUTMR. The GC dismissed the action. The GC confirmed the BoA’s finding that the relevant public was composed of professionals and average consumers and that its level of attention varied from average to high, since among the goods in Class 11 there exist inexpensive goods whose purchase does not require specialist advice (paras 19 to 23). The GC emphasised that the dominant element of the earlier mark was the word ‘Redpur’ and that the rest of its elements were negligible (paras 29 to 33). The dominant element of the earlier mark shares three initial letters (r, e, d) with the contested sign, the signs are thus visually similar to a certain degree (paras 37 to 38). They also have the same stress, rhythm and number of syllables, which makes the signs aurally highly similar (paras 43 to 44). The GC held that the public that has at least a basic understanding of English will perceive the common syllable ‘red’ as referring to the colour red, whereas the terms ‘well’ and ‘pur’ are laudatory in character; the marks are therefore conceptually similar for part of the relevant public (paras 49 to 50). The applicant’s claim that the term ‘red’ lacked distinctiveness with respect to the goods at issue because it was directly linked to them was rejected as unproven. Even in cases involving an earlier mark of weak distinctive character, the existence of likelihood of confusion cannot be excluded (paras 57 to 60). Taking into account the identity of the goods (not disputed), the similarity between the contested sign and the dominant element of the earlier sign, the negligible character of the figurative and other verbal elements of the earlier sign and its normal distinctiveness, the GC confirmed that there was a likelihood of confusion (para. 61). **LOC**

2. **No likelihood of confusion (NO LOC)**

♦[T-802/14](#); **Lenah.C / LEMA**; Judgment of 21 January 2016; *Laboratorios Ern, S.A. v OHIM*; Language of the case: EN. The applicant sought to register the word mark **Lenah.C** as an EUTM for goods within Classes 3 and 5. An opposition based on the earlier word mark **LEMA**, registered in Spain for goods in Class 5 was filed on the grounds of Article 8(1)(b) EUTMR. The OD rejected the opposition. The BoA dismissed the opponent’s appeal. The



opponent filed an action before the GC. As to the substance, the GC affirmed that there was no likelihood of confusion in Spain. The relevant public was made up of professionals and average consumers with a relatively high level of attentiveness towards pharmaceutical products, as well as average consumers with a normal level of attentiveness for cleaning and beauty products (para. 21). Regarding the comparison of the goods, the GC found, as the BoA did, that the goods covered by the sign sought are identical to the opponent's goods (para. 23). As regards the distinctive and dominant elements of the signs, the applicant's argument that the comparison of the signs should be restricted to the words 'lenah' and 'lema' was not upheld and the GC found that the BoA was correct to compare the contested sign **Lenah.C** as a whole with the earlier sign **LEMA**. Visually, the GC concluded that the signs have a low degree of similarity. Phonetically the GC concluded that the signs have an average level of similarity. Conceptually, the GC concluded that they are not similar as the GC found that the term 'lema' in Spanish, which means 'motto' or 'slogan', is a commonly used word that is found in various Spanish language dictionaries and has a clear meaning and synonyms reflecting a more sustained level of language. According to the case-law, there can be no conceptual similarity between a mark which conveys no clear meaning in any of the official languages (Lenah.C) and another mark of which the verbal element generally carries actual meaning for the relevant public. As regards the likelihood of confusion, the GC has concluded that given the low level of visual similarity, the average phonetic similarity, and the conceptual differences due to the clear meaning of the earlier mark and its average distinctiveness, no likelihood of confusion exists, even for identical goods. **NO LOC**

[T-781/14](#); **TVR ENGINEERING / TVR et al.**; Judgment of 28 January 2016; *TVR Automotive Ltd v OHIM*; Language of the case: EN.

EUTM application	Earlier marks
	<ol style="list-style-type: none"> <li data-bbox="858 1279 967 1312">1. TVR <li data-bbox="858 1408 884 1442">2. 

The applicant sought to register the figurative mark represented above as an EUTM for goods in Classes 12, 18 and 25. An opposition based on the word mark **TVR** for goods in Class 12 and the figurative mark represented above registered in Classes 9, 12, 16 and 25, was filed pursuant to Article 8(1)(b) EUTMR. The OD partly upheld the opposition and rejected the EUTM application for some goods in Class 12. The opponent appealed the decision in relation to the goods in Classes 18 and 25. The BoA dismissed the appeal for goods in Classes 18 and 25. The opponent filed an action before the GC relying on one plea in law, namely the infringement of Article 8(1)(b) EUTMR. The GC found that the signs are different. The figurative elements of the signs are very distinctive. The presence in the EUTM application of the word 'engineering' in smaller but legible letters is not insignificant. The existence of visual similarity depends on the comparison of the signs as perceived by the relevant public, not as they were described at the time of filing the application (para. 33). Even if the sequence of letters TVR could be recognised in each of the signs, their figurative elements are so different that there is no visual similarity. There is a low degree of phonetic similarity for the relevant public, which recognises in each of the signs a sequence of letters that coincides at least partially. There is no conceptual similarity. The signs are not similar.



Even for the section of the relevant public for which the signs display a low degree of phonetic similarity, the very significant visual differences cancel out such similarity. The action was dismissed. **NO LOC**

[T-640/13](#); **CRETEO / STOCRETE et al.**; Judgment of 28 January 2016; *Sto SE & Co. KGaA v OHIM*; Language of the case: DE. The applicant sought to register word mark **CRETEO** as an EUTM for goods and services within Classes 1, 2, 17 and 19. An opposition based on the earlier word marks **StoCretec** and **STOCRETE**, registered in Germany for goods in Classes 1, 2, 17 and 19 was filed on the grounds of Article 8(1)(b) EUTMR. The OD dismissed the opposition. The BoA confirmed this decision. The opponent filed an action before the GC. The GC rejected the only claim of infringement of Article 8(1)(b) EUTMR. It confirmed the finding that the EUTM applied for is dissimilar to the earlier mark **StoCretec** and only similar to a low degree to the earlier mark **STOCRETE**. The beginning of the earlier marks ‘STO’, which is not present in the EUTM applied for will not be neglected by the relevant public (para. 33 et seq.). The use of the capital letter ‘C’ in the earlier mark **StoCretec** cannot lead to the conclusion that the public will separate the beginning ‘Sto’ from the part ‘Cretec’, since the mark is protected as a word mark, thus just the sequence of letters (paras 36 to 39). The argument of the applicant, according to which the first part ‘Sto’ of the earlier mark corresponds to its company name and according to the German case-law would not be taken into account when assessing the likelihood of confusion, is not convincing. The BoA was not obliged to examine the German law, if the applicant did not prove it (para. 46). The European trade mark law is an autonomous system and the German law not applicable to the comparison of the signs (paras 47 and 53). **NO LOC**

♦ [T-683/13](#); **EUROMARKER / EURIMARK**; Judgment of 2 February 2016; *Brammer GmbH v OHIM*; Language of the case: DE. The applicant sought to register the word mark **EUROMARKER** as an EUTM for inter alia services in Class 38 *providing access to database servers(...)* and Class 42 *creation and administration of databases(...)*. The opponent filed an opposition on the grounds of Article 8(1)(b) EUTMR on the basis of the earlier trade mark word mark **EURIMARK**, registered for services in Classes 35, 41, 42 (inter alia: *design and development of computer hardware and software(...)*) and 45. The OD upheld the opposition. The EUTM applicant filed an appeal against the decision. The BoA dismissed the applicant’s appeal. It held that the relevant public are professionals in the entire Union. The services in question are either remotely similar or similar. The signs are similar from a visual, phonetic and conceptual point of view. Although the earlier right is of weak distinctive character this does not exclude, in the present case, a likelihood of confusion. The applicant filed an action before the GC. As regards Class 38, however, the GC ruled that the BoA erred in finding a remote similarity between the services *providing access to database servers(...)* and *design and development of computer hardware and software(...)*. According to the GC, the BoA was right to conclude that these services are of a different type, do not serve the same application, its use is different, are not addressed to the same public, are not interchangeable, are neither in competition nor complement each other, but was wrong to find, despite the indicated differences, a remote similarity between these services. Moreover, the GC confirmed the findings of the BoA that there is no similarity between the remaining services of the earlier mark (in particular *scientific or legal services*) and the services of Class 38 of the EUTM application. **NO LOC**



[T-485/14](#); **Bon Appétit! / Bon Apetî et al.**; Judgment of 2 February 2016; *Bon Net OOD v OHIM*; Language of the case: DE.

EUTM application	Earlier mark
	

The applicant sought to register the figurative mark, shown above, as an EUTM for various foodstuff products in Class 29. The opponent based an opposition on Article 8(1)(b) EUTMR, directed against said goods, relying inter alia on the earlier figurative Bulgarian mark represented above, registered for goods partially contained in the EUTM application’s specification. The OD rejected the opposition because it found that there is no likelihood of confusion between the EUTM application and earlier marks. The BoA dismissed the appeal. The opponent filed an action before the GC relying on one plea in law, namely the infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. It found that the relevant public consists of average consumers in Bulgaria, paying an average attention (para. 26). For the conflicting goods, the BoA was entitled to assume their identity for the purpose of the following assessment. The services *accommodation for guests* of one of the earlier marks are dissimilar to the *foodstuff products* in Class 29 since they neither substitute nor complement one another (paras 29 to 30). The BoA did not commit an error in holding that the conflicting signs’ word elements have at most a low degree of distinctiveness. The expression ‘Bon Appétit’ is commonly known amongst Bulgarian consumers, meaning ‘enjoy your meal’. The earlier mark’s word element has the same meaning. Both evoke the comforting feeling that precedes a good meal. Therefore, these word elements will immediately be perceived as descriptive (paras 43 to 44). The applicant cannot challenge this finding of the BoA, which did not held the signs to lack registrability. In the assessment, it must be distinguished between the earlier mark’s distinctiveness and the distinctive character of the sign’s element when determining its overall impression (paras 48 to 49). The word elements are not dominant. The figurative elements, in particular form, size and colour clearly contribute towards the signs’ overall impression and hence the word elements will not distract the public’s attention (paras 52 to 55). Visually, the signs are different (paras 56 to 69). Aurally, they are pronounced identically (para. 61). The conceptual similarity is based on the signs’ word elements (para. 63). In the overall assessment, the signs are visually clearly different. The signs are aurally and conceptually similar but the visual perception is more important for the goods in question since they are selected in self-service stores based on their display (paras 67 and 71 to 72). Given the descriptive meaning of ‘Bon Appétit’ and ‘Bon Apetî’ and the sufficiently striking figurative elements, the BoA was right to conclude that the word element cannot have a decisive bearing in the overall assessment (para. 73). Therefore, there is no likelihood of confusion. **NO LOC**



♦ [T-247/14](#); **STICK MiniMINI Fratelli Beretta 1812 GLI ORIGINALI / MINI WINI**; Judgment of 4 February 2016; *Meica Ammerländische Fleischwarenfabrik Fritz Meinen GmbH & Co. KG v OHIM*; Language of the case: EN.

EUTM application	Earlier mark
	<p style="text-align: center;">MINI WINI</p>

The EUTM applicant sought to register the figurative mark above as an EUTM, inter alia, for goods in Classes 29 and 43. An opposition in respect of these goods and services, based on the earlier word EUTM above registered for goods in Class 29, was filed on the grounds of Article 8(1)(b) EUTMR. The OD upheld the opposition for the goods in Class 29, allowing the EUTM application with respect to the services in Class 43. The EUTM applicant filed an appeal seeking the annulment of the decision of the OD insofar as it upheld the opposition for goods in Class 29. The opponent filed a response by which it sought, inter alia, an alteration of the decision of the OD for the services in Class 43. The BoA declared the opponent’s submissions seeking an alteration of the contested decision to be inadmissible and annulled the decision of the OD, rejecting the opposition in its entirety. The opponent filed an application before the GC for the annulment of the decision of the BoA. Since the goods concerned are everyday consumer goods, the relevant public is the average consumer of the EU (para. 39). The goods concerned are identical (para. 43). The word ‘mini’ refers to the small size of the goods and consequently is less capable of identifying the goods. The repetition of the word ‘mini’ in the element ‘minimini’ of the mark applied for does not have the effect of making that element more distinctive. It is true that the words ‘fratelli’, ‘1812’ and ‘gli originali’ of the mark applied for attract the relevant public’s attention less because of their small size, and the element ‘stick’ will become part of the overall impression for the English-speaking public, which will understand it as descriptive of the shape of the goods. However, the public’s attention will be held by the element ‘Beretta’, which has no meaning in the relevant languages. Accordingly, all the elements comprising the mark applied for, and in particular the element ‘Beretta’, contribute to forming the image of that mark that the relevant public keeps in mind (paras 49 to 57). Taking into account the findings as to the distinctiveness of the elements of the marks, the signs in question display only a low degree of visual similarity and a low degree of phonetic similarity. Conceptually, the signs only share the word ‘mini’; therefore they display a low degree of conceptual similarity (paras 58 to 64). Although the evidence submitted showed use of the earlier mark in Germany for sausages, it did not permit a finding that the level of distinctiveness of that mark was greater than average. Hence, since the sign MINI WINI viewed as a whole has no meaning, the inherent distinctive character of the earlier mark is average (paras 69 to 74). Taking account all these factors, there is no likelihood of confusion (para. 80). The BoA’s decision must therefore be annulled inasmuch as it rejected the submissions made by the opponent seeking a decision altering the decision of the OD for the services in Class 43. The remainder of the action should be dismissed (paras 81 to 82). **NO LOC**

♦ [T-135/14](#); **kicktipp / KICKERS et al.**; Judgment of 5 February 2016; *Kicktipp GmbH v OHIM*; Language of the case: EN. The EUTM applicant sought to register the word mark



kicktipp as an EUTM for, inter alia, goods in Class 25. An opposition based, inter alia, on the earlier Italian word mark **KICKERS**, registered for goods in Class 25, was filed, inter alia, on the grounds of Article 8(1)(b) EUTMR. The OD upheld the opposition. The BoA dismissed the appeal. The EUTM applicant filed an application before the GC for the annulment of the decision of the BoA relying on two pleas in law: (i) the infringement of Rule 19(1) and (2) EUTMIR; and (ii) infringement of Article 8(1)(b) EUTMIR. Concerning the second plea in law, the relevant public is the general public in Italy; its level of attention is average (paras 99 to 100). The goods covered by the contested mark are identical to the earlier mark's goods (para. 101). Even assuming that there is no likelihood of confusion for the part of the public in Italy that has a thorough knowledge of English, it is not possible to reject the opposition on the basis of that fact alone, as it is not necessary to find that there is a likelihood of confusion for the whole of the relevant public. In any event, the words 'kick', 'kickers' and 'tipp' cannot be regarded as basic English vocabulary and bear no resemblance to their Italian counterparts. For these reasons, the words 'kick', 'kickers' and 'tipp' are not weakly distinctive and neither of the elements of the contested mark will have a more distinctive character than the other (paras 103 to 129). As for visual comparison, the mere presence at the end of the contested mark of a double consonant ('pp'), which is perceived as unusual at the end of a word by the relevant public, does not mean that the last syllable dominates the visual perception of that mark, especially in the present case, where the letter 'k' at the beginning of the mark is also unusual in Italian (para. 139), with the result that it would also attract the public's attention. The case-law according to which the consumer generally pays greater attention to the beginning of a mark (which is relevant for the present case) concerns the beginning of a mark and not necessarily the first syllable thereof: the fact that, in the present case, the first four letters of the marks at issue are identical, which gives rise to a certain degree of visual similarity, is not called in question by the fact that, in the earlier trade mark, the first four letters may belong to different syllables. As a result, and in view of the fact that the last part of the marks is different, the visual similarity is low. As for phonetic comparison, the mere fact that the stress is not placed on the second syllable of the earlier mark does not mean that that syllable will be murmured. However, in the mark applied for both of the elements are stressed, whereas the earlier mark only consists of one element. In Italian, the pronunciation of the word 'kicktipp' is identical to the pronunciation of the word 'kicktip'. In any event, it is unclear how the sound 'p' at the end of a word might be pronounced 'for longer'. However, the initial sound 'kik' and the number of syllables is the same in both marks. For these reasons, and as result of the difference in the rhythm of pronunciation of the marks at issue, their phonetic similarity must be described as very low, (paras 159 to 179). It is not possible to carry out a conceptual comparison (para. 180). As for the global assessment of likelihood of confusion, the GC applied the general rule according to which the visual aspect plays a greater role for clothes, as the choice of an item of clothing is generally made visually (para. 190). The mark applied for will not be perceived as a mere configuration of the earlier trade mark: the mere fact that the marks at issue share their first four letters is not sufficient, as the way in which those marks are structured is very different (para. 201). There is no likelihood of confusion between the marks (para. 202). The BoA's decision is annulled (para. 205). **NO LOC**



♦[T-402/14](#); **AQUALOGY / AQUALIA et al.**; Judgment of 25 February 2016; *FCC Aqualia S.A. v OHIM*; Language of the case: ES.

EUTM application	Earlier marks
	<p>1. AQUALIA</p>  <p>2.</p>

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 1, 4-7, 9, 11, 12, 17, 19, 27, 32, 33, 35-45. An opposition based on the earlier word mark **AQUALIA** registered for goods and services in Classes 7, 9, 32, 35-37, 39, 40 and 42, and the earlier figurative mark represented above registered for services in Class 39, was filed pursuant to Article 8(1)(b) EUTMR. Both the OD and the BoA dismissed the opposition. The relevant public of the services is composed by professionals with a very high level of attention. Taking into account the differences between the conflicting signs, there can be no likelihood of confusion. The opponent filed an action before the GC relying on two pleas in law: (i) infringement of Article 8(1)(b) EUTMR; (ii) and infringement of Article 8(5) EUTMR. The GC confirms that the relevant public is composed of the professionals who select the company that will provide the relevant services. End users of water distribution services do not intervene at the moment where the choice between the marks is made by institutional users (para. 32). The contested decision erred in considering the services of *water distribution* and *transport* to be similar. They are identical, since the former are included in the latter (paras 47 to 48). The figurative elements of the signs are totally different. They are basic but not insignificant, so they must be taken into account in the overall impression of the signs (para. 55). There is a low degree of visual similarity. Even if the BoA had taken into account the low degree of distinctiveness of 'aqua' when examining the visual similarity, the assessment of the visual similarity between the signs is not vitiated (para. 63). There is a low degree of phonetic and conceptual similarity, even though the different suffixes allow the specialised public to gather a different conceptual content (paras 71 to 73). The GC confirms that the lack of distinctive character of the term AQUA for the relevant services was taken into account by the BoA at the time of the global assessment of likelihood of confusion. The specialised relevant public will not pay much attention to the descriptive element AQUA, the only common element of the conflicting signs. The differences between the signs are sufficient to exclude likelihood of confusion, even for identical services and admitting the enhanced distinctiveness of the earlier marks (para. 86).

NO LOC



♦ [T-61/15](#); **1e1 / UNOE et al.**; Judgment of 1 March 2016; *1&1 Internet AG v OHIM*; Language of the case: EN.

EUTM application	Earlier marks
1e1	<ol style="list-style-type: none"> 1.  2. UNO E

The applicant sought to register the word mark **1e1** as an EUTM for a range of services in Classes 35, 38, 42 and 45. An opposition based on the Spanish marks shown above was filed pursuant to Article 8(1)(b) EUTMR. The OD rejected the opposition. The applicant filed a notice of appeal with the Office. The BoA upheld the appeal and annulled the OD’s decision. The applicant appealed to the GC, alleging the infringement of Article 8(1)(b) EUTMR. The GC upheld the appeal. The GC endorsed the finding of the BoA that the relevant public is a professional public for the services in Classes 35, 42 and 45 and also the public in general for the services in Class 38. The GC found, however, that also the non-professional public will have a relatively high level of attention when purchasing those services (paras 22 to 27).

Comparison of the services: regarding the comparison of the services, the GC found that *creation of domain names; maintenance of domains; domain name registration services and buying and selling of domains; allocating of domains; rental and leasing of domains* covered by the contested mark in Class 45 are neither identical nor similar to *legal services* covered by the earlier word mark in the same class. They have a different nature, purpose or use. Nor has it been demonstrated that they are competing or complementary. Lastly, contrary to the BoA’s statements, there is nothing showing that those services have the same providers, distribution channels or end users (paras 35 to 41). The GC upheld the finding of the BoA that *market analysis; organisational consultancy with regard to creating multimedia products, with regard to internet and communications technology, and with regard to audio-visual productions; display services for merchandising; compilation and systemisation of information into computer databases*, covered by the contested mark in Class 35 are included in the general category of *help in the exploitation or management of commercial or industrial firms* covered by the earlier figurative mark in Class 35 and the contested *compilation and systemisation of information into computer databases* are included in the category of *office work*. Therefore they must be considered identical. As regards the other services covered by the contested mark in Class 35, the BoA correctly found that they are also identical (paras 43 to 45). The GC confirmed also the finding of the contested decision that the services covered by the marks at issue in Classes 38 and 42 must be considered to be identical or highly similar.

Comparison of the signs: as a preliminary remark, since the services covered by the earlier word mark were found to be dissimilar to the contested services, the comparison of the conflicting signs was limited to the comparison of the contested mark with the earlier figurative mark. The GC found that the relevant public will break down the word component of the earlier figurative mark into two parts, the first comprising the term ‘uno’, perceived as a reference to the number ‘1’ in Spanish, and the second made up of the letter ‘e’. Contrary to what the applicant claimed, the letter ‘e’ will not be perceived as referring to electronics or the internet. Although ‘e’ is a well-known abbreviation for ‘electric’ or ‘electronic’, as the Office has stated, it will generally be perceived as such only when placed before another word component, usually with a hyphen between the ‘e’ and the other component, not after, as in the present case. It follows from the foregoing that, contrary to the applicant’s assertions and as argued by the Office, taken as a



whole, the earlier figurative mark has an average degree of distinctiveness (paras 61 and 62). The GC confirmed that **visually** the signs will be perceived as completely different. **phonetically**, the GC found that the fact that the component ‘uno’ is repeated in the mark sought may potentially accentuate the phonetic differences between it and the earlier figurative mark, particularly given the length and tone that repetition confers on the mark sought. In those circumstances, the conflicting signs may be phonetically similar, but only to an average degree (paras 61 to 63). **Conceptually**, the conflicting signs may be viewed as conveying a reference to the number ‘one’. However, the mark sought could as a whole be perceived as referring to the concept of connection, junction or joining of units or individuals. In the present case, the component ‘e’ in that mark could be perceived as constituting a linking component between the components ‘1’, which surround it and refer to the unit. The positioning of the letter ‘e’, which resembles an ampersand, in the centre, combined with the fact that the component ‘one’ is written as a number and the component ‘e’ as a letter, reinforce that impression. Thus, the mark sought could be perceived as a play on words resembling the expression ‘1 + 1’ or ‘1&1’. Such a concept, which in essence relates to the joining of a unit, is absent from the earlier figurative mark. The combination of the components ‘uno’ and ‘e’ does not seem to have its own conceptual meaning and, at the most, can be construed as also containing a reference to the number ‘1’. In those circumstances, it must be found, on the basis of an overall impression, that the conceptual similarity between the conflicting signs is weak. In the global assessment, the GC found that, taking into account the relevant public’s heightened level of attention, the average degree of distinctiveness of the earlier figurative mark and the lack of visual similarity between the conflicting signs, which will offset their average degree of phonetic similarity and weak conceptual similarity, there is no likelihood of confusion between the conflicting signs within the meaning of Article 8(1) EUTMR (paras 71 to 72). **NO LOC**

[T-454/15](#); **Dynamic Life / DYNAMIN**; Judgment of 3 May 2016; *Laboratorios Ern, SA v EUIPO*; Language of the case: EN.

EUTM application	Earlier mark
	<p style="text-align: center;">DYNAMIN</p>

The applicant sought to register the figurative mark represented above as an EUTM for goods in Classes 5 and 32. An opposition based on the earlier word mark **DYNAMIN** registered for goods in Classes 1 and 5, was filed pursuant to Article 8(1)(b) EUTMR. The OD rejected the opposition in its entirety. The BoA dismissed the appeal. The applicant filed an action before the GC relying on a single plea in law: i) a violation of Article 8(1)(b) EUTMR. The GC dismissed the appeal. The GC confirmed the dissimilarity between the *tobacco-free cigarettes for medical purposes* in Class 5 of the contested mark and the *dietetic foods adapted for medical use in any shape or form* covered by the earlier mark because of different purposes and ways of use, different nature and because they are not in competition and are not interchangeable. The fact that both types of goods relate to health does not make them similar (para. 23). The contested goods in Class 32 are primarily for quenching thirst and are thus different from *dietetic foods adapted for medical use in any shape or form* (para. 25). None of the signs contains elements that are more dominant than others (para. 31). The signs are visually and phonetically similar to a low degree (paras 34 and 36 to 40) and conceptually not similar since the Spanish public is not likely to associate the term ‘dynamin’ with the Spanish word ‘dinámico’ (paras 41 to 44). The main



differentiating elements ‘life’ and the figurative element are not negligible and even the differences between ‘dynamic’ and ‘dynamin’ are likely to be noticed due to the heightened level of awareness of the relevant public for goods for medical use. Notwithstanding the identical character of certain goods, there is no likelihood of confusion within the meaning of Article 8(1)(b) EUTMR. **NO LOC**

[T-99/15](#); **NOOSFER / SFERA et al.**; Judgment of 26 May 2016; *Sfera Joven, S.A. v EUIPO*; Language of the case: ES.

EUTM application	Earlier marks
NOOSFERA	<p style="text-align: center;">SFERA</p>  

The intervener sought to register the word mark **NOOSFERA** as an EUTM for goods and services in Class 25, 32 and 42. An opposition based on the earlier Spanish word mark **SFERA** registered for goods in Class 25, the earlier Spanish word mark **SFERA** registered for services in Class 41, the earlier Spanish figurative mark **SFERA COLOURS** registered for products in Class 32 and the earlier Spanish figurative mark **SFERA CENTROS** registered for products in Class 32, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition. The BoA dismissed the opponent’s appeal. For reasons of procedural economy, the BoA considered the goods and services as identical. It found that the signs were similar to a very low degree from a visual and phonetic point of view and completely dissimilar from a conceptual point of view. It therefore concluded that there was no likelihood of confusion. The opponent filed an action before the GC relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. According to the GC, the term ‘SFERA’, which represents the only component of the earlier word marks, is also the dominant element of the earlier figurative marks (para. 36). Accordingly, the GC stated that the signs have a low degree of visual and phonetic similarity (paras 41 and 45). From a conceptual point of view the marks would be different only for the small part of the public who would understand ‘NOOSFERA’ as a philosophic concept (para. 47). For the remaining part of the public it would not be possible to make a conceptual comparison of the signs (para. 49). The GC concluded that the low degree of visual and conceptual similarity between the marks was not enough to balance the differences existing between them (para. 55). These circumstances led the GC to exclude the existence of a likelihood of confusion on the part of the relevant public. **NO LOC**

♦ [T-292/12RENV](#); **MAGNEXT / MAGNET 4 et al.**; Judgment of 1 June 2016; *Mega Brands International, Luxembourg, Zweigniederlassung Zug v EUIPO*; Language of the case: EN. The applicant sought to register the word mark **MAGNEXT** as an EUTM for goods in Class 28. An opposition based on, inter alia, the earlier word mark **MAGNET 4** registered for goods in Class 28, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld an opposition against all goods in Class 28 of the EUTM based on the earlier Spanish word mark. The BoA dismissed the applicant’s appeal. In a judgment on 4 February 2014 the GC dismissed the appeal Case T-292/12. The CJ C-182/14 P later set aside the judgment of the GC of 4 February 2014, and referred the case back to the GC for judgment (T-292/12RENV). The CJ held, in essence, that the GC had erred in failing to take into account, in its assessment of the similarity between the signs at issue, the presence of the element ‘4’ in



the earlier mark. Visually the element ‘4’ will be noted and cannot be entirely neglected in the assessment of the visual impression of the signs at issue, and that it contributes to distinguishing between those signs. Phonetically only the first syllable is common to the two signs at issue — ‘mag’ and ‘next’ versus five syllables, ‘mag’, ‘net’, ‘cu’, ‘a’ and ‘tro’. The public will associate the earlier mark with the adjective ‘magnético’, commonly used by the relevant public to designate an article having magnetic properties. There is no conceptual similarity between the mark applied for, on the one hand, and the earlier mark, on the other, since the word ‘magnext’, which does not exist in Spanish and is not otherwise connected to any current concept, will be perceived as being fanciful (paras 27 to 29). Not only is there merely a low degree of visual similarity and a very low degree of phonetic similarity between the marks at issue, but also they are conceptually dissimilar (para. 30). The conceptual differences are capable of counteracting to a very large extent, and even cancelling, the visual and phonetic similarities. Only the earlier mark will be perceived as referring to the concept of magnetism, while the mark applied for will be perceived as being purely fanciful (para. 32). This distinctive overall impression is further reinforced by the possibility that the relevant public might identify the English word ‘next’ within the mark applied for, whereas the mark **MAGNET 4** does not contain any element that can associate it with that word (para. 33). Contrary to the assertions of the Office, the relevant public will identify the word ‘next’ within the mark applied for and will immediately grasp its meaning (para. 35). The earlier trade mark **MAGNET 4** conveys a message that may be associated in the mind of the relevant public with characteristics of the goods for which the trade mark is registered, and therefore that it has only a weak distinctive character (para. 41). In the context of a global assessment of the likelihood of confusion, taking into account the low degree of similarity between the mark applied for and the earlier mark, the conceptual differences between the two marks, the presence of the element ‘4’ in the earlier mark alone and the weak distinctive character of that earlier mark, it must be held that the BoA erred in its assessment in recognising a likelihood of confusion between the marks within the meaning of Article 8(1)(b) EUTMR (para. 42). **NO LOC**

♦[T-34/15](#); **CHEMPIOIL / CHAMPION**; Judgment of 1 June 2016; *Wolf Oil Corp. v EUIPO / UAB SCT Lubricants*; Language of the case: EN.

IR designating the EU	Earlier mark
CHEMPIOIL	

The applicant obtained the international registration designating the European Union of the word mark **CHEMPIOIL** for goods covering, inter alia, *hydraulic and brake fluids* (Class 1), *cleaning and washing preparations for oil-soiled engines and other soiled industrial objects* (Class 3), *lubricants; fuels, industrial greases and industrial oils* (Class 4). An opposition based on the earlier figurative mark represented above, also registered for goods in Classes 1, 3 and 4, was filed pursuant to Article 8(1)(b) EUTMR. The OD partly upheld the opposition. The BoA annulled the OD’s decision and upheld the appeal. It found that there was no likelihood of confusion between the marks at issue because the signs were different due, in particular, to the fact that the earlier mark had a fixed meaning for all the public in the EU, whereas the earlier mark had no meaning or different ones. The opponent filed an action before the GC relying on two pleas in law: (i) infringement of Article 75 and Article 76(1)



EUTMR; and (ii) infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. On the likelihood of confusion: It was not disputed that the goods at issue were identical or similar. The GC confirmed the finding of the BoA that the earlier mark **CHAMPION** is an English and French word meaning a person who has beaten or overcome his or her rivals in a competition, which is part of the basic vocabulary of those languages. By contrast the **CHEMPIOIL** sign does not convey any clear concept. Thus, it is unlikely that a significant part of the public will associate a specific meaning to that sign (para. 42). The GC applied, as the BoA did, the case-law following which conceptual differences may counteract to a large extent visual or phonetic similarities between the signs concerned. Therefore, it concluded that consumers would differentiate the signs at issue, despite their visual and phonetic similarities. The GC therefore confirmed that since the requirement of identity or similarity between signs was not met in the present case, there was no likelihood of confusion between the marks at issue (paras 53 to 54). **NO LOC**

♦[T-789/14](#); **MEISSEN / MEISSEN et al.**; Judgment of 14 June 2016; *Staatliche Porzellan-Manufaktur Meissen GmbH v EUIPO*; Language of the case: DE.

EUTM application	Earlier marks
	<ol style="list-style-type: none"> 1) MEISSEN 2) MEISSENER PORZELLAN 3) HAUS MEISSEN 4) 

An opposition was filed against the EUTM application represented above, applied for goods in Classes 11, 19 and 20. The opposition was based on the earlier marks represented above, registered for goods and services in Classes 3, 8, 11, 14, 16, 18, 19, 21, 24, 28, 29, 30, 32, 33, 34, 36, 41, 42 and 43. The grounds of opposition were Article 8(1)(b) and Article 8(5) EUTMR. Upon request the opponent had to provide proof of use for some of the earlier marks. The OD partly upheld the opposition, namely for the goods in Classes 11 and 19 and rejected the opposition as regards the goods in Class 20. Upon appeal by both parties the BoA annulled OD’s decision in as far as OD had upheld the opposition for Classes 11 and 19. The BoA found that there is no likelihood of confusion between any of the marks. As regards Article 8(5) EUTMR the BoA held that neither a link between the signs nor a risk of injury had been proven by the opponent. The opponent filed an action before the GC. The GC dismissed the appeal. Regarding Article 8(1)(b) EUTMR and the similarity between goods, the GC confirmed the BoA’s view that *household/kitchen utensils* and *decoration articles* are not similar to *sanitary articles* and *furniture*. Even if the respective goods might be produced by the same undertakings, this is nevertheless only one factor of the examination of similarity, which is not decisive, if the method and purpose of use of the goods differ (paras 56 to 59). As far as the element ‘MEISSEN’ in the trade marks at issue is concerned, this element will be understood as a reference to the geographical origin of the goods, namely the city of Meißen in Germany, famous for its porcelain industry. Therefore, ‘MEISSEN’ is descriptive for all goods possibly made of porcelain and cannot be the dominant element of any of the marks at issue (paras 77 to 83). The EUTM application and the earlier trade mark **HAUS MEISSEN**, which coincide only in the descriptive element ‘MEISSEN’, are visually, aurally and conceptually similar only to a below average degree. In



light of these parameters the BoA was right to deny a likelihood of confusion for similar as well as for identical goods (para. 111). **NO LOC**

♦[T-567/15](#); **DEVICE OF A BLACK SQUARE WITH FOUR WHITE STRIPES / DEVICE OF THREE VERTICAL WAVY LINES et al.**; Judgment of 14 July 2016; *Monster Energy Company v EUIPO*; Language of the case: EN.

EUTM application	Earlier mark
	

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Class 25. An opposition based on inter alia the earlier figurative mark represented above was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The OD dismissed the opposition. The opponent appealed the OD decision. The BoA dismissed the appeal. It found that the differences between the signs clearly outweighed the very low visual similarities between them, even where the goods are identical. As regards the reputation claim, the BoA held that no relevant documents in relation to *clothing* and *headgear* had been provided. Consequently, the appeal was dismissed. The opponent challenged the decision before the GC. **Infringement of Article 8(1)(b) EUTMR:** the definition of relevant public (general public) and the identity of the goods involved was not disputed. The BoA was fully entitled to find that the signs present only a very low degree of visual similarity (paras 25 to 28). The signs are purely figurative and abstract in nature; no phonetic comparison is possible (para. 29). For the relevant public the perception of the trade mark applied for as ‘scratches’ is not the most obvious perception since those lines rather call to mind white brushstrokes on a black square (para. 32). Therefore, the most likely assumption in regard to the perception of the signs is that suggested by the BoA: either they are abstract devices (no conceptual comparison possible) or the earlier trade mark is a ‘claw’ whereas the trade mark applied for are ‘white brushstrokes’ (conceptually different) (paras 30 and 33). It is apparent from the documents submitted that the applicant operates in the non-alcoholic beverages or energy drinks sector. There is no evidence of enhanced distinctiveness or reputation of the earlier trade mark in relation to *clothing* or *headgear*. (paras 41 to 44). The fact that the earlier mark enjoyed reputation for *drinks* had no relevance insofar as the opposition was not based on *drinks* and *drinks* were clearly not similar to the contested goods (para. 46). **NO LOC**

♦[T-429/15](#); **MAD CATZ / MONSTER et al.**; Judgment of 14 July 2016; *Monster Energy Company v EUIPO*; Language of the case: EN.

EUTM application	Earlier marks
	



The other party to the proceedings sought to register the figurative mark as depicted above for, inter alia, Class 25. The applicant filed an opposition pursuant Article 8(1)(b) and Article 8(5) EUTMR. Both instances of the Office rejected the opposition, insofar as the marks were deemed to be dissimilar. The applicant filed an appeal before the GC claiming an infringement of Article 8(1)(b) and Article 8(5) EUTMR. Regarding the infringement of Article 8(1)(b) EUTMR with respect to earlier mark number 1, the GC stated that the orientation and the number of lines are different, the lines, in themselves, are not similar and, moreover, the background of the mark applied for creates a visual difference. Furthermore, the mark applied for includes two additional verbal elements, namely ‘mad’ and ‘catz’. The marks are visually dissimilar (paras 23 and 24). Aurally the marks are different. The earlier mark will not be pronounced. Even assuming that the earlier mark could be considered to be a stylised representation of the letter ‘m’, its pronunciation remains very different to that of the mark applied for (para. 26). From a conceptual point of view, the figurative elements of the signs do not share any common meaning, consequently there is no conceptual similarity (paras 29 to 31). The signs are therefore dissimilar overall (para. 32). Regarding the infringement of Article 8(1)(b) EUTMR with respect to earlier marks numbers 2, 3 and 4, the GC pointed out that the remaining earlier marks, compared to the contested sign, are even more dissimilar than the first earlier mark. They have additional word and figurative elements, which render them more different. Consequently, these earlier marks are also dissimilar (paras 34 to 40). Since one of the necessary conditions for the application of Article 8(1)(b) EUTMR, namely the similarity between the marks, is not fulfilled, there cannot be a likelihood of confusion in the sense of the aforementioned provision (paras 42 and 43). **NO LOC**

♦[T-345/15](#); **KRISTAL / HOME KRISTAL**; Judgment of 14 July 2016; *Modas Cristal, S.L. v EUIPO*; Language of the case: ES.

EUTM application	Earlier marks
	<p>1) </p> <p>2) </p>

The EUTM applicant sought to register the figurative mark **KRISTAL** (as depicted above) for goods and services in Classes 24, 26 and 35. An opposition based on the earlier word mark **MODA CRISTAL**, registered for services in Class 35 and the figurative mark **HOME CRISTAL** (as depicted above), registered for goods in Class 24, was filed on the grounds of Article 8(1)(b) EUTMR. The OD dismissed the opposition. It found that the use of the earlier word mark was not proven and there was no likelihood of confusion between the contested sign and the earlier figurative mark. The BoA dismissed the opponent’s appeal. The opponent filed an action before the GC raising two pleas in law: (i) breach of Article 42(2) and (3) EUTMR and (ii) breach of Article 8(1)(b) EUTMR. As regards the second plea, the GC dismissed the claim regarding the breach of Article 8(1)(b) EUTMR in relation to the earlier word mark. The issue of genuine use is specific and preliminary to the opposition proceedings, since it leads to a determination whether, for the purposes of the examination of the opposition, the earlier trade mark can be deemed to be registered for the goods or services in question. As regards the earlier figurative mark and the contested sign, the goods and services were assumed to be identical (not disputed). Despite the bigger size of the element ‘HOME’, the word element ‘Cristal’ in the contested mark is legible and therefore, the former is not dominant but predominant in the overall impression given by the marks. Only if all the other components of the mark are negligible, the assessment of the similarity



can be carried out solely on the basis of the dominant element (paras 66 to 68). The fact that the marks at issue contain similar word elements is not in itself sufficient to justify the conclusion that the signs at issue are visually similar. The presence in the signs of figurative elements of a particular configuration is likely to lead to the overall impression conveyed by each sign being different (para. 73). The marks are visually similar to a very low degree. From the aural and conceptual perspective the signs are similar to certain extent. The element ‘HOME’ is, because of its bigger size, colour, typography and position at the beginning of the sign, the most important element. In particular, in relation to the relevant goods in Class 24, the visual aspect plays a greater role in the global assessment of the likelihood of confusion (para. 100). There is no likelihood of confusion. **NO LOC**

♦ [T-565/15](#); **MERLIN’S KINDERWELT / KINDER**; Judgment of 20 September 2016; *Excalibur City s.r.o. v EUIPO*; Language of the case: EN. The applicant sought to register the word mark **MERLIN’S KINDERWELT** as an EUTM for, inter alia, services in Class 41. An opposition based on the earlier Italian word mark **KINDER**, registered for, inter alia, services in Class 41, was rejected. The OD found that there is no likelihood of confusion within the meaning of Article 8(1)(b) EUTMR. Moreover, it found that consumers will not establish a mental link between the marks for the purposes of Article 8(5) EUTMR. The BoA upheld the applicant’s appeal, finding likelihood of confusion between the marks. The BoA based its decision mainly on the fact that the earlier mark **KINDER** is meaningless for the relevant Italian public and that the word ‘Merlin’s’ is a non-distinctive element because it indicates the subject matter of the relevant services (*education, entertainment etc.*). The applicant filed an action before the GC. The GC upheld the appeal and annulled the Board’s decision. The GC assessed the distinctive and dominant elements of the marks and found that although the public may associate the word ‘Merlin’s’ with the emblematic character of Arthurian legend, this does not prevent this element from being capable of playing a distinctive role in the mark. The GC refused that this element would be perceived as a characteristic of the contested services. None of the elements dominates the overall impression created by the contested mark. The word ‘Kinder’ in the contested mark does not have an independent existence but it’s merely a part of an element that has equal importance as the element ‘MERLIN’S’. The common element ‘KINDER’ is found in the contested mark between two other elements, ‘MERLIN’S’ and ‘WELT’. The overall impression is sufficiently different. The marks are not similar visually and aurally and conceptually they are different on account of the word ‘Merlin’s’. Consequently, the marks are not similar for the purposes of Article 8(1)(b) EUTMR and the BoA erred in finding that there was a likelihood of confusion. **NO LOC**

♦ [T-566/15](#); **MERLIN’S KINDERWELT / MERLIN**; Judgment of 20 September 2016; *Excalibur City s.r.o. v EUIPO*; Language of the case: EN.

EUTM application	Earlier mark
	<p style="text-align: center;">KINDER</p>

The applicant sought to register the figurative mark represented above as an EUTM for, inter alia, services in Class 41. An opposition based on the earlier Italian word mark **KINDER**, registered for, inter alia, services in Class 41, was upheld pursuant to Article 8(1)(b) EUTMR. The BoA dismissed the applicant’s appeal, finding likelihood of confusion between the marks.



The BoA based its decision mainly on the fact that the earlier mark KINDER is meaningless for the relevant Italian public and that the word ‘Merlin’s’ is a non-distinctive element because it indicates the subject matter of the relevant services (*education, entertainment etc.*). The applicant filed an action before the GC. The GC upheld the appeal and altered the decision of the Board to the effect that the opposition is rejected. The GC assessed the distinctive and dominant elements of the marks and found that although the public may associate the word ‘Merlin’s’ with the emblematic character of Arthurian legend, this does not prevent this element from being capable of playing a distinctive role in the mark. The GC refused that this element would be perceived as a characteristic of the contested services. Even if assumed that this element is not the dominant element of the mark, it is of average distinctiveness and it is not negligible. The word ‘Kinder’ in the contested mark does not have an independent existence and there are many other elements in the mark that are distinctive and non-negligible. The overall impression is sufficiently different. The marks are not similar visually, aurally and conceptually they are different on account of the word ‘Merlin’s’. Consequently, the marks are not similar for the purposes of Article 8(1)(b) EUTMR and there is no likelihood of confusion. On account of the lack of similarity, Article 8(5) EUTMR does not apply, either.

NO LOC

[T-593/15](#); **THE ART OF RAW / art et al.**; Judgment of 28 September 2016; *The Art Company B & S, SA v EUIPO*; Language of the case: EN.

EUTM application	Earlier marks
THE ART OF RAW	1) *art 2) 

The applicant sought to register the word mark **THE ART OF RAW** as an EUTM for goods and services in Classes 18, 25 and 35. An opposition based on the earlier figurative marks represented above, registered for goods and services in Classes 18, 25 and 35 was filed pursuant to Article 8(1)(b) EUTMR. The OD partly upheld the opposition insofar as some of the contested goods in Class 18 and all the contested ones in Classes 25 and 35 were concerned. The BoA upheld the applicant’s appeal. It found that the word element ‘art’ of the marks had a weak distinctive character and that the identity or similarity between the goods and services was counteracted by the, at most, very low similarity between the signs. The opponent filed an action before the GC relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. It confirmed the finding of no likelihood of confusion. The examination of the opposition was mainly based on the figurative mark **ART**. The goods at issue are in part identical, in part similar (not disputed). The level of attention is that of the general public of the European Union, even for the services in Class 35 since it is the less attentive group within the relevant public for services in that class (paras 22 to 24). The signs are only remotely similar from a visual standpoint, because they differ in all their elements with the exception of the word ‘art’, their structure and length being different. The element placed at the beginning of each sign plays a role in the perception of the marks (paras 27 to 29). Phonetically, there is no relevant degree of similarity in view of the fact that the mark applied for is significantly longer and contains additional word elements. The identical pronunciation of the earlier mark and the second syllable of the contested mark is not sufficient for a finding of similarity (para. 30). The relevant public, including non-English speaking public, will understand ‘the art of’ and will perceive the whole



expression, even if ‘raw’ is not understood, as a logical unit with a semantic value different from the word ‘art’, understood as an abstract word; the marks are conceptually dissimilar (paras 31 to 36). The GC emphasised that the common element ‘art’ is laudatory for the goods and services concerned. In view of its weak intrinsic distinctive character, it cannot be decisive in the overall impression (paras 42 to 49). The identity and similarity between the goods are not such as to offset the very low degree of similarity between the signs (paras 50 to 52). The mark applied for cannot be seen as a sub-brand of the earlier marks since the marks do not share a common dominant element (para. 53). There are even more differences between the contested application and the remaining figurative mark (paras 54 to 57). The BoA did not err in finding that there is no likelihood of confusion. **NO LOC**

♦[T-430/15](#); **SILVANIA FOOD / SYLVANIA et al.**; Judgment of 30 September 2016; *Flowil International Lighting (Holding) BV v EUIPO — SC Lorimod Prod Com, Srl*; Language of the case: EN.

EUTM application	Earlier mark
	<p style="text-align: center;">SYLVANIA</p>

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 29, 30 and 35. An opposition based, inter alia, on the earlier EU word mark **SYLVANIA**, covering goods in Classes 9, 10 and 11, (including, in short, *apparatus and installations for lighting; lamps; lamps devices and accessories*), was filed pursuant to Article 8(1)(b) and Article 8(2)(c) EUTMR read in conjunction with Article 8(1)(b), Article 8(4) and (5) EUTMR. The OD rejected the opposition. The Second BoA dismissed the appeal. The BoA found that there was no likelihood of confusion for the purposes of Article 8(1)(b) EUTMR. It considered that, while the signs at issue were similar overall, the goods and services in question were different, in view in particular of the differences in the nature, purpose and intended use of those goods and services, neither were in competition with each other or complementary. The BoA also rejected the opposition based on Article 8(5) EUTMR. In that regard, it found that, as the applicant had failed to establish that there was a link between the mark applied for and the earlier rights relied on in support of the opposition, one of the requirements laid down in Article 8(5) of Regulation No 207/2009 was not fulfilled. The opponent filed an action before the GC relying on two pleas in law alleging (i) infringement of Article 8(1)(b) EUTMR and (ii) infringement of Article 8(5) EUTMR. The GC dismissed the appeal. As regards the first plea, the GC confirmed that the relevant public for the goods in Classes 29 and 30 covered by the mark applied for is the average consumer with a normal level of attention and that the relevant public for the goods and services in Classes 7, 9, 10, 11, 35 and 42 is a public consisting of professionals with an above-average level of attention (paras 17 to 19). As far as the comparison of the signs is concerned, the GC found that the BoA was correct to find that the signs at issue are similar overall, a finding that was not contested by the parties (para. 28). As regards the comparison of the goods and services, the GC endorsed the findings of the contested decision that foodstuffs covered by the mark applied for in Classes 29 and 30 are dissimilar to the goods and services in Classes 7, 9, 10, 11, 35 and 42 covered by the earlier marks. The nature, purpose, intended use, usual origins and distribution channels of those goods and services are different. They are not in competition with or complementary to each other and are not intended for the



same consumers. There is no evidence to suggest that such a connection exists in the present case. It is clear that the purchase of the foodstuffs covered by the mark applied for is not conditional on the purchase of the lighting goods or the lighting-related design and planning services covered by the earlier marks and there is nothing to support the conclusion that the purchaser of those goods or services would be prompted to buy the others. Moreover, those goods and services are made by different manufacturers (paras 23 to 27).

NO LOC

♦[T-549/14](#); **Castello / Castelló et al.**; Judgment of 4 October 2016; *Lidl Stiftung & Co. KG v EUIPO*; Language of the case: EN.

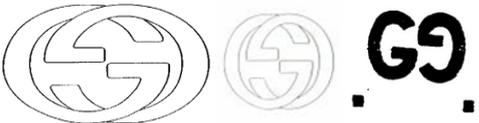
EUTM application	Earlier marks
<p>Castello</p>	<p>1) </p> <p>2) </p>

The applicant sought to register the word mark **Castello** as an EUTM for goods and services in Classes 29, 30 and 31. An opposition based on, inter alia, the earlier figurative marks represented above (EUTM and Spanish), registered for goods and services in Classes 30, 35 and 39, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition in part with respect to certain goods in Classes 29 and 30 and rejected it for the remainder. Both parties filed an appeal. The BoA of the Office dismissed the appeal brought by the applicant and partially upheld the action brought by the opponent. The BoA found the evidence of use of the earlier Spanish mark sufficient (the earlier trade mark was not subject to proof of use) and the marks in question very similar. The BoA found identity/similarity between all the contested goods in Classes 29 and 30 and concluded that there was a likelihood of confusion for those goods. Goods in Class 31 were considered dissimilar. The applicant filed an action before the GC relying on two pleas in law: (i) infringement of Article 42(2) and (3) EUTMR and of Rule 22(3) and (4) EUTMIR and (ii) infringement of Article 8(1)(b) EUTMR. The GC partly upheld the appeal. It confirmed the BoA's findings regarding proof of use (POU) and regarding the likelihood of confusion for all goods in Classes 29 and 30. However, it found that the contested *frozen fruit and vegetables* in Class 29 were not similar to any of the goods covered by the earlier trade marks and to this extent it upheld the action. **Second plea (LOC):** comparison of goods: *baking ingredients of all kinds, candied fruits, glacier cherries, raisins, sultanas, candied orange peel and candied lemon peel* on the one hand and *industrial confectionery* on the other hand are complementary; there is a similarity between these products. The former are ingredients of the latter; although this is not in itself sufficient to conclude that there is as similarity, it is necessary to take into account that the consumer himself uses the ingredients to make confectionery goods or patisserie or baking goods — on that account such goods must be considered interchangeable and in competition (para. 74); thus the average consumer will associate the ingredients with the opponent's final goods, even though the latter are industrial goods (para. 72). Another factor for similarity is that both sets of goods are processed products (para. 73). The same reasoning was applied to a rather broad array of contested goods in Class 29, which can be ingredients of patisserie and bakery goods



(paras 77, 79 and 86). Nevertheless, there is no similarity between the contested *frozen fruit and vegetables* and any of the opponent's goods. They are sold in specific departments, they are generally not processed, they are closer to fresh or raw goods (para. 82). As regards the contested goods in Class 30, they are all similar to the goods of the earlier marks (paras 87 to 96). The GC confirmed the BoA's assessment of the similarity between the signs and other factors for likelihood of confusion and concluded that there was a likelihood of confusion for the identical and similar goods. The second plea is partially upheld, but only for *frozen fruit and vegetables* (paras 97 to 115). **NO LOC**

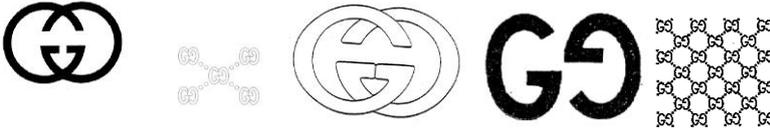
♦[T-461/15](#); **DEVICE OF FOUR INTERLOCKING Gs / GG**; Judgment of 11 October 2016; *Guccio Gucci SpA v EUIPO and Guess? IP Holder LP*; Language of the case: EN.

EUTM	Earlier marks
	

The applicant for invalidity, the owner of the earlier rights, sought to invalidate the mark represented above, registered as an EUTM for goods within Classes 3, 9, 14, 16, 18, 25 and 35. The action for invalidity was based on the earlier marks represented above, registered in the European Union for goods in, inter alia, Classes 3, 9, 16, 18 and 25, and was filed on the grounds of Article 8(1)(b) EUTMR and Article 8(5) EUTMR. The CD rejected the application for invalidity. The BoA dismissed the applicant for invalidity's appeal. The applicant for invalidity filed an action before the GC based on three pleas in law: (i) infringement of Article 75 EUTMR, (ii) infringement of Article 8(1)(b) EUTMR and (iii) infringement of Article 8(5) EUTMR. As regards the second plea, the GC confirmed the finding of the BoA that the relevant public was the general public, which had an average level of attention (para. 20). As to the substance, regarding the infringement of Article 8(1)(b) EUTMR the GC affirmed that there was no likelihood of confusion for the relevant public. Regarding the comparison of the signs the GC holds that, visually, the contested sign will be retained as an ornamental motif but the public will not perceive the capital letter 'G' in the sign. Visually, they are considered as different. As regards the phonetic comparison, as the contested sign is a purely figurative sign, it will not be pronounced so no phonetic comparison can be carried out. Conceptually, the comparison can also not be carried out because the contested mark as an abstract ornamental motif has no meaning and the earlier marks, which refer at most to the capital letter 'G', have no semantic meaning of their own. As the marks are dissimilar overall, the BoA did not infringe Article 8(1)(b) EUTMR. **NO LOC**



♦[T-753/15](#); **DEVICE OF FOUR INTERLOCKING Gs / GG**; Judgment of 11 October 2016; *Guccio Gucci SpA v EUIPO and Guess? IP Holder LP*; Language of the case: EN.

EUTM application	Earlier marks
	

The applicant, sought to register the mark represented above as an EUTM for goods within Class 9. The opposition was based on the earlier marks represented above, registered in the EU for goods in, inter alia, Classes 9, 18 and 25, and was filed on the grounds of Article 8(1)(b) and Article 8(5) EUTMR. The OD upheld the opposition in its entirety. The BoA upheld the applicant's appeal. The opponent filed an action before the GC based on three pleas in law: (i) infringement of Article 75 EUTMR, (ii) infringement of Article 8(1)(b) EUTMR and (iii) infringement of Article 8(5) EUTMR. As regards the second plea, the GC confirmed the finding of the BoA that the relevant public was the general public, which had an average level of attention (para. 22). As to the substance, regarding the infringement of Article 8(1)(b) EUTMR, the GC affirmed that there was no likelihood of confusion for the relevant public. Regarding the comparison of the signs the GC holds that, visually, the contested sign will be retained as an ornamental motif but the public will not perceive the capital letter 'G' in the sign. Visually, they are considered as different. As regards the phonetic comparison, as the contested sign is a purely figurative sign, it will not be pronounced so no phonetic comparison can be carried out. Conceptually, the comparison can also not be carried out because the contested mark as an abstract ornamental motif has no meaning and the earlier marks, which refer at most to the capital letter 'G', have no semantic meaning of their own. As the marks are dissimilar overall, the BoA did not infringe Article 8(1)(b) EUTMR. **NO LOC**

♦[T-407/15](#); **HOTOGO SELF / HEATING CAN TECHNOLOGY-M**; Judgment of 20 October 2016; *Monster Energy Company v EUIPO / Hot-Can Intellectual Property Sdn Bhd*; Language of the case: EN.

EUTM application	Earlier marks
	

The EUTM applicant/intervener sought to register the figurative mark **HOTOGO SELF-HEATING CAN TECHNOLOGY** as an EUTM for goods and services in Class 29, 30 and 33.



An opposition based on several earlier figurative EUTMs, registered for goods Classes 5, 25 and 32, was filed pursuant to Article 8(1)(b) and Article (5) EUTMR. The OD dismissed the opposition insofar as the marks were found to be dissimilar. The BoA dismissed the opponent’s appeal. It found that the marks at issue were visually, conceptually and phonetically dissimilar. The opponent brought an action before the GC relying on two pleas in law: (i) an infringement of Article 8(1)(b) EUTMR and (ii) an infringement of Article 8(5) EUTMR. As regards the first plea, the GC emphasised that the word element ‘hotogo’ in the mark applied for was as visually important as the figurative element consisting of three wavy lines (para. 41). In addition, even if the word elements ‘self-heating can technology’ is written in fairly small characters and could be considered descriptive of the goods at issue, at least for English speakers, these word elements cannot be considered to be negligible (para. 43). Consequently, the GC set out that the BoA rightly found that the three wavy lines did not constitute the dominant element in the mark applied for (para. 45). As regards the comparison of signs, the GC found that, if all the elements — figurative and word — in the mark applied for are taken into consideration, the marks at issue are visually very different (para. 51). The mark applied for would refer to the concept of heat or stream, which is clearly absent from the earlier marks (para. 53), therefore the signs are conceptually different. Lastly, as regards the phonetic comparison, the GC confirmed that the aural comparison of two signs, one of which is purely figurative, is therefore impossible (paras 56 to 57). From all the foregoing the GC endorsed the conclusion that the marks are dissimilar overall (para. 58). **NO LOC**

[T-349/15](#); **P PRO PLAYER / P PROTECTIVE et al.**; Judgment of 24 November 2016; *CG Verwaltungsgesellschaft mbH v EUIPO*; Language of the case: EN.

EUTM application	Earlier marks
	<p>1) </p> <p>2) </p> <p>3) </p>

The applicant sought to register the figurative mark represented above as an EUTM for goods in Class 25. An opposition based on the earlier figurative marks represented above, registered for, inter alia, goods in Class 25, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition in its entirety. The BoA upheld the applicant’s appeal. It found that the marks at issue were visually similar to a very low degree and not similar phonetically and conceptually. The opponent filed an action before the GC relying on a single plea in law: Article 8(1)(b) EUTMR. The GC dismissed the appeal. It was not disputed that the goods at issue were identical or highly similar. The GC upheld the findings of the BoA as regards the meaning of the verbal elements of the contested mark (in English the word ‘pro’ means, inter alia, ‘a person who engages in an activity on a professional rather than an amateur basis’; furthermore, according to the case-law, the word ‘pro’ may be laudatory; the word ‘player’ means, inter alia, ‘a person who practises physical exercise’) (paras 37 to 38). The GC held that as regards some goods (jackets, shorts, socks, etc.), although they may be used for playing a sport, nothing in their description indicates that they are specifically designed for



that purpose and the inherent distinctiveness of the word element ‘pro player’ is normal (para. 40). However, as regards some of the goods, the wording of which does indicate that they have a direct link with sporting activities (such as swimsuits) this element will be weak (para. 41). The GC confirmed that the BoA rightly took into account all elements of the marks at issue and based its comparison on the overall impression of the marks and rightfully concluded that there was a low degree of visual similarity, that the phonetic similarity would not be more than low and that there is no conceptual similarity, considering that the single letter ‘p’ does not convey any concept (paras 48 to 64). The GC confirmed that the inherent distinctiveness of the marks was not higher than normal. There is no likelihood of confusion. **NO LOC**

♦ [T-635/15](#); **TUUM / THUN**; Judgment of 6 December 2016; *Tuum Srl v EUIPO — Thun SpA*; Language of the case: EN.

EUTM application	Earlier mark
	

The applicant sought to register the figurative mark represented above as an EUTM for a range of goods in Class 14. An opposition based on the earlier national figurative mark represented above, registered in Italy and covering goods in Class 14, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition. The BoA dismissed the appeal filed against the above decision and confirmed that there was a likelihood of confusion between the marks at issue. The applicant filed an action before the GC alleging an infringement of Article 8(1)(b) EUTMR. The GC upheld the appeal and annulled the contested decision. The GC confirmed that the relevant public includes both professionals in the sector of jewellery and the public at large in Italy and that the goods at issue are identical. As far as the comparison of signs is concerned, the GC confirmed that that the signs are aurally similar to a high degree but it also found that, contrary to what stated in the contested decision, the marks are not similar from a visual point of view (paras 52 to 67). Conceptually, the GC endorsed the finding of the BoA that a significant part of the relevant public will not perceive any meaning in the signs at issue and that, thus, the conceptual comparison is neutral (para. 72). With reference to the overall assessment of the likelihood of confusion, the GC found that the BoA made an error when it stated at point 28 of the contested decision that the signs were visually similar to a high degree. That finding is inconsistent with the finding made earlier in the comparison of the signs that the marks only showed a certain degree of visual similarity (paras 73 to 74). The GC noted that, in any case, the signs are not similar from a visual point of view. The GC added in that regard that the goods in question are normally purchased after being perceived visually. Therefore, the visual similarity between the signs at issue carries more weight than their phonetic similarity in the assessment of the risk of confusion (para. 83). **NO LOC**



3. Other LOC related cases

♦ [T-692/14](#); **DEVICE OF AN UNIDENTIFIABLE ANIMAL / DEVICE OF A PUMA et al.**; Judgment of 25 February 2016; *PUMA SE v OHIM*; Language of the case: PL.

EUTM application	Earlier mark
	

The applicant sought to register the figurative mark represented above as an EUTM for goods within Class 5. An opposition based on, inter alia, the earlier figurative mark represented above, registered for goods in Class 5, was filed on the grounds of Article 8(1)(b) EUTMR. The OD dismissed the opposition on the basis that the trade marks were dissimilar. The BoA dismissed the opponent's appeal and confirmed the finding of dissimilarity between the signs. The opponent filed an action before the GC claiming an infringement of Article 8(1)(b) EUTMR. The GC decided with a very brief reasoning (paras 33 to 36) that the BoA did not consider the coincidences between the marks (both containing a black silhouette of a jumping animal with the same line of the back) but only emphasised the differences. This contradicts the principle that the trade marks comparison is based on the overall impression (para. 32). The decision was annulled and remitted to the BoA for a new assessment.

[T-778/14](#); **COYOTE UGLY / COYOTE UGLY**; Judgment of 3 March 2016; *Ugly, Inc. v OHIM*; Language of the case: EN. The applicant sought to register the word mark **COYOTE UGLY** as an EUTM for services in Classes 41 and 43. An opposition based on the earlier word mark, well-known mark and non-registered mark **COYOTE UGLY** for goods and services in Class 9, 14, 16, 21, 25, 32, 34, 41, 42 was filed on the grounds of Article 8(1)(b), Article 8(2)(c) and Article 8(4) EUTMR. The OD dismissed the opposition. The BoA dismissed the opponent's appeal. In particular, as far as the ground of Article 8(1)(b) EUTMR is concerned the BoA held that the earlier right being revoked could no longer be relied on as the basis of the opposition. The opponent filed an action before the GC relying on two pleas in law: (i) alleging that the BoA erred in assessing the effect of the declaration of revocation of the earlier trade mark; (ii) alleging that the BoA erred in assessing the evidence of existence of the earlier rights under Article 8(2)(c) and Article 8(4) EUTMR. Concerning the first plea, the GC confirmed the BoA's finding that the earlier trade mark invoked as the basis of opposition, because of its revocation ceased to have effects specified in EUTMR as of the date of its revocation, which in this case was prior to the opposition. Therefore it did not constitute a valid basis for the opposition (para. 18). This plea was rejected. Concerning the second plea, in relation to evidence of use/well-known character, the GC confirmed that it must be in the language of the proceedings, thus the BoA rightly disregarded the evidence in Spanish (para. 35) and confirmed the settled approach that Wikipedia has a low probative value (para. 38). The remaining evidence concerns the film and the soundtrack 'Coyote Ugly', which are not owned by the opponent. The fact that the film was based on the 'true' story of the opponent's bar does not amount to the use of the mark as required by Article 8(4) EUTMR (para. 46). **Well known marks:** the GC found that well-known marks



enjoy protection irrespective of their use in the relevant territory (para. 60). The evidence, although it shows that the film ‘Coyote Ugly’ and its soundtrack were successful in 2000, does not demonstrate that the opponent’s business was widely associated with the film by the relevant public at the date the mark applied for was filed (para. 61). The GC rejected the arguments related to the lack of reasoning.

♦ [T-742/14](#); **CALCILITE**; Judgment of 19 July 2016; *Alpha Calcit Füllstoffgesellschaft mbH v EUIPO*; Language of the case: EN.

EUTM	Earlier mark
CALCILITE	Calcilit

The EUTM proprietor was granted the registration of the figurative mark represented above as an EUTM for goods in Classes 2 and 19. An application for invalidity was filed pursuant to Article 53(1)(a) EUTMR in conjunction with, inter alia, Article 8(1)(b) EUTMR. The CD dismissed the application for invalidity as it considered that the goods at issue were dissimilar. The BoA dismissed the invalidity applicant’s appeal. It found that the opponent’s goods for which genuine use had been proven (*crystalline calcium carbonate filler* (CCCF)) were not similar to the contested goods. The invalidity applicant filed an action before the GC relying on a single plea in law: infringement of Article 53(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR. The GC partly upheld the appeal. **Likelihood of confusion (loc)**: the relevant public cannot extend beyond the professional public in the industrial sector (para. 46). The GC notes that a manufactured product may constitute an ingredient, raw material or component of another manufactured product; the fact that certain goods are purchased by non-industrial consumers does not mean those products may not be marketed to industrial professionals for the manufacture of other products (paras 50 to 52). The BoA failed to correctly identify the relevant public for the purposes of examining likelihood of confusion between CCCF and *paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants*, so the applicant’s plea in law in this regard is upheld (paras 60 to 61). However, the contested decision is confirmed with respect to the remaining contested products (para. 79). *Raw natural resins* and CCCF have a different nature and purpose, are not in competition with each other and the companies that produce them are different. The fact that the same public uses those products to manufacture the same product, namely adhesives, is not such as to justify a finding that they are similar (paras 62 to 70). CCCF and *targets* do not have a common public. Thus they cannot be similar (paras 71 to 78).

♦ [T-804/14](#); **Tropical / TROPICAL**; Judgment of 21 July 2016; *Tadeusz Ogrodnik v EUIPO*; Language of the case: EN.

EUTM	Earlier mark
	TROPICAL



The EUTM proprietor was granted the registration of the figurative mark **Tropical** represented above as an EUTM for goods in Classes 5 and 31. An application for invalidity was filed pursuant to Article 53(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR, on the basis of the earlier Portuguese registered trade mark **TROPICAL** (word mark). The CD dismissed the application for invalidity, finding that the applicant had not proved genuine use of the earlier mark. The BoA upheld the applicant's appeal. It found that the applicant had proved genuine use of the earlier mark in Portugal as regards some of the goods for which it was registered (those in Class 31), rejected the applicant's argument on acquiescence and concluded that, in view of the identity and similarity between the goods concerned and of the fact that the signs at issue were phonetically identical and, on the visual and conceptual levels, similar to a strong degree, there was a likelihood of confusion for the relevant public. The EUTM proprietor filed an action before the GC relying on a single plea in law, namely the infringement of Article 53(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR. The GC upheld the appeal and annulled the contested decision. **Comparison of the goods:** as regards the goods of the contested mark in Class 31, the GC confirmed the identity of *food for fish* covered by the earlier mark with the goods of the contested mark that could be considered to be *food for fauna*. However, it found that, despite the use of the term 'especially', some of the goods covered by the contested mark, such as *products and preparations for the cultivation of plants and aquarium plants* were not related to *food for fauna* and could not be considered to be identical to *food for fish* (paras 32 to 46). As regards the goods of the contested mark in Class 5, the GC found that the criteria mentioned in the contested decision to conclude there was an average degree of similarity with the *food for fish* in Class 31 of the earlier mark (distribution by the same companies, at the same points of sale and to the same end-consumers), were either not met or insufficient in this case to conclude on such a degree of similarity. Consequently the contested decision must be annulled in this regard (paras 65 to 73). **Global assessment, coexistence of trade marks, lack of reasoning:** neither the decision of the CD (which had rejected the application) nor the contested decision had examined the proprietor's arguments on the coexistence of the marks at issue. The GC found that, given that coexistence is one of the factors to be taken into consideration in the assessment of the likelihood of confusion, this omission meant that the contested decision was vitiated by a failure to state reasons and must be annulled (paras 137 to 177). The contested decision is annulled.

♦ [T-14/15](#); **airpass.ro / AirPlus International**; Judgment of 20 October 2016; *Lufthansa AirPlus Servicekarten GmbH v EUIPO*; Language of the case: EN.

EUTM application	Earlier mark
	<p>AirPlus International</p>

The applicant sought to register the figurative mark represented above as an EUTM for services in Classes 35 and 39. An opposition based on the earlier word mark **AirPlus International** registered for goods in Class 9 and for services in Class 35, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition in its entirety. On the same date, the OD also issued a decision concerning opposition, brought by *Airpas Aviation AG* against the mark applied for, at issue in the present case, based on an earlier registered figurative EUTM. The OD upheld the opposition in those proceedings in part and concluded that there was a likelihood of confusion for the services in Class 35. The decision adopted was definitive. The BoA dismissed the applicant's appeal and ordered to pay the costs. It found



that there was no likelihood of confusion within the meaning of Article 8(1)(b) EUTMR, as the signs at issue were different. The applicant filed an action before the GC relying on a single plea in law: infringement of Article 64(1) and Article 76(1) EUTMR, leading to infringement of Article 8(1)(b) EUTMR. The GC partially annulled the appeal. It found that, although the applicant's single plea in law was based on Articles 64 and 76 EUTMR, it is sufficiently clear from the application that the applicant also intended to plea an infringement of Rule 21(3) EUTMR. Due to the fact that the decision adopted in the parallel opposition proceedings has become final as consequence of the action brought by the applicant as regards the services in Class 35, the action has become devoid of purpose in that regard; nevertheless, the BoA should have concluded that there was no need to adjudicate in part and therefore freely allocated the costs in that regard. The GC emphasised that according to settled case-law, it is not necessary for a party to indicate expressly the provisions on which its pleas are based. It is enough for the subject matter of that party's application and the main elements of fact and law on which it is based to be set out sufficiently clearly in the application, which is the case here (para. 38). The GC recalled that pursuant to Rule 21(2) EUTMR, in the event of multiple oppositions, if a preliminary examination of one or more oppositions reveals that the trade mark for which an application for registration has been filed is possibly not eligible for registration for some or all of the goods or services for which registration is sought, the Office may suspend the other opposition proceedings. Pursuant to Rule 21(3) EUTMR, applicable *mutatis mutandi* to appeal proceedings under Rule 50(1) of the regulation, if the final decision leads to the rejection of the EUTM application, the parallel opposition proceedings in which the assessment has been suspended are deemed to be closed. The termination of proceedings is therefore considered to constitute a case that has not proceeded to judgment within the meaning of Article 81(4) EUTMR (para. 42). Although the BoA did not take in consideration the decision of the OD adopted in the parallel proceedings and it had no bearing on the definitive nature of the contested decision, which refused registration of the mark applied for as regards the services in Class 35, that omission had the result of ordering the applicant to pay the costs incurred by the EUTM applicant within the meaning of Article 85(1) EUTMR. However, as it is apparent from the foregoing, the BoA should have concluded that there was no need to adjudicate in part and therefore freely allocated the costs in that regard, pursuant to Article 85(4) EUTMR (para. 49). As the applicant did not dispute the reasoning underlying the contested decision, but rather disputed his responsibility to assume the costs incurred by the EUTM applicant, the contested decision must be partially annulled.

♦ [T-24/16](#); **FONTOLIVA / FUENOLIVA**; Judgment of 6 December 2016; *Sovena Portugal — Consumer Goods, SA v EUIPO — Mueloliva, SL*; Language of the case: EN. The applicant sought to register the word mark **FONTOLIVA** as an EUTM for *edible oils and fats; olive oil* in Class 29. An opposition based on the earlier Spanish word mark **FUENOLIVA**, covering *virgin olive oil* in Class 29, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition. The Second BoA dismissed the appeal filed against the above decision and confirmed that there was a likelihood of confusion between the marks at issue. The applicant filed an action before the GC. The applicant puts forward two pleas in law: (i) an infringement of Article 42(2) and (3) EUTMR, read in conjunction with Articles 15(1) and (2) EUTMR, and (ii) an infringement of Article 8(1)(b) EUTMR. As regards the second plea, the GC dismissed the applicant's argument that the BoA could not have upheld the opposition as being well founded since when the BoA confirmed that the opposition was well founded, the registration of the earlier national mark **FUENOLIVA**, on which the opposition was based, had not been the subject of a renewal. The GC found that the legality of the contested measure must be assessed on the basis of the elements of fact and of law existing at the time when the



measure was adopted. The GC further added that none of the parties raised the question of the maintenance of the validity of the registration of the earlier national mark before the BoA, although the year 2015, during which that registration would expire and would, if necessary, have to be renewed, was close, and indeed had already begun. Therefore, the BoA cannot be criticised for not having taken into account the possible non-renewal of the earlier mark (paras 32 to 34).

C. Article 8(3) and Article 53(1)(b) EUTMR — TM filed by agent

[no entry]

D. Article 8(4) and Article 53(1)(c) EUTMR — non-registered marks/other signs used in the course of trade

♦[T-62/14](#); **HOKEY POKEY / HOKEY POKEY**; Judgment of 21 January 2016; *EKBR IP Holder LLC v OHIM*; Language of the case:EN. The EUTM applicant sought to register the word mark **HOKEY POKEY** as an EUTM for *Confectionery* in Class 30. The opposition was based on the unregistered earlier word mark **HOKEY POKEY**, used in the United Kingdom since 1997 for *Confectionery, namely ice cream*. The OD dismissed the opposition. The BoA dismissed the appeal. The opponent filed an application before the GC for the annulment of the BoA's decision relying on one single plea, namely the infringement of Article 8(4) EUTMR. The GC decided to examine of its own motion the issue of the BoA's compliance with its obligation to state reasons, provided for in Article 75 EUTMR and adopted a measure of organisation of procedure by which it asked the parties to express their views on the matter in writing (para. 33). The GC came to the conclusion that the BoA did not state in a sufficiently clear manner whether it was in the light of the criteria laid down in national law that it was assessing the fourth condition provided for in Article 8(4) EUTMR, even less which national law was the source of the criteria in the light of which it made that assessment. In those circumstances, the GC is unable to verify the accuracy of the BoA's reasoning and carry out its review of the lawfulness of the contested decision (paras 34 to 37). This conclusion is supported by the fact that the contested decision contains inconsistencies: the BoA stated explicitly that the evidence adduced by the opponent was insufficient to prove use of the sign in the course of trade of more than mere local significance. An assessment such as that comes within the scope of the first and second conditions provided for in Article 8(4) EUTMR, which fall to be interpreted in the light of EU law, and not the fourth condition, which falls to be assessed in the light of the criteria laid down in the law governing the sign relied on. Moreover, the BoA also alluded to the first and second conditions provided for in Article 8(4) EUTMR, concluding that the evidence adduced by the opponent was not sufficient to prove use of the sign in question in the course of trade of more than mere local significance, after having referred, in the same paragraph, to 'damage', which may be construed as a reference to the fourth condition and, thus, to an assessment under the applicable national law, which makes it even more difficult to understand the reasoning in the contested decision (paras 28 to 39). The GC annulled the BoA's decision owing to the above inconsistencies.



[T-727/14](#) and [T-728/14](#) (joined cases); **animal / ANIMAL**; Judgments of 29 June 2016; *Universal Protein Supplements Corp. v EUIPO*; Language of the cases: EN.

EUTMs	Earlier mark
	<p style="text-align: center;">ANIMAL</p>

The EUTM proprietor was granted the registration of the figurative marks represented above for goods and services in Classes 3, 6, 8, 9, 12, 14, 16, 18, 20 to 22, 24, 25, 27, 28, 35, 36, 39 and 42. An application for declaration for invalidity was filed on the basis of the earlier unregistered word mark **ANIMAL** for goods within Class 25. The invalidity applicant produced various documents seeking to demonstrate that its unregistered sign **ANIMAL** had been used for clothing in various European Union countries. However, it did not give details of the provisions of national law on which it based its applications for declarations of invalidity. The CD rejected the application for declaration of invalidity. The BoA dismissed the appeals. The invalidity applicant filed an action for the annulment of the BoA decisions before the GC relying on two pleas in law: (i) infringement of Article 8(4) EUTMR and Rule 37(b)(ii) EUTMIR; and (ii) breach of Article 76 EUTMR as the EUIPO did not on its own motion obtain information from Member States. Concerning the first plea, the invalidity applicant relied on the use of the sign **ANIMAL**, as an unregistered mark, in several EU countries and made a general reference to the table annexed to the EUIPO guidelines. Even though the table contains all the information relating to one or several applicable national rights necessary to comply with the obligation arising under Rule 37(b)(ii) EUTMIR to provide the particulars of the right on which the application for a declaration of invalidity is based, in the present case, however, the applicant, did not identify, in a precise and unambiguous manner, the provisions of the various national laws on which it based its applications for declarations of invalidity (para. 33). In order to satisfy the requirements of Rule 37(b)(ii) EUTMIR, it is not sufficient for a party relying on rights flowing from Article 8(4) EUTMR merely to set out or indicate, *in abstracto*, the conditions for the application of national provisions, but on the contrary requires, that it shows, *in concreto*, in the instant case, that it satisfies those conditions of application (para. 38). Concerning the second plea, since the applicant has not provided to the Office particulars regarding the applicable national rights, the BoA was not required, in the present case, to exercise its power of verification of the relevance of the evidence produced by the invalidity applicant (paras 41 to 49).



♦ [T-567/14](#); **GROUP Company TOURISM & TRAVEL / GROUP Company TOURISM & TRAVEL**; Judgment of 29 June 2016; *Group OOD v EUIPO and Kosta Lliev*, Language of the case: BG.

Earlier non-registered mark	Earlier mark
	

The applicant, sought to register the figurative trade mark represented above for goods and services in Classes 35, 39 and 43. An opposition based on a non-registered figurative mark used in Bulgaria, Czech Republic, Hungary, Poland and Slovakia for services in Class 39 was filed pursuant to Article 41 EUTMR. The OD dismissed the opposition insofar as the opponent had not provided any evidence of the applicable national law on which it was relying and under which the use of the mark sought might have been prohibited in the Member States concerned (para. 8). The BoA dismissed the appeal. It found that in the opposition proceedings the opponent had failed to make out proof of which national law was applicable. The opponent filed an action before the GC claiming the infringement of Article 8(4) EUTMR, Article 76(1) and (2) EUTMR. The GC annulled the decision of the BoA. The GC held that the particulars of the national legislation supplemented the initial evidence, which concerned the use in the course of trade of an unregistered sign, both sets of evidence being regarded altogether as ‘one piece of evidence proving the acquisition, permanence and the scope of the protection of an earlier right’ (para. 38). The BoA could therefore not rule out the admissibility of the content of the national law, submitted for the first time before it, without exercising its discretion under Article 76(2) EUTMR (paras 53 to 58). The GC also annulled the BoA’s decision in that the BoA had required the particulars of the national law to be submitted in the form of a document having an official source, drafted in its original language, together with a translation in the language of the proceedings. According to the GC, the production of the content of the national law is not subject to compliance with any specific formality. The mere citation of the national law in the notice of opposition and in the language of the proceedings satisfies the formal requirements set out under Rule 19(2)(d) EUTMIR. The Office must verify that the information provided by the parties regarding the content of the national legislation relied on is correct (paras 69 to 70 and 77 to 81). Furthermore, the GC stated that the BoA did err in concluding that the national provision, namely Article 12(6) of the Law on trade marks and geographical indications, applied only to well-known marks (para. 63). By examining the national law of its own motion, the BoA drew incorrect conclusions as to their content, thereby, infringing the obligation to make findings of its own motion and to apply strictly the law of the Member States, laid down in Article 76(1) EUTMR (para. 64). As a consequence, the BoA, on the one hand, failed to ascertain the relevance of the evidence about national law adduced by the applicant and, on the other hand, it disregarded the evidence, referring to a source of information that turned out to be inaccurate (para. 80).



♦ [T-217/15](#); **PALLADIUM PALACE IBIZA RESORT & SPA**; Judgment of 30 November 2016; *Fiesta Hotels & Resorts, S.L. v EUIPO and Residencial Palladium, S.L.*; Language of the case: ES.

EUTM	Earlier right
	<p style="text-align: center;">GRAND HOTEL PALLADIUM</p>

An application for invalidity pursuant to Article 53(1) in conjunction with Article 8(4) EUTMR was filed against the figurative EUTM **PALLADIUM PALACE IBIZA RESORT & SPA** (represented above), registered for *education; providing of training; entertainment; sporting and cultural activities* in Class 41 and *services for providing food and drink; temporary accommodation* in Class 43. The application for invalidity was based on the unregistered name **GRAND HOTEL PALLADIUM**, used in Spain for restaurant and temporary accommodation services. The CD dismissed the application as regards services in Class 41 and upheld it for services in Class 43. It found that, according to Spanish law, the applicant was entitled to prohibit the use of a later mark similar to its trade name if there is a likelihood of confusion between the signs. The BoA dismissed the EUTM proprietor’s appeal. The applicant brought an action before the GC relying on two pleas alleging: (i) infringement of Article 53(1) in conjunction with Article 8(4) EUTMR and (ii) infringement of Article 8(1)(b) EUTMR. Regarding the first plea, based on Article 8(4) EUTMR, the GC ruled that the BoA was wrong to take into consideration some invoices bearing a date subsequent to the filing date of the contested mark (para. 36). Nevertheless, considering that so much other valid evidence had been submitted by the cancellation applicant, the GC concluded that the BoA rightly found that the non-registered earlier sign had been used more than locally (para. 50). The GC noted that the *Audiencia Provincial de Palma de Mallorca* ruled that the non-registered sign was protected under the Spanish law, as requested by Article 8(4) EUTMR (para. 66). The plea based on Article 8(4) EUTMR was therefore dismissed (para. 73).

E. Article 8(2)(c), Article 8(5) and Article 53(1)(a) EUTMR — well-known marks / marks with a reputation

[C-50/15 P](#); **Carrera / CARRERA**; Judgment of 21 January 2016; *Kurt Hesse v OHIM*; Language of the case: DE. The applicant sought to register the word mark **Carrera** as an EUTM for goods in Class 9. An opposition based on the earlier word mark **CARRERA**, registered for goods in Class 12, was filed pursuant to Articles 8(1)(b) and 8(5) EUTMR. The OD found the goods of the EUTM application in Class 9 and the goods in Class 12 of the earlier mark to be dissimilar and that the encroachment according to Article 8(5) EUTMR has not been shown. The BoA reversed the decision and found that the goods were similar and the conditions for the application of Article 8(5) EUTMR were met. The GC confirmed that finding of the BoA. The CJ rejected the appellant’s complaint that the GC did not assess all the relevant factors for the examination of the similarity between the goods. The GC took all those factors into account and stated that the existing complementary character of the goods leads to a similarity between them. The CJ confirmed that the complementarity is an independent factor, which may on its own justify the finding of similarity (paras 21 to 23). To the extent that the appellant challenges the importance that the GC gave to the



complementarity among all the other factors, this is a question of facts for which the CJ is not competent (para. 26). The CJ confirmed the case-law that the findings if an earlier mark is reputed or not is a question of facts, which cannot be an issue before the CJ. A distortion of facts has not been shown by the appellant (paras 29 to 31). The appellant’s complaint referring to the wrong acceptance by the GC of a ‘transfer of image’ of the earlier mark is just a repetition of an argument brought already against the decision of the BoA (para. 34). Moreover the appellant’s assumption of dissimilar goods is wrong, as the goods have been held by the GC as being similar (para. 35).

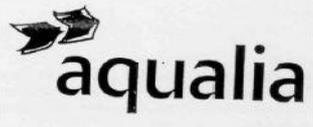
♦[T-169/13](#); **MOTO B / B MOTOB** *et al.*; Judgment of 2 February 2016; *Benelli Q.J. Srl v OHIM*; Language of the case: EN.

EUTM application	Earlier marks
	

The EUTM applicant sought to register the figurative mark above as an EUTM for goods in Classes 9, 12 and 25. An opposition in respect of these goods, based on the earlier Italian non-registered marks represented above, was filed on the grounds of, *inter alia*, Article 8(2)(c) EUTMR. The OD dismissed the opposition. The opponent appealed the decision before the BoA. The BoA dismissed the appeal. The opponent filed an application before the GC for the annulment of the decision of the BoA. The GC found that it may not be inferred solely from the absence of any market surveys that the applicant is unable to establish the well-known character of the earlier non-registered marks by other means. However, in the present case, most of the evidence was drafted in a language other than the language of the proceedings and not duly translated or was not referring to the relevant period (n) or to the earlier marks, so that the documents lodged by the opponent did not allow to ascertain the degree of knowledge on the part of the relevant public of the earlier non-registered marks (paras 63 to 83). For the reasons above, the opponent’s action was dismissed (para. 84).



♦[T-402/14](#); **AQUALOGY / AQUALIA et al.**; Judgment of 25 February 2016; *FCC Aqualia S.A. v OHIM*; Language of the case: ES.

EUTM application	Earlier marks
	1. AQUALIA  2.

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 1, 4-7, 9, 11, 12, 17, 19, 27, 32, 33 and 35-45. An opposition based on the earlier word mark **AQUALIA** registered for goods and services in Classes 7, 9, 32, 35-37, 39, 40 and 42, and the earlier figurative mark represented above registered for services in Class 39, was filed pursuant to Article 8(1)(b) EUTMR. Both the OD and the BoA dismissed the opposition. The relevant public of the services is composed of professionals with a very high level of attention. Taking into account the differences between the conflicting signs, there can be no likelihood of confusion. The opponent filed an action before the GC relying on two pleas in law: (i) infringement of Article 8(1)(b) EUTMR; (ii) and infringement of Article 8(5) EUTMR. In relation to Article 8(5) EUTMR, the GC confirms that the common element AQUA will not allow the relevant public to establish a link between the signs as regards the relevant services, all of them in the field of water distribution and management. The appeal is dismissed.

♦[T-645/13](#); **E / E**; Judgment of 15 March 2016; *Evcharis Nezi v OHIM*; Language of the case: EL.

EUTM application	Earlier mark
	

The EUTM applicant sought to register the figurative mark above as an EUTM for goods in Classes 14, 16, 18, 25, 26, 35 and 40. An opposition based on the earlier figurative EUTM, registered for goods in Class 3, 18 and 25 was filed on the grounds of Article 8(1)(b) and 8(5) EUTMR. The OD dismissed the opposition. The BoA partly upheld the appeal, allowing the opposition for goods in Class 18 and 25. The EUTM applicant filed an application before the GC for the partial annulment of the decision of the BoA, insofar as it upheld the opposition. The opponent filed an intervention for the partial annulment of the same decision, insofar as it dismissed the opposition. The opponent essentially claimed that the BoA did not examine the evidence of the reputation of the earlier mark. However the BoA found that the opponent had not explained why it had not produced such evidence before the OD. Moreover, it added that all of the evidence related to the mark ETAM or to a figurative mark consisting of the word element 'etam', and not to the earlier mark, thus noting that such evidence was not prima facie relevant. It follows that the BoA made a correct use of its discretionary power to accept or not new evidence (paras 124 to 131).



[T-201/14](#); **SPA WISDOM / SPA**; Judgment of 16 March 2016; *The Body Shop International plc v OHIM*; Language of the case: EN. The applicant sought to register the word mark **SPA WISDOM** for goods in Class 3. An opposition based on Articles 8(1)(b) and Article 8(5) EUTMR was filed. The OD upheld the opposition pursuant to Article 8(5) EUTMR, as the EUTM application would take unfair advantage of the word mark **SPA**, which covers goods in Class 32. The BoA dismissed the appeal. The EUTM applicant filed an action before the GC relying on one single plea alleging the infringement of Article 8(5) EUTMR. This plea relies on two claims: the signs are not similar because **SPA** is descriptive; there is no injury to the earlier mark. According to the GC, the examples show that the term SPA is used as a play on words alluding to the common use of the term for wellness centres, but not as a reference to characteristics of cosmetic products (para. 32). The evidence provided does not make it possible to invalidate the finding that the term SPA is not descriptive or weakly distinctive as regards cosmetic products (para. 36). There is an average degree of visual, phonetic and conceptual similarity between the signs (para. 38). The degree of closeness between the goods or services covered by the signs at issue, which is required by Article 8(5) EUTMR, does not imply that they must be identical or similar (para. 45). There is a certain link between the goods covered by the signs at issue (para. 48). The image of the earlier word mark and the message it conveys relate to health, beauty, purity and richness in minerals (para. 59). There is a risk of unfair advantage (para. 63). There is no due cause (para. 67). The action is dismissed.

◆[T-789/14](#); **MEISSEN / MEISSEN et al.**; Judgment of 14 June 2016; *Staatliche Porzellan-Manufaktur Meissen GmbH v EUIPO*; Language of the case: DE. An opposition was filed against the figurative EUTM application **MEISSEN**, applied for goods in Classes 11, 19 and 20. The opposition was based on the earlier word marks **MEISSEN**, **MEISSENER PORZELLAN**, **HAUS MEISSEN** and the figurative mark **Meissen**, registered for goods and services in Classes 3, 8, 11, 14, 16, 18, 19, 21, 24, 28, 29, 30, 32, 33, 34, 36, 41, 42 and 43. The grounds of opposition were Article 8(1)(b) and Article 8(5) EUTMR. Upon request the opponent had to provide proof of use for some of the earlier marks. The OD partly upheld the opposition, namely for the goods in Classes 11 and 19 and rejected the opposition as regards the goods in Class 20. Upon appeal by both parties the BoA annulled OD's decision in as far as OD had upheld the opposition for Classes 11 and 19. The BoA found that there is no likelihood of confusion between any of the marks. As regards Article 8(5) EUTMR the BoA held that neither a link between the signs nor a risk of injury had been proven by the opponent. The opponent filed an action before the GC. The GC dismissed the appeal. Regarding Article 8(5) EUTMR the GC stressed that the applicant failed to provide prima facie evidence of a future risk of injury, which is not hypothetical, and that it is not sufficient to merely generally claim one of the types of injury, as the applicant has done (paras 127 to 130). Additionally, the GC found that the goods at issue — *high end hand painted porcelain* on one hand, *tiles and sanitary goods made of porcelain* on the other hand — are so dissimilar that the public will not establish a link between the marks at issue (paras 134 to 135). Based on the foregoing, the action was dismissed.



[T-518/13](#); **MACCOFFEE**; Judgment of 5 July 2016; *Future Enterprises Pte Ltd v EUIPO — McDonald’s International Property Co. Ltd*; Language of the case: EN.

EUTM	Earlier marks
MACCOFFEE	McDONALD’S McFISH, McTOAST, McMUFFIN, McRIB, McFLURRY, McCHICKEN, et al.

The applicant registered the word mark **MACCOFFEE** as an EUTM for goods in Classes 29, 30 and 32. An application for invalidity was filed on the grounds of Article 53(1)(a) EUTMR in conjunction with Article 8(1)(a) and (b), Article 8(2)(c) and Article 8(5) EUTMR. The CD declared the contested mark to be invalid in its entirety, pursuant to Article 53(1)(a) in conjunction with Article 8(5) EUTMR. The BoA dismissed the applicant’s appeal. The applicant filed an action before the GC claiming an infringement of Article 8(5) EUTMR. The GC dismissed the action. It was not disputed that the **McDONALD’S** trade mark enjoys a considerable reputation for fast-food restaurant services in the European Union. Neither was the absence of a likelihood of confusion between the marks at issue disputed. In relation to Article 8(5) EUTMR, the GC confirmed the finding of the BoA that it was likely that the relevant public would associate the contested mark with the ‘Mc’ family of marks and establish a mental link between the marks at issue, so that there was a serious risk that use of the contested trade mark would take unfair advantage of the reputation of the **McDONALD’S** trade mark. **Similarity between the signs:** the GC found that there was no visual similarity between the marks at issue, contrary to the contested decision, which found a low degree of visual similarity (paras 23 to 25). Phonetically, the GC confirmed the BoA’s findings that the marks were similar to a certain degree (paras 26 to 28). From a conceptual point of view, the GC found that the prefixes ‘MAC’/‘Mc’ are associated with the same idea of a Gaelic surname prefix, they are written interchangeably and that an association of those prefixes with a word used in everyday language is not unusual. Therefore, **MACCOFFEE** would probably be understood as a reference to a beverage produced by a person of Scottish or Irish origin. Therefore, the GC confirmed the BoA’s finding that there was certain conceptual similarity (paras 29 to 31). Overall, the condition of a minimal degree of similarity between the marks set out in Article 8(5) EUTMR was fulfilled (para. 22). **The link:** the GC reminded that the types of damage referred to in Article 8(5) EUTMR, where they occur, are the consequence of a connection that the relevant public makes between the marks at issue, that is to say, a link that it establishes between those marks, even though it does not confuse them and that the establishment of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case (para. 42). The GC in particular found that the relevant public could establish a link between the trade marks at issue due to the presence of the following factors: (i) the trade marks at issue were similar, (ii) the **McDONALD’S** trade mark enjoyed a considerable reputation for fast-food restaurant services and that reputation also extended to the combination of the prefix ‘mc’ with the name of a menu item or foodstuff, (iii) the intervener was the proprietor of a family of trade marks, which combined the prefix ‘mc’ with the name of a menu item or foodstuff (the ‘Mc’ family of trade marks), (iv) the contested trade mark reproduced the structure common to the ‘Mc’ family of trade marks and (v) the services and goods covered by the trade marks at issue had a certain degree of similarity owing to the close links existing between them (paras 71 to 86). Therefore, the establishment of such a link, on the part of the relevant public, could entail a transfer of the image of the **McDONALD’S** trade mark or the characteristics associated with that trade mark to the goods covered by the contested trade mark, such that it was highly probable that the applicant took unfair advantage of the



reputation of the **McDONALD’S** trade mark (paras 37 to 46). **The family of marks:** the GC confirmed the BoA’s finding that the existence of the ‘Mc’ family of marks was a factor to be taken into account in assessing the establishment, on the part of the relevant public, of a link between the marks at issue (para. 73). In particular, the GC found that the earlier marks **McMUFFIN**, **McRIB**, **McFLURRY**, **CHICKEN McNUGGETS**, **McCHICKEN** and **EGG McMUFFIN**, derived from the **McDONALD’S** trade mark, fulfilled all the conditions to form a ‘family’ of trade marks for the following reasons: the ‘family marks’ were sufficient in number and reproduced in full the same distinctive element, ‘mc’, with the addition of a word element that differentiates them from each other and they are characterised by the repetition of the same prefix (para. 66). The contested mark had characteristics capable of associating it with the ‘Mc’ family of marks, insofar as (i) that mark began with the prefix ‘mac’ (perceived as almost identical), (ii) the structure of the mark at issue was very similar to that which was common to the ‘Mc’ family of marks and (iii) the prefixes ‘mc’ and ‘mac’ occupied, in the contested mark and in the ‘Mc’ family of marks, the same position and had the same semantic content (para. 66). **The relevant periods:** the GC found that it follows from Article 57(2) EUTMR, read in conjunction with Article 42(2) EUTMR that the periods to be taken into account to establish genuine use of the earlier marks, deriving from **McDONALD’S** mark, are the same periods applied to the latter mark (the original mark, the ‘father’/or mother of the family). The evidence provided by the intervener was sufficient for a finding of actual use on the market of marks combining the prefix ‘mc’ with another word, such as the marks **McFISH**, **McTOAST**, **McMUFFIN**, **McRIB**, **McFLURRY**, **CHICKEN McNUGGETS**, **McCHICKEN**, **EGG McMUFFIN** and **McFEAST**, for fast-food restaurant services and products in the menu of fast-food establishments, in a part of the territory of the European Union. **Taking unfair advantage of the repute:** the GC found that reputation had been acquired by the prefix ‘mc’ combined with the name of a menu item or a foodstuff, for fast-food restaurant services and goods on the menu of fast-food establishments. The BoA was right to conclude that the considerable reputation of the **McDONALD’S** trade mark extended to the characteristic elements of the ‘Mc’ family of trade marks, without having to determine, as submitted by the applicant, whether each of the marks constituting that family was a mark with a reputation. The contested mark reproduces the structure common to the ‘Mc’ family of marks. The BoA was therefore right to find that the existence of a ‘Mc’ family of marks was a key factor to take into account when assessing whether there was an unfair advantage (paras 102 to 104). Therefore, the GC confirmed that there was a serious risk that the relevant public would be able to associate the contested trade mark with the ‘Mc’ family of trade marks and establish a mental link between the marks at issue, so there was a serious likelihood that use of the contested trade mark would take unfair advantage of the reputation of the **McDONALD’S** trade mark (para. 108).

♦[T-567/15](#); **DEVICE OF A BLACK SQUARE WITH FOUR WHITE STRIPES / DEVICE OF THREE VERTICAL WAVY LINES et al.**; Judgment of 14 July 2016; *Monster Energy Company v EUIPO*; Language of the case: EN.

EUTM application	Earlier mark
	

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Class 25. An opposition based on, inter alia, the earlier figurative mark



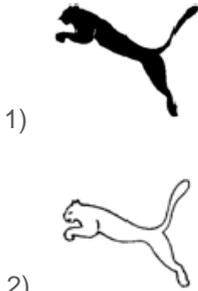
represented above was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The OD dismissed the opposition. The opponent appealed the OD decision. The BoA dismissed the appeal. It found that the differences between the signs clearly outweighed the very low visual similarities between them, even where the goods are identical. As regards the reputation claim, the BoA held that no relevant documents in relation to *clothing* and *headgear* had been provided. Consequently, the appeal was dismissed. The opponent challenged the decision before the GC. **Infringement of Article 8(5) EUTMR:** reputation was claimed by the opponent only for goods in Class 25, consequently the question whether or not that mark enjoys a reputation for goods other than *articles of clothing* and *headgear* is irrelevant. As there is no proof of reputation in relation to goods in Class 25, one of the essential conditions of Article 8(5) EUTMR is not met.

♦[T-429/15](#); **MAD CATZ / MONSTER et al.**; Judgment of 14 July 2016; *Monster Energy Company v. EUIPO*; Language of the case: EN.

EUTM application	Earlier marks
	

The other party to the proceedings sought to register the figurative mark as depicted above for, inter alia, Class 25. The applicant filed an opposition pursuant Article 8(1)(b) and Article 8(5) EUTMR. Both instances of the Office rejected the opposition, since the marks were dissimilar. The applicant filed an appeal before the GC claiming an infringement of Article 8(1)(b) and Article 8(5) EUTMR. As regards the plea based on unfair advantage (Article 8(5) EUTMR), the GC concludes that for the application of Article 8(5) EUTMR the necessary similarity between the marks is not given either and consequently, the BoA was right in dismissing the appeal as to this ground for refusal (paras 44 to 46). The action must therefore be dismissed in its entirety (para. 48).

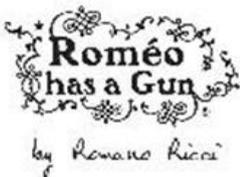
♦♦[T-159/15](#); **DEVICE OF A JUMPING ANIMAL / PUMA et al.**; Judgment of 9 September 2016; *Puma SE v EUIPO*; Language of the case: EN.

EUTM application	Earlier marks
	



The opponent invoked Article 8(5) EUTM and provided, for the purpose of substantiating the reputation of its earlier mark, inter alia (i) references to earlier decisions of the Office recognising the reputation of the earlier mark (i.e. number and date of decision) and short extracts of these decisions, (ii) copies of earlier decisions taken by different national offices/courts as well as (iii) a — non translated — market survey. The OD rejected the appeal without examining the reputation for the opponent’s lack of having established a link between the opposing mark protecting very different goods *specialised machines for treating wood, aluminium and PVC* in Class 7 v goods in Classes 18, 25 and 28 and one of the infringements of Article 8(5) EUTMR. The BoA dismissed the appeal on the basis of the finding that reputation had not been established, confirming furthermore in an *obiter dictum* the OD’s finding as regards the remaining conditions of Article 8(5) EUTMR. It found, in particular, that (i) the Office’s previous decisions invoked by the opponent were not binding, (ii) that the national decisions were not relevant as it was unclear on which evidence these had been adopted and that (iii) the non-translated evidence was to be disregarded in application of Rule 19(3) EUTMR. Before the GC, the opponent claimed, inter alia, a breach of the principles of legal certainty and sound administration in that the BoA had (i) rejected the non-translated evidence and (ii) concluded that the earlier mark’s reputation had not been established despite the fact that the opponent had, in particular, referred to earlier Office decisions recognising such reputation. The GC upheld the appeal. The GC found in application of the CJ’s Technopol judgment (C-51/10 P, paras 74 to 77) that the BoA breached the principle of sound administration in departing — without giving any reasons in this respect or even mentioning them (para. 31) — from the Office’s previous (relatively recent) decisions in which the Office had recognised (on the basis of a detailed analysis of voluminous evidence) the earlier mark’s high degree of distinctiveness as a result of its long standing and intensive use and high degree of recognition (paras 20 and 34). This would be all the more the case as the national decisions invoked by the applicant did confirm the Office’s previous findings as well as in a recent judgment of the GC (para. 32). The GC refused to accept the BoA’s ‘even if’ reasoning according to which none of the infringements under Article 8(5) EUTMR had been established even assuming that the earlier mark had reputation (paras 41 to 42) on the ground that the application of Article 8(5) EUTMR always requires to establish — expressly — the earlier mark’s exact degree of reputation.

♦[T-358/15](#); **Roméo has a Gun by Romano Ricci / NINA RICCI et al.**; Judgment of 15 September 2016; *Arrom Conseil v EUIPO*; Language of the case: EN.

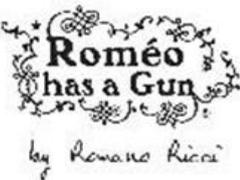
EUTM application	Earlier marks
	<ol style="list-style-type: none"> 1. RICCI 2. NINA RICCI

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 3, 25 and 35. An opposition based on the earlier word marks **RICCI** and **NINA RICCI**, registered for different goods in Class 3, was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The OD rejected the opposition. The BoA partly upheld the opponent’s appeal. It found that the OD wrongly dismissed the opposition against all the contested goods in Classes 3 and 25 and some of the contested services in Class 35.



The applicant filed an action before the GC relying on two pleas in law: (i) infringement of Article 8(1)(b) EUTMR, (ii) infringement of Article 8(5) EUTMR. The GC dismissed the appeal. **On the risk of unfair advantage:** it is undisputed that the earlier mark NINA RICCI enjoys a reputation for *perfumery, in particular perfumes, eau de parfum and eau de toilette not containing alcohol, perfume extracts; cosmetics* in Class 3. The relevant public is likely to make a connection between the marks due to the reputation of the earlier mark **NINA RICCI**, as the contested mark covers goods, and services of presentation of goods, that complement, or are identical to, the goods for which the earlier mark **NINA RICCI** has a reputation. Hence, by taking into consideration this proximity between the goods and services, the degree of similarity between the marks (which was found to be low), and the reputation of the earlier mark **NINA RICCI** (which was found to be reputed as a mark conveying floral, romantic and classical concepts, the same concepts conveyed by the contested mark) the BoA correctly made a global assessment when it concluded that there was a risk that use of the contested mark for those goods and services held to be identical, similar or complementary to the goods for which the earlier mark **NINA RICCI** has a reputation would take unfair advantage of that reputation (paras 64 to 75). The circumstance that Romano Ricci is the name of the legal representative and founder of the applicant is not due cause for the registration and use of the contested mark, as according to the case-law there is no unconditional right to the registration of a surname or first name as an EUTM. Similarly, the applicant does not advance any argument explaining how Mr Romano being a direct descendent of Ms Ricci could constitute due cause for registration (paras 79 to 85).

♦[T-359/15](#); **Roméo has a Gun by Romano Ricci / NINA RICCI et al.**; Judgment of 15 September 2016; *Arron Conseil v EUIPO*; Language of the case: EN.

EUTM application	Earlier marks
	<ol style="list-style-type: none"> 1. RICCI 2. NINA RICCI

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 3, 25 and 35. An opposition based on the earlier word marks **RICCI**, and **NINA RICCI**, registered for different goods in Class 25, was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The OD rejected the opposition. The BoA partly upheld the opponent’s appeal. It found that the OD wrongly dismissed the opposition against all the contested goods in Classes 3 and 25 and some of the contested services in Class 35. The applicant filed an action before the GC relying on two pleas in law: (i) infringement of Article 8(1)(b) EUTMR, (ii) infringement of Article 8(5) EUTMR. The GC dismissed the appeal. **On the risk of unfair advantage:** it is undisputed that the earlier mark **NINA RICCI** enjoys a reputation for *clothing* in Class 25. The relevant public is likely to make a connection between the marks due to the reputation of the earlier mark **NINA RICCI**, as the contested mark covers goods, and services of presentation of goods, that complement, or are identical to, the goods for which the earlier mark **NINA RICCI** has a reputation. Hence, by taking into consideration this proximity between the goods and services, the degree of similarity between the marks (which was found to be low), and the reputation of the earlier mark **NINA RICCI** (which was found to be reputed as a mark conveying floral, romantic and classical



concepts, the same concepts conveyed by the contested mark) the BoA correctly made a global assessment when it concluded that there was a risk that use of the contested mark for those goods and services held to be identical, similar or complementary to the goods for which the earlier mark **NINA RICCI** has a reputation would take unfair advantage of that reputation (paras 67 to 78). The circumstance that Romano Ricci is the name of the legal representative and founder of the applicant is not due cause for the registration and use of the contested mark, as according to the case-law there is no unconditional right to the registration of a surname or first name as an EUTM. Similarly, the applicant does not advance any argument explaining how Mr Romano being a direct descendent of Ms Ricci could constitute due cause for registration (paras 82 to 87).

♦ [T-362/15](#); **HENLEY / HENLEYS**; Judgment of 28 September 2016; *The Lacamanda Group Ltd, established in Manchester (United Kingdom) v EUIPO*; Language of the case: EN. The EUTM proprietor registered the word mark **HENLEY** as an EUTM for goods in Classes 9, 11 and 18. An application for invalidity was filed pursuant to Article 52(1)(a) and Article 53(1) EUTMR, read in conjunction, first, with Article 7(1)(b),(c) and (d) EUTMR and, secondly, Article 8(5) EUTMR. The CD dismissed the application for invalidity/revocation. The BoA dismissed the invalidity applicant's appeal. It found that the contested mark had not been registered in breach of either Article 7(1)(b), (c), or (d) or of Article 8(5) EUTMR. The invalidity applicant filed an action before the GC relying on three pleas in law: (i) infringement of Article 7(1)(c), (ii) Article 7(1)(b) and (iii) Article 8(5) EUTMR. The GC upheld the appeal. It found that, in excluding the application of Article 8(5) EUTMR without examining the earlier mark's reputation, the BoA infringed that provision. The judgment confines itself to the BoA's handling of the claim under Article 8(5) EUTMR. The BoA had excluded Article 8(5) EUTMR without considering it necessary to examine the reputation of the earlier mark. It stressed that the conditions for the application of Article 8(5) are cumulative and pointed out the following shortcomings in the invalidity applicant's case.

- | | |
|-----------------------------------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| (i) Unfair advantage | Failure to establish that the earlier trade mark conveys any image so the BoA is unable to assess whether there would be unfair advantage of an image attributable to the earlier mark. |
| (ii) Detriment to distinctive character | Failure to provide the required prima facie evidence of a change in the economic behaviour of the earlier trade marks' average consumer. |
| (iii) Detriment to repute | Failure to allege that the contested goods have a characteristic or quality that may produce a negative influence on the earlier trade marks' image. |

The BoA concluded that, since the contested EUTM neither takes unfair advantage of the earlier trade marks nor is it detrimental to the earlier trade marks' distinctive character or repute, it was unnecessary to assess the earlier trade marks' reputation. The GC found that the application of Article 8(5) EUTMR 'necessarily requires a 'definitive conclusion' regarding whether or not a reputation exists, which, in principle, means that no analysis regarding the



possible application of that provision can be carried out on the basis of a vague hypothesis, that is to say, a hypothesis that is not based on the acknowledgement of a reputation with a specific level of strength' (para. 22). The GC noted that the BoA neither (i) concluded that the earlier mark enjoyed a reputation nor (ii) made an assumption based on the acceptance of a reputation of a specific strength nor (iii) adopted the detailed analysis which had been carried out by the CD on the earlier mark's reputation. The GC concluded that, in excluding the application of Article 8(5) EUTMR without examining the earlier mark's reputation, the BoA infringed that provision.

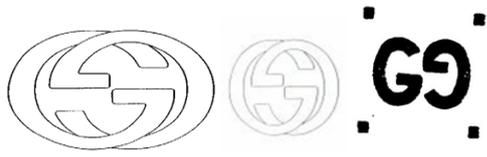
♦[T-430/15](#); **SILVANIA FOOD / SYLVANIA et al.**; Judgment of 30 September 2016; *Flowil International Lighting (Holding) BV v EUIPO — SC Lorimod Prod Com, Srl*; Language of the case: EN.

EUTM application	Earlier mark
	SYLVANIA

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 29, 30 and 35. An opposition based, inter alia, on the earlier EU word mark **SYLVANIA**, covering goods in Classes 9, 10 and 11, (including, in short, *apparatus and installations for lighting; lamps; lamps devices and accessories*), was filed pursuant to Articles 8(1)(b) EUTMR, 8(2)(c) EUTMR read in conjunction with Article 8(1)(b) EUTMR, Article 8(4) EUTMR and Article 8(5) EUTMR. The OD rejected the opposition. The Second BoA dismissed the appeal. The BoA found that there was no likelihood of confusion for the purposes of Article 8(1)(b) EUTMR. It considered that, while the signs at issue were similar overall, the goods and services in question were different, in view in particular of the differences in the nature, purpose and intended use of those goods and services, neither were they in competition with each other or complementary. The BoA also rejected the opposition based on Article 8(5) EUTMR. In that regard, it found that, as the applicant had failed to establish that there was a link between the mark applied for and the earlier rights relied on in support of the opposition, one of the requirements laid down in Article 8(5) EUTMR was not fulfilled. The opponent filed an action before the GC relying on two pleas in law alleging (i) infringement of Article 8(1)(b) EUTMR and (ii) infringement of Article 8(5) EUTMR. The GC dismissed the appeal. As regards the second plea, the GC endorsed the finding of the contested decision that the lack of any similarity between the goods and services at issue and the fact that the earlier marks do not have a strong reputation make it possible to rule out any link between the marks at issue. Given that those goods and services are of a very different nature, it is unlikely that the quality image associated with the goods for which it has been established that the earlier marks have a reputation might be transferred to the foodstuffs or food industry services covered by the earlier marks. Therefore, the GC dismissed the appeal also as far as the second plea of the opponent is concerned (paras 46 to 49).

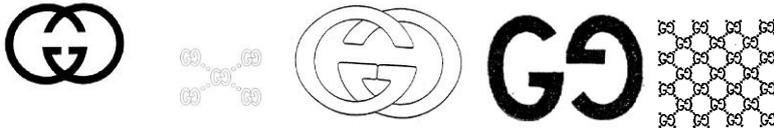


♦[T-461/15](#); **DEVICE OF FOUR INTERLOCKING Gs / GG**; Judgment of 11 October 2016; *Guccio Gucci SpA v EUIPO and Guess? IP Holder LP*; Language of the case: EN.

EUTM	Earlier marks
	

The applicant for invalidity, the owner of the earlier rights, sought to invalidate the mark represented above, registered as an EUTM for goods within Classes 3, 9, 14, 16, 18, 25 and 35. The action for invalidity was based on the earlier marks represented above, registered in the European Union for goods in, inter alia, Classes 3, 9, 16, 18 and 25, and was filed on the grounds of Article 8(1)(b) EUTMR and Article 8(5) EUTMR. The CD rejected the application for invalidity. The BoA dismissed the applicant for invalidity's appeal. The applicant for invalidity filed an action before the GC based on three pleas in law: (i) infringement of Article 75 EUTMR, (ii) infringement of Article 8(1)(b) EUTMR and (iii) infringement of Article 8(5) EUTMR. As regards the third plea, one of the requirements for its application is not fulfilled as the signs at issue are different, where for the application of the Article some similarity needs to exist. The BoA did not infringe that Article either.

♦[T-753/15](#); **DEVICE OF FOUR INTERLOCKING Gs / GG**; Judgment of 11 October 2016; *Guccio Gucci SpA v EUIPO and Guess? IP Holder LP*; Language of the case: EN.

EUTM application	Earlier marks
	

The applicant, sought to register the mark represented above as an EUTM for goods within Class 9. The opposition was based on the earlier marks represented above, registered in the EU for goods in, inter alia, Classes 9, 18 and 25, and was filed on the grounds of 8(1)(b) EUTMR and Article 8(5) EUTMR. The OD upheld the opposition in its entirety. The BoA upheld the applicant's appeal. The opponent filed an action before the GC based on three pleas in law: (i) infringement of Article 75 EUTMR, (ii) infringement of Article 8(1)(b) EUTMR and (iii) infringement of Article 8(5) EUTMR. As regards the third plea, one of the requirements for its application is not fulfilled as the signs at issue are different, where for the application of the Article some similarity needs to exist. The BoA did not infringe that Article either.



♦ [T-407/15](#); **HOTOGO SELF / HEATING CAN TECHNOLOGY-M**; Judgment of 20 October 2016; *Monster Energy Company v EUIPO / Hot-Can Intellectual Property Sdn Bhd*; Language of the case: EN.

EUTM application	Earlier marks
	

The EUTM applicant/intervener sought to register the figurative mark **HOTOGO SELF-HEATING CAN TECHNOLOGY** as an EUTM for goods and services in Class 29, 30 and 33. An opposition based on several earlier figurative EUTMs, registered for goods Classes 5, 25 and 32, was filed pursuant to Article 8(1)(b) and Article (5) EUTMR. The OD dismissed the opposition insofar as the marks were found to be dissimilar. The BoA dismissed the opponent's appeal. It found that the marks at issue were visually, conceptually and phonetically dissimilar. The opponent brought an action before the GC relying on two pleas in law: (i) an infringement of Article 8(1)(b) EUTMR and (ii) an infringement of Article 8(5) EUTMR. Concerning the second plea in law, alleging an infringement of Article 8(5) EUTMR, the GC supported the BoA's conclusion according to which one of the cumulative conditions for applying Article 8(5) EUTMR, namely, the existence of a connection between the sign applied for and the earlier mark, was not satisfied on the ground that the signs were dissimilar overall (para. 67). Consequently there is no likelihood that the relevant public will make a connection between the signs at issue (para. 69). It follows that also the second plea must be rejected (para. 70).

[T-515/12 RENV](#); **The English Cut / EL CORTE INGLES et al.**; Judgment of 27 October 2016; *El Corte Inglés, S.A. v EUIPO*; Language of the case: ES.

EUTM application	Earlier marks
<p>THE ENGLISH CUT</p>	

The intervener sought to register the word mark **THE ENGLISH CUT** as an EUTM for goods in Class 25. An opposition based on the earlier figurative marks represented above, registered for goods and services in Classes 25 and 35, was filed pursuant to Articles 8(1)(b) and Article 8(5) EUTMR. The OD dismissed the opposition and an appeal was submitted by the opponent. The BoA dismissed the appeal. It found that no visual or phonetic similarities existed between the signs, which were just slightly similar under the conceptual point of view. The opponent filed an action before the GC relying on two pleas in law: (i) infringement of Article 8(1)(b) EUTMR and (ii) infringement of Article 8(5) EUTMR. The GC dismissed the



appeal, concluding that the signs presented just a negligible conceptual similarity, which was not sufficient for the Article 8(1)(b) EUTMR to apply. Having found that the signs were neither similar nor identical, and having excluded the likelihood of confusion, the Court also stated that Article 8(5) EUTMR did not apply. The opponent filed an action before the CJEU. The CJ upheld the appeal and found that the GC erred in law in ignoring that the degree of similarity between the signs necessary to apply Article 8(1)(b) and Article 8(5) EUTMR is different. It should have examined whether that degree of conceptual similarity, albeit low, was sufficient, on account of the presence of other relevant factors such as the renown or reputation of the earlier mark, for the relevant public to establish a link between those signs, for the purpose of Article 8(5) EUTMR. The CJ referred back the case for a new assessment of the fulfilment of the requirements laid down by the Article 8(5) EUTMR. **Substance:** the GC emphasised that for the application of Article 8(5) EUTMR the existence of the likelihood of confusion is not required, being sufficient the condition that the relevant public might establish a link between the signs in conflict (para. 30). This article does not request this link to be immediate (para. 46). Indeed, even a slight conceptual similarity would be enough for concluding that the relevant public might establish a relation between the signs or, at least, associate them with each other (para. 47). The slight conceptual similarity existing between the signs was enough for the Article 8(5) EUTMR to apply, but other conditions have to be complied with. The GC underlined that when the earlier mark is exceptionally well-known it might not be necessary to prove why the opposed mark would take unfair advantage of, or be detrimental to, its distinctive character or its reputation (para. 54). However, although the GC recognised the high reputation of the opponent’s earlier marks, such reputation was not considered to be exceptional (para. 55). Therefore, the opponent had to prove specifically that the opposed mark would be detrimental to the distinctive character or the reputation of its earlier signs, but that circumstance remained unproven (para. 55). As a consequence, the GC concluded that the BoA correctly stated that the opposed mark was not detrimental to the earlier marks’ reputation (para. 56) and rejected the plea in law alleging the infringement of the Article 8(5) EUTMR.

[T-123/15](#); **UNICORN-čerpací stanice / UNICORN et al.**; Judgment of 28 October 2016; *Unicorn a.s. v EUIPO*; Language of the case: EN.

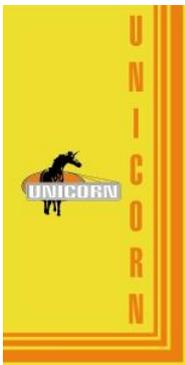
EUTM application	Earlier marks
UNICORN-čerpací stanice	1) UNICORN 2) UNICORN

The applicant sought to register the word mark **UNICORN-čerpací stanice** as an EUTM for goods and services in Classes 4, 35 and 37. An opposition was directed against all goods and services applied for. It was based on the earlier word and figurative marks represented above and registered for goods and services in Classes 9, 16, 35-38, 41 and 42. It was filed pursuant to Article 8(5) EUTMR. The OD partly upheld the opposition. The BoA dismissed the appeal. The opponent filed an action before the GC relying on a single plea in law alleging infringement of Article 8(5) EUTMR. The GC dismissed the appeal. The complaint about the infringement of Rule 22(6) EUTMIR to the extent that the Office did not request the translation of the Czech documents into the language of the proceedings was rejected by the GC. First, Rule 22(6) EUTMIR is applicable as regards proof of use of a trade mark and not to proof of its reputation (para. 23). Second, the applicable Rule 19(3) and (4) EUTMIR require both submission and translation of the evidence of reputation within the time limit set by the Office (paras 24 to 26). The opponent failed to establish reputation of its marks in the



relevant territory. The crucial evidence was either not translated into the language of the proceedings or was missing (paras 40 to 54). The recognition of the company name Unicorn in the Czech Republic cannot make up for the insufficiency of the evidence submitted with the view to proving that the earlier marks have a reputation. Even if a name of a company is known, that recognition is not capable of establishing that the mark of which it is the proprietor, even if it is a ‘house mark’ that is identical to the name of the company, is known to a significant part of the public for the goods and services that it covers (paras 55 to 57).

[T-124/15](#); **UNICORN / UJNICORN et al.**; Judgment of 28 October 2016; *Unicorn a.s. v EUIPO*; Language of the case: EN.

EUTM application	Earlier marks
	<p>1) UNICORN</p> <p>2) UNICORN</p> <p>3) </p> <p>4)  UNICORN</p>

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 4, 35 and 37. An opposition was directed against all goods and services applied for. It was based on the earlier word and figurative marks represented above and registered for goods and services in Classes 9, 16, 35-38, 41 and 42. It was filed pursuant to Article 8(5) EUTMR. The OD partly upheld the opposition. The BoA dismissed the appeal. The opponent filed an action before the GC relying on a single plea in law alleging infringement of Article 8(5) EUTMR. The GC dismissed the appeal. The complaint about the infringement of Rule 22(6) EUTMIR to the extent that the Office did not request the translation of the Czech documents into the language of the proceedings was rejected by the GC. First, Rule 22(6) EUTMIR is applicable as regards proof of use of a trade mark and not to proof of its reputation (para. 23). Second, the applicable Rule 19(3) and (4) EUTMIR require both submission and translation of the evidence of reputation within the time limit set by the Office (paras 24 to 26). The opponent failed to establish reputation of its marks in the relevant territory. The crucial evidence was either not translated into the language of the proceedings or was missing (paras 40 to 54). The recognition of the company name Unicorn in the Czech Republic cannot make up for the insufficiency of the evidence submitted with the view to proving that the earlier marks have a reputation. Even if a name of a company is known, that recognition is not capable of establishing that the mark of which it is the proprietor, even if it is a ‘house mark’ that is identical to the name of the company, is known to a significant part of the public for the goods and services that it covers (paras 55 to 57).



[T-125/15](#); **UNICORN / UNICORN et al.**; Judgment of 28 October 2016; *Unicorn a.s. v EUIPO*; Language of the case: EN.

EUTM application	Earlier marks
	1) UNICORN 2) UNICORN 3)  4)  UNICORN

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 4, 35 and 37. An opposition was directed against all goods and services applied for. It was based on the earlier word and figurative marks represented above and registered for goods and services in Classes 9, 16, 35-38, 41 and 42. It was filed pursuant to Article 8(5) EUTMR. The OD partly upheld the opposition. The BoA dismissed the appeal. The opponent filed an action before the GC relying on a single plea in law alleging infringement of Article 8(5) EUTMR. The GC dismissed the appeal. The complaint about the infringement of Rule 22(6) EUTMIR to the extent that the Office did not request the translation of the Czech documents into the language of the proceedings was rejected by the GC. First, Rule 22(6) EUTMIR is applicable as regards proof of use of a trade mark and not to proof of its reputation (para. 23). Second, the applicable Rule 19(3) and (4) EUTMIR require both submission and translation of the evidence of reputation within the time limit set by the Office (paras 24 to 26). The opponent failed to establish reputation of its marks in the relevant territory. The crucial evidence was either not translated into the language of the proceedings or was missing (paras 40 to 54). The recognition of the company name Unicorn in the Czech Republic cannot make up for the insufficiency of the evidence submitted with the view to proving that the earlier marks have a reputation. Even if a name of a company is known, that recognition is not capable of establishing that the mark of which it is the proprietor, even if it is a 'house mark' that is identical to the name of the company, is known to a significant part of the public for the goods and services that it covers (paras 55 to 57).

[T-201/15](#); **UNICORN / UNICORN et al.**; Judgment of 28 October 2016; *Unicorn a.s. v EUIPO*; Language of the case: EN.

EUTM application	Earlier marks
UNICORN	1) UNICORN 2) UNICORN

The cancellation applicant sought to cancel the word mark **UNICORN**, registered as an EUTM for goods and services in Classes 4, 9 and 37. The CD rejected the application for invalidity pursuant to Article 53(1)(a) EUTMR in conjunction with Article 8(5) EUTMR based on the earlier word and figurative marks represented above and registered for goods and services in Classes 9, 16, 35-38, 41 and 42. The BoA dismissed the appeal. The opponent filed an action before the GC relying on a single plea in law alleging infringement of



Article 8(5) EUTMR. The GC dismissed the appeal. The complaint about the infringement of Rule 22(6) EUTMIR to the extent that the Office did not request the translation of the Czech documents into the language of the proceedings was rejected by the GC. First, Rule 22(6) EUTMIR is applicable as regards proof of use of a trade mark and not to proof of its reputation (para. 22). Second, the applicable Rule 19(3) and (4) EUTMIR require both submission and translation of the evidence of reputation within the time limit set by the Office (paras 23 to 25). The cancellation applicant failed to establish reputation of its marks in the relevant territory. The crucial evidence was either not translated into the language of the proceedings or was missing (paras 40 to 54). The recognition of the company name Unicorn in the Czech Republic cannot make up for the insufficiency of the evidence submitted with the view to proving that the earlier marks have a reputation. Even if a name of a company is known, that recognition is not capable of establishing that the mark of which it is the proprietor, even if it is a ‘house mark’ that is identical to the name of the company, is known to a significant part of the public for the goods and services that it covers (paras 55 to 57).

♦[T-2/16](#); **Pret | A | Diner / PRET A MANGER et al.**; Judgment of 30 November 2016; Pret *K&K Group AG v EUIPO*; Language of the case: EN.

EUTM application	Earlier marks
<p>Pret A Diner</p>	<p>1) </p> <p>2) PRET</p>

The applicant sought to register the figurative mark represented above for goods and services in Classes 29, 30, 35 and 43. An opposition based on the earlier EU figurative mark and the UK word mark represented above, was filed on the grounds of Article 8(5) EUTMR. The OD found that genuine use of the earlier marks had been proved for some of the goods and services in Classes 29, 30 and 43 and upheld the opposition. The BoA upheld the decision of the OD. In its action before the GC, the applicant put forward two pleas in law: (i) an alleged infringement of Articles 42(2) and (3) EUTMR, as well as (ii) an alleged infringement of Article 8(5) EUTMR. The GC dismissed the appeal. Regarding Article 8(5) EUTMR, the GC found that the earlier marks enjoyed a reputation in the UK. The GC confirmed that there was a risk that goods and services covered by the mark applied for may take unfair advantage of the efforts and investments made by the holder of the earlier marks (para. 110). This had been substantiated by the fact that the structure of the **PRET A MANGER** sign or the **PRET** sign — which the BoA noted had practically become household names in the UK — is included in the mark applied for **Pret A Diner** (para. 111).

♦[T-625/15](#); **SPA VILLAGE / Spa**; Judgment of 27 October 2016; *Spa Monopole, compagnie fermière de Spa SA/NV v EUIPO*; Language of the case: FR. The EUTM application **SPA VILLAGE** covers services in Classes 43 (including *bar services, restaurant, hotel*) and 44 (including *beauty treatment*). An opposition is filed by the owner of the Benelux mark **Spa**, which has reputation for mineral water. The opposition was based on Article 8(1)(b) and Article 8(5) EUTMR. The OD upheld the opposition under Article 8(1)(b) EUTMR. The BoA annulled this decision and dismissed the opposition both under Articles 8(1)(b) and Article 8(5) EUTMR. The BoA considered that the goods and services were dissimilar and



that any risk of unfair advantage was ruled out given that the word ‘spa’ has a plurality of meanings, including a descriptive one, the signs have a limited similarity and the goods and services have only a remote connection. The GC annuls the BoA decision under Article (8)(5) EUTMR. The reputation of the earlier mark **Spa** was not challenged and was even already established by the GC case-law (para. 31). The GC finds that the degree of visual and aural similarity between the marks is higher than what the BoA found given that ‘Spa’ is clearly recognisable in the mark applied for (para. 37) and that this term is not descriptive in the context of Class 43 services (para. 38). Conceptually the signs are highly similar because ‘Spa Village’ does not form a logical unit of its own (para. 40). Overall, the degree of similarity between the signs is average, if not high (para. 41). There is therefore a link between the marks. Regarding the similarity between the goods and services, the GC finds that there is a degree of ‘proximity’ between these goods and services, which is strengthened by their complementarity (paras 51 to 54). The GC confirms that, if the uniqueness of a mark is a strong sign of a high distinctive character *per se*, the polysemy of a sign does not, however, impact adversely a mark’s reputation acquired by use (para. 59). The reputed mark **Spa** is associated with an image of health, beauty and purity. Such an image would facilitate the sale of the contested services, which would be perceived as bringing health and well-being (para. 64). The fact that the image of purity is foreign to bar services and hotel services is irrelevant because a mark can be linked with different images and messages and it is enough for Article 8(5) EUTMR to apply if an association of the contested mark with only one of them would facilitate its commercial success (para. 66). Given that the appeal is upheld under Article 8(5) EUTMR, there is no need to examine the plea alleging a violation of Article 8(1)(b) EUTMR.

F. Other issues

♦[T-75/15](#); **ROD / RODI et al.**; Judgment of 21 January 2016; *Rod Leichtmetallräder GmbH v OHIM*; Language of the case: EN.

EUTM	Earlier mark
	

The EUTM proprietor was granted the registration of the figurative mark represented above as an EUTM for goods and services in Classes 3, 12, 35 and 37. An application for invalidity was filed pursuant to Article 53(1)(a) EUTMR in conjunction with Article 8(1)(b) and Article 8(5) EUTMR. The CD upheld the application for invalidity for all goods and services except for those in Class 3, based on an earlier Spanish mark. The BoA dismissed the EUTM proprietor’s appeal. The EUTM proprietor filed an action before the GC based on two pleas in law. Concerning the second plea, namely the infringement of essential procedural requirements as the applicant claims an infringement of Rule 37(b)(ii) and Rule 39(3) EUTMR on the ground that it never received a colour copy of the registration of the earlier mark. Contrary to what the applicant before the GC claimed, the application for a declaration of invalidity was admissible since at the date of filing it contained a colour reproduction of the earlier Spanish trade mark and that colour copy was also present in the observations filed by the invalidity applicant. There was therefore no infringement of essential procedural



requirements (para. 74). Even if the Office had not forwarded the applicant the colour copy of the earlier Spanish trade mark, it is apparent from the certificate of registration of the earlier Spanish trade mark, which certificate was annexed to the application for a declaration of invalidity and sent to the applicant in connection with that application, that the colours of the earlier Spanish trade mark were expressly described therein as follows: ‘blue pantone RAL, 5002, yellow pantone, RAL, 1016, white’. Accordingly, the applicant cannot claim that it did not know that the earlier Spanish trade mark included colours (para. 75).

◆[T-135/14](#); **kicktipp / KICKERS et al.**; Judgment of 5 February 2016; *Kicktipp GmbH v OHIM*; Language of the case: EN. The EUTM applicant sought to register the word mark **kicktipp** as an EUTM for, inter alia, goods in Class 25. An opposition based, inter alia, on the earlier Italian word mark **KICKERS**, registered for goods in Class 25, was filed, inter alia, on the grounds of Article 8(1)(b) EUTMR. The OD upheld the opposition. The BoA dismissed the appeal. The EUTM applicant filed an application before the GC for the annulment of the decision of the BoA relying on two pleas in law: (i) the infringement of Rule 19(1) and (2) EUTMIR; and (ii) infringement of Article 8(1)(b) EUTMIR. Concerning the first plea in law, the Office and the opponent cannot claim that the EUTM applicant’s argument is not sufficiently clear and precise as Rule 19(1) and (2) EUTMIR sets out specific rules and — as far as the Office is concerned — it is for the Office to examine of its own motion whether an opposing party has established the existence, validity and scope of protection of the earlier mark (paras 34 to 40). A teleological interpretation of Rule 19(2) EUTMIR permits the conclusion that what is crucial is that the Office should have available to it reliable ‘proof’ of the existence, validity and scope of protection of an earlier trade mark on which an opposition is based. It follows that an opposing party cannot be required to produce a registration certificate when they are providing a document emanating from the same authority (in this case, a renewal certificate) — which is therefore just as reliable as a registration certificate — which contains all the necessary information (paras 62 to 63). In this respect, the partial translation submitted by the opponent is sufficient since, when an incomplete translation of a document is submitted, the consequence is not that it is possible to reject the document in its entirety, but simply that only the parts that have been translated into the language of the proceedings may be taken into account (para. 83). The BoA was wrong to find that the documents appended to the notice of opposition were sufficient to substantiate the earlier trade mark. Nevertheless, that error cannot justify the GC’s annulling the contested decision, as other documents produced by the opponent within the prescribed period were sufficient to substantiate the earlier trade mark. The GC may not carry out an assessment on which the BoA has not yet adopted a position. However, in the present case, the BoA did in fact examine whether the documents provided by the opponent were sufficient to substantiate the earlier trade mark. Accordingly, the GC is not examining a new issue, but simply modifying its reasoning, by relying on a piece of evidence provided by the opponent not mentioned by the BoA in its reasoning, the Court having obtained the parties’ comments on that piece of evidence by means of a written question (paras 90 to 92).



[T-126/15](#); **Supeco / SUPER COR et al.**; Judgment of 24 May 2016; *El Corte Inglés v EUIPO*; Language of the case: FR.

EUTM application	Earlier mark
	

The applicant sought to register the figurative mark represented above as an EUTM for, inter alia, *auctioneering* and *retail services* in Class 35. An opposition based on the earlier figurative mark represented above registered for goods and services in Class 35, was filed pursuant to Article 8(1)(b) EUTMR. The opponent ticket the case ‘based on part of the goods and services’ in the opposition form and listed the following services: *advertising; business management; business administration; office functions*. The OD partly upheld the opposition, in particular insofar as it was directed against all the contested goods in Class 35. The BoA partially upheld the applicant’s appeal. It found that the OD wrongly upheld the opposition against *auctioneering* and *retail services* in Class 35. The opponent filed an action before the GC relying on one plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. Point V of Communication No 2/12 of the President of the Office of 20/06/2012 concerning the use of class headings in lists of goods and services in [EU] trade mark applications and registrations does not entail that a broad interpretation of those headings also applies to the list of goods and services on which an opposition is based, since opposition proceedings are governed by specific provisions. By virtue of those provisions, a notice of opposition must contain a clear and precise indication of the goods and services on which the opposition is based (para. 21). In fact, according to Rule 15(2)(f) EUTMIR, the notice of opposition must contain the goods and services on which the opposition is based. In this respect, an interpretation of Rule 15(2)(f) EUTMIR by reference to the general scheme and the purpose of the rules of which it forms part shows that the French version of that provision, according to which ‘*l’acte d’opposition doit comporter [...] les produits et services à l’encontre desquels l’opposition est formée*’, results from a clerical error and does not allow for an interpretation of that provision as not requiring the indication of the products and services on which the opposition is based in the notice of opposition (paras 22 to 28). Moreover, the requirements of clarity and precision as introduced by the case-law of the CJ in Case C-307/10, *IP Translator*, also apply to the opponent when it comes to the designation of the goods and services on which the opposition is based (paras 29 to 30). It follows that the circumstance that the services on which the opposition was based as mentioned in the opposition notice *advertising; business management; business administration; office functions* coincided with a Class 35 heading encompassing *auctioneering* and *rental of vending machine* does not allow for the conclusion that the opposition was in fact based on *auctioneering* and *rental of vending machine* (paras 31 to 32). Thus, the BoA correctly compared the contested services only to the services mentioned in the opposition notice (para. 35).

♦[C-309/15 P](#); **real,- / Real mark et al.**; Order of 8 September 2016; *Real Express SRL v EUIPO — MIP METRO Group Intellectual Property GmbH & Co. KG*; Language of the case: EN. The applicant sought to register the figurative mark **real,-** as an EUTM for goods and services, amongst others, in Classes 3 and 35. An opposition based on the earlier figurative marks **Real mark** and **Real lichid**, registered for goods and services in Classes 3



and 35, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition as unfounded. The BoA dismissed the opponent's appeal. The opponent filed an action before the GC who dismissed the appellant's action as partly inadmissible (for lack of clarity and coherence and therefore for failure to satisfy the minimum requirements of Article 44(1)(c) RPGC (1991)) and as partly manifestly unfounded. The opponent filed an action before the CJEU requesting the annulment of the GC's order claiming, in substance, an erroneous application of Article 44(1)(c) RPGC, a violation of the duty to state reasons, violations of Rule 15(2)(h)(iii), Rule 17(1) and (4) and Rules 19 and 20 EUTMIR as well as of the principle of legal certainty. The CJ rejected the appellant's claim according to which the GC erred in law in refusing to accept that the payment of the opposition fee should have entailed its entitlement to the opposition. Rule 17(1) EUTMIR being of a solely procedural nature, it cannot possibly have an impact on the substantiation of the opposition. The CJ found that the GC erred in law in failing to find that the Office itself had erred in law in not rejecting directly the opposition in application of Rule 20(1) EUTMIR but instead forwarded the opponent's observations to the applicant. However, that error in law could not justify the setting aside of the GC's judgment given that (i) it concerned only a procedural provision, not a substantive one, and (ii) the GC had found — without erring in law — that the evidence submitted for the substantiation of the earlier right (ownership of the earlier mark) had been insufficient (paras 70 to 74). Finally, the CJ also confirmed the GC's position that the BoA's discretion to accept belated evidence filed for the purpose of substantiation of an opposition (ownership of the earlier mark) has to be exercised restrictively. This would follow from the fact that Rule 19(2)(a)(ii) EUTMIR is both precise and exhaustive and that the appellant 'was, therefore, deemed to be aware, even before filing its opposition, of the precise documents that it had to produce in support of it' (para. 90). The BoA was thus fully 'entitled not to take into account' the evidence submitted belatedly (para. 91).

[C-223/15](#); **combit Software GmbH-COMBIT / COMMIT**; Preliminary ruling of 22 September 2016; *combit Software GmbH v Commit Business Solutions Ltd.*; Language of the case: DE. This request for a preliminary ruling was made in proceedings between *combit Software GmbH*, proprietor of the German and EU word marks **combit** for goods and services in the computer industry, on the one hand, and *Commit Business Solutions Ltd.*, who was selling software bearing the word sign **Commit** in a number of countries including Germany, on the other hand. The proprietor of the earlier mark sought an order for the applicant to refrain from using, in the EU, the word sign **Commit** for the software it was marketing. In the alternative, it requested, in reliance on its German trade mark, an order that the applicant refrain from using that word sign in Germany. The *Landgericht Düsseldorf* (Regional Court) dismissed the applicant's principal claim but upheld its alternative claim. The applicant brought an appeal before the *Oberlandesgericht Düsseldorf* (Higher Regional Court) regarding its principal claim. The appeal court concluded that there is a likelihood of confusion in the German-speaking Member States and there is NO LOC in the English-speaking Member states, since that part of the public is capable of identifying an important conceptual difference between the signs, as 'commit' has a clear meaning in English and 'combit' is made up of two usual terms in the computer industry ('com' for computer and 'bit' for 'binary digit'). The appeal court decided to stay the proceedings and refer it to the CJEU for a preliminary ruling: **Question referred to the CJ:** how Article 1(2), Article 9(1)(b) and Article 102(1) EUTMR must be interpreted where an EUTM court finds that the use of a sign creates a likelihood of confusion with an EUTM in one part of the EU whilst not creating such likelihood of confusion in another? (para. 23) **Answer of the CJ:** when the use of a sign creates, in one part of the EU, a likelihood of confusion with an EUTM, whilst, in another part of the Union, that same use does not give rise to such a likelihood of confusion, the court must find that the function of the trade mark as an indication of origin is adversely affected and, therefore, there is an



infringement of the exclusive right conferred by the mark (para. 25). However, the court **must limit** the territorial scope of prohibition in the part of the EU where there is NO LOC, in particular for linguistic reasons (para. 31). The defendant must submit the arguments and evidence of NO LOC in a certain area, so that legitimate trade arising from the use of the contested sign in that part of the EU cannot be prohibited. As observed by the Advocate General (AG), such prohibition would go beyond the exclusive right conferred by the EUTM (para. 32). Without prejudice of the unitary character of the EUTM, Article 1(2), Article 9(1)(b) and Article 102(1) must be interpreted as meaning that, where an EUTM court finds that the use of a sign creates a likelihood of confusion with an EUTM in one part of the EU but not in another part thereof, the EUTM court must conclude that there is an infringement of the exclusive right conferred by the EUTM and issue an order prohibiting the use in question for the entire area of the European Union **with the exception of the part for which there has been found to be NO LOC** (para. 36).

♦[T-400/15](#); **CITRUS SATURDAY / CITRUS**; Judgment of 28 September 2016; *Ana Isabel Pinto Eliseu Baptista Lopes Canhoto v EUIPO*; Language of the case: EN. The applicant sought to register the word mark **CITRUS SATURDAY** as an EUTM for goods in, inter alia, Class 25. An opposition based on the earlier word mark **CITRUS** registered for goods in Class 25, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition as unsubstantiated as the opponent had not submitted a translation of the certificate of registration of the earlier mark into the language of the proceedings within the period prescribed for that purpose. The translation reached the Office on 21 May 2014 although the time limit expired on 12 May 2014. The BoA dismissed the opponent's appeal. It found that the OD had correctly rejected the opposition as unfounded pursuant to Rule 20(1) EUTMIR. The opponent filed an action before the GC relying on two pleas in law: (i) infringement of Rules 19 and 20 EUTMIR and of Article 76 EUTMR and (ii) infringement of Article 21, Article 41(1) and Article 47 of the Charter of Fundamental Rights of the European Union and of Article 18 TFEU. **Regarding the infringement of Rules 19 and 20 EUTMIR and of Article 76 EUTMR:** the opponent argued that the translations in question, that is, certificate of registration of the earlier mark should have been regarded as admissible evidence, given that (i) they had been sent before the expiry of that period, (ii) the context in which they had been submitted [a delay on the part of the postal services] justified the delay in their being received by the Office and (iii) the BoA should, in any event, have proceeded to examine those documents of its own motion pursuant to Article 76 EUTMR. Firstly, the GC found that the fact that the translations were sent within the prescribed period, is irrelevant, given that only the receipt of those documents by the Office is to be taken into account (para. 22). The interpretation that it is the date on which a document is filed with the Office that is to be taken into account is consistent with the general scheme of the EUTMR and EUTMIR (para. 25). Secondly, the submission of facts and evidence by the parties in relation to substantiation remains possible after the expiry of the relevant time limits under EUTMR and the Office is in no way prohibited from taking account of facts and evidence that are submitted late (paras 29 to 30). Nevertheless, where an opposition is based on an earlier national registered trade mark, the evidence of the existence, validity and scope of protection of that mark, which must be submitted during the opposition proceedings, is set out precisely and exhaustively in Rule 19(2)(a)(ii) and Rule 19(3) EUTMIR, so that an opponent is in a position to be aware of the specific documents that it must produce in support of that opposition. Consequently, the BoA must, in those circumstances, exercise its discretion restrictively and may allow the late submission of such documents only if the surrounding circumstances are likely to justify the delay that has occurred in the submission of proof (para. 33). The circumstances surrounding the late receipt of the documents in question — even considering postal delays — did not constitute a legitimate reason capable of justifying the submission of



the documents after the expiry of the period prescribed for that purpose. In particular, the circumstances did not constitute exceptional circumstances capable of interrupting or disrupting the proper functioning of the Office for the purposes of Rule 72 EUTMIR (para. 34). Thirdly, as regards the opponent's assertion that the BoA infringed Article 76(1) EUTMR by refusing to examine the facts of its own motion. In that regard, it is sufficient to note that it is apparent from that provision that the obligation for the Office to examine facts of its own motion is restricted to relevant facts that could lead to it applying absolute grounds for refusal to the examination of an EUTM application carried out by the examiners and, on appeal, by the BoA during the procedure for the registration of that mark. However, in the context of opposition proceedings, it is for the proprietor of the earlier trade mark to prove the existence, validity and scope of protection of that mark (para. 38). In any event, it should be borne in mind that the opponent also had the possibility of sending the Office the proof in question by personal delivery, by fax or by any other means, including electronically, so that an alleged discrimination on grounds of nationality, connected with the delivery times for communications sent by post, is excluded (para. 52).



IV. Proof of Use

♦[T-846/14](#); **SPOKEY / SPOOKY**; Judgment of 21 January 2016; *Spokey sp. z o.o. v OHIM*; Language of the case: PL. The EUTM proprietor was granted the registration of the figurative mark **SPOKEY**. An application for invalidity was filed based on the earlier trade mark word mark **SPOOKY**. The CD partly upheld the application for invalidity and declared the contested EUTM partially invalid by finding that there was a likelihood of confusion as regards the goods in Class 18. The BoA confirmed this decision. The applicant filed an action before the GC. It claimed infringement of Article 75 and 76 EUTMR and of Article 8(1)(b) EUTMR. As regards the applicant's argument that the BoA was wrong to disregard the evidence relating to its distribution methods and actual use of the mark on the goods, the GC recalled that the assessment of the likelihood of confusion is a legal question (para. 26) and that the comparison of goods has to be made by reference to the goods for which the conflicting marks are registered (unless proof of use is at stake, duly requested before the first instance, para. 27). Here, the BoA was right to find the request for proof of use inadmissible and to compare the goods as on the register (para. 28). The BoA was also right to disregard the evidence relating to the actual use of the contested mark (para. 29).

♦[T-171/13](#); **MOTOBI B PESARO**; Judgment of 2 February 2016; *Benelli Q.J. Srl v OHIM*; Language of the case: EN. In 2001 The EUTM proprietor registered the figurative mark **MOTOBI B PESARO** as an EUTM for goods in Classes 9, 12 and 25. In 2009, an application for revocation of the EUTM for these goods was filed on the grounds of Article 51(1)(a) EUTMR. The CD revoked the EUTM. The BoA dismissed the appeal. The EUTM proprietor filed an application before the GC for the alteration or annulment of the decision of the BoA. The BoA expressly referred to the evidence concerning *motorcycles* falling within Class 12, took it into consideration, analysed it, and stated why it did not give any further adequate information concerning the extent of use of the mark at issue during the relevant period. It follows that the EUTM proprietor's complaint that the evidence was not taken into consideration is ineffective in this respect (paras 33 to 34). As for goods falling within Classes 9 and 25, it is apparent from the various language versions that the additional or supplementary facts or evidence (Articles 50(1) and Article 76(2) EUTMR), must supplement facts or evidence already submitted. In the present case, the evidence filed before the CD relating to the Class 25 clothing items was obviously irrelevant since it did not concern the trade mark at issue. Moreover, the figurative aspects shown were scarcely legible, and no evidence at all had been submitted as regards the Class 9 goods, with the result that the evidence produced for the first time before the BoA had to be declared inadmissible (paras 35 to 62).

♦[T-638/14](#); **FRISA / Frinsa F**; Judgment of 8 April 2016; *Frinsa del Noroeste v EUIPO*; Language of the case: ES. The EUTM applicant sought to register the figurative mark **FRISA** for goods in Class 3. An opposition based on Articles 8(1)(b) EUTMR was filed on the basis of the figurative EUTM **Frinsa F** represented above. The OD partially upheld the opposition after finding that genuine use for some products had been proved. The BoA annulled the decision of the OD and considered that no genuine use of the earlier mark had been proved. Single plea before the GC: infringement of Article 42(2) EUTMR. The GC confirms that, if proof of genuine use is requested, the requirements are not softened in the case of reputed or well-known marks (para. 35). Documents dated after the relevant period must be taken into account and globally appraised with the evidence dated within the relevant period, as they may prove an effective commercial exploitation of the earlier mark (para. 38) **but only if**



some evidence dated within the relevant period has been filed (para. 39). Although only two adverts and two books are dated within the relevant period, the BoA should have decided whether this evidence, as corroborated by the post-dated proof, allowed to conclude that genuine use had been proved (para. 42). The BoA erred in denying any probative value to the two adverts (paras 52 to 56), even though they referred to a very limited period of a few days within the relevant 5-year period (para. 54). The BoA also erred in stating that two promotional books did not provide any information about the commercial activity linked to the relevant products during the 5-year period (para. 57). The BoA should have also examined post-dated evidence in order to find out whether it corroborated the proof of use contained in the two adverts and the two promotional books dated within the relevant period (para. 59).

[T-20/15](#); **PICCOLOMINI / PICCOLO**; Judgment of 14 April 2016; *Henkel & Co. Sektkellerei KG v EUIPO*; Language of the case: EN. The applicant sought to register the word mark **PICCOLOMINI** as an EUTM for goods within Class 33. An opposition based on the earlier word mark **PICCOLO** registered as an EUTM for goods and services in Classes 33 and 42, was filed on the grounds of Article 8(1)(b) EUTMR. Upon request of the applicant, the opponent submitted proof of use of the earlier right, pursuant to Article 42(2) EUTMR. The OD found that the earlier mark had been genuinely used for all the goods and services for which it is registered, and upheld the opposition on the grounds of Article 8(1)(b) EUTMR. The BoA upheld the applicant's appeal and annulled the opposition decision on the basis that genuine use of the earlier mark had not been proven. The BoA dismissed the opposition pursuant to Article 42(2) EUTMR. The opponent filed an action before the GC. The GC confirmed that no genuine use of the earlier mark was found. The GC agreed with the BoA's findings that regardless of whether consumers understood the meaning of the term 'piccolo', the way in which the earlier mark had been used on the applicant's bottles of sparkling wine and on the product folders and invoices did not make it possible to conclude that that mark had been used as a trade mark (paras 39 and 42). Genuine use of a trade mark may be held to exist only where that mark is used to guarantee the identity of the origin of the goods or services for which it was registered (para. 42). Moreover, contrary to the applicant's argument, the GC confirms that the BoA did not in any way rule on whether there were absolute grounds precluding the earlier mark from being registered or from being valid, but confined itself to assessing whether that mark had been genuinely used in accordance with its essential function (paras 50 and 58) for the purposes of Article 42(2) EUTMR. The BoA correctly confined itself to finding that the evidence provided showed that the earlier mark had been used by the applicant in a descriptive manner, namely in order to describe a bottle of a certain size (para.59).

◆ [T-322/14](#) and [T-325/14](#) (joined cases); **mobile.de / mobile**; Judgments of 12 May 2016; *mobile.international GmbH v EUIPO*; Language of the cases: DE. The owner of the earlier figurative Bulgarian trade mark **mobile** represented above (Classes 35 and 42) filed a request for invalidity against the EUTMs **mobile.de** (word mark/figurative mark, Class 35 et al.) represented above, pursuant to Article 53(1)(a) in conjunction with Article 8(1)(b) EUTMR. Upon request from the EUTM proprietor, the invalidity applicant provided evidence of genuine use of its mark. The CD rejected the invalidity request in its entirety as it deemed genuine use of the earlier mark not proven, particularly regarding the extent of use. The invalidity applicant, before the BoA filed further evidence of use (81 invoices). The BoA considered the further evidence as 'additional', took it into account and accepted genuine use of the earlier mark for *advertising in connection with vehicles*. Consequently, the BoA annulled the CD decision and referred the case back to the CD for further examination as regards likelihood of confusion. The EUTM proprietor filed an application before the GC,



requesting the annulment of the BoA's decision. It raised a total of seven pleas in law, amongst which the following: i) The evidence filed before the BoA was not 'additional', but 'new' (Rule 22(2)/Rule 40(6) EUTMR); ii) The BoA misapplied its discretion to take into account the further evidence (Article 76(2) EUTMR); iii) The BoA should have examined whether the 'Declarations' the invalidity applicant submitted — inter alia — for proving genuine use, have a 'similar effect under National (Bulgarian) law' as sworn/affirmed statements (Article 78(1)(f) EUTMR); iv) The use of the earlier mark alters the distinctive character of the registration (Article 15(1)(a) EUTMR). Concerning iii), the 'Declarations' submitted before the CD have the character of affirmed statements, as they state that the signee is aware of the legal consequences according to Bulgarian law. Therefore, the BoA was not obliged to examine potential 'similar effects' under national (Bulgarian) law (paras 46 to 50). Concerning iv) the different ways the earlier trade mark was used differ from the registered form mainly in an additional dot, followed by the additional letter sequence 'bg'. Even though the additional element '.bg' confers an additional message, it does not alter the fact that the relevant public will perceive it merely as a reference to a (Bulgarian) top-level domain, and, thus, as a weak element. The element 'mobile' is the dominant element of the earlier mark, which determines its distinctive character (paras 57 to 59). As regards the use of the figurative form 'mobilen.bg', it needs to be pointed out, that 'mobilen' is the Bulgarian synonym for 'mobile' and thus, does not alter the distinctive character of 'mobile' (para. 60). Based on the foregoing the actions were dismissed.

♦[T-789/14](#); **MEISSEN / MEISSEN et al.**; Judgment of 14 June 2016; *Staatliche Porzellan-Manufaktur Meissen GmbH v EUIPO*; Language of the case: DE. An opposition was filed against the EUTM application **MEISSEN**, applied for goods in Classes 11, 19 and 20. The opposition was based on the earlier word marks **MEISSEN**, **MEISSENER PORZELLAN**, **HAUS MEISSEN** and the figurative mark **Meissen**, registered for goods and services in Classes 3, 8, 11, 14, 16, 18, 19, 21, 24, 28, 29, 30, 32, 33, 34, 36, 41, 42 and 43. The grounds of opposition were Article 8(1)(b) and Article 8(5) EUTMR. Upon request the opponent had to provide proof of use for some of the earlier marks. The OD partly upheld the opposition, namely for the goods in Classes 11 and 19 and rejected the opposition as regards the goods in Class 20. Upon appeal by both parties, the BoA annulled the OD's decision in as far as the OD had upheld the opposition for Classes 11 and 19. The BoA found that there is no likelihood of confusion between any of the marks. As regards Article 8(5) EUTMR the BoA held that neither a link between the signs nor a risk of injury had been proven by the opponent. The opponent filed an action before the GC. The GC dismissed the appeal. As regards proof of use the GC held that the applicant merely claimed a misinterpretation of the evidence submitted, without, however, pointing out any specific errors of the BoA's detailed analysis (paras 26 to 33).

[T-614/14](#); **KULE / CULE**; Judgment of 16 June 2016; *Fútbol Club Barcelona v EUIPO*; Language of the case: EN. The EUTM applicant sought to register the word mark **KULE** for goods in Classes 14, 18 and 25. An opposition based on the earlier Spanish registration for the word mark **CULE** was filed pursuant to Article 8(1)(b) EUTMR. The applicant requested proof of use. The evidence of use filed by the opponent showed that the word **CULE** is used to denote a supporter or player of FC Barcelona. The OD considered that there was no trade mark use in relation to the goods concerned (Class 14, 18 and 25). The BoA dismissed the appeal. It confirmed the OD's findings on proof of use. As to additional evidence filed before the BoA, it was considered that it cannot be taken into account. The BoA took the view that (i) no proof of use was submitted within the original time limit, and (ii) in any event the evidence submitted late did not prove genuine use. The opponent filed an action before the



GC. It claimed infringement of Article 8(1)(b) EUTMR and of Article 42(2) EUTMR. It challenged the BoA's rejection of new evidence and criticised its assessment of evidence. In the first place the GC considered the opponent's challenge to the BoA's refusal of new evidence. The GC observed that BoA referred to the fact that the evidence was submitted at the late stage of the proceedings and it was not actually relevant to the outcome of the case as it did not provide any indication concerning the place, time or extent of use of the earlier trade marks in relation to the goods in question. By doing this, the BoA effectively exercised its discretion, providing a statement of reasons for refusing new evidence (paras 28 to 30). As regards the assessment of the evidence of use filed within the original time limit, GC confirmed the BoA's findings. The opponent submitted extracts from dictionaries and various printouts from websites dedicated to football, which show that the term 'CULE' denotes a supporter or player of FC Barcelona and it is used in this meaning (para. 43 to 45). The evidence did not show use of the mark in relation to the goods concerned (para. 44 to 46). Uncertainty of Wikipedia-based evidence was also recalled (para. 47). The GC confirmed that the evidence filed did not show use of **CULE** in relation to the goods concerned.

♦[C-295/15](#); **ARKTIS**; Order of 22 June 2016; *Matratzen Concord GmbH v EUIPO*; Language of the case: DE. The applicant before the GC requested the revocation for non-use according to Article 51(1)(a) EUTMR of the EUTM **ARKTIS**, registered for goods in Classes 20 and 24. The CD revoked the mark partially for the goods in Class 20. It found that for the goods in Class 24 the EUTM had been used. The BoA confirmed the First Instance decision. The GC examined if the use is to be considered as genuine and stated that the volume of 3 490 *pillows and sleeping bags* (Class 20) confirms the position of the BoA that this constitutes a sufficient volume of use and cannot be considered as token use. The claim that the addition of the term 'line' would alter the distinctive character of the sign as used was rejected by the GC. This expression will also be understood in Germany, where the mark has been used, in the sense of product line. The GC also quoted the case-law (judgments of 12/01/2000, T-19/99, *Companyline*, EU:T:2000:4; 22/05/2012, T-273/10, *O•live*, EU:T:2012:246). The addition is subordinated and the term 'ARKTIS' is dominant. The statement that the mark has been used by another company without consent of the proprietor was dismissed. The GC confirmed the case-law that from the fact that the proprietor has the information referring to the use of another company it may be inferred that such use has been done with its consent. Procedure before the CJ: the CJ applied Article 181 RPCJ according to which a manifestly inadmissible or manifestly unfounded appeal may be dismissed by reasoned order (paras 16 and 17). **The issue of consent:** the appellant puts forward that the GC erred when it stated in paragraph 44 that the appellant failed to contest the consent by the trade mark owner to use the mark by a third party. The CJ states that this reasoning is just an additional reason. Possible errors in additional reasoning do not have any impact in the operative part of the judgment and may not lead to its annulment. In any event, the GC was fully right to uphold the genuine use of the trade mark. According to constant case-law the proprietor would not be in possession of the evidence of use by a third party, unless it consented to it. Consequently, the proprietor's consent is implicit (paras 32 to 35). **Alteration of the distinctive character:** finally, the appellant puts forward that the use of 'Arktis line' alters the distinctive character of the mark as registered and the GC did not reason the rejection of this argument by wrongly referring to the case-law in the judgments of 12/01/2000, T-19/99, *Companyline*, EU:T:2000:4; 22/05/2012, T-273/10, *O•live*, EU:T:2012:246; 11/04/2014, T-209/13, *Olive line*, et al., EU:T:2014: 216 (para. 42). The CJ states that the appellant failed to explain why the conclusion in those judgments relating to the protectability of a mark may not be applicable to the examination if the mark as used does alter the distinctive character of a mark as registered. For this assessment it must be examined if the additional element



'line' is descriptive and consequently the BoA and the GC could validly rely on those judgments. Therefore, this plea is unfounded (paras 43 to 45).

♦[T-96/15](#); **Alfredo alla Scrofa / L'ORIGINALE ALFREDO**; Judgment of 6 July 2016; *Mario Mozzetti v EUIPO*; Language of the case: IT. The EUTM proprietor was granted the registration of the figurative mark **Alfredo alla Scrofa** as an EUTM for goods and services in Classes 30 and 43 (*pasta* and *restaurant services*). An application for invalidity based on the earlier Italian word mark **L'ORIGINALE ALFREDO** for goods and services in Classes 30 and 43 was filed pursuant to Article 53(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR. The CD upheld the application for invalidity. The BoA dismissed the EUTM proprietor's appeal. It found that there was a likelihood of confusion between the conflicting marks. The EUTM proprietor filed an action before the GC claiming firstly that the BoA erred in finding inadmissible the request of proof of use of the earlier mark because it was filed for the first time before the BoA; secondly, the EUTM proprietor claimed that the BoA erred in finding a likelihood of confusion between the marks at issue. **On the request of proof of use:** the GC confirmed the finding of the BoA that the EUTM proprietor did not file any request of proof of use during the cancellation proceedings since it only criticised the evidence filed spontaneously by the other party for proving reputation of the earlier mark or other factors such as the use of a non-registered mark. In addition, the other party did not interpret the EUTM proprietor's submissions in the cancellation proceedings as a request for showing genuine use of the earlier mark. An effective request of proof of use was filed only before the BoA and it was, therefore, inadmissible as correctly held in the contested decision (paras 20 to 25).

♦[T-97/15](#); **ALFREDO'S GALLERY alla Scrofa Roma / L'ORIGINALE ALFREDO**; *Mario Mozzetti v EUIPO*; Judgment of 6 July 2016; Language of the case: IT. The EUTM proprietor was granted the registration of the figurative mark **ALFREDO'S GALLERY alla Scrofa Roma** as an EUTM for goods and services in Classes 30 and 43 (*pasta* and *restaurant services*). An application for invalidity based on the earlier Italian word mark **L'ORIGINALE ALFREDO** for goods and services in Classes 30 and 43 was filed pursuant to Article 53(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR. The CD upheld the application for invalidity. The BoA dismissed the EUTM proprietor's appeal. It found that there was a likelihood of confusion between the conflicting marks. The EUTM proprietor filed an action before the GC claiming firstly that the BoA erred in finding inadmissible the request of proof of use of the earlier mark because it was filed for the first time before the BoA; secondly, the EUTM proprietor claimed that the BoA erred in finding a likelihood of confusion between the marks at issue. **On the request of proof of use:** the GC confirmed the finding of the BoA that the EUTM proprietor did not file any request of proof of use during the cancellation proceedings since it only criticised the evidence filed spontaneously by the other party for proving reputation of the earlier mark or other factors such as the use of a non-registered mark. In addition, the other party did not interpret the EUTM proprietor's submissions in the cancellation proceedings as a request for showing genuine use of the earlier mark. An effective request of proof of use was filed only before the BoA and it was, therefore, inadmissible as correctly held in the contested decision (paras 20 to 25).

♦[T-431/15](#); **FRUIT**; Judgment of 7 July 2016; *Fruit of the Loom, Inc. v EUIPO*; Language of the case: EN. The EUTM proprietor was granted the registration of the word mark **FRUIT** as an EUTM for goods in Class 25. An application for revocation was filed pursuant to Article 51 EUTMR. The CD upheld the application for revocation. The BoA dismissed the EUTM



proprietor's appeal. It upheld the findings of the CD regarding lack of genuine use of the contested mark, inter alia, as a stand-alone trade mark in preparatory works for the launch of the 'Born in the USA' range. The EUTM proprietor filed an action before the GC, contesting paragraphs 33 to 43 of the contested decision, namely those in which the BoA considered whether there had been genuine use of the stand-alone trade mark **FRUIT**. The GC upheld the appeal and annulled the BoA decision. **Single plea: infringement of Article 15(1) EUTMR:** the BoA concluded that there had been no genuine use on the basis of two lines of reasoning: (i) in the market size of the European Union market, as regards goods such as those in the present case, it was necessary to adduce and prove commercial acts aimed at end consumers in order to establish genuine use of a mark; commercial acts aimed exclusively at professionals from the sector concerned are insufficient for that purpose; (ii) it was evident that the contested mark had not been 'objectively present on the market in a manner that was effective and consistent over time' (paras 40 to 43). The GC held that outward use of a mark does not necessarily mean use aimed at end consumers. It is common and even necessary to direct commercial acts at professionals in the sector concerned and particularly at resellers. The BoA was not entitled to rule out the genuineness of the use solely because the commercial acts invoked by the applicant were not directed to end consumers (paras 48 to 51). The BoA erred, in the present case, in taking into account, when assessing the genuineness of that use, the subsequent decision of the applicant to stop the launch of the goods on which the mark at issue was affixed on the ground that that decision resulted in those goods never being offered for sale to end consumers (para. 57). The second line of reasoning lacks a specific analysis of the evidence and fails to give proper considerations to practices of marking that are specific to the clothing sector (paras 75 to 80). While it is true that there is a functional continuity between the CD and the BoAs, the decision of the CD does not contain any assessment of the evidence submitted by the applicant beyond a number of mere assertions; therefore the fact that the BoA confirmed the conclusions of the CD is irrelevant in the present case (paras 81 to 83). Finally, the Office's analysis filed before the GC for the first time must be considered as a belated attempt to state reasons for the contested decision (para. 84). The action is upheld and the BoA decision annulled.

♦[T-345/15](#); **KRISTAL / HOME CRISTAL**; Judgment of 14 July 2016; *Modas Cristal, S.L. v EUIPO*; Language of the case: ES. The EUTM applicant sought to register the figurative mark **KRISTAL** for goods and services in Classes 24, 26 and 35. An opposition based on the earlier word mark **MODA CRISTAL**, registered for services in Class 35 and the figurative mark **HOME CRISTAL**, registered for goods in Class 24, was filed on the grounds of Article 8(1)(b) EUTMR. The OD dismissed the opposition. It found that the use of the earlier word mark was not proven and there was no likelihood of confusion between the contested sign and the earlier figurative mark. The BoA dismissed the opponent's appeal. The opponent filed an action before the GC raising two pleas in law: (i) breach of Article 42(2) and (3) EUTMR and (ii) breach of Article 8(1)(b) EUTMR. The GC dismissed the appeal. As regards the first plea, the GC found that the documents produced by the opponent as proof of use (POU) of the earlier mark submitted for the first time before the GC are inadmissible. It confirmed the BoA assessment on POU. Affidavits are admissible means of POU, however as they have a limited probative value, further evidence is necessary to establish use. The evidence filed shows the use of the denomination Modas Cristal S.L. as a business name, which identifies a company with activity in the textile industry, but not as a trade mark. From the documents submitted it is impossible to confirm that the opponent renders services in Class 35 under the earlier trade mark.



♦[C-224/14 P](#); **LIDL / LIDL MUSIC et al.**; Order of 6 September 2016; *Lidl Stiftung & Co. KG v EUIPO — Lidl Music spol. s r.o.*; Language of the case: EN. The GC had dismissed the appellant's claims based on Article 8(1)(b), Article 15(1), Article 15(1)(a) and Article 42(2) and (3) EUTMR. The appellant requested the annulment of the GC's judgment putting forward three pleas in law, alleging, in essence, first, infringement of the combined provisions of Article 42(2) and (3) EUTMR and Rule 22(3) and (4) EUTMR, in conjunction with Article 15(1) EUTMR that there was genuine use of the earlier mark; secondly, infringement of Article 15(1)(a) EUTMR in conjunction with Article 42(2) and (3) EUTMR, on the ground that the BoA had erred in finding that the use of the earlier mark in a form that differed from the form in which it was registered constituted genuine use for the purposes of Article 15(1) EUTMR; and, thirdly, infringement of Article 8(1)(b) EUTMR, on the ground that the BoA had erred in finding that there was a likelihood of confusion between the marks at issue. The CJ dismissed the appeal. **Article 15(1)(a) in conjunction with Article 42(2) and (3) EUTMR:** by its second ground of appeal, the appellant submits that the GC erred in law in holding that the use of the mark as shown in the photographs was not likely to alter the distinctive character of the earlier mark as registered. The CJ firstly dismissed as manifestly unfounded the appellant's argument that Article 15(1)(a) EUTMR is an exception to be applied strictly. Secondly, the CJ found that, although the GC did not specifically list each of the figurative elements in the judgment under appeal, it is nevertheless apparent from an overall reading of that judgment that the GC's assessment relates to all of the figurative elements of the earlier mark (paras 39 to 42). Moreover, the fact that the GC arrived at a different conclusion from the appellant as regards the conditions for the application of Article 15(1)(a) EUTMR does not, in itself, show that that Court erred in law (para. 43). Finally, inasmuch as the appellant seeks to show that the figurative elements of the earlier mark have a decisive influence on the distinctive character of that mark as registered, the appellant is seeking, in actual fact, to request that the Court carry out a new assessment of the facts and evidence without, however, showing, or even claiming, that there has been any distortion of those facts and that evidence. Therefore, the CJ rejected that line of argument as manifestly inadmissible (para. 44).

♦[C-237/14 P](#); **LIDL express / LIDL MUSIC et al.**; Order of 6 September 2016; *Lidl Stiftung & Co. KG v EUIPO — Lidl Music spol. s r.o.*; Language of the case: EN. The GC had dismissed the appellant's claims based on Article 8(1)(b), Article 15(1), Article 15(1)(a) and Article 42(2) and (3) EUTMR. The appellant requested the annulment of the GC's judgment putting forward three pleas in law, alleging, in essence, first, infringement of the combined provisions of Article 42(2) and (3) EUTMR and Rule 22(3) and (4) EUTMR, in conjunction with Article 15(1) EUTMR that there was genuine use of the earlier mark; secondly, infringement of Article 15(1)(a) EUTMR in conjunction with Article 42(2) and (3) EUTMR, on the ground that the BoA had erred in finding that the use of the earlier mark in a form that differed from the form in which it was registered constituted genuine use for the purposes of Article 15(1) EUTMR; and, thirdly, infringement of Article 8(1)(b) EUTMR, on the ground that the BoA had erred in finding that there was a likelihood of confusion between the marks at issue. The CJ dismissed the appeal. **Article 15(1)(a) in conjunction with Article 42(2) and (3) EUTMR:** by its second ground of appeal, the appellant submits that the GC erred in law in holding that the use of the mark as shown in the photographs was not likely to alter the distinctive character of the earlier mark as registered. The CJ firstly dismissed as manifestly unfounded the appellant's argument that Article 15(1)(a) EUTMR is an exception to be applied strictly. Secondly, the CJ found that, although the GC did not specifically list each of the figurative elements in the judgment under appeal, it is nevertheless apparent from an overall reading of that judgment that the GC's assessment relates to all of the figurative elements of the earlier mark (paras 39 to 42). Moreover, the fact that the GC arrived at a



different conclusion from the appellant as regards the conditions for the application of Article 15(1)(a) EUTMR does not, in itself, show that that Court erred in law (para. 43). Finally, inasmuch as the appellant seeks to show that the figurative elements of the earlier mark have a decisive influence on the distinctive character of that mark as registered, the appellant is seeking, in actual fact, to request that the Court carry out a new assessment of the facts and evidence without, however, showing, or even claiming, that there has been any distortion of those facts and that evidence. Therefore, the CJ rejected that line of argument as manifestly inadmissible (para. 44).

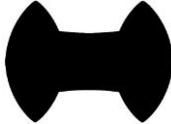
♦[C-586/15 P](#); **LOTTE / SCHÖLLER KOALA**; Order of 7 September 2016; *Lotte Co. Ltd GmbH v EUIPO*; Language of the case: DE. In the case under appeal (T-483/12) the GC had upheld the opponent's action. It decided that some of the examples provided by the opponent showed the use of the earlier mark in a form different from registered, which, however, does not alter its distinctive character. These examples show the elements that produce the distinctive character of the earlier mark: the hexagonal form, the word element 'KOALA' and the picture of koalas in their environment. The lack of the word element 'Bären' [bears] will not change the distinctive character of the earlier mark as this word can be omitted. The scope of use of this trade mark was proven by the invoices and price lists. The applicant filed an appeal before the CJ claiming the infringement of Article 15(1)(a) EUTMR. The CJ dismissed the appeal. There was no error in law by the GC when applying the criteria, that were developed in the case-law for a comparison of the trade marks, to the assessment of whether the differences between the form used and the form registered alter the distinctiveness pursuant to Article 15(1)(a) EUTMR, as that case-law defines the general issue of consumer's perception of the mark (para. 31). The claims related to the assessment of the distinctive and dominant elements of the mark were question of facts (para. 33). Also several further arguments of the applicant are of factual nature (para. 39).

♦[T-204/14](#); **VICTOR / victoria et al.**; Judgment of 7 September 2016; *Victor International GmbH v EUIPO and Gregorio Ovejero Jimenez & Maria Luisa Cristina Becerra*; Language of the case: EN. The applicant sought to register the word mark **VICTOR** as an EUTM for goods in Class 25 and services in Class 35. An opposition based on a number of Spanish trade marks, including the figurative mark **victoria** — which was considered as the only mark of relevance for the purpose of the case — for goods in Class 25, was filed pursuant to Article 8(1)(b) EUTMR. The applicant requested the interveners to prove genuine use of the earlier mark. The OD partially upheld the opposition by recognising that the marks at issue were visually, phonetically and conceptually similar and concluding that there was a likelihood of confusion on the part of the public in the relevant territory, which was identified as Spain. However, *footwear* was the only good for which genuine use of the earlier mark was proved. The applicant filed a notice of appeal. The BoA dismissed the appeal on the same grounds as the OD. The applicant filed an action before the GC based on three pleas in law: (i) infringement of Article 15(1) EUTMR, read in conjunction with Article 42(2) and (3) EUTMR and Rule 22(3) and (4) EUTMR, (ii) infringement of Article 15(1) EUTMR, read in conjunction with Article 42(2) and (3) EUTMR and (iii) infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal in its entirety. As regards the first and the second plea, the GC noticed that the applicant merely challenged the BoA's assessment of the nature of the use of the earlier mark (para. 60). The GC stated that the use of the earlier mark on the invoices, catalogues or other evidence cannot be regarded as use of the sign as a company name but as use as a trade mark (para. 65). Moreover, the earlier mark, in the forms in which it is used on the market, is included in the top right-hand corner of the invoices, which made possible to establish a link between the invoices and the catalogues produced by the interveners,



since they contain the same names and the same product codes (para. 71). Having said that, the evidence produced by the interveners, considered globally, demonstrated the genuine use of the earlier mark for *footwear*, during the relevant period in the territory of Spain (para. 76).

♦ [T-146/15](#); **DEVICE OF A POLYGON**; Judgment of 13 September 2016; *hyphen GmbH v EUIPO*; Language of the case: DE.

EUTM as registered	EUTM as used
	

An application for revocation of the mark represented above, registered for goods and services in Classes 3, 5, 9, 24, 25 and 42 was filed pursuant to Article 51(1)(a) EUTMR and partly upheld by the CD. The BoA annulled the CD’s decision in as far as it had only partly revoked the registration and revoked the registration in its entirety. It found that the evidence submitted for the use of the trade mark did not show the trade mark as registered but rather in different forms (also represented above), which alter the distinctive character of the registration. Additionally, the BoA found that the trade mark owner had not provided sufficient evidence of use for some of the goods and services (Classes 24 and 42). The proprietor filed an action before the GC relying on a single plea in law, namely an infringement of Article 15(1)(a) EUTMR. The GC partly upheld the appeal. The GC emphasised that, first, for the finding that the distinctive character of the registered mark has been altered, it is not appropriate to determine (as the BoA has done) whether the distinctive character of the trade mark in the registered form has been altered by the components that have been added [in the present case a circle and — in used form c) — the word element ‘hyphen c’]. Rather, it is necessary to assess the distinctive or dominant character of the components added on the basis of their intrinsic qualities, as well as on their relative position within the arrangement of the trade mark (paras 33, 37 and 38). Second, the BoA’s view that ‘the “distinctive character” within the meaning of Article 15(1)(a) EUTMR does not refer to the suitability for serving as an indication of origin, but merely to the “overall impression” of the sign’ constitutes an error of law and is in contradiction with the case-law of the Court, according to which the distinctive character of a mark means that that mark serves to identify the product for which registration is sought as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (para. 39). The added component (circle) is a basic and common geometric figure, which is devoid of distinctive character and, thus, has no distinctive or dominant character in the composition of the registered mark. The thickness of the circle does not suffice to confer distinctive character on the added component. Contrary to the BoA’s view, the addition of the circle to the registered mark does not have the effect of creating a sort of transformation of the sign (e.g. from a ‘dog bone’/‘dumbbell’ to a ‘button’). The BoA was wrong in finding that ‘in the form used, the outer circle and the central area form a unit’. It is clear that the registered mark retains its distinctive character, irrespective of whether it is shown in the form as registered or surrounded by a circle, without it being necessary to make random and necessarily inaccurate comparisons (paras 45 to 49). In the overall impression, the distinctive and dominant component of the used sign lies in the form as conveyed by the registered mark, as the circle is completely lacking distinctive character. Similarly, the use of the blue colour is not particularly original, nor distinctive or dominant. The BoA’s finding that the mark as registered was altered by the addition of the circle was an



error vitiating the lawfulness of the contested decision (paras 50 to 55). As far as the used form c) is concerned [including the stylised word element ‘hyphen c’], the consumer’s attention will be drawn to both the word element and the figurative element. The mere addition of the word element ‘hyphen c’ does not alter the distinctive character of the registered mark (paras 59 and 60).

The GC annulled the BoA’s decision on the revocation of the trade mark only in as far as it was solely based on the finding that the trade mark’s distinctive character had been altered. As far as the BoA — for certain goods and services (Classes 24 and 42) — had based the revocation also on other grounds (namely a lack of evidence of use), the GC observed that the trade mark owner had not contested the BoA’s findings in this respect and had not brought forward specific arguments challenging the contested decision. Therefore, the action for annulment was dismissed in this point (para. 64)

♦[T-479/15](#); **KOALA LAND / KOALA**; Judgment of 14 September 2016; *Lotte Co. Ltd. v EUIPO*; Language of the case: DE. An opposition based on the earlier German word mark **KOALA**, registered for goods in Class 30, was filed pursuant to Article 8(1)(b) EUTMR against the EUTM application **KOALA LAND**, applied for goods in Class 30. Upon request the opponent provided proof of genuine use of its earlier mark. The OD deemed the earlier mark to be genuinely used and found a likelihood of confusion for identical and similar goods. The BoA dismissed the applicant’s appeal. It found that the evidence proved genuine use of the earlier mark. The earlier mark’s *pastries* were deemed similar to the contested marks’ *chewing gum, chocolate, caramels, ice cream, edible ices* to a certain degree. In light of a normal degree of consumer attention, an average distinctiveness of the earlier mark, the full incorporation of the earlier sign into the EUTM application and the partial identity of the signs as regards the element ‘KOALA’, the BoA found a likelihood of confusion even for goods similar to a low degree. The applicant filed an action before the GC relying on two pleas in law: i) a violation of Article 42(2) EUTMR and ii) a violation of Article 8(1)(b) EUTMR. The GC dismissed the appeal. The GC confirmed the BoA assessment of the evidence as regards proof of use and found that two affidavits supported by various product catalogues and invoices in an overall assessment were sufficient to establish time, place, nature and extent of use of the earlier mark (paras 19 to 32).

♦[T-716/15](#); **DEVICE OF A HORSE BIT / DEVICE OF A HORSE BIT et al.**; Judgment of 9 November 2016; *D. Juan Gallardo Blanco v EUIPO*; Language of the case: ES. The applicant sought to register a device of a horse bit as an EUTM for goods and services in Classes 31, 41 and 44. An opposition based, inter alia, on earlier figurative marks, registered for goods in Class 31 and services in Class 41 respectively, was filed pursuant to Articles 8(1)(b) and Article 8(5) EUTMR against part of the goods and services. The OD upheld the opposition in its entirety insofar as it found there was a likelihood of confusion. The BoA dismissed the applicant’s appeal. It found, considering the similarity between the signs and the identity and similarity between the goods and services, that there was a likelihood of confusion for the relevant public, and in particular for the general public. The applicant filed an action before the GC relying on three pleas in law: (i) infringement of Article 4 EUTMR, (ii) infringement of Article 8(1)(b) EUTMR, and (iii) infringement of Article 42(2) EUTMR. The GC dismissed the appeal. It rejected the first plea as inadmissible pursuant to Article 76(d) RPGC. It also confirmed the finding of a likelihood of confusion. **Proof of use:** the allegation that the applicant is the owner of a Spanish mark that is similar and prior to the contesting EUTM, is an irrelevant argument in the context of genuine use of



the marks (para. 53). The GC confirms that the submitted evidence proves genuine use of both earlier marks in the sector of ‘horse breeding’ (paras 40 to 54).

♦[T-355/15](#); **ASTEX / ALPEX**; Judgment of 30 September 2016; *Alpex Pharma SA v EUIPO*; Language of the case: EN. The applicant sought to register the word mark **ASTEX** as an EUTM for goods and services in Classes 1, 5, 9, 42 and 44. An opposition was directed against all services in Class 42. It was based on the earlier word mark **ALPEX**, registered for services in Class 42, inter alia, and was filed pursuant to Article 8(1)(b) EUTMR. The OD rejected the opposition in its entirety. The BoA dismissed the appeal. The applicant filed an action before the GC relying on four pleas in law. The first two pleas allege infringement of Article 15 and Article 42(2) EUTMR and of Rule 22(3) and (4) EUTMIR for proof of use and genuine use. The third plea alleges infringement of Article 75 EUTMR and the fourth plea alleges infringement of Article 76(1) EUTMR. The GC dismissed the appeal. **Proof of use and genuine use:** the GC confirmed that the evidence filed was not sufficient to prove genuine use of the contested services in Class 42. Conducting research in the field of pharmaceuticals in order to develop an undertaking’s own drugs does not constitute an external service for third parties. A service is generally supplied for an economic consideration yet the volume/turnover linked to the external supply of those services is not mentioned (para. 37). The brochures do not make it clear whether the presented lists of equipment, tests and methods form part of offers sent to third parties or whether they are simply a presentation of the applicant’s laboratories in the internal context of its pharmaceutical business (para. 38). The applicant’s submission that invoices for pharmaceuticals in Class 5 also show genuine use of the earlier trade mark for services in Class 42, given that the pharmaceuticals are the final result of scientific, technological and research services carried out by the applicant was rejected by the GC. There was no evidence that the customers named in the invoices requested the applicant to develop pharmaceutical products for their specific needs or that it actually supplied such services to them (paras 39 and 40).

♦[T-549/14](#); **Castello / Castelló et al.**; Judgment of 4 October 2016; *Lidl Stiftung & Co. KG v EUIPO*; Language of the case: EN. The applicant sought to register the word mark **Castello** as an EUTM for goods and services in Classes 29, 30 and 31. An opposition based on, inter alia, the earlier figurative marks **Castelló** (EUTM and Spanish), registered for goods and services in Classes 30, 35 and 39, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition in part with respect to certain goods in Classes 29 and 30 and rejected it for the remainder. Both parties filed an appeal. The BoA of the Office dismissed the appeal brought by the applicant and partially upheld the action brought by the opponent. The BoA found the evidence of use of the earlier Spanish mark sufficient (the earlier trade mark was not subject to proof of use) and the marks in question very similar. The BoA found identity/similarity between all the contested goods in Classes 29 and 30 and concluded that there was a likelihood of confusion for those goods. Goods in Class 31 were considered dissimilar. The applicant filed an action before the GC relying on two pleas in law: (i) infringement of Article 42(2) and (3) EUTMR and of Rule 22(3) and (4) EUTMIR and (ii) infringement of Article 8(1)(b) EUTMR. The GC partly upheld the appeal. It confirmed the BoA’s findings regarding proof of use (POU) and regarding the likelihood of confusion for all goods in Classes 29 and 30. However, it found that the contested *frozen fruit and vegetables* in Class 29 were not similar to any of the goods covered by the earlier trade marks and to this extent it upheld the action. **First plea (POU):** use of the earlier Spanish mark without the figurative elements does not alter the distinctive character of the trade mark as registered (paras 49 to 50). The same applies for the use of the Spanish mark as the earlier trade mark



(para. 56). Printouts from the opponent's invoicing system only demonstrate use within the undertaking concerned, they nevertheless constitute indirect evidence of genuine use (para. 55). The submitted invoices and packaging are sufficient to prove genuine use; the evidence relates to a sufficiently large range of goods to cover all the goods designated by the Spanish mark (paras 52 to 53). The first plea is rejected.

[T-824/14](#); **POWER EDGE / EDGE**; Judgment of 18 October 2016; *Eveready Battery Company, Inc. v EUIPO*; Language of the case: EN. The applicant sought to register the figurative mark represented above as an EUTM for goods in Classes 3 and 8. An opposition based on the earlier word mark **EDGE**, registered for goods in Class 3, was filed pursuant to Article 8(1)(b) EUTMR. The OD partly upheld the opposition, finding that the opponent had proved the genuine use of the earlier mark for *shaving gels* and that there was a likelihood of confusion for some of the contested goods. The BoA upheld the applicant's appeal and annulled OD's decision. It found that the evidence filed by the opponent to prove use, namely a sworn statement, six invoices and clippings and pictures of labels and displays, was insufficient to establish genuine use of the earlier mark. The opponent filed an action before the GC relying on a single plea in law, namely an erroneous assessment of the proof of genuine use of the earlier mark for the purposes of Article 15(1) and Article 42(2) EUTMR. The GC dismissed the appeal, thus confirming the BoA's decision. The GC considered, contrary to the opponent's arguments, that the BoA did not fail to take the information contained in the sworn statement into account. However it rightly found that this information (approximate sale figures in EUR) was imprecise and that the number of units sold until the end of the relevant period was unknown. In addition, the fact that the turnover values were formulated as approximations weakens the probative force of the statement, while the number of units shown in the invoices do not give any direct information as to the total of sales in EUR it mentions (paras 27 and 29). As regards the information contained in the six invoices, neither the quantity of units sold (1 872 units, of which 1 620 units in a single invoice and the other five for very small amounts), nor the frequency of invoices or the duration of use (covering only 4 months at the end of the relevant period) is sufficient in this case to establish genuine use of the mark (para. 32). The GC also held that a change in the ownership of the earlier mark (which in this case happened a year before the relevant period) does not affect the requirement that the use of the earlier mark must be genuine, irrespective of the point at which the opponent became the proprietor of that mark. He is not obliged to prove the continuous use of his mark during the relevant period, but to establish for that period that there was real commercial exploitation of that mark in the course of trade (para. 42). The additional documents filed by the opponent (clippings and pictures of labels and displays) did refer to the nature and place of use, but did not contain any information concerning the duration or the extent of use of the goods at issue (paras 45 to 48).

♦ [T-367/14](#); **Fruitfuls**; Judgment of 18 October 2016; *August Storck KG v EUIPO and Chiquita Brands LLC*; Language of the case: EN. The CD had upheld the application for revocation against the EUTM **Fruitfuls** (word mark) covering *Confectionary, chocolate and chocolate goods, pastry* (Class 30). The decision relied on Article 51(1)(a) EUTMR and established that the EUTM proprietor did not prove genuine use of the contested mark during the relevant period. The BoA dismissed the appeal in its entirety and endorsed the CD's conclusions. The BoA took the view that the volume of sales made by the proprietor, compared to sales made on the European confectionary market, was extremely low and therefore not enough to prove the genuine use of the mark. The decision was appealed before the GC. The GC analysed in the first place the applicant's third complaint, by means of which the BoA had been criticised for having compared the volume of sales of products

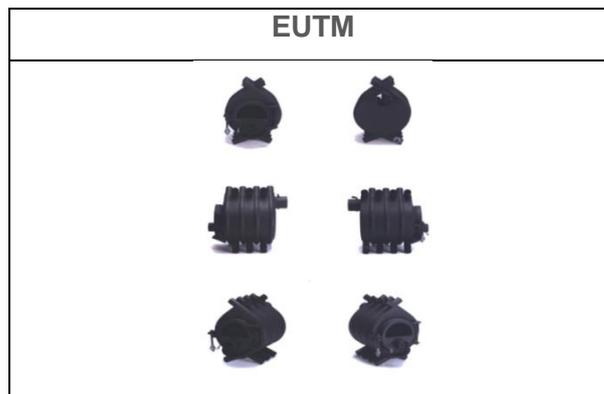


showing the contested mark to sales on the confectionary market as a whole in the entire European Union (para. 18). In particular the applicant stressed that the confectionary market is not a uniform market, since it is divided into several branches; therefore it was not correct to compare the sales related to the whole market to the sale referring to a sub-category of confectionary products, namely *hard fruit candies* (para. 18). The GC reminded that evidence of genuine use must in principle cover all of the goods covered by the EUTM, but if the evidence refers to only a part of the goods, the mark might be revoked just partially (para. 21). It is to be taken into account that, even though the EUTM covered *confectionary, chocolate and chocolate goods, pastry*, the proof of use provided by the applicant concerned just a single type of confectionary, namely *hard fruit candies* (para. 22). Such evidence of use consisted of a few deliveries of goods to consumers in Slovenia, at the very end of the relevant period. Since the BoA confirmed the CD's conclusions according to which the volume of sales made by the applicant was extremely low (para. 7), the GC had to investigate whether the CD and BoA were right to compare the applicant's sales of *hard fruit candies* with the market volume of the wider *confectionary* category in all of Europe. The GC reported that, according to case-law, when a trade mark has been registered for a category of goods, which is sufficiently broad to include a number of independent sub-categories, proof that the mark has been genuinely used in relation to a part of the goods affords protection only for the sub-category to which those goods for which the mark was used belong (para. 27). On the contrary, if a trade mark has been registered for goods precisely and narrowly defined, then, for the purposes of the opposition, the proof of genuine use necessarily covers the entire category (para. 28). The GC had to verify, therefore, whether *hard fruit candies* constitute a coherent sub-category of *confectionary* or whether these goods are part of a single group of goods. The applicant put forward that huge differences exist between the different types of confectionary and that *hard fruit candies* are not interchangeable with any other confectionary product (para. 34). Nevertheless, the GC assessed that the decisive criterion for defining sub-categories of goods or services is the purpose and intended use of the goods and that the nature and characteristics of these goods was irrelevant. It follows that, even if the nature or characteristics of different types of goods are different and these goods are not interchangeable, to constitute a separate sub-category of goods, it is necessary that their purpose or intended use be different (para. 35). This was not the case. The GC recognised, however, that it is impossible for an EUTM proprietor to prove the use of the mark for all conceivable variations of goods belonging to the product category. As a consequence the GC considered that the BoA was wrong to compare sales of a specific type of hard fruit candies, namely candies showing the contested mark, with the production volume and the turnover in the whole confectionary sector in the entire European Union. In doing so, the BoA imposed an excessive burden of proof to the owner (para. 40). Concerning the extent of the use, the GC reminded that it is not necessary that the mark should be used in an extensive geographic area for the use to be deemed genuine and that the aim of the proof of use is not to assess the commercial success of an undertaking (paras 42 and 43). Once it has been proven that a trade mark was used in accordance with its essential function and to create or preserve an outlet for the designated goods, it must be concluded that the mark was genuinely used (para. 44). In the case at issue, instead, the BoA used a method of reasoning that underestimated the relative scale of the applicant's sales (para. 46). In particular the GC found that the BoA erred not only by comparing the applicant's sales of *hard fruit candies* with the market volume of *confectionary* as a whole, but also by comparing the sales made by the applicant in Slovenia with the market volume in the entire European Union (para. 48). Finally, the GC partially annulled the decision of the BoA as regards the revocation of the mark in relation to *confectionary products* in Class 30, and dismissed the remainder of the action.



♦[T-2/16](#); **Pret | A | Diner / PRET A MANGER et al.**; Judgment of 30 November 2016; Pret *K&K Group AG v EUIPO*; Language of the case: EN. The applicant sought to register the figurative mark **Pret | A | Diner** for goods and services in Classes 29, 30, 35 and 43. An opposition based on the earlier EU figurative mark **PRET A MANGER** and the UK word mark **PRET**, was filed on the grounds of Article 8(5) EUTMR. The OD found that genuine use of the earlier marks had been proved for some of the goods and services in Classes 29, 30 and 43 and upheld the opposition. The BoA upheld the decision of the OD. In its action before the GC, the applicant put forward two pleas in law: (i) an alleged infringement of Articles 42(2) and (3) EUTMR, as well as (ii) an alleged infringement of Article 8(5) EUTMR. The GC dismissed the appeal. The GC dismissed the plea on lack of proof of genuine use of the earlier marks. It confirmed that the earlier marks had been used extensively for many years in the UK, considering the commercial volume of all the acts of use, the duration of the period in which those acts of use occurred and the frequency of those acts (para. 50).

♦♦[C-642/15 P](#); **SHAPE OF AN OVEN**; Judgment of 1 December 2016; *Toni Klement v EUIPO*; Language of the case: DE.



The applicant for cancellation requested the revocation for non-use of the 3D mark shown above, registered as an EUTM for *ovens* in Class 11. The proprietor of the EUTM filed evidence of use, which contained the shape of the EUTM with the additional word element ‘Bullerjan’ on it. The instances in the Office found that the use requirements have been satisfied and rejected the request for declaration of revocation for non-use. The applicant for cancellation appealed to the GC alleging infringement of Article 15(1)(a) EUTMR. The GC concluded that the shape is unusual and is reminiscent of an engine of an aeroplane rather than an oven. The distinctive character would be therefore high (para. 38 of the contested judgment) whereas the distinctive character of the term ‘Bullerjan’ is average (para. 40 of the contested judgment). Overall the GC held that the addition of the term ‘Bullerjan’ would not alter the distinctive character in a way that would infringe Article 15(1)(a) EUTMR and dismissed the application. The CJ found that the contested judgment contained a contradictory reasoning in a sensitive point. First of all it clarified that the question if the reasoning in a judgment is contradictory or insufficient is a matter of law, which may be brought before the CJ (para. 25). The GC found on one hand that the shape of the oven would be fanciful and highly distinctive independently of its functionality. It went on by stating that such conclusion would not be questionable due to the fact that other producers use very similar shapes, which might be a consequence of the technical function of the shape (para. 26). The CJ notes that the contested judgment does not explain why the relevant consumers would consider the shape of the oven as a strong indicator of its origin for the case in question whereas a very similar shape used by the competitors would have a



functional nature (para. 27). In the framework of the examination, if a mark used in the market is still to be considered as use of the mark as registered because it does not alter the distinctive character of the mark as registered according to Article 15(1)(a) EUTMR, the distinctive character of the registered mark and in particular its degree must be assessed previously (para. 29). Consequently, the reasoning in the contested judgment given in an aspect that is relevant for the examination of the conditions for the application of Article 15(1)(a) EUTMR is not clear and comprehensive (para. 30). For that reason, the contested judgment is to be annulled and the case referred back to the GC because the case may not be finally decided yet (paras 32 and 33).

◆ [T-24/16](#); **FONTOLIVA / FUENOLIVA**; Judgment of 6 December 2016; *Sovena Portugal — Consumer Goods, SA v EUIPO — Mueloliva, SL*; Language of the case: EN. The applicant sought to register the word mark **FONTOLIVA** as an EUTM for *edible oils and fats; olive oil* in Class 29. An opposition based on the earlier Spanish word mark **FUENOLIVA**, covering *virgin olive oil* in Class 29, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition. The Second BoA dismissed the appeal filed against the above decision and confirmed that there was a likelihood of confusion between the marks at issue. The applicant filed an action before the GC. The applicant puts forward two pleas in law: (i) an infringement of Article 42(2) and (3) EUTMR, read in conjunction with Articles 15(1) and (2) EUTMR, and (ii) an infringement of Article 8(1)(b) EUTMR. In relation to the proof of genuine use of the earlier mark, the GC found that genuine use of the earlier Spanish mark **FUENOLIVA** for virgin olive oil during the relevant period has not been established, contrary to the finding of the contested decision. The GC noted that, in particular having regard to the low volumes, which were proved to have been marketed under that mark (invoices for a period of less than 1 year for a volume in the region of 42 000 litres) and the irregular nature of the sales in question during the relevant period in relation to the characteristics of that mass-consumption food product, such a use of the earlier Spanish mark **FUENOLIVA** cannot be regarded as a genuine use for the purpose of maintaining or creating a share in the market (paras 44 to 47).

[T-397/15](#); **PAL (FIG. MARK)**; Judgment of 14 December 2016; *PAL-Bullermann GmbH v EUIPO*; Language of the case: EN. An action for revocation was filed in 2013 against the EUTM **PAL** (figurative mark) (the EUTM) and registered for goods in Classes 7 and 21 in 1999 due to non-use pursuant to Article 51(1)(a) EUTMR. In its defence, the EUTM owner submitted as evidence of use: invoices for the years 2010 to 2012, a 2012 price list and a 2012 **PAL** product catalogue. The CD decided that the use was proven for a part of the goods and partially rejected the request. An appeal and an ancillary appeal were filed. The BoA dismissed the revocation applicant's appeal and upheld in part the ancillary appeal filed by the EUTM owner. In essence, it held that the evidence produced showed that the contested mark had been genuinely used in the European Union during the relevant period for a part of the registered goods. The revocation applicant filed an action before the GC based on two pleas in law: (i) an infringement of Article 15(1)(a) EUTMR and (ii) an infringement of Rule 22(3) and (4) EUTMR. The GC dismissed the action. As regards the first plea in law alleging the **infringement of Article 15(1)(a) EUTMR**, insofar as the BoA erroneously concluded that the intervener had submitted evidence of use of the contested mark in a form differing in elements, which do not alter the distinctive character of the mark in its registered form, the GC confirmed the assessment in the contested decision. The EUTM derives its distinctive character from its word element, which indeed dominates the mark. The figurative element of that mark acts essentially as a frame, in particular the black



background, in order to highlight the presence of the word element ‘pal’. Consequently, the figurative element occupies a secondary position in the overall impression produced by the mark and will be perceived by the relevant public as a purely decorative element (para. 32). When 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 word elements rather than describing the figurative elements of the mark (para. 33 and the case-law quoted). As regards the signs as they are used, in the first form of use in the catalogue the word ‘pal’ appears in capital letters and is used alone for each product listed. In addition, the price list refers to the ‘pal’ goods and that word is also in capitals. In the form in which the EUTM was used, the presentation and configuration of the word element remain almost identical to those as registered. The figurative element of the EUTM was insufficiently distinctive to be taken into account. Consequently, the omission of that figurative element cannot be considered to have altered that mark’s distinctive character (para. 35). The second plea alleging an **infringement of Rule 22 EUTMIR** insofar as the evidence the EUTM owner produced did not meet the minimum standards for providing sufficient proof on the time and extent of use thereof, was rejected too. The evidence considered as a whole showed that the EUTM had been genuinely used for the relevant goods. The invoices generally concerned a small number of regular customers in Belgium, Germany, France and Poland, whereas the main consumer was in Germany. Since the quantity of each of those invoices is not determinative according to the case-law, the GC concluded that the relevant goods had actually been marketed in the European Union (para. 51). Addressing the arguments of the revocation applicant the GC recalled that the fact that the EUTM is not referred to on invoices cannot prove that the latter are irrelevant for the purposes of proving genuine use of that mark. The invoices are designed to reproduce the list of goods sold, so they must include the number or name of the item concerned, possibly accompanied by a mark. Furthermore, a link between the EUTM and the goods concerned may be established without it being necessary for the mark to be affixed on the goods (paras 53, 54 and the case-law quoted).

[T-391/15](#); **ALDIANO / ALDI**; Judgment of 15 December 2016; *Aldi GmbH & Co. KG v EUIPO*; Language of the case: EN. The applicant sought to register the word mark **ALDIANO** as an EUTM for *alcoholic beverages* in Class 33. An opposition filed pursuant to Article 8(1)(b) EUTMR was directed against all goods for which protection was sought. It was based on the earlier word mark **ALDI**, registered for a variety of goods and services, including *alcoholic beverages* in Class 33. The OD rejected the opposition based on the lack of genuine use of the earlier mark. The BoA dismissed the appeal. The opponent filed an action before the GC relying on a single plea in law alleging infringement of Article 42(2) EUTMR and Rule 22(3) EUTMIR. The GC dismissed the appeal. **The nature of use:** contrary to the findings of the BoA, the mark ALDI was placed on the packaging of some wines — affixed to the goods, even though the related advertisements do not show that the corresponding products bear the ALDI mark. Affixing the company name to the goods can constitute ‘trade mark use in relation to goods’ (para. 30). It is not relevant that the mark affixed is small or is not affixed to the front of the packaging (paras 29 and 31). The nature of use of the earlier mark was sufficiently proven for two kinds of wine (paras 34 and 35). **The extent of use:** the affidavit coming from the employee of the opponent was not sufficiently supported by additional evidence, that is to say, invoices, undated advertisements and labels. The invoices only prove the sale and delivery of wine to the opponent and its distribution companies in Spain — but not the marketing — by the opponent or its distribution companies, of that wine (para. 46). The argument that due to personal data protection it is impossible to provide till receipts for each bottle of wine sold under the ALDI mark was not accepted by the GC. Even if it were materially impossible to submit all the till receipts, such



impossibility does not remove the opponent's obligation to prove actual use of its mark. Additional evidence such as copies of till receipts, sales invoices or accounting documents referring to the wines bearing the ALDI mark is not of a kind which it would have been difficult for the opponent to obtain (paras 47 and 48). The opponent has not proved, to the requisite legal standard, the extent of the use of the earlier mark. Consequently, the genuine use of the earlier mark was not proven.

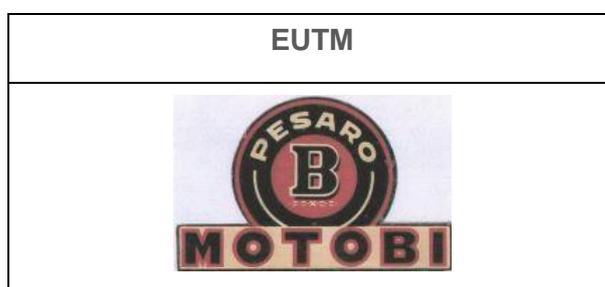


V. Other Cancellations

A. Article 51(1)(a) EUTMR — revocation due to non-use

[T-170/13](#); **MOTOBI**; Judgment of 2 February 2016; *Benelli Q.J. Srl v OHIM*; Language of the case: EN. In 1999 The EUTM proprietor registered the word mark **MOTOBI** as an EUTM for goods in Class 12. In 2009, an application for revocation of the EUTM for these goods was filed on the grounds of Article 51(1)(a) EUTMR. The CD revoked the EUTM. The BoA dismissed the appeal. The EUTM proprietor filed an application before the GC for the alteration or annulment of the decision of the BoA. Most of the documents produced by the applicant for the purposes of establishing genuine use of the mark at issue are devoid of evidential value insofar as they are undated or bear a date before or after the relevant period, or do not refer to the mark at issue, or are undated photographs, which cannot be cross-referenced with other documents such as product catalogues or lists of references. None of the documents contain data regarding the turnover or the number of sales of the goods bearing the trade mark during the relevant period. Even assuming that the scooter market is not characterised by a high number of sales, the applicant has shown no sale during the relevant period, but an order for 26 scooters resulting in a single sale. Even if that sole sale had been taken into account for the purposes of proving genuine use of the mark at issue, the fact would have remained that the sale in question was clearly insufficient for the purposes of proving genuine use. In these circumstances, documents not relating to the relevant period do not enable the extent to which the trade mark was used during that period to be better assessed, since there is no information in relation to that period in the first place (paras 48 to 68). As for the various statements submitted, given that they come from the applicant itself and are all drafted identically, stating that the vehicles bearing the **MOTOBI** trade mark shown in the annexed photographs were developed, prepared and promoted by the applicant in 2004 and 2005, they cannot constitute, by themselves, adequate proof of the genuine use of the mark at issue. The information contained therein is only indicative and needs to be corroborated by other proof (para. 70).

♦[T-171/13](#); **MOTOBI B PESARO**; Judgment of 2 February 2016; *Benelli Q.J. Srl v OHIM*; Language of the case: EN.



In 2001 The EUTM proprietor registered the figurative mark above as an EUTM for goods in Classes 9, 12 and 25. In 2009, an application for revocation of the EUTM for these goods was filed on the grounds of Article 51(1)(a) EUTMR. The CD revoked the EUTM. The BoA dismissed the appeal. The EUTM proprietor filed an application before the GC for the alteration or annulment of the decision of the BoA. Most of the documents produced by the applicant for the purposes of establishing genuine use of the mark at issue are devoid of evidential value insofar as they are undated or bear a date before or after the relevant period,



or do not refer to the mark at issue, or are undated photographs, which cannot be cross-referenced with other documents such as product catalogues or lists of references. None of the documents contain data regarding the turnover or the number of sales of the goods bearing the trade mark during the relevant period. Even assuming that the scooter market is not characterised by a high number of sales, the applicant has shown no sale during the relevant period, but an order for 26 scooters resulting in a single sale. Even if that sole sale had been taken into account for the purposes of proving genuine use of the mark at issue, the fact would have remained that the sale in question was clearly insufficient for the purposes of proving genuine use. In these circumstances, documents not relating to the relevant period do not enable the extent to which the trade mark was used during that period to be better assessed, since there is no information in relation to that period in the first place (paras 77 to 96). As for the various statements submitted, given that they come from the applicant itself and are all drafted identically, stating that the vehicles bearing the **MOTOBI** trade mark shown in the annexed photographs were developed, prepared and promoted by the applicant in 2004 and 2005, they cannot constitute, by themselves, adequate proof of the genuine use of the mark at issue. The information contained therein is only indicative and needs to be corroborated by other proof (para. 99). The action was therefore dismissed (para. 103).

[T-81/15](#); **Synthesis**; Judgment of 13 April 2016; *Danila FACCHINELLO v EUIPO*; Language of the case: IT.

EUTM
<i>Synthesis</i>

The EUTM proprietor was granted the registration of the figurative mark represented above as an EUTM for goods in Classes 7, 9 and 11. An application for revocation was filed pursuant to Article 51 EUTMR. The CD partly upheld the application for revocation, that is, for all the contested goods with the exception of *apparatus for air conditioning*. The BoA upheld the revocation applicant's appeal and dismissed the EUTM proprietor's cross appeal. It found that the EUTM was to be revoked also for *apparatus for air conditioning* (Class 11) on the basis of **insufficient extent of use**. The EUTM proprietor relied on a single plea in law: an alleged infringement of Article 51(1)(a) EUTMR. In particular, she argued that the BoA had not considered all the documents submitted as evidence of use (catalogue, price lists, internet excerpts, etc.), but only focused on the invoices. In addition, the invoices submitted were only a sample and, in any event, showed minimal, but sufficient use. The new documents (invoices) submitted before the GC removed any doubt about the sufficient use of the mark. Therefore, the GC was asked to annul the BoA decision and confirm the validity of the EUTM for the goods in Class 11 (*apparatus for air conditioning*). The GC dismissed the appeal. It found that the documents submitted for the first time before the GC were inadmissible (paras 22 to 23). It confirmed the calculation of the relevant period for use as made in the contested decision taking into account the request of retroactivity of the effects of the revocation claimed by the invalidity applicant (EUTM registered on 15 June 2004; invalidity application filed on 14 September 2012 but effects required as from 16 June 2009; therefore, use to be proven between 15 June 2004 and 14 September 2012) (para. 39). The BoA's conclusion that the most relevant invoice (in terms of amount) was unable to prove use of the trade mark in question (since there was no clear indication of the contested mark in relation to the relevant goods) was also confirmed (para. 42). The relevant invoices and all the other documents (which, contrary to the EUTM proprietor's allegations



were taken into account by the contested decision, paras 64 to 67) were not able to prove genuine use of the EUTM. In fact, they show a very limited extent (sale of about 10 items), use made during only 5 months and they do not contain any specific indications as to the distribution of the advertisements (paras 44 to 63 and 68). Contrary to the EUTM proprietor's argument, the Office information sheet indicating that the evidence of use should not exceed 110 pages is only a recommendation and it is not to be interpreted as an obligation (para. 70).

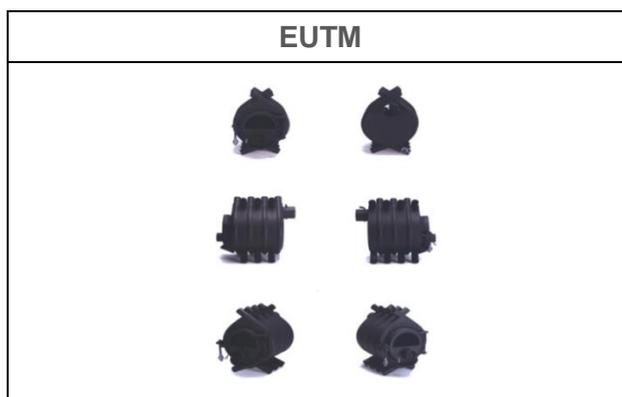
[T-324/15](#); **BAG PAX**; Order of 10 May 2016; *Volkswagen AG v EUIPO*; Language of the case: DE. The EUTM proprietor was granted the registration of the word mark **BAG PAX** as an EUTM for goods in Classes 12 and 22. An application for revocation was filed pursuant to Article 51 EUTMR based on non-use. The CD partly upheld the application for revocation. The BoA dismissed the revocation applicant's appeal. The revocation applicant filed an action before the GC. The GC dismissed the appeal as being manifestly unfounded. It found that use of the EUTM in the form **BAXPAX** [rather than **BAG PAX**] does not alter the distinctive character of the EUTM. The only difference between the mark as registered and as used is a space in between 'bag' and 'pax'. This difference is insignificant and does not influence the overall impression of the mark. BAGPAX will be perceived as the mere sum of the elements 'bag' and 'pax'.

♦[C-295/15](#); **ARKTIS**; Order of 22 June 2016; *Matratzen Concord GmbH v EUIPO*; Language of the case: DE. The applicant before the GC requested the revocation for non-use according to Article 51(1)(a) EUTMR of the EUTM **ARKTIS**, registered for goods in Classes 20 and 24. The CD revoked the mark partially for the goods in Class 20. It found that for the goods in Class 24 the EUTM had been used. The BoA confirmed the First Instance decision. The GC examined if the use is to be considered as genuine and stated that the volume of 3 490 *pillows and sleeping bags* (Class 20) confirms the position of the BoA that this constitutes a sufficient volume of use and cannot be considered as token use. The claim that the addition of the term 'line' would alter the distinctive character of the sign as used was rejected by the GC. This expression will also be understood in Germany, where the mark has been used, in the sense as product line. The GC also quoted the case-law (judgments of 12/01/2000, T-19/99, *Companyline*, EU:T:2000:4; 22/05/2012, T-273/10 *O•live*, EU:T:2012:246). The addition is subordinated and the term 'ARKTIS' is dominant. The statement that the mark has been used by another company without consent of the proprietor was dismissed. The GC confirmed the case-law that from the fact that the proprietor has the information referring to the use of another company it may be inferred that such use has been done with its consent. Procedure before the CJ: the CJ applied Article 181 RPCJ according to which a manifestly inadmissible or manifestly unfounded appeal may be dismissed by reasoned order (paras 16 and 17). **The issue of consent:** the appellant puts forward that the GC erred when it stated in paragraph 44 that the appellant failed to contest the consent by the trade mark owner to use the mark by a third party. The CJ states that this reasoning is just an additional reason. Possible errors in additional reasoning do not have any impact in the operative part of the judgment and may not lead to its annulment. In any event, the GC was fully right to uphold the genuine use of the trade mark. According to constant case-law the proprietor would not be in possession of the evidence of use by a third party, unless it consented to it. Consequently, the proprietor's consent is implicit (paras 32 to 35). **Alteration of the distinctive character:** finally, the appellant puts forward that the use of 'Arktis line' alters the distinctive character of the mark as registered and the GC did not reason the rejection of this argument by wrongly referring to the case-law in the judgments of 12/01/2000, T-19/99, *Companyline*, EU:T:2000:4; 22/05/2012, T-273/10, *O•live*, EU:T:2012:246; 11/04/2014,



T-209/13, Olive line, et al., EU:T:2014: 216 (para. 42). The CJ states that the appellant failed to explain why the conclusion in those judgments relating to the protectability of a mark may not be applicable to the examination if the mark as used does alter the distinctive character of a mark as registered. For this assessment it must be examined if the additional element 'line' is descriptive and consequently the BoA and the GC could validly rely on those judgments. Therefore, this plea is unfounded (paras 43 to 45).

♦♦[C-642/15 P](#); **SHAPE OF AN OVEN**; Judgment of 1 December 2016; *Toni Klement v EUIPO*; Language of the case: DE.



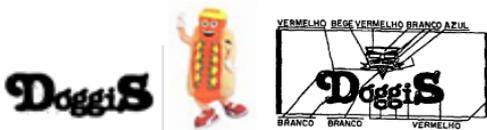
The applicant for cancellation requested the revocation for non-use of the 3D mark shown above, registered as an EUTM for *ovens* in Class 11. The proprietor of the EUTM filed evidence of use, which contained the shape of the EUTM with the additional word element 'Bullerjan' on it. The instances in the Office found that the use requirements have been satisfied and rejected the request for declaration of revocation for non-use. The applicant for cancellation appealed to the GC alleging infringement of Article 15(1)(a) EUTMR. The GC concluded that the shape is unusual and is reminiscent of an engine of an aeroplane rather than an oven. The distinctive character would be therefore high (para. 38 of the contested judgment) whereas the distinctive character of the term 'Bullerjan' is average (para. 40 of the contested judgment). Overall the GC held that the addition of the term 'Bullerjan' would not alter the distinctive character in a way that would infringe Article 15(1)(a) EUTMR and dismissed the application. The CJ found that the contested judgment contained a contradictory reasoning in a sensitive point. First of all it clarified that the question if the reasoning in a judgment is contradictory or insufficient is a matter of law, which may be brought before the CJ (para. 25). The GC found on one hand that the shape of the oven would be fanciful and highly distinctive independently of its functionality. It went on by stating that such conclusion would not be questionable due to the fact that other producers use very similar shapes, which might be a consequence of the technical function of the shape (para. 26). The CJ notes that the contested judgment does not explain why the relevant consumers would consider the shape of the oven as a strong indicator of its origin for the case in question whereas a very similar shape used by the competitors would have a functional nature (para. 27). In the framework of the examination, if a mark used in the market is still to be considered as use of the mark as registered because it does not alter the distinctive character of the mark as registered according to Article 15(1)(a) EUTMR, the distinctive character of the registered mark and in particular its degree must be assessed previously (para. 29). Consequently, the reasoning in the contested judgment given in an aspect that is relevant for the examination of the conditions for the application of Article 15(1)(a) EUTMR is not clear and comprehensive (para. 30). For that reason, the



contested judgment is to be annulled and the case referred back to the GC because the case may not be finally decided yet (paras 32 and 33).

B. Article 52(1)(b) EUTMR — bad faith

♦[T-335/14](#); **DoggiS / DoggiS et al.**; Judgment of 28 January 2016; *José-Manuel Davó Lledó v OHIM*; Language of the case: ES.

EUTM	Earlier marks
	

The EUTM proprietor was granted the registration of the figurative sign **DoggiS** represented above as an EUTM for goods and services within Classes 29, 30 and 43. An application for invalidity was filed pursuant to Article 52(1)(b) EUTMR, based, inter alia, on the ownership of several earlier Brazilian, Chilean, Peruvian and Uruguayan figurative marks **DoggiS** represented above, registered for goods in Classes 16, 25, 28, 29, 30, 32, 38, 39, 42, 43 and 60. The invalidity applicants alleged that the EUTM proprietor was acting in bad faith when applying for the contested mark and that the proprietor was aware of the existence of the earlier marks and the activities of the applicants at the time of filing. The CD rejected the application for a declaration of invalidity in its entirety. The BoA upheld the appeal, annulled the decision of the CD and declared the registration of the contested mark invalid. The invalidity applicants filed an action before the GC relying on two pleas in law: i) infringement of Article 76 EUTMR; ii) infringement of Article 52(1)(b) EUTMR. As to the second plea, it also finds the EUTM proprietor acted in bad faith based on certain objective factors liable to shed light to his intentions, such as the nature of the mark sought, the reputation of the marks in question and the commercial logic of which the filing of the application for registration of the contested TM forms a part (para. 73). Also it finds the applicant acted in bad faith at the time he filed the application of registration of the contested mark. The fact that the EUTM proprietor sought to effect that registration was indisputably guided by the intention to take undue advantage of the rights attached to the marks belonging to the parties requesting the declaration of invalidity. That intention is confirmed inter alia by the manner in which the EUTM proprietor presents his franchise chain to the public (para. 89). The action was dismissed in its entirety.

♦♦[T-674/13](#); **GUGLER**; Judgment of 28 January 2016; *Gugler France v OHIM*; Language of the case: EN.

EUTM




The EUTM proprietor was granted the registration of the figurative mark represented above as an EUTM for goods and services in Classes 6, 17, 19, 22, 37, 39, 42. An application for invalidity was filed pursuant to Article 52(1)(b) EUTMR, and to Article 53(1)(c) EUTMR in conjunction with Article 8(4) EUTMR. The CD upheld the application for invalidity. The BoA upheld the EUTM proprietor's appeal. The invalidity applicant filed an action before the GC relying on two pleas in law: (i) infringement of Article 53(1)(c) EUTMR, read in conjunction with Article 8(4) EUTMR (ii) infringement of Article 52(1)(b) EUTMR. The GC upheld the appeal. **On the infringement of Article 52(1)(b) EUTMR:** the BoA concluded that there was no bad faith on the part of the EUTM proprietor since when it filed for registration of the contested mark it had had an active business producing, selling and exporting doors and windows under the name 'Gugler' for many years and filing an EUTM application was therefore an 'obvious and completely justified action'. However, it is not apparent whether the reference to the name 'Gugler' refers to the surname Gugler, the company name or trade name of Gugler GmbH or the 'Gugler' products, or even to all of those different elements. Moreover, the BoA took the view that that conclusion was not altered by the fact that the EUTM proprietor had not informed the invalidity applicant of the application for registration of the contested mark or of the existence of that mark, that the invalidity applicant was not aware of the existence of that mark, that other registrations, including a French one, had been filed afterwards in the name of Gugler Europe (a company formed, inter alia, by the EUTM proprietor and some founders of the invalidity applicant), that Gugler Europe had, for whatever reason, obtained the invalidity applicant's consent at the time of filing the application for registration of the later French mark, that that latter mark had been licensed to the invalidity applicant and, lastly, that the EUTM proprietor had invoked the contested mark in a recent court action, which had been brought against the invalidity applicant as a consequence of the distorted commercial relationship between the parties. The BoA however failed to explain in what way those facts, which corresponded to the invalidity applicant's argument, did not alter its conclusion that there was no bad faith on part of the EUTM proprietor. Hence, the BoA infringed the obligation to state reasons imposed upon by Article 75 EUTMR (paras 63 to 94).

♦[T-167/15](#); **NEUSCHWANSTEIN**; Judgment of 5 July 2016; *Bundesverband Souvenir — Geschenke — Ehrenpreise e.V. v EUIPO*; Language of the case: DE. The applicant for invalidity (applicant before the GC) requested the invalidity of the EUTM **NEUSCHWANSTEIN** for goods and services in Classes 3, 8, 14, 15, 16, 18, 21, 25, 28, 30, 32, 33, 34, 35, 36, 38 and 44 for lack of distinctive character and descriptiveness according to Article 52(1)(a) EUTMR in conjunction with Article 7(1)(b) and (c) EUTMR and for bad faith according to Article 52(1)(b) EUTMR. Both the CD as well as the BoA dismissed the action. The applicant filed an application before the GC based on three pleas in law: (i) infringement of Article 7(1)(b) EUTMR, (ii) infringement of Article 7(1)(c) EUTMR and (iii) infringement of Article 52(1)(b) EUTMR. The GC confirms the BoA as to the attention of the general public, which will be average except for the goods in Class 14 and the services in Class 36, where the attention will be above average (para. 22). As regards the third plea, the GC held that the applicant did not show that the proprietor of the mark was aware at the date of filing that a third party was using the same or a similar mark (para. 55). The BoA correctly pointed out that the possibility to licence a mark is no indication of bad faith but rather envisaged in the EUTMR (para. 56). The applicant could not show that the proprietor of the mark had the intention to hinder with its filing any third party (para. 57). Finally, as to the argument that the proprietor of the mark would profit from the renown of the castle, the GC sustained that it is the owner of the castle and that the selling of the souvenirs and the provision of the services would be helpful for the administration and proper functioning of the castle. This would justify the fact that it profits of the well-known character of the castle (para. 58).



[T-82/14](#); **LUCEO**; Judgment of 7 July 2016; *Copernicus Trademarks Ltd. v EUIPO*; Language of the case: DE. The EUTM **LUCEO** (word mark) was declared invalid by the CD because the application has been filed in bad faith (Article 52(1)(b) EUTMR). The BoA confirmed the first instance decision. At the time the application was filed, Ivo-Kermartin, not the applicant, was the proprietor of the mark at issue. In the case in question the GC takes the view that, for reasons of procedural economy, it is appropriate to consider at the outset the merits of the action for invalidity, without first ruling on its admissibility, since the action is, in any event unfounded (paras 19 to 22). **Unlawful filing strategy:** the GC agrees with the finding of the BoA that the applicant submitted chains of applications for registration of national trade marks, which were filed every 6 months, alternately in Germany and in Austria, just before the expiry of the 6-month period of reflection in order to claim priority for an EUTM. Those applications were successively cancelled due to non-payment of registration fees and were therefore not examined by the national trade mark offices (para. 48). Such a successive chain of applications for registration of national trade marks for the same sign for goods and services covered by classes, which are at least partly identical seeks to grant to the applicant a blocking position. When a third party files an application for registration of an identical or similar EUTM, the applicant applies for registration of an EUTM, claims priority for it by relying on the last link of the chain of applications for registration of national trade marks and brings opposition proceedings on the basis of that application for an EUTM. This blocking position exceeds the 6-month period of reflection provided for by Article 29(1) EUTMR and even the 5-year grace period provided for by Article 51(1)(a) EUTMR (para. 51). Such a filing strategy is not — as claimed by the applicant — a legitimate business activity but incompatible with the objectives pursued by the EUTMR and may be considered as ‘abuse of law’ (para. 52). Under the given circumstances the application for the EUTM **LUCEO** has been done in order to oppose the intervener’s application **LUCEA LED** and as it enjoyed a priority from the unlawful chain of national applications in Austria and Germany it could be used as earlier right in the corresponding opposition proceedings. The GC concludes that by chaining together the applications for registration of the German and Austrian trade marks **LUCEO**, the applicant sought to be granted a blocking position allowing him to oppose possible applications for registration of identical or similar signs filed by third parties. In order to benefit from that blocking position or to maintain it, it sufficed to check, before the expiry of the respective period of reflection, whether third parties had filed applications for registration of identical or similar trade marks (para. 102). **The use of the mark at issue:** the GC confirms the BoA’s finding that the applicant did not intend to use the mark at issue himself being unable to indicate the name of the clients who expressed an interest in that mark and, secondly, he had requested payment of EUR 75 000 from the intervener. The request for payment was the sole possibility to exploit the mark at issue (paras 109 to 126). **The lack of transparency:** a further additional argument for the finding of bad faith was the lack of transparency in the whole filing strategy. The GC rebuts the applicant’s arguments and concludes that with reference to the national trade marks the successive transfers of those trade marks and applications for trade marks to different companies, the alternation between the applications for registration of German and Austrian trade marks and the non-payment of registration fees for them made the applicant’s unlawful filing strategy less transparent for third parties (para. 142). **Conclusion:** the GC confirms finally the BoA’s assessment to formulate the conclusion according to which the chain of applications for registration of German and Austrian trade marks **LUCEO** organised by the applicant were intended to grant a blocking position to him, which he used to be able to claim priority for an application for registration of an EUTM where a third party applied for registration of an identical or similar EUTM. Therefore, when the applicant applied for registration of the mark at issue, it did not intend to make use of its essential function, namely to guarantee the identity of the origin of goods or services to the consumer or end user, by



enabling him, without any possibility of confusion, to distinguish the product or service from others, which have another origin, but intended to use it in order to prevent the registration of the EUTM **LUCEA LED** applied for by the intervener and to derive economic advantages from its blocking position (para. 145). The final applicant's argument that the intervener himself acted in bad faith is not to be followed. In any event, the ground for invalidity for bad faith is based on public interest and cannot therefore depend on the bad faith of the person who applies for the invalidity of the trade mark (para. 159).

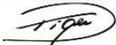
♦[T-453/15](#); **VOGUE**; Judgment of 18 September 2016; *Trinity Haircare AG v EUIPO*; Language of the case: EN.



The EUTM proprietor was granted the registration of the figurative mark represented above as an EUTM for goods in Class 3. The Office refused to invalidate the registration of the EUTM pursuant to Article 52(1)(a) EUTMR in conjunction with Article 7(1)(b) or (c) EUTMR, as it was found distinctive, non-descriptive or laudatory for the goods. It also found that no act of bad faith within the meaning of Article 52(1)(b) EUTMR had been proved. The invalidity applicant appealed reiterating his arguments that the term 'vogue' was used as a synonym for 'fashion' or as a shortened form of the expression 'en vogue' and thus was descriptive of the goods. The BoA dismissed the invalidity applicant's appeal. The BoA confirmed that, as in French, 'vogue' in English had the meaning 'popularity, use or general acceptance; popularity with the audience' according to well-known dictionaries. It also asserted that there were expressions such as 'en vogue' (in French) or 'in vogue' (in English), which mean 'fashionable, tendency'. However, the BoA stated that the applicant had not demonstrated that the word 'vogue' was used as a synonym for those expressions (contested decision, paragraph 16). Likewise, it held that nothing indicated that the word 'vogue' was descriptive of the goods at issue. The invalidity applicant filed an action before the GC relying on three pleas in law: i) infringement of Article 7(1)(b) EUTMR; ii) infringement of Article 7(1)(c) EUTMR; and iii) infringement of Article 52(1)(b) EUTMR. The GC dismissed the appeal. Regarding the bad faith arguments, the contested mark was allegedly submitted in bad faith, given that the intervener had repeatedly submitted, between 1962 and 2003, that is to say, before the contested mark was filed, the mark **VOGUE** in numerous Member States for goods included in Class 3, without having the intention of using them but with the sole aim of avoiding consequences of non-use. The GC rejected the evidence submitted, namely that, the withdrawal of the opposition before the Spanish Patent and Trademark Office does not constitute evidence of non-use of the contested mark, which would at all events be insufficient in itself to adduce evidence of the intervener's bad faith.



[T-456/15](#); **T.G.R. ENERGY DRINK**; Judgment of 5 October 2016; *Foodcare sp. z o.o. v EUIPO*; Judgment of 5 October 2016; Language of the case: EN.

EUTM	Earlier mark
T.G.R. ENERGY DRINK	Dariusz Tiger Michalczewski  

The registration of the word mark **T.G.R. ENERGY DRINK** as an EUTM was granted for goods in Class 32. An application for invalidity was filed pursuant to Article 52(1)(b) EUTMR and Article 53(1)(a) EUTMR in conjunction with Article 8(1)(b) and Article 8(3) EUTMR. The CD dismissed the application for invalidity. The BoA upheld the invalidity applicant's appeal. It found that the EUTM proprietor had acted in bad faith when it filed the application for registration of the contested mark. The EUTM proprietor filed an action before the GC relying on a single plea in law: infringement of Article 52(1)(b) EUTMR. The GC dismissed the appeal. The GC confirms that the BoA did not err in taking into account as relevant factors in assessing the existence of bad faith: (i) the existence of direct contractual relations between the parties before the application to register the contested mark was filed and their content (paras 30 to 33); (ii) the EUTM proprietor's intention to develop its commercial activity relying, in particular, on the image projected by the invalidity applicant and his reputation, this being supported by the content of the contracts and the get-up of the packaging of the products marketed by the EUTM proprietor (paras 30, 34 and 35); (iii) the EUTM proprietor's intention to create at least an association between the sign Tiger Energy Drink used on account of the parties' agreements, which enjoyed a considerable reputation, and the contested mark, this being supported by the strong similarity between the signs (paras 36 to 41); (iv) the EUTM proprietor's intention to continue benefiting from the extent of the reputation enjoyed by the sign **Tiger Energy Drink**, while circumventing the contractual obligations arising from the agreements concluded with the invalidity applicant, as supported by the content of the contracts (paras 42 to 44).

C. Article 53(1), (2) and (3) EUTMR — other relative grounds for invalidity

[no entry]

D. Article 54 EUTMR — acquiescence

♦[T-77/15](#); **SkyTec**; Judgment of 20 April 2016; *Tronios Group International BV v EUIPO*; Language of the case: NL. The EUTM proprietor was granted the registration of the word mark **SkyTec** as an EUTM for goods in Classes 9 and 11. An application for invalidity was filed pursuant to Article 53(1)(a) EUTMR in conjunction with Article 8(1)(b) and Article 8(5) EUTMR and Article 53(1)(c) EUTMR in conjunction with Article 8(4) EUTMR with respect to the goods in Class 9. The CD upheld the application for invalidity and dismissed the EUTM proprietor's defence based on Article 54(2) EUTMR (limitation in consequence of acquiescence). The BoA dismissed the EUTM proprietor's appeal. It confirmed that the exception of Article 54(2) EUTMR was unfounded. The EUTM proprietor did not prove that the invalidity applicant on the date of the invalidity application had acquiesced, for a period of



five successive years, in the use of the contested EUTM while being aware of such use. The BoA also stated that there is a likelihood of confusion between the contested EUTM and the invalidity applicant's earlier UK trade mark. The EUTM proprietor filed an action before the GC relying on two pleas in law: (i) violation of Article 54(2) EUTMR and (ii) wrong assessment of the likelihood of confusion according to Article 53(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR. The GC dismissed the appeal. It found that the evidence of acquiescence submitted by the EUTM proprietor was correctly assessed by the BoA and that it was not proven whether the invalidity applicant was 'actually', and not only potentially, aware of the use of the contested EUTM. Furthermore, the GC confirmed the existence of a likelihood of confusion. The GC emphasised that it is established case-law that the period of limitation in consequence of acquiescence starts running when four conditions are fulfilled (para. 30). The invalidity applicant must have 'knowingly' tolerated the use of the subsequent EUTM, the *onus* is on the EUTM proprietor (para. 33). Consequently, it is not sufficient that 'potential' knowledge of use of the subsequent mark is proven, it has to be proven whether there was 'actual' knowledge of such use (paras 34 to 35).



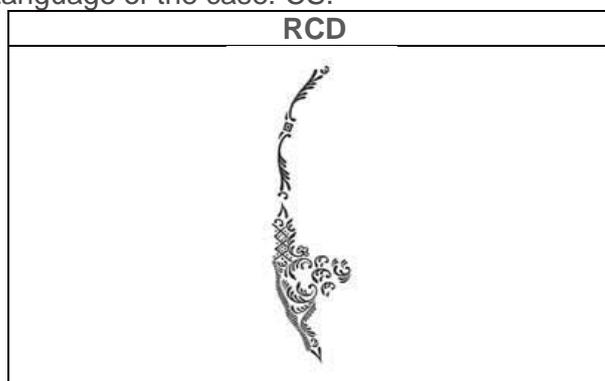
VI. Design Matters

A. Article 3(a) and Article 9 CDR — registration proceedings

[no entry]

B. Article 25(b) CDR — invalidity proceedings

♦[T-420/15](#); **DESIGN OF DECORATIVE GRAPHIC SYMBOLS**; Judgment of 14 July 2016; *Thun 1794 v EUIPO*; Language of the case: CS.

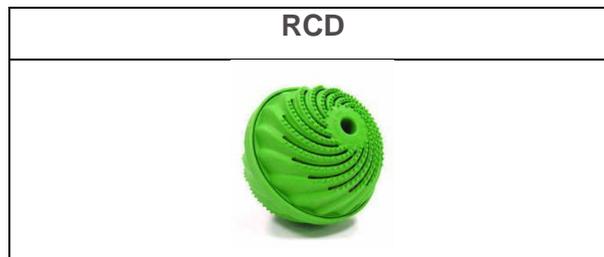


The registered Community design (RCD) proprietor was granted the registration of the design represented above as an RCD for the product indication *graphic symbols*. An application for invalidity was filed pursuant to Article 25(1)(b) CDR in conjunction with Article 4 and 9 CDR based on lack of novelty and individual character. It was upheld by the ID, who considered that the invalidity applicant proved disclosure of an identical prior design. The BoA annulled the decision of the Invalidity Division (ID), holding that such disclosure was not proved to a requisite legal standard. The invalidity applicant filed an action before the GC. Second plea: lack of novelty and individual character — the global assessment of the evidence submitted by the applicant does not show that the applicant submitted solid and objective evidence of disclosure of a prior design (paras 21 to 35). The plea is dismissed. Third plea: misuse of power — the applicant uses the plea of misuse of power as a pretext to challenge, once again, the global assessment of the evidence filed to prove disclosure of a prior design. That global assessment is not vitiated by any error and must be confirmed. Moreover, there is no indication of any omission or partiality on the part of the BoA (para. 38). The third plea is dismissed.



C. Others

[C-419/15](#); **DESIGN OF A LAUNDRY BALL**; Preliminary ruling of 22 June 2016; *Thomas Philipps GmbH & Co. KG v Grüne Welle Vertriebs GmbH*; Language of the case: DE.



Grüne Welle Vertriebs GmbH, the applicant at first instance (the applicant) claims damages from Thomas Philipps GmbH & Co. KG, the defendant at first instance (the defendant) in connection with a purported infringement of RCD No 877030-0001 for a laundry ball. The holder of the RCD is EMKER S.A., of Geneva (Switzerland). The applicant claims that it is the exclusive licensee of that RCD for Germany and has been empowered by the rights holder to bring all claims arising from the design in its own name. The applicant has not been entered as a licensee in the register of RCD. The first instance, the Landgericht (Regional Court) found in favour of the applicant and considered the applicant, as the exclusive licensee, to be empowered to bring the claims for damages in its own name. The defendant disputes the finding of the Landgericht and claims that the applicant is not entitled to bring claims arising from the RCD. According to the referring Chamber, the issues are twofold: can the applicant bring claims arising from an infringement of the RCD despite not having been entered in the Community designs register as a licensee? Even if the applicant has the standing to bring an infringement action, does Article 32(3) CDR allow the licensee to pursue its own claim for damages independently? The questions referred to the CJEU: does the first sentence of Article 33(2) CDR preclude a licensee who has not been entered in the register of Community designs from bringing claims for the infringement of a registered Community design? In the event that the first question is answered in the negative: may the exclusive licensee of a Community design, with the consent of the rights holder, bring an action on its own claiming damages for its own loss under Article 32(3) CDR or can the licensee only intervene in an action brought by the rights holder for an infringement of its Community design under Article 32(4) CDR? **FINDINGS OF CJ: first question** — the CJ found that, in isolation, Article 33(2) CDR could be interpreted as requiring registration of the licence in order for a licensee to have the standing to bring an infringement action (para. 17). But, it is necessary to consider not only wording but also the **context** (para. 18). The context that the CJ considered pertinent to Article 33(2) CDR is that it is aimed at safeguarding third parties who have, or are likely to have, rights in the RCD. The CJ based its conclusions on the following factors: Article 33(2) CDR excludes ‘third parties who have acquired rights’ but who ‘knew of the legal act at the date on which the rights were acquired’ or acquired the RCD or rights by universal succession (para. 19). Title III CDR is entitled ‘Community Designs as objects of property’ (para. 20). Article 32(3) CDR, the licensee’s right to bring proceedings for infringement is subject only to the proprietor’s consent thereto (para. 21). Article 28(b) CDR would serve no useful purpose if a licensee had no standing to bring infringement actions (para. 23). The CJ concluded that Article 33(2) CDR **does not preclude** a licensee who is not entered in the Register of RCDs from bringing proceedings for infringement of an RCD. **Second question:** Whereas Article 32(4) CDR states that a licensee is, for the purpose of obtaining compensation for damage suffered by him, entitled to intervene in an infringement



action brought by the rights holder in an RCD, Article 32(3) CDR does not state whether the licensee can claim damages for that loss where it brings the infringement action envisaged in that provision in its own right (para. 27). However, those two provisions, which establish a system of legal remedies open to the licence holder of an RCD against the infringer of that RCD, must be read together. Those provisions allow the licensee to bring proceedings either by way of an action, by bringing infringement proceedings with the consent of the design holder or, in the case of an exclusive licence, if having been given notice the rights holder does not itself bring infringement proceedings within an appropriate period, or by way of intervention in infringement proceedings brought by the rights holder in an RCD. The latter route is the only one available to the holder of a non-exclusive licence who does not obtain the consent of the rights holder of the design to act alone (para. 28). Whilst the licensee may seek damages for its losses by intervening in the infringement proceedings brought by the rights holder of the RCD, nothing prevents it from also doing so where it brings the infringement proceedings itself with the consent of the rights holder, or, if it is an exclusive licensee, without that consent in the case of inaction by that rights holder after having given it notice to bring proceedings (para. 29). The system would, moreover, lack coherence if the licensee could defend its own interests only by joining an action brought by the rights holder of the RCD when he may act alone by way of an action with the consent of that rights holder, or without its consent in the case of an exclusive licence, to defend their common interests (para. 30). The possibility for the licensee to seek compensation for damage suffered by it is consistent with the objective set out in recital 29 of ensuring that the rights conferred by an RCD can be enforced in an efficient manner throughout the territory of the EU and also with the purpose of Article 32(4), which is to give to the licensee the procedural means to bring proceedings for the infringement and thus to defend those rights, which have been conferred on it. To prohibit it from acting for that purpose would make it totally dependent, including in the case of an exclusive licence, on the rights holder to obtain compensation for damage suffered by it and, should that rights holder not bring proceedings, would, therefore, be detrimental to the exercise of those rights (para. 31). Consequently, Article 32(3) CDR must be interpreted as meaning that the licensee can claim damages for its own loss in proceedings for infringement of an RCD brought by it in accordance with that provision.



VII. Enforcement

[no entry]



VIII. Other

A. Article 5 of First Council Directive 89/104/EEC of 21 December 1988

[C-179/15](#); **Mercedes Benz**; Preliminary ruling of 3 March 2016; *Daimler AG v Együd Garage Gépjárműjavító és Értékesítő Kft.*; Language of the case: HU.



Daimler AG is the proprietor of the international figurative trade mark **Mercedes-Benz** represented above, protected in Hungary covering, inter alia, motor vehicle parts. The Hungarian company *Együd Garage* is engaged in the retail sale of motor vehicles and parts and their repair and servicing, including the sale of Daimler goods and in the supply of related services. Daimler's subsidiary company and *Együd Garage* concluded a contract for the supply of after-sales services, which expired. Under that contract *Együd Garage* was entitled to use the abovementioned trade mark and to describe itself as authorised Mercedes-Benz dealer in its own advertisements. While the after-sales services contract was in force, *Együd Garage* ordered an online advertisement, which names that company as an authorised Mercedes-Benz dealer. Following the termination of that contract, *Együd Garage* tried to end all use of the trade mark at issue, on the basis of which the public might assume that there was still a contractual link between it and Daimler. In particular, *Együd Garage* asked the online advertiser to amend the advertisement so that it no longer made reference to it as an authorised Mercedes-Benz dealer. Furthermore, *Együd Garage* wrote to the operators of several other websites requesting the removal of online advertisements, which had been published without its consent, in particular without *Együd Garage* having ordered them, and which presented that company as an authorised Mercedes-Benz dealer. Despite taking those steps, online advertisements containing such a reference continued to be distributed online. Moreover, when the key words 'együd' and 'garage' were inserted into the Google search engine, this resulted in a list of results displaying such advertisements in the first line of which, serving as a link, *Együd Garage* appeared as an 'authorised Mercedes-Benz dealer'. Daimler brought an infringement action before the referring court. *Együd Garage's* defence was that, apart from the advertisement that appeared on the website www.telefonkonyv.hu, it did not place any other advertisements on the internet and that those at issue appeared or still appears contrary to its intention, without it having any influence on their content, publication or removal. In that context, *Együd Garage* submitted that it had been the victim of a common commercial practice, which consists, essentially, in certain providers of internet advertising services summarising advertisements published on other advertising sites, without the knowledge or consent of the advertiser, in order to create their own database of information available free of charge or for consideration. In those circumstances, the referring court decided to stay the proceedings and essentially asks whether Article 5(1)(a) and (b) of Directive 2008/95 must be interpreted as meaning that a third party, who is named in an advertisement published on a website, which contains a sign identical or similar to a trade mark in such a way as to give the impression that there is a commercial relationship between him and the proprietor of the trade mark, makes a use of that sign, which may be prevented by that proprietor under that provision, even where that advertisement has not been placed by that third party or on his behalf or where that third



party took all reasonable steps to have it removed, but did not succeed in doing so. In accordance with Article 5(1) of Directive 2008/95, *Daimler AG* was not entitled to prohibit, while the after-sales service contract was in force, the publication of the online advertisement since it permitted such use (para. 31). As regards their publication following the expiry of said contract, while the publication online of an advertisement on a referencing website, referring to another person's trade mark, is attributable to the advertiser who ordered that advertisement and upon whose instruction the operator of that site, as service provider, acted (see, by analogy, judgments of 23/03/2010, C-236/08 - C-238/08, *Google-Louis Vuitton*, EU:C:2010:159, § 51-52 ; 15/12/2011, C-119/10, *Red Bull*, EU:C:2011:837, § 36), that advertiser cannot be held liable for the acts or omissions of such a provider who, intentionally or negligently, disregards the express instructions given by that advertiser who is seeking, specifically, to prevent that use of the mark. Accordingly, where that provider fails to comply with the advertiser's request to remove the advertisement at issue or the reference to the mark contained therein, the publication of that reference on the referencing website can no longer be regarded as a use of the mark by the advertiser (para. 34). As regards, secondly, the publication of the advertisement in question on other company referencing websites, it must be pointed out that an advertiser cannot be held liable for the independent actions of other economic operators, such as those of referencing website operators with whom the advertiser has no direct or indirect dealings and who do not act by order and on behalf of that advertiser, but on their own initiative and in their own name (para. 35 to 36). It follows that, in both of the situations the proprietor of the mark is not entitled, under Article 5(1)(a) or (b) of Directive 2008/95, to take action against the advertiser in order to prevent him from publishing online the advertisement containing the reference to its trade mark (para. 37). That conclusion is supported by the wording, scheme and purpose of Article 5 of Directive 2008/95. According to its ordinary meaning, the expression 'zu benutzen', 'using', 'faire usage', 'usare', 'het gebruik', 'hasznal', used respectively in the German, English, French, Italian, Hungarian and Dutch versions of that provision, involves active behaviour and direct or indirect control of the act constituting the use. However, that is not the case if that act is carried out by an independent operator without the consent of the advertiser, or even against his express will (para. 39). As follows from the scheme of Article 5 of Directive 2008/95, it refers exclusively to active behaviour on the part of the third party, such as that of 'affixing' the sign on the goods and their packaging or 'using' it in business papers and advertising, 'offering' the goods, 'putting them on the market' or 'stocking' them for those purposes, 'importing' or 'exporting' them or 'offering' or 'supplying' services under that sign (para. 40). Article 5(1) of Directive 2008/95 is intended to provide the proprietor with a legal instrument allowing him to prohibit, and to prevent, any use of his trade mark by a third party without his consent. However, only a third party who has direct or indirect control of the act constituting the use is effectively able to stop that use and therefore comply with that prohibition. Allowing the prohibition would misconstrue the purpose of that provision and conflict with the principle that no one can be legally obliged to do the impossible (*impossibillum nulla obligatio est*). On those grounds, the CJ ruled:

Article 5(1)(a) and (b) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that a third party, who is named in an advertisement on a website, which contains a sign identical or similar to a trade mark in such a way as to give the impression that there is a commercial relationship between him and the proprietor of the trade mark, does not make use of that sign that may be prohibited by that proprietor under that provision, where that advertisement has not been placed by that third party or on his behalf or, if that advertisement has been placed by that third party or on his



behalf with the consent of the proprietor, where that third party has expressly requested the operator of that website, from whom the third party ordered the advertisement, to remove the advertisement or the reference to the mark contained therein.

B. Classification of Goods and Services

♦[T-687/14](#); **AFRICAN SIMBA / SIMBA et al.**; Judgment of 28 January 2016; *Novomatic AG, v OHIM*; Language of the case: DE. The EUTM applicant sought to register a figurative mark with the verbal elements 'AFRICAN SIMBA' for goods in Class 28. The opponent based its opposition, inter alia, on Article 8(1)(b) EUTMR using, inter alia, the earlier German figurative mark as depicted above, registered for goods in Class 28. The opposition was directed against all the goods covered by the EUTM application. The OD upheld the opposition. The BoA dismissed the applicant's appeal, finding that there was a likelihood of confusion, taking into account, the identity of the goods and the similarity between the signs. The applicant appealed to the GC, putting forward two pleas in law: (i) an alleged infringement of Article 75 EUTMR and (ii) an alleged infringement of Article 8(1)(b) EUTMR. Concerning the comparison of the goods in Class 28 the contested decision stated that the contested goods, namely *lottery game machines* are encompassed in the broad category of *games and plaything except plush toys* (German: '*Spielwaren, ausgenommen weichgestopfte Spieltiere*') covered by the earlier German mark. To this extent the GC stated that the contested goods do not fall within the natural meaning of the opponent's goods. Furthermore, the use of some of the headings does not comply with the criteria of IPT to consider that the earlier mark covers all the goods included in the alphabetical list. This applies even more, taking into account that the opponent's goods contain an exclusion of plush toys. Consequently, the goods in Class 28 are not identical (paras 51 to 55). The GC proceeded with its examination to see if this error has an impact on the outcome of the contested decision (para. 56).

[T-775/15](#); **FERLI**; Judgment of 1 December 2016; *EK/servicegroup eG v EUIPO*; Language of the case: DE. The BoA confirmed the Office's refusal of the EUTM application **FERLI** (word mark) with respect to *retail, mail order and wholesale services in relation to household goods and electronic goods* in Class 35 because these services are not sufficiently clear within the meaning of Rule 2(2) EUTMR in conjunction with Article 28 EUTMR. The GC confirmed the BoA's findings holding that the goods to which the services relate (judgment of 07/07/2005, C-418/02, *Praktiker*, EU:C:2005:425, § 52) must be sufficiently clear on their own account (judgment of 19/06/2012, C-307/10, *IP Translator*, EU:C:2012:361, § 49). Without such clear definition of the relevant goods it would be impossible to determine the mark's scope of protection and a possible likelihood of confusion (paras 32 and 33). The terms *household goods and electronic goods* are not sufficiently clear (paras 35 to 37).

C. Exhaustion of rights

[C-297/15](#); **FERRING / KLYX**; Preliminary ruling of 10 November 2016; *Ferring Lægemedler A/S v Orifarm A/S*; Language of the case: DA. This request for a preliminary ruling has been made in proceedings *between Ferring Lægemedler A/S*, acting on behalf of *Ferring BV*, and *Orifarm A/S* for *Ferring's* opposition to the marketing in Denmark of one of its medicinal products, under the trade mark **Klyx**, as repackaged by *Orifarm*, in the context of parallel



imports originating in Norway carried out by that company. The trade mark proprietor claims that it can legitimately oppose the contested repackaging in that, in the first place, that repackaging is not necessary to market the product imported in parallel and, in the second place, that repackaging is justified only by the importer's attempt to secure a commercial advantage. However, the parallel importer contends that the repackaging is necessary to gain access to the segment of the Danish market for the medicinal product packaged in packets of one (the parallel importer purchases the medicinal product in Norway in packets of 10 and sells them on the Danish market, after having repackaged it in new packets of 1, upon which the trade mark is reaffixed). The *Sø-og Handelsretten* (Maritime and Commercial Court, Denmark) observed that it follows from the case-law of the CJEU that the trade mark proprietor cannot oppose the repackaging if that opposition contributes to the partitioning of the markets. That would be the case where the opposition prevents a repackaging, which is necessary to market the medicinal product in the importing State. In those circumstances, the referring court questions whether the contested repackaging can be considered **necessary**, given that the medicinal product at issue is available in packets of one or packets of ten in all the States party to the EEA Agreement in which the medicinal product is placed on the market, including the States in question in the main proceedings. The *Sø-og Handelsretten* decided to stay the proceedings and refer it to the CJ for a preliminary ruling: **question referred to the CJ** — how Article 7(2) of Directive 2009/95 must be interpreted in the sense that the trade mark proprietor may oppose the continued marketing of a medicinal product by a parallel importer, where that importer has repackaged the medicinal product in a new, outer packaging and reaffixed the trade mark (para. 13). **Answer of the CJ:** the CJ noticed that the medicinal product at issue is marketed by the trade mark proprietor in the same packaging as in all the States party to the EEA Agreement in which it is placed on the market, including the States in question in the main proceedings (para. 24). The CJ highlighted by quoting the *Bristol-Myers Squibb and Others* Judgment:

that the trade mark proprietor cannot oppose the repackaging of the product in new external packaging, when the packet size used by that proprietor in the State party to the EEA Agreement where the importer purchased the product, cannot be marketed in the importing State because of, in particular, a rule authorising packaging only of a certain size or a national practice to the same effect, sickness insurance rules making the reimbursement of medical expenses depend on the size of the packaging, or well-established medical prescription practices based, inter alia, on standard sizes recommended by professional groups and sickness insurance institutions (see, C-427/93, C-429/93 and C-436/93, EU:C:1996:282, para. 53) (para. 21).

Since the CJ pointed out that it is not apparent from the information available to the Court that one of the abovementioned situations existed in the present case or that because of the specific circumstances prevailing at the time of the marketing, effective access to the Danish market for the medicinal product at issue was hindered; as a consequence, the referring court should be the one to determine whether one or several of the these situations are in existence in the main proceedings. If this is not the case, then the proprietor of the earlier mark can oppose the contested repackaging, as long as the product imported in parallel can be marketed in Denmark in the same packaging as that in which that product is marketed in Norway (paras 25 to 26). Therefore, Article 7(2) of Directive 2008/95 must be interpreted as meaning that a trade mark proprietor may object to the continued marketing of a medicinal product by a parallel importer, where that importer has repackaged that medicinal product in a new, outer packaging and reaffixed the trade mark, where, first, the medicinal product at issue can be marketed in the importing State party to the EEA Agreement in the same



packaging as that in which it is marketed in the exporting State party to the EEA Agreement and, second, the importer has not demonstrated that the imported product can only be marketed in a limited part of the importing State's market, and those are matters that are for the referring court to determine (para. 29).

D. Fax transmission reports

♦[T-420/15](#); **DESIGN OF DECORATIVE GRAPHIC SYMBOLS**; Judgment of 14 July 2016; *Thun 1794 v EUIPO*; Language of the case: CS. The RCD proprietor was granted the registration of the design of decorative graphic symbols as an RCD for the product indication *graphic symbols*. An application for invalidity was filed pursuant to Article 25(1)(b) CDR in conjunction with Article 4 and 9 CDR based on lack of novelty and individual character. It was upheld by the ID, who considered that the invalidity applicant proved disclosure of an identical prior design. The BoA annulled the decision of ID, holding that such disclosure was not proved to a requisite legal standard. The invalidity applicant filed an action before the GC. First plea — substantial procedural violation: the GC confirmed the case-law according to which the production, by the Office, of fax transmission reports, which included items conferring probative value on them was sufficient to prove that the fax in question had been received by the addressee. Where there has been no error message and there is a transmission report stating the word 'ok', it can be considered that the fax sent has been received by the addressee (para. 17). Thus, the applicant could not be successful merely claiming that it never received the fax in question.

E. Licenses

[C-163/15](#); **ARKTIS**; Preliminary ruling of 4 February 2016; *Youssef Hassan v Breiding Vertriebsgesellschaft mbH*; Language of the case: DE. The applicant at first instance was a licensee of the EUTM **ARKTIS**, owned by *KBT & Co. Ernst Kruchen agenzia commerciale società*. Under the licence agreement, the applicant is obliged to assert, in its own name, rights arising from the infringement of the licensor's trade mark rights. The licence was not entered in the Register of EUTMs. The questions referred to the CJEU: does the first sentence of Article 23(1) EUTMR ... preclude a licensee who is not entered in the Register of Community trade marks from invoking claims for infringement of a Community trade mark? In the event that the first question is answered in the affirmative: does the first sentence of Article 23(1) EUTMR ... preclude a national legal practice in accordance with which the licensee can enforce the trade mark proprietor's rights against the infringer by virtue of the power conferred on it for that purpose (Prozessstandschaft)? **Findings of CJ:** Article 23(1) EUTMR (previous version) reads: '[I]legal acts referred to in Articles 17, 19 and 22 concerning a Community trade mark will have effects vis-à-vis third parties ... only after entry in the Register. Nevertheless, such an act, before it is so entered, will have effect vis-à-vis third parties who have acquired rights in the trade mark after the date of that act but who knew of the act at the date on which the rights were acquired' (underline added). The CJ found that, in isolation, Article 23(1) EUTMR could be interpreted as requiring registration of the licence in order for a licensee to have the standing to bring an infringement action (para. 18). But, it is necessary to consider not only wording but also the context (para. 19). The context that the CJ considered pertinent to Article 23(1) EUTMR is that it is aimed at safeguarding 'Third parties who have, or are likely to have, rights in EUTM'. The CJ based its conclusions on the following factors: Article 23 EUTMR excludes 'third parties who have acquired rights' but who 'knew of the legal act at the date on which the rights were acquired' or acquired the EUTM or



rights by universal succession (para. 20). Section 4 EUTMR is entitled ‘European Union trade marks as objects of property’ (para. 21). Article 22(3) EUTMR, the licensee’s right to bring proceedings for infringement is subject only to the proprietor’s consent thereto (para. 22). Article 17(6) EUTMR would serve no useful purpose if a licensee had no standing to bring infringement actions (para. 24). The CJ concluded that Article 23(1) EUTMR does not preclude a licensee who is not entered in the Register of EUTMs from bringing proceedings for infringement of an EUTM.

F. Locus standi

♦[T-11/15](#); **SUEDTIROL**; Judgment of 20 July 2016; *Internet Consulting GmbH v EUIPO*; Language of the case: DE. The request for declaration of invalidity of the EUTM **SUEDTIROL** (word mark) for Classes 35, 39 and 42 based on Article 7(1)(c) EUTMR was rejected by the CD. However, the Grand Board reversed that decision and declared the mark invalid as a descriptive indication. The applicant filed an application before the GC based on two pleas in law: (i) an alleged infringement of Article 5 EUTMR in conjunction with Article 56 EUTMR and (ii) an alleged infringement of Article 7(1)(c) EUTMR in conjunction with Article 12 EUTMR and Article 52 EUTMR. **Article 5 EUTMR in conjunction with Article 56 EUTMR**. The applicant alleges that authorities established under public law would not be legitimated to file an invalidity action. The reason would lie in the fact that Article 5 EUTMR, ruling on the capacity to become an owner of an EUTM, does expressly mention authorities established under public law, whereas Article 56(1)(a) EUTMR, ruling on the active legitimation for filing an invalidity, does not. The GC confirms that Article 56(1)(a) EUTMR refers to any legal and natural person, which includes also authorities established under public law. There is no reason for following the applicant’s interpretation. Public entities, to the extent that they have the capacity to sue and be sued, may initiate invalidity proceedings (paras 16 to 20).

G. Professional representation

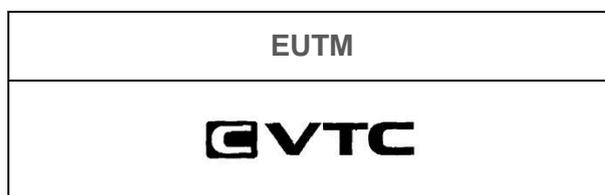
♦[T-512/15](#); **SUN CALI**; Judgment of 22 September 2016; *Sun Cali Inc. v EUIPO*; Language of the case: EN. The EUTM proprietor was granted the registration of the figurative mark **SUN CALI** as an EUTM for goods and services in Classes 18, 25, 35 and 45. An application for invalidity was filed pursuant to Article 53(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR. The CD partly upheld the application for invalidity insofar as goods in Classes 18 and 25 were concerned. Both the invalidity applicant and the EUTM proprietor appealed the CD decision. The BoA joined the appeals and (i) dismissed the EUTM proprietor’s appeal as it considered that it was not duly represented before BoA pursuant to Article 92(2) EUTMR (R 1260/2014-5) and (ii) partly upheld the invalidity applicant’s appeal (R 1281/2014-5). It also declared the EUTM invalid for the services in Class 35. It dismissed the appeal insofar the services in Class 45 were concerned. The EUTM proprietor filed an action before the GC relying on two pleas in law: (i) alleged infringement of Article 92(3) EUTMR and (ii) alleged infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. It found that the EUTM proprietor did not meet the requirements of Article 92 EUTMR and therefore its appeal before BoA was inadmissible. It also confirmed the existence of likelihood of confusion as regards the services in Class 35. **Representation of foreign companies before BoA (R 1260/2014-5)**: the GC assessed whether the applicant (a US based company) met the requirements of Article 92(3) EUTMR so it could be represented by its CEO in her alleged



capacity as an employee of a commercial establishment in Munich. It confirmed BoA assessment. The GC **first** assessed whether the applicant had a real and effective industrial or commercial establishment in the EU so it could be represented before the Office by an employee. GC confirmed that the evidence presented before BoA by the applicant (extracts from a website, pictures of an establishment in Munich) was not capable of proving the real and effective commercial establishment in the EU (para. 28). The GC recalls in this respect the case-law in *Somafer* on the concept of a branch and concludes that the evidence does not show that the establishment in Munich cannot be considered a branch of the US company (para. 30). This is further confirmed by the commercial register extracts submitted by the Other Party (para. 31). **Secondly**, the GC assessed whether the employee of a legal person having its real and effective establishment in the EU could represent another legal person established outside the EU (the applicant) given their economic connections. The GC confirms that the entries in the commercial register of the establishment in Munich show that it was registered as a ‘sole trader’ (paras 33 to 34). The GC considers that, as a matter of principle, a sole trader, with no legal personality, cannot represent a legal person established outside the EU. In any case, even if the sole trader had legal personality, the applicant had not proven any economic connections between the Munich shop and the applicant: the evidence submitted does not show that the two persons are part of the same group, or that the existing management mechanisms are such that one of those two controls the other (para. 36 in fine).

H. Renewals

♦ [C-207/15P](#); **CVTC**; Judgment of 22 June 2016; *Nissan Jidosha KK v EUIPO*; Language of the case: EN.



The EUTM proprietor was granted the registration of the figurative mark shown above for goods in Classes 7, 9 and 12. The proprietor requested, within the 6 months prior to the expiry of its mark (initial period), the partial renewal of that mark for the goods registered in two (out of three) classes. After the expiry of the ‘initial period’, but before the end of the 6 month period following the expiry of its mark (grace period), the applicant requested in addition the renewal of its mark with respect to the goods in the third class. This request was rejected by the Office. The BoA rejected the appeal, and the GC (T-572/12) dismissed the action for annulment. The GC held that the wording of Article 47(3) EUTMR as well as considerations of legal certainty would preclude an EUTM proprietor to proceed to partial renewals staggered over the ‘initial’ and the ‘grace’ period. Following the proposal of the Advocate General, the CJ found that Article 47(3) EUTMR does not prohibit an EUTM to be renewed by means of partial renewal requests staggered over both time periods mentioned in that provision (the ‘initial’ and the ‘grace’ periods) time (para. 51). The GC’s interpretation to the contrary based on the term ‘failing this’ in Article 47(3) EUTMR was rejected on the grounds that (i) the different language versions differ on this particular point (excluding thus any interpretation based on a particular language version, (paras 43 to 46)), that (ii) the only clear condition established by that provision belated renewal requests filed within the ‘grace period’ is the payment of the ‘penalty fee’ for late submission (para. 48), and that (iii) this



reading would be supported by the general objective underlying Articles 46 and 47 EUTMR, which is to assist trade mark proprietors as much as possible in the renewal of their marks and preservation of these economic values (paras 52 to 55). As far as the GC's interpretation was based upon the need to secure legal certainty (partial renewals create effects *erga omnes*), the CJ found that this was (i) partly based on the erroneous interpretation of Article 47(3) EUTMR and (ii) partly based on the erroneous assumption that the registration of a partial renewal of a mark would necessarily require the cancellation from the register of the 'non renewed' goods before the end of the grace period (para. 57). Therefore the CJ annulled both (i) the GC's judgment and (ii) the decision of the BoA.

I. Res judicata

♦[C-226/15 P](#); **ENGLISH PINK / PINK LADY et al.**; Judgment of 21 July 2016; *Apple and Pear Australia, Star Fruits Diffusion v EUIPO*; Language of the case: FR. The applicant sought to register the word mark **ENGLISH PINK** as an EUTM for goods in Class 31. An opposition based on the earlier word mark **PINK LADY**, and other figurative marks, all registered for goods in Class 31, was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The OD dismissed the opposition. The opponent appealed this decision. One year before adopting the contested decision, the BoA was notified of a final judgment of the Belgian EUTM Court — *Tribunal de Commerce de Bruxelles* (TCB) — cancelling the Benelux mark **ENGLISH PINK** (which had been applied for at the same time as the identical contested **ENGLISH PINK** EUTM) because of likelihood of confusion with the earlier trade mark registration for the word mark **PINK LADY** and earlier Benelux trade marks. The TCB found that the Benelux mark **ENGLISH PINK** infringes the **PINK LADY** marks (both EUTMs and Benelux marks) and prohibited the other party from using the sign **PINK LADY** within the EU. The TCB ruled that the **PINK LADY** trade marks enjoy a high degree of protection and that there is a significant LOC between **PINK LADY** and **ENGLISH PINK**. The BoA transmitted the judgment and its translation to the other party, but the contested decision did not even mention it in the summary of the facts. The BoA dismissed the opponent's appeal, thereby taking the opposite view to the TCB: no enhanced distinctiveness, no Article 8(5) EUTMR, no likelihood of confusion. The opponent filed an action before the GC relying on seven pleas in law. The GC annulled the BoA's decision based on the first plea, because it had not taken account of the judgment of the TCB and had not assessed the potential impact that that judgment could have on the outcome of the opposition proceedings. The GC rejected the action as to the remainder. The opponent filed an action before the CJEU raising three grounds of appeal: (i) alleged infringement of the principle of *res judicata*; (ii) alleged infringement of the general principles of legal certainty, sound administration and the protection of legitimate expectations; (iii) alleged infringement of the GC of Article 65(3) EUTMR by refusing to alter the contested decision. The CJ dealt with the first and second ground together, which in essence claimed that the judgment of TCB was *res judicata*, and therefore binding on the BoA. The judgment of the TCB is, *prima facie*, a relevant factual element for resolving the case in question, as there are essential common points between the factual aspects at issue. In failing to assess the potential impact of this judgment for the outcome of the dispute before it, the BoA failed to assess all the relevant factual aspects of the case with the required diligence and infringed the principle of sound administration. The GC stated further that the judgment of the TCB is not in itself sufficient to enable the GC to alter the contested decision and to ascertain which decision the BoA was required to take. When exercising its exclusive jurisdiction over registration of EUTMs and when examining oppositions lodged against EUTM applications, the Office is not bound by a decision of an EUTM court delivered in an action for infringement. The unitary character of the EUTM does



not mean that the principle of *res judicata* precludes the Office and, consequently, the European courts, from examining the possible existence of a likelihood of confusion in the context of the opposition proceedings concerning the registration of a new EUTM, even though it is identical to a national mark, which has been held by an EUTM court to undermine the earlier trade mark. The CJ confirms that there is no provision in the EUTMR whereby the Office is bound by a decision of an EUTM court delivered in an action for infringement when it exercises its exclusive jurisdiction over registration of EUTMs and when, in so doing, it examines oppositions lodged against applications to register EUTMs (para. 48). The CJ also confirms that the subject-matters of the proceedings before the TCB and the Office are not identical. The infringement action sought the annulment of the Benelux mark **ENGLISH PINK** and an order to refrain from using that sign throughout the territory of the Union, whilst the proceedings before the Office concerned opposition to the registration of the EUTM **ENGLISH PINK** (para. 54). The principle of *res judicata* does not impose that the BoA of the Office was bound by the judgment of the TCB (para. 64).

J. Restitutio in integrum (Article 67 CDR and Article 81 EUTMR)

[T-279/15](#); **DESIGN OF TYRE TREAD**; Judgment of 23 February 2016; *Pirelli Tyre SpA v OHIM*; Language of the case: EN.

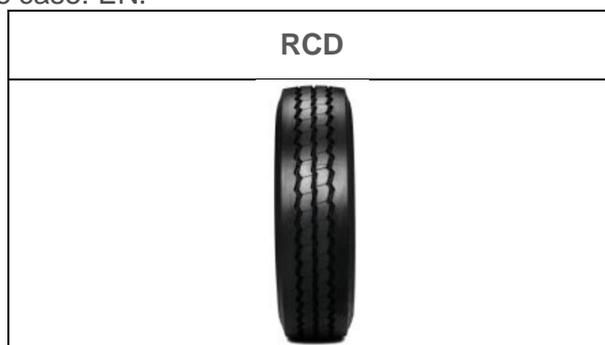


Following a reminder, the professional representative of the RCD's holder was notified by the Office of the definitive expiry of the RCD. The failure to renew was due to the fact the RCD was part of a larger portfolio of rights whose renewal was entrusted to the professional representative after the previous management by another firm: by mistake, the RCD holder had not communicated to its professional representative that the RCD in question was among the rights of this portfolio. Only after the notification of the RCD's expiry would the RCD holder have been aware of the failure to comply with the renewal time limit. The RCD holder sent a request for *restitutio in integrum* pursuant to Article 67 CDR. The request was refused by the Office. The BoA dismissed the appeal against the Office's decision. The RCD holder filed an application before the GC for the annulment of the decision of the BoA. The GC found that the duty of care pursuant to Article 67 CDR fell in principle and first of all on the professional representative. Therefore, it was irrelevant whether the RCD holder's duty of care was fulfilled (paras 16 to 21). As for the duty of care of the professional representative, it might be true that, when the professional representative was entrusted with the task of renewing the portfolio of rights, the RCD in question was not mentioned. However, the professional representative could not ignore, because of its experience and knowledge, the prejudicial consequences of the expiry of the renewal time limit for the RCD holder. It follows that the professional representative did not fulfil its duty of care when it did not inform the



RCD holder of the impending expiry of the RCD (paras 22 to 27). The action was therefore dismissed (para. 32).

[T-280/15](#); **DESIGN OF TYRE TREAD**; Judgment of 23 February 2016; *Pirelli Tyre SpA v OHIM*; Language of the case: EN.



Following a reminder, the professional representative of the RCD's holder was notified by the Office of the definitive expiry of the RCD. The failure to renew was due to the fact the RCD was part of a larger portfolio of rights whose renewal was entrusted to the professional representative after the previous management by another firm: by mistake, the RCD holder had not communicated to its professional representative that the RCD in question was among the rights of this portfolio. Only after the notification of the RCD's expiry would the RCD holder have been aware of the failure to comply with the renewal time limit. The RCD holder sent a request for *restitutio in integrum* pursuant to Article 67 CDR. The request was refused by the Office. The BoA dismissed the appeal against the Office's decision. The RCD holder filed an application before the GC for the annulment of the decision of the BoA. The GC found that the duty of care pursuant to Article 67 CDR fell in principle and first of all on the professional representative. Therefore, it was irrelevant whether the RCD holder's duty of care was fulfilled (paras 16 to 21). As for the duty of care of the professional representative, it might be true that, when the professional representative was entrusted with the task of renewing the portfolio of rights, the RCD in question was not mentioned. However, the professional representative could not ignore, because of its experience and knowledge, the prejudicial consequences of the expiry of the renewal time limit for the RCD holder. It follows that the professional representative did not fulfil its duty of care when it did not inform the RCD holder of the impending expiry of the RCD (paras 22 to 27). The action was therefore dismissed (para. 32).

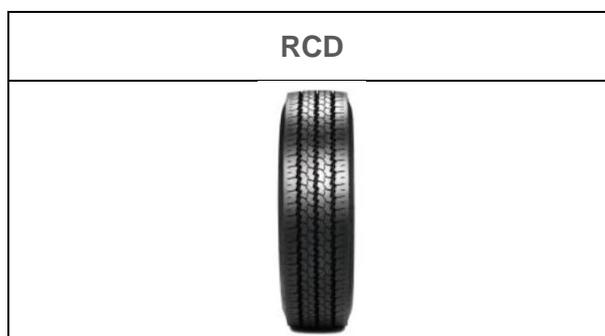
[T-281/15](#); **DESIGN OF TYRE TREAD**; Judgment of 23 February 2016; *Pirelli Tyre SpA v OHIM*; Language of the case: EN.





Following a reminder, the professional representative of the RCD's holder was notified by the Office of the definitive expiry of the RCD. The failure to renew was due to the fact the RCD was part of a larger portfolio of rights whose renewal was entrusted to the professional representative after the previous management by another firm: by mistake, the RCD holder had not communicated to its professional representative that the RCD in question was among the rights of this portfolio. Only after the notification of the RCD's expiry would the RCD holder have been aware of the failure to comply with the renewal time limit. The RCD holder sent a request for *restitutio in integrum* pursuant to Article 67 CDR. The request was refused by the Office. The BoA dismissed the appeal against the Office's decision. The RCD holder filed an application before the GC for the annulment of the decision of the BoA. The GC found that the duty of care pursuant to Article 67 CDR fell in principle and first of all on the professional representative. Therefore, it was irrelevant whether the RCD holder's duty of care was fulfilled (paras 16 to 21). As for the duty of care of the professional representative, it might be true that, when the professional representative was entrusted with the task of renewing the portfolio of rights, the RCD in question was not mentioned. However, the professional representative could not ignore, because of its experience and knowledge, the prejudicial consequences of the expiry of the renewal time limit for the RCD holder. It follows that the professional representative did not fulfil its duty of care when it did not inform the RCD holder of the impending expiry of the RCD (paras 22 to 27). The action was therefore dismissed (para. 32).

[T-282/15](#); **DESIGN OF TYRE TREAD**; Judgment of 23 February 2016; *Pirelli Tyre SpA v OHIM*; Language of the case: EN.



Following a reminder, the professional representative of the RCD's holder was notified by the Office of the definitive expiry of the RCD. The failure to renew was due to the fact the RCD was part of a larger portfolio of rights whose renewal was entrusted to the professional representative after the previous management by another firm: by mistake, the RCD holder had not communicated to its professional representative that the RCD in question was among the rights of this portfolio. Only after the notification of the RCD's expiry would the RCD holder have been aware of the failure to comply with the renewal time limit. The RCD holder sent a request for *restitutio in integrum* pursuant to Article 67 CDR. The request was refused by the Office. The BoA dismissed the appeal against the Office's decision. The RCD holder filed an application before the GC for the annulment of the decision of the BoA. The GC found that the duty of care pursuant to Article 67 CDR fell in principle and first of all on the professional representative. Therefore, it was irrelevant whether the RCD holder's duty of care was fulfilled (paras 16 to 21). As for the duty of care of the professional representative, it might be true that, when the professional representative was entrusted with the task of renewing the portfolio of rights, the RCD in question was not mentioned. However, the



professional representative could not ignore, because of its experience and knowledge, the prejudicial consequences of the expiry of the renewal time limit for the RCD holder. It follows that the professional representative did not fulfil its duty of care when it did not inform the RCD holder of the impending expiry of the RCD (paras 22 to 27). The action was therefore dismissed (para. 32).

[T-583/15](#); **DEVICE OF THE PEACE SYMBOL**; Judgment of 8 June 2016; *Monster Energy v EUIPO*; Language of the case: EN.



The applicant sought to register the figurative mark represented above as an EUTM application for goods in Classes 5, 30 and 32. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b) EUTMR, as it was found to be devoid of distinctive character. The decision was confirmed by the BoA. Following a check on the progress of the case, the applicant discovered that the decision had been taken by the BoA, however, the applicant claimed before the BoA that it had not received the notification of the BoA's decision. It filed an appeal to the GC against that decision (T-633/14, dismissed as manifestly inadmissible owing to its belated nature), and at the same time, a *restitutio in integrum* request pursuant to Article 81 EUTMR before the Registry of the BoA, where it sought to re-establish its rights to challenge the BoA's decision before the GC. The Registry of the BoA informed the applicant that the request could not be allowed as Article 81 EUTMR concerns only deadlines *vis-à-vis* the Office and that the transmission report of the fax machine confirmed that the BoA's decision was duly notified. Following that, the applicant filed an appeal with the Office against the letter of the Registry. The appeal was found inadmissible by the BoA. The BoA stated that the letter from the Registry was not a decision originating from a first instance division, which could be subject to appeal before it. It further added that in any event, Article 81(1) EUTMR was not applicable to the time limit fixed in Article 65(5) EUTMR to bring an action before the GC and it was not competent to decide on the application, as *restitutio* had been requested regarding a time limit *vis-à-vis* the GC and not *vis-à-vis* the Office. That decision by the BoA was challenged before the GC. To acknowledge that one of the Office's departments has the power to grant an application for *restitutio in integrum* as regards a time limit for bringing an action before the GC would mean encroaching upon the jurisdiction of that Court, which is the only Court, subject to review by the CJ, which may assess whether a case that has been brought before it is admissible, in accordance with Articles 256 and 263 TFEU (para. 41). The applicant's arguments based on considerations of vocabulary and on the fact that the Office is concerned in various ways by the period for bringing an action before the GC cannot succeed (para. 47). The BoA was therefore right in declaring itself not competent, like the Registry of the BoA, to examine the application for *restitutio in integrum* filed by the applicant (para. 52).

[T-585/15](#); **GREEN BEANS**; Judgment of 8 June 2016; *Monster Energy Company v EUIPO*; Language of the case: EN. The applicant sought to register the word mark **GREEN BEANS** as an EUTM application for goods in Classes 5, 30 and 32. The Office refused the



registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR, as it was found to be devoid of distinctive character and to be descriptive. The decision was confirmed by the BoA. Following a check on the progress of the case, the applicant discovered that the decision had been taken by the BoA. The applicant claimed before the BoA that it had not received the notification of the BoA's decision. It filed an appeal to the GC against that decision (T-666/14, dismissed as manifestly inadmissible owing to its belated nature), and at the same time, a *restitutio in integrum* request pursuant to Article 81 EUTMR before the Registry of the BoA, where it sought to re-establish its rights to challenge the BoA's decision before the GC. The Registry of the BoA informed the applicant that the request could not be allowed as Article 81 EUTMR concerns only deadlines *vis-à-vis* the Office and that the transmission report of the fax machine confirmed that the BoA's decision was notified. Following that, the applicant filed an appeal with the Office against the letter of the Registry. The appeal was found inadmissible by the BoA. The BoA stated that the letter from the Registry was not a decision originating from a first instance division, which could be subject to appeal before it. It further added that in any event, Article 81(1) EUTMR was not applicable to the time limit fixed in Article 65(5) EUTMR to bring an action before the GC and it was not competent to decide on the application, as *restitutio* had been requested regarding a time limit *vis-à-vis* the GC and not *vis-à-vis* the Office. That decision by the BoA was challenged before the GC. To acknowledge that one of the Office's departments has the power to grant an application for *restitutio in integrum* as regards a time limit for bringing an action before the GC would mean encroaching upon the jurisdiction of that Court, which is the only Court, subject to review by the CJ, which may assess whether a case that has been brought before it is admissible, in accordance with Articles 256 and 263 TFEU (para. 39). The applicant's arguments based on considerations of vocabulary and on the fact that the Office is concerned in various ways by the period for bringing an action before the GC cannot succeed (para. 45). The BoA was therefore right in declaring itself not competent, like the Registry of the BoA, to examine the application for *restitutio in integrum* filed by the applicant (para. 50).

K. Suspensions

♦[T-643/14](#); **ABTRONIC / TRONIC**; Judgment of 12 May 2016; *Red Lemon Inc v EUIPO*; Language of the case: DE. The BoA confirmed the refusal of the EUTM application for a word mark **ABTRONIC** upon an opposition based on the earlier word mark **TRONIC** for goods in Class 9 pursuant to Article 8(1)(b) EUTMR. The applicant filed an action before the GC claiming an infringement of Article 8(1)(b) EUTMR. First the GC rejected the request for the stay until a cancellation action brought by the applicant against the earlier trade mark is decided, because the action was filed after the decision of the BoA was rendered and cannot affect its legality. Moreover, the application for revocation due to non-use of the earlier mark would only produce its effects as from the date of the application for cancellation as seen in Article 55 EUTMR (paras 13 to 18).

♦[T-775/14](#); **ABTRONIC / TRONIC**; Judgment of 12 May 2016; *Red Lemon Inc v EUIPO*; Language of the case: DE. The BoA confirmed the refusal of the EUTM application for the figurative mark **ABTRONIC** upon an opposition based on the earlier word mark **TRONIC** for goods in Class 9 pursuant to Article 8(1)(b) EUTMR. The applicant filed an action before the GC claiming an infringement of Article 8(1)(b) EUTMR. First the GC rejected the request for the stay until a cancellation action brought by the applicant against the earlier trade mark is decided, because the action was filed after the decision of the BoA was rendered and cannot



affect its legality. Moreover, the application for revocation due to non-use of the earlier mark would only produce its effects as from the date of the application for cancellation as seen in Article 55 EUTMR (paras 13 to 18).

♦[T-776/14](#); **ABTRONICX2 / TRONIC**; Judgment of 12 May 2016; *Red Lemon Inc v EUIPO*; Language of the case: DE. The BoA confirmed the refusal of the EUTM application for a figurative mark **ABTRONICX2** upon an opposition based on the earlier word mark **TRONIC** for goods in Class 9 pursuant to Article 8(1)(b) EUTMR. The applicant filed an action before the GC claiming an infringement of Article 8(1)(b) EUTMR. First the GC rejected the request for the stay until a cancellation action brought by the applicant against the earlier trade mark is decided, because the action was filed after the decision of the BoA was rendered and cannot affect its legality. Moreover, the application for revocation due to non-use of the earlier mark would only produce its effects as from the date of the application for cancellation as seen in Article 55 EUTMR (paras 13 to 18).



Annex 1:

Alphabetical list of GC and CJ judgments and important orders in 2016 by nickname of trade mark

Actions on Appeal from the Office

♦ **1e1 / UNOE et al.**; Judgment of 1 March 2016 in Case [T-61/15](#); *1&1 Internet AG v OHIM*

69; Judgment of 8 September 2016 in Case [T-360/15](#); *Dr Vita sp. z o.o., v EUIPO*

♦ **100% Capri / CAPRI**; Judgment of 19 April 2016 in Case [T-198/14](#); *100% Capri Italia Srl v EUIPO* [on page(s):]

3D / 3D's et al.; Judgment of 13 September 2016 in Case [T-390/15](#); *Perfetti Van Melle Benelux BV v EUIPO*

♦ **ABTRONIC / TRONIC**; Judgment of 12 May 2016 in Case [T-643/14](#); *Red Lemon Inc v EUIPO*

♦ **ABTRONIC / TRONIC**; Judgment of 12 May 2016 in Case [T-775/14](#); *Red Lemon Inc v EUIPO*

♦ **ABTRONICX2 / TRONIC**; Judgment of 12 May 2016 in Case [T-776/14](#); *Red Lemon Inc v EUIPO*

AEROSTONE / STONE et al.; Judgment of 28 January 2016 in Case [T-194/14](#); *Bristol Global Co. Ltd v OHIM*

♦ **AFRICAN SIMBA / SIMBA et al.**; Judgment of 28 January 2016 in Case [T-687/14](#); *Novomatic AG, v OHIM*

♦ **AFRODITA COSMETICS / EXOTIC AFRODITA MYSTIC MUSK OIL et al.**; Judgment of 28 September 2016 in case [T-575/15](#); *Kozmetika Afrodita d. o. o. v EUIPO*

♦ **Alfredo alla Scrofa / L'ORIGINALE ALFREDO**; Judgment of 6 July 2016 in Case [T-96/15](#); *Mario Mozzetti v EUIPO*

♦ **airpass.ro / AirPlus International**; Judgment of 20 October 2016 in Case [T-14/15](#); *Lufthansa AirPlus Servicekarten GmbH v EUIPO*

ALDIANO / ALDI; Judgment of 15 December 2016 in Case [T-391/15](#); *Aldi GmbH & Co. KG v EUIPO*

♦ **ALFREDO'S GALLERY alla Scrofa Roma / L'ORIGINALE ALFREDO**; Judgment of 6 July 2016 in Case [T-97/15](#); *Mario Mozzetti v EUIPO*

Animal / ANIMAL; Judgments of 29 June 2016 in Cases [T-727/14](#) and [T-728/14](#) (joined cases); *Universal Protein Supplements Corp. v EUIPO*

Anna Smith / SMITH; Order of 18 April 2016 in Case [T-295/15](#); *Yongyu Zhang v EUIPO*

APAX / APAX et al.; Judgment of 13 December 2016 in Case [T-58/16](#); *Apax Partners LLP v EUIPO*

APlan; Judgment of 14 December 2016 in Case [T-154/16](#); *Grid applications GmbH v EUIPO*

♦ **APOTEKE**; Judgment of 13 September 2016 in Case [T-563/15](#); *Pagliari Sell System Sp.A v*



EUIPO

♦ **AQUALOGY / AQUALIA et al.**; Judgment of 25 February 2016 in Case [T-402/14](#); *FCC Aqualia S.A. v OHIM*

♦♦ **AROMA**; Judgment of 12 May 2016 in Case [T-749/14](#); *Peter Chung-Yuan Chang v EUIPO*

♦ **ARKTIS**; Order of 22 June 2016 in Case [C-295/15](#); *Matratzen Concord GmbH v EUIPO*

♦ **ASTEX / ALPEX**; Judgment of 30 September 2016 in Case [T-355/15](#); *Alpex Pharma SA v EUIPO*

♦ **bambinoLÜK / BAMBINO**; Judgment of 26 October 2016 in Case [C-482/15 P](#); *Westermann Lernspielverlage GmbH v EUIPO*

BasenCitrato; Judgment of 15 December 2016 in Case [T-330/15](#); *Rudolf Keil v EUIPO*

B'lue / BLU DE SAN MIGUEL; Judgment of 28 September 2016 in Case [T-803/14](#); *Compagnie Gervais Danone v EUIPO*

B!O / bo; Judgment of 18 February 2016 in Case [T-364/14](#); *Penny-Market GmbH v OHIM*

BAG PAX; Order of 10 May 2016 in Case [T-324/15](#); *Volkswagen AG v EUIPO*

BIG BINGO; Judgment of 14 January 2016 in Case [T-663/14](#); *International Gaming Projects Ltd v OHIM*

BK PARTNERS / bk. et al.; Judgment of 22 September 2016 in Case [T-228/15](#); *Grupo de originación y análisis, S.L. v EUIPO*

Bon Appétit! / Bon Apetí et al.; Judgment of 2 February 2016 in Case [T-485/14](#); *Bon Net OOD v OHIM*

BOTANIC W & H LONDON DRY GIN / THE BOTANICALS; Judgment of 4 May 2016 in Case [T-193/15](#); *Bodegas Williams & Humbert, S.A. v EUIPO*

♦ **BRAUWELT**; Judgment of 18 October 2016 in Case [T-56/15](#); *Raimund Schmitt Verpachtungsgesellschaft mbH & Co.KG v EUIPO*

♦ **Bugui va / BUGUI et al.**; Judgment of 21 July 2016 in Case [C-597/14 P](#); *Xavier Grau Ferrer v EUIPO*

♦♦ **Café del Sol / CAFE DEL SOL et al.**; Judgment of 13 December 2016 in Case [T-548/15](#); *Ramón Guiral Broto v EUIPO*

♦♦ **CAFE DEL SOL / Café del Sol et al.**; Judgment of 13 December 2016 in Case [T-549/15](#); *Ramón Guiral Broto v EUIPO*

♦ **CAFFÈ NERO**; Judgment of 27 October 2016 in Case [T-29/16](#); *Caffè Nero Group Ltd v EUIPO*

♦ **CAFFÈ NERO**; Judgment of 27 October 2016 in Case [T-37/16](#); *Caffè Nero Group Ltd v EUIPO*

♦♦ **CALCILITE**; Judgment of 19 July 2016 in Case [T-742/14](#); *Alpha Calcit Füllstoffgesellschaft mbH v EUIPO*

Carrera / CARRERA; Judgment of 21 January 2016 in Case [C-50/15 P](#); *Kurt Hesse v OHIM*

Casale Fresco / FREZCO; Judgment of 26 May 2016 in Case [T-254/15](#); *Aldi Einkauf GmbH & Co. OHG v EUIPO*



♦**Castello / Castelló et al.**; Judgment of 4 October 2016 in Case [T-549/14](#); *Lidl Stiftung & Co. KG v EUIPO*

♦**CHEMPIOIL / CHAMPION**; Judgment of 1 June 2016 in Case [T-34/15](#); *Wolf Oil Corp. v EUIPO / UAB SCT Lubricants*

♦**CITRUS SATURDAY / CITRUS**; Judgment of 28 September 2016 in Case [T-400/15](#); *Ana Isabel Pinto Eliseu Baptista Lopes Canhoto v EUIPO*

♦**CLAN / CLAN MACGREGOR**; Judgment of 24 November 2016 in Case [T-250/15](#); *Speciality Drinks Ltd v EUIPO*

CLOVER CANYON / CANYON; Judgment of 20 October 2016 in Case [T-693/15](#); *Clover Canyon, Inc. v EUIPO*

comfotherm / KOMFOTHERM; Judgment of 28 April 2016 in Case [T-267/14](#); *Zehnder Group International AG v EUIPO*

♦**compressor technology / KOMPRESSOR et al.**; Judgment of 8 November 2016 in Case [C-43/15 P](#); *BSH Bosch und Siemens Hausgeräte GmbH v EUIPO*

♦**ConnectedWork**; Judgment of 14 July 2016 in Case [T-491/15](#); *Volkswagen AG v EUIPO*

COYOTE UGLY / COYOTE UGLY; Judgment of 3 March 2016 in Case [T-778/14](#); *Ugly, Inc. v OHIM*

CRETEO / STOCRETE et al.; Judgment of 28 January 2016 in Case [T-640/13](#); *Sto SE & Co. KGaA v OHIM*

Curodont / Eurodont; Judgment of 10 March 2016 in Case [T-53/15](#); *credentis AG v OHIM*

♦**CVTC**; Judgment of 22 June 2016 in Case [C-207/15 P](#); *Nissan Jidosha KK v EUIPO*

CHOICE CHOCOLATE & ICE CREAM; Judgment of 12 April 2016 in Case [T-361/15](#); *Choice sp. z o.o., v EUIPO*

Daylong, Judgment of 19 April 2016 in Case [T-261/15](#); *Spirig Pharma AG v EUIPO*

♦**DESIGN OF DECORATIVE GRAPHIC SYMBOLS**; Judgment of 14 July 2016 in Case [T-420/15](#); *Thun 1794 v EUIPO*

DESIGN OF TYRE TREAD; Judgment of 23 February 2016 in Case [T-279/15](#); *Pirelli Tyre SpA v OHIM*

DESIGN OF TYRE TREAD; Judgment of 23 February 2016 in Case [T-280/15](#); *Pirelli Tyre SpA v OHIM*

DESIGN OF TYRE TREAD; Judgment of 23 February 2016 in Case [T-281/15](#); *Pirelli Tyre SpA v OHIM*

DESIGN OF TYRE TREAD; Judgment of 23 February 2016 in Case [T-282/15](#); *Pirelli Tyre SpA v OHIM*

♦**DEVICE OF A BLACK SQUARE WITH FOUR WHITE STRIPES / DEVICE OF THREE VERTICAL WAVY LINES et al.**; Judgment of 14 July 2016 in Case [T-567/15](#); *Monster Energy Company v EUIPO*

DEVICE OF A BODYBUILDER; Judgment of 29 September 2016 in Case [T-335/15](#); *Universal Protein Supplements Corp., established in New Brunswick, New Jersey (United States) v EUIPO*



♦ **DEVICE OF A CRESCENT**; Judgment of 15 December 2016 in Case [T-678/15](#) and [T-679/15](#) (joint cases); *Novartis AG v EUIPO*

♦ **DEVICE OF A HORSE BIT / DEVICE OF A HORSE BIT et al.**; Judgment of 9 November 2016 in Case [T-716/15](#); *D. Juan Gallardo Blanco v EUIPO*

♦♦ **DEVICE OF A JUMPING ANIMAL / PUMA et al.**; Judgment of 9 September 2016 in Case [T-159/15](#); *Puma SE v EUIPO*

♦♦ **DEVICE OF A PATTERN**; Judgment of 9 November 2016 in Case [T-579/14](#); *Birkenstock Sales GmbH v EUIPO*

♦ **DEVICE OF A POLYGON**; Judgment of 13 September 2016 in Case [T-146/15](#); *hyphen GmbH v EUIPO*

DEVICE OF A SOLAR CELL; Judgment of 24 November 2016 in Case [T-578/15](#); *Azur Space Solar Power GmbH v EUIPO*

♦ **DEVICE OF AN UNIDENTIFIABLE ANIMAL / DEVICE OF A PUMA et al.**; Judgment of 25 February 2016 in Case [T-692/14](#); *PUMA SE v OHIM*

DEVICE OF BLACK LINES; Judgment of 24 November 2016 in Case [T-614/15](#); *Azur Space Solar Power GmbH v EUIPO*

♦ **DEVICE OF FOUR INTERLOCKING Gs / GG**; Judgment of 11 October 2016 in Case [T-461/15](#); *Guccio Gucci SpA v EUIPO and Guess? IP Holder LP*

♦ **DEVICE OF FOUR INTERLOCKING Gs / GG**; Judgment of 11 October 2016 in Case [T-753/15](#); *Guccio Gucci SpA v EUIPO and Guess? IP Holder LP*

DEVICE OF THE PEACE SYMBOL; Judgment of 8 June 2016 in Case [T-583/15](#); *Monster Energy v EUIPO*

DEVICE OF WHITE AND BLUE SQUARE-SHAPED PACKAGING; Judgment of 10 May 2016 in Case [T-806/14](#); *August Storck KG v EUIPO*

Dino / Device of a dinosaur; Judgment of 26 April 2016 in Case [T-21/15](#); *Franmax UAB v EUIPO*

♦ **DoggiS / DoggiS et al.**; Judgment of 28 January 2016 in Case [T-335/14](#); *José-Manuel Davó Lledó v OHIM*

♦ **Dolokorn / DOLOPUR**; Judgment of 24 November 2016 in Case [T-769/15](#); *SeNaPro GmbH v EUIPO*

♦ **Du bist, was du erlebst.**; Judgment of 31 May 2016 in Case [T-301/15](#); *Jochen Schweizer GmbH v EUIPO*

Dynamic Life / DYNAMIN; Judgment of 3 May 2016 in Case [T-454/15](#); *Laboratorios Ern, SA v EUIPO*

♦ **E / E**; Judgment of 15 March 2016 in Case [T-645/13](#); *Evcharis Nezi v OHIM*

e@sy Credit / EasyCredit; Judgment of 20 July 2016 in Case [T-745/14](#); *TeamBank AG Nürnberg v EUIPO*

EFEKT PERLENIA; Judgment of 12 May 2016 in Case [T-298/15](#); *Atlas sp. z o.o., v EUIPO*



♦ **ELECTRIC HIGHWAY**; Judgment of 17 November 2016 in Case [T-315/15](#); *Dale Vince v EUIPO*

ELGO / ERGO; Judgment of 12 May 2016 in Case [T-750/14](#); *Ivo-Kermartin GmbH v EUIPO*

e-miglia / MILLE MIGLIA; Judgment of 30 November 2016 in Case [T-458/15](#); *Rebel Media Ltd, Automobile Club di Brescia v EUIPO Rebel Media Ltd*

♦ **eSMOKINGWORLD**; Judgment of 29 November 2016 in Case [T-617/15](#); *Chic Investments sp. z o.o., v EUIPO*

♦ **ENGLISH PINK / PINK LADY et al.**; Judgment of 21 July 2016 in Case [C-226/15 P](#); *Apple and Pear Australia, Star Fruits Diffusion v EUIPO*

♦♦ **EUROMARKER / EURIMARK**; Judgment of 2 February 2016 in Case [T-683/13](#); *Brammer GmbH v OHIM*

FERLI; Judgment of 1 December 2016 in Case [T-775/15](#); *EK/servicegroup eG v EUIPO*

♦ **FITNESS**; Judgment of 28 September 2016 in Case [T-476/15](#); *European Food S.A. v EUIPO*

♦♦ **FONTOLIVA / FUENOLIVA**; Judgment of 6 December 2016 in Case [T-24/16](#); *Sovena Portugal — Consumer Goods, SA v EUIPO — Mueloliva, SL*

fortune / FORTUNE-HOTELS; Judgment of 8 November 2016 in Case [T-579/15](#); *For Tune sp. z o.o. v EUIPO — Gastwerk Hotel Hamburg GmbH & Co. KG*

♦ **FRISA / Frinsa F**; Judgment of 8 April 2016 in Case [T-638/14](#); *Frinsa del Noroeste v EUIPO*

♦ **FRUIT**; Judgment of 7 July 2016 in Case [T-431/15](#); *Fruit of the Loom, Inc. v EUIPO*

♦ **Fruitfuls**; Judgment of 18 October 2016 in Case [T-367/14](#); *August Storck KG v EUIPO & Chiquita Brands LLC*

Ganz schön ausgeschlafen; Order of 28 November 2016 in Case [T-225/16](#); *Matratzen Concord GmbH v EUIPO*

GO SPORT / GO; Judgment of 6 December 2016 in Case [T-703/15](#); *Groupe Go Sport v EUIPO*

Gourmet / Gourmet; Judgment of 15 December 2016 in Case [T-212/15](#); *Aldi GmbH & Co. KG v EUIPO*

GREEN BEANS; Judgment of 8 June 2016 in Case [T-585/15](#); *Monster Energy Company v EUIPO*

♦♦ **GROUP Company TOURISM & TRAVEL / GROUP Company TOURISM & TRAVEL**; Judgment of 29 June 2016 in Case [T-567/14](#); *Group OOD v EUIPO and Kosta Lliev*

♦♦ **GUGLER**; Judgment of 28 January 2016 in Case [T-674/13](#); *Gugler France v OHIM*

Gummi Bear-Rings / GUMMY; Judgment of 26 February 2016 in Case [T-210/14](#); *Mederer GmbH v OHIM*

♦♦ **HARRY'S BAR / PUB CASINO Harrys RESTAURANG et al.**; Judgments of 18 February 2016 in [T-711/13](#) and [T-716/13](#) (joined cases); *Harrys Pubar AB v OHIM and Harry's New York Bar SA v OHIM*



♦ **HARRY'S NEW YORK BAR / PUB CASINO Harrys RESTAURANG et al.**; Judgments of 18 February 2016 in [T-84/14](#) and [T-97/14](#) (joined cases); *Harrys Pubar AB v OHIM* and *Harry's New York Bar SA v OHIM*

♦ **HENLEY / HENLEYS**; Judgment of 28 September 2016 in Case [T-362/15](#); *The Lacamanda Group Ltd, established in Manchester (United Kingdom) v EUIPO*

♦ **HOKEY POKEY / HOKEY POKEY**; Judgment of 21 January 2016 in Case [T-62/14](#); *EKBR IP Holder LLC v OHIM*

HOT JOKER / JOKER; Judgment of 19 April 2016 in Case [T-326/14](#); *Novomatic AG v EUIPO*

♦ **HOTOGO SELF / HEATING CAN TECHNOLOGY-M**; Judgment of 20 October 2016 in Case [T-407/15](#); *Monster Energy Company v EUIPO / Hot-Can Intellectual Property Sdn Bhd*

♦ **HOT SOX**; Judgment of 26 February 2016 in Case [T-543/14](#); *provima Warenhandels GmbH v OHIM*

IPVanish; Judgment of 17 March 2016 in Case [T-78/15](#); *Mudhook Marketing, Inc. v OHIM*

ILLIRIA / CASTILLO DE LIRIA et al.; Judgment of 2 February 2016 in Case [T-541/14](#); *Antica Azienda Agricola Vitivinicola Dei Conti Leone De Castris Srl v OHIM*

keep it easy; Judgment of 20 July 2016 in Case [T-308/15](#); *Peter Reisenhel v EUIPO*

♦ **kicktipp / KICKERS et al.**; Judgment of 5 February 2016 in Case [T-135/14](#); *Kicktipp GmbH v OHIM*

♦ **KOALA LAND / KOALA**; Judgment of 14 September 2016 in Case [T-479/15](#); *Lotte Co. Ltd. v EUIPO*

♦ **KOZMETIKA AFRODITA / EXOTIC AFRODITA MYSTIC MUSK OIL et al.**; Judgment of 28 September 2016 in Case [T-574/15](#); *Kozmetika Afrodita d. o. o. v EUIPO*

♦ **KRISTAL / HOME CRISTAL**; Judgment of 14 July 2016 in Case [T-345/15](#); *Modas Cristal, S.L. v EUIPO*

KULE / CULE; Judgment of 16 June 2016 in Case [T-614/14](#); *Fútbol Club Barcelona v EUIPO*

LA TARTE TROPÉZIENNE 1955. SAINT-TROPEZ; Judgment of 28 October 2016 in Case [T-7/16](#); *LA TARTE TROPÉZIENNE v EUIPO*

♦ **Lenah.C / LEMA**; Judgment of 21 January 2016 in Case [T-802/14](#); *Laboratorios Ern, S.A. v OHIM*

♦ **LIDL / LIDL MUSIC et al.**; Order of 6 September 2016 in Case [C-224/14 P](#); *Lidl Stiftung & Co. KG v EUIPO — Lidl Music spol. s r.o.*

♦ **LIDL express / LIDL MUSIC et al.**; Order of 6 September 2016 in Case [C-237/14 P](#); *Lidl Stiftung & Co. KG v EUIPO — Lidl Music spol. s r.o.*

Liiga; Judgment of 28 April 2016 in Case [T-54/15](#); *Jaakiekon SM-liiga Oy v EUIPO*

♦ **LOTTE / SCHÖLLER KOALA**; Order of 7 September 2016 in Case [C-586/15 P](#); *Lotte Co. Ltd GmbH v EUIPO*

LR nova pure. / NOVA; Judgment of 26 January 2016 in Case [T-202/14](#); *LR Health & Beauty Systems GmbH v OHIM*



- LUCEO**; Judgment of 7 July 2016 in Case [T-82/14](#); *Copernicus Trademarks Ltd. v EUIPO*
- Iuvo / Iuvo**; Judgment of 27 September 2016 in Case [T-449/15](#); *Satkirit Holdings Ltd v EUIPO*
- Iuvoworld / Iuvo**; Judgment of 27 September 2016 in Case [T-450/15](#); *Satkirit Holdings Ltd v EUIPO*
- MACCOFFEE**; Judgment of 5 July 2016 in Case [T-518/13](#); *Future Enterprises Pte Ltd v EUIPO — McDonald's International Property Co. Ltd*
- ♦ **MAD CATZ / MONSTER et al.**; Judgment of 14 July 2016 in Case [T-429/15](#); *Monster Energy Company v EUIPO*
- ♦ **MAGNEXT / MAGNET 4**; Judgment of 1 June 2016 in Case [T-292/12 RENV](#); *Mega Brands International, Luxembourg, Zweigniederlassung Zug v EUIPO*
- MANGO**; Judgment of 23 February 2016 in Case [T-761/14](#); *Consolidated Artists BV v OHIM*
- Mark1**; Judgment of 12 May 2016 in Case [T-844/14](#); *GRE Grand River Enterprises Deutschland GmbH v EUIPO*
- Mark1**; Judgment of 12 May 2016 in Case [T-32/15](#); *GRE Grand River Enterprises Deutschland GmbH v EUIPO*
- ♦ **MEGABUS.COM**; Order of 25 May 2016 in Case [T-805/14](#); *Stagecoach Group plc v EUIPO*
- MEISSEN KERAMIK**; Judgment of 18 October 2016 in Case [T-776/15](#); *Meissen Keramik GmbH v EUIPO*
- ♦ **MEISSEN / MEISSEN et al.**; Judgment of 14 June 2016 in Case [T-789/14](#); *Staatliche Porzellan-Manufaktur Meissen GmbH v EUIPO*
- ♦ **MERLIN'S KINDERWELT / KINDER**; Judgment of 20 September 2016 in Case [T-565/15](#); *Excalibur City s.r.o. v EUIPO*
- ♦ **MERLIN'S KINDERWELT / KINDER**; Judgment of 20 September 2016 in Case [T-566/15](#); *Excalibur City s.r.o. v EUIPO*
- MINICARGO / MINI**; Judgment of 10 March 2016 in Case [T-160/15](#); *LG Developpement v OHIM*
- MITOCHRON / MIVACRON**; Judgment of 13 May 2016 in Case [T-312/15](#); *Market Watch Franchise & Consulting Inc. v EUIPO and Glaxo Group Ltd*
- Mitochron / mito**; Judgment of 13 May 2016 in Case [T-62/15](#); *Market Watch Franchise & Consulting Inc. v EUIPO and El Corte Inglés*
- ♦ **mobile.de / mobile**; Judgments of 12 May 2016 in Cases [T-322/14](#) and [T-325/14](#) (joined cases); *mobile.international GmbH v EUIPO*
- ♦ **MOTO B / B MOTOBİ et al.**; Judgment of 2 February 2016 in Case [T-169/13](#); *Benelli Q.J. Srl v OHIM*
- MOTOBİ**; Judgment of 2 February 2016 in Case [T-170/13](#); *Benelli Q.J. Srl v OHIM*
- ♦ **MOTOBİ B PESARO**; Judgment of 2 February 2016 in Case [T-171/13](#); *Benelli Q.J. Srl v OHIM*
- MOTORTOWN / M MOTOR**; Judgment of 18 March 2016 in Case [T-785/14](#); *El Corte Inglés, S.A v OHIM*



MR JONES / JONES et al.; Judgment of 12 April 2016 in Case [T-8/15](#); *Auyantepui Corp., SA v EUIPO*

Multiprop; Judgment of 1 March 2016 in Case [T-538/14](#); *Peri GmbH v OHIM*

♦ **NANO**; Judgment of 22 September 2016 in Case [T-237/15](#); *Edward Labowicz v EUIPO, Pure Fishing, Inc.*

Natür-bal / NATURVAL; Judgment of 3 May 2016 in Case [T-503/15](#); *Aranynektár Termékgyártó és Kereskedelmi KFT v EUIPO*

♦ **NEOFON / FON**; Judgment of 26 April 2016 in Case [T-777/14](#); *Fon Wireless Ltd v EUIPO*

♦ **NEUSCHWANSTEIN**; Judgment of 5 July 2016 in Case [T-167/15](#); *Bundesverband Souvenir — Geschenke — Ehrenpreise e.V. v EUIPO*

NIAGARA, Judgment of 27 April 2016 in Case [T-89/15](#); *Niagara Bottling LLC v EUIPO*

NOOSFER / SFERA et al.; Judgment of 26 May 2016 in Case [T-99/15](#); *Sfera Joven, S.A. v EUIPO*

ocean ibiza / OC ocean club Ibiza et al.; Judgment of 25 May 2016 in Case [T-6/15](#); *Ice Mountain Ibiza, S.L. v EUIPO*

P / P; Judgment of 11 October 2016 in Case [T-350/15](#); *Perry Ellis International Group Holdings Ltd v EUIPO*

PAL; Judgment of 14 December 2016 in Case [T-397/15](#); *PAL-Bullermann GmbH v EUIPO*

♦ **PALLADIUM PALACE IBIZA RESORT & SPA**; Judgment of 30 November 2016 in Case [T-217/15](#); *Fiesta Hotels & Resorts, S.L. v EUIPO and Residencial Palladium, S.L.*

♦ **PARK REGIS / ST. REGIS et al.**; Judgments of 2 June 2016 in Cases [T-510/14](#) and [T-536/14](#) (joined cases); *Staywell Hospitality Group Pty Ltd v EUIPO and Sheraton International IP, LLC v EUIPO*

PARKWAY; Orders of 8 November 2016 in Cases [T-268/15](#) and [T-272/15](#) (joined cases); *Apcoa parking GmbH v EUIPO*

PICCOLOMINI / PICCOLO; Judgment of 14 April 2016 in Case [T-20/15](#); *Henkel & Co. Sektkellerei KG v EUIPO*

♦ **POLO CLUB SAINT-TROPEZ HARAS DE GASSIN / BEVERLY HILLS POLO CLUB et al.**; Judgment of 10 November 2016 in Case [T-67/15](#); *Polo Club, established in Gassin (France) v EUIPO*

Polycart A Whole Cart Full of Benefits / POLICAR; Judgment of 7 April 2016 in Case [T-613/14](#); *Industrias Tomás Morcillo, S.L. v EUIPO*

POWER EDGE / EDGE; Judgment of 18 October 2016 in Case [T-824/14](#); *Eveready Battery Company, Inc. v EUIPO*

P PRO PLAYER / P PROTECTIVE et al.; Judgment of 24 November 2016 in Case [T-349/15](#); *CG Verwaltungsgesellschaft mbH v EUIPO*

PREFERISCO / I PREFERITI; Judgment of 14 July 2016 in Case [T-371/15](#); *Preferisco Foods Ltd v EUIPO*

PRESSO / PRESSO; Judgment of 29 November 2016 in Case [T-545/15](#); *Pi-Design AG v EUIPO*



♦ **Pret | A | Diner / PRET A MANGER et al.**; Judgment of 30 November 2016 in Case [T-2/16](#); *Pret K&K Group AG v EUIPO*

PUSH / PUNCH; Judgment of 15 September 2016 in Case [T-633/15](#); *JT International SA v EUIPO and Corporación Habanos, SA*

Q10; Judgment of 7 September 2016 in Case [T-4/15](#); *Beiersdorf AG v EUIPO*

♦ **real,- / Real mark et al.**; Judgment of 8 September 2016 in Case [C-309/15 P](#); *Real Express SRL v EUIPO and MIP METRO Group Intellectual Property GmbH & Co. KG*

♦ **REAL HANDCOOKED / real; QUALITY**; Judgment of 24 February 2016 in Case [T-816/14](#); *Tayto Group Ltd. v OHIM*

Redpur / redwell INFRAROT HEIZUNGEN et al.; Judgment of 15 December 2016 in Case [T-227/15](#); *Redpur GmbH v EUIPO*

♦ **RESCUE**; Judgment of 29 September 2016 in Case [T-337/15](#); *Bach Flower Remedies Ltd v EUIPO*

♦ **REVOLUTION**; Judgment of 2 June 2016 in Case [T-654/14](#); *Revolution LLC v EUIPO*

♦ **ROD / RODI et al.**; Judgment of 21 January 2016 in Case [T-75/15](#); *Rod Leichtmetallräder GmbH v OHIM*

♦ **Roméo has a Gun by Romano Ricci / NINA RICCI et al.**; Judgment of 15 September 2016 in Case [T-358/15](#); *Arrom Conseil v EUIPO*

♦ **Roméo has a Gun by Romano Ricci / NINA RICCI et al.**; Judgment of 15 September 2016 in Case [T-359/15](#); *Arrom Conseil v EUIPO*

♦ ♦ **SCOPE**; Judgment of 16 March 2016 in Case [T-90/15](#); *Schoeller Corporation GmbH v OHIM*

SCRUBMASTER; Order of 17 June 2016 in Case [T-629/15](#); *Hako GmbH v EUIPO*

♦ **SHAPE OF A BAR WITH FOUR CIRCLES (3D MARK)**; Judgment of 1 June 2016 in Case [T-240/15](#); *Grupo Bimbo, S.A.B. v EUIPO*

♦ **SHAPE OF A BOTTLE (3D MARK)**; Judgment of 24 February 2016 in Case [T-411/14](#); *Coca-Cola Company v OHIM*

SHAPE OF A BOX COMPOSED OF TWO OPEN CUBES (3D MARK); Order of 20 April 2016 in Case [T-326/15](#); *Dima Verwaltungs GmbH v EUIPO*

SHAPE OF A BOX COMPOSED OF TWO OPEN CUBES (3D MARK); Order of 20 April 2016 in Case [T-383/15](#); *Dima Verwaltungs GmbH v EUIPO*

♦ **SHAPE OF A CUBE**; Judgment of 10 November 2016 in Case [C-30/15 P](#); *Simba Toys GmbH & Co. KG v EUIPO*

SHAPE OF A FORMWORK COUPLER; Judgment of 28 June 2016 in Case [T-656/14](#); *Peri GmbH v EUIPO*

♦ **SHAPE OF A FOUR-FINGER CHOCOLATE BAR (3D MARK)**; Judgment of 15 December 2016 in Case [T-112/13](#); *Mondelez UK Holdings & Services Ltd v EUIPO*

♦ ♦ **SHAPE OF AN OVEN**; Judgment of 1 December 2016 in Case [C-642/15 P](#); *Toni Klement v EUIPO*

SHAPE OF A TOOTHBRUSH; Judgment of 14 June 2016 in Case [T-385/15](#); *Loops LLC v*



EUIPO

♦ **SHAPE OF TOY CRATE CONTAINING WOOD BLOCKS (3D MARK)**; Judgment of 16 March 2016 in Case [T-363/15](#); *Työhönvalmennus Valma Oy v OHIM*

♦♦ **SHOP ART / art**; Judgment of 6 December 2016 in Case [T-735/15](#); *The Art Company B & S, SA v EUIPO*

SILICIUM ORGANIQUE G5 LLR / G5 -Silicium Organique ...et al.; Judgment of 28 September 2016 in Case [T-539/15](#); *LLR-G5 Ltd v EUIPO and GLYCAN FINANCE CORP. Ltd*

♦ **SILVANIA FOOD / SYLVANIA et al.**; Judgment of 30 September 2016 in Case [T-430/15](#); *Flowil International Lighting (Holding) BV v EUIPO — SC Lorimod Prod Com, Srl*

Sky BONUS / SKY; Order of 11 March 2016 in Case [T-840/14](#); *International Gaming Projects Ltd v OHIM*

♦ **SkyTec**; Judgment of 20 April 2016 in Case [T-77/15](#); *Tronios Group International BV v EUIPO*

SLIM LEGS BY AIRPRESSURE BODYFORMING; Judgment of 05 February 2016 in Case [T-842/14](#); *Airpressure Bodyforming v OHIM*

smartline; Judgment of 11 December 2016 in Case [T-744/15](#); *Puro Italian Style SpA v EUIPO*

♦ **SMART WATER**; Judgment of 17 March 2016 in Case [C-252/15 P](#); *Naanzeen Investments Ltd v OHIM*

♦ **SMARTER TRAVEL**; Judgment of 9 November 2016 in Case [T-290/15](#); *Smarter Travel Media LLC v EUIPO*

SO'BiO etic / SO...? et al.; Judgment of 27 October in Case [C-537/14 P](#); *Debonair Trading International Lda v EUIPO*

♦ **SOUND OF A JINGLE PLIM PLIM**; Judgment of 13 September 2016 in Case [T-408/15](#); *Globo Comunicação e Participações S/A v EUIPO*

♦ **SPA VILLAGE / Spa**; Judgment of 27 October 2016 in Case [T-625/15](#); *Spa Monopole, compagnie fermière de Spa SA/NV v EUIPO*

SPA WISDOM / SPA; Judgment of 16 March 2016 in Case [T-201/14](#); *The Body Shop International plc v OHIM*

♦ **SPEZOOMIX / Spezi**; Judgment of 1 March 2016 in Case [T-557/14](#); *BrandGroup GmbH v OHIM*

♦ **SPOKEY / SPOOKY**; Judgment of 21 January 2016 in Case [T-846/14](#); *Spokey sp. z o.o. v OHIM*

♦ **START UP INITIATIVE**; Judgment of 15 December 2016 in Case [T-529/15](#); *Intesa Sanpaolo v EUIPO*

♦♦ **STICK MiniMINI Fratelli Beretta 1812 GLI ORIGINALI / MINI WINI**; Judgment of 4 February 2016 in Case [T-247/14](#); *Meica Ammerländische Fleischwarenfabrik Fritz Meinen GmbH & Co. KG v OHIM*

♦ **STONE**; Judgment of 31 May 2016 in Case [T-454/14](#); *Warimex Waren-Import Export Handels-GmbH v EUIPO*



- ♦ **SUEDTIROL**; Judgment of 20 July 2016 in Case [T-11/15](#); *Internet Consulting GmbH v EUIPO*
- ♦ **SUN CALI**; Judgment of 22 September 2016 in Case [T-512/15](#); *Sun Cali Inc. v EUIPO*
- Supeco / SUPER COR et al.**; Judgment of 24 May 2016 in Case [T-126/15](#); *El Corte Inglés v EUIPO*
- SUREID**; Order of 28 November 2016 in Case [T-128/16](#); *SureID Inc. v EUIPO*
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- THE DINING EXPERIENCE**; Judgment of 25 May 2016 in Cases [T-422/15](#) and [T-423/15](#); *U-R LAB v EUIPO*
- The English Cut / EL CORTE INGLES et al.**; Judgment of 27 October 2016 in Case [T-515/12RENV](#); *El Corte Inglés, S.A. v EUIPO*
- ♦ **THE SNACK COMPANY**; Judgment of 26 May 2016 in Case [T-331/15](#); *Bimbo, S.A. v EUIPO*
- T.G.R. ENERGY DRINK**; Judgment of 5 October 2016 in Case [T-456/15](#); *Foodcare sp. z o.o. v EUIPO*
- TRIPLE BONUS**; Judgment of 14 January 2016 in Case [T-318/15](#); *Zitro IP Sàrl v OHIM*
- ♦ **Tropical / TROPICAL**; Judgment of 21 July 2016 in Case [T-804/14](#); *Tadeusz Ogrodnik v EUIPO*
- ♦ **TUUM / THUN**; Judgment of 6 December 2016 in Case [T-635/15](#); *Tuum Srl v EUIPO — Thun SpA*
- TVR ENGINEERING / TVR et al.**; Judgment of 28 January 2016 in Case [T-781/14](#); *TVR Automotive Ltd v OHIM*
- TVR ITALIA / TVR et al.**; Order of 14 January 2016 in Case [C-500/15P](#); *TVR Italia Srl v OHIM*
- ♦♦ **ULTIMATE FIGHTING CHAMPIONSHIP**; Judgment of 12 May 2016 in Case [T-590/14](#); *Zuffa, LLC v EUIPO*
- ultra.air ultrafilter**; Order of 21 April 2016 in Case [C-232/15P](#); *ultra air GmbH v EUIPO*
- UNICORN-čerpací stanice / UNICORN et al.**; Judgment of 28 October 2016 in Case [T-123/15](#); *Unicorn a.s. v EUIPO*
- UNICORN / UJNICORN et al.**; Judgment of 28 October 2016 in Case [T-124/15](#); *Unicorn a.s. v EUIPO*
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◆ **VICTOR / victoria et al.**; Judgment of 7 September 2016 in Case [T-204/14](#); *Victor International GmbH v EUIPO* and *Gregorio Ovejero Jimenez & Maria Luisa Cristina Becerra*

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◆ **VOGUE**; Judgment of 18 September 2016 in Case [T-453/15](#); *Trinity Haircare AG v EUIPO*

◆ **WAVE 2 PAY** and **WAVE TO PAY**; Judgments of 28 September 2016 in Cases [T-129/15](#) and [T-130/15](#) (joined cases); *Intesa Sanpaolo SpA v EUIPO*

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