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Anti-Fraud Network meeting at EUIPO

On February 28, EUIPO organised the second Anti-Fraud (Anti-Scam) Network meeting, to share best practices among stakeholders with a view to addressing the practical difficulties in the fight against misleading invoices.

The Anti-Fraud (Anti-Scam) Network activities are undertaken in collaboration with EU national and regional IP offices, user associations, the European Patent Office (EPO) and the World Intellectual Property Office (WIPO), along with Europol, the European Union's law enforcement agency.

The network covers four areas: IT measures; communication; legal action and cooperation, and is part of EUIPO's commitment to protect its users against fraudulent activities, in collaboration with enforcement authorities, partner IP offices and user associations.

In common with other IP offices, EUIPO works to alert its users to the problem of misleading invoices. EUIPO reminds its users never to pay until they have checked that the source is official, and that the Office never sends invoices or letters requesting direct payment to users.

The Office's dedicated web page contains samples of misleading invoices sent to it by users; when a new misleading invoice is passed on to the Office, it is republished there.

If users receive any communications that give rise to doubts, they are kindly asked to check with their legal advisers or to contact the Office.

EUIPO currently works at several levels to help protect users from fraud. Its IT experts implement security measures, and through ongoing contact with users, its customer support department responds to queries and distributes direct information about the issue.

The Office also spreads awareness about its anti-fraud activities through its social media channels (on Twitter as @EU_IPO and on LinkedIn), as well as through its other channels.

EUIPO remains committed to protecting its users against fraudulent activities, in collaboration with enforcement authorities, partner IP offices and user associations.

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The James Nurton Interview

Interview: Marlous Stal-Hilders, managing partner, NLO Shieldmark

What is your background?

I studied law and then specialised in IP, as I found that the most interesting field. When I graduated I searched for a job in the field of IP. I worked for one year with another firm and then transferred to NLO and have been there ever since.

We have 180 people working in five offices – four in the Netherlands and a new one in Belgium which we opened last year.

Marlous Stal-Hilders

What did you like about IP?

It is always different and always moving forward, which makes it very interesting. Also it is about companies and the market and is a little bit more commercial than other areas of law. I found that attractive. I was most interested in trade marks from the beginning as far as I remember.

What kind of work do you do now?

I started combining IP portfolio management and firm management early in my career, after two or three years, and I liked that very much. My work is now split about 50-50 – I have been managing partner for eight years or more. I like that you know what it is like to manage a business. I can easily combine that with my IP portfolio work and understand the client better.

As managing partner I am mostly responsible for the trade mark and design department, NLO Shieldmark. It involves making plans and delivering our strategy. We have 14 attorneys and will hire two new trainees this year. They are structured in four teams, each of which has a team leader, some attorneys, administrators and other staff – and I have most contact with the team leaders.

For most of our clients we focus on portfolio management – these are medium and big-sized companies. Three of the teams focus on these, and the fourth team focuses on small companies, who

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need slightly different types of advice. We have new work coming in and one of our goals is to grow.

How much of your work is Benelux, EU or international?

We do some Benelux trade mark work. But because we serve bigger and mid-size companies we do a lot of EU work as well. We focus on Dutch or European clients – they make up 80% of our clients – but we also work for clients from Korea, the US and other countries, and do all their Benelux or EU work.

What do you think of the EU systems?

There are a lot of people who complain, but I am a fan of the EU system. It offers an effective registration, opposition and cancellation process and that shows the success of the system. The only think you could say is the pan-EU system leads to non-realistic perspectives on the current state of the internal market. Borders are still there – we had the Leno Trademark ruling that borders of member states should not pose an obstruction but they are still there in practice. Sometimes that leads to practical issues. Maybe there will be further clarification in the future. The question of what is use is one of the most difficult things about the system as the territorial scope of the EU is very big.

Sometimes there are issues with IT but in general they deal with it, and I like all the new developments. We also do a fair amount of design work. I think that system also works well.

How does the Benelux system compare?

The Benelux Office is still improving, and there are some problems that need to be addressed. But they are open to suggestions. There is good communication between the IP practice and the Office. Like in the EU, we have cross-border issues with Belgium, Luxembourg and the Netherlands and in practice companies take a position in one country rather than the whole Benelux. This creates issues in proving acquired distinctiveness through use, for example.

What will be interesting will be how Benelux will introduce administrative cancellation proceedings. We understand they are planning to implement this very quickly so that will be an interesting development. We expect them to deliver it well before the deadline. It will be a really new development and will change our world a little bit. At the moment you have lengthy court proceedings so we expect this procedure to be much faster and cheaper. If it is not too expensive, I think a lot of people will use it.

The other interesting change for Benelux and the EU is the potential for new types of trade marks, such as sound marks, movement marks and 3D marks. It will be interesting to see how that develops and what impact it will have on litigation and court actions. If it becomes easier to file, it will be interesting to see if you get enough room to litigate: today it's very difficult to get those sorts of marks so we don't really know the answer to that yet.

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The James Nurton Interview

The James Nurton Interview is produced monthly for Alicante News, and contains the personal views of the interviewee.

What's been the most unusual case you have worked on?

Difficult question; recently I worked on a sound mark for a particular sound for a client. What was interesting was I found that I can file it in the European register by putting the sound in a sound file, and there are some already on the register. But I'm not yet able to file the sound file in the Benelux as they are not able to accept them.

I think it's a problem: interest in unusual trade marks is growing because the world is changing. We are more focused on colours and images and these marks can span different cultures and languages.

What do you think the future holds for trade marks?

Trade marks will continue to become more important for companies, as it is how you protect your distinctiveness. A problem is that the registers are getting crowded, and the European register in particular is polluted by marks which are not used. I don't know if the law will become easier for trade marks but I hope so because sometimes I don't think that some things we apply in trade mark law are really based on marketing experience and the way people experience brands and signs. Trade mark law could do a better job of reflecting that commercial reality. Maybe we should allow more room for those sorts of developments. I worry that we are becoming more restrictive on trade marks than we used to be.

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Case T-16/16; Mast-Jägermeister SE v EUIPO; Judgment of 9 February 2017; Language of the case: DE

The General Court (GC) has recently provided some guidance regarding the required representation of a design suitable for reproduction and the related accordance of a filing date. Two designs applied for and containing two products in a single representation were confirmed to be deemed not to have been filed. For the reason that these designs have never been registered and published, they cannot be disclosed in this short judgment summary. However, even without the views of the designs, it is worth learning from the principles applied by the GC.

The applicant filed a multiple application seeking protection for three designs, out of which two contained more than just 'the matter for which protection was sought' and what was declared in the indication of the product.

The examiner issued a report seeking remedy, requesting the applicant to amend the indication of the product to reflect the contents of the representations of the designs, and to divide the application in two, because the products shown in the views of the two designs were classified in two different classes of the Locarno Classification.

The GC summarised the initial Office action as follows:

> By an initial examination report [...], the examiner informed the applicant that, with regard to the designs [concerned], the indication of the product, namely the 'beakers' in respect of which protection was sought, did not correspond to the representations filed, on the ground that those representations also showed bottles. It therefore suggested that the applicant add the indication of 'Bottles' in Class 09.01 of the Locarno Agreement to the two designs. The examiner added that, in so far as 'Beakers' and 'Bottles' belonged to different classes, the multiple application had to be divided. It stated that, unless the deficiencies were remedied within the prescribed period, the application would be refused.

The applicant disagreed. It contested that it was sufficiently clear from the filing that protection was sought for the 'beakers', but not for the 'bottles' and suggested maintaining one multiple application with the product indication altered to 'Drinking beakers as receptacles for a bottle which is part of those beakers'.

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In a second report, the examiner suggested that the applicant should exclude the bottle for which protection was not sought, by applying a graphical disclaimer to it. However, the examiner indicated that this would lead to the allocation of a new filing date once new representations of the designs reached the Office.

In response, the applicant argued that all the requirements for granting the filing date had been met by the original filing.

The examiner issued a decision that two designs of the application did not meet the requirements of Article 4(1)(e) CDIR, because due to the presence of the bottles, the characteristics for which protection was sought were not clearly visible, and therefore, the application was not dealt with as an application for a registered Community design for those two designs and no filing date was granted for them.

The applicant appealed; however, the Board of Appeal confirmed the contested decision. The applicant appealed to the General Court.

The applicant pleaded infringement of Articles 45 and 46 CDR in conjunction with Article 36(1) CDR and Article 4(1)(e) CDIR. It essentially argued that the representations of the designs concerned were of a quality that made it possible to enable their reproduction pursuant to Article 36(1)(c) CDR; the designs were on a neutral background; they were not retouched with ink or correcting fluid, and were of a quality permitting all the details of the matter for which protection was sought to be clearly distinguished and permitting it to be reduced or enlarged in accordance with Article 4(1)(e) CDIR. According to the applicant, those were the only requirements laid down by the EU legislation, and the provisions concerned only the quality of the representation of the design, not the content. The Board of Appeal's refusal to grant a date of filing on the grounds that it was not possible to determine from the representations whether protection was being sought for the 'beaker', for the 'bottle', or for a combination of the two was incorrect, in so far as that question would arise only in the context of infringement proceedings; it was not an impediment to granting a date of filing.

Therefore, according to the General Court, the point to be determined was:

> whether, in view of its wording and context, Article 36(1) of Regulation No 6/2002 applies — as the applicant argues — only to situations where the representation of the contested design is 'physically' muddled or vague, as a result of, inter alia, poor print quality, or whether the scope of that provision also covers — as EUIPO contends — a lack of precision, certainty or clarity regarding the matter to be protected by the design for which registration is sought.

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n the view taken by the GC, the provision of Article 4(1)(e) CDIR specifies, inter alia, that the representation must permit all the details of 'the matter for which protection is sought' to be clearly distinguished. Thus, imprecise representations would not enable third parties to determine unequivocally the matter to be protected by the design under consideration. (In the case at hand, it was unclear whether the protection was sought for the beaker, the bottle or a combination of both). Accordingly, clarification is necessary for the purposes of ensuring legal certainty for third parties, who need to know precisely what the subject of the protection conferred on the design is. The contested decision was upheld.

The case described illustrates how important it is to pay particular attention to the representation of a design in filing strategy. It is worth repeating these simple and basic principles: that the representation should contain only the design for which protection is sought, excluding any other matter and should resist the temptation of showing the purpose or way of use of the product; that the protection by virtue of Community design registration can be efficient for the protection of a particular appearance of a product but not an underlying idea or concept; and that all the tools available, including graphical disclaimers, should be applied efficiently in the filing strategy. In the present case, the application fee refund for the designs not filed can only be cold comfort.

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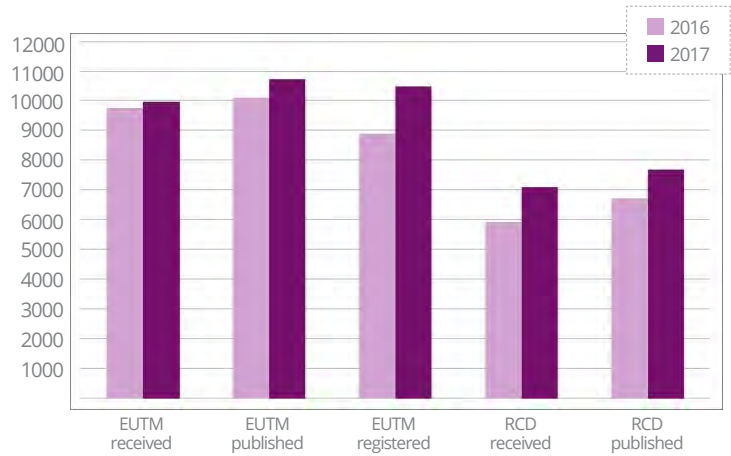
Monthly statistical highlights January*	2016	2017
European Union Trade Mark applications received	9 769	9 952
European Union Trade Mark applications published	10 107	10 710
European Union Trade Mark registered (certificates issued)	8 898	10 487
Registered Community Designs received	5 930	7 094
Registered Community Designs published	6 709	7 696

** Statistical data for the month in course is not definitive. Figures may vary slightly thereafter.*



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15 Fully-Funded PhD Positions under the EIPIN-Innovation Society Programme ITN/EJD Marie Skłodowska-Curie Project

New positions for 15 PhD candidates to conduct doctoral research on the role that intellectual property plays in fostering innovation have been announced.

Successful candidates will be awarded a joint or double doctoral degree from two of the five participating universities, which have set three vacancies each. Interested candidates can apply until 29 March 2017, 23.59 CET.

The EUIPO has a long-standing record of initiatives developed with different stakeholders, including the academic world, aimed at raising awareness and the dissemination of IP knowledge.

The Office collaborates as a partner organisation of the EIPIN-Innovation Society, a joint doctorate programme in intellectual property, along with five other European Intellectual Property Institutes Network (EIPIN) partners, which include:

- Magister Lvcentinvs (ML), University of Alicante
- Center for International Intellectual Property Studies (CEIPI), University of Strasbourg
- Intellectual Property and Knowledge Management (IPKM), Maastricht University
- Munich Intellectual Property Law Center (MIPLC), University of Augsburg
- Queen Mary Intellectual Property Research Institute (QMIPRI), University of London

The EIPIN-Innovation Society has received a grant from the EU Commission under its Marie Skłodowska-Curie actions (MSCA), in order to set up this European Joint Doctorate. The programme is run by the five Universities — the EIPIN's academic partners — and by fifteen non-academic partner organisations, including the EUIPO.

The positions are open to candidates from all domains of sciences and they will start on 1 September 2017 (date of recruitment) and finish on 31 August 2020.

For more information on these positions, how to apply and the selection process, go to the EIPIN website or read the press release.

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The European Union Intellectual Property Office (EUIPO), through the European Observatory on Infringements of Intellectual Property Rights, has published the tenth sectorial study, covering the economic cost of IPR infringement in the Pesticides Sector.

This report shows that 13.8% of legitimate revenues are lost each year due to counterfeiting of pesticides in the EU-28.

Those lost sales translate into 2,600 jobs directly lost across the pesticides sector in the EU, as legitimate manufacturers employ fewer people than they would have done in the absence of counterfeiting.

For the full report please visit our webpage.

2017 Work Programme: EUIPO's priorities for 2017

The Office Work Programme 2017 details the actions to be undertaken in 2017 by EUIPO under the Strategic Plan 2020 and the Multi-Annual staff policy plan.

It takes into account key assumptions on trade mark and design volumes and their impact on operations.

The structure of the Office Work Programme 2017, and its annexes, follow the guidelines of the programming document for decentralised EU Agencies adopted by the European Parliament, the Council and the Commission in 2012 and the entry into force of the Framework Financial Regulation.

The new provisions ensure a consistent approach between annual and multi-annual programming.

This Work Programme consists of two main parts. The first part describes the projects and running activities that the Office will undertake under the Strategic Plan 2020 in 2017, divided into six lines of action.

The second part is composed of the annexes including the forecast for volumes of trade mark and design applications as well as for other types of filings, such as oppositions and appeals. It outlines the key assumptions behind those forecasts, which form the basis for the Office's 2017 Budget.

The section also contains the Office's Service Charter for 2017, which sets out the service commitment of the Office towards its users in quality, timeliness and accessibility.

The annexes also include the annual staff policy plan, financial resources, the corporate risk register, the procurement plan, the Office's organisational chart and the Work Programme for the European Observatory on Infringements of Intellectual Property Rights.

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A: Court of Justice: Orders, Judgments and Preliminary Rulings.

Case C-297/15; Ferring Lægemidler A/S v. Orifarm A/S; Preliminary ruling of 10 November 2016; Language of the case: DA

KEYWORDS: Free movements of goods, Packaging

FACTS: This request for a preliminary ruling has been made in proceedings between Ferring Lægemidler A/S, acting on behalf of Ferring BV, and Orifarm A/S in respect of 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. On the other hand, 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 Court of Justice of the European Union (CJ) 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 1 or packets of 10 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:

SUBSTANCE: 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

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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 proceeding (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. 25-26).

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 which it is for the referring court to determine (para. 29).

Case C-642/15P; Toni Klement v EUIPO; Judgment of 1 December 2016; Language of the case: DE

RESULT: Action upheld (GC and BoA decision annulled)

KEYWORDS: Distinctive element, Functional element, Lack of reasoning, Use not as registered, Three dimensional mark

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FACTS: The applicant for cancellation requested the revocation for non-use of the 3D mark shown below. The EUTM is registered for ovens (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 General Court (GC) alleging infringement of Article 15 (1) (a) EUTMR.

The GC concluded that the shape is unusual and reminds 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 Court of Justice of the European Union (CJ) found that the contested judgment contained a contradictory reasoning in a sensitive point.

EUTM

SUBSTANCE: 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 at hand whereas a very similar shape used by the competitors would have aa 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).

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Consequently, the reasoning in the contested judgment given in an aspect which is relevant for the examination of the conditions for the application of Article 15(1)(a) EUTMR is not clear und 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, 33).

B: General Court: Orders and Judgments on appeals
against decisions of the EUIPO

Case T-258/08; Matthias Rath v EUIPO; Judgment of 24 January 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Burden of proof

FACTS: Likelihood of confusion (LOC) established by the Opposition Division (OD) and confirmed by the Board of Appeal (BoA) and the General Court (GC). Goods at issue: 'antitussive medicines' versus 'food supplements, dietetic supplements, vitamins, minerals'.

EUTMA
DIACOR
Earlier mark
Diacol PORTUGAL

SUBSTANCE: LOC confirmed.
Interesting points: Succession of laws, substantial law applicable: in view of the time at which the events occurred, this case is still governed by Regulation No 40/94, at least as regards provisions which are not strictly procedural (para. 15).
The GC confirms that the BoA was right in not obliging the opponent to submit translations of the evidence of use in Portuguese into the language of the proceedings (EN): 'in order to be able actually to exercise his rights of defence with regard to that evidence, it is not necessary for the applicant to be able to understand fully all the details in that evidence. It is sufficient for a person who has a knowledge of the language of the proceedings before EUIPO to be able to identify and understand the relevant information in the documents submitted as proof of use' (para. 21).
The GC considers that the fact that a product bearing the name DIACOL was referred to

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throughout the relevant period in an encyclopaedia listing pharmaceutical products marketed on the Portuguese market does not in itself prove that the mark which that product bears was put to genuine use in Portugal during the relevant period. However, it may be an indication of such genuine use, in particular where there is additional evidence as in the present case (para. 40).

Case T-579/14; Birkenstock Sales GmbH v EUIPO; Judgment of 9 November 2016; Language of the case: DE

RESULT: Action partially dismissed (BoA decision partially annulled)

KEYWORDS: Shape of the product, Distinctive element

FACTS: The Board of Appeal (BoA) confirmed the refusal of protection of the international mark represented below (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 in respect of the products at issue. The Board 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 Board 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 in dissociable from the appearance of the goods in question.
The IR owner filed an action before the General Court (GC) claiming an infringement of Art. 7(1)(b) in conjunction with Article 154 (1) EUTMR.

IR designating the EU

SUBSTANCE: 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,

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hides', for which the decision was annulled.
The GC confirmed the assessment of the Board that the trade mark in question is in dissociable 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 in dissociable 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).

Joint Cases T-268/15 and T-272/15; Apcoa parking GmbH v EUIPO; Order of 8 November 2016; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive element, Distinctive element

FACTS: The applicant sought to register the word as well as figurative marks represented below as EUTMs for services in Classes 35, 36, 39, 42 and 45. The Office refused the registration of the EUTM applications (EUTMAs) pursuant to Articles 7(1)(b), (c) and 7(2) EUTMR, as being descriptive and devoid of distinctive character in parts of the EU. The Board of Appeal (BoA) dismissed the applicant's appeals. The applicant filed an action before the General Court (GC) relying on 2 pleas in law.

EUTMAs

1)

PARKWAY

2)

PARK WAY

SUBSTANCE: 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 which 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

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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 did correctly conclude that the applications are descriptive and lack distinctive character.

Case T-290/15; Smarter Travel Media LLC v EUIPO; Judgment of 9 November 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Descriptive element, Figurative element, Figurative trade mark, Principle of legality

FACTS: An application for registration of the figurative mark represented below as an EU trade mark 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 Board of Appeal (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 General Court (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) of that regulation, (iii) an infringement of the principles of equal treatment and sound administration.

EUTMA

SMARTER TRAVEL

SUBSTANCE: Article 7(1)(c) EUTMR: The GC confirmed that the services concerned are targeted at the English-speaking part of the general public, which is reasonably well informed and reasonably observant and circumspect (paras 27, 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

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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, 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 ad inadmissible pursuant to Article 84(1) of the Rules of Procedure (paras. 33-35). 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. 36-39). The GC therefore found that the Board did not err in concluding, that 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.

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 EU trade mark. 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. 57-60).

Principles of equal treatment and sound administration: The GC noted that, according to the case-law of the Court of Justice of the European Union, the reasons on which the contested decision is based apply even if the sign in respect of which registration is sought as an EU trade mark is composed in a manner identical to that of a mark in respect of which the Office has already approved registration as an EU trade mark and which relates to goods or services identical or similar to those in respect of which registration of the sign in question is sought (paras. 70-72).

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

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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. 89-96).

Case T-617/15; Chic Investments sp. z o.o., v EUIPO; Judgment of 29 November 2016; Language of the case: PL

RESULT: Action dismissed

KEYWORDS: Descriptive element, Figurative element, Principle of legality, Lack of reasoning

FACTS: The Board of Appeal confirmed the refusal of the registration for the EUTM application (EUTMA) for goods in classes 35 and 41:, pursuant to Article 7(1)(b) and Art 7(1)(c) EUTMR. For the contested services the trade mark applied for informs the target public about their nature and purpose, 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 General Court (GC) claiming the infringement of Art. 7(1)(b) EUTMR and Art. 75 EUTMR in conjunction with Art. 41(2)(c) of the EU Charter of Fundamental Rights.

EUTMA

eSMOKING WORLD

SUBSTANCE: With regard to the alleged infringement of Art. 7(1)(b) EUTMR the GC confirmed the assessment of the Board and decided that the EUTMA 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" means" a group of somehow related among each other things or person related to (paras 36, 37). The contested services are directly or indirectly related to electronic cigarettes (paras 40, 41). The word element is therefore descriptive of all contested services (para 45), whereas the figurative element emphasizes its meaning (para 56).
With regard to the alleged infringement of Art. Art. 75 EUTMR in conjunction with Art. 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

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reasoning does not need to mention all arguments of the party if they are not relevant for the outcome (para 102).

Case T-703/15; Groupe Go Sport v EUIPO; Judgment of 6 December 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Admissibility, Statement of grounds, Restitutio in integrum

FACTS: The applicant filed an appeal against the decision of the opposition division, using the Office's Ecomm system. On 19 May 2015, the applicant sent two electronic communications to the OfficeO 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 response 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 Board of Appeal (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 of Regulation No 207/2009.
The applicant filed an action before the General Court (GC) relying on a single plea in law, namely infringement of Article 60 EUTMR and Rule 49(1) of EUTMIR by wrongly rejecting the appeal of the applicant. The GC dismissed the action.

EUTMA
GO SPORT
Earlier mark
GO

SUBSTANCE: 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. 34-47). 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

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applicant's argument that by filing the statement of grounds in good faith after the deadline expired cannot be accepted either (paras. 55-74).

Case T-391/15; Aldi GmbH & Co. KG v EUIPO; Judgment of 15 December 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Evidence of use, Extent of use, Nature of use

FACTS: The applicant sought to register the word mark represented below as an EUTM for alcoholic beverages in Class 33. An opposition filed pursuant to Article 8(1)(b) EUTMR was directed against all goods applied for. It was based on the earlier word mark represented below and registered for a variety of goods and services, including alcoholic beverages in Class 33. The Opposition Division (OD) rejected the opposition based on the lack of the genuine use of the earlier mark. The Board of Appeal (BoA) dismissed the appeal. The opponent filed an action before the General Court (GC) relying on a single plea in law alleging infringement of Article 42(2) EUTMR and Rule 22(3) CTMIR. The GC dismissed the appeal.

EUTMA
ALDIANO
Earlier mark
ALDI

SUBSTANCE: 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 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, i.e. 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

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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.

Case T-701/15; Stock Polska Sp. z o. o. v EUIPO; Judgment of 19 January 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Complex mark, Figurative element, Figurative trade mark, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Similarity of the signs, Visual similarity

FACTS: The applicant sought to register the figurative mark represented below as an EUTM for goods in Class 33. An opposition filed pursuant to Article 8(1)(b) EUTMR was directed against all goods applied for. It was based on the earlier word mark represented below and registered for the same goods in Class 33. The Opposition Division (OD) upheld the opposition in its entirety. The Board of Appeal (BoA) dismissed the appeal. The applicant filed an action before the General Court (GC) relying on a single plea in law alleging infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal.

EUTMA

LUBELSKA

Earlier mark

Lubeca

SUBSTANCE: LEVEL OF ATTENTION OF THE RELEVANT PUBLIC: The GC rejected the applicant's argument that the level of attention of the average German consumer of alcoholic beverages is higher than average. These goods are for everyday consumption and are normally widely distributed, ranging from supermarkets to restaurants. The consumer of alcohol is a member of the general public, who is deemed to be reasonably well informed and reasonably observant and circumspect, and who will demonstrate an average level of attention when purchasing such goods (para. 22). This assessment is not called into

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question by the limitations on access to alcoholic beverages resulting from restrictions on their sale depending on the age of consumers (para. 23). The arguments of the high price and the occasional nature of the purchase of alcoholic beverages concern only certain beverages. However, the goods in question are not limited to such goods (para. 24). The fact that the purchase of alcoholic beverages is determined by the individual and specific taste of purchasers is equally applicable to virtually any foodstuff or beverage as well as to many other mass consumption goods (para. 25).

SIMILARITY OF THE SIGNS: The figurative elements constituting a crown will be perceived by the consumer as essentially decorative, or even laudatory. The element of a crown is commonly used in the sector of (alcoholic) beverages (para. 33). Visually and phonetically, the similarities prevail over the differences (paras. 38 and 39). The applicant failed to establish that at least one of the two word elements at issue has a clear and specific meaning for the relevant German consumer (paras. 41-43). The visual and phonetic similarities of the signs at issue are not outweighed by conceptual differences, particularly because, according to the case-law, when the goods concerned, such as those at issue in the present case, are also ordered verbally for consumption in bars, restaurants or nightclubs, the phonetic similarity between the marks at issue is, by itself, sufficient to give rise to a likelihood of confusion (para. 44).

Case T-548/15; Ramón Guiral Broto v EUIPO; Judgment of 13 December 2016; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Admissibility; Competence of the Boards, Essential element to be translated, Examination of facts ex officio, Right to be heard, Right of defence, Substantiation of earlier right, Translation of evidence

FACTS: 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 the earlier figurative marks represented below, 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 Opposition Division (OD) partly upheld the opposition in so far as it related to services for providing of food and drink, temporary accommodation, outside catering in Class 43. Only one of earlier marks was valid and substantiated, namely, Spanish trade mark registration No 2 348 110.

The Board of Appeal (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 colour of the mark. The BoA also confirmed that the other earlier marks were either no longer valid at the operative

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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 General Court (GC) relying on 3 plea(s) 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.

EUTMA

Café del Sol

Earlier mark

SUBSTANCE: 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 which 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 in respect of 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

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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).

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) of 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 in respect of 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.

Case T-529/15; Intesa Sanpaolo v EUIPO; Judgment of 15 December 2016; Language of the case: IT

RESULT: Action dismissed

KEYWORDS: Descriptive element, Distinctive element, Figurative element, Figurative trade mark, Lack of reasoning

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FACTS: The EUTM applicant sought to register the figurative mark shown below as an EUTM for services in Classes 35, 36, 41 and 42. The examiner refused the application in respect of all the services on the basis of lack of distinctive character. The First Board of Appeal (BoA) dismissed the appeal. The EUTM applicant filed an application before the General Court (GC) for the annulment of the decision of the BoA relying on two pleas in law: infringement of Article 75 EUTMR, and of Article 7(1)(b) EUTMR.

EUTMA

START UP INITIATIVE

SUBSTANCE: Article 75 EUTMR: The GC dismissed the appeal and 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. 14-18). 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. 27-42). 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).

Article 7(1)(b) EUTMR: 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. 54-55). 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

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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 comics language is very common in advertising. Therefore, since consumer will recall principally the mark at issue in force of the expression "start up initiative" it has to be confirmed the finding of the BoA that the mark applied for is devoid of distinctive character in relation to the services requested. (paras. 59-63).

Case T-614/15; Azur Space Solar Power GmbH v EUIPO; Judgment of 24 November 2016 Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Distinctive element, Figurative trade mark, Function of trade mark, Specialised public

FACTS: The IR holder filed an application for an IR designating the European Union (EU) for the figurative trademark represented below for goods in Class 9. The Office refused the registration of the EUTMA pursuant to Article 7(1)(b) EUTMR. The Board of Appeal (BoA) dismissed the appeal and confirmed the examiner`s decision. The applicant filed an action before the General Court (GC). The action was dismissed in its entirety by the GC.

IR designating the EU

SUBSTANCE: The GC pointed out that the case-law relating to three-dimensional trademarks consisting of the appearance of the goods themselves also applies where, as in the present case, the mark applied for is a figurative trademark, since that mark consists of 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 roofs ends with 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

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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).

Case T-716/15; D. Juan Gallardo Blanco v EUIPO; Judgment of 9 November 2016; Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Common element, Conceptual similarity, Dominant element, Figurative element, Figurative trade mark, Identity of the goods and services, Likelihood of confusion, Proof of use, Phonetic similarity, Similarity of the goods and services, Similarity of the signs, Visual similarity

FACTS: The applicant sought to register the figurative mark represented below as an EUTM for goods and services in Classes 31, 41 and 44.

An opposition based, inter alia, on the earlier figurative marks represented below, 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 Opposition Division (OD) upheld the opposition in its entirety in so far as it found there was a likelihood of confusion (LOC).

The Board of Appeal (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 LOC for the relevant public, and in particular for the general public.

The applicant filed an action before the General Court (GC) relying on three pleas in law: infringement of Article 4 EUTMR; infringement of Article 8(1)(b) EUTMR; and infringement of Article 42(2) EUTMR. The GC dismissed the appeal. It confirmed the finding of LOC.

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EUTMA

Earlier marks

SUBSTANCE: 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. 40-54). 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. 69-72). Concerning the earlier EUTM, the signs are highly similar because they have a dominant element in common, the letter 'C' being a secondary element (para. 81). The allegued 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. 84-87). At least the professional public will recognise a meaning in the element that resemble 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. 92-97). The GC confirms the distinctiveness of the earlier mark and concludes there is LOC, despite the applicant's argument on the coexistence of several similar marks, which is dismissed (paras. 100-107). The reference to previous decisions does not have an effect on this case (paras. 110-112). There is no need to enter in the assessment of the remaining claims (para. 114).

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Case T-775/15; EK/servicegroup eG v EUIPO; Judgment of 1 December 2016; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Retail services

FACTS: The Board of Appeal (BoA) confirmed the Office's refusal of the EUTM application 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) CTMIR in conjunction with Article 28 EUTMR.

SUBSTANCE: The General Court (GC) confirmed the BoA's findings holding that the goods to which the services relate (see judgement of 7 July 2005, Praktiker Bau- und Heimwerkermärkte, C-418/02, EU:C:2005:425, para. 52) must be sufficiently clear on their own account (see judgement of 19 June 2012, Chartered Institute of Patent Attorneys, C-307/10, EU:C:2012:361, para. 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, 33). The terms 'household goods and electronic goods' are not sufficiently clear (paras. 35-37).

Case T-330/15; Rudolf Keil v EUIPO; Judgment of 15 December 2016; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive element, Distinctive element

FACTS: The Board of Appeal (BoA) confirmed the Cancellation Division's finding that the term 'BasenCitrate' will be understood by the German speaking public as designating citrates having an alkaline effect. It thus describes the goods at hand, 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 (c) in conjunction with Article 52(1)(a) EUTMR.

EUTM
BasenCitrate

SUBSTANCE: The General Court (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 'Citrate' as facilitated by the capital letter 'C' within the composition (paras. 26-

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28). The GC refuted various arguments raised by the applicant concerning the alleged novelty of the composition and its claimed vague meaning (paras. 32-41). The GC also held that consumers are often advised by professionals and hence be 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. 49-50).

Case T-578/15; Azur Space Solar Power GmbH v EUIPO; Judgment of 24 November 2016 Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Distinctive element, Figurative trade mark, Function of trade mark

FACTS: The IR holder filed an application for an IR designating the European Union (EU) for the figurative trademark represented below for goods in Class 9. The Office refused the registration of the EUTMA pursuant to Article 7(1)(b) EUTMR. The Board of Appeal (BoA) dismissed the appeal and confirmed the examiner`s decision. The applicant filed an action before the General Court (GC). The action was dismissed in its entirety by the GC.

IR designating the EU

SUBSTANCE: The GC pointed out that the case-law relating to three-dimensional trademarks consisting of the appearance of the goods themselves also applies where, as in the present case, the mark applied for is a figurative trademark, since that mark consists of 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 roofs ends with 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

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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).

Case T-399/15; Morgan & Morgan Srl International Insurance v EUIPO + Grupo Morgan & Morgan; Judgment of 19 January 2017; Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Common element, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Similarity of the signs, Visual similarity

FACTS: The applicant sought to register the figurative mark represented below as an EUTM for services in Class 36. An opposition based on the earlier figurative mark represented below, registered, inter alia, for services in Classes 35, 36 and 45, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) dismissed the opposition.
The Board of Appeal (BoA) annulled the decision of the OD and upheld the opposition. It found that there was likelihood of confusion (LOC) since the signs at issue bore a certain degree of similarity, the services covered were identical and consumers were more likely to identify the mark applied for by the word element 'morgan & morgan' than by the figurative element. The applicant filed an action before the General Court (GC) claiming an infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal.

EUTMA

Morgan & Morgan

Earlier mark

MMG TRUST
MIEMBRO DEL GRUPO MORGAN & MORGAN

SUBSTANCE: The BoA was right in considering that the relevant public is the general public, who has an average degree of attention, since when the relevant public is made up of two categories of consumers each having a different level of attention, the public

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with the lower level of attention must be taken into consideration (para. 30). Regarding the comparison of the services, the BoA did not commit an error of assessment in concluding that the services in question were identical, even though the EUTMA covers the field of insurance in general, meanwhile, the earlier mark covers more specifically financial assessment in terms of insurance. According to case-law, services can be regarded as identical where the services covered by the earlier mark are included in a more general category, designated by the mark applied for (paras. 33-40). The GC confirmed a degree of visual, phonetic and conceptual similarity between the signs which is not high. However, due to the presence in both signs of the word element 'morgan & morgan', which has inherent distinctive character, and in view of the identity of the services, the BoA was right in concluding that there was LOC (paras. 41-64).

Joint Cases T-678/15 and T-679/15; Novartis AG v EUIPO; Judgment of 15 December 2016; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Distinctive element, Figurative trade mark, Minimum degree of distinctiveness

FACTS: The applicant sought to register the figurative marks represented below as EUTMs for goods in Class 5. The Office refused the registration of the EUTM applications (EUTMA) pursuant to Article 7(1) (b) EUTMR, as it was found the marks to be devoid of distinctive character. The Board of Appeal (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 bef

EUTMAs	
1)	
2)	

SUBSTANCE: 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

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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 which 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.

Case T-769/15; SeNaPro Gmbh v EUIPO; Judgment of 24 November 2016; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, New submission on appeal, Conceptual dissimilarity

FACTS: The applicant sought to register the word mark Dolokorn as a EUTM for goods in Class 1, among which manures; fertilisers for soil and Inorganic fertilisers. An opposition based on the earlier EUTM DOLOPUR, registered for goods and services in Classes 1, 3, 5, 19 and 40 was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition in so far as the signs were considered to be similar and the goods identical. The Board of Appeal (BoA) dismissed the applicant's appeal. It did not take into account the applicant's argument, according to which the prefix 'DOLO' would 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 General Court (GC) relying on a single plea in law: infringement of Articles 75 and 76(1)(2) EUTMR. The GC dismissed the appeal.

EUTMA
Dolokorn
Earlier mark
DOLOPUR

SUBSTANCE: 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 result enhanced (para. 20).

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As 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, due to that 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).

Under the 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).

Case T-187/16; Anton Riemerschmid Weinbrennerei und Likörfabrik GmbH & Co. KG v EUIPO; Judgment 25 January 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Similarity of the signs, Visual similarity, Phonetic similarity

FACTS: The applicant filed an application for the registration as EU trade mark of the word mark represented below in respect of the goods in Class 33. An opposition based on the earlier EU trade mark represented below registered for goods in Classes 30, 32 and 33 was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The Opposition Division (OD) rejected the opposition in its entirety. The Board of Appeal (BoA) dismissed the opponent's appeal. It endorsed the OD's findings that there was no likelihood of confusion between the conflicting trade marks and that the opponent failed to prove the reputation of the earlier trade mark. The opponent filed an action before the General Court (GC) relying on a single plea in law, i.e. violation of Article 8(1)(b) EUTMR. The GC dismissed the appeal.

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EUTMA
LITU
Earlier mark
PITU

SUBSTANCE: The GC endorsed the BoA's findings that the goods of the conflicting trade marks are identical and that they are targeted at the general public in the European Union who would show an average level of attention (para. 23). The signs were found to be visually and aurally similar to the extent that they share three letters '-ITU' in common. However, their first letters, namely 'L' and 'P', are markedly different (paras. 25 and 28). Moreover, the signs cannot be compared from the conceptual perspective (para. 29). Therefore, the GC concluded that even if their goods are considered to be identical, there is no likelihood of confusion between the trade marks in question given the clear differences between their first letters and considering that they are rather short signs (paras. 32-34).

Case T-54/16; Netguru sp. z o.o., v EUIPO; Judgment of 17 January 2017; Language of the case: PL

RESULT: Action dismissed

KEYWORDS: Descriptive element, Principle of legality, Lack of reasoning

FACTS: The examiner refused of the registration for the EUTM application (EUTMA) for the word mark NETGURU for goods and services in Classes 9, 35, 37, 38, 41 and 42 pursuant to Articles 7(1) (b) and 7(1)(c) EUTMR. The Board of Appeal (BoA) confirmed the refusal pursuant to Article 7(1)(b) EUTMR. It decided that for the contested goods and services the trade mark applied for will be understood by the target public in the sense that those are coming from an expert in the field of computer networks, since the word 'guru' is used as synonym to 'expert' and 'net' is an abbreviation for computer network.
The EUTM applicant filed an action before the General Court (GC) claiming the infringements of Article 75 EUTMR in conjunction with Articles 41(1) and 41(2)(c) of the EU Charter of Fundamental Rights, of Article 76(2) EUTMR, as well as of Article 7(1)(b) EUTMR and Article 7(1)(c) EUTMR.

SUBSTANCE: The GC dismissed first the claim of infringement of of Article 75 EUTMR in conjunction with Article 41(1) and Article 41(2)(c) of the EU Charter of Fundamental Rights. It decided that the

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EUTMA

NETGURU

reasoning of the contested decision applies, at least implicitly, to all products which form a sufficiently homogenous category (paras. 26, 27).

With regard to the alleged infringement of Article 76 (2) EUTMR the GC noted that the applicant did not substantiated its claim (para. 32). The BoA was allowed to base its decision on the meaning of the word 'guru' found in the common dictionaries and to disregard the evidence provided by the applicant (paras. 34, 35).

With regard to the alleged infringement of Article 7(1)(b) EUTMR the GC confirmed the definition of the mark in the contested decision and its laudatory character (paras. 58, 59).

With regard to the alleged infringement of Article 75 EUTMR in conjunction with Article 41(1) and Article 41(2)(c) and Article 7(1)(c) EUTMR the GC confirmed that the BoA was competent to base its decision on one of the absolute grounds for refusal quoted in the expert´s decision, and after having confirmed that ground it was not obliged to examine other grounds for refusal.

Case T-225/16; Matratzen Concord GmbH v EUIPO; Order of 28 November 2016; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive element, Slogan mark

FACTS: The EUTM applicant sought to register the word mark Ganz schön ausgeschlafen as a EUTM for services in Class 35. The examiner refused the application on the basis of descriptiveness and lack of distinctive character in respect of all the services. The First Board of Appeal (BoA) dismissed the appeal. The EUTM applicant filed an application before the General Court (GC) for the annulment of the decision of the BoA.

EUTMA

Ganz schön ausgeschlafen

SUBSTANCE: 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' with regard to the services at issue.

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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. 26-28). 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. 33-35).

Case T-96/16; Solenis Technologies LP v EUIPO; Judgment of 24 January 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Distinctive element, Laudatory mark

FACTS: The applicant sought to register the word mark STRONG BONDS. TRUSTED SOLUTIONS. as a EUTM for goods in Class 1. The Office refused the registration of the EUTM application (EUTMA) pursuant to Article 7(1)(b) and (2) EUTMR, as it was found to be devoid of distinctive character.

The Board of Appeal (BoA) dismissed the applicant's appeal. It took the view that the EUTMA was an ordinary advertising message, which was devoid of any elements that might enable the relevant public to memorise it easily and immediately as a trade mark in respect of the goods in question. The BoA also held the mark applied for was not distinctive, at least for the English-speaking part of the relevant public, within the meaning of Article 7(1)(b) EUTMR.

The applicant filed an action before the General Court (GC) relying on a single plea in law, namely a violation of Article 7(1)(b) EUTMR. The GC dismissed the appeal.

EUTMA

STRONG BONDS. TRUSTED SOLUTIONS.

SUBSTANCE: The GC endorsed the BoA´s finding as to the meaning of the words 'strong', 'bond' and 'trusted' and 'solution' and as to the combination of the combination of the elements 'strong' and 'bonds' and the word elements 'trusted' and 'solutions' respectively (paras. 22-24). The sign STRONG BONDS. TRUSTED SOLUTIONS., taken as whole, will easily be understood by the relevant public as meaning that the applicant's goods provide solid adhesive strengths that constitute reliable answers to problems or that those goods are trusted solutions (para. 28).

The GC also rejected the applicant's argument that

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the relevant public will perceive the term 'bonds' in its figurative sense as referring to emotional ties or bonds of affection and will understand the mark applied for, as a ~ whole, as meaning 'strong or resistant emotional ties and sincere and honest answers to problems'. Even if that meaning were to be accepted, the mark applied for would still be a banal slogan the laudatory meaning of which would be clear and unequivocal. The applicant has not established otherwise (para. 33). Taken as a whole, the mark applied for would be understood by the relevant public as referring to goods which constitute trusted solutions, irrespective of whether all the goods marketed by the applicant and covered by the application for registration have strong adhesive properties or not (para. 34).
In view of the above the BoA correctly considered the EUTMA as being a laudatory promotional formula and therefore non-distinctive within the meaning of Article 7(1)(b) EUTMR (para. 35).

Case T-128/16; SureID Inc. v EUIPO; Order of 28 November 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Abbreviation, Descriptive element, Specialised public, Nature of the goods and services, Purpose of the goods and services, Quality of the goods and services

FACTS: The applicant sought to register the word mark SUREID as a EUTM for services in Classes 35 and 45. The Office refused the registration of the EUTM application pursuant to Articles 7(1)(b) and (c) EUTMR, as it was found to be descriptive and therefore also devoid of distinctive. The applicant filed a notice of appeal against the examiner's decision pursuant to Articles 58 to 64 EUTMR. The Board of Appeal (BoA) dismissed the appeal and confirmed the examiner's decision. The applicant filed an action before the General Court (GC) relying on a single plea in law, alleging infringement of Article 7(1)(c) EUTMR. The GC dismissed the action.

EUTMA
SUREID

SUBSTANCE: 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 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 consists of one word that is common in the English language,

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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 has 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. 31-32). 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).

Case T-119/16; Topera, Inc. v EUIPO; Order of 26 January 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Descriptive element, Distinctive element, Specialised public, Nature of the goods and services, Purpose of the goods and services

FACTS: The applicant sought to register the word RHYTHMVIEW as an EUTM for goods and services in Classes 9 and 10.
The Office refused the registration of the EUTM application (EUTMA) pursuant to Article 7(1)(b), (c) and Article 7(2) EUTMR as it was found to be descriptive and devoid of distinctive character.
The Board of Appeal (BoA) dismissed the applicant's appeal. It considered the mark in relation to Class 9: Medical software for identifying and visualising rotors and focal sources in cardiac atria and Class 10: Medical workstations; parts and fittings for medical workstations, all for identifying and visualising rotors and focal sources in cardiac atria.
The BoA found that that the relevant English-speaking public, composed only of medical professionals and in particular cardiology specialists, will perceive RHYTHMVIEW as consisting of the meaningful expression 'observing the regularity of recurring physiological functions or events of the body or a visual aspect of them or a pictorial representation of the same'.
The applicant filed an action before the General Court (GC) relying on 2 plea(s) in law: (i) infringement of Article 7(1)(c) EUTM and (ii) infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal.

EUTMA

RHYTHMVIEW

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SUBSTANCE: The GC found that the meaning of the EUTMA for the relevant public is 'viewing' a rhythm (para. 23). The applicant's argument that RHYTHMVIEW has an unusual character because rhythm is not something that can be seen, failed. Rhythm is commonly represented visually (e.g. the pendulum of a metronome or flashing lights of audio systems) (para. 25).

As to the direct and specific relationship between the EUTMA and the goods, the GC found that the intended use or purpose of the goods at issue is apparent from their very description 'identifylng and visualising the rotors and focal sources of cardiac atria'. Although such rotors and focal sources do not themselves have any rhythm, it follows from the applicant's explanations that electrical signals in the heart enable the visualisation of rotors' as a 'consistent rotational activity around a centre' and of focal sources as 'concentric patterns'. In so doing, on the one hand, the applicant confirms the direct and immediate relationship between the goods at issue and a heart rhythm. On the other hand, the applicant's explanations about rotors and focal sources make it possible to understand that they fall within the definition of the English word 'rhythm', namely, any sequence of regularly recurring functions or events, such as the regular recurrence of certain physiological functions of the body (para. 29).

Finally, the applicant itself states that the goods at issue sense, filter and analyse signals emitted by rotors and focal sources and transform them into graphical representations, which are thus mapped out, it confirms, essentially, that the word 'view' in the mark applied for precisely indicates that the goods at issue are for visualising the phenomena covered by the notion of 'rhythm' (para. 30).

The GC must therefore find that the relevant public, when confronted with RHYTHMVIEW, will immediately, without further thought, believe that it designates goods which, by providing a visual representation of the electrical activity of the heart, make it possible to examine a heartbeat. In so far as rotors and focal sources can be visualised as sequences of regularly recurring functions or events the goods at issue will, for the relevant public, be associated with the rhythm to be viewed (para. 31).

Case T-2/16; K&K Group AG v EUIPO; Judgment of 30 November 2016 Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Detriment to earlier mark, Evidence of use, Figurative trade mark, Identity of the goods and services, Phonetic similarity, Proof of use, Relevant territory, Visual similarity, Well known trade mark

FACTS: The applicant sought to register the figurative mark below 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 below, was filed on the grounds of Article 8(5)

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EUTMR. The Opposition Division (OD) found that genuine use of the earlier marks had been proved in respect of some of the goods and services in Classes 29, 30 and 43 and upheld the opposition The Board of Appeal (BoA) upheld the decision of the OD. In its action before the General Court (GC), the applicant alleged infringement of Articles 42(2) and (3) EUTMR, as well as of Article 8(5) EUTMR. The GC dismissed the appeal.

EUTMA

Pret | A | Diner

Earlier marks

1)

2)

PRET

SUBSTANCE: 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 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).

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).

Case T-154/16; Grid applications GmbH v EUIPO; Judgment of 14 December 2016; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive element, Distinctive element, Principle of legality, Specialised public

FACTS: The applicant sought to register the word mark represented below as a EUTM for goods and services in Classes 9, 35 and 42. The Office refused the registration of the EUTM application (EUTMA) pursuant to Article 7(1)(b), (c) and 7(2) EUTMR, as it was found to be descriptive and devoid of distinctive character. The Board of Appeal (BoA) dismissed the applicant's appeal. The applicant filed an action before the General Court (GC).

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EUTMA

APlan

SUBSTANCE: 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 decision of the Office and similar trademark registration in Austria and the UK, the GC found that the Ofice is neither bound by its previous nor by decisions of other trademark offices. Due to the descriptive nature of the application it furthermore lacks distinctive character.

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R2568/2015-1 MicroBnk /

MICROBANK (fig.) et al.

RESULT: Decision annulled.

KEYWORDS: Conceptual identity, Figurative element, Figurative trade mark, Nature of the goods and services, Phonetic identity, Reimbursement, Relevant territory, Visual similarity.

NORMS: Article 8(1)(b) EUTMR, Article 64 EUTMR.

FACTS: An opposition was filed against the application for the word sign 'MicroBnk' on the grounds of Article 8(1)(b) EUTMR and several earlier rights. The Opposition Division (OD) found no likelihood of confusion and, therefore, rejected the opposition without examining the evidence of use filed by the opponent.

SUBSTANCE: The degree of similarity between the services applied for and those for which the earlier mark has been put to genuine use, will be decisive in the overall assessment of the likelihood of confusion. The assumption that because there would be no likelihood of confusion it was unnecessary to examine the evidence of use filed by the opponent, as requested by the applicant, is inappropriate in the present case. Such an assumption may only be used in cases where the trade marks are so different that they may not be confused, even for identical services, for which the earlier trade marks may enjoy enhanced distinctiveness (§ 17-18).
The signs and the territories covered by each of the earlier marks are different; the examination should have been carried out for each of the different earlier trade marks (§ 21).
A figurative trade mark with the word element 'MICROBANK' is phonetically (the contested decision incorrectly held that they 'differ in "b-n-k" pronounced as an abbreviation') and conceptually identical (the fact that the earlier trade mark contains a figurative element resembling works by the Catalan artist Miro, does not render them conceptually different). Examining various different earlier trade marks in one comparison runs the risk that the overall assessment is flawed (§ 31, 34).
The OD should have thoroughly assessed the proof of use submitted, should have carried out a comparison of the services in question and thoroughly analysed all aspects of the marks at issue, as well as the linguistic aspects thereof (§ 35).
The contested decision is annulled and the case is remitted to the OD for further examination (§ 41).

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R1396/2015-1 Babys Life /

Baby line (fig.)

RESULT: Decision confirmed.

KEYWORDS: Conceptual dissimilarity, Figurative element, Figurative trade mark, Identity between the goods and services, Likelihood of confusion (no), Phonetic similarity, Similarity between the goods and services, Visual similarity.

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

FACTS: The above EUTM application was partially opposed in respect of some of the goods in Classes 3 and 5 based on Article 8(1)(b) EUTMR. The earlier right, as represented above, was registered as an international registration designating several European countries. The OD rejected the opposition because did not find a likelihood of confusion between the marks.

SUBSTANCE: The similar elements 'Babys' and 'baby' are weakened in respect of the goods at issue. The signs are the same only in terms of descriptive components that are devoid of distinctive character, are only slightly similar in relation to the other components, and differ in terms of the earlier trade mark's figurative elements. According to the established case-law of the Boards and the Court, the likelihood of confusion cannot be based on a component with no distinctive character (18/09/2013, R 1462/2012-G, Ultimate Greens, § 56-62) (§ 42).
The fact that there is a certain degree of similarity in the aural impression is irrelevant: it was not proven that the aural impression is important in relation to the goods at issue and the differences in meaning also have an effect on the aural impression and enable an unequivocal identification (§ 44).
The Opposition Division was correct in finding that there was no likelihood of confusion. The appeal is dismissed (§ 45).

R1260/2015-3

Bottles

RESULT: Decision confirmed.

KEYWORDS: Admissibility, Conflict of design with prior trade mark, Dissimilarity of the goods and services, Fax, Individual character, Substantiation of earlier right.

NORMS: Article 6 CDR, Article 25(1)(b) CDR, Article 25(1)(e) CDR, Article 57 CDR, Article 28(1)(b)(iii) CDIR.

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FACTS: An application for a declaration of invalidity against the registered Community design (RCD) – as represented above – was filed claiming that it lacked novelty and individual character (Article 25(1)(b) and Articles 5, 6 CDR), and used a distinctive sign (Article 25(1)(e) CDR). The Invalidity Division rejected the application for a declaration of invalidity.

SUBSTANCE: The fax listing provided by the appellant is sufficient proof that the decision was not duly notified and that the time-limit to file the appeal did not expire four months after the date of the fax transmission (§ 17).
Given that the contested design and the prior design only share the features of the trapezoid base, the transparent material of the container and the golden opaque material of the top, but differ in all other features, makes the overall impression produced by the contested RCD and the prior designs different (§ 33). Given the individual character of the RCD with regard to the prior designs, it must necessarily be considered novel (§ 35).
The ground of invalidity under Article 25(1)(e) CDR was not sufficiently substantiated (§ 39-41).
In any case, there is no likelihood of confusion (§ 42). The bottle according to the RCD and the perfumes and cosmetics for which the earlier mark is registered are dissimilar, the visual similarity between the RCD and the earlier mark is very low and the alleged enhanced distinctiveness of the earlier mark has not been proven (§ 42-46).
The appeal is dismissed and the application for a declaration of invalidity is rejected.

R2270/2015-5 Veggiemett

RESULT: Decision confirmed.

KEYWORDS: Deceptive element, Descriptive element, Function of trade mark, Nature of the goods and services, Purpose of the goods and services

NORMS: Article 7(1)(b) EUTMR, Article 7(1)(c) EUTMR, Article 7(1)(g) EUTMR

FACTS: The applicant sought to register the word mark for, among others, goods in Class 29. The examiner refused the application on the basis of Article 7(1)(b) (lack of distinctive character), (c) (descriptive indication) and (g) EUTMR (risk of deception).

SUBSTANCE: That 'Veggie' is understood by the relevant German-speaking public in relation to foodstuffs as an indication of purely vegetable ingredients, or of a purely vegetable origin, is a fact which is well known, that is, which is likely to be known by anyone or which may be learnt from generally accessible sources (22/06/2004, T-185/02, Picaro, EU:T:2004:189, § 29) (§ 20). As regards 'Mett', this is a meat product consisting specifically of mince (§ 20).

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The sign applied for amounts to nothing more than the simple statement that the food products designated thereby represent a vegetarian variant of mett. The trade mark applied for is, therefore, incapable of performing its function as a distinctive sign in respect of these goods (§ 38).

In connection with the goods 'meat, fish, poultry and game, in particular sausage and ham products; meat extracts' the trade mark applied for refers to a vegetarian, that is to say purely vegetable, product, accordingly its deceptive capability is confirmed. The public is not able, through a mere inspection of the product, to ascertain whether or not it is vegetarian, but must rely upon the details on the packaging. If a German-speaking consumer is confronted with the word 'Veggiemett' for meat, fish, poultry, game or meat extracts, he or she will erroneously assume that it involves a vegetarian foodstuff. The sign is, therefore, capable of deceiving the public about the nature of the foodstuffs (§ 45).

The appeal must, therefore, be dismissed.

R2220/2015-5

SHARRI INDUSTRIA E MISHIT (fig.) /

SHARRI (fig.)

RESULT: Decision annulled.

KEYWORDS: Figurative element, Figurative trade mark, Likelihood of confusion, Phonetic identity, Phonetic similarity, Visual similarity.

NORMS: Article 8(1)(b) EUTMR, Article 53(1)(a) EUTMR.

FACTS: The registered figurative mark 'SHARRI INDUSTRIA E MISHIT' – as represented above – was challenged by the cancellation applicant, pursuant to Article 53(1)(a) EUTMR, in conjunction with Article 8(1)(b) EUTMR. The application was based on an international registration for the figurative mark 'SHARRI' as represented above. The Cancellation Division rejected the application for a declaration of invalidity in its entirety.

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SUBSTANCE: The Cancellation Division found that part of the relevant public would recognise the shared word component 'SHARRI' as the name of the mountain range that lies on the border between Kosovo, Macedonia and Albania. This mountain range is indeed located in Europe, but outside the European Union, in a region that is still fairly unknown and which has not been discovered by tourists. It is not known exclusively by the name 'SHARRI'. The most common name for the mountain range is 'Šar'. 'Sharri' is therefore closest to the Albanian name, but less than 1% of the mountain range is located in Albania. The Board, therefore, takes the view that, in connection with the goods that are the subject of these proceedings, consumers would be more likely to perceive 'Sharri' as a fanciful term (§ 20).

'SHARRI' is the only word element in the earlier trade mark and the most visually apparent in the contested sign. The figurative elements of both signs convey the concept of a mountain landscape. Although the additional, smaller word components of the contested trade mark, 'INDUSTRIA' and 'MISHIT', will have a meaning for at least some of the public targeted, they do not contribute towards any differences in meaning between the two trade marks that would be capable of 'counteracting' the visual, aural and conceptual similarities that exist (§ 27).

The differences between the conflicting signs in the present case are, therefore, insufficient to rule out a likelihood of confusion in the case of identical goods (§ 28).

The contested decision is annulled and the EUTM declared invalid.

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