

Up to date information on IP and EUIPO-related matters

October  
2017

## 20 years of the Boards of Appeal at EUIPO



Anna Carboni, talks to James Nurton

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### 20 years of the Boards of Appeal at EUIPO

In 1997, the year in which the Boards of Appeal took their first decision, just 20 appeals were filed. That was back at the very beginning of EUIPO's history, in its very earliest days. There was no IT system in place, no Registered Community Design and no case law of the General Court or the Court of Justice on EU trade marks

As more applications were received, so the number of appeals grew significantly. But the principle of independence has always underpinned all that the Boards do. Members cannot take any instructions and must be absolutely impartial - declining to judge a case at the merest hint of a conflict of interests.

Following the entry into force of the Community Design Regulation, the Boards began to take decisions on an entirely new EU unitary intellectual property right. This led to a series of decisions which, in turn, began to shape EU design law.

The workload of the Boards increased enormously as the years went on, growing from 20 decision in that first year to 2,568 decisions in 2016, with a confirmation rate before the General Court of 85.7%. The percentage of decisions appealed before



the General Court was 9.6% in 2016. This means that every year more than 90% of cases are finally decided by the Boards and never go on appeal to the Court.

One of the most significant developments at the Boards over the past two decades has been the integration of quality management. Practically, this means well-reasoned decisions and predictable proceedings successfully embracing and complying with ISO 9001 and 27001 standards and indicators.

Another major milestone for the Boards was reached this year, with the launch of the eAppeal tool, allowing users to file appeals online for the first time ever.

Mediation at the Boards of Appeal is something entirely new at EU trade mark and design level, and since its introduction in 2011, the Boards of Appeal have offered parties the opportunity to use a mediation service in inter partes matters as an alternative to an appeal decision.

In terms of cooperation, EUIPO's Boards of Appeal have close links with their counterparts at EU Member State level and in other EU agencies and international organisations, contributing to the second instance community of practice in the EU and worldwide.

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The Boards of Appeal regularly hold conferences and knowledge sharing events, which attract members of the judiciary and legal professionals from all over the EU and beyond. The Mediation Conference in 2014 was just the start of a series of conferences, seminars, laboratories and workshops at which discussion and debate flow. In the wake of the inaugural IP Case Law Conference in 2016, the Boards will continue with a second such conference on 7-8 May 2018.

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## The James Nurton Interview



### Interview: Anna Carboni, partner, Redd Solicitors

#### Tell me about your firm?

#### What led to your interest in IP?

I studied natural sciences at Cambridge University, my father was a City solicitor and my uncle was a patent attorney so I was always aware of IP and I thought I might become a patent lawyer. I was lucky to get a vacation job at Linklaters working in the IP department for one month and went on to do my articles there.

In those days most IP lawyers did everything – all IP rights, both contentious and non-contentious



Anna Carboni

work – so I tended to do what came my way. But I soon found that trade mark work was quite fun so I gravitated more towards the brands side. Nowadays I do trade marks, designs, copyright and some trade secrets work. I haven't done a patent case for about 10 years – it's hard to keep up with all the developments in the law particularly if you are not just being a litigator but also doing advisory work. And I do find brands is the most fun area.

#### What kinds of work do you do?

I do a lot of strategic advice on brand protection and risk assessment, addressing “what if?” questions such as “are we going to get sued?” so it's slightly hard to say how much is actually litigation, but it's probably about 60%. Most of that is related to brands but I've had some copyright cases that can end up totally dominating your time while they're on. I also have overall responsibility for managing some IP portfolios, but other people at the firm do most of the day-to-day work.

#### How big is your team?

We are four partners and 12 lawyers in total at Redd. On 6th November we will join with the law firm Wiggin, so after that we will have an IP department of about 20 lawyers with eight partners. The move is not about trying to change our focus but about being able to do more of the same, for whatever kind of client comes through the door regardless of sector. Wiggin have a focus on film, media and digital work

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so we will be strong in those areas as well as the luxury goods, software, engineering, life sciences and other areas that we already practise in. We will also hopefully be able to do more commercial IP work – there is a limit to how much you can build a standalone practice in that area.

Of course Brexit is also on our horizon. We want to ensure we can continue to advise clients on EU law, EU trade marks and registered Community designs. We had explored options such as becoming Irish-qualified solicitors, and we looked at property in Dublin and Alicante as well as insurance and staffing questions. Wiggin has a Brussels office so we will see how that helps with the Brexit problem – it gives us an extra bit of security. I think the UK is an important entry point into the EU, especially for US clients, so we are determined to continue that work.

### How has your career developed?

I started at Linklaters which is a magic circle firm, and that was fantastic at the time as it gave lots of opportunities – but you also have to accept that, as an IP practitioner, you are to an extent a support department and there will be certain types of work you can't do. I became head of the IP department in London and I was worried about becoming more of a manager than a lawyer, so I decided to move to the Bar: that meant I could get back to the grassroots of the law, reading textbooks and cases. Being a barrister meant I had a fantastic

independent life, which worked well with children and holidays as I could choose when I wanted to work to a large extent. But I also found I missed the direct client contact, and it was difficult to manage my commitment to IP associations. It is also quite lonely being a barrister and I missed being part of a team.

So I decided to return to being a solicitor in a boutique IP firm. I have been at Redd for nearly six years, and am now looking forward to the next phase as we merge into Wiggin. I still do some of my own advocacy, and encourage my colleagues to do so too, but of course we also instruct barristers in a lot of cases.

### What do you think of the EU and UK systems?

Having the EU trade mark has really improved things for brand owners. You can now get proper pan-EU relief or you can get a decision in one EU member state which has commercial consequences in others. That simply wasn't the case before. That has been a great change, especially in the past decade or so as the case law has developed.

In the UK, the courts have a reputation for being over-complicated and expensive, which I think is somewhat unfair. We have been significantly improving our game, especially with the IPEC and the Shorter Trial Scheme pilot in the High Court. Clients now have more cost-effective options and

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the courts have become more savvy: the IP judges have led the way on that which is very welcome.

### What do you think of the case law on trade marks?

Of course it took a while to settle down. People criticise the CJEU and the EU General Court for giving inconsistent or Delphic judgments but you could say that about any national court too. Overall I think the case law has generally been helpful, and is going in the right direction.

One area that is frustrating is regarding non-traditional trade marks and the obligation to prove acquired distinctiveness for product configuration design. The current position is that brand owners have to go a long way – providing survey evidence across the entirety of the EU and proving their case to the nth degree. That is not commercially viable and needs to be looked at.

It is enshrined in EU law that consumers don't regard product design configuration as a badge of origin – but that is patently factually untrue. You only have to look at trainers to see that the appearance of certain design features are critical in choosing between say a Nike and an Adidas product. The world has moved on but the courts haven't.

### How did your experience as an Appointed Person help you as a litigator?

I spent seven-and-a-half years as an Appointed Person hearing trade mark cases and it was very interesting to see the different approaches to advocacy and preparation. Judges do not always have a lot of time to prepare and read all the documents, so it is really important for the written and oral arguments to place the important issues upfront and help them see the wood for the trees. A really good advocate can match together the applicable law to the facts of the case to explain why their side should win.

### Do you use mediation very much?

Yes. The reality in many trade mark cases is that there is a significant element of subjective impression so, even if you think your client has a strong chance of success, you are unlikely to advise them that they have better than a 70% chance of winning. That's a 30% chance of losing, which is quite a risk! The advantage of mediation is that you gain certainty and everyone feels they have won a bit. We see lots of cases settle following mediation.

I have also been involved in several quasi-mediations, where you don't have an independent mediator but you have the same structure to the day and a bit less formality. But my impression is that mediation has taken off more in the UK than in countries such as Germany or France, possibly because the courts have encouraged it which is helpful.

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I've had two big copyright cases recently which had multiple parties and quite unusual facts, and both were settled by mediation shortly before going to court.

### What's been the most memorable case you've been involved in?

As a very junior assistant at Linklaters, I was sent to Italy to interview some Gucci manufacturers to collect evidence statements, and I spent six months on secondment with the Jacobacci firm in Turin where I learned Italian among other things.

I then ended up being the lead assistant solicitor in the Gucci v Paolo Gucci trade mark case, which really set me on the trade mark path. At the time Gucci was a family-owned business, headed by Maurizio Gucci, and the company was in dispute with his first cousin, Paolo Gucci, who wanted to market a line of fashion items and household goods under his name. He had developed a PG logo that looked like the GG logo, was using a blue-red-blue stripe device like Gucci's green-red-green device, and significantly exaggerated his historic involvement in the development of Gucci's product lines.

It was a bitter dispute, with allegations of fraud and it emerged that Paolo had lied about various activities, which he blamed on his divorce proceedings. This didn't play well for him in court, and ultimately we won and the judge ended up being won over by the idea, as he put it, that if you put Gucci on a camel it becomes a Gucci camel.

### Tell me about your involvement with INTA?

For the past two years I have chaired a new committee on unfair competition, and I have now been nominated to become INTA counsel for the next year (subject to approval by the Board in November), which is very exciting [Anna will be the first person outside of North America to hold this position].

I think it is very important as an IP practitioner to be involved in associations. It's the best way of staying in touch with clients and getting to know other lawyers from around the world, as well as having an interesting time.

### What do you think the future holds for IP?

I think there are interesting things happening in the law in each area of IP. The biggest challenge is probably around digital and the online environment, and how that affects how people deal with IP rights. In terms of enforcement, the challenge is how all-pervasive infringements can be, so you have to decide which cases you go after. The law itself needs to adapt to the online environment bit-by-bit as we have seen in copyright. No one knows what exactly lies around the corner, but I think both the law and practice will be driven by the internet.

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

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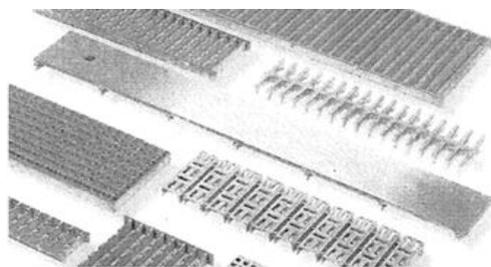
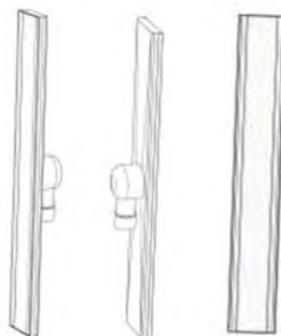
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The dispute arose after the predecessor of Group Nivelles N.V. submitted an application to EUIPO for a declaration of invalidity of the registered Community design held by Easy Sanitary Solutions BV which, according to that registration, relates to a 'shower drain'. In support of its application for a declaration of invalidity Group Nivelles N.V. claimed that that design lacked novelty and individual character, relying on the existence of an earlier design which had been made available to the public. The Invalidation Decision declared the contested design invalid on the basis of lack of novelty. The Third Board of Appeal in contrast found the contested design not to be identical with the earlier design, annulling the decision of the first instance and remitting the case back for further examination of individual character. This decision was appealed to the General Court by both parties, which led to the judgment T-15/13 Group Nivelles v OHIM — Easy Sanitary Solutions, resulting in the GC annulling BoA decision. With this recent judgement, the CJEU has provided some light and clarifications.

The present case has led the CJEU to consider the scope and basic principles for the application of



Council Regulation (EC) NO 6/2002 of 12 December 2001 on Community designs, 'CDR', as well as the competences which are to be conferred to the EUIPO within the examination of applications for declaration of invalidity of a RCD.

The decision of the highest instance mainly focuses on two major issues. First of all, on the identification of the conflicting designs, the CJEU concludes that protection cannot be extended to component parts

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which are not visible during normal use, therefore highlighting the importance of the

**visibility** of a design as being essential for its protection. Express reference is made to Article 3(1) of CDR on the concept of a design, and to its recital 12, which excludes from protection those component parts of a design which are not visible during normal use of a product, and those features of such part which are not visible when the part is mounted stating that those characteristics should not, for those reasons, be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection.

On the debate on the burden of proof and the taking of evidence in proceedings relating to a declaration of invalidity, the CJEU stresses the importance for the EUIPO to have an image of the earlier design that enables the appearance of the product in which the design is incorporated to be seen, and to identify the earlier design precisely and with certainty, so that the novelty and individual character of the contested design may be assessed, and a comparison of the designs at issue can be carried out as part of such assessment. It is a prerequisite of an examination whether the contested design does in fact lack novelty or individual character that a specific and defined earlier design is available.

Therefore, it is for **the party who lodged the application for a declaration of invalidity to provide EUIPO with the necessary information and, in particular, to identify and reproduce precisely and entirely the design that is allegedly earlier in order to demonstrate that the contested design cannot be validly registered.**

In this sense, the Court considers that the GC erred in law when it imposed the requirement on EUIPO, that for the purpose of assessing the novelty of the contested design, it had to construct the earlier design from the various elements of one or more earlier designs in various catalogues attached to the application for a declaration of invalidity, even though the applicant for a declaration of invalidity had failed to reproduce in its entirety the design that it claimed to be earlier. However, the CJEU considered that this error of law would not invalidate the judgment under appeal as its operative part was well founded on other legal grounds.

On another note, the CJEU reminds us that in accordance with Article 6 CDR a design is to be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public. It has already held before that the concept of the 'informed user' may be understood as referring, to a particularly observant one, either because of his personal experience or his extensive

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knowledge of the sector in question.

However, such concept cannot be interpreted as meaning that it is only if that user knows the earlier design that the earlier design could prevent recognition of the individual character of a subsequent design. Nothing in Article 7(1) CDR permits the conclusion that it is necessary for an informed user of the product in which the contested design is incorporated or applied to know the earlier design when it is incorporated in a product in an industry sector that differs from the relevant sector for the contested design, or is applied to such a product.

Therefore, and on the second issue raised by the Court, the relevance of the products to which the designs are applied, it concludes that **the fact that the protection granted to a design is not limited only to the products in which it is intended to be incorporated or applied must necessarily mean that the assessment of the novelty of such design must neither be limited to those products alone.** It therefore clarifies the limits of the 'sector concerned' under Article 7(1) CDR. And it follows from the wording of the first sentence of such article that the effect of that provision is that the question of whether there is disclosure to the public is dependent only upon **how that disclosure is in fact achieved and not upon the product in which that design is intended to be incorporated or to which it is intended to be applied.**

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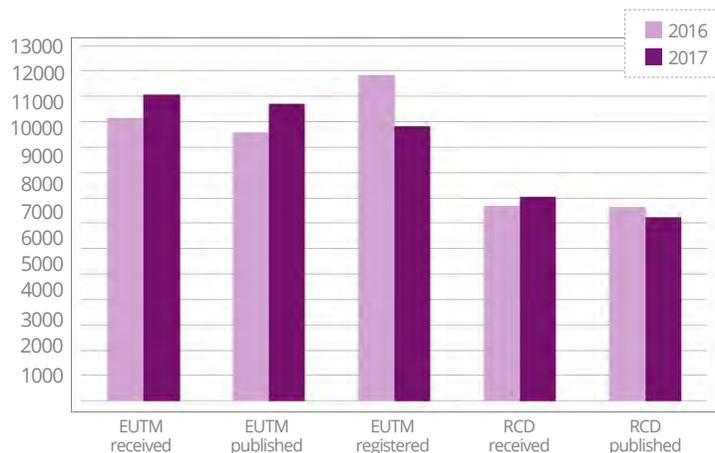


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Monthly statistical highlights September*	2016	2017
European Union Trade Mark applications received	11 144	12 080
European Union Trade Mark applications published	10 595	11 714
European Union Trade Mark registered (certificates issued)	12 849	10 820
Registered Community Designs received	7 690	8 026
Registered Community Designs published	7 632	7 218

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



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### Peru joins TMview

As of 10 October 2017, The National Institute for the Defense of Free Competition and the Protection of Intellectual Property of Peru (INDECOPI) has made its trade mark data available to the TMview search tool.

Since the introduction of TMview on 13 April 2010 the tool has served more than 34.7 million searches from 157 different countries, with visitors from Spain, Germany and Italy among the most frequent users.

### The State Agency on Intellectual Property of the Republic of Moldova (AGEPI) joins TMclass

As of 23 October 2017, the State Agency on Intellectual Property of the Republic of Moldova (AGEPI) has joined TMclass.

This last addition brings the total number of national and regional IP Offices, including OAPI, WIPO and EUIPO, in the tool to 66.

TMclass offers users the opportunity to search and translate goods and services to and from any of the 43 available languages.

### EUIPO bilateral meetings during the WIPO General Assemblies

A delegation from EUIPO, led by the Deputy Executive Director, Christian Archambeau, held 22 technical bilateral meetings and four joint events with heads of non-EU IP Offices, including WIPO and other regional organisations such as ARIPO and OAPI, in Geneva from 2 to 4 October 2017.

The three-day event enabled the EUIPO to reach out to 60 IP Offices in total, from candidate and potential candidate countries, TM5/ID5 partners and other regions of the world with which the EUIPO already has cooperation activities and with which cooperation activities will soon be launched. These 60 IP offices represent the 'countries of origin' of 21.97 % of total EUTMs and 14.85 % of total RCDs respectively.

The EUIPO delegation reviewed the current status of the technical cooperation projects with the Office's partners and jointly agreed on future steps. Integration into the EUIPN tools, as well as the launching of the new EU-funded projects, IP Key Latin America, IP Key SEA and IP Key China, were the main points of discussion with international partners.

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The TM5 and ID5 cooperation projects were also discussed with the IP Offices of China, Japan, South Korea and the USA.

In the framework of the Strategic Plan 2020, this event falls within Line of Action 4 and contributes towards the development of the 'Extension of tools and support to Observatory in non-European countries' project.

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### Legislative Reform: full implementation of tools and services on 1 October

At 00:00 CEST on Sunday 1 October, all the e-business tools and services within the EUIPO website were brought fully into line with the entry into force of the second wave of Legislative Reform changes.

EUIPO's trade mark e-filing system was taken offline for 12 hours on Saturday 30 September to enable the updates to be carried out.

The change brought about by the second wave of the Legislative Reform process included the removal of the graphical representation requirement, the introduction of the EU Certification mark, and other procedural changes.

More information can be accessed through our [Legislative Reform information hub](#).

### Stakeholder Quality Assurance Panels Project: SQAP

On 2-3 October 2017, EUIPO welcomed an external audit on the quality of opposition decisions.

In its 2020 Strategic Plan, EUIPO sets the goal of enhancing customer-driven quality services by being

user-oriented and focusing on the quality of EUIPO's products and services. In this context, Stakeholder Quality Assurance Panels (SQAP) is an innovative project aiming at involving users in the quality management of the Office and in contributing to the quality of the Office decisions.

In the form of Stakeholder Quality Assurance Panels (SQAP), this is the third of a series of quarterly pilot audits in 2017. The main objective of this project is to involve stakeholders in the Office's quality processes, in order to bridge the gap between the users' perception of quality and the internal quality measurement results.

During two days, 14 auditors representing eight User Associations checked EUIPO opposition decisions to assess their quality in accordance with the established Office quality criteria. The checks are conducted on a sample of decisions already checked ex-post and following the same methodology by ex-post quality checks.

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#### A: Court of Justice (CJ): Orders, Judgments and Preliminary Rulings

**Case C-139/16; Moreno Marín a.o v Abadía RetuertaSA; Preliminary ruling of 6 July 2017;**

**Language of the case:** ES

**KEYWORDS:** Geographical origin, Descriptive element, Minimum degree of distinctiveness

**FACTS:** The applicant in the main proceedings is the owner of the Spanish trade mark La Milla de Oro, registered for distinguish wines. The applicant brought an action against the defendant who used the sign El Pago de Milla de Oro, alleging that there was a likelihood of confusion. The defendant brought a counterclaim seeking a declaration of invalidity of the La Milla de Oro trade mark, submitting, inter alia, that the trade mark constituted an indication of geographical origin. The first instance court upheld the counterclaim, declaring the mark invalid on the grounds that it was an indication of geographical origin. The referring court points out that the sign does not seem to be an indication of geographical origin but is still associated with a specific place which is characterised by a high concentration of high quality goods. As with geographical indications,

in which a given characteristic of a product is associated with the place in question, that sign would be associated with the place concerned insofar as it was characterised by the quality of the goods and their accumulation.

**SUBSTANCE:** By the second question, which the CJ examines first, the referring Court asks whether a sign such as La Milla de Oro, referring to the characteristic of a product or service which is that it can be found in abundance in a single place with a high degree of value and quality, may be considered as an indication of geographical origin where the goods or services concerned are concentrated in a specific physical area. The CJ holds that the sign La Milla de Oro, first, designates a geographical zone which varies depending on the name of the geographical place which accompanies it and, second, refers to a specific level of quality of the goods and services which varies depending on the name of the geographical place with which that sign is associated. Consequently, that sign must be accompanied by a name designating a given geographical place so that the geographical origin of the goods or services concerned may be identified, the latter being characterised by the possibility of finding in abundance, in that determined physical space, such goods or services of a high degree of value or quality. There is no connection between the product concerned in the present case, namely wine, and the geographical origin attributed to the sign La Milla de Oro, since it is precisely on the basis

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of the name of the given geographical place with which they are associated that the geographical origin of the goods or services in question can be determined. The answer to the second question is that a sign such as La Milla de Oro referring to the characteristic of a product or service which is that it can be found in abundance in a single place with a high degree of value and quality, cannot constitute an indication of geographical origin (paras 15-21). By the first question, the referring Court asks whether Article 3(1)(c) of Directive 2008/95 must be interpreted as meaning that a sign such as La Milla de Oro, referring to the characteristic of a product or service which is that it can be found in abundance in a single place with a high degree of value and quality, may have characteristics the use of which as a trade mark would constitute a ground for invalidity within the meaning of that provision. The CJ holds that it will be for the referring court to ascertain, during the assessment in concreto of all the relevant facts and circumstances, whether the sign La Milla de Oro can be perceived by the relevant public as being descriptive of a characteristic of a product, such as wine, which is that it can be found in abundance in a single place with a high degree of value and quality. The referring Court will have to examine, in the light of all the relevant facts and circumstances, whether the sign La Milla de Oro, provided that it is not descriptive of the characteristic of a product or service which is that it can be found in abundance in a single place with a high degree of value and quality, is perceived by the

public concerned as being a slogan or promotional formula capable of indicating the commercial origin of the product or service concerned. Article 3(1)(c) of Directive 2008/95/EC must be interpreted as meaning that a sign such as La Milla de Oro, referring to the characteristic of a product or service which is that such a product or service can be found in abundance in a single place with a high degree of value, is unlikely to have characteristics the use of which as a trade mark would constitute a ground for invalidity within the meaning of that provision.

**Case C-433/16; Bayerische Motoren Werke AG v Acacia; Preliminary ruling of 13 July 2017; EU:C:2017:550;**

**Language of the case:** IT

**KEYWORDS:** Infringement

**FACTS:** Preventive actions for a declaration of non-infringement of a Community design, where permitted by the applicable national law, have to be brought before an EU design court (Article 81(b) CDR) at the domicile of the defendant (Article 82(1) CDR: 'forum rei principle'). This judgment concerns the question whether the CDR and/or the Brussels I-Regulation contain exceptions from that principle, and under which conditions those exceptions apply.

In the case at hand pending before the referring

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court, Acacia (applicant) sought from the Italian jurisdiction (i) a declaration of non-infringement of BMW's (defendant's) Community designs as well as (ii) declaration of abuse of a dominant market position and unfair competition by BMW and (iii) an injunction to prevent BMW from taking any action hindering the marketing of Acacia's replica of BMW's alloy rims for automobile wheels. Acacia considered its replica products to fall under the 'reparation clause' (Article 110(1) CDR). BMW is not domiciled in Italy but in Germany.

BMW entered an appearance before the Italian jurisdiction by lodging a defence raising (i) as preliminary points, the non-notification of the application and the lack of mandate of Acacia's lawyer, (ii) in the alternative, but still as a preliminary matter, the jurisdictional incompetence of the Italian courts, and (iii) in the further alternative, that Acacia's submissions were unfounded.

The referring court asked whether or not the Italian courts had international jurisdictional competence to hear the case.

**SUBSTANCE:** The Court of Justice of the European Union (CJEU) found that (i) a number of exceptions from the forum rei principle provided for in the Brussels I-Regulation have been explicitly excluded by the legislator with regard to actions for a declaration of non-infringement of a Community design and (ii) that another exception did not apply to the facts of the case at hand.

In line with earlier case-law (C-360/12 Coty Germany

and C-617/15 Hummel), the CJ confirmed that the CDR excludes the application of certain provisions of the Brussels I-Regulation (Article 79(3) CDR) and provides instead its own lex specialis-provisions on international jurisdictional competence (paras 38, 39) laid down in Article 82 CDR. Specifically with regard to actions for a declaration of non-infringement of a Community design (Article 81(b) CDR), the Court observed that, where the defendant is domiciled in the Union, these specific rules (Article 82(1),(4),(5) CDR) provide for exceptions from the 'forum rei principle' only (i) in case of agreement between the parties, (ii) where the defendant enters appearance without contesting the jurisdiction of the EU design court seised, and (iii) in cases of litis pendens and related actions (paras 40-42).

As a consequence, neither the derogation from the 'forum rei principle' provided for in Article 22 Brussels I-Regulation (registration or validity proceedings of patents, trade marks, designs, or other similar rights), nor that laid down in Article 5(3) Brussels I-Regulation (place where the harmful event occurred or may occur) are applicable, both of them being furthermore explicitly excluded by Article 79(3)(a) CDR (paras 41, 43-44). The CJ found furthermore (para. 49) that the explicit exclusion of jurisdictional competence based on Article 5(3) Brussels I-Regulation (place where the harmful event occurred or may occur) by Article 79(3)(a) CDR cannot be circumvented by having recourse to the 'connexity'-exception (related further claims such as abuse of a dominant position and unfair

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competition) to be heard in the courts for the place where the harmful event occurred or may occur (Article 28 Brussels I-Regulation). This would compromise the effectiveness of Article 79(3)(a) CDR which is specifically designed to set aside Article 5(3) Brussels I-Regulation regard to actions concerning the infringement and validity of Community designs (para. 50).

With regard to the derogation from the 'forum rei principle' based on the entering of an appearance by the defendant provided for by Article 24 of Regulation No 44/2001, the CJ confirmed, in line with its earlier case-law, that such tacit prorogation of jurisdiction is excluded where the defendant 'unambiguously contests the jurisdiction of the court in its first defence' (paras 34, 35). As long as this condition is fulfilled, it is immaterial whether the defendant has raised an objection of lack of jurisdictional competence in the alternative to other procedural objections (para. 36) or further presented, in the alternative, submissions on the substance (para. 33).

**Case C-93/16; Ornuia Co-operative Ltd, formerly The Irish Dairy Board Co-operative Ltd (Ornuia) v Tindale & Stanton Ltd España SL (T&S); Preliminary ruling of 20 July 2017; EU:C:2017:571;**

**Language of the case:** ES

**KEYWORDS:** Coexistence of trade marks, Due cause, Infringement, Likelihood of confusion, Relevant

territory, Reputation.

**FACTS:** Ornuia, the owner of several KERRYGOLD EUTMs for butter and other dairy products filed an infringement action before the Juzgado de lo Mercantil de Alicante (Alicante Commercial Court) against T&S's use of KERRYMAID for margarines in Spain. That court held that the only similarity between the signs was the element 'Kerry', which refers to an Irish county known for its cattle breeding. It was common ground that, in Ireland and the UK, the KERRYGOLD and the KERRYMAID marks coexisted peacefully. The court dismissed the infringement action holding that:

There was no likelihood of confusion between the marks since Ireland and the UK together have a significant demographic weight in the EU and the peaceful coexistence of the marks in those places, in view of the unitary character of the EUTM, must lead to the conclusion that there is no likelihood of confusion throughout the entire EU.

Peaceful coexistence of the marks in Ireland and the UK means that, in Spain, T&S cannot take unfair advantage of the distinctive character or repute of the earlier marks.

Ornuia appealed to the Provincial Court of Alicante (Referring Court) which stayed the proceedings and referred the following questions [abridged below] to the CJEU:

Can Article 9(1)(b) EUTMR be interpreted as meaning

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that there is no likelihood of confusion where the earlier trade mark has, owing to the acquiescence of the proprietor, peacefully coexisted for some years with similar national marks in two Member States of the EU so that the absence of a likelihood of confusion in those two Member States is extended to other Member States, or to the EU as a whole?

In the situation set out in the previous paragraph, can the geographical, demographic, economic or other circumstances of the States in which the coexistence has occurred be taken into consideration for the purpose of assessing the likelihood of confusion, so that the absence of a likelihood of confusion in those Member States can be extended to a third Member State or to the EU as a whole?

Must Article 9(1)(c) EUTMR be interpreted as meaning that, where an earlier trade mark has coexisted with the contested sign for a certain number of years in two EU Member States without the proprietor of the earlier trade mark opposing it, this acquiescence on the part of the proprietor towards the use of the later sign in these two States can be extended to the remaining territory of the EU for the purpose of determining whether there is due cause for a third party's use of the later sign?

**SUBSTANCE:** The CJ began its answer to the first question by affirming the unitary character of the EUTM and by highlighting that the exclusive right conferred by an EUTM under Article 9(1) EUTMR,

extends, as a rule, to the entire area of the EU. The CJ also pointed out, however, that when the use of a mark gives rise, in one part of the EU to likelihood of confusion with an EUTM, whilst, in another part of the EU, that same use does not give rise to such a likelihood of confusion, the EUTM court must prevent use of the sign at issue throughout the entire territory of the EU with the exception of the part in respect of which there is no likelihood of confusion (paras 25-33).

Next, the CJ stressed that where peaceful coexistence between marks has been found in Ireland and the UK, the EUTM Court in Spain involving those marks cannot merely base its assessment of infringement on the situation in Ireland and the UK. Quite the reverse, that court must make a global assessment of all the relevant factors so the fact that marks peacefully coexist in one part of the EU, does not allow the conclusion that elsewhere, where peaceful coexistence is absent, there is no likelihood of confusion (paras 34-38).

In response to the second question, the CJ found that there is nothing to prevent an EUTM Court when assessing infringement in one part of the EU (Spain) from considering relevant factors that rule out infringement in another part of the EU (Ireland and the UK). That court must, however, ensure that there is no significant difference in market conditions and sociocultural circumstances. Indeed, the CJ noted that consumers' perception of the geographical term Kerry may differ in the relevant places and that this is important when considering

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whether the defendant follows honest business practices (paras 39-47).

On the third question, interestingly, the Advocate General felt that a situation of co-existence must be taken into consideration, not in the context of due cause, but in the global assessment of the existence of a link between the trade marks (para. 51 opinion of AG). The Court ultimately ruled out peaceful coexistence in one part of the EU automatically giving rise to due cause in another part because an analysis of detriment to reputation of an EUTM must be based on a global assessment which takes into account all the factors relevant to the case. So, when examining due cause in Spain, the EUTM court cannot merely base its assessment on peaceful coexistence in Ireland and the UK (paras 56-60).

**Case C-437/16 P; Wolf Oil Corp. v EUIPO; Judgment of 5 October 2017; EU:C:2017:737;**

**Language of the case:** EN

**RESULT:** Action dismissed

**KEYWORDS:** International registration, Figurative trade mark

**FACTS:** The applicant obtained the international registration designating the European Union of the word mark represented below for goods in Classes 1,3 and 4. An opposition was based inter

alia on the international registration designating the Union and France of the figurative mark represented below for goods in Classes 1, 3 and 4. The Opposition Division (OD) partly upheld the opposition. The Board of Appeal (BoA) upheld the appeal. It annulled the OD's decision in so far as it had upheld the opposition for part of the goods referred to and dismissed it for the other goods. The opponent filed an action before the GC, which dismissed the action. The opponent filed an action before the CJ relying on two pleas in law: alleging a distortion of the evidence and a failure to state reasons, and infringement of Article 8(1)(b) EUTMR. The CJ dismissed the appeal.

### IR designating the EU

CHEMPIOIL

### Earlier rights

CHAMPION®

**SUBSTANCE:** As to the first plea in law, the CJ emphasised that the appellant merely criticises the reasoning of the judgment under appeal in so far as the GC considered that the sign 'CHEMPIOIL' did not convey any clear concept. In so doing,

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without precisely identifying the evidence which the GC allegedly distorted, it seeks in effect to obtain from the CJ a new assessment of the conceptual differences between the two signs at issue. Consequently, the first ground of appeal must be regarded as inadmissible in so far as it alleges a distortion of the evidence (para. 26-27). Furthermore, according to the CJ, the GC clearly set out the reasons which led it to consider that the signs at issue should be regarded as conceptually different (para. 31). As to the second plea in law, the CJ stated that the GC correctly distinguished the assessment of the conceptual differences in the analysis of the possible neutralisation of visual and phonetic similarities by conceptual differences. In particular, the GC found that the word 'champion' had a clear and specific meaning, whereas the term 'chempioil' did not have a clear meaning which could be immediately understood by the public (para. 46). Finally, without erring in law, it held that the visual and phonetic similarities of the signs at issue could be neutralised (para. 47). Additionally, the GC did not err in law when it considered that the BoA had correctly held that a consumer would make a distinction between the signs at issue, despite their visual and phonetic similarities (para. 55). To conclude, the CJ stated that the appellant did not base the ground of appeal which it raised for the first time at the hearing before the GC on any element of law or of fact disclosed during the proceedings giving rise to the judgment under appeal and itself recognises that the factual evidence on which it relies



formed part of the evidence before the Office. The GC was therefore right to refrain from responding to that complaint, which was inadmissible (para. 62).

### **B: General Court (GC): Orders and judgments on appeals against decisions of the EUIPO**

#### **Case T-350/13; Jordi Nogues SL v EUIPO; Judgment of 20 September 2017; EU:T:2017:633;**

**Language of the case:** ES

**RESULT:** Action upheld (BoA decision annulled)

**KEYWORDS:** Likelihood of confusion, Dissimilarity of signs, Dominant element, figurative element, Coexistence of trade marks

**FACTS:** The applicant sought to register the figurative mark BADTORO, represented below, as an EUTM for goods and services in Classes 25 and 34. An opposition based, among others, on the Spanish figurative marks TORO, represented below, registered for goods in Class 34 and the word EUTMs TORO, registered for goods in Classes 25 and 35, was filed pursuant to Article 8(1)(b) EUTMR. The OD ascertained the existence of a likelihood of confusion and allowed the opposition. The BoA dismissed the applicant's appeal. It found that there had not been peaceful coexistence between the marks under conflict and that a likelihood

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of confusion existed on the relevant public. The applicant filed an action before the GC relying on a single plea in law: infringement of Article 8(1)(b) EUTMR.

### EUTM application



### Earlier mark

TORO



**SUBSTANCE:** The GC emphasised that, contrary to the BoA's position, the figurative element of the contested mark is original and capable to divert the public's attention away from its word component (para. 30). The latter has indeed of secondary importance within the overall impression generated by the sign (para. 37). The circumstance that both the earlier and the contested marks include the term 'TORO' is of scarce relevance within the assessment

of the degree of visual similarity existing between them, which shall be considered low (para. 48). On the other hand, the GC endorsed the BoA's assessment that the signs are aurally similar to a normal degree (para. 52). As far as the conceptual comparison is concerned, the GC set out that the contested mark's figurative and word element, considered jointly, convey a message that departs from the classical concept of bull (TORO) as an animal. For that reason, the signs are conceptually similar to an average degree, and not high as the BoA had concluded (para. 61). In general, the BoA was wrong to consider the signs similar overall (para. 63), as there is only a small degree of global similarity between them (para. 62). Under these circumstances, despite the high degree of similarity existing between the goods and services at issue, the relevant public will not get confused as to their commercial origin (para. 69). The GC allowed the appeal and annulled the contested decision (para. 70).

**Case T-386/15; Jordi Nogues S.L. v EUIPO; Judgment of 20 September 2017; EU:T:2017:632;**

**Language of the case:** ES

**RESULT:** Action upheld (BoA decision annulled)

**KEYWORDS:** Likelihood of confusion, Dissimilarity of signs, Dominant element, figurative element,

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### Coexistence of trade marks

**FACTS:** The applicant sought to register the figurative mark BADTORO represented below as an EUTM for goods and services in Classes 30, 32 and 35. An opposition was filed pursuant to Article 8(1) (b) EUTMR, based on the earlier figurative EUTM TORO (Classes 33 and 42), the earlier word EUTMs TORO (Classes 32, 33, 35 and 42) and the figurative Spanish mark TORO (Class 35). The OD partly upheld the opposition, on the grounds that a likelihood of confusion existed between the contested mark and the earlier figurative EUTM No 1 500 917 registered for goods and services in Class 32, 33 and 42 and the earlier word EUTM No 1 722 362 registered for services in Class 35. It rejected the opposition and allowed the registry of the mark as to the 'import and export services' designated by the contested mark in Class 35. The BoA dismissed the applicant's appeal. The applicant had brought a counterclaim before the EU trademark Court of Alicante to request the cancellation of some of the marks of the other part before the BoA and had requested the BoA to stay the proceedings waiting for the decision of the EU trademark court. The BoA rejected the claim on the ground that the EU Court had already dismissed the counterclaim for cancellation. Moreover it confirmed the existence of a likelihood of confusion as found by the OD. The applicant filed an action before the GC relying on two pleas in law: infringement of Rule 20(7)(c) of Regulation No 2868/95 (unlawfulness of the BoA's decision to deny the stay of proceedings) and infringement of Article 8(1)(b) EUTMR.

### EUTM application



### Earlier trade marks

TORO



**SUBSTANCE:** As regards the first plea of law, the GC emphasised that the EUTM court's decision rejecting the counterclaim for cancellation had been appealed before the Spanish court of appeal and, afterwards, before the Supreme Court (para. 25). The BoA based its decision on a judgment of first instance which actually was not final (para. 26). The Office and the intervener claimed that this error of fact did not affect the lawfulness of the contested decision, because the opposition was based on three other trade marks which were not included

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in the counterclaim for cancellation (para. 29). However, the GC underlined that the BoA, for procedural economy, based its decision exclusively on the earlier word EUTM No 1 722 362 registered for goods in Class 35, which was actually one of the marks object of the counterclaim (para. 30). As a consequence the contested decision is annulled as far as the goods applied for in Class 35 are concerned (para. 33). As regards the second plea, the GC emphasised that, contrary to the BoA's assessment, the term 'TORO' has a secondary position in the EUTM applied for (para. 59) and has not an autonomous and distinctive position within the contested mark (para. 62). On the other hand, the term 'TORO' was the dominant element of the earlier marks. In view of that, the GC considered that the visual similarity existing between the signs was very low (para. 70). As the animal drawn on the contested mark resembles more a pet or a cartoon than a real bull, the GC stated that this mark conveys a concept that is far away from the idea of a classic bull (para. 81). Therefore, the marks in conflict are conceptually similar only to an average degree (para. 83). Considering the differences existing between the marks, arising from the fanciful representation of the bull and the presence of the term 'BAD' on the contested mark, the GC concluded that the likelihood of confusion on the relevant public is to be excluded (para. 91). The GC upheld the action and annulled the contested decision in its entirety (para. 93).

**Case T-287/15; Tayto Group Ltd v EUIPO; Judgment of 28 June 2017;**

**Language of the case:** EN

**RESULT:** Action dismissed

**KEYWORDS:** Minimum degree of distinctiveness, Proof of use, Evidence of use, Extent of use, Declaration, Misuse of power, Lack of reasoning, Use not as registered

**FACTS:** The EUTM proprietor was granted the registration of the figurative mark represented below as an EUTM for goods and services in Classes 3, 8, 16, 18, 20, 21, 22, 24, 25, 28, 29, 30, 31 and 32. An application for revocation was filed pursuant to Article 51 EUTMR. The Cancellation Division (CD) upheld the application for revocation. The BoA partially upheld the EUTM proprietor's appeal. It found that the contested mark had been put to genuine use for part of the goods covered by it. The revocation applicant filed an action before the GC relying on six pleas in law, alleging, first, infringement of Article 15(1) EUTMR; second, infringement of Article 15(2) EUTMR; third, infringement of Articles 64 and 76 EUTMR; fourth, infringement of Article 51(1)(a) EUTMR; fifth, infringement of Article 75 EUTMR; and, sixth, a misuse of power and an infringement of general principles of law.

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EUTM



**SUBSTANCE:** First plea: In its review of the lawfulness of the contested decision, it is not for the GC itself to assess the distinctive character of the mark at issue, but to ensure that the BoA correctly assessed the effect of the additions to that mark (para. 27). The element 'quality', which is situated below the mark at issue, mainly under the element 'real', and which is written in capital letters that are smaller than the letters in the word element 'real' and is in blue, has a merely laudatory character and is weakly distinctive. The addition, in the mark used, of the stylisation in the form of a label, within which both the elements in the mark at issue and the element 'quality' are placed, is purely ornamental, since it is situated in the background of the mark at issue and is therefore in an ancillary position, which does not confer on it any distinctive character of its own (para. 34). Although it is true that a company name or a shop name is limited to identifying a company, it is quite possible that it may also constitute a trade mark, if it is used as such. The mark at issue had not been used solely as a company name (paras 41-42). Second plea: Since the EUTM proprietor has demonstrated to the requisite legal standard that there was use of the

mark at issue, therefore proving that that mark was used by a third party, it must be accepted that that mark was used with the EUTM proprietor's consent (para. 60). Third plea: The extent of use of the mark at issue had been confirmed by the overview of turnover figures, broken down in respect of the various goods during the relevant period, as well as by the affidavit. The argument that the BoA did not notice that some documents did not fall within the relevant period cannot succeed, since the appeal brought before it was upheld only in part, which again shows, to the requisite legal standard, that it carried out an appropriate assessment of the evidence in its possession (paras 66-68). Fifth plea: the reasoning may be implicit. The BoA did not have to take into account decisions of national authorities regarding lack of distinctiveness of 'REAL' (paras 70-75). Sixth plea: The applicant does not put forward any evidence showing that, by refusing to grant it an extension of the time limit, the BoA used its powers for a purpose other than that for which they were conferred on it. The extension of a period specified is not automatic: in each case, it depends on circumstances which are specific to the individual case and which make it appropriate to grant an extension, as well as on the submission of a request for an extension. That holds especially true in relation to inter partes proceedings, in which an advantage granted to one of the parties constitutes a disadvantage for the other. In such cases, the Office must therefore ensure that it remains impartial with regard to the parties. As regards the

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alleged infringement of general principles of law, it must be pointed out, first, that the applicant has not stated which ones it was relying on in particular and, second, that, at the hearing, it submitted that this was not necessary for the GC to be able to rule on that argument (paras 76-87).

**Case T-333/15; Josel, SL v EUIPO; Judgment of 28 June 2017;**

**Language of the case:** EN

**RESULT:** Action dismissed

**KEYWORDS:** Distinctive element, Company name, Used not as registered

**FACTS:** The applicant sought to register the word mark NN as an EUTM for services in Class 36. An opposition based on the Spanish earlier word mark NN, registered for services in Class 36, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition. The BoA dismissed the opponent's appeal. It found that proof of genuine use of the earlier mark had not been provided. The opponent filed an action before the GC relying on a single plea in law, alleging infringement of Article 15(1)(a) and Article 42(2) and (3). The GC dismissed the appeal. It found that the earlier trade mark had been used in a form which altered its distinctive character.

### Earlier mark

NN

### Earlier mark as used



**SUBSTANCE:** Even if reproduction of the word element 'nn', which forms the earlier mark, within the signs used in the evidence could, in principle, be sufficient to prove genuine use of the earlier mark in respect of the services in question, this is not the case if the modifications and additions in documents produced as evidence have an intrinsic distinctive character that alters the character of that mark and, as a consequence, means that the mark is no longer recognised as such within the signs used. Given that the earlier mark is a word mark, it is not distinguished by the use of a particular font. Concerning the word element 'núñez i navarro', the applicant's argument that the term 'núñez i navarro'

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referred to the name of the parent or holding company of the group of companies to which it belonged has no effect on the possible alteration. 'Núñez i navarro' is always placed below the circle containing the letters 'nn'. However, in the majority of the pieces of evidence presented it occupies a central position, especially when either the word element 'hotels' or the reference to an address is placed below it. The word element 'núñez i navarro', in terms of width, occupies a much more significant space than that of the word mark 'nn', having regard to the number of characters each contains. With regard to the fact that the surnames 'núñez' and 'navarro' appear in the marks used, the letters 'nn' are very likely to be perceived as constituting the initials of those surnames. As surnames, the words 'núñez' and 'navarro' are not generic terms and therefore have normal distinctive character. It is concluded that the addition of the word element 'núñez i navarro' to the earlier mark changes its distinctive character (paras 37-46).

**Case T-374/15; VM Vermögens-Management GmbH v EUIPO; Judgment of 7 September 2017; EU:T:2017:589;**

**Language of the case:** DE

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive element, Distinctive element

**FACTS:** The EUTM proprietor was granted the registration of the word mark Vermögensmanufaktur, literally translated 'asset manufacture', as an EUTM for the class headings in Classes 35 and 36. An application for invalidity was filed pursuant to Article 52(1)(a) in conjunction with Article 7(1)(b) and (c) EUTMR. The CD dismissed the application for invalidity. The BoA upheld the invalidity applicant's appeal and declared the EUTM invalid on account of its descriptive character and lack of distinctiveness. The EUTM proprietor filed an action before the GC relying on four pleas in law, namely an infringement of Article 75 EUTMR, Article 76 EUTMR, Article 7(1)(b) EUTMR and Article 7(1)(c) EUTMR. After filing the action, the EUTM proprietor declared under Article 28(8) EUTMR that its intention on the date of filing the EUTM had been to seek protection in respect of services beyond those covered by the literal meaning of the class headings of Classes 35 and 36. Accordingly, services from the alphabetical list were included in the EUTM's specification. With regard to these services from the alphabetical list, the EUTMR proprietor requested the GC, in the alternative, to declare that the EUTM's registration is partially maintained or to remit the case to this extent to the CD. The GC dismissed the appeal.

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EUTM

Vermögensmanufaktur



EUTMR made after the contested decision was adopted and, hence, not apt to challenge its legality (paras 149-151).

**Case T-609/15, Repsol YPF, SA / EUIPO — Basic AG Lebensmittelhandel (BASIC); Judgment of 21 September 2017; EU:T:2017:640;**

**Language of the case:** EN

**RESULT:** BoA Decision annulled

**KEYWORDS:** Substantiation of earlier right, Used in the course of trade, Declaration

**FACTS:** The CD declared the contested EUTM invalid on the ground laid down in Article 8(4) EUTMR as it found that the earlier trade and company names (i) had been used in trade of a more than local significance in Germany and (ii) entitle its owner to prohibit the use of the contested EUTM in accordance with Section 15(2) of the German Trade Mark Act due to the existence of a likelihood of confusion for the relevant German public. The BoA dismissed the Appeal. It found, in particular, that the invalidity applicant had established use of more than local significance of its earlier trade and company names in Germany (i) before the filing date of the contested EUTM (2007), (ii) at the date of filing the invalidity request (2011), and (iii) for the period between these relevant points in time

**SUBSTANCE:** The relevant circles consist of German speakers from the general public and from professional circles (paras 36-38). The German word 'Manufaktur' designates a workshop producing, partially by manual labour, specialised products of higher quality. It also referred, at the relevant time, to bespoke and high-quality services, e.g. in the word combination 'Finanzmanufaktur' and 'Kreditmanufaktur' (paras 40-52). Therefore, 'Vermögensmanufaktur' indicates a place where non-standardised services closely connected to assets and finances are prepared and rendered (paras 54-58). It describes, within the meaning of Article 7(1)(c) EUTMR, the class headings of Classes 35 and 36 apart from the services advertising; office functions, for which there is no sufficiently direct and specific relationship given their broad character (paras 60-75). The EUTM lacks distinctive character pursuant to Article 7(1)(b) EUTMR for all class headings, that is including advertising; office functions, on account of its promotional character promising the service's efficiency in respect of financial profits (paras 103-115). The EUTM's alternative requests with respect to services from the alphabetical list are inadmissible since they are based on the declaration under Article 28(8)

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(2007 to 2011). The documents submitted by the invalidity applicant analysed by the BoA to that effect consisted of (i) an affidavit with regard to the use throughout the entire period (pre-2007 to 2011), (ii) extensive supporting evidence regarding the period prior to 2007, (iii) and one screenshot of the invalidity applicant's website displaying information on the company and a map showing the location of its supermarkets in Germany and Austria (dated 2010 and 2011). The EUTM owner challenged the BoA's decision, inter alia, on the ground that the invalidity applicant had not established use in trade of a more than merely local significance as required by Article 8(4) EUTMR. The GC upheld the action for annulment on that ground and annulled the contested decision.



**SUBSTANCE:** The GC accepted that the documents actually analysed by the BoA (paras 50 and 66) showed use of the earlier signs to the requisite legal standard for the period prior to the date of filing of the contested EUTM (pre-2007, paras 51-59). However, the GC considered that these documents were insufficient for also showing use on the date of filing of the invalidity request (2011, paras 60-67). This would be so because the affidavit would — despite indications on the turnover made under



the signs made up until July 2009, December 2010 and July 2011 (para. 63) — be 'primarily intended to corroborate the [invalidity applicant's] use of the sign in the course of trade prior to 2007' (para. 62) and not be confirmed by further probative evidence (paras 64-65). The GC confirmed that the obligation to establish use under Article 8(4) EUTMR applies not only with regard to the filing date of the contested EUTM (29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 164-168) but with respect to the date on which the invalidity request is filed (23/10/2013, T-581/11, Baby Bambolina, EU:T:2013:553, § 27). In addition, the GC clarified (i) that the 'EU law standard' applies to the proof of continued existence of the earlier national right and (ii) that there is, in principle, no requirement to establish use between those two points in time (paras 48 to be read in conjunction with paras 42, 45 and 46).

**Case T-90/16; Thomas Murphy v EUIPO; Judgment of 4 July 2017;**

**Language of the case:** EN

**RESULT:** Action dismissed

**KEYWORDS:** Colours of design, Conflict of design with prior design, Disclaimer in representation of design, Freedom of designer, Individual character, Informed user, Overall impression

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**FACTS:** The RCD proprietor was granted the registration of the design represented below as an RCD for measuring instruments, apparatus and devices in Class 10.04 of the Locarno Agreement. An application for invalidity was filed pursuant to Article 6(1)(b) in conjunction with Article 25(1) (b) CDR. The Invalidation Division (ID) dismissed the application for invalidity. The BoA dismissed the invalidity applicant's appeal. The invalidity applicant filed an action before the GC relying on three pleas in law: By the first plea, he submits that the BoA failed to give him a fair hearing and infringed its obligation to state reasons by failing to take account of the explanations relating to the features of the prior design and by failing to answer the argument that the prior design had to enjoy a high degree of protection. By the second plea, the applicant submits that the BoA infringed its obligation to state reasons by failing to address the argument that the degree of freedom of the designer was very high. By the third plea, the applicant relies, in essence, on an infringement of Article 6(1)(b) of Regulation No 6/2002 on the ground that the BoA did not properly assess the overall impression produced by the designs at issue. The GC dismissed the action.

**SUBSTANCE:** The argument that the BoA endorsed, without adequate reasoning, the RCD holder's argument that the freedom of the designer was limited and failed to quantify the degree of freedom of the designer follows from a misreading of the contested decision. The question as to whether



### RCD



### Earlier design



that degree of freedom is very high goes to the substance of the contested decision. There was no infringement of the right to fair hearing and of the duty to state reasons (paras 13-31). The BoA correctly found that the degree of freedom of a designer of an electronic wristband was limited by the technical constraints which apply to those wristbands, namely the need to be ergonomic in order to fit the wrist and to contain measuring instruments. It also correctly took the view that, in order for a wristband to be able to fulfil its function properly, it had to be relatively small, thin and light and to fit easily around the wrist. The BoA correctly found that the degree of freedom of the designer

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was high, and not very high (paras 36-42). The GC rejects all the invalidity applicant's arguments regarding the similarity of the prior design and the contested RCD. The comparison of the overall impressions produced by the designs must relate solely to the elements actually protected. Some of the features of the prior design, claimed by the invalidity applicant in his explanations before the BoA, are not clear from the representations of that design. The fact that that button on the contested RCD served a functional purpose did not preclude it from being capable of being regarded as a differentiating factor in so far as that button could be placed on a wristband in different ways and could have different shapes and sizes. The prior design does not appear to be composed of transparent material, in contrast to the contested design. The BoA correctly assessed the prior design as if it was represented in black and white. Electronic wristbands must have a circular shape so as to fit the wrist; the common feature consisting in their circular shape will have only minor importance in the overall impression. The clasps are similar but are not a very important element of the designs. When using an electronic wristband, the informed user attaches more importance to the part of the wristband which displays the data than to the clasp of that wristband (paras 43-70). The invalidity applicant argues that the prior design enjoys a high degree of protection because it was, at the time of its registration, a significant advance in relation to the prior art. In support of that argument the invalidity applicant



relies on a judgment of the Court of Appeal (England and Wales). That argument cannot be accepted, as it does not follow from CDR that the advance on prior art of the prior design must be taken into account in the assessment of individual character of a later design, moreover the BoA is not bound by decisions of national authorities; finally the invalidity applicant did not prove that his design is a significant advance in relation to the prior art (paras 71 et seq.).

### **Joined Cases T-427/16 to T-429/16; Isabel Martín Osete v EUIPO; Judgment of 29 June 2017;**

**Language of the case:** EN

**RESULT:** Action dismissed

**KEYWORDS:** Proof of use, Evidence of use, Extent of use, Use not as registered

**FACTS:** The EUTM proprietor was granted the registrations of the word marks AN IDEAL WIFE, AN IDEAL LOVER and AN IDEAL HUSBAND as EUTMs for goods in Class 3. Three applications for revocation were filed pursuant to Article 51 EUTMR. The CD upheld the applications for revocation. The BoA dismissed the EUTM proprietor's appeal. It found that there was no genuine use of the EUTMs and that there were no proper reasons for non-use. The EUTM proprietor filed three actions before the GC relying on a single plea in law, alleging infringement

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of Article 51(1)(a) of Regulation No 207/2009. The GC dismissed the actions.

### EUTMs

AN IDEAL WIFE

AN IDEAL LOVER

AN IDEAL HUSBAND

**SUBSTANCE:** Genuine use: The EUTM proprietor has produced no invoice, no sales figures, no advertising figures and no data indicating the market share of the perfumery products marketed under the registered marks. The EUTM proprietor produced a table which she had compiled with a view to summarising the sales figures for the perfumes protected by the registered marks. For the period from 12 December 2006 to 12 March 2012, the EUTM proprietor sold perfumes under those three marks for a total amount of EUR 2 385 and GBP 3 733. The figures for the sales of the perfumes protected by the registered marks were particularly low, given that the price of each perfume was between 18 and 60 euros, and between 4 and 30 pounds. The smaller the commercial volume of the use of the mark, the more necessary it is for the proprietor of the mark to produce additional evidence to dispel any doubts as to the genuineness of that mark's use.



The sales which she claims to have made under the registered marks were made at a number of literary salons, in particular those organised by the Oscar Wilde Society in Paris, and at infrequent meetings with a small number of loyal customers. In addition, the advertising documents or correspondence with potential suppliers, which is not supported by any evidence such as invoices or purchase orders, also do not make it possible to find a high degree of intensity or consistency over time in the use of those marks and do not, therefore, make it possible to remove potential doubts as to the genuine use of the marks in question. The EUTM proprietor failed to prove genuine use. Proper reasons for non-use: The rules of IFRA and of the European Union apply to all operators in the perfumes sector and not just to the EUTM proprietor. Compliance with the applicable rules is inherent in any commercial activity and cannot, unless a particularly broad interpretation of the concept of 'proper reason for non-use' is to be adopted, justify the absence of genuine use during the relevant period. The problems associated with the manufacture of the products of an undertaking form part of the commercial difficulties encountered by that undertaking. The concept of proper reasons refers to circumstances unconnected with the trade mark proprietor rather than to circumstances associated with his commercial difficulties. The existence of complex regulations applicable in a certain field cannot be regarded as an obstacle which makes it impossible or unreasonable to use registered marks.

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**Case T-780/16; Mediaexpert sp. z o.o v EUIPO; Judgment of 20 July 2017;**

**Language of the case:** EN

**RESULT:** Action dismissed

**KEYWORDS:** Admissibility, Substantiation of earlier right, Translation of evidence, Legitimate expectations

**FACTS:** The applicant filed a declaration of invalidity based on the earlier Polish trade mark, invoked Article 53(1)(a) EUTMR in conjunction with Article 8(1) (b) EUTMR. In support of the declaration, it filed an extract from the Polish Patent Office database in Polish. In order to remedy relative admissibility deficiencies it also filed the list of relevant goods and services in English. The application for declaration of invalidity was rejected in its entirety as not substantiated. The BoA dismissed the appeal. The applicant filed an action before the GC relying on, in essence, two pleas in law, alleging first, infringement of Rule 37(b), Rule 38(1) and (2), Rule 39(2) and (3) and Rule 98(1) of EUTMR and, second, infringement of the principle of protection of legitimate expectations. By the first plea, the applicant claimed that (i) the Office had the knowledge of the scope of protection of the earlier Polish mark by means of the information contained in the application for a declaration of invalidity and by the translation of the list goods and services; (ii) the Office did not ask to



submit a full translation of the database extract. By the second plea, it complained that the Office gave the impression that the application for a declaration of invalidity was complete and that the Office guidelines had not been correctly applied. The GC dismissed the appeal.

EUTM

mediaexpert 

Earlier trade mark

mediaexpert 

**SUBSTANCE:** The first plea: The GC stressed a fundamental distinction between the admissibility conditions and the conditions concerning the production of the facts, evidence and arguments and of the documents in support of the application (para. 35). The list in English of the goods and services only supplemented the application for a declaration of invalidity for it to be admissible; the registration certificate for the earlier mark (the database extract), and a translation thereof constitute documents relating to the examination of the merits of an application. The CD was not obliged to ask the applicant to produce the complete translation of the database extract (para. 41). Contrary to what the applicant claimed, it could not

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be held that a translation of the data base had been validly produced. The mere indication of the list of goods and services in English could not constitute a complete and structured translation of the database extract within the meaning of Rule 98(1) EUTMIR (para. 47); the applicant failed explicitly to refer to the database extract and to reproduce its structure. The validity of the earlier mark cannot be merely inferred from the dates of filing as registration as the untranslated textual elements corresponding to them, namely, 'Decyzja o rejestracji — nadanie numeru rejestracji', leave open the question whether the earlier mark had been definitively registered. As the evidence filed contained different indications regarding the nature of the earlier mark, it was essential that the textual elements 'Rodzaj znaku towarowego', 'Słowno-graficzny' concerning the nature of the earlier mark were translated. The second plea: Precise assurances given by the Office were lacking. First, the letter inviting to remedy the admissibility deficiencies clearly stipulated that it merely concerned admissibility and it was possible that the documents or translations submitted would not be sufficient to substantiate the application. Second, the applicant could not be unaware of the obligation to produce translations of supporting evidence which has a clear legal basis in Rule 38(2) EUTMIR nor expect the Office to exempt a party from compliance with such requirement. The attempt to rely on the Guidelines is misconceived as the conditions governing the distinction between admissibility and substantiation are clearly explained in the Guidelines.



**Case T-432/16; Lackmann Fleisch- und Feinkostfabrik GmbH v EUIPO; Judgment of 19 July 2017; EU:T:2017:527;**

**Language of the case:** DE

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive element

**FACTS:** The applicant sought to register the figurative mark

Медведь

(the Russian word for 'bear') as an EUTM for goods in Classes 29, 30, 31 and 33. The examiner refused the registration of the EUTM application (EUTMA) pursuant to Article 7(1)(c) and (b) EUTMR for certain goods in Classes 29, 30 and 31 (mainly meat, meat products and meals ready for consumption). The BoA dismissed the applicant's subsequent appeal. The BoA found that the existence of absolute grounds for refusal had to be examined with regard to the Russian-speaking consumers in the European Union and that such an examination was not limited to the official languages of the Union. Further the BoA found that the mark applied for was descriptive for the goods at issue because it could be perceived as a direct and obvious reference to their kind and as a descriptive indication suggesting that these goods consist of, contain or imitate the taste of bear meat. The applicant filed an action before the GC

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relying on two pleas in law, namely infringement of Article 7(1)(c) and infringement of Article 7(1)(b) EUTMR. The GC dismissed the action.

### EUTM application

Медведь

**SUBSTANCE:** The GC confirmed, in line with its earlier case-law, the finding of the BoA that the existence of absolute grounds for refusal in relation to the relevant consumers cannot be limited to the official languages of the European Union and that in the particular case at hand the existence of absolute grounds for refusal has to be examined with regard to the Russian-speaking consumers in the European Union. A significant part of the EU citizens understand Russian, whereas a part of the residents in the Baltic States have a good command of this language which for part of them is even the mother tongue. The GC accepted (as a subsidiary argument) also the Office's submission that the Russian word 'Медведь' (bear) is known to a significant number of consumers that used to learn Russian as a foreign language and that, moreover, belongs to the Russian basic vocabulary and is well present in Russian culture, in particular in Russian folklore, art, literature and sports. Bearing in mind the meaning of the word, the GC agreed with the BoA that in relation to the concerned goods in Classes 29, 30 and 31, in particular meat and meat products and also meals ready for consumption, that could



contain meat, the word 'bear' will be understood as an indication that the contested goods consist of bear meat or at least imitate its taste. The latter perception not being prejudiced by the possible perception of the word with a different meaning as claimed by the applicant, namely as an association with a bear's power/size/greatness.

The GC rejected the applicant's arguments that the latter does not put bear meat on the market and that actually putting bear meat on the European Union market was prohibited by law as irrelevant and not true respectively. Finally, the GC addressed also the possible limitation of the specification of the goods as a way of overcoming the refusal of the application for certain goods as suggested by the applicant, namely by adding '... except bear meat'. The GC again confirmed the BoA's finding that such a limitation is unacceptable, since the use of the mark in relation to goods that do not consist of or contain bear meat can deceive the relevant consumer and would, therefore, be contrary to Article 7(1)(g) EUTMR.

**Case T-276/16; Viridis Pharmaceutical Ltd v EUIPO; Judgment of 15 September 2017; EU:T:2017:611;**

**Language of the case:** DE

**RESULT:** Action dismissed

**KEYWORDS:** Proof of use, Legitimate expectations

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**FACTS:** The EUTM proprietor was granted the registration of the word mark Boswelan as an EUTM for the goods pharmaceutical products and health-care products in Class 5. An application for revocation due to a lack of genuine use was filed pursuant to Article 51(1)(a) EUTMR. The CD upheld the application for revocation. The BoA dismissed the EUTM proprietor's appeal. It found in particular that the use of the EUTM in the context of conducting a clinical trial did not constitute an outward use directed at marketing or advertising a product on the pharmaceutical market. It cannot be qualified as a preparatory act for the subsequent marketing either given the point in time long before the actual marketing, the ongoing clinical trial phase and the lack of a request for marketing authorisation. Under these circumstances, conducting a clinical trial cannot be considered a proper reason for non-use for the EUTM proprietor being it's responsible, in particular as regards its required length. Only after submitting a request for the required marketing authorisation, this responsibility shifts to the public authorities. The EUTM proprietor filed an action before the GC relying on three pleas in law: infringement of Article 51(1)(a) EUTMR with respect to the lack of genuine use (i) and with respect to proper reasons for non-use (ii), and an infringement of its legitimate expectations arising from the Office's Guidelines under Article 83 EUTMR (iii). The GC dismissed the appeal.



### EUTM

## Boswelan

**SUBSTANCE:** The GC confirmed that under the circumstances of the present case, the use in the context of a clinical trial, including promotions in relation thereto, was insufficient to support a genuine use for which an external use to create or preserve an outlet for the goods is essential. Such use may only follow from the marketing authorisation and is, by contrast, excluded by pharmaceutical regulations prohibiting any prior advertisement for the purpose of gaining an outlet for the goods (paras 35-36). The EUTM proprietor did not establish that the marketing of the goods was imminent either (paras 37-38). Conducting a clinical trial may give rise to proper reasons for non-use. However, in the present case, the use of the EUTM was not legally required for the trial and the proprietor's choice despite the uncertainties if and when the pharmaceutical may be marketed. Furthermore, the length of trial depends on the proprietor's financial investment. Moreover, the authorisation to conduct the trial was requested more than three years after the EUTM's registration. These circumstances are not unconnected with the proprietor and hence do not justify the absence of genuine use (paras 54-63). The Office's Guidelines,

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according to which clinical trials are typical examples for proper reasons for non-use, do not amount to precise assurance that the proprietor's clinical trial qualifies as such. Therefore, the proprietor cannot rely on legitimate expectations (paras 67-70).

**Case T-315/16; Tamasu Butterfly Europa GmbH v EUIPO; Judgment of 19 September 2017; EU:T:2017:629;**

**Language of the case:** DE

**RESULT:** Action dismissed

**KEYWORDS:** Similarity of the goods and services, Reputation, Sign used in the course of trade, Trade name

**FACTS:** The intervener sought to register the word mark Butterfly as an EUTM for goods and services in Classes 28 and 41. An opposition based on the earlier word EUTM Butterfly, registered for goods and services in Classes 25 and 28 was filed pursuant to Article 8(1)(b) and 8(5) EUTMR. The opposition was also based on the trade name Butterfly, pursuant to Article 8(4) EUTMR. The OD dismissed the opposition and the applicant lodged an appeal. The BoA dismissed the appeal insofar as, first, neither the goods and services were similar nor identical; secondly, because the applicant had not proven the reputation of its earlier mark and, thirdly, because



it had not proven that the trade name had been used in the course of trade of more than mere local significance. The applicant filed an action before the GC relying on three pleas in law: infringement of Articles 8(1)(b), 8(5) and 8(4) EUMTR.

### EUTM application

Butterfly

### Earlier trade mark

Butterfly

**SUBSTANCE:** In light of the applicant's response to an interrogation, the GC established that the products to be taken into account were only those included in Class 28 (para. 16). The GC emphasised that the circumstance that some of the goods belong to the same class does not automatically mean that such products present similarities (para. 15). Nor the fact that a metal or plastic housing (goods covered by the contested mark) may be included into sport equipment (goods covered by the earlier mark) makes these two goods similar (para. 31). Consequently, the GC excluded the existence of a likelihood of confusion between the marks (para. 42). As far as the second plea is concerned, the GC noticed that, in the documents provided by the applicant, the earlier mark does not

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appear as it is, but in association with a figurative element (para. 54). On the other hand, many of the internet extracts showing the mark were aimed at a specialised public and not at the general public (para. 55). As a consequence, the GC upheld that the evidence is not sufficient to prove the reputation of the mark in Germany, in relation to sport equipment and other products in Class 28 (para. 63). As regards the documents that according to the applicant have not been taken duly into account by the BoA, the GC set out that, on the one hand, the BoA was not obliged to mention, into its reasoning, all the evidence presented by the parties (para. 70); and, on the other hand, that the documents making reference to the trade name are not suitable to prove the reputation of a mark, as the aim of a trade name is to designate an enterprise, and not its goods and services (para. 73). As regards the third plea, the GC rejected the applicant's argument according to which the requirements laid down in Article 8(4) EUTMR shall be interpreted in the light of German law (para. 79), insofar as the proceedings refer to the registration of a European Union trade mark and not a national mark (para. 80). Taking into account the documents related to the geographical and economic extent of the use of the trade name, it was not possible to conclude that the unregistered mark had been used in trade of more than local significance (para. 97). As a consequence of all the above, the GC upheld the BoA's decision in its entirety.



**Case T-789/16, InvoiceAuction B2B GmbH / EUIPO, Judgment of 21 September 2017; EU:T:2017:638;**

**Language of the case:** DE

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive, Figurative element

**FACTS:** The examiner rejected the contested EUTM applied for goods in Class 9 and services in Classes 35 and 36 on the grounds of Article 7(1)(c) and (b) EUTMR. The BoA dismissed the applicant's appeal. The GC dismissed the applicant's action for annulment.

### EUTM application



**SUBSTANCE:** The GC confirmed the Office's findings that the relevant English-speaking consumers in the European Union well versed in finance and business matters having an enhanced degree of attention (para. 33) will immediately perceive the mark applied for as a whole as reference to an 'invoice auction' and 'auctioning of invoices' and thus as an auction for invoices that are not yet due

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with reductions (percentages, or early payment discounts, paras 36-37). The percentage symbol (%) would be immediately associated with the clear meaning of the word elements and, in any event, be seen as a conventional mathematical symbol entirely customary in the relevant financial sector (paras 38, 44). The sign's immediately comprehensible meaning (para. 39) would be understood by the relevant specialist consumers as a description of the goods and services applied for (paras 40-43).

**Case T-327/16; Aldi Einkauf GmbH & Co. OHG v EUIPO; Judgment of 27 June 2017; EU:T:2017:439;**

**Language of the case:** EN

**RESULT:** Action dismissed

**KEYWORDS:** Deceptive element, Descriptive element, Distinctive element, Function of trade mark, Geographical origin, Laudatory mark, Slogan mark

**FACTS:** The EUTM proprietor was granted the registrations of the word mark ANTICO CASALE as an EUTM for goods and services in Classes 29, 30 and 35. The application for a declaration of invalidity was filed pursuant to Article 52(1)(a) EUTMR in conjunction with Article 7(1)(b), (c) and (g) EUTMR. The CD rejected the application for invalidity. The



BoA dismissed the EUTM proprietor's appeal. It found that the mark was not directly descriptive but merely allusive, not a mere laudatory statement about the quality of the goods and not deceptive. The EUTM proprietor filed an action before the GC relying on three pleas in law, alleging infringement of Article 52(1)(a) EUTMR in conjunction with Article 7(1)(b), (c) and (g) EUTMR.

EUTM

ANTICO CASALE

**SUBSTANCE:** Descriptiveness: Consumers do not imagine a specific origin when they encounter ANTICO CASALE, meaning 'old farmhouse' or 'old hamlet'. It does not directly describe a specific characteristic or the quality of the goods or services at issue but at best alludes to certain characteristics of the goods or services, which will vary depending on different consumers' personalities. The link between the meaning of a mark and the goods and services covered is not sufficiently direct and specific for Article 7(1)(c) EUTMR to apply. Distinctiveness: The applicant's argument that goods sold in an old farmhouse or services provided from an old farmhouse, had a 'considerable reputation' compared to industrial goods was not backed up by any evidence. In invalidity proceedings, as the registered EU trade mark is presumed to be valid,

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it is for the person who has filed the application for a declaration of invalidity to place before the Office the specific facts which call the validity of that trade mark into question. As for the assertion that the expression 'antico casale' will be perceived as a laudatory statement, given that it conveys a certain refinement or exclusivity, it is sufficient to note that the fact that a mark may have a laudatory connotation does not necessarily deprive it of a distinctive character Deceptiveness: It is settled case-law that, when a mark does not convey a sufficiently specific and clear message concerning the protected goods and services or their characteristics but, at the very most, hints at them, there can be no deception in relation to those goods and services.

**Case T-305/16; Lidl Stiftung & Co. KG v EUIPO; Judgment of 15 September 2017; EU:T:2017:607;**

**Language of the case:** EN

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive element, Distinctive element, Lack of reasoning, Slogan mark

**FACTS:** An application for invalidity was filed pursuant to Article 52(1)(a) EUTMR, in conjunction with Articles 7(1)(b) and (c) EUTMR. The CD dismissed the application for invalidity in its entirety. The applicant filed a notice of appeal against the



decision of the CD. The BoA dismissed the appeal. It found that the contested mark was not capable of describing the goods covered; therefore, the connection between the expression 'love to lounge' and the goods concerned was too indeterminate to constitute a ground for invalidity. Moreover, it found that the contested mark could not be regarded as being completely devoid of any distinctive character. The applicant filed an action before the GC relying on four pleas in law: (i) infringement of Article 76 EUTMR, (ii) infringement of Article 75 EUTMR, (iii) infringement of Article 7(1)(c) EUTMR and (iv) infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal.

### EUTM application

LOVE TO LOUNGE

**SUBSTANCE:** The GC found that, notwithstanding the 'doubtful' online search methodology used for some items of evidence, the BoA did not infringe its obligation to state reasons, since the evidence submitted did not prove that the contested mark was descriptive (paras 24-29). In addition, the GC pointed out that the contested mark is to be understood simply as a vague and evocative message which alludes to a particular interest or pleasure in relaxing and not as an easily recognisable property of the contested goods; therefore, the contested mark is not descriptive of the goods in question or

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of one of its characteristics (paras 49-56). As regards the assessment of distinctive character, when the contested mark is used in relation to the contested goods, namely clothing, footwear and headgear, the relevant public will have to place that mark in a certain context, which requires an intellectual effort. Consequently, the contested mark has inherent distinctive character due to a certain originality which consumers can recall and which enables them to identify the commercial origin of the contested goods (paras 93-95).

**Case T-86/16; Codorníu, S.A. v EUIPO; Judgment of 18 September 2017; EU:T:2017:627;**

**Language of the case:** ES

**RESULT:** Action upheld (BoA decision annulled)

**KEYWORDS:** Similarity of signs, Reputation, Lack of reasoning

**FACTS:** The applicant sought to register the figurative mark ANA DE ALTÚN represented below as an EUTM for goods in Class 33.

An opposition based on, inter alia, the earlier Spanish figurative mark ANNA represented below, registered for goods in Class 33 was filed pursuant to Articles 8(1)(b) and (5) EUTMR. The OD upheld the opposition in so far as it considered that there would be a likelihood of confusion.



The BoA upheld the applicant's appeal. It found that there would be no likelihood of confusion between the contested mark and the Spanish earlier trade mark ANNA, even for identical goods. It did not assess the alleged enhanced distinctiveness of the earlier trade mark as it considered the signs dissimilar. BoA did not assess Article 8(1)(b) EUTMR with regard to the other earlier rights ANNA DE CODORNIU as it considered that they were even less similar to the examined earlier right. Finally, it considered that there was no link between the signs for Article 8(5) EUTMR to apply.

The opponent filed an action before the GC relying on three pleas in law: (i) infringement of Article 75 and 76 EUTMR, (ii) infringement of Article 8(1)(b) EUTMR and, (iii) infringement of Article 8(5) EUTMR. The GC upheld the appeal. It found that the BoA methodology in assessing likelihood of confusion was based on the wrong premise that the signs were globally different. As a result, the BoA incorrectly considered that the evidence of enhanced distinctiveness and reputations did not need to be examined. Finally, the GC considers that the decision lacked reasoning regarding the absence of likelihood of confusion with regards to other earlier trade marks which BoA considered less similar to the earlier Spanish mark being assessed.

**SUBSTANCE:** SIMILARITY OF THE SIGNS: the GC agrees with BoA that the signs are visually and aurally lowly similar and that the contested EUTMA will be associated with a name and family name and to this extent, the surname 'DE ALTUN' does not

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### EUTM application



### Earlier trade mark



play a secondary role so the signs are conceptually different. However, it disagrees with BoA in that the conceptual differences will compensate the visual and aural similarities rendering the signs globally different. The concept in 'ANA DE ALTUN' is not sufficiently clear and precise for such compensation. The GC considers that the signs are similar to a certain extent (paras 49-62). LIKELIHOOD OF CONFUSION: the GC considers that the methodology followed by BoA in the likelihood of confusion assessment was based on the wrong premise that the signs were sufficiently dissimilar for the evidence of enhanced distinctiveness to be taken into account. Consequently, the second plea

in law is upheld (paras 70-73). REPUTATION: in line with the GC conclusions on the second plea, the GC considers that BoA incorrectly found that the signs were not similar for the consumers to establish an association and consequently, wrongly dismissed the application of Article 8(5) EUTMR (para. 79). LACK OF REASONING: the GC considers that the decision lacks reasoning regarding the absence of likelihood of confusion with regards to other earlier trade marks which BoA considered less similar to the earlier Spanish mark being assessed. According to the GC, the relevant public was not only the Spanish public with regards to some of the other earlier trade marks (paras 92-93).

**Case T-620/16; The Logistical Approach BV v EUIPO; Judgment of 21 September 2017; EU:T:2017:635;**

**Language of the case:** FR

**RESULT:** Action dismissed

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

**FACTS:** The applicant sought to register the figurative mark Idealogistic represented below as

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an EUTM for services in Class 39.

An opposition based on the earlier French word marks *idéa logistique* and *IDEA* registered for services in Class 39, was filed pursuant to Article 8(1) (b) EUTMR. The OD upheld the opposition on the basis of earlier French mark *IDEA*.

The BoA confirmed the existence of likelihood of confusion but on the basis of earlier French mark *idéa logistique* (without examining the opposition based on the mark *IDEA*). It dismissed the applicant's appeal.

The applicant filed an action before the GC relying on two pleas in law: (i) the BoA exceeded its powers and infringed Article 76 EUTMR by stating that 'logistics' is 'commercial transportation' whereas no evidence thereof was submitted by the parties and 'logistics' is normally defined as a planning and organisation method, (ii) infringement of Article 8(1) (b) EUTMR. The GC dismissed the appeal.

### EUTM application

**Idealogistic** 

### Earlier trade mark

**idéa logistique**

**SUBSTANCE:** ARTICLE 76 EUTMR: For the comparison of the services, the BoA relied on a definition of 'logistics' mentioned by the intervener before OD; this definition is also a well-known fact (paras 18-23). This plea is dismissed. ARTICLE 8(1) (b) EUTMR: The GC confirmed that the services of transport; packaging and storage of goods were aimed at the general public displaying an average degree of attention, and not high contrary to the applicant's claim (paras 32-34), as well as at a professional public having a high degree of attention (para. 36). The fact that the applicant claims to be specialised in highly secured transport of valuable goods and multimedia products is irrelevant since the specification of services as filed does not include such precisions (para. 35). As found by the BoA, Transport; packaging and storage of goods are identically specified in the contested trade mark application and in the earlier mark. The applicant's claim that they target a different public is dismissed (paras 39-43). Consultancy ('conseils') services are a type of information services (para. 46). The services of 'transportation information' covered by the earlier mark are identical with the contested consultancy in the field of logistics, including route selection, storage facilities and selection of means of transport (paras 44-53). There is nothing to prevent a determination as to whether there is any visual similarity between a word mark and a figurative mark, since the two types of mark have graphic form capable of creating a visual impression (para. 59). The marks are visually similar to an average degree

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(para. 61). The marks are phonetically identical. The space between the two words of the earlier mark has no incidence on the pronunciation (para. 65). The figurative element of the contested mark is devoid of any conceptual meaning. It is purely decorative (paras 72-73). Both marks refer to a 'logistic idea' ('une idée logistique') for the French public. 'Idea' is a basic English word (para. 77). The signs are conceptually identical (para. 81). The distinctiveness of the contested sign's figurative element is low (para. 89). There is a likelihood of confusion.

**Case T-454/16; Arrigoni Spa v EUIPO; Judgment of 22 September 2017; EU:T:2017:646;**

**Language of the case:** IT

**RESULT:** Action dismissed

**KEYWORDS:** Likelihood of confusion, Principle of legality

**FACTS:** The applicant sought to register an international registration designating the EU for goods in Class 29. An application for invalidity was filed pursuant to Article 158(2) EUTMR, in conjunction with Article 53(2)(a) and 8(1)(b) EUTMR. The CD dismissed the application for invalidity in its entirety. The CD informed the applicant that it wanted to revoke its first decision because of procedural mistakes pursuant to Article 80 EUTMR.



Therefore, the CD dismissed the application for invalidity partly. The BoA dismissed the appeal. The applicant filed an action before the GC. The GC dismissed the appeal.

### IR designating the EU



### Earlier trade mark

**ARRIGONI**

**SUBSTANCE:** The BoA stated that the evidence submitted by the applicant shows that the earlier mark has been used effectively for some of the goods in Class 29 such as tomato preserves, chickpeas, peas, corn, beans, preserved lentils, preserved tuna, marmalade, olive oil. According to the BoA, these goods are part of subcategories such as preserve food, jams, and oils for food. Therefore, the likelihood of confusion has to be assessed only with regard to these goods (para. 38). The GC found that the BoA was correct in assessing the likelihood of confusion only in relation to preserve food, jams, and oils for food in Class 29 (paras 42-44).

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Furthermore, contrary to the applicant's reasoning, the GC stated that the BoA never questioned the registration of the earlier mark in regard to all the goods in Class 29 (para. 49). According to the GC, it is necessary to reject the entire applicant's arguments based on the Italian case-law and Italian law because the Office and the GC are not bound by them (para. 52). To conclude, according to the GC, the appeal has to be rejected.

**Case T-139/16; Sports Division SR, SA (SDSR). v EUIPO; Judgment 6 October 2017; EU:T:2017:705;**

**Language of the case:** EN

**RESULT:** Action dismissed

**KEYWORDS:** Likelihood of confusion, Similarity of the signs, Visual similarity, Phonetic similarity, Conceptual similarity, Identity of the goods and services, Similarity of the goods and services, Coexistence of trade marks, Reputation

**FACTS:** The applicant filed an application for an international registration designating the EU for the figurative mark represented below in respect of the goods in Classes 18, 22 and 25. An opposition based inter alia on two earlier EU trade marks represented below registered for goods in Classes 20, 22 and Classes 9, 14, 18, 21, 25 respectively. The ground invoked was that of Article 8(1)(b) EUTMR. The



OD upheld the opposition and refused the mark in respect of all the goods applied for. The BoA dismissed the applicant's appeal. It endorsed the findings of the OD concerning the identity and similarity between the goods and the similarity between marks and found that there was a likelihood of confusion. The applicant filed an action before the GC relying on a single plea in law, i.e. violation of Article 8(1)(b) EUTMR. The GC dismissed the appeal.

### EUTM application



### Earlier trade mark

BERGHAUS

**SUBSTANCE:** Although the GC acknowledged that the applicant did not submit its arguments regarding the coexistence of the marks and the reputation of the mark applied for in a coherent manner, differently from what was argued by the Office, these arguments were found to be admissible (para. 27). However, they were dismissed by GC as unfounded (paras 30, 32). The GC endorsed the finding that the goods of the conflicting trade marks are partly identical and partly similar (para. 40) and that for the purpose of comparing the marks it should be the

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general public in the European Union who show an average level of attention that should be taken into account (para. 39). As to the signs, it was concluded that BoA correctly assessed their dominant and distinctive elements (para. 52). Moreover, GC also confirmed that there was a certain visual similarity between the signs at issue, that they displayed an average degree of phonetic similarity and that there was a certain conceptual similarity for the part of the public capable of understanding the meaning of the common element 'berg' (para. 56). Therefore, it was concluded that BoA was right to find a likelihood of confusion within the meaning of Article 8(1)(b) EUTMR (para. 73).

**Case T-755/16; Alessandro La Rocca v EUIPO; Judgment of 26 September 2017; EU:T:2017:663;**

**Language of the case:** IT

**RESULT:** Action dismissed

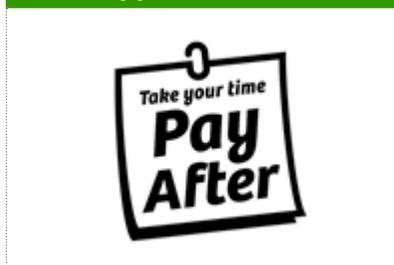
**KEYWORDS:** Minimum degree of distinctiveness, Lack of reasoning, Nature of goods and services

**FACTS:** The applicant sought to register the figurative mark TAKE YOUR TIME PAY AFTER represented below as an EUTM for goods and services in Class 36. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b) and 7(2) EUTMR, as the mark was found to be devoid



of distinctive character. The BoA dismissed the applicant's appeal. It found that the sign was a banal expression deprived of distinctive elements. The applicant filed an action before the GC, pursuant to two pleas in law: infringement of Articles 7(1)(b) and 75 EUMTR.

### EUTM application



**SUBSTANCE:** The GC emphasised that the English speaking consumer will understand the expression 'TAKE YOUR TIME' as a suggestion not to be hasty and the expression 'PAY AFTER' as an indication that it is possible to pay something later (para. 27). The sign will be understood as a purely promotional message (para. 28) and the graphical elements do not suffice to provide it with a distinctive character (para. 29). The first plea based on the infringement of Article 7(1)(b) EUMTR is rejected (para. 33). As regards the second plea, the BoA had considered the designated services homogenous, due to belonging to the general category of financial, monetary, insurance, real estate affair services (para. 44). Considering such an homogenous nature,

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the general reasoning given by the BoA and related to all the services as a whole was in compliance with the duty to state reasons (para. 45). As regards the services that, according to the applicant, do not share the same nature as the others, the GC stated that these are remunerated services and that also in relation to these services the relevant public will understand the sign just as a promotional and exhortative message (para. 46). The GC rejected also the second plea of law (para. 48).

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EUIPO decisions, judgments of the General Court, the Court of Justice and the National Courts can be found on [eSearch Case Law](#). For best results, the use of Mozilla Firefox or Google Chrome browsers is recommended.

31/07/2017, R 619/2016-5, DEVICE OF A NEON TUBE (fig.)

#### EUTMA



**Result:** Decision confirmed.

**Keywords:** Distinctive element, Shape of the products, Technical result, Three-dimensional mark.

**Norms:** Article 7(1)(b) EUTMR, Article 7(1)(e)(ii) EUTMR.

**Facts:** The Office's examiner rejected the EUTMA



claiming that the feature of the spiral-shaped indentation along the tube does not give distinctive character (Article 7(1)(b) EUTMR) to the mark.

Substance: The Board finds that the mark in question does not differ sufficiently from similar tube-shaped elements available on the market. The long, thin tube shape of the component, the materials used (primarily white glass) and the mode of the connections can be observed in all products designed for a similar purpose because it can also be associated with the operation of the product. Nothing out of the ordinary can be observed on the connection piece either. Not even the groove running in a spiral along the tube changes the appearance of the long, thin tube profile to the extent of transforming it into a form substantially different from sector norms or customs and hence making it capable of fulfilling its essential function of indicating origin as a trade mark (§ 19). The examiner was therefore correct to refuse the application for the goods in Classes 10 and 11 under Article 7(1)(b) EUTMR (§ 23).

As regards Article 7(1)(e)(ii) EUTMR, the Board finds that the spiral curved line can serve technical purposes, namely improving the stability of the glass tube, less exposed to breakage, and it may also serve to disperse the light better (§ 27-28).

Accordingly, the appeal is dismissed.

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13/09/2017, R 2161/2016-4, CAPOL (fig.) / COPAL



**Result:** Appeal inadmissible/Opposition rejected.

**Keywords:** Admissibility.

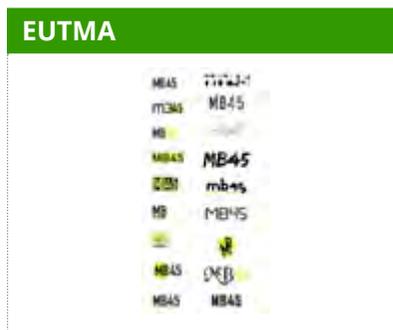
**Norms:** Rule 48 CTMIR, Rule 49 CTMIR, Article 60 EUTMR.

**Facts:** The Opposition Division partially rejected the opposition against the EUTM applied for, namely for part of goods and services in Classes 1, 4 and 35, which were found identical and similar to the earlier goods and services.

**Substance:** Pursuant to Article 60 EUTMR, first sentence, EUTMR and Rule 48(1)(c) CTMIR, the notice of appeal must contain a statement identifying the extent to which amendment or cancellation of the decision is requested. In the notice of appeal, the opponent indicated that the decision is contested

‘in part’, thereby however merely specifying that it concerned ‘some of goods and services (Classes 4 and 35)’ (§ 12-15). Such ‘specification’ does not clearly indicate the extent to which the decision is contested. The deficiency was not remedied within the time-limit and even the statement of grounds states that only ‘some’ of the goods and services found dissimilar are challenged, without specifying which of them (§ 16-18). The extent of appeal should be clear and not open to interpretation, and since the opponent failed to remedy the deficiency to identify the extent to which amendment or cancellation of the decision is requested within the statutory time-limit, the appeal does not comply with Article 60 EUTMR (§ 24).

05/9/2017, R 177/2017-5, MB45 (fig.) / MB45 et al.



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**Result:** Decision confirmed.

**Keywords:** Bad faith, Figurative trade mark, Non-registered trade mark, Personal name mark, Ration legis, Scope of proceedings.

**Norms:** Article 8(4) EUTMR, Article 52(1)(b) EUTMR, Article 53(1)(c) EUTMR, Article 53(2) EUTMR, Article 53(2)(a) EUTMR.

**Facts:** The Cancellation Division rejected the request for a declaration of invalidity because it did not find the evidence sufficient to prove either bad faith or that the earlier non-registered trade marks were used in the course of trade of more than mere local significance. It was also established that 'MB45' is a well-known sign in the field of sports – according to the applicant, 'MB45' is composed of the initials and jersey number of Italian footballer Mario Balotelli – does not qualify as a name under Article 53(2)(a) EUTMR.

**Substance:** As regards bad faith, the cancellation applicant argues that the Cancellation Division erred in that it did not make a 'holistic' assessment of the evidence and arguments presented before it. However, rather than identifying those alleged deficiencies and their consequences, the cancellation applicant reiterates the statements already presented. Based on the evidence submitted

and for the extensive and thorough reasons already stated by the Cancellation Division, it has not been demonstrated that the EUTM proprietor actually was or even should have been aware of such usage, nor that the use of the contested mark would be capable of inducing any confusion with regard to the right claimed by the cancellation applicant (§ 28). Insofar as the cancellation applicant invoked a right to a name under national law, the Board found that the nickname 'MB45' does not meet the condition of a personal name under Italian law and the applicant did not demonstrate that this nickname is well-known nor that it came into existence before the contested mark's filing date (§ 44-48).

As for the application of Article 8(4) EUTMR, the applicant failed to demonstrate that the sign was used in the course of trade or that it was of more than a local significance (§ 56-59).

Consequently, given the nature and scarcity of evidence showing use of the indication 'MB45' by the cancellation applicant prior to the date of application for the contested mark, the appeal is dismissed (§ 60).

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06/09/2017, R 1890/2016-1, MOM GOD SAVE THE GIN Royal Smoothness (3D) / MOMA et al.

### EUTMA



**Result:** Proceedings terminated.

**Keywords:** Admissibility, Three dimensional mark, Statement of grounds.

**Norms:** Article 60 EUTMR, Rule 49(1) CTMIR.

**Facts:** An appeal was filed against the decision rejecting the opposition filed against the above EUTMA. The Registry of the Boards of Appeal acknowledged receipt of the notice of appeal and reminded the applicant that a written statement of grounds (SOG) should be filed within the set time limit. According to the Registry, the SOG was not received within the said deadline, therefore the appeal is inadmissible.

**Substance:** The applicant replied to the deficiency letter stating that the statements of grounds had been sent to the Office by courier but that the filing receipt was not available. The applicant claimed

that the SOG must have arrived at the Office since they have the filing receipt regarding proof of use of other proceedings included in the same shipment (§ 9).

The Board found that, had the SOG been sent to the Office in a separate dispatch, with its own shipment label with acknowledgment of receipt, the applicant could (and ought to) have requested the courier company to provide it with the specific receipt signed by the corresponding EUIPO service for its reception, or, at least, with the courier company's confirmation that the shipment was indeed delivered, and details of the delivery (date, time, address and the name of the person who signed for receipt) (§ 17).

Moreover, the explanation and evidence provided by the applicant are unclear, unsubstantiated and unable to prove the prompt filing of the SOG in this appeal (§ 19).

Nothing proves that the SOG of the present appeal was indeed included in the 'same shipment' as other dispatches addressed to the EUIPO on that day (§ 25).

The applicant cannot attempt to reverse the burden of proof on the Office, by vaguely claiming that it 'knows' that the SOG must have reached the Office (§ 29).

Since the applicant failed to prove that it submitted a SOG of the appeal within the non-extendable time limit of four months, the appeal does not comply with Article 60 EUTMR. It is, therefore, inadmissible pursuant to Rule 49(1) CTMIR (§ 35-36).

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05/9/2017, R 660/2017-5, PULSAR / PULSAR et al.

**Result:** Proceedings terminated.

Keywords:

**Norms:** Article 50 EUTMR, Article 50(1) EUTMR, Article 50(2) EUTMR, Article 50(3) EUTMR.

**Facts and substance:** During the course of the cancellation proceedings the EUTM proprietor sent a communication to the Office stating that 'we wish to give up the case and will refrain from using PULSAR'. The Cancellation applicant requested that 'the trademark PULSAR of the proprietor / IR holder Rhinometrics A/S will be deleted' (§ 6). The Operations Department of the Office sent a notification of deficiency regarding the application to register a declaration of total surrender (missing EUTM registration no. and the name and/or address or ID number of the proprietor) (§ 9). The recordal application was rejected as the EUTM proprietor failed to supply the requested information within the deadline. The Cancellation Division rejected the request for declaration of invalidity in its entirety (§ 10-11). The EUTM proprietor again sent a request to 'consider this a cancellation of the trademark PULSAR owned by Rhinometricss A/S-- Reg. number: 013631346' (§ 12). The cancellation applicant filed an appeal and its statement of grounds against the contested decision, requesting that the decision be entirely set aside (§ 13). The Office sent a notification of deficiency to the EUTM proprietor informing it that the request for total surrender had been suspended because the EUTM

is subject to cancellation proceedings and that the suspension will last until the proceedings are closed or until a final decision is taken (§ 14). After the EUTM proprietor sent an authorisation of employee representative, the application for total surrender of the contested sign was recorded (§ 16-17). The Board considered that, as a result of the combined communications submitted by the EUTM proprietor, the Office has before it a request for the complete surrender of the contested sign which complies with Article 50 EUTMR, cf. Rule 36(1) CTMIR, it is therefore for the Office to take the necessary steps to comply with it (§ 21). As a result of the valid request for the complete surrender of the contested sign, the proceedings at hand have become devoid of purpose and shall be closed.

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