

Alicante News

Up to date information on IP and EUIPO-related matters

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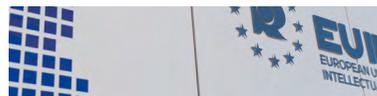


**The countdown is on
Second phase Legislative Reform
1 October 2017**



Amanda Michaels talks to James Nurton

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The countdown is on

The publication of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, codifying Council Regulation (EC) 207/2009 (EUTMR), in the [Official Journal](#) of the European Union was yet another milestone in the next wave of changes brought about the legislative reform process.

Regulation (EU) 2017/1001 repeals Regulation (EC) 207/2009, and will apply from 1 October 2017. Secondary legislation adopted on 18 May 2017 in the form of two separate acts, a [Delegated Regulation \(EUTMDR\)](#) and an [Implementing Regulation \(EUTMIR\)](#) will also apply from 1 October 2017.

The wave of changes that apply from 1 October 2017 mark the culmination of a process that started in 2008 when the European Commission committed to an evaluation of the functioning of the trade mark system in the European Union. Like the changes that came into force on 23 March 2016, they give effect to the ambition of the legislator to build on the success of the EU trade mark system by making it more efficient and consistent overall, and by adapting it to the internet era.

The abolition of the graphical representation requirement is one such change. Pursuant to Article 4 of the EUTMR, an EUTM is no longer required to be represented graphically as long

as it is represented in a manner that enables the competent authorities to determine the subject matter of protection with clarity and precision.

Article 3 of the EUTMIR takes account of this by providing that EUTMs may be represented in any appropriate form using generally available technology. As a consequence, certain types of trade marks that can be represented in electronic format only (e.g. multimedia marks) are now acceptable.

The same article also affirms that the precise subject matter of the exclusive right conferred by the registration is defined by the representation of the mark. The representation may be complemented by an indication of the type of mark concerned or, where appropriate, by a description that accords with the representation but that may not extend the scope of that representation.

The result is a 'what you see is what you get' system, which aspires to make the trade mark entries on the EUTM Register clearer, more accessible and easier to search for. Clearly, publication using conventional means is not viable for marks that are represented in electronic format only. In order to address this, a link to the publicly available electronic file on EUIPO's Register will be recognised as a valid form of representation for the purposes of publication and for issuing registration certificates.

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A summarised version of some of the other main changes that apply from 1 October 2017 is provided here, but users are reminded that this is not an exhaustive list. Please note that the Office's Guidelines will reflect these changes. The Guidelines should be the main point of reference for users of the European Union trade mark system and professional advisers who want to make sure that they have the latest information on EUIPO's examination practices.

Certification marks

Starting on 1 October 2017, the EUTMR introduces a new kind of EUTM, certification marks. These marks exist in some national systems where they are used to indicate that goods or services comply with the certification requirements of a certifying institution or organisation. The owner of an EU certification mark may be a public body or a private entity, as such, EU certification marks cover both public and private certification schemes. The basic fee for a certification mark is EUR 1 800 — (by electronic means, EUR 1 500).

Specific rules for types of marks

Article 3 EUTMR lays down specific rules and requirements for the representation of 10 of the most popular types of trade mark, including some



technical requirements, in accordance with the trade mark's specific nature and attributes. The objective is to increase legal certainty for users and reduce the objections' rate for formalities' objections.

Priority

Priority claims must be filed together with the EUTM application (before, such claims could be made subsequent to filing the application). The documentation in support of the claim must be filed within three months of the filing date (previously within three months from receipt of the declaration of priority). If the latter documentation is not in a language of the Office, it is now optional for the Office to request a translation of such documentation.

A further change in the practice of the Office is that the priority claim is no longer examined in substance. It remains as a 'mere' claim until it is relied upon and it is necessary to validate it in proceedings.

Acquired distinctiveness as a subsidiary claim

Applicants will have the possibility of invoking Article 7(3) as a subsidiary or alternative claim, either at the start of the application process or later. The advantage to of a subsidiary claim is that it only crystallises if there is a negative final

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decision on inherent distinctiveness. This allows the applicant to exhaust its right of appeal on inherent distinctiveness before it is required to prove acquired distinctiveness. This will mean that users do not need to incur the expense of gathering and presenting evidence of use unless it is necessary.

Opposition/cancellation proceedings

The requirements of admissibility and substantiation for relative grounds' actions have been reordered for clarity and to take into account the separate ground on geographical indications introduced by Article 8(6) EUTMR. Provisions applicable to cancellation proceedings are aligned with opposition proceedings except where differences are justified by their different nature. The EUTMDR introduces framework rules on belated evidence and codifies Office practice on suspension of surrenders and the closure/continuation of pending revocation or invalidity proceedings.

Online substantiation

A clear example of adapting to the internet era is where evidence that concerns earlier rights that are 'registered' (e.g. registered trade marks, certain signs used in the course of trade or geographical indications), or the contents of relevant national law, is accessible from an online source recognised by the Office, the opponent or cancellation applicant may provide such evidence by making reference to

that source.

For this purpose, the Office 'recognises' all of the databases of the national and regional EU IP offices, and [TMview](#) is acceptable as a portal through which the national offices may be 'accessed'.

Languages and translation

The requirements for translation have been simplified. Most types of evidence can be filed in any official language of the EU. Where the language used is not the language of the proceedings, a translation will now be required only where requested by the Office (of its own motion or upon reasoned request of the other party).

However, evidence of substantiation (certificates of filing, registration and renewal or provisions of relevant law) must still be submitted in the language of the proceedings (or translated into this language) within the time limit set for substantiation.

Furthermore, the 'standard of translation' is less onerous than previously to the extent that, where a party has indicated that only parts of the document are relevant, the translation may be limited to those parts.

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Communication with the Office

The means of communication by and with the Office have been changed to take account of developments in information technology. In particular:

- Obsolete forms of communication have been removed, namely, hand delivery and deposit in a post box at the Office;
- 'Electronic means' is defined broadly so that it now covers fax and potentially many other types of media. The Executive Director shall determine to what extent and under which technical conditions those media may be used;
- Specific mention of 'tele copier and other technical means' of communication – which covers faxes – is removed from secondary legislation (but see the previous point on 'electronic means');
- 'Courier' has been introduced specifically as a means of communication by and with the Office alongside communications by post.

Structure and presentation of evidence

Articles 55 EUTMDR (which mirrors the General Court rules) introduces formal requirements on the structure and format of evidence attached to submissions and requires that such evidence must be clearly identified and referenced. If parties fail to do this, the Office may invite them to remedy such deficiencies. Non-compliance could result in



evidence, or part of it, being set aside.

Boards of Appeal

The EUTMDR consolidates provisions relating to the Boards of Appeal that were previously spread across various sources including Commission Regulation (EC) No 216/96 (Rules of Procedure of the Boards of Appeal). The principal clarifications and changes relate to the content of the statement of grounds and of the response, 'cross appeals', claims raised and facts or evidence filed for the first time before the Board of Appeal, new absolute grounds raised by the Board of Appeal, expedited proceedings and the organisation and structure of the Boards of Appeal.

Over the coming months, the Office will be organising information sessions and webinars aimed at its users in the context of the changes. Full details will be made available on our website and through our social media channels.

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The James Nurton Interview



Interview: Amanda Michaels, Hogarth Chambers, London

How did you become interested in IP?

I think I have probably wanted to be a barrister since I was quite young, even when I knew next to nothing about it.

I did a law degree at Durham University. As part of my degree I studied European law and my professor encouraged me to do a postgraduate course in European law, which I did at the College of Europe in Bruges with the benefit of a Belgian State Scholarship. There were further scholarships available and the College was about to offer a Master's programme, so I had the opportunity to



Amanda Michaels

stay in Belgium and write a Master's thesis. I was interested in competition law and thought the most fascinating aspect of it at that time was trade marks, so I wrote my thesis on trade mark law. I also did a "stage" in the European Commission for six months, before returning to the UK and starting at the Bar, hoping to specialise in IP law.

I've always been in these Chambers and when I started we did a mixture of Chancery and IP work. The IP work included a lot of copyright because the authors of the leading copyright textbook "Copinger and Skone James on Copyright" were all members of Chambers. We've had two mergers since then, which have both boosted the IP work in chambers, especially in terms of hard IP and trade marks.

When did you become an Appointed Person, and why?

I became an Appointed Person in 2007. There were only four of us at the time, although the panel has now expanded due largely to the increase in oppositions since the UK IPO stopped doing relative grounds examination. We are essentially an appeal tier from the Registry. If there's a decision from the UK IPO, you can choose either to appeal to the High Court as an ordinary High Court case, and then potentially to the Court of Appeal, or to go before the Appointed Person.

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The James Nurton Interview



All the Appointed Persons are trade mark specialists, and we endeavour to deal with cases rapidly and cheaply. Costs awards are usually in the low thousands of pounds, which is much lower than in the High Court. The huge majority of UK IPO trade mark appeals come before the Appointed Person. In the year ending 31st March 2017, for example, there were 57 appeals, of which 52 came to the Appointed Person, with just five going to the High Court. The Office was wholly upheld in 81% of Appointed Person cases, and partly upheld in others. Similarly, four out of the five High Court appeals failed.

I think people find the Appointed Person an attractive tribunal: trade mark attorneys and litigants in person find it more approachable than the High Court and like the limited cost risk. Hearings are nearly always set down for a half-day or two hours so they are fairly short. You are concentrating solely on the alleged errors in the Hearing Officer's decision, as appeals are a review of the decision below, not a rehearing.

Many of the cases settle. I might do six or seven a year that are actually contested. For each of these, reading-in might take anything from an hour to a day, and then I generally reserve judgment. I often spend quite a lot of time writing the judgment. I think part of the reason people choose the Appointed Person is that we are the final instance of appeal, subject only to a judicial review, so I feel it's important to write a full judgment so that the

winning and losing parties know why they've won and lost. People do also rely on Appointed Person decisions as precedents.

Quite a lot of the cases turn on the facts, and many appeals are purely speculative, but some raise interesting points. If there's a substantial point of law, we can send the appeal to the High Court, and that happens sometimes.

What are your other judicial roles?

I am a Deputy High Court Judge and Recorder. The system in the UK is very dependent on part-time judges, unlike many other jurisdictions; most UK courts have part-timers (either solicitors or barristers) who sit as a judge there on a temporary basis. I had to pass a selection process involving an exam, interviews and role plays before I was appointed as a Recorder, which meant I could sit at the County Court level. The UK view is: if you've done litigation for many years, it's very good training for being a judge, and the overwhelming majority of deputy judges are very experienced litigators. There is also ongoing judicial training after you're appointed.

After I was appointed as a Recorder, I heard a wide range of civil cases and also started sitting in the Patents County Court hearing only IP cases. When that Court was replaced by the Intellectual Property Enterprise Court (IPEC) and became part of the

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High Court, there was a competition for Deputy Enterprise Judges (Deputy High Court Judges who sit in IPEC), so I now sit as a deputy in the IPEC.

IPEC has become incredibly busy, partly thanks to the new rules and for SMEs in particular the attraction too of the IPEC's restricted costs regime. There are numerous trade mark and passing off cases in IPEC, as well as other cases like design right, copyright and confidential information cases, all of which I'm very happy to do. It's fascinating to work on a variety of cases.

Most weeks, most of my time is spent being a barrister. But the workload is never balanced so you have to work flexibly when you need to in order to get it done.

Does it help your advocacy?

Absolutely it does. I find it fascinating seeing things from the other side of the bench and it's improved my advocacy enormously.

It's brought home to me that as an advocate you can (should) help the judge to see the merits of your client's case by presenting it in a way that makes it palatable and accessible. For example, it's very easy to produce a skeleton argument that is incredibly dense before explaining what the case is all about. I now ask myself: how would I as a judge get into this? Another important lesson is to have manageable

and realistic reading lists. Once you know the case, you can whizz through the pre-reading, but as a judge you're coming to it fresh and you need guidance and signposts about what is important and what the real issues are. In IPEC the parties have to identify the real issues at the case management stage, and that can be really helpful to the judge. But I don't think I would want to be a full-time judge.

I enjoy having my independence at the Bar and the variety of work I do; it's a nice balance to do both advocacy and judging. I enjoy resolving disputes – I also do mediation – and I think I get the best of both worlds. Both aspects on their good days are really good.

Would it be useful for all advocates to have that experience?

It probably would be, but I don't think everyone is cut out for it. It requires different skills and I find that writing a judgment is totally different to writing a legal opinion. You always do your best to get the right answer: if it turns on the oral evidence, and you have to decide whether you believe someone or not, sometimes that is very difficult.

In some cases you know what your decision will be by the end of the trial. But in the IPEC, cases are very concentrated into a short trial, so it's common to be referred to documents and authorities but not taken through them in court. You obviously have to suspend judgment until you've had time to read and consider everything. In that sense having a short hearing makes the judgment writing longer.

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The James Nurton Interview



How do you think trade mark law has developed?

There have been so many interesting developments since European harmonisation. I think the biggest change, which I had not anticipated, relates to the extended protection for marks with a reputation. It's a much broader protection than we had under the old law or than most people expected and it's had an enormous impact on trade mark litigation. There's barely a claim where you don't say "this is a mark with a reputation", because it's not a very high hurdle – then you've got a much broader base for the complaint. I think people thought initially this protection would only be available for very dominant marks, but it's much broader than that.

Another area that's been galloping along is everything to do with the internet. In 2004 we had the Reed case, which was the first significant case that involved thinking about the internet, keywords and search engine optimisation. We were starting from scratch and since then we've had lots of cases about advertising, jurisdiction, liability – all fascinating stuff. And we have the recent case law on functions of a trade mark. When I wrote my dissertation, years ago, functions of trade marks were seen as important. That faded away with the Directive but has since come back again.

Now we have Brexit and nobody knows how things will develop in the long term. I expect we will retain

much in the short term but will we have a new UK Trade Mark Act at some point? Will we align ourselves with the rest of Europe? I don't know, any more than anyone else does.

What's been the most interesting case you've worked on?

The Reed case was fascinating, partly because it kept changing as it went along. I was for the defendant in that case, and we lost at first instance but won on appeal. It addressed infringement on the internet – it didn't start off as an internet case but morphed into one as the other aspects fell away. I was led by Martin Howe QC who really understood the technology, and we had a very good expert too. The LTJ Diffusion decision also came out from the CJEU during the litigation, and that was very important in addressing the difference between "identical" and "similar" marks.

The most fun case I've worked on probably involved the rights to the film "Life of Brian". I've acted for the Monty Python production company in a number of cases, and that often involved delving into the background to the making and funding of the films. That was very interesting and an insight into quite another world.

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The James Nurton Interview



Is there anything you think could be improved?

One of the ways procedural things have changed is that a huge proportion of IP cases used to be resolved by interim injunctions. There are far fewer now, which may be down to costs. I think that is a pity, and I can think of IP cases in which parties could have saved themselves a lot of trouble in the long run by getting an interim injunction.

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

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European Union Trade Mark



Update on declarations under Article 28(8) EUTMR

A brief recap:

Last year the Legal Reform brought clarification to the scope of protection of a trade mark containing the entire class heading of a specific class by stating, in Article 28(5) EUTMR that protection is restricted to the literal meaning of the specific terms and not to alphabetical list or any other additional terms as had been the former practice in some jurisdictions.

In the transitory period between 23rd March and 24th September 2016, owners of EU trade marks filed before 22 June 2012 for an entire class heading had the possibility of filing a declaration under Article 28(8) EUTMR, adjusting the specification of their marks to their original intention when they filed them.

The interest of the public in using this opportunity has been fairly high with almost 25,000 declarations received. However, the amount of requirements to comply with the eligibility criteria and the extent of the exercise has shown, for many users, to be complex and, at times, rather difficult.

The Office has received a significant number of declarations not complying with the basic requirements stipulated in the Article 28(8) EUTMR, where a deficiency cannot be overcome. The

main causes of such deficiencies are the lack of a complete class heading in a particular class, either by omission of some of the general indications, or by a limitation narrowing the scope of protection, and declarations for goods or services not contained in the alphabetical list of the Nice classification edition in question.

How it works:

Apart from matching the filing date of the EUTM with the correct Nice edition, making sure the class headings are complete according to the Nice edition in force at the time of filing the EUTM, and complying with the requirements of filing date (before 22nd June 2012) and registration date (before 23rd March 2016), the additional goods or services users wished to declare needed to be limited only to alphabetical list terminology of the corresponding Nice classification edition that go beyond the literal meaning of the class heading.

The Office has provided guidance and published a number of informative materials on the matter, including a Frequently Asked Questions document and an extensive list of acceptable terminology for each applicable Nice edition, in all classes, in the five languages of the Office. This list has been prepared by the Office after a thorough analysis of the entire alphabetical list terminology of the Nice classification with the aim of facilitating the exercise for the users to the maximum extent possible.

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Although published as non-exhaustive, the list is considered to include most of the terminology acceptable for the purposes of a declaration under Article 28(8) EUTMR.

Declarations claiming goods or services included in the alphabetical list of the correct Nice edition – but not included in the list of the acceptable examples published by the Office – are examined each on their own merits.

Current state of play

The Office is now working to enter the declarations in the register as quickly as possible and has already examined over 67% of the declarations received. Of these, 27% have been registered. The corresponding deficiency letters have been issued for those with objections.

Users are reminded to carefully read and understand any deficiencies received. In particular, if the deficiency concerns a term that the Office considers is clearly covered by the literal meaning, such term cannot be accepted as it does not comply with the requirements of Article 28(8) EUTMR.

It should be emphasized that the purpose of Article 28(8) EUTMR is not to extend trade mark protection to additional goods or services. It is aimed at users who could have a real interest in protecting goods or services not included in the literal meaning

of the class heading, and who would need to take into account the limitations and obligations involved in specifying any “new” terms (for example, the limitations of Article 28(9) EUTMR, and the applicability of Article 42(2) EUTMR to those terms).

Declarations take effect from the day they are entered in the register.

As regards parallel proceedings, there are cases where EUTMs invoked as earlier marks in opposition proceedings are subject to a declaration under Article 28(8) EUTMR. Where the declaration under Article 28(8) EUTMR is considered, on the face of it, likely to be relevant to the outcome of the opposition, the opposition proceedings will be suspended until the declaration is entered in the register.

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Registered Community Design



The Wayback machine and the disclosure of designs on internet

In the framework of the European Cooperation Programme, the issues arising from disclosures of earlier designs on internet have been identified as one of the possible topics for a future convergence project. Considering this, this article will focus on one of the tools used to prove disclosure of designs on internet: the Wayback Machine.

The Wayback Machine is a non-profit digital archive which allows web users to find archived versions of websites. On typing the full web address (URL), this online library will show when, at what time and how many times a website has been saved. For example, a copy of the EUIPO website, <https://euipo.europa.eu/>, was archived three times on 4 April, 2016 at different hours and it was saved 50 times between 21 March, 2016 and 25 April, 2017.

Most of the data are collected by Alexa Internet, a company, known as a web crawler, which browses the web in order to identify, analyse and classify websites based on the traffic data provided by users¹. This data is then donated to the archive between 6-12 months after it has been collected. As a result, there is usually a time lag between when data from a site is gathered and when it appears in the Wayback Machine².

There are no guarantees, however, that every website can be found in the archive. In particular, web pages protected with passwords are not saved and some websites can decline internet archive inclusion by using specific software, such as Robots.txt Query Exclusion, which prevents web crawlers from collecting data. Furthermore, some content in the archived web pages may disappear because IP owners, who are concerned about IP infringements, can request to have it removed³.

Furthermore, the Wayback Machine's abilities are limited when collecting dynamic pages that are not created with the standard HTML programming language, such as images and JavaScript content. According to the Wayback Machine's website, the digital library works properly if a dynamic page has been created with html language whereas if it contains forms, such as JavaScript, or other elements that require interaction with the originating host, it may have some issues in the archiving process because of the lack of the original site's functionality. Therefore, some dynamic pages might be easily stored while others fall apart completely⁴.

Importantly, with respect to the disclosure of earlier designs, the dates of images saved in the digital library may raise some issues⁵. In particular, the date indicated by each archived web page is related to the HTML file but not to when the images are embedded in the html file as external files. For that reason, images that appear on the printed page

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may not have been archived on the same date as the HTML file⁶. Consequently, in order to find out when a particular image was archived it is necessary to check its specific URL⁷. In any case, sometimes the date of the image may not appear, for instance when an image is not archived.

In recent times, the archived web pages have been used in the form of printouts as part of evidence subject to the overall assessment in designs proceedings before the EUIPO, to prove the disclosure of designs on internet. Nonetheless, their use has raised an important question: to what extent can internet materials from the digital archive be considered as a valuable piece of proof, taking into account that this digital tool shows some limitations, especially in regard to the dates of images.

As the Office's Guidelines state that in principle, the date of disclosure on internet will be considered reliable in particular where information relating to the updates of a web page is available from an internet archiving service such as the 'Wayback Machine'⁸. However, it is important to stress that the evidence of disclosure is subject to an overall assessment, in view of the facts, evidence and arguments provided by the parties (Article 63 CDR). Whilst the Wayback Machine is a valid source of evidence it may not in all cases constitute sufficient prove and must thus be corroborated with additional evidence⁹.

Apart from the very date of publication, as a distinct issue, disclosure within the meaning of Article 7 CDR also depends on additional factors for which a printout from the Wayback

Machine may not suffice. In particular, a simple printout of the Wayback Machine does not show the context in which the publication was made and therefore does not permit any statements to be made as to whether it could have become known to the relevant public in the normal course of business¹⁰.

As a result, even if the archived web page is accepted as proof, the design holder may contest the veracity of the indicated date and for proving disclosure it often has to be supported by other evidence.

To conclude, the Wayback Machine can be considered a useful tool for the purpose of establishing the disclosure of designs on internet. The Office, in principle, accepts archived web pages as evidence with the corroboration of other proof. As a consequence, in designs proceedings, the parties can provide materials obtained from the Wayback machine website. However, the veracity of the copies of the Wayback Machine can be challenged by the parties due to uncertainty regarding content accuracy and the date of images.

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1. <https://support.alexa.com/hc/en-us/articles/200450254-Why-is-Alexa-crawling-my-site->
2. http://web.archive.bibalex.org/web/policies/faq.html#ba_privacy
3. http://web.archive.bibalex.org/web/policies/faq.html#ba_privacy
4. http://web.archive.bibalex.org/web/policies/faq.html#ba_privacy
5. See also 'PCT guidelines for the processing international patent applications' <http://www.wipo.int/export/sites/www/pct/en/texts/pdf/ispe.pdf> and 'International Internet Preservation consortium' <http://netpreserve.org/resources/member-archives>
6. <https://archive.org/legal/faq.php>
7. <https://archive.org/legal/faq.php>
8. Guidelines, Examination of Design Invalidity Applications, (decision of 02/07/2015, R 25/2014-3, — Soft Drink Bottle, § 29)
9. Decision of 20/12/2016, R 1850/2015/3, — Doors, § 31; decision of 20/12/2016, R 1852/2015-3, — Doors, § 24; decision of 20/12/2016, R 1849/2015-3, § 24; decision of 02/07/2015, R 25/2014-3, — Soft Drink Bottle, § 29.
10. Decision of 02/07/2015, R 25/2014-3, — Soft Drink Bottle, § 29.

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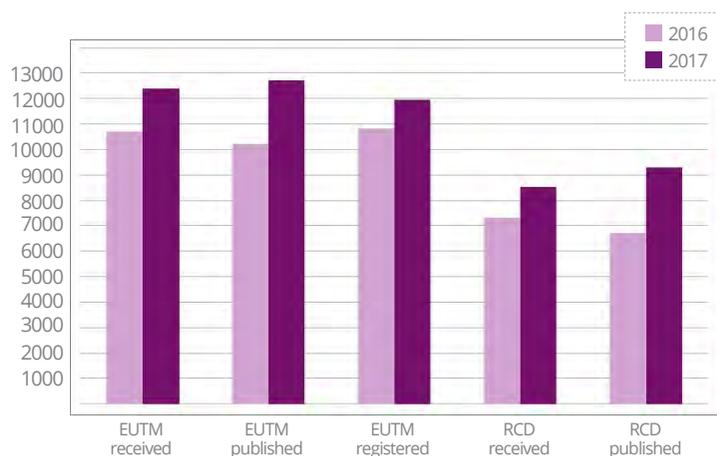


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Monthly statistical highlights May*	2016	2017
European Union Trade Mark applications received	10 717	12 375
European Union Trade Mark applications published	10 207	12 721
European Union Trade Mark registered (certificates issued)	10 825	11 947
Registered Community Designs received	7 334	8 538
Registered Community Designs published	6 730	9 296

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



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Colombia joins TMview

As of 19 June 2017, The Colombian Superintendence of Industry and Commerce (SIC) has made its trade mark data available to the TMview search tool.

This latest extension brings the total number of offices participating in TMview to 58, and with the addition of almost 700,000 trade marks from Colombia TMview now provides information and access to more than 43.8 million trade marks in total.

Since the introduction of TMview on 13 April 2010 the tool has served almost 31.3 million searches from 157 different countries, with visitors from Spain, Germany and Italy among the most frequent users.

Bosnia and Herzegovina joins Designview

As of 12 June 2017, the Institute for Intellectual Property of Bosnia and Herzegovina (IIP-BIH) has made its industrial design data available to the Designview search tool.

With IIP-BIH on board, Designview now contains data from 55 offices. With the addition of more than 700 designs from IIP-BIH, Designview now provides information and access to almost 10.4 million designs in total.

Designview is now available in 35 languages.

Since the introduction of Designview on 19 November 2012, the tool has served more than 2,6 million searches from 146 different countries, with Germany, Spain and the UK among the most frequent users.

You can find out more at www.tmdn.org

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Codified version of EU trade mark regulation published

Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, codifying Council Regulation (EC) 207/2009, has been published in the [Official Journal](#) of the European Union.

Regulation (EU) 2017/1001 repeals Regulation (EC) 207/2009, and will apply from 1 October 2017.

2016 case-law overview: from the General Court and Court of Justice

The Legal Practice Service of EUIPO has prepared an [overview of case-law](#) from the General Court (GC) and Court of Justice (CJ) in Luxembourg on trade mark and design matters.

This useful legal resource is published for information purposes, and includes abstracts of judgments, preliminary rulings and important orders rendered by the GC and CJ in 2016.

The information is arranged in categories for easy browsing.

Users can find more detailed information in the eSearch Case Law, our search tool for decisions of the Office, GC and CJ judgments and from the national courts.

Annual Report 2016 published

[The Annual Report of the EUIPO for 2016](#) has been published following its approval by the Management Board of the Office.

The 2016 Annual Report provides an overview of the Office's activities in year of progress and transition, in which the Office finalised its first Strategic Plan and embarked upon its new vision for the following years under the Strategic Plan 2020.

The Annual Report is available in English. The German, French, Italian and Spanish versions will be published shortly.

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

Case C-655/15 P; Panrico, S.A. v EUIPO; Judgment of 2 March 2017; Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Reputation, Unfair advantage, Phonetic similarity, Distinctive element

FACTS: An application for invalidity was filed pursuant to current Article 53(1)(a) in conjunction with Article 8(1)(b) and Article 8(5) EUTMR against the EUTM represented below, which was registered for goods in Class 30 and services in Class 42. The application for invalidity was based on the Spanish word marks **DOGHNUTS** and **DONUT** (both registered for products in Class 30), the Spanish figurative marks represented below **DONUTS** and **DONUTS CREAM** (both registered for products in Class 30) and the international word mark **DONUT** (which covers products in Classes 30 and 31). The Cancellation Division (CD) rejected the application for invalidity in its entirety. The Board of Appeal (BoA) dismissed the invalidity applicant's appeal. It found that the mark **DONUTS CREAM** had expired and that the genuine use of the mark **DOGHNUTS** had not been proven. Concerning the remaining

earlier marks, the BoA ruled out the likelihood of confusion (LOC) and concluded that the contested mark would not take unfair advantage of the distinctive character or the repute of the earlier word marks. The invalidity applicant filed an action before the General Court (GC) relying on two pleas in law: infringement of current Article 53(1)(a) EUTMR in relation to Article 8(1)(b) EUTMR and in relation to Article 8(5) EUTMR. The GC dismissed the action. It found that there was only a remote aural similarity between the signs and concluded that there was no LOC even if the earlier marks had an enhanced distinctiveness, and that such remote similarity was insufficient for the consumers to establish a link between the signs, regardless of the high reputation of the earlier marks and the similarity or even identity between the goods and services involved. The invalidity applicant filed an action before the Court of Justice of the European Union (CJ). The CJ dismissed the appeal.

SUBSTANCE: The invalidity applicant argued that the BoA should have taken into account in its assessment of the similarity of the signs the enhanced distinctiveness that the element 'DOUGHNUTS' has because of the reputation of the earlier marks. The CJ found it inadmissible since it had been alleged for the first time before the CJ (paras 44-47). The CJ dismissed the first plea after clarifying that, contrary to the invalidity applicant's understanding, the GC had taken into account the enhanced protection enjoyed by the reputed trade

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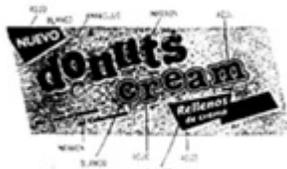


EUTM application



Earlier trade marks

DOGHNUTS
DONUT



marks and that the validity of the earlier marks had never been questioned by the GC (paras 48-54). The CJ dismissed the second and third pleas as partially inadmissible, namely the parts that implied a request for a new factual assessment (paras 68-69 and 87-89), and partially unfounded. Regarding the second plea, the CJ clarified that, contrary to

the invalidity applicant's allegation, the GC had taken into account the fact that the goods involved belonged to the same class and that the GC's statements were sufficient to comply with the duty to state reasons (paras 72-74). The CJ denied the GC incurred in any contradiction, since the fact that a restaurant service is defined not only by the kind of product that is offered but also by the conditions under which this service is rendered, does not imply that, when the goods offered in a specific kind of restaurant are identical to those covered by the earlier marks, there is necessarily at least an average degree of similarity between those goods and that restaurant service (para. 77). Regarding the third plea, the CJ pointed out that the GC's reasoning supporting the conclusion that the aural similarity of the marks was too remote to allow the public to establish a link between them was included purely for the sake of completeness and, therefore, the invalidity applicant's allegation in this regard were nugatory (paras 90-92).

Case C-421/15 P; Yoshida Metal Industry Co. Ltd. v EUIPO; Judgment of 11 May 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Functional element, Technical result, Distinctive element

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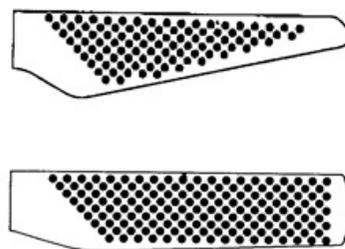
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FACTS: The applicant for registration/appellant before the Court of Justice of the European Union (CJ) obtained registration for the figurative marks represented below as an EUTM for goods and services in Classes 8 and 21. The interveners applied for the annulment of the marks pursuant to Article 51(1)(a) EUTMR on the ground that they had been registered in breach of Article 7(1)(e)(ii) EUTMR. The Cancellation Division (CD) rejected the applications for the declaration of invalidity. The interveners filed a notice of appeal against the decisions of the CD. On the basis of Article 7(1)(e)(ii) EUTMR, the Board of Appeal (BoA) upheld the appeals and annulled the CD's decisions. The BoA concluded that the black dots representing dents performed the technical function of obtaining a non-skid effect. The applicant for registration filed an action before the General Court (GC) and claimed in particular that the subject matter of the trade marks at issue had been incorrectly assessed. The GC annulled the decisions at issue, considering in particular that no account could be taken of the proof of current use of the signs at issue given that 'only the shape as reproduced in the registration application may be the subject-matter of the examination of the trade mark'. Both the Office and the interveners appealed the decisions before the CJ, alleging infringement of Article 7(1)(e)(ii) EUTMR. The CJ upheld the appeals, annulled the decisions and referred the cases back to the GC. The CJ found that when determining the essential characteristics of a sign, account could be taken of the actual use

made of the trade mark following its registration (C-337/12 P, para. 61). On remittal, the GC rejected the single plea raised by the appellant/applicant for registration and, consequently, dismissed its actions in their entirety (T-331/10 RENV & T-416/10 RENV). The appellant/applicant for registration brought a new appeal before the CJ putting forward two grounds of appeal, specifically infringement of Article 7(1)(e)(ii) and infringement of Article 51(3) EUTMR.

EUTM application



SUBSTANCE: The CJ emphasised that the appellant did not present any element capable to support its argument that the GC distorted the facts and evidence in not reaching the conclusion that the specific configuration of the array of black dots had a sufficiently significant ornamental character for them to be considered an essential non-functional element (para. 24). The CJ also underlined that, as regards the condition that registration of a shape

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of goods as a trade mark may be refused under Article 7(1)(e)(ii) EUTMR only if the shape is 'necessary' to obtain a technical result, that condition does not mean that the shape at issue must be the only one capable of obtaining that result (para. 28). What is important for the CJ is to identify the essential characteristics of the sign and afterwards ascertain whether they all perform the technical function of the goods at issue (para. 29). In any case, contrary to what the appellant claimed, the fact that the sign had ornamental and fanciful aspects did not preclude the ground for refusal under Article 7(1)(e)(ii) EUTMR from applying 'in so far as those aspects do not play an important role in the shape of goods at issue' (para. 30). Accordingly, the GC was right to conclude that Article 7(1)(e)(ii) EUTMR applied where all the essential characteristics of the sign performed a technical function (para. 31). As far as the distinctiveness of the signs was concerned, the CJ underlined that Article 7(1)(e)(ii) EUTMR constituted an obstacle to registration of a sign consisting exclusively of the shape of goods necessary to obtain a technical result, even though that sign was distinctive and capable of performing the essential function of a trade mark, that of guaranteeing the identity of the origin of the goods or services in question (para. 35). The CJ dismissed the second plea in law, based on a violation of Article 51(3) EUTMR in that the BoA and the GC would have failed to apply Article 7(1)(e)(ii) EUTMR in respect of each individual product. The CJ noted that this plea (which concerned an essential procedural

requirement) was new and therefore inadmissible (para. 46). According to all the foregoing, the appeal was dismissed in its entirety (para. 48).

Case C-471/16 P; August Storck KG v EUIPO; Judgment of 4 May 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Distinctive element, Figurative trade mark

FACTS: An application for an IR designating the European Union (EU) was filed for the figurative trade mark represented below for goods in Class 30. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b) EUTMR. The Board of Appeal (BoA) dismissed the appeal and confirmed the examiner's decision. The applicant filed an action before the General Court (GC). The GC dismissed the action. It upheld the BoA's conclusion that the mark applied for did not differ significantly from the usual shape of the goods concerned and therefore could not fulfil its function of identifying the origin of the goods. The applicant filed an appeal before the Court of Justice of the European Union (CJ) on the basis of two grounds, each alleging infringement of Article 7(1)(b) EUTMR.

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EUTM application



SUBSTANCE: The CJ dismissed the appeal in its entirety. First, the CJ pointed out that the case-law relating to three-dimensional trade marks' consisting of the appearance of the products itself also applies where, as in the present case, the mark applied for is a figurative trade mark, consisting of the two-dimensional representation of products. Therefore, the GC did not err in law in applying the principle that only a mark that departs significantly from the standard or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character (paras 35-38). Second, the presence of a graphic element on the figurative mark was not sufficient in itself to exclude the application of that case-law. In this sense, the different colours are commonplace and will be perceived by the relevant public as presentational elements. The interpretation that the figurative element in question represents a snow-covered mountain and a blue sky is not



obvious for the relevant consumer — that it is well known that such a pattern and a blue sky appear frequently on the packaging of products such as the goods concerned and the addition of images affixed to the mark applied for and the grey edges of the packaging were not such as to confer a distinctive character on that mark. Consequently, the GC was right in finding that the mark applied for was devoid of any distinctive character (paras 39-43). The CJ also dismissed the alleged error of assessment in relation to the distinctive character of the graphic representation affixed to the mark applied for and the level of attention of the relevant public, since both were appraisals of facts that did not constitute points of law open to review by the CJ on appeal (paras 44-52).

Case C-71/16 P; Comercializadora Eloro, S.A. v EUIPO + Zumex Group, S.A.; Order of 4 May 2017; Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Complementary evidence, Evidence of use, Proof of use

FACTS: The applicant sought to register the figurative mark represented below as an EUTM for goods in Class 32. An opposition based on the

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earlier mark represented below, registered for products in the same class, was filed pursuant to Article 8(1) EUTMR. The applicant requested the opponent to prove genuine use of the earlier mark. The Opposition Division (OD) estimated as proven the genuine use of the earlier mark and upheld the opposition in its entirety. The applicant filed an appeal before the Board of Appeal (BoA). The BoA, after inviting the opponent to clarify, in particular, whether the products mentioned in the invoices were actually put into circulation in the territory of the European Union, and after considering that the new documents to prove use of the earlier mark were submitted too late, found that genuine use had not been proven. Consequently, the BoA upheld the appeal and annulled the decision of the OD. The opponent filed an action before the General Court (GC) relying on two pleas in law: (i) infringement of Article 42(2) EUTMR, and (ii) infringement of Article 8(1)(b) EUTMR. The GC dismissed the first plea and consequently the second one and the action in its entirety. The opponent filed an action before the Court of Justice of the European Union (CJ). The CJ dismissed the appeal.



EUTM application

zūmex

Earlier trade mark

JUMEX

SUBSTANCE: The CJ dismissed all the grounds. The opponent alleged, as a first ground, that the GC had based its decision on the probative value of a document that should not have been taken into account and that the GC infringed its duty to state reasons in relation to the probative value of that document. The CJ pointed out that any reference to that document was made purely for the sake of completeness (paras 34-39), which was also the reason to dismiss the second ground (paras 48-49). The CJ also found that the GC's implicit dismissal of the arguments concerning its probative value was according to the jurisprudence (paras 41-43). Concerning the third ground, the CJ confirmed that the GC did not err in law when it determined that the BoA had correctly applied Article 76(2) EUTMR (paras 61-67). The CJ pointed out that there was no jurisprudence requiring an 'enhanced motivation' to justify the decision of not taking into account belated evidence (para. 60).

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B : **General Court: Orders and Judgments on Appeals against Decisions of the EUIPO**

Case T-568/15; Giuseppe Morgese, Pasquale Morgese, Felice D'Onofrio v EUIPO; Judgment of 15 February 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Similarity of the goods and services, Similarity of the signs, Likelihood of confusion (LOC), Weak element, Weak trade mark

FACTS: The applicant sought to register the figurative mark represented below as an EUTM for goods in Classes 9, 18 and 25. An opposition based on the earlier figurative marks, represented below, registered for goods and services in Classes 18, 25 and 35, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition on the basis of Article 8(1)(b) EUTMR and rejected the EUTM application in its entirety.

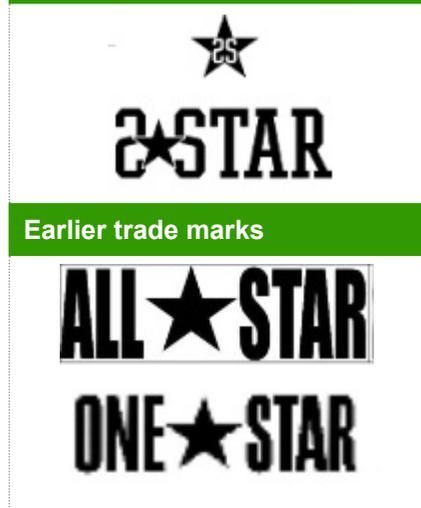
The Board of Appeal (BoA) dismissed the applicant's appeal. It found that the goods in Classes 18 and 25 were identical and that there was a certain degree of similarity between the goods in Class 9 and the opponent's services in Class 35. Further on the BoA found that, as regards the very similar structure of the signs at issue and the degree of visual, phonetic and conceptual similarity between them, there was a LOC between the signs for the purpose of



Article 8(1)(b) EUTMR.

The applicant filed an action before the General Court (GC) relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal.

EUTM application



SUBSTANCE: The GC put particular emphasis on the similarity of goods and retail services of those goods (paras 38-46).

Further on, the GC found an above-average degree of visual similarity between the signs at issue, due to the same overall structure of the signs consisting, in essence, of three elements. The GC noted that the position and design of the star-shaped device were identical in all three marks and this formed,

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in conjunction with the word 'star', an element that was common to all the signs at issue. This common structure was not altered by the impression created by the additional element placed on the top of the contested sign (para. 54).

The GC further explained that it could not rule out automatically that the signs were similar if they coincided in weakly distinctive elements. Within the signs at issue, the 'star' device took up a large part of the signs, contributed strongly to the overall structure of all of those signs and was therefore in a highly visible position. Therefore, it could not be perceived as being of secondary importance (paras 58-61). Accordingly, the GC found an average degree of phonetic and conceptual similarity between the marks (paras 69 and 75). It established that the common element 'star', owing to its position in the sign or its size, determined, to a large extent, the overall impression created by the signs at issue (paras 71-74).

Case T-504/15; Raffhaelo Gutti,, S.L. v EUIPO; Judgment of 8 March 2017; Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Relevant public, Similarity of the signs, Likelihood of confusion (LOC)



FACTS: The applicant sought to register the figurative mark represented below as an EUTM for goods in Class 25. The Board of Appeal (BoA) confirmed the decision of first instance and refused the EUTM application upon opposition based on the earlier Spanish figurative mark represented below. The goods were identical and the BoA found that the relevant public in Spain would have an average degree of attention. The verbal element of the contested mark CAMISERIA LA ESPAÑOLA indicates the geographical origin and the kind of goods and is, therefore, not distinctive. The coincidences in the similar figurative element, which is distinctive and the identity of the goods, were sufficient to conclude that there was a LOC in this case. The applicant filed an action before the General Court (GC) claiming an infringement of Article 8(1)(b) EUTMR.

EUTM application



Earlier trade mark



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SUBSTANCE: The GC confirmed the decision of the BoA and concluded the LOC in the meaning of Article 8(1)(b) EUTMR, Relevant Public: The GC confirmed that it consisted of the Spanish general public with an average level of attention (para. 24). The limited distinctiveness of the verbal element, 'CAMISERIA LA ESPAÑOLA', was also confirmed by the GC (para. 26). The marks were visually similar to an average degree (para. 49) and conceptually similar (para. 57). Moreover, the signs could not be compared from an aural perspective (para. 39). This was due to the figurative elements of the marks, which comprise two crossed flags with very similar features (paras 43-46). The differences between these elements are likely to go unnoticed by consumers (para. 47) and the limited distinctiveness of the verbal element does not introduce a relevant difference. The GC acknowledged that the visual perspective was particularly relevant with regard to goods in Class 25 (para. 60). Therefore, the GC concluded that, given the average degree of similarity between the signs and the identity between the goods, there was a LOC between the trade marks in question (para. 64).

Case T-132/15; IR v EUIPO; Judgment of 14 March 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Admissibility, Clarity of party submission, Evidence of use, Licence agreement, Proof of use, Representative, Revocation grounds, Right to be heard

FACTS: The EUTM proprietor was granted the registration of the word mark POPCHRONO as an EUTM for goods and services in Class 12. An application for revocation was filed pursuant to Article 51 EUTMR. The Cancellation Division (CD) upheld the application for revocation. The Board of Appeal (BoA) dismissed the EUTM proprietor's appeal. It found that the EUTM proprietor did not prove genuine use of the contested EUTM.

EUTM

popchronos

SUBSTANCE: The General Court (GC) first rejected the Office's plea of inadmissibility of the action for lack of clarity (paras 13-25). Then it confirmed that it was not competent to issue confirmatory judgments (paras 26-28), that the late evidence filed by the EUTM proprietor was inadmissible (paras 29-31) and the new plea in law and offer of further evidence was

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also inadmissible (paras 32-43). The GC dismissed in a standard way the applicant's plea related to the right to be heard (paras 46-67). The evidence of use consisted in offerings of licence agreements to use the contested mark, which could not be considered genuine use, even if it was the intention of the EUTM proprietor. The use by the licensees could have amounted to genuine use, but there was no evidence about any use by the licensees (paras 83-85). The GC did not consider the EUTM proprietor's acts as preparations for use within the meaning of paragraph 37 of C-40/01, *Ansul*, because they did not constitute an advertising campaign and they were not intended to promote goods covered by the contested EUTM but to promote the mark itself. Furthermore, the EUTM proprietor did not show that the goods were about to be marketed, which is a necessary condition (paras 88-91). Admissibility of an application for revocation is assessed irrespective of the motives of the applicant for revocation and it is not conditional on the applicant for revocation having opposed registration of the contested mark beforehand (para. 103). The EUTM merely provides for the possibility of the Office inviting the parties to settle, without imposing any obligation to that effect (para. 105).



Case T-680/15; Les Éclaires GmbH v EUIPO; Judgment of 8 May 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Catalogue, Evidence of use, Extent of use, Proof of use, Declaration

FACTS: The EUTM proprietor was granted the registration of the word mark L'ECLAIREUR as an EUTM for goods in Classes 3, 4, 9, 14, 18, 20 and 25. An application for revocation was filed pursuant to Article 51 EUTMR. The Cancellation Division (CD) upheld the application for revocation. The Board of Appeal (BoA) partly upheld the EUTM proprietor's appeal. It found that the contested trade mark had been genuinely used for clothing and shoes in Class 25. The revocation applicant filed an action before the General Court (GC). The GC dismissed the action; it agreed with the BoA that there had been genuine use for clothing and shoes.

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L'ECLAIREUR

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SUBSTANCE: The Office is only entitled, but not obliged, to request translation of proof of use (PoU). Moreover, the revocation applicant did not expressly request translation during the proceedings before the Office. The principle of the right to be heard and equality of arms was observed, and there was no effect on the exercise of the revocation applicant's rights of defence, since it was in a position to challenge the documents in question before the Court (paras 15-24). The intervener was active as a 'concept store', 'retailing luxury products', inter alia 'clothing and shoes'. There is some evidence that the EUTM proprietor collaborated, on several occasions, with various designers and fashion labels — consumers were confronted, therefore, with textile products labelled with specific marks, composed of both the name of the designer and the mark l'Eclairer. The goods that were subject to that collaboration were always presented in such a way that the mark at issue was easily identifiable, even when they were preceded by the name of the specific creator. Although it was indeed true that some particular lines of products were offered in a very limited series, this was nevertheless a logical consequence of the concept, common in the fashion sector, of offering consumers a luxury product that is often novel and exclusive, at a high price. Evidence that the EUTM proprietor purchased certain goods is relevant because, as it is a retail store, it is reasonable to conclude that he or she purchased the goods in question in order to resell them to the final consumer. The sworn declaration

cannot be rejected at the outset merely because it was made by the EUTM proprietor. The declaration contained sound information that was supported by data from other evidence submitted by the intervener (paras 50-76). The Office's Guidelines are not binding legal acts for the purpose of interpreting provisions of EU law (para. 80). The BoA could draw inferences from the evidence, as an overall assessment of the facts had to be made, taking account of all the relevant factors in the particular case and the interdependence between those factors. Thus, it was indeed for the BoA to place the evidence within the context of the economic sector in question (para. 85).

Case T-721/15; BASF SE v EUIPO; Judgment of 27 April 2017; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Acronym, Descriptive element

FACTS: The EUTM proprietor registered the word mark DINCH for Chemicals for use in the chemical industry in the production and processing of plastics within Class 1.

The invalidity applicant sought to invalidate the EUTM, arguing that the EUTM was descriptive of the goods registered and the time of registration. The Cancellation Division (CD) dismissed the application

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for invalidity. The Board of Appeal (BoA) upheld the invalidity applicant's appeal.

The EUTM proprietor filed an action before the General Court (GC).

EUTM

DINCH

SUBSTANCE: The GC dismissed the appeal finding in favour of the descriptive character of the EUTM. It applied the principles developed for neologisms in the case at hand, an acronym describing chemical substance in accordance with the standard denomination nomenclature as referred to i.a. in DIN and ISO standards known to the professional public. The fact that individual letter parts of the acronym could be interpreted in various ways was immaterial since at least in one interpretation following the nomenclature, the full acronym was descriptive.



Case T-223/15; Morton's of Chicago, Inc. v EUIPO; Judgment of 15 May 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Passing Off

FACTS: For some time, the invalidity applicant has run a club called MORTON'S in London. It alleged that, under the UK laws of passing off, it could prohibit use of the contested EUTM for the relevant goods and services in Classes 29, 30 and 43. The Cancellation Division (CD) rejected this claim and found, inter alia, that the invalidity applicant failed to prove that it was the owner of goodwill in the name MORTON'S.

The Board of Appeal (BoA) upheld the appeal. It found that the invalidity applicant owned goodwill in MORTON'S for club services and restaurant, bar and entertainment services and that all the requirements of passing off were satisfied.

The EUTM proprietor filed an action before the General Court (GC). The principal plea consisted of five complaints: (i) a misinterpretation of the UK rules on passing off, (ii) the flawed nature of the evidence, (iii) that the invalidity applicant did not own the goodwill in the name MORTON'S, (iv) that there was no likelihood of misrepresentation and (v) that the earlier right had only local significance.

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EUTM



Earlier right

MORTON'S

SUBSTANCE: The GC rejected complaint (i) which alleged that the finding of goodwill for restaurant and bar services as well as entertainment and club services was too broad and should have been limited to 'services of a private members' club'. The GC reasoned that customers, accustomed to associating the name MORTON'S with the exclusive restaurant, bar and entertainment services that club offers, would assume that the goods and services marketed under the contested EUTM would also originate from the invalidity applicant (paras 21-22).

Complaint (ii) queried the date of the evidence presented to show use and goodwill for the earlier mark but the GC was satisfied that the BoA took account of the relevant dates when finding that the invalidity applicant had proved goodwill and

use of the earlier marks of more than mere local significance (para. 29).

On complaint (iii) regarding ownership of goodwill, the evolution of MORTON'S club down the years involved various stages where the club changed ownership and/or management and where various aspects of the business (e.g. management of the business and ownership of the property) were split between several entities. The many agreements and parties meant that it was not easy to determine where 'control' over the day-to-day business lay. Under the laws of passing off, if the invalidity applicant was responsible for the day-to-day running of MORTON'S, then the goodwill would accrue to it unless another party retained control over the quality of the services provided. Resolving this issue touched on the following key characteristics of goodwill:

- goodwill attaches to a business (and not merely to a name);
- goodwill cannot be separated from the underlying business to which it attaches;
- any agreement purporting to assign or license goodwill (and hence an unregistered trade mark) separate from the underlying business is invalid under English law as an 'assignment in gross' or 'bare licence'.

The invalidity applicant argued that the goodwill in the business passed to it via the agreements,

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whereas the EUTM proprietor argued that the agreements showed that another party maintained final control of key matters, which meant that the invalidity applicant was merely a manager who did not own the goodwill.

The GC examined the agreements and concluded that it was, in fact, the invalidity applicant who had been conducting the day-to-day business and using the earlier rights in relation to the relevant services since 2002. Furthermore, it had, under an agreement of 3 April 2002, acquired the goodwill relating to MORTON'S and the exclusive right to operate that club and use the trade names associated with it. Consequently, it owned the goodwill (paras 39-45).

The GC went on to consider complaint (iv) which alleged that there was no likelihood of misrepresentation because customers of MORTON'S were a 'niche group of wealthy individuals' who are particularly attentive to the club's activities; thus they would not confuse them with the activities of a restaurant bearing a similar name. First, the GC found that the relevant public was comprised of the invalidity applicant's customers, namely the members of MORTON'S club and their guests. Next, it observed that the goods and services covered by the EUTM were partly identical and partly similar to the restaurant, bar, club and entertainment services for which the earlier marks enjoyed goodwill. Finally, the GC pointed out that the signs in question were practically identical. These factors gave rise to a

likelihood of misrepresentation for the purposes of passing off (paras 51-57).

On the final complaint (v) alleging that that the earlier right was only of local significance, the GC pointed out that it is necessary to take into account: the geographical dimension (the territory in which it is used to identify its proprietor's economic activity) and the economic dimension of the sign's significance. As regards the former, although MORTON'S is located in London, it was referred to in a number of press articles with UK-wide and international coverage as well as in restaurant guides in the UK. As to the economic dimension, the GC found that the duration and intensity of the use of the earlier trade marks can be considered as being non-negligible. In particular, as exclusivity is part of the club's image, the relatively small number of members is not critical. The allegation that the earlier right was only of local significance was also rejected (paras 65-79).

Accordingly, the entire first plea was rejected. Since the invalidity of the EUTM declared by the BoA was upheld, it was not necessary to examine the second plea in law, based on an infringement of Article 52(1) (b) of Regulation No 297/2009.

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Case T-367/15; Renfe Operadora, Entidad Pública Empresarial v EUIPO; Judgment of 5 April 2017; Language of the case: ES ave

RESULT: Action dismissed

KEYWORDS: Declaration, Fax, Restitutio in integrum, Right of defence, Notification

FACTS: The Cancellation Division (CD) revoked the contested EUTM AVE partially, including some goods under the description of vehicles; vehicles for locomotion by land in Class 12. The language of the proceeding was English. The EUTM proprietor filed a notice of appeal in Spanish against the decision of the CD. The Board of Appeal (BoA) rejected the appeal on the grounds that it was not filed in the language of the proceeding and that no English translation was submitted within the time limit. The applicant lodged an action against that decision before the General Court (GC), who dismissed that action (T-616/14), and filed in parallel a request for restitutio in integrum based on Article 81(1) EUTMR. The BoA rejected the application for restitutio in integrum since the applicant had failed to substantiate that it took all due care required by the circumstances within the meaning of Article 81(1) EUTMR to avoid non-observance of the time limit for filing the English translation of its notice of appeal. The EUTM proprietor filed an action before the General Court (GC) against this decision. The GC dismissed the action.



SUBSTANCE: Taking into account the jurisprudence concerning Rule 49 EUTMIR, the GC confirmed that the Office did not have the power to grant an additional period to comply with the provision under Rule 48(2) EUTMIR. All the arguments concerning which would be the time limits to comply with Article 60 EUTMR and Rule 48 EUTMIR in the present case were irrelevant within the scope of these proceedings, where the issue to be assessed was whether the applicant proved having taken the due care required by the circumstances (paras 37-40). The fact that the applicant used a pre-printed form to file its notice of appeal was not enough reason for the applicant to show less diligence. The applicant was obliged to submit this form in the language of the proceeding within the established deadlines (paras 42-44). The GC recalled that the BoA is not obliged to take a position on all the arguments raised by the parties and that a fax report can be sufficient evidence of its receipt, as it so happened in the case at hand. The GC confirmed that the BoA correctly determined that the submitted evidence was unable to counteract the evidence provided by the fax report and observed that this evidence

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suggested that the alleged circumstances were not exceptional events (paras 45-55). The GC also confirmed that the BoA's acknowledgment and notification of receipt of an appeal did not constitute a decision on its admissibility and that the opposite could not be inferred from the content of that letter. Therefore, it could not justify the applicant's failure to comply with the established time limits. The alleged Office's practice of informing the appellants about irregularities in their appeals was irrelevant to determine the applicant's due care, since these time limits were already established in the corresponding provisions and must be fulfilled (paras 57-61). The GC found the allegation of lack of equal treatment unfounded (para. 64) and finally confirmed the BoA's finding that the applicant's failure to comply with the time limit was attributable to human error and was not the result of exceptional or unforeseeable events (para. 68). Lastly, the GC considered that the present action concerned the re-establishing of the applicant's rights, and not the correctness of the BoA's decision contested in Case T-616/14. Consequently, all the arguments relating to the infringement of the right of defence were dismissed (paras 70-75).



Case T-681/15; Environmental Manufacturing LLP v EUIPO; Judgment of 3 May 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Figurative trade mark, Phonetic similarity, Conceptual similarity, Enhanced distinctiveness

FACTS: The Opposition Division (OD) had dismissed the opposition under Article 8(1)(b) and (5) EUMTR on account of a lack of similarity of the signs. The Board of Appeal (BoA) reversed this decision and found that Article 8(5) EUMTR applied. The General Court (GC) dismissed the appeal (T-570/10). The Court of Justice (CJ) annulled this judgment and found that the GC should have examined, as a condition for dilution, whether a change (or the risk of a change) in the economic behaviour of the consumer had been established (C-383/12P). Applying this guidance, the GC annulled the BoA's decision (T-570/10 RENV). The case was remitted to the First BoA which upheld the opposition, this time under Article 8(1)(b) EUMTR, after finding that the earlier mark had enhanced distinctiveness in France in respect of lawnmowers and brush cutters. The GC dismissed the appeal.

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EUTM application



Earlier trade mark



SUBSTANCE: Neither the fact that the public consisted of both professionals and non-professionals, or the identity/close similarity of the goods were challenged. The signs were visually similar, bearing in mind that the figurative element of the earlier mark was co-dominant (paras 45-47). The GC confirmed that a phonetic comparison was impossible: 'a phonetic comparison of the signs at issue is irrelevant in the examination of the similarity of a purely figurative mark with another mark' (para. 52), unless the semantic content of the purely figurative mark could immediately be associated with a specific, concrete word. In this case, the figurative element in the mark applied



for reproduces the head of a canine, which is capable of being perceived as a wolf, a dog or a fox. Consequently, no specific word could with certainty be attributed to the mark applied for (para. 53). The signs were conceptually similar despite the fact that the earlier mark includes a verbal element. This was irrelevant because the existence of a meaningless verbal element cannot render the signs conceptually dissimilar (para. 61). Moreover, part of the public may understand the word 'wolf' as an English word denoting the animal represented in both signs (para. 62). Given that the signs were similar overall, the goods were at least similar to a high degree and the earlier mark had enhanced distinctiveness, a global assessment of the relevant factors led to the conclusion that there was a likelihood of confusion (LOC) (paras 69-70). The opposition could be upheld under Article 8(1) (b) EUTMR even if in the previous decision the BoA had found (at least implicitly) that the degree of similarity of the signs could at best justify the existence of a link when applying Article 8(5) EUTMR. Since Article 8(1)(b) EUTMR had not been examined, it could not be inferred that the BoA and the GC had accepted in their previous decision/judgment that a LOC was ruled out (para. 74).

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Case T-637/15; Alma-the soul of Italian wine v EUIPO; Judgment of 31 May 2017; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

FACTS: After annulment of a first decision of the Board of Appeal (BoA) applying Article 8(5)(T-605/13), the BoA examined the documents submitted by the applicant during the administrative proceedings on the alleged weak distinctive character of the word 'sun' in various languages. It found that 'SOL' was not devoid of distinctive character for wines, although it had a 'somewhat below level' of distinctiveness. The BoA found that there was a link between the signs, that there was detriment to the distinctive character of the earlier mark and that there was no due cause for the use of the mark applied for. The applicant filed an action before the General Court (GC) relying on three pleas in law: infringement of Articles 8(5) and 64(1) and Article 8(1)(b) EUTMR.

SUBSTANCE: The GC only dealt with the plea on Article 8(5) EUTMR. It confirmed the BoA's finding that the relevant public was the EU general public, whose level of attention was average (para. 39), as well as the reputation of the earlier mark. The GC found that the extracts from websites offering EU consumers wines identified by marks that included the words 'sol', 'sole', 'soleil' or 'sun' and images of the sun, combined with a list of EUTMs in Class 22 containing those words or images, allowed to



EUTM application



Earlier trade mark

VIÑA SOL

conclude that EUTMs coexisted that included a reference to the concept of the sun. The EU relevant consumers are frequently exposed to such marks (paras 61-62). The term 'SOL' has a low degree of distinctiveness. When associated with the weak term 'VIÑA', it conferred on the earlier mark only a low degree of distinctiveness (para. 63). The majority of EU consumers were likely to understand 'SOLE' and 'ITALIANO', which are the dominant elements of the EUTM application (para. 67). There was only a low degree of visual similarity: the coincidence of the sequence of letters 'SOL' is not capable of offsetting the many differences between the signs. There was no phonetic similarity. Conceptual dissimilarity: vineyard of the sun/origin and place of production

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of the wine (paras 69-76). The degree of similarity between the signs was not sufficient for the relevant public to establish a link (para. 78). Article 8(5) could not apply. The action was upheld.

Case T-85/15; Alfa Wassermann SpA v EUIPO; Judgment of 16 May 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Common element, Complementary goods, Distinctive element, Likelihood of confusion (LOC), Phonetic similarity, Visual similarity

FACTS: The applicant sought to register the word mark YLOELIS as an EUTM for goods in Class 5. An opposition based on the earlier marks represented below, registered for goods in Class 5, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition. The Board of Appeal (BoA) dismissed the appeal. It found that there was a LOC between the mark applied for and the earlier word mark. The GC dismissed the action.

SUBSTANCE: The GC confirmed that the level of attention of the relevant public, composed of oncologists, doctors and EU health care professionals and cancer patients in the European Union, was high (para. 23). The GC pointed out that the fact that the contesting goods were expressly



EUTM application

YLOELIS

Earlier trade marks

YONDELIS

Yondelis 

excluded from the list of the contested goods was not in itself sufficient to exclude any similarity between them (para. 31), and that they did not differ in their intended purpose, method of use and end users given that it could not be excluded that they were complementary in so far as the contested goods could be used to limit the side effects of the goods covered by the earlier mark (para. 32). Taking into account that the goods had the same nature (pharmaceutical products for human use), purpose or intended use (treatment of human health problems), consumers (medical professionals and patients) and distribution channels (pharmacies and hospital supply services) as well as the fact that they also had a complementary connection, the GC

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confirmed that there was similarity between the goods (paras 28-29 and 35). The GC stated that the signs were visually similar because the elements that differentiated them were not capable of nullifying the common features that they possessed (paras 38-42); that they had, overall, a phonetic similarity, even where the letter 'y' was pronounced differently (paras 43-45); and that the conceptual comparison between the marks was neutral because they did not have any specific meaning in any specific language (para. 46). Additionally, the GC confirmed the distinctive character of the earlier mark (para. 50). For all the above, the GC concluded that there was a LOC, even in the event of a high level of attention on the part of the relevant public (para. 55). The GC clarified that a high level of attention is not in itself sufficient, in light of the other factors, to exclude any LOC (para. 53), which in the present case did not take the form of the likelihood that the public might confuse the two goods (i.e. the medication YONDELIS, administered to treat cancer, and the product YLOELIS, administered to treat the side effects of treatment with YONDELIS) but of the likelihood that they could wrongly believe that they are goods marketed by the same undertaking (para. 54).



Case T-97/16; Martin Kasztantowicz v EUIPO; Judgment of 4 May 2017; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Fax, Burden of proof, Right to be heard, Right of defence, Notification

NORMS: Article 51(1)(a) Regulation No 207/2009, Rule 40(5) Regulation No 2868/95; Rule 61(2) and (3) and Rule 65 (1) Regulation No 2868/95; Article 78 Regulation No 207/2009; Rule 57 Regulation No 2868/95; Article 76(2) Regulation No 207/2009

FACTS: A cancellation action pursuant to Article 51(1)(a) Regulation No 207/2009 (non-use) was filed against the EUTM GEOTEK. The Cancellation Division (CD) sent a fax informing the EUTM proprietor about the cancellation action and asking the proprietor to provide evidence of genuine use of the contested EUTM by 24 May 2014. The fax was sent to the fax number provided by the proprietor in the EUTM application form. The Office was not informed of the change to this number. On 2 June 2014, the CD informed the proprietor via fax and ordinary mail that the Office had not received a response and that it would therefore make a decision pursuant to the evidence on file. It was undisputed that the proprietor did not receive this notification. Upon the proprietor's request to access the Office's electronic communication services on 23 June 2014,

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the proprietor informed the Office that it had not received any of the notifications due to a change of postal address (the change to the fax number was not mentioned). The proprietor also informed the Office of his or her new address and sent evidence of use of the earlier mark.

On 26 September 2014, the CD annulled the contested EUTM pursuant to Rule 40(5) Regulation No 2868/95 since no proof of use was provided in due time (namely by 24 May 2014).

Upon appeal, the proprietor offered oral witness statements for the fact that it had changed its postal address. It argued that the evidence was submitted on time since it had never received notification of the cancellation request due to its change of address. It also offered a witness statement to prove that it had not received the fax without mentioning any concrete facts to that regard.

The Board of Appeal (BoA) confirmed the CD's decision. It held that the Office's fax notifying the cancellation request and setting the deadline for proving genuine use of the contested EUTM had been duly sent by the Office and received by the proprietor. This was shown by the Office's fax report. The Office had always used the same fax number since the very first filing of the contested EUTM. The proprietor did not inform the Office of the change to his or her number. The BoA further held that it enjoyed a power of discretion, pursuant

to Article 76(2) Regulation No 207/2009, to take into account the evidence that was filed on 23 June and therefore belated. Exercising this power of discretion, it held that the circumstances of the case did not justify taking the belated evidence into account nor to hear any witnesses.

SUBSTANCE: On Rule 40(5) Regulation No 2868/96 and Article 76(2) Regulation No 207/2009: If the deadline for proving genuine use of the contested EUTM, namely 24 May 2014, was duly set by the Office, the EUTM had to be cancelled pursuant to Rule 40(5) Regulation No 2868/95 since no proof of use was filed within this deadline (para. 28). In this scenario, and pursuant to established case-law, the Office would only have had discretion to take belated evidence into account pursuant to Article 76(2) Regulation No 207/2009 if the belated evidence was 'additional' to duly submitted evidence (para. 29). It is, however, undisputed that no evidence was submitted within the deadline set by the Office, namely by 24 May 2014. Therefore, there would have been no discretion of the Office to take the belated evidence into account and the contested EUTM had to be cancelled provided that this deadline was duly set. The main question, therefore, was whether the proprietor had received the Office's notification setting this deadline (para. 32).

On Article 51(1) Regulation No 207/2009 in conjunction with Rules 40(5), 61(2) and (3) and 65(1) Regulation No 2868/95: (a) Pursuant to

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Rule 61(2) Regulation No 2686/95, as interpreted by the General Court (GC), any kind of Office decision can be notified via telecopier. Pursuant to Rule 65(1) second sentence Regulation No 2686/95, a notification is deemed to have taken place on the date on which the communication was received by the telecopying device of the recipient. It is sufficient that the recipient receives the notification so that the recipient is in the position to take notice (external aspect of the notification); actual knowledge (internal aspect of the notification) by the recipient is not necessary (paras 38-40). Regarding the external aspect of notification, the sender has to prove that it took the measures so that the fax can enter the recipient's 'sphere'. It has not only to be proven that the fax was sent but also that it was transmitted in a way that the recipient was in the position to take notice of its content. The sender is, however, not obliged to prove that the recipient in fact took notice of the content (internal aspect). The sender is not in the position to enter the recipient's organisation in order to ensure that it takes notice (para. 41). The GC, therefore, had already decided in previous judgments that the fax reports demonstrated that the other side had received the fax (para. 42). Fax machines report any issue regarding the transmission or receipt. The absence of an 'error' message and the existence of a fax report showing 'OK', therefore, indicated that the fax had been duly transmitted and received (para. 42). This did not imply that the recipient was not permitted to prove the contrary, for example,



because of an accident, force majeure or an error outside of the recipient's responsibility (paras 43 and 44). There was, however, no indication whatsoever on file that the proprietor had not received the fax in question although the Office's fax report showed 'OK' (para. 45). The proprietor did not argue or submit proof to the contrary, for example, any technical error that could not have been foreseen or prevented by the proprietor (para. 46). Due to the fax report and the lack of arguments to the contrary, the Office was entitled to assume that the fax had indeed been received by the proprietor setting the deadline for proving genuine use (para. 46). The offered testimonies were not relevant because they were offered regarding irrelevant facts (para. 50).

On Article 78(1)(a) and (d) of Regulation No 207/2009 in conjunction with Rule 57 Regulation No 2868/95: The Office was not obliged to hear witnesses in the case at hand. Article 78(1)(a) and (d) Regulation No 207/2009 and Rule 57 Regulation No 2868/95 envisaged the possibility of aural evidence by witnesses but did not establish any obligation on the Office to grant such request (para. 56). The Office had a wide discretion (para. 57). The GC was, therefore, limited to assess whether the Office committed an obvious error or misuse of this power of discretion when denying the request (para. 58). Since all the facts submitted by the EUTM proprietor were irrelevant for the question as to whether the fax was received, the BoA was indeed entitled to find that hearing the witnesses was not

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justified (para. 61). The BoA did not expressly refuse a second request to summon a witness. It followed implicitly, however, from the contested decision that this request was refused since the proprietor did not submit any relevant fact that could speak against the receipt of the fax and which the witness could have confirmed (paras 63 and 64).

Case T-107/16; Airhole Facemasks, Inc. v EUIPO – industrysurf, SL; Judgment of 16 May 2017; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Bad faith

FACTS: The applicant requested the contested mark — identical to the applicant's prior US and Canadian marks — to be declared invalid. It based its request upon Article 53(1)(b) EUTMR in conjunction with Article 8(3) EUTMR (filing by unauthorised agent) as well as upon Article 52(1)(b) EUTMR (bad faith). At the time of the filing of the contested mark, the EUTM proprietor was the applicant's distributor for six member states of the European Union. While it was undisputed that the applicant had consented to the filing of the contested mark, the parties disagreed on the question as to whether or not that consent extended to the filing of the contested mark in the EUTM proprietor's own name. The Cancellation Division (CD) declared the contested



mark invalid. It found that the EUTM proprietor acted in bad faith (Article 52(1)(b) EUTMR) when it filed the contested mark in its own name. The Board of Appeal (BoA) annulled the decision of the CD and rejected the applicant's invalidity request. It found, in essence, that the applicant had not established that it had not consented to the filing of the contested mark, excluding the application of both grounds of invalidity invoked by the applicant. Before the General Court (GC), the applicant invoked a breach of Article 8(3) EUTMR and Article 52(1)(b) EUTMR, and requested the contested decision to be altered accordingly.

EUTM



**AIR
HOLE**
FACE MASKS YOU IDIOT

SUBSTANCE: The GC found that the BoA was required to find, as the CD had done, that the EUTM proprietor had acted in bad faith when it filed the contested mark (paras 42 and 49). The GC thus annulled the contested decision and also altered the latter to the effect that the EUTM proprietor's

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appeal before the BoA was dismissed (paras 45-50), ordering the EUTM proprietor to bear the applicant's costs in the proceedings before the BoA (para. 53). The GC found, first, that the contested mark had not been filed with the applicant's consent (paras 25-36) given there was no indication suggesting that the applicant had consented in a clear, specific and unconditional manner to that filing in the EUTM proprietor's own name (para. 25). This would follow from (i) the correspondence between the parties before (paras 26-27) and after (para. 28) the filing and (ii) from the objective circumstances of the case (para. 29) such as the identity of the contested mark with the applicant's prior US and Canadian marks (paras 30-31), the existence of an exclusive distribution agreement, which was in force at the time of filing, submitting the EUTM proprietor to the requirement of an express consent for the use of the applicant's logos and marks (paras 32-34), which allowed the EUTM proprietor to understand the filing of the contested mark as following the applicant's commercial logic to extend the protection of its mark to the territory of the European Union (para. 35). The GC found, second, that the EUTM proprietor had sought to usurp the applicant's rights (para. 37). This would follow from the fact that the EUTM proprietor could not claim any priority with regard to the contested mark (para. 38) and was, by reason of the distribution agreement, fully aware of the existence and use of the applicant's identical mark at the time when the contested mark was filed (para. 39) as well as of its own territorial and substantive restrictions

as regards the use it was entitled to make of the applicant's marks in the European Union (para. 40). This would, in addition, be confirmed by the EUTM proprietor's omissions and acts following the filing of the contested mark (para. 41) given that it had neither informed the applicant of the filing and the subsequent registration of the contested mark, nor honoured its undertaking to transfer the contested mark to the applicant, and threatened the applicant and its other distributors in the EU with infringement proceedings based on the contested mark.

Case T-372/16; Alexander Bammer v EUIPO; Judgment of 11 May 2017; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive element

FACTS: The EUTM proprietor was granted the registration of the word mark MÄNNERSPIELPLATZ as an EUTM for the goods clothing, footwear, headgear in Class 25 and the services travel reservation; travel arrangement; booking of seats (travel) in Class 39 and organisation and conducting of sporting and cultural events; organisation of entertainment shows; arranging participation in special events; seat reservation for entertainment events in Class 41.

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An application for invalidity was filed pursuant to Article 52(1)(a) in conjunction with Article 7(1)(b),(c) and (d) EUTMR. The Cancellation Division (CD) upheld the application for invalidity. The Board of Appeal (BoA) dismissed the EUTM proprietor's appeal. It found that the EUTM was registered contrary to Articles 7(1)(b) and (c) EUTMR. The German term 'männerspielplatz' designates a place ('platz') where specific users, namely men ('männer'), pursue an activity, namely playing ('spielen'). With this meaning, 'playground for men', the EUTM may serve to describe the goods and services and it lacked the required distinctiveness.

The EUTM proprietor filed an action before the General Court (GC) relying on two pleas in law under Article 7(1)(b) and (c) EUTMR in conjunction with Article 52(1)(a) EUTMR, namely that the BoA erred in determining the relevant point in time for assessing these provisions and in assessing the evidence filed to show the EUTM's descriptiveness. The GC dismissed the appeal.

EUTM

Männerspielplatz

SUBSTANCE: The relevant public consists of the German-speaking general public (paras 21-22). As to the relevant point in time, the time of the application

of the EUTM, it was not disputed that the words combined in the EUTM, 'männer' and 'spielplatz', had the meaning on which the BoA based its decision. As a matter of fact there are places where men may pursue leisure activities following their play instinct, such as operating a digger or a tank. In accordance with the common German word 'Kinderspielplatz', referring to a playground for children, the relevant public was in a position, at the time of the application, to understand MÄNNERSPIELPLATZ as referring to a playground for men (paras 25-27). The evidence filed as regards an actual use of this term is not relevant and the BoA did not rely on it in its findings (paras 28-29). The GC confirmed the BoA's finding as to the descriptiveness in relation to the goods and services at hand under Article 7(1)(c) EUTMR. The goods in Class 25 may be specifically designed for leisure activities of men due to their wear resistance. The services in Class 39 may relate to trips that may be understood as playgrounds for men, such as motorbike tours, or that take the public to playgrounds for men. The services in Class 41 may relate to events that include leisure activities where men may play or watch others playing (paras 33-35). Given that the EUTM was registered contrary to Article 7(1)(c) EUTMR and the action therefore was dismissed, it was not necessary to examine Article 7(1)(b) EUTMR (para. 62).

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Case T-262/16; Globo Media, SA, v EUIPO; Judgment of 5 May 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Relevant public, Similarity of the signs, Likelihood of confusion (LOC)

FACTS: The applicant sought to register the verbal mark represented below as an EUTM for services in Classes 35, 38 and 41. The Board of Appeal (BoA) confirmed the decision of first instance and refused the EUTM application upon opposition based on the earlier Portuguese figurative mark represented below. The BoA considered that given the coincidence in the dominant and distinctive element 'GLOBO' in both marks, there was a LOC for the services at stake, even for the relevant public with a high level of attention.

SUBSTANCE: The GC confirmed the decision of the BoA and concluded there was a LOC in the meaning of Article 8(1)(b) EUTMR. The relevant public was the public at large and the professional public in Portugal, whose attention would vary according to the category of services (para. 20). The GC also confirmed that the services at issue were at least similar. Regarding the distinctive elements of the sign, the GC considered that the figurative element of the earlier mark was less distinctive than the verbal elements and that both 'TV' and 'PORTUGAL'



EUTM application

GLOBO MEDIA

Earlier trade mark



were descriptive elements of the relevant services (paras 28-29). This mark did not have any dominant element (paras 34-35). On the contrary, the element 'GLOBO' present in both marks the element 'globo' was not, per se, descriptive of anything but a globe and, at most, alluded to the planet (para. 53). The GC found, as did the BoA, that the signs were visually similar only to a low degree (para. 43) and phonetically similar to a medium degree (para. 47). The finding that the marks were conceptually similar to a high degree taking into account the meaning of the common element 'globo' (globe), the link between the concepts of 'tv' and 'media' and the fact that this concept was reinforced by the figurative element, was not disputed by the applicant and therefore the BoA was entitled to rely on that

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element (para. 49). The GC rejected the argument that the visual perspective played a greater role for the services in question (paras 57-58) and concluded that there was a LOC in this case (para. 60).

Case T-218/16; Mühlbauer Technology GmbH v EUIPO; Judgment of 16 May 2017; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive element, Misspelled word mark

FACTS: The applicant sought to register the word mark Magicrown as an EUTM for the goods material for stopping teeth; fixing materials and impression materials; crown and bridge materials; repair materials for dental purposes; dental preparations and articles for repairing teeth in Class 5 and artificial teeth, dental crowns, dental bridges, dental prostheses and dental prosthetic parts in Class 10.

The Office refused the registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR.

The Board of Appeal (BoA) dismissed the applicant's appeal. It found that the relevant English-speaking dental professionals would perceive the EUTM application as a combination of the word 'magic' designating the wonderful properties of the goods



concerned and the word 'crown' referring to a tooth crown — despite the missing letter 'c'. With this meaning it described the goods at hand under Article 7(1)(c) EUTMR and it also lacked the distinctive character required under Article 7(1)(b) EUTMR.

The applicant filed an action before the General Court (GC) relying on a violation of said provisions. The GC dismissed the appeal.

EUTM application

Magicrown

SUBSTANCE: The GC confirmed the BoA's findings under Article 7(1)(c) EUTMR holding that there was no noticeable difference between 'magicrown' and the sum of its components 'magic' and 'crown'. In English, it is usual to combine words into one. The relevant public would thus understand the EUTM application as meaning a wonderful tooth crown, which designates the goods' quality (paras 22-23). Given this finding under Article 7(1)(c) EUTMR it was not necessary to assess the plea concerning Article 7(1)(b) EUTMR.

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Case T-163/16; **Reisswolf Akten- und Datenvernichtung GmbH & Co. KG v EUIPO; Judgment of 18 May 2017; Language of the case:** DE

RESULT: Action dismissed

KEYWORDS: Examination of facts ex officio, Lack of reasoning, Descriptive element

FACTS: The applicant sought to register the word mark *secret. service* as an EUTM for various office functions in Class 35, document-related services in Classes 39 and 40 and a variety of consultancy and IT-related services in Class 42. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR. The Board of Appeal (BoA) dismissed the applicant's appeal. It found that the EUTM application referred to a service that was related to something secret. For services concerning the storage and destruction of documents and data, the EUTM application designated their purpose to keep them secret. For this reason, the EUTM application also lacked the required distinctiveness. The applicant filed an action before the General Court (GC) relying on four pleas in law: (i) a violation of the obligation to examine the facts ex officio, (ii) a violation of the obligation to state reasons, (iii) a violation of Article 7(1)(c) EUTMR, and (iv) a violation of Article 7(1)(b) EUTMR. The GC dismissed the appeal.



EUTM application

secret.service

SUBSTANCE: The BoA correctly assessed the EUTM application's registrability from the point of view of the English-speaking public. The contested decision's references to the EUTM application's translation into German resulted merely from the language of the proceedings (para. 20). Given that all services concerned the storage and destruction of documents and data, and thus formed a homogenous group, the BoA was entitled to employ the same line of reasoning in rejecting the application for all of them (paras 30-47). On the merits of the EUTM application's registrability, the GC confirmed the BoA's findings. In the context of the services at hand, other possible associations in relation to the *secret service* protecting, for instance, the US president or featuring in a James Bond movie, were unlikely to arise. Furthermore, the term '*secret*' is also commonly used in a commercial context (paras 59-70). The EUTM application was thus correctly refused registration under Article 7(1)(c) EUTMR and so was not required to address the plea concerning Article 7(1)(b) EUTMR.

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Case T-472/16; Marsh GmbH v EUIPO; Judgment of 16 May 2017; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive element

FACTS: The applicant sought to register the word mark LegalPro as an EUTM for insurance-related services in Class 36. The examiner refused the application based on Article 7(1)(b) and (c) EUTMR. The Board of Appeal (BoA) confirmed the decision. It held that the mark, for the relevant English-speaking end consumers with an average level of attention, directly described that the services offered concerned legal issues and were rendered in a professional way. Being descriptive for the services at issue, the trade mark was also non-distinctive for these services. The applicant filed an action before the General Court (GC), claiming a violation of Article 7(1)(c) and (b) EUTMR.

EUTM application

LegalPro

SUBSTANCE: The GC dismissed the applicant's claim that the relevant public was not confined to English-speaking end consumers. As, according to Article 7(2) EUTMR, it is sufficient for a refusal that



the trade mark is descriptive in one part of the EU — in the case at hand at least Ireland, Malta and the UK — it was irrelevant whether the sign was also descriptive in other parts of the EU (paras 17-18). The fact that the contested trade mark does not appear in dictionaries was immaterial as it was not necessary that the sign, at the time of the application, was already being used in a descriptive way in the market. Furthermore, it was immaterial that the sign might have various meanings, as long as it was descriptive in at least one of its meanings — in the present case: 'legal and professional' (paras 25-28). As the trade mark application was already to be rejected in accordance with Article 7(1)(c) EUTMR, it was immaterial whether the conditions of Article 7(1)(b) EUTMR were also fulfilled (para. 44). Based on the foregoing, the action was dismissed.

Case T-159/16; Metronia S.A. v EUIPO; Judgment of 16 May 2017; Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion (LOC), Distinctive element

FACTS: The applicant sought to register the figurative sign TRIPLE O NADA as an EUTM for goods and services in Classes 9, 28 and 41.

An opposition based on the earlier figurative EUTM

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TRIPLE BINGO, registered for goods and services in Classes 9, 28 and 41, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition.

The Board of Appeal (BoA) dismissed the applicant's appeal. For the assessment of the LOC, the BoA took into consideration only the Hungarian, Bulgarian and Polish part of the relevant public, for which the word 'TRIPLE' has no meaning. It found that, despite the low degree of distinctive character shown by the earlier mark, there was a LOC on that part of the public, since the conflicting marks coincided on 'TRIPLE', the most relevant element in both signs.

The applicant filed an action before the General Court (GC) relying on a single plea in law: infringement of Article 8(1)(b) of the Regulation.

SUBSTANCE: The GC reiterated the BoA's conclusions on the relevant public (para. 26) and those on the existence of identity between the products and services (para. 28). It found that the conflicting signs were visually and phonetically similar to a degree lower than average (paras 37 and 42). Furthermore, since the Hungarian, Bulgarian and Polish public was not able to understand the meaning of the word 'TRIPLE', it was not possible to carry out a conceptual comparison between the signs (para. 49). The GC also underlined that, in the context of opposition proceedings, it was not possible for the applicant to claim the lack of



EUTM application



Earlier trade mark



distinctiveness of the earlier trade mark (para. 56) and that a low degree of distinctive character was not incompatible with a finding of LOC (para. 57). In any event, in the case at hand the earlier mark did not present a low degree of distinctive character, at least for the Hungarian, Bulgarian and Polish part of the relevant public, who do not understand the meaning of the term 'TRIPLE' and for which it would be distinctive (para. 58). Finally, the GC confirmed the existence of the LOC, upholding the BoA's decision (para. 60).

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Case T-375/16; Sabre GBLB Inc. v EUIPO; Judgment of 18 May 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Right to be heard, Descriptive element, Laudatory mark, Purpose of the goods and services, Quality of the goods and services

FACTS: The applicant sought to register the word mark INSTASITE as an EUTM for goods and services in Classes 9, 35 and 42.

The examiner refused the registration of the EUTM application for all the goods in Class 9 and part of the services in Class 42 pursuant to Article 7(1)(b) and (c) and Article 7(2) EUTMR. The term 'INSTASITE' was found to be descriptive of the goods and services at hand, and devoid of distinctive character.

The Board of Appeal (BoA) dismissed the applicant's appeal.

Before the General Court (GC), the applicant claimed an infringement of (i) the right to be heard (Article 75 EUTMR), (ii) Article 7(1)(c) EUTMR and (iii) Article 7(1) (b) EUTMR. The GC dismissed the appeal.

EUTM application

INSTASITE

SUBSTANCE: The GC emphasised that it was clear from the contested decision that the BoA found that the factual and legal reasons and the evidence on which the examiner relied were sufficient to establish the descriptive nature of the mark applied for (para. 23). By referring to the laudatory nature and the perception of the mark applied for as a mere advertising slogan (argument not mentioned by the examiner), the BoA did not in any way state that it was taking those factors in consideration, but merely pointed out the existence of other factors, such that the evidence which formed the basis for the contested decision was not exhaustive (para. 24).

The GC confirmed that the relevant public was mainly professional but also the public at large, which would display a higher degree of attention (para. 35). Since the mark consisted of elements in English, the existence of absolute grounds for refusal was examined with regard to English-speaking consumers of the EU (para. 36). The GC confirmed that the words 'insta' and 'site' would be immediately and intuitively perceived by the relevant public (para. 52), regardless of the number of dictionaries where it could be found. A mark's conceptual content is not necessarily identical to the dictionary definitions since, during the short space of time in which the consumer is faced with a mark, he perceives the meaning of the terms intuitively rather than in a linguistically scientific way (para. 56). Furthermore, the GC upheld the assessment of the

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BoA that the relevant consumers understood the expression 'INSTASITE' as immediately informing them without further reflection that the goods and services applied for are, first, services enabling the instant production, maintenance and updating of internet sites, and, second, software used for this purpose (para. 44). Therefore, the expression 'INSTASITE' described the type, intended purpose and quality of the goods and services at issue.

Case T-36/16; Enercon GmbH v EUIPO; Judgment of 03 May 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Colour mark, Distinctive element

FACTS: The applicant sought to register the colour mark represented below as an EUTM for goods in Class 7. An application for a declaration of invalidity was filed pursuant to Article 52(1)(a) and (b) EUTMR. The Cancellation Division (CD) granted the application for a declaration of invalidity on the basis of Article 7(1)(b) EUTMR in so far as the mark defined the way in which the registered colours could be applied to a wind turbine tower. The Board of Appeal (BoA) annulled the decision of the CD. The invalidity applicant filed an action before the General Court (GC) alleging the infringement of Article 7(1)(b) EUTMR, Article 62 EUTMR and Article 52(1)(b) EUTMR. The GC annulled the BoA's decision. It found



that the BoA had based its decision on a mistaken perception of the nature and characteristics of the contested mark and had made an error of assessment in finding that the contested mark was not a colour mark, but rather a two-dimensional figurative mark made up of colours. The applicant filed an action before the Court of Justice (CJ). The CJ dismissed the appeal as manifestly inadmissible. The case was remitted to the Second BoA, which confirmed the CD's decision. The applicant filed an appeal alleging the infringement of Article 7(1)(b) EUTMR.

EUTM application



SUBSTANCE: The GC stated that the relevant public was composed of specialist business consumers with a heightened degree of attention (para. 35). The GC confirmed that the indication of the nature of the mark (as a colour mark), in the EUTM application, was

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relevant when determining the subject-matter of protection. 'It follows that the distinctiveness of the contested mark had to be examined (...) in the light of the category chosen by the applicant, without any possibility of re-categorising the mark' (para. 36). The GC noted that the BoA did not err in finding that the contested mark, which is composed of five shades of the colour green and of white, applied to wind energy converters and parts thereof, conveyed exclusively an aesthetic message as a decorative element of those goods and therefore could not indicate the commercial origin of goods. According to the GC, it was also correct that green, as the colour of nature, referred to the fact that the goods at issue were ecological or environmentally friendly (paras 45-46). Furthermore, as the GC has already held, the colour green, even in five different shades, would enable the contrast between vegetation and wind energy converters to be reduced. The presence of the colour white does not affect that conclusion in any way, given the neutrality of that colour. Additionally, the arrangement of the colours on the lower part of the shaft was also devoid of any distinctive character, and was only an aesthetic consideration to enable the goods to better blend in to their environment (judgment of 28/01/2015, T-655/13, Grün, EU:T:2015:49, § 35, not published) (paras 49-50). Consequently, the GC emphasised that given that wind energy converters and parts thereof are high-value capital goods, the specialist consumers will neither identify nor purchase that equipment by reference to its decoration or

external presentation, but will be guided by precise and accurate information on the origin of the goods (para. 51). For all the above, the GC dismissed the action.

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R2245/2016-2 [ecoparts automotive quality \(fig.\) / eco parts](#)

EUTMA



Earlier trade marks

ECO PARTS

Result: Decision confirmed.

Keywords: Costs.

Norms: Article 85(3) EUTMR, Article 85(5) EUTMR.

Facts: By decision of 29 November 2016, the Opposition Division issued a decision on costs

stating that according to Article 85(3) EUTMR the party who terminated the proceeding by withdrawing the opposition had to bear the costs incurred by the other party.

On 30 November 2016, the opponent appealed this decision on costs. It reiterated that 'no decision of costs is required, because each party shall bear its own costs and expenses in relation to the above referenced opposition proceedings'.

Substance: Article 85(3) EUTMR provides that a party who withdraws the opposition shall bear the fees and costs incurred by the other party. Article 85(5) EUTMR stipulates that where the parties have reached an agreement on costs, the Board shall take note of such agreement. However, in the present case, the Office has not received confirmation from both parties on a cost agreement (§ 13).

Consequently, the appeal must be dismissed and the contested decision becomes final, including the decision on costs (§ 14).

Case citation: [2/5/2017](#), [R 2245/2016-5](#), [ecoparts automotive quality \(fig.\) / ECO PARTS](#)

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R0019/2016-4 Maico M (fig.)

EUTMA



Result: Decision annulled.

Keywords: Admissibility, Distinctive element, Dominant element, Evidence of use, Figurative element, New submission on appeal, Press articles, Relevant territory, Revocation grounds, Use not as registered, Well known fact needs no evidence.

Norms: Article 15(1)(a) EUTMR, Article 76(2) EUTMR, Article 51(1)(a) EUTMR.

Facts: The Cancellation Division revoked the contested EUTM for all the goods for which it was registered, except for 'scooters' in Class 12.

The revocation applicant appealed this decision, arguing that the EUTM did not appear in any of the magazines. The word 'MAICO' alone altered the distinctive character of the EUTM – the contested EUTM was never used as registered but only in different forms which altered its distinctive character pursuant to Article 15(1)(a) EUTMR. These conclusions were supported by some new documents submitted together with the statement of grounds.

Substance: Considering the fact that new evidence submitted together with the statement of grounds clashes with the argumentations and evidence submitted by the EUTM proprietor to prove genuine use during the first-instance proceedings, the Board is allowed to take this evidence into consideration (§ 29). A re-assessment of the evidence submitted by EUTM proprietor brings about serious doubts about its reliability – very probably somebody manipulated the Google Street View screenshots, took photos of one location, but from different distances / angles and there are also doubts about the size of the billboards, the prices of the items in question etc. (§ 43, § 60 and § 98). The Board finds that the EUTM proprietor did not reply in a satisfactory way to any of the arguments stated in the statement of grounds. An overall assessment of the evidence does not allow the Board, without resorting to probabilities, speculation or presumptions, to establish that there was genuine use of the EUTM for 'scooters' in the European Union within the relevant period (§ 111). Moreover, the Board also points out that EUTM was not used as registered – the use of this sign alters the distinctive character of the sign within meaning of Article 15(1)(a) EUTMR (§ 84).

The appeal is successful and the contested decision annulled insofar as it considered that genuine use of the EUTM was established for 'scooters'. The EUTM is revoked in its entirety as of 4 March 2014 (§ 112).

Case citation: [26/04/20147](#), [R 19/2016-4](#), [MAICO M \(fig.\)](#)

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R1305/2016-1 Krupnik / Krupnik (fig.) et al.

EUTMA

Krupnik

Earlier trade marks



Result: Decision confirmed.

Keywords: Substantiation of earlier right.

Norms: Rule 19(2)(ii) CTMIR, Article 7(1)(c) EUTMR, Article 37(1) EUTMR, Article 39 EUTMR, Article 40(2) EUTMR.

Facts: An opposition was filed against the EUTM applied for, the word mark 'Krupnik'. The opposition was based on three Polish trade marks as represented above. During the opposition proceedings third-party observations were received

by the Office. The Opposition Division rejected the opposition.

Substance: First, the appeal is rejected because the Opposition Division correctly established that the earlier right had not been substantiated (§ 16). Moreover, the Board notes that as results from Article 40(2) EUTMR, the examination of absolute grounds for refusal may be opened again at a later stage, in particular when third-party observations are filed, in the present case another company (§ 7). Taking into account the facts and evidence, the Board remits the case to the examiner for a re-examination under Article 7 EUTMR (§ 17).

Case citation: [06/03/2017, R 1305/2016-1, Krupnik / Krupnik \(fig.\) et al.](#)

R0885/2016-2 Device of Chinese characters (fig.)

EUTMA

美心食品

Result: Decision confirmed.

Keywords: Nature of use, Proof of use.

Norms: Article 51(1)(a) EUTMR.

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Facts: A request for a declaration of revocation of the registered mark as represented above was submitted. The Cancellation Division revoked the contested EUTM in its entirety stating that there was no evidence of use of the contested EUTM for the registered services in Class 35, moreover the evidence of use for the Class 42 services was insufficient.

Substance: The Board confirms that use of a mark for the sale of foodstuffs does not equal use for the services of wholesale, import and export and preparation of food. The mere fact that a company sells goods to third parties overseas is not sufficient to make that company a provider of wholesale, import and/or export services. (§ 35). The appeal is dismissed.

Case citation: [16/05/2017, R 885/2016-2, DEVICE OF CHINESE CHARACTERS \(fig.\)](#)

R1444/2016-5 Lux* Bodrum, Turkey (fig.)

EUTMA



Result: Decision confirmed.

Keywords: Descriptive element, Laudatory mark.

Norms: Article 7(1)(b) EUTMR, Article 7(1)(c) EUTMR, Article 7(2) EUTMR, Article 7(3) EUTMR.

Facts: The applicant sought to register the figurative mark above for services in Class 43. The examiner refused the EUTM applied for claiming that the sign was descriptive and non-distinctive. As the evidence filed was insufficient the claim of acquired distinctiveness also failed.

Substance: The word 'TURKEY' is an English name for a country in Eurasia where the resort, Bodrum, is situated (§ 17). The term 'LUX' will be understood as 'luxury' in particular by the French-, German-, Polish-, Romanian- and Latvian-speaking public (§ 19-22). The expression as a whole 'LUX* BODRUM TURKEY' has a clear meaning (§ 23).

The examiner correctly considered that the sign was descriptive.

The inclusion of an asterisk and the blue colour do not affect the above findings (§ 32) the mark as a whole is also devoid of any distinctive character.

The Board confirms that on the basis of the evidence filed, it cannot be established that the mark applied for acquired distinctive character by virtue of use (§ 51).

The appeal is dismissed.

Case citation: [05/05/2017, R 1444/2016-5, LUX* BODRUM, TURKEY \(fig.\)](#)

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R2131/2016-1 Winbet online (fig.)



Result: Decision confirmed.

Keywords: Descriptive element, Dominant element, Figurative element.

Norms: Article 7(1)(b) EUTMR, Article 7(1)(c) EUTMR, Article 7(2) EUTMR, Article 37 EUTMR.

Facts: The examiner refused the international registration in part for services in Classes 41 and 42 pursuant to Article 7(1)(b), (c) and Article 7(2) EUTMR.

Substance: The word element of the contested sign is the juxtaposition of basic English terms (§ 16). Waiving exclusive rights to the word 'ONLINE' cannot result in the sign applied for being examined as though that word were not present; waiving exclusive rights to one of the elements does not make it distinctive (§ 22). The services are, or are connected with, activities as regards wagers which can be offered online: The most obvious and direct meaning of the contested mark will be to win on a bet placed online (§ 36). The word component has

a plain meaning and is not arbitrary or fanciful, and lacks any original sequence or structure for online gambling services (§ 48). The relevant public will not tend to perceive in the sign any particular indication of commercial origin (§ 49).

The appeal is dismissed.

Case citation: [02/052017](#), [R 2131/2016-1](#), [WINBET ONLINE](#) (fig.)

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