

Alicante News

Up to date information on IP and EUIPO-related matters

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eAppeal

File an appeal online

April
2017



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New eAppeal : file an appeal online

The new eAppeal, available since 10th April, allows users to file an appeal online. eAppeal is designed to make filing an appeal as efficient as possible, and is part of the Office's commitment to providing high quality electronic services to its users. The new tool offers clear guidance to users, an improved and user-friendly interface and provides a reduced likelihood of deficiencies.

The new eAppeal is the latest step in a journey of digital improvement undertaken by the Office. Starting in 2011, EUIPO began to simplify and modernise its IT systems, making them more efficient and user-friendly.

eAppeal is easy to use and can be accessed directly from the User Area of the EUIPO website, and through the [online services page](#). It can also be entered under Actions and Communications after accessing the file in eSearch plus.

The entire process has just four steps. The first step allows the requester (either the appellant or the representative) to submit their information electronically.

The second step allows the requester to identify the contested trade mark or design decision.

The third step allows the requester to upload a

statement of grounds as an attachment to the form, or to file it later on. The statement of grounds needs to be filed in the language of the proceedings. If a written statement of grounds is not attached to eAppeal, please note that if it is not filed within four months, the appeal will be inadmissible.

The fourth step requires the requester to sign the form by entering his or her name, as described in Rule 79, 80(3) and 82(3) EUTMIR. The signature confirms that the requester has checked all details and wishes to sign and confirm the submission of the Notice of Appeal.

Once the four steps are completed, the user is directed to a payment page, with all payment options (credit card, transfer, current account).

Users can save their work as a draft at any time in the process, and return to it later. Once the Notice of Appeal is submitted, users are requested to download the confirmation copy, which contains the appeal number, and save it locally. The number of the exact Board which will deal with the appeal will be communicated to the appellant or representative at a later stage by the Registry of the Boards of Appeal.

The Office has prepared a number of resources for users on the new eAppeal form. A webinar on eAppeal was broadcast earlier this month; the recording is available to watch [here](#). A full guide to using the form is available [here](#).

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The James Nurton Interview



Ana-Maria Baciú, Partner, NNDKP, Bucharest

What is your background?

I've been a lawyer for 18 years. When I started in the profession, I worked in a small law firm where I mainly did corporate law and real estate. Then I moved to NNDKP 14 years ago in March 2003. When I came here Mr Nestor told me: "You're going to do IP and IT." It was quite a surprise to me – I had only come across trade marks in my previous life, and IP did not come up in my interviews to join Nestor! So it's funny how things started.



Ana-Maria Baciú

I had to learn everything about IP from the beginning, but the same was happening for everyone in Romania. Our IP department was born at that time with me and two other lawyers. I became a partner in 2011 and head of the department. I did a lot of in-house training, and clients also trained us quite quickly, especially international clients. We had to put a lot of effort into meeting their expectations. Now when I read material we drafted 10 years ago, I am surprised to find I am not too disappointed!

I also had some local training and some WIPO training online for trade marks and designs. Luckily I also had the chance to work in a lot of areas. We called the department coordinated by me the "miscellaneous" department so whenever something new comes up it comes to us. As a result we started to do pharmaceutical work, including regulatory law – I was helped by a lawyer from Covington & Burling in Brussels who was very supportive.

Nowadays there are more IP cases in Romania, but mainly on trade marks rather than patents. Back then, we used to go to the Patent and Trade Mark Office every month to copy the opposition decisions – it was not the best but that was all we had to learn from. In Romania, the former state-owned IP company, Rominvent, was the biggest and there were good small boutiques but we were the first general law firm to start a standalone IP practice. We are now 11 people and in 2015 we added a new partner Cosmina Simion.

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The James Nurton Interview



What kind of work do you do?

We do pretty much everything. For example, we are advising a local company called Bitdefender, which is an antivirus provider, on its worldwide re-branding. We were involved from the very first discussions with a marketing agency when they created the new logo. We helped develop the strategy with filing in Romania, using the Madrid System and working with countries that are not part of the Madrid System, coordinating all the professionals in all those countries. The registration process started in 2010 and is not finished yet – it is hard to register the trade mark in some countries, as we have to overcome some objections.

Our team do a lot of trade mark searches for big clients, as well as filing and registration and litigation mainly in trade marks. We do have a lot of pharmaceutical patent cases too, mainly representing generic companies.

It can be frustrating because often it seems we do not manage to convey our point of view to the judges, despite our best efforts. We've had difficult cases in various parts of Romania: in one case, the judge said: "This is my first IP case ever!"

Historically, we used to have specialised courts, but we no longer have them – it was decided there is no need. But the judges are still there, and they still have that IP knowledge. In Bucharest there is a good chance of getting a judge who is familiar with IP.

Trade mark cases are increasing – both standalone cases and appeals from the decisions of the Trade Mark Office. But I am still happier to resolve cases outside of court if we possibly can, whether we are acting for claimant or defendant clients. We have had some complex and long-running cases. We had a case for a major media group which we have resolved: it concerned a local betting shop company, which was infringing the trade mark by using a sign that was similar to our client's trademark. After we brought the case, they settled and agreed to re-brand. It was a good resolution and we didn't have to go to court.

How did you come to specialise in gaming law?

In 2009, online gaming was officially forbidden in Romania. Nobody knew how to answer the questions we were getting from clients, and as we were the miscellaneous department they came to me. The legislation in Romania finally changed in 2014 and now we do have an online market, and most of the big players are here. The gaming practice is now as important as IP, though we don't know if it will stay like that. So far, every year it has proved us wrong. Initially it was all about getting licences and getting permission to operate in Romania and now it is a mix of regulatory, IP, advertising and media law.

The gaming law market is very small and only a few lawyers are active. We go to the big IP conferences and the big gaming conferences and they are very similar in size. The big gaming conferences such

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as ICE are very visual, with lots of machines and exhibits. The two areas can overlap: we had one gaming provider who wanted to buy a website, and we were able to advise on the IP and domain name as well as M&A issues.

Turning to trade marks, how do the European and Romanian systems compare?

They are similar. The work in Alicante is more reliable: I may like the decision or not, but I know that in a similar case the decision will be similar. I don't have that security in Romania: the cases are less predictable. In Romania we had two cases for different defendants, who were both sued for patent infringement by a global innovative healthcare company. The cases were identical. On the preliminary injunction, we won one case and lost the other one. It's difficult to explain to clients. We don't have the case law but still you expect that judges from the same court will look at each other's decisions.

We rely on the General Court and CJEU decisions, as well as the decisions from the EUIPO. But there is no guarantee that the courts in Romania will follow them. There are a lot of examiners, and each thinks independently and can reach different conclusions. By contrast, the EUIPO is more consistent – even if we do not always agree with what they say.

Do you file many EU trade marks?

If we have to choose, we always recommend EUIPO

to clients unless they are purely local clients. If they are interested in targeting other countries in the EU, then we recommend going to EUIPO. You have to beware that there may be other rights in other countries and that is a risk, but clients are aware of that and of course you can always turn to local registrations if something goes wrong.

We also use the Madrid System. As I mentioned, the BitDefender rebranding would have been a nightmare without the Madrid System: it was very efficient and cost-effective. It is good and I expect it will add more countries and it will become even easier. The countries that are not part of the System have been the most difficult for us. We turn to local attorneys when there is a procedure in the local country. Other than that, we can manage everything from here in Bucharest.

What impact will the new Trade Mark Directive have in Romania?

I'm not sure when it will lead to changes. Unfortunately, I think political will in Romania is more concerned with other issues at the moment.

More generally, I think there are some improvements needed in trade mark law. In Romania, you can only cancel a trade mark within five years of registration and after that only in cases of bad faith – which is quite difficult to prove. We had raised this issue in a case in court and we are awaiting the decision. We argued that the five-year limit is contrary to EU law, and the client was brave to take that. Hopefully we will get the decision later this year.

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

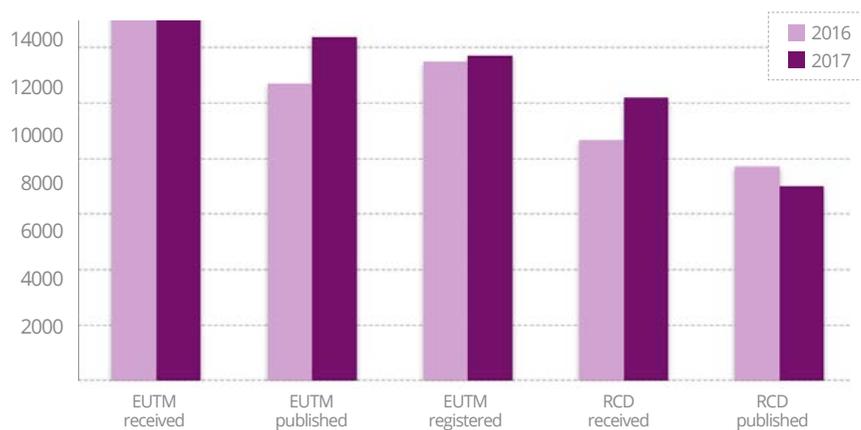


Statistical Highlights



Monthly statistical highlights March*	2016	2017
European Union Trade Mark applications received	13935	13615
European Union Trade Mark applications published	10701	12373
European Union Trade Marks registered (certificates issued)	11471	11715
Registered Community Designs received	8651	10184
Registered Community Designs published	7706	7025

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



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IP Key China closure event in Beijing

IP Key, the EU-funded project with China implemented by EUIPO, is coming to an end in June.

On the occasion of the EU-China IP Working Group meeting held on 20 April in Beijing, the Office organised a stakeholder event to mark the success of the IP Key project.

EUIPO was joined by high ranking officials from DG Trade and the Chinese Ministry of Commerce to welcome more than 120 European and Chinese stakeholders.

The event featured a presentation wrapping up the more than 250 activities implemented by EUIPO/IP Key over the past four years.

USPTO implements Forecasting

The United States Patent and Trademark Office (USPTO) has implemented the Forecasting tool for trademarks.

21 EU IP offices across the European Union Intellectual Property Network currently use the Forecasting tool, which allows IP offices to generate forecasts of trade mark and design filings using the latest available technologies.

The USPTO is the first IP office outside the EU to adopt the tool as one of its forecasting methodologies.

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Death of former President of EUIPO Wubbo de Boer

The Office is deeply saddened to inform of the death of the former President of the EUIPO, Mr Wubbo de Boer.

As President of the EUIPO from 2000 to 2010, Mr de Boer was a keen advocate of the importance of the Internet and of putting users at the centre of the Office's activities.

During his two mandates, he led the process of introducing a published Service Charter and the first trade mark e-filing tool, leaving the Office with an enduring legacy that has contributed to its current success.

A Dutch national, prior to joining the Office, Mr de Boer was a career public servant, holding senior posts in the Dutch Ministries of Transport and Economic Affairs.

The Office extends its sincere condolences to his family, friends and colleagues.

IP Case Law Laboratory

On 12 June, EUIPO will hold its first ever Case Law Laboratory, aimed at professionals in the field of trade mark and design law.

The event will focus on a variety of select, essential and relevant legal topics such as non-traditional trade marks, functional trade marks and designs, national law rights in the context of Article 8(4) EUTMR and challenges involving disclosure of designs.

The event aims to help participants to exchange views and develop a common, in-depth understanding of essential legal issues that are relevant to both the private sector and the Office.

The event will be divided into two sessions. At the morning session, topics will be analysed and discussed in four separate interactive working groups under the guidance of EUIPO staff, accompanied by practitioners and industry professionals with 'hands on' experience.

The afternoon session will involve debate and discussion on the topics by all participants.

The conference fee is EUR 100 and a participation certificate will be issued after the conference. Registration details are available [here](#).

Annual audit of EUIPO activities

EUIPO has successfully completed a full re-certification audit of all its activities, namely for quality (ISO 9001), information security (ISO 27001), environment (EMAS), health and safety

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(OHSAS 18001) and universal accessibility (UNE 170001).

The auditors' feedback was positive in all these areas. They noted with satisfaction that the Office had acted on their observations and solved the minor issues raised at the last audit.

ISO 9001 is the one of the most prestigious quality management standards worldwide. In 2009, the Office achieved the ISO 9001 standard for all design-related activities. In 2012, the scope of certification was extended to cover all trade mark process and, in October 2013, the Office achieved certification for all its activities.

The EUIPO's information security policy is based on ISO 27001. This is a world-class management standard that provides a methodology for managing information security. The Office has been certified to ISO 27001 standard since 2004.

The EUIPO also belongs to the EU Eco-Management and Audit Scheme (EMAS), which is a management tool for evaluating, reporting on and improving environmental performance, and is certified to universal accessibility standard UNE 170001, which promotes universal access as a means of achieving equal opportunities in the workplace.

OHSAS 18001:2007 helps organisations better control occupational health and safety risks, while

improving overall performance. The EUIPO has held this standard since 2013.

Key User Programme: Advanced IP Management

The Key User Programme at EUIPO is specially designed for users with a current account, offering them new ways to communicate with the Office. It also provides an improved User Area with business analytics and specialised guidance with dedicated support from the Key User team.

Users need to hold a current account and have [eCommunications](#) activated to participate in the programme, and should also use the online registration solutions provided by EUIPO.

The programme allows users to access an advanced User Area with details on filing and eCommunication statistics, and also offers real-time information on payment status, with automatic fee debits.

Users can unlock tailored training courses on EUIPO's online tools and Office practice, as well as keeping up to date via a dedicated news feed and a special newsletter.

[Find out more.](#)

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Luxembourg trade mark and design news

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

Case C-577/14P; Brandconcern BV v EUIPO and Scooters India Ltd; Judgment of 16 February 2017;

Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Proof of use, Extent of use

FACTS: The intervener was the proprietor of EU trade mark **LAMBRETTA**, registered by EUIPO on 6 August 2002 for, inter alia, 'vehicles; apparatus for locomotion by land, air or water' in Class 12. The applicant requested the revocation of the trade mark for lack of genuine use pursuant to Article 51(1)(a) and (2) EUTMR. The Cancellation Division (CD) partially upheld the application and revoked the trade mark **LAMBRETTA** in respect of the goods in Class 12. The Board of Appeal (BoA) dismissed the EUTM proprietor's appeal, applying the so-called 'literal approach' to Class headings. Since the evidence of use submitted by Scooters India was limited to the sale of spare parts (and not to vehicles or apparatus for locomotion), the BoA found that 'it

cannot be inferred from the sale of spare parts that [Scooters India] has also manufactured and sold ... any vehicle'.

The EUTM proprietor filed an action before the General Court (GC) alleging infringement of Article 51(2) EUTMR. The GC upheld the appeal and found that, even if spare parts for scooters did not actually appear in the alphabetical list of goods in Class 12, the BoA had to examine whether or not there had been genuine use of that mark in respect of the many fittings and parts listed therein.

The revocation applicant filed an action before the Court of Justice of the European Union (CJ) seeking the annulment of the GC judgment on the basis that there was no temporary limitation of the effects of the IP Translator judgment (IPT). The CJ dismissed the appeal.

EUTM

LAMBRETTA

SUBSTANCE: The CJ referred to paragraph 61 of IPT judgment, where it was established that if the applicant for a trade mark uses the heading of a particular class of the Nice Agreement to identify the goods and services covered by the mark applied for, it must be specify whether the application for registration is intended to cover all the goods or

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services included in the alphabetical list or only some of them (para. 28). In this regard, the CJ upheld the Office submission that IPT did not concern the proprietors of registered trade marks, but solely applicants for trade marks (para. 29). Therefore, the rule set out in paragraph 61 of IPT is not applicable to the registration of the trade mark **LAMBRETTA**, which took place before the delivery of IP Translator judgement (para. 31). Consequently, the CJ considered that the GC was not wrong in finding that the words ‘vehicles; apparatus for locomotion by land, air or water’ in the trade mark application filed on 7 February 2000 must be interpreted as seeking to protect the mark **LAMBRETTA** in respect of all the goods in the alphabetical list in Class 12 (para. 32). The CJ also upheld the Office’s practice regarding Class Headings, namely Communications No 4/03 and 2(12) (paras. 31 and 32).

Case C-598/14P; EUIPO v Gilbert Szajner; Judgment of 5 April 2017;

Language of the case: FR

RESULT: Appeal dismissed

KEYWORDS: Principle of legality, Sign used in the course of trade

FACTS: The holder of the contested EUTM registration had submitted, for the first time before the General Court (GC), a judgment of the French

Cour de cassation adopted after the Board’s o Appeal (BoA) decision and which supported the view that the scope of protection of a corporate name is defined by reference to the business actually carried out by a company. The GC had considered this judgment admissible and had reviewed the legality of the BoA’s decision in its light. This led the GC to annul in part the BoA’s decision (T-453/11, 21 October 2014). The Office had lodged an appeal before the Court of Justice of the European Union (CJ) on two accounts: violation of Article 65(2) EUTMR in that the legality of the BoA’s decision was examined in the light of subsequent circumstances and violation of Article 8(4) in that the GC had failed to apply properly the French law.

SUBSTANCE: The CJ dismisses the appeal. The CJ confirms that in reviewing the correct application of national law under Article 8(4) EUTMR, the GC has competence to make searches ex officio in the national case-law ‘beyond the documents submitted’ in order to make up for the parties’ ‘possible lacunae in the documents submitted as evidence of the applicable national law’ (para. 38). The GC may also take into account national judgments handed down **after** the adoption of the BoA’s decision failing which the GC would be deprived “of the real possibility of conducting in an effective manner the full review of legality” and would not be in position to comply with the principle of effective judicial protection (para. 41-42). “It is true that the taking into consideration of a decision

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of a national court issued after the adoption of the decision of the Board of Appeal of EUIPO could lead the General Court to undertake an assessment of a rule of national law which differs from that of that Board of Appeal. However, since the judicial review of the assessment of national law by that Board of Appeal, conducted by the General Court, would be a full review of legality, the fact — revealed after the adoption of the decision of the same Board of Appeal — that that decision was based on an incorrect interpretation of national law cannot (...) prevent that error from being corrected” (para. 43). Regarding the second plea, the CJ confirms that its review is limited to verifying that the GC did not make a manifest error in applying the national law (para. 56) and that no such manifest error could be found in the manner in which the GC interpreted the French judgment of the Cour de cassation (paras. 59-62). According to the CJ, the GC correctly applied the French law in determining the scope of protection of a corporate name by reference to activities concretely carried out by a company (as opposed to the activities merely mentioned in the company’s articles of incorporation. The GC did not make any error in defining the activities of the cancellation applicant on account, not only of the nature of the goods which this cancellation applicant markets, but also of their intended use, purpose, customers and distribution channels (para. 70).

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

Case T-741/14; Hersill SL v EUIPO; Judgment of 14 March 2017;

Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Burden of proof, Proof of use, Declaration, Catalogue

FACTS: The applicant sought to register the word mark **VACUP** as an EUTM for goods in Class 10. An opposition based on the earlier word marks, MINIVAC and V.A.C, registered for goods in Classes 5 and 10, was filed pursuant to Article 8(1)(b) and (5) EUTMR. The applicant made a request under Article 42(2) and (3) EUTMR for the intervener to prove that the earlier marks had been put to genuine use. The Opposition Division (OD) rejected the opposition on the ground that the intervener had failed to prove genuine use of the earlier marks. The Board of Appeal (BoA) annulled the OD’s decision and upheld the opposition. The applicant filed an action before the General Court (GC) relying on three pleas in law, alleging (i) infringement of Article 42(2) and (3) EUTMR and Rule 22(3) of CTMIR; (ii) infringement of the principles of legal certainty and protection of legitimate expectations; and (iii) infringement of Article 8(1)(b) EUTMR.

SUBSTANCE: The GC checked whether the BOA correctly found that the earlier marks had been put

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to genuine use during the relevant period The GC confirmed that the invoices were irrelevant because their dates were outside the relevant period (paras. 26-28) The BoA had found that the pre-formulated declarations, as well as the catalogues, the information concerning the intervener's products and the advertisements corroborated the affidavit made by an employee of the intervener and established the genuine use of the mark **V.A.C.** during the relevant period (para. 32). However, the GC stated that the pre-formulated declarations describe the use of the marked products by the relevant public but not the use of that mark by its proprietor on the market. Consequently, they cannot establish by themselves the use of the mark **V.A.C.** during the relevant period (para. 34). Furthermore, a large number of catalogues and advertisements show that the mark **V.A.C.** was used with additional word elements liable to alter the distinctive character of that mark, so that genuine use of that mark could not be established (para. 37). As a result, according to the GC, the items of evidence were insufficient to allow the BoA to consider that the mark **V.A.C.** had been put to genuine use during the relevant period (para. 41).

Joined Cases T-766/15 and T-767/15; Labeyrie v EUIPO; Judgments of 28 February 2017;

Language of the case: FR

RESULT: Action dismissed



KEYWORDS: Use not as registered

FACTS: The Board of Appeal confirmed Cancellation Division's finding that the two contested EUTMs were to be revoked for all goods in Classes 29, 30 and 31 since they have been used in respect of fish only, and in a way which alters their distinctive character.



SUBSTANCE: The General Court (GC) dismisses the action. The GC takes the position that the less inherently distinctive a sign, the more probable it is that a use together with additional elements which are potentially more distinctive would alter this sign's distinctive character (para. 22 and the odd reference to the judgment in T-317/14 which was annulled by the Court of Justice in C-642/15P for lack of reasoning). The GC acknowledges that the two EUTMs, despite being registered as figurative marks, may be contour less (para. 27). The GC also confirms that the repetitive pattern of stylised fish is distinctive to a low degree only (paras. 29-33). A survey concerning the market recognition of the applicant's packaging is irrelevant because it is limited to France (para. 36). Use of signs in combination with others does not necessarily alter their distinctive character.

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In this case, however, the superimposition of the sign LABEYRIE, which is also registered as a mark (para. 47), on the repetitive pattern alters the EUTMs' distinctive character because 'LABEYRIE' is comparatively more distinctive and eclipses the pattern (paras. 51-54). The public will perceive the EUTMs as mere backgrounds having an ornamental function rather than as distinctive signs (para. 59). 'The weak degree of distinctive character of the contested mark is easily altered by the adjunction of an element such as the mark LABEYRIE which is in itself distinctive' (para. 60).

Case T-513/15; Gruppe Nymphenburg Consult AG. v EUIPO; Judgment of 16 February 2017;

Language of the case: DE

RESULT: Decision upheld (BoA decision annulled)
KEYWORDS: Descriptive element

FACTS: The applicant sought to register the word mark **Limbic® Map** as EUTM for goods and services in Classes 16, 35 and 41. The Office refused the registration of the EUTM application (EUTMA) for part of the goods and services in above mentioned Classes pursuant to Article 7(1)(b) and (c) EUTMR, as it was found to be devoid of distinctive character and descriptive. The Board of Appeal (BoA), in a single member decision, dismissed the applicant's appeal, basing its decision solely on Article 7(1)(c) EUTMR.

It took the view that 'Limbic' refers to the 'limbic system', which describes the area of the brain which influences hormonal control and the automatic nervous system and is responsible for emotional responses to environmental stimuli, such as instincts and emotions (fear, pleasure, anger) and drives (hunger, sex, dominance, care of offspring). 'Map' is the English term for a chart, plan, diagram etc. As a whole, the expression 'Limbic® Map' is understood by the relevant public such that the goods and services applied for constitute, contain, use or are intended for the creation of a map of the limbic system. Therefore, there exists a sufficiently direct and concrete connection between the goods and services and the EUTMA to render the application descriptive (Article 7(1)(c) EUTMR) and to refuse its registration already for this reason. The applicant filed an action before the General Court (GC), relying on 2 pleas in law, namely a violation of Article 7(1)(c) EUTMR and of Articles 63, 75 and 76 EUTMR.

EUTMA

Limbic® Map

SUBSTANCE: The GC endorsed the BoA's findings that the relevant public consists of both the English speaking general public and a specialized public in the context of artist supplies (Class 16) and

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consulting/management/administration services (Classes 35, 41) – a public, which is, however, not particularly specialized in the medical field (paras. 24-28). However, the GC found that the BoA did not sufficiently prove that the relevant public will – without further mental steps being necessary – establish an immediate and concrete descriptive connection between the EUTMA and the goods and services at issue. First, the GC found the combination of the three elements of the mark to be unusual with regard to the goods and services at issue. The various definitions provided show that ‘limbic’ in the English language is normally used as part of the well-known expressions ‘limbic system’ or ‘limbic lobe’. In the present case, however, ‘limbic’ has been removed from the expression usually conveying sense to it, and therefore has been deprived of a clear and direct meaning (paras. 38-41). Furthermore, the combination of ‘limbic’ with the remaining elements ‘®’ and ‘Map’ is not common in the structure of the English language. Therefore, the impression the expression conveys in its entirety departs from the impression generated by the mere addition of the three elements (para. 42). Second, the GC stressed that ‘limbic’ is a highly specialized medical/neurological term. It is not proven that the relevant public, which does not comprise medical professions, will understand ‘limbic’ directly and without further mental steps as describing an area of the brain which influences hormonal control and the automatic nervous system and is responsible for emotional responses to environmental stimuli.

Furthermore, it is not proven that the relevant public will, without the need for further reflection, understand the combination of the three elements as a map, describing the region of the brain, which influences the hormonal control and the automatic nervous system. Finally, it is not sufficient for an assumption of descriptiveness that the relevant services can constitute, contain, use or are intended for the creation of a map of the limbic system (paras. 43-46). Irrespective of the unusual combination in which ‘limbic’ is used and which blurs its direct meaning, it is not proven that the average specialized public, particularly in the field of sales, staff management, education, training and publishing, when confronted with highly specialized medical vocabulary, will not have to go through a time consuming interpretation process in order to understand the sense of the EUTMA for the goods and services in question. Such an interpretation process cannot be reconciled with the recognition of a descriptive character, which has to be discernible immediately and without further thinking. The considerations with regard to a necessary interpretation process apply all the more for the non-specialised public (paras. 47-49). Consequently the BoA’s findings that **Limbic® Map** will be understood as reference to goods and services, which constitute, contain, use or are intended for the creation of a map of the limbic system is as erroneous as the BoA’s finding that the EUTMA has a sufficiently direct and immediate link with the relevant goods and services. The contested

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decision violates Article 7(1)(c) EUTMR and is to be annulled irrespective of the claimed violation (also of Article 7(1)(b) EUTMR (paras. 51-54). As the BoA's decision was only based on Article 7(1)(c) EUTMR, it is not the task of the GC in the context of the review of the legality of the contested decision to decide on a violation of Article 7(1)(b) EUTMR for the first time. Should the wording of the contested decision have to be interpreted as denying the distinctiveness of the EUTMA in the sense of Article 7(1)(b) EUTMR, these findings would, in any event, lack any reasoning and, for this reason, would lead to annulment of the contested decision (paras. 55-57). Based on the foregoing, the contested decision was annulled.

Case T-516/15; Gruppe Nymphenburg Consult AG. v EUIPO; Judgment of 16 February 2017;

Language of the case: DE

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Descriptive element

FACTS: The applicant sought to register the word mark **Limbic® Types** as EUTM for goods and services in Classes 16, 35 and 41. The Office refused the registration of the EUTM application (EUTMA) for part of the goods and services in above mentioned classes pursuant to Article 7(1)(b) and (c) EUTMR, as it was found to be devoid of distinctive character and descriptive. The Board of Appeal (BoA), in a single member

decision, dismissed the applicant's appeal, basing its decision solely on Article 7(1)(c) EUTMR. It took the view that 'Limbic' refers to the 'limbic system', which describes the area of the brain which influences hormonal control and the automatic nervous system and is responsible for emotional responses to environmental stimuli, such as instincts and emotions (fear, pleasure, anger) and drives (hunger, sex, dominance, care of offspring). The English word 'Types' may be defined as the general form, structure or character distinguishing a particular kind, group or class of beings or objects from others. As a whole, the expression 'Limbic® Types' is understood by the relevant public as 'different personality types, which respond differently to stimulation of the limbic system' and is therefore potentially capable of describing the goods and services at issue. Therefore, there exists a sufficiently direct and concrete connection between the goods and services and the EUTMA to render the application descriptive (Article 7(1)(c) EUTMR) and to refuse its registration already for this reason. The applicant filed an action before the General Court (GC), relying on 2 pleas in law, namely a violation of Article 7(1)(c) and of Articles 63, 75 and 76 EUTMR.

EUTMA

Limbic® Types

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SUBSTANCE: The GC endorsed the BoA's findings that the relevant public consists of both the English speaking general public and a specialized public in the context of artist supplies (Class 16) and consulting/management/administration services (Classes 35, 41) – a public, which is, however, not particularly specialized in the medical field (paras. 24-28). However, the GC found that the BoA did not sufficiently prove that the relevant public will – without further mental steps being necessary – establish an immediate and concrete descriptive connection between the EUTMA and the goods and services at issue. First, the GC found the combination of the three elements of the mark to be unusual with regard to the goods and services at issue. The various definitions provided show that 'limbic' in the English language is normally used as part of the well-known expressions 'limbic system' or 'limbic lobe'. In the present case, however, 'limbic' has been removed from the expression usually conveying sense to it, and therefore has been deprived of a clear and direct meaning (paras. 38-41). Furthermore, the combination of 'limbic' with the remaining elements '@' and 'Types' is not common in the structure of the English language. Therefore, the impression the expression conveys in its entirety departs from the impression generated by the mere addition of the three elements (para. 42). Second, the GC stressed that 'limbic' is a highly specialized medical/neurological term. It is not proven that the relevant public, which does not

comprise medical professions, will understand 'limbic' directly and without further mental steps as describing an area of the brain which influences hormonal control and the automatic nervous system and is responsible for emotional responses to environmental stimuli. Furthermore, it is not proven that the relevant public will, without the need for further reflection, understand the combination of the three elements as describing different personality types, which respond differently to stimulation of the part of the brain, which influences hormonal control and the automatic nervous system. Finally, it is not sufficient for an assumption of descriptiveness that the relevant services may be directed at conveying information on different personality types and their modes of behaviour or on how the limbic system influences behaviour (paras. 43-46). Irrespective of the unusual combination in which 'limbic' is used and which blurs its direct meaning, it is not proven that the average specialized public, particularly in the field of sales, staff management, education, training and publishing, when confronted with highly specialized medical vocabulary, will not have to go through a time consuming interpretation process in order to understand the sense of the EUTMA for the goods and services in question. Such an interpretation process cannot be reconciled with the recognition of a descriptive character, which has to be discernible immediately and without further thinking. The considerations with regard to a necessary interpretation process apply all the more for the non-specialised public (paras. 47-49).

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Consequently the BoA's findings that **Limbic® Types** will be understood as reference to different personality types, which respond differently to stimulation of the limbic system is as erroneous as the BoA's finding that the EUTMA has a sufficiently direct and immediate link with the relevant goods and services. The contested decision violates Article 7(1)(c) EUTMR and is to be annulled irrespective of the claimed violation (also) of Article 7(1)(b) EUTMR (paras. 51-54). As the BoA's decision was only based on Article 7(1)(c) EUTMR, it is not the task of the GC in the context of the review of the legality of the contested decision to decide on a violation of Article 7(1)(b) EUTMR for the first time. Should the wording of the contested decision have to be interpreted as denying the distinctiveness of the EUTMA in the sense of Article 7(1)(b) EUTMR, these findings would, in any event, lack any reasoning and, for this reason, would lead to annulment of the contested decision (paras. 55-57). Based on the foregoing, the contested decision was annulled.

Case T-517/15; Gruppe Nymphenburg Consult AG. v EUIPO; Judgment of 16 February 2017;

Language of the case: DE

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Descriptive element

FACTS: The applicant sought to register the word mark **Limbic® Sales** as EUTM for goods and services in Classes 16, 35 and 41. The Office refused the registration of the EUTM application (EUTMA) for part of the goods and services in above mentioned classes pursuant to Article 7(1)(b) and (c) EUTMR, as it was found to be devoid of distinctive character and descriptive. The Board of Appeal (BoA), in a single member decision, dismissed the applicant's appeal, basing its decision solely on Article 7(1)(c) EUTMR. It took the view that "Limbic" refers to the "limbic system", which describes the area of the brain which influences hormonal control and the automatic nervous system and is responsible for emotional responses to environmental stimuli, such as instincts and emotions (fear, pleasure, anger) and drives (hunger, sex, dominance, care of offspring). 'Sales' is the English term for the German word 'Verkauf'. As a whole, the expression 'Limbic® Sales' is understood by the relevant public such that the goods and services applied for are connected with 'sales activities, which relate to the limbic system' and is, thus, potentially capable of describing the goods and services at issue. Therefore, there exists a sufficiently direct and concrete connection between the goods and services and the EUTMA to render the application descriptive (Article 7(1)(c) EUTMR) and to refuse its registration already for this reason. The applicant filed an action before the General Court (GC), relying on 2 pleas in law, namely a violation of Article 7(1)(c) and of Articles 63, 75 and 76 EUTMR.

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EUTMA

Limbic® Sales

SUBSTANCE: The GC endorsed the BoA's findings that the relevant public consists of both the English speaking general public and a specialized public in the context of artist supplies (Class 16) and consulting/management/administration services (Classes 35, 41) – a public, which is, however, not particularly specialized in the medical field (paras. 24-28). However, the GC found that the BoA did not sufficiently prove that the relevant public will – without further mental steps being necessary – establish an immediate and concrete descriptive connection between the EUTMA and the goods and services at issue. First, the GC found the combination of the three elements of the mark to be unusual with regard to the goods and services at issue. The various definitions provided show that 'limbic' in the English language is normally used as part of the well-known expressions 'limbic system' or 'limbic lobe'. In the present case, however, 'limbic' has been removed from the expression usually conveying sense to it, and therefore has been deprived of a clear and direct meaning (paras. 38-41). Furthermore, the combination of 'limbic' with the remaining

elements '@' and 'Sales' is not common in the structure of the English language. Therefore, the impression the expression conveys in its entirety departs from the impression generated by the mere addition of the three elements (para. 42). Second, the GC stressed that 'limbic' is a highly specialized medical/neurological term. It is not proven that the relevant public, which does not comprise medical professions, will understand 'limbic' directly and without further mental steps as describing an area of the brain which influences hormonal control and the automatic nervous system and is responsible for emotional responses to environmental stimuli. Furthermore, it is not proven that the relevant public will, without the need for further reflection, understand the combination of the three elements as referring to sales activities in connection with the part of the brain, which influences hormonal control and the automatic nervous system. Finally, it is not sufficient for an assumption of descriptiveness that the relevant services may be directed at conveying information about controlling purchasers' behaviour and influencing customers' emotions, which are controlled by the limbic system (paras. 43-46). Irrespective of the unusual combination in which "limbic" is used and which blurs its direct meaning, it is not proven that the average specialized public, particularly in the field of sales, staff management, education, training and publishing, when confronted with highly specialized medical vocabulary, will not have to go through a time consuming interpretation

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process in order to understand the sense of the EUTMA for the goods and services in question. Such an interpretation process cannot be reconciled with the recognition of a descriptive character, which has to be discernible immediately and without further thinking. The considerations with regard to a necessary interpretation process apply all the more for the non-specialised public (paras. 47-49). Consequently the BoA's findings that **Limbic@Sales** will be understood as reference to sales activities, which relate to the limbic system is as erroneous as the BoA's finding that the EUTMA has a sufficiently direct and immediate link with the relevant goods and services. The contested decision violates Article 7(1)(c) EUTMR and is to be annulled irrespective of the claimed violation (also) of Article 7(1)(b) EUTMR (paras. 51-54). As the BoA's decision was only based on Article 7(1)(c) EUTMR, it is not the task of the GC in the context of the review of the legality of the contested decision to decide on a violation of Article 7(1)(b) EUTMR for the first time. Should the wording of the contested decision have to be interpreted as denying the distinctiveness of the EUTMA in the sense of Article 7(1)(b) EUTMR, these findings would, in any event, lack any reasoning and, for this reason, would lead to annulment of the contested decision (paras. 55-57). Based on the foregoing, the contested decision was annulled.

Case T-621/15; Tractel Greifzug GmbH v EUIPO; Judgment of 5 April 2017;

Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Technical result, Three dimensional mark

FACTS: The Cancellation Division rejected the request for a declaration of invalidity based upon absolute grounds of invalidity (Articles 7(1)(e)(ii) and (b) EUTMR). The Board of Appeal (BoA) upheld the appeal and invalidated the contested mark on the basis of Article 7(1)(e)(ii) EUTMR, observing that the contested mark would, in any event, also have to be invalidated on the basis of Article 7(1)(b) EUTMR.

EUTM



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SUBSTANCE: The General Court (GC) dismissed the action, confirming the BoA's finding that the contested trade mark – which indisputably corresponds essentially to the illustration of the 'Tirak' rope winch produced by the EUTM proprietor with the four components of motor, gears, control unit and traction sheave – consists of a shape whose essential characteristics perform a technical function. This would also be the case of the vertically and horizontally arranged ribs on the shape of the engine if these were to be considered as either as an essential characteristic, or as an aesthetic element, of the shape given that these would, or at least could, perform the function of cooling the engine (paras. 24-26). The existence of alternative forms is irrelevant in that respect (paras. 27-29).

Case T-21/16; Karl Conzelmann GmbH + Co. KG v EUIPO; Order of 14 March 2017;

Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Slogan mark, Laudatory mark

FACTS: The EUTM applicant sought to register the word mark LIKE IT as a EUTM for goods in Classes 3, 18, 24 and 25. The examiner refused the application on the basis of lack of distinctive character in respect of all the goods. The Board of Appeal (BoA) dismissed the appeal. The EUTM applicant

filed an application before the General Court (GC) for the annulment of the decision of the BoA.

EUTMA

LIKE IT

SUBSTANCE: The applicant admitted that the slogan may be perceived in the meaning of 'you should like it! Buy it!'. Therefore, the GC confirmed the findings of the BoA that the slogan will be perceived as an incitement to like the goods (para. 28). The GC found that at least part of the relevant public will perceive the expression as a request to purchase the goods applied for due to its conjugation in the way of an imperative, even though an exclamation mark is lacking (paras. 30 and 31). A further meaning of the expression in the sense of 'the same as it' or 'similar to it' does not render the sign distinctive as a sign must be refused registration if at least one of its possible meanings lacks distinctiveness (paras. 33-38). Previous registrations of EUTM's with the elements 'like' or 'love it' are not binding (paras. 39-43).

Case T-76/16; Ikos GmbH v EUIPO; Order of 1 March 2017;

Language of the case: DE

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RESULT: Action dismissed

KEYWORDS: Descriptive element

FACTS: The applicant sought to register the word mark **AEGYPTISCHE ERDE** as a EUTM for goods in class 3 (Make up, bronze powder etc.). 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 German end consumers with an average level of attention, directly describes that the goods are or consist of Egypt powder/clay. The trade mark is also non-distinctive, as it exclusively consists of a laudatory message, praising the qualities and special features of the goods in question. The applicant filed an action before the General Court (GC). It argues, that the BoA violated Article 7(1)(c) EUTMR by stating that the goods at stake do contain clay from Egypt – when, in fact, the goods do not necessarily have this territorial origin.

EUTMA

AEGYPTISCHE ERDE

SUBSTANCE: The GC stressed that the BoA decision, which fully confirmed the first instance decision, is to be read in conjunction with the examiners findings

that “Aegyptische Erde” is widely known by the relevant public as a cosmetic product made of clay, namely a bronze/terracotta powder, which has been used for millenniums, amongst others by ancient Egyptian pharaohs. The applicant misinterpreted the contested decision when it inferred that the BoA had found a descriptive character with regard to the geographical origin of the clay used for the goods at stake, rather than a mere indication of the goods’ nature and consistence (paras. 29, 30). The connection between the EUTMA and the goods at issue is sufficiently close and direct to allow the relevant public to immediately grasp the descriptive character of the mark (para. 33). Based on the foregoing, the action was dismissed as obviously unfounded.

Case T-216/16; Vignerons de la Méditerranée v EUIPO; Judgments of 23 March 2017;

Language of the case: FR

RESULT: Action dismissed

KEYWORDS: Admissibility, Similarity of the signs, Similarity of the goods and services, Likelihood of confusion

FACTS: The applicant sought to register a figurative mark represented below as an EUTM for goods in Class 33. An opposition based on the earlier word mark registered for goods in Class 33 was filed pursuant to Article 8(1)(b) EUTMR. The Opposition

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Division (OD) upheld the opposition. The Board of Appeal confirmed OD's finding that there is likelihood of confusion (LOC) in the English-speaking parts of the EU in view of the identity/similarity of the goods and the fact that the dominant element 'VAL' of the earlier mark coincides with the dominant element of the mark applied for.

the element 'VAL' has no clear meaning in English (at best a poetic meaning, para. 35), that the term 'VIÑA' is poorly distinctive even in English-speaking Member States (para. 62), and that the figurative element of the contested mark is essentially ornamental (para. 52). Consumers of alcoholic beverages pay less attentive to decorative elements (para. 58). The signs are visually and aurally similar to an average degree (paras. 70 & 78) while there are elements of conceptual dissimilarity (the earlier mark refers to 'vineyard' while the contested mark denotes religion and French origin) (para. 86). Such elements of conceptual differentiation do not, however, offset the elements of similarity (para. 95). There is LOC even if the signs denote different geographical rather than business origins (para. 100).



SUBSTANCE: The General Court (GC) dismisses the action. On the procedure, the GC confirms that new documents submitted for the first time before it and aiming at showing that the term 'VAL' is commonly used for wines in the EU are inadmissible. Whereas new documents can be admissible if they seek to establish a well-known fact, this does not apply to the alleged widespread use of the term 'VAL' in the wine sector, because this fact is not well-known (para. 40). New documents are not admissible either only because they support an argument previously submitted before the Office (para. 42). On the substance, the only point of discussion was the similarity of the signs. The GC notes that

Case T-18/16; DMC Srl v EUIPO - Etike' International Srl; Judgment of 16 February 2017;

Language of the case: IT

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Distinctive element, Dominant element, Common element, Phonetic similarity, Visual similarity

FACTS: The applicant sought to register the figurative mark shown below as an EUTM for, inter alia, beers in Class 32 and wines and alcoholic beverages in Class 33. An opposition based on the

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earlier EU word mark ORGOGLIO, covering, inter alia, beers in Class 32 and alcoholic beverages in Class 33, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition. The Fifth Board of Board of Appeal (BoA) dismissed the appeal filed against the above decision and confirmed that there was a likelihood of confusion between the marks at issue. The applicant filed an action before the General Court (GC).

EUTMA	Earlier trade mark
	ORGOGGIO

SUBSTANCE: The applicant put forward one plea in law: infringement of Article 8(1)(b) EUTMR. The GC confirmed firstly, contrary to the applicant's opinion, that the relevant public is the public at large in the Union with an average level of attention (paras. 22-26). The GC then dismissed the argument of the applicant that the goods in question are similar to an average degree and confirmed that they are identical (paras. 27-30). As far as the comparison of the signs is concerned, the GC noted that, although the element 'De Giusti' is visually outstanding in the mark applied for, due to its size and its distinctiveness, the word 'ORGOGGIO'

is not negligible in the overall impression of that mark. The GC dismissed the applicant's argument that the Italian word 'ORGOGGIO' (pride) is descriptive of the goods at issue, in particular wines. That word is not directly descriptive of any characteristics of those goods (paras. 33-37). The GC confirmed that that the signs are moderately similar from a visual point of view, taking into particular account the fact that they coincide in the word element 'ORGOGGIO', which reproduces the earlier mark in its entirety (paras. 33-37). The GC also confirmed the finding that the signs show a certain degree of similarity from the phonetic and the conceptual (for the Italian-speaking consumers) point of view (paras. 46-57). In the light of the foregoing, the GC found that the BoA did not commit any error in finding that there was a likelihood of confusion between the marks in question.

Case T-215/16; Cop Vertriebs-GmbH v EUIPO; Judgment of 3 April 2017;

Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive element, Burden of proof

FACTS: The Cancellation Division (CD) rejected the request for a declaration of invalidity based upon absolute grounds of

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invalidity (Articles 7(1)(c) and (b) EUTMR). The Board of Appeal (BoA) dismissed the appeal. As regards Article 7(1)(c) EUTMR, it confirmed the CD's finding that the invalidity applicant had not established the descriptive character of the contested mark **AMPHIBIAN** for 'waterproof watches' in Class 14 for the relevant English-speaking public in the European Union. With respect to Article 7(1)(b) EUTMR, it observed that the invalidity applicant had not put forward any specific argument in support of this ground.

EUTM

AMPHIBIAN

SUBSTANCE: The GC dismissed the action. First, while the irrelevance of the noun 'amphibian' for the present case was not disputed (para. 40), the adjective 'amphibian' would not be directly – but only as result of several mental steps – linked with the notion of waterproofness given that (i) it is not a synonym for 'waterproof' and that (ii) goods designed for use both on land and in water are not necessarily waterproof (paras. 43, 44). Second, while the term 'amphibian' has acquired a particular meaning with respect to specific vehicles designed for use on both land and water, such a linguistic development has not taken place as regards watches (paras. 45, 46).

Therefore, it does not directly and immediately inform the relevant consumer that the protected watches can be used both on land and in water but remains merely evocative (para. 47). The argument of the invalidity applicant – upon whom lies the burden of proof for demonstrating the descriptive character of the contested mark (paras. 49-51) – that this might be different for professionals in the sector of army and police, was made for the first time in the proceedings before the GC and thus rejected as inadmissible (paras. 48, 52, 53).

**Case T 291/16; Anta (China) Co. Ltd v EUIPO;
Judgment of 5 April 2017;**

Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Figurative trade mark, Minimum degree of distinctiveness, Principle of legality

FACTS: The applicant sought to register as a EUTM the figurative sign represented below. The goods in respect of which registration was sought consist, in essence, of leather, various leatherware and luggage goods in Class 18, clothing, footwear and clothing accessories in Class 25 and games, playthings and sporting articles in Class 28. The EUTM application (EUTMA) was refused by the examiner pursuant to Article 7(1)(b) EUTMR. The Office's decision was confirmed by the Fifth Board of

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Appeal (BoA). The applicant lodged an action before the General Court (GC) alleging infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal.

EUTMA



SUBSTANCE: Firstly, the GC upheld the BoA's findings concerning the relevant public. The GC held that the majority of the relevant public of the goods at issue are reasonably well informed and reasonably observant and circumspect, but no more. It cannot be presumed that the majority of the relevant consumers would be particularly critical in the analysis of the goods concerned or place importance on the reputation of brand images and labels in the market at issue (para. 26). Secondly, the GC stated that, although the EUTMA is not a basic geometrical figure, it consists of a representation of two intersecting lines whose simplicity is comparable to that of a basic geometrical figure and is incapable of conveying a message allowing consumers to perceive it as an indication of the commercial origin of the relevant goods (paras. 31-33). The mark has no element which is visually eye-catching or likely to be remembered by consumers (para. 36). This conclusion would not change even if the attention

of the public was deemed to be higher than average, since the sign would be likely to be perceived as a mere decorative element. In particular, the sign at issue, used on clothing such as jackets or trousers, will be perceived as a simple combination of two lines that might bring to mind other combinations of lines used on clothing for aesthetic or ornamental purposes (paras. 40-41). Furthermore, the examples put forward by the applicant in order to illustrate its claim that the relevant consumers in particular of clothing and sporting equipment are used to perceiving purely figurative simple signs, are marks owned by undertakings for which it cannot be ruled out that they could, if they had to prove at the time the distinctive character of their mark, claim distinctive character acquired through use (paras. 42-43). In light of the above the BoA was correct to find that the EUTMA was devoid of distinctive character in relation to the goods concerned and the perception of the relevant public. As to the previous decisions of the BoA and the Office the applicant refers to, the GC recalled the case-law according to which the legality of the BoA's decisions must be assessed solely on the basis of the EUTMR, as interpreted by the European Courts, and not on the basis of previous decision-making practice (para. 46). The principle of equal treatment and sound administration must be consistent with respect for legality (para. 48). In the case at issue, the BoA took into account the decisions cited by the applicant and its assessment cannot be called into question only because it was not consistent with the

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Office's earlier practice (paras. 51-53). Concerning the earlier registrations in other countries the applicant relies on, the GC reminded that the EUTM regime is an autonomous legal system that applies independently of any national system (para. 56).

Case T-209/16; Apax Partners UK Ltd. v EUIPO; Judgment 30 March 2017;

Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Similarity of the goods and services, Visual similarity, Phonetic similarity.

FACTS: The applicant filed an application for the registration as EU trade mark of the word mark represented below in respect of the services in Class 36. An application for the declaration of invalidity was filed pursuant to Article 53(1)(a) EUTMTR and Article 8(1)(a)(b) EUTMR which was based on the below represented international trade mark designating, among other countries, Sweden, and covering inter alia services in Class 36. The Cancellation Division (CD) upheld the application for a declaration of invalidity in respect of all the services covered by the contested mark on the basis of Article 53(1)(a) EUTMTR in conjunction with Article 8(1)(b) EUTMR. The Board of Appeal (BOA) dismissed the proprietor's appeal. It endorsed

the CD's findings that there was a likelihood of confusion between the conflicting trade marks. The proprietor filed an action before the General Court (GC) relying on a single plea in law, i.e. violation of Article 53(1)(a) EUTMTR in conjunction with Article 8(1)(b) EUTMR. The GC dismissed the appeal.

EUTMA	Earlier trade mark
APAX PARTNERS	APAX

SUBSTANCE: The GC endorsed the BOA's findings that the level of attention in respect of the services in question, which may be aimed both at the general public and at a specialist public, was relatively high (para. 25). Moreover, BoA was also right in finding that the signs at issue were similar overall, in particular since the only element of the earlier mark was identical to the first element of the contested mark and because the second element of the latter was weakly distinctive (para. 27). GC also held that the 'financial services' covered by the earlier mark were correctly found as being similar to the services of 'insurance' covered by the contested mark (paras. 29-32) and identical to the rest (para. 39). Furthermore, it was considered that the declaration filed by the proprietor under Article

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28(8) EUTMR during the course of proceedings before GC could not affect the outcome of the comparison of the services since the items added to the specification of the contested mark had already been taken into account by previous instances (paras. 33-38). Therefore, the GC concluded that given the similarity between the signs and the identity and similarity between the services, there was a likelihood of confusion between the trade marks in question despite the relatively high level of attention of the relevant public (paras. 43-35).

Case T-49/16; Azanta A/S v EUIPO; Judgment 06 April 2017;

Language of the case: EN

RESULT: Action dismissed

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

FACTS: The applicant filed an application for the registration as EU trade mark of the word mark represented below in respect of the goods in Class 5. An opposition based on the earlier EU trade mark represented below registered for goods in Class 5 was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition in its entirety. The Board of Appeal (BoA) dismissed the applicant's appeal. It endorsed

the OD's findings that there was a likelihood of confusion between the conflicting trade marks. The opponent filed an action before the General Court (GC) relying on a single plea in law, i.e. violation of Article 8(1)(b) EUTMR. The GC dismissed the appeal.

EUTMA	Earlier trade mark
NIMORAL	NEORAL

SUBSTANCE: The GC endorsed the BoA's findings that the goods of the conflicting trade marks are identical (paras. 29-30) and that they are targeted both at the specialized public and the general public in the European Union who would show high degree of attention (paras. 26-27). The signs were found to be visually and aurally similar to an average degree (paras. 42 and 49). Moreover, the signs could not be compared from the conceptual perspective (para. 58). Therefore, the GC concluded that given the average degree of similarity between the signs and the identity between the goods, there was a likelihood of confusion between the trade marks in question despite the high level of attention of the relevant public (para. 69).

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R0873/2016-2



MATRATZEN CONCORD (fig.) / MATRATZEN

RESULT: Appeal inadmissible.

KEYWORDS: Admissibility, Legal certainty.

NORMS: Rule 49 CTMIR, Article 60 EUTMR.

FACTS: By decision of 24 October 2013 in case No 6 180 C concerning an application for a declaration of invalidity, the Cancellation Division found that the cancellation applicants had not satisfied the requirement to prove that their earlier mark had been put to genuine use and, therefore, rejected the application for invalidity pursuant to Article 57(2) EUTMR. The cancellation applicants did not appeal that decision which, therefore, became final. On 23 December 2013 the cancellation applicants filed a new application for a declaration of

invalidity involving the same subject-matter, cause of action and the same parties. The request was rejected as inadmissible, pursuant to the general principle of *res judicata* (Article 56(3) EUTMR).

SUBSTANCE: A decision which merely confirms an earlier decision not challenged in due time is not an actionable measure. For the purpose of not allowing the time-limit for bringing an action against the confirmed decision to recommence, an action against such a confirmatory decision must be declared inadmissible (06/10/2015, [T-545/13](#), engineering for a better world, EU:T:2015:789, § 15 and the case-law cited therein). A decision which has not been challenged within that mandatory time-limit becomes definitive. That definitive nature concerns not only the decision itself, but also any later decision which is merely confirmatory (see in that sense 18/10/2007, [C-299/05](#), Commission v Parliament and Council, EU:C:2007:608, § 29). Therefore the confirmed decision, as well as subsequent confirmatory decisions, are not appealable (15/05/2015, [R 66/2015-2](#), SUPER GLUE (fig.), § 15) (§ 19). In the present case, the time-limit for bringing an appeal against the Cancellation Division's decision of 24 October 2013 expired pursuant to Article 60 EUTMR, without the cancellation applicants having brought such an action. That decision, therefore, became definitive (§ 20). That finality applies both to the operative part of that decision and to the grounds constituting the

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essential basis thereof. Since the operative part of that decision was capable of producing legal effects and, as a consequence, of adversely affecting interests, the cancellation applicants had to challenge it within the mandatory prescribed time-limit or become time barred (08/02/2011, [T-157/08](#), *Insulate for Life*, EU:T:2011:33, § 31). A decision is regarded a mere confirmation of an earlier decision if it contains no new factors as compared with the earlier decision and is not preceded by any re-examination of the situation of the addressee of the earlier decision (08/02/2011, [T-157/08](#), *Insulate for Life*, EU:T:2011:33, § 30) (§ 21-22). This appeal is inadmissible as it is directed against the contested decision, which merely confirmed the first definitive Cancellation Division's decision of 24 October 2013, which is not appealable (§ 25).

[R0497/2016-4](#)



BBQLOUMI (fig.) / HALLOUMI

RESULT: Decision confirmed

KEYWORDS: Collective mark, Dissimilarity of signs, Reputation, Similarity between the goods and services.

NORMS: Article 8(1)(b) EUTMR, Article 8(5) EUTMR.

FACTS: An opposition was filed against the figurative mark, as represented above, pursuant to Article 8(1)(b) and Article 8(5) EUTMR and based on an EU collective mark. The opposition was rejected by the Opposition Division.

SUBSTANCE: Likelihood of confusion – Halloumi designates a type of cheese and is weak (being from Cyprus, but not being a geographical indication). Taking into account the low distinctive character of the earlier mark, the low visual similarity between the signs, the absence of phonetic or conceptual similarities and the various degrees of similarity as regards part of the goods (the services being found dissimilar), there is no likelihood of confusion (§ 45). **Reputation** – Reputation in Cyprus or any other EU Member State as a distinctive (collective) trade mark for 'cheese' was not proven (§ 54). The opponent did not demonstrate a prima facie situation in which one of the types of injury to which Article 8(5) EUTMR refers would be likely (§ 55). Non-compliance with the Regulations of Use is not a ground for opposition and not a matter for the perception of the target consumer, which is always the threshold under Article 8, whether it be section (1) or (5), EUTMR (§ 65). The appeal is dismissed.

[R0581/2016-5](#) **Cellapy / CELLAP et al.**

RESULT: Decision confirmed.

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KEYWORDS: Company name, Domain names, Dominant element, Evidence of use, Extent of use, Likelihood of confusion, Nature of the goods and services, Non-registered trade mark, Phonetic similarity, Ratio legis, Sign of mere local significance, Similarity between the goods and services, Similarity of the signs, Substantiation of earlier right, Trade name, Used in the course of trade, Visual similarity, Weak element.

NORMS: Article 8(4) EUTMR.

FACTS: An opposition was filed against the published EUTM application for goods in Class 3. The grounds of opposition were based on Article 8(4) EUTMR and on several earlier rights (including trade names, company names, domain names and signboards) used in the course of trade of more than mere local significance. The opponent based its claim on Article L.711-4 of the French Intellectual Property Code (IPC). The Opposition Division rejected the opposition in its entirety.

SUBSTANCE: The Opposition Division wrongfully rejected the opposition on the basis that Article L.711-4 IPC could not be used as a ground. The Article mentioned is classically admitted as a valid national provision enabling a proprietor to raise an opposition based on Article 8(4) EUTMR (see 21/03/2014, [T-453/11](#), Laguiole, EU:T:2014:901, § 37). Article L.711-4 IPC must be deemed as enabling the proprietor of an earlier right to

prohibit not only the registration of a sign as a trade mark, but also its use (§15-17).

The Board has examined the merits of the opposition and has found that the opposition fails as regards all the earlier rights.

In relation to trade names, the Board has found that the requirement of use throughout the national territory is not fulfilled, because the vast majority of the evidence submitted by the opponent does not prove that the trade names have been used in France. It has to be considered that the opponent did not benefit from having a national right to prohibit the use of the trade names 'CELLAP' and 'CELLAP LABORATOIRE SA' as a subsequent trade mark under French national law, thus failing to fulfil the first requirement set by Article 8(4) EUTMR (§ 49, § 53).

In relation to the company name it is not clear whether or not a Swiss company may benefit from the protection of its company name in France (§ 59). Thus, the opposition based on this earlier right fails as well.

In relation to the domain name it has been proven that the opponent benefited from an earlier right based on the domain name 'cellap.ch' at the date of application for registration of the contested mark (§ 85). However, compared to the approximate total population of France, the total

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number of French visitors to the domain name in question is not sufficient to consider that the said domain name was used in the course of trade of more than mere local significance, which is required for the application of Article 8(4) EUTMR (§ 96). Thus, this earlier right also fails.

In relation to the signboard taking into consideration, firstly, the established existence of a risk of confusion between the signs and, secondly, the signboard's use throughout France, the Board concludes that the conditions set by Article L.711-4 IPC for an earlier right based on a signboard to exist are met. However, as a result of the evaluation of the economic impact of the use of the sign the Board considers that the signboard 'CELLAP SHOP FR' was not used in the course of trade of more than mere local significance (§ 130). Consequently, the appeal is dismissed and the opposition is rejected by the Board.

R1565/2016-1 FLOW FESTIVAL /



LOW FESTIVAL (fig.)

RESULT: Decision confirmed.

KEYWORDS: Complementary evidence, Database printout, Fax, Likelihood of confusion, Obvious mistakes, Phonetic similarity, Substantiation of earlier right, Translation of evidence, Visual similarity.

NORMS: Rule 19(1) CTMIR, Rule 19(2) CTMIR,

Rule 19(2)(ii) CTMIR, Rule 19(3) CTMIR, Rule 19(4) CTMIR, Rule 50(1) CTMIR, Rule 76(2) CTMIR, Rule 98(1) CTMIR, Article 8(1)(b) EUTMR.

FACTS: The opponent filed an opposition against the application for services in Classes 35 and 41 on the grounds of a likelihood of confusion within the meaning of Article 8(1)(b) EUTMR. The opposition was based on Spanish trade mark registration of the figurative mark above and registered for the services of 'organising festivals. Specifically music' in Class 41. The Opposition Division (OD) upheld the opposition and rejected the mark applied for in respect of the services at issue.

SUBSTANCE: The Board confirms the finding of the OD that the opposition based on the earlier mark was well founded inasmuch as the submission of the updated SITADEx extract and a translation in a separate document reproducing the structure and content of that extract was additional to, and supplemented, the first set of evidence and translations provided (§ 38-40).

On the issue of a likelihood of confusion, the earlier mark 'low festival' taken as a whole does not describe a characteristic of the services (§ 53). While consumers normally attach more importance to the first part of a word, that consideration cannot apply here (12/11/2008, T-281/07, Ecoblue, EU:T:2008:489, § 32): 'FLOW' is a relatively short term, which when combined with the term 'FESTIVAL' bears a close visual

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resemblance to the earlier mark. There is visual similarity and a high level of phonetic similarity (§ 54-55). The marks are not conceptually dissimilar for a large part of the Spanish public who does not understand the meaning of 'FLOW' / 'LOW' (§ 56). The similarity of those services, the visual similarity and high degree of phonetic similarity justify a finding of a likelihood of confusion including a likelihood of association in Spain (§ 63).

The Board dismisses the appeal.

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