

Alicante News

Up to date information on IP and EUIPO-related matters

Quick Links 

Editorial

■ Common Communication

James Nurton
Interviews

Andrea Lensing-Kramer

Statistical Highlights

■ November 2017

EUIPN Updates

■ Japan joins DesignView

More News

■ 1 January 2018: EUTM applications and renewals by fax

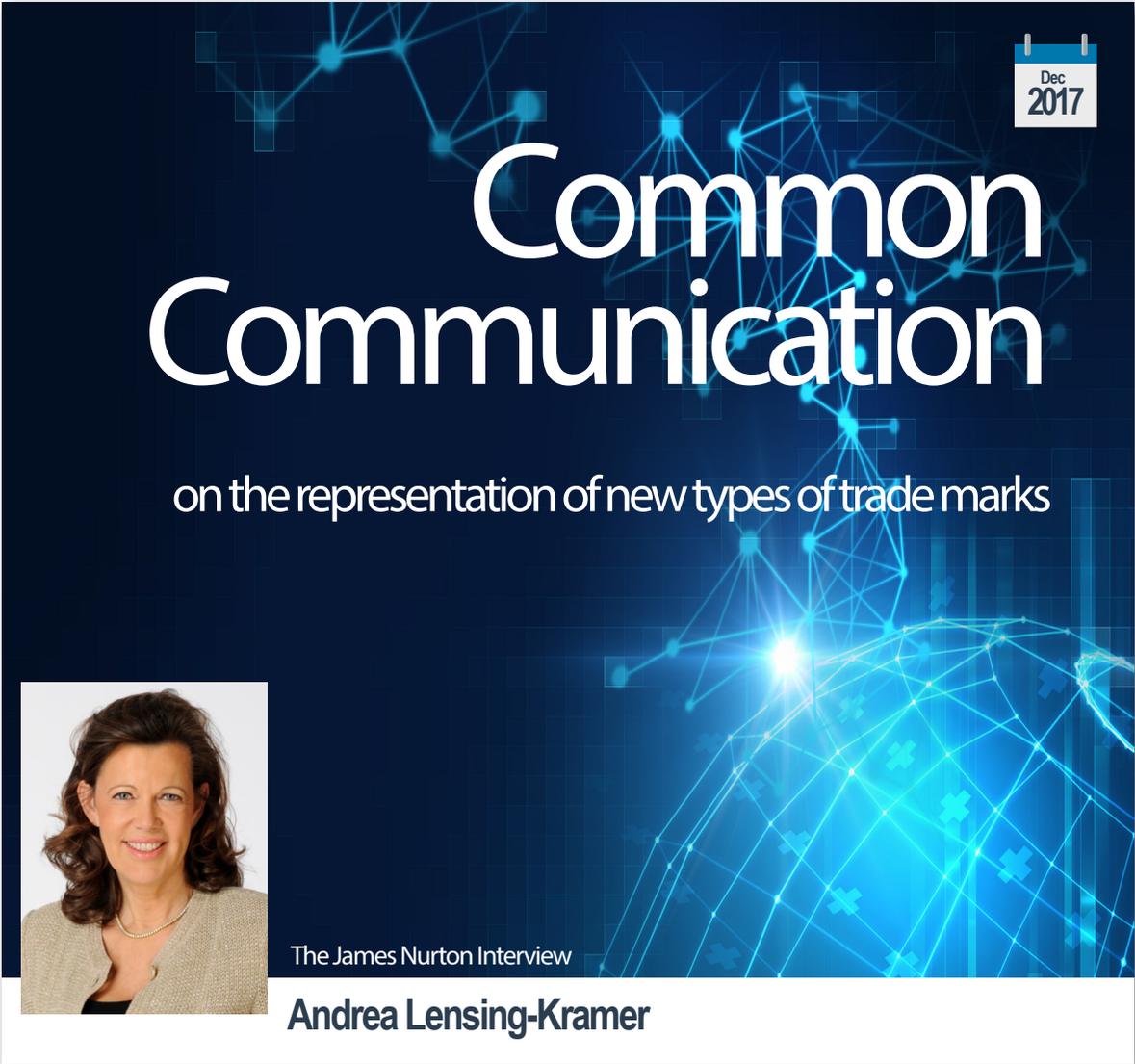
■ Annual User Satisfaction Survey: January

■ IP Case Law Conference

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



Common Communication

on the representation of new types of trade marks



The James Nurton Interview

Andrea Lensing-Kramer



Common Communication on the representation of new types of trade marks

The elimination of the graphical representation requirement from the definition of EU and national trade marks is one of the key changes brought by Directive (EU) 2015/2436.

This provision paves the way for the acceptance of new types of trade mark and new means of representation.

Therefore, to ensure the transition to the new Directive is as smooth as possible for all stakeholders, the Intellectual Property Offices of the Member States of the EU, the EUIPO and the European Commission have been working together to develop a common initiative on the representation of new types of trade marks.

The result is a [Common Communication](#), which gives a complete overview of the state of play of each Office's transposition process, showing:

- the types of trade mark each Office plans to accept;
- the definitions thereof;
- the accepted electronic file formats for sound, motion, multimedia and hologram marks.

The Common Communication also contains an [Annex](#).

After the first publication, the Communication will be

updated on a six-monthly basis to reflect the developing positions of the Offices as they advance with the transposition process.

The first update is scheduled for the 1st of June 2018.

Editorial

■ Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

■ November 2017

EUIPN Updates

■ Japan joins DesignView

More News

■ 1 January 2018: EUTM applications and renewals by fax

■ Annual User Satisfaction Survey: January

■ IP Case Law Conference

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



The James Nurton Interview



Andrea Lensing-Kramer, Freshfields Bruckhaus Deringer

What is your background?

I did not cover IP as part of my legal studies. But I went to Brussels as a stagier and worked on antitrust and merger control issues at about the time the Merger Task Force was established. Then in 1992 I started at Bruckhaus, which later became Freshfields Bruckhaus Deringer, where I have remained ever since as a partner.



Andrea Lensing-Kramer

When I started there was a desperate need for an associate to do IP work, so I combined both competition and IP work to begin with.

It was an exciting time in trade marks as there were big changes coming from the EU Trade Marks Directive and the launch of the Community trade mark. In Germany, the new Trade Mark Law of 1995 changed the definition and even the name of the trade mark right.

I have always found trade marks very interesting, and I have seen many changes and new challenges over the past 25 years. I think the biggest one is that the work has become more and more international. That really developed for us with the Freshfields merger in 2000.

However, I have always had a lot of international clients, particularly in the US and other English-speaking countries. I have worked with some of these big international brand owners, throughout my career, along with a team of associates and paralegals, some of whom joined the team more than 15 or even 20 years ago. We have seen the people at the clients change in that time, so sometimes we know more about their brand positioning, risk awareness and portfolios than they do themselves!

What kind of work do you do?

Mostly we provide general advice and litigation on trade marks, company names, designs, unfair competition and issues arising from distribution such as licensing, promotional campaigns and advertising. We also do IP work related to mergers and acquisitions. We also manage trade mark portfolios for some of our biggest clients.

Editorial

Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

November 2017

EUIPN Updates

Japan joins DesignView

More News

- 1 January 2018: EUTM applications and renewals by fax
- Annual User Satisfaction Survey: January
- IP Case Law Conference

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



The James Nurton Interview



In our German trade mark and unfair competition team we have about 15 lawyers, supported in particular by paralegals and personal assistants and we work very closely with our other offices worldwide where they have IP expertise. But we look at every case individually and if appropriate we will work with IP specialists in other firms.

What do you think of the EU trade mark system?

I have always been impressed with the high value of the system from the start. The Office provides an impressive service, and is innovative – for example with the development of online filing – and service-oriented.

Over time we have also seen national offices getting better, which suggests that competition seems to be good for the whole system. The German Office has less international experience and fewer resources but they are constantly improving.

I think some trade mark practitioners outside of Europe still do not appreciate the differences that exist within Europe. They sometimes think that Europe is effectively one country, and there is no need for strategies or local counsel in each country. But there is still room for national applications as well as European ones, to ensure you have effective protection. Particularly if you have a mark that may be difficult to register, there may be a benefit to applying in different jurisdictions.

Another thing I like about the EU trade mark system is the cooling-off period and the ability to extend deadlines. We try to avoid litigation as much as possible: if it's not a ground-breaking issue, we try to settle and make

agreements on coexistence or recognition of prior rights.

What do you think of the courts?

I consider the courts in Luxembourg highly unpredictable, even if I admit that litigating in court is always a challenge. One of the differences is that the CJEU judges are not IP specialists, whereas in Germany the IP judges are highly specialised and have a “feeling” for IP law by experience. I very much like litigating in Germany as I feel like everyone – lawyers and judges – is speaking the same language.

In Germany, we are frequently before the Düsseldorf court, which is very highly experienced, and sometimes also the courts in Hamburg and Munich. These courts are, among others, competent to hear EU trade mark cases in Germany.

You mentioned resolving disputes – what about arbitration and mediation?

We are seeing more interest in arbitration, though not so much in mediation. That interest is coming from clients: often there are arbitration clauses in licence agreements.

However, people need to be aware that arbitration can be very expensive, even more so than litigation which in Germany is efficient and relatively cheap, meaning that you get good value for money. Arbitration is probably most useful where you have an international dispute that spans more than one jurisdiction.

Which cases are particularly important at the moment?

I think everyone in Germany is studying closely the recent CJEU judgment in the Coty case regarding selective

Editorial

■ Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

■ November 2017

EUIPN Updates

■ Japan joins DesignView

More News

- 1 January 2018: EUTM applications and renewals by fax
- Annual User Satisfaction Survey: January
- IP Case Law Conference

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



The James Nurton Interview



distribution. That is a very pro-brand owner decision and it would be good to see it applied beyond just luxury goods.

The other area of interest is the new types of trade marks: we are waiting to see how the case law on that will develop. Clients often use shapes and colours in their marketing and want to be able to protect their unique selling points, but the decisions are unpredictable. At the outset the EU system was quite liberal in this regard, but it is now stricter, and we will see how it develops following the latest changes.

What have been your most interesting cases?

We filed an application for the colour brown in the very early days of the EU trade mark. It was one of the first colour trade marks and the law was still quite undeveloped at the time. It involved a lot of work and we were right up against the deadlines! We didn't have Pantone charts at the time and we had to get a brown plate shipped over from the US to submit to the Office.

I also acted for Apple in the extensive litigation over design rights for smartphones against Samsung. That was a very big case and something I will probably never forget.

One of my most interesting cases was about 15 years ago: we acted for Rolex against eBay in one of the first cases over the liability of an online marketplace for IP infringement. The decision in Germany was one of the first in the world and when I told people the court had found in favour of Rolex, they asked: are you crazy?

Since then however it has been followed by several decisions in other countries, and the liability of

intermediaries is now a very important topic throughout the world. Despite the novelty of the legal issues, we were absolutely convinced that our legal arguments in the case were very strong.

We also had good factual evidence – the Fraunhofer Institute had done research which showed that it was relatively easy for eBay to put keywords in place to identify search terms such as “looks like a Rolex” or “nice as a Rolex” and we challenged eBay's claim that this would spoil its business model. It was very new ground but the Federal Court was brave in tackling these issues.

What do you think the future holds for IP?

I think there will continue to be small transitions in trade mark law here and there, rather than fundamental change.

I am sure there will gradually be more harmonisation based on guidance from the courts in Luxembourg. In the short term, we are receiving lots of enquiries from clients about the impact of Brexit, and particularly what action they should take regarding their registered rights, so we hope for guidance on that as soon as possible.

One issue that we are seeing much more is the relationship between IP and tax. This has come to the forefront thanks to the publication of the Panama Papers, though sometimes we see that a tax structure has been set up almost accidentally – because an individual managing the patent or trade mark portfolio has moved to another country, for example.

It's certainly now clear that thought should be given to the implications of how the portfolio is structured for tax

Editorial

Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

November 2017

EUIPN Updates

Japan joins DesignView

More News

- 1 January 2018: EUTM applications and renewals by fax
- Annual User Satisfaction Survey: January
- IP Case Law Conference

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



The James Nurton Interview



reasons. We have been holding workshops with our tax colleagues, so we can make them aware about IP and they can tell us about tax. It is clear we do not always understand each other or speak a common language. We need to try to work out how to advise clients to be in the best position for both tax and IP so that they have a joint solution.

Editorial

- Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

- November 2017

EUIPN Updates

- Japan joins DesignView

More News

- 1 January 2018: EUTM applications and renewals by fax
- Annual User Satisfaction Survey: January
- IP Case Law Conference

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

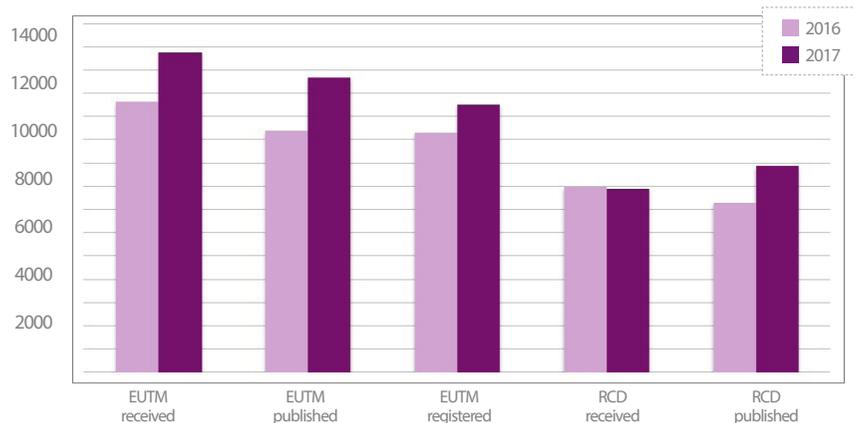


Statistical Highlights



Monthly statistical highlights November*	2016	2017
European Union Trade Mark applications received	11 627	13 729
European Union Trade Mark applications published	10 398	12 678
European Union Trade Marks registered (certificates issued)	10 305	11 517
Registered Community Designs received	7 954	7 874
Registered Community Designs published	7 291	8 860

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



Editorial

Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

November 2017

EUIPN Updates

Japan joins DesignView

More News

- 1 January 2018: EUTM applications and renewals by fax
- Annual User Satisfaction Survey: January
- IP Case Law Conference

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



Japan joins Designview

As of 04 December 2017 the Japan Patent Office (JPO) has made its design data available to the Designview search tool.

With JPO on board, Designview now contains data from 62 participating offices.

With the addition of more than 525,000 designs from JPO, Designview provides information and access to more than 13.2 million designs.

Since the introduction of Designview on 19 November 2012 the tool has served more than 3.1 million searches from 159 different countries, with users from Germany, the UK and Spain among the most frequent users.

Editorial

■ Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

■ November 2017

EUIPN Updates

■ Japan joins DesignView

More News

- 1 January 2018: EUTM applications and renewals by fax
- Annual User Satisfaction Survey: January
- IP Case Law Conference

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



More News



From 1 January 2018, EUTM applications and renewals by fax not accepted

Users are reminded that, in accordance with [Decision EX-17-4](#) of the Executive Director of EUIPO, from 1 January 2018 fax will no longer be accepted for filing EUTM applications or renewals except as a backup system if technical malfunctions prevent e-filing.

See Decision [EX-17-4](#) for further details.

EUIPO User Satisfaction Survey launches in January

The annual EUIPO satisfaction survey will launch on 15 January.

Every year the Office carries out a satisfaction survey to identify goals and priorities for improvement, as well as to assess the satisfaction of users with the services provided. The 2017 user satisfaction survey will be sent via e-mail to the users of EUIPO's services. Each email will contain a link to a secure web-based questionnaire, compiled by the market research agency Berent which managing the survey on behalf of the EUIPO.

The questionnaire can be completed in any of the five working languages of the Office (English, Spanish, German, French and Italian) before 4 February.

IP Case Law Conference – save the date!

On 7-8 May, the Office will hold its second IP Case Law Conference. The event will be dedicated to substantive and procedural issues surrounding trade mark and design registration.

This conference builds on the first IP Case Law Conference which took place in May 2016.

The 2018 conference will bring together users of the international IP systems, practitioners, judges, national and international institutions and administrations for a two day event.

The event is designed to be as innovative and user-focused as possible. It will be held in an interactive format with ample opportunity for questions from the audience.

Registration will open in January

Editorial

Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

November 2017

EUIPN Updates

Japan joins DesignView

More News

- 1 January 2018: EUTM applications and renewals by fax
- Annual User Satisfaction Survey: January
- IP Case Law Conference

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case Law



Luxembourg trade mark and design news

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

Case [C-501/15 P](#); Cactus SA v EUIPO; Judgment of 11 October 2017; EU:C:2017:383; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Use not as registered

FACTS: The applicant sought to register the figurative mark CACTUS OF PEACE CACTUS DE LA PAZ as an EUTM for goods and services in Classes 31, 39 and 44. An opposition based inter alia on the earlier EUTM figurative mark CACTUS, registered for goods and services in all class headings of Classes 2, 3, 5 to 9, 11, 16, 18, 20, 21, 23 to 35, 39, 41 and 42, was filed pursuant to Article 8(1)(b) of Regulation No 207/2009. The Opposition Division (OD) upheld the opposition for goods and services in Classes 31 and 44. The Board of Appeal (BoA) upheld the EUTM applicant's appeal. It found that the OD had erred in considering that the opponent had adduced proof of genuine use of the earlier trade marks in respect of 'retailing of natural plants and flowers, grains; fresh fruits and vegetables' services in Class 35. The opponent filed an action before the General Court (GC) relying on three pleas in law: infringement of (i) Article 42(2), (ii) Articles 75 and 76(1) and (iii) Article 76(2) of Regulation No 207/2009. The GC partly upheld the

action. It annulled the decision at issue to the extent that it, first, rejected the opposition on the ground that 'retailing of natural plants and flowers, grains; fresh fruits and vegetables' services were not covered by the designation of the class heading in Class 35 of the earlier trade mark; second, rejected the opposition based on 'natural plants and flowers, grains' in Class 31; and third, had considered that use of the earlier mark had not been made in the form as registered. It dismissed the action as to the remainder. The Office filed an action before the Court of Justice of the European Union (CJ) relying on two pleas in law: (i) infringement of Article 28 of Regulation No 207/2009, read in conjunction with Rule 2 of Regulation No 2868/95 and (ii) an infringement of Article 42(2) of Regulation No 207/2009, read in conjunction with point (a) of the second subparagraph of Article 15(1) of that regulation. The CJ dismissed the appeal.

EUTM	Earlier trade marks
CACTUS OF PEACE	CACTUS
CACTUS DE LA PAZ	

SUBSTANCE: According to the IP Translator judgment (judgment of 19 June 2012, C-307/10, Chartered Institute

Editorial

■ Common Communication

James Nurton
Interviews

Andrea Lensing-Kramer

Statistical Highlights

■ November 2017

EUIPN Updates

■ Japan joins DesignView

More News

■ 1 January 2018: EUTM applications and renewals by fax

■ Annual User Satisfaction Survey: January

■ IP Case Law Conference

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case Law



of Patent Attorneys, EU:C:2012:361, paras 57 to 64), the general indications of a given class heading of the Nice Classification may cover all the goods or services included in the alphabetical list of this class, providing two cumulative conditions are fulfilled: the individual terms making up the class heading must be sufficiently 'clear and precise', and the application must reflect the applicant's intention to cover all the goods or services included in the alphabetical list of the class in question. According to the Praktiker Bau judgment (judgment of 7 July 2005, C-418/02, Praktiker Bau, EU:C:2005:425, para. 50), retail trade in goods constitutes a service but the applicant must specify the goods or types of goods to which the retail trade relates (para. 44).

NON-APPLICABILITY OF IP TRANSLATOR AND PRAKTIKER TO EUTMs REGISTERED BEFORE THEIR ADOPTION: Regarding the first plea based on the violation of Article 28 EUTMR, the CJ confirmed the Brandconcern judgment (judgment of 16 February 2017, C-577/14, Brandconcern v EUIPO and Scooters India, EU:C:2017:122, paras 29 to 31) by stating that the guidance set out in IP Translator and Praktiker Bau only applies to trade marks registered after the date of adoption of these judgments (paras 36 and 45 to 48). These judgments do, therefore, have no retroactive effect. The scope of the protection afforded by trade marks that have been registered before such dates may not be altered on the basis of Communication No 2/12 (Communication of the Executive Director of the EUIPO of 20 June 2012 repealing Communication No 4/03 and concerning the use of class headings in lists of goods and services for EUTM applications and registrations,

point V), a non-binding communication which has no function other than to provide clarification for applicants as to the practices of the EUIPO (para. 40). The transitional provision under Article 28(8) of Regulation No 207/2009 (as amended by Regulation 2015/2424) was not applicable at the date of the decision at issue (para. 49). In light of all the above arguments, the CJ confirmed that, for the earlier trade marks at issue, the designation of the class heading of Class 35 covered all the services included in that class, including services consisting of the retail of goods (para. 50).

USE IN A FORM DIFFERING FROM THAT OF REGISTRATION: Regarding the second plea based on the violation of Article 15(1)(a) EUTMR, the GC considered that two sets of arguments were inadmissible to the extent that they challenged factual assessments, namely the findings in relation to the attentiveness, the perception and the attitude of the relevant public (para. 61). In turn, the determination of the criterion to be employed for the assessment of genuine use, as well as for the global assessment of equivalence of signs from the perspective of their distinctiveness, is a question of law falling within the CJ jurisdiction (para. 64). The CJ confirmed that genuine use is satisfied even where only the figurative element of a composite mark is used, as long as the distinctive character of that mark, as registered, is not altered (para. 67). In the event that the word element does not possess a distinctive character that differs from that of the figurative element, the absence of that word element in the abbreviated version of the earlier figurative mark does not alter its distinctive character. Finding that the word and figurative

Editorial

■ Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

■ November 2017

EUIPN Updates

■ Japan joins DesignView

More News

- 1 January 2018: EUTM applications and renewals by fax
- Annual User Satisfaction Survey: January
- IP Case Law Conference

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case Law



elements conveyed the same semantic content, the GC did not err in considering that the absence of that word element in the abbreviated version of the earlier figurative mark was not sufficiently important in the perception of that mark as a whole as to alter its distinctive character (para. 69). The GC did not err in not conducting a phonetic comparison since the compared signs had the same semantic content (para. 70).

Case [C-231/16](#); Merck KCaA v Merck & Co. Inc. and Others; Preliminary ruling of 19 October 2017; EU:C:2017:771; Language of the case: DE

KEYWORDS: Infringement, Domain names

FACTS: The applicant in the main proceeding Merck KCaA is the proprietor of a national word mark MERCK, registered in the United Kingdom, and an EUTM word mark MERCK. The name 'Merck' is used by the defendants in the main proceedings on the internet in domain names and on social media platforms. On those websites, the dissemination of information is not geographically targeted, with the result that all of the content is accessible in the same form worldwide. On 8 March 2013, the applicant in the main proceedings brought an action before the High Court of Justice of England and Wales, Chancery Division (United Kingdom) against, in particular, Merck & Co. and Merck Sharp & Dohme, for an alleged infringement of its national trade mark due to the use of the name 'Merck' in the United Kingdom. On 11 March 2013, the applicant in the main proceedings also brought an action before the Landgericht Hamburg (Regional Court, Hamburg,

Germany) against the same defendants, but also against MSD Sharp & Dohme, on the basis of the EUTM MERCK. The applicant originally requested the Langericht Hamburg to adopt an order prohibiting the use of the EUTM MERCK throughout the EU, and subsequently restricted the territorial extent of its request to the EU with the exception of the United Kingdom. That restriction was opposed by the defendants in the main proceedings, taking the view that the action pending before the Landgericht Hamburg is inadmissible in the light of Article 109(1)(a) of Regulation No 207/2009. The Landgericht Hamburg decided to stay the proceedings and to refer questions to the Court of Justice (CJ) for a preliminary ruling.

SUBSTANCE: Under Article 109(1)(a) of Regulation No 207/2009, where actions for infringement involving the same cause of action and between the same parties are brought in the courts of different Member States, one seized on the basis of an EUTM and the other seized on the basis of a national trade mark, the court other than the court first seized is required, of its own motion, to decline jurisdiction in favour of that court where the trade marks concerned are identical and valid for identical goods or services.

Is the condition as to the existence of the 'same cause of action' satisfied where actions for infringement between the same parties, the first on the basis of a national trade mark concerning an alleged infringement within the territory of a Member State and the second on the basis of an EUTM concerning an alleged infringement in the entire territory of the

Editorial

■ Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

■ November 2017

EUIPN Updates

■ Japan joins DesignView

More News

■ 1 January 2018: EUTM applications and renewals by fax

■ Annual User Satisfaction Survey: January

■ IP Case Law Conference

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case Law



European Union, are brought before the courts of different Member States (para. 23)?

The CJ stated that the 'cause of action' comprises the facts and the rule of law relied on as the basis of the action (para. 36). Successive civil actions on the basis of an EUTM and a national trade mark must be considered as having the same basis, given that they are based on exclusive rights arising from identical trade marks (para. 37). The condition relating to the identical nature of the facts is satisfied in the present case, given that both of the actions initiated concern the use of the term 'Merck' on the internet in domain names and on social media platforms (para. 38). As regards the 'subject matter', account must be taken of the applicants' respective claims in each of the sets of proceedings. In the present case, the two actions concern claims which only partially overlap, as the action brought before the High Court of Justice of England and Wales seeks to prohibit the use of the name 'Merck' in the United Kingdom, while the action brought before the Landgericht Hamburg seeks to prohibit the use of that name in the territory of the EU (paras 39 to 41). The condition as to the existence of the 'same cause of action' is satisfied so far as the actions brought before the courts of different Member States relate to an alleged infringement in the territory of the same Member States (paras 42 to 44).

Where the first action concerns an alleged infringement in the territory of a Member States and the second seeks a prohibition in the entire territory of the EU, must the court other than the court first seized decline jurisdiction as regards the action for infringement

brought before it in its entirety, or should it only decline jurisdiction in respect of the part of the dispute relating to the territory of the Member State referred to in the action for infringement brought before the court first seized (para. 45)?

The CJ answered that even though the EUTM has a unitary character, the territorial scope of prohibition may in certain circumstances be restricted. This must apply when the court other than the court first seized is required partially to decline jurisdiction. Therefore, the court other than the court first seized must decline jurisdiction in respect of the part of the dispute relating to the territory of the Member State referred to in the action for infringement brought before the court first seized (paras 49 to 53).

Is the condition as to the existence of the 'same cause of action' still satisfied after the partial withdrawal by an applicant of an action for infringement on the basis of an EUTM, where such a withdrawal is concerning the Member State referred to in the action brought before the court first seized (para. 54)?

Following a partial withdrawal of the applicant's request concerning the Member State referred to in the action brought before the court first seized, the actions for infringement no longer relate to an alleged infringement of a national trade mark and an identical EUTM in the territory of the same Member States. Therefore, the condition as to the existence of the 'same cause of action' is no longer satisfied and the court other than the court first seized is not required to decline jurisdiction in favour

Editorial

■ Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

■ November 2017

EUIPN Updates

■ Japan joins DesignView

More News

- 1 January 2018: EUTM applications and renewals by fax
- Annual User Satisfaction Survey: January
- IP Case Law Conference

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Editorial

Common Communication

James Nurton
Interviews

Andrea Lensing-Kramer

Statistical Highlights

November 2017

EUIPN Updates

Japan joins DesignView

More News

1 January 2018: EUTM applications and renewals by fax

Annual User Satisfaction Survey: January

IP Case Law Conference

Case Law

Luxembourg trade mark and design news

New decisions from the Boards of Appeal

Case Law



of the court first seized (paras 56 to 58).

Must the court other than the court first seized decline jurisdiction in favour of the court first seized only in so far as the trade marks are valid for identical goods or services, or does it also lack jurisdiction where the EUTM relied on before the court other than the court first seized is registered for additional goods and services not covered by the identical national trade mark (para. 59)?

The CJ stated that, where trade marks are identical, the court other than the court first seized must decline jurisdiction in favour of the court first seized insofar as those trade marks are valid for identical goods or services (paras 60 to 62).

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

Case T-211/14 RENV; Toni Klement v EUIPO, Judgment of 10 October 2017; EU:T:2015:688, Language of the case: DE

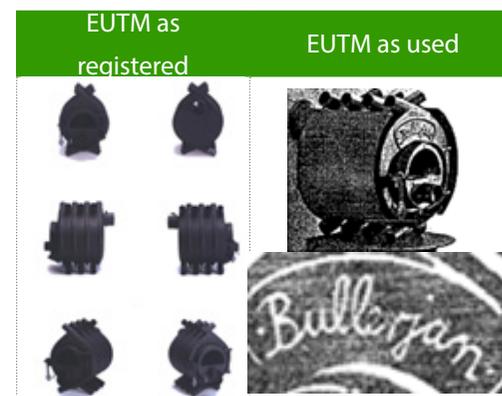
RESULT: Action dismissed

KEYWORDS: Use not as registered, Shape of the product

FACTS: In revocation proceedings for non-use, the EUTM proprietor had to show use for the following 3D-mark (on the left). In the evidence submitted, the EUTM proprietor established use of the contested EUTM in combination with the word mark 'Bullerjan' (on the right).

The Cancellation Decision dismissed the revocation request as it considered this use to be in conformity with Article 15(1)(a) [now Article 18(1)(a)] EUTMR. The Board of Appeal dismissed the appeal. The use shown of the contested EUTM would be both use 'as a trade mark' and in a form which does not alter its distinctive character. Arguments relating to the alleged functional character and alleged lack of distinctiveness of the contested EUTM would be inadmissible in revocation proceedings.

As in its previous judgment (annulled by the Court of Justice for lack of comprehensive reasoning, C-642/15 P), the General Court (GC) dismissed the invalidity applicant's action for annulment.



SUBSTANCE: The GC first dismissed the invalidity applicant's claim according to which the use shown would not constitute use 'as a trade mark'. It found that the invalidity

Case Law



applicant questioned in reality the distinctive character — and thus the validity — of the contested EUTM. This would be inadmissible in revocation proceedings for non-use (paras 25-29).

The GC also dismissed the invalidity applicant's second claim according to which the use shown of the contested EUTM — namely its combination with the word mark 'Bullerjan' — would constitute use in a form altering its distinctive character.

On the one hand, the contested EUTM would possess a high distinctive character (paras 38-46). On the other hand, the combination of the contested EUTM with the word element 'Bullerjan' in the sign as used would not modify the form of the contested EUTM given that (i) the distinctive form (shape) remained identical and (ii) would still be perceived as such — as indicator of origin — by the relevant consumer. Overall, the word mark would be less eye-catching ('moins frappante' in FR; 'fällt ... weniger auf' in DE), inter alia, because the combination of shape and word marks would be common in the relevant market at hand (para. 47).

Case [T-7/15](#); Leopard SA v EUIPO; Judgment of 19 October 2017; EU:T:2017:731; Language of the case: FR

RESULT: Action dismissed

KEYWORDS: Scope of proceedings, Similarity of the goods and services, Similarity of the signs, Dominant element

KEYWORDS: Proof of use, Proprietor consent, Extent of use

FACTS: The Board of Appeal (BoA) confirmed the Cancellation Division's finding that the earlier UK mark had been put to genuine use, and that the contested mark was to be declared invalid on the basis of Article 53(1)(a) in conjunction with Article 8(1)(a) and (b) EUTMR.



SUBSTANCE: SCOPE OF PROCEEDINGS: The GC may not annul or alter a decision on grounds which come into existence subsequent to its adoption. During its review of legality, the GC is not required to take into account the EUIPO decision revoking the earlier mark which formed the basis for this opposition since this revocation took effect as from a date which is later than the date of the Board's decision (paras 20 to 22). The GC declared inadmissible the claim seeking for confirmation of part of the findings of the BoA's contested decision (paras 25 to 26). SIMILARITY OF THE GOODS: The goods can be considered as identical when those designated by the trade mark application are included in a more general category, designated by the earlier mark. Therefore, 'clothing for sports' is identical to 'clothes' (para. 38). Specific clothes, such as 'clothing for

Editorial

■ Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

■ November 2017

EUIPN Updates

■ Japan joins DesignView

More News

- 1 January 2018: EUTM applications and renewals by fax
- Annual User Satisfaction Survey: January
- IP Case Law Conference

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case Law



cycling' are similar to 'clothing' (para. 39). 'Gymnastic and sporting articles' in Class 28 and 'clothes' have a weak degree of similarity (paras 46 to 47). SIMILARITY OF THE SIGNS: The GC found that the element 'LEOPARD' was dominant in the overall impression of the two signs. The figurative and verbal elements will be perceived as decorative or informative elements. As the dominant element is common in both signs, the GC held that there was a visual, aural and conceptual similarity (paras 61 to 75). In light of all the above arguments, there was a likelihood of confusion between the signs (paras 85 to 86).

Case [T-695/15](#); BMB sp. z o.o. v EUIPO; Judgment of 3 October 2017; EU:T:2017:684; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Conflict of design with prior trade mark

FACTS: The RCD proprietor was granted the registration of the design represented below as an RCD with the product indication 'comfit boxes' and 'container'.

An application for invalidity was filed pursuant to Article 25(1)(e) CDR on the basis of an international registration of a three-dimensional trade mark with effect in France for 'sweets' in Class 30. The Invalidity Division upheld the application for invalidity.

The Board of Appeal (BoA) dismissed the RCD proprietor's appeal. It found that the goods are at least highly similar and that the high visual similarity of the signs is not offset

by phonetic and conceptual differences. Despite the below average degree of distinctiveness of the earlier mark, it thus found a likelihood of confusion.

The RCD proprietor filed an action before the General Court (GC) relying on three pleas in law: infringement of Article 62 CDR due to an incorrect legal basis (i), infringement of Article 25(1)(e) CDR for finding a likelihood of confusion (ii), infringement of Article 63(1) CDR for failing to have regard to evidence (iii). The GC dismissed the appeal.

Editorial

■ Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

■ November 2017

EUIPN Updates

■ Japan joins DesignView

More News

■ 1 January 2018: EUTM applications and renewals by fax

■ Annual User Satisfaction Survey: January

■ IP Case Law Conference

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case Law



RCD

Earlier trade mark



law of the Court of Justice of the European Union. A sole reference to Article 8(1)(b) CTMR in the contested decision can be qualified as a mere formal error (paras 18-26). Given that the goods in question are confectionery, the level of attention of the relevant public is rather low (paras 37-38). The label of the RCD and the words on that label will be considered by the relevant public as not overshadowing the impact of the three-dimensional box and not affecting the perception that the average consumer will have of it (para. 48). The earlier mark and the RCD both consist of transparent boxes for sweets. The graphical representation of the earlier mark, namely a thin rectangular box with an opaque lid and a label 'straddling' the box from front to back, is included in the RCD. The appearance of the white lid of each box is also similar. As regards the elements that dominate the overall impression conveyed by the RCD, the sweets are not a specific component of that registration which may be taken into account. The RCD differs in certain respects from the earlier mark, principally regarding the curved edges, which are indeed slightly visible on the registered side views, and the label of the RCD, compared to the rectangular shape of the earlier mark. However, in view of their secondary importance, those differences cannot override the similarities. Thus, the signs have significant visual similarities. No phonetic or conceptual comparison is possible (paras 49-59). Insofar as the goods in question are at least highly similar there is a likelihood of confusion, even though the earlier mark has a weak distinctive character (para. 62).

SUBSTANCE: The correct legal basis was Article L713-3 of the French Intellectual Property Code, which confers the earlier rights holder the right to prohibit the use of the RCD. The BoA properly applied this provision, which transposes the provisions of the Trade Mark Directive and thus could be interpreted in accordance with the case-

Editorial

■ Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

■ November 2017

EUIPN Updates

■ Japan joins DesignView

More News

■ 1 January 2018: EUTM applications and renewals by fax

■ Annual User Satisfaction Survey: January

■ IP Case Law Conference

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case Law



Case T 336/15; Windrush Aka LLP v EUIPO; Judgment of 22 March 2017;

Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Burden of proof, Proof of use

FACTS: The EUTM proprietor was granted the registration of the word mark The Specials for goods and services in Classes 9, 16, 25 and 41. An application for revocation on the grounds of lack of genuine use of that mark was filed pursuant to Article 51(1)(a) EUTMR. The Cancellation Division (CD) partly upheld the application for revocation. The applicant filed a notice of appeal with the Office pursuant to Articles 58 to 64 EUTMR. The Board of Appeal (BoA) partly upheld the appeal and found that the EUTM had been used only in respect of compact discs (audio-video) in Class 9. The applicant filed an action before the General Court (GC), alleging infringement of Article 15(2) EUTMR. The GC dismissed the action.

SUBSTANCE: The applicant put forward a single plea in law, alleging infringement of Article 15(2) EUTMR, as the BoA had erred in finding that the intervener had validly consented to the use of the contested mark by a third party in relation to compact discs (audio-video) in Class 9. In this regard, the GC denied that the BoA placed on the applicant the burden of proving that there was no consent on

the part of the intervener to the use of the contested mark by a third party (para. 39). Furthermore, the GC found it irrelevant whether the contested mark was put to genuine use by the intervener or with the intervener's consent (para. 50). Finally, the GC quoted the case-law, according to which, where the EUTM proprietor claims that use of that mark by a third party constitutes genuine use of such mark, he or she is claiming implicitly that that use was made with his or her consent. Furthermore, it seems unlikely that the intervener could have had the relevant documents and submitted them as proof of use of the contested mark if such use had taken place against his or her wishes (para 56).

Case [T-736/15](#); Aldi GmbH & Co. KG v EUIPO; Judgment of 19 October 2017; EU:T:2017:729; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Bad faith, Conceptual similarity, Likelihood of confusion, Phonetic similarity, Request for proof of use, Scope of proceedings, Similarity of the goods and services, Similarity of the signs, Visual similarity

FACTS: The applicant sought to register the figurative mark represented below as an EUTM for goods in Classes 9 and 18. An opposition based on the earlier EUTM word mark SKY registered inter alia for goods in Classes 9 and 18, was filed pursuant to Article 8(1)(b) and Articles (4) and (5) of EUTMR. The Opposition Division (OD) upheld the opposition for the contested goods in Classes 9 and 18.

Editorial

■ Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

■ November 2017

EUIPN Updates

■ Japan joins DesignView

More News

■ 1 January 2018: EUTM applications and renewals by fax

■ Annual User Satisfaction Survey: January

■ IP Case Law Conference

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case Law



The Board of Appeal (BoA) dismissed the applicant's appeal. It found that a request for proof of use made was inadmissible since, at the date of publication of the mark applied for, the relevant earlier mark had been registered for less than five years. Next, the BoA held that the (at least) average degree of visual and aural similarity between the marks and the conceptual similarity due to the concept of sky as well as the identity of the goods at issue meant that there was a likelihood of confusion.

The applicant filed an action before the General Court (GC) relying on two pleas in law: (i) infringement of Article 42(2) and (3) and Article 15(1) EUTMR, read in conjunction with Rule 22(2) of Regulation (EC) No 2868/95, (ii) infringement of Article 8(1)(b) EUTMR.

EUTM application	Earlier trade mark
	SKY

SUBSTANCE: The applicant argued that the request for proof of use was necessary in the case of the repeated applications of an earlier mark which seek to circumvent or prolong the 'grace period' of five years for use of mark, and which, for that reason, appear to be 'abusive' (para. 17). Article 42(2) EUTMR, as applicable at the time of the facts, only requires the opponent to produce, at the applicant's request, proof of genuine use of the earlier mark provided that '... the earlier Community mark was registered for not less than five years' (para. 20). This is not

called into question by the argument that a party operated a 'practice of re-filing identical trade mark registrations' without ever having the intention of using them (para. 23). A finding of bad faith when filing the application for an EU mark is an absolute ground for invalidity under Article 52(1)(b) EUTMR and the EUIPO cannot examine such criteria in the opposition procedure. The EUTMR provides no procedural mechanism that allows the validity of an earlier mark to be contested having regard to the bad faith of the opponent (paras 25 to 27).

There was a medium degree of visual and aural similarity between the signs (paras 92 and 103) and they were conceptually similar (para. 109). The BoA was fully entitled to hold that there was a likelihood of confusion within the meaning of Article 8(1)(b) EUTMR for the goods at issue for the English-speaking part of the relevant public (para. 127).

Case [T-857/16](#); Erdinger Weißbräu Werner Brombach GmbH & Co. KG v EUIPO; Judgment of 26 October 2017; EU:T:2017:754; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Distinctive element, Three-dimensional mark

FACTS: The applicant sought to register the 3D mark represented below as an EUTM for, amongst others, goods in Class 21, namely 'glassware, porcelain and earthenware, so far as included in Class 21; unworked or semi-worked glass (except glass used in buildings); household or kitchen utensils and containers (not of metal or coated therewith)'. 18

Editorial

■ Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

■ November 2017

EUIPN Updates

■ Japan joins DesignView

More News

■ 1 January 2018: EUTM applications and renewals by fax

■ Annual User Satisfaction Survey: January

■ IP Case Law Conference

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case Law



The Office refused the registration of the EUTM application (EUTMA) pursuant to Article 7(1)(b) EUTMR, as it was found to be devoid of distinctive character.

The Board of Appeal (BoA) dismissed the applicant's appeal. It held that it is common for drinking glasses to have more or less fanciful decorations and as shown by the results of a search conducted by the examiner, these also include patterns resembling footballs. The appearance of the mark applied for does not depart significantly from the norms and customs of the relevant sector. Therefore, it is devoid of distinctive character under Article 7(1)(b) EUTMR.

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

EUTM application



SUBSTANCE: The relevant glassware goods are ordinary

consumer goods directed at the public at large (para. 27). The examples referred to by the BoA show cylindrically shaped drinking glasses with a narrower middle part and a rounded top part. Furthermore, drinking glasses are often decorated including patterns resembling footballs. The EUTM application appears to be merely a variant of such common shapes (paras 31-41). Even if the public would associate the drinking glass at hand with a trophy, it is not apparent that it would infer a commercial origin from this (para. 42).

Case [T-330/16](#); Hello Media Group SL v EUIPO; Judgment of 26 October 2017; EU:T: 2017:762; Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion

FACTS: The applicant sought to register the figurative sign represented below as an EUTM for goods and services in Classes 9, 35 and 42. An opposition based on the earlier word mark HELLO! and the figurative sign below, registered for goods and services in Classes 9, 35 and 38, was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The Opposition Division (OD) upheld the opposition for all the goods and services. The EUTM applicant filed an appeal against the decision. The Board of Appeal (BoA) upheld the decision of the OD. It found that a likelihood of confusion (LOC) existed because of the similarity between the earlier marks and the EUTM application, and the similarity or identity between the goods and services. The applicant filed an action before the General Court

Editorial

■ Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

■ November 2017

EUIPN Updates

■ Japan joins DesignView

More News

■ 1 January 2018: EUTM applications and renewals by fax

■ Annual User Satisfaction Survey: January

■ IP Case Law Conference

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case Law



(GC) relying on one plea in law based on infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal.

EUTM application	Earlier trade marks
	1) HELLO! 2) 

SUBSTANCE: The GC confirms the BoA's findings that the relevant public is the European Union public, made up of both the general public and professionals, whose medium to high level of attentiveness depends on the categories of the goods and services (para. 25). Moreover, the contested goods and services are partially identical and partially similar (para. 33). Then, the GC confirmed the BoA's assessment regarding the conflicting signs. For instance, 'digitalmente diferentes' will be perceived as a promotional formula that does not provide any unusual feature, but just a simple and unequivocal message that can be associated to the products and services designated by the EUTMA (para. 46). The symbol '#' will be largely understood as a reference to metadata used in social networks (para. 51). Thus, the term 'digitalmente diferentes' and the symbol '#' have a low degree of distinctiveness (para. 53). Moreover, the term 'hello' is the dominant

element of the EUTMA (para. 61). The GC concluded that the signs in conflict are visually, phonetically similar and conceptually very similar (paras 68, 71 and 74) and that a high level of attentiveness from the relevant public is not enough to avoid any likelihood of confusion (para. 82). Therefore, there is a likelihood of confusion for the goods of Class 9 and the services of Classes 35 and 42 (para. 85). Based on the foregoing, the action was dismissed.

Case [T-331/16](#); Hello Media Group SL v EUIPO; Judgment of 26 October 2017; EU:T:2017:760; Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion

FACTS: The applicant sought to register the figurative sign represented below as an EUTM for goods and services in Classes 9, 35 and 42. An opposition based on the earlier word mark HELLO! and on the figurative sign below, registered for goods and services in Classes 9, 35 and 38, was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The Opposition Division (OD) upheld the opposition for all the goods and services. The EUTM applicant filed an appeal against the decision. The Board of Appeal (BoA) upheld the decision of the OD. It found that a likelihood of confusion (LOC) existed because of the similarity between the earlier marks and the EUTM application, and the similarity or identity between the goods and services. The applicant filed an action before the General Court (GC) relying on one plea in law based on infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal.

Editorial

■ Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

■ November 2017

EUIPN Updates

■ Japan joins DesignView

More News

- 1 January 2018: EUTM applications and renewals by fax
- Annual User Satisfaction Survey: January
- IP Case Law Conference

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case Law



EUTM application	Earlier trade marks
	1) HELLO! 2) 

SUBSTANCE: The GC confirms the BoA's findings that the relevant public is the European Union public, made up of both the general public and professionals, whose medium to high level of attentiveness depends on the categories of the goods and services (para. 21). Moreover, the contested goods and services are partially identical and partially similar (para. 29). Then, the GC confirmed the BoA's assessment regarding the conflicting signs. For instance, 'media group' is basic English vocabulary, and designates a conglomerate of businesses in the media field (para. 40). The symbol '#' will be largely understood as a reference to metadata used in social networks (para. 44). Thus, the term 'media group' and the symbol '#' have a low degree of distinctiveness (para. 46). Moreover, the term 'hello' is the dominant element of the EUTMA (para. 54). The GC concluded that the signs in conflict are visually, phonetically similar and conceptually very similar (paras 61, 64 and 67) and that a high level of attentiveness from the relevant public is not enough to avoid any likelihood of confusion (para. 75). Therefore, there is a likelihood of confusion for

the goods of Class 9 and the services of Classes 35 and 42 (para. 78). Based on the foregoing, the action was dismissed.

Case [T-844/16](#); Alpirsbacher Klosterbräu Glauner GmbH & Co. KG v EUIPO; EU:T:2017:759; Judgment of 26 October 2017; Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Descriptive element, Deceptive element

FACTS: The applicant sought to register the word mark Klosterstoff as an EUTM for goods and services in Classes 32 and 33. The examiner refused the application as non-distinctive, descriptive and deceptive based on Articles 7(1)(b), 7(1)(c) and 7(1)(g) EUTMR. The applicant filed an appeal before the Board of Appeal (BoA). The BoA dismissed the appeal. It found that the word 'Klosterstoff' would be understood, by the German-speaking public, as designating products containing alcohol, originating from a monastery or produced there. Therefore, the sign is non-distinctive, descriptive and deceptive.

The applicant filed an action before the General Court (GC) relying on four pleas in law: (i) infringement of Article 7(1)(c) EUTMR; (ii) infringement of Article 7(1)(b) EUTMR; (iii) infringement of Article 7(1)(g) EUTMR; and (iv) ignorance of the Office's previous decision-making practice. The GC dismissed the appeal.

SUBSTANCE: The GC dismissed the first plea. Thus, it found that the BoA correctly held that the public

Editorial

■ Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

■ November 2017

EUIPN Updates

■ Japan joins DesignView

More News

■ 1 January 2018: EUTM applications and renewals by fax

■ Annual User Satisfaction Survey: January

■ IP Case Law Conference

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case Law



targeted by the contested mark consists of the general Germanophone public or the public mastering basic German vocabulary. And the degree of attention of the relevant public is reasonably well informed and reasonably observant and circumspect (para. 17). Then, the GC confirms that the terms 'kloster' and 'stoff' are descriptive for they would be understood by the relevant public as references to products containing alcohol originating from a monastery or produced there (para. 18). The second plea is also dismissed. Indeed, the GC recalls that as the sign is considered descriptive, then it cannot be registered. Therefore, assessing its distinctiveness is not necessary (para. 36). The third plea is also dismissed. Indeed, the applicant seeks to register the sign for non-alcoholic beverages. Yet, the term 'stoff' means 'alcohol'. Therefore, consumers are likely to believe that they are purchasing alcoholic beverages, even though they are not. Consequently, the sign is considered deceptive (para. 43). Finally, the fourth plea is also dismissed. Indeed, contrary to the applicant's claims, the Office has sufficiently stated reasons for its decision (para. 54). Based on the foregoing, the action was dismissed (para. 59).

Case [T-184/16](#); NRJ Group v EUIPO; Judgment of 6 October 2017; EU:T:2017:703; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Conceptual similarity, Enhanced distinctiveness, Likelihood of confusion, Phonetic similarity, Purpose of the goods and services, Similarity of the goods and services, Similarity of the signs, Visual

dissimilarity

FACTS: The applicant sought to register the word mark SKY ENERGY as an EUTM for goods and services in Classes 9, 35, 38, 41 and 45. An opposition based on the earlier word mark NRJ was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) dismissed the opposition finding that there was no likelihood of confusion.

The Board of Appeal (BoA) partly upheld the opponent's appeal finding likelihood of confusion for certain goods and services in Classes 9, 38 and 41. The BoA found the marks to be visually dissimilar but phonetically and conceptually similar. It found likelihood of confusion where several cumulative factors applied: (i) the contested goods and services must be identical and similar to the earlier 'radio broadcasting' and 'radio entertainment' (services for which the BoA found the earlier mark enjoyed enhanced distinctiveness through use); (ii) the contested goods and services must be aimed at the general public (for whom the level of attention is not high); and (iii) the relevant consumer must buy or access the goods and services in circumstances where the mark will not be apparent visually.

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

SUBSTANCE: The intervener's request that the GC reinstate the OD's decision is a 'cross-claim' because it seeks the annulment of the contested decision on a matter which is not raised in the application. This cross-claim was

Editorial

■ Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

■ November 2017

EUIPN Updates

■ Japan joins DesignView

More News

- 1 January 2018: EUTM applications and renewals by fax
- Annual User Satisfaction Survey: January
- IP Case Law Conference

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case Law



contained in the response and not in a separate document which does not satisfy the requirements in Article 182(1) and (2) RPGC. It must be rejected as manifestly inadmissible (paras 31-32). The advisory services in Class 45 are completely different in nature from broadcasting services (para. 43). The BoA made clerical errors as regards the goods and services on which the opposition was based but there was no failure to adjudicate as the omission related to the mere addition of the words 'services for the' to services that were compared and the BoA implicitly intended to apply the same reasoning (paras 45-47). The marks at issue are phonetically similar overall as the pronunciations of 'nrj' and 'energy' by the French-speaking public is very similar (para. 55). The marks are conceptually similar inasmuch as they both refer to the term 'energy', in particular for the French-speaking public which has already heard the earlier mark being pronounced (para. 56). The BoA was right in finding that the earlier mark had enhanced distinctiveness only in relation to the services of 'radio broadcasting' and 'radio entertainment' (para. 79). The BoA was right in finding that there is a likelihood of confusion only with regard to the goods and services that are: (i) identical or similar to the earlier 'radio broadcasting' and 'radio entertainment' for which the earlier mark enjoyed enhanced distinctiveness; (ii) aimed at the general public; and (iii) purchased or accessed in circumstances where the mark will not be apparent visually (paras 81-98).

Case [T-144/16](#); Mundipharma AG v EUIPO; Judgment of 7 November 2017; EU:T:2017:783; Language of the case: DE

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Descriptive element, Distinctive element, Likelihood of confusion, Weak element, Similarity of the goods and services, Similarity of the signs, Visual similarity, Phonetic similarity, Scope of proceedings

FACTS: A registration for the word mark MULTIPHARMA as an EUTM was sought for goods and services in Classes 5, 35 and 42. An opposition based on the earlier word mark MUNDIPHARMA regarding covered goods in Class 5 was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition and an appeal was filed against the OD's decision. The Board of Appeal (BoA) upheld the appeal and annulled the OD's decision, insofar as it found that there was no likelihood of confusion (LOC), taking into account the increased level of attention on behalf of the relevant public, the clear conceptual differences between the signs and the inherently weak distinctive character of the earlier mark. The opponent filed an action before the General Court (GC) on the ground of a single plea: infringement of Article 8(1)(b) EUTMR.

SUBSTANCE: The relevant public consists of professionals from the medical field as well as average end consumers within the EU, both with a higher level of attention when recommending or buying the product, either with or without a medical prescription, since pharmaceutical products affect health (paras 24 and 26). After recognising the partial identity and varying degrees of similarity between the goods (para. 32), the GC found the following regarding the comparison of signs: i) the signs are visually similar in terms of the overall impression created, because of the common verbal elements 'mu' and 'pharma' (despite

Editorial

■ Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

■ November 2017

EUIPN Updates

■ Japan joins DesignView

More News

■ 1 January 2018: EUTM applications and renewals by fax

■ Annual User Satisfaction Survey: January

■ IP Case Law Conference

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



Case Law



the descriptive and hence, weak distinctive character of the latter). Their only difference, the verbal elements 'nd' and 'lt', is negligible, as these are positioned in the middle of the word sign (paras 37 and 43); ii) the signs are phonetically similar for the same reasons that justify the visual similarity, regardless of the different rules of pronunciation that apply in different parts of the relevant territory (para. 50); iii) it is impossible to carry out a conceptual comparison as none of the signs have a clear and specific meaning in the mind of the relevant public (para. 60). In any case, there is no clear conceptual difference that could counteract the visual and phonetic similarities, since both MUNDIPHARMA and MULTIPHARMA have various meanings; furthermore, 'mundi' and 'multi' are often used as banal terms in the marketing of goods or services (paras 55-57 and 64). LOC: given the contested goods and services are partly identical and partly similar, the signs are visually and phonetically similar, and the impossibility of assessing the existence of a clear conceptual difference, there is likelihood of confusion in the mind of the relevant public, even when it has a higher level of attention (para. 70). SCOPE OF PROCEEDINGS: For the purposes of the conceptual comparison, the GC legitimately took into account a relevant judgment issued by a national (German) court and submitted before it for the first time, assessing it as case-law cited in support of the plea regarding the infringement of Article 8(1)(b) EUTMR (para. 62).

Case [T 441/16](#); Tetra Pharm (1997) Ltd v EUIPO; Judgment of 23 October 2017; EU:T:2017:747; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Lack of reasoning, Phonetic similarity, Similarity of the signs, Visual similarity, Weak element

FACTS: The applicant sought to register the word mark SeboCalm for goods in Class 3. An opposition based on the earlier EU word mark Sebotherm, registered for, inter alia, goods in Class 3, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition for all the contested goods and rejected the application in its entirety. The Board of Appeal (BoA) dismissed the applicant's appeal finding that the unitary character of the EUTM means that an opposition may prevail if there is likelihood of confusion in only part of the EU. In this case, the average Slovak-, Bulgarian- and Estonian-speaking public do not perceive 'Sebo' at the beginning of the marks as having any meaning nor do they understand the remainder of the marks — the English words 'Calm' and 'therm'. Consequently, the marks do not convey any concrete concept that impacts their respective distinctiveness. Due to the similarity of the marks (identical beginnings and similar structure) and the fact that the goods are identical, a likelihood of confusion could not be excluded. The applicant filed an action before the General Court (GC) relying on: Article 8(1)(b) in conjunction with Article 7(2), Article 75 and Article 76(1) EUTMR. The GC dismissed the appeal.

SUBSTANCE: RELEVANT PUBLIC: The GC confirmed that it follows from the unitary character of the EUTM that an earlier EUTM is protected in the same way in all Member

Editorial

■ Common Communication

James Nurton
Interviews

Andrea Lensing-Kramer

Statistical Highlights

■ November 2017

EUIPN Updates

■ Japan joins DesignView

More News

■ 1 January 2018: EUTM applications and renewals by fax

■ Annual User Satisfaction Survey: January

■ IP Case Law Conference

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case Law



States and may therefore be relied on in opposition to any subsequent application to register a trade mark which infringes that protection even if it is only in the perception of the consumers of only a part of the EU. The principle laid down in Article 7(2) EUTMR — whereby registration of an EUTM is to be refused where an absolute ground for refusal exists in part of the EU only — applies by analogy to Article 8(1)(b) EUTMR (para. 24). There is no breach of the duty to state reasons as regards limiting the analysis to a part of the public as this issue was explicitly addressed by the BoA (para. 26). The degree of attention of the relevant public is not high enough for these everyday cleaning and personal hygiene goods (paras 28 to 36). COMPARISON OF MARKS: The marks are almost identical in length and they have the same first four letters and the same last letter (para. 44) which renders them visually (para. 40 et seq.) and phonetically (paras 60 to 62) similar to an average degree. The visual and the phonetic aspects have the same weight (para. 59). A conceptual comparison cannot be made since the word elements and the marks as a whole are not understood by the relevant consumers (paras 67 and 68). OVERAL ASSESSMENT: Due to the similarity of the goods (para. 37), the average degree of visual and phonetic similarity of the marks (paras 55 and 62), the lack of meaning of the marks for part of the relevant public (para. 69) and the average degree of inherent distinctive character of the earlier mark (para. 75), the BoA rightly held that it was clear from an overall assessment of the conflicting marks that there was a likelihood that part of the relevant public would believe that the products at issue are from the same undertaking or from economically linked undertakings (para. 76).

Editorial

■ Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

■ November 2017

EUIPN Updates

■ Japan joins DesignView

More News

- 1 January 2018: EUTM applications and renewals by fax
- Annual User Satisfaction Survey: January
- IP Case Law Conference

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case Law



New Decisions from the Boards of Appeal

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

[05/10/2017, R 617/2017-1, CHAMPAGNE PRINCESSE D'ISENBURG \(fig.\) / COMTES D'ISENBURG et al.](#)

Contested sign



Earlier mark

COMTES D'ISENBURG

Result: Decision confirmed

Keywords: Likelihood of confusion

Norms: Article 8(1)b EUTMR

Facts: The opponent filed an opposition on the grounds of Article 8(1)(a) and Article 8(1)(b) EUTMR, relying on an earlier word mark, registered for wines and alcoholic beverages, explicitly defined as coming from the region of Alsace. The contested sign was filed in Class 33 for wines in conformity with the specifications of the PDO 'Champagne'. The Opposition Division upheld the opposition, finding that the goods, even if likely to come from different regions, were anyhow similar in their genre (wines) and that the signs were similar too, at least for the French-speaking consumers.

Substance: The opposition decision is confirmed. The goods compared are wines that, even if coming from different regions of France, are considered to be highly similar (§ 23). There is also a visual and phonetic similarity between the earlier mark 'Comtes d'Isenbourg' and the dominant word element of the contested mark 'Princesse d'Isenbourg' (§ 29-30). A certain degree of conceptual similarity is also recognized between the signs, to the extent that the public is likely to understand the expressions 'Comtes d'Isenbourg' and 'Princesse d'Isenbourg' as references to members of the noble family of 'Isenbourg' (§ 32). The average wine-drinking consumer is likely to

Editorial

■ Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

■ November 2017

EUIPN Updates

■ Japan joins DesignView

More News

- 1 January 2018: EUTM applications and renewals by fax
- Annual User Satisfaction Survey: January
- IP Case Law Conference

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case Law



consider that the wines at issue, independently of their region of origin or kind, may have the same commercial origin, i.e. come from different vineyards of the same wine producer (§ 40). Therefore, there is a likelihood of confusion in the European Union.

[24/10/2017, R 671/2017-4, CERTIFIED WILDLIFE FRIENDLY](#)

Result: Decision confirmed

Keywords: Admissibility, company name, descriptive element, distinctive element, quality of the goods

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

Facts: The examiner rejected the application, considering the sign applied for products in Classes 4, 6, 14, 16-18, 22-25, 27, 29-31, descriptive and devoid of distinctive character. The applicant appealed the decision and filed its statement of grounds on 3 April 2017.

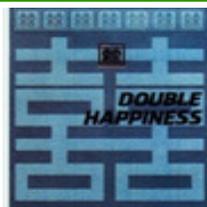
Substance: The Board finds that the appeal is not well founded. The mark consists in a common expression, 'Certified Wildlife Friendly', likely to be used as description or quality of the goods at hand. The trade mark, therefore, is descriptive and not distinctive. This descriptive nature is also not overcome by the applicant's argument that the trade mark is considered as 'a wordplay of the applicant's company name' [Wildlife Friendly Enterprise]. The mark is in fact immediately comprehensible by the consumers and the alleged wordplay would not be visible from their

perspective (§ 30).

Last but not least, the right to protect one's own name is no longer extended to company names. After the legislative reform of Article 12(1)(a) EUTMR, that took place on 23 March 2016, a claim can be based only on the basis of names of natural persons. The argument claiming rights on the basis of a company name was made at the time when such an option was no longer effective (§ 31-32).

[17/10/2017, R 644/2017-4, DOUBLE HAPPINESS \(fig.\) / SHUANGXI \(fig.\) et al.](#)

Contested sign



Earlier marks

Editorial

Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

November 2017

EUIPN Updates

Japan joins DesignView

More News

- 1 January 2018: EUTM applications and renewals by fax
- Annual User Satisfaction Survey: January
- IP Case Law Conference

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

Case Law



Result: Decision confirmed

Keywords: Dissimilarity of signs, likelihood of confusion

Norms: Article 8(1)(b) EUTMR

Facts: The applicant sought to register the figurative sign consisting of the words 'DOUBLE HAPPINESS', written in Latin characters over a blue background of Chinese characters, for goods in Class 34 (mainly cigarettes, cigars and related products).

The opponent opposed the registration on the grounds of Article 8(1)(b) EUTMR and on the basis of three earlier figurative trade marks. These trade marks are also characterized by the presence of Chinese characters on a coloured background. The Opposition Division rejected the opposition and the opponent filed an appeal.

Substance: The Board finds that the appeal is not well founded because, as the first instance stated, there is no likelihood of confusion between the conflicting trade marks.

In fact, the marks at issue have been recognized as dissimilar from a visual point of view. As much as it concerns the aural and conceptual points of view, the Board considers that the relevant public in the European Union is not familiar with the Chinese language; therefore, the average consumer does not know how to pronounce the Chinese characters and is not capable of giving them any particular meaning. These characters will be conceived as 'random oriental character[s]' that could have a meaning only for the Chinese-speaking public, a factor not relevant in the assessment of the risk of confusion for EUTMs (§ 22-23, § 27, § 29-31).

Editorial

■ Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

■ November 2017

EUIPN Updates

■ Japan joins DesignView

More News

■ 1 January 2018: EUTM applications and renewals by fax

■ Annual User Satisfaction Survey: January

■ IP Case Law Conference

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case Law



12/10/2017, R 1001/2017-4, Ice blue (fig.)

EUTMA

Ice blue

Result: Decision reversed in full

Keywords: Descriptive element

Norms: Article 7(1)(c) EUTMR

Facts: The applicant filed an application for the figurative sign for products in Classes 7 and 11. The examiner found the sign to be descriptive and non-distinctive within the meaning of Article 7(1)(c), (b) and Article 7(2) EUTMR. He reasoned that 'ice blue' would be understood by its lexical meaning of 'very pale blue'. The sign immediately informed the relevant English-speaking consumer that the goods applied for were of a very pale blue colour. Given its descriptive meaning, the sign was also devoid of any distinctive character.

Substance: The Board, contrary to the examiner's decision, found that the sign is neither descriptive nor devoid of any distinctive character.

The wording 'ICE BLUE', meaning 'very pale blue colour', can be conceived as descriptive of the qualities of the

product only when such name designates also a specific type of product corresponding to that colour. In the case at issue though, there is no link between an ice blue colour and, for example, electric household appliances. A product category of ice blue vacuum cleaners, washing machines, dishwashers, refrigerators etc. does not exist (§ 10).

Since the examiner based the refusal of the mark on it being non-distinctive as regards its descriptive nature, given the fact that the relevant public will not perceive a descriptive meaning in the mark in relation to the goods applied for (§ 13), the Board annulled the contested decision and allowed the application to be registered.

17/11/2017, R 0820/2017-2 DEVICE OF A FLOWING CIRCULAR BLUE RING (al.)

EUTMA



Result: Decision reversed in full

Keywords: Graphical representation, motion mark

Norms: Article 7(1)(a) EUTMR, Article 7(1)(b) EUTMR, Article 3(3)(h) EUTMDR

Facts: The applicant sought to register the motion trade mark at issue characterized by a 'flowing circular

Editorial

■ Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

■ November 2017

EUIPN Updates

■ Japan joins DesignView

More News

■ 1 January 2018: EUTM applications and renewals by fax

■ Annual User Satisfaction Survey: January

■ IP Case Law Conference

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case Law



blue ring' depicted in five different stages, in five different shades of blue, in Classes 9, 35, 41 and 42. The examiner refused the application pursuant to Article 7(1)(a) EUTMR, because neither the description nor the representation of the trade mark shows the 'flow' of the sign. There are also no indications relating to direction or speed or how the colours change during the movement.

Substance: The contested decision is annulled on the grounds that the mark was adequately graphically represented, pursuant to Article 7(1)(a) EUTMR, meaning that a reasonably observant person with normal levels of perception and intelligence is, upon consulting the EUTM register, able to understand precisely what the mark consists of, without expending a huge amount of intellectual energy and imagination (§ 19-21).

However, the simplicity of the sequence of the rings and the negligible touches of blue around the narrow circumferences may not be sufficiently distinctive to act as a badge of trade origin for some or all of the goods and services for which registration is sought. Consequently, the case is remitted to the examiner to decide on the mark's registrability pursuant to Article 7(1)(b) EUTMR (§ 28).

Editorial

■ Common Communication

James Nurton Interviews | Andrea Lensing-Kramer

Statistical Highlights

■ November 2017

EUIPN Updates

■ Japan joins DesignView

More News

- 1 January 2018: EUTM applications and renewals by fax
- Annual User Satisfaction Survey: January
- IP Case Law Conference

Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal