

Alicante News

Up to date information on IP and EUIPO-related matters



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for advanced IP management**

 Key User Programme
Advanced IP management

July 2017

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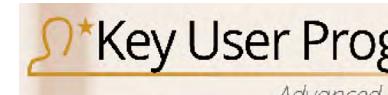


Key User Programme for advanced IP management

The Key User Programme, launched in 2017, supports users to become more efficient by offering advanced IP management solutions. There are currently more than 350 key users in the Key User Programme (KUP) who together account for almost 40% of EUIPO trade mark applications. The benefits of the programme for users include direct support and guidance on trade mark and design applications and access to user performance statistics.

The programme is very easy to use; the only requirement is that participants hold a current account and opt in to receiving electronic communications option ticked off. In 2016, users who have chosen the EUIPO's online communication services saved EUR 3.7 million in administrative costs.

The Key User Programme offers a dedicated team to guide users through the entire e-filing process and beyond, and an advanced User Area with access to all the user's e-filing statistics and e-communications. This allows users to see their own performance, and benchmark their activities against average performance in terms of volumes, the percentage of e-filing, the percentage of straight-through files and usage of the harmonised database. The programme also offers up to the minute information about payment and fees to



be debited automatically (this ensures prompt payment) and tailor-made advice about online tools and Office practice. Key User Programme adherents also have a dedicated news feed and newsletter to keep them up to date with the Office and its latest filing tips.

The programme began in 2013 in pilot phase, focusing on the EUIPO's top 250 users in terms of volumes of trade marks and designs. The pilot phase also incorporated visits by participants to the Office, in which users met examiners in a series of exchanges which helped both the Office and its users. The pilot ended in 2016, and the Key User Programme was opened to all users on 10 April 2017. Around 90% of the original pilot participants said they would continue being part of the full programme.

Nicolas Vigneron, the project manager of the Key User Management Programme considers that "EUIPO is offering an additional layer of service and guidance for users. We visit them and explain our practice, provide them with their results and performance, draw attention to potential anomalies and provide training. It is this extra service that really counts."

EUIPO continues to develop the programme by creating new service-friendly tools and optimising the rate of straight-through files. The Key User Programme's 'clearance pilot', for instance, is a way

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to flag up delays or issues in the process or issues as soon as possible, and provide quick solutions. If there are any possible issues with classification, the user is contacted and informed about an alternative from the Harmonised Database whenever possible. Another tool being currently provided only to key users during this pilot phase is an online chat, to ensure direct communication and provide more effective guidance when filling in an application for a EUTM or RCD online. Depending on the success of this new service, it could be extended to more tools, and to all users.

Alain Rassat, Director of EUIPO's Customer Services Department, said: "EUIPO was recently named as the world's most innovative IP office in a global survey carried out by the intellectual property magazine World Trademark Review. One of the most innovative aspects of our organisation is our commitment to the Office's users who are at the heart of our organisation."

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The James Nurton Interview

Interview: Zsófia Lendvai, Baker McKenzie, Budapest

How did you become interested in IP?

I wrote my thesis at university on copyright law – which I was interested in because I played the cello. The final thesis was about performing artists and sheet music. At the time I didn't want to work in a law firm, and I did not look for an opportunity for work during my studies.

After law school I went sailing with my father in mid-summer. While we were sailing, he told me he thought it was time to look for a job. During a lunch break on the shore I bought a paper and saw an advert from the BMG record company. They



Zsófia Lendvai



wanted a handwritten CV which I could do even on a sailing boat. And I got the job as a young lawyer and assistant to the managing director, which was very interesting work. I got to meet the musicians and learn about the business.

I was also interested in the academic field so I applied for a scholarship to do a PhD in Germany. My dissertation was a comparative study of the English and German systems of authors' moral rights. My tutor was Professor Hartwieg. I also spent time at Cambridge studying with Professor Cornish. My thesis was published by the Max Planck Institute in Munich.

This was before Hungary joined the EU so I couldn't stay in Germany. But in 2003 the Hungarian Ministry of Justice was looking for people to work on Hungary's accession to the EU so I had the chance to work on the legislation affecting IP laws and free movement of services. It was a very exciting time and I shifted a bit from copyright to industrial property. Because of that, I later moved to Gedeon Richter, the biggest pharmaceutical manufacturer in the region, where I was deputy head of the IP department. It was very interesting patent work, with a lot of multi-jurisdictional patent disputes for example in Hungary, Romania, Russia and before the EPO. I also had to learn a bit about the chemistry and talk to scientists. I was also dealing with employee inventions, namely the provision of incentives for employee inventors and their

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The James Nurton Interview



remuneration, as well as trade mark work and licensing and R&D agreements.

While I was there I was headhunted by Baker McKenzie, where I now work. So I have had different perspectives of IP – academic, legislation, in-house and now in a law firm.

What kind of work do you do now?

I do all aspects of IP – which is typical in a small country. We don't have the privilege to work in only one part of IP but on the other hand it's fortunate because you can see the connections and synergies between these fields. For example, if you have done an enforcement case in copyright, that might be useful for a trade mark case. I also get to see the whole lifespan of trade marks from searching and clearing through to enforcement and licensing.

I still think copyright is the most interesting area as it always has to adapt to new technologies, but trade marks makes up around 60% of my work. In our office we work cross-practice which means that I for example cooperate with our competition law team to ensure that the IP licensing agreements comply with the competition law rules or with our M&A group if the target company's operation is based on some essential IP elements (e.g. software or licences).

What do you think of the EU trade mark system?

I think the EU system works well. In countries like Hungary we don't always like the fact that it takes away work from the smaller countries. But from the client's perspective it is a very useful system. Despite the single market and harmonisation, within Baker McKenzie we often receive mandates for multi-jurisdictional risk assessments and surveys, which often reveal differences in the approaches used in the different jurisdictions.

I think the EUIPO is fast, handy, approachable – you can always talk to or write to them – and the electronic filing is very good. The system is well organised and it is easy to find know-how and precedents online. I can understand why more and more people opt for EUTMs! The broad geographic scope of EUTMs can lead to an increased number of conflicts of trade marks. However, the majority of disputes are closed by settlement agreements. The national and European trade mark system can exist in parallel well.

What about the Hungarian system?

Compared with other eastern European countries, the Hungarian IP system is based on a long tradition as even during the socialist regime the Hungarian legal system maintained modern rules on IP. The Hungarian Intellectual Property Office works along similar European standards to the EUIPO and the

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The James Nurton Interview

Office's decisions often refer to European practice and case law.

In the courts, we have specialised judges in trade mark and patent civil cases and we have one court in Budapest, which is good as it provides for consistent judgments. The judgments often stress that the courts apply Hungarian law and are not bound by foreign decisions. In copyright and criminal cases we see the need for specialisation.

We don't really have statistics on the number of cases. The hearings are public but you have to go to court to get the list. It's a pity it's not online. The final and binding judgments are published months later but they have to be anonymised, which can be a problem in trade mark cases when you compare two trade marks. This obligation to anonymise the judgments is hard to understand, especially given that the hearings are public. Practitioners have to ask each other about the cases to find out the details.

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

I recently had a case where I was working for The Body Shop and we filed an opposition action against a trade mark application for THEFACESHOP. It's a challenge to convince the judge that people understand the English words, and there was also a question over the word "The" and how distinctive



that is in the trade mark. In the end we prevailed and the trade mark did not go on to registration.

I have had a lot of interesting copyright cases. We just represented the most famous Hungarian musician Gabor Presser in a case against Kanye West, over the use of his music from 1969 in the song "New Slaves" on the album Yeezus. Kanye West did the rap but the music was sampled from a song that is very famous in Hungary. It took many years to resolve the dispute, but it was finally settled with the help of a US lawyer.

I would love to do more music cases! But it's difficult to get the work – some musicians think that big law firms are expensive. We do work on producer agreements. We had one interesting case where a well-known ballet made a Queen ballet, and had sold the tickets, but forgot to get the licence for the music. We had to track down the licensing manager in Switzerland two weeks before the premier.

It must be challenging to work with smaller clients?

IP awareness is low in Hungary. Creators often only think about IP when their creation has already been stolen and it's too late. And even then their first thoughts are: "It's not worth it, I'm quite small, I don't have a chance." That is common to see. People also sometimes don't like to ask for an NDA from a big company because they think it will be embarrassing. This makes enforcement not easy.

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The James Norton Interview

Do you work closely with your IP lawyers in other offices?

I have more common projects with my other IP colleagues from other Baker offices than for example with the banking and finance lawyers in my own office. For example, the government asked us to do some research on counterfeits and the assessment of damages in criminal cases, and I was able to get an answer to this question from all over Europe in just two days. IP is a very close community within Baker McKenzie. We meet twice a year, which is very inspiring.

What do you think the future will hold?

In a world where we communicate with text messages and signs and icons such as emoticons, I think trade marks will become ever more important. A few weeks ago I went for a walk with my two-year-old son and when we passed an empty construction area he saw a sign that must have been 30 years old for Shell oils and asked me: "Is there a gas station here?" That reminded me how important in our daily communication and orientation trade marks are. We will see more non-traditional trade marks, but I think the traditional words and slogans will still dominate.

There is a big debate now about trade secrets, and whether there will be a shift away from registered rights protection. Baker McKenzie has just published with Euromoney Institutional Investor Thought



Leadership a survey on this topic, which is very topical also because of the Trade Secrets Directive which has to be implemented in the Member States in less than one year's time. As for copyright, people have been saying for 120 years it is dead!

In Hungary I hope we will make the shift to an innovation-based economy and we see more investment. Without investments we cannot hope for the growth of IP. We do see a lot of start-ups but they don't have awareness of IP, or many times appropriate financial resources for IP protection. The danger for them is they go to law firms when it is often too late to secure their IP rights, and to establish who is the holder of the IP. This, however, means that they don't get investment from venture capital because the due diligence reveals this deficiency. Where we can, we try to do pro bono work for them to help.

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

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Registered Community Design

The importance of disclaimers

The importance of the disclaimers in the assessment of the subject matter of protection of designs: 04/07/2017, Murphy/EUIPO — Nike Innovate (Electronic wrist band), T-16/16, Application for Community design representing an electronic wrist band, EU:T:2017:464

In July this year, the General Court (GC) had to interpret the subject matter of protection of conflicting designs.

The contested design was registered for Measuring instruments, apparatus and devices and was represented as follows:



The applicant filed an invalidity request based on a lack of individual character under Article 6(1)(b) CDR and submitted, inter alia, the following earlier design, registered for 'flexible LCD watch bands':



The Invalidity Division rejected the application for a declaration of invalidity and the Board of Appeal confirmed the contested decision. The applicant appealed to the GC and put forward three pleas in law, all of which were rejected by the GC and the contested decision was upheld.

With the plea relating to the lack of individual character the applicant claimed that the overall impression produced by the designs at issue was not properly assessed, inter alia, by disregarding his explanations relating to the prior design and to what it would have looked like in its finished state, in both its on and off positions.

It is worth looking into the assessment of this plea in law in more detail, as it provides useful guidance in relation to the usage of disclaimers in interpreting the subject matter of protection of a design.

In its assessment the GC endorsed the Board of Appeal findings in relation to the various differences of the designs compared, such as by the presence of an oval button embedded in the top surface, the use of transparent material and the absence of ornamentation on the outer surface in the contested design.

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The GC further noted that in accordance with the case-law, the comparison of the overall impressions produced by the designs must relate solely to the elements actually protected, without taking account of the features excluded from the protection. Contrary to the explanations of the applicant, the GC stated that the prior design differed from the contested one as it contained indications of time and measurement, a figure of a man diving, thin lines running around the wristband on both sides and a lighter-coloured thin line running around the wristband in the middle of its outer surface. It is those features of the prior design which were visible in the representations of it which were protected.

Consequently, the GC disregarded the explanations submitted by the applicant before the Board of Appeal in relation to the fact that the electronic features and the wristband display were hidden unless it was switched on or activated. The GC stated that the applicant would, inter alia, have been able to use dotted lines to represent the unclaimed features of the design. Thus, a written explanation of the prior design was not even necessary.

It is worth noting that by arriving to this conclusion the GC made a reference to the Guidelines for Examination of Registered Community Designs of the EUIPO, as well as to the judgment of 14/06/2011, Sphere Time v OHIM — Punch (Watch attached to a lanyard), T 68/10, EU:T:2011:269, paragraphs 59 to 64), so encouraging the applicants to use disclaimers when registering Community designs.

The case described also illustrates how important it is



to pay particular attention to the representation of the design in the filing strategy as it plays an essential role in determining the subject matter of protection of design. Moreover, the representation of a design is of particular importance in design invalidity proceedings. According to the case-law, the comparison of the overall impressions produced by the designs must relate solely to the elements actually protected, without taking account of the features excluded from protection. Therefore, it is worth repeating that the representation should contain only the design for which protection is sought excluding any other matters.

Finally, it must be recalled that the usage of disclaimers (e.g. broken lines, blurring, boundaries or colour shading) to indicate what is not intended to be protected is in accordance with Common Practice (CP6). Disclaimers are also foreseen, as the GC mentioned, in the Guidelines for Examination of Registered Community Designs of the EUIPO, where it is clearly indicated that disclaimers must be apparent from the representation of the design itself, rather than be included in the description of a design.

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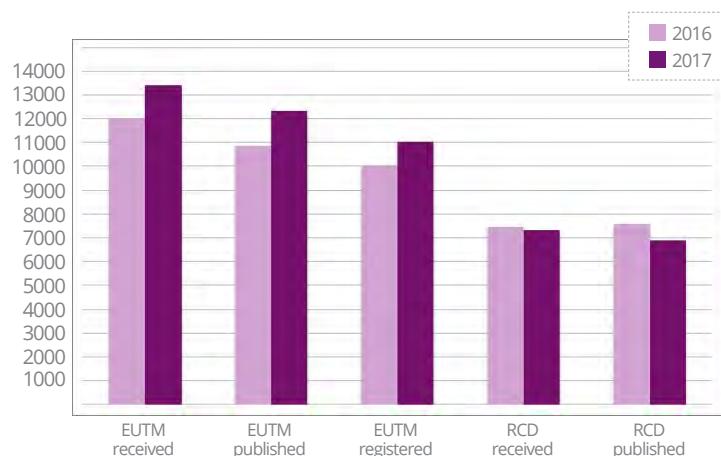


Statistical Highlights



Monthly statistical highlights June*	2016	2017
European Union Trade Mark applications received	12 025	13 416
European Union Trade Mark applications published	10 887	12 345
European Union Trade Mark registered (certificates issued)	10 034	11 028
Registered Community Designs received	7 431	7 331
Registered Community Designs published	7 572	6 881

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



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EUIPN Updates

USS implemented in Bosnia and Herzegovina, FYROM and India

The Institute for Intellectual Property of Bosnia and Herzegovina (IIP-BIH), the State Office for Intellectual Property (SOIP) of FYR of Macedonia and the Controller General of Patents, Designs and Trade Marks (CGPDTM) of India implemented the User Satisfaction Survey (USS) tool on 10 July.

This is a strategic objective for the Office within Line of Action 4 of the Strategic Plan 2020, and forms part of the extension of the European Union Intellectual Property Network (EUIPN) tools to IP offices outside the European Union.

This is the first time that the USS tool has been extended beyond the borders of the European Union.

The Common User Satisfaction Survey allows for a common approach in carrying out surveys across participating IP offices.



The Israel Patent Office (ILPO) joins TMclass

On 17 July 2017, the Israel Patent Office (ILPO) joined TMclass.

This last addition brings the total number of national and regional IP Offices, including OAPI, WIPO and EUIPO, in the tool to 63.

TMclass offers users the opportunity to search and translate goods and services to and from any of the 42 available languages, with Hebrew as the latest incorporation.

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Representatives of users associations contributing to the quality of EUIPO Decisions

On 6 and 7 July, as part of the Stakeholder Quality Assurance Panels (SQAP) project, EUIPO welcomed a panel of users to participate in an audit on the quality of opposition decisions. It was the second of a series of three pilot audits planned for 2017.

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In its [Strategic Plan 2020](#), EUIPO sets a goal of enhancing customer-driven quality services by being user-oriented and focusing on the quality of EUIPO's products and services. In this context, the SQAP aims to involve users in the quality management of the Office, and in contributing to the quality of the Office's decisions. The SQAP project will be run as a pilot initiative during 2017, in order to gain further feedback on its methodology, with a view to consolidating the exercise in 2018.

During the July audit, 13 auditors representing seven user associations checked EUIPO opposition decisions to assess their quality in accordance with the Office's quality criteria. Following a peer review, discussions took place between user representatives and EUIPO experts to assess and explain each finding, which were then reflected in an audit report.



Benjamin Fontaine from the European Communities Trade Mark Association (ECTA) praised this new form of dialogue. "We are invited to share our opinion on the work done by the Office, on all of its procedures," he said. "This is a luxury because we can contribute in improving the quality, the examiners' work, the way the Office perceives [quality], or the way we might like - or not like - the way they work."

The SQAP project represents an opportunity for users to play a proactive role in the Office's quality processes, enabling EUIPO to gather valuable feedback and to address the gap between the users' perceived quality of decisions with that of the Office's.

Jana Bogatz from the International Trademark Association (INTA) underlined that "it's always good to see how EUIPO examiners work, what they think, or what the rationale is behind their decision."

Roland Mallinson from MARQUES (the Association of European Trade Mark Owners) also praised the initiative. "It's been interesting working with other people in the audit team," he said. "It's also been very interesting to meet those working in EUIPO and, obviously, see how they think and, perhaps, let them hear a little bit about how we think. I think the opportunity has been very positive."

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The 13 auditors represented the following user associations:

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- Benjamin Fontaine (ECTA)
- Steve Felix (APRAM)
- Julien Delucenay (APRAM)
- Roberto Kunz-Hallstein (GRUR)
- Paola Ruggiero (INTA)
- Tobias Dolde (ECTA)
- Jana Bogatz (INTA)
- Cristina Bercial-Chaumier (INTA)
- Roland Mallinson (MARQUES)
- Minna Aalto-Setälä (International Chamber of Commerce)
- Lucy Cundliffe (CITMA)
- Mark Hiddleston (CITMA)

EUIPO would like to thank all the users and user associations for taking part in this valuable exercise which will be further consolidated. If you are interested in taking part, please contact your own user association for further details.

Protecting Innovation through Trade Secrets and Patents: Determinants for European Union Firms

EUIPO, through the European Observatory on Infringements of Intellectual Property Rights, has



launched a report on [Protecting Innovation through Trade Secrets and Patents: Determinants for European Union Firms](#).

The report uses data from the Community Innovation Survey for 24 EU Member States to examine the economic importance of trade secrets and their relation with patents.

The study finds that the use of trade secrets is higher than the use of patents for most types of companies (although it is particularly prevalent among SMEs), in most economic sectors and in all Member States.

Market novelty and innovation in tangible goods are associated with a preference for patents while process and service innovations are more often protected through secrecy.

However, in general, the study finds that there is complementarity between the use of trade secrets and patents—many companies use both methods to protect their innovations.

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Case law

Luxembourg trade mark and design news

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

Case C-617/15; Hummel Holding A/S v Nike Inc. and Nike Retail B.V.; Judgment of 18 May 2017 (Request for a preliminary ruling from the Oberlandesgericht Düsseldorf); Language of the case: DE

FACTS: Where a defendant in proceedings concerning an infringement of an EUTM is not domiciled in the EU but in a third country, such proceedings have to be brought before the EU trade mark courts of the Member State in which the defendant has an 'establishment' (Article 97(1) in fine EUTMR). This judgment concerns the definition of the concept of 'establishment' under this provision concerning the international jurisdictional competence of EU trade mark courts.

In the case in question pending before the referring court, the defendant was domiciled in the United States. It had a main subsidiary in the Netherlands and — legally distinct — second-tier subsidiaries, *inter alia*, in Germany. The question was whether the latter could qualify as an 'establishment' within the meaning of Article 97(1) in fine EUTMR, and if so, under what conditions.



SUBSTANCE: The Court of Justice (CJ) considered that the concept of 'establishment' used in Article 97(1) in fine EUTMR has to be construed broadly. This would be required to ensure the widest application to the general 'defendant's domicile-principle' — also embodied in that very provision. This would be so because it would be easier for a defendant to defend before the EU trade mark courts of a Member State in which it has an establishment and with which it is therefore more closely linked (paras 34-35). Such a broad interpretation would not undermine the objective of Article 97(1) EUTMR of strengthening the protection of EUTMs and in particular of their unitary character by providing for decisions of EU trade mark courts having effect and covering the entire EU (paras 28 and 36).

Consequently, an 'establishment' requires the existence of a certain, real, and stable (permanent) commercial presence (personnel, equipment), which has to be visible as much as the appearance of the link with the parent company (para. 37). However, it is, as such, immaterial whether or not the establishment has legal personality (para. 38), is a direct subsidiary of the parent company (para. 39), or has itself participated in the alleged acts of infringement (para. 40).

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Case C-689/15; W.F. Gözze Frottierweberei GmbH, Wolfgang Gözze v Verein Bremer Baumwollbörse; Preliminary ruling of 8 June 2017; Language of the case: DE

KEYWORDS: Deceptive element, Function of trade mark, Nature of use

FACTS: The applicant in the infringement proceedings before the EU trade mark court ('the applicant') was an association exercising various activities linked to cotton. It was the proprietor of the following individual figurative EUTM, registered in particular for textiles ('the cotton flower mark'):

EUTM



The cotton flower mark had been used by manufacturers of textiles made from cotton fibres to certify the composition and the quality of their goods. Since registration, the applicant has concluded licence agreements in respect of its cotton flower mark with undertakings affiliated to the association. Those undertakings agree to use the mark only for goods made from good-quality cotton fibres. Compliance with this commitment may be checked by the applicant.



The defendant in the infringement proceedings before the EU trade mark court ('the defendant') had not concluded a licence agreement with the applicant. It manufactures textiles made from cotton fibres. The infringement proceedings were directed against the defendant's sale of towels to which hangtags were attached with the following reverse side:



The defendant brought a counterclaim for cancellation of the cotton flower mark, claiming that it was purely descriptive and non-distinctive and had not been put to genuine use by the applicant or its licensees.

SUBSTANCE: First, the referring court asked whether Article 15(1) EUTMR was to be interpreted as meaning that the affixing of an individual EUTM, by the proprietor or with the proprietor's consent, on goods as a label of quality was a use as a trade mark that fell under the concept of 'genuine use' within the meaning of that provision, with the result that the proprietor of that mark was entitled to prevent, pursuant to Article 9(1)(b) EUTMR, the affixing by a third party of a similar sign on identical goods where there was a likelihood of confusion as

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referred to in the latter provision (para. 33). It was indispensable that a mark be used in accordance with its essential function, which is to indicate the origin of the marked goods or services. It may also be used to fulfil other functions, such as that of guaranteeing the quality of the goods or services.

However, where the use of an individual mark, despite certifying the composition or quality of the goods or services, does not guarantee to consumers that the goods or services come from a single undertaking under the control of which they are manufactured or supplied and which, consequently, is responsible for the quality of those goods or services, such use is not made in accordance with the function of indicating origin. It follows that there is no use in accordance with the essential function of the individual mark, where it is affixed on goods for the sole purpose of being a label of quality for those goods and not that of guaranteeing, in addition, that the goods come from a single undertaking under the control of which they are manufactured and which is responsible for their quality (paras 40-46).

It is for the referring court to verify whether evidence makes it possible to consider that the affixing of the cotton flower mark by the applicant's licensees to their goods guarantees to consumers that the goods come from a single undertaking, namely the applicant, comprising its affiliates, under the control of which the goods are manufactured and which is responsible for their quality. In any event, the fact



that the licence agreements enable the applicant to verify that the licensees use good-quality cotton fibres exclusively cannot constitute such evidence. It implies, at most, that the applicant certifies the quality of the raw material used. As is apparent from Articles 66 and 74a EUTMR, such a certification may suffice for the view to be taken that a mark other than an individual mark fulfils its function as an indication of origin. However, the dispute in the main proceedings concerned an individual mark registered for goods (paras 49-50).

Secondly, the referring court asked whether Article 52(1)(a) and Article 7(1)(g) EUTMR must be interpreted as meaning that an individual mark may be declared invalid where the proprietor of the mark fails to ensure that expectations relating to the quality that the public associates with the mark are being met, by carrying out periodic quality controls on its licensees (para. 52). It is for the referring court to examine whether the cotton flower sign filed by the applicant was capable per se of deceiving the consumer. The subsequent management by the applicant of its mark and licences for its use was irrelevant in this respect and, therefore, the mark could not be declared invalid because the proprietor of the mark failed to ensure, by carrying out periodic quality controls on its licensees, that expectations relating to the quality that the public associates with the mark were being met (paras 52-57).

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Thirdly, the referring court asked whether the EUTMR must be interpreted as meaning that its provisions on collective EUTMs may be applied mutatis mutandis to individual EUTMs (para. 58). The scope of Articles 66 to 74 EUTMR, relating to collective EUTMs, is expressly confined, according to the wording of Article 66(1) EUTMR, to marks described as such when applied for. The demarcation of the applicability of those articles must be strictly adhered to, especially as the rules they introduce, such as those set out in Article 67 EUTMR concerning regulations governing use of the mark, go hand in hand with the requirement, when making the application for registration, to expressly describe the mark applied for as a collective mark. Therefore, it was not possible to apply those rules by analogy to individual EUTMs (paras 58-60)

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

Case T-495/15; Sociedad agraria de transformación No 9982 Montecitrus v EUIPO; Judgment of 16 March 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Colour mark, Common element, Complex mark, Conceptual similarity, Descriptive element, Ending of mark, Figurative element, Figurative trade mark, Identity of the goods and



services, Phonetic similarity, Visual similarity, Weak element

FACTS: The applicant sought to register the figurative mark below for goods and services in Classes 29, 31 and 39. An opposition based on the earlier figurative mark protected as an EUTM represented below, registered for goods in Classes 29, 31 and 32, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) found no likelihood of confusion. The Board of Appeal (BoA) dismissed the appeal. The applicant sought partial annulment of the BoA decision (paras 16-17) in so far as the BoA ruled out likelihood of confusion for the goods in Classes 29 and 31. The General Court (GC) dismissed the appeal.



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SUBSTANCE: The GC confirmed that the level of attention of the public to be taken into account was that of the average consumer, which was neither high nor low, since the goods in question targeted the general public, even if it might be the case that the parties did not sell directly to the public. With respect to the comparison of the marks, the GC confirmed the finding of a low degree of visual similarity and a high degree of conceptual similarity, but disagreed with the phonetic comparison of the marks. It agreed that there was a low degree of visual similarity, since the different figurative elements and the colours of the earlier mark created different visual impressions (paras 38-40). According to the GC, the degree of phonetic similarity was average and not low, as the BoA had found, since the marks had the word 'citrus' in common and there was no clear phonetic difference between the syllables 'tain' and 'te' (paras 44-49). Despite the identity of the goods, the phonetic similarity and the high degree of conceptual similarity, the GC confirmed the finding of no likelihood of confusion, since the phonetic and conceptual aspects of the signs would not hold the public's attention: For food products that are selected by consumers directly, therefore, the analysis of visual similarity with the assessment of the figurative elements is of greater importance than the phonetic and conceptual similarities (paras 62-63). Moreover, where the idea conveyed is descriptive, the conceptual similarity does not have an impact on the global assessment.



Case T-9/15; Ball Beverage Packaging Europe Ltd v EUIPO; Judgment of 13 June 2017; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Deficiencies of RDC application, Definition of design, Freedom of designer, Individual character, Informed user, Overall impression

FACTS: The RCD holder was granted the registration of the design represented below as an RCD with the product indication '[beverage] cans'. The description of the RCD submitted by the RCD proprietor read: 'Group of cans for drink, all having a sleek but high appearance with reduced neck, preferably made of thin sheet metal, especially for filling volumes of 250 ml, 300 ml or 330 ml, respectively.'

An application for invalidity was filed pursuant to Article 25(1)(b) in conjunction with Article 6 CDR, based on three cans disclosed prior to the priority date of the contested RCD, one of which is depicted below. The Invalidity Division (ID) dismissed the application for invalidity.

The Board of Appeal (BoA) upheld the invalidity applicant's appeal. It found that the contested RCD consisted in the appearance of an individual can represented in three different sizes. Invoking Article 98(1) CDR, it refused to take into consideration the description of the contested design in English

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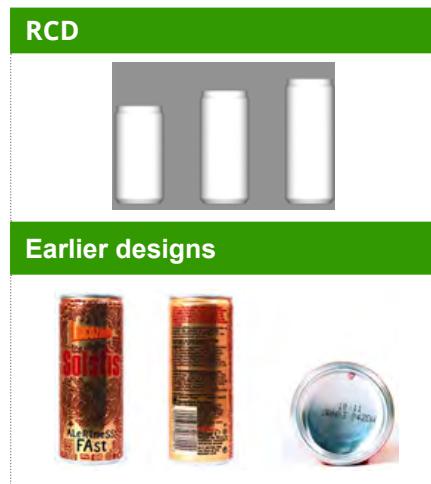
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that was included in the application for registration, on the grounds that the description had not been made in the language of application (German). In the context of the assessment of the individual character of the contested design, the BoA concluded that the differences between the contested design and the earlier designs were insignificant and had no impact on the overall impression of the informed user, who had been defined as persons who are responsible for bottling in the drinks industry.

The RCD proprietor filed an action before the General Court (GC), relying on two pleas in law: (i) infringement of the obligation to state reasons and (ii) infringement of the assessment of individual character. The GC dismissed the appeal.



SUBSTANCE: The RCD holder alleged that the BoA incorrectly assessed the scope of the protection conferred by the contested RCD, in so far as it refused to find that the latter represented a group of three cans of different sizes, that is to say, a unitary object. The GC held in this respect that the BoA was required, in the course of the substantive examination of the overall impression produced by the contested RCD, to determine its subject matter of protection as a preliminary question.

A possible position on the part of the Office on that question during the registration process could not bind the BoA in the light of the essentially formal and expeditious nature of the review carried out by the Office during that registration process. Moreover, the refusal by the BoA to define the subject matter of the protection afforded by the contested RCD as a group of cans did not lead to an unlawful questioning of its validity (paras 49-58). The definition of the contested RCD as a group of cans would amount to an element of differentiation between that design and the earlier designs that represented a single can. The subject matter of a design may only be a unitary object, since Article 3(a) CDR refers expressly to the appearance of 'a product'.

Moreover, the BoA correctly stated that a group of articles may constitute 'a product' within the meaning of the abovementioned provision if they are linked by aesthetic and functional complementarity and are usually marketed as a unitary product.

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Irrespective of the way beverage cans are marketed, it is clear that the three cans represented in the contested RCD do not perform a common function in the sense of a function that cannot be performed by each of them individually, as is the case, for example, of table cutlery or a chessboard and chess pieces (paras 59-63). As follows from Article 36(3) (a) and (6) CDR, confirmed by Article 1(2)(a) CDIR, a description that may be contained in the application for registration may not have an influence on the substantive assessments relating to the novelty or individual character of the design, and on the subject matter of protection. The RCD holder's claims relating to the BoA's refusal to take account of the description were therefore ineffective (paras 66-69).

The BoA defined the informed user, without committing an error, as the person who, in the drinks industry, was responsible for bottling the beverages and who obtained information about relevant offers by means of specialised journals and catalogues as well as by attending specialised exhibitions (para. 83). The GC also approved the BoA finding that the freedom of the designer was unlimited with regard to the configuration of the basic cylindrical shape, the neck of the can and the base of the can. The degree of freedom of the designer was limited only in so far as the basic cylindrical shape had been established as a standard and the round shape of the lid and base resulted necessarily from that basic shape. Limitations relating to the size of the cans resulted from the capacity, which normally did not



exceed 500 ml and corresponded to normal quantities used in business for the sale of drinks (para. 84). The GC also confirmed the BoA's comparison of the overall impression produced by the conflicting design, in particular that the differences between the proportions of the cans were not visible and that the height/width ratio appeared to be approximately identical. Even if the informed user noticed differences between the proportions, they were not relevant to the overall impression. The representation in three sizes of the contested RCD did not show the existence of a relevant difference in so far as the informed user knew the normal capacity of beverage cans and did not attach importance to the differences in size thereof in the overall impression. The BoA correctly concluded that the contested RCD was devoid of individual character (paras 86-91).

Case T-580/15, Flamagas SA v EUIPO — MatMind Srl; Judgment of 27 June 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Three-dimensional mark, Shape of the product, Distinctive element

FACTS: The applicant's contested EUTM had been applied for, and registered, as a three-dimensional mark without any further description and without

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any disclaimer. It depicts the shape of a lighter from five different perspectives. On one of these five representations, one can detect a small word element that reads 'CLIPPER', is represented in dark grey letters on a light grey background, and occupies less than one tenth of the total surface of the lighter's front.

The Cancellation Division (CD) rejected the other party's invalidity request (Article 52(1)(a) EUTMR). On appeal, the Board of Appeal (BoA) annulled the decision of the CD and declared the contested mark invalid on the basis of the absolute grounds of invalidity laid down in Article 7(1)(e)(ii) and Article 7(1)(a) and (b) EUTMR.

The BoA found, in essence, that (i) the contested shape fulfilled a technical function and was non-distinctive, and (ii) the word element played a marginal role in the contested mark as a whole. The General Court (GC) dismissed the applicant's appeal.

EUTM



SUBSTANCE: With regard to Article 7(1)(e)(ii) EUTMR, the GC confirmed the BoA's finding — which was itself based upon the existence of a Spanish utility model — that the contested shape fulfilled a technical function (paras 47-53). The GC stressed that the presumed perception by the relevant consumer, although not decisive for such a finding, could be taken into account for this assessment (paras 54-57). It also observed that the existence of alternative forms (paras 58-59) and the mark's alleged reputation (para. 60) were immaterial in this respect.

As regards the word element, the GC confirmed the BoA's finding that it constituted a non-essential characteristic of the contested mark (para. 40). The contested mark's essential characteristics would be limited to the elements constituting the shape itself (para. 37 in fine) for two reasons. In the first place, because the contested mark had been filed as a 3D mark without any further clarification with respect to the — very small — word element (para. 34). Such a choice could not be disregarded by the Office (para. 35) — both for the reasons of legal certainty required by Article 4 EUTMR and for safeguarding the public interest underlying Article 7(1)(e)(ii) EUTMR (para. 36). Second, and in addition, the word element's minor and secondary importance would also stem from its small size and lack of visibility (para. 38).

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With regard to Article 7(1)(b) EUTMR, the GC confirmed that the contested shape did not differ significantly from the norms or the customs of the sector (paras 74, 76-77) and that, for the same two reasons given in the context of Article 7(1)(e)(ii) EUTMR, the word element was marginal (paras 79-81).

Case T-13/15; Deutsche Post AG v EUIPO; Judgment of 27 June 2017; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Conceptual dissimilarity, Likelihood of confusion, Weak trade mark

FACTS: The applicant sought to register the word mark PostModern as an EUTM for, *inter alia*, various transport and postal services in Class 39. An opposition based on the earlier German word mark POST and the earlier EUTM Deutsche Post, registered, *inter alia*, for various transport and postal services in Class 39, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division upheld the opposition in relation to these services. The Board of Appeal (BoA) upheld the applicant's appeal. It found that the conflicting signs were similar to a low degree only, if any, despite the visual and aural concurrences. Taking into account the differences in the conflicting signs' meanings, their



composition and the earlier mark's low degree of distinctiveness, it excluded a likelihood of confusion. The GC dismissed the appeal.

EUTM application

PostModern

Earlier trade marks

1. **POST**
2. **Deutsche Post**

SUBSTANCE: The conflicting services targeted the general public and professionals; as regards the earlier trademark POST, the consumers were situated in Germany (para. 27). The conflicting services were identical or highly similar (para. 29). The meaning of the EUTM application cannot be exclusively reduced to 'modern post' or 'post', ignoring the evident connection with the postmodernism movement. 'PostModern' is a play on words, which may be understood as referring to modern postal services; in the exact composition, however, it alludes to the said movement. This play on words is not excluded by the fact that the services in question have no connection with postmodernism. The relevant public is in fact accustomed to trade marks with a general meaning that do not describe the goods

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or services (paras 40-42). The upper case 'M' of 'PostModern' was irrelevant since it was registered as a word mark; furthermore, it did not affect the said play on words (para. 43). The EUTM application contained the earlier mark 'POST', but not all word combinations encompassing the Latin prefix 'post' can be considered to be related to the earlier mark (para. 44). Even if the earlier mark 'POST' were held to enjoy some degree of enhanced distinctiveness, for part of the EUTM application, the term 'post' could not play a dominant role (para. 48). It did not have an independent distinctive role within the EUTM application either, which constituted a logical unit on account of its play on words (paras 49-52).

On a visual and aural level, the conflicting signs were similar only to a low degree (paras 57-58). In the overall assessment, these similarities were counterbalanced by the conceptual difference despite the identity or high similarity of the conflicting services. Moreover, it was noted that the EUTM application had a normal degree of distinctiveness. Therefore, there was no likelihood of confusion with the earlier mark POST (paras 66-68). As regards the earlier EUTM Deutsche Post, the GC also confirmed the finding of the BoA: the majority of consumers in the EU would perceive it as a German expression designating the former monopolist for postal services in Germany. The EUTM application would also be understood as a reference to postmodernism outside Germany. For these consumers, the conflicting signs had a different



meaning. For other consumers understanding only the EUTM application and not the meaning of 'post' (e.g. Spanish consumers), conceptually the signs were not more similar, since the earlier EUTM was meaningless for them. Given the differences in meaning, the significant dissimilarities in their composition and the low degree of distinctiveness of the earlier mark, there was no likelihood of confusion (paras 76-78).

Case T-457/15; Fakro sp. z o.o. v EUIPO; Judgment of 15 June 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Conceptual similarity, Descriptive element, Likelihood of confusion, Phonetic similarity, Visual similarity

FACTS: The applicant sought to register the figurative mark represented below as an EUTM for goods and services, inter alia, in Classes 6, 19, 20, 24 and 37 (EUTM application). An opposition based on the earlier word mark, CLIMAVER DECO, registered for goods in Classes 11, 17 and 19, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division partly upheld the opposition with regard to shutters, jalousies, blinds, and curtains of various types in Classes 6, 19, 20, 24 and for assembly of related goods in Class 37. The Board of Appeal (BoA) dismissed the applicant's appeal. It considered

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that the goods and services were directed at both professionals and the general public and that a high level of attention was appropriate. The BoA found the goods and services to be identical or similar and the marks to be similar due to the elements 'climavera' and 'climaver' respectively. The applicant filed an action before the General Court (GC), relying on a single plea in law, alleging an infringement of Article 8(1)(b) EUTMR. It argued that: (i) the relevant consumer was a specialist, (ii) the BoA incorrectly interpreted Communication No 2/1 and that a literal approach should have been used when comparing the goods and services (iii) the BoA did not take sufficient account of the differences between the goods (in particular the contested goods had an anti-burglary or security function) and (iv) the BoA failed to take account of several factors distinguishing the two marks. The GC dismissed the appeal.

EUTM application



Earlier trade mark

CLIMAVER DECO

SUBSTANCE: Relevant consumer and level of attention — The GC found that the BoA was correct to hold that the goods in question targeted



professionals and the general public, namely DIY amateurs. First, the general public might only involve professionals for the installation of the goods after it may have examined a range of goods and services pertaining to shutters, jalousies or blinds. Furthermore, the installation of some of the goods (e.g. non-metallic blinds and indoor curtains) was not solely carried out by professionals. Additionally, purchasers may be DIY amateurs, so the goods concerned may be purchased and installed not only by professionals but also by skilled end users. The level of attention to be applied is high (paras 21-24). Goods and services — Regarding the goods covered by the earlier trade mark, the GC noted that Communication No 2/12, which had been relied upon by the BoA, was found to be compatible with the principles laid down by the Court. It then confirmed the BoA's finding that, as the earlier EUTM was registered before 21 June 2012 by using the entire class heading of Classes 11 and 19, the opponent was deemed to have intended to cover all the goods included in the alphabetical list of the Nice Classification for those classes (including shutters, not of metal and jalousies, not of metal in Class 19) (paras 25-32). On the comparison of goods and services, the GC dismissed the applicant's arguments that the BoA had not taken due account of the security function of the contested goods. Indeed, the applicant acknowledged that the goods in question could be used for a variety of reasons, not just security. The overlap of the nature and purpose of the goods in

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Classes 6, 20 and 24 of the EUTM application and shutters, not of metal and jalousies, not of metal covered by the earlier trade mark was sufficient to make them similar (paras 33-44). The marks — The GC found that the shared element 'climaver' was an indication of visual similarity, especially as it was at the beginning of the EUTM application. It conceded that 'clima' was weakly distinctive because it directly alluded to — and was not, as was held by the BoA, laudatory of — the goods and services concerned, but this was offset by other factors (paras 59-60). The GC considered that the points of dissimilarity did not dispel the impression of similarity. The impact of the figurative elements of the EUTM application (resembling a blind or a curtain) was limited because it was purely decorative. Likewise, the element 'deco' in the earlier mark was rather descriptive. Consequently, the marks were visually similar (paras 61-65). Phonetically, there was a high degree of phonetic similarity between the marks at issue, as 'climaver' would be pronounced the same way in both marks. The different sound, 'a', in the EUTM application was at the end and the element 'deco' in the earlier mark was secondary (paras 70-72). The GC upheld the BoA's finding that 'deco' in the earlier trade mark provided a point of conceptual distinction between the marks, since it associated that trade mark with the theme of 'decoration'. It was, however, descriptive. For consumers who perceived the terms 'clima' and/or 'ver(a)' as separate elements in the marks, they would be conceptually similar as they could be associated with climate and



'vero' respectively. Others would see 'climavera' and 'climaver' as invented words and as having no concept (para. 77). Likelihood of confusion — even though the terms 'clima' and 'deco', taken individually, had a weak distinctive character, the GC held that the BoA was entitled to conclude that the earlier trade mark as a whole had no meaning in relation to all the goods and services in question, and therefore had a normal distinctive character. This was because a part of the relevant public would perceive the term 'climaver' of the earlier trade mark as an invented word and would not split it into those components (paras 85-86). Considering that the goods covered by the marks at issue were identical or similar, and that the two marks were visually and phonetically similar and were either conceptually similar or conceptually neutral, the BoA was entitled to conclude that there was a likelihood of confusion, even in the event of the consumer displaying a high level of attention.

Case T-326/16; Bundesverband Deutsche Tafel eV v EUIPO; Judgment of 8 June 2017; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Competence of the Boards, Descriptive element, Scope of proceedings

FACTS: The EUTM word mark TAFEL was registered



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for gathering, collection, transportation and distribution of essential goods, including foodstuffs, for others, in particular for those in need services in Class 39 and personal and social services rendered by others to meet individual needs in Class 45. An application for invalidity was filed pursuant to Article 52(1)(a) in conjunction with Article 7(1)(b) and (c) EUTMR. The Cancellation Division dismissed the application for invalidity. The Board of Appeal (BoA) upheld the invalidity applicant's appeal. It found that the German word 'TAFEL' with its meaning of a festively decorated table ('first meaning') described the services in question under Article 7(1)(c) EUTMR, since they may be offered at such a table. This was confirmed by lexical entries, according to which this term refers to the provision of those in need with free or inexpensive foodstuffs not sold in the trade but still in good condition or meals prepared therefrom ('second meaning'). The General Court (GC) annulled the BoA decision in case T-710/13, holding that Article 7(1)(c) EUTMR did not apply based on the first meaning of 'TAFEL'. According to the GC, the second meaning was merely adduced by the BoA to confirm its findings and thus did not support Article 7(1)(c) EUTMR on its own account. The BoA upheld the invalidity applicant's appeal in its new decision under Article 7(1)(c) EUTMR, based on the second meaning of 'TAFEL'. The EUTM proprietor filed an action before the GC pleading that the BoA had infringed Article 7(1)(c) and Article 65(6) EUTMR. The GC dismissed the appeal.



EUTM

TAFEL

SUBSTANCE: Following the annulment, the BoA was obliged to render a new decision in accordance not only with the operative part of the judgment but also with the grounds constituting its essential basis (paras 19-22). The judgment did not rule on the applicability of Article 7(1)(c) EUTMR regarding the second meaning and the BoA was thus entitled to base its decision on it without infringing Article 65(6) EUTMR (paras 23-26). The second meaning, which 'TAFEL' already had at the time of the EUTM application, was confirmed by the GC in case T-710/13 and was therefore considered to be final for the purpose of the present proceedings (para. 40). The EUTM was descriptive under Article 7(1)(c) EUTMR in its second meaning for the services in question (para. 41).

Case T-258/16; Mediterranean Premium Spirits, SL v EUIPO; Judgment of 7 June 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Conceptual similarity, Common

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element, Descriptive element, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Right to be heard, Similarity of the signs, Visual similarity, Weak element

FACTS: The applicant sought to register the word mark GINRAW for goods in Classes 21 and 33. An opposition based on the word mark RAW, protected by two European Union registrations was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition. The Board of Appeal (BoA) dismissed the applicant's appeal. The applicant claimed infringement of Article 8(1)(b) EUTMR and an infringement of the obligation to state reasons before the General Court (GC). The GC dismissed the action.

EUTM application

GINRAW

Earlier trade mark

RAW

SUBSTANCE: The GC found that the BoA rightfully found the likelihood of confusion and fully satisfied the requirements of case-law. As to the goods in Class 21, the GC rejected the opponent's claim that household and kitchen utensils and containers are



dissimilar to cocktail shakers, sticks and straws in the application, stating that there was no evidence to suggest that. To the contrary, they were identical as the former included the latter (paras 24-26). The applicant did not dispute that the goods in Class 33 were identical. The GC rejected the applicant's claims on the descriptiveness of the earlier marks, finding that the link between the word 'RAW' and the goods in Classes 33 and 21 was too indirect to establish descriptiveness. The BoA rightly found that the dominant element of the mark applied for was 'RAW', since 'GIN' was descriptive of the goods, and did not err in breaking the mark applied for down to the elements 'gin' and 'raw' (paras 63-65). The GC also found no errors in the assessment of the visual, phonetic and conceptual similarity of the signs: the fact that the mark applied for consists of the earlier mark to which another word had been added indicates an average degree of visual and phonetic similarity (paras 54-57). The GC also found that the decision of the BoA could not be criticised for lack of reasoning as regards the normal distinctiveness of the earlier marks or the descriptiveness of the word 'GIN', in as much as the BoA cannot be required to reply specifically to each of the arguments put forward or to reject specifically each of the items of evidence: since the OD's decision was confirmed in its entirety, that decision and its reasoning are part of the context in which the decision of the BoA was adopted. A more detailed statement of reasons on the point was given in the decision of the OD, which the BoA confirmed in its entirety. Moreover, the applicant expressly conceded the descriptiveness of the word 'GIN' before the BoA (paras 88-94).

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Case T-104/16; Puma SE v EUIPO; Judgment of 9 March 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Slogan mark, Laudatory mark

FACTS: The IR holder designated the European Union for the international registration of the word mark FOREVER FASTER for, inter alia, footwear in Class 25 and games and playthings; gymnastics and sporting apparatus; gymnastics and sporting articles (included in this class); balls for games, golf balls; tennis rackets, cricket bats, golf clubs, hockey sticks, table tennis bats, badminton and squash rackets, table tennis and cricket bats, golf clubs and hockey sticks; roller skates, ice skates and in-line skates. The examiner refused the registration of the international trade mark pursuant to Article 7(1) (b), (c) and (2) EUTMR. The BoA dismissed the appeal confirming the refusal under Article 7(1)(b) EUTMR, as the mark would be perceived as a simple laudatory formula or information on the desired qualities of the goods. The BoA did not rule on Article 7(1)(c) EUTMR. The IR holder filed an action before the GC pleading that the BoA had infringed Article 7(1)(b) EUTMR and the principles of equal treatment and sound administration .The General Court (GC) dismissed the appeal.



IR designating the EU

FOREVER FASTER

SUBSTANCE: The GC found no error of assessment under Article 7(1)(b) EUTMR. The BoA carried out the assessment on the basis of dictionary definitions and the meanings are among those normally attributed to those words (para. 28). The IR holder could not rely on the EUTM registration of the word mark FOREVER, which had expired and which had been refused by a BoA decision for lack of distinctiveness (para. 29). The BoA did not err in taking the view that the word 'faster' referred to an increase in speed, which described a desired characteristic of the goods (para. 30). A sign must be refused registration if at least one of its possible meanings lacks distinctiveness (para. 31).The mark applied for as a whole described a quality or characteristics of the goods. It sent out a clear message that was not unusual in the sporting sector, was a simple laudatory declaration or information on the desired characteristics of the goods, was frequently used in advertisements to motivate athletes and sportsmen and was per se not distinctive (paras 35-36). The intrinsic distinctiveness of a mark cannot be assessed on the basis of an advertising campaign conducted after the filing date, which in any event supported the use of the mark applied for as a trade mark. Registrations in other English-speaking countries are not binding (paras 47-49).

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Case T-685/16; Carlos Jiménez Gasalla v EUIPO; Judgment of 27 June 2017; Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Descriptive element, Distinctiveness acquired by use

FACTS: The word sign B2B SOLUTIONS was applied for as an EUTM for goods and services in Classes 9, 35 and 42. An objection was raised ex Article 7(1)(b) and (c) EUTMR with regard to the English-speaking public in the EU. The applicant invoked Article 7(3) EUTMR. The examiner refused the mark. The Board of Appeal dismissed the appeal.

EUTM application

B2B SOLUTIONS

SUBSTANCE: The General Court (GC) recalled the content of Article 7(2) EUTMR and rejected the applicant's argument that the perception of the English-speaking public should not be given too much importance as it was only a part of the EU public. The GC confirmed that 'B2B SOLUTIONS' would be understood as 'business to business solutions' and immediately referred to goods and services that provided solutions to the business



needs of a company and which were provided by a business company. For the GC, the expression 'B2B SOLUTIONS' was neither equivocal nor suggestive. Finally, the documents submitted for the first time before the GC regarding Article 7(3) EUTMR were declared inadmissible. The application was dismissed.

Case T-294/16; Kaane American International Tobacco Company FZE v EUIPO; Judgment of 8 June 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Proof of use, Use not as registered

FACTS: On 21 August 2009, the EUTM proprietor registered the figurative mark EUTM No 7 157 233 in Class 34, as represented below.

On 22 October 2014, a request for revocation was filed on the grounds that the mark was not put to genuine use pursuant to Article 51(1)(a) EUTMR. The EUTM proprietor presented evidence that the EUTM had been used, and argued that, in any event, there were proper reasons for non-use because tests were being carried out on the products in question (cigarettes). On 28 July 2015, the Cancellation Division upheld the request for revocation.

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The Board of Appeal (BoA) dismissed the EUTM proprietor's appeal. It found that the evidence adduced did not make it possible to establish that the mark at issue had been put to genuine use in the EU during the relevant period. It also found that there were no proper reasons for non-use of the mark.

The EUTM proprietor filed an action before the General Court (GC), relying on a single plea in law, alleging infringement of Article 51(1)(a) EUTMR. First, it challenged the BoA's finding that proof of genuine use of the mark at issue had not been furnished. Second, it disputed the conclusion that there were no proper reasons for non-use of that mark.

EUTM



SUBSTANCE: Evidence of use — The EUTM proprietor's challenge focused on the evidence of the EUTM proprietor's participation in international trade fairs. The BoA had found, inter alia, that the photographs adduced by the EUTM proprietor to prove use did not show use of the mark as



registered because the graphic element showing a mountain, which was a co-dominant element of the EUTM as registered, did not appear in the evidence.

The EUTM proprietor argued that the evidence demonstrated that the trade fairs took place during the relevant period for proving use and that BoA did not take into account that they have participants from all over the world, are held only once each year and require significant investment in terms of both time and money. Thus, attendance at one trade fair per year should have been considered enough to show that it was making serious attempts to acquire a relevant position in the EU tobacco market and that it had made important investments in order to promote its products in that market.

The GC pointed out that the EUTM proprietor had not challenged the BoA's finding that use was not demonstrated of the mark as registered. Consequently, the reason that the BoA discounted the evidence on trade fairs was not disputed by the EUTM proprietor (para. 28).

Furthermore, the EUTM proprietor did not dispute one of the reasons given by the BoA for the sake of completeness, namely that there was no evidence that its participation in international trade fairs targeted the public in the EU (para. 30).

It follows that the EUTM proprietor's arguments cannot call into question the BoA's conclusion that

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evidence of genuine use of the mark at issue had not been submitted (para. 31).

Proper reasons for non-use — The EUTM proprietor submitted several test results demonstrating that the EUTM proprietor's cigarettes exceeded the maximum required levels of carbon monoxide emissions regulated by Directive 2014/40/EU concerning the manufacture, presentation and sale of tobacco and related products.

The GC stressed that, according to the case-law, the concept of proper reasons for non-use refers to circumstances unconnected with the trade mark proprietor rather than to circumstances associated with its commercial difficulties and that problems associated with the manufacture of products form part of the commercial difficulties encountered by that proprietor (para. 43).

In the present case, the fact that a third party carried out tests on the cigarettes did not allow the conclusion to be drawn that the manufacture of those cigarettes was independent of the EUTM proprietor's will. It was a matter for the EUTM proprietor to decide when it was going to have the tests carried out and to ensure that its cigarettes were compliant with EU legislation. The BoA therefore acted correctly in finding that the manufacture of cigarettes that complied with EU legislation depended on the will of the EUTM proprietor (paras 45-46).



Case T-95/16; Savas Aydin v EUIPO; Judgment of 14 June 2017; Language of the case: FR

RESULT: Action dismissed

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

FACTS: The applicant sought to register mark ROYAL & CAPORAL as an EUTM for goods and services in Classes 3, 9, 14, 18, 20, 24 and 25.

An opposition based on the earlier EU word mark KAPORAL, registered for goods in Class 25, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) partly upheld the opposition for part of the contested goods. The applicant filed an appeal against part of the contested decision (only Class 25 goods).

The Board of Appeal (BoA) dismissed the applicant's appeal. The BoA found that the goods at issue in Class 25 were identical and that the marks were visually, aurally and conceptually similar to the extent that they both referred to a caporal. The BoA confirmed that there was a likelihood of confusion for the French-speaking public in the EU without it being necessary to take into account the opponent's claim of enhanced distinctiveness of its earlier mark; therefore, it was not necessary to give a ruling on

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the 'belated' evidence filed before the OD (i.e. filed after the time limit to substantiate the opposition) and filed again before the BoA.

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

EUTM application

ROYAL & CAPORAL

Earlier trade mark

KAPORAL

SUBSTANCE: The GC confirmed that the relevant public was composed of the general public, displaying an average level of attention as regards the Class 25 goods at issue (para. 28) and not particularly high, contrary to the applicant's claim. The goods at issue were identical (not disputed). Given that the terms 'CAPORAL' and 'KAPORAL' were visually quasi-identical and that the contested mark consisted, in addition to 'KAPORAL' of, 'ROYAL &' (para. 38), which were weakly distinctive, the marks were visually similar to an average degree (para. 42). The marks were phonetically similar to an average degree (paras 51-52). The marks were conceptually similar to an average degree, since they referred to



the same concept of a caporal (paras 55-57), even though the concept of 'royal' was not present in the earlier mark (para. 59). The term 'CAPORAL' had an independent distinctive role within the contested mark (paras 72-75). There was a likelihood of confusion (para. 76). The applicant's arguments as to the inadmissibility of the evidence relating to the claim of the earlier mark's enhanced distinctiveness were irrelevant as they tended to confirm the BoA's decision.

Case T-236/16; Biogena Naturprodukte GmbH & Co. KG v EUIPO; Judgment of 22 June 2017; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive element, Statement of grounds

FACTS: The applicant sought to register the figurative mark represented below as an EUTM for various foodstuffs and beverages in Classes 29, 30, 32 and for food and drink preparation services; takeaway services; provision of information relating to the preparation of food and drink in Class 43. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR. The Board of Appeal (BoA) dismissed the applicant's appeal. The BoA found that the EUTM application was descriptive of the goods

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and services concerned, within the meaning of Article 7(1)(c) EUTMR, since the German expression 'zum Wohl' would be immediately recognised by the relevant public (general public and a specialist public, being German-speaking or having at least a sufficient knowledge of German) as meaning that they would contribute to the well-being of the targeted consumers. The figurative elements of the EUTM application would not divert the consumer's attention from the clear laudatory advertising message conveyed by this expression. It also held that the EUTM application was devoid of distinctive character under Article 7(1)(b) EUTMR. The applicant filed an action before the General Court (GC), relying on three pleas in law: alleging infringement of Article 7(1)(b) and (c) EUTMR and an infringement of the obligation to state reasons under Article 75 EUTMR. The GC dismissed the appeal.

EUTM application



SUBSTANCE: Obligation to state reasons — In order to facilitate drafting and for want of any challenge concerning any of the goods or services in



question specifically, the BoA on several occasions referred to the goods and services generally, in particular to goods and services of the food industry. Nevertheless, when the analysis required it, it adapted its reasoning according to whether it was goods or services in question and specified its reasoning for those products, grouping some of them by food or drink type and mentioning separately those products that could not be grouped. Furthermore, the goods and services in question could, by the fact that they were all food goods of everyday consumption or services with a direct link to such goods, be considered to have a sufficiently direct and specific link between them, to the point that they comprised a category of sufficient homogeneity. Therefore, the BoA could not be criticised for having for the most part used global reasoning in its assessment (paras 24-30).

Descriptiveness — The case concerned a German expression that has a common meaning when written, 'zum Wohl', namely 'to wish well-being' for a person, particularly when toasting or following a sneeze. When the adverb 'wohl', meaning 'probably', was attached to the term 'zum', the relevant German-speaking public would notice the mistake made and substitute the word 'wohl', incorrectly written in this case, with that of 'Wohl'. This was particularly so since, as the EUTM application was for a figurative mark, the use of upper- and lower-case letters would be perceived more as being part of the stylisation of the word element of the mark rather than changing

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the meaning of this word element. The EUTM application would thus be understood as meaning 'for well-being' (paras 40-45). The black circular background and the circles constituting the outline corresponded to a basic geometric shape as well as to standard borders. Likewise, the difference in size between the two word elements and the different typefaces used for those two elements would cause the consumer's attention to be drawn to the word 'Wohl' and, thus, to the idea of well-being.

Lastly, the colours black and white are frequently used to attract consumers' attention and, in the present case, contributed to making the word element, 'zum wohl', written in white on a black background, stand out, thus highlighting this element. Accordingly, even taken together, the figurative elements of the mark applied for do not divert the relevant public from the message conveyed by the German expression 'zum Wohl' (para. 51). The food and drink goods contribute to good health and thus to the physical but also psychological well-being of their consumers. The same applied to the food-related services in Class 43, since they too can contribute to the good health and well-being of their beneficiaries by providing food and drink or information relating to the preparation of that food and drink. Therefore, the EUTM application would be easily recognisable by that public as a description of one of the characteristics of the goods and services in question (paras 56-57). There was no need to examine the plea alleging an infringement of Article 7(1)(b) EUTMR (para. 63).



Case T-286/16; Ernst Kneidinger v EUIPO; Judgment of 21 June 2017; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Freedom of designer, Individual character, Overall impression

FACTS: The RCD proprietor was granted the registration of the design represented below as an RCD with the product indication toilet seats (part of -), ornamentation (for a larger representation and additional views, consult RCD No 2274035-0001 on eSearch plus). An application for invalidity was filed pursuant to Article 25(1)(b) in conjunction with Articles 4 to 6 CDR for a lack of novelty and/or individual character. The Invalidity Division upheld the application for invalidity. The Board of Appeal (BoA) dismissed the RCD proprietor's appeal, holding that the RCD lacked individual character within the meaning of Article 6 CDR in comparison with the earlier design as represented below (for additional views, consult the judgment). The RCD proprietor filed an action before the General Court (GC) relying on a single plea in law, namely an infringement of Article 6(1)(b) CDR. The GC dismissed the appeal.

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RCD



Earlier design



SUBSTANCE: The designer's freedom is limited to the design of the lid, since the outer shape is determined by the dimensions of the toilet bowl and by the technical function of covering the toilet seat and bowl (para. 27). For the comparison of conflicting designs, only those parts subject to design protection are to be taken into account. The RCD as registered does not show an edge that protrudes above the remaining lid surface, contrary to the RCD holder's claim. It would have been required to submit a side or sectional view of the lid to represent such a protrusion. The views do not determine the edge's proportions or its design



either. Therefore, it cannot be excluded that the conflicting designs' overall impression is similar for the informed user in that they have similar elevated edges (paras 39-43).

Case T-235/16; GP Joule PV GmbH & Co. KG v EUIPO; Judgment of 21 June 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Substantiation of earlier right, Complementary evidence

FACTS: The applicant sought to register the figurative mark GPTech as an EUTM for goods and services in Classes 9 and 42. An opposition based on two earlier EU word marks, GP JOULE, registered for services in Classes 36, 37, 39, 40 and 42 and goods in Classes 6, 9 and 19, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) dismissed the opposition in so far as it was considered unfounded pursuant to Rules 19 and 20 EUTMIR. The applicant had pointed out that the opponent (GP Joule PV) and the proprietor of the earlier marks (Mr P) did not match. The opponent argued that it was the exclusive licensee of the proprietor of the earlier marks but did not produce any proof. The OD rejected the opposition as the opponent had not submitted any proof of an existing licence agreement or of any entitlement

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to file a notice of opposition. The Board of Appeal (BoA) dismissed the opponent's appeal. It found that the opponent satisfied the requirements of admissibility under Rule 15(2)(h)(iii) EUTMIR. However, it had not substantiated its entitlement to file a notice of opposition under Rule 19 EUTMIR. The BoA considered that it had no discretion under Rule 50(1) EUTMIR in conjunction with Article 76(2) EUTMR to accept evidence produced for the first time at appeal stage (i.e. a statement from Mr P declaring that he had granted the opponent the authority to use the earlier trade marks and defend them in its own name). In any event, and for the sake of completeness, the BoA indicated that, even assuming that it had such discretion, it would have exercised that discretion by not taking into account the additional evidence. The opponent filed an action before the General Court (GC) relying on two pleas in law: (i) misapplication of the rules governing opposition proceedings and (ii) misapplication of Rule 50(1) EUTMIR and Article 76(2) EUTMR. The GC dismissed the appeal.

EUTM application



Earlier trade mark

GP JOULE



SUBSTANCE: Admissibility and substantiation rules

— The GC dismissed the opponent's arguments as in part inadmissible and in part ineffective. The opponent had argued that the Office failed to inform it of the lack of evidence to substantiate the earlier rights allegedly pursuant to Rule 17 EUTMIR (at the admissibility stage). The GC confirmed BoA in differentiating between the admissibility criteria under Rule 17 EUTMIR (where it is enough to submit a statement concerning the entitlement to file an opposition) and the substantiation requirements, where proof of such entitlement is required. The GC confirmed that pursuant to Rules 19(1) and 20(6) EUTMIR, the Office is not obliged to ask the opponent to submit evidence at the admissibility stage (in other words, it is not a deficiency that the opponent should be invited to remedy) (para. 30). The GC considered that in view of the lack of evidence of the opponent's entitlement, the Office could have rejected the opposition after the expiry of the substantiation period without taking any further steps in the proceedings. However, the fact that OD took further steps did not vitiate the contested decision (para. 34).

Assessment of new evidence — The GC referred to settled case-law on the application of Rule 50(1) EUTMIR in conjunction with Article 76(2) EUTMR. Rule 50 EUTMIR does not extend the discretion of the BoA to new evidence but only to additional evidence. The opponent filed a statement for the first time before the BoA. The GC considered that

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in light of the facts of the case, it was not 'additional' evidence, so the BoA had rightly found that it could not take it into account (paras 46-48). The plea was dismissed as unfounded. Moreover, the GC further confirmed the BoA's conclusion that refused to take into account the statement, should it be considered 'additional' evidence: there was no justification for its late submission and the opponent did not put forward any grounds justifying the delay (paras 55-56).

Case T-23/16; Ilona Biernacka-Hoba v EUIPO — Formata Bogusław Hoba (Formata); Judgment of 8 March 2017; Language of the case: PL

RESULT: Action partially upheld (BoA decision partially annulled)

KEYWORDS: Evidence of use, Admissibility, Substantiation of the earlier right, Bad faith

FACTS: The case concerns an invalidity action between ex spouses who had previously run a family business together. The invalidity applicant (Ilona Biernacka-Hoba) filed a request for a declaration of invalidity against the EUTM FORMATA (fig.), registered by her former husband. She invoked an earlier international registration with effect in Slovakia for an identical mark. She also relied on an earlier Polish registration (expired) and invoked bad faith. The Board of Appeal (BoA) rejected the



invalidity action. In respect of relative grounds for invalidity, the BoA found that the invalidity applicant did not prove her entitlement to rely on the earlier mark, as the renewal certificate filed showed that the owner was 'Przedsiebiorstwo Produkcyjno Handlowo Usługowe Formatta II Ilona Biernacka-Hoba' (which the BoA considered to be a company), while the invalidity applicant was Ilona Biernacka-Hoba (a natural person). The invalidity applicant filed an action before the General Court (GC), claiming infringement of Article 52(1)(b) EUTMR. She argued, in particular that, according to the Polish Civil Code, a business activity run by a natural person (not having a corporate form) can use any indications (fanciful or describing the business) in addition to the name and surname of the person running the business. Therefore, it was clear from the indication of the name on the renewal certificate 'Przedsiebiorstwo Produkcyjno Handlowo Usługowe Formatta II Ilona Biernacka-Hoba' that the owner was not a company but Ilona Biernacka-Hoba running her business as a natural person.

SUBSTANCE: The GC did not expressly rule on the admissibility of new evidence in the form of specific provisions of the Polish Civil Code relating to the way a sole trader can name its business. While admitting that the data on the renewal certificate could cast doubts as to whether the invalidity applicant was in fact the owner of the earlier right, the indication on the renewal certificate contained the name of the invalidity applicant and did not make reference to

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any corporate legal form. This should, at the very least, have alerted the BoA that the entity does not have a corporate form (paras 22-23). Furthermore, it is known that sole traders run business under their names with the addition of other indications (para. 24). In any event, should the BoA have had any doubts as to the entitlement, it should have requested the invalidity applicant, pursuant to Rule 39(3) EUTMIR, to confirm that it was in fact the owner of the earlier right. Consequently, the contested decision was annulled in so far as it rejected the invalidity action on relative grounds for invalidity. As regards bad faith, the GC confirmed the BoA's decision. The fact that the EUTM proprietor did not make any submissions before the Office in reply to the invalidity request did not lead to a presumption of bad faith (para. 46). As regards the specific circumstances of the case, in particular the divorce of the parties and the division of property between them, the invalidity applicant failed to submit sufficient evidence to demonstrate bad faith on the part of the EUTM proprietor.

Case T-306/16; Gamet S.A. v EUIPO; Judgment of 5 July 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Freedom of designer, Immaterial details, Individual character, Informed user, Overall impression



FACTS: The applicant obtained the registration of the design represented below for handles, knobs and hinges ('RCD'). The invalidity declaration was filed based on Article 25(1)(b) CDR, arguing that the RCD was not new and lacked individual character pursuant to Articles 4 and 6 CDR. The earlier design invoked is represented below. The Invalidity Division (ID) rejected the invalidity application because it considered that the RCD satisfied the requirements of novelty and individual character. However, the Board of Appeal (BoA) upheld the intervener's appeal. The BOA accepted certain items submitted by the intervener for the first time before it and found that the RCD lacked individual character as a result of the earlier design, which was properly disclosed before the relevant date. The applicant filed an action before the GC relying on two pleas in law, that is to say, infringement of Article 63(1) and (2) CDR and infringement of Articles 4 and 6 CDR. The GC dismissed the appeal.

SUBSTANCE: The GC considered that the BoA correctly exercised its discretion by accepting certain items of evidence submitted by the intervener for the first time before it. The GC confirmed that the additional views of the earlier design merely supplemented the evidence submitted before the ID and were relevant for the outcome of the case (para. 21). Moreover, the GC considered that the BoA did not infringe Article 63(1) CDR because all the evidence that the BoA relied on in its decision originated from the intervener (para. 32). As regards

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RCD



Earlier design



the substance of the dispute, the GC endorsed the findings of the BoA, which were that considering a high degree of designer's freedom in respect of door handles (para. 46), the overall impression produced by the RCD was the same as that of the earlier design (para. 55). Contrary to what was argued by the applicant, the GC considered that the groove present in the RCD could not alter the overall impression produced by this design (para. 50).



Case T-659/16; LG Electronics, Inc. v EU IPO; Judgment of 14 June 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Descriptive element, Distinctive element

FACTS: The applicant filed an application for the registration as an EUTM of the word mark represented below for goods in Classes 9 and 14. The examiner rejected the application for registration on the grounds that the mark applied for fell under the grounds for refusal set out in Articles 7(1)(b) and (c) EUTMR. The BoA dismissed the applicant's appeal. The applicant filed an action before the General Court (GC), relying on three pleas in law, that is to say, infringement of Article 7(1)(b) and (c) and Article 75(3) EUTMR. The GC dismissed the appeal.

EUTM application

Second Display

SUBSTANCE: The GC endorsed the BoA's findings that the level of attention of the relevant public ranged from normal to high (para. 25). It was also confirmed that the relevant public would immediately perceive the combination of the

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words 'Second Display' as designating an extra screen or, possibly, a device indicating the seconds as they pass (para. 27). Therefore, the mark was found to be descriptive of the characteristics of products that have an extra screen or, possibly, a screen measuring function (para. 28) and also of the ancillary goods (para. 29). Moreover, the GC confirmed that since the mark was descriptive of the characteristics of the goods applied for, it was, on that account, necessarily devoid of any distinctive character in relation to the same goods and thus also had to be refused under Article 7(1)(b) EUTMR (para. 38). Finally, the GC rejected the applicant's arguments that the BoA had failed to state sufficient reasons to back up its decision (para. 46).

Case T-406/16; Dogg Label v EUIPO; Judgment of 11 July 2017; Language of the case: FR

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Visual similarity, Phonetic similarity, Conceptual similarity

FACTS: The Opposition Division (OD) dismissed the opposition under Article 8(1)(b) EUTMR on account of lack of similarity of the signs, without assessing the EUTM applicant's request for proof of use. The Board of Appeal (BoA) confirmed that there was no likelihood of confusion, even for identical goods (assuming the earlier French registration had been



used for all the goods in respect of which it was registered), because the signs were only remotely similar visually/aurally and because the French public could not grasp the prefix 'JAP' as denoting 'Japan' or 'Japanese' (para. 32 of the decision). According to the BoA, the signs were conceptually different and globally dissimilar.

EUTM application

JAPRAG

Earlier trade mark

JAPAN - RAG

SUBSTANCE: The General Court (GC) observed that the goods in Class 25 were identical, as well as leather, imitations of leather and animal skins and hides in Class 18 (para. 37). In turn, leather, imitations of leather and animal skins and hides were dissimilar to the products made of leather and imitations of leather [not included in other classes], luggage and carrying bags; umbrellas and parasols; walking sticks; whips, harness and saddlery covered by the EUTM application, notwithstanding that they belonged to the same Class 18. The fact that the former can be used as raw material for the production of the latter does not render them complementary. The raw materials subject to a

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transformation process are essentially different from the finished products, which incorporate, or are covered by, those raw materials, both by their nature and by their aim and intended purpose (para. 42). The GC disagreed with the BoA that the signs were visually and aurally similar to a very low degree only: the degree of visual and aural similarity was in fact medium (paras 55 and 64). The GC also disagreed with BoA that the signs were conceptually dissimilar because there was proof on file that the term 'jap' was a commonly used abbreviation in France to denote Japan, inter alia, in social media and the restoration sector (paras 73-74). The BoA therefore erred in considering that there was no conceptual similarity at all (para. 75). Having regard to the fact that the signs are similar to some degree, the BoA should have examined the request for proof of use before carrying out a global examination of likelihood of confusion (para. 79). Since the examination of the request for proof of use remains to be done, the GC lacked competence to alter the decision (para. 82). This is so even if a French judgment established the partial revocation of the earlier mark as from 2007, in respect of the Class 18 goods. It was for the Office to draw the consequences of this French judgment (para. 88).



Case T-448/16; Mr. Kebab s.r.o. v EUIPO; Judgment of 29 June 2017; Language of the case: SK

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Similarity of the signs, Visual similarity, Phonetic similarity, Conceptual similarity, Descriptive element, Dominant element

FACTS: The applicant sought to register the figurative mark represented below as an EUTM for goods and services in Classes 29, 30, 32, 41 and 43 (EUTM application). An opposition based on the earlier Spanish figurative trade mark represented below, registered for, inter alia, services in Class 43, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) partly upheld the opposition with regard to pastries, petits fours [cakes], farinaceous foods, pancakes, tarts, cakes in Class 30 and preparation and home delivery of meals made to order and street food; restaurants and restaurant services; fast food, snack bars in Class 43. 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 applicant filed an action before the General Court (GC), relying on a single plea in law, that is to say, an infringement of Article 8(1)(b) EUTMR while it emphasised the descriptive character of the common word elements and the weak distinctive character of the earlier trade mark. The GC dismissed the appeal.

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EUTM application



Earlier trade mark



SUBSTANCE: The GC endorsed the BoA's findings that the signs in question were similar. It stated that the global assessment of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks, must be based on the overall impression given by the marks while taking into account their distinctive and dominant components (para. 20). The GC considered that in the case in question the dominant elements of both signs were 'Mr. Kebab' and 'Mister Kebap' and at the same time found that these elements were distinctive (para. 29). The GC confirmed the BoA findings that the figurative elements of the contested sign emphasised the meaning of its word elements and as such were descriptive. Furthermore, it



stated that the figurative elements in both signs were not very striking (para. 41). The signs were found to be visually similar and aurally similar to a very high degree. Moreover, the signs were found almost identical from the conceptual point of view for a part of the relevant public, whereas the signs could not have been compared from the conceptual perspective in relation to the part of the relevant public that would not understand their verbal elements (paras 42-46). Therefore, the GC concluded that there was a likelihood of confusion between the trade marks in question (paras 47-49). It furthermore emphasised that although the distinctive character of the earlier trade mark must be taken into account when assessing the likelihood of confusion, it was only one factor among others involved in that assessment. It also stated that the applicant's arguments regarding the distinctive character of the earlier trade mark would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that, where the earlier mark was only of weak distinctive character, a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. Such a result would not, however, be consistent with the very nature of the global appreciation that the competent authorities are required to undertake by virtue of Article 8(1)(b) EUTMR (paras 51-52).

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Case T-82/16; International Gaming Projects Ltd v EUIPO; Judgment of 9 February 2017; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Similarity of the signs, Colour mark, Conceptual identity, Figurative element, Likelihood of confusion, Phonetic similarity, Visual similarity

FACTS: The applicant sought to register the figurative mark represented below as an EUTM for goods and services in Classes 28 and 41. An opposition based on the earlier EU word mark Evolution, registered for goods and services in Classes 28 and 41, was filed pursuant to Article (8)(1)(b) EUTMR. The Opposition Division (OD) upheld the opposition and rejected the application. The applicant filed a notice of appeal pursuant to Articles 58 to 60 EUTMR. The Board of Appeal (BoA) dismissed the appeal. It found that there was a likelihood of confusion between the signs. The applicant filed an action before the General Court (GC), relying on a single plea in law, alleging an infringement of Article 8(1)(b) EUTMR. The GC dismissed the action.

SUBSTANCE: The relevant public was composed of the general public with an average level of attention and a professional public with a higher level of attention (para. 27). The goods and services at issue were identical (para. 29). With regard to the conceptual comparison, the two signs coincided in



EUTM application



Earlier trade mark

Evolution

the word element 'Evolution', the only element of the earlier trade mark, which was entirely reproduced in the mark applied for (para. 43). Furthermore, as to the contested mark, the word elements 'triple' and 'evolution' appear in capital letters, in a font that is slightly stylised and close to printed characters, the edges of which are rounded and outlined in black in order to produce a slight effect of depth. Considering the arrangement of each of those elements, which cross each other in a perspective effect, there is not a dominant element. The figurative elements of the contested mark, namely their position, colour, outline and the stars on the mark, would be perceived as a simple decoration (paras 36-41). Consequently, the GC found that the marks were visually similar, as correctly stated by the BoA. Phonetically, the signs were similar overall because of their common word element 'evolution',

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and its pronunciation would not be altered by the presence of the word element 'triple' (paras 46-47). Conceptually, the common word element 'evolution' would be perceived by the relevant public as referring to the process of unrolling, opening out or revealing, or a movement of change or position (para. 48). The meaning of this word would not be changed for the relevant public by the presence of the word element 'triple', which simply evoked a multiplication by three of the element 'evolution' (para. 54). Therefore, the signs were conceptually identical. As to the global assessment, the goods and services were identical and the marks at issue, taken as a whole, and despite the additional elements in the mark applied for, showed a certain degree of visual, phonetic and conceptual similarity (para. 58). As a result, there was a likelihood of confusion.



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Trade marks

[16/01/2017, R 912/2016-5, PANOTEC / PlanoTek et al](#)

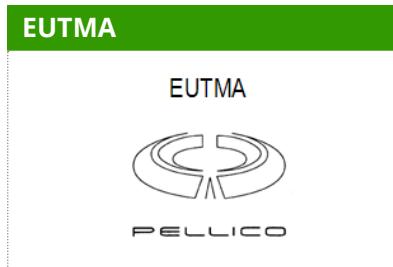
Result: Remitted to the Grand Board.

Substance: The Board considers that the case is legally important in the sense of Article 135(3) EUTMR. The case is remitted to the Grand Board in order to decide on the three issues: i) when the Board of Appeal has to adjudicate on an appeal at the latest, when, after the notification of the same, the applicant (appellant) lodged a revocation action against the earlier trademarks ; ii) if the earlier rights, upon which an opposition is based, have to be valid until the end of the proceedings (including the appeal stage); iii) if the Boards should suspend the appeal proceedings, pending the outcome of the cancellation proceedings and to assess whether the criteria for accepting belated evidence apply by analogy and, where relevant, to the discretion of whether to suspend the proceedings, provided



that there are some circumstances which may point to negligence or delaying tactics on the part of the applicant's representative.

[31/01/2017, R2595/2015-1, Pellico \(fig.\)](#)



Result: Remitted to the Grand Board.

Substance: The Board considers that the case is legally important in the sense of Article 135(3) EUTMR. The case is remitted to the Grand Board in order to decide on the criteria that have to be followed to create subcategories of products of the same class in the context of revocation proceedings. In the present case, the issues are whether i) gender-specific goods in the area of footwear may be considered as a subcategory, as for instance 'women's footwear' as a subcategory of 'footwear', or whether ii) it may be considered as another type of subcategory, or whether iii) no subcategory to 'footwear' should have been defined at all.

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25/05/2017, R368/2016-1 INMOBILIARIA PORTIXOL (fig.) fig.)/INMOBILIARIA Portixol

EUTM

INMOBILIARIA PORTIXOL

Earlier sign



Result: Remitted to the Grand Board.

Substance: Since 'Portixol' recalls the name of a touristic destination in Mallorca, the figurative EUTM 'INMOBILIARIA PORTIXOL' was challenged with a cancellation application on the grounds of, among others, Article 7(1)(b) and (c). The Board considers that the case is legally important in the sense of Article 135(3) EUTMR. The case is remitted to the Grand Board in order to determine the relative weight to be attributed to the size and the tourist importance of the place, and on the other hand to decide whether – despite the relative geographical importance of the place corresponding to the name for which trade mark registration is being sought – the place could in future become well known to a significant part of the relevant public as being descriptive of the origin or other characteristics of the goods or services in dispute.



01/06/2017, R1893/2011-G Cheapflights (fig.) / Cheapflights (fig.)

EUTMA

Cheapflights

Earlier trade mark

CheapFlights

Result: Proceeding terminated.

Keywords: Distinctive element, Minimum degree of distinctiveness.

Norms: Article 8(1)(b) EUTMR, Article 7(1)(c) and (b) EUTMR.

Substance: The holder of the earlier trademark Cheapflights filed an opposition against the application 'Cheapflights', for travel-related products and services in Classes 9, 16, 38, 39, 41, 42, 43 and 44 invoking, among others, Articles 8(1)(a) and 8(1)(b) EUTMR. The decision of the Opposition Division was annulled by the Boards, resulting in the rejection of the opposition in its entirety. The decision considered the word 'cheapflights' and the representation of an aeroplane to be descriptive

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for the services at issue, and it found that there was no likelihood of confusion even for the identical services, since the signs, even coinciding in descriptive elements, differed in their graphic elements, apparently more distinctive (namely the colours and the details of the aeroplane device). Subsequently, the opponent initiated an action before the General Court, which confirmed the descriptiveness both of the word 'cheapflights' and of the representation of an aeroplane for services related to travel arrangement, but remitted the case to the Boards, in order to ascertain the descriptive character of the trade mark with specific regard to each of the services at issue.

Following this judgement, the Grand Board remitted the case to the first instance for further decision with respect to absolute grounds for refusal ([04/07/2012, R 1893/2011-G – Cheapflights \(FIG. MARK\) / CheapFlights \(FIG. MARK\)](#)).

The application was examined under absolute grounds pursuant to Article 7(1)(c) and (b) EUTMR and Article 7(2) EUTMR and finally it was rejected on the grounds that the English-speaking consumers would perceive the sign as descriptive and non-distinctive for the goods and services in Classes 9 (Computer etc.), 16 (Printed matter etc.) and 39 (Travel services etc.).

After a second objection, the trade mark application has been rejected ([30/11/2016, 003485349](#),



[Cheapflights \(fig.\)](#) on the same grounds, for services in Classes 38 (Providing and/or operating search engines etc.), 39 (Car hire services etc.), 41 (Holiday entertainment etc.), 42 (Custom design of question-answering functionally of World Wide Web sites), 43 (Hotel and accommodation services etc.) and 44 (Medical advisory services for travellers). On the other hand, the contested application shall proceed for other goods and services in Class 9 (Computer hardware, manuals in electronic form, etc.), Class 16 (User and instruction manuals), Class 35 (Compiling, storing, analysing and retrieving data and information, etc.) and Class 42 (Computer services; computer programming, etc.). Consequently, the opposition proceedings are closed.

[31/05/2017, R 1807/2016-1, POLINOX \(fig.\) / PORTINOX \(fig.\)](#)



Result: Decision confirmed.

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Keywords: Likelihood of Confusion (no), Dissimilarity of the Goods and Services (yes), Nature of the Goods and Services, Purpose of the Goods and Services.

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

Facts: The holder of the trademark Portinox filed an opposition against the trademark Polinox, for the goods and services in Classes 6 and 37, pursuant to Article. 8(1)(b) EUTMR. The Opposition Division partially rejected the opposition.

Substance: In relation to metals for street construction, street furniture of steel, metal building materials and cleaning, maintenance, repairing of plants and facilities thereof, the relevant public, being the attentive professional for these goods, is specialised.

Such goods and services are found to be dissimilar from the goods and services protected by the earlier trademark (barrels, containers, tanks for beverages and gas and repair services relating thereto).

As finished goods the opponent's goods differ in nature and purpose from 'common metals and alloys' which are raw materials. The fact that the conflicting goods are made of metal, does not of itself render the goods similar since very many different types of goods can be made of metal but serve entirely different purposes. The goods of the mark applied for are the raw materials for the

manufacture of metal goods, or are goods used in the maintenance and construction of buildings or the provision of amenities to buildings. The sectors implicated and the public targeted are not the same. The distribution channels will also differ. Moreover, a close complementary relationship does not exist and the goods are not substitutes for each other (§20). The opponent's services are also dissimilar to the goods of the applicant in Class 6 (§21). The conflicting services differ in nature and purpose, a close complementary relationship does not exist – the provision of the services of the earlier mark does not directly implicate the services in the application. The services do not substitute each other. The relevant public is not the same. The consumer would not expect that undertakings repairing barrel or containers of metal will offer repair, maintenance and cleaning services in factories, industry and manufacturing plants generally or will be directly involved in the modernization and maintenance of industrial installations, machines, apparatus and equipment used on production lines let alone build, construct or run electrical installations (§23).

The public is aware that 'INOX' is the prefix for the word 'inoxidable', which is not distinctive for metal goods.

Consequently, there is no likelihood of confusion between the conflicting marks, even though they present some visual and phonetic similarities (§24).

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14/06/2017, R2400/2016-2 - VibeSys

Result: Decision confirmed.

Keywords: Restitutio in integrum.

Norms: Article 81 EUTMR.

Facts: The IR applicant, seeking to register its trademark in the European Union, claimed the priority of an earlier EUTM and was requested to provide evidence on that issue. Having missed the deadline to submit evidence, the applicant submitted a request for a restitutio in integrum. The examiner considered the request as deemed not filed because the six-month priority period was not a time-limit to which Article 81(1) EUTMR applied in the interests of legal certainty. The IR applicant filed then an appeal against the contested decision.

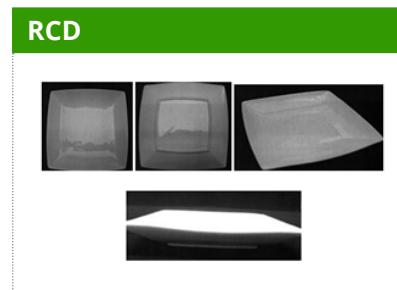
Substance: Article 81(1) EUTMR sets the remedy of the restitutio in integrum for those cases in which the applicant for or proprietor of an EU trade mark is unable to observe a time limit vis-à-vis the Office. The Board agrees that the six-month priority period does not belong to the time limits excluded from restitutio in integrum; however, it is necessary that the right of priority is attributed to an EU trade mark application. In the case at hand, the priority claim, albeit based on an EUTM application, is not attributed to an EU trade mark application but to an International Application (§18).



In the case at hand, the six-month time limit the IR applicant refers to is not vis-à-vis the Office but vis-à-vis the International Bureau (WIPO) (§19). Consequently, the request for restitutio in integrum does not comply with the conditions as established by Article 81(1) EUTMR. The appeal has been dismissed (§20).

Designs

01/06/2017, R0459/2016-3 Dishes / Dishes



Result: Remitted to the Grand Board.

Substance: The Board considers the case is legally important in the sense of Article 135(3) EUTMR. The case is remitted to the Grand Board to decide on the issue of whether when comparing a prior design consisting of a set of articles with a later design depicting only one (or some) of the articles included in the set, the comparison made to evaluate whether the overall impression which the

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later design creates on the informed user differs from the overall impression created on such a user by the prior design should be a) limited only to the article(s) making up the later design which is (are) included in the prior design, or b) based on the complete combination of the articles making up the set included in the prior design compared to the later design.

[17/02/2017, R1266/2016-3 Graphic symbols and logos](#)



Result: Decision annulled.

Keywords: Definition of a design.

Norms: Article 3(a) CDR.

Facts: The applicant filed a multiple application for 'graphic symbols and logos, surface patterns and ornamentation'. The examiner informed the applicant that the application did not comply with



the definition of design set by Article 3(a) CDR, in the light of the fact that the words per se do not display the appearance of a product, and neither bold nor italic type constitutes fanciful characters which could render the design eligible for registration. The examiner decided finally to reject the application and the applicant appealed its decision.

Substance: The design at hand does not consist of the simple reproduction of lexical words in standard script, as the examiner understood, but consists of specific arrangements of words and symbols which are frequently used as adornment on T-shirts, sweatshirts, bags, etc. and that meet the requirements set by Article 3(a) CDR (§13). It is irrelevant to which extent the typeface used for the individual words is commonplace or not and, at the same time, it is also irrelevant whether or not the words not only produce a visual appearance but also convey a message. In fact, a registered Community design only protects the features of appearance of a product or ornamentation and not the meaning of any words contained in the design. Therefore, there is no reason why designers of such arrangements should be deprived of the protection as a registered Community design (§15).

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