

Alicante News

Up to date information on IP and EUIPO-related matters

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INTA President Ronald van Tuijl

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We are EUIPO

On March 23, 2016, Regulation (EU) 2015/2424 entered into force and the Office for Harmonization in the Internal Market (OHIM) became the European Union Intellectual Property Office (EUIPO).

The Community trade mark became the European Union trade mark.

On March 23, a revised set of Guidelines entered into force, and are available through the EUIPO website. The EUTM section in this month's Alicante News contains a summary of the changes for users.

The fees payable to the Office have also changed. The Office has moved to a one-class-per-fee system, which means that in practice applicants pay a lower fee if they only apply for one class, the same fee if they apply for two, and a higher fee if they apply for three or more.

Renewal fees are substantially reduced in all instances and set to the same level as application fees, and there are also reductions in opposition, cancellation and appeal fees. All our online applications have been adapted to the change of name and the new fee structure.

Regulation (EU) 2015/2424 also contains a number of provisions that will come into force 21 months after its publication (on October 1, 2017). EUIPO



is committed to informing users about the impact of these changes on its practice ahead of their entry into force. The Guidelines for Examination of the Office will also be updated to reflect Office examination practice in the light of these changes in time for their entry into force.

The form for entering a declaration under Article 28(8) of Regulation (EU) 2015/2424 is now available through the Office's website. It can be found in the "forms and filing" section. Users need to log in to make the online request. Proprietors/holders wishing to file on paper should use the normal Recordal Application form. Only one form may be filed per EU trade mark.

Users are kindly invited to read the [FAQs on declarations](#) under Article 28(8) EUTMR before entering a declaration.

Users are also invited to note the [new contact details](#) of the Office. Only the website address (www.euipo.europa.eu) and the email addresses have changed; the postal address and telephone numbers remain the same.

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The James Nurton Interview



INTA President Ronald van Tuijl of JT International

When did you become interested in IP?

It was in the final year of my law studies in the Netherlands. One of the subjects I could choose was copyright and that got me into the area of IP. My thesis was also on copyright – on the role of collecting societies on the internet.



Ronald van Tuijl, President of INTA

My first role was an in-house practitioner at KPN

Telecom. I worked there for around five years and trained as a Benelux trade mark and design attorney. The focus was on trade marks and designs and also copyright. It was a really interesting period. They were the biggest trade mark owner in the Benelux and they also owned internet providers, so there were issues about liability. I learned a lot.

I moved to Unilever and spent a good eight years, and that formed me as an IP counsel. I worked on a wide range of portfolios across food and beverages and personal care, from Ben & Jerry's to Lipton Ice Tea. They're very different brands, and the brand strategy is different. As you move to different portfolios in the company you move to different roles.

I came to a point where I wanted to broaden my horizons and I joined Philips Electronics for about three years. Philips also has a very large IP portfolio and it was very professional and project-based so again I learned a lot. Then in August 2012 I moved to Switzerland to my current position as Intellectual Property Trade Marks Director at JT International. People joked that I had worked for all the Dutch multinationals so it was time to move abroad!

What does your current job involve?

In my team I have a group of trade mark counsel reporting in to me. There are currently four managers and five assistants. Together we handle all the company's tobacco brands globally. I have overall responsibility for that and oversee the

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activities of the managers. I manage people in their own development and ensure there is consistency in the work they do. The managing part is an important part of my role, but also I handle litigation – that's something I focus on a lot. The team is working with the brand groups and the agent network, while I work with other functions in the company, such as the taxation department.

We have about 36,000 trade marks, which are spread worldwide – globally we have several markets that are key markets – but it's a centralised IP function. We pick up designs in the trade mark team, but the patent group pick up some of the designs too. We have a small portfolio of domain names but we don't have a big online presence, due to the restrictions that apply to the tobacco industry.

What are your expectations as INTA President?

The Presidential Task Force is focusing on the role of in-house IP professionals such as myself. In my career I've seen all sorts of changes to in-house teams regarding who they report to, how work is handled, the size of the team, what is insourced and outsourced and so on. I wanted to understand whether some of this is the result of economic crisis of technological development, or whether there is a trend, and to ask questions such as: what opportunities are there for people to further their career?

The Task Force is hopefully going to come up with

a set of recommendations as to what INTA can do to support in-house practitioners on those topics, to see how in-house practitioners can participate and be active in INTA, and whether INTA is offering the right opportunities. Next to the task force, growing the regular INTA membership is important because we need to hear their voice.

Are the challenges increasing for in-house practitioners?

My feeling when I talk to people is that there is something in that. For example, has technology evolved to such a point that fewer people can do more work? The amount of emails you get on a daily basis is not a sign of whether your work has become easier: you are more than just a person who's answering all the questions. You should be the guardian of IP and go outside your organisation to learn more by participation in associations or in seminars. If that is slowly minimised, the question is: are you contributing all that you can to your company?

What other plans do you have as President?

With the different committees, we will see more policy work coming up, and I expect to see Board resolutions arising from the work of those committees. One of those is the new Designs Committee, and we recently held a designs conference in Singapore with AIPPI.

We are also opening an office in Singapore, and

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this year we will hold the first INTA conference in Africa for 20 years, which shows the growing internationalisation of INTA.

What do you think are the biggest challenges in trade marks?

The EU reforms are very important, in particular concerning goods in transit, the classification of goods and services and administrative procedures for oppositions and cancellations. We've all read the reform package so know what's coming, but we need to know how the changes will impact industry, our brands and clients.

Another important issue is internet governance, in particular the new gTLD process and the IANA transition. These are two topics that trade mark owners cannot ignore.

And plain packaging is a trade mark and a brand issue with the potential to impact a number of industries, so that is important to focus on. I think trade mark owners need to be aware of this issue and they are. The proof of that is that INTA passed a Board Resolution last year on plain and highly standardised packaging. The Board represents a multitude of companies in different industries and they passed that Resolution.

Do you think the EU reforms are welcome?

It is a significant step towards a more harmonised and more modern trade mark system. There will

be new opportunities. The reform as such provides tools for businesses to protect and enforce trade mark rights. I believe the changes will result in a speedier, more accessible and more efficient system. Accessibility will be improved, not only because of the reduction of renewal fees but also the elimination of the graphical representation requirement. I'm curious to see what will happen there. It will also be more efficient because of the goods-in-transit provisions.

Of course you are always hoping for the ultimate harmonisation. We would have liked to see bad faith added as an opposition ground. We would also have liked to see the removal of ex officio examination on relative grounds.

Do you think the EUTM has been successful?

I think it has been very successful and the filing and renewal statistics confirm that.

We are very supportive of regional systems and of expanding the Madrid System, because it simplifies registration and maintenance and usually a result of that is lower cost. It can also result in harmonisation in trade mark offices at different levels, and we all benefit from that.

Is there anything you would like to see improved in the EU?

Speed will always be everybody's answer – we can all benefit from faster decisions. We always ask for

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more speed but maybe that shows that so much else is working well!

If you look at how a company develops, it used to take years to roll out a new product – I can remember we would file a trade mark application and wait to see if there was an obstacle. But the speed to market for companies is increasingly fast. If you wish to have freedom-to-use or to enforce a mark associated with a product, you need faster procedures. And with social media and globalisation, you can be famous overnight – literally. With that comes the exposure and the risk of people filing bad faith applications. If it takes a year to take action on that, it's too long, so it all comes down to speed.

What's been your most interesting case?

I had an interesting case in 1999 involving Sinterklaas – the Dutch equivalent of Santa Claus – which is of course a fictitious person played by many different people. At that time, there was one actor considered the official Sinterklaas who arrived on a steam boat in the harbour in November. The company I worked for used an image of that Sinterklaas. The actor and the broadcaster requested a preliminary injunction to stop the use of that image. The interesting question was: does a fictitious person have image rights? But it didn't go into that much detail because the actor himself was recognisable, and so his image was protected under Dutch copyright law. There was an article saying you can object to the use of your image if you have a reasonable interest.

Under case law that included a reputation you can commercialise and that's what happened in this case: the court found the actor had a reasonable case to prevent the use of the image.

The decision came on 2nd December and we had 24 hours to remove all the point-of-sale materials from stores all over the Netherlands. It was a high-profile case, legally interesting and attracted a lot of publicity. Was he recognisable, was he popular? Yes and yes. But if we'd had any other Sinterklaas, it would not have been the same.

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Changes to Office Guidelines under the Amending Regulation

The new version of the Guidelines, with changes introduced as a consequence of Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16/12/2015 (the Amending Regulation) entered into force on 23/03/2016.

To this effect, [Decision EX-16-1](#) of 10/03/2016 has been adopted

The Office opted for a separate revision cycle for this, in parallel with Work Package 1 and Work Package 2, so that the abovementioned changes in the Guidelines could enter into force at the same time as the new Regulation.

Despite the tight schedule for implementing the changes in the Guidelines, the usual consultation mechanisms as for other revision cycles were maintained. For instance, at the Liaison Meeting of 06-07/10/2015, the definitions of practice prepared by the various Knowledge Circles were presented and discussed at special workshops. The draft changes were published for comment in December 2015.

The changes in the Guidelines described in this article are those that enter into force on 23/03/2016. Certain other articles, basically those that need to be

developed by secondary legislation (implementing or delegated acts), will only enter into force on 01/10/2017. These are not reflected in the Guidelines yet.

Please find hereafter the changes introduced into the Guidelines by the various Knowledge Circles.

Part A: General Rules

Changes to the section of the Guidelines dealing with general rules concern notification by post and time limits, the extension of the capacity to act before the Office to European Economic Area ('EEA') countries, clarification of the practice regarding continuation of proceedings, and the abolishment of interlocutory revision in inter partes cases.

Part A, General Rules, Section 1, Means of Communication, Time Limits

Notification by post and time limits

The Guidelines have been amended to reflect the fact that notification by registered mail with recorded delivery is no longer limited to addressees with a place of business or domicile within the Member States of the European Union ('EU') but has been extended also to those with a place of business or domicile in countries belonging to the EEA.

Similarly, the rules regarding time limits specified

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by the Office in cases involving a party having its domicile or its principal place of business or an establishment in the EU now extend to EEA members (such time limits may not be shorter than one month).

These changes are reflected in:

- Part A, General Rules, Section 1, Means of Communication, Time Limits; paragraph 3.2.2 on notification by post;
- Part A, General Rules, Section 1, Means of Communication, Time Limits; paragraph 4.1.1 on the length of time limits specified by the Office.

Continuation of proceedings

The Guidelines have been modified to reflect the content of Article 82(4) EUTMR, which deals with requests for continuation of proceedings when a decision has already been taken. It is now clearly stated that in such cases the department competent to decide on the omitted act will review the decision and either take a different decision or confirm the original one.

This change is reflected in Part A, General Rules, Section 1, Means of Communication, Time Limits, paragraph 4.1.4 on the continuation of proceedings.

Part A, General Rules, Section 5, Professional Representation

Practice regarding representatives and the obligation to be represented in proceedings for trade mark matters that previously applied only to the EU has been extended to the EEA (European Economic Area).

This means that those natural or legal persons having their domicile, place of business or a real and effective establishment within the EEA do not have to be represented.

For representatives, the consequence of the Amending Regulation is that legal practitioners entitled to act in trade mark matters before an IP office of an EEA Member State may now also act as representatives in trade mark proceedings before the Office. The same applies mutatis mutandis to representatives to be included in the Office's special list where they comply with the further conditions. Finally, employees of undertakings having their place of business within the EEA may also act as representatives of undertakings from outside the EEA if there are economic connections.

Part A, General Rules, Section 7, Revision

Following the deletion of Article 62 CTMR, the revision of decisions in inter partes proceedings will not be possible after the entry into force of the Amending Regulation. Therefore, the part of the Guidelines dealing with revision in inter partes

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cases has been deleted too. This change is reflected in Part A, General Rules, Section 7, Revision.

Part B: Examination

Filing of EUTM applications through National Offices

To reflect the change brought about by Article 25 EUTMR, provisions in the Guidelines referring to the option of filing an EUTM application through a National Office of an EU Member State have been deleted.

This change is reflected in:

- Part A, General Rules, Section 1, Means of Communication, Time Limits, paragraph 2 on procedures for filing and for communication with the Office;
- Part A, General Rules, Section 8, Restitutio in Integrum, paragraph 3.3 on the time limit for National Offices to forward an application to the Office;
- Part A, General Rules, Section 9, Enlargement, paragraph 2.6 on other practical consequences;
- Part B, Examination, Section 2, Formalities, paragraphs 2 and 4.2 on filing of applications and filing date receipt respectively.

Search reports

The part dealing with search reports has been

substantially modified as a result of the new wording of Articles 38 and 155 EUTMR.

The Guidelines now clarify that an EU search report will be sent to an EUTM applicant only if the latter has expressly requested this at the time of filing. In the case of international registrations designating the EU, holders may send such a request to the Office within one month of the date of notification of the international registration.

The Office remains obliged to send surveillance letters to the proprietors of any earlier EUTMs, EUTM applications or international registrations designating the EU cited in an EU search report. However, proprietors may now expressly request to opt out of surveillance letters, in which case they will no longer receive any.

As regards national searches, all references to the timing of reports by the National Offices have been deleted from the Guidelines.

Finally, according to the new text of the Guidelines, the search reports do not imply any time constraints for the publication of an application.

The corresponding changes are reflected in:

- Part B, Examination, Section 1, Proceedings, paragraphs 2 and 4 on searches and publication;
- Part M, International Marks, paragraph 3.3.2 on

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searches.

Timing of third party observations

The section dealing with procedural aspects concerning third party observations has been clarified to take into account the new wording of Article 40(2) EUTMR. According to the Guidelines, observations on the existence of an absolute ground for refusal can be made by third parties before an EUTM application has been published, as well as within the opposition period or, where an opposition has been filed, before the final decision on the opposition has been taken.

This change is reflected in Part B, Examination, Section 1, Proceedings, paragraph 3.1 on procedural aspects concerning third party observations and the review of absolute grounds.

Reduction of fees for e-filing of collective marks

The information on fees applicable to EUTM applications has been amended to mirror the changes in Annex I to the EUTMR.

As a consequence of the introduction of a fee for EU collective marks filed electronically, the Guidelines have been amended to reflect the fact that the specific formality deficiency for applications filed electronically will apply also to EU collective marks filed in this way.

These changes are reflected in:

- Part B, Examination, Section 2, Formalities, paragraph 3.1 on fees in general;
- Part B, Examination, Section 2, Formalities, paragraph 5.2 on the specific deficiency for e-filing.

Disclaimers

Following the deletion of Article 37 CTMR, the part on disclaimers has been redrafted to clearly indicate that, as from 23/03/2016, disclaimers can no longer be applied for nor can the Office request them.

This change is reflected in Part B, Examination, Section 2, Formalities, paragraph 14 on disclaimers.

References to disclaimers have also been deleted from:

- Part B, Examination, Section 2, Formalities, paragraphs 7 and 12 on languages/translations and indicators of colour respectively;
- Part C, Opposition, Section 1, Procedural matters, paragraph 5.4.4.5 on reactions to disclaimers.

Seniority examination

The part of the Guidelines dealing with the examination of seniorities has been modified to reflect the content of Article 34(3) EUTMR. It is now

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stated that seniority claimed for an EUTM will lapse if an earlier trade mark, the seniority of which is claimed, is declared to be invalid or revoked. Where the earlier trade mark for which seniority has been claimed is revoked, the seniority will lapse provided that the revocation takes effect prior to the filing date or priority date of the EUTM.

The change is reflected in Part B, Examination, Section 2, Formalities, paragraph 17.2 on the examination of seniority.

Part B, Examination, Section 3, Classification

The main changes to this section of the Guidelines concern the replacement of all references to Rule 2 CTMIR by references to the new wording of Article 28 EUTMR. All references to IP Translator and its wording have been replaced by the new wording of Article 28 EUTMR. In particular, paragraph 4.2 clarifies that, in accordance with Article 28(3) EUTMR, class headings are acceptable for classification purposes and will be interpreted according to their literal meaning.

This review of the Guidelines also includes an update of the general indications considered to be unclear or imprecise following the entry into force of the 2016 version of the 10th edition of the Nice Classification.

In essence, the Amending Regulation does not

bring any specific changes in practice as regards classification practice, as the new wording of Article 28 EUTMR simply serves to codify the practice originally put in place following the IP Translator judgment.

However, as far as goods and services are concerned, Article 28(8) EUTMR allows for a transitional period during which proprietors of EU trade marks filed before 22/06/2012 and registered for the entire heading of a Nice class may declare that their intention at the time of filing had been to cover goods and services beyond those covered by the literal meaning of the class heading. The procedure for implementing this provision was laid down in Communication No 1/2016 of the President of the Office.

Part B, Examination, Section 4, Absolute Grounds for Refusal

The main changes concern:

- observations by third parties — Article 40 EUTMR
- functional trade marks — Article 7(1)(e) EUTMR
- protected designations of origin (PDOs) and protected geographical indications (PGIs) — Article 7(1)(j) EUTMR
- traditional terms for wine (TTWs) — Article 7(1)(k) EUTMR
- traditional specialities guaranteed (TSGs) — Article 7(1)(l) EUTMR

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- plant variety rights (PVRs) — Article 7(1)(m) EUTMR
- temporal scope

Observations by third parties — Article 40 EUTMR

The Amending Regulation codifies the existing practice to the effect that the Office can reopen the examination of absolute grounds at any time before registration either upon receipt of observations from third parties or on its own initiative.

Functional trade marks — Article 7(1)(e) EUTMR

The Amending Regulation extends the prohibition that currently applies to 'shape' marks to signs consisting exclusively of other characteristics (e.g. colours, smells or sounds) that result from the nature of the goods they designate, that are necessary for obtaining a technical result or that add substantial value to the goods. There is no established practice yet in this respect.

Protected designations of origin (PDO) and protected geographical indications (PGI) — Article 7(1)(j) EUTMR

Article 7(1)(j) EUTMR is now a catch-all provision that governs conflicts between trade marks and PDOs/PGIs in all fields. The previously separate sets of rules for wines and spirit drinks on the one hand and foodstuffs and agricultural products on the other have been merged into one single set in the new version of the Guidelines.

Article 7(1)(j) EUTMR governs conflicts between the EUTMR and PGIs/PDOs protected by both EU and national law. The Guidelines have been amended to cover conflicts with PGIs/PDOs protected by national law. In view of the exhaustive nature of the protection granted by EU legislation in the agricultural field for wines, spirit drinks and foodstuffs, the Office interprets the reference to PGIs/PDOs protected under national law as being limited to non-agricultural products. The Office will therefore not object to trade marks that conflict with PDOs and PGIs in the agricultural field that are protected by national law because of the existence of EU legislation, which establishes a uniform system of protection. However, since there is no EU legislation replacing national legislation in the non-agricultural field, national law will have to be taken into account for non-agricultural products.

In addition to the changes brought by the Amending Regulation, the Office has introduced three additional changes regarding the substantive assessment of PGIs/PDOs protected by EU legislation: (i) guidelines for trade mark conflicts with PGIs for aromatised wines; (ii) scenarios where conflict with PGIs/PDOs can be excluded; (iii) a catalogue of situations where a trade mark is in conflict with more than one PGI/PDO, along with an examination of whether such conflicts can be overcome by limitations.

Traditional terms for wines (TTWs) — Article 7(1)(k) EUTMR

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The Amending Regulation now expressly refuses the registration of trade marks that conflict with TTWs. These are terms traditionally used in the EU to provide information on the quality of wines, complementing the information conveyed by PGIs/PDOs (e.g. ageing methods, colours, places). An example of a TTW is 'château'. TTWs are protected under EU law or international agreements to which the EU is party.

The assessment of trade mark conflicts with TTWs is to some extent similar to the assessment of conflicts with PGIs/PDOs. However, TTWs are protected only in the language of the application (translations excluded) and only for grape vine products (comparable goods excluded). On the other hand, the protection afforded to TTWs covers direct and indirect use, misuse and misleading indications. An objection can be overcome by a limitation of the list of goods and services.

Traditional specialities guaranteed (TSG) — Article 7(1)(l) EUTMR

The EUTMR also expressly refuses the registration of trade marks that conflict with TSGs. These are terms that designate a traditional method of production or recipes that use traditionally raw materials and ingredients (e.g. Jamón Serrano). Unlike with the PGIs, there is no link with a specific geographical area.

TSGs are protected under EU law, or under international agreements to which the EU is party, against direct and indirect use, imitation, evocation or misuse and misleading indications. While their protection is analogous to that of PGIs, comparable products and translations are excluded.

Plant variety denominations (PVDs) — Article 7(1)(m) EUTMR

In the past, the Office objected under Article 7(1)(f) CTMR to trade marks that conflicted with PVDs. The EUTMR now introduces a stand-alone ground for this IP title and, importantly, adds PVDs protected under national law and international agreements to which Member States are a party to those already protected by EU legislation and international agreements concluded by the EU.

Article 7(1)(m) EUTMR also clarifies the scope of protection of PVDs vis-à-vis trade marks. First, objections can be raised only if the PVD represents one of the essential elements of a trade mark and second, objections should be raised not only against trade marks that include the species protected by the PVD but also against closely related species.

The Guidelines now include new sections covering Article 7(1)(k), Article 7(1)(l) and 7(1)(m) EUTMR.

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Part C: Opposition

Part C, Opposition, Section 1, Procedural Matters

With respect to the section dealing with opposition proceedings, the Guidelines have been amended to reflect changes relating to the new start date of the opposition period in respect of international registrations designating the EU and the introduction of a new relative ground of refusal, namely Article 8(4a) EUTMR.

The start date of the opposition period in respect of international registrations designating the EU

The section on early oppositions against an international registration has been modified to implement the change introduced by Article 156(2) EUTMR, which states that the opposition period begins one month after the date of first republication. Previously, this period began on the sixth month after the date of first republication. The actual length of the opposition period, however, remains the same (three months). With regard to timing, the Guidelines further clarify that, for international registrations whose date of first republication falls before 23/03/2016, the previous time limit applies, that is to say, that an opposition should be filed within a period of three months starting six months after the date of first republication.

The change is reflected in Part C, Opposition,

Section 1, Procedural Matters, paragraph 2.1.1 on early oppositions against international registrations.

New Article 8(4a) EUTMR: admissibility and substantiation

Following the introduction of a new relative ground of refusal, new sections dealing with admissibility and substantiation requirements with regard to oppositions based on an earlier protected designation of origin or a geographical indication have been added.

The Guidelines now clarify that, in order for an opposition based on Article 8(4a) EUTMR to be considered admissible, the notice of opposition must contain an indication of the nature of the right, the territory where the protected designation of origin or geographical indication is claimed to be protected and a representation of such earlier right. Only persons authorised under the relevant EU legislation or national law to exercise the rights to the earlier protected designation of origin or geographical indication are entitled to file an opposition based on this ground. Finally, a new section on the substantiation of oppositions based on designations of origin or geographical indications has been introduced.

The change is reflected in Part C, Opposition, Section 1, Procedural Matters, paragraphs 2.4 and 4.2 on admissibility checks and substantiation respectively.

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Part C, Opposition, Section 2, Chapter 2, Comparison of Goods and Services

The main changes to this chapter of the Guidelines concern the replacement of all references to Rule 2 CTMIR with references to the new wording of Article 28 EUTMR. In addition, paragraph 2.5 regarding practice on the use of general indications of class headings has been developed to explain how to interpret the scope of protection given to class headings before, during and after the transitional period provided for in Article 28(8) EUTMR, which allows proprietors of trade marks filed before 22/06/2012 to file a declaration that their intention at the time of filing had been to cover goods and service beyond those covered by the literal meaning.

This chapter also provides an insight into the limitations of Article 28(9) EUTMR.

Part C, Opposition, Section 4, Rights under Articles 8(4) and 8(4a) EUTMR

Article 8(4a) EUTMR introduces separate provisions for oppositions based on geographical indications. Although this ground applies to the same geographical indications that were protected under Article 8(4) CTMR, use of more than mere local significance does not need to be proven any longer. Oppositions based on Article 8(4a) EUTMR are dealt with in the new text in Guidelines, Part C, Section 4, Rights under Articles 8(4) and 8(4a) EUTMR,

paragraph 5.

Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR)

The changes reflected in Article 8(5) EUTMR are intended merely to clarify settled case-law that the Office has already been following in current practice.

Part C, Opposition, Section 6, Proof of Use

The time limit relating to proof of use will now be calculated backwards from the date of application for the contested EUTM or even from the priority date. Under the old rules, the relevant point in time was the date of publication of the contested EUTM. This change will result in fewer earlier trade marks being subject to the proof of use requirement (only those registered five years before the date of application for the contested EUTM or the priority date). Initially, both old and new regimes will run side by side, and the one applied will depend on the date of the opposition. The Guidelines explain both scenarios (Guidelines, Part C, Section 6, Proof of Use, paragraph 2.5).

When an opposition is filed against an international registration (IR), the opponent may have to submit proof of use for the relevant five-year period if its earlier mark was registered five years before registration of the IR or the priority date (Guidelines, Part C, Section 6, Proof of Use, paragraph 2.5).

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Part D: Cancellation

Part D, Cancellation, Section 1, Cancellation Proceedings

Absolute admissibility deficiencies

The part dedicated to absolute admissibility requirements has been modified to reflect the new wording of Article 56(3) EUTMR.

This change is reflected in Part D, Cancellation, Section 1, Proceedings, paragraph 4 on the admissibility check.

Part D, Cancellation, Section 2, Substantive Provisions

Article 76(1) EUTMR

The Amending Regulation codifies existing Office practice, as sanctioned by case-law, which stipulates that in invalidity proceedings based on absolute grounds, the Office must limit its examination to the grounds and arguments submitted by the parties.

Part E: Register Operations

Part E, Register Operations, Section 4, Renewal

The Amending Regulation revises the renewal fees as well as how the renewal periods are calculated.

During a transitional period the following applies according to Communication No 2/2016 of the President of the Office:

Fees. For the purpose of calculating the amount of renewal fees, the due date for these is the date of expiry of the registration (Article 47(5) EUTMR, which is not modified by the Legal Reform). Consequently, EUTMs expiring before 23/03/2016 will pay the renewal fee according to the old fee schedule while those expiring on or after 23/03/2016 will pay according to the new fee schedule. This principle applies regardless of when renewal is actually requested and paid for. Owners who have already paid according to the old fee schedule for the renewal of an EUTM expiring after 23/03/2016 will be refunded the excess payment (the difference between the old and new fee schedules).

Calculation of renewal periods. Under the previous CTM Regulation, requests for renewal could be made, and the fee for renewal paid, right up until the end of the month in which the registration of the mark was due to expire, and the additional six-month 'grace period' for renewal started to count from the first day following the end of the month.

The Amending Regulation modifies this Article so that both the request for renewal must be made and the fee for renewal paid within the six-month period prior to the expiry date of the registration (in other words, prior to the mark's 'date of expiry'), and

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the additional six-month grace period for renewal starts to count from the day following the date of expiry.

However, the Office has established transitional arrangements for those marks for which the basic six-month period for renewal started before the entry into force of the Amending Regulation on 23/03/2016. For these marks, the 'old' method of calculation will apply, even if their date of expiry falls after 23/03/2016. This means that EUTMs that expire on 22/09/2016 will be the first to which the new calculation of the renewal periods applies in full.

Part M: International Marks

The most important change in this part relates to the much shorter time before commencement of the period for filing of oppositions, which will start only one month after the first republication of the IR designating the EU, instead of the current six months. This will apply only to IRs designating the EU republished on or after 23/03/2016.

However, the Office still has the option of reopening the examination of absolute grounds on its own initiative at any time before the final statement of grant of protection.

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Implementation of the CP6 Convergence Project on Graphic representation of designs

After launching in January 2014, twenty-three participating IP Offices, five observers, two User Associations and the EUIPO in the context of the European Trade Mark and Design Network, worked collaboratively with the intention of giving guidance to users and examiners on how best reproduce graphically designs and on quality standards for design applications.

This objective was successfully achieved with the endorsement of the first Common Practice on designs in November 2015.

The first Common Practice on designs will be implemented by the EUIPO on 15 April 2016. This Common Practice will be made public through a Common Communication, which includes the Common Practice and additional details regarding implementing offices.

EUIPO has also been working to incorporate the practice in its Examination Guidelines to ensure that the agreed Common Practice is also reflected in the Office's Guidelines.

The Common Practice will be available in 23 EU languages and will increase transparency, legal

certainty and predictability in how to use the appropriate disclaimers, types of views and how to represent designs on a neutral background.

In determining how to use the appropriate visual disclaimer, although graphic or photographic representations showing only the claimed designs are preferred, recommendations are given for the following visual disclaimers: broken lines, colour shading, boundaries and blurring.

In relation to types of views, general recommendations and guidelines for each type of view are provided in order to obtain a suitable representation of the design.

Furthermore, in order to assess if a background is neutral, requirements related to colours, contrasts and shadows or reflections are also provided.

Finally, as additional information for users, there is also an overview of the Offices' quality standards for design applications received by electronic means and by paper.

Shortly after the publication of the Common Communication, training material and a FAQs document will be made available to further facilitate the users' and examiners' understanding of the Common Practice.

The prior divergence amongst the participating

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offices made this an issue where harmonisation was highly welcome.

This Common Practice is the first stone in the harmonization of the designs practices and should be the beginning of a consolidated and continuous collaboration between the IP Offices in the designs field.

EUIPO takes this opportunity to again thank all project stakeholders involved for their dedication and investment in improving the European designs landscape.

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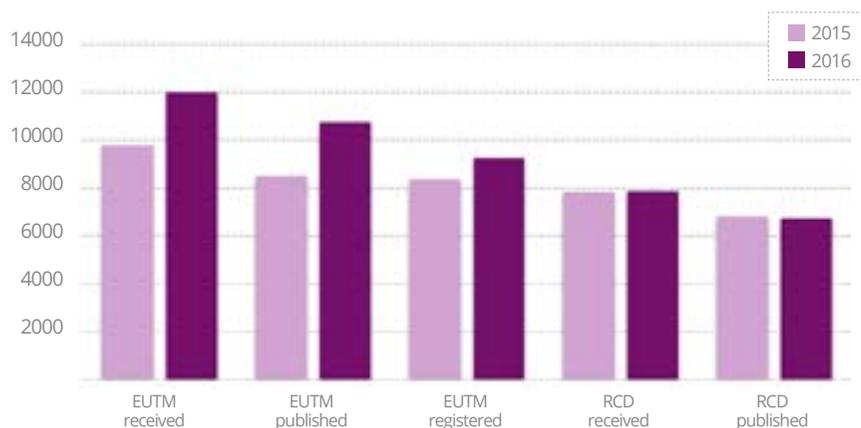


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Monthly statistical highlights February*	2015	2016
European Union Trade Mark applications received	9 774	11 985
European Union Trade Mark applications published	8 492	10 748
European Union Trade Marks registered (certificates issued)	8 366	9 269
Registered Community Designs received	7 819	7 856
Registered Community Designs published	6 831	6 747

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



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DESIGNEUROPA awards

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The Brunei Darussalam Intellectual Property Office (BrulPO) and the Department of Intellectual Property of the Ministry of Commerce of Cambodia (D/IPR) join TMclass

As of 21 March 2016, Brunei Darussalam Intellectual Property Office (BrulPO) and the Department of Intellectual Property of the Ministry of Commerce of Cambodia (D/IPR) have joined TMclass.

These latest additions bring the total number of national and regional IP Offices participating in the tool to 60.

BrulPO and D/IPR were already part of ASEAN TMclass which was developed by the Intellectual Property Offices of the ASEAN Member States with the support of the EU-ASEAN Project on the Protection of Intellectual Property Rights (ECAP III Phase II), for which OHIM is the implementing agency.

BrulPO's and D/IPR's decision to join TMclass is a result of the International Cooperation programme managed by OHIM in collaboration with its international partners.

TMclass brings together the classification databases

of each Participating Office to facilitate the process of classifying Goods & Services. It also offers users the opportunity to search and translate terms to and from any of the 40 available languages.

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Revised version of the Guidelines enters into force

A revised version of the [Guidelines on Trade Mark Practice and Designs](#), updated to reflect the entry into force of Regulation (EU) 2015/2424 on March 23 2016, has been published.

The changes brought about by the amending Regulation affect a number of areas of the Office's practice. As a result, the Guidelines have been revised to align their content with the new legislative framework.

They are now available on the Office's website after their adoption by the President of OHIM on 10 March 2016, by [Decision No EX-16-1](#).

The revised Guidelines entered into force on March 23, 2016.

EUIPO at INTA 2016

EUIPO will once again be participating in the INTA Annual Meeting, to be held this year in Orlando, Florida.

EUIPO experts will be on hand at the Office's Information Point (Booth 415) giving seminars and demonstrations of tools, databases and services.

The Office will also be holding its regular information

meeting on Sunday May 22, 2016 from 09:00 to 10:30 in Room W315-A.

The meeting will focus on the substantive changes brought about by Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2016 amending the Community trade mark regulation.

There will also be presentations on:

- Classification strategies for the EU
- Cooperation between IP Offices in the EU
- The work of the EU Observatory on Infringements of Intellectual Property Rights
- Quality initiatives for the benefit of users

IP Case Law Conference

On May 5-6, the Office is holding its first ever IP Case Law Conference.

This event is dedicated to substantive and procedural issues surrounding trade mark and design dispute resolution.

The conference brings together users of the international IP systems, IP professionals, judges, national and European level institutions and administrations. A provisional version of the conference programme is available here. The

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programme will be updated on a regular basis.

The event is designed to be as innovative and user-focused as possible. It will be held in an interactive format with ample opportunity for questions from the audience, and presentations on recent EUIPO Boards of Appeal and EU case law topics.

The language of the conference is English, but interpretation into French and Spanish will be provided.

A certificate of attendance will be available for all participants.

The conference is being held in the Office's headquarters in Alicante, Spain.

A registration fee of €150 will apply.

Registration details are available [here](#).

IP for Paralegals

After the success of last year's 'IP Course for Paralegals', the EUIPO is organising a new edition from 27 to 29 April 2016 in Alicante.

The 'IP Course for Paralegals' programme has been especially designed to give paralegals in-depth knowledge of:

- how to apply for clean files and avoid objections;
- opposition procedures;
- changes to CTM practice resulting from the Amending Regulation;
- appeal proceedings.

New for this year – workshops that include:

- tips for the examination of absolute and relative grounds;
- patent basics for paralegals;
- RCD registration procedures.
- cancellation proceedings.

All presentations will be held in English.

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Luxembourg trade mark and design news

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

Joined Cases T-381/13 and T-382/13; Perfetti Van Melle SpA v OHIM; Judgment of 16 December 2015; Language of the case: IT.

RESULT: Action upheld (BOA decision annulled)

KEYWORDS: Competence of the Boards, Descriptive element

FACTS: The applicant sought the registration of the word marks **DAISY** and **MARGARITAS** in relation to, “pastries and confectionaries, caramel, sweets, chewing gum, licorice, lollipops, toffee, sugar, chocolate, cocoa, coffee” in Class 30. The examiner refused the trade mark in relation to the above mentioned goods on the basis of Article 7 (1) (b), (c) and 7 (2) CTMR in relation to the English and Spanish speaking consumers in the EU. The examiner found that that part of the public would perceive the signs as a description of the shape of the goods. The examiner then withdrew the objection raised at the first time as far as it concerned “caramel, sugar, chocolate, cocoa, coffee”. The Second Board of Appeal (BoA) confirmed the examiner’s decision in relation to the above mentioned goods. The BoA, however, found that the applications had

to be rejected also in relation to “caramel, sugar, chocolate, cocoa, coffee”. To that regard, the BoA found that, in force of Article 64 (1) CTMR, it had to exercise the same competencies of the first instance. The applicant filed an action before the General Court (GC).

CTMA - T-381/13

DAISY

CTMA - T-382/13

MARGARITAS

SUBSTANCE: ARTICLE 64 (1) CTMR: The GC found, ex officio, that the BoA did not make an appropriate use of the discretionary power conferred by Article 64 (1) CTMR, to the extent that it refused the CTM application also in relation to the goods for which the objection was withdrawn at the first instance (Paras. 38-42).

ARTICLE 7 (1) (c) CTMR: According to the GC, the BoA correctly found that the words “daisy” and “margaritas” may be perceived as a reference to that flower, respectively, by the English and Spanish speaking part of the relevant public. The BoA was also right in finding that the appearance is an essential characteristic of the goods in the confectionery sector. Nevertheless, the

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GC found that neither the word “daisy” or the word “margaritas” present a sufficiently direct relationship with the characteristic of the goods in question, namely with their shape, in contrast to the requirements of Article 7 (1) (c) CTMR. The contested decisions do not show that the words “daisy” or “margaritas” are used to designate the goods in question, in one of the relevant languages (Paras. 59-63). The fact that the relevant goods can be made with the shape of a daisy flower, or that some goods with the appearance of a flower can be found in the relevant sector, are not sufficient to find that the consumers will perceive immediately and without further reflexion that there is a relationship between the signs in question and the shape of a pastry or confectionery product. In the absence of concrete evidence showing that the shape of a daisy was used extensively, or on a large scale, in the relevant sector, it is not possible to conclude that that shape is a formalized or standardized shape of the products in question. Therefore, although occasionally consumers could had seen these products in the form of other flowers or even, for some, specifically in the form of a “daisy”, the existence of a relationship between the words “daisy” or “margaritas” and those goods is, merely hypothetical in the case at hand (Paras. 66-69).

ARTICLE 7 (1) (b) CTMR: The GC noted that, according to the contested decision, the fact that the signs were devoid of any distinctive character derived directly from the finding that they had

a descriptive character in relation to the shape of the goods. Therefore, in the absence of any autonomous reasoning in respect of Article 7 (1) (b) CTMR, the decision has to be annulled also as far as that article is concerned (Para. 83).

Case T-491/13; Perfetti Van Melle Benelux BV v OHIM - Intercontinental Great Brands LLC; Judgment of 16 December 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Dominant element, Visual similarity, Phonetic similarity, Conceptual similarity, Complex marks

FACTS: The applicant sought the registration of the Community word mark **TRIDENT PURE** for the following goods in Class 30: “Non-medicated confectionery, sugar confectionery including mints”. An opposition was lodged based on, inter alia, the earlier figurative Community marks shown below. The Opposition Division (OD) upheld the opposition on the ground that there was a likelihood of confusion, within the meaning of Article 8 (1) (b) CTMR, between the mark applied for and the Community figurative mark No 9 291 634 in relation to all the goods covered by the application. The applicant filed a notice of appeal with the Office. The Fourth Board of Appeal (BoA) upheld the appeal and annulled the OD’s decision.

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The applicant appealed to the General Court (GC), alleging the infringement of Article 8 (1) (b) CTMR.

CTMA

TRIDENT PURE

Earlier marks



Community mark No 9 291 634

PURE
WHITE

Community figurative mark No 6 771

869

SUBSTANCE: The GC dismissed the appeal. The relevant public is the public at large in the EU and the goods at issue are identical. Those issues were

not disputed by the parties. The GC confirmed the assessment made in the contested decision that the word element “pure” featuring in all the marks at issue will be perceived by a part of the relevant public, in particular by consumers in English-, French-, Italian-, German-, Dutch-, Portuguese-, Spanish- and Romanian-speaking areas, as being a reference to the freshness or purity of the goods sold and, therefore, as a mere description of those goods. For those consumers who do not understand the meaning of the word “pure”, the element has an average level of distinctiveness (Paras. 44, 45). For the part of the relevant public that understand the meaning of the word “pure”, the more distinctive and dominant element of the mark applied for is the element “trident”. For those consumers who do not understand the word “pure”, the element “trident” is still the more dominant element, since it features at the beginning of the mark and is longer than the element (Paras. 51, 54).

Earlier CTMR No 9291634 **PURE** - The GC found that, despite its weak distinctive character in relation to the public who understand its meaning, the element “pure” cannot be regarded as being secondary in the overall visual impression produced by the earlier mark, since it also attracts attention by reason of its size and the fact that it is the sole word element and is placed at the top of that mark. The GC recalled the case law for which the fact that one of the two words which make up a word mark is descriptive is not, on its own, sufficient to conclude that that word is negligible in the overall impression produced by

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that mark. The BoA therefore erred in denying the existence of any visual similarity between the marks. However, for those consumers who understand the word “pure”, the main element of that mark consists of the image of the mint leaf. Similarly, the main element of the mark applied for, for that category of consumers, is the word element “trident”. It follows that the element common to both marks, namely the element “pure”, will attract those consumers’ attention to a limited extent and that the degree of visual similarity is thus very low (Paras. 68-71). For those consumers who do not understand the word “pure”, that element is endowed with a more evident distinctive character. However, it must be stated that that fact is mitigated by the position, size and graphic representation of the mint leaf. Moreover, the more important element of the mark applied for is, for that category of consumers also, the word element “trident”. Therefore, the degree of visual similarity is, for those consumers, low, as the BoA correctly found (Para. 72). Phonetically, for those consumers who understand the word “pure”, that fact, the absence of distinctiveness of the element “pure” and the fact that the different element in placed at the beginning result in a low phonetic similarity between the marks at issue. By contrast, the degree of similarity for other consumers is greater. For those who pronounce the word “pure” in one syllable, the phonetic similarity between the marks at issue remains below average, since the word “trident” consists of two syllables containing three dental consonants the pronunciation of which

is even more emphasised, as opposed to one syllable in the word “pure”, which, phonetically, plays a less important role in the mark applied for. However, even for those consumers who pronounce the word “pure” in two syllables, the significance of the element “trident”, which is positioned in first place, lessens the resemblance between the marks at issue, with the result that, for those consumers, those marks are of merely average phonetic similarity (Paras. 84-89). Conceptually, the GC held, contrary to the BoA’s findings, that, for those consumers who understand the word “pure” as being a reference to the purity of the goods at issue and to the purity of breath, there is a conceptual similarity between the marks at issue. The fact that the word “pure” is descriptive of the characteristics of the goods in question does not alter the conceptual content of those marks. For consumers who do not understand the word ‘pure’, the conceptual comparison is neutral (Paras. 90-94). In the global assessment of the likelihood of confusion, the GC found that the goods covered by the signs at issue are intended for the general public and can be bought in, inter alia, supermarkets, specialised points of sale, such as kiosks, or service stations. As a general rule, those shops operate on a self-service basis. Even if the goods at issue may be purchased orally, visual perception of the marks at issue will take place before the actual purchase. Therefore, the visual similarity of the signs at issue carries more weight than their phonetic similarity in the assessment of overall similarity (Para. 106). In relation to those consumers who do not

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understand the word 'pure', the GC found that the overall impressions created by the marks at issue are, despite the similarities identified, sufficiently different to justify the conclusion that there is no likelihood of confusion for consumers who do not understand the word "pure". For those consumers who do understand that word, any likelihood of confusion must also a fortiori be ruled out, since, first, those consumers will attribute even less importance to the element "pure", which to them is merely descriptive, and, second, the impact of the identified conceptual similarity on the overall impression created by the marks at issue is very low and is thus not decisive for the purposes of the global assessment of the likelihood of confusion (Paras. 107, 108). Accordingly, the BoA was right to conclude that there was no likelihood of confusion between the marks at issue, even if it committed two errors, first, in concluding that there was no visual similarity between those marks and, second, in taking the view that the conceptual similarity of those marks resulting from the presence of the word element "pure" was not relevant for the purposes of the conceptual comparison. However, those errors had no bearing on the result of the assessment which it carried out (Para. 109).

Earlier CTMR No 6 771 869 **PURE WHITE** - For the part of the relevant public that does not understand either "pure" or "white", each of those elements is of average distinctiveness. From a visual perspective, they have the same weight in the earlier mark on account of their very similar size and similar graphic

representation. While it is true that the element "pure" appears at the beginning of the mark, the element 'white' is nevertheless emphasised by virtue of the small star featuring at the bottom left of the capital letter 'W', a factor which, to a certain extent, focuses attention on that element and mitigates the fact that the element 'white' is placed below the element "pure". Since, for those consumers, the element 'trident' in the mark applied for is of greater importance than the element 'pure', it must be held as the Board correctly did, that there is a low degree of visual similarity between those marks. From a phonetic perspective, those consumers will attribute more value to the beginning of each of the marks at issue. In addition, the dissimilarity between the elements "trident" and "white" lessens the similarity associated with the common element 'pure'. Therefore, for those consumers the similarity of the marks is, at most, average. The conceptual comparison remains neutral (Paras. 113-115). For those consumers who understand the words "pure" or "white", those elements are descriptive. Therefore, although they have to be taken into account for the purposes of the comparison, those consumers will attribute more attention to the graphic representation and the degree of similarity for that category of consumers is lower than for those who do not understand those words. Therefore, the degree of phonetic similarity is merely very low. Conceptually, there is a certain degree of similarity between the marks, also for those consumers who understand the word "pure",

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but not the word “white” (Paras. 116-119). In the global assessment, the GC found that, taking into account the fact that, first, consumers pay more attention to the beginnings of marks than to their ends and that, second, visual appearance plays a more important role than phonetic appearance, the BoA was correct to exclude, also for CTM No 6771869, all likelihood of confusion for all groups of consumers (Paras. 120-121). The GC confirmed that a likelihood of confusion in relation to the remaining earlier marks is excluded, given that the similarities between those marks and the CTMA are even less evident than in the context of the other marks examined.

Case T-751/14; Hikari Miso Co. Ltd v OHIM; Judgment of 11 December 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Similarity of the goods and services, Nature of goods and services, Complementary goods and services, Proof of use

FACTS: The Board of Appeal (BoA) annulled Opposition Division which had found no likelihood of confusion on the basis that earlier Class 29 “rice” and contested Class 29 “Instant or pre-cooked miso soup” and Class 30 “Miso (soya bean paste [condiment]” were dissimilar. The BoA found a low degree of similarity between the goods.

CTMA
HIKARI
Earlier mark
HIKARI

SUBSTANCE: The General Court (GC) upheld the BoA’s finding that the goods in question were similar. In doing so it confirmed that the degree of similarity of the goods is a matter of law which must be assessed ex officio by the Office even if the parties do not comment on it.

There are clear links between the goods in question, since they are both food products, they may have the same distribution channels, they may, in some circumstances, be available close to each other in supermarkets, and they both form part of Japanese cuisine — miso and miso soups as Japanese specialities and rice as a basic element of Japanese cuisine. Those factors constitute a similarity between the goods in question. It should be added, moreover, that those goods are also complementary, since a Japanese meal including miso soup is likely to include rice also (Para. 48).

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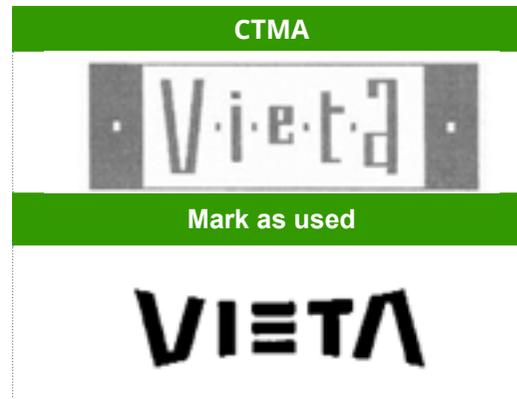
The GC stressed that the proof of use of a mark for some categories of goods, on the one hand, and the analysis of the similarities of goods in the context of opposition proceedings, on the other, are two different issues, which give rise to different challenges and are based on analysis criteria specific to each issue. It cannot therefore be maintained that the goods in question in the present case are not similar because the use of the earlier Community trade mark for one of those goods was not found to constitute use of that mark for the other (Para.50).

Case T-690/14; Sony Computer v OHIM; Judgment of 10 December 2015; Language of the case: EN

RESULT: Action partially upheld (BoA decision partially annulled)

KEYWORDS: Proof of use, Figurative trade mark, Figurative element, Distinctive element

FACTS: Revocation request for lack of use pursuant to Article 51 (1) (a) CTMR. The Board of Appeal (BoA) found that the contested mark had been put to genuine use in relation to “loudspeakers, loudspeaker systems, sound amplifiers” and “computers, video screens, apparatus for the reproduction of sound and images, television sets and record players” in Class 9.



SUBSTANCE: With regard to the alleged infringement of Article 15 (1) CTMR, point (a) of the second subparagraph, the General Court (GC) confirms that the distinctive character of the contested mark is essentially derived from its word element “VIETA”, not from its figurative elements (Para. 47). The word “VIETA” has a high level of distinctive character and occupies an important position in the overall impression created by the contested mark, as registered, whilst the figurative elements occupy merely an ancillary position and have a relatively marginal visual impact (Para. 48).

As a consequence, the contested mark has been used in a form that does not alter its distinctive character. However, the confirmation by the BoA that the earlier mark had been used for “apparatus for reproduction of sound and images”

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should be annulled because such category is not defined sufficiently “precisely and narrowly”. On the one hand, it includes equipment for which the Cancellation Division found that proof of genuine use had not been provided, such as “video cameras or photographic apparatus”. On the other hand, such expression can, at the very least, be subdivided into two subcategories: “apparatus for the reproduction of sound” and “apparatus for the reproduction of images”.

The contested decision is partially annulled in so far as it found that genuine use of the contested mark had been proved for “apparatus for the reproduction of sound and images”.

Case T-62/14; BR IP Holder LLC v OHIM; Judgment of 21 January 2016; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Passing off, Non-registered trade mark, Lack of reasoning, Sign of mere local significance, Sign used in the course of trade

FACTS: The CTM applicant sought to register the word mark **HOKEY POKEY** as a CTM for “Confectionery” in Class 30. The opposition was based on the unregistered earlier word mark **HOKEY POKEY**, used in the United Kingdom since 1997 for “Confectionery, namely ice cream”. The Opposition Division (OD) dismissed the opposition. The Board of Appeal (BoA) dismissed

the appeal. The opponent filed an application before the General Court (GC) for the annulment of the BoA’s decision.

CTMA

HOKEY POKEY

Earlier mark

HOKEY POKEY

SUBSTANCE: The GC decided to examine of its own motion the issue of the BoA compliance with its obligation to state reasons, provided for in Article 75 CTMR and adopted a measure of organisation of procedure by which it asked the parties to express their views on the matter in writing (Para. 33). The GC came to the conclusion that the BoA did not state in a sufficiently clear manner whether it was in the light of the criteria laid down in national law that it was assessing the fourth condition provided for in Article 8 (4) CTMR, even less which national law was the source of the criteria in the light of which it made that assessment. In those circumstances, the GC is unable to verify the accuracy of the BoA’s reasoning and carry out its review of the lawfulness of the contested decision (Paras. 34-37). This conclusion is supported by the fact that the

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contested decision contains inconsistencies: the BoA stated explicitly that the evidence adduced by the opponent applicant was insufficient to prove use of the sign in the course of trade of more than mere local significance. An assessment such as that comes within the scope of the first and second conditions provided for in Article 8 (4) CTMR, which fall to be interpreted in the light of EU law, and not the fourth condition, which falls to be assessed in the light of the criteria laid down in the law governing the sign relied on. Moreover, the BoA also alluded to the first and second conditions provided for in Article 8 (4) CTMR, concluding that the evidence adduced by the opponent was not sufficient to prove use of the sign in question in the course of trade of more than mere local significance, after having referred, in the same paragraph, to “damage”, which may be construed as a reference to the fourth condition and, thus, to an assessment under the applicable national law, which makes it even more difficult to understand the reasoning in the contested decision (Paras. 28-39).

Case T-846/14; Spokey sp. z o.o. v OHIM; Judgment of 21 January 2016; Language of the case: PL

RESULT: Action dismissed

KEYWORDS: Admissibility, Figurative trade mark, Identity of the goods and services, Likelihood of confusion, Request for proof of use

FACTS: The registered CTM represented below was challenged by the owner of the earlier CTM **SPOOKY** (word mark). The Cancellation Division declared the contested CTM partially invalid, finding that there was a likelihood of confusion as regards the goods in Class 18. The Board of Appeal (BoA) confirmed this decision.

The applicant filed an action before the General Court (GC). It claimed infringement of Article 75 and 76 CTMR and of Article 8 (1) (b) CTMR.

CTMA



Earlier mark

SPOOKY

SUBSTANCE: As regards the applicant’s claim that the reasoning of the contested decision is contradictory in that BoA considered that the relevant territory is the European Union and then focused on the English-speaking public, GC referred to the unitary character of the CTM and recalled that the mark has to be invalidated even if the likelihood of confusion exists in one part of the European Union only (Para. 19).

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As regards the applicant's argument that BoA was wrong to disregard the evidence relating to its distribution methods and actual use of the mark on the goods, GC recalled that the assessment of the likelihood of confusion is a legal question (Para. 26) and that the comparison of goods has to be made by reference to the goods for which the conflicting marks are registered (unless proof of use is at stake, duly requested before the first instance, Para. 27). Here, the BoA was right to find the request for proof of use inadmissible and to compare the goods as on the register (Para. 28). BoA was also right to disregard the evidence relating to the actual use of the contested mark (Para. 29).

GC also dismissed the applicant's arguments as to the alleged higher degree of attention of consumers in relation to the goods in Class 18. Even if some of these goods can indeed be purchases in specialised shop, they are all also available in supermarkets or commercial centres. Admittedly, some of the goods (in particular alpine bag packs or baby-carriers) often are bought for more than just one season but the level of attention of the relevant public will be that of reasonable, at most slightly higher, certainly not comparable to the level exercised in relation to cars or financial services (Para. 43). GC also confirmed the BoA's finding of identity of the conflicting goods in Class 18, again stressing that the comparison has to refer to the list of goods as registered and not to the actual goods for which the marks are used (Para. 48).

As regards the comparison between the marks, GC also confirmed BoA reasoning in all aspects. GC stated that although the earlier mark has a meaning in English, the conceptual comparison is not possible as the contested mark is meaningless (Para. 63). GC confirmed that there was a likelihood of confusion between the marks.

Case T-663/14; International Gaming Projects Ltd v OHIM; Judgment of 14 January 2016; Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Descriptive element, Minimum degree of distinctiveness

FACTS: The CTM applicant sought to register the figurative sign below for goods in Classes 9, 28 and 41. The examiner rejected the application for almost all of the goods and services. The First Board of Appeal (BoA) dismissed the appeal.

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

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CTMA



SUBSTANCE: The BoA correctly held that the public targeted by the contested mark consists of the general European public and of professionals, and that the public to be considered when analysing the descriptive character of the sign is the English-speaking European public (para. 21)

In light of the GC's case law (T-564/08), the word element 'bingo' is descriptive of all the goods and services at issue, as it refers to the bingo-type game of chance that consumers can play thanks to the contested goods or thanks to the contested services (para. 23). The term 'big' can refer to the dimensions of the game, of the apparatus or game machines or even the game rooms where the contested services are provided, to the prizes that can be won with this game or also to the many participants, in particular with respect to bingo games that can be played on-line thanks to a software that allows access to them. The BoA therefore correctly found that the term 'big' was descriptive (para. 28). The combination of the two terms is not an unusual or arbitrary combination of words whose meaning differs from

the mere sum of its elements: the expression 'big bingo' should therefore be considered descriptive (Para. 30).

The graphic elements are purely ornamental and decorative; they only channel the consumer's attention to the words 'big bingo' and to the information it conveys. Moreover, it is common in the game of chance sector to resort to a letter stylisation made by bright colors and giving the impression of being animated, often with contours and reliefs that produce three-dimensional effects similar to those of the sign (Paras 43-44).

The CTM applicant cannot successfully claim that the expression 'big bingo' is not commonly used in the game of chance sector, as according to the case law, for a sign to be descriptive it is sufficient that the signs and indications that compose the sign could be used to describe the contested goods and services (Para. 54). The trade mark is therefore descriptive and there is no need to rule on the distinctiveness of the signs (Para. 58). The action is therefore dismissed in its entirety (Para. 59).

Case T-541/14; Antica Azienda Agricola Vitivinicola Dei Conti Leone De Castris Srl v OHIM; Judgment of 2 February 2016; Language of the case: EN

RESULT: Action dismissed

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KEYWORDS: Distinctive element, Dominant element, Figurative element, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Similarity of the signs, Visual similarity, Weak element

FACTS: The applicant sought to register the figurative mark represented below as a CTM for “wines” in Class 33. An opposition based on the earlier word mark **CASTILLO DE LIRIA**, registered inter alia for “wine” in Class 33, was filed on the grounds of Article 8 (1) (b) CTMR.

The Opposition Division dismissed the opposition. The Board of Appeal (BoA) upheld opponent’s appeal. It found that it was necessary to attach particular weight to the phonetic aspect, and considering that the elements other than “illiria” and “liria” had a lower distinctive character, there was a likelihood of confusion between the signs at issue in view of the identical goods. The applicant filed an action before the General Court (GC).

Earlier mark

CASTILLO DE LIRIA

SUBSTANCE: The GC dismissed the appeal. It found that the relevant territory is the entire Union and that the relevant public consist of the average consumer. The goods at issue are identical (not disputed). As regards the element “castillo de” of the earlier mark, this element is generic and of weak distinctive character. In addition, the figurative element of the CTMA is simple. Thus the GC found that the elements “liria” and “illiria” are the dominant (and distinctive) elements of the marks. The marks are visually similar to a low and phonetically similar to a medium degree. As regards the conceptual comparison the GC ruled that a substantial number of EU consumers would not associate the elements “illiria” and “liria” with a particular concept. The conceptual comparison therefore remains neutral. Considering that for “wines” particular importance has to be attached to the phonetic aspect, that the expression “castillo de” was of low distinctive character, while “liria” has no meaning for parts of the relevant public, taking into account the degree of similarity of “illiria” and “liria” and the fact that the other elements of the signs have a less distinctive character, the GC confirmed the existence of a likelihood of confusion.

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Case T-485/14 Bon Net OOD v OHIM; Judgment of 2 February 2016; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Figurative trademark, Figurative element, Likelihood of confusion, Visual dissimilarity, Phonetic similarity, Conceptual similarity, Similarity of signs, Dominant element, Weak element, Descriptive element

FACTS: The applicant sought to register the figurative mark, shown below, for various foodstuff products in Class 29. The opponent based an opposition on Article 8 (1) (b) CTMR, directed against said goods, relying inter alia on the earlier figurative Bulgarian mark represented below, registered for goods partially contained in the CTMA's specification. The Opposition Division rejected the opposition because it found that there is no likelihood of confusion between the CTMA and earlier marks. The Board of Appeal (BoA) dismissed the appeal. The opponent filed an action before the General Court (GC).

Earlier mark



SUBSTANCE: The relevant public consists of average consumers in Bulgaria, paying an average attention (Para. 26). For the conflicting goods, the BoA was entitled to assume their identity for the purpose of the following assessment. The services "accommodation for guests" of one of the earlier marks are dissimilar to the foodstuff products in Class 29 since they neither substitute nor complement one another (Paras. 29-30). The BoA did not commit an error in holding that the conflicting signs' word elements have at most a low degree of distinctiveness. The expression "Bon Appétit" is commonly known amongst Bulgarian consumers, meaning "enjoy your meal". The earlier mark's word element has the same meaning. Both evoke the comforting feeling which precedes a good meal. Therefore, these word elements will immediately be perceived as descriptive (Paras. 43-44). The applicant cannot challenge this finding of the BoA which did not hold the signs to lack registrability. In the assessment, it must be distinguished between the earlier mark's distinctiveness and the distinctive character of the sign's element when determining

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its overall impression (Paras. 48-49). The word elements are not dominant. The figurative elements, in particular form, size and colour clearly contribute towards the signs' overall impression and hence the word elements will not distract the public's attention (Paras. 52-55). Visually, the signs are different (Paras. 56-69). Aurally, they are pronounced identically (Para. 61). The conceptual similarity is based on the signs' word elements (Para. 63). In the overall assessment, the signs are visually clearly different. The signs are aurally and conceptually similar but the visual perception is more important for the goods at hand since they are selected in self-service stores based on their display (Paras. 67, 71-72).

Given the descriptive meaning of "Bon Appétit" and "Bon Apet" and the sufficiently striking figurative elements, the BoA was right to conclude that the word element cannot have a decisive bearing in the overall assessment (Para. 73). Therefore, there is no likelihood of confusion.

Case T-210/14; Mederer GmbH v OHIM; Judgment of 26 February 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Conceptual similarity; Descriptive element; Distinctive element; Identity of the goods and services; Likelihood of confusion; Relevant territory; Similarity of the signs

FACTS: The applicant sought to register the figurative mark represented below as a CTM for goods within Class 30: mainly "confectionary". An opposition based on the earlier national Spanish figurative mark represented below, registered for goods in Class 30: "confectionary", was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division upheld the oppositions. The Board of Appeal dismissed the applicant's appeal. It found that the earlier sign had no meaning in Spain and considering the similarities of the signs and identity of goods that there is a likelihood of confusion. The applicant filed an action before the General Court (GC).

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Earlier mark

GUMMY

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SUBSTANCE: The GC found that the relevant territory is Spain and that the goods are directed at the general public. The goods are identical. The signs are visually similar to a low degree and phonetically similar. From a conceptual point of view the GC concluded that in general the knowledge of the English language is low for the relevant Spanish public. "Gummy" is not a basic English term and won't be understood by the Spanish public and thus perceived to be a fanciful term. The signs are therefore not conceptually similar. It doesn't matter that the Spanish youth may have a better command of English, as the goods "confectionary" are aimed at all consumers. The earlier right is neither devoid of distinctive character nor descriptive. Even if the relevant public, when purchasing the goods at issue, perceived the signs at issue visually, the fact remains that, in the light of the identity of goods and the consumers' low level of attentiveness, the low degree of visual similarity between the signs at issue is not capable of excluding the existence of a likelihood of confusion between those signs.

Case T-842/14; Airpressure Bodyforming v OHIM; Judgment of 05 February 2016; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive element

FACTS: The applicant sought to register the word

mark **SLIM LEGS BY AIRPRESSURE BODYFORMING** as a CTM for goods and services in Classes 28, 35 and 41. The examiner refused the application in its entirety, based on Article 7 (1) (b) and (c) CTMR. The Board of Appeal (BoA) dismissed the appeal on account of Article 7 (1) (b) and (c) and stated that the CTMA lacked distinctiveness due to its descriptive character. The CTM applicant filed an action before the General Court (GC), claiming a violation of Article 7 (1) (b) and (c) CTMR.

CTMA

SLIM LEGS BY AIRPRESSURE BODYFORMING

SUBSTANCE: The GC confirmed that the goods and services in question are addressed to general consumers as well as to a specialized public. As the BoA referred explicitly to the assessment of the examiner, there is no lack of reasoning in the decision of the BoA. Even if the combination "airpressure" should be seen as a new word as it is written without hyphen, according to settled case law the meaning of the word doesn't change (Para. 27). The word element "bodyforming" will also be recognized as an equivalent of the word "bodyshaping". The fact that

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the word as such is not listed in the dictionary does not mean that the term is able to distinguish the goods and services from those of another company (Para. 28).

Even if the “airpressure” and “bodyforming” would be grammatically or linguistically wrong and considered as new terms, both terms would be understood by the relevant public together with the word elements “slim legs by”. As such, the trade mark is not considered as an unusual combination of words (Para. 30). The BoA found that the trade mark describes equipment, clothing etc. that is used to slimmer the legs by using air-pressure. Thus, also in relation to the services applied for it would be understood that the specialist public provides the services using equipment and devices as well as clothing with air-pressure technology.

The GC confirms the statement of the BoA that the term is descriptive for all the goods and services applied for as the relevant public would directly associate the goods and services with the meaning of the term.

Based on the foregoing, the action was dismissed.

Case T-761/14 Consolidated Artists BV v OHIM; Judgment of 23 February 2016; Language of the case: FR

RESULT: Action dismissed

KEYWORDS: Burden of proof, Catalogue, Database printout, Distinctiveness acquired by use, Evidence of use

FACTS: The Cancellation Division (CD) rejected a declaration of invalidity based on Article 52 (1) (a) CTMR in conjunction with Article 7 (1) (b) and (c) CTMR against the registration of the figurative mark “MANGO” for “soaps; perfumery, essential oils, cosmetics” in Class 3. The Second Board (BoA) (12/03/2012, R 471/2011 2) annulled the decision and remitted the case to the cancellation division to examine the claim of acquired distinctiveness under Article 7 (3) CTMR.

The CD found that acquired distinctiveness (territory: EU-15 except France, Greece and Portugal) was not proven and declared the CTM invalid for the contested goods.

The Fourth BoA dismissed the CTM proprietor’s appeal. The BoA found that there was no sufficient proof of acquired distinctiveness, at the time of filing and after registration, with regard to the goods in Class 3 for which “Mango” is descriptive.

The CTM proprietor filed an action before the General Court (GC). The CTM proprietor argued before the GC that the evidence filed was sufficient. The CTM proprietor, relying on T-405/05 “Manpower”, also

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argued that there was a “transfer of distinctiveness” of the mark reputed for clothing to perfumery.

CTMA

MANGO

SUBSTANCE: ARTICLE 7 (3) CTMR: The GC recalls that the evidence of acquired distinctiveness through use had to be submitted for the goods specified in Class 3. Since the rejected goods in Class 3 and those in Class 25 are not similar and not complementary, the CTM proprietor could not allege that the acquired distinctiveness through use for those goods could have had an impact on the perception of the mark by the relevant public for the relevant goods belonging to Class 3 (Paras. 26 and 31). The pieces of evidence [extracts from catalogues and one article] do not present sufficient concrete and objective indications in order to determine the relevant public’s perception (Para. 27). They refer to 2 Member states (Germany and the Netherlands) only and therefore do not cover a substantial part of the EU (Para. 33). The judgment T-405/05 “Manpower” is not applicable to the present case. The acquired distinctiveness through use of the mark MANPOWER for temporary personnel services, for which it was found descriptive, was extended to some goods and services in Classes 9,

16, 41 and 42 as they were used in the performance of the temporary personnel services (Paras. 34-35). Allowing the extension of the well-known character of the mark ‘MANGO’ for the Class 25 goods to those belonging to Class 3 would overcome the dispositions of Article 7 (3) CTMR. There is no reason to extend the well-known character from one class to another (Para. 36).

ARTICLE 52 (2) CTMR: The GC confirms that the evidence allows to admit the existence on the market of the products in Germany, Spain and the United Kingdom, as well as a promotional investment, but in view of the lack of precise information and concrete indications, they do not allow to determine that the mark acquired distinctiveness through use after registration, for the goods for which it is registered (Para. 46).

Case T-538/14; Peri GmbH v OHIM; Judgment of 1 March 2016; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive element

FACTS: The applicant sought to register the word mark Multiprop for various goods and services in Classes 6, 19 and 37, all related to “props”. The examiner refused this CTMA under Article 7 (1) (b) and (c) CTMR. The Board of Appeal (BoA) dismissed the appeal holding that “Multiprop” designates

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props which carry many times more. The General Court confirmed the BoA decision.

CTM

Multiprop

SUBSTANCE: INFRINGEMENT OF ARTICLE 7 (1) (c) CTMR: The BoA erred in holding that “Multiprop” designates props which carry many times more and which are therefore particularly solid. A prop supports only one ceiling and for the relevant public, namely professionals of the building sector, the supporting capacity is indicated by precise measurement units such as newton rather than the vague indication of many times more (Para. 41). However, the BoA alternatively referred to the examiner’s reasoning who stated that “Multiprop” designates multifunctional props. This reasoning holds true as the props may be adaptable in relation to all types of ceilings as regards their height, weight or material. The English prefix “Multi” in combination with the indication of an object indicates the versatility of that object (Paras. 42-44). Therefore, “Multiprop” designates characteristics of the goods and services within the meaning of Article 7 (1) (c) CTMR (Para. 48).

INFRINGEMENT OF ARTICLE 7 (1) (b) CTMR: Due to its descriptiveness the CTMA also lacks the required distinctive character (Para. 54).

Case T-318/15; Zitro IP Sàrl v OHIM; Judgment of 14 January 2016; Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Descriptive element, Minimum degree of distinctiveness

FACTS: The CTM applicant sought to register the figurative sign below for goods in Classes 9, 28 and 41. The examiner rejected the application. The First Board of Appeal (BoA) dismissed the appeal. The CTM applicant filed an application before the General Court (GC) for the annulment of the decision of the BoA.

CTMA

SUBSTANCE: The goods and services at issue can be related to games of chance as they are machines, apparatus and facilities that can be used in order

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to play these games. They are in fact goods that can be used as support for games (Class 9), games themselves (Class 28) and services related to them (Class 41) (Para. 22).

The relevant public is composed of average consumers and professional consumers (para. 22). The analysis of the absolute grounds should be made with respect to the English speaking consumers of the EU (Para. 24)

Consumers will perceive the expression “triple bonus” as indicating that the goods and services for which registration is sought allow the tripling of the winnings usually gained at the equivalent game of chances. The term “bonus” will be understood by the relevant public, particularly the English-speaking one, as extra winnings. Hence “triple bonus” describes in an unequivocal and direct way one of the characteristics of the goods and services at issue. Even if the expression were to be interpreted as a promise or guarantee of triple winnings, it would still be promotional and, as such, descriptive of the objective of the goods and services or of the desire of the consumers to obtain high winnings. (Paras. 27-29).

The slightly stylized letters in white colour with a black, blue and yellow border, disposed on two lines, will be perceived, because of their simplicity, as merely decorative elements of the sign, simply highlighting and strengthening on the descriptive

character of the expression. They are not important enough to make to relevant public make an effort to perceive the link between the word elements and the goods and services (Paras. 30-32).

The trade mark being descriptive, there is no need to rule on the distinctiveness of the signs (Para. 36).

The action is therefore dismissed in its entirety (Para. 37).

Case T-75/15; Rod Leichtmetallräder GmbH v OHIM; Judgment of 21 January 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Complex mark, Distinctive element, Figurative element, Infringement, Likelihood of confusion, Phonetic similarity, Relevant territory, Retail services, Similarity of the signs, Visual similarity

FACTS: The CTM proprietor was granted the figurative mark represented below as a CTM for goods and services in Classes 3, 12, 35 and 37. The application for invalidity was upheld for all goods and services but those in Class 3 based on an earlier Spanish mark. The Board of Appeal (BoA) dismissed the CTM proprietor's appeal. The CTM proprietor filed an action before the General Court (GC) based on two pleas in law.

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SUBSTANCE: INFRINGEMENT OF ARTICLE 8 (1) (b) CTMR: The GC confirmed the BoA finding that retail services of trading in “motor vehicle rims and motor vehicle accessories, except chains” applied for in Class 35 had an average level of similarity to the “accessories and spare parts of vehicles” in Class 12 covered by the earlier mark (not a low degree of similarity as found by the Cancellation Division in line with the Guidelines). The BoA found that since the goods at issue could be sold and retailed by the producers themselves, the connection between the goods and services at issue could not be regarded as low (Para. 22). A figurative detail animating the letter “O” of the word “RODI” will be perceived as a mere decoration and not as a dominant element of the earlier mark (Para. 32). The circular shape in the contested mark is likely to evoke the shape of

a tyre which accentuates the visual resemblance (Para. 34). The elements that differentiate the marks, considered as a whole, do not outweigh the common element “rod” (Para. 43). It is unlikely that the earlier mark will be pronounced letter by letter since the simplest and shortest possible pronunciation in Spanish is of the whole word (Para. 48). In Spanish, when a word ends with a vowel, as in “rodi”, the stress is on the penultimate syllable, that is, in the present case, on the sequence of letters “ro” (Para. 50). The marks have the stress on the same syllable, namely that involving the vowel “O”. The earlier mark will neither be perceived as the English term “roadie” nor as a Catalan term “roda”, meaning “wheels” (Paras. 54 and 55). Conceptual comparison could not be made (Para. 57). Due to an average degree of similarity between the marks at issue and given that the earlier Spanish trade mark had a normal distinctive character the BoA was fully entitled to conclude that there was a likelihood of confusion (Paras. 63 and 66).

INFRINGEMENT OF ESSENTIAL PROCEDURAL REQUIREMENTS: Contrary to what the applicant before the GC claimed, the application for a declaration of invalidity was admissible since at the date of filing it contained a colour reproduction of the earlier Spanish trade mark and that colour copy was also present in the observations filed by the invalidity applicant. There was therefore no infringement of essential procedural requirements (Para. 74). Even if the Office had not forwarded the

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applicant the colour copy of the earlier Spanish trade mark, it is apparent from the certificate of registration of the earlier Spanish trade mark, which certificate was annexed to the application for a declaration of invalidity and sent to the applicant in connection with that application, that the colours of the earlier Spanish trade mark were expressly described therein as follows: “blue pantone RAL, 5002, yellow pantone, RAL, 1016, white”. Accordingly, the applicant cannot claim that it did not know that the earlier Spanish trade mark included colours (Para. 75).

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R2897/2014-5



BOSQUE VERDE (fig.) / VINHO VERDE et al. – EN

KEYWORDS: Figurative element, Figurative trade mark, Geographical origin, Likelihood of confusion, Proof of use, Substantiation of earlier right, Suspension of the proceedings, Article 8(4) CTMR, Article 8(5) CTMR, Article 42(2) CTMR, Article 42(3) CTMR, Article 64(1) CTMR, Rule 22 CTMIR, Rule 22(3) CTMIR.

FACTS: The applicant sought to register the figurative mark 'BOSQUE VERDE', as represented below, for goods and services in Classes 10, 18, 22, 25, 28, 29, 30, 32, 33, 34, 35 and 39.

The opponent filed an opposition against all the goods and services based on Article 8(1)(b), 8(4) and 8(5) CTMR. The opponent invoked the earlier rights below. The Opposition Division rejected the

opposition and allowed the mark to proceed to registration.

SUBSTANCE: Regarding the proof of use in relation to Article 8(1)(b) and 8(5) CTMR invoked, in the Board's view the Opposition Division correctly concluded that the evidence showed use of the sign only as a designation of origin but not as a trade mark and, consequently, that the opponent had not provided sufficient indications concerning the earlier marks' nature of use (§ 35-36).

As regards the opposition based on Article 8(4) CTMR, the Board confirmed that the Opposition Division's approach was correct as the evidence was filed belatedly (more than eight months after the notice of opposition was filed) and within the framework of a trade mark's proof of use request and not proof of use of the EU DPO (§ 47 and 52). Under the ground of Article 8(4) CTMR, the opponent also claimed a series of protected national designations of origin.

The Board relied on the judgment PORT CHARLOTTE (18/11/2015, [T-659/14](#), PORT CHARLOTTE, EU:T:2015:863, § 61-62, an appeal case before the Court of Justice C-56/16 P) and considered that these earlier rights could also have been examined. However, as for the national PDOs the opponent did not substantiate any of these other earlier rights.

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Therefore, the Opposition Division could not have assessed them in the course of the opposition proceedings (§ 59). Consequently, the appeal was dismissed and the opposition rejected.

R0466/2015-1 
ideel (fig.) – EN

RESULT: Decision annulled

KEYWORDS: Figurative trade mark, **Legal certainty**, Reimbursement, **Substantial procedural violation**, Rule 2(2) CTMIR, Rule 20(7) CTMIR

FACTS: The applicant sought to register a figurative mark for services in Class 35. The denomination of the services did not entirely comply with Rule 2(2) CTMIR, therefore the Office invited the applicant to modify the list. In a first decision, an examiner rejected the application in its entirety under Article 7(1)(b), 7(1)(c) and 7(2) CTMIR (see appeal under [R 298/2015-1](#)). The next month, in a second decision, another examiner partially rejected the application because the applicant had not amended the specification of services as required.

SUBSTANCE: Case R 466/2015-1 dealt with the

appeal against the second decision. It was well founded, as an application that had already been rejected could not be rejected a second time (§ 12). The examiner could not partially reject a list of services as regards a trade mark application which had already been rejected in its entirety. It was certain that it would have been more appropriate to clarify the services applied for before the examination of absolute grounds took place (§ 15-16).

Consequently, the appeal was upheld and the contested decision was declared null and void. In addition, due to the substantial procedural violation the Office had to reimburse the applicant the appeal fee.

R1253/2015-5


bonus & more (fig.)


/ bonus net (fig.) – EN

RESULT: Decision annulled

KEYWORDS: Common element, Conceptual similarity, Dominant element, Figurative element, Figurative trademark, Identity of goods and services, **Likelihood of confusion**, **Nature of**

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goods and services, Phonetic similarity, Purpose of goods and services, Similarity of the goods and services, **Specialised public**, Visual similarity, Article 8(1)(b) CTMR

FACTS: The applicant sought to register the figurative mark 'bonus & more', as represented below, for goods and services in Classes 35, 36, 38, 41 and 42. The opponent filed an opposition against part of the goods and services, namely in Classes 35, 36 and 42. The opposition was based on Article 8(1)(b) CTMR and the opponent invoked the earlier right reproduced below. The Opposition Division upheld the opposition for part of the contested services in Classes 35, 36 and 42 and partially rejected the CTM applied for. The applicant appealed against this decision to the extent that the opposition was upheld. The appeal was upheld by the Fourth Board on 12 November 2012 (in case [R 1890/2011-4](#)) and the opposition was rejected in its entirety. The General Court annulled the Board's decision (05/02/2015, [T-33/13](#), bonus & more, EU:T:2015:77). The case was remitted to the Fifth Board under R 1253/2015-5.

SUBSTANCE: In the present case, the level of attentiveness of the consumers involved had to be considered high. The identical and similar services could not be compared to cheap goods bought for everyday consumption. Most of the compared services were aimed at business professionals

with a presumed high attention level and some financial, real estate, insurance and IT services concerned the highly attentive members of the general public, interested in these services. The careful selection of expensive services (which might result in a long-term contract, or affect expensive technology) left little, if any, room for the 'imperfect recollection' of a certain earlier mark. Even if the services were offered over the telephone, the differences between the second words of the signs would be clearly perceptible and understandable. It was reasonable to assume that the purchase would be carried out by professional consumers with a relatively high degree of attentiveness (§ 44). Therefore, the Board concluded that relying on the elevated attention level of the public concerned, even for the identical goods, a likelihood of confusion was excluded, taking into account the lower than average similarity between the marks and the lower than average distinctiveness of the earlier mark (§ 45). Consequently, the appeal was upheld and the opposition rejected in its entirety.



[R3255/2014-2](#)

RABA (fig.) / RABA (fig.) et al. - EN

KEYWORDS: Article 3 CTMR, **Article 5 CTMR**, Article 8 CTMR

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RESULT: Decision annulled

FACTS: The applicant sought to register the figurative mark 'RABA', as represented below, for goods and services in Classes 7 and 42. The opponent filed an opposition against the registration of the published trade mark. During the opposition proceedings, the opponent raised doubts about the applicant's existence and submitted corroborating evidence. The Opposition Division upheld the opposition for part of the contested goods and services and partially rejected the CTM. Nevertheless, the contested decision did not deal with the opponent's argument concerning the applicant's non-existence.

SUBSTANCE: Pursuant to Article 5 CTMR, 'any natural or legal person, including authorities established under public law, may be the proprietor of a Community trade mark'. The applicant's non-existence had to be deemed as an extinction of the applicant's legal personality. Given that the applicant no longer existed and no successor-in-title had claimed any rights to the application since then, the application for the Community trade mark had to be deemed to have ceased to exist or to have been abandoned. Therefore, all proceedings related to this application had to be discontinued (§ 16-18). Accordingly, the appeal proceedings became without purpose and had to be closed.

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and awarding period.

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The list of finalists will be announced on October 15, 2016, through EUIPO's website.

The Awards ceremony will take place in Milan, Italy, on November 30, 2016.

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