

# Alicante News

Up to date information on IP and EUIPO-related matters

Quick Links 

## First Page

---

■ Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

---

## Statistical Highlights

---

■ March 2017

## ETMDN Updates

---

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

---

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

---

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



**Second phase of legislative changes:  
1 October 2017**



The James Nurton Interview  
**Associate Professor Yann Basire**

## First Page

### Second phase of legislative changes: 1 October 2017

On 23 March 2016, the first wave of changes brought about by the entry into force of [Regulation \(EU\) 2015/2424](#) (the Amending Regulation) came into force. However, some parts of the Amending Regulation will only apply from 1 October 2017.

Additionally, the Amending Regulation also provides that the European Commission will pass secondary legislation to further develop its provisions. This will be done by means of two separate acts, a Delegated act and an Implementing act which will both apply from 1 October 2017.

On 1 October, the graphical representation requirement for EUTMs will be removed. From that date, EUTMs can be represented in any appropriate form using generally available technology, as long as the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective. Ahead of the entry into force of this change, the Office will provide users with information on the various media and formats that are considered to comply with the new provision.

On 1 October 2017, a new type of intellectual property right at EU level will be introduced – the EU certification mark. Certification marks already exist in some national systems and are used to allow a certifying institution or organisation to permit

adherents to the certification system to use the mark as a sign that goods or services comply with the certification requirements. A certification mark will cost EU 1 800, or EUR 1 500 if applied for online.

Other changes include: priority claims will have to be filed together with an application, not subsequently; new streamlined and modern procedural rules in oppositions, cancellations and appeals including substantiation online and rules on belated evidence; the possibility of assigning to the proprietor an EUTM registered without justification in the name of an agent; a codification of the existing practice of suspending surrenders of an EUTM that are made while a revocation action is pending.

Horizontal changes include: a single provision on suspensions applicable to all proceedings; new rules on means of communication; simplified translation requirements; rules on how annexes to submissions must be structured; a new time limit for revocation of decisions and entries in the Register; continuation of proceedings will be applicable to deadlines previously excluded (in particular in opposition proceedings) as well as other changes.

On 2 May, the Office will publish its draft Guidelines which take account of the second phase of the legislative changes for comments from users, with a definitive set of Guidelines to be published on 1 October.

## First Page

---

- Second phase of legislative changes: 1 October 2017

James Nurton  
Interviews | Yann Basire

---

## Statistical Highlights

---

- March 2017

## ETMDN Updates

---

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

---

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

---

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

## First Page



The second phase of implementation of Regulation 2015/2424 and secondary legislation is being implemented by the Office in a manner that ensures that any impact on users is minimised. The Office will update [the dedicated web section on the legislative changes](#) to keep users informed ahead of the entry into force.

## First Page

---

- Second phase of legislative changes: 1 October 2017

James Nurton | Yann Basire  
Interviews

---

## Statistical Highlights

---

- March 2017

## ETMDN Updates

---

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

---

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

---

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



## The James Nurton Interview



### Yann Basire, associate professor, University of Haute Alsace, France

What is your background? What interested you about IP and about research/teaching?

I studied law for four years in Caen, in Normandy, and spent one year as an Erasmus student at Trinity College Dublin. I discovered IP law during these years. I had the chance to follow the lectures of



Yann Basire

Professor Jérôme Passa when I was in Caen, who was a brilliant lecturer and probably the best trade mark specialist in France.

After that, I did a postgraduate degree at CEIPI – the Centre for International Intellectual Property Studies in Strasbourg. Then I did a PhD under the direction of Professor Reboul, who was another big influence on me. The thesis took seven years in total, but I changed the topic after three years to study the functions of trade marks. Even if it was hard work and long, it was a great personal experience. And during this period I decided to try to work in the academic field.

#### What do you like about the academic field?

The first thing is the freedom: I do not have clients, I choose my responsibilities, and I choose what I want to develop in my research. The second thing is the contact with the students. You know I believe that the best way to learn is to teach – really! My students are very interested in IP, especially in trade mark law, and many of them want to work in the IP field. Our lectures at CEIPI are in French but we have students from many countries, including examiners from national offices such as Mexico, China and Vietnam.

Why IP? It is difficult to explain. I really fell in love with the matter when I studied it. At the beginning it was copyright law, and after that trade marks. We live in a world where trade marks are so significant.

## First Page

- Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

- March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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



## The James Nurton Interview



It is not only law, it is also marketing. Trade marks are in the centre of our lives and we cannot live without them. And to be honest the fact that IP and more particularly trade mark law is a European and international matter is also important. I did not want to do something which was limited to France. I can't imagine to do law only in France, only in studying the things which happen in France.

### What jobs have you held during your career?

First when I was in CEIPI, I was a research assistant. It was for me the opportunity to discover the functioning of the university at an administrative level. But it was also the occasion to discover what research means in law: write articles, comment on decisions and organise common projects with other universities. I was for example the EIPIN coordinator for the CEIPI.

At the end of my PhD, I qualified as associate-professor (Maitre de conferences) from the CNU and I obtained my first position at the University of Orleans. After two years there, I got a position in the University of Haute Alsace (Mulhouse). I have been here for three years now. In parallel, I am a lecturer at CEIPI, where I teach trade mark law, and also other masters or LLM programmes, for example in Paris and in Skopje in Macedonia. In 2012, for three months I was a researcher in the IIP in Tokyo where I conducted research about the trade mark function in Japan.

### What does your current job involve?

I teach in many areas of law, such as company law, commercial law and contract law. But of course I can teach trade mark law in CEIPI, in Paris and abroad in Skopje for example. In the field of my job I have also decided to create a journal which is online and available in open access: the RFPI. This journal is in French and we try to find authors all around the world to write articles in French.

For the last three years, I have tried to organise every year a conference abroad with French academics and practitioners. I did it in Brazil, Japan and in Colombia. The next conference is planned in May in Abu Dhabi. It is the occasion to share our point of view – the French one – with those of academics and practitioners of the countries where we organise it. I think at a time of globalisation we need to think about IP with a global view.

### What are your main areas of research?

Obviously, my main area of research is trade mark law. I am interested by national trade marks and EU trade marks. For example, I am in charge of the EU trade mark part of the journal Propriétés intellectuelles in France. Therefore, each three months I try to comment on some decision of the General Court or of the EU Court of Justice.

But there is one thing which is important for me: the future of IP law and trade mark law. I worked on the trade mark package and its potential consequences.

## First Page

- Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

- March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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



## The James Nurton Interview



And as I said before, I try to study trade mark law in a global perspective in order to make some proposals or to try to have a better understanding of our system. I really think that we need to learn from other systems. To give just one example: what is the quality function of a trade mark? It exists, but it is not explained – but in Japan, they use it. That's why I think we need to do comparative law.

What IP/trade mark issues do you think are of most importance today?

It is a difficult question. If we speak about IP in general, I think about the harmonisation of copyright in Europe; I think about the new issues as 3D printing, the place of IP in a digital area, the Unitary Patent, etc.

But concerning trade marks, the first issue is the implementation of the trade mark package at the European level, for the EU trade mark, and at a national level. I think about the harmonisation in the new directive: there is a lot of work to do for the national offices which need to create administrative proceedings (for cancellation and revocation of national trade marks).

Brexit is also an earthquake and it will be a big issue in the next few years – for the people who work at the EUIPO, for the question of representation, for the future of the EU trade mark and other issues as the exhaustion, the revocation or the assessment of the reputation. I am working on a paper on the impact of Brexit. For the moment, we need a crystal

ball!

How good a job do you think the courts do in trade mark cases? How could they improve?

As with all academics, one of my missions is to criticise – in a positive way but also in a negative way. And to be honest, sometimes I am disappointed by the decisions.

Today we have so many topics where the case law could be improved: I think about the protection – the over-protection – of trade marks with a weak distinctive character – see the Kompressor decision of the Court of Justice.

Think also about decisions related to trade marks with a reputation. It is today impossible to recognise the prejudice of dilution given the requirements of the Intel decision of 2008. Therefore, we have a provision – the one related to dilution – which is deprived of usefulness.

I believe that we should also rethink the question of the assessment of the risk of confusion. The method, that I understand, seems to me too “mechanical”. It may be an exaggeration but I have a feeling that we could find a risk a confusion in any case that comes up. I think for example of the case Lacoste v Kajman: I always give this example to my students and none of them consider that there is a risk of confusion. But for the General Court it seems on the contrary obvious.

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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



## The James Nurton Interview



What do you think have been the most interesting/important trade mark cases in recent years?

There are about 300 General Court decisions a year, and with so many decisions it is difficult to make a choice!

However, regarding the topic of my dissertation, I would say that the decisions related to the function of trade marks are the most important: the L'Oréal v Bellure, Google Adwords and Interflora cases. These are the decisions that have definitely changed the paradigm: for French lawyers, a trade mark right is a property right, an intellectual property right, but that is not how the case law has developed. And you could enforce easily your right in a case of double identity without having to demonstrate a risk of confusion or other prejudice. That is not the case anymore since the Arsenal case.

In such a case, with the hypothesis of double identity, you need to demonstrate that one of the functions of the trade mark is infringed: I think this is in contradiction of the spirit of the right and of paragraph 11 of the preamble to the Directive (which says that in a case of double identity the protection is absolute). And with the L'Oréal, Google Adwords and Interflora cases, you can also demonstrate another prejudice: the infringement of the advertising function or the investment function. In France, these functions have never been used by the judges.

At the General Court, I think that the Kit Kat case of last December is quite important concerning the question of the territory which must be taken into account in order to assess the extent of the use. For me, the position of the General Court is too strict and contrary to case law of the CJEU: we should think about it as a unitary system, rather than in terms of each member state. The decision demonstrates once again, following the Louis Vuitton pattern case, that it is very hard to get a trade mark for the shape of a product.

There is one more decision of last December (C-654/15) which affirms two important principles: first, the trade mark right is a result of a registration and not of use. It is important. And the second principle, which is a consequence of the first one, is that the likelihood of confusion must be assessed with regard to the goods and services designated in the registration.

It is important to remember that because in France, in some decisions, some judges refused to notice the risk of confusion because the trade mark was not exploited. It is not a good solution. Even if there is a function of a trade mark, the function of guarantee of origin, the most important thing is the registration. And during five years, you can enforce your right even if it is not exploited. The Court of Justice recognised a grace period of five years, and I think that decision is important.

What do you think will be the big issues in

## First Page

- Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

- March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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



## The James Nurton Interview



trade marks in the future?

In terms of case law, I hope that one day we will define the other functions of a trade mark: the quality function, the communication function. I tried to define them in my thesis. I also hope that one day the judges will be more clear concerning the function of trade marks with a reputation.

Sometimes I think it is necessary to resolve a paradox: it seems more and more difficult to register a trade mark (see the 3D signs for example). But on the other hand weak trade marks are very well protected. That is strange!

In general, how do you think trade mark law might evolve in the future?

This is a hard question. You know trade mark law is a living topic, a living matter for a simple reason: we have so many decisions each year and many of them bring something, sometimes only a detail, sometimes something which is more important.

In the last 20 or 30 years, for French academics, trade marks have changed. It was not only an evolution. Consider the question of the distinctiveness under Article 7(1)(b) of the Regulation or 3(1)(b) of the Directive: it did not exist in France. Consider the case law related to the function of a trade mark, or the question of the assessment of the risk of confusion or questions related to trade marks with a reputation. The trade mark paradigm has changed

We had last year the trade mark package. Is it a big change? I don't think so; it is not an earthquake. We have also the removal of the graphic representation requirement. But, to be honest, it will not change very much; I think we still need to wait to see the registrations of scents for example. It is difficult for me to see the interest in these marks. They are registered but then what is the scope of protection?

So the trade mark package was not a big change, just an evolution. And, for the moment I do not see what could happen; therefore, I think the trade mark system will continue to evolve in the same way, between the principles or promoting free competition and protecting consumers' interests.

## First Page

---

- Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

---

## Statistical Highlights

---

- March 2017

## ETMDN Updates

---

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

---

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

---

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

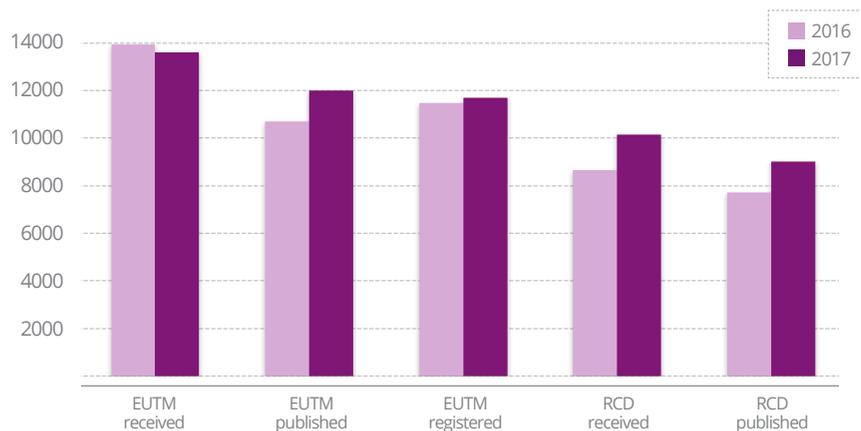


## Statistical Highlights



Monthly statistical highlights February*	2016	2017
European Union Trade Mark applications received	13 935	13 609
European Union Trade Mark applications published	10 701	12 011
European Union Trade Marks registered (certificates issued)	11 472	11 715
Registered Community Designs received	8 651	10 148
Registered Community Designs published	7 706	9 015

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



## First Page

- Second phase of legislative changes: 1 October 2017

James Nurton  
Interviews | Yann Basire

## Statistical Highlights

- March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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



## European Cooperation working groups meet at EUIPO

From 27-31 March, 150 experts from national and regional EU IP offices, along with representatives of IP user associations, the European Patent Office and the World Intellectual Property Office, met at EUIPO for the latest round of working group sessions on European Cooperation projects.

The working groups will review progress made on 11 European Cooperation projects to date, including the newly launched IP User Repository.

## Closure of EU-ASEAN project on the Protection of Intellectual Property Rights

The EU-ASEAN Project on the Protection of Intellectual Property Rights (ECAP III) Phase 2 came to an end on 21 February 2017.

The ECAP project was implemented in the Association of South East Asian Nations (ASEAN) region by EUIPO since 2013, and had a budget of EUR 3.8 million. It aimed to further integrate ASEAN countries in the global economy by strengthening the contribution of intellectual property rights to regional integration and overall economic development.

In view of the project's closure, the final Project Steering Committee took place in Vientiane, LAO PDR on February 17th 2017 to assess results, and focus on future EU-ASEAN cooperation. A successor project, which will also be implemented by EUIPO, will begin later in 2017.

## First Page

---

- Second phase of legislative changes: 1 October 2017

James Nurton | Yann Basire  
Interviews

---

## Statistical Highlights

---

- March 2017

## ETMDN Updates

---

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

---

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

---

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



## More News



### EUIPO at INTA 2017

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

The Office will have its usual Information Booth at INTA (space C1). The EUIPO Information Meeting takes place on Sunday May 21 from 09:00 to 10:30 at Hall 8.0 - B4.

### Case Law Laboratory

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

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

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

The event will be divided into two sessions. At the morning session, topics will be analysed and discussed in four separate interactive working groups

under the guidance of EUIPO staff, accompanied by practitioners and industry professionals with 'hands on' experience.

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

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

### IP Course for Paralegals

As in previous years, the EUIPO will be hosting a new edition of the "IP Course for Paralegals" from 24 to 26 April 2017 in Alicante.

The programme has been especially designed to give participants in-depth knowledge of:

- pre-clearance — how to apply for clean files and avoid formalities and classification objections;
- trade mark and RCD procedures (through practical workshops);
- proceedings before the Office (examination/opposition and post-registration — complete overview).

Participants will also have the opportunity to

## First Page

- Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

- March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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



## More News



broaden their knowledge by selecting from parallel sessions in the following areas:

- practical changes in the EUTM system (Legislative Reform and Guidelines);
- how to become an efficient paralegal;
- cancellation proceedings;
- appeal proceedings;
- the Madrid system;
- update on website and tools.

All presentations will be given in English. Please find programme details and the possibility to register online [here](#).

## First Page

---

- Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

---

## Statistical Highlights

---

- March 2017

## ETMDN Updates

---

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

---

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

---

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

## Case Law



### Luxembourg trade mark and design news

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

**Case T-112/13; Mondelez UK Holdings & Services Ltd v EUIPO; Judgment of 15 December 2016;**

**Language of the case: EN**

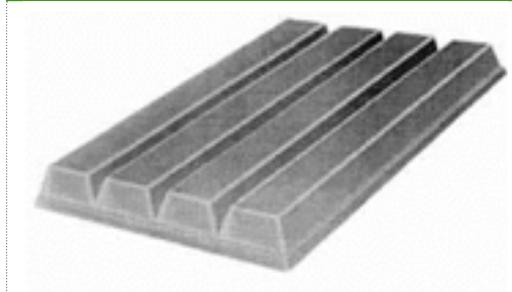
**RESULT: Action upheld (BoA decision annulled)**

**KEYWORDS: Distinctiveness acquired by use, Relevant territory, Evidence of use, Extent of use, Three dimensional mark**

**FACTS:** The applicant sought to register the three-dimensional mark represented below as a EUTM for goods in Class 30. The Cancellation action was upheld by the Cancellation Division on the basis of Article 7(1)(b) EUTMR and the claim regarding the acquisition of distinctive character under Article 52(2) EUTMR in combination with Article 7(3) EUTMR was dismissed. The Board of Appeal (BoA) upheld the appeal and found that the absolute grounds for refusal under Article 7(1)(b) to (d) EUTMR were overcome by the submission of evidence showing that the contested EU trade mark registration had acquired distinctive character in EU (15 Member States (MS)), at the latest on 23 March 2007 (date of lodgement of the request for cancellation). The

BoA had found that the surveys carried out in ten MS, showing spontaneous recognition by the public in proportions varying from 30 % (Finland) to 88 % (UK), established the acquisition of distinctive character not only in the MS concerned (which represented over 80 % of the overall EU population) but also in the EU as a whole. This was corroborated by additional proof that the shape had been used extensively in four other MS, without the BoA taking expressly position on the acquisition of distinctive character in those four Member States.

#### EUTM



**SUBSTANCE: PARTIAL USE.** Drawing an analogy with the case-law relating to partial use in the context of Article 15 EUTMR, the GC found that use of the Kit Kat product was deemed to be used in respect of both categories of 'sweets' and 'biscuits', but not of other autonomous sub-categories of confectionery, such as bakery products, pastries, cakes and waffles (paras. 27-43). **Use in combination with other signs.** The CJ held in 2015 that 'for the purposes of

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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



## Case Law



the registration of the mark itself, the trade mark applicant must prove that that mark alone, as opposed to any other trade mark which may also be present, identifies the particular undertaking from which the goods originate' (Société des Produits Nestlé SA v Cadbury UK Ltd (Shape of a chocolate bar), C-215/14, ECLI:EU:C:2015:604, para. 66). According to the GC, the phrase 'as opposed to any other trade mark' should be construed as meaning 'independently of any other trade mark'. **Proof of market recognition concerned the 'naked' shape of the Kit Kat product.** A spontaneous association in the public's mind with the name of the famous product was therefore no obstacle to the shape alone performing its function of guaranteeing origin (paras 59-63 and 99-103). **Territorial extent of the proof of acquisition of distinctive character.** According to the GC, 'although, as was held by the Court of Justice in the judgment of 24 May 2012, Chocoladefabriken Lindt & Sprüngli v OHIM (C98/11 P, EU:C:2012:307, paragraph 62), there cannot be a requirement that proof of distinctive character acquired through use of that mark be adduced for each individual Member State concerned, such proof may be adduced globally for all the Member States concerned or separately for different Member States or groups of Member States'. The GC goes on to explain that, where 'the evidence submitted does not cover part of the European Union, even a part which is not substantial or consists of only one Member State, it cannot be concluded that distinctive character has been acquired through

use of the mark throughout the European Union' (para 139). The GC noted that the BoA's conclusion regarding the acquisition of distinctive character in the ten Member States concerned by the surveys was correct. However, in the absence of any concrete conclusion on the acquisition of distinctive character in the remaining MS, the BoA erred in law: 'the relevant question is not whether it was shown that a substantial proportion of the public in the European Union, merging all the MS and regions, perceived a mark as an indication of the commercial origin of the goods designated by that mark, but whether, throughout the European Union, it was proved that a significant proportion of the relevant public perceived a mark as an indication of the commercial origin of the goods designated by that mark. A lack of recognition of the sign as an indication of commercial origin in one part of the territory of the European Union cannot be offset by a higher level of awareness in another part of the European Union' (paras 141 – 143). The GC thus annulled the BoA's decision to the extent that it had failed to take expressly position on the acquisition of distinctive character in the four Member States for which no surveys were submitted, but only information concerning the market shares, promotional investments and the length of use (paras. 173-177).

**Case T-622/14; Lauritzen Holding AS v EUIPO; Judgment of 7 March 2017;**

**Language of the case: EN**

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton | Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



**RESULT: Action dismissed**

**KEYWORDS: Likelihood of confusion**

**FACTS:** The Opposition Division partially upheld the opposition based upon Article 8(1)(b) EUTMR. The Board of Appeal (BoA) dismissed the applicant's appeal, finding likelihood of confusion to exist for the non-English-speaking general public in the European Union between the conflicting marks IWEAR and INWEAR for identical and similar goods and services in Classes 18 and 25.

EUTMA	Earlier mark
IWEAR	INWEAR

**SUBSTANCE:** The General Court (GC) fully confirmed the BoA's findings. For the relevant public composed of general consumers within the EU displaying an average degree of attention (para. 21) and including non-English-speaking consumers (para. 29) would, in light of the (uncontested) identity and similarity between the conflicting goods (para. 22), the high similarity of the signs (para. 34), and an average degree of distinctive character of the earlier mark (para. 30) exist a likelihood of confusion between the conflicting

marks (para. 38). In particular, the non-English-speaking public would not break down the signs into elements which have a clear meaning to them (para. 25), not perceive the sign as being composed of different, meaningful elements (para. 30).

**Cases T-828/14 and T-829/14; Antrax It Srl v EUIPO; Judgment of 16 February 2017**

**Language of the case: IT**

**RESULT: Action dismissed**

**KEYWORDS: Conflict of design with prior design, Individual character, Density of design corpus**

**FACTS:** Two applications for invalidity were filed pursuant to Article 25 in conjunction with Article 5 and 6 CDR. The Invalidity Division upheld the applications for invalidity due to a lack of novelty pursuant to Article 5 CDR. The 3rd Board of Appeal (BoA) annulled the contested decisions. However, it declared the contested RCDs invalid since they produce on the informed user the same overall impressions than those of the prior designs within the meaning of Article 6 RCD. The appellant lodged two actions for annulment before the General Court (GC). The GC upheld the appeals and annulled the contested decisions for lack of motivation as the BoA had not addressed the appellant's argument regarding the density of the state of art in the radiators/heaters sector. As a result, the cases were

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



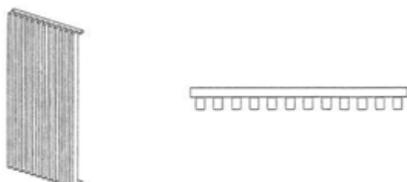
remitted to the BoA which was called upon to assess the contested RCDs individual character by taking into account the appellant's argument that the sector concerned was crowded. The BoA gave to the parties the opportunity to comment and provide evidence in connection with this argument, which, if upheld, could support that the circumstance informed user would be more attentive to the details of the designs. The BoA took two decisions, finding that the appellant did not prove the saturation of the sector concerned and confirming that the contested RCDs lack of individual character. The appellant lodged two actions for annulment and the GC joined the two cases.



**SUBSTANCE:** The GC found that the BoA did not infringe any general principle of the EU law. In particular, the GC found that no infringement of right to defence occurred and that the principle of equal treatment and sound administration had been respected (paras. 93, 94). The GC confirmed that the BoA is not bound by its previous decisions. The respective trade mark case-law is applicable by analogy to design invalidity proceedings (para. 93). The GC also confirmed that where the RCD holder invokes a saturation of the state of the art, the evidence filed in support must be sufficient in number, quality and relevance (paras. 69, 70). The GC reiterated that the saturation of the state of the art must be ascertained. The GC clarified that, however, this does not necessarily mean that well known facts cannot be enough (para. 93) to establish saturation. The relevant date for determining saturation of the state of the art is the filing date of the contested RCD (para. 63).

**Case T 811/14; Unilever NV / EUIPO, Judgment of 17 February 2017;**

RCD – T-828/14



RCD – T-829/14

## First Page

- Second phase of legislative changes: 1 October 2017

James Nurton | Yann Basire  
Interviews

## Statistical Highlights

- March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



**Language of the case:** EN

**RESULT:** Action upheld (BoA decision annulled)

**KEYWORDS:** Competence of the Boards, Right to be heard, Suspension of the proceedings, Substantial procedural violation

**FACTS:** The Opposition Division (OD) allowed the opposition based upon Article 8(1)(b) EUTMR and rejected the contested trade mark application. It found likelihood of confusion to exist with one of the several national earlier rights (a Spanish mark) which had been invoked as basis of the opposition.

The Board of Appeal (BoA) dismissed the appeal as it found likelihood of confusion to exist with another of the earlier national marks (a Benelux mark) upon which the opponent relied. The Board of Appeal did so after having rejected the Applicant's request for suspension of the appeal proceedings. This request was made on the ground that the Applicant claimed to have started cancellation actions against, inter alia, the opponent's earlier Benelux mark. The Applicant had filed evidence to support its claim that the earlier Benelux had been attacked.

Before the General Court (GC), the applicant claimed, inter alia, the following: (1) that the BoA was not entitled at all – or, at least, not without giving it the right to be heard – to reject the appeal on the basis of a finding of likelihood of confusion with respect

to a different earlier mark than that examined by the OD; (2) that the BoA had made, inter alia, manifest errors of assessment when examining and analysing the evidence submitted in support of its request for a suspension of the appeal proceedings.

**SUBSTANCE:** The General Court (GC) dismissed the first plea and confirmed established case law (i) that Article 64(1) EUTMR requires the BoA to fully re-examine the opposition, including as regards earlier rights which had not been taken into account by the OD, and (ii) that Article 75 EUTMR does not require the BoA to hear the applicant before dismissing the appeal on the basis of a different earlier right properly relied upon by the opponent and upon which the applicant had the opportunity to comment.

The GC upheld the second plea as it found a breach of Rule 20(7)(c) EUTMR.

On the one hand, it confirmed established case law that the BoAs have a broad discretion as regards its decisions on requests of suspensions of the appeal proceedings (para. 54) and that an attack upon the earlier mark does not create – as such – any obligation for the BoA to suspend proceedings (para. 61). It furthermore indicated, albeit indirectly, that 'fumus boni iuris' considerations are to be taken into account when assessing a request for suspension (para. 67 in fine). – On the other hand, the GC also confirmed established case-law that decisions on suspensions are subject to judicial

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



review, albeit limited to misuse of power and manifest errors of assessment (para. 55) and as regards the observance of 'the general principles governing procedural fairness within a European Union governed by the rule of law', namely that 'the decision whether or not to suspend the proceedings must follow upon a balancing of the competing interests' (para. 56). – In particular, a proper and careful examination of the evidence submitted constitutes a pre-condition being capable of exercising any discretionary power (para. 67).

In the case at hand, the GC found that the BoA had not properly analysed the documents filed by the applicant (evidence of existence of cancellation proceedings against the earlier BX mark based grounds not yet examined by the Office) in support of its request for a suspension of the proceedings (paras. 62-65). Those errors, in themselves, could have prevented the Board of Appeal from taking into consideration all the factors characterising the applicant's situation, with the result that, when appraising the interests of the applicant, the Board of Appeal did not address the whole picture and, accordingly, was not in a position to weigh properly the various interests involved' (para. 67).

**Case T-351/14; Construlink – Tecnologias de Informaçao SA v EUIPO; Judgment of 17 February 2017;**

**Language of the case: EN**

**RESULT: Action dismissed**

**KEYWORDS: Admissibility, Conceptual similarity, Descriptive element, Distinctive element, Dominant element, Figurative trade mark, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Similarity of the signs, Specialised public, Visual similarity, Weak element**

**FACTS:** The applicant sought to register the word mark GATEWIT represented below as a EUTM for services in Class 42. An opposition based on the earlier figurative mark represented below, registered for goods and services in Classes 9, 38 and 42 and on company name Wit-Software Consultoria para a Internet Móvel SA was filed on the grounds of Articles 8(1)(b) and 8(4) EUTMR.

The Opposition Division dismissed the opposition. The Board of Appeal (BoA) upheld the opponent's appeal. The applicant filed an action before the General Court (GC).

**EUTMA Earlier rights**

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



GATEWIT

1)   
2) WIT-SOFTWARE,  
CONSULTORIA E  
SOFTWARE PARA A  
INTERNET MÓVEL, S.A.

**SUBSTANCE:** The head of claim seeking a declaration from the GC that the trade mark application is fully sustained seeks to obtain statements of law from the GC and, therefore, is inadmissible (para. 24). A party must be given the opportunity of referring to national judicial decisions for the first time before the Court, given that the BoA is being criticised, not for failing to take account of elements of fact set out in a specific national decision, but for infringing Regulation No 207/2009 (para. 29). However in the present case the judgment of Lisbon court is irrelevant as the applied legal provisions and their interpretation differs from EUTMR.

For the purpose of comparison of services and identifying relevant public only the list of services as set out in the application matters and not the applicant's assertions relating to the specific services in respect of which it has used or intends to use the mark applied for (para. 49). Within the European Union, computer hardware (computers, tablets, smartphones, and so on)

and computer products (software and so on) correspond, for the most part, to standardised goods that are easy to use, are not highly technical, and are widely distributed in all types of stores at affordable prices. To that extent, they are everyday consumer goods intended for the general public. Similarly, computer consultancy services may be provided for general public and there are no reasons to find that consumer's level of attention would be higher than normal (paras. 52-53). On the other hand when a consumer does not purchase an already commercially-available standard product, but turns to a supplier specialising in the design, creation, research and development of computer programmes, he is looking to obtain a product corresponding to a specific need, which involves significant interaction with the supplier and which is, consequently, more technical and more expensive than a standard product. Those services are most often aimed at specialists and dealers whose degree of attentiveness is generally high. Nonetheless, occasionally some consumers from the general public may from time to time make use of computer design and programming services. However, in such a situation, their degree of attentiveness will be higher than normal, because those are specialised services, which are not purchased every day and represent a significant financial investment (para. 54).

The part of the relevant public that specialised in computing would break down the EUTM application into the elements 'gate' and 'wit' and would perceive

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton  
Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

■ European Cooperation working groups meet at EUIPO  
■ Closure of EU-ASEAN project on protection of IP rights

## More News

■ EUIPO at INTA 2016  
■ IP Case Law Laboratory  
■ IP for Paralegals

## Case Law

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

## Case Law



the element 'gate' as descriptive while the term 'wit' will be perceived as fanciful term since its meaning in English is not widely known and is not applicable to inanimate objects (paras. 73-75). Due to the corresponding element 'wit' the signs are visually similar to a normal degree and not merely low as found by the BoA and this is not affected by the fact that EUTM application begins with 'gate' as such a beginning is descriptive (paras. 81-84). For the same reasons the signs are phonetically similar (para. 90). Conceptual comparison shall remain neutral because the element 'wit' will be perceived as fanciful since consumers specialising in computing will be unable to attribute a specific meaning to it in relation to the relevant services (paras. 96-97).

There is a likelihood of confusion despite higher degree of attention of the relevant public, as the services are identical and the signs are similar differing only in weakly distinctive elements (para. 106). As the opposition was upheld under 8(1)(b) EUTMR it is irrelevant to examine the infringement of 8(4) EUTMR.

**Case T-596/15; Batmore Capital Ltd v EUIPO; Judgment of 17 February 2017;**

**Language of the case:** EN

**RESULT:** Action dismissed

**KEYWORDS:** Coexistence of trade marks,

### **Similarity of the signs, Similarity of the goods and services, Likelihood of confusion**

**FACTS:** The applicant sought to register the international mark represented below for goods in Class 9. An opposition based on earlier French marks represented below registered for goods and services in Classes 9, 16, 38, 41, and on the domain name **pocket.fr** was filed on the grounds of Article 8(1)(b), (4) and (5) EUTMR. The Opposition Division upheld the opposition. The Board of Appeal (BoA) found likelihood of confusion (LOC) on account of the similarities between the signs and the goods and services. It held that there was a certain degree of similarity between the various goods and services (G&S) concerned, in the sense that an average consumer was likely to assume that the content provider, a publishing house that offers electronic publications, for example, would also provide the necessary hardware to reproduce or display those publications.



## First Page

- Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

- March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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



## Case Law



**SUBSTANCE:** The GC dismisses the action. **Similarity of the G&S:** The GC confirmed that the 'portable and handheld digital electronic devices' are complementary to the data carriers and they can be sold in the same retail outlets (paras. 44 and 50-52). The 'portable and handheld digital electronic devices' are also complementary to the on-line publication services (para. 53). **Similarity of the signs:** The signs are similar on the three levels of perception to the extent that they share the dominant element 'Pocket', despite the low distinctive character of this term in respect of the goods covered by the EUTMA and some of the goods covered by the earlier mark (paras. 67-71 and 74-76). **Likelihood of confusion:** The argument taken from the co-existence of many marks containing the element 'Pocket' is dismissed because the applicant merely referred to extracts from trade mark registers (paras. 83-84).

**Case T-19/15; Yuleidy Caridad Gómez Echevarría v EUIPO; Judgment of 1 February 2017;**

**Language of the case:** ES

**RESULT:** Action dismissed

**KEYWORDS:** Common element, Conceptual similarity, Descriptive element, Dominant element, Figurative trade mark, Functionality continuity, Identity of goods and services, New submissions on appeal, Phonetic similarity, Relevant territory, Similarity of

**the signs, Visual similarity, Weak element**

**FACTS:** The EUTM proprietor was granted the registration of the figurative mark represented below as a EUTM for goods and services in Class 25.

An application for invalidity was filed pursuant to Article 53(1)(a) in conjunction with Article 8(1)(b) EUTMR. The Cancellation Division (CD) upheld the application for invalidity on the basis of the earlier word mark. It considered unnecessary to assess the case on the basis of the remaining earlier mark.

The Board of Appeal (BoA) dismissed the EUTM proprietor's appeal. It found that there was a likelihood of confusion between the contested EUTM and the two earlier marks.

The proprietor filed an action before the General Court (GC) relying on five pleas in law: (i) infringement of Article 64(1) EUTMR in relation to Article 41(2) of Charter of Fundamental Rights; (ii) abuse of right; (iii) and (iv) infringement of Article 53(1)(a) in conjunction with Article 8(1)(b); and (v) infringement of Rule 94(1)(7) EUTMIR in relation to Article 85(1) EUTMR. The GC dismissed the appeal.

EUTM

Earlier marks

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



**SUBSTANCE:** The BoA correctly assessed whether there was a likelihood of confusion between the contested mark and the two earlier marks. This is not altered by the facts that the CD did not proceed to this assessment on the basis of the figurative earlier mark and that the EUTM proprietor did not present arguments before the BoA in relation to that earlier mark (paras. 17-23). The GC refers to previous case-law by analogy (Bellram case) and confirms that the right of defence was not infringed in this case (paras. 24-31). The applicant's arguments concerning abuse of right are inadmissible since they are presented for the first time before the GC (paras. 33-38). **LIKELIHOOD OF CONFUSION:** The relevant public was the English speaking consumer from the general public, with a normal degree of attentiveness as minimum (paras. 48-52). The GC confirms that the term 'wax' has a limited intrinsic distinctiveness but it is the dominant element of the contested mark and of the earlier figurative mark. Since the remaining elements are insignificant in the overall impression of the signs, their similarity can be assessed on the sole basis of this dominant element (paras. 71-83 and paras. 93-94). These marks are visually similar taking into account the significant impact of the term in

common due to their size and position, without it being neutralized by the remaining elements (paras. 85-86). After considering that 'by Yuli's' might not even be pronounced, the GC found the signs phonetically similar at least to an average degree (paras. 87-89). These marks are also conceptually highly similar because of the coincidence in their dominant verbal element. The figurative elements of the marks and the additional verbal elements in the contested mark are conceptually insignificant because of their link to the goods involved (paras. 91-92). Considering the interdependence principle, there is a likelihood of confusion between these marks (paras. 100-104). **BOA'S DECISION ON COSTS:** the fixation of cost of representation does not require the previous submission of evidence or justification of their existence or amount (para. 113).

**Case T-225/15; QuaMa Quality Management GmbH v EUIPO; Judgment of 17 January 2017;**

**Language of the case: DE**

**RESULT: Action dismissed**

**KEYWORDS: Transfer of IP right, Likelihood of confusion, Common element, Visual similarity, Phonetic similarity, Identity of the goods and services**

**FACTS:** An opposition based on the earlier EUTM **MedialB** (Classes 9, 41, 42), was filed pursuant to

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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



## Case Law



Article 8(1)(b) EUTMR against the EUTM application **medialbo** (Classes 9, 37, 41). The notice of opposition was accompanied by an application requesting for a 'change of name and address' of the owner of the earlier mark. The Office informed the opponent (=other party before the General Court) that from the circumstances it seemed apparent that he actually wanted to request a 'transfer of ownership' and not a 'change of name & address'. Following this Office communication, the opponent indeed requested a transfer using now the correct form. Subsequently, the transfer of ownership was registered and the Office rejected the original application for a 'change of name & address'. The Opposition Division (OD) partly rejected and partly upheld the opposition. Both parties appealed.

The Board of Appeal (BoA) rejected both appeals. With regard to Article 17(4) EUTMR, a violation of which had been claimed by the EUTM applicant (=applicant before the General Court), the BoA stated that it is sufficient if a transfer of ownership is requested the same day as the opposition is filed. The opponent's request for a 'change of name & address' was viewed as an obvious request for a 'transfer of ownership', which was rectified in the course of the proceedings (falsa demonstratio non nocet). The required identity of opponent and owner of the earlier mark was therefore deemed given at all times. With regard to Article 8(1)(b) EUTMR, the BoA confirmed the finding of OD of a likelihood of confusion for identical and similar goods.

The applicant filed an action before the General Court (GC), raising two pleas of law, namely a violation of Article 41(1) EUTMR and of Article 8(1)(b) EUTMR.

EUTMA	Earlier mark
<b>medialbo</b>	<b>MediaLB</b>

**SUBSTANCE:** As far as a violation of **Article 41 EUTMR** was claimed, it is undisputed that the other party filed its application on the same day as the notice of opposition and only proof of transfer was missing (Rule 31(5) EUTMIR). Because of this and the discrepancy between the wording 'application for a change of name and address' and the content of the actual application the Office invited the other party to fill in the appropriate form. Consequently, the other party filled in the correct form, signed by the same owner of both, the old and the new company. This healed the deficiencies of the original application for transfer of ownership. The Office cannot simply rely on the literal wording of the application without also taking account of the content of the application. It is clear from the circumstances of the case that the actual will of the other party was to file an application for transfer of ownership and not a 'change of

## First Page

- Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

- March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



name & address' (paras. 30-41). Therefore, the Office interpreted the original application correctly as an application for 'transfer of ownership' and Article 41 EUTMR was not violated (paras. 30-42).

With regard to **Article 8(1)(b) EUTMR** and a likelihood of confusion, it is apparent, that the element 'media' is the longest and only element with a clear meaning in both marks, which, therefore, cannot be disregarded in a global assessment (paras. 55-57). The signs are visually similar above average as they coincide in 7 letters, which constitute the entire earlier mark (paras. 58-61). Phonetically, the marks are pronounced identically at their beginning and similar for the remaining part, which justifies the assumption of a high phonetic similarity (paras. 62-63). Conceptually, the marks are similar, if the consumers recognize the meaning of 'media', and if not, a conceptual comparison remains neutral (para. 64). Even assuming a low distinctiveness of the earlier mark, a likelihood of confusion exists in light of identical goods and services and the high similarity of the signs, irrespective of a possibly enhanced degree of attention of the relevant public (paras. 68-70).

Based on the foregoing, the appeal was dismissed.

**Case T-686/15; Marcas Costa Brava, SL v EUIPO; Judgment of 2 February 2017;**

**Language of the case: EN**

**RESULT: Action dismissed**

**KEYWORDS: Proof of use, Extent of use, Burden of proof**

**FACTS:** The owner of the earlier EUTM **café crem** in Class 30 (=applicant before the General Court) filed an opposition against the figurative EUTM application (Class 30) as displayed underneath, based on Article 8(1)(b) EUTMR. Upon request of the owner of the EUTM application (=other party), the applicant provided evidence of genuine use of its earlier mark.

The Opposition Division (OD) acknowledged genuine use of the earlier mark, found a likelihood of confusion between the marks at issue and, thus, upheld the opposition in its entirety. The Board of Appeal (BoA) found the appeal of the other party to be well founded, as it deemed the evidence submitted not sufficient to establish genuine use of the earlier mark. It annulled the OD decision without entering into the examination of a likelihood of confusion. The applicant filed an action before the General Court (GC).

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton  
Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



EUTMA

Earlier mark



**SUBSTANCE:** With regard to the territorial scope of genuine use the GC confirmed the BoA's finding that use had only been established in two of the four provinces of Catalonia (Spain), namely Tarragona and Barcelona. Merely providing a copy of the extract from the central trade register of Spain to prove the place of establishment of the company in another province (Girona) or providing a screenshot of a website with a postal address of a distributor in another province (Lleida) is not sufficient evidence to establish use in these provinces (paras. 36-40).

The BoA was correct in not taking into account sales of products documented in invoices, which did not display the trade mark, but solely referred to the acronym 'CC', as it has not been established unambiguously that this acronym indeed refers to the earlier mark. Furthermore, it has not been shown that all of the goods sold under the mark **café crem** correspond to those, for which the earlier mark is registered (paras. 43-48).

Even if it is assumed that the sums indicated on several **affidavits** – mentioning only global sums, not broken down into products or product categories and not corroborated by other documents such as statistical tables, annual reports, accounting/balance sheet items etc. - are correct, it cannot be ruled out in light of the diversity of marks mentioned in the invoices that the sums related to goods other than those sold under the earlier mark. The BoA was, therefore, right to attribute only little evidential value to the affidavits, which did not make it possible to determine the extent of use of the earlier mark with regard to the goods for which the mark was registered (paras. 49-55).

The GC stressed that the use of the earlier mark on **promotional and advertising material** (which, in the case at hand, was undated or predated in its vast majority), cannot be proved by simply producing copies of that material. It is also necessary to demonstrate that that material, regardless of its nature, has been successfully distributed to the relevant public (paras. 56- 63).

Overall, the GC found that in view of the material submitted, taken as a whole, the BoA did not err in finding that genuine use of the earlier mark has not been proven (para. 67). Based on the foregoing, the appeal was dismissed.

## First Page

- Second phase of legislative changes: 1 October 2017

James Nurton  
Interviews | Yann Basire

## Statistical Highlights

- March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



**Case T-687/15; Marcas Costa Brava, SL v EUIPO; Judgment of 2 February 2017;**

**Language of the case:** EN

**RESULT:** Action dismissed

**KEYWORDS:** Proof of use, Extent of use, Burden of proof

**FACTS:** The owner of the earlier EUTM café crem in Class 30 (=applicant before the General Court) filed an opposition against the figurative EUTM application (Class 30) as displayed underneath, based on Article 8(1)(b) EUTMR. Upon request of the owner of the EUTM application (=other party), the applicant provided evidence of genuine use of its earlier mark. The Opposition Division (OD) acknowledged genuine use of the earlier mark, found a likelihood of confusion between the marks at issue and, thus, upheld the opposition in its entirety. The Board of Appeal (BoA) found the appeal of the other party to be well founded, as it deemed the evidence submitted not sufficient to establish genuine use of the earlier mark. It annulled the OD decision without entering into the examination of a likelihood of confusion. The applicant filed an action before the General Court (GC).



**SUBSTANCE:** With regard to the territorial scope of genuine use the GC confirmed the BoA's finding that use had only been established in two of the four provinces of Catalonia (Spain), namely Tarragona and Barcelona. Merely providing a copy of the extract from the central trade register of Spain to prove the place of establishment of the company in another province (Girona) or providing a screenshot of a website with a postal address of a distributor in another province (Lleida) is not sufficient evidence to establish use in these provinces (paras. 37-40). The BoA was correct in not taking into account sales of products documented in invoices, which did not display the trade mark, but solely referred to the acronym 'CC', as it has not been established unambiguously that this acronym indeed refers to the earlier mark. Furthermore, it has not been shown that all of the goods sold under the mark "café crem" correspond to those, for which the earlier mark is registered (paras. 43-48). Even if it is assumed that the sums indicated on

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



several affidavits – mentioning only global sums, not broken down into products or product categories and not corroborated by other documents such as statistical tables, annual reports, accounting/balance sheet items etc. - are correct, it cannot be ruled out in light of the diversity of marks mentioned in the invoices that the sums related to goods other than those sold under the earlier mark. The BoA was, therefore, right to attribute only little evidential value to the affidavits, which did not make it possible to determine the extent of use of the earlier mark with regard to the goods for which the mark was registered (paras. 49-55). The GC stressed that the use of the earlier mark on promotional and advertising material (which, in the case at hand, was undated or predated in its vast majority), cannot be proved by simply producing copies of that material. It is also necessary to demonstrate that that material, regardless of its nature, has been successfully distributed to the relevant public (paras. 56- 63). Overall, the GC found that in view of the material submitted, taken as a whole, the BoA did not err in finding that genuine use of the earlier mark has not been proven (para. 67). Based on the foregoing, the appeal was dismissed.

**Case T-689/15; Marcas Costa Brava, SL v EUIPO; Judgment of 2 February 2017;**

**Language of the case: EN**

**RESULT: Action dismissed**

**KEYWORDS: Proof of use, Extent of use, Burden of proof**

**FACTS:** The owner of the earlier EUTM café crem in Class 30 (=applicant before the General Court) filed an opposition against the figurative EUTM application (Class 30) as displayed underneath, based on Article 8(1)(b) EUTMR. Upon request of the owner of the EUTM application (=other party), the applicant provided evidence of genuine use of its earlier mark.

The Opposition Division (OD) acknowledged genuine use of the earlier mark, found a likelihood of confusion between the marks at issue and, thus, upheld the opposition in its entirety. The Board of Appeal (BoA) found the appeal of the other party to be well founded, as it deemed the evidence submitted not sufficient to establish genuine use of the earlier mark. It annulled the OD decision without entering into the examination of a likelihood of confusion. The applicant filed an action before the General Court (GC).

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton  
Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

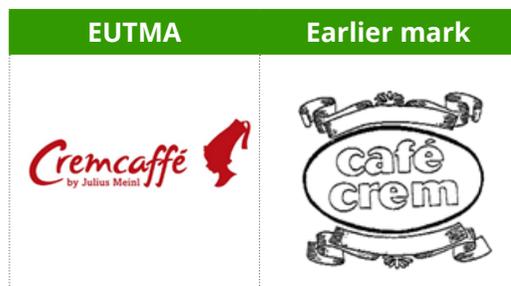
## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



**SUBSTANCE:** With regard to the territorial scope of genuine use the GC confirmed the BoA's finding that use had only been established in two of the four provinces of Catalonia (Spain), namely Tarragona and Barcelona. Merely providing a copy of the extract from the central trade register of Spain to prove the place of establishment of the company in another province (Girona) or providing a screenshot of a website with a postal address of a distributor in another province (Lleida) is not sufficient evidence to establish use in these provinces (paras. 37-40).

The BoA was correct in not taking into account sales of products documented in **invoices**, which did not display the trade mark, but solely referred to the acronym 'CC', as it has not been established unambiguously that this acronym indeed refers to the earlier mark. Furthermore, it has not been shown that all of the goods sold under the mark "café crem" correspond to those, for which the earlier mark is registered (paras. 43-48).

Even if it is assumed that the sums indicated on several **affidavits** – mentioning only global sums, not broken down into products or product categories and not corroborated by other documents such as statistical tables, annual reports, accounting/balance sheet items etc. - are correct, it cannot be ruled out in light of the diversity of marks mentioned in the invoices that the sums related to goods other than those sold under the earlier mark. The BoA was, therefore, right to attribute only little evidential value to the affidavits, which did not make it possible to determine the extent of use of the earlier mark with regard to the goods for which the mark was registered (paras. 49-55).

The GC stressed that the use of the earlier mark on **promotional and advertising material** (which, in the case at hand, was undated or predated in its vast majority), cannot be proved by simply producing copies of that material. It is also necessary to demonstrate that that material, regardless of its nature, has been successfully distributed to the relevant public (paras. 56- 63).

Overall, the GC found that in view of the material submitted, taken as a whole, the BoA did not err in finding that genuine use of the earlier mark has not been proven (para. 67).

Based on the foregoing, the appeal was dismissed

## First Page

- Second phase of legislative changes: 1 October 2017

James Nurton | Yann Basire  
Interviews

## Statistical Highlights

- March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



**Case T-690/15; Marcas Costa Brava, SL v EUIPO; Judgment of 2 February 2017;**

**Language of the case:** EN

**RESULT:** Action dismissed

**KEYWORDS:** Proof of use, Extent of use, Burden of proof

**FACTS:** The owner of the earlier EUTM **café crem** in Class 30 (=applicant before the General Court) filed an opposition against the figurative EUTM application (Class 30) as displayed underneath, based on Article 8(1)(b) EUTMR. Upon request of the owner of the EUTM application (=other party), the applicant provided evidence of genuine use of its earlier mark.

The Opposition Division (OD) acknowledged genuine use of the earlier mark, found a likelihood of confusion between the marks at issue and, thus, upheld the opposition in its entirety. The Board of Appeal (BoA) found the appeal of the other party to be well founded, as it deemed the evidence submitted not sufficient to establish genuine use of the earlier mark. It annulled the OD decision without entering into the examination of a likelihood of confusion. The applicant filed an action before the General Court (GC).



**SUBSTANCE:** With regard to the territorial scope of genuine use the GC confirmed the BoA's finding that use had only been established in two of the four provinces of Catalonia (Spain), namely Tarragona and Barcelona. Merely providing a copy of the extract from the central trade register of Spain to prove the place of establishment of the company in another province (Girona) or providing a screenshot of a website with a postal address of a distributor in another province (Lleida) is not sufficient evidence to establish use in these provinces (paras. 37-40).

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## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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



## Case Law



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The GC stressed that the use of the earlier mark on **promotional and advertising material** (which, in the case at hand, was undated or predated in its vast majority), cannot be proved by simply producing copies of that material. It is also necessary to demonstrate that that material, regardless of its nature, has been successfully distributed to the relevant public (paras. 56- 63).

Overall, the GC found that in view of the material submitted, taken as a whole, the BoA did not err in finding that genuine use of the earlier mark has not been proven (para. 67).

Based on the foregoing, the appeal was dismissed.

**Case T-691/15; Marcas Costa Brava, SL v EUIPO; Judgment of 2 February 2017;**

**Language of the case: EN**

**RESULT: Action dismissed**

**KEYWORDS: Proof of use, Extent of use, Burden of proof**

**FACTS:** The owner of the earlier EUTM **café crem** in Class 30 (=applicant before the General Court) filed an opposition against the figurative EUTM application (Class 30) as displayed underneath, based on Article 8(1)(b) EUTMR. Upon request of the owner of the EUTM application (=other party), the applicant provided evidence of genuine use of its earlier mark.

The Opposition Division (OD) acknowledged genuine use of the earlier mark, found a likelihood of confusion between the marks at issue and, thus, upheld the opposition in its entirety. The Board of Appeal (BoA) found the appeal of the other party to be well founded, as it deemed the evidence submitted not sufficient to establish genuine use of the earlier mark. It annulled the OD decision without entering into the examination of a likelihood of confusion. The applicant filed an action before the General Court (GC).

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton  
Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



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Overall, the GC found that in view of the material submitted, taken as a whole, the BoA did not err in finding that genuine use of the earlier mark has not been proven (para. 67).

Based on the foregoing, the appeal was dismissed.

## First Page

- Second phase of legislative changes: 1 October 2017

James Nurton | Yann Basire  
Interviews

## Statistical Highlights

- March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



**Case T-745/15; Scorpio Poland v EUIPO; Judgment of 14 December 2016;**

**Language of the case: PL**

**RESULT: Action dismissed**

**KEYWORDS: Admissibility, Claim for alteration of EUIPO decision, Figurative trade mark, Figurative element, Similarity of the signs, Identity of the goods and services, Likelihood of confusion.**

**FACTS:** The applicant sought to register a figurative sign YO (represented below) as EUTM for goods and services in Class 25.

An opposition based on the earlier German word mark YO, registered for goods and services in Class 25, was filed pursuant to Article 8 (1)(b) EUTMR. The Opposition Division dismissed the opposition in its entirety. The opponent filed an appeal. The Board of Appeal (BoA) upheld the opponent's appeal. It found that both signs would be perceived by a large part of the German speaking public as consisting of the verbal element 'YO'. The signs were therefore aurally identical and visually similar to a low or average degree. Since none of the signs had a meaning, the signs were neither conceptually similar nor identical. The goods were identical. Considering the above BoA found that there existed a likelihood of confusion between the signs.

The applicant filed an action before the General Court (GC) relying on a single plea in law: Article 8(1)(b) EUTMR. The application sought, inter alia, to have the decision of BoA altered and EUTMA registered. The GC found the latter claim to be inadmissible. As to the remaining claim the GC dismissed the appeal. It found that there existed a likelihood of confusion between the signs at issue.



**SUBSTANCE: As to Claim for alteration of the Office decision:** As to applicant's plea to alter the Office decision and allow for registration for EUTMA the GC found it inadmissible and explained the meaning of Article 65(3) EUTMR and referred to the relevant case law (para. 14).

As to the comparison of goods: The goods were found to be identical, but the applicant argued that they belonged to different industries because the opponent's company was in the foodstuff business. The GC observed that the comparison of goods should be made on the basis of the characteristics relevant to their mutual relationship. It referred to the criteria relevant for the comparison of goods

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



such as the nature, purpose, method of use, whether they are in competition or are complementary, and observed that considering the above, the finding that the goods were identical was correct, since they all belonged to class 25. The GC further observed that the fact that the goods were used for promotion or merchandising did not change their main characteristics relevant for the comparison of goods; therefore the commercial purpose did not affect that relationship between the goods under comparison (paras. 26-27, 31). Moreover the applicant argued that the goods of the opponent were in fact used in merchandising and advertising thus suggesting a lack of genuine use. To this the GC commented that since the earlier sign was registered for less than 5 years, it was not subject to proof of use. The relevant goods were, therefore, the ones for which the trade mark was registered (paras 28-30).

**As to the comparison of signs:** The GC referred to the relevant case law on comparison of signs, on visual, aural and conceptual level and observed that a word mark can be compared with a figurative sign on all these levels. The GC confirmed BoA's assessment that the earlier mark was likely to be perceived as letters 'YO' by large part of the relevant public. Even though this element was stylised it was still clearly legible, and the fact that it was followed by an exclamation mark only emphasized it. The GC found the figurative elements not to be negligible, but denied that they should be perceived as dominant within the earlier mark. Consequently

the GC confirmed that the visual similarity was between low and average. As to the aural similarity the GC confirmed BoA's conclusion of its identity. The GC found that the presence of exclamation mark while having some impact on intonation, will not affect the finding of aural identity between the signs. As to the conceptual similarity, since neither of the signs had a meaning, it was irrelevant.

**As to the likelihood of confusion:** The GC confirmed that considering the identity of the goods and the visual similarity between low to average and aural identity between the signs there is a likelihood of confusion between the signs at issue.

**Case T-71/15; Jaguar Land Rover Ltd v EUIPO; Judgment of 16 February 2017;**

**Language of the case: EN**

**RESULT: Action upheld (BoA decision annulled)**  
**KEYWORDS: Weak element, Descriptive element, Similarity of the signs, Enhanced distinctiveness, Reputation**

**FACTS:** The EUTM applicant sought to register the word mark Land Glider as an EUTM for goods in Class 12. An opposition based on a number of word and figurative marks containing the terms 'LAND ROVER', registered for goods in Class 12, was filed pursuant to Articles 8(1)(b) and (5) EUTMR. The Opposition Division (OD) upheld the opposition

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton  
Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



on the basis of Article 8(5) of the Regulation and refused the EUTMA in its entirety. The Board of Appeal (BoA) upheld the applicant's appeal. It found that there was no likelihood of confusion under Article 8(1)(b) EUTMR. As regards Article 8(5) EUTMR, the BoA considered that, even if the earlier marks had a reputation, the common element 'land', which classified the goods in question and would be understood throughout the EU, was not sufficient to lead the consumer to establish a relevant link between the marks at issue. The opponent filed an action before the General Court (GC) relying on three pleas in law: an infringement of (i) Article 8(1)(b) EUTMR, (ii) Article 8(5) EUTMR, and (iii) Article 75 EUTMR. The GC upheld the appeal.

form part of such a basic vocabulary. Thus, for a considerable part of the relevant public there were no grounds to find that this word element was descriptive or weakly distinctive. The BoA's assessment in respect of the similarity of the signs and of whether the relevant public will establish a link between the marks at issue was based on the incorrect premise that the element 'land' is descriptive for the whole of the relevant public (paras. 62-78). ASSESSMENT OF ENHANCED DISTINCTIVE CHARACTER / REPUTATION: The BoA had examined the enhanced distinctiveness in the context of Article 8(1)(b) EUTMR. However, the GC considered it necessary to check this assessment in the context of Article 8(5) EUTMR since, if it was true that the earlier mark did not have a reputation, this ground would not apply. The contested decision merely stated that the probative value of the evidence submitted by the applicant did not allow any conclusions to be drawn as to whether the earlier marks enjoyed an enhanced distinctive character. The GC found that it did not contain a comprehensive analysis of the 2 500 pages of documents submitted by the applicant, and therefore that it was not possible to reject the opponent's second plea in law on the ground that the applicant had not, in any event, established the earlier marks' reputation (paras. 79-83).

**Case T-98/15; Tubes Radiatori Srl v EUIPO; Judgment of 16 February 2017;**

**Language of the case: IT**

EUTMA	Earlier marks
Land Glider	1) Land Rover 2) 

**SUBSTANCE:** The GC only examined the plea related to the infringement of Article 8(5) EUTMR. **DISTINCTIVENESS OF THE COMMON ELEMENT:** With the exception of certain terms forming part of the basic English vocabulary, it cannot be assumed that English-language terms are widely known in the European Union. In the present case, the English word 'land', in particular in the sense of 'solid part of the Earth's surface', cannot be considered to

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



**RESULT:** Action upheld (BoA decision annulled)

**KEYWORDS:** Conflict of design with prior design, Individual character, Density of design corpus

**FACTS:** An application for invalidity was filed pursuant to Article 25 in conjunction with Article 5 and 6 CDR. The Invalidity Division upheld the application for invalidity due to a lack of individual character pursuant to Article 6 CDR. The 3rd Board of Appeal (BoA) confirmed the contested decision. The appellant lodged an action for annulment before the General Court (GC). The GC upheld the appeal and annulled the contested decision for lack of motivation as the BoA had not addressed the appellant's argument regarding the density of the state of art in the radiators/heating sector. As a result, the case was remitted to the BoA which was called upon to assess the contested RCD individual character by taking into account the appellant's argument that the sector concerned was crowded. The BoA found that the appellant did not prove the saturation of the sector concerned and confirmed that the contested RCD lack of individual character. The appellant lodged an action for annulment.

### RCD



**SUBSTANCE:** The GC found that, contrary to the appellant's line of arguments, the previous judgment implied the BoA was called upon to assess again the individual character of the contested RCD also by taking into account the appellant's argument regarding the saturation of the sector concerned (para. 30). The GC considered that the annulment of the previous Board's decision required a new examination (para. 32). The GC endorsed the appellant's argument that the Board, by finding that the saturation of the sector of radiators/heaters was not established without granting the possibility of filing arguments and/or evidence further to the remittal of the case, infringed the appellant's right to be heard (paras. 46-53).

34

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



**Case T-369/15; Hernández Zamora, S.A. v EUIPO; Judgment of 17 February 2017;**

**Language of the case:** EN

**RESULT:** Action dismissed

**KEYWORDS:** Dissimilarity of the goods and services, Likelihood of confusion

**FACTS:** The applicant sought to register the word mark PALOMA as an EUTM for goods in Class 31. An opposition based on the earlier figurative mark PALOMA, registered for goods in Class 31 was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) dismissed the opposition in so far as it considered the goods dissimilar.

The Board of Appeal (BoA) dismissed the opponent's appeal. It confirmed that the goods were dissimilar. The applicant filed an action before the General Court (GC) relying on one plea in law: (i) infringement of Article 8(1)(b) EUTMR. The General Court dismissed the appeal. It confirmed that the goods were dissimilar.

EUTMA	Earlier mark
PALOMA	

**SUBSTANCE:** The GC reiterates standard case-law to the effect that in assessing the similarity of the goods, the BoA was right not to take into account the similarities of the signs (paras. 23-24). The GC confirms each of the conclusions of the BoA regarding the dissimilarity between the contested roses and rose plants; propagation material of roses and the earlier fruits, garden herbs, fresh. Their nature and intended use is very different (non-edible organisms vs fresh food items) (para. 25); the goods are not in competition (they serve different purposes so they cannot be interchangeable) (para. 26) and are not complementary (one is not indispensable or important for the other) (para. 27). Finally, the GC confirms the Office practice that the fact that the goods may be sold in the same department stores is not particularly significant given the very different kinds of goods that may be found in those shops (para. 28). The GC stresses that the opponent did not adduce any evidence calling into question these findings. It dismisses the opponent's arguments, inter alia, the reference to Explanatory Note to Class 31 referring to all goods as 'land products'. The Note shows that such Class includes a great

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



variety of different goods. The GC also reminds that the classification only serves administrative purposes pursuant to Rule 2(4) EUTMIR (para. 33) During the proceedings, the Office raised the fact that the original ES version of the earlier goods frutas y hortalizas frescas had been incorrectly translated into EN as fruits, garden herbs, fresh. Dissimilarity of the goods was even more obvious taking into account the authentic ES version (which does not refer to garden herbs). The GC sent a written question inquiring on the effect of this error on the case. The judgment confirms the Office's views in this regard: the ES version is the authentic one but in any event, the error has no effect on the legality of the decision as the BoA conclusions could be transposed to a comparison with the correct translation of the goods. None of BoA conclusions are specific to garden herbs (para. 37 to 43).

**Case T-276/15; Edison SpA v EUIPO; Judgment of 14 March 2017;**

**Language of the case: EN**

**RESULT: Action dismissed**

**KEYWORDS: Likelihood of confusion, Letter mark, Distinctive element**

**FACTS:** The Opposition Division dismissed the opposition based upon Article 8(1)(b) EUTMR in its entirety. The Board of Appeal (BoA) allowed the

appeal in part, finding likelihood of confusion to exist between the conflicting marks for the identical goods and services. This part of the BoA-Decision was not challenged before the General Court (GC).

The BoA rejected the appeal for the similar and dissimilar goods and services (inter alia electric energy emanating from wind power; plants for the production of renewable energy; leasing of wind power energy generating facilities) for which it found no likelihood of confusion to exist for the relevant public having a high degree of attention. This would follow from (i) the very low degree of similarity between the signs and (ii) the fact that the earlier mark's degree of distinctiveness would stem from its specific stylisation rather than from the presence of the letter 'e'. The evidence submitted would not establish an enhanced distinctiveness through use of the earlier mark.

Before the General Court (GC), the opponent argued that (1) the signs would be similar (and not just similar to a low degree), (2) the goods and services identical or highly similar and (3) an enhanced distinctive character through use of its earlier mark been established in the proceedings before the Office.

**EUTMA**

**Earlier mark**

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton  
Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



**SUBSTANCE:** The GC rejected the three arguments put forward by the opponent and dismissed the appeal.

First, the GC confirmed the BoA's finding that the signs at issue are 'at most, similar overall to a low extent' (paras. 23-29). Even though the signs can both be perceived as representing the letter 'e', they differ visually in their respective colours, typefaces and the overall impressions they convey (para. 25). The phonetic comparison would serve no purpose as the signs would be described rather than pronounced (para. 26). Conceptually, the signs are identical as the letter 'e' would be perceived as a descriptive reference to 'energy' or 'electricity' (paras. 27 and 33) – 'with the result that the conceptual identity is of limited importance in the comparison of the marks' (para. 28).

Next, the GC confirmed the BoA's finding that the opponent had not put forward, as it was its duty in the proceedings before the Office pursuant to Article 76(1) in fine EUTMR, any argument to support its claim that the conflicting goods and services would be identical or highly similar (paras.

42, 45, 46, 47). The facts invoked could neither be considered as well-known facts (paras. 41, 45, 47).

Third, the GC rejected the opponent's argument that the BoA had not properly analysed the evidence submitted before the Office to establish its earlier mark's enhanced distinctive character through use (para. 57).

Finally, the GC found that the opponent had not put forward any convincing argument which would call into question the BoA's findings that the particularly attentive relevant public will not base its purchasing decision exclusively on a commonly used, and therefore descriptive, abbreviation in the relevant energy market, but rather on the specific stylisation given to the letter 'e'. Even if phonetic or conceptual similarities were found to exist between the signs, the relevant public would be capable of perceiving the visual differences and would not be led to believe that the goods or services in question come from the same undertaking or from economically-linked undertakings (para. 63).

**Case T-106/16; zero Holding GmbH & Co. KG v EUIPO; Judgment of 9 February 2017;**

**Language of the case: EN**

**RESULT: Decision upheld (BoA decision annulled)**

**KEYWORDS: Identity of the goods and services,** 37

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

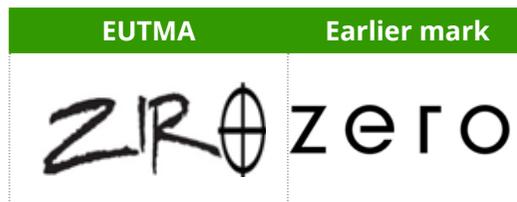
## Case Law



### Visual similarity, Phonetic similarity, Likelihood of confusion

**FACTS:** The EUTM applicant sought to register the mark as depicted hereunder for, as far as relevant, goods in Classes 14 and 25. An opposition based on the earlier figurative mark ZERO, registered for goods in Classed 14 and 25 was filed on the grounds of Article 8(1)(b) EUTMR. The Opposition Division dismissed the opposition. The Board of Appeal dismissed the opponent's appeal. The opponent filed an action before the General Court (GC) raising two pleas in law, namely breach of Article 8(1)(b) EUTMR and of Article 75, second sentence EUTMR. The GC annulled the contested decision on the first plea; no need to assess the 2nd plea.

average visual similarity (paras. 25-36). The signs are phonetically similar to an average degree, at least for the English-speaking relevant public (paras. 37-46). Conceptually, the verbal element 'zero' of the earlier sign has a meaning in English and in several other widely spoken languages of the EU. However, in the absence of a clear and specific meaning of the verbal element 'ziro', the signs at issue are not conceptually similar (paras. 47-50). The visual aspect of the goods at issue has greater importance in the global assessment of the likelihood of confusion. Nevertheless, the signs at issue are of average visual and phonetic similarity (para. 53). Conceptual differences between two signs may counteract visual and phonetic similarities existing between them, provided that at least one of those signs has a clear and specific meaning for the relevant public. In the present case, in the absence of a clear and specific meaning of 'ziro', the signs are not conceptually different. It is possible only to find that, conceptually, that element is not similar to the verbal element of the earlier sign. In such circumstances, the absence of similarity is not capable of counteracting the average visual and phonetic similarity (para. 54).



**SUBSTANCE:** The relevant public is made up of the public at large with an average degree of attention for goods in Class 25 and high degree for goods in Class 14 (para. 20). The goods are identical, with the sole exception of the 'precious metals and their alloys, not included in other classes' in Class 14 (para. 23). The relevant public would recognise the verbal element 'ziro' in the contested mark. The signs are of

**Case T-88/16; OPKO Ireland Global Holdings, Ltd v EUIPO; Judgment of 26 January 2017;**

**Language of the case: EN**

**RESULT: Action dismissed**

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton  
Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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



## Case Law



**KEYWORDS:** Burden of proof, Competence of the Boards, Identity of the signs, Likelihood of confusion, Similarity of the goods and services, Specialised public

**FACTS:** The Board's of Appeal (BoA) decision had been annulled in part by judgment T-222/09 because the BoA had violated Article 76(1) EUTMR by making its own investigations on the therapeutic indication of the compared pharmaceutical goods. The case was remitted back to a BoA in which the rapporteur was already a member in the first (annulled) decision. This led to a second annulment in T-106/12. The case was remitted to another BoA in which the chairperson found, after adopting a decision that he was already sitting on the BoA in the first decision. Another appeal was lodged before the General Court (GC) but the BoA revoked their decision and the case was considered devoid of purpose. A new decision, almost identical to the revoked decision, was adopted by a BoA having a composition in which no member had already been a member in previous proceedings. On the merits, the BoA confirmed that there was likelihood of confusion (LOC) having regard to the similarity of the pharmaceutical goods which both aim at treating kidney disorders and the similarity of signs, in the perception of patients (but not health professionals who would consider 'Alpha' to be descriptive).

EUTMA	Earlier mark
ALPHAREN	ALPHA D3

**SUBSTANCE:** The GC dismisses the action. Composition of BoA after revocation: The GC confirmed that the requirement to have a composition of the BoA free of any member having dealt with a previously annulled decision does not apply where the decision is revoked (para. 35). After the 5th BoA revoked its decision, the case did not need be dealt with by a BoA of an entirely different composition. The mere fact that the content of the decision adopted after revocation is almost identical to that of the revoked decision is not, in itself, capable of establishing a lack of independence on the part of the members of the BoA (para. 38). Discretionary power: The BoA did not make any error in accepting the submission of late evidence, which it had requested from the parties after annulment of the first decision. The discretionary power did not need to be applied restrictively since the evidence did not concern proof of the earlier right (paras. 48-52). Burden of proof: The GC confirms that there is no obligation on the opposing party, in opposition proceedings, to adduce evidence on the similarity of the goods at issue (paras. 58-61). Likelihood of confusion: Pharmaceuticals have only a low degree

## First Page

- Second phase of legislative changes: 1 October 2017

James Nurton  
Interviews | Yann Basire

## Statistical Highlights

- March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



of similarity on account of their common nature unless their therapeutic indication is the same, in which case the degree of similarity is high (paras. 79-82). The fact that the public is mixed means that the descriptive character of the component 'Alpha' for health professionals can be ignored for the purpose of assessing whether there is LOC in the patients' perception (paras. 100-104). All relevant factors support a finding of LOC (para. 110).

**Case T-64/16; Michał Wieromiejczyk v EUIPO; Judgment of 18 January 2017;**

**Language of the case: PL**

**RESULT: Action dismissed.**

**KEYWORDS: Figurative trade mark, Descriptive element, Principle of legality**

**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.

### EUTMA



**SUBSTANCE: As to Article 7(1)(c) EUTMR:** The GC confirmed the finding of BoA that the average consumer in this case was an English-speaker, both native as well as consumer with acquired language skills in that language (paras. 18-19). To the argument of the applicant about the higher level of attentiveness of the consumers with regard to goods in Class 34, the GC observed that such claim had to be proven and confirmed the BoA's assessment, that the level of attentiveness would be average (para. 18).

The GC found that the figurative elements of the sign, that is the typeface and various dots placed around the verbal elements, would not divert the consumer's attention from the verbal elements 'tasty puff' in the application. What is more, these elements should only emphasize the descriptive message conveyed by the verbal elements, because, both the rounded typeface as well as

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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



## Case Law



the dots, can be associated with puffs of smoke. This was the more relevant in case of goods in class 34 (Par. 25). It was therefore found that the figurative elements of the sign could not bestow distinctive character on the application (para. 26).

The applicant argued that the expression 'tasty puff' did not have a direct meaning for the goods in question, as it was not commonly used in relation to these goods. Moreover the applicant maintained that 'puff' was synonymous to 'breath'. To this the GC observed that obviously the latter statement is incorrect because these two words do not have the same meaning (para. 28). The GC indicated that the expression 'tasty puff' could in general be understood by the native English speakers as referring to a salty or sweet filling, like in the expressions 'jam puff', 'cream puff' or 'cheese puff' (para. 29). However, considering that all the relevant goods in class 34 have to do with tobacco and tobacco substitutes, the relevant public of these goods would perceive the sign in the context of smoking. The GC confirmed BoA's interpretation of the meaning of this expression and found that this expression would be perceived as 'as delicious smoke or delicious smoking' (paras. 32-34). As such this expression was not merely allusive but had a direct, descriptive meaning in relation to the goods in question because it described a good taste of the goods or in relation to the articles used with tobacco, their ability to enhance the good taste of tobacco or its substitutes (para. 35).

The applicant also argued that by refusing the registration of the application BoA violated the principle of equal treatment and good administration, because a similar trade mark with the expression 'tasty puff' was accepted by the Office for goods in class 34. To this argumentation the GC observed that the principles of equal treatment and good administration have to be in line with the principle of legality. The examination of any registration application must be stringent and full in order to prevent trade marks from being improperly registered. That examination must be undertaken in each individual case. The registration of a sign as a mark depends on specific criteria, which are applicable in the factual circumstances of the particular case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal the infringement (para. 37). A potential mistake committed in other proceedings cannot be used to obtain a registration in violation of the Article 7 EUTMR (para. 38).

Since the application is to be refused on the basis of Article 7(1)(c) EUTMR there was not need to examine Article 7(1)(b) EUTMR.

**Case T-30/16; M.I. Industries, Inc. v EUIPO;  
Judgment of 15 February 2017;**

**Language of the case: EN**

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton  
Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



**RESULT: Action partially upheld (BoA decision partially annulled)**

**KEYWORDS: Proof of use, Declarations, Nature of use, Likelihood of confusion**

**FACTS:** The applicant sought to register the figurative mark represented below as an EUTM for goods in Class 31. An opposition based on the earlier word marks **INSTINCT** and **NATURE'S VARIETY** both, registered for goods in Class 31, was filed pursuant to Article 8(1) (b) EUTMR. The Opposition Division (OD) dismissed the opposition. It considered that the opponent had not proven the genuine use of the earlier mark **INSTINCT** and that there would be no likelihood of confusion with the earlier mark **NATURE'S VARIETY**. The Board of Appeal (BoA) dismissed the opponent's appeal. It examined the genuine use of both earlier marks. It found that the nature of the use had not been proven as the trade marks had not been used publicly and outwardly. Moreover, with regards to **NATURE'S VARIETY**, it found that the evidence did not show that the mark had been used as a mark. The applicant filed an action before the General Court (GC) relying on three pleas in law: (i) infringement of Article 42(2) EUTMR and Rules 22(3) and (4) EUTMIR; (ii) infringement of Article 8(1)(b) EUTMR; and (iii) infringement of Article 75 EUTMR. The GC partly upheld the appeal. It found that BoA wrongly assessed the evidence of use of

the mark **INSTINCT**. However, it confirmed BoA conclusion that the evidence did not show that **NATURE'S VARIETY** had been used as a trade mark. It considered the second plea as ineffective as BoA had not taken position on likelihood of confusion (LOC). It dismissed the third plea.

EUTMA	Earlier marks
	

**SUBSTANCE:** ADMISSIBILITY OF NEW EVIDENCE: the GC rejects the Office claim that colour copies of previously submitted evidence in black and white is inadmissible (para. 17). As regards the first plea, the GC considers BoA reasoning incorrect in various respects. VALUE OF AFFIDAVIT: reviewing the case-law on affidavits, the GC considers that the BoA erred in considering that the affidavit by the owner of Cat's Country (which distributed the opponent's goods in Germany) is of lesser probative value. In the present case, the existence of contractual links does not, on its own, mean that the affidavit is not that of a third party. The affidavit should have been considered as coming from an independent source and the case is not analogous to T-250/13 SMART WATER (paras. 35-48). GENUINE USE OF 'INSTINCT': the GC considers that BoA erred in concluding that, in light of the evidence, the goods delivered to

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

■ European Cooperation working groups meet at EUIPO  
 ■ Closure of EU-ASEAN project on protection of IP rights

## More News

■ EUIPO at INTA 2016  
 ■ IP Case Law Laboratory  
 ■ IP for Paralegals

## Case Law

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

## Case Law



Cat's Country had not actually entered the German market. In view of case law (T-524/12 RECARO), outward use does not necessarily mean that use is aimed at end consumers (paras. 55-58). Moreover, sales to a single customer does not a priority preclude use being genuine (C-416/04P VITAFRUIT) (para. 59). GENUINE USE OF 'NATURE'S VARIETY': GC confirms that the use is not of a trade mark. It reviews the evidence and points why the sign has been used as a company name (invoices, affidavit, mock-up of a label) (paras. 67-73). LOC: as BoA did not take position on LOC, the plea is ineffective (paras. 74-78). LACK OF REASONING: GC dismisses the opponent's claims on the failure to state reasons (paras. 79-86).

**Case T-130/16; Coesia SpA v EUIPO; Judgment of 31 January 2017;**

**Language of the case: IT**

**RESULT: Action upheld (BoA decision annulled)**

**KEYWORDS: Descriptive element, Figurative element, Figurative trade mark, Specialised public**

**FACTS:** An application for registration of the figurative mark represented below as an EU trade mark was filed for a range of goods and services in Classes 7, 35, 37 and 42. The examiner rejected the application on the ground that the mark applied for was devoid of any distinctive character within the

meaning of Article 7(1)(b) EUTMR. The Second Board of Appeal (BoA) dismissed the appeal filed against the examiner's decision and confirmed that the mark applied for fell into the prohibition of Article 7(1)(b) EUTMR. The applicant claimed two pleas in law, alleging an infringement of Article 7(1)(b) EUTMR, and an infringement of the duty to state reasons.

### EUTMA



**SUBSTANCE:** The GC confirmed that the goods and services concerned are mostly targeted at professional consumers whose level of level of attention is greater than that of the general public (para 16). The applicant claimed in particular that the BoA totally omitted to take into consideration the level of attention of the relevant public. In that regard the GC held that the fact that the relevant public is a specialist one cannot have a decisive influence on the legal criteria used to assess the distinctive character of a sign. Although it is true that the degree of attention of the relevant specialist public is, by definition, higher than that of the average consumer, it does not necessarily follow that a weaker distinctive character of a sign

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



is sufficient where the relevant public is specialist. The GC observed, however, that it does not follow from the previous considerations that the level of attention of the relevant public is not to be taken into consideration at the moment of assessing the distinctive character of a trade mark (paras 20-22). In the light of the foregoing, the GC noted that the BoA did not mention of having considered that level of attention at the time of the assessment of distinctive character of the mark at issue, and that a total abstention from considering such level of attention will be inconsistent with the relevant case-law. Therefore, the GC found that the BoA did not apply Article 7(1)(b) EUTMR in conformity to one of the essential criteria established by the case-law (paras 20-26). The first plea of the applicant was thus upheld and the contested decision was annulled by the GC without need to examine the second plea in law.

**Case T-400/16; Maximum Play, Inc v EUIPO; Judgment of 9 March 2017;**

**Language of the case:** EN

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive element

**FACTS:** The applicant sought to register the word mark MAXPLAY as an EUTM for goods and services in Classes 9, 41 and 42. The Office refused the registration of the EUTM application (EUTMA) pursuant to

Article 7(1)(b) and (c) EUTMR, as it was found to be descriptive and devoid of distinctive character. The Board of Appeal (BoA) dismissed the applicant's appeal. It found that 'MAXPLAY' would be perceived immediately and intuitively as meaning 'maximum play' or 'best play'. The mark was therefore descriptive as a whole for the relevant goods and services. It further considered that the mark was devoid of any distinctive character. The applicant filed an action before the General Court (GC) relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR and (ii) infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal. It confirmed that the trade mark was descriptive and therefore non distinctive.

### EUTMA

### MAXPLAY

**SUBSTANCE:** DESCRIPTIVENESS: the GC applies the case-law on compound word signs and considers that these marks may be assessed, in part in relation to each of the elements forming the mark but also, in any event, in relation to the mark as a whole. Contrary to the applicant's views, the BoA not only assessed each of the elements but also examined the overall impression created by the mark (paras. 27-29). The GC confirms the definitions of 'MAX'

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton  
Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



and 'PLAY' and that the expression 'MAXPLAY' does not contain any unusual element in its syntax so it is nothing but the mere combination of 'MAX' and 'PLAY' (paras. 32-34). Taking into account the relevant goods and services, the relevant consumer will perceive the mark as referring to extended abilities, enhanced performance or best solution offered by the goods or services (para. 35). The fact that the term does not appear in dictionaries does not affect this fact (paras. 36-38). The GC dismisses the applicant's claims on analogy with the case T-749/14 Aroma (para. 39), the fact that 'MAX' is also a male first name (paras. 40-41) and the fact that the mark has been registered in the US (paras. 42-43). Finally, the GC dismisses, on the basis of settled case-law, the applicant's claim that the Office had accepted registrations of trade marks with the term 'MAX' (paras. 44-50). **DISTINCTIVENESS:** the GC confirms that insofar one of the absolute grounds for refusal in Article 7(1) EUTMR applies, the sign is ineligible for registration. Therefore the second plea is rejected.

## First Page

---

- Second phase of legislative changes: 1 October 2017

James Nurton  
Interviews | Yann Basire

---

## Statistical Highlights

---

- March 2017

## ETMDN Updates

---

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

---

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

---

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

## Case Law



### New Decisions from the Boards of Appeal

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

**R0710/2016-1**

#### ROTON

**ROTON (fig.) / rotor**

**RESULT:** Decision annulled

**KEYWORDS:** Competence of the Boards, Representative.

**NORMS:** Rule 15(2)(h)(ii) CTMIR, Article 64(1) EUTMR, Article 92(2) EUTMR, Article 92(3) EUTMR, Article 93(1) EUTMR

**FACTS:** An opposition was filed against the published trade mark application. The Opposition Division upheld the opposition claiming that there was a likelihood of confusion. After the applicant filed an appeal against the contested decision – the Registry of the Boards of Appeal, having receiving information from the duly notified earlier representatives that they were

no longer representing the opponent – informed the opponent that, as it was not based within the European Union, it would be necessary for it to appoint a professional representative.

**SUBSTANCE:** The opponent is a Chinese company which has neither its domicile, its principal place of business nor a real and effective industrial or commercial establishment in the European Economic Area. Therefore, as a substantial procedural requirement, it needs to be represented in all proceedings other than the filing of an application for an EU trade mark (§ 16-17).

The opponent has neither replied to the Registry nor appointed a representative. Given that the opponent failed to remedy this deficiency within the set time-limit, it follows that failing to comply with the substantial procedural requirement of Article 92(2) EUTMR, the opposition must be rejected (§ 21 22).

**R0860/2016-5**



**EAR (fig.) /**



**APPLE BITE (fig.) et al.**

**RESULT:** Decision confirmed

**KEYWORDS:** Conceptual similarity, Distinctive element, Due cause, Figurative element, Figurative trade mark, Identity between the goods and services, Nature of the goods and services, Phonetic

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



dissimilarity, Purpose of the goods and services, Reputation, Scope of proceedings, Similarity between the goods and services, Specialised public, Unfair advantage, Visual similarity.

**NORMS:** Article 8(5) EUTMR

**FACTS:** An opposition was filed against the published trade mark application 'PEAR' as represented above. The opposition was based on several earlier rights, but the Board primarily took the 'APPLE BITE' trade mark, as represented above, into consideration for which reputation under Article 8(5) EUTMR was claimed. The Opposition Division upheld the opposition.

**SUBSTANCE:** The Board found that there is a remote visual similarity and a low level of conceptual similarity between the marks. It follows from case-law, that the existence of a visual and conceptual similarity, however faint, is a precondition for the application of Article 8(5) EUTMR and that the degree of similarity is a relevant factor in determining whether there is a link between those signs (judgment of 11/12/2014, T-480/12, MASTER, EU:T:2014:1062, § 73) (§ 33). The evidence submitted by the opponent before the Opposition Division provides enough proof to determine that the earlier Apple logo had acquired a high degree of reputation for the relevant goods and services in the relevant territory before the filing of the contested application (§ 36).

As regards unfair advantage, according to the Board the applicant has sought to mimic the iconic image of an apple by taking the fruit which is closest to that image, namely a pear, and riding on the coat-tails of the Apple brand's customer base (§ 60).

The Board concludes, in line with the Opposition Division, that in view of the substantial exposure of the public to the opponent's earlier reputed mark there exists a probability that the use without due cause of the contested sign may acquire some unearned benefit and lead to free-riding, that is to say, it would take unfair advantage of the earlier trade mark's distinctive character and repute (§ 66).

Accordingly, the appeal is dismissed and the contested decision is confirmed.

**R1841/2016-4**

**STREAMLINE TANKERS GMBH (fig.)**

**RESULT:** Decision annulled

**KEYWORDS:** Descriptive element, Distinctive element, Figurative element, Nature of goods and services.

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



## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



**FACTS:** The applicant sought to register the figurative mark (international registration designating the European Union) as represented above for goods and services in Classes 12, 35 and 39. The examiner rejected the application on the basis of Article 7(1)(b) and (c) EUTMR, in conjunction with Article 7(2) EUTMR.

**SUBSTANCE:** Given that 'STREAMLINE' does not describe the goods and services in issue, the same must hold true for the sign considered as a whole since it does not consist exclusively of indications that could serve in trade to describe the goods and services applied for within the meaning of Article 7(1)(c) EUTMR. Notwithstanding the fact that the word 'TANKERS' is descriptive of vessels and tankers and that the figurative element of wavy lines appears to be rather plain, the sign as a whole does not inform consumers of any characteristics of the goods and services in issue (§ 13). The examiner based the refusal of the mark as being non-distinctive on its descriptive nature. As explained above, the relevant public will not perceive a descriptive meaning in the mark in relation to the goods and services applied for. Other reasons to deny the sign protection have not been brought forward by the examiner and are not apparent to the Board. It follows that the contested decision to refuse the international registration protection in the European Union on the basis of Article 7(1)(b) and (c) EUTMR and

Article 7(2) EUTMR must be annulled. The Office will have to inform the International Bureau of WIPO that the refusal of protection is withdrawn in accordance with Rule 113(2)(a) CTMIR (§ 16-18).

### R1898/2016-2 Sensorik4.0 – EN

**RESULT:** Decision annulled

**KEYWORDS:** Descriptive element, Nature of the goods and services, Purpose of the goods and services, Specialised public.

**NORMS:** Article 7(1)(c) EUTMR.

**FACTS:** The applicant sought to register the word mark (international registration designating the EU) 'Sensorik4.0' for goods and services in Classes 9 and 42. The examiner refused the application on the basis of Article 7(1)(b) and (c), in conjunction with Article 7(2), EUTMR.

**SUBSTANCE:** The Board is satisfied that the relevant professional trade circles will perceive 'Sensorik4.0' as a meaningful expression, i.e. sensor technology for or within the framework of Industry 4.0, referring to the specific technical characteristics, kind and intended purpose of the goods and services, namely that they are either sensors, sensor systems and/or electronic parts and accessories for sensors and sensor systems or specialist software and hardware

## First Page

■ Second phase of legislative changes: 1 October 2017

James Nurton  
Interviews | Yann Basire

## Statistical Highlights

■ March 2017

## ETMDN Updates

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

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

## Case Law



for sensor systems as well as technical and specific computer technology services within the field of sensor technology in connection with Industry 4.0, and, thus, not as a commercial name pointing to a particular undertaking (§ 24).

The relationship between the goods and services and the contested mark is, therefore, direct and close. The combination of the words in the contested mark does not create an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed.

The relevant public will have no difficulty in comprehending that the contested mark designates the kind, characteristics and intended purpose of the goods and services. The contested mark consists of elements, all of which are descriptive of the goods and services in respect of which registration is sought. The combination of the word elements does not create an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed (§ 25).

The appeal is dismissed.

## First Page

---

- Second phase of legislative changes: 1 October 2017

James Nurton  
Interviews | Yann Basire

---

## Statistical Highlights

---

- March 2017

## ETMDN Updates

---

- European Cooperation working groups meet at EUIPO
- Closure of EU-ASEAN project on protection of IP rights

## More News

---

- EUIPO at INTA 2016
- IP Case Law Laboratory
- IP for Paralegals

## Case Law

---

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