

Alicante News

Up to date information on IP and EUIPO-related matters



**European
Cooperation
towards 2020**



Renata Righetti talks to James Nurton

First Page

- European Cooperation at EUIPO

James Nurton
Interviews

Kate O'Rourke

Registered Community Design

- Evidence of proof of lack of novelty and individual character

Statistical Highlights

- August 2016

ETMDN Updates

- UKIPO implements Back Office for Designs
- Ireland implements e-Services
- Data update of International Registrations in TMview

More News

- FAQs on Copyright – Providing help for consumers
- EUIPO performance update

Case Law

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



First Page



European Cooperation at EUIPO

On September 12-15, over 100 experts from EU Intellectual property offices and user associations met to begin work on the European Cooperation Projects in EUIPO's headquarters in Alicante.

These projects build on the success of the Cooperation Fund and the Convergence Programme.

The Cooperation Fund was created in 2009 to enhance the user experience, support the provision of information and common tools, and provide better platforms for enforcement of IP rights. Over time, joint teams of experts from the private and public sector succeeded in building 20 separate specialised projects, from search engines like DesignView to trade mark and design e-filing for national and regional EU IP offices. No less than 12 separate back offices were also built, and are expected to lead to significant gains in service provision to users by European Intellectual Property Offices.

To date nearly 400 tool and e-service implementations of its projects have taken place across the EU.

The Convergence Programme, which began in 2011, set out to support EU IPOs in converging practice on the granting of IP rights. This is part of an overall harmonisation effort aimed at improving IP protection across jurisdictions.

The programme consisted of seven projects, five for trade marks and two for designs, which linked EUIPO with national and regional IP offices and user associations, and has succeeded in bringing practices significantly closer together over time.

Now the European Cooperation projects seek to expand and build on the work done in the Cooperation Fund and the Convergence Programme. Article 123 (c) of the amended EU trade mark regulation has institutionalised cooperation as one

of the core competencies of EUIPO, and a new Strategic Plan has been launched for the Office, with European Cooperation and its new projects at its heart.

Between now and 2020, work will intensify on the projects, which are grouped into five strands. Each strand responds to a different identified need.

- ECP 1 consolidates and completes the Cooperation Fund landscape, allowing the benefits of the original Fund projects to be reaped by IP offices that could benefit from tools that they have not yet implemented.
- ECP 2 concentrates on delivering major improvements to the existing Cooperation Fund tools, in conjunction with users, updating and modernising them in accordance with user needs and taking advantage of the opportunities offered by new technology.
- ECP3 develops new tools: solutions to improve trade mark searches and examiner workflows, among others.
- ECP 4 concentrates on shared services and practices, including convergence of practices.
- ECP 5 supports the network with initiatives like deployed project managers for the national and regional IP offices and technical support certification.

The projects themselves were each chosen to respond to an identified need, and developed in collaboration with partners and stakeholders. Earlier this year, a consultation process took place on each of the projects, with national and regional EU IP offices, international IP office partners, user groups and the general public invited to send feedback on what was proposed via the [EUIPO website](#).



First Page



The working group phase involves representatives from national and regional EU IP offices, users and international organisations working with project teams to develop the projects during their lifespan, securing enhanced benefits and making sure that the projects remain relevant, while supporting their coordination through the Management Board of the EUIPO.

The aim is to build and develop projects that will support the network built during the lifetime of the first Strategic Plan at EUIPO, and which will have real and lasting benefit for users.



The James Nurton Interview



Renata Righetti, Bugnion, Milan, Italy

What's your background?

I never thought to become a trade mark attorney or lawyer; I wanted to be a teacher. Then I didn't find any special interest in anything in particular so I decided to accept what my father had been asking me to accept for many years.

He was the one who started our firm and he decided it was time to have a newsletter for clients and prospects, and he needed someone to take care of it. As my studies were literature and arts he thought maybe I was the one to take charge of this.

So I joined the firm and I took care of the newsletter, and the information to be shared between different offices, and I started to learn about IP, but as I said I didn't study law or have any technical background. I started to work on trade marks and for a while I was also in charge of the international incoming work, as far as trade marks were concerned.

At that time we didn't have the European system, so it was many years ago, mid-1980s. Then I started to take care of some Italian clients and some international clients and so on,



Renata Righetti

more or less until the end of the 1990s. At the beginning of the 2000s I became much more in charge of managing the firm.

Are family-run firms still common?

Most of the IP firms in Italy are still family organisations. Most of them date back to the nineteenth century: the oldest are older than Italy itself as a country! In Turin they started to work on IP before Italy was an independent state.

Our firm was only started at the end of the 1960s. At a certain time there was a need for someone to take over and chair matters, management and so on, and that is what I did. My son is 29; he studied economics, then joined the firm and passed the trade mark attorney exam recently, and now he is a young member of AIPPI.

What do you do now?

Over the last few years we have hired an executive director, so I am now president of the Board and I work with people, try to build a team and make strategic plans together with the Board. But at least half of my time is devoted to AIPPI, mainly because almost three years ago I was elected president of the Italian group.

When I became president of the national group I decided that the activities of the group had to be implemented, so we changed some things and we organised a lot of events. We took advantage of the Expo in Milan last year and the Feeding the Planet project. We decided to organise three events over four full days, together with the regional authorities and universities, on different aspects of IP and food – two days devoted to geographical indications and trade marks, one day devoted to design and food, and one day devoted to food and innovation – patenting and food.

But we have also focused on many different issues. For example, we had a three-day seminar in Bologna on patent



The James Nurton Interview



drafting and negotiating and prosecution issues specifically for patent attorneys. Then we had an event in Padua on anti-counterfeiting and the web, with more than 200 people in attendance, and a nice seminar in Rome hosted and organised with the Italian Patent and Trade Mark Office in their premises, focused on smartphones.

AIPPI Italy has 570 members – we have increased a lot over the past years. Some of the other AIPPI groups are a branch of larger organisations, as is the case in Germany, Brazil and the US, but we are just on our own, and not linked to anyone else. So I think we are one of the largest AIPPI national groups.

What IP issues are particularly important in Italy?

Italy is the country with the largest number of GI registrations in the EU by a long way, ahead of France. I think this is absolutely relevant for us, but what I would like to underline is that we are not only food and fashion and design and natural products.

Milan is the second-most industrialised area in Europe, so there are a lot of very sophisticated technologies. In the profession, too, I think that we have very skilled people in Italy – a lot of European trade mark, patent and design attorneys.

Tell me more about AIPPI?

This month I was elected second vice-president of AIPPI for one year. Eventually I will be elected first vice-president next year and then in 2018 president. I will be the first ever woman to have this role in AIPPI. It will be a great honour.

AIPPI also has Sarah Matheson who is Reporter General and she is the very first woman to hold that role and we will have the first woman Secretary General in a couple of years. Things are changing. It used to be very rare even to see a woman even in the audience at AIPPI Executive Council meetings. Now the profession is changing and not just in trade marks

and designs, where women used to do more work. We now have a lot of women in the profession, though it depends on the country. In the former Soviet Union and Eastern Europe for example there were a lot of women who were involved in technology as engineers, chemists and physicians.

What can be done to encourage more women to work in IP?

It depends on many things. I never thought about studying science when I was young – I liked to study literature and history. Nowadays in Italy the number of young girls studying technology at university is increasing. And generally high-level education for women is improving all over the world. For example, the Italian astronaut Samantha Cristoforetti spent 200 days in space and she showed young girls that they can do that too.

US firms have specific programmes for LGBT diversity etc., but apparently that doesn't exist in Italy. I think a lot depends on the culture of the firm. All over the western hemisphere this is becoming a reality, for example we now have civil unions for people of the same gender in Italy. It's the way we are going, but there is still a long way to go. I think the legal profession is generally more open-minded than some other sectors.

What work does your firm do?

We have just over 200 people, about 70 of them patent and trade mark attorneys, plus some trainees. We are a company which means we cannot handle litigation so we have a strong relation with a separate legal entity called Bugnion Legal that we work with for litigation purposes, and they have about 20 litigators. They are not in the same building but we work together every day.

We have 12 offices in Italy, the biggest ones are in Milan and Bologna and some of the others are very small. According to official statistics, the Bologna area has the most patent



The James Nurton Interview



applications per person in Italy. They have the oldest university in the world, and so-called packaging valley, and different industrial areas for tiles, automotives, agricultural products and others.

Several years ago Italy introduced trade mark oppositions, which was a new thing, and this is very similar to the EU system. Sometimes the decisions are absolutely in agreement with EUIPO decisions and sometimes there are differences so it's difficult to predict the outcome. It's becoming more and more popular.

We are the largest filer of trade marks in Italy and second in Europe for designs. We also do many European patent and opposition cases mainly for domestic clients.

Is EU system doing a good job?

Generally yes, even if some things are not so easily understandable. Some decisions are not obvious and we do not always share the opinion of the examiner. But the system is working well with the electronic filing and it is more efficient most of the time.

However, while there is a lot of pushing towards unified rights for trade marks, designs and even now patents and while we are all in favour of Europe, there are some concerns that the new system may be too costly and in some specific areas people may return to national filings.

I don't see any problem with the registered Community design. It is very helpful and inexpensive. Non-Europeans didn't understand the system very much and they could use it more than they do – but it depends on the culture. The US approach to designs is very different from what we have. It is something that will develop over the coming years as a weapon that IP owners can use. It doesn't cost very much and you can file any number of shapes at EUIPO.

In trade marks there are some judgments and oppositions that are much more controversial than they used to be. It seems to me they try to be more strict than they used to be.



Registered Community Design



Evidence of proof of lack of novelty and individual character

Case T-420/15; Thun 1794 a.s. v EUIPO; Judgment of 14 June 2016; Language of the case: CZ .

The CJEU recently delivered a judgment in which the court rejected an invalidity action for insufficient proof of disclosure of a prior design.

The contested Community design (RCD) (shown below) was registered as a graphic symbol in 2007 and renewed in 2012. By nature it is a traditional porcelain decoration. In 2014, it faced an invalidity action before the Office and the core issue in the case was whether the evidence supporting the invalidity ground of lack of novelty and individual character of the challenged design was sufficient or not.

According to the invalidity applicant, a porcelain set sold under the trade name 'Bernadotte' was manufactured in the 'interwar period of the 20th century' and revitalised in 1968 to the appearance of the registered design. In support of these arguments, the invalidity applicant submitted an expert report on the history of 'Bernadotte' porcelain and its typical motif, which also contained images of a 'Bernadotte' porcelain set. The images were taken from a German publication, *Glasrevue*, published in 1971. Furthermore, the invalidity applicant submitted an undated catalogue of 'Bernadotte' porcelain, and a plate as a sample with an imprint reading 'Czechoslovakia', an indication that the sample must have been manufactured before 1993, the year when the former Czechoslovakia came to the end of its existence.

The Invalidity Division (ID) declared the contested RCD invalid for lack of novelty. It reasoned in its decision that the catalogue provided by the invalidity applicant was all about various 'Bernadotte' porcelain items, which typically showed the same contours, with the surface relief clearly visible in some of the

items and highly similar to the contested RCD. Some of the items from one of the porcelain sets shown in the catalogue were apparently published in the German *Glasrevue*, thus the ID inferred that the items with that particular decoration must have been known to the public prior to the RCD filing date. The plate sample submitted bearing the indication of time of its manufacture prior to 1993 also supported this finding.

In the appeal, the holder argued that the catalogue of the 'Bernadotte' porcelain was undated, the designs under comparison were not identical, the quality of the photographs in the German magazine was too low to be compared with the contested design, and that the colourful decoration on the published items, which was the only decoration clearly visible in the photos, was a quite usual decorative element and it was clearly different from the contested design. The plate sample was created on purpose by the invalidity applicant since it is the porcelain manufacturer. According to the holder, the evidence submitted was not sufficient to prove the lack of novelty of the challenged design.

The Third Board of Appeal (BoA) agreed with the holder, ruling that insufficient solid and objective evidence had been submitted to conclude that a prior identical design had been made available to the public before the date of filing of the RCD. The catalogue was undated, as was correctly pointed out by the design holder. The catalogue text, although it mentioned that the manufacturer had been known for several decades for its wide range of the famous 'Bernadotte' shape evoking the Baroque style by its purity of fine relief, did not mention those particular items on which the first instance invalidity decision was based; there was no indication, nor was it even claimed that the specific 'Bernadotte' set shown in the German magazine would contain a relief that would resemble the contested RCD, and it was not apparent from the images in the published magazine. The specific design of the plate submitted as a sample was not included in the catalogue, nor was there any other indication that this specific plate design



Registered Community Design



would have been made public at some point in time and even less for at which point in time. Even if it were accepted that the fact that it contained the word Czechoslovakia placed the origin of the plate before 1993, this could perhaps be accepted as somehow defining the date of production, but it did not prove that it had been made public at some point before 1993, or even that it was made public at all.

In the appeal to the General Court (GC), the invalidity applicant argued that the BoA did not consider satisfactorily, nor even take into account the fact that the catalogue was produced for a company that ceased operations in 2008, so this catalogue must have been printed no later than 2007. In addition, the catalogue was not dated because it had to include a few seasons, since the 'Bernadotte' products were porcelain with a classic historical shape, which were not subject to fashion trends. Regarding the plate bearing its date of manufacture (1993), the applicant stated that for the invalidity proceedings it was not the colourful ornament on that plate that did not match any of the ornaments illustrated in the catalogue of 'Bernadotte' porcelain but the relief, an argument that the BoA did not take into account. Accordingly, the BoA did not take into account the other evidence submitted either — the expert report and technical papers spanning the history of 'Bernadotte' porcelain with its typical relief.

According to the GC, the BoA did not err in its assessment of the evidence and rejected the appeal to its full extent. It ruled that according to the applicant's information, the catalogue could have been produced prior to the commencement of insolvency proceedings in September 2008, and, therefore, not prior to the RCD filing date. Furthermore, it could not be reasonably assumed that the claimed typical relief appeared on each of the porcelain 'Bernadotte' products shown in the evidence, or even assuming that this were so, it would be the same relief located on the sample plate, and even the relief forming the contested design. This is all the more so because the images originating from the magazine *Glasrevue* or from

an undated catalogue did not include any representation of the sample plate. The expert report did not prove that the representation of 'Bernadotte' porcelain, especially with the decoration shown in the catalogue, coincided with the decoration of the set in the illustrations of the magazine that was disclosed to the public before the contested design's filing date.

The judgment and the course of the proceedings demonstrate once again how the solid evidence of state of the art is crucial in design invalidity actions. As has been ruled many times by both the BoA and the GC, the onus is on the invalidity applicant to prove the disclosure of the earlier designs. There are no provisions in the CDR or the CDIR as to the kind or specific form of evidence the invalidity applicant is required to submit to prove that the prior design on which the application for a declaration of invalidity is based has been made available to the public before the relevant date. Article 28(1)(b)(v) CDIR only states that where the ground for invalidity is that the RCD does not fulfil the requirements set out in Article 5 or 6 CDR, the indication and the reproduction of the prior designs that could form an obstacle to the novelty or individual character of the RCD, as well as documents proving the existence of those earlier designs have to be contained in the application. In this regard, the disclosure of an earlier design cannot be proved by means of probabilities or suppositions, but must be based on solid and objective evidence that proves that the earlier design was made available to the public within the meaning of Article 7 CDR (judgment of 09/03/2012, T-450/08, *Phials*, EU:T:2012:117, § 24).

To see the CJEU judgment click [T-420/15](#)



Registered Community Design



Contested [RCD 000840400-0001](#)



Glasrevue, 26, 1971, s. 151:



The porcelain plate sample:





Registered Community Design



Catalogue of porcelain 'Bernadotte':



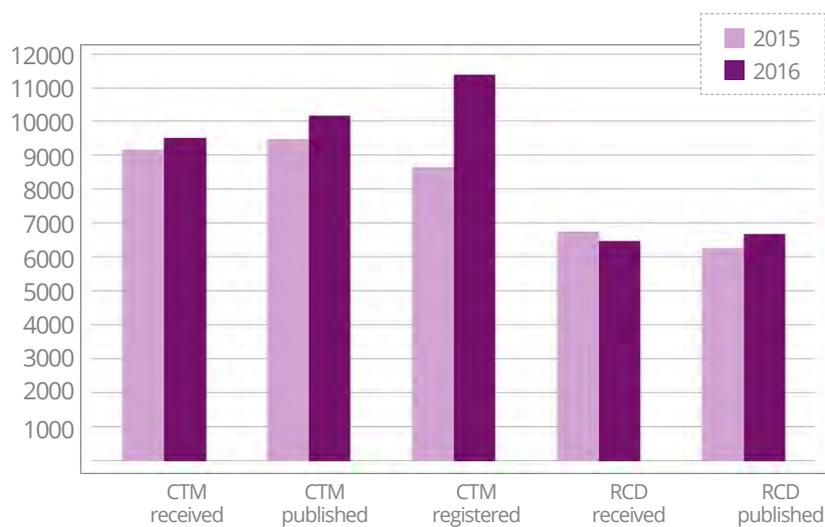


Statistical Highlights



Monthly statistical highlights August*	2015	2016
Community Trade Mark applications received	9 181	9 531
Community Trade Mark applications published	9 465	10 171
Community Trade Marks registered (certificates issued)	8 654	11 386
Registered Community Designs received	6 760	6 488
Registered Community Designs published	6 260	6 685

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





ETMDN Updates



UKIPO implements Back Office for Designs

On 5 September 2016, the Intellectual Property Office of the United Kingdom (UK IPO) saw the live launch of its Back Office for Designs.

The tool is part of the Software Package developed largely under the previous Cooperation Fund framework, but taken forward and completed as part of the new European Cooperation Projects (ECP1).

This implementation by the UK means that eleven of the twelve European IP offices who wished to implement the Back Office software package now have systems up and running.

The Back Office tool helps the UK IPO to manage multiple tasks related to the Designs lifecycle, including the examination, the registration and the modification through several recordal dossiers.

This latest implementation by the UK IPO also means that the Cooperation Fund has reached a total of 373 project deployments across the European Union IP Offices.

It is also the first implementation completed under new European Cooperation Projects (ECP1) portfolio.

Ireland implements e-Services

On 16 September 2016, the Irish Patents Office announced its implementation of the SP e-Services project.

The new facility expands the range of fee types that can be paid online to include all national Trade Mark and Design fee types and allows users and agents to submit a range of requests and pay relevant fees after the initial filing.

In addition, all documentation associated with a particular fee type can be uploaded and submitted via the new tool.

The e-Services project has also developed a set of web-based

tools for European IP Offices to facilitate the electronic filing of trade mark oppositions, trade mark and design registrations and renewals, trade mark cancellations and design invalidities.

This latest implementation is a result of collaborative work between Irish and EUIPO technical experts.

Data update of International Registrations in TMview

As of 19 September 2016 the International Registrations (IR) from the World Intellectual Property Organization (WIPO) have been updated in TMview.

This means that WIPO now also provide IRs in the Filed, Ended and Expired statuses as well as more detailed information on Recordals.



More News



FAQs on Copyright – Providing help for consumers

The European Observatory on Infringements of Intellectual Property Rights has launched a [new online initiative](#) providing answers to 15 of the most common questions European consumers have regarding copyright in the digital environment.

The questions range from very general ones such as ‘Who owns copyright?’ or ‘What does infringement mean?’ to more specific ones about streaming and downloading or the use of protected works on social media platforms.

28 national copyright experts have replied to the FAQs for their respective EU Member State. Furthermore, representatives of national public authorities as well as Observatory stakeholders have provided their input.

The answers will be reviewed regularly to keep them up-to-date in the future. The status date published together with the respective answers indicates the last update.

These FAQs aim to provide guidance to consumers and answer uncertainties they might have regarding copyright in the digital environment; they do not seek to provide legal advice.

The FAQs are [available](#) in at least one official language of the country they refer to and in English.

EUIPO performance update

On August 10, EUIPO published the 2016-Q2 results for timeliness, quality and accessibility.

The Office is [committed to improving](#) the quality and timeliness of its decisions. However, as the result of a significant rise in the applications received by the Office last year and in the first half of 2016, several indicators have dropped. The Office is working to bring those indicators back to the compliance

level. In the next few months, the Office will implement several corrective and preventive actions.

All the Office accessibility indicators remain in “excellence”, which reflects the Office’s strong focus on supporting and listening to users.

For any comment or suggestions, please contact CGS@euipo.europa.eu.



Case law



Luxembourg trade mark and design news

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

Case C-226/15P; Apple and Pear Australia, Star Fruits Diffusion v EUIPO; Judgment of 21 July 2016; Language of the case: FR

RESULT: Appeal dismissed

KEYWORDS: Lack of reasoning, Res judicata, Reputation, Likelihood of confusion, Enhanced distinctiveness

FACTS: The other party sought to register the word mark ENGLISH PINK for goods in Class 31. Opposition pursuant to Article 8(1)(b) and Article 8(5) EUTMR, based on the word EUTM PINK LADY as well as on the figurative EUTMs below, all covering goods in Class 31. The Opposition Division (OD) dismissed the opposition. One year before adopting the contested decision, the Board of Appeal (BoA) was notified a final judgment of the Belgian CTM Court –Tribunal de Commerce de Bruxelles (TCB) - cancelling the Benelux mark ENGLISH PINK (which had been applied for at the same time as the identical ENGLISH PINK EUTM) because of likelihood of confusion (LOC) with the earlier PINK LADY EUTM and Benelux trademarks. The TCB found that the Benelux mark ENGLISH PINK infringes the PINK LADY marks (both EUTMs and Benelux) and prohibited the other party from using the sign PINK LADY within the EU. The TCB ruled that the PINK LADY EUTMs enjoy a high degree of protection and that there is a significant LOC between PINK LADY and ENGLISH PINK. The BoA transmitted the judgment and its translation to the other party, but the contested decision did not even mention it in the summary of the facts. The BoA rejected the opposition,

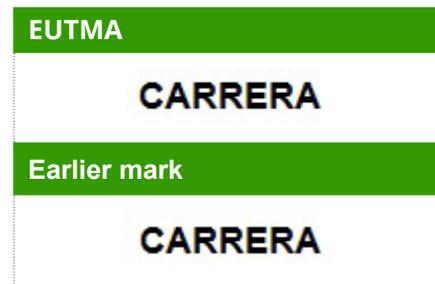
thereby taking the opposite view to the TCB: no enhanced distinctiveness, no Article 8(5) EUTMR, no LOC. General Court (GC): The BoA infringed Article 75 EUTMR because it did not mention the judgment of the TCB or explain why it did not take this new fact into consideration. The judgment of the TCB is, prima facie, a relevant factual element for resolving the case at hand, as there are essential common points between the factual aspects at issue. In failing to assess the potential impact of this judgment for the outcome of the dispute before it, the BoA failed to assess all the relevant factual aspects of the case with the required diligence and infringed the principle of sound administration. The GC stated further the judgment of the TCB is not in itself sufficient to enable the GC to alter the contested decision and to ascertain which decision the BoA was required to take. When exercising its exclusive jurisdiction over registration of EUTMs and when examining oppositions lodged against EUTM applications, the Office is not bound by a decision of a EUTM court delivered in an action for infringement. The unitary character of the CTM does not mean that the principle of res judicata precludes the Office and, consequently, the European courts, from examining the possible existence of a LOC in the context of the opposition proceedings concerning the registration of a new EUTM, even though it is identical to a national mark which has been held by a EUTM court to undermine the earlier EUTM.

SUBSTANCE: The CJ confirms that there is no provision in the EUTMR whereby the Office is bound by a decision of a EUTM court delivered in an action for infringement when it exercises its exclusive jurisdiction over registration of EUTMs and when, in so doing, it examines oppositions lodged against applications to register EUTMs (para. 48).

The CJ also confirms that the subject-matters of the proceedings before the TCB and the Office are not identical. The infringement action sought the annulment of the Benelux mark ENGLISH PINK and an order to refrain from using that sign throughout the territory of the Union, whilst the proceedings before the Office concerned opposition to the



Case law



registration of the EUTM ENGLISH PINK (para. 54).
The principle of res judicata does not impose that the BoA of the Office was bound by the judgment of the TCB (para. 64).

Case C-50/15P; Kurt Hesse v OHIM; Judgment of 21 January 2016; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Admissibility, Distortion of facts of evidence, Complementary goods and services

FACTS: The Opposition Division found the goods of the EUTMA in Class 9 and the goods in Class 12 of the earlier mark to be dissimilar and that the encroachment according to Article 8(5) EUTMR has not been shown. The Board of Appeal (BoA) reversed the decision and found that the goods were similar and the conditions for the application of Article 8(5) EUTMR were met. The General Court (GC) confirmed that finding of the BoA.

SUBSTANCE: The Court of Justice of the European Union (CJ) rejected the appellant's complaint that the GC did not assess all the relevant factors for the examination of the similarity of the goods. The GC took all those factors into account and stated that the existing complementary character of the goods leads to a similarity between them. The CJ confirmed that the complementarity is an independent factor which may on its own justify the finding of similarity (paras. 21 to 23).

To the extent that the appellant challenges the importance that the GC gave to the complementarity among all the other factors, this is a question of facts for which the CJ is not competent (para. 26).

The CJ confirmed the case-law that the findings if an earlier mark is reputed or not is a question of facts which cannot be an issue before the CJ. A distortion of facts has not been shown by the appellant (paras. 29 to 31).

The appellant's complaint referring to the wrong acceptance by the GC of a 'transfer of image' of the earlier mark is just a repetition of an argument brought already against the decision of the BoA (para. 34). Moreover the appellant's assumption of dissimilar goods is wrong, as the goods have been held by the GC as being similar (para. 35).



Case law



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

Case T-674/13; Gugler France v OHIM; Judgment of 28 January 2016; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Lack of reasoning, Company name, Bad faith, Claim for alteration of EUIPO decision

FACTS: The EUTM proprietor was granted the registration of the figurative mark represented below as an EUTM for goods and services in Classes 6, 17, 19, 22, 37, 39, 42. An application for invalidity was filed pursuant to Article 52(1)(b), and to Article 53(1)(c) in conjunction with Article 8(4) EUTMR. The Cancellation Division (CD) upheld the application for invalidity. The Board of Appeal (BoA) upheld the EUTM proprietor's appeal. The invalidity applicant filed an action before the General Court (GC) relying on two pleas in law: (i) infringement of Article 53(1)(c), read in conjunction with Article 8(4) EUTMR (ii) infringement of Article 52(1)(b) EUTMR. The GC upheld the appeal.

EUTM

SUBSTANCE: ON THE INFRINGEMENT OF ARTICLE 53(1)(C), READ IN CONJUNCTION WITH ARTICLE 8(4) EUTMR: First, although the fourth condition set out in Article 8(4) EUTMR – i.e. that an earlier sign must confer on its proprietor the right to prohibit the use of a subsequent trade mark - must be assessed in the light of the criteria set by national law, the BoA's analysis does not include any reference to the national law applicable, whether that reference is to legislation or to the case-law. Secondly, the BoA based its reasoning on the existence of an earlier company name and an earlier trade

name and on a 'trade mark GUGLER' belonging to the EUTM proprietor (who was producing the products that were sold and installed by the invalidity applicant), which, in its view, prevented the invalidity applicant from acquiring a right in the 'name "GUGLER"'. However, it is not sufficiently clear on what evidence the BoA based its assessment. Furthermore, the contested decision does not contain any mention of, or reference to, the right to the protection of a company name conferred by French law, or, a fortiori, the conditions laid down by French law which define the invalidity applicant's rights relating to the protection of its company name. The Office's explanations, according to which allowing the invalidity applicant to prohibit the use by the EUTM proprietor of the contested mark in France would have been contrary to Article 34 TFEU, cannot be regarded as supplementing a statement of reasons which is already self-sufficient, since they constitute a completely new statement of reasons. Hence, the BoA infringed the obligation to state reason imposed upon by Article 75 EUTMR (paras. 31-62).

ON THE INFRINGEMENT OF ARTICLE 52(1)(B) EUTMR: The BoA concluded that there was no bad faith on the part of the EUTM proprietor since when it filed for registration of the contested mark it had had an active business producing, selling and exporting doors and windows under the 'name "Gugler"' for many years and filing a EUTM application was therefore an 'obvious and completely justified action'. However it is not apparent whether the reference to the 'name "Gugler"' refers to the surname Gugler, the company name or trade name of Gugler GmbH or the "'Gugler" products', or even to all of those different elements. Moreover, the BoA took the view that that conclusion was not altered by the fact that the EUTM proprietor had not informed the invalidity applicant of the application for registration of the contested mark or of the existence of that mark, that the invalidity applicant was not aware of the existence of that mark, that other registrations, including a French one, had been filed afterwards in the name of Gugler Europe (a company formed, inter alia, by the EUTM proprietor and some founders of the invalidity applicant), that



Case law

Gugler Europe had, for whatever reason, obtained the invalidity applicant's consent at the time of filing the application for registration of the later French mark, that that latter mark had been licensed to the invalidity applicant and, lastly, that the EUTM proprietor had invoked the contested mark in a recent court action which had been brought against the invalidity applicant as a consequence of the distorted commercial relationship between the parties. The BoA however failed to explain in what way those facts, which corresponded to the invalidity applicant's argument, did not alter its conclusion that there was no bad faith on part of the EUTM proprietor. Hence, the BoA infringed the obligation to state reason imposed upon by Article 75 EUTMR (paras. 63-94).

ON THE REQUEST TO ALTER THE CONTESTED DECISION: The GC is not in a position to determine, on the basis of the matters of fact and of law examined by the BoA, to determine what decision the BoA was required to take and cannot therefore exercise its power to alter decisions (paras. 95-105).

Case T-335/14; José-Manuel Davó Lledó v OHIM; Judgment of 28 January 2016; Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Bad faith, Complementary evidence, Figurative trade mark, Unfair advantage

FACTS: The applicant registered the figurative sign DoggiS with the indication of the colour red represented below as an EUTM for goods and services within Classes 29, 30 and 43.

An application for invalidity was filed based inter alia on the several earlier figurative marks, DoggiS represented below, registered for goods in Classes 16, 25, 28, 29, 30, 32, 38, 39, 42, 43 and 60.

The Cancellation Division (CD) rejected the application for a declaration of invalidity in its entirety.

The Board of Appeal (BoA) annulled the decision of the CD and



declared the registration of the contested mark invalid. The applicant filed an action before the General Court (GC)

EUTM

Earlier marks



SUBSTANCE: The GC rejected the first plea emphasizing that the evidence adduced for the first time before the BoA by the invalidity applicants was actually relevant for the outcome of the dispute (para. 39) and that in fact such late production was mainly intended to address the CD's finding that they had not furnished sufficient proof (para. 38). The BoA was able to exercise its discretion objectively.

As to the second plea, it also finds the applicant acted in bad faith based on certain objective factors liable to shed light



Case law



to his intentions, such as the nature of the mark sought, the reputation of the marks in question and the commercial logic of which the filing of the application for registration

of the contested TM forms a part (para. 73). Also it finds the applicant acted with bad faith at the time he filed the application of registration of the contested mark. The fact that the EUTM proprietor sought to effect that registration was indisputably guided by the intention to take undue advantage of the rights attached to the marks belonging to the parties requesting the declaration of invalidity. That intention is confirmed *inter alia* by the manner in which the EUTM proprietor presents his franchise chain to the public (para. 89).

Case T-194/14; Bristol Global Co. Ltd v OHIM; Judgment of 28 January 2016; Language of the case: EN

RESULT: Action dismissed

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

FACTS: The applicant sought to register the figurative sign represented below for goods in Class 12. An opposition was filed *inter alia* on the basis of the earlier EU word marks BRIDGESTONE, STONE registered for goods in Class 12. The Opposition Division (OD) considered that since the EUTMA sought protection for the entire Class 12 heading and the applicant did not clarify its intentions, it shall be considered that the applicant's intention is to cover all the goods and services included in the alphabetical list of Class 12. OD upheld the opposition in so far as it was based on the earlier trade mark STONE. The Board of Appeal (BoA) upheld the decision of OD.

The applicant filed an action before the General Court (GC).

EUTMA

AEROSTONE

Earlier mark

STONE

SUBSTANCE: The GC rejected as unfounded the applicant's complain the BoA did not address all the arguments which it put forward before it (paras. 28-45).

The relevant public comprises members of the general public and specialised personnel in the European Union (para. 54).

Regarding the goods, "vehicles; apparatus for locomotion by land" and "apparatus for locomotion by air", on the one hand, and "automobile tyres", on the other, which were specifically referred to in the EUTMA, are, respectively, similar and identical to the goods covered by the earlier EUTM. (para. 14) "Apparatus for locomotion by water" specifically referred to in the EUTMA was dissimilar to the goods covered by the earlier EUTM (para. 15). There is similarity or an identity between the goods covered by the earlier EUTM, and the rest items in the alphabetical list for Class 12 covered by the EUTMA which did not fall within the natural and usual meaning of those general indications. (para. 16).

In spite of the fact that the element "aero" is situated at the beginning of the mark applied for, the element "stone" in that mark had to have at least equal weight (paras. 59-69).

The mere presence of the word element "aero" in the mark applied for cannot preclude the relevant public from perceiving the similarity between the marks at issue which results from the identity of the word element that they have in common, "stone", which is also longer than the word element "aero". Consequently, the marks at issue are visually similar (paras. 70-77).

In the light of the phonetic identity between the second



Case law

element of the mark applied for and the whole of the earlier mark, those marks are phonetically similar, notwithstanding the particular sound of the element “aero” (paras. 79-87). English-speaking consumers will perceive the mark applied for as the association of the prefix “aero” meaning “air” with the noun “stone” meaning “a solid non-metallic material”. In the light of the ambiguous nature of such an association, the element “stone” will retain a semi-independent role for English-speaking consumers (para. 92). Therefore, there is a conceptual similarity between the mark applied for and the earlier mark for part of the relevant public, namely the English-speaking consumers (paras. 88-97). There is a likelihood of confusion (paras. 98-110).

Case T-364/14; Penny-Market GmbH v OHIM; Judgment of 18 February 2016; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Phonetic identity, Visual similarity, Weak element

FACTS: The invalidity applicant requested the invalidity of the figurative mark as depicted below which is registered for foodstuff and drinks in Classes 29 to 32. The request was based on inter alia the earlier EUTM bo (word mark) registered for goods in Classes 29 to 32. The Board of Appeal (BoA) cancelled the contested EUTM, since it found that there was likelihood of confusion in the sense of Article 8(1)(b) EUTMR. The proprietor of the contested EUTM filed an appeal before the General Court (GC) claiming an infringement of Article 53(1)(a) EUTMR in connection with Article 8(1)(b) EUTMR.

SUBSTANCE: The (GC) confirms the assessment of the BoA as to the relevant consumers which will have a low up to a medium attentiveness. The foodstuff and drinks are goods for every day consumption and the public will in principle not examine them thoroughly (para. 17). The GC finds that the



EUTM



Earlier mark

bo

contested mark contains the combination of the letters ‘b’ and ‘o’ with an exclamation mark in-between together with a green rectangle (para. 22). The signs coincide in the letters, ‘b’ and ‘o’ because the earlier mark, being a word mark, is protected in all scripts (para. 23). The GC confirms the BoA to the extent that the exclamation mark will not be perceived as an ‘l’ which has been turned around. Furthermore, the exclamation mark is bigger than the letters and has a different script. Therefore, it will not be seen as forming a unity together with the letters ‘b’ and ‘o’. The contested mark will not be read as meaning ‘bio’ (paras. 25 and 26).

The green rectangle is banal and has no distinctive character (para. 27). The BoA was right in assessing that the marks have important visual similarities. The different assessments on the visual similarity in decisions at national level as well as those from the Office are not binding and refer to different factual situations (paras. 31 to 33). Aurally the marks are identical (para. 35) and conceptually none of them has a meaning (para. 38). As to the global assessment on likelihood of confusion the GC states that the earlier mark has an average distinctiveness. Consequently, taking the visual similarity and the aural identity and the identical and similar goods (undisputed by the applicant) into consideration, there is likelihood of confusion (para. 46).

The GC endorses the Intervener’s argument that even in short marks differences which have no consequence in the aural or visual perception in order to distinguish the signs, have no relevance (para. 49).



Case law



Case T-805/14; Stagecoach Group plc v EUIPO; Order of 25 May 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Descriptive element, Domain names, Laudatory mark

FACTS: The EUTM applicant sought to register the word sign MEGABUS.COM for goods and services in, inter alia, Classes 16, 35 and 39. The examiner rejected the application in respect of all the goods and the services mentioned. The Board of Appeal (BoA) dismissed the appeal. The applicant filed an application before the General Court (GC) for the annulment of the decision of the BoA. In support of its action, the applicant relies, in essence, on four pleas in law, alleging: (i) infringement of Article 7(1)(c) of Regulation No 207/2009; (ii) infringement of Article 7(1)(b) of that regulation; (iii) infringement of Article 75 of that regulation; and (iv) infringement of Article 7(3) of that regulation.

EUTMA

MEGABUS.COM

SUBSTANCE: The GC found that the second, third and fourth pleas in law raised by the applicant were manifestly inadmissible on the ground that they are devoid of clarity and consistency and that, consequently, they do not meet the minimum requirements of Article 44(1)(c) of the Rules of Procedure of 2 May 1991 (paras. 16-22). The GC found that the plea based on Article 7(1)(c) EUTMR, though admissible, was manifestly unfounded. The GC upheld the finding of the BoA that the word 'mega' meant 'very large, great, excellent', that the word 'bus' designated a 'large motor vehicle carrying passengers by road' and that those two words, which are part of basic English vocabulary and exist in other languages of

the European Union, would be immediately perceived by the relevant public as a reference to a very large or excellent bus. Furthermore, as correctly stated by the BoA, the element '.com' is a common domain name denoting commercial entities, widely used and known throughout the entire European Union. The BoA was therefore correct in finding that that the sign would be immediately perceived by the relevant public as being directly descriptive of the services in Class 39 and as describing the subject matter and intended purpose of the goods in Class 16 and services in Class 35 (paras. 31-33). The only argument put forward by the applicant is that is that the fact that the BoA used forty words to explain the descriptive character of the sign cannot be directly descriptive of the kind or quality of the relevant goods and services. That argument is clearly not capable of invalidating that conclusion: firstly, the BoA by no means used forty words to describe the meaning of the mark applied for; secondly, the fact that the explanation of that meaning requires more than just a few words does not mean that such a meaning will not be grasped immediately, without further reflection, by the relevant public (paras. 34-38).

Case T-654/14; Revolution LLC v EUIPO; Judgment of 2 June 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Distinctive element, Lack of reasoning, Laudatory mark, Legitimate expectations, Minimum degree of distinctiveness

FACTS: The applicant sought to register the word mark REVOLUTION as an EUTM for services in Class 36. The Office refused the registration of the EUTM application (EUTMA) pursuant to Article 7(1)(b) EUTMR, as it was found to be devoid of distinctive character. The Board of Appeal (BoA) dismissed



Case law



the applicant's appeal. It found that the mark was not distinctive for the services applied for. The applicant filed an action before the General Court (GC) relying on infringement of Article 7(1) (b) of Regulation 207/2009 as well as on the breach of the general principles of equal treatment, good administration and legal certainty and infringement of Article 75 of Regulation 207/2009. The GC dismissed the appeal.

EUTMA

REVOLUTION

SUBSTANCE: First plea: Infringement of Article 7(1)(b) of Regulation 207/2009: The GC found that the term 'REVOLUTION' is a laudatory term in the nature of an advertisement, the purpose being to highlight the positive qualities of the services covered, it conveys clear and unequivocal message, immediately apparent, no interpretative effort is needed, the sign will be seen as a promotional message (paras. 29-30). The fact that the sign is (even primarily) a promotional formula is not enough for finding of lack of distinctiveness (C-398/08 Vorsprung durch Technik, para. 45), but in that case, it was demonstrated that the slogan required a certain interpretative effort and exhibited certain originality and resonance which made it easy to remember; in case of the word mark REVOLUTION, there is no interpretative effort required, there is no originality or resonance (paras. 32-49). The applicant's argument regarding family of marks: the GC found that the concept of family of marks only comes into play in relative grounds and that the BoA had to assess the distinctive character of the mark applied for in the light of its inherent characteristics, without taking into consideration the other allegedly similar marks of which the applicant was the proprietor (para. 51). Second plea: Breach of the general principles of equal treatment, good administration and legal certainty and infringement of Article 75 of Regulation 207/2009. The GC confirmed the standard case-law according to which

the legality of the decisions of the BoA must be assessed solely on the basis of Regulation No 207/2009, as interpreted by the Union judicature. Article 75 of Regulation 207/2009 was not breached either, as the statement of reasons discloses clearly and unequivocally the reasoning adopted by the BoA in rejecting the registration of the mark applied for and enables the applicant to have knowledge of the reasons leading the BoA to take that decision and the GC to review it (paras. 54-66).

Case T-745/14; TeamBank AG Nürnberg v EUIPO; Judgment of 20 July 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Distinctive element, Dominant element, Common element, Figurative element, Weak element, Figurative trade mark, Visual similarity, Phonetic identity, Conceptual identity

FACTS: The EUTM proprietor was granted the registration of the figurative mark represented below as an EUTM for services in Classes 36 and 38. An application for invalidity was filed pursuant to Article 53(1)(a) in conjunction with Article 8(1)(b) EUTMR, based on the Bulgarian figurative mark represented below. The Cancellation Division (CD) dismissed the application for invalidity, stating that there was no likelihood of confusion. The invalidity applicant filed an appeal, which was upheld by the Board of Appeal (BoA). It held that there was a likelihood of confusion on the part of the relevant public due to the strong similarity of the signs.

SUBSTANCE: There is a strong visual similarity between the signs at issue. They coincide in their word elements, and the figurative elements in the earlier marks are of lower importance due to their size, position and purely decorative shape. The contested sign does not contain any free-standing figurative element other than the word element. In addition, despite the figurative nature of the signs at issue, the fonts



Case law



EUTM

**e@sy
Credit**

Earlier mark

EasyCredit

used for the word elements of those signs are very common and do not make it possible to detect any particular difference between them (para. 28). In that regard, the GC rejects the applicant's argument that, due to a lack of distinctiveness, the word elements must be disregarded when comparing the signs at issue (para. 29). The signs are aurally and conceptually identical (paras. 33-36). Specific circumstances may justify a descriptive element having a dominant character (para. 41). That is the position in the present case. With regard to the services in question, while the English term 'easy credit' may be of a descriptive nature for the Bulgarian public, the respective word elements still occupy a central position in the signs at issue and dominate the overall picture (para. 42). In addition, with regard to the distinctive character of the earlier mark, as recalled by the BoA, the fact that a national mark has been registered implies that that mark has a minimum of inherent distinctiveness (para. 43). It follows that the BoA was right to conclude that there is a likelihood of confusion in the present case (para. 44).

Case T-749/14; Peter Chung-Yuan Chang v EUIPO; Judgment of 12 May 2016; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Descriptive element, Minimum degree of distinctiveness

FACTS: The EUTM proprietor was granted the registration of the word mark AROMA as an EUTM for, inter alia, goods in Classes 7 and 11. An application for invalidity was filed pursuant to Article 52(1)(a) in conjunction with Article 7(1) (b) and (c) EUTMR. The Cancellation Division dismissed the application for invalidity. The Board of Appeal upheld the invalidity applicant's appeal. The EUTM proprietor filed an action before the General Court (GC) relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR (ii) infringement of Article 7(1)(b). The GC upheld the appeal.

EUTM

AROMA

SUBSTANCE: ON THE DESCRIPTIVENESS OF THE MARK: The term 'aroma' can have several meanings. It is, inter alia in English, Italian and German, in precisely the same way as the term 'arôme' in French, a synonym for 'scent', 'perfume', 'bouquet' and 'fragrance' and is commonly used in cooking to mean a 'distinctive, usually pleasant smell, especially of spices, wines and plants'. It may therefore be synonymous with 'smell', even if 'aroma' appears to be more specific and subtle since it has a positive connotation. Thus, the average consumer will attribute a more laudatory character to term 'aroma'. Furthermore, at least in German, the term 'aroma' may also be treated as similar to the notions of 'flavour' or 'taste' (paras 30-32).

The contested sign is not descriptive of any characteristics



Case law

of the contested goods. That is because, first, the contested goods consist, for the main part, of electrical cooking utensils. Those goods do not give off any particular aroma. Secondly, the aroma of a foodstuff depends, most importantly, on the foodstuff used and the way in which it is prepared or cooked. Every foodstuff already has its own natural smell which may be accentuated or brought out, suppressed, or even hidden, in the course of its preparation, to such an extent that an aroma which may be given off by a foodstuff after having been cooked or prepared with the help of an electrical cooking appliance does not allow for a direct reference to those goods to be created without further thought. The function or intended use of the contested goods is not to obtain beverages or foodstuffs with aroma, since that is rather a desirable characteristic of other goods, i.e. the food prepared or cooked with the help of the contested goods. Hence, by contrast to what found by the GC in Case T-188/14, GentleCare, the contested sign does not even allude to an ancillary characteristic of the contested goods. The sign in question is therefore not caught by the prohibition laid down in Article 7(1)(c) EUTM (paras 39-48).

ON THE DISTINCTIVENESS OF THE MARK: Despite the lack of evidence for establishing the origin of the word in its context, the concept of 'aroma' is not commonly used in the context of electrical cooking appliances and that the mere fact that a mark is perceived by the relevant public as a promotional formula capable in principle of being used by other undertakings, is not in itself sufficient to support the conclusion that that mark is devoid of distinctive character. It requires a certain degree of interpretation on the part of consumers, who will be unable to associate the mark directly with the goods at issue because the intended use of the goods at issue is not to preserve or accentuate the taste of foodstuffs and beverages, but to prepare, cook, transform, process, heat, mix, blend, toast or roast foodstuffs and beverages. That mark could even be regarded as demonstrating a certain degree of originality, since the term 'aroma' is not normally used in such a context and requires interpretation by the relevant public or a cognitive process to be set off in their minds to enable them



to arrive at a conclusion as to the relationship, which is only remotely evocative, between the mark and the goods. Hence, the contested Mark is not devoid of distinctive character within the meaning of Article 7(1)(b) EUTMR (paras. 61-64).

Case T-454/14; Warimex Waren-Import Export Handels-GmbH v EUIPO; Judgment of 31 May 2016; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive element, Figurative element

FACTS: The applicant sought to register figurative mark represented below as a EUTM for goods and services in Classes 1, 3, 7, 8, 9, 11, 12, 16, 21, 24 and 25. The Office refused the registration of the EUTM application (EUTMA) pursuant to Articles 7(1)(b) and (c) EUTMR, as it was found to be descriptive and devoid of distinctive character. The Board of Appeal (BoA) confirmed this refusal. The EUTM applicant filed an action before the General Court (GC), claiming the infringement of Article 7(1)(b) and Article 7(1)(c), Article 75 and Article 76 EUTMR.

EUTMA

STONE

SUBSTANCE: The GC dismissed all claims. It emphasized that the examination of the case and the reasoning of the decision follows the requirements of Article 75 and Article 76 EUTMR. The reasoning is specific for different groups of goods. The alleged infringement of the duty to state the reasons results



Case law

from a wrong understanding of the decision (para. 49). With regard to the alleged infringement of Article 7(1)(c) EUTMR the GC confirmed the findings of the BoA that the relevant consumers belong to the English speaking general as well as professional public (para. 60). It confirmed the descriptive character of the sign in connection with all contested goods (para. 92). As the existence of one ground quoted in Article 7(1) EUTMR is sufficient for the refusal, the GC did not examine the alleged infringement of Article 7(1)(b) EUTMR (para. 94).

Case T-21/15; Franmax UAB v EUIPO; Judgment of 26 April 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Similarity of the goods and services, Visual similarity, Conceptual similarity

FACTS: The Board of Appeal (BoA) confirmed partially the refusal of the EUTM application for the figurative mark represented below for some goods in Classes 29 and 30 upon opposition based on the earlier international figurative mark designating the EU represented below. The applicant filed an action before the General Court (GC) claiming an infringement of Article 8(1)(b) EUTMR.

SUBSTANCE: The GC confirmed the decision of the BoA and concluded the likelihood of confusion in the meaning of Article 8(1)(b) EUTMR. The relevant public consists of general one with an average level of attention (para. 20). The GC confirmed that some of the contested goods “compotes” in Class 29 and “pastry and confectionery” in Class 30 are similar to the opponent’s “milk products” in Class 29 (paras. 48, 58) whereas “coffee, cocoa and artificial coffee and preparations made from cereals” in Class 30 are similar to a low degree to “milk



EUTMA



Earlier mark



products” (paras. 28 and 41). On the other hand, the marks are visually similar to an average to the extent they contain the

representation of a “cartoon-like image” of a dinosaur giving the impression of a friendly and happy creature (paras. 69-73). The phonetic comparison of the signs at issue is irrelevant, given that a figurative mark without word elements such as the earlier mark cannot, as such, be pronounced (para. 75). Conceptually the marks are “highly similar”, in so far as they both refer to the concept of a moving dinosaur giving the impression of a friendly, happy creature (para. 78).



Case law



Case T-78/15; Mudhook Marketing, Inc. v OHIM; Judgment of 17 March 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Descriptive element, Specialised public, Abbreviation, Slogan mark

FACTS: The EUTM applicant sought to register the word sign IPVanish for the goods virtual private network (VPN) operating software in Class 9 and the services providing virtual private network (VPN) services in Class 38. The examiner rejected the application in respect of all the goods and the services mentioned. The Board of Appeal (BoA) dismissed the appeal. The applicant filed an application before the General Court (GC) for the annulment of the decision of the BoA.

EUTMA

IPVanish

SUBSTANCE: The GC confirmed that the meaning of the term 'IP' was 'Internet Protocol' and that that of the element 'VANISH' was 'to disappear, especially suddenly or mysteriously, to cease to exist, fade away or to become zero' and that 'VPN' is an 'Internet encryption and privacy tool' (para. 32). The GC upheld the finding of the BoA that, in view of the meaning of the elements forming the term 'ipvanish', the sign may evoke the idea that the goods and services covered by it will somehow achieve or contribute to the disappearance or continuing confidentiality of the user's internet address. Therefore, the sign applied for describes the purpose as well as a desirable quality of the goods and services at issue. Consequently, the sign applied for will be perceived by the relevant public as a promotional or advertising information, rather than as an indication of the commercial origin of the goods or services covered by the sign (paras. 35-40). To that regards the GC also

found that the BoA did not base its assessment solely on the lack of imaginativeness. The finding of lack of imaginativeness constitutes only one of the elements which the BoA took into account. It conducted a detailed assessment of the constituent elements of the mark applied for, as well as of the mark as a whole, in order to correctly conclude that the word element 'ipvanish' was not capable of constituting an indication of the commercial origin of the goods and services which it covers (paras. 43-46). As regards the level of attention of the relevant public, the GC found that, firstly, the level of attention of the relevant public may be relatively low with regard to statements of a promotional nature, whether an average end consumer is at issue or a generally more attentive public consisting of specialists or informed consumers. Secondly, since the promotional message was clear to everyone, the relevant public will immediately understand it, even if it were the case that, contrary to the assertion of the BoA, that public, as a whole, had a relatively low level of attention. (paras. 50-53).

Case T-96/15; Mario Mozzetti v EUIPO; Judgment of 6 July 2016; Language of the case: IT

RESULT: Action dismissed

KEYWORDS: Request for proof of use, Likelihood of confusion, Similarity of the goods and services, Similarity of the signs, Common element, Distinctive element, Weak element, Figurative element, Descriptive element, Visual similarity, Phonetic similarity, Conceptual similarity, Coexistence of trade marks

FACTS: The applicant registered the figurative mark ALFREDO alla Scrofa (shown below) as an EUTM for goods and services in Classes 30 and 43 (pasta and restaurant services). A cancellation action based on the earlier Italian word mark L'ORIGINALE ALFREDO for goods and services in Classes 30



Case law



and 43 was filed on the grounds of Article 8(1)(b) and 53(1) (a) EUTMR. The Board of Appeal (BoA) upheld the Cancellation Division's finding that there was a likelihood of confusion between the conflicting marks and dismissed the appeal. The applicant filed an action before the General Court (GC) claiming firstly that the BoA erred in finding inadmissible the request of proof of use of the earlier mark because it was filed for the first time before the BoA. Secondly, the applicant claimed that the BoA erred in finding a likelihood of confusion between the marks at issue.

EUTM

Earlier marks

L'ORIGINALE ALFREDO

SUBSTANCE: ON THE REQUEST OF PROOF OF USE: The GC confirmed the finding of the BoA that the applicant did not file any request of proof of use during the cancellation proceedings since it only criticized the evidence filed spontaneously by the other party for proving reputation of the earlier mark or other factors such as the use of a non-registered mark. In addition, the other party did not interpret the applicant's submissions in the cancellation proceedings as a request for showing genuine use of the earlier mark. An effective request of proof of use was filed only before the BoA and it was, therefore, inadmissible as correctly held in the contested decision (paras. 20-25).

ON THE LIKELIHOOD OF CONFUSION: As far as Articles 53(1) (a) and 8(1)(b) EUTMR are concerned, the GC firstly confirmed the finding of the BoA that the goods at issue are identical

or similar to a high degree. Secondly, the GC rejected the applicant's argument that the common term 'ALFREDO' is weakly distinctive since it has become generic with reference to a pasta dish named 'fettuccine Alfredo'. The GC held that the evidence submitted by the applicant could not prove that 'ALFREDO' has become common in relation to the goods and services at issue. In addition, that term is the element to which consumers will pay more attention in both marks in force of its position, size and because the element 'originale' in the earlier mark will be seen as an adjective qualifying the word 'ALFREDO' (paras. 37-41). In relation to the signs, the GC found that the BoA did not err in finding that the signs are visually and phonetically similar to an average degree. From a conceptual point of view, the signs are similar to the extent that they both evoke the same first name of a person. However, since they also include different concepts (originality vs a place) the conceptual similarity is not high. The GC held that, overall, the fact that the marks have different beginnings cannot counteract the similarity arising from the presence of the common element 'Alfredo'. Therefore, the GC approved the finding of the BoA that, taking also into account the interdependence between the degree of similarity of the goods and services and that of the signs, there was a risk of confusion between the marks at issue (paras. 44-55). Finally, according to the GC, the BoA did not err also in rejecting the applicant's arguments about the coexistence between the marks about one agreement for the sale of the restaurant 'Alfredo' in Rome stipulated in 1943: the alleged coexistence was not covering all the relevant territory (Italy) and was referred only to restaurant services; the agreement was irrelevant in relation to the assessment of the similarity of the signs and of the goods and services (paras. 56-59).



Case law

Case T-97/15; Mario Mozzetti v EUIPO; Judgment of 6 July 2016; Language of the case: IT

RESULT: Action dismissed

KEYWORDS: Request for proof of use, Likelihood of confusion, Similarity of the goods and services, Similarity of the signs, Common element, Distinctive element, Weak element, Figurative element, Descriptive element, Visual similarity, Phonetic similarity, Conceptual similarity, Coexistence of trade marks

FACTS: The applicant registered the figurative mark ALFREDO'S GALLERY alla Scrofa Roma (shown below) as a EUTM for goods and services in Classes 30 and 43 (pasta and restaurant services). A cancellation action based on the earlier Italian word mark L'ORIGINALE ALFREDO for goods and services in Classes 30 and 43 was filed on the grounds of Article 8(1)(b) and 53(1)(a) EUTMR. The Board of Appeal (BoA) upheld the Cancellation Division's finding that there was a likelihood of confusion between the conflicting marks and dismissed the appeal. The applicant filed an action before the General Court (GC) claiming firstly that the BoA erred in finding inadmissible the request of proof of use of the earlier mark because it was filed for the first time before the BoA. Secondly, the applicant claimed that the BoA erred in finding a likelihood of confusion between the marks at issue.

SUBSTANCE: ON THE REQUEST OF PROOF OF USE: The GC confirmed the finding of the BoA that the applicant did not file any request of proof of use during the cancellation proceedings since it only criticized the evidence filed spontaneously by the

other party for proving reputation of the earlier mark or other factors such as the use of a non-registered mark. In addition, the other party did not interpret the applicant's submissions in the cancellation proceedings as a request for showing genuine use of the earlier mark. An effective request of proof of use was



EUTM



Earlier marks

L'ORIGINALE ALFREDO

filed only before the BoA and it was, therefore, inadmissible as correctly held in the contested decision (paras. 20-25).

ON THE LIKELIHOOD OF CONFUSION: As far as Articles 53 (1) (a) and 8(1)(b) EUTMR are concerned, the GC firstly confirmed the finding of the BoA that the goods at issue are identical or similar to a high degree. Secondly, the GC rejected the applicant's argument that the common term 'ALFREDO' is weakly distinctive since it has become generic with reference to a pasta dish named 'fettuccine Alfredo'. The GC held that the evidence submitted by the applicant could not prove that 'ALFREDO' has become common in relation to the goods and services at issue. In addition, that term is the element to which consumers will pay more attention in both marks in force of its position, size and because the element 'l'originale' in the earlier mark will be seen as an adjective qualifying the word 'ALFREDO' (paras. 35-41). In relation to the signs, the GC found that the BoA did not err in finding that the signs are visually and phonetically similar to an average degree. From a conceptual point of view, the signs are similar to the extent that they both evoke the same first name of a person. However, since they also include different concepts (originality vs a place) the conceptual similarity is not high. The GC held that, overall, the fact that the marks have different



Case law

beginnings cannot counteract the similarity arising from the presence of the common element 'Alfredo'. Therefore, the GC approved the finding of the BoA that, taking also into account the interdependence between the degree of similarity of the goods and services and that of the signs, there was a risk of confusion between the marks at issue (paras. 44-55). Finally, according to the GC, the BoA did not err also in rejecting the applicant's arguments about the coexistence between the marks and about one agreement for the sale of the restaurant 'Alfredo' in Rome stipulated in 1943: the alleged coexistence was not covering all the relevant territory (Italy) and was referred only to restaurant services; the agreement was irrelevant in relation to the assessment of the similarity of the signs and of the goods and services (paras. 56-59).

Case T-567/15; Monster Energy Company v EUIPO; Judgment of 14 July 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Enhanced distinctiveness, Figurative trade mark, Reputation, Similarity of the signs, Visual similarity

FACTS: The applicant sought to register the figurative mark represented below as an EUTM for goods and services in Class 25. An opposition based on inter alia the earlier figurative mark represented below was filed pursuant to Article 8(1)(b) and 8(5) EUTMR. The Opposition Division (OD) dismissed the opposition. The opponent appealed the OD decision. The Board of Appeal (BoA) dismissed the appeal. It found that the differences between the signs clearly outweighed the very low visual similarities between them, even where the goods are identical. As regards the reputation claim, the BoA held that no relevant documents in relation to clothing and headgear had been provided. Consequently, the appeal was dismissed. The opponent challenged the decision before the General Court (GC).



EUTMA



Earlier mark



SUBSTANCE: Infringement of Article 8(1)(b) EUTMR: the definition of relevant public (general public) and the identity of the goods involved was not disputed. The BoA was fully entitled to find that the signs present only very low degree of visual similarity (paras. 25-28). The signs are purely figurative and abstract in nature; no phonetic comparison is possible (para 29). For the relevant public the perception of the trade mark applied for as 'scratches' is not the most obvious perception since those lines rather call to mind white brushstrokes on a black square (para. 32). Therefore, the most likely assumption in regard to the perception of the signs is that suggested by the BoA: either they are abstract devices (no conceptual comparison possible) or the earlier trade mark is a 'claw' whereas the trade mark applied for are 'white brushstrokes' (conceptually different) (paras. 30 and 33). It is apparent from the documents submitted that the applicant operates in the non-alcoholic beverages or energy drinks sector. There is no evidence of enhanced distinctiveness or reputation of the earlier trade mark in relation to clothing



Case law

or headgear. (paras. 41-44). The fact that the earlier mark enjoyed reputation for drinks had no relevance insofar as the opposition was not based on drinks and drinks were clearly not similar to the contested goods (para. 46). Infringement of Article 8(5) EUTMR: reputation was claimed by the applicant only for goods in Class 25, consequently the question whether or not that mark enjoys a reputation for goods other than articles of clothing and headgear is irrelevant. As there is no proof of reputation in relation to goods in Class 25, one of the essential conditions of Article 8(5) EUTMR is not met.

Case T-420/15; Thun 1794 v EUIPO; Judgment of 14 July 2016; Language of the case: CS

RESULT: Action dismissed

KEYWORDS: Novelty, Individual character, Substantial procedural violation, Fax, Burden of proof, Misuse of power

FACTS: Invalidity application was filed against the contested RCD, based on lack of novelty and individual character. It was upheld by the Invalidity Division (ID), who considered that the Applicant proved disclosure of an identical prior design. The BoA annulled the decision of ID, holding that such disclosure was not proved to a requisite legal standard. The invalidity applicant filed an action before the General Court (GC).

SUBSTANCE: First plea: Substantial procedural violation: the GC confirmed the case-law according to which the production, by the Office, of fax transmission reports which included items conferring probative value on them was sufficient to prove that the fax in question had been received by the addressee. Where there has been no error message and there is a transmission report stating the word 'ok', it can be considered that the fax sent has been received by the addressee (para. 17). Thus, the applicant could not be successful merely claiming that it never received the fax in question. Second plea: Lack of novelty and



RCD



individual character: The global assessment of the evidence submitted by the applicant does not show that the applicant submitted solid and objective evidence of disclosure of a prior design (paras. 21-35). The plea is dismissed. Third plea: Misuse of power: the applicant uses the plea of misuse of power as a pretext to challenge, once again, the global assessment of the evidence filed to prove disclosure of a prior design. That global assessment is not vitiated by any error and must be confirmed. Moreover, there is no indication of any omission or partiality on the part of the BoA (para. 38). The third plea is dismissed.

Case T-431/15; Fruit of the Loom, Inc. v EUIPO; Judgment of 7 July 2016; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Evidence of use, Proof of use, Extent of use, Functional continuity, Lack of reasoning

FACTS: The EUTM proprietor was granted the registration of the word mark FRUIT as an EUTM for goods in Class 25.



Case law



An application for revocation was filed pursuant to Article 51 EUTMR. The Cancellation Division (CD) upheld the application for revocation. The Board of Appeal (BoA) dismissed the EUTM proprietor's appeal. It upheld the findings of the CD regarding lack of genuine use of the contested mark, *inter alia*, as a stand-alone trade mark in preparatory works for the launch of the 'Born in the USA' range. The EUTM proprietor filed an action before the General Court (GC), contesting paragraphs 33 to 43 of the contested decision, namely those in which the BoA considered whether there had been genuine use of the stand-alone trade mark FRUIT. The GC upheld the appeal and annulled the BoA decision.

EUTM

FRUIT

SUBSTANCE: Single plea: Infringement of Article 15(1) EUTMR: The BoA concluded that there had been no genuine use on the basis of two lines of reasoning: (i) in the market size of the European Union market, as regards goods such as those in the present case, it was necessary to adduce and prove commercial acts aimed at end consumers in order to establish genuine use of a mark; commercial acts aimed exclusively at professionals from the sector concerned are insufficient for that purpose; (ii) it was evident that the contested mark had not been 'objectively present on the market in a manner that was effective and consistent over time' (paras. 40-43). The GC held that outward use of a mark does not necessarily mean use aimed at end consumers. It is common and even necessary to direct commercial acts at professionals in the sector concerned and particularly at resellers. The BoA was not entitled to rule out the genuineness of the use solely because the commercial acts invoked by the applicant were not directed to end consumers (paras. 48-51). The BoA erred, in the present case, in taking into account, when assessing the genuineness of that use, the subsequent decision of the applicant to stop

the launch of the goods on which the mark at issue was affixed on the ground that that decision resulted in those goods never being offered for sale to end consumers (para. 57). The second line of reasoning lacks a specific analysis of the evidence and fails to give proper considerations to practices of marking that are specific to the clothing sector (paras. 75-80). While it is true that there is a functional continuity between the CD and the BoAs, the decision of the CD does not contain any assessment of the evidence submitted by the applicant beyond a number of mere assertions; therefore the fact that the BoA confirmed to conclusions of the CD is irrelevant in the present case (paras. 81-83). Finally, the Office's analysis filed before the GC for the first time must be considered as a belated attempt to state reasons for the contested decision (para. 84). The action is upheld and the BoA decision annulled.

Case T-585/15; Monster Energy Company v EUIPO; Judgment of 8 June 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Admissibility, Competence of the Boards, Lack of reasoning, Restitutio in integrum

FACTS: The applicant's trade mark application for the word mark GREEN BEANS, applied for goods in Classes 5, 30 and 32 was refused on absolute grounds (AG) by the examiner, the decision was confirmed by the Board of Appeal (BoA). Following a check on the progress of the case, the applicant had discovered that the decision had been taken by the BoA. The applicant claimed before the BoA that it had not received the notification of the BoA's decision. It filed an appeal to the General Court (GC) against that decision (T-666/14, dismissed as manifestly inadmissible owing to its belated nature), and at the same time, a restitutio in integrum request pursuant to Article 81 EUTMR before the Registry of the BoAs, where it sought to re-establish its rights to challenge the BoA's decision



Case law



on AG before the GC. The Registry of the BoAs informed the applicant that the request could not be allowed as Article 81 EUTMR concerns only deadlines vis-à-vis the Office and that the transmission report of the fax machine confirmed that the BoA's decision was notified. Following that, the applicant filed an appeal with the Office against the letter of the Registry. The appeal was found inadmissible by the BoA. The BoA stated that the letter from the Registry was not a decision originating from a first instance division which could be subject to appeal before it. It further added that in any event, Article 81(1) EUTMR was not applicable and it was not competent to decide on the application, as restitutio had been requested regarding a time limit vis-à-vis the GC and not vis-à-vis the Office. That decision by the BoA was challenged before the GC.

EUTM

GREEN BEANS

SUBSTANCE: To acknowledge that one of the Office's departments has the power to grant an application for restitutio in integrum as regards a time limit for bringing an action before the GC would mean encroaching upon the jurisdiction of that court, which is the only court, subject to review by the Court of Justice of the European Union, which may assess whether a case which has been brought before it is admissible, in accordance with Articles 256 and 263 TFEU (para. 39). The applicant's arguments based on considerations of vocabulary and on the fact that Office is concerned in various ways by the period for bringing an action before the GC cannot succeed (para. 45). The BoA was therefore right in declaring itself not competent, like the Registry of the BoAs, to examine the application for restitutio in integrum filed by the applicant (para: 50).

Case T-583/15; Monster Energy v EUIPO; Judgment of 8 June 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Admissibility, Competence of the Boards, Lack of reasoning, Restitutio in integrum

FACTS: The applicant's trade mark application for the figurative mark depicted below, applied for goods in Classes 5, 30 and 32 was refused on absolute grounds (AG) by the examiner, the decision was confirmed by the Board of Appeal (BoA). Following a check on the progress of the case, the applicant had discovered that the decision had been taken by the BoA. The applicant claimed before the BoA that it had not received the notification of the BoA's decision. It filed an appeal to the GC against that decision (T-633/14, dismissed as manifestly inadmissible owing to its belated nature), and at the same time, a restitutio in integrum request pursuant to Article 81 EUTMR before the Registry of the BoAs, where it sought to re-establish its rights to challenge the BoA's decision on AG before the GC. The Registry of the BoAs informed the applicant that the request could not be allowed as Article 81 EUTMR concerns only deadlines vis-à-vis the Office and that the transmission report of the fax machine confirmed that the BoA's decision was notified. Following that, the applicant filed an appeal with the Office against the letter of the Registry. The appeal was found inadmissible by the BoA. The BoA stated that the letter from the Registry was not a decision originating from a first instance division which could be subject to appeal before it. It further added that in any event, Article 81(1) EUTMR was not applicable and it was not competent to decide on the application, as restitutio had been requested regarding a time limit vis-à-vis the GC and not vis-à-vis the Office. That decision by the BoA was challenged before the GC.



Case law



EUTMA



SUBSTANCE: To acknowledge that one of the Office's departments has the power to grant an application for restitutio in integrum as regards a time limit for bringing an action before the GC would mean encroaching upon the jurisdiction of that court, which is the only court, subject to review by the Court of Justice of the European Union, which may assess whether a case which has been brought before it is admissible, in accordance with Articles 256 and 263 TFEU (para. 41). The applicant's arguments based on considerations of vocabulary and on the fact that the Office is concerned in various ways by the period for bringing an action before the GC cannot succeed (para. 47). The BoA was therefore right in declaring itself not competent, like the Registry of the BoA, to examine the application for restitutio in integrum filed by the applicant (para. 52).

Case T-126/15; El Corte Inglés v EUIPO; Judgment of 24 May 2016; Language of the case: FR

RESULT: Action dismissed

KEYWORDS: Ratio legis

FACTS: The applicant sought to register the figurative mark represented below as an EUTM for, inter alia, auctioneering and retail services in Class 35. An opposition based on the earlier figurative mark represented below registered for goods and services in Class 35, was filed pursuant to Article

8(1)(b) EUTMR. The opponent ticked the case 'based on part of the goods and services' in the opposition form and listed the following services: advertising; business management; business administration; office functions. The Opposition Division (OD) partly upheld the opposition, in particular in so far as it was directed against all the contested goods in Class 35. The Board of Appeal (BoA) partially upheld the applicant's appeal. It found that the OD wrongly upheld the opposition against auctioneering and retail services in Class 35. The opponent filed an action before the General Court (GC) relying on one plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal.

EUTMA

Supeco 

Earlier mark



SUBSTANCE: Point V of Communication No 2/12 of the President of the Office of 20/06/2012 concerning the use of class headings in lists of goods and services in [EU] trade mark applications and registrations does not entail that a broad interpretation of those headings also applies to the list of goods and services on which an opposition is based, since opposition proceedings are governed by specific provisions. By virtue of those provisions, a notice of opposition shall contain a clear and precise indication of the goods and services on which the opposition is based (para. 21).



Case law

In fact, according to Rule 15(2)(f) EUTMR, the notice of opposition shall contain the goods and services on which the opposition is based. In this respect, an interpretation of Rule 15(2)(f) EUTMR by reference to the general scheme and the purpose of the rules of which it forms part shows that the French version of that provision, according to which “l’acte d’opposition doit comporter [...] les produits et services à l’encontre desquels l’opposition est formée”, results from a clerical error and does not allow for an interpretation of that provision as not requiring the indication of the products and services on which the opposition is based in the notice of opposition (paras. 22-28).

Moreover, the requirements of clarity and precision as introduced by the case-law of the Court of Justice of the European Union in Case C-307/10, IP Translator, also apply to the opponent when it comes to the designation of the goods and services on which the opposition is based (paras. 29-30). It follows that the circumstance that the services on which the opposition was based as mentioned in the opposition notice advertising; business management; business administration; office functions coincided with a Class 35 heading encompassing auctioneering and rental of vending machine does not allow for the conclusion that the opposition was in fact based on auctioneering and rental of vending machine (paras. 31-32). Thus, the BoA correctly compared the contested services only to the services mentioned in the opposition notice (para. 35).

Case T-385/15; Loops LLC v EUIPO; Judgment of 14 June 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Three dimensional mark



FACTS: The applicant sought to register the 3D mark of a toothbrush [represented below] as an EUTM for goods and services in Class 21. The Office refused the registration of the EUTM application (EUTMA) pursuant to Article 7(1)(b) EUTMR, as it was found to be devoid of distinctive character. The Board of Appeal (BoA) dismissed the applicant’s appeal. It found that the shape was commonplace and not markedly different from other shapes. The applicant filed an action before the General Court (GC) relying on a single plea in law alleging infringement of Article 7(1)(b) EUTMR.

EUTMA



SUBSTANCE: The GC dismissed the appeal. It found that only marks departing significantly from the norm or customs of the sector are able to fulfil the essential function of indicating origin (para. 18). Overall the mark applied for is in the form of a toothbrush, the characteristics of which are similar to variations of toothbrushes usually available on the market (para. 28). Earlier precedents could not alter this result (paras. 31-35). The BoA undertook a full and specific examination and the applicant could therefore not rely on previous Office decisions in order to cast doubt on the conclusion that the registration of the mark applied for is incompatible with the EUTMR.



Case law



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[R2234/2015-2 ROMANS](#)

RESULT: Decision annulled.

KEYWORDS: Descriptive element, Distinctive element, Restriction of the list of goods and services; Article 7(1)(b) EUTMR, Article 7(1)(c) EUTMR, Article 7(2) EUTMR.

FACTS: The applicant sought to register the word mark 'ROMANS' for goods and services in Classes 9, 16, 25 and 41. After a limitation made by the applicant the word mark 'ROMANS' was only refused for goods in Class 25 'clothing, footwear, headgear' under Article 7(1)(c) and (b) EUTMR.

SUBSTANCE: The Board annuls the contested decision and the mark may be accepted for publication for all the goods and services applied for, taking into account the limitations made.

First, the Board agrees with the applicant that ancient Roman fashion would not be the first thing that comes to the relevant consumer's mind when seeing the sign 'ROMANS' used on clothing, footwear or headgear. The average consumer would not describe such an item, even if it were inspired by ancient Roman fashion, as 'romans'. 'Romans' is not a natural expression in relation to the goods and the average consumer would not state, in relation to clothing, footwear or headgear,

that it was 'romans'. The term 'ROMANS' is distinguishable from the term 'ROMAN' used in relation to the goods (§ 18). Second, the Board finds that to use the word 'ROMANS' in the context of the goods in question would be somewhat alien and strange for the relevant public. The Board considers that, in the sector which is relevant in this case, the relationship between the expression 'ROMANS' and the goods in question is, at most, only of an indirect, allusive nature. Therefore the idea of 'ROMANS' in the context of the goods applied for seems quite far-fetched (§ 19).

For the aforementioned reasons the appeal must be upheld.

[R2583/2014-5](#)



DEVICE OF A TYRE TREAD (fig.)

RESULT: Decision partially annulled.

KEYWORDS: Figurative trade mark, Function of trade mark, Reimbursement, Right to be heard, Scope of proceedings, Shape of the product, Substantial procedural violation, Technical result; Article 7(1) EUTMR, Article 7(1)(e)(ii) EUTMR, Article 77(1) EUTMR, Article 51(b) CTMIR.

FACTS: The figurative mark 'DEVICE OF A TYRE TREAD' was registered for goods in Class 12. The cancellation applicant filed a request for a declaration of invalidity of the registered mark for part of the goods, namely 'tyres, solid, semi-pneumatic and pneumatic tyres for vehicle wheels of all kinds'. The Cancellation Division declared the invalidity of the EUTM for all those goods.



Case law



SUBSTANCE: The Board annuls the contested decision insofar as the Cancellation Division went beyond the scope of the cancellation applicant's request. In that regard, the contested decision is vitiated by a substantial procedural violation.

The EUTM proprietor criticised the Cancellation Division for not properly defining the contested sign's essential characteristics. In the Board's view, the Cancellation Division mentioned that the 'main feature' of the contested mark is 'the long angular "L-shaped groove"', which at least, in a broad sense, captures the essential characteristics of the sign, namely an (approx.) 90° angle, a curved segment in the intersection of the two sides and finally the two sides gradually shifting from pointy (end of lower side) to thick (end of upper side) (§ 30).

Concerning the question of the functionality of the essential characteristics, the EUTM proprietor pointed out that the fact that a shape can be found in a patent does not automatically mean that it has a technical function (§ 38). The Board notes that it could be objected that one could, to a lesser or greater degree, vary the angle, the length of the sides of the angle, or their thickness for that matter, without significant detriment to a tyre's functionality. Nevertheless, even though it could be argued that the parameters (i.e. angle, curved segment, variation in thickness) in the contested sign are not the only ones to achieve the desired traction, steering stability, efficient water draining, etc., it is clear that the design of the EUTM proprietor's groove has been designed with a specific technical purpose in mind, namely to maximise the functioning of a tyre (§ 40). In the present case, it is clear from the evidence that the 'L-shaped groove is frequently used in tyre treads on the operational part of tyres. Thus, it is clearly of essential importance for the proper functioning of those tyres (§ 42). It is appropriate to mention that the registration of a sign consisting of the shape of a product is precluded even if that technical result can be achieved by other shapes (12/11/2008, [T-270/06](#), Lego brick, EU:T:2008:483, § 39 as confirmed in 14/09/2010, [C-48/09 P](#), Lego brick, EU:C:2010:516, § 52) (§ 41). In the Board's view, it is clear that the registration of the proprietor's 'L-shaped groove', without any essential

ornamental details, colours or other aesthetic features, is likely to unduly impair the opportunity for competitors to place on the market tyres whose treads incorporate the same or similar grooves as a technical solution for tyres (§ 42).

For the abovementioned reasons the Board must find that the contested EUTM is invalid in relation to 'tyres, solid, semi-pneumatic and pneumatic tyres for vehicle wheels of all kinds' in Class 12, since it was registered in breach of Article 7(1)(e) (ii) EUTMR (§ 48).

However, the Cancellation Division erroneously invalidated the registration for goods that were not part of the cancellation applicant's request for a declaration of invalidity, namely 'rims and covers for vehicle wheels of all kinds' in Class 12 and the appeal must be upheld insofar as the EUTM registration was declared invalid for these goods in Class 12 (§ 51).

Consequently, the appeal is partially upheld.

R2330/2015-2 Cariphy / karify

RESULT: Decision annulled.

KEYWORDS: Filing date, Substantiation of earlier right, Translation of evidence, Ratio legis, Article 64 EUTMR, Rule 72(1) CTMIR.

FACTS: The cancellation applicant filed a request for a declaration of invalidity of the registered mark 'Cariphy' for all the goods and services based on Article 53(1) EUTMR. English was indicated as the language of the proceedings. The cancellation applicant submitted an extract of the earlier trade mark registration in Dutch. The EUTM proprietor submitted its observations in reply which included an extract of the earlier trade mark registration in Dutch. The Office received, after requesting it, the English translations, including an English translation of the extract of the earlier trade mark registration in Dutch, from the EUTM proprietor. The Cancellation Division rejected the request for a declaration of invalidity in its entirety.



Case law



SUBSTANCE: The Board states that it is true, as alleged by the EUTM proprietor, that the cancellation applicant – not the Office or the EUTM proprietor – is responsible for the translation of its own evidence. In the case at hand, it is evident that the cancellation applicant did not send the required translation in English of the earlier Dutch trade mark registration extract within the time-limit set by the Cancellation Division (§ 26-27). Under normal circumstances this should lead to a rejection of the request for a declaration of invalidity in accordance with legal norms as mentioned in the contested decision which also clearly set out the difference between admissibility and substantiation requirements (§ 28).

Nonetheless, it is evident that the EUTM proprietor (a Dutch company) represented by a Dutch representative was able to understand the Dutch extract submitted by the cancellation applicant. Such also follows from the observations made by the EUTM proprietor in its reply to the statement of grounds of the appeal, which also included a Dutch extract of the earlier trade mark registration. Moreover, and albeit on a request from the Office, the cancellation applicant provided an English translation of the Dutch extract concerning the earlier trade mark registration (§ 29).

Consequently, the EUTM proprietor has been able to verify the scope, validity of the earlier mark and the entitlement of the cancellation applicant to file the declaration of invalidity and thus the ratio legis of the relevant rules as mentioned in the contested decision were complied with (see, by analogy, Board of Appeal decision of 10 December 2012, [R 2534/2011-2](#) Opticare Neutral / NEUTRAL et al., § 24) (§ 30).

It must be concluded that in the special circumstance of the case at hand - this being the evidence in a language that is understood by both parties - the failure of providing a translation in the language of proceedings during the set time-limit therefor cannot have the harmful consequence of finding the invalidity proceedings unfounded (15/07/1970, [C-41/69](#), ACF Chemiefarma NV v Commission of the European Communities, EU:C:1970:71 § 48-53, applicable here by analogy, and 12/07/2012, [T-346/09](#), Bañoftal, EU:T:2012:368, § 21-40) (§ 31).

Given the parties' legitimate interest that the case be examined by both instances of the Office, the contested decision is to be annulled and the case is to be remitted to the Cancellation Division, pursuant to Article 64 EUTMR, for further prosecution (§ 34).

R0376/2016-5 DASH 3 / Dash

RESULT: Proceedings terminated.

KEYWORDS: Admissibility, Ownership of IP right; Rule 48(1)(a) CTMIR, Rule 49(2) CTMIR, Article 59 EUTMR.

FACTS: The applicant sought to register the word mark 'DASH 3'. An opposition was filed against all the contested goods based on an earlier EUTM for the word mark 'Dash'. The Opposition Division upheld the opposition. The applicant's representative filed an appeal in the name of Intervene Group Limited.

SUBSTANCE: The appeal has been filed in the name of an entity, Intervene Group Ltd, which does not correspond to the applicant's name, Intervene Ltd. Although Intervene Group Ltd might be related to the applicant, as is stated by the representative, yet it was previously not involved in the proceedings, and cannot be regarded as a party to the proceedings (§ 13).

Moreover, the letter sent by the representative only provides an explanation for the incorrect address indicated on the notice of appeal, but does not constitute proof for the change of ownership, since Intervene Group Ltd, and Intervene Ltd (the applicant) are two independent companies, registered under different registration numbers, each one in possession of their own assets and liabilities. The letter also cannot be regarded as documentary evidence for the claimed relationship between the two companies (§ 14).



Case law



Since the appeal is deemed to be filed in the name of a company different from the applicant, it must be declared inadmissible (§ 15).

R1506/2015-1 FoamFatale

RESULT: Proceedings terminated.

KEYWORDS: Admissibility, Restitutio in integrum, Transfer of IP right; Rule 49(1) CTMIR, Rule 70(2) CTMIR, Rule 70(4) CTMIR, Article 60 EUTMR, Article 81 EUTMR.

FACTS: After the claimant was granted the EUTM, a representative requested that its transfer, to a Saudi company on the basis of a transfer agreement, be recorded.

The transfer of ownership had been entered in the register but the recordal was appealed by the claimant.

The Registry of the Boards of Appeal reminded the claimant that a written statement of grounds had to be filed within a four-month time-limit. The claimant submitted a request for restitutio in integrum after the expiry of the time-limit and filed the grounds of appeal as well. The claimant stated that he could not submit the grounds of appeal within the time-limit because their content depended on those of an application filed with the Budapest Court in order to declare the invalidity of the transfer agreement. The claimant argued that restitutio in integrum was within its due time-limit because it was made within one year from the expiry of the unobserved time-limit and within two months of the removal of the cause of non-observance, i.e. the application before the Court. In the statement of grounds, the claimant asked that the Board annul the contested decision on the grounds that the agreement did not establish the transfer and no consent was given to record the Saudi company as the new proprietor.

SUBSTANCE: The claimant argues that the “due care” required from him, that he first sue the Saudi company (for the annulment of the transfer document) because the content of the grounds of appeal depended on the content of the judicial application and the drafting of that judicial application by lawyers, has been a time-consuming process. The claimant contends, as a result, that the filing of this judicial application was the obstacle that prevented him from filing the grounds of appeal in due time (§ 16).

The Board does not find this causal relationship convincing. The claimant, being the party directly affected by the contested decision, should have been aware since the date of notification of that decision of the reasons for which, in his view, he had been unjustly deprived of the ownership of the EUTM. In other words, these reasons did not become known to him only when the judicial application was drafted and filed. These reasons have been known to him since the date of notification of the decision or, at least, since the date of the appeal. The Board notes, in this regard, that the claimant does not argue that he became aware of these reasons only after the time-limit at issue expired (§ 20).

It necessarily follows from the above that the filing of the Hungarian lawsuit was not an ‘obstacle’, either in law or in fact, to the timely submission of the grounds of appeal (§ 23).

Since the request for restitutio in integrum is not well founded and the grounds of appeal were received out of time, the appeal must be dismissed as inadmissible (§ 24).

The present decision is rendered without prejudice to the claimant’s right to be recorded in the EUIPO Register as the owner of the EUTM as a result of a judgment (Article 17 EUTMR and Rule 31 CTMIR) (§ 25).