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The Legal Practice Service of the International Cooperation and Legal Affairs Department prepares a yearly overview of the General Court/Court of Justice (GC/CJ) case-law with regard to trade mark and design matters. The judgments and orders are arranged in categories to be browsed more easily according to their content.

This overview includes judgments, preliminary rulings and important orders rendered by the GC and the CJ.

Cases in which the GC or CJ have decided differently from the EUIPO are indicated by the symbol ♦ before the case number.

Cases that are cited in more than one category in the present report are indicated by the symbol ◆ before the case number.

As all of the summaries and citations in this edition were compiled after 23/03/2016, the new name of the Office, EUIPO, is used. For all cases, the new terminology, such as European Union trade mark application or registration (EUTM application or registration), is used (instead of the previous Community trade mark application or registration (CTMA or CTM registration)), and the legal texts will always be referred to as the European Union Trade Mark Regulation (EUTMR) and Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (Implementing Regulation (EC) No 2868/95), respectively. The numbering used for the EUTMR is the numbering of Regulation (EU) 2017/1001.

Preliminary rulings are integrated alongside the judgments. References to the EUTMR in the chapter headings should be read as extending to the equivalent rules in Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (Codified version), where such equivalents exist.

Each reference to a case contains an abstract of the relevant issues together with an indication of the language of the proceedings. For internal users (EUIPO staff), the original and any available translations thereof can be accessed by CTRL+Click on the respective case number. For external users, or for more detailed information, please see the GC/CJ Database, which can be accessed online at <http://curia.europa.eu/> (and contains keywords, relevant legal norms, facts in brief and headnotes for each judgment, including the official translations), or the eSearch case-law database, which can be accessed online at <https://euiipo.europa.eu/eSearchCLW/>.

Please note that the document does not necessarily reproduce the exact wording of the judgments, preliminary rulings or orders.



CTRL+Click on the titles of the index will take you directly to the text (internal EUIPO users only).



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I. Procedural Matters

A. Procedure before the GC/CJ

1. Admissibility

1.1 Right to appeal, form, deadline

♦[T-132/15](#); **popchrono**; *IR v EUIPO*; Judgment of 14 March 2017; EU:T:2017:162; Language of the case: EN. The EUTM proprietor was granted registration of the word mark **POPCHRONO** as an EUTM for goods and services in Class 12. An application for revocation was filed pursuant to Article 58 EUTMR. The Cancellation Division (CD) upheld the application for revocation. The Board of Appeal (BoA) dismissed the EUTM proprietor's appeal. It found that the EUTM proprietor had not proven genuine use of the contested EUTM. The General Court (GC) first rejected the Office's plea of inadmissibility of the action for lack of clarity (paras 13-25).

♦[T-387/15](#); **J AND JOY / joy SPORTSWEAR**; *J & Joy SA v EUIPO*; Judgment of 29 March 2017; EU:T:2017:233; Language of the case: EN. The applicant sought to register the word mark **J AND JOY** as an EUTM for goods and services in, inter alia, Classes 18 and 25. An opposition based on the earlier German figurative mark **joy SPORTSWEAR**, registered for goods and services in Class 25, was filed pursuant to Article 8(1)(b) EUTMR. The Opposition Division (OD) partly upheld the opposition, considering that there was a likelihood of confusion (LOC) for some of the contested goods in Classes 18 and 25. The BoA dismissed the applicant's appeal. It found that there was a LOC, given the identity or similarity between the goods in question, the overall similarity between the signs at issue and the average distinctive character of the earlier trade mark. The applicant filed an action before the GC, relying on several pleas in law that related to: (i) the relevant public, (ii) the degree of attention, (iii) the comparison of the goods, (iv) the comparison of the marks, including the distinctiveness and dominance of the common element, (v) the inherent distinctiveness of the earlier mark, and (vi) the purported reputation of the contested mark. The GC dismissed the appeal, ruling that the BoA had not erred in finding a LOC for the goods within the scope of the appeal. **Admissibility of the heads of claim:** the GC began by ruling on the admissibility of the applicant's first head of claim (paras 9-13). In the application initiating proceedings, the applicant had claimed that the GC should 'review the decision of the Opposition Division and declare the opposition inadmissible'. The Office had objected to this head of claim. In the context of a measure of organisation of procedure, the GC requested the applicant to state precisely the subject matter of its application. The applicant responded that the form of order sought should be understood as a claim that the GC should annul the contested decision. The Office did not dispute that the application could be interpreted as seeking annulment of the contested decision. The GC concluded that the application was for the annulment of the contested decision.

♦[T-388/15](#); **JN-JOY / joy SPORTSWEAR**; *J & Joy SA v EUIPO*; Judgment of 29 March 2017; EU:T:2017:232; Language of the case: EN. The applicant sought to register the word mark **JN-JOY** as an EUTM for goods and services in, inter alia, Classes 18 and 25. An opposition based on the earlier German figurative mark **joy SPORTSWEAR**, registered for goods and services in Class 25, was filed pursuant to Article 8(1)(b) EUTMR. The OD partly upheld the opposition, considering that there was a LOC for some of the contested goods in Classes 18 and 25. The BoA dismissed the applicant's appeal. It found that there was a LOC, given the identity or similarity between the goods in question, the overall similarity between



the signs at issue and the average distinctive character of the earlier trade mark. The applicant filed an action before the GC, relying on several pleas in law that related to: (i) the relevant public, (ii) the degree of attention, (iii) the comparison of the goods, (iv) the comparison of the marks, including the distinctiveness and dominance of the common element, (v) the inherent distinctiveness of the earlier mark, and (vi) the purported reputation of the contested mark. The GC dismissed the appeal, ruling that the BoA had not erred in finding a LOC for the goods within the scope of the appeal. **Admissibility of the heads of claim:** the GC began by ruling on the admissibility of the applicant's first head of claim (paras 9-13). In the application initiating proceedings, the applicant had claimed that the GC should 'review the decision of the Opposition Division and declare the opposition inadmissible'. The Office had objected to this head of claim. In the context of a measure of organisation of procedure, the GC requested the applicant to state precisely the subject matter of its application. The applicant responded that the form of order sought should be understood as a claim that the GC should annul the contested decision. The Office did not dispute that the application could be interpreted as seeking annulment of the contested decision. The GC concluded that the application is for the annulment of the contested decision.

♦[T-389/15](#); **J&JOY / joy SPORTSWEAR**; J & Joy SA v EUIPO; Judgment of 29 March 2017; EU:T:2017:231; Language of the case: EN. The applicant sought to register the figurative mark J&JOY as an EUTM for goods and services in, inter alia, Classes 18 and 25. An opposition based on the earlier German figurative mark **joy SPORTSWEAR**, registered for goods and services in Class 25, was filed pursuant to Article 8(1)(b) EUTMR. The OD partly upheld the opposition, considering that there was a LOC for some of the contested goods in Classes 18 and 25. The BoA dismissed the applicant's appeal. It found that there was a LOC, given the identity or similarity between the goods in question, the overall similarity between the signs at issue and the average distinctive character of the earlier trade mark. The applicant filed an action before the GC, relying on several pleas in law that related to: (i) the relevant public, (ii) the degree of attention, (iii) the comparison of the goods, (iv) the comparison of the marks, including the distinctiveness and dominance of the common element, (v) the inherent distinctiveness of the earlier mark, and (vi) the purported reputation of the contested mark. The GC dismissed the appeal, ruling that the BoA had not erred in finding a LOC for the goods within the scope of the appeal. **Admissibility of the heads of claim:** the GC began by ruling on the admissibility of the applicant's first head of claim (paras 9-13). In the application initiating proceedings, the applicant had claimed that the GC should 'review the decision of the Opposition Division and declare the opposition inadmissible'. The Office had objected to this head of claim. In the context of a measure of organisation of procedure, the GC requested the applicant to state precisely the subject matter of its application. The applicant responded that the form of order sought should be understood as a claim that the GC should annul the contested decision. The Office did not dispute that the application could be interpreted as seeking annulment of the contested decision. The GC concluded that the application is for the annulment of the contested decision.

♦[T-699/15](#); **CityTrain**; *City Train GmbH v EUIPO*; Judgment of 21 June 2017; EU:T:2017:409; Language of the case: DE. The applicant sought to register the figurative mark **CityTrain** as an EUTM for goods and services in Classes 12, 37 and 42. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b)(c) and 7(2) EUTMR, as it was found to be descriptive and devoid of distinctive character. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. However, this arrived one day after the end of the appeal period. The GC refused the Office's request to dismiss the appeal for being belated. According to the GC, the application was belated due



to unforeseeable circumstances. The applicant had sent the application via fax and courier more than 2 weeks ahead of the end of the appeal period. While the fax was received by the GC on the same day it was sent, the hard copy of the appeal did not arrive until one day after the end of the appeal period. According to the GC, the applicant had sent off the hard copy of the application in time to ensure its delivery well before the expiry of the appeal period.

♦[T-336/16](#); **VERSACE 19.69 ABBIGLIAMENTO SPORTIVO... / VERSACE et al.**; *Versace 19.69 Abbigliamento Sportivo Srl v EUIPO*; Judgment of 5 October 2017; EU:T:2017:691; Language of the case: IT. The applicant sought to register the figurative mark **VERSACE 19.69 ABBIGLIAMENTO SPORTIVO** as an EUTM for goods in Classes 9, 24 and 25. An opposition based, inter alia, on the earlier word mark **VERSACE**, registered for goods in Classes 9, 24 and 25, was filed pursuant to Article 8(1)(b) EUTMR. The OD partially upheld the opposition and allowed registration of the mark for goods in Class 9, apart from *optical apparatus, glasses, sunglasses and lenses*. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC, requesting that it annul the contested decision. **Interpretation of the agreement between the parties:** the applicant claimed that registration of the EUTM application was allowed under an agreement signed with the opponent. The GC pointed out that the applicant had to clearly indicate which provisions of this agreement were relevant for the case, as the GC could not search for such provisions in the evidence (para. 33).

♦[T-771/15](#); **BITTORRENT**; *Hochmann Marketing GmbH (formerly Bittorrent Marketing GmbH) v EUIPO*; Judgment of 12 December 2017; EU:T:2017:887; Language of the case: EN. The applicant was the proprietor of the EUTM registration for the word sign **BITTORRENT** for Classes 35, 38 and 42. The intervener, BitTorrent Inc., filed an application for revocation of the mark at issue, based on Article 58(1)(a) EUTMR, on the ground that this mark had not been put to genuine use in the European Union (EU) in connection with the services concerned within a continuous period of 5 years. The Office notified the applicant that it had 3 months within which to submit evidence of use of the mark at issue. Following a request from the applicant, the Office extended this time limit (which expired on 19 October 2011) by one month (i.e. to 21 November 2011, since 19 November 2011 was a Saturday). On 21 November 2011, the last day of the time limit for establishing genuine use of the mark at issue, the applicant sent a five-page letter by fax, which referred to attached documents. However, no documents were attached. By fax of 23 November 2011, the applicant's representative informed the Office that it had not sent all the documents due to a fax machine failure. On 24 November 2011, the Office received by post the 69 pages of items of evidence referred to in the five-page letter sent by fax on 21 November 2011. The BoA held that the applicant had submitted no relevant proof before the CD within the time limit specified, and therefore the evidence submitted before the BoA could not be taken into account. The BoA therefore held that genuine use of the mark at issue had not been proven and that the mark had to be revoked. For the sake of completeness, the BoA nonetheless assessed the evidence submitted late before the CD, as well as that submitted before the BoA at the appeal stage, and held that it did not prove use of the mark at issue. The applicant raised two pleas: (i) infringement of Article 95(1) and (2) EUTMR and (ii) infringement of Article 58(1)(a) EUTMR. **Regarding the admissibility of the annexes:** the evidence submitted for the first time before the GC was inadmissible (paras 16-21).

[C-101/17 P](#); **LUCEO**; *Versus EOOD v EUIPO*; Order of 14 December 2017; EU:C:2017:979; Language of the case: DE. The applicant registered the word mark **LUCEO** as an EUTM for goods and services in Classes 10, 12 and 18. An application for a declaration of invalidity was filed pursuant to Article 59(1)(b) EUTMR. The CD upheld the application and declared the contested trade mark invalid because the application had been filed in bad faith. The



applicant appealed the decision. The BoA confirmed the first-instance decision. The applicant appealed that decision too. The GC dismissed the appeal. The applicant filed an action before the Court of Justice of the European Union (CJEU) on the basis of three grounds: (i) infringement of Article 94 EUTMR, (ii) infringement of Article 95 EUTMR, and (iii) infringement of Article 59(1)(b) EUTMR, seeking the annulment of the contested decision. The CJ dismissed the appeal, restating that the pleas in law and legal arguments relied on by the applicant had to identify precisely the points in the grounds of the GC's decision that were contested (Article 169 of the Rules of Procedure of the Court of Justice). Appeals are confined to points of law (Article 256(1) Treaty on the Functioning of the European Union, Article 58(1) Statute of the CJEU). In this case, the grounds of appeal were particularly unclear and incomprehensible, which prevented the Court from fulfilling its role and carrying out its review of legality (paras 20-23). The Court then restated that the appeal had not identified which facts had allegedly been distorted. Therefore, the plea, simply mentioning an error or distortion by the GC, was inadmissible, because it did not specify which elements had allegedly been distorted by the GC (paras 30-31). Consequently, the CJ dismissed the appeal (para. 35).

1.2 Claims

1.2.1 Claims to issue directions to EUIPO

♦[T-704/16](#); **SCATTER SLOTS**; *Murka Ltd v EUIPO*; Judgment of 17 October 2017; EU:T:2017:728; Language of the case: EN. The applicant filed an application for registration as an EUTM of the word mark **SCATTER SLOTS** for services in Class 41. The examiner rejected the application for registration on the ground that the mark applied for fell under the grounds for refusal of Article 7(1)(b) and (c) EUTMR. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) EUTMR and (iii) infringement of Article 7(3) EUTMR. The GC dismissed the appeal. **Admissibility**: the GC rejected as inadmissible the applicant's head of claim requesting that registration of the mark applied for be allowed. It also declared inadmissible the evidence submitted by the applicant for the first time before the GC.

1.2.2 Claims to change an EUIPO decision

♦[T-395/16](#); **WINDFINDER**; *Windfinder R & L GmbH & Co. KG v EUIPO*; Judgment of 20 July 2017; EU:T:2017:530; Language of the case: DE. The applicant sought to register the word mark **WINDFINDER** as an EUTM for goods and services in Classes 9, 35, 38, 41 and 42. The Office informed the applicant that registration of the EUTM application went against Article 7(1)(b) and (c) EUTMR. The applicant submitted its observations, and the examiner refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR for the abovementioned goods and services. The BoA dismissed the EUTM applicant's appeal, finding that the mark was descriptive and non-distinctive. The EUTM applicant filed an action before the GC claiming: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) and (c) EUTMR and (iii) infringement of Article 7(3) EUTMR. It requested that the contested decision be annulled and the appeal before the BoA be allowed. The GC annulled the contested decision for all goods and services except 'anemometers' in Class 9 and services related to meteorology in Class 42. Insofar as it



annulled the decision, it allowed the appeal. The GC considered the request that the appeal before the BoA be upheld to be an admissible request for alteration in the sense of Article 72(3) EUTMR and decided accordingly (para. 87).

♦[T-802/16](#); **FEMIBION**; *Endoceutics, Inc. v EUIPO*; Judgment of 17 November 2017; EU:T:2017:818; Language of the case: EN. Registration as an EUTM for goods in Class 5 (*Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; disinfectants*) was sought for the word mark **FEMIBION**. An application for revocation against all the goods covered by the mark was filed, based on Article 58(1)(a) EUTMR. The CD partially upheld the application, since it found that genuine use of the mark at issue had been shown only for the *dietetic substances adapted for medical use*, in respect of which registration of the mark at issue was maintained. An appeal was filed against the CD's decision by the EUTM applicant. The BoA partially upheld the appeal and annulled the CD's decision regarding maintenance of the mark's registration for the abovementioned goods. The revocation applicant filed an action before the GC, requesting annulment of the BoA decision and revocation of the mark for *pharmaceutical preparations for immune system support, for menopause, for menstruation, for treatment and management of pregnancy, for the prevention, treatment and management of stress, for the prevention, treatment and management of stress [caused by] ill-balanced or deficient nutrition*. The applicant relied on a single plea in law before the GC: infringement of Article 58(1)(a) EUTMR. **Scope of proceedings:** the GC cannot alter the BoA's decision, since that would imply, in substance, the exercise of functions specific to the Office, and would upset the institutional balance on which the division of jurisdiction between the Office and the GC is based. The GC's power to alter decisions does not allow it to carry out an assessment on which the BoA has not yet adopted a decision. It is limited to situations in which the GC can review an assessment made by the BoA (paras 46-47).

♦[T-249/15](#); **QUILAPAYÚN / QUILAPAYÚN**; *JT v EUIPO*; Judgment of 11 December 2017; EU:T:2017:885, Language of the case: ES. Registration as an EUTM for goods and services in Classes 9, 16 and 41 was sought for the figurative sign **QUILAPAYÚN**. An opposition based on the earlier well-known figurative mark, French trade mark and international trade mark **QUILAPAYÚN**, registered for goods and services in Class 41, was filed pursuant to Article 8(1)(a) and (b) and Article 46 EUTMR. The OD partly upheld the opposition insofar as it found a LOC, given the identity of the signs and the similarity or identity of the goods and services covered (in Class 9: *magnetic data carriers, recording discs* and in Class 41: *providing of training; entertainment; sporting and cultural activities*). The BoA upheld the appeal filed, annulling the OD's decision. It also found that the opponent had not presented evidence of being the 'real proprietor' of the previous well-known mark; proprietorship was also claimed by the other parties to the proceedings. Finally, it concluded that it had no competence to decide who met the conditions of being proprietor of the unregistered well-known mark; this was up to the national court to decide. The opponent filed an action before the GC, relying on a single plea in law: the erroneous interpretation and application of Article 8(2)(c) EUTMR in conjunction with Article 6*bis* of the Paris Convention. **Co-proprietorship and entitlement for opposition:** the BoA had erred in law insofar as it had required evidence of the opponent being the sole proprietor of the previous mark without assessing whether co-proprietorship was sufficient entitlement for filing the opposition (para. 50). Article 2(1) EUTMDR does not prevent the earlier mark from having several proprietors. Should sole proprietorship be necessary, then none of the co-proprietors of the trade mark could individually oppose registration of the contested sign on behalf of a third party (paras 47-48). The opponent did not maintain for the first time before the GC that he was co-proprietor of the previous mark: he had not denied that the previous well-known mark



could have several proprietors, as he had stated that, in the absence of any explicit decision regarding co-proprietorship, two different musical groups had been set up, both claiming the contested sign (para. 51). **The request to refuse registration:** as for the request for the GC to refuse registration, it must be noted that the GC's competence to alter decisions does not have the effect of conferring on the GC the power to substitute its own reasoning for that of a BoA or to assess issues on which the BoA has not yet adopted a position. Exercise of the power to alter decisions must therefore, in principle, be limited to situations in which the GC, after reviewing the assessment made by the BoA, is in a position to determine, on the basis of the matters of fact and of law as established, what decision the BoA was obliged to take. Therefore, it is not up to the GC to examine the arguments regarding the acquisition of rights by the applicant in the earlier unregistered mark (para. 52).

1.2.3 *Claim by applicant to confirm decision*

♦[T-132/15](#); **popchrono**; *IR v EUIPO*; Judgment of 14 March 2017; EU:T:2017:162; Language of the case: EN. The EUTM proprietor was granted registration of the word mark **POPCHRONO** as an EUTM for goods and services in Class 12. An application for revocation was filed pursuant to Article 58 EUTMR. The CD upheld the application for revocation. The BoA dismissed the EUTM proprietor's appeal. It found that the EUTM proprietor had not proven genuine use of the contested EUTM. The GC confirmed that it was not competent to issue confirmatory rulings (paras 26-28).

♦[T-7/15](#); **LEOPARD true racing / Leopard CASA Y JARDIN**; *Leopard SA v EUIPO*; Judgment of 19 October 2017; EU:T:2017:731; Language of the case: FR. The applicant sought to register the figurative mark **LEOPARD TRUE RACING** as an EUTM for goods and services in Classes 9, 12, 18, 25, 28, 35 and 41. An opposition based, inter alia, on the earlier EUTM figurative mark **LEOPARD CASA Y JARDIN**, registered for goods in Class 25, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition for all goods in Class 25 and for some of the goods in Classes 18 and 28. The BoA partly upheld the EUTM applicant's appeal. It found that there was a LOC for all goods in Class 25 and for some of the goods in Class 28. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal and declared inadmissible the claim for confirmation of some of the findings of the BoA's contested decision (paras 25-26).

1.2.4 *Claim in excess of what is appealable*

♦[T-374/15](#); **Vermögensmanufaktur**; *VM Vermögens-Management GmbH v EUIPO*; Judgment of 7 September 2017; EU:T:2017:589; Language of the case: DE. The EUTM proprietor was granted registration of the word mark **Vermögensmanufaktur**, which translates literally as 'asset manufacture', as an EUTM for the class headings in Classes 35 and 36. An application for invalidity was filed pursuant to Article 59(1)(a) in conjunction with Article 7(1)(b) and (c) EUTMR. The CD dismissed the application for invalidity. The BoA upheld the invalidity applicant's appeal and declared the EUTM invalid on account of its descriptive character and lack of distinctiveness. The EUTM proprietor filed an action before the GC, relying on four pleas in law, namely infringements of (i) Article 7(1)(b), (ii) Article 7(1)(c), (iii) Article 94 and (iv) Article 95 EUTMR. After filing the action, the EUTM proprietor declared under Article 33(8) EUTMR that its intention on the date of filing the



EUTM had been to seek protection in respect of services beyond those covered by the literal meaning of the class headings of Classes 35 and 36. Accordingly, services from the alphabetical list were included in the EUTM's specification. With regard to these services, the EUTMR proprietor requested, in the alternative, that the GC declare the EUTM's registration to be partially maintained or remit the case to this extent to the CD. The GC dismissed the appeal. **The applicant's requests in the alternative:** the applicant's alternative requests with respect to services from the alphabetical list were inadmissible since they were based on the declaration under Article 33(8) EUTMR made after the contested decision was adopted and, hence, not apt to challenge its legality (paras 149-155).

♦[T-7/15](#); **LEOPARD true racing / Leopard CASA Y JARDIN**; *Leopard SA v EUIPO*; Judgment of 19 October 2017; EU:T:2017:731; Language of the case: FR. The applicant sought to register the figurative mark LEOPARD TRUE RACING as an EUTM for goods and services in Classes 9, 12, 18, 25, 28, 35 and 41. An opposition based, inter alia, on the earlier EUTM (figurative mark) LEOPARD CASA Y JARDIN, registered for goods in Class 25, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition for all goods in Class 25 and for some of the goods in Classes 18 and 28. The BoA partly upheld the EUTM applicant's appeal. It found that there was a LOC for all goods in Class 25 and for some of the goods in Class 28. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. **Scope of proceedings:** the GC may not annul or alter a decision on grounds that come into existence subsequent to its adoption. For its review of the legality of the contested decision in this case, the GC was not required to take into account the Office decision revoking the earlier mark that formed the basis for the opposition, since such revocation post-dated the contested decision (paras 20-22).

1.2.5 Clarification of claim by applicant

[No entry]

1.2.6 Interpretation of claim by Court

♦[T-470/16](#); **DEVICE OF A TRIANGLE**; *X-cen-tek v EUIPO*; Judgment of 28 June 2017; EU:T:2017:442; Language of the case: DE. The applicant sought to register a figurative EUTM for goods in Classes 5, 9 to 12, 18, 22, 25 and 26. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) EUTMR as it was found to be devoid of distinctive character. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC, relying on two pleas in law: infringement of (i) Article 7(1)(b) EUTMR, and (ii) Article 94(1) EUTMR. The GC dismissed the action. Although the applicant had not quoted Article 94 EUTMR, it was clear from its arguments that it claimed a lack of reasoning (para. 51). It claimed that the BoA had not given reasons why the different colours and sizes of the triangles were not sufficient for the sign to be perceived as an indication of origin. Even if this were true, it would not result in the annulment of the decision, as it followed from the decision that the sign lacked distinctive character (paras 52-56). The BoA had set out the factual findings and the legal considerations for the refusal in sufficient detail (para. 59).



1.2.7 *Claim that the case has become devoid of purpose*
[No entry]

1.3 **Undisputed facts, arguments, grounds or evidence**
[No entry]

1.4 **New facts, arguments, grounds or evidence**

♦[T-19/15](#); **wax by Yuli's**; *Yuleidy Caridad Gómez Echevarría v EUIPO*; Judgment of 1 February 2017; EU:T:2017:46; Language of the case: ES. The EUTM proprietor was granted registration of the figurative mark **wax by Yuli's** as an EUTM for goods and services in Class 25. An application for invalidity was filed pursuant to Article 60(1)(a) in conjunction with Article 8(1)(b) EUTMR. The CD upheld the application for invalidity on the basis of the earlier word mark **MADWAX**. It considered it unnecessary to assess the case on the basis of the remaining earlier mark. The BoA dismissed the EUTM proprietor's appeal. It found that there was a LOC between the contested EUTM and the two earlier marks. The proprietor filed an action before the GC, relying on five pleas in law: (i) infringement of Article 71(1) EUTMR in conjunction with Article 41(2) of the Charter of Fundamental Rights; (ii) infringement of Article 8(1)(b) EUTMR insofar as the application for invalidity constituted an abuse of rights; (iii) and (iv) incorrect application and interpretation of Article 60(1)(a) in conjunction with Article 8(1)(b) EUTMR; and (v) incorrect application of Rule 94(1) and (7) of Implementing Regulation (EC) No 2868/95 in conjunction with Article 109(1) EUTMR. The GC dismissed the appeal. The BoA had correctly carried out an assessment of whether there was a LOC between the contested mark and both earlier marks. This was not altered by the facts that (i) the CD had not included the figurative earlier mark in its assessment, and (ii) the EUTM proprietor had not submitted any arguments before the BoA in relation to that earlier mark (paras 17-23). The GC referred to previous case-law by analogy (15/01/2013, T-237/11, Bellram, EU:T:2013:11) and confirmed that the right of defence had not been infringed in this case (paras 24-31). The applicant's arguments on the abuse of rights were inadmissible since they had been presented for the first time before the GC (paras 33-38).

♦[T-30/16](#); **Natural Instinct Dog&Cat food as nature intended (FIG. MARK) / NATURE'S VARIETY et al.**; *M.I. Industries, Inc. v EUIPO*; Judgment of 15 February 2017; EU:T:2017:77; Language of the case: EN. The applicant sought to register the figurative mark **Natural Instinct Dog&Cat food as nature intended** as an EUTM for goods in Class 31. An opposition based on the earlier word marks **INSTINCT** and **NATURE'S VARIETY**, both registered for goods in Class 31, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition, considering that the opponent had not proven genuine use of the earlier mark **INSTINCT** and that there would be no LOC with the earlier mark **NATURE'S VARIETY**. The BoA dismissed the opponent's appeal. It examined the genuine use of both earlier marks, and found that the nature of the use had not been proven, as the trade marks had not been used publicly and outwardly. Moreover, with regard to **NATURE'S VARIETY**, it found that the evidence did not show use as a trade mark. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 47(2) EUTMR and Rules 22(3) and (4) of Implementing Regulation (EC) No 2868/95; (ii) infringement of Article 8(1)(b) EUTMR; and (iii) infringement of Article 94 EUTMR. The GC partly upheld the appeal. It found that the BoA had wrongly assessed the evidence of use of the mark **INSTINCT**. However, it confirmed the BoA's conclusion that the evidence did not show that



NATURE'S VARIETY had been used as a trade mark. It considered the second plea ineffective as the BoA had not taken a position on the LOC. It dismissed the third plea. **Admissibility of new evidence:** the GC rejected the Office's claim that colour copies of evidence previously submitted in black and white are inadmissible (para. 17).

♦[T-132/15](#); **popchrono**; *IR v EUIPO*; Judgment of 14 March 2017; EU:T:2017:162; Language of the case: EN. The EUTM proprietor was granted registration of the word mark **POPCHRONO** as an EUTM for goods and services in Class 12. An application for revocation was filed pursuant to Article 58 EUTMR. The CD upheld the application for revocation. The BoA dismissed the EUTM proprietor's appeal. It found that the EUTM proprietor had not proven genuine use of the contested EUTM. The GC held that the evidence submitted by the EUTM proprietor for the first time before the GC was inadmissible (paras 29-31), as was a new plea in law and the offer of further evidence (paras 32-43).

♦[T-239/15](#); **Cryo-Save**; *Cryo-Save AG v EUIPO*; Judgment of 23 March 2017; EU:T:2017:202; Language of the case: DE. An application for revocation was filed pursuant to Article 58(1)(a) EUTMR. The proprietor had to prove that the mark **Cryo-Save** was used for all goods and services, which were mainly special medical apparatus in Class 10; highly specific scientific and technological services, mainly in the area of stem cells, in Class 42; and medical services, also mainly relating to stem cells, in Class 44. The CD upheld the application for invalidity in its entirety as the proof of use was considered insufficient. The BoA dismissed the EUTM proprietor's appeal. It found that the documents submitted before the CD, as well as additional documents submitted during the appeal proceedings, were not sufficient to prove use of the contested mark, which thus had to be revoked. The EUTM proprietor filed an action before the GC, relying on two pleas in law: (i) an infringement of Article 63(2) EUTMR and Rule 37(b)(iv); and (ii) an infringement of Article 58(1)(a) EUTMR. The GC dismissed the appeal. The EUTM proprietor had raised an issue relating to the admissibility of the application for revocation for the first time before the GC, arguing primarily that an application for revocation had to state the grounds on which the application was based (e.g. by submitting a search carried out at the time of filing the application for revocation to show that the mark attacked was not used). The GC found that the proprietor had at no time before the BoA claimed that the revocation request did not fulfil the requirements according to Article 63(2) EUTMR and Rule 37(b)(iv) of Implementing Regulation (EC) No 2868/95. The BoA had not had to decide in the case concerned whether the application for revocation had been filed in a written reasoned statement in accordance with Article 63(2) EUTMR (para. 21). The fact that the claim in that respect had been made for the first time only before the GC would widen the legal scope of the proceedings and thus the case that had been at issue before the BoA.

♦[T-216/16](#); **Le Val / VIÑA DEL VAL et al.**; Judgments of 23 March 2017; *Vignerons de la Méditerranée v EUIPO*; EU:T:2017:201; Language of the case: FR. The applicant sought to register the figurative mark **Le Val** as an EUTM for goods in Class 33. An opposition based on the earlier word mark **VIÑA DEL VAL**, registered for goods in Class 33, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition. The BoA confirmed the OD's finding that there was a LOC in the English-speaking parts of the EU in view of the identity/similarity of the goods and the fact that the dominant element 'VAL' of the earlier mark coincided with the dominant element of the mark applied for. The GC dismissed the action. Regarding procedure, the GC confirmed that new documents submitted for the first time before it, with the aim of showing that the term 'VAL' was commonly used for wines in the EU were inadmissible. Although new documents may be admissible if they seek to establish a well-known fact, this did not apply to the alleged widespread use of the term 'VAL' in the wine sector, because this fact was not well known (para. 40). Nor are new documents



admissible merely because they support an argument previously submitted before the Office (para. 42).

♦[T-215/16](#); **AMPHIBIAN**; Judgment of 3 April 2017; *Cop Vertriebs-GmbH v EUIPO*; EU:T:2017:241; Language of the case: DE. The CD rejected the request for a declaration of invalidity based upon absolute grounds for invalidity (Articles 7(1)(c) and (b) EUTMR). The BoA dismissed the appeal. As regards Article 7(1)(c) EUTMR, it confirmed the CD's finding that the invalidity applicant had not established the descriptive character of the contested mark **AMPHIBIAN** for *waterproof watches* in Class 14 for the relevant English-speaking public in the EU. With respect to Article 7(1)(b) EUTMR, it observed that the invalidity applicant had not put forward any specific argument in support of this ground. The GC dismissed the action. The argument of the invalidity applicant — upon whom falls the burden of demonstrating the descriptive character of the contested mark (paras 49-51) — that such descriptive character might be different for the professional public consisting of the military or police was made for the first time in the proceedings before the GC and was thus rejected as inadmissible (paras 48, 52, 53).

♦[C-71/16 P](#); **ZuMEX / JUMEX**; *Comercializadora Eloro, S.A. v EUIPO + Zumex Group, S.A.*; Order of 4 May 2017; EU:C:2017:345; Language of the case: ES. The applicant sought to register a figurative mark as an EUTM for goods in Class 32. An opposition based on an earlier mark registered for goods in the same Class was filed pursuant to Article 8(1) EUTMR. The applicant requested that the opponent prove genuine use of the earlier mark. The OD considered genuine use of the earlier mark to be proven and upheld the opposition in its entirety. The applicant filed an appeal before the BoA. The BoA, after inviting the opponent to clarify, in particular, whether the goods mentioned in the invoices had actually been put into circulation in the territory of the EU, and after considering that the new documents for proving use of the earlier mark had been submitted out of time, found that genuine use had not been proven. Consequently, the BoA upheld the appeal and annulled the OD's decision. The opponent filed an action before the GC, relying on two pleas in law: (i) infringement of Article 47(2) EUTMR, and (ii) infringement of Article 8(1)(b) EUTMR. The GC dismissed the first plea and, consequently, the second one and the action in its entirety. The opponent filed an action before the CJ. The CJ dismissed all three grounds of appeal and hence the appeal in its entirety. The opponent had alleged, as a first ground, that the GC had based its decision on the probative value of a document that should not have been taken into account and that the GC had failed in its duty to state reasons in relation to the probative value of that document. The CJ pointed out that any reference to that document was made purely for the sake of completeness (paras 34-39), which was also the reason why the second ground was dismissed (paras 48-49). The CJ also found that the GC's implicit dismissal of the arguments concerning the probative value of the document concerned was in accordance with settled case-law (paras 41-43). As regards the third ground, the CJ confirmed that the GC had not erred in law when it had determined that the BoA had correctly applied Article 95(2) EUTMR (paras 61-67). The CJ pointed out that the case-law in no way imposes an enhanced obligation to justify a decision to not take belated evidence into account (para. 60).

♦[C-437/16 P](#); **CHEMPIOIL / CHAMPION**; *Wolf Oil Corp. v EUIPO*; Judgment of 5 October 2017; EU:C:2017:737; Language of the case: EN. The applicant had obtained the international registration (IR) designating the EU of the word mark **CHEMPIOIL** for goods in Classes 1, 3 and 4. An opposition was filed, based, inter alia, on the IR designating the EU and France of the figurative mark **CHAMPION** for goods in Classes 1, 3 and 4. The OD partly upheld the opposition. The BoA upheld the appeal, annulling the OD's decision insofar as it had upheld the opposition for some of the goods referred to and dismissed it for the others. The opponent's action before the GC was dismissed. The opponent then filed an



action before the CJ, relying on two pleas in law: (i) alleged distortion of evidence and failure to state reasons, and (ii) infringement of Article 8(1)(b) EUTMR. The CJ dismissed the appeal, stating that the appellant had not based the third part of its second ground of appeal, which it had raised for the first time at the hearing before the GC, on any element of law or fact disclosed during the proceedings giving rise to the judgment under appeal and had itself recognised that the factual evidence on which it relied formed part of the evidence before the EUIPO. The GC was therefore right to refrain from responding to that complaint, which was inadmissible (para. 62).

♦[T-36/17](#); **colineb / Colina**; *Forest Pharma BV v EUIPO*; Judgment of 5 October 2017; EU:T:2017:690; Language of the case: EN. The BoA dismissed the appeal (R 500/2016-5) against the OD's decision. The goods of the earlier mark in Class 5 were identical to the contested goods in Class 5 and similar to a low degree to those in Class 10, the signs were similar, and there was a LOC. The GC dismissed the action. Challenging the proof of use (PoU) for the first time before the GC is inadmissible, as this issue does not constitute a question of law that must necessarily be examined by the BoA (paras 16-26). The BoA did not breach the adversarial principle, as it was entitled to rely on information it considered 'well known' (namely, that certain gastric conditions may cause respiratory disorders), without being obliged to (i) prove the accuracy of the facts or (ii) even produce examples to illustrate the facts (paras 30, 33, 35, 72).

♦[T-704/16](#); **SCATTER SLOTS**; *Murka Ltd v EUIPO*; Judgment of 17 October 2017; EU:T:2017:728; Language of the case: EN. The applicant filed an application for registration as an EUTM of the word mark **SCATTER SLOTS** for services in Class 41. The examiner rejected the application for registration on the ground that the mark applied for fell under the grounds for refusal of Article 7(1)(b) and (c) EUTMR. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) EUTMR, and (iii) infringement of Article 7(3) EUTMR. The GC dismissed the appeal. **Admissibility:** the GC rejected as inadmissible the applicant's head of claim requesting that registration of the mark applied for be allowed. It also declared inadmissible the evidence submitted by the applicant for the first time before the GC.

♦[T-114/16](#); **DESIGN OF INFRARED CABINS AND SAUNAS**; *Delfin Wellness GmbH v EUIPO*; Judgment of 13 December 2017; EU:T:2017:899; Language of the case: DE. The intervener is the proprietor of three contested Community designs, all registered on 17 December 2008 for *infrared cabins, saunas* in Class 23.02 of the Locarno classification. The applicant filed an application for invalidity on the grounds that, as it had been selling these designs since at least 2007, the registered Community designs (RCDs) did not meet the condition of novelty. The Invalidity Division (ID) upheld the application for invalidity pursuant to Article 25(1)(b) of the Community Design Regulation (CDR) on the grounds that the evidence submitted by the applicant demonstrated the disclosure of the contested designs. The intervener filed three appeals against the ID's decisions. The BoA considered that the applicant had not proven an event of disclosure outside the grace period and, therefore, rejected the invalidity application. The applicant raised two pleas in law: (i) incorrect assessment of the evidence for the purposes of Article 7 CDR, and (ii) infringement of the right to be heard. Admissibility of the annexes: evidence submitted for the first time before the GC is inadmissible (paras 28 and 29).



1.5 Limitation, including restriction of goods and services

♦[T-473/15](#); **APUS / ABUS**; *Capella EOOD v EUIPO*; Judgment of 16 March 2017; EU:T:2017:174; Language of the case: DE. In the course of the appeal proceedings, the applicant declared two subsequent restrictions on the goods *vehicles and their parts* in Class 12 of its EUTM application. The first restriction read: *vehicles for use on land*; [...], while the second read: *automotive vehicles for use on land, namely passenger vehicles; tyres; wheel trims*; [...]. In the contested decision, the BoA accepted the first restriction but rejected the second in its entirety, reasoning that *tyres; wheel trims* were previously not contained in the specification. On the merits, the BoA upheld the opposition for *vehicles for use on land* on the basis of Article 8(1)(b) EUTMR and rejected it for the remaining goods. Before the GC, the applicant claimed that only the OD, not the BoA, was competent to decide on restriction, and that its right to be heard had been infringed because it had not been informed about the refusal of its second application for restriction before the contested decision was taken. The GC confirmed the BoA's competence to process restrictions declared during the course of appeals. By virtue of Article 71(1) EUTMR (para. 29), and with regard to the principle of continuation of proceedings (para. 38), this competence is based on and shaped by that of the OD. Restrictions may have an effect (a) on the continuation of the opposition proceedings, and (b) on the assessment of the LOC (para. 34). Thus, there is a close connection between restriction and opposition proceedings that is relevant for the parties' right to be heard. The GC found an infringement of the general legal principle of the right to be heard, as enshrined in Article 94 EUTMR, since the BoA had decided on the opposition on the basis of the first restriction, without informing the applicant beforehand that the second restriction was ineffective (paras 41-61). Furthermore, the BoA had also committed a procedural error in not applying Rule 13(3) Implementing Regulation (EC) No 2868/95, which also specifies the right to be heard (paras 62-67). This provision stipulates that the Office should communicate to the applicant any formal or other deficiencies with regard to restrictions under Article 49 EUTMR. Given that the errors concerned the goods to be compared, they may have had an impact on the assessment of the LOC and thus led to the annulment of the contested decision (paras 68-69).

♦[T-771/16](#); **EZMIX**; *Toontrack Music AB v EUIPO*; Judgment of 22 November 2017; EU:T:2017:826; Language of the case: SV. The applicant sought to register the word mark **EZMIX** as an EUTM for goods and services in Classes 9, 15 and 42. The examiner refused registration for goods in Classes 9 and 15 on the grounds of Article 7(1)(b) and (c) EUTMR but allowed it for goods in Class 42 (*cloud computing*). Upon appeal, the applicant filed, inter alia, the restriction *all goods/services intended exclusively for use with digital audio workstations (DAW) only, and for professional composers and music creators* at the end of Classes 9 and 42. The BoA dismissed both the restriction to particular persons and the appeal. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 49 EUTMR, (ii) infringement of Article 7(1)(c) and Article 7(2) EUTMR, and (iii) infringement of Article 7(1)(b) and Article 7(2) EUTMR. **Restriction of the list of goods and services:** the restriction of the goods and services to *professional composers and music creators* at the end of the specification cannot be divided from the further restrictions within the specification; it builds a unit. Therefore, the Board correctly found the entire restriction inadmissible. It was not necessary to assess the admissibility of the further restrictions. In addition, the further goods restricted to *namely, for amplifier simulator* are also used for mixing music. The restriction cannot affect the direct link between the trade mark and the goods and services. The same applies to the restriction *for composers and creators of music* (paras 70-75).



1.6 Matters of fact appealed to CJ

♦[C-655/15 P](#); **Krispy Kreme DOUGHNUTS**; *Panrico, S.A. v EUIPO*; Judgment of 2 March 2017; EU:C:2017:155; Language of the case: ES. An application for invalidity was filed pursuant to Article 60(1)(a) in conjunction with Article 8(1)(b) and Article 8(5) EUTMR against this EUTM, which was registered for goods in Class 30 and services in Class 42. The application for invalidity was based on the Spanish word marks **DOGHNUTS** and **DONUT** (both registered for goods in Class 30), the Spanish figurative marks **DONUTS** and **DONUTS CREAM** (both registered for goods in Class 30) and the international word mark **DONUT** (which covers goods in Classes 30 and 31). The CD rejected the application for invalidity in its entirety. The BoA dismissed the invalidity applicant's appeal. It found that the mark **DONUTS CREAM** had expired and that genuine use of the mark **DOGHNUTS** had not been proven. For the rest, the BoA ruled out a LOC and concluded that the contested mark would not take unfair advantage of the distinctive character or repute of the earlier word marks. The invalidity applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 60(1)(a) in conjunction with Article 8(1)(b) EUTMR, and (ii) infringement of Article 60(1)(a) in conjunction with Article 8(5) EUTMR. The GC dismissed the action. It found that there was only a remote aural similarity between the signs and concluded that there was no LOC even if the earlier marks had enhanced distinctiveness; such remote similarity was insufficient for consumers to establish a link between the signs, regardless of the high reputation of the earlier marks and the similarity or even identity between the goods and services involved. The invalidity applicant's appeal before the CJ was dismissed. The invalidity applicant argued that the BoA, in its assessment of the similarity between the signs, should have taken into account the enhanced distinctiveness of the element 'DOUGHNUTS' because of the reputation of the earlier marks. The CJ found this argument inadmissible since it had been presented for the first time before the CJ (paras 44-47). The CJ dismissed the first plea after clarifying that, contrary to the invalidity applicant's understanding, the GC had taken into account the enhanced protection enjoyed by reputed trade marks and hence by the earlier marks (paras 48-54). The CJ dismissed the second and third pleas as partially inadmissible, namely the parts that implied a request for a new factual assessment (paras 68-69 and 87-89), and partially unfounded.

♦[C-437/16 P](#); **CHEMPIOIL / CHAMPION**; *Wolf Oil Corp. v EUIPO*; Judgment of 5 October 2017; EU:C:2017:737; Language of the case: EN. The applicant had obtained the international registration (IR) designating the EU of the word mark **CHEMPIOIL** for goods in Classes 1, 3 and 4. An opposition was filed, based, inter alia, on the IR designating the EU and France of the figurative mark **CHAMPION** for goods in Classes 1, 3 and 4. The OD partly upheld the opposition. The BoA upheld the appeal, annulling the OD's decision insofar as it had upheld the opposition for some of the goods referred to and dismissed it for the others. The opponent's action before the GC was dismissed. The opponent then filed an action before the CJ, relying on two pleas in law: (i) alleged distortion of evidence and failure to state reasons, and (ii) infringement of Article 8(1)(b) EUTMR. The CJ dismissed the appeal. Regarding the first plea in law, the CJ emphasised that the appellant was merely criticising the reasoning of the judgment under appeal insofar as the GC had considered that the sign 'CHEMPIOIL' did not convey any clear concept. In so doing, without precisely identifying the evidence that the GC had allegedly distorted, it was in effect seeking to obtain from the CJ a new assessment of the conceptual differences between the two signs at issue. Consequently, the first ground of appeal had to be regarded as inadmissible insofar as it alleged a distortion of the evidence (paras 26-27). Furthermore, according to the CJ, the GC had clearly set out the reasons that led it to consider that the signs at issue should be regarded as conceptually different (para. 31).



1.7 **Other, including general reference to previous statements**

♦[T-419/16](#); **Carrera**; *Carrera Brands Ltd v EUIPO*; Judgment of 16 November 2017; EU:T:2017:812; Language of the case: DE. In 2005, Autec AG, the applicant for revocation, gave a contractual undertaking vis-à-vis Lutter & Partner GmbH not to challenge any trade mark application containing the term 'CARRERA'. In 2007, Lutter & Partner was granted registration of the word mark **CARRERA** as an EUTM for goods and services in Classes 7 to 11 and 21. The mark was then transferred to L+P holding GmbH, before being transferred to Carrera Brands, the EUTM proprietor. In 2012, an application for revocation was filed by Autec AG. The CD upheld the application for all the goods. The BoA partly upheld the EUTM proprietor's appeal since genuine use of the mark was proven for some of the goods. However, it rejected the request for suspension of proceedings. It also found that the no-challenge agreement could not have any effect on the obligation to use the mark. The proprietor filed an action before the GC, relying on two pleas in law: (i) infringement of Article 63(1)(a) EUTMR, and (ii) infringement of Rule 20(7)(c) of Implementing Regulation (EC) No 2868/95. The GC dismissed the appeal. **Admissibility:** the applicant's general reference to the pleadings before the Office is inadmissible (paras 21-25).

2. **Essential procedural requirements**

2.1 **Right to be heard**

♦[T-509/15](#); **PremeNo / Pramino**; *Kessel medintim GmbH v EUIPO*; Judgment of 3 February 2017; EU:T:2017:60; Language of the case: DE. An opposition against the EUTM application for the word mark **PremeNo** for *vaginal ovules* in Class 5 was upheld on the basis of the earlier word mark **Pramino**, registered in Germany for *prescription medicines*. Use of the earlier mark was proven for *prescription medicines, namely hormonal contraceptives*. The goods were considered identical, the marks were considered similar, and a LOC was affirmed. In the appeal against this decision, the EUTM applicant requested a limitation of the goods applied for to *non-prescription vaginal ovules against vaginal dryness and vaginal infections*. When dismissing the appeal, the BoA considered the limitation inadmissible and upheld the finding of a LOC (first BoA decision). By judgment in Case [T-536/10](#) (08/11/2013, T-536/10, *Premeno*, EU:T:2013:586), the GC annulled the BoA decision, considering the restriction of goods admissible. That judgment was confirmed by the CJ (11/12/2014, [C-31/14 P](#), *Premeno*, EU:C:2014:2436). The case was remitted to the BoA, which based its examination on the list of goods as restricted by the applicant. It found a LOC. The EUTM applicant filed an action before the GC, claiming infringement of Article 94 EUTMR, with the reasoning that the BoA had not given it an opportunity to comment on the judgment and make a further limitation. It also claimed infringement of Article 8(1)(b) EUTMR, contesting the LOC. The GC rejected both pleas. With regard to the alleged infringement of Article 94 EUTMR, the GC restated that there was no obligation to hear the parties after the case had been remitted to the BoAs upon an annulment by the GC (paras 25 and 26 with reference to further case-law). The applicant's right to be heard had been observed when it was given the opportunity to present its position in the proceedings that led to the first BoA decision (para. 27). The BoA followed the guidelines laid down by the GC judgment (para. 33). The applicant was not prohibited from making further restrictions of the goods at any time of the proceedings pursuant to Article 49(1) EUTMR, without being invited to do so by the BoA (para. 34).



♦[T-132/15](#); **popchrono**; *IR v EUIPO*; Judgment of 14 March 2017; EU:T:2017:162; Language of the case: EN. The EUTM proprietor was granted registration of the word mark **POPCHRONO** as an EUTM for goods and services in Class 12. An application for revocation was filed pursuant to Article 58 EUTMR. The CD upheld the application for revocation. The BoA dismissed the EUTM proprietor's appeal. It found that the EUTM proprietor had not proven genuine use of the contested EUTM. The GC dismissed in a standard way the applicant's pleas related to the right to be heard (paras 46-67).

♦[T-36/17](#); **colineb / Colina**; *Forest Pharma BV v EUIPO*; Judgment of 5 October 2017; EU:T:2017:690; Language of the case: EN. The BoA dismissed the appeal (R 500/2016-5) against the OD's decision. The goods of the earlier mark in Class 5 were identical to the contested goods in Class 5 and similar to a low degree to those in Class 10, the signs were similar, and there was a LOC. The GC dismissed the action. Challenging the PoU for the first time before the GC is inadmissible as this issue does not constitute a question of law that must necessarily be examined by the BoA (paras 16-26). The BoA did not breach the adversarial principle, as it was entitled to rely on information it considered 'well known' (namely, that certain gastric conditions may cause respiratory disorders), without being obliged to (i) prove the accuracy of the facts or (ii) even produce examples to illustrate the facts (paras 30, 33, 35, 72).

2.2 Adequate reasoning

♦[C-598/14 P](#); **LAGUIOLE**; Judgment of 5 April 2017; *EUIPO v Gilbert Szajner*; EU:C:2017:265; Language of the case: FR. The holder of the contested EUTM registration had submitted, for the first time before the GC, a judgment of the French *Cour de Cassation* [Court of Cassation], rendered **after** the BoA decision. This judgment supported the view that the scope of protection of a corporate name is defined by reference to the business actually carried out by a company. The GC had considered this judgment admissible and had reviewed the legality of the BoA decision in the light thereof. This had led the GC to annul in part the BoA decision (21/10/2014, [T-453/11](#), *Laguiole*, EU:T:2014:901). The Office lodged an appeal before the CJ on two accounts: (i) infringement of Article 72(2) EUTMR in that the legality of the BoA decision had been examined in the light of subsequent circumstances, and (ii) infringement of Article 8(4) EUTMR in that the GC had failed to apply the French law properly. The CJ dismissed the appeal. **The scope of review of legality and the duty to state reasons:** the CJ confirmed that, when reviewing the correct application of national law under Article 8(4) EUTMR, the GC has the competence to make searches *ex officio* in the national case-law 'beyond the documents submitted' in order to make up for 'possible lacunae in the documents submitted as evidence of the applicable national law' (para. 38). The GC may also take into account national judgments handed down **after** the adoption of a BoA decision. Otherwise, the GC would be deprived 'of the real possibility of conducting in an effective manner the full review of legality' and would not be in a position to comply with the principle of effective judicial protection (paras 41-42). 'It is true that the taking into consideration of a decision of a national court issued after the adoption of the decision of the Board of Appeal of EUIPO could lead the General Court to undertake an assessment of a rule of national law which differs from that of that Board of Appeal. However, since the judicial review of the assessment of national law by that Board of Appeal, conducted by the General Court, would be a full review of legality, the fact — revealed after the adoption of the decision of the same Board of Appeal — that that decision was based on an incorrect interpretation of national law cannot ... prevent that error from being corrected' (para. 43).



♦[C-71/16 P](#); **ZuMEX / JUMEX**; *Comercializadora Eloro, S.A. v EUIPO + Zumex Group, S.A.*; Order of 4 May 2017; EU:C:2017:345; Language of the case: ES. The applicant sought to register a figurative mark as an EUTM for goods in Class 32. An opposition based on an earlier mark, registered for goods in the same Class was filed pursuant to Article 8(1) EUTMR. The applicant requested that the opponent prove genuine use of the earlier mark. The OD considered genuine use of the earlier mark to be proven and upheld the opposition in its entirety. The applicant filed an appeal before the BoA. The BoA, after inviting the opponent to clarify, in particular, whether the goods mentioned in the invoices had actually been put into circulation in the territory of the EU, and after considering that the new documents for proving use of the earlier mark had been submitted out of time, found that genuine use had not been proven. Consequently, the BoA upheld the appeal and annulled the OD's decision. The opponent filed an action before the GC, relying on two pleas in law: (i) infringement of Article 47(2) EUTMR, and (ii) infringement of Article 8(1)(b) EUTMR. The GC dismissed the first plea and, consequently, the second one and the action in its entirety. The opponent filed an action before the CJ. The CJ dismissed all grounds of appeal and hence the appeal in its entirety. The opponent had alleged, as a first ground, that the GC had based its decision on the probative value of a document that should not have been taken into account and that the GC had failed in its duty to state reasons in relation to the probative value of that document. The CJ pointed out that any reference to that document was made purely for the sake of completeness (paras 34-39), which was also the reason why the second ground was dismissed (paras 48-49). The CJ also found that the GC's implicit dismissal of the arguments concerning the probative value of the document concerned was in accordance with settled case-law (paras 41-43). As regards the third ground, the CJ confirmed that the GC had not erred in law when it had determined that the BoA had correctly applied Article 95(2) EUTMR (paras 61-67). The CJ pointed out that the case-law in no way imposes an 'enhanced obligation' to justify a decision to not take belated evidence into account (para. 60).

♦[C-437/15 P](#); **deluxe**; *EUIPO v Deluxe Entertainment Services Group Inc.*; Order of 17 May 2017; EU:C:2017:380; Language of the case: ES. The applicant sought to register the figurative mark **deluxe** as an EUTM for goods and services in Classes 9, 35, 37, 39, 40, 41, 42 and 45. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR, on the grounds that it, first, was devoid of distinctive character and, second, informed consumers about the quality of the goods and services concerned. The applicant's appeal before the BoA was dismissed. The BoA held that in the parts of the EU where English was understood, the word 'deluxe' was not on its own capable of distinguishing the applicant's goods and services from those of its competitors since it was a commonplace promotional tag and merely consisted of a 'statement of superior quality'. It also found that the remaining elements were not capable of providing the mark with the minimum distinctive character and that the claimed acquired distinctiveness through use had not been proven. The applicant filed an application for annulment before the GC. The GC upheld the action. It held that the BoA had erred in law in adopting a general reasoning for all the goods and services, as they did not have a sufficiently direct and specific link to each other to form a homogenous category; nor had the BoA identified such a link. Therefore, the BoA had neither carried out the specific assessment required by Article 7(1)(b) EUTMR nor justified its decision for each of the goods and services. The Office filed an appeal before the CJ. The CJ annulled the GC decision and remitted the case to the GC for further assessment. The GC should, first, have verified whether the mark applied for could be perceived, directly and immediately, as a statement of superior quality or as a laudatory message by the relevant public instead of as an indication of the commercial origin of the designated goods and services. Second, the GC should also have verified whether the term 'deluxe' conveyed the concept of superior quality as a result of it being a direct reference to the concept of 'luxury'.



In the event of it having a different meaning, the GC should have determined whether or not, in the light of that meaning, the goods and services covered by the mark constituted a homogenous group that justified a general reasoning (paras 38-39). The CJ found that the GC had ruled out generally the possibility that all the goods and services at issue could have a homogeneous character, without taking into account the particularities of the sign and its perception by the relevant public (para. 40). The GC had ignored the possibility that all of them, despite their differences, could have a relevant characteristic in common that justified their being considered as a single homogenous group and the Board applying a general reasoning in relation to all of them (para. 41).

♦[C-182/16 P](#); **STICK MINIMINI FRATELLI BERETTA 1812 GLI ORIGINALI / MINI WINI**; *Meica Ammerländische Fleischwarenfabrik Fritz Meinen GmbH & Co. KG v EUIPO*; Judgment of 26 July 2017; EU:C:2017:600; Language of the case: EN. The applicant sought to register the figurative mark **STICK MINIMINI FRATELLI BERETTA 1812 GLI ORIGINALI** as an EUTM for goods and services in Classes 29 and 43. An opposition based on the earlier EU word mark **MINI WINI**, registered, inter alia, for goods in Class 29, was filed pursuant to Article 8(1)(b) EUTMR. The OD partially upheld the opposition. The BoA annulled the OD decision in its entirety. The applicant then filed an action before the GC, relying on two pleas in law: (i) infringement of Article 8(3) of Commission Regulation (EC) No 216/96 of 5 February 1996 laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs), and (ii) infringement of Article 8(1)(b) EUTMR. The GC upheld the first plea and dismissed the second. The owner of the earlier right filed an appeal before the CJEU, alleging (i) infringement of Article 8(1)(b) EUTMR and (ii) infringement of the obligation to state reasons. **Obligation to state reasons:** the reasoning of the GC enables the owner of the earlier right to understand why the GC rejected its argument regarding the low level of attention of the relevant public and why the element ‘MiniMINI’ did not have an independent distinctive role, and provides the CJ with sufficient information to exercise its power of review (paras 44, 45, 59 and 61). The analysis by the General Court of whether ‘MiniMINI’ was a dominant element constituted a factual assessment; the arguments challenging that analysis were therefore manifestly inadmissible (paras 68 and 69). Furthermore, the CJ found no ground for the complaint that the GC had confused the assessment of visual similarity and that of conceptual similarity (para. 76).

2.3 *Ultra petita*

[No entry]

2.4 *Others*

♦[T-326/16](#); **TAFEL**; *Bundesverband Deutsche Tafel e.V. v EUIPO*; Judgment of 8 June 2017; EU:T:2017:380; Language of the case: DE. The EUTM word mark **TAFEL** was registered for the services *gathering, collection, transportation and distribution of essential goods, including foodstuffs, for others, in particular for those in need* in Class 39 and *personal and social services rendered by others to meet individual needs* in Class 45. An application for invalidity was filed pursuant to Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b) and (c) EUTMR. The CD dismissed the application for invalidity. The BoA upheld the invalidity



applicant's appeal. It found that the German word **TAFEL**, with its meaning of a festively decorated table ('first meaning'), described the services concerned within the meaning of Article 7(1)(c) EUTMR, since they might be offered at such a table. This was confirmed by lexical entries, according to which the term also referred to providing those in need with free or inexpensive foodstuffs not sold in the trade but still in good condition, or meals prepared therefrom ('second meaning'). The GC, in Case T-710/13 (18/09/2015, [T-710/13](#), Tafel, EU:T:2015:643), annulled the BoA decision, holding, on the basis of the first meaning of 'TAFEL', that Article 7(1)(c) EUTMR did not apply. According to the GC, the second meaning had merely been adduced by the BoA to confirm its findings and thus did not support Article 7(1)(c) EUTMR on its own account. The BoA upheld the invalidity applicant's appeal in its new decision under Article 7(1)(c) EUTMR, based on the second meaning of 'TAFEL'. The EUTM proprietor filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR and (ii) infringement of Article 72(6) EUTMR. The GC dismissed the appeal. Following the annulment, the BoA had been obliged to render a new decision in accordance not only with the operative part of the judgment but also with the grounds constituting its essential basis (paras 19-22). The judgment had not ruled on the applicability of Article 7(1)(c) EUTMR with regard to the second meaning, and the BoA was thus entitled to take its decision on this without infringing Article 72(6) EUTMR (paras 23-26). The second meaning, which 'TAFEL' already had at the time of the EUTM application, was confirmed by the GC in Case T-710/13 and was therefore to be considered final for the purposes of this judgment (para. 40). The EUTM in its second meaning was descriptive under Article 7(1)(c) EUTMR for the services concerned (para. 41).

3. **General principles of EU law**

♦[C-471/16 P](#); **MEISSEN / Meissen et al.**; *Staatliche Porzellan-Manufaktur Meissen GmbH v EUIPO*; Judgment of 26 July 2017; EU:C:2017:602; Language of the case: DE. An opposition was filed against an EUTM application applied for in respect of goods in Classes 11, 19 and 20. The opposition was based on earlier marks registered for goods and services in Classes 3, 8, 11, 14, 16, 18, 19, 21, 24, 28, 29, 30, 32, 33, 34, 36, 41, 42 and 43. The grounds of opposition were Article 8(1)(b) and Article 8(5) EUTMR. Upon request, the opponent had to provide PoU for some of the earlier marks. The OD partly upheld the opposition, namely for the goods in Classes 11 and 19, and rejected it with regard to the goods in Class 20. Upon appeal by both parties, the BoA annulled the OD's decision insofar as the OD had upheld the opposition for Classes 11 and 19. The BoA found that there was no LOC between any of the marks. With regard to Article 8(5) EUTMR, the BoA held that neither a link between the signs nor a risk of injury had been proven by the opponent. The opponent filed an action before the GC, based on an alleged infringement of Article 8(1)(b), Article 8(5) and Article 47(2) and (3) EUTMR. The GC dismissed the appeal (14/06/2016, [T-789/14](#), MEISSEN / MEISSEN (fig.), EU:T:2016:349). The opponent/appellant filed an appeal before the CJ, raising, inter alia, the following pleas in law: (i) infringement of Article 47(2) of the Charter of Fundamental Rights of the European Union ('Right to an effective remedy and to a fair trial'), because the GC had not taken into account supplementary documents submitted for the first time before the GC to support the prior evidence and arguments of the appellant; (ii) infringement of Article 18(1) EUTMR, because the GC had denied genuine use of the earlier marks for certain goods, despite the fact that the documentation submitted clearly proved use for those goods, and had therefore distorted the facts; and (iii) infringement of Article 8(5) EUTMR. The GC, by stressing that the goods at issue were 'so different' that the relevant public would not establish a link between the marks, had erroneously insinuated that the application of Article 8(5) EUTMR was dependent on



similarity between the goods. The CJ dismissed the appeal. **Fair trial:** irrespective of whether the documentation submitted before the GC was new or supplementary, the appellant did not deny that the documentation at issue had been submitted for the first time before the GC. Thus, the BoA had not been able to rely on the information contained therein. Therefore, the GC had rightly refused to take it into account when examining the legality of the BoA's decision. Furthermore, the GC had also given reasons as to why it believed the documentation to be new and not merely supplementary. The fact that the GC had used a wording frequently found in case-law did not alter the fact that the reasons given were sufficient (paras 24-31).

B. Procedure before the EUIPO

1. Admissibility

1.1 Right to appeal, form, deadline

♦[T-235/16](#); **GPTECH / GP JOULE et al.**; *GP Joule PV GmbH & Co. KG v EUIPO*; Judgment of 21 June 2017; EU:T:2017:413; Language of the case: EN. The applicant sought to register the figurative mark **GP Tech** as an EUTM for goods and services in Classes 9 and 42. An opposition based on two earlier EU word marks 'GP JOULE', registered for services in Classes 36, 37, 39, 40 and 42 on the one hand and goods in Classes 6, 9 and 19 on the other hand, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition insofar as it was considered unfounded pursuant to Rule 19 and 20 of Implementing Regulation (EC) No 2868/95. The applicant had pointed out that the opponent (GP Joule PV) and the proprietor of the earlier marks (Mr P) did not match. The opponent argued that it was the exclusive licensee of the proprietor of the earlier marks but did not produce any proof. The OD rejected the opposition as the opponent had not submitted any proof of an existing licence agreement or of any entitlement to file a notice of opposition. The BoA dismissed the opponent's appeal. It found that the opponent satisfied the requirements of admissibility under Rule 15(2)(h)(iii) of Implementing Regulation (EC) No 2868/95. However, it had not substantiated its entitlement to file a notice of opposition under Rule 19 of Implementing Regulation (EC) No 2868/95. The BoA considered that it had no discretion under Rule 50(1) of Implementing Regulation (EC) No 2868/95 in conjunction with Article 95(2) EUTMR to accept evidence produced for the first time at the appeal stage (i.e. a statement from a Mr P declaring that he had granted the opponent the authority to use the earlier trade marks and defend them in its own name). In any event, and for the sake of completeness, the BoA had indicated that, even assuming that it had such discretion, it would have exercised it by not taking into account the additional evidence. The opponent filed an action before the GC, relying on two pleas in law: (i) misapplication of the rules governing opposition proceedings, and (ii) misapplication of Rule 50(1) of Implementing Regulation (EC) No 2868/95 and Article 95(2) EUTMR. The GC dismissed the appeal. **With regard to the admissibility and substantiation rules:** the GC dismissed the opponent's arguments as in part inadmissible and in part ineffective. The opponent argued that the Office had failed to inform it of the lack of evidence to substantiate the earlier rights pursuant to Rule 17 of Implementing Regulation (EC) No 2868/95 (at the admissibility stage). The GC found that the BoA had rightly differentiated between admissibility criteria under Rule 17 of Implementing Regulation (EC) No 2868/95 (where it is enough to submit a statement on entitlement to file an opposition) and substantiation requirements (where proof of such entitlement is required). The GC confirmed that pursuant to Rule 19(1) and 20(6) of Implementing Regulation (EC)



No 2868/95, the Office is not obliged to ask the opponent to present evidence at the admissibility stage (in other words, this is not a deficiency that the opponent should be invited to remedy) (para. 30). The GC considered that in view of the lack of evidence on the opponent's entitlement, the Office could have rejected the opposition after the expiry of the substantiation period without taking any further steps in the proceedings. However, the fact that the OD took further steps did not vitiate the contested decision (para. 34).

[T-519/15](#); **myBaby (fig.) / MAYBABY et al.**; *myToys.de GmbH v EUIPO*; Order of 13 July 2017; EU:T:2017:502; Language of the case: EN. The applicant sought to register the figurative mark **myBaby** as an EUTM for services in Classes 35, 41 and 45. An opposition based on the earlier word marks **MAYBABY** and **MAY BABY** as well as on the earlier figurative mark **may BaBy**, registered for goods in Classes 3, 5, 10, 16 and 25, was filed pursuant to Article 8(1)(b) EUTMR. The OD partly upheld the opposition in relation to the services *retailing, in particular via the internet, of babies' napkins of cellulose* in Class 35. The applicant and the intervener each filed appeals, which were dealt with by the BoA in two separate proceedings. The BoA dismissed the applicant's appeal in its entirety and partially upheld the intervener's appeal. The applicant filed an action before the GC, requesting, inter alia, annulment of the contested decision and revocation of the decision relating to the intervener's appeal. The GC dismissed the appeal as inadmissible. The GC concluded that the BoA's decision in the separate appeal proceedings filed by the intervener had become final, and the applicant's claim, insofar as it requested the revocation of that decision, was inadmissible. Furthermore, the GC found that the contested decision merely confirmed the earlier BoA decision in the appeal proceedings initiated by the intervener. According to the GC, the applicant had not put forward any other argument capable of calling into question the merely confirmatory nature of the contested decision and the resulting inadmissibility of its action.

♦ [T-83/16](#); **WIDIBA / ING DiBa et al.**; *Banca Monte dei Paschi di Siena SpA and Wise Dialog Bank SpA (Banca Widiba SpA) v EUIPO*; Judgment of 26 September 2017; EU:T:2017:662; Language of the case: EN. The applicant sought to register the word mark WIDIBA for goods and services in Classes 9, 16, 36 and 38. An opposition, based on the existence of a LOC with regard to, inter alia, German trade mark DiBa for services in Class 36, was filed against all the goods and services applied for. The OD partially upheld the opposition for some goods and services in Classes 9, 36 and 38. Both parties filed appeals before the BoA. The appeal filed by the opponent was against the dismissal of the opposition with regard to *credit cards*, while the applicant's appeal requested annulment of the OD decision insofar as it upheld the opposition for some of the goods and services in question. The BoA decision upheld the appeal filed by the opponent, considering that there was a LOC also for *credit cards*. In the applicant's case, the BoA rejected the applicant's request for *restitutio in integrum* and consequently considered its appeal inadmissible because the grounds of appeal had not been filed within the relevant period established by the EUTMR. The EUTM applicant filed an action against this decision before the GC, relying on two pleas in law: (i) infringement of Articles 68 and 104 EUTMR and of Rule 49(1) of Implementing Regulation (EC) No 2868/95 and (ii) infringement of Article 8(1)(b) EUTMR. The GC dismissed the action. **Regarding the admissibility of the appeal and the request for *restitutio in integrum***: *restitutio in integrum* is subject to two requirements: first, that the requesting party has exercised all due care required by the circumstances and, second, that the obstacle to the party's compliance has the direct consequence of causing a loss of rights or means of redress (para. 27). Representatives are subject to the requirement to exercise due care just as much as other persons. 'Due care required by the circumstances' requires the putting in place of a system of internal checking and monitoring of time limits that generally excludes involuntary non-compliance with time limits. In this case, the obligation to exercise due care



did not specifically relate to the actions of the offending employee but to the obligations of the representative before the Office in terms of organisation and checks (para. 39). Consequently, the BoA had not erred in considering it inappropriate to grant the request for *restitutio in integrum*, given that the party had not exercised all due care required by the circumstances (para. 42). Owing to the failure to file a statement of grounds of appeal within the relevant time limit established by Article 68 EUTMR, and in accordance with Rule 49(1) of Implementing Regulation (EC) No 2868/95, which establishes that, in the event of a deficiency linked to non-compliance with that rule, the Office cannot award an additional time limit, the BoA had correctly rejected the appeal as inadmissible (paras 35-37).

♦[T-84/16](#); **WIDIBA / ING DiBa et al.**; *Banca Monte dei Paschi di Siena SpA and Wise Dialog Bank SpA (Banca Widiba SpA) v EUIPO*; Judgment of 26 September 2017; EU:T:2017:661; Language of the case: EN. The applicant sought to register the figurative mark **WIDIBA** for goods and services in Classes 9, 16, 36 and 38. An opposition, based on the existence of a LOC, was filed against all the goods and services applied for. The OD partially upheld the opposition for some goods and services in Classes 9, 36 and 38. Both parties filed appeals before the BoA. The appeal filed by the opponent was against the dismissal of the opposition with regard to *credit cards*, while the applicant's appeal requested annulment of the OD decision insofar as it upheld the opposition for some of the goods and services in question. The BoA decision upheld the appeal filed by the opponent, considering that there was a LOC also for *credit cards*. In the applicant's case, the BoA rejected the applicant's request for *restitutio in integrum* and consequently considered its appeal inadmissible because the grounds of appeal had not been filed within the relevant period established by the EUTMR. The EUTM applicant filed an action against this decision before the GC, relying on two pleas in law: (i) infringement of Articles 68 and 104 EUTMR and of Rule 49(1) of Implementing Regulation (EC) No 2868/95 and (ii) infringement of Article 8(1)(b) EUTMR. The GC dismissed the action. **Regarding the admissibility of the appeal and the request for *restitutio in integrum***: *restitutio in integrum* is subject to two requirements: first, that the requesting party has exercised all due care required by the circumstances and, second, that the obstacle to the party's compliance has the direct consequence of causing a loss of rights or means of redress (para. 27). Representatives are subject to the requirement to exercise due care just as much as other persons. 'Due care required by the circumstances' requires the putting in place of a system of internal checking and monitoring of time limits that generally excludes involuntary non-compliance with time limits. In this case, the obligation to exercise due care did not specifically relate to the actions of the offending employee but to the obligations of the representative before the Office in terms of organisation and checks (para. 39). Consequently, the BoA had not erred in considering it inappropriate to grant the request for *restitutio in integrum*, given that the party had not exercised all due care required by the circumstances (para. 42). Owing to the failure to file a statement of grounds of appeal within the relevant time limit established by Article 68 EUTMR, and in accordance with Rule 49(1) of Implementing Regulation (EC) No 2868/95, which establishes that, in the event of a deficiency linked to non-compliance with that rule, the Office cannot award an additional time limit, the BoA had correctly rejected the appeal as inadmissible (paras 35-37).

1.2 **New facts, arguments, grounds or evidence**

♦[T-54/16](#); **NETGURU**; *Netguru sp. z.o.o. v EUIPO*; Judgment of 17 January 2017; EU:T:2017:60; Language of the case: PL. The examiner refused a request for registration as an EUTM of the word mark **NETGURU** for goods and services in Classes 9, 35, 37, 38, 41



and 42 pursuant to Article 7(1)(b) and (c) EUTMR. The BoA confirmed the refusal pursuant to Article 7(1)(b) EUTMR. It found that, for the contested goods and services, the trade mark applied for would be understood by the target public in the sense of coming from an expert in computer networks, since the word 'guru' is a synonym for 'expert', and 'net' is an abbreviation for computer network. The EUTM applicant filed an action before the GC, claiming (i) infringement of Article 94 EUTMR in conjunction with Article 41(1) and Article 41(2)(c) of the Charter of Fundamental Rights of the European Union, (ii) infringement of Article 95(2) EUTMR, and (iii) infringement of Article 7(1)(b) and (c) EUTMR. With regard to the alleged infringement of Article 95(2) EUTMR, the GC noted that the applicant had not substantiated its claim (para. 32). The BoA was allowed to base its decision on the meaning of the word 'guru' found in common dictionaries and to disregard the evidence provided by the applicant (paras 34, 35).

♦[T-88/16](#); **ALPHAREN / ALPHA D3**; *OPKO Ireland Global Holdings, Ltd v EUIPO*; Judgment of 26 January 2017; EU:T:2017:32; Language of the case: EN. The BoA decision had been annulled in part by judgment of 09/02/2011, [T-222/09](#), *Alpharen*, EU:T:2011:36 because the BoA had infringed Article 95(1) EUTMR by making its own investigations on the therapeutic indication of the pharmaceutical goods under comparison. The case was remitted to the BoA, but it was found that the rapporteur of the BoA concerned had already been involved in the first (annulled) decision. This led to a second annulment (03/07/2013, [T-106/12](#), *Alpharen*, EU:T:2013:340). The case was remitted to a different BoA. However, it transpired, after this BoA had adopted its decision, that its chairperson had also been a member of the BoA that had taken the first decision. Another appeal was lodged before the GC but the BoA revoked its decision and the case was considered devoid of purpose. A new decision, almost identical to the revoked decision, was adopted by a BoA in which no member had been involved in the previous proceedings. On the merits, the BoA confirmed that there was a LOC in view of the similarity of the pharmaceutical goods, which were both aimed at treating kidney disorders, and the similarity of the signs for patients (but not for health professionals, who would consider 'Alpha' to be descriptive). The GC dismissed the action. **Discretionary power**: the BoA had not erred in accepting the submission of late evidence, which it had requested from the parties after the annulment of the first decision. The discretionary power did not need to be applied restrictively since the evidence did not concern earlier rights (paras 48-52).

♦[T-97/16](#); **GEOTEX**; *Martin Kasztantowicz v EUIPO*; Judgment of 4 May 2017; EU:T:2017:298; Language of the case: DE. A cancellation action pursuant to Article 58(1)(a) EUTMR (non-use) was filed against the EUTM **GEOTEK**. The CD sent a fax informing the EUTM owner about the cancellation action and asking the owner to provide evidence of genuine use of the contested EUTM by 24 May 2014. The fax was sent to the fax number provided by the owner in the EUTM application form. The Office had never been informed of any change of number. On 2 June 2014, the CD informed the owner via fax and ordinary mail that the Office had not received any response and that it would therefore take a decision based on the evidence on file. It is undisputed that the owner did not receive the notification. After requesting access to the Office's electronic communication service on 23 June 2014, the owner informed the Office that he had not received any of the notifications due to a change of postal address (no change of fax number was mentioned). He also informed the Office of his new address and sent evidence of use of the earlier mark. On 26 September 2014, the CD annulled the contested EUTM pursuant to Rule 40(5) of Implementing Regulation (EC) No 2868/95 since no PoU had been submitted in due time (namely by 24 May 2014). Upon appeal, the owner offered oral witness statements for the fact that he had changed his postal address. He argued that the evidence had been submitted on time because he had never received the notification of the cancellation request due to his change of address. He also offered a witness statement to prove that he had not received the fax,



without mentioning any concrete facts in this respect. The BoA confirmed the CD's decision. It held that the Office's fax notifying the cancellation request and setting the deadline for proving genuine use of the contested EUTM had been duly sent by the Office and received by the owner. This was shown by the Office's fax report. The Office had always used the same fax number since the filing of the contested EUTM. The owner had never informed the Office of a change of number. The BoA further held that it enjoyed a power of discretion pursuant to Article 95(2) EUTMR to take into account the evidence filed on 23 June and therefore belatedly. Exercising this power of discretion, it held that the circumstances of the case did not justify taking the belated evidence into account or hearing any witnesses. **On Rule 40(5) of Implementing Regulation (EC) No 2868/96 and Article 95(2) EUTMR:** if the deadline for proving genuine use of the contested EUTM, namely 24 May 2014, had been duly set by the Office, the EUTM had to be cancelled pursuant to Rule 40(5) of Implementing Regulation (EC) No 2868/95 since no PoU had been submitted within this deadline (para. 28). In this scenario, and pursuant to established case-law, the Office would only have been able to exercise its discretion to take belated evidence into account pursuant to Article 95(2) EUTMR if that evidence was 'additional' to duly submitted evidence (para. 29). It is, however, undisputed that no evidence was submitted within the deadline set by the Office, namely by 24 May 2014. Therefore, the Office could not exercise its discretion to take the belated evidence into account and the contested EUTM had to be cancelled, given that this deadline had been duly set. The main question in this case, therefore, was whether the owner had received the Office's notification setting this deadline (para. 32).

♦[T-235/16](#); **GPTECH / GP JOULE et al.**; *GP Joule PV GmbH & Co. KG v EUIPO*; Judgment of 21 June 2017; EU:T:2017:413; Language of the case: EN. The applicant sought to register the figurative mark **GPTech** as an EUTM for goods and services in Classes 9 and 42. An opposition based on two earlier EU word marks 'GP JOULE', registered for services in Classes 36, 37, 39, 40 and 42 on the one hand and goods in Classes 6, 9 and 19 on the other hand, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition insofar as it was considered unfounded pursuant to Rule 19 and 20 of Implementing Regulation (EC) No 2868/95. The applicant had pointed out that the opponent (GP Joule PV) and the proprietor of the earlier marks (Mr P) did not match. The opponent argued that it was the exclusive licensee of the proprietor of the earlier marks but did not produce any proof. The OD rejected the opposition as the opponent had not submitted any proof of an existing licence agreement or of any entitlement to file a notice of opposition. The BoA dismissed the opponent's appeal. It found that the opponent satisfied the requirements of admissibility under Rule 15(2)(h)(iii) of Implementing Regulation (EC) No 2868/95. However, it had not substantiated its entitlement to file a notice of opposition under Rule 19 of Implementing Regulation (EC) No 2868/95. The BoA considered that it had no discretion under Rule 50(1) of Implementing Regulation (EC) No 2868/95 in conjunction with Article 95(2) EUTMR to accept evidence produced for the first time at appeal stage (i.e. a statement from a Mr P declaring that he had granted the opponent the authority to use the earlier trade marks and defend them in its own name). In any event, and for the sake of completeness, the BoA had indicated that, even assuming that it had such discretion, it would have exercised it by not taking into account the additional evidence. The opponent filed an action before the GC, relying on two pleas in law: (i) misapplication of the rules governing opposition proceedings and (ii) misapplication of Rule 50(1) of Implementing Regulation (EC) No 2868/95 and 76(2) EUTMR. The GC dismissed the appeal. **With regard to the assessment of new evidence:** the GC referred to settled case-law on the application of Rule 50(1) of Implementing Regulation (EC) No 2868/95 in conjunction with Article 95(2) EUTMR. Rule 50 did not extend the discretion of the BoA to **new** evidence but only to **additional** evidence. The opponent had filed a statement for the first time before the BoA. The GC considered that, in the light of the facts of the case, this was not 'additional' evidence and the BoA had been right to find



that it could not take it into account (paras 46-49). The plea was rejected as unfounded. Moreover, the GC further confirmed the BoA's conclusion to refuse to take into account the statement, should it be considered 'additional' evidence: there was no justification for its late submission and the opponent had not put forward any ground justifying the delay (paras 55-56).

♦[T-223/16](#); **DEVICE OF A CLOUD RESEMBLING A SAFE / ICLOUD et al.**; *Massive Bionics, S.L. v EUIPO*; Judgment of 14 July 2017; EU:T:2017:500; Language of the case: EN. The applicant sought to register a figurative mark as an EUTM for services in Classes 35, 42 and 44. An opposition based, inter alia, on the earlier word mark **ICLOUD**, registered for goods and services in Classes 9, 35, 38 to 42 and 45, was filed pursuant to several grounds, including Article 8(1)(b) EUTMR. The OD dismissed the opposition. The BoA partly upheld the opponent's appeal. It found that there was a LOC on the basis of the earlier word marks **ICLOUD** for all the services applied for in Class 35 and some of the services applied for in Class 42. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 95(2) EUTMR, and (ii) infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. **Belated evidence**: the GC confirmed that the BoA had exercised its discretion correctly in deciding, in a reasoned manner and having due regard to all the relevant circumstances, whether or not to take into account the additional evidence concerning the substantiation of some of the earlier international trade marks belatedly submitted before it (para. 38).

♦[T-316/16](#); **SDC-554S / SDC-554S**; *Moravia Consulting spol. s r.o. v EUIPO*; Judgments of 12 October 2017; EU:T:2017:717; Language of the case: EN. The applicant sought to register the word mark **SDC-554S** for goods in Class 9. An opposition, based on an earlier non-registered trade mark identical to the trade mark applied for, was filed pursuant to Article 8(4) EUTMR. The OD dismissed the opposition. The BoA dismissed the appeal. The opponent filed an action before the GC. The GC dismissed the appeal. The opponent relied on two pleas in law: (i) infringement of Article 8(4) EUTMR and of Article 95(1) EUTMR, and (ii) infringement of Article 59(1)(b) EUTMR. The plea of bad faith is inadmissible in the context of opposition proceedings (paras 26-31). The opponent must provide evidence of the content of national law before the EUIPO (paras 38-43). Such evidence cannot be filed for the first time before the BoA if no evidence had been submitted before the OD as to the existence, validity and scope of protection of the right relied on. In such a case, the BoA has no discretion to accept the evidence submitted for the first time before it, as it could not be considered additional or supplementary (paras 38-61). The evidence produced by the opponent for the first time at the hearing was also inadmissible (para. 63). Even if the evidence were to be considered additional or supplementary, the BoA would have had to exercise its discretion in the negative, because the opponent must necessarily have been aware, also because of the standard letter sent by the OD on how to support its opposition, that it was obliged to produce some evidence to establish the content of the national law before the OD. The principle *iura novit curia* was not applicable, since national law is a matter of establishing facts. It is only when the Office already has information on national law available to it that it must of its own motion inform itself of the latter (paras 65-74).

♦[T-317/16](#); **SDC-888TII RU / SDC-888TII RU**; *Moravia Consulting spol. s r.o. v EUIPO*; Judgments of 12 October 2017; EU:T:2017:718; Language of the case: EN. The applicant sought to register the word mark **SDC-888TII RU** for goods in Class 9. An opposition, based on an earlier non-registered trade mark identical to the trade mark applied for, was filed pursuant to Article 8(4) EUTMR. The OD dismissed the opposition. The BoA dismissed the appeal. The opponent filed an action before the GC. The GC dismissed the appeal. The opponent relied on two pleas in law: (i) infringement of Article 8(4) EUTMR and of



Article 95(1) EUTMR, and (ii) infringement of Article 59(1)(b) EUTMR. The plea of bad faith is inadmissible in the context of opposition proceedings (paras 26-31). The opponent must provide evidence of the content of national law before the EUIPO (paras 38-43). Such evidence cannot be filed for the first time before the BoA, if no evidence had been submitted before the OD as to the existence, validity and scope of protection of the right relied on. In such a case, the BoA has no discretion to accept the evidence submitted for the first time before it, as it could not be considered additional or supplementary (paras 38-61). The evidence produced by the opponent for the first time at the hearing was also inadmissible (para. 63). Even if the evidence were to be considered additional or supplementary, the BoA would have had to exercise its discretion in the negative, because the opponent must necessarily have been aware, also because of the standard letter sent by the OD on how to support its opposition, that it had to produce some evidence to establish the content of the national law before the OD. The principle *iura novit curia* was not applicable, since national law is a matter of establishing facts. It is only when the Office already has information on national law available to it that it must of its own motion inform itself of the latter (paras 65-74).

♦[T-318/16](#); **SDC-444S / SDC-444S**; *Moravia Consulting spol. s r.o. v EUIPO*; Judgments of 12 October 2017; EU:T:2017:719; Language of the case: EN. The applicant sought to register the word mark **SDC-444S** for goods in Class 9. An opposition, based on an earlier non-registered trade mark identical to the trade mark applied for, was filed pursuant to Article 8(4) EUTMR. The OD dismissed the opposition. The BoA dismissed the appeal. The opponent filed an action before the GC. The GC dismissed the appeal. The opponent relied on two pleas in law: (i) infringement of Article 8(4) EUTMR and of Article 95(1) EUTMR, and (ii) infringement of Article 59(1)(b) EUTMR. The plea of bad faith is inadmissible in the context of opposition proceedings (paras 26-31). The opponent must provide evidence of the content of national law before the EUIPO (paras 38-43). Such evidence cannot be submitted for the first time before the BoA if no evidence had been submitted before the OD as to the existence, validity and scope of protection of the right relied on. In such a case, the BoA has no discretion to accept the evidence submitted for the first time before it, as it could not be considered additional or supplementary (paras 38-61). The evidence produced by the opponent for the first time at the hearing was also inadmissible (para. 63). Even if the evidence were to be considered additional or supplementary, the BoA would have had to exercise its discretion in the negative, because the opponent must necessarily have been aware, also because of the standard letter sent by the OD on how to support its opposition, that it was obliged to produce some evidence to establish the content of the national law before the OD. The principle *iura novit curia* was not applicable, since national law is a matter of establishing facts. It is only when the Office already has information on national law available to it that it must of its own motion inform itself of the latter (paras 65-74).

♦[T-771/15](#); **BITTORRENT**; *Hochmann Marketing GmbH (formerly Bittorrent Marketing GmbH) v EUIPO*; Judgment of 12 December 2017; EU:T:2017:887; Language of the case: EN. The applicant was the proprietor of the EUTM registration for the word sign **BITTORRENT** for Classes 35, 38 and 42. The intervener, BitTorrent Inc., filed an application for revocation of the mark at issue, based on Article 58(1)(a) EUTMR, on the ground that this mark had not been put to genuine use in the EU in connection with the services concerned within a continuous period of 5 years. The Office notified the applicant that it had 3 months within which to submit evidence of use of the mark at issue. Following a request from the applicant, the Office extended this time limit (which expired on 19 October 2011) by one month (i.e. to 21 November 2011, since 19 November 2011 was a Saturday). On 21 November 2011, the last day of the time limit for establishing genuine use of the mark at issue, the applicant sent a five-page letter by fax, which referred to attached documents.



However, no documents were attached. By fax of 23 November 2011, the applicant's representative informed the Office that it had not sent all the documents due to a fax machine failure. On 24 November 2011, the Office received by post the 69 pages of items of evidence referred to in the five-page letter sent by fax on 21 November 2011. The BoA held that the applicant had submitted no relevant proof before the CD within the time limit specified, and therefore the evidence submitted before the BoA could not be taken into account. The BoA therefore held that genuine use of the mark at issue had not been proven and that the mark had to be revoked. For the sake of completeness, the BoA nonetheless assessed the evidence submitted late before the CD, as well as that submitted before the BoA at the appeal stage, and held that it did not prove use of the mark at issue. The applicant raised two pleas: (i) infringement of Article 95(1) and (2) EUTMR and (ii) infringement of Article 58(1)(a) EUTMR. **Regarding the first plea in law:** in EUTM revocation proceedings, it is for the EUTM proprietor, and not the Office of its own motion, to establish genuine use of the mark concerned (paras 28, 29 and 30). The rule that the Office is to examine the facts of its own motion, as laid down in Article 95(1) EUTMR, does not apply to the question of proof of genuine use of the EUTM in revocation proceedings brought before the Office (para. 31). Regarding the evidence submitted late before the CD, the Office may disregard facts or evidence that are not submitted in due time by the parties concerned and has broad discretion to decide whether or not to take such information into account (paras 33, 36). Where the Office is called upon to rule on an application for revocation, the taking into account of belated evidence is particularly likely to be justified where the material is complementary to evidence submitted within the time limit and the Office considers firstly, that it is likely to be relevant to the outcome of the application for revocation and, secondly, that the circumstances and the stage of the proceedings do not argue against it being taken into account (para. 40). In this case, only the letter sent by fax on 21 November 2011 was produced by the applicant before the CD within the period specified (para. 41). The letter submitted within the prescribed period was a five-page document but clearly contained only statements that were not substantiated by any supporting evidence capable of adducing proof of the place, time, extent and nature of use of the mark at issue, since the evidence was not submitted until 3 days after the prescribed period had expired. The BoA was thus correct in concluding that no proof had been submitted in due time before the CD (para. 45). The reason behind the failure to meet the deadline showed inexcusable negligence and was not attributable to exceptional circumstances that could not have been predicted from experience (paras 49-51). The BoA duly took into account all the relevant circumstances concerning the belated evidence (para. 52). With regard to the items produced before the Landgericht Berlin (Regional Court, Berlin, Germany) in 2010, the mark contested in those proceedings was not the EUTM at issue but a German mark registration **BITTORRENT**, and the territory was Germany rather than, as in this case, the EU (para. 56). With regard to the items produced in May 2008 in opposition proceedings against the intervener, the applicant referred to these only before the BoA. In addition, they were insufficient to prove genuine use of the EUTM as they consisted only of a very brief description of the website 'bittorrent.net' and three extracts from that website (para. 57). As to the evidence submitted for the first time before the BoA, since no PoU of the EUTM had been filed before the CD within the prescribed period and since the evidence submitted at the appeal stage was not by way of complement to the evidence produced within that period, the applicant could not argue that the evidence submitted before the BoA was additional evidence that should have been taken into account (para. 63). Furthermore, the applicant had not filed a request for either the continuation of proceedings under Article 105 EUTMR or *restitutio in integrum* under Article 104 EUTMR (para. 65).



2. Essential procedural requirements

2.1 Right to be heard

♦[T-19/15](#); **wax by Yuli's**; *Yuleidy Caridad Gómez Echevarría v EUIPO*; Judgment of 1 February 2017; EU:T:2017:46; Language of the case: ES. The EUTM proprietor was granted registration of the figurative mark **wax by Yuli's** as an EUTM for goods and services in Class 25. An application for invalidity was filed pursuant to Article 60(1)(a) in conjunction with Article 8(1)(b) EUTMR. The CD upheld the application for invalidity on the basis of the earlier word mark **MADWAX**. It considered it unnecessary to assess the case on the basis of the remaining earlier mark. The BoA dismissed the EUTM proprietor's appeal. It found that there was a LOC between the contested EUTM and the two earlier marks. The proprietor filed an action before the GC, relying on five pleas in law: (i) infringement of Article 71(1) EUTMR in conjunction with Article 41(2) of the Charter of Fundamental Rights; (ii) infringement of Article 8(1)(b) EUTMR insofar as the application for invalidity constituted an abuse of rights; (iii) and (iv) incorrect application and interpretation of Article 60(1)(a) in conjunction with Article 8(1)(b) EUTMR; and (v) incorrect application of Rule 94(1) and (7) of Implementing Regulation (EC) No 2868/95 in conjunction with Article 109(1) EUTMR. The GC dismissed the appeal. The BoA had correctly carried out an assessment of whether there was a LOC between the contested mark and both earlier marks. This was not altered by the facts that (i) the CD had not included the figurative earlier mark in its assessment, and (ii) the EUTM proprietor had not submitted any arguments before the BoA in relation to that earlier mark (paras 17-23). The GC referred to previous case-law by analogy (15/01/2013, T-237/11, *Bellram*, EU:T:2013:11) and confirmed that the right of defence had not been infringed in this case (paras 24-31). The applicant's arguments on the abuse of rights were inadmissible since they had been presented for the first time before the GC (paras 33-38).

♦[T-811/14](#); **FAIR & LOVELY / NEW YORK FAIR & LOVELY**; *Unilever NV / EUIPO*, Judgment of 17 February 2017; EU:T:2017:98; Language of the case: EN. The OD allowed an opposition based on Article 8(1)(b) EUTMR and rejected the contested trade mark application. It found a LOC with one of the several national earlier rights (a Spanish mark) that had been invoked as the basis of the opposition. The BoA dismissed the appeal as it found a LOC with another of the earlier national marks (a Benelux mark) upon which the opponent had relied. This was after the BoA had rejected the applicant's request for suspension of the appeal proceedings, made on the ground that the applicant claimed to have started cancellation actions against, inter alia, the opponent's earlier Benelux mark. The applicant had filed evidence to support its claim that the earlier Benelux had been attacked. Before the GC, the applicant claimed, inter alia: (i) that the BoA was not entitled — or, at least, not without giving the applicant the right to be heard — to reject the appeal on the basis of a finding of a LOC with respect to an earlier mark other than that examined by the OD; (ii) that the BoA had made, inter alia, manifest errors of assessment when examining and analysing the evidence submitted by the applicant in support of its request for suspension of the appeal proceedings. **Competence of the BoA and the right to be heard:** the GC dismissed the first plea, confirming the established case-law according to which, first, Article 71(1) EUTMR requires the BoA to fully re-examine the opposition, including as regards earlier rights not taken into account by the OD and, second, Article 94 EUTMR does not require the BoA to hear the applicant before dismissing the appeal on the basis of a different earlier right properly relied upon by the opponent and upon which the applicant had the opportunity to comment.



♦[T-276/15](#); **e / e**; *Edison SpA v EUIPO*; Judgment of 14 March 2017; EU:T:2017:163; Language of the case: EN. The OD dismissed an opposition based upon Article 8(1)(b) EUTMR in its entirety. The BoA allowed the appeal in part, finding a LOC between the conflicting marks for the identical goods and services. This part of the BoA decision was not challenged before the GC. The BoA rejected the appeal for the similar and dissimilar goods and services (inter alia, *electric energy emanating from wind power; plants for the production of renewable energy; leasing of wind power energy generating facilities*), for which it found no LOC for the relevant public with a high degree of attention. This followed from the very low degree of similarity between the signs and the fact that the earlier mark's degree of distinctiveness stemmed from its specific stylisation rather than from the presence of the letter 'e'. The evidence submitted had not proven that the earlier mark had acquired enhanced distinctiveness through use. Before the GC, the opponent argued that the signs were similar (and not just similar to a low degree), the goods and services were identical or highly similar, and enhanced distinctive character through use had been established for its earlier mark in the proceedings before the Office. The GC rejected the opponent's three arguments and dismissed the appeal. **Evidence of acquired distinctiveness:** the GC confirmed the BoA finding that the opponent had not, as was its duty in proceedings before the Office pursuant to Article 95(1) *in fine* EUTMR, presented any argument to support its claim that the conflicting goods and services were identical or highly similar (paras 42, 45, 46, 47). Nor could the facts invoked be considered well known (paras 41, 45, 47).

♦[T-174/16](#); **DESIGN OF NOZZLES FOR VACUUM CLEANERS**; *Wessel-Werk GmbH v EUIPO*; Judgment of 14 March 2017; EU:T:2017:161; Language of the case: DE. The applicant before the GC was the owner of a registered Community design ('suction nozzle for vacuum cleaners'). The intervener had filed an invalidity action based, inter alia, on lack of individual character in the sense of Article 6 CDR. The intervener had based its request in particular on earlier registered designs. Both instances upheld the invalidity request and found that the challenged design lacked individual character. The applicant appealed to the GC, arguing infringement of, inter alia, Article 6(1) and Article 62 CDR. **Infringement of right to be heard (Article 62 CDR):** concerning the alleged infringement of the right to be heard, the GC stated that the contested decision had indeed based its reasoning on a different depiction of the earlier RCD from the one considered by the CD. However, this had not affected the applicant's right to be heard, as the applicant had had the opportunity to file observations right from the beginning of the administrative procedure. Moreover, the BoA had been charged with carrying out a completely new examination of the merits of the application for invalidity, in terms of both law and fact, and giving a ruling on that action (paras 40-42).

♦[T-175/16](#); **DESIGN OF NOZZLES FOR VACUUM CLEANERS**; *Wessel-Werk GmbH v EUIPO*; Judgment of 14 March 2017; EU:T:2017:160; Language of the case: DE. The applicant before the GC was the owner of a registered Community design ('suction nozzle for vacuum cleaners'). The intervener had filed an invalidity action based, inter alia, on lack of individual character in the sense of Article 6 CDR. The intervener had based its request in particular on earlier registered designs. Both instances upheld the invalidity request and found that the challenged design lacked individual character. The applicant appealed to the GC, arguing infringement of, inter alia, Article 6(1) and Article 62 CDR. **Infringement of right to be heard (Article 62 CDR):** concerning the alleged infringement of the right to be heard, the GC stated that the contested decision had indeed based its reasoning on a different depiction of the earlier RCD from the one considered by the CD. However, this had not affected the applicant's right to be heard, as the applicant had had the opportunity to file observations right from the beginning of the administrative procedure. Moreover, the BoA had been charged with carrying out a completely new examination of the merits of the



application for invalidity, in terms of both law and fact, and giving a ruling on that action (paras 40-42).

♦[T-473/15](#); **APUS / ABUS**; *Capella EOOD v EUIPO*; Judgment of 16 March 2017; EU:T:2017:174; Language of the case: DE. In the course of the appeal proceedings, the applicant declared two subsequent restrictions on the goods *vehicles and their parts* in Class 12 of its EUTM application. The first restriction read: *vehicles for use on land*; [...], while the second read: *automotive vehicles for use on land, namely passenger vehicles; tyres; wheel trims*; [...]. In the contested decision, the BoA accepted the first restriction but rejected the second in its entirety, reasoning that *tyres; wheel trims* were previously not contained in the specification. On the merits, the BoA upheld the opposition for *vehicles for use on land* on the basis of Article 8(1)(b) EUTMR and rejected it for the remaining goods. Before the GC, the applicant claimed that only the OD, not the BoA, was competent to decide on restriction, and that its right to be heard had been infringed because it had not been informed about the refusal of its second application for restriction before the contested decision was taken. The GC confirmed the BoA's competence to process restrictions declared during the course of appeals. By virtue of Article 71(1) EUTMR (para. 29), and with regard to the principle of continuation of proceedings (para. 38), this competence is based on and shaped by that of the OD. Restrictions may have an effect (a) on the continuation of the opposition proceeding and (b) on the assessment of the LOC (para. 34). Thus, there is a close connection between restriction and opposition proceedings that is relevant for the parties' right to be heard. The GC found an infringement of the general legal principle of the right to be heard, as enshrined in Article 94 EUTMR, since the BoA had decided on the opposition on the basis of the first restriction, without informing the applicant beforehand that the second restriction was ineffective (paras 41-61). Furthermore, the BoA also committed a procedural error in not applying Rule 13(3) of Implementing Regulation (EC) No 2868/95, which also specifies the right to be heard (paras 62-67). This provision stipulates that the Office should communicate to the applicant any formal or other deficiencies with regard to restrictions under Article 49 EUTMR. Given that the errors concerned the goods to be compared, they may have had an impact on the assessment of the LOC and thus led to the annulment of the contested decision (paras 68-69).

♦[T-39/16](#); **NANA FINK / NANA**; *Nanu-Nana Joachim Hoepp GmbH & Co. KG v EUIPO*; Judgment of 6 April 2017; EU:T:2017:263; Language of the case: DE. The intervener had obtained the international registration (IR) designating the EU of the figurative mark **NANA FINK** for goods in Classes 14, 18 and 26. Following the IR's publication, the applicant filed a notice of opposition. The opposition was based on the earlier EU word mark **NANA**, registered for goods in Classes 14, 18 and 26, pursuant to Article 8(1)(b) EUTMR. The opposition was rejected, due to lack of similarity between the goods, for some of the goods and upheld, because of a LOC, for the other goods covered by the IR at issue. The applicant filed an appeal against the decision. The BoA upheld the OD's decision. It found that, given the lack of similarity between the goods, there was no LOC for the marks at issue. The applicant filed an action before the GC, relying on one plea in law based on infringement of Article 8(1)(b) EUTMR. The GC partially annulled the decision. Regarding the alleged infringement of Article 8(1)(b) EUTMR, the GC confirmed that the relevant territory was that of the European Union (para. 59) and that there was no similarity between the goods at issue (para. 80) and thus no LOC for the marks (para. 92). However, the main issue was the BoA's failure to fulfil one of its obligations. The OD had upheld the opposition for *products made of precious metals and their alloys* and rejected it for *precious metals and their alloys* (para. 30). However, in its decision, the BoA had failed to adjudicate on the appeal brought before it as regards *precious metals and their alloys*. Thus, the GC considered that the BoA had failed to fulfil its obligation to decide on the entirety of the appeal before it, pursuant to Article 71(1)



EUTMR (para. 37). Consequently, the contested decision had to be annulled insofar as the BoA had omitted to rule on *precious metals and their alloys* in Class 14 for the IR at issue (para. 93).

♦[T-622/15](#); **EXHAUST-GARD**; *Deere & Company v EUIPO*; Judgment of 27 April 2017; EU:T:2017:287; Language of the case: DE. The applicant sought to register the word mark **EXHAUST-GARD** as an EUTM for *diesel exhaust fluid* in Class 1. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) and Article 7(2) EUTMR, as it was found to be descriptive and devoid of distinctive character. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. The GC found that the applicant had been given the opportunity to comment on the BoA's understanding of the meaning of 'EXHAUST-GARD', although this meaning did differ from that taken into account by the Office. The applicant had commented on the meaning taken into account by the BoA within the administrative proceedings before the Office and therefore the contested decision had not been based on facts on which the applicant had been unable to comment. Furthermore, the GC endorsed the BoA finding that 'EXHAUST-GARD' was solely descriptive for *diesel exhaust fluid* and thus also lacked distinctive character.

♦[T-97/16](#); **GEOTEX**; *Martin Kasztantowicz v EUIPO*; Judgment of 4 May 2017; EU:T:2017:298; Language of the case: DE. A cancellation action pursuant to Article 58(1)(a) EUTMR (non-use) was filed against the EUTM **GEOTEK**. The CD sent a fax informing the EUTM owner about the cancellation action and asking the owner to provide evidence of genuine use of the contested EUTM by 24 May 2014. The fax was sent to the fax number provided by the owner in the EUTM application form. The Office had never been informed of any change of number. On 2 June 2014, the CD informed the owner via fax and ordinary mail that the Office had not received any response and that it would therefore take a decision based on the evidence on file. It is undisputed that the owner did not receive the notification. After requesting access to the Office's electronic communication service on 23 June 2014, the owner informed the Office that he had not received any of the notifications due to a change of postal address (no change of fax number was mentioned). He also informed the Office of his new address and sent evidence of use of the earlier mark. On 26 September 2014, the CD annulled the contested EUTM pursuant to Rule 40(5) of Implementing Regulation (EC) No 2868/95 since no PoU had been submitted in due time (namely by 24 May 2014). Upon appeal, the owner offered oral witness statements for the fact that he had changed his postal address. He argued that the evidence had been submitted on time because he had never received the notification of the cancellation request due to his change of address. He also offered a witness statement to prove that he had not received the fax, without mentioning any concrete facts in this respect. The BoA confirmed the CD's decision. It held that the Office's fax notifying the cancellation request and setting the deadline for proving genuine use of the contested EUTM had been duly sent by the Office and received by the owner. This was shown by the Office's fax report. The Office had always used the same fax number since the filing of the contested EUTM. The owner had never informed the Office of a change of number. The BoA further held that it enjoyed a power of discretion pursuant to Article 95(2) EUTMR to take into account the evidence filed on 23 June and therefore belatedly. Exercising this power of discretion, it held that the circumstances of the case did not justify taking the belated evidence into account or hearing any witnesses. **On Article 97(1)(a) and (d) EUTMR in conjunction with Rule 57 of Implementing Regulation (EC) No 2868/95:** the Office was not obliged to hear witnesses in the case in question. Article 97(1)(a) and (d) EUTMR and Rule 57 of Implementing Regulation (EC) No 2868/95 envisage the possibility of hearing witnesses but do not impose any obligation on the Office to grant requests for such hearings (para. 56). The Office has broad powers of discretion (para. 57). The GC is therefore limited to assessing whether the Office has committed any



obvious error or misused such power when denying a request (para. 58). Since all the facts submitted by the EUTM owner were irrelevant for the question as to whether the fax was received, the BoA was indeed entitled to find that hearing witnesses was not justified (para. 61). The BoA had not expressly refused a second request for a witness hearing. It followed, however, implicitly from the contested decision that this request had been refused since the owner had not submitted any relevant fact that could speak against the receipt of the fax and that a witness could have confirmed (paras 63 and 64).

♦[T-375/16](#); **INSTASITE**; *Sabre GLBL Inc. v EUIPO*; Judgment of 18 May 2017; EU:T:2017:348; Language of the case: EN. The applicant sought to register the word mark **INSTASITE** as an EUTM for goods and services in Classes 9, 35 and 42. The examiner refused registration of the EUTM application for all the goods in Class 9 and for some of the services in Class 42 pursuant to Article 7(1)(b) and (c) and Article 7(2) EUTMR. The term 'INSTASITE' was found to be descriptive of the goods and services in question and devoid of distinctive character. Before the GC, the applicant claimed (i) infringement of the right to be heard (Article 94 EUTMR), (ii) infringement of Article 7(1)(c) EUTMR and (iii) infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal. The GC emphasised that it was clear from the contested decision that the BoA had found the factual and legal reasons and the evidence on which the examiner relied to be sufficient to establish the descriptive nature of the mark applied for (para. 23). By referring to the laudatory nature and the perception of the mark applied for as a mere advertising slogan (an argument not mentioned by the examiner), the BoA had in no way stated that it was taking those factors in consideration, but had merely pointed out the existence of other factors, such that the evidence that formed the basis for the contested decision was not exhaustive (para. 24).

♦[T-287/15](#); **real,-**; *Tayto Group Ltd v EUIPO*; Judgment of 28 June 2017; EU:T:2017:443; Language of the case: EN. The EUTM proprietor was granted registration of a figurative mark as an EUTM for goods and services in Classes 3, 8, 16, 18, 20, 21, 22, 24, 25, 28, 29, 30, 31 and 32. An application for revocation was filed pursuant to Article 58 EUTMR. The CD upheld the application for revocation. The BoA partially upheld the EUTM proprietor's appeal. It found that the contested mark had been put to genuine use for some of the goods covered by it. The revocation applicant filed an action before the GC, relying on six pleas in law: (i) infringement of Article 18(1) EUTMR, (ii) infringement of Article 18(2) EUTMR, (iii) infringement of Articles 71 and 95 EUTMR, (iv) infringement of Article 58(1)(a) EUTMR, (v) infringement of Article 94 EUTMR, and (vi) misuse of power and infringement of general principles of law. **Third plea**: the extent of use of the mark at issue had been confirmed by an overview of turnover figures, broken down in respect of the various goods during the relevant period, as well as by an affidavit. The argument that the BoA had not noticed that some documents did not fall within the relevant period could not succeed, since the appeal brought before it was upheld only in part, which again showed, to the requisite legal standard, that it had carried out an appropriate assessment of the evidence in its possession (paras 66-68). **Fifth plea**: the reasoning may be implicit. The BoA did not have to take into account decisions of national authorities regarding the lack of distinctiveness of the element 'real' (paras 70-75).

♦[T-81/16](#); **POSITION OF TWO CURVED STRIPS ON THE SIDE OF A TYRE**; *Pirelli Tyre SpA v EUIPO*; Judgment of 4 July 2017; EU:T:2017:463; Language of the case: EN. An application for registration of a figurative mark as an EUTM was filed for *tyres, solid, semi-pneumatic and pneumatic tyres, rims and covers for vehicle wheels* in Class 12. The application was for a position mark described as 'a pair of essentially equal curved strips positioned on the side of a tyre and running along its circumference'. The examiner rejected the application on the ground that the mark applied for was devoid of distinctive character



within the meaning of Article 7(1)(b) EUTMR. The First BoA dismissed the appeal against the examiner's decision and confirmed that the mark applied for was caught by the prohibitions of Article 7(1)(b) EUTMR. The applicant filed an appeal before the GC, relying on three pleas in law: (i) infringement of Articles 94 and 95 EUTMR, (ii) infringement of Article 7(1)(b) EUTMR, and (iii) infringement of Article 7(3) EUTMR. The GC dismissed the appeal. **Infringement of Article 95 EUTMR:** the GC dismissed the applicant's argument that the BoA had infringed the principle of examination of the facts by the Office of its own motion, as laid down in Article 95(1) EUTMR. The GC found that the applicant did not indicate how the BoA had failed to examine the facts arguments or evidence before it. Furthermore, it was for the applicant to present evidence to the Office showing that the mark applied for had, contrary to the Office's analysis, acquired distinctive character in the EU (paras 31-37). Thus, the BoA had not failed to fulfil its obligations under Article 95 EUTMR.

♦[T-620/16](#); **Idealogistic (fig.) / IDEA et al.**; *The Logistical Approach BV v EUIPO*; Judgment of 21 September 2017; EU:T:2017:635; Language of the case: FR. The applicant sought to register the figurative mark **Idealogistic** as an EUTM for services in Class 39. An opposition, based on the earlier French word marks **idée logistique** and **IDEA** registered for services in Class 39, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition on the basis of earlier French mark **IDEA**. The BoA confirmed the existence of a LOC but on the basis of earlier French mark **idée logistique** (without examining the opposition based on the mark **IDEA**). It dismissed the applicant's appeal. The applicant filed an action before the GC, relying on two pleas in law: (i) the BoA had exceeded its powers and infringed Article 95 EUTMR by stating that 'logistics' was 'commercial transportation', when no evidence thereof had been submitted by the parties and 'logistics' is normally defined as a planning and organisation method, and (ii) infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. **On the alleged infringement of Article 95 EUTMR:** for the comparison of the services, the BoA had relied on a definition of 'logistics' provided by the intervener before the OD; this definition was also a well-known fact (paras 18-23). This plea was dismissed.

♦[T-411/15](#); **GAPPOL / GAP et al.**; *PP Gappol Marzena Porczyńska v EUIPO*; Judgment of 4 October 2017; EU:T:2017:689; Language of the case: EN. The applicant sought to register the mark GAPPOL as an EUTM for goods and services in Classes 20 and 25. An opposition based on the earlier word mark GAP, registered for goods and services in Class 25, was filed pursuant to Article 8(1)(b) and 8(5) EUTMR. The OD partly upheld the opposition for goods in Class 25 (LOC) and rejected it for goods in Class 20. The BoA dismissed the applicant's appeal and upheld the opponent's ancillary appeal for *furniture* in Class 20. It found that there was a LOC for the identical goods in Class 25 and that use of the contested mark for *furniture* took unfair advantage of the distinctiveness of the earlier mark. The applicant filed an action before the GC, relying on five pleas in law: (i) infringement of Article 67 and Article 71(1) EUTMR, (ii) infringement of Article 94 EUTMR and Rule 50(2)(h) of Regulation No 2868/95, (iii) infringement of Article 94 EUTMR, (iv) infringement of Article 8(1)(b) EUTMR, and (v) infringement of Article 8(5) and 9(2)(c) EUTMR and Rule 19(2)(c) of Implementing Regulation (EC) No 2868/95. The GC partly upheld the appeal. Regarding the alleged *reformatio in peius*, the GC confirmed that the BoA had been entitled to examine and uphold the opponent's cross-appeal (paras 24-36).

♦[T-316/16](#); **SDC-554S / SDC-554S**; *Moravia Consulting spol. s r.o. v EUIPO*; Judgments of 12 October 2017; EU:T:2017:717; Language of the case: EN. The applicant sought to register the word mark **SDC-554S** for goods in Class 9. An opposition, based on an earlier non-registered trade mark identical to the trade mark applied for, was filed pursuant to Article 8(4) EUTMR. The OD dismissed the opposition. The BoA dismissed the appeal. The opponent filed an action before the GC. The GC dismissed the appeal. The opponent relied



on two pleas in law: (i) infringement of Article 8(4) EUTMR and of Article 95(1) EUTMR, and (ii) infringement of Article 59(1)(b) EUTMR. The plea of bad faith is inadmissible in the context of opposition proceedings (paras 26-31). The opponent must provide evidence of the content of national law before the EUIPO (paras 38-43). Such evidence cannot be filed for the first time before the BoA if no evidence had been submitted before the OD as to the existence, validity and scope of protection of the right relied on. In such a case, the BoA has no discretion to accept the evidence submitted for the first time before it, as it could not be considered additional or supplementary (paras 38-61). The evidence produced by the opponent for the first time at the hearing was also inadmissible (para. 63). Even if the evidence were to be considered additional or supplementary, the BoA would have had to exercise its discretion in the negative, because the opponent must necessarily have been aware, also because of the standard letter sent by the OD on how to support its opposition, that it was obliged to produce some evidence to establish the content of the national law before the OD. The principle *iura novit curia* was not applicable, since national law is a matter of establishing facts. It is only when the Office already has information on national law available to it that it must of its own motion inform itself of the latter (paras 65-74).

♦[T-317/16](#); **SDC-888TII RU / SDC-888TII RU**; *Moravia Consulting spol. s r.o. v EUIPO*; Judgments of 12 October 2017; EU:T:2017:718; Language of the case: EN. The applicant sought to register the word mark **SDC-888TII RU** for goods in Class 9. An opposition, based on an earlier non-registered trade mark identical to the trade mark applied for, was filed pursuant to Article 8(4) EUTMR. The OD dismissed the opposition. The BoA dismissed the appeal. The opponent filed an action before the GC. The GC dismissed the appeal. The opponent relied on two pleas in law: (i) infringement of Article 8(4) EUTMR and of Article 95(1) EUTMR, and (ii) infringement of Article 59(1)(b) EUTMR. The plea of bad faith is inadmissible in the context of opposition proceedings (paras 26-31). The opponent must provide evidence of the content of national law before the EUIPO (paras 38-43). Such evidence cannot be filed for the first time before the BoA if no evidence had been submitted before the OD as to the existence, validity and scope of protection of the right relied on. In such a case, the BoA has no discretion to accept the evidence submitted for the first time before it, as it could not be considered additional or supplementary (paras 38-61). The evidence produced by the opponent for the first time at the hearing was also inadmissible (para. 63). Even if the evidence were to be considered additional or supplementary, the BoA would have had to exercise its discretion in the negative, because the opponent must necessarily have been aware, also because of the standard letter sent by the OD on how to support its opposition, that it was obliged to produce some evidence to establish the content of the national law before the OD. The principle *iura novit curia* was not applicable, since national law is a matter of establishing facts. It is only when the Office already has information on national law available to it that it must of its own motion inform itself of the latter (paras 65-74).

♦[T-318/16](#); **SDC-444S / SDC-444S**; *Moravia Consulting spol. s r.o. v EUIPO*; Judgments of 12 October 2017; EU:T:2017:719; Language of the case: EN. The applicant sought to register the word mark **SDC-444S** for goods in Class 9. An opposition, based on an earlier non-registered trade mark identical to the trade mark applied for, was filed pursuant to Article 8(4) EUTMR. The OD dismissed the opposition. The BoA dismissed the appeal. The opponent filed an action before the GC. The GC dismissed the appeal. The opponent relied on two pleas in law: (i) infringement of Article 8(4) EUTMR and of Article 95(1) EUTMR, and (ii) infringement of Article 59(1)(b) EUTMR. The plea of bad faith is inadmissible in the context of opposition proceedings (paras 26-31). The opponent must provide evidence of the content of national law before the EUIPO (paras 38-43). Such evidence cannot be filed for the first time before the BoA if no evidence had been submitted before the OD as to the



existence, validity and scope of protection of the right relied on. In such a case, the BoA has no discretion to accept the evidence submitted for the first time before it, as it could not be considered additional or supplementary (paras 38-61). The evidence produced by the opponent for the first time at the hearing was also inadmissible (para. 63). Even if the evidence were to be considered additional or supplementary, the BoA would have had to exercise its discretion in the negative, because the opponent must necessarily have been aware, also because of the standard letter sent by OD on how to support its opposition, that it had to produce some evidence to establish the content of the national law before the OD. The principle *iura novit curia* was not applicable, since national law is a matter of establishing facts. It is only when the Office already has information on national law available to it that it must of its own motion inform itself of the latter (paras 65-74).

♦[T-80/17](#); **IST / ista et al.**; *Ingo Steiniger v EUIPO*; Judgment of 8 November 2017; EU:T:2017:784; Language of the case: DE. The applicant sought to register the figurative mark **IST** as an EUTM for goods and services in Classes 6, 7, 8, 9, 10, 11, 17, 35, 37, 40 and 42. An opposition based on the earlier figurative mark **ista** and registered for goods and services in Classes 7, 9, 11, 35, 36, 37, 38, 39, 40 and 42 was filed pursuant to Article 8(1)(b) EUTMR. The OD partially upheld the opposition for the goods and services covered by the contested trade mark. The applicant appealed against the OD's decision. The BoA dismissed the applicant's appeal insofar as it found a LOC, given the identity or at least similarity of the goods and services, the similarity of the signs and the nature of the relevant public. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 8(1)(b) EUTMR and (ii) infringement of Article 8(9) EUTMR. **No infringement of the right to be heard**: since the other party in the proceedings had not introduced any new matter of fact or of law in its pleadings before the BoA, there was no need for the applicant to be given the opportunity to reply to those pleadings (para. 75).

♦[T-771/15](#); **BITTORRENT**; *Hochmann Marketing GmbH (formerly Bittorrent Marketing GmbH) v EUIPO*; Judgment of 12 December 2017; EU:T:2017:887; Language of the case: EN. The applicant was the proprietor of the EUTM registration for the word sign **BITTORRENT** for Classes 35, 38 and 42. The intervener, BitTorrent Inc., filed an application for revocation of the mark at issue, based on Article 58(1)(a) EUTMR, on the ground that this mark had not been put to genuine use in the EU in connection with the services concerned within a continuous period of 5 years. The Office notified the applicant that it had 3 months within which to submit evidence of use of the mark at issue. Following a request from the applicant, the Office extended this time limit (which expired on 19 October 2011) by one month (i.e. to 21 November 2011, since 19 November 2011 was a Saturday). On 21 November 2011, the last day of the time limit for establishing genuine use of the mark at issue, the applicant sent a five-page letter by fax, which referred to attached documents. However, no documents were attached. By fax of 23 November 2011, the applicant's representative informed the Office that it had not sent all the documents due to a fax machine failure. On 24 November 2011, the Office received by post the 69 pages of items of evidence referred to in the five-page letter sent by fax on 21 November 2011. The BoA held that the applicant had submitted no relevant proof before the CD within the time limit specified, and therefore the evidence submitted before the BoA could not be taken into account. The BoA therefore held that genuine use of the mark at issue had not been proven and that the mark had to be revoked. For the sake of completeness, the BoA nonetheless assessed the evidence submitted late before the CD, as well as that submitted before the BoA at the appeal stage, and held that it did not prove use of the mark at issue. The applicant raised two pleas: (i) infringement of Article 95(1) and (2) EUTMR and (ii) infringement of Article 58(1)(a) EUTMR. **Regarding the first plea in law**: in EUTM revocation proceedings, it is for the EUTM proprietor, and not the Office of its own motion, to



establish genuine use of the mark concerned (paras 28, 29 and 30). The rule that the Office is to examine the facts of its own motion, as laid down in Article 95(1) EUTMR, does not apply to the question of proof of genuine use of the EUTM in revocation proceedings brought before the Office (para. 31). Regarding the evidence submitted late before the CD, the Office may disregard facts or evidence that are not submitted in due time by the parties concerned and has broad discretion to decide whether or not to take such information into account (paras 33, 36). Where the Office is called upon to rule on an application for revocation, the taking into account of belated evidence is particularly likely to be justified where the material is complementary to evidence submitted within the time limit and the Office considers, firstly, that it is likely to be relevant to the outcome of the application for revocation and, secondly, that the circumstances and the stage of the proceedings do not argue against it being taken into account (para. 40). In this case, only the letter sent by fax on 21 November 2011 was produced by the applicant before the CD within the period specified (para. 41). The letter submitted within the prescribed period was a five-page document but clearly contained only statements that were not substantiated by any supporting evidence capable of adducing proof of the place, time, extent and nature of use of the mark at issue, since the evidence was not submitted until 3 days after the prescribed period had expired. The BoA was thus correct in concluding that no proof had been submitted in due time before the CD (para. 45). The reason behind the failure to meet the deadline showed inexcusable negligence and was not attributable to exceptional circumstances that could not have been predicted from experience (paras 49-51). The BoA duly took into account all the relevant circumstances concerning the belated evidence (para. 52). With regard to the items produced before the Landgericht Berlin in 2010, the mark contested in those proceedings was not the EUTM at issue but a German mark registration **BITTORRENT**, and the territory was Germany rather than, as in this case, the EU (para. 56). With regard to the items produced in May 2008 in opposition proceedings against the intervener, the applicant referred to these only before the BoA. In addition, they were insufficient to prove genuine use of the EUTM as they consisted only of a very brief description of the website 'bittorrent.net' and three extracts from that website (para. 57). As to the evidence submitted for the first time before the BoA, since no PoU of the EUTM had been filed before the CD within the prescribed period and since the evidence submitted at the appeal stage was not by way of complement to the evidence produced within that period, the applicant could not argue that the evidence submitted before the BoA was additional evidence that should have been taken into account (para. 63). Furthermore, the applicant had not filed a request for either the continuation of proceedings under Article 105 EUTMR or *restitutio in integrum* under Article 104 EUTMR (para. 65).

2.2 Adequate reasoning

♦[T-54/16](#); **NETGURU**; *Netguru sp. z.o.o. v EUIPO*; Judgment of 17 January 2017; EU:T:2017:9; Language of the case: PL. The examiner refused a request for registration as an EUTM of the word mark **NETGURU** for goods and services in Classes 9, 35, 37, 38, 41 and 42 pursuant to Articles 7(1)(b) and (c) EUTMR. The BoA confirmed the refusal pursuant to Article 7(1)(b) EUTMR. It found that, for the contested goods and services, the trade mark applied for would be understood by the target public in the sense of coming from an expert in computer networks, since the word 'guru' is a synonym for 'expert', and 'net' is an abbreviation for computer network. The EUTM applicant filed an action before the GC, claiming infringement of (i) Article 94 EUTMR in conjunction with Article 41(1) and Article 41(2)(c) of the Charter of Fundamental Rights of the European Union, (ii) infringement of Article 95(2) EUTMR, and (iii) infringement of Article 7(1)(b) and (c) EUTMR. The GC



dismissed first the claim of infringement of Article 94 EUTMR in conjunction with Article 41(1) and Article 41(2)(c) of the Charter of Fundamental Rights of the European Union. It held that the reasoning of the contested decision applied to all products, as they formed a sufficiently homogenous category (paras 26, 27).

♦[T-19/15](#); **wax by Yuli's**; *Yuleidy Caridad Gómez Echevarría v EUIPO*; Judgment of 1 February 2017; EU:T:2017:46; Language of the case: ES. The EUTM proprietor was granted registration of the figurative mark **wax by Yuli's** as an EUTM for goods and services in Class 25. An application for invalidity was filed pursuant to Article 60(1)(a) in conjunction with Article 8(1)(b) EUTMR. The CD upheld the application for invalidity on the basis of the earlier word mark **MADWAX**. It considered it unnecessary to assess the case on the basis of the remaining earlier mark. The BoA dismissed the EUTM proprietor's appeal. It found that there was a LOC between the contested EUTM and the two earlier marks. The proprietor filed an action before the GC, relying on five pleas in law: (i) infringement of Article 71(1) EUTMR in conjunction with Article 41(2) of the Charter of Fundamental Rights; (ii) infringement of Article 8(1)(b) EUTMR insofar as the application for invalidity constituted an abuse of rights; (iii) and (iv) incorrect application and interpretation of Article 60(1)(a) in conjunction with Article 8(1)(b) EUTMR; and (v) incorrect application of Rule 94(1) and (7) of Implementing Regulation (EC) No 2868/95 in conjunction with Article 109(1) EUTMR. The GC dismissed the appeal. The BoA had correctly carried out an assessment of whether there was a LOC between the contested mark and both earlier marks. This was not altered by the facts that (i) the CD had not included the figurative earlier mark in its assessment, and (ii) the EUTM proprietor had not submitted any arguments before the BoA in relation to that earlier mark (paras 17-23). The GC referred to previous case-law by analogy (15/01/2013, T-237/11, *Bellram*, EU:T:2013:11) and confirmed that the right of defence had not been infringed in this case (paras 24-31). The applicant's arguments on the abuse of rights were inadmissible since they had been presented for the first time before the GC (paras 33-38).

♦[T-513/15](#); **Limbic® Map**; *Gruppe Nymphenburg Consult AG. v EUIPO*; Judgment of 16 February 2017; EU:T:2017:84; Language of the case: DE. The applicant sought to register the word mark **Limbic® Map** as an EUTM for goods and services in Classes 16, 35 and 41. The Office refused registration of the EUTM application for some of the goods and services in the abovementioned classes pursuant to Article 7(1)(b) and (c) EUTMR, as the EUTM application was found to be descriptive and devoid of distinctive character. The BoA, in a single-member decision, dismissed the applicant's appeal, basing its decision solely on Article 7(1)(c) EUTMR. It took the view that 'Limbic' referred to the 'limbic system', which describes the area of the brain that influences hormonal control and the autonomic nervous system and is responsible for emotional responses to environmental stimuli, such as instincts and emotions (fear, pleasure, anger) and drives (hunger, sex, dominance, care of offspring). 'Map' is the English term for a chart, plan, diagram, etc. As a whole, the expression 'Limbic® Map' would be understood by the relevant public such that the goods and services applied for constituted, contained, used or were intended for the creation of a map of the limbic system. Therefore, there was a sufficiently direct and concrete connection between the goods and services and the EUTM application to render the application descriptive (Article 7(1)(c) EUTMR) and refuse its registration for this reason alone. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR, and (ii) infringement of Articles 70, 94 and 95 EUTMR. **Lack of reasoning**: as the BoA's decision had been based only on Article 7(1)(c) EUTMR, it was not the task of the GC, within the context of reviewing the legality of the contested decision, to be the first to decide on an infringement of Article 7(1)(b) EUTMR. If the wording of the contested decision were to be interpreted to the effect that the BoA had found the EUTM application to be devoid of distinctive character in the sense of Article 7(1)(b) EUTMR, this conclusion was not



supported by any reasoning and would, for this reason, lead to the annulment of the contested decision (paras 55-57). Based on the foregoing, the contested decision was annulled.

♦♦[T-516/15](#); **Limbic® Types**; *Gruppe Nymphenburg Consult AG. v EUIPO*; Judgment of 16 February 2017; EU:T:2017:83; Language of the case: DE. The applicant sought to register the word mark **Limbic® Types** as an EUTM for goods and services in Classes 16, 35 and 41. The Office refused registration of the EUTM application for some of the goods and services in the abovementioned classes pursuant to Article 7(1)(b) and (c) EUTMR, as the EUTM application was found to be descriptive and devoid of distinctive character. The BoA, in a single-member decision, dismissed the applicant's appeal, basing its decision solely on Article 7(1)(c) EUTMR. It took the view that 'Limbic' refers to the 'limbic system', which describes the area of the brain that influences hormonal control and the autonomic nervous system and is responsible for emotional responses to environmental stimuli, such as instincts and emotions (fear, pleasure, anger) and drives (hunger, sex, dominance, care of offspring). The English word 'Types' could be defined as referring to the general form, structure or character distinguishing a particular kind, group or class of beings or objects from others. As a whole, the expression 'Limbic® Types' would be understood by the relevant public as 'different personality types, which respond differently to stimulation of the limbic system', and was therefore potentially capable of describing the goods and services at issue. Therefore, there was a sufficiently direct and concrete connection between the goods and services and the EUTM application to render the application descriptive (Article 7(1)(c) EUTMR) and refuse its registration for this reason alone. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR, and (ii) infringement of Articles 70, 94 and 95 EUTMR. **Lack of reasoning:** as the BoA's decision had been based only on Article 7(1)(c) EUTMR, it was not the task of the GC, within the context of reviewing the legality of the contested decision, to be the first to decide on an infringement of Article 7(1)(b) EUTMR. If the wording of the contested decision were to be interpreted to the effect that the BoA had found the EUTM application to be devoid of distinctive character in the sense of Article 7(1)(b) EUTMR, this conclusion was not supported by any reasoning and would, for this reason, lead to the annulment of the contested decision (paras 55-57). Based on the foregoing, the contested decision was annulled.

♦♦[T-517/15](#); **Limbic® Sales**; *Gruppe Nymphenburg Consult AG. v EUIPO*; Judgment of 16 February 2017; EU:T:2017:81; Language of the case: DE. The applicant sought to register the word mark **Limbic® Sales** as an EUTM for goods and services in Classes 16, 35 and 41. The Office refused registration of the EUTM application for some of the goods and services in the abovementioned classes pursuant to Article 7(1)(b) and (c) EUTMR, as the EUTM application was found to be descriptive and devoid of distinctive character. The BoA, in a single-member decision, dismissed the applicant's appeal, basing its decision solely on Article 7(1)(c) EUTMR. It took the view that 'Limbic' referred to the 'limbic system', which describes the area of the brain that influences hormonal control and the autonomic nervous system and is responsible for emotional responses to environmental stimuli, such as instincts and emotions (fear, pleasure, anger) and drives (hunger, sex, dominance, care of offspring). 'Sales' is the English term for the German word 'Verkauf'. As a whole, the expression 'Limbic® Sales' would be understood by the relevant public such that the goods and services applied for were connected with 'sales activities that relate to the limbic system' and was, thus, potentially capable of describing the goods and services at issue. Therefore, there was a sufficiently direct and concrete connection between the goods and services and the EUTM application to render the application descriptive (Article 7(1)(c) EUTMR) and refuse its registration already for this reason. The applicant filed an action before the GC, relying on



two pleas in law: (i) infringement of Article 7(1)(c) EUTMR, and (ii) infringement of Articles 70, 94 and 95 EUTMR. **Lack of reasoning:** as the BoA's decision had been based only on Article 7(1)(c) EUTMR, it was not the task of the GC, within the context of reviewing the legality of the contested decision, to be the first to decide on an infringement of Article 7(1)(b) EUTMR. If the wording of the contested decision were to be interpreted to the effect that the BoA had found the EUTM application to be devoid of distinctive character in the sense of Article 7(1)(b) EUTMR, this conclusion was not supported by any reasoning and would, for this reason, lead to the annulment of the contested decision (paras 55-57). Based on the foregoing, the contested decision was annulled.

♦[T-178/16](#); **Policolor / ProfiColor**; *CWS-Lackfabrik Conrad W.Schmidt GmbH & Co. KG v EUIPO*; Judgment of 6 April 2017; EU:T:2017:264; Language of the case: EN. The applicant sought to register the figurative mark **Policolor** for goods in Class 2. An opposition based on the earlier figurative mark **ProfiColor**, registered for goods in Class 2, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition. The BoA dismissed the appeal. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 8(1)(b) EUTMR, (ii) infringement of Article 94 EUTMR, and (iii) invalidity of the earlier mark. The GC dismissed the appeal. **The obligation to state reasons:** although the BoA had not expressly ruled on the distinctiveness of the term 'color', it had clearly explained that consumers would focus on that element because it was the element most familiar to them (para. 76).

♦[T-163/16](#); **secret.service**; *Reisswolf Akten- und Datenvernichtung GmbH & Co. KG v EUIPO*; Judgment of 18 May 2017; EU:T:2017:350; Language of the case: DE. The applicant sought to register the word mark **secret.service** as an EUTM for various office functions in Class 35, document-related services in Classes 39 and 40, and a variety of consultancy and IT-related services in Class 42. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR. The BoA dismissed the applicant's appeal. It found that the EUTM application referred to a service related to something secret. For the services concerning the storage and destruction of documents and data, the EUTM application designated their purpose of keeping such documents/data secret. For this reason, the EUTM application also lacked the required distinctiveness. The applicant filed an action before the GC, relying on four pleas in law: (i) breach of the obligation to examine the facts *ex officio*, (ii) breach of the obligation to state reasons, (iii) infringement of Article 7(1)(c) EUTMR, and (iv) infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal. The BoA had correctly assessed the EUTM application's registrability from the point of view of the English-speaking public. The contested decision's references to the German translation of the words 'secret' and 'service' were merely a result of German being the language of the proceedings (para. 20). Given that all services concerned the storage and destruction of documents and data, and thus formed a homogenous group, the BoA had been entitled to employ the same line of reasoning in rejecting the application for all of them (paras 30-47). On the merits of the EUTM application's registrability, the GC confirmed the BoA's findings. In the context of the services in question, associations with, for example, the protection of the US president or with a film featuring James Bond were unlikely. Furthermore, the term 'secret' was also commonly used in a commercial context (paras 59-70). The EUTM application had therefore correctly been refused registration under Article 7(1)(c) EUTMR, with the result that it was not necessary to address the plea concerning Article 7(1)(b) EUTMR.

♦[T-258/16](#); **GINRAW / RAW**; *Mediterranean Premium Spirits, SL v EUIPO*; Judgment of 7 June 2017; EU:T:2017:375; Language of the case: EN. The applicant sought to register the word mark **GINRAW** for goods in Classes 21 and 33. An opposition based on the word mark



RAW, protected by two EUTMs, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition. The BoA dismissed the applicant's appeal. Before the GC, the applicant claimed (i) infringement of Article 8(1)(b) EUTMR and (ii) breach of the obligation to state reasons. The GC dismissed the action. The GC found that the BoA's decision could not be criticised for lack of reasoning as regards the normal distinctiveness of the earlier marks or the descriptiveness of the word 'GIN' inasmuch as the BoA could not be required to reply specifically to each argument put forward or reject specifically each item of evidence: since the OD's decision had been confirmed in its entirety, that decision and its reasoning formed the context for the adoption of the BoA decision. A more detailed statement of reasons had been given in the OD decision. Moreover, the applicant had expressly conceded the descriptiveness of the word 'GIN' before the BoA (paras 88-94).

♦[T-236/16](#); **ZUM wohl**; *Biogena Naturprodukte GmbH & Co. KG v EUIPO*; Judgment of 22 June 2017; EU:T:2017:416; Language of the case: DE. The applicant sought to register the figurative mark **ZUM wohl** as an EUTM for various foodstuffs and beverages in Classes 29, 30 and 32, and for *food and drink preparation services; takeaway services; provision of information relating to the preparation of food and drink* in Class 43. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR. The BoA dismissed the applicant's appeal. The BoA found that the EUTM application was descriptive of the goods and services concerned, within the meaning of Article 7(1)(c) EUTMR, since the German expression 'zum Wohl' would be immediately recognised by the relevant public (general public and specialist public, both either German-speaking or with at least a sufficient knowledge of German) as meaning that they would contribute to the targeted consumers' well-being. The figurative elements of the EUTM application would not divert consumers' attention from the clear laudatory advertising message conveyed by this expression. The BoA also held that the EUTM application was devoid of distinctive character under Article 7(1)(b) EUTMR. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 7(1)(b) EUTMR, (ii) infringement of Article 7(1)(c) EUTMR, and (iii) breach of the obligation to state reasons under Article 94 EUTMR. The GC dismissed the appeal. **Obligation to state reasons**: in order to facilitate drafting, and in the absence of any challenge concerning any one of the goods or services in question specifically, the BoA had on several occasions referred to the goods and services generally, in particular to 'goods and services of the food industry'. Nevertheless, when the analysis had required it, the BoA had adapted its reasoning according to whether goods or services were involved and had also specified its reasoning, for example grouping some goods by food or drink type and mentioning separately those that could not be grouped. Furthermore, given that the goods and services in question were all everyday foods or services with a direct link to such goods, they could be considered to have a sufficiently direct and specific link between them, to the point that they comprised a category of sufficient homogeneity. Therefore, the BoA could not be criticised for having mostly used global reasoning in its assessment (paras 24-30).

♦[T-81/16](#); **POSITION OF TWO CURVED STRIPS ON THE SIDE OF A TYRE**; *Pirelli Tyre SpA v EUIPO*; Judgment of 4 July 2017; EU:T:2017:463; Language of the case: EN. An application for registration of a figurative mark as an EUTM was filed for *tyres, solid, semi-pneumatic and pneumatic tyres, rims and covers for vehicle wheels* in Class 12. The application was for a position mark described as 'a pair of essentially equal curved strips positioned on the side of a tyre and running along its circumference'. The examiner rejected the application on the ground that the mark applied for was devoid of distinctive character within the meaning of Article 7(1)(b) EUTMR. The First BoA dismissed the appeal against the examiner's decision and confirmed that the mark applied for was caught by the prohibitions of Article 7(1)(b) EUTMR. The applicant filed an appeal before the GC, relying on three pleas



in law: (i) infringement of Articles 94 and 95 EUTMR, (ii) infringement of Article 7(1)(b) EUTMR, and (iii) infringement of Article 7(3) EUTMR. The GC dismissed the appeal. **Infringement of Article 94 EUTMR:** the GC dismissed the applicant's argument that the BoA had failed in its duty to state reasons by not examining the distinctive character of the mark in relation to each of the goods in question. The GC restated first that the Board was entitled to give a general reasoning as the goods formed a sufficiently homogeneous category or group of goods. Second, the GC noted that, in any event, the applicant had applied for registration of a 'position mark', intended to be affixed to the side of a tyre. Therefore, as a direct consequence of the nature of the mark applied for, even though the applicant had claimed protection for additional goods, namely *rims and covers for the wheels of vehicles*, the sign for which registration was sought was necessarily limited to *tyres*, as it was affixed to these and not to any other goods (paras 23 and 24). The GC also dismissed the applicant's argument that the BoA had failed in its duty to state reasons by not explaining why the consumer would perceive the mark applied for as a mere frame for technical information provided on the sidewalls of tyres and not as an indication of origin (para. 26). The GC found in this respect that the marking of technical specifications on tyre sidewalls is a matter of common knowledge and therefore required no specific reasoning in order to be taken into account by the BoA. Furthermore, contrary to what the applicant claimed, it was apparent from the wording used in paragraph 16 of the contested decision that the BoA had relied on that reason for the sake of completeness in relation to the reason relating to the extreme simplicity of the mark applied for (paras 26-28). Moreover, this question concerning the BoA's assessment of distinctive character concerned the validity of the reasons, which was the subject of the second plea, rather than the adequacy of the statement of reasons of the contested decision as an essential procedural requirement (paras 28 and 29).

♦[T-3/16](#); **DRIVEWISE**; *Allstate Insurance Company v EUIPO*; Judgment of 5 July 2017; EU:T:2017:467; Language of the case: EN. The EUTM applicant sought to register the word mark **DRIVEWISE** as an EUTM for goods in Class 9 and services in Class 42. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR, and the BoA dismissed the appeal. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) EUTMR, and (iii) infringement of Article 94 EUTMR. The GC dismissed the appeal. **On the alleged lack of reasoning:** the GC found that the BoA decision was sufficiently reasoned in accordance with the requirements set out under Article 94 EUTMR. The GC restated the case-law according to which the Office has in principle to give reasons for the refusal for each of the relevant goods and services. However, general reasons may be stated where the goods show a sufficiently direct and objective link to the extent that they form a homogeneous category or group (para. 52). In the present case, the BoA had duly given sufficient reasons for finding a link between the mark and all the goods and services (paras 54 and 55).

♦[T-150/16](#); **ECOLAB**; *Ecolab USA Inc. v EUIPO*; Judgment of 13 July 2017; EU:T:2017:490; Language of the case: EN. The applicant sought to designate the EU in its IR for the word sign **ECOLAB** for an extensive range of goods and services. The Office refused protection pursuant to Article 7(1)(b) and (c) EUTMR for the services in Class 42. The applicant appealed the partial refusal. The BoA dismissed the appeal on the same grounds, as well as on the basis that the applicant had not demonstrated acquired distinctive character through use pursuant to Article 7(3) EUTMR. The applicant filed an action before the GC, relying on four pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) and Article 7(2) EUTMR in conjunction with Article 7(3) EUTMR; (iii) a breach of the principles of equal treatment and the protection of legitimate expectations, and (iv) infringement of Article 94 EUTMR. The GC dismissed the appeal. **On the alleged lack of**



reasoning: in relation to the fourth plea, the GC held that the BoA had given sufficient reasons for finding a link between the mark and all the services at issue, and that the imputed decision was in accordance with the requirements set out under Article 94 EUTMR (paras 70-72).

♦[T-194/16](#); **CLASSIC FINE FOODS**; *Klassisk investment Ltd v EUIPO*; Judgment of 14 July 2017; EU:T:2017:498; Language of the case: DE. The holder sought to register the figurative mark **CLASSIC FINE FOODS** as an international registration (IR) designating the EU for services in Class 35. The Office refused registration of the international registration (IR) pursuant to Article 7(1)(b) and (c) and Article 7(2) EUTMR, as it was found to be descriptive and devoid of distinctive character. The BoA dismissed the holder's appeal and confirmed the examiner's decision. The holder filed an action before the GC, relying on three pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) EUTMR, and (iii) infringement of Article 94 EUTMR. The GC dismissed the appeal. With regard to the third plea, the lack of reasoning, the GC dismissed this plea since the contested decision had examined in detail the various verbal and figurative elements in connection with the services claimed (para. 46). On the basis of the foregoing, the action was dismissed.

♦[T-110/16](#); **SAVANT**; *Savant Systems LLC v EUIPO*; Judgment of 18 July 2017; EU:T:2017:521; Language of the case: EN. The EUTM proprietor was granted registration of the word mark **SAVANT** for goods and services in Classes 9, 16, 41 and 42. An application for revocation was filed pursuant to Article 58 EUTMR. The CD upheld the application for revocation in respect of all the goods and services registered with the exception of *computer software services; computer programming services, consultancy services relating to computer software* in Class 42, for which the application for revocation was rejected. The BoA partly upheld the EUTM proprietor's appeal. It found that genuine use had been proven not only for *computer software services; computer programming services, consultancy services relating to computer software* in Class 42, which were not covered by the appeal, but also for the other services in Classes 41 and 42 and for *computer software* in Class 9. The invalidity applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 58(1)(a) EUTMR in conjunction with Article 18 EUTMR; (ii) breach of the duty to state reasons. **Duty to state reasons:** the GC considered that the BoA had provided a complete and precise set of reasons for its decision; the fact that it had not commented on a specific report produced by the invalidity applicant did not mean that it had not fulfilled its duty to state reasons. The duty to state reasons did not amount to an obligation to respond to every argument and every piece of evidence submitted.

♦[T-305/16](#); **LOVE TO LOUNGE**; *Lidl Stiftung & Co. KG v EUIPO*; Judgment of 15 September 2017; EU:T:2017:607; Language of the case: EN. An application for invalidity was filed pursuant to Article 59(1)(a) EUTMR in conjunction with Articles 7(1)(b) and (c) EUTMR. The CD dismissed the application for invalidity in its entirety. The applicant filed a notice of appeal against the CD's decision. The BoA dismissed the appeal. It found that the contested mark was not capable of describing the goods covered; therefore, the connection between the expression 'love to lounge' and the goods concerned was too indeterminate to constitute a ground for invalidity. Moreover, it found that the contested mark could not be regarded as being completely devoid of any distinctive character. The applicant filed an action before the GC, relying on four pleas in law: (i) infringement of Article 95 EUTMR, (ii) infringement of Article 94 EUTMR, (iii) infringement of Article 7(1)(c) EUTMR, and (iv) infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal. The GC found that, notwithstanding the 'doubtful' online search methodology used for some items of evidence, the BoA had not breached its obligation to state reasons, since the evidence submitted did not prove that the contested mark was descriptive (paras 24-29).



♦ [T-86/16](#); **ANA DE ALTUN / ANNA et al.**; *Codorníu, S.A. v EUIPO*; Judgment of 18 September 2017; EU:T:2017:627; Language of the case: ES. The applicant sought to register the figurative mark **ANA DE ALTUN** as an EUTM for goods in Class 33. An opposition based on, inter alia, the earlier Spanish figurative mark **ANNA**, registered for goods in Class 33, was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The OD upheld the opposition insofar as it considered that there would be a LOC. The BoA upheld the applicant's appeal. It found that there would be no LOC between the contested mark and the Spanish earlier trade mark **ANNA**, even for identical goods. It did not assess the alleged enhanced distinctiveness of the earlier trade mark as it considered the signs dissimilar. The BoA did not assess Article 8(1)(b) EUTMR with regard to the other earlier rights **ANNA DE CODORNIU** as it considered that they were even less similar to the examined earlier right. Finally, it considered that there was no link between the signs within the meaning of Article 8(5) EUTMR. The opponent filed an action before the GC, relying on three pleas in law: (i) infringement of Articles 94 and 95 EUTMR, (ii) infringement of Article 8(1)(b) EUTMR, and (iii) infringement of Article 8(5) EUTMR. The GC upheld the appeal. It found that the BoA methodology for assessing the LOC had been based on the wrong premise that the signs were globally different. As a result, the BoA had incorrectly considered that the evidence of enhanced distinctiveness and reputation did not need to be examined. Finally, the GC considered that the decision lacked reasoning regarding the absence of a LOC with regard to other earlier trade marks that the BoA had considered less similar to the earlier Spanish mark being assessed. **Lack of reasoning**: the GC considered that the decision lacked reasoning regarding the absence of a LOC with regard to other earlier trade marks that the BoA had considered less similar to the earlier Spanish mark being assessed. According to the GC, the relevant public for some of the other earlier trade marks was not only the Spanish public (paras 92-93).

♦ [T-844/16](#); **Klosterstoff**; *Alpirsbacher Klosterbräu Glauner GmbH & Co. KG v EUIPO*; EU:T:2017:759; Judgment of 26 October 2017; Language of the case: ES. The applicant sought to register the word mark **Klosterstoff** as an EUTM for goods and services in Classes 32 and 33. The examiner refused the application, on the basis of Article 7(1)(b), (c) and (g) EUTMR, as non-distinctive, descriptive and deceptive. The applicant filed an appeal before the BoA. The BoA dismissed the appeal. It found that the word 'Klosterstoff' would be understood, by the German-speaking public, as designating products containing alcohol, originating from a monastery or produced there. Therefore, the sign was non-distinctive, descriptive and deceptive. The applicant filed an action before the GC, relying on four pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) EUTMR, (iii) infringement of Article 7(1)(g) EUTMR, and (iv) ignorance of the Office's previous decision-making practice. The GC dismissed the appeal. The fourth plea was also dismissed. Contrary to the applicant's claims, the Office had sufficiently stated reasons for its decision (para. 54). Based on the foregoing, the action was dismissed (para. 59).

♦ [T-129/16](#); **Claranet / Claro**; *Claranet Europe Ltd v EUIPO*; Judgment of 14 November 2017; EU:T:2017:800; Language of the case: EN. The applicant sought to register the figurative mark **claranet** as an EUTM for goods and services in Classes 9, 35, 38 and 42. An opposition based, inter alia, on the earlier Benelux word mark **CLARO** (registered for *telecommunications services* in Class 38) was filed on the grounds of Article 8(1)(b) EUTMR. The OD upheld the opposition in relation to the earlier Benelux word mark **CLARO**. The BoA dismissed the applicant's appeal against this decision. The applicant then filed an action before the GC, relying on three pleas in law: (i) infringement of Article 8(1)(b) EUTMR, (ii) breach of the principle of equal treatment, and (iii) breach of the obligation to state reasons (Article 94 EUTMR). **The alleged breach of the obligation to state reasons**: the contested decision contained an adequate statement of the reasons and the BoA could not be criticised



for not sufficiently fulfilling its obligation to state reasons, in particular, by not explicitly referring to a judgment of the GC (para. 103).

♦ [T-403/16](#); **Immunostad**; *Stada Arzneimittel AG v EUIPO*; Judgment of 20 November 2017; EU:T:2017:824; Language of the case: EN. The applicant was granted registration of the word mark **Immunostad** as an EUTM for goods in Classes 3 and 5. An application for invalidity was filed, based on Article 8(1)(b) EUTMR, in respect of the subcategory *pharmaceutical preparations; dietetic substances adapted for medical use* and in the light of the earlier French word mark **Immunostim** covering, inter alia, *dietetic substances adapted for medical use, namely food supplements* in Class 5. The CD upheld the application for invalidity insofar as it found identity between the goods regarding *dietetic substances adapted for medical use* and similarity regarding *pharmaceutical preparations*. The applicant appealed against the CD's decision. The BoA dismissed the appeal because it found visual, aural and conceptual similarity between the marks, considering the similarity between the goods and the average degree of distinctiveness of the earlier mark. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 60(1)(a) in conjunction with Article 8(1)(b) EUTMR and (ii) infringement of Article 94 EUTMR. **Alleged lack of reasoning**: the BoA had been in no way obliged to provide reasoning about the perception of the part of the public that understood the element 'stim' as the abbreviation of the French word 'stimuler'. The finding of a LOC for a non-negligible part of the relevant public was sufficient for the granting of an application for invalidity in respect of a registered trade mark (paras 66-69).

♦ [T-35/16](#); **VITA**; *Sony Computer Entertainment Europe Ltd v EUIPO*; Judgment of 12 December 2017; EU:T:2017:886; Language of the case: EN. The word mark **VITA** was registered as an EUTM for goods in, inter alia, Class 9 by Vitakraft-Werke Wührmann & Sohn GmbH & Co KG. Subsequently, Forrester Ketley Ltd informed the Office that the former company had transferred to the latter the rights in the abovementioned trade mark with regard to the abovementioned goods. It later informed the EUIPO that it had transferred the contested mark to the current EUTM proprietor. An application for revocation was filed pursuant to Article 58(1)(a) EUTMR. The CD upheld the application for revocation and revoked the contested mark. Upon the EUTM proprietor's appeal, the BoA dismissed the appeal as it found, inter alia, that all of the evidence submitted by the applicant showed evidence of use for goods in Class 28 and not for the goods covered by the contested mark. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 58(1)(a) EUTMR. The BoA decision did not make it possible to determine with sufficient clarity why it had taken the view that the applicant had not proven genuine use of the contested mark for the various types of goods in question. The BoA did not in any way explain why the reproductions of memory cards bearing the sign PSVita could not establish genuine use of the contested mark for *data carriers containing programs*, even though, first, it expressly listed those reproductions among the evidence relating to the relevant period and, second, it also expressly referred to memory cards as an example of such data carriers (para. 51). The BoA did not state in a sufficiently clear and unequivocal manner why it had found that genuine use of the contested mark had not been established for *audio and/or image carriers (not of paper), in particular magnetic tape cassettes, audio tapes, audio compact discs, DAT (digital audio tape) cassettes, videodiscs, videotapes, exposed films, lithographs*. Although the same part of the BoA decision referred to the expression *data carrier* several times it could not be established with certainty whether the expression covered only *data carriers containing programs* or whether it also included the abovementioned category (para. 53). The BoA did not explain why it had not accepted the applicant's evidence establishing the presence of the sign **PSVita** on the video games to be



played on the PlayStation Vita console (para. 55). The Office's argument that the photographs of video game boxes bearing the sign **PSVita** did not contain information relating to use could not be regarded as supplementing a statement of reasons that was already self-sufficient. Statements of reasons for a decision may not be made by means of subsequent explanations provided by the Office, save in exceptional circumstances (paras 56-58). The BoA had breached its obligation to state reasons with respect to the elements of reasoning that were essential to support its final conclusion (para. 59).

2.3 *Ultra petita*

[No entry]

2.4 *Others*

♦[T-88/16](#); **ALPHAREN / ALPHA D3**; *OPKO Ireland Global Holdings, Ltd v EUIPO*; Judgment of 26 January 2017; EU:T:2017:32; Language of the case: EN. The BoA decision had been annulled in part by judgment of 09/02/2011, [T-222/09](#), *Alpharen*, EU:T:2011:36 because the BoA had infringed Article 95(1) EUTMR by making its own investigations on the therapeutic indication of the pharmaceutical goods under comparison. The case was remitted to the BoA, but it was found that the rapporteur of the BoA concerned had already been involved in the first (annulled) decision. This led to a second annulment (03/07/2013, [T-106/12](#), *Alpharen*, EU:T:2013:340). The case was remitted to a different BoA. However, it transpired, after this BoA had adopted its decision, that its chairperson had also been a member of the BoA that had taken the first decision. Another appeal was lodged before the GC but the BoA revoked its decision and the case was considered devoid of purpose. A new decision, almost identical to the revoked decision, was adopted by a BoA in which no member had been involved in the previous proceedings. On the merits, the BoA confirmed that there was a LOC in view of the similarity of the pharmaceutical goods, which were both aimed at treating kidney disorders, and the similarity of the signs for patients (but not for health professionals, who would consider 'Alpha' to be descriptive). The GC dismissed the action. **Composition of BoA after revocation:** the GC confirmed that the requirement for the BoA to be free of any member having dealt with a previously annulled decision does not apply where the decision is revoked (para. 35). After the 5th BoA had revoked its decision, the case did not need be dealt with by a BoA of an entirely different composition. The mere fact that the content of the decision adopted after revocation was almost identical to that of the revoked decision was not, in itself, capable of establishing a lack of independence on the part of the members of the BoA (para. 38).

♦[T-238/15](#); **ZIMARA / FEMARA**; *Novartis AG v EUIPO*; Judgment of 21 September 2017; EU:T:2017:636; Language of the case: EN. The applicant sought to register the word mark **ZIMARA** for goods in Classes 3 and 5. An opposition based on the earlier word mark **FEMARA**, registered for goods in Class 5, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition. The BoA dismissed the opponent's appeal. It found that the OD had correctly defined the subcategory for which genuine use was shown as *pharmaceutical preparations for the treatment of breast cancer*. It noted that, even if genuine use had been proven for *pharmaceutical preparations for the treatment of cancer*, as argued by the opponent, this would not have changed the result of the comparison of the goods. According to the BoA, the level of attention of the relevant consumer was 'high' and



'heightened'. There was a very low degree of visual and a low degree of aural similarity between the marks. The BoA had found that the English-speaking part of the relevant public would pronounce the 'e' in FEMARA like the 'e' in the English word 'lemon'. The opponent filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. **On the obligation of the Board of Appeal to decide on the appeal (Article 71(1) EUTMR):** the GC rejected the argument that the BoA's failure to compare the contested *veterinary preparations* could have no bearing on the outcome since the BoA had found no LOC even for identical goods. The BoA had not mentioned *veterinary preparations* and had not adjudicated on the relevant public's level of attention with regard to them. The Court could not assess anything on which the BoA had not adopted a position (para. 34). The contested decision had to be annulled insofar as the BoA had failed to adjudicate on *veterinary preparations* (para. 36).

3. **General principles of EU law**

♦[T-856/16](#); **LONGHORN STEAKHOUSE**; *Rare Hospitality International, Inc. v EUIPO*; Judgment of 21 June 2017; EU:T:2017:412; Language of the case: EN. The applicant sought to register the word mark **LONGHORN STEAKHOUSE** as an EUTM for services in Class 43. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR. The applicant filed a notice of appeal pursuant to Articles 66 to 71 EUTMR. The BoA dismissed the appeal. It found that the mark applied for was descriptive of the services in Class 43 and devoid of distinctive character. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) EUTMR, and (iii) breach of the principles of equal treatment and sound administration. The GC dismissed the appeal. With regard to the third plea, the GC stated that the BoA assessment could not be called into question on the sole ground that it did not follow the Office's supposed decision-making practice (para. 58). Furthermore, specifically as regards the assessment of the term 'longhorn' carried out by the BoA, the applicant's line of argument was based on a misreading of the contested decision (para. 59). Consequently, all the pleas had to be rejected.

♦[T-287/15](#); **real,-**; *Tayto Group Ltd v EUIPO*; Judgment of 28 June 2017; EU:T:2017:443; Language of the case: EN. The EUTM proprietor was granted registration of a figurative mark as an EUTM for goods and services in Classes 3, 8, 16, 18, 20, 21, 22, 24, 25, 28, 29, 30, 31 and 32. An application for revocation was filed pursuant to Article 58 EUTMR. The CD upheld the application for revocation. The BoA partially upheld the EUTM proprietor's appeal. It found that the contested mark had been put to genuine use for some of the goods covered by it. The revocation applicant filed an action before the GC, relying on six pleas in law: (i) infringement of Article 18(1) EUTMR, (ii) infringement of Article 18(2) EUTMR, (iii) infringement of Articles 71 and 95 EUTMR, (iv) infringement of Article 58(1)(a) EUTMR, (v) infringement of Article 94 EUTMR, and (vi) misuse of power and infringement of general principles of law. **Sixth plea:** the applicant does not put forward any evidence showing that, by refusing to grant it an extension of the time limit, the BoA used its powers for a purpose other than that for which they were conferred on it. The extension of a specified period is not automatic: in each case, it depends on circumstances that are specific to the individual case and that make it appropriate to grant an extension, as well as on the submission of a request for extension. That is particularly true for *inter partes* proceedings, in which an advantage granted to one of the parties constitutes a disadvantage for the other. In such cases, the Office must therefore ensure that it remains impartial with regard to the parties. As regards the alleged infringement of general principles of law, it must be pointed out, first, that the



applicant did not state which ones it was relying on in particular and, second, that, at the hearing, it had submitted that this was not necessary in order for the GC to be able to rule on that argument (paras 76-87).

♦[T-150/16](#); **ECOLAB**; *Ecolab USA Inc. v EUIPO*; Judgment of 13 July 2017; EU:T:2017:490; Language of the case: EN. The applicant sought to designate the EU in its IR for the word sign **ECOLAB** for an extensive range of goods and services. The Office refused protection pursuant to Article 7(1)(b) and (c) EUTMR for the services in Class 42. The applicant appealed the partial refusal. The BoA dismissed the appeal on the same grounds, as well as on the basis that the applicant had not demonstrated acquired distinctive character through use pursuant to Article 7(3) EUTMR. The applicant filed an action before the GC, relying on four pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) and Article 7(2) EUTMR in conjunction with Article 7(3) EUTMR; (iii) breach of the principles of equal treatment and the protection of legitimate expectations, and (iv) infringement of Article 94 EUTMR. The GC dismissed the appeal. **On the alleged breach of the principles of equal treatment and the protection of legitimate expectations:** as to the third plea, the GC stated that the application had been fully examined and rightly found to be descriptive. Therefore, the principles mentioned had been correctly reconciled with respect for legality, and the applicant could not challenge the findings on the basis of previous Office decisions.

♦[T-780/16](#); **Mediaexpert**; *Mediaexpert sp. z o.o v EUIPO*; Judgment of 20 July 2017; EU:T:2017:538; Language of the case: EN. The applicant filed a declaration of invalidity based on an earlier Polish trade mark, invoking Article 60(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR. In support of the declaration, it filed an extract from the Polish Patent Office database in Polish. In order to remedy relative admissibility deficiencies, it also filed the list of relevant goods and services in English. The application for a declaration of invalidity was rejected in its entirety as not substantiated. The BoA dismissed the appeal. The applicant filed an action before the GC, relying essentially on two pleas in law: (i) infringement of Rule 37(b) and Rules 38(1) and (2), 39(2) and (3) and 98(1) of Implementing Regulation (EC) No 2868/95, and (ii) breach of the principle of protection of legitimate expectations. By its first plea, the applicant claimed that the Office had knowledge of the scope of protection of the earlier Polish mark by means of both the information contained in the application for a declaration of invalidity and the translation of the list of goods and services; the Office had not asked it to submit a full translation of the database extract. By its second plea, the applicant complained that the Office had given it the impression that the application for a declaration of invalidity was complete. It also considered that the Office guidelines had not been correctly applied. The GC dismissed the appeal. **Principle of protection of legitimate expectations:** the Office had not given the applicant the 'precise assurances' required by the case-law. First, the letter inviting the applicant to remedy the admissibility deficiencies clearly stipulated that it merely concerned admissibility and that it was possible that the documents or translations submitted would not be sufficient to substantiate the application. Second, the applicant could neither be unaware of the obligation to produce translations of supporting evidence, which had a clear legal basis in Rule 38(2) of Implementing Regulation (EC) No 2868/95, nor expect the Office to exempt a party from compliance with such requirement. The attempt to rely on the Guidelines was misconceived as the distinction between conditions governing admissibility and the questionsubstantiation were clearly explained in the Guidelines.

♦[T-670/15](#); **OSHO**; *Osho Lotus Commune e. V. v EUIPO*; Judgment of 11 October 2017; EU:T:2017:716; Language of the case: DE. An application for invalidity was filed pursuant to Article 59(1)(a) in conjunction with Article 7(1)(b), (c) and (f) EUTMR against the word mark **OSHO** for *educational services; yoga instruction* in Class 41 and *religious services*;



meditation services in Class 42. The CD rejected the application. The BoA dismissed the applicant's subsequent appeal. The BoA found that there was no evidence that **OSHO**, beyond being a man's personal name and a reference to his teachings, had over the years acquired a descriptive meaning with regard to a specific type of education, yoga practice, meditation technique or religious service. The BoA also found that use of the name of a spiritual leader in relation to the services in question could not be considered offensive by the relevant public. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 7(1)(b) EUTMR, (ii) infringement of Article 7(1)(c) EUTMR, and (iii) infringement of Article 7(1)(f) EUTMR. The GC dismissed the action. **Alleged infringement of public order**: without going into the question of its admissibility, the GC also addressed the applicant's claim raised for the first time in the oral hearing, namely breach of Article 9(1) of the European Convention on Human Rights, according to which everyone has the right to freedom of thought, conscience and religion. The GC stated that the applicant had not explained how registration of the trade mark OSHO would deprive the applicant of the right to freedom of thought, conscience and religion, and in particular how such registration would prejudice the applicant's rights to change religion or belief and profess the latter. The mere claim that monopolising the name of a spiritual teacher would prevent the applicant from professing his or her belief was not enough to justify finding a breach against public order.

♦[T-129/16](#); **Claranet / Claro**; *Claranet Europe Ltd v EUIPO*; Judgment of 14 November 2017; EU:T:2017:800; Language of the case: EN. The applicant sought to register the figurative mark **claranet** as an EUTM for goods and services in Classes 9, 35, 38 and 42. An opposition based, inter alia, on the earlier Benelux word mark **CLARO** (registered for *telecommunications services* in Class 38) was filed on the grounds of Article 8(1)(b) EUTMR. The OD upheld the opposition in relation to the earlier Benelux word mark **CLARO**. The BoA dismissed the applicant's appeal against this decision. The applicant then filed an action before the GC, relying on three pleas in law: (i) infringement of Article 8(1)(b) EUTMR, (ii) breach of the principle of equal treatment, and (iii) breach of the obligation to state reasons (Article 94 EUTMR). **The alleged breach of the principle of equal treatment**: the BoA had conducted a full and specific assessment of the trade mark for which registration was sought before refusing to register it. Previous practice of the BoA could not be taken as a basis for assessing the registrability of an EUTM (para. 96).

♦[T-101/15](#) and [T-102/15](#) (joined cases); **Blue and Silver (col.)**; *Red Bull GmbH v EUIPO*; Judgment of 30 November 2017; EU:T:2017:852; Language of the case: EN. The applicant sought to register two colour marks as EUTMs for goods in Class 32. Each colour mark's representation was a combination of two colours accompanied by a description [blue (RAL 5002) and silver (RAL 9006) juxtaposed in a ratio of 'approximately 50 %-50 %' in one case and 'the two colours ... applied in equal proportions and juxtaposed to each other' in the other case]. An application for invalidity was filed pursuant to Article 59(1)(a) EUTMR in conjunction with Article 7(1)(a), (b) and (d) EUTMR. The CD upheld the application for invalidity insofar as the contested marks constituted the mere juxtaposition of two or more colours, designated in the abstract and without contours, and did not exhibit the qualities of precision and uniformity required by Article 4 EUTMR. The applicant appealed against the CD's decision, but the BoA dismissed the appeals, finding infringement of Article 4 and Article 7(1)(a) EUTMR. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 4 and Article 7(1)(a) EUTMR and breach of the principles of proportionality and equal treatment, and (ii) breach of the principle of protection of legitimate expectations. The GC dismissed the appeal. **Equal treatment**: colour marks differ from other types of mark, because of their intrinsically less precise nature (without contours or shape). Accordingly, the requirement that their subject matter be defined in appropriate detail does not constitute a breach of the principle of equal treatment (paras 85 and 96). Moreover, the



requirement for a systematic arrangement follows directly from the wording of the paragraph of the EUIPO Guidelines regarding the graphic representation of a combination of colours (para. 101). **Principle of proportionality:** the GC stated that the principle of proportionality had not been breached. It was not disproportionate to require the combination of colours to be represented graphically or be accompanied by a description (para. 119). **Principle of protection of legitimate expectations:** the GC confirmed the BoA statement that the applicant could not rely on the principle of legality. The examiner's suggestions for a description did not amount to precise, unconditional and consistent information that could give rise to legitimate expectations (para. 128). Nor did mere practice on the part of the EUIPO, no matter how current, amount to such information (para. 140). Furthermore, the applicant could not rely on previous decisions by EUIPO examiners, the BoA, or the EU judicature on colour mark registration to conclude that colour marks complied with Article 4 EUTMR (para. 141). Based on the foregoing, the action was dismissed.

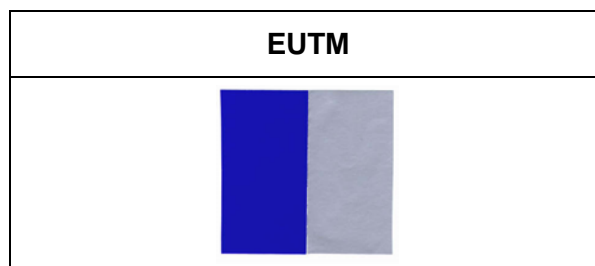
♦[T-798/16](#); **REAL**; *Hanso Holding AS v EUIPO*; Judgment of 30 November 2017; EU:T:2017:854; Language of the case: EN. The applicant sought to register the figurative mark **REAL** as an EUTM for goods in Classes 29, 30 and 31. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR, as it was found to be descriptive and devoid of distinctive character. The BoA dismissed the applicant's appeal against the examiner's decision. It found that the relevant public consisted of average consumers and professionals who paid a high level of attention, that the mark was descriptive and that it was also devoid of distinctive character, insofar as the applicant had not submitted the evidence necessary to assess whether the contested trade mark had acquired distinctive character by prior use. The applicant filed an action before the GC, relying on four pleas in law: (i) infringement of Article 7(1)(c) in conjunction with Article 7(2) EUTMR, (ii) infringement of Article 7(1)(b) in conjunction with Article 7(2) EUTMR, (iii) infringement of Article 7(3) EUTMR, and (iv) infringement of Article 107 EUTMR. **On the alleged infringement of the principles of equal treatment and sound administration:** the legality of the BoA decisions had to be assessed solely on the basis of the EUTMR as interpreted by the EU judicature and not on the basis of a previous Office decision-making practice (para. 58).



II. Absolute Grounds for Refusal/Invalidity

A. Article 7(1)(a), 52(1)(a) EUTMR — sign of which an EUTM may consist

♦[T-101/15](#) and [T-102/15](#) (joined cases); **Blue and Silver (col.)**; *Red Bull GmbH v EUIPO*; Judgment of 30 November 2017; EU:T:2017:852; Language of the case: EN.



The applicant sought to register two colour marks as EUTMs for goods in Class 32. Each colour mark's representation was a combination of two colours accompanied by a description [blue (RAL 5002) and silver (RAL 9006) juxtaposed in a ratio of 'approximately 50 %-50 %' in one case and 'the two colours ... applied in equal proportions and juxtaposed to each other' in the other case]. An application for invalidity was filed pursuant to Article 59(1)(a) EUTMR in conjunction with Article 7(1)(a), (b) and (d) EUTMR. The CD upheld the application for invalidity insofar as the contested marks constituted the mere juxtaposition of two or more colours, designated in the abstract and without contours, and did not exhibit the qualities of precision and uniformity required by Article 4 EUTMR. The applicant appealed against the CD's decision, but the BoA dismissed the appeals, finding infringement of Article 4 and Article 7(1)(a) EUTMR. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 4 and Article 7(1)(a) EUTMR and breach of the principles of proportionality and equal treatment, and (ii) breach of the principle of protection of legitimate expectations. The GC dismissed the appeal. **Graphic representation:** the GC confirmed the BoA statement that the graphic representation of the contested marks consisted of a mere juxtaposition of two colours without shape or contours, allowing several different combinations of the two colours. Moreover, the descriptions that accompanied the graphic representations did not provide any additional details with regard to a systematic arrangement associating the colours in a predetermined and uniform way and precluding a number of different combinations of those colours (paras 59-60). The GC referred to the judgment of 24/06/2004, C-49/02 *Blau/Gelb*, EU:C:2004:384. Application of the 'what you see is what you get' rule precisely required that the graphic representation, as filed and as visible ('what you see'), be the only subject matter of the protection afforded by the contested marks ('what you get') (para. 69). Therefore, a mere indication of the ratio of the two colours and the use of the word 'approximately' to refer to the percentages were not sufficient for finding that there was only one possible arrangement associating the colours in a predetermined and uniform way (paras 89-90). **Equal treatment:** colour marks differ from other types of mark, because of their intrinsically less precise nature (without contours or shape). Accordingly, the requirement that their subject matter be defined in appropriate detail does not constitute a breach of the principle of equal treatment (paras 85 and 96). Moreover, the requirement for a systematic arrangement follows directly from the wording of the paragraph of the EUIPO Guidelines regarding the graphic representation of a combination of colours (para. 101). **Principle of proportionality:** the GC stated that the principle of proportionality had not been breached. It was not disproportionate to require the combination



of colours to be represented graphically or be accompanied by a description (para. 119). **Principle of protection of legitimate expectations:** the GC confirmed the BoA statement that the applicant could not rely on the principle of legality. The examiner's suggestions for a description did not amount to precise, unconditional and consistent information that could give rise to legitimate expectations (para. 128). Nor did mere practice on the part of the EUIPO, no matter how current, amount to such information (para. 140). Furthermore, the applicant could not rely on previous decisions by EUIPO examiners, the BoA or the EU judicature on colour mark registration to conclude that colour marks complied with Article 4 EUTMR (para. 142). On the basis of the foregoing, the action was dismissed.

B. Article 7(1)(b), (c) and (d), 52(1)(a) EUTMR — non-distinctive, descriptive, customary

1. Non-distinctive (Article 7(1)(b) EUTMR)

♦[T-54/16](#); **NETGURU**; Judgment of 17 January 2017; *Netguru sp. z.o.o. v EUIPO*; EU:T:2017:9; Language of the case: PL. The examiner refused a request for registration as an EUTM of the word mark **NETGURU** for goods and services in Classes 9, 35, 37, 38, 41 and 42 pursuant to Articles 7(1)(b) and (c) EUTMR. The BoA confirmed the refusal pursuant to Article 7(1)(b) EUTMR. It found that, for the contested goods and services, the trade mark applied for would be understood by the target public in the sense of coming from an expert in computer networks, since the word 'guru' is a synonym for 'expert' and 'net' is an abbreviation for computer network. The EUTM applicant filed an action before the GC, claiming infringement of (i) Article 94 EUTMR in conjunction with Article 41(1) and Article 41(2)(c) of the Charter of Fundamental Rights of the European Union, (ii) infringement of Article 95(2) EUTMR, and (iii) infringement of Article 7(1)(b) and (c) EUTMR. With regard to the alleged infringement of Article 7(1)(b) EUTMR, the GC confirmed the definition of the mark in the contested decision and its laudatory character (paras 58, 59).

[T-96/16](#); **STRONG BONDS. TRUSTED SOLUTIONS.**; *Solenis Technologies LP v EUIPO*; Judgment of 24 January 2017; EU:T:2017:23; Language of the case: EN. The applicant sought to register the word mark **STRONG BONDS. TRUSTED SOLUTIONS.** as an EUTM for goods in Class 1. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) and Article 7(2) EUTMR, as it was found to be devoid of distinctive character. The BoA dismissed the applicant's appeal. It took the view that the EUTM application was an ordinary advertising message, devoid of any elements that might enable the relevant public to memorise it easily and immediately as a trade mark in respect of the goods in question. The BoA also held that the mark applied for was not distinctive, at least for the English-speaking part of the relevant public, within the meaning of Article 7(1)(b) EUTMR. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal. The GC endorsed the BoA's findings regarding the meaning of the words 'strong', 'bond', 'trusted' and 'solution', and the combinations of the elements 'strong' and 'bonds' and of 'trusted' and 'solutions', respectively (paras 22-24). The sign **STRONG BONDS. TRUSTED SOLUTIONS.**, taken as whole, would easily be understood by the relevant public as meaning that the applicant's goods provided solid adhesive strengths that constitute reliable answers to problems, or that those goods were trusted solutions (para. 28). The GC also rejected the applicant's argument that the relevant public would perceive the term 'bonds' in its figurative sense as referring to emotional ties or bonds of affection and would understand the mark applied for, as a whole,



as meaning ‘strong or resistant emotional ties and sincere and honest answers to problems’. Even if that meaning were to be accepted, the mark applied for would still be a banal slogan, the laudatory meaning of which would be clear and unequivocal. The applicant has not established otherwise (para. 33). Taken as a whole, the mark applied for would be understood by the relevant public as referring to goods that constitute trusted solutions, irrespective of whether all the goods marketed by the applicant and covered by the application for registration had strong adhesive properties or not (para. 34).

In view of the above, the BoA had correctly considered the EUTM application as being a laudatory promotional formula and therefore non-distinctive within the meaning of Article 7(1)(b) EUTMR (para. 35).

[T-104/16](#); **FOREVER FASTER**; *Puma SE v EUIPO*; Judgment of 9 March 2017; EU:T:2017:153; Language of the case: EN. The international registration (IR) holder designated the EU for the international registration of the word mark **FOREVER FASTER** for, inter alia, *footwear* in Class 25 and *games and playthings; gymnastics and sporting apparatus; gymnastics and sporting articles (included in this class); balls for games, golf balls; tennis rackets, cricket bats, golf clubs, hockey sticks, table tennis bats, badminton and squash rackets, table tennis and cricket bats, golf clubs and hockey sticks; roller skates, ice skates and in-line skates* in Class 28. The examiner refused registration pursuant to Article 7(1)(b) and (c) and Article 7(2) EUTMR. The BoA dismissed the appeal, confirming the refusal under Article 7(1)(b) EUTMR, as the mark would be perceived as a simple laudatory formula or information on the desired qualities of the goods. It did not rule on Article 7(1)(c) EUTMR. The international registration holder filed an action before the GC, pleading that the BoA had infringed Article 7(1)(b) EUTMR and breached the principles of equal treatment and sound administration. The GC dismissed the appeal, finding no error of assessment under Article 7(1)(b) EUTMR. The BoA assessment had been based on dictionary definitions, including meanings that were among those normally attributed to those words (para. 28). The international registration holder could not rely on the EUTM registration of the word mark ‘FOREVER’, as it had expired and had in any event been refused by a BoA decision for lack of distinctiveness (para. 29). The BoA had not erred in taking the view that the word ‘faster’ referred to an increase in speed, which described a desired characteristic of the goods (para. 30). A sign must be refused registration if at least one of its possible meanings lacks distinctiveness (para. 31). The mark applied for as a whole described a quality or characteristics of the goods. It sent out a clear message that was not unusual in the sporting sector, was a simple laudatory declaration or information on the desired characteristics of the goods, was frequently used in advertisements to motivate athletes and sportsmen and was per se not distinctive (paras 35 and 36). The intrinsic distinctiveness of a mark could not be assessed on the basis of an advertising campaign conducted after the filing date, which in any case did not support the use of the mark applied for as a trade mark. Registrations in other English-speaking countries were not binding (paras 47-49).

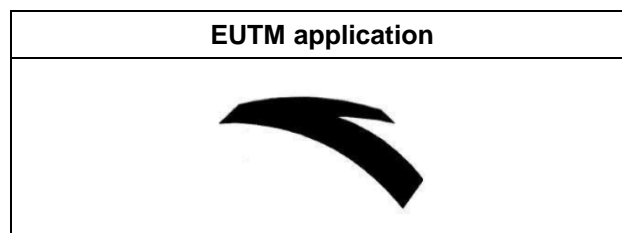
[T-21/16](#); **LIKE IT**; *Karl Conzelmann GmbH + Co. KG v EUIPO*; Order of 14 March 2017; EU:T:2017:187; Language of the case: DE. The EUTM applicant sought to register the word mark **LIKE IT** as an EUTM for goods in Classes 3, 18, 24 and 25. The examiner refused the application on the basis of lack of distinctive character for all the goods. The BoA dismissed the appeal. The EUTM applicant filed an application before the GC for the annulment of the BoA decision. The applicant admitted that the slogan might be perceived as meaning ‘you should like it! Buy it!’. The GC therefore confirmed the BoA findings that the slogan would be perceived as an incitement to like the goods (para. 28). The GC found that at least some of the relevant public would perceive the expression as a call to purchase the goods applied for due to its conjugation in the imperative, even despite the lack of an exclamation mark



(paras 30 and 31). A further meaning of the expression in the sense of ‘the same as it’ or ‘similar to it’ did not render the sign distinctive as a sign must be refused registration if at least one of its possible meanings lacks distinctiveness (paras 33-38). Previous EUTM registrations with the elements ‘like’ or ‘love it’ were not binding (paras 39-43).

[T-425/16](#); **Genius**; *Karl Hoffmann v EUIPO*; Judgment of 22 March 2017; EU:T:2017:199; Language of the case: DE. The applicant sought to register the word mark **Genius** as an EUTM for goods and services in Classes 9, 16, 25, 28, 35, 38, 41 and 42. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) EUTMR as it was found to be devoid of distinctive character due to its clearly laudatory meaning. The BoA dismissed the applicant’s appeal and confirmed the examiner’s reasoning. The applicant’s action before the GC, claiming infringement of Article 7(1)(b) EUTMR, was dismissed. The GC referred to the case-law on the ability of advertising slogans to be registered as EUTMs (para. 26 et seq.) and emphasised that a slogan that was perceived by the public only as such and not as an indication of commercial origin lacked distinctive character (para. 29). The examiner, in his first objection communicated to the applicant on 11 December 2014, referred to the definition of the word ‘genius’ as an adjective in the online Oxford dictionary. It was assumed that the meaning of this word had not changed between the filing date of the EUTM application, 28 November 2014, and the date of the examiner’s objections (paras 36 and 37). Furthermore, the applicant had erred in claiming that, as the mark applied for had a number of meanings, there was no clear link between it and the goods and services that it covered. For the goods and services at issue, the mark applied for would be perceived immediately by the relevant public as a promotional message and not as an indication of commercial origin; this was sufficient to preclude that mark from having distinctive character (para. 39 with reference to further case-law). Nor was the technological character of the goods and services applied for capable of calling into question the finding that even the relevant specialised public would perceive it merely as laudatory (para. 44).

[T-291/16](#); **DEVICE OF TWO LINES FORMING AN ACUTE ANGLE**; *Anta (China) Co. Ltd v EUIPO*; Judgment of 5 April 2017; EU:T:2017:253; Language of the case: EN.

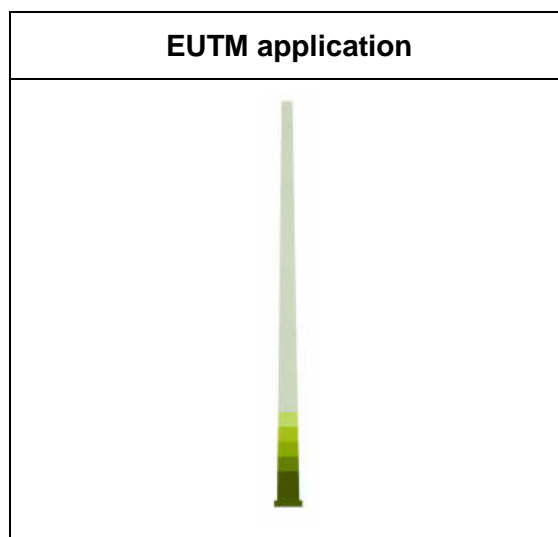


The applicant sought to register the figurative sign represented above as an EUTM. The goods in respect of which registration was sought consisted essentially of *leather, various leatherware and luggage goods* in Class 18; *clothing, footwear and clothing accessories* in Class 25; and *games, playthings and sporting articles* in Class 28. The EUTM application was refused by the examiner pursuant to Article 7(1)(b) EUTMR. The Office’s decision was confirmed by the Fifth BoA. The applicant lodged an action before the GC, alleging infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal. Firstly, the GC upheld the BoA’s findings concerning the relevant public. The GC held that the majority of the relevant public of the goods at issue were reasonably well informed and reasonably observant and circumspect, but no more than that. It could not be presumed that the majority of the relevant consumers would be particularly critical in their analysis of the goods concerned or would place importance on the reputation of brand images and labels in the market at issue (para. 26). Secondly, the GC stated that, although the EUTM application was



not a basic geometrical figure, it consisted of a representation of two intersecting lines whose simplicity was comparable to that of a basic geometrical figure and was incapable of conveying a message that would allow consumers to perceive the mark as an indication of the commercial origin of the relevant goods (paras 31-33). The mark had no element that was visually eye-catching or likely to be remembered by consumers (para. 36). This would be the case even if the public's attention was deemed to be higher than average, since the sign would likely be perceived as a mere decorative element. In particular, the sign at issue, used on clothing such as jackets or trousers, would be perceived as a simple combination of two lines that might bring to mind other combinations of lines used on clothing for aesthetic or ornamental purposes (paras 40-41). Furthermore, the examples put forward by the applicant in order to illustrate its claim that the relevant consumers, of in particular clothing and sporting equipment, were used to perceiving purely figurative simple signs, were marks for which it might be possible, if necessary, to claim distinctive character acquired through use (paras 42-43). In light of the above, the BoA had been correct to find that the EUTM application was devoid of distinctive character for the goods concerned and in the perception of the relevant public. As to the previous BoA decisions referred to by the applicant, the GC restated the case-law according to which the legality of the BoA's decisions must be assessed solely on the basis of the EUTMR, as interpreted by the EU courts, and not on the basis of previous decision-making practice (para. 46). The principle of equal treatment and sound administration must be consistent with respect for legality (para. 48). In the case at issue, the BoA had taken into account the decisions cited by the applicant, and its assessment could not be called into question merely because it was not consistent with the Office's earlier practice (paras 51-53). Regarding the applicant's reliance on earlier registrations in other countries, the GC restated that the EUTM regime was an autonomous legal system that applied independently of any national system (para. 56).

[T-36/16](#); **GREEN STRIPES ON A PIN (col.)**; *Enercon GmbH v EUIPO*; Judgment of 3 May 2017; EU:T:2017:295; Language of the case: EN.

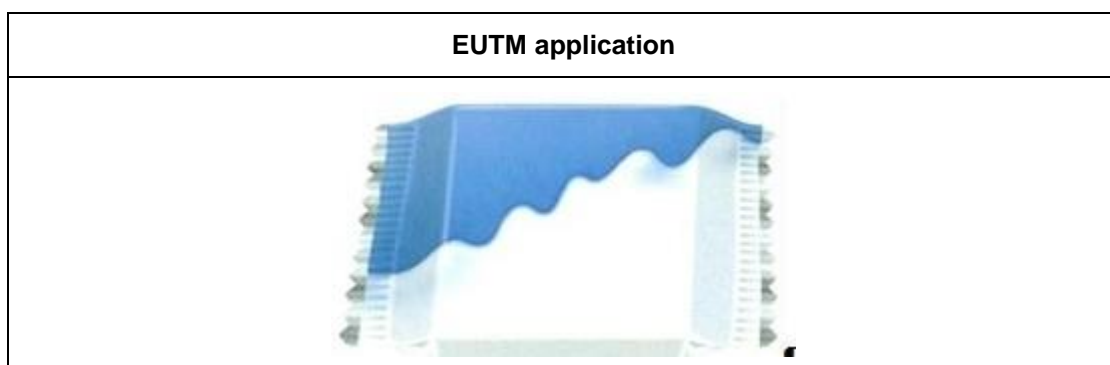


The applicant sought to register the colour mark represented above as an EUTM for goods in Class 7. An application for a declaration of invalidity was filed pursuant to Article 59(1)(a) and (b) EUTMR. The CD granted the application for a declaration of invalidity on the basis of Article 7(1)(b) EUTMR; with regard to the nature of the mark, it found that the mark defined the way in which the registered colours could be applied to a wind turbine tower. The BoA annulled the CD's decision. The invalidity applicant filed an action before the GC, alleging



infringement of (i) Article 7(1)(b) EUTMR, (ii) Article 62 EUTMR, and (iii) Article 59(1)(b) EUTMR. The GC annulled the BoA’s decision. It found that the BoA had based its decision on a mistaken perception of the nature and characteristics of the contested mark and had made an error of assessment in finding that the contested mark was not a colour mark, but rather a two-dimensional figurative mark made up of colours. The applicant filed an action before the CJ. The CJ dismissed the appeal as manifestly inadmissible. The case was remitted to the Second BoA, which confirmed the CD’s decision. The applicant filed an appeal, alleging infringement of Article 7(1)(b) EUTMR. The GC stated that the relevant public was composed of specialist business consumers with a heightened degree of attention (para. 35). The GC confirmed that the indication of the nature of the mark (as a colour mark) in the EUTM application was relevant when determining the subject matter of protection. ‘It follows that the distinctiveness of the contested mark had to be examined ... in the light of the category chosen by the applicant, without any possibility of re-categorising the mark’ (para. 37). The GC noted that the BoA had not erred in finding that the contested mark, which was composed of five shades of the colour green and of white, when applied to wind energy converters and parts thereof, conveyed exclusively an aesthetic message as a decorative element of those goods and therefore could not indicate their commercial origin. The GC also agreed that green, as the colour of nature, referred to the fact that the goods at issue were ecological or environmentally friendly (paras 45-46). Furthermore, as the GC had already held, the colour green, even in five different shades, would enable the contrast between vegetation and wind energy converters to be reduced. The presence of the colour white did not affect that conclusion in any way, given the neutrality of that colour. Additionally, the arrangement of the colours on the lower part of the shaft was also devoid of any distinctive character, and was only an aesthetic consideration to enable the goods to better blend in with their environment (judgment of 28/01/2015, T-655/13, Grün, EU:T:2015:49, para. 35) (paras 49-50). Finally, the GC emphasised that, as wind energy converters and parts therefor were high-value capital goods, the specialist consumers would neither identify nor purchase such equipment by reference to its decoration or external presentation, but would instead be guided by precise and accurate information on the origin of the goods (para. 51). In view of all the above, the GC dismissed the action.

[C-417/16 P](#); **DEVICE OF A SQUARE-SHAPED PACKAGING**; *August Storck KG v EUIPO*; Judgment of 4 May 2017; EU:C:2017:422; Language of the case: EN.



An application for an international registration designating the EU was filed for the figurative trade mark represented above for goods in Class 30. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) EUTMR. The BoA dismissed the appeal and confirmed the examiner’s decision. The applicant filed an action before the GC. The GC dismissed the action, upholding the BoA’s conclusion that the mark applied for did not differ significantly from the usual shape of the goods concerned and therefore could not fulfil its



function of identifying the origin of the goods. The applicant filed an appeal before the CJ on the basis of two grounds, each alleging infringement of Article 7(1)(b) EUTMR. The CJ dismissed the appeal in its entirety. First, the CJ pointed out that the case-law relating to three-dimensional trade marks consisting of the appearance of the product itself applied also where, as in the present case, the mark applied for was a figurative trade mark consisting of the two-dimensional representation of products. Therefore, the GC had not erred in law in applying the principle that only a mark that departed significantly from the standard or customs of the sector and thereby fulfilled its essential function of indicating origin was not devoid of any distinctive character (paras 35-38). Second, the presence of a graphic element in the figurative mark was not sufficient in itself to exclude application of that case-law. In this case, the different colours were commonplace, such that they would be perceived by the relevant public as presentational elements; the interpretation of the figurative element in question as a snow-covered mountain and a blue sky was not obvious for the relevant consumer; it was well known that such a pattern and a blue sky frequently appeared on the packaging of products such as the goods concerned; and the image affixed to the mark applied for and the grey edges of the packaging were not such as to confer distinctive character on the mark. Consequently, the GC had been right to find that the mark applied for was devoid of any distinctive character (paras 39-43). The CJ also dismissed the alleged errors of assessment in relation to the distinctive character of the graphic representation affixed to the mark applied for and the level of attention of the relevant public; both are appraisals of facts that did not constitute points of law open to review by the CJ on appeal (paras 44-52).

♦[T-285/16](#); **DREAMLINE**; *Dominator International GmbH v EUIPO*; Order of 15 May 2017; EU:T:2017:342; Language of the case: DE. The examiner refused the EU designation of the IR for the word mark **DREAMLINE** as descriptive and non-distinctive for goods in Class 12 (Article 7(1)(b) and (c) EUTMR). The BoA dismissed the appeal. It confirmed that **DREAMLINE** would be understood by the English-speaking public (namely in Ireland, Malta and the UK) and in Member States where English was understood (namely Denmark, Cyprus, the Netherlands, Portugal, Finland and Sweden) either as ‘perfect vessel’ or ‘range of products too good to be true’. It therefore described the quality of the goods (Article 7(1)(c) EUTMR). In addition, it would be perceived as a laudatory promotional statement. Therefore, the sign was also non-distinctive (Article 7(1)(b) EUTMR). The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 7(2) EUTMR, (ii) infringement of Article 7(1)(b) EUTMR, and (iii) infringement of Article 7(1)(c) EUTMR. The GC dismissed the appeal. The applicant’s first plea (infringement of Article 7(2) EUTMR) was ineffective and devoid of any legal basis. The applicant had not questioned the limitation of the targeted public to Member States in which English was an official language but only the knowledge of English in the other Member States (para. 29 and paras 35-36). There was no infringement of Article 7(1)(c) EUTMR either. The applicant had failed to explain how the BoA might have committed an error. Thus the third plea was manifestly inadmissible (paras 45-46). The second plea (Article 7(1)(b) EUTMR) was also dismissed. The applicant had pleaded that descriptiveness was separate from distinctiveness. However, the BoA had also based its decision on a separate examination of distinctiveness (paras 48-51). Moreover, a mark which is descriptive or lacks distinctive character cannot be registered (paras 57-59). The action was dismissed (para. 61).

♦[C-437/15 P](#); **deluxe**; *EUIPO v Deluxe Entertainment Services Group Inc.*; Order of 17 May 2017; EU:C:2017:380; Language of the case: ES.

EUTM application



The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 9, 35, 37, 39, 40, 41, 42 and 45. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR, on the grounds that it, first, was devoid of distinctive character and, second, informed consumers about the quality of the goods and services concerned. The applicant's appeal before the BoA was dismissed. The BoA held that in the parts of the EU where English was understood, the word 'deluxe' was not on its own capable of distinguishing the applicant's goods and services from those of its competitors since it was a commonplace promotional tag and merely consisted of a 'statement of superior quality'. It also found that the remaining elements were not capable of providing the mark with the minimum distinctive character and that the claimed acquired distinctiveness through use had not been proven. The applicant filed an application for annulment before the GC. The GC upheld the action. It held that the BoA had erred in law in adopting a general reasoning for all the goods and services, as they did not have a sufficiently direct and specific link to each other to form a homogenous category; nor had the BoA identified such a link. Therefore, the BoA had neither carried out the specific assessment required by Article 7(1)(b) EUTMR nor justified its decision for each of the goods and services. The Office filed an appeal before the CJ. The CJ annulled the GC decision and remitted the case to the GC for further assessment. The GC should, first, have verified whether the mark applied for could be perceived, directly and immediately, as a statement of superior quality or as a laudatory message by the relevant public instead of as an indication of the commercial origin of the designated goods and services. Second, the GC should also have verified whether the term 'deluxe' conveyed the concept of superior quality as a result of it being a direct reference to the concept of 'luxury'. In the event of it having a different meaning, the GC should have determined whether or not, in the light of that meaning, the goods and services covered by the mark constituted a homogenous group that justified a general reasoning (paras 38-39). The CJ found that the GC had ruled out generally the possibility that all the goods and services at issue could have a homogeneous character, without taking into account the particularities of the sign and its perception by the relevant public (para. 40). The GC had ignored the possibility that all of them, despite of their differences, could have a relevant characteristic in common that justified their being considered as a single homogenous group and the Board applying a general reasoning in relation to all of them (para. 41).

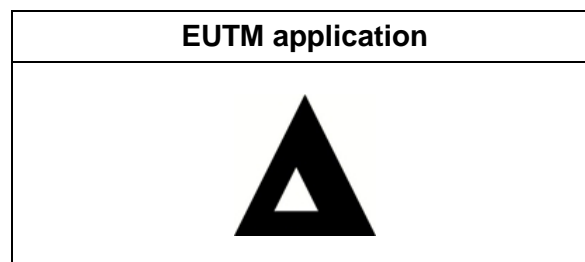


♦[T-580/15](#); **SHAPE OF A LIGHTER WITH THE WORD ELEMENT ‘CLIPPER’**; *Flamagas SA v EUIPO – MatMind Srl*; Judgment of 27 June 2017; EU:T:2017:433; Language of the case: EN.



The applicant’s contested EUTM had been applied for, and registered, as a three-dimensional mark without any further description and without any disclaimer. It depicted the shape of a lighter from five different perspectives. On one of these five representations, a small word element reading ‘CLIPPER’ could be seen, written in dark grey letters on a light grey background and occupying less than one tenth of the total surface of the lighter’s front. The CD rejected the other party’s invalidity request (Article 59(1)(a) EUTMR). On appeal, the BoA annulled the CD’s decision and declared the contested mark invalid on the basis of the absolute grounds of invalidity laid down in (i) Article 7(1)(e)(ii) (ii) Article 7(1)(b), and (iii) Article 7(1)(a) EUTMR. The BoA found essentially that (i) the contested shape fulfilled a technical function and was non-distinctive, and (ii) the word element played a marginal role in the contested mark as a whole. The GC dismissed the applicant’s appeal. With regard to Article 7(1)(b) EUTMR, the GC confirmed that the contested shape did not differ significantly from the norms or the customs of the sector (paras 74, 76-77) and that, for the same two reasons given in the context of Article 7(1)(e)(ii) EUTMR, the word element was marginal (paras 79-81).

♦[T-470/16](#); **DEVICE OF A TRIANGLE**; *X-cen-tek v EUIPO*; Judgment of 28 June 2017; EU:T:2017:442; Language of the case: DE.

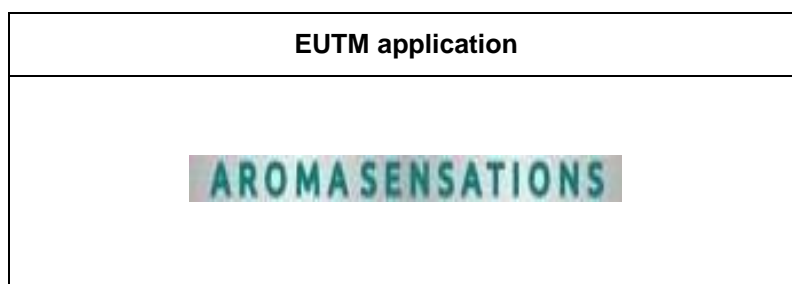


The applicant sought to register the figurative EUTM represented above for goods in Classes 5, 9 to 12, 18, 22, 25 and 26. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) EUTMR, as it was found to be devoid of distinctive character. The BoA dismissed the applicant’s appeal. The applicant filed an action before the GC, relying on two pleas in law: infringement of (i) Article 7(1)(b) EUTMR and (ii) Article 94(1) EUTMR. The GC dismissed the action. The contested sign consisted of **simple elements**, which were not distinctive. It did not contain any elements that attracted the consumer’s attention or enabled him or her to remember the sign as an indicator of origin (para. 28). The sole particularity lay in the fact that the triangle had a black frame with sides of unequal width



(para. 29). However, despite this irregularity, the frame remained essentially a triangle, which lacks distinctiveness pursuant to established case-law. No different result could derive from the use of a frame since the latter does not differ significantly from the normal shape defined by a line. The sign did not go beyond the sum of its non-distinctive elements. The presence of certain elements concerning the frame (e.g. different colours, the interior of the frame) could not change this outcome (paras 31-36). Moreover, an observer would generally not be surprised by irregularities in the representation of a triangle (para. 40). It followed that the sign, whether seen as a black triangular frame or as the combination of two triangles, did not have the minimum distinctive character required for registration (paras 43-44). The registration of the mark in Germany was not binding (paras 45-47). Although the applicant had not quoted Article 94(1) EUTMR, it was clear from its arguments that it claimed a lack of reasoning (para. 51). It claimed that the BoA had not given reasons why the different colours and sizes of the triangles were not sufficient for the sign to be perceived as an indication of origin. Even if this were true, it would not result in the annulment of the decision, since it followed from the decision that the sign lacked distinctive character (paras 52-56). The BoA had set out the factual findings and the legal considerations for the refusal in sufficient detail (para. 59).

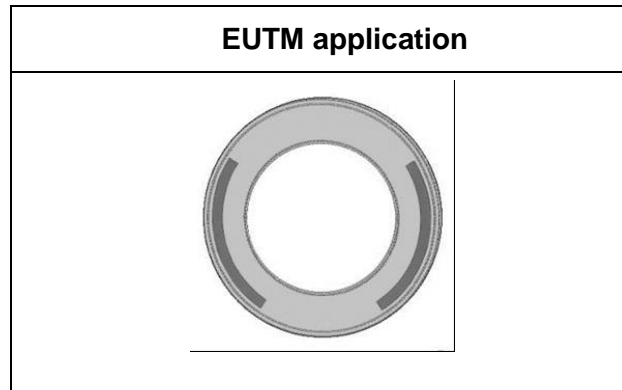
[T-479/16](#); **AROMASENSATIONS**; *Colgate-Palmolive Co. v EUIPO*; Judgment of 28 June 2017; EU:T:2017:441; Language of the case: EN.



The applicant sought to register the figurative mark represented above for goods in Class 3. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) EUTMR, as it was found to be devoid of distinctive character. The BoA dismissed the applicant's appeal. It found that the term **aromasensations** would be perceived as a laudatory promotional message, the function of which was to describe a characteristic of the goods. The applicant filed an action before the GC. The GC dismissed the action, referring to the standard case-law as regards the distinctive character of trade marks and slogans. The GC emphasised that it was sufficient if a mark was non-distinctive in even one of its several possible meanings. The BoA had correctly defined the meaning of aroma as 'distinctive, usually pleasant smell, especially of spices, wines and plants'. The GC confirmed that this characteristic was an important feature of the goods in Class 3. The term 'sensations' had also been correctly defined by the BoA, and the two words together would, in connection with the goods concerned, be perceived as 'experiences resulting from the stimulation of one of the sense organs [olfaction] by a certain [in principle] pleasant scent'. It was irrelevant that the combination might have other meanings as well. The graphical elements did not add anything unusual to the perception of the sign by the relevant public and could not divert the latter's attention from the purely laudatory and non-distinctive message. The combination of the two words, which were simply juxtaposed, did not add anything unusual or striking, given that it merely combined the meanings of the two words of which it was composed. The BoA had been correct to conclude that the sign lacked distinctive character for the relevant goods.



[♦T-81/16](#); **POSITION OF TWO CURVED STRIPS ON THE SIDE OF A TYRE**; *Pirelli Tyre SpA v EUIPO*; Judgment of 4 July 2017; EU:T:2017:463; Language of the case: EN.



An application for registration of the figurative mark represented above as an EUTM was filed for *tyres, solid, semi-pneumatic and pneumatic tyres, rims and covers for vehicle wheels* in Class 12. The application was for a position mark described as ‘a pair of essentially equal curved strips positioned on the side of a tyre and running along its circumference’. The examiner rejected the application on the ground that the mark applied for was devoid of distinctive character within the meaning of Article 7(1)(b) EUTMR. The First BoA dismissed the appeal against the examiner’s decision and confirmed that the mark applied for was caught by the prohibitions of Article 7(1)(b) EUTMR. The applicant filed an appeal before the GC, relying on three pleas in law: (i) infringement of Articles 94 and 95 EUTMR, (ii) infringement of Article 7(1)(b) EUTMR, and (iii) infringement of Article 7(3) EUTMR. The GC dismissed the appeal. **Infringement of Article 7(1)(b) EUTMR**: the GC confirmed the finding of the contested decision that the mark applied for was extremely simple and did not display any particular characteristics or any aspect easily and immediately perceived by the relevant public as indicating the commercial origin of the goods at issue. Consequently, consumers would perceive the contested sign as a mere decorative element affixed to the sidewall of tyres or any other goods covered by the application for registration. It followed that the BoA was correct in finding that the mark applied for was devoid of distinctive character (paras 56-58).

[T-623/15](#); **JEDE FLASCHE ZÄHLT!**; *Lidl Stiftung & Co. KG v EUIPO*; Judgment of 11 July 2017; EU:T:2017:480; Language of the case: DE.

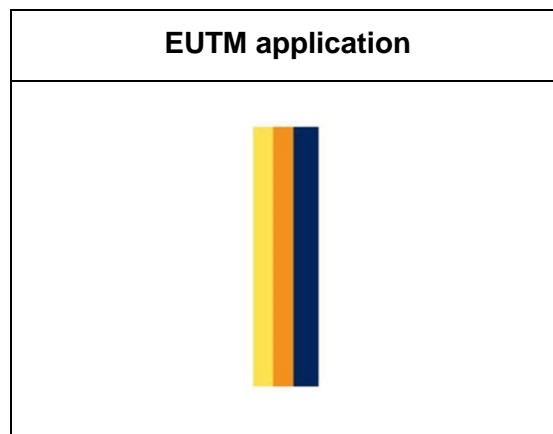


The applicant sought to register the figurative mark JEDE FLASCHE ZÄHLT! as an EUTM for goods and services in Classes 16, 21, 39 and 40. The examiner refused registration for the goods and services concerned because of lack of distinctiveness on the grounds of Article 7(1)(b) and Article 7(1)(2) EUTMR. The BoA dismissed the applicant’s appeal



because the mark was non-distinctive. The applicant filed an action before the GC, relying on an infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal. The mark was made up of three German words that could be clearly understood by the German-speaking public in the EU ('every bottle counts'). No further intellectual effort was needed to perceive the meaning (paras 30-31). The goods and services applied for were all related to bottles and recycling. For those goods and services, the mark would be directly understood as an invitation to recycle. The mark was a promotional slogan that gave the public a laudatory message regarding the purpose of the goods and services but not their commercial origin (paras 39-40). The GC dismissed the applicant's argument that the applied mark was actually complex and therefore distinctive. A more complex mark actually makes it more difficult for the consumer to remember a sign (para. 86). In line with previous case-law, the GC confirmed that the level of attention of the relevant public might be relatively low for promotional indications, irrespective of whether that public consisted of the general public or a more attentive public made up of specialists (para. 68). The colours and graphical representation of the verbal elements of the mark could not overcome the lack of distinctive character of the figurative mark applied for. The colour blue on a bottle referred to mineral water (para. 47). The colour green was associated with environmental protection and was used for goods and services that were less harmful to the environment (para. 48). The stylisation of the letters served to reinforce the verbal elements and was merely of decorative character (paras 50-52). The arrow represented a recycling circle (para. 45). Based on the foregoing, the action was dismissed.

♦[T-612/15](#); **DEVICE OF THREE VERTICAL STRIPES**; *Basic Net SpA v EUIPO*; Judgment of 20 July 2017; EU:T:2017:537; Language of the case: IT.



The applicant sought to register the figurative mark depicted above as an EUTM for goods in Classes 18, 25 and 26. The examiner rejected the application on the ground that the mark applied for was devoid of any distinctive character within the meaning of Article 7(1)(b) EUTMR. The BoA dismissed the appeal filed against the examiner's decision, confirming that the mark applied for was caught by the prohibitions of Article 7(1)(b) EUTMR. The applicant filed an appeal before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(b) EUTMR and (ii) infringement of Article 7(3) EUTMR. The GC dismissed the appeal. **Distinctiveness:** the GC confirmed the finding of the contested decision that the requested sign was not distinctive under Article 7(1)(b) EUTMR for all the goods in Classes 18, 25 and 26. In particular (paras 35-75), the figurative element represented by three vertical stripes was a simple geometrical shape, which was not capable of distinguishing the claimed goods. The claimed colours yellow, orange and blue could be considered basic colours. Furthermore, colours such as orange and yellow might have a functional role in making the



goods in question visible. The colours claimed were commonly used in the relevant market sectors; they would therefore be perceived by consumers of the goods in question as decorative elements that conveyed an aesthetic message. A systematic arrangement of the colours concerned in a predetermined and uniform way was not sufficient per se to allow registration of the sign as a trade mark. Contrary to what the applicant claimed, the BoA had carried out a complete analysis of the situation before refusing to register the sign as trade mark and had explained the reasons behind its refusal.

♦ [T-395/16](#); **WINDFINDER**; *Windfinder R & L GmbH & Co. KG v EUIPO*; Judgment of 20 July 2017; EU:T:2017:530; Language of the case: DE. The applicant sought to register the word mark **WINDFINDER** as an EUTM for goods and services in Classes 9, 35, 38, 41 and 42. The Office informed the applicant that registration of the EUTM application went against Article 7(1)(b) and (c) EUTMR. The applicant submitted its observations, and the examiner refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR for the abovementioned goods and services. The BoA dismissed the EUTM applicant's appeal, finding that the mark was descriptive and non-distinctive. The EUTM applicant filed an action before the GC, claiming: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) and (c) EUTMR and (iii) infringement of Article 7(3) EUTMR. It requested that the contested decision be annulled and the appeal before the BoA be allowed. The GC annulled the contested decision for all goods and services except 'anemometers' in Class 9 and services related to meteorology in Class 42. Insofar as it annulled the decision, it allowed the appeal. With regard to the alleged infringement of Article 7(1)(b) EUTMR, the GC found that the EUTM application was not descriptive pursuant to Article 7(1)(c) EUTMR. To this extent, it found no reason to conclude that it was devoid of distinctive character (para. 66).

♦ [T-374/15](#); **Vermögensmanufaktur**; *VM Vermögens-Management GmbH v EUIPO*; Judgment of 7 September 2017; EU:T:2017:589; Language of the case: DE. The EUTM proprietor was granted registration of the word mark **Vermögensmanufaktur**, which translates literally as 'asset manufacture', as an EUTM for the class headings in Classes 35 and 36. An application for invalidity was filed pursuant to Article 59(1)(a) in conjunction with Article 7(1)(b) and (c) EUTMR. The CD dismissed the application for invalidity. The BoA upheld the invalidity applicant's appeal and declared the EUTM invalid on account of its descriptive character and lack of distinctiveness. The EUTM proprietor filed an action before the GC, relying on four pleas in law, namely infringements of (i) Article 7(1)(b), (ii) Article 7(1)(c), (iii) Article 94 and (iv) Article 95 EUTMR. After filing the action, the EUTM proprietor declared under Article 33(8) EUTMR that its intention on the date of filing the EUTM had been to seek protection in respect of services beyond those covered by the literal meaning of the class headings of Classes 35 and 36. Accordingly, services from the alphabetical list were included in the EUTM's specification. With regard to these services, the EUTMR proprietor requested, in the alternative, that the GC declare the EUTM's registration to be partially maintained or remit the case to this extent to the CD. The GC dismissed the appeal. **Distinctiveness:** the EUTM lacked distinctive character pursuant to Article 7(1)(b) EUTMR for all class headings, that is including *advertising*; *office functions*, on account of its promotional character promising the service's efficiency in respect of financial profits (paras 103-115).

[T-421/16](#); **Beste Oma**; *sheepworld AG v EUIPO*; Judgment of 15 September 2017; EU:T:2017:615; Language of the case: DE. The applicant sought to register the word mark **Beste Oma** as an EUTM for goods in Classes 3, 9, 14, 16, 18, 20, 21, 24, 25, 28, 30 and 33. The examiner refused the application as non-distinctive based on Article 7(1)(b) EUTMR. The BoA confirmed the decision. It held that the trade mark consisted of a combination of



words that was grammatically correct and, for the relevant German-speaking public with an average level of attention, was directly understandable with the laudatory meaning of ‘Grandma is the best’. The sign merely conveyed the message that the goods were for ‘the best Grandma’, were suitable as gifts and would be understood by the recipient as an expression of gratitude or personal affection, but not as an indication of origin. The applicant filed an action before the GC, claiming infringement of Article 7(1)(b) EUTMR. The GC noted that the EUTM application consisted of a classic slogan that was grammatically correct and merely conveyed a laudatory message of personal affection. ‘Beste Oma’ was a banal slogan that the relevant public was familiar with in various contexts. Contrary to what the applicant claimed, it did not require several intellectual steps to understand the slogan as a laudatory message of personal affection. All the goods at issue were suitable as presents and were offered for sale in a way that allowed consumers to choose presents or goods specifically tailored to their individual family situation. Therefore, the connection between all the goods claimed and the laudatory slogan was sufficiently concrete to prevent the application from fulfilling its essential function as an indication of origin (para. 31). The banal character of the EUTM application was reinforced by numerous examples, particularly on the internet, of use of the slogan ‘Beste Oma’ on goods similar to those listed in the EUTM application’s specification, such as *coffee mugs, pillows, T-shirts*’ (para. 36). The BoA, which, in its examination of the distinctiveness of the EUTM application had rightly relied on ‘common knowledge’ for its finding that ‘Beste Oma’ and similar slogans were affixed to goods similar to those at issue, was not obliged to prove this well-known fact with concrete evidence from advertisement campaigns (para. 40). The EUTM application contained nothing other than a laudatory message relating to family, particularly to grandmothers. It did not contain any additional elements that would trigger an intellectual process and convey a minimum degree of distinctiveness alongside the laudatory message (paras 41-44). Finally, the BoA was not bound by previous decisions or former Office practice concerning allegedly similar registrations (paras 46, 47). Based on the foregoing, the action was dismissed.

[T-422/16](#); **Beste Mama**; *sheepworld AG v EUIPO*; Judgment of 15 September 2017; EU:T:2017:606; Language of the case: DE. The applicant sought to register the word mark **Beste Mama** as an EUTM for goods in Classes 3, 9, 14, 16, 18, 20, 21, 24, 25, 28, 30 and 33. The examiner refused the application as non-distinctive based on Article 7(1)(b) EUTMR. The BoA confirmed the decision. It held that the trade mark consisted of a combination of words that was grammatically correct and, for the relevant German-speaking public with an average level of attention, directly understandable with the laudatory meaning of ‘Mummy is the best’. The sign merely conveyed the message that the goods were for ‘the best Mummy’, were suitable as gifts and would be understood by the recipient as an expression of gratitude or personal affection, but not as an indication of origin. The applicant filed an action before the GC, claiming infringement of Article 7(1)(b) EUTMR. The GC noted that the EUTM application consisted of a classic slogan that was grammatically correct and merely conveyed a laudatory message of personal affection. ‘Beste Mama’ was a banal slogan that the relevant public was familiar with in various contexts. Contrary to what the applicant claimed, it did not take several intellectual steps to understand the slogan as a laudatory message of personal affection. All the goods at issue were suitable as presents and were offered for sale in a way that allowed consumers to choose presents or goods specifically tailored to their individual family situation. Therefore, the connection between all the goods claimed and the laudatory slogan was sufficiently concrete to prevent the application from fulfilling its essential function as an indication of origin (para. 31). The banal character of the EUTM application was reinforced by numerous examples, particularly on the internet, of use of the slogan ‘Beste Mama’ on goods similar to those listed in the EUTM application’s specification, such as *coffee mugs, pillows, T-shirts*’ (para. 36). The BoA, which, in its examination of the distinctiveness of the EUTM application had rightly relied on ‘common



knowledge’ for its finding that ‘Beste Mama’ and similar slogans were affixed to goods similar to those at issue, was not obliged to prove this well-known fact with concrete evidence from advertisement campaigns (para. 40). The EUTM application contained nothing other than a laudatory message relating to family, particularly to mothers. It did not contain any additional elements that would trigger an intellectual process and convey a minimum degree of distinctiveness alongside the laudatory message (paras 41-44). Finally, the BoA was not bound by previous decisions or former Office practice concerning allegedly similar registrations (paras 46-47). Based on the foregoing, the action was dismissed.

[T-449/16](#); **Bester Opa**; *sheepworld AG v EUIPO*; Judgment of 15 September 2017; EU:T:2017:610; Language of the case: DE. The applicant sought to register the word mark **Bester Opa** as an EUTM for goods in Classes 3, 9, 14, 16, 18, 20, 21, 24, 25, 28, 30 and 33. The examiner refused the application as non-distinctive based on Article 7(1)(b) EUTMR. The BoA confirmed the decision. It held that the trade mark consisted of a combination of words that was grammatically correct and, for the relevant German-speaking public with an average level of attention, directly understandable with the laudatory meaning of ‘Grandpa is the best’. The sign merely conveyed the message that the goods were for ‘the best Grandpa’, were suitable as gifts and would be understood by the recipient as an expression of gratitude or personal affection, but not as an indication or origin. The applicant filed an action before the GC, claiming infringement of Article 7(1)(b) EUTMR. The GC noted that the EUTM application consisted of a classic slogan that was grammatically correct and merely conveyed a laudatory message of personal affection. ‘Bester Opa’ was a banal slogan that the relevant public was familiar with in various contexts. Contrary to what the applicant claimed, it did not take several intellectual steps to understand the slogan as a laudatory message of personal affection. All the goods at issue were suitable as presents and were offered for sale in a way that allowed consumers to choose presents or goods specifically tailored to their individual family situation. Therefore, the connection between all the goods claimed and the laudatory slogan was sufficiently concrete to prevent the application from fulfilling its essential function as an indication of origin (para. 31). The banal character of the EUTM application was reinforced by numerous examples, particularly on the internet, of use of the slogan ‘Bester Opa’ on goods similar to those listed in the EUTM application’s specification, such as *coffee mugs, pillows, T-shirts* (para. 36). The BoA, which in its examination of the distinctiveness of the EUTM application had rightly relied on ‘common knowledge’ for its finding that ‘Bester Opa’ and similar slogans were affixed to goods similar to those at issue, was not obliged to prove this well-known fact with concrete evidence from advertisement campaigns (para. 40). The EUTM application contained nothing other than a laudatory message relating to family, particularly to grandfathers. It did not contain any additional elements that would trigger an intellectual process and convey a minimum degree of distinctiveness alongside the laudatory message (paras 41-44). Finally, the BoA was not bound by previous decisions or former Office practice concerning allegedly similar registrations (paras 46, 47). Based on the foregoing, the action was dismissed.

[T-450/16](#); **Beste Freunde**; *sheepworld AG v EUIPO*; Judgment of 15 September 2017; EU:T:2017:609; Language of the case: DE. The applicant sought to register the word mark **Beste Freunde** as an EUTM for goods in Classes 3, 9, 14, 18, 20, 21, 25 and 33. The examiner refused the application as non-distinctive based on Article 7(1)(b) EUTMR. The BoA confirmed the decision. It held that the trade mark consisted of a combination of words that was grammatically correct and, for the relevant German-speaking public with an average level of attention, directly understandable with a laudatory meaning concerning close friends. The sign merely conveyed the message that the goods were for ‘best friends’, were suitable as gifts and would be understood by the recipient as an expression of gratitude or personal affection, but not as an indication or origin. The applicant filed an action before the GC,



claiming infringement of Article 7(1)(b) EUTMR. The GC noted that the EUTM application consisted of a classic slogan that was grammatically correct and merely conveyed a laudatory message of personal affection. ‘Beste Freunde’ was a banal slogan that the relevant public was familiar with in various contexts. Contrary to what the applicant claimed, it did not take several intellectual steps to understand the slogan as a laudatory message of personal affection. All the goods at issue were suitable as presents and were offered for sale in a way that allowed consumers to choose presents or goods specifically tailored to their individual situation. Therefore, the connection between all the goods claimed and the laudatory slogan was sufficiently concrete to prevent the application from fulfilling its essential function as an indication of origin (para. 31). The banal character of the EUTM application was reinforced by numerous examples, particularly on the internet, of use of the slogan ‘Beste Freunde’ on goods similar to those listed in the EUTM application’s specification, such as *coffee mugs, pillows, T-shirts* (para. 36). The BoA, which, in its examination of the distinctiveness of the EUTM application, had rightly relied on ‘common knowledge’ for its finding that ‘Beste Freunde’ and similar slogans were affixed to goods similar to those at issue, was not obliged to prove this well-known fact with concrete evidence from advertisement campaigns (para. 40). The EUTM application contained nothing other than a laudatory message about friendship. It did not contain any additional elements that would trigger an intellectual process and convey a minimum degree of distinctiveness alongside the laudatory message (paras 41-44). Finally, the BoA was not bound by previous decisions or former Office practice concerning allegedly similar registrations (paras 46, 47). Based on the foregoing, the action was dismissed.

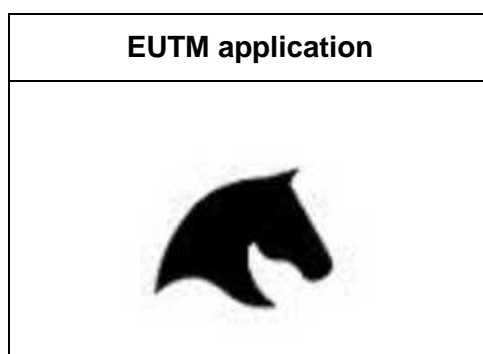
[T-451/16](#); **Bester Papa**; *sheepworld AG v EUIPO*; Judgment of 15 September 2017; EU:T:2017:608; Language of the case: DE. The applicant sought to register the word mark **Bester Papa** as an EUTM for goods in Classes 3, 9, 14, 16, 18, 20, 21, 24, 25, 28, 30 and 33. The examiner refused the application as non-distinctive based on Article 7(1)(b) EUTMR. The BoA confirmed the decision. It held that the trade mark consisted of a combination of words that was grammatically correct and, for the relevant German-speaking public with an average level of attention, directly understandable with the laudatory meaning of ‘Daddy is the best’. The sign merely conveyed the message that the goods were for ‘the best Daddy’, were suitable as gifts and would be understood by the recipient as an expression of gratitude or personal affection, but not as an indication of origin. The applicant filed an action before the GC, claiming infringement of Article 7(1)(b) EUTMR. The GC noted that the EUTM application consisted of a classic slogan that was grammatically correct and merely conveyed a laudatory message of personal affection. ‘Bester Papa’ was a banal slogan that the relevant public was familiar with in various contexts. Contrary to what the applicant claimed, it did not take several intellectual steps to understand the slogan as a laudatory message of personal affection. All the goods at issue were suitable as presents and were offered for sale in a way that allowed consumers to choose presents or goods specifically tailored to their individual family situation. Therefore, the connection between all the goods claimed and the laudatory slogan was sufficiently concrete to prevent the application from fulfilling its essential function as an indication of origin (para. 31). The banal character of the EUTM application was reinforced by numerous examples, particularly on the internet, of use of the slogan ‘Bester Papa’ on goods similar to those listed in the EUTM application’s specification, such as *coffee mugs, pillows, T-shirts* (para. 36). The BoA, which, in its examination of the distinctiveness of the EUTM application, had rightly relied on ‘common knowledge’ for its finding that ‘Bester Papa’ and similar slogans were affixed to goods similar to those at issue, was not obliged to prove this well-known fact with concrete evidence from advertisement campaigns (para. 40). The EUTM application contained nothing other than a laudatory message relating to family, particularly to fathers. It did not contain any additional elements that would trigger an intellectual process and convey a minimum degree of



distinctiveness alongside the laudatory message (paras 41-44). Finally, the BoA was not bound by previous decisions or former Office practice concerning allegedly similar registrations (paras 46, 47). Based on the foregoing, the action was dismissed.

T-452/16; Beste Freundin; sheepworld AG v EUIPO; Judgment of 15 September 2017; EU:T:2017:614; Language of the case: DE. The applicant sought to register the word mark **Beste Freundin** as an EUTM for goods in Classes 3, 9, 14, 16, 18, 20, 21, 24, 25, 28, 30 and 33. The examiner refused the application as non-distinctive based on Article 7(1)(b) EUTMR. The BoA confirmed the decision. It held that the trade mark consisted of a combination of words that was grammatically correct and, for the relevant German-speaking public with an average level of attention, directly understandable with a laudatory meaning concerning one's 'best girlfriend'. The sign merely conveyed the message that the goods were for 'the best girlfriend', were suitable as gifts and would be understood by the recipient as an expression of gratitude or personal affection, but not as indication of origin. The applicant filed an action before the GC, claiming infringement of Article 7(1)(b) EUTMR. The GC noted that the EUTM application consisted of a classic slogan that was grammatically correct and merely conveyed a laudatory message of personal affection. 'Beste Freundin' was a banal slogan that the relevant public was familiar with in various contexts. Contrary to what the applicant claimed, it did not take several intellectual steps to understand the slogan as a laudatory message of personal affection. All the goods at issue were suitable as presents and were offered for sale in a way that allowed consumers to choose presents or goods specifically tailored to their individual situation. Therefore, the connection between all the goods claimed and the laudatory slogan was sufficiently concrete to prevent the application from fulfilling its essential function as an indication of origin (para. 31). The banal character of the EUTM application was reinforced by numerous examples, particularly on the internet, of use of the slogan 'Beste Freundin' on goods similar to those listed in the EUTM application's specification, such as *coffee mugs, pillows, T-shirts*' (para. 36). The BoA, which, in its examination of the distinctiveness of the EUTM application, had rightly relied on 'common knowledge' for its finding that 'Beste Freundin' and similar slogans were affixed to goods similar to those at issue, was not obliged to prove this well-known fact with concrete evidence from advertisement campaigns (para. 40). The EUTM application contained nothing other than a laudatory message about friendship. It did not contain any additional elements that would trigger an intellectual process and convey a minimum degree of distinctiveness alongside with the laudatory message (paras 41-44). Finally, the BoA was not bound by previous decisions or former Office practice concerning allegedly similar registrations (paras 46, 47). Based on the foregoing, the action was dismissed.

T-717/16; PFERDEKOPF; Waldhausen GmbH & Co. KG v EUIPO; Judgment of 26 September 2017; EU:T:2017:667; Language of the case: DE.





The applicant sought to register the figurative mark represented above as an EUTM for goods in Classes 9, 18, 25 and 28. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) EUTMR, as it was found to be devoid of distinctive character. The BoA dismissed the applicant's appeal. It found that the EUTM application showed a true-to-life silhouette of a horse's head without any peculiarities. The goods were related to keeping or riding horses. For the public in question, which include people who kept or rode horses, the EUTM application lacked distinctive character. The applicant filed an action before the GC, relying on an infringement of Article 7(1)(b) EUTMR. The GC dismissed the action. Even if some of the relevant goods were sold in specialised equestrian shops, the relevant public's attention was not necessarily high. Goods such as clothing and accessories varied in quality and price. Sports glasses and bags could be purchased without specific knowledge and by the general public. Furthermore, the section of the public that might pay less attention was not inconsiderable. In any event, a figurative mark could lack distinctive character even for a highly attentive public (paras 25-31). The relevant public might be accustomed to animal representations being used on specific parts of goods to indicate a specific commercial origin. However, distinctive character under Article 7(1)(b) EUTMR could not be dependent on a particular marketing method; this was therefore irrelevant for assessment purposes (paras 38-43). None of the silhouette's features gave an impression that was sufficiently far removed from the simple representation of a horse's head. Furthermore, in respect of accessories for animals, such as leather goods or bags, true-to-life or stylised images of animals regularly indicated the species in question. Therefore, the EUTM application would be perceived as a general indication for horses, the area in which the goods were to be used, and thus lacked distinctive character (paras 48-53).

[T-755/16](#); **Take your time Pay After**; *Alessandro La Rocca v EUIPO*; Judgment of 26 September 2017; EU:T:2017:663; Language of the case: IT



The applicant sought to register the figurative mark **TAKE YOUR TIME PAY AFTER**, represented above, as an EUTM for goods and services in Class 36. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) and Article 7(2) EUTMR, as it found the mark to be devoid of distinctive character. The BoA dismissed the applicant's appeal. It found that the sign was a banal expression deprived of distinctive elements. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(b) EUTMR and (ii) infringement of Article 94 EUMTR. The GC emphasised that the English-speaking consumer would understand the expression 'TAKE YOUR TIME' as a suggestion not to be hasty, and the expression 'PAY AFTER' as an indication that it was possible to pay something later (para. 27). The sign would be understood as a purely promotional message (para. 28), and the graphical elements were not capable of providing it



with distinctive character (para. 29). The first plea based on the infringement of Article 7(1)(b) EUMTR was rejected (para. 33). As regards the second plea, the BoA had considered the designated services homogenous as they all belonged to the general category of financial, monetary, insurance and real estate services (para. 44). Therefore, the general reasoning given by the BoA for all the services as a homogenous group was in compliance with the duty to state reasons (para. 45). As regards the services that, according to the applicant, were not of the same nature as the others, the GC pointed out that they were all remunerated services and that, for them too, the relevant public would understand the sign merely as a promotional and exhortative message (para. 46). The GC also rejected the second plea of law (para. 48).

T-126/16; SPÜRBAR ANDERS; *1. FC Köln GmbH & Co. KGaA v EUIPO*; Judgment of 4 October 2017; EU:T:2017:688; Language of the case: DE. The applicant sought to register the word mark SPÜRBAR ANDERS as an EUTM for goods and services in Classes 16, 25 and 41. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) EUTMR, as it was found to be devoid of distinctive character. The BoA dismissed the applicant’s appeal. It found that the German word sequence (which could be translated into English as ‘noticeably different’) was banal and devoid of distinctive character. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal. It found that the word sequence would be understood in the sense of ‘deutlich verschieden’ (‘noticeably different’ or ‘deviating from the norm’). In respect of the goods and services at issue, this meant that the goods were not the same as those of competitors, but ‘noticeably different’, that is to say of better quality (para. 30). The sign applied for could not serve as an identifier of trade origin. It contained a clear and precise promotional message (para. 54). The situation in the judgment of 21/01/2010, C-398/08 P, *Vorsprung durch Technik*, EU:C:2010:29 was not comparable as the applicant in the latter case had relied on arguments such as reputation and many years of use (para. 57).

T-857/16; SHAPE OF A TALL GLASS; *Erdinger Weißbräu Werner Brombach GmbH & Co. KG v EUIPO*; Judgment of 26 October 2017; EU:T:2017:754; Language of the case: DE.



The applicant sought to register the 3D mark represented above as an EUTM for, inter alia, goods in Class 21, namely *glassware, porcelain and earthenware, so far as included in Class 21; unworked or semi-worked glass (except glass used in buildings); household or kitchen utensils and containers (not of metal or coated therewith)*. The Office refused registration pursuant to Article 7(1)(b) EUTMR on the grounds of lack of distinctive character. The BoA dismissed the applicant’s appeal. It held that it was common for drinking glasses to have more or less fanciful decorations, including, as shown by the examiner’s internet search results, shapes resembling footballs. The appearance of the mark applied for did not depart



significantly from the norms and customs of the relevant sector. Therefore, it was devoid of distinctive character under Article 7(1)(b) EUTMR. The applicant filed an action before the GC, relying on a single plea in law, namely infringement of Article 7(1)(b) EUTMR. The relevant glassware goods were ordinary consumer goods directed at the public at large (para. 27). The examples of glasses referred to by the BoA were cylindrical, with a narrower part in the middle and more rounded upper part. They were often decorated, including patterns resembling footballs. The EUTM application appeared to be merely a variant of such common shapes (paras 31-41). Even if the public would associate the drinking glass in question with a trophy, it was not apparent that it would infer any commercial origin from this (para. 42).

[T-31/16](#); **JUWEL**; *adp Gauselmann GmbH v EUIPO*; Judgment of 28 November 2017; EU:T:2017:845; Language of the case: DE. The applicant sought to register the word mark **JUWEL** for goods and services in Classes 9, 28 and 41. The examiner refused to register the word mark as an EUTM on the grounds of Article 7(1)(b) and (c) EUTMR. The EUTM applicant appealed against the Office's decision. The BoA dismissed the applicant's appeal because the mark was non-distinctive for all the goods concerned and descriptive for the goods related to games. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(b) EUTMR and (ii) infringement of Article 7(1)(c) EUTMR. **Relevant consumer**: since the mark was made up of German words, the relevant public was mainly the German-speaking general public and professionals with a high level of attention (paras 10 and 21). **Meaning of the sign**: according to the dictionary, 'JUWEL' could have two meanings in German: 'precious gemstone' and 'object of particular value to someone' (para. 26). The word mark indicated that the goods and services concerned were of value. **Distinctiveness**: the mark had been refused not because of its direct descriptiveness but because of its lack of distinctiveness (para. 33); both grounds were independent of each other. The public would perceive the word mark as a direct indication of the quality of the goods and services and not as an indication of commercial origin (paras 30 and 33). Without being precise about it, the sign indicated that the goods were precious. Semantically, therefore, it referred to the goods' value (para. 39). Since one ground for refusal is sufficient, there was no need to examine Article 7(1)(c) EUTMR (paras 52-55).

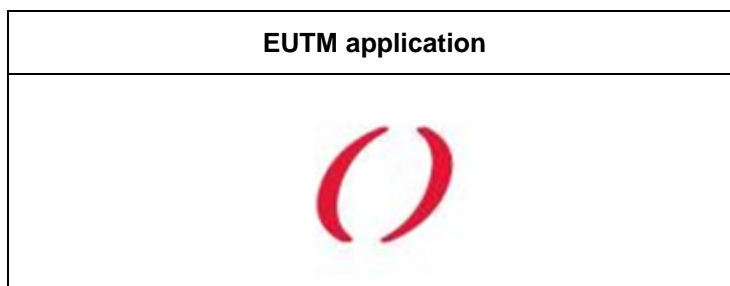
[T-50/17](#); **TO CREATE REALITY**; *Mackevision Medien Design GmbH Stuttgart v EUIPO*; Judgment of 30 November 2017; EU:T:2017:855; Language of the case: DE. The applicant sought to register the word mark TO CREATE REALITY for goods and services in Classes 9, 41 and 42. The examiner refused registration because the mark lacked distinctiveness and was descriptive on the grounds of Article 7(1)(b) and (c) EUTMR. The BoA dismissed the applicant's appeal because the mark was not distinctive. The applicant filed an action before the GC, relying on an infringement of Article 7(1)(b) EUTMR. **Relevant consumer**: since the mark was made up of English words, the relevant public consisted of consumers in the English-speaking Member States, namely Ireland, Malta and the United Kingdom. The goods in Class 9 were directed at both the general public and professionals, the services in Classes 40 and 41 mainly at professionals (para. 18). **Meaning of the sign**: the sign was made up of three English words which could be clearly understood by the English-speaking public without any intellectual effort (paras 31, 32 and 48). For the goods and services related to digital media and entertainment, it would be understood as a direct reference to virtual reality. The goods and services allowed consumers to process and improve digital media (paras 31-35). The mark was a promotional slogan that conveyed to the public a laudatory message regarding the goods and services but was not appropriate for identifying their commercial origin (paras 39, 40 and 48). **Scope of the sign**: the interpretation of the mark was logical for the goods and services concerned, which were all related to multimedia entertainment (paras 45 and 46).



[T-622/16](#); **ALLES WIRD GUT**; *Sheepworld AG v EUIPO*; Judgment of 7 December 2017; EU:T:2017:878; Language of the case: DE. The applicant sought to register the word mark **Alles wird gut** as an EUTM for goods in Classes 3, 9, 14, 16, 18, 20, 21, 24, 25, 28 and 33. The examiner refused the registration of the EUTM application pursuant to Article 7(1)(b) EUTMR, as it was found to be devoid of distinctive character. The BoA dismissed the applicant’s appeal. It found that the EUTM application would not be perceived by the relevant public as an indication of the commercial origin of the goods in question. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal. ‘Alles wird gut’ was a German expression meaning ‘Everything will be fine’, used in everyday language to express, in particular, affection or consolation in the face of certain life events. The German-speaking public would understand this phrase only in the sense that, by buying or using the goods covered by the EUTM application, including those given as gifts, ‘everything will be fine’; it would therefore be perceived as a reassuring message, creating a positive feeling (para. 34). No interpretation or intellectual associations would be required of consumers in order for them to understand the phrase as a laudatory expression that encourages the purchase or use of the goods and highlights their attractiveness. Therefore, the EUTM application would not be understood as an indication of the commercial origin of the goods (para. 37). The BoA had correctly assessed how the EUTM application might be perceived in the future and was not required to establish that it was commonly used in advertisements (para. 44). Overall, the BoA had been right to find that the EUTM application was devoid of distinctive character (para. 49).

2. **Distinctive (Article 7(1)(b) EUTMR)**

♦ [T-130/16](#); **RAPPRES () INCLINATE DI COLORE ROSSO**; *Coesia SpA v EUIPO*; Judgment of 31 January 2017; EU:T:2017:44; Language of the case: IT.

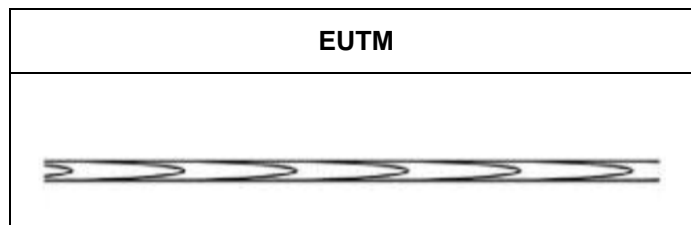


An application was filed for registration of the figurative mark represented above as an EUTM for a range of goods and services in Classes 7, 35, 37 and 42. The examiner rejected the application on the ground that the mark applied for was devoid of any distinctive character within the meaning of Article 7(1)(b) EUTMR. The Second BoA dismissed the appeal filed against the examiner’s decision, confirming that the mark applied for was caught by the prohibition of Article 7(1)(b) EUTMR. The applicant filed an action before the GC based on two pleas in law: (i) infringement of Article 7(1)(b) EUTMR and (ii) infringement of the duty to state reasons. The GC confirmed that the goods and services concerned mostly targeted professional consumers whose level of attention was higher than that of the general public (para. 16). The applicant claimed, in particular, that the BoA had totally failed to take into consideration the level of attention of the relevant public. In that regard, the GC held that the fact that the relevant public was a specialist one could not have a decisive influence on the legal criteria used to assess the distinctive character of a sign. Although the level of attention paid by the relevant specialist public was, by definition, higher than that of the average



consumer, it did not necessarily follow that a lower degree of distinctiveness was sufficient if the relevant public were specialists. Nor did it follow that the level of attention of the relevant public was not to be taken into consideration at all when assessing the distinctive character of a trade mark (paras 20-22). In the light of the foregoing, the GC noted that the BoA had never mentioned having considered the relevant public's high level of attention in and that this was inconsistent with the relevant case-law. The GC therefore found that the BoA had not applied Article 7(1)(b) EUTMR in accordance with one of the essential requirements arising from the case-law (paras 20-26). The applicant's first plea was therefore upheld, and the contested decision was annulled by the GC without any need to examine the second plea.

♦ [T-20/16](#); **DEVICE OF A REPEATED GEOMETRIC DESIGN**; *M/S. Indeutsch International v EUIPO*; Judgment of 21 June 2017; EU:T:2015:521; Language of the case: EN.



The EUTM proprietor was granted registration of the figurative mark represented above as an EUTM for *knitting needles and crochet hooks* in Class 26. An application for invalidity was filed pursuant to Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b) EUTMR. The CD dismissed the application for invalidity. The BoA upheld the invalidity applicant's appeal. It found that the mark was devoid of distinctive character. The EUTM proprietor filed an action before the GC. The GC upheld the action, annulling the contested decision. The EUTM proprietor submitted evidence of how the EUTM was used on the surface of the goods, showing multi-coloured chevrons on the surface of knitting needles and crochet hooks. The BoA used that evidence to support its finding that the mark was indissociable from the designated goods and that it lacked distinctiveness as it did not depart significantly from the norms in the trade. The GC held that the mark as registered had the characteristics of an abstract geometric shape composed of a repetitive design consisting of two parallel lines enclosing clearly delineated chevrons, all in black and white. It could not validly be maintained that the mark at issue would immediately and without further reflection be perceived as the representation of a detail or an aspect of the goods that it covered and even less that it consisted of the shape of the knitting needles and crochet hooks produced by the EUTM proprietor. The BoA had assessed the distinctive character of the mark at issue by referring, first, to the coloured outward appearance of the EUTM proprietor's goods, and, secondly, to the coloured surface of the crochet hooks shown in the evidence. To rely on the fact that a pattern in the form of multicoloured chevrons appeared on the surface of the EUTM proprietor's goods in order to examine distinctive character for the purpose of Article 7(1)(b) EUTMR, instead of basing that examination on the mark as registered, did not form part of a process of identifying the essential characteristics of that mark, but rather constituted a significant alteration of those characteristics. The fact that the EUTM proprietor itself had intended to apply the mark to the surface of the goods could not change that finding. Even if the EUTM proprietor's statement could be understood as implying that it did not oppose the BoA's considering the appearance of the goods when examining the distinctive character of the mark at issue, it was irrelevant in the case in question. The lawfulness of the contested decision was to be assessed in view only of the reasons supporting its operative part.



♦[T-327/16](#); **ANTICO CASALE**; *Aldi Einkauf GmbH & Co. OHG v EUIPO*; Judgment of 27 June 2017; EU:T:2017:439; Language of the case: EN. The EUTM proprietor was granted registration of the word mark **ANTICO CASALE** as an EUTM for goods and services in Classes 29, 30 and 35. An application for a declaration of invalidity was filed pursuant to Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b), (c) and (g) EUTMR. The CD rejected the application for invalidity. The BoA dismissed the cancellation applicant's appeal. It found that the mark was not directly descriptive but merely allusive, was not a mere laudatory statement about the quality of the goods and was not deceptive. The cancellation applicant filed an action before the GC, relying on three pleas in law, alleging infringement of Article 59(1)(a) EUTMR in conjunction with (i) Article 7(1)(b) EUTMR, (ii) Article 7(1)(c) EUTMR, and (iii) Article 7(1)(g) EUTMR. **Distinctiveness**: the applicant's argument that goods sold in an old farmhouse, or services provided from an old farmhouse, had a 'considerable reputation' compared with industrial goods was not backed up by any evidence. In invalidity proceedings, as the registered EUTM is presumed to be valid, it is for the applicant for a declaration of invalidity to provide the Office with the specific facts that call the validity of that trade mark into question. As for the assertion that the expression 'antico casale' would be perceived as a laudatory statement, given that it conveyed a certain refinement or exclusivity, it was sufficient to note that the fact that a mark might have a laudatory connotation did not necessarily deprive it of distinctive character.

♦[T-305/16](#); **LOVE TO LOUNGE**; *Lidl Stiftung & Co. KG v EUIPO*; Judgment of 15 September 2017; EU:T:2017:607; Language of the case: EN. An application for invalidity was filed pursuant to Article 59(1)(a) EUTMR in conjunction with Articles 7(1)(b) and (c) EUTMR. The CD dismissed the application for invalidity in its entirety. The applicant filed a notice of appeal against the CD's decision. The BoA dismissed the appeal. It found that the contested mark was not capable of describing the goods covered; therefore, the connection between the expression 'love to lounge' and the goods concerned was too indeterminate to constitute a ground for invalidity. Moreover, it found that the contested mark could not be regarded as being completely devoid of any distinctive character. The applicant filed an action before the GC, relying on four pleas in law: (i) infringement of Article 95 EUTMR, (ii) infringement of Article 94 EUTMR, (iii) infringement of Article 7(1)(c) EUTMR, and (iv) infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal. **Distinctiveness**: as regards the assessment of distinctive character, when the contested mark is used in relation to the contested goods, namely *clothing, footwear and headgear*, the relevant public will have to place that mark in a certain context, which requires an intellectual effort. Furthermore, the contested mark has inherent distinctive character due to a certain originality that can be remembered by consumers and that enables them to identify the commercial origin of the contested goods (paras 93-95).

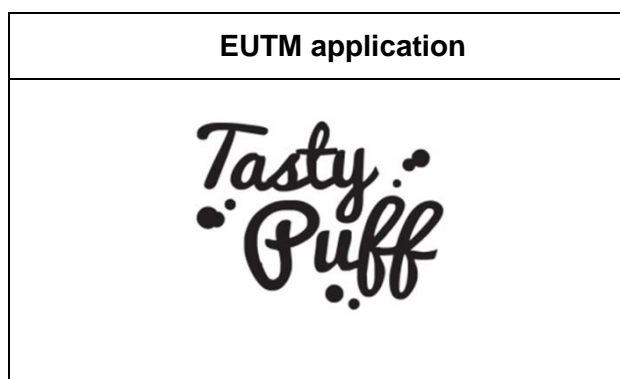
♦[T-280/16](#); **GEO**; *GeoClimaDesign v EUIPO*; Judgment of 14 December 2017; EU:T:2017:913; Language of the case: DE. The EUTM proprietor was granted registration of the word mark **GEO** as an EUTM for services in Classes 35, 37 and 42. An application for declaration of invalidity was filed pursuant to Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b), (c) and (d) EUTMR. The CD partly upheld the application for invalidity for some of the services in Classes 35, 37 and 42. The BoA upheld the EUTM proprietor's appeal. It found that the EUTM was not devoid of any distinctive character, was not descriptive for the designated services and had not become customary. The invalidity applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(b) EUTMR and (ii) infringement of Article 7(1)(c) EUTMR. The GC dismissed the action. **Distinctiveness**: the term 'GEO' did not have a laudatory meaning in common linguistic usage and would not be perceived immediately as a promotional statement praising the quality of a service (para. 61). It had not been demonstrated that this term was commonly



used in the sector of the services at issue, namely construction or project planning in the field of renewable energies, to designate the quality of those services (para. 62). Nor had it been demonstrated that ‘GEO’ was commonly used in connection with those services (para. 64). Therefore, the BoA had correctly found no clear link between ‘GEO’ and the services at issue that would prevent the relevant public from identifying the commercial origin of the services. This conclusion was valid for both professionals and average consumers (para. 66).

3. Descriptive (Article 7(1)(c) EUTMR)

[T-64/16](#); **Tasty Puff**; *Michał Wieromiejczyk v EUIPO*; Judgment of 18 January 2017; EU:T:2017:13; Language of the case: PL.



The EUTM applicant sought to register the figurative sign represented above as an EUTM for goods in Class 34. The examiner refused registration of the EUTM application pursuant to Articles 7(1)(b) and (c) and Article 7(2) EUTMR, as it was found to be descriptive and devoid of distinctive character. The BoA dismissed the applicant’s appeal. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(b) EUTMR and (ii) infringement of Article 7(1)(c) EUTMR. The GC dismissed the appeal. **As to Article 7(1)(c) EUTMR:** the GC confirmed the BoA finding that the average consumer in this case was either a native English speaker or a consumer who had studied English to a sufficiently high level (paras 18-19). On the applicant’s argument regarding the higher level of attentiveness of consumers with regard to goods in Class 34, the GC observed that such claim had to be proven and confirmed the BoA assessment that the level of attentiveness would be average (para. 18). The GC found that the figurative elements of the sign, that is the typeface and various dots placed around the verbal elements, would not divert the consumer’s attention from the verbal elements ‘tasty puff’, but rather only emphasise the descriptive message conveyed by the verbal elements, as both the undulating typeface and the dots could be associated with puffs of smoke. This was particularly relevant for goods in Class 34 (para. 25). It was therefore found that the figurative elements of the sign could not bestow distinctive character on the application (para. 26). The applicant argued that the expression ‘tasty puff’ did not have a direct meaning for the goods in question, as it was not commonly used in relation to these goods. Moreover, the applicant maintained that ‘puff’ was synonymous with ‘breath’. The GC observed that this was obviously incorrect as these two words did not have the same meaning (para. 28). The GC indicated that the expression ‘tasty puff’ could in general be understood by the native English speakers as referring to a salty or sweet filling, as in the expressions ‘jam puff’, ‘cream puff’ or ‘cheese puff’ (para. 29). However, considering that all the relevant goods in Class 34 had to do with tobacco or tobacco substitutes, the relevant public would perceive the sign in the context of smoking.



The GC confirmed the BoA's interpretation of the meaning of this expression, finding that it would be perceived as 'delicious smoke' or 'delicious smoking' (paras 32-34). As such, this expression was not merely allusive but had a direct, descriptive meaning in relation to the goods in question, as it referred to the pleasant taste of the goods or, in the case of articles used with tobacco, the ability of the latter to produce such a taste when the tobacco or a substitute therefor was inhaled (para. 35). The applicant also argued that, by refusing registration of the application, the BoA had infringed the principle of equal treatment and good administration, as the Office had previously accepted a similar trade mark with the expression 'tasty puff' for goods in Class 34. The GC observed that the principles of equal treatment and good administration had to be in line with the principle of legality. The examination of every application for registration had to be stringent and full in order to prevent trade marks from being improperly registered. Each individual case had to be examined. The registration of a sign as a trade mark depended on specific criteria, applicable according to the factual circumstances of the particular case and intended to ascertain whether the sign at issue was caught by a ground for refusal (para. 37). A potential mistake committed in other proceedings could not justify registration of a mark that infringed Article 7 EUTMR (para. 38). Since the application was to be refused on the basis of Article 7(1)(c) EUTMR, there was no need to examine Article 7(1)(b) EUTMR.

[T-119/16](#); **RHYTHMVIEW**; *Topera, Inc. v EUIPO*; Order of 26 January 2017; EU:T:2017:38; Language of the case: EN. The applicant sought to register the word RHYTHMVIEW as an EUTM for goods and services in Classes 9 and 10. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) and Article 7(2) EUTMR as it was found to be descriptive and devoid of distinctive character. The BoA dismissed the applicant's appeal. It considered the mark in relation to *medical software for identifying and visualising rotors and focal sources in cardiac atria* in Class 9 and *medical workstations; parts and fittings for medical workstations, all for identifying and visualising rotors and focal sources in cardiac atria* in Class 10. The BoA found that the relevant English-speaking public, composed only of medical professionals and, in particular, cardiology specialists, would perceive **RHYTHMVIEW** as consisting of the meaningful expression 'observing the regularity of recurring physiological functions or events of the body or a visual aspect of them or a pictorial representation of the same'. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR and (ii) infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal. The GC found that the meaning of the EUTM application for the relevant public was that of 'viewing' a rhythm (para. 23). The applicant's argument that **RHYTHMVIEW** had an unusual character, because rhythm was not something that could be seen, could not succeed. Rhythm was commonly represented visually, for example by the pendulum of a metronome or the flashing lights of audio systems (para. 25). As to the direct and specific relationship between the EUTM application and the goods, the GC found that the intended use or purpose of the goods at issue was apparent from their very description: 'identifying and visualising the rotors and focal sources of cardiac atria'. Although such rotors and focal sources did not themselves have any rhythm, it followed from the applicant's explanations that electrical signals in the heart enabled the visualisation of rotors as a 'consistent rotational activity around a centre' and of focal sources as 'concentric patterns'. The applicant's explanations, first, confirmed the direct and immediate relationship between the goods at issue and a heart rhythm and, second, made it possible to understand that rotors and focal sources fell within the definition of the English word 'rhythm', namely any sequence of regularly recurring functions or events, such as the regular recurrence of certain physiological functions of the body (para. 29). Finally, as the applicant itself stated that the goods at issue sensed, filtered and analysed signals emitted by rotors and focal sources and transformed them into graphical representations, which were thus mapped out, it essentially confirmed that the word 'view' in the mark applied for



precisely indicated that the goods at issue were for visualising the phenomena covered by the notion of ‘rhythm’ (para. 30). The GC therefore had to find that the relevant public, when encountering **RHYTHMVIEW**, would immediately, without further thought, believe that it designated goods that, by providing a visual representation of the electrical activity of the heart, made it possible to examine a heartbeat. Insofar as rotors and focal sources could be visualised as sequences of regularly recurring functions or events, the goods at issue would, for the relevant public, be associated with the rhythm to be viewed (para. 31).

[T-76/16](#); **AEGYPTISCHE ERDE**; *Ikos GmbH v EUIPO*; Order of 1 March 2017; EU:T:2017:140; Language of the case: DE. The applicant sought to register the word mark **AEGYPTISCHE ERDE** as an EUTM for goods in Class 3 (*make-up preparations, bronze powder, etc*). The examiner refused the application on the grounds of Article 7(1)(b) and (c) EUTMR. The BoA confirmed the examiner’s decision. It held that, for the relevant German end consumers with an average level of attention, the mark directly described that the goods were or consisted of Egyptian clay. The trade mark was also non-distinctive, as it consisted exclusively of a laudatory message, praising the qualities and special features of the goods in question. The applicant filed an action before the GC. It argued, that the BoA had infringed Article 7(1)(c) EUTMR by stating that the goods concerned contained clay from Egypt when, in fact, the goods were not necessarily of such origin. The GC stressed that the BoA decision, which fully confirmed the first instance decision, was to be read in conjunction with the examiner’s finding that ‘Aegyptische Erde’ was widely known by the relevant public as a cosmetic product made of clay, namely a bronze/terracotta powder, which has been used for millennia, inter alia by ancient Egyptian pharaohs. The applicant had misinterpreted the contested decision when it inferred that the BoA had found the indication to be descriptive of the geographical origin of the clay used in the goods concerned, rather than merely a reference to the nature and consistency of the goods (paras 29, 30). The connection between the EUTM application and the goods at issue was sufficiently direct and specific to allow the relevant public to immediately grasp the descriptive character of the mark (para. 33). Based on the foregoing, the action was dismissed as partially inadmissible and for the rest obviously unfounded.

[T-308/16](#); **ClaimsExcellence**; *Marsh GmbH v EUIPO*; Judgment of 9 March 2017; EU:T:2017:154; Language of the case: DE. The applicant sought to register the word sign **ClaimsExcellence** for insurance-related services in Class 36. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR, as it was found to be descriptive and therefore devoid of distinctive character, primarily for the English-speaking public within the EU. The BoA dismissed the applicant’s appeal. It found that the application was descriptive of the services applied for in either meaning, whether ‘(he/she) claims excellence’ or ‘Claims — Excellence’. The applicant filed an action before the GC, claiming that (i) the sign was not directly descriptive for the services applied for and that (ii) the Office had erroneously considered all the services to be *underwriting services*, whereas *insurance brokerage* and *consulting concerning insurance* were not covered by this general term. The GC dismissed the appeal. The GC agreed that **ClaimsExcellence** could be understood either as the short form of the sentence ‘he/she/Marsh claims excellence’ or as the joining of two buzzwords (paras 25-31). ‘Claims’ was a technical term in the relevant area of insurance services, as had also been shown by the extensive use made of that term by the applicant itself; it was therefore descriptive for the services applied for (para. 37). ‘Excellence’ described the quality of the services to be delivered (paras 38-40). The joining of these terms resulted in a descriptive combination (paras 41-43). It followed from Article 2(3) of Directive 2002/92/EC on insurance mediation that *insurance brokerage* as well as *consulting concerning insurance* were encompassed by *insurance mediation*. This meant that the link



with claims dealt with by insurance companies was sufficiently close that the BoA's global reasoning correctly covered all the services (paras 44-47).

[T-400/16](#); **MAXPLAY**; *Maximum Play, Inc. v EUIPO*; Judgment of 9 March 2017; EU:T:2017:152; Language of the case: EN. The applicant sought to register the word mark **MAXPLAY** as an EUTM for goods and services in Classes 9, 41 and 42. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR, as it was found to be descriptive and devoid of distinctive character. The BoA dismissed the applicant's appeal. It found that 'MAXPLAY' would be perceived immediately and intuitively as meaning 'maximum play' or 'best play'. The mark was therefore descriptive as a whole for the relevant goods and services. It further considered that the mark was devoid of any distinctive character. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR and (ii) infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal. It confirmed that the trade mark was descriptive and therefore non-distinctive. **Descriptiveness**: the GC applied the case-law on compound word signs and considered that the marks could be assessed in part on the basis of each of its elements but had to also be assessed as a whole. Contrary to the applicant's views, the BoA had not only assessed each of the elements but had also examined the overall impression created by the mark (paras 27-29). The GC confirmed the definitions of 'MAX' and 'PLAY' and the fact that the expression 'MAXPLAY' did not contain any unusual element in its syntax, with the result that it was nothing other than the mere combination of the words 'MAX' and 'PLAY' (paras 32-34). Taking into account the relevant goods and services, the relevant consumer would perceive the mark as referring to the extended abilities, enhanced performance or best solution offered by the goods or services (para. 35). The fact that the term does not appear in dictionaries did not alter this finding (paras 36-38). The GC dismissed the applicant's claims regarding an analogy with the judgment of 12/05/2016, [T-749/14](#), AROMA, EU:T:2016:286 (para. 39), the fact that 'MAX' was also a male first name (paras 40-41) and the fact that the mark had been registered in the United States America (paras 42-43). Finally, the GC, on the basis of settled case-law, dismissed the applicant's claim that the Office had allowed the registration of trade marks with the term 'MAX' (paras 44-50). **Distinctiveness**: the GC confirmed that, insofar as one of the absolute grounds for refusal in Article 7(1) EUTMR applies, the sign was ineligible for registration. Therefore the second plea was rejected.

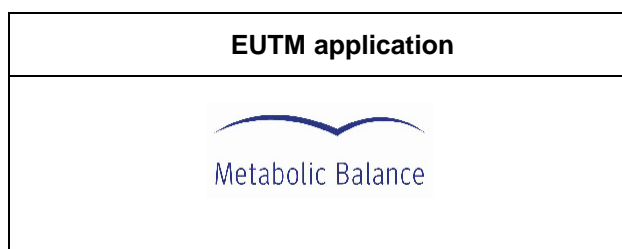
[T-430/16](#); **BRENT INDEX**; *Intercontinental Exchange Holdings, Inc. v EUIPO*; Judgment of 22 March 2017; EU:T:2017:198; Language of the case: EN. The applicant sought to register the word mark **BRENT INDEX** as an EUTM for goods and services in Classes 9, 36 and 42. The Office refused registration of the EUTM application pursuant to Article 7(1)(c) and (b) EUTMR, as it was found to be descriptive and devoid of any distinctive character. The applicant filed a notice of appeal pursuant to Articles 66 to 71 EUTMR against the examiner's decision. The BoA dismissed the appeal. It found that the mark applied for was descriptive of the goods and services at issue and devoid of any distinctive character. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR and (ii) infringement of Article 7(1)(b) EUTMR. The GC dismissed the action. Regarding the infringement of Article 7(1)(c) EUTMR, first, the GC emphasised that the word sign 'BRENT INDEX' consisted solely of the two elements 'brent' and 'index', without any addition (para. 28). As correctly stated by the BoA, the term 'brent' referred to a certain type of crude oil but was also commonly used by professionals in the financial sector. Moreover, the applicant did not really dispute that the term was used in the financial sector (paras 29-30). Second, the term 'index' was used in certain parts of the financial sector, namely the stock market, to compare the values and prices of shares. The applicant did not dispute the BoA's finding in this respect either (paras 31-32). Furthermore, the GC stated that the juxtaposition of the terms 'brent' and 'index', separated by a space, was consistent with



English lexical and grammatical rules and did not contain any unusual element in its syntax that would make it possible for the expression to be anything other than the mere combination of the words ‘brent’ and ‘index’ (para. 34). Therefore, in connection with the goods and services at issue, the mark applied for would inform the professionals concerned immediately, without any need for reflection, of the intended purpose of the goods and services, namely the fact that they were linked to finance (para. 35). With regard to the goods and services, the GC pointed out that the BoA had not erred in finding that all the goods and services in Classes 9, 36 and 42 were linked to the financial sector (para. 41). In the light of all above, the two pleas in law were rejected (paras 48 and 50).

♦[T-215/16](#); **AMPHIBIAN**; *Cop Vertriebs-GmbH v EUIPO*; Judgment of 3 April 2017; EU:T:2017:241; Language of the case: DE. The CD rejected the request for a declaration of invalidity based upon absolute grounds for invalidity (Articles 7(1)(c) and (b) EUTMR). The BoA dismissed the appeal. As regards Article 7(1)(c) EUTMR, it confirmed the CD’s finding that the invalidity applicant had not established the descriptive character of the contested mark **AMPHIBIAN** for *waterproof watches* in Class 14 for the relevant English-speaking public in the EU. With respect to Article 7(1)(b) EUTMR, it observed that the invalidity applicant had not put forward any specific argument in support of this ground. The GC dismissed the action. First, the irrelevance of the noun ‘amphibian’ for the present case was not disputed (para. 40), and the adjective ‘amphibian’ would not be directly, but only as result of several mental steps, linked with the notion of ‘waterproof’, given that (i) it is not a synonym for ‘waterproof’ and (ii) goods designed for use both on land and in water are not necessarily waterproof (paras 43, 44). Second, while the term ‘amphibian’ has acquired a particular meaning with respect to specific vehicles designed for use on both land and water, no such linguistic development has taken place as regards watches (paras 45, 46). Therefore, the term does not directly and immediately inform the relevant consumer that the protected watches can be used both on land and in water but remains merely evocative (para. 47). The argument of the invalidity applicant — upon whom falls the burden of demonstrating the descriptive character of the contested mark (paras 49-51) — that such descriptive character might be different for the professional public consisting of the military or police was made for the first time in the proceedings before the GC and thus rejected as inadmissible (paras 48, 52, 53).

[T-594/15](#); **Metabolic Balance**; *Metabolic Balance Holding GmbH v EUIPO*; Judgment of 6 April 2017; EU:T:2017:261; Language of the case: DE.



The applicant sought to register the figurative mark represented above as an EUTM for services in Classes 35, 41, 42 and 44. The Office refused registration of the EUTM application pursuant to Article 7(1)(c) and 7(1)(b) EUTMR, as it was found to be descriptive and devoid of distinctive character. The BoA dismissed the applicant’s appeal. It found that the EUTM application was descriptive and devoid of distinctive character. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR and (ii) infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal. It



found that the mark had descriptive character. It was sufficient that one of the absolute grounds for refusal listed in Article 7(1) EUTMR applied. The second plea (distinctive character) therefore also had to be dismissed. The GC confirmed that the relevant public was composed of professionals and reasonably well-informed consumers (para. 24). Considering English grammar rules, the mark had a clear meaning for English-speaking consumers: the combination of words was not a neologism and was not unusual (para. 28). The GC confirmed that the figurative element did not convey any message to the consumers and that the colour of the sign was not unusual (para. 31). The graphic element could be recognised as a decorative element or a design feature around the word elements. The figurative elements were not dominant or striking and did not alter the descriptive character of the expression (para. 35). The term conveyed direct information regarding all the services in question; it referred or could refer to a diet and nutrition programme for maintaining a balanced metabolism (paras 38 and 40). The argument that the expression was used only by the applicant is irrelevant: the examination could not be dependent on the result of any internet searches or on the fact that other competitors did not use it (paras 42-43). The argument that the Office had registered similar signs in the past was also irrelevant. The BoA found on the basis of Article 7(1)(c) EUTMR that the mark was descriptive for the services at issue; previous decisions could not change this conclusion (para. 46). The argument that an identical sign had been registered in other countries was also irrelevant in this case. The European Union trade mark regime was an autonomous system, independent of any national system and not bound by decisions adopted in any Member State or indeed a third country. There was no provision obliging the EUIPO or the court to come to the same conclusions as those arrived at by national authorities in similar circumstances (para. 48). As regards the applicant’s argument that the Office had been applying stricter examination requirements compared with its previous practice, the GC pointed out that the BoA was not bound by previous practice or by the Guidelines of the EUIPO; the application was refused on the basis of the EUTMR and the relevant case-law (para. 51).

[T-219/16](#); **ViSAGE**; *Aldi GmbH & Co. KG v EUIPO*; Judgment of 6 April 2017; EU:T:2017:265; Language of the case: DE.



The applicant sought to register the figurative mark represented above as an EUTM for, *inter alia, hygiene and beauty instruments for humans and animals* in Class 8, *electric or non-electric massage appliances* in Class 10 and *facial sprays [saunas], solar ultraviolet lamps for cosmetic use* in Class 11. The Office partially refused the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR, namely for the abovementioned goods. The EUTM application was found to be descriptive and devoid of distinctive character. The applicant filed an appeal before the BoA, which was dismissed. The BoA found that the mark was descriptive for the goods among the French-speaking public and had no distinctive character. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(b) and (ii) infringement of Article 7(1)(c) EUTMR. The GC dismissed the action. **Descriptiveness:** the relevant public (the French-speaking general public) would show a



high degree of attentiveness regarding the products concerned (para. 14). The majority would perceive the mark as a single word, meaning 'face' (paras 18 and 24). Even if the contested mark had more than one meaning, it was sufficient that even just one of the possible meanings of the word 'visage' designated a characteristic of the goods or services concerned (para. 25). The term 'visage' was sufficiently clear (para. 26). Goods covered by the EUTM application were or included products applied to the facial area. For Class 8, it was sufficient that the mark was descriptive for *hygienic and beauty implements for humans*, if not for *hygienic and beauty implements for animals*. As the applicant had not distinguished between humans and animals, this category was to be considered as a whole, and it was sufficient that the mark was descriptive for one subcategory, in this case for human use (para. 29). Regarding Class 10, it was an acknowledged fact that there were massage devices especially for the facial area (para. 30). Regarding Class 11, it was common knowledge that lamps were used on the facial area (para. 31). There was descriptiveness even if the EUTM application could be used as a descriptive indication in the future (para. 32). The EUTM application was found to be purely descriptive, and the first plea in law was dismissed (para. 33). **Lack of distinctive character:** since the EUTM application was to be refused as descriptive, there was no need to address the second plea in law (para. 35).

♦[T-622/15](#); **EXHAUST-GARD**; *Deere & Company v EUIPO*; Judgment of 27 April 2017; EU:T:2017:287; Language of the case: DE. The applicant sought to register the word mark **EXHAUST-GARD** as an EUTM for *diesel exhaust fluid* in Class 1. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) and Article 7(2) EUTMR, as it was found to be descriptive and devoid of distinctive character. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. The GC found that the applicant had been given the opportunity to comment on the BoA's understanding of the meaning of 'EXHAUST-GARD', although this meaning did differ from that taken into account by the Office. The applicant had commented on the meaning taken into account by the BoA within the administrative proceedings before the Office and therefore the contested decision had not been based on facts on which the applicant had been unable to comment. Furthermore, the GC endorsed the BoA finding that 'EXHAUST-GARD' was solely descriptive for *diesel exhaust fluid* and thus also lacked distinctive character.

[T-721/15](#); **DINCH**; *BASF SE v EUIPO*; Judgment of 27 April 2017; EU:T:2017:286; Language of the case: DE. The EUTM proprietor registered the word mark **DINCH** for *chemicals for use in the chemical industry in the production and processing of plastics* in Class 1. The invalidity applicant sought to invalidate the EUTM, arguing that the EUTM was descriptive of the goods registered at the time of registration. The CD dismissed the application for invalidity. The BoA upheld the invalidity applicant's appeal. The EUTM proprietor filed an action before the GC. The GC dismissed the appeal, finding that the EUTM had descriptive character. It applied the principles developed for neologisms to this case, which concerned an acronym that described a chemical substance in accordance with standard denomination nomenclature referred to, inter alia, in DIN and ISO standards known to the professional public. The fact that the individual letters of the acronym could be interpreted in various ways was immaterial as, in at least one interpretation following the nomenclature, the full acronym was descriptive.

[T-372/16](#); **Männerspielplatz**; *Alexander Bammer v EUIPO*; Judgment of 11 May 2017; EU:T:2017:331; Language of the case: DE. The EUTM proprietor was granted registration of the word mark **MÄNNERSPIELPLATZ** as an EUTM for the *clothing, footwear, headgear* in Class 25, *travel reservation; travel arrangement; booking of seats (travel)* in Class 39 and *organisation and conducting of sporting and cultural events; organisation of entertainment shows; arranging participation in special events; seat reservation for entertainment events* in Class 41. An application for invalidity was filed pursuant to Article 59(1)(a) in conjunction with



Article 7(1)(b), (c) and (d) EUTMR. The CD upheld the application for invalidity. The BoA dismissed the EUTM proprietor's appeal. It found that the EUTM had been registered contrary to Article 7(1)(b) and (c) EUTMR. The German term 'MÄNNERSPIELPLATZ' designated a place ('PLATZ') where specific users, namely men ('MÄNNER'), pursued an activity, namely playing ('SPIELEN'). With this meaning (playground for men), the EUTM could describe the goods and services and lacked the required distinctiveness. The EUTM proprietor filed an action before the GC, relying on two pleas in law under Article 7(1)(b) and (c) EUTMR in conjunction with Article 59(1)(a) EUTMR, namely that the BoA had erred (i) in determining the relevant point in time for assessing these provisions and (ii) in assessing the evidence submitted of the EUTM's descriptiveness. The GC dismissed the appeal. The relevant public consisted of the German-speaking general public (paras 21-22). As to the relevant point in time, the time of filing of the EUTM application, it was not disputed that the words combined in the EUTM, 'MÄNNER' and 'SPIELPLATZ', had the meaning on which the BoA based its decision. As a matter of fact, there were places where men could pursue leisure activities following their play instinct, such as operating a digger or a tank. In accordance with the common German word 'Kinderspielplatz' referring to a playground for children, the relevant public was in a position, at the time of the application, to understand 'MÄNNERSPIELPLATZ' as referring to a playground for men (paras 25-27). The evidence submitted as regards actual use of this term was not relevant and the BoA did not rely on it in its findings (paras 28-29). The GC confirmed the BoA's finding as to descriptiveness for the goods and services concerned under Article 7(1)(c) EUTMR: The goods in Class 25 could be specifically designed for men's leisure activities due to their wear resistance. The services in Class 39 could relate to trips that could be understood in the sense of a playground for men, such as motorbike tours or trips that took the public to such playgrounds for men. The services in Class 41 could relate to events that included leisure activities and at which men could play or watch others play (paras 33-35). Given that the EUTM was registered contrary to Article 7(1)(c) EUTMR and the action was therefore to be dismissed, it was not necessary to examine Article 7(1)(b) EUTMR (para. 62).

♦[T-285/16](#); **DREAMLINE**; *Dominator International GmbH v EUIPO*; Order of 15 May 2017; EU:T:2017:342; Language of the case: DE. The examiner refused the EU designation of the IR for the word mark **DREAMLINE** as descriptive and non-distinctive for goods in Class 12 (Article 7(1)(b) and (c) EUTMR). The BoA dismissed the appeal. It confirmed that **DREAMLINE** would be understood by the English-speaking public (namely in Ireland, Malta and the United Kingdom) and in Member States where English was understood (namely Denmark, Cyprus, the Netherlands, Portugal, Finland and Sweden) either as 'perfect vessel' or 'range of products too good to be true'. It therefore described the quality of the goods (Article 7(1)(c) EUTMR). In addition, it would be perceived as a laudatory promotional statement. Therefore, the sign was also non-distinctive (Article 7(1)(b) EUTMR). The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 7(2) EUTMR, (ii) infringement of Article 7(1)(b) EUTMR, and (iii) infringement of Article 7(1)(c) EUTMR. The GC dismissed the appeal. The applicant's first plea (infringement of Article 7(2) EUTMR) was ineffective and devoid of any legal basis. The applicant had not questioned the limitation of the targeted public to Member States in which English was an official language but only that the knowledge of English in the other Member States, (para. 29 and paras 35-36). There was no infringement of Article 7(1)(c) EUTMR either. The applicant had failed to explain how the BoA might have committed an error. Thus the third plea was manifestly inadmissible (paras 45-16). The second plea (Article 7(1)(b) EUTMR) was also dismissed. The applicant had pleaded that descriptiveness was separate from distinctiveness. However, the BoA had also based its decision on a separate examination of distinctiveness (paras 48-51). Moreover, a mark which is descriptive or lacks distinctive character cannot be registered (paras 57-59). The action was dismissed (para. 61).



[T-218/16](#); **Magicrown**; *Mühlbauer Technology GmbH v EUIPO*; Judgment of 16 May 2017; EU:T:2017:334; Language of the case: DE. The applicant sought to register the word mark **Magicrown** as an EUTM for *material for stopping teeth; fixing materials and impression materials; crown and bridge materials; repair materials for dental purposes; dental preparations and articles for repairing teeth* in Class 5 and *artificial teeth, dental crowns, dental bridges, dental prostheses and dental prosthetic parts* in Class 10. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR. The BoA dismissed the applicant's appeal. It found that the relevant English-speaking dental professionals would perceive the EUTM application as a combination of the word 'magic', designating the wonderful properties of the goods concerned, and the word 'crown', referring, despite the missing letter 'c', to a dental crown. With this meaning, it described the goods within the meaning of Article 7(1)(c) EUTMR and also lacked the distinctive character required under Article 7(1)(b) EUTMR. The applicant filed an action before the GC, relying on infringement of those provisions. The GC dismissed the appeal. The GC confirmed the BoA's findings under Article 7(1)(c) EUTMR, holding that there was no noticeable difference between 'magicrown' and the sum of its components 'magic' and 'crown'. In English, it was common to combine two words into one. The relevant public would thus understand the EUTM application as meaning 'wonderful dental crown', which designated a quality of the goods concerned (paras 22-23). Given this finding under Article 7(1)(c) EUTMR, it was not necessary to assess the plea concerning Article 7(1)(b) EUTMR.

[T-472/16](#); **LegalPro**; *Marsh GmbH v EUIPO*; Judgment of 16 May 2017; EU:T:2017:341; Language of the case: DE. The applicant sought to register the word mark **LegalPro** as an EUTM for insurance-related services in Class 36. The examiner refused the application on the grounds of Article 7(1)(b) and (c) EUTMR. The BoA confirmed the decision. It held that the mark, for the relevant English-speaking end consumers with an average level of attention, directly described that the services offered concerned legal issues and were rendered in a professional manner. As the trade mark was descriptive for the services at issue, it was also non-distinctive for them. The applicant filed an action before the GC, claiming infringement of Article 7(1)(c) and (b) EUTMR. The GC dismissed the applicant's claim that the relevant public was not confined to English-speaking consumers. As, according to Article 7(2) EUTMR, it was sufficient for a refusal that the trade mark be descriptive in one part of the EU — in this case Ireland, Malta and the United Kingdom at least — it was irrelevant whether it was also descriptive in other parts of the EU (paras 17, 18). The fact that the contested trade mark did not appear in dictionaries was immaterial as it was not necessary that the sign, at the time of the application, already be used in a descriptive way in the market. Furthermore, it was immaterial that the sign might have various meanings, as long as at least one of these was descriptive — in this case, 'legal and professional' (paras 25-28). As the trade mark application already had to be rejected pursuant to Article 7(1)(c) EUTMR, it was immaterial whether the conditions of Article 7(1)(b) EUTMR were also fulfilled (para. 44). Based on the foregoing, the action was dismissed.

[T-355/16](#); **MULTI FRUITS**; *adp Gauselmann GmbH v EUIPO*; Judgment of 17 May 2017; EU:T:2017:345; Language of the case: DE. The applicant sought to register the word mark **MULTI FRUITS** as an EUTM for goods and services in Classes 9, 28 and 41. The Office partially refused the registration of the EUTM application, pursuant to Article 7(1)(b) and (c) and Article 7(2) EUTMR, as descriptive and non-distinctive. The BoA partly upheld the applicant's appeal. It found that the mark was descriptive and non-distinctive only for goods and services related to games. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 7(1)(b) EUTMR, (ii) infringement of Article 7(1)(c) EUTMR, and (iii) infringement of Article 7(2) EUTMR. The GC dismissed the action. 'MULTI FRUITS' could be understood as 'many fruits' or 'several fruits' (para. 33). Although the mark



applied for had only the word ‘fruit’ in common with the word ‘fruit machine’, it reminded the public of such machines. It described both a variant of them and the associated games of chance, whether physical or virtual (para. 36). It also had descriptive character for the component parts of such machines (para. 37) and for any other type of goods in respect of games since these could use fruit symbols (para. 38). Therefore, the BoA did not err in finding that the mark was descriptive for all the contested goods and services (para. 39). It was thus not necessary to examine the plea under Article 7(1)(b) EUTMR (para. 43). Infringement of Article 7(2) EUTMR had not been claimed independently of infringement of Article 7(1)(b) and (c) (para. 44).

♦[T-163/16](#); **secret.service**; *Reisswolf Akten- und Datenvernichtung GmbH & Co. KG v EUIPO*; Judgment of 18 May 2017; EU:T:2017:350; Language of the case: DE. The applicant sought to register the word mark **secret.service** as an EUTM for various office functions in Class 35, document-related services in Classes 39 and 40, and a variety of consultancy and IT-related services in Class 42. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR. The BoA dismissed the applicant’s appeal. It found that the EUTM application referred to a service related to something secret. For the services concerning the storage and destruction of documents and data, the EUTM application designated their purpose of keeping such document/data secret. For this reason, the EUTM application also lacked the required distinctiveness. The applicant filed an action before the GC, relying on four pleas in law: (i) breach of the obligation to examine the facts *ex officio*, (ii) breach of the obligation to state reasons, (iii) infringement of Article 7(1)(c) EUTMR, and (iv) infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal. The BoA had correctly assessed the EUTM application’s registrability from the point of view of the English-speaking public. The contested decision’s references to the German translation of the words ‘secret’ and ‘service’ merely a result of German being the language of the proceedings (para. 20). Given that all services concerned the storage and destruction of documents and data, and thus formed a homogenous group, the BoA had been entitled to employ the same line of reasoning in rejecting the application for all of them (paras 30-47). On the merits of the EUTM application’s registrability, the GC confirmed the BoA’s findings. In the context of the services in question, associations with, for example, the protection of the US president or a film featuring James Bond, were unlikely. Furthermore, the term ‘secret’ was also commonly used in a commercial context (paras 59-70). The EUTM application had therefore correctly been refused registration under Article 7(1)(c) EUTMR, with the result that it was not necessary to address the plea concerning Article 7(1)(b) EUTMR.

♦[T-375/16](#); **INSTASITE**; *Sabre GBLB Inc. v EUIPO*; Judgment of 18 May 2017; EU:T:2017:348; Language of the case: EN. The applicant sought to register the word mark **INSTASITE** as an EUTM for goods and services in Classes 9, 35 and 42. The examiner refused registration of the EUTM application for all the goods in Class 9 and some of the services in Class 42 pursuant to Article 7(1)(b) and (c) and Article 7(2) EUTMR. The term ‘INSTASITE’ was found to be descriptive of the goods and services concerned and devoid of distinctive character. Before the GC, the applicant claimed (i) infringement of the right to be heard (Article 94 EUTMR), (ii) infringement of Article 7(1)(c) EUTMR, and (iii) infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal. The GC confirmed that the relevant public was mainly a professional public but also the public at large, which would display a higher than average degree of attention (para. 35). Since the mark consisted of elements in English, the existence of absolute grounds for refusal had to be examined with regard to English-speaking consumers of the EU (para. 36). The GC confirmed that, regardless of the number of dictionaries where the term ‘instasite’ could be found, the words ‘insta’ and ‘site’ would be immediately and intuitively understood by the relevant public (para. 52). A mark’s conceptual content was not necessarily identical to the dictionary definitions since, during the



short space of time in which a consumer was faced with a mark, he or she perceived the meaning of the terms intuitively rather than in a linguistically scientific way (para. 58). Furthermore, the GC upheld the BoA's assessment that the relevant consumers understood the expression 'INSTASITE' as immediately informing them without further reflection that the goods and services applied for were, first, services enabling the instant production, maintenance and updating of internet sites, and, second, software used for this purpose (para. 44). Therefore, the expression 'INSTASITE' described the kind, intended purpose and quality of the goods and services at issue.

♦ [T-326/16](#); **TAFEL**; *Bundesverband Deutsche Tafel e.V. v EUIPO*; Judgment of 8 June 2017; EU:T:2017:380; Language of the case: DE. The EUTM word mark **TAFEL** was registered for the services *gathering, collection, transportation and distribution of essential goods, including foodstuffs, for others, in particular for those in need* in Class 39 and *personal and social services rendered by others to meet individual needs* in Class 45. An application for invalidity was filed pursuant to Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b) and (c) EUTMR. The CD dismissed the application for invalidity. The BoA upheld the invalidity applicant's appeal. It found that the German word **TAFEL**, with its meaning of a festively decorated table ('first meaning'), described the services concerned within the meaning of Article 7(1)(c) EUTMR, since they might be offered at such a table. This was confirmed by lexical entries, according to which this term also referred to providing those in need with free or inexpensive foodstuffs not sold in the trade but still in good condition, or meals prepared therefrom ('second meaning'). The GC, in its judgment of 18/09/2015, [T-710/13](#), *Tafel*, EU:T:2015:643, annulled the BoA decision, holding, on the basis of the first meaning of 'TAFEL' that Article 7(1)(c) EUTMR did not apply. According to the GC, the second meaning had merely been adduced by the BoA to confirm its findings and thus did not support Article 7(1)(c) EUTMR on its own account. The BoA upheld the invalidity applicant's appeal in its new decision under Article 7(1)(c) EUTMR, based on the second meaning of 'TAFEL'. The EUTM proprietor filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR and (ii) infringement of Article 72(6) EUTMR. The GC dismissed the appeal. Following the annulment, the BoA had been obliged to render a new decision in accordance not only with the operative part of the judgment but also with the grounds constituting its essential basis (paras 19-22). The judgment had not ruled on the applicability of Article 7(1)(c) EUTMR with regard to the second meaning, and the BoA was thus entitled to take its decision on this without infringing Article 72(6) EUTMR (paras 23-26). The second meaning, which 'TAFEL' already had at the time of the EUTM application, was confirmed by the GC in Case T-710/13 and was therefore to be considered final for the purposes of this judgment (para. 40). The EUTM in its second meaning was descriptive under Article 7(1)(c) EUTMR for the services concerned (para. 41).

[T-659/16](#); **Second Display**; *LG Electronics, Inc. v EUIPO*; Judgment 14 June 2017; EU:T:2017:387; Language of the case: EN. The applicant filed an application for the registration of the word mark **Second Display** as an EUTM for goods in Classes 9 and 14. The examiner rejected the application on the ground that the mark applied for was caught by the grounds for refusal set out in Article 7(1)(b) and (c) EUTMR. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) EUTMR and (iii) infringement of Article 94 EUTMR. The GC dismissed the appeal. The GC endorsed the BoA's findings that the level of attention of the relevant public ranged from normal to high (para. 25). It also confirmed that the relevant public would immediately perceive the combination of the words 'Second Display' as designating an extra screen or, possibly, a device indicating the seconds as they passed (para. 27). Therefore, the mark was found to be descriptive of the characteristics of products that had such features (para. 28) and also of



ancillary goods (para. 29). Moreover, the GC confirmed that, since the mark was descriptive of the characteristics of the goods applied for, it was, on that account, necessarily devoid of any distinctive character in relation to the same goods and thus had to be refused also under Article 7(1)(b) EUTMR (para. 38). Finally, the GC rejected the applicant's arguments that the BoA had failed to state sufficient reasons to back up its decision (para. 46).

♦[T-699/15](#); **CityTrain**; *City Train GmbH v EUIPO*; Judgment of 21 June 2017; EU:T:2017:409; Language of the case: DE.



The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 12, 37 and 42. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b)(c) and 7(2) EUTMR, as it was found to be descriptive and devoid of distinctive character. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. However, this arrived one day after the end of the appeal period. The GC refused the Office's request to dismiss the appeal as being belated. According to the GC, the application was belated due to unforeseeable circumstances. The applicant had sent the application via fax and courier more than 2 weeks ahead of the end of the appeal period. While the fax was received by the GC on the same day it was sent, the hard copy of the appeal did not arrive until one day after the end of the appeal period. According to the GC, the applicant had sent off the hard copy of the application in time to ensure its delivery well before the expiry of the appeal period. **Descriptiveness:** as regards the substance, the GC endorsed the BoA findings that the EUTM application was merely descriptive for the goods and services and thus lacked distinctive character. The graphical elements of the EUTM application were negligible and would not change the perception of the relevant public.

♦[T-856/16](#); **LONGHORN STEAKHOUSE**; *Rare Hospitality International, Inc. v EUIPO*; Judgment of 21 June 2017; EU:T:2017:412; Language of the case: EN. The applicant sought to register the word mark **LONGHORN STEAKHOUSE** as an EUTM for services in Class 43. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR. The applicant filed a notice of appeal pursuant to Articles 66 to 71 EUTMR. The BoA dismissed the appeal. It found that the mark applied for was descriptive of the services in Class 43 and devoid of distinctive character. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) EUTMR, and (iii) breach of the principles of equal treatment and sound administration. The GC dismissed the appeal. With regard to the first plea, the services covered by the mark applied for were directed at the general public (para. 31). The GC emphasised that the term 'longhorn' could designate specific breeds of cattle, and, in



particular, the Texas Longhorn breed of cattle, or it could have a more generic meaning and thus designate, without referring to a specific breed of cattle, beef cattle with long horns (para. 27). Therefore, a not insignificant part of the general public, consisting of consumers who particularly enjoy red meat, and beef in particular, and who therefore have extensive knowledge of the field concerned, will be aware of the Texas Longhorn breed of cattle (para. 32). Moreover, even if the average English-speaking consumer in the EU did not perceive the term ‘longhorn’ as designating a specific breed of cattle, he or she would nevertheless be led to regard the term ‘longhorn’ as constituting a juxtaposition of the words ‘long’ and ‘horn’ — everyday words commonly used by the English-speaking public — and thus as designating an animal with long horns (para. 40). As to the meaning of ‘steakhouse’, this term designates a ‘restaurant that specialises in serving steaks’, namely slices of meat for grilling intended for human consumption, and is widely and commonly used by the English-speaking public. Consequently, a not insignificant part of the relevant public will perceive the mark applied for as being descriptive of the services covered by it (para. 33). In view of all this, the average English-speaking consumer, including one who is not necessarily a connoisseur or lover of red meat, will be led immediately to perceive one of the characteristics of the services that the mark applied for covers, within the meaning of Article 7(1)(c) EUTMR, namely their specialisation in beef from animals with long horns (para. 42). Consequently, all the pleas had to be rejected.

♦[T-236/16](#); **ZUM wohl**; *Biogena Naturprodukte GmbH & Co. KG v EUIPO*; Judgment of 22 June 2017; EU:T:2017:416; Language of the case: DE.



The applicant sought to register the figurative mark represented above as an EUTM for various foodstuffs and beverages in Classes 29, 30 and 32, and for *food and drink preparation services; takeaway services; provision of information relating to the preparation of food and drink* in Class 43. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR. The BoA dismissed the applicant’s appeal. The BoA found that the EUTM application was descriptive of the goods and services concerned, within the meaning of Article 7(1)(c) EUTMR, since the German expression ‘zum Wohl’ would be immediately recognised by the relevant public (general public and specialist public, both either German-speaking or with at least a sufficient knowledge of German) as meaning that they would contribute to the targeted consumers’ well-being. The figurative elements of the EUTM application would not divert the consumer’s attention from the clear laudatory advertising message conveyed by this expression. It also held that the EUTM application was devoid of distinctive character under Article 7(1)(b) EUTMR. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 7(1)(b) EUTMR, (ii) infringement of Article 7(1)(c) EUTMR, and (iii) breach of the obligation to state reasons under Article 94 EUTMR. The GC dismissed the appeal. **Descriptiveness:** the case



concerned a German expression that has a common meaning when written ‘zum Wohl’ (with upper case ‘W’), namely that of ‘to wish well-being’ for a person, particularly when toasting or following a sneeze. The pertinent German-speaking public would perceive the adverb ‘wohl’ meaning ‘probably’, attached to the term ‘zum’, as a mistake and substitute ‘Wohl’ (with upper case ‘W’) for ‘wohl’, particularly since, with the EUTM application being a figurative mark, the use of upper and lower case letters would be perceived as being part of the stylisation of the word element rather than as changing its meaning. The EUTM application would thus be understood as meaning ‘for well-being’ (paras 40-45). The black circular background and the circles constituting the outline corresponded to a basic geometric shape and standard borders, respectively. Likewise, the difference in size between the two word elements and the different typefaces used for those two elements drew the consumer’s attention to the word ‘Wohl’ and, thus, to the idea of well-being. Lastly, the colours black and white were frequently used to attract consumers’ attention and, in the present case, contributed to making the word element ‘zum wohl’, written in white on a black background, stand out. Accordingly, even taken together, the figurative elements of the mark applied for did not divert the relevant public from the message conveyed by the German expression ‘zum Wohl’ (para. 51). The foods and drinks covered contributed to good health and thus to both the physical and psychological well-being of consumers. The same applied to the food-related services in Class 43, since they too could contribute to the good health and well-being of their beneficiaries by providing food and drink or information relating to the preparation thereof. Therefore, the EUTM application would be easily recognisable by that public as a description of one of the characteristics of the goods and services in question (paras 56-57). There was no need to examine the plea alleging infringement of Article 7(1)(b) EUTMR (para. 63).

[T-685/16](#); **B2B SOLUTIONS**; *Carlos Jiménez Gasalla v EUIPO*; Judgment of 27 June 2017; EU:T:2017:438; Language of the case: ES. The word sign **B2B SOLUTIONS** was applied for as an EUTM for goods and services in Classes 9, 35 and 42. An objection was raised under Article 7(1)(b) and (c) EUTMR with regard to the English-speaking public in the EU. The applicant invoked Article 7(3) EUTMR. The examiner refused the mark. The BoA dismissed the appeal. The GC restated the content of Article 7(2) EUTMR and rejected the applicant’s argument that the perception of the English-speaking public should not be given too much importance as it represented only part of the EU public. The GC confirmed that ‘B2B SOLUTIONS’ would be understood as ‘business to business solutions’, thus directly referring to goods and services that provided solutions to a company’s business needs through another business company. For the GC, the expression ‘B2B SOLUTIONS’ was neither equivocal nor suggestive. Finally, the documents submitted for the first time before the GC regarding Article 7(3) EUTMR were declared inadmissible. The application was dismissed.

♦[T-3/16](#); **DRIVEWISE**; *Allstate Insurance Company v EUIPO*; Judgment of 5 July 2017; EU:T:2017:467; Language of the case: EN. The EUTM applicant sought to register the word mark **DRIVEWISE** as an EUTM for goods in Class 9 and services in Class 42. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR, and the BoA dismissed the appeal. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) EUTMR, and (iii) infringement of Article 94 EUTMR. The GC dismissed the appeal. **Descriptiveness:** the GC endorsed the BoA finding that the relevant public was made up of both average consumers and professionals in the English-speaking countries of the EU (paras 15-18). The BoA had been correct in finding that the relevant public would perceive the term ‘DRIVEWISE’ as a combination of the terms ‘drive’ and ‘wise’ (para. 20), and thus see the mark as a whole as descriptive of the intended purpose of the goods and services, i.e. to assist with the efficient, safe and optimum performance of a vehicle. As one of the



possible meanings of the mark designates a characteristic of the goods and services within the meaning of Article 7(1)(c) EUTMR, and is no more than the sum of its parts according to case-law, the BoA had correctly upheld the decision to refuse to register the mark (paras 21-23). The expression ‘drivewise’ might be immediately understood as the expression ‘drive safe’, equivalent in meaning to the expression ‘drive safely’, it being common knowledge that some adverbs and adjectives were used interchangeably in English. This particular descriptive meaning was unambiguous and could be attributed without requiring any effort of interpretation by the relevant public (paras 24-38). The application was consequently devoid of distinctive character pursuant to Article 7(1)(b) EUTMR (para. 41). The BoA was also right to conclude that the other marks relied upon by the applicant were either not comparable or irrelevant (paras 47-50). **On the alleged lack of reasoning:** the GC further found that the BoA decision was sufficiently reasoned in accordance with the requirements set out under Article 94 EUTMR. The GC restated the case-law according to which the Office has in principle to give reasons for the refusal for each of the relevant goods and services. However, general reasons may be stated where the goods show a sufficiently direct and objective link to the extent that they form a homogeneous category or group (para. 52). In the present case, the BoA had duly given sufficient reasons for finding a link between the mark and all the goods and services (paras 54 and 55).

♦ [T-150/16](#); **ECOLAB**; *Ecolab USA Inc. v EUIPO*; Judgment of 13 July 2017; EU:T:2017:490; Language of the case: EN. The applicant sought to designate the EU in its IR for the word sign **ECOLAB** for an extensive range of goods and services. The Office refused protection pursuant to Article 7(1)(b) and (c) EUTMR for the services in Class 42. The applicant appealed the partial refusal. The BoA dismissed the appeal on the same grounds, as well as on the basis that the applicant had not demonstrated acquired distinctive character through use pursuant to Article 7(3) EUTMR. The applicant filed an action before the GC, relying on four pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) and Article 7(2) EUTMR in conjunction with Article 7(3) EUTMR, (iii) breach of the principles of equal treatment and the protection of legitimate expectations, and (iv) infringement of Article 94 EUTMR. The GC dismissed the appeal. **Descriptiveness:** the GC endorsed the undisputed finding of the BoA that the relevant public was made up of professionals in the English-speaking countries of the EU (paras 30, 31). The BoA had been correct in establishing, by reference to an English dictionary, that the mark was made up of the known abbreviations ‘eco’ and ‘lab’, standing for ‘ecology’ or ‘ecological’ and ‘laboratory’, respectively (para. 33). The BoA had not committed any error of assessment in finding that the relevant public would perceive the neologism as a mere combination of descriptive terms that, together, was no more than the sum of its parts within the meaning of established case-law (para. 34). To the extent that the services concerned were scientific and technological services, industrial analysis and research services and environmental services, it was reasonable to hold that the professional public would perceive the mark as describing an ‘ecological laboratory’, as opposed to any of the other meanings ascribed by the applicant (para. 35). The mark as a whole would be perceived as designating services offered by an environmentally friendly laboratory, for example. As one of the possible meanings of the mark designated a characteristic of the services within the meaning of Article 7(1)(c) EUTMR, the BoA had not erred in law in finding that the mark applied for was descriptive (paras 39-44). These findings could not be called into question on the basis of decisions from other jurisdictions. The EU trade mark regime is an autonomous system, made up of a body of rules and pursuing objectives specific to it; its implementation is independent of any national system (paras 43 and 44). Since it is sufficient for the mark to be refused registration if one of the absolute grounds is applicable, the GC did not adjudicate on the plea pursuant to Article 7(1)(b) EUTMR (para. 48).



[T-650/16](#); **QD**; *LG Electronics, Inc. v EUIPO*; Judgment of 13 July 2017; EU:T:2017:489; Language of the case: EN. The EUTM applicant sought to register the word mark QD as an EUTM for goods in Class 9. The examiner refused the application in respect of all the goods on the basis of descriptiveness and lack of distinctive character. The BoA dismissed the appeal. The EUTM applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(b) EUTMR and (ii) infringement of Article 7(1)(c) EUTMR. **Descriptiveness**: the GC confirmed that references to online dictionaries that specialised in abbreviations and acronyms had to be treated with particular caution. However, use of an abbreviation on the internet by several operators in the field concerned could confirm use of the abbreviation in practice. Different non-linked internet pages confirmed that the acronym QD was an abbreviation of the words ‘quantum dot’, which refer to a display technology based on the use of small light-emitting crystals that is used, in particular, for television sets, monitors and mobile devices (Class 9). The mere fact that one of the online dictionaries mentioned by the BoA enabled users to add new entries, even if it were established, was not sufficient to challenge the reliability of all the sources referred to by the BoA (paras 22 and 23). It was not necessary to show that QD was in fact used to designate the goods at issue. It sufficed that it could be used for such purpose (para. 26). There was no obligation to prove that the sign in respect of which registration was sought was included in dictionaries (para. 27). The sign QD was descriptive of the characteristics of the goods which it designated and was therefore caught by the prohibition of Article 7(1)(c) EUTMR. **Lack of distinctiveness**: it is sufficient that one of the absolute grounds for refusal listed in Article 7(1) EUTMR applies for the sign at issue not to be registrable as an EU trade mark. There was therefore no need to examine the applicant’s second plea in law, alleging infringement of Article 7(1)(b) EUTMR (paras 33 and 34).

♦[T-194/16](#); CLASSIC FINE FOODS; *Klassisk investment Ltd v EUIPO*; Judgment of 14 July 2017; EU:T:2017:498; Language of the case: DE



The holder sought to register the figurative mark represented above as an IR designating the EU for services in Class 35. The Office refused registration of the international registration (IR) pursuant to Article 7(1)(b) and (c) and Article 7(2) EUTMR, as it was found to be descriptive and devoid of distinctive character. The BoA dismissed the holder’s appeal and confirmed the examiner’s decision. The holder filed an action before the GC, relying on three pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) EUTMR, and (iii) infringement of Article 94 EUTMR. The GC dismissed the appeal. The mark was made up of three English words that could be easily understood by the English-speaking public in the EU (para. 28). The holder had not contested the BoA decision with regard to the meanings of ‘classic’ as a reference to ‘excellence and high quality over a long period of time’, of ‘fine’ as a reference to ‘very high quality; very good in its field’, and ‘food’ as ‘any nutritious substance that people or animals eat or drink or that plants absorb in order to survive or grow’. No further reflection was needed to perceive the meaning (paras 27-30). The word combination ‘classic fine foods’ in connection with the services claimed would be



understood by the relevant public as services directly related to food of high quality, such as retail, consultancy, franchising, import-export agency services or advertising in Class 35. The figurative element of a chef's hat without any additional characteristic or fanciful design would be associated with high-quality food and the marketing thereof. The lines did nothing to enhance the distinctive character. However, the chef's hat enhanced the verbal elements (para. 32). Therefore, the GC dismissed the first plea. Since the mark was descriptive, the mark was also not distinctive (para. 41). Therefore, the GC also dismissed the second plea. Based on the foregoing, the action was dismissed.

[T-214/16](#); **4600**; *Sata GmbH & Co. KG v EUIPO*; Judgment of 14 July 2017; EU:T:2017:50; Language of the case: DE. The BoA confirmed the refusal of the application for the word mark **4600** as an EUTM for some goods in Class 7 pursuant to Articles 7(1)(b) and 7(1)(c) EUTMR. The BoA decided that limiting the goods *spray guns for paint* to *air-pressurized spray guns for paint* did not change this finding. The EUTM applicant filed an action before the GC, claiming infringement of Articles 94 and Article 7(1)(b) and (c) EUTMR as well as breach of the principle of equal treatment. The GC dismissed the action. It confirmed the BoA's finding that the number '4600' could be understood as a measure of pressure for the *spray guns for paint* and was therefore descriptive of a characteristic of those goods pursuant to Article 7(1)(c) EUTMR. This applied even after the limitation to *air-pressurized spray guns for paint* (para. 42). Being descriptive, the sign was devoid of any distinctive character (para. 46). The EUTM applicant could not rely on prior registrations, as an absolute ground for refusal had been confirmed for the sign applied for. The principle of equal treatment had not been infringed (paras 50 and 51). The contested decision had to be understood in the sense that the absolute grounds for refusal applied to the goods after limitation too. The alleged breach of the duty to state reasons was not justified (para. 54).

[T-432/16](#); **Медведь**; *Lackmann Fleisch- und Feinkostfabrik GmbH v EUIPO*; Judgment of 19 July 2017; EU:T:2017:527; Language of the case: DE. The applicant sought to register the figurative mark **Медведь** (the Russian word for 'bear') as an EUTM for goods in Classes 29, 30, 31 and 33. The examiner refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR for certain goods in Classes 29, 30 and 31 (mainly meat, meat products and ready meals). The BoA dismissed the applicant's subsequent appeal. The BoA found that the existence of absolute grounds for refusal could not be limited to the official languages of the EU but had to be examined with regard to the Russian-speaking consumers in the EU. Further, the BoA found that the mark applied for was descriptive for the goods at issue because it could be perceived as a direct and obvious reference to their kind and as a descriptive indication suggesting that the goods consisted of, contained or imitated the taste of bear meat. The applicant filed an action before the GC, relying on two pleas in law: infringement of Article 7(1)(c) EUTMR and (ii) infringement of Article 7(1)(b) EUTMR. The GC dismissed the action. The GC confirmed, in line with its earlier case-law, the BoA's finding that the existence of absolute grounds for refusal in relation to the relevant consumers could not be limited to the official languages of the EU but in this particular case had to be examined with regard to the Russian-speaking consumers in the EU. A significant part of the EU public understands Russian, with some residents in the Baltic States having a good or even mother-tongue command of it. The GC also accepted (as a subsidiary argument) the Office's submission that the Russian word 'Медведь' (bear) was known to a significant number of consumers that had learned Russian as a foreign language; moreover, it formed part of the basic Russian vocabulary and was very present in Russian culture, in particular in Russian folklore, art, literature and sports. Bearing in mind the meaning of the word, the GC agreed with the BoA that, for the goods concerned in Classes 29, 30 and 31, in particular meat, meat products and ready meals that might contain



meat, the word 'bear' would be understood as an indication that the contested goods consisted of bear meat or at least imitated its taste. The latter perception was not prejudiced by the word's possibly being perceived differently, as claimed by the applicant, namely as an association with a bear's power/size/greatness. The GC rejected the applicant's arguments that the latter did not put bear meat on the market, and that actually putting bear meat on the EU market was prohibited by law, as irrelevant and not true, respectively. Finally, the GC also addressed the possible limitation of the specification of the goods, suggested by the applicant as a way of overcoming the refusal of the application for certain goods, namely the addition of the wording ... *except bear meat*. The GC again confirmed the BoA's finding that such a limitation was unacceptable, as use of the mark in relation to goods that did not consist of or contain bear meat could deceive the relevant consumer and would, therefore, be contrary to Article 7(1)(g) EUTMR.

◆[T-395/16](#); **WINDFINDER**; *Windfinder R & L GmbH & Co. KG v EUIPO*; Judgment of 20 July 2017; EU:T:2017:530; Language of the case: DE. The applicant sought to register the word mark **WINDFINDER** as an EUTM for goods and services in Classes 9, 35, 38, 41 and 42. The Office informed the applicant that registration of the EUTM application went against Article 7(1)(b) and (c) EUTMR. The applicant submitted its observations, and the examiner refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR for the abovementioned goods and services. The BoA dismissed the EUTM applicant's appeal, finding that the mark was descriptive and non-distinctive. The EUTM applicant filed an action before the GC, claiming: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) and (c) EUTMR and (iii) infringement of Article 7(3) EUTMR. It requested that the contested decision be annulled and the appeal before the BoA be allowed. The GC annulled the contested decision for all goods and services except 'anemometers' in Class 9 and services related to meteorology in Class 42. Insofar as it annulled the decision, it allowed the appeal. With regard to the alleged infringement of Article 7(1)(c) EUTMR, the GC confirmed that the trade mark meant 'person or device that finds (the) wind', as established by the BoA (para. 37). However, it confirmed the descriptive relationship between the trade mark with this meaning and the goods and services only for 'anemometers' in Class 9 and services related to meteorology in Class 42 (para. 48), denying it for the rest (para. 54).

◆[T-374/15](#); **Vermögensmanufaktur**; *VM Vermögens-Management GmbH v EUIPO*; Judgment of 7 September 2017; EU:T:2017:589; Language of the case: DE. The EUTM proprietor was granted registration of the word mark **Vermögensmanufaktur**, which translates literally as 'asset manufacture', as an EUTM for the class headings in Classes 35 and 36. An application for invalidity was filed pursuant to Article 59(1)(a) in conjunction with Article 7(1)(b) and (c) EUTMR. The CD dismissed the application for invalidity. The BoA upheld the invalidity applicant's appeal and declared the EUTM invalid on account of its descriptive character and lack of distinctiveness. The EUTM proprietor filed an action before the GC, relying on four pleas in law, namely infringements of (i) Article 7(1)(b), (ii) Article 7(1)(c), (iii) Article 94 and (iv) Article 95 EUTMR. After filing the action, the EUTM proprietor declared under Article 33(8) EUTMR that its intention on the date of filing the EUTM had been to seek protection in respect of services beyond those covered by the literal meaning of the class headings of Classes 35 and 36. Accordingly, services from the alphabetical list were included in the EUTM's specification. With regard to these services, the EUTMR proprietor requested, in the alternative, that the GC declare the EUTM's registration to be partially maintained or remit the case to this extent to the CD. The GC dismissed the appeal. **Descriptiveness:** the relevant circles consisted of German speakers from the general public and from professional circles (paras 36-38). The German word 'Manufaktur' designated a workshop that produced specialised products, either mainly or partially by



manual labour, which led to high quality. It also referred, at the relevant time, to bespoke, high-quality services, for example in the word combination ‘Finanzmanufaktur’ and ‘Kreditmanufaktur’ (paras 40-52). Therefore, ‘Vermögensmanufaktur’ indicated a place where non-standardised services closely connected to assets and finances were offered and rendered (paras 54-58). It described, within the meaning of Article 7(1)(c) EUTMR, the class headings of Classes 35 and 36 apart from the services *advertising; office functions*, for which there was no sufficiently direct and specific relationship, given their broad nature (paras 60-75).

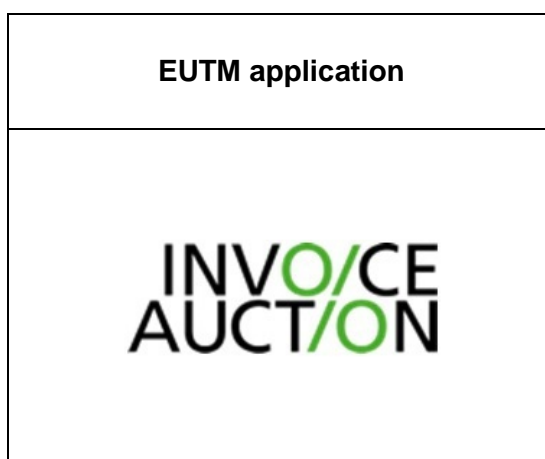
[T-402/16](#); **berlinGas**; *Berliner Stadtwerke GmbH v EUIPO*; Order 20 September 2017; EU:T:2017:655; Language of the case: DE. The applicant filed the EUTM application **berlinGas** for services in Classes 37, 39 and 40. The Office refused the EUTM application in its entirety pursuant to Article 7(1)(b) and (c) EUTMR. The EUTM application was found to be descriptive and devoid of distinctive character for all the services applied for. The applicant filed an appeal before the BoA, which was dismissed. The BoA found that the mark was descriptive of the services for the German-speaking public and had no distinctive character. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(b) EUTMR and (ii) infringement of Article 7(1)(c) EUTMR. The GC dismissed the action. **Descriptiveness**: the relevant public consists of both the German-speaking general public, in particular consumers of electrical energy, light and heat (derived from gas), and specialists, namely in the field of the production and supply of energy/power (in particular derived from gas) (para. 20). All the services applied for explicitly relate to the provision of gas and gas products and the production of energy from gas (para. 22). The mark would be understood to indicate that the services were provided to customers in Berlin or that the energy provider had its headquarters in Berlin (para. 21). Even if the EUTM application were to be considered grammatically incorrect, its overall impression was not sufficiently distinct from the mere sum of the meanings of its two components (para. 28). The reference to previous registrations by the Office was also dismissed as examiners’ decisions could not have any binding effect on the BoA. (para. 32). The EUTM was found to be purely descriptive and the first plea in law was dismissed (para. 36). **Lack of distinctive character**: since the EUTM application was to be refused as descriptive, the second plea in law did not need to be addressed (paras 39, 40).

[T-719/16](#); **berlinWärme**; *Berliner Stadtwerke GmbH v EUIPO*; Order 20 September 2017; EU:T:2017:658; Language of the case: DE. The applicant sought registration of the word mark **berlinWärme** as an EUTM for services in Classes 37, 39 and 40. The Office refused the EUTM application in its entirety pursuant to Article 7(1)(b) and (c) EUTMR. The EUTM application was found to be descriptive and devoid of distinctive character for all the services applied for. The applicant filed an appeal before the BoA, which was dismissed. The BoA found that the mark was descriptive of the services for the German-speaking public and had no distinctive character. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(b) EUTMR and (ii) infringement of Article 7(1)(c) EUTMR. The GC dismissed the action. **Descriptiveness**: the relevant public consisted of both the German-speaking general public, in particular consumers of electrical energy, light and heat, and specialists, namely in the field of the production and supply of energy/power (para. 21). All the services applied for explicitly related to the provision of heat (para. 23). The mark would be understood to indicate that the services were provided in Berlin or were intended for customers in Berlin (para. 23). Even if the EUTM application were to be considered grammatically incorrect, its overall impression was not sufficiently distinct from the mere sum of the meanings of its two components (para. 28). The reference to previous registrations by the Office was also dismissed as examiners’ decisions could not have any binding effect on the BoA (para. 37). The EUTM was found to be purely descriptive and the first plea in law



was dismissed (para. 40). **Lack of distinctive character:** since the EUTM application was to be refused as descriptive, the second plea in law did not need to be addressed (paras 43, 44).

[T-789/16](#); **INVOICE AUCTION**; *InvoiceAuction B2B GmbH v EUIPO*; Judgment of 21 September 2017; EU:T:2017:638; Language of the case: DE.



The examiner rejected the contested EUTM for goods in Class 9 and services in Classes 35 and 36 on the grounds of Article 7(1)(c) and (b) EUTMR. The BoA dismissed the applicant's appeal. The GC dismissed the applicant's action for annulment. The GC confirmed the Office's findings that the relevant English-speaking consumers in the EU, well versed in finance and business matters and having a relatively high degree of attention (para. 33), would immediately perceive the mark applied for as a whole as a reference to an 'invoice auction' and 'auctioning of invoices' and thus as an auction for invoices that are not yet due, with reductions applied (percentages, or early payment discounts, paras 36-37). The percentage symbol ('%') would be immediately associated with the clear meaning of the word elements and, in any event, be seen as a conventional mathematical symbol entirely customary in the relevant financial sector (paras 38 and 44). The sign's immediately comprehensible meaning (para. 39) would be understood by the relevant specialist consumers as a description of the goods and services applied for (paras 40-43).

[T-878/16](#); **KARELIA**; *INo Karelia v EUIPO*; Judgment of 6 October 2017; ECLI:EU:T:2017:702; Language of the case: EN. The applicant sought to register the word mark **KARELIA** as an EUTM for goods in Class 4. The Office dismissed the application pursuant to Article 7(1)(b) and (c) EUTMR and Article 7(2), as it was found to be descriptive and devoid of distinctive character. The BoA dismissed the appeal. The applicant filed an action before the GC, requesting the GC to annul the contested decision. With its first plea, the applicant contested the BoA's finding that the sign was descriptive of the requested goods. The GC restated that Article 7(1)(c) EUTMR prevented the registration of signs that might serve to designate the geographical origin of the categories of goods for which protection was sought, because: (i) such signs should remain available to the public, and (ii) they might be an indication of the quality of the categories of goods concerned and have an influence on consumer tastes (paras 14-15). In order to make assess this, the Office had to verify whether the geographical name was known by the relevant public. Considering that the word 'Karelia' refers to a region situated in Finland with historical connections to Sweden, the GC confirmed the BoA's finding that the relevant public was composed of the general public in Finland and Sweden (para. 20). Furthermore, since that region had a reputation for the



production of *biomass and biofuels*, such relevant public could easily make a connection between the sign requested and goods in Class 4 (para. 22). Finally, the GC restated that, according to Article 7(1)(c) EUTMR and the settled case-law, the Office could refuse registration of a trade mark in the following cases: (i) when the sign/indication requested could be used in the future — and not only at the time of filing — in a way that might be descriptive of the goods and services for which protection was sought (para. 34); (ii) when the sign had several meanings but at least one of them identified a feature of the goods and services concerned (paras 37, 42). Consequently, the GC dismissed the action.

♦[T-704/16](#); **SCATTER SLOTS**; *Murka Ltd v EUIPO*; Judgment of 17 October 2017; EU:T:2017:728; Language of the case: EN. The applicant filed an application for registration as an EUTM of the word mark **SCATTER SLOTS** for services in Class 41. The examiner rejected the application for registration on the ground that the mark applied for fell under the grounds for refusal of Article 7(1)(b) and (c) EUTMR. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) EUTMR, and (iii) infringement of Article 7(3) EUTMR. The GC dismissed the appeal. **Descriptiveness**: the GC endorsed the BoA's finding that the level of attention of the relevant public ranged from normal to high (para. 28). However, unlike the BoA, the GC considered that the words 'scatter' and 'slots' were not basic English words that would be understood throughout the EU. Therefore, for assessing the absolute ground for refusal, the relevant public had to be limited to the English-speaking public (paras 30-32). The GC confirmed that the relevant public would perceive the combination of words 'scatter slots' as designating 'services connected with gambling machines characterised by the "scatter" function' (para. 40). Therefore, the mark was found to be descriptive of the subject matter of the services covered by the mark (para. 47). Moreover, the GC confirmed that the BoA was entitled to adopt a general reasoning for all the services in question because they all covered 'gaming services related to slot machines, including those provided by means of the internet or mobile phones' (para. 53). The GC considered that there was no need to rule on the alleged infringement of Article 7(1)(b) EUTMR since the mark applied for had already been refused under Article 7(1)(c) EUTMR (para. 59).

[T-683/16](#); **MATRIX BODY SHOP**; *Kuka Systems GmbH v EUIPO*; Judgment of 19 October 2017; EU:T:2017:735; Language of the case: DE. The applicant sought to register the word mark **MATRIX BODY SHOP** as an EUTM for goods and services in Classes 7, 9, 12 and 42. The examiner refused the application as non-distinctive and descriptive on the grounds of Article 7(1)(b) and (c) EUTMR. The applicant filed an appeal before the BoA. The BoA dismissed the appeal, finding that the sign was descriptive of the goods and services concerned for the relevant English-speaking public and was therefore devoid of distinctive character. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR and (ii) infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal. The GC confirmed the BoA's statement that, as the sign was made up entirely of English words, the relevant public was composed of English-speaking professionals and the descriptive character of the sign had to be assessed on the basis of this relevant public, for (paras 23 and 24). The GC then dismissed the first plea, pointing out that the term 'MATRIX', which referred to 'metal mould for moulding', in association with the term 'BODY SHOP', immediately denoted a metallic mould to be used in a workshop where the bodywork of motor vehicles was built or repaired (para. 41). Consequently, the GC considered that the sign presented a sufficiently direct and specific link with the goods and services covered by the trade mark application. Indeed, it described the nature and place of use of the goods and services in Classes 7, 9 and 42, as well as the final product in Class 12 (para. 53). Finally, the GC also dismissed the second plea, restating that, as the sign was



considered descriptive, its registration had to be refused also on the ground of lack of distinctive character (Para. 61). On the basis of the foregoing, the action was dismissed.

[T-87/17](#); **Matrix light**; *KuKa Systems GmbH v EUIPO*; Judgment of 19 October 2017; EU:T:2017:732; Language of the case: DE. The applicant sought to register the word mark **Matrix light** as an EUTM for goods and services in Classes 7, 9, 12 and 42. The examiner refused the application as non-distinctive and descriptive on the grounds of Article 7(1)(b) and (c) EUTMR. The applicant filed an appeal before the BoA. The BoA dismissed the appeal, finding that the sign was descriptive of the goods and services concerned for the relevant English-speaking public and was therefore devoid of distinctive character. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR and (ii) infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal. The GC confirmed the BoA's statement that, as the sign was made up entirely of English words, the relevant public was composed of English-speaking professionals and the descriptive character of the sign had to be assessed on the basis of this relevant public (paras 23 and 24). The GC then dismissed the first plea, pointing out that the term 'Matrix', which referred to 'metal mould for moulding', in association with the term 'light', would be understood by the relevant public as a 'light metal mould for moulding' or as a 'non-bulky metal mould for moulding'. Furthermore, the GC considered that the relevant public, specialised in the development and design of assembly plant, would perceive the sign as referring essentially to 'metal mould for moulding'. Indeed, the term 'light' would not be decisive in their minds, for they would still be able to establish a link with the goods and services mentioned in the application (para. 42). Consequently, the GC considered that the sign presented a sufficiently direct and specific link with the goods and services covered by the trade mark application. Indeed, it described the nature and place of use of the goods and services in Classes 7, 9 and 42, as well as the final product in Class 12 (para. 54). Finally, the GC also dismissed the second plea, restating that, as the sign was considered descriptive, its registration had to be refused also on the ground of lack of distinctive character (para. 62). On the basis of the foregoing, the action was dismissed.

[T-810/16](#); **Mediline**; *Barmenia Krankenversicherung AG v EUIPO*; Judgment of 23 October 2017; EU:T:2017:749; Language of the case: DE. The applicant sought to register the word mark **Mediline** as an EUTM for goods and services in Class 36. The examiner refused the application as non-distinctive and descriptive on the basis of Article 7(1)(b) and (c) in conjunction with Article 7(2) EUTMR. The applicant filed an appeal before the BoA. The BoA dismissed the appeal. It found that the trade mark applied for had a clear meaning regarding the purpose and nature of the services, and was therefore devoid of distinctive character. Indeed, for the English-speaking relevant public, it would not fulfil the function of indicating the origin of the services for which protection had been sought. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7 (1) (c) EUTMR and (ii) infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal. It dismissed the first plea, finding that the BoA had correctly held that the public targeted by the contested mark consisted of both the general public and professionals, and that, as the sign was made up entirely of English words, the public to be considered when analysing the descriptive character of the sign was the English-speaking European public (para.19). The GC then confirmed that the term 'medi' would be understood by the relevant public as the abbreviation for 'medical' and that the term 'line' was a generic term in the insurance field, designating a branch of insurance. Therefore, 'Mediline' would be understood as an 'insurance sector whose insurance concerns the medical field' (paras 26-29). Consequently, the GC considered that the sign was descriptive for the services covered by the trade mark application (para. 38). Finally, the GC also dismissed the second plea, restating that, as the sign was considered descriptive, its registration had to be refused also on the ground of lack



of distinctive character (para. 40). On the basis of the foregoing, the action was dismissed (para. 42).

♦[T-844/16](#); **Klosterstoff**; *Alpirsbacher Klosterbräu Glauner GmbH & Co. KG v EUIPO*; EU:T:2017:759; Judgment of 26 October 2017; Language of the case: ES. The applicant sought to register the word mark **Klosterstoff** as an EUTM for goods and services in Classes 32 and 33. The examiner refused the application, on the basis of Article 7(1)(b), (c) and (g) EUTMR, as non-distinctive, descriptive and deceptive. The applicant filed an appeal before the BoA. The BoA dismissed the appeal. It found that the word ‘Klosterstoff’ would be understood, by the German-speaking public, as designating products containing alcohol, originating from a monastery or produced there. Therefore, the sign was non-distinctive, descriptive and deceptive. The applicant filed an action before the GC, relying on four pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) EUTMR, (iii) infringement of Article 7(1)(g) EUTMR, and (iv) ignorance of the Office’s previous decision-making practice. The GC dismissed the appeal. The GC dismissed the first plea. It found that the BoA had correctly held that the public targeted by the contested mark consisted of the general German-speaking public or a public with knowledge of basic German vocabulary, and that the relevant public was reasonably well informed and reasonably observant and circumspect (para.17). The GC further confirmed that the terms ‘kloster’ and ‘stoff’ were descriptive, as they would be understood by the relevant public as a reference to products containing alcohol originating from a monastery or produced there (para.18). The second plea was also dismissed. Indeed, the GC restated that, as the sign was considered descriptive, it could not be registered. There was therefore no need to assess its distinctiveness (para. 36).

[T-767/16](#); **metals**; *Nanogate AG v EUIPO*; Judgment of 16 November 2017; EU:T:2017:809; Language of the case: DE.



The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 1, 2, 17 and 40. The examiner refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) in conjunction with Article 7(2) EUTMR. The BoA dismissed the applicant’s appeal against that decision. The applicant then filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR and (ii) infringement of Article 7(1)(b) EUTMR. Since the figurative mark had as its only word element the English word ‘metals’, the relevant public in the first place was the English-speaking public within the EU. The targeted public consisted of both the general public and specialists (for instance, in the sector of surface treatments), and an increased level of attention had to be assumed, at least with regard to some of the goods and services (paras 27-28). **Descriptiveness:** regarding the word element, the applicant had not presented any argument of its own as to why the word ‘metals’ should not be deemed descriptive, but had merely made a general reference to arguments already made in the course of the administrative proceedings. As an application before the GC needs to contain at least a short description of the pleas, which cannot be substituted by mere general references to prior submissions, this plea was inadmissible (paras 30-31). The figurative



element consisted of a banal representation of a red arch, without any very memorable details or salient points. It was perceived as a purely decorative element and was not capable, per se, of communicating a memorable message to consumers (paras 40-41). Nor was the distinctive character enhanced by the striking red colour or the figurative element. Neither of the figurative elements gave rise to a difference between the mark applied for and the mere perception of the word elements used (para. 34). Overall, the EUTM application was descriptive for all the goods and services covered (para. 46). **Distinctiveness:** given the descriptive character of the mark, there was no need to assess the distinctiveness, since it was sufficient for one of the absolute grounds for refusal to apply (para. 62). **Scope of the proceedings:** the legality of BoA decisions A must be assessed solely on the basis of the EUTMR as interpreted by the GC and not on the basis of a previous decision-making practice (para. 48). The decision regarding the international registration could not be taken into account since it was issued 8 days after the BoA had issued the contested decision. The GC could not annul or alter the contested decision on grounds that had come into existence subsequent to its adoption (paras 53-54). The merely indicative reference to other previous registrations of the same brand (in the form of examples) was insufficient and could not be taken into account (para. 56). The previous registrations of identical national (German and USA) trade marks had no influence on this case, since the Office and the GC were not bound by any decision rendered in a Member State or third country (para. 57).

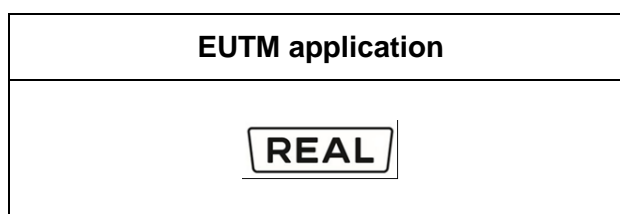
♦[T-771/16](#); **EZMIX**; *Toontrack Music AB v EUIPO*; Judgment of 22 November 2017; EU:T:2017:826; Language of the case: SV. The applicant sought to register the word mark **EZMIX** as an EUTM for goods and services in Classes 9, 15 and 42. The examiner refused registration for goods in Classes 9 and 15 on the grounds of Article 7(1)(b) and (c) EUTMR but allowed it for goods in Class 42 (*cloud computing*). Upon appeal, the applicant filed, inter alia, the restriction *all goods/services intended exclusively for use with digital audio workstations (DAW) only, and for professional composers and music creators* at the end of Classes 9 and 42. The BoA dismissed both the restriction to particular persons and the appeal. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 49 EUTMR, (ii) an infringement of Article 7(1)(c) and Article 7(2) EUTMR, and (iii) infringement of Article 7(1)(b) and Article 7(2) EUTMR. **Descriptiveness:** as the mark was made up of English words, the relevant public consisted of consumers in the English-speaking Member States, namely Ireland, Malta and the United Kingdom, and in those Member States where English was well understood, namely Denmark, Cyprus, the Netherlands, Finland and Sweden. Given the nature of the goods concerned, the public targeted consisted of professionals with an expected high level of attention and the average consumer, who was deemed to be reasonably well informed and reasonably observant and circumspect (paras 31-32). The term ‘EZMIX’ meant ‘easy, simple mixing’, and was descriptive for the goods and services (para. 36). The term ‘easy’ was a laudatory term, and no great mental effort was required on the part of the relevant public to perceive the immediate positive message embodied in the sign. The customer was very well aware that a major selling point in connection with music recording equipment and software is the ease with which they can be used for mixing; this is one of the key factors in deciding whether or not to buy the product (para. 42). As one ground of refusal is sufficient, there is no need to go into the plea regarding lack of distinctiveness (para. 66). The fact that the Office had registered previous marks containing the word element ‘ez’ could not affect the assessment (para. 53).

♦[T-239/16](#); **perlage**; *Polskie Zdroje sp. z o.o. sp.k. v EUIPO*; Judgment of 28 November 2017; EU:T:2017:844; Language of the case: PL. The applicant sought to register the word mark **perlage** for goods in Class 32 (*mineral water*). The examiner refused to register the word mark as an EUTM on the grounds of Article 7(1)(c) EUTMR. The applicant filed an



appeal against that decision. The BoA dismissed the applicant’s appeal because of the descriptive character of the mark for the French-speaking public. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(3) EUTMR, and (iii) infringement of Article 7(1)(b) EUTMR. **Descriptiveness:** since the mark was made up of French words, the relevant public was the French-speaking general public with a low level of attention (paras 22-24). The average French consumer would immediately deduce from use of the mark **perlage** for a product such as *mineral water* that the water would have bubbles (para. 26). According to the most used French dictionary, *Le Grand Robert*, the word ‘perlage’ has two meanings: ‘to form in droplets, for a liquid’ and ‘formation of oil droplets on the spark plugs of a combustion engine as a result of incomplete combustion’. Therefore, applying its first meaning, the mark **perlage** indicated that the *mineral water* contained bubbles and was sparkling water (paras 29-31).

♦[T-798/16](#); **REAL**; *Hanso Holding AS v EUIPO*; Judgment of 30 November 2017; EU:T:2017:854; Language of the case: EN.



The applicant sought to register the figurative mark represented above as an EUTM for goods in Classes 29, 30 and 31. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR, as it was found to be descriptive and devoid of distinctive character. The BoA dismissed the applicant’s appeal against the examiner’s decision. It found that the relevant public consisted of average consumers and professionals who paid a high level of attention, that the mark was descriptive and that it was also devoid of distinctive character, insofar as the applicant had not submitted the evidence necessary to assess whether the contested trade mark had acquired distinctive character by prior use. The applicant filed an action before the GC, relying on four pleas in law: (i) infringement of Article 7(1)(c) in conjunction with Article 7(2) EUTMR, (ii) infringement of Article 7(1)(b) in conjunction with Article 7(2) EUTMR, (iii) infringement of Article 7(3) EUTMR, and (iv) infringement of Article 107 EUTMR. **Descriptiveness:** the word element ‘real’ of the trade mark meant ‘not artificial or simulated, genuine’, directly and immediately informing the relevant public (Spanish, English, Portuguese and Romanian consumers) that the goods (foodstuffs and foods mainly intended for human consumption) were solely composed of the product and did not contain any artificial additives or supplements, or had not been prepared or treated in any way. Therefore, it was immediately descriptive of a characteristic of the goods (para. 24). It was irrelevant that the word ‘real’ was used without any other additional element; nor did it matter whether the characteristics of the goods described were commercially essential or merely ancillary (paras 26 and 34). **Distinctiveness:** given the descriptiveness and the failure to prove distinctiveness acquired by use, it was not necessary to assess the distinctiveness of the mark (para. 55).

[T-895/16](#); **SUPERIOR DRUMMER**; *Toontrack Music AB v EUIPO*; Judgment of 30 November 2017; EU:T:2017:851; Language of the case: SV. The applicant sought to register the word mark **SUPERIOR DRUMMER** as an EUTM for goods and services in Classes 9 and 42. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR, as it was found to be descriptive and devoid of distinctive character, except for *cloud computing*, and distinctive character acquired through use



pursuant to Article 7(3) EUTMR had not been proven. The BoA dismissed the applicant's appeal against the above refusal, and rejected the requested limitation since it did not apply to the goods and services themselves but to the group of consumers for whom these were intended. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR and (ii) infringement of Article 7(1)(b) EUTMR.

DESCRIPTIVENESS: the goods and services involved were partly intended for mass consumption and partly specialised goods and services directed at both average consumers (amateur musicians) and professional users (paras 26-27). The term '**SUPERIOR DRUMMER**' consisted of two English words and had the meaning 'first-rate drummer' (para. 29). The mark was descriptive of all the goods and services involved since it would be immediately understood, in relation to the goods in Class 9, as a direct indication that they allowed users to create a drum sound such as that created by a first-rate drummer, and that they could help average consumers become 'first-rate' drummers by improving their drumming skills. The same applied for the services in Class 42, which enabled the goods to be produced. All the goods and services were directed at consumers that wished to produce the high-quality sound of a 'first-rate' drummer (paras 32-33). Even if it were admitted that the software at issue was intended for use in music recording and production and that the professional public was aware of this distinction, the average consumer would still perceive the mark as one of the qualities of the goods and services covered, that is, that of reproducing the drum sound of a drummer (para. 41). The relevant public would reach this conclusion without any intellectual effort and would establish a direct link between the meaning of the mark and the qualities of the goods and services covered (para. 46). The Court restated that the BoA could not be required to provide an account that exhaustively followed all the lines of reasoning presented by the parties before them (para. 39).

Distinctiveness: there was no need to assess the distinctive character of the mark, since one of the absolute grounds for refusal (descriptiveness) applied (para. 50). In any case, a descriptive sign was necessarily devoid of distinctive character in relation to the same goods and services (para. 51).

[T-212/16](#); **FREE STYLE**; *El Corte Inglés, SA v EUIPO*; Judgment of 5 December 2017; EU:T:2017:869; Language of the case: EN.



The applicant sought to register the figurative mark represented above as an EUTM for goods in Classes 14, 18 and 25. An application for invalidity was filed pursuant to Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b) and (c) EUTMR. The CD refused



the application for a declaration of invalidity, as it found that the contested mark was not descriptive of the goods. An appeal was filed against the CD's decision. The BoA upheld the appeal, declaring the contested mark invalid on the ground that it was descriptive for all the goods in respect of which it had been registered. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 95 EUTMR, (ii) infringement of Article 7(1)(c) EUTMR, and (iii) breach of the principle of equal treatment. **Relevant public:** the goods concerned belonged in the fashion sector in the broad sense and were directed at average consumers who were reasonably informed and reasonably observant, as well as at fashion professionals. The relevant public was composed of English-speaking consumers in the EU, since the contested mark was composed of two English words (paras 21-22). **Meaning of the mark and descriptiveness:** regarding Class 14, the contested mark referred to jewellery made or designed in a particular style that did not comply with the conventional rules of fashion and could be worn to give the person a casual or spontaneous look (para. 31). Regarding Class 18, the contested mark would immediately be associated by the public with items made of leather or imitations of leather that were manufactured in a specific casual style, or one that did not follow the prevailing rules of fashion (para. 35). Regarding Class 25, the mark referred to the idea that the goods concerned were manufactured or designed in a particular casual style and could be used in sports as a 'freestyle' version (para. 40). The graphic representation of the mark could not divert the relevant public's attention from the descriptive message delivered by the combination of the words 'free' and 'style' (para. 44). **Equal treatment:** the other earlier marks consisting of the words 'free' and 'style' mostly designated different goods (para. 62). Even if some concerned goods of similar classes, the BoA had, on the basis of a full examination and taking into account the perception of the relevant English-speaking public, correctly found, in the light of the principle of legality, that the contested mark was descriptive (and, therefore, not distinctive) (para. 65).

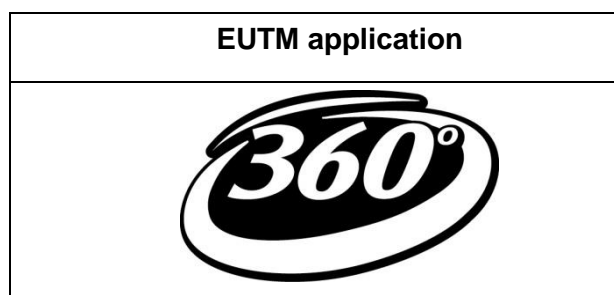
[T-213/16](#); **FREE STYLE**; *El Corte Inglés, SA v EUIPO*; Judgment of 5 December 2017; EU:T:2017:867; Language of the case: EN. The applicant sought to register the word sign **FREE STYLE** as an EUTM for goods in Classes 3, 18 and 25. An application for invalidity was filed pursuant to Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b) and (c) EUTMR. The CD refused the application for a declaration of invalidity, as it found that the contested mark was not descriptive of the goods. An appeal was filed against the CD's decision. The BoA upheld the appeal, declaring the contested mark invalid on the ground that it was descriptive for goods in Classes 18 and 25. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 95 EUTMR, (ii) infringement of Article 7(1)(c) EUTMR, and (iii) breach of the principle of equal treatment. **Relevant public:** the goods concerned were mostly clothing articles and accessories, directed at average consumers who were reasonably informed and reasonably observant, as well as at fashion professionals. The relevant public was composed of English-speaking consumers in the EU, since the contested mark was composed of two English words (paras 21-22). **Meaning of the mark and descriptiveness:** regarding Class 18, the contested mark would immediately be associated by the public with items made of leather or imitations of leather that were manufactured in a specific casual style or a style that did not follow the prevailing rules of fashion (para. 31). Regarding Class 25, the mark referred to the idea that the goods concerned were manufactured or designed in a particular casual style and could be used in sports as a 'freestyle' version (para. 36). Therefore, the contested mark would be immediately perceived as descriptive. Even assuming that the contested mark contained elements unrelated to its name or to the mere concept, the prevailing message of the combination of the words 'free' and 'style' was descriptive (para. 40). **Equal treatment:** the other earlier marks consisting of the words 'free' and 'style' mostly designated different goods (para. 58). Even if some of them concerned goods of similar classes, the BoA had, on the



basis of a full examination and taking into account the perception of the relevant English-speaking public, correctly found, in the light of the principle of legality, that the contested mark was descriptive (and, therefore, not distinctive) (para. 61).

♦[T-332/16](#); **360°**; *Colgate-Palmolive Co. v EUIPO*; Judgment of 7 December 2017; EU:T:2017:876; Language of the case: EN. The applicant sought to register the word sign **360°** as an EUTM for goods in Class 21 corresponding to the description *toothbrush*. The examiner rejected the application on the grounds of Article 7(1)(b) and (c) EUTMR. The applicant filed a notice of appeal against the examiner’s decision. The BoA dismissed the appeal, confirming that the word mark was descriptive and non-distinctive. Distinctiveness acquired by use was not proven. The applicant filed an action before the GC, relying on four pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b), (iii) breach of the principles of equal treatment and sound administration, and (iv) infringement of Article 7(3) EUTMR. **Relevant consumer:** the relevant public consisted of average, reasonably well informed and reasonably observant and circumspect consumers of toothbrushes in the EU (para. 18). **Descriptiveness:** the sign applied for had at least the possible meaning of the mathematical concept of 360°, and was connected with a circle, in the sense of ‘all round’, designating a characteristic of the goods concerned, namely that of allowing profound brushing and complete, quality dental cleaning (para. 20). The sign was, therefore, not ambiguous and described profound brushing all around the tooth (para. 21).

♦[T-333/16](#); **360°**; *Colgate-Palmolive Co. v EUIPO*; Judgment of 7 December 2017; EU:T:2017:875; Language of the case: EN



The applicant sought to register the figurative sign represented above as an EUTM for goods in Class 21, corresponding to the description *toothbrush*. The examiner rejected the application on the grounds of Article 7(1)(b) and (c) EUTMR. The applicant filed a notice of appeal against the examiner’s decision. The BoA dismissed the appeal, confirming that the word mark is descriptive and non-distinctive. Distinctiveness acquired by use was deemed not proven. The applicant filed an action before the GC, relying on four pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) EUTMR, (iii) breach of the principles of equal treatment and sound administration, and (iv) infringement of Article 7(3) EUTMR. **Relevant consumer:** the relevant public consisted of average, reasonably well informed and reasonably observant and circumspect consumers of toothbrushes in the EU (para. 18). **Descriptiveness:** the sign applied for had at least the possible meaning of the mathematical concept of 360°, and was connected with a circle, in the sense of ‘all round’, designating a characteristic of the goods concerned, namely that of allowing profound brushing and complete, quality dental cleaning (para. 20). The sign was, therefore, not ambiguous and described profound brushing all around the tooth (para. 21). The figurative elements around the number reinforced that descriptive message by evoking a characteristic of the goods in question, namely their ability to clean ‘all around’ a tooth (para. 28).



4. **Not descriptive (Article 7(1)(c) EUTMR)**

♦[T-513/15](#); **Limbic® Map**; *Gruppe Nymphenburg Consult AG. v EUIPO*; Judgment of 16 February 2017; EU:T:2017:84; Language of the case: DE. The applicant sought to register the word mark **Limbic® Map** as an EUTM for goods and services in Classes 16, 35 and 41. The Office refused registration of the EUTM application for some of the goods and services in the abovementioned classes pursuant to Article 7(1)(b) and (c) EUTMR, as the EUTM application was found to be descriptive and devoid of distinctive character. The BoA, in a single-member decision, dismissed the applicant's appeal, basing its decision solely on Article 7(1)(c) EUTMR. It took the view that 'Limbic' referred to the 'limbic system', which describes the area of the brain that influences hormonal control and the autonomic nervous system and is responsible for emotional responses to environmental stimuli, such as instincts and emotions (fear, pleasure, anger) and drives (hunger, sex, dominance, care of offspring). 'Map' is the English term for a chart, plan, diagram, etc. As a whole, the expression 'Limbic® Map' would be understood by the relevant public such that the goods and services applied for constituted, contained, used or were intended for the creation of a map of the limbic system. Therefore, there was a sufficiently direct and concrete connection between the goods and services and the EUTM application to render the application descriptive (Article 7(1)(c) EUTMR) and refuse its registration for this reason alone. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR, and (ii) infringement of Articles 70, 94 and 95 EUTMR. **Descriptiveness:** the GC endorsed the BoA's findings that the relevant public consisted of both the English-speaking general public and a specialised public, for example in the field of artists' supplies (Class 16), and educational/training and consultancy/management/administration services (Classes 35, 41), that did not include the medical professions (paras 24-28). However, the GC found that the BoA had not sufficiently proven that the relevant public would — without having to take further mental steps — establish an immediate and concrete descriptive connection between the EUTM application and the goods and services at issue. First, the GC found the combination of the three elements of the mark unusual with regard to the goods and services at issue. The various definitions provided showed that, in English, 'limbic' was normally used as part of the well-known expressions 'limbic system' and 'limbic lobe'. In the case in question, however, 'limbic' had been removed from the expression that usually gave it some sense, and had therefore been deprived of a clear and direct meaning (paras 38-41). Furthermore, the combination of 'limbic' with the remaining elements '®' and 'Map' was not common in English constructions. Therefore, the impression conveyed by the expression in its entirety departed from that conveyed by the mere combination of the three elements (para. 42). Second, the GC stressed that 'limbic' was a highly specialised medical/neurological term. It had not been proven that the relevant public, which did not include the medical professions, would understand 'limbic' directly and without further reflection as describing a region of the brain that influences hormonal control and the autonomic nervous system. Furthermore, it had not been proven that the relevant public would, without further reflection, understand the combination of the three elements as a map, describing the region of the brain that influences hormonal control and the autonomic nervous system. Finally, it was not sufficient for an assumption of descriptiveness that the relevant services could constitute, contain, use or be intended for the creation of a map of the limbic system (paras 43-46). Irrespective of the unusual combination in which 'limbic' was used, which blurred its meaning, it had not been proven that the average expert, particularly in the fields of business or staff management, education, training or publishing, would, when confronted with a specialist medical term, not have to at least interpret and reflect on it in order to understand the sense of the EUTM application for the goods and services in question. Such interpretation could not be reconciled with the recognition of descriptive character, which had to be discernible immediately and without further reflection. The



considerations with regard to the interpretation required applied all the more to the non-specialist public (paras 47-49). Consequently, the BoA's finding that **Limbic® Map** would be understood as a reference to goods and services that constitutes, contained, used or were intended for the creation of a map of the limbic system was as erroneous as its finding that the EUTM application had a sufficiently direct and concrete link with the relevant goods and services. The contested decision infringed Article 7(1)(c) EUTMR and was to be annulled irrespective of the claimed infringement (also) of Article 7(1)(b) EUTMR (paras 51-54).

♦ [T-516/15](#); **Limbic® Types**; *Gruppe Nymphenburg Consult AG v EUIPO*; Judgment of 16 February 2017; EU:T:2017:83; Language of the case: DE. The applicant sought to register the word mark **Limbic® Types** as an EUTM for goods and services in Classes 16, 35 and 41. The Office refused registration of the EUTM application for some of the goods and services in the abovementioned classes pursuant to Article 7(1)(b) and (c) EUTMR, as the EUTM application was found to be descriptive and devoid of distinctive character. The BoA, in a single-member decision, dismissed the applicant's appeal, basing its decision solely on Article 7(1)(c) EUTMR. It took the view that 'Limbic' referred to the 'limbic system', which describes the area of the brain that influences hormonal control and the autonomic nervous system and is responsible for emotional responses to environmental stimuli, such as instincts and emotions (fear, pleasure, anger) and drives (hunger, sex, dominance, care of offspring). The English word 'Types' could be defined as referring to the general form, structure or character distinguishing a particular kind, group or class of beings or objects from others. As a whole, the expression 'Limbic® Types' would be understood by the relevant public as 'different personality types, which respond differently to stimulation of the limbic system', and was therefore potentially capable of describing the goods and services at issue. Therefore, there was a sufficiently direct and concrete connection between the goods and services and the EUTM application to render the application descriptive (Article 7(1)(c) EUTMR) and refuse its registration for this reason alone. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR, and (ii) infringement of Articles 70, 94 and 95 EUTMR. **Descriptiveness:** the GC endorsed the BoA's findings that the relevant public consisted of both the English-speaking general public and a specialised public, for example in the fields of artists' supplies (Class 16), and educational/training and consultancy/management/administration services (Classes 35, 41), that did not include the medical professions (paras 24-28). However, the GC found that the BoA had not sufficiently proven that the relevant public would — without having to take further mental steps — establish an immediate and concrete descriptive connection between the EUTM application and the goods and services at issue. First, the GC found the combination of the three elements of the mark unusual with regard to the goods and services at issue. The various definitions provided showed that, in English, 'limbic' was normally used as part of the well-known expressions 'limbic system' and 'limbic lobe'. In the case in question, however, 'limbic' had been removed from the expression that usually gave it some sense, and had therefore been deprived of a clear and direct meaning (paras 38-41). Furthermore, the combination of 'limbic' with the remaining elements '®' and 'Types' was not common in English constructions. Therefore, the impression conveyed by the expression in its entirety departed from that conveyed by the mere combination of the three elements (para. 42). Second, the GC stressed that 'limbic' was a highly specialised medical/neurological term. It had not been proven that the relevant public, which did not include the medical professions, would understand 'limbic' directly and without further reflection as describing a region of the brain that influences hormonal control and the autonomic nervous system. Furthermore, it had not been proven that the relevant public would, without further reflection, understand the combination of the three elements as describing different personality types, which respond differently to stimulation of the part of the brain that influences hormonal control and the automatic nervous system. Finally, it was



not sufficient for an assumption of descriptiveness that the relevant services could be directed at conveying information on different personality types and their modes of behaviour or on how the limbic system influenced behaviour (paras 43-46). Irrespective of the unusual combination in which ‘limbic’ was used, which blurred its meaning, it had not been proven that the average expert, particularly in the fields of business or staff management, education, training or publishing, would, when confronted with a specialist medical term, not have to at least interpret and reflect on it in order to understand the sense of the EUTM application for the goods and services in question. Such interpretation could not be reconciled with the recognition of descriptive character, which had to be discernible immediately and without further reflection. The considerations with regard to the interpretation required applied all the more to the non-specialist public (paras 47-49). Consequently, the BoA’s finding that **Limbic® Types** would be understood as a reference to different personality types, which respond differently to stimulation of the limbic system, was as erroneous as its finding that the EUTM application had a sufficiently direct and concrete link with the relevant goods and services. The contested decision infringed Article 7(1)(c) EUTMR and was to be annulled irrespective of the claimed infringement (also) of Article 7(1)(b) EUTMR (paras 51-54).

♦ [T-517/15](#); **Limbic® Sales**; *Gruppe Nymphenburg Consult AG v EUIPO*; Judgment of 16 February 2017; EU:T:2017:81; Language of the case: DE. The applicant sought to register the word mark **Limbic® Sales** as an EUTM for goods and services in Classes 16, 35 and 41. The Office refused registration of the EUTM application for some of the goods and services in the abovementioned classes pursuant to Article 7(1)(b) and (c) EUTMR, as the EUTM application was found to be descriptive and devoid of distinctive character. The BoA, in a single-member decision, dismissed the applicant’s appeal, basing its decision solely on Article 7(1)(c) EUTMR. It took the view that ‘Limbic’ referred to the ‘limbic system’, which describes the area of the brain that influences hormonal control and the autonomic nervous system and is responsible for emotional responses to environmental stimuli, such as instincts and emotions (fear, pleasure, anger) and drives (hunger, sex, dominance, care of offspring). ‘Sales’ is the English term for the German word ‘Verkauf’. As a whole, the expression ‘Limbic® Sales’ would be understood by the relevant public such that the goods and services applied for were connected with ‘sales activities that relate to the limbic system’ and was, thus, potentially capable of describing the goods and services at issue. Therefore, there was a sufficiently direct and concrete connection between the goods and services and the EUTM application to render the application descriptive (Article 7(1)(c) EUTMR) and refuse its registration for this reason alone. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(c) EUTMR, and (ii) infringement of Articles 70, 94 and 95 EUTMR. **Descriptiveness:** the GC endorsed the BoA’s findings that the relevant public consisted of both the English-speaking general public and a specialised public, for example in the fields of artists’ supplies (Class 16), and educational/training and consulting/management/administration services (Classes 35, 41), that did not include the medical professions (paras 24-28). However, the GC found that the BoA had not sufficiently proven that the relevant public would — without having to take further mental steps — establish an immediate and concrete descriptive connection between the EUTM application and the goods and services at issue. First, the GC found the combination of the three elements of the mark unusual with regard to the goods and services at issue. The various definitions provided show that, in English, ‘limbic’ was normally used as part of the well-known expressions ‘limbic system’ and ‘limbic lobe’. In the case in question, however, ‘limbic’ had been removed from the expression that usually gave it some sense, and had therefore been deprived of a clear and direct meaning (paras 38-41). Furthermore, the combination of ‘limbic’ with the remaining elements ‘®’ and ‘Sales’ was not common in English constructions. Therefore, the impression conveyed by the expression in its entirety departed from that conveyed by the mere combination of the three elements (para. 42).



Second, the GC stressed that ‘limbic’ was a highly specialised medical/neurological term. It had not been proven that the relevant public, which did not include the medical professions, would understand ‘limbic’ directly and without further reflection as describing a region of the brain that influences hormonal control and the autonomic nervous system. Furthermore, it had not been proven that the relevant public would, without further reflection, understand the combination of the three elements as referring to sales activities related to the part of the brain that influences hormonal control and the autonomic nervous system. Finally, it was not sufficient for an assumption of descriptiveness that the relevant services could be directed at conveying information about controlling purchasers’ behaviour and influencing customers’ emotions, which are controlled by the limbic system (paras 43-46). Irrespective of the unusual combination in which ‘limbic’ was used, which blurred its meaning, it had not been proven that the average expert, particularly in the fields of business or staff management, education, training or publishing, would, when confronted with a specialist medical term, not have to at least interpret and reflect on it in order to understand the sense of the EUTM application for the goods and services in question. Such interpretation could not be reconciled with the recognition of descriptive character, which had to be discernible immediately and without further reflection. The considerations with regard to the interpretation required applied all the more to the non-specialist public (paras 47-49). Consequently, the BoA’s finding that **Limbic® Sales** would be understood as a reference to sales activities relating to the limbic system was as erroneous as its finding that the EUTM application had a sufficiently direct and concrete link with the relevant goods and services. The contested decision infringed Article 7(1)(c) EUTMR and was to be annulled irrespective of the claimed infringement (also) of Article 7(1)(b) EUTMR (paras 51-54).

♦[T-327/16](#); **ANTICO CASALE**; *Aldi Einkauf GmbH & Co. OHG v EUIPO*; Judgment of 27 June 2017; EU:T:2017:439; Language of the case: EN. The EUTM proprietor was granted registration of the word mark **ANTICO CASALE** as an EUTM for goods and services in Classes 29, 30 and 35. An application for a declaration of invalidity was filed pursuant to Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b), (c) and (g) EUTMR. The CD rejected the application for invalidity. The BoA dismissed the cancellation applicant’s appeal. It found that the mark was not directly descriptive but merely allusive, was not a mere laudatory statement about the quality of the goods and was not deceptive. The cancellation applicant filed an action before the GC, relying on three pleas in law, alleging infringement of Article 59(1)(a) EUTMR in conjunction with (i) Article 7(1)(b) EUTMR, (ii) Article 7(1)(c) EUTMR, and (iii) Article 7(1)(g) EUTMR. **Descriptiveness**: consumers did not imagine a specific origin when they encountered **ANTICO CASALE**, meaning ‘old farmhouse’ or ‘old hamlet’, as this did not directly describe a specific characteristic or the quality of the goods or services at issue but at most alluded to certain characteristics, which would vary depending on different consumers’ personalities. The link between the meaning of the mark and the goods and services covered was not sufficiently direct and specific for Article 7(1)(c) EUTMR to apply.

[C-139/16](#); **Moreno Marín a.o. / La Milla de Oro**; *Marín a.o v Abadía Retuerta SA*; Preliminary ruling of 6 July 2017; EU:C:2017:518; Language of the case: ES. The applicant in the main proceedings was the owner of the Spanish trade mark **La Milla de Oro**, registered to distinguish wines. The applicant brought an action against the defendant, who used the sign **El Pago de Milla de Oro**, alleging that there was a LOC. The defendant brought a counterclaim seeking a declaration of invalidity of the **La Milla de Oro** trade mark, submitting, inter alia, that the trade mark constituted an indication of geographical origin. The first-instance court upheld the counterclaim, declaring the mark invalid on the grounds that it was an indication of geographical origin. The referring court pointed out that the sign did not seem to be an indication of geographical origin but was still associated with a specific place



that was characterised by a high concentration of high-quality goods. As with geographical indications, in which a given characteristic of a product is associated with the place in question, that sign would be associated with the place concerned insofar as it was characterised by the quality of the goods and their accumulation. Regarding the second question referred, which the CJ examined first, the referring court, referring to the characteristic of a product or service consisting in the possibility of it being found in abundance in a single place with a high degree of value and quality, asked whether a sign such as La Milla de Oro could be considered as an indication of geographical origin where the goods or services concerned were concentrated in a specific physical area. The CJ held that the sign La Milla de Oro, first, designated a geographical area that varied depending on the name of the geographical place accompanying it and, second, referred to a specific level of quality of the goods and services, which also varied depending on the name of the geographical place with which that sign is associated. Consequently, in order to identify the geographical origin of the goods or services concerned, the sign had to be accompanied by a name designating a specific geographical place, given that the goods and services were characterised by the possibility of finding in abundance, in that specific physical space, such goods or services of a high degree of value or quality. There was no connection between the product concerned in this case, namely wine, and the geographical origin attributed to the sign La Milla de Oro, since it was precisely on the basis of the name of the specific geographical place with which they were associated that the geographical origin of the goods or services in question could be determined. The answer to the second question was that a sign such as La Milla de Oro, which referred to the characteristic of a product or service consisting in the possibility of it being found in abundance in a single place with a high degree of value and quality, could not constitute an indication of geographical origin (paras 15-21). By the first question referred, the referring court asked whether Article 3(1)(c) of Directive 2008/95/EC had to be interpreted as meaning that a sign such as La Milla de Oro, which referred to the characteristic of a product or service consisting in the possibility of it being found in abundance in a single place with a high degree of value and quality, could have characteristics the use of which as a trade mark would constitute a ground for invalidity within the meaning of that provision. The CJ held that it would be for the referring court to ascertain, by means of an assessment *in concreto* of all the relevant facts and circumstances, whether the sign La Milla de Oro could be perceived by the relevant public as being descriptive of a characteristic of a product, such as wine, consisting in the possibility of it being found in abundance in a single place with a high degree of value and quality. The referring court would also have to examine, in the light of all the relevant facts and circumstances, whether the sign La Milla de Oro, provided that it was not descriptive of the characteristic of a product or service consisting in the possibility of it being found in abundance in a single place with a high degree of value and quality, was perceived by the public concerned as being a slogan or promotional formula capable of indicating the commercial origin of the product or service concerned. Article 3(1)(c) of Directive 2008/95/EC had to be interpreted as meaning that a sign such as La Milla de Oro, which referred to the characteristic of a product or service consisting in the possibility of such a product or service being found in abundance in a single place with a high degree of value, was unlikely to have characteristics the use of which as a trade mark would constitute a ground for invalidity within the meaning of that provision.

♦ [T-305/16](#); **LOVE TO LOUNGE**; *Lidl Stiftung & Co. KG v EUIPO*; Judgment of 15 September 2017; EU:T:2017:607; Language of the case: EN. An application for invalidity was filed pursuant to Article 59(1)(a) EUTMR in conjunction with Articles 7(1)(b) and (c) EUTMR. The CD dismissed the application for invalidity in its entirety. The applicant filed a notice of appeal against the CD's decision. The BoA dismissed the appeal. It found that the contested mark was not capable of describing the goods covered; therefore, the connection between the expression 'love to lounge' and the goods concerned was too indeterminate to constitute a



ground for invalidity. Moreover, it found that the contested mark could not be regarded as being completely devoid of any distinctive character. The applicant filed an action before the GC, relying on four pleas in law: (i) infringement of Article 95 EUTMR, (ii) infringement of Article 94 EUTMR, (iii) infringement of Article 7(1)(c) EUTMR, and (iv) infringement of Article 7(1)(b) EUTMR. The GC dismissed the appeal. **Descriptiveness:** the GC pointed out that the contested mark was to be understood simply as a vague and evocative message alluding to a particular interest or pleasure in relaxing and not as an easily recognisable property of the contested goods; therefore, the contested mark was not descriptive of the goods in question or of one of their characteristics (paras 49-56).

♦[T-670/15](#); **OSHO**; *Osho Lotus Commune e. V. v EUIPO*; Judgment of 11 October 2017; EU:T:2017:716; Language of the case: DE. An application for invalidity was filed pursuant to Article 59(1)(a) in conjunction with Article 7(1)(b), (c) and (f) EUTMR against the word mark **OSHO** for *educational services; yoga instruction* in Class 41 and *religious services; meditation services* in Class 42. The CD rejected the application. The BoA dismissed the applicant's subsequent appeal. The BoA found that there was no evidence that **OSHO**, beyond being a man's personal name and a reference to his teachings, had over the years acquired a descriptive meaning with regard to a specific type of education, yoga practice, meditation technique or religious service. The BoA also found that use of the name of a spiritual leader in relation to the services in question could not be considered offensive by the relevant public. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 7(1)(b) EUTMR, (ii) infringement of Article 7(1)(c) EUTMR, and (iii) infringement of Article 7(1)(f) EUTMR. The GC dismissed the action. **Descriptiveness:** the GC found that the BoA had made a mistake when defining the relevant public, wrongly considering that the services in question targeted only the general public, which was deemed to be reasonably well informed and reasonably observant and circumspect. By referring to previous case-law, the GC found that such services were directed also at a specialised public with knowledge in the fields of yoga, meditation and spirituality. Despite this wrong assessment by the BoA, which would in itself be sufficient reason for annulling the contested decision, the GC proceeded with its analysis in order to establish whether, on the date of registration of the contested EUTM (1999), the mark had possessed distinctive character in relation to the relevant public as defined by the GC. The GC found that the BoA had not erred in its assessment of the evidence, confirming the BoA's conclusion that the relevant public in 1999 could not have established a direct and immediate connection between the word 'OSHO' and the description of specific content of *educational services; yoga instruction and religious services*. In relation to *meditation services*, the GC found that, at the time when the trade mark was filed (1999), the word 'OSHO' and even the combination 'Osho-Meditations' might have been known only to an insignificant part of the relevant public in Germany. Therefore, the BoA had been right to conclude that the contested trade mark was not descriptive in relation to *meditation services* either.

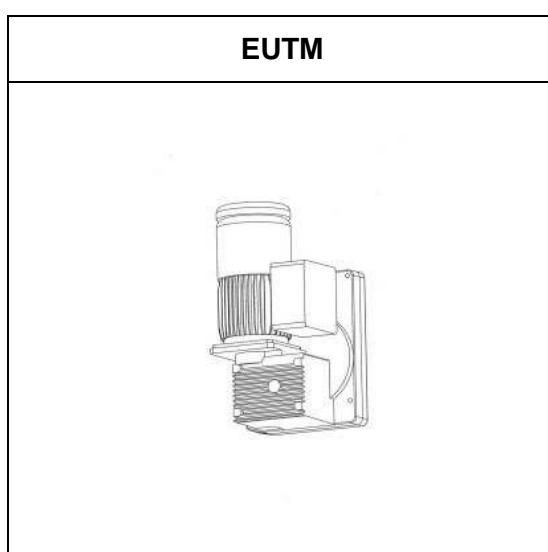
♦[T-280/16](#); **GEO**; *GeoClimaDesign v EUIPO*; Judgment of 14 December 2017; EU:T:2017:913; Language of the case: DE. The EUTM proprietor was granted registration of the word mark **GEO** as an EUTM for services in Classes 35, 37 and 42. An application for declaration of invalidity was filed pursuant to Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b), (c) and (d) EUTMR. The CD partly upheld the application for invalidity for some of the services in Classes 35, 37 and 42. The BoA upheld the EUTM proprietor's appeal. It found that the EUTM was not devoid of any distinctive character, was not descriptive for the designated services and had not become customary. The invalidity applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(b) EUTMR and (ii) infringement of Article 7(1)(c) EUTMR. The GC dismissed the action. **Descriptiveness:** irrespective of whether the relevant public was composed of



professionals or average consumers, it had not been demonstrated that either public would immediately and without further reflection perceive the term ‘GEO’ as a reference to the services’ compliance with geoscience standards (paras 40-45). The link between ‘GEO’ and the services in the field of renewable energies was too vague and indirect to conclude that the EUTM was descriptive (para. 47).

C. Article 7(1)(e), 52(1)(a) EUTMR — shape

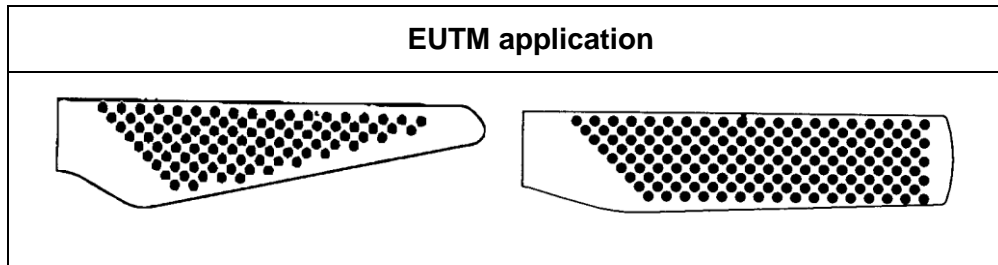
[T-621/15](#); **SHAPE OF A MOTORISED ROPE WINCH**; *Tractel Greifzug GmbH v EUIPO*; Judgment of 5 April 2017; EU:T:2017:254; Language of the case: DE.



The CD rejected the request for a declaration of invalidity based upon absolute grounds of invalidity (Article 7(1)(e)(ii) and Article 7(1)(b) EUTMR). The BoA upheld the appeal and invalidated the contested mark on the basis of Article 7(1)(e)(ii) EUTMR, observing that the contested mark would, in any event, also have had to be invalidated on the basis of Article 7(1)(b) EUTMR. The GC dismissed the action, confirming the BoA’s finding that the contested trade mark — corresponded essentially to the illustration of the ‘Tirak’ rope winch produced by the EUTM proprietor and consisted of the four components of motor, gears, control unit and traction sheave — consisted of a shape whose essential characteristics performed a technical function. This would also be the case for the vertically and horizontally arranged ribs on the housing of the engine if these were to be considered as either an essential characteristic or an aesthetic element of the shape, given that these would, or at least could, perform the function of cooling the engine (paras 24-26). The existence of alternative forms was irrelevant in that respect (paras 27-29).



C-421/15 P; DEVICE OF A SURFACE WITH BLACK DOTS; Yoshida Metal Industry Co. Ltd v EUIPO; Judgment of 11 May 2017; EU:C:2017:360; Language of the case: EN.



The applicant for registration/appellant before the CJ obtained registration of the figurative marks represented above as EUTMs for goods in Classes 8 and 21. The interveners applied for the annulment of the marks pursuant to Article 58(1)(a) EUTMR on the ground that they had been registered in breach of Article 7(1)(e)(ii) EUTMR. The CD rejected the applications for the declaration of invalidity. The interveners filed a notice of appeal against the CD's decisions. On the basis of Article 7(1)(e)(ii) EUTMR, the BoA upheld the appeals and annulled the CD's decisions. The BoA concluded that the black dots representing dents performed the technical function of obtaining a non-skid effect. The applicant for registration filed an action before the GC, claiming in particular that the subject matter of the trade marks at issue had been incorrectly assessed. The GC annulled the decisions at issue, considering in particular that no account could be taken of the proof of current use of the signs at issue given that only the shape as reproduced in the registration application could be the subject matter of the examination of the trade mark. Both the Office and the interveners appealed the decisions before the CJ, alleging infringement of Article 7(1)(e)(ii) EUTMR. The CJ upheld the appeals, annulled the decisions and referred the cases back to the GC. The CJ found that, when determining the essential characteristics of a sign, account could be taken of the actual use made of a trade mark following its registration (06/03/2014, C-337/12 P-C-340/12 P, Surface covered with circles, EU:C:2014:129, § 61). On remittal, the GC rejected the single plea raised by the appellant/applicant for registration and, consequently, dismissed its actions in their entirety (21/05/2015, T-331/10 RENV & T-416/10 RENV, A surface covered with circles (fig.), EU:T:2015:302). The appellant/applicant for registration brought a new appeal before the CJ, putting forward two grounds of appeal, specifically infringement of Article 7(1)(e)(ii) EUTMR and infringement of Article 58(3) EUTMR. The CJ emphasised that the appellant had not presented any element capable of supporting its argument that the GC had distorted the facts and evidence in not reaching the conclusion that the specific configuration of the array of black dots had a sufficiently significant ornamental character for them to be considered an essential non-functional element (para. 24). The CJ also underlined that, as regards the condition that registration of a shape of goods as a trade mark could be refused under Article 7(1)(e)(ii) EUTMR only if the shape was 'necessary' to obtain a technical result, that condition did not mean that the shape at issue had to be the only one capable of obtaining that result (para. 28). The CJ considered it important to identify the essential characteristics of a sign first and then ascertain whether they all performed the technical function of the goods at issue (para. 29). In any case, contrary to what the appellant claimed, the fact that the sign had ornamental and fanciful aspects did not preclude the ground for refusal of Article 7(1)(e)(ii) EUTMR from applying 'in so far as those aspects do not play an important role in the shape of goods at issue' (para. 30). Accordingly, the GC had been right to conclude that Article 7(1)(e)(ii) EUTMR applied where all the essential characteristics of the sign performed a technical function (para. 31). As far as the distinctiveness of the signs was concerned, the CJ underlined that Article 7(1)(e)(ii) EUTMR constituted an obstacle to registration of a sign that consisted



exclusively of the shape of goods necessary to obtain a technical result, even if that sign was distinctive and capable of performing the essential function of a trade mark — that of guaranteeing the identity of the origin of the goods or services in question (para. 35). The CJ dismissed the second plea in law, based on infringement of Article 58(3) EUTMR insofar as the BoA and the GC had failed to apply Article 7(1)(e)(ii) EUTMR in respect of each individual product. The CJ noted that this plea (which concerned an essential procedural requirement) was new and therefore inadmissible (para. 46). According to all the foregoing, the appeal was dismissed in its entirety (para. 48).

♦[T-580/15](#): **SHAPE OF A LIGHTER WITH THE WORD ELEMENT ‘CLIPPER’**; *Flamagas, SA v EUIPO – MatMind Srl*; Judgment of 27 June 2017; EU:T:2017:433; Language of the case: EN.



The applicant’s contested EUTM had been applied for, and registered, as a three-dimensional mark without any further description and without any disclaimer. It depicted the shape of a lighter from five different perspectives. On one of these five representations, a small word element reading ‘CLIPPER’ could be seen, written in dark grey letters on a light grey background and occupying less than one tenth of the total surface of the lighter’s front. The CD rejected the other party’s invalidity request (Article 59(1)(a) EUTMR). On appeal, the BoA annulled the CD’s decision and declared the contested mark invalid on the basis of the absolute grounds of invalidity laid down in (i) Article 7(1)(e)(ii), (ii) Article 7(1)(b), and (iii) Article 7(1)(a) EUTMR. The BoA found essentially that (i) the contested shape fulfilled a technical function and was non-distinctive, and (ii) the word element played a marginal role in the contested mark as a whole. The GC dismissed the applicant’s appeal. With regard to Article 7(1)(e)(ii) EUTMR, the GC confirmed the BoA’s finding — which was itself based on a Spanish utility model — that the contested shape fulfilled a technical function (paras 47-53). The GC stressed that the presumed perception of a sign by the relevant consumer, while not decisive for such a finding, could be taken into account assessing this ground of refusal (paras 54-57). It also observed that the existence of alternative forms (paras 58-59) and the mark’s alleged reputation (para. 60) were immaterial in this respect. As regards the word element, the GC confirmed the BoA’s finding that it constituted a non-essential characteristic of the contested mark (para. 40). The contested mark’s essential characteristics would be limited to the elements constituting the shape itself (para. 37 *in fine*) for two reasons. First, because the contested mark had been filed as a three-dimensional mark without any further clarification of the (very small) word element (para. 34). Such choice could not be disregarded by the Office (para. 35), both for reasons of legal certainty required by Article 4 EUTMR and to safeguard the public interest underlying Article 7(1)(e)(ii) EUTMR (para. 36). Second, the word element was of minor and secondary importance in view of its small size and lack of visibility (para. 38).

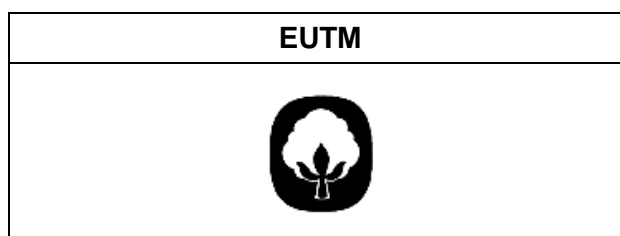


D. Article 7(1)(f), 52(1)(a) EUTMR — public policy/morality

♦[T-670/15](#); **OSHO**; *Osho Lotus Commune e. V. v EUIPO*; Judgment of 11 October 2017; EU:T:2017:716; Language of the case: DE. An application for invalidity was filed pursuant to Article 59(1)(a) in conjunction with Article 7(1)(b), (c) and (f) EUTMR against the word mark **OSHO** for *educational services; yoga instruction* in Class 41 and *religious services; meditation services* in Class 42. The CD rejected the application. The BoA dismissed the applicant’s subsequent appeal. The BoA found that there was no evidence that **OSHO**, beyond being a man’s personal name and a reference to his teachings, had over the years acquired a descriptive meaning with regard to a specific type of education, yoga practice, meditation technique or religious service. The BoA also found that use of the name of a spiritual leader in relation to the services in question could not be considered offensive by the relevant public. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 7(1)(b) EUTMR, (ii) infringement of Article 7(1)(c) EUTMR, and (iii) infringement of Article 7(1)(f) EUTMR. The GC dismissed the action. **Public policy and accepted principles of morality**: in relation to the claim pursuant to Article 7(1)(f) EUTMR, the GC found, first, that the word ‘OSHO’ as such was in no way offensive for the relevant public. Moreover, as it was registered in relation to spiritual services — those promoted by ‘OSHO’ himself — its use for such services could in no way be perceived by the relevant circles as offensive or harmful. Second, even if it could not be ruled out that monopolising the name of a spiritual teacher for commercial purposes could be perceived as offensive and against the public order, this had not been proven in the case in question. The GC reasoned that it could not be inferred from the evidence that a significant part of the relevant public in Germany and in Europe knew ‘OSHO’ as a spiritual teacher at the date of filing of the application (1999) sufficiently for registration of the mark to be perceived as contrary to public policy.

E. Article 7(1)(g), 52(1)(a) EUTMR — deceptive

[C-689/15](#); **W. F. Gözze Frottierweberei+Gözze / International cotton certification**; *W.F. Gözze Frottierweberei GmbH, Wolfgang Gözze v Verein Bremer Baumwollbörse*; Preliminary ruling of 8 June 2017; EU:C:2017:434; Language of the case: DE. The applicant in the infringement proceedings before the European Union trade mark court (‘the applicant’) was an association engaged in various activities linked to cotton. It was the proprietor of the following individual, figurative EUTM, registered in particular for textiles (‘the cotton flower mark’):



The cotton flower mark had been used by manufacturers of textiles made from cotton fibres to certify the composition and the quality of their goods. Since registration, the applicant had concluded licence agreements in respect of its cotton flower mark with undertakings affiliated with the association. Those undertakings agreed to use the mark only for goods made from



good-quality cotton fibres. Compliance with this commitment could be checked by the applicant. The defendant in the infringement proceedings before the European Union trade mark court ('the defendant') had not concluded a licence agreement with the applicant. It manufactured textiles made from cotton fibres. The infringement proceedings had been directed against the defendant's sale of towels to which hangtags were attached with the following reverse side:



The defendant brought a counterclaim for cancellation of the cotton flower mark, claiming that it was purely descriptive and non-distinctive and had not been put to genuine use by the applicant or its licensees. Firstly, the referring court asked whether Article 18(1) EUTMR was to be interpreted as meaning that the affixing of an individual EUTM, by the proprietor or with its consent, to goods as a label of quality was a trade mark use that fell under the concept of 'genuine use' within the meaning of that provision, with the result that the proprietor of that mark was entitled, pursuant to Article 9(1)(b) EUTMR, to prevent the affixing by a third party of a similar sign to identical goods where there was a LOC as referred to in the latter provision (para. 33). It was indispensable that a mark be used in accordance with its essential function which was to indicate the origin of the goods or services marked with it. It might admittedly also be used to fulfil other functions, such as that of guaranteeing the quality of the goods or services. However, where the use of an individual mark, despite certifying the composition or quality of the goods or services, did not guarantee to consumers that the goods or services came from a single undertaking under the control of which they were manufactured or supplied and which, consequently, was responsible for the quality of those goods or services, such use was not made in accordance with the function of indicating origin. It followed that there was no use in accordance with the essential function of the individual mark where it was affixed to goods for the sole purpose of being a label of quality for those goods and not that of guaranteeing, in addition, that the goods came from a single undertaking under the control of which they were manufactured and which was responsible for their quality (paras 40-46). It was for the referring court to verify whether evidence made it possible to consider that the affixing of the cotton flower mark by the applicant's licensees to their goods guaranteed to consumers that the goods came from a single undertaking, namely the applicant's association, under the control of which the goods were manufactured and which was responsible for their quality. In any event, the fact that the licence agreements enabled the applicant to verify that the licensees used exclusively good-quality cotton fibres could not constitute such evidence. It implied, at most, that the applicant certified the quality of the raw material used. As was apparent from Article 74 EUTMR and Article 83 EUTMR, such certification might suffice for the view to be taken that a mark other than an individual mark fulfilled its function as an indication of origin. However, the dispute in the main proceedings concerned an individual mark registered for goods (paras 49-50). Secondly, the referring court asked whether Article 59(1)(a) and Article 7(1)(g) EUTMR had to be interpreted as meaning that an individual mark might be declared invalid where the proprietor of the mark failed to ensure, by carrying out periodic quality controls at its licensees' premises, that expectations relating to the quality which the public associated with the mark were being met (para. 52). It was for the referring court to examine whether the cotton flower sign filed by the applicant was capable per se of deceiving the consumer. The subsequent management by the applicant of its mark and licences for its use was irrelevant in this respect and, therefore, the mark could not be declared invalid on the grounds that the



proprietor of the mark failed to ensure, by carrying out periodic quality controls at its licensees' premises, that expectations relating to the quality that the public associated with the mark were being met (paras 52-57). Thirdly, the referring court asked whether the EUTMR had to be interpreted as meaning that its provisions on collective EU trade marks could be applied *mutatis mutandis* to individual EUTMs (para. 58). The scope of Article 74 to 82 EUTMR, relating to collective EUTMs, was expressly confined, according to the wording of Article 74(1) EUTMR, to marks described as such when applied for. The demarcation of the applicability of those articles had to be strictly adhered to, especially as the rules they introduced, such as those set out in Article 75 EUTMR concerning regulations governing use of the mark, went hand in hand with the requirement, when filing the application for registration, to expressly describe the mark applied for as a collective mark. Therefore, it was not possible to apply those rules by analogy to individual EUTMs (paras 58-60).

♦[T-327/16](#); **ANTICO CASALE**; *Aldi Einkauf GmbH & Co. OHG v EUIPO*; Judgment of 27 June 2017; EU:T:2017:439; Language of the case: EN. The EUTM proprietor was granted registration of the word mark **ANTICO CASALE** as an EUTM for goods and services in Classes 29, 30 and 35. An application for a declaration of invalidity was filed pursuant to Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b), (c) and (g) EUTMR. The CD rejected the application for invalidity. The BoA dismissed the cancellation applicant's appeal. It found that the mark was not directly descriptive but merely allusive, was not a mere laudatory statement about the quality of the goods and was not deceptive. The cancellation applicant filed an action before the GC, relying on three pleas in law, alleging infringement of Article 59(1)(a) EUTMR in conjunction with (i) Article 7(1)(b) EUTMR, (ii) Article 7(1)(c) EUTMR, and (iii) Article 7(1)(g) EUTMR. **Deceptiveness**: it is settled case-law that, when a mark does not convey a sufficiently specific and clear message concerning the protected goods and services or their characteristics but, at the very most, only hints at them, there can be no deception in relation to those goods and services.

♦[T-844/16](#); **Klosterstoff**; *Alpirsbacher Klosterbräu Glauner GmbH & Co. KG v EUIPO*; EU:T:2017:759; Judgment of 26 October 2017; Language of the case: ES. The applicant sought to register the word mark **Klosterstoff** as an EUTM for goods and services in Classes 32 and 33. The examiner refused the application, on the basis of Article 7(1)(b), (c) and (g) EUTMR, as non-distinctive, descriptive and deceptive. The applicant filed an appeal before the BoA. The BoA dismissed the appeal. It found that the word 'Klosterstoff' would be understood, by the German-speaking public, as designating products containing alcohol, originating from a monastery or produced there. Therefore, the sign was non-distinctive, descriptive and deceptive. The applicant filed an action before the GC, relying on four pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) EUTMR, (iii) infringement of Article 7(1)(g) EUTMR, and (iv) ignorance of the Office's previous decision-making practice. The GC dismissed the appeal. The third plea was dismissed. While the applicant sought to register the sign for non-alcoholic beverages, the term 'stoff' meant 'alcohol'. Therefore, consumers were likely to believe that they were purchasing alcoholic beverages, even though they were not. Consequently, the sign was considered deceptive (para. 43).

F. Article 7(1)(h) and (i), 52(1)(a) EUTMR — emblems, etc.

[No entry]



G. Article 7(1)(j) and (k), 52(1)(a) EUTMR — geographical indication for wines and spirits — agricultural products and foodstuffs

[T-510/15](#); **TOSCORO**; *Roberto Mengozzi v EUIPO*; Judgment of 2 February 2017; EU:T:2017:54; Language of the case: EN.

| EUTM | Protected geographical indication |
|---------|-----------------------------------|
| TOSCORO | TOSCANO |

The EUTM proprietor (applicant before the GC) obtained registration of the word mark **TOSCORO** as an EUTM for goods in Classes 29 and 30 on 17 November 2003. An application for invalidity was filed pursuant to Article 59(1)(a) in conjunction with Article 7(1)(c), (g) and (k) EUTMR on 10 December 2012. The CD partly upheld the application for invalidity. The BoA partly upheld the EUTM proprietor’s appeal. It annulled that part of the cancellation decision that invalidated the challenged EUTM for *products for flavouring or seasoning foodstuffs, salad dressings*. The applicant before the GC relied on three pleas in law: (i) infringement of Article 7(1)(k) EUTMR and of Article 6(1) of Regulation (EU) No 1151/2012, (ii) error of assessment in the analysis of the similarity of the signs at issue in the context of Article 13(1)(b) of Regulation (EU) No 1151/2012, and (iii) infringement of Article 15 of the Agreement on the Trade-Related Aspects of Intellectual Property Rights of 15 April 1994. The GC dismissed the appeal. The first and the third plea were found inadmissible. For the second plea in law, the GC established that the concept of ‘evocation’ set out in Article 13(1)(b) of Council Regulation (EEC) No 2081/92 covered a situation where the term used to designate a product incorporated part of a protected designation, with the result that, when the consumer encountered the name of the product, the image triggered in his or her mind was that of the product the designation of which was protected (para. 31). In that regard, visual, aural and conceptual similarities were taken into account. There might be evocation of a protected designation even in the absence of any LOC between the goods concerned, since what mattered was, in particular, that an association of ideas regarding the origin of the products was not created in the mind of the public, and that a trader did not take undue advantage of the reputation of the protected geographical indication (PGI) (para. 31). Having regard to the visual and aural similarities between the signs at issue (paras 34-39), use of the sign **TOSCORO** amounted to an evocation of the PGI **TOSCANO** for certain goods in Class 29. The fact that the PGI might not be well known was irrelevant: the reputation of a PGI was not a condition for its protection (para. 48). Article 14(1) of Council Regulation (EEC) No 2081/92 provided for the refusal of the application for registration of any mark that was in one of the situations set out in Article 13 of that Regulation and relating to the same type of product. The product at issue therefore did not necessarily have to be identical to the product that was the subject of the PGI, but had to share some common characteristics with it (para. 44). In that regard, the GC confirmed that olive oil and olive creams were goods of the same type.

♦ [T-696/15](#); **TEMPOS VEGA SICILIA**; *Bodegas Vega Sicilia, S.A. v EUIPO*; Judgment of 9 February 2017; EU:T:2017:131; Language of the case: ES. The applicant sought to register the word mark TEMPOS VEGA SICILIA as an EUTM for *alcoholic beverages (except beers)* in Class 33. The examiner refused to register the trade mark as an EUTM pursuant to Article 7(1)(j) EUTMR. The BoA dismissed the applicant’s appeal, finding that the trade mark



applied for contained the whole Protected Designation of Origin (PDO) Sicilia, protected in the EU for wines, while the goods covered by the mark applied for did not originate from there. The applicant filed an action before the GC. The GC dismissed the appeal. The sign applied for was an expression consisting of, inter alia, the PDO Sicilia, which was clearly identifiable within the sign (not disputed). The GC confirmed that Article 7(1)(j) EUTMR applied without it being necessary to consider whether or not the mark for which registration was sought was liable to deceive the public or lead to a LOC regarding the origin of the product. **Family of marks:** the GC dismissed the applicant's claim, pointing out that the concept of a family of marks was only applicable in refusal proceedings based on relative grounds (paras 44-45). Article 102(2) of Regulation (EU) No 1308/2013 was not applicable, as the trade mark in question had not been registered before the PDO nor had previous use in good faith of the trade mark been proven. Priority could be claimed, where appropriate, only in respect of an existing mark and not for the registration of new marks that also consisted of the geographical indication in question but had not existed when protection was granted to the geographical indication (para. 52). A trade mark could be registered only individually, and the minimum five-year protection afforded by such registration was conferred on it only as an individual trade mark, even where several trade marks sharing one or more common and distinctive elements had been registered at the same time. Families of marks could not be registered and enjoy protection as such. The fact that a trade mark might belong to a family of marks was not relevant for the application of Article 102(2) of Regulation (EU) No 1308/2013 (para. 53). **Reputation:** the GC confirmed that the fact that a trade mark (or a previous trade mark belonging to the same family of marks) was widely known or enjoyed a reputation in the European Union was irrelevant in proceedings based on the absolute ground for refusal of Article 7(1)(j) EUTMR (paras 60-61). **Sound administration of justice:** the GC restated the case-law, according to which the Office had a duty to exercise its powers in accordance with the general principles of EU law, such as the principles of equal treatment and sound administration. The BoA had not erred in refusing registration of the trade mark on the grounds of Article 7(1)(j) EUTMR (paras 63-66).

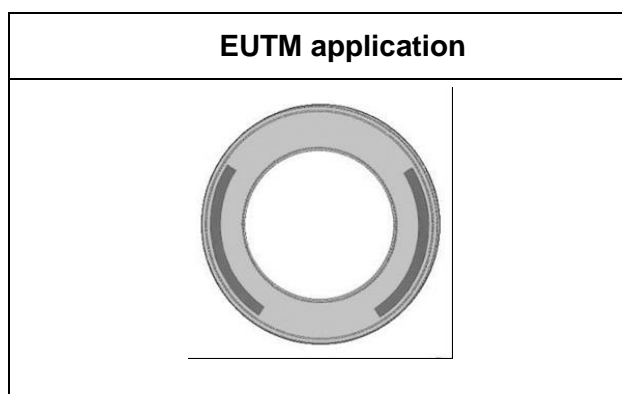
[T-206/16](#); **TRES TOROS 3**; *Bodegas Verdúñez, SL, v EUIPO*; Judgment of 28 September 2017; EU:T:2017:673; Language of the case: ES. The applicant sought to register the word mark **TRES TOROS 3** as an EUTM for *alcoholic beverages (except beers)* in Class 33. The Office refused registration of the EUTM application pursuant to Article 7(1)(j) EUTMR. The BoA dismissed the applicant's appeal, finding that the trade mark applied for contained the whole PDO **Toro**, protected in the EU for *wines*, while the goods covered by the mark applied for, namely *alcoholic beverages* (which include wines), did not originate from there. The PDO 'Toro' was in a central position within the EUTM application as it was included in the dominant element 'TOROS' and would be clearly identified by the relevant Spanish-speaking public. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(j) EUTMR and (ii) infringement of Article 42 EUTMR. The GC dismissed the appeal. Article 7(1)(j) EUTMR applied without it being necessary to consider whether or not the mark for which registration was sought was liable to deceive the public or lead to a LOC regarding the origin of the product. For the absolute ground for refusal of Article 7(1)(j) EUTMR to apply, it sufficed that the mark applied for contained or consisted of elements that enabled the geographical indication in question to be identified with certainty (para. 27). GC found that the PDO **Toro** was included in the central element 'TOROS' and therefore could be clearly identified by the relevant Spanish-speaking public in the EU. The PDO **Toro** enjoyed protection at EU level and therefore the relevant public was that of the EU, and not just in Spain. Since the word 'TOROS' was longer than the other elements of the sign and occupied an important position, the PDO **Toro** was also identifiable by the non-Spanish-speaking public. The appellant had not proven that the trade mark applied for would be seen as a semantic unity referring to 'bullfights' and in which the PDO **Toro** was not



perceived. The applicant had requested registration of the trade mark **TRES TOROS 3** for all the goods in Class 33 without distinction. Article 42 EUTMR did not allow the Office to dissect *ex officio* a broad category of goods applied for. Accordingly, the BoA had not erred in refusing registration of the trade mark on the grounds of Article 7(1)(j) EUTMR for the whole broad category of goods applied for, namely *alcoholic beverages (excepts beers)* (para. 64).

H. Article 7(3), 52(2) EUTMR — distinctiveness acquired through use

♦[T-81/16](#); **POSITION OF TWO CURVED STRIPS ON THE SIDE OF A TYRE**; *Pirelli Tyre SpA v EUIPO*; Judgment of 4 July 2017; EU:T:2017:463; Language of the case: EN.



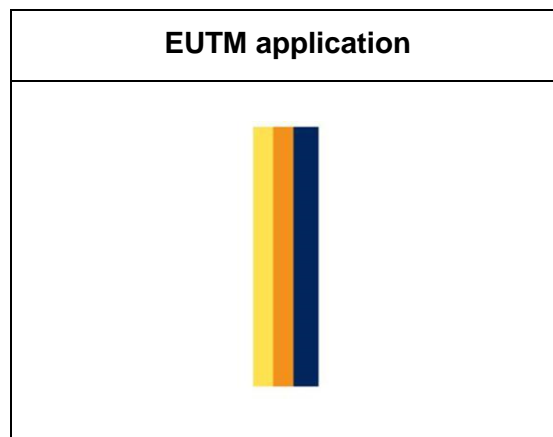
An application for registration of the figurative mark represented above as an EUTM was filed for *tyres, solid, semi-pneumatic and pneumatic tyres, rims and covers for vehicle wheels* in Class 12. The application was for a position mark described as ‘a pair of essentially equal curved strips positioned on the side of a tyre and running along its circumference’. The examiner rejected the application on the ground that the mark applied for was devoid of distinctive character within the meaning of Article 7(1)(b) EUTMR. The First BoA dismissed the appeal against the examiner’s decision and confirmed that the mark applied for was caught by the prohibitions of Article 7(1)(b) EUTMR. The applicant filed an appeal before the GC, relying on three pleas in law: (i) infringement of Articles 94 and 95 EUTMR, (ii) infringement of Article 7(1)(b) EUTMR, and (iii) infringement of Article 7(3) EUTMR. The GC dismissed the appeal. **Infringement of Article 7(3) EUTMR**: the GC confirmed the finding that the applicant had presented none of the necessary information — such as the market share held by the mark, the duration, extent or geographic area of use — that could prove use of the mark applied for. In addition, the GC noted that hardly any of the evidence related specifically to the mark applied for. Thus, none of the evidence submitted could show that the relevant persons or, at least, a significant proportion of them, identified, by virtue of the mark applied for, the goods covered by it (paras 79-81).

♦[T-150/16](#); **ECOLAB**; *Ecolab USA Inc. v EUIPO*; Judgment of 13 July 2017; EU:T:2017:490; Language of the case: EN. The applicant sought to designate the EU in its IR for the word sign **ECOLAB** for an extensive range of goods and services. The Office refused protection pursuant to Article 7(1)(b) and (c) EUTMR for the services in Class 42. The applicant appealed the partial refusal. The BoA dismissed the appeal on the same grounds, as well as on the basis that the applicant had not demonstrated acquired distinctive character through use pursuant to Article 7(3) EUTMR. The applicant filed an action before the GC, relying on



four pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) and Article 7(2) EUTMR in conjunction with Article 7(3) EUTMR, (iii) breach of the principles of equal treatment and the protection of legitimate expectations, and (iv) infringement of Article 94 EUTMR. The GC dismissed the appeal. **Acquired distinctiveness:** the GC went on to hold, in respect of the second plea, that proof of distinctive character acquired through use could not be furnished by the mere production of sales volumes, advertising material or documentation in respect of global turnover that does not specifically identify the services provided under the mark applied for (paras 52 and 53).

♦[T-612/15](#); **DEVICE OF THREE VERTICAL STRIPES**; *Basic Net SpA v EUIPO*; Judgment of 20 July 2017; EU:T:2017:537; Language of the case: IT.



The applicant sought to register the figurative mark depicted above as an EUTM for goods in Classes 18, 25 and 26. The examiner rejected the application on the ground that the mark applied for was devoid of any distinctive character within the meaning of Article 7(1)(b) EUTMR. The BoA dismissed the appeal filed against the examiner's decision, confirming that the mark applied for was caught by the prohibitions of Article 7(1)(b) EUTMR. The applicant filed an appeal before the GC, relying on two pleas in law: (i) infringement of Article 7(1)(b) EUTMR and (ii) infringement of Article 7(3) EUTMR. The GC dismissed the appeal. **Acquired distinctiveness:** as far as Article 7(3) EUTMR was concerned, the GC restated that, even though it would be excessive to request evidence of use for each of the Member States of the European Union, it was still necessary that at least a significant part of the relevant public would be capable of identifying the goods and services at issue as originating from a single undertaking (paras 82-84). The GC noted that acquired distinctive character had been proven only for France, Italy, the Netherlands and the United Kingdom. The affidavit reporting information about sales in other Member States had not been confirmed by any other evidence. In the light of the above, the GC confirmed the BoA finding that the evidence of use was not sufficient to prove that the mark at issue had acquired distinctive character in the relevant territory (paras 88-96).

♦♦[T-395/16](#); **WINDFINDER**; *Windfinder R & L GmbH & Co. KG v EUIPO*; Judgment of 20 July 2017; EU:T:2017:530; Language of the case: DE. The applicant sought to register the word mark **WINDFINDER** as an EUTM for goods and services in Classes 9, 35, 38, 41 and 42. The Office informed the applicant that registration of the EUTM application went against Article 7(1)(b) and (c) EUTMR. The applicant submitted its observations, and the examiner refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR for the abovementioned goods and services. The BoA dismissed the EUTM applicant's appeal, finding that the mark was descriptive and non-distinctive. The EUTM



applicant filed an action before the GC, claiming: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) and (c) EUTMR and (iii) infringement of Article 7(3) EUTMR. It requested that the contested decision be annulled and the appeal before the BoA be allowed. The GC annulled the contested decision for all goods and services except 'anemometers' in Class 9 and services related to meteorology in Class 42. Insofar as it annulled the decision, it allowed the appeal. With regard to the alleged infringement of Article 7(3) EUTMR, the GC confirmed the BoA's finding that the evidence submitted was not sufficient as it originated from the applicant itself without any reference to independent sources (para. 84). Finally, with regard to the request that the appeal before the BoA be upheld, the GC considered this an admissible alteration request in the sense of Article 72(3) EUTMR and decided accordingly (para. 87).

♦[T-704/16](#); **SCATTER SLOTS**; *Murka Ltd v EUIPO*; Judgment of 17 October 2017; EU:T:2017:728; Language of the case: EN. The applicant filed an application for registration as an EUTM of the word mark **SCATTER SLOTS** for services in Class 41. The examiner rejected the application for registration on the ground that the mark applied for fell under the grounds for refusal of Article 7(1)(b) and (c) EUTMR. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) EUTMR, and (iii) infringement of Article 7(3) EUTMR. The GC dismissed the appeal. **Acquired distinctiveness**: the GC rejected the applicant's arguments criticising the BoA for failing to find that the mark applied for had acquired distinctiveness through use under Article 7(3) EUTMR. It was acknowledged that the evidence submitted showed some use; however, it was not sufficient to show that the mark applied for had acquired distinctive character (paras 60-79).

♦[T-239/16](#); **perlage**; *Polskie Zdroje sp. z o.o. sp.k. v EUIPO*; Judgment of 28 November 2017; EU:T:2017:844; Language of the case: PL. The applicant sought to register the word mark **perlage** for goods and services in Class 32 (*mineral water*). The examiner refused to register the word mark as an EUTM on the grounds of Article 7(1)(c) EUTMR. The applicant filed an appeal against that decision. The BoA dismissed the applicant's appeal because of the descriptive character of the mark for the French-speaking public. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(3) EUTMR, and (iii) infringement of Article 7(1)(b) EUTMR. **Distinctiveness acquired through use**: the invoices submitted neither demonstrated that the relevant public perceived the mark as an indication of commercial origin nor proved use of the mark (para. 47). Regarding the Superior Taste Award 2010, the fact that some members of the jury had a French background could not demonstrate that the mark had acquired distinctiveness for French-speaking consumers. Moreover, distinctiveness had to be assessed taking into account the perception of the general public and not, as in this case, that of specialists (para. 48). The Superbrands (awards for brands that have earned an excellent reputation within the industry) concerned only the Polish market and therefore had no effect on recognition of the trade mark by the French-speaking public. Furthermore, even if the results of these national awards had benefited from worldwide diffusion, this could not establish distinctiveness acquired by use for French-speaking consumers (para. 49). **Lack of distinctiveness**: as one ground of refusal was sufficient, there was no need to examine this plea in law (paras 56-57).

♦[T-798/16](#); **REAL**; *Hanso Holding AS v EUIPO*; Judgment of 30 November 2017; EU:T:2017:854; Language of the case: EN. The applicant sought to register the figurative mark **REAL** as an EUTM for goods in Classes 29, 30 and 31. The Office refused registration of the EUTM application pursuant to Article 7(1)(b) and (c) EUTMR, as it was found to be



descriptive and devoid of distinctive character. The BoA dismissed the applicant's appeal against the examiner's decision. It found that the relevant public consisted of both average consumers and professionals who paid a high level of attention, that the mark was descriptive and that it was also devoid of distinctive character, insofar as the applicant had not submitted the evidence necessary to assess whether the contested trade mark had acquired distinctive character by prior use. The applicant filed an action before the GC, relying on four pleas in law: (i) infringement of Article 7(1)(c) in conjunction with Article 7(2) EUTMR, (ii) infringement of Article 7(1)(b) in conjunction with Article 7(2) EUTMR, (iii) infringement of Article 7(3) EUTMR, and (iv) infringement of Article 107 EUTMR. **Acquired distinctiveness:** if not corroborated by any other evidence, sales figures per se did not show that the public targeted by the goods perceived the trade mark at issue as an indication of commercial origin. In respect of the Member States for which neither declarations by professional associations nor market studies were submitted, proof of distinctive character acquired through use could not be furnished merely by producing sales figures. Furthermore, the sales figures provided by the applicant did not state whether they specifically concerned the contested mark (paras 49-51).

♦[T-332/16](#); **360°**; *Colgate-Palmolive Co. v EUIPO*; Judgment of 7 December 2017; EU:T:2017:876; Language of the case: EN. The applicant sought to register the word sign **360°** as an EUTM for goods in Class 21 corresponding to the description *toothbrush*. The examiner rejected the application on the grounds of Article 7(1)(b) and (c) EUTMR. The applicant filed a notice of appeal against the examiner's decision. The BoA dismissed the appeal, confirming that the word mark was descriptive and non-distinctive. Distinctiveness acquired by use was not proven. The applicant filed an action before the GC, relying on four pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b) EUTMR, (iii) breach of the principles of equal treatment and sound administration, and (iv) infringement of Article 7(3) EUTMR. **Distinctiveness acquired by use:** the word mark never appeared on its own but always associated with the trade mark **Colgate** and with other descriptive terms (para. 51). The BoA had been right to find that the territory in which the mark applied for did not have any distinctive character *ab initio* was the EU as a whole. Consequently, the acquisition of distinctive character by that mark had to be established in relation to each of the Member States (para. 56). As the evidence did not in any way show the relevant public's perception of the mark applied for on its own, the applicant had not proven that the mark applied for, taken purely on its own, had acquired distinctive character throughout the EU (paras 62 and 63).

♦[T-333/16](#); **360°**; *Colgate-Palmolive Co. v EUIPO*; Judgment of 7 December 2017; EU:T:2017:875; Language of the case: EN. The applicant sought to register the figurative sign **360°** as an EUTM for goods in Class 21, corresponding to the description *toothbrush*. The examiner rejected the application on the grounds of Article 7(1)(b) and (c) EUTMR. The applicant filed a notice of appeal against the examiner's decision. The BoA dismissed the appeal, confirming that the word mark was descriptive and non-distinctive. Distinctiveness acquired by use was deemed not proven. The applicant filed an action before the GC, relying on four pleas in law: (i) infringement of Article 7(1)(c) EUTMR, (ii) infringement of Article 7(1)(b), (iii) breach of the principles of equal treatment and sound administration, and (iv) infringement of Article 7(3) EUTMR. **Distinctiveness acquired by use:** the sign was always used in combination with the applicant's trade name and other descriptive elements (para. 56). As the evidence did not in any way show the relevant public's perception of the mark applied for on its own, the applicant had not proven that the mark applied for, taken purely on its own, had acquired distinctive character throughout the EU (paras 67 and 68).



♦ [T-304/16](#); **BET 365**; *bet365 Group Ltd v EUIPO*; Judgment of 14 December 2017; EU:T:2017:912; Language of the case: EN. The EUTM proprietor was granted registration of the word mark **BET 365** as an EUTM for goods and services in Classes 9, 28, 35, 36, 38, 41 and 42 on account of acquired distinctiveness under Article 7(3) EUTMR. An application for invalidity was filed pursuant to Article 7(1)(b) and (c) EUTMR. The CD dismissed the application for invalidity insofar as it found that the EUTM had acquired distinctive character through use. The BoA upheld the appeal. It held that the EUTM had, on its date of filing, not acquired distinctiveness through use in Denmark, Ireland, the Netherlands, Finland, Sweden and the United Kingdom. The EUTM proprietor had provided insufficient direct evidence of a link between the demonstrated commercial success or its advertising activities and the public's perception of the EUTM due to. The press articles mainly relied on did not relate to the relevant territory, and the figurative and colour signs shown therein did not correspond to the EUTM. Furthermore, the evidence related to use of the element 'bet365' for designating either the applicant itself or its website, but not to its use as a mark. Nor had the commercial data provided been apportioned among all the goods and services. There were no opinion polls, or assessments from chambers of commerce, consumer organisations or competitors to provide information in that regard, and the evidence supplied concerned only the services in Class 41 relating to betting and gambling per se. The EUTM proprietor filed an action before the GC, relying on a single plea in law: infringement of Article 7(3) EUTMR. Even though the EUTM proprietor expressly referred only to an infringement of Article 7(3) EUTMR, its plea in law also concerned infringement of Article 59(2) EUTMR. The invalidity proceedings based on absolute grounds for refusal directly referred to the absolute grounds for refusal set out in Article 7 EUTMR, and to the exception of the acquisition of distinctive character through use that moderates them, the only potential substantive difference between the two procedures being the time at which the acquisition of such distinctive character had to be assessed. Therefore, it was sufficient to give a ruling taking into account the situation existing on the date of filing of the invalidity request (paras 23-24). The examination was correctly limited to the abovementioned EU Member States and not extended to others with a public that had at least a passive knowledge of English. However, Cyprus and Malta should also have been taken into account, since they were already members of the EU on the date on which the proprietor sought registration of the EUTM. Distinctive character acquired through use had to be proven only for countries that were Member States of the EU at the time of filing of the application for registration of the EUTM (paras 32-35). The proprietor had submitted evidence only for betting and gambling services in Class 41. For the other goods and services, the BoA decision could not be annulled (para. 36). The BoA had erred in excluding figurative marks or marks composed of several word elements containing the EUTM (with different typography and colours) (para. 39). The use of the EUTM as a website name could constitute use 'as a trade mark' because: (i) only the applicant used the element 'bet365' for the marketing of gambling and betting services; (ii) the element was found in all the marks used to identify its services; (iii) its website was its main gambling and betting sales channel; (iv) in that sector, most of the marks used by online operators were inherently descriptive; and (v) betters and players were, in the very great majority of cases, regular customers (paras 43-44). Consequently, the number of connections to the applicant's website, the website's ranking in terms of the number of visits in various countries or the number of times the contested mark or its derived marks had been the subject of a search using internet search engines was an indication of acquired distinctiveness by use. The same applied to extracts of pages from the proprietor's website or other websites, in various languages, on which the contested mark or its derived marks appeared (para. 46). The use of the EUTM in press articles, in particular in association with betting odds and comparison of services, illustrated use of the EUTM as a trade mark and not exclusively as a company name (paras 49-52). The stake figures, advertising investment



(particularly that concerning sponsorship) and the sums paid to affiliate websites for directing players and betters to the applicant's website related either completely or essentially to gambling and betting services marketed by the applicant under the EUTM or its derived marks. Therefore, this evidence could not be dismissed with the argument that it could not be apportioned among the goods and services (para. 54).



III. Relative Grounds for Refusal/Invalidity

A. Article 8(1)(a), 53(1)(a) EUTMR — identical signs/g&s

[No entry]

B. Article 8(1)(b), 53(1)(a) EUTMR — likelihood of confusion

1. Likelihood of confusion (LOC)

♦[T-225/15](#); **medialbo / MediaLB**; *QuaMa Quality Management GmbH v EUIPO*; Judgment of 17 January 2017; EU:T:2017:10; Language of the case: DE.



| EUTM application | Earlier trade mark |
|------------------|--------------------|
| medialbo | MediaLB |

An opposition based on the earlier EUTM **MediaLB** (Classes 9, 41 and 42) was filed pursuant to Article 8(1)(b) EUTMR against the EUTM application **medialbo** (Classes 9, 37 and 41). The notice of opposition was accompanied by an application requesting the ‘change of name and address’ of the owner of the earlier mark. The Office informed the opponent (i.e. the other party before the GC) that it appeared that what the opponent actually wanted was a ‘transfer of ownership’ and not a ‘change of name and address’. Following this communication from the Office, the opponent indeed requested a transfer, this time using the correct form. The transfer of ownership was registered and the Office rejected the original application for a ‘change of name and address’. The OD partly rejected and partly upheld the opposition. Both parties appealed. The BoA rejected both appeals. With regard to Rule 17(4) of Implementing Regulation (EC) No 2868/95, infringement of which had been claimed by the EUTM applicant (i.e. the applicant before the GC), the BoA stated that it was sufficient if a transfer of ownership was requested the same day as the opposition was filed. The opponent’s request for a ‘change of name and address’ had been seen as an obvious request for a ‘transfer of ownership’ and had been rectified in the course of the proceedings (*falsa demonstratio non nocet*). Therefore, the required identity of opponent and owner of the earlier mark was deemed given at all times. With regard to Article 8(1)(b) EUTMR, the BoA confirmed the OD’s finding of a LOC for identical and similar goods. The applicant filed an action before the GC, raising two pleas in law: (i) infringement of Article 46(1) EUTMR and (ii) infringement of Article 8(1)(b) EUTMR. **With regard to Article 8(1)(b) EUTMR and a LOC**, it was apparent that the element ‘media’ was both the longest element and the only element with a clear meaning in both marks; it therefore could not be disregarded in a global assessment (paras 55-57). The signs were visually similar to a greater than average degree as they coincided in seven letters, which constituted the entire earlier mark (paras 58-61). Aurally, the beginnings of the marks were pronounced identically and their remaining parts were similar, which justified the assumption of a high degree of aural similarity (paras 62-63). Conceptually, the marks were similar if the consumers recognised the meaning of ‘media’; otherwise, the conceptual comparison remains neutral (para. 65). Even if the earlier mark were assumed to have a low level of distinctiveness, there was a LOC in light of the identical goods and services and the high similarity of the signs, even if there was an enhanced




degree of attention on the part of the relevant public (paras 68-70). Based on the foregoing, the appeal was dismissed. **LOC**

[T-399/15](#); **M&M Morgan & Morgan / MMG TRUST MIEMBRO DEL GRUPO MORGAN & MORGAN**; *Morgan & Morgan Srl International Insurance v EUIPO + Grupo Morgan & Morgan*; Judgment of 19 January 2017; EU:T:2018:192; Language of the case: EN.

| EUTM application | Earlier trade mark |
|---|--|
|  |  |

The applicant sought to register the figurative mark represented above as an EUTM for services in Class 36. An opposition based on the earlier figurative mark represented above, registered, inter alia, for services in Classes 35, 36 and 45, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition. The BoA annulled the OD's decision and upheld the opposition. It found that there was a LOC since the signs at issue bore a certain degree of similarity, the services covered were identical and consumers were more likely to identify the mark applied for by the word element 'morgan & morgan' than by the figurative element. The applicant filed an action before the GC, claiming infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. The BoA was right in considering that the relevant public was the general public, with an average degree of attention, since when the relevant public was made up of two categories of consumers, each having a different level of attention, the public with the lower level of attention had to be taken into consideration (para. 30). Regarding the comparison of the services, the BoA had not committed an error of assessment in concluding that the services in question were identical, even though the EUTM application covered the field of insurance in general, while the earlier mark covered more specifically financial assessment in terms of insurance. According to case-law, services could be regarded as identical where those covered by the earlier mark were included in a more general category designated by the mark applied for (paras 33-40). The GC confirmed visual, aural and conceptual similarity between the signs, although not to a high degree. Nevertheless, due to the presence in both signs of the word element 'morgan & morgan', which had inherent distinctive character, and in view of the identity of the services, the BoA had been right to conclude that there was a LOC (paras 41-64). **LOC**

[T-701/15](#); **LUBELSKA / Lubeca**; *Stock Polska sp. z o.o. v EUIPO*; Judgment of 19 January 2017; ECLI:EU:T:2017:16; Language of the case: EN.

| EUTM application | Earlier trade mark |
|---|----------------------|
|  | <p>Lubeca</p> |

The applicant sought to register the figurative mark represented above as an EUTM for goods in Class 33. An opposition filed pursuant to Article 8(1)(b) EUTMR was directed



against all the goods applied for. It was based on the earlier word mark represented above and registered for the same goods in Class 33. The OD upheld the opposition in its entirety. The BoA dismissed the appeal. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. **Level of attention of the relevant public:** the GC rejected the applicant’s argument that the level of attention of the average German consumer of *alcoholic beverages* was higher than average. These goods were for everyday consumption and normally of wide distribution, ranging from supermarkets to restaurants. The consumer of alcohol was a member of the general public, who was deemed to be reasonably well informed and reasonably observant and circumspect, and who would demonstrate an average level of attention when purchasing such goods (para. 22). This assessment was not called into question by the limitations on access to alcoholic beverages resulting from restrictions on their sale depending on the age of consumers (para. 23). The arguments regarding high price and the occasional nature of the purchase of *alcoholic beverages* concerned only certain beverages. However, the goods in question were not limited to such goods (para. 24). The fact that the purchase of alcoholic beverages was determined by the individual and specific taste of purchasers was equally applicable to virtually any foodstuff or beverage as well as to many other goods for mass consumption (para. 25). **Similarity of the signs:** the figurative elements constituting a crown would be perceived by the consumer as essentially decorative, or even laudatory. The element of a crown was commonly used in the sector of (alcoholic) beverages (para. 33). Visually and aurally, the similarities prevailed over the differences (paras 38 and 39). The applicant had failed to establish that at least one of the two word elements at issue had a clear and specific meaning for the relevant German consumer (paras 41-43). The visual and aural similarities of the signs at issue were not outweighed by conceptual differences, particularly because, according to the case-law, when the goods concerned, such as those at issue in this case, were also ordered orally for consumption in bars, restaurants or nightclubs, the aural similarity between the marks at issue was, by itself, sufficient to give rise to a LOC (para. 44). **LOC**

♦[T-258/08](#); **DIACOR / Diacol PORTUGAL**; *Matthias Rath v EUIPO*; EU:T:2017:22; Judgment of 24 January 2017; Language of the case: EN.

| EUTM application | Earlier mark |
|------------------|---|
| DIACOR |  |

The existence of a LOC between the two marks in this case had been established by the OD and confirmed by the BoA and the GC. The goods at issue were *antitussive medicines* versus *food supplements, dietetic supplements, vitamins, minerals*. With regard to the succession of laws and the substantive law applicable, the GC held that, in view of the time at which the events occurred, this case was still governed by Council Regulation (EC) No 40/94, at least as regards provisions that were not strictly procedural (para. 15). The GC confirmed that the BoA had been right not to oblige the opponent to submit translations in the language of the proceedings (EN) of the evidence of use in Portuguese: ‘in order to be able actually to exercise his rights of defence with regard to that evidence, it is not necessary for the applicant to be able to understand fully all the details in that evidence. It is sufficient, in that regard, for a person who has a knowledge of the language of the proceedings before EUIPO to be able to identify and understand the relevant information in the documents submitted as proof of use’ (para. 21). The GC considered that the fact that a product bearing





the name 'DIACOL' was referred to throughout the relevant period in an encyclopedia listing pharmaceutical products marketed on the Portuguese market did not in itself prove that the mark affixed to that product had been put to genuine use in Portugal during the relevant period. However, it might be an indication of such genuine use, in particular where there was additional evidence, as in this case (para. 40).

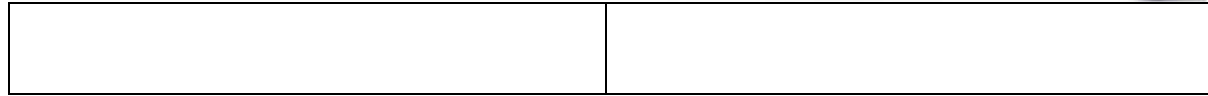
♦[T-88/16](#); **ALPHAREN / ALPHA D3**; *OPKO Ireland Global Holdings, Ltd v EUIPO*; Judgment of 26 January 2017; EU:T:2017:32; Language of the case: EN.

| EUTM application | Earlier trade mark |
|------------------|--------------------|
| ALPHAREN | ALPHA D3 |

The BoA decision had been annulled in part by judgment of 09/02/2011, [T-222/09](#), Alpharen, EU:T:2011:36 because the BoA had infringed Article 95(1) EUTMR by making its own investigations on the therapeutic indication of the pharmaceutical goods under comparison. The case was remitted to the BoA, but it was found that the rapporteur of the BoA concerned had already been involved in the first (annulled) decision. This led to a second annulment in the judgment of 03/07/2013, [T-106/12](#), Alpharen, EU:T:2013:340. The case was remitted to a different BoA. However, it transpired, after this BoA had adopted its decision, that its chairperson had also been a member of the BoA that had taken the first decision. Another appeal was lodged before the GC but the BoA revoked its decision and the case was considered devoid of purpose. A new decision, almost identical to the revoked decision, was adopted by a BoA in which no member had been involved in the previous proceedings. On the merits, the BoA confirmed that there was a LOC in view of the similarity of the pharmaceutical goods, which were both aimed at treating kidney disorders, and the similarity of signs for patients (but not for health professionals, who would consider 'Alpha' to be descriptive). **Burden of proof:** the GC confirmed that there was no obligation for the opposing party, in opposition proceedings, to adduce evidence on the similarity of the goods at issue (paras 58-61). **LOC:** pharmaceuticals have only a low degree of similarity on account of their common nature unless their therapeutic indication is the same, in which case the degree of similarity is high (paras 79-82). The fact that the public was mixed meant that the descriptive character of the component 'Alpha' for health professionals could be ignored when assessing whether there was a LOC for patients (paras 100-104). All relevant factors supported finding a LOC (para. 110). **LOC**

♦[T-19/15](#); **wax by Yuli's**; *Yuleidy Caridad Gómez Echevarría v EUIPO*; Judgment of 1 February 2017; EU:T:2017:46; Language of the case: ES.

| EUTM | Earlier trade marks |
|---|--|
|  | <p>1) </p> <p>2) MADWAX</p> |



The EUTM proprietor was granted registration of the figurative mark represented above as an EUTM for goods and services in Class 25. An application for invalidity was filed pursuant to Article 60(1)(a) in conjunction with Article 8(1)(b) EUTMR. The CD upheld the application for invalidity on the basis of the earlier word mark **MADWAX**. It considered it unnecessary to assess the case on the basis of the remaining earlier mark. The BoA dismissed the EUTM proprietor's appeal. It found that there was a LOC between the contested EUTM and the two earlier marks. The proprietor filed an action before the GC, relying on five pleas in law: (i) infringement of Article 71(1) EUTMR in conjunction with Article 41(2) of the Charter of Fundamental Rights; (ii) infringement of Article 8(1)(b) EUTMR insofar as the application for invalidity constituted an abuse of rights; (iii) and (iv) incorrect application and interpretation of Article 60(1)(a) in conjunction with Article 8(1)(b) EUTMR; and (v) incorrect application of Rule 94(1) and (7) of Implementing Regulation (EC) No 2868/95 in conjunction with Article 109(1) EUTMR. The GC dismissed the appeal. **LOC**: the relevant public was the English-speaking consumer from the general public with at least a normal degree of attentiveness (paras 48-52). The GC confirmed that the term 'wax' had limited inherent distinctiveness but was the dominant element of both the contested mark and the figurative earlier mark. Since the remaining elements were insignificant for the overall impression of the signs, similarity could be assessed solely on the basis of this dominant element (paras 71-83 and paras 93-94). The signs were visually similar, taking into account the significant impact of the term in common due to its size and position; such impact was not offset by the remaining elements (paras 85-86). After considering that 'by Yuli's' might not even be pronounced, the GC found the signs aurally similar, at least to an average degree (paras 87-89). They were also highly similar conceptually because of the coincidence in their dominant verbal element. The figurative elements of the marks and the additional verbal elements in the contested mark were conceptually insignificant because of their link to the goods involved (paras 91-92). Considering the interdependence principle, there was a LOC between these marks (paras 100-104). **LOC**

♦ [T-509/15](#); **Premeno / Pramino**; *Kessel medintim GmbH v EUIPO*; Judgment of 3 February 2017; EU:T:2017:60; Language of the case: DE. An opposition against the EUTM application for the word mark **Premeno** for *vaginal ovules* in Class 5 was upheld on the basis of the earlier word mark **Pramino**, registered in Germany for *prescription medicines*. Use of the earlier mark was proven for *prescription medicines, namely hormonal contraceptives*. The goods were considered identical, the marks were considered similar, and a LOC was affirmed. In the appeal against this decision, the EUTM applicant requested a limitation of the goods applied for to *non-prescription vaginal ovules against vaginal dryness and vaginal infections*. When dismissing the appeal, the BoA considered the limitation inadmissible and upheld the finding of a LOC (first BoA decision). By judgment of 08/11/2013 ([T-536/10](#), *Premeno*, EU:C:2014:2436), the GC annulled the BoA decision, considering the restriction of goods admissible. That judgment was confirmed by the CJ (11/12/2014, C-31/14 P, *Premeno*, EU:C:2014:2436). The case was remitted to the BoA, which based its examination on the list of goods as restricted by the applicant. It found a LOC. The EUTM applicant filed an action before the GC, claiming infringement of Article 94 EUTMR, with the reasoning that the BoA had not given it an opportunity to comment on the judgment and make a further limitation. It also claimed infringement of Article 8(1)(b) EUTMR contesting the LOC. The GC rejected both pleas. With regard to the alleged infringement of Article 8(1)(b) EUTMR, the GC decided that the goods were similar to an average degree because they had different therapeutic indications (para. 69 with references to further case-law). The signs were visually



and aurally similar (para. 71). There was a LOC given the interdependence of the factors to be taken into consideration (para. 76). **LOC**



T-82/16; **TRIPLE EVOLUTION / Evolution**; *International Gaming Projects Ltd v EUIPO*; Judgment of 9 February 2017; EU:T:2017:66; Language of the case: EN.

| EUTM application | Earlier trade mark |
|---|--|
|  | <p data-bbox="1015 622 1134 656">Evolution</p> |

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 28 and 41. An opposition based on the earlier EU word mark **Evolution**, registered for goods and services in Classes 28 and 41, was filed pursuant to Article (8)(1)(b) EUTMR. The OD upheld the opposition and rejected the application. The applicant filed a notice of appeal pursuant to Articles 66 to 68 EUTMR. The BoA dismissed the appeal. It found that there was a LOC between the signs. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the action. The relevant public was composed of the general public with an average level of attention and a professional public with a higher level of attention (para. 27). The goods and services at issue were identical (para. 29). Conceptually, the two signs coincided in the word element ‘Evolution’, which was the only element of the earlier mark and was entirely reproduced in the mark applied for (para. 43). Furthermore, the word elements ‘triple’ and ‘evolution’ in the contested mark appeared in upper case letters, in a font that was slightly stylised and close to being printed characters, the edges of which were rounded and outlined in black in order to produce a slight effect of depth. Considering the arrangement of both those elements, which slightly crossed each other in a play of perspective, there was no dominant element. The figurative elements of the contested mark, namely the position, colour, outline and stars on the word elements, would be perceived as mere decoration (paras 36-41). Consequently, the GC found that the marks were visually similar, as correctly stated by the BoA. Aurally, the signs were similar overall because of their common word element ‘evolution’, the pronunciation of which would not be altered by the presence of the word element ‘triple’ (paras 46-47). Conceptually, the common word element ‘evolution’ would be perceived by the relevant public as referring to the process of unrolling, opening out or revealing, or a movement of change or position (para. 48). The meaning of this word would not be changed, for the relevant public, by the presence of the word element ‘triple’, which simply evoked the multiplication by three of the element ‘evolution’ (para. 54). Therefore, the signs were conceptually identical. As to the global assessment, the goods and services were identical, and the marks at issue, taken as a whole, and despite the additional elements in the mark applied for, showed a certain degree of visual, aural and conceptual similarity (para. 58). As a result, there was a LOC. **LOC**




[T-568/15](#); **2 STAR 2S (fig.) / ONE STAR (fig.) et al.**; *Giuseppe Morgese, Pasquale Morgese, Felice D’Onofrio v EUIPO*; Judgment of 15 February 2017; EU:T:2017:78; Language of the case: EN.

| EUTM application | Earlier trade marks |
|---|--|
|  |  |

The applicant sought to register the figurative mark represented above as an EUTM for goods in Classes 9, 18 and 25. An opposition based on the earlier figurative marks represented above, registered for goods and services in Classes 18, 25 and 35, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition on the basis of Article 8(1)(b) EUTMR and rejected the EUTM application in its entirety. The BoA dismissed the applicant’s appeal. It found that the goods in Classes 18 and 25 were identical and there was a certain degree of similarity between the goods in Class 9 and the opponent’s services in Class 35. Further, the BoA found that, having regard to the very similar structure of the signs at issue and to the degree of visual, aural and conceptual similarity between them, there was a LOC between the signs for the purposes of Article 8(1)(b) EUTMR. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal, emphasising in particular the similarity between goods and retail services of those goods (paras 38-46). Furthermore, the GC found an above average degree of visual similarity between the signs at issue, due to their same overall structure, consisting, in essence, of three elements. The GC noted that the position and design of the star-shaped device were identical in all three marks and formed, in conjunction with the word ‘star’, an element that was common to all the signs at issue. This common structure was not altered by the impression created by the additional element placed at the top of the contested sign (para. 54). The GC further explained that it could not automatically be ruled out that the signs were similar if elements in which they coincided were distinctive only to a low degree. Within the signs at issue, the ‘star’ device took up a large part of the signs, contributed strongly to the overall structure of all of those signs and was therefore in a highly visible position. Therefore, it could not be perceived as being of secondary importance (paras 58-61). Accordingly, the GC found an average degree of aural and conceptual similarity between the marks (paras 69 and 75). It established that the common element ‘star’, owing to its position in the sign or its size, determined, to a large extent, the overall impression created by the signs at issue (paras 71-74). **LOC**




[T-18/16](#); **De Giusti ORGOGLIO / ORGOGLIO**; Judgment of 16 February 2017; *DMC Srl v EUIPO - Etike' International Srl*; EU:T:2017:85; Language of the case: IT.

| EUTM application | Earlier trade mark |
|---|--------------------|
|  | <p>ORGOGLIO</p> |

The applicant sought to register the figurative mark represented above as an EUTM for, inter alia, *beers* in Class 32 and *wines and alcoholic beverages* in Class 33. An opposition based on the earlier EU word mark **ORGOGLIO**, covering, inter alia, *beers* in Class 32 and *alcoholic beverages* in Class 33, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition. The Fifth Board of BoA dismissed the appeal filed against the above decision and confirmed that there was a LOC between the marks at issue. The applicant filed an action before the GC. The applicant put forward one plea in law: infringement of Article 8(1)(b) EUTMR. The GC first confirmed, contrary to the applicant's opinion, that the relevant public was the public at large in the EU with an average level of attention (paras 22-26). The GC then dismissed the applicant's argument that the goods in question were similar to an average degree and confirmed that they were identical (paras 27-30). As far as the comparison of the signs was concerned, the GC noted that, although, visually, the element 'De Giusti' stood out in the mark applied for, due to its size and distinctiveness, the word 'ORGOGLIO' was not negligible in the overall impression of that mark. The GC dismissed the applicant's argument that the Italian word 'ORGOGLIO' (pride) was descriptive of the goods at issue, in particular wines: it was not directly descriptive of any characteristic of those goods (paras 33-37). The GC confirmed that, visually, the signs were moderately similar, taking into account in particular the fact that they coincided in the word element 'ORGOGLIO', which constituted the earlier mark in its entirety (paras 33-37). The GC also confirmed the finding that the signs showed a certain degree of similarity from the aural and (for the Italian-speaking consumers) conceptual point of view (paras 46-57). In the light of the foregoing, the GC found that the BoA had not committed any error in finding that there was a LOC between the marks in question. **LOC**

[T-351/14](#); **GATEWIT / Wit software et al.**; *Construlink – Tecnologias de Informação SA v EUIPO*; Judgment of 17 February 2017; EU:T:2017:101; Language of the case: EN.

| EUTM application | Earlier rights |
|------------------|--|
| <p>GATEWIT</p> | <p>1)  software</p> <p>2) WIT-SOFTWARE, CONSULTORIA E SOFTWARE PARA A INTERNET MÓVEL, S.A.</p> |



The applicant sought to register the word mark **GATEWIT** as an EUTM for services in Class 42. An opposition based on the earlier figurative mark represented above, registered for goods and services in Classes 9, 38 and 42, and on company name **WiT-Software Consultoria para a Internet Móvel SA**, was filed on the grounds of Article 8(1)(b) and Article 8(4) EUTMR. The OD dismissed the opposition. The BoA upheld the opponent’s appeal. The applicant filed an action before the GC. The head of claim seeking a declaration from the GC that the trade mark application was fully sustained sought to obtain statements of law from the GC and, therefore, was inadmissible (para. 24). A party had to be given the opportunity of referring to national judicial decisions for the first time before the court, given that the BoA was being criticised, not for failing to take account of elements of fact set out in a specific national decision, but for infringing the EUTMR (para. 29). However, in the present case, the judgment of the Lisbon court was irrelevant as the legal provisions applied and their interpretation differed from the EUTMR. For comparing the services and identifying the relevant public, only the list of services as set out in the application mattered and not the applicant’s assertions relating to the specific services in respect of which it had used or intended to use the mark applied for (para. 49). Within the EU, computer hardware (computers, tablets, smartphones, etc.) and computer products (software, etc.) were, for the most part, standardised goods that were easy to use, were not highly technical, and were widely distributed in all types of stores at affordable prices. To that extent, they were everyday consumer goods intended for the general public. Similarly, computer consultancy services might be provided to the general public, and there was no reason to find that the consumer’s level of attention would be higher than normal (paras 52-53). However, when a consumer did not purchase an already commercially available standard product, but turned to a supplier specialising in the design, creation, research and development of computer programmes, he or she was looking to obtain a product to meet a specific need; this involved significant interaction with the supplier and was, consequently, more technical and more expensive than a standard product. Those services were most often aimed at specialists and dealers whose degree of attentiveness was generally high. Although some consumers from the general public might occasionally make use of computer design and programming services, their degree of attentiveness would then be higher than normal, because such services were specialised, were not purchased every day and represented a significant financial investment (para. 54). The part of the relevant public that specialised in computing would break down the EUTM application into the elements ‘gate’ and ‘wit’ and perceive the element ‘gate’ as descriptive, while the term ‘wit’ would be perceived as fanciful term since its meaning in English was not widely known and was not applicable to inanimate objects (paras 73-75). Due to the shared element ‘wit’, the signs were visually similar to a normal degree and not merely to the low degree found by the BoA; this was not affected by the fact that the EUTM application began with ‘gate’ as that beginning was descriptive (paras 81-84). For the same reasons, the signs were aurally similar (para. 90). The conceptual comparison remained neutral because the element ‘wit’ would be perceived as fanciful, given that consumers specialising in computing would be unable to attribute a specific meaning to it in relation to the relevant services (paras 96-97). There was a LOC despite the higher level of attention paid by the relevant public, as the services were identical and the signs were similar, differing only in elements of weak distinctive character (para. 106). As the opposition was upheld under Article 8(1)(b) EUTMR, it was irrelevant to examine infringement of Article 8(4) EUTMR. **LOC**

[T-596/15](#); **POCKETBOOK / POCKET**; *Batmore Capital Ltd v EUIPO*; Judgment of 17 February 2017; EU:T:2017:10; Language of the case: EN.

| | |
|------------------------------|---------------------------|
| IR designating the EU | Earlier trade mark |
|------------------------------|---------------------------|



The international registration (IR) holder designated the EU as a territory to be covered by its international registration for the figurative mark represented above for goods in Class 9. An opposition based on earlier French marks represented above, registered for goods and services in Classes 9, 16, 38 and 41, and on the domain name **pocket.fr**, was filed on the grounds of Article 8(1)(b) and Article 8(4) and (5) EUTMR. The OD upheld the opposition. The BoA found LOC on account of the similarities between the signs and the goods and services. It held that there was a certain degree of similarity between the various goods and services concerned, in the sense that the average consumer was likely to assume that the content provider, a publishing house that offers electronic publications, for example, would also provide the necessary hardware to reproduce or display those publications. The GC dismissed the action. **Similarity of the G&S:** the GC confirmed that *portable and handheld digital electronic devices* complemented data carriers and could be sold in the same retail outlets (paras 44 and 50-52). The *portable and handheld digital electronic devices* also complemented the online publication services (para. 53). **Similarity of the signs:** the signs were similar visually, aurally and conceptually insofar as they shared the dominant element ‘Pocket’, despite this term being of weak distinctive character for the goods covered by the international registration and some of the goods covered by the earlier mark (paras 67-71 and 74-76). **LOC:** the argument regarding the coexistence of many marks containing the element ‘Pocket’ was dismissed because the applicant had merely referred to extracts from trade mark registers (paras 83-84). **LOC**

[T-622/14](#); **IWEAR / INWEAR**; *Lauritzen Holding AS v EUIPO*; Judgment of 7 March 2017; EU:T:2017:143; Language of the case: EN.

| EUTM application | Earlier trade mark |
|------------------|--------------------|
| IWEAR | INWEAR |


The OD partially upheld the opposition based on Article 8(1)(b) EUTMR. The BoA dismissed the applicant’s appeal, finding a LOC for the non-English-speaking general public in the EU between the conflicting marks **IWEAR** and **INWEAR** for identical and similar goods and services in Classes 18 and 25. The GC fully confirmed the BoA’s findings. In the light of the (uncontested) identity or similarity between the conflicting goods (para. 22), the high similarity of the signs (para. 34), and the average degree of distinctive character of the earlier mark (para. 41), there would be a LOC between the conflicting marks (para. 38) for the relevant public, composed of general consumers within the EU, displaying an average degree of attention (para. 21) and including non-English-speaking consumers (para. 29). The non-English-speaking public, in particular, could not break the signs down into elements that had a clear meaning to them (para. 25) nor perceive the sign as being composed of different, meaningful elements (para. 30). **LOC**

[T-504/15](#); **CAMISERIA LA ESPAÑOLA / REPRES 2 BANDERAS CRUZADAS**; *Rafhaelo Gutti, SL v EUIPO*; Judgment of 8 March 2017; EU:T:2017:150; Language of the case: ES.

| EUTM application | Earlier trade mark |
|---|--|
|  |  |

The applicant sought to register the figurative mark represented above as an EUTM for goods in Class 25. The BoA confirmed the first-instance decision and refused the EUTM application following an opposition based on the earlier Spanish figurative mark represented above. The goods were identical and the BoA found that the relevant public in Spain would have an average degree of attention. The verbal element of the contested mark **CAMISERIA LA ESPAÑOLA** indicated the geographical origin and the kind of goods and therefore was not distinctive. The coincidences in the figurative element, which was distinctive, and the identity of the goods, were sufficient to conclude that there was a LOC in this case. The applicant filed an action before the GC, claiming the infringement of Article 8(1)(b) EUTMR. The GC confirmed the BoA’s decision and concluded that there was a LOC within the meaning of Article 8(1)(b) EUTMR. **Relevant public:** the GC confirmed that the relevant public consisted of the Spanish general public with an average level of attention (para. 24). The limited distinctiveness of the verbal element ‘CAMISERIA LA ESPAÑOLA’ was also confirmed by the GC (para. 34). The marks were visually similar to an average degree (para. 49) and conceptually similar (para. 57). They could not be compared aurally (para. 39) because of the figurative elements of the marks, which consisted of two crossed flags with very similar features (para. 43-46). The differences between these elements were likely to go unnoticed by consumers (para. 47) and the limited distinctiveness of the verbal element did not introduce any relevant difference. The GC acknowledged that the visual perspective was particularly relevant for goods in Class 25 (para. 60). Therefore, the GC concluded that, given the average degree of similarity between the signs and the identity between the goods, there was a LOC between the trade marks in question (para. 64). **LOC**

[♦T-216/16](#); **Le Val / VIÑA DEL VAL et al.**; Judgment of 23 March 2017; *Vignerons de la Méditerranée v EUIPO*; EU:T:2017:201; Language of the case: FR.


| EUTM application | Earlier trade mark |
|---|---|
|  | <p data-bbox="1026 1776 1230 1809">VIÑA DEL VAL</p> |

The applicant sought to register the figurative mark represented above as an EUTM for goods in Class 33. An opposition based on the earlier word mark **VIÑA DEL VAL**, registered for goods in Class 33, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the



opposition. The BoA confirmed the OD's finding that there was a LOC in the English-speaking parts of the EU in view of the identity/similarity of the goods and the fact that the dominant element 'VAL' of the earlier mark coincided with the dominant element of the mark applied for. The GC dismissed the action. On the substance, the only point of discussion was the similarity of the signs. The GC noted that the element 'VAL' had no clear meaning in English (at most a poetic meaning, para. 35), that the term 'VIÑA' was distinctive only to a low degree (para. 62), and that the figurative element of the contested mark was essentially ornamental (para. 52). It also stated that consumers of alcoholic beverages paid less attention to decorative elements (para. 58). The signs were visually and aurally similar to an average degree (paras 70 and 78) but had elements of conceptual dissimilarity — the earlier mark referred to wine, while the contested mark denoted religion and French origin (para. 86). The conceptual differences did not, however, offset the similarities (para. 95). There was LOC, even if the signs denoted different geographical rather than business origins (para. 100). **LOC**

[T-538/15](#); **REGENT UNIVERSITY**; *Regent University v EUIPO*; Judgment of 28 March 2017; EU:T:2017:226; Language of the case: EN.


| EUTM application | Earlier trade mark |
|-------------------|---|
| REGENT UNIVERSITY |  |

The applicant was granted registration of the word mark REGENT UNIVERSITY as an EUTM for services in Class 41. An application for invalidity was filed pursuant to Article 60(1)(a) in conjunction with Article 8(1)(b) EUTMR. The CD declared the registration of the contested mark invalid for all the services covered by it. The applicant filed a notice of appeal under Articles 66 to 71 EUTMR against the CD's decision. The BoA dismissed the appeal. It found that there was a LOC between the marks at issue on the part of the relevant public. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 60(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR. The GC dismissed the appeal. The GC pointed out that the relevant public was the public of the United Kingdom because the earlier trade mark was registered there. That public was also made up of professionals and students with a higher than average level of attention — either high or relatively high (para. 24). The services covered by the marks at issue were identical (para. 25). Visually, the BoA had correctly found that the common element 'regent', which was also the distinctive and dominant element of both signs, clearly outweighed the differentiating elements, without there being any need to attach importance to the apostrophe and letter 's' present in the earlier trade mark (para. 57). Aurally, the GC found that the signs at issue were similar to a normal degree because their pronunciation was the same as a result of the fact that the syllables 're' and 'gent' appeared at the beginning of both signs and constituted their distinctive and dominant element (para. 58). Conceptually, the word 'regent' common in both signs might be understood either in a general sense, namely as a person who rules or governs in the stead of another, whether a minor or legally incapacitated, or as a reference to the Prince Regent and future King George IV (para. 59). With regard to the elements 'college' in the earlier trade mark and 'university' in the contested mark, the GC pointed out that they were conceptually similar, even for a public with a high level of attention, given that they both referred to higher education (para. 60). Therefore, the two



signs were conceptually similar. The earlier mark possessed a normal degree of inherent distinctiveness. To conclude, the global assessment confirmed the BoA's conclusion that there was a LOC between the marks (para. 80). **LOC**

♦[T-387/15](#); **J AND JOY / joy SPORTSWEAR**; *J & Joy SA v EUIPO*; Judgment of 29 March 2017; EU:T:2017:233; Language of the case: EN.


| EUTM application | Earlier trade mark |
|------------------|--|
| J AND JOY |  |

The applicant sought to register the word mark **J AND JOY** as an EUTM for goods and services in, inter alia, Classes 18 and 25. An opposition based on the earlier German figurative mark represented above and registered for goods and services in Class 25 was filed pursuant to Article 8(1)(b) EUTMR. The OD partly upheld the opposition, considering that there was a LOC for some of the contested goods in Classes 18 and 25. The BoA dismissed the applicant's appeal. It found that there was a LOC, given the identity or similarity between the goods in question, the overall similarity between the signs at issue and the average distinctive character of the earlier trade mark. The applicant filed an action before the GC, relying on several plea(s) in law that related to: (i) the relevant public, (ii) the degree of attention, (iii) the comparison of the goods, (iv) the comparison of the marks, including the distinctiveness and dominance of the common element, (v) the inherent distinctiveness of the earlier mark, and (vi) the purported reputation of the contested mark. The GC dismissed the appeal, finding that the BoA had not erred in finding a LOC for the goods within the scope of the appeal. **Likelihood of confusion:** the GC began examination of the LOC by clarifying that the relevant public was made up of German consumers, given that the earlier mark on which the contested decision had been based was a German trade mark (paras 17-21). Next, the GC dismissed the applicant's argument that the degree of attention paid to the goods was higher than average because the goods concerned were aimed at 'young and trendy' consumers. In so doing, the GC confirmed that the trade mark applicant's commercial strategy was not determinative of the degree of attention; rather, this had to be assessed on the basis of the perception of the average consumer of the category of the goods concerned (paras 22-29). Regarding the comparison of the goods, the GC upheld the BoA's conclusions, confirming that the comparison had to be made between the goods listed in the specifications of the relevant marks and not the goods on which the marks were actually used (paras 30-35). Turning to the comparison of the marks, the GC supported the BoA findings that the element 'JOY' was of average distinctive character for the German public. 'JOY' was not necessarily understood by the relevant German consumer. Further, even if they knew English, it was likely that such German consumers would make an association with the female first name Joy rather than with the idea of happiness (paras 39-47). The GC considered that 'JOY' dominated the earlier mark due to its relative size and position (paras 48-51). It also agreed with the BoA's assessment of an average degree of visual and aural similarity. In doing so, it referred to the dominant position of 'JOY' in the earlier mark, the secondary nature of 'J' and 'AND' in the contested mark and the secondary role of 'sportswear' in the earlier mark, which would not be pronounced when consumers referred to that mark (paras 52-73). Conceptually, the applicant had contended that there was a difference between the marks because 'joy' in the earlier mark highlighted the idea of happiness, and 'sportswear' described sports clothing. By contrast, the contested mark **J AND JOY** alluded to a young couple enjoying life, because of the association with the male



first name ‘Jay’ and the female first name ‘Joy’, and the wordplay on the English term ‘enjoy’. The GC rejected this and concluded that the German consumer would attribute significance only to the term ‘joy’ in the contested trade mark (paras 74-81). When assessing the LOC, the GC first clarified that an opponent was not required to establish the inherent distinctiveness of the earlier mark. It also confirmed that the purported reputation of the **contested** mark was not relevant for analysing the LOC (paras 84-95). It went on to conclude that the BoA had not erred in finding that there was a LOC between the signs at issue for the relevant goods. **LOC**

♦[T-388/15](#); **JN-JOY / joy SPORTSWEAR**; *J & Joy SA v EUIPO*; Judgment of 29 March 2017; EU:T:2017:232; Language of the case: EN.



| EUTM application | Earlier trade mark |
|------------------|--|
| JN-JOY |  |

The applicant sought to register the word mark **JN-JOY** as an EUTM for goods and services in, inter alia, Classes 18 and 25. An opposition based on the earlier German figurative mark represented above and registered for goods and services in Class 25 was filed pursuant to Article 8(1)(b) EUTMR. The OD partly upheld the opposition, considering that there was a LOC for some of the contested goods in Classes 18 and 25. The BoA dismissed the applicant’s appeal. It found that there was a LOC, given the identity or similarity between the goods in question, the overall similarity between the signs at issue and the average distinctive character of the earlier trade mark. The applicant filed an action before the GC, relying on several pleas in law that related to: (i) the relevant public, (ii) the degree of attention, (iii) the comparison of the goods, (iv) the comparison of the marks, including the distinctiveness and dominance of the common element, (v) the inherent distinctiveness of the earlier mark, and (vi) the purported reputation of the contested mark. The GC dismissed the appeal, ruling that the BoA had not erred in finding a LOC for the goods within the scope of the appeal. **Likelihood of confusion:** the GC began the examination of the LOC by clarifying that the relevant public to be taken into consideration was made up of German consumers, given that the earlier mark, on which the contested decision had been based, was a German trade mark (paras 17-21). Next, the GC dismissed the applicant’s argument that the degree of attention paid to the goods was higher than average because the goods concerned were aimed at ‘young and trendy’ consumers. In so doing, the GC confirmed that the trade mark applicant’s commercial strategy was not determinative of the degree of attention; rather, this had to be assessed on the basis of the perception of the average consumer of the category of the goods concerned (paras 22-29). Regarding the comparison of the goods, the GC upheld the BoA’s conclusions, confirming that the comparison had to be made between the goods listed in the specifications of the relevant marks and **not** the goods on which the marks were actually used (paras 30-35). Turning to the comparison of the marks, the GC supported the BoA findings that the element ‘JOY’ was of average distinctive character for the German public. ‘JOY’ was not necessarily understood by the relevant German consumer. Further, even if they knew English, it was likely that such German consumers would make an association with the female first name Joy rather than with the idea of happiness (paras 39-47). The GC considered that ‘JOY’ dominated the earlier mark due to its relative size and position (paras 48-51). It also agreed with the BoA’s assessment of an average degree of visual and aural similarity. In doing so, it referred to the



dominant position of ‘JOY’ in the earlier mark, the secondary nature of the set of letters ‘JN’ and the hyphen in the contested mark and the secondary role of ‘sportswear’ in the earlier mark, which would not be pronounced when consumers referred to that mark (paras 52-73). Conceptually, the applicant had contended that there was a difference between the marks because ‘joy’ in the earlier mark highlighted the idea of happiness, and ‘sportswear’ described sports clothing. By contrast, the contested mark **JN-JOY** alluded to a young couple enjoying life. This was because of the association with the male first name ‘Jay’ and the female first name ‘Joy’, and the wordplay on the English term ‘enjoy’. The GC rejected this and concluded that the German consumer would attribute significance only to the term ‘joy’ in the contested trade mark (paras 74-81). When assessing the LOC, the GC first clarified that an opponent was not required to establish the inherent distinctiveness of the earlier mark. It also confirmed that the purported reputation of the contested mark was not relevant for analysing the LOC (paras 84-95). It went on to conclude that the BoA had not erred in finding that there was a LOC between the signs at issue for the relevant goods. **LOC**

♦[T-389/15](#); **J&JOY / joy SPORTSWEAR**; *J & Joy SA v EUIPO*; Judgment of 29 March 2017; EU:T:2017:231; Language of the case: EN.

| EUTM application | Earlier trade mark |
|--|--|
|  |  |

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in, inter alia, Classes 18 and 25. An opposition based on the earlier German figurative mark represented above and registered for goods and services in Class 25 was filed pursuant to Article 8(1)(b) EUTMR. The OD partly upheld the opposition, considering that there was a LOC for some of the contested goods in Classes 18 and 25. The BoA dismissed the applicant’s appeal. It found that there was a LOC, given the identity or similarity between the goods in question, the overall similarity between the signs at issue and the average distinctive character of the earlier trade mark. The applicant filed an action before the GC, relying on several pleas in law that related to: (i) the relevant public, (ii) the degree of attention, (iii) the comparison of the goods, (iv) the comparison of the marks, including the distinctiveness and dominance of the common element, (v) the inherent distinctiveness of the earlier mark, and (vi) the purported reputation of the contested mark. The GC dismissed the appeal, ruling that the BoA had not erred in finding a LOC for the goods within the scope of the appeal. **Likelihood of confusion:** the GC began examination of the LOC by clarifying that the relevant public to be taken into consideration was made up of German consumers, given that the earlier mark on which the contested decision had been based was a German trade mark (paras 17-21). Next, the GC dismissed the applicant’s argument that the degree of attention paid to the goods was higher than average because the goods concerned were aimed at ‘young and trendy’ consumers. In so doing, the GC confirmed that the trade mark applicant’s commercial strategy was not determinative of the degree of attention; rather, this had to be assessed on the basis of the perception of the average consumer of the category of the goods concerned (paras 22-29). Regarding the comparison of the goods, the GC found that the comparison had to be made between the goods listed in the specifications of the relevant marks and not between the goods on which the marks were actually used (paras 30-35). Turning to the comparison of the marks, the GC



supported the BoA findings that the element ‘JOY’ was of average distinctive character for the German public. ‘JOY’ was not necessarily understood by the relevant German consumer. Further, even if they knew English, it was likely that such German consumers would make an association with the female first name Joy rather than the idea of happiness (paras 39-47). The GC considered that ‘JOY’ dominated the earlier mark due to its relative size and position (paras 48-51). It also agreed with the BoA’s assessment of an average degree of visual similarity and aural similarity. In doing so, it referred to the dominant position of ‘JOY’ in the earlier mark, the secondary nature of the separate letter ‘J’ and the ampersand ‘&’ in the contested mark and the secondary role of ‘sportswear’ in the earlier mark, which would not be pronounced when consumers referred to that mark (paras 52-73). Conceptually, the applicant had contended that there was a difference between the marks because ‘joy’ in the earlier mark highlighted the idea of happiness, and ‘sportswear’ described sports clothing. By contrast, the contested mark **J&JOY** alluded to a young couple enjoying life, because of the association with the male first name ‘Jay’ and the female first name ‘Joy’, and the wordplay on the English term ‘enjoy’. The GC rejected this and concluded that the German consumer would attribute significance only to the term ‘joy’ in the contested trade mark (paras 74-81). When assessing the LOC, the GC first clarified that an opponent was not required to establish the inherent distinctiveness of the earlier mark. It also confirmed that the purported reputation of the contested mark was not relevant for analysing the LOC (paras 84-95). It went on to conclude that the BoA had not erred in finding that there was a LOC between the signs at issue for the relevant goods. **LOC**

[T-209/16](#); **APAX PARTNERS / APAX**; *Apax Partners UK Ltd v EUIPO*; Judgment 30 March 2017; EU:T:2017:240; Language of the case: EN.

| EUTM application | Earlier trade mark |
|------------------|--------------------|
| APAX PARTNERS | APAX |

The applicant filed an application for registration of the word mark **APAX PARTNERS** as an EUTM in respect of services in Class 36. An application for the declaration of invalidity was filed pursuant to Article 60(1)(a) EUTMTR and Article 8(1)(a)(b) EUTMR, based on the international registration shown above, which designated, among other countries, Sweden, and covered, inter alia, services in Class 36. The CD upheld the application for a declaration of invalidity for all the services covered by the contested mark on the basis of Article 60(1)(a) EUTMTR in conjunction with Article 8(1)(b) EUTMR. The BoA dismissed the proprietor’s appeal. It endorsed the CD’s findings that there was a LOC between the conflicting trade marks. The proprietor filed an action before the GC, relying on a single plea in law: infringement of Article 60(1)(a) EUTMTR in conjunction with Article 8(1)(b) EUTMR. The GC dismissed the appeal. The GC endorsed the BoA’s findings that the level of attention in respect of the services in question, which might be aimed both at the general public and at a specialist public, was relatively high (para. 25). Moreover, the BoA had also been right to find that the signs at issue were similar overall, in particular since the only element of the earlier mark was identical to the first element of the contested mark and because the second element of the latter was distinctive only to a low degree (para. 27). The GC also held that the *financial services* covered by the earlier mark had been correctly found similar to the services of *insurance* covered by the contested mark (paras 29-32) and identical to the rest (para. 39). Furthermore, it was considered that the declaration filed by the proprietor under





Article 33(8) EUTMR during the course of proceedings before the GC could not affect the outcome of the comparison of the services since the items added to the specification of the contested mark had already been taken into account by previous instances (paras 33-38). Therefore, the GC concluded that, given the similarity between the signs and the identity and similarity between the services, there was a LOC between the trade marks in question despite the relatively high level of attention of the relevant public (paras 43-35). **LOC**

[T-49/16](#); **NIMORAL / NEORAL**; *Azanta A/S v EUIPO*; Judgment of 6 April 2017; EU:T:2017:259; Language of the case: EN.

| EUTM application | Earlier trade mark |
|------------------|--------------------|
| NIMORAL | NEORAL |

The applicant filed an application for the registration of the word mark **NIMORAL** as an EUTM in respect of goods in Class 5. An opposition based on the earlier EU word mark **NEORAL** registered for goods in Class 5 was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition in its entirety. The BoA dismissed the applicant's appeal. It endorsed the OD's finding that there was a LOC between the conflicting trade marks. The opponent filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. The GC endorsed the BoA's findings that the goods of the conflicting trade marks were identical (paras 29-30) and that they targeted both a specialised public and the general public in the EU, who would both be particularly attentive (paras 26-27). The signs were found to be visually and aurally similar to an average degree (paras 42 and 49). They could not be compared conceptually (para. 58). Therefore, the GC concluded that, given the average degree of similarity between the signs and the identity between the goods, there was a LOC between the trade marks in question in spite of the particularly high level of attention of the relevant public (para. 69). **LOC**

♦[T-178/16](#); **Policolor / ProfiColor**; *CWS-Lackfabrik Conrad W.Schmidt GmbH & Co. KG v EUIPO*; Judgment of 6 April 2017; EU:T:2017:264; Language of the case: EN.



| EUTM application | Earlier trade mark |
|---|--|
|  |  |

The applicant sought to register the figurative mark represented above for goods in Class 2. An opposition based on the earlier figurative mark represented above, registered for goods in Class 2, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition. The BoA dismissed the appeal. The applicant filed an action before the GC, relying on three



pleas in law: (i) infringement of Article 8(1)(b) EUTMR, (ii) infringement of Article 94 EUTMR, and (iii) invalidity of the earlier mark. The GC dismissed the appeal. **Validity of the earlier mark:** no account could be taken of the non-renewal of the earlier mark, as the proprietor could, pursuant to Article 53(3) EUTMR, still submit a request for renewal within 6 months following the expiry of registration. Any revocation of the earlier mark was also irrelevant for the purpose of assessing the legality of the contested decision as the revocation proceedings, which were still pending before the Office, had been initiated after the contested decision had been adopted. The action brought in the present case related to an earlier mark that had been in effect at the time when the contested decision was adopted (paras 21-23). **LOC:** the term ‘color’ was descriptive, was of weak distinctive character, and was not the most dominant element of the marks; however, it was not negligible (paras 36-40). The signs would be broken down into ‘poli’/‘profi’ and ‘color’. Visually, they were similar to a low degree because, apart from sharing the term ‘color’, their first parts also shared three letters, and in the same order – ‘P’, ‘o’ and ‘i’. Figurative elements were essentially decorative (paras 43-46). Aurally, the signs had the same number of syllables and only minor differences in pronunciation (para. 50). Conceptually, the signs were similar to an average degree. ‘Color’ would be understood in the EU, whereas the conceptual difference between ‘poli’ and ‘profi’ would be perceived only by a limited number of consumers in the EU (paras 53-55). In view of the identical and similar goods and the similarity at least to a low degree between the signs, the BoA had not erred in finding that there was a LOC, although it had erred in concluding that the signs were highly similar (para. 65). The coexistence of the marks had not been proven (para. 68). **LOC**

[T-681/15](#); **DEVICE OF A WOLF’S HEAD / WOLF** *Jardin et al.*; *Environmental Manufacturing LLP / EUIPO*; Judgment of 3 May 2017; EU:T:2017:296; Language of the case: EN.


| EUTM application | Earlier trade mark |
|---|--|
|  |  |

The OD had dismissed the opposition under Article 8(1)(b) and Article 8(5) EUMTR on account of lack of similarity between the signs. The BoA reversed this decision, finding that Article 8(5) EUMTR applied. The GC dismissed the appeal (22/05/2012, T-570/10, *Répresentation d’une tête de loup*, EU:T:2012:250). The CJ annulled this judgment, holding that the GC should have examined, as a condition for finding dilution, whether use of the mark might lead to any change in the economic behaviour of the consumer (14/11/2013, C-383/12 P, *Répresentation d’une tête de loup*, EU:C:2013:741). Applying this guidance, the GC annulled the BoA’s decision (05/02/2015, T-570/10 RENV, *Répresentation d’une tête de loup*, EU:T:2015:250). The case was remitted to the First BoA, which upheld the opposition, this time under Article 8(1)(b) EUTMR, after finding that the earlier mark had enhanced distinctiveness in France in respect of lawnmowers and brush cutters. The GC dismissed the appeal. Neither the fact that the public consisted of both professionals and non-



professionals, nor the identity/close similarity of the goods were challenged. The signs were visually similar, bearing in mind that the figurative element of the earlier mark was co-dominant (paras 45-47). The GC confirmed that, unless the semantic content of the purely figurative mark could immediately be associated with a specific, concrete word, an aural comparison was impossible: ‘a phonetic comparison of the signs at issue is irrelevant in the examination of the similarity of a purely figurative mark with another mark’ (para. 52). In this case, the figurative element in the mark applied for reproduced the head of a canine, capable of being perceived as a wolf, dog or fox. Consequently, no specific word could with certainty be attributed to the mark applied for (para. 53). The signs were conceptually similar despite the fact that the earlier mark included a verbal element. The latter was irrelevant because the existence of a meaningless verbal element could not render the signs conceptually dissimilar (para. 61). Moreover, some of the public might understand the word ‘Wolf’ as an English word denoting the animal represented in both signs (para. 62). Given that the signs were similar overall, that the goods were at least similar to a high degree and that the earlier mark had enhanced distinctiveness, a global assessment of the relevant factors concluded that there was a LOC (paras 69-70). The opposition could be upheld under Article 8(1)(b) EUTMR even if in the previous decision the BoA had found (at least implicitly) that the degree of similarity of the signs could at most justify the existence of a link under Article 8(5) EUTMR. Since Article 8(1)(b) EUTMR had not been examined then, it could not be inferred that the BoA and the GC had ruled out a LOC in their previous decision and judgment, respectively (para. 74). **LOC**

[T-224/16](#); **Outdoor / OUTDOOR PRO et al.**; *Messe Friedrichshafen GmbH v EUIPO*; Judgment of 5 May 2017; EU:T:2017:314; Language of the case: EN


| EUTM application | Earlier trade mark |
|---|--|
|  | <p style="text-align: center;">OUTDOOR PRO</p> |

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 9, 16, 25, 28, 35, 37, 38, 41 to 43 and 45. An opposition based on the earlier word mark **OUTDOOR PRO**, registered for goods and services in Classes 9, 12, 14, 18, 22, 24, 25, 28 and 35, was filed pursuant to Article 8 (1)(b) EUTMR. The OD partly upheld the opposition for all the goods and services in Classes 9, 25, 28, 35 and 38 and for some of the goods and services in Classes 16, 37, 41 and 42. The BoA partly upheld the applicant’s appeal, finding that there was no LOC for some of the services in Class 41, but confirming the OD’s decision for the remainder. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 95 EUTMR and (ii) infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. With regard to the first plea, the GC pointed out that, in the context of opposition proceedings, there was no need to examine the validity of the registration of the earlier mark, in particular under Article 7 EUTMR; it rejected the first plea as unfounded (paras 21-22). With regard to the second plea, infringement of Article 8(1)(b) EUTMR, the GC emphasised that the term ‘outdoor’ in the earlier mark would not be understood by the non-English-speaking part of the relevant public. Furthermore, some of that part of the public would also not perceive the term ‘pro’ as an abbreviation of the term ‘professional’ or as meaning ‘for’. For that part of the relevant



public, the earlier mark would not have any meaning with regard to the goods and services covered (para. 52). Despite some visual differences, the public would perceive the signs as being visually similar on account of the fact that they both contain the group of letters ‘outdoor’ (para. 43). The partially identical and partially similar nature of the goods and services at issue was not disputed. The BoA was right in finding that it was apparent from an overall assessment of the marks at issue that there was a risk that part of the relevant public might believe that the goods and services in question came from the same undertaking or from economically linked undertakings (para. 65). **LOC**


[T-262/16](#); **GLOBO MEDIA / TV GLOBO PORTUGAL (FIG. MARK) et al.**; *Globo Media, SA, v EUIPO*; Judgment of 5 May 2017; EU:T:2017:315; Language of the case: EN.

| EUTM application | Earlier trade mark |
|------------------|---|
| GLOBO MEDIA |  |

The applicant sought to register the word mark **GLOBO MEDIA** as an EUTM for services in Classes 35, 38 and 41. The BoA confirmed the first-instance decision and refused the EUTM application following an opposition based on the earlier Portuguese figurative mark represented above. The BoA considered that, given the coincidence in the dominant and distinctive element ‘GLOBO’ in both marks, there was a LOC for the services in question, even for the relevant public with a high level of attention. The GC confirmed the BoA’s decision and concluded there was a LOC within the meaning of Article 8(1)(b) EUTMR. The relevant public was the public at large and the professional public in Portugal, whose attention would vary according to the category of services (para. 20). The GC also confirmed that the services at issue were at least similar. Regarding the distinctive elements of the sign, the GC considered that the figurative element of the earlier mark was less distinctive than the verbal elements, and that both ‘TV’ and ‘PORTUGAL’ were descriptive of the relevant services (para. 28-29). This mark did not have any dominant element (paras 34-35). The element ‘GLOBO’ present in both marks was not, per se, descriptive of anything but a globe and, at most, alluded to the planet (para. 53). The GC, like the BoA, found that the signs were visually similar only to a low degree (para. 43) and aurally similar to a medium degree (para. 47). The finding that the marks were conceptually similar to a high degree in view of the meaning of the common element ‘globo’ (globe), the link between the concepts of ‘tv’ and ‘media’ and the fact that this concept was reinforced by the figurative element, was not disputed by the applicant; therefore, the BoA had been entitled to rely on that element (para. 49). The GC rejected the argument that the visual perspective played a greater role for the services in question (paras 57-59) and concluded that there was a LOC in this case (para. 60). **LOC**



[T-85/15](#); **YLOELIS / YONDELIS et al.**; *Alfa Wassermann SpA v EUIPO*; Judgment of 16 May 2017; EU:T:2017:336; Language of the case: EN.

| EUTM application | Earlier trade marks |
|------------------|--|
| YLOELIS | <p>YONDELIS</p>  |

The applicant sought to register the word mark **YLOELIS** as an EUTM for goods in Class 5. An opposition based on the earlier marks represented above, registered for goods in Class 5, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition. The BoA dismissed the appeal. It found that there was a LOC between the mark applied for and the earlier word mark. The GC dismissed the action. The GC confirmed that the level of attention of the relevant public, which was composed of oncologists, doctors, healthcare professionals and cancer patients in the European Union, was high (para. 23). The GC pointed out that the fact that the goods covered by the earlier mark were expressly excluded from the list of goods covered by the application was not in itself sufficient to rule out similarity between them (para. 31). They did not differ in their intended purpose, method of use or end users, given that it could not be ruled out that they were complementary insofar as the contested goods could be used to limit the side effects of the goods covered by the earlier mark (para. 32). Taking into account that the goods were of the same nature (pharmaceutical products for human use), had the same purpose or intended use (treatment of human health problems), same consumers (medical professionals and patients) and same distribution channels (pharmacies and hospital supply services), and were also complementary, the GC confirmed that there was similarity between them (paras 28-29 and 35). The GC stated that the signs were visually similar because the elements that differentiated them were not capable of nullifying their common features (paras 38-42); that they were, overall, aurally similar, even where the letter 'y' was pronounced differently (paras 43-45); and that the conceptual comparison between the marks was neutral because they did not have any specific meaning in any language (para. 46). Additionally, the GC confirmed that the earlier mark was distinctive (para. 50). For all the reasons above, the GC concluded that there was a LOC, even where there was a high level of attention on the part of the relevant public (para. 55). The GC clarified that the high level of attention was not in itself sufficient, in light of the other factors, to rule out any LOC (para. 53), which in the present case was not the likelihood that the public might confuse the two goods (i.e. the medication YONDELIS, administered to treat cancer, and the product YLOELIS, administered to treat the side effects of treatment with YONDELIS) but the likelihood that they could wrongly believe that both were marketed by the same undertaking (para. 54). **LOC**



[T-159/16](#); **TRIPLE o NADA / TRIPLE BINGO**; *Metronia S.A. v EUIPO*; Judgment of 16 May 2017; EU:T:2017:340; Language of the case: ES.

| EUTM application | Earlier mark |
|---|--|
|  |  |

The applicant sought to register the figurative sign **TRIPLE O NADA** as an EUTM for goods and services in Classes 9, 28 and 41. An opposition based on the earlier figurative EUTM **TRIPLE BINGO**, registered for goods and services in Classes 9, 28 and 41, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition. The BoA dismissed the applicant's appeal. For the assessment of the LOC, the BoA took into consideration only the Bulgarian, Hungarian and Polish part of the relevant public, for which the word 'TRIPLE' had no meaning. It found that, despite the low degree of distinctive character shown by the earlier mark, there was a LOC for that part of the public, since the conflicting marks coincided in 'TRIPLE', the most relevant element in both signs. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC reiterated the BoA's conclusions on the relevant public (para. 26) and those on the existence of identity between the goods and services (para. 28). It found that the conflicting signs were visually and aurally similar to a degree lower than average (paras 37 and 42). Furthermore, since the Bulgarian, Hungarian and Polish public was not able to understand the meaning of the word 'TRIPLE', it was not possible to carry out a conceptual comparison between the signs (para. 49). The GC also underlined that, in the context of opposition proceedings, it was not possible for the applicant to claim that the earlier EUTM lacked distinctiveness (para. 56) and that a low degree of distinctive character was not incompatible with a finding of LOC (para. 57). In any event, in this case, the earlier mark did not have a low degree of distinctive character, at least not for the Bulgarian, Hungarian and Polish part of the relevant public, who did not understand the meaning of the term 'TRIPLE' and for whom it would therefore be distinctive (para. 58). Finally, the GC confirmed the existence of the LOC, upholding the BoA's decision (para. 60). **LOC**

♦[T-258/16](#); **GINRAW / RAW**; *Mediterranean Premium Spirits, SL v EUIPO*; Judgment of 7 June 2017; EU:T:2017:375; Language of the case: EN.


| EUTM application | Earlier trade marks |
|------------------|---------------------|
| GINRAW | RAW |

The applicant sought to register the word mark **GINRAW** for goods in Classes 21 and 33. An opposition based on the word mark **RAW**, protected by two EUTMS, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition. The BoA dismissed the applicant's



appeal. Before the GC, the applicant claimed (i) infringement of Article 8(1)(b) EUTMR and (ii) breach of the obligation to state reasons. The GC dismissed the action. The GC held that the BoA had rightfully found LOC and had fully satisfied the requirements of case-law. As to the goods in Class 21, the GC rejected the opponent’s claim that *household and kitchen utensils and containers* were dissimilar to *cocktail shakers, sticks, straws* in the application, stating that there was no evidence to suggest that. On the contrary, they were identical as the former included the latter (paras 24-26). The applicant did not dispute that the goods in Class 33 were identical. The GC rejected the applicant’s claims regarding the descriptiveness of the earlier marks, finding that the link between the word ‘RAW’ and the goods in Classes 33 and 21 was too indirect to establish descriptiveness. The BoA had rightly found that the dominant element of the mark applied for was ‘RAW’, since ‘GIN’ was descriptive of the goods. Furthermore, it had not erred in breaking down the mark applied for into the elements ‘gin’ and ‘raw’ (paras 63 to 65). The GC also found no errors in the assessment of the visual, aural and conceptual similarity of the signs: the fact that the mark applied for consisted of the earlier mark, to which another word has been added, indicated an average degree of visual and aural similarity (paras 54 to 57). **LOC**

♦ [T-341/13 RENV](#); **SO’BiO etic / SO...? et al.**; *Groupe Léa Nature SA v EUIPO*; Judgment of 8 June 2017; EU:T:2014:802; Language of the case: EN.

| EUTM application | Earlier trade mark |
|---|---|
|  | <p style="text-align: center;">SO...?</p> |

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 3 and 25. An opposition based on the earlier word mark **SO...?**, registered for goods and services in Class 3, was filed pursuant to Article 8(1)(b) and Article 8(4) and (5) EUTMR. The OD dismissed the opposition. The BoA upheld the opponent’s appeal. It found that there was a LOC between the signs at issue with regard to the goods that were identical or similar. As regards the *bleaching preparations and other substances for laundry use*, which were dissimilar to the opponent’s goods, it held there was a risk that the sale of those goods would be detrimental to the repute of the earlier marks for the purposes of Article 8(5) EUTMR. The applicant filed an action before the GC, relying on four pleas in law: (i) an error of law in the choice of the legal basis for the contested decision, and breach of the principle of legal certainty, the principle of the protection of legitimate expectations and the right to a fair hearing; (ii) an error of law in the assessment of the genuine use of the earlier marks; (iii) infringement of Article 8(1)(b) EUTMR; and (iv) infringement of Article 8(5) EUTMR. The GC rejected the first and second pleas but upheld the action on the basis of the third and fourth pleas. It found that the signs were not similar. The opponent filed an appeal before the CJ. The CJ upheld the appeal and set aside the GC’s first judgment; it found that there had been a contradiction in the GC’s reasoning that amounted to a failure to state reasons. There was no need to rule again on the first and second plea, which had already been rejected by the GC. **LOC**: the fact that the first element in the earlier marks was fully included in the mark applied for and was also placed first in the



upper part of that mark made it impossible to rule out any similarity between the signs at issue; the word elements 'bio' and 'étic' might be perceived as a reference to the composition or origin of the goods covered, or to environmentally friendly methods of producing cosmetic products. Notwithstanding their different lengths and structures, the signs at issue were visually similar to a certain extent (paras 43-49). They were also aurally similar to a certain extent (paras 50-51). The BoA observed that consumers would understand the earlier marks **SO...?** as an introduction to a question whereas the sign applied for **SO'BiO étic** would be understood as a reference to a 'bio-ethical product', with the result that the signs at issue were not conceptually similar. The GC upheld this finding (paras 52-56). In the light of the identity or similarity of the goods at issue, with the exception of the *bleaching preparations and other substances for laundry use* in Class 3 of the mark applied for, the similarity of the signs at issue, the average level of attention of the relevant public and the enhanced distinctiveness and reputation of the earlier marks, which the applicant had not convincingly called into question, the BoA's assessment that there was a LOC between the marks at issue, as regards the goods that were identical or similar, had to be confirmed (paras 57-67).

LOC

[T-6/16](#); **SOUTHERN TERRITORY 23°48'25"S** / **SOUTHERN**; *AWG Allgemeine Warenvertriebs GmbH v EUIPO*; Judgment of 8 June 2017; EU:T:2017:383; Language of the case: DE. The EUTM proprietor was granted registration of the word mark **SOUTHERN TERRITORY 23°48'25"S** for, inter alia, goods in Class 25. An application for invalidity based on the earlier EUTM **SOUTHERN**, registered for, inter alia goods in Class 25, was filed pursuant to Article 60(1)(a) in conjunction with Article 8(1)(b) EUTMR. The CD upheld the application for invalidity for some of the goods in Class 25. The BoA dismissed the EUTM proprietor's appeal. It found that there was a LOC. The proprietor filed an action before the GC, relying on a single plea in law: infringement of Article 60(1)(a) (now Article 68(1)(a)) EUTMR read in conjunction with Article 8(1)(b) EUTMR. The GC dismissed the action. **Relevant consumer:** the relevant public was the English-speaking general public with a normal degree of attention is relevant (paras 19-23). **Similarity of the goods:** *articles of outer clothing for men* was identical to *clothing* and similar to *shoes* and *headgear* (para. 24). **Similarity of the signs:** the word elements 'Southern' and 'Territory' had average inherent distinctive character, and the word 'Territory' could not be considered to have greater distinctive character than 'Southern' (para. 35). The element 'SOUTHERN' in the earlier mark had a normal degree of distinctiveness; in particular, it had to be taken into account that this mark was registered and therefore to be considered inherently distinctive (para. 36). The elements '23°48'25"S' played a secondary role in the overall impression since the average consumer might not understand them and did not make complex geographical deliberations when buying the goods in question (para. 40). Due to their common element 'Southern', the signs were visually and aurally similar to an average degree (paras 45-54). Aurally, it was established case-law that there was similarity where the earlier mark fully included in the contested mark (para. 53). They were conceptually similar to a high degree, since they both referred to the concept of a place lying to the south, the only difference being the reference in the contested mark to a territory (para. 60). The expression 'Southern Territory' did not form a unit; it was not a fixed term (para. 67). It was very likely that the relevant public would see in the EUTM application a sub-mark or variant of the earlier mark and regard the goods designated by the conflicting marks as coming from the same undertaking (para. 80). It followed that the BoA had not erred in finding a LOC (para. 81). **LOC**


[T-95/16](#); **ROYAL & CAPORAL / KAPORAL**; *Savas Aydin v EUIPO*; Judgment of 14 June 2017; EU:T:2017:388; Language of the case: FR.



| EUTM application | Earlier trade mark |
|------------------|--------------------|
| ROYAL & CAPORAL | KAPORAL |

The applicant sought to register the mark **ROYAL & CAPORAL** as an EUTM for goods and services in Classes 3, 9, 14, 18, 20, 24 and 25. An opposition based on the earlier EU word mark **KAPORAL**, registered for goods in Class 25, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition for some of the contested goods. The applicant filed an appeal against part of the contested decision (only Class 25 goods). The BoA dismissed the applicant’s appeal. The BoA found that the goods at issue in Class 25 were identical and that the marks were visually similar, aurally similar and conceptually similar to the extent they both referred to a ‘caporal’ (a military rank). The BoA confirmed that there was a LOC for the French-speaking public in the EU without it being necessary to take into account the opponent’s claim of enhanced distinctiveness for its earlier mark; therefore it was not necessary to give a ruling on the ‘belated’ evidence submitted before the OD (i.e. after the time limit to substantiate the opposition) and again before the BoA. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. The GC confirmed that the relevant public was composed of the general public with an average level of attention as regards the Class 25 goods at issue (para. 28), and not a particularly high level as claimed by the applicant. The goods at issue were identical (not disputed). Given that the terms ‘CAPORAL’ and ‘KAPORAL’ were visually quasi-identical and that the contested mark consisted, in addition to ‘KAPORAL’, of ‘ROYAL &’ (para. 38) which were distinctive to a low degree, the marks were visually similar to an average degree (para. 42). They were also aurally similar to an average degree (paras 51, 52). Conceptually, they were again similar to an average degree, since they referred to the same concept of a caporal/corporal (paras 55-57), even though the concept of ‘royal’ was not present in the earlier mark (para. 59). The term ‘CAPORAL’ had an independent distinctive role within the contested mark (paras 72-75). There was a LOC (para. 76). The applicant’s arguments as to the inadmissibility of the evidence relating to earlier mark’s claimed acquired distinctiveness were irrelevant as they tended to merely confirm the BoA’s decision. **LOC**

[T-457/15](#); **climaVera / CLIMAVER DECO**; *Fakro sp. z o.o., v EUIPO*; Judgment of 15 June 2017; EU:T:2017:391; Language of the case: EN.

| EUTM application | Earlier trade mark |
|---|--------------------|
|  | CLIMAVER DECO |

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in, inter alia, Classes 6, 19, 20, 24 and 37. An opposition based on the earlier word mark CLIMAVER DECO, registered for goods in Classes 11, 17 and 19, was filed pursuant to Article 8(1)(b) EUTMR. The OD partly upheld the opposition, with regard to *shutters, жалюзи, blinds, curtains of various types* in Classes 6, 19, 20 and 24, and for the assembly of related goods in Class 37. The BoA dismissed the applicant’s appeal. It considered that the goods and services were directed at both professionals and the general



public and that a high level of attention was apt. The BoA found the goods and services to be identical or similar and the marks to be similar due to the elements ‘climavera’ and ‘climaver’, respectively. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. It argued that: (i) the relevant consumer was a specialist, (ii) the BoA had incorrectly interpreted Communication No 2/12 and that a literal approach should have been used when comparing the goods and services, (iii) the BoA had not taken sufficient account of the differences between the goods (in particular, the fact that the contested goods had an anti-burglary or security function), and (iv) the BoA had failed to take account of several factors distinguishing the two marks. The GC dismissed the appeal.

Regarding the relevant consumer and the level of attention: the BoA had been correct to hold that the goods in question were directed at professionals and the general public, namely DIY amateurs. First, a member of the general public might only involve professionals for the installation of the goods *after* he or she had examined a range of goods and services pertaining to shutters, jalousies or blinds. Further, the installation of some of the goods (e.g. non-metallic blinds and indoor curtains) was not solely the preserve of professionals. Additionally, purchasers might be DIY amateurs; therefore, the goods concerned might be purchased and installed not only by professionals but also by skilled end users. The level of attention to be applied was high (paras 21-24). **Regarding the goods covered by the earlier mark:** the GC found that Communication No 2/12, relied upon by the BoA, was compatible with the principles laid down by the CJc. It then confirmed the BoA’s finding that, as the earlier EUTM had been registered before 21 June 2012 using the entire class heading of Classes 11 and 19, the opponent was deemed to have intended to cover all the goods included in the alphabetical list of the Nice classification for those classes (including *shutters, not of metal and jalousies, not of metal* in Class 19) (paras 25-32). **On the comparison of goods and services:** the GC dismissed the applicant’s arguments that the BoA had not taken due account of the security function of the contested goods. Indeed, the applicant acknowledged that the goods in question might be used for a variety of reasons, not just security. The overlap of the nature and purpose of the goods in Classes 6, 20 and 24 of the EUTM application with the *shutters, not of metal and jalousies, not of metal* covered by the earlier trade mark was sufficient to make them similar (paras 33-44). **On the comparison of marks:** the GC found that the shared element ‘climaver’ was an indication of visual similarity, especially as it was at the beginning of the EUTM application. It conceded that ‘clima’ was distinctive only to a low degree because it directly alluded to — not, as the BoA had held, was laudatory of — the goods and services concerned. However, this was offset by other factors (paras 59-60). The GC considered that the points of dissimilarity did not dispel the impression of similarity. The impact of the figurative elements of the EUTM application (namely the graphical representation of a sun and vertical dotted lines resembling a blind or a curtain) was limited because they were purely decorative. Likewise, the element ‘deco’ in the earlier mark was rather descriptive. Consequently, the marks were visually similar (paras 61-66). Aurally, there was a high degree of similarity between the marks at issue, as ‘climaver’ would be pronounced the same way in both marks. The different sound ‘a’ in the EUTM application is at the end, and the element ‘deco’ in the earlier mark was secondary (paras 70-72). The GC upheld the BoA’s finding that ‘deco’ in the earlier trade mark provided a point of conceptual distinction between the marks since it associated that trade mark with the theme of ‘decoration’. It was, however, descriptive. For consumers who perceived the terms ‘clima’ and/or ‘ver(a)’ as separate elements in the marks, the marks would be conceptually similar as they would be associated with climate and ‘vero’ respectively. Others would see ‘climavera’ and ‘climaver’ as invented words and with no concept in common (para. 79). **On the LOC:** even though the terms ‘clima’ and ‘deco’, taken individually, had a low level of distinctive character, the GC held that the BoA had been entitled to conclude that the earlier trade mark as a whole had no meaning in relation to all the goods and services in question,




and therefore was of normal distinctive character. This was because some of the relevant public would perceive the term ‘climaver’ of the earlier trade mark as an invented word (paras 85 and 86). Considering that the goods covered by the marks at issue were identical or similar, and that the two marks were visually and aurally similar and either conceptually similar or conceptually neutral, the BoA had been entitled to conclude that there was a LOC, even in the event of the average consumer displaying a high level of attention. **LOC**

♦ [T-541/15](#); **NSU / NSU**; *Industrie Aeronautiche Reggiane Srl v EUIPO*; Judgment of 20 June 2017; EU:T:2017:406; Language of the case: EN. The applicant sought to register the word mark **NSU** as an EUTM for goods in Class 12. An opposition based on the earlier national German word mark **NSU**, registered for goods and services in Classes 7, 8 and 12, was filed pursuant to Article 8(1)(a) and (b) EUTMR. The OD partly upheld the opposition in relation to certain Class 12 goods. The BoA dismissed the applicant’s appeal and upheld the opponent’s ancillary appeal. It found that use of the earlier right had been proven for more goods than originally concluded by the OD. The applicant filed an action before the GC. The GC dismissed the appeal. The GC found that the BoA had been right to find that genuine use of the earlier mark had been shown both for *bicycles* in Class 12 and *parts of machines* in Class 7, and for *accessories for automobiles and bicycles, parts of vehicles* in Class 12. In this regard, the GC clarified that there was no requirement for the evidence of use to be authenticated. Furthermore, the GC concluded that the BoA had not erred in concluding that *parts of vehicles* in Class 12 and *vehicles* of the same Class were similar goods. Taking into account the identity of the marks at issue and the similarity between the goods in question, the BoA had correctly concluded that there was a LOC on the part of the relevant public. **LOC**

[T-632/15](#); **OCTASA / PENTASA**; *Tillots Pharma v EUIPO*; Judgment of 21 June 2017; EU:T:2017:408; Language of the case: EN. The applicant sought to register the word mark **OCTASA** for goods in Class 5. An opposition based on the earlier word mark **PENTASA**, registered for goods in Class 5, was filed pursuant to Article 8(1)(b) and 8(5) EUTMR. The OD dismissed the opposition. The BoA dismissed the appeal. The opponent filed an action before the GC. The GC upheld the appeal. In the subsequent decision, the BoA upheld the appeal, thus upholding the opposition and refusing the application for registration of an EUTM. It found that there was a LOC within the meaning of Article 8(1)(b) EUTMR between the earlier German and Benelux marks, on the one hand, and the mark applied for, on the other, in relation to the goods covered by the latter. The applicant filed an action before the GC. The GC dismissed the action. The relevant public consisted of healthcare professionals and patients in their capacity as end users of the pharmaceutical products at issue. The level of attention was high. The goods were identical. The suffix ‘asa’ was not descriptive from the point of view of a significant number of end users. The signs were of a similar length — six and seven letters, respectively — and the last four letters, ‘tasa’, were the same and were in the same order and position. For an end user who did not perceive the descriptive character of the suffix ‘asa’ and perceived the marks at issue as a whole, the differences between the first parts of the signs at issue could not negate a certain degree of visual and aural similarity. For those end users of the goods in question who understood that the first part of each of the signs referred to the Greek numbers ‘penta’ and ‘octa’, there was a conceptual similarity, albeit slight. The identity of the goods and the similarity between the mark applied for and the earlier German and Benelux marks justified the finding of a LOC, not only in cases where the earlier marks were highly distinctive because of their use, but also where they had only a normal level of distinctiveness on account of their intrinsic distinctiveness. There was no need to rule on the merits of the applicant’s complaint regarding the enhanced distinctiveness of the earlier mark. **LOC**



[T-179/16](#); **MASTER SMOKY / MASTERS COLORS PARIS**; *L'Oréal / EUIPO – Guinot*, Order of 26 June 2017; EU:T:2017:445; Language of the case: FR.

| EUTM application | Earlier trade mark |
|------------------|--|
| MASTER SMOKY |  |


The BoA dismissed the applicant's appeals against the decisions of the OD, confirming the finding of a LOC for the relevant French public between this one of five contested EUTM applications and the earlier mark for identical goods — *eye make-up preparations* — on account of the near identity between their word elements 'Master' and 'Masters', respectively. The BoA found, in particular, that the additional verbal elements ('colors' and 'Paris') and the figurative elements (colour) in the earlier mark were, all in all, negligible, and that the additional verbal element present only in the contested mark **MASTER SMOKY** was not sufficient to offset the similarities between the marks stemming from the common element 'Master'. The GC dismissed the applicant's appeals as manifestly unfounded (Article 126 of the Rules of Procedure of the General Court). The applicant contested the BoA's comparison of the conflicting signs and its overall assessment of LOC. The GC found, however, that the BoA had analysed the opposed marks as a whole (paras 23-25), had correctly found that the earlier mark was not dominated by its figurative elements (paras 28-30), which were just as weak as its additional word elements, 'colors' and 'Paris' (para. 32), and that the applicant had not put forward any argument that would call into question the BoA's assessment that the term 'Master' would be distinctive and dominant in the earlier mark (paras 31 and 33). The GC also confirmed that the presence of the additional verbal elements in the contested marks — including that of the non-descriptive word 'Drama' (in the judgment of 26/06/2017, [T-183/16](#), **MASTER DRAMA / MASTERS COLORS PARIS** (fig.), EU:T:2017:449) — would not offset the significant similarity due to the common word element 'Master' (paras 34-37). The applicant's further arguments in that respect, alleging lack of reasoning and breach of the right to be heard, were dismissed as manifestly unfounded. The GC also confirmed the BoA's global assessment of LOC (paras 48-53). Finally, the GC dismissed the applicant's argument that only the particular combination of the (allegedly all) weak elements in the earlier mark ought to be protected by observing that a comparison limited to the sole distinctive elements of a mark would be alien to an assessment of LOC (para. 44). (References above are made to the paragraphs of the order delivered in Case T-183/16).

LOC

[T-180/16](#); **MASTER SHAPE / MASTERS COLORS PARIS**; *L'Oréal / EUIPO – Guinot*, Order of 26 June 2017; EU:T:2017:451; Language of the case: FR.


| EUTM application | Earlier trade mark |
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| MASTER SHAPE |  |
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The BoA dismissed the applicant’s appeals against the decisions of the OD, confirming the finding of a LOC for the relevant French public between this one of five contested EUTM applications and the earlier mark for identical goods — *eye make-up preparations* — on account of the near identity between their word elements ‘Master’ and ‘Masters’, respectively. The BoA found, in particular, that the additional verbal elements (‘colors’ and ‘Paris’) and the figurative elements (colour) in the earlier mark were, all in all, negligible, and that the additional verbal element present only in the contested mark **MASTER SHAPE** was not sufficient to offset the similarities between the marks stemming from the common element ‘Master’. The GC dismissed the applicant’s appeals as manifestly unfounded (Article 126 of the Rules of Procedure of the General Court). The applicant contested the BoA’s comparison of the conflicting signs and its overall assessment of the LOC. The GC found, however, that the BoA had analysed the opposed marks as a whole (paras 23-25), had correctly found that the earlier mark was not dominated by its figurative elements (paras 28-30), which were just as weak as its additional word elements, ‘colors’ and ‘Paris’ (para. 32), and that the applicant had not put forward any argument that would call into question the BoA’s assessment that the term ‘Master’ would be distinctive and dominant in the earlier mark (paras 31 and 33). The GC also confirmed that the presence of the additional verbal elements in the contested marks — including that of the non-descriptive word ‘Drama’ (in the judgment of 26/06/2017, [T-183/16](#), MASTER DRAMA / MASTERS COLORS PARIS (fig.), EU:T:2017:449) — would not offset the significant similarity due to the common word element ‘Master’ (paras 34-37). The applicant’s further arguments in that respect, alleging lack of reasoning and breach of the right to be heard, were dismissed. The GC also confirmed the BoA’s global assessment of LOC (paras 48-53). Finally, the GC dismissed the applicant’s argument that only the particular combination of the (allegedly all) weak elements in the earlier mark ought to be protected by observing that a comparison limited to the sole distinctive elements of a mark would be alien to an assessment of LOC (para. 44). (References above are made to the paragraphs of the order delivered in Case T-183/16). **LOC**


[T-181/16](#); **MASTER PRECISE / MASTERS COLORS PARIS**; *L’Oréal / EUIPO – Guinot*, Order of 26 June 2017; EU:T:2017:447; Language of the case: FR.

| EUTM application | Earlier trade mark |
|------------------|---|
| MASTER PRECISE |  |



The BoA dismissed the applicant’s appeals against the decisions of the OD, confirming the finding of a LOC for the relevant French public between this one of five contested EUTM applications and the earlier mark for identical goods — *eye make-up preparations* — on account of the near identity between their word elements ‘Master’ and ‘Masters’, respectively. The BoA found, in particular, that the additional verbal elements (‘colors’ and ‘Paris’) and the figurative elements (colour) in the earlier mark were, all in all, negligible, and that the additional verbal element present only in the contested mark **MASTER PRECISE** was not sufficient to offset the similarities between the marks stemming from the common element ‘Master’. The GC dismissed the applicant’s appeals as manifestly unfounded (Article 126 of the Rules of Procedure of the General Court). The applicant contested the BoA’s comparison of the conflicting signs and its overall assessment of the LOC. The GC found, however, that the BoA had analysed the opposed marks as a whole (paras 23-25), had correctly found that the earlier mark was not dominated by its figurative elements (paras 28-30), which were just as weak as its additional word elements ‘colors’ and ‘Paris’ (para. 32), and that the applicant had not put forward any argument that would call into question the BoA’s assessment that the term ‘Master’ would be distinctive and dominant in the earlier mark (paras 31 and 33). The GC also confirmed that the presence of the additional verbal elements in the contested marks — including that of the non-descriptive word ‘Drama’ (in the judgment of 26/06/2017, [T-183/16](#), MASTER DRAMA / MASTERS COLORS PARIS (fig.), EU:T:2017:449) — would not offset the significant similarity due to the common word element ‘Master’ (paras 34-37). The applicant’s further arguments in that respect, alleging lack of reasoning and breach of the right to be heard, were dismissed. The GC also confirmed the BoA’s global assessment of LOC (paras 48-53). Finally, the GC dismissed the applicant’s argument that only the particular combination of the (allegedly all) weak elements in the earlier mark ought to be protected by observing that a comparison limited to the sole distinctive elements of a mark would be alien to an assessment of LOC (para. 44). (References above are made to the paragraphs of the order delivered in Case T-183/16). **LOC**

[T-182/16](#); **MASTER DUO / MASTERS COLORS PARIS**; *L’Oréal / EUIPO – Guinot*, Order of 26 June 2017; EU:T:2017:448; Language of the case: FR.


| EUTM application | Earlier trade mark |
|------------------|--|
| MASTER DUO |  |

The BoA dismissed the applicant’s appeals against the decisions of the OD, confirming the finding of a LOC for the relevant French public between this one of five contested EUTM applications and the earlier mark protecting identical goods — *eye make-up preparations* — on account of the near identity between their word elements ‘Master’ and ‘Masters’, respectively. The BoA found, in particular, that the additional verbal (‘colors’ and ‘Paris’) and the figurative elements (colour) in the earlier mark were, all in all, negligible, and that the additional verbal element present only in the contested mark **MASTER DUO** was not sufficient to offset the similarities between the marks stemming from the common element ‘Master’. The GC dismissed the applicant’s appeals as manifestly unfounded (Article 126 of



the Rules of Procedure of the General Court). The applicant contested the BoA’s comparison of the conflicting signs and its overall assessment of the LOC. The GC found, however, that the BoA had analysed the opposed marks as a whole (paras 23-25), had correctly found that the earlier mark was not dominated by its figurative elements (paras 28-30), which were just as weak as its additional word elements ‘colors’ and ‘Paris’ (para. 32), and that the applicant had not put forward any argument that would call into question the BoA’s assessment that the term ‘Master’ would be distinctive and dominant in the earlier mark (paras 31 and 33). The GC also confirmed that the presence of the additional elements in the contested marks — including that of the non-descriptive word ‘Drama’ (in the judgment of 26/06/2017, [T-183/16](#), MASTER DRAMA / MASTERS COLORS PARIS (fig.), EU:T:2017:449) — would not offset the significant similarity due to the common word element ‘Master’ (paras 34-37). The applicant’s further arguments in that respect, alleging lack of reasoning and breach of the right to be heard, were dismissed. The GC also confirmed the BoA’s global assessment of LOC (paras 48-53). Finally, the GC dismissed the applicant’s argument that only the particular combination of the (allegedly all) weak elements in the earlier mark ought to be protected by observing that a comparison limited to the sole distinctive elements of a mark would be alien to an assessment of LOC (para. 44). (References above are made to the paragraphs of the order delivered in Case T-183/16). **LOC**

[T-183/16](#); **MASTER DRAMA / MASTERS COLORS PARIS**; *L’Oréal / EUIPO – Guinot*, Order of 26 June 2017 EU:T:2017:449; Language of the case: FR.



| EUTM application | Earlier trade mark |
|------------------|--|
| MASTER DRAMA |  |

The BoA dismissed the applicant’s appeals against the decisions of the OD, confirming the finding of a LOC for the relevant French public between this one of five contested EUTM applications and the earlier mark for identical goods — *eye make-up preparations* — on account of the near identity between their word elements ‘Master’ and ‘Masters’, respectively. The BoA found, in particular, that the additional verbal elements (‘colors’ and ‘Paris’) and the figurative elements (colour) in the earlier mark were, all in all, negligible, and that the respective additional verbal element present only in the contested mark **MASTER DRAMA** was not sufficient to offset the similarities between the marks stemming from the common element ‘Master’. The GC dismissed the applicant’s appeals as manifestly unfounded (Article 126 of the Rules of Procedure of the General Court). The applicant contested the BoA’s comparison of the conflicting signs and its overall assessment of the LOC. The GC found, however, that the BoA had analysed the opposed marks as a whole (paras 23-25), had correctly found that the earlier mark was not dominated by its figurative elements (paras 28-30), which were just as weak as its further word elements ‘colors’ and ‘Paris’ (para. 32), and that the applicant had not put forward any argument that would call into question the BoA’s assessment that the term ‘Master’ would be distinctive and dominant in the earlier mark (paras 31 and 33). The GC also confirmed that the presence of the additional elements in the contested marks — including that of the non-descriptive word



‘Drama’ — would not offset the significant similarity due to the common word element ‘Master’ (paras 34-37). The GC also confirmed the BoA’s global assessment of LOC (paras 48-53). Finally, the GC dismissed the applicant’s argument that only the particular combination of the (allegedly all) weak elements in the earlier mark ought to be protected by observing that a comparison limited to the sole distinctive elements of a mark would be alien to an assessment of LOC (para. 44). **LOC**

[T-448/16](#); **Mr. KEBAB / MISTER K KEBAP**; *Mr. Kebab s.r.o. v EUIPO*; Judgment of 29 June 2017; EU:T:2017:459; Language of the case: SK.


| EUTM application | Earlier trade mark |
|--|--|
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The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 29, 30, 32, 41 and 43. An opposition based on the earlier Spanish figurative mark represented above, registered for, inter alia, services in Class 43, was filed pursuant to Article 8(1)(b) EUTMR. The OD partly upheld the opposition with regard to *pastries, petits fours [cakes], farinaceous foods, pancakes, tarts, cakes* in Class 30 and *preparation and home delivery of meals made to order and street food; restaurants and restaurant services; fast food, snack bars* in Class 43. The BoA dismissed the applicant’s appeal. It endorsed the OD’s findings that there was a LOC between the conflicting trade marks. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. It emphasised the descriptive character of the common word elements and the low level of distinctiveness of the earlier trade mark. The GC dismissed the appeal. The GC endorsed the BoA’s findings that the signs in question were similar. It stated that the global assessment of the LOC, in relation to the visual, aural and conceptual similarity of the marks, had to be based on the overall impression given by the marks, taking into account, in particular, their distinctive and dominant components (para. 20). The GC considered that the dominant elements of the signs were ‘Mr. Kebab’ and ‘Mister Kebab’, respectively. It also found that these elements were distinctive (para. 29). The GC confirmed the BoA’s findings that the figurative elements of the contested sign emphasised the meaning of its word elements and as such were descriptive. Furthermore, the figurative elements in both signs were not very striking (para. 41). The signs were visually similar and aurally similar to a very high degree. In addition, they were almost identical conceptually for some of the relevant public, while they could not be compared conceptually for that part of the relevant public that would not understand their verbal elements (paras 42-46). Therefore, the GC concluded that there was a LOC between the trade marks in question (paras 47-49). It also emphasised that, although the distinctive character of the earlier trade mark had to be taken into account when assessing the LOC, it was only one factor among others involved in that assessment. The applicant’s arguments regarding the distinctive character of the earlier trade mark would have the effect of disregarding the notion of the



similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that, where the earlier mark had only a low level of distinctiveness, a LOC would exist only when that mark was reproduced completely by the mark applied for, whatever the degree of similarity between the marks in question. Such a result would not, however, be consistent with the very nature of the global appreciation that the competent authorities were required to undertake by virtue of Article 8(1)(b) EUTMR (paras 51-52). **LOC**



[T-359/16](#); **TestBild / test et al.**; *Axel Springer SE v EUIPO*; Judgment of 7 July 2017; EU:T:2017:477; Language of the case: DE.

| EUTM application | Earlier trade marks |
|------------------|--|
| TestBild |  |

The applicant sought to register the word mark **TestBild** for different goods and services. Following an opposition pursuant to Article 8(1)(b) EUTMR, based on the earlier German figurative trade marks **test** (represented above) registered in Classes 36 and 45, the EUTM application was refused for goods and services in Classes 16, 35 and 36. The appeal filed by the EUTM applicant was dismissed by the BoA. The EUTM applicant filed an action before the GC, claiming an infringement of Article 8(1)(b) EUTMR. The GC partially upheld the action, finding the goods applied for dissimilar to the protected services and for this reason ruling out a LOC pursuant to Article 8(1)(b) EUTMR. For the remainder it confirmed the BoA’s decision. The relevant public was the public at large in Germany, who would pay an enhanced level of attention as far as the financial, legal and tax advisory services in Class 36 were concerned and an average level of attention for the other goods and services (para. 20). The services applied for in Classes 35 and 36 were similar or identical to those protected by the earlier marks in Classes 36 and 45 (para. 23). The goods in Class 16 for which protection was sought (printed materials of different kinds) were not similar to the services protected by the earlier marks. The fact that the provider of advisory services was obliged to give a client written confirmation of information conveyed orally was not enough to give rise to similarity (para. 34). The comparison of the signs had to take into account the distinctive and dominant character of their elements (para. 39). The common element ‘test’ had a normal level of distinctiveness for the services in Classes 35 and 36 for which protection was sought (para. 48). It could not be neglected in the comparison of the signs (para. 51). The signs were visually, aurally and conceptually similar to (at least) an average degree (paras 63, 67 and 74). **LOC**



[T-634/15](#); **Frinsa LA CONSERVERA / FRUISA et al.**; *Frinsa del Noroeste SA v EUIPO*; Judgment of 12 July 2017; EU:T:2017:484; Language of the case: ES

| EUTM application | Earlier trade mark |
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The applicant sought to register the figurative mark represented above as an EUTMR for goods and services in Classes 29, 35 and 43. An opposition based, inter alia, on the earlier figurative EUTM represented above, registered for services in Classes 35 and 40, was filed pursuant to Article 8(1)(b) EUTMR. The OD partly upheld the opposition for the services in Class 35. The BoA dismissed the applicant's appeal. It found that there was a LOC for the services in Class 35. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the action. **Similarity of services:** the services at issue in Class 35 were partly 'highly similar' and partly 'similar to some extent', being of the same nature, having the same purpose (namely the sale of food products), and having common suppliers (para. 31). **Dominant elements:** the expression 'la conservera' would be understood as descriptive by Spanish, French, Italian and Portuguese speakers. The word elements 'Friusa' in the earlier EUTM and 'Frinsa' in the EUTM application were dominant (paras 43-47). **Similarity of signs:** there was some visual similarity and an average degree of aural similarity between the signs (paras 51-57). Conceptually, the signs were similar only insofar as they both referred to the marketing of products that were preserved either in cans or in the form of frozen products (para. 63). **LOC:** in the food sector, it was common for the same mark to have different configurations, depending on the type of food designated. The services at issue could be regarded as belonging to two distinct lines of services provided by the same undertaking (para. 73). The submission of a list of earlier marks, in support of the claim that those registrations coexisted on the market, was insufficient to show that the LOC between the marks at issue is reduced, still less eliminated (para. 77). The BoA had been right to conclude that there was a LOC (para. 82). **LOC**

♦ [T-189/16](#); **CReMESPRESSO / CREMESSO**; *Migros-genossenschafts-Bund (Switzerland) v EUIPO*; Judgment of 13 July 2017; EU:T:2017:488; Language of the case: EN.

| EUTM application | Earlier trade mark |
|---|--------------------|
|  | CREMESSO |

The EUTM proprietor was granted registration of the figurative mark represented above as an EUTM for goods in Classes 7, 11 and 30. An application for invalidity was filed pursuant to Article 8(1)(b) EUTMR in conjunction with Article 60(1)(a) EUTMR. The CD invalidated the mark for all the goods in Classes 7 and 11, and for some goods in Class 30. The BoA upheld the EUTM proprietor's appeal in part, annulling the CD decision for the goods in




Classes 7 and 11. The EUTM remained registered for these goods, as well as for the goods found dissimilar by the CD. The BoA dismissed the appeal for the remaining goods in Class 30. The invalidity applicant filed an action before the GC, stating that the level of attention of the relevant public with respect to the goods in Classes 7 and 11 covered by the marks at issue had been wrongly defined by the BoA, that the BoA had incorrectly classified the degree of similarity between the signs at issue as low, and that the BoA had wrongly concluded that there was no LOC. The GC annulled the BoA's decision for all the goods in Classes 7 and 11. For Class 30, the application was considered to be inadmissible/a mistake. The GC annulled the BoA's decision for all the goods in Classes 7 and 11 (therefore, the GC considered that there was a LOC for those goods). The GC upheld the majority of the BoA's findings (relevant public, high degree of attention for the goods at issue, comparison of the goods, and the fact that visual similarity carried more weight than aural). As regards the scope of the action — the request to invalidate the EUTM also for Class 30 in its entirety — the GC stated that either the applicant had made a mistake in requesting cancellation of the mark for this entire class or, assuming that this was indeed what the invalidity applicant intended, the action should be dismissed as inadmissible (as the Office had requested) because the invalidity applicant had not appealed before the BoA the partial cancellation of the mark for Class 30 and therefore could not request it now before the GC (paras 18-23). **Relevant public and degree of attention:** the BoA had correctly held that the goods at issue targeted both the public at large and professionals. The GC extensively assessed the level of attention of the relevant public for the goods in Classes 7 and 11, agreeing with the Office's findings that the level was high. The Office had been correct that *coffee machines* sold at a very low price were more the exception than the rule in that sector (paras 24-38, particularly paras 30, 33, 35, 38). The GC rejected the applicant's claim that the Office's Guidelines did not consider *electric kitchen machines* to be valuable goods or technically complicated machines to which the consumers would pay a higher level of attention. It explained that the legality of the BoA's decisions concerning the registration of trade marks had to be assessed solely on the basis of the EUTMR and not on the basis of the Office's Guidelines (para. 37). The comparison of goods had been carried out correctly by the BoA (no objections raised by the parties). **Comparison of signs:** the GC disagreed with the BoA on the comparison of the signs and basically carried out another comparison. The marks were visually similar (paras 42-58), and aurally similar (paras 59-67) to a high degree, and not only to a 'certain' degree as the BoA had said, because all the letters of the earlier mark were included in the contested sign and both the beginning and the ending of the marks were the same. Conceptually, the marks were similar to an average degree (and not only to a 'certain' degree as the BoA had said) due to the common element 'CREM' and because both marks would be associated with a creamy drink based on espresso coffee (paras 68-74 and particularly 72, 73). The common word 'CREM' could not be considered dominant in a word mark. The protection offered by the registration of a word mark applied to the word stated in the application for registration and not to the mark's graphic or stylistic characteristics. The applicant's claim that the protection of the earlier word mark held by it would also apply with respect to variations of stylisation similar to that of the contested mark (therefore CReMESSO or CReMESSO) was rejected (para. 56). ESPRESSO was descriptive for the goods in question, and the ending ESSO of the mark CREMESSO was very likely to be associated by consumers who did not speak Spanish, Italian or Portuguese with a creamy drink based on espresso coffee. Although the distinctiveness of an element of a composite mark had to be examined at the stage of assessing the similarity of the signs in order to determine any dominant element of the sign, the distinctiveness of the earlier mark had to be taken into account in the context of the global assessment of the LOC (para. 74). The BoA had been right to hold that the visual similarity carried more weight than the aural one because the trade marks would generally



be perceived visually before the relevant goods in Classes 7 and 11 were purchased (paras 83-84). A high level of attention did not allow the automatic conclusion that there was no LOC, since all the other factors had to be taken into account, for example identity and similarity of the goods, degree of similarity between the marks (para. 87). **LOC**

♦[T-389/16](#); **MONTORSI F. & F**; *Agricola italiana alimentare SpA (AIA) v EUIPO - Casa Montorsi Srl*; Judgment of 13 July 2017; EU:T:2017:492; Language of the case: IT. The applicant sought to register the word mark **MONTORSI F. & F** as an EUTM for goods in Class 29. An application for invalidity was filed pursuant to Article 60(1)(a) in conjunction with Article 8(1)(b) EUTMR on the basis of Italian word mark registration **Casa Montorsi** for goods in Class 29. The CD upheld the application for invalidity in its entirety. The applicant appealed that decision and the BoA dismissed the appeal. The BoA found that there was a LOC due to the similarity of the signs and the identity and similarity between some of the contested goods and the goods for which use of the earlier mark had been proven. The BoA rejected the applicant's argument that the invalidity action had to be dismissed on the grounds of an agreement signed by the parties on the coexistence of their marks in Italy. The applicant filed an action before the GC, claiming infringement of Article 60(1)(a) and Article 60(3) EUTMR. The GC dismissed the appeal. The GC first assessed the applicant's second claim and found that the BoA had been correct in finding that the agreement signed by the parties could not prove that the intervener (owner of the earlier mark) had given its express consent to registration of the contested EUTM by the applicant. The GC upheld the Office's argument that the agreement contained no reference to the contested EUTM, or to the EU or EU law. The agreement did not even mention the sign 'MONTORSI F. & F' but only the word 'MONTORSI' (para. 43). Therefore, it could not be inferred from that agreement that the parties had taken a common position on the registration of marks including the word 'MONTORSI' as EUTMs. The consent required by Article 60(3) EUTMR had to be clearly expressed. However, such consent could not be found in the agreement, which referred only to Italian trade marks that had already existed at that time (para. 45). The GC also clarified that the fact that the intervener, owner of the earlier mark, had signed a coexistence agreement with the applicant concerning their marks in Italy, did not mean that it had renounced opposing registration of an EUTM by the applicant (paras 46-50). On the basis of the foregoing, the GC rejected the applicant's first claim, that the BoA had infringed Article 60(1)(a) in conjunction with Article 8(1)(b) EUTMR, stating that, as the agreement had not included any direct consent to registration of the contested mark, and coexistence between the marks had not been proven, the BoA had been right in finding a LOC between the marks at issue. **LOC**

♦[T-223/16](#); **DEVICE OF A CLOUD RESEMBLING A SAFE / ICLOUD et al.**; *CMassive Bionics, SL v EUIPO*; Judgment of 14 July 2017; EU:T:2017:500; Language of the case: EN



| EUTM application | Earlier trade mark |
|---|--------------------|
|  | <p>ICLOUD</p> |

The applicant sought to register the figurative mark represented above as an EUTM for services in Classes 35, 42 and 44. An opposition based, inter alia, on the earlier word mark



ICLOUD, registered for goods and services in Classes 9, 35, 38 to 42 and 45, was filed pursuant to several grounds, including Article 8(1)(b) EUTMR. The OD dismissed the opposition. The BoA partly upheld the opponent’s appeal. It found that there was a LOC on the basis of the earlier word marks **ICLOUD** for all the services applied for in Class 35 and some of the services applied for in Class 42. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 95(2) EUTMR, and (ii) infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. **LOC**: the GC pointed out that the mutually opposed trade marks covered services that went beyond the commercial activities alleged by the applicant (paras 54-57). It also restated that the comparison of the goods and services under Article 8(1)(b) EUTMR had to relate to the description of the goods and services covered by the marks at issue and not to those in respect of which the trade marks were actually used unless, upon request, proof of genuine use of the earlier mark had been submitted only in respect of some of them, which had not been the case here (paras 58-59). The GC confirmed that part of the public might perceive the word element ‘dricloud’ as consisting of the two elements ‘dr’ and ‘icloud’, in particular because of the other elements in the mark and the nature of some of the services applied for (para. 65). The GC confirmed that the signs were similar overall. There was a low degree of visual similarity due to the common word element ‘icloud’, and an average degree of aural similarity for the part of the public that would pronounce the mark applied for as ‘doctor icloud’; conceptually, the signs evoked similar ideas for those consumers who understood the meaning of ‘icloud’ (paras 65-69). The applicant’s arguments that the word ‘cloud’, the expression ‘cloud computing’ and the symbol of the cloud that represents them were totally generic and used by countless undertakings could not call into question the finding of a LOC (para. 73 et seq.). **LOC**

[T-243/16](#); **Freggo / TENTAZIONE FREDDO FREDDO et al.**; *Freddo SA v EUIPO*; Judgment of 18 July 2017; EU:T:2017:522; Language of the case: EN.

| EUTM application | Earlier trade mark |
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The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 30 and 43. An opposition based, inter alia, on the earlier figurative mark represented above, registered for goods and services in Classes 29, 30 and 43, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition. The BoA dismissed the applicant’s appeal. The BoA took account of French- and Spanish-speaking consumers and found that their degree of attention would be average at most. It found, inter alia, that ‘FREDDO FREDDO’ was particularly eye-catching in the contested mark and that the relevant public would associate ‘TENTAZIONE’ with the (very similar) French and Spanish equivalents, ‘tentation’ and ‘tentación’, respectively (English: temptation), in each case a laudatory term alluding to the attractive power of the goods and services in question. The ice-cream cones also had little distinctive character. The BoA found the marks to be visually similar to a low degree, aurally similar to an average degree and conceptually dissimilar. The earlier mark had an average degree of of inherent distinctiveness. Overall, the BoA found that there was a LOC. The BoA pointed out that it was also common for a trader to use sub-brands (signs that derive from a principal mark and share with it a common distinctive element) to distinguish its various lines from one another. The applicant filed an

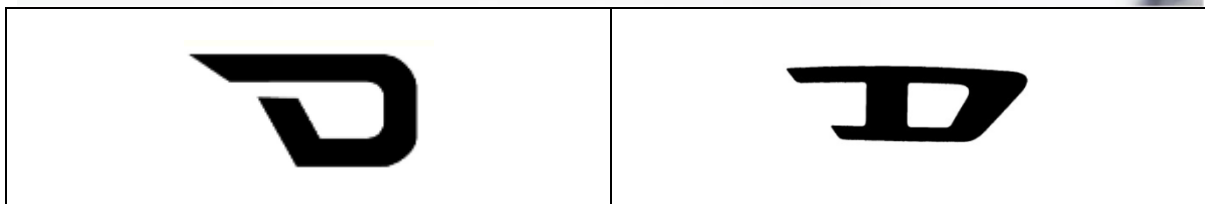


action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. This plea was divided into five ‘grounds of challenge’: (i) failing to consider each of the marks at issue as a whole; (ii) failing to take adequate account of the word element ‘tentazione’ in the earlier mark; (iii) considering the distinctive character of the marks at issue when comparing them, when this element should have been taken into account during the assessment of the LOC; (iv) adopting contradictory approaches as to the meaning or absence of meaning of the terms ‘tentazione’ and ‘freddo’ in the earlier mark from the point of view of French-speaking and Spanish-speaking consumers; and (v) considering that the mark for which registration was sought could be mistaken for a sub-brand of the earlier mark.

On the alleged infringement of Article 8(1)(b) EUTMR: the goods in issue were in part identical, in part highly similar (not disputed). The GC held that the BoA had not focused on particular elements of the mark rather than considered the marks as a whole. It pointed out that all elements of the marks had been considered visually, aurally and conceptually, and that the BoA had not therefore considered only the word element ‘freddo freddo’ in the earlier mark, as claimed by the applicant (paras 35-43). The second challenge was that the element ‘tentazione’ at top centre of the earlier mark had particular importance, which the BoA had ignored. The GC rejected this and endorsed the BoA’s view that ‘freddo freddo’ was the central, eye-catching element of the earlier mark because of the fanciful character, the size of the letters and the use of a stylised typeface, compared with the element ‘tentazione’, which was in markedly smaller standard black letters. In addition, ‘freddo’ had no meaning for French- and Spanish-speaking consumers, whereas ‘tentazione’ would mean ‘temptation’ — a laudatory term (paras 51-53). The third challenge was that the BoA had erred when considering the distinctive character of the marks at issue during the comparison of the marks because distinctiveness should be taken into account during the assessment of the LOC. The applicant argued that the ‘Flexi Air’ case (27/04/2006, C-235/05 P, Flexi Air, EU:C:2006:271) could be interpreted in this way. The GC disagreed and stressed that it was crucial to distinguish between the distinctive character of the earlier mark, which determined the protection granted to that mark and **was not** a factor in assessing the similarity between the marks and the distinctive character of an element of a composite mark, namely the greater or lesser capacity of that element to identify the goods or services for which the mark was registered as coming from a particular undertaking, which **was** a factor in assessing such similarity (paras 54-61). The applicant’s fourth challenge, that the term ‘freddo’ could be understood by French- and Spanish-speaking consumers as meaning cold and was therefore weak, was also rejected. The GC referred to the marked differences between the Italian ‘freddo’ and the French and Spanish equivalents, ‘froid’ and ‘frío’, respectively. ‘Tentazione’ on the other hand was only slightly different in Spanish and French and, consequently, would be understood. Finally, the applicant claimed that the BoA had erred in law by raising the possibility that the contested mark could be considered a sub-brand of the earlier mark. The GC found that the BoA’s statement was clearly not a necessary finding for the conclusion on LOC, such that, even if it were incorrect, that would not be sufficient to invalidate the BoA’s decision. **LOC**

♦ [T-521/15](#); **D / D**; *Diesel SpA. v EUIPO*; Judgment of 20 July 2017; EU:T:2017:536; Language of the case: EN.

| | |
|-------------------------|---------------------------|
| EUTM application | Earlier trade mark |
|-------------------------|---------------------------|



The applicant filed an application for the registration of the figurative mark represented above as an EUTM in respect of the goods in Classes 18, 25 and 28. An opposition based on, inter alia, the earlier EUTM represented above and registered for goods in Classes 18 and 25 was filed pursuant to Article 8(1)(b) EUTMR. The OD rejected the opposition because it was considered that the signs were not sufficiently similar for a LOC. The BoA fully endorsed the OD's decision and dismissed the opponent's appeal. The opponent filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC upheld the appeal, annulling the BoA's decision. The GC endorsed the BoA's findings that the relevant public in this case consisted of the general public in the EU, the level of attention of which was average (para. 27). Moreover, the GC confirmed that the earlier mark would be perceived by the relevant public as a capital letter 'D' (para. 32). However, it found that the BoA had erred in finding that only a small part of the relevant public would perceive the mark applied for as a capital letter 'D' (para. 38). The GC considered that, despite the slanted stem, which was not attached to the bowl, and the absence of a serif in the lower part of the contested trade mark, a non-negligible part of the relevant public would perceive the trade mark applied for as a capital letter 'D'. In respect of the visual comparison, the GC, unlike the BoA, considered that the minor stylistic differences between the signs could not dispel the impression of similarity gained when the marks at issue were compared overall. Therefore, there was a high degree of visual similarity between them (para. 50). As both signs at issue were capable of being perceived by a significant part of the relevant public as a capital letter 'D', they would be pronounced in the same way and were thus aurally identical (para. 54). Likewise, they were conceptually identical as they referred to the same letter of the alphabet (para. 55). Consequently, the GC held that, even if it were accepted that the earlier mark was, as stated by the BoA, not very distinctive, there was still a LOC between the signs at issue for the identical goods (para. 68), at least for the part of the relevant public that would perceive both signs as the capital letter 'D' (para. 69). **LOC**

[C-84/16 P](#); **XKING (fig.) / X (fig.) et al.**; *Continental Reifen Deutschland GmbH v EUIPO*; Judgment of 26 July 2017; EU:C:2017:596; Language of the case: EN.

| EUTM application | Earlier trade mark |
|---|---|
|  |  |

The EUTM applicant (Continental) sought to register the figurative mark **XKing** for *tyres* in Class 12. The opponent (Michelin) filed an opposition based on, inter alia, the earlier figurative French mark **X**, registered for identical and very similar goods in Class 12. The opposition was based on Article 8(1)(b) EUTMR and Article 8(5) EUTMR and was directed against all goods of the EUTM application. The OD upheld the opposition and found a LOC pursuant to Article 8(1)(b) EUTMR. The BoA found the EUTM applicant's appeal to be well




founded, annulled the OD decision and rejected the opposition in its entirety. It found that the identity or similarity of the goods in question was outweighed by (i) the differences between the marks, (ii) the consumers' high level of attention, and (iii) the low level of inherent distinctive character of the earlier French trade mark. As far as Article 8(5) EUTMR was concerned, the BoA found that the opponent had failed to provide proof of the earlier marks' reputation. Michelin filed an action before the GC, requesting that the BoA decision be annulled. It based its action, inter alia, on the claimed infringement of Article 8(1)(b) EUTMR and Article 8(5) EUTMR. The GC annulled the BoA decision for the following reasons: with regard to the distinctiveness of the element 'KING' in the EUTM application, the GC stated — contrary to what the BoA had held — that this basic English word would be perceived by the French public as meaning 'king' or 'the best', and thus, as a laudatory term for the goods in question. The GC also held that the element 'X' was the dominant element of the mark applied for, since, first, it was placed at the beginning, had no meaning in relation to the goods in question and was larger than the word 'king', and, second, the word 'king' had very little distinctive character. With regard to the visual comparison, the letter 'X', as the dominant element of the EUTM application, carried more weight than the additional element 'KING' — although the latter element was not negligible. In both marks, the letter 'X' was similar, being white with a black outline. Overall, there was an average — not just low — degree of visual similarity. Since the marks at issue shared the same first syllable, they were aurally similar to an average — not below-average — degree. As the earlier mark **X** had no meaning, no conceptual comparison was possible. Contrary to what the BoA had held, the inherent distinctiveness of the earlier mark **X** had to be deemed normal, and not merely low. Although letters were often displayed on tyres to designate a particular characteristic (e.g. 'r' (radial tyre), 'v' (speed)), it was not apparent from the evidence that the letter 'x' designated a characteristic of tyres. Furthermore, the letter 'X' of the earlier mark was not standard. It was stylised, being white, with a double outline in black. Accordingly, it would not be perceived as designating a characteristic of the goods at issue. In light of the identity/similarity of the goods, the average degree of similarity between the marks and the normal inherent distinctiveness of the earlier mark, there was LOC, even if the relevant public's attentiveness was high. Consequently, the BoA had been wrong to conclude that there was no LOC. Continental — partly supported by the Office — filed an appeal with the CJ, based on the claimed infringement of Article 8(1)(b) EUTMR. It requested that the CJ set aside the judgment under appeal and refer the case back to the GC for re-examination of the inherent degree of distinctiveness of the signs at issue, including of the elements of which those signs were composed, and re-examination of the degree of similarity between those signs. **The findings of the Court of Justice:** the CJ confirmed the appellant's claim that the GC had obviously distorted the facts when it held that it was not apparent from the evidence submitted that the letter 'X' was used, in isolation or in combination with other letters, to designate a technical characteristic of Michelin tyres, namely their tread pattern. The GC's reading of the evidence had been marred by a material inaccuracy, which resulted in an error of law when the GC concluded that the earlier French trade mark had a normal degree of inherent distinctiveness (paras 38-40). However, that error in law by the GC did not invalidate the judgment under appeal if the operative part of the judgment was shown to be well founded on other legal grounds (para. 44). With regard to the appellant's attempt to call into question the GC's assessment that the letter 'X' would be perceived as the dominant element of the mark applied for, it had to be pointed out that determining the distinctive character of the various elements of a sign and their importance in the overall impression involved weighing up those criteria, which entailed an analysis of a factual nature. However, unless the facts or evidence had been distorted — which had not been claimed — this fell outside the jurisdiction of the CJ (paras 69-71). The general rule, claimed by the appellant, that a single letter of the alphabet constituted a weakly distinctive element of a sign, was not to be



found in the case-law of the CJ (para. 72). Insofar as the appellant admonished the GC for breaching its duty to state why the letters ‘X’ in both marks were deemed to be similar overall, the CJ pointed out that the GC had held that both trade marks ‘are white and outlined in black’. It had therefore explained to the requisite legal standard the reasons for its finding (para. 84). The appellant’s questioning of whether the GC had been right in its analysis when it found only ‘slight phonetic differences’ between ‘X’ and ‘XKing’ amounted to questions of fact, which could not be the subject of an appeal before the CJ (para. 86). Finally, with regard to the finding of a LOC, the GC had based its assessment on three separate grounds, namely, first, the high degree of similarity or identity of the goods in question; second, the average degree of similarity of the marks; and third, the normal degree of inherent distinctiveness of the earlier French trade mark. Even though the assessment that the degree of distinctiveness of the earlier mark was normal, rather than low, had been based on an error in law, it had to be remembered that LOC depended on a number of factors and that the distinctive character of the earlier mark was just one of those. Even where the earlier mark had only a low degree of distinctive character, the GC might find a LOC on account, in particular, of a similarity between the signs and between the goods covered. Consequently, the GC had been fully entitled to find a LOC between the marks at issue. The error in law could not lead to the judgment under appeal being set aside. Based on the foregoing, the appeal was dismissed. **LOC**

[T-103/16](#); **Alpenschmaus / ALPEN et al.**; *Aldi Einkauf GmbH & Co. OHG v EUIPO*; Judgment of 14 September 2017; EU:T:2017:605; Language of the case: DE.


| EUTM application | Earlier trade mark |
|---|--|
|  | <p style="text-align: center;">ALPEN</p> |

The applicant sought to register the figurative EUTM represented above for, inter alia, goods in Class 30. An opposition based on the earlier word mark **ALPEN**, registered for goods in Class 30, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition. The BoA upheld the opponent’s appeal. It found that there was a LOC. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the action. **Relevant public:** since an opposition should be upheld where a LOC exists for the public in part of the EU, the BoA was entitled to restrict its assessment of LOC to the public of the United Kingdom, as long as it demonstrated that a LOC existed for that public (paras 27-28). **Similarity of the goods:** *preparations made from cereals; muesli, muesli bars; bakery goods; confectionery and cereal preparations for food for human consumption* were identical or highly similar (paras 33-37). **Distinctive and dominant elements:** the word ALPEN was not descriptive of any characteristic of the goods at issue, in particular their geographical origin. The inherent distinctiveness of ALPEN was therefore not influenced by whether or not it was perceived by the relevant public in the United Kingdom as referring to the mountain range of the Alps. Accordingly, ALPEN had an average degree of inherent distinctiveness (paras 57-62). Likewise, the word element ALPENSCHMAUS had an



average degree of inherent distinctiveness (para. 64). **Similarity of the signs:** there was a low degree of visual similarity and above-average aural similarity between the signs (paras 68-77). Regarding the conceptual comparison, either (a) it was neutral (para. 79); (b) the evocation of the concept of a mountain in the EUTM application could not lead to a conceptual dissimilarity (para. 82); or (c) a conceptual similarity would exist if the public of the United Kingdom associated the common element ALPEN with the English word Alps (para. 83). **Likelihood of confusion:** the BoA had been right to conclude that there was a LOC for the average consumer in the United Kingdom (paras 89-90). **LOC**

♦[T-620/16](#); **Idealogistic (fig.) / IDEA et al.**; *The Logistical Approach BV v EUIPO*; Judgment of 21 September 2017; EU:T:2017:635; Language of the case: FR.



| EUTM application | Earlier trade mark |
|--|-------------------------------|
| <p>Idealogistic </p> | <p>idée logistique</p> |

The applicant sought to register the figurative mark **Idealogistic** represented above as an EUTM for services in Class 39. An opposition, based on the earlier French word marks **idée logistique** and **IDEA** registered for services in Class 39, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition on the basis of earlier French mark **IDEA**. The BoA confirmed the existence of a LOC but on the basis of earlier French mark **idée logistique** (without examining the opposition based on the mark **IDEA**). It dismissed the applicant's appeal. The applicant filed an action before the GC, relying on two pleas in law: (i) the BoA had exceeded its powers and infringed Article 95 EUTMR by stating that 'logistics' was 'commercial transportation', when no evidence thereof had been submitted by the parties and 'logistics' is normally defined as a planning and organisation method, and (ii) infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. **LOC:** the GC confirmed that the services *transport; packaging and storage of goods* were aimed at a general public that would pay an average degree of attention, and not, as claimed by the applicant, a high degree (paras 32-34), as well as at a professional public that would pay a high degree of attention (para. 36). The fact that the applicant claimed to specialise in the high-security transport of valuable goods and multimedia products was irrelevant since the specification of services as filed did not include this detail (para. 35). As found by the BoA, *transport; packaging and storage of goods* were identically specified in both the contested trade mark application and the earlier mark. The applicant's claim that they targeted a different public was dismissed (paras 39-43). Consultancy ('*conseils*') was a type of information service (para. 46). The *transportation information* services covered by the earlier mark were identical with the contested *consultancy in the field of logistics, including route selection, storage facilities and selection of means of transport* (paras 44-53). There was nothing to prevent a check being made of whether there was any visual similarity between a word mark and a figurative mark, since both types of mark are graphically capable of creating a visual impression (para. 59). The marks were visually similar to an average degree (para. 61). Aurally, they were identical. The space between the two words of the earlier mark had no effect on pronunciation (para. 65). The figurative element of the contested mark was devoid of any conceptual meaning and was purely decorative (paras 72-73). Both marks referred to a 'logistic idea' ('*une idée logistique*') for the French public. 'Idea' was a basic English word (para. 77). The signs were therefore conceptually identical (para. 81). The



contested sign's figurative element was distinctive only to a low degree (para. 89). There was a LOC. **LOC**

[T-454/16](#); **Arrigoni Valtaleggio**; *Arrigoni Spa v EUIPO*; Judgment of 22 September 2017; EU:T:2017:646; Language of the case: IT

| IR designating the EU | Earlier trade mark |
|---|--|
|  |  |


The applicant sought to register an IR designating the EU for goods in Class 29. An application for invalidity was filed pursuant to Article 198(2) in conjunction with Article 60(2)(a) and 8(1)(b) EUTMR. The CD dismissed the application for invalidity in its entirety. The CD then informed the applicant that it wanted to revoke its first decision because of procedural mistakes pursuant to Article 103 EUTMR. Consequently, the CD dismissed the application for invalidity partly. The BoA dismissed the appeal. The applicant filed an action before the GC, whereupon the GC dismissed the appeal. The BoA stated that the evidence submitted by the applicant showed that the earlier mark had been used effectively for some of the goods in Class 29 such as *tomato preserves, chickpeas, peas, corn, beans, preserved lentils, preserved tuna, marmalade, olive oil*. According to the BoA, these goods belong to the subcategories *preserved food, jams, and oils for food*. Therefore, the LOC had to be assessed only with regard to these goods (para. 38). The GC found that the BoA had been correct in assessing the LOC only in relation to *preserved food, jams, and oils for food* in Class 29 (paras 42-44). Furthermore, the GC stated that, contrary to what the applicant had said, the BoA had never questioned registration of the earlier mark for all the goods in Class 29 (para. 49). According to the GC, all of the applicant's arguments based on Italian case-law and Italian law had to be rejected because the Office and GC were not bound by them (para. 52). The GC concluded that the appeal had to be rejected. **LOC**

♦[T-83/16](#); **WIDIBA / ING DiBa et al.**; *Banca Monte dei Paschi di Siena SpA and Wise Dialog Bank SpA (Banca Widiba SpA) v EUIPO*; Judgment of 26 September 2017; EU:T:2017:662; Language of the case: EN. The applicant sought to register the word mark **WIBIDA** for goods and services in Classes 9, 16, 36 and 38. An opposition, based on the existence of a LOC with regard to, inter alia, German trade mark **DiBa** for services in Class 36, was filed against all the goods and services applied for. The OD partially upheld the opposition for some goods and services in Classes 9, 36 and 38. Both parties filed appeals before the BoA. The appeal filed by the opponent was against the dismissal of the opposition with regard to *credit cards*, while the applicant's appeal requested annulment of the OD decision insofar as it upheld the opposition for some of the goods and services in question. The BoA decision upheld the appeal filed by the opponent, considering that there was a LOC also for *credit cards*. In the applicant's case, the BoA rejected the applicant's request for *restitutio in integrum* and consequently considered its appeal inadmissible because the grounds of appeal had not been filed within the relevant period established by the EUTMR. The EUTM applicant filed an action against this decision before the GC, relying on two pleas in law: (i) infringement of Articles 68 and 104 EUTMR and of Rule 49(1) of Implementing Regulation



(EC) No 2868/95 and (ii) infringement of Article 8(1)(b) EUTMR. The GC dismissed the action. **LOC:** as to the scope of the review carried out by the GC, the GC stated that the purpose was to obtain a review of the legality of the BoA decision. According to Article 95 EUTMR, revision had to be carried out in the light of the factual and legal context of the dispute as brought before the BoA. Thus, the GC may not annul or alter a decision against which an action has been brought on grounds that come into existence subsequent to its adoption. On the other hand, the pleadings of the parties in proceedings before the GC may not change the subject matter of the proceedings before the BoA (paras 49-50). Arguments regarding the absence of a LOC for goods and services other than *credit cards* had been raised for the first time before the GC (para. 51). Consequently, the applicant’s argument that, even if the request for *restitutio in integrum* were to be rejected, the Court would nonetheless be permitted to assess the legality of the entirety of the contested decision had to be declared inadmissible, and the review was to be limited to the correctness of extending the list of goods in respect of which there was a LOC to *credit cards* (paras 52-53). **Relevant public:** the relevant public appeared to consist of German consumers — in part average consumers and in part professional consumers in the financial sector with a high degree of attention (para. 58). **Comparison of the goods and services:** the GC upheld the analysis performed by the BoA. The only intended purpose of *credit cards* was their use in the course of *financial services*. The usual origin of *credit cards* and *financial affairs* had to be considered in the light of their perception by the relevant consumer in the case in question. ‘Credit cards’ were produced with the sole objective of being used in the course of a *financial service* (para. 62). **Intended purpose and usual origin:** although credit cards took the tangible form of a plastic rectangle, they also corresponded to a set of contractual relationships between, inter alia, an issuer or a supplier of financial services, which managed accounts and granted credit, and clients, who used the cards to make payments or establish credit (para. 63). Issuers were financial institutions, and consumers would not usually consider who had actually produced the tangible support but would believe that the correct functioning of credit cards was the responsibility of the issuer (para.64). Credit cards were produced solely for use in the course of financial services; therefore, it was of little importance whether they were manufactured by entities distinct from the financial institutions issuing them (para. 65). As a consequence thereof, *credit cards* and *financial affairs* were considered complementary and similar (paras 66 and 69). The Office’s Guidelines were not binding legal acts for the purpose of interpreting EU law (para. 68). **Comparison of signs:** the findings of the OD as to the similarity of the signs appeared to be well founded and had not been disputed by the parties. They had also been endorsed by the BoA; therefore, they had to be upheld (paras 73-74). **Global assessment of LOC:** there is a LOC. There was no evidence permitting the conclusion that the earlier mark did not have average distinctiveness, even if the relevant public paid a high level of attention (para. 81). **LOC**

♦[T-84/16](#); **WIDIBA / ING DiBa et al.**; *Banca Monte dei Paschi di Siena SpA and Wise Dialog Bank SpA (Banca Widiba SpA) v EUIPO*; Judgment of 26 September 2017; EU:T:2017:661; Language of the case: EN.


| EUTM application | Earlier trade mark |
|---|--------------------|
|  | <p>DiBa</p> |



The applicant sought to register the figurative mark represented above for goods and services in Classes 9, 16, 36 and 38. An opposition, based on the existence of a LOC, was filed against all the goods and services applied for. The OD partially upheld the opposition for some goods and services in Classes 9, 36 and 38. Both parties filed appeals before the BoA. The appeal filed by the opponent was against the dismissal of the opposition with regard to *credit cards*, while the applicant's appeal requested annulment of the OD decision insofar as it upheld the opposition for some of the goods and services in question. The BoA decision upheld the appeal filed by the opponent, considering that there was a LOC also for *credit cards*. In the applicant's case, the BoA rejected the applicant's request for *restitutio in integrum* and consequently considered its appeal inadmissible because the grounds of appeal had not been filed within the relevant period established by the EUTMR. The EUTM applicant filed an action against this decision before the GC, relying on two pleas in law: (i) infringement of Articles 68 and 104 EUTMR and of Rule 49(1) of Implementing Regulation (EC) No 2868/95 and (ii) infringement of Article 8(1)(b) EUTMR. The GC dismissed the action. **LOC:** as to the scope of the review carried out by the GC, the GC stated that the purpose was to obtain a review of the legality of the BoA decision. According to Article 95 EUTMR, revision had to be carried out in the light of the factual and legal context of the dispute as brought before the BoA. Thus, the GC may not annul or alter a decision against which an action has been brought on grounds that come into existence subsequent to its adoption. On the other hand, the pleadings of the parties in proceedings before the GC may not change the subject matter of the proceedings before the BoA (paras 49-50). Arguments regarding the absence of a LOC for other goods and services other than *credit cards* had been raised for the first time before the GC (para. 51). Consequently, the applicant's argument that, even if the request for *restitutio in integrum* were to be rejected, the Court would nonetheless be permitted to assess the legality of the entirety of the contested decision had to be declared inadmissible, and the review was to be limited to the correctness of extending the list of goods in respect of which there was a LOC to *credit cards* (paras 52-53). **Relevant public:** the relevant public appeared to consist of German consumers — in part average consumers and in part professional consumers in the financial sector with a high degree of attention (para. 58). **Comparison of the goods and services:** the GC upheld the analysis performed by the BoA. The only intended purpose of *credit cards* was their use in the course of *financial services*. The usual origin of *credit cards* and *financial affairs* had to be considered in the light of their perception by the relevant consumer in the case in question. *Credit cards* were produced with the sole objective of being used in the course of a *financial service* (para. 62). **Intended purpose and usual origin:** although credit cards took the tangible form of a plastic rectangle, they also corresponded to a set of contractual relationships between, inter alia, an issuer or a supplier of financial services, which managed accounts and granted credit, and clients, who used the cards to make payments or establish credit (para. 63). Issuers were financial institutions, and consumers would not usually consider who had actually produced the tangible support but would believe that the correct functioning of credit cards was the responsibility of the issuer (para. 64). Credit cards were produced solely for use in the course of financial services; therefore, it was of little importance whether they were manufactured by entities distinct from the financial institutions issuing them (para. 65). As a consequence thereof, *credit cards* and *financial affairs* were considered complementary and similar (paras 66 and 69). The Office's Guidelines were not binding legal acts for the purpose of interpreting EU law (para. 68). **Comparison of signs:** the findings of the OD as to the similarity of signs appeared to be well founded and had not been disputed by the parties. They had also been endorsed by the BoA; therefore, they had to be upheld (paras 73-74). **Global assessment of LOC:** there is a LOC. There was no evidence permitting the conclusion that the earlier mark did not have average distinctiveness, even if the relevant public paid a high level of attention (para.81). **LOC**




♦ [T-411/15](#); **GAPPOL / GAP et al.**; *PP Gappol Marzena Porczyńska v EUIPO*; Judgment of 4 October 2017; EU:T:2017:689; Language of the case: EN.

| EUTM application | Earlier mark |
|---|--------------|
|  | GAP |

The applicant sought to register the mark represented above as an EUTM for goods and services in Classes 20 and 25. An opposition based on the earlier word mark GAP, registered for goods and services in Class 25, was filed pursuant to Article 8(1)(b) and 8(5) EUTMR. The OD partly upheld the opposition for goods in Class 25 (LOC) and rejected it for goods in Class 20. The BoA dismissed the applicant's appeal and upheld the opponent's cross-appeal for *furniture* in Class 20. It found that there was a LOC for the identical goods in Class 25 and that use of the contested mark for *furniture* in Class 20 took unfair advantage of the distinctiveness of the earlier mark. The applicant filed an action before the GC, relying on five pleas in law: (i) infringement of Article 67 and Article 71(1) EUTMR, (ii) infringement of Article 94 EUTMR and Rule 50(2)(h) of Implementing Regulation (EC) No 2868/95, (iii) infringement of Article 95 EUTMR, (iv) infringement of Article 8(1)(b) EUTMR, and (v) infringement of Article 8(5) and Article 9(1)(c) EUTMR and Rule 19(2)(c) of Implementing Regulation (EC) No 2868/95. The GC partly upheld the appeal. **LOC**: the public had an average level of attention. The goods were identical. The signs were visually and aurally similar to (at least) an average degree and had a certain conceptual similarity for some of the public. There was a LOC (paras 38-109). There had been no breach of duty to state reasons (paras 110-138). **Reputation**: the GC accorded a certain probative value to the documents submitted by the opponent in order to prove the reputation of the earlier mark (paras 162-167). The BoA had correctly upheld the OD's finding that the earlier mark had a reputation. However, the BoA had not established the strength of such reputation. There was a very limited degree of proximity between *furniture* in Class 20 and *clothing, footwear, headgear* in Class 25. The BoA could have upheld the opposition on the basis of Article 8(5) EUTMR only if it had found that the earlier mark had a sufficiently strong reputation or a sufficiently high degree of distinctiveness. As the strength of reputation had not been established, the BoA had infringed Article 8(5) EUTMR. **LOC**

♦ [T-337/16](#); **VERSACCINO / VERSACE et al.**; *Versace 19.69 Abbigliamento Sportivo Srl. v EUIPO*; Judgment of 5 October 2017; ECLI:EU:T:2017:692; Language of the case: IT.


| EUTM application | Earlier trade mark |
|---|--------------------|
|  | VERSACE |

The applicant sought to register the figurative mark represented above as an EUTM for goods in Class 25. An opposition based, inter alia, on the earlier word mark **VERSACE**,



registered for goods in Class 25, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition. The BoA dismissed the applicant’s appeal. The applicant filed an action before the GC, requesting that the Court annul the contested decision and register the sign for the goods claimed. The applicant relied on two pleas in law: (i) infringement of Article 47(2) EUTMR and (ii) infringement of Article 8(1)(b) EUTMR. Regarding the claim related to the assessment of the **LOC**, the GC stated that, in order to analyse the **similarity between the goods**, the Office could only take into account the list of goods and services as filed in the trade mark application. As the applicant had not limited the goods in Class 25 for which protection was sought to *clothing for children*, the BoA had correctly taken into account all the goods within that class for which protection had been sought (paras 80-81). As to the **similarity between the signs**, the GC had rejected the applicant’s claim aimed at comparing the contested sign with the earlier figurative trade mark (a comparison that the BoA had not carried out as a measure of procedural economy). In this regard, the GC restated that, pursuant to Article 72 EUTMR, it could only carry out a review of the legality of the BoA’s decision and did not have the power to substitute its own reasoning for that of the BoA (paras 83-84). **LOC**


♦[T-36/17](#); **colineb / Colina**; *Forest Pharma BV v EUIPO*; Judgment of 5 October 2017; EU:T:2017:690; Language of the case: EN.

| EUTM application | Earlier trade mark |
|------------------|--|
| COLINEB |  |

The BoA dismissed the appeal (R 500/2016-5) against the OD’s decision. The goods of the earlier mark in Class 5 were identical to the contested goods in Class 5 and similar to a low degree to those in Class 10, the signs were similar, and there was a LOC. The GC dismissed the action. **Comparison of the goods and services:** the goods in Class 5 were identical; in particular, the contested *veterinary preparations* included, as a broader category, the *pharmaceutical products for the treatment of gastrointestinal disorders* of the earlier mark (paras 53-66). Those goods of the earlier mark were also similar, to a low degree, to the contested goods in Class 10. In particular, *pharmaceutical products for the treatment of gastrointestinal disorders* were similar to a low degree to the contested medical apparatus for the treatment of respiratory diseases (such as inhalers), essentially because certain gastric conditions are linked to respiratory conditions that the contested apparatus are used to treat (paras 67-74). **Comparison of the signs:** the signs would not be broken down into parts; the relevant German public would not single out the elements ‘COLI’ or ‘NEB’. The signs were visually similar, were aurally similar to a high degree and could not be compared conceptually (paras 75-96). Notwithstanding the high degree of attention of the relevant public, there was a LOC even in relation to the goods that were found similar only to a low degree (paras 97-102). **LOC**

[T-139/16](#); **BERG OUTDOOR / BERGHAUS et al.**; *Sports Division SR, SA (SDSR). v EUIPO*; Judgment 6 October 2017; EU:T:2017:705; Language of the case: EN.





| EUTM application | Earlier trade marks |
|---|---------------------|
|  | BERGHAUS |

The applicant filed an application for an IR designating the EU for the figurative mark represented above in respect of goods in Classes 18, 22 and 25. An opposition based, inter alia, on the two earlier EUTMsade marks represented above, which were registered for goods in Classes 20 and 22, and Classes 9, 14, 18, 21 and 25 respectively, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition and refused the mark in respect of all the goods applied for. The BoA dismissed the applicant’s appeal. It endorsed the OD’s findings concerning the identity and similarity between the goods and the similarity between the marks, and found that there was a LOC. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. Although the GC acknowledged that the applicant had not submitted its arguments regarding the coexistence of the marks and the reputation of the mark applied for in a coherent manner, the arguments were, contrary to what the Office had argued, admissible (para. 27). However, they were dismissed by GC as unfounded (paras 30 and 32). The GC endorsed the finding that the goods of the conflicting trade marks were partly identical and partly similar (para. 40) and that, for comparing the marks, account should be taken of the general public in the EU with an average level of attention (para. 39). Regarding the signs, it was concluded that BoA had correctly assessed their dominant and distinctive elements (para. 52). Moreover, the GC also confirmed that there was a certain visual similarity between the signs at issue, that they displayed an average degree of aural similarity and that there was a certain conceptual similarity for the part of the public capable of understanding the meaning of the common element ‘berg’ (para. 56). Therefore, it was concluded that the BoA had been right to find a LOC within the meaning of Article 8(1)(b) EUTMR (para. 73). **LOC**



♦[T-176/16](#); **UGO / il UGO!**; *Kofola ČeskoSlovensko a.s. v EUIPO*; Judgment of 6 October 2017; EU:T:2017:704; Language of the case: EN

| EUTM application | Earlier trade mark |
|---|--|
|  |  |

The OD upheld the opposition for all the goods in Class 32. The BoA dismissed the appeal against the OD's decision. Despite a low degree of visual similarity, there was a LOC due to the aural identity of the signs, the identity of the goods and the average distinctiveness of the earlier mark. The GC dismissed the action. **LOC**: the opponent's goods in Class 32 included the contested goods. They were identical. Contrary to the applicant's view, they had to be compared as registered and not as they were being used at the time of the comparison (para. 43). The word 'UGO' was the most dominant and distinctive element in the contested mark (para. 56) and the only clearly discernible and legible word in the earlier mark (para. 61). Its impact was greater than that of the secondary figurative elements (para. 63). 'UGO' was not descriptive of the relevant goods, namely *non-alcoholic beverages* (paras 65-67). The distinctive character of the earlier mark was therefore average (para. 68). The pronunciation of the two signs coincided in the sound of the element 'UGO' (para. 72). In the absence of proof of any meaning/different meanings of 'UGO' in the marks at issue, it was impossible to carry out a conceptual comparison (paras 74-77). Despite the different stylisation of the signs at issue, there was a LOC. The word element 'ugo', which would possibly play the main role in the process by which both signs at issue were memorised by the relevant public, was likely to be perceived by consumers as indicating the commercial origin of the goods (para. 81). **LOC**

♦[T-233/15](#); **1841**; *Cofra Holding AG v EUIPO*; Judgment of 10 October 2017; EU:T:2017:714; Language of the case: EN.



| EUTM | Earlier trade mark |
|------|--------------------|
| 1841 | AD-1841-TY |

The EUTM proprietor was granted registration of the word mark **1841** as an EUTM for, inter alia, *clothing, footwear, headgear* in Class 25. An application for invalidity was filed pursuant to Article 60(1)(a) in conjunction with Article 8(1)(b) EUTMR on the basis of earlier French word mark **AD-1841-TY** (registered on 6 June 2007) for a range of goods in Class 25. Before the CD, the EUTM proprietor requested that the applicant furnish proof of genuine use of its



earlier mark. The CD dismissed the application for invalidity insofar as the applicant had not provided such proof. The BoA upheld the invalidity applicant's appeal and declared the contested EUTM invalid in respect of *clothing, footwear, headgear*. The EUTM proprietor filed an action before the GC, relying on two pleas in law: (i) infringement of Article 64(2) EUTMR and Article 19(2) EUTMDR concerning evidence of genuine use (claimed as belated and in any event insufficient) and (ii) infringement of Article 8(1)(b) EUTMR (claiming lack of similarity of the signs and coexistence). The GC dismissed the appeal. **LOC**: the GC acknowledged the (uncontested) partial identity and similarity of the goods (para. 86) and confirmed the BoA's conclusions on the average degree of visual similarity (paras 92 and 97) and a certain degree of aural (paras 98 and 101) and conceptual similarity (para. 108). It concluded that, taking into account the overall assessment, the BoA had correctly found a LOC between the marks at issue (para. 117). The claim of alleged **coexistence** was considered inadmissible by the GC, since it had not been put forward during the proceedings before the Office (para. 122). **LOC**


[T-434/16](#); **CONTADO DEL GRIFO / EL GRIFO et al.**; *Sensi Vigne & Vini Srl v EUIPO*; Judgment of 13 October 2017; EU:T:2017:721; Language of the case: IT

| EUTM application | Earlier trade mark |
|---|--|
|  |  |

The applicant sought to register the figurative EUTM represented above for goods in Class 33. An opposition based, inter alia, on the earlier figurative mark represented above, registered for goods in Class 33, was filed pursuant to Article 46 EUTMR. The OD upheld the opposition. The BoA dismissed the appeal filed by the applicant, finding a LOC between the conflicting signs. The applicant filed an action before the GC, requesting that the GC annul the contested decision and register the sign for the products for which protection was sought. Since *wines and alcoholic beverages* were usually subject to widespread distribution, the GC found that the relevant public was the average European consumer of everyday consumer goods, who was deemed to be reasonably well informed and reasonably observant and circumspect (paras 29-30). **Similarity between the goods and services**: the quality of the goods could not be considered for assessing similarity (para. 39), but only the list of goods and services as filed in the application (para. 36). **Similarity between the signs**: the GC stated that in order to prove that the distinctive character of a term was weak, it was not sufficient to submit a list of trade marks that included the contested term and had been registered for goods in the same class. This did not necessarily prove that the relevant public might make an association between the sign and the goods in question (para. 54). Finally, the GC confirmed the relevance of the **aural similarity** between signs registered for wines, since these were usually ordered and identified by their verbal elements in restaurants and bars. In light of the foregoing, the GC found a LOC between the signs and dismissed the action. **LOC**



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

| EUTM application | Earlier trade mark |
|---|--------------------|
|  | SKY |



The applicant sought to register the figurative mark represented above as an EUTM for goods in Classes 9 and 18. An opposition based on the earlier EUTM word mark **SKY**, registered, inter alia, for goods in Classes 9 and 18, was filed pursuant to Article 8(1)(b) and Article 8(4) and (5) EUTMR. The OD upheld the opposition for the contested goods in Classes 9 and 18. The BoA dismissed the applicant’s appeal. It found that a request for PoU was inadmissible since, at the date of publication of the mark applied for, the relevant earlier mark had been registered for less than 5 years. Next, the BoA held that the (at least) average degree of visual and aural similarity between the marks and the conceptual similarity due to the concept of sky, as well as the identity of the goods at issue, meant there was a LOC. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 47(2) and (3) and Article 18(1) EUTMR in conjunction with Rule 22(2) of Implementing Regulation (EC) No 2868/95, and (ii) infringement of Article 8(1)(b) EUTMR. The applicant argued that a request for PoU was necessary where repeated applications for an earlier mark sought to circumvent or prolong the ‘grace period’ of 5 years for use of the mark and, for that reason, appeared to be ‘abusive’ (para. 17). Article 47(2) EUTMR, as applicable at the time of the facts, only required the opponent to produce, at the applicant’s request, proof of genuine use of the earlier mark ‘provided that ... the earlier Community mark was registered for not less than five years’ (para. 20). This was not called into question by the argument that a party operated a ‘practice of re-filing identical trade mark registrations’ without ever having the intention of using them (para. 23). A finding of bad faith when filing an application for an EUTM was an absolute ground for invalidity under Article 59(1)(b) EUTMR; the EUIPO could not examine such criteria in the opposition procedure. The EUTMR provided no procedural mechanism that allowed the validity of an earlier mark to be contested with regard to bad faith on the part of the opponent (paras 25-27). There was a medium degree of visual and aural similarity between the signs (paras 92 and 103) and they were conceptually similar (para. 109). The BoA had been fully entitled to hold that there was a LOC within the meaning of Article 8(1)(b) EUTMR for the goods at issue for the English-speaking part of the relevant public (para. 127). **LOC**

[T-441/16](#); **SeboCalm / Sebotherm**; *Tetra Pharm (1997) Ltd v EUIPO*; Judgment of 23 October 2017; EU:T:2017:747; Language of the case: EN. The applicant sought to register the word mark **SeboCalm** for goods in Class 3. An opposition based on the earlier EU word mark **Sebotherm**, registered for, inter alia, goods in Class 3, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition for all the contested goods and rejected the application in its entirety. The BoA dismissed the applicant’s appeal, finding that the unitary character of the EUTM meant that an opposition might prevail if there were a LOC in even only part of the EU. In this case, the average Bulgarian-, Estonian- and Slovak-speaking consumers did not perceive ‘Sebo’ at the beginning of the marks as having any meaning. Nor did they understand the other elements of the marks — the English words ‘Calm’ and ‘therm’. Consequently, the marks did not convey any concrete concept that had any impact on distinctiveness. Due to the similarity of the marks (identical beginnings and similar structure) and the fact that the goods were identical, a LOC could not be ruled out.



The applicant filed an action before the GC, relying on infringement of Article 8(1)(b) in conjunction with Article 7(2), Article 94 and Article 95(1) EUTMR. The GC dismissed the appeal. **Relevant public:** the GC confirmed that it followed from the unitary character of the EUTM that an earlier EUTM was protected in the same way in all Member States and could therefore be relied on in opposition to any subsequent application to register a trade mark that infringed that protection, even if only in the perception of consumers of part of the EU. The principle laid down in Article 7(2) EUTMR, whereby registration of an EUTM was to be refused where an absolute ground for refusal existed in part of the EU only, applied by analogy to Article 8(1)(b) EUTMR (para. 24). There was no breach of the duty to state reasons in limiting the analysis to a part of the public as this issue had been explicitly addressed by the BoA (para. 26). The degree of attention of the relevant public was not high for these everyday cleaning and personal hygiene goods (paras 28-36). **Comparison of marks:** the marks were almost identical in length and had the same first four letters and the same last letter (para. 44), which rendered them visually (para. 40 et seq.) and aurally (paras 60-62) similar to an average degree. The visual and aural aspects carried the same weight (para. 59). A conceptual comparison could not be made since the word elements and the marks as a whole were not understood by the relevant consumers (paras 67 and 68). **Overall assessment:** due to the similarity of the goods (para. 37), the average degree of visual and aural similarity of the marks (paras 55 and 62), the lack of meaning of the marks for part of the relevant public (para. 69) and the average degree of inherent distinctive character of the earlier mark (para. 75), the BoA had rightly held that it was clear from an overall assessment of the conflicting marks that part of the relevant public might believe that the products at issue were from the same undertaking or from economically linked undertakings (para. 76). **LOC**

[T-202/16](#); **coffee inn / coffee in**; *UAB Keturi kambariai v EUIPO*; Judgment of 24 October 2017; EU:T:2017:750; Language of the case: EN.

| EUTM application | Earlier trade mark |
|---|--|
|  |  |

The applicant sought to register the figurative mark represented above as an EUTM for services in Classes 35 and 43. An opposition based, in particular, on the earlier Estonian figurative mark represented above, registered for goods and services in Classes 30 and 43, was filed pursuant to Article 8(1)(b) EUTMR. At the applicant's request, the opponent furnished PoU. The OD partly upheld the opposition. The BoA dismissed the applicant's appeal. It found that the evidence of use submitted by the opponent, taken as a whole, showed genuine use of the earlier trade mark in Estonia. As regards the LOC, the BoA held that the services were partly identical and partly similar and that the signs were visually and conceptually similar to an average degree and aurally highly similar/identical. Therefore, in view also of the average distinctiveness of the earlier mark, there was LOC. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 47(2) EUTMR and (ii) infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. **LOC:**



as regards the comparison of the goods and services, the GC confirmed that there had been no need to compare the Class 30 goods of the earlier mark with the contested services in Classes 35 and 43 as this would have had no effect on the outcome of the case, which was based on a comparison of the services in Class 43 covered by the earlier mark with those in Classes 35 and 43 covered by the trade mark applied for (paras 75-78). In relation to the degree of attention of the relevant public, the GC stated that the fact that the determination of the relevant public at issue and its level of attention was not challenged by the applicant before the BoA in no way precluded the Office from having jurisdiction over the question whether the relevant public had been correctly identified. Likewise, therefore, that fact did not deprive a party of the right to challenge, before the court and within the factual and legal context of the dispute before the BoA, the findings of that body on that point (paras 84-85). On substance, the GC dismissed the applicant’s claim that consumers of coffee displayed brand loyalty and were therefore particularly attentive and selective. The GC endorsed the comparison of the signs performed by the BoA. It confirmed that the figurative elements and the graphic structure of the signs were not particularly striking and that, therefore, their word elements dominated the overall impression (paras 102-107). It also dismissed the applicant’s arguments that the signs were conceptually different due to the different meanings of ‘in’ and ‘inn’ that would be understood by the Estonian public. The GC held that the terms ‘coffee in’ and ‘coffee inn’ did not have a clear and established meaning in English and that, therefore, the BoA had not erred in holding that the signs were conceptually similar inasmuch as Estonian consumers would recognise the reference to ‘coffee’ in both word elements. Given the identity or similarity of the services, the identity of a very significant number of letters in the same position in the word elements of the two signs, and the dominant character and aural identity of those word elements, there was a LOC. The GC held, in particular, that in respect of catering services, the visual aspect played a secondary role. In order to choose a restaurant or café, a consumer usually referred to it by name (para. 138). **LOC**

[T-330/16](#); **hello digitalmente diferentes / HELLO! et al.**; *Hello Media Group SL v EUIPO*; Judgment of 26 October 2017; EU:T: 2017:762; Language of the case: ES



| EUTM application | Earlier trade marks |
|---|---|
|  | <p>1) HELLO!</p>  <p>2)</p> |

The applicant sought to register the figurative sign represented above as an EUTM for goods and services in Classes 9, 35 and 42. An opposition based on the earlier word mark **HELLO!** and the figurative sign represented above, registered for goods and services in Classes 9, 35 and 38, was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The OD upheld the opposition for all the goods and services. The EUTM applicant filed an appeal against the decision. The BoA upheld the OD’s decision. It found that a LOC existed because of the similarity between the earlier marks and the EUTM application, and the similarity or identity between the goods and services. The applicant filed an action before the GC, relying on one plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. The GC confirmed the BoA’s findings that the relevant public was the EU public, made up of both the



general public and professionals, whose level of attentiveness varied from medium to high, depending on the categories of goods and services (para. 25). It also found the contested goods and services to be partially identical and partially similar (para. 33). The GC further confirmed the BoA's assessment regarding the conflicting signs. For instance, 'digitalmente diferentes' would be perceived as a promotional formula that was not at all unusual, but merely conveyed a simple and unequivocal message that could be associated with the goods and services designated by the EUTM application (para. 46). The symbol '#' would largely be understood as a reference to metadata used in social networks (para. 51). Therefore, the expression 'digitalmente diferentes' and the symbol '#' had a low degree of distinctiveness (para. 53). Furthermore, the term 'hello' was the dominant element of the EUTM application (para. 61). The GC concluded that the signs in conflict were visually and aurally similar, and conceptually very similar (paras 68, 71 and 74) and that a high level of attentiveness from the relevant public was not enough to avoid any LOC (para. 82). Therefore, there was a LOC for the goods of Class 9 and the services of Classes 35 and 42 (para. 85). Based on the foregoing, the action was dismissed. **LOC**

[T-331/16](#); **hello media group / HELLO! et al.**; *Hello Media Group SL v EUIPO*; Judgment of 26 October 2017; EU:T:2017:760; Language of the case: ES

| EUTM application | Earlier trade marks |
|---|---|
|  | <p>1) HELLO!</p>  <p>2)</p> |

The applicant sought to register the figurative sign represented above as an EUTM for goods and services in Classes 9, 35 and 42. An opposition based on the earlier word mark HELLO! and the figurative sign represented above, registered for goods and services in Classes 9, 35 and 38, was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The OD upheld the opposition for all the goods and services. The EUTM applicant filed an appeal against the decision. The BoA upheld the OD's decision. It found that a LOC existed because of the similarity between the earlier marks and the EUTM application, and the similarity or identity between the goods and services. The applicant filed an action before the GC, relying on one plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. The GC confirmed the BoA's findings that the relevant public was the EU public, made up of both the general public and professionals, whose level of attentiveness varied from medium to high, depending on the categories of goods and services (para. 21). It also found the contested goods and services to be partially identical and partially similar (para. 29). The GC further confirmed the BoA's assessment regarding the conflicting signs. For instance, 'media group' was part of the basic English vocabulary, and designated a conglomerate of businesses in the media field (para. 40). The symbol '#' would largely be understood as a reference to metadata used in social networks (para. 44). Therefore, the term 'media group' and the symbol '#' had a low degree of distinctiveness (para. 46). Furthermore, the term 'hello' was the dominant element of the EUTM application (para. 54). The GC concluded that the signs in conflict were visually and aurally similar, and conceptually very similar (paras 61, 64 and 67) and that a high level of attentiveness from the relevant public is not enough to avoid any



LOC (para. 75). Therefore, there was a LOC for the goods of Class 9 and the services of Classes 35 and 42 (para. 78). Based on the foregoing, the action was dismissed. **LOC**

[T-627/15](#); **BIANCALUNA / bianca. et al.**; *Frame Srl v EUIPO*; Judgment of 7 November 2017; EU:T:2017:782; Language of the case: EN

| EUTM application | Earlier trade mark |
|------------------|--|
| BIANCALUNA |  |

The applicant sought to register the word mark **BIANCALUNA** as an EUTM for goods in Classes 3, 24 and 25. An opposition based on, inter alia, the earlier German figurative mark represented above (covering *clothing* in Class 25) was filed pursuant to Article 8(1)(b) EUTMR. The OD partially upheld the opposition for goods in Classes 24 and 25. The applicant filed an appeal against the OD’s decision regarding the refusal to register goods in Classes 24 and 25, which was dismissed by the BoA. The applicant filed an action before the GC against the above decision (and against decision of 07/08/2015, R 2720/2014-5, *BiancalunA (fig.) / bianca. (fig.) et al.*, regarding the BoA’s refusal to register the figurative mark ‘BiancalunA’ for goods in Class 25). The action relied on a single plea in law: infringement of Article 8(1)(b) EUTMR. The relevant public was the general public in Germany, reasonably well informed, reasonably observant and circumspect, with an average degree of attention (para. 39). The goods at issue were in part identical, in part similar (para. 67). **Scope of proceedings:** in principle, a restriction of the list of goods or services of a trade mark application carried out after the BoA had adopted a decision that was challenged before the GC could not affect the legality of that decision, except if the alteration might possibly have an effect on the examination of the trade mark carried out by the adjudicating bodies of the Office during the administrative proceedings (paras 25 and 28). The applicant had validly restricted the list of goods and withdrawn its action in part (para. 31). It was sufficient for the BoA to examine the LOC between the mark for which registration was sought and the earlier German trade mark only, since the Office was under no obligation to give priority to EUTMs if the opposition was founded on a number of earlier national marks and EUTMs (para. 77). **Similarity of the signs:** the marks were visually similar in their overall impression, since the black rectangle and the white dot could be perceived as purely decorative elements (not dominant), and the first (and common) element ‘bianca’ attracted more attention than the somewhat neutralised ‘luna’ (paras 50-52). Aurally, the marks were similar, since their common word element ‘bianca’ was pronounced first and was therefore more striking for the consumer (para. 54). The marks were conceptually similar, since the relevant German public would not recognise a concept in the term consisting of the two words ‘bianca’ and ‘luna’, but would notice the reference to the first part, ‘bianca’, which was a distinctive element of the earlier mark. The error made by the BoA in finding that the word ‘luna’ (which was a poetic synonym for ‘Mond’) would be unknown to the German public did not affect the outcome of the conceptual comparison, whereby the BoA rightly found no conceptual differences (paras 56, 62 and 65). **LOC:** given the average distinctiveness of the earlier mark, the similarity of the signs, and the identity or similarity of the goods, there was a LOC on the part of the relevant public (para. 73). **LOC**



♦[T-144/16](#); **MULTIPHARMA / MUNDIPHARMA**; *Mundipharma AG v EUIPO*; Judgment of 7 November 2017; EU:T:2017:783; Language of the case: DE. A registration for the word mark **MULTIPHARMA** as an EUTM was sought for goods and services in Classes 5, 35 and 42. An opposition based on the earlier word mark **MUNDIPHARMA** for goods in Class 5 was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition and an appeal was filed against the OD’s decision. The BoA upheld the appeal and annulled the OD’s decision, insofar as it found that, in view of the increased level of attention on behalf of the relevant public, the clear conceptual differences between the signs and the inherently weak distinctive character of the earlier mark, there was no LOC. The opponent filed an action before the GC on the ground of a single plea: infringement of Article 8(1)(b) EUTMR. The relevant public consisted of both medical professionals and average end consumers within the EU, both with a higher level of attention when recommending or buying the product, either with or without a medical prescription, since pharmaceutical products affected health (paras 24 and 26). After recognising the partial identity and varying degrees of similarity between the goods (para. 32), the GC compared the signs. It found the following: (i) the signs were visually similar in terms of overall impression, because of the common verbal elements ‘mu’ and ‘pharma’ (despite the descriptive and hence weak distinctive character of the latter). Their only difference, the verbal elements ‘nd’ and ‘lt’, was negligible, as these elements were in the middle of the respective word signs (paras 37 and 43); (ii) the signs were aurally similar for the same reasons that they were visually similar, regardless of the different rules of pronunciation that applied in different parts of the relevant territory (para. 50); (iii) it was impossible to carry out a conceptual comparison as none of the signs had a clear and specific meaning in the mind of the relevant public (para. 60). In any case, there was no clear conceptual difference that could counteract the visual and aural similarities, since both **MUNDIPHARMA** and **MULTIPHARMA** had various meanings; furthermore, ‘mundi’ and ‘multi’ were often used as banal terms in the marketing of goods or services (paras 55-57 and 64). Given that the contested goods and services were partly identical and partly similar, the signs were visually and aurally similar, and no clear conceptual difference could be found, there was a LOC in the mind of the relevant public, even assuming a higher level of attention (para. 70). **Scope of proceedings:** for the purposes of the conceptual comparison, the GC legitimately took into account a relevant judgment issued by a national (German) court and submitted before it for the first time, assessing it as case-law cited in support of the plea regarding infringement of Article 8(1)(b) EUTMR (para. 62). **LOC**

♦[T-271/16](#); **THOMAS MARSHALL GARMENTS OF LEGENDS / Marshall et al.**; *Yusuf Pempé v EUIPO*; Judgment of 8 November 2017; EU:T:2017:787; Language of the case: EN

| EUTM application | Earlier trade marks |
|---|--|
|  |  |

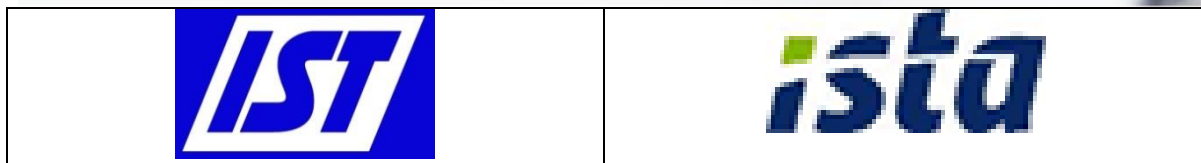
The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 9, 16, 18 and 25. An opposition based on, inter alia, the



earlier figurative EUTM represented above and registered for goods in Classes 16, 18 and 25, and the earlier EUTM (word mark) **MARSHALL**, registered for Classes 9 and 11, was filed pursuant to Article 8(1)(b) and Article 8(4) and (5) EUTMR. The OD partly upheld the opposition for goods in Classes 9, 16, 18 and 25. The applicant appealed against the OD's decision and the BoA dismissed the applicant's appeal, except for the following goods in Class 9: *apparatus and instruments for conducting, accumulating, electricity and cash registers*. It found that there was a LOC, except for the above goods (Class 9), which were different from those covered by the earlier marks. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 18(1)(a) and Article 47(2) and (3) EUMTR and (ii) infringement of Article 8(1)(b) EUTMR. **Relevant public and level of attention:** the relevant territory was the EU as a whole and, for the sake of procedural economy, the English-speaking part, with an average to high level of attention as regards normal mass consumer goods, goods attracting due consideration and goods that professionals might use (para. 30). **Comparison of goods:** given the absence of solid arguments and evidence to support any difference between the goods, they were similar or identical, taking into account their nature, (almost) identical wording, purpose, use, manufacture and distribution channels, and the complementarity of the goods (para. 88, not para. 58). **Comparison of signs:** the signs were visually similar, since they coincided in the word 'marshall', which was the dominant element of the earlier mark and was co-dominant with the word 'Thomas' in the mark applied for. The expression 'garments of legends' (in a much smaller typeface and perceived as promotional 'fluff'), the seal in the contested mark, and the word 'amplification' (also in a much smaller typeface) in one of the earlier signs were secondary in the overall impression. The additional word 'thomas' in the contested mark (being co-dominant with 'Marshall'), was not. The different typeface and the use of italics did not lead to the conclusion that the signs would be perceived as different by the relevant public (paras 61-62). The signs were aurally similar because of their common dominant element 'marshall', even taking into account the 'co-dominance' of 'marshall' and 'thomas' in the contested mark. The consumer would not pronounce either the expression 'garments of legends', because of its length and very small typeface, or the initials in the seal of the contested mark, because of their discreteness in the overall sign, their function as a 'label' and their small typeface (para. 69). The signs were conceptually similar, since the word 'marshall' could be understood as the same family name in both signs and the addition of the first name 'thomas' did not render the signs conceptually different. For part of the relevant public, the word 'marshall' of the earlier marks might be understood as referring to a person with the name 'Thomas Marshall', that is to say to the same person referred to by the dominant words of the contested mark. Given the equally distinctive character of 'thomas' and 'marshall', the relevant public would not attach greater importance to the first name 'Thomas' just because it came before the surname 'Marshall', since that order was usual when identifying people (paras 52-53 and 78). **LOC:** in view of the identical nature or similarity of the goods covered by the marks, and the visual, aural and conceptual similarity of the signs, there was a LOC between the marks, at least from the perspective of the English-speaking consumers within the EU (para. 91). It was not proven that the alleged coexistence of earlier marks on the market had been based on an absence of confusion on the part of the relevant public (para. 105). **LOC**

♦[T-80/17](#); **IST / ista et al.**; *Ingo Steiniger v EUIPO*; Judgment of 8 November 2017; EU:T:2017:784; Language of the case: DE

| EUTM application | Earlier trade mark |
|------------------|--------------------|
| | |



The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 6, 7, 8, 9, 10, 11, 17, 35, 37, 40 and 42. An opposition based on the earlier figurative mark represented above and registered for goods and services in Classes 7, 9, 11, 35, 36, 37, 38, 39, 40 and 42 was filed pursuant to Article 8(1)(b) EUTMR. The OD partially upheld the opposition for the goods and services covered by the contested trade mark. The applicant appealed against the OD’s decision. The BoA dismissed the applicant’s appeal insofar as it found a LOC, given the identity or at least similarity of goods and services, the similarity of the signs and the nature of the relevant public. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 8(1)(b) EUTMR, and (ii) infringement of Article 8(9) EUTMDR. **Relevant public and level of attention:** the relevant public consisted of both a specialised public with an increased level of attention and the general public, which, given the technical nature of some of the goods and services, would display an above-average level of attention (para. 29). **Comparison of goods and services:** the goods and services covered were identical or similar. The BoA had duly assessed the list of products and services covered by the earlier mark and its restriction by use of the term ‘namely’. It had not interpreted the list of goods and services in an excessively broad way but had merely specified which goods and services could fall under broad generic terms (para. 35). **Comparison of signs:** the signs were visually similar because of the correspondence of the letters ‘i’, ‘s’ and ‘t’, the colour blue, and the script’s slight inclination to the right. The differences, namely the final letter ‘a’ of the earlier trade mark, the shades of blue and the additional figurative elements (such as upper and lower case letters, the colour green in the earlier trade mark, the geometric figurative elements in the background of the contested trade mark, etc.) did not counteract the fact that ‘IST’ was the only word element, which could be remembered more easily and would be used to designate the trade mark (para. 47). The aural similarity between the conflicting signs was above average: the only pronounceable word element of the contested trade mark was contained in full in the word element of the earlier trade mark. The different ending of the earlier mark, the letter ‘a’, could easily be missed or ignored in certain EU languages, including English (paras 51-52). Even if a part of the relevant public would pronounce the word elements as ‘is-ta’ and ‘I-S-T’, another part would prefer the pronunciation ‘ista’ and ‘ist’ (para. 52). No conceptual comparison between the signs was possible, since neither of the signs had a meaning for the public in the relevant territory. Even though ‘IST’ on its own had a meaning in some EU languages (in German it is the third-person singular form of the verb ‘sein’ [to be]), it had no meaning in others. The earlier mark ‘ISTA’ had no meaning whatsoever except in Latin, which was irrelevant for the purposes of conceptual comparison (paras 59-60). **LOC:** given the similarity of the goods and services covered, the increased level of attention of the relevant public and the similarity of the signs, there was likelihood of confusion (para. 66). **LOC**

♦[T-129/16](#); **Claranet / Claro**; *Claranet Europe Ltd v EUIPO*; Judgment of 14 November 2017; EU:T:2017:800; Language of the case: EN

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|-------------------------|---------------------------|
| EUTM application | Earlier trade mark |
|-------------------------|---------------------------|



| | |
|-----------------|-------|
| claranet | CLARO |
|-----------------|-------|

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 9, 35, 38 and 42. An opposition based, inter alia, on the earlier Benelux word mark **CLARO** (registered for *telecommunications services* in Class 38) was filed on the grounds of Article 8(1)(b) EUTMR. The OD upheld the opposition in relation to the earlier Benelux word mark **CLARO**. The BoA dismissed the applicant’s appeal against this decision. The applicant then filed an action before the GC, relying on three pleas in law: (i) infringement of Article 8(1)(b) EUTMR, (ii) breach of the principle of equal treatment, and (iii) breach of the obligation to state reasons (Article 94 EUTMR). The protection of the earlier trade mark extended to the Benelux countries, and the relevant goods and services targeted both the public at large and the professional public in the telecommunications sector, among whom the level of attention varied from average to higher than average (paras 21-22). **Similarity between the goods and services:** the relevant goods and services in Classes 9, 35, 38 and 42 covered by the trade mark for which registration was sought were partly identical and partly similar to the *telecommunications services* in Class 38 of the earlier mark (para. 10). **Similarity between the signs:** the GC found an average degree of visual similarity because of the element common to both marks (‘clara’). The public generally paid more attention to the initial part of word marks, in particular where the element that followed (‘net’) was descriptive due to its generic character and its frequent use in the telecommunications sector, which made it less distinctive (paras 38, 41 and 55). The fact that the mark **claranet** comprised lower-case letters in a standard typeface did not affect the visual comparison of the signs (para. 63). Contrary to what the BoA had found, the signs at issue were aurally similar only to an average degree: the pronunciation of the signs differed, inter alia, by the length and sound of the second and third syllables, while the descriptive character of the element ‘net’ was also likely to have an influence (para. 77). The signs were conceptually neutral: as the term ‘claro’ had no meaning for the relevant public, no conceptual comparison of the signs could be made (para. 82). **LOC:** from the point of view of the average consumer, the goods and services covered were the same or similar, while the marks were visually and aurally similar to an average degree and conceptually neutral. Given the LOC, there was no need to examine the distinctive character of the earlier mark (paras 89-90). **LOC**

♦[T-456/16](#); **GULLON DARVIDA / DAR VIDA et al.**; *Galletas Gullón v EUIPO*; Judgment of 16 November 2017; EU:T:2017:811; Language of the case: EN

| EUTM application | Earlier trade mark |
|------------------|--------------------|
| GULLON DARVIDA | DAR VIDA |

The applicant sought to register the word mark **GULLON DARVIDA** as an EUTM for goods in Class 30. An opposition was filed by the IR/national trade mark holder pursuant to Article 8(1)(b) EUTMR, based on the earlier international trade mark **Dar Vida** for goods in




the same class, as well as on the Danish word mark **DAR VIDA**, the Finnish word mark **DAR VIDA**, the Swedish word mark **DAR VIDA** and the UK word mark **DAR VIDA**. The OD dismissed the opposition insofar as the evidence submitted upon its request for PoU was not sufficient to establish genuine use of the marks concerned and for the goods concerned in the relevant territories, namely in Denmark, Finland, Sweden and the United Kingdom, during the relevant period. The IR/national trade mark holder filed an appeal, which was upheld by the BoA. The BoA found that the IR/national trade mark holder had established its earlier right during the relevant period, that evidence of genuine use of the earlier international mark had been provided, and, finally — as the relevant goods were identical, there was an average level of visual and aural similarity between the signs and a normal level of attention on the part of the relevant public, and the earlier mark had normal inherent distinctive character — that there was a LOC. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 95 EUTMR and Article 7 EUTMDR, (ii) infringement of Article 47(2) and (3) EUTMR and Article 10(2) EUTMDR, and (iii) infringement of Article 8(1)(b) EUTMR. The GC emphasised that the BoA had discretion (i) to admit additional evidence presented for the first time before it regarding the entitlement to file an opposition and (ii) to decide whether or not it was necessary to take such additional evidence into account (paras 40 and 43). The BoA had correctly assessed the evidence presented before it. The GC made particular reference to the EUIPO’s Guidelines for Examination (Part C, Section 1) as a source of reference for BoA practice when examining the name of the opponent company, since the Guidelines constituted a self-imposed restriction on the EUIPO, namely that of complying with the rules that it had itself established (paras 55-57). **Relevant territory and public:** the relevant territory for the purposes of LOC was Germany, and the relevant public was the average consumer who was reasonably well informed and reasonably observant and circumspect (paras 17 and 86). **Comparison of goods:** the goods were found to be identical (para. 111). **Comparison of the signs:** the GC stated that the need for the sign ‘vida’ to be available for economic operators could not be one of the relevant factors to be taken into account when assessing the LOC (para. 88). The GC assessment was the following: (i) the signs had an average degree of visual similarity, s the word ‘darvida’ had no meaning for the German consumer and there was considerable similarity between the word elements ‘dar vida’ and ‘darvida’, which was not counteracted by the first element ‘gullon’ (paras 89 and 93); (ii) the signs had an average degree of aural similarity, despite the fact that the word ‘gullon’ appeared at the beginning of the mark, since the three syllables ‘dar’, ‘vi’ and ‘da’ were identical (para. 102); iii) the signs were conceptually neutral, since neither the word ‘gullon’ nor the word ‘darvida’ had any meaning in German (para. 103). There was no proof of even limited distinctiveness in the relevant territory (para. 92). **LOC:** taking into account the identity of the relevant goods, the average degree of visual and aural similarity, the normal level of attention of the relevant public and the normal degree of distinctiveness of the earlier mark, there was a LOC. The relevant public might believe that the goods came from the same undertaking (paras 110 and 112). **LOC**

[T-722/16](#); **Zerø / ZERO**; *Mapei SpA v EUIPO*; Judgment of 16 November 2017; EU:T:2017:808; Language of the case: FR.


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| EUTM application | Earlier trade mark |
|-------------------------|---------------------------|



| | |
|---|-------------|
|  | ZERO |
|---|-------------|

The applicant sought to register the figurative mark represented above as an EUTM for goods in Classes 1 and 19. An opposition based on the earlier word mark **ZERO**, registered for goods and services in Class 19, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition. The EUTM applicant appealed against the OD’s decision. The BoA dismissed the appeal. It found that there was a LOC because the contested goods were partly similar and partly identical, the signs were visually, aurally and conceptually similar, and the relevant public was specialised and displayed a high level of attention. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. The relevant public was an EU public, consisting of both average consumers and professionals in industry and construction with a high level of attention (paras 19-20). **Comparison of goods:** the contested goods were partly identical and partly similar (para. 28). **Comparison of signs:** the GC stated that, visually, the signs were similar to a high degree insofar as they had the same letters in the same order. Their differences, which lay in the border surrounding the contested trade mark and in the letter ‘ø’, written with an oblique line, could not counteract the similarity, since they would be perceived as decorative elements by the consumers (para. 35). The signs were aurally identical: the letter ‘ø’ did not exist in French or English, and the relevant public would therefore pronounce it in the same way as the letter ‘o’ (paras 40-41). The relevant public would understand ‘zero’ as the word for the figure ‘0’, whereas it would not associate the term ‘zerø’ with the expression ‘zéro résidus’ (in English, ‘zero residues’), since there were no other references in the sign applied for that would allow this term to be associated with a lack of residues (para. 45) **LOC:** given the high level of attention of the relevant public, the identity or similarity of the contested products, and the visual similarity and aural and conceptual identity of the signs, there was a LOC (para. 50). Based on the foregoing, the action was dismissed. **LOC**

[T-723/16](#); **RE-CON zerø / ZERO**; *Mapei SpA v EUIPO*; Judgment of 16 November 2017; EU:T:2017:807, Language of the case: FR

| EUTM application | Earlier trade mark |
|---|--------------------|
|  | ZERO |

The applicant sought to register the figurative mark represented above as an EUTM for goods in Classes 1 and 9. An opposition based on the earlier word mark **ZERO**, registered for goods and services in Class 19, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition. The appeal filed by the applicant was dismissed by the BoA. It found that there was a LOC because the contested goods were partly identical and partly similar, the signs were visually, aurally and conceptually similar, and the relevant public displayed a high level of attention. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 94 EUTMR and (ii) infringement of Article 8(1)(b) EUTMR. The





GC dismissed the appeal. The relevant public consisted of both average consumers and professionals in industry and construction with a high level of attention (para. 29). The contested goods were partly identical and partly similar (para. 31). Regarding the comparison of the signs, the GC stated that the signs were visually similar, insofar as they coincided in the letters 'Z-E-R-O', and differed only in the thin border surrounding the contested trade mark and in the letter 'ø', written with an oblique line (para. 42). Despite being placed first, the verbal element 're-con', which did not appear in the earlier mark, was just as dominant as the verbal element 'zero' (paras 38-39). The upper-case letters and the grey background of the verbal element 're-con' would be perceived as decorative elements and would not be remembered by the public (para. 47). The signs were aurally similar, since 'zero' and 'zerø' would be pronounced the same (para. 42). The signs were conceptually similar insofar as 're-con' had no meaning and there was no evidence on file that the contested trade mark would be perceived as meaning 'king with a zero' or 'residuo conglomerato' (conglomerated residue) by the relevant English- and French-speaking public (para. 56). **LOC:** given the high level of attention of the relevant public, the identity or similarity of the contested products and the similarity of the signs, there was a likelihood of confusion. Based on the foregoing, the action was dismissed. **LOC**

♦[T-403/16](#); **Immunostad**; *Stada Arzneimittel AG v EUIPO*; Judgment of 20 November 2017; EU:T:2017:824; Language of the case: EN. The applicant was granted registration of the word mark **Immunostad** as an EUTM for goods within Classes 3 and 5. An application for invalidity was filed, based on Article 8(1)(b) EUTMR, in respect of the subcategory *pharmaceutical preparations; dietetic substances adapted for medical use* and in the light of the earlier French word mark **Immunostim** covering, inter alia, *dietetic substances adapted for medical use, namely food supplements* in Class 5. The CD upheld the application for invalidity insofar as it found identity between the goods regarding *dietetic substances adapted for medical use* and similarity regarding *pharmaceutical preparations*. The applicant appealed against the CD's decision. The BoA dismissed the appeal because it found visual, aural and conceptual similarity between the marks, considering the similarity between the goods and the average degree of distinctiveness of the earlier mark. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 60(1)(a) in conjunction with Article 8(1)(b) EUTMR and (ii) infringement of Article 94 EUTMR. **Alleged infringement of Article 8(1)(b) EUTMR:** the relevant public was both the general public and a more specialised public with expertise in the field of healthcare in France, which would display a level of attention varying from average to high in relation to dietetic substances, and relatively high in relation to pharmaceutical preparations (para. 16). The relevant public consisted of two non-negligible groups of consumers: those who did not understand the element 'stim' as the abbreviation of the French word 'stimuler' and those who did understand the element 'stim' in that sense (para. 48). **Comparison of the goods:** the goods covered were identical to the *dietetic substances adapted for medical use* and similar to the *pharmaceutical preparations* (para. 17). **Comparison of the signs:** the two marks were highly similar visually and aurally, since they were the same length and had in common not only the element 'immuno' (which comprised the first six letters of each mark and, despite its weak distinctive character, attracted attention), but also the seventh and eighth letters, namely 's' and 't', and therefore differed only in their last two letters (paras 26 and 29-30). There was conceptual similarity, since both marks referred (by virtue of the element 'immuno') to the concepts of immunity and the immune system (para. 35). Moreover, for the part of the relevant public that did not understand the element 'stim' as the abbreviation of the French word 'stimuler', the two marks were, as a whole, arbitrary terms with no specific meaning, despite the descriptive connotation of the common initial part 'immuno' (para. 34). Even if the element 'stim' in the earlier mark were understood as being the abbreviation of



the French word ‘stimuler’, the resulting conceptual difference would not be capable of counteracting the conceptual similarity resulting from the first common element, ‘immuno’ (paras 36-37). **LOC:** in the light of the identity or similarity between the goods, and given that the signs at issue were highly similar visually and aurally, and similar conceptually, there was a LOC, even if the distinctive character of the earlier mark was weak for some of the relevant public (para. 42). **LOC**

[T-465/16](#); **cotecnica OPTIMA / visán Optima PREMIUM PETFOOD et al.**; *Cotécnica, S.C.C.L. v EUIPO*; Judgment of 20 November 2017; EU:T:2017:825; Language of the case: ES.

| EUTM application | Earlier trade marks |
|---|--|
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The applicant sought to register the figurative mark **cotecnica OPTIMA** as an EUTM for goods in Class 31. An opposition based, inter alia, on the earlier figurative mark **visán Optima PREMIUM PETFOOD**, registered for goods in Class 31, was filed on the grounds of Article 8(1)(b) EUTMR. The OD upheld the opposition in respect of the earlier figurative mark. The BoA dismissed the applicant’s subsequent appeal, and the applicant filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. **Relevant public:** given that the earlier trade mark was an EUTM, the relevant public was the general public within the European Union with an average level of attention (para. 26). **Comparison of the goods:** the goods were identical (para. 28). **Dominant and distinctive element:** neither the judgment 20/01/2009, T-424/07, *Optimum*, EU:T:2009:9 referred to by the applicant nor the documents submitted led to the conclusion that the common element ‘optima’ lacked distinctiveness (paras 46-54); however, it did have slight distinctive character for a considerable part of the public, who would understand it as a reference to something ‘very good’ and consequently as a laudatory term (para. 55). Moreover, on account of its position and size, it was the dominant element in both signs (paras 56-59), whereas the fanciful verbal elements ‘cotecnica’ and ‘visán’, despite their distinctive character, played a secondary role and were barely perceptible within the sign as a whole (paras 72-74). **Comparison of signs:** the signs were visually similar insofar as they all included the dominant element ‘OPTIMA’, while the remaining verbal elements (i.e. ‘visán’ and ‘PREMIUM PETFOOD’ in the earlier trade mark and ‘cotecnica’ in the contested trade mark), which were secondary, would attract much less attention and could be perceived as ornamental (para. 79). The signs were aurally similar because of their common dominant verbal element ‘optima’. The verbal elements ‘visán’ and ‘cotecnica’ could only be seen and understood after careful examination of the trade mark, and the expression ‘PREMIUM PETFOOD’ was almost illegible. Therefore, due to consumers’ natural tendency to simplify the pronunciation of long trade marks, those elements might not even be pronounced when the goods were requested orally, which would make the marks beingaurally identical (para. 80). The finding of conceptual similarity between the signs was confirmed in accordance with the case-law, which did not rule out similarity between signs that coincided only in elements with weak distinctive character (paras 81-84). **LOC:** there was a LOC. The principle of imperfect



recollection of the marks was of particular relevance, given the average level of attention of the relevant public, the considerable visual similarity between the signs, and the way in which the products were usually marketed (paras 89-92). **LOC**

[T-893/16](#); **MI PAD / IPAD**; *Xiaomi, Inc. v EUIPO*; Judgment of 5 December 2017; EU:T:2017:868; Language of the case: EN. The applicant sought to register the word mark **MI PAD** for goods and services in Classes 9 and 38. The intervener filed an opposition against all the goods and services of the contested mark based on the earlier word mark **IPAD**, which covered goods and services in the same classes. The OD upheld the opposition on the basis of Article 8(1)(b) EUTMR and rejected the application for registration for all the goods and services covered. The applicant filed an appeal against the OD's decision. The BoA dismissed the appeal because it considered that the marks were highly similar visually and aurally, and very similar conceptually in the English-speaking part of the EU. Moreover, it considered that the marks at issue had little distinctive character, at least for the English-speaking public. The applicant raised a single plea in law: infringement of Article 8(1)(b) EUTMR. **Relevant public**: for the goods and services in Classes 9 and 38, the average consumer's level of attention ranged from average to high, depending on complexity and price (para. 25). **Comparison of the signs**: the marks at issue did not contain any dominant elements, and the common element 'pad' could not be regarded as negligible (para. 41). The signs were highly similar visually despite the additional letter 'm' at the beginning of the mark applied for (para. 45). Aurally, the marks displayed an average degree of similarity for the English-speaking part of the relevant public of the EU and a high degree of similarity for the non-English-speaking part of that public (para. 48). Because of the meaning attributed to the common element 'pad', the marks displayed an average degree of conceptual similarity for the English-speaking part of the relevant public. As regards the non-English-speaking part, the conceptual comparison was neutral (paras 54 and 55). As the relevant territory was that of the EU, the existence of a LOC for the non-English-speaking part of the relevant public because of the high degree of visual and aural similarity between the marks at issue and the identity or the similarity of the goods and services in question was sufficient to prevent registration of the mark applied for (para. 65). **LOC**

[T-815/16](#); **opus AETERNATUM / OPUS**; *For Tune sp. z o.o. v EUIPO*; Judgment of 12 December 2017; EU:T:2017:888; Language of the case: EN.


| EUTM application | Earlier trade mark |
|---|---|
|  | <p style="text-align: center;">OPUS</p> |

The applicant sought to register the figurative sign represented above for the Classes 9, 16, 35, 40 and 41, describing the mark as follows: 'A figurative mark consisting of two words, in colour. The word "opus" is in blue (pantone cyan c) and the letter "o" is in white inside a rhombus in blue (pantone cyan c). The word "aeternatum" is in black, upper-case letters.' Simplicity trade GmbH filed an opposition pursuant to Article 8(1)(b) EUTMR against the goods and services in Classes 16, 35 and 41, based, inter alia, on the earlier EU word mark **OPUS**. The OD partially upheld the opposition, refusing the application for *Paper, cardboard*



and goods made from these materials, not included in other classes, printed matter; book-binding material, photographs, plastic materials for packaging (not included in other classes), in Class 16, advertising; business management; business administration; office functions in Class 35 and education; providing of training; entertainment; sporting and cultural activities in Class 41. The applicant filed a notice of appeal against the OD's decision. The BoA dismissed the appeal and held that there was a LOC between the marks. The applicant raised a single plea in law: infringement of Article 8(1)(b) EUTMR. **RELEVANT PUBLIC:** the goods and services in Classes 16 and 35 were aimed at both the general public and business customers. The level of attention might vary from average (Class 16) to high (Class 35); for Class 41, in which the services were rather varied and aimed at both the general public and professionals, the level of attention was normal (para. 29). **Comparison of the goods and services:** the goods in Class 16 and the services in Class 35 and 41 were identical to those covered by the earlier mark (para. 34). **Comparison of the signs:** the two marks were visually similar as they both contained the word OPUS (para. 39). Moreover, in the mark applied for, the word element OPUS was dominant as it was the largest element and was placed above the smaller element AETERNATUM (paras 44-46). The graphic elements were only slightly distinctive because they would be perceived as decorative and meaningless elements, and the stylised typeface had no effect on the overall impression of the mark (paras 47-50). Aurally, the signs were similar if not identical as the pronunciation of the marks coincided in the syllables 'o' and 'pus' and it was likely that a significant part of the relevant public would not pronounce the element 'aeternatum' (para. 58). Conceptually, the signs had the concept of 'opus' in common, while the word 'AETERNATUM' and the figurative elements had no meaning for a significant part of the public in the relevant territory (para. 63). **Distinctive character:** the earlier mark had a normal degree of inherent distinctiveness arising out of the fact that it was not, as a whole, descriptive, allusive or laudatory (para. 69-72). **LOC:** as the goods and services concerned were identical or similar to a normal degree and the distinctive word element was not only common to both marks but also dominant in the mark applied for — meaning that the two marks were visually and conceptually similar and aurally similar to an average degree — there is a LOC (para. 79). **LOC**

[T-792/16](#); **ojo sunglasses / oio et al.**; *N & C Franchise Ltd v EUIPO*; Judgment of 14 December 2017; EU:T:2017:908; Language of the case: EN.

| EUTM application | Earlier trade mark |
|---|--|
|  | <p style="text-align: center;">oio</p> |

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 9, 21 and 37. An opposition based on the earlier international word mark **oio**, registered for *spectacles, spectacle frames, optical apparatus and instruments* in Class 9, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition and the applicant filed an appeal against the OD's decision. The BoA dismissed the applicant's appeal. It found that given the average to high level of attention of the public, the higher than average visual and aural similarity of the signs and the similarity or identity of



the goods, there was a LOC. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. **Relevant public:** the relevant public was in the EU, and in particular in the part where Slovenian was spoken, and paid a higher than average degree of attention, depending on the price and frequency of purchase of the goods and services (paras 21 and 23). **Comparison of goods:** the goods covered by the signs were identical or similar (para. 23). **Comparison of signs:** the signs were visually similar to a higher than average degree. The ‘figurative element’ of the contested mark, representing the shape, in yellow, of a nose and two eyes, was purely descriptive and therefore less distinctive than the word element ‘ojo’, whereas the earlier trade mark, ‘oio’, was almost entirely reproduced in the contested mark ‘ojo’, in which it also formed the most dominant and distinctive element, since it was clearly visible owing to its size and position (in first place) within the mark (paras 31, 34 and 40). According to the EUIPO’s Guidelines for Examination, for three-letter signs, a difference of one letter does not rule out similarity, especially if that letter is aurally similar, as in this case (para. 34). The signs were aurally similar to a high degree, as the words ‘ojo’ and ‘oio’ would both be pronounced the same, at least in Slovenian (para. 52). **LOC:** the evidence showing that consumers visiting the applicant’s shops would not expect to find goods originating from other manufacturers was irrelevant, since the applicant’s actual distribution method should not be taken into consideration (paras 61-62). Moreover, the fact that the earlier trade mark was not particularly well known or highly distinctive did not prevent consumers from perceiving economic links between the marks (para. 68). Given the identity or similarity of the goods, the average to high degree of attention of the relevant public, and the high visual and aural similarity of the signs (the dominant and distinctive element ‘ojo’), there was a LOC (para. 71). **LOC**

[T-912/16](#); **RROFA / ROFA et al.**; *RRTec sp. z o.o. v EUIPO*; Judgment of 14 December 2017; EU:T:2017:905; Language of the case: EN.

| EUTM application | Earlier trade mark |
|---|--------------------|
|  | <p>ROFA</p> |


The applicant sought to register the figurative sign represented above as an EUTM for goods and services in Classes 4, 7, 9, 11, 37, 39, 40 and 42. The intervener filed an opposition against the goods and services in Classes 11, 37 and 42, based on, inter alia, the earlier EUTM (word mark) **ROFA**, which covered: *apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes specially air feed devices for incineration works in Class 11; building construction; repair; installation services specially construction, installation and maintenance concerning environmental engineering works and works for incineration in Class 37; and scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software specially engineering construction investigations and consultations concerning environmental engineering, incineration technique and emission technique in Class 42.* The opposition was filed pursuant to Article 8(1)(a) and (b) EUTMR. The OD partially upheld the opposition because there was



a LOC between the signs at issue for all the goods and services in Classes 7, 11, 37 and 42 and for the *transmission and distribution of steam and hot water; water supply and distribution; and information relating to the aforesaid fields* in Class 39 and the *production and processing of thermal energy; production of heat (steam and hot water); and information relating to the aforesaid fields* in Class 40. The applicant filed a notice of appeal against the OD's decision. The BoA held that there was a LOC between the marks under Article 8(1)(b) EUTMR. The applicant raised a single plea in law: infringement of Article 8(1)(a) and (b) EUTMR. The BoA did not examine the ground for opposition based on Article 8(1)(a) EUTMR because the applicant had not developed any specific line of argument in its application that differed from the argument put forward in support of its plea alleging infringement of Article 8(1)(b) EUTMR. The relevant public consisted of both the general public and professionals within the EU with at least an average level of attention, or even higher than average (depending on the goods and services in Classes 11, 37 and 42) (paras 27-34). After confirming that the goods and services in Classes 11, 37 and 42 of the earlier mark, were identical, similar or similar to a low degree to the goods and services in Classes 7, 11, 37 and 42 of the mark applied for (para. 21), the GC compared the signs. It found them visually similar because the earlier sign **ROFA** was totally incorporated in the contested sign **RROFA**, even if the latter had five letters in a specific typeface and the first two letters in bold (which did not, however, add to the sign's distinctive character) (paras 41-42). The signs were aurally similar because it was unlikely that a significant part of the relevant public would pronounce the signs differently due to the additional 'r' in the contested sign (paras 45-46). A conceptual comparison was not possible as none of the signs had a clear and specific meaning for the relevant public (para. 47). **LOC**: given the high similarity between the marks at issue, the identity or relatively high similarity of the goods and services concerned, and the average distinctive character of the earlier mark, there was a LOC (para. 55). In the assessment of the LOC, the section of the public with the lowest level of attention had to be taken into consideration, and it was not necessary to examine the LOC for the relevant public with a higher than average level of attention (para. 56). **LOC**

2. **No likelihood of confusion (NO LOC)**

[T-325/15](#); **Choco Love / CHOCOLATE**; *Sun System Kereskedelmi és Szolgáltató Kft. v EUIPO*; Judgment of 25 January 2017; EU:T:2017:29; Language of the case: EN.

| EUTM application | Earlier trade mark |
|---|--------------------|
|  | <p>CHOCOLATE</p> |

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 10, 11 and 44. The opponent filed an opposition based, inter alia, on a word mark for goods in Classes 10 and 11 (mostly tanning apparatus). The OD partly upheld the opposition and the EUTM was rejected for all the goods and services in Classes 10 and 44 and some of the goods in Class 11. The OD's decision was annulled by the BoA. The opponent filed an action before the GC. **Relevant public**: the GC emphasised that the goods in Class 10, which were tanning appliances, especially those for medical purposes, were specialist goods, which were usually bought only by professionals or by end



consumers with a high level of attention (para. 31) and that the services in Class 44 were aimed not only at professionals but mainly at non-professionals with an average level of attention (para. 32). As regards the contested goods in Class 11, namely *solarium equipment (quartz lamps); tanning beds; tanning apparatus (sun beds); solaria, other than for medical purposes*, they were mainly intended for professionals and, more exceptionally, for end consumers. They were also specialist goods, which were relatively expensive and in respect of which the level of attention was high. The level of attention of the relevant public, whether professionals or end consumers, was high. The GC emphasised that price was only one factor among others to be taken into consideration when determining the level of attention of the relevant public. **Comparison of goods and services:** the GC upheld the finding that the goods in Classes 10 and 11 were identical (not disputed) but that the goods in Class 11 were only remotely similar to the services in Class 44 (paras 39-46). **Comparison of signs:** the marks were visually and aurally similar only to a low degree. Conceptually, the element LOVE altered the meaning of the contested mark, with the result that the signs were conceptually similar and not identical as claimed (para. 67). **Distinctiveness of the earlier trade mark:** the GC confirmed the BoA findings that the opponent had not proven the claimed enhanced distinctiveness of the earlier marks, since the evidence submitted had not been translated (para. 75), and that the earlier mark’s distinctiveness was weak for the goods since ‘chocolate’ would be associated with the colour brown as a reference to tanning and achieving the desired colour of tanned skin by using the goods at issue (paras 77 and 78). The GC also rejected the claim of a family of marks as there was no PoU of a sufficient number of trade marks capable of constituting a family. **Global assessment:** in view of the differences between the marks at issue, the average and high levels of attention of the relevant public, and the principle of interdependence between factors to be taken into account, it could not be held that there was a LOC, even though the goods and services at issue were in part identical and in part remotely similar. The remaining earlier rights were even less similar to the contested one. **NO LOC**

[T-187/16](#); **LITU / PITU**; *Anton Riemerschmid Weinbrennerei und Likörfabrik GmbH & Co. KG v EUIPO*; Judgment of 25 January 2017; EU:T:2017:30; Language of the case: EN. The applicant filed an application for registration of the word mark **LITU** as an EUTM in respect of goods in Class 33. An opposition based on the earlier EUTM **PITU**, registered for goods in Classes 30, 32 and 33, was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The OD rejected the opposition in its entirety. The BoA dismissed the opponent’s appeal. It endorsed the OD’s findings that there was no LOC between the conflicting trade marks and that the opponent had failed to prove the reputation of the earlier trade mark. The opponent filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. The GC endorsed the BoA’s findings that the goods of the conflicting trade marks were identical and that they targeted the general public in the EU, who would show an average level of attention (para. 23). The signs were found to be visually and aurally similar to the extent that they shared the three letters ‘-ITU’ in common. However, their first letters, namely ‘L’ and ‘P’, respectively, were markedly different (paras 25 and 28). The signs could not be compared conceptually (para. 29). Therefore, the GC concluded that even if the goods were considered to be identical, there was, in view of the clear differences between their first letters and the fact that they were rather short signs, no LOC between the trade marks in question (paras 32-34). **NO LOC**

♦ [T-106/16](#); **ZIRO / zero**; *zero Holding GmbH & Co. KG v EUIPO*; Judgment of 9 February 2017; EU:T:2017:67; Language of the case: EN.

| EUTM application | Earlier mark |
|------------------|--------------|
|------------------|--------------|




ZIRO

ZERO

The EUTM applicant sought to register the mark depicted above for, insofar as relevant, goods in Classes 14 and 25. An opposition based on the earlier figurative mark represented above, registered for goods in Classes 14 and 25, was filed on the grounds of Article 8(1)(b) EUTMR. The OD dismissed the opposition. The BoA dismissed the opponent's appeal. The opponent filed an action before the GC, raising two pleas in law: (i) infringement of Article 8(1)(b) EUTMR and (ii) infringement of Article 94, second sentence, EUTMR. The GC annulled the contested decision on the first plea; there was therefore no need to assess the second plea. The relevant public was made up of the public at large, with an average degree of attention for goods in Class 25 and a high degree for goods in Class 14 (para. 20). The goods were identical, with the sole exception of the *precious metals and their alloys, not included in other classes* in Class 14 (para. 23). The relevant public would recognise the verbal element 'ziro' in the contested mark. The signs were of average visual similarity (paras 25-36). The signs were aurally similar to an average degree, at least for the English-speaking relevant public (paras 37-46). Conceptually, the verbal element 'zero' of the earlier sign had a meaning in English and several other widely spoken languages of the EU. However, as the verbal element 'ziro' had no clear and specific meaning, the signs at issue were not conceptually similar (paras 47-50). Although the GC agreed with the BoA that the visual aspect of the goods at issue had greater importance in the global assessment of the LOC, it found, in contrast to the BoA, that the signs at issue were of average visual and aural similarity (para. 53). Conceptual differences between two signs could counteract visual and aural similarities between them, provided that at least one of the signs had a clear and specific meaning for the relevant public. In the present case, as 'ziro' had no clear and specific meaning, the signs were not conceptually different. It was possible only to find that, conceptually, that element was not similar to the verbal element of the earlier sign. In such circumstances, the lack of conceptual similarity was not capable of counteracting the average visual and aural similarity (para. 54). **NO LOC**

[T-369/15](#); **PALOMA / Paloma**; *Hernández Zamora, S.A. v EUIPO*; Judgment of 17 February 2017; EU:T:2017:106; Language of the case: EN.



| EUTM application | Earlier mark |
|------------------|--|
| PALOMA |  |

The applicant sought to register the word mark **PALOMA** as an EUTM for goods in Class 31. An opposition based on the earlier figurative mark represented above, registered for goods in Class 31, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition insofar as it considered the goods dissimilar. The BoA dismissed the opponent's appeal. It confirmed that the goods were dissimilar. The opponent filed an action before the GC, relying



on one plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. It confirmed that the goods were dissimilar. The GC reiterated standard case-law to the effect that, in assessing the similarity of the goods, the BoA had been right not to take into account the similarities between the signs (paras 23-24). The GC confirmed each of the conclusions of the BoA regarding the dissimilarity between the contested *roses and rose plants; propagation material of roses* and the opponent's *fruits, garden herbs, fresh*. Their nature and intended use was very different (non-edible organisms *v* fresh food items) (para. 25). Moreover, the goods were neither in competition (they served different purposes so could not be interchangeable) (para. 26), nor complementary (one was not indispensable or important for the other) (para. 27). Finally, the GC confirmed the Office practice that the fact that the goods may be sold in the same department stores is not particularly significant given the very different kinds of goods that may be found in those shops (para. 28). The GC stressed that the opponent had not adduced any evidence calling these findings into question. It dismissed the opponent's arguments, including the reference to the Explanatory Note to Class 31 of the Nice Classification, which referred to all the goods as 'land products' and showed that that Class included a wide variety of different goods. The GC also restated that the Nice Classification served only administrative purposes pursuant to Rule 2(4) of Implementing Regulation (EC) No 2868/95 (para. 33). During the proceedings, the Office raised the fact that the original ES version of the opponent's goods *frutas y hortalizas frescas* had been incorrectly translated into EN as *fruits, garden herbs, fresh*. Dissimilarity of the goods was even more obvious when account was taken of the authentic ES version (which does not refer to *garden herbs*). The GC sent a written question, enquiring about the effect of this error on the case. It confirmed the Office's views in this regard: the ES version was the authentic one but in any event, the error had no effect on the legality of the decision as the BoA's conclusions could be transposed to a comparison with the correct translation of the goods. None of the BoA's conclusions were specific to *garden herbs* (para. 37 to 43). **NO LOC**

♦ [T-276/15](#); *e / e*; *Edison SpA v EUIPO*; Judgment of 14 March 2017; EU:T:2017:163; Language of the case: EN.



| EUTM application | Earlier trade mark |
|---|--|
|  |  |

The OD dismissed an opposition based upon Article 8(1)(b) EUTMR in its entirety. The BoA allowed the appeal in part, finding a LOC between the conflicting marks for the identical goods and services. This part of the BoA decision was not challenged before the GC. The BoA rejected the appeal for the similar and dissimilar goods and services (inter alia, *electric energy emanating from wind power; plants for the production of renewable energy; leasing of wind power energy generating facilities*), for which it found no LOC for the relevant public with a high degree of attention. This followed from the very low degree of similarity between the signs and the fact that the earlier mark's degree of distinctiveness stemmed from its specific stylisation rather than from the presence of the letter 'e'. The evidence submitted had not proven that the earlier mark had acquired enhanced distinctiveness through use. Before the GC, the opponent argued that the signs were similar (and not just similar to a low degree), the goods and services were identical or highly similar, and enhanced distinctive



character through use had been established for its earlier mark in the proceedings before the Office. The GC rejected the opponent's three arguments and dismissed the appeal. **LOC**: the GC confirmed the BoA finding that the signs at issue are 'at most, similar overall to a low extent' (paras 23-29). Even though the signs could both be perceived as representing the letter 'e', they differed visually in their respective colours, typefaces and the overall impressions they conveyed (para. 25). An aural comparison served no purpose as the signs would be described rather than pronounced (para. 26). Conceptually, the signs were identical as the letter 'e' would be perceived as a descriptive reference to 'energy' or 'electricity' (paras 27 and 33) — 'with the result that the conceptual identity is of limited importance in the comparison of the marks' (para. 28). **NO LOC**


[T-495/15](#); **Mountain citrus / monteCitrus**; *Sociedad agraria de transformación No 9982 Montecitrus v EUIPO*; Judgment of 16 March 2017; EU:T:2017:173; Language of the case: EN.

| EUTM application | Earlier trade mark |
|--|---|
|  |  |

The applicant sought to register the figurative mark represented above for goods and services in Classes 29, 31 and 39. An opposition based on the earlier figurative EUTM represented above, registered for goods in Classes 29, 31 and 32, was filed pursuant to Article 8(1)(b) EUTMR. The OD found no LOC. The BoA dismissed the appeal. The applicant sought partial annulment of the BoA decision (paras 16 and 17) insofar as the BoA had ruled out a LOC for the goods in Classes 29 and 31. The GC dismissed the appeal. The GC confirmed that the level of attention of the public to be taken into account was that of the average consumer, which was neither high nor low, since the goods in question were aimed at the general public, even if the parties possibly did not sell directly to the public. With regard to the comparison of the marks, the GC confirmed the finding of a low degree of visual similarity, since the different figurative elements and the colours of the earlier mark created a different visual impression (paras 38, 39 and 40). It also confirmed a high degree of conceptual similarity, but disagreed with the aural comparison of the marks: the GC found the degree of aural similarity to be average rather than low (as the BoA had found) since the marks had in common the word 'citrus' and since there was no clear aural difference between the syllables 'tain' and 'te', as the BoA had already found (paras 44-49). Despite the identity of the goods, the aural similarity and the high degree of conceptual similarity, the GC confirmed the finding of no LOC, since the aural and conceptual aspects of the signs would not hold the public's attention: as food products were self-selected, the visual similarity, with assessment of the figurative elements, was of greater importance than aural and conceptual similarities (paras 62 and 63). Moreover, where the idea conveyed was descriptive, the conceptual similarity had no impact on the global assessment. **NO LOC**



♦ [T-39/16](#); **NANA FINK / NANA**; *Nanu-Nana Joachim Hoepf GmbH & Co. KG v EUIPO*; Judgment of 6 April 2017; :EU:T:2017:263; Language of the case: DE

| IR designating the EU | Earlier trade mark |
|---|--------------------|
|  | <p>NANA</p> |

The intervener had obtained the IR designating the EU of the figurative mark represented above for goods in Classes 14, 18 and 26. Following the IR's publication, the applicant filed a notice of opposition. The opposition was based on the earlier EU word mark **NANA**, registered for goods in Classes 14, 18 and 26, pursuant to Article 8(1)(b) EUTMR. The opposition was rejected, due to lack of similarity between the goods, for some of the goods and upheld, because of a LOC, for the other goods covered by the IR at issue. The applicant filed an appeal against the decision. The BoA upheld the OD's decision. It found that, given the lack of similarity between the goods, there was no LOC for the marks at issue. The applicant filed an action before the GC, relying on one plea in law based on infringement of Article 8(1)(b) EUTMR. The GC partially annulled the decision. Regarding the alleged infringement of Article 8(1)(b) EUTMR, the GC confirmed that the relevant territory was that of the European Union (para. 59) and that there was no similarity between the goods at issue (para. 80) and thus no LOC for the marks (para. 92). However, the main issue was the BoA's failure to fulfil one of its obligations. The OD had upheld the opposition for *products made of precious metals and their alloys* and rejected it for *precious metals and their alloys* (para. 30). However, in its decision, the BoA had failed to adjudicate on the appeal brought before it as regards *precious metals and their alloys*. Thus, the GC considered that the BoA had failed to fulfil its obligation to decide on the entirety of the appeal before it, pursuant to Article 71(1) EUTMR (para. 37). Consequently, the contested decision had to be annulled insofar as the BoA had omitted to rule on *precious metals and their alloys* in Class 14 for the IR at issue (para. 93). **NO LOC**

[T-13/15](#); **PostModern / Deutsche Post et al.**; *Deutsche Post AG v EUIPO*; Judgment of 27 June 2017; EU:T:2017:434; Language of the case: DE.


| EUTM application | Earlier trade marks |
|-------------------|----------------------------------|
| <p>PostModern</p> | <p>POST</p> <p>Deutsche Post</p> |

The applicant sought to register the word mark **PostModern** as an EUTM for, inter alia, various transport and postal services in Class 39. An opposition based on the earlier German word mark 'POST' and the earlier EUTM 'Deutsche Post', registered, inter alia, for various



transport and postal services in Class 39, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition for these services. The BoA upheld the applicant’s appeal. It found that, despite the visual and aural concurrences, the conflicting signs were similar only to a low degree only, if at all. Taking into account the differences in the conflicting signs’ meanings, their composition and the earlier mark’s low degree of distinctiveness, the BoA ruled out a LOC. The GC dismissed the appeal. The conflicting services targeted the general public and professionals; for the earlier mark ‘POST’, the consumers were in Germany (para. 27). The conflicting services were identical or highly similar (para. 29). The meaning of the EUTM application could not just be reduced to ‘modern post’ or ‘post’, ignoring the evident connection with the postmodernist movement. ‘PostModern’ was a play on words, which could be understood as referring to modern postal services; however, the way it was composed alluded to said movement. The fact that the services in question did not have any connection with postmodernism did not prevent the use of such a play on words. The relevant public was accustomed to trade marks with a general meaning that did not describe the goods or services (paras 40-42). The capital letter ‘M’ of ‘PostModern’ was irrelevant in a word mark registration and did not affect the play on words (para. 43). The EUTM application contained the earlier mark ‘POST’, but not all word combinations containing the Latin prefix ‘post’ could be considered related to the earlier mark (para. 44). Even if the earlier mark ‘POST’ were held to enjoy some degree of enhanced distinctiveness, the term ‘post’ could not play a dominant role in the EUTM application (para. 48). It did not play an independent distinctive role within the EUTM application either, as the latter constituted a logical unit on account of its play on words (paras 49-52). Visually and aurally, the conflicting signs were similar to a low degree only (paras 57-58). In the overall assessment, these similarities were counterbalanced by the conceptual difference, despite the identity or high similarity of the conflicting services. The EUTM application also had a normal degree of distinctiveness. Therefore, there was no LOC with the earlier mark ‘POST’ (paras 66-68). As regards LOC with the earlier EUTM ‘Deutsche Post’, the GC confirmed the BoA’s findings that the EUTM application would be understood as a reference to postmodernism also outside Germany, and that the majority of consumers in the EU would perceive the earlier EUTM as a German expression designating the former monopolist of postal services in Germany. For these consumers, therefore, the conflicting signs had a different meaning. For consumers understanding only the EUTM application and not the meaning of ‘post’ (e.g. Spanish consumers), the signs were conceptually no more similar either since the earlier EUTM was meaningless for them. Given the differences in meaning, the significant dissimilarities in their composition and the low degree of distinctiveness of the earlier mark, there was no LOC (paras 76-78). **NO LOC**

♦ [T-189/16](#); **CReMESPRESSO / CREMESSO**; *Migros-genossenschafts-Bund (Switzerland) v EUIPO*; Judgment of 13 July 2017; EU:T:2017:488; Language of the case: EN.

| EUTM application | Earlier trade mark |
|---|--------------------|
|  | CREMESSO |

The EUTM proprietor was granted registration of the figurative mark represented above as an EUTM for goods in Classes 7, 11 and 30. An application for invalidity was filed pursuant to Article 8(1)(b) EUTMR in conjunction with Article 60(1)(a) EUTMR. The CD invalidated the mark for all the goods in Classes 7 and 11 and for some goods in Class 30. The BoA upheld the EUTM proprietor’s appeal in part, annulling the CD decision for the goods in Classes 7 and 11. The EUTM remained registered for these goods, as well as for the goods found





dissimilar by the CD. The BoA dismissed the appeal for the remaining goods in Class 30. The invalidity applicant filed an action before the GC, stating that the level of attention of the relevant public with respect to the goods in Classes 7 and 11 covered by the marks at issue had been wrongly defined by the BoA, that the BoA had incorrectly classified the degree of similarity between the signs at issue as low, and that BoA had wrongly concluded that there was no LOC. The GC annulled the BoA's decision for all the goods in Classes 7 and 11. For Class 30, the application was considered to be inadmissible/a mistake. The GC annulled the BoA's decision for all the goods in Classes 7 and 11 (therefore, the GC considered that there was a LOC for those goods). The GC upheld the majority of the BoA's findings (relevant public, high degree of attention for the goods at issue, comparison of the goods, and the fact that visual similarity carried more weight than aural). As regards the scope of the action — the request to invalidate the EUTM also for Class 30 in its entirety — the GC stated that either the applicant had made a mistake in requesting cancellation of the mark for this entire class or, assuming that this was indeed what the invalidity applicant intended, the action should be dismissed as inadmissible (as the Office had requested) because the invalidity applicant had not appealed before the BoA the partial cancellation of the mark for Class 30 and therefore could not request it now before the GC (paras 18-23). **Relevant public and degree of attention:** the BoA had correctly held that the goods at issue targeted both the public at large and professionals. The GC extensively assessed the level of attention of the relevant public for the goods in Classes 7 and 11, agreeing with the Office's findings that the level was high. The Office had been correct that *coffee machines* sold at a very low price were more the exception than the rule in that sector (paras 24-38, particularly paras 30, 33, 35, 38). The GC rejected the applicant's claim that the Office's Guidelines did not consider *electric kitchen machines* to be valuable goods or technically complicated machines to which the consumers would pay a higher level of attention. It explained that the legality of the BoA's decisions concerning the registration of trade marks had to be assessed solely on the basis of the EUTMR and not on the basis of the Office's Guidelines (para. 37). The comparison of goods had been carried out correctly by the BoA (no objections raised by the parties). **Comparison of signs:** the GC disagreed with the BoA on the comparison of the signs and basically carried out another comparison. The marks were visually similar (paras 42-58) and aurally similar (paras 59-67) to a high degree, and not only to a 'certain' degree as the BoA had said, because all the letters of the earlier mark were included in the contested sign, and both the beginning and the ending of the marks were the same. Conceptually, the marks were similar to an average degree (and not only to a 'certain' degree as the BoA had said) due to the common element 'CREM' and because both marks would be associated with a creamy drink based on espresso coffee (paras 68-74 and particularly 72, 73). The common word 'CREM' could not be considered dominant in a word mark. The protection offered by the registration of a word mark applied to the word stated in the application for registration and not to the mark's graphic or stylistic characteristics. The applicant's claim that the protection of the earlier word mark held by it would also apply with respect to variations of stylisation similar to that of the contested mark (therefore CReMESSO or CReMESSO) was rejected (para. 56). ESPRESSO was descriptive for the goods in question, and the ending ESSO of the mark CREMESSO was very likely to be associated by consumers who did not speak Spanish, Italian or Portuguese with a creamy drink based on espresso coffee. Although the distinctiveness of an element of a composite mark had to be examined at the stage of assessing the similarity of the signs in order to determine any dominant element of the sign, the distinctiveness of the earlier mark had to be taken into account in the context of the global assessment of the LOC' (para. 74). The BoA had been right to hold that the visual similarity carried more weight than the aural one because the trade marks would generally be perceived visually before the relevant goods in Classes 7 and 11 were purchased (paras 83-84). A high level of attention did not permit allow



the automatic conclusion that there was no LOC since all the other factors had to be taken into account, for example identity and similarity of the goods, degree of similarity between the marks (para. 87). **NO LOC**

T-55/15; CERTIFIED AUSTRALIAN ANGUS BEEF / CERTIFIED ANGUS BEEF BRAND SINCE 1978; *Certified Angus Beef LLC v EUIPO*; Judgment of 14 July 2017; EU:T:2017:499; Language of the case: EN.

| EUTM application | Earlier trade marks |
|---|--|
|  |  CERTIFIED ANGUS BEEF BRAND |

The contested EUTM application was the figurative mark **CERTIFIED ANGUS BEEF AUSTRALIAN** represented above, which was filed for goods and services related to meat derived from Angus Beef (Classes 29, 30 and 43). The opposition was based, inter alia, on the word mark **CERTIFIED ANGUS BEEF BRAND** and the figurative mark represented above. Both marks were claimed to be well known within the meaning of Article 8(2)(c) EUTMR in all Member States of the EU for the goods and services covered by the mark applied for and for *certification services, licensing services and quality control services in the field of meat and beef products*. The opposition was based, inter alia, on Article 8(1)(b) EUTMR. The OD rejected the opposition. The BoA upheld the OD's decision. It found that the signs at issue could not be regarded as similar, thus ruling out the application of Article 8(1)(b) EUTMR and the other grounds of opposition. The coinciding elements (the word elements, the image of a bovine animal and the frame) were considered non-distinctive and therefore incapable of leading to a LOC regardless of the degree of similarity between the conflicting goods and services and the distinctiveness of the earlier mark. The opponent's action before the GC was based solely on infringement of Article 8(1)(b) EUTMR. The GC confirmed that the distinctive character of an earlier mark and the distinctive character of its elements were to be differentiated. Where a mark had distinctive character, the latter had to be ascribed to the mark as a whole and not automatically to all the elements of which it is composed. Consequently, the applicant's argument that the word element 'certified angus beef' had acquired distinctive character because the earlier marks were, in its view, well known could not succeed (para. 22). Since the BoA had found that the marks at issue were dissimilar overall, any LOC had to be ruled out. The possible distinctiveness of the earlier marks, acquired through use, could not offset the lack of similarity between the marks at issue (para. 24). The fact that a mark was well known or had a reputation had no bearing on the assessment of LOC where the signs at issue were different overall (para. 25). The BoA therefore could not be criticised for not having examined any distinctive character that the earlier marks might have acquired through use before, or at the same time as, it assessed the similarity between the signs at issue (para. 26). Since the BoA had not found the elements common to the marks at issue to be distinctive even to a low degree, and the applicant had not validly called that conclusion into question, the applicant's arguments that the BoA should have examined whether the other elements of the marks at issue were of a lower degree of distinctiveness and whether the overall impression created by those marks



was highly similar were irrelevant (para. 27). The BoA therefore could not be criticised for not having taken into account the OD’s findings relating to the well-known character of the earlier figurative mark (para. 29). Since the applicant did not dispute the BoA’s findings relating to the dissimilarity of the marks at issue other than by claiming that the earlier marks, as well as the element ‘certified angus beef’, had acquired distinctive character through being well known, its arguments relating to the comparison of the signs, to the possibly identical nature of the goods and to the existence of a LOC were also irrelevant (para. 30). Since there was no similarity between the marks at issue, it was not necessary to analyse whether the goods were similar and whether there was a LOC (para. 31). **NO LOC**

♦[C-182/16 P](#); **STICK MINIMINI FRATELLI BERETTA 1812 GLI ORIGINALI / MINI WINI**; *Meica Ammerländische Fleischwarenfabrik Fritz Meinen GmbH & Co. KG v EUIPO*; Judgment of 26 July 2017; EU:C:2017:600; Language of the case: EN.


| EUTM application | Earlier trade mark |
|--|--------------------|
|  | <p>Mini Wini</p> |

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 29 and 43. An opposition based on the earlier EU word mark represented above, registered, inter alia, for goods in Class 29, was filed pursuant to Article 8(1)(b) EUTMR. The OD partially upheld the opposition. The BoA annulled the OD decision in its entirety. The applicant then filed an action before the GC, relying on two pleas in law: (i) infringement of Article 8(3) of Regulation (EC) No 216/96, and (ii) infringement of Article 8(1)(b) EUTMR. The GC upheld the first plea and dismissed the second. The owner of the earlier right filed an appeal before the CJEU, alleging (i) infringement of Article 8(1)(b) EUTMR and (ii) infringement of the obligation to state reasons. **LOC**: the CJ stated that, contrary to what was argued by the owner of the earlier right, the combined occurrence of certain factors (average distinctiveness of the earlier trade mark, average level of attention of the relevant public, identical goods and low degree of similarity between the signs) — which were ‘present to a certain level and degree’ — in no way entailed a presumption that there was a LOC. The GC had not erred in law when, following a global assessment, it had confirmed the BoA’s finding of no LOC (paras 23-25). Furthermore, by its arguments concerning the visual aspects of the mark and the weak distinctive character of the elements ‘mini’ and ‘MiniMINI’, the owner of the earlier right was, without showing any distortion of the facts, seeking to have the CJ assess those facts; its arguments must consequently be rejected as inadmissible (paras 34 and 35). **NO LOC**

[T-768/15](#); **RP ROYAL PALLADIUM / RP**; *RP Technik GmbH Profilsysteme v EUIPO*; Judgment of 19 September 2017; EU:T:2017:630; Language of the case: EN.

| EUTM application | Earlier trade mark |
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|---|-----------|
|  | <p>RP</p> |
|---|-----------|



An EUTM application was filed for the mark **RP ROYAL PALLADIUM** (fig.) for goods and services in Classes 19 and 40. The opponent filed a notice of opposition based on the earlier EU word mark **RP**, registered for goods and services in Classes 6, 19, 37, 40 and 42, pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition. The opponent filed an appeal against the OD's decision. The BoA dismissed the opponent's appeal. It found that there was no LOC between the marks. The opponent filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the action (in its entirety), considering the plea unfounded. The GC upheld the BoA's findings that: (i) the relevant public (professionals in the building sector and DIY enthusiasts) paid a high degree of attention at the time of purchase, because of the specialised nature of the goods and services in question and because of the responsibilities of the professionals (paras 27-28); (ii) there was at most, a low degree of visual similarity as, although the word element 'rp' might be dominant, neither the expression 'royal palladium' nor the golden square pattern in the EUTM application would go unnoticed by the relevant public and both would constitute factors differentiating between the marks (para. 65); (iii) the marks had only slight similarity aurally insofar as the EUTM application would be referred to using all the word elements of which it was composed, including the not negligible expression 'royal palladium' EUTM application (paras 76-77); (iv) conceptually, the marks were dissimilar, as the EUTM application had a meaning for the entire relevant public (even though the BoA had only assessed English speakers), whereas the earlier trade mark, comprising only the letters 'rp', had no meaning (paras 88-89). **No LOC**: relying on the premise of identity between the goods and services, and given the high level of attentiveness of the consumers, the low degree of visual and aural similarity and the lack of conceptual similarity, there was no LOC (paras 90 and the following). **NO LOC**

♦[T-315/16](#); **Butterfly / Butterfly**; *Tamasu Butterfly Europa GmbH v EUIPO*; Judgment of 19 September 2017; EU:T:2017:629; Language of the case: DE. The intervener sought to register the word mark **Butterfly** as an EUTM for goods and services in Classes 28 and 41. An opposition based on the earlier EUTM (word mark) **Butterfly**, registered for goods and services in Classes 25 and 28, was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The opposition was also based, pursuant to Article 8(4) EUTMR, on the trade name **Butterfly**. The OD dismissed the opposition and the applicant lodged an appeal. The BoA dismissed the appeal insofar as (i) the goods and services were neither similar nor identical; (ii) the applicant had not proven the reputation of its earlier mark; and (iii) the applicant had not proven that the trade name had been used in the course of trade of more than mere local significance. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 8(1)(b) EUTMR, (ii) infringement of Article 8(5) EUTMR, and (iii) infringement of Article 8(4) EUMTR. **LOC**: in the light of the applicant's response to a question from the GC, it was established that only the goods of Class 28 were to be taken into account (para. 16). The GC emphasised that the fact that some of the goods belonged to the same class did not automatically mean that they were similar (para. 30). The fact that a *metal or plastic housing* (covered by the contested mark) could be included in *sport*



equipment (covered by the earlier mark) did not make these two goods similar either (para. 31). Consequently, the GC ruled out a LOC between the marks (para. 42). **NO LOC**

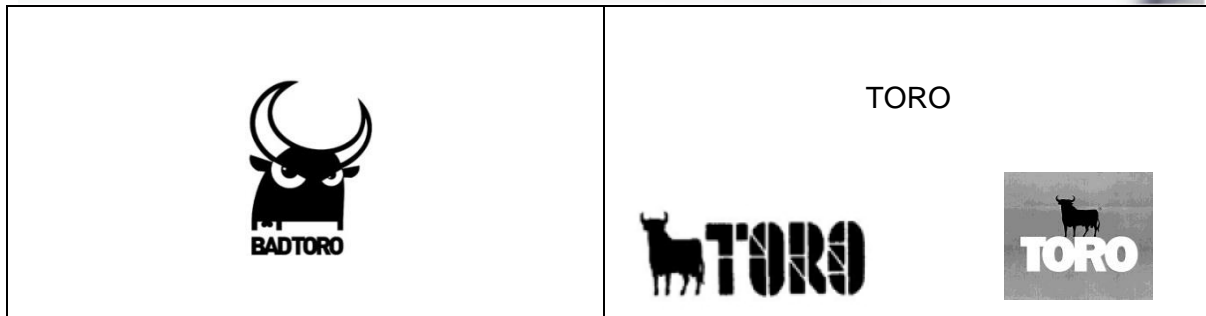
♦[T-350/13](#); **BADTORO / TORO et al.**; *Jordi Nogues SL v EUIPO*; Judgment of 20 September 2017; EU:T:2017:633; Language of the case: ES.

| EUTM application | Earlier marks |
|---|--|
|  | <p data-bbox="1038 607 1126 636">TORO</p>  |

The applicant sought to register the figurative mark **BADTORO**, represented above, as an EUTM for goods and services in Classes 25 and 34. An opposition was filed pursuant to Article 8(1)(b) EUTMR on the basis of, inter alia, the Spanish figurative marks **TORO**, represented above, registered for goods in Class 34, and the EUTMs (word marks) **TORO**, registered for goods in Classes 25 and 35. The OD found a LOC and allowed the opposition. The BoA dismissed the applicant's appeal, finding that there had not been peaceful coexistence between the marks under conflict and that there was a LOC for the relevant public. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC emphasised that, contrary to what the BoA had held, the figurative element of the contested mark was original and capable of diverting the public's attention from the word component (para. 30). The latter was of secondary importance within the overall impression created by the sign (para. 37). The fact that both the earlier and the contested marks included the term 'TORO' was scarcely relevant for assessing the degree of visual similarity between them, which was to be considered low (para. 48). On the other hand, the GC endorsed the BoA's assessment that the signs were aurally similar to a normal degree (para. 52). Conceptually, the GC found that the contested mark's figurative and word elements, considered jointly, conveyed a message that departed from the classical concept of the bull (TORO) as an animal. For that reason, the signs were conceptually similar to an average degree, and not a high degree as the BoA had concluded (para. 61). In general, the BoA had been wrong to consider the signs overall similar (para. 63), as they were overall only slightly similar (para. 62). Under these circumstances, despite the high degree of similarity between the goods and services at issue, the relevant public would not get confused as to their commercial origin (para. 69). The GC allowed the appeal and annulled the contested decision (para. 70). **NO LOC**

♦[T-386/15](#); **BADTORO / TORO et al.**; *Jordi Nogues SL v EUIPO*; Judgment of 20 September 2017; EU:T:2017:632; Language of the case: ES.

| EUTM application | Earlier trade marks |
|------------------|---------------------|
|------------------|---------------------|



The applicant sought to register the figurative mark **BADTORO**, represented above, as an EUTM for goods and services in Classes 30, 32 and 35. An opposition was filed pursuant to Article 8(1)(b) EUTMR on the basis of the earlier figurative EUTM **TORO** (Classes 33 and 42), the earlier EUTMs (word marks) **TORO** (Classes 32, 33, 35 and 42) and the figurative Spanish mark **TORO** (Class 35). The OD partly upheld the opposition, on the grounds of a LOC between the contested mark and the earlier figurative EUTM, No 1 500 917, registered for goods and services in Class 32, 33 and 42, and the earlier EUTM (word mark) No 1 722 362, registered for services in Class 35. It rejected the opposition and allowed registration of the contested mark for the *import and export services* designated in Class 35. The BoA dismissed the applicant's appeal. The applicant had brought a counterclaim before the EUTM court of Alicante to request the cancellation of some of the marks of the other party before the BoA and had requested that the BoA stay the proceedings pending the decision of the EUTM court. The BoA rejected that claim on the grounds that the EUTM court had already dismissed the counterclaim for cancellation. It also confirmed the OD's finding of a LOC. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Rule 20(7)(c) of Implementing Regulation (EC) No 2868/95 (unlawfulness of the BoA decision to deny the stay of proceedings) and (ii) infringement of Article 8(1)(b) EUTMR. As regards the second plea, the GC emphasised that, contrary to what the BoA had found, the term 'TORO' was of secondary importance in the EUTM applied for (para. 59) and did not occupy an autonomous and distinctive position within it (para. 62). By contrast, the term 'TORO' was the dominant element of the earlier marks. In view of that, the GC considered that there was very little visual similarity between the signs (para. 70). As the animal of the contested mark resembled more a pet or a cartoon than a real bull, the GC stated that this mark conveyed a concept far removed from the classic idea of a bull (para. 81). Therefore, the marks in conflict were conceptually similar only to an average degree (para. 83). Considering the differences between the marks, arising from the fanciful representation of the bull and the presence of the term 'BAD' in the contested mark, the GC ruled out a LOC for the relevant public (para. 91). The GC upheld the action and annulled the contested decision in its entirety (para. 93). **NO LOC**

[T-214/15](#); **ZYMARA / FEMARA**; *Novartis AG v EUIPO*; Judgment of 21 September 2017; EU:T:2017:637. Language of the case: EN. The applicant sought to register the word mark **ZYMARA** for goods in Classes 3 and 5. An opposition based on the earlier word mark **FEMARA**, registered for goods in Class 5, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition. The BoA dismissed the opponent's appeal. It found that the OD had correctly defined the subcategory for which genuine use was shown as *pharmaceutical preparations for the treatment of breast cancer*. It noted that, even if genuine use had been proven for *pharmaceutical preparations for the treatment of cancer*, as argued by the opponent, the result of the comparison of the goods would not have been any different. According to the BoA, the level of attention of the relevant consumer was 'high' and 'heightened'. There was a very low degree of visual and a low degree of aural similarity



between the marks. The BoA had found that the English-speaking part of the relevant public would pronounce the 'y' in ZYMARA like an 'i' and the 'e' in FEMARA like the 'e' in the English word 'lemon'. The opponent filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. It was irrelevant whether the earlier mark was deemed to have been registered for pharmaceutical preparations for the *treatment of breast cancer* or the *treatment of cancer* (para. 25). The BoA had used 'high' and 'heightened' as synonyms for a level of attention that was above average (paras 35 and 36). The high level of attention of non-professional users of medicines was associated with the health implications of the medicines (para. 42). As regards *dietetic substances adapted for medical use* and *sanitary preparations for medical purposes*, the level of attention of the public was high in the same way as for pharmaceuticals (paras 45 and 46). The BoA had erred in classifying the degree of similarity between *sanitary preparations for medical purposes* and *pharmaceutical preparations for the treatment of breast cancer* as low. It was instead 'relatively high' (para. 61). *Dietetic preparations adapted for medical use*, and *pharmaceutical preparations for the treatment of breast cancer* were similar to at least an average, not a low degree (para. 70). Since the second and third syllables of the marks at issue were the same, visual similarity could not be considered, as it had been by the BoA, to be 'very low'; instead it was 'low' (Para. 80). The pronunciation of a word in an EU language is a question of well-known facts (para. 100) and the BoA is not bound by the arguments of the parties on well-known facts (para. 103). The BoA had been right to find that the first vowel of the earlier mark **FEMARA** would be pronounced like the letter 'e' in the English word 'lemon' (para. 134). As the level of attention of the relevant public was high and the degree of visual and aural similarity is low, it had to be concluded that there was no LOC between the marks at issue, even for identical goods (para. 158). **NO LOC**

◆ [T-238/15](#); **ZIMARA / FEMARA**; *Novartis AG v EUIPO*; Judgment of 21 September 2017; EU:T:2017:636. Language of the case: EN. The applicant sought to register the word mark **ZIMARA** for goods in Classes 3 and 5. An opposition based on the earlier word mark **FEMARA**, registered for goods in Class 5, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition. The BoA dismissed the opponent's appeal. It found that the OD had correctly defined the subcategory for which genuine use was shown as *pharmaceutical preparations for the treatment of breast cancer*. It noted that, even if genuine use had been proven for *pharmaceutical preparations for the treatment of cancer*, as argued by the opponent, this would not have changed the result of the comparison of the goods. According to the BoA, the level of attention of the relevant consumer was 'high' and 'heightened'. There was a very low degree of visual and a low degree of aural similarity between the marks. The BoA had found that the English-speaking part of the relevant public would pronounce the 'e' in FEMARA like the 'e' in the English word 'lemon'. The opponent filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. **On the obligation of the Board of Appeal to decide on the appeal (Article 71(1) EUTMR)**: the GC rejected the argument that the BoA's failure to compare the contested *veterinary preparations* could have no bearing on the outcome since the BoA had found no LOC even for identical goods. The BoA had not mentioned *veterinary preparations* and had not adjudicated on the relevant public's level of attention with regard to them. The Court could not assess anything on which the BoA had not adopted a position (para. 34). The contested decision had to be annulled insofar as the BoA had failed to adjudicate on *veterinary preparations* (para. 36). **On LOC**: it was irrelevant whether the earlier mark was deemed to have been registered for pharmaceutical preparations for the *treatment of breast cancer* or the *treatment of cancer* (para. 85). The BoA had used 'high' and 'heightened' as synonyms for a level of attention that was above average (paras 58 and 59). The high level of attention of non-professional users of medicines was associated with the health implications of the medicines (para. 66). As regards *sanitary preparations for medical use*,




the level of attention of the public was high in the same way as for pharmaceuticals (para. 69). The BoA had erred in classifying the degree of similarity between *sanitary preparations for medical purposes* and *pharmaceutical preparations for the treatment of breast cancer* as low. It was instead ‘relatively high’ (para. 84). Since the second and third syllables of the marks at issue were the same, visual similarity could not be considered, as it had been by the BoA, to be ‘very low’; instead it was ‘low’ (para. 94). The pronunciation of a word in an EU language is a question of well-known facts (para. 114) and the BoA is not bound by parties’ arguments on well-known facts (para. 117). The BoA had been right to find that the first vowel of the earlier mark **FEMARA** would be pronounced like the letter ‘e’ in the English word ‘lemon’ (para. 147). As the level of attention of the relevant public is high and the degree of visual and aural similarity is low, it had to be concluded that there was no LOC between the marks at issue, even for identical goods (para. 158). **NO LOC**

[T-184/16](#); **SKY ENERGY / NRJ**; *NRJ Group v EUIPO*; Judgment of 6 October 2017; EU:T:2017:703; Language of the case: EN. The applicant sought to register the word mark **SKY ENERGY** as an EUTM for goods and services in Classes 9, 35, 38, 41 and 45. An opposition based on the earlier word mark **NRJ** was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition finding that there was no LOC. The BoA partly upheld the opponent’s appeal, finding a LOC for certain goods and services in Classes 9, 38 and 41. The BoA found the marks to be visually dissimilar but aurally and conceptually similar. It found a LOC where several cumulative factors applied: (i) where the contested goods and services were identical or similar to the opponent’s *radio broadcasting* and *radio entertainment* (services for which the BoA found the earlier mark enjoyed enhanced distinctiveness through use); (ii) where the contested goods and services were aimed at the general public (for whom the level of attention was not high); and (iii) where the relevant consumer bought or accessed the goods and services in circumstances where the mark would not be visible. The opponent filed an action before the GC, relying on a single plea: infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. The intervener’s request that the GC reinstate the OD’s decision was a ‘cross-claim’ because it sought to annul the contested decision on a matter that had not been raised in the application. This cross-claim had been submitted as part of the intervener’s response and not in a separate document; this did not satisfy the requirements of Article 182(1) and (2) of the Rules of Procedure of the General Court and therefore had to be rejected as manifestly inadmissible (paras 31-32). The advisory services in Class 45 were of a completely different from broadcasting services (para. 43). The BoA had made clerical errors regarding the goods and services on which the opposition was based, but there was no failure to adjudicate as the error was the mere addition of the words ‘services for the’ to the services compared and it was found that the BoA had implicitly intended to apply the same reasoning (paras 45-47). The marks at issue were aurally similar overall as the pronunciations of ‘nrj’ and ‘energy’ by the French-speaking public were very similar (para. 55). The marks were conceptually similar inasmuch as they both referred to the term ‘energy’, in particular for the public that had already heard the earlier mark being pronounced (para. 56). The BoA had been right in finding that the earlier mark had enhanced distinctiveness only for the services of *radio broadcasting* and *radio entertainment* (para. 79). The BoA had also been right in finding that there was a LOC **only** with regard to the goods and services that were: (i) identical or similar to the opponent’s *radio broadcasting* and *radio entertainment*, for which the earlier mark enjoyed enhanced distinctiveness; (ii) aimed at the general public; and (iii) purchased or accessed in circumstances where the mark would not be visible (paras 81-98). **NO LOC**

♦ [T-685/15](#); **SULAYR** *Sulayr Global Service v EUIPO*; Judgment of 26 October 2017; EU:T:2017:761; Language of the case: ES.



| EUTM application | Earlier trade mark |
|---|---|
|  | <p style="text-align: center;">SULAYR</p> |

The applicant sought to register the figurative mark reproduced above as an EUTM for *transport of plastic materials* in Class 39 and *recycling, treatment and transformation of plastic materials; and selection of recyclable material (transformation)* in Class 40. An opposition was filed pursuant to Article 8(1)(b) EUTMR on the basis of the earlier Spanish word mark **SULAYR** (*industrial analysis services and legal services* in Class 42). The OD dismissed the opposition. The BoA upheld the opponent’s appeal. It found that there was an average degree of similarity between the services applied for in Class 40 and the earlier mark’s *industrial analysis services* in Class 42, since they were related to the conservation of the environment and were complementary. As the signs were found to be highly similar, the BoA stated that there was a LOC. The applicant filed an action before the GC, alleging infringement of Article 8(1)(b) EUTMR. The GC upheld the appeal. **Dissimilarity of the services**: although the BoA had based its finding of similarity between the services on the fact that they were both related to the conservation of the environment in an industrial context, the GC disagreed and stated that the scope of the conflicting services was not one of the relevant factors expressly laid down by the case-law. The nature and purpose of the services differed insofar as those in Class 42 consisted essentially of a consultancy activity, while those in Class 40 were related to the treatment of certain materials, with the objective of managing waste. A possible link with environmental protection was not sufficient to characterise significantly the relationship between the conflicting services and thus to conclude that they were similar (para. 30). Regarding the complementarity of the services, the GC held that, although the conflicting services targeted the same public, the BoA had not based its assessment on the fact that *industrial analysis services* were essential or important for the use of the services applied for in Class 40 (para. 36). The fact that the services were naturally and frequently used together was not sufficient to establish that they were complementary (para. 40). The GC stressed that, in order to assess the similarity of the services, only those protected by the conflicting marks were to be taken into account, and not those that were actually offered. Therefore, a copy of the company’s objects indicating the services actually offered was not relevant for assessing the complementarity of the conflicting services (para. 43). As it had not been established that the services at issue were either complementary or perceived by the relevant public as having the same commercial origin, the GC found the services dissimilar (paras 44-48). **NO LOC**

♦ [T-628/15](#); **BiancalunaA / bianca. et al.**; *Frame Srl v EUIPO*; Judgment of 7 November 2017; EU:T:2017:781; Language of the case: EN



| EUTM application | Earlier trade mark |
|------------------|--------------------|
| | |



The applicant applied to register the figurative mark represented above as an EUTM for goods in Classes 3, 24 and 25. An opposition based on, inter alia, the earlier German figurative mark represented above (covering *clothing* in Class 25) was filed pursuant to Article 8(1)(b) EUTMR. The OD partially upheld the opposition for goods in Class 25. The applicant filed an appeal against the OD’s decision regarding the refusal to register goods in Class 25, which was dismissed by the BoA. The applicant filed an action before the GC against the above decision (and against decision of 07/08/2015, R 2952/2014-5, BIANCALUNA / bianca. (fig.) et al., regarding the BoA’s refusal to register the word mark **BIANCALUNA** for goods in Classes 24 and 25). The action relied on a single plea in law: infringement of Article 8(1)(b) EUTMR. The relevant public was the general public in Germany, reasonably well informed, reasonably observant and circumspect, with an average degree of attention (para. 39). **Scope of proceedings:** in principle, a restriction of the list of goods and services of a trade mark application carried out after the BoA had adopted a decision that was challenged before the GC could not affect the legality of that decision, except if the alteration might possibly have an effect on the examination of the trade mark carried out by the adjudicating bodies of the Office during the administrative proceedings (paras 25 and 28). The applicant had validly restricted the list of goods and withdrawn its action before the GC in part (para. 31). It was sufficient that the BoA examine the LOC between the mark for which registration was sought and the earlier German trade mark only, since the Office was under no obligation to give priority to EUTMs if the opposition was founded on a number of earlier national marks and EUTMs (para. 84). **Comparison of the signs:** the marks were not visually similar overall, since there were significant stylistic differences between the earlier German trade mark and the mark for which registration was sought. The mark applied for was ornamented with a white half-moon in an orange square and had two stylised capital letters. The double evocation of the moon (figurative and word) diminished the importance of the common element ‘bianca’ (paras 56 and 77). Aurally, the marks were dissimilar since, even if their common word element ‘bianca’ was pronounced first, the figurative evocation of the moon at the beginning of the mark applied for could be verbalised by association with the second word element ‘luna’ and therefore could have an effect on the pronunciation of the mark **Biancaluna** (paras 63 and 65). The marks were conceptually dissimilar: for the German public, the word ‘luna’ was a synonym for ‘Mond’ (moon); it also had magical and mythological connotations and was associated with concepts of coolness and movement. The immediately recognisable representation of a white moon at the beginning ruled out any conceptual confusion with the earlier German trade mark, despite the common word element ‘bianca’ (which was dominant in the earlier mark) and even if the German consumer did not understand the meaning of the Italian word ‘bianca’ (‘white’) (paras 48-49). **LOC:** on an overall impression, the signs are not visually and conceptually similar and they are also capable of being distinguished from one another aurally. Therefore there was no LOC, in particular for textile goods, for which the visual comparison had to be accorded the greatest weight (para. 80). Given the above findings, there was no need to compare the goods covered by the two marks (para. 83). **NO LOC**

♦[T-754/16](#); CC / O; *Oakley, Inc. v EUIPO*; Judgment of 8 November 2017; EU:T:2017:786; Language of the case: ES.




| EUTM application | Earlier trade mark |
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The applicant sought to register the figurative mark represented above as an EUTM for goods in Classes 9, 18 and 25. An opposition based on the earlier figurative mark represented above, registered for goods in the same classes, was filed pursuant to Article 8(1)(b) and, for goods in Class 9, pursuant to Article 8(5) EUTMR. The OD dismissed the opposition and the opponent appealed the decision. The BoA dismissed the opponent's appeal. It found that the signs were dissimilar, insofar as they had no visual or conceptual similarity, while an aural comparison was not relevant. There was therefore no need to examine enhanced distinctiveness. It also found that there was not sufficient evidence to determine the reputation of the earlier sign and that the public would not make a link between the signs. The opponent filed an action before the GC, relying on two pleas in law: (i) infringement of Article 8(1)(b) EUTMR and (ii) infringement of Article 8(5) EUTMR. The GC confirmed the non-contested finding that the relevant public was the general consumer within the EU, with an average level of attention (para. 24), and that the relevant goods were in part identical and in part similar or slightly similar (paras 24-28) **Similarity of signs:** the GC pointed out that a conceptual comparison between two purely figurative marks could be relevant (paras 47-48) and that the comparison of the signs could not take into account circumstances that depended on the owner's intention, such as the trade mark's possible size (para. 53). Thus, the signs were visually similar, since each of them was perceived as a rectangular figure with rounded edges and an overall elliptical aspect, in which the lateral edges were shorter than the longitudinal edges; the public would not perceive the gap in the longitudinal edges of the earlier mark as a clear break and, therefore, would not attribute any importance to that difference (para. 55). An aural comparison was not relevant for figurative marks without any word elements (para. 61). The signs were conceptually neutral, as no clear and precise meaning could be attributed to them (para. 65). **LOC:** considering the degree of similarity between the signs and between the goods, the degree of distinctiveness of the earlier mark could be relevant in this case (paras 74-76). The BoA had correctly found that the earlier mark had inherently weak distinctive character (para. 78) but had erred in not assessing the evidence of claimed enhanced distinctiveness submitted (para. 79). **NO LOC**

[T-776/16](#); **iCell. / Isocell**; *Isocell GmbH v EUIPO*; Judgment of 8 November 2017; EU:T:2017:788; Language of the case: DE.


| EUTM application | Earlier trade mark |
|------------------|--------------------|
|------------------|--------------------|



| | |
|---|----------------|
|  | <p>Isocell</p> |
|---|----------------|

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 17 and 37. An opposition based, inter alia, on the earlier word mark **Isocell**, registered for goods and services in Classes 7, 16, 17, 19, 37, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition for all goods and services. The BoA upheld the applicant's appeal. It found that there was no LOC. The opponent filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. The BoA had been right in determining that the relevant public was composed of both average consumers and professionals (para. 21) and that some of the goods and services were identical while others were similar (paras 22-23). **Comparison of signs:** it was not contested that the word element 'cell' had only slight distinctive character due to the frequency of its use in the European insulation market (para. 28). Visually and aurally, the signs were dissimilar. Conceptually, the signs could refer to two different, but at the same vaguely similar, concepts. Therefore, the signs did have some similarities, mainly because they both referred to the qualities of the goods, but also had significant differences (paras 32-43). Given the weak inherent distinctiveness of the word elements and the fact that the figurative elements of the EUTM application clearly distinguished it from the earlier marks, the BoA had not erred in considering that the figurative element was dominant in the EUTM application. In this context, and taking into consideration the high level of attention of the relevant public, there was no LOC (para. 45). **NO LOC**

[T-777/16](#); **iCell Insulation Technology Made in Sweden (fig.) / Isocell et al.**; *icell Insulation Technology M Isocell GmbH v EUIPO*; Judgment of 8 November 2017; EU:T:2017:788; Language of the case: DE

| EUTM application | Earlier trade mark |
|---|--------------------|
|  | <p>Isocell</p> |

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 17 and 37. An opposition based, inter alia, on the earlier word mark **Isocell**, registered for goods and services in Classes 7, 16, 17, 19, 37, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition for all goods and services. The BoA upheld the applicant's appeal. It found that there was no LOC. The opponent filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. The BoA had been right in determining that the




relevant public was composed of both average consumers and professionals (para. 21) and that some of the goods and services were identical while others were similar (paras 22-23). **Comparison of signs:** it was not contested that the word element 'cell' had only slight distinctive character due to the frequency of its use in the European insulation market (para. 28). Visually and aurally, the signs were dissimilar. Conceptually, the signs could refer to two different, but at the same time vaguely similar, concepts. Therefore, the signs did have some similarities, mainly because they both referred to the qualities of the goods, but also had significant differences (paras 31-41). Given the weak inherent distinctiveness of the word elements and the fact that the figurative elements of the EUTM application clearly distinguished it from the earlier marks, the BoA had not erred in considering that the figurative element was dominant in the EUTM application. In this context, and taking into consideration the high level of attention of the relevant public, there was no LOC (para. 43). **NO LOC**

[T-909/16](#); **NRIM Life Sciences / RYM**; *Laboratorios Ern, SA v EUIPO*; Judgment of 28 November 2017; EU:T:2017:843; Language of the case: EN. An application was filed to register the word mark NRIM Life Sciences as an EUTM for goods in Class 5. An opposition based on the earlier Spanish word mark RYM, registered for goods in Class 5, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition. The BoA dismissed the opponent's subsequent appeal. It found that, despite the identity or similarity of the goods, there was no LOC for the relevant Spanish public, that is, the general public and health professionals with a high level of attention, given that the signs were conceptually neutral and had a low degree of visual and aural similarity. The opponent filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. **Relevant public:** the relevant territory was Spain and the relevant public was the general public and health professionals, each with a high level of attention (para. 21). **Comparison of the goods:** the goods covered were similar or identical (para. 21). **Comparison of the signs:** the words 'life' and 'sciences' were descriptive of the goods for a large part of the relevant public and were, therefore, only slightly distinctive. Both average consumers with a knowledge of English and health professionals would understand the terms 'life' and 'sciences' as referring to the notion of 'life sciences' and to the medical and pharmaceutical fields (as relating to human health). Although the word 'nrim' was the dominant element, the terms 'life' and 'sciences' could not be regarded as negligible in the overall impression of the composite mark. The composite mark had to be examined as a whole (paras 33-35). Visually, the signs were only slightly similar, insofar as they had only 2 of the 16 letters of the contested sign in common ('r' and 'm') and even these were in different positions. They also differed in their beginning letters, namely 'r' in the earlier sign and 'n' in the contested sign, as well as in the two additional words 'life' and 'sciences' of the contested sign (para. 37). Aurally, the signs were only slightly similar, insofar as the pronunciation of the two signs in full differed in the sounds of the initial letter 'n' and the two terms 'life' and 'sciences' of the contested sign (para. 39). Conceptually, the signs were neutral, since they had no meaning in Spanish and were, consequently, meaningless for the general public that did not understand English. The health professionals and general public that had a knowledge of English and would understand the meaning of the terms 'life' and 'sciences', would still not associate any meaning with the earlier sign and would therefore perceive the signs as conceptually dissimilar (para. 41). **LOC:** given the high degree of attention of the public and the very low degree of similarity between the signs, there was, despite the identity of the goods, no LOC (para. 46). **NO LOC**

[T-475/16](#); **F1 / fly.de**; *FTI Touristik GmbH v EUIPO*; Judgment of 30 November 2017; EU:T:2017:856; Language of the case: DE.




| EUTM application | Earlier trade mark |
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An application was filed for registration of the figurative mark represented above as an EUTM for goods and services in Classes 16, 39 and 43. The opponent filed an opposition based on the earlier figurative mark represented above, registered as an EUTM for goods and services in Classes 16, 39, 41 and 43. The OD upheld the opposition on the grounds of Article 8(1)(b) EUTMR. An appeal was filed against the OD’s decision. The BoA upheld the appeal insofar as it found that there was no LOC even for the identical services, given the merely descriptive character of the sign, and the aural, conceptual and visual differences. The opponent filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. **Relevant public:** the relevant public consisted of the average consumer, with an average level of attention, within the EU (paras 11 and 23). **Comparison of the goods and services:** the goods and services covered were partly identical and partly similar (paras 12 and 24). **Comparison of the signs:** the GC found the signs to be visually dissimilar insofar as the earlier trade mark was slightly slanted and consisted of the verbal element ‘fly.de’ in dark blue, linear, lower-case letters on a background consisting of a yellow price ticket, while the contested trade mark consisted of a black upper-case letter ‘F’, followed by a lower-case letter ‘i’. There was no visual similarity between the heart-shaped figurative element of the application and the letter ‘y’ of the earlier trade mark (paras 27 and 34). Furthermore, it was not customary to replace the letter ‘y’ with a heart symbol. The consumer would not spontaneously identify the letter ‘y’, in the shape of a stylised heart, in the contested trade mark (para. 34). The signs were aurally dissimilar: there was a great difference between the letter ‘y’ and the symbol of the trade mark. As already mentioned, it was not customary to replace the letter ‘y’ with a heart symbol, and, even if the heart symbol were to be identified as a ‘y’, the aural coincidence of the common verbal element ‘fly’ would be counteracted by the verbal element ‘.de’ of the earlier mark. In any case, the earlier trade mark would always be pronounced in several syllables, the exact number depending on the rules of pronunciation of the language concerned (para. 42). The signs were conceptually dissimilar. The consumers would not instantly recognise the letter ‘y’ in the heart symbol and, therefore, would not perceive the word ‘fly’ in the contested mark. They would perceive it as a combination of the letters ‘f’ and ‘i’, or a combination of the letter ‘f’ and the number ‘1’, with the latter potentially creating an association with motor racing. Even if the sign of the contested mark were to be perceived as ‘fly’, the conceptual coincidence would be counteracted by the verbal element ‘.de’ of the earlier mark, which would be perceived as a domain name and as a reference to a website (paras 49-50). **Distinctiveness of the earlier mark:** the earlier mark had an average degree of inherent distinctive character for the non-English-speaking relevant public, and a low degree for the English-speaking public. For the latter, the words ‘fly.de’ would be perceived as a reference to a German website that discussed subjects relating to flying (para. 52). In this sense, the GC noted that *transport* included transport by plane, while *travel arrangement* and *services for providing food and drink* encompassed the organisation of journeys by air and the provision of food and drink to air passengers; lastly, *temporary accommodation* could take account of the particular



requirements of air travellers, such as airport hotels (para. 55). **No LOC**: there was no LOC whatsoever for the non-English-speaking public since there was no visual, aural or conceptual similarity (para. 59). Only if the English-speaking public were to perceive the contested trade mark as ‘fly’ (which was unlikely) would there be aural and conceptual similarity. However, the shared element ‘fly’ would still be purely descriptive for those consumers, as it referred directly to goods and services relating to flying and the differences (particularly the visual differences) would still be sufficient to rule out a LOC even for identical goods and services (para. 61). **NO LOC**

[T-700/16](#); **Slim Dynamics / DYNAMIN**; *Laboratorios Ern, SA v EUIPO*; Judgment of 13 December 2017; EU:T:2017:896; Language of the case: EN

| EUTM application | Earlier trade mark |
|---|--------------------|
|  | <p>DYNAMIN</p> |

The applicant sought to register the figurative mark represented above as an EUTM for goods in, inter alia, Class 5. An opposition was filed on the basis of the earlier Spanish word mark **DYNAMIN**, which covered goods in Class 5 corresponding to the following description: *dietetic foods adapted for medical use in any shape or form*. The OD partly upheld the opposition insofar as it found that there was a LOC for *dietary supplements, dietetic preparations and medical and veterinary preparations and articles* in Class 5. The BoA partly dismissed the opponent’s appeal against the OD’s decision. It found that there was a LOC only for the goods covered by the contested mark that were identical to those covered by the earlier mark, namely the *dietetic preparations* in Class 5. It annulled in part the OD’s decision to the extent that the opposition had been upheld for *dietary supplements and medical and veterinary preparations and articles*. The opponent filed an action before the GC, relying on a single plea in law: infringement of Article 8(1)(b) EUTMR. **Relevant public**: the relevant public consisted of both Spanish professionals and average consumers, with an average to high level of attention (the latter, where goods directly affected users’ health) (paras 24-25). **Comparison of the goods**: the *dietetic foods adapted for medical use in any shape or form* covered by the earlier mark differed from *hygienic preparations and articles*, since the latter were for personal hygiene whereas the former were for medical diets. Moreover, the goods covered by the earlier mark were foodstuffs and were therefore to be ingested, whereas *hygienic preparations and articles* were generally applied to the body. They were similar to the *dietary supplements and medical and veterinary preparations and articles* (paras 35 and 37). **Comparison of the signs**: there was little visual similarity, as the contested mark ended in the (rounded) letters ‘c’ and ‘s’, whereas the earlier mark ended in the (linear) letter ‘n’. The term ‘slim’ made the word element of the contested mark longer visually. The figurative elements before and after the word elements of the contested mark also made a difference to the overall impression (para. 49). There was, at most, average aural similarity, since even if the term ‘dynamics’ was dominant within the contested mark, the contested mark contained four syllables whereas the earlier mark contained only three, the element ‘slim’ having no equivalent in the earlier mark. The final letters ‘c’ and ‘s’ of the contested mark produced a very different sound from that produced by the final letter ‘n’ of the earlier mark (para. 53). There was also little conceptual similarity insofar as, although both marks evoked the idea of dynamism, they differed in the term ‘slim’ of the contested mark, which constituted a fanciful term for the relevant non-English-speaking public. If the relevant public understood the term



‘slim’, that would only increase the conceptual differences between the signs (para. 65). **No likelihood of confusion:** there was no LOC for *hygiene preparations and articles* since they were different from the goods of the earlier mark (para. 78). Moreover, despite the similarity between *dietary supplements* and *medical and veterinary preparations and articles*, there was no LOC for them either, given the limited similarity of the signs, the normal distinctive character of the earlier mark and the average to high level of attention of the relevant public (paras 79 and 80). **NO LOC**

3. Other LOC-related cases



♦ [C-655/15 P](#); **Krispy Kreme DOUGHNUTS**; *Panrico, S.A. v EUIPO*; Judgment of 2 March 2017; EU:C:2017:155; Language of the case: ES. An application for invalidity was filed pursuant to Article 60(1)(a) in conjunction with Article 8(1)(b) and Article 8(5) EUTMR against this EUTM, which was registered for goods in Class 30 and services in Class 42. The application for invalidity was based on the Spanish word marks **DOGHNUTS** and **DONUT** (both registered for goods in Class 30), the Spanish figurative marks **DONUTS** and **DONUTS CREAM** (both registered for goods in Class 30) and the international word mark **DONUT** (which covers goods in Classes 30 and 31). The CD rejected the application for invalidity in its entirety. The BoA dismissed the invalidity applicant’s appeal. It found that the mark **DONUTS CREAM** had expired and that genuine use of the mark **DOGHNUTS** had not been proven. For the rest, the BoA ruled out a LOC and concluded that the contested mark would not take unfair advantage of the distinctive character or repute of the earlier word marks. The invalidity applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 60(1)(a) in conjunction with Article 8(1)(b) EUTMR, and (ii) infringement of Article 60(1)(a) in conjunction with Article 8(5) EUTMR. The GC dismissed the action. It found that there was only a remote aural similarity between the signs and concluded that there was no LOC even if the earlier marks had enhanced distinctiveness; such remote similarity was insufficient for consumers to establish a link between the signs, regardless of the high reputation of the earlier marks and the similarity or even identity between the goods and services involved. The invalidity applicant’s appeal before the CJ was dismissed. The CJ dismissed the second and third pleas as partially inadmissible, namely the parts that implied a request for a new factual assessment (paras 68-69 and 87-89), and partially unfounded. Regarding the second plea, the CJ clarified that, (i) contrary to the invalidity applicant’s allegation, the GC had taken into account the fact that the goods involved belonged to the same class, and (ii) that the GC’s statements were sufficient to comply with the duty to state reasons (paras 72-74). The CJ denied any contradiction on the part of the GC, since the fact that a restaurant service was defined not only by the kind of product that was offered but also by the conditions under which the service was rendered, did not imply that, when the goods offered in a specific kind of restaurant were identical to those covered by the earlier marks, there was necessarily at least an average degree of similarity between those goods and that restaurant service (para. 77). Regarding the third plea, the CJ pointed out that the GC’s reasoning supporting the BoA’s conclusion that the aural similarity of the marks was too remote to allow the public to establish a link between them had been included purely for the sake of completeness and, therefore, the invalidity applicant’s allegations in this respect were nugatory (paras 90-92).

♦ [T-23/16](#); **Formata**; *Ilona Biernacka-Hoba v EUIPO - Formata Bogusław Hoba*; Judgment of 8 March 2017; EU:T:2017:149; Language of the case: PL. The case concerned an invalidity action between ex-spouses who had previously run a family business together. The invalidity applicant (Ilona Biernacka-Hoba) filed a request for a declaration of invalidity



against the EUTM ‘FORMATA’ (fig.) registered by her former husband. She invoked an earlier IR with effect in Slovakia for an identical mark. She also relied on an earlier Polish registration (which had expired) and invoked bad faith. The BoA rejected the invalidity action. With regard to relative grounds for invalidity, the BoA found that the invalidity applicant had not proven her entitlement to rely on the earlier mark, as the renewal certificate filed showed that the owner was ‘Przedsiębiorstwo Produkcyjno Handlowo Usługowe Formatta II Ilona Biernacka-Hoba’ (which the BoA had considered to be a company), while the invalidity applicant was Ilona Biernacka-Hoba (a natural person). The invalidity applicant filed an action before the GC, claiming infringement of Article 59(1)(b) EUTMR. She argued, in particular, that, according to the Polish Civil Code, business activities run by a natural person (not having a corporate form) could use any indications (fanciful or describing the business) in addition to the name and surname of the person running the business. Therefore, it was clear from the indication of the name on the renewal certificate ‘Przedsiębiorstwo Produkcyjno Handlowo Usługowe Formatta II Ilona Biernacka-Hoba’ that the owner was not a company but Ilona Biernacka-Hoba running her business as a natural person. **Entitlement for invalidity based on relative grounds:** the GC did not expressly rule on the admissibility of new evidence in the form of specific provisions of the Polish Civil Code relating to how a sole trader can name his or her business. While admitting that the data on the renewal certificate could cast doubts on whether the invalidity applicant was in fact the owner of the earlier right, the indication on the renewal certificate contained the name of the invalidity applicant and did not refer to any corporate legal form. This should, at the very least, have alerted the BoA to the fact that the entity did not have a corporate form (paras 22-23). Furthermore, it was known for sole traders to run businesses under their names with the addition of other indications (para. 24). In any case, in case of any doubt regarding entitlement, the BoA should have requested the invalidity applicant, pursuant to Rule 39(3) of Implementing Regulation (EC) No 2868/95, to confirm that it was in fact the owner of the earlier right. Consequently, the contested decision was annulled insofar as it rejected the invalidity action on relative grounds for invalidity.

[T-25/16](#); **GelenkGold / Shape of a tiger**; *Haw Par Corp.Ltd v EUIPO*; Judgment of 4 May 2017; EU:T:2017:774; Language of the case: DE

| EUTM application | Earlier trade mark |
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The applicant sought to register the figurative mark represented above as an EUTM for goods within Class 5. An opposition was filed on the basis of, inter alia, the earlier figurative mark represented above, registered for goods in Class 5. The OD upheld the opposition. The BoA dismissed the applicant’s appeal. The applicant filed an action before the GC. The BoA decision was annulled by the GC in its judgment of 07/05/2015, [T-599/13](#), GELENKGOLD / FORM EINES TIGERS et al., EU:T:2015:262. The GC considered that the BoA had erred in finding that the mark in question could not be compared aurally since only one of the marks contained a verbal element. The GC found that the earlier mark could be compared aurally on the basis of its description as a ‘tiger’, whereas the EUTM application would be



pronounced as ‘Gelenkgold’; they were therefore aurally dissimilar. As the request for amendment of the decision in the sense that the opposition be refused required further assessment of the distinctive character of the earlier mark by the BoA, the GC remitted the case back. The judgment was not appealed. The BoA followed the judgment with regard to the assessment of the similarity of goods and signs and the relevant public. It examined acquired distinctiveness and denied it. As a result it ruled out a LOC. The opponent brought an action before the GC, claiming (i) an error in the aural comparison of the mark, (ii) infringement of Article 94 EUTMR and (iii) failure to take account of a series of marks claimed by the opponent. The aural comparison had been part of the subject matter of the judgment in Case T-599/13, which had become final; therefore, a new analysis of this was inadmissible (para. 29 et seq. with further case-law). Article 94 EUTMR did not require that parties automatically be given a new opportunity to be heard after a BoA decision had been annulled by a judgment of the GC and new proceedings before the BoA had been opened (para. 54 et seq.). At least in the case in question there were no new circumstances to justify the parties being given an opportunity to be heard again (para. 60). The BoA decision did not contain any passage specifically devoted to the issue of series marks on which the opponent could rely (para. 73). The statements made by the BoA in the context of examining enhanced distinctiveness, however, justified the finding that use of the series of the earlier mark on the market had not been proven (para. 93).

♦ [T-406/16](#); **JAPRAG / JAPAN-RAG**; *Dogg Label / EUIPO*; Judgment of 11 July 2017; EU:T:2017:482; Language of the case: FR.

| EUTM application | Earlier trade mark |
|------------------|--------------------|
| JAPRAG | <i>JAPAN - RAG</i> |

The OD had dismissed the opposition under Article 8(1)(b) EUTMR on account of lack of similarity between the signs, without assessing the EUTM applicant’s request for PoU. The BoA confirmed that there was no LOC, even for identical goods (assuming the earlier French registration had been used for all goods for which it was registered) because the signs were only remotely similar visually/aurally and the French public would not grasp the prefix ‘JAP’ as denoting ‘Japan’ or ‘Japanese’ (para. 32 of the BoA decision). According to the BoA, the signs were different conceptually and dissimilar overall. The GC observed that the goods in Class 25 and *leather, imitations of leather and animal skins and hides* in Class 18 were identical (para. 37), while the *leather, imitations of leather and animal skins and hides* of the earlier mark were dissimilar to the *luggage and carrying bags; umbrellas and parasols; walking sticks; whips, harness and saddlery* of the EUTM application, notwithstanding that they all belonged to the same class (Class 18). The fact that the former could be used as raw material for the production of the latter did not render them complementary. Raw materials subjected to a transformation process were essentially different from the finished products that incorporated them, both by their nature and by their aim and intended purpose (para. 42). The GC did not confirm the BoA’s finding that the signs were visually and aurally similar to a very low degree only: the degree of visual and aural similarity was in fact medium (paras 55 and 64). The GC also disagreed with the BoA’s finding that the signs were conceptually dissimilar because there was proof on file that the term ‘jap’ was commonly used as an abbreviation in France to denote Japan, inter alia on social media and in the catering sector (paras 73-74). The BoA had therefore erred in finding that there was no



conceptual similarity at all (para. 75). As the signs were similar to some degree, the BoA should have examined the request for PoU before carrying out a global examination of the LOC (para. 79). As the request for PoU still had to be examined, the GC lacked the competence to amend the decision (para. 82). This remained the case even though a French judgment had partially revoked the earlier mark as from 2007 for the goods in Class 18. It was for the Office to draw the appropriate conclusions from the French judgment (para. 88).

[C-93/16](#); **KERRYGOLD**; *Ornua Co-operative Ltd, formerly The Irish Dairy Board Co-operative Ltd (Ornua) v Tindale & Stanton Ltd España SL (T&S)*; Preliminary ruling of 20 July 2017; EU:C:2017:571; Language of the case: ES. Ornua, the owner of several **KERRYGOLD** EUTMs for butter and other dairy products, filed an infringement action before the Juzgado de lo Mercantil de Alicante (Alicante Commercial Court) against T&S's use of **KERRYMAID** on margarines in Spain. That court held that the only similarity between the signs was the element 'Kerry', which refers to an Irish county known for its cattle breeding. It was common ground that, in Ireland and the United Kingdom, the **KERRYGOLD** and the **KERRYMAID** marks coexisted peacefully. The court dismissed the infringement action, holding that there was no LOC between the marks since Ireland and the United Kingdom together had a significant demographic weight in the EU and, in view of the unitary character of the EUTM, the peaceful coexistence of the marks in those countries necessarily led to the conclusion that there was no LOC throughout the entire EU. Peaceful coexistence of the marks in Ireland and the United Kingdom meant that, in Spain, T&S could not take unfair advantage of the distinctive character or repute of the earlier marks. Ornua appealed to the Provincial Court of Alicante (Referring Court), which stayed the proceedings and referred the following questions [abridged below] to the CJ:

... [C]an [Article 9(1)(b) EUTMR] be interpreted as meaning that there is no likelihood of confusion where the earlier [EU] trade mark has, owing to the acquiescence of the proprietor, peacefully coexisted for some years with similar national marks in two Member States of the European Union, so that the absence of a likelihood of confusion in those two Member States is extended to other Member States, or to the European Union as a whole?

In the situation set out in the previous paragraph, can the geographical, demographic, economic or other circumstances of the States in which the coexistence has occurred be taken into consideration for the purpose of assessing the likelihood of confusion, so that the absence of a likelihood of confusion in those Member States can be extended to a third Member State or to the European Union as a whole?



... [M]ust [Article 9(1)(c) EUTMR] be interpreted as meaning that, where an earlier trade mark has coexisted with the contested sign for a certain number of years in two European Union Member States without the proprietor of the earlier trade mark opposing it, this acquiescence on the part of the proprietor towards the use of the later sign in these two States in particular can be extended to the remaining territory of the European Union for determining whether there is due cause for a third party's use of the later sign?

The CJ began its answer to **the first question** by affirming the unitary character of the EUTM and by highlighting that the exclusive right conferred by an EUTM under Article 9(1) EUTMR, extends, as a rule, to the entire area of the EU. It also pointed out, however, that when the use of a mark gives rise, in one part of the EU, to a LOC with an EUTM, while, in another part of the EU, that same use does not give rise to such a LOC, the EUTM court



must prevent use of the sign at issue throughout the entire territory of the EU **with the exception of** the part in respect of which there is no LOC (paras 25-33). Next, the CJ stressed that where peaceful coexistence between marks had been found in Ireland and the United Kingdom, the EUTM court in Spain could not base its assessment of infringement involving those marks merely on the situation in Ireland and the United Kingdom. Quite the reverse: that court had to make a global assessment of all the relevant factors. Therefore, the fact that marks coexisted peacefully in one part of the EU, did not allow the conclusion that elsewhere, where there was no peaceful coexistence, there was also no LOC (paras 34-38). In response to **the second question**, the CJ found that there was nothing to prevent an EUTM court, when assessing infringement in one part of the EU (e.g. Spain), from considering relevant factors that ruled out infringement in another part of the EU (e.g. Ireland and the United Kingdom). That court, however, had to ensure that there was no significant difference in market conditions and sociocultural circumstances. Indeed, the CJ noted that consumers' perception of the geographical term Kerry might differ in the relevant places and that this was important when considering whether the defendant was following honest business practices (paras 39-47). On **the third question**, interestingly, the Advocate General felt that a situation of coexistence had to be taken into consideration, not in the context of due cause, but for the global assessment of the existence of a link between the trade marks (para. 51 opinion of AG). The court ultimately ruled out that peaceful coexistence in one part of the EU automatically gave rise to due cause in another part, because an analysis of detriment to reputation of an EUTM has to be based on a global assessment that takes into account all the factors relevant to the case. Therefore, when examining due cause in Spain, the EUTM court could not merely base its assessment on peaceful coexistence in Ireland and the United Kingdom (paras 56-60).

♦[T-780/16](#); **Mediaexpert**; Mediaexpert sp. z o.o v EUIPO; Judgment of 20 July 2017; EU:T:2017:538; Language of the case: EN.



| EUTM | Earlier trade mark |
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The applicant filed a declaration of invalidity based on an earlier Polish trade mark, invoking Article 60(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR. In support of the declaration, it filed an extract from the Polish Patent Office database in Polish. In order to remedy relative admissibility deficiencies, it also filed the list of relevant goods and services in English. The application for a declaration of invalidity was rejected in its entirety as not substantiated. The BoA dismissed the appeal. The applicant filed an action before the GC, relying essentially on two pleas in law: (i) infringement of Rule 37(b) and Rules 38(1) and (2), 39(2) and (3) and 98(1) of Implementing Regulation (EC) No 2868/95, and (ii) breach of the principle of protection of legitimate expectations. By its first plea, the applicant claimed that the Office had knowledge of the scope of protection of the earlier Polish mark by means of both the information contained in the application for a declaration of invalidity and the translation of the list of goods and services; the Office had not asked it to submit a full translation of the database extract. By its second plea, the applicant complained that the Office had given it the impression that the application for a declaration of invalidity was complete. It also considered that the Office guidelines had not been correctly applied. The



GC dismissed the appeal. **Evidence of existence, validity and scope of protection of the earlier mark:** the GC stressed a fundamental distinction between the conditions governing admissibility and the conditions concerning the production of facts, evidence, arguments and documents in support of the application (para. 35). The list in English of the goods and services merely supplemented the application for a declaration of invalidity for admissibility purposes; the registration certificate for the earlier mark (the database extract) and a translation thereof constituted documents relating to the examination of the merits of the application. The CD was not obliged to ask the applicant to produce the complete translation of the database extract (para. 41). Contrary to what the applicant claimed, it could not be held that a translation of the database extract had been validly produced. A mere indication of the list of goods and services in English could not constitute a complete and structured translation of the database extract within the meaning of Rule 98(1) of Implementing Regulation (EC) No 2868/95 (para. 47); the applicant had failed explicitly to refer to the database extract and to reproduce its structure. The validity of the earlier mark could not be inferred merely from the dates of filing and registration, as the corresponding untranslated textual elements, namely, *‘Decyzja o rejestracji — nadanie numeru rejestracji’*, left open the question whether the earlier mark had been definitively registered. As the evidence submitted contained different indications regarding the nature of the earlier mark, it was essential that the textual elements *‘Rodzaj znaku towarowego’* and *‘Słowno-graficzny’* concerning the nature of the earlier mark were translated.

♦[T-86/16](#); **ANA DE ALTUN / ANNA et al.**; *Codorníu, S.A. v EUIPO*; Judgment of 18 September 2017; EU:T:2017:627; Language of the case: ES.



| EUTM application | Earlier trade mark |
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The applicant sought to register the figurative mark represented above as an EUTM for goods in Class 33. An opposition based on, inter alia, the earlier Spanish figurative mark represented above, registered for goods in Class 33, was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The OD upheld the opposition insofar as it considered that there would be a LOC. The BoA upheld the applicant’s appeal. It found that there would be no LOC between the contested mark and the Spanish earlier trade mark **ANNA**, even for identical goods. It did not assess the alleged enhanced distinctiveness of the earlier trade mark as it considered the signs dissimilar. The BoA did not assess Article 8(1)(b) EUTMR with regard to the other earlier rights **ANNA DE CODORNIU** as it considered that they were even less similar to the examined earlier right. Finally, it considered that there was no link between the signs within the meaning of Article 8(5) EUTMR. The opponent filed an action before the GC, relying on three pleas in law: (i) infringement of Articles 94 and 95 EUTMR, (ii) infringement of Article 8(1)(b) EUTMR, and (iii) infringement of Article 8(5) EUTMR. The GC upheld the appeal. It found that the BoA methodology for assessing the LOC had been based on the wrong premise that the signs were globally different. As a result, the BoA had incorrectly considered that the evidence of enhanced distinctiveness and reputation did not need to be examined. Finally, the GC considered that the decision lacked reasoning regarding the



absence of a LOC with regard to other earlier trade marks that the BoA had considered less similar to the earlier Spanish mark being assessed. **Similarity of the signs:** the GC agreed with the BoA that the signs were visually and aurally similar to a low degree. It also agreed that, conceptually, the contested EUTM application would be associated with a name and family name and to this extent, the surname ‘DE ALTUN’ did not play a secondary role; therefore, the signs were different in this respect too. However, it disagreed with the BoA that the conceptual differences would compensate for the visual and aural similarities, thus rendering the signs globally different. The concept in ‘ANA DE ALTUN’ was not sufficiently clear and precise to allow such compensation. The GC considered that the signs were similar to a certain extent (paras 49-62). **LOC:** the GC considered that the methodology applied by the BoA in the LOC assessment had been based on the wrong premise that the signs were sufficiently dissimilar and therefore there was no need to take into account the evidence of enhanced distinctiveness. Consequently, the second plea in law is upheld (paras 70-73).

♦[C-673/15 P](#) to [C-676/15 P](#) (joined cases); **Darjeeling / DARJEELING et al.**; *The Tea Board v EUIPO*; Judgment of 20 September 2017; EU:C:2017:702, Language of the case: EN

| EUTM applications | Earlier trade marks |
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The applicant sought to register the figurative marks represented above as EUTMs for goods and services in Classes 25, 35 and 38. An opposition based on the earlier EU collective marks represented above, registered for goods in Class 30, was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The OD dismissed the oppositions. The BoA dismissed the appeals and upheld the OD’s decisions. The applicant filed four actions before the GC, relying on two pleas in law: (i) infringement of Article 8(1)(b) EUTMR and (ii) infringement of Article 8(5) EUTMR. The GC rejected the first plea as unfounded and upheld the second plea in part. The owner of the earlier right/the opponent filed an appeal before the CJ, alleging infringement of Article 8(1)(b) and Article 8(5) EUTMR. The EUTM applicant filed a cross-appeal before the CJ, alleging, first, a distortion of the respective functions of trade marks and PGIs and, second, inconsistency in the GC’s reasoning and an error of law in the application of Article 8(5) EUTMR. **The main appeal:** regarding the first ground of appeal, the CJ stated that the GC had not erred in law when it held that the essential function of an EU collective mark was to distinguish the goods or services of the members of the association that was the proprietor of the trade mark from those of other undertakings, thereby guaranteeing their collective commercial origin (para. 57), and not to distinguish those goods according to their geographical origin (para. 63). With regard to the second ground of appeal, the appellant had failed to substantiate the complaint of distortion of the facts (para. 70). Furthermore, as regards the argument that the qualities conveyed by the word element ‘darjeeling’ were capable of being transferred to the whole body of services for which registration was sought, this actually aimed at obtaining an assessment of the facts from the CJ and consequently had to be rejected as inadmissible (para. 72). **The cross-appeal:** the CJ found that the GC had not adopted a position on whether proof of the



reputation of the earlier trade marks had been adduced, or on whether, for the purpose of establishing such proof, the reputation enjoyed by the name ‘Darjeeling’ as a geographical indication for tea could be transferred to the same sign protected as a collective trade mark for identical goods. Therefore, the first part of the single ground of appeal was based on a misreading of the judgments under appeal and was rejected as unfounded (paras 80-81). Additionally, the GC had not contradicted itself when it held, on the one hand, that the consumer of goods covered by the earlier trade marks would not be led to believe that the goods and services covered by the trade marks applied for originated from the Darjeeling region, while considering, on the other hand, that the consumer of the goods and services covered by the trade marks applied for by the intervener could be attracted by the values and positive qualities connected with that region (para. 93). Therefore, the second part of the single ground of appeal was rejected and the cross-appeal was dismissed in its entirety (para. 94). **LOC**


♦[C-437/16 P](#); **CHEMPIOIL / CHAMPION**; *Wolf Oil Corp. v EUIPO*; Judgment of 5 October 2017; EU:C:2017:737; Language of the case: EN

| IR designating the EU | Earlier rights |
|-----------------------|---|
| CHEMPIOIL |  |

The applicant had obtained the international registration designating the EU of the word mark represented above for goods in Classes 1, 3 and 4. An opposition was filed, based, inter alia, on the IR designating the EU and France of the figurative mark represented above for goods in Classes 1, 3 and 4. The OD partly upheld the opposition. The BoA upheld the appeal, annulling the OD’s decision insofar as it had upheld the opposition for some of the goods referred to and dismissed it for the others. The opponent’s action before the GC was dismissed. The opponent then filed an action before the CJ, relying on two pleas in law: (i) alleged distortion of evidence and failure to state reasons, and (ii) infringement of Article 8(1)(b) EUTMR. The CJ dismissed the appeal. Regarding the second plea in law, the CJ stated that the GC had ‘correctly distinguished the assessment of the conceptual differences in the analysis of the possible neutralisation of visual and aural similarities by conceptual differences’. In particular, the GC had found that the word ‘champion’ had a clear and specific meaning, whereas the term ‘chempioil’ had no clear meaning that could be immediately understood by the public (para. 46). Finally, without erring in law, it had held that ‘the visual and aural similarities of the signs at issue could be neutralised’ (para. 47). Additionally, the GC had not erred in law in considering that the BoA had correctly held that a consumer would make a distinction between the signs at issue, despite their visual and aural similarities (para. 55). To conclude, the CJ stated that the appellant had not based the ground of appeal that it had raised for the first time at the hearing before the GC on any element of law or of fact disclosed during the proceedings giving rise to the judgment under appeal and had itself recognised that the factual evidence on which it relied had formed part of the evidence before EUIPO. The GC had therefore been right to refrain from responding to that complaint, which was inadmissible (para. 62).



♦ [T-336/16](#); **VERSACE 19.69 ABBIGLIAMENTO SPORTIVO... / VERSACE et al.**; *Versace 19.69 Abbigliamento Sportivo Srl v EUIPO*; Judgment of 5 October 2017; EU:T:2017:691; Language of the case: IT.

| EUTM application | Earlier trade mark |
|---|--|
|  | <p style="text-align: center;">VERSACE</p> |

The applicant sought to register the figurative mark represented above as an EUTM for goods in Classes 9, 24 and 25. An opposition based, inter alia, on the earlier word mark **VERSACE**, registered for goods in Classes 9, 24 and 25, was filed pursuant to Article 8(1)(b) EUTMR. The OD partially upheld the opposition and allowed registration of the mark for goods in Class 9, apart from *optical apparatus, glasses, sunglasses and lenses*. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC, requesting that it annul the contested decision. Regarding the **similarity between the goods** in Class 9, the GC confirmed the general principle that the goods can be considered identical when those designated by the trade mark application are included in a more general category designated by the earlier trade mark, also bearing in mind their nature, final use and destination. Thus, it concluded that *optical apparatus, glasses, sunglasses and lenses* fell within the general category of *spectacles*. With respect to the **similarity between the signs**, the GC rejected the applicant's claim that the requested sign be compared with the earlier figurative trade mark. In this respect, the GC restated that, pursuant to Article 72 EUMTR, it could only carry out a review of the legality of the BoA's decision and did not have the power to substitute its own reasoning for that of the BoA (paras 84-88).

♦ [T-120/16](#); **BURLINGTON / BURLINGTON ARCADE et al.**; *Tulliallan Burlington Ltd v EUIPO*; Judgment of 6 December 2017; EU:T:2017:873; Language of the case: EN. An application was filed for the figurative mark **BURLINGTON** to be registered as an EUTM for goods in Classes 3, 14, 18 and 25. The opponent filed an opposition against the goods in Classes 3, 14 and 18 on the basis of, inter alia, the earlier UK word mark **BURLINGTON** (Classes 35 and 36), the earlier UK word mark **BURLINGTON ARCADE** (Classes 35, 36 and 41) and the UK and EU figurative mark **BURLINGTON ARCADE** covering, for the EUTM, *advertising and promotion services and information services relating thereto; the bringing together for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from a range of general merchandise retail stores in Class 35, rental of shops; leasing of, or management of real estate; leasing of, or space between or within, buildings; real estate management services; information services relating to the rental of shops in Class 36, and entertainment services; provision of live entertainment in Class 41*. The opposition was filed pursuant to Article 8(1)(b) and Article 8(4) and (5) EUTMR. The OD fully upheld the opposition, examining only Article 8(5) EUTMR on the basis of the earlier figurative EUTM. The EUTM applicant filed an appeal. The BoA found the appeal to be well founded and annulled the OD decision. With regard to Article 8(5) EUTMR, it held that the reputation of the earlier marks had been proven in the relevant territory for the services in



Classes 35 and 36, with the exception of the services of *the bringing together for the benefit of others, a variety of goods, enabling customers to conveniently ... purchase those goods from a range of general merchandise retail stores* in Class 35. However, the BoA denied any link between the conflicting marks and, irrespective of this, held that the applicant had not presented a consistent line of argument with regard to Article 8(5) EUTMR. Regarding Article 8(4) EUTMR, the BoA held that the applicant had not demonstrated that the prerequisites for establishing misrepresentation and damage vis-à-vis the target public had been met. Finally, as regards Article 8(1)(b) EUTMR, it was held that the goods and services at issue were dissimilar and that, for this reason alone, irrespective of the similarity of the marks concerned, a LOC was ruled out. The opponent filed an action before the GC, relying on three pleas in law: (i) infringement of Article 8(5) EUTMR and breach of procedural rules; (ii) breach of the obligation to state reasons, infringement of the right to be heard and infringement of Article 8(4) EUTMR; and (iii) infringement of Article 8(1)(b) EUTMR. **Regarding the third plea in law:** as regards the services in Class 36, there was no similarity between the rental of shops and offices or real estate management services and goods such as soap, jewellery and leather articles. As regards the services in Class 35, no similarity or complementarity could be established: the lack of any precise statement of the goods that might be sold in the various shops comprising a shopping arcade precluded any association between those shops and the goods of the contested mark, since the definition relating to 'luxury goods' was insufficient to specify the goods concerned (paras 70-71).

♦[T-121/16](#); **BURLINGTON THE ORIGINAL / BURLINGTON ARCADE et al.**; *Tulliallan Burlington Ltd v EUIPO*; Judgment of 6 December 2017; EU:T:2017:872; Language of the case: EN. An application was filed to register the figurative mark **BURLINGTON THE ORIGINAL** as an EUTM for goods in Classes 3, 14, 18 and 25. An opposition was filed, pursuant to Article 8(1)(b) and Article 8(4) and (5) EUTMR, against the goods in Classes 3, 14 and 18, based on, inter alia, the earlier UK word mark **BURLINGTON** (Classes 35 and 36), the earlier UK word mark **BURLINGTON ARCADE** (Classes 35, 36 and 41) and the earlier EU and UK figurative mark **BURLINGTON ARCADE** (Classes 35, 36 and 41). The OD fully upheld the opposition, examining only Article 8(5) EUTMR on the basis of the earlier figurative EUTM. An appeal was filed against the OD's decision. The BoA found the appeal to be well founded and annulled the OD decision. With regard to Article 8(5) EUTMR, it held that the reputation of the earlier marks had been proven in the relevant territory for the services in Classes 35 and 36, with the exception of the service of *the bringing together for the benefit of others, a variety of goods, enabling customers to conveniently ... purchase those goods from a range of general merchandise retail stores* in Class 35. However, the BoA denied any link between the conflicting marks and, irrespective of this, held that the applicant had not submitted a consistent line of argument with regard to Article 8(5) EUTMR. Regarding Article 8(4) EUTMR, the BoA held that the applicant had not demonstrated that the prerequisites for establishing misrepresentation and damage vis-à-vis the target public had been met. Finally, as regards Article 8(1)(b) EUTMR, no LOC was found, irrespective of the similarity of the marks, as the goods and services were dissimilar. The opponent filed an action before the GC, relying on three pleas in law: (i) infringement of Article 8(5) EUTMR, a procedural defect and a breach of the procedural rules; (ii) breach of the obligation to state reasons, infringement of the right to be heard and infringement of Article 8(4) EUTMR; and (iii) infringement of Article 8(1)(b) EUTMR. **Regarding the third plea in law:** as regards the services in Class 36, there was no similarity between the rental of shops and offices or real estate management services and goods such as soap, jewellery and leather articles. As regards the services in Class 35, no similarity or complementarity could be established: the lack of any precise statement of the goods that might be sold in the various shops comprising a shopping arcade precluded any association between those shops and the goods of the



contested mark, since the definition relating to 'luxury goods' was insufficient to specify the goods concerned (paras 70-71).

♦[T-122/16](#); **Burlington / BURLINGTON ARCADE**; *Tulliallan Burlington Ltd v EUIPO*; Judgment of 6 December 2017; EU:T:2017:871; Language of the case: EN. The intervener filed an application for protection in the EU of the figurative mark **Burlington** for goods in Classes 3, 14, 18 and 25. The applicant filed a notice of opposition for the goods in Classes 3, 14 and 18. The opposition was based on the word mark **BURLINGTON**, designating services in Classes 35 and 36; on the word mark **BURLINGTON ARCADE**, designating services in Classes 35, 36 and 41 and on the figurative mark **BURLINGTON ARCADE**, designating services in Classes 35, 36 and 41. The opposition was filed pursuant to Article 8(1)(b) and Article 8(4) and (5) EUTMR. The OD fully upheld the opposition, examining only Article 8(5) EUTMR on the basis of the earlier figurative EUTM. An appeal was filed against the OD's decision. The BoA found the appeal to be well founded and annulled the OD decision. With regard to Article 8(5) EUTMR, it held that the reputation of the earlier marks had been proven in the relevant territory for the services in Classes 35 and 36, with the exception of the service of *the bringing together for the benefit of others, a variety of goods, enabling customers to conveniently ... purchase those goods from a range of general merchandise retail stores* in Class 35. However, the BoA denied any link between the conflicting marks and, irrespective of this, held that the applicant had not submitted a consistent line of argument with regard to Article 8(5) EUTMR. Regarding Article 8(4) EUTMR, the BoA held that the applicant had not demonstrated that the prerequisites for establishing misrepresentation and damage vis-à-vis the target public had been met. Finally, as regards Article 8(1)(b) EUTMR, no LOC was found, irrespective of the similarity of the marks, as the goods and services were dissimilar. The opponent filed an action before the GC, relying on three pleas in law: (i) infringement of Article 8(5) EUTMR, a procedural defect and breach of the procedural rules; (ii) breach of the obligation to state reasons, infringement of the right to be heard and infringement of Article 8(4) EUTMR; and (iii) infringement of Article 8(1)(b) EUTMR. **Regarding the third plea in law:** as regards the services in Class 36, there was no similarity between the rental of shops and offices or real estate management services and goods such as soap, jewellery and leather articles. As regards the services in Class 35, no similarity or complementarity could be established: the lack of any precise statement of the goods that might be sold in the various shops comprising a shopping arcade precluded any association between those shops and the goods of the contested mark, since the definition relating to 'luxury goods' was insufficient to specify the goods concerned (paras 70-71).

♦[T-123/16](#); **BURLINGTON / BURLINGTON ARCADE et al.**; *Tulliallan Burlington Ltd v EUIPO*; Judgment of 6 December 2017; EU:T:2017:870; Language of the case: EN. The intervener filed an application for protection in the EU of the figurative mark **BURLINGTON** for goods in Classes 3, 14, 18 and 25. The applicant filed a notice of opposition for the goods in Classes 3, 14 and 18. The opposition was based on the word mark **BURLINGTON** designating services in Classes 35 and 36; on the word mark **BURLINGTON ARCADE** designating services in Classes 35, 36 and 41 and on the figurative mark **BURLINGTON ARCADE** designating services in Classes 35, 36 and 41. The opposition was filed pursuant to Article 8(1)(b), Article 8(4) and Article 8(5) EUTMR. The OD fully upheld the opposition, examining only Article 8(5) EUTMR on the basis of the earlier figurative EUTM. An appeal was filed against the OD's decision. The BoA found the appeal to be well founded and annulled the OD decision. With regard to Article 8(5) EUTMR, it held that the reputation of the earlier marks had been proven in the relevant territory for the services in Classes 35 and 36, with the exception of the service of *the bringing together for the benefit of others, a variety of goods, enabling customers to conveniently ... purchase those goods from a range*



of general merchandise retail stores in Class 35. However, the BoA denied any link between the conflicting marks and, irrespective of this, held that the applicant had not submitted a consistent line of argument with regard to Article 8(5) EUTMR. Regarding Article 8(4) EUTMR, the BoA held that the applicant had not demonstrated that the prerequisites for establishing misrepresentation and damage vis-à-vis the target public had been met. Finally, as regards Article 8(1)(b) EUTMR, no LOC was found, irrespective of the similarity of the marks, as the goods and services were dissimilar. The opponent filed an action before the GC, relying on three pleas in law: (i) infringement of Article 8(5) EUTMR, a procedural defect and breach of the procedural rules; (ii) breach of the obligation to state reasons, infringement of the right to be heard and an infringement of Article 8(4) EUTMR; and (iii) infringement of Article 8(1)(b) EUTMR. **Regarding the third plea in law:** as regards the services in Class 36, there was no similarity between the rental of shops and offices or real estate management services and goods such as soap, jewellery and leather articles. As regards the services in Class 35, no similarity or complementarity could be established: the lack of any precise statement of the goods that might be sold in the various shops comprising a shopping arcade precluded any association between those shops and the goods of the contested mark, since the definition relating to 'luxury goods' was insufficient to specify the goods concerned (paras 70-71).

C. Article 8(3), 53(1)(b) EUTMR — trade mark filed by agent

[No entry]


D. Article 8(4), 53(1)(c) EUTMR — non-registered marks/other signs used in the course of trade

♦[C-598/14 P](#); **LAGUIOLE**; *EUIPO v Gilbert Szajner*, Judgment of 5 April 2017; EU:C:2017:265; Language of the case: FR. The holder of the contested EUTM registration had submitted, for the first time before the GC, a judgment of the French *Cour de Cassation*, rendered **after** the BoA decision. This judgment supported the view that the scope of protection of a corporate name is defined by reference to the business actually carried out by a company. The GC had considered this judgment admissible and had reviewed the legality of the BoA decision in the light thereof. This had led the GC to annul in part the BoA decision (21/10/2014, [T-453/11](#), *Laguiole*, EU:T:2014:901). The Office lodged an appeal before the CJ on two accounts: (i) infringement of Article 72(2) EUTMR, in that the legality of the BoA decision had been examined in the light of subsequent circumstances, and (ii) infringement of Article 8(4) EUTMR, in that the GC had failed to apply the French law properly. The CJ dismissed the appeal. **The interpretation of the Cour de Cassation judgment and the application of French law:** as regards the second plea, the CJ confirmed that its review was limited to verifying that the GC had not made any manifest error in applying the national law (para. 56) and that no such manifest error could be found in the way in which the GC had interpreted the judgment of the French *Cour de Cassation* (paras 59-62). According to the CJ, the GC had correctly applied the French law in determining the scope of protection of a corporate name by reference to activities actually carried out by the company concerned (as opposed to activities merely mentioned in the company's articles of incorporation). The GC had not committed any error in defining the activities of the cancellation applicant by



reference not only to the nature of the goods concerned, but also to their intended use, purpose, customers and distribution channels (para. 70).

[T-223/15](#); **MORTON'S**; *Morton's of Chicago, Inc. v EUIPO*; Judgment of 15 May 2017; EU:T:2017:333; Language of the case: EN.

| EUTM | Earlier right |
|---|--|
|  | <p data-bbox="1002 622 1161 651">MORTON'S</p> |

For some time, the invalidity applicant had run a club called **MORTON'S** in London. It alleged that, under the UK laws of passing off, it could prohibit use of the contested EUTM for the relevant goods and services in Classes 29, 30 and 43. The CD rejected this claim and found, inter alia, that the invalidity applicant had failed to prove that it was the owner of goodwill in the name MORTON'S. The BoA upheld the appeal. It found that the invalidity applicant owned goodwill in MORTON'S for *club services and restaurant, bar and entertainment services*, and that all the requirements of passing off were satisfied. The EUTM proprietor filed an action before the GC, relying on two pleas in law: (i) infringement of Article 8(4) EUTMR and (ii) infringement of Article 59(1)(b) EUTMR. **Infringement of Article 8(4) EUTMR**: the principal plea consisted of five complaints: (i) that the UK rules on passing off had been misinterpreted, (ii) that the evidence was flawed, (iii) that the invalidity applicant did not own the goodwill in the name MORTON'S, (iv) that there was no likelihood of misrepresentation, and (v) that the earlier right had only local significance. The GC rejected complaint (i), which alleged that the finding of goodwill for *restaurant and bar services as well as entertainment and club services*, 'was too broad and should have been limited to *services of a private members' club*. The GC reasoned that customers, accustomed to associating the name MORTON'S with the exclusive restaurant, bar and entertainment services that the club offered, would assume that the goods and services marketed under the contested EUTM also originated from the invalidity applicant (paras 21-22). Complaint (ii) queried the date of the evidence presented to prove use and goodwill for the earlier mark. However, the GC was satisfied that the BoA had taken account of the relevant dates when finding that the invalidity applicant had proven goodwill and use of the earlier marks of more than mere local significance (para. 29). On complaint (iii), regarding ownership of goodwill, the evolution of MORTON'S Club over the years had involved various stages where the club had changed ownership and/or management and where various aspects of the business (e.g. management of the business and ownership of the property) had been split between several entities. The many agreements and parties meant that it was not easy to determine where 'control' over day-to-day business lay. Under the laws of passing off, if the invalidity applicant was responsible for the day-to-day running of MORTON'S, then the goodwill would accrue to it **unless** another party retained control over the quality of the services provided. Resolving this issue touched on the following key characteristics of goodwill:

- goodwill attaches to a business (and not merely to a name);
- goodwill cannot be separated from the underlying business to which it attaches;

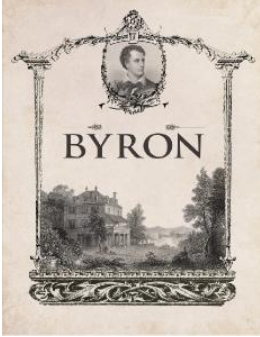


- any agreement purporting to assign or licence goodwill (and hence an unregistered trade mark) **separate from** the underlying business is invalid under English law as an ‘assignment in gross’ or ‘bare licence’.

The invalidity applicant argued that the goodwill in the business passed to it via the various agreements, whereas the EUTM proprietor argued that the agreements showed that another party maintained final control of key matters, which meant that the invalidity applicant was merely a manager who did not own the goodwill. The GC examined the agreements and concluded that it was, in fact, the invalidity applicant who had been conducting the day-to-day business and using the earlier rights in relation to the relevant services since 2002. Furthermore, it had, under an agreement of 3 April 2002, acquired the goodwill relating to MORTON’S and the exclusive right to operate that club and use the trade names associated with it. Consequently, it did own the goodwill (paras 39-45). The GC went on to consider complaint (iv), which alleged that there was no likelihood of misrepresentation because customers of MORTON’S were a ‘niche group of wealthy individuals’ who were particularly attentive to the club’s activities; thus they would not confuse them with the activities of a restaurant bearing a similar name. First, the GC found that the relevant public comprised the invalidity applicant’s customers, namely the members of MORTON’S Club and their guests. Next, it observed that the goods and services covered by the EUTM were partly identical and partly similar to the restaurant, bar, club and entertainment services for which the earlier marks enjoyed goodwill. Finally, the GC pointed out that the signs in question were practically identical. These factors gave rise to a likelihood of misrepresentation for the purposes of passing off (paras 51-57). On the final complaint (v), alleging that the earlier right was only of local significance, the GC pointed out that it was necessary to take into account both the geographical dimension (the territory in which the sign was used to identify its proprietor’s economic activity) and the economic dimension of the sign’s significance. As regards the former, although MORTON’S was located in London, it was referred to in a number of press articles with UK-wide and international coverage as well as in restaurant guides in the United Kingdom. As to the economic dimension, the GC found that the duration and intensity of the use of the earlier trade marks could be considered as being non-negligible. In particular, as exclusivity is part of the club’s image, the relatively small number of members was not critical. The allegation that the earlier right was only of local significance was therefore also rejected (paras 65-79). Accordingly, the entire first plea was rejected. **Infringement of Article 59(1)(b) EUTMR:** since the invalidity of the EUTM, declared by the BoA, was upheld, it was not necessary to examine the second plea in law, based on an infringement of Article 59(1)(b) EUTMR.



[T-45/16](#); **BYRON / BYRON**; *Nelson Alfonso Egüed v EUIPO*; Judgment 18 July 2017; EU:T:2017:518; Language of the case: EN

| EUTM application | Earlier non-registered mark |
|---|--|
|  | <p style="text-align: center;">BYRON</p> |

The applicant filed an application for the registration of the figurative mark represented above as an EUTM for goods in Class 33. An opposition was filed pursuant to Article 8(4) EUTMR, based on, inter alia, the earlier non-registered trade mark represented above, used in the course of trade in the United Kingdom to designate wines. The OD upheld the opposition in its entirety. The BoA dismissed the applicant’s appeal. It endorsed the OD’s findings that the evidence submitted by the opponent was sufficient to demonstrate that the non-registered trade mark was used in the course of trade and that its use was not of mere local significance in the United Kingdom. Moreover, it concluded that the wine sold under the earlier mark had acquired goodwill and there was a likelihood that the applicant’s goods would be confused with those of the opponent, as a result of which the latter would suffer damage. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 8(4) EUTMR. The applicant did not contest the BoA’s findings that the earlier non-registered trade mark was used in the course of trade in the United Kingdom in relation to wine and that that use was of more than mere local significance. The single plea in law put forward by the applicant related to one of the three conditions that make up the ‘classic trinity’ of the tort of passing off, namely goodwill. The GC dismissed the appeal. The GC endorsed the BoA’s findings that the opponent was engaged in genuine trading activities related to the wines sold under the **BYRON** trade mark in the United Kingdom. Consequently, it had acquired goodwill at the time of the application for registration of the figurative mark **BYRON** as an EUTM. The fact that the opponent was established in the United States and sold its wine through its distributor could not alter the BoA’s findings that the applicant had goodwill in the United Kingdom. Likewise, although the sales were not particularly high, they were sufficient to create goodwill. Moreover, even if the opponent did not present any evidence that the earlier mark was used between the filing of the contested EUTM and the date when the opposition was filed, this 5-month period was not long enough for the goodwill to have been extinguished solely on account of the passage of time. The GC confirmed that the BoA had correctly relied on the ‘classic’ form of the action for passing off, concluding that there was a LOC in that the applicant’s goods would be taken for those of the opponent. In the present case, there was no need to apply the ‘extended’ form of the tort of passing off; therefore, the applicant’s arguments concerning the low price and average quality of the opponent’s goods were ineffective. As to the acquisition of goodwill, the GC confirmed that, although the goods were sold in the United Kingdom through the sole distributor, it was the opponent who actually owned the goodwill. Finally, the fact that the



opponent had an identical registered EUTM, which had been allowed to expire some 5 years before the filing of the contested EU trade mark, could not disprove the existence of goodwill generated by the non-registered trade mark **BYRON** and acquired by the opponent. Therefore, in the absence of any arguments by the applicant concerning misrepresentation and damage, the GC upheld the BoA's conclusion that, given the identical nature of the goods at issue and the similarities between the signs, there was a likelihood that the applicant's goods would be confused with those of the opponent, a misrepresentation which would cause the opponent damage.

[C-56/16 P](#); **PORT CHARLOTTE**; *EUIPO v Instituto dos Vinhos do Douro e do Porto IP*; Judgment of 14 September 2017; EU:C:2017:693; Language of the case: EN. The EUTM proprietor registered an EUTM for the word sign **PORT CHARLOTTE** for goods in Class 33. The invalidity applicant filed an application for a declaration of invalidity pursuant to Article 60(1)(c) in conjunction with Article 8(4) EUTMR, Article 60(1)(a) in conjunction with Article 7(1)(c) and (g) EUTMR, and Article 60(2)(d) EUTMR. In response to the application, the EUTM proprietor limited the list of goods to *whisky*. The CD rejected the application for a declaration of invalidity. The invalidity applicant filed an appeal with the BoA, which was dismissed. It then lodged an appeal before the GC, relying on one plea in fact and five pleas in law. The GC upheld the third plea and the first part of the fourth plea, inasmuch as those pleas essentially criticised the BoA for not applying the relevant rules of Portuguese law relating to the protection of the appellations of origin **Porto** or **Port**, and rejected the other pleas. The Office appealed against the GC judgment. The invalidity applicant (the appellant before the GC) brought a cross-appeal against the same judgment. The Office relied on a single ground of appeal: infringement of Article 60(1)(c) in conjunction with Article 8(4) and Article 60(2)(d) EUTMR (para. 33). In support of its cross-appeal, the invalidity applicant put forward three grounds of appeal (para. 50). With regard to the **first ground of the cross-appeal**, the CJ found that the GC had not erred in law by applying to the system provided for by Council Regulation (EC) No 1234/2007 the principles laid down by the CJ in the *Budějovický Budvar* judgment (08/09/2009, C-478/07, *Budějovický Budvar*, EU:C:2009:521) regarding the uniform and exclusive nature of the system of protection provided for by Council Regulation (EC) No 510/2006 (para. 75). It held that, although the system of protection established by Regulation No 1234/2007 was not identical to that provided for by Regulation No 510/2006, the GC had been right in holding that the two systems had essentially the same in nature, since their objectives and characteristics were similar. In analysing the objectives of the system of protection of Regulation No 1234/2007, the CJ drew an analogy with the conclusions in *Budějovický Budvar*. Consequently, the CJ concluded that the GC had been right in holding that, as regards the designations of origin 'Porto' or 'Port', which were protected under Regulation No 1234/2007, that regulation contained a uniform and exclusive system of protection, with the result that the BoA did not have to apply the relevant rules of Portuguese law (para. 96). With regard to the **single ground of appeal in the main appeal**, the CJ reaffirmed that the system provided for by Regulation No 1234/2007 was exhaustive in nature, with the result that it precluded the application of a national system of protection for geographical indications that were protected under that regulation (para. 103). In this light, the CJ found that the GC had erred in law in holding that the protection conferred on protected designations of origin and geographical indications under Regulation No 1234/2007 might be supplemented by the relevant national law granting additional protection (para. 108). It therefore upheld the single ground of appeal in the main appeal (para. 109). With regard to the **second ground of appeal in the cross-appeal**, alleging infringement of Article 118m(2)(a) of Regulation No 1234/2007, the CJ found that the incorporation in a trade mark of a PDO could not exploit the reputation of such PDO if the relevant public did not associate that mark or the goods in respect of which it was registered with the PDO or the product protected by the PDO. The GC's assessment of the



facts of how the trade marks would be perceived was not open to challenge. It was not established that there had been a manifest distortion of evidence (paras 113-116). Therefore, the second ground of appeal in the cross-appeal was rejected (para. 119). The **third ground of appeal of the cross-appeal** concerned the alleged infringement of Article 118m(2)(b) of Regulation No 1234/2007, namely that the contested mark ‘Port Charlotte’, which was registered in respect of a whisky, did not involve ‘misuse, imitation or evocation’, within the meaning of that provision, of the protected designation of origin **Porto** or **Port** (para. 120). The CJ found that the GC, without erring in law, had applied the fundamental criterion deriving from the case-law by holding that, even though the term ‘port’ formed an integral part of the contested mark, the average consumer, even if he or she was of Portuguese origin or spoke Portuguese, would not associate a whisky bearing that mark with a port wine covered by the designation of origin in question (para. 124). The CJ further stated that the assessments carried out by the GC to conclude a lack of evocation were factual assessments, and the appellant before the GC had not established that there was any distortion of the evidence (para. 126). This ground too was rejected (para. 127). Consequently, the main appeal was upheld and the cross-appeal dismissed. The CJ ordered the GC’s judgment to be set aside (para. 128).


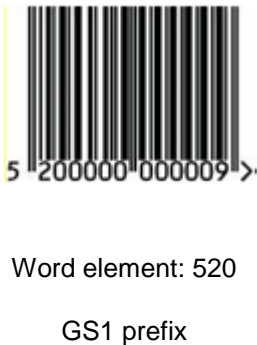
♦[T-315/16](#); **Butterfly / Butterfly**; *Tamasu Butterfly Europa GmbH v EUIPO*; Judgment of 19 September 2017; EU:T:2017:629; Language of the case: DE. The intervener sought to register the word mark **Butterfly** as an EUTM for goods and services in Classes 28 and 41. An opposition based on the earlier EUTM (word mark) **Butterfly**, registered for goods and services in Classes 25 and 28, was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The opposition was also based, pursuant to Article 8(4) EUTMR, on the trade name **Butterfly**. The OD dismissed the opposition and the applicant lodged an appeal. The BoA dismissed the appeal insofar as (i) the goods and services were neither similar nor identical; (ii) the applicant had not proven the reputation of its earlier mark; and (iii) the applicant had not proven that the trade name had been used in the course of trade of more than mere local significance. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 8(1)(b) EUTMR, (ii) infringement of Article 8(5) EUTMR, and (iii) infringement of Article 8(4) EUMTR. **Use in trade of more than mere local significance**: the GC rejected the applicant’s argument that the requirements laid down in Article 8(4) EUTMR had to be interpreted in the light of German law (para. 79) insofar as the proceedings referred to the registration of an EUTM and not a national mark (para. 80). Taking into account the documents related to the geographical and economic extent of the use of the trade name, it was not possible to conclude that the unregistered mark had been used in trade of more than local significance (para. 97). As a consequence of all the above, the GC upheld the BoA’s decision in its entirety.

♦[T-609/15](#); **BASIC**; *Repsol YPF, SA / EUIPO – Basic AG Lebensmittelhandel (BASIC)*; Judgment of 21 September 2017; EU:T:2017:640; Language of the case: EN. The CD declared the contested EUTM invalid on the grounds of Article 8(4) EUTMR as it found that the earlier trade and company names (i) had been used in trade of more than local significance in Germany and (ii) entitled their owner to prohibit the use of the contested EUTM in accordance with Section 15(2) of the German Trade Mark Act due to the existence of a LOC for the relevant German public. The BoA dismissed the appeal. It found, in particular, that the invalidity applicant had established use of more than local significance of its earlier trade and company names in Germany (i) before the filing date of the contested EUTM (2007), (ii) at the time of filing the invalidity request (2011), and (iii) for the period between these relevant points in time (2007 to 2011). The documents submitted by the invalidity applicant analysed by the BoA to that effect consisted of (i) an affidavit with regard to use throughout the entire period (pre-2007 to 2011), (ii) extensive supporting evidence



regarding the period prior to 2007, and (iii) one screenshot of the invalidity applicant's website, displaying information on the company and a map showing the location of its supermarkets in Germany and Austria (dated 2010 and 2011). The EUTM owner challenged the BoA's decision on the grounds, inter alia, that the invalidity applicant had not established use in trade of more than merely local significance as required by Article 8(4) EUTMR. The GC upheld the action for annulment on that ground and annulled the contested decision. The GC accepted that the documents actually analysed by the BoA (paras 50 and 66) showed use of the earlier signs to the requisite legal standard for the period prior to the date of filing of the contested EUTM (pre-2007, paras 51-59). However, it considered the documents insufficient for also showing use on the date of filing of the invalidity request (2011, paras 60-67). Despite indications on turnover under the signs up until July 2009, December 2010 and June 2011 (para. 63), the affidavit was 'primarily intended to corroborate the intervener's [invalidity applicant's] use of the basic sign in the course of trade prior to 2007' (para. 62) and was not confirmed by further probative evidence (paras 64-65). The GC confirmed that the obligation to establish use under Article 8(4) EUTMR applied not only for the filing date of the contested EUTM (29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 164-168) but also for the date on which the invalidity request was filed (23/10/2013, T-581/11, Baby Bambolina, EU:T:2013:553, § 27). In addition, the GC clarified that (i) EU law applied to the proof of continued existence of the earlier national right, and (ii) there was, in principle, no requirement to establish use between the two dates (para. 48 in conjunction with paras 42, 45 and 46).

♦[T-453/16](#); **5 21000 603856 520Barcode Hellas / 520 barcode**; *Ellinikos Syndesmos Epicheiriseon gia ti Diacheirisi ton Diethnon Protypon GS1 v EUIPO*; Judgment of 3 October 2017; EU:T:2017:685; Language of the case: EN

| EUTM application | Earlier right |
|---|--|
|  |  |

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 6, 7, 9, 11, 14, 16, 20, 29, 30, 35, 36, 37, 38, 39, 41, 42, 43 and 45. An opposition based on the sign represented above was filed pursuant to Article 8(4) EUTMR. The OD dismissed the opposition. The BoA dismissed the opponent's appeal. It found that the opponent had failed to identify clearly and precisely the earlier non-registered trade mark and the goods and services covered by it. The goods and services on which the opposition was based were also not indicated with sufficient clarity and precision. No use was shown of the earlier trade mark as represented in the notice of opposition. The opponent filed an action before the GC, relying on two pleas in law: (i) infringement of Article 8(4) EUTMR and (ii) infringement of Articles 94 and 95 EUTMR. The GC upheld the appeal. The



GC considered that despite and beyond the reference, in the notice of opposition, to ‘the GS1 barcode and prefix’, and to the graphic representation of a barcode with the 13-digit sequence 5 200000 000009 underneath it, the opposition was, in actual fact, based on the trigraph ‘520’ as ‘another sign’. The OD had wrongly rejected the opposition on the assumption (partially due to an IT error) that the earlier right was a non-registered trade mark (paras 30-38). In its appeal before the BoA, the opponent had specifically criticised this. The BoA’s findings concerning the alleged non-registered trade mark were irrelevant to the assessment of the legality of the contested decision, since they did not relate to the sign ‘520’ cited in opposition and failed to provide a response to the opposition put forward by the opponent. The BoA had erred in law in its assessment of the nature of the opposition and in its assessment of the arguments put forward before it by the opponent; as a result of that error, it had failed to examine the conditions of Article 8(4) EUTMR in respect of ‘520’ as ‘another sign’ (paras 39-73). As far as the BoA’s statement that the indication of Classes 1-45 as goods and services for which the earlier sign was protected was not sufficiently clear and precise, the GC stated that Implementing Regulation (EC) No 2868/95 did not require an indication of the goods and services in respect of which the sign was protected, but only of the goods and services on which the opposition was based. In addition, the case in question differed from the circumstances of the IP Translator case (19/06/2012, C-307/10, IP Translator, EU:C:2012:361) (paras 74-82). The BoA’s finding that the reference to Classes 1 to 45 to designate the goods and services on which the opposition was based was insufficient also had to be rejected. The opponent had intended to base its opposition on ‘another sign’ used in the identification of all types of goods and services across all sectors; the identification and classification of goods and services assumed by barcode systems, including the GS1 system, were operations that could be carried out in the most diverse types of economic activity. It was not illogical in that context and given the particular nature of the sign cited in opposition, for the opponent to refer in the broadest way possible to the goods and services in Classes 1 to 45, that is to say, to all goods and services (paras 83-86). Moreover, the EUIPO had accepted that definition of the goods and services by considering the opposition admissible and not sending a letter to the opponent under Rule 17(4) of Implementing Regulation (EC) No 2868/95 (para. 88).

♦[T-316/16](#); **SDC-554S / SDC-554S**; *Moravia Consulting spol. s r.o. v EUIPO*; Judgments of 12 October 2017; EU:T:2017:717; Language of the case: EN. The applicant sought to register the word mark **SDC-554S** for goods in Class 9. An opposition, based on an earlier non-registered trade mark identical to the trade mark applied for, was filed pursuant to Article 8(4) EUTMR. The OD dismissed the opposition. The BoA dismissed the appeal. The opponent filed an action before the GC. The GC dismissed the appeal. The opponent relied on two pleas in law: (i) infringement of Article 8(4) EUTMR and of Article 95(1) EUTMR and (ii) infringement of Article 59(1)(b) EUTMR. The plea of bad faith is inadmissible in the context of opposition proceedings (paras 26-31). The opponent must provide evidence of the content of national law before the EUIPO (paras 38-43). Such evidence cannot be filed for the first time before the BoA, if no evidence had been submitted before the OD as to the existence, validity and scope of protection of the right relied on. In such a case, the BoA has no discretion to accept the evidence submitted for the first time before it, as it could not be considered additional or supplementary (paras 38-61). The evidence produced by the opponent for the first time at the hearing was also inadmissible (para. 63). Even if the evidence were to be considered additional or supplementary, the BoA would have had to exercise its discretion in the negative, because the opponent must necessarily have been aware, also because of the standard letter sent by OD on how to support its opposition, that it was obliged to produce some evidence to establish the content of the national law before the OD. The principle *iura novit curia* was not applicable, since national law is a matter of



establishing facts. It is only when the Office already has information on national law available to it that it must of its own motion inform itself of the latter (paras 65-74).

♦[T-317/16](#); **SDC-888TII RU / SDC-888TII RU**; *Moravia Consulting spol. s r.o. v EUIPO*; Judgments of 12 October 2017; EU:T:2017:718; Language of the case: EN. The applicant sought to register the word mark **SDC-888TII RU** for goods in Class 9. An opposition, based on an earlier non-registered trade mark identical to the trade mark applied for, was filed pursuant to Article 8(4) EUTMR. The OD dismissed the opposition. The BoA dismissed the appeal. The opponent filed an action before the GC. The GC dismissed the appeal. The opponent relied on two pleas in law: (i) infringement of Article 8(4) EUTMR and of Article 95(1) EUTMR, and (ii) infringement of Article 59(1)(b) EUTMR. The plea of bad faith is inadmissible in the context of opposition proceedings (paras 26-31). The opponent must provide evidence of the content of national law before the EUIPO (paras 38-43). Such evidence cannot be filed for the first time before the BoA if no evidence had been submitted before the OD as to the existence, validity and scope of protection of the right relied on. In such a case, the BoA has no discretion to accept the evidence submitted for the first time before it, as it could not be considered additional or supplementary (paras 38-61). The evidence produced by the opponent for the first time at the hearing was also inadmissible (para. 63). Even if the evidence were to be considered additional or supplementary, the BoA would have had to exercise its discretion in the negative, because the opponent must necessarily have been aware, also because of the standard letter sent by OD on how to support its opposition, that it was obliged to produce some evidence to establish the content of the national law before the OD. The principle *iura novit curia* was not applicable, since national law is a matter of establishing facts. It is only when the Office already has information on national law available to it that it must of its own motion inform itself of the latter (paras 65-74).

♦[T-318/16](#); **SDC-444S / SDC-444S**; *Moravia Consulting spol. s r.o. v EUIPO*; Judgments of 12 October 2017; EU:T:2017:719; Language of the case: EN. The applicant sought to register the word mark **SDC-444S** for goods in Class 9. An opposition, based on an earlier non-registered trade mark identical to the trade mark applied for, was filed pursuant to Article 8(4) EUTMR. The OD dismissed the opposition. The BoA dismissed the appeal. The opponent filed an action before the GC. The GC dismissed the appeal. The opponent relied on two pleas in law: (i) infringement of Article 8(4) EUTMR and of Article 95(1) EUTMR, and (ii) infringement of Article 59(1)(b) EUTMR. The plea of bad faith is inadmissible in the context of opposition proceedings (paras 26-31). The opponent must provide evidence of the content of national law before the EUIPO (paras 38-43). Such evidence cannot be filed for the first time before the BoA if no evidence had been submitted before the OD as to the existence, validity and scope of protection of the right relied on. In such a case, the BoA has no discretion to accept the evidence submitted for the first time before it, as it could not be considered additional or supplementary (paras 38-61). The evidence produced by the opponent for the first time at the hearing was also inadmissible (para. 63). Even if the evidence were to be considered additional or supplementary, the BoA would have had to exercise its discretion in the negative, because the opponent must necessarily have been aware, also because of the standard letter sent by the OD on how to support its opposition, that it was obliged to produce some evidence to establish the content of the national law before the OD. The principle *iura novit curia* was not applicable, since national law is a matter of establishing facts. It is only when the Office already has information on national law available to it that it must of its own motion inform itself of the latter (paras 65-74).

♦[T-120/16](#); **BURLINGTON / BURLINGTON ARCADE et al.**; *Tulliallan Burlington Ltd v EUIPO*; Judgment of 6 December 2017; EU:T:2017:873; Language of the case: EN. An



application was filed for the figurative mark **BURLINGTON** to be registered as an EUTM for goods in Classes 3, 14, 18 and 25. The opponent filed an opposition against the goods in Classes 3, 14 and 18 on the basis of, inter alia, the earlier UK word mark **BURLINGTON** (Classes 35 and 36), the earlier UK word mark **BURLINGTON ARCADE** (Classes 35, 36 and 41) and the UK and EU figurative mark **BURLINGTON ARCADE** covering, for the EUTM, *advertising and promotion services and information services relating thereto; the bringing together for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from a range of general merchandise retail stores in Class 35, rental of shops; leasing of, or management of real estate; leasing of, or space between or within, buildings; real estate management services; information services relating to the rental of shops in Class 36, and entertainment services; provision of live entertainment in Class 41.* The opposition was filed pursuant to Article 8(1)(b) and Article 8(4) and (5) EUTMR. The OD fully upheld the opposition, examining only Article 8(5) EUTMR on the basis of the earlier figurative EUTM. The EUTM applicant filed an appeal. The BoA found the Appeal to be well founded and annulled the OD decision. With regard to Article 8(5) EUTMR, it held that the reputation of the earlier marks had been proven in the relevant territory for the services in Classes 35 and 36, with the exception of the services of *the bringing together for the benefit of others, a variety of goods, enabling customers to conveniently ... purchase those goods from a range of general merchandise retail stores in Class 35.* However, the BoA denied any link between the conflicting marks and, irrespective of this, held that the applicant had not presented a consistent line of argument with regard to Article 8(5) EUTMR. Regarding Article 8(4) EUTMR, the BoA held that the applicant had not demonstrated that the prerequisites for establishing misrepresentation and damage vis-à-vis the target public had been met. Finally, as regards Article 8(1)(b) EUTMR, it was held that the goods and services at issue were dissimilar and that, for this reason alone, irrespective of the similarity of the marks concerned, a LOC was ruled out. The opponent filed an action before the GC, relying on three pleas in law: (i) infringement of Article 8(5) EUTMR and breach of procedural rules; (ii) breach of the obligation to state reasons, infringement of the right to be heard and infringement of Article 8(4) EUTMR; and (iii) infringement of Article 8(1)(b) EUTMR. **Regarding the second plea in law:** the BoA had analysed the conditions relating to Article 8(4) EUTMR and the action for passing off. In addition, the applicant had indeed been in a position to submit its observations throughout the proceedings before the Office. The BoA could not be criticised for not requesting additional observations from the parties. The right to be heard extended to all the factual and legal factors on which the decision-making act was based, but not to the final position that the BoA intended to adopt (paras 53-55). The applicant had not demonstrated that the prerequisites for an action for passing off had been duly met, simply stating before the BoA that it maintained the arguments it had submitted before the OD, without any further substantiation, either in fact or in law (para. 61).

♦[T-121/16](#); **BURLINGTON THE ORIGINAL / BURLINGTON ARCADE et al.**; *Tulliallan Burlington Ltd v EUIPO*; Judgment of 6 December 2017; EU:T:2017:872; Language of the case: EN. An application was filed to register the figurative mark **BURLINGTON THE ORIGINAL** as an EUTM for goods in Classes 3, 14, 18 and 25. An opposition was filed, pursuant to Article 8(1)(b) and Article 8(4) and (5) EUTMR, against the goods in Classes 3, 14 and 18, based on, inter alia, the earlier UK word mark **BURLINGTON** (Classes 35 and 36), the earlier UK word mark **BURLINGTON ARCADE** (Classes 35, 36 and 41) and the earlier EU and UK figurative mark **BURLINGTON ARCADE** (Classes 35, 36 and 41). The OD fully upheld the opposition, examining only Article 8(5) EUTMR on the basis of the earlier figurative EUTM. An appeal was filed against the OD's decision. The BoA found the appeal to be well founded and annulled the OD decision. With regard to Article 8(5) EUTMR, it held that the reputation of the earlier marks had been proven in the relevant territory for the services in Classes 35 and 36, with the exception of the service of *the bringing together for*



the benefit of others, a variety of goods, enabling customers to conveniently ... purchase those goods from a range of general merchandise retail stores in Class 35. However, the BoA denied any link between the conflicting marks and, irrespective of this, held that the applicant had not submitted a consistent line of argument with regard to Article 8(5) EUTMR. Regarding Article 8(4) EUTMR, the BoA held that the applicant had not demonstrated that the prerequisites for establishing misrepresentation and damage vis-à-vis the target public had been met. Finally, as regards Article 8(1)(b) EUTM, no LOC was found, irrespective of the similarity of the marks, as the goods and services were dissimilar. The opponent filed an action before the GC, relying on three pleas in law: (i) infringement of Article 8(5) EUTMR, a procedural defect and infringement of the procedural rules; (ii) breach of the obligation to state reasons, infringement of the right to be heard and infringement of Article 8(4) EUTMR; and (iii) infringement of Article 8(1)(b) EUTMR. **Regarding the second plea in law:** the BoA had analysed the conditions relating to Article 8(4) EUTMR and the action for passing off. In addition, the applicant had indeed been in a position to submit its observations throughout the proceedings before the Office. The BoA could not be criticised for not requesting additional observations from the parties. The right to be heard extended to all the factual and legal factors on which the decision-making act was based, but not to the final position that the BoA intended to adopt (paras 53-55). The applicant had not demonstrated that the prerequisites for an action for passing off had been duly met, simply stating before the BoA that it maintained the arguments it had submitted before the OD, without any further substantiation, either in fact or in law (para. 61).

♦[T-122/16](#); **Burlington / BURLINGTON ARCADE**; *Tulliallan Burlington Ltd v EUIPO*; Judgment of 6 December 2017; EU:T:2017:871; Language of the case: EN. The intervener filed an application for protection in the EU of the figurative mark **Burlington** for goods in Classes 3, 14, 18 and 25. The applicant filed a notice of opposition for the goods in Classes 3, 14 and 18. The opposition was based on the word mark **BURLINGTON**, designating services in Classes 35 and 36; on the word mark **BURLINGTON ARCADE**, designating services in Classes 35, 36 and 41, and on the figurative mark **BURLINGTON ARCADE**, designating services in Classes 35, 36 and 41. The opposition was filed pursuant to Article 8(1)(b) and Article 8(4) and (5) EUTMR. The OD fully upheld the opposition, examining only Article 8(5) EUTMR on the basis of the earlier figurative EUTM. An appeal was filed against the OD's decision. The BoA found the appeal to be well founded and annulled the OD decision. With regard to Article 8(5) EUTMR, it held that the reputation of the earlier marks had been proven in the relevant territory for the services in Classes 35 and 36, with the exception of the service of *the bringing together for the benefit of others, a variety of goods, enabling customers to conveniently ... purchase those goods from a range of general merchandise retail stores* in Class 35. However, the BoA denied any link between the conflicting marks and, irrespective of this, held that the applicant had not submitted a consistent line of argument with regard to Article 8(5) EUTMR. Regarding Article 8(4) EUTMR, the BoA held that the applicant had not demonstrated that the prerequisites for establishing misrepresentation and damage vis-à-vis the target public had been met. Finally, as regards Article 8(1)(b) EUTMR, no LOC was found, irrespective of the similarity of the marks, as the goods and services were dissimilar. The opponent filed an action before the GC, relying on three pleas in law: (i) infringement of Article 8(5) EUTMR, a procedural defect and breach of the procedural rules; (ii) breach of the obligation to state reasons, infringement of the right to be heard and infringement of Article 8(4) EUTMR; and (iii) infringement of Article 8(1)(b) EUTMR. **Regarding the second plea in law:** the BoA had analysed the conditions relating to Article 8(4) EUTMR and the action for passing off. In addition, the applicant had indeed been in a position to submit its observations throughout the proceedings before the Office. The BoA could not be criticised for not requesting additional observations from the parties. The right to be heard extended to all the factual and legal



factors on which the decision-making act was based, but not to the final position that the BoA intended to adopt (paras 53-55). The applicant had not demonstrated that the prerequisites for an action for passing off had been duly met, simply stating before the BoA that it maintained the arguments it had submitted before the OD, without any further substantiation, either in fact or in law (para. 61).

♦[T-123/16](#); **BURLINGTON / BURLINGTON ARCADE et al.**; *Tulliallan Burlington Ltd v EUIPO*; Judgment of 6 December 2017; EU:T:2017:870; Language of the case: EN. The intervener filed an application for protection in the EU of the figurative mark **BURLINGTON** for goods in Classes 3, 14, 18 and 25. The applicant filed a notice of opposition for the goods in Classes 3, 14 and 18. The opposition was based on the word mark **BURLINGTON**, designating services in Classes 35 and 36; on the word mark **BURLINGTON ARCADE**, designating services in Classes 35, 36 and 41; and on the figurative mark **BURLINGTON ARCADE**, designating services in Classes 35, 36 and 41. The opposition was filed pursuant to Article 8(1)(b) and Article 8(4) and (5) EUTMR. The OD fully upheld the opposition, examining only Article 8(5) EUTMR on the basis of the earlier figurative EUTM. An appeal was filed against the OD’s decision. The BoA found the Appeal to be well founded and annulled the OD decision. With regard to Article 8(5) EUTMR, it held that the reputation of the earlier marks had been proven in the relevant territory for the services in Classes 35 and 36, with the exception of the service of *the bringing together for the benefit of others, a variety of goods, enabling customers to conveniently ... purchase those goods from a range of general merchandise retail stores* in Class 35. However, the BoA denied any ‘link’ between the conflicting marks and, irrespective of this, held that the applicant had not submitted a consistent line of argument with regard to Article 8(5) EUTMR. Regarding Article 8(4) EUTMR, the BoA held that the applicant had not demonstrated that the prerequisites for establishing misrepresentation and damage vis-à-vis the target public had been met. Finally, as regards Article 8(1)(b) EUTMR, no LOC was found, irrespective of the similarity of the marks, as the goods and services were dissimilar. The opponent filed an action before the GC, relying on three pleas in law: (i) infringement of Article 8(5) EUTMR, a procedural defect and breach of the procedural rules; (ii) breach of the obligation to state reasons, infringement of the right to be heard and infringement of Article 8(4) EUTMR; and (iii) infringement of Article 8(1)(b) EUTMR. **Regarding the second plea in law:** the BoA had analysed the conditions relating to Article 8(4) EUTMR and the action for passing off. In addition, the applicant had indeed been in a position to submit its observations throughout the proceedings before the Office. The BoA could not be criticised for not requesting additional observations from the parties. The right to be heard extended to all the factual and legal factors on which the decision-making act was based, but not to the final position that the BoA intended to adopt (paras 53-55). The applicant had not demonstrated that the prerequisites for an action for passing off were duly met, simply stating before the BoA that it maintained the arguments it had submitted before the OD, without any further substantiation, either in fact or in law (para. 61).

♦[T-828/16](#); **QUESO Y TORTA DE LA SERENA / TORTA DEL CASAR et al.**; *Consejo Regulador de la Denominación de Origen ‘Torta del Casar’ v EUIPO*; Judgment of 14 December 2017, EU:T:2017:918; Language of the case: ES.

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PDO TORTA DEL CASAR

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 29, 35 and 39. An opposition based on, inter alia, the PDO TORTA DEL CASAR was filed pursuant to Article 8(4) EUTMR. The OD dismissed the opposition. Following that, the BoA dismissed the opponent's appeal, insofar as the conditions for prohibiting the use of a later mark had not been met. It found that the protection granted by the PDO related to the whole of the expression applied for and not to each of the terms considered individually. It also found that the term 'TORTA' was not a traditional name designating an agricultural product, and the opponent had not submitted any proof in support of this argument. In any case, it was irrelevant since the PDO was for 'TORTA DEL CASAR' and the opposition was not based on a traditional name. According to the BoA, it was not the case that the term 'TORTA' had become generic or was the usual name for a cheese; rather it merely designated the shape of the product, without this fact being linked to the production of this foodstuff in a particular area. Finally, the BoA held that the geographically significant expression 'DE LA SERENA', when perceived in the trade mark applied for, was unlikely to bring to the consumer's mind the geographically significant element 'DEL CASAR'. The opponent filed an action before the GC, relying on four pleas in law: (i) infringement of Article 2(2), Article 3(1) and Article 13(1) of Regulation (EC) No 510/2006 on foodstuffs in conjunction with Article 8(4) EUTMR; (ii) infringement of Article 13(1) of Regulation (EC) No 510/2006 in conjunction with Article 8(4) EUTMR (iii) infringement of Article 94 EUTMR; and (iv) breach of the principles of legal certainty and sound administration. The opponent had stated since the beginning of the opposition proceedings that the term 'torta' constituted a traditional non-geographical name, and had submitted evidence that the term was a traditional name (administrative decisions and national judgments) (paras 44 and 50). Despite that, the BoA had not assessed whether or not the term 'torta' constituted a traditional name: it had merely asserted, on the one hand, that the opponent had not provided any evidence that the term 'torta' constituted a traditional name and, on the other hand, that the Spanish public would associate the term, used for cheese products, with a description of the shape of the product rather than with its place of production (para. 42). Moreover, it had not taken into consideration any of the factors that made it possible to carry out the necessary analysis of the possibly generic nature of a name or of one of its components; nor had it turned to any opinion polls of consumers or opinions of experts qualified in the subject area, or requested information from either Member States or the Commission (para. 43). However, it was possible for a protected designation to be evoked even where no EU protection extended to the parts of the designation echoed in the term at issue ('torta') (para. 60). What was important for finding evocation was the presumed reaction of consumers faced with the term used to designate the product — it was essential that they established a link between that term and the protected name (para. 61). The Board had erred in not examining whether the term 'torta' was a traditional non-geographical name and in ruling out that the EUTM application evoked the PDO 'Torta del Casar' merely because the term 'torta' did not refer to a geographical place (para. 66).



E. Article 8(2)(c), 8(5), 53(1)(a) EUTMR — well-known marks/marks with a reputation

♦[T-696/15](#); **TEMPOS VEGA SICILIA**; *Bodegas Vega Sicilia, S.A., v EUIPO*; Judgment of 9 February 2017; EU:T:2017:131; Language of the case: ES. The applicant sought to register the word mark TEMPOS VEGA SICILIA as an EUTM for *alcoholic beverages (except beers)* in Class 33. The examiner refused to register the trade mark as an EUTM pursuant to Article 7(1)(j) EUTMR. The BoA dismissed the applicant's appeal, finding that the trade mark applied for contained the whole PDO Sicilia, protected in the EU for wines, while the goods covered by the mark applied for did not originate from there. The applicant filed an action before the GC. The GC dismissed the appeal. The sign applied for was an expression consisting of, inter alia, the PDO Sicilia, which was clearly identifiable within the sign (not disputed). The GC confirmed that Article 7(1)(j) EUTMR applied without it being necessary to consider whether or not the mark for which registration was sought was liable to deceive the public or lead to a LOC regarding the origin of the product. **Family of marks**: the GC dismissed the applicant's claim, pointing out that the concept of a family of marks was only applicable in refusal proceedings based on relative grounds (paras 44-45). Article 102(2) of Regulation (EU) No 1308/2013 was not applicable, as the trade mark in question had not been registered before the PDO nor had previous use in good faith of the trade mark been proven. Priority could be claimed, where appropriate, only in respect of an existing mark and not for the registration of new marks that also consisted of the geographical indication in question but had not existed when protection was granted to the geographical indication (para. 52). A trade mark could be registered only individually, and the minimum five-year protection afforded by such registration was conferred on it only as an individual trade mark, even where several trade marks sharing one or more common and distinctive elements had been registered at the same time. Families of marks could not be registered and enjoy protection as such. The fact that a trade mark might belong to a family of marks was not relevant for the application of Article 102(2) of Regulation (EU) No 1308/2013 (para. 53). **Reputation**: the GC confirmed that the fact that a trade mark (or a previous trade mark belonging to the same family of marks) was widely known or enjoyed a reputation in the European Union was irrelevant in proceedings based on the absolute ground for refusal of Article 7(1)(j) EUTMR (paras 60-61). **Sound administration of justice**: the GC restated the case-law, according to which the Office had a duty to exercise its powers in accordance with the general principles of EU law, such as the principles of equal treatment and sound administration. The BoA had not erred in refusing registration of the trade mark on the grounds of Article 7(1)(j) EUTMR (paras 63-66).

[T-71/15](#); **Land Glider / LAND ROVER et al.**; Judgment of 16 February 2017; *Jaguar Land Rover Ltd v EUIPO*; EU:T:2017:82; Language of the case: EN. The EUTM applicant sought to register the word mark **Land Glider** as an EUTM for goods in Class 12. An opposition based on a number of word and figurative marks containing the terms 'LAND ROVER', registered for goods in Class 12, was filed pursuant to Articles 8(1)(b) and Article 8(5) EUTMR. The OD upheld the opposition on the basis of Article 8(5) EUTMR and refused the EUTM application in its entirety. The BoA upheld the applicant's appeal. It found that there was no LOC under Article 8(1)(b) EUTMR. As regards Article 8(5) EUTMR, the BoA considered that, even if the earlier marks had a reputation, the common element 'land', which classified the goods in question and would be understood throughout the EU, was not sufficient to lead the consumer to establish a relevant link between the marks at issue. The opponent filed an action before the GC, relying on three pleas in law: (i) infringement of Article 8(1)(b) EUTMR, (ii) infringement of Article 8(5) EUTMR, and (iii) infringement of Article 94 EUTMR. The GC upheld the appeal. The GC only examined the plea related to the infringement of Article 8(5) EUTMR. **Distinctiveness of the common element**: with the



exception of certain terms that formed part of the basic English vocabulary, it could not be assumed that English-language terms were widely known in the EU. In the case in question, the English word 'land', in particular in the sense of 'solid part of the Earth's surface', would not be considered to form part of such a basic vocabulary. Thus, for a considerable part of the relevant public there were no grounds to find that this word element was descriptive or weakly distinctive. The BoA's assessment of the similarity of the signs and of whether the relevant public would establish a link between the marks at issue was based on the incorrect premise that the element 'land' was descriptive for all of the relevant public (paras 62-78).

Assessment of enhanced distinctive character/Reputation: the BoA had examined enhanced distinctiveness in the context of Article 8(1)(b) EUTMR. However, the GC considered it necessary to check this assessment in the context of Article 8(5) EUTMR since, if it was true that the earlier mark did not have a reputation, this ground would not apply. The contested decision merely stated that the probative value of the evidence submitted by the applicant did not allow any conclusions to be drawn as to whether the earlier marks enjoyed enhanced distinctive character. The GC found that there was no comprehensive analysis of the 2 500 pages of documents submitted by the applicant, and therefore that it was not possible to reject the opponent's second plea in law on the grounds that the applicant had, in any event, not established the earlier marks' reputation (paras 79-83).

♦[C-655/15 P](#); **Krispy Kreme DOUGHNUTS**; *Panrico, S.A. v EUIPO*; Judgment of 2 March 2017; EU:C:2017:155; Language of the case: ES. An application for invalidity was filed pursuant to Article 60(1)(a) in conjunction with Article 8(1)(b) and Article 8(5) EUTMR against this EUTM, which was registered for goods in Class 30 and services in Class 42. The application for invalidity was based on the Spanish word marks **DOGHNUTS** and **DONUT** (both registered for goods in Class 30), the Spanish figurative marks **DONUTS** and **DONUTS CREAM** (both registered for goods in Class 30) and the international word mark **DONUT** (which covers goods in Classes 30 and 31). The CD rejected the application for invalidity in its entirety. The BoA dismissed the invalidity applicant's appeal. It found that the mark **DONUTS CREAM** had expired and that genuine use of the mark **DOGHNUTS** had not been proven. For the rest, the BoA ruled out a LOC and concluded that the contested mark would not take unfair advantage of the distinctive character or repute of the earlier word marks. The invalidity applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 60(1)(a) in conjunction with Article 8(1)(b) EUTMR, and (ii) infringement of Article 60(1)(a) in conjunction with Article 8(5) EUTMR. The GC dismissed the action. It found that there was only a remote aural similarity between the signs and concluded that there was no LOC even if the earlier marks had enhanced distinctiveness; such remote similarity was insufficient for consumers to establish a link between the signs, regardless of the high reputation of the earlier marks and the similarity or even identity between the goods and services involved. The invalidity applicant's appeal before the CJ was dismissed. The CJ dismissed the second and third pleas as partially inadmissible, namely the parts that implied a request for a new factual assessment (paras 68-69 and 87-89), and partially unfounded. Regarding the second plea, the CJ clarified that, (i) contrary to the invalidity applicant's allegation, the GC had taken into account the fact that the goods involved belonged to the same class, and (ii) that the GC's statements were sufficient to comply with the duty to state reasons (paras 72-74). The CJ denied any contradiction on the part of the GC, since the fact that a restaurant service was defined not only by the kind of product that was offered but also by the conditions under which the service was rendered, did not imply that, when the goods offered in a specific kind of restaurant were identical to those covered by the earlier marks, there was necessarily at least an average degree of similarity between those goods and that restaurant service (para. 77). Regarding the third plea, the CJ pointed out that the GC's reasoning supporting the BoA's conclusion that the aural similarity of the marks was too remote to allow the public to establish a link between them had been included purely for the



sake of completeness and, therefore, the invalidity applicant's allegations in this respect were nugatory (paras 90-92).

♦[T-637/15](#); **SOTTO IL SOLE ITALIANO SOTTO IL SOLE / VIÑA SOL et al.**; *Alma-the soul of Italian wine v EUIPO*; Judgment of 31 May 2017; EU:T:2017:371; Language of the case: EN. After the annulment (25/09/2014, [T-605/13](#), *SOTTO IL SOLE ITALIANO Sotto il Sole (fig.) / VIÑA SOL et al.*, EU:T:2014:812) of a first BoA decision based on Article 8(5) EUTMR, the BoA examined documents submitted by the applicant during the administrative proceedings on the alleged weak distinctive character of the word 'sun' in various languages. It found that 'SOL' was not devoid of distinctive character for wines, although it had a 'somewhat below normal level' of distinctiveness. It also found that there was a link between the signs, that there was detriment to the distinctive character of the earlier mark and that there was no due cause for the use of the mark applied for. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 8(5) EUTMR, (ii) infringement of Article 71(1), and (iii) infringement of Article 8(1)(b) EUTMR. The GC only dealt with the plea relating to Article 8(5) EUTMR. It confirmed the BoA's finding that the relevant public was the EU general public, whose level of attention was average (para. 39), and that the earlier mark had a reputation. The GC found that the extracts from websites offering consumers in the EU wines identified by marks that included the words 'sol', 'sole', 'soleil' or 'sun' and images of the sun, combined with a list of EUTMs in Class 22 containing those words or images, made it possible to conclude that EUTMs with references to the concept of the sun did coexist. The relevant EU consumers were frequently exposed to such marks (paras 61-62). The term 'SOL' had a low degree of distinctiveness. When associated with the weak term 'VIÑA', it conferred on the earlier mark only a low degree of distinctiveness (para. 63). Most EU consumers were likely to understand 'SOLE' and 'ITALIANO', which were the dominant elements of the ETM application (para. 67). There was only a low degree of visual similarity: the coincidence of the sequence of letters 'SOL' was not capable of offsetting the many differences between the signs. There was no aural similarity. Conceptually, there was dissimilarity: the earlier mark referred to a 'vineyard of the sun' whereas the mark applied for referred to the origin and place of production of the wine (paras 69-76). Overall, the degree of similarity between the signs was not sufficient for the relevant public to establish a link between them (para. 78). Article 8(5) could not apply. The action was upheld.

♦[T-341/13 RENV](#); **SO'BiO etic / SO...et al.**; *Groupe Léa Nature SA v EUIPO*; Judgment of 8 June 2017; EU:T:2014:802; Language of the case: EN. The applicant sought to register the figurative mark as an EUTM for goods and services in Classes 3 and 25. An opposition based on the earlier word mark SO...?, registered for goods and services in Class 3, was filed pursuant to Article 8(1)(b) and Article 8(4) and (5) EUTMR. The OD dismissed the opposition. The BoA upheld the opponent's appeal. It found that there was a LOC between the signs at issue with regard to the goods that were identical or similar. As regards the *bleaching preparations and other substances for laundry use* which were dissimilar to the opponent's goods, it held there was a risk that the sale of those goods would be detrimental to the repute of the earlier marks for the purposes of Article 8(5) EUTMR. The applicant filed an action before the GC relying on four pleas in law: (i) an error of law in the choice of the legal basis for the contested decision, and breach of the principle of legal certainty, the principle of the protection of legitimate expectations and the right to a fair hearing; (ii) an error of law in the assessment of the genuine use of the earlier marks; (iii) infringement of Article 8(1)(b) EUTMR; and (iv) infringement of Article 8(5) EUTMR. The GC rejected the first and second pleas but upheld the action on the basis of the third and fourth pleas. It found that the signs were not similar. The opponent filed an appeal before the CJEU. The CJ upheld the appeal and set aside the GC's first judgment of the GC; it found that there had



been a contradiction in the GC's reasoning that amounted to a failure to state reasons. There was no need to rule again on the first and second plea, which had already been rejected by the GC. **Reputation:** it was the conflicting nature of the goods covered by the marks at issue that made it possible to hold that there was a 'risk of tarnishment' of the image associated with the earlier mark, which is registered in respect of cosmetic products. As the BoA had correctly found, the fact that the mark applied for was to be used for cleaning products strengthened the likelihood that the relevant public would make a negative association with the earlier marks, which had a reputation for cosmetics, thinking that the goods marketed under the earlier marks contained substances that were toxic or a danger to health (paras 69-92).

♦[C-471/16 P](#); **MEISSEN / Meissen et al.**; *Staatliche Porzellan-Manufaktur Meissen GmbH v EUIPO*; Judgment of 26 July 2017; EU:C:2017:602; Language of the case: DE. An opposition was filed against an EUTM application applied for in respect of goods in Classes 11, 19 and 20. The opposition was based on earlier marks registered for goods and services in Classes 3, 8, 11, 14, 16, 18, 19, 21, 24, 28, 29, 30, 32, 33, 34, 36, 41, 42 and 43. The grounds of opposition were Article 8(1)(b) and Article 8(5) EUTMR. Upon request, the opponent had to provide PoU for some of the earlier marks. The OD partly upheld the opposition, namely for the goods in Classes 11 and 19 and rejected it with regard to the goods in Class 20. Upon appeal by both parties, the BoA annulled the OD's decision insofar as the OD had upheld the opposition for Classes 11 and 19. The BoA found that there was no LOC between any of the marks. With regard to Article 8(5) EUTMR, the BoA held that neither a link between the signs nor a risk of injury had been proven by the opponent. The opponent filed an action before the GC, based on an alleged infringement of Article 8(1)(b), Article 8(5) and Article 47(2) and (3) EUTMR. The GC dismissed the appeal (14/06/2016, [T-789/14](#), **MEISSEN / MEISSEN** (fig.), EU:T:2016:349). The opponent/appellant filed an appeal before the CJ, raising, inter alia, the following pleas in law: (i) infringement of Article 47(2) of the Charter of Fundamental Rights of the European Union ('Right to an effective remedy and to a fair trial'), because the GC had not taken into account supplementary documents submitted for the first time before the GC to support the prior evidence and arguments of the appellant; (ii) infringement of Article 18(1) EUTMR, because the GC had denied genuine use of the earlier marks for certain goods despite the fact that the documentation submitted clearly proved use for these goods, and had therefore distorted the facts; and (iii) infringement of Article 8(5) EUTMR. The GC, by stressing that the goods at issue were 'so different' that the relevant public would not establish a link between the marks, had erroneously insinuated that the application of Article 8(5) EUTMR was dependent on similarity between the goods. The CJ dismissed the appeal. **Reputation:** the existence of a 'link' between the marks had to be examined taking into account all relevant circumstances of the case, including, inter alia, the nature of the goods and services in question as well as the degree of proximity between the goods and services. In the case concerned, the GC had not presumed similarity between the goods to be a prerequisite for the application of Article 8(5) EUTMR, but had rather examined the proximity between the goods as one of the acknowledged factors for establishing a possible 'link' between the marks. Therefore, it could not be inferred from the contested judgment that the GC had advocated a similarity between the goods as an obligatory precondition for the application of Article 8(5) EUTMR (paras 47-63). Based on the foregoing, the appeal was dismissed.

♦[T-86/16](#); **ANA DE ALTUN / ANNA et al.**; *Codorníu, S.A. v EUIPO*; Judgment of 18 September 2017; EU:T:2017:627; Language of the case: ES. The applicant sought to register the figurative mark ANA DE ALTÚN as an EUTM for goods in Class 33. An opposition based on, inter alia, the earlier Spanish figurative mark ANNA, registered for goods in Class 33, was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The OD



upheld the opposition insofar as it considered that there would be a LOC. The BoA upheld the applicant's appeal. It found that there would be no LOC between the contested mark and the Spanish earlier trade mark ANNA, even for identical goods. It did not assess the alleged enhanced distinctiveness of the earlier trade mark as it considered the signs dissimilar. The BoA did not assess Article 8(1)(b) EUTMR with regard to the other earlier rights **ANNA DE CODORNIU** as it considered that they were even less similar to the examined earlier right. Finally, it considered that there was no link between the signs within the meaning of Article 8(5) EUTMR. The opponent filed an action before the GC, relying on three pleas in law: (i) infringement of Articles 94 and 95 EUTMR, (ii) infringement of Article 8(1)(b) EUTMR, and (iii) infringement of Article 8(5) EUTMR. The GC upheld the appeal. It found that the BoA methodology for assessing the LOC had been based on the wrong premise that the signs were globally different. As a result, the BoA had incorrectly considered that the evidence of enhanced distinctiveness and reputation did not need to be examined. Finally, the GC considered that the decision lacked reasoning regarding the absence of a LOC with regard to other earlier trade marks that the BoA had considered less similar to the earlier Spanish mark being assessed. **Reputation:** in line with its conclusions on the second plea, the GC considered that the BoA had incorrectly found the signs not sufficiently similar for the consumers to establish an association between them and, consequently, for Article 8(5) EUTMR to apply (para. 79).

♦[T-315/16](#); **Butterfly / Butterfly**; *Tamasu Butterfly Europa GmbH v EUIPO*; Judgment of 19 September 2017; EU:T:2017:629; Language of the case: DE. The intervener sought to register the word mark **Butterfly** as an EUTM for goods and services in Classes 28 and 41. An opposition based on the earlier EUTM (word mark) **Butterfly**, registered for goods and services in Classes 25 and 28, was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The opposition was also based, pursuant to Article 8(4) EUTMR, on the trade name **Butterfly**. The OD dismissed the opposition and the applicant lodged an appeal. The BoA dismissed the appeal insofar as (i) the goods and services were neither similar nor identical; (ii) the applicant had not proven the reputation of its earlier mark; and (iii) the applicant had not proven that the trade name had been used in the course of trade of more than mere local significance. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 8(1)(b) EUTMR, (ii) infringement of Article 8(5) EUTMR, and (iii) infringement of Article 8(4) EUTMR. **Reputation:** the GC noted that, in the documents provided by the applicant, the earlier mark did not appear on its own, but in association with a figurative element (para. 54). Furthermore, many of the internet extracts showing the mark were aimed at a specialised public, not the general public (para. 55). The GC therefore upheld the BoA's finding that the evidence was not sufficient to prove the reputation of the mark in Germany for sports equipment and other goods in Class 28 (para. 63). As regards the documents that the applicant claimed had not duly been taken into account by the BoA, the GC restated that the BoA was not obliged to mention in its reasoning all the evidence presented by the parties (para. 70). Furthermore, the documents that referred to the trade name were not suitable for proving the reputation of a mark, as the aim of a trade name was to designate a business, not its goods and services (para. 73).

♦[C-673/15 P](#) to [C-676/15 P](#) (joined cases); **Darjeeling / DARJEELING et al.**; *The Tea Board v EUIPO*; Judgment of 20 September 2017; EU:C:2017:702, Language of the case: EN. The applicant sought to register the figurative marks **Darjeeling** as EUTMs for goods and services in Classes 25, 35 and 38. An opposition based on the earlier EU collective marks **DARJEELING**, registered for goods in Class 30, was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The OD dismissed the oppositions. The BoA dismissed the appeals and upheld the OD's decisions. The applicant filed four actions before the GC, relying on two pleas in law: (i) infringement of Article 8(1)(b) and (ii) infringement of Article 8(5) EUTMR.



The GC rejected the first plea as unfounded and upheld the second plea in part. The owner of the earlier right/the opponent filed an appeal before the CJ, alleging infringement of Article 8(1)(b) and Article 8(5) EUTMR. The EUTM applicant filed a cross-appeal before the CJ, alleging, first, a distortion of the respective functions of trade marks and PGIs and, second, inconsistency in the GC's reasoning and an error of law in the application of Article 8(5) EUTMR. **The main appeal:** regarding the first ground of appeal, the CJ stated that the GC had not erred in law when it held that the essential function of an EU collective mark was to distinguish the goods or services of the members of the association that was the proprietor of the trade mark from those of other undertakings, thereby guaranteeing their collective commercial origin (para. 57), and not to distinguish those goods according to their geographical origin (para. 63). With regard to the second ground of appeal, the appellant had failed to substantiate the complaint of distortion of the facts (para. 70). Furthermore, as regards the argument that the qualities conveyed by the word element 'darjeeling' were capable of being transferred to the whole body of services for which registration was sought, this actually aimed at obtaining an assessment of the facts from the CJ and consequently had to be rejected as inadmissible (para. 72). **The cross-appeal:** the CJ found that the GC had not adopted a position on whether proof of the reputation of the earlier trade marks had been adduced, or on whether, for the purpose of establishing such proof, the reputation enjoyed by the name 'Darjeeling' as a geographical indication for tea could be transferred to the same sign protected as a collective trade mark for identical goods. Therefore, the first part of the single ground of appeal was based on a misreading of the judgments under appeal and was rejected as unfounded (paras 80-81). Additionally, the GC had not contradicted itself when it held, on the one hand, that the consumer of goods covered by the earlier trade marks would not be led to believe that the goods and services covered by the trade marks applied for originated from the Darjeeling region, while considering, on the other hand, that the consumer of the goods and services covered by the trade marks applied for by the intervener could be attracted by the values and positive qualities connected with that region (para. 93). Therefore, the second part of the single ground of appeal was rejected and the cross-appeal was dismissed in its entirety (para. 94).


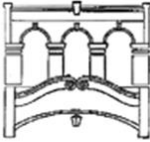

◆ [T-411/15](#); **GAPPOL / GAP et al.**; *PP Gappol Marzena Porczyńska v EUIPO*; Judgment of 4 October 2017; EU:T:2017:689; Language of the case: EN. The applicant sought to register the mark GAPPOL as an EUTM for goods and services in Classes 20 and 25. An opposition based on the earlier word mark GAP, registered for goods and services in Class 25, was filed pursuant to Article 8(1)(b) and 8(5) EUTMR. The OD partly upheld the opposition for goods in Class 25 (LOC) and rejected it for goods in Class 20. The BoA dismissed the applicant's appeal and upheld the opponent's cross-appeal for *furniture* in Class 20. It found that there was a LOC for the identical goods in Class 25 and that use of the contested mark for *furniture* in Class 20 took unfair advantage of the distinctiveness of the earlier mark. The applicant filed an action before the GC, relying on five pleas in law: (i) infringement of Article 67 and Article 71(1) EUTMR, (ii) infringement of Article 94 EUTMR and Rule 50(2)(h) of Implementing Regulation (EC) No 2868/95, (iii) infringement of Article 95 EUTMR, (iv) infringement of Article 8(1)(b) EUTMR, and (v) infringement of Article 8(5) and Article 9(1)(c) EUTMR and Rule 19(2)(c) of Implementing Regulation (EC) No 2868/95. The GC partly upheld the appeal. **LOC:** the public had an average degree of attention. The goods were identical. The signs were visually and aurally similar to (at least) an average degree and had a certain conceptual similarity for some of the public. There was a LOC (paras 38-109). There had been no breach of duty to state reasons (paras 110-138). **Reputation:** the GC accorded a certain probative value to the documents submitted by the opponent in order to prove the reputation of the earlier mark (paras 162-167). The BoA had correctly upheld the OD's finding that the earlier mark had a reputation. However, the BoA had not established the strength of such reputation. There was a very limited degree of proximity between



furniture in Class 20 and clothing, footwear, headgear in Class 25. The BoA could have upheld the opposition on the basis of Article 8(5) EUTMR only if it had found that the earlier mark had a sufficiently strong reputation or a sufficiently high degree of distinctiveness. As the strength of reputation had not been established, the BoA had infringed Article 8(5) EUTMR.

♦♦[T-754/16](#); **CC / O**; *Oakley, Inc. v EUIPO*; Judgment of 8 November 2017; EU:T:2017:786; Language of the case: ES. The applicant sought to register the figurative mark CC as an EUTM for goods in Classes 9, 18 and 25. An opposition based on the earlier figurative mark O registered for goods in the same classes was filed pursuant to Article 8(1)(b) and, regarding the products in Class 9, Article 8(5) EUTMR. The OD dismissed the opposition and the opponent appealed the decision. The BoA dismissed the opponent’s appeal. It found that the signs were dissimilar insofar as they had no visual or conceptual similarity, while an aural comparison was not relevant. There was therefore no need to examine enhanced distinctiveness. It also found that there was not sufficient evidence to determine the reputation of the earlier sign and that the public would not make a connection between the signs. The opponent filed an action before the GC, relying on two pleas in law: (i) infringement of Article 8(1)(b) EUTMR and (ii) infringement of Article 8(5) EUTMR. **Reputation of the earlier mark:** insofar as the evidence submitted to prove the reputation of the earlier mark could be considered to actually refer to that mark, it was, even considered as a whole, insufficient. It did not provide direct information on relevant data and, although it showed that the mark had enjoyed a certain visibility, could not lead to the certain conclusion that the mark was well known for the general public. The renown of a mark could not simply be assumed on the basis of fragmentary and insufficient data (para. 112).

♦[T-120/16](#); **BURLINGTON / BURLINGTON ARCADE et al.**; *Tulliallan Burlington Ltd v EUIPO*; Judgment of 6 December 2017; EU:T:2017:873; Language of the case: EN.


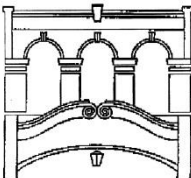
| EUTM application | Earlier trade marks |
|---|--|
|  | <p data-bbox="962 1368 1294 1447" style="text-align: center;">BURLINGTON BURLINGTON ARCADE</p> <div style="display: flex; justify-content: space-around; align-items: center;">   </div> <p data-bbox="820 1675 1318 1753" style="text-align: center;">BURLINGTON ARCADE BURLINGTON ARCADE</p> |

An application was filed for the figurative mark represented above to be registered as an EUTM for goods in Classes 3, 14, 18 and 25. The opponent filed an opposition against the goods in Classes 3, 14 and 18 on the basis of, inter alia, the earlier UK word mark **BURLINGTON** (Classes 35 and 36), the earlier UK word mark **BURLINGTON ARCADE** (Classes 35, 36 and 41) and the UK and EU figurative mark represented above covering, for the EUTM, *advertising and promotion services and information services relating thereto*; the



bringing together for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from a range of general merchandise retail stores in Class 35, rental of shops; leasing of, or management of real estate; leasing of, or space between or within, buildings; real estate management services; information services relating to the rental of shops in Class 36, and entertainment services; provision of live entertainment in Class 41. The opposition was filed pursuant to Article 8(1)(b) and Article 8(4) and (5) EUTMR. The OD fully upheld the opposition, examining only Article 8(5) EUTMR on the basis of the earlier figurative EUTM. The EUTM applicant filed an appeal. The BoA found the appeal to be well founded and annulled the OD decision. With regard to Article 8(5) EUTMR, it held that the reputation of the earlier marks had been proven in the relevant territory for the services in Classes 35 and 36, with the exception of the services of *the bringing together for the benefit of others, a variety of goods, enabling customers to conveniently ... purchase those goods from a range of general merchandise retail stores* in Class 35. However, the BoA denied any link between the conflicting marks and, irrespective of this, held that the applicant had not submitted a consistent line of argument with regard to Article 8(5) EUTMR. Regarding Article 8(4) EUTMR, the BoA held that the applicant had not demonstrated that the prerequisites for establishing misrepresentation and damage vis-à-vis the target public had been met. Finally, with regard to Article 8(1)(b) EUTMR, it was held that the goods and services at issue were dissimilar and that, for this reason alone, irrespective moreover of the similarity of the marks concerned, a LOC was ruled out. The opponent filed an action before the GC, relying on three pleas in law: (i) infringement of Article 8(5) EUTMR and breach of procedural rules; (ii) breach of the obligation to state reasons, infringement of the right to be heard and infringement of Article 8(4) EUTMR; and (iii) infringement of Article 8(1)(b) EUTMR. **Regarding the first plea in law:** the signs at issue were similar to an average degree due to their common word element ‘burlington’ (para. 24). Having regard to the wording of Class 35, the concept of retail services also included a shopping arcade’s services in relation to sales (para. 34). The applicant’s reference to the ‘near uniqueness’ of its earlier trade marks and their ‘significant and exclusive’ reputation did not provide any specific evidence that use of the contested mark would make its earlier marks less attractive. The same applied to the fact that another economic agent might be authorised to use a mark including the word ‘burlington’ for goods similar to those on sale in the applicant’s London arcade (paras 44-45).



♦[T-121/16](#); **BURLINGTON THE ORIGINAL / BURLINGTON ARCADE et al.**; *Tulliallan Burlington Ltd v EUIPO*; Judgment of 6 December 2017; EU:T:2017:872; Language of the case: EN.

| EUTM application | Earlier trade marks |
|---|---|
|  | <p data-bbox="916 1659 1246 1731">BURLINGTON BURLINGTON ARCADE</p>  <p data-bbox="916 1928 1246 2029">BURLINGTON ARCADE</p> |



An application was filed to register the figurative mark represented above as an EUTM for goods in Classes 3, 14, 18 and 25. An opposition was filed, pursuant to Article 8(1)(b) and Article 8(4) and (5) EUTMR, against the goods in Classes 3, 14 and 18, based on, inter alia, the earlier UK word mark **BURLINGTON** (Classes 35 and 36), the earlier UK word mark **BURLINGTON ARCADE** (Classes 35, 36 and 41) and the earlier EU and UK figurative mark represented below (Classes 35, 36 and 41). The OD fully upheld the opposition, examining only Article 8(5) EUTMR on the basis of the earlier figurative EUTM. An appeal was filed against the OD's decision. The BoA found the appeal to be well founded and annulled the OD decision. With regard to Article 8(5) EUTMR, it held that the reputation of the earlier marks had been proven in the relevant territory for the services in Classes 35 and 36, with the exception of the service of *the bringing together for the benefit of others, a variety of goods, enabling customers to conveniently ... purchase those goods from a range of general merchandise retail stores* in Class 35. However, the BoA denied any link between the conflicting marks and, irrespective of this held that the applicant had not submitted a consistent line of argument with regard to Article 8(5) EUTMR. Regarding Article 8(4) EUTMR, the BoA held that the applicant had not demonstrated that the prerequisites for establishing misrepresentation and damage vis-à-vis the target public had been met. Finally, as regards Article 8(1)(b) EUTMR, no LOC was found, irrespective of the similarity of the marks, as the goods and services were dissimilar. The opponent filed an action before the GC, relying on three pleas in law: (i) infringement of Article 8(5) EUTMR, a procedural defect and breach of the procedural rules; (ii) breach of the obligation to state reasons, infringement of the right to be heard and infringement of Article 8(4) EUTMR; and (iii) infringement of Article 8(1)(b) EUTMR. **Regarding the first plea in law:** the signs at issue were similar to an average degree due to their common word element 'burlington' (para. 24). Having regard to the wording of Class 35, the concept of retail services also included a shopping arcade's services in relation to sales (para. 34). The applicant's reference to the 'near uniqueness' of its earlier trade marks and their 'significant and exclusive' reputation did not provide any specific evidence that use of the contested mark would make its earlier marks less attractive. The same applied to the fact that another economic agent might be authorised to use a mark including the word 'burlington' for goods similar to those on sale in the applicant's London arcade (paras 44-45).

♦[T-122/16](#); **Burlington / BURLINGTON ARCADE**; *Tulliallan Burlington Ltd v EUIPO*; Judgment of 6 December 2017; EU:T:2017:871; Language of the case: EN.

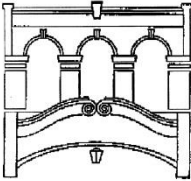
| IR designating EU | Earlier trade mark |
|---|--|
|  |  |

The intervener filed an application for protection in the EU of the figurative mark represented above for goods in Classes 3, 14, 18 and 25. The applicant filed a notice of opposition for the goods in Classes 3, 14 and 18. The opposition was based on the word mark **BURLINGTON**, designating services in Classes 35 and 36; on the word mark **BURLINGTON ARCADE**,



designating services in Classes 35, 36 and 41; and on the figurative mark reproduced above, designating services in Classes 35, 36 and 41. The opposition was filed pursuant to Article 8(1)(b) and Article 8(4) and (5) EUTMR. The OD fully upheld the opposition, examining only Article 8(5) EUTMR on the basis of the earlier figurative EUTM. An appeal was filed against the OD's decision. The BoA found the appeal to be well founded and annulled the OD decision. With regard to Article 8(5) EUTMR, it held that the reputation of the earlier marks had been proven in the relevant territory for the services in Classes 35 and 36, with the exception of the service of *the bringing together for the benefit of others, a variety of goods, enabling customers to conveniently ... purchase those goods from a range of general merchandise retail stores* in Class 35. However, the BoA denied any link between the conflicting marks and, irrespective of this, held that the applicant had not submitted a consistent line of argument with regard to Article 8(5) EUTMR. Regarding Article 8(4) EUTMR, the BoA held that the applicant had not demonstrated that the prerequisites for establishing misrepresentation and damage vis-à-vis the target public had been met. Finally, as regards Article 8(1)(b) EUTMR, no LOC was found, irrespective of the similarity of the marks, as the goods and services were dissimilar. The opponent filed an action before the GC, relying on three pleas in law: (i) infringement of Article 8(5) EUTMR, a procedural defect and breach of the procedural rules; (ii) breach of the obligation to state reasons, infringement of the right to be heard and infringement of Article 8(4) EUTMR; and (iii) infringement of Article 8(1)(b) EUTMR. **Regarding the first plea in law:** the signs at issue were similar to an average degree due to their common word element 'burlington' (para. 24). Having regard to the wording of Class 35, the concept of retail services also included a shopping arcade's services in relation to sales (para. 34). The applicant's reference to the 'near uniqueness' of its earlier trade marks and their 'significant and exclusive' reputation did not provide any specific evidence that use of the contested mark would make its earlier marks less attractive. The same applied to the fact that another economic agent might be authorised to use a mark including the word 'burlington' for goods similar to those on sale in the applicant's London arcade (paras 44-45).

♦[T-123/16](#); **BURLINGTON / BURLINGTON ARCADE et al.**; *Tulliallan Burlington Ltd v EUIPO*; Judgment of 6 December 2017; EU:T:2017:870; Language of the case: EN.



| IR designating EU | Earlier trade mark |
|-------------------|--|
| BURLINGTON |  BURLINGTON ARCADE |

The intervener filed an application for protection in the EU of the figurative mark **BURLINGTON** for goods in Classes 3, 14, 18 and 25. The applicant filed a notice of opposition for the goods in Classes 3, 14 and 18. The opposition was based on the word mark **BURLINGTON**, designating services in Classes 35 and 36; on the word mark **BURLINGTON ARCADE**, designating services in Classes 35, 36 and 41; and on the figurative mark **BURLINGTON ARCADE**, designating services in Classes 35, 36 and 41. The opposition was filed pursuant to Article 8(1)(b) and Article 8(4) and (5) EUTMR. The OD



fully upheld the opposition, examining only Article 8(5) EUTMR on the basis of the earlier figurative EUTM. An appeal was filed against the OD’s decision. The BoA found the appeal to be well founded and annulled the OD decision. With regard to Article 8(5) EUTMR, it held that the reputation of the earlier marks had been proven in the relevant territory for the services in Classes 35 and 36, with the exception of the service of *the bringing together for the benefit of others, a variety of goods, enabling customers to conveniently ... purchase those goods from a range of general merchandise retail stores* in Class 35. However, the BoA denied any link between the conflicting marks and, irrespective of this, held that the applicant had not submitted a consistent line of argument with regard to Article 8(5) EUTMR. Regarding Article 8(4) EUTMR, the BoA held that the applicant had not demonstrated that the prerequisites for establishing misrepresentation and damage vis-à-vis the target public had been met. Finally, as regards Article 8(1)(b) EUTMR, no LOC was found, irrespective of the similarity of the marks, as the goods and services were dissimilar. The opponent filed an action before the GC, relying on three pleas in law: (i) infringement of Article 8(5) EUTMR, a procedural defect and breach of the procedural rules; (ii) breach of the obligation to state reasons, infringement of the right to be heard and infringement of Article 8(4) EUTMR; and (iii) infringement of Article 8(1)(b) EUTMR. **Regarding the first plea in law:** the signs at issue were similar to an average degree due to their common word element ‘burlington’ (para. 24). Having regard to the wording of Class 35, the concept of retail services also included a shopping arcade’s services in relation to sales (para. 34). The applicant’s reference to the ‘near uniqueness’ of its earlier trade marks and their ‘significant and exclusive’ reputation did not provide any specific evidence that use of the contested mark would make its earlier marks less attractive. The same applied to the fact that another economic agent might be authorised to use a mark including the word ‘burlington’ for goods similar to those on sale in the applicant’s London arcade (paras 44-45).

♦ [T-61/16](#); **MASTER / COCA-COLA et al.**; *The Coca-Cola Company v EUIPO*; Judgment of 7 December 2017; EU:T:2017:877; Language of the case EN.

| EUTM application | Earlier trade marks |
|---|--|
|  |  |

The applicant sought to register the figurative mark represented above as an EUTM for goods in Classes 29, 39 and 32. An opposition based on the earlier figurative marks registered, inter alia, for goods in Class 32 was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The OD dismissed the opposition. The opponent appealed against the OD’s decision and the BoA dismissed the appeal. It found that the signs were not all similar and that, despite the identity of the goods, there was no LOC. It also disregarded the evidence adduced by the opponent, since it claimed that only use of the mark applied for could be taken into account. The applicant filed an action before the GC on the grounds of Article 8(5) EUTMR. The GC annulled the BoA’s first decision and requested the BoA to take into consideration the evidence regarding commercial use of the contested mark. It referred the case to the BoA for examination, which again dismissed the opponent’s appeal. The



opponent filed an action before the GC, relying on two pleas in law: (i) infringement of Article 8(5) EUTMR and (ii) infringement of Article 72(6) EUTMR. **Use of a sign in the composite mark ‘MARKET COLA’:** since the term ‘master’ was the distinctive and dominant element of the Master Cola mark used on ‘www.mastercola.com’, in particular for drinks, the element ‘master’ continued to be perceived as an indication of the origin of the goods. Therefore, use of that term within the composite trade mark **Master Cola** did indeed constitute use of the trade mark Master as such, and the evidence regarding its commercial use had correctly been taken into account (para. 76). **Territoriality and use in third countries:** there was no derogation from the principle of territoriality, since the applicant relied on EUTMs, namely the four earlier Coca-Cola marks, and not on marks that were well-known in non-EU states but not registered in the EU (para. 85) The principle of territoriality did not preclude taking into consideration evidence relating to the actual commercial use of the contested mark **Master** (in combination with the term ‘cola’) in Syria and the Middle East, such as excerpts from the website ‘www.mastercola.com’, which is written mainly in Arabic. These might serve for establishing whether use of that mark in the EU would take unfair advantage of the reputation of the four earlier Coca-Cola EUTMs (para. 89). **Risk of free-riding:** actual use of the mark applied for anywhere in the world might lead to a logical inference that there was a serious risk that the contested mark would be used in the same way within the EU as in the non-EU countries (para. 104). The fact that presentational features (namely the red label on which the term ‘Master Cola’ is written in white, the characteristic shape of the container, the red cap and the Spenserian script) were currently used on the applicant’s website might reinforce the logical inference that there was a risk of free-riding and that an amended form of those features could be used in the future on that website in order to target consumers in the EU (para. 105). The applicant referred at length to the image of the four earlier Coca-Cola marks. The evidence submitted, in particular excerpts from a Superbrands study, made it possible to establish clearly what Coca-Cola stood for, and therefore, the image liable to be transferred from the earlier marks to the contested mark (paras 114 and 119).

♦ [T-249/15](#); **QUILAPAYÚN / QUILAPAYÚN**; *JT v EUIPO*; Judgment of 11 December 2017; EU:T:2017:885, Language of the case. ES. Registration as an EUTM for goods and services in Classes 9, 16 and 41 was sought for the figurative sign **QUILAPAYÚN**. An opposition based on the earlier well-known figurative mark, French trade mark and international trade mark **QUILAPAYÚN**, registered for goods and services in Class 41, was filed pursuant to Article 8(1)(a) and (b) and Article 46 EUTMR. The OD partly upheld the opposition insofar as it found a LOC, given the identity of the signs and the similarity or identity of the goods and services covered (in Class 9: *magnetic data carriers, recording discs* and in Class 41: *providing of training; entertainment; sporting and cultural activities*). The BoA upheld the appeal filed, annulling the OD’s decision. It also found that the opponent had not presented evidence of being the ‘real proprietor’ of the previous well-known mark; proprietorship was also claimed by the other parties to the proceedings. Finally, it concluded that it had no competence to decide who met the conditions of being proprietor of the unregistered well-known mark; this was up to the national court to decide. The opponent filed an action before the GC, relying on a single plea in law: the erroneous interpretation and application of Article 8(2)(c) EUTMR in conjunction with Article 6*bis* of the Paris Convention. **Co-proprietorship and entitlement for opposition:** the BoA had erred in law insofar as it had required evidence of the opponent being the sole proprietor of the previous mark without assessing whether co-proprietorship was sufficient entitlement for filing the opposition (para. 50). Article 2(1) EUTMDR does not prevent the earlier mark from having several proprietors. Should sole proprietorship be necessary, then none of the co-proprietors of the trade mark could individually oppose registration of the contested sign on behalf of a third party (paras 47-48). The opponent did not maintain for the first time before the GC that he



was co-proprietor of the previous mark: he had not denied that the previous well-known mark could have several proprietors, as he had stated that, in the absence of any explicit decision regarding co-proprietorship, two different musical groups had been set up, both claiming the contested sign (para. 51). **The request to refuse registration:** as for the request for the GC to refuse registration, it must be noted that the GC's competence to alter decisions does not have the effect of conferring on the GC the power to substitute its own reasoning for that of a BoA or to assess issues on which the BoA has not yet adopted a position. Exercise of the power to alter decisions must therefore, in principle, be limited to situations in which the GC, after reviewing the assessment made by the BoA, is in a position to determine, on the basis of the matters of fact and of law as established, what decision the BoA was obliged to take. Therefore, it is not up to the GC to examine the arguments regarding the acquisition of rights by the applicant in the earlier unregistered mark (para. 52).

F. Other issues

♦[T-225/15](#); **medialbo / MediaLB**; *QuaMa Quality Management GmbH v EUIPO*; Judgment of 17 January 2017; EU:T:2017:10; Language of the case: DE. An opposition based on the earlier EUTM **MediaLB** (Classes 9, 41 and 42) was filed pursuant to Article 8(1)(b) EUTMR against the EUTM application **medialbo** (Classes 9, 37 and 41). The notice of opposition was accompanied by an application requesting the 'change of name and address' of the owner of the earlier mark. The Office informed the opponent (i.e. the other party before the GC) that it appeared that what the opponent actually wanted was a 'transfer of ownership' and not a 'change of name and address'. Following this communication from the Office, the opponent indeed requested a transfer, this time using the correct form. The transfer of ownership was registered and the Office rejected the original application for a 'change of name and address'. The OD partly rejected and partly upheld the opposition. Both parties appealed. The BoA rejected both appeals. With regard to Rule 17(4) of Implementing Regulation (EC) No 2868/95, infringement of which had been claimed by the EUTM applicant (i.e. the applicant before the GC), the BoA stated that it was sufficient if a transfer of ownership was requested the same day as the opposition was filed. The opponent's request for a 'change of name and address' had been seen as an obvious request for a 'transfer of ownership' and had been rectified in the course of the proceedings (*falsa demonstratio non nocet*). Therefore, the required identity of opponent and owner of the earlier mark was deemed given at all times. With regard to Article 8(1)(b) EUTMR, the BoA confirmed the OD's finding of a LOC for identical and similar goods. The applicant filed an action before the GC, raising two pleas in law: (i) infringement of Article 46(1) EUTMR and (ii) infringement of Article 8(1)(b) EUTMR. As far as an infringement of **Article 46 EUTMR** was claimed, it was undisputed that the other party had filed its application on the same day as the notice of opposition and that only proof of transfer had been missing (Rule 31(5) of Implementing Regulation (EC) No 2868/95). Because of this and the discrepancy between the wording 'application for a change of name and address' and the content of the actual application, the Office had invited the other party to fill in the appropriate form. The other party had then filled in the correct form, signed by the same owner of both companies — the previous owner and the new one. This remedied the deficiencies of the original application for transfer of ownership. The Office could not simply rely on the literal wording of the application, without also taking account of the content of the application. It was clear from the circumstances of the case that the other party's actual intention had been to file an application for transfer of ownership and not a 'change of name and address' (paras 30-41). Therefore, the Office had



interpreted the original application correctly as an application for 'transfer of ownership' and there had been no infringement of Article 46 EUTMR (paras 30-42).



IV. Proof of Use (PoU)

♦[T-258/08](#); **DIACOR / Diacol PORTUGAL**; *Matthias Rath v EUIPO*; Judgment of 24 January 2017; EU:T:2017:22; Language of the case: EN. The existence of a LOC between the two marks in this case had been established by the OD and confirmed by the BoA and the GC. The goods at issue were *antitussive medicines versus food supplements, dietetic supplements, vitamins, minerals*. With regard to the succession of laws and the substantive law applicable, the GC held that, in view of the time at which the events occurred, this case was still governed by Council Regulation (EC) No 40/94, at least as regards provisions that were not strictly procedural (para. 15). The GC confirmed that the BoA had been right not to oblige the opponent to submit translations in the language of the proceedings (EN) of the evidence of use in Portuguese: ‘in order to be able actually to exercise his rights of defence with regard to that evidence, it is not necessary for the applicant to be able to understand fully all the details in that evidence. It is sufficient, in that regard, for a person who has a knowledge of the language of the proceedings before EUIPO to be able to identify and understand the relevant information in the documents submitted as proof of use’ (para. 21). The GC considered that the fact that a product bearing the name ‘DIACOL’ was referred to throughout the relevant period in an encyclopedia listing pharmaceutical products marketed on the Portuguese market did not in itself prove that the mark affixed to that product had been put to genuine use in Portugal during the relevant period. However, it might be an indication of such genuine use, in particular where there was additional evidence, as in this case (para. 40).

[T-686/15](#); **CREMCAFFÉ BY JULIUS MEINL / CAFÉ CREM**; *Marcas Costa Brava, SL v EUIPO*; Judgment of 2 February 2017; EU:T:2017:53; Language of the case: EN. The owner of the earlier EUTM **café crem**, registered for goods in Class 30 (the applicant before the GC), filed an opposition against the figurative EUTM application (for goods in Class 30) **CREMCAFFÉ BY JULIUS MEINL** pursuant to Article 8(1)(b) EUTMR. Upon request of the owner of the EUTM application (the other party before the GC), the applicant provided evidence of genuine use of its earlier mark. The OD acknowledged genuine use of the earlier mark, found a LOC between the marks at issue and therefore upheld the opposition in its entirety. The BoA found the other party’s appeal to be well founded, as it deemed the evidence submitted insufficient to establish genuine use of the earlier mark. It annulled the OD decision without examining the LOC. The applicant filed an action before the GC. With regard to the territorial scope of genuine use, the GC confirmed the BoA’s finding that use had only been established in two of the four provinces of Catalonia (Spain), namely Tarragona and Barcelona. Merely providing a copy of an extract from the central trade register of Spain to prove the place of establishment of the company in another province (Girona) or providing a screenshot of a website with the postal address of a distributor in another province (Lleida) was not sufficient evidence to establish use in those provinces (paras 36-40). The BoA had correctly not taken into account sales of products documented in **invoices** that did not display the trade mark but solely referred to the acronym ‘CC’, as it had not been established unambiguously that this acronym indeed referred to the earlier mark. Furthermore, it had not been shown that all of the goods sold under the mark **café crem** corresponded to those for which the earlier mark was registered (paras 43-48). Even if it were assumed that the sums indicated on several **affidavits** — which mentioned only global sums, not broken down into products or product categories and not corroborated by other documents, such as statistical tables, annual reports, accounting/balance sheet items, etc. — were correct, it could not be ruled out, given the diversity of the marks mentioned in the invoices, that the sums indicated related to goods other than those sold under the earlier mark. The BoA had, therefore, correctly attributed little evidential value to the affidavits,



which did not make it possible to determine the extent of use of the earlier mark with regard to the goods for which the mark was registered (paras 49-55). The GC stressed that use of the earlier mark on **promotional and advertising material** (which, in the case in question was mostly undated or predated the relevant period) could not be proven simply by producing copies of that material. It also had to be demonstrated that that material, regardless of its nature, had been successfully distributed to the relevant public (paras 56-63). Overall, the GC found that, in view of the material submitted, taken as a whole, the BoA had not erred in finding that genuine use of the earlier mark had not been proven (para. 67). Based on the foregoing, the appeal was dismissed.

[T-687/15](#); **Cremcaffé by Julius Meinl / café crem**; *Marcas Costa Brava, SL v EUIPO*; Judgment of 2 February 2017; EU:T:2016:37; Language of the case: EN. The owner of the earlier EUTM **café crem**, registered for goods in Class 30 (the applicant before the GC), filed an opposition against the figurative EUTM application (for goods in Class 30) **Cremcaffé by Julius Meinl** pursuant to Article 8(1)(b) EUTMR. Upon request of the owner of the EUTM application (the other party before the GC), the applicant provided evidence of genuine use of its earlier mark. The OD acknowledged genuine use of the earlier mark, found a LOC between the marks at issue and therefore upheld the opposition in its entirety. The BoA found the other party's appeal to be well founded, as it deemed the evidence submitted insufficient to establish genuine use of the earlier mark. It annulled the OD decision without examining the LOC. The applicant filed an action before the GC. With regard to the territorial scope of genuine use, the GC confirmed the BoA's finding that use had only been established in two of the four provinces of Catalonia (Spain), namely Tarragona and Barcelona. Merely providing a copy of an extract from the central trade register of Spain to prove the place of establishment of the company in another province (Girona) or providing a screenshot of a website with the postal address of a distributor in another province (Lleida) was not sufficient evidence to establish use in those provinces (paras 37-40). The BoA had correctly not taken into account sales of products documented in **invoices** that did not display the trade mark but solely referred to the acronym 'CC', as it had not been established unambiguously that this acronym indeed referred to the earlier mark. Furthermore, it had not been shown that all of the goods sold under the mark **café crem** corresponded to those for which the earlier mark was registered (paras 43-48). Even if it were assumed that the sums indicated on several **affidavits** — which mentioned only global sums, not broken down into products or product categories and not corroborated by other documents, such as statistical tables, annual reports, accounting/balance sheet items, etc. — were correct, it could not be ruled out, given the diversity of the marks mentioned in the invoices, that the sums indicated related to goods other than those sold under the earlier mark. The BoA had therefore correctly attributed little evidential value to the affidavits, which did not make it possible to determine the extent of use of the earlier mark with regard to the goods for which the mark was registered (paras 49-55). The GC stressed that use of the earlier mark on **promotional and advertising material** (which, in the case in question, was mostly undated or predated the relevant period), could not be proven simply by producing copies of that material. It also had to be demonstrated that that material, regardless of its nature, had been successfully distributed to the relevant public (paras 56- 63). Overall, the GC found that, in view of the material submitted, taken as a whole, the BoA had not erred in finding that genuine use of the earlier mark had not been proven (para. 67). Based on the foregoing, the appeal was dismissed.

[T-689/15](#); **Cremcaffé by Julius Meinl / café crem**; *Marcas Costa Brava, SL v EUIPO*; Judgment of 2 February 2017; EU:T:2017:50; Language of the case: EN. The owner of the earlier EUTM **café crem**, registered for goods in Class 30 (the applicant before the GC), filed an opposition against the figurative EUTM application (for goods in Class 30) **Cremcaffé by**



Julius Meinl pursuant to Article 8(1)(b) EUTMR. Upon request of the owner of the EUTM application (the other party before the GC), the applicant provided evidence of genuine use of its earlier mark. The OD acknowledged genuine use of the earlier mark, found a LOC between the marks at issue and therefore upheld the opposition in its entirety. The BoA found the other party's appeal to be well founded, as it deemed the evidence submitted insufficient to establish genuine use of the earlier mark. It annulled the OD decision without examining the LOC. The applicant filed an action before the GC. With regard to the territorial scope of genuine use, the GC confirmed the BoA's finding that use had only been established in two of the four provinces of Catalonia (Spain), namely Tarragona and Barcelona. Merely providing a copy of an extract from the central trade register of Spain to prove the place of establishment of the company in another province (Girona) or providing a screenshot of a website with the postal address of a distributor in another province (Lleida) was not sufficient evidence to establish use in those provinces (paras 37-40). The BoA had correctly not taken into account sales of products documented in **invoices** that did not display the trade mark but solely referred to the acronym 'CC', as it had not been established unambiguously that this acronym indeed referred to the earlier mark. Furthermore, it had not been shown that all of the goods sold under the mark **café crem** corresponded to those for which the earlier mark was registered (paras 43-48). Even if it were assumed that the sums indicated on several **affidavits** — which mentioned only global sums, not broken down into products or product categories and not corroborated by other documents, such as statistical tables, annual reports, accounting/balance sheet items, etc. — were correct, it could not be ruled out, given the diversity of the marks mentioned in the invoices, that the sums indicated related to goods other than those sold under the earlier mark. The BoA had therefore correctly attributed little evidential value to the affidavits, which did not make it possible to determine the extent of use of the earlier mark with regard to the goods for which the mark was registered (paras 49-55). The GC stressed that use of the earlier mark on **promotional and advertising material** (which, in the case in question, was mostly undated or predated the relevant period), could not be proven simply by producing copies of that material. It also had to be demonstrated that that material, regardless of its nature, had been successfully distributed to the relevant public (paras 56-63). Overall, the GC found that, in view of the material submitted, taken as a whole, the BoA had not erred in finding that genuine use of the earlier mark had not been proven (para. 67). Based on the foregoing, the appeal was dismissed.

[T-690/15](#); **CREMCAFFÉ / CAFÉ CREM**; *Marcas Costa Brava, SL v EUIPO*; Judgment of 2 February 2017; EU:T:2017:51; Language of the case: EN. The owner of the earlier EUTM **café crem**, registered for goods in Class 30 (the applicant before the GC), filed an opposition against the figurative EUTM application (for goods in Class 30) **CREMCAFFÉ** pursuant to Article 8(1)(b) EUTMR. Upon request of the owner of the EUTM application (the other party before the GC), the applicant provided evidence of genuine use of its earlier mark. The OD acknowledged genuine use of the earlier mark, found a LOC between the marks at issue and therefore upheld the opposition in its entirety. The BoA found the other party's appeal to be well founded, as it deemed the evidence submitted not sufficient to establish genuine use of the earlier mark. It annulled the OD decision without examining the LOC. The applicant filed an action before the GC. With regard to the territorial scope of genuine use, the GC confirmed the BoA's finding that use had only been established in two of the four provinces of Catalonia (Spain), namely Tarragona and Barcelona. Merely providing a copy of an extract from the central trade register of Spain to prove the place of establishment of the company in another province (Girona) or providing a screenshot of a website with the postal address of a distributor in another province (Lleida) was not sufficient evidence to establish use in those provinces (paras 37-40). The BoA had correctly not taken into account sales of products documented in **invoices** that did not display the trade mark but solely referred to the



acronym 'CC', as it had not been established unambiguously that this acronym indeed referred to the earlier mark. Furthermore, it had not been shown that all of the goods sold under the mark **café crem** corresponded to those for which the earlier mark was registered (paras 43-48). Even if it were assumed that the sums indicated on several **affidavits** — which mentioned only global sums, not broken down into products or product categories and not corroborated by other documents, such as statistical tables, annual reports, accounting/balance sheet items, etc. — were correct, it could not be ruled out, given the diversity of the marks mentioned in the invoices, that the sums indicated related to goods other than those sold under the earlier mark. The BoA had therefore correctly attributed little evidential value to the affidavits, which did not make it possible to determine the extent of use of the earlier mark with regard to the goods for which the mark was registered (paras 49-55). The GC stressed that use of the earlier mark on **promotional and advertising material** (which, in the case in question, was mostly undated or predated the relevant period), could not be proven simply by producing copies of that material. It also had to be demonstrated that that material, regardless of its nature, had been successfully distributed to the relevant public (paras 56-63). Overall, the GC found that, in view of the material submitted, taken as a whole, the BoA had not erred in finding that genuine use of the earlier mark had not been proven (para. 67). Based on the foregoing, the appeal was dismissed.

[T-691/15](#); **Cremcafé by Julius Meinl / café crem**; *Marcas Costa Brava, SL v EUIPO*; Judgment of 2 February 2017; EU:T:2017:52; Language of the case: EN. The owner of the earlier EUTM **café crem**, registered for goods in Class 30 (the applicant before the GC), filed an opposition against the figurative EUTM application (for goods in Class 30) **Cremcafé by Julius Meinl** pursuant to Article 8(1)(b) EUTMR. Upon request of the owner of the EUTM application (the other party before the GC), the applicant provided evidence of genuine use of its earlier mark. The OD acknowledged genuine use of the earlier mark, found a LOC between the marks at issue and therefore upheld the opposition in its entirety. The BoA found the other party's appeal to be well founded, as it deemed the evidence submitted not sufficient to establish genuine use of the earlier mark. It annulled the OD decision without examining the LOC. The applicant filed an action before the GC. With regard to the territorial scope of genuine use, the GC confirmed the BoA's finding that use had only been established in two of the four provinces of Catalonia (Spain), namely Tarragona and Barcelona. Merely providing a copy of an extract from the central trade register of Spain to prove the place of establishment of the company in another province (Girona) or providing a screenshot of a website with the postal address of a distributor in another province (Lleida) was not sufficient evidence to establish use in those provinces (paras 37-40). The BoA had correctly not taken into account sales of products documented in **invoices** that did not display the trade mark but solely referred to the acronym 'CC', as it had not been established unambiguously that this acronym indeed referred to the earlier mark. Furthermore, it had not been shown that all of the goods sold under the mark **café crem** corresponded to those for which the earlier mark was registered (paras 43-48). Even if it were assumed that the sums indicated on several **affidavits** — which mentioned only global sums, not broken down into products or product categories and not corroborated by other documents, such as statistical tables, annual reports, accounting/balance sheet items, etc. — were correct, it could not be ruled out, given the diversity of the marks mentioned in the invoices that the sums indicated related to goods other than those sold under the earlier mark. The BoA had therefore correctly attributed little evidential value to the affidavits, which did not make it possible to determine the extent of use of the earlier mark with regard to the goods for which the mark was registered (paras 49-55). The GC stressed that use of the earlier mark on **promotional and advertising material** (which, in the case in question, was mostly undated or predated the relevant period), could not be proven simply by producing copies of that material. It also had to be demonstrated that that material, regardless of its nature, had been successfully



distributed to the relevant public (paras 56-63). Overall, the GC found that, in view of the material submitted, taken as a whole, the BoA had not erred in finding that genuine use of the earlier mark had not been proven (para. 67). Based on the foregoing, the appeal was dismissed.

♦[T-15/16](#); **Cystus**; *Georgios Pandalis v EUIPO*; Judgment of 14 February 2017; EU:T:2017:75; Language of the case: DE. The CD revoked the contested EUTM **Cystus** partially, for *non-medical food supplements* in Class 30, on account of the lack of genuine use. The BoA rejected the appeal, holding that the EUTM proprietor had made only descriptive use of the EUTM and that the goods marketed, such as lozenges, could not be qualified, on the basis of the evidence provided, as *non-medical food supplements* in Class 30. The EUTM proprietor filed an action before the GC. The GC rejected the action. In holding that the contested EUTM was used only descriptively, the BoA had not made any findings on Article 7 EUTMR but had examined whether it had been used in accordance with its main function, as required for genuine use. The BoA therefore had not infringed Article 71(1) EUTMR (paras 14-18). The goods in question contained as a main active ingredient an extract from a plant with the scientific name ‘Cistus Incanus L.’ and the Latin name ‘Cistus’. On the product packaging, ‘Cystus’ appeared to describe this ingredient, in particular as it formed part of the expression ‘Cystus®-Extrakt’ and featured in the list of ingredients. This multiple use and prominent display of ‘Cystus’ on the packaging did not allow it to be perceived as a trade mark. Nor was use of the ® symbol sufficient evidence, as it did not always appear and was also combined with other elements. Furthermore, the spelling with the letter ‘y’ was insufficient to prove genuine use since such variations generally did not render a sign distinctive. In the case in question, the BoA had been right to consider the letters ‘y’ and ‘i’ interchangeable in words of Latin origin and aurally identical in German (Germany being the territory to which the evidence related). Nor did the addition of the figures ‘052’ and ‘52’ endow the sign with distinctive character for the purpose of proving genuine use (paras 42-47). The GC confirmed the BoA’s findings on lack of use in relation to the goods in question. With regard to the legal requirements for goods to be marketed as supplements, as laid down by Directive 2002/46/EC of 10 June 2002 on the approximation of the laws of the Member States relating to food supplements, the EUTM proprietor had not established that the goods could be qualified as such. Furthermore, the allocation of a drug code, used for distribution in pharmacies, and the claims that the goods offered protection against the cold and flu, indicated that the goods were not *non-medical food supplements* in Class 30 (paras 57-59).

♦[T-30/16](#); **Natural Instinct Dog&Cat food as nature intended (FIG. MARK) / NATURE’S VARIETY et al.**; *M.I. Industries, Inc. v EUIPO*; Judgment of 15 February 2017; EU:T:2017:77; Language of the case: EN. The applicant sought to register the figurative mark **Natural Instinct Dog&Cat food as nature intended** as an EUTM for goods in Class 31. An opposition based on the earlier word marks **INSTINCT** and **NATURE’S VARIETY**, both registered for goods in Class 31, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition considering that the opponent had not proven genuine use of the earlier mark **INSTINCT** and that there would be no LOC with the earlier mark **NATURE’S VARIETY**. The BoA dismissed the opponent’s appeal. It examined the genuine use of both earlier marks, and found that the nature of the use had not been proven as the trade marks had not been used publicly and outwardly. Moreover, with regard to **NATURE’S VARIETY**, it found that the evidence did not show use as a trade mark. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 47(2) EUTMR and Rules 22(3) and (4) of Implementing Regulation (EC) No 2868/95; (ii) infringement of Article 8(1)(b) EUTMR; and (iii) infringement of Article 94 EUTMR. The GC partly upheld the appeal. It found that the BoA had wrongly assessed the evidence of use of the mark



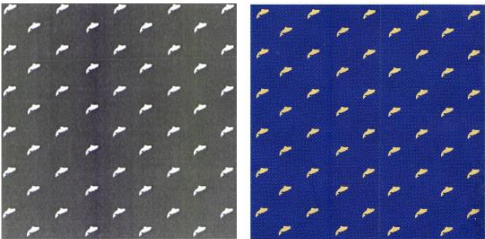

INSTINCT. However, it confirmed the BoA's conclusion that the evidence did not show that NATURE'S VARIETY had been used as a trade mark. It considered the second plea ineffective as the BoA had not taken a position on the LOC. It dismissed the third plea. As regards the first plea, the GC considered the BoA reasoning incorrect in various respects. **Value of the affidavit:** reviewing the case-law on affidavits, the GC considered that the BoA had erred in considering the affidavit by the owner of Cat's Country (which distributed the opponent's goods in Germany) to be of lesser probative value. In the present case, the existence of contractual links did not, on its own, mean that the affidavit was not that of a third party. The affidavit should have been considered as coming from an independent source; the case was not analogous to that in the judgment of 18/03/2015, T-250/13, SMART WATER, EU:T:2015:160 (paras 35-48). **Genuine use of 'INSTINCT':** the GC considered that the BoA had erred in concluding that, in light of the evidence, the goods delivered to Cat's Country had not actually entered the German market. According to the case-law (21/11/2013, T-524/12, RECARO, EU:T:2013:604), outward use did not necessarily mean that use was aimed at end consumers (paras 55-58). Moreover, sales to a single customer did not a priori preclude the use being genuine (11/05/2006, C-416/04 P, Vitafruit, EU:C:2006:310) (para. 59). **Genuine use of 'NATURE'S VARIETY':** the GC confirmed that there had been no use as a trade mark. It reviewed the evidence and pointed out that the sign had been used only as a company name (invoices, affidavit, mock-up of a label) (paras 67-73).

♦[C-577/14 P](#); **LAMBRETTA**; *Brandconcern BV v EUIPO and Scooters India Ltd*; ; Judgment of 16 February 2017; EU:C:2017:122; Language of the case: EN. The intervener was the proprietor of the EUTM **LAMBRETTA**, registered by the EUIPO on 6 August 2002 for, inter alia, *vehicles; apparatus for locomotion by land, air or water* in Class 12. The applicant requested revocation of the trade mark for lack of genuine use pursuant to Article 58(1)(a) and (2) EUTMR. The CD partially upheld the application and revoked the trade mark **LAMBRETTA** in respect of the goods in Class 12. The BoA dismissed the EUTM proprietor's appeal, applying the so-called 'literal approach' to class headings. Since the evidence of use submitted by Scooters India had been limited to the sale of spare parts (and not to vehicles or apparatus for locomotion), the BoA found that 'it cannot be inferred from the sale of spare parts that [Scooters India] has also manufactured and sold ... any vehicle'. The EUTM proprietor filed an action before the GC, alleging infringement of Article 58(2) EUTMR. The GC upheld the appeal and found that, even if *spare parts for scooters* did not actually appear in the alphabetical list of goods in Class 12, the BoA had to examine whether or not there had been genuine use of the mark in respect of the many fittings and parts listed therein. The revocation applicant filed an action before the CJ, seeking annulment of the GC judgment on the basis that there was no temporal limitation of the effects of the 'IP Translator' judgment (19/06/2012, C-307/10, IP Translator, EU:C:2012:361). The CJ dismissed the appeal. The CJ referred to paragraph 61 of the IP Translator judgment, where it was established that if the applicant for a trade mark used the heading of a particular class of the Nice Agreement to identify the goods and services covered by the mark applied for, it had to specify whether the application for registration was intended to cover all the goods or services included in the alphabetical list or only some of them (para. 28). In this regard, the CJ upheld the Office's submission that the IP Translator judgment did not concern the proprietors of registered trade marks, but solely applicants for trade marks (para. 29). Therefore, the rule set out in paragraph 61 of the IP Translator judgment was not applicable to registration of the trade mark **LAMBRETTA**, which took place before the IP Translator judgment (para. 31). Consequently, the CJ considered that the GC had not erred in finding that the words *vehicles; apparatus for locomotion by land, air or water* in the trade mark application filed on 7 February 2000 had to be interpreted as seeking to protect the mark **LAMBRETTA** in respect of all the goods in the alphabetical list in Class 12 (para. 32). The CJ also upheld the



Office’s practice regarding class headings, namely Communication Nos 04/03 and 02/12 (paras 31 and 32).

♦[T-766/15](#) and [T-767/15](#) (joined cases); **DEVICE OF A PATTERN OF GOLD FISH ON A BLUE BACKGROUND**; *Labeyrie v EUIPO*; Judgments of 28 February 2017; EU:T:2017:123; Language of the case: FR.

| EUTMs as registered | EUTMs as used |
|---|---|
|  |  |

The BoA confirmed the CD’s finding that the two contested EUTMs were to be revoked for all goods in Classes 29, 30 and 31 since they had been used in respect of fish only, and in a way that altered their distinctive character. The GC, dismissing the action, took the position that the less inherently distinctive a sign, the more likely it was that use together with additional elements that were potentially more distinctive would alter this sign’s distinctive character (para. 22 and reference to the judgment of 24/09/2015, T-317/14, Shape of a cooking stove, EU:T:2015:689, which was annulled by the CJ in its judgment of 01/12/2016, [C-642/15 P](#), SHAPE OF AN OVEN (3D), EU:C:2016:918 for lack of reasoning). The GC acknowledged that the two EUTMs, despite being registered as figurative marks, might be contourless (para. 27). It also confirmed that the repetitive pattern of stylised fish was distinctive to a low degree only (paras 29-33). A survey concerning the market recognition of the applicant’s packaging was irrelevant because it was limited to France (para. 36). Use of signs in combination with others did not necessarily alter their distinctive character. In this case, however, the superimposition of the sign **LABEYRIE**, which was also registered as a mark (para. 47), on the repetitive pattern altered the EUTMs’ distinctive character because ‘LABEYRIE’ was more distinctive and eclipsed the pattern (paras 51-54). The public would perceive the EUTMs as mere backgrounds with an ornamental function rather than as distinctive signs (para. 59). ‘The low degree of distinctive character of the contested mark is easily altered by the addition of an element such as the mark **LABEYRIE**, which is in itself distinctive’ (para. 60).

♦[T-741/14](#); **VACUP / V.A.C. et al.**; *Hersill SL v EUIPO*; Judgment of 14 March 2017; EU:T:2017:165; Language of the case: EN. The applicant sought to register the word mark **VACUP** as an EUTM for goods in Class 10. An opposition based on the earlier word marks, MINIVAC and V.A.C, registered for goods in Classes 5 and 10, was filed pursuant to Article 8(1)(b) and (5) EUTMR. The applicant made a request under Article 47(2) and (3) EUTMR for the intervener to prove that the earlier marks had been put to genuine use. The OD rejected the opposition on the grounds that the intervener had failed to prove genuine



use of the earlier marks. The BoA annulled the OD's decision and upheld the opposition. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 47(2) and (3) EUTMR and Rule 22(3) of Implementing Regulation (EC) No 2868/95, (ii) breach of the principles of legal certainty and the protection of legitimate expectations, and (iii) infringement of Article 8(1)(b) EUTMR. The GC, examining whether the BoA had been correct in finding that the earlier marks had been put to genuine use during the relevant period, confirmed that the invoices were irrelevant because their dates were outside the relevant period (paras 26-28). The BoA had found that the pre-formulated declarations, as well as the catalogues, the information concerning the intervener's products and the advertisements, corroborated the affidavit made by an employee of the intervener and established genuine use of the mark **V.A.C.** during the relevant period (para. 32). However, the GC stated that the pre-formulated declarations described the use of the marked products by the relevant public but not the use of that mark by its proprietor on the market. Consequently, they could not by themselves establish use of the mark **V.A.C.** during the relevant period (para. 34). Furthermore, a large number of catalogues and advertisements showed that the mark **V.A.C.** was used with additional word elements that were liable to alter its distinctive character, with the result that genuine use of it could not be established (para. 37). The GC concluded that the items of evidence were insufficient to allow the BoA to consider that the mark **V.A.C.** had been put to genuine use during the relevant period (para. 41). It therefore annulled the contested decision on the basis of the first plea, without examining the remaining ones.

[T-336/15](#); **The Specials**; *Windrush Aka LLP v EUIPO*; Judgment of 22 March 2017; EU:T:2017:197; Language of the case: EN. The EUTM proprietor was granted registration of the word mark **The Specials** for goods and services in Classes 9, 16, 25 and 41. An application for revocation on the ground of lack of genuine use of that mark was filed pursuant to Article 58(1)(a) EUTMR. The CD partly upheld the application for revocation. The applicant filed a notice of appeal with the Office pursuant to Articles 66 to 71 EUTMR. The BoA partly upheld the appeal, finding that the EUTM had been used only in respect of *compact discs (audio-video)* in Class 9. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 18(2) EUTMR. The GC dismissed the action. The applicant alleged that the BoA had erred in finding that the intervener had validly consented to use of the contested mark by a third party for *compact discs (audio-video)* in Class 9. In this regard, the GC denied that the BoA had burdened the applicant with proving that there had been no consent on the part of the intervener to use of the contested mark by a third party (para. 39). Furthermore, the GC found it irrelevant whether the contested mark had been put to genuine use by the intervener or with the intervener's consent (para. 50). Finally, the GC quoted the case-law according to which, where an EUTM proprietor claims that use of a mark by a third party constitutes genuine use of such mark, the EUTM proprietor is implicitly claiming that that use was made with its consent. Furthermore, in the case in question, it seemed unlikely that the intervener could have had the relevant documents and submitted them as PoU of the contested mark if such use had taken place against its wishes (para. 56).

♦ [T-239/15](#); **Cryo-Save**; *Cryo-Save AG v EUIPO*; Judgment of 23 March 2017; EU:T:2017:202; Language of the case: DE. An application for revocation was filed pursuant to Article 58(1)(a) EUTMR. The proprietor had to prove that the mark **Cryo-Save** was used for all goods and services, which were mainly special medical apparatus in Class 10; highly specific scientific and technological services, mainly in the area of stem cells, in Class 42; and medical services, also mainly relating to stem cells, in Class 44. The CD upheld the application for invalidity in its entirety as the PoU was considered insufficient. The BoA dismissed the EUTM proprietor's appeal. It found that the documents submitted before the



CD, as well as additional documents submitted during the appeal proceedings, were not sufficient to prove use of the contested mark, which therefore had to be revoked. The EUTM proprietor filed an action before the GC, relying on two pleas in law: (i) infringement of Article 63(2) EUTMR and Rule 37(b)(iv) of Implementing Regulation (EC) No 2868/95, and (ii) infringement of Article 58(1)(a) EUTMR. The GC dismissed the appeal. Regarding the issue of PoU, the GC confirmed the BoA decision in its entirety. For the goods in Class 10, no proof had been submitted that the goods had been sold within the relevant period. Regarding some of the services in Classes 42 and 44, there was no proof that doctors or medical personnel had extracted blood or other human tissue, such as stem cells, under the trade mark **Cryo-Save** during the relevant period in the EU. As regards a further group of services in Class 44 (mainly services of a blood bank and a bank for the storage of cell material, in particular a stem cell bank), the vast majority of documents were undated; it was therefore not possible to conclude that there had been genuine use during the relevant period. Nor could the documents prove use as a trade mark, but only as a company name (paras 39-40). Furthermore, no sales figures had been submitted (para. 43).

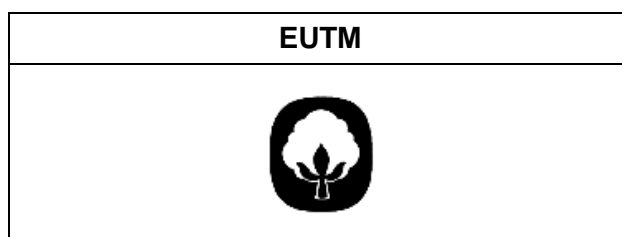
♦[T-638/15](#); **ALCOLOCK**; *Alcohol Countermeasure Systems (International) Inc. v EUIPO*; Judgment of 29 March 2017; EU:T:2017:229; Language of the case: EN. The BoA confirmed the CD's finding that the earlier UK mark had been put to genuine use and that the contested mark was to be declared invalid on the basis of Article 60(1)(a) in conjunction with Article 8(1)(a) and (b) EUTMR. The GC confirmed the BoA's findings that the invalidity applicant had proven genuine use of the earlier UK mark by presenting evidence of use by its licensee of another mark consisting of an identical sign and registered for identical goods. The GC chiefly relied on the case-law, according to which genuine use includes use of an earlier mark in a form differing in elements that do not alter the distinctive character of that mark in the form under which it was registered, even when that different form is itself registered as a trade mark (paras 17-35). In the case in question, use by the licensee had been with the invalidity applicant's consent, which was unencumbered by any infringements of the terms of the licensing agreement by the licensee (paras 42-44). Article 19(2) TRIPS, like any provision of the TRIPS Agreement, had no direct effect, but Article 18(2) EUTMR had to be interpreted in the light thereof. However, as the applicant before the GC had not put forward any specific argument, this plea had to be rejected (paras 47-51). Genuine use had been proven by means of a licensing agreement; a selection of invoices, accompanied by purchase orders and email requests; a selection of press articles; and a selection of advertisements, together with invoices for placing them. A press article published in Ireland, that is to say outside the relevant territory of the United Kingdom, nevertheless contained information on use of the earlier mark in the United Kingdom and could therefore be taken into account. Furthermore, the presence of the earlier mark on invoices and in articles and advertisements relating to the goods at issue could constitute a sufficient link between them. As regards extent of use, at 350, the number of breathalyser devices sold during the relevant periods to different persons was relatively low but sufficient to create or preserve an outlet for the goods concerned. Genuine use was thus proven, as correctly found by the BoA (paras 52-96).

♦[T-680/15](#); **L'ECLAIREUR**; *Les Éclaires GmbH v EUIPO*; Judgment of 8 May 2017 EU:T:2017:320; Language of the case: EN. The EUTM proprietor was granted registration of the word mark **L'ECLAIREUR** as an EUTM for goods in Classes 3, 4, 9, 14, 18, 20 and 25. An application for revocation was filed pursuant to Article 58 EUTMR. The CD upheld the application for revocation. The BoA partly upheld the EUTM proprietor's appeal. It found that the contested trade mark had been genuinely used for *clothing* and *shoes* in Class 25. The revocation applicant filed an action before the GC. The GC dismissed the action; it agreed with the BoA that there had been genuine use for *clothing* and *shoes*. The Office was merely



entitled, but not obliged, to request translation of PoU. Moreover, the revocation applicant had not expressly requested translation during the proceedings before the Office. The principle of the right to be heard and equality of arms had been observed, and there was no effect on the exercise of the revocation applicant's rights of defence, since the latter had been in a position to challenge the documents in question before the Court (paras 15-24). The intervener was active as a 'concept store', retailing 'luxury products', inter alia 'clothing' and 'shoes'. There was some evidence that the EUTM proprietor had collaborated, on several occasions, with other fashion designers and fashion labels; consumers had therefore encountered textile products labelled with marks composed of both the name of the designer and the mark **l'Eclaireur**. Such goods were always presented in such a way that the mark at issue was easily identifiable, even in all of the cases in which it was preceded by the name of the specific creator. The fact that some particular lines of products were offered in very limited series was a logical consequence of the concept, common in the fashion sector, of offering consumers a luxury product, often novel and exclusive, at a high price. Evidence that the EUTM proprietor had purchased certain goods was relevant because, as the latter was a retail store, it was reasonable to conclude that it had purchased the goods in question in order to resell them to the end consumers. The sworn declaration could not be rejected at the outset merely because it was made by the EUTM proprietor. It contained sound information that was supported by data from other evidence submitted by the intervener (paras 50-76). The EUIPO Guidelines were not binding legal acts for the purpose of interpreting provisions of EU law (para. 80). The BoA could draw inferences from the evidence, as an overall assessment of the facts had to be made, taking account of all the relevant factors in the particular case and the interdependence between those factors. Therefore, it had indeed been for the BoA to place the evidence within the context of the economic sector in question (para. 85).

[C-689/15](#); **W. F. Gözze Frottierweberei+Gözze / International cotton certification**; *W.F. Gözze Frottierweberei GmbH, Wolfgang Gözze v Verein Bremer Baumwollbörse*; Preliminary ruling of 8 June 2017; EU:C:2017:434; Language of the case: DE. The applicant in the infringement proceedings before the European Union trade mark court ('the applicant') was an association engaged in various activities linked to cotton. It was the proprietor of the following individual, figurative EUTM, registered in particular for textiles ('the cotton flower mark'):



The cotton flower mark had been used by manufacturers of textiles made from cotton fibres to certify the composition and the quality of their goods. Since registration, the applicant had concluded licence agreements in respect of its cotton flower mark with undertakings affiliated with the association. Those undertakings agreed to use the mark only for goods made from good-quality cotton fibres. Compliance with this commitment could be checked by the applicant. The defendant in the infringement proceedings before the European Union trade mark court ('the defendant') had not concluded a licence agreement with the applicant. It manufactured textiles made from cotton fibres. The infringement proceedings had been directed against the defendant's sale of towels to which hangtags were attached with the following reverse side:



The defendant brought a counterclaim for cancellation of the cotton flower mark, claiming that it was purely descriptive and non-distinctive and had not been put to genuine use by the applicant or its licensees. Firstly, the referring court asked whether Article 18(1) EUTMR was to be interpreted as meaning that the affixing of an individual EUTM, by the proprietor or with its consent, to goods as a label of quality was a trade mark use that fell under the concept of ‘genuine use’ within the meaning of that provision, with the result that the proprietor of that mark was entitled, pursuant to Article 9(1)(b) EUTMR, to prevent the affixing by a third party of a similar sign to identical goods where there was a LOC as referred to in the latter provision (para. 33). It was indispensable that a mark be used in accordance with its essential function, which was to indicate the origin of the goods or services marked with it. It might admittedly also be used to fulfil other functions, such as that of guaranteeing the quality of the goods or services. However, where the use of an individual mark, despite certifying the composition or quality of the goods or services, did not guarantee to consumers that the goods or services came from a single undertaking under the control of which they were manufactured or supplied and which, consequently, was responsible for the quality of those goods or services, such use was not made in accordance with the function of indicating origin. It followed that there was no use in accordance with the essential function of the individual mark where it was affixed to goods for the sole purpose of being a label of quality for those goods and not that of guaranteeing, in addition, that the goods came from a single undertaking under the control of which they were manufactured and which was responsible for their quality (paras 40-46). It was for the referring court to verify whether evidence made it possible to consider that the affixing of the cotton flower mark by the applicant’s licensees to their goods guaranteed to consumers that the goods came from a single undertaking, namely the applicant’s association, under the control of which the goods were manufactured and which was responsible for their quality. In any event, the fact that the licence agreements enabled the applicant to verify that the licensees used exclusively good-quality cotton fibres could not constitute such evidence. It implied, at most, that the applicant certified the quality of the raw material used. As was apparent from Article 74 EUTMR and Article 83 EUTMR, such certification might suffice for the view to be taken that a mark other than an individual mark fulfilled its function as an indication of origin. However, the dispute in the main proceedings concerned an individual mark registered for goods (paras 49-50). Secondly, the referring court asked whether Article 59(1)(a) and Article 7(1)(g) EUTMR had to be interpreted as meaning that an individual mark might be declared invalid where the proprietor of the mark failed to ensure, by carrying out periodic quality controls at its licensees’ premises, that expectations relating to the quality which the public associated with the mark were being met (para. 52). It was for the referring court to examine whether the cotton flower sign filed by the applicant was capable per se of deceiving the consumer. The subsequent management by the applicant of its mark and licences for its use was irrelevant in this respect and, therefore, the mark could not be declared invalid on the grounds that the proprietor of the mark failed to ensure, by carrying out periodic quality controls at its licensees’ premises, that expectations relating to the quality that the public associated with the mark were being met (paras 52-57). Thirdly, the referring court asked whether the EUTMR had to be interpreted as meaning that its provisions on collective EUTMs could be applied *mutatis mutandis* to individual EUTMs (para. 58). The scope of Article 74 to 82 EUTMR, relating to collective EU trade marks, was expressly confined, according to the wording of Article 74(1) EUTMR, to marks described as such when applied for. The



demarcation of the applicability of those articles had to be strictly adhered to, especially as the rules they introduced, such as those set out in Article 75 EUTMR concerning regulations governing use of the mark, went hand in hand with the requirement, when filing the application for registration, to expressly describe the mark applied for as a collective mark. Therefore, it was not possible to apply those rules by analogy to individual EUTMs (paras 58-60).



♦ [T-294/16](#); **GOLD MOUNT**; *Kaane American International Tobacco Company FZE v EUIPO*; Judgment of 8 June 2017; EU:T:2017:653; Language of the case: EN. On 21 August 2009, the EUTM proprietor was granted registration of the figurative mark **GOLD MOUNT** as an EUTM for goods in Class 34. On 22 October 2014, a request for revocation was filed on the grounds that the mark had not been put to genuine use pursuant to Article 58 (1)(a) EUTMR. The EUTM proprietor presented evidence that the EUTM had been used, arguing that, in any event, there were proper reasons for non-use because tests were being carried out on the products in question (cigarettes). On 28 July 2015, the CD upheld the request for revocation. The BoA dismissed the EUTM proprietor's appeal. It found that the evidence adduced did not make it possible to establish that the mark at issue had been put to genuine use in the EU during the relevant period. It also found that there were no proper reasons for non-use of the mark. The EUTM proprietor filed an action before the GC, relying on a single plea in law: infringement of Article 58(1)(a) EUTMR. First, it challenged the BoA's finding that proof of genuine use of the mark at issue had not been furnished. Second, it disputed the conclusion that there were no proper reasons for non-use of that mark. **Evidence of use:** the EUTM proprietor's challenge focused on the evidence of the EUTM proprietor's participation in international trade fairs. The BoA had found, inter alia, that the photographs adduced by the EUTM proprietor to prove use did not show use of the mark as registered because the graphic element showing a mountain, which is a co-dominant element of the EUTM as registered, did not appear in the evidence. The EUTM proprietor argued that that evidence showed that the trade fairs had taken place during the relevant period for proving use and that the BoA had not taken into account that such fairs attracted participants from all over the world, were held only once a year and required significant investment in terms of both time and money. Therefore, attendance at one trade fair per year should have been considered enough to show that the EUTM proprietor was making serious attempts to acquire a relevant position in the EU tobacco market and that it had made significant investments in order to promote its products on that market. The GC pointed out that the EUTM proprietor had not challenged the BoA's finding that no use had been shown of the mark as registered. Consequently, the reason that the BoA had discounted the evidence on trade fairs was not disputed by the EUTM proprietor (para. 28). Furthermore, the EUTM proprietor had not disputed one of the reasons given by the BoA for the sake of completeness, namely that there was no evidence that its participation in international trade fairs had targeted the public in the EU (para. 30). It followed that the EUTM proprietor's arguments could not call into question the BoA's conclusion that evidence of genuine use of the mark at issue had not been furnished (para. 31). **Proper reasons for non-use:** the EUTM proprietor had submitted several test results showing that its cigarettes exceeded the maximum level of carbon monoxide emission, as regulated by Directive 2014/40/EU concerning the manufacture, presentation and sale of tobacco and related products. The GC stressed that, according to the case-law, the concept of proper reasons for non use referred to circumstances unconnected with the trade mark proprietor rather than to circumstances associated with commercial difficulties experienced by it, and that problems associated with the manufacture of products fell under the latter (para. 43). In the case in question, the fact that a third party had carried out tests on the cigarettes did not allow the conclusion to be drawn that the manufacture of those cigarettes was independent of the EUTM proprietor's will. It was for the



EUTM proprietor to decide when it was going to have the tests carried out and to ensure that its cigarettes were compliant with the EU legislation. The BoA had therefore correctly found that the manufacture of cigarettes that complied with EU legislation depended on the will of the EUTM proprietor (paras 45 and 46).

♦[T-541/15](#); **NSU / NSU**; *Industrie Aeronautiche Reggiane Srl v EUIPO*; Judgment of 20 June 2017; EU:T:2017:406; Language of the case: EN. The applicant sought to register the word mark **NSU** as an EUTM for goods in Class 12. An opposition based on the earlier national German word mark **NSU**, registered for goods and services in Classes 7, 8 and 12, was filed pursuant to Article 8(1)(a) and (b) EUTMR. The OD partly upheld the opposition in relation to certain Class 12 goods. The BoA dismissed the applicant’s appeal and upheld the opponent’s ancillary appeal. It found that use of the earlier right had been proven for more goods than originally concluded by the OD. The applicant filed an action before the GC. The GC dismissed the appeal. The GC found that the BoA had been right to find that genuine use of the earlier mark had been shown both for *bicycles* in Class 12 and *parts of machines* in Class 7, and for *accessories for automobiles and bicycles, parts of vehicles* in Class 12. In this regard, the GC clarified that there was no requirement for the evidence of use to be authenticated. Furthermore, the GC concluded that the BoA had not erred in concluding that *parts of vehicles* in Class 12 and *vehicles* of the same Class were similar goods. Taking into account the identity of the marks at issue and the similarity between the goods in question, the BoA had correctly concluded that there was a LOC on the part of the relevant public.

♦[T-287/15](#); **real,-**; *Tayto Group Ltd v EUIPO*; Judgment of 28 June 2017; EU:T:2017:443; Language of the case: EN.


| EUTM as registered | EUTM as used |
|---|--|
|  |  |

The EUTM proprietor was granted registration of the figurative mark represented above as an EUTM for goods and services in Classes 3, 8, 16, 18, 20, 21, 22, 24, 25, 28, 29, 30, 31 and 32. An application for revocation was filed pursuant to Article 58 EUTMR. The CD upheld the application for revocation. The BoA partially upheld the EUTM proprietor’s appeal. It found that the contested mark had been put to genuine use for some of the goods covered by it. The revocation applicant filed an action before the GC, relying on six pleas in law: (i) infringement of Article 18(1) EUTMR, (ii) infringement of Article 18(2) EUTMR, (iii) infringement of Articles 71 and 95 EUTMR, (iv) infringement of Article 58(1)(a) EUTMR, (v) infringement of Article 94 EUTMR, and (vi) misuse of power and infringement of general principles of law. **First plea:** in its review of the lawfulness of the contested decision, the GC did not have to assess the distinctive character of the mark at issue, but to ensure that the BoA had correctly assessed the effect of additions to that mark (para. 27). The element ‘quality’, which is situated below the mark at issue, mainly under the element ‘real’, and is written in blue upper case letters that are smaller than the letters in the word element ‘real’, had a merely laudatory character and was distinctive only to a low degree. The addition, in the mark used, of stylisation in the form of a label within which both the elements of the mark



at issue and the element ‘quality’ are placed, was purely ornamental since in the background of the mark at issue and therefore in an ancillary position, which does not confer on it any distinctive character of its own (para. 34). Although a company name or shop name is limited to identifying a company, it may also constitute a trade mark if used as such. The mark at issue had not been used solely as a company name (paras 41-42). **Second plea:** since the EUTM proprietor has demonstrated to the requisite legal standard that there was use of the mark at issue, therefore proving that that mark was used by a third party, it had to be accepted that that mark was used with the EUTM proprietor’s consent (para. 60).

[T-333/15](#); **NN / NN**; *Josel, SL v EUIPO*; Judgment of 28 June 2017; EU:T:2017:444; Language of the case: EN.

| Earlier mark | Earlier mark as used |
|---------------------------------------|--|
| <p style="text-align: center;">NN</p> |  |

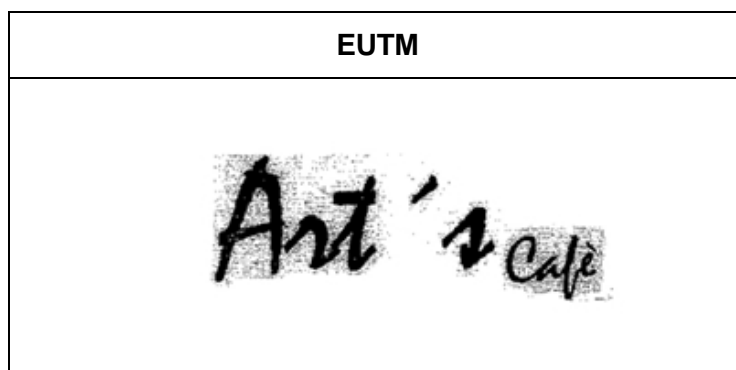
The applicant sought to register the word mark **NN** as an EUTM for services in Class 36. An opposition based on the Spanish earlier word mark **NN**, registered for services in Class 36, was filed pursuant to Article 8(1)(b) EUTMR. The OD dismissed the opposition. The BoA dismissed the opponent’s appeal. It found that proof of genuine use of the earlier mark had not been provided. The opponent filed an action before the GC, relying on a single plea in law: infringement of Article 18(1)(a) and Article 47(2) and (3) EUTMR. The GC dismissed the appeal. It found that the earlier trade mark had been used in a form that altered its distinctive character. Even if reproduction of the word element ‘nn’, which formed the earlier mark, within the signs used in the evidence could, in principle, be sufficient to prove genuine use of the earlier mark as registered in respect of the services in question, this was not the case if the modifications and additions in documents produced as evidence had an intrinsic distinctive character that altered the character of that mark and, as a consequence, meant that the mark was no longer recognised as such within the signs used. Given that the earlier mark was a word mark, it was not distinguished by the use of a particular font. As regards the word element ‘núñez i navarro’, the applicant’s argument that the term ‘núñez i navarro’ referred to the name of the parent or holding company of the group of companies to which it belonged had no effect on the possible alteration. ‘Núñez i navarro’ was always placed below the circle containing the letters ‘nn’. However, in the majority of the pieces of evidence presented, it occupied a central position, especially when either the word element ‘hotels’ or the reference to an address was placed below it. The word element ‘núñez i navarro’, in terms of width, occupied much more space than that of the word mark ‘nn’, having regard to the number of characters each contained. With regard to the fact that the surnames ‘núñez’ and ‘navarro’ appeared in the marks used, the letters ‘nn’ were very likely to be perceived as constituting the initials of those surnames. As surnames, the words ‘núñez’ and ‘navarro’ were not generic terms and therefore had normal distinctive character. It was concluded that



the addition of the word element ‘núñez i navarro’ to the earlier mark changed its distinctive character (paras 37-46).

♦[T-110/16](#); **SAVANT**; *Savant Systems LLC v EUIPO*; Judgment of 18 July 2017; EU:T:2017:521; Language of the case: EN. The EUTM proprietor was granted registration of the word mark **SAVANT** for goods and services in Classes 9, 16, 41 and 42. An application for revocation was filed pursuant to Article 58 EUTMR. The CD upheld the application for revocation in respect of all the goods and services registered with the exception of *computer software services; computer programming services, consultancy services relating to computer software* in Class 42, for which the application for revocation was rejected. The BoA partly upheld the EUTM proprietor’s appeal. It found that genuine use had been proven not only for *computer software services; computer programming services, consultancy services relating to computer software*’ in Class 42, which were not covered by the appeal, but also for the other services in Classes 41 and 42 and for *computer software* in Class 9. The invalidity applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 58(1)(a) EUTMR in conjunction with Article 18 EUTMR; (ii) breach of the duty to state reasons. **Revocation due to non-use:** the GC dismissed the claim that the evidence demonstrated use of the company name rather than use of the mark or that there was no link between the sign used and the relevant services. The GC stated that use of the trade name in invoices could be such as to establish genuine use of the registered mark (para. 31). In addition, the representation of the contested mark alongside other sub-brands corresponded to the situation where a number of signs are used simultaneously without changing the distinctive character of the registered sign (para. 32). Furthermore, as the mark may not be affixed to services, the link between the sign and the services has to be established through other indirect means. In the case in question, there was such a link in that the mark appeared at the top of each invoice, and in brochures, advertisements and articles in newspapers. These documents informed the customer of the origin of the goods and services. The GC also dismissed the arguments alleging that the evidence was insufficient to establish genuine use for all the goods and services claimed.

♦[T-309/16](#); **Art’s Café**; *Café’ Pont SL v EUIPO*; Judgment of 20 July 2017; EU:T:2017:535; Language of the case: EN.



The applicant was granted registration of the figurative mark represented above as an EUTM for goods in Class 30. An application for revocation was filed pursuant to Article 58(1)(a) and Article 63(1) EUTMR. The CD revoked the mark insofar as it had not been genuinely used in a form that did not differ from the registered mark by elements that altered its distinctive character. The BoA dismissed the appeal. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 58(1)(a) in conjunction with Article 18(1)(a) EUTMR. The GC, dismissing the action, stated that the BoA had not erred in



concluding that the evidence provided by the applicant was not capable of demonstrating genuine use of the mark at issue (from the point of view of the nature of that use) during the relevant period (para. 21). In particular, the BoA had found lack of genuine use of the mark at issue because the evidence produced by the applicant for that purpose did not show the mark at issue either in the form in which it was registered or in a form that did not alter its distinctive character within the meaning of Article 18(1)(a) EUTMR. Nor did the evidence satisfy the criterion relating to the nature of the use of the mark at issue within the meaning of Article 58(1)(a) EUTMR (para. 19). Additionally, the GC pointed out that the figurative element of the mark at issue, whose graphic presentation was neither negligible nor trivial, was a distinctive element of it, such that the use of a word mark without that element could not constitute use of the mark at issue within the meaning of Article 58(1)(a) in conjunction with Article 18(1)(a) EUTMR. Considering the descriptive character of the word ‘café’ for that product, the figurative element of the mark at issue had to be regarded as an important element of that mark (para. 20). As a result, the mark had to be revoked.

♦[C-471/16 P](#); **MEISSEN / Meissen et al.**; *Staatliche Porzellan-Manufaktur Meissen GmbH v EUIPO*; Judgment of 26 July 2017; EU:C:2017:602; Language of the case: DE. An opposition was filed against an EUTM application applied for in respect of goods in Classes 11, 19 and 20. The opposition was based on earlier marks registered for goods and services in Classes 3, 8, 11, 14, 16, 18, 19, 21, 24, 28, 29, 30, 32, 33, 34, 36, 41, 42 and 43. The grounds of opposition were Article 8(1)(b) and Article 8(5) EUTMR. Upon request, the opponent had to provide PoU for some of the earlier marks. The OD partly upheld the opposition, namely for the goods in Classes 11 and 19, and rejected it with regard to the goods in Class 20. Upon appeal by both parties, the BoA annulled the OD’s decision insofar as the OD had upheld the opposition for Classes 11 and 19. The BoA found that there was no LOC between any of the marks. With regard to Article 8(5) EUTMR, the BoA held that neither a link between the signs nor a risk of injury had been proven by the opponent. The opponent filed an action before the GC, based on an alleged infringement of Article 8(1)(b), Article 8(5) and Article 47(2) and (3) EUTMR. The GC dismissed the appeal in its judgment of 14/06/2016, [T-789/14](#), **MEISSEN / MEISSEN** (fig.), EU:T:2016:349. The opponent/appellant filed an appeal before the CJ, raising, inter alia, the following pleas in law: (i) infringement of Article 47(2) of the Charter of Fundamental Rights of the European Union (‘Right to an effective remedy and a fair trial’), because the GC had not taken into account supplementary documents submitted for the first time before the GC to support the prior evidence and arguments of the appellant; (ii) infringement of Article 18(1) EUTMR, because the GC had denied genuine use of the earlier marks for certain goods, despite the fact that the documentation submitted clearly proved use for these goods, and had therefore distorted the facts; and (iii) infringement of Article 8(5) EUTMR. The GC, by stressing that the goods at issue were ‘so different’ that the relevant public would not establish a link between the marks, had erroneously insinuated that the application of Article 8(5) EUTMR was dependent on similarity between the goods. The CJ dismissed the appeal. **Genuine use (distortion of facts)**: according to settled case-law, an appellant that claims a distortion of facts must indicate precisely the evidence alleged to have been distorted and must show the errors of appraisal that, in the appellant’s view, led to the distortion. A mere general reference to the content of the file without specifying the concrete error the GC had allegedly committed in its assessment of genuine use in the contested decision — as in the present case — was not sufficient (paras 32-37).

♦[T-276/16](#); **Boswelan**; *Viridis Pharmaceutical Ltd v EUIPO*; Judgment of 15 September 2017; EU:T:2017:611; Language of the case: DE. The EUTM proprietor was granted registration of the word mark **Boswelan** as an EUTM for *pharmaceutical products and health-care products* in Class 5. An application for revocation due to a lack of genuine



use was filed pursuant to Article 58(1)(a) EUTMR. The CD upheld the application for revocation. The BoA dismissed the EUTM proprietor's appeal. It found, in particular, that use of the EUTM in the context of a clinical trial did not constitute outward use aimed at marketing or advertising a product on the pharmaceutical market. Nor could it be qualified as preparatory to subsequent marketing, given the point in time long before the actual marketing, the ongoing clinical trial phase and the lack of a request for marketing authorisation. Under these circumstances, conducting a clinical trial could not be considered a proper reason for non-use as the EUTM proprietor was responsible for such trials, and in particular for how long they lasted. Only once the proprietor had submitted a request for the required marketing authorisation would this responsibility shift to the public authorities. The EUTM proprietor filed an action before the GC, relying on three pleas in law: (i) infringement of Article 58(1)(a) EUTMR with respect to the lack of genuine use, (ii) infringement of Article 58(1)(a) EUTMR with respect to proper reasons for non-use, and (iii) breach of its legitimate expectations arising from the Office's Guidelines under Article 107 EUTMR. The GC dismissed the appeal. It confirmed that, under the circumstances of this case, use in the context of a clinical trial, including promotions in relation thereto, was insufficient to support genuine use, for which external use with a view to creating or preserving an outlet for the goods was essential. Such use could only follow marketing authorisation as pharmaceutical regulations prohibited any prior advertising for the purpose of gaining an outlet for the goods (paras 35-36). Furthermore, the EUTM proprietor had not established that the marketing of the goods was imminent (paras 37-38). Conducting a clinical trial might give rise to proper reasons for non-use. However, in the case in question, use of the EUTM was not legally required for the trial and had been the proprietor's choice, despite the uncertainties as to when or even if the pharmaceutical might be marketed. Furthermore, the length of trials depended on the proprietor's financial investment. In the case in question, authorisation to conduct the trial had been requested more than 3 years after the EUTM's registration. As these circumstances were not unconnected with the proprietor, they did not justify the lack of genuine use (paras 54-63). The Office's Guidelines, according to which clinical trials were typical examples of proper reasons for non-use, did not amount to concrete assurance that the proprietor's clinical trial qualified as such. Therefore, the proprietor could not rely on legitimate expectations (paras 67-70).


♦[T-143/16](#); **INTESA**; *Intesa Sanpaolo SpA v EUIPO*; Judgment of 4 October 2017; EU:T:2017:687; Language of the case: EN. The EUTM proprietor was granted registration of the word mark **INTESA** as an EUTM for goods and services in Classes 16, 35, 36, 38, 41 and 42. An application for revocation was filed pursuant to Article 58 EUTMR. The CD partly upheld the application for revocation, namely for all goods and services in Classes 16, 38 and 41 and for some services in Classes 35, 36 and 42. The BoA dismissed the appeal. It found that genuine use had not been sufficiently proven for the goods and services for which the CD had revoked registration. The EUTM proprietor filed an action before the GC, relying on a single plea in law: infringement of Article 58(1)(a) and (2) EUTMR. The GC dismissed the appeal. *Advertising* and *office functions* in Class 35 had not been proven to be services offered to third parties. Their use was merely internal, in support of the company's own management and business activities (paras 29-35). Genuine use for *real-estate affairs* in Class 36 had not been demonstrated. There was no evidence on the commercial significance of the use and no turnover figures or invoices had been provided (paras 38-42). The website used by the EUTM proprietor as a vehicle for promoting its financial services did not constitute evidence of offering *telecommunications* and *electronic transmission of documents* in Class 38 to third parties. No proof of such 'technical services' had been submitted (paras 50-54). The *providing of education; providing of training; amusements; and sporting and recreational activities* in Class 41 to third parties had also not been proven. The purpose of contracts provided was to raise funds rather than offer training. Cards enabling



customers to benefit from special offers at cultural and entertainment events could not be perceived as automatically relating to the *amusements* or *sporting and recreational activities* that the EUTM proprietor claimed to offer, as they were rather part of a business promotion plan aimed at rewarding customers for loyalty. No relevant turnover figures had been submitted in connection with the services in question in Class 41 (paras 57-61). As regards services allegedly rendered in connection with *scientific and technological services and research and design relating thereto; design and development of computer hardware and computer software; and legal services* in Class 42, the evidence of use was not sufficient either. Although it was not without any evidential value, there was no reference to the duration or commercial volume of those services (paras 65-67).

♦[T-336/16](#); **VERSACE 19.69 ABBIGLIAMENTO SPORTIVO... / VERSACE et al.**; *Versace 19.69 Abbigliamento Sportivo Srl v EUIPO*; Judgment of 5 October 2017; EU:T:2017:691; Language of the case: IT. The applicant sought to register the figurative mark **VERSACE 19.69 ABBIGLIAMENTO SPORTIVO** as an EUTM for goods in Classes 9, 24 and 25. An opposition based, inter alia, on the earlier word mark **VERSACE**, registered for goods in Classes 9, 24 and 25, was filed pursuant to Article 8(1)(b) EUTMR. The OD partially upheld the opposition and allowed registration of the mark for goods in Class 9, apart from *optical apparatus, glasses, sunglasses and lenses*. The BoA dismissed the applicant’s appeal. The applicant filed an action before the GC, requesting that it annul the contested decision. Regarding the PROOF OF USE filed by the opponent, the GC challenged the BoA’s decision in respect of goods in Class 24: the opponent had not proven use of its sign for *textiles* but only for *household linen*, which formed a subcategory consisting of all textiles for domestic use (paras 51-54). Moreover, the GC rejected the motion filed by the applicant for goods in Class 25, considering that it was not possible to distinguish a subcategory of *luxury clothing* within the general category of *clothing* (para. 58).

♦[T-337/16](#); **VERSACCINO / VERSACE et al.**; *Versace 19.69 Abbigliamento Sportivo Srl. v EUIPO*; Judgment of 5 October 2017; ECLI:EU:T:2017:692; Language of the case: IT.

| EUTM application | Earlier trade mark |
|---|--|
|  | <p data-bbox="1011 1442 1153 1473">VERSACE</p> |


The applicant sought to register the figurative mark represented above as an EUTM for goods in Class 25. An opposition based, inter alia, on the earlier word mark **VERSACE**, registered for goods in Class 25, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition. The BoA dismissed the applicant’s appeal. The applicant filed an action before the GC, requesting that the Court annul the contested decision and register the sign for the goods claimed. The applicant relied on two pleas in law: (i) infringement of Article 47(2) EUTMR and (ii) infringement of Article 8(1)(b) EUTMR. The applicant contested the BoA’s conclusions in relation to the PoU of the earlier trade mark. In that regard, the GC found that, according to Rule 22 of Implementing Regulation (EC) No 2868/95, where the evidence supplied by the opposing party was not in the language of the opposition proceedings, the Office could require the opposing party to submit a translation of such evidence in that language. In the present case, the Office did not require a translation due to the fact that the opposing party had filed invoices in English (i.e. the language of international



trade), which clearly referred to ‘clothing and footwear’ (paras 31-34). The fact that the earlier mark did not appear beside the goods sold did not mean that the invoices provided were not relevant for the purposes of proving genuine use of that mark. It had to be ascertained whether the invoices did actually cover such goods or, at least, whether that mark had been used in accordance with its essential function (para. 44). The holder of the previous trade mark was not obliged to prove continuous, uninterrupted, use of its sign throughout the relevant period, but only genuine use during the course of it (para. 51).

♦[T-233/15](#); **1841**; *Cofra Holding AG v EUIPO*; Judgment of 10 October 2017; EU:T:2017:714; Language of the case: EN. The EUTM proprietor was granted registration of the word mark **1841** as an EUTM for, inter alia, *clothing, footwear, headgear* in Class 25. An application for invalidity was filed pursuant to Article 60(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR on the basis of earlier French word mark **AD-1841-TY** (registered on 6 June 2007) for a range of goods in Class 25. Before the CD, the EUTM proprietor requested that the applicant furnish proof of genuine use of its earlier mark. The CD dismissed the application for invalidity insofar as the applicant had not provided such proof. The BoA upheld the invalidity applicant’s appeal and declared the contested EUTM invalid in respect of *clothing, footwear, headgear*. The EUTM proprietor filed an action before the GC, relying on two pleas in law: (i) infringement of Article 64(2) EUTMR and Article 19(2) EUTMDR concerning evidence of genuine use (claimed as belated and in any event insufficient) and (ii) infringement of Article 8(1)(b) EUTMR (claiming lack of similarity of the signs and coexistence). The GC dismissed the appeal. **PoU**: the GC confirmed the established principles on the BoA’s exercise of discretionary power and ‘belated evidence’ (paras 22-28) and concluded that the BoA had made proper use of the discretion conferred on it by taking into account evidence submitted for the first time before it (para. 34). In addition, after an analysis of all the documents submitted by the invalidity applicant before the Office, the GC confirmed that sufficient genuine use had been proven (para. 76) in terms of place (paras 59-60), extent (paras 61-66), time (para. 60) and nature (paras 67-75).

♦[C-501/15 P](#); **CACTUS OF PEACE DE LA PAZ / CACTUS**; *Cactus SA v EUIPO*; Judgment 11 October 2017; EU:C:2017:383; Language of the case: EN.


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

The applicant sought to register the figurative mark represented above as an EUTM for goods and services in Classes 31, 39 and 44. An opposition based, inter alia, on the earlier EUTM figurative mark represented above, registered for goods and services in all class headings of Classes 2, 3, 5 to 9, 11, 16, 18, 20, 21, 23 to 35, 39, 41 and 42, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition for goods and services in Classes 31 and 44. The BoA upheld the EUTM applicant’s appeal. It found that the OD had erred in considering that the opponent had adduced proof of genuine use of the earlier trade



marks for *retailing of natural plants and flowers, grains; fresh fruits and vegetables* in Class 35. The opponent filed an action before the GC, relying on three pleas in law: (i) infringement of Article 47(2) EUTMR, (ii) infringement of Article 94 and Article 95(1) EUTMR, and (iii) infringement of Article 95(2) EUTMR. The GC partly upheld the action. It annulled the decision at issue to the extent that it, first, had rejected the opposition on the ground that *retailing of natural plants and flowers, grains; fresh fruits and vegetables* were not covered by the designation of the class heading of Class 35 of the earlier trade mark; second, had rejected the opposition on the basis of *natural plants and flowers, grains* in Class 31; and third, had considered that use of the earlier mark had not been made in the form as registered. It dismissed the action for the remainder of the goods and services. The Office filed an appeal before the CJ, raising two grounds of appeal: (i) infringement of Article 33 EUTMR in conjunction with Rule 2 of Implementing Regulation (EC) No 2868/95 and (ii) infringement of Article 47(2) in conjunction with Article 18(1)(a) EUTMR. The CJ dismissed the appeal. **Use in a form differing from that of registration:** the GC considered the second plea, based on the infringement of Article 18(1)(a) EUTMR, inadmissible to the extent that it challenged factual assessments, namely the GC’s findings in relation to the attentiveness, the perception and the attitude of the relevant public (para. 61). In turn, determining the criteria to be employed for the assessment of genuine use, as well as for the global assessment of equivalence of signs from the perspective of their distinctiveness, was a question of law that fell within the CJ’s jurisdiction (para. 64). The CJ confirmed that the condition of genuine use was satisfied even where only the figurative element of a composite mark was used, as long as the distinctive character of that mark, as registered, was not altered (para. 67). Where the distinctive character of the word element did not differ from that of the figurative element, the absence of that word element in the abbreviated version of the earlier figurative mark did not alter its distinctive character. Finding that the word and figurative elements conveyed the same semantic content, the GC had not erred in considering that the absence of that word element in the abbreviated version of the earlier figurative mark was not sufficiently important in the perception of that mark as a whole as to alter its distinctive character (para. 69). The GC had not erred in not conducting an aural comparison since the compared signs had the same semantic content (para. 70).

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



| EUTM application | Earlier trade mark |
|---|--------------------|
|  | SKY |

The applicant sought to register the figurative mark represented above as an EUTM for goods in Classes 9 and 18. An opposition based on the earlier EUTM word mark **SKY**, registered, inter alia, for goods in Classes 9 and 18, was filed pursuant to Article 8(1)(b) and Article 8(4) and (5) EUTMR. The OD upheld the opposition for the contested goods in Classes 9 and 18. The BoA dismissed the applicant’s appeal. It found that a request for PoU was inadmissible since, at the date of publication of the mark applied for, the relevant earlier mark had been registered for less than 5 years. Next, the BoA held that the (at least) average degree of visual and aural similarity between the marks and the conceptual similarity due to the concept of sky, as well as the identity of the goods at issue, meant there was a LOC. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement



of Article 47(2) and (3) and Article 18(1) EUTMR, read in conjunction with Rule 22(2) of Implementing Regulation (EC) No 2868/95, and (ii) infringement of Article 8(1)(b) EUTMR. The applicant argued that a request for PoU was necessary where repeated applications for an earlier mark sought to circumvent or prolong the ‘grace period’ of 5 years for use of the mark and, for that reason, appeared to be ‘abusive’ (para. 17). Article 47(2) EUTMR, as applicable at the time of the facts, only required the opponent to produce, at the applicant’s request, proof of genuine use of the earlier mark ‘provided that ... the earlier Community mark was registered for not less than five years’ (para. 20). This was not called into question by the argument that a party operated a ‘practice of re-filing identical trade mark registrations’ without ever having the intention of using them (para. 23). A finding of bad faith when filing an application for an EUTM was an absolute ground for invalidity under Article 59(1)(b) EUTMR; and the EUIPO could not examine such criteria in the opposition procedure. The EUTMR provided no procedural mechanism that allowed the validity of an earlier mark to be contested with regard to bad faith on the part of the opponent (paras 25-27). There was a medium degree of visual and aural similarity between the signs (paras 92 and 103) and they were conceptually similar (para. 109). The BoA had been fully entitled to hold that there was a LOC within the meaning of Article 8(1)(b) EUTMR for the goods at issue for the English-speaking part of the relevant public (para. 127).

♦ [T-404/16](#); **SHAPE OF A PACKET OF BISCUITS (3D)**; *Galletas Gullón, SA v EUIPO*; Judgment of 23 October 2017; EU:T:2017:745; Language of the case: EN.



| EUTM as registered | EUTM as used |
|---|---|
|  |  |

The 3D EUTM represented above was registered for *biscuits* in Class 30. An application for revocation was filed pursuant to Article 58(1)(a) EUTMR. The CD dismissed the application for revocation. The BoA annulled the CD decision and revoked the applicant’s rights in the contested mark on the grounds of non-use for the goods in question, as the mark was used in a form that —according to the BoA — altered its dominant elements, such as the colouring of the packaging and the house mark. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 58(1) EUTMR. Despite the brevity of the application, the GC dismissed the plea of inadmissibility put forward by the intervener, considering that the information contained in the application allowed both the GC to rule on the action, and the defendant and intervener to prepare their defence (paras 18-19). The GC found that the only differences between the registered EUTM and the mark as used were the white colour in the upper part of the packaging and the stylisation of the element ‘gullón’ and of the letter ‘O’ and number ‘2’; these were considered minor changes, ornamental in nature, that did not significantly alter the overall impression created by the registered mark (para. 32). Use of the EUTM in a different colour combination could not alter the distinctive character of the registered mark, since the colour combination ‘blue-yellow-blue’ was not a distinctive or dominant element of the registered mark, and colours possessed little capacity for conveying specific information, especially when they were relatively commonplace. They



would be understood as elements for purely aesthetic purposes or as presentational features rather than as an indication of commercial origin (para. 33). As regards genuine use, the GC noted that the fact that the mark was not referred to on invoices did not mean that the latter were irrelevant for proving genuine use of that mark (para. 51). The GC found that the extent of use was sufficient to amount to a real and serious commercial effort (para. 55). Furthermore, despite the limited commercial volume of the use of the mark, the very regular invoices made it possible to conclude that use of the mark had been genuine (paras 56 and 60). Finally, it was not relevant whether the goods in question reached the consumers, since genuine use only required a mark to be used publicly and outwardly (para. 62).

♦[T-418/16](#); **SHAPE OF A PACKET OF BISCUITS (3D)**; *Galletas Gullón, SA v EUIPO*; Judgment of 23 October 2017; EU:T:2017:745; Language of the case: EN.

| EUTM as registered | EUTM as used |
|--|--|
|  |  |

The 3D EUTM represented above was registered for *biscuits* in Class 30. An application for revocation was filed pursuant to Article 58(1)(a)EUTMR. The CD dismissed the application for revocation. The BoA annulled the CD decision and revoked the applicant’s rights in the contested mark on the grounds of non-use for the goods in question, as the mark was used in a form that — according to the BoA — altered its dominant elements, such as the colouring of the packaging and the house mark. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 58(1) EUTMR. Despite the brevity of the application, the GC dismissed the plea of inadmissibility put forward by the intervener, considering that the information contained in the application allowed both the GC to rule on the action, and the defendant and intervener to prepare their defence (paras 18-19). The GC found that the only differences between the registered EUTM and the mark as used were the white colour in the upper part of the packaging, the stylisation of the element ‘gullón’ and of the letter ‘O’ and number ‘2’, and the addition of the descriptive term ‘chocolate’ to the element ‘mini O2’; these were considered minor changes, ornamental in nature, that did not significantly alter the overall impression created by the registered mark (para. 32). Use of the EUTM in a different colour combination could not alter the distinctive character of the registered mark, since the colour combination ‘red-yellow-red’ was not a distinctive or dominant element of the registered mark, and colours possessed little capacity for conveying specific information, especially when they were relatively commonplace. They would be understood as elements for purely aesthetic purposes or as presentational features rather than as an indication of commercial origin (para. 33). As regards genuine use, the GC noted that the fact that the mark was not referred to on invoices did not mean that the latter were irrelevant for proving genuine use of that mark (para. 51). The GC found that the extent of use was sufficient to amount to a real and serious commercial effort (para. 55). Furthermore, despite the limited commercial volume of the use of the mark, the very regular invoices made it possible to conclude that use of the mark had been genuine (paras 56 and 60). Finally, it



was not relevant whether the goods in question reached the consumers, since genuine use only required a mark to be used publicly and outwardly (para. 62).

[T-202/16](#); **coffee inn / coffee in**; *UAB Keturi kambariai v EUIPO*; Judgment of 24 October 2017; EU:T:2017:750; Language of the case: EN. The applicant sought to register the figurative mark **coffee inn** as an EUTM for services in Classes 35 and 43. An opposition based, in particular, on the earlier Estonian figurative mark **coffee in**, registered for goods and services in Classes 30 and 43, was filed pursuant to Article 8(1)(b) EUTMR. At the applicant's request, the opponent furnished PoU. The OD partly upheld the opposition. The BoA dismissed the applicant's appeal. It found that the evidence of use submitted by the opponent, taken as a whole, showed genuine use of the earlier trade mark in Estonia. As regards the LOC, the BoA held that the services were partly identical and partly similar and that the signs were visually and conceptually similar to an average degree and aurally highly similar/identical. Therefore, in view also of the average distinctiveness of the earlier mark, there was a LOC. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 47(2) EUTMR and (ii) infringement of Article 8(1)(b) EUTMR. The GC dismissed the appeal. **PoU**: the GC endorsed the overall assessment of the evidence of use of the earlier mark, noting that the applicant did not dispute the authenticity or accuracy but rather the extent. It emphasised the probative value of the annual reports and stated that the fact that the name of the opponent's undertaking coincided with the word elements of its mark might also constitute an indication of use of the earlier mark for the opponent's main activity and thus for the services forming part of that activity and protected by that mark (para. 42). The GC also held that the supply of coffee cups bearing the earlier trade mark, as evidenced by numerous invoices, made it possible to assume with a reasonable degree of certainty that those cups were used in the opponent's commercial activity since they could be considered essential equipment for the sale of coffee as a service (para. 44). The GC dismissed the applicant's argument that no information had been provided on the market share held and the turnover achieved, since this information was just one of the factors to be assessed, and the lack of such information was not capable of showing, in itself, that use of the mark did not make it possible to maintain or create a market share for the goods or services protected by that mark (para. 62).

♦[T-271/16](#); **THOMAS MARSHALL GARMENTS OF LEGENDS / Marshall et al.**; *Yusuf Pempe v EUIPO*; Judgment of 8 November 2017; EU:T:2017:787; Language of the case: EN. The applicant sought to register the figurative mark **THOMAS MARSHALL GARMENTS OF LEGENDS** as an EUTM for goods and services in Classes 9, 16, 18 and 25. An opposition based on, inter alia, the earlier figurative EUTM **Marshall**, registered for goods in Classes 16, 18 and 25, and the earlier EUTM (word mark) **MARSHALL**, registered for Classes 9 and 11, was filed pursuant to Article 8(1)(b) and Article 8(4) and (5) EUTMR. The OD partly upheld the opposition for goods in Classes 9, 16, 18 and 25. The applicant appealed against the OD's decision and the BoA dismissed the applicant's appeal, except for the following goods in Class 9: *apparatus and instruments for conducting, accumulating, electricity and cash registers*. It found that there was a LOC, except for the above goods (Class 9), which were different from those covered by the earlier marks. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 18(1)(a) and Article 47(2) and (3) EUMTR and (ii) infringement of Article 8(1)(b) EUTMR. **PoU**: for the two earlier marks, the fact that the 5-year period came to an end during the course of the proceedings before the EUIPO was irrelevant, since it had still been under way when the EUTM application was published (para. 22).

♦[T-456/16](#); **GULLON DARVIDA / DAR VIDA et al.**; *Galletas Gullón v EUIPO*; Judgment of 16 November 2017; EU:T:2017:811; Language of the case: EN. The applicant sought to



register the word mark **GULLON DARVIDA** as an EUTM for goods in Class 30. An opposition was filed by the IR/national trade mark holder pursuant to Article 8(1)(b) EUTMR, based on the earlier international trade mark **Dar Vida** for goods in the same class, as well as on the Danish word mark **DAR VIDA**, the Finnish word mark **DAR VIDA**, the Swedish word mark **DAR VIDA** and the UK word mark **DAR VIDA**. The OD dismissed the opposition insofar as the evidence submitted upon its request for PoU was not sufficient to establish genuine use of the marks concerned and for the goods concerned in the relevant territories, namely in Denmark, Finland, Sweden and the United Kingdom, during the relevant period. The IR/national trade mark holder filed an appeal, which was upheld by the BoA. The BoA found that the IR/national trade mark holder had established its earlier right during the relevant period, that evidence of genuine use of the earlier international mark had been provided, and, finally — as the relevant goods were identical, there was an average level of visual and aural similarity between the signs and a normal level of attention on the part of the relevant public, and the earlier mark had normal inherent distinctive character — that there was a LOC. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 95 EUTMR and Article 7 EUTMDR, (ii) infringement of Article 47(2) and (3) EUTMR and Article 10(2) EUTMDR, and (iii) infringement of Article 8(1)(b) EUTMR. **PoU**: in examining whether there had been genuine use of the earlier marks, the BoA had been entitled to take into account the earlier IR that took effect in the relevant territory (Germany), without having to examine genuine use of the other earlier national marks (para. 71).

♦ [T-802/16](#); **FEMIBION**; *Endoceutics, Inc. v EUIPO*; Judgment of 17 November 2017; EU:T:2017:818; Language of the case: EN. Registration as an EUTM for goods in Class 5 (*Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; disinfectants*) was sought for the word mark **FEMIBION**. An application for revocation against all the goods covered by the mark was filed, based on Article 58(1)(a) EUTMR. The CD partially upheld the application, since it found that genuine use of the mark at issue had been shown only for the *dietetic substances adapted for medical use*, in respect of which registration of the mark at issue had been maintained. An appeal was filed against the CD's decision by the EUTM applicant. The BoA partially upheld the appeal and annulled the CD's decision regarding maintenance of the mark's registration for the abovementioned goods. The revocation applicant filed an action before the GC, requesting annulment of the BoA decision and revocation of the mark for *pharmaceutical preparations for immune system support, for menopause, for menstruation, for treatment and management of pregnancy, for the prevention, treatment and management of stress, for the prevention, treatment and management of stress [caused by] ill-balanced or deficient nutrition*. The applicant relied on a single plea in law before the GC: infringement of Article 58(1)(a) EUTMR. **Assessment of genuine use**: the main issue addressed by the GC was the classification of the goods in Class 5 subcategories in respect of which genuine use had been shown and, therefore, the limitation of protection strictly to subcategories where the mark had actually been used. It was found that genuine use of the mark had not been shown for *pharmaceutical preparations for immune system support, for menopause, for menstruation, for treatment and management of pregnancy, for the prevention, treatment and management of stress, for the prevention, treatment and management of stress [caused by] ill-balanced or deficient nutrition*, but only for *dietetic substances adapted for medical use* (para. 7), for the following reasons: (i) The products 'Femibion@ Healthy Pregnancy', 'Femibion@ Energetic Mum', 'Femibion@ Balance', 'Femibion@ Radiance' and 'Femibion@ Healthy Bones' were, according to the evidence, nutritional supplements (para. 30), the use of which was intended to treat certain health problems (not diseases), for example physical symptoms resulting from hormonal changes frequently experienced by women, such as



those associated with the transition to menopause, during menstruation or in times of stress. Therefore, they were not intended to treat or prevent a disease, but rather to address nutritional deficiencies resulting from normal physiological processes (paras 34, 36 and 37). (ii) Regarding the product 'Femibion Flore Intime vaginal gel', even though this clearly could not be classified as a *food supplement* or a *dietetic substance*, nor could it be classified as a *pharmaceutical preparation*. Furthermore, even if it were a *pharmaceutical preparation*, its use could not be classified as genuine due to insufficient evidence of use (only two invoices proving the sale of a few units of the product) (paras 40-41). (iii) The fact that these goods were available in pharmacies did not mean that they could not also be available in other sales outlets. In any event, the sale, even the exclusive sale, of certain goods in pharmacies did not mean that they were necessarily pharmaceutical preparations or medicinal products (para. 38).



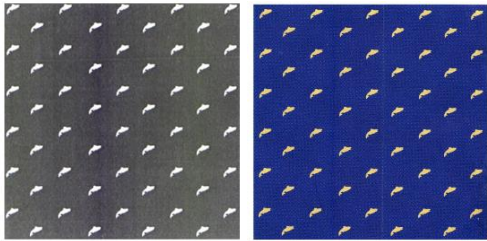

V. Other Cancellations

A. Article 51(1) (a) EUTMR — revocation due to non-use

♦[T-15/16](#); **Cystus**; *Georgios Pandalis v EUIPO*; Judgment of 14 February 2017; EU:T:2017:75; Language of the case: DE. The CD revoked the contested EUTM **Cystus** partially, for *non-medical food supplements* in Class 30, on account of the lack of genuine use. The BoA rejected the appeal, holding that the EUTM proprietor had made only descriptive use of the EUTM and that the goods marketed, such as lozenges, could not be qualified, on the basis of the evidence provided, as *non-medical food supplements* in Class 30. The EUTM proprietor filed an action before the GC. The GC rejected the action. In holding that the contested EUTM was used only descriptively, the BoA had not made any findings on Article 7 EUTMR but had examined whether it had been used in accordance with its main function, as required for genuine use. The BoA therefore had not infringed Article 71(1) EUTMR (paras 14-18). The goods in question contained as a main active ingredient an extract from a plant with the scientific name ‘Cistus Incanus L.’ and the Latin name ‘Cistus’. On the product packaging, ‘Cystus’ appeared to describe this ingredient, in particular as it formed part of the expression ‘Cystus®-Extrakt’ and featured in the list of ingredients. The multiple use and prominent display of ‘Cystus’ on the packaging did not allow it to be perceived as a trade mark. Nor was use of the ® symbol sufficient evidence, as it did not always appear and was also combined with other elements. Furthermore, the spelling with the letter ‘y’ was insufficient to prove genuine use since such variations generally did not render a sign distinctive. In the case in question, the BoA had been right to consider the letters ‘y’ and ‘l’ interchangeable in words of Latin origin and aurally identical in German (Germany being the territory to which the evidence related). Nor did the addition of the figures ‘052’ and ‘52’ endow the sign with distinctive character for the purpose of proving genuine use (paras 42-47). The GC confirmed the BoA’s findings on lack of use in relation to the goods in question. With regard to the legal requirements for goods to be marketed as supplements, as laid down by Directive 2002/46/EC of 10 June 2002 on the approximation of the laws of the Member States relating to food supplements, the EUTM proprietor had not established that the goods could be qualified as such. Furthermore, the allocation of a drug code, used for distribution in pharmacies, and the claims that the goods offered protection against the cold and flu, indicated that the goods were not *non-medical food supplements* in Class 30 (paras 57-59).



♦[T-766/15](#) and [T-767/15](#) (joined cases); **DEVICE OF A PATTERN OF GOLD FISH ON A BLUE BACKGROUND**; *Labeyrie v EUIPO*; Judgments of 28 February 2017; EU:T:2016:617; EU:T:2017:122; Language of the case: FR.

| EUTMs as registered | EUTMs as used |
|---|--|
|  |  |

The BoA confirmed the CD's finding that the two contested EUTMs were to be revoked for all goods in Classes 29, 30 and 31 since they had been used in respect of fish only, and in a way that altered their distinctive character. The GC, dismissing the action, took the position that the less inherently distinctive a sign, the more likely it was that use together with additional elements that were potentially more distinctive would alter this sign's distinctive character (para. 22 and reference to the judgment of 24/09/2015, T-317/14, Shape of a cooking stove, EU:T:2015:689, which was annulled by the CJ in its judgment of 01/12/2016, [C-642/15 P](#), SHAPE OF AN OVEN (3D), EU:C:2016:918 for lack of reasoning). The GC acknowledged that the two EUTMs, despite being registered as figurative marks, might be contourless (para. 27). It also confirmed that the repetitive pattern of stylised fish was distinctive to a low degree only (paras 29-33). A survey concerning the market recognition of the applicant's packaging was irrelevant because it was limited to France (para. 36). Use of signs in combination with others did not necessarily alter their distinctive character. In this case, however, the superimposition of the sign **LABEYRIE**, which was also registered as a mark (para. 47), on the repetitive pattern altered the EUTMs' distinctive character because 'LABEYRIE' was more distinctive and eclipsed the pattern (paras 51-54). The public would perceive the EUTMs as mere backgrounds with an ornamental function rather than as distinctive signs (para. 59). 'The low degree of distinctive character of the contested mark is easily altered by the addition of an element such as the mark **LABEYRIE**, which is in itself distinctive' (para. 60).

♦[T-132/15](#); **popchrono**; *IR v EUIPO*; Judgment of 14 March 2017; EU:T:2017:162; Language of the case: EN. The EUTM proprietor was granted registration of the word mark **POPCHRONO** as an EUTM for goods and services in Class 12. An application for revocation was filed pursuant to Article 58 EUTMR. The CD upheld the application for revocation. The BoA dismissed the EUTM proprietor's appeal. It found that the EUTM proprietor had not proven genuine use of the contested EUTM. The GC found that the evidence of use consisted of the offer of licence agreements to use the contested mark, which cannot be considered genuine use, even this were the intention of the EUTM proprietor. The use by the licensees could have amounted to genuine use, but there was no evidence of any use by them (paras 83-85). The GC did not consider the EUTM proprietor's acts as preparations for



use within the meaning of paragraph 37 of the CJ judgment of 11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, because they did not constitute an advertising campaign and were intended not to promote goods covered by the contested EUTM but rather to promote the mark itself; furthermore, the EUTM proprietor did not show that the goods were about to be marketed, which is an essential condition (paras 88-91). The admissibility of an application for revocation is assessed irrespective of the applicant's motives for revocation, and it is not conditional upon the applicant for revocation having opposed registration of the contested mark beforehand (para. 103). The EUTMR merely provides for the possibility of the Office inviting the parties to settle, without imposing any obligation to that effect (para. 105).

♦[T-239/15](#); **Cryo-Save**; *Cryo-Save AG v EUIPO*; Judgment of 23 March 2017; EU:T:2017:202; Language of the case: DE. An application for revocation was filed pursuant to Article 58(1)(a) EUTMR. The proprietor had to prove that the mark **Cryo-Save** was used for all goods and services, which were mainly special medical apparatus in Class 10; highly specific scientific and technological services, mainly in the area of stem cells, in Class 42; and medical services, also mainly relating to stem cells, in Class 44. The CD upheld the application for invalidity in its entirety as the PoU was considered insufficient. The BoA dismissed the EUTM proprietor's appeal. It found that the documents submitted before the CD, as well as additional documents submitted during the appeal proceedings, were not sufficient to prove use of the contested mark, which therefore had to be revoked. The EUTM proprietor filed an action before the GC, relying on two pleas in law: (i) infringement of Article 63(2) EUTMR and Rule 37(b)(iv) of Implementing Regulation (EC) No 2868/95, and (ii) infringement of Article 58(1)(a) EUTMR. The GC dismissed the appeal. Regarding the issue of PoU, the GC confirmed the BoA decision in its entirety. For the goods in Class 10, no proof had been submitted that the goods had been sold within the relevant period. Regarding some of the services in Classes 42 and 44, there was no proof that doctors or medical personnel had extracted blood or other human tissue, such as stem cells, under the trade mark **Cryo-Save** during the relevant period in the EU. As regards a further group of services in Class 44 (mainly services of a blood bank and a bank for the storage of cell material, in particular a stem cell bank), the vast majority of documents were undated; it was therefore not possible to conclude that there had been genuine use during the relevant period. Nor could the documents prove use as a trade mark, but only as a company name (paras 39-40). Furthermore, no sales figures had been submitted (para. 43).

♦[T-97/16](#); **GEOTEX**; *Martin Kasztantowicz v EUIPO*; Judgment of 4 May 2017; EU:T:2017:298; Language of the case: DE. A cancellation action pursuant to Article 58(1)(a) EUTMR (non-use) was filed against the EUTM **GEOTEK**. The CD sent a fax informing the EUTM owner about the cancellation action and asking the owner to provide evidence of genuine use of the contested EUTM by 24 May 2014. The fax was sent to the fax number provided by the owner in the EUTM application form. The Office had never been informed of any change of number. On 2 June 2014, the CD informed the owner via fax and ordinary mail that the Office had not received any response and that it would therefore take a decision based on the evidence on file. It is undisputed that the owner did not receive the notification. After requesting access to the Office's electronic communication service on 23 June 2014, the owner informed the Office that he had not received any of the notifications due to a change of postal address (no change of fax number was mentioned). He also informed the Office of his new address and sent evidence of use of the earlier mark. On 26 September 2014, the CD annulled the contested EUTM pursuant to Rule 40(5) of Implementing Regulation (EC) No 2868/95 since no PoU had been submitted in due time (namely by 24 May 2014). Upon appeal, the owner offered oral witness statements for the fact that he had changed his postal address. He argued that the evidence had been submitted on time because he had never received the notification of the cancellation request due to his change



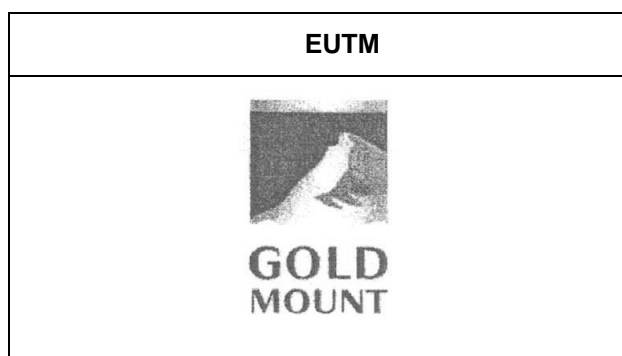
of address. He also offered a witness statement to prove that he had not received the fax, without mentioning any concrete facts in this respect. The BoA confirmed the CD's decision. It held that the Office's fax notifying the cancellation request and setting the deadline for proving genuine use of the contested EUTM had been duly sent by the Office and received by the owner. This was shown by the Office's fax report. The Office had always used the same fax number since the filing of the contested EUTM. The owner had never informed the Office of a change of number. The BoA further held that it enjoyed a power of discretion pursuant to Article 95(2) EUTMR to take into account the evidence filed on 23 June and therefore belatedly. Exercising this power of discretion, it held that the circumstances of the case did not justify taking the belated evidence into account or hearing witnesses. **On Article 58(1) EUTMR in conjunction with Rule 40(5), Rule 61(2) and (3) and Rule 65(1) of Implementing Regulation (EC) No 2868/95:** pursuant to Rule 61(2) of Implementing Regulation (EC) No 2686/95, as interpreted by the GC, any kind of Office decision can be notified via telecopier (fax). Pursuant to Rule 65(1), second sentence, of Implementing Regulation (EC) No 2686/95, a notification is deemed to have been made on the date on which the communication was received by the recipient's telecopying device. It is sufficient that the notification is received by the recipient and that the recipient is in a position to take note of it (the external aspect of notification); actual knowledge (the internal aspect of notification) by the recipient is not necessary (paras 38 to 40). Regarding the external aspect of notification, the sender has to prove that it took measures to ensure that the fax entered the 'sphere' of the recipient. It must prove not only that the fax was sent but also that it was transmitted in a way that would allow the recipient to take note of its content. However, the sender is not obliged to prove that the recipient actually did take note of the content (internal aspect). The sender is not in a position to intrude into the recipient's organisation in order to ensure that note is taken of the communication (para. 41). The GC had already decided in previous judgments that fax reports were sufficient to show receipt of a fax (para. 42). Fax machines report any problem with the transmission or receipt. The lack of an 'error' message and the existence of a fax report showing 'OK' therefore indicated that the fax had been duly sent and received (para. 42). This did not imply that the recipient was not allowed to prove the contrary, for example because of an accident, force majeure or an error outside the recipient's responsibility (paras 43 and 44). However, there was no indication whatsoever on file that the owner had not received the fax in question despite the Office's 'OK' fax report (para. 45). The owner did not argue or submit proof to the contrary, for example in the form of a technical error that could not have been envisaged or prevented by the owner (para. 46). Owing to the fax report and the lack of arguments to the contrary, the Office was entitled to assume that the fax had indeed been received by the owner, thus setting the deadline for proving genuine use (para. 46). The testimonies offered were not relevant because the facts they contained, even if proven, were irrelevant (para. 50).

♦[T-680/15](#); **L'ECLAIREUR**; *Les Éclaires GmbH v EUIPO*; Judgment of 8 May 2017; EU:T:2017:320; Language of the case: EN. The EUTM proprietor was granted registration of the word mark **L'ECLAIREUR** as an EUTM for goods in Classes 3, 4, 9, 14, 18, 20 and 25. An application for revocation was filed pursuant to Article 58 EUTMR. The CD upheld the application for revocation. The BoA partly upheld the EUTM proprietor's appeal. It found that the contested trade mark had been genuinely used for *clothing* and *shoes* in Class 25. The revocation applicant filed an action before the GC. The GC dismissed the action; it agreed with the BoA that there had been genuine use for *clothing* and *shoes*. The Office was merely entitled, but not obliged, to request translation of PoU. Moreover, the revocation applicant had not expressly requested translation during the proceedings before the Office. The principle of the right to be heard and equality of arms had been observed, and there was no effect on the exercise of the revocation applicant's rights of defence, since the latter had been in a position to challenge the documents in question before the Court (paras 15-24).



The intervener was active as a ‘concept store’, retailing ‘luxury products’, inter alia ‘clothing’ and ‘shoes’. There was some evidence that the EUTM proprietor had collaborated, on several occasions, with other fashion designers and fashion labels; consumers had therefore encountered textile products labelled with marks composed of both the name of the designer and the mark **I’Eclaireur**. Such goods were always presented in such a way that the mark at issue was easily identifiable, even in all of the cases in which it was preceded by the name of the specific creator. The fact that some particular lines of products were offered in very limited series was a logical consequence of the concept, common in the fashion sector, of offering consumers a luxury product, often novel and exclusive, at a high price. Evidence that the EUTM proprietor had purchased certain goods was relevant because, as the latter was a retail store, it was reasonable to conclude that it had purchased the goods in question in order to resell them to the end consumers. The sworn declaration could not be rejected at the outset merely because it was made by the EUTM proprietor. It contained sound information that was supported by data from other evidence submitted by the intervener (paras 50-76). The EUIPO Guidelines were not binding legal acts for the purpose of interpreting provisions of EU law (para. 80). The BoA could draw inferences from the evidence, as an overall assessment of the facts had to be made, taking account of all the relevant factors in the particular case and the interdependence between those factors. Therefore, it had indeed been for the BoA to place the evidence within the context of the economic sector in question (para. 85).

♦[T-294/16](#); **GOLD MOUNT**; *Kaane American International Tobacco Company FZE v EUIPO*; Judgment of 8 June 2017; EU:T:2017:382; Language of the case: EN.





On 21 August 2009, the EUTM proprietor was granted registration of the figurative mark represented above as an EUTM for goods in Class 34. On 22 October 2014, a request for revocation was filed on the grounds that the mark had not been put to genuine use pursuant to Article 58(1)(a) EUTMR. The EUTM proprietor presented evidence that the EUTM had been used, arguing that, in any event, there were proper reasons for non-use because tests were being carried out on the products in question (cigarettes). On 28 July 2015, the CD upheld the request for revocation. The BoA dismissed the EUTM proprietor’s appeal. It found that the evidence adduced did not make it possible to establish that the mark at issue had been put to genuine use in the EU during the relevant period. It also found that there were no proper reasons for non-use of the mark. The EUTM proprietor filed an action before the GC, relying on a single plea in law: infringement of Article 58(1)(a) EUTMR. First, it challenged the BoA’s finding that proof of genuine use of the mark at issue had not been furnished. Second, it disputed the conclusion that there were no proper reasons for non-use of that mark. **Evidence of use:** the EUTM proprietor’s challenge focused on the evidence of the EUTM proprietor’s participation in international trade fairs. The BoA had found, inter alia, that the photographs adduced by the EUTM proprietor to prove use did not show use of the mark



as registered because the graphic element showing a mountain, which is a co-dominant element of the EUTM as registered, did not appear in the evidence. The EUTM proprietor argued that that evidence showed that the trade fairs had taken place during the relevant period for proving use and that the BoA had not taken into account that such fairs attracted participants from all over the world, were held only once a year and required significant investment in terms of both time and money. Therefore, attendance at one trade fair per year should have been considered enough to show that the EUTM proprietor was making serious attempts to acquire a relevant position in the EU tobacco market and that it had made significant investments in order to promote its products on that market. The GC pointed out that the EUTM proprietor had not challenged the BoA’s finding that no use had been shown of the mark as registered. Consequently, the reason that the BoA had discounted the evidence on trade fairs was not disputed by the EUTM proprietor (para. 28). Furthermore, the EUTM proprietor had not disputed one of the reasons given by the BoA for the sake of completeness, namely that there was no evidence that its participation in international trade fairs had targeted the public in the EU (para. 30). It followed that the EUTM proprietor’s arguments could not call into question the BoA’s conclusion that evidence of genuine use of the mark at issue had not been furnished (para. 31). **Proper reasons for non-use:** the EUTM proprietor had submitted several test results showing that its cigarettes exceed the maximum level of carbon monoxide emission, as regulated by Directive 2014/40/EU concerning the manufacture, presentation and sale of tobacco and related products. The GC stressed that, according to the case-law, the concept of proper reasons for non-use referred to circumstances unconnected with the trade mark proprietor rather than to circumstances associated with commercial difficulties experienced by it, and that problems associated with the manufacture of products fell under the latter (para. 43). In the case in question, the fact that a third party had carried out tests on the cigarettes did not allow the conclusion to be drawn that the manufacture of those cigarettes was independent of the EUTM proprietor’s will. It was for the EUTM proprietor to decide when it was going to have the tests carried out and to ensure that its cigarettes were compliant with the EU legislation. The BoA had therefore correctly found that the manufacture of cigarettes that complied with the EU legislation depended on the will of the EUTM proprietor (paras 45 and 46).

♦[T-287/15](#); **real,-**; *Tayto Group Ltd v EUIPO*; Judgment of 28 June 2017; EU:T:2017:443; Language of the case: EN.

| EUTM as registered | EUTM as used |
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The EUTM proprietor was granted registration of the figurative mark represented above as an EUTM for goods and services in Classes 3, 8, 16, 18, 20, 21, 22, 24, 25, 28, 29, 30, 31 and 32. An application for revocation was filed pursuant to Article 58 EUTMR. The CD upheld the application for revocation. The BoA partially upheld the EUTM proprietor’s appeal. It found that the contested mark had been put to genuine use for some of the goods covered by it. The revocation applicant filed an action before the GC, relying on six pleas in law: (i) infringement of Article 18(1) EUTMR, (ii) infringement of Article 18(2) EUTMR, (iii)



infringement of Articles 71 and 95 EUTMR, (iv) infringement of Article 58(1)(a) EUTMR, (v) infringement of Article 94 EUTMR, and (vi) misuse of power and infringement of general principles of law. **First plea:** in its review of the lawfulness of the contested decision, the GC did not have to assess the distinctive character of the mark at issue, but to ensure that the BoA had correctly assessed the effect of additions to that mark (para. 27). The element ‘quality’, which is situated below the mark at issue, mainly under the element ‘real’, and is written in blue upper case letters that are smaller than the letters in the word element ‘real’, had a merely laudatory character and was distinctive only to a low degree. The addition, in the mark used, of stylisation in the form of a label within which both the elements of the mark at issue and the element ‘quality’ are placed, was purely ornamental since in the background of the mark at issue and therefore in an ancillary position, which does not confer on it any distinctive character of its own (para. 34). Although a company name or shop name is limited to identifying a company, it may also constitute a trade mark if used as such. The mark at issue had not been used solely as a company name (paras 41-42). **Second plea:** since the EUTM proprietor has demonstrated to the requisite legal standard that there was use of the mark at issue, therefore proving that that mark was used by a third party, it had to be accepted that that mark was used with the EUTM proprietor’s consent (para. 60).

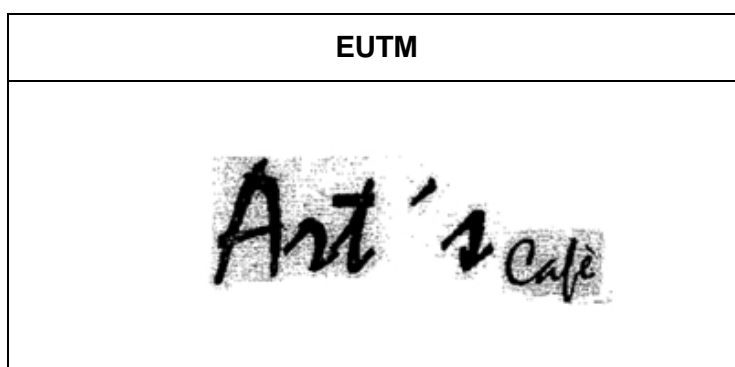
[T-427/16](#) to [T-429/16](#) (joined cases); **AN IDEAL WIFE, AN IDEAL LOVER, AN IDEAL HUSBAND**; *Isabel Martín Osete v EUIPO*; Judgment of 29 June 2017; EU:T:2017:455; EU:T:2017:455; Language of the case: EN. The EUTM proprietor was granted registration of the word marks **AN IDEAL WIFE, AN IDEAL LOVER** and **AN IDEAL HUSBAND** as EUTMs for goods in Class 3. Three applications for revocation were filed pursuant to Article 58 EUTMR. The CD upheld the applications for revocation. The BoA dismissed the EUTM proprietor’s appeal. It found that there was no genuine use of the EUTMs and that there were no proper reasons for non-use. The EUTM proprietor filed three actions before the GC, relying on a single plea in law: infringement of Article 58(1)(a) EUTMR. The GC dismissed the actions. **Genuine use:** the EUTM proprietor had produced no invoices, no sales figures, no advertising figures and no data indicating the market share of the perfumery products marketed under the registered marks. The EUTM proprietor produced a table she had compiled with a view to summarising the sales figures for the perfumes protected by the registered marks. For the period from 12 December 2006 to 12 March 2012, the EUTM proprietor had sold perfumes under those three marks for a total of EUR 2 385 and GBP 3 733. The figures for the sales of the perfumes protected by the registered marks were particularly low, given that the price of each perfume was between EUR 18 and 60, and between GBP 4 and 30. The smaller the commercial volume of the use of the mark, the more essential it was for the proprietor of the mark to produce additional evidence to dispel any doubts as to the genuineness of that mark’s use. The sales that she claims to have made under the registered marks were made at a number of literary salons, in particular those organised by the Oscar Wilde Society in Paris, and at infrequent meetings with a small number of loyal customers. In addition, the advertising documents and the correspondence with potential suppliers, which was not supported by any evidence such as invoices or purchase orders, did not make it possible to find a high degree of intensity or consistency over time in the use of the marks and therefore did not make it possible to remove potential doubts as to the genuine use of the marks in question. The EUTM proprietor failed to prove genuine use. **Proper reasons for non-use:** the rules of IFRA and of the European Union apply to all operators in the perfumes sector and not just to the EUTM proprietor. Compliance with the applicable rules is inherent in any commercial activity and cannot, unless a particularly broad interpretation of the concept of ‘proper reason for non-use’ is to be adopted, justify the absence of genuine use during the relevant period. The problems associated with the manufacture of the products of an undertaking form part of the commercial difficulties encountered by that undertaking. The concept of proper reasons refers to circumstances



unconnected with the trade mark proprietor rather than to circumstances associated with commercial difficulties experienced by it. The existence of complex regulations applicable in a certain field cannot be regarded as an obstacle that makes it impossible or unreasonable to use registered marks.

♦[T-110/16](#); **SAVANT**; *Savant Systems LLC v EUIPO*; Judgment of 18 July 2017; EU:T:2017:521; Language of the case: EN. The EUTM proprietor was granted registration of the word mark **SAVANT** for goods and services in Classes 9, 16, 41 and 42. An application for revocation was filed pursuant to Article 58 EUTMR. The CD upheld the application for revocation in respect of all the goods and services registered with the exception of *computer software services; computer programming services, consultancy services relating to computer software* in Class 42, for which the application for revocation was rejected. The BoA partly upheld the EUTM proprietor’s appeal. It found that genuine use had been proven not only for *computer software services; computer programming services, consultancy services relating to computer software* in Class 42, which were not covered by the appeal, but also for the other services in Classes 41 and 42 and for *computer software* in Class 9. The invalidity applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 58(1)(a) EUTMR in conjunction with Article 18 EUTMR; (ii) breach of the duty to state reasons. **Revocation due to non-use**: the GC dismissed the claim that the evidence had demonstrated use of the company name rather than use of the mark or that there was no link between the sign used and the relevant services. The GC stated that use of the trade name in invoices could be such as to establish genuine use of the registered mark (para. 31). In addition, the representation of the contested mark alongside other sub-brands corresponded to the situation where a number of signs are used simultaneously without changing the distinctive character of the registered sign (para. 32). Furthermore, as the mark may not be affixed to services, the link between the sign and the services has to be established through other indirect means. In the case in question, there was such a link in that the mark appeared at the top of each invoice, and in brochures, advertisements and articles in newspapers. These documents informed the customer of the origin of the goods and services. The GC also dismissed the arguments alleging that the evidence was insufficient to establish genuine use for all the goods and services claimed.

♦[T-309/16](#); **Art’s Café**; *Café’ Pont SL v EUIPO*; Judgment of 20 July 2017; EU:T:2017:535; Language of the case: EN.



The applicant was granted registration of the figurative mark represented above as an EUTM for goods in Class 30. An application for revocation was filed pursuant to Article 58(1)(a) and Article 63(1) EUTMR. The CD revoked the mark insofar as it had not been genuinely used in a form that did not differ from the registered mark by elements that altered its distinctive character. The BoA dismissed the appeal. The applicant filed an action before the GC,




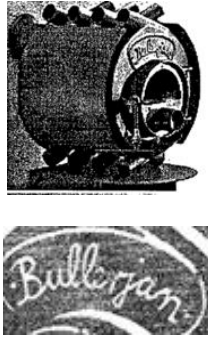
relying on a single plea in law: infringement of Article 58(1)(a) in conjunction with Article 18(1)(a) EUTMR. The GC, dismissing the action, stated that the BoA had not erred in concluding that the evidence provided by the applicant was not capable of demonstrating genuine use of the mark at issue (from the point of view of the nature of that use) during the relevant period (para. 21). In particular, the BoA had found lack of genuine use of the mark at issue because the evidence produced by the applicant for that purpose did not show the mark at issue either in the form in which it was registered or in a form that did not alter its distinctive character within the meaning of Article 18(1)(a) EUTMR. Nor did the evidence satisfy the criterion relating to the nature of the use of the mark at issue within the meaning of Article 58(1)(a) EUTMR (para. 19). Additionally, the GC pointed out that the figurative element of the mark at issue, whose graphic presentation was neither negligible nor trivial, was a distinctive element of it, such that the use of a word mark without that element could not constitute use of the mark at issue within the meaning of Article 58(1)(a) EUTMR, read in conjunction with Article 18(1)(a) EUTMR. Considering the descriptive character of the word 'café' for that product, the figurative element of the mark at issue had to be regarded as an important element of that mark (para. 20). As a result, the mark had to be revoked.

♦[T-276/16](#); **Boswelan**; *Viridis Pharmaceutical Ltd v EUIPO*; Judgment of 15 September 2017; EU:T:2017:611; Language of the case: DE. The EUTM proprietor was granted registration of the word mark **Boswelan** as an EUTM for *pharmaceutical products and health-care products* in Class 5. An application for revocation due to a lack of genuine use was filed pursuant to Article 58(1)(a) EUTMR. The CD upheld the application for revocation. The BoA dismissed the EUTM proprietor's appeal. It found, in particular, that use of the EUTM in the context of a clinical trial did not constitute outward use aimed at marketing or advertising a product on the pharmaceutical market. Nor could it be qualified as preparatory to subsequent marketing, given the point in time, long before the actual marketing, the ongoing clinical trial phase and the lack of a request for marketing authorisation. Under these circumstances, conducting a clinical trial could not be considered a proper reason for non-use as the EUTM proprietor was responsible for such trials, and in particular for how long they lasted. Only once the proprietor had submitted a request for the required marketing authorisation would this responsibility shift to the public authorities. The EUTM proprietor filed an action before the GC, relying on three pleas in law: (i) infringement of Article 58(1)(a) EUTMR with respect to the lack of genuine use, (ii) infringement of Article 58(1)(a) EUTMR with respect to proper reasons for non-use, and (iii) breach of its legitimate expectations arising from the Office's Guidelines under Article 107 EUTMR. The GC dismissed the appeal. It confirmed that, under the circumstances of this case, use in the context of a clinical trial, including promotions in relation thereto, was insufficient to support genuine use, for which external use with a view to creating or preserving an outlet for the goods was essential. Such use could only follow marketing authorisation as pharmaceutical regulations prohibited any prior advertising for the purpose of gaining an outlet for the goods (paras 35-36). Furthermore, the EUTM proprietor had not established that the marketing of the goods was imminent (paras 37-38). Conducting a clinical trial might give rise to proper reasons for non-use. However, in the case in question, use of the EUTM was not legally required for the trial and had been the proprietor's choice, despite the uncertainties as to when or even if the pharmaceutical might be marketed. Furthermore, the length of trials depended on the proprietor's financial investment. In the case in question, the authorisation to conduct the trial had been requested more than 3 years after the EUTM's registration. As these circumstances were not unconnected with the proprietor, they did not justify the lack of genuine use (paras 54-63). The Office's guidelines, according to which clinical trials were typical examples of proper reasons for non-use, did not amount to concrete assurance that the proprietor's clinical trial qualified as such. Therefore, the proprietor could not rely on legitimate expectations (paras 67-70).



♦[T-143/16](#); **INTESA**; *Intesa Sanpaolo SpA v EUIPO*; Judgment of 4 October 2017; EU:T:2017:687; Language of the case: EN. The EUTM proprietor was granted registration of the word mark **INTESA** as an EUTM for goods and services in Classes 16, 35, 36, 38, 41 and 42. An application for revocation was filed pursuant to Article 58 EUTMR. The CD partly upheld the application for revocation, namely for all goods and services in Classes 16, 38 and 41 and for some services in Classes 35, 36 and 42. The BoA dismissed the appeal. It found that genuine use had not been sufficiently proven for the goods and services for which the CD had revoked registration. The EUTM proprietor filed an action before the GC, relying on a single plea in law: infringement of Article 58(1)(a) and (2) EUTMR. The GC dismissed the appeal. *Advertising and office functions* in Class 35 had not been proven to be services offered to third parties. Their use was merely internal, in support of the company’s own management and business activities (paras 29-35). Genuine use for *real estate affairs* in Class 36 had not been demonstrated. There was no evidence on the commercial significance of the use and no turnover figures or invoices had been provided (paras 38-42). The website used by the EUTM proprietor as a vehicle for promoting its financial services did not constitute evidence of offering *telecommunications* and *electronic transmission of documents* in Class 38 to third parties. No proof of such ‘technical services’ had been submitted (paras 50-54). The *providing of education; providing of training; amusements; and sporting and recreational activities* in Class 41 to third parties had also not been proven. The purpose of contracts provided was to raise funds rather than offer training. Cards enabling customers to benefit from special offers at cultural and entertainment events could not be perceived as automatically relating to the *amusements* or *sporting and recreational activities* that the EUTM proprietor claimed to offer. As they were rather part of a business promotion plan aimed at rewarding customers for loyalty. No relevant turnover figures had been submitted in connection with the services in question in Class 41 (paras 57-61). As regards services allegedly rendered in connection with *scientific and technological services and research and design relating thereto; design and development of computer hardware and computer software; and legal services* in Class 42, the evidence of use was not sufficient either. Although it was not without any evidential value, there was no reference to the duration or commercial volume of those services (paras 65-67).

[T-211/14](#) **RENV**; **SHAPE OF AN OVEN**; *Toni Klement v EUIPO*, Judgment of 10 October 2017; EU:T:2015:688, Language of the case: DE.



| EUTM as registered | EUTM as used |
|---|--|
|  |  |

In revocation proceedings for non-use, the EUTM proprietor had to show use for the 3D-mark represented above (on the left). In the evidence submitted, the EUTM proprietor established



use of the contested EUTM in combination with the word mark ‘Bullerjan’ (on the right). The CD dismissed the revocation request as it considered this use to be in conformity with Article 18(1)(a) EUTMR. The BoA dismissed the appeal. The use shown of the contested EUTM would both be use ‘as a trade mark’ and use in a form that did not alter its distinctive character. Arguments relating to the alleged functional character and alleged lack of distinctiveness of the contested EUTM would be inadmissible in revocation proceedings. As in its previous judgment of 01/12/2016, [C-642/15 P](#), *SHAPE OF AN OVEN (3D)*, EU:C:2016:918, annulled by the CJ for lack of comprehensive reasoning, the GC dismissed the invalidity applicant’s action for annulment. The GC first dismissed the invalidity applicant’s claim according to which the use shown would not constitute use ‘as a trade mark’. It found that the invalidity applicant had in reality questioned the distinctive character — and thus the validity — of the contested EUTM. This would be inadmissible in revocation proceedings for non-use (paras 25-29). The GC also dismissed the invalidity applicant’s claim second claim, according to which the use shown of the contested EUTM — namely its combination with the word mark ‘Bullerjan’ — would constitute use in a form that altered its distinctive character. On the one hand, the contested EUTM would possess a high level of distinctive character (paras 38-46). On the other hand, the combination of the contested EUTM with the word element ‘Bullerjan’ in the sign as used would not modify the form of the contested EUTM as (i) the distinctive form (shape) remained identical and (ii) it would still be perceived as such — as an indicator of origin — by the relevant consumer. Overall, the word mark would be less eye-catching (‘moins frappante’ in FR; ‘fällt ... weniger auf’ in DE) because, inter alia, the combination of shape and word marks would be common in the relevant market (para. 47).

♦ [T-404/16](#); **SHAPE OF A PACKET OF BISCUITS (3D)**; *Galletas Gullón, SA v EUIPO*; Judgment of 23 October 2017; EU:T:2017:745; Language of the case: EN.



| EUTM as registered | EUTM as used |
|---|---|
|  |  |

The 3D EUTM represented above was registered for *biscuits* in Class 30. An application for revocation was filed pursuant to Article 51(1)(a) EUTMR. The CD dismissed the application for revocation. The BoA annulled the CD decision and revoked the applicant’s rights in the contested mark on the grounds of non-use for the goods in question, as the mark was used in a form that — according to the BoA — altered its dominant elements, such as the colouring of the packaging and the house mark. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 58(1) EUTMR. Despite the brevity of the application, the GC dismissed the plea of inadmissibility put forward by the intervener, considering that the information contained in the application allowed both the GC to rule on the action, and the defendant and intervener to prepare their defence (paras 18-19). The GC found that the only differences between the registered EUTM and the mark as used were the white colour in the upper part of the packaging and the stylisation of the element ‘gullón’ and of the letter ‘O’ and the number ‘2’; these were considered minor changes, ornamental in



nature, that did not significantly alter the overall impression created by the registered mark (para. 32). Use of the EUTM in a different colour combination could not alter the distinctive character of the registered mark, since the colour combination ‘blue-yellow-blue’ was not a distinctive or dominant element of the registered mark, and colours possessed little capacity for conveying specific information, especially when they were relatively commonplace. They would be understood as elements for purely aesthetic purposes or as presentational features rather than as an indication of commercial origin (para. 33). As regards genuine use, the GC noted that the fact that the mark was not referred to on invoices did not mean that the latter were irrelevant for proving genuine use of that mark (para. 51). The GC found that the extent of use was sufficient to amount to a real and serious commercial effort (para. 55). Furthermore, despite the limited commercial volume of the use of the mark, the very regular invoices made it possible to conclude that use of the mark had been genuine (paras 56 and 60). Finally, it was not relevant whether the goods in question reached the consumers, since genuine use only required a mark to be used publicly and outwardly (para. 62).

♦ [T-418/16](#); **SHAPE OF A PACKET OF BISCUITS (3D)**; *Galletas Gullón, SA v EUIPO*; Judgment of 23 October 2017; EU:T:2017:745; Language of the case: EN.

| EUTM as registered | EUTM as used |
|---|--|
|  |  |

The 3D EUTM represented above was registered for *biscuits* in Class 30. An application for revocation was filed pursuant to Article 58(1)(a)EUTMR. The CD dismissed the application for revocation. The BoA annulled the CD decision and revoked the applicant’s rights in the contested mark on the grounds of non-use for the goods in question, as the mark was used in a form that — according to the BoA — altered its dominant elements, such as the colouring of the packaging and the house mark. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 58(1) EUTMR. Despite the brevity of the application, the GC dismissed the plea of inadmissibility put forward by the intervener, considering that the information contained in the application allowed both the GC to rule on the action, and the defendant and intervener to prepare their defence (paras 18-19). The GC found that the only differences between the registered EUTM and the mark as used were the white colour in the upper part of the packaging, the stylisation of the element ‘gullón’ and of the letter ‘O’ and number ‘2’, and the addition of the descriptive term ‘chocolate’ to the element ‘mini O2’; these were considered minor changes, ornamental in nature, that did not significantly alter the overall impression created by the registered mark (para. 32). Use of the EUTM in a different colour combination could not alter the distinctive character of the registered mark, since the colour combination ‘red-yellow-red’ was not a distinctive or dominant element of the registered mark, and colours possessed little capacity for conveying specific information, especially when they were relatively commonplace. They would be understood as elements for purely aesthetic purposes or as presentational features rather than as an indication of commercial origin (para. 33). As regards genuine use, the GC found that the fact that the mark was not referred to on invoices did not mean that the latter were



irrelevant for proving genuine use of that mark (para. 51). The GC found that the extent of use was sufficient to amount to a real and serious commercial effort (para. 55). Furthermore, despite the limited commercial volume of the use of the mark, the very regular invoices made it possible to conclude that use of the mark had been genuine (paras 56 and 60). Finally, it was not relevant whether the goods in question reached the consumers, since genuine use only required a mark to be used publicly and outwardly (para. 62).

♦[T-419/16](#); *Carrera*; *Carrera Brands Ltd v EUIPO*; Judgment of 16 November 2017; EU:T:2017:812; Language of the case: DE. In 2005, Autec AG, the applicant for revocation, gave a contractual undertaking vis-à-vis Lutter & Partner GmbH not to challenge any trade mark application containing the term 'CARRERA'. In 2007, Lutter & Partner was granted registration of the word mark CARRERA as an EUTM for goods and services in Classes 7 to 11 and 21. The mark was then transferred to L+P holding GmbH, before being transferred to Carrera Brands, the EUTM proprietor. In 2012, an application for revocation was filed by Autec AG. The CD upheld the application for all the goods. The BoA partly upheld the EUTM proprietor's appeal since genuine use of the mark was proven for some of the goods. However, it rejected the request for suspension of proceedings. It also found that the no-challenge agreement could not have any effect on the obligation to use the mark. The proprietor filed an action before the GC, relying on two pleas in law: (i) infringement of Article 63(1)(a)EUTMR, and (ii) infringement of Rule 20(7)(c) of Implementing Regulation (EC) No 2868/95. The GC dismissed the appeal. **Legitimate interest in bringing revocation:** Article 63(1)(a)EUTMR makes no reference to an interest in bringing an application for revocation. According to Recital 10 of the same Regulation, there is no justification for protecting a trade mark that is not actually used. Consequently, it is apparent that the legislature did not intend to restrict the circle of persons able to apply for revocation. Therefore, a no-challenge agreement cannot affect the admissibility of the action (paras 31-35). The fact that no-challenge agreements may be taken into account by a national court on the basis of national law is irrelevant in proceedings before the Office (para. 38).

♦[T-802/16](#); **FEMIBION**; *Endoceutics, Inc. v EUIPO*; Judgment of 17 November 2017; EU:T:2017:818; Language of the case: EN. Registration as an EUTM for goods in Class 5 (*Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; disinfectants*) was sought for the word mark **FEMIBION**. An application for revocation against all the goods covered by the mark was filed, based on Article 58(1)(a) EUTMR. The CD partially upheld the application, since it found that genuine use of the mark at issue had been shown only for the *dietetic substances adapted for medical use*, in respect of which registration of the mark at issue had been maintained. An appeal was filed against the CD's decision by the EUTM applicant. The BoA partially upheld the appeal and annulled the CD's decision regarding maintenance of the mark's registration for the abovementioned goods. The revocation applicant filed an action before the GC, requesting annulment of the BoA decision and revocation of the mark for *pharmaceutical preparations for immune system support, for menopause, for menstruation, for treatment and management of pregnancy, for the prevention, treatment and management of stress, for the prevention, treatment and management of stress [caused by] ill-balanced or deficient nutrition*. The applicant relied on a single plea in law before the GC: infringement of Article 58(1)(a) EUTMR. **Assessment of genuine use:** the main issue addressed by the GC was the classification of the goods in Class 5 subcategories in respect of which genuine use had been shown and, therefore, the limitation of protection strictly to subcategories where the mark had actually been used. It was found that genuine use of the mark had not been shown for *pharmaceutical preparations for immune system support, for menopause, for menstruation, for treatment and management of pregnancy, for the prevention, treatment and management of stress, for the prevention, treatment and management of stress [caused by]*



ill-balanced or deficient nutrition, but only for *dietetic substances adapted for medical use* (para. 7), for the following reasons: (i) The products ‘Femibion@ Healthy Pregnancy’, ‘Femibion@ Energetic Mum’, ‘Femibion@ Balance’, ‘Femibion@ Radiance’ and ‘Femibion@ Healthy Bones’ were, according to the evidence, nutritional supplements (para. 30), the use of which was intended to treat certain health problems (not diseases), such as physical symptoms resulting from hormonal changes frequently experienced by women, those associated with the transition to menopause, during menstruation or in times of stress. Therefore, they were not intended to treat or prevent a disease, but rather to address nutritional deficiencies resulting from normal physiological processes (paras 34, 36 and 37). (ii) Regarding the product ‘Femibion Flore Intime vaginal gel’, even though this clearly could not be classified as a *food supplement* or a *dietetic substance*, nor could it be classified as a *pharmaceutical preparation*. Furthermore, even if it were a *pharmaceutical preparation*, its use could not be classified as genuine due to insufficient evidence of use (only two invoices proving the sale of a few units of the product) (paras 40-41). (iii) The fact that these goods were available in pharmacies did not mean that they could not also be available in other sales outlets. In any event, the sale, even the exclusive sale, of certain goods in pharmacies did not mean that they were necessarily pharmaceutical preparations or medicinal products (para. 38).

♦[T-771/15](#); **BITTORRENT**; *Hochmann Marketing GmbH (formerly Bittorrent Marketing GmbH) v EUIPO*; Judgment of 12 December 2017; EU:T:2017:887; Language of the case: EN. The applicant was the proprietor of the EUTM registration for the word sign **BITTORRENT** for Classes 35, 38 and 42. The intervener, BitTorrent Inc., filed an application for revocation of the mark at issue, based on Article 58(1)(a) EUTMR, on the ground that this mark had not been put to genuine use in the EU in connection with the services concerned within a continuous period of 5 years. The Office notified the applicant that it had 3 months within which to submit evidence of use of the mark at issue. Following a request from the applicant, the Office extended this time limit (which expired on 19 October 2011), by one month (i.e. to 21 November 2011, since 19 November 2011 was a Saturday). On 21 November 2011, the last day of the time limit for establishing genuine use of the mark at issue, the applicant sent a five-page letter by fax, which referred to attached documents. However, no documents were attached. By fax of 23 November 2011, the applicant’s representative informed the Office that it had not sent all the documents due to a fax machine failure. On 24 November 2011, the Office received by post the 69 pages of items of evidence referred to in the five-page letter sent by fax on 21 November 2011. The BoA held that the applicant had submitted no relevant proof before the CD within the time limit specified, and therefore the evidence submitted before the BoA could not be taken into account. The BoA therefore held that genuine use of the mark at issue had not been proven and that the mark had to be revoked. For the sake of completeness, the BoA nonetheless assessed the evidence submitted late before the CD, as well as that submitted before the BoA at the appeal stage, and held that it did not prove use of the mark at issue. The applicant raised two pleas: (i) infringement of Article 95(1) and (2) EUTMR and (ii) infringement of Article 58(1)(a) EUTMR. **Regarding the first plea in law:** in EUTM revocation proceedings, it is for the EUTM proprietor, and not the Office of its own motion, to establish genuine use of the mark concerned (paras 28, 29 and 30). The rule that the Office is to examine the facts of its own motion, as laid down in Article 95(1) EUTMR, does not apply to the question of proof of genuine use of the EUTM in revocation proceedings brought before the Office (para. 31). Regarding the evidence submitted late before the CD, the Office may disregard facts or evidence that are not submitted in due time by the parties concerned and has broad discretion to decide whether or not to take such information into account (paras 33, 36). Where the Office is called upon to rule on an application for revocation, the taking into account of belated evidence is particularly likely to be justified where the material



is complementary to evidence submitted within that time limit and the Office considers, firstly, that it is likely to be relevant to the outcome of the application for revocation and, secondly, that the circumstances and the stage of the proceedings do not argue against it being taken into account (para. 40). In this case, only the letter sent by fax on 21 November 2011 was produced by the applicant before the CD within the period specified (para. 41). The letter submitted within the prescribed period was a five-page document but clearly contained only statements that were not substantiated by any supporting evidence capable of adducing proof of the place, time, extent and nature of use of the mark at issue, since the evidence was not submitted until 3 days after the prescribed period had expired. The BoA was thus correct in concluding that no proof had been submitted in due time before the CD (para. 45). The reason behind the failure to meet the deadline showed inexcusable negligence and was not attributable to exceptional circumstances that could not have been predicted from experience (paras 49-51). The BoA duly took into account all the relevant circumstances concerning the belated evidence (para. 52). With regard to the items produced before the Landgericht Berlin in 2010, the mark contested in those proceedings was not the EUTM at issue but a German mark registration **BITTORRENT**, and the territory was Germany rather than, as in this case, the EU (para. 56). With regard to the items produced in May 2008 in opposition proceedings against the intervener, the applicant referred to these only before the BoA. In addition, they were insufficient to prove genuine use of the EUTM as they consisted only of a very brief description of the website 'bittorrent.net' and three extracts from that website (para. 57). As to the evidence submitted for the first time before the BoA, since no PoU of the EUTM had been filed before the CD within the prescribed period and since the evidence submitted at the appeal stage was not by way of complement to the evidence produced within that period, the applicant could not argue that the evidence submitted before the BoA was additional evidence that should have been taken into account (para. 63). Furthermore, the applicant had not filed a request for either the continuation of proceedings under Article 105 EUTMR or *restitutio in integrum* under Article 104 EUTMR (para. 65). **Regarding the second plea in law:** with regard to the arguments presented in the context of the first plea in law, no genuine use of the mark at issue had been proven by the applicant (para. 67).

B. Article 59(1) (b) EUTMR — bad faith

♦[T-23/16](#); **Formata**; *Ilona Biernacka-Hoba v EUIPO - Formata Bogusław Hoba*; Judgment of 8 March 2017; EU:T:2017:149; Language of the case: PL. The case concerned an invalidity action between ex-spouses who had previously run a family business together. The invalidity applicant (Ilona Biernacka-Hoba) filed a request for a declaration of invalidity against the EUTM 'FORMATA' (fig.) registered by her former husband. She invoked an earlier IR with effect in Slovakia for an identical mark. She also relied on an earlier Polish registration (which had expired) and invoked bad faith. The BoA rejected the invalidity action. With regard to relative grounds for invalidity, the BoA found that the invalidity applicant had not proven her entitlement to rely on the earlier mark, as the renewal certificate filed showed that the owner was 'Przedsiębiorstwo Produkcyjno Handlowo Usługowe Formatta II Ilona Biernacka-Hoba' (which the BoA had considered to be a company), while the invalidity applicant was Ilona Biernacka-Hoba (a natural person). The invalidity applicant filed an action before the GC, claiming infringement of Article 59(1)(b) EUTMR. She argued, in particular, that, according to the Polish Civil Code, business activities run by a natural person (not having a corporate form) could use any indications (fanciful or describing the business) in addition to the name and surname of the person running the business. Therefore, it was clear from the indication of the name on the renewal certificate 'Przedsiębiorstwo



Produkcyjno Handlowo Usługowe Formatta II Ilona Biernacka-Hoba' that the owner was not a company but Ilona Biernacka-Hoba running her business as a natural person. **Bad faith:** as regards bad faith, the GC confirmed the BoA's decision. The fact that the EUTM proprietor did not make any submissions before the Office in reply to the invalidity request did not lead to a presumption of bad faith (para. 46). As regards the specific circumstances of the case, in particular the divorce of the parties and the division of property between them, the invalidity applicant had failed to submit sufficient evidence to demonstrate bad faith on the part of the EUTM proprietor.

♦ [T-132/16](#); **VENMO**; *PayPal, Inc. v EUIPO*; Judgment of 5 May 2017; EU:T:2017:316; Language of the case: EN. An invalidity request based on Article 59(1)(b) EUTMR was filed against the sign **VENMO**, which was registered as an EUTM for goods in Class 9 and services in Class 36. The invalidity applicant (a predecessor-in-title of the applicant before the GC) claimed to have used a trade mark **VENMO** in the United States before the application for the contested EU trade mark. It also referred to prior contacts and negotiations between the parties. The CD did not confirm the alleged bad faith. The BoA confirmed this view. It restated that the burden of proving bad faith lay with the invalidity applicant. It found that the invalidity applicant had not proven the circumstances justifying the alleged bad faith. It also restated the principle of territoriality in the trade mark law and decided that the mere existence of a trade mark right in another country did not prevent an application for that same mark as an EUTM; nor did this necessarily indicate bad faith. The BoA's decision was annulled by the GC pursuant to Article 59(1)(b) EUTMR. The GC restated that the EUTM registration system was based on the 'first-to-file' principle laid down in Article 8(2) EUTMR (para. 31). Where the applicant for a declaration of invalidity sought to rely on that ground, it was for that party to prove the circumstances that substantiated a finding that the EUTM proprietor had acted in bad faith when it filed the application for registration of that mark (para. 33) as well as the other circumstances to be taken into account, according to the CJ, when assessing bad faith (para. 36). It emphasised that the fact that the EUTM applicant knew or must have known that a third party had long been using an identical or similar sign for identical or similar goods that might give rise to confusion with the sign for which registration is sought, was not sufficient in itself to permit the conclusion that the application had been made in bad faith (para. 38). The GC took the view that the analysis carried out by the BoA in that regard had not been based on all of the relevant factors and was vitiated by factual errors, as became apparent at the oral hearing (paras 55 and 65). The GC further found that, as it was undisputed that the intervener (the EUTM proprietor) had known about the applicant's use of the sign **VENMO**, assessment of the latter's reputation was irrelevant for determining whether the EUTM owner knew or should have known that a third party was using an identical or similar sign for identical or similar goods that might give rise to confusion with the sign for which registration was sought. Taking into account the lack of any substantial reputation, while it could not be argued that the EUTM proprietor had sought to take advantage of the rights conferred by the EUTM with the sole aim of competing unfairly with a competitor that was using a sign that, because of characteristics of its own, had by that time obtained some degree of legal protection, this was also not sufficient in itself to exclude the existence of bad faith on the part of the intervener (paras 68 and 69). Finally, insofar as the BoA had noted that the invalidity applicant had explicitly stated, in its letter to the EUTM owner, that it '[was] not currently at a point that it [was] seeking to have global operations, but rather [was] trying to confine its services to specific cities within the United States' the GC noted that it was apparent from the terms of that letter that the intention to 'have global operations' in the near or more distant future had not been entirely excluded (paras 70 and 71).



♦ [T-107/16](#); **AIRHOLE**; *Airhole Facemasks, Inc. / EUIPO — industrysurf, SL*; Judgment of 16 May 2017; EU:T:2017:335; Language of the case: EN. The applicant requested that the contested mark, which was identical to the applicant's prior US and Canadian marks, be declared invalid. It based its request on Article 60(1)(b) in conjunction with Article 8(3) EUTMR (filing by unauthorised agent) as well as on Article 59(1)(b) EUTMR (bad faith). At the time of filing of the contested mark, the EUTMR proprietor was the applicant's distributor for six Member States of the European Union. While it was undisputed that the applicant had consented to the filing of the contested mark, the parties disagreed on whether or not that consent extended to the filing of the contested mark in the EUTM proprietor's own name. The CD declared the contested mark invalid. It found that the EUTMR proprietor had acted in bad faith (Article 59(1)(b) EUTMR) when it filed the contested mark in its own name. The BoA annulled the CD's decision and rejected the applicant's invalidity request. It found, in essence, that the applicant had not established that it had not consented to the filing of the contested mark, thus excluding the application of both grounds of invalidity invoked by the applicant. Before the GC, the applicant invoked the infringement of Article 8(3) and Article 59(1)(b) EUTMR, and requested that the contested decision be altered accordingly. The GC found that the BoA was required to find, as the CD had done, that the EUTM proprietor had acted in bad faith when it filed the contested mark (paras 42 and 49). The GC thus effectively annulled the contested decision, by altering it to the effect that the EUTM proprietor's appeal before the BoA was dismissed (paras 45-50) and the EUTM proprietor was ordered to bear the applicant's costs in the proceedings before the BoA (para. 53). The GC found, first, that there was no indication that the applicant had consented in a clear, specific and unconditional manner to the filing of the contested mark in the EUTM proprietor's name (paras 25-36). This followed from (i) the correspondence between the parties both before (paras 26-27) and after (para. 28) the filing and (ii) the objective circumstances of the case (para. 29), such as the identity between the contested mark and the applicant's prior US and Canadian marks (paras 30-31), and the existence of an exclusive distribution agreement, in force at the time of filing, under which the EUTM proprietor required the express consent of the applicant to use the latter's logos and marks (paras 32-34), which allowed the EUTM proprietor to perceive the filing of the contested mark as following the applicant's commercial logic to extend the protection of its mark to the territory of the EU (para. 35). The GC found, second, that the EUTM proprietor had sought to usurp the applicant's rights (para. 37). This followed from the fact that the EUTM proprietor could not claim any priority with regard to the contested mark (para. 38), and was — by reason of the distribution agreement — fully aware of the existence and use of the applicant's identical mark when the contested mark was filed (para. 39) as well as of its own territorial and substantive restrictions as regards the use it was entitled to make of the applicant's marks in the EU (para. 40). This was, in addition, confirmed by the EUTMR proprietor's omissions and acts following the filing of the contested mark (para. 41) in that it neither informed the applicant of the filing and subsequent registration of the contested mark nor honoured its undertaking to transfer the contested mark to the applicant, it further threatened the applicant and its other distributors in the EU with infringement proceedings based on the contested mark.

♦ [T-343/14](#); **CIPRIANI**; *Arrigo Cipriani v EUIPO*; Judgment of 29 June 2017; EU:T:2017:458; Language of the case: EN. An application for invalidity was filed against the EUTM **CIPRIANI** pursuant to Article 60(2)(a) EUTMR in conjunction with Article 8(3) of the Italian Industrial Property Code (IPC), which referred to personal name rights, and Article 59(1)(b) EUTMR. The CD found the claim of infringement of Article 59(1)(b) EUTMR inadmissible, insofar as a national court had already given a definitive ruling on that issue. The CD also considered inadmissible the part of the application relating to Article 60(2)(a) EUTMR on use of the contested sign for services in Class 42, insofar as the applicant had knowingly acquiesced to



use of the contested mark for more than 5 years. As regards the goods and services in Classes 16 and 35, the CD held that there was no infringement of the applicant's right to his name. The BoA dismissed the applicant's appeal. Regarding the infringement of Article 59(1)(b) EUTMR, it found that the intervener's predecessor-in-title, which had lawfully run Hotel Cipriani for years, was entitled to seek registration of the contested mark. As regards the infringement of Article 60(2)(a) EUTMR, it found, first, that the evidence supporting the invalidity request always referred to the name and surname of the applicant, Arrigo Cipriani, and that use of the surname CIPRIANI on its own did not constitute an infringement of the applicant's right to his name; second, that there could be no usurpation by a third party of the name of a well-known person where the mark was registered by a person with the same surname, that is to say Giuseppe Cipriani, the father of the applicant and predecessor-in-title of the intervener. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 60(2)(a) EUTMR in conjunction with Article 8(3) of the IPC and (ii) infringement of Article 59(1)(b) EUTMR. **Regarding the alleged infringement of Article 59(1)(b) EUTMR:** the GC first examined the second plea in law and found that registration of the contested mark could be regarded as part of the commercial strategy of the intervener's predecessor-in-title (para. 45), which simply wished to extend the protection of its national mark to the EU, an act that could not be assimilated to bad faith (para. 50). Regarding the English court's judgment, which the BoA had referred to, the GC considered that consistent case-law allowed the BoA to take that judgment into account as one of the indicia when assessing the facts at issue (para. 38), in particular for establishing whether the right of the intervener's predecessor-in-title to use the name CIPRIANI was limited to a period of 5 years and to the hotel sector. Consequently, the BoA could not be criticised for having referred to the 2008 judgment (para. 38). Therefore, the BoA had not erred in holding that there was no bad faith on the part of the intervener's predecessor-in-title (para. 69).

♦[T-316/16](#); **SDC-554S / SDC-554S**; *Moravia Consulting spol. s r.o. v EUIPO*; Judgments of 12 October 2017; EU:T:2017:717; Language of the case: EN. The applicant sought to register the word mark **SDC-554S** for goods in Class 9. An opposition, based on an earlier non-registered trade mark identical to the trade mark applied for, was filed pursuant to Article 8(4) EUTMR. The OD dismissed the opposition. The BoA dismissed the appeal. The opponent filed an action before the GC. The GC dismissed the appeal. The opponent relied on two pleas in law: (i) infringement of Article 8(4) EUTMR and of Article 95(1) EUTMR and (ii) infringement of Article 59(1)(b) EUTMR. The plea of bad faith is inadmissible in the context of opposition proceedings (paras 26-31).



♦[T-317/16](#); **SDC-888TII RU / SDC-888TII RU**; *Moravia Consulting spol. s r.o. v EUIPO*; Judgments of 12 October 2017; EU:T:2017:718; Language of the case: EN. The applicant sought to register the word mark **SDC-888TII RU** for goods in Class 9. An opposition, based on an earlier non-registered trade mark identical to the trade mark applied for, was filed pursuant to Article 8(4) EUTMR. The OD dismissed the opposition. The BoA dismissed the appeal. The opponent filed an action before the GC. The GC dismissed the appeal. The opponent relied on two pleas in law: (i) infringement of Article 8(4) EUTMR and of Article 95(1) EUTMR, and (ii) infringement of Article 59(1)(b) EUTMR. The plea of bad faith is inadmissible in the context of opposition proceedings (paras 26-31).

♦[T-318/16](#); **SDC-444S / SDC-444S**; *Moravia Consulting spol. s r.o. v EUIPO*; Judgments of 12 October 2017; EU:T:2017:719; Language of the case: EN. The applicant sought to register the word mark **SDC-444S** for goods in Class 9. An opposition, based on an earlier non-registered trade mark identical to the trade mark applied for, was filed pursuant to Article 8(4) EUTMR. The OD dismissed the opposition. The BoA dismissed the appeal. The



opponent filed an action before the GC. The GC dismissed the appeal. The opponent relied on two pleas in law: (i) infringement of Article 8(4) EUTMR and of Article 95(1) EUTMR, and (ii) infringement of Article 59(1)(b) EUTMR. The plea of bad faith is inadmissible in the context of opposition proceedings (paras 26-31).

[T-687/16](#); **STYLO & KOTON**; *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ v EUIPO*; Judgment of 30 November 2017; EU:T:2017:853; Language of the case: EN.

| EUTM | Earlier trade mark |
|---|--|
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The EUTM owner (intervener) sought to register the figurative sign represented above (the contested EUTM) for Classes 25, 35 and 39. The opposition based on the earlier mark represented above was partly upheld because of a LOC between the marks for the goods in Class 25 and the services in Class 35. After dismissal of the appeal before the BoA, the EUTM was registered only for some services in Class 39. The applicant (owner of the earlier mark) requested a declaration of invalidity of the contested EUTM because of bad faith on the part of the intervener. The CD rejected the application for a declaration of invalidity in its entirety because of lack of proof of dishonest intention. The applicant filed a notice of appeal against the CD's decision. The BoA dismissed the appeal but based its decision on the lack of similarity between the goods and services identified by the conflicting signs. The applicant raised a single plea: infringement of Article 59(1)(b) EUTMR. The stylised KOTON element was sufficiently original and striking to be able to state that the intervener knew of the existence of the earlier marks (para. 34). The signs displayed an undeniable degree of similarity, based on the word element KOTON, which was reproduced virtually identically in both marks (para. 35), but there was no similarity between the services identified by the contested sign in Class 39 and the goods and services of the earlier mark. According to the GC, the BoA had merely applied the case-law, namely the judgment of 11/06/2009, C-529/07, *Lindt Goldhase*, EU:C:2009:361, according to which bad faith presupposes that a third party is using an identical or similar sign for an identical or similar product or service capable of being confused with the sign for which registration is sought (para. 44).

C. Article 60(1), (2) & (3) EUTMR — other relative grounds for invalidity

♦ [T-343/14](#); **CIPRIANI**; *Arrigo Cipriani v EUIPO*; Judgment of 29 June 2017; EU:T:2017:458; Language of the case: EN. An application for invalidity was filed against the EUTM **CIPRIANI** pursuant to Article 60(2)(a) EUTMR in conjunction with Article 8(3) of the Italian Industrial Property Code (IPC), which referred to personal name rights, and Article 59(1)(b) EUTMR. The CD found the claim of infringement of Article 53(1)(b) inadmissible, insofar as a national



court had already given a definitive ruling on that issue. The CD also considered inadmissible the part of the application relating to Article 60(2)(a) EUTMR as on use of the contested sign for services in Class 42, insofar as the applicant had knowingly acquiesced to use of the contested mark for more than 5 years. As regards the goods and services in Classes 16 and 35, the CD held that there was no infringement of the applicant's right to its name. The BoA dismissed the applicant's appeal. Regarding the infringement of Article 59(1)(b) EUTMR, it found that the intervener's predecessor-in-title, which had lawfully run Hotel Cipriani for years, was entitled to seek registration of the contested mark. As regards the infringement of Article 60(2)(a) EUTMR, it found first, that the evidence supporting the invalidity request always referred to the name and surname of the applicant, Arrigo Cipriani, and that use of the surname CIPRIANI on its own did not constitute an infringement of the applicant's right to his name; second, that there could be no usurpation by a third party of the name of a well-known person where the mark was registered by a person with the same surname, that is to say Giuseppe Cipriani, the father of the applicant and predecessor-in-title of the intervener. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 60(2)(a) EUTMR in conjunction with Article 8(3) of the IPC and (ii) infringement of Article 59(1)(b) EUTMR. **Regarding the alleged infringement of Article 60(2)(a) EUTMR in conjunction with Article 8(3) of the IPC:** the GC agreed that the contested mark could be declared invalid if its use could be prohibited under Italian law for a well-known name protected by Article 8(3) of the IPC (para. 78). The applicant was therefore required to prove that the renown of the Cipriani name, used only, having regard to the contested mark, in the form of that single name, was attached to his person (para. 91). This was not the case, since the name Cipriani could also evoke the intervener's predecessor-in-title, which had filed the application for the contested mark, and thereafter the intervener, or even the Italian word mark Cipriani (para. 100). In conclusion, the fact that, under Article 8(3) of the IPC, the applicant could not rely on the renown of the Cipriani name without it being accompanied by his first name meant that that provision could not be relied on in order to dispute the validity of the contested mark (para. 103). The action was therefore dismissed.

♦[T-389/16](#); **MONTORSI F. & F**; *Agricola italiana alimentare SpA (AIA) v EUIPO - Casa Montorsi Srl*; EU:T:2017:492; Judgment of 13 July 2017; Language of the case: IT. The applicant sought to register the word mark **MONTORSI F. & F** as an EUTM for goods in Class 29. An application for invalidity was filed pursuant to Article 60(1)(a) in conjunction with Article 8(1)(b) EUTMR on the basis of Italian word mark registration **Casa Montorsi** for goods in Class 29. The CD upheld the application for invalidity in its entirety. The applicant appealed that decision and the BoA dismissed the appeal. The BoA found that there was a LOC due to the similarity of the signs and the identity and similarity between some of the contested goods and the goods for which use of the earlier mark had been proven. The BoA rejected the applicant's argument that the invalidity action had to be dismissed on the grounds of an agreement signed by the parties on the coexistence of their marks in Italy. The applicant filed an action before the GC, claiming infringement of Article 60(1)(a) and Article 60(3) EUTMR. The GC dismissed the appeal. The GC first assessed the applicant's second claim and found that the BoA had been correct in finding that the agreement signed by the parties could not prove that the intervener (owner of the earlier mark) had given its express consent to registration of the contested EUTM by the applicant. The GC upheld the Office's argument that the agreement contained no reference to the contested EUTM, or to the EU or EU law. The agreement did not even mention the sign 'MONTORSI F. & F' but only the word 'MONTORSI' (para. 43). Therefore, it could not be inferred from that agreement that the parties had taken a common position on the registration of marks including the word 'MONTORSI' as EUTMs. The consent required by Article 60(3) EUTMR had to be clearly expressed. However, such consent could not be found in the agreement, which referred only to Italian trade marks that had already existed at that time (para. 45). The



GC also clarified that the fact that the intervener, owner of the earlier mark, had signed a coexistence agreement with the applicant concerning their marks in Italy, did not mean that it had renounced opposing registration of an EUTM by the applicant (paras 46-50). On the basis of the foregoing, the GC rejected the applicant's first claim, that the BoA had infringed Article 60(1)(a) in conjunction with Article 8(1)(b) EUTMR, stating that, as the agreement had not included any direct consent to registration of the contested mark, and coexistence between the marks had not been proven, the BoA had been right in finding a LOC between the marks at issue.

D. Article 61 EUTMR — acquiescence

[No entry]



VI. Design Matters

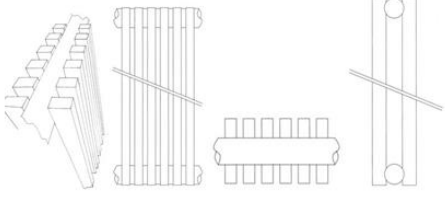
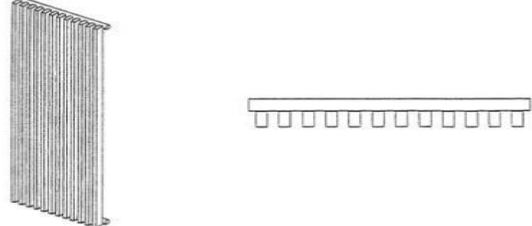
A. Article 3(a), 6, 9 CDR — registration proceedings

[T-16/16](#); **DESIGN OF BEAKERS**; *MasT-Jägermeister SE v EUIPO*; Judgment of 9 February 2017; EU:T:2017:68 EU:T:2017:68; Language of the case: DE. The two RCD applications each showed a beaker and a bottle and indicated ‘beaker’ as the relevant product. According to the examiner, it resulted from the examination that the applicant was not seeking protection for the bottles. The applicant did not remedy the defects raised in this respect and the applications were therefore not dealt with as applications for RCDs pursuant to Article 46(2) CDR. The BoA confirmed that it was not possible to determine whether protection was being sought for the beaker, for the bottle, or for a combination of the two. According to the BoA, the representation to be filed with the application pursuant to Article 36(1)(c) CDR served to identify the design for which protection was sought and was the condition for the attribution of a date of filing, which was relevant for novelty and individual character. A representation of the design suitable for reproduction for the purpose of attributing a filing date in accordance with Article 36(1)(c) CDR had to be of a ‘quality permitting all the details of the matter for which protection is sought to be clearly distinguished’, as followed from Article 4(1)(e) CDIR in conjunction with Article 10 CDIR and Article 36(5) CDR (paras 31-34). The phrase quoted referred to the requirement inherent in any registration, that is to say, to enable third parties to determine with clarity and precision all the details of the design for which protection was sought (para. 45). Moreover, clarification was necessary for accounting purposes, insofar as the amount of fees collected by the Office varied according to the number of classes of goods to which the design concerned related (para. 47). The BoA had properly applied Article 46(2) CDR and not attributed a filing date, rather than refused the application under Article 46(3) CDR (paras 50-51).

B. Article 25(b) CDR — invalidity proceedings

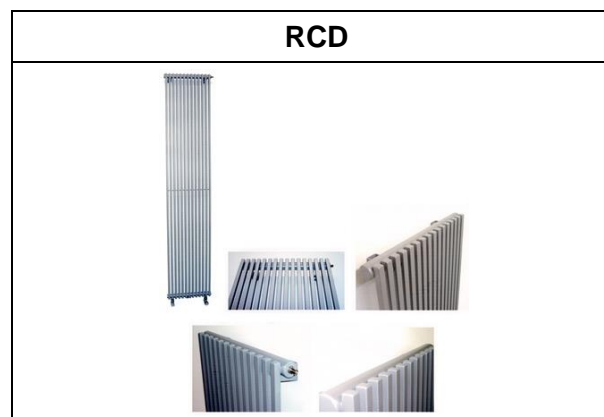
[T-828/14](#) and [T-829/14](#) (joined cases); **DESIGN OF THERMOSIPHONS FOR RADIATORS**; *Antrax It Srl v EUIPO*; Judgment of 16 February 2017; EU:T:2017:87; Language of the case: IT. Two applications for invalidity were filed pursuant to Article 25 CDR in conjunction with Article 5 and 6 CDR. The ID upheld the applications for invalidity due to a lack of novelty pursuant to Article 5 CDR. The 3rd BoA annulled the contested decisions. However, it declared the contested RCDs invalid since the overall impression they produced on the informed user was the same as those of the prior designs within the meaning of Article 6 RCD. The appellant lodged two actions for annulment before the GC. The GC upheld the appeals and annulled the contested decisions for lack of reasoning as the BoA had not addressed the appellant’s argument regarding the saturation of the state of art in the radiators/heaters sector. As a result, the cases were remitted to the BoA, which was called upon to assess the contested RCDs’ individual character in the light of the appellant’s argument that the sector concerned was crowded. The BoA gave the parties the opportunity to comment and to provide evidence in connection with this argument, which, if upheld, could support the fact that the informed user would be more attentive to the details of the designs. The BoA took two decisions, finding that the appellant had not proven the saturation of the sector concerned and confirming that the contested RCDs lacked individual character. The appellant lodged two actions for annulment; the GC joined the two cases.



| RCD — T-828/14 | RCD — T-829/14 |
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The GC found that the BoA had not infringed any general principle of the EU law. In particular, there had been no breach of the right to defence, and the principle of equal treatment and sound administration had been respected (paras 93, 94). The GC confirmed that the BoA was not bound by its previous decisions. The corresponding trade mark case-law was applicable by analogy to design invalidity proceedings (para. 93). The GC also confirmed that where the RCD holder invoked the saturation of the state of the art, the evidence submitted in support had to be sufficient in terms of number, quality and relevance (paras 69, 70). The GC reiterated that the saturation of the state of the art had to be ascertained. The GC clarified that, however, this did not necessarily mean that well-known facts could not be sufficient (para. 93) to establish saturation. The relevant date for determining saturation of the state of the art was the filing date of the contested RCD (para. 63).



♦[T-98/15](#); **DESIGN OF RADIATORS FOR HEATING**; *Tubes Radiatori Srl v EUIPO*; Judgment of 16 February 2017; EU:T:2017:91; Language of the case: IT. An application for invalidity was filed pursuant to Article 25 CDR in conjunction with Article 5 and 6 CDR. The Invalidity Division upheld the application for invalidity due to a lack of individual character pursuant to Article 6 CDR. The 3rd BoA confirmed the contested decision. The appellant lodged an action for annulment before the GC. The GC upheld the appeal and annulled the contested decision for lack of reasoning as the BoA had not addressed the appellant’s argument regarding the saturation of the state of the art in the radiators/heating sector. As a result, the case was remitted to the BoA to assess the contested RCD’s individual character in the light of the appellant’s argument that the sector concerned was crowded. The BoA found that the appellant had not proven the saturation of the sector concerned and confirmed that the contested RCD lacked individual character. The appellant lodged an action for annulment.





The GC found that, contrary to the appellant’s line of argument, the previous judgment did imply that the BoA was called upon to re-assess the individual character of the contested RCD in the light of the appellant’s argument regarding the saturation of the sector concerned (para. 30). The GC considered that the annulment of the previous Board’s decision required a new examination (para. 32). However, it did endorse the appellant’s argument that the Board had infringed the former’s right to be heard by finding that the saturation of the sector of radiators/heaters was not established without having given the appellant the opportunity to file arguments and/or evidence further to the remittal of the case (paras 46-53).

♦[T-174/16](#); **DESIGN OF NOZZLES FOR VACUUM CLEANERS**; *Wessel-Werk GmbH v EUIPO*; Judgment of 14 March 2017; EU:T:2017:161; Language of the case: DE



| RCD application | Earlier RCD |
|---|---|
|  |  |

The applicant before the GC was the owner of a registered Community design (‘suction nozzle for vacuum cleaners’), as represented above. The intervener had filed an invalidity action based, inter alia, on lack of individual character in the sense of Article 6 CDR. The intervener had based its request in particular on earlier registered designs, as represented above. Both instances upheld the invalidity request and found that the challenged design lacked individual character. The applicant appealed to the GC, arguing infringement of, inter alia, Article 6(1) and Article 62 CDR. **Infringement of Article 6(1) CDR**: the GC confirmed the BoA finding that the informed user was the person who would use the vacuum cleaner and its suction nozzles for cleaning purposes and not — as claimed by the applicant — the producers of the vacuum cleaners (paras 17-20). Regarding the level of attention paid by the informed user, the GC confirmed the case-law. The informed user was not an expert or specialist, capable of observing in detail the minimal differences that might exist between the conflicting designs. Thus, the qualifier ‘informed’ suggested that, without being a designer or a technical expert, the user knew the various designs in the sector concerned, possessed a certain level of knowledge of the features such designs normally included and, as a result of his or her interest in the products concerned, paid a relatively high degree of attention when



using them (para. 25). The thread lifters, which were slightly different from those of the earlier RCD, were part of the more complex product constituted by the suction nozzle of the vacuum cleaner. The informed user would not consider them in isolation but within the broader context of the suction nozzle. Consequently, the slight differences in the length and colour of the thread lifters would not alter the overall impression (paras 29-31).

♦[T-175/16](#); **DESIGN OF NOZZLES FOR VACUUM CLEANERS**; *Wessel-Werk GmbH v EUIPO*; Judgment of 14 March 2017; EU:T:2017:160; Language of the case: DE

| RCD application | Earlier RCD |
|---|---|
|  |  |

The applicant before the GC was the owner of a registered Community design ('suction nozzle for vacuum cleaners'), as represented above. The intervener had filed an invalidity action based, inter alia, on lack of individual character in the sense of Article 6 CDR. The intervener had based its request in particular on earlier registered designs, as represented above. Both instances upheld the invalidity request and found that the challenged design lacked individual character. The applicant appealed to the GC, arguing infringement of, inter alia, Article 6(1) and Article 62 CDR. **Infringement of Article 6(1) CDR:** the GC confirmed the BoA finding that the informed user was the person who would use the vacuum cleaner and its suction nozzles for cleaning purposes and not — as claimed by the applicant — the producers of the vacuum cleaners (paras 17-20). Regarding the level of attention paid by the informed user, the GC confirmed the case-law. The informed user was not an expert or specialist, capable of observing in detail the minimal differences that might exist between the conflicting designs. Thus, the qualifier 'informed' suggested that, without being a designer or a technical expert, the user knew the various designs in the sector concerned, possessed a certain level of knowledge of the features such designs normally included and, as a result of his or her interest in the products concerned, paid a relatively high degree of attention when using them (para. 25). The thread lifters, which were slightly different from those of the earlier RCD, were part of the more complex product constituted by the suction nozzle of the vacuum cleaner. The informed user would not consider them in isolation but within the broader



context of the suction nozzle. Consequently, the slight differences in the length and colour of the thread lifter would not alter the overall impression (paras 29-31).

T-9/15; DESIGN OF CANS FOR BEVERAGES; *Ball Beverage Packaging Europe Ltd v EUIPO*; Judgment of 13 June 2017; EU:T:2017:386; Language of the case: DE.

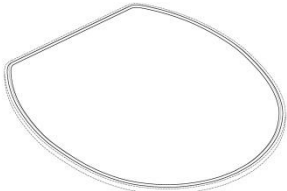

| RCD | Earlier designs |
|---|--|
|  |  |

The RCD holder was granted registration of the design represented above as an RCD with the product indication [*beverage*] cans. The description of the RCD submitted by the RCD proprietor read: ‘Group of cans for drink, all having a sleek but high appearance with reduced neck, preferably made of thin sheet metal, especially for filling volumes of 250 ml, 300 ml or 330 ml, respectively.’ An application for invalidity was filed pursuant to Article 25(1)(b) in conjunction with Article 6 CDR, based on three cans disclosed before the priority date of the contested RCD. The ID dismissed the application for invalidity. The BoA upheld the invalidity applicant’s appeal. It found that the contested RCD consisted in the appearance of an individual can represented in three different sizes. Invoking Article 98(1) CDR, it refused to take into consideration the description of the contested design in English, included in the application for registration, on the ground that that description had not been made in the language of application (German). In the context of the assessment of the individual character of the contested design, the BoA concluded that the differences between the contested design and the earlier designs were insignificant and had no impact on the overall impression on informed users, defined as persons responsible for bottling in the drinks industry. The RCD proprietor filed an action before the GC, relying on two pleas in law: (i) breach of the obligation to state reasons and (ii) infringement of the provisions relating to the assessment of individual character. The GC dismissed the appeal. The RCD holder alleged that the BoA had incorrectly assessed the scope of protection conferred by the contested RCD, insofar as it had refused to find that the latter represented a group of three cans of different sizes, that is to say, a unitary object. The GC held that the BoA was required, in the course of the substantive examination of the overall impression produced by the contested RCD, to determine, as a preliminary question, its subject matter of protection. Any position on that question taken by the Office during the registration process could not bind the BoA in view of the essentially formal and expeditious nature of the review carried out by the Office during the registration process. Moreover, the refusal by the BoA to define the subject matter of the protection afforded by the contested RCD as a group of cans had not led to an unlawful questioning of its validity (paras 49-58). The definition of the contested RCD as a group of cans would have amounted to an element of differentiation between that design and the earlier designs, which represented a single can. The subject matter of a design may only be a unitary object, since Article 3(a) CDR refers expressly to the appearance of ‘a product’. However, the BoA correctly stated that a group of articles might constitute ‘a product’ within



the meaning of the abovementioned provision if they were linked by aesthetic and functional complementarity and were usually marketed as a unitary product. Irrespective of the way beverage cans were marketed, it was clear that the three cans represented in the contested RCD did not perform a common function in the sense of a function that could not be performed by each of them individually as is the case, for example, of table cutlery or a chess board and chess pieces (paras 59-63). As follows from Article 36(3)(a) and Article 36(6) CDR, and confirmed by Article 1(2)(a) CDIR, a description that may be contained in the application for registration may not have an influence on the substantive assessments relating to the novelty or individual character of the design, or on the subject matter of protection. The RCD holder’s claims relating to the BoA’s refusal to take account of the description were therefore ineffective (paras 66-69). The BoA had correctly defined the informed user as a person who bottled beverages in the drinks industry and who obtained information about relevant offers by means of specialised journals and catalogues as well as by attending specialised exhibitions (para. 83). The GC also approved the BoA finding that the designer’s freedom was unlimited with regard to the configuration of the basic cylindrical shape, the neck of the can and the base of the can. In fact, it was limited only insofar as the basic cylindrical shape had been established as a standard and the round shape of the lid and base resulted necessarily from that basic shape. Limitations relating to the size of the cans resulted from the capacity, which normally did not exceed 500 ml and corresponded to normal quantities used in business for the sale of drinks (para. 84). The GC also confirmed the BoA’s findings on the overall impression produced by the conflicting designs, in particular that the differences between the proportions of the cans were not visible and that the height/width ratio appeared to be approximately identical. Even if the informed user noticed differences between the proportions, they were not relevant to the overall impression. The representation in three sizes of the contested RCD did not show the existence of a relevant difference insofar as the informed user knew the normal capacity of beverage cans and did not attach importance to the differences in size thereof in the overall impression. The BoA had correctly concluded that the contested RCD was devoid of individual character (paras 86-91).

[T-286/16](#); **DESIGN OF A PART OF TOILET SEATS**; *Ernst Kneidinger v EUIPO*; Judgment of 21 June 2017; EU:T:2017:411; Language of the case: DE.



| RCD | Earlier design |
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The RCD proprietor was granted registration of the design represented above as an RCD with the product indication *toilet seats (part of -), ornamentation* (for a larger representation and additional views, consult RCD No 2274035-0001 on eSearch plus). An application for invalidity was filed pursuant to Article 25(1)(b) in conjunction with Articles 4 to 6 CDR on the



grounds of lack of novelty and/or individual character. The ID upheld the application for invalidity. The BoA dismissed the RCD proprietor’s appeal, holding that the RCD lacked individual character within the meaning of Article 6 CDR in comparison with the earlier design represented above (see judgment for additional views). The RCD proprietor filed an action before the GC, relying on a single plea in law: infringement of Article 6(1)(b) CDR. The GC dismissed the appeal. The designer’s freedom was limited to the design of the lid since the outer shape was determined by the dimensions of the toilet bowl and by the technical function of covering the toilet seat and bowl (para. 27). When comparing conflicting designs, only those parts subject to design protection were to be taken into account. Contrary to the RCD holder’s claim, the RCD as registered did not have an edge protruding above the rest of the lid surface. It should have submitted a side or sectional view of the lid to represent such protrusion. The views did not reveal the edge’s proportions or concrete design either. Therefore, it could not be ruled out that the conflicting designs gave the informed user a similar overall impression in that they had similar elevated edges (paras 39-43).

[T-90/16](#); **DESIGN OF AN ELECTRONIC WRISTBAND**; *Thomas Murphy v EUIPO*; Judgment of 4 July 2017; EU:T:2017:464; Language of the case: EN.

| RCD | Earlier design |
|---|--|
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The RCD proprietor was granted registration of the design represented above as an RCD for *measuring instruments, apparatus and devices* in Class 10.04 of the Locarno Agreement. An application for invalidity was filed pursuant to Article 6(1)(b) CDR in conjunction with Article 25(1)(b) CDR. The ID dismissed the application for invalidity. The BoA dismissed the invalidity applicant’s appeal. The invalidity applicant filed an action before the GC, relying on three pleas in law. First, he submitted that the BoA had not given him a fair hearing and, by not taking account of the explanations relating to the features of the prior design and not answering the argument that the prior design had to enjoy a high degree of protection, had failed to fulfil its obligation to state reasons. Second, he submitted that, by failing to address the argument that the degree of freedom of the designer was very high, the BoA had again failed to fulfil its obligation to state reasons. Third, he essentially invoked an infringement of Article 6(1)(b) CDR on the grounds that the BoA had not properly assessed the overall impression produced by the designs at issue. The GC dismissed the action. The argument that the BoA had, without adequate reasoning, endorsed the RCD holder’s argument that the freedom of the designer was limited and that it had failed to quantify the degree of the freedom of the designer was the result of a misreading of the contested decision. The question as to whether that degree of freedom was very high went to the substance of the



contested decision. There was no infringement of the right to fair hearing or breach of the duty to state reasons (paras 13-31). The BoA had correctly found that the degree of freedom of a designer of an electronic wristband was limited by the technical constraints, namely the need to be ergonomic in order to both fit the wrist and contain measuring instruments. It had also correctly taken the view that, in order to fulfil its function properly, a wristband had to be relatively small, thin and light and fit easily around the wrist. The BoA had correctly found that the degree of freedom of the designer was merely high, rather than very high (paras 36-42). The GC rejected all the invalidity applicant’s arguments regarding the similarity of the prior design and the contested RCD. The comparison of the overall impressions produced by the designs had to relate solely to the elements actually protected. Some of the features of the prior design, claimed by the invalidity applicant in his explanations before the BoA, were not clear from the representations of that design. The fact that a button on the contested RCD served a functional purpose did not preclude it from being capable of being regarded as a differentiating factor insofar as it could be placed on a wristband in different ways and could be of different shapes and sizes. The prior design, in contrast to the contested design, did not appear to be made of transparent material. The BoA had correctly assessed the prior design as if it were represented in black and white. Regarding shape, electronic wristbands had to be circular to fit the wrist; the common feature consisting in their circular shape would have only minor importance in the overall impression. The clasps were similar but were not a very important element of the designs. When using an electronic wristband, the informed user attached more importance to the part of the wristband that displayed the data than to the clasp (paras 43-70). The invalidity applicant argued that the prior design enjoyed a high degree of protection because it was, at the time of registration, a significant advance over the prior art. In support of that argument, the invalidity applicant relied on a judgment of the Court of Appeal (England and Wales). That argument, however, could not be accepted, as it did not follow from the CDR that an advance over the prior art on the part of the prior design had to be taken into account when assessing the individual character of a later design. Moreover, the BoA was not bound by decisions of national authorities. Finally, the invalidity applicant had not proven that his design was a significant advance over the prior art (paras 71 et seq.).

[T-306/16](#); **DESIGN OF DOOR HANDLES**; *Gamet S.A. v EUIPO*; Judgment of 5 July 2017; EU:T:2017:466; Language of the case: EN.


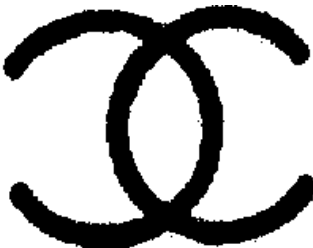
| RCD | Earlier design |
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The applicant obtained registration of the design represented above for *handles, knobs and hinges*. A request for a declaration of invalidity was filed based on Article 25(1)(b) CDR, arguing that the RCD was not new and lacked individual character within the meaning of Articles 4 and 6 CDR. The earlier design invoked is represented above. The ID rejected the application for invalidity because it considered that the RCD satisfied the requirements of



novelty and individual character. However, the BoA upheld the intervener’s appeal. The BoA accepted certain items submitted by the intervener for the first time before it and found that the RCD lacked individual character as a result of the earlier design having been properly disclosed before the relevant date. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Article 63(1) and (2) CDR and (ii) infringement of Articles 4 and 6 CDR. The GC dismissed the appeal. It considered that the BoA had correctly exercised its discretion in accepting certain items of evidence submitted by the intervener for the first time before it. The GC confirmed that the additional views of the earlier design merely supplemented the evidence submitted before the Invalidity Division and were relevant for the outcome of the case (para. 21). Moreover, the GC considered that the BoA had not infringed Article 63(1) CDR because all the evidence it relied upon in its decision had originated from the intervener (para. 32). As regards the substance of the dispute, the GC endorsed the BoA’s finding that, considering the high degree of designer’s freedom in respect of door handles (para. 47), the overall impression produced by the RCD was the same as that produced by the earlier design (para. 55). Contrary to what the applicant argued, the GC considered that the groove present in the RCD could not alter the overall impression produced by this design (para. 50).

♦ [T-57/16](#); **DESIGN OF ORNAMENTATION**; *Chanel SAS v EUIPO*; Judgment of 18 July 2017; EU:T:2017:517; Language of the case: ES.

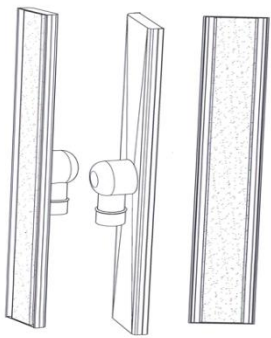
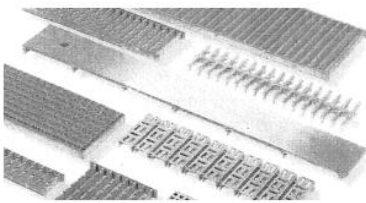
| RCD | Earlier right |
|---|--|
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The RCD proprietor was granted registration of the design represented above as an RCD for the product indication *ornamentation*. An application for invalidity was filed pursuant to Article 25(1)(b) CDR. The ID dismissed the application for invalidity insofar as, with regard to the assessment of the individual character of the contested RCD, the signs produced a different overall impression. The BoA dismissed the invalidity applicant’s appeal, confirming the ID’s conclusions. The invalidity applicant filed an action before the GC, relying on one plea in law: infringement of Article 25(1)(b) CDR. The GC upheld the appeal. It found that the overall impression created by the contested RCD did not differ from that of the earlier right invoked by the invalidity applicant; therefore, it lacked individual character. It was common ground that the applicant’s right was earlier, that the contested design was for *ornamentation* in Class 32, that the informed user comprised both professionals and end users, and that the degree of freedom of the designer in this case was high. The GC focused its assessment on two questions: (i) on whether, as argued by the invalidity applicant, the BoA should have identified the product to which the design was applied; and (ii) on the impact of the use of the design on the comparison of the general impression created by the conflicting designs.



Nature of the products: the GC confirmed that, contrary to the invalidity applicant's arguments, the BoA was not obliged to identify the exact product to which the design for *ornamentation* was going to be applied as it had not been registered for any particular product (para. 44). **General impression:** the GC indicated that evidence of use of the sign on products (as in the evidence submitted by the invalidity applicant) as well as examples of the rotation of the contested design on products could be taken into account when assessing the individual character of the design. However, they did not serve as the only point of reference for the assessment as the design had been applied for in respect of *ornamentation* and could therefore be applied to multiple products (paras 46-50). After this preliminary remark, the GC had made a detailed factual analysis of the similarities between the designs. It considered that, despite the differences in their central elements, the designs were similar externally and in their oval forms. This was reinforced by the possibility of rotating the design 90 degrees and varying the size (para. 55). **Conclusion:** in view of the high degree of freedom of the designer, the fact that the product indication was ornamentation and the lack of technical restrictions, the GC came to the conclusion that the differences between the designs did not give the informed user a different overall impression. Therefore, the contested sign lacked individual character (paras 58-61).

[C-361/15 P](#) and [C-405/15 P](#) (joined cases) **DESIGN OF A SHOWER DRAINAGE CHANNEL;** *Easy Sanitary Solutions BV v EUIPO*; Judgment of 21 September 2017; EU:C:2017:720; Language of the case: NL.

| Contested RCD | Earlier design |
|---|--|
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Easy Sanitary Solutions B.V (the applicant) registered the Community design represented above for the product indication *shower drains*. An invalidity action based on a prior design was filed pursuant to Articles 4 to 9 CDR. The Invalidity Division declared the contested RCD invalid due to lack of novelty. The BoA upheld the applicant's appeal and annulled the Invalidity Division's decision. The GC upheld the action filed by the holder of the earlier design, annulling the BoA's decision. As regards Article 5 CDR and the examination of novelty, the GC found that any disclosure, irrespective of the product, was relevant. The reasoning was based on two distinct pillars: (i) since the scope of protection was not limited to the product indicated in the application (Articles 36(6) and 19(1) CDR), it would be paradoxical if an RCD were immune to the disclosure of an earlier design applied to a different product and simultaneously entitled to oppose the use of the earlier design; (ii) a literal interpretation of Article 7 CDR led to the conclusion that the 'sector concerned' was that concerning the disclosed design, **not** that concerning the contested RCD. As regards Article 6 CDR and the examination of individual character, the GC held that it could not be



assumed that the informed user of the *shower drains* (contested RCD) was aware of the existence of an earlier design that might pertain to a totally different industrial field. It was only if this knowledge were established that the earlier design could rule out the individual character of the contested RCD (para. 132). The applicant filed an appeal before the CJ.



Infringement of the principles governing the burden of proof: the CJ found that it was for the invalidity applicant to identify what the ‘earlier design’ was, and not for the Office to deduce it from the evidence. In the case in question, the GC had erred in criticising the BoA for not having compared the contested RCD with ‘the entirety of the liquid drainage device’ marketed by the invalidity applicant. The GC had thus erred in law when requiring the Office to combine extracts from various catalogues in order to identify the earlier design. According to Article 63(1) CDR, in proceedings relating to a declaration of invalidity the Office is restricted in this examination to the facts, evidence and arguments provided by the parties (paras 56-60).

Assessment of novelty: the CJ criticised the GC for holding that, where a design was made up of several elements, it had to be considered disclosed where those elements had been disclosed, even separately, provided it was clear that the elements were intended to be combined in order to constitute a predetermined product. The CJ clarified that the contested design had to be compared with earlier individualised and defined designs and not with a combination of designs that had already been made available to the public (paras 61, 65, 69). However, the CJ did not invalidate the contested judgment since its operative part was well founded on other legal grounds (paras 73-77).

Disclosure of the earlier design: the CJ confirmed that the product in which the earlier design was incorporated was irrelevant when comparing it with the contested RCD for the purpose of examining the latter’s novelty: an RCD ‘cannot be regarded as being new ... if an identical design has been made available to the public before the dates specified in that provision [Article 5(1) CDR], even if that earlier design was intended to be incorporated into a different product or to be applied to a different product’ (para. 96).

Individual character of the contested design: the CJ stated that the GC had erred in law when requiring knowledge, by the informed user of the product in which the contested RCD was incorporated, of the earlier design where this earlier design was incorporated in a different product (para. 126). According to the CJ, the prior art is composed of all designs disclosed pursuant to Article 7 CDR, that is to say, all designs known to the professional circles, not to the (non-professional) informed users. Therefore, for the purpose of applying Article 6 CDR, the informed user must be assumed to have knowledge of the entirety of the prior art, even if such prior art includes designs that are incorporated in products in industrial sectors other than that of the contested RCD (paras 130-133).

[T-779/16](#); **DESIGN OF A STAR-SHAPED LAMP**; *Lothar Rühland v EUIPO*; Judgment of 28 September 2017; EU:T:2017:674; Language of the case: DE.

| Contested RCD | Earlier RCD |
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The applicant obtained registration of the design represented above for *lights*. An application for invalidity was filed by the other party, based on Article 25(1)(b) and (d) CDR, arguing that the contested RCD was not new, lacked individual character and was in conflict with the



other party's earlier RCD, also represented above. The ID upheld the application for invalidity and declared the contested RCD invalid due to a lack of individual character. The BoA confirmed the Invalidity Division's decision and rejected the applicant's appeal. The BoA, in essence, argued that the overall impression produced by both RCDs was the same and that the freedom of the designer in respect of lamps was not restricted. The BoA emphasised in particular that the claimed form of a pyramid of the upper arm of the star-shaped RCD could not be inferred from the images submitted. The differences between the RCDs at issue, which consisted in different widths of the upper and lower arms, were only visible on close inspection of the lateral view and could not constitute individual character. The applicant filed an action before the GC, relying on a single plea in law: infringement of Article 25(1)(b) in conjunction with Article 6 CDR. The GC dismissed the appeal. The GC confirmed the BoA's findings concerning the informed user, who — due to his or her knowledge of available lamps in the market — was aware that they usually had a housing, in which a means of illumination, normally a light bulb, was contained (para. 21). The designer's degree of freedom in the case of lamps was restricted insofar as lamps with housings had to be capable of receiving customary means of illumination. However, the designer was not subject to any restrictions in the specific design of the lamps (para. 25). The BoA had rightly found that the overall impression created by the RCDs was determined by the following identical features: (i) the lamp consisted of a housing; (ii) the housing was in a light-coloured shade; (iii) the housing was in the shape of a five-pointed star; (iv) the housing stood on the two lower points of the star; (v) the circular inside of the housing was brighter than the points of the star. The only visibly different feature of the RCDs was that, in the contested RCD, in profile view, the upper point of the star was tapered upwards to form a triangle, whereas in the earlier RCD all the points of the star were of the same width (paras 31-38).

[T-695/15](#); **DESIGN OF A CONTAINER FOR SWEETS**; *BMB sp. z o.o. v EUIPO*; Judgment of 3 October 2017; EU:T:2017:684; Language of the case: EN.

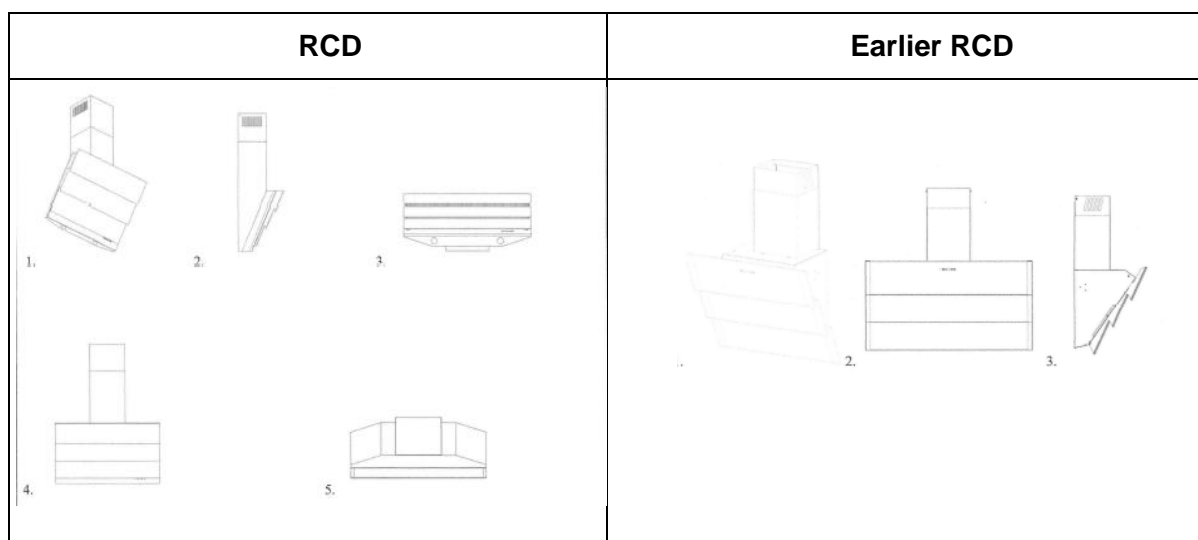
| RCD | Earlier trade mark |
|---|---|
|  |  |

The RCD proprietor was granted registration of the design represented above as an RCD for the product indications *confit boxes* and *container*. An application for invalidity was filed pursuant to Article 25(1)(e) CDR on the basis of an IR of a three-dimensional trade mark with effect in France for *sweets* in Class 30. The ID upheld the application for invalidity. The BoA dismissed the RCD proprietor's appeal. It found that the goods were at least highly similar and that the high visual similarity of the signs was not offset by aural and conceptual differences. Despite the below-average degree of distinctiveness of the earlier mark, it therefore found a LOC. The RCD proprietor filed an action before the GC relying on three pleas in law: (i) infringement of Article 62 CDR due to an incorrect legal basis, (ii) infringement of Article 25(1)(e) CDR for finding a LOC, and (iii) infringement of Article 63(1) CDR for failing to have regard to evidence. The GC dismissed the appeal. The correct legal basis was Article L713-3 of the French Intellectual Property Code, which conferred on the



earlier rights holder the right to prohibit use of the RCD. The BoA had properly applied this provision, which transposed the provisions of the Trade Mark Directive and therefore could be interpreted in accordance with the case-law of the CJEU. A sole reference to Article 8(1)(b) CTMR in the contested decision could be qualified as a mere formal error (paras 18-26). Given that the goods in question were confectionery, the level of attention of the relevant public was rather low (paras 37-38). The label of the RCD and the words on that label would be considered by the relevant public as not overshadowing the impact of the three-dimensional box and not affecting the perception that the average consumer would have of it (para. 48). The earlier mark and the RCD both consisted of transparent boxes for sweets. The graphical representation of the earlier mark, namely a thin rectangular box with an opaque lid and a label 'straddling' the box from front to back, was included in the RCD. The appearance of the white lid of each box was also similar. As regards the elements that dominated the overall impression conveyed by the RCD, the sweets were not a specific component that might be taken into account. The RCD differed in certain respects from the earlier mark, principally regarding the curved edges, which were indeed slightly visible on the side views and label of the RCD, compared with the rectangular shape of the earlier mark. However, in view of their secondary importance, those differences could not override the similarities. Therefore, the signs had significant visual similarities. No aural or conceptual comparison was possible (paras 49-59). Insofar as the goods in question were at least highly similar, there was a LOC, even though the earlier mark was of weak distinctive character (para. 62).

T-684/16; DESIGN OF COOKER HOODS; *Ciarko spółka z ograniczoną odpowiedzialnością sp.k. v EUIPO*; Judgment of 17 November 2017; EU:T:2017:819. Language of the case: PL.





The RCD proprietor was granted registration of the design represented above as an RCD for the product indication *cooker hoods*. An application for invalidity was filed pursuant to Article 25(1)(b) CDR, relying on a previous design registered under the same indication. The ID dismissed the application for invalidity, and the ID's decision was appealed. The BoA upheld the appeal and annulled the ID's decision, due to the lack of individual character in view of the existing earlier design. The RCD proprietor filed an action before the GC, relying on one plea in law: infringement of Article 25(1)(b) CDR in conjunction with Article 4(1) and Article 6 CDR. **Informed user:** the informed user was someone who had been exposed to cooker hoods previously and was aware of their main functional and aesthetic characteristics, and was particularly observant but not a specialist (such as a sales assistant



or kitchen designer): rather, the informed user would be the owner of a house or a flat who, with the intention of buying a cooker hood, collected information in shops and on the internet (para. 24). **Freedom of the designer:** it was a well-known fact that there were many designs of cooker hood available on the market. The cover panels (or ‘canopy elements’) could be designed in various ways, could be constructed from a few large or numerous smaller elements, and could be plain or ornamental. The chimney hood might also be constructed of a number of smaller or a few larger elements, and could be rectangular or circular (para. 41). **Overall impression:** the designs were too similar to be able to produce a different overall impression on the informed user in question. Minor differences that might be apparent to the trained eye of a professional would be less obvious for an informed user (para. 32). For instance, the main constructional difference between the two cooker hoods lay in the greater elongation of the chimney and in the additional narrow line visible below the third wide glass panel in the RCD, which had no counterpart in the prior design; however, these were considered minor details (para. 33). The main assessment had to be based on the front view of the cooker hood, since that was the only relevant view in the course of normal usage of the cooker hood by the informed user (para. 49). In both cooker hood designs, the latter’s attention would be drawn more to the three slanted overlapping panels of the canopy, which were all of the same proportions, than to the more simply designed chimney (para. 44). Moreover, the angles at which those panels were tilted were also very similar (para. 53). **Lack of individual character:** the extremely similar design of the canopy meant that the cooker hoods both produced a similar overall impression on the informed user that could not be counteracted by the slight differences. Taking into account the ample degree of freedom of the designer in the context of cooker hoods, the RCD coincided in several essential elements with the prior design. The overall impression produced by the contested design on an informed user did not differ in any way from that produced by the earlier design (para. 55). The question whether a design followed current trends might affect its commercial success but was not a criterion for assessing individual character (para. 58).

♦[T-114/16](#); **DESIGN OF INFRARED CABINS AND SAUNAS**; *Delfin Wellness GmbH v EUIPO*; Judgment of 13 December 2017; EU:T:2017:899; Language of the case: DE.

| RCDs | Earlier designs |
|---|--|
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The intervener is the proprietor of the three contested Community designs represented above, all registered on 17 December 2008 for *infrared cabins, saunas* in Class 23.02 of the Locarno Classification. The applicant filed an application for invalidity on the grounds that, as it had been selling these designs since at least 2007, the RCDs did not meet the condition of



novelty. The ID upheld the application for invalidity pursuant to Article 25(1)(b) CDR on the grounds that the evidence submitted by the applicant demonstrated the disclosure of the contested designs. The intervener filed three appeals against the ID's decisions. The BoA considered that the applicant had not proven an event of disclosure outside the grace period and, therefore, rejected the invalidity application. The applicant raised two pleas in law: (i) incorrect assessment of the evidence for the purposes of Article 7 CDR, and (ii) infringement of the right to be heard. **Assessment of evidence of disclosure:** the intervener was the creator of the contested designs. The applicant and the intervener had previously worked together (para. 42). In view of their commercial relationship, the disclosure by the applicant during the grace period could not be taken into account as it was obviously based on information given by the intervener (para. 44). The evidence submitted was not sufficient to prove disclosure of the design described as RCD No 1 (para. 56). The date mentioned in the catalogue did not establish exactly when the catalogue was made available to the relevant public (para. 58). The order for a TM 1 Elegance cabin did not contain any picture of the cabin and, therefore, did not prove that it was the same design as that of RCD No 1 (para. 59). The fact that the trade names and item numbers of the TM 1 Elegance cabin and the cabin of RCD No 1 were the same did not prove disclosure of the design, as the order had been placed before the publication of said catalogue and might, therefore, have referred to a previous model (para. 62). The same argument is presented for RCDs No 2 and No 3. **Right to be heard:** the applicant had the opportunity to submit its observations and evidence in each of the three proceedings (para. 113).



VII. Enforcement

[C-617/15](#); **Hummel Holding AS / NIKE**; *Hummel Holding A/S v Nike Inc. and Nike Retail B.V.*; Judgment of the Court (Second Chamber) of 18 May 2017, EU:C:2017:390 (Request for a preliminary ruling from the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany)); Language of the case: DE. Where a defendant in proceedings concerning an infringement of an EUTM is domiciled not in the EU but in a third country, such proceedings have to be brought before the EUTM courts of the Member State in which the defendant has an ‘establishment’ (Article 125(1) *in fine* EUTMR). This judgment concerns the definition of the concept of ‘establishment’ under this provision concerning the international jurisdiction of EUTM courts. In the case in question, pending before the referring court, the defendant was domiciled in the US. It had a main subsidiary in the Netherlands and — legally distinct — second-tier subsidiaries in, inter alia, Germany. The question was whether the latter could qualify as ‘establishments’ within the meaning of Article 125(1) *in fine* EUTMR, and if so, under which conditions. The CJ considered that the concept of ‘establishment’ used in Article 125(1) EUTMR had to be construed broadly in order to ensure the widest application of the general ‘defendant’s domicile principle’ also embodied in that provision. This was because it would be easier for a defendant to defend itself before the EUTM courts of a Member State in which it had an establishment and with which it was therefore more closely linked (paras 34-35). Such broad interpretation would not undermine the objective of Article 125(1) EUTMR to strengthen the protection of EUTMs and in particular their unitary character by means of EUTM court decisions that have effect for and cover the entire EU (paras 36 and 28). Consequently, an ‘establishment’ required the existence of a certain real and stable (permanent) commercial presence (personnel, equipment), which had to be visibly linked with the parent company (para. 37). However, it was immaterial whether or not the establishment had legal personality (para. 38), was a direct subsidiary of the parent company (para. 39) or had itself participated in the alleged infringement (para. 40).

[C-433/16](#); **Bayerische Motoren Werke**; *Bayerische Motoren Werke AG v Acacia*; Preliminary ruling of 13 July 2017; EU:C:2017:550; Language of the case: IT. Preventive actions for a declaration of non-infringement of a Community design, where permitted by the applicable national law, have to be brought before an EU design court (Article 81(b) CDR) at the defendant’s domicile (Article 82(1) CDR: *forum rei* principle). This judgment concerned whether the CDR and/or Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (Council Regulation (EC) No 44/2001) contained exceptions to that principle, and under what conditions those exceptions applied. In the case in question, pending before the referring court, Acacia (the applicant) sought from the Italian jurisdiction (i) a declaration of non-infringement of BMW’s (the defendant’s) Community designs; (ii) a declaration of abuse of a dominant market position and unfair competition by BMW; and (iii) an injunction to prevent BMW from taking any action hindering the marketing of Acacia’s replica of BMW’s alloy rims for motor vehicle wheels. Acacia considered its replica products to fall under the ‘repair clause’ (Article 110(1) CDR). BMW is domiciled not in Italy but in Germany. BMW lodged a defence before the Italian jurisdiction: (i) raising, as preliminary points, the non-notification of the application and lack of mandate of Acacia’s lawyer; (ii) contesting in the alternative, but still as a preliminary matter, the jurisdiction of the Italian courts; and (iii) claiming, in the further alternative, that Acacia’s submissions were unfounded. The referring court asked whether or not the Italian courts had international jurisdiction to hear the case. The CJ found that (i) a number of exceptions from the *forum rei* principle provided for in Council Regulation (EC) No 44/2001 had been explicitly excluded by the legislator with



regard to actions for a declaration of non-infringement of a Community design and (ii) that no other exception applied to the facts of the case in question. In line with earlier case-law (05/06/2014, C-360/12, Coty Germany, EU:C:2014:1318 and 18/05/2017, C-617/15, Hummel Holding AS-NIKE, EU:C:2017:390), the CJ confirmed that the CDR excluded the application of certain provisions of Council Regulation (EC) No 44/2001 (Article 79(3) CDR) and instead provided its own *lex specialis* provisions on international jurisdiction (paras 38, 39) in Article 82 CDR. Specifically with regard to actions for a declaration of non-infringement of a Community design (Article 81(b) CDR), the court observed that, where the defendant is domiciled in the EU, these specific rules (Article 82(1), (4) and (5) CDR) provide for exceptions from the *forum rei* principle only (i) in the event of agreement between the parties; (ii) where the defendant has entered an appearance without contesting the jurisdiction of the EU design court seized; and (iii) in cases of *litis pendens* and related actions (paras 40-42). As a consequence, neither the derogation from the *forum rei* principle provided for in Article 22 of Council Regulation (EC) No 44/2001 (registration or validity proceedings concerned with patents, trade marks, designs, or other similar rights) nor that laid down in Article 5(3) of Council Regulation (EC) No 44/2001 (place where the harmful event occurred or may occur) were applicable, both being furthermore explicitly excluded by Article 79(3)(a) CDR (paras 41, 43-44). The CJ found furthermore (para. 49) that the latter exclusion could not be circumvented by having recourse to the ‘connexity’ exception — related further claims, such as abuse of a dominant position and unfair competition, to be heard in the courts for the place where the harmful event occurred or may occur (Article 28 of Council Regulation (EC) No 44/2001). This would compromise the effectiveness of Article 79(3)(a) CDR, which was specifically designed to set aside Article 5(3) of Council Regulation (EC) No 44/2001 with regard to actions concerning the infringement and validity of Community designs (para. 50). With regard to the derogation from the *forum rei* principle based on the entering of an appearance by the defendant provided for in Article 24 of Council Regulation (EC) No 44/2001, the CJ confirmed, in line with its earlier case-law, that such tacit prorogation of jurisdiction was excluded where the defendant ‘unambiguously contests the jurisdiction of the court in its first defence’ (paras 34, 35). As long as this condition was fulfilled, it was immaterial whether the defendant had raised an objection of lack of jurisdiction in the alternative to other procedural objections (para. 36) or further presented, in the alternative, submissions on the substance (para. 33).

[C-231/16](#); **Merck**; *Merck KCaA v Merck & Co. Inc. and Others*; Preliminary ruling of 19 October 2017; EU:C:2017:771; Language of the case: DE. The applicant in the main proceedings Merck KCaA was the proprietor of a national word mark **MERCK**, registered in the United Kingdom, and an EUTM word mark **MERCK**. The name ‘Merck’ was used by the defendants in the main proceedings on the internet in domain names and on social media platforms. On those websites, the dissemination of information was not geographically targeted, with the result that all of the content was accessible in the same form worldwide. On 8 March 2013, the applicant in the main proceedings brought an action before the High Court of Justice of England and Wales, Chancery Division (United Kingdom) against, in particular, Merck & Co. and Merck Sharp & Dohme, for an alleged infringement of its national trade mark due to the use of the name ‘Merck’ in the United Kingdom. On 11 March 2013, the applicant in the main proceedings also brought an action before the Landgericht Hamburg (Regional Court, Hamburg, Germany) against the same defendants, but also against MSD Sharp & Dohme, on the basis of the EUTM **MERCK**. The applicant originally requested the Landgericht Hamburg to adopt an order prohibiting the use of the EUTM **MERCK** throughout the EU, but subsequently restricted the territorial extent of its request to the EU with the exception of the United Kingdom. That restriction was opposed by the defendants in the main proceedings, taking the view that the action pending before the Landgericht Hamburg was inadmissible in the light of Article 136(1)(a) EUTMR. The



Landgericht Hamburg decided to stay the proceedings and to refer questions to the CJ for a preliminary ruling.

Under Article 136(1)(a) EUTMR, where actions for infringement involving the same cause of action and between the same parties are brought in the courts of different Member States, one seized on the basis of an EUTM and the other seized on the basis of a national trade mark, the court other than the court first seized must, of its own motion, decline jurisdiction in favour of that court where the trade marks concerned are identical and valid for identical goods or services.

Is the condition as to the existence of the ‘same cause of action’ satisfied where actions for infringement between the same parties, the first on the basis of a national trade mark concerning an alleged infringement within the territory of a Member State and the second on the basis of an EUTM concerning an alleged infringement in the entire territory of the European Union, are brought before the courts of different Member States (para. 23)?

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

Where the first action concerns an alleged infringement in the territory of one Member State and the second seeks prohibition in the entire territory of the EU, must the court other than the court first seized decline jurisdiction as regards the action for infringement brought before it in its entirety, or should it only decline jurisdiction in respect of the part of the dispute relating to the territory of the Member State referred to in the action for infringement brought before the court first seized (para. 45)?

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

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



Following a partial withdrawal of the applicant's request concerning the Member State referred to in the action brought before the court first seized, the actions for infringement no longer relate to an alleged infringement of a national trade mark and an identical EUTM in the territory of the same Member States. Therefore, the condition as to the existence of the 'same cause of action' is no longer satisfied and the court other than the court first seized is not required to decline jurisdiction in favour of the court first seized (paras 56-58).

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

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



VIII. Others

A. Classification of goods and services

♦[C-577/14 P](#); **LAMBRETТА**; *Brandconcern BV v EUIPO and Scooters India Ltd*; ; Judgment of 16 February 2017; EU:C:2017:122; Language of the case: EN. The intervener was the proprietor of the EUTM **LAMBRETТА**, registered by the EUIPO on 6 August 2002 for, inter alia, *vehicles; apparatus for locomotion by land, air or water* in Class 12. The applicant requested revocation of the trade mark for lack of genuine use pursuant to Article 58(1)(a) and (2) EUTMR. The CD partially upheld the application and revoked the trade mark **LAMBRETТА** in respect of the goods in Class 12. The BoA dismissed the EUTM proprietor's appeal, applying the so-called 'literal approach' to class headings. Since the evidence of use submitted by Scooters India had been limited to the sale of spare parts (and not to vehicles or apparatus for locomotion), the BoA found that 'it cannot be inferred from the sale of spare parts that [Scooters India] has also manufactured and sold ... any vehicle'. The EUTM proprietor filed an action before the GC, alleging infringement of Article 58(2) EUTMR. The GC upheld the appeal and found that, even if *spare parts for scooters* did not actually appear in the alphabetical list of goods in Class 12, the BoA had to examine whether or not there had been genuine use of the mark in respect of the many fittings and parts listed therein. The revocation applicant filed an action before the CJ, seeking annulment of the GC judgment on the basis that there was no temporal limitation of the effects of the 'IP Translator judgment (19/06/2012, C-307/10, IP Translator, EU:C:2012:361). The CJ dismissed the appeal. The CJ referred to paragraph 61 of the IP Translator judgment, where it was established that if the applicant for a trade mark used the heading of a particular class of the Nice Agreement to identify the goods and services covered by the mark applied for, it had to specify whether the application for registration was intended to cover all the goods or services included in the alphabetical list or only some of them (para. 28). In this regard, the CJ upheld the Office's submission that the IP Translator judgment did not concern the proprietors of registered trade marks, but solely applicants for trade marks (para. 29). Therefore, the Rule set out in paragraph 61 of the IP Translator judgment was not applicable to registration of the trade mark **LAMBRETТА**, which took place before the IP Translator judgment (para. 31). Consequently, the CJ considered that the GC had not erred in finding that the words *vehicles; apparatus for locomotion by land, air or water* in the trade mark application filed on 7 February 2000 had to be interpreted as seeking to protect the mark **LAMBRETТА** in respect of all the goods in the alphabetical list in Class 12 (para. 32). The CJ also upheld the Office's practice regarding Class Headings, namely Communication Nos 04/03 and 02/12 (paras 31 and 32).

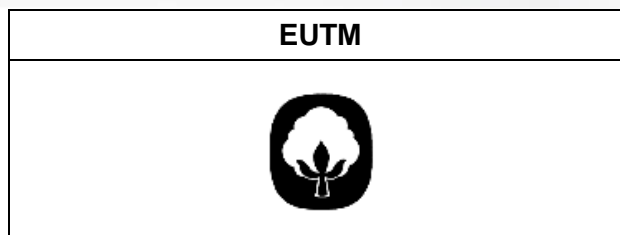
♦[C-501/15 P](#); **CACTUS OF PEACE DE LA PAZ / CACTUS**; *Cactus SA v EUIPO*; Judgment 11 October 2017; EU:C:2017:383; Language of the case: EN. The applicant sought to register the figurative mark **CACTUS OF PEACE CACTUS DE LA PAZ** as an EUTM for goods and services in Classes 31, 39 and 44. An opposition based, inter alia, on the earlier EUTM figurative mark **CACTUS**, registered for goods and services in all class headings of Classes 2, 3, 5 to 9, 11, 16, 18, 20, 21, 23 to 35, 39, 41 and 42, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition for goods and services in Classes 31 and 44. The BoA upheld the EUTM applicant's appeal. It found that the OD had erred in considering that the opponent had adduced proof of genuine use of the earlier trade marks for *retailing of natural plants and flowers, grains; fresh fruits and vegetables* in Class 35. The opponent filed an action before the GC, relying on three pleas in law: (i) infringement of Article 47(2) EUTMR, (ii) infringement of Article 94 and Article 95(1) EUTMR, and (iii) infringement of Article 95(2) EUTMR. The GC partly upheld the action. It annulled the



decision at issue to the extent that it, first, had rejected the opposition on the grounds that *retailing of natural plants and flowers, grains; fresh fruits and vegetables* were not covered by the designation of the class heading of Class 35 of the earlier trade mark; second, had rejected the opposition on the basis of *natural plants and flowers, grains* in Class 31; and third, had considered that use of the earlier mark had not been made in the form as registered. It dismissed the action for the remainder of the goods and services. The Office filed an appeal before the CJ, raising two grounds of appeal: (i) infringement of Article 33 EUTMR in conjunction with Rule 2 of Implementing Regulation (EC) No 2868/95 and (ii) infringement of Article 47(2) in conjunction with Article 18(1)(a) EUTMR. The CJ dismissed the appeal. According to the ‘IP Translator’ judgment (19/06/2012, C-307/10, IP Translator, EU:C:2012:361, § 57-64), the general indications of a given class heading of the Nice Classification may cover all the goods or services included in the alphabetical list of that class, providing two cumulative conditions are fulfilled: the individual terms making up the class heading must be sufficiently ‘clear and precise’, and the application must reflect the applicant’s intention to cover all the goods or services included in the alphabetical list of the class in question. According to the ‘Praktiker Bau’ judgment (07/07/2005, C-418/02, Praktiker, EU:C:2005:425, § 50), retail trade in goods constitutes a service but the applicant must specify the goods or types of goods to which the retail trade relates (para. 44). **Non applicability of the ‘IP Translator’ and ‘Praktiker Bau’ judgments to EUTMs registered before their adoption:** regarding the first plea based on infringement of Article 33 EUTMR, the CJ confirmed the ‘Brandconcern’ judgment (16/02/2017, [C-577/14 P](#), LAMBRETTA, EU:C:2017:122, § 29-31) by stating that the guidance set out in ‘IP Translator’ and ‘Praktiker Bau’ applied only to trade marks registered after the date of adoption of those judgments (paras 36 and 45-48). Those judgments therefore did not have retroactive effect. The scope of the protection afforded by trade marks registered before those dates could not be altered on the basis of Communication No 02/12 (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 for Community trade mark applications and registrations, point V), which was a non-binding communication with no function other than to provide clarification for applicants on EUIPO practices (para. 40). The provision under Article 33(8) EUTMR was not applicable at the date of the decision at issue (para. 49). In the light of all the above arguments, the CJ confirmed that, for the earlier trade marks at issue, the designation of the class heading of Class 35 covered all the services included in that class, including services consisting of the retail of goods (para. 50).

B. EU collective marks

[C-689/15](#); **W. F. Gözze Frottierweberei+Gözze / International cotton certification**; *W.F. Gözze Frottierweberei GmbH, Wolfgang Gözze v Verein Bremer Baumwollbörse*; Preliminary ruling of 8 June 2017; EU:C:2017:434; Language of the case: DE. The applicant in the infringement proceedings before the European Union trade mark court (‘the applicant’) was an association engaged in various activities linked to cotton. It was the proprietor of the following individual, figurative EUTM, registered in particular for textiles (‘the cotton flower mark’).



The cotton flower mark had been used by manufacturers of textiles made from cotton fibres to certify the composition and the quality of their goods. Since registration, the applicant had concluded licence agreements in respect of its cotton flower mark with undertakings affiliated with the association. Those undertakings agreed to use the mark only for goods made from good-quality cotton fibres. Compliance with this commitment could be checked by the applicant. The defendant in the infringement proceedings before the European Union trade mark court ('the defendant') had not concluded a licence agreement with the applicant. It manufactured textiles made from cotton fibres. The infringement proceedings had been directed against the defendant's sale of towels to which hangtags are attached with the following backside:



The defendant brought a counterclaim for cancellation of the cotton flower mark, claiming that it is purely descriptive and non-distinctive and had not been put to genuine use by the applicant or its licensees. Firstly, the referring court asked whether Article 18(1) EUTMR was to be interpreted as meaning that the affixing of an individual EUTM, by the proprietor or with its consent, to goods as a label of quality was a trade mark use that fell under the concept of 'genuine use' within the meaning of that provision, with the result that the proprietor of that mark was entitled, pursuant to Article 9(1)(b) EUTMR, to prevent the affixing by a third party of a similar sign to identical goods where there is a LOC as referred to in the latter provision (para. 33). It was indispensable that a mark be used in accordance with its essential function, which was to indicate the origin of the goods or services marked with it. It might admittedly also be used to fulfil other functions, such as that of guaranteeing the quality of the goods or services. However, where the use of an individual mark, despite certifying the composition or quality of the goods or services, did not guarantee to consumers that the goods or services came from a single undertaking under the control of which they were manufactured or supplied and which, consequently, was responsible for the quality of those goods or services, such use was not made in accordance with the function of indicating origin. It follows that there was no use in accordance with the essential function of the individual mark where it was affixed to goods for the sole purpose of being a label of quality for those goods and not that of guaranteeing, in addition, that the goods came from a single undertaking under the control of which they were manufactured and which was responsible for their quality (paras 40-46). It was for the referring court to verify whether evidence made it possible to consider that the affixing of the cotton flower mark by the applicant's licensees to their goods guaranteed to consumers that the goods came from a single undertaking, namely the applicant's association, under the control of which the goods were manufactured and which was responsible for their quality. In any event, the fact that the licence agreements enabled the applicant to verify that the licensees use exclusively good-quality cotton fibres could not constitute such evidence. It implied, at most, that the applicant certified the quality of the raw



material used. As was apparent from Article 74 EUTMR and Article 83 EUTMR, such certification might suffice for the view to be taken that a mark other than an individual mark fulfilled its function as an indication of origin. However, the dispute in the main proceedings concerned an individual mark registered for goods (paras 49-50). Secondly, the referring court asked whether Article 59(1)(a) and Article 7(1)(g) EUTMR had to be interpreted as meaning that an individual mark might be declared invalid where the proprietor of the mark failed to ensure, by carrying out periodic quality controls at its licensees' premises, that expectations relating to the quality which the public associated with the mark were being met (para. 52). It was for the referring court to examine whether the cotton flower sign filed by the applicant was capable per se of deceiving the consumer. The subsequent management by the applicant of its mark and licences for its use was irrelevant in this respect and, therefore, the mark could not be declared invalid on the grounds that the proprietor of the mark failed to ensure, by carrying out periodic quality controls at its licensees' premises, that expectations relating to the quality which the public associated with the mark were being met (paras 52-57). Thirdly, the referring court asked whether the EUTMR had to be interpreted as meaning that its provisions on collective EUTMs could be applied *mutatis mutandis* to individual EUTMs (para. 58). The scope of Article 74 to 82 EUTMR, relating to collective EUTMs, was expressly confined, according to the wording of Article 74(1) EUTMR, to marks described as such when applied for. The demarcation of the applicability of those articles had to be strictly adhered to, especially as the rules they introduced, such as those set out in Article 75 EUTMR concerning regulations governing use of the mark, went hand in hand with the requirement, when filing the application for registration, to expressly describe the mark applied for as a collective mark. Therefore, it was not possible to apply those rules by analogy to individual EU trade marks (paras 58-60).

♦[C-673/15 P](#) to [C-676/15 P](#) (joined cases); **Darjeeling / DARJEELING et al.**; *The Tea Board v EUIPO*; Judgment of 20 September 2017; EU:C:2017:702, Language of the case: EN. The applicant sought to register the figurative marks **Darjeeling** as EUTMs for goods and services in Classes 25, 35 and 38. An opposition based on the earlier EU collective marks **DARJEELING**, registered for goods in Class 30, was filed pursuant to Article 8(1)(b) and Article 8(5) EUTMR. The OD dismissed the oppositions. The BoA dismissed the appeals and upheld the OD's decisions. The applicant filed four actions before the GC, relying on two pleas in law: (i) infringement of Article 8(1)(b) and (ii) infringement of Article 8(5) EUTMR. The GC rejected the first plea as unfounded and upheld the second plea in part. The owner of the earlier right/the opponent filed an appeal before the CJ, alleging infringement of Article 8(1)(b) and Article 8(5) EUTMR. The EUTM applicant filed a cross-appeal before the CJ, alleging, first, a distortion of the respective functions of trade marks and PGIs and, second, inconsistency in the GC's reasoning and an error of law in the application of Article 8(5) EUTMR. **The main appeal:** regarding the first ground of appeal, the CJ stated that the GC had not erred in law when it held that the essential function of an EU collective mark was to distinguish the goods or services of the members of the association that was the proprietor of the trade mark from those of other undertakings, thereby guaranteeing their collective commercial origin (para. 57), and not to distinguish those goods according to their geographical origin (para. 63). With regard to the second ground of appeal, the appellant had failed to substantiate the complaint of distortion of the facts (para. 70). Furthermore, as regards the argument that the qualities conveyed by the word element 'darjeeling' were capable of being transferred to the whole body of services for which registration was sought, this actually aimed at obtaining an assessment of the facts from the CJ and consequently had to be rejected as inadmissible (para. 72). **The cross-appeal:** the CJ found that the GC had not adopted a position on whether proof of the reputation of the earlier trade marks had been adduced, or on whether, for the purpose of establishing such proof, the reputation enjoyed by the name 'Darjeeling' as a geographical indication for tea could be transferred to



the same sign protected as a collective trade mark for identical goods. Therefore, the first part of the single ground of appeal was based on a misreading of the judgments under appeal and was rejected as unfounded (paras 80-81). Additionally, the GC had not contradicted itself when it held, on the one hand, that the consumer of goods covered by the earlier trade marks would not be led to believe that the goods and services covered by the trade marks applied for originated from the Darjeeling region, while considering, on the other hand, that the consumer of the goods and services covered by the trade marks applied for by the intervener could be attracted by the values and positive qualities connected with that region (para. 93). Therefore, the second part of the single ground of appeal was rejected and the cross-appeal was dismissed in its entirety (para. 94).

C. Exhaustion of rights

[C-291/16](#); **Schweppes S.A.**; *Schweppes SA v Red Paralela SL*; Judgment of the Court (Second Chamber) of 20 December 2017; EU:C:2017:990; Preliminary ruling from the Juzgado de lo Mercantil n° 8 of Barcelona; Language of the case: ES. The sign ‘Schweppes’, protecting in particular *tonic water*, was registered not as an EUTM but as a national mark in each of the Member States of the European Economic Area (EEA). This bundle of parallel national trade marks was originally owned by one single proprietor (Schweppes). Subsequently, the latter had assigned some of those parallel trade marks to Coca-Cola and the bundle of national parallel trade marks was therefore divided territorially as follows (blue areas for Coca-Cola):



Schweppes’ licensee in Spain sought to prevent Red Paralela from importing tonic water that was already placed on the EU market under the Schweppes mark owned by Coca-Cola. In its defence, Red Paralela contended that Schweppes’ exclusive trade mark rights were already exhausted, given that Schweppes had consented to the placing of the goods in the EEA under its mark. The referring judge asked the CJ under what conditions the proprietor of a national trade mark could prevent the import of identical goods bearing the same mark originating in another Member State that it had originally owned but had subsequently assigned to a third party. The judgment confirmed the principle that there was no exhaustion of a national trade mark in such a situation — provided that there was no economic link between the old and the new proprietor of the parallel national marks. In the absence of such economic links, the parallel national marks fulfilled their essential function within the various territories of protection (paras 38-39, 43). In the presence of such economic links, the partitioning of the national markets was neither justified nor necessary for preserving the essential function of the marks concerned (para. 47). The judgment clarified that the existence of an economic link was to be assessed on the basis of functional criteria as opposed to purely formal criteria (para. 46): the mere ability to control the quality of the goods concerned was sufficient (para. 49). An economic link between the proprietors of



different trade marks existed where the proprietors coordinated their commercial policies or reached an agreement to exercise joint control over the use of those marks (para. 46). In line with previous case-law on exhaustion, the judgment alleviated the parallel importer's burden of proof with regard to the existence of an economic link between the trade mark owners of a divided bundle of parallel national marks (paras 52-54). It was sufficient to put forward a body of precise and consistent (circumstantial) evidence [FR and ES: 'indices'] from which it could be inferred that such economic links existed (para. 54).

D. Fax transmission reports

♦[T-367/15](#); **AVE**; *Renfe Operadora, Entidad Pública Empresarial v EUIPO*; Judgment of 5 April 2017; EU:T:2017:255; Language of the case: ES. The CD revoked the contested EUTM **AVE** partially, including for some goods under the description *vehicles; vehicles for locomotion by land* in Class 12. The language of the proceedings was English. The EUTM proprietor filed a notice of appeal in Spanish against the CD's decision. The BoA rejected the appeal on the ground that it had not been filed in the language of the proceedings and no English translation had been submitted within the time limit. The applicant lodged an action against that decision before the GC (which dismissed it by its judgment of 24/11/2014, [T-616/14](#), **AVE** (fig.), EU:T:2014:1014) and filed in parallel a request for *restitutio in integrum* based on Article 104(1) EUTMR. The BoA rejected the application for *restitutio in integrum* since the applicant had failed to prove that it had taken all due care required by the circumstances within the meaning of Article 104(1) EUTMR to avoid non-observance of the time limit for filing the English translation of its notice of appeal. The EUTM proprietor filed an action before the GC against this decision. The GC dismissed the action. Taking into account the case-law concerning Rule 49 of Implementing Regulation (EC) No 2868/95, the GC confirmed that the Office did not have the power to grant an additional period to comply with Rule 48(2) of Implementing Regulation (EC) No 2868/95. All the arguments concerning the time limits for compliance with Article 68 EUTMR and Rule 48 of Implementing Regulation (EC) No 2868/95 were irrelevant within the scope of the proceedings in question, where the issue to be assessed was whether the applicant had proven that it had taken all due care required by the circumstances (paras 37-40). The fact that the applicant had used a pre-printed form to file its notice of appeal was not sufficient reason for showing less diligence. The applicant was still obliged to submit this form in the language of the proceedings within the established deadlines (paras 42-44). The GC restated that the BoA was not obliged to take a position on all the arguments raised by the parties and that a fax report could be sufficient evidence of receipt, as in the case in question. The GC confirmed that the BoA had correctly determined that the evidence submitted was unable to counteract the evidence provided by the fax report and observed that this evidence suggested that the alleged circumstances were not exceptional events (paras 45-55). The GC also confirmed that the BoA's acknowledgement and notification of receipt of an appeal did not constitute a decision on its admissibility and that the opposite could not be inferred from the content of its letter. Therefore, this could not justify the applicant's failure to comply with the established time limits. The alleged Office practice of informing appellants about irregularities in their appeals was irrelevant for determining whether the applicant had shown due care, since the time limits were already established in the corresponding provisions and had to be fulfilled (paras 57-61). The GC found that the allegation of lack of equal treatment was unfounded (para. 64) and confirmed the BoA's finding that the applicant's failure to comply with the time limit was attributable to human error and not the result of exceptional or unforeseeable events (para. 68). Lastly, the GC considered that the action concerned the re-establishment



of the applicant's rights and not the correctness of the BoA's contested decision in Case T-616/14. Consequently, all the arguments relating to the infringement of the right of defence were dismissed (paras 70-75).

♦[T-97/16](#); **GEOTEX**; *Martin Kasztantowicz v EUIPO*; Judgment of 4 May 2017; EU:T:2017:298; Language of the case: DE. A cancellation action pursuant to Article 58(1)(a) EUTMR (non-use) was filed against the EUTM **GEOTEK**. The CD sent a fax informing the EUTM owner about the cancellation action and asking the owner to provide evidence of genuine use of the contested EUTM by 24 May 2014. The fax was sent to the fax number provided by the owner in the EUTM application form. The Office had never been informed of any change of number. On 2 June 2014, the CD informed the owner via fax and ordinary mail that the Office had not received any response and that it would therefore take a decision based on the evidence on file. It is undisputed that the owner did not receive the notification. After requesting access to the Office's electronic communication service on 23 June 2014, the owner informed the Office that he had not received any of the notifications due to a change of postal address (no change of fax number was mentioned). He also informed the Office of his new address and sent evidence of use of the earlier mark. On 26 September 2014, the CD annulled the contested EUTM pursuant to Rule 40(5) of Implementing Regulation (EC) No 2868/95 since no PoU had been submitted in due time (namely by 24 May 2014). Upon appeal, the owner offered oral witness statements for the fact that he had changed his postal address. He argued that the evidence had been submitted on time because he had never received the notification of the cancellation request due to his change of address. He also offered a witness statement to prove that he had not received the fax, without mentioning any concrete facts in this respect. The BoA confirmed the CD's decision. It held that the Office's fax notifying the cancellation request and setting the deadline for proving genuine use of the contested EUTM had been duly sent by the Office and received by the owner. This was shown by the Office's fax report. The Office had always used the same fax number since the filing of the contested EUTM. The owner had never informed the Office of a change of number. The BoA further held that it enjoyed a power of discretion pursuant to Article 95(2) EUTMR to take into account the evidence filed on 23 June and therefore belatedly. Exercising this power of discretion, it held that the circumstances of the case did not justify taking the belated evidence into account or hearing witnesses. **On Article 58(1) EUTMR in conjunction with Rule 40(5), Rule 61(2) and (3) and Rule 65(1) of Implementing Regulation (EC) No 2868/95**: pursuant to Rule 61(2) of Implementing Regulation (EC) No 2868/95, as interpreted by the GC, any kind of Office decisions can be notified via telecopier (fax). Pursuant to Rule 65(1), second sentence, of Implementing Regulation (EC) No 2868/95, a notification is deemed to have been made on the date on which the communication was received by the recipient's telecopying device. It is sufficient that the notification is received by the recipient and that the recipient is in a position to take note of it (the external aspect of notification); actual knowledge (the internal aspect of notification) by the recipient is not necessary (paras 38-40). Regarding the external aspect of notification, the sender has to prove that it took measures to ensure that the fax entered the 'sphere' of the recipient. It must prove not only that the fax was sent but also that it was transmitted in a way that would allow the recipient to take note of its content. However, the sender is not obliged to prove that the recipient actually did take note of the content (internal aspect). The sender is not in a position to intrude into the recipient's organisation in order to ensure that note is taken of the communication (para. 41). The GC had already decided in previous judgments that fax reports were sufficient to show receipt of a fax (para. 42). Fax machines report any problem with transmission or receipt. The lack of an 'error' message and the existence of a fax report showing 'OK' therefore indicated that the fax had been duly sent and received (para. 42). This did not imply that the recipient was not allowed to prove the contrary, for example because of an accident, force majeure or an error outside the



recipient's responsibility (paras 43 and 44). However, there was no indication whatsoever on file that the owner had not received the fax in question despite the Office's 'OK' fax report (para. 45). The owner did not argue or submit proof to the contrary, for example in the form of a technical error that could not have been envisaged or prevented by the owner (para. 46). Owing to the fax report and the lack of arguments to the contrary, the Office was entitled to assume that the fax had indeed been received by the owner, thus setting the deadline for proving genuine use (para. 46). The testimonies offered were not relevant because the facts they contained, even if proven, were irrelevant (para. 50).

♦[T-699/15](#); **CityTrain**; *City Train GmbH v EUIPO*; Judgment of 21 June 2017; EU:T:2017:409; Language of the case: DE. The applicant sought to register the figurative mark **CityTrain** as an EUTM for goods and services in Classes 12, 37 and 42. The Office refused the registration of the EUTM application pursuant to Article 7(1)(b)(c) and 7(2) EUTMR, as it was found to be descriptive and devoid of distinctive character. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. However, this arrived one day after the end of the appeal period. The GC refused the Office's request to dismiss the appeal as being belated. According to the GC, the application was belated due to unforeseeable circumstances. The applicant had sent the application via fax and courier more than 2 weeks ahead of the end of the appeal period. While the fax was received by the GC on the same day it was sent, the hard copy of the appeal did not arrive until one day after the end of the appeal period. According to the GC, the applicant had sent off the hard copy of the application in time to ensure its delivery well before the expiry of the appeal period.

E. Licences

♦[T-132/15](#); **popchrono**; *IR v EUIPO*; Judgment of 14 March 2017; EU:T:2017:162; Language of the case: EN. The EUTM proprietor was granted registration of the word mark **POPCHRONO** as an EUTM for goods and services in Class 12. An application for revocation was filed pursuant to Article 58 EUTMR. The CD upheld the application for revocation. The BoA dismissed the EUTM proprietor's appeal. It found that the EUTM proprietor had not proven genuine use of the contested EUTM. The GC held that the evidence of use consisted of the offer of licence agreements to use the contested mark, which could not be considered genuine use, even if this were the intention of the EUTM proprietor. The use by the licensees could have amounted to genuine use, but there was no evidence of any use by them (paras 83-85).

F. Professional representation

♦[T-527/14](#); **PAUL ROSENICH**; *Rosenich v EUIPO*; Judgment of 13 July 2017; EU:T:2017:487; Language of the case: EN. The Director of the 'Operations Support Department' of the Office had rejected the applicant's request for inclusion on the list of professional representatives, reasoning that residence in a country of the EU was a requirement for being included in the list pursuant to Article 120(2)(b) EUTMR, and the applicant was resident in Lichtenstein. The applicant filed an appeal, relying on the EEA Agreement and arguing that his place of residence in Lichtenstein should be considered equivalent to residence within the EU. The BoA refused the appeal, reasoning that the EEA Agreement defined in its annexes the provisions that should apply to the EEA area instead of



the EU area, and the EUTMR was not one of them (Article 65(2) of the EEA Agreement in conjunction with Protocol 1 and Annex XVII thereto). The principle of freedom to provide services within the EEA pursuant to Article 36(1) of the EEA Agreement could not be applied directly. The applicant filed an action before the GC, claiming infringement of Article 120 EUTMR in conjunction with the principle of freedom to provide services within the EEA. The Office defended the decision, reasoning that, if the reading of Article 120(2)(b) EUTMR in the sense claimed by the applicant followed from the obligations under the EEA Agreement, it was for the legislator to amend the quoted provision accordingly. Neither the Office nor the BoA could interpret the provision against the clear wording. Whether such an interpretation was correct in the light of the EEA Agreement could only be decided by the GC. Amending Regulation (EU) 2015/2424 of 16 December 2015 had amended the provision of Article 120(2)(b) EUTMR to include the residents of the EEA countries. The GC annulled the decision taken by the Director of the 'Operations Support Department' of the Office on 7 September 2012, by which the applicant's request to be included in the list of professional representatives before the EUIPO was rejected, accordingly altering the BoA's decision. The GC decided that the provision of Article 120(2)(b) EUTMR in the version before the amendment should have been interpreted as including residents of EEA countries in the light of Article 36(1) of the EEA Agreement, regarding the freedom to provide services. The GC reasoned in that regard that Article 36(2) of the EEA Agreement applied directly (para. 65). Residence in an EEA country did not affect the quality of representation (para. 71) or complicate the proceedings (para. 73). It was not necessary in the interests of justice (para. 74). Whether or not Lichtenstein's law contained reciprocal provisions regarding representation before the IP Office in Liechtenstein was not relevant for the direct application of Article 36(1) of the EEA Agreement, but was a matter for the Surveillance Authority or the dispute resolution process pursuant to Articles 109 and 111 of the EEA Agreement (para. 79). Indeed, the principle that secondary law had to be interpreted in conformity could not serve as the basis for an interpretation of that law *contra legem*. However, it was not apparent that the *ratio legis* of Article 120(2)(b) EUTMR in the old version had been to exclude the residents of the EEA countries (paras 83 and 84). In particular, the changes made to the wording of Article 120(2)(b) EUTMR by Amending Regulation (EU) 2015/2024, when the term 'European Community' was replaced by 'EEA', showed that the legislator considered it to be only a technical adjustment, as it had been introduced at a late stage of the legislation process and without being mentioned in the recital thereto (para. 86). The GC fulfilled the conditions for exercising the power to alter decisions and, in this case, exercised them by annulling the decision of the Director of the 'Operations Support Department' of 7 September 2012 insofar as it had rejected the applicant's request pursuant to Article 120(2)(b) EUTMR.

G. Renewals

♦[T-178/16](#); **Policolor / ProfiColor**; *CWS-Lackfabrik Conrad W.Schmidt GmbH & Co. KG v EUIPO*; Judgment of 6 April 2017; EU:T:2017:264; Language of the case: EN. The applicant sought to register the figurative mark **Policolor** for goods in Class 2. An opposition based on the earlier figurative mark **ProfiColor**, registered for goods in Class 2, was filed pursuant to Article 8(1)(b) EUTMR. The OD upheld the opposition. The BoA dismissed the appeal. The applicant filed an action before the GC, relying on three pleas in law: (i) infringement of Article 8(1)(b) EUTMR, (ii) infringement of Article 94 EUTMR, and (iii) invalidity of the earlier mark. The GC dismissed the appeal. **Validity of the earlier mark**: no account could be taken of the non-renewal of the earlier mark, as the proprietor could, pursuant to Article 53(3)



EUTMR, still submit a request within 6 months following the expiry of registration. Any revocation of the earlier mark was also irrelevant for the purpose of assessing the legality of the contested decision, as the revocation proceedings, which were still pending before the Office, had been initiated after the contested decision had been adopted. The action brought in the present case related to an earlier mark that had been in effect at the time when the contested decision was adopted (paras 21-23).

H. *Restitutio in integrum* (Article 67 CDR and Article 104 EUTMR)

♦[T-367/15](#); **AVE**; *Renfe Operadora, Entidad Pública Empresarial v EUIPO*; Judgment of 5 April 2017; EU:T:2017:255; Language of the case: ES. The CD revoked the contested EUTM **AVE** partially, including for some goods under the description *vehicles; vehicles for locomotion by land* in Class 12. The language of the proceedings was English. The EUTM proprietor filed a notice of appeal in Spanish against the CD's decision. The BoA rejected the appeal on the ground that it had not been filed in the language of the proceedings and no English translation had been submitted within the time limit. The applicant lodged an action against that decision before the GC (which dismissed it by its judgment of 24/11/2014, [T-616/14](#), **AVE** (fig.), EU:T:2014:1014), and filed in parallel a request for *restitutio in integrum* based on Article 104(1) EUTMR. The BoA rejected the application for *restitutio in integrum* since the applicant had failed to prove that it had taken all due care required by the circumstances within the meaning of Article 104(1) EUTMR to avoid non-observance of the time limit for filing the English translation of its notice of appeal. The EUTM proprietor filed an action before the GC against this decision. The GC dismissed the action. Taking into account the case-law concerning Rule 49 of Implementing Regulation (EC) No 2868/95, the GC confirmed that the Office did not have the power to grant an additional period to comply with Rule 48(2) of Implementing Regulation (EC) No 2868/95. All the arguments concerning the time limits for compliance with Article 68 EUTMR and Rule 48 of Implementing Regulation (EC) No 2868/95 were irrelevant within the scope of the proceedings in question, where the issue to be assessed was whether the applicant had proven that it had taken all due care required by the circumstances (paras 37-40). The fact that the applicant had used a pre-printed form to file its notice of appeal was not sufficient reason for showing less diligence. The applicant was still obliged to submit this form in the language of the proceedings within the established deadlines (paras 42-44). The GC restated that the BoA was not obliged to take a position on all the arguments raised by the parties and that a fax report could be sufficient evidence of its receipt, as in the case in question. The GC confirmed that the BoA had correctly determined that the evidence submitted was unable to counteract the evidence provided by the fax report and observed that this evidence suggested that the alleged circumstances were not exceptional events (paras 45-55). The GC also confirmed that the BoA's acknowledgement and notification of receipt of an appeal did not constitute a decision on its admissibility and that the opposite could not be inferred from the content of that letter. Therefore, this could not justify the applicant's failure to comply with the established time limits. The alleged Office practice of informing appellants about irregularities in their appeals was irrelevant for determining whether the applicant had shown due care, since the time limits were already established in the corresponding provisions and had to be fulfilled (paras 57-61). The GC found that the allegation of lack of equal treatment was unfounded (para. 64) and confirmed the BoA's finding that the applicant's failure to comply with the time limit was attributable to human error and not the result of exceptional or unforeseeable events (para. 68). Lastly, the GC considered that the action concerned the re-establishment of the applicant's rights, and not the correctness of the BoA's contested decision in Case



T-616/14. Consequently, all the arguments relating to the infringement of the right of defence were dismissed (paras 70-75).

♦[T-83/16](#); **WIDIBA / ING DiBa et al.**; *Banca Monte dei Paschi di Siena SpA and Wise Dialog Bank SpA (Banca Widiba SpA) v EUIPO*; Judgment of 26 September 2017; EU:T:2017:662; Language of the case: EN. The applicant sought to register the word mark **WIBIDA** for goods and services in Classes 9, 16, 36 and 38. An opposition, based on the existence of a LOC with regard to, inter alia, German trade mark **DiBa** for services in Class 36, was filed against all the goods and services applied for. The OD partially upheld the opposition for some goods and services in Classes 9, 36 and 38. Both parties filed appeals before the BoA. The appeal filed by the opponent was against the dismissal of the opposition with regard to *credit cards*, while the applicant's appeal requested annulment of the OD decision insofar as it upheld the opposition for some of the goods and services in question. The BoA decision upheld the appeal filed by the opponent, considering that there was a LOC also for *credit cards*. In the applicant's case, the BoA rejected the applicant's request for *restitutio in integrum* and consequently considered its appeal inadmissible because the grounds of appeal had not been filed within the relevant period established by the EUTMR. The EUTM applicant filed an action against this decision before the GC, relying on two pleas in law: (i) infringement of Articles 68 and 104 EUTMR and of Rule 49(1) of Implementing Regulation (EC) No 2868/95 and (ii) infringement of Article 8(1)(b) EUTMR. The GC dismissed the action. **Regarding the admissibility of the appeal and the request for *restitutio in integrum***: *restitutio in integrum* is subject to two requirements: first, that the requesting party has exercised all due care required by the circumstances and, second, that the obstacle to the party's compliance has the direct consequence of causing a loss of rights or means of redress (para. 27). Representatives are subject to the requirement to exercise due care just as much as other persons. 'Due care required by the circumstances' requires the putting in place of a system of internal checking and monitoring of time limits that generally excludes involuntary non-compliance with time limits. In this case, the obligation to exercise due care did not specifically relate to the actions of the offending employee but to the obligations of the representative before the Office in terms of organisation and checks (para. 39). Consequently, the BoA had not erred in considering it inappropriate to grant the request for *restitutio in integrum*, given that the party had not exercised all due care required by the circumstances (para. 42). Owing to the failure to file a statement of grounds of appeal within the relevant time limit established by Article 68 EUTMR, and in accordance with Rule 49(1) of Implementing Regulation (EC) No 2868/95, which establishes that, in the event of a deficiency linked to non-compliance with that rule, the Office cannot award an additional time limit, the BoA had correctly rejected the appeal as inadmissible (paras 35-37).

♦[T-84/16](#); **WIDIBA / ING DiBa et al.**; *Banca Monte dei Paschi di Siena SpA and Wise Dialog Bank SpA (Banca Widiba SpA) v EUIPO*; Judgment of 26 September 2017; EU:T:2017:661; Language of the case: EN. The applicant sought to register the figurative mark **WIDIBA** for goods and services in Classes 9, 16, 36 and 38. An opposition, based on the existence of a LOC, was filed against all the goods and services applied for. The OD partially upheld the opposition for some goods and services in Classes 9, 36 and 38. Both parties filed appeals before the BoA. The appeal filed by the opponent was against the dismissal of the opposition with regard to *credit cards*, while the applicant's appeal requested annulment of the OD decision insofar as it upheld the opposition for some of the goods and services in question. The BoA decision upheld the appeal filed by the opponent, considering that there was a LOC also for *credit cards*. In the applicant's case, the BoA rejected the applicant's request for *restitutio in integrum* and consequently considered its appeal inadmissible because the grounds of appeal had not been filed within the relevant period established by the EUTMR. The EUTM applicant filed an action against this decision before the GC, relying on two pleas



in law: (i) infringement of Articles 68 and 104 EUTMR and of Rule 49(1) of Implementing Regulation (EC) No 2868/95 and (ii) infringement of Article 8(1)(b) EUTMR. The GC dismissed the action. **Regarding the admissibility of the appeal and the request for *restitutio in integrum*:** *restitutio in integrum* is subject to two requirements: first, that the requesting party has exercised all due care required by the circumstances and, second, that the obstacle to the party's compliance has the direct consequence of causing a loss of rights or means of redress (para. 27). Representatives are subject to the requirement to exercise due care just as much as other persons. 'Due care required by the circumstances' requires the putting in place of a system of internal checking and monitoring of time limits that generally excludes involuntary non-compliance with time limits. In this case, the obligation to exercise due care did not specifically relate to the actions of the offending employee but to the obligations of the representative before the Office in terms of organisation and checks (para. 39). Consequently, the BoA had not erred in considering it inappropriate to grant the request for *restitutio in integrum*, given that the party had not exercised all due care required by the circumstances (para. 42). Owing to the failure to file a statement of grounds of appeal within the relevant time limit established by Article 68 EUTMR, and in accordance with Rule 49(1) of Implementing Regulation (EC) No 2868/95, which establishes that, in the event of a deficiency linked to non-compliance with that rule, the Office cannot award an additional time limit, the BoA had correctly rejected the appeal as inadmissible (paras 35-37).

I. Surrenders

♦[T-176/16](#); **UGO / il UGO!**; *Kofola ČeskoSlovensko a.s. v EUIPO*; Judgment of 6 October 2017; EU:T:2017:704; Language of the case: EN. The OD upheld the opposition for all the goods in Class 32. The BoA dismissed the appeal against the OD's decision. Despite a low degree of visual similarity, there was a LOC due to the aural identity of the signs, the identity of the goods and the average distinctiveness of the earlier mark. The GC dismissed the action. **Partial surrender of the earlier mark:** the applicant submitted before the GC that, as the opponent had surrendered the earlier mark in respect of the goods on the basis of which the opposition had been successful, the action should be devoid of purpose. However, as the surrender took effect after the contested decision, it was held that, at the date of the adoption of that decision, the earlier mark did indeed benefit in full from all the effects laid down by the provisions of Section 1 of Title VI of Regulation (EC) 207/2009 (para. 26). The applicant's form of order seeking the closure of the opposition proceedings was rejected (para. 30).

J. Suspensions

♦[T-811/14](#); **FAIR & LOVELY / NEW YORK FAIR & LOVELY**; *Unilever NV / EUIPO*, Judgment of 17 February 2017; EU:T:2017:98; Language of the case: EN. The OD allowed an opposition based on Article 8(1)(b) EUTMR and rejected the contested trade mark application. It found a LOC with one of the several national earlier rights (a Spanish mark) that had been invoked as the basis of the opposition. The BoA dismissed the appeal as it found a LOC with another of the earlier national marks (a Benelux mark) upon which the opponent had relied. This was after the BoA had rejected the applicant's request for suspension of the appeal proceedings, made on the ground that the applicant claimed to have started cancellation actions against, inter alia, the opponent's earlier Benelux mark. The applicant had filed evidence to support its claim that the earlier Benelux had been attacked.



Before the GC, the applicant claimed, inter alia: (i) that the BoA was not entitled — or, at least, not without giving the applicant the right to be heard — to reject the appeal on the basis of a finding of a LOC with respect to an earlier mark other than that examined by the OD; (ii) that the BoA had made, inter alia, manifest errors of assessment when examining and analysing the evidence submitted by the applicant in support of its request for suspension of the appeal proceedings. **Suspension of the proceedings:** the GC upheld the second plea as it found an infringement of Rule 20(7)(c) of Implementing Regulation (EC) No 2868/95. First, it confirmed the established case-law that the BoA has broad powers of discretion as regards decisions on requests for suspension of the appeal proceedings (para. 54) and that an attack upon the earlier mark does not in itself oblige the BoA to suspend the proceedings (para. 61). It further indicated, albeit indirectly, that ‘*fumus boni iuris*’ considerations are to be taken into account when assessing a request for suspension (para. 67 *in fine*). Second, the GC confirmed the established case-law that decisions on suspensions are subject to judicial review, albeit restricted to the misuse of powers, manifest errors of assessment (para. 55) and observance of ‘the general principles governing procedural fairness within a European Union governed by the rule of law’, namely that ‘[t]he decision whether or not to suspend the proceedings must follow upon a balancing of the competing interests’ (para. 56). In particular, proper and careful examination of the evidence submitted is a pre-condition for being capable of exercising any discretionary power (para. 67). In the case concerned, the GC found that the BoA had not properly analysed the documents filed by the applicant (evidence of existence of cancellation proceedings against the earlier BX mark based on grounds not yet examined by the Office) in support of its request for a suspension of the proceedings (paras 62-65). Those errors, in themselves, ‘could have prevented the Board of Appeal from taking into consideration all the factors characterising the applicant’s situation, with the result that, when appraising the interests of the applicant, the Board of Appeal did not address the whole picture and, accordingly, was not in a position to weigh properly the various interests involved’ (para. 67).

♦ [T-572/15](#); **GOURMET / ORIGINE GOURMET**; *Aldi GmbH & Co. KG v EUIPO*; Judgment of 8 September 2017; EU:T:2017:591; Language of the case: DE. The applicant sought to register the figurative trade mark Gourmet as an EUTM for goods in Classes 29, 30, 31, 32 and 33. An opposition based on an earlier EUTM for the figurative mark Origine Gourmet, registered for goods in Classes 29, 30, 31, 32 and 33, was filed pursuant to Article 8(1)(b) EUTMR. The OD partly upheld the opposition for goods in Classes 29, 30, 31, 32 and 33. By decision of 30 July 2015, the CD partially revoked the earlier mark. The applicant requested a suspension of the proceedings. The BoA did not suspend the proceedings and partly upheld the applicant’s appeal, rejecting the opposition for some of the goods in Class 31. The applicant essentially based its appeal on two pleas: (i) infringement of Article 70 EUTMR in conjunction with Rule 20(7)(c) of Implementing Regulation (EC) No 2868/95 and (ii) infringement of Article 8(1)(b) EUTMR. The GC upheld the appeal. According to Rule 20(7)(c) of Implementing Regulation (EC) No 2868/95, the Office has a discretionary power to suspend opposition proceedings. According to case-law, the BoA is obliged to deal first with a request for suspension and then with the LOC (para. 24). In this case, the contested decision did mention the request for suspension. However, the decision did not contain any legal analysis. Therefore, since the BoA had not exercised its discretionary power, the GC was not able to review the legality (paras 28-29). It followed that the BoA had committed an error in refusing to stay the proceedings (para. 42). The contested decision was therefore annulled without it being necessary to rule on the other plea (para. 43).

♦ [T-386/15](#); **BADTORO / TORO et al.**; *Jordi Nogues SL v EUIPO*; Judgment of 20 September 2017; EU:T:2017:632; Language of the case: ES. The applicant sought to register the figurative mark **BADTORO** as an EUTM for goods and services in Classes 30, 32 and 35. An



opposition was filed pursuant to Article 8(1)(b) EUTMR on the basis of the earlier figurative EUTM **TORO** (Classes 33 and 42), the earlier EUTMs (word marks) **TORO** (Classes 32, 33, 35 and 42) and the figurative Spanish mark **TORO** (Class 35). The OD partly upheld the opposition, on the grounds of a LOC between the contested mark and the earlier figurative EUTM, No 1 500 917, registered for goods and services in Class 32, 33 and 42, and the earlier EUTM (word mark) No 1 722 362, registered for services in Class 35. It rejected the opposition and allowed registration of the contested mark for the *import and export services* designated in Class 35. The BoA dismissed the applicant's appeal. The applicant had brought a counterclaim before the EUTM court of Alicante to request the cancellation of some of the marks of the other party before the BoA and had requested that the BoA stay the proceedings pending the decision of the EUTM court. The BoA rejected that claim on the grounds that the EUTM court had already dismissed the counterclaim for cancellation. It also confirmed the OD's finding of a LOC. The applicant filed an action before the GC, relying on two pleas in law: (i) infringement of Rule 20(7)(c) of Implementing Regulation (EC) No 2868/95 (unlawfulness of the BoA decision to deny the stay of proceedings) and (ii) infringement of Article 8(1)(b) EUTMR. As regards the first plea, the GC emphasised that the EUTM court's decision rejecting the counterclaim for cancellation had been appealed before the Spanish court of appeal and, afterwards, before the Supreme Court (para. 25). The BoA had based its decision on a judgment of first instance, which was not actually final (para. 26). The Office and the intervener claimed that this error of fact did not affect the lawfulness of the contested decision, because the opposition had also been based on three other trade marks, which were not included in the counterclaim for cancellation (para. 29). However, the GC stressed that, for procedural economy, the BoA had based its decision exclusively on earlier EUTM (word mark) No 1 722 362, registered for goods in Class 35, which was actually one of the marks included in the counterclaim (para. 30). Consequently, the contested decision was annulled insofar as the goods applied for in Class 35 were concerned (para. 33).

♦[T-419/16](#); **Carrera**; *Carrera Brands Ltd v EUIPO*; Judgment of 16 November 2017; EU:T:2017:812; Language of the case: DE. In 2005, Autec AG, the applicant for revocation, gave a contractual undertaking vis-à-vis Lutter & Partner GmbH not to challenge any trade mark application containing the term 'CARRERA'. In 2007, Lutter & Partner was granted registration of the word mark **CARRERA** as an EUTM for goods and services in Classes 7 to 11 and 21. The mark was then transferred to L+P holding GmbH, before being transferred to Carrera Brands, the EUTM proprietor. In 2012, an application for revocation was filed by Autec AG. The CD upheld the application for all the goods. The BoA partly upheld the EUTM proprietor's appeal since genuine use of the mark was proven for some of the goods. However, it rejected the request for suspension of proceedings. It also found that the no-challenge agreement could not have any effect on the obligation to use the mark. The proprietor filed an action before the GC, relying on two pleas in law: (i) infringement of Article 63(1)(a) EUTMR, and (ii) infringement of Rule 20(7)(c) of Implementing Regulation (EC) No 2868/95. The GC dismissed the appeal. **Suspension of proceedings:** the BoA has broad discretion to suspend proceedings before it; the scope of review by the GC is thus limited to manifest errors of assessment and misuse of powers (paras 47-48). Since a national jurisdiction is not entitled to order the withdrawal of a revocation application before the Office, any proceedings pending before a national court that seek to order such withdrawal cannot affect the outcome of the proceedings before the Office. Therefore, the refusal to stay proceedings is not vitiated by a manifest error of assessment (paras 50-52).



K. TRIPS Agreement

♦[T-638/15](#); **ALCOLOCK**; *Alcohol Countermeasure Systems (International) Inc. v EUIPO*; Judgment of 29 March 2017; EU:T:2017:229; Language of the case: EN. The BoA confirmed the CD's finding that the earlier UK mark had been put to genuine use and that the contested mark was to be declared invalid on the basis of Article 60(1)(a) in conjunction with Article 8(1)(a) and (b) EUTMR. The GC confirmed the BoA's findings that the invalidity applicant had proven genuine use of the earlier UK mark by presenting evidence of use by its licensee of another mark consisting of an identical sign and registered for identical goods. The GC chiefly relied on the case-law, according to which genuine use includes use of an earlier mark in a form differing in elements that do not alter the distinctive character of that mark in the form under which it was registered, even when that different form is itself registered as a trade mark (paras 17-35). In the case in question, use by the licensee had been with the invalidity applicant's consent, which was unencumbered by any infringements of the terms of the licensing agreement by the licensee (paras 42-44). Article 19(2) TRIPS, like any provision of the TRIPS Agreement, had no direct effect, but Article 18(2) EUTMR had to be interpreted in the light thereof. However, as the applicant before the GC had not put forward any specific argument, this plea had to be rejected (paras 47-51). Genuine use had been proven by means of a licensing agreement; a selection of invoices, accompanied by purchase orders and email requests; a selection of press articles; and a selection of advertisements, together with invoices for placing them. A press article published in Ireland, that is to say outside the relevant territory of the United Kingdom, nevertheless contained information on use of the earlier mark in the United Kingdom and could therefore be taken into account. Furthermore, the presence of the earlier mark on invoices and in articles and advertisements relating to the goods at issue could constitute a sufficient link between them. As regards extent of use, at 350, the number of breathalyser devices sold during the relevant periods to different persons was relatively low but sufficient to create or preserve an outlet for the goods concerned. Genuine use was thus proven, as correctly found by the BoA (paras 52-96).



Annex 1

Alphabetical List of GC and CJ Judgments and Important Orders in 2017 by nickname of trade mark

Actions on appeal from the Office

- ◆ **360°**; Judgment of 7 December 2017 in Case [T-332/16](#); *Colgate-Palmolive Co. v EUIPO*
- ◆ **360°**; Judgment of 7 December 2017 in Case [T-333/16](#); *Colgate-Palmolive Co. v EUIPO*
- ◆ **1841**; Judgment of 10 October 2017 in Case [T-233/15](#); *Cofra Holding AG v EUIPO*
- 4600**; Judgment of 14 July 2017 in Case [T-214/16](#); *Sata GmbH & Co. KG v EUIPO*
- ◆ **5 21000 603856 520Barcode Hellas / 520 barcode**; Judgment of 3 October 2017 in Case [T-453/16](#); *Ellinikos Syndesmos Epicheiriseon gia ti Diacheirisi ton Diethnon Prototypon GS1 v EUIPO*
- 2 STAR 2S (fig.) / ONE STAR (fig.) et al.**; Judgment of 15 February 2017 in Case [T-568/15](#); *Giuseppe Morgese, Pasquale Morgese, Felice D'Onofrio v EUIPO*
- AEGYPTISCHE ERDE**; Order of 1 March 2017 in Case [T-76/16](#); *Ikos GmbH v EUIPO*
- ◆ **AIRHOLE**; Judgment of 16 May 2017 in Case [T-107/16](#); *Airhole Facemasks, Inc. / EUIPO – industrysurf, SL*
- ◆ **ALCOLOCK**; Judgment of 29 March 2017 in Case [T-638/15](#); *Alcohol Countermeasure Systems (International) Inc. v EUIPO*
- ALLES WIRD GUT**; Judgment of 7 December 2017 in Case [T-622/16](#); *Sheepworld AG v EUIPO*
- Alpenschmaus / ALPEN et al.**; Judgment of 14 September 2017 in Case [T-103/16](#); *Aldi Einkauf GmbH & Co. OHG v EUIPO*
- ◆ **ALPHAREN / ALPHA D3**; Judgment of 26 January 2017 in Case [T-88/16](#); *OPKO Ireland Global Holdings, Ltd v EUIPO*
- ◆ **AMPHIBIAN**; Judgment of 3 April 2017 in Case [T-215/16](#); *Cop Vertriebs-GmbH v EUIPO*
- ◆ **ANA DE ALTUN / ANNA et al.**; Judgment of 18 September 2017 in Case [T-86/16](#); *Codorníu, S.A. v EUIPO*
- AN IDEAL WIFE, AN IDEAL LOVER, AN IDEAL HUSBAND**; Judgment of 29 June 2017 in Case [T-427/16](#) to [T-429/16](#) (joined cases); *Isabel Martín Osete v EUIPO*
- ◆ **ANTICO CASALE**; Judgment of 27 June 2017 in Case [T-327/16](#); *Aldi Einkauf GmbH & Co. OHG v EUIPO*
- APAX PARTNERS / APAX**; Judgment 30 March 2017 in Case [T-209/16](#); *Apax Partners UK Ltd v EUIPO*
- ◆ **APUS / ABUS**; Judgment of 16 March 2017 in Case [T-473/15](#); *Capella EOOD v EUIPO*
- AROMASENSATIONS**; Judgment of 28 June 2017 in Case [T-479/16](#); *Colgate-Palmolive Co. v EUIPO*



Arrigoni Valtaleggio; Judgment of 22 September 2017 in Case [T-454/16](#); *Arrigoni Spa v EUIPO*

♦ **Art's Cafè**; Judgment of 20 July 2017 in Case [T-309/16](#); *Cafés Pont SL v EUIPO*

♦ **AVE**; Judgment of 5 April 2017 in Case [T-367/15](#); *Renfe Operadora, Entidad Pública Empresarial v EUIPO*

B2B SOLUTIONS; Judgment of 27 June 2017 in Case [T-685/16](#); *Carlos Jiménez Gasalla v EUIPO*

♦ **BADTORO / TORO et al.**; Judgment of 20 September 2017 in Case [T-350/13](#); *Jordi Nogues SL v EUIPO*

♦♦ **BADTORO / TORO et al.**; Judgment of 20 September 2017 in Case [T-386/15](#); *Jordi Nogues SL v EUIPO*

♦ **BASIC**; Judgment of 21 September 2017 in Case [T-609/15](#); *Repsol YPF, SA / EUIPO – Basic AG Lebensmittelhandel (BASIC)*

BERG OUTDOOR / BERGHAUS et al.; Judgment 6 October 2017 in Case [T-139/16](#); *Sports Division SR, SA (SDSR). v EUIPO*

berlinGas; Order 20 September 2017 in Case [T-402/16](#); *Berliner Stadtwerke GmbH v EUIPO*

berlinWärme; Order 20 September 2017 in Case [T-719/16](#); *Berliner Stadtwerke GmbH v EUIPO*

Beste Freunde; Judgment of 15 September 2017 in Case [T-450/16](#); *sheepworld AG v EUIPO*

Beste Freundin; Judgment of 15 September 2017 in Case [T-452/16](#); *sheepworld AG v EUIPO*

Beste Mama; Judgment of 15 September 2017 in Case [T-422/16](#); *sheepworld AG v EUIPO*

Beste Oma; Judgment of 15 September 2017 in Case [T-421/16](#); *sheepworld AG v EUIPO*

Bester Opa; Judgment of 15 September 2017 in Case [T-449/16](#); *sheepworld AG v EUIPO*

Bester Papa; Judgment of 15 September 2017 in Case [T-451/16](#); *sheepworld AG v EUIPO*

♦ **BET 365**; Judgment of 14 December 2017 in Case [T-304/16](#); *bet365 Group Ltd v EUIPO*

BIANCALUNA / bianca. et al.; Judgment of 7 November 2017 in Case [T-627/15](#); *Frame Srl v EUIPO*

♦ **Biancaluna / bianca. et al.**; Judgment of 7 November 2017 in Case [T-628/15](#); *Frame Srl v EUIPO*

♦ **BITTORRENT**; Judgment of 12 December 2017 in Case [T-771/15](#); *Hochmann Marketing GmbH (formerly Bittorrent Marketing GmbH) v EUIPO*

♦ **Blue and Silver (col.)**; Judgment of 30 November 2017 in Case [T-101/15](#) and [T-102/15](#) (joined cases); *Red Bull GmbH v EUIPO*

Boswelan; Judgment of 15 September 2017 in Case [T-276/16](#); *Viridis Pharmaceutical Ltd v EUIPO*

BRENT INDEX; Judgment of 22 March 2017 in Case [T-430/16](#); *Intercontinental Exchange*



Holdings, Inc. v EUIPO

♦ **BURLINGTON / BURLINGTON ARCADE et al.**; Judgment of 6 December 2017 in Case [T-120/16](#); *Tulliallan Burlington Ltd v EUIPO*

♦ **Burlington / BURLINGTON ARCADE**; Judgment of 6 December 2017 in Case [T-122/16](#); *Tulliallan Burlington Ltd v EUIPO*

♦ **BURLINGTON / BURLINGTON ARCADE et al.**; Judgment of 6 December 2017 in Case [T-123/16](#); *Tulliallan Burlington Ltd v EUIPO*

♦ **BURLINGTON THE ORIGINAL / BURLINGTON ARCADE et al.**; Judgment of 6 December 2017 in Case [T-121/16](#); *Tulliallan Burlington Ltd v EUIPO*

♦ **Butterfly / Butterfly**; Judgment of 19 September 2017 in Case [T-315/16](#); *Tamasu Butterfly Europa GmbH v EUIPO*

BYRON / BYRON; Judgment 18 July 2017 in Case [T-45/16](#); *Nelson Alfonso Egüed v EUIPO*

♦ **CACTUS OF PEACE DE LA PAZ / CACTUS**; Judgment 11 October 2017 in Case [C-501/15 P](#); *Cactus SA v EUIPO*

CAMISERIA LA ESPAÑOLA / REPRES 2 BANDERAS CRUZADAS; Judgment of 8 March 2017 in Case [T-504/15](#); *Rafhaelo Gutti, SL v EUIPO*

♦ **Carrera**; Judgment of 16 November 2017 in Case [T-419/16](#); *Carrera Brands Ltd v EUIPO*

♦♦ **CC / O**; Judgment of 8 November 2017 in Case [T-754/16](#); *Oakley, Inc. v EUIPO*

CERTIFIED AUSTRALIAN ANGUS BEEF / CERTIFIED ANGUS BEEF BRAND SINCE 1978; Judgment of 14 July 2017 in Case [T-55/15](#); *Certified Angus Beef LLC v EUIPO*

CHEMPIOIL / CHAMPION; Judgment of 5 October 2017 in Case [C-437/16 P](#); *Wolf Oil Corp. v EUIPO*

Choco Love / CHOCOLATE; Judgment of 25 January 2017 in Case [T-325/15](#); *Sun System Kereskedelmi és Szolgáltató Kft. v EUIPO*

♦ **CIPRIANI**; Judgment of 29 June 2017 in Case [T-343/14](#); *Arrigo Cipriani v EUIPO*

♦ **CityTrain**; Judgment of 21 June 2017 in Case [T-699/15](#); *City Train GmbH v EUIPO*

ClaimsExcellence; Judgment of 9 March 2017 in Case [T-308/16](#); *Marsh GmbH v EUIPO*

♦ **Claranet / Claro**; Judgment of 14 November 2017 in Case [T-129/16](#); *Claranet Europe Ltd v EUIPO*

♦ **CLASSIC FINE FOODS**; Judgment of 14 July 2017 in Case [T-194/16](#); *Klassisk investment Ltd v EUIPO*

climaVera / CLIMAVER DECO; Judgment of 15 June 2017 in Case [T-457/15](#); *Fakro sp. z o.o. v EUIPO*

coffee inn / coffee in; Judgment of 24 October 2017 in Case [T-202/16](#); *UAB Keturi kamariai v EUIPO*

♦ **colineb / Colina**; Judgment of 5 October 2017 in Case [T-36/17](#); *Forest Pharma BV v EUIPO*

CONTADO DEL GRIFO / EL GRIFO et al.; Judgment of 13 October 2017 in Case [T-434/16](#);



Sensi Vigne & Vini Srl v EUIPO

cotecnica OPTIMA / visán Optima PREMIUM PETFOOD et al.; Judgment of 20 November 2017 in Case [T-465/16](#); *Cotécnica, S.C.C.L. v EUIPO*

CREMCAFFÉ / CAFÉ CREM; Judgment of 2 February 2017 in Case [T-690/15](#); *Marcas Costa Brava, SL v EUIPO*

CREMCAFFÉ BY JULIUS MEINL / CAFÉ CREM; Judgment of 2 February 2017 in Case [T-686/15](#); *Marcas Costa Brava, SL v EUIPO*

Cremcaffé by Julius Meinl / café crem; Judgment of 2 February 2017 in Case [T-687/15](#); *Marcas Costa Brava, SL v EUIPO*

Cremcaffé by Julius Meinl / café crem; Judgment of 2 February 2017 in Case [T-689/15](#); *Marcas Costa Brava, SL v EUIPO*

Cremcaffé by Julius Meinl / café crem; Judgment of 2 February 2017 in Case [T-691/15](#); *Marcas Costa Brava, SL v EUIPO*

♦♦**CReMESPRESSO / CREMESSO**; Judgment of 13 July 2017 in Case [T-189/16](#); *Migros-genossenschafts-Bund (Switzerland) v EUIPO*

♦♦**Cryo-Save**; Judgment of 23 March 2017 in Case [T-239/15](#); *Cryo-Save AG v EUIPO*

♦♦**Cystus**; Judgment of 14 February 2017 in Case [T-15/16](#); *Georgios Pandalis v EUIPO*

♦♦**D / D**; Judgment of 20 July 2017 in Case [T-521/15](#); *Diesel SpA. v EUIPO*

♦♦**Darjeeling / DARJEELING et al.**; Judgment of 20 September 2017 in Case [C-673/15 P](#) to [C-676/15 P](#) (joined cases); *The Tea Board v EUIPO*

De Giusti ORGOGLIO / ORGOGLIO; Judgment of 16 February 2017 in Case [T-18/16](#); *DMC Srl v EUIPO - Etike' International Srl*

♦♦**deluxe**; Order of 17 May 2017 in Case [C-437/15 P](#); *EUIPO v Deluxe Entertainment Services Group Inc.*

DESIGN OF A CONTAINER FOR SWEETS; Judgment of 3 October 2017 in Case [T-695/15](#); *BMB sp. z o.o. v EUIPO*

DESIGN OF A PART OF TOILET SEATS; Judgment of 21 June 2017 in Case [T-286/16](#); *Ernst Kneidinger v EUIPO*

DESIGN OF A SHOWER DRAINAGE CHANNEL; Judgment of 21 September 2017 in Cases [C-361/15 P](#) and [C-405/15 P](#) (joined cases); *Easy Sanitary Solutions BV v EUIPO*

DESIGN OF A STAR-SHAPED LAMP; Judgment of 28 September 2017 in Case [T-779/16](#); *Lothar Rühland v EUIPO*

DESIGN OF AN ELECTRONIC WRISTBAND; Judgment of 4 July 2017 in Case [T-90/16](#); *Thomas Murphy v EUIPO*

DESIGN OF BEAKERS; Judgment of 9 February 2017 in Case [T-16/16](#); *MasT-Jägermeister SE v EUIPO*

DESIGN OF CANS FOR BEVERAGES; Judgment of 13 June 2017 in Case [T-9/15](#); *Ball Beverage Packaging Europe Ltd v EUIPO*

DESIGN OF COOKER HOODS; Judgment of 17 November 2017 in Case [T-684/16](#); *Ciarko spółka z ograniczoną odpowiedzialnością sp.k. v EUIPO*



DESIGN OF DOOR HANDLES; Judgment of 5 July 2017 in Case [T-306/16](#); *Gamet S.A. v EUIPO*

♦ **DESIGN OF INFRARED CABINS AND SAUNAS**; Judgment of 13 December 2017 in Case [T-114/16](#); *Delfin Wellness GmbH v EUIPO*

♦ **DESIGN OF NOZZLES FOR VACUUM CLEANERS**; Judgment of 14 March 2017 in Case [T-174/16](#); *Wessel-Werk GmbH v EUIPO*

♦ **DESIGN OF NOZZLES FOR VACUUM CLEANERS**; Judgment of 14 March 2017 in Case [T-175/16](#); *Wessel-Werk GmbH v EUIPO*

♦ **DESIGN OF ORNAMENTATION**; Judgment of 18 of July 2017 in Case [T-57/16](#); *Chanel SAS v EUIPO*

♦ **DESIGN OF RADIATORS FOR HEATING**; Judgment of 16 February 2017 in Case [T-98/15](#); *Tubes Radiatori Srl v EUIPO*

DESIGN OF THERMOSIPHONS FOR RADIATORS; Judgment of 16 February 2017 in Cases [T-828/14](#) and [T-829/14](#) (joined cases); *Antrax It Srl v EUIPO*

♦ **DEVICE OF A CLOUD RESEMBLING A SAFE / ICLOUD et al.**; Judgment of 14 July 2017 in Case [T-223/16](#); *Massive Bionics, SL v EUIPO*

♦ **DEVICE OF A PATTERN OF GOLD FISH ON A BLUE BACKGROUND**; Judgments of 28 February 2017 in Case [T-766/15](#) and [T-767/15](#) (joined cases); *Labeyrie v EUIPO*

♦ **DEVICE OF A REPEATED GEOMETRIC DESIGN**; Judgment of 21 June 2017 in Case [T-20/16](#); *M/S. Indeutsch International v EUIPO*

DEVICE OF A SQUARE-SHAPED PACKAGING; Judgment of 4 May 2017 in Case [C-417/16 P](#); *August Storck KG v EUIPO*

DEVICE OF A SURFACE WITH BLACK DOTS; Judgment of 11 May 2017 in Case [C-421/15 P](#); *Yoshida Metal Industry Co. Ltd v EUIPO*

♦ **DEVICE OF A TRIANGLE**; Judgment of 28 June 2017 in Case [T-470/16](#); *X-cen-tek v EUIPO*

DEVICE OF A WOLF'S HEAD / WOLF Jardin et al.; Judgment of 3 May 2017 in Case [T-681/15](#); *Environmental Manufacturing LLP / EUIPO*

♦ **DEVICE OF THREE VERTICAL STRIPES**; Judgment of 20 July 2017 in Case [T-612/15](#); *Basic Net SpA v EUIPO*

DEVICE OF TWO LINES FORMING AN ACUTE ANGLE; Judgment of 5 April 2017 in Case [T-291/16](#); *Anta (China) Co. Ltd v EUIPO*

♦ **DIACOR / Diacol PORTUGAL**; Judgment of 24 January 2017 in Case [T-258/08](#); *Matthias Rath v EUIPO*

DINCH; Judgment of 27 April 2017 in Case [T-721/15](#); *BASF SE v EUIPO*

DREAMLINE; Order of 15 May 2017 in Case [T-285/16](#); *Dominator International GmbH v EUIPO*

♦ **DRIVEWISE**; Judgment of 5 July 2017 in Case [T-3/16](#); *Allstate Insurance Company v EUIPO*

♦ **e / e**; Judgment of 14 March 2017 in Case [T-276/15](#); *Edison SpA v EUIPO*



- ♦ **ECOLAB**; Judgment of 13 July 2017 in Case [T-150/16](#); *Ecolab USA Inc., v EUIPO*
- ♦ **EXHAUST-GARD**; Judgment of 27 April 2017 in Case [T-622/15](#); *Deere & Company v EUIPO*
- ♦ **EZMIX**; Judgment of 22 November 2017 in Case [T-771/16](#); *Toontrack Music AB v EUIPO*
- F1 / fly.de**; Judgment of 30 November 2017 in Case [T-475/16](#); *FTI Touristik GmbH v EUIPO*
- ♦♦ **FAIR & LOVELY / NEW YORK FAIR & LOVELY**; Judgment of 17 February 2017 in Case [T-811/14](#); *Unilever NV / EUIPO*
- ♦♦ **FEMIBION**; Judgment of 17 November 2017 in Case [T-802/16](#); *Endoceutics, Inc. v EUIPO*
- FOREVER FASTER**; Judgment of 9 March 2017 in Case [T-104/16](#); *Puma SE v EUIPO*
- ♦♦ **Formata**; Judgment of 8 March 2017 in Case [T-23/16](#); *Ilona Biernacka-Hoba v EUIPO - Formata Bogusław Hoba*
- FREE STYLE**; Judgment of 5 December 2017 in Case [T-212/16](#); *El Corte Inglés, SA v EUIPO*
- FREE STYLE**; Judgment of 5 December 2017 in Case [T-213/16](#); *El Corte Inglés, SA v EUIPO*
- Freggo / TENTAZIONE FREDDO FREDDO et al.**; Judgment of 18 July 2017 in Case [T-243/16](#); *Freddo SA v EUIPO*
- Frinsa LA CONSERVERA / FRUISA et al.**; Judgment of 12 July 2017 in Case [T-634/15](#); *Frinsa del Noroeste SA v EUIPO*
- ♦♦ **GAPPOL / GAP et al.**; Judgment of 4 October 2017 in Case [T-411/15](#); *PP Gappol Marzena Porczyńska v EUIPO*
- GATEWIT / Wit software et al.**; Judgment of 17 February 2017 in Case [T-351/14](#); *Construlink – Tecnologias de Informaçao SA v EUIPO*
- GelenkGold / Shape of a tiger**; Judgment of 4 May 2017 in Case [T-25/16](#); *Haw Par Corp.Ltd v EUIPO*
- Genius**; Judgment of 22 March 2017 in Case [T-425/16](#); *Karl Hoffmann v EUIPO*
- ♦ **GEO**; Judgment of 14 December 2017 in Case [T-280/16](#); *GeoClimaDesign v EUIPO*
- ♦ **GEOTEX**; Judgment of 4 May 2017 in Case [T-97/16](#); *Martin Kasztantowicz v EUIPO*
- ♦ **GINRAW / RAW**; Judgment of 7 June 2017 in Case [T-258/16](#); *Mediterranean Premium Spirits, SL v EUIPO*
- GLOBO MEDIA / TV GLOBO PORTUGAL (FIG. MARK) et al.**; Judgment of 5 May 2017 in Case [T-262/16](#); *Globo Media, SA, v EUIPO*
- ♦ **GOLD MOUNT**; Judgment of 8 June 2017 in Case [T-294/16](#); *Kaane American International Tobacco Company FZE v EUIPO*
- ♦ **GOURMET / ORIGINE GOURMET**; Judgment of 8 September 2017 in Case [T-572/15](#); *Aldi GmbH & Co. KG v EUIPO*
- ♦ **GPTECH / GP JOULE et al.**; Judgment of 21 June 2017 in Case [T-235/16](#); *GP Joule PV GmbH & Co. KG v EUIPO*
- GREEN STRIPES ON A PIN (col.)**; Judgment of 03 May 2017 in Case [T-36/16](#); *Enercon*



GmbH v EUIPO

◆ **GULLON DARVIDA / DAR VIDA et al.**; Judgment of 16 November 2017 in Case [T-456/16](#); *Galletas Gullón v EUIPO*

hello digitalmente diferentes / HELLO! et al.; Judgment of 26 October 2017 in Case [T-330/16](#); *Hello Media Group SL v EUIPO*

hello media group / HELLO! et al.; Judgment of 26 October 2017 in Case [T-331/16](#); *Hello Media Group SL v EUIPO*

iCell. / Isocell; Judgment of 8 November 2017 in Case [T-776/16](#); *Isocell GmbH v EUIPO*

iCell Insulation Technology Made in Sweden (fig.) / Isocell et al.; Judgment of 8 November 2017 in Case [T-777/16](#); *Icell Insulation Technology M Isocell GmbH v EUIPO*

◆ **Idealogistic (fig.) / IDEA et al.**; Judgment of 21 September 2017 in Case [T-620/16](#); *The Logistical Approach BV v EUIPO*

◆ **Immunostad**; Judgment of 20 November 2017 in Case [T-403/16](#); *Stada Arzneimittel AG v EUIPO*

◆ **INSTASITE**; Judgment of 18 May 2017 in Case [T-375/16](#); *Sabre GLOB Inc. v EUIPO*

◆ **INTESA**; Judgment of 4 October 2017 in Case [T-143/16](#); *Intesa Sanpaolo SpA v EUIPO*

INVOICE AUCTION; Judgment of 21 September 2017 in Case [T-789/16](#); *InvoiceAuction B2B GmbH / EUIPO*

◆ **IST / ista et al.**; Judgment of 8 November 2017 in Case [T-80/17](#); *Ingo Steiniger v EUIPO*

IWEAR / INWEAR; Judgment of 7 March 2017 in Case [T-622/14](#); *Lauritzen Holding AS v EUIPO*

◆ **J&JOY / joy SPORTSWEAR**; Judgment of 29 March 2017 in Case [T-389/15](#); *J & Joy SA v EUIPO*

◆ **J AND JOY / joy SPORTSWEAR**; Judgment of 29 March 2017 in Case [T-387/15](#); *J & Joy SA v EUIPO*

◆ **JAPRAG / JAPAN-RAG**; Judgment of 11 July 2017 in Case [T-406/16](#); *Dogg Label / EUIPO*

JEDE FLASCHE ZÄHLT!; Judgment of 11 July 2017 in Case [T-623/15](#); *Lidl Stiftung & Co. KG v EUIPO*

◆ **JN-JOY / joy SPORTSWEAR**; Judgment of 29 March 2017 in Case [T-388/15](#); *J & Joy SA v EUIPO*

JUWEL; Judgment of 28 November 2017 in Case [T-31/16](#); *adp Gauselmann GmbH v EUIPO*

KARELIA; Judgment of 6 October 2017 in Case [T-878/16](#); *Ino Karelia v EUIPO*

◆ **Klosterstoff**; Judgment of 26 October 2017 in Case [T-844/16](#); *Alpirsbacher Klosterbräu Glauner GmbH & Co. KG v EUIPO*

◆ **Krispy Kreme DOUGHNUTS**; Judgment of 2 March 2017 in Case [C-655/15 P](#); *Panrico, S.A. v EUIPO*

◆ **L'ECLAIREUR**; Judgment of 8 May 2017 in Case [T-680/15](#); *Les Éclaires GmbH v EUIPO*



- ♦ **LAGUIOLE**; Judgment of 5 April 2017 in Case [C-598/14 P](#); *EUIPO v Gilbert Szajner*
- ♦ **LAMBRETTA**; Judgment of 16 February 2017 in Case [C-577/14 P](#); *Brandconcern BV v EUIPO and Scooters India Ltd*
- Land Glider / LAND ROVER et al.**; Judgment of 16 February 2017 in Case [T-71/15](#); *Jaguar Land Rover Ltd v EUIPO*
- LegalPro**; Judgment of 16 May 2017 in Case [T-472/16](#); *Marsh GmbH v EUIPO*
- ♦ **LEOPARD true racing / Leopard CASA Y JARDIN**; Judgment of 19 October 2017 in Case [T-7/15](#); *Leopard SA v EUIPO*
- ♦ **Le Val / VIÑA DEL VAL et al.**; Judgments of 23 March 2017 in Case [T-216/16](#); *Vignerons de la Méditerranée v EUIPO*
- LIKE IT**; Order of 14 March 2017 in Case [T-21/16](#); *Karl Conzelmann GmbH + Co. KG v EUIPO*
- ♦ ♦ **Limbic® Map**; Judgment of 16 February 2017 in Case [T-513/15](#); *Gruppe Nymphenburg Consult AG. v EUIPO*
- ♦ ♦ **Limbic® Sales**; Judgment of 16 February 2017 in Case [T-517/15](#); *Gruppe Nymphenburg Consult AG. v EUIPO*
- ♦ ♦ **Limbic® Types**; Judgment of 16 February 2017 in Case [T-516/15](#); *Gruppe Nymphenburg Consult AG. v EUIPO*
- LITU / PITU**; Judgment 25 January 2017 in Case [T-187/16](#); *Anton Riemerschmid Weinbrennerei und Likörfabrik GmbH & Co. KG v EUIPO*
- ♦ **LONGHORN STEAKHOUSE**; Judgment of 21 June 2017 in Case [T-856/16](#); *Rare Hospitality International, Inc. v EUIPO*
- ♦ **LOVE TO LOUNGE**; Judgment of 15 September 2017 in Case [T-305/16](#); *Lidl Stiftung & Co. KG v EUIPO*
- LUBELSKA / Lubeca**; Judgment of 19 January 2017 in Case [T-701/15](#); *Stock Polska Sp. z o.o. v EUIPO*
- LUCEO**; Order of 14 December 2017 in Case [C-101/17 P](#); *Versus EOOD v EUIPO*
- M&M Morgan & Morgan / MMG TRUST MIEMBRO DEL GRUPO MORGAN & MORGAN**; Judgment of 19 January 2017 in Case [T-399/15](#); *Morgan & Morgan Srl International Insurance v EUIPO + Grupo Morgan & Morgan*
- Männerspielplatz**; Judgment of 11 May 2017 in Case [T-372/16](#); *Alexander Bammer v EUIPO*
- Magicrown**; Judgment of 16 May 2017 in Case [T-218/16](#); *Mühlbauer Technology GmbH v EUIPO*
- ♦ **MASTER / COCA-COLA et al.**; Judgment of 7 December 2017 in Case [T-61/16](#); *The Coca-Cola Company v EUIPO*
- MASTER DRAMA / MASTERS COLORS PARIS**; Order of 26 June 2017 in Case [T-183/16](#); *L'Oréal / EUIPO – Guinot*
- MASTER DUO / MASTERS COLORS PARIS**; Order of 26 June 2017 in Case [T-182/16](#);



L'Oréal / EUIPO – Guinot

MASTER PRECISE / MASTERS COLORS PARIS; Order of 26 June 2017 in Case [T-181/16](#); *L'Oréal / EUIPO – Guinot*

MASTER SHAPE / MASTERS COLOR PARIS; Order of 26 June 2017 in Case [T-180/16](#); *L'Oréal / EUIPO – Guinot*

MASTER SMOKY / MASTERS COLORS PARIS; Order of 26 June 2017 in Case [T-179/16](#); *L'Oréal / EUIPO – Guinot*

MATRIX BODY SHOP; Judgment of 19 October 2017 in Case [T-683/16](#); *Kuka Systems GmbH v EUIPO*

Matrix light; Judgment of 19 October 2017 in Case [T-87/17](#); *KuKa Systems GmbH v EUIPO*

MAXPLAY; Judgment of 9 March 2017 in Case [T-400/16](#); *Maximum Play, Inc. v EUIPO*

♦ **Mediaexpert**; Judgment of 20 July 2017 in Case [T-780/16](#); *Mediaexpert sp. z o.o v EUIPO*

♦ **medialbo / MediaLB**; Judgment of 17 January 2017 in Case [T-225/15](#); *QuaMa Quality Management GmbH v EUIPO*

Mediline; Judgment of 23 October 2017 in Case [T-810/16](#); *Barmenia Krankenversicherung AG v EUIPO*

Медведь; Judgment of 19 July 2017 in Case [T-432/16](#); EU:T:2017:527; *Lackmann Fleisch- und Feinkostfabrik GmbH v EUIPO*

♦ **MEISSEN / Meissen et al.**; Judgment of 26 July 2017 in Case [C-471/16 P](#); *Staatliche Porzellan-Manufaktur Meissen GmbH v EUIPO*

Metabolic Balance; Judgment of 06 April 2017 in Case [T-594/15](#); *Metabolic Balance Holding GmbH v EUIPO*

metals; Judgment of 16 November 2017 in Case [T-767/16](#); *Nanogate AG v EUIPO*

MI PAD / IPAD; Judgment of 5 December 2017 in Case [T-893/16](#); *Xiaomi, Inc. v EUIPO*

MONTORSI F.& F; Judgment of 13 July 2017 in Case [T-389/16](#); *Agricola italiana alimentare SpA (AIA) v EUIPO - Casa Montorsi Srl*

MORTON'S; Judgment of 15 May 2017 in Case [T-223/15](#); *Morton's of Chicago, Inc. v EUIPO*

Mountain citrus / monteCitrus; Judgment of 16 March 2017 in Case [T-495/15](#); *Sociedad agraria de transformación No 9982 Montecitrus v EUIPO*

Mr. KEBAB / MISTER K KEBAP; Judgment of 29 June 2017 in Case [T-448/16](#); *Mr. Kebab s.r.o. v EUIPO*

MULTI FRUITS; Judgment of 17 May 2017 in Case [T-355/16](#); *Radp Gauselmann GmbH v EUIPO*

♦ **MULTIPHARMA / MUNDIPHARMA**; Judgment of 7 November 2017 in Case [T-144/16](#); *Mundipharma AG v EUIPO*

myBaby (fig.) / MAYBABY et al.; Order of 13 July 2017 in Case [T-519/15](#); *myToys.de GmbH v EUIPO*



♦♦**NANA FINK / NANA**; Judgment of 6 April 2017 in Case [T-39/16](#); *Nanu-Nana Joachim Hoepf GmbH & Co. KG v EUIPO*

♦♦**Natural Instinct Dog&Cat food as nature intended (FIG. MARK) / NATURE'S VARIETY et al.**; Judgment of 15 February 2017 in Case [T-30/16](#); *M.I. Industries, Inc. v EUIPO*

♦**NETGURU**; Judgment of 17 January 2017 in Case [T-54/16](#); *Netguru sp. z o.o., v EUIPO*

NIMORAL / NEORAL; Judgment 06 April 2017 in Case [T-49/16](#); *Azanta A/S v EUIPO*

NN / NN; Judgment of 28 June 2017 in Case [T-333/15](#); *Josel, SL v EUIPO*

NRIM Life Sciences / RYM; Judgment in Case [T-909/16](#); *Laboratorios Ern, SA v EUIPO*

♦**NSU / NSU**; Judgment of 20 June 2017 in Case [T-541/15](#); *Industrie Aeronautiche Reggiane Srl v EUIPO*

OCTASA / PENTASA; Judgment of 21 June 2017 in Case [T-632/15](#); *Tillots Pharma v EUIPO*

ojo sunglasses / oio et al.; Judgment of 14 December 2017 in Case [T-792/16](#); *N & C Franchise Ltd v EUIPO*

opus AETERNATUM / OPUS; Judgment of 12 December 2017 in Case [T-815/16](#); *For Tune sp. z o.o. v EUIPO*

OSHO; Judgment of 11 October 2017 in Case [T-670/15](#); *Osho Lotus Commune e. V. v EUIPO*

Outdoor / OUTDOOR PRO et al.; Judgment of 5 May 2017 in Case [T-224/16](#); *Messe Friedrichshafen GmbH v EUIPO*

PALOMA / Paloma; Judgment of 17 February 2017 in Case [T-369/15](#); *Hernández Zamora, S.A. v EUIPO*

♦**PAUL ROSENICH**; Judgment of 13 July 2017 in Case [T-527/14](#); *Rosenich v EUIPO*

♦**perlage**; Judgment of 28 November 2017 in Case [T-239/16](#); *Polskie Zdroje sp. z o.o. sp.k. v EUIPO*

PFERDEKOPF; Judgment of 26 September 2017 in Case [T-717/16](#); *Waldhausen GmbH & Co. KG v EUIPO*

POCKETBOOK / POCKET; Judgment of 17 February 2017 in Case [T-596/15](#); *Batmore Capital Ltd v EUIPO*

♦**Policolor / ProfiColor**; Judgment of 6 April 2017 in Case [T-178/16](#); *CWS-Lackfabrik Conrad W.Schmidt GmbH & Co. KG v EUIPO*

♦**popchrono**; Judgment of 14 March 2017 in Case [T-132/15](#); *IR v EUIPO*

PORT CHARLOTTE; Judgment of 14 September 2017 in Case [C-56/16 P](#); *EUIPO v Instituto dos Vinhos do Douro e do Porto IP*

♦**POSITION OF TWO CURVED STRIPS ON THE SIDE OF A TYRE**; Judgment of 4 July 2017 in Case [T-81/16](#); *Pirelli Tyre SpA v EUIPO*

PostModern / Deutsche Post et al.; Judgment of 27 June 2017 in Case [T-13/15](#); *Deutsche Post AG v EUIPO*

♦**Premeno / Pramino**; Judgment of 3 February 2017 in Case [T-509/15](#); *Kessel medintim*



GmbH v EUIPO

QD; Judgment of 13 July 2017 in Case [T-650/16](#); *LG Electronics, Inc. v EUIPO*

♦ **QUESO Y TORTA DE LA SERENA / TORTA DEL CASAR et al.**; Judgment of 14 December 2017 in Case [T-828/16](#); *Consejo Regulador de la Denominación de Origen 'Torta del Casar' v EUIPO*

♦♦ **QUILAPAYÚN / QUILAPAYÚN**; Judgment of 11 December 2017 in Case [T-249/15](#); *JT v EUIPO*

♦ **RAPPRES () INCLINATE DI COLORE ROSSO**; Judgment of 31 January 2017 in Case [T-130/16](#); *Coesia SpA v EUIPO*

♦ **REAL**; Judgment of 30 November 2017 in Case [T-798/16](#); *Hanso Holding AS v EUIPO*

♦ **real,-**; Judgment of 28 June 2017 in Case [T-287/15](#); *Tayto Group Ltd v EUIPO*

RE-CON zero / ZERO; Judgment of 16 November 2017 in Case [T-723/16](#); *Mapei SpA v EUIPO*

REGENT UNIVERSITY; Judgment of 28 March 2017 in Case [T-538/15](#); *Regent University v EUIPO*

RHYTHMVIEW; Order of 26 January 2017 in Case [T-119/16](#); *Topera, Inc. v EUIPO*

ROYAL & CAPORAL / KAPORAL; Judgment of 14 June 2017 in Case [T-95/16](#); *Savas Aydin v EUIPO*

RP ROYAL PALLADIUM / RP; Judgment of 19 September 2017 in Case [T-768/15](#); *RP Technik GmbH Profilsysteme v EUIPO*

RROFA / ROFA et al.; Judgment of 14 December in Case [T-912/16](#); *RRTec sp. z o.o. v EUIPO*

♦ **SAVANT**; Judgment of 18 July 2017 in Case [T-110/16](#); *Savant Systems LLC v EUIPO*

♦ **SCATTER SLOTS**; Judgment of 17 October 2017 in Case [T-704/16](#); *Murka Ltd v EUIPO*

♦ **SDC-444S / SDC-444S**; Judgments of 12 October 2017 in Case [T-318/16](#); *Moravia Consulting spol. s r.o. v EUIPO*

♦ **SDC-554S / SDC-554S**; Judgments of 12 October 2017 in Case [T-316/16](#); *Moravia Consulting spol. s r.o. v EUIPO*

♦ **SDC-888TII RU / SDC-888TII RU**; Judgments of 12 October 2017 in Case [T-317/16](#); *Moravia Consulting spol. s r.o. v EUIPO*

SeboCalm / Sebotherm; Judgment of 23 October 2017 in Case [T-441/16](#); *Tetra Pharm (1997) Ltd v EUIPO*

Second Display; Judgment 14 June 2017 in Case [T-659/16](#); *LG Electronics, Inc. v EUIPO*

♦ **secret.service**; Judgment of 18 May 2017 in Case [T-163/16](#); *Reisswolf Akten- und Datenvernichtung GmbH & Co. KG v EUIPO*

♦ **SHAPE OF A LIGHTER WITH THE WORD ELEMENT 'CLIPPER'**; Judgment of 27 June 2017 in Case [T-580/15](#); *Flamagas SA / EUIPO – MatMind Srl*

SHAPE OF A MOTORISED ROPE WINCH; Judgment of 5 April 2017 in Case [T-621/15](#);



Tractel Greifzug GmbH v EUIPO

SHAPE OF AN OVEN; Judgment of 10 October 2017 in Case [T-211/14](#) RENV; *Toni Klement v EUIPO*

♦♦**SHAPE OF A PACKET OF BISCUITS (3D)**; Judgment of 23 October 2017 in Case [T-404/16](#); *Galletas Gullón, SA v EUIPO*

♦♦**SHAPE OF A PACKET OF BISCUITS (3D)**; Judgment of 23 October 2017 in Case [T-418/16](#); *Galletas Gullón, SA v EUIPO*

SHAPE OF A TALL GLASS; Judgment of 26 October 2017 in Case [T-857/16](#); *Erdinger Weißbräu Werner Brombach GmbH & Co. KG v EUIPO*

SKY ENERGY / NRJ; Judgment of 6 October 2017 in Case [T-184/16](#); *NRJ Group v EUIPO*

skylite / SKY et al.; Judgment of 19 October 2017 in Case [T-736/15](#); *Aldi GmbH & Co. KG v EUIPO*

Slim Dynamics / DYNAMIN; Judgment of 13 December 2017 in Case [T-700/16](#); *Laboratorios Ern, SA v EUIPO*

♦**SO'BiO etic / SO...et al.**; Judgment of 8 June 2017 in Case [T-341/13](#) RENV; *Groupe Léa Nature SA v EUIPO*

♦**SOTTO IL SOLE ITALIANO SOTTO IL SOLE / VIÑA SOL et al.**; Judgment of 31 May 2017 in Case [T-637/15](#); *Alma-the soul of Italian wine v EUIPO*

SOUTHERN TERRITORY 23°48'25''S / SOUTHERN; Judgment of 8 June 2017 in Case [T-6/16](#); *AWG Allgemeine Warenvertriebs GmbH v EUIPO*

SPÜRBAR ANDERS; Judgment of 4 October 2017 in Case [T-126/16](#); *1. FC Köln GmbH & Co. KGaA v EUIPO*

♦**STICK MINIMINI FRATELLI BERETTA 1812 GLI ORIGINALI / MINI WINI**; Judgment of 26 July 2017 in Case [C-182/16 P](#); *Meica Ammerländische Fleischwarenfabrik Fritz Meinen GmbH & Co. KG v EUIPO*

STRONG BONDS. TRUSTED SOLUTIONS.; Judgment of 24 January 2017 in Case [T-96/16](#); *Solenis Technologies LP v EUIPO*

STYLO & KOTON; Judgment of 30 November 2017 in Case [T-687/16](#); *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ v EUIPO*

♦**sulayr GLOBAL SERVICE / SULAYR et al.**; Judgment of 26 October 2017 in Case [T-685/15](#); *Sulayr Global Service v EUIPO*

SUPERIOR DRUMMER; Judgment of 30 November 2017 in Case [T-895/16](#); *Toontrack Music AB v EUIPO*

♦**TAFEL**; Judgment of 8 June 2017 in Case [T-326/16](#); *Bundesverband Deutsche Tafel e.V. v EUIPO*

Take your time Pay After; Judgment of 26 September 2017 in Case [T-755/16](#); *Alessandro La Rocca v EUIPO*

Tasty Puff; Judgment of 18 January 2017 in Case [T-64/16](#); *Michał Wieromiejczyk v EUIPO*

♦**TEMPOS VEGA SICILIA**; Judgment of 9 February 2017 in Case [T-696/15](#); *Bodegas Vega*



Sicilia, S.A., v EUIPO

TestBild / test et al.; Judgment of 7 July 2017 in Case [T-359/16](#); *Axel Springer SE v EUIPO*

The Specials; Judgment of 22 March 2017 in Case [T-336/15](#); *Windrush Aka LLP v EUIPO*

♦ **THOMAS MARSHALL GARMENTS OF LEGENS / Marshall et al.**; Judgment of 8 November 2017 in Case [T-271/16](#); *Yusuf Pempe v EUIPO*

TO CREATE REALITY; Judgment of 30 November 2017 in Case [T-50/17](#); *Mackevision Medien Design GmbH Stuttgart v EUIPO*

TOSCORO; Judgment of 2 February 2017 in Case [T-510/15](#); *Roberto Mengozzi v EUIPO*

TRES TOROS 3; Judgment of 28 September 2017 in Case [T-206/16](#); *Bodegas Verdúñez, SL, v EUIPO*

TRIPLE EVOLUTION / Evolution; Judgment of 9 February 2017 in Case [T-82/16](#); *International Gaming Projects Ltd v EUIPO*

TRIPLE o NADA / TRIPLE BINGO; Judgment of 16 May 2017 in Case [T-159/16](#); *Metronia S.A. v EUIPO*

♦ **UGO / il UGO!**; Judgment of 6 October 2017 in Case [T-176/16](#); *Kofola ČeskoSlovensko a.s. v EUIPO*

♦ **VACUP / V.A.C. et al.**; Judgment of 14 March 2017 in Case [T-741/14](#); *Hersill SL v EUIPO*

♦ **VENMO**; Judgment of 5 May 2017 in Case [T-132/16](#); *PayPal, Inc. v EUIPO*

♦ **Vermögensmanufaktur**; Judgment of 7 September 2017 in Case [T-374/15](#); *VM Vermögens-Management GmbH v EUIPO*

♦ **VERSACCINO / VERSACE et al.**; Judgment of 5 October 2017 in Case [T-337/16](#); *Versace 19.69 Abbigliamento Sportivo Srl. v EUIPO*

♦ ♦ **VERSACE 19.69 ABBIGLIAMENTO SPORTIVO... / VERSACE et al.**; Judgment of 5 October 2017 in Case [T-336/16](#); *Versace 19.69 Abbigliamento Sportivo Srl v EUIPO*

ViSAGE; Judgment of 6 April 2017 in Case [T-219/16](#); *Aldi GmbH & Co. KG v EUIPO*

♦ **VITA**; Judgment of 12 December 2017 in Case [T-35/16](#); *Sony Computer Entertainment Europe Ltd v EUIPO*

♦ **wax by Yuli's**; Judgment of 1 February 2017 in Case [T-19/15](#); *Yuleidy Caridad Gómez Echevarría v EUIPO*

♦ **WIDIBA / ING DiBa et al.**; Judgment of 26 September 2017 in Case [T-83/16](#); *Banca Monte dei Paschi di Siena SpA and Wise Dialog Bank SpA (Banca Widiba SpA) v EUIPO*

♦ **WIDIBA / ING DiBa et al.**; Judgment of 26 September 2017 in Case [T-84/16](#); *Banca Monte dei Paschi di Siena SpA and Wise Dialog Bank SpA (Banca Widiba SpA) v EUIPO*

♦ ♦ **WINDFINDER**; Judgment of 20 July 2017 in Case [T-395/16](#); *Windfinder R & L GmbH & Co. KG v EUIPO*

XKING (fig.) / X (fig.) et al.; Judgment of 26 July 2017 in Case [C-84/16 P](#); *Continental Reifen Deutschland GmbH v EUIPO*

YLOELIS / YONDELIS et al.; Judgment of 16 May 2017 in Case [T-85/15](#); *Alfa Wassermann*



SpA v EUIPO

Zerø / ZERO; Judgment of 16 November 2017 in Case [T-722/16](#); *Mapei SpA v EUIPO*

◆ **ZIMARA / FEMARA**; Judgment of 21 September 2017 in Case [T-238/15](#); *Novartis AG v EUIPO*

◆ **ZIRO / zero**; Judgment of 9 February 2017 in Case [T-106/16](#); *zero Holding GmbH & Co. KG v EUIPO*

◆ **ZuMEX / JUMEX**; Order of 4 May 2017 in Case [C-71/16 P](#); *Comercializadora Eloro, S.A. v EUIPO + Zumex Group, S.A.*

◆ **ZUM wohl**; Judgment of 22 June 2017 in Case [T-236/16](#); *Biogena Naturprodukte GmbH & Co. KG v EUIPO*

ZYMARA / FEMARA; Judgment of 21 September 2017 in Case [T-214/15](#); *Novartis AG v EUIPO*

Preliminary Rulings

Bayerische Motoren Werke; Preliminary ruling of 13 July 2017 in Case [C-433/16](#); *Bayerische Motoren Werke AG v Acacia*

Hummel Holding AS / NIKE; Judgment of the Court (Second Chamber) of 18 May 2017, EU:C:2017:390 (Request for a preliminary ruling from the Oberlandesgericht Düsseldorf) in Case [C-617/15](#); *Hummel Holding A/S v Nike Inc. and Nike Retail B.V.*

KERRYGOLD; Preliminary ruling of 20 July 2017 in Case [C-93/16](#); EU:C:2017:571; *Ornua Co-operative Ltd, formerly The Irish Dairy Board Co-operative Ltd (Ornua) v Tindale & Stanton Ltd España SL (T&S)*

Merck; Preliminary ruling of 19 October 2017 in Case [C-231/16](#); *Merck KCaA v Merck & Co. Inc. and Others*

Moreno Marín a.o. / La Milla de Oro; Preliminary ruling of 6 July 2017 in Case [C-139/16](#); *Marín a.o vs Abadía RetuertaSA*

Schweppes S.A.; Preliminary ruling from the Juzgado de lo Mercantil n° 8 de Barcelona Judgment of the Court (Second Chamber) of 20 December 2017 in Case [C-291/16](#); *Schweppes SA v Red Paralela SL*

W. F. Gözze Frottierweberei+Gözze / International cotton certification; Preliminary ruling of 8 June 2017 in Case [C-689/15](#); *W.F. Gözze Frottierweberei GmbH, Wolfgang Gözze v Verein Bremer Baumwollbörse*