



Boards of Appeal
Litigation Service

OVERVIEW OF CJ/GC CASE-LAW

STATUS: 01/01/2019 — 31/08/2020



- Preface -

The Litigation Service of the International Cooperation and Legal Affairs Department [now the Litigation Service of the Boards of Appeal] prepares this OVERVIEW OF GJ/GC CASE-LAW.

It contains a systematic compilation of the key points of judgments and of orders rendered by the Court of Justice and the General Court of the European Union in 2019 on actions brought against decisions taken by the Office's Boards of Appeal (BoA) in trade mark and design matters. It also contains key points of judgments rendered by the Court of Justice in preliminary rulings on IP rights and their enforcement. The key points consist of new or infrequent statements or statements that, while not new, are relevant in confirming established case-law. Please note that the key points do not necessarily reproduce the exact wording of the judgments or orders. Each key point is preceded by keywords to allow the user to quickly identify the case-law of interest and the relevant issues.

The hyperlinks in the case reference lead to the Office's eSearch Case Law database, giving the user easy access to the full text of the judgment or order, together with any available translations of them, a summary of the case, and also further relevant information and documents (e.g. first instance and BoA decisions) and a link to the InfoCuria Database of the Court of Justice of the European Union.

This compilation will be constantly updated with the corresponding key points of future judgments and orders, allowing users to search quickly and easily the most recent case-law.

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CHAPTER I — PROCEDURAL MATTERS

1 PROCEEDINGS BEFORE THE CJ

1.1 ADMISSIBILITY

1.1.1 Appeal allowed / not allowed to proceed

Article 58a(3) Statute — Article 170a(1) RPCJ [applicable as from 1 May 2019]

An appeal brought against a decision of the GC concerning a decision of the BoA is only allowed to proceed, wholly or in part, where it raises an issue that is significant with respect to the unity, consistency or development of EU law, Article 58a(3) Statute, Article 170a(1) RPCJ (§ 2-4).

10/07/2019, C-359/19 P, [MEBLO](#), EU:C:2019:591, § 2-4

Request that the appeal be allowed to proceed — Article 170a(1) RPCJ

The appellant must annex to the appeal a request that the appeal be allowed to proceed (the request), setting out the issue raised by the appeal that is significant with respect to the unity, consistency or development of EU law and containing all the information necessary to enable the CJ to rule on that request, Article 170a(1) RPCJ (§ 4).

It is for the appellant to demonstrate that the issues raised by its appeal are significant with respect to the unity, consistency or development of EU law (§ 15-17).

The request must contain all the information necessary to enable the Court to give a ruling on whether the appeal should be allowed to proceed and to specify, where the appeal is allowed to proceed in part, the pleas in law or parts of the appeal to which the response must relate (§ 16).

The request must set out clearly and in detail the grounds on which the appeal is based, identify with equal clarity and detail the issue of law raised by each ground of appeal, specify whether that issue is significant with respect to the unity, consistency or development of EU law and set out the specific reasons why that issue is significant according to that criterion. As regards, in particular, the grounds of appeal, the request must specify the provision of EU law or the case-law that has been infringed by the judgment under appeal, explain succinctly the nature of the error of law allegedly committed by the GC, and indicate to what extent that error had an effect on the outcome of the judgment under appeal. Where the error of law relied on results from an infringement of case-law, the request that the appeal be allowed to proceed must explain, in a succinct but clear and precise manner, first, where the alleged contradiction lies, by identifying the paragraphs of the judgment or order under appeal that the appellant is calling into question, as well as those of the ruling of the CJ or the GC alleged to have been infringed, and, secondly, the concrete reasons why such a contradiction raises an issue that is significant with respect to the unity, consistency or development of EU law (§ 17).

24/10/2019, C-614/19P, [Personenkraftwagen /Kraftwagen et al.](#), EU:C:2019:904, § 4, 15-17

1.1.2 Admissibility of the appeal

1.1.2.1 Locus standi, interest in bringing proceedings

Appeal against GC judgment dismissing action brought against revocation decision

An appellant's interest in bringing appeal proceedings presupposes that the appeal must be likely, if successful, to procure an advantage for it (§ 16). The BoA decision, which was subsequently

revoked by the contested decision, was favourable to the appellant [proprietor] insofar as the appeal lodged by the invalidity applicant against the Cancellation Division's (CD) decision, which was partially favourable in itself to the proprietor, was rejected. If the present appeal were allowed and the judgment under appeal annulled, the BoA's decision would remain in force, so that the appeal would procure an advantage to the appellant [proprietor], since the latter would continue to benefit from the protection for the word mark **Repower** for certain goods and services (§ 17-18). This cannot be called into question by the argument that this advantage would only be temporary, because the GC implicitly stated in the judgment under appeal that it would have to annul the BoA's decision which contains an inadequate statement of reasons (§ 19).

31/10/2019, C-281/18 P, [REPOWER](#), EU:C:2019:916, § 16-19

1.1.2.2 Form, time limit, means of communication

Inadmissibility of an appeal relating to costs — Article 58 Statute

'No appeal shall lie regarding only the amount of the costs or the party ordered to pay them' (Article 58 Statute). Where all grounds of an appeal are rejected, any form of order sought concerning the alleged unlawfulness of the GC's decision on costs is rejected as inadmissible (Order of 15/10/2012, *Internationaler Hilfsfonds v Commission*, C-554/11 P, EU:C:2012:629, § 38, 39) (§ 100).

29/07/2019, C-124/18P, [Blue and Silver \(COLOUR MARK\)](#), EU:C:2019:641, § 100

1.1.3 Admissibility of the pleas

1.1.3.1 Distinction between points of law and matters of fact

- Points of law

Methodological error in the assessment — Failure to take all relevant factors into account

The existence of a likelihood of confusion (LOC) on the part of the public must be assessed globally, taking into account all the factors relevant to the circumstances of the case. Whereas the evaluation of those factors is an issue of fact that cannot be reviewed by the Court, failure to take all the relevant factors into account constitutes an error of law and may, as such, be raised before the Court in the context of an appeal (16/06/2011, C-317/10 P, *Uniweb*, EU:C:2011:405, § 45) (§ 13). An alleged methodological error in the assessment of the possible existence of a LOC, in that the GC failed to take account, in its examination of the similarity between the signs, of the name in normal script of the mark applied for, as set out in the *European Union Trade Marks Bulletin*, constitutes an error of law (§ 13).

04/07/2019, C-99/18 P, [Fl \(fig. / fly.de \(fig.\)\)](#), EU:C:2019:565, § 13

Misinterpretation of Article 95(1) EUTMR — Rejection as inadmissible of a plea raised for the first time before the GC concerning alleged weak distinctive character of the earlier mark

The allegation that the GC misinterpreted and misapplied Article 76(1) CTMR [now Article 95(1) EUTMR] by declaring the appellant's argument concerning the weak distinctive character of the earlier mark inadmissible on the ground that that argument had been put forward before it for the first time, is a question of law which may be subject to review on appeal (§ 26).

18/06/2020, C-702/18 P, [PRIMART Marek Łukasiewicz \(fig.\) / PRIMA et al.](#), EU:C:2020:489, § 26.

Criteria for assessment of existence of genuine use — Methodology and criteria for assessment of conceptual similarity

The criteria in respect of which the GC must assess the existence of genuine use of a trade mark for the goods or services for which it is registered, or part of those goods or services, within the meaning of Article 42(2) CTMR [now Article 47(2) EUTMR], as well as the methodology and criteria within the assessment of the conceptual similarity of the signs, are questions of law which can be subject to review by the CJ on appeal (12/12/2019, C-143/19 P, EIN KREIS MIT ZWEI PFEILEN (fig.), EU:C:2019:1076, § 51) (§ 29, 74).

16/07/2020, C-714/18 P, [tigha / TAIGA](#), EU:C:2019:1139, § 29, 74

- [Matters of fact](#)

Well-known facts

The GC's finding on whether or not facts on which the BoA based its decision are well known is a factual assessment which, save where the facts or evidence are distorted, is not subject to review by the CJ on appeal (§ 69).

16/01/2019, C-162/17 P, [LUBELSKA \(FIG. MARK\) / Lubeca](#), EU:C:2019:27, § 69

- [Control of the legal qualification of the facts](#)

[No key points available yet.]

1.1.3.2 Distortion of facts

Distortion of certain facts — No impact on the result

The CJ reveals numerous flaws in the GC's judgment: some of the facts were distorted by the GC in the judgment (§ 51-56); the GC did not justify its finding that the contested mark is similar to the sign used by the invalidity applicant and that it could be confused with it (§ 59); the GC was wrong to find that the proprietor intended to exploit the economic potential that could be mined from the name of the invalidity applicant's sign, because it is based on an unsubstantiated assertion that the signs in question are similar (§ 66). However, despite those flaws, the CJ upholds the GC's judgment, holding that the GC had highlighted certain objective circumstances and, solely on the basis of these circumstances, it was entitled to find that the proprietor had acted in bad faith (§ 67-68).

13/11/2019, C-528/18 P, [Outsource 2 India \(fig.\)](#), EU:C:2019:961, § 51-56, 59, 66-68

1.1.3.3 Pleas to be put forward expressly, intelligibly and coherently

[No key points available yet.]

1.1.3.4 Mere repetition of the arguments put forward before the General Court

[No key points available yet.]

1.1.3.5 Inadmissibility of ‘new’ pleas and exceptions to the principle

[No key points available yet.]

1.1.3.6 Pleas raised for the first time in the reply or during the hearing

[No key points available yet.]

1.1.4 Cross-appeals

[No key points available yet.]

1.2 REVIEW OF THE DECISIONS OF THE GC

1.2.1 Essential procedural requirements

[No key points available yet.]

1.2.2 Conditions for admissibility

[No key points available yet.]

1.2.3 Rights of the defence

[No key points available yet.]

1.2.4 Duty to state reasons

Scope of the GC’s duty to state reasons — Article 36 Statute — Article 53 Statute

The GC’s duty to state reasons under Article 36 and the first paragraph of Article 53 of the Statute does not require the GC to provide an account that follows exhaustively and one by one all the arguments put forward by the parties to the case. The reasoning may also be implicit, on condition that it enables the persons concerned to understand the grounds of the GC’s judgment and provides the CJ with sufficient information to exercise its powers of review on appeal (20/09/2016, *Mallis and Others v Commission and ECB*, C-105/15 P to C-109/15 P, EU:C:2016:702, § 45) (§ 17).

04/07/2019, C-99/18 P, [FI \(fig. / fly.de \(fig.\)\)](#), EU:C:2019:565, § 17

16/01/2019, C-162/17 P, [LUBELSKA \(FIG. MARK\) / Lubeca](#), EU:C:2019:27, § 79

1.2.5 Obligation to respond to the heads of claim and pleas

[No key points available yet.]

1.3 STAY OF THE PROCEEDINGS

[No key points available yet.]

1.4 DISCONTINUANCE AND NO NEED TO ADJUDICATE

[No key points available yet.]

1.5 REMITTAL/NON-REMITTAL FROM THE CJ TO THE GC

[No key points available yet.]

1.6 COSTS

[No key points available yet.]

1.7 OTHER QUESTIONS

Revision — Article 44 Statute — Article 159 RPCJ

Revision is not an appeal procedure, but an exceptional review procedure that allows the authority of res judicata attaching to a final judgment or to an order to be called into question on the basis of the findings of fact relied upon by the Court.

Revision presupposes the discovery of elements of a factual nature that existed before the judgment or the order and that were unknown at that time to the Court that delivered the judgment or the order as well as to the party applying for revision and that, had the Court been able to take them into consideration, could have led it to a different determination of the proceedings (§ 25).

08/05/2019, C-118/18 P REV [bittorrent](#), EU:C:2019:396, § 25
16/01/2020, C-118/18 P-REV II, [bittorent](#), EU:C:2020:11, § 28

Request to reopen the oral part of the procedure — Article 83 RPCJ

The RPCJ make no provision for submitting observations in response to the Advocate General's Opinion. Disagreement with the Advocate General's Opinion cannot therefore in itself constitute grounds justifying the reopening of the oral procedure. The Court is not bound by the description of the grounds of appeal and arguments, as set out in the Advocate General's Opinion. The findings in that opinion do not constitute a new fact submitted by a party after the closure of the oral part of the procedure within the meaning of Article 83 RPCJ (§ 37-38).

05/03/2020, C-766/18 P, [BBQLOUMI \(fig.\) / HALLOUMI.](#), EU:C:2020:170, § 37-38

2 PROCEEDINGS BEFORE THE GC

2.1 ADMISSIBILITY

2.1.1 Admissibility of the application

2.1.1.1 Locus standi, interest in bringing proceedings

Locus standi — Several applicants

Where admissibility must be established for one and the same application lodged by a number of applicants and the application is admissible in respect of one of them, there is no need to consider

whether the other applicants are entitled to bring proceedings (24/03/1993, CIRFS and Others v Commission, C-313/90, EU:C:1993:111, § 31) (§ 17-19).

03/10/2019, T-533/18, [WANDA FILMS / WANDA et al.](#), EU:T:2019:727, § 17-19
03/10/2019, T-542/18, [wanda films \(fig.\) / WANDA et al.](#), EU:T:2019:728, § 17-19

No locus standi — International registration designating the EU — No recording of the change in ownership in the international register — Inadmissibility of the action

The admissibility of an action must be judged by reference to the situation prevailing when the application was filed (§ 20). Under Article 72(4) EUTMR, action against a BoA decision is open to any party to proceedings before the BoA adversely affected by its decision (§ 21).

Where the change in ownership of an international registration designating the European Union takes place after the BoA has adopted a decision, but before an action has been brought before the GC, the new proprietor may bring an action before the GC without having to submit an application for replacement and should be accepted as a party to the proceedings once it has proven ownership of the registration invoked before the EUIPO (see, by analogy, 28/06/2005, T-301/03, Canal Jean, EU:T:2005:254, § 19, and 21/04/2010, T-361/08, Thai silk, EU:T:2010:152, § 31) (§ 24).

However, the date on which a change in ownership is recorded in the international register is only relevant for establishing the admissibility of the action. According to the combined reading of Article 20 EUTMR, in particular Article 20(11) EUTMR, on the one hand, and Article 199 EUTMR on the other, the new proprietor may invoke the rights arising from the international registration only after the recording of a change in ownership in the international register (§ 22).

16/01/2020, T-128/19; [Sativa \(fig.\) / K KATIVA \(fig.\) et al.](#); ECLI:EU:T:2020:3, § 21-22, 24

No interest in bringing proceedings — Action brought against an obsolete BoA decision — Article 71(3) EUTMR

Where an invalidity application is withdrawn after the adoption of the BoA's decision and before the action was brought before the GC, within the two-month period for bringing an action before the GC, the contested decision becomes obsolete and cannot take effect nor become final. The EUTM proprietor does not have any interest in bringing proceedings since the annulment of an obsolete decision cannot procure it any advantage (§ 28-30).

23/05/2019, T-609/18, [d:ternity / iTernity et al.](#), EU:T:2019:366, § 28-30

No challengeable act — Action brought against an intermediate measure — Inadmissibility

An action for annulment is, in principle, only available against a measure by which the institution concerned definitively determines its position upon the conclusion of an administrative procedure. An intermediate measure whose aim is to prepare the final decision cannot form the subject matter of an action for annulment (13/10/2011, C-463/10 P and C-475/10 P Deutsche Post and Germany v Commission, EU:C:2011:656, § 50) (§ 22).

The BoA's decision to suspend the proceedings before it pending a definitive decision of the General Court (GC) in a parallel case (and taken in accordance with the principles of legal certainty, procedural economy and good administration, after balancing the interests of the parties to the dispute) constitutes an intermediate measure, the purpose of which is to prepare for the final decision to be adopted by the BoA. It is not intended to produce binding legal effects capable of affecting the interests of the applicant before the GC, by bringing about a distinct change in its legal position, insofar as it does not terminate the proceedings before the BoA and does not

definitively determine the position of the BoA as to the outcome of the appeal before it (05/09/2019, C-162/19 P, *INSPIRED BY ICELAND-ICELAND*, EU:C:2019:686, § 5, 6) (§ 25).

15/07/2020, T-838/19 to T-842/19, [Fluid distribution equipment](#), EU:T:2020:343, § 22, 25

Article 50 TUE — Withdrawal of a Member State — Opposition based on earlier UK mark — Interest in bringing proceedings

The fact that the earlier trade mark could lose the status of a trade mark registered in a Member State after the filing of the application for registration of the EU trade mark against which a notice of opposition has been filed on the basis of that earlier mark, in particular following the possible withdrawal of the Member State concerned from the European Union under Article 50 TEU, without specific provision having been made in that respect in any agreement concluded under Article 50(2) TEU, is therefore, in principle, irrelevant to the outcome of the opposition (§ 19).

The existence of an interest in bringing proceedings before the GC against a decision of the BoA allowing such an opposition based on such an earlier national mark — or upholding a decision of the OD in that sense — is not, in principle, affected (see, by analogy, 08/10/2014, T-342/12, *Star*, EU:T:2014:858, § 23-29) (§ 19).

30/01/2020, T-598/18, [BROWNIE / BROWNIE, Brownie \(series mark\)](#); EU:T:2020:22, § 19

2.1.1.2 Representation

Power of attorney signed by the applicant's legal representative

The RPGC no longer require proof that the authority granted to the lawyer was conferred on him/her by someone authorised for that purpose, Article 51(3) RPGC (28/09/2016, T-476/15, *FITNESS*, EU:T:2016:568, § 19) (§ 13-14).

19/12/2019, T-40/19, [THE ONLY ONE by alphspirit wild and perfect \(fig.\) / ONE](#), EU:T:2019:890, § 13-14

2.1.1.3 Time limit, force majeure, means of communication

e-Curia — Article 56a(4) RPGC

If a procedural document is lodged via e-Curia before the supporting documents required for validation of the access account have been produced, and those supporting documents are not lodged within the following 10 days, the action is manifestly inadmissible (§ 4-10).

25/02/2019, T-759/18, [Open data security](#), EU:T:2019:126, § 4-10

16/07/2020, T-309/20, [Travelnetto / Nett-Travel et al.](#), EU:T:2020:356, § 5-11

2.1.2 Admissibility of a cross-claim

Locus standi — Inadmissibility of a cross-claim

Insofar as a decision of a Board of Appeal (BoA) upholds a party's claims in their entirety, that party is not entitled to bring an action before the Court (14/07/2009, T-300/08, *Golden Elephant Brand*, EU:T:2009:275, § 27). A BoA decision upholds the claims of one of the parties when it has granted the party's application on the basis of one of the grounds for refusal or for invalidity of a mark or, more generally, of only part of the arguments put forward by that party, even if it did not examine, or if it rejected, the other grounds or arguments raised by that party (25/09/2015,

T-684/13, BLUECO / BLUECAR, EU:T:2015:699, § 28 and the case-law cited therein; 17/01/2019, T-671/17, TURBO-K / TURBO-K (fig.), EU:T:2019:13, § 91) (§ 24-31).

05/02/2019, T-44/19; [TC Touring Club \(fig.\) / TOURING CLUB ITALIANO et al.](#), EU:T:2020:31, § 24-31

2.1.3 Replacement (Articles 174-176 RPGC)

Transfer of an intellectual property right during proceedings before the GC

Where an intellectual property right has been transferred to a third party, the successor to that right may apply to replace the original party in the proceedings before the GC, Article 174 RPGC. If the application for replacement is granted, the successor to the party who is replaced must accept the case as it finds it at the time of that replacement. The party is bound by the procedural documents lodged by the party which it has replaced, Article 176(5) RPGC (§ 18-21).

After entry of the transfer of an EUTM application in the Office Register, the successor may rely on the rights deriving from that application, Articles 17 and 24 CTMR [now Articles 20 and 28 EUTMR] (§ 19).

19/09/2019, T-176/17, [VEGA ONE \(fig.\) / Vegas et al.](#), EU:T:2019:625, § 18-21

2.1.4 Admissibility of the heads of claim

2.1.4.1 Claim to issue directions to the EUIPO

General principle

Under Article 72(3) EUTMR, in an action brought against a decision of the BoA, the Court has jurisdiction to annul or to alter that decision. According to settled case-law, in an action before the EU judicature against the decision of a BoA, the Office is required, under Article 72(6) EUTMR, to take the measures necessary to comply with judgments of the EU judicature. Accordingly, it is not for the Court to issue directions to the Office, but for the Office to draw the appropriate inferences from the operative part and grounds of the judgments of the EU judicature (§ 16-18).

25/06/2019, T-82/19, [EAGLESTONE \(fig.\)](#), EU:T:2019:484, § 16-18

2.1.4.2 Claim to alter an EUIPO decision

Claim seeking alteration of the contested decision — Interpretation

The head of claim requesting the alteration of the contested decision may be interpreted, in the light of the contents of the application, as including a claim for annulment even though it is not explicitly expressed in the head of claim itself (§ 18-19).

22/05/2019, T-197/16, [ANDREA INCONTRI / ANDREIA et al.](#), EU:T:2019:347, § 18-19

Single head of claim seeking alteration — Inadmissibility

A single head of claim seeking that the GC should alter the contested decision so as to instruct that the trade mark applied for should be registered is inadmissible because the BoA does not have the power to take cognisance of an application requesting that it register an EU trade mark. Consequently, it is not for the GC to take cognisance of an application for alteration requesting

that it amend the decision of a BoA to that effect. Accordingly, the action as a whole is dismissed as manifestly inadmissible (§ 12-16).

28/03/2019, T-631/18, <#>, EU:T:2019:208, § 12-16

Claim seeking to annul the OD's decision — Interpretation as claim seeking to alter the contested decision

The form of order sought seeking annulment of the OD's decision falls within the GC's jurisdiction to annul or to alter decisions, as provided for in Article 72(3) EUTMR (§ 97).

29/04/2020, T-37/19, [cimpres / p impres \(fig.\) et al.](#), EU:T:2020:164, § 97

2.1.4.3 Claim to confirm a decision

Action against a confirmatory decision — Inadmissibility

An action against a confirmatory decision is inadmissible as it merely confirms an earlier decision not challenged in due time. A decision is regarded as a mere confirmation of an earlier one if it contains no new factors compared with the earlier decision and if it was not preceded by any re-examination of the situation of the addressee of that earlier decision (§ 38-39). However, a decision cannot be regarded as 'confirmatory' of a decision adopted by the Opposition Division (OD) in the context of different opposition proceedings concerning the same parties and the same trade marks, in particular when it concerns the genuine use of the earlier mark or the conceptual comparison, which can vary depending on the relevant public and also over time (§ 40-42).

07/11/2019, T-380/18, [INTAS / INDAS \(fig.\) et al.](#), EU:T:2019:782, § 38-42

2.1.4.4 Claim in excess of what is appealable

Head of claim seeking registration of the mark applied for — Inadmissibility

A head of claim seeking registration of the mark applied for is inadmissible. Albeit the claim could be interpreted as seeking an alteration of the BoA's decision, the BoA has no competence to deal with a request to register an EUTM. Thus, it is not for the GC to take a decision on an application requiring the alteration of the BoA decision in this respect (§ 10-13).

20/03/2019, T-760/17, [Triotherm+](#), EU:T:2019:175, § 10-13

A head of claim seeking to 'declare that the trade mark applied for may proceed to registration'

A head of claim seeking to 'declare that the trade mark applied for may proceed to registration' is inadmissible since the Court has no jurisdiction to deliver declaratory judgments (§ 18-20).

09/07/2019, T-397/18, [Hugo's Burger Bar \(fig.\) / H'ugo's et al.](#), EU:T:2019:489 § 18-20

Head of claim seeking to obtain confirmatory or declaratory rulings

A head of claim seeking to obtain confirmatory or declaratory rulings is inadmissible (§ 23-27).

29/01/2019, T-336/17, [YATEKOMO / YA TE COMERE EL VACIO QUE TE LLENA \(fig.\)](#), EU:T:2019:36, § 23-27

12/03/2019, T-463/18, [SMARTSURFACE](#), EU:T:2019:152, § 9-11

Head of claim seeking a declaration that the action before the GC has become devoid of purpose

Where a contested decision is obsolete at the moment of the introduction of the action before the GC, the action is already devoid of purpose at that moment. It has not become devoid of purpose in the course of the proceedings before the GC (§ 37).

23/05/2019, T-609/18, [d:ternity / iTernity](#), EU:T:2019:366, § 37

Claim challenging part of the decision that was not challenged before the BoA — Inadmissibility

The OD's decision becomes final in respect of the part of the decision/goods not challenged before the BoA. A head of claim challenging that part of the OD's decision before the GC is therefore inadmissible (§ 15).

28/05/2020, T-333/19, [GN Genetic Nutrition Laboratories \(fig.\) / GNC GENERAL NUTRITION CENTERS et al.](#), EU:T:2020:232, § 15

2.1.4.5 Clarification of a claim

[No key points available yet.]

2.1.4.6 Interpretation of a claim by the GC

Interpretation of the intervener's head of claim seeking to confirm the contested decision

An intervener's head of claim seeking to confirm, or to 'uphold', the contested decision is interpreted as seeking the dismissal of the action (§ 15) (13/12/2016, T-58/16, APAX / APAX et al., EU:T:2016:724, § 15).

27/02/2019, T-107/18, [Dienne \(fig.\) / ENNE \(fig.\)](#), EU:T:2019:114, § 15

12/07/2019, T-698/17, [MANDO / MAN \(fig.\) et al.](#), EU:T:2019:524, § 16

Interpretation of the applicant's head of claim seeking annulment of a decision by which the BoA had upheld its claim in part

Even though the BoA partially upheld the applicant's appeal, the applicant's head of claim seeking annulment of the contested decision is interpreted as seeking the annulment of the contested decision in part (26/02/2015, T-713/13, 9flats.com, EU:T:2015:114, § 19).

10/07/2020, T-616/19, [Wonderland / Wondermix et al.](#), EU:T:2020:334, § 19

Interpretation of a head of claim requesting the alteration of a contested decision

A head of claim requesting the alteration of a contested decision may be interpreted in the light of the contents of the application as including a claim for annulment, even though it is not explicitly expressed in the head of claim itself (§ 18-19).

22/05/2019, T-197/16, [ANDREA INCONTRI / ANDREIA et al.](#), EU:T:2019:347, § 18-19
29/04/2020, T-106/19; [ABARCA SEGUROS \(fig.\) / Abanca](#), EU:T:2020:158, § 16

Interpretation of a head of claim seeking to alter a contested decision

Where the applicant before the GC (opponent) seeks to have the BoA decision altered, without seeking the annulment of that decision, the application for alteration necessarily includes an application for annulment (07/11/2013, T-666/11, Gato domestico, EU:T:2013:584, § 18) (§ 19). Insofar as the opponent requests the GC to order the rejection of the application for registration for the services in Classes 35 and 39 in respect of which its appeal was dismissed by the BoA, the opponent is essentially asking the GC to adopt the decision which, in its view, the Office should have taken, that is to say, a decision finding that the conditions of opposition are satisfied, so that the Office enforces it by refusing registration of the trade mark applied for in respect of those services. Accordingly, the opponent requests that the contested decision be altered, Article 72(3) EUTMR (§ 18-21).

12/03/2020, T-296/19, [Sum011 / ORIGINAL Sumol ORANGE ORIGINAL Sumol LARANJA \(fig.\)](#), EU:T:2020:93, § 18-21

Interpretation of a head of claim seeking to annul the OD's decision as claim seeking to alter the contested decision

The form of order sought seeking to annul the OD's decision falls within the GC's jurisdiction to annul or to alter decisions, as provided for in Article 72(3) EUTMR (§ 97).

29/04/2020, T-37/19, [cimpres / p impress \(fig.\) et al.](#), EU:T:2020:164, § 97

2.1.5 Formal requirements

2.1.5.1 Oral hearing request

Possibility to rule by reasoned order at any time according to Article 126 RPGC despite an oral hearing request

Pursuant to Article 126 RPGC, the GC can decide to rule by reasoned order without taking further steps in the proceedings, notwithstanding the fact that a hearing was requested (12/09/2019, T-182/19, SOFTFOAM (fig.), EU:T:2019:604, § 10) (§ 18).

11/06/2020, T-553/19, [PERFECT BAR](#), EU:T:2020:268, § 18
11/06/2020, T-563/19, [PERFECT BAR \(fig.\)](#), EU:T:2020:271, § 18
16/06/2020, T-558/19, [HOSPITAL DA LUZ LEARNING HEALTH TRAINING, RESEARCH & INNOVATION CENTER \(fig.\) / C LUZCLINICA LA LUZ \(fig.\) et al.](#), EU:T:2020:274, § 18

2.1.5.2 General references to documents produced before a BoA

Formal requirement of the application — General references

According to Article 21 Statute and Article 171 and Article 177(1) RPGC, any application must indicate the subject matter of the proceedings and a summary of the pleas in law relied on. The

basic matters of fact and law relied on must be indicated, at least in summary form, coherently and intelligibly in the application. The summary and the pleas of law must be sufficiently clear and precise to enable the defendant to prepare its defence and the competent court to rule on the action. Although the body of the application may be supported and supplemented in relation to specific points by references to extracts from documents annexed to it, general references to other written submissions are inadmissible, even if these submissions are annexed, to the extent that they cannot be linked to the pleas and arguments put forward in the application itself (§ 11, 12).

11/07/2019, T-349/18, [TurboPerformance \(fig.\)](#), EU:T:2019:495, § 11, 12

General references

General references to previous submissions lodged before the Office are inadmissible according to Article 21 Statute and Article 177(1)(d) RPGC (§ 15-23).

13/02/2019, T-278/18, [DENTALDISK](#), EU:T:2019:86, § 15-23

08/07/2020, T-328/19, [SCORIFY \(fig.\) / Scor et al.](#), EU:T:2020:311, § 20-21

2.1.5.3 Others

Unforeseen documents in the RPGC — Request to lodge a reply

As the RPGC no longer provide for requests to lodge a reply in IP proceedings, any such request is rejected (§ 24-26).

13/02/2019, T-278/18, [DENTALDISK](#), EU:T:2019:86, § 24-26

2.2 SUBJECT MATTER OF THE PROCEEDINGS BEFORE THE GC

2.2.1 Admissibility of pleas in law, arguments and evidence

Admissible plea — Allegation of insufficient evidence for the BoA's confirmation of an undisputed issue — Part of the factual and legal background of the dispute

The BoA considered that the disclosure of the earlier design was undisputed, since the RCD proprietor had acknowledged in a letter that the design had been introduced on the European market in 2009. Therefore, the question concerning the disclosure of the earlier design had been examined and formed part of the factual and legal background to the dispute brought before the BoA. Consequently, the RCD proprietor's claim before the GC that the evidence on which the BoA had based its decision was not sufficient to find that the earlier design had indeed been made available, is admissible (§ 17-18).

08/07/2020, T-748/18, [Pneumatic power tools](#), EU:T:2020:321, § 17-18

2.2.1.1 Pleas to be put forward expressly, intelligibly and coherently

[No key points available yet.]

2.2.1.2 No alteration of the subject matter of the proceedings

Scope of the GC's review — Admissible plea

The plea relating to the 'agent-principal' relationship is admissible despite the fact that the invalidity applicant did not challenge the conclusion of the CD before the BoA (§ 28). Even if the appellant has not raised a specific ground of appeal, the BoA is required to examine whether a new decision with the same operative part as the decision under appeal may be lawfully adopted at the time of the appeal ruling (§ 27). The invalidity applicant made submissions regarding the 'agent-principal' relationship before the cancellation. Therefore, it also appeared in the documents before the BoA that correctly proceeded to analyse the conditions of the invalidity ground (§ 28).

14/02/2019, T-796/17, [MOULDPRO](#), EU:T:2019:88, § 27-28

Scope of the GC's review — Admissible plea — Issue to be examined *ex officio* by the BoA

In opposition proceedings based on Article 8(1) CTMR [now Article 8(1) EUTMR], the assessment of the inherent distinctive character of the earlier mark constitutes an issue of law which is necessary to ensure the correct application of that regulation: the instances of the Office are required to examine that issue, of their own motion if necessary, and it forms part of the subject matter of the proceedings before the BoA within the meaning of Article 188 RPGC (§ 43).

Therefore, the GC erred in law by declaring the appellant's plea concerning the allegedly weak distinctive character of the earlier mark inadmissible on the ground that that argument had been put forward before it for the first time (§ 47).

18/06/2020, C-702/18 P, [PRIMART Marek Łukasiewicz \(fig.\) / PRIMA et al.](#), EU:C:2020:489, § 43 and 47.

Scope of the GC's review — Inadmissible plea

Under Article 72(1) EUTMR, actions may be brought before the EU judicature only against BoA decisions. Therefore, pleas are only admissible when directed against such decisions, and cannot be directed against grounds that are only included in first instance decisions or communications (§ 39-40).

12/03/2019, T-463/18, [SMARTSURFACE](#), EU:T:2019:152, § 39-40

Scope of the GC's review — Presumption of identity of the goods by the BoA — Inadmissible plea

For reasons of procedural economy, the OD and the BoA proceeded on the basis that the services were identical without carrying out an exhaustive comparison of those services (§ 28). It is not for the GC to deal with that question, which was not examined by the adjudicating body, but it will determine whether, in the light of that assumption, the BoA's global assessment of LOC is correct (§ 31).

20/09/2019, T-367/18, [UKIO / <IO \(fig.\)](#), EU:T:2019:645, § 28, 31

2.2.1.3 Admissible amplified pleas in law and arguments

[No key points available yet.]

2.2.1.4 Inadmissible new evidence

General principle

Documents, produced for the first time before the Court, cannot be taken into consideration since the purpose of actions before the GC is to review the legality of decisions of the BoA. Therefore, it is not the Court's function to review the facts in the light of documents produced for the first time before it (24/11/2005, T-346/04, Arthur et Félicie, EU:T:2005:420, § 19) (§ 15, 52).

12/07/2019, T-264/18, [mo.da](#), EU:T:2019:528, § 15, 52

24/10/2019, T-708/18, [Flis Happy Moreno choco \(fig.\) / MORENO \(fig.\) et al.](#), EU:T:2019:762, § 26-28

Website extract

A website extract produced as evidence for the first time before the GC (reproduction of an extract of a page of the Wikipedia website which refers to the letter 'æ' of the Danish alphabet) cannot be taken into account within the review of legality of the contested decision and is therefore inadmissible (§ 16).

28/11/2019, T-642/18, [DermaFaes Atopimed / Dermowas](#), EU:T:2019:819, § 16

2.2.1.5 Admissible new evidence

Evidence to refute new arguments in the contested decision — Extracts from the Office's database

Evidence produced for the first time before the GC is admissible if it is necessary to refute arguments put forward for the first time in the contested decision (§ 17).

Extracts from the Office's database containing information about similar registered EUTMs are admissible, since they relate to decisions already taken in respect of similar applications for registration, which must be examined by the Office of its own motion (§ 20-23).

11/04/2019, T-223/17, [ADAPTA POWDER COATINGS \(fig.\)](#), EU:T:2019:245, § 17, 20-23

Database extracts from the Office, National Trade Mark Offices and WIPO

The database extracts from the Office, the German Patent and Trade Mark Office and WIPO, which were produced in order to argue that the contested decision was vitiated by an error in the comparison of goods and services and the LOC with regard to the list of goods for which the earlier marks were registered, are admissible, as this error could not have been detected before the contested decision was adopted (§ 30).

24/10/2019, T-708/18, [Flis Happy Moreno choco \(fig.\) / MORENO \(fig.\) et al.](#), EU:T:2019:762, § 30

Evidence relating to the Office's decision-making practice

Documents that relate to the Office's decision-making practice are not, strictly speaking, evidence within the meaning of Article 85 RPGC and are admissible, even if they are produced for the first time at the hearing. A party may refer to them even where that practice post-dates the proceedings before the Office (24/11/2005, T-346/04, Arthur et Félicie, EU:T:2005:420, § 20) (§ 18-19).

12/07/2019, T-264/18, [mo.da](#), EU:T:2019:528, § 18-19

Evidence to establish the accuracy of well-known facts

Evidence that is restricted to commenting on matters which are common knowledge or to establish the accuracy of well known facts cannot be regarded as new evidence and is therefore admissible (§ 18).

11/07/2019, T-349/18, [TurboPerformance \(fig\)](#), EU:T:2019:495, § 18
10/09/2019, T-744/18, [Silueta en forma de elipse discontinua \(fig.\) / Silueta en forma de elipse \(fig.\)](#), EU:T:2019:568, § 59, 61

2.2.1.6 Pleas raised for the first time during the hearing

Principle — Article 84(1) RPGC, Article 191 RPGC

A new plea in law that was not alleged in the application but put forward for the first time in the oral hearing, without justifying that it is based on matters of law or of fact which came to light in the course of the procedure, is inadmissible, Article 84(1) RPGC, Article 191 RPGC (§ 15-18).

19/06/2019, T-479/18, [Premiere](#), EU:T:2019:430, § 15-18

Amplifying admissible arguments and new inadmissible arguments put forward at the oral hearing

The applicant's arguments concerning the proof of genuine use put forward for the first time at the oral hearing can be interpreted as being a development of the argumentation already contained in the application (§ 25, 28). However, the argument that seeks to challenge the lack of a translation of the evidence into English is inadmissible, as it cannot be considered to be implicitly contained in the statement that the evidence is not 'solid and objective' (§ 25, 28-29, 32).

07/11/2019, T-380/18, [INTAS / INDAS \(fig.\) et al.](#), EU:T:2019:782, § 25, 28-29, 32

Admissible new plea — Plea alleging failure to state reasons — Matter of public policy

A plea alleging failure to state reasons is a plea involving a matter of public policy which may be put forward at any stage of the procedure (§ 87-89).

29/04/2020, T-108/19; [TasteSense By Kerry \(fig.\) / Multisense et al.](#), EU:T:2020:161
29/04/2020, T-109/19; [TasteSense \(fig.\) / Multisense et al.](#), EU:T:2020:162, § 87-89

2.2.1.7 Distortion of facts in the GC's decision

[No key points available yet.]

2.2.1.8 Other

Ineffective plea

A plea seeking to dispute a ground added for the sake of completeness is ineffective and is therefore rejected (§ 48).

31/01/2019, T-97/18, [STREAMS](#), EU:T:2019:43, § 48

2.2.2 Restriction of the list of goods and services

2.2.2.1 Admissible restrictions

Request for limitation of goods and services — Subject matter of the dispute

Where the trade mark applicant requests the limitation of the goods and services after the BoA's decision, this statement is interpreted in the sense that the contested decision is being challenged only insofar as it covers the remainder of the goods concerned, or as a partial withdrawal, where that statement made during the proceedings before the GC does not alter the subject matter of the proceedings before the BoA. Such a limitation must be taken into account by the Court, since it is no longer asked to review the legality of the BoA's decision with regard to the goods or services withdrawn from the list but only insofar as it relates to the remaining goods or services (§ 31-33).

28/11/2019, T-736/18, [Bergsteiger / BERG \(fig.\) et al.](#), EU:T:2019:826, § 31-33

Request for the limitation of goods and services — General conditions

A request for limitation must be filed expressly and unconditionally (§ 45).

31/01/2019, T-97/18, [STREAMS](#), EU:T:2019:43, § 45

Procedure for the limitation of goods and services

Granting the request for the restriction of the goods and services without asking the opponent whether, for that reason, it intended to waive the opposition procedure does not constitute an infringement of Article 95 EUTMR (§ 104-105).

16/05/2019, T-354/18, [SKYFi / SKY et al.](#), EU:T:2019:33, § 104-105

2.2.2.2 Inadmissible restrictions

Inadmissible limitation of goods and services at the oral hearing

The applicant's restriction of the goods from *software applications for mobile phones and software applications for computer* to *software applications for smartphones and tablets*, requested in the oral hearing, does not constitute an admissible limitation of the goods. It is, rather, a modification of the category of goods that would lead to a modification of the subject matter of the dispute. Therefore, it cannot be taken into account by the Court when assessing the legality of the decision (§ 19-20).

24/09/2019, T-492/18, [Scanner Pro](#), EU:T:2019:667, § 19-20

Inadmissible limitation of goods and services — Infringement of the obligation to draw up the list of goods with clarity and precision

The proprietor of the trade mark should not gain from the infringement of its obligation to draw up the list of goods with clarity and precision (§ 80). Given that the concept of *means of transport* is so general and broad that it may naturally be understood as including *moving vehicles for children*, the interpretation of the opponent's limitation *means of transport, excluding bicycles and children's bicycles; moving vehicles for children* in Class 12, in the sense that the list of goods covers only

means of transport and does not concern *moving vehicles for children* cannot be considered as admissible (§ 78-79).

28/11/2019, T-736/18, [Bergsteiger / BERG \(fig.\) et al.](#), EU:T:2019:826, § 78-80

2.3 STAY OF THE PROCEEDINGS

Decision to stay the proceedings — Discretion of the GC

The decision whether or not to stay proceedings falls within the GC's discretion (§ 18).

13/06/2019, T-392/18, [Innocenti / i INNOCENTI \(fig.\)](#), EU:T:2019:414, § 18

2.4 POWER OF ALTERATION

Alteration of the contested decision

The power of the Court to alter decisions pursuant to Article 72(3) EUTMR does not have the effect of conferring on that Court the power to carry out an assessment 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 Court, 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 required to take (16/05/2017, T-107/16, AIR HOLE FACE MASKS YOU IDIOT, EU:T:2017:335, § 45 and the case-law cited) (§ 139).

In this case, the BoA adopted a position on whether there was a LOC between the signs with regard to the initial list of goods covered by the earlier marks, with the result that the Court has the power to alter that decision in that regard (§ 130).

24/10/2019, T-498/18, [Happy Moreno choco \(fig.\) / MORENO \(fig.\) et al.](#), EU:T:2019:763, § 130, 139

2.5 INTERVENTION

2.6 COSTS

Costs of the proceedings before the GC — Article 139a RPGC

In principle, proceedings before the GC are free of charge. However, where a party has caused the GC to incur avoidable costs, in particular where the action is manifestly an abuse of process, the GC may order that party to refund them, Article 139a RPGC.

Following the withdrawal of the application in the night before the delivery of the judgment, the GC orders the parties to refund a portion of the costs incurred over a number of months with a view to delivering a decision closing the proceedings (amounting to EUR 5 000). These costs could have been avoided if at least one of the parties had informed the GC, in the context of a request to stay the proceedings, of the existence of negotiations aimed at an amicable agreement, Article 69(c) RPGC (§ 15-20).

24/09/2019, T-748/17 and T-770/17, [iBeat](#), EU:T:2019:607, § 15-20

Recoverable costs — Article 190(2) RPGC

According to Article 190(2) RPGC, recoverable costs are the costs necessarily incurred by the parties for the purposes of the proceedings before the BoA. They do not include costs incurred in the proceedings before the OD (§ 72).

28/11/2019, T-642/18, [DermoFaes Atopimed / Dermowas](#), EU:T:2019:819, § 72

3 PROCEEDINGS BEFORE THE BoA

3.1 APPEAL DEEMED NOT TO BE FILED

Failure to comply with the obligation to pay the appeal fee within the prescribed period

The notice of appeal to be filed in writing within two months of the date of notification of the contested decision is deemed to have been filed only when the fee for appeal has been paid (Article 68 EUTMR) (§ 25).

The date on which the payment is considered to have been made is the date on which the amount of the payment or transfer is actually entered in a bank account held by the Office (Article 180(1) EUTMR).

In this case, the BoA was entitled to consider that the appeal fee had not been paid within the period provided for in Article 68 EUTMR and that the appeal was deemed not to have been filed (Article 23(3) EUTMDR) (§ 27).

09/10/2019, T-713/18, [Esim Chemicals / Eskim](#), EU:T:2019:744, § 25, 27

3.2 ADMISSIBILITY OF THE APPEAL

3.2.1 Locus standi, interest in bringing proceedings

Article 59 CTMR [now Article 67 EUTMR]

The EUTM proprietor has no interest in bringing an appeal before the BoA against the CD's decisions to close the invalidity proceedings after the withdrawal of the invalidity application. The EUTM proprietor had claimed that it had been deprived of the possibility of obtaining a positive decision on the validity of its EUTM. The EUTM proprietor is not adversely affected by the CD's decisions insofar as the EUTMs remain on the Office's register. The question whether a decision adversely affects a party must be evaluated with respect to the current proceedings and not in comparison, or in conjunction, with other proceedings. The existence of other proceedings before EU trade mark courts has no bearing on the conditions for the admissibility of the action before the BoA (§ 5).

15/01/2019, C-463/18 P, [Hip Ball \(3D\)](#), EU:C:2019:18, § 5

Inadmissibility of a cross-claim — Possibility of conversion does not give locus standi

The cross-claim must be likely to procure, by its outcome, an advantage. The risk that the EUTM applicant might request the conversion of its EUTM application into an application for a national trade mark concerns a future and uncertain legal situation (§ 96-100).

17/01/2019, T-671/17, [TURBO-K / TURBO-K \(fig.\)](#), EU:T:2019:13, § 96-100

3.2.2 Time limit and form of appeal, means of communication

Article 68 EUTMR — Article 23(1)(b) EUTMDR

A notice of appeal before the BoA prepared in the applicant's User Area of the Office's website in 'DRAFT' status is, in the absence of further evidence, not capable of proving the timely submission of the notice of appeal (§ 43).

15/01/2019, T-111/17, [COMPUTER MARKET \(fig.\)](#), EU:T:2019:4, § 43

Electronic communications — Notification by eComm — *Dies a quo*

Article 4(4) of Decision No EX-13-2 of 26 November 2013 concerning electronic communication must be interpreted as meaning that notification will be deemed to have taken place on the fifth calendar day following the day on which the Office placed the document in the user's inbox, unless the actual date of notification can be accurately established as a different date within that period of time (§ 43).

[NB: Article 4(4) of Decision No EX-13-2 of 26 November 2013 was repealed by Article 3(4) of Decision No EX-19-1 of 18 January 2019 (which entered into force on 1 March 2019), which now reads 'Notification will be deemed to have taken place on the fifth calendar day following the day on which the Office placed the document in the user's inbox.' Therefore, when a document is now notified electronically by the Office, an automatic extension of five calendar days following the day on which the document is placed in the User Area is included in the time limit set for any response or procedural step to be taken.]

10/04/2019, C-282/18 P, [Formula E](#), EU:C:2019:300, § 43

Notification of decisions — Notification by email — Notification by registered post with advise of delivery — Burden of proof

A decision is properly notified, provided that it is communicated to the person to whom it is addressed and the latter is put in a position to become acquainted with it (21/02/2018, C-326/16 P, LL/Parliament, EU:C:2018:83, § 47, 48) (§ 42).

Notification by registered post with advice of delivery under the meaning of Article 58(1) EUTMDR, for which the Office bears the burden of proof according to Article 58(3) EUTMDR, requires a signature of the addressee (§ 50). Lacking such a signature, the Office is not able to prove the delivery (§ 55).

A decision is duly notified by email according to Article 56(2)(a) EUTMDR and Article 57(1) EUTMDR, in so far it is possible to prove that the addressee indeed received it and was able to acquire the knowledge of its contents (07/12/2018, T-280/17, GE.CO.P./Commission, EU:T:2018:889, § 50; 21/02/2018, C-326/16 P, LL/Parliament, EU:C:2018:83, § 50) (§ 57-58).

08/07/2020, T-305/19; [Welmax / Valmex](#), EU:T:2020:327, § 42, 50, 55, 57-58

Notification of a decision containing blank spaces — Article 98(1) EUTMR

The Office has to prove that the decision was duly notified to the parties, Article 98(1) EUTMR and Article 56(1) EUTMDR (§ 17-23, 29). However, the parties must show good faith and notify the Office in good time of any omissions or errors that they have detected in the documents sent to them (§ 17, 30).

Notifications to duly authorised representatives — Effect

Where a representative has been appointed, notifications are to be addressed to that representative. A notification or other communication addressed by the Office to the duly authorised representative has the same effect as if it had been addressed to the represented person, Article 60(1) and (3) EUTMDR (§ 30).

28/05/2020, T-564/19, [Libertador](#), EU:T:2020:228, § 30

Admissibility of the appeal — Official designation and legal form of the entity — Article°21(1)(a) EUTMDR, Article°2(1)(b) EUTMIR

The BoA was wrong in declaring the appeal inadmissible due to the applicant's failure to provide the essential information (official designation and legal form of the entity) required by Article 21(1)(a) EUTMDR and Article 2(1)(b) EUTMIR (§ 24-25). The BoA should have taken into account the applicant's status in the EUTM Register on the date on which the contested decision was delivered (§ 23).

11/02/2020, T-262/19, [FORM EINER TASSE \(3D\)](#), EU:T:2020:41, § 23

3.2.3 Restitutio in integrum

Restitutio in integrum — Representative's duty of care — Article 67 CDR

Restitutio in integrum is subject to two cumulative conditions: i) that the party before the Office acted with all due care required by the circumstances; ii) that the party's inability to observe a time limit had, as a direct consequence, the loss of a right or of a means of redress (§ 58). Since the duty of care provided for in Article 67 CDR rests, in principle, on the applicant's representative (§ 20), the question of whether the RCD holder has exercised the necessary vigilance to compensate for the errors of its representative is not relevant (§ 21).

31/01/2019, T-604/17, [REJECTION OF RESTITUTIO IN INTEGRUM \(RECORDAL\)](#), EU:T:2019:42, § 20-21, 58

3.2.4 Continuation of proceedings (not applicable to designs)

[No key points available yet.]

3.2.5 Suspension

Principle — Suspension of the proceedings — BoA's broad discretion — Restricted judicial review

The right to be heard is not infringed by not giving the party that requests a stay of the opposition the opportunity to reply to the observations on that request, since there is no provision that lays down this possibility (§ 55). Pursuant to Rule 20(7)(c) and Rule 50(1) CTMIR [now Article 71(1) EUTMDR] and also case-law, the BoA has a broad discretion as to whether or not to suspend

proceedings (§ 57-58). Any judicial review on its merits is restricted to ascertaining that no manifest error of assessment or misuse of powers has occurred (§ 59).

16/05/2019, T-354/18, [SKYFi/SKY et al.](#), EU:T:2019:33, § 55, 57-59

Manifest error of assessment — Lack of weighing of competing interests

Within the broad discretion of the BoA as to whether or not to suspend ongoing proceedings, the decision must follow upon a weighing of competing interests (§ 20-21). It is a manifest error of assessment when a request for suspension of opposition proceedings, filed on the ground of initiation of invalidity proceedings, is rejected solely on the basis of the relevant party's failure to identify the prospects of success of the invalidity proceedings and the reasons why those proceedings were not brought at an earlier stage (§ 31).

12/06/2019, T-346/18, [VOGUE / VOGA](#), EU:T:2019:406, § 20-21, 31

Manifest error of assessment — Lack of weighing of competing interests — Pending revocation proceedings against the earlier mark

A suspension is not mandatory when revocation proceedings against the earlier mark are pending (§ 38). It was, however, for the BoA to determine, *prima facie*, the likelihood of success of an application for revocation for the purposes of weighing the competing interests (§ 44). The fact that opposition proceedings may become devoid of purpose does not render the grace period conferred by Article 18(1) EUTMR and Article 57(1)(a) and (2) EUTMR illusory, since that period remains intact during the five years provided (§ 48). The BoA may take into account the stage of the procedure at which the application for suspension was filed and the possible dilatory conduct of the party requesting suspension (§ 51). In that regard, the BoA must examine the circumstances in which the request for suspension has been made (§ 52).

14/02/2019, T-162/18, [ALTUS \(fig.\) / ALTOS et al.](#), EU:T:2019:87, § 38, 44, 51-52

No manifest error of assessment — Pending revocation proceedings against the earlier mark

The BoA has broad discretion to suspend proceedings before it. The scope of judicial review by the Courts of the EU is restricted to ascertaining that no manifest error of assessment or misuse of powers has occurred. The mere fact that revocation proceedings against the earlier mark on which the opposition was based were pending does not suffice to categorise the BoA's refusal to suspend the proceedings as a manifest error of assessment (§ 35-36).

13/06/2019, T-392/18, [Innocenti / i INNOCENTI \(fig\)](#), EU:T:2019:414, § 35-36

No manifest error of assessment — *Prima facie* analysis of the likelihood of success of the counterclaim for a declaratory judgment before the German Courts

The BoA did not commit a manifest error of assessment or misuse of powers in rejecting the request for suspension of the appeal proceedings (§ 134). Taking into account the case-law in the pilot proceedings before the GC and the CJ and also the case-law in the parallel cases before the German courts (Oberlandesgericht Düsseldorf and the Bundesgerichtshof), the BoA did not err in finding that the applicant had not proved that the demarcation agreement conferred on it the right to have EU trade marks registered (§ 131, 132). It was therefore possible to conclude the *prima facie* analysis of the likelihood of success of the counterclaim for a declaratory judgment by asserting that this likelihood had not been established (§ 133).

13/05/2020, T-443/18, [Vogue Peek & Cloppenburg / Peek & Cloppenburg](#), EU:T:2020:184, § 117-120
13/05/2020, T-444/18, [Peek & Cloppenburg](#), EU:T:2020:185, § 124-127
13/05/2020, T-445/18, [Peek & Cloppenburg / Peek & Cloppenburg](#), EU:T:2020:186, § 120-123
13/05/2020, T-446/18, [Peek & Cloppenburg / Peek & Cloppenburg](#), EU:T:2020:187, § 122-125
13/05/2020, T-534/18, [Peek / Peek & Cloppenburg](#), EU:T:2020:188, § 129-131
13/05/2020, T-535/18, [Peek's / Peek & Cloppenburg](#), EU:T:2020:189, § 131-134

Failure to state reasons — Pending invalidity proceedings against the earlier mark — Annulment of the OD's decision and remittal of the cases recommending suspension

The BoA examined the appeals without stating reasons for its final decision not to suspend the proceedings, even though it found that it was appropriate to suspend them on account of invalidity proceedings relating to the earlier marks. It upheld the appeals, annulled the OD's decisions and remitted the cases to OD recommending that it suspend the opposition proceedings until the final decisions were reached concerning the validity of the earlier marks (§ 67, 72).

Respect for the right of the persons concerned to have adequate reasons provided for a decision that affects them is particularly important where that decision stems from a broad discretion, as is the case when the BoA has to decide on the possible suspension of the proceedings before it (§ 73).

The approach, aimed at a delayed application of Article 71(1) EUTMDR, is improper (§ 75). The examination of the question of whether to suspend the appeal proceedings must be carried out first before the examination of whether there is a LOC. If the BoA finds that it is appropriate to suspend the proceedings, it has no other option than suspending them, and may not therefore examine the appeal. Since the BoA had found that it was appropriate to suspend the proceedings, it could not rule on the appeals and was unable to make any recommendation whatsoever to the OD, as any referral of the cases to the latter would mean examining the appeals and would therefore stem from an error of law (§ 76).

28/05/2020, T-84/19 & T-88/19 to T-98/19, [We IntelliGence the World \(fig.\) / DEVICE OF TWO OVERLAPPING CIRCLES \(fig.\) et al.](#), EU:T:2020:231, § 67, 72-73, 75-76

3.3 SCOPE OF THE APPEAL

Extent of the appeal — Goods and services

The BoA is not competent to extend its examination to goods and services which are not subject of the appeal (§ 31). However, where the operative part of the contested decisions is limited to the dismissal of the appeal (§ 26, 32), the statements made in the contested decisions that relate to the examination of goods and services for which the examiner had not raised any objections do not affect the scope of the contested decision (§ 34). The plea alleging infringement of Article 64 CTMR [now Article 71 EUTMR], due to the BoA's lack of competence to examine goods and services that were accepted by the examiner, is ineffective (§ 35).

28/03/2019, T-251/17 and T-252/17, [Simply. Connected. \(fig.\)](#), EU:T:2019:202, § 26, 31-32, 34-35

Functional continuity between the first instance and the BoA

When the Board of Appeal (BoA) confirms some aspects of the first instance decision, and given the functional continuity between the first instance and the BoA, that decision, together with the statement of reasons pertaining to those aspects, forms part of the context in which the BoA decision was adopted, a context which is known to the parties and enables the Court to carry out fully its review as to whether the BoA's assessment was well founded (§ 19).

06/02/2020, T-135/19, [LaTV3D / TV3](#), EU:T:2020:36, § 19

Matters of law for the Office to take into account of its own motion

In proceedings relating to relative grounds for refusal, a matter of law may have to be ruled on by the Office of its own motion, even when it has not been raised by the parties, if it is necessary to resolve that matter in order to ensure the correct application of the EUTMR. Therefore, the matters of law put forward before the BoA also include any issue of law that must necessarily be examined for the purpose of assessing the facts and evidence relied on by the parties and for the purpose of allowing or dismissing the claims, even if the parties have not put forward a view on those matters, and even if the Office has omitted to rule on that aspect (§ 31).

28/02/2019, T-459/18, [PEPERO original \(fig.\) / REPRÉSENTATION D'UN BATÔNNET \(fig.\)](#), EU:T:2019:119, § 31

Matters of law for the Office to take into account of its own motion

Under Article 71(1) EUTMR, the BoA has the power to carry out a new, full examination of the merits of the opposition by conducting a new examination of the LOC with the marks that formed part of the subject matter of the proceedings before the OD. It can also decide on earlier rights that were not taken into account by the OD in its decision (§ 71).

16/05/2019, T-354/18, [SKYFi / SKY et al.](#), EU:T:2019:33, § 71

No examination of absolute grounds in invalidity proceedings based on relative grounds

It is not incumbent on the Office or the GC, in the context of invalidity proceedings based on relative grounds, to examine whether an earlier national mark is constituted by a shape, which gives substantial value to the product, within the meaning of Article 7(1)(e)(iii) EUTMR (§ 47).

28/02/2019, T-459/18, [PEPERO original \(fig.\) / REPRÉSENTATION D'UN BATÔNNET \(fig.\)](#), EU:T:2019:119, § 47

BoA's right to re-open the examination of absolute grounds

The BoA has the right to re-open the examination of absolute grounds of refusal on its own initiative at any time before registration, where appropriate, including the right to raise a ground for refusal of the application for registration of the trade mark that has not already been invoked in the decision subject to appeal, Article 45(3) EUTMR and Article 27(1) EUTMDR (§ 21-22).

12/12/2019, T-747/18, [SHAPE OF A FLOWER \(3D\)](#), EU:T:2019:849, § 21-22

BoA's obligation to decide on the limitation of the contested EUTM

Where a request for limitation of the goods and services which, according to Article 49(1) EUTMR, can be made 'at any time', is filed in the course of the appeal proceedings, the BoA is bound to process this request, irrespective of any decision on the admissibility of the appeal, Article 27(5) EUTMDR (§ 27-30).

07/05/2019, T-629/18, [DARSTELLUNG EINES AUTOS IN EINER SPRECHBLASE \(fig.\)](#), EU:T:2019:292, § 27-30

Admissible limitation of goods and services — No extension of the original list of services covered by the earlier national mark

The limitation of the *retail services* in Class 35 by adding the words *namely clothing, headgear made of textile materials, household linen, bed linen and table linen* (§ 29) clarifies the scope of protection of the German mark insofar as the word 'namely' is exhaustive and limits the scope of protection only to the specifically listed goods or services (§ 30). The German term 'Textilien' refers not only to textile materials, fabrics and textiles, but also to 'clothing' and 'products made from textiles'. Therefore, that term refers to goods such as *clothing, headgear made of textile materials, household linen, bed linen and table linen*, so the addition is a limitation and not an extension or amendment of the original list of services covered by the earlier national mark (§ 31).

08/07/2020, T-659/19, [kix \(fig.\) / kik](#), EU:T:2020:328, § 30-31

Cross-appeal ancillary to the appeal before the BoA

Where the claims of a party to opposition proceedings have been rejected in part, that party can either file an (independent) appeal against the decision of the OD, under Articles 66 and 67 EUTMR, or make incidental submissions seeking the annulment or alteration of that decision on a point not raised during the appeal, under Article 8(3) of Regulation No 216/96 (Rules of Procedure of the BoA) (§ 14). In the latter case, in the event of discontinuance of the proceedings, its capacity to take part in legal proceedings is inextricably linked to the intentions of the other party that brought the action before the BoA (§ 15).

The action brought before the GC by the party that made incidental submissions against the decision is necessarily linked, procedurally, to the other party's appeal against the decision of the OD, insofar as the BoA has ruled on the OD's decision. Furthermore, an appeal, brought within the prescribed periods, leads to the suspension of the taking effect of the BoA decisions, under Article 71(3) EUTMR (§ 17).

Therefore, the GC did not err in law in finding that it was still possible for the other party to withdraw its appeal before the BoA, and that this withdrawal meant, as a result, that the BoA was no longer required to rule on the incidental submissions (§ 18).

10/07/2019, C-170/19P, [Cheapflights \(fig.\) / Cheapflights \(fig.\)](#), EU:C:2019:581, § 15, 17, 18

3.4 ESSENTIAL PROCEDURAL REQUIREMENTS

3.4.1 Right to be heard

Scope of the principle

The right to be heard for the purposes of Article 94(1) EUTMR extends to the factual and legal matters on which the decision-making act is based, but not to the final position that the authority intends to adopt (07/09/2006, T-168/04, *Aire limpio*, EU:T:2006:245, § 116) (§ 27).

26/03/2020, T-653/18, [GIORGIO ARMANI le Sac 11 \(fig.\) / LESAC et al.](#), EU:T:2020:121, § 27
26/03/2020, T-654/18, [le Sac 11 \(fig.\) / LESAC et al.](#), EU:T:2020:122, § 27

Scope of the principle — Article 62 CDR

The right to be heard, as enshrined in Article 62 CDR, extends to all the matters of fact or of law which form the basis of the decision, but not to the final position which the authority intends to adopt (09/02/2017, T-16/16, *BECHER*, EU:T:2017:68, § 57) or to each well-known fact on which it relies in order to arrive at that position (01/06/2016, T-34/15, *CHEMPIOIL / CHAMPION et al.*, EU:T:2016:330, § 83) (§ 15).

29/04/2020, T-73/19; [wood splitting tools](#), EU:T:2020:157, § 15

Scope of the principle — Well-known fact

An infringement of the right to be heard cannot be invoked with respect to well-known facts (§ 74). The right to be heard is not infringed where the concerned party is not invited by the BoA to put forward its arguments on observations that do not bring any new argument and are limited only to answering the notice of appeal (§ 78). Neither is it infringed if the observations do not form the basis of the decision, but are merely of an illustrative nature (§ 84). The BoA's conclusion could stand on the basis of practical experience alone, without requiring the supporting evidence on which the EUTM proprietor claims it was not heard (§ 85).

29/03/2019, T-611/17, [REPRESENTATION D'UNE SEMELLE DE CHAUSSURE \(3D\)](#), EU:T:2019:210, § 74, 78, 84-85

Scope of the principle — Well-known fact

The right to be heard is not infringed if the contested decision is based on information and on the content of a website (i.e. an online dictionary) that had not been communicated to the party other than in the form of an internet link, where the content of the website corresponds precisely to the definitions given by the examiner and the meaning of the terms constitutes a well-known fact (§ 17-18). Since the web pages were still accessible and their content had not changed in relation to the content cited by the examiner, the issue of not being able to access the content, or changes to it (07/02/2007, T-317/05, *Guitar*, EU:T:2007:39) does not arise (§ 19-21).

23/05/2019, T-439/18, [ProAssist](#), EU:T:2019:359, § x

Scope of the principle — Well-known fact

The use by the BoA of dictionary definitions to clarify the meaning of the words composing the sign cannot be regarded as a reason on which the applicant should have had an opportunity to

present its comments, within the meaning of Article 94 CTMR [now Article 94 EUTMR], even though such definitions were not mentioned in the examiner's decision, (§ 29).

12/03/2019, T-463/18, [SMARTSURFACE](#), EU:T:2019:152, § 29

Infringement of the right to effectively submit observations before the BoA

An infringement of the right of defence entails the annulment of the contested decision if, in the absence of that procedural irregularity, it is shown that there was even a slight chance that the applicant would have been better able to defend himself (§ 48).

After annulment of the contested decision and referral of the case back to the BoA, the opponent was misled by the chairperson's invitation to comment on the consequences to be drawn from the GC judgments and, notably, by the indication that the communication was not an invitation to submit additional documents at that stage of the proceedings. The communication therefore had an influence on the content of the opponent's views and on the way in which he submitted them (§ 37). In the case of submission of additional evidence, the BoA would have had to exercise its discretion (§ 38). Therefore, the opponent's right to effectively submit his views before the BoA had been infringed (§ 35-37).

14/05/2019, T-89/18 and T-90/18, [Café del Sol / Café del Sol \(fig.\) et al.](#), EU:T:2019:331, § 35-38, 48

No infringement of the right to be heard — Functional continuity between the first instance and the BoA

According to Article 71(1) EUTMR, enshrining the principle of functional continuity, the BoA is under no obligation to remit the case to the OD for a decision on new factors (such as the limitation of the list of services covered by the earlier mark) liable to alter the outcome of the case (§ 34). Where the parties have had the possibility to submit their observations on the comparison of services and the limitation of the scope of protection of the earlier rights after the OD's decision, the right to be heard is not infringed (§ 35).

08/07/2020, T-659/19, [kix \(fig.\) / kik](#), EU:T:2020:328, § 35

Infringement of the right to be heard — BoA's statement on proof of genuine use for period not discussed by the parties — CD's error in calculating the relevant periods

There is no obligation for the CD to determine the relevant periods for the proof of genuine use (§ 33). If the BoA finds an error by the CD in calculating the relevant periods, it cannot base its decision on a lack of genuine use of the earlier marks for a period, which was never discussed by the parties and on which they had no opportunity to comment or to submit evidence at any stage of the proceedings before the Office (§ 39).

20/03/2019, T-138/17, [PRIMED / GRUPO PRIM \(fig\) et al.](#), EU:T:2019:174, § 33, 39

No infringement of the right to be heard — Procedure for suspension of the proceedings

The right to be heard is not infringed by not giving the party that requests a stay of the opposition proceedings the opportunity to reply to the observations on a request for suspension, since there is no provision that lays down this possibility (§ 55).

16/05/2019, T-354/18, [SKYFi / SKY et al.](#), EU:T:2019:33, § 55

No infringement of the right to be heard — Confidential information vis-à-vis third parties — Scope of the right to be heard

Article 88(4) CTMR, read in conjunction with Rule 88(c) CTMIR [now Article 114(4) EUTMR], concerns the non-disclosure of certain documents or items of business information considered to be confidential vis-à-vis third parties and not vis-à-vis parties to proceedings before the Office (§ 27-28).

The Office's decisions are to be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments, (Article 75 CTMR and Article 63(2) CTMR [now Article 94 EUTMR and Article 70(2) EUTMR]) (§ 33-34). The right to be heard is not infringed when the party is in a position to present its comments on all the matters of fact and of law that form the basis of the contested decision (§ 37-39).

05/03/2020, T-80/19, [DECOPAC](#), EU:T:2020:81, § 27-28, 37-39

Scope of the right to a 'fair hearing' enshrined in Article 6 ECHR — Right to be heard

The right to a 'fair hearing', enshrined in Article 6 ECHR, does not apply to proceedings before the BoA since these are administrative and not judicial in nature (11/07/2013, T-197/12, Metro, EU:T:2013:375, § 54) (§ 24).

28/05/2020, T-564/19, [Libertador](#), EU:T:2020:228, § 24

Infringement of rights of defence — Impact on contested decision

A violation of the rights of defence (right to be heard) does not require showing that the decision would have been different. It is sufficient to prove that such a possibility cannot be ruled out (§ 28).

20/03/2019, T-138/17, [PRIMED / GRUPO PRIM \(fig\) et al.](#), EU:T:2019:174, § 28

3.4.2 Duty to state reasons

Principle — Article 94(1) EUTMR

The obligation to state reasons according to Article 94(1) EUTMR has the same scope as that which derives from Article 296 TFEU. It is settled case-law that the statement of reasons required by Article 296 TFEU must disclose, in a clear and unequivocal manner, the reasoning followed by the institution that adopted the measure in question in such a way as to enable the persons concerned to ascertain the reasons for the measure and to enable the court having jurisdiction to exercise its power of review (§ 25).

13/06/2019, T-75/18, [MANUFACTURE PRIM 1949 \(fig.\)](#), EU:T:2019:413, § 25

3.4.2.1 Scope of the duty to state reasons

Scope of the duty to state reasons — Facts and legal considerations of decisive importance

The purpose of the obligation to state reasons is twofold: to enable the parties concerned to ascertain the reasons for the measure in order to defend their rights, and to enable the competent European court to exercise its power of review of the legality of the decision. However, in stating the reasons for their decisions, the BoA are not obliged to take a view on every argument that the

parties have submitted to them. It is sufficient that they set out the facts and legal considerations having a decisive importance in the context of the decision (§ 41).

11/09/2019, T-649/18, [transparent pairing](#), EU:T:2019:585, § 41

Scope of the duty to state reasons — No obligation to provide concrete examples — Well-known fact

It is not the BoA's responsibility to provide concrete examples of the generally acquired practical experience of the marketing of products on which it based its assessment (§ 21).

28/03/2019, T-829/17, [RAPPRESENTAZIONE DI UNA FORMA CIRCOLARE, FORMATA DA DUE LINEE OBLIQUE SPECULARI E LEGGERMENTE INCLINATE DI COLORE ROSSO \(fig.\)](#), EU:T:2019:199, § 21

Scope of the duty to state reasons — Decisions implying a broad discretion — Failure to state reasons regarding the suspension of the proceedings

Respect for the right of the persons concerned to have adequate reasons provided for a decision that affects them is particularly important where that decision stems from a broad discretion, as is the case when the BoA has to decide on the possible suspension of the proceedings before it (§ 73).

28/05/2020, T-84/19 & T-88/19 to T-98/19, [We IntelliGence the World \(fig.\) / DEVICE OF TWO OVERLAPPING CIRCLES \(fig.\) et al.](#), EU:T:2020:231, § 67, 72-73, 75-76

3.4.2.2 Ex officio examination

Matter of public policy — Ex officio examination

Failure to state reasons in the contested decision is a public policy issue that can be examined *ex officio* (§ 20)

17/01/2019, T-368/18, [ETI Bumbo / BIMBO \(fig.\)](#), EU:T:2019:15, § 20

08/05/2019, T-269/18, [ZARA / ZARA \(fig.\) et al.](#), EU:T:2019:306, § 37, 47-51, 55

Matter of public policy — Ex officio examination

Compliance with the duty to state reasons is a matter of public policy that must be raised, if necessary, of the Court's own motion (§ 93).

12/07/2019, T-792/17, [MANDO \(fig.\) / MAN et al.](#), EU:T:2019:533, § 93

3.4.2.3 General reasoning for goods and services

General reasoning — Sufficiently homogeneous category or group of goods or services

In examining absolute grounds for refusal, the competent authority may use only general reasoning for all the goods or services concerned when the same ground for refusal is given for a category or group of goods and services, provided that these are interlinked in a sufficiently

direct and specific way that they form a sufficiently homogeneous category or group of goods or services (§ 48-49).

11/04/2019, T-223/17, [ADAPTA POWDER COATINGS \(fig.\)](#), EU:T:2019:245, § 48-49

17/01/2019, T-91/18, [DIAMOND CARD \(fig.\)](#), EU:T:2019:17, § 18-21

20/09/2019, T-650/18, [Reaktor](#), EU:T:2019:635, § 40-50

General reasoning for goods and services — Perception of the relevant public

For the examination of the homogeneity of the goods and services, the specificity of the mark applied for or, in particular, of its perception by the relevant public must be taken into account (§ 44) (17/05/2017, C-437/15 P, *deluxe (fig.)*, EU:C:2017:380, § 32, 44).

04/04/2019, T-804/17, [DARSTELLUNG VON ZWEI SICH GEGENÜBERLIEGENDEN BÖGEN \(fig.\)](#), EU:T:2019:218, § 32, 44

General reasoning for goods and services — Laudatory marks

If the EUTM application is a slogan and covers several goods and services, global reasoning could be considered sufficient. In such cases, all the goods/services belong to a sufficiently homogenous category, linked by the fact that they can offer benefits, since the sign is perceived as an advertising promise (§ 61-62).

10/10/2019, T-832/17, [achtung! \(fig.\)](#), EU:T:2019:2, § 61-62

General reasoning for goods and services — Slogans

In view of the meaning of the mark applied for, the BoA was entitled to find that the services were in a homogeneous category and an overall reasoning was justified (§ 48). When the BoA explained that, for all the services for which protection was sought, the trade mark application would be perceived by the relevant public as a 'motivational slogan [involving] the consumer in the innovation actions [of the trade mark proprietor]', it adequately explained how it had defined the homogeneous category on which it based its assessment of the distinctive character of the trade mark applied for (§ 49).

13/02/2020, T-8/19, [Inventemos el futuro](#), EU:T:2020:66, § 48-49

3.4.2.4 Principles of legality, equal treatment and sound administration

Principle of legality — Principles of equal treatment and sound administration — Obligation to provide express reasons for departing from previous decisions

The BoA has to provide explicit reasoning when it decides to take a different view from previous decisions. However, the legality of the decisions must be assessed solely on the basis of the EUTMR. The BoA gave express reasons for departing from the previous decisions (§ 53-55).

31/01/2019, T-97/18, [STREAMS](#), EU:T:2019:43, § 53-55

22/05/2019, T-161/16, [CMS Italy \(fig.\) / PUMA \(fig.\) et al.](#), EU:T:2019:350, § 30-31, 35, 44, 46, 50.

No obligation of express reasons for departing from previous decisions not relied on by a party

The BoA does not have to explicitly set out the reasons why it intends to depart from previous decisions that were not relied on by a party before it. Moreover, the duty to state reasons in

respect of previous apparently diverging decisions is 'less stringent where the examination depends exclusively on the mark applied for than on factual findings which are independent of this mark' (§ 36-38, 48).

05/09/2019, T-753/18, [#BESTDEAL \(fig.\)](#), EU:T:2019:560, § 36-38, 48

Decisions of first instance

The BoA is not bound by the Office's first instance decisions (§ 96). The legality of the BoA's decisions must be assessed solely on the basis of the EUTM Regulation, as interpreted by the EU courts (§ 97-109).

19/09/2019, T-679/18, [SHOWROOM \(fig.\) / SHOWROOM 86 \(fig.\)](#), EU:T:2019:631, § 96-109

Decisions of national authorities — Identical marks

The Office is not required to take into account decisions of national authorities concerning marks identical to those on which it has to give a decision. If it does take them into account, it is not bound by those decisions (§ 83-84).

24/01/2019, T-785/17, [BIG SAM SPORTSWEAR COMPANY \(fig.\) / SAM et al.](#), EU:T:2019:29, § 83-84
19/12/2019, T-624/18, [GRES ARAGÓN \(fig.\)](#), EU:T:2019:868, § 28-29.

3.4.2.5 Lack of reasoning

Lack of reasoning — Geographical name

The Office is obliged to demonstrate that the geographical name is known to the relevant public as the designation of a place and that the name in question currently suggests to that public a link with the goods or services in question, or that it is reasonable to assume that such a name may, for that public, designate the geographical origin of the goods or services mentioned (15/01/2015, T-197/13, MONACO, EU:T:2015:16, § 51 and the Office's Guidelines, Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 4, Descriptive trade marks (Article 7(1)(c) EUTMR), paragraph 2.6, Geographical terms) (§ 42, 43).

19/12/2019, T-624/18, [GRES ARAGÓN \(fig.\)](#), EU:T:2019:868, § 42-43

Lack of reasoning — Mere quotation of case-law

The mere quotation of case-law does not meet the requirements of the obligation to state reasons within the meaning of Article 75(1) CTMR [now Article 94(1) EUTMR] (§ 31).

20/03/2019, T-762/17, [DARSTELLUNG EINER GEOMETRISCHEN FIGUR \(fig.\)](#), EU:T:2019:171, § 31

Lack of reasoning — Previous decisions — Lack of explicit statement of reasoning for departing

Where the Office decides to take a different view from the one adopted in previous decisions, it should provide an explicit statement of reasoning for departing from those decisions (§ 54, 55, 58).

27/06/2019, T-334/18, [ANA DE ALTUN \(fig.\) / ANNA \(fig.\) et al.](#), EU:T:2019:451, § 54, 55, 58

Lack of reasoning — Previous decisions — Lack of explicit statement of reasoning for departing

Where an opposition is based on Article 8(5) CTMR [now Article 8(5) EUTMR], the opponent is free, in principle, to choose the form of evidence it considers useful to submit to the Office, pursuant to Rule 19(2)(c) CTMIR [now Article 7(2)(f) EUTMDR]. Thus, the opponent is free to rely, as evidence of the reputation of the earlier mark relied upon, on one or several previous decisions of the Office finding that that mark enjoys a reputation. The Office is required to take into account those decisions when they are identified in a precise manner in the notice of opposition (28/06/2018, C-564/16 P, DEVICE OF A JUMPING ANIMAL (FIG. MARK) / PUMA (FIG. MARK) et al., EU:C:2018:509, § 69) and to consider whether or not it should decide in the same way and, if not, to provide an explicit statement of its reasoning for departing from those decisions, stating why they are no longer relevant (§ 30-31, 35, 44, 46, 50).

22/05/2019, T-161/16, [CMS Italy \(fig.\) / PUMA \(fig.\) et al.](#), EU:T:2019:350, § 30-31, 35, 44, 46, 50.

Lack of reasoning — Proof of use in a form different from the one registered

A finding of an alteration of the distinctive character of the mark as registered requires an assessment of the distinctive and dominant character of the elements added, based on the intrinsic qualities of each of those elements and their relative position within the arrangement of the trade mark (§ 47). The finding in the contested decision that the verbal element 'ZARA' is distinctive and is included identically in 'the earlier trade marks' does not provide clear and sufficient indications about the existence or not of use of the earlier trade marks in a form differing in elements which do not alter their distinctive character (§ 48, 51). The BoA's analysis and the conclusion reached in respect of a possible alteration of the distinctive character of the earlier marks are equivocal and imprecise and do not enable the GC to review the legality of the contested decision.

08/05/2019, T-269/18, [ZARA / ZARA \(fig.\) et al.](#), EU:T:2019:306, § 47, 48, 51

Lack of reasoning — General reasoning — Sufficiently homogeneous category of goods and services

The BoA disregarded its obligation to state reasons by failing to establish whether the goods and services represent a sufficiently homogeneous category which could be subject to general reasoning. Moreover, it committed an error of assessment in considering that there is a sufficiently direct and specific link between the sign and goods and services such as *computers, namely laptops, personal computers, satellite computers*, and software relating to *3D printing and space technology* in Class 9 and *arranging and conducting competitions in the field of computer coding* in Class 41 (§ 40-50)

20/09/2019, T-650/18, [Reaktor](#), EU:T:2019:635, § 40-50

3.4.3 Ultra petita

[No key points available yet.]

3.4.4 Other

Implementation of GC's Judgment — Res judicata

The obligation to state reasons is an essential procedural requirement that must be distinguished from the question of the merits of those reasons, which concern the substantive legality of the contested measure (§ 48). Where the GC rules only that the BoA had, to the requisite legal standard, stated the reasons forming the basis of the contested decision (in this case, with regard to only some of the contested goods), but did not examine the parties' arguments and did not rule on the substantive legality of the contested decision, the force of res judicata concerns only the statement of reasons as an essential procedural requirement and not its substantive legality (§ 51).

The force of res judicata extends only to the grounds of a judgment that constitute the necessary support of its operative part and are therefore inseparable from it (25/07/2018, C-84/17 P, C-85/17 P and C-95/17 P, SHAPE OF A 4-FINGER CHOCOLATE BAR (3D), EU:C:2018:596, § 52) (§ 52).

19/12/2019, T-690/18, [Vita](#), EU:T:2019:894, § 48, 51-52

Corrigendum of decisions — Article 102(1) EUTMR — Errors and manifest oversights

The substitution of the list of goods covered by the earlier marks cannot be classified as a linguistic error nor an error of transcription, and it does not correspond to a manifest oversight that can justify the adoption of a corrigendum in accordance with Article 102(1) EUTMR (§ 38-39).

24/10/2019, T-708/18, [Flis Happy Moreno choco \(fig.\) / MORENO \(fig.\) et al.](#), EU:T:2019:762, § 38-39

24/10/2019, T-498/18, [Happy Moreno choco \(fig.\) / MORENO \(fig.\) et al.](#), EU:T:2019:763, § 38-39

Corrigendum of decisions — Article 102(1) EUTMR — Errors and manifest oversights

Where a paragraph amounts to an erroneous restatement of what the BoA allegedly noted in an earlier passage of the contested decision and thus is the result of a manifest oversight (§ 34-38), it can be corrected according to Article 102 EUTMR (§ 39).

28/05/2020, T-724/18 & T-184/19, [AUREA BIOLABS \(fig.\) / Aurea et al.](#), EU:T:2020:227, § 39

Revocation of decisions — Article 80(1) CTMR [now Article 103 EUTMR] — Obvious procedural error

Any infringement of the obligation to state reasons, such as a failure to state reasons or an inadequate statement of reasons, constitutes a procedural error for the purposes of Article 80(1) CTMR [now Article 103 EUTMR], which should lead to the revocation by the Office of the decision vitiated by it where that error is obvious (§ 34).

31/10/2019, C-281/18 P, [REPOWER](#), EU:C:2019:916, § 34

Guidelines — Internet searches

The Office's examination guidelines, although they lack binding force, are not only a reference source on the Office's practice in respect of trade marks, they are also a consolidated set of rules setting out the line of conduct which the Office itself proposes to adopt. Provided that these rules are consistent with the legal provisions of higher authority, they constitute a self-imposed restriction on the Office, namely that of compliance with the rules which it has itself laid down.

However, the Office did not breach these guidelines when consulting electronic sources to determine the meaning of the word 'PANORAMICZNYCH'. It is clear from the text of the examination guidelines, in its version of 1 February 2014, that the possibility of using internet sources to define the meaning of a mark was not limited to new terms. In the 1 October 2017 version, moreover, it states that 'an internet search also constitutes a valid means to prove a descriptive meaning, especially where new terms, technical jargon or slang expressions are concerned' (§ 47-49).

26/06/2019, T-117/18 to T-121/18, [200 PANORAMICZNYCH](#), EU:T:2019:447, § 47-49

Translation errors

The question whether the BoA correctly translated the word 'pack' from English into German is irrelevant. Since German only was the language of proceedings at the Office, the conclusions as to how the relevant English-speaking public understands that word are not influenced by the accuracy of its translation into German, as long as those conclusions are objectively correct (09/03/2015, T-377/13, *ultra.air ultrafilter*, EU:T:2015:149, § 20) (§ 26).

04/07/2019, T-662/18, [Twistpac](#), EU:T:2019:483, § 26

Procedural irregularity — Decisive influence on the outcome of the proceedings

A procedural irregularity entails the annulment of a decision in whole or in part only if it is shown that, had it not been for the irregularity, the contested decision might have been substantively different. Where the examiner or the BoA does not consider with particular attention whether or not to decide in the same way as in a previous registration decision for a similar mark for the same goods, as required by the principles of equal treatment and sound administration (10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 75), there could be a failure to comply with such principles. However, in the present case, the decision would not have been substantively different, so there is no such influence on the outcome of the decision (§ 110-121).

26/06/2019, T-117/18 to T-121/18, [200 PANORAMICZNYCH](#), EU:T:2019:447, § 110-121

Procedural irregularity — Decisive influence on the outcome of the proceedings

A procedural irregularity can vitiate the administrative procedure only if it is shown that, had it not been for that irregularity, the outcome of the procedure might have been different (§ 33).

11/04/2019, T-223/17, [ADAPTA POWDER COATINGS \(fig.\)](#), EU:T:2019:245, § 33

3.5 ASSESSMENT OF EVIDENCE

3.5.1 Evidence found by the BoA on its own motion — Article 95(1) EUTMR

Absolute grounds of refusal — Internet researches

Having the same competences as the examiner, the BoA can rely, after hearing the party, on the existence of facts found through internet searches conducted after the filing date (§ 30-31). However, keeping in mind that the relevant date for the assessment of an absolute ground for refusal is the date on which the application for registration was filed, the GC takes into consideration only those documents that contain a date earlier than the filing date (§ 34-35).

13/02/2019, T-278/18, [DENTALDISK](#), EU:T:2019:86, § 34-35

Absolute grounds of refusal — Internet research

Since the orthographic deviation is negligible, BoA did not err in conducting internet research on the correctly spelled sign 'dental disc', and was entitled to demonstrate by means of internet extracts that the expression 'dental disc' was descriptive (§ 51, 69). Descriptive use of the sign by only one operator already constitutes corroborating evidence of the descriptive nature of the sign (§ 70).

13/02/2019, T-278/18, [DENTALDISK](#), EU:T:2019:86, § 51, 69, 70

Opposition proceedings — No obligation to examine the earlier marks in a specific order

Neither Article 95, Article 67 nor Article 71(1) EUTMR require the Office to examine the earlier marks on which the opposition is based in the order chosen by the party that filed the opposition (§ 33).

16/05/2019, T-354/18, [SKYFi/SKY et al.](#), EU:T:2019:33, § 33

Opposition proceedings — Bad faith is not analysed in opposition proceedings

In opposition proceedings, the Office cannot examine whether the earlier mark has been registered in bad faith pursuant to Article 59(1)(b) EUTMR, even if the EUTM applicant claims that the earlier marks may have merely been identical re-filings in bad faith of marks previously filed (§ 46-48).

16/05/2019, T-354/18, [SKYFi/SKY et al.](#), EU:T:2019:33, § 46-48

Invalidity proceedings — Absolute grounds for refusal — Presumption of validity of the registered trade mark

The BoA is not required to carry out of its own motion the examination of the absolute grounds for refusal which the examiner conducted. The EUTM is regarded as valid until it has been declared invalid following invalidity proceedings. Therefore, it is up to the applicant for a declaration of invalidity to produce the 'specific facts' capable of supporting its claim that the contested trade mark was devoid of any distinctive character at the relevant date (§ 26, 33, 35).

The mere existence of images on the internet does not demonstrate that golden bottles are widespread on the market (§ 33). The submitted evidence was not sufficient to support the claims as to the lack of distinctive character of the contested trade mark. The BoA is limited to considering the submitted evidence and cannot decide on the distinctive character of the trade mark as a whole on its own motion, since the registered trade mark enjoys the presumption of validity (§ 35).

08/05/2019, T-324/18, [BOTTIGLIA DORATA \(3D\)](#), EU:T:2019:297, § 26, 33, 35

Invalidity proceedings — Absolute grounds for refusal — Well-known facts

The presumption of validity of the EUTM cannot prevent the Office from relying on well-known facts observed by the Office in the invalidity proceedings (§ 46); neither can the rules on burden of proof (§ 134). The BoA inferred its conclusions from its internet searches. As the results obtained required a low degree of technical investigation, they may be regarded as capable of

being well-known facts (§ 50, 53). The Office is not required to establish the accuracy of its internet searches (§ 55)

29/03/2019, T-611/17, [REPRESENTATION D'UNE SEMELLE DE CHAUSSURE \(3D\)](#), EU:T:2019:210, § 46, 50, 53, 55, 134

Invalidity proceedings — Absolute grounds for refusal — Well-known facts — Burden of proof

The fact that the BoA took into account a well-known fact when finding that the mark at issue lacked inherent distinctive character in the context of invalidity proceedings is not contrary to the rules on the burden of proof (21/04/2015, T-360/12, Device of a chequerboard Pattern (grey), EU:T:2015:214, § 64-65) (§ 29).

10/06/2020, T-105/19, [DEVICE OF A CHEQUEROARD PATTERN \(fig.\)](#), EU:T:2020:258, § 29

3.5.2 Discretionary power and belated evidence — Article 95(2) EUTMR

Proof of use — Discretionary power

The BoA is not prohibited from taking account of additional evidence which is submitted after the expiry of the period that it has initially set, due to its discretionary power, Article 76(2) CTMR [now Article 95(2) EUTMR] (§ 52, 55). When genuine use must be established with regard to two relevant periods (the five-year period before the cancellation application and the five-year period before the publication of the application of the contested EUTMR), the evidence relating to one of the relevant periods, even if it is submitted late, is, in addition to the initial evidence forwarded within the time limits, relating to the other relevant period (§ 56) and does not constitute new evidence (§ 57, 59).

20/03/2019, T-138/17, [PRIMED / GRUPO PRIM \(fig\) et al.](#), EU:T:2019:174, § 56-57, 59

Reputation of the earlier marks recognised in previous decisions — Additional evidence

Where an opposition is based on Article 8(5) CTMR [now Article 8(5) EUTMR], the opponent is free, in principle, to choose the form of evidence it considers useful to submit to the Office, pursuant to Rule 19(2)(c) CTMIR [now Article 7(2)(f) EUTMDR]. Thus, the opponent is free to rely, as evidence of the reputation of the earlier mark relied upon, on one or several previous decisions of the Office finding that that mark enjoys a reputation. The Office is required to take into account those decisions, when they are identified in a precise manner in the notice of opposition (28/06/2018, C-564/16 P, DEVICE OF A JUMPING ANIMAL (fig.) / PUMA (fig.) et al., EU:C:2018:509, § 69) and to consider whether or not it should decide in the same way and, if not, to provide an explicit statement of its reasoning for departing from those decisions, stating why they are no longer relevant (§ 30-31, 35, 44, 46, 50). When, under such circumstances, additional evidence is filed with the statement setting out the grounds of appeal, it cannot be excluded as inadmissible as new evidence submitted out of time (§ 51, 62).

22/05/2019, T-161/16, [CMS Italy \(fig.\) / PUMA \(fig.\) et al.](#), EU:T:2019:350, § 30-31, 35, 44, 46, 50, 51, 62

Invalidity proceedings — Absolute grounds for refusal — Discretionary power

Evidence submitted in due time for the first time before the BoA in invalidity proceedings, that is either evidence supplementary to that submitted in the proceedings before the CD or evidence on a new matter that could not be raised during those proceedings, is not automatically admissible. It is for the party presenting that evidence to justify why that evidence has been

submitted at that stage of the proceedings and demonstrate that submission during the proceedings before the CD was impossible. Accordingly, it is for the BoA to assess the merits of the reasons put forward by the party that has submitted that evidence in order to exercise its discretion as to whether or not it should be taken into account (§ 44).

The BoA has discretion to disregard facts or evidence pursuant to Article 76(2) CTMR [now Article 95(2) EUTMR] when they have been produced late (§ 46). The BoA erroneously found that it followed from the judgment of the CJ on appeal and the annulment judgment of the GC that it was required to take the evidence into account. Therefore, the BoA infringed Article 65(6) CTMR [now Article 72(6) EUTMR] and failed to comply with its obligation to exercise its discretion according to Article 76(2) CTMR [now Article 95(2) EUTMR] and its obligation to state the reasons on which its decision on the taking into account of that evidence was based (§ 46-48).

10/10/2019, T-536/18, [FITNESS](#), EU:T:2019:737, § 44, 46-48

3.5.3 Distortion of facts in the BoA decision

[No key points available yet.]

3.6 PRINCIPLES OF UNION LAW

Preliminary ruling — Principles of legal certainty and the protection of legitimate expectations — Application *ratione temporis*

The substantive rules of EU law must be interpreted as applying to situations existing before their entry into force only insofar as it clearly follows from their terms, objective or general scheme that such effect must be given to them (§ 30).

14/03/2019, C-21/18, [Textilis](#), EU:C:2019:199, § 30

Application *ratione temporis* — Procedural rules — Substantive rules — Distinction

According to settled case-law, procedural rules are generally held to apply from the date on which they enter into force, as opposed to substantive rules, which are usually interpreted as applying to situations existing before their entry into force only insofar as it follows clearly from their terms, their objectives or their general scheme that such effect must be given to them (§ 18-24).

06/06/2019, T-220/18, [Battistino \(fig.\) / BATTISTA et al.](#), EU:T:2019:383, § 18-24

Application *ratione temporis* of substantive rules

The absolute grounds for refusal to register a trade mark or to declare the invalidity of a previously registered trade mark must be applied in accordance with the valid version of the Regulation at the date of the filing of the application for registration (§ 16-18).

08/05/2019, T-324/18, [BOTTIGLIA DORATA \(3D\)](#), EU:T:2019:297, § 16-18

Principle of legality — Principle of equal treatment — Principle of sound administration — References to other EUTMs / identical national marks

As to the Office's practice in similar cases, although the Office is required to exercise its powers in accordance with the general principles of EU law and must take into account the decisions already taken on similar applications, the application of those principles must be reconciled with

respect for the principle of legality (§ 39-43). Previous decisions at national level are irrelevant, since the EU trade mark regime is an autonomous system (§ 46).

05/02/2019, T-88/18, [ARMONIE](#), EU:T:2019:58, § 39-43, 46
10/10/2019, T-832/17, [achtung! \(fig.\)](#), EU:T:2019:2, § 67-69
26/03/2019, T-787/17, [GlamHair](#), EU:T:2019:192, § 52
04/04/2019, T-804/17, [DARSTELLUNG VON ZWEI SICH GEGENÜBERLIEGENDEN BÖGEN \(fig.\)](#), EU:T:2019:218, § 30
28/03/2019, T-829/17, [RAPPRESENTAZIONE DI UNA FORMA CIRCOLARE, FORMATA DA DUE LINEE OBLIQUE SPECULARI E LEGGERMENTE INCLINATE DI COLORE ROSSO \(fig.\)](#), EU:T:2019:199, § 85-87
14/02/2019, T-123/18, [DARSTELLUNG EINES HERZENS \(fig.\)](#), EU:T:2019:95, § 37
11/04/2019, T-226/17, [Rustproof System ADAPTA](#), EU:T:2019:246, § 59
08/05/2019, T-469/18, [HEATCOAT](#), EU:T:2019:302, § 46-53

Principle of equality of arms — Well-known facts

The BoA may raise well-known facts for the first time without infringing the principle of equality of arms (03/05/2018, T-463/17, RAISE, EU:T:2018:249, § 21, 30) (§ 50).

10/06/2020, T-105/19, [DEVICE OF A CHEQUERBOARD PATTERN \(fig.\)](#), EU:T:2020:258, § 50

Obligation of the Office, including the BoA, to adopt decisions within a reasonable time

The excessive length of the administrative procedure cannot be remedied by the annulment of the decision if it has no impact on the outcome of the dispute (§ 92).

29/03/2019, T-611/17, [REPRESENTATION D'UNE SEMELLE DE CHAUSSURE \(3D\)](#), EU:T:2019:210, § 92

No infringement of principle of effective judicial protection — Decision of suspension — Possibility of bringing an action against inappropriate length of the BoA proceedings

The [RCD] proprietor has the opportunity of relying on the possible unlawfulness of the BoA's decision to suspend the proceedings within an action before the GC, directed against the final decision of the BoA. If it considers, at the end of the proceedings before the BoA, that the Office has infringed its obligations with regard to the duration of the proceedings, it will be able to assert its rights by bringing an action that it deems appropriate for that purpose (15/03/2019, T-410/18, Silgan Closures and Silgan Holdings v Commission, EU:T:2019:166, § 27). Consequently, the inadmissibility of the present action does not result in a lack of effective judicial protection for the applicant (§ 27, 28).

15/07/2020, T-838/19 to T-842/19, [Fluid distribution equipment](#), EU:T:2020:343, § 27-28

3.7 COSTS

Rule 94 CTMIR [now Article 109 EUTMR]

The flat rate of EUR 1 000 for representation and cancellation proceedings can only be awarded to the winning party if this party has participated in the administrative proceedings (§ 60).

27/03/2019, T-265/18, [Formata \(fig.\) / Formata \(fig.\) et al.](#), EU:T:2019:197, § 60

4 PROCEEDINGS IN FIRST INSTANCE

4.1 ESSENTIAL PROCEDURAL REQUIREMENTS

4.1.1 Duty to state reasons

[No key points available yet.]

4.1.2 Right to be heard

[No key points available yet.]

4.2 EX PARTE PROCEEDINGS

4.2.1 Trade mark cases

[No key points available yet.]

4.2.1.1 Admissibility

[No key points available yet.]

4.2.1.2 Time limits, form, means of communication

[No key points available yet.]

4.2.1.3 Other procedural questions

- Repetitive filings and confirmatory decisions

Inadmissibility of an action introduced against a confirmatory decision

An action against a confirmatory decision is inadmissible as it merely confirms an earlier decision not challenged in due time. A decision is regarded as a mere confirmation of an earlier one if it contains no new factors compared with the earlier decision and if it was not preceded by any re-examination of the situation of the addressee of that earlier decision (§ 38-39). However, a decision cannot be regarded as 'confirmatory' of a decision adopted by the OD in the context of different opposition proceedings concerning the same parties and the same trade marks, in particular when it concerns the genuine use of the earlier mark or the conceptual comparison, which can vary depending on the relevant public and also over time (§ 40-42).

07/11/2019, T-380/18, [INTAS / INDAS \(fig.\) et al.](#), EU:T:2019:782, § 38-42

- Costs

[No key points available yet.]

4.2.2 Design cases

[No key points available yet.]

4.2.2.1 Admissibility

[No key points available yet.]

4.2.2.2 Time limits, form, means of communication

[No key points available yet.]

4.2.2.3 Other procedural questions

[No key points available yet.]

4.3 INTER PARTES PROCEEDINGS

4.3.1 Trade mark cases

4.3.1.1 Opposition proceedings

- Admissibility of an opposition, time limits and form, means of communication

Clear identification of the earlier mark

An earlier mark is to be identified clearly in the respective field of the opposition notice. Allegations made in other parts of the form, in particular not made in the language of proceedings, cannot be taken into account (§ 50-51).

13/02/2019, T-823/17, [Etnik / ETNIA](#), EU:T:2019:85, § 50-51

Entitlement to file an opposition — Article 46(1) EUTMR

When an opponent has not proved that it was entitled to file an opposition as an authorised licensee of the proprietor of an earlier trade mark, but it was the proprietor of another earlier mark on which the opposition was based, it can, in that capacity, file an opposition against the mark applied for (§ 25-27).

16/05/2019, T-354/18, [SKYFi / SKY et al.](#), EU:T:2019:33, § 25-27

- Substantiation of the earlier right/s

[No key points available yet.]

- Other procedural questions regarding opposition proceedings

Principles of *res judicata* and *ne bis in idem*

The principle of *res judicata* is not applicable to subsequent opposition decisions, given that these proceedings are administrative and not judicial. A fortiori, the grounds of an OD decision in different opposition proceedings do not have the force of *res judicata* and are not capable of creating acquired rights or legitimate expectations with regard to the parties concerned (§ 35).

The principle of *ne bis in idem* is applicable only to penalties. Therefore, it cannot be applied in the context of opposition proceedings (§ 37).

07/11/2019, T-380/18, [INTAS / INDAS \(fig.\) et al.](#), EU:T:2019:782, § 35, 37

4.3.1.2 Cancellation proceedings

- Invalidation proceedings

Substantiation of the earlier right in invalidity proceedings — Rule 19(2) CTMIR [now Article 7(2) EUTMDR]

The representation of the sign in black and white does not constitute reliable proof of the existence, validity and scope of the protection of the earlier mark when colours are claimed, as per Rule 19(2) CTMIR [now Article 7(2) EUTMDR], applicable by analogy for invalidity proceedings (§ 47-48). If a reproduction of the earlier mark in colour is not provided, the formal requirements related to the evidence of registration of the earlier mark as a substantial condition are not fulfilled (§ 49-53).

27/03/2019, T-265/18, [Formata \(fig.\) / Formata \(fig.\) et al.](#), EU:T:2019:197, § 47-53

- Revocation proceedings

[No key points available yet.]

- Burden of proof, acquiescence

[No key points available yet.]

- Other procedural questions regarding cancellation proceedings

- *Res judicata*

[No key points available yet.]

- *Other*

[No key points available yet.]

4.3.2 Design cases — Invalidation proceedings

4.3.2.1 Admissibility, time limits and form, means of communication

[No key points available yet.]

4.3.2.2 Other procedural questions regarding invalidity proceedings

[No key points available yet.]

CHAPTER II — ABSOLUTE GROUNDS FOR REFUSAL / INVALIDITY

1 ARTICLE 7(1)(a), ARTICLE 52(1)(a) EUTMR — EUTM DEFINITION

Preliminary ruling — Colour mark or figurative mark — Graphic representation of a mark submitted as a figurative mark — Insufficiently clear and precise graphic representation — Article 2 and Article 3(1)(b) Directive 2008/95/EC

When the trade mark application contains an inconsistency between the sign's representation in the form of a drawing and the classification given to the mark by the applicant, in such a way that it is impossible to determine exactly the subject matter and scope of the protection, the trade mark registration must be refused on account of the lack of clarity and precision of the application (§ 40, 45).



27/03/2019, C-578/17, [Oy Hartwall Ab](#), EU:C:2019:261, § 40, 45

Combination of two colours per se — No systematic arrangement associating the colours in a predetermined and uniform way

A sign may be registered as a mark only if the applicant provides a graphic representation in accordance with the requirements of Article 4 CTMR, to the effect that the subject matter and scope of the protection sought are clearly and precisely determined. Where the application is accompanied by a verbal description of the sign, it must be consistent with the graphic representation and must not give rise to doubts as to the subject matter and scope of that graphic representation (27/03/2019, C-578/17, *Oy Hartwall Ab*, EU:C:2019:261, § 39, 40) (§ 36-37).

A graphic representation of two or more colours, designated in the abstract and without contours, must be systematically arranged so that the colours concerned are associated in a predetermined and uniform way. The mere juxtaposition of two or more colours, without shape or contours, or a reference to two or more colours 'in every conceivable form', does not exhibit the qualities of precision and uniformity required by Article 4 CTMR (24/06/2004, C-49/02, *Blau/Gelb*, EU:C:2004:384, § 33-35). The GC was correct to find that the mere indication of the ratio of colours is insufficient. Regard can be made to the manner in which the mark is used, if registration was obtained under Article 7(3) EUTMR (§ 38, 47-48).



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29/07/2019, C-124/18P, [Blue and Silver \(COLOUR MARK\)](#), EU:C:2019:641, § 36-37, 38, 47-

2 ARTICLES 7(1)(b), 52(1)(a) EUTMR — DISTINCTIVE CHARACTER

2.1 WORD SIGNS

2.1.1 Titles of books

[No key points available yet.]

2.1.2 Single letters

[No key points available yet.]

2.1.3 Prefix or suffix

Non-distinctive — Prefix

According to existing case-law, use of the verbal element 'bio' as a prefix or suffix has acquired a highly suggestive connotation, which may be perceived in different ways according to the product offered for sale. However, in general, it refers to the idea of environmental protection, the use of natural materials or ecological manufacturing processes (§ 48). Where a sign provides the relevant public with information regarding the content of the goods, it does not indicate their commercial or industrial origin and cannot therefore be regarded as being distinctive (§ 77).

05/06/2019, T-229/18, [Biolatte](#), EU:T:2019:375, § 77

2.1.4 Abbreviations

Non-distinctive — Abbreviation

The word mark 'Fi Network' is devoid of distinctive character. The term 'network' lacks distinctive character and the term 'fi' is understood as abbreviation of 'fast infonet' which is a standard system of file compression and will be associated with goods and services such as electrical devices and telecommunications by the relevant public (§ 34, 35, 39).

11/07/2019, T-601/18, [Fi Network](#), EU:T:2019:510, § 34-35, 39

Non-distinctive — Term with an immediately comprehensible meaning

The term 'pro' (e.g. in the expression 'proassist') is immediately understood by the relevant public as meaning 'professional' in the context of specialised services (§ 41-42, 44-45).

23/05/2019, T-439/18, [ProAssist](#), EU:T:2019:359, § 41-42, 44-45

2.1.5 Slogans

Non-distinctive — Mark comprising advertising slogans

Concise formulations and the repetition of some of the words making up a trade mark, like the element 'more', are commonly used in advertising to make slogans stronger and cannot suffice to endow the mark with striking features and make it easier to memorise for the relevant public (§ 29).

03/04/2019, T-555/18, [See More. Reach More. Treat More.](#), EU:T:2019:213, § 28-29

Non-distinctive — Mark comprising advertising slogans

Although the CJ clarifies certain questions relating to the acceptability of slogans as trade marks, in the *Vorsprung durch Technik* judgment (21/01/2010, C-398/08 P, *Vorsprung durch Technik*, EU:C:2010:29), the case-law cannot and should not be read as suggesting that any promotional phrase can now be registered as a trade mark simply because it is presented in the form of an advertising slogan (§ 31-36).

Non-distinctive — Mark comprising advertising slogans

All marks made up of signs or indications that are also used as advertising slogans convey, by definition, to a greater or lesser extent, an objective message, even a simple one, and can still be capable of indicating to the consumer the commercial origin of the goods or services, in particular where those marks are not merely an ordinary advertising message, but possess a certain originality or resonance, requiring at least some interpretation or setting off a cognitive process. (21/01/2010, C-398/08 P, *Vorsprung durch Technik*, EU:C:2010:29, § 56-57; 25/05/2016, T-422/15 & T-423/15, *THE DINING EXPERIENCE* (fig.), EU:T:2016:314, § 48) (§ 27).

08/07/2020, T-696/19, [Moins de migraine pour vivre mieux](#), EU:T:2020:329, § 27

08/07/2020, T-697/19, [Weniger Migräne. Mehr vom Leben](#), EU:T:2020:330, § 27

Non-distinctive — Mark consisting of a single word — Slogan mark

Even a sign consisting of a single word which is clearly laudatory is capable of constituting a promotional formula that is unfit to identify the commercial origin of the products and services it designates (§ 24-27, 37).

08/07/2020, T-729/19, [Favorit](#), EU:T:2020:314, § 24-27, 37.

Non-distinctive — Mark comprising advertising slogans

13/05/2020, T-156/19, [We're on it](#), EU:T:2020:200

2.1.6 Laudatory marks

Non-distinctive — Mere laudatory message

The term 'Armonie', being the plural of the Italian word 'armonia', refers to the concepts of 'proportionate correspondence'/'adequate arrangement [of the elements] in a whole'. The Italian-speaking consumers could consider that the relevant products are primarily intended to create or organise a pleasant place/environment insofar as it is harmonious (§ 28). Furthermore, and taking into account the simplicity of the sign itself, it also has a laudative character in terms of advertising, being a mere promotional formula highlighting a positive quality of the products concerned (§ 29-30).

05/02/2019, T-88/18, [ARMONIE](#), EU:T:2019:58, § 29-30

Non-distinctive — Mere promotional message

The word mark **Premiere** is understood by the relevant public, at least in one of its possible meanings, as a reference to first-class quality or premium characteristics of the goods or services and therefore is understood as being a quality indication (§ 45). A trade mark consisting of an advertising slogan is to be regarded as non-distinctive if it is perceived by the relevant public only as a simple advertising statement (§ 44). It must therefore be examined whether the sign could also be understood, beyond this indication of quality, as an indication of the commercial origin of the goods or services in question, particularly because it is not confined to a common advertising message, but possesses a certain originality or resonance requiring at least some interpretation by the relevant public, or setting off a cognitive process in the minds of that public (§ 46).

The sign 'Premiere' does not contain any intrinsic characteristic such as to allow the assumption that the sign, beyond its indication of quality or advertising message, is perceived as an indication of commercial origin (§ 47).

19/06/2019, T-479/18, [Premiere](#), EU:T:2019:430, § 45-47

Non-distinctive — Mere promotional message

The verbal element, 'eurolamp', may provide information on the nature of the goods or their geographical origin, but they cannot serve as an indication of the commercial origin (§ 34). The verbal elements 'pioneers in new technology' contain no unusual element and have no originality capable of endowing the sign with distinctive character. The relevant public will perceive the expression as a mere promotional message (§ 37-39). The mark applied for, taken as a whole, is not greater than the sum of its parts (§ 40-41). Thus, the mark is devoid of distinctive character (§ 42).

14/05/2019, T-465/18, [EUROLAMP pioneers in new technology](#), EU:T:2019:327, § 34, 40-41, 42

Non-distinctive — Mere promotional and laudatory message

The fact that the word 'free' has a wide variety of possible meanings cannot call into question the validity of the meaning accepted by the BoA, since a word sign must be refused registration under Article 7(1)(b) EUTMR if at least one of its possible meanings designates a characteristic of the goods or services (25/04/2013, T-145/12, Eco Pro, EU:T:2013:220, § 34) (§ 30).

The mark applied for conveys a promotional message and has a laudatory meaning because it indicates to the consumer a positive characteristic, namely that the goods and services (related to slimming, weight control, diet, food, beverages, nutrition, dieting, exercise, health, fitness, recreation, lifestyle, eating habits and well-being) relate to, or are connected with, goods that are free or clear from undesirable or harmful constituents. In addition, the word 'free' is commonly used in trade as a generic laudatory term. It is therefore devoid of distinctive character (§ 20, 35, 45, 47, 48).

12/07/2019, T-113/18, [FREE](#), EU:T:2019:531, § 20, 30, 35, 45, 47, 48

12/07/2019, T-114/18, [FREE](#), EU:T:2019:530, § 20, 30, 35, 45, 47, 48

Non-distinctive — Mere promotional and laudatory message

The relevant public perceives the term 'moda' in relation to the goods (building materials for flooring and coverings) as a laudatory message of a promotional nature concerning a general characteristic of those goods rather than as an indication of their commercial origin. The sign is devoid of distinctive character (§ 37-40).

12/07/2019, T-264/18, [mo.da](#), EU:T:2019:528, § 37-40

Non-distinctive — Mere promotional and laudatory message — Non-negligible part of the public

The term 'xoxo' will be understood as meaning 'hugs and kisses'. This understanding is, in particular, shown by the online dictionaries *Urban dictionary* and *Internetslang* (§ 42). It is irrelevant that perhaps only teenagers and very young women will attribute that meaning to the sign 'XOXO', since it is sufficient that a ground of refusal exists in relation to a non-negligible part of the target public (§ 43). With regard to goods that are capable of being offered as gifts, the sign will be perceived as a promotional message conveying feelings of love and affection. The sign is thus devoid of distinctive character (§ 45-49).

13/05/2020, T-503/19, [Xoxo](#), EU:T:2020:183, § 45-49

Non-distinctive marks comprising a mere promotional or laudatory message

24/09/2019, T-749/18, [ROAD EFFICIENCY](#), EU:T:2019:688, § 16, 34

15/10/2019, T-434/18, [ULTRARANGE](#), EU:T:2019:746

20/03/2019, T-760/17, [TrioTherm+](#), EU:T:2019:175, § 36

12/12/2019, T-54/19, [BIANCOFINO](#), EU:T:2019:893, § 38-40, 47

11/09/2019, T-649/18, [transparent pairing](#), EU:T:2019:585, § 28

13/02/2020, T-8/19, [Inventemos el futuro](#), EU:T:2020:66, § 48-49

2.1.7 Assessment of the distinctive character

Preliminary ruling — Article 3(1)(b) Directive 2008/95/EC — Distinctive character — Criteria for assessment

Article 3(1)(b) Directive 2008/95/EC must be interpreted as meaning that, in examining the distinctive character of a sign, all the relevant facts and circumstances must be taken into account, including all the likely types of use of the mark applied for. The latter correspond, in the absence of other indications, to the types of use that, in the light of the customs in the economic sector concerned, can be practically significant (§ 34).

The examination of the distinguishing capacity of a sign cannot be limited to the ‘most likely’ use unless ‘solely one type of use is practically significant in the economic sector concerned’. This examination must take into account all practically significant conceivable uses of the sign in the economic sector concerned by the goods. Where a sign consists of a slogan that can be placed either on the front of T-shirts or on a label, the mark will be found to be distinctive if the consumers perceives it as a badge of origin according to at least one of the alternative types of placement of the sign (§ 25-30).

12/09/2019, C-541/18, [Deutsches Patent-und Markenamt](#), EU:C:2019:725, § 25-30, 34

Non-distinctive — Burden of proof

Since the applicant claims that the trade mark applied for is distinctive, it is for the applicant to provide specific and substantiated evidence that it has an intrinsic distinctive character, since it is much better placed to do so, given its thorough knowledge of the market (§ 46).

11/09/2019, T-649/18, [transparent pairing](#), EU:T:2019:585, § 46

Non-distinctive — ‘Family of marks’ concept not applicable within absolute grounds for refusal

The ‘family of marks’ concept does not apply to absolute grounds for refusal, but only to relative grounds for refusal. Therefore, the BoA had to assess whether the mark was distinctive in the light of its inherent characteristics without taking into consideration the other allegedly similar marks the applicant was the proprietor of (§ 53).

12/03/2019, T-463/18, [SMARTSURFACE](#), EU:T:2019:152, § 53

Non-distinctive

25/06/2020, T-379/19, [Serviceplan](#), EU:T:2020:284

2.2 SIMPLE FIGURATIVE SIGNS

2.2.1 Commonplace figurative elements

Non-distinctive — Public's level of attention

A mark must allow the relevant public to distinguish the products covered by that mark from those of other undertakings without paying particular attention, so the distinctiveness threshold necessary for the registration of a mark cannot depend on the public's level of attention (§ 17).



14/02/2019, T-123/18, [DARSTELLUNG EINES HERZENS \(fig.\)](#), EU:T:2019:95, § 17

Non-distinctive — Assessment of distinctive character

The mark must be assessed as it was filed, not as it is used. The applicant filed the mark applied for without adding a description to restrict the scope of protection to a logo or a label and without specifying where the mark might be positioned on its products. As a result, the mark is sought in respect of a scope of protection that covers all possible uses as a figurative mark, including as a pattern applied to the surface of the goods in question (§ 36).



03/12/2019, T-658/18, [DEVICE OF A CHECKERED GINGHAM PATTERN \(fig.\)](#), EU:T:2019:830, § 36

Non-distinctive — Expression with an immediately comprehensible meaning

The figurative mark 'Simply. Connected.' is not understood as two separate and independent words but as an expression with an immediately comprehensible meaning (§ 62). In view of the obvious meaning, the typographical features, such as the fact that the words stand above and below one another, and the presence of upper-case letters and a full stop, are not pertinent (§ 63). The global assessment confirms the dominant position of the verbal elements compared to the figurative elements that are devoid of distinctive character (§ 99-100).



28/03/2019, T-251/17 and T-252/17, [Simply. Connected. \(fig.\)](#), EU:T:2019:202, § 62-63, 99-100

Non-distinctive — Slogan

The mark applied for does not have any particular originality or significance and does not require a minimum interpretative effort or trigger any particular cognitive process on the part of the relevant public. Rather, it is merely an ordinary advertising slogan according to which the goods and services make people more intelligent.



08/05/2019, T-473/18, [getsmarter \(fig.\)](#), EU:T:2019:315, § 38

Non-distinctive — Laudatory mark

The laudatory message is reinforced by the drawing of the diamond (§ 23-39).



17/01/2019, T-91/18, [DIAMOND CARD \(fig.\)](#), EU:T:2019:17, § 23-39

Non-distinctive — Laudatory mark

The mark will be understood merely as a laudatory message, namely that the goods cater to the welfare and safety of animals (§ 19-23). The figurative element (a heart that will be interpreted by the public in light of the verbal elements) does not give any distinctive character to the mark applied for (§ 24-25).



24/01/2019, T-181/18, [TAKE CARE \(fig.\)](#), EU:T:2019:30, § 19-25

Non-distinctive laudatory marks



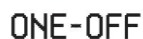
10/10/2019, T-832/17, [achtung! \(fig.\)](#), EU:T:2019:2



14/05/2019, T-466/18, [EUROLAMP pioneers in new technology \(fig.\)](#), EU:T:2019:326



09/04/2019, T-277/18, [PICK & WIN MULTISLOT \(fig.\)](#), EU:T:2019:230



10/06/2020, T-707/19, [ONE-OFF \(fig.\)](#), EU:T:2020:251

Non-distinctive — Sign of extreme simplicity — Basic geometric shapes

A sign of extreme simplicity, representing a basic geometric form or diverging from it only in a negligible way, does not permit the identification of the good or service for which registration is sought as originating from a specified undertaking. Such a sign, unless it has acquired distinctive character through use, is not capable of transmitting a message about the commercial origin that will be memorised by the relevant public, but will be perceived as exercising a purely ornamental or decorative function (§ 57-58). The fact that the mark applied for consists of part of a mark that is already registered is irrelevant (§ 64).



28/03/2019, T-829/17, [RAPPRESENTAZIONE DI UNA FORMA CIRCOLARE, FORMATA DA DUE LINEE OBLIQUE SPECULARI E LEGGERMENTE INCLINATE DI COLORE ROSSO \(fig.\)](#), EU:T:2019:199, § 57-58, 64

Non-distinctive — Sign of extreme simplicity

The mark is excessively simple. The fact that the sign does not represent a geometrical form is irrelevant (§ 23-25). No aspect of the sign may be easily and instantly remembered, even by the

most attentive relevant public, nor allow it to be immediately perceived as an indication of the commercial origin of the goods and services (§ 26-27). The trade mark applied for will be perceived exclusively as a decorative element (§ 28).


 04/04/2019, T-804/17, [DARSTELLUNG VON ZWEI SICH GEGENÜBERLIEGENDEN BÖGEN \(fig.\)](#), EU:T:2019:218, § 23-25, 28


Non-distinctive — Sign consisting solely of a colour representation of an octagonal polygon


The circumstance that a sign that does not represent a basic geometrical figure as such, does not suffice to support the view that it has the minimum distinctive character necessary to be registered as an EU trade mark (§ 28). A sign consisting solely of a colour representation of an octagonal polygon does not have any striking features that would be perceived immediately as an indication of the commercial origin of the goods by the relevant public (§ 29).

 06/06/2019, T-449/18, [ACHTECKIGES POLYGON \(fig.\)](#), EU:T:2019:386, § 28-29

Non-distinctive figurative signs

 05/09/2019, T-753/18, [#BESTDEAL \(fig.\)](#), EU:T:2019:560

 20/11/2019, T-101/19, [imot .bg \(fig.\)](#), EU:T:2019:793

 11/09/2019, T-34/19, [PRODUCED WITHOUT BOILING SCANDINAVIAN DELIGHTS ESTABLISHED 1834 FRUIT SPREAD \(fig.\)](#), EU:T:2019:576

 26/09/2019, T-663/18, [Soba JAPANESE FRIED NOODLES \(fig.\)](#), EU:T:2019:716

 07/11/2019, T-240/19, [DEVICE OF A BELL ICON \(fig.\)](#), EU:T:2019:779

2.2.2 Typographical symbols

[No key points available yet.]

2.2.3 Pictograms

[No key points available yet.]

2.3 SHAPE MARKS

Non-distinctive — Assessment of distinctive character

Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or verbal element. It could therefore prove more difficult to establish distinctive character in relation to a three-dimensional mark than in relation to a word or figurative mark (22/06/2006, C-25/05 P, Bonbonverpackung, EU:C:2006:422, § 27 and the case-law cited) (§ 31).

The more closely the shape resembles the shape most likely to be taken by the product, the greater the likelihood of the shape being devoid of any distinctive character. Only a mark that departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character (07/10/2004, C-136/02 P, Torches, EU:C:2004:592, § 31 and the case-law cited).

The originality of a shape must be evaluated in the light of the situation on the market, taking as the starting point the date of filing of a three-dimensional mark. The presence on the market of shapes which might be counterfeit copies is irrelevant (21/05/2014, T-553/12, BATEAUX MOUCHES, EU:T:2014:264, § 46).

Where, in a specific market with an international dimension, such as the electric guitar market, the prevailing cultural references are, nonetheless, universal values also recognised by EU consumers, evidence from North American publications, which contains references to musicians from the EU, allows the characteristics of the EU market to be evaluated (§ 46-50).



28/06/2019, T-340/18, [SHAPE OF A FLYING V GUITAR \(3D\)](#), EU:T:2019:455, § 31, 46-50

Distinctive character— Assessment of distinctive character — Norms or customs of the sector

A three-dimensional mark depicting the form of the good applied for can only be considered to be distinctive where that mark departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin (12/01/2006, C-173/04 P, Standbeutel, EU:C:2006:20, § 29, 31; 07/05/2015, C-445/13 P, Bottle, EU:C:2015:303, § 90-91) (§ 24-26).

There is no need to explicitly define the norms and customs of the sector of the goods concerned (C-445/13 P, Bottle, EU:C:2015:303, § 82-87) (§ 31).

Various factors, such as the aesthetic result and the aesthetic value, can be considered to justify the finding of a significant departure from the norms of the sector, as long as these factors relate to the finding of an 'objectively unusual visual effect of the design' of the shape (§ 32).



12/12/2019, C-783/18P, [FORM EINER FLASCHE \(3D\)](#), EU:C:2019:1073, § 24-26, 31-32

Non-distinctive — Assessment of distinctive character — Norms or customs of the sector

The shape of a bottle that is customary in the wine sector (shape of the traditional 'Bocksbeutel' bottle) (§ 40, 43-44) is also not distinctive in respect of beverages other than wines pertaining to

adjacent markets, such as beers and mineral water, since these goods have a similar nature and target the same consumers (§ 20-22, 50, 53-54). The mark is devoid of distinctive character for *bottles*, regardless of whether they are filled with content or empty (§ 20-22, 56-58).



58

24/09/2019, T-68/18, [FORM EINER FLASCHE \(3D\)](#), EU:T:2019:677, § 20-22, 40, 43-44, 50, 56-

Non-distinctive — Assessment of distinctive character — Norms or customs of the sector

In its analysis of whether the mark departed from the norms or customs of the sector, the BoA was right to take into consideration the alcoholic beverages sector in general, rather than just the sector dedicated to rum (§ 37). Depending on the nature of the product, it may be necessary to consider a broader sector (§ 38). The analysis should not be limited to the sector dedicated to rum, since it cannot be excluded that rum consumers' perception of the mark might be influenced by the marketing methods developed for other drinks of the same kind and intended for the same consumers, including *alcoholic drinks* (§ 41).

13/05/2020, T-172/19, [FORME D'UN TRESSAGE SUR UNE BOUTEILLE \(3D\)](#), EU:T:2020:202, § 41

Non-distinctive

Where a three-dimensional mark is constituted by the shape of the product, the mere fact that that shape is a 'variant' of a common shape of that type of product is not sufficient to establish that the mark has distinctive character for the purposes of Article 7(1)(b) EUTMR. It must always be determined whether such a mark permits the average consumer of that product, who is reasonably well informed and reasonably observant and circumspect, to distinguish the product concerned from those of other undertakings without conducting an analytical examination and without paying particular attention (§ 24-26).



19/06/2019, T-213/18, [SHAPE OF FAUCET/TAP FOR PREPARING AND DISPENSING BEVERAGES \(3D\)](#), EU:T:2019:435, § 24-26

Non-distinctive

The case-law relating to three-dimensional marks consisting of the appearance of the product designated is also applicable to the cases where the mark (the shape of a sole) constitutes only part of those goods (§ 111-112). The figurative patterns in the mark do not significantly differ from those generally present on soles, that always involve more or less complex geometric patterns (§ 118-119).



29/03/2019, T-611/17, [REPRESENTATION D'UNE SEMELLE DE CHAUSSURE \(3D\)](#), EU:T:2019:210, § 111-112, 118-119

Non-distinctive

The mere possibility that a trade mark constitutes the whole or a part of the shape of the goods for which protection is claimed is sufficient to apply to figurative marks the case-law relating to signs which are indissociable from the appearance of the goods (§ 45).



05/02/2020, T-331/19, [REPRÉSENTATION D'UNE TÊTE DE LION EN CERCLÉE PAR DES ANNEAUX FORMANT UNE CHAÎNE \(fig.\)](#), EU:T:2020:33, § 45



05/02/2020, T-332/19, [REPRÉSENTATION D'UNE TÊTE DE LION EN CERCLÉE PAR DES ANNEAUX FORMANT UNE CHAÎNE \(fig.\)](#), EU:T:2020:33, § 45

Non-distinctive

It is sufficient that a ground for refusal exists in relation to a non-negligible part of the target public (11/07/2019, T-601/18, Fi Network, EU:T:2019:510, § 26) (§ 16).

In order to determine whether the shape of the contested sign is significantly different from the norms or customs of the sector, it is not required to prove that an identical or almost identical shape already exists on the market. However, it must be checked whether, in the industry in question, a large variety of shapes is present, and whether the mark will be considered only as a variant of those shapes (28/06/2019, T-340/18, SHAPE OF A FLYING V GUITAR (3D), EU:T:2019:455, § 35, 36) (§ 21).

If a shape is very simple, the relevant public will perceive it as a mere variant of the available shapes on the market, and not as originating from a particular manufacturer (§ 22).

Where a market is characterised by a wide variety of forms, the existing shapes on the market are a well-known fact (§ 29).

Novelty or originality are not relevant criteria when assessing the distinctive character of a mark (§ 33).



26/03/2020, T-570/19, [FORM EINES KÄSESTRANGS \(3D\) III](#), EU:T:2020:127, § 16, 21, 22, 29, 33



26/03/2020, T-571/19, [FORM EINES KÄSESTRANGS \(3D\)](#), EU:T:2020:128, § 16, 21, 22, 29, 33



26/03/2020, T-572/19, [FORM EINES KÄSESTRANGS \(3D\) II](#), EU:T:2020:129, § 16, 21, 22, 29,

33

Non-distinctive

The protection of a design right concerns the appearance of a product that differs from existing designs, and is based on the novelty of that design, namely that no identical design has been publicly disclosed, and on its individual character. By contrast, in the case of a trade mark, while the shape of the mark must necessarily be significantly different from the norm or from the customs of the sector concerned in order for it to have distinctive character, the mere novelty of that shape is not a sufficient ground for finding that distinctive character exists, since the decisive criterion is the ability of that shape to fulfil the function of indicating commercial origin (§ 64).



05/02/2020, T-573/18, [FORM EINES SCHNÜRSENKELS \(3D\)](#), EU: T:2020:32, (§ 64)

Non-distinctive

When the trade mark for which registration is sought consists of the three-dimensional shape of the packaging of the goods, the relevant norm or customs may be those that apply in the sector of the packaging of goods that are of the same type and intended for the same consumers as those goods for which registration is sought (12/01/2006, C-173/04 P, Standbeutel, EU:C:2006:20, § 33-34) (§ 28).



02/04/2020, T-546/19, [FORME D'UN RÉCIPIENT DORÉ AVEC UNE SORTE DE VAGUE \(3D\)](#), EU:T:2020:138, § 28

2.4 POSITION MARKS

Non-distinctive

According to established case-law, only a mark that departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) EUTMR. That case-law, which was developed in relation to three-dimensional trade marks consisting of the appearance of the product itself, also applies where a figurative sign consists of the two-dimensional representation of a product (§ 25). It further applies where a mark represents only part of a designated product inasmuch as the relevant public will immediately, and without further thought, perceive it as a representation of a particularly interesting or attractive detail of the product in question, and not as an indication of its commercial origin (§ 26). The decisive element is the fact that the sign is indissociable from the appearance of the product designated (§ 28).



14/11/2019, T-669/18, [VIER AUSGEFÜLLTE LÖCHER IN EINEM REGELMÄßIGEN LOCHBILD \(posit.\)](#), EU:T:2019:788, § 25, 26, 28

Non-distinctive — Three-dimensional position mark

Average consumers are not in the habit of making assumptions about the origin of products on the basis of signs that are indistinguishable from the appearance of the goods. The case-law applies to three-dimensional marks, two-dimensional figurative marks representing the external appearance of the goods, pattern marks and position marks (§ 17). The bottle top does not depart

significantly from the norms and customs of the sector, since it is composed of several components that are not untypical for spirits and liqueurs (§ 37).



16/01/2019, T-489/17, [DARSTELLUNG EINES FLASCHENVERSCHLUSSES \(Posit.\)](#), EU:T:2019:9, § 17, 37

2.5 PATTERN MARKS

[No key points available yet.]

2.6 COLOUR MARKS

[No key points available yet.]

2.7 SOUND MARKS

[No key points available yet.]

2.8 MOTION, MULTIMEDIA AND HOLOGRAM MARKS

[No key points available yet.]

3 ARTICLES 7(1)(c), 52(1)(a) EUTMR — DESCRIPTIVE TRADE MARKS

3.1 WORD MARKS

Relevant public

The fact that the relevant public is a specialist public cannot have a decisive influence on the legal criteria used to assess the distinctive character of a sign. The same is true of the assessment of the descriptiveness of a sign (§ 14).

07/05/2019, T-423/18, [vita](#), EU:T:2019:291, § 14

Relevant public — Level of command of the non-EU languages

The GC did not distort the evidence or fail to reason its assessment of the relevant public and the descriptiveness of the term 'PLOMBIR' for ice cream (as the transliteration into Latin characters of the word 'Пломбир', meaning 'ice cream' in Russian). The relevant public was the Russian-speaking public, which included that part of the general public within the EU that understood or spoke Russian in Germany and the Baltic States. Whether or not Russian was understood in Germany, or whether the GC had committed an error in finding that Russian was understood in Germany, was irrelevant, as the judgment would still stand on the basis of the well-known fact established by the GC that Russian was understood in the Baltic States (§ 41-43). Although the GC had not stated whether the level of command of Russian in the Baltic States was that of a native speaker, it had adequately reasoned that it had been proven that 'Plombir' was used in everyday Russian (§ 68-74).

Descriptive — Actual or potential characteristic of the goods

The fact that a sign describes a characteristic which does not, at the current stage of the technology, exist does not preclude it being perceived as descriptive by the relevant public. It is sufficient, to justify refusal of the mark applied for, that, in the perception of the relevant public, it is able to be used for the purposes of designating an actual or potential characteristic of the goods, even if that characteristic does not yet pertain at the current stage of technology (§ 24).

The word mark 'oral Dialysis' is descriptive for goods such as oral preparations for dialysis since the consumer perceives it as an indication of a medicine taken orally for dialysis. The fact that, from a scientific perspective, oral dialysis does not exist and the word sign has no concrete meaning when considered technically, has no influence on the descriptive character (§ 20, 24, 27).

13/06/2019, T-652/18, [oral Dialysis](#), EU:T:2019:412, § 20, 24, 27

Descriptive — Descriptiveness in relation to a general category of goods or services

The relevant public (English-speaking, specialist public of orthopaedic surgeons) will immediately perceive the words 'Compliant Constructs', in relation to surgical implants or orthopaedic articles, as descriptive for those goods, especially those that consist of an elastic or flexible material (§ 41-46).

The finding of the descriptive character of a mark applies not only to the goods for which it is directly descriptive but also, in the absence of a suitable restriction of the trade mark by the applicant, to the general category of goods to which they belong (§ 50). Therefore, the descriptive character is not only applicable to *surgical instruments and apparatus*, but also to *surgical, medical, dental and veterinary apparatus and instruments* (§ 52).

12/06/2019, T-291/18, [Compliant Constructs](#), EU:T:2019:407, § 41-46, 50, 52

Descriptive — Descriptiveness in relation to only some of the goods or services within the category

The fact that a sign is descriptive in relation to only some of the goods or services within a category does not preclude that sign being refused registration if the application is not confined to the goods for which the sign is not descriptive. Otherwise, if the sign were to be registered, there would be nothing to preclude the applicant from also using it for the goods covered by the registration for which it is descriptive (§ 32).

The sign is descriptive for all the goods applied for (i.e. *clothing, footwear and headgear* in Class 25), which, in the absence of any specific limitation, include *goods relating to sport* (§ 32-33, 35).

12/03/2019, T-220/16, [PRO PLAYER](#), EU:T:2019:159, § 32-33, 35

Descriptive — Descriptiveness in relation to only some of the goods or services

Regarding the goods in Classes 5, 28 and 31, the sign **real nature** describes the characteristics of genuinely natural products, that is, products that contain exclusively natural ingredients or materials (§ 25). Insofar as the sign refers to artificial goods for which an exclusively natural origin is ruled out, it refers to the fact that these goods use natural ingredients or materials as far as possible, or constitute a genuine substitute for a natural product by realistically imitating the

properties of that product (§ 26). The sign also refers to services in Class 35 that are related to such goods (§ 27).

However, the sign cannot be regarded as descriptive for certain services in Class 35, notably *advertising, marketing, business advice and organisational consultancy for franchise concepts, and providing of business know-how (franchising)*, since these do not have any direct and specific link with nature or nature-related goods (§ 30-31).

For these services, the sign even has a certain originality, since they have no direct and specific link with nature, and the sign could be perceived as surprising, unexpected and therefore memorable. The sign is therefore not only not descriptive but also not devoid of distinctive character (§ 52).

20/09/2019, T-458/18, [real nature](#), EU:T:2019:634, § 25-27, 30-31, 52

Descriptive

The term 'bio' has acquired a broad meaning in everyday language. It refers to the ideas of respecting the environment, using natural materials or being manufactured in an ecological way (§ 20-23).

12/12/2019, T-255/19, [BIOTON](#), EU:T:2019:853, § 20-23

Descriptive

The term 'theatre' may be understood by the relevant public beyond its traditional meaning, as a general reference to the experience of being the audience in a theatre, cinema or auditorium, and therefore as being connected with various types of visual and acoustic performances for entertainment purposes, whether in a cinema or public theatre or at home. The sign is therefore also descriptive for private installations, such as home cinema (§ 24-26), and has a clear link with the goods and services (§ 53).

17/09/2019, T-399/18, [Theatre](#), EU:T:2019:612, § 24-26, 53

Descriptive — Neologism

A trade mark consisting of a neologism composed of descriptive verbal elements in respect of the goods or services is not descriptive only if there is a perceptible difference between the neologism and the mere sum of its elements. Such a perceptible difference assumes an unusual nature of the combination of the descriptive elements (§ 21). Furthermore, the neologism itself must be qualified as descriptive (§ 31). Therefore, a sufficiently direct and specific link between the word sign and the products must be established (§ 33).

04/04/2019, T-373/18, [FLEXLOADER](#), EU:T:2019:219, § 21, 31, 33

Descriptive — Neologism

A trade mark consisting of a neologism or a word composed of elements, each of which is descriptive of characteristics of the goods or services, is itself descriptive of those characteristics, unless there is a perceptible difference between the neologism or the word and the mere sum of its parts (§ 18).

There is no perceptible difference between the meaning of the sign and that of the mere sum of its two components, 'micro' and 'garden'. Therefore the sign does not, in itself, constitute a neologism that is suggestive or allusive for the goods in question (§ 22-26).

23/05/2019, T-364/18, [MicroGarden](#), EU:T:2019:355, § 18, 22-26

Not descriptive — Absence of 'intrinsic' characteristic that is 'inherent to the nature' of the goods

Within the meaning of Article 7(1)(c) CTMR [now Article 7(1)(c) EUTMR], a characteristic must be 'objective' and 'inherent to the nature of the good or service and 'intrinsic and permanent' with regard to that good or service. In Swedish, the word 'vita' as the plural form of 'vit' means 'white'. The colour white does not constitute an 'intrinsic' characteristic that is 'inherent to the nature' of the goods, but, rather, is a purely random and incidental aspect which only some of the goods may have and which does not have any direct and immediate link with their nature (§ 44-48).

07/05/2019, T-423/18, [vita](#), EU:T:2019:291, § 44-48

Not descriptive

The sign 'CINKCIARZ', consisting of a term that originally, under the Polish People's Republic, designated persons who were engaged in the illegal trade of foreign exchange, is not perceived as descriptive by the relevant public for lawful currency exchange services. The relevant public is aware of the fact that the services cannot contain illegal foreign exchange activities. Therefore, from the point of view of the relevant public, the term designating such activities as illegal cannot serve in normal usage to designate lawful currency exchange services (§ 52-53).

19/12/2019, T-501/18, [Cinkciarz](#), EU:T:2019:879, § 52-53

Evidence for descriptive character must relate to the trade mark's filing date — Invalidation proceedings

In an invalidity action, the evidence of the descriptive character of a mark must relate to the time of the application to make it possible to draw conclusions about the situation at that time (§ 58).

13/05/2020, T-86/19, [BIO-INSECT Shocker](#), EU:T:2020:199, § 58

Descriptive word marks

17/01/2019, T-40/18, [SOLIDPOWER](#), EU:T:2019:18
30/01/2019, T-256/18, [SCHUTZ](#), EU:T:2019:38
31/01/2019, T-97/18, [STREAMS](#), EU:T:2019:43
13/02/2019, T-278/18, [DENTALDISK](#), EU:T:2019:86
06/02/2019, T-332/18, [MARRY ME](#), EU:T:2019:61
12/03/2019, T-463/18, [SMARTSURFACE](#), EU:T:2019:152
12/03/2019, T-220/16, [PRO PLAYER](#), EU:T:2019:159
26/03/2019, T-787/17, [GlamHair](#), EU:T:2019:192
04/04/2019, T-373/18, [FLEXLOADER](#), EU:T:2019:219
11/04/2019, T-225/17, [BIO Proof ADAPTA](#), EU:T:2019:247
11/04/2019, T-226/17, [Rustproof System ADAPTA](#), EU:T:2019:246
08/05/2019, T-469/18, [HEATCOAT](#), EU:T:2019:302
23/05/2019, T-364/18, [MicroGarden](#), EU:T:2019:355
04/07/2019, T-662/18, [Twistpac](#), EU:T:2019:483
07/06/2019, T-719/18, [TELEMARKFEST](#), EU:T:2019:401
12/06/2019, T-291/18, [Compliant Constructs](#), EU:T:2019:407
13/06/2019, T-652/18, [oral Dialysis](#), EU:T:2019:412

26/06/2019, T-117/18 to T-121/18, [200 PANORAMICZNYCH](#), EU:T:2019:447
 17/09/2019, T-634/18, [revolutionary air pulse technology](#), EU:T:2019:611
 17/09/2019, T-399/18, [Theatre](#), EU:T:2019:612
 20/09/2019, T-458/18, [real nature](#), EU:T:2019:634
 12/12/2019, T-255/19, [BIOTON](#), EU:T:2019:853
 19/12/2019, T-175/19; [eVoter](#), EU:T:2019:874
 19/12/2019, T-501/18, [Cinkciarz](#), EU:T:2019:879
 29/01/2020, T-42/19, [CROSS](#), EU:T:2020:15
 11/02/2020, T-487/18, [VirusProtect](#), EU:T:2020:44
 02/04/2020, T-307/19, [Innerbarend](#), EU:T:2020:144
 11/06/2020, T-553/19, [PERFECT BAR](#), EU:T:2020:268

3.2 FIGURATIVE MARKS

Descriptive — Descriptive verbal elements — Reinforcing figurative element

The verbal element ‘TurboPerformance’ will be perceived as ‘performance aided by a turbo engine’ and is therefore descriptive for *vehicle electronic goods* and *vehicle maintenance services; vehicle ‘tuning’* (§ 58). This is reinforced by the mark’s inclusion of a figurative element depicting a speedometer with a needle pointing towards the right (§ 62).



TurboPerformance 11/07/2019, T-349/18, [TurboPerformance](#), EU:T:2019:495, § 62

Descriptive — Descriptive verbal elements — Various ‘usual or decorative’ figurative elements

The relevant public is perfectly capable of understanding the word ‘basmati’ as referring to a specific variety of popular long-grain rice used in savoury dishes (§ 52). ‘Basmati’ and ‘rice’ are directly descriptive of the nature of the goods designated by the mark, which are, or contain, rice (§ 53). The word ‘sir’ does not confer any notable degree of distinctive character on the mark at issue, either in isolation or considered in the overall impression created by that mark (§ 67). The combination of the word and figurative elements of the mark does not preclude the finding that the mark is perceived immediately and without further thought as being not only non-distinctive, but also descriptive of the goods in question (§ 61). The alleged ‘complexity’ of the mark is the result of various ‘usual or decorative’ elements that were wrongly found to confer the required degree of distinctive character on the mark (§ 63).



05/11/2019, T-361/18, [SIR BASMATI RICE \(fig.\)](#), EU:T:2019:777, § 52-53, 67, 61, 63

Descriptive — Figurative element consisting of a not-corresponding shape of a map

The presence of the shape of a map that is not of the United States does not change the meaning of the descriptive message of the remaining elements of the sign and, notably, does not prevent the relevant public from perceiving the verbal element as referring to foodstuffs from the sea in the United States (§ 19-22, 32).



17/10/2019, T-10/19, [UNITED STATES SEAFOODS \(fig.\)](#), EU:T:2019:751, § 19-22,


Descriptive — Misspelled word element

The verbal element 'pantys' does not differ from everyday language in such a way that the relevant public would regard it as more than a mere misspelling of the English word 'panties' (§ 27). The sign is descriptive for all sanitary products, especially for women (§ 21).


pantys 13/05/2020, T-532/19, [Pantys \(fig.\)](#), EU:T:2020:193, § 21, 27

Not descriptive — Absence of 'intrinsic' characteristic that is 'inherent to the nature' of the goods

The elegant and discreet character of the colour off-white and the improved visual impression that that colour produces in relation to certain goods (such as protective helmets), do not make it possible to establish that it constitutes a characteristic which is 'objective' and 'inherent to the nature of the goods in question'. These considerations, when referring to the aesthetic value and contribution of that colour, involve an element of subjective assessment, likely to vary greatly according to the individual preferences of each consumer and, therefore, cannot be used to determine how a sign may be perceived by the public as a whole (13/12/2018, T-98/18, MULTIFIT, EU:T:2018:936, § 31) (§ 44).


 25/06/2020, T-133/19, [OFF-WHITE \(fig.\)](#), EU:T:2020:293, § 44

Descriptive Figurative marks

 06/02/2019, T-333/18, [marry me \(fig.\)](#), EU:T:2019:60

SATISFYERMEN 31/01/2019, T-427/18, [SATISFYERMEN \(fig.\)](#), EU:T:2019:41

 11/04/2019, T-223/17, [ADAPTA POWDER COATINGS \(fig.\)](#), EU:T:2019:245

 11/04/2019, T-224/17, [Bio proof ADAPTA \(fig.\)](#), EU:T:2019:242

 08/05/2019, T-55/18, [LIEBLINGSWEIN \(fig.\)](#), EU:T:2019:311

07/05/2019, T-423/18, [vita](#), EU:T:2019:291

 08/05/2019, T-56/18, [WEIN FÜR PROFIS \(fig.\)](#), EU:T:2019:312

 08/05/2019, T-57/18, [WEIN FÜR PROFIS \(fig.\)](#), EU:T:2019:313

EXECUTIVE SELLING  09/09/2019, T-689/18, [EXECUTIVE SELLING \(fig.\)](#), EU:T:2019:564

LEGALCAREERSTM 03/10/2019, T-686/18, [LEGALCAREERS \(fig.\)](#), EU:T:2019:722



19/12/2019, T-69/19, [Bad Reichenhaller Alpsaline \(fig.\)](#), EU:T:2019:895

ring

19/12/2019, T-270/19, [ring \(fig.\)](#), EU:T:2019:871



12/12/2019, T-747/18, [SHAPE OF A FLOWER \(3D\)](#), EU:T:2019:849

PROFI CARE 13/05/2020, T-5/19, [PROFI CARE \(fig.\)](#), EU:T:2020:191



11/06/2020, T-563/19, [PERFECT BAR \(fig.\)](#), EU:T:2020:271, § 18



25/06/2020, T-651/19, [Credit24 \(fig.\)](#), EU:T:2020:288

4 ARTICLES 7(1)(d), 52(1)(a) EUTMR — CUSTOMARY SIGNS OR INDICATIONS

[No key points available yet.]

5 ARTICLE 7(3) EUTMR — ACQUIRED DISTINCTIVENESS THROUGH USE

5.1 THE POINT IN TIME FOR WHICH ACQUIRED DISTINCTIVENESS HAS TO BE ESTABLISHED

[No key points available yet.]

5.2 CONSUMERS

[No key points available yet.]

5.3 GOODS AND SERVICES

[No key points available yet.]

5.4 TERRITORIAL ASPECTS

Distinctive character acquired through use — Territorial aspects — Assessment

The distinctive character acquired by the use of a trade mark must be demonstrated in the part of the European Union where it was devoid of such character (§ 51). It is also apparent from case-law that the acquisition of distinctive character through the use of a mark requires that at least a significant proportion of the relevant public identify the goods or services concerned as originating from a particular undertaking because of the mark, and therefore distinguishes those goods or services from those of other undertakings (§ 52).

As the mark applied for was devoid of distinctive character for the English-speaking public of the European Union, including Member States where English is an official language, namely Ireland, Malta and the United Kingdom, distinctiveness acquired through use needed to be proved, in particular for this public (§ 54-55). The evidence provided mostly targeted Greece and, marginally, other Member States where English is understood (Cyprus, the Netherlands, Sweden) for a period of less than three years (§ 58-62). Therefore, there is not sufficient proof of distinctiveness acquired through use (§ 66).

14/05/2019, T-465/18, [EUROLAMP pioneers in new technology](#), EU:T:2019:327, § 52, 58-62, 66

Distinctive character acquired through use — Territorial aspects — Assessment

In the case of a mark that does not have inherent distinctive character **throughout the European Union**, the distinctive character acquired through the use of that mark must be shown throughout that territory, and not only in a substantial part or the majority of it. Consequently, although such proof may be produced globally for all the Member States concerned, or separately for different Member States or groups of Member States, it is not, however, sufficient that the party with the burden of providing such evidence merely produces evidence of such acquisition that does not cover part of the European Union, even a part consisting of only one Member State (25/07/2018, C-84/17 P, C-85/17 P and C-95/17 P, *SHAPE OF A 4-FINGER CHOCOLATE BAR (3D)*, EU:C:2018:596, § 87) (§ 75).

In this case, an extrapolation of the global data concerning the EU market could not be made with regard to Cyprus and Slovenia, since the applicant had not previously demonstrated use of the challenged mark on their territory (§ 76).

28/06/2019, T-340/18, [SHAPE OF A FLYING V GUITAR \(3D\)](#), EU:T:2019:455, § 75-76

Distinctive character acquired through use — Territorial aspects — Assessment

Evidence of distinctive character acquired through use may relate globally to all the Member States or to a group of Member States. Certain evidence may therefore be relevant as regards a number of Member States or even the entire European Union. No provision of the EUTM Regulation requires that the acquisition of distinctive character through use be established by separate evidence in each individual Member State and it would be unreasonable to require proof of such acquisition for each Member State separately (25/07/2018, C-84/17 P, C-85/17 P & C-95/17 P, *Shape of a 4-Finger Chocolate Bar (3D)*, EU:C:2018:596, § 79-80, 87) (§ 82-83).

Nowadays, the fact that there are no physical shops in a Member State does not necessarily prevent the relevant public of that Member State from becoming familiar with and recognising the mark as originating from its proprietor by seeing it on websites, social media, in electronic catalogues and brochures, through online advertising by globally or locally known celebrities or influencers, or in shops in the most central and popular tourist areas of major cities and airports (§ 88).

Distinctive character acquired through use — Territorial aspects — Assessment

Although the proprietor submitted extensive evidence of use, only the market surveys concerning five Member States are actually relevant to some extent for establishing that the mark has acquired distinctive character through use (§ 117, 151, 152). The proprietor did not demonstrate that the markets of the remaining 23 Member States are comparable to the domestic markets of the 5 Member States where the surveys were carried out. The results of the surveys cannot, consequently, be extrapolated to all the Member States (§ 156-157).

19/06/2019, T-307/17, [DEVICE OF THREE PARALLEL STRIPES \(fig.\)](#), EU:T:2019:427, § 117, 151-152, 156-157

5.5 EVIDENCE

5.5.1 Means of evidence

Probative value of the evidence — Declarations made by professionals

The Office is under no obligation to explain to the EUTM proprietor what type of evidence it needs to submit in order to show that the mark has distinctive character acquired through use (§ 142-143). The declarations made by professionals are indirect evidence and do not reflect on the perception of the general public (§ 148-149). Declarations featuring largely general assertions and lacking reference to supporting figures or to the perception of the mark by the average consumer in various markets in the EU lack sufficient credibility to identify the sole covered by the mark as an indication of origin (§ 154). Pursuant to Article 52(2) CTMR [now Article 59(1)(a) EUTMR], it is up to the EUTM proprietor to submit appropriate and sufficient evidence to demonstrate acquired distinctive character (§ 157)

29/03/2019, T-611/17, [REPRESENTATION D'UNE SEMELLE DE CHAUSSURE \(3D\)](#), EU:T:2019:210, § 142-143, 148-149, 154, 157

Secondary evidence — Sales figures

Sales figures are not sufficient to show distinctiveness acquired by use if they are not accompanied by information relating to the market share that they represent in respect of both the global market for the goods and services in question and the global amount of advertising costs in that market in the relevant territory (§ 118).

11/04/2019, T-223/17, [ADAPTA POWDER COATINGS \(fig.\)](#), EU:T:2019:245, § 118

Secondary evidence — Sales figures

The acquisition of distinctive character through use of a mark requires that at least a significant proportion of the relevant section of the public identify products or services as originating from a particular undertaking because of the mark. Sales figures only constitute secondary evidence which may support, if necessary, direct evidence of distinctive character acquired through use, such as declarations from professional associations or market studies. The sales figures in themselves do not show that the public targeted by the goods concerned perceives the trade mark as an indication of their commercial origin (§ 74-82).

26/06/2019, T-117/18 to T-121/18, [200 PANORAMICZNYCH](#), EU:T:2019:447, § 74-82

Secondary evidence — Advertising materials

Advertising materials can be regarded only as secondary evidence which may support direct evidence of distinctive character acquired through use. However, advertising material, as such, does not demonstrate that the public targeted by the goods or services perceives the sign as an indication of commercial origin (§ 36).

24/09/2019, T-404/18, [PDF Expert](#), EU:T:2019:666, § 36

Evidence for acquired distinctiveness through use — Market share held by the mark

There is no requirement that the evidence submitted to prove distinctiveness acquired through use must relate directly to the market share held by the mark or the proportion of the relevant section of the public that identifies the goods or services as originating from a particular undertaking. It is sufficient for that evidence to enable conclusions to be drawn regarding that market share or proportion of the public (§ 62-65).

14/05/2019, T-12/18, [Triumph / TRIUMPH](#), EU:T:2019:328, § 62-65

Evidence — Use of a verbal element in combination with the icon of an app

The use of the verbal element 'pdf expert' in combination with the icon of the app, that was not a registered trade mark, as a figurative element, is not sufficient to establish that the verbal element 'pdf expert' has acquired distinctiveness through use (§ 27). The icon is predominant and most often used completely separately from the verbal element 'pdf expert'. Therefore, it does not confer distinctiveness on that element in itself, but rather, given its descriptive nature, renders it explanatory of the icon (§ 28).

Statistics on internet searches for the keyword 'pdf expert' could be capable of demonstrating that a mark has acquired distinctive character through use. However, that possibility is only accepted in special circumstances, such as where the majority of the marks in the sector are inherently descriptive or clients were generally regular customers, permitting the inference that clients used the mark to identify the applicant's goods or services, as opposed to goods or services offered by its competitors (14/12/2017, T-304/16, BET365, EU:T:2017:912) (§ 37).

24/09/2019, T-404/18, [PDF Expert](#), EU:T:2019:666, § 27, 28, 37

Evidence — Use of verbal element in combination with the icon of an app

The evidence submitted to prove the acquired distinctiveness of the sign, showing the verbal elements 'Scanner' and 'pro' sometimes combined with the icon depicted in the app store, is not sufficient. This is because the icon is predominant and most often used completely separately from the verbal element 'scanner pro'. Therefore, it does not confer distinctiveness on that element in itself, but rather, given its descriptive nature, renders it explanatory of the icon (§ 43-45).

24/09/2019, T-492/18, [Scanner Pro](#), EU:T:2019:667, § 43-45

Evidence — Burden of proof — Certificates from the UK IP Office referring to the earlier UK marks as having acquired distinctive character through use

Enhanced distinctiveness as a result of extensive use or reputation cannot be presumed and must therefore be demonstrated by the party seeking to rely on it. In that regard, the mere fact that the

certificates from the UK IP Office refer to the earlier UK marks as having acquired distinctive character as a result of use does not suffice to demonstrate that the distinctiveness of the earlier word marks has been enhanced as a result of extensive use or reputation (§ 74).

28/05/2020, T-506/19, [Uma workspace / WORKSPACE \(fig.\) et al.](#), EU:T:2020:220, § 74

5.5.2 Use as a trade mark

Use in forms which differ from the form by insignificant variations — Reversed colour scheme

The concept of use of a trade mark, within the meaning of Article 7(3) CTMR [now Article 7(3) EUTMR] and Article 52(2) CTMR [now Article 59(2) EUTMR], must be interpreted as referring not only to use of the mark in the form in which it was submitted for registration but also to the use of the trade mark in forms which differ from that form solely by insignificant variations and that are able to be regarded as broadly equivalent to that form (§ 62).

The act of reversing the colour scheme, even if a sharp contrast between the three stripes and the background is preserved, is a significant variation compared to the registered form of the mark (§ 77).

Numerous pieces of evidence were correctly dismissed on the grounds of showing forms of use not broadly equivalent to the registered form (sloping lines, reversed colour scheme) (§ 78, 97, 103).



19/06/2019, T-307/17, [DEVICE OF THREE PARALLEL STRIPES \(fig.\)](#), EU:T:2019:427, § 62, 77, 78, 97, 103

Use in combination with another registered trade mark

A three-dimensional mark can acquire distinctive character through use, even if it is used in conjunction with a word mark or a figurative mark, provided the mark embodies the shape of the product or its packaging and that they systematically bear the word mark under which they are marketed (§ 129).

The acquisition of the distinctive character of a mark could result from its use in combination with another registered trade mark, provided that the public concerned continue to perceive the products as coming from a specified undertaking (§ 130).

The proprietor of a registered trade mark may, for the purpose of establishing the particular distinctive character and reputation of that trade mark, avail itself of evidence of its use in combination with another registered and reputed mark, provided that the public concerned continue to perceive the products as coming from the same undertaking (§ 131).

28/02/2019, T-459/18, [PEPERO original \(fig.\) / REPRÉSENTATION D'UN BATÔNNET \(fig.\)](#), EU:T:2019:119, § 129-131

Use of a three-dimensional mark in combination with another trade mark

A three-dimensional mark may acquire distinctive character through use, even if it is used in conjunction with a word mark or a figurative mark. Evidence of use of a three-dimensional mark

in conjunction with another registered and well-known mark may serve to establish its distinctive character and its reputation, provided that the relevant public continue to perceive the goods as originating from the same undertaking (§ 80-82). The fact that the three-dimensional representation of the shape of the biscuit, protected by the earlier trade mark, has been used together with the word mark OREO, and that the biscuit is known to be an 'Oreo', does not permit the conclusion that the reputation is based solely on the word mark OREO and not on the earlier mark itself (§ 94).

28/05/2020, T-677/18, [GULLÓN TWINS COOKIE SANDWICH \(fig.\) / OREO \(fig.\) et al.](#), EU:T:2020:229, § 80-82, 94

Distinctive character acquired through the use of an individual mark following collective use

The fact that the use of the terms 'crédit mutuel' is regulated or reserved to a single economic actor is irrelevant to assess its inherent descriptive character since it does not affect the perception of the relevant public. However, it may be a relevant element when assessing the distinctive character acquired through use (§ 63, 102-105).

Terms designating a regulated activity can acquire distinctive character through use under Article 7(3) EUTMR (§ 104).

To establish if an individual mark has acquired distinctive character through use following collective use, it must be determined if consumers perceive that the goods and services originate from a single undertaking under whose control they are manufactured or provided and who is liable for the quality of the goods and services (§ 143).

24/09/2019, T-13/18, [Crédit Mutuel](#), EU:T:2019:673, § 63, 102-105, 104, 143

6 ARTICLES 7(1)(e), 52(1)(a) EUTMR — SHAPE

6.1 SHAPE OR OTHER CHARACTERISTICS RESULTING FROM THE NATURE OF THE GOODS

Application *ratione temporis*

Article 7(1)(e) CTMR [now Article 7(1)(e) EUTMR], *after* amendment, cannot be applied retroactively to trade marks registered before 23 March 2016 (§ 33).

14/03/2019, C-21/18; [Textilis](#), EU:C:2019:199, 33

08/05/2019, T-324/18, [BOTTIGLIA DORATA \(3D\)](#), EU:T:2019:297, § 16-18

Shape commonly used by most of the producers

The fact that a shape is commonly used by most of the producers of a certain type of goods does not imply that this shape results from the nature of the product, since that fact is the result of a marketing choice driven by what is customary for that type of product (§ 46).



08/05/2019, T-324/18, [BOTTIGLIA DORATA \(3D\)](#), EU:T:2019:297, § 46

6.2 SHAPE OR OTHER CHARACTERISTICS OF GOODS NECESSARY TO OBTAIN A TECHNICAL RESULT

Concept of 'shape' — Colours

The concept of 'shape' is usually understood as a set of lines or contours that outline the product concerned. Colour per se could not constitute a shape (§ 54-55).

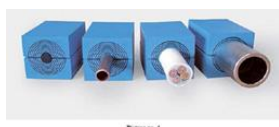


08/05/2019, T-324/18, [BOTTIGLIA DORATA \(3D\)](#), EU:T:2019:297, § 54-55

Essential characteristics — Article 7(1)(e)(ii) EUTMR

Neither the distinctive character of the elements of a sign nor their distinctive character acquired through use is relevant in determining the sign's essential characteristics for the purposes of Article 7(1)(e)(ii) EUTMR (§ 51-55, 59-61, 64).

Article 7(1)(e)(ii) EUTMR applies to a sign that does not include every detailed characteristic of the product, provided that it is demonstrated that the essential characteristics of that sign combine at least the characteristics which are technically causal of, and sufficient to obtain, the intended technical results (§ 77).

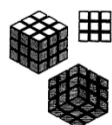


24/09/2019, T-261/18, [DEVICE OF A BLACK SQUARE CONTAINING SEVEN CONCENTRIC BLUE CIRCLES \(fig.\)](#), EU:T:2019:674 § 51-55, 59-61, 64, 77

Essential characteristics — Article 7(1)(e)(ii) EUTMR

The examination, under Article 7(1)(e)(ii) EUTMR, consists of two steps: first, the identification of the essential characteristics of the sign as represented (without taking into account the actual product) (§ 49), and second, the analysis of the functionality of the essential characteristics of the sign, which must be carried out in the light of the actual goods and the intended technical result of those goods (§ 84).

The BoA made an error of assessment in identifying the essential characteristics of the contested mark by including 'the differences in the colours on the six faces of the cube' as one of the essential characteristics (§ 65-70, 92). However, that error does not affect the legality of the contested decision (§ 71, 93).



24/10/2019, T-601/17, [Cubes \(3D\)](#), EU:T:2019:765, § 49, 65-70, 71, 84, 92-93

Preliminary ruling — Essential characteristics — Technical result — Article 3(1)(e)(ii) of Directive 2008/95

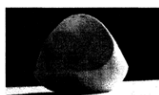
Article 3(1)(e)(ii) of Directive 2008/95 may be applied when the graphic representation of the shape of the product allows only part of the shape to be seen, provided that the visible part of the shape is necessary to obtain the technical result sought by that product, even if it is not sufficient, on its own, to obtain that result. Therefore, that ground for refusal is applicable to a sign consisting of the shape of the product concerned which does not show all the essential characteristics required to obtain the technical result sought, provided that at least one of the essential characteristics required to obtain that technical result is visible in the graphic representation of the shape of that product (§ 32).



23/04/2020, C-237/19, [Gömböc](#) Kutató, EU:C:2020:296, § 32

Preliminary ruling — Essential characteristics — Functionality and the public's knowledge — Article 3(1)(e)(ii) of Directive 2008/95

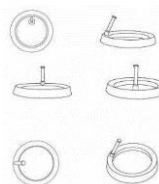
Article 3(1)(e)(ii) of Directive 2008/95/EC must be interpreted as meaning that, in order to establish whether a sign consists exclusively of the shape of goods which is necessary to obtain a technical result, the assessment does not have to be limited to the graphic representation of that sign (§ 37). The first step of the analysis is to identify the essential characteristics of the sign. For that step, information other than that relating to the graphic representation alone, such as the relevant public's perception, may be used (§ 29-31, 37). The second step of the analysis is to establish if the essential characteristics perform a technical result. For that step, information which is not apparent from the graphic representation of the sign must originate from objective and reliable sources and may not include the relevant public's perception (§ 32-36, 37).



23/04/2020, C-237/19, [Gömböc](#) Kutató, EU:C:2020:296, § 29-32, 36-37

Sign consisting exclusively of the shape of the product — Article 7(1)(e)(ii) EUTMR

The sign applied for coincides with the shape of the product necessary to obtain a technical result (§ 24-27). The existence of other shapes that could achieve the same technical result does not impede the application of Article 7(1)(e)(ii) CTMR [now Article 7(1)(e)(ii) EUTMR] (§ 32-33). The shape of the product does not incorporate a major non-functional element, such as a decorative or imaginative element that plays an autonomous role in that shape (§ 41-44).



26/03/2020, T-752/18, [3D](#), EU:T:2020:130, § 41-44

6.3 SHAPE OR OTHER CHARACTERISTICS GIVING SUBSTANTIAL VALUE TO THE GOODS

Preliminary ruling — Concept of ‘shape’ — Shape giving substantial value to the goods

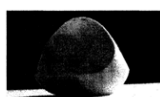
Article 7(1)(e)(iii) CTMR must be interpreted as meaning that a sign consisting of two-dimensional decorative motifs, which are affixed to goods, such as fabric or paper, does not ‘consist exclusively of the shape’, within the meaning of that provision (§ 48). The notion of ‘shape’ within the meaning of Article 3(1)(e)(iii) of Directive 2008/95/EC is limited to the contours of a product, to the exclusion of all other characteristics which may contribute to the appearance of this product, such as a pattern applied to the entirety or a specific part of a product without being delineated in a fixed manner (§ 33, 36-41). It cannot be held that a sign consisting of two-dimensional decorative motifs is indissociable from the shape of the goods where that sign is affixed to goods, such as fabric or paper, the form of which differs from those decorative motifs (§ 42). Such a sign cannot be regarded as consisting ‘exclusively of the shape’ within the meaning of Article 7(1)(e)(iii) CTMR (§ 43).



14/03/2019, C-21/18; [Textilis](#), EU:C:2019:199, § 33, 36-41, 42-43

Preliminary ruling — Shape giving substantial value to the goods — The relevant public’s perception or knowledge — Decision on purchase — Article 3(1)(e)(iii) of Directive 2008/95

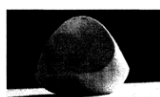
Article 3(1)(e)(iii) of Directive 2008/95 must be interpreted as meaning that the relevant public’s perception or knowledge of the product represented graphically by a sign that consists exclusively of the shape of that product may be taken into consideration in order to identify an essential characteristic of that shape. The ground for refusal may be applied if it is apparent from objective and reliable evidence that the consumer’s decision to purchase the product in question is to a large extent determined by that characteristic (§ 39-46, 47).



23/04/2020, C-237/19, [Gömböc Kutató](#), EU:C:2020:296, § 39-46, 47

Preliminary ruling — Shape giving substantial value to the goods — Cumulative protection — Designs — Decorative items — Article 3(1)(e)(iii) of Directive 2008/95

Article 3(1)(e)(iii) of Directive 2008/95 must be interpreted as meaning that that ground for refusal must not be applied systematically to a sign which consists exclusively of the shape of the goods where that sign enjoys protection under the law relating to designs or where the sign consists exclusively of the shape of a decorative item (§ 50, 53, 58-59, 62).



23/04/2020, C-237/19, [Gömböc Kutató](#), EU:C:2020:296, § 39-46, 47, 50, 53, 58-59, 62

7 ARTICLES 7(1)(f), 52(1)(a) EUTMR — PUBLIC POLICY / MORALITY

Contrary to public policy or principles of morality

The combination of the verbal element ‘store’, which normally means ‘shop’, with the dominant verbal element ‘cannabis’ will be perceived by the relevant English-speaking public as meaning ‘cannabis shop in Amsterdam’, and by the relevant non-English-speaking public as ‘cannabis in Amsterdam’. In both cases, coupled with the image of the cannabis leaves, which is a commonly used symbol for marijuana, it is a clear and unequivocal reference to the narcotic substance (§ 65). A sign referring to cannabis may not, as the law currently stands, be registered as an EU trade mark since it is contrary to the fundamental interest of Member States and is therefore against public policy for all the consumers in the European Union who can understand its meaning (§ 74-77).



12/12/2019, T-683/18, [CANNABIS STORE AMSTERDAM](#), EU:T:2019:855, § 65, 74-77

Not contrary to public policy or principles of morality — Accepted principles of morality

The concept of ‘accepted principles of morality’ is determined by taking into account the fundamental moral values and standards that society adheres to at a given time. Those values and norms, which are likely to change over time and vary geographically, should be determined according to the social consensus prevailing in that society at the time of the assessment, taking into account the social context (including cultural, religious or philosophical diversities) to assess objectively what that society considers to be morally acceptable at that time (§ 39).

27/02/2020, C-240/18 P, [Fack Ju Göhte](#), EU:C:2020:118, § 39

8 ARTICLES 7(1)(g), 52(1)(a) EUTMR — DECEPTIVE TRADE MARK

Scope of Article 7(1)(g) EUTMR — Possibility of non-misleading use of a mark

The term ‘bio’, generally speaking, refers to the idea of respect for the environment, the use of natural materials, or organic products (§ 80-81).

Use of the term ‘bio’ on biocidal goods (§ 75) establishes a sufficiently serious risk of misleading the consumer as to the purpose of those goods, namely that they serve to destroy or prevent pests (§ 83).

Article 7(1)(g) CTMR [now Article 7(1)(g) EUTMR] applies even where non-misleading use of the mark at issue is possible (§ 84-85).

13/05/2020, T-86/19, [BIO-INSECT Shocker](#), EU:T:2020:199, § 80-81, 83, 84-85

9 ARTICLES 7(1)(h), 52(1)(a) EUTMR — FLAGS AND OTHER SYMBOLS EMBLEMS, etc.

[No key points available yet.]

10 ARTICLES 7(1)(i), 52(1)(a) EUTMR — EMBLEMS NOT PROTECTED UNDER ARTICLE 6ter PC

[No key points available yet.]

11 ARTICLE 7(1)(j) EUTMR — GEOGRAPHICAL INDICATIONS

Preliminary ruling — Geographical origin — Article 2(1)(a) of Regulation (EC) No 510/2006 — Article 13(1) Regulation (EC) No 510/2006

Geographical indications (GIs) are protected against any evocation, including by figurative signs (§ 18). A producer established in a geographical area corresponding to a Protected Designation of Origin (PDO), whose products are not protected by the PDO but are similar or comparable to those protected by it, is not excluded from the application of Article 13(1)(b) Regulation (EC) No 510/2006 (§ 34).

02/05/2019, C-614/17; [Fundación Consejo Regulador de la Denominación de Origen Protegida Queso Manchego](#), EU:C:2019:344, § 18, 34

12 ARTICLE 7(1)(k) EUTMR — TRADE MARKS IN CONFLICT WITH TRADITIONAL TERMS FOR WINES

[No key points available yet.]

13 ARTICLE 7(1)(l) EUTMR — TRADE MARKS IN CONFLICT WITH TRADITIONAL SPECIALITIES GUARANTEED

[No key points available yet.]

14 ARTICLE 7(1)(m) EUTMR — TRADE MARKS IN CONFLICT WITH EARLIER PLANT VARIETY DENOMINATIONS

Criteria for assessment — Article 7(1)(m) EUTMR

Article 7(1)(m) EUTMR must be interpreted in the light of its objective, which is to determine whether the registration of the trade mark applied for hinders the free use of the plant variety denomination included in the trade mark (§ 29-30).

For this purpose, it must be established whether the plant variety denomination holds an essential position within the complex trade mark applied for. If so, the free use of this variety denomination would be hindered. In contrast, if its original essential function is not based on the variety denomination, but on other components of the trade mark, the availability requirement for variety denominations is maintained (§ 31).

In order to determine whether the essential function of the mark applied for is based on the variety denomination or on other elements, the criteria to be assessed are, in particular, the distinctive character of the other elements, the message conveyed as a whole by the mark applied for, the visual dominance of the various elements by reason of their size and position, or the number of elements of which the mark is composed (§ 32).

18/06/2019, T-569/18, [Kordes' Rose Monique](#), EU:T:2019:421, § 29-32

15 EUROPEAN UNION COLLECTIVE MARKS

LOC — Criteria for assessment — Applicability in the case of an earlier collective mark — Distinctive character of a collective mark — Global assessment of LOC — Interdependence

When the earlier mark is a collective mark, the likelihood of confusion (LOC) must be understood as the risk that the public might believe that the goods or services covered by the earlier mark and those covered by the contested sign all originate from members of the association that is the proprietor of the earlier trade mark, or from undertakings economically linked to those members or to that association (§ 64).

In the event of an opposition by the proprietor of a collective mark, the essential function of that mark must be taken into account to understand what LOC means (§ 65). However, the case-law establishing the criteria for assessing a LOC is applicable to cases concerning an earlier collective mark. None of the characteristics of this type of mark justifies a derogation from those assessment criteria (§ 65-66).

Having regard, in particular, to Article 66(2) EUTMR, which is not an exception to the requirement of distinctiveness (§ 73), the distinctiveness of the earlier mark must not be assessed differently if it is an EU collective mark (§ 71). Therefore, in the absence of any contrary provision, Article 7(1)(b) EUTMR and Article 7(3) EUTMR apply to EU collective marks that must, intrinsically or through use, be distinctive (§ 72).

It is an incorrect premise to consider that, when the earlier mark is weak, the existence of a LOC must be ruled out as soon as it is established that the similarity of the marks does not allow a LOC to be established. To determine the existence of a LOC, bearing in mind the criterion of interdependence established in case-law, it is necessary to examine whether the low degree of similarity of the marks is offset by the higher degree of similarity, or even identity, of the goods they cover them (§ 85-86).



05/03/2020, C-766/18 P, [BBQLOUMI \(fig.\) / HALLOUMI.](#), EU:C:2020:170, § 64-66, 72, 85-86

16 EUROPEAN UNION CERTIFICATION MARKS

17 SPECIFIC ABSOLUTE GROUNDS FOR INVALIDITY — ARTICLE 59(1)(b) EUTMR — BAD FAITH

17.1 RELEVANT POINT IN TIME

Relevant point in time for bad faith — Time of the filing of the application

The fact that, for a certain period, the proprietor paid the profits obtained from the exploitation of the trade mark into the accounts of Can Ganguil is not relevant. This is because bad faith must be proven at the time of filing the application and the profits were paid later (§ 55).

12/07/2019, T-772/17, [Café del Mar \(fig.\)](#), EU:T:2019:538, § 55

17.2 CONCEPT OF BAD FAITH

17.2.1 Factors likely to indicate the existence of bad faith

Concept of bad faith — LOC not a prerequisite of bad faith

Bad faith presupposes a dishonest state of mind or intention (§ 45). It applies where it is apparent from relevant and consistent indicia that the proprietor of an EUTM filed its application for registration, not with the aim of engaging fairly in competition, but with the intention of undermining the interests of third parties in a manner inconsistent with honest practices, or with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, in particular the essential function of indicating origin (§ 46).

LOC is not a prerequisite of bad faith. In the absence of any LOC between the sign used by a third party and the contested EUTM, other factual circumstances may constitute relevant and consistent indicia establishing the bad faith of the EUTM applicant (§ 56).



12/09/2019, C-104/18P, [STYLO & KOTON \(fig.\)](#), EU:C:2019:724, § 45-46, 56

Concept of bad faith

The concept of bad faith relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct that departs from accepted principles of ethical behaviour or honest commercial and business practices (§ 23).

The existence of bad faith on the part of the applicant for registration at the time of filing the application for registration of an EU trade mark must be assessed, inter alia, in the light of his intention. The intention of the applicant for registration at the relevant time is a subjective factor, which must be determined by reference to the objective circumstances of the particular case (§ 49).

Neymar was already recognised as a very promising football player on the relevant date (§ 30-33). It can be deduced from this objective fact, proved by evidence, and from the other objective fact that the EUTM proprietor had filed an application for registration of the word mark IKER CASILLAS on the same day, that the EUTM proprietor possessed more than a little knowledge of the world of football (§ 36). In the light of only those factors and the particular circumstances of the case, the real purpose of the commercial logic behind the application for registration of the EUTM was to 'free-ride' on Neymar's reputation and take advantage of that reputation (§ 50-51).

14/05/2019, T-795/17, [NEYMAR](#), EU:T:2019:329, § 23, 30-33, 36, 49-51

Bad faith of a distributor — Deterioration of the distribution agreement with the manufacturer

The factors to be taken into consideration are: (i) whether the EUTM proprietor knew, at the date of filing of the EUTM, that the invalidity applicant had previously been using the sign corresponding to the EUTM, (ii) the nature of the contractual relationship between the parties, (iii) the origin of the sign corresponding to the EUTM, (iv) the degree of legal protection of the sign corresponding to the EUTM, and (v) the EUTM proprietor's intention at the time of filing of the EUTM (§ 46).

The distributor acted in bad faith, since the application for the EUTM was filed, without genuine intention to use it, for the sole purpose of preventing the marketing of competing products (§ 82-83). The lack of intention to use the sign corresponding to the EUTM is of particular importance because it goes against the essential function of a mark, which is to guarantee the identity of the origin of the goods and services it protects (§ 85).

30/04/2019, T-136/18, [K \(fig.\)](#), EU:T:2019:265, § 46, 82-83, 85

Indication of bad faith — Attempt to obtain the right to market goods under an identical trade mark

The attempt to obtain the right to market goods under an identical trade mark owned by the invalidity applicant, that the latter had refused to follow up, constitutes an indication of bad faith (§ 124, 125).

The use of the contested sign may constitute a factor to be taken into account when establishing the intention underlying the application for registration of the sign, including use after the date of that application (§ 118, 119, 126).



ANN TAYLOR 23/05/2019, T-3/18 and T-4/18, [ANN TAYLOR / ANNTAYLOR et al.](#), EU:T:2019:357, § 118-119, 124-125, 126

Bad faith of a partner — Power of representation

One of the three partners in the company that owned **CAFÉ DEL MAR** applied for the registration of this EUTM figurative mark. An invalidity application was filed by the two other partners in the company that owned **CAFÉ DEL MAR**. All the companies incorporated by the invalidity applicants and the EUTM proprietor belonged to the three partners equally. One of these companies, Can Ganguil, granted a power of representation to the EUTM proprietor to act on behalf of the company and to represent it (§ 39).

The power of attorney granted to act on behalf of the company and to represent it cannot be considered as an acknowledgement of the supremacy of the representative regards the other partners as to rights in the sign **Café del Mar**. Furthermore, even if the company's representative plays an outstanding role in the promotion and development of the sign, he is not entitled to use its power in his own name (§ 53).

By registering in his own name a trade mark generating confusion with the earlier sign **Café del Mar** while he was the representative of one of the companies exploiting that sign, and by paying the registration costs with funds from that company, he departed from accepted principles of ethical behaviour or honest commercial and business practices and therefore acted in bad faith (§ 54).

The fact that, for a certain period, the proprietor paid the profits obtained from the exploitation of the trade mark into the accounts of Can Ganguil is not relevant. This is because bad faith must be proven at the time of filing the application and the profits were paid later (§ 55).

Café del Mar

12/07/2019, T-772/17, [Café del Mar \(fig.\)](#), EU:T:2019:538, § 39, 53-55

Café del Mar

12/07/2019, T-773/17, [Café del Mar \(fig.\)](#), EU:T:2019:536, § 39, 53-55

Bad faith — Same overall impression of the signs

The invalidity applicants and the proprietor had used the figurative sign **Café del Mar** since 1980 when they opened the music bar 'Café del Mar' in Ibiza (Spain). The sign was also used to distinguish the goods and services provided by various companies that the individual invalidity applicants and the proprietor had incorporated since 1987 (§ 35, 37).

The contested mark coincides in the letters 'c' and 'm' with the initial letters of the terms of the earlier sign, in the preposition 'del', and also the typography is identical. The contested mark is the abbreviation of the earlier figurative sign and therefore the signs may produce the same overall impression (§ 49).

The bar 'Café del Mar' became well known over the course of the years and its activities expanded to include music products, clothing and merchandising bearing the figurative sign **Café del Mar** (§ 43, 50). It cannot be excluded that leather goods are sold within the framework of the sale of clothing and fashion accessories, and umbrellas and perfumes may be part of the merchandising goods of a cafeteria or may be offered as fashion accessories (§ 52).

Therefore, the contested mark is not completely different to the earlier figurative sign **Café del Mar** and is registered for goods and services at least partially similar to those distinguished by the earlier sign (§ 53).



12/07/2019, T-774/17, [C del M \(fig.\)](#), EU:T:2019:535, § 35, 37, 49, 52-53

Bad faith — Potentially descriptive character of a common element

Where certain objective circumstances show that the EUTM proprietor filed the mark in bad faith, the potentially descriptive character of the element common to both signs cannot prevail over the finding of bad faith (§ 69).

The proprietor acted in bad faith when, shortly after the invalidity applicant refused cooperation, it requested registration of the EUTM specifically containing the element 'outsource2india', used by the invalidity applicant in its commercial activities (§ 70).



13/11/2019, C-528/18P, [Outsource 2 India \(fig.\)](#), EU:C:2019:961, § 69-70

17.2.2 Factors unlikely to indicate the existence of bad faith

LOC not a prerequisite of bad faith

LOC is not a prerequisite of bad faith. In the absence of any LOC between the sign used by a third party and the contested EUTM, other factual circumstances may constitute relevant and consistent indicia establishing the bad faith of the EUTM applicant (§ 56).



12/09/2019, C-104/18P, [STYLO & KOTON \(fig.\)](#), EU:C:2019:724, § 56

No need for LOC — No need for identical similar signs — No need for reputation

To prove bad faith, it is not necessary to systematically establish the existence of a LOC between an earlier trade mark and the contested mark (§ 56-57). In particular, it is not mandatory to show the presence in the European Union of a sign identical or similar to the sign for which registration is sought for identical or similar goods or services, giving rise to a LOC (§ 52-57). A correlation between the goods or services (i.e. between watches and clothing) is sufficient (§ 58, 64-65, 69-72). Furthermore, it is not necessary to systematically establish a reputation of the earlier mark in the European Union (§ 59-61).



ANN TAYLOR 23/05/2019, T-3/18 and T-4/18, [ANN TAYLOR / ANNTAYLOR et al.](#), EU:T:2019:357, § 52-58, 64-65, 69-72

Existence of cooperation, correspondence or a distribution agreement

The existence of cooperation, correspondence or a distribution agreement with the director of the EUTM proprietor does not, on its own, prove bad faith. The mark was not mentioned in the emails, nor is there any information relating to its use with respect to the specific goods or services (§ 90-93, 96). The mention of the company name without any relation to identical or similar goods does not lead to a contrary conclusion (§ 91). Knowledge of the use of the earlier mark cannot be presumed since use, if any, was limited to a maximum of 16 months (§ 94-95). Nor can there be any assumption of such knowledge inferred from the fact that the directors of the parties knew each other and that a degree of collaboration existed between them when different companies, marks and goods were concerned (§ 97). The identity of the signs does not suffice on its own to prove such knowledge. The sign is a relatively simple combination, consisting of a reference to the moulding sector and the suffix 'pro', a common abbreviation of the word 'professional' (§ 98). Mere knowledge that the sign was used as a company name does not point to a dishonest intention (§ 104). Nor did the invalidity applicant prove that the EUTM proprietor sought to keep it out of the German market (§ 103). The fact that the EUTM proprietor used its mark supports the conclusion that the filing was made in good faith (§ 105).

14/02/2019, T-796/17, [MOULDPRO](#), EU:T:2019:88, § 90-93, 96, 94-95, 97, 98, 103, 104, 105

17.3 PROOF OF BAD FAITH

Means of evidence

Bad faith can be proved on the basis of sworn written statements of the invalidity applicant's lawyers, acting as independent third parties (§ 94-99), or an email exchange between the lawyers of both parties establishing an attempt to obtain a licence agreement prior to the application of registration (§ 84-88). The use of these communications in the context of invalidity proceedings is not precluded, since they do not constitute a correspondence between lawyer and client that might be qualified as confidential (§ 102-103).

23/05/2019, T-3/18 and T-4/18, [ANN TAYLOR / ANNTAYLOR et al.](#), EU:T:2019:357, § 84-88, 102-103

17.4 RELATION TO OTHER EUTMR PROVISIONS

[No key points available yet.]

17.5 EXTENT OF INVALIDITY

CHAPTER III — RELATIVE GROUNDS FOR REFUSAL / INVALIDITY

1 ARTICLES 8(1)(a), 53(1)(a) EUTMR — IDENTICAL SIGNS / G&S

[No key points available yet.]

2 ARTICLES 8(1)(b), 53(1)(a) EUTMR — LIKELIHOOD OF CONFUSION

2.1 RELEVANT PUBLIC AND DEGREE OF ATTENTION

2.1.1 Relevant part of the public

Consideration of the list of goods and services protected by the mark

The rights conferred by the mark extend to the goods and services for which it is protected. When determining the relevant public, the list of goods and services protected by the mark has to be taken into account rather than products that are actually marketed under the mark in question. As long as the list has not been amended, the commercial decisions taken by the proprietor of the mark do not influence the definition of the relevant public (§ 39, 40).

20/06/2019, T-389/18, [WKU / WKA et al.](#), EU:T:2019:438, § 39, 40

Consideration of only a part of the relevant public

The BoA may take only part of the public in the EU into account insofar as it is sufficient to refuse a trade mark registration on a relative ground under Article 8(1)(b) EUTMR (§ 21).

11/02/2020, T-732/18, [charantea / CHARITÉ \(fig.\)](#), EU:T:2020:43, § 21

11/02/2020, T-733/18, [charantea \(fig.\) / CHARITÉ \(fig.\)](#), EU:T:2020:42, § 21

Consideration of the part of the public with the lowest level of attention

When a section of the relevant public consists of professionals with a higher level of attention and another section of the relevant public consists of reasonably observant and circumspect average consumers, the public with the lowest level of attention must be taken into consideration for assessing LOC (§ 36).

25/06/2020, T-114/19, [B \(fig.\) / b \(fig.\)](#), EU:T:2020:286, § 36.

2.1.2 Level of degree of attention

Enhanced level of attention — Air, rail transport or maritime services

Although it is true that the general public does not necessarily pay an above-average level of attention to the purchase of certain air, rail transport or maritime services, in relation to the chartering of merchant ships, chartering [brokerage of ship cargoes], transport and freight

brokerage services, (transport of goods by ship), the general public will pay an enhanced level of attention comparable to that of professionals (§ 23).

03/04/2019, T-468/18, [CONDOR SERVICE, NSC \(fig.\) / ibercóndor transportes internacionales y aduanas \(fig.\) et al.](#), EU:T:2019:214, § 23

Enhanced level of attention — Pharmaceutical, medical and veterinary fields

In the pharmaceutical, medical and veterinary fields, the general public, much like specialists, display a heightened degree of attentiveness, even in respect of goods without a prescription, since they affect, to a greater or lesser degree, health. Similarly, dietetic substances adapted for medical use may be regarded as products to which a higher than average level of attention is paid (§ 26).

28/11/2019, T-642/18, [DermoFaes Atopimed / Dermowas](#), EU:T:2019:819, § 26

28/11/2019, T-643/18, [DermoFaes / Dermowas](#), EU:T:2019:818, § 26

28/11/2019, T-644/18, [DermoFaes AtopiDerm / Dermowas](#), EU:T:2019:817, § 26

Degree of attention — Mass consumption goods

The goods in Classes 18 and 25 are mass consumption goods, frequently purchased and used by the average consumer. The degree of attention of the relevant public is no higher than average since the goods in question are not costly or rare and no specific knowledge is required for their purchase (20/10/2009, T-307/08, 4 OUT Living, EU:T:2009:409, § 21) (§ 26-28).

15/07/2020, T-371/19, [FAKEDUCK \(fig.\) / Save the duck \(fig.\) et al.](#), EU:T:2020:339, § 26-28

2.2 COMPARISON OF THE GOODS AND SERVICES

2.2.1 Identity

[No key points available yet.]

2.2.2 Similarity

Comparison of goods and services — Assessment — Burden of proof

When carrying out the comparison to assess whether there is a likelihood of confusion, it is necessary to take into account the services covered by the marks, not the services actually marketed under those marks (21/09/2017, T-620/16, Idealogistic (fig.) / IDEA et al., EU:T:2017:635, § 35) (§ 48).

The opposing party is not obliged, in opposition proceedings, to adduce evidence as to the similarity of the services at issue (09/02/2011, T-222/09, Alpharen, EU:T:2011:36, § 22) (§ 51).

08/07/2020, T-328/19, [SCORIFY \(fig.\) / Scor et al.](#), EU:T:2020:311, § 48, 51

2.2.3 Scope of the list of goods and services

Declaration under Article 28(8) CTMR 2016 [now Article 33(8) EUTMR]

The declaration under Article 28(8) CMTR 2016 [now Article 33(8) EUTMR] has retrospective effect. However, it is not intended to allow the addition of new goods or services to the protection

enjoyed by the contested mark, but to ensure that, following the expiry of the period referred to in the third subparagraph of Article 28(8) CTMR, the goods or services covered by that declaration continue to enjoy protection even though they are not clearly covered by the literal meaning of the indications included in the class headings (§ 50). Therefore, a decision, by which a mark is declared invalid, although adopted before a declaration under Article 28(8) CTMR, concerns all the goods and services for which the contested mark was registered, including those covered by the declaration under Article 28(2) CTMR (§ 51).

15/05/2019, C-653/17 P, [Vermögensmanufaktur](#), EU:C:2019:406, § 50-51

Application *ratione temporis* of the requirements of the Praktiker judgment — Registration date — Right of priority — International registrations designating the EU

The right of priority has effect only when it is necessary to determine the priority of conflicting signs and therefore has no effect on the date of registration of a trade mark if this is not the same as its priority date (§ 36).

For the application of the requirements resulting from the judgment of 07/07/2005, C-418/02, Praktiker, EU:C:2005:425, the relevant date is the date of registration of the EU trade mark concerned, namely the date of its final registration, which must be after the delivery of that judgment (§ 38). Such requirements are intended to apply to international registrations designating the EU for which registration was granted after the judgment was delivered, even if the filing date of the application was earlier than that judgment, and even if the protection conferred by the registration is retroactive to the date of the application (§ 44).

29/01/2020, T-697/18, [ALTISPORT \(fig.\) / ALDI et al.](#), EU:T:2020:14, § 36, 44

Vaguely defined terms — Complex goods — ‘Parts’ and ‘accessories’

An EUTM proprietor cannot gain from the vague wording of the goods covered by its marks. In particular, in the event of complex goods (in the case at issue *head ends for cable networks*), the terms ‘parts’ and ‘accessories’ used in the wording of the goods are vaguely defined terms and cannot be taken into account when assessing the similarity or complementarity of goods and services (§ 30).

26/03/2020, T-312/19, [Chameleon / Chameleon](#), EU:T:2020:125, § 30

Vaguely defined terms followed by the expression ‘in particular’

Since the goods covered by the earlier mark are not described solely as *goods made of leather and imitations of leather*, but have been listed more precisely (*in particular bags, trunks and travelling bags; suit bags, wallets, purses, key cases, cases for writing utensils, cases for cutlery; umbrellas, parasols and walking sticks*), the protection of the earlier mark extends only to those finished goods made of leather and imitations of leather primarily used to carry, bring and contain small items (§ 51-53).

25/06/2020, T-114/19, [B \(fig.\)-B \(fig.\)](#), EU:T:2020:286, § 51-53.

Explanatory notes of the Nice Classification

Notwithstanding the fact that the Nice Classification was adopted for exclusively administrative purposes, the explanatory notes on the different classes of that classification are relevant in determining the nature and purpose of the goods and services under comparison (§ 38).

09/09/2019, T-575/18, [The Inner Circle / InnerCircle](#), EU:T:2019:580, § 38

2.2.4 Particular industries

2.2.4.1 Chemicals, pharmaceuticals and cosmetics

Food, nutritional, dietary and vitamin supplements — Creams for medical use — Common purpose

Food, nutritional, dietary and vitamin supplements and creams for medical use in Class 5 are similar, to at least a low degree, due to their common general intended purpose, their several specific intended purposes, their possible joint use and the identity of their distribution channels (§ 75).

28/05/2020, T-724/18 & T-184/19, [AUREA BIOLABS \(fig.\) / Aurea et al.](#), EU:T:2020:227, § 75

2.2.4.2 Automobile industry

Bicycles and motorcycles — Parts and accessories of bicycles and motorcycles

Bicycles and *motorcycles* in Class 12 are similar to a low degree (§ 28-30 and 33). The same applies to *parts and accessories of bicycles* and *parts and accessories of motorcycles* in Class 12 (§ 37), and *bicycle sports helmets* and *protective clothing for motorcyclists* in Class 9 (§ 41-42).

14/05/2019, T-12/18, [Triumph / TRIUMPH](#), EU:T:2019:328, § 28-30, 33, 37, 41-42

Accessories — Caravans, and spare parts therefor in Class 12

Accessories (included in Class 12); car accessories, namely trailer couplings, luggage racks, ski racks, mudguards, snow chains, wind deflectors are identical to *caravans, and spare parts therefor* in Class 12, since accessories are parts intended to supplement a main object and fall under the broader category of parts (§ 36-37).

27/02/2020, T-202/19, [Caratour / Carado et al.](#), EU:T:2020:75, § 36-37

27/02/2020, T-203/19; [Caratwo / Carado et al.](#), EU:T:2020:76, § 36-37

Various bicycles and moving vehicles for children — Vehicles — Apparatus for locomotion by land

Various bicycles and *moving vehicles for children* in Class 12 cannot be considered identical. There is only a weak similarity between these goods (§ 86).

The various *vehicles and apparatus for locomotion by land* in Class 12 are in part identical (cars; motorcycles; scooters), in part similar to a low degree (*e-bicycles; e-bikes; bicycles; bicycles for grown-ups; trekkingbikes; citybikes; BMX-bikes; racingbikes; foldingbikes; crossbikes; moutainbikes; bicycles for adolescent; bicycles for children*), and in part similar to an average

degree (*buggies*) to *means of transport, excluding bicycles and children's bicycles; moving vehicles for children* in Class 12 (§ 88).

28/11/2019, T-736/18, [Bergsteiger / BERG \(fig.\) et al.](#), EU:T:2019:826, § 88

2.2.4.3 Electric apparatus/instruments

Lighting apparatus for industrial use — Electric lights and decorations

The goods under comparison have different purposes, namely practical and industrial purposes for the IR's goods, whereas the goods covered by the earlier marks are exclusively intended for decorative and aesthetic purposes for Christmas trees (§ 43). *Lighting apparatus for industrial use*, on the one hand, and *electric lights and decorations*, on the other hand, cannot be deemed to be similar on the mere basis that they are both *light sources* or *electrical lighting apparatus*. The fact that they might have the same distribution channels, are sold through the same commercial establishments and are used by the same customers is not sufficient for similarity. Finally, the goods covered by the IR are purchased mainly by professionals, while the relevant goods of the earlier marks are, as a rule, intended for the general public (§ 47-51).

19/03/2019, T-133/18, [Lumiqs \(fig.\) / Lumix et al.](#), EU:T:2019:169, § 43, 47-51

2.2.4.4 Fashion and textile industries

Sport articles and clothes

Luggage and bags (especially sport bags) share their nature and intended purpose with *golf bags and caddy bags* namely to transport items necessary for sport (§ 57). *Clothing* includes *sport clothing* and therefore *golf gloves*. Both may be sold in the same retail outlets, specifically sport shops. The goods are similar at least to a low degree (§ 61-63).

26/03/2019, T-105/18, [LILI LA TIGRESSE / TIGRESS](#), EU:T:2019:194, § 57, 61-63

Clothing, footwear and headgear — Leather and imitations of leather and animal skins

Goods cannot be regarded as complementary on the ground that one is manufactured with the other (§ 36). There is no similarity between *clothing, footwear and headgear* and *leather and imitations of leather and animal skins* (§ 37).

Such complementarity not being a well-known fact, the similarity between *clothing, footwear, headgear* in Class 25 and *trunks and travelling bags, umbrellas, walking sticks, whips, harness and saddlery* in Class 18 needs to be proven by the party claiming it (§ 38).

Clothing, footwear and headgear of Class 25 and *jewellery, jewellery, horological and chronometric instruments* in Class 14, are in general not associated with one another and are generally not produced by the same undertakings. Since it is not a matter of generally well-known facts, it is up to the party alleging similarity to prove the reality and alleged complementarity between the goods (§ 50-51).

27/06/2019, T-385/18, [CRONE \(fig.\) / crane \(fig.\) et al.](#), EU:T:2019:449, § 36-38, 50-51

Leather and imitations of leather — Goods made of leather and imitations of leather — Animal skins, hides — Home textiles

Leather and imitations of leather in Class 18 are not similar to *goods made of leather and imitations of leather* in Class 18 (§ 54-59).

Animal skins, hides in Class 18 and *home textiles* in Class 24 are dissimilar (§ 60-61).

25/06/2020, T-114/19, [B \(fig.\) / b \(fig.\)](#), EU:T:2020:286, § 54-59, 60-61.

Gymnastic and sports articles — Games and toys

In certain cases, an exact delimitation between *gymnastic and sports articles* and *games and toys* is difficult (§ 50).

A 'continuous shift' is not entirely excluded between the clothing industry and the games industry on the basis that there is a tendency for game and toy manufacturers to also manufacture sports clothing, for example, which is particularly suitable for games, and vice versa (§ 51).

29/01/2020, T-697/18, [ALTISPORT \(fig.\) / ALDI et al.](#), EU:T:2020:14, § 50-51

Orthopaedic footwear and boots for medical purposes — Health shoes

Orthopaedic footwear and *boots for medical purposes* in Class 10, and *health shoes* in Class 25 are similar to a low degree (§ 53). They target a public composed of professionals and consumers who suffer from orthopaedic problems, whose level of attention is high (§ 41, 45).

The explanatory notes of the Nice Classification have to be taken into account since they are relevant in determining the nature and purpose of the goods and services under comparison. The explanatory note relating to Class 25 excludes *orthopaedic footwear*, which falls in Class 10. This leads to the conclusion that *orthopaedic footwear* or *footwear for medical purposes* must primarily be regarded as medical apparatus since their primary function is correcting physical handicaps of an orthopaedic nature (§ 55).

Contrary to *footwear*, *orthopaedic footwear* is directly prescribed by a physician or sold in specialised shops (§ 56). It is not produced industrially or in a standardised manner, but is tailored to each patient's needs (§ 57).

08/07/2020, T-20/19, [Mediflex easystep / Stepeasy \(fig.\)](#), EU:T:2020:309, § 41, 45, 53, 55, 57

08/07/2020, T-21/19, [mediFLEX easySTEP \(fig.\) / Stepeasy \(fig.\)](#), EU:T:2020:310, § 41, 45, 53, 55, 57

2.2.4.5 Food, beverages and restaurant services

Chips — Tortillas, tacos, cereal preparations, bread

Chips and the contested goods (inter alia, *tortillas, tacos, cereal preparations, bread, snack foods products made from wheat, popcorn*) are distributed through the same channels and they may be manufactured by the same undertakings (§ 47-48, 54, 60, 65).

The contested goods can be consumed at any time of the day to satisfy a nutritional need, or as appetisers. Furthermore, some can be used as side dishes like the opponent's *chips* (§ 43, 53, 57, 59, 64). Therefore, they were considered similar or similar to a low degree (§ 49, 55, 61, 66).

17/09/2019, T-464/18, [Tia Rosa \(fig.\) / TÍA ROSA \(fig.\)](#), EU:T:2019:607, § 43, 47-49, 53-55, 57, 59-60, 64-66

Alcoholic drinks — Non-alcoholic drinks

There is no similarity between alcoholic drinks such as *beers* and non-alcoholic drinks such as *coffee*, although they can be consumed together. The goods are dissimilar in that their nature, intended purpose and method of use are different. The beverages are consumed on different occasions and serve to satisfy different needs on the part of the consumer (§ 25-43).

12/12/2019, T-648/18, [Crystal / CRISTAL](#), EU:T:2019:857, § 25-43

2.2.4.6 Services to support other businesses

[No key points available yet.]

2.2.4.7 Retail services

Retail services and related goods — Similarity

There is a similarity between goods and the retail services which relate to those goods (16/10/2013, T-282/12, *Free your style.*, EU:T:2013:533, § 37) (§ 29).

28/05/2020, T-333/19, [GN Genetic Nutrition Laboratories \(fig.\) / GNC GENERAL NUTRITION CENTERS et al.](#), EU:T:2020:232, § 29

Concept of ‘retail services’ — Precise statement of the goods to which the retail services relate

The concept of ‘retail services’ covers services, offered to consumers, consisting of bringing together, on behalf of the businesses occupying a shopping arcade’s stores, a variety of goods in a range of stores to enable the consumer to conveniently view and purchase those goods, and offering a variety of services separate from the act of sale that seek to ensure that that consumer purchases the goods sold in those stores (§ 127).

The concept of ‘retail services’ includes a shopping arcade’s services for consumers with a view to enabling them to conveniently view and purchase the goods (§ 130).

The case-law precedent set by the *Praktiker* judgment (07/07/2005, C-418/02, , EU:C:2005:425) only concerns applications for registration and does not concern trade marks registered at the date of that judgment’s delivery (§ 133).

If an opposition is based on Article 8(1)(b) EUTMR and an earlier trade mark covering retail services that was registered after the *Praktiker* judgment’s delivery, that ground of opposition may not be rejected simply because of the absence of a precise statement of the goods to which the retail services relate (§ 134).

04/03/2020, C-155/18 P to C-158/1 P, [BURLINGTON /BURLINGTON ARCADE et al.](#), EU:C:2020:151, § 127, 130, 133, 134

Scope of protection of *retail sales services* — Proof of use

The earlier Spanish mark was registered for *retail sales services* before the *Praktiker* judgment (07/07/2005, C-418/02, *Praktiker*, EU:C:2005:425), which required further clarification of the services but did not apply retroactively. There had been a request for proof of use and the BoA found use for *retail services for handbags, purses and wallets made from leather, ready-made clothing and footwear*.

The GC stated that the term 'retail sales services' is not a vague term and covers the retail sale of any goods (§ 39) and endorsed the BoA's finding of proof of use for *retail services for handbags, purses and wallets made from leather, ready-made clothing and footwear* (§ 40-41).

26/03/2020, T-653/18, [GIORGIO ARMANI le Sac 11 \(fig.\) / LESAC et al.](#), EU:T:2020:121, § 39, 40-41
26/03/2020, T-654/18, [le Sac 11 \(fig.\) / LESAC et al.](#), EU:T:2020:122, § 39, 40-41

Spectacles — Retail store services for sunglasses — Robes — Household textiles and linen

Spectacles is a broad term including *sunglasses*. Consequently, *spectacles* and *retail store services for sunglasses* have an average degree of similarity (§ 69, 71). *Robes* include bathrobes which are often absorbent robes worn before or after bathing and *household textiles and linen* include towels used to absorb moisture. They also have an average degree of similarity (§ 72-73).

12/07/2019, T-54/18, [1st AMERICAN \(fig.\) / DEVICE OF A BIRD \(fig.\)](#), EU:T:2019:518, § 69, 71, 72-73

Games — Service of retailing of sporting goods

The goods *games* in Class 28 covered by the mark applied for are dissimilar to the *service of retailing of sporting goods* in Class 35 (§ 47). There is no complementarity between them and it has not been shown that they have the same distribution channels. The mere fact that the goods and services might be targeted at the same public is not sufficient to find similarity between them (§ 44-47, 50-51).

04/12/2019, T-524/18, [Billa / BILLABONG et al.](#), EU:T:2019:838

Health products — Wholesale and retail services

There exists a complementary relationship, and thus similarity, between goods which can be grouped under a relatively broad category, such as *health products*, and services such as *wholesale and retail services* which cover the same broad category, for example 'wholesale and retail services relating to health products'. The goods and services are closely connected since the goods are indispensable, or at least important, for the provision of the services in question (§ 29-30).

24/01/2019, T-800/17, [FIGHT LIFE / FIGHT FOR LIFE](#), EU:T:2019:31, § 29-30

2.2.4.8 Financial services

[No key points available yet.]

2.2.4.9 Transport, packaging and storage

[No key points available yet.]

2.2.4.10 Information technology

Head ends for cable networks — ‘parts’ and ‘accessories’ — Vaguely defined terms

An EUTM proprietor cannot gain from the vague wording of the goods covered by its marks. In particular, in the event of complex goods, the terms ‘parts’ and ‘accessories’ used in the wording of the goods are vaguely defined terms and cannot be taken into account for assessing the similarity or complementarity of goods and services (§ 30).

26/03/2020, T-312/19, [Chameleon / Chameleon](#), EU:T:2020:125, § 30

2.2.4.11 Education

Teaching and instructional and teaching material — Teaching and CDs, CD-ROMs, DVDs, computer software

Teaching and instructional and teaching material (except apparatus) are similar (§ 45).

Teaching and CDs, CD-ROMs, DVDs; computer software; electronic publications (downloadable); audio and video files (downloadable) are similar since these goods are commonly used for offering teaching services (§ 46).

24/09/2019, T-497/18, [IAK / IAK - Institut für angewandte Kreativität](#), EU:T:2019:689, § 45-46

2.2.4.12 Other

Products and preparations for the breeding of birds, reptiles and amphibians — Food for fish

Products and preparations for the breeding of birds, reptiles and amphibians in Class 31 and *veterinary, therapeutic, disinfecting and sanitary products and preparations for use in terraristics* in Class 5, on the one hand, and *food for fish*, on the other, are dissimilar because it is unlikely that ‘a consumer who wishes to set up an aquarium or breed fish will also buy goods intended for birds, reptiles or amphibians’ (§ 57). The mere fact that these goods fall within the same market segment and use the same distribution channels is insufficient for finding them similar (§ 41, 61).

12/07/2019, T-276/17, [Tropical \(fig.\) / TROPICAL](#), EU:T:2019:525, § 41, 57, 61

2.3 COMPARISON OF THE SIGNS

2.3.1 Distinctive and dominant elements

2.3.1.1 Banal elements

[No key points available yet.]

2.3.1.2 Negligible elements

Illegible sign

Not only must a sign which is actually impossible to read or decipher be regarded as illegible, but also a sign which is so difficult to decipher, understand or read that a reasonably observant and circumspect consumer cannot manage to do so without making an analysis that goes beyond what may reasonably be expected of him in a purchasing situation (§ 41).

Global assessment. The elements that differentiate the signs visually, phonetically and conceptually, namely the predominance of the figurative element of the sign applied for, the structure of that sign and the logical unit formed by its word and figurative elements considered as a whole, are sufficient for it to be found that, when faced with the signs, the relevant public will not make a connection between them, since those factors as a whole create a genuine dichotomy visually, phonetically and conceptually between the signs (§ 116).



19/06/2019, T-28/18, [AC MILAN \(fig.\) / AC et al.](#), EU:T:2019:436, § 41, 116

2.3.1.3 Disclaimers

Preliminary ruling — Disclaimer — Article 4(1)(b) Directive 2008/95

A disclaimer provided for by national law whose effect was to exclude an element of a complex trade mark, mentioned in the disclaimer, from the analysis of the relevant factors for establishing the existence of a LOC within the meaning of Article 4(1)(b) of Directive 2008/95 because that element is descriptive or not distinctive, would not be compatible with the requirements of that provision (§ 46).

A disclaimer provided for in national law whose effect were to attribute, in advance and permanently, a lack of distinctiveness to the element of a complex trade mark mentioned by it, so that that element has only limited importance in the analysis of the LOC within the meaning of Article 4(1)(b) of Directive 2008/95, would also be incompatible with the requirements of that provision (§ 52).

12/06/2019, C-705/17; [Mats Hansson](#), EU:C:2019:481, § 46, 52

2.3.1.4 Composite marks

Distinctive verbal elements

The prefix 'trico', in Italian, belongs to scientific terminology and not to common or current language (§ 111). The documents submitted in the proceedings before the Office did not allow the conclusion that the general Italian public, without having studied ancient Greek or without having any particular technical knowledge, would recognise the term 'trico' as a prefix meaning 'hair' (§ 112-113).



19/09/2019, T-359/18, [TRICOPID / TRICODIN \(fig.\)](#), EU:T:2019:626, § 112-113

Simple figurative element and verbal element

Although it cannot be ruled out that the figurative element in the EUTM application may attract the consumer's attention, it is unlikely that the consumer will refer to the mark applied for by describing that element which represents a simple geometric form (§ 59).

Where the verbal element of a mark is substantially longer than the figurative element of that mark, it attracts more attention on the part of the average consumer because of its larger size (06/09/2013, T-349/12, Revaro, EU:T:2013:412, § 19, 24) (§ 60).



08/07/2020, T-328/19, [SCORIFY \(fig.\) / Scor et al.](#), EU:T:2020:311, § 59, 60

Words with meaning in foreign languages

Since a knowledge of a foreign language may not, in general, be presumed (§ 48), the fact that it had been stated that the verbal element 'Bimbo' (meaning 'child') is descriptive for the Italian public in connection with goods in Class 30 does not have any impact on the distinctive character of that element for the Spanish public, i.e. the public whose perception was taken into account in this case, which is not expected to know the meaning of the word 'Bimbo' in Italian (§ 49).



17/01/2019, T-368/18, [ETI Bumbo / BIMBO \(fig.\)](#), EU:T:2019:15, § 48-49

Relevant public's knowledge of a language other than its mother tongue — Burden of proof

Since knowledge of English on the part of the Polish and Spanish public is not a well-known fact (in contrast to the knowledge of English on the part of, inter alia, the Swedish public) and since the sector in question (additives in the manufacture of foods and beverages) is not one of those in which English is frequently or normally used (in contrast to the technology or computing sectors), it was for the applicant to provide, in the course of the administrative proceedings, evidence to highlight the relevant public's knowledge of a language other than its mother tongue (§ 63).

29/04/2020, T-108/19; [TasteSense By Kerry \(fig.\) / Multisense et al.](#), EU:T:2020:161, § 63

29/04/2020, T-109/19; [TasteSense \(fig.\) / Multisense et al.](#), EU:T:2020:162, § 63

Relevant public's knowledge of a language other than its mother tongue — Burden of proof

The understanding of a word sign may be assumed for a territory in which the language of the sign is the native language of that territory's population. It must be proved in territories in which the relevant language is not the population's native language, unless a sufficient knowledge of the language of the sign on the part of the target public in those territories is a well-known fact (26/11/2008, T-435/07, New Look, EU:T:2008:534, § 22 (§ 63)).

Basic English words are understood by a large part of the EU public. In this case there is no need to decide whether the Polish-speaking public's knowledge of basic English vocabulary is a well-known fact since the term 'impress' is not basic English vocabulary. This public cannot be presumed to have an understanding of this term and it must therefore be proved (§ 64, 70).

29/04/2020, T-37/19, [cimpres / p impress \(fig.\) et al.](#), EU:T:2020:164, § 63-64, 70

Breaking down of verbal elements — Common element

Faced with a basic verbal element that is easily understood throughout the EU, the relevant public will break down the sign into two parts, one corresponding to a word that it understands as part of everyday language and the other consisting of the rest of the sign, even if the other part does not suggest a specific meaning or does not resemble words that the relevant public knows (§ 59). Therefore, the English-speaking relevant public will immediately understand the sign applied for as a combination of 'meat' and 'love', and will break down the earlier sign into two verbal elements, 'carni' and 'love' (§ 60). Although the concepts of 'love of carnivores/meat eaters' and 'love of meat' are not identical, they both refer to a feeling of affection for or great pleasure in something

connected with meat. At least for the English-speaking relevant public, there is a conceptual low degree of similarity despite the low distinctive character of the common element 'love' (§ 61-72).

03/10/2019, T-491/18, [Meatlove / carnilove](#), EU:T:2019:726, § 59, 60, 61-72

Breaking down of verbal elements — Common element

There is no evidence that, for a significant part of the relevant public, in particular for German-speaking consumers, the prefix 'noc[u]' would be perceived as referring to the terms 'nocturia' or 'nocturnal' (night) and therefore as being descriptive of the goods in question. Therefore, for this part of the public, the coincidence in the first four letters renders the marks visually and phonetically similar to an average degree (§ 72-73). No conceptual comparison can be made as the words in question have no meaning for the consumers (§ 74). The signs are similar to an average degree (§ 75).

06/03/2019, T-321/18, [NOCUVANT/ NOCUTIL et al.](#), EU:T:2019:139, § 72-75

Breaking down of verbal elements — Common element

In view of the different endings of the words 'aquaprint' and 'aquacem' and the weak distinctive character of the common element 'aqua', the existence of misrepresentation in this case is excluded, since the offer of the goods in the UK under the trade mark applied for, AQUAPRINT, is not likely to lead the public to attribute the commercial origin of these goods to the applicant, which markets its goods under the signs AQUACEM and AQUASIL (§ 107-108).

23/05/2019, T-312/18, [AQUAPRINT / AQUACEM et al.](#), EU:T:2019:358, § 38-39, 55, 91

Distinctive and non-distinctive figurative elements

Flags are often used for decoration in the maritime sector and therefore have a low degree of distinctiveness (§ 56).



03/04/2019, T-468/18, [CONDOR SERVICE, NSC \(fig.\) / ibercóndor transportes internacionales y aduanas \(fig.\) et al.](#), EU:T:2019:214, § 56

Verbal elements and figurative elements

The verbal element 'OOF' of the mark applied for, which is easily recognisable and identifiable, is the distinctive and, compared with the figurative elements, dominant element. The bar above each letter 'O' and the use of the colours red and white for the letters 'OO' and 'F' are perceived as secondary decorative elements (§ 26).



10/10/2019, T-453/18, [OOF \(fig.\) / OO \(fig.\) et al.](#), EU:T:2019:733, § 26

Common verbal element in different positions

The letters 'mg' are the most distinctive element of the earlier mark (§ 35). The fact that the letters 'mg' are present in both marks is sufficient to establish the existence of phonetic and visual

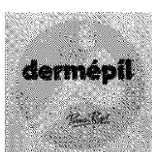
similarity between them, even though the position of these letters differs in the marks (§ 36). Therefore, there is a LOC (§ 44).

GINMG

03/10/2019, T-500/18, [MG PUMA / GINMG \(fig.\)](#), EU:T:2019:721, § 35-36, 44

Descriptive but dominant element

Although the relevant consumer generally does not consider a descriptive element forming part of a complex trade mark as a distinctive and dominant element, there may be special circumstances that justify the dominance of a descriptive element. This is the case, in particular, because of its position in the sign or its size, so that it may make an impression on consumers and be remembered by them, or the fact that the respective verbal elements occupy a central position in the marks at issue and dominate their overall image (29/06/2017, T-448/16, Mr. KEBAB (fig.) / MISTER K MR. KEBAP (fig.), EU:T:2017:459, § 28) (§ 128-135, 137).



13/06/2019, T-398/18, [DERMAEPIL SUGAR EPIL SYSTEM \(fig.\) / dermépil Perron Rigot \(fig.\)](#), EU:T:2019:415, § 128-135, 137

Weakly distinctive or descriptive but dominant element

That an element of a composite mark has weak distinctive character does not necessarily preclude it from constituting a dominant element, since it may, on account, in particular, of its position in the sign or its size, make an impression on consumers and be remembered by them (§ 46).

13/05/2020, T-63/19, [ПОШЕИ \(fig.\) / ПОМАШКИ \(fig.\)](#), EU:T:2020:195, § 46

Abbreviations

The verbal element 'Institut für angewandte Kreativität' of the earlier mark is, as a general reference to the proprietor's field of business, perceived as less distinctive than the inherently distinctive verbal element 'IAK'. The element 'IAK' does not in itself describe the services, so it possesses distinctive character. Even if it were perceived by the relevant public as an acronym of 'Institut für angewandte Kreativität', this circumstance, on its own, cannot prove that the distinctive character of the element 'IAK' is reduced in the perception of the sign as a whole (§ 65-66). The relevant public will perceive and remember the element 'IAK', irrespective of the element that follows it (§ 73).



24/09/2019, T-497/18, [IAK \(fig.\) / IAK - Institut für angewandte Kreativität](#), EU:T:2019:689, § 73

2.3.2 Visual comparison

Colours

The visual comparison of the signs must be carried out on the basis of all of their various constituent elements. The colours of the signs are constituent elements that must be taken into

account. By failing to take into account the marks' colours, even though these might constitute additional similarities, the BoA did not compare the marks in their entirety (§ 34).



Sole difference between the first letters of word marks

The difference between the first letters is not sufficient to counterbalance the identity of all the remaining letters which are also placed in the same order. The signs are visually (§ 43-48) and phonetically similar to an average degree (§ 49, 51-53).

25/06/2020, T-550/19, [Noster / Foster](#), EU:T:2020:290, § 49, 51-53

2.3.2.1 Word mark v figurative mark

Irrelevance of graphical or stylistic elements — Word mark

The graphical or stylistic elements of the mark applied for are irrelevant when it is a word mark (§ 60-61)



17/01/2019, T-368/18, [ETI Bumbo / BIMBO \(fig.\)](#), EU:T:2019:15, § 60-61

2.3.2.2 Figurative signs

Font — Pertinent element

The font is a pertinent element to take into consideration particularly if it is a stylised font that is not commonly used in the course of trade (§ 43-44).



24/09/2019, T-356/18, [V V-WHEELS \(fig.\) / VOLVO \(fig.\) et al.](#), EU:T:2019:690, § 43-44x

Description of the mark contained in the application — No relevance

The description of a mark that an applicant might file pursuant to Rule 3(3) CTMIR is not relevant for the assessment of the perception of that mark by the relevant public (§ 38).

The way in which the mark applied for is referred to in databases managed by the Office (eSearch plus or TMview) reflects the applicant's perception of the mark applied for and not that of the relevant public (§ 40).



08/07/2020, T-633/19, [\(fig.\) / TOTTO \(fig.\)](#), EU:T:2020:312, § 38, 40.

The earlier mark's reputation and distinctive character — No impact on the comparison between the signs — No impact on the determination of dominant elements

Unlike the factor of the similarity of the signs, the factor of the earlier mark's reputation and distinctive character does not involve a comparison between signs, but only concerns the sign registered by the opponent. Since those two factors are fundamentally different in scope, examination of one of them does not allow conclusions to be drawn concerning the other. Even where the earlier mark has a high degree of distinctive character by reason of its reputation, that fact does not make it possible to determine whether, or to what extent, that mark is visually, phonetically and conceptually similar to the mark for which registration is sought (§ 58).

The identification of the sign's dominant element may be relevant when comparing the signs, but it does not necessarily mean that the sign's reputation and degree of distinctive character, which concern it as a whole, make it possible to determine which of that sign's components is dominant in the relevant public's perception (§ 61).

The trade mark regulation cannot be understood as meaning that a trade mark's reputation or high level of distinctive character may lead to a finding that one of its constituent elements dominates over another for the purposes of assessing the similarity of signs (§ 62).



11/06/2020, C-115/19 P, [CCB \(fig.\) / CB \(fig.\) et al.](#), EU:T:2020:469, § 58, 61-62

2.3.3 Phonetic comparison

2.3.3.1 Elements to be taken into account

Different pronunciation in different languages

The English-speaking and the German-speaking parts of the relevant public pronounce the term 'wyld' differently and therefore the latter does not associate that term with 'wild' (§ 85).

26/11/2019, T-711/18, [Wyld / Wild Crisp et al.](#), EU:T:2019:812, § 85, 89

Number of syllables — Tonic stress — Overall impression by complete pronunciation

The different number of syllables in the word elements 'FAKEDUCK' and 'SAVE THE DUCK' is not enough to exclude phonetic similarity between the signs since the similarity will be assessed considering the overall impression made by their complete pronunciation (§ 49). Although the public usually gives more importance to the initial part of a mark, the fact that the tonic stress falls on the word 'duck' makes the marks highly similar (§ 50).

15/07/2020, T-371/19, [FAKEDUCK \(fig.\) / Save the duck \(fig.\) et al.](#), EU:T:2020:339, § 50

2.3.3.2 Figurative signs

No phonetic comparison

Since the mark applied for does not contain any verbal elements, there is no need for a phonetic comparison (§ 39)



12/12/2019, T-266/19; [\(fig.\) / gastivo \(fig.\) \(II\)](#), EU:T:2019:854, § 39

2.3.4 Conceptual comparison

2.3.4.1 Words

Possibility of a conceptual comparison

It is apparent from case-law that, in the conceptual comparison of the signs, where at least one of the signs conveys a concept that is understood by a significant part of the relevant public, a conceptual comparison is possible and cannot be qualified as neutral (§ 57-60, 66).

08/05/2019, T-37/18, [Brave Paper / BRAVO](#), EU:T:2019:300, § 57-60, 66

Possibility of a conceptual comparison

Conceptual differences can exist even if only one of the two compared signs has a clear meaning (§ 75-76).

12/07/2019, T-698/17, [MANDO / MAN \(fig.\) et al.](#), EU:T:2019:524, § 75-76
19/09/2019, T-176/17, [VEGA ONE \(fig.\) / Vegas et al.](#), EU:T:2019:625, § 82

Different pronunciation in different languages — Consequence for conceptual comparison

The English-speaking and the German-speaking parts of the relevant public pronounce the term 'wyld' differently and therefore the latter does not associate that term with 'wild' (§ 85). As a consequence of this phonetical assessment, the signs **wyld** and **WILD CRISP** are conceptually very similar only for the English-speaking part of the relevant public. For the German-speaking part of the relevant public, the mark **wyld** is void of any meaning (§ 89).

26/11/2019, T-711/18, [Wyld / Wild Crisp et al.](#), EU:T:2019:812, § 85, 89

2.3.4.2 Names

Signs having a name in common — One sign including a surname

When comparing signs that have in common a first name and differ in that only one of them includes a surname, it is to be considered, inter alia, how common in the relevant territory the surname is compared to the first name (§ 69-70).

08/02/2019, T-647/17, [CHIARA FERRAGNI \(fig.\) / Chiara](#), EU:T:2019:73, § 69-70

Sign comprising a surname and/or first name — Assessment of distinctive and dominant character

The assessment of the distinctive and dominant character of the sign's elements comprising a surname and/or first name must be conducted with an examination of all relevant factors, including their rarity or commonness in the Member States concerned (§ 44-45, 47).

22/05/2019, T-197/16, [ANDREA INCONTRI / ANDREIA et al.](#), EU:T:2019:347, § 44-45, 47

Distinctive character of a first name and a surname — Wine and alcoholic beverages

In the wine and alcoholic beverages sector, the use of a sign containing a combination of a first name and surname is a common practice. Therefore, even if the public is not familiar with a first

name (e.g. 'Jaume'), given the context, it could perceive it as such (§ 45). Depending on the circumstances of the case, the fact that a surname is unusual or very common may affect the distinctive character of the mark (§ 50). In the wine sector, when the conflicting signs consist of a first name that is not particularly rare or unusual and of surnames that are not particularly common in the relevant territory, the surnames are more distinctive than the first name (§ 53, 55).

The evidence submitted in relation to the earlier mark's reputation concerns the mark as a whole (i.e. first name and surname) and cannot be attributed only to one of the elements (i.e. 'Jaume') (§ 60).

Conceptual similarity has no bearing on the degree of similarity between signs where both signs represent a combination of first name and surname since they will be perceived as identifying two separate individuals coming from different families (§ 77-81).

The protection conferred by the registration is granted to the mark as a whole and not to each element separately (§ 86). Where it has not been proved that one of the elements (e.g. 'Jaume') is perceived separately in the earlier mark, the EUTM applied for cannot be considered as a sub-brand derived from the earlier mark (§ 87).

08/05/2019, T-358/18, [JAUME CODORNÍU / JAUME SERRA et al.](#), EU:T:2019:304, § 86-87

Signs consisting of first names and surnames — Wine sector— Conceptual comparison

A conceptual comparison between two signs consisting solely of first names and surnames is possible where the first name and surname in question have become the symbol of a concept, due, for example, to the celebrity of the person carrying that first name or surname, or where that first name or that surname has a clear and immediately recognisable semantic content (§ 86).

In the wine-growing world, names carry great weight, whether names or surnames of vineyards, since they are used to reference and designate wines. In general, it should be noted that consumers usually describe and recognise wines by reference to the verbal element that identifies them and that this element designates, in particular, the grower or the estate on which a wine is produced (11/07/2018, T-707/16, ANTONIO RUBINI / RUTINI (fig.) et al., EU:T:2018:424, § 49). Therefore, it is the distinctive element 'Sandrone' or the name as a whole, 'Luciano Sandrone', that will serve to identify the applicant's wines, but not the element 'Luciano' alone (§ 98-99).

27/06/2019, T-268/18, [Luciano Sandrone / DON LUCIANO](#), EU:T:2019:452, § 86, 98-99

2.3.4.3 Figurative signs, colours and shapes

Different overall impression

As regards the conceptual comparison, the signs are not similar to an average degree, as stated by the BoA, but different (§ 51). For part of the relevant public the term 'imagin' is likely to evoke the Spanish notion of 'imagen' or the Spanish verb 'imaginar', while the term 'imagic' is likely to evoke the Spanish term 'mágico' (§ 49). The overall impression produced by the signs is thus different. While the verbal element of the trade mark applied for is likely to evoke what is covered by image, imagination or imagination, the verbal element in the earlier trade mark will rather evoke the idea of magic (§ 50).



19/09/2019, T-761/18, [imagin bank \(fig.\) / imagic \(fig.\)](#), EU:T:2019:627, § 49-51

Different overall impression

The figurative element of the mark applied for is the dominant part since it is in a more visible position and is thus likely to occupy a position of greater importance, even if imperfectly, in the mind of the consumers. That element will not be perceived by the relevant public as the group of upper-case letters 'IJTI'. The close interconnection of the lines forming the element concerned will lead the consumer who forms part of the relevant public to perceive that element as an abstract and unitary shape rather than as a combination of four upper-case letters forming a group (§ 29). The verbal element 'i.j. tobacco industry' is not totally negligible but has a visually secondary position. It does not alter the assessment (§ 31). The overall impression created by the marks is different, as they do not display sufficient visual, phonetic or conceptual similarities (§ 45).



I.J. TOBACCO INDUSTRY
§ 29, 31, 45

19/12/2019, T-743/18, [I.J. TOBACCO INDUSTRY \(fig.\) / JTi \(fig.\)](#), EU:T:2019:872,

Conceptual dissimilarity — Differences in semantic content

The signs convey clear differences in their semantic content (§ 37-38). The mere fact that there is a generic word 'tree' which serves to describe the semantic content of the signs is not such as to establish conceptual similarity. The conflicting marks evoke the concept of 'tree' only in an indirect manner. Thus, the signs will not be perceived as representing an unidentifiable tree, but rather as evoking: (i) the silhouette of a fir tree, or an 'arbre magique' in the case of the international registration, and (ii) a deciduous tree, or the symbol of 'the tree of life' (§ 39).



30/01/2020, T-559/19, [Device of a white deciduous tree \(fig.\) / Device of a fir tree silhouette on a base \(fig.\)](#), EU:T:2020:19

2.3.4.4 Numbers, letters

Signs consisting of a single letter — Conceptual comparison

Single letters of the alphabet might have their own conceptual content, so there may be conceptual identity where the signs refer to the same letter of the alphabet (§ 82-84).



25/06/2020, T-114/19, [B \(fig.\) / b \(fig.\)](#), EU:T:2020:286, § 82-84

2.3.4.5 Geographical places

[No key points available yet.]

2.3.5 Conclusion / Other principles

2.3.5.1 Short signs

Short signs — Differences in one letter

Regarding the question as to whether a difference in one letter can exclude the similarity of the marks consisting of three letters each, no general rule can be derived from case-law (§ 56-58). Even if the relevant public may perceive differences more clearly in the case of abbreviations, whether the difference in one letter can lead to a different overall impression must be assessed on a case-by-case basis (§ 59).

20/06/2019, T-389/18, [WKU / WKA et al.](#), EU:T:2019:438, § 56-58, 59



20/06/2019, T-390/18, [WKU WORLD KICKBOXING AND KARATE UNION \(fig.\) / WKA et al.](#), EU:T:2019:439, § 56-58, 59, 73

2.3.5.2 Beginning of the marks

Trade marks composed of words from two different languages

In general, the relevant public does not assume that trade marks are composed of words from two different languages (§ 51). The mere fact that one element is placed at the beginning of the mark is not sufficient to confer on it dominant character (§ 57).

07/03/2019, T-106/18, [VERA GREEN / Lavera et al.](#), EU:T:2019:143, § 51, 57

2.3.5.3 Impact of a verbal element

Signs composed of both verbal and figurative elements

Where signs are composed of both verbal and figurative elements, the verbal element of the sign, in principle, has a greater impact on the consumer than the figurative element (§ 65).



20/06/2019, T-390/18, [WKU WORLD KICKBOXING AND KARATE UNION \(fig.\) / WKA et al.](#), EU:T:2019:439, § 65

2.4 DISTINCTIVENESS OF THE EARLIER MARK

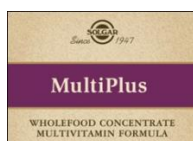
2.4.1 Inherent distinctiveness

Principle of coexistence of EU trade marks and national trade marks — Certain degree of distinctiveness of earlier national marks

A national mark on which an opposition is based is to be recognised as having a certain degree of distinctiveness (§ 40), referring to 24/05/2012, C-196/11 P, F1-Live, EU:C:2012:314, although this does not give rise to an unconditional right to oppose the registration of every later trade mark in which the term constituting the national mark appears (§ 40), referring to 13/05/2015, T-102/14, TPG POST / DP et al., EU:T:2015:279.

It follows that an element (in the EUTM applied for) that is identical to an earlier mark, which has been registered in a Member State, cannot be considered devoid of distinctive character when it is included in a later composite EUTM (§ 43, 45). Such a finding would be incompatible with the coexistence of EU trade marks and national trade marks (§ 43-44). Consequently, such an

element (of the EUTM applied for) is to be accorded at least a very low degree of distinctiveness (§ 46).



07/05/2019, T-152/18 and T-155/18, [SOLGAR Since 1947 MultiPlus WHOLEFOOD CONCENTRATE MULTIVITAMIN FORMULA \(fig.\) / MULTIPLUS](#), EU:T:2019:294, § 43-44, 46

Certain degree of distinctiveness of earlier national marks

In order to avoid infringing Article 8(1)(b) CTMR [now Article 8(1)(b) EUTMR], it is necessary to acknowledge a certain degree of distinctiveness of a national mark relied on in support of an opposition to the registration of a trade mark (24/05/2012, C-196/11 P, F1-Live, EU:C:2012:314, § 47) (§ 139-142).



13/06/2019, T-398/18, [DERMAEPIL SUGAR EPIL SYSTEM \(fig.\) / dermépil Perron Rigot \(fig.\)](#), EU:T:2019:415, § 139-142

Certain degree of distinctiveness of earlier national marks

The distinctive character of the earlier mark cannot be questioned in opposition proceedings. The earlier mark is presumed to have sufficient distinctive character to have been registered (§ 53). The assessment of the LOC, in this case, should be based on the fact that the earlier mark has a low degree of inherent distinctiveness (§ 65), a fact which does not exclude the LOC (§ 66).



10/09/2019, T-744/18, [Silueta en forma de elipse discontinua \(fig.\) / Silueta en forma de elipse \(fig.\)](#), EU:T:2019:568, § 53, 65-66

Laudatory connotation and distinctiveness

The laudatory nature of a mark is capable of weakening its distinctive character. However that does not mean that the mark would thereby be entirely devoid of distinctive character (§ 57-58).

14/05/2019, T-12/18, [Triumph / TRIUMPH](#), EU:T:2019:328, § 57-58

Weak distinctive character of the earlier mark

The human figures constitute the dominant element of each of the marks (not disputed). These figures are likely to represent strong or healthy people. Since the goods in question are foodstuffs, these figures are likely to indicate that those goods contribute to making people who consume them strong or healthy. To the extent that many foodstuffs may be regarded as having such attributes, these figures are not necessarily perceived as indicating the commercial origin of those goods. Consequently, the distinctive character of these figures and the distinctive character of the earlier mark as a whole is weak, taking into consideration that the rest of the figurative elements of the earlier mark also have weak distinctive character (while the BoA found it to be average) (§ 29-30, 41).

In view of the weak distinctive character of the earlier mark and the lack of visual similarity, a LOC would not be established even if the goods were identical (§ 47).



14/11/2019, T-149/19, [DEVICE OF A HUMAN FIGURE CENTERED OVER A BLUE ESCUTCHEON \(fig.\) / DEVICE OF A HUMAN FIGURE WITH A SEMICIRCLE \(fig.\)](#), EU:T:2019:789, § 29-30, 41, 47

Proof of the weak distinctive character of the earlier mark

A list of registered marks which contain the element 'scor' is insufficient to show that the element is not distinctive or has only a weak distinctive character. The mere presence of marks containing a certain term in the Register of EU trade marks without any reference to their use on the market or to any challenge to those marks on account of the existence of a LOC, cannot prove that the distinctive character of that term has been reduced (06/07/2016, T-97/15, Alfredo alla Scrofa, EU:T:2016:393, § 39 and case-law cited) (§ 84).



08/07/2020, T-328/19, [SCORIFY \(fig.\) / Scor et al.](#), EU:T:2020:311, § 84

2.4.2 Enhanced distinctiveness through use

Evidential value — Statements of distributors — Screenshots published on Facebook or Instagram

The evidential value of the statements provided by distributors contractually tied to the applicant is lower than that of declarations provided by third parties. Where distributors are tied to the applicant as clients and performed tasks, including the marketing and promotion of the earlier mark, they cannot be regarded as independent sources (§ 31).

Screenshots published as newsletters on Facebook or Instagram do not constitute conclusive evidence that the earlier mark has acquired enhanced distinctiveness through use. What matters in this regard is the effect of such activities on the recognition of the mark by the public, which is not quantifiable in the absence of data on the degree of exposure of the public to the advertising (§ 37).

19/09/2019, T-378/18, [CRUZADE / SANTA CRUZ et al.](#), EU:T:2019:620, § 31, 37

2.5 OTHER FACTORS

2.5.1 Family of marks

Prefix 'mc'

The prefix 'mc' of the opponent's family of names (such as McDONALD'S) has acquired a high degree of distinctiveness through its use on the fast-food market (§ 71).

10/10/2019, T-428/18, [mc dreams hotels Träumen zum kleinen Preis! \(fig.\) / McDONALD'S et al.](#), EU:T:2019:738, § 71

2.5.2 Coexistence

Coexistence — Proof of peaceful coexistence based on absence of any LOC

The EUTM proprietor is obliged to prove that the peaceful coexistence of the marks was based on the absence of any LOC, at least during the proceedings before the Office concerning relative grounds for refusal (§ 80-81).

The absence of any LOC cannot be inferred from the mere fact that the applicant for a declaration of invalidity did not oppose the registration of the contested national mark or apply for a declaration that it was invalid at an earlier stage, even where there has been significant use of the marks, 05/07/2016, T-518/13, MACCOFFEE, EU:T:2016:389, § 110 (§ 84).

12/07/2019, T-276/17, [Tropical \(fig.\) / TROPICAL](#), EU:T:2019:525, § 80-81, 84

Coexistence — Territorial aspect

Coexistence must be demonstrated in the territory in which the earlier trade mark is protected. When the earlier mark is a European Union trade mark, coexistence limited to a single Member State is inadequate (§ 59).

03/10/2019, T-533/18, [WANDA FILMS / WANDA et al.](#), EU:T:2019:727, § 59

03/10/2019, T-542/18, [wanda films \(fig.\) / WANDA et al.](#), EU:T:2019:728, § 59

2.5.3 Other

Irrelevance of bad faith in opposition proceedings

The question whether the earlier mark was filed in bad faith is irrelevant. Bad faith is a significant factor in the context of an application for a declaration of invalidity under Article 59(1)(b) EUTMR. It is not, however, a factor that must be taken into account in opposition proceedings brought under Article 8 EUTMR (§ 16).

12/02/2019, T-231/18, [Djili \(fig.\) / GILLY](#), EU:T:2019:82, § 16

2.6 GLOBAL ASSESSMENT

2.6.1 Interdependence

LOC — Identical goods — High level of attention of the relevant public — Phonetic identity — Low degree of visual similarity

As the goods are identical, the phonetic identity and the low degree of visual similarity of the marks serve to establish that there is a LOC, notwithstanding the high level of attention of the relevant public (§ 52-53).

 14/02/2019, T-34/18, [KALON AL CENTRO DELLA FAMIGLIA \(fig.\) / CALOON](#), EU:T:2019:94, § 52-53

No LOC — Identical services — Normal distinctiveness of the earlier mark — Low degree of similarity of the signs — Services directed solely at professionals

Even if the services were identical, taking into account the normal distinctiveness of the earlier mark and the low degree of similarity between the signs, the BoA should have ruled out any LOC, at least with regard to the services aimed solely at the professional public displaying a high level of attention (§ 65-66). Since the BoA did not exhaustively identify which services were directed solely at professionals, the decision is annulled in its entirety (§ 65-66, 70).



20/09/2019, T-716/18, [Idealogistic Compass Greatest care in getting it there \(fig.\) / iDĒA \(fig.\) et al.](#), EU:T:2019:642, § 70

LOC — Identical goods — Simple reversion of almost identical elements

When the goods are identical or similar and the signs consist of two almost identical elements, such as 'med' or 'medi' and 'flora' or 'flor', reversing the order of the elements is not sufficient to exclude a LOC (§ 52).



20/11/2019, T-695/18, [fLORAMED \(fig.\) / MEDIFLOR et al.](#), EU:T:2019:794, § 52

LOC — Identical services — Low distinctiveness of the earlier mark

Having regard to the identity of the services, the signs' above-average degree of visual similarity, their phonetic identity and the distinctive character, albeit low, of the earlier trade mark and the relevant public's average level of attention, there is a LOC (§ 81-82).



07/11/2019, T-568/18, [WE \(fig.\) / WE](#), EU:T:2019:783, § 81-82

Collective mark — Interdependence between the similarity of the trade marks and the similarity of the goods or services

It is an incorrect premise to consider that, when the earlier mark is weak, a LOC must be ruled out as soon as it is established that the similarity of the marks does not allow a LOC to be established. Bearing in mind the criterion of interdependence established in case-law, to determine the existence of a LOC, it is necessary to examine whether the low degree of similarity of the marks is offset by the higher degree of similarity, or even identity, of the goods they cover (§ 85-86).



05/03/2020, C-766/18 P, [BBQLOUMI \(fig.\) / HALLOUMI.](#), EU:C:2020:170, § 85-86

2.6.2 Imperfect recollection

LOC — Low degree of distinctiveness of the earlier mark — Principles of imperfect recollection

The signs are visually highly similar, taking into account the overall impression given by them when recalled by the general public, whose degree of attention is average. This indirect comparison of the conflicting trade marks and their imperfect recollection is particularly important (§ 67). There is a LOC even though the degree of distinctiveness of the earlier trade mark is low (§ 68).



10/09/2019, T-744/18, [Silueta en forma de elipse discontinua \(fig.\) / Silueta en forma de elipse \(fig.\)](#), EU:T:2019:568, § 67-68

LOC — Distinctive and dominant elements — Principles of interdependence and imperfect recollection

The verbal element 'OOF' of the mark applied for, which is easily recognisable and identifiable, is the distinctive and, compared with the figurative elements, dominant element. The bar above each letter 'O' and the use of the colours red and white for the letters 'OO' and 'F' are perceived as secondary decorative elements (§ 26).

Given the average degree of visual and phonetic similarity and the similarity of the goods, which is average at the very least, and in light of the principles of interdependence and imperfect recollection, there is a LOC on the part of the relevant public (§ 58).



10/10/2019, T-453/18, [OOF \(fig.\) / OO \(fig.\) et al.](#), EU:T:2019:733, § 26, 58



10/10/2019, T-454/18, [OO \(fig.\) / OO \(fig.\)](#), EU:T:2019:735, § 26, 58

Public with a high level of attention — Perception of differences between the marks

The fact that the public has a high level of attention does not mean that it will examine the mark before it in the smallest detail or that it will compare it in minute detail to another mark (21/11/2013, T-443/12, ancotel, EU:T:2013:605, § 52-54; 13/03/2018, T-824/16, K (fig.) / K (fig.) et al., EU:T:2018:133, § 72, 73 (§ 59).

28/05/2020, T-333/19, [GN Genetic Nutrition Laboratories \(fig.\) / GNC GENERAL NUTRITION CENTERS et al.](#), EU:T:2020:232, § 59

2.6.3 Independent distinctive role

No LOC — Independent distinctive role

The application of the notion of independent distinctive role deriving from the Medion judgment (06/10/2005, C-120/04, Thomson Life, EU:C:2005:594, § 37) presupposes that the earlier mark is contained in the mark applied for (28/09/2016, T-574/15, KOZMETIKA AFRODITA (fig.) / EXOTIC AFRODITA MYSTIC MUSK OIL et al., EU:T:2016:574, § 45) (§ 40). Where the earlier mark is not fully contained in the mark applied for, the element in common cannot have any

independent distinctive role (§ 40-42). In this case, the common verbal element ‘caprice’ is not sufficient to counterbalance the very limited similarity of the signs (§ 55).



17/10/2019, T-628/18, [FRIPAN VIENNOISERIE CAPRICE PUR BEURRE \(fig.\) / Caprice \(fig.\)](#), EU:T:2019:750, § 40-42, 55

No LOC — Independent distinctive role

The verbal element ‘unit’ of the mark applied for does not have an ‘independent distinctive role’. The other verbal element ‘k9’ and the figurative elements are clearly dominant compared to the verbal element ‘unit’ which is written in a much smaller font. Moreover, the verbal element ‘k9’ is part of the applicant’s name, Julius-K9, which manufactures the goods. So, from the perspective of the relevant public, the word ‘unit’ cannot be regarded as independent from the element ‘k9’ (§ 62). The signs have significant visual and phonetic differences that cancel out the similarity resulting from the common verbal element ‘unit’ (§ 63).



28/03/2019, T-276/18, [K9 Unit \(fig.\) / unit \(fig.\) et al.](#), EU:T:2019:200, § 62-63

LOC — Enhances distinctiveness of the earlier mark

Since the more distinctive the earlier mark is, the greater the likelihood of confusion will be, marks with a high degree of distinctiveness enjoy more extensive protection than those with a lower degree of distinctiveness (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 24; 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 20). Therefore, the enhanced distinctiveness of the earlier mark increases LOC (§ 67).



§ 67

15/07/2020, T-371/19, [FAKEDUCK \(fig.\) / Save the duck \(fig.\) et al.](#), EU:T:2020:339,

2.6.4 Method of purchase

Consideration of marketing circumstances — Global assessment

Marketing circumstances are to be taken into account at the stage of the global assessment of the LOC and not in the assessment of the similarity of the signs (§ 70).

04/03/2020, C-328/18 P, [BLACK LABEL BY EQUIVALENZA \(fig.\) / LABELL \(fig.\) et al.](#), EU:C:2020:156, § 70

Items of furniture

Concerning items of furniture particular importance must be attached to the visual perception of the marks. The phonetic similarity is less important (§ 75-76).

27/02/2019, T-107/18, [Dienne \(fig.\) / ENNE \(fig.\)](#), EU:T:2019:114, § 75-76

Alcoholic beverages

Phonetic similarity is particularly important with regard to *alcoholic beverages* because those goods are often consumed after being ordered orally (§ 68).

19/12/2019, [T-589/18, MIM NATURA \(fig.\) / MM et al.](#), EU:T:2019:887

Wine sector

In the wine sector, particular importance must be attached to the phonetic aspect and the fact that consumers usually describe and recognise wine by reference to the verbal element of the sign, since this element designates in particular the grower or the estate on which the wine is produced. The element 'DE' is just a preposition before 'GIUSTI' which will be perceived as the core element of the family name (§ 54-56).

19/09/2019, T-678/18, [GIUSTI WINE / DG DeGIUSTI \(fig.\) et al.](#), EU:T:2019:616, § 54-56

Wine — Designations of origin

The fact that the labels of wines marketed under different marks indicate different designations of origin is irrelevant, since it cannot be ruled out that the same undertaking produces several wines bearing different designations of origin (§ 68).

17/01/2019, T-576/17, [EL SEÑORITO / SEÑORITA](#), EU:T:2019:16, § 68

Clothes shops — Impact of the visual perception

In clothes shops, customers can either choose the clothes they wish to buy themselves or be assisted by the sales staff. Whilst oral communication is not excluded, the choice of the item of clothing is generally made visually. The visual perception of the marks in question will generally take place prior to purchase and, therefore, the visual aspect plays an important role in the global assessment of the likelihood of confusion (06/10/2004, T-117/03 - T-119/03 & T-171/03, NL, EU:T:2004:293, § 50] (§ 66).

15/07/2020, T-371/19, [FAKEDUCK \(fig.\) / Save the duck \(fig.\) et al.](#), EU:T:2020:339, § 66

Clothing manufacturer — Sub-brands

It is common for a single clothing manufacturer to use sub-brands (signs that derive from a principal mark and which share with it a common dominant element) to distinguish its various lines from one another. The relevant public is likely to wrongly identify the contested mark as a sub-brand of the earlier mark and wrongly conclude that the conflicting marks are marketed by the same undertaking (§ 80-82).

24/01/2019, T-785/17, [BIG SAM SPORTSWEAR COMPANY \(fig.\) / SAM et al.](#), EU:T:2019:29, § 80-82

Goods chosen in shops, catalogues or on the internet or prescribed or recommended orally — Particular importance of visual and phonetic aspects

Since *clothing*, *headgear* and *footwear* will generally be chosen when viewed in shops, catalogues or on the internet or prescribed or recommended orally, the visual and phonetic aspects are the most important (06/10/2004, T-117/03 - T-119/03 & T-171/03, NL, EU:T:2004:293, § 50;

08/02/2007, T-88/05, Nars, EU:T:2007:45, § 69; 18/05/2011, T-502/07, McKenzie, EU:T:2011:223, § 50-51) (§ 106).

08/07/2020, T-21/19, [mediFLEX easySTEP \(fig.\) / Stepeasy \(fig.\)](#), EU:T:2020:310, § 106

2.6.5 Impact of conceptual comparison

Counteraction of a phonetic similarity through visual and conceptual differences — Conditions for counteraction

Conceptual differences between two signs may exceptionally counteract their phonetic and visual similarities, provided that at least one of those signs has a clear and specific meaning that the relevant public can grasp immediately (§ 74). The assessment of the conditions of this counteraction forms part of the assessment of the similarity of the signs that follows the assessment of their visual, phonetic and conceptual similarities (05/10/2017, C-437/16 P, CHEMPIOIL / CHAMPION et al., EU:C:2017:737, § 43) (§ 75).

04/03/2020, C-328/18 P, [BLACK LABEL BY EQUIVALENZA \(fig.\) / LABELL \(fig.\) et al.](#), EU:C:2020:156, § 74-75

2.6.6 Impact of weak elements

LOC — Weak distinctive and dominant elements — Consideration of their position and their size

The figurative elements depicting symbols of an arrow and a bottle are used throughout the whole of the European Union to denote the recycling process or recycling services. Therefore, these figurative elements, as the distinctive and dominant elements of the signs, have weak distinctive character in respect of the goods and services, which all relate to the recycling of packaging (not disputed). However, on account of their position and size, the arrow and the bottle will make an impression on consumers and are likely to be remembered by them, while the can and the frame are not insignificant (§ 34-35). In view of the average degree of visual and conceptual similarity between the signs, a LOC could not be excluded on the basis that the signs produced a different overall impression (§ 54-57).



11/04/2019, T-477/18, [DEVICE OF A BOTTLE SILHOUETTE AND AN ARROW \(fig.\) / DEVICE OF A CAN AND A BOTTLE SILHOUETTE AND AN ARROW \(fig.\)](#), EU:T:2019:240, § 34-35, 54-57

LOC or no LOC depending on the distinctiveness of the common element in relation to certain goods and services

The similarity between the signs is due to the coincidence in the term 'carajillo'. There is no LOC for the goods and services in relation to which this term is weak. The term 'carajillo' designates 'a beverage that is generally prepared by adding a strong alcoholic beverage to hot coffee'. This definition renders 'carajillo' as descriptive in relation to *liqueurs and other alcoholic beverages (except beer)* in Class 33 and *retail and wholesale services regarding liqueurs and other alcoholic*

beverages in Class 35 (§ 57). There is a LOC for the remaining goods and services, in relation to which this term is fully distinctive (§ 50-76).



08/03/2019, T-326/18, [CARAJILLO LICOR 43 CUARENTA Y TRES \(fig.\) / Carajillo \(fig.\)](#), EU:T:2019:149, § 50-76

No LOC — Weak distinctive character of the common element

The word 'aqua' has a certain descriptive dimension insofar as it will be perceived by the relevant public, composed of specialists in the dental field with a high degree of attention, as alluding to a certain characteristic of the goods, namely that they are suitable for functioning in a wet environment, whether that be the mouth of a patient, or a clinical or laboratory environment where contact with water is to be expected (§ 38-39). Therefore, the inherent distinctive character of the element 'aqua' of the marks is weak (§ 40). It is not necessary for the two elements 'aqua' and 'cem' to have a concrete meaning for the relevant public to break down the word 'aquacem' into the two elements 'aqua' and 'cem'. (§ 55).

The signs are restricted to the presence of the element 'aqua', which has a weak distinctive character, and are offset to a large extent by the presence of the words 'cem' and 'print'. Although those elements can also have a weak distinctive character with respect to certain goods and for certain parts of the relevant public, they give rise to a clear difference between the signs, taken together. The circumstances of the case are therefore such that the relevant public will clearly distinguish the signs, even if they have a weak degree of similarity due to the element 'aqua' (§ 90).

23/05/2019, T-312/18, [AQUAPRINT / AQUACEM et al.](#), EU:T:2019:358, § 55, 107-108

No LOC — Weak distinctive character of the common element

The similarities between the signs are restricted to the presence of the element 'city', which has a weak distinctive character, and are offset to a large extent by the endings 'mania' and 'lights'. Although the elements 'mania' and 'lights' may also have a weak distinctive character for certain goods and for certain parts of the relevant public, they give rise to a difference between the signs when taken as a whole. The relevant public will therefore clearly distinguish the signs, even though they have a low degree of similarity due to the presence of the common element 'city' (§ 60-62).

13/05/2020, T-381/19, [City Mania / City Lights](#), EU:T:2020:190, § 60-62

LOC — Weak elements

It is only if all the other components of the signs are negligible that the assessment of their similarity can be carried out solely on the basis of their dominant elements (§ 32).

Where some elements of a trade mark are descriptive of the goods and services in respect of which that mark is protected or of the goods and services covered by the application for

registration, those elements are recognised as having only a weak, or even very weak, distinctive character (§ 48).



§ 32, 48

12/06/2019, T-583/17, [IOS FINANCE \(fig.\) / EOS \(fig.\)](#), EU:T:2019:403,

LOC — Weak distinctive character of the verbal element

As regards the conceptual comparison, the signs are similar to an average degree since the words 'show' and 'room', present in both signs, have the same meaning. The presence of the numerical and figurative element '86' in the earlier trade mark conveys no specific and distinct concept (§ 67-77).

The BoA concluded, without committing any error of assessment, that there was a LOC despite the weak distinctive character of the verbal element 'showroom' (§ 84-89).



EU:T:2019:631, § 67-77, 84-89

19/09/2019, T-679/18, [SHOWROOM \(fig.\) / SHOWROOM 86 \(fig.\)](#),

No LOC — Common descriptive element

The mere presence of a descriptive element in both signs does not automatically imply that the signs are visually, phonetically, or conceptually similar (§ 68).

05/03/2020, T-688/18, [CORNEREYE / BACKEYE et al.](#), EU:T:2020:80, § 68

No LOC — Weak distinctive character of the earlier mark

Where the earlier mark does not have a high degree of distinctiveness, the mere association that the relevant public might make between two trade marks as a result of their analogous semantic content is not in itself a sufficient ground for finding a LOC (§ 46). As the marks are not visually similar, a phonetic comparison between them is irrelevant and, conceptually, they are similar to only a low degree, there is no LOC (§ 46).



12/12/2019, T-266/19; [\(fig.\) / gativo \(fig.\) \(II\)](#), EU:T:2019:854, § 46

12/12/2019, T-267/19; [\(fig.\) / gativo \(fig.\) \(I\)](#), EU:T:2019:852, § 46

LOC — Common elements — Weak distinctive character — Applicability for laudatory elements

Where the elements of similarity between two signs arise from the fact that they share a component which has a weak distinctive character, the impact of such elements of similarity on the global assessment of the LOC is itself low (22/02/2018, T-210/17, TRIPLE TURBO (fig.) / TURBO 2, EU:T:2018:91, § 73 and 20/09/2018, T-266/17, UROAKUT / UroCys (fig.) et al., EU:T:2018:569, § 79) (§ 84).

However, the case-law has so far not been applied in situations where the common element is laudatory in relation to the goods. That case-law cannot apply in all cases and must be read in

the light of the circumstances prevailing in each case, in particular where the conflicting signs differ in their most distinctive elements. Even assuming that a significant part of the relevant public would consider that the elements 'master' or 'masters' of the conflicting signs share the concept of 'mastery' or 'expertise' and give them a laudatory connotation, the signs differ in terms that are not more distinctive or dominant than the one on which they converge. The reasoning underlying the abovementioned case-law is therefore not applicable (§ 85).



19/06/2019, T-179/16 RENV, [MASTER SMOKY / MASTERS COLORS PARIS \(fig.\)](#), EU:T:2019:433, § 84-85

19/06/2019, T-180/16 RENV, [MASTER SHAPE / MASTERS COLORS PARIS \(fig.\)](#), EU:T:2019:431, § 84-85

19/06/2019, T-181/16 RENV, [MASTER PRECISE / MASTERS COLORS PARIS \(MARQUE FIGURATIVE\)](#), EU:T:2019:429, § 84-85

19/06/2019, T-182/16 RENV, [MASTER DUO / MASTERS COLORS PARIS \(MARQUE FIGURATIVE\)](#), EU:T:2019:426, § 84-85

19/06/2019, T-183/16 RENV, [MASTER DRAMA / MASTERS COLORS PARIS \(fig.\)](#), EU:T:2019:428, § 84-85

Overall perception of the relevant public — Elements with weak distinctive character individually — Distinctive character when combined

The earlier mark consists of a representation, probably of an eagle, spreading its wings upwards and with its beak and claws open. The mark applied for is a figurative element representing a bird, which can be described in the same way as the earlier mark, together with the verbal element '1st AMERICAN' on a black rectangle above (§ 79). The BoA carried out a two-step analysis considering the elements '1st' as laudatory and 'AMERICAN' as descriptive (§ 98). The BoA did not carry out a global analysis of the verbal elements of the mark applied for. It should have based its assessment on the overall perception by the relevant public. The fact that those elements may have a weak distinctive character individually does not prejudice in any way their possible distinctive character when combined (§ 100), in particular when the verbal element constitutes a whole in the mark applied for (§ 101). This error is liable to vitiate the entire assessment in the contested decision (§ 105).

1st AMERICAN



EU:T:2019:518

12/07/2019, T-54/18, [1st AMERICAN \(fig.\) / DEVICE OF A BIRD \(fig.\)](#),

Impact of weakly distinctive or descriptive elements

The fact that certain elements of similarity in the signs may be perceived as alluding to the characteristics of the goods in question (and thus as being descriptive or only weakly distinctive) this is not in itself sufficient to rule out LOC between the marks, since they remain visually, aurally and conceptually similar as a whole (§ 90).

13/05/2020, T-63/19, [ПОШЕН \(fig.\) / ПОМАШКИ \(fig.\)](#), EU:T:2020:195, § 90

2.6.7 LOC



MEAT IN STYLE 14/02/2019, T-63/18, [TORRO Grande Meat in Style \(fig.\) / TORRO et al.](#), EU:T:2019:89

ARBET 30/01/2019, T-79/18, [ARBET \(fig.\) / BORBET](#), EU:T:2019:39



29/01/2019, T-336/17, [YATEKOMO / YA TE COMER EL VACIO QUE TE LLENA \(fig.\)](#), EU:T:2019:36

26/03/2019, T-105/18, [LILI LA TIGRESSE / TIGRESS](#), EU:T:2019:194

28/03/2019, T-259/18, [Unifoska / NITROFOSKA et al.](#), EU:T:2019:198

06/03/2019, T-321/18, [NOCUVANT/ NOCUTIL et al.](#), EU:T:2019:139



28/03/2019, T-562/17, [ALBÉA \(fig.\) / Balea](#), EU:T:2019:204



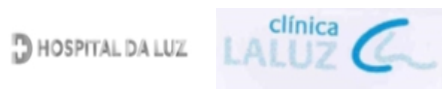
23/05/2019, T-837/17, [SkyPrivate \(fig.\) / SKY et al.](#), EU:T:2019:351



AUDIMAS 12/07/2019, T-467/18, [AUDIMAS \(fig.\) / Audi et al.](#), EU:T:2019:513



09/07/2019, T-397/18, [Hugo's Burger Bar \(fig.\) / H'ugo's et al.](#), EU:T:2019:489



13/06/2019, T-357/18, [HOSPITAL DA LUZ \(fig.\) / clínica LA LUZ \(fig.\) et al.](#), EU:T:2019:416



20/09/2019, T-287/18, [Nature's Variety Instinct \(fig.\) / Natural Instinct Dog and Cat food as nature intended \(fig.\) et al.](#), EU:T:2019:641

20/09/2019, T-288/18, [NATURE'S VARIETY INSTINCT / NATURAL INSTINCT Dog and Cat food as nature intended \(fig.\) et al.](#), EU:T:2019:640



09/09/2019, T-680/18, [LUMIN8 \(fig.\) / LUMI et al.](#), EU:T:2019:565



19/09/2019, T-678/18, [GIUSTI WINE / DG DeGIUSTI \(fig.\) et al.](#), EU:T:2019:616


28/11/2019, T-665/18, [Vibble / Vybe et al.](#), EU:T:2019:825


FLORAMED 20/11/2019, T-695/18, [fLORAMED \(fig.\) / MEDIFLOR et al.](#), EU:T:2019:794

19/12/2019, T-28/19, [VERITEA / VERI - AGUA PURA DEL PIRINEO et al.](#), EU:T:2019:870

  19/12/2019, T-589/18, [MIM NATURA \(fig.\) / MM et al.](#), EU:T:2019:887


07/02/20, T-214/19, [Fleximed / MediFlex](#), EU:T:2020:40

 26/03/2020, T-77/19, [alcar.se \(fig.\) / Alcar](#), EU:T:2020:126

 **King** 12/03/2020, T-85/19, [KinGirls \(fig.\) / King et al.](#), EU:T:2020:100







29/01/2020, T-239/19, [ENCANTO \(fig.\) / Belcanto](#), EU:T:2020:12

 13/02/2020, T-387/18; [DELTA SPORT \(fig.\) / DELTA \(fig.\) et al.](#); EU:T:2020:65

27/02/2020, T-202/19, [Caratour / Carado et al.](#), EU:T:2020:75, § 36-37

27/02/2020, T-203/19; [Caratwo / Carado et al.](#), EU:T:2020:76, § 36-37

  26/03/2020, T-653/18, [GIORGIO ARMANI le Sac 11 \(fig.\) / LESAC et al.](#), EU:T:2020:121

  26/03/2020, T-654/18, [le Sac 11 \(fig.\) / LESAC et al.](#), EU:T:2020:122



29/04/2020, T-106/19; [ABARCA SEGUROS \(fig.\) / Abanca](#), EU:T:2020:158

TasteSense By Kerry 29/04/2020, T-108/19; [TasteSense By Kerry \(fig.\) / Multisense et al.](#), EU:T:2020:161


TasteSense 29/04/2020, T-109/19; [TasteSense \(fig.\) / Multisense et al.](#), EU:T:2020:162



28/05/2020, T-341/19, [TASER \(fig.\) / Taser et al.](#), EU:T:2020:233



28/05/2020, T-342/19, [TASER \(fig.\) / Taser et al.](#), EU:T:2020:234

 **pontinova** 13/05/2020, T-76/19, [pontinova \(fig.\) / Ponti et al.](#), EU:T:2020:198

13/05/2020, T-284/19, [Kenwell / Kenwood et al.](#), EU:T:2020:192



28/05/2020, T-333/19, [GN Genetic Nutrition Laboratories \(fig.\) / GNC GENERAL NUTRITION CENTERS et al.](#), EU:T:2020:232



28/05/2020, T-724/18 & T-184/19, [AUREA BIOLABS \(fig.\) / Aurea et al.](#), EU:T:2020:227, § 75



16/06/2020, T-558/19, [HOSPITAL DA LUZ LEARNING HEALTH TRAINING, RESEARCH & INNOVATION CENTER \(fig.\) / C LUZCLINICA LA LUZ \(fig.\) et al.](#), EU:T:2020:274, § 18

25/06/2020, T-550/19, [Noster / Foster](#), EU:T:2020:290



10/06/2020, T-646/19, [e \(fig.\) / e \(fig.\)](#), EU:T:2020:253



25/06/2020, T-114/19, [B \(fig.\) / b \(fig.\)](#), EU:T:2020:286



15/07/2020, T-371/19, [FAKEDUCK \(fig.\) / Save the duck \(fig.\) et al.](#), EU:T:2020:339

2.6.8 No LOC

Dienne ENNE

27/02/2019, T-107/18, [Dienne \(fig.\) / ENNE \(fig.\)](#), EU:T:2019:114



07/03/2019, T-106/18, [VERA GREEN / Lavera et al.](#), EU:T:2019:143

Lumiqs Lumix

19/03/2019, T-133/18, [Lumiqs \(fig.\) / Lumix et al.](#), EU:T:2019:169



20/09/2019, T-67/19, [Dokkio / <IO \(fig.\)](#), EU:T:2019:648

MediWell



17/09/2019, T-502/18, [MediWell \(fig.\) / Well and well et al.](#), EU:T:2019:614



11/04/2019, T-403/18, [W S WELLPARMA SHOP \(fig.\) / WELL AND WELL](#), EU:T:2019:248



19/12/2019, T-40/19, [THE ONLY ONE by alphaspirit wild and perfect \(fig.\) / ONE](#), EU:T:2019:890



12/12/2019, T-266/19; [\(fig.\) / gastivo \(fig.\) \(II\)](#), EU:T:2019:854 Aligned with Bo



12/12/2019, T-267/19; [\(fig.\) / gastivo \(fig.\) \(I\)](#), EU:T:2019:852



I.J. TOBACCO INDUSTRY

19/12/2019, T-743/18, [I.J. TOBACCO INDUSTRY \(fig.\) / JTi \(fig.\)](#), EU:T:2019:872



05/12/2019, T-29/19, [Idealogistic Verhoeven Greatest care in getting it there \(fig.\) / iDĒA \(fig.\) et al.](#), EU:T:2019:841



EU:T:2020:31

05/02/2019, T-44/19; [TC Touring Club \(fig.\) / TOURING CLUB ITALIANO et al.](#),

26/03/2020, T-343/19, [Sonance / Conlance](#), EU:T:2020:124



30/01/2020, T-559/19, [DEVICE OF A WHITE DECIDUOUS TREE AGAINST A BLUE BACKGROUND \(fig.\) / DEVICE OF A FIR TREE SILHOUETTE ON A BASE \(fig.\) et al.](#), EU:T:2020:19

05/03/2020, T-688/18, [CORNEREYE / BACKEYE et al.](#), EU:T:2020:80



28/05/2020, T-696/18, [AIRESANO BLACK El ibérico de Teruel \(fig.\) / JAMON DE TERUEL CONSEJO REGULADOR DE LA DENOMINACION DE ORIGEN \(fig.\)](#), EU:T:2020:219



08/07/2020, T-633/19, [\(fig.\) / TOTTO \(fig.\)](#), EU:T:2020:312

3 ARTICLE 8(2)(c) EUTMR — EARLIER WELL-KNOWN MARKS

Invalidity proceedings — Well-known trade mark within the meaning of Article 6bis of the Paris Convention

The invalidity applicant had demonstrated to the requisite legal standard that the earlier word mark and the earlier figurative mark were well known in Bulgaria in the sense of Article 6bis of the Paris Convention for the goods in Classes 29 and 32 (§ 95).

10/06/2020, T-717/18, [Philibon / PHILICON \(fig.\) et al.](#), EU:T:2020:256, § 95

4 ARTICLE 8(3) EUTMR, ARTICLE 60(1)(b) EUTMR — TRADE MARK FILED BY AGENT

Pre-contractual negotiations — ‘Agent-principal’ relationship

Article 8(3) EUTMR requires an agreement of commercial cooperation between the parties of a kind that gives rise to a fiduciary relationship by imposing on the trade mark applicant, whether expressly or implicitly, a general duty of trust and loyalty as regards the interests of the trade mark proprietor. Article 8(3) EUTMR can apply to agreements that have expired before the date of filing of the EUTM application, provided that the duty of trust and confidentiality still existed on the filing date (§ 35). After five years, it cannot be assumed that post-contractual obligations still exist. The mere existence of pre-contractual negotiations concerning commercial cooperation does not justify the application of Article 8(3) EUTMR (§ 36). An ‘agent-principal’ relationship between the EUTM proprietor and the invalidity applicant cannot be based on the fact that their directors were acquainted with each other in the context of a professional relationship which, itself, cannot be characterised as an ‘agent-principal’ relationship and which, moreover, involves different companies, marks and times (§ 37).

14/02/2019, T-796/17, [MOULDPRO](#), EU:T:2019:88, § 35-37

5 ARTICLE 8(4) EUTMR, ARTICLE 60(1)(c) EUTMR — NON-REGISTERED MARKS / OTHER SIGNS USED IN THE COURSE OF TRADE

5.1 PROOF OF THE APPLICABLE LAW GOVERNING THE SIGN

5.1.1 The burden of proof

Company name — Sign of mere local significance — Coexistence of trade marks — Right to prohibit use — Scope of examination — Exhaustive examination under national law — Burden of proof for ‘substantive exceptions’ — Suspension of the proceedings

The GC confirms that the scope of examination that the Office is required to carry out, due to the full reference to Article 8(4) EUTMR and the law of the Member State governing the sign, includes all the conditions which, according to the law concerned, determine whether ‘this sign gives its proprietor the right to prohibit the use of a more recent trade mark’ (24/10/2018, T-435/12, 42 BELOW (fig.) / VODKA 42 (fig.), EU:T:2018:715, § 45) (§ 53, 66). It clarifies that the examination under national law must be exhaustive and must also include the substantive exceptions which, under national law, allow excluding the right to prohibit use (§ 69).

However, regarding the burden of proof, the GC recalls the case-law on the opponent/invalidity applicant’s duty to establish existence of the right to prohibit use (the legislation and its interpretation by the competent national courts) (§ 72, 77, 78, 80). That duty exists regardless of the Office’s duty to check the correctness of the ‘legal facts’, if needs be, *ex officio* (§ 73-76, 79). The GC confirms that this duty also applies to the ‘substantive exceptions’ (§ 80, 82, 83) and that the burden of proof in this regard is on the EUTM applicant/owner: the existence of the national right is a matter of fact (07/05/2013, T-579/10, makro, EU:T:2013:232, § 62 (§ 80) and each party has to establish the rights upon which it relies (24/10/2018, T-435/12, 42 BELOW (fig.) / VODKA 42 (fig.), EU:T:2018:715, § 83, 92) (§ 82, 83).

The BoA did not commit a manifest error of assessment or misuse of powers in rejecting the request for suspension of the appeal proceedings (§ 134). Taking into account the case-law in

the pilot proceedings before the GC and the Court of Justice (CJ) and also the case-law in the parallel cases before the German courts (Oberlandesgericht Düsseldorf and the Bundesgerichtshof), the BoA did not err in finding that the applicant had not proved that the demarcation agreement conferred on it the right to have EU trade marks registered (§ 131, 132). It was therefore possible to conclude the prima facie analysis of the likelihood of success of the counterclaim for a declaratory judgment by asserting that this likelihood had not been established (§ 133).

13/05/2020, T-443/18, [Vogue Peek & Cloppenburg / Peek & Cloppenburg](#), EU:T:2020:184, § 53, 66, 69, 72, 77-78, 80, 82-83, 117-120

13/05/2020, T-444/18, [Peek & Cloppenburg](#), EU:T:2020:185, § 53, 66, 69, 76-79, 82-83, 85-86, 124-127

13/05/2020, T-445/18, [Peek & Cloppenburg / Peek & Cloppenburg](#), EU:T:2020:186, § 53, 66, 69, 75-80, 82-83, 85-86, 120-123

13/05/2020, T-446/18, [Peek & Cloppenburg / Peek & Cloppenburg](#), EU:T:2020:187, § 55, 68, 71, 77, 82-83, 85, 78-81, 84, 87-88, 122-125

13/05/2020, T-534/18, [Peek / Peek & Cloppenburg](#), EU:T:2020:188, § 53, 85, 88, 67-70, 73-74, 94-95, 129-131

13/05/2020, T-535/18 [Peek's / Peek & Cloppenburg](#), EU:T:2020:189, § 53, 68-71, 74-75, 87, 96-97, 131-134

5.1.2 Means of evidence and standard of proof

5.1.2.1 National law

[No key points available yet.]

5.1.2.2 European Union law

[No key points available yet.]

5.2 ENTITLEMENT: DIRECT RIGHT CONFERRED ON THE OPPONENT / INVALIDITY APPLICANT

[No key points available yet.]

5.3 TYPES OF RIGHTS FALLING UNDER ARTICLE 8(4) EUTMR

5.3.1 Non-registered trade marks

[No key points available yet.]

5.3.2 Other signs used in the course of trade

5.3.2.1 Trade names

[No key points available yet.]

5.3.2.2 Corporate names

Company name — Use by another undertaking — Examination of economic link

The existence of an economic link does not presuppose a particular order between the undertakings concerned. On the contrary, it may be sufficient in that regard that there is a single point of control within a group of operators in respect of the goods manufactured by one of them and distributed by another, thus ruling out any likelihood of confusion as to the commercial origin of those goods (§ 36)

Furthermore, the methodological approach adopted by the GC (§ 29-30) complies with the requirement that the examination of whether an economic link exists must be conducted globally, taking into account all the relevant circumstances (20/12/2017, C-291/16, Schweppes S.A., EU:C:2017:990, § 51) (§ 37).

23/04/2020, C-736/18 P, [GUGLER \(fig.\) / GUGLER FRANCE](#), EU:C:2020:308, § 37-38

5.3.2.3 Domain names

[No key points available yet.]

5.3.2.4 Copyright

[No key points available yet.]

5.4 USE REQUIREMENTS

5.4.1 National standard

Passing off — Goodwill

Genuine trading activities, which result in acquiring reputation and gaining customers, are usually sufficient to establish goodwill (§ 58).

From national case-law, the claimant in an action for passing off is not required to demonstrate that it is the sole owner of the goodwill. In certain circumstances, the goodwill may be shared by multiple entities such as unincorporated business associations (§ 69).

The defendant of an action for passing off can furnish proof of use of the mark on the basis of its own goodwill acquired independently of the applicant, by an honest concurrent use of that mark (§ 79).

17/01/2019, T-671/17, [TURBO-K / TURBO-K \(fig.\)](#), EU:T:2019:13, § 58, 69, 79

Action for passing off

According to Section 5(4) of the United Kingdom Law on Trade Marks, the party invoking that provision must establish that three conditions are satisfied: first, the goodwill acquired by the sign at issue; second, misrepresentation by the proprietor of the subsequent mark; and, third, damage caused to that goodwill (06/12/2018, T-459/17, THE COMMODORES / Commodores et al., EU:T:2018:886, § 32) (§ 102).

Misrepresentation by a defendant in an action for passing off, whether or not it is intentional, is a representation which is likely to lead the claimant's customers to attribute the commercial origin of the goods and services offered by the defendant to it (§ 103).

In view of the different endings of the words 'aquaprint' and 'aquacem' and the weak distinctive character of the common element 'aqua', the existence of misrepresentation in this case is

excluded, since the offer of the goods in the UK under the trade mark applied for, AQUAPRINT, is not likely to lead the public to attribute the commercial origin of these goods to the applicant, which markets its goods under the signs AQUACEM and AQUASIL (§ 107-108).

23/05/2019, T-312/18, [AQUAPRINT / AQUACEM et al.](#), EU:T:2019:358, § 102-103, 107-108

5.4.2 European standard - Use in the course of trade of more than mere local significance

5.4.2.1 Use in the course of trade

[No key points available yet.]

5.4.2.2 Use of more than mere local significance

[No key points available yet.]

5.4.2.3 Nature of the use

[No key points available yet.]

5.5 PRECEDENCE IN TIME

5.6 RIGHT TO PROHIBIT THE USE OF A SUBSEQUENT TRADE MARK UNDER THE APPLICABLE LAW

Scope of protection — Other earlier national rights of the EUTM proprietor

It is neither for the Office nor for the GC to settle a conflict between the earlier sign and another company name or non-registered national trade mark in invalidity proceedings against an EUTM (§ 50-57). This conflict falls within the competence of the national authorities (§ 54). The issue of the earlier right is examined by reference to the registration of the contested EUTM, and not by reference to the alleged earlier rights that the EUTM proprietor may have (§ 58).

07/02/2019, T-287/17, [SWEMAC](#), EU:T:2019:69, § 50-58

6 ARTICLE 8(5) EUTMR, ARTICLE 60(1)(a) EUTMR — MARKS WITH A REPUTATION

6.1 APPLICABILITY TO REGISTERED MARKS

[No key points available yet.]

6.2 APPLICABILITY TO SIMILAR AND IDENTICAL GOODS AND SERVICES

[No key points available yet.]

6.3 CONDITIONS OF APPLICATION:

6.3.1 Earlier mark with reputation

6.3.1.1 Nature of recognition

[No key points available yet.]

6.3.1.2 Scope of reputation

- Degree of reputation
- Relevant public
- Goods and services covered
- Relevant territory
- Relevant point in time
- Reputation acquired as part of another mark

[No key points available yet.]

Acquisition of reputation of a mark as result of its use under a different form

The submitted documents essentially show the words 'ANNA DE CODORNIU', sometimes accompanied by the bust of a woman. The GC considered that the submitted evidence proved reputation of the earlier word mark 'ANNA DE CODORNIU', but did not prove that the earlier figurative mark 'ANNA' is reputed on its own, i.e. independently from the expression 'DE CODORNIU' (§ 39-40, 58).

The acquisition of reputation of a mark may also be as a result of its use under a different form, in particular under the form of another registered mark, provided that the relevant public continues to perceive the goods as originating from the same undertaking (05/05/2015, T 131/12, SPARITUAL / SPA et al., EU:T:2015:257, § 33). In order to determine whether that is the case, it should be ascertained that the components which differentiate the two marks do not prevent the relevant public from continuing to perceive the goods as originating from a particular undertaking (01/03/2018, T-629/16, DEVICE OF TWO PARALLEL STRIPES (other) / DEVICE OF THREE PARALLEL STRIPES (fig.) et al., EU:T:2018:108, § 28) (§ 45). That the sign used on the market includes all the elements of the mark as registered is not in itself sufficient to apply that jurisprudence (§ 46-48).

27/06/2019, T-334/18, [ANA DE ALTUN \(fig.\) / ANNA \(fig.\) et al.](#), EU:T:2019:451, § 33, 39-40, 46-48, 58

6.3.1.3 Assessment of reputation-relevant factors

[No key points available yet.]

6.3.1.4 Proof of reputation

Forms of evidence to prove reputation

The relevant factors to assess the existence of repute, that is to say, in particular, the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it, being merely illustrative, it cannot be required that proof of the reputation of a mark be based on all those elements (§ 23, 24).

The evidence to establish the presence of the earlier trade mark on the internet is an additional element making it possible to establish the reputation of that trade mark. A significant presence of the earlier trade mark on the internet, given the number of subscribers to accounts dedicated to this trade mark on social networks, or the number of visitors to blogs mentioning this trade mark, constitutes an element making it possible to establish the knowledge of the trade mark by the public concerned and therefore its reputation (§ 33).

Since the EUTMR and the EUTMDR do not list the forms of evidence which the opponent may present in order to demonstrate the existence of the earlier mark's reputation, the opponent is free, in principle, to choose the form of evidence which it considers useful to submit (§ 35).

26/06/2019, T-651/18, [HAWKERS \(fig.\) / HAWKERS \(fig.\) et al.](#), EU:T:2019:444, § 23-24, 33, 35

Forms of evidence to prove reputation — Seasonal products

When assessing evidence related to the reputation of an earlier mark for *sandals* and *bathing shoes*, it must be taken into account that the sales volumes are influenced by the fact that they are seasonal products mainly sold during the summer (§ 34).

13/05/2020, T-288/19, [IPANEMA \(fig.\) / iPANEMA \(fig.\) et al.](#), EU:T:2020:201, § 34

Previous decisions recognising the reputation of the earlier marks

Where an opposition is based on Article 8(5) CTMR [now Article 8(5) EUTMR], the opponent is free, in principle, to choose the form of evidence it considers useful to submit to the Office, pursuant to Rule 19(2)(c) CTMIR [now Article 7(2)(f) EUTMDR]. Therefore, the opponent is free to rely on, as evidence of the reputation of the earlier mark relied upon, one or several previous decisions of the Office finding that that mark enjoys a reputation. The Office is required to take into account those decisions, when they are identified in a precise manner in the notice of opposition (28/06/2018, C-564/16 P, *DEVICE OF A JUMPING ANIMAL (FIG. MARK) / PUMA (FIG. MARK) et al.*, EU:C:2018:509, § 69) and to consider whether or not it should decide in the same way and, if not, to provide an explicit statement of its reasoning for departing from those decisions, stating why they are no longer relevant (§ 30-31, 35, 44, 46, 50). When under such circumstances, additional evidence filed with the statement setting out the grounds of appeal cannot be excluded as inadmissible new evidence submitted out of time (§ 51, 62).

22/05/2019, T-161/16, [CMS Italy \(fig.\) / PUMA \(fig.\) et al.](#), EU:T:2019:350, § 30-31, 35, 44, 46, 50, 51, 62.

6.3.2 Similarity of the signs

Concept of similarity

The concept of similarity is equally valid for the application of both Article 8(1)(b) CTMR [now Article 8(1)(b) EUTMR] and Article 8(5) CTMR [now Article 8(5) EUTMR] (§ 76).

28/02/2019, C-505/17 P, [SO' BiO etic \(FIG. MARK\) / SO...? et al.](#), EU:C:2019:157, § 76

Comparison of the conflicting marks

Since food products in Classes 29 and 30 are normally purchased in supermarkets or similar establishments and selected directly by the consumer, rather than requested orally, for the assessment of the existence of a possible LOC or link between the signs, the figurative elements of a trade mark may play a more important role than its verbal elements in the perception of the relevant consumer (§ 155).

A phonetic comparison is irrelevant in the context of examining the similarity of a three-dimensional mark devoid of verbal elements with another mark. At most, its visual or conceptual content can be described orally, though a description like this would necessarily coincide with either its visual or conceptual perception. Consequently, it is not necessary to examine the phonetic perception of a three-dimensional mark devoid of verbal elements autonomously and to compare it with the phonetic perception of other marks (§ 166).

28/02/2019, T-459/18, [PEPERO original \(fig.\) / REPRÉSENTATION D'UN BATÔNNET \(fig.\)](#), EU:T:2019:119, § 155, 156

Lack of similarity at visual and conceptual level — Article 8(5) CTMR [now Article 8(5) EUTMR] not applicable

The conflicting marks, each considered as a whole, produce different overall impressions on a visual level (§ 54). There are clear differences between the marks on a conceptual level (§ 79).



31/01/2019, T-215/17, [PEAR \(fig.\) / APPLE BITE \(fig.\) et al.](#), EU:T:2019:45, § 54,

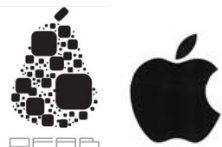
79

6.3.3 Link between the signs

Reputation of the earlier mark — Distinctive character of the earlier mark

The reputation of the earlier mark is a relevant factor for the assessment, not of the similarity of the conflicting marks, but of the existence of a link between them in the mind of the relevant public. Moreover, it is only if the conflicting marks have a certain similarity that it is necessary to make an overall assessment in order to determine whether there is a link between those marks in the mind of the relevant public (§ 51).

The distinctive character of the earlier mark is a relevant factor for the assessment, not of the similarity of the conflicting marks, but of the existence of a link between them in the mind of the public concerned (§ 60).



60

31/01/2019, T-215/17, [PEAR \(fig.\) / APPLE BITE \(fig.\) et al.](#), EU:T:2019:45, § 51,

Overall assessment of the link between the marks

The overall assessment of the link between the marks is to be carried out considering the degree of closeness or dissimilarity between the goods or services for which the marks were registered, and the strength of the earlier mark's reputation (§ 84).

28/02/2019, C-505/17 P, [SO' BiO etic \(FIG. MARK\) / SO...? et al.](#), EU:C:2019:157, § 84

Nature and degree of proximity of the goods or services

The nature and degree of proximity of the goods or services concerned are relevant factors for the purpose of determining whether the use of a trade mark takes unfair advantage of the distinctive character or reputation of another trade mark. However, the existence of a similarity between the goods and services concerned does not constitute a condition for the application of Article 8(5) EUTMR (§ 182).

28/02/2019, T-459/18, [PEPERO original \(fig.\) / REPRÉSENTATION D'UN BATÔNNET \(fig.\)](#), EU:T:2019:119, § 182

Nature and degree of proximity of the goods or services — Seasonal products

There is a link between *(optical) spectacles, rims for the latter (for sunglasses)* and *sandals and bathing shoes*. This is because they belong to the field of fashion accessories and are mainly sold and used in summer (§ 61). Although *(optical) spectacles, rims for the latter (for sunglasses)* and *sandals and bathing shoes* do not share sufficient criteria to be found similar, a valid application of Article 8(5) CTMR [now Article 8(5) EUTMR] does not require the products to be identical or similar to the point of causing a risk of confusion within the meaning of Article 8(1)(b) CTMR [now Article 8(5) EUTMR] (§ 62).

Protective goggles are not similar to *sunglasses*. *Protective goggles* constitute personal protective equipment intended for the world of work. Even though they can be used as protection against intense light, they are sufficiently different from *sunglasses*, in particular as regards their purpose and their distribution channels, namely shops dedicated to manual and industrial work. Furthermore, *protective goggles* are not used during just one season of the year, particularly in the summer (§ 63-64).

13/05/2020, T-288/19, [IPANEMA \(fig.\) / iPANEMA \(fig.\) et al.](#), EU:T:2020:201, § 62-64

Absence of a link between the signs — First name and a surname — Wine and alcoholic beverages

The fact that the relevant public will identify the two signs **Jaume Codorniu** and **Jaume Serra et al.** as a combination of the first name 'JAUME' followed by the surnames 'SERRA' and 'Codorniu'

is not sufficient to generate the necessary link between the signs, even if the earlier mark has a high reputation. This is because in the wine sector, when the conflicting signs consist of a first name that is not particularly rare or unusual and of surnames that are not particularly common in the relevant territory, the surnames are more distinctive than the first name (§ 53, 55, 97).

08/05/2019, T-358/18, [JAUME CODORNÍU / JAUME SERRA et al.](#), EU:T:2019:304, § 53, 55, 97

Establishment of a link

The BoA is not required to rule on the exceptionally strong reputation of a mark on its own motion where no evidence or arguments in this regard are provided by the party (§ 38-39).

In the context of the application of Article 8(5) CTMR [now Article 8(5) EUTMR], the applicant is required to provide prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or detriment, when indicated on the basis of logical deductions (§ 47-48).



11/04/2019, T-655/17, [ZARA TANZANIA ADVENTURES \(FIG. MARK\) / ZARA et al.](#), EU:T:2019:241, § 38-39, 47-48

6.3.4 Risk of injury

6.3.4.1 Assessment of the risk of injury

[No key points available yet.]

6.3.4.2 Types of injury

- Taking unfair advantage of distinctiveness or repute

Taking unfair advantage of repute (free-riding) — Relevant factors

The nature and degree of proximity of the goods or services are relevant factors in determining whether the use of one trade mark takes unfair advantage of the distinctive character or reputation of another trade mark. However, the existence of similarity between the goods and services concerned by the conflicting trade marks not being a condition for the application of Article 8(5) EUTMR, arguments to establish that the goods covered by the conflicting marks are different are not relevant (§ 55-56).

HAWKERS **H A W K E R S** 26/06/2019, T-651/18, [HAWKERS \(fig.\) / HAWKERS \(fig.\) et al.](#), EU:T:2019:444, § 55-56

Taking unfair advantage of repute (free-riding) — Nature and degree of proximity of the goods or services

The nature and degree of proximity of the goods or services concerned are relevant factors for the purposes of determining whether the use of a trade mark takes unfair advantage of the distinctive character or reputation of another trade mark. However, the existence of a similarity

between the goods and services concerned does not constitute a condition for the application of Article 8(5) EUTMR (§ 182).

28/02/2019, T-459/18, [PEPERO original \(fig.\) / REPRÉSENTATION D'UN BATÔNNET \(fig.\)](#), EU:T:2019:119, § 182

Taking unfair advantage of repute (free-riding)

The prefix 'mc' of the opponent's family of marks (such as McDONALD'S) has acquired a high degree of distinctiveness through its use on the fast-food market (§ 71).

Having regard to the exceptional nature of the reputation of the earlier mark, the average level of attention of the relevant public, the existence of a degree of similarity between the marks and the significant degree of similarity between the services, as well as the existence of a family of marks, the structure of which is reproduced, at least in part, by the mark applied for, the relevant public would establish a link between the marks, even though the opponent did not offer any form of accommodation or hotel services (§ 85).

The relevant public would associate the mark applied for with the image of reliability, efficiency, low-cost services and, on that account, choose it instead of the services provided by its competitors. The mark applied for would therefore ride on the coat-tails of the earlier mark to benefit from the power of attraction, the reputation and the prestige of that mark. The economic advantage would consist, for the applicant, of exploiting the effort expended by the opponent to establish the reputation and the image of its earlier mark, without paying any compensation in exchange (§ 90, 98).

10/10/2019, T-428/18, [mc dreams hotels Träumen zum kleinen Preis! \(fig.\) / McDONALD'S et al.](#), EU:T:2019:738, § 71, 85, 90, 98

Taking unfair advantage of repute (free-riding)

In the context of the application of Article 8(5) CTMR [now Article 8(5) EUTMR], the opponent is required to provide prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or detriment, when indicated on the basis of logical deductions (§ 47-48). The BoA erred in finding that the opponent confined itself to making general allegations regarding the existence of a risk of unfair advantage being taken of the distinctive character and the repute of the earlier marks (§ 49). The opponent made a number of allegations based on the specific circumstances of the case during the administrative procedures, inter alia the tendency of fashion brand owners to expand their activities to other sectors, including possibly services of hotels and travel agency (§ 49).



11/04/2019, T-655/17, [ZARA TANZANIA ADVENTURES \(FIG. MARK\) / ZARA et al.](#), EU:T:2019:241, § 47-49

- [Detriment to distinctiveness](#)

[No key points available yet.]

- [Detriment to repute](#)

[No key points available yet.]

6.3.5 Use without due cause

[No key points available yet.]

7 ARTICLE 8(6) EUTMR — GEOGRAPHICAL INDICATIONS

Preliminary ruling — Geographical origin — Article 2(1)(a) Regulation No 510/2006 — Article 13(1) Regulation No 510/2006

Geographical indications (GIs) are protected against any evocation, including by figurative signs (§ 18). A producer established in a geographical area corresponding to a Protected Designation of Origin (PDO), whose products are not protected by the PDO but are similar or comparable to those protected by it, is not excluded from the application of Article 13(1)(b) Regulation No 510/2006 (§ 34).

02/05/2019, C-614/17; [Fundación Consejo Regulador de la Denominación de Origen Protegida Queso Manchego](#), EU:C:2019:344, § 18, 34

8 SPECIFIC RELATIVE GROUNDS FOR INVALIDITY: ARTICLE 60(2) EUTMR

8.1 PROOF OF THE APPLICABLE LAW GOVERNING THE SIGN

8.1.1 The burden of proof

[No key points available yet.]

8.1.2 Means of evidence and standard of proof

8.1.2.1 National law

[No key points available yet.]

8.1.2.2 European Union law

[No key points available yet.]

8.2 ENTITLEMENT: DIRECT RIGHT CONFERRED ON THE INVALIDITY APPLICANT

[No key points available yet.]

8.3 TYPES OF RIGHTS FALLING UNDER ARTICLE 60(2) EUTMR:

8.3.1 A right to a name/right of personal portrayal

[No key points available yet.]

8.3.2 Copyright

[No key points available yet.]

8.3.3 Other industrial property rights

[No key points available yet.]

8.4 PRECEDENCE IN TIME

[No key points available yet.]

8.5 RIGHT TO PROHIBIT THE USE OF A SUBSEQUENT TRADE MARK UNDER THE APPLICABLE LAW

[No key points available yet.]

CHAPTER IV — PROOF OF USE IN OPPOSITION; INVALIDITY PROCEEDINGS AND REVOCATION FOR NON-USE PROCEEDINGS (PoU)

1 PROCEDURAL ASPECTS

1.1 REQUEST FOR POU IN OPPOSITION AND INVALIDITY PROCEEDINGS

Request for proof of use

Article 47(2) EUTMR and Rule 22 EUTMIR do not lay down any specific requirements as to the form and content of the applicant's request of proof of genuine use (§ 44-46). According to case-law, such a request must be made expressly and timeously to the Office. The expression 'timeously' not only concerns the observance of any period laid down, but also implies the requirement to present that request before the OD, not for the first time before the BoA (§ 47). By the sentence 'Furthermore, we raise the objection of non-use (Art. 15)' inserted in a separate paragraph of its reply to the opposition, the applicant explicitly and unambiguously contested the genuine use of the earlier marks (§ 49-50).

28/11/2019, T-736/18, [Bergsteiger / BERG \(fig.\) et al.](#), EU:T:2019:826, § 44-47, § 49-50

1.2 BURDEN OF PROOF

No examination of genuine use *ex officio* in the proceedings before the BoA

When the issue of genuine use of the earlier mark is not specifically raised before the BoA, it does not constitute a question of law which must necessarily be examined by the BoA in order for the dispute before it to be settled. Consequently, it must not be regarded as the subject matter of the proceedings before the BoA (05/10/2017, T-36/17, COLINEB / Colina (fig.), EU:T:2017:690, § 21) (§ 39).

08/07/2020, T-659/19, [kix \(fig.\) / kik](#), EU:T:2020:328, § 39

1.3 ACQUIESCENCE — ARTICLE 61 EUTMR

Conditions of acquiescence

Four conditions must be satisfied to cause the start of the limitation period in consequence of acquiescence: (i) the later trade mark must be registered; (ii) the application must have been made in good faith by its proprietor; (iii) it must be used in the Member State where the earlier trade mark is protected; and, (iv) the proprietor of the earlier trade mark must be aware of the use of that trade mark after its registration (§ 20 and case-law cited).

24/01/2019, T-785/17, [BIG SAM SPORTSWEAR COMPANY \(fig.\) / SAM et al.](#), EU:T:2019:29, § 20

Relevant point in time

The plea of inadmissibility resulting from acquiescence requires demonstration of *actual awareness* of the use made of the more recent mark during a five-year period after its registration. The registration of the contested mark is one of the conditions which must be satisfied before the period of limitation in consequence of acquiescence pursuant to Article 61(1) EUTMR starts

running. The questions of whether the contested mark was used before its registration, and whether the proprietor of the earlier trade mark was aware of such a use before registration, are irrelevant for the calculation of the time period pursuant to this provision (§ 17-18).

20/06/2019, T-389/18, [WKU / WKA et al.](#), EU:T:2019:438, § 17-18

Relevant point in time

The fact that an earlier right holder had filed an opposition against the contested mark does not imply that this earlier right holder was necessarily aware of the subsequent use made of the contested mark. The date of filing of the opposition can therefore not constitute the starting point of the 5-year period for acquiescence (§ 36).

24/01/2019, T-785/17, [BIG SAM SPORTSWEAR COMPANY \(fig.\) / SAM et al.](#), EU:T:2019:29, § 36

2 NATURE OF USE

2.1 USE OF A MARK IN ACCORDANCE WITH ITS FUNCTION: INDIVIDUAL, COLLECTIVE AND CERTIFICATION MARKS

No genuine use — Descriptive use of a trade mark for specific goods

A trade mark is to be used in accordance with its essential function, guaranteeing the identity of the origin of the goods or services for which it is registered. This condition is not fulfilled where the mark affixed to an item does not contribute to creating an outlet or to distinguishing the item from the goods of other undertakings, but rather serves as a descriptive indication for the goods' ingredients (§ 83).

31/01/2019, C-194/17 P, [Cystus](#), EU:C:2019:80, § 83

No genuine use — Use for promotional purposes

The free distribution of the CDs, DVDs and software on which the contested trade mark is affixed, exclusively in the context of the marketing of goods (photobooks and calendars) — although it is indispensable for the order and design of these goods — does not constitute genuine use of the trade mark according to its essential function. The items are not distributed with the aim of penetrating the market for goods in the same class. Affixing the EUTM on such products does not aim at creating an outlet for them (§ 38-39).

11/04/2019, T-323/18, [DARSTELLUNG EINES SCHMETTERLINGS \(fig.\)](#), EU:T:2019:243, § 38-39

Genuine use — Irrelevance of the classification of a mark for the assessment of genuine use

When assessing the distinctiveness of a mark, the classification of a 'position mark' as a figurative or three-dimensional mark, or as a specific category of marks, is irrelevant (§ 42). This classification is also irrelevant in assessing the genuine use of such a mark (§ 43).

The GC correctly relied on the graphic representation of the mark, regardless of its classification, for the purpose of assessing whether there is genuine use, stating that it could be inferred directly from the graphic representation of the mark, and with sufficient precision, that the protection

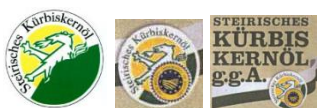
sought covered only a cross, consisting of two black intersecting lines, represented in solid lines (§ 41, 46-47).



06/06/2019, C-223/18 P, [DEVICE OF A CROSS ON A SPORT SHOE SIDE \(fig.\)](#), EU:C:2019:471, § 41-43, 46-47

No genuine use — No use in accordance with the function of indicating origin

Where the use of an individual mark, despite certifying the geographical origin of the mark and the qualities attributable to the origin of the goods from different producers, does not guarantee to consumers that those goods or services come from a single undertaking under the control of which they are manufactured or supplied and which, consequently, is responsible for the quality of those goods or services, such use is not made in accordance with the function of indicating origin (§ 39).



17/10/2019, C-514/18P, [Steirisches Kürbiskernöl \(fig.\)](#), EU:C:2019:878, § 39

Genuine use — Indication of the company name combined with the sign

Where the trade mark is systematically placed in invoice headers as the first element above the company name 'ad Pepper media GmbH', use of the sign **ad pepper** goes beyond merely identifying the company and refers to the commercial origin of the services provided. The design of the invoices therefore allows a close connection to be made between the sign **ad pepper** and the invoiced services (§ 82).

03/10/2019, T-666/18, [ad pepper \(fig.\)](#), EU:T:2019:720, § 82

Genuine use of collective marks

The essential function of a collective mark is to distinguish the goods or services of the members of the association which is the proprietor of that mark from those of other undertakings (§ 52). Therefore, unlike an individual mark, a collective mark does not have the function of indicating to the consumer 'the identity of origin' of goods or services in respect of which it is registered (§ 53). Article 66 CTMR [now Article 74(1) EUTMR] by no means requires that manufacturers, producers, suppliers or traders that are affiliated with the association which is the proprietor of a collective mark, form part of the same group of companies which manufacture or supply the goods or services under unitary control (§ 54). Collective marks are, like individual marks, part of the course of trade (§ 56). Their use must therefore, in order to be classified as 'genuine' within the meaning of Article 15(1) CTMR [[now Article 18(1) EUTMR], be part of the objective of the undertakings concerned to create or preserve an outlet for their goods or services (§ 56).

A collective mark is used in accordance with its essential function from the moment it enables the consumer to understand that the goods or services covered originate from undertakings that are affiliated with the association, the proprietor of the mark, and to thereby distinguish those goods or services from those originating from undertakings that are not affiliated (§ 58).

The assessment of genuine use of the mark should be carried out by evaluating, particularly, whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods

or services, the characteristics of the market and the scale and frequency of use of the mark (§ 62).



12/12/2019, C-143/19P, [EIN KREIS MIT ZWEI PFEILEN \(fig.\)](#), EU:C:2019:1076, § 52-54, 56, 58, 62

Evidence concerning proof of genuine use

As an accumulation of items of evidence may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (17/04/2008, C-108/07 P, *Ferro*, EU:C:2008:234, § 36), all the evidence submitted to the BoA must make it possible to establish proof of use and each piece of evidence therefore does not necessarily have to relate to the place, duration, nature and extent of use (§ 61-63)

13/06/2019, T-398/18, [DERMAEPIL SUGAR EPIL SYSTEM \(fig.\) / dermépil Perron Rigot \(fig.\)](#), EU:T:2019:415, § 61-63

Evidence concerning proof of genuine use

Statutory declarations by the managing director and the head of the HR department cannot in themselves constitute sufficient evidence of genuine use of the contested trade mark. However, they can be taken into consideration if they are supported by other evidence, without their impartiality or credibility having to be questioned (§ 89-90, 92).

03/10/2019, T-666/18, [ad pepper \(fig.\)](#), EU:T:2019:720, § 89-90, 92

Proof of genuine use of earlier national marks

When the proprietor of an EU trade mark requests proof of genuine use to be provided, that use constitutes a condition which must be met, not only by EU trade marks but also by earlier national marks relied on in support of an application for a declaration of invalidity of that EU trade mark. The application of Article 64(2) EUTMR to earlier national marks under paragraph 3 of that Article means that genuine use is to be defined according to Article 18 EUTMR, and not assessed according to the relevant national law (§ 23).

The use of the sign did not alter the distinctive character of the earlier national mark (§ 28-34).

12/07/2019, T-412/18, [mobile.ro \(fig.\) / mobile \(fig.\)](#), EU:T:2019:516, § 23, 28-34

2.2 PUBLIC USE IN THE COURSE OF TRADE

Outward use of a mark — Relevant public

Genuine use of a mark depends on the market in which the EUTM proprietor pursues its commercial activities and in which it hopes to put its mark to use. Accordingly, for assessing outward use of a mark, the relevant public to which marks are addressed comprises not only end consumers, but also specialists, industrial customers and other professional users (§ 80).

03/10/2019, T-666/18, [ad pepper \(fig.\)](#), EU:T:2019:720, § 80

Outward use of a mark — Relevant public

Outward use does not necessarily mean use aimed at end consumers. The relevant public does not comprise only the end consumer, but also specialists, industrial customers and other professional users. Genuine use of the mark relates to the market in which its proprietor pursues its commercial activities (§ 38, 39)

04/04/2019, T-910/16 and T-911/16, [TESTA ROSSA \(fig.\)](#), EU:T:2019:221, § 38-39

Genuine use for goods or services already marketed or about to be marketed

Genuine use of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way.

03/07/2019, C-668/17 P, [Boswelan](#), EU:C:2019:557, § 39, 51, 53

2.3 USE IN RELATION TO GOODS OR SERVICES

Requirements of nature of use for the relevant goods

Use of the sign **Jones** to designate shops located in Austria is relevant for determining the place of use, but does not meet the requirements of nature of use for the relevant goods (§ 86). Although evidence providing indications of the time of use of the sign **Jones** was submitted, such use does not meet the relevant requirements as to the nature either since, in the catalogues and magazine submitted, the sign does not appear on the clothing, but in the page margins (§ 70), and is therefore open to multiple interpretations (§ 87).

17/09/2019, T-633/18, [TON JONES / Jones \(fig.\) et al.](#), EU:T:2019:608, § 70, 86-87

Assessment of proof of use for goods and services — Notion of partial use — Coherent subcategories of goods — Criterion of the purpose and intended use of the goods

From the wording of the last sentence of Article 42(2) CTMR [now Article 47(2) EUTMR] and the principles established by case-law (11/12/2014, C-31/14 P, *Premeno*, EU:C:2014:2436, § 37, 39) (§ 39-42), it follows that it is important to assess in a concrete manner – principally in relation to the goods for which the proprietor of the earlier mark has submitted proof of use of the earlier mark – whether those goods constitute an independent subcategory in relation to the goods falling within the class of goods concerned, so as to link the goods for which genuine use of the earlier mark has been proved to the category of goods covered by the application for registration of that trade mark (§ 46).

The aim of the criterion of the purpose and intended use of the goods is not to provide an abstract or artificial definition of independent subcategories of goods; it must be applied coherently and specifically (11/12/2014, C-31/14 P, *Premeno*, EU:C:2014:2436, § 37, 39, 41) (§ 50). Accordingly, if the goods concerned have several purposes and intended uses, determining whether a separate subcategory of goods exists, by considering in isolation each of the purposes that those goods may have, will not be possible. Indeed, such an approach would not enable independent subcategories to be identified coherently and would excessively limit the rights of the proprietor of the earlier mark, *inter alia*, in that their legitimate interest in expanding their range of goods or services for which their trade mark is registered would not be sufficiently taken into consideration (§ 51).

Most plausible and predictable interpretation of the specification of a trade mark

When determining the extent of the protection of an earlier EU trade mark and assessing the evidence of genuine use of that mark in the context of Article 47(2) EUTMR, if two possible literal interpretations of the specification of that mark exist, but one of them would lead to an absurd result as regards the extent of the protection of the mark, the BoA must opt for the most plausible and predictable interpretation of that specification. It would be absurd to adopt an interpretation of the specification that would have the effect of excluding all of the opponent's goods, leaving only goods for which it has not sought trade mark protection as the goods protected by the earlier EU trade mark (§ 51).

Only when both possible literal interpretations of the list of goods and services designated by an earlier EU trade mark are each equally plausible and predictable, is it appropriate to apply the principle derived from the judgment of 06/04/2017, T-39/16, NANA FINK (fig.) / NANA, EU:T:2017:263, § 48, that the proprietor of an EU trade mark should not gain from the infringement of its obligation to indicate the goods and services with clarity and precision (§ 60).

17/10/2019, T-279/18, [AXICORP ALLIANCE / ALLIANCE et al.](#), EU:T:2019:752, § 51, 60

Means of evidence — Undated evidence — Scope of protection

Undated evidence of use such as labels, photographs of shop windows and posts on social media may be intended to show the range of goods in respect of which the registered mark was used and how that mark was displayed on the contested goods, and therefore do not need to be dated (§ 45).

08/07/2020, T-686/19, [Gnc live well](#), EU:T:2020:320, § 45

Proof of use — Scope of protection of *retail sales services*

The earlier Spanish mark was registered for *retail sales services* before the Praktiker judgment (07/07/2005, C-418/02, Praktiker, EU:C:2005:425), which required clarification of the services but did not apply retroactively. There had been a request for proof of use and the BoA found use for *retail services for handbags, purses and wallets made from leather, ready-made clothing and footwear*.

The GC stated that the term 'retail sales services' is not a vague term and covers the retail sale of any goods (§ 39) and endorsed the BoA's finding of proof of use for *retail services for handbags, purses and wallets made from leather, ready-made clothing and footwear* (§ 40-41).

26/03/2020, T-653/18, [GIORGIO ARMANI le Sac 11 \(fig.\) / LESAC et al.](#), EU:T:2020:121, § 39, 40-41
26/03/2020, T-654/18, [le Sac 11 \(fig.\) / LESAC et al.](#), EU:T:2020:122, § 39, 40-41

Proof of use for accessories of goods classified in different classes of the Nice Classification

The proprietor is not required to prove genuine use of the trade mark based only on the formal interpretation of the Nice Classification for accessories of goods that are classified in different classes but, in reality, concern the same goods (§ 34). The Nice Classification is, in essence, designed to reflect the needs of the market and not to impose an artificial segmentation of the goods (§ 40).

28/05/2020, T-681/18, [Stayer \(fig.\)](#), EU:T:2020:222, § 40

Proof of use — Irrelevance of the classification of goods according to other rules of EU law

The contested mark has been put to genuine use in connection with the goods for which it was registered, namely *pharmaceutical products administered by injection for use in moisturising skin and reducing wrinkles* in Class 5 (§ 29-32). The fact that these goods are not classified as *pharmaceuticals*, that is to say *medicines*, registered and authorised in accordance with Directive 2001/83/EC on the Community code relating to medicinal products for human use, but rather as *other preparations for medical use*, within the meaning of that class, namely *injectable dermal fillers*, regulated by Directive 93/94 is irrelevant. The classification of goods according to other rules of EU law, such as that of guaranteeing the quality of the goods, is not in principle decisive with regard to their classification for the purposes of the registration of an EU trade mark (§ 27-28).

25/06/2020, T-104/19, [Juvéderm](#), EU:T:2020:283, § 27-32

Proof of use— Affixing of a trade mark in publications — Scope of protection

The affixing of a trade mark to a magazine, periodical, review, journal or catalogue is, in principle, capable of constituting ‘valid use of the sign’ as a trade mark for the goods and services designated by that mark if the content of the publications confirms use of the sign for goods and services covered by it (05/02/2020, T-44/19, TC Touring Club (fig.) / TOURING CLUB ITALIANO et al., EU:T:2020:31, § 67) (§ 51).

08/07/2020, T-533/19, [sflooring \(fig.\) / T-flooring](#), EU:T:2020:323, § 51

Proof of use— Catalogues — Scope of protection — Homogenous subcategories of goods

Unlike the catalogues in the present case, the catalogues submitted in ‘peerstorm’ (08/07/2010, T-30/09, Peerstorm, EU:T:2010:298) were intended for end consumers, contained clear and precise information on the items available, their prices, the shops in which they were sold, and how they were marketed. Therefore, those catalogues alone provided sufficient information as to the place, time, nature and extent of the use of the earlier mark (§ 45-46).

The goods *leather and imitation of leather; animal skins, hides* designate raw or semi-finished goods: photographs of bags, which are finished goods, cannot constitute evidence of use in that regard (§ 53).

Men and women’s denim jeans were the only items of clothing in Class 25 for which there were invoices and evidence of use showing the goods with the signs at issue affixed: insofar as those goods constitute a consistent and homogenous subcategory, the BoA rightly carried out its examination for that specific subcategory (§ 90).

28/05/2020, T-615/18, [D \(fig.\) / D \(fig.\) et al.](#), EU:T:2020:223, § 45-46, 53, 90

3 PLACE OF USE

Territorial scope of use

Article 42(2) and (3) CTMR [now Article 47(2) and (3) EUTMR] and Rule 22 CTMIR [now Article 10(3) EUTMDR] do not require proof of genuine use in a substantial part of the relevant territory (§ 37, 41).

04/04/2019, T-779/17, [VIÑA ALARDE / ALARDE](#), EU:T:2019:220, § 37, 41

Territorial scope of use

In certain circumstances, the proof of genuine use can be restricted to the territory of a single Member State. That may, in particular, be the case for the pharmaceutical market, which is characterised by a system of marketing authorisation and certification of protection which may be issued on a national basis (§ 43).

06/03/2019, T-321/18, [NOCUVANT/ NOCUTIL et al.](#), EU:T:2019:139, § 43

Territorial scope of use

The territorial scope is only one of several factors that have to be taken into account in assessing whether use of an EU trade mark is genuine. A *de minimis* rule for establishing whether that factor is satisfied cannot be laid down. It is not necessary that an EU trade mark be used in an extensive geographic area for the use to be deemed genuine, since such a qualification will depend on the characteristics of the goods or services concerned on the corresponding market and, more generally, on all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered (19/12/2012, C-149/11, *Onel / Omel*, EU:C:2012:816, § 55) (§ 80).

It is not required either that the EUTM be used in a substantial part of the European Union. The possibility that the mark may have been used in the territory of a single Member State must not be ruled out, since the borders of the Member States must be disregarded and the characteristics of the goods or services concerned must be taken into account (§ 80).

07/11/2019, T-380/18, [INTAS / INDAS \(fig.\) et al.](#), EU:T:2019:782, § 80

4 TIME OF USE

4.1 PERIOD OF TIME TO BE CONSIDERED IN OPPOSITION PROCEEDINGS

[No key points available yet.]

4.2 PERIOD OF TIME TO BE CONSIDERED IN REVOCATION PROCEEDINGS

Definition of relevant periods — Article 57(2) and (3) CTMR [now Article 64(2) and (3) EUTMR]

In the context of invalidity actions, the contested mark holder may request the applicant for invalidity to submit proof that an earlier mark had been genuinely used during two distinct periods (although they may overlap), that is, firstly, ‘during the period of five years preceding the date of

the application for a declaration of invalidity', and secondly, during the period of five years preceding the *date of filing* or the priority date of the contested mark, provided the earlier mark was already registered for more than five years on this date, Article 57(2) and (3) CTMR [now Article 64(2) and (3) EUTMR]. The Office is not required to determine the relevant periods for the proof of use and to inform the invalidity applicant of them. It is therefore the invalidity applicant's responsibility to determine the relevant period(s) during which genuine use must be proved (§ 33). If the BoA finds an error by the CD in calculating the relevant periods, it cannot base its decision on a lack of genuine use of the earlier marks for a period that was never discussed by the parties and on which they had no opportunity to comment or to submit evidence at any stage of the proceedings before the Office (§ 39).

20/03/2019, T-138/17, [PRIMED / GRUPO PRIM \(fig\) et al.](#), EU:T:2019:174, § 33, 39

Definition of relevant periods

Article 57(2) CTMR [now Article 64(2) EUTMR], must be considered a substance provision as regards the definition of periods where genuine use must be proven (§ 20). The second relevant period must be calculated from the date of the first publication of the international registration (§ 40).

06/06/2019, T-220/18, [Battistino \(fig.\) / BATTISTA et al.](#), EU:T:2019:383, § 40

06/06/2019, T-221/18, [BATTISTINO / BATTISTA et al.](#), EU:T:2019:382, § 40

Consideration of circumstances after the relevant period

For assessing genuine use during the relevant period, it is not ruled out that account may be taken of circumstances after that period. Such circumstances may make it possible to confirm or better assess the extent to which the trade mark was used during the relevant period (§ 65-69).

03/10/2019, T-666/18, [ad pepper \(fig.\)](#), EU:T:2019:720, § 65-69

Means of evidence — Documents from just outside the relevant period — Consideration in combination with other evidence for extent of use

Provided that there is proof of use which relates to the relevant period, the documents from just outside that period, far from being irrelevant, can be taken into account and evaluated together with the rest of the evidence, since they can offer proof of real and genuine commercial exploitation of the mark (§ 46).

08/07/2020, T-686/19, [Gnc live well](#), EU:T:2020:320, § 46

Means of evidence — Documents from outside the relevant period — No consideration for extent of use

When assessing genuine use of an earlier mark, account may be taken, where appropriate, of evidence produced after the relevant date, in order to better assess the extent of use of the earlier mark during the relevant period (28/02/2019, T-459/18, PEPERO original (fig.) / REPRÉSENTATION D'UN BATÔNNET (fig.), EU:T:2019:119, § 63). However, a sales volume assessment cannot be called into question by taking into account invoices that postdate the relevant period by 3 months (§ 56).

08/07/2020, T-533/19, [sflooring \(fig.\) / T-flooring](#), EU:T:2020:323, § 56

5 EXTENT OF USE

Extent of use — Pharmaceutical market

The requirement of genuine use is not intended to assess commercial success or to review the economic strategy of an undertaking (§ 49). The use of the earlier mark need not always be quantitatively significant in order to be deemed genuine. A low turnover attained in the EU pharmaceutical market can be considered sufficient for proof of genuine use (§ 51).

06/03/2019, T-321/18, [NOCUVANT / NOCUTIL et al.](#), EU:T:2019:139, § 51

Extent of use — Pharmaceutical market

With regard to the proof of use submitted for the earlier mark, 74 invoices issued to more than 20 different companies located across Italy during the relevant period of 5 years for the sale of 'hair care lotions' for a total amount of approximately EUR 2 450, are considered sufficient, particularly taking into account that most of the invoices are addressed to companies operating pharmacies, which usually order goods on a regular basis in limited quantities (§ 52-54).

19/09/2019, T-359/18, [TRICOPID / TRICODIN \(fig.\)](#), EU:T:2019:626, § 52-54

Extent of use — Means of evidence — Different types of evidence

No rule of law requires that the proof of genuine use must consist of different types of evidence (§ 26). Genuine use can be proved by invoices only, provided they contain all the relevant indications required by Rule 22(3) CTMIR [now Article 10(3) EUTMDR], notably place, time, extent and nature of use (§ 27).

The differences between the volume of capsules and labels purchased and the number of bottles sold reinforces the assumption that the evidence submitted represents only a sample of invoices (§ 54).

A small volume of products marketed, notably 1 200 bottles of wine for a total value of EUR 4 200 can be considered sufficient to prove actual commercial activity (§ 55, 58-59).

04/04/2019, T-779/17, [VIÑA ALARDE / ALARDE](#), EU:T:2019:220, § 27, 54, 55, 58-59

Extent of use — Means of evidence — Catalogue

While a catalogue is not evidence of sales, it is, however, proof that the goods in question have been placed on the market and that those goods have actually been offered for sale to consumers (§ 31).

27/06/2019, T-268/18, [Luciano Sandrone / DON LUCIANO](#), EU:T:2019:452, § 31

Extent of use — Expensive luxury products — Restricted market

Coffee is a widely consumed product that can be sold in the entire territory of the EU and is not, in principle, an expensive, luxury product, or a product sold in limited quantities in a restricted market (§ 60).

06/06/2019, T-220/18, [Battistino \(fig.\) / BATTISTA et al.](#), EU:T:2019:383, § 60

Means of evidence — Sufficient overall volume of income provided by the invoices in relation to the unit price of the goods

The overall volume of income proved by the invoices, namely USD 34 733.82, cannot be regarded as token, considering the unit price of between USD 2.57 to USD 34.37 at which the contested goods are sold (§ 71).

08/07/2020, T-686/19, [Gnc live well](#), EU:T:2020:320, § 71

6 USE OF THE MARK IN FORMS DIFFERENT FROM THE ONE REGISTERED

6.1 ADDITIONS

Use as registered — Joint use with another trade mark

The fact that the relevant public acknowledges the earlier mark, by referring to another mark designating the same products, and which is used jointly, does not mean that the earlier mark itself is not used as a source of identification (§ 74).

The condition of genuine use of a trade mark may be fulfilled when it is used in conjunction with another trade mark, provided that the mark continues to be regarded as an indication of the origin of the product in question (§ 97).

28/02/2019, T-459/18, [PEPERO original \(fig.\) / REPRÉSENTATION D'UN BATÔNNET \(fig.\)](#), EU:T:2019:119, § 74, 97

Use not as registered — Joint use of a shape mark with a word mark

The use of a three-dimensional mark consisting of the shape of an oven together with the word mark **Bullerjan** is liable to alter the distinctive character of the shape mark unless the word part of the mark is comparatively less distinctive. This was not the case because it was found that the shape was particularly unusual, partly due to functional characteristics which contributed to its distinctive character (§ 31-34, 40-45).



23/01/2019, C-698/17P, [SHAPE OF AN OVEN \(3D MARK\)](#), EU:C:2019:48, § 31-34, 40-45

Use as registered — Graphic additions for words marks

Word marks are considered to be used as registered insofar as the graphic additions do not alter the general impression that they produce (§ 42).

27/06/2019, T-268/18, [Luciano Sandrone / DON LUCIANO](#), EU:T:2019:452, § 42

Use as registered — Addition of the company name

The fact that the company name or the trade name of the proprietor of the earlier mark is also depicted in the representation of that mark is not such as to alter its distinctive character, since

the earlier mark may clearly be perceived independently in a form that does not differ from that in which it is registered (§ 34).

21/11/2019, T-527/18, [tec.nicum \(fig.\) / T TECNIUM \(fig.\)](#), EU:T:2019:798, § 34

Use as registered — Registration without colour claim — Modification of banal colours — No alteration of the distinctive character of the mark

Since the earlier mark was registered without any colour claim, its representation in colour does not alter the distinctive character of the mark as registered, because the registration covers all possible colour combinations (§ 44).

15/10/2019, T-582/18, [X BOXER BARCELONA \(fig.\) / X \(fig.\) et al.](#), EU:T:2019:747, § 44

Use as registered — Modification of colours — No alteration of the distinctive character of the mark

The use of different colours that are not particularly original is neither distinctive nor dominant and does not have the effect of altering a mark as registered (§ 45-46).



03/10/2019, T-666/18, [ad pepper \(fig.\)](#), EU:T:2019:720, § 45-46

Use as registered — No alteration of the distinctive character of the mark

The fact that the signs as used contain two separate word components ('ad' and 'pepper') is not in itself capable of affecting the distinctive character of the contested trade mark, since the relevant public will break the word down into elements that have a concrete meaning for it or that resemble words it knows (§ 39-40).

The figurative element of three crooked chilli peppers plays only a secondary role in the signs used by the proprietor (§ 46-50).

Whether the signs are written in upper or lower case is irrelevant, since word marks that differ only in this respect are considered to be identical (§ 55).

The additional verbal elements 'Germany', 'digital pioneers since 1999' and 'the e-advertising network' do not affect the distinctive character of the trade mark since they are placed underneath the actual sign and will be perceived by the public as descriptive additions (§ 60-68). Therefore, overall, these forms of use differ only in negligible elements from the form of the trade mark as registered (§ 69).

03/10/2019, T-668/18, [ADPepper](#), EU:T:2019:719, § 39-40, 46-50, 55, 60-68, 69

Use as registered — No alteration of the distinctive character of the mark

The figurative elements in the earlier mark are limited to the presentation of the word 'brownies' in a yellow stylised font, the dot on the letter 'i' in the form of a flower and, sometimes, an uneven border (§ 66). The word 'brownies' remains the distinctive element in the sign thus stylised and, consequently, its use in that form is to be considered use of the earlier mark (§ 68).

The fact that a figurative mark, while having a certain distinctive character, may also be used to decorate the product bearing it does not affect its ability to fulfil the essential function of a mark.

That is especially true in the clothing sector, where it is not unusual for products to bear a stylised form of a mark (§ 69).



30/01/2020, T-598/18, [BROWNIE / BROWNIE, Brownie \(series mark\)](#); EU:T:2020:22, § 66, 68-69

Use not as registered — Addition of distinctive elements — Addition of a ‘house mark’ — Alteration of the distinctive character of the mark

The way in which the combination ‘air blue’ or ‘air blue 100’ is used in the evidence submitted alters the distinctive character of the contested mark AIR as registered (§ 32). While the word ‘blue’ is often used on the tobacco market by various manufacturers, there is no evidence that the relevant public would perceive that word or the colour blue as having a descriptive purpose indicating a milder taste. The fact that the word ‘blue’ appears on invoices in the abbreviated form ‘bl’ does not demonstrate any descriptiveness in relation to the contested goods since the descriptive character must be assessed in relation to the goods and not the details on the invoices. Moreover, the recipients of invoices are professionals and not the general public in relation to which the genuine use of the contested mark must be assessed (§ 30).

The element ‘memphis’ is always clearly visible in a dominant position in the overall impression produced by the trade mark as used. Even if that element were a ‘house mark’, it would not call into question the fact that that word alters the distinctive character of the contested mark AIR, since the relevant public no longer perceives the element ‘air’ as an indication of the origin of the goods in question (18/07/2013, C-252/12, Specsavers, EU:C:2013:497, § 26) (§ 35).



08/07/2020, T-800/19, [Air](#), EU:T:2020:324, § 30, 32, 35

6.2 OMISSIONS

[No key points available yet.]

6.3 OTHER ALTERATIONS

Use of a three-dimensional mark

The three-dimensional character of a mark precludes a static vision, in two dimensions, and commands a dynamic perception, in three dimensions. Therefore, the representations in perspective, and in any position, of the product (the shape of which embodies the earlier mark) are of real relevance for the purpose of appreciating its serious use and cannot be disregarded simply because they do not constitute two-dimensional reproductions of the shape (§ 93).

28/02/2019, T-459/18, [PEPERO original \(fig.\) / REPRÉSENTATION D'UN BATÔNNET \(fig.\)](#), EU:T:2019:119, § 93

7 USE FOR THE GOODS OR SERVICES FOR WHICH THE MARK IS REGISTERED, CATEGORIES AND SUBCATEGORIES

7.1 USE AND REGISTRATION FOR GENERAL INDICATIONS IN ‘CLASS HEADINGS’

[No key points available yet.]

7.2 USE FOR SUBCATEGORIES OF GOODS/SERVICES AND SIMILAR GOODS/SERVICES

Subcategories of goods and services for proof of genuine use

When defining subcategories for which genuine use of the mark was shown, the purpose of the goods and services is a relevant factor (§ 44). The goods are dissimilar when the relevant consumers do not overlap (§ 55).

07/02/2019, T-789/17, [TecDocPower / TecDoc \(fig.\) et al.](#), EU:T:2019:70, § 44, 55

Subcategories of goods and services for proof of genuine use — Wine — Designation of origin of a wine

The designation of origin of a wine cannot be considered to be of systemic importance in determining whether wines with different designations of origin may constitute sufficiently defined and independent subcategories within the category ‘wines’ (30/06/2015, T-489/13, VIÑA ALBERDI / VILLA ALBERTI, EU:T:2015:446, § 37 (§ 45-46).

17/01/2019, T-576/17, [EL SEÑORITO / SEÑORITA](#), EU:T:2019:16, § 45-46

Subcategories of goods and services for proof of genuine use — Partial genuine use

If a trade mark has been registered for a category of goods or services which is sufficiently broad to be divided into subcategories capable of being viewed independently, proof that the mark has been genuinely used in relation to a part of those goods or services affords protection only for the subcategory or subcategories to which the goods or services for which the trade mark has actually been used belong (§ 47). The category of printed matter is broad enough to be subdivided (§ 52). The subcategory of printed matter printed with individual photos is sufficiently homogeneous (§ 53). Therefore, the protection of the contested trade mark is restricted to the subcategory printed matter printed with individual photos (§ 55).

11/04/2019, T-323/18, [DARSTELLUNG EINES SCHMETTERLINGS \(fig.\)](#), EU:T:2019:243, § 47, 52-53, 55

Necessity to break down wide range of goods and services into subcategories for proof of genuine use — Reference to the explanatory note to the Nice Agreement — Partial genuine use

The evidence provided in the context of revocation proceedings is valid insofar as it allows clear inferences to be drawn as to the criteria provided for in Article 10(3) EUTMDR (§ 40).

The explanatory note to the Nice Agreement states that Class 20 ‘includes mainly ... plastic goods, not included in other classes’ (§ 55). With respect to the plastic goods that are not included in other classes, as is the case with ‘urns’, the sale of those goods cannot constitute proof of genuine use with respect to a category as broad as ‘articles made of plastics’ or ‘goods of water-

soluble, biodegradable and compostable plastic' (§ 56). The requirement for proof of genuine use seeks to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services (§ 57).

The contested mark's goods in Class 20 should have been divided into subcategories and a separate analysis of the evidence provided in relation to each of those subcategories should have been carried out (§ 58).

29/04/2020, T-78/19, [green cycles \(fig.\)](#), EU:T:2020:166, § 40, 57, 58

7.3 USE OF THE MARK AS REGARDS INTEGRAL PARTS AND AFTER-SALES SERVICES OF THE REGISTERED GOODS

[No key points available yet.]

8 USE BY THE PROPRIETOR OR ON ITS BEHALF

[No key points available yet.]

9 PROPER REASONS FOR NON-USE

Proper reasons for non-use — Obstacles in sufficiently direct relationship with the trade mark

Only obstacles having a sufficiently direct relationship with a trade mark making its use impossible or unreasonable, and which arise independently of the will of the proprietor of that mark, may be described as 'proper reasons for non-use' of that mark. It must be assessed on a case-by-case basis whether a change in the strategy of the undertaking to circumvent the obstacle under consideration would make the use of that mark unreasonable (§ 66-73).

03/07/2019, C-668/17 P, [Boswelan](#), EU:C:2019:557, § 66-73

CHAPTER V — OTHER GROUNDS FOR REVOCATION

1 EUTM BECOMING A COMMON NAME (GENERIC TERM) — ARTICLE 58(1)(b) EUTMR

1.1 BURDEN OF PROOF

[No key points available yet.]

1.2 POINT IN TIME TO BE CONSIDERED

[No key points available yet.]

1.3 RELEVANT PUBLIC

[No key points available yet.]

1.4 COMMON NAME

[No key points available yet.]

1.5 DEFENCE FOR THE PROPRIETOR

[No key points available yet.]

2 EUTM BECOMING MISLEADING — ARTICLE 58(1)(c) EUTMR

2.1 BURDEN OF PROOF

[No key points available yet.]

2.2 POINT IN TIME TO BE CONSIDERED

[No key points available yet.]

3 ADDITIONAL GROUNDS FOR REVOCATION OF EU COLLECTIVE MARKS (ARTICLE 81 EUTMR)

[No key points available yet.]

4 ADDITIONAL GROUNDS FOR REVOCATION OF EU CERTIFICATION MARKS (ARTICLE 91 EUTMR)

[No key points available yet.]

CHAPTER VI — JURISDICTION

Preliminary ruling — Article 97(5) CTMR [now Article 125(5) EUTMR] — International jurisdiction

Article 97(5) CTMR must be interpreted as meaning that the proprietor of an EU trade mark, who considers that his rights have been infringed by the use without his consent, by a third party, of a sign identical to that mark in advertising and offers for sale displayed electronically in relation to products that are identical or similar to the goods for which that mark is registered, may bring an infringement action against that third party before an EU trade mark court of the Member State within which the consumers or traders to whom that advertising and those offers for sale are directed are located, notwithstanding that that third party took decisions and steps in another Member State to bring about that electronic display (§ 65).

05/09/2019, C-172/18, [AMS Neve e.a.](#), EU:C:2019:674, § 65

CHAPTER VII — DESIGN MATTERS

1 REGISTRATION PROCEEDINGS

1.1 CONTENTS OF THE APPLICATION

[No key points available yet.]

1.2 LANGUAGE OF THE APPLICATION

[No key points available yet.]

1.3 DATE OF RECEIPT

[No key points available yet.]

1.4 ALLOCATION OF A FILING DATE

[No key points available yet.]

1.5 REPRESENTATION OF THE DESIGN

[No key points available yet.]

1.6 COMPLIANCE WITH THE DEFINITION OF A DESIGN

[No key points available yet.]

1.7 PUBLIC POLICY AND MORALITY

[No key points available yet.]

1.8 INDICATION OF PRODUCTS

[No key points available yet.]

1.9 PRIORITY

[No key points available yet.]

1.10 DESCRIPTION

[No key points available yet.]

1.11 MULTIPLE APPLICATIONS

[No key points available yet.]

2 INVALIDITY PROCEEDINGS

2.1 SCOPE OF THE EXAMINATION

Article 25(1)(b) CDR as ground for invalidity — Scope of the examination

When the ground for invalidity relied on is Article 25(1)(b) CDR, it does not mean that the Office has to automatically examine all the requirements set out in Articles 4 to 9 EUTMR (§ 51), since those requirements are cumulative and the non-fulfilment of one of them can lead to the invalidity of the design (§ 54, 67).

The requirements set out in Articles 4 to 9 CDR relate to different legal criteria and, therefore, the facts and evidence submitted to prove the infringement of one are not necessarily relevant to the others (§ 68).

10/06/2020, T-100/19, [Acoplamientos para vehículos](#), EU:T:2020:255, § 54, 67-68

2.2 BELATED EVIDENCE

[No key points available yet.]

2.3 LOCUS STANDI OF THE APPLICANT

[No key points available yet.]

2.4 STATEMENT OF GROUNDS

[No key points available yet.]

2.5 FACTS, EVIDENCE AND ARGUMENTS

Application for a declaration of invalidity

When the application for a declaration of invalidity is based on the lack of novelty and individual character of the RCD, it must contain, *inter alia*, the indication and reproduction of the prior designs that could form an obstacle to the novelty or individual character of the RCD and documents proving their existence (§ 24).

Making reference to previous decisions, without elaborating further, does not satisfy the requirement to demonstrate the existence of a prior design identical to the contested design (§ 29).

It is for the applicant to make sure that all prior designs relied on are clearly identified and reproduced, given that invalidity proceedings are *inter partes* proceedings (§ 30).

17/09/2019, T-532/18, [Washing sponges](#), EU:T:2019:609, § 24, 29-30

2.6 SCOPE OF DEFENCE

[No key points available yet.]

2.7 REPLY BY THE APPLICANT

[No key points available yet.]

2.8 EXAMINATION OF THE GROUNDS FOR INVALIDITY

Lack of reasoning — Article 63 CDR — Scope of the examination in invalidity proceedings

The interpretation of Article 95 EUTMR is applicable, *mutatis mutandis*, to the examination to be carried out by the Office in invalidity proceedings pursuant to Article 63 CDR: the applicant for a declaration of invalidity must provide elements to show that the contested design does not fulfil the requirements set out in Articles 4 to 9 CDR (§ 70-71).

The dismissal of the appeal reflects a complete turnabout in the BoA's position on the application of Article 4(2) and (3) CDR to the contested RCD, as compared to the position indicated in its communication to the parties during the appeal proceedings. The BoA was obliged to clearly state the reasons for that change (§ 114), since that communication, and the subsequent observations submitted by the parties, were part of the context in which it adopted the contested decision (§ 124). Without those reasons, the applicant is not in a position to meaningfully challenge the BoA's departure from the conclusions in its communication (§ 116) and the GC is not in a position to verify the merits of those reasons or to carry out its review properly (§ 117).

10/06/2020, T-100/19, [Acoplamientos para vehículos](#), EU:T:2020:255, § 70-71, 114, 116-117, 124

2.9 JURISDICTION

Preliminary ruling — Design — Article 90(1) CDR — Jurisdiction of national courts of first instance

Article 90(1) CDR must be interpreted as meaning that the courts and tribunals of the Member States with jurisdiction to order provisional measures, including protective measures, in respect of a national design also have jurisdiction to order such measures in respect of a Community design (§ 44).

21/11/2019, C-678/18, [Procureur-Generaal bij de Hoge Raad der Nederlanden](#), EU:C:2019:998, § 44

3 THE DIFFERENT GROUNDS FOR INVALIDITY

3.1 NOT A DESIGN

3.1.1 Living organisms

[No key points available yet.]

3.1.2 Ideas and methods of use

[No key points available yet.]

3.2 LACK OF ENTITLEMENT

[No key points available yet.]

3.3 TECHNICAL FUNCTION

[No key points available yet.]

3.4 DESIGNS OF INTERCONNECTIONS

[No key points available yet.]

3.5 LACK OF NOVELTY AND INDIVIDUAL CHARACTER

[No key points available yet.]

3.5.1 Disclosure of earlier design

3.5.1.1 General principles

Public availability (disclosure) of an earlier design — Article 7 CDR

A disclosure cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient disclosure of the earlier design, 09/03/2012, T-450/08, Phials, EU:T:2012:117 (§ 21-24).

13/06/2019, T-74/18, [Informationstafeln für Fahrzeuge](#), EU:T:2019:417, § 21-24

3.5.1.2 Establishing the event of disclosure

Means of evidence — Proof of disclosure

To establish that there has been disclosure of an earlier design, it is necessary to carry out a two-stage analysis to examine: 1) whether the evidence submitted in the application for a declaration of invalidity shows, firstly, that there have been events constituting disclosure of a design and, secondly, that that disclosure occurred before the date of filing or priority of the contested design; 2) if the holder of the contested design has claimed the contrary, whether those events could reasonably have become known in the normal course of business to the specialised circles of the sector concerned operating within the EU, failing which, a disclosure will be considered to have no effect and will not be taken into account (§ 20).

The disclosure of an earlier design cannot be proved by means of probabilities or presumptions but must be demonstrated by solid objective evidence of actual disclosure of the earlier design on the market. In addition, the items of evidence provided by the applicant for a declaration of invalidity must be assessed in relation to each other. Although some of the items of evidence might be insufficient on their own, when combined or read in conjunction with other documents or information, they may contribute to establishing disclosure. Lastly, in order to assess the evidential value of a document, it is necessary to verify the plausibility and the accuracy of the information contained in that document (§ 22).

Means of evidence — Proof of disclosure

The disclosure of an earlier design cannot be proved by means of probabilities or suppositions but must be demonstrated by precise and objective evidence of an effective disclosure in the market (§ 28).

A publication of a patent application by the German Patent Office is proof of a disclosure of a design contained in it (§ 30).

Technical drawings submitted without complementing documents (affidavits, catalogues etc.) are not sufficient as proof of disclosure. They are typically made for internal use (§ 33-35).

24/10/2019, T-559/18, [Medizinische Pflaster](#), EU:T:2019:758, § 28, 30, 33-35

24/10/2019, T-560/18, [Medizinische Pflaster](#), EU:T:2019:767, § 30, 33-35

3.5.1.3 Official publications

[No key points available yet.]

3.5.1.4 Exhibitions and use in trade

[No key points available yet.]

3.5.1.5 Disclosures derived from the internet

[No key points available yet.]

3.5.1.6 Disclosure to a third person under explicit or implicit conditions of confidentiality

[No key points available yet.]

3.5.1.7 Disclosure within the priority period

[No key points available yet.]

3.5.1.8 Grace period

[No key points available yet.]

3.5.2 Assessment of novelty

[No key points available yet.]

3.5.3 Assessment of individual character

Freedom of designer — Individual character — Overall impression — Technical function of design

The saturation of the state of the art is not a restriction of the designer's freedom of design. It is up to the invalidity applicant to prove that the freedom of the designer is not restricted by regulations or technical function (§ 29). The impression created by a design is also determined by the way in which the product is used (§ 43). It is irrelevant that not all of the contested design's elements are shown in all graphical representations since all elements are shown together in at least one of the graphical representations (§ 51). Although the earlier design does not show certain parts of the contested design, the assessment of the overall impression is not limited to those elements. All elements are to be taken into account when assessing whether the overall impression of the contested design is different from that produced by the earlier design (§ 54-56).



07/02/2019, T-766/17, [Leuchten](#), EU:T:2019:68, § 29, 43, 51, 54-56



07/02/2019, T-767/17, [Leuchten](#), EU:T:2019:67, § 29, 43, 51, 54-56

Freedom of designer — No Individual character — No different overall impression

When assessing the individual character of a design, any differences that are insufficiently significant to affect the overall impression are not to be taken into account, even though they may be more than insignificant details (§ 25, 40).

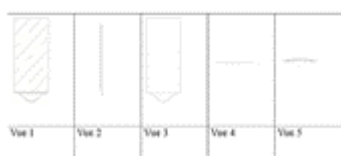
The comparison of the overall impressions produced by the designs must be synthetic in nature and cannot be confined to the analytical comparison of a list of similarities and differences (§ 49).



10/05/2019, T-517/18, [Backwaren](#), EU:T:2019:323, § 25, 40, 49

Freedom of the designer — No individual character — No different overall impression

The freedom of the designer is restricted, inter alia, by the constraints of the features imposed by the technical function of the product or an element thereof, or by statutory requirements applicable to the product. Marketing trends are irrelevant. The greater the designer's freedom in developing a design, the less likely it is that minor differences between the designs will be sufficient to produce different overall impressions on an informed user. Indeed, this only moderates the individual character assessment, but does not determine how different the two designs have to be in order for one of them to have individual character, 10/09/2015, T-525/13, Sacs à main, EU:T:2015:617 (§ 35).



13/06/2019, T-74/18, [Informationstafeln für Fahrzeuge](#), EU:T:2019:417, § 35

Minor differences — No individual character — No different overall impression

Despite the relatively high level of attention, the informed user does not notice minor differences that may exist between the designs (13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 90) (§ 62).



08/07/2020, T-748/18, [Pneumatic power tools](#), EU:T:2020:321, § 62

Freedom of designer — Informed user — Different overall impression

The informed user of vehicles is aware that manufacturers regularly submit their models to technical and visual restyling (§ 28).

If differences are sufficiently clear to conclude that the design produces a different overall impression on the informed user, a weighting of each of the characteristics and an analysis of common points is not required (§ 43).

The freedom of motor vehicle designers is limited to the extent that a motor vehicle's purpose is to transport people or products and is subject to certain legal requirements which oblige it to include elements such as headlights, stop lights, indicators and mirrors (§ 46).

Potential market expectations or certain design trends do not constitute relevant limitations on the freedom of the designer (§ 50).



06/06/2019, T-43/18, [Fahrzeuge](#), EU:T:2019:376, § 28, 43, 46, 50

Informed user — Individual character — Different overall impression

The informed user of vehicles is aware that manufacturers regularly submit their models to technical and visual restyling (§ 28).

If differences are sufficiently clear to conclude that the design produces a different overall impression on the informed user, a weighting of each of the characteristics and an analysis of common points is not required (§ 45).

The freedom of motor vehicle designers is limited to the extent that a motor vehicle's purpose is to transport people or products and is subject to certain legal requirements which oblige it to include elements such as headlights, stop lights, indicators and mirrors (§ 48).

Potential market expectations or certain design trends do not constitute relevant limitations on the freedom of the designer (§ 52).



06/06/2019, T-191/18, [Kraftfahrzeuge](#), EU:T:2019:378, § 28, 45, 48, 52



06/06/2019, T-192/18, [Kraftfahrzeuge](#), EU:T:2019:379, § 28, 45, 48, 52

Freedom of designer — Informed user — No individual character

Informed user. In order to ascertain the product in which the contested design is intended to be incorporated or to which it is intended to be applied, the relevant indication in the application for registration of that design should be taken into account, and also, where necessary, the design itself, insofar as it clarifies the nature of the product, its intended purpose or its function. Such consideration may enable the identification of the product within a broader category of goods indicated at the time of registration and therefore to determine the informed user and the degree of freedom of the designer in developing its design (§ 33-34).

There are no special categories in the current International Classification for Industrial Designs designating ‘sports cars’, ‘limousines’ or ‘Porsche 911’, and the RCD proprietor itself requested and obtained the registration of the contested design for goods in Class 12-08 *motor cars, buses and lorries* (§ 36). Thus, the informed user of the products is not a user of ‘Porsche 911’ cars, but of cars in general, who is familiar with the models available on the market and whose level of attention and interest is high (§ 28, 33-35, 37).

Freedom of designer. The freedom of motor vehicle designers is limited to the extent that a motor vehicle’s purpose is to transport people or products and is subject to certain legal requirements which oblige it to include elements such as headlights, stop lights, indicators and mirrors. However, it is not restricted in relation to the design of these components (§ 50).

Potential market expectations or certain design trends (namely the expectations of consumers, to find the ‘design concept’ of the ‘Porsche 911’ in the following series) do not constitute relevant limitations on the freedom of the designer (§ 51, 56-57, 61).

Minor changes, such as the rearrangement of the bumper, the different air intake openings or the removal of the tailboard are not sufficient, in the eyes of the informed user, to cause a different global impression with regards to the earlier model. Therefore, the contested designs lack novelty and individual character (§ 94).



06/06/2019, T-209/18, [Kraftfahrzeuge](#), EU: T:2019:377, 28, 33-35, 37, 50-51, 56-57, 61



57, 61

06/06/2019, T-210/18, [Personenkraftwagen](#), EU:T:2019:380, § 28, 33-35, 37, 50-51, 56-

Conflict of design with prior design — No individual character — No different overall impression

The classification of the products may contribute to establishing the overall impression produced by that design on the informed user for the purpose of assessing whether it has individual character in relation to an earlier design (§ 28).

The presence of visible foodstuffs inside the products in which the contested design is intended to be incorporated merely provides a better illustration of their purpose, namely as packaging for foodstuffs, as well as one of their components, specifically the transparent lid (§ 31).

The comparison of the overall impressions produced by the designs must relate solely to the elements actually protected (13/06/2017, T-9/15, Dosen [für Getränke], EU:T:2017:386, § 79). The protection conferred by the contested design relates to its appearance in that it is intended to be incorporated into packaging for foodstuffs having certain components with specific characteristics, namely a metal container that has a transparent lid with a translucent tab. The foodstuffs inside the container must not therefore be taken into consideration for the purpose of assessing the 'overall impression' (§ 33).

The assessment of the overall impression produced on the informed user by a design includes the manner in which the product represented by that design is used (21/11/2013, T-337/12, Sacacorchos, EU:T:2013:601, § 46). Accordingly, the informed user of the contested design, whether a consumer of the preserves or a professional of the food processing industry, will assess that design according to the purpose of the products, namely as packaging for foodstuffs, and will be able to differentiate between that packaging and its contents. Therefore, the appearance of the foodstuffs contained in the packaging in which the contested design is intended to be incorporated, as well as their specific arrangement inside that packaging, is not relevant for the purpose of assessing the overall impression produced on the informed user by the contested design (§ 40).



EU:T:2020:94, § 28, 31, 33, 40

12/03/2019, T-352/19; [Packaging for foodstuffs](#),



§ 28, 31, 33, 40

12/03/2019, T-353/19; [Packaging for foodstuffs](#), EU:T:2020:95,

Conflict of design with prior design — No individual character — No different overall impression

The assessment of the earlier design's overall impression on the informed user must include the way in which the product represented by that design is used (07/11/2013, T-666/11, Gatto domestico, EU:T:2013:584, § 31). The fact that the representation of the earlier design is limited to a single view, representing the tool in question in an open position, does not exclude the possibility of comparing it with the contested design insofar as the visual representation of the tool in question in a closed position may be deduced from the representation of the earlier design (21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 80) (§ 41).



29/04/2020, T-73/19; [wood splitting tools](#), EU:T:2020:157, § 41

Article 6(1) CDR — Different linguistic versions — Uniform interpretation — Individual character — Different overall impression

The Italian version of Article 6(1) CDR states that the RCD is deemed to have individual character if the overall impression it produces on informed users differs 'significantly' from that produced by any design which has been made available to the public. That Article, however, must be applied in accordance with the uniform interpretation in case-law and taking into consideration the other linguistic versions where the qualifier 'significantly' does not appear (§ 29, 32, 34).

The perspective during the use of scooters does not prevail since the purchase choice is also based on design (§ 57).



§ 29, 32, 34, 57

24/09/2019, T-219/18, [Ciclomotori](#), EU:T:2019:681,

3.6 CONFLICT WITH A PRIOR DESIGN RIGHT

[No key points available yet.]

3.7 USE OF AN EARLIER DISTINCTIVE SIGN

3.7.1 Distinctive sign and right to prohibit use

[No key points available yet.]

3.7.2 Use in a subsequent design

[No key points available yet.]

3.7.3 Substantiation of the application under Article 25(1)(e) CDR (earlier distinctive signs)

[No key points available yet.]

3.8 UNAUTHORISED USE OF A WORK PROTECTED UNDER THE COPYRIGHT LAW OF A MEMBER STATE

Works for the purposes of applying Article 25(1)(f) CDR

The works invoked for the purposes of applying Article 25(1)(f) CDR cannot be an accumulation of the stylised versions of a product during various decades (§ 101).

The characteristics listed by the French and Italian judgments, recognising that the work corresponding to the earlier design deserves protection as copyright, are not present in the contested design (§ 94, 104-105).

24/09/2019, T-219/18, [Ciclomotori](#), EU:T:2019:681, § 94, 101, 104-105

3.9 IMPROPER USE OF FLAGS AND OTHER SYMBOLS

[No key points available yet.]

3.10 PARTIAL INVALIDITY

[No key points available yet.]

4 OTHERS

[No key points available yet.]

CHAPTER VIII — PROFESSIONAL REPRESENTATION

[No key points available yet.]

CHAPTER IX — DIRECTIVES

1 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

Preliminary ruling — Article 3(1)(b) Directive 2008/95/EC — Distinctive character — Criteria for assessment

Article 3(1)(b) Directive 2008/95/EC must be interpreted as meaning that, in examining the distinctive character of a sign, all the relevant facts and circumstances must be taken into account, including all the likely types of use of the mark applied for. The latter correspond, in the absence of other indications, to the types of use that, in the light of the customs in the economic sector concerned, can be practically significant (§ 34).

The examination of the distinguishing capacity of a sign cannot be limited to the ‘most likely’ use unless ‘solely one type of use is practically significant in the economic sector concerned’. This examination must take into account all practically significant conceivable uses of the sign in the economic sector concerned by the goods. Where a sign consists of a slogan which can be placed either on the front of T-shirts or on a label, the mark will be found distinctive if the consumers perceives it as a badge of origin according to *at least one* of the alternative types of placement of the sign (§ 25-30).

12/09/2019, C-541/18, [Deutsches Patent-und Markenamt](#), EU:C:2019:725, § 25-30, 34

Preliminary ruling — Article 5(1)(a) and (b) Directive 2008/95/EC — Individual trade mark consisting of a test label

Article 9(1)(a) and (b) CTMR and Article 5(1)(a) and (b) Directive 2008/95/EC must be interpreted as meaning that they do not entitle the proprietor of an individual trade mark consisting of a quality label to oppose the affixing, by a third party, of a sign identical with, or similar to, that mark to products that are neither identical with, nor similar to, the goods or services for which that mark is registered.

Article 9(1)(c) CTMR and Article 5(2) Directive 2008/95/EC must be interpreted as meaning that they entitle the proprietor of an individual trade mark with a reputation, consisting of a quality label, to oppose the affixing, by a third party, of a sign identical with, or similar to, that mark to products that are neither identical with, nor similar to, the goods or services for which that mark is registered, provided that it is established that, by that affixing, the third party takes unfair advantage of the distinctive character or the reputation of the mark concerned or causes detriment to that distinctive character or reputation and provided that, in that case, the third party has not established the existence of a ‘due cause’, within the meaning of those provisions, in support of such affixing (§ 54).

The CJ ruled out any infringement under Article 5(1)(a) Directive 2008/95/EC because the defendant did not ‘present itself to the public as specialist in the field of product testing’ and because there is no ‘specific and indissociable link’ between toothpaste, on the one hand, and the activity of product testing, on the other hand. This circumstance must be distinguished from the case where a third party uses, for its own services (for example, car repair services), a trade mark registered for the goods which constitute the actual subject matter of the services (for

example, cars), which may 'exceptionally' justify a double identity within the meaning of Article 5(1)(a) Directive 2008/95/EC (§ 31-33).



11/04/2019, C-690/17; [ÖKO-Test](#), EU:C:2019:317, § 31-33, 54

Preliminary ruling — Article 2 and Article 3(1)(b) Directive 2008/95 — Colour mark or figurative mark — Graphical representation of a mark submitted as a figurative mark

Article 2 and Article 3(1)(b) Directive 2008/95/EC must be interpreted as meaning that the classification as a 'colour mark' or 'figurative mark' given to a sign by the applicant on registration is a relevant factor among others for establishing whether that sign can constitute a trade mark within the meaning of Article 2 of the Directive and, if so, whether it is distinctive within the meaning of Article 3(1)(b) of that Directive, but does not release the competent trade mark authority from its obligation to carry out a global assessment of distinctive character by reference to the actual situation of the mark considered, which means that that authority cannot refuse registration of a sign as a mark on the sole ground that that sign has not acquired distinctive character through use in relation to the goods or services claimed.

Article 2 Directive 2008/95/EC must be interpreted as precluding, in circumstances such as those in the main proceedings, the registration of a sign as a mark due to an inconsistency in the application for registration, which it is for the referring court to ascertain (§ 45).

When the trade mark application contains an inconsistency between the sign's representation in the form of a drawing and the classification given to the mark by the applicant, so that it is impossible to determine exactly the subject matter and scope of the protection, the trade mark registration must be refused on account of the lack of clarity and precision of the application (§ 40).



27/03/2019, C-578/17, [Oy Hartwall Ab](#), EU:C:2019:261, § 40, 45

Preliminary ruling — Disclaimer — Article 4(1)(b) Directive 2008/95

A disclaimer provided for by national law whose effect was to exclude an element of a complex trade mark, mentioned in the disclaimer, from the analysis of the relevant factors for establishing the existence of a LOC within the meaning of Article 4(1)(b) of Directive 2008/95 because that element is descriptive or not distinctive, would not be compatible with the requirements of that provision (§ 46).

A disclaimer provided for in national law whose effect were to attribute, in advance and permanently, a lack of distinctiveness to the element of a complex trade mark mentioned by it, so that that element has only limited importance in the analysis of the LOC within the meaning of Article 4(1)(b) of Directive 2008/95, would also be incompatible with the requirements of that provision (§ 52).

12/06/2019, C-705/17; [Mats Hansson](#), EU:C:2019:481, § 46, 52

Preliminary ruling — Article 3 and Article 13 First Council Directive 89/104/EEC — Article 7 and Article 51 Regulation (EC) No 40/94 — Failure to comply with the requirements of clarity and precision — Bad faith — No intention to use the trade mark for the goods or services covered by the registration — Effects

An EUTM or a national trade mark cannot be declared wholly or partially invalid on the ground that the terms used to designate the goods and services for which that trade mark was registered lack clarity and precision (§ 71).

A trade mark application that is filed without any intention to use the trade mark for the goods and services covered by the registration may constitute bad faith if the applicant for registration of that mark had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (§ 77, 81). Such bad faith cannot be presumed; it is established only if there is objective, relevant and consistent indicia to support this (§ 77, 78).

When the absence of the intention to use the trade mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that application constitutes bad faith only insofar as it relates to those goods or services (§ 81).

First Directive 89/104 must be interpreted as not precluding a provision of national law under which an applicant for registration of a trade mark must state that the trade mark is being used in relation to the goods and services for which registration is sought, or that he or she has a bona fide intention that it should be so used, insofar as the infringement of such an obligation does not constitute, in itself, a ground for invalidity of a trade mark already registered (§ 86-87).

29/01/2020, C-371/18, [SKY](#), EU:C:2020:45, § 77, 78, 81, 86-87

Preliminary ruling — Article 5(1)(b) Directive 2008/95/EC — Article 10(1) Directive 2008/95/EC — Article 12(1) Directive 2008/95/EC — Revocation of a trade mark for lack of genuine use — Right to protection against infringement of exclusive rights before the date on which the revocation took effect

Article 5(1)(b), the first subparagraph of Article 10(1) and the first subparagraph of Article 12(1) of Directive 2008/95/EC must be interpreted as leaving Member States the option of allowing the proprietor of a trade mark, whose rights have been revoked due to lack of genuine use on expiry of the 5-year period from its registration, to retain the right to claim compensation for damage resulting from use by a third party before the date of revocation (§ 49).

Although the fact that a trade mark has not been used does not in itself preclude compensation for acts of infringement, it is an important factor when determining the existence and extent of the damage sustained by the proprietor, and the amount of compensation that they might claim (§ 47).

26/03/2020, C-622/18, [SAINT GERMAIN](#), EU:C:2020:241, § 47, 49

Preliminary ruling — Article 3(1)(e)(ii) Directive 2008/95 — Sign consisting exclusively of the shape of goods which is necessary to obtain a technical result — Article 3(1)(e)(iii) Directive 2008/95 — Sign consisting of the shape which gives substantial value to the goods — Consideration of the perception of the relevant public — Cumulative protection

Article 3(1)(e)(ii) of Directive 2008/95/EC must be interpreted as meaning that, in order to establish whether a sign consists exclusively of the shape of goods which is necessary to obtain a technical result, assessment does not have to be limited to the graphic representation of that sign (§ 37). The first step of the analysis is to identify the essential characteristics of the sign. For

that step, information other than that relating to the graphic representation alone, such as the relevant public's perception, may be used (§ 29-31, 37). The second step of the analysis is to establish if the essential characteristics perform a technical result. For that step, information which is not apparent from the graphic representation of the sign must originate from objective and reliable sources and may not include the relevant public's perception (§ 32-36, 37).

Article 3(1)(e)(iii) of Directive 2008/95 must be interpreted as meaning that the relevant public's perception or knowledge of the product represented graphically by a sign that consists exclusively of the shape of that product may be taken into consideration in order to identify an essential characteristic of that shape. The ground for refusal may be applied if it is apparent from objective and reliable evidence that the consumer's decision to purchase the product in question is to a large extent determined by that characteristic (§ 39-46, 47).

Article 3(1)(e)(iii) of Directive 2008/95 must be interpreted as meaning that that ground for refusal must not be applied systematically to a sign which consists exclusively of the shape of the goods where that sign enjoys protection under the law relating to designs or where the sign consists exclusively of the shape of a decorative item (§ 50, 53, 58-59, 62).



23/04/2020, C-237/19, [Gömböc Kutató](#), EU:C:2020:296, § 29-32, 36-37, 39-46, 47, 50, 53, 58-59, 62

Preliminary ruling — Article 5(1) Directive 2008/95/EC — Article 5(3)(b) Directive 2008/95/EC — Article 5(3)(c) Directive 2008/95/EC — Concept of ‘use in the course of trade’

Article 5(1) of Directive 2008/95/EC, read in conjunction with Article 5(3)(b) and (c) of that directive, must be interpreted as meaning that a person who does not engage in trade as an occupation, who takes delivery of, releases for free circulation in a Member State and retains goods that are manifestly not intended for private use, where those goods were sent to their address from a third country and where a trade mark, without the consent of the proprietor of that trade mark, is affixed to those goods, must be regarded as using that trade mark in the course of trade, within the meaning of Article 5(1) of that directive (§ 31).

30/04/2020, C-772/18, [Korkein oikeus](#), EU:C:2020:341, § 31

Preliminary ruling — Article 5(1) Directive 2008/95/EC — Advertising — Infringement

Article 5(1) of Directive 2008/95/EC must be interpreted as meaning that a person operating in the course of trade that has arranged for an advertisement (which infringes another person's trade mark) to be placed on a website, is not using a sign which is identical to that trade mark where the operators of other websites reproduce that advertisement by placing it online, on their own initiative and in their own name, on other websites (§ 31).

The term ‘using’ in Article 5(1) of Directive 2009/95/EC involves active conduct and direct or indirect control of the act constituting the use. However, that is not the case if that act is carried out by an independent operator without the consent of the advertiser (03/03/2016, C-179/15, Mercedes Benz, EU:C:2016:134, § 39) (§ 23).

02/07/2020, C-684/19, [mk advokaten](#), EU:C:2020:519, § 31, 23

2 DIRECTIVE 98/71/EC OF THE EUROPEAN PARLIAMENT AND THE COUNCIL OF 13 OCTOBER 1998 ON THE LEGAL PROTECTION OF DESIGNS

[No key points available yet.]

3 DIRECTIVES ON COPYRIGHTS

3.1 DIRECTIVE (EU) 2019/790 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL 17 APRIL 2019 ON COPYRIGHT AND RELATED RIGHTS IN THE DIGITAL SINGLE MARKET

[No key points available yet.]

3.2 DIRECTIVE 2001/29/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL OF 22 MAY 2001 ON THE HARMONISATION OF CERTAIN ASPECTS OF COPYRIGHT AND RELATED RIGHTS IN THE INFORMATION SOCIETY

Preliminary ruling — Article 2(a) Directive 2001/29/EC — Concept of ‘work’ — Protection of works by copyright — Connection with the protection of designs

Article 2(a) Directive 2001/29/EC must be interpreted as precluding national legislation from conferring protection, under copyright, to designs such as the clothing designs at issue in the main proceedings, on the ground that, over and above their practical purpose, they generate a specific, aesthetically significant visual effect (§ 58).

The subject matter protected as a design was not as a general rule capable of being treated in the same way as a subject matter constituting works protected by Directive 2001/29/EC. The principle of the system laid down in the EU is that the protection reserved for designs and the protection ensured by copyright are not mutually exclusive (§ 40, 43). Such cumulative and concurrent protection of the same subject matter can be envisaged only in certain situations (§ 52).

12/09/2019, C-683/17; [Cofemel](#), ECLI:EU:C:2019:721, §40, 43, 52, 58

Preliminary ruling — Article 3(1) Directive 2001/29/EC — Article 8(2) Directive 2006/115/EC Copyright and related rights — Concept of ‘communication to the public’

Article 3(1) of Directive 2001/29/EC on the harmonisation of certain aspects of copyright and related rights in the information society and Article 8(2) of Directive 2006/115/EC on rental right and lending right and on certain rights related to copyright in the field of intellectual property must be interpreted as meaning that the hiring out of motor vehicles equipped with radio receivers does not constitute a communication to the public within the meaning of those provisions (§ 41).

02/04/2020, C-753/18, [Stim and SAMI](#), EU:C:2020:268, § 41

Preliminary ruling — Article 2 to Article 5 Directive 2001/29/EC — Scope — Copyright and related rights — Concept of ‘work’ — Copyright protection of works — Shape of the product which is necessary to obtain a technical result — Folding bicycle

Articles 2 to 5 of Directive 2001/29/EC must be interpreted as meaning that the copyright protection provided for therein applies to a product whose shape is necessary (at least in part) to obtain a technical result, but where that product is also an original work resulting from intellectual creation because, through its shape, its author expresses their creative ability in an original manner by making free and creative choices so that the shape reflects their personality. It is for the national court to verify this, bearing in mind all the relevant aspects of the dispute in the main proceedings (§ 39).

11/06/2020, C-833/18, [Folding bicycle](#), EU:C:2020:461, § 39

3.3 DIRECTIVE 96/9/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL OF 11 MARCH 1996 ON THE LEGAL PROTECTION OF DATABASES

[No key points available yet.]

3.4 DIRECTIVE 2004/48/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL OF 29 APRIL 2004 ON THE ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS

Preliminary ruling — Article 9(7) Directive 2004/48/EC — Patent — Appropriate compensation — Compensation for losses — Preliminary injunction — Patent revocation

Article 9(7) Directive 2004/48/EC, and in particular the concept of ‘appropriate compensation’ referred to in that provision, must be interpreted as not precluding national legislation which provides that a party will not be compensated for losses which he has suffered due to his not having acted as may generally be expected in order to avoid or mitigate his loss and which, in circumstances such as those in the main proceedings, results in the court not making an order for provisional measures against the applicant obliging him to provide compensation for losses caused by those measures even though the patent on the basis of which those had been requested and granted has subsequently been found to be invalid, to the extent that that legislation permits the court to take due account of all the objective circumstances of the case, including the conduct of the parties, in order, *inter alia*, to determine that the applicant has not abused those measures (§ 72).

‘Appropriate compensation’ is an autonomous concept of EU law which must be given an independent and uniform meaning (§ 49). National courts must decide, on a case-by-case basis, whether compensation is appropriate, that is to say ‘justified in light of the circumstances’ (§ 50). Article 9(7) Directive 2004/48/EC establishes as a pre-condition that the preliminary injunction is repealed or that no infringement or threat of infringement is found. However, that does not mean that compensation for losses will be automatically ordered (§ 52). Recital 22 of the Enforcement Directive which considers compensation to be ‘appropriate’ to the extent that it repairs the cost and injury suffered because of ‘unjustified’ provisional measures (§ 60). Provisional measures would be unjustified when there is no risk of delays causing irreparable harm to the rights holder (§ 61). When a generic product is marketed although a patent has been granted, there may, in principle, be such a risk. The fact that the provisional measures have already been repealed is not a decisive factor to prove that the measures were unjustified (§ 63). Otherwise rights holders

could be discouraged from applying for these types of measures (§ 65). National courts must check that an applicant has not abused provisional measures (§ 70).

12/09/2019, C-688/17, [Bayer Pharma](#), ECLI:EU:C:2019:722, § 49-50, 52, 60-61, 63, 65, 72

Preliminary ruling — Article 8(2)(a) Directive 2004/48/EC — Internet video platform — Uploading of a film without the consent of the rights holder — Proceedings concerning an infringement of an intellectual property right — Applicant’s right of information

Where a film is uploaded onto an online video platform, such as YouTube, without the copyright holder’s consent, Directive 2004/48/EC does not oblige the judicial authorities to order the operator of the video platform to provide the email address, IP address or telephone number of the user who uploaded the film concerned. The directive, under Article 8, provides for disclosure of the ‘addresses’ of persons who have infringed an intellectual property right, but this only covers the postal address of the user concerned, not their email, IP address or telephone number (§ 38-40).

09/07/2020, C-264/19, [Constantin Film Verleih](#), EU:C:2020:542, § 38-40

ANNEX

List of abbreviations

BoA: Board of Appeal

CD: Cancellation Division

CJ: Court of Justice of the European Union

GC: General Court of the European Union

GI: Geographical Indications

IR: International Registration

LOC: Likelihood of confusion

OD: Opposition Division

RPCJ: Rules of Procedure of the Court of Justice

RPGC: Rules of Procedure of the General Court

Statute: Statute of the Court of Justice of the European Union

TFEU: Treaty on the Functioning of the European Union

WIPO: World Intellectual Property Organisation