



Boards of Appeal  
Operations Area

# OVERVIEW OF GC/CJ CASE-LAW

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## Preface

The Operations Area of the Boards of Appeal prepares this OVERVIEW OF GC/CJ CASE-LAW.

It contains a systematic compilation of the most important key points of judgments and of orders rendered by the General Court and the Court of Justice of the European Union as from 1 of January 2019 on actions brought against decisions taken by the Office's Boards of Appeal in trade mark and design matters. The overview 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.

## 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

## Integrated Judgments / Orders of December 2021

- 21/12/2021, T-699/20, [1st AMERICAN \(fig.\) / DEVICE OF A BIRD \(fig.\)](#), EU:T:2021:928
- 21/12/2021, T-6/20, [Alpenrausch Dr. Spiller / RAUSCH](#), EU:T:2021:920
- 21/12/2021, T-598/20, [Arch fit](#), EU:T:2021:922
- 21/12/2021, T-369/20, [Cefa certified european financial analyst / Cfa et al.](#), EU:T:2021:921
- 21/12/2021, T-870/19, [CLEOPATRA QUEEN \(fig.\) / Cleopatra melfinco et al.](#), EU:T:2021:919
- 21/12/2021, T-194/21, [HYALOSTEL ONE \(fig.\) / HyalOne \(fig.\) et al.](#), EU:T:2021:934
- 21/12/2021, T-571/20, [LUNA SPLENDIDA \(fig.\) / Luna \(fig.\) et al.](#), EU:T:2021:956
- 21/12/2021, T-159/21, [motwi \(fig.\) / Monty et al.](#), EU:T:2021:924
- 21/12/2021, T-549/20, [Superzings / ZING \(fig.\) et al.](#), EU:T:2021:935
- 15/12/2021, T-69/21, [COLLINI \(fig.\) / Pollini et al.](#), EU:T:2021:893
- 15/12/2021, T-205/21, [Liftbot](#), EU:T:2021:953
- 15/12/2021, T-188/21, [Malle](#), EU:T:2021:903
- 15/12/2021, T-682/20, [Schuhwaren](#), EU:T:2021:907
- 15/12/2021, T-683/20, [Schuhwaren](#), EU:T:2021:909
- 15/12/2021, T-684/20, [Schuhwaren](#), EU:T:2021:912
- 10/12/2021, C-382/21 P, [Turn- oder Sportgeräte und -artikel](#), EU:C:2021:1050
- 08/12/2021, T-556/19, [GRILLOUMI / HALLOUMI et al](#), EU:T:2021:864
- 08/12/2021, T-593/19, [Grilloumi Burger / Halloumi et al.](#), EU:T:2021:865
- 08/12/2021, T-595/19, [GRILLOUMI BURGER / HALLOUMI et al.](#), EU:T:2021:866
- 08/12/2021, T-294/20, [Kaas keys as a service](#), EU:T:2021:867
- 07/12/2021, T-422/21, [Iq / Eq](#), EU:T:2021:888
- 01/12/2021, T-84/21, [Doll's heads](#), EU:T:2021:844
- 01/12/2021, T-700/20, [Steirisches Kürbiskernöl g.g.A GESCHÜTZTE GEOGRAFISCHE ANGABE \(fig.\)](#), EU:T:2021:851
- 01/12/2021, T-359/20, [Team beverage / Team](#), EU:T:2021:841
- 01/12/2021, T-662/20, [Triple helicoid cheese](#), EU:T:2021:843
- 01/12/2021, T-467/20, [ZARA / ZARA \(fig.\) et al.](#), EU:T:2021:842

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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 [applicable as from 1 May 2019]

##### **Article 58a(3) Statute — Article 170a(1) RPCJ**

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 58a(3) Statute — 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

##### **Article 58a(3) Statute — Article 170b RPCJ — Request demonstrating that an issue is significant with respect to the unity, consistency or development of EU law — Appeal allowed to proceed**

In accordance with the burden of proof which lies with an appellant requesting that an appeal be allowed to proceed, the appellant must demonstrate that, independently of the issues of law invoked in its appeal, the appeal raises one or more issues that are significant with respect to the

unity, consistency or development of EU law, the scope of that criterion going beyond the judgment under appeal and, ultimately, its appeal (04/05/2021, C-26/21P, Juvederm ultra, EU:C:2021:355, § 16) (§ 27).

In order to demonstrate that that is the case, it is necessary to establish both the existence and significance of such issues by means of concrete evidence specific to the particular case, and not simply arguments of a general nature (04/05/2021, C-26/21P, Juvederm ultra, EU:C:2021:355, § 20) (§ 28).

In the present case the appellant, apart from identifying the issue, namely the question whether a possible legislative lacuna in an act of EU law (Article 41 CDR) can be made good by the direct application of a provision of international law which does not satisfy the conditions required by the case-law of the Court of Justice in order to have direct effect (Article 4 Paris Convention) (§ 23-25) having effect on the outcome of the judgment under appeal (§ 26), demonstrates to the requisite legal standard that the appeal raises an issue that is significant with respect to the unity, consistency and development of EU law (§ 31-34).

In that regard, the appellant points out that the point of law raised by its appeal goes beyond the scope of that appeal in that the allegedly erroneous interpretation of Article 41(1) CDR will have repercussions on the admissibility of priority claims for Community designs and on the assessment of the novelty of a Community design (§ 31). It states that its appeal also goes beyond the context of the law applicable to Community designs in that the principle established by the judgment under appeal is liable to determine the system of priority claims applicable to other types of intellectual property rights. It provides concrete examples of the consequences that the judgment under appeal could have for patent applicants and points to the risk of legal uncertainty and lack of reciprocity in certain third countries resulting from the recognition of a 12-month priority period for Community designs where the priority claim is based on a patent application (§ 32). Last, the appellant highlights the systemic consequences, affecting the unity, consistency and development of EU law, of recognising that Article 4 of the Paris Convention has direct effect in that, first, the interpretation of that article by the EU judiciary would be imposed on the EU legislature and the Member States of the EU and, second, such recognition would run counter to the objectives of the Paris Convention and the Agreement on Trade-Related Aspects of Intellectual Property Rights, contained in Annex 1C to the Marrakesh Agreement establishing the World Trade Organization (WTO) (§ 33).

10/12/2021, C-382/21 P, [Turn- oder Sportgeräte und -artikel](#), EU:C:2021:1050, § 27-28, 31-34

## 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 — Interest in bringing an appeal — Admissibility**

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 CD's 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

#### Calculation of the time limit to bring an appeal — Extension on account of distance

In accordance with Article 56 of the Statute, the time limit for bringing an appeal is two months from the date of notification of the decision to be appealed. That time limit is to be extended on account of distance by a single period of 10 days, Article 51 RPCJ (§ 22).

The single period of extension on account of distance is not to be considered to be distinct from the period for bringing an appeal referred to in Article 56 of the Statute, but rather as an integral part of that period which it extends by a fixed period of time. The period expires at the end of the day that, in the last month in which the period ends, bears the same number as the day from when the time limit started, that is to say the day of notification, and then to which is added a single period of 10 days on account of distance (11/06/2020, C-575/19 P, GMPO v Commission, EU:C:2020:448, § 30) (§ 25).

Consequently, Article 49(2) RPCJ, which states that 'if the time limit would otherwise end on a Saturday, Sunday or an official holiday, it shall be extended until the end of the first subsequent working day', applies only to the end of the period of two months plus 10 days (§ 26).

03/09/2020, C-174/20 P, [VirusProtect](#), EU:C:2020:651, § 22, 25-26

#### 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 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, [FI \(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 \(fig.\) / PRIMAet 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

The GC has exclusive jurisdiction to assess the value of any items of evidence submitted to it, unless there has been a distortion of the facts or evidence (19/10/2018, C-198/16 P, *Agriconsulting Europe v Commission*, EU:C:2017:784, § 69 and the case-law cited) (§ 55).

16/09/2020, C-121/19 P, *EDISON (fig.)*, EU:C:2020:714, § 55

#### 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 GC

[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

#### Belated plea — Inadmissibility

A plea of partial inadmissibility regarding a head of claim that it is raised only at the hearing is inadmissible, and in any event, ineffective, when it could have been raised at the stage of the reply (22/03/2018, T-581/16, *Popotas v Ombudsman*, EU:T:2018:169, § 66) (§ 24-26).

30/06/2021, T-531/20, *ROLF (fig.) / Wolf et al.*, EU:T:2021:406, § 24-26

### 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

#### **Obligation to indicate the specific points of the GC judgment that are challenged**

Pursuant to Article 169(2) ROPCJ, the appellant must precisely identify the specific points of the GC judgment against which its pleas in law and legal arguments are directed (07/06/2018, C-671/17 P, *Gaki v Europol*, EU:C:2018:416, § 36) (§ 37).

16/09/2020, C-121/19 P, [EDISON \(fig.\)](#), EU:C:2020:714, § 37

### 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

#### **Sufficient implicit reasoning — References to other EUTMs / identical national marks**

The Court's reasoning in rejecting the applicant's references to earlier BoA or national decisions may also be implicit, without infringing the Court's obligation to state reasons (§ 45).

03/09/2020, C-214/19 P, [achtung ! \(fig.\)](#), EU:C:2020:632, § 45

### 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, [bittorrent](#), 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

###### **Interest in bringing the proceedings — Lenient interpretation of arguments and pleas in law — Admissibility of the action**

The BoA refused registration of the mark under two absolute grounds for refusal, Article 7(1)(b) and Article 7(1)(c) EUTMR. Before the GC, the applicant explicitly challenged only one of them (Article 7(1)(b) EUTMR). First, the interest in bringing the proceedings must be assessed based on the subject matter of the action, and not based on the merits. Second, what matters is the substantive content of the applicant's arguments, not the formal titles of the pleas in law. The applicant's various arguments in the action may be interpreted as also criticising the assessments of the BoA regarding descriptiveness under Article 7(1)(c) EUTMR (§ 19, 25). The applicant has a legitimate interest in seeking the annulment of the contested decision. The action is admissible (§ 16-26).

19/05/2021, T-535/20, [TIER SHOP \(fig.\)](#), EU:T:2021:283, § 16, 19, 25-26

### **Interest in bringing the proceedings — Invalidity of the contested mark following annulment or alteration of the contested decision capable in itself to have legal consequences and to procure an advantage to the applicant — Admissibility**

An interest in having the contested act annulled requires that the annulment of that act must be capable, in itself, of having legal consequences and that the action may therefore, through its outcome, procure an advantage to the party which brought it (17/09/2015, C-33/14 P, Mory and Others v Commission, EU:C:2015:609, § 55) (§ 18).

According to Article 62(2) EUTMR, a trade mark which has been declared invalid is to be deemed not to have had, from the outset, the effects specified in that regulation. It follows that the invalidity of the contested mark, which is liable to occur only following the annulment or alteration of the contested decision, is capable of having legal consequences and the action is capable of procuring an advantage to the applicant in respect of the period prior to the expiry of the registration of the earlier design (§ 18).

Consequently, neither the fact that the registration of the earlier design has expired, nor the fact that the applicant cannot prohibit, by virtue of that design, the use of other marks registered after the expiry of the registration of that design deprived the applicant of an interest in having the contested decision annulled or altered (§ 18). Therefore the action is admissible (§ 19).

02/06/2021, T-169/19, [DEVICE OF A POLO PLAYER \(fig.\) / DEVICE OF A POLO PLAYER \(fig.\) et al.](#), EU:T:2021:318, § 18-19

### **Lack of interest in bringing the proceedings — Revocation of the earlier mark predating the contested BoA decision — No need to adjudicate**

The revocation of the earlier mark with effect from a date prior to that of the contested decision taken by the BoA, although declared after the adoption of the contested decision, deprives the invalidity proceedings of their very basis. Those proceedings having therefore become devoid of purpose, the contested decision has been deprived of its purpose and does not take effect (§ 42). Therefore, a judgment of the GC on the merits cannot bring any benefit to the appellant (§ 43), irrespective of the possible claims to be made in infringement actions before national courts (§ 44-47).

20/07/2021, T-500/19, [Coravin](#), EU:T:2021, § 42-47

### **Lack of 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 need to adjudicate — Opposition proceedings — Partial Invalidity of the earlier mark — Effects on the proceedings before the BoA**

The action before the GC becomes devoid of purpose where the earlier mark is partially declared invalid with effect *ex tunc* (Article 62(2) EUTMR) and the contested decision is based exclusively on the existence of that earlier right which has been declared invalid. The contested decision is

deemed not to have had effect from the outset, and cannot take effect in the future. The GC therefore cannot rule on the legality of a decision, which is deprived of all legal effect. *A fortiori*, the GC cannot annul that decision (14/02/2017, T-333/14, SportEyes / EYES SPORT EYE (fig.) et al., EU:T:2017:108, § 22-26, 37-40). The applicant would not gain any advantage from the annulment of the contested decision (§ 41).

Where neither the OD nor the BoA examined whether there was a LOC between the opposing signs in respect of the goods for which the earlier mark remains registered, the BoA is still called upon to resolve the dispute in the appeal proceedings and to either examine the appeal itself or to remit the case to the OD for examination of whether there is a LOC between the mark applied for and the earlier mark, as it remains registered (§ 42).

23/02/2021, T-587/19, [MARIEN \(fig.\) / MARIN](#), EU:T:2021:107, § 37-42

### **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 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

### **No challengeable act — Decision to refer an appeal case to the Grand Board of Appeal**

A decision of the Presidium to refer an appeal case to the Grand Board cannot be challenged as such, but only to the extent that this decision may affect the legality of the decision of the BoA, given that actions for annulment according to Article 72(1) EUTMR can only be made against decisions of the BoA (§ 22-23).

01/09/2021, T-96/20, [Limbic® Types](#), EU:T:2021:527, § 22-23

### **Challengeable act — Action against a BoA decision to remit the case to the OD — Admissibility**

While it is true that an action brought against a preparatory act is not admissible, since it is not brought against an act which constitutes the final position taken by the administrative body at the end of a procedure, the Courts of the EU have previously recognised the admissibility of actions against acts which did not set out the final position of the administrative body but whose implications for the persons to whom they were addressed justified them being regarded as more than merely preparatory acts. Furthermore, Article 72 EUTMR, which provides that 'actions may be brought before the GC against decisions of the BoA in relation to appeals', does not distinguish between those decisions depending on whether or not they constitute the final position of the EUIPO bodies (§ 44).

In the present case, the BoA had, in any event, given a final decision on certain aspects of the dispute, binding in respect of those points that the OD was tasked with considering after its remittal. Accordingly, the applicant had to be able to challenge the BoA's final conclusions, without having to wait for proceedings to continue before the OD so that it could then bring an appeal before the BoA and, if necessary, subsequently bring an action before the Court against the new decision (§ 45).

23/09/2020, T-421/18, [MUSIKISS / KISS \(fig.\) et al.](#), EU:T:2020:433, § 44-45

### **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

### **Withdrawal of the UK from the EU — Transition period — Opposition based on earlier UK mark — Protection of trade marks registered in the UK**

In the absence of any provisions to the contrary in the withdrawal agreement, the EUTMR continues to be applicable to UK trade marks and, accordingly, until the end of the transition period earlier marks registered in the UK continue to receive the same protection they would have received had the UK not withdrawn from the EU (§ 33).

The existence of a relative ground for opposition must be assessed as at the time of filing of the application for registration of an EUTM against which the opposition has been filed (30/01/2020, T-598/18, *BROWNIE / BROWNIE, Brownie (series mark)*, EU:T:2020:22, § 19) (§ 34).

The fact that the earlier trade mark could lose the status of a trade mark registered in a Member State at a time after the filing of the application for registration of the EUTM (in particular following the possible withdrawal of the Member State concerned from the EU) is in principle irrelevant to the outcome of the opposition (30/01/2020, T-598/18, *BROWNIE / BROWNIE, Brownie (series mark)*, EU:T:2020:22, § 19) (§ 35).

23/09/2020, T-421/18, [MUSIKISS / KISS \(fig.\) et al.](#), EU:T:2020:433, § 33-35

01/12/2021, T-467/20, [ZARA / ZARA \(fig.\) et al.](#), EU:T:2021:842, § 58-59

### **Withdrawal of the UK from the EU — Transition period — Opposition based on an earlier non-registered UK mark — Subject matter of the action — Interest in bringing proceedings — Admissibility**

The withdrawal of the United Kingdom from the European Union has not rendered this dispute devoid of purpose (§ 16-23). The withdrawal agreement, which set out the arrangements for the withdrawal of the United Kingdom from the EU, entered into force on 1 February 2020. It provided

for a transition period between 1 February and 31 December 2020, during which EU law continued to be applicable in the United Kingdom (§ 16).

As regards the subject matter of the action and admissibility, the existence of a relative ground for opposition must be assessed at the time that the Office gives a decision on the opposition at the latest. The GC recently held that the earlier mark on which the opposition is based must be valid not only at the time of the publication of the application for registration of the mark applied for but also at the time that the Office gives a decision on the opposition (14/02/2019, T-162/18, ALTUS (fig.) / ALTOS et al., EU:T:2019:87, § 41). There is contrasting case-law which states that, in assessing whether a relative ground for opposition exists, it is appropriate to look only at the time of filing of the application for an EUTM against which a notice of opposition has been filed on the basis of an earlier trade mark (17/10/2018, T-8/17, GOLDEN BALLS / BALLON D'OR et al., EU:T:2018:692, § 19; 30/01/2020, T-598/18, BROWNIE / BROWNIE, Brownie (series mark), EU:T:2020:22, § 19; 23/09/2020, T-421/18, MUSIKISS / KISS et al., EU:T:2020:433, § 34). According to this case-law, the fact that the earlier sign could lose the status of a non-registered trade mark (or of another sign used in the course of trade of more than local significance) at a later date, in particular following the possible withdrawal of the Member State in which the mark enjoys protection is, in principle, irrelevant to the outcome of the opposition (see, by analogy, 30/01/2020, T-598/18, BROWNIE / BROWNIE, Brownie (series mark), EU:T:2020:22, § 19) (§ 17).

In the present case, there is no need to decide that question. The applicant applied for registration of the EUTM on 14 June 2017 at a time when the United Kingdom was a Member State of the EU. The decision of the BoA was taken on 2 April 2020 during the transition period. Until the end of that period, the earlier mark continued to receive the same level of protection that it would have received had the United Kingdom not withdrawn from the EU (§ 18).

Since the purpose of the action before the GC is to review the legality of decisions of the BoA, the GC must consider the date of the contested decision when assessing its legality (§ 19). For the GC to find that the litigation becomes devoid of purpose following the withdrawal of the United Kingdom from the EU, the GC would have to consider matters arising after the adoption of the contested decision which do not affect its merits (§ 20, 23).

The interest in bringing proceedings must continue until the final decision. This presupposes that the action must have the potential to procure an advantage for the party bringing it (§ 25). The GC rejects the Office's argument that the trade mark applicant had no interest in bringing proceedings because, if the opposition were upheld, the applicant would be able to convert their mark into national trade mark applications in all EU Member States. In principle, these considerations apply to all opposition proceedings (§ 24-26).

The annulment of the contested decision and referral back does not implicate that the BoA is obliged to dismiss the action in the absence of an earlier trade mark protected by the law of a Member State. Following the annulment of a decision of the BoA, the BoA must take a new decision on the same action considering the situation at the time that the action was brought, since the action is pending at the same stage as it had been before the contested decision (§ 27).

*06/10/2021, T-342/20, [Abresham Super Basmati Selaa Grade One World's Best Rice \(fig.\) / BASMATI](#), EU:T:2021:651, § 16-18, 20, 23-27*

### **2.1.1.2 Representation**

#### **Representation — No representation by a lawyer — Inadmissibility**

According to Article 19 of the Statute, two cumulative conditions must be met in order that a person may validly represent parties other than the Member States and the EU institutions before the Courts of the EU, namely: (i) that person must be a lawyer and (ii) he or she must be

authorised to practise before a court of a Member State or of another State which is a party to the EEA Agreement (§ 8).

With regard to the first of those conditions, it also follows from the case-law that the person who signs the application must be a member of the Bar in order to be regarded as a lawyer for the purposes of Article 19 of the Statute; it is not sufficient that that person is entitled to represent parties in proceedings before the courts of a Member State (§ 9). The notion of 'lawyer', within the meaning of Article 19, must be interpreted independently and without reference to national law (11/05/2017, C-22/17 P, *neonart*, EU:C:2017:369, § 6-7) (§ 10).

In the present case, Mr Kivitie, who signed the application, is not a member of the Bar of Finland. Even if, as the appellant contends, Mr Kivitie was granted authorisation to practise as a licenced legal counsel and to represent his clients before all courts of law in Finland, he cannot be regarded as a 'lawyer' (*asianajaja*) within the meaning of the Finnish version of Article 19 of the Statute (§ 11). Accordingly, Mr Kivitie does not satisfy the first of the two cumulative conditions and was therefore not authorised to represent the applicant before the Court (§ 12).

05/07/2021, T-128/21, [rubyred CRANBERRY \(fig.\)](#), EU:T:2021:479, § 8-12

05/07/2021, T-191/21, [Fittings for windows](#), EU:T:2021:470, § 8-12

### **Representation by a lawyer who is not an independent third party — Lack of connections which manifestly has a detrimental effect on the representative's capacity to carry out the client's defence**

From the use of the word 'represented' in the third paragraph of Article 19 of the Statute, it follows that, for the purposes of bringing an action before the GC, a 'party', within the meaning of that article, in whatever capacity, is not permitted to act on its own behalf, but must use the services of a third person authorised to practise as a lawyer before a court of a Member State or of a State which is party to the EEA Agreement (04/02/2020, C-515/17 P and C-561/17 P, *Uniwersytet Wrocławski and Republic of Poland / REA*, EU:C:2020:73, § 58 and case law cited) (§ 8). The concept of the independence of lawyers, is determined not only negatively, that is to say, by the absence of an employment relationship, but also positively, that is, by reference to professional ethical obligations (06/09/2012, C-422/11 P and C-423/11 P, *Prezes Urzędu Komunikacji Elektronicznej and Republic of Poland / European Commission* EU:C:2012:553, § 24) (§ 11). In that context, the lawyer's duty of independence is to be understood not as the lack of any connection whatsoever between the lawyer and his or her client, but the lack of connections which manifestly has a detrimental effect on his or her capacity to carry out the task of defending his or her client while acting in that client's interests to the greatest possible extent (04/02/2020, C-515/17 P and C-561/17 P, *Uniwersytet Wrocławski and Republic of Poland / REA*, EU:C:2020:73, § 64) (§ 12).

The Court has previously held, in that regard, that a lawyer who has been granted extensive administrative and financial powers which place his or her function at a high executive level within the legal person he or she is representing, such that his or her status as an independent third party is compromised, is not sufficiently independent from that legal person. The same is true for a lawyer who holds a high-level management position within the legal person he or she is representing, or a lawyer who holds shares in, and is the Chair of the management board of the company he or she is representing (04/02/2020, C-515/17 P and C-561/17 P, *Uniwersytet Wrocławski and Republic of Poland / REA*, EU:C:2020:73, § 65) (§ 13).

In the present case, Mr Kwaśniewski and Mr Zych, who represent the applicant, a non-governmental organisation governed by Polish law (NGO), are president and vice-president of the applicant respectively, and cannot therefore be considered to satisfy the condition of being a *third party* in relation to the applicant (§ 14-16).

Mr Słoniowski, who also represents the applicant, acts as a legal adviser in a law firm where one of the partners is Mr Kwaśniewski, president of the applicant (§ 20). In view of (i) the legal nature

of the duties he performs for the NGO, (ii) the fact that one of the partners of the law firm in which he acts as legal adviser is president of the NGO, and (iii) the fact that he cooperates with the president and the vice-president of the NGO for the purposes of the present case, the links between Mr Słoniowski and the NGO, applicant he represents, have a manifestly detrimental effect on his capacity to defend the client to the greatest possible extent whilst acting in that client's interests, even though he does not occupy a management position within the applicant he represents and there is no financial connection (§ 21).

25/06/2021, T-42/21, [Fundacja Instytut na rzecz kultury prawnej Ordo Iuris v Parliament](#), EU:T:2021:385, § 12-16, 21

### **Representation by a lawyer who is not an independent third party**

From the use of the word 'represented' in Article 19, third paragraph of the Statute follows that, for the purposes of bringing an action before the GC, a 'party' within the meaning of that article, in whatever capacity, is not permitted to act itself but must use the services of a third person authorised to practise as a lawyer before a court of a Member State or of a State which is a party to the EEA Agreement (04/02/2020, *Uniwersytet Wrocławski and Republic of Poland / REA*, C-515/17 P and C-561/17 P, EU:C:2020:73, § 58 and case law cited) (§ 7).

A legal person cannot be properly represented before the EU Courts by a lawyer who occupies a directing position within the body which he represents (04/12/2014, C-259/14 P, *ADR Center/Commission*, EU:C:2014:2417, § 23, 27; 06/04/2017, C-464/16 P, *PITEE/Commission*, EU:C:2017:291, § 25). In the present case, the lawyer who represents the applicant is one of three members of the board of directors and cannot be considered to satisfy the condition of being a *third party* in relation to the applicant (§ 9-10).

17/11/2020, T-495/20, [sb hotels \(fig.\)-Sbe](#), EU:T:2020:556, § 7, 9-10

### **Representation by a lawyer who is not a third party — Director of a legal person**

A lawyer representing the applicant (legal person), who is the sole director of the applicant, cannot be considered to be a third party within the meaning of Article 19 of the Statute (05/12/1996, C-174/96 P, *Lopes v Court of Justice*, EU:C:1996:473, § 11; 04/12/2017, T-522/17, *Nap Innova Hoteles v SRB*, EU:T:2017:881, § 6-8).

26/03/2021, T-716/20, [CRZ](#), EU:T:2021:175, § 6-8

### **Article 19 Statute — Article 91(1) and (2) of the withdrawal agreement of the UK — Lack of representation — Action introduced after the end of the transition period — Contested decision adopted after the end of the transition period — Manifest inadmissibility**

According to Article 19(4) of the Statute of the CJEU, only a lawyer authorised to practise before a court of a Member State or of another State which is a party to the Agreement on the European Economic Area may represent or assist a party before the Courts of the EU. Article 91(1) and (2) of the withdrawal agreement of the UK provides for various situations in which a lawyer who is authorised to practise before the courts or tribunals of the UK may represent or assist a party before the Courts of the EU. These situations cover proceedings that were pending before the Courts of the EU prior to the end of the transition period; decisions adopted by institutions, bodies, offices and agencies of the EU before the end of that period; proceedings for failure to fulfil obligations brought by the Commission; administrative procedures concerning compliance with EU law by the UK or persons residing or established there, or concerning compliance with EU law relating to competition; European Anti-Fraud Office procedures or State aid procedures (§ 19-22).

The present action was not covered by any of the situations set out in the withdrawal agreement, with the result that the applicant's lawyers were unable to represent the applicant before the Courts of the EU (§ 24-25).

Furthermore, the case was not covered by Article 97 of the withdrawal agreement, because this provision relates solely to representation in ongoing proceedings before the EUIPO, and not before the Court (§ 23).

07/12/2021, T-422/21, [Iq / Eq](#), EU:T:2021:888, § 19-22, 23-25

### **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 alphaspirit wild and perfect \(fig.\) / ONE](#), EU:T:2019:890, § 13-14

### **Certificate of the lawyer's authorisation to practise — No need to provide a translation into the language of the proceedings**

There is no need to provide a translation into the language of the proceedings (Article 46(2) RPGC) for documents lodged pursuant to Article 51(2) RPGC. In particular, the certificates showing that the parties' representatives are members of the Bar are intended first and foremost for the GC, so that it can ascertain whether the parties are properly represented. This admissibility criterion relates to public policy and the GC must verify of its own motion that it is satisfied (07/10/2014, T-531/12, T, EU:T:2014:855, § 22) (§ 20-23).

27/01/2021, T-817/19, [Hydrovision \(fig.\) / Hylo vision](#), EU:T:2021:41, § 20-23

#### **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

02/07/2021, T-290/21, [Meso fresh vitamin](#), EU:T:2021:476, § 4-10

##### **Time limit — 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

## 2.1.2 Admissibility of a cross-claim

### Locus standi — Inadmissibility of a cross-claim

Insofar as a decision of a 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

### Locus standi — Inadmissibility of a cross-claim

By the contested decision, the BoA upheld the intervener's claims in their entirety, notwithstanding the fact that the intervener did not share the contested decision's findings relating to the goods in respect of which genuine use was deemed proven. Therefore, the intervener is not entitled to bring a cross-claim against the contested decision, including the part of the contested decision by which the BoA declared the cross-appeal inadmissible. As a result, the cross-claim before the GC must be dismissed as inadmissible (§ 21-27).

28/04/2021, T-31/20, [THE KING OF SOHO \(fig.\) / SOHO](#), EU:T:2021:217, § 21-27

## 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

#### Head of claim — No GC competence to issue directions — Inadmissibility

A head of claim by which the applicant asks that the Court reject the application for registration of the mark or address an injunction to the opposition decision is inadmissible. The GC is not entitled to issue directions to the Office. It is for the latter to draw the conclusions from the operative part of this judgment and the grounds on which it is based (§ 31-32).

17/05/2021, T-328/20, [Aicook / My cook](#), EU:T:2021:291, § 31-32

#### Head of claim seeking to alter the contested decision by declaring the contested mark invalid — No request to issue directions — Admissibility

A head of claim requesting that the Court alter the contested decision by declaring the contested mark invalid cannot be interpreted (as the applicant argued) as asking the Court to issue directions. Rather, it is a request to alter the contested decision (§ 15). The admissibility of the request for alteration must be assessed in light of the powers conferred on the BoA (30/06/2009, T-285/08, Natur-Aktien-Index, EU:T:2009:230, § 14-15) (§ 16). As the BoA is competent to declare the contested mark invalid (Article 71(1) EUTMR and Article 163(1) EUTMR), the request is admissible (§ 16).

The question of whether the conditions for the exercise of the Court's power to alter the contested decision are met is a question of substance and not of admissibility (12/03/2020, T-296/19, Sum011 / ORIGINAL Sumol ORANGE ORIGINAL Sumol LARANJA (fig.), EU:T:2020:93, § 22).

02/06/2021, T-169/19, [DEVICE OF A POLO PLAYER \(fig.\) / DEVICE OF A POLO PLAYER \(fig.\) et al.](#), EU:T:2021:318, § 15-16, 22

### 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

## **Head of claim ‘to alter the contested decision for reimbursement of the appeal fees’**

The head of claim ‘to alter the contested decision with a view to reimbursement of the appeal fees’ can be interpreted as a request for an order requiring the Office to reimburse the appeal fee paid (Article 68 EUTMR) under Article 190(2) RPGC (§ 20).

09/12/2020, T-30/20, [Promed](#), EU:T:2020:599, § 20

## **Single head of claim seeking alteration — Inadmissibility of the action**

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

25/11/2020, T-882/19, [ΑΠΛΑ! \(fig.\)](#), EU:T:2020:558, § 23-26

## **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 impress \(fig.\) et al.](#), EU:T:2020:164, § 97

## **Head of claim seeking to alter the contested decision by declaring the contested mark invalid — Admissibility**

A head of claim requesting that the Court alter the contested decision by declaring the contested mark invalid cannot be interpreted (as the applicant argued) as asking the Court to issue directions. Rather, it is a request to alter the contested decision (§ 15). The admissibility of the request for alteration must be assessed in light of the powers conferred on the BoA (30/06/2009, T-285/08, Natur-Aktien-Index, EU:T:2009:230, § 14-15) (§ 16). As the BoA is competent to declare the contested mark invalid (Article 71(1) EUTMR and Article 163(1) EUTMR), the request is admissible (§ 16).

The question of whether the conditions for the exercise of the Court’s power to alter the contested decision are met is a question of substance and not of admissibility (12/03/2020, T-296/19, Sum011 / ORIGINAL Sumol ORANGE ORIGINAL Sumol LARANJA (fig.), EU:T:2020:93, § 22).

02/06/2021, T-169/19, [DEVICE OF A POLO PLAYER \(fig.\) / DEVICE OF A POLO PLAYER \(fig.\) et al.](#), EU:T:2021:318, § 16, 22

## **No obligation for the Office to systematically defend the decisions of the BoA — No competence to seek annulment or alteration on a point of law not raised by the application — Independence of the BoA**

The Office cannot be obliged to systematically defend every contested decision of a BoA nor to automatically claim that every action challenging such a decision should be dismissed (07/05/2019, T-629/18, DARSTELLUNG EINES AUTOS IN EINER SPRECHBLASE (fig.), EU:T:2019:292, § 18 and the case-law cited). Nothing precludes the EUIPO from endorsing the

heads of claim of the applicant or from simply leaving the decision to the discretion of the Court while putting forward all the arguments it considers appropriate for giving guidance to the Court (§ 15).

In contrast, the Office may not seek an order annulling or altering the decision of the BoA on a point not raised in the application, or put forward pleas in law not raised in the application (29/04/2020, T-78/19, green cycles (fig.), EU:T:2020:166, § 47 and the case-law cited) (§ 15).

The Office does not possess the power to amend or withdraw the decision, nor can it instruct the BOA to do so, as the independence of the BOA is enshrined in Article 166(7) EUTMR (§ 17).

22/09/2021, T-195/20, [chic ÁGUA ALCALINA 9,5 PH \(fig.\) / Chic Barcelona et al.](#), EU:T:2021:601, § 15, 17

### 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 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

#### Action following an appeal against a partially confirmatory decision — Partial inadmissibility

An action against a confirmatory decision must be declared inadmissible. A decision is regarded as a mere confirmation of an earlier decision if it contains no new factors as compared with the earlier measure and is not preceded by any re-examination of the situation of the addressee of the earlier measure (07/11/2019, T-380/18, INTAS / INDAS (fig.) et al., EU:T:2019:782, § 38-39). This requires the identity of (i) the parties to the proceedings, (ii) their submissions, their pleas, their arguments, and (iii) the relevant matters of law and fact characterising those proceedings and determining the operative parts of those decisions (08/02/2011, T-157/08, Insulate for life, EU:T:2011:33, § 29-41; 06/10/2015, T-545/14, engineering for a better world, EU:T:2015:789, § 18-29). The assessment relating to the existence of an absolute ground for refusal of registration cannot be called into question solely because the examiner or the appeal body did not follow the Office's decision-making practice in a specific case (08/02/2011, T-157/08, Insulate for life, EU:T:2011:33, § 38; 06/10/2015, T-545/14, engineering for a better world, EU:T:2015:789, § 23) (§ 22-26).

16/06/2021, T-487/20, [imot.bg \(fig.\)](#), EU:T:2021:366, § 22-26

#### Challengeable act — No confirmatory decision — Admissibility

With regard to orthopaedic shoes in Class 10, the contested decision is not merely a confirmatory decision of the judgment 11/07/2013, T-208/12, Rote Schnürsenkelenden, EU:T:2013:376 (confirmed by judgment 11/09/2014, C-521/13 P, Rote Schnürsenkelenden, EU:C:2014:2222).

The red colour of the shoelace ends has been defined more precisely in the present application and the goods covered by this application differ from those covered by the earlier application. The

present action, and the earlier decisions referred to above, do not concern the same subject matter. Therefore, the application is not inadmissible (§ 28-31).

The criterion that the mark applied for must satisfy in the present case is not that of mere originality. Instead, in order to be registrable, the mark applied for must deviate significantly from what is customary in the sector, which is not apparent from the file (§ 49).



17/11/2021, T-298-19, [FORM VON ROTEN SCHNÜRSENKELENDEN \(Posit.\)](#), EU:T:2021:792, § 28-31, 49

#### 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

##### Head of claim seeking to 'declare that the trade mark applied for may proceed to registration'— Inadmissibility

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 issue declaratory judgments — Inadmissibility

A head of claim by which the applicant asks the Court that it declare that proof of use of the earlier mark has not been adduced is neither a request for annulment nor alteration of the contested decision, but an express request for delivery of a declaratory judgment. The GC has no jurisdiction when exercising its judicial review of legality to issue declaratory judgments (§ 23-24).

17/05/2021, T-328/20, [Aicook / My cook](#), EU:T:2021:291, § 23-24

##### Head of claim seeking to obtain confirmatory or declaratory rulings — Inadmissibility

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

29/01/2019, T-336/17, [YATEKOMO / YA TE COMERER 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 — Inadmissibility**

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

### **Head of 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**

### **Possibility of clarification of pleas — Plea challenging the reasoning of the OD decision — Limit — Formal requirements of the application — Article 21 Statute and Article 177(1)(d) RPGC — Inadmissibility**

The Court has jurisdiction to rule on actions relating to decisions of the BoA and not decisions of the OD, Article 72 EUTMR (§ 21). The purpose of those actions is to review the legality of decisions of the BoA, a review which must, pursuant to Article 95 EUTMR, be carried out in light of the factual and legal context of the dispute as it was brought before the BoA (§ 22).

The Court must interpret the pleas in law on which an applicant relies in terms of their substance rather than of their classification (05/09/2014, T-471/11, *Éditions Odile Jacob v Commission*, EU:T:2014:739, § 51). However, such an interpretation is possible only provided that that substance is sufficiently clear from the application, Article 21 of the Statute and Article 177(1)(d) of the RPGC (§ 27).

The applicant's plea submitting that the OD erred in examining the opposition under Article 8(1)(b) EUTMR, although it had been brought only on the basis of Article 8(1)(a) EUTMR is rejected as inadmissible since the applicant has not identified, in a sufficiently clear and precise manner, the reasons why, in its view, the BoA made an error in reviewing the merits of the assessments which had led the OD, in its decision, to reject the opposition under Article 8(1)(b) CTMR [now EUTMR] (§ 18, 28-31).

12/05/2021, T-70/20, [MUSEUM OF ILLUSIONS \(fig.\) / MUSEUM OF ILLUSIONS \(fig.\)](#), EU:T:2021:253, § 18, 22, 27-31

### **Modification of a head of claim — Principle of unalterability of proceedings — Modification of the application — Inadmissibility**

Pursuant to Article 86(1) RPGC, where a measure, the annulment of which is sought, is replaced or amended by another measure with the same subject matter, the applicant may, before the oral part of the procedure is closed, or before the decision of the GC to rule without an oral part of the procedure, modify the application to take account of that new factor (§ 22). As an exception to the principle of unalterability of proceedings, Article 86 must be interpreted strictly (20/09/2018, C-114/17 P, *Spain v Commission*, EU:C:2018:753, § 54) (§ 23).

In its statement of modification of the form of order sought, the applicant not only seeks the annulment of the contested decision, that claim having already been included in the application, but also asks the Court to uphold the action for cancellation of the contested mark's registration (§ 21). Since the applicant does not refer to any replacement or amendment of the contested decision, the modification of its first head of claim is inadmissible (§ 24).

06/10/2021, T-254/20, [DEVICE OF A LOBSTER \(fig.\)](#), EU:T:2021:650, § 21-24

#### 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 alteration of the contested decision and confirmation of the OD decision**

The applicant's head of claim, seeking the annulment or alteration of the contested decision and the confirmation of the OD's decision, is admissible. It is to be understood as requesting that the contested decision be annulled insofar as the BoA annulled the OD's decision, or that the BoA take the decision which it should have taken, which is to say that the appeal against the OD's decision should be dismissed in its entirety (Article 71(1) and Article 72(3) EUTMR; 04/05/2017, T-97/16, GEOTEK, EU:T:2017:298, § 17 and case-law cited) (§ 20, 22-23).

10/02/2021, T-821/19, [B.home / B-Wohnen](#), EU:T:2021:80, § 20, 22-23

## **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

## **Interpretation of a single head of claim seeking alteration and annulment — Admissibility**

The applicant requests the Office to 'be ordered to register the mark applied for also in respect of the other goods in Class 21, namely [...]' (§ 7).

If this single head of claim were to be interpreted as seeking to alter the contested decision, it would be inadmissible (30/06/2009, T-285/08, Natur-Aktien-Index, EU:T:2009:230, § 21; 17/05/2017, T-164/16, THE TRAVEL EPISODES (fig.), EU:T:2017:352, § 24) (§ 10-13).

However, where from the content of the application it is apparent that, by its single head of claim, the applicant seeks not only to alter the contested decision but also to annul it (07/11/2013, T-666/11, Gatto domestico, EU:T:2013:584, § 18), the sole head of claim must be interpreted as also seeking annulment of the contested decision and is therefore admissible (§ 14-15).

30/06/2021, T-624/19, [FORM EINES HANDGRIFFS MIT BORSTEN \(3D\)](#), EU:T:2021:393, § 7, 10-15

### **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  
07/07/2021, T-205/20, [I-cosmetics](#), EU:T:2021:414, § 42

### 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

#### Extension of time limit to file a response only for the party who requested it

The other party to the proceedings before the BoA cannot automatically benefit from an extension of the time limit to file a response accorded to the Office. Its response has to be filed within the time limit prescribed, unless it asks the Court for an extension (§ 28).

23/02/2021, T-587/19, [MARIEN \(fig.\) / MARIN](#), EU:T:2021:107, § 28

#### Formal requirements of the application — Article 76(d) RPGC — Admissibility of arguments and pleas

The BoA did not consider that the examination of the distinctive character of the sign applied for had to be different depending on whether it related to orthopaedic footwear (Class 10) or to footwear in general (Class 25). In these circumstances, the applicant was not obliged to put forward specific arguments relating to orthopaedic footwear in order to avoid the inadmissibility of its action in respect of those goods. Moreover, the absence of these specific arguments cannot be interpreted as meaning that the applicant waived its right to challenge the contested decision insofar as it rejects the application for orthopaedic footwear in Class 10 (§ 23-25).

## **Formal requirements of pleas and arguments of the response — Inadmissibility of the intervener's arguments**

The intervener's argument regarding the fact that some documents submitted during the administrative proceedings were not translated into the language of the proceedings does not satisfy the requirements of Article 180(1)(c) RPGC in so far as, first, it did not identify the documents which should be disregarded on the ground that they had not been translated into the language of the case during the administrative proceedings and, second, it did not dispute the BoA's findings which were based on those documents (§ 19).

24/11/2021, T-434/20, [dziandruk \(fig.\)](#), ECLI:EU:T:2021:815, § 19

## **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**

#### **Inoperative single plea in law — Declaration of invalidity granted on the basis of two grounds with regards to the descriptive character and lack of distinctive character**

The BoA allowed an application for a declaration of invalidity of a trade mark both on the basis of Article 7(1)(c) EUTMR with regard to the descriptive character of the mark and on the ground of lack of distinctive character within the meaning of Article 7(1)(b) EUTMR. In these circumstances, the contested decision may only be annulled if the applicant puts forward sufficiently clear and precise arguments and demonstrates that the BoA's assessments are vitiated by errors of law in relation to each of those grounds for invalidity.

The applicant has not challenged the BoA's assessment that the contested mark is devoid of any distinctive character within the meaning of Article 7(1)(b) EUTMR by putting forward a plea in law that is sufficiently clear and precise. The single plea is rejected inoperative (§ 24).

15/12/2021, T-188/21, [Malle](#), EU:T:2021:903, § 24

### 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 the trade mark 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 account of Article 76(1) CTMR since 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 — Subject matter of the proceedings — Article 95(1) EUTMR

According to Article 95(1) EUTMR, in proceedings relating to relative grounds for refusal the Office is restricted in its examination to the facts, evidence and arguments provided by the parties and the relief sought. Therefore, the BoA may base its decision only on the relative grounds for refusal relied on by the party concerned, and the related facts and evidence presented by the parties (18/06/2020, C-702/18 P, [PRIMART Marek Łukasiewicz \(fig.\) / PRIMA et al.](#), EU:C:2020:489, § 41) (§ 28). In light of Article 188 RPGC, the parties, in proceedings before the Court, do not have the power to alter the legal context of the dispute, as set out in the claims and contentions that they had put forward during the proceedings before the BoA (08/03/2019, T-326/18, [CARAJILLO LICOR 43 CUARENTA Y TRES \(fig.\) / Carajillo \(fig.\)](#), EU:T:2019:149, § 35-36) (§ 26-27, 29).

Where the BoA was right in finding that the applicant had agreed with the OD's assessment regarding genuine use of the earlier mark in connection with certain goods and was entitled to restrict its assessment of the LOC to those goods alone, the applicant's arguments seeking to question the evidence of use of the earlier mark are ineffective and irrelevant (§ 31-33).

30/06/2021, T-227/20, [BIOVÈNE BARCELONA \(fig.\) / Biorene](#), EU:T:2021:395, § 26-27, 29, 31-33

30/06/2021, T-232/20, [Biovène / Biorene](#), EU:T:2021:396, § 26-27, 29, 31-33

#### Scope of the GC's review — Plea directed against grounds that are only included in first instance decisions — 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

### **Scope of the GC's review — Similarity of goods and services disputed for the first time before the GC — Admissible**

The fact that the applicant did not dispute the similarity of the goods of the opposing signs before the BoA cannot deprive it of the right to challenge the findings of the BoA before the GC in that respect, BoA having endorsed the grounds of the OD's decision (28/11/2019, T-665/18, *Vibble / Vybe et al.*, EU:T:2019:825, § 31) (§ 36).

24/02/2021, T-61/20, [B-direct / bizdirect \(fig.\)](#), EU:T:2021:101, § 36

### **Scope of the GC's review — Examination of facts ex officio — Incorrect assessment by the BoA — Principle of interdependence**

Where it is called upon to assess the legality of BoA decisions, the Court cannot be bound by an incorrect assessment of the facts by the BoA, since that assessment is part of the findings the legality of which is being disputed before it (18/12/2008, C-16/06 P, *Mobilix*, EU:C:2008:739, § 48; 05/02/2020, T-44/19, *TC Touring Club (fig.) / TOURING CLUB ITALIANO et al.*, EU:T:2020:31, § 88) (§ 49).

Although the opponent did not challenge the BoA's conclusion in relation to the conceptual comparison, it did call into question the BoA's assessment relating to the LOC. Therefore, by virtue of the principle of interdependence, the Court has jurisdiction to examine the BoA's findings on the conceptual comparison (05/12/2019, T-29/19, *Idealogistic Verhoeven Greatest care in getting it there (fig.) / iDÉA (fig.) et al.*, EU:T:2019:841, § 89) (§ 50).

02/12/2020, T-35/20, [DEVICE OF CLAW-LIKE SCRATCH \(fig.\) / DEVICE OF CLAW-LIKE SCRATCH \(fig.\) et al.](#), EU:T:2020:579, § 49-50

### **Scope of the GC's review — Examination of facts ex officio — Incorrect assessment by the BoA — Principle of interdependence**

Where one of the parties claiming that the BoA should be annulled has called into question the BoA's assessment relating to the LOC, the Court has, by virtue of the principle of interdependence between the factors taken into account, in particular the similarity of the trade marks and that of the goods and services covered, jurisdiction to examine the BoA's assessment of not disputed factors. Where it is called upon to assess the legality of a decision of a BoA of EUIPO, the Court cannot be bound by an incorrect assessment of the facts by that BoA, since that assessment is

part of the findings the legality of which is being disputed before it (18/12/2008, C-16/06 P, Mobilix, EU:C:2008:739, § 47-48) (§ 37).

12/05/2021, T-70/20, [MUSEUM OF ILLUSIONS \(fig.\) / MUSEUM OF ILLUSIONS \(fig.\)](#), EU:T:2021:253, § 37

### **Scope of the GC's review — Examination of facts ex officio — Incorrect assessment of the BoA**

In spite of the fact that the applicant has not disputed the general public's level of attention, the GC, where it is called upon to assess the legality of a decision, cannot be bound by an incorrect assessment within it. This is because that assessment is part of the findings the legality of which is being disputed before the GC (18/10/2012, C-101/11 P & C-102/11 P, Ornamentación, EU:C:2012:641, § 40). In this case, the BoA's assessments regarding the general public's level of attention are part of the findings the legality of which is being disputed before the Court (§ 25-26).

21/12/2021, T-369/20, [Cefa certified european financial analyst / Cfa et al.](#), EU:T:2021:921, § 25-26

#### **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  
09/09/2020, T-144/19, [ADLON / ADLON](#), EU:T:2020:404, § 19

##### **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, [DermoFaes Atopimed / Dermowas](#), EU:T:2019:819, § 16

##### **Claims made and evidence filed for the first time before the GC — Inadmissibility**

The claim of the earlier trade mark's particular strength of reputation must be made in the proceedings before the Office and cannot be made for the first time in the proceedings before the GC (§ 67-81). The same applies to evidence submitted in support of the claims made (§ 117-118, 122).

19/05/2021, T-510/19, [DEVICE OF A JUMPING ANIMAL \(fig.\) / PUMA \(fig.\) et al.](#), EU:T:2021:281, § 67-81, 117-118, 122

## **Community design — Evidence produced for the first time in the proceedings before the GC — Inadmissibility**

The evidence, which was acquired through the use of freely accessible applications (such as Google and the Wayback Machine) and submitted for the first time before the GC, is inadmissible since the purpose of actions brought before the GC is to review the legality of decisions of the BoA, as referred to in Article 61 CDR. It is not the GC's function to review the facts in light of documents that have been produced for the first time before the GC itself (§ 11-14).

20/10/2021, T-823/19, [Bobby pins](#), EU:T:2021:718, § 11-14

### **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

#### **National judgment submitted for the first time before the GC**

A national judgment submitted for the first time before the GC is admissible where the party does not claim that it should have been taken into account by the BoA, but relies on that judgment to support its argument that the BoA was correct to conclude that authorship of the work invoked had not been proven. Admissibility of a judgment of a national court depends on the purpose for which it is relied on by the person concerned (§ 82).

### **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

#### Request for investigative measures

A party may rely before the Court on the existence of evidence that may question the accuracy of the content or probative value of the evidence considered by the Office by requesting investigative measures for that evidence to be produced, for the first time, before the Court. However, in such a case, the party requesting such measures must explain in detail the reasons for considering that the evidence taken into account by the Office does not correspond, in its view, to reality, or the reasons for considering that the probative value of that evidence has not been established (§ 51). According to Article 97 EUTMR, parties to proceedings before the Office may request or propose investigative measures in order to establish facts relevant to the case. However, the applicable provisions do not impose an obligation on the Office to take such measures (§ 53).

29/09/2021, T-592/20, [Agate / Agate](#), EU:T:2021:633, § 51, 53

#### Conditions for annulment of a decision with several pillars of reasoning

Where the operative part of a decision is based on several pillars of reasoning, each of which would in itself be sufficient to justify that operative part, that decision should, in principle, be annulled only if each of those pillars is vitiated by an illegality. In such a case, an error or other illegality which affects only one of the pillars of reasoning cannot be sufficient to justify annulling the decision at issue because that error could not have had a decisive effect on the operative part adopted by the decision-maker (§ 38).

24/11/2021, T-434/20, [dziandruk \(fig.\)](#), ECLI:EU:T:2021:815, § 38

## 2.2.2 Restriction of the list of goods and services

### 2.2.2.1 Admissible restrictions

#### Restriction of the goods and services — Subject matter of the proceedings before the GC

In principle, a restriction within the meaning of Article 49(1) EUTMR of the list of goods or services made after the adoption of the BoA decision challenged before the GC cannot affect the legality of that decision (09/07/2008, T-304/06, Mozart, EU:T:2008:268, § 25) (§ 21).

Where the restriction amounts to a change in the subject-matter of the proceedings in the course of the proceedings, it cannot be taken into account by the GC (Article 188 RPGC; 09/07/2008, T-304/06, Mozart, EU:T:2008:268, § 29) (§ 22-23). However, a restriction of the list of the goods and services is possible if the applicant confines itself to withdrawing one or more goods or services from the list, or one or more categories of goods or services. In such a case, it is clear that the GC is in fact being asked to review the legality of the BoA decision not insofar as it relates to the goods or services withdrawn from the list but only insofar as it relates to the other goods or services remaining on that list (09/07/2008, T-304/06, Mozart, EU:T:2008:268, § 27-28) (§ 24-25).

10/02/2020, T-341/20, [Radioshuttle](#), EU:T:2021:72, § 21, 24-25

### **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

### **Inadmissible limitation of goods and services — Alteration of the subject matter of the dispute — Relevant public and its level of attention**

A restriction of the services of the mark applied for, requested by the applicant after the BoA decision, is not limited to reducing the subject matter of the dispute by withdrawing certain services in the same category of those applied for, but is capable of changing the subject matter of the dispute by altering the composition of the relevant public and its level of attention. Therefore, it cannot be taken into account by the GC for the purposes of examining the legality of the contested BoA decision (§ 22-23).

09/12/2020, T-819/19, [BIM READY \(fig.\) / BIM freelance \(fig.\)](#), EU:T:2020:596, § 22-23

### **Restriction of the services covered by the mark applied for — Change of the subject matter of the dispute before the GC — Inadmissible**

Where the restriction leads to a change in the subject matter of the dispute, in that it results in the introduction of new elements which had not been submitted for examination by the BoA for the purposes of the adoption of the contested decision, it may not, in principle, be taken into account by the Court. This is the case where the restriction of the goods and services consists of specifications capable of influencing the assessment of the similarity of the goods and services or the determination of the target public and of changing, consequently, the factual context presented before the BoA (30/04/2015, T-100/14, *TECALAN / TECADUR et al.*, EU:T:2015:251, § 32 and the case-law cited) (§ 23-24).

02/06/2021, T-17/20, [GAMELAND \(fig.\) / Gameloft](#), EU:T:2021:313, § 23-24

## **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

[No key points available yet.]

## 2.6 COSTS

### **Repartition of costs of the proceedings before the GC — Article 135(2) RPGC — Equity and unreasonable or vexatious costs — Avoidable incurred travel costs to the oral hearing due to the withdrawal of the request for the oral hearing**

By its conduct, the Office caused the applicant to incur travel expenses that could have been avoided. Therefore, even though the applicant was unsuccessful, as per Article 135(2) of the RPGC, the Office was ordered to pay the applicant's lawyers' travel costs to the oral hearing that was initially requested by the Office, scheduled and then cancelled following the withdrawal of the Office's request for the oral hearing (§ 117-119).

10/11/2021, T-353/20, [ACM 1899 AC MILAN \(fig.\) / Milan et al.](#), EU:T:2021:773, § 117-119

### **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

27/01/2021, T-382/19, [Skylife \(fig.\) / SKY](#), EU:T:2021:45, § 56

## 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

##### **Invalidity proceedings — Relation between Article 7(1)(a) EUTMR and 7(1)(b) EUTMR — Adverse effect of the BoA decision — Admissibility of an action or of a cross-claim**

Where an application for a declaration of invalidity is based on the fact that the sign at issue has been registered contrary to the provisions of Article 7(1)(a) EUTMR or the provisions of Article 7(1)(b) EUTMR, it is essential to examine the first of these grounds before assessing, where appropriate, whether the mark has inherent distinctive character or whether it has acquired distinctive character through use (§ 44-48).

The invalidity applicant is adversely affected by the BoA's decision which upheld the invalidity request on the basis of Article 7(1)(b) EUTMR and remitted the case to the Cancellation Division for the assessment of Article 7(3) EUTMR, but which did not examine Article 7(1)(a) EUTMR, which was also invoked by the invalidity applicant (§ 54).

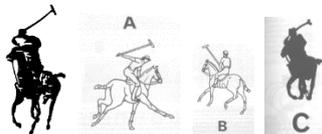
In light of the relationship between Article 4 and Article 7(1)(a) EUTMR, and of Article 7(1)(b) thereof, the Grand Board of Appeal could not dispense with the examination of the ground for invalidity under Article 7(1)(a) EUTMR and refer the case back to the Cancellation Division to decide on the possible acquisition of distinctive character by the mark following the use which has been made of it, in accordance with Article 7(3) and Article 52(2) EUTMR (§ 69).

06/10/2021, T-124/20; [DEVICE OF A REPEATED GEOMETRIC DESIGN \(fig.\)](#), EU:T:2021:668, § 44-48, 54, 69

### **Invalidity proceedings — Relevant date for the establishment of the existence and protection of the earlier right — Date on which the Office takes its decision**

It follows from the broad logic of the other provisions of the regulation concerning relative grounds for refusal that an application for a declaration of invalidity must be rejected where the cancellation applicant is unable to prove that its earlier mark continues to enjoy protection on the date on which the Office takes its decision and it is established, with certainty, that the conflict with the earlier trade mark no longer exists (§ 27-29).

In the context of Article 52(2)(d) CTMR [now Article 60(2)(d) EUTMR] the proprietor of an earlier industrial property right must therefore establish that he may prohibit the use of the contested EU trade mark not only on the date of filing or priority of that mark, but also on the date on which the Office gives a ruling on the application for a declaration of invalidity (§ 30).



02/06/2021, T-169/19, [DEVICE OF A POLO PLAYER \(fig.\) / DEVICE OF A POLO PLAYER \(fig.\) et al.](#), EU:T:2021:318, § 27-30

### **Invalidity proceedings — Continued existence of earlier right throughout proceedings before the Office**

An earlier mark invoked as the basis of an invalidity request in proceedings before the Office must exist (i) at the filing/priority date of the contested EUTM (§ 33-34) and (ii) throughout the proceedings until the date on which the Office decides on the request for invalidity (§ 35). This follows from the applicable provisions in the EUTMR and the EUTMDR (§ 36-39), and also from the principle that any claim before an administrative body is conditional upon the existence of a legitimate interest, vested and present, in the success or rejection of that claim (§ 40-41).

20/07/2021, T-500/19, [Coravin](#), EU:T:2021, § 33-41

### **Community design — Standing to challenge a decision to maintain a design in an amended form**

The ground for invalidity laid down in Article 25(1)(e) CDR provides for a right to prohibit the use of the contested design on the basis of an earlier distinctive sign. Where the applicant has challenged the contested design on this ground and the Office invalidates the design, the design owner may apply to maintain the registration of the contested design in an amended form pursuant to Article 25(6) CDR. Where that amendment consists of removing the earlier distinctive

sign from the contested design, the applicant has no standing to challenge the Office's decision to grant the amendment (§ 49, 52, 57, 58, 60, 61).

The design owner has standing to challenge a decision of the Office rejecting its application to maintain the registration of the contested design in an amended form pursuant to Article 25(6) CDR (§ 53).



25/10/2021, T-329/20, [Pendenti](#), EU:T:2021:732, § 49, 52-53, 57, 58, 60, 61

### 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).

### **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).

13/06/2019, T-366/18, [SUIMOX / ZYMOX](#), EU:T:2019:410, § 17-23, 29, 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**

### **Time-limit to file a restitutio in integrum — Locus standi — Licence agreement**

Under Article 53(1) EUTMR, only the proprietor of the trade mark or a person expressly authorised by him can be regarded as a party to the renewal proceedings (§ 25).

No provision in the EUTMR precludes a 'party to the renewal proceedings' from being regarded as a 'party to proceedings before [the EUIPO]', within the meaning of Article 104(1) EUTMR (§ 26).

An EUTM licensee is not on the same legal footing, for the purposes of the renewal of an EUTM registration, as the EUTM proprietor: in the same way as any other person, the licensee must be expressly authorised by the proprietor to be able to submit a request for renewal and must prove the existence of such authorisation (§ 27).

According to Article 104(2) EUTMR, an application to have rights re-established must be filed in writing within 2 months of the removal of the obstacle to compliance with the time limit (§ 45). The lack of an express authorisation from the EUTM proprietor to the EUTM licensee does not constitute an obstacle to compliance within the meaning of Article 104 (§ 48). Therefore, the 2-month period cannot begin to run from the date on which the licensee received the proprietor's authorisation (§ 47).

### **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

### **Restitutio in integrum — Duty of care — Due care requires system of internal control and monitoring of time limits**

A system of internal control and monitoring of time limits, which is based in essence on one person controlling the work of the other, cannot generally preclude involuntary non-compliance with time limits (§ 31).

21/04/2021, T-382/20, [Table knives, forks and spoons](#), EU:T:2021:210, § 31

### **Restitutio in integrum — Due care required by the circumstances — Error of bank transfer**

In support of his action, the applicant alleged solely an error in the transmission of the data to the bank or an error by the bank in the execution of the transfer to the EUIPO (§ 29).

However, since such errors are neither rare nor improbable, they cannot be regarded as exceptional and unforeseeable (§ 30). The applicant was under an obligation to anticipate those circumstances and to take the necessary precautions to ensure that the payment was made within the established time period. This applies a fortiori in the case of an action as important as the renewal of the registration of a trade mark, where the transfer was ordered via an online banking system on the same day as leaving for a stay abroad and where the first deadline for carrying out this formality had been missed (§ 31).

Therefore, despite the absence of an error message from the bank regarding the execution of the transfer, the applicant should have enquired with his bank about the execution of the transfer to remedy any non-payment. Indeed, an effective system of internal control and monitoring of compliance with deadlines should have included such a check. Moreover, the requirement to take such precautions does not infringe the principle of proportionality, since, under Article 53(8) EUTMR, the breach of an obligation such as compliance with the time limits prescribed by that regulation is, in principle, punishable by the loss of rights (§ 32). The BoA did not err in finding that, in the present case, the applicant had not exercised all the due care required by the circumstances and that, therefore, the first condition of Article 104(1) EUTMR was not satisfied (§ 36).

13/10/2021, T-732/20, [Crystal](#), EU:T:2021:696, § 29-32, 36

13/10/2021, T-733/20, [Bandit](#), EU:T:2021:697, § 30-32, 36

## **Restitution in integrum — Article 67(1) CDR — Duty of care — Letter sent by ordinary mail — Due care requires verification of reception**

According to Article 67(1) CDR *restitutio in integrum* is subject to two requirements, the first being that the party has exercised all due care required by the circumstances. The second requirement is that the non-observance by the party has the direct consequence of causing the loss of any right or means of redress.

Where an applicant, proprietor, or any party to proceedings before the Office is represented, the representative is subject to the requirement to take due care. The expression 'all due care required by the circumstances' in Article 67(1) CDR requires a system of internal control and monitoring of time limits to be put in place which generally excludes the involuntary non-observance of time limits. It follows that *restitutio in integrum* may be granted only in the case of exceptional events, which cannot therefore be predicted from experience (31/01/2019, T-604/17, REJECTION OF RESTITUTIO IN INTEGRUM (RECORDAL), EU:T:2019:42, § 11, 17-19, 31) (§ 17-20). As the observance of time limits is a matter of public policy and *restitutio in integrum* is liable to undermine legal certainty, the conditions for the application of *restitutio in integrum* must be interpreted strictly (19/09/2012, T-267/11, VR, EU:T:2012:446, § 35) (§ 21).

In those circumstances, the risk inherent in sending a document by ordinary mail, which is the method of communication chosen by the representative before the Office, cannot be borne by the addressee of that letter, where the addressee of that letter makes various claims such as to cast reasonable doubt as to the receipt of the document in question (25/10/2012, T-191/11, Miura, EU:T:2012:577, § 32-34) (§ 29, 32). In such a situation, it is for the representative before the Office, as a professional who is requested to take all due care required by the circumstances, to ensure that the disputed letter, which he claims was sent by ordinary mail, was received within the time limit set (§ 33-34). An effective system of internal supervision and monitoring of compliance with time limits, where posting of mail by ordinary mail is used as a method of communication, must include verification that such mail has been received by its addressee (§ 38).

20/01/2021, T-276/20, [Air deodorizing apparatus](#), EU:T:2021:26, § 21, 29, 32-34, 38

## **Restitutio in integrum — Duty of care — Lawyer's sworn declaration as evidence — Specific sudden illness — Article 97(1)(f) EUTMR — Probative value**

Where a sworn declaration, submitted as evidence according to Article 97(1)(f) EUTMR, is made in the interest of the declarant, it has only limited probative value and should be supported by additional evidence (16/06/2015, T-585/13, JBG Gauff Ingenieure (fig.) / Gauff et al., EU:T:2015:386, § 28-31). The assessment of the probative value to be attributed to such a statement, however, must consider the circumstances of the concrete case (§ 51-52).

As regards a declaration made by a lawyer, the fact that the lawyer is a member of the legal profession who is required to carry out his duties in accordance with the rules of professional conduct and moral requirements, and who would be exposed to penal sanctions in case of a false statement that would be, moreover, prejudicial to his reputation, must be considered (§ 55). A written sworn declaration by a lawyer (and by his wife) constitutes, in itself, sound evidence of the information contained therein, if it is clear, consistent and conclusive and there is no doubt about its authenticity (§ 56, 58).

Where additional evidence capable of supporting the content of a sworn declaration, such as a medical certificate, could not reasonably be required or was not available, (namely in case of a specific and sudden illness), the situation is different from those where such statements are submitted in order to establish purely objective facts, such as genuine use of a mark, and where according to established case-law, the declarations must be supported by additional evidence for their probative value (§ 57-59).

### **Restitutio in integrum — Late payment of the appeal fee — Inadmissibility of the appeal before the BoA — Article 101(4) EUTMR**

The BoA rightly considered that it was not competent to adopt a decision pursuant to Article 101(4) EUTMR, which covers the Executive Director's power to extend the time limit on account of an exceptional occurrence or disaster. The BoA has no such competence, nor can it transmit corresponding requests to the Executive Director (§ 29-30).

The only solution for a party that has failed to comply with a time limit (in the present case time limit for paying appeal fees, laid down in Article 68 EUTMR) is to submit an application for *restitutio in integrum* (§ 31, 33-35). In the context of the *restitutio in integrum* procedure, the applicant could have raised all of its substantive arguments. These were the fact that Bulgaria was facing the exceptional occurrence of the COVID-19 pandemic (which also affected its representative who was placed in quarantine), and the capital control measures then in place in Lebanon that prevented the representative from making payments outside the country (§ 32). However, the applicant did not submit an application for *restitutio in integrum* (not disputed) (§ 34).

The Office is not required to direct the applicant to submit an application for *restitutio in integrum* so that it can argue its reasons for non-compliance with the time limit laid down in Article 68 EUTMR. There is no provision requiring the Office to inform a party of the procedures available to it under Article 104 EUTMR and Article 68 EUTMDR. Nor is the Office required to advise a party to pursue any particular legal remedy. Moreover, information for the parties is contained in the Office's Guidelines, particularly applicable in the event of the expiry of a time limit (§ 36).

06/10/2021, T-635/20, [Juvéderm vybrance](#), ECLI:EU:T:2021:656, § 29-36

06/10/2021, T-636/20, [Juvéderm voluma](#), ECLI:EU:T:2021:657, § 29-36

06/10/2021, T-637/20, [Juvéderm volíte](#), ECLI:EU:T:2021:658, § 29-36

### **Article 106(1)(b) EUTMR — Conditions for interruption of proceedings**

According to Article 106(1)(b) EUTMR, proceedings must be interrupted 'in the event of the applicant for, or proprietor of, an EU trade mark being prevented, for legal reasons resulting from action taken against his property, from continuing the proceedings before the Office'. This cannot extend to applicants for a declaration of invalidity. This strict interpretation is justified by the possibility to ask for *restitutio in integrum* (§ 45).

#### **3.2.4 Continuation of proceedings (not applicable to designs)**

### **Article 72(6) EUTMR — Resumption of proceedings before the BoA after the annulment of a previous decision by the GC — Article 94(1) EUTMR — Right to be heard**

In order to comply with a judgment annulling a measure and to implement it fully, the institution responsible for adopting that measure must have regard not only to the operative part of the judgment but also to the grounds constituting its essential basis, insofar as they are necessary for determining the exact meaning of what is stated in the operative part. These grounds identify the exact provision held to be unlawful on the one hand and, on the other, indicate the specific reasons for the finding of unlawfulness contained in the operative part, which the institution concerned must take into account when replacing the annulled measure (§ 24-26, 30-31).

The second sentence of Article 94(1) EUTMR in no way requires that, after resuming proceedings before the Office following the annulment of a BoA decision by the GC, the applicant be invited to submit observations again on points of law and fact on which it has already had ample

opportunity to express its views during the earlier written procedure, given that the file, as then constituted, has been taken over by the BoA (§ 33-34).

14/07/2021, T-749/20, [VERONESE \(fig.\) / Veronese](#), EU:T:2021:430, § 24-26, 30-31, 33-34

### 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

### **No manifest error of assessment — No reasoned request for suspension of proceedings**

A mere reference to revocation proceedings that does not contain any explanation cannot satisfy the requirements of Article 71(1) EUTMDR, which requires a reasoned request from one of the parties. The fact that an action for revocation of the earlier mark on which the opposition is based is pending is not, in itself, sufficient to classify the BoA's refusal to stay proceedings as a manifest error of assessment. As regards the applicant's argument that the Office should have stayed the opposition proceedings of its own motion, under Article 71(1) EUTMDR it is for the BoA to decide whether or not to order the stay, and it only exercises that power if it considers it justified (§ 51-53).

01/12/2021, T-359/20, [Team Beverage](#), EU:T:2021:841, § 51-53

### **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 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*

### **Scope of the appeal — BoA's power to examine essential procedural requirements not raised by the parties — No amendment of the form of order sought — Legitimate expectations**

The power of the BoA to review infringements of essential procedural requirements in the first instance does not mean that it has the power to amend, of its own motion, the form of order sought by an appellant since this approach would disregard the distinction between the pleas in law and the form of order sought in an action. It is the form of order sought that defines the limit of the dispute (§ 24-25).

The applicant's alleged belief that the decision of the Opposition Division complied with the procedural rules, despite the procedural defect committed by that division, cannot give rise to a legitimate expectation that the decision was formally valid (§ 29).

13/10/2021, T-712/20, [DEVICE OF ARROW WITH WING \(fig.\) / DEVICE OF ARROW WITH WING \(fig.\)](#), EU:T:2021:700, 24-25, 29

### **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 — No need for further observations after annulment by the GC/CJ**

The second sentence of Article 94(1) EUTMR in no way requires that, upon the resumption of proceedings before the Office after the annulment of the BoA decision by the GC, the parties be invited again to submit observations on points of law and fact on which they already had ample opportunity to express their views in the course of the written procedure previously conducted, given that the file as then constituted has been taken over by the BoA (03/02/2017, T-509/15, *Premeno / Pramino*, EU:T:2017:60, § 26 and case-law cited) (§ 50).

28/04/2021, T-509/19, [Flügel / ... Verleiht Flügel et al](#), EU:T:2021:225, § 50

### **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

### **Infringement of the right to be heard — The Office's obligation to obtain information about national law invoked under Article 8(4) EUTMR**

The obligation of the Office to obtain information *ex officio* about the national law invoked under Article 8(4) EUTMR by all means available to it in relation to its power of verification should have been better reconciled with the obligation under Article 94(1), second sentence, EUTMR (the right to be heard). By failing to invite the opponent to take a position on an important provision of the Bulgarian Law on Marks and Geographical Indications, which had a decisive impact on the outcome of the dispute, the BoA infringed the opponent's right to be heard (§ 51-52).

25/11/2020, T-57/20, [GROUP Company TOURISM & TRAVEL \(fig.\)-GROUP Company TOURISM & TRAVEL \(fig.\)](#), EU:T:2020:559, § 51-52

### **No infringement of the right to be heard — *Audi alteram partem* rule — Failure to request authorisation to submit a reply according to Article 26(1) EUTMDR**

Where the appellant failed to request authorisation to submit a reply according to Article 26(1) EUTMDR, as a means available to it in order to submit its observations on the new arguments and evidence adduced by the other party in its response, it cannot be alleged that the BoA deprived the appellant of the opportunity to comment on the evidence adduced for the first time before the BoA and thereby vitiated the administrative procedure, in breach of the *audi alteram partem* rule and the right to be heard (§ 86-89).

16/06/2021, T-215/20, [HYAL](#), EU:T:2021:371, § 86-89

### **No infringement of the right to be heard — Application of case-law**

The BoA is under no obligation under the second sentence of Article 94(1) EUTMR or Article 95(1) EUTMR to inform the applicant regarding the case-law on which it intended to rely in its findings (§ 92).

30/06/2021, T-531/20, [ROLF \(fig.\) / Wolf et al.](#), EU:T:2021:406, § 92

### **No infringement of the right to be heard — No duty to inform about evidence to submit for the substantiation of arguments**

The right to be heard set out in the second sentence of Article 94(1) EUTMR requires that decisions of the Office be based only on reasons on which the parties have had an opportunity to present their views. However, this right does not mean that the Office informs the parties what evidence they have to submit in order to substantiate their arguments (§ 87).

17/11/2021, T-298-19, [FORM VON ROTEN SCHNÜRSENKELENDEN \(Posit.\)](#), EU:T:2021:792, § 87

### **No infringement of the right to be heard — Article 72(6) EUTMR — Resumption of proceedings before the BoA after the annulment of a previous decision by the GC**

In order to comply with a judgment annulling a measure and to implement it fully, the institution responsible for adopting that measure must have regard not only to the operative part of the judgment but also to the grounds constituting its essential basis, insofar as they are necessary for determining the exact meaning of what is stated in the operative part. These grounds identify the exact provision held to be unlawful on the one hand and, on the other, indicate the specific reasons for the finding of unlawfulness contained in the operative part, which the institution concerned must take into account when replacing the annulled measure (§ 24-26, 30-31).

The second sentence of Article 94(1) EUTMR in no way requires that, after resuming proceedings before the Office following the annulment of a BoA decision by the GC, the applicant be invited to submit observations again on points of law and fact on which it has already had ample opportunity to express its views during the earlier written procedure, given that the file, as then constituted, has been taken over by the BoA (§ 33-34).

14/07/2021, T-749/20, [VERONESE \(fig.\) / Veronese](#), EU:T:2021:430, § 24-26, 30-31, 33-34

### **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 — Article 94(1) EUTMR — Implicit reasoning**

The reasoning of a decision may be implicit, on the condition that it enables the persons concerned to know the reasons for the BoA's decision and provides the competent Court with sufficient material for it to exercise its power of review (12/03/2020, T-321/19, *Jokers WILD Casino* (fig.), EU:T:2020:101, § 15-17 and case-law cited) (§ 21).

24/03/2021, T-354/20, [Representation of a fish \(fig.\) / Blinka](#), EU:T:2021:156, § 21

### **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 — Evidence not mentioned in the BoA's decision**

Just because the BoA did not mention a particular document in the contested decision does not mean that the BoA did not consider that document (§ 70).

20/01/2021, T-656/18, [MANUFACTURE PRIM 1949 \(II\)](#), EU:T:2021:17, § 70

### **Exception to the obligation to examine (as a preliminary matter) proof of genuine use of an earlier mark — Article 94 EUTMR — No contradiction or failure to state reasons**

Where there is no LOC between the signs, it is not necessary to examine proof of use of the earlier mark as a preliminary step before the analysis of the similarity of the signs (§ 24-25). The Office and the Court can carry out a comparison of the signs by taking into consideration a situation which is fictitious but close to reality, determining a hypothetical relevant public having regard to the goods and services in respect of which the earlier mark can be deemed to be registered (15/02/2005, T-296/02, *Lindenhof*, EU:T:2005:49, § 49-68) (§ 26). However, where the BoA considers that the differences between the marks are not sufficient to rule out the existence of a LOC on the part of the relevant public, the preliminary examination of genuine use of the earlier mark has to be carried out (§ 30, 58, 61).

28/04/2021, T-300-20 [Accusi-Acústic \(fig.\) et al](#), EU:T:2021:223, § 24-26, 30, 58, 61

### **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).

### **Scope of the duty to state reasons — Confirmation of a lower-level decision in its entirety**

Where the BoA confirms a lower-level decision of the Office in its entirety, that decision together with its statement of reasons forms part of the context in which the BoA's decision was adopted, which is known to the parties and enables the EU judicature to carry out fully its judicial review as to whether the BoA's assessment was well founded (§ 79).

The institutions are not obliged, when stating the reasons for the decisions which they are called on to make, to take a view on every argument that the parties have submitted to them. It is sufficient if they set out the facts and legal considerations having decisive importance in the context of the decision (§ 82).

30/06/2021, T-531/20, [ROLF \(fig.\) / Wolf et al.](#), EU:T:2021:406, § 79, 82

### **Scope of the duty to state reasons — BoA decision taken following annulment of an earlier decision by the GC — Reference to the grounds of that earlier annulled decision — Not permissible**

A judgment annulling a measure takes effect *ex tunc*, retroactively eliminating the annulled measure from the legal system. Thus, that initial decision does not exist in the EU legal order and can therefore have no effect (§ 200). Consequently, that initial decision does not form part of the legal context in the light of which the statement of reasons of the decision subsequently adopted by the BoA to implement that judgment must be assessed (§ 201).

Where, on an appeal against a decision of the BoA, the Court finds that the BoA's assessment is invalid, it must annul that decision in its entirety, even if it is only invalid for one of the grounds of opposition relied on (§ 207). In such a situation, when providing the basis for the operative part of the decision subsequently adopted to implement the judgment annulling the initial decision, the BoA is not permitted to reject all the grounds of opposition relied on by referring, for certain ones of those grounds, to the reasoning of the initial decision without examining and rejecting each of the grounds of opposition (§ 203).

23/09/2020, T-796/16, [Grass in bottle / Bottle with strand of grass et al.](#), EU:T:2020:439, § 200-203

#### **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

23/09/2020, T-677/19, [SYRENA](#), EU:T:2020:424, § 84

##### **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

03/09/2020, C-214/19 P, [achtung ! \(fig.\)](#), EU:C:2020:632, § 41

#### General reasoning — Requirement of substantiated argumentation for alleging lack of a sufficiently direct and specific link between the sign and the goods and services

Arguments concerning the lack of a sufficiently direct and specific link between the sign and the goods and services must be sufficiently substantiated. The citation of examples in this regard is not sufficient. The specific goods and services to which the submission relates must be specified and it must be explained why there is no sufficiently direct and specific link between the sign and those goods and services (§ 32, 62).

02/12/2020, T-152/20, [Home Connect \(fig.\)](#), EU:T:2020:584, § 32, 62

#### 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.

#### Departure from previous EUIPO decisions — Duty to state reasons — Principle of sound administration

The BoA is not required to respond expressly and exhaustively to all of the arguments put forward by the applicant, provided that it sets out the facts and legal considerations having decisive importance in the contested decision. As long as the BoA sets out the decisive reasons for its conclusion regarding the lack of a link between the earlier marks and the mark applied for, it was not obliged to respond expressly to the argument by which the applicant relied on a previous EUIPO decision. That EUIPO decision was not relied on as evidence of a factual situation such as that relating to the reputation of the earlier mark, but merely to claim that legal provisions should be applied in the same way to comparable factual situations (§ 92-94).

10/03/2021, T-71/20, [Puma-system / PUMA \(fig.\)](#), EU:T:2021:121, § 92-94

#### 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

#### Action for infringement — Opposition proceedings

As for the claim that the BoA erred in disregarding the judgment of the *Audiencia Provincial de Alicante* (Provincial Court, Alicante) and a judgment of the First Chamber of the *Qorti Ċivili* (Civil Court), Malta, the EUTMR does not contain any provision by which the Office is bound by a

decision, even now definitive, of an EU trade mark court delivered in an action for infringement, in the context of the exercise of its exclusive jurisdiction over registration of EU trade marks and, in particular, when it examines oppositions lodged against applications to register EU trade marks (21/07/2016, C-226/15 P, English Pink / PINK LADY, EU:C:2016:582, § 48) (§ 153).

10/03/2021, T-693/19, [KERRYMAID / Kerrygold \(fig.\)](#), EU:T:2021:124, § 153

### **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.

### **Relevance of case-law post-dating the EUTM application**

The BoA did not err in basing the contested decision on, inter alia, the interpretation given by the CJ and by the GC to Article 7(1)(b) and (c) EUTMR in decisions delivered after the date the application for registration of the contested mark was filed, insofar as, by those decisions, the EU Courts merely interpreted the substantive rules applicable on the date the application was filed, with the result that such decisions, which clarify the scope and conditions for application of Article 7(1)(b) and (c) EUTMR, allow conclusions to be drawn about the legal situation as it was on that date (§ 33).

Registration of an EU trade mark cannot create a legitimate expectation by the proprietor of that mark regarding the outcome of subsequent invalidity proceedings, since the applicable rules expressly allow for a possible subsequent challenge to that registration in an application for a declaration of invalidity or in a counterclaim in infringement proceedings. The fact that a mark was initially registered by the EUIPO does not bind the EUIPO in the future, since the registration of a mark does not preclude that mark from being declared invalid if it was registered in breach of one of the absolute grounds for refusal set out in Article 7 EUTMR (§ 95).

The applicable provisions do not set out a period within which an application for a declaration of invalidity on the ground of absolute nullity must be filed. The requirement of legal certainty constitutes the general interest pursued by Article 51(1) EUTMR. The objective of that provision is to make it possible to rectify any errors committed by the examiner at the time of filing an application for registration (§ 107, 109). The applicant does not raise a plea of illegality in respect of Article 51(1)(a) EUTMR pursuant to Article 277 TFEU (§ 116).

01/09/2021, T-834/19, [e\\*message \(fig.\)](#), EU:T:2021:522, § 33, 95, 107, 109, 116

### 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 — 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

#### Scope of the duty to state reasons — Different assessment compared to previous decisions — No obvious differences that would justify different answers

Although the Office is not bound by its previous decisions, it must take into account decisions already taken and consider with special care whether it should decide in the same way or not. In that regard, the Office has not shown to what extent in the previous decisions the understanding of the semantic content of the word 'amen' by the general public differed from that in the present case. In actual fact, in view of the limited scope of that question, there are no obvious factual differences that would justify different answers. In particular, since the BoA based its assessment of the semantic content on the *Collins* English-language dictionary, it cannot be accepted that a difference arises from the language context of the relevant public, namely the general German-, Slovak- or Czech-speaking public, on the one hand, and the European or Italian public, on the other (§ 58).

**.A.M E N.** 05/05/2021, T-442/20, [Âme / .A.M E N. \(fig.\)](#), EU:T:2021:237, § 58

#### 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 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

### **Lack of reasoning — Invalidity proceedings based on different prior rights**

On applications for a declaration of invalidity based on different prior rights it follows from the *ratio legis* of Article 53(4) CTMR [now Article 60(4) EUTMR] that such provision is applicable even if the initial application for a declaration of invalidity has been withdrawn or considered inadmissible, the **mere filing** of an initial application being sufficient (§ 45).

The BoA did not describe the rights relied on in support of each of the two applications. In particular, as regards the signs used in the course of trade, it did not specify their nature and the verbal elements of which they are composed. Because of the deficiencies in the statement of reasons, it is not sufficiently clear and precise what those rights are and whether the BoA considered that the right or rights relied upon in support of the second application for a declaration of invalidity had or had not been relied upon in the first application for a declaration of invalidity (§ 58, 61, 64, 77).

01/09/2021, T-566/20, [PALLADIUM HOTEL GARDEN BEACH \(fig.\) / Grand hotel palladium](#), EU:T:2021:525, §§ 45, 58, 61, 64, 77

15/09/2021, T-207/20, [PALLADIUM HOTELS & RESORTS \(fig.\) / Grand hotel palladium](#), EU:T:2021:587, § 45, 58, 61, 64, 77

### **Lack of reasoning — Belated evidence in the proceedings before the BoA — Licensee’s entitlement to file the opposition — Proof of entitlement**

Proof of the licensee’s entitlement to file an opposition must be submitted during the substantiation period (§ 47). The proprietor’s authorisation cannot be presumed from the mere existence and registration of a licence if this licensee (exclusive or not) does not explicitly address the licensee’s right to file oppositions (§ 50). On the facts of the case, such proof could not be deduced from the following circumstances: (i) the proprietor of the earlier EU marks and the opponent are members of the same group of companies and are economically linked (§ 53, 62); (ii) the two companies have the same representative before the Office; (iii) the application to register the licence was submitted through that common representative, who also filed the opposition; (iv) the EUTM proprietor and its licensee are owners of parallel marks in the UK (§ 63) and (v) the EUTM applicant never challenged, either before the OD or in the appeal against the OD’s decision, the opponent’s entitlement to file the opposition during the administrative proceedings (§ 61). The BoA violated its duty to state reasons in failing to take position on whether proof of the licensee’s entitlement was admissible for the first time on appeal (§ 59, 79-80).

30/06/2021, T-15/20, [Skyliners / Sky et al.](#), EU:T:2021:401, § 47, 50, 53, 59, 61-63, 79-80

### **Lack of reasoning — Contradictory reasoning in the contested decision**

It is apparent from paragraph 97 of the contested decision that the BoA excluded the existence of a likelihood of confusion between the earlier EU word mark HYALISTIL and the mark applied for, finding that the term ‘hyal’ could allude to hyaluronic acid for part of the Italian-speaking relevant public. However, in paragraph 28 of that decision, the BoA had stated that it would focus primarily on the Italian-speaking part of the public which is more prone to confusion, considering that this part of the relevant public would not perceive the term as evoking the concept of hyaluronic acid (§ 24).

The BoA’s reasoning in relation to the existence of a likelihood of confusion is based on contradictory considerations (§ 25-33). The lack of clarity in the contested decision cannot be remedied by the clarifications provided by the Office in its written pleadings (§ 34). The decision is annulled in its entirety on the basis of breach of the obligation to state reasons. The case is referred back to the Office, since the Court cannot substitute its own assessment for that which was worded ambiguously by the BoA regarding the relevant public taken as a reference point in the present case and for all the other assessments based on that assessment (§ 35).

21/12/2021, T-194/21, [HYALOSTEL ONE \(fig.\) / HyalOne \(fig.\) et al.](#), EU:T:2021:934, 24, 25-33, 35

#### **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

### **Decision taken following the annulment of an earlier decision by the GC — Article 72(6) EUTMR — No *res judicata***

In order to comply with a judgment annulling a measure and to implement it fully, the Office is required to adopt a new decision. This decision must have regard not only to the operative part of the judgment, but also to the grounds that led to that ruling and constitute its essential basis, in so far as they are necessary in determining the exact meaning of what is stated in the operative part. It is those grounds that, on one hand, identify the precise provision held to be illegal and, on the other, indicate the specific reasons underlying the finding of illegality contained in the operative part, which the Office must take into account when replacing the annulled measure (10/10/2019, T-536/18, *FITNESS*, EU:T:2019:737, § 34-35 and the case-law cited) (§ 36-37).

In the present case, for the purposes of complying with the annulling judgment, the BoA was required, when re-examining the applicant's arguments regarding the enhanced distinctiveness and the reputation of the earlier mark, to raise the question of whether that reputation could be established on the basis of a trade mark registered in a different form (§ 38-44).

The GC was not itself, pursuant to the powers conferred on it by Article 72 EUTMR, entitled to assess the merits of those arguments. It does not have the power to substitute its own reasoning for that of the BoA or to carry out an assessment on which the BoA has not yet adopted a position (§ 47-48). The question of whether the proprietor of a mark can rely on evidence that proves that its mark has a reputation in a different form had neither been raised nor analysed by the BoA as regards the earlier mark (§ 49-52).

Secondly, when a decision of the BoA is annulled by the GC, the grounds on the basis of which the GC dismissed certain arguments relied upon by the parties cannot be considered to have gained the force of *res judicata* (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, § 53) (§ 51).

In the present case, in paragraphs 108 to 111 of the annulling judgment, the GC rejected the arguments which the opponent had put forward in order to establish that the earlier mark had a reputation in a different form by holding specifically that those arguments had not been assessed during the proceedings before the Office (§ 52). Consequently, the considerations set out in those paragraphs did not, contrary to what the BoA found in paragraph 28 of the contested decision, have the force of *res judicata* and were not in any way final with regard to that BoA (§ 53).

17/11/2021, T-616/20, [THE ONLY ONE by alphaspirt wild and perfect \(fig.\) / ONE](#), EU:T:2021:794, § 36-44, 47-53

### **Power to re-open the examination on absolute grounds — *Res judicata***

Whilst the Office is able to reopen, on its own initiative and at any time prior to registration, the examination of absolute grounds for refusal if it deems it appropriate (§ 47-50), it can only do so in compliance with its obligation to comply with a final decision (that is, the operative part and the reasons that led to it) of the EU judge annulling a previous decision of the BoA on the matter (§ 49-50). The Office's power to examine the facts on its own initiative does not enable it to call

into question matters of fact and of law that have been settled by the EU judge, even when new facts become apparent following the final decision of the court (§ 56-57).

01/09/2021, T-96/20, [Limbic® Types](#), EU:T:2021:527, § 47-50, 56-57

### **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

### **Cancellation of an entry in the register which contains an obvious error attributable to the Office — Trade mark involved in insolvency proceedings — Duty of diligence — Registration of the transfer of the mark — Effects vis-à-vis third parties**

When dealing with a request for recordal of a transfer of an EUTM, the Office's competence is, in principle, confined to examining the formal requirements set out in Article 20 EUTMR and Article 13 EUTMR and does not imply an assessment of substantive issues that may arise under the applicable national law (§ 61). However, the Office must diligently take into account facts that can have legal implications for the application for registration of such a transfer, including the existence of insolvency proceedings (§ 62-65, 68).

The duty of diligence is all the more imperative where, before receiving an application for registration of the transfer of an EUTM, the Office is informed – by an earlier request for recordal which has been submitted in accordance with Article 24(3) EUTMR – that that mark has been involved in insolvency proceedings. In such a case, the Office has to take into consideration the objective of 'guarantee[ing] the effectiveness' of the insolvency proceedings referred to in recital 36 of Regulation 2015/848 on insolvency proceedings, in particular if the existence, validity or particular date of that transfer is disputed by the liquidator. (§ 58, 69).

According to Article 27(1) EUTMR, transfers of an EUTM have effects vis-à-vis third parties only after entry in the EUTM register. Such an entry does not have retroactive effect (§ 64). Furthermore, according to Article 27(4) EUTMR the effects vis-à-vis third parties of insolvency

proceedings are governed by national law (§ 65). Under the applicable Italian law, the insolvency proceedings at issue had the effect of making ineffective the formalities required to ensure that an act by the debtor was enforceable against third parties, since those formalities had been carried out after the declaration of insolvency. Consequently, the Office was required to suspend the registration of those transfers until the national court had examined the substance of the case (§ 72).

The Office made an obvious error within the meaning of Article 103 EUTMR by entering the successive transfers of the mark in the register on 16 April 2018, having failed to enter the insolvency proceedings concerning the proprietor of the mark at issue in the register. The result was that the entries of 16 April 2018 containing the obvious error had to be cancelled as soon as possible (§ 114-117).

22/09/2021, T-169/20, [Marina yachting](#), EU:T:2021:609, § 61, 58, 62-65, 68-69, 72, 114-117

22/09/2021, T-173/20, [Henry Cotton's and Henry Cotton's \(fig.\)](#), EU:T:2021:610, § 62, 59, 63-66, 68-10, 73, 115-118

### **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

### **Reallocation of a case to a BoA following a judgment annulling a decision**

The provision on the basis of which a case should have been reallocated to a BoA following the GC annulment of the BoA decision was Article 1(d) of Commission Regulation No 216/96 and not Article 35(4) of Delegated Regulation 2017/1430 (§ 30). The latter provision does not apply to appeals filed before the BoA before 1 October 2017, which is the case here (§ 31). Accordingly, pursuant to Article 1(d)(1) of Regulation No 216/96, the decision to reallocate a case to a BoA following a judgment annulling a decision was a matter for the Presidium of the BoA and not for the President of the BoA (§ 34).

09/12/2020, T-722/18, [BASIC \(fig.\) / BASIC et al.](#), EU:T:2020:592, § 34

### **Exclusion of a member of the BoA**

A member of the BoA is not excluded from taking part in appeal proceedings pursuant to Article 169(1) EUTMR on the grounds that he participated in taking the previous decision in the appeal which has been subsequently annulled by the GC; the exclusion pursuant to Article 35(4) EUTMDR does not apply where the appeal is referred to the Grand Board of Appeal (§ 29-30).

01/09/2021, T-96/20, [Limbic® Types](#), EU:T:2021:527, § 29-30

## **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

### **Absolute grounds for refusal — Discretion to accept belated evidence in invalidity proceedings — Examination of facts**

In invalidity proceedings concerning absolute grounds for refusal, the BoA cannot accept belated evidence on the grounds of public interest but must ascertain whether the two requirements of Article 27(4) EUTMDR are satisfied (§ 28).

In invalidity proceedings based on an absolute ground for refusal, as the registered EU trade mark is presumed to be valid, it is for the person who has filed the application for a declaration of invalidity to invoke before the Office the specific facts which call the validity of that trade mark into question. Therefore, the second sentence of Article 95(1) EUTMR, which consolidates the Court's previous case-law (13/092013, T-320/10, Castel, EU:T:2013:424, § 28), provides that, in invalidity proceedings pursuant to Article 59 of that regulation, the Office is to limit its examination to the grounds and arguments submitted by the parties (10/06/2020, T-105/19, DEVICE OF A CHEQUERBOARD PATTERN (fig.), EU:T:2020:258, § 23 and the case-law cited) (§ 40).

Although, in invalidity proceedings based on an absolute ground for refusal, the Office is to limit its examination to the grounds and arguments submitted by the parties, that does not, however, preclude the BoA, in its own examination of the facts, arguments and evidence submitted by the applicant for a declaration of invalidity, from reaching a different conclusion from that proposed by the latter. In that regard, it follows from Article 71(1) EUTMR that, through the effect of the appeal brought before it, the BoA may exercise any power within the competence of the department that was responsible for the contested decision and is therefore called upon, in this respect, to conduct a new, full examination as to the merits of the appeal, in terms of both law and fact (§ 42-43).

The BoA was therefore required to carry out an examination which was limited to the grounds and arguments of the parties, without prejudice to the possibility of taking well-known facts into account (§ 44).

02/06/2021, T-854/19; [Montana](#), EU:T:2021:309, § 40, 42-44

02/06/2021, T-855/19; [MONTANA \(fig.\)](#), EU:T:2021:310, § 40, 42-44

02/06/2021, T-856/19; [MONTANA \(fig.\)](#), EU:T:2021:311, § 40, 42-44

### **Opposition proceedings — Limitation of examination in inter partes proceedings**

Where reputation of the earlier mark is claimed by relying on an earlier decision of the Office recognising a specific strength of reputation, the Office's examination is restricted to whether or not that specific strength of reputation has been established (§ 93, 96-99).

19/05/2021, T-510/19, [DEVICE OF A JUMPING ANIMAL \(fig.\) / PUMA \(fig.\) et al.](#), EU:T:2021:281, § 93, 96-99

### **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 — Interpretation by the BoA of the nature of the trade mark — Colour mark — Issue of the nature of the contested mark not raised by the parties — Infringement of Article 95(1) EUTMR — Infringement of the right to be heard**

In the context of a declaration of invalidity, by virtue of the presumption of validity of the registered mark, the Office's obligation under Article 95(1) EUTMR to examine of its own motion the relevant facts which may lead it to apply absolute grounds for refusal is restricted to the examination of the EUTM application carried out by the examiners of the Office and, on appeal, by the BoA during the registration procedure of that mark. As the registered EUTM is presumed to be valid, it is for the person who has filed the application for a declaration of invalidity of that mark to invoke before the Office the specific facts that question the validity of that trade mark (see by analogy, 29/03/2019, T-611/17, REPRESENTATION D'UNE SEMELLE DE CHAUSSURE (3D), EU:T:2019:210, § 45 and the case-law cited) (§ 33).

At the *inter partes* stage of the application for a declaration of invalidity in the present case, the question of the nature of the contested mark was not a matter of fact or of law raised by the parties. Nor did that question concern relevant fact or essential procedural requirements. It was not necessary to resolve it to ensure the correct application of the EUTMR. The BoA had taken the issue of the nature of the contested mark into account and had already decided upon it in the context of the registration procedure (§ 37).

The presumption of validity of the registration cannot prevent the Office, *inter alia* in the light of what was put forward by the party questioning the validity of the contested mark, from relying not only on the arguments and evidence submitted by that party in support of its application for a declaration of invalidity, but also on the well-known facts identified by the Office during the invalidity proceedings (15/10/2020, T-48/19, smart:)things (fig.), EU:T:2020:483, § 69) (§ 38). However, in the present case, no evidence or well-known facts were submitted or relied on before the BoA (§ 39). In interpreting the trade mark application filed on 12 February 1998 of its own motion as relating to a figurative mark composed of a clearly defined contour, the BoA went beyond the pleas and arguments submitted by the parties, in infringement of the last sentence of Article 95(1) EUTMR, read in conjunction with Article 27(2) EUTMDR. In so doing, it exceeded its jurisdiction (§ 40).

The BoA did not question the parties on the issue of the nature of the contested mark which it raised of its own motion. In so doing, it infringed the applicant's right to be heard, within the meaning of Article 94(1) EUTMR and Article 41(2)(a) of the Charter of Fundamental rights (§ 46-52).



15/09/2021, T-274/20, [ORANGE \(fig.\)](#), EU:T:2021:592, § 33, 37-40, 46-52

### **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

### **Absolute grounds of invalidity — Burden of proof**

It is for the party making the application for a declaration of invalidity to rely, before the Office, on the specific elements that might call the validity of the mark into question (§ 59).

08/12/2021, T-294/20, [Kaas keys as a service](#), EU:T:2021:867, § 59

### **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

### **Invalidity proceedings — Article 95(1) EUTMR — Well-known facts**

While the presumption of validity of the registration restricts the Office’s obligation to an examination of the relevant facts, it does not preclude it, particularly in view of the elements put forward by the party challenging the validity of the mark, from relying, not only on those arguments and on any evidence produced by that party in its application for a declaration of invalidity, but also on well-known facts observed by the Office in the context of the invalidity proceedings (§ 128, 134).

### 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

### **Renewal certificate submitted for the first time before the BoA — Discretion to accept belated evidence — Article 27(4) EUTMDR**

The applicant did not dispute that the renewal certificate was relevant to the proceedings and that the purpose of the submission of the renewal certificate was to contest the finding that the Cancellation Division had made of its own motion, namely that the earlier mark no longer existed during the relevant period of time. By agreeing to take the renewal certificate into account on the basis of that justification, the BoA complied with the two cumulative requirements laid down in Article 27(4) EUTMDR and, consequently, exercised its discretion correctly (§ 26-30).

27/10/2021, T-356/20, [Racing Syndicate \(fig.\) / Syndicate](#), EU:T:2021:736, § 26-30

### **Belated evidence — Article 95(2) EUTMR — Article 27(4) EUTMDR — Burden of proof**

It is for the party submitting evidence for the first time before the BoA to explain to what extent that submission satisfies the conditions laid down in Article 27(4) EUTMDR (10/10/2019, T-536/18, FITNESS, EU:T:2019:737, § 42-43) (§ 57-59).

06/10/2021, T-254/20, [DEVICE OF A LOBSTER \(fig.\)](#), EU:T:2021:650, § 57-59

### **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

### **Application *ratione temporis* of substantive rules — Date of filing — Priority date — Date of filing of proof of use**

The filing date of the application is relevant (08/05/2014, C-591/12 P, Bimbo Doughnuts, EU:C:2014:305, § 12; 18/06/2020, C-702/18 P, PRIMART Marek Łukasiewicz (fig.) / PRIMA et al., EU:C:2020:489, § 2). The priority date is the date of filing, according to Article 29(1) and Article 31 CTMR (now Article 34(1) and Article 36 EUTMR), which means that Article 42 CTMR applies. However, Article 10 EUTMDR applies, according to Article 82(2)(d) EUTMDR, since the request for proof of use of the earlier mark was filed after 1 October 2017 (§ 17).

10/11/2021, T-353/20, [ACM 1899 AC MILAN \(fig.\) / Milan et al.](#), EU:T:2021:773, § 17

### **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; 03/09/2020, C-214/19 P, [achtung ! \(fig.\)](#), EU:C:2020:632, § 45

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

22/09/2021, T-250/20, [AIRSCREEN \(fig.\)](#), EU:T:2021:602, § 62-65, 70

### **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

##### **No confirmatory decision in the context of different opposition proceedings**

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

- Seniority

##### **Seniority — Conditions for the admissibility of the seniority claim**

In view of the consequences of claiming seniority of an identical earlier national trade mark under Articles 39 and 40 EUTMR, which derogate from the principle that the proprietor of such a trade mark loses the rights conferred by it in the event of non-renewal of its registration, the conditions under which such a claim may be allowed must be interpreted restrictively (§ 23).

According to the wording of Article 40(1) EUTMR, the identical earlier national trade mark whose seniority is claimed by the proprietor of the EU trade mark must, depending on the language version, be a trade mark 'registered' in a Member State or a trade mark which is 'registered' in a Member State. This wording in the present indicative makes it clear that the identical earlier national trade mark whose seniority is claimed in favour of the EU trade mark must be registered at the time the claim of seniority is made (§ 24-25).

Therefore, the applicant's argument that Article 40 EUTMR, read in conjunction with Article 39 EUTMR, simply requires that the earlier national mark must have been registered at some time in the past to prevent the claim of seniority from being based only on a mark in use, is unfounded (§ 26).

It follows from all of the foregoing that the BoA did not err in law when it interpreted Article 40 EUTMR, read in conjunction with Article 39 EUTMR, as meaning that the identical earlier national trade mark whose seniority is claimed in favour of a subsequently registered EU trade mark must itself be registered and in force at the time the application for seniority is made (§ 40).

06/10/2021, T-32/21, [Muresko](#), EU:T:2021:643, § 23-26, 40

- 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*

#### **Licensee's entitlement to file the opposition — Proof of entitlement — Belated evidence in the proceedings before the BoA — Lack of reasoning**

Proof of the licensee's entitlement to file an opposition must be submitted during the substantiation period (§ 47). The proprietor's authorisation cannot be presumed from the mere

existence and registration of a licence if this licensee (exclusive or not) does not explicitly address the licensee's right to file oppositions (§ 50). On the facts of the case, such proof could not be deduced from the following circumstances: (i) the proprietor of the earlier EU marks and the opponent are members of the same group of companies and are economically linked (§ 53, 62); (ii) the two companies have the same representative before the Office; (iii) the application to register the licence was submitted through that common representative, who also filed the opposition; (iv) the EUTM proprietor and its licensee are owners of parallel marks in the UK (§ 63) and (v) the EUTM applicant never challenged, either before the OD or in the appeal against the OD's decision, the opponent's entitlement to file the opposition during the administrative proceedings (§ 61). The BoA violated its duty to state reasons in failing to take position on whether proof of the licensee's entitlement was admissible for the first time on appeal (§ 59, 79-80).

30/06/2021, T-15/20, [Skyliners / Sky et al.](#), EU:T:2021:401, § 47, 50, 53, 59, 61-63, 79-80

- [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**

- [Invalidity 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

#### **Invalidity proceedings — Relevant date for the assessment of the descriptiveness of the sign — Conditions for consideration of subsequent evidence**

The date on which the application for registration of the mark was filed is the relevant date for the assessment of the descriptiveness of the sign. However, evidence subsequent to the date on which the contested mark was filed can be taken into consideration when it enables conclusions to be drawn about the situation as it was on that date. In the present case, the evidence, such as

extracts from Wikipedia refers to articles dating from the relevant time and some of the additional evidence predates the filing date, enabled the BoA to confirm the assessment in the first instance on the basis of evidence subsequent to the filing date. The BoA did not base its reasoning on assumptions or estimations, but made relevant assessments of the descriptiveness of the sign 'HYAL' as it was on the date of filing (§ 57-62, 74).

16/06/2021, T-215/20, [HYAL](#), EU:T:2021:371, § 57-62

### **Determination of the grounds of an application for a declaration of invalidity in light of the statement of reasons**

In order to determine the grounds on which an application for a declaration of invalidity is based, it is necessary to examine all of the application, especially in light of the detailed statement of reasons in support of it (18/03/2016, T-501/13, WINNETOU, EU:T:2016:166, § 26) (§ 27).

09/12/2020, T-30/20, [Promed](#), EU:T:2020:599, § 27

- **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 — Invalidity 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**

### **Community design — Invalidity of the design and maintaining it in an amended form**

The possibility of maintaining the registration of the design in an amended form according to Article 25(6) CDR is an alternative to invalidating the design in its entirety. This ensures the proportionality of the sanction (§ 39-40).



25/10/2021, T-329/20, [Pendenti](#), EU:T:2021:732, 39-40

## **Evidence — Translation into the language of proceedings**

Article 29(5) CDIR provides that '[w]here the evidence in support of the application is not filed in the language of the invalidity proceedings, the applicant shall file a translation of that evidence into that language within two months of the filing of such evidence.' It follows that the Office is not required to take into account untranslated evidence. Similarly, it follows from Article 31(2) CDIR, according to which '[i]f the holder files no observations, the Office may base its decision concerning invalidity on the evidence before it', that the Office was not required to request a translation of its own motion in the present case (§ 45).

*07/07/2021, T-492/20, [Leuchten](#), EU:T:2021:413, § 45*

## CHAPTER II — ABSOLUTE GROUNDS FOR REFUSAL / INVALIDITY

### 1 ARTICLE 7 EUTMR — GENERAL PRINCIPLES

#### **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

#### **Colour mark — Sufficiently clear and precise graphic representation — Requirement for a 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).



29/07/2019, C-124/18P, [Blue and Silver \(COLOUR MARK\)](#), EU:C:2019:641, § 36-37, 38, 47-48

#### **Colour mark — Sufficiently clear and precise graphic representation — Requirement for a systematic arrangement associating the colours in a predetermined and uniform way**

The juxtaposition of two colours, without shape or contours, does not amount to claiming protection of such colours 'in every conceivable form', where the description makes it clear that the combination of colours follows a predetermined arrangement, such as a vertical partition of the colours on the housing of chainsaws divided into one upper and one lower part (§ 37-39).



24/03/2021, T-193/18, [GREY AND ORANGE \(col.\)](#), EU:T:2021:163, 37-39

### **Three-dimensional mark — Conditions for registration — Sufficiently clear and precise graphic representation — Obligation to align the description with the representation**

The representation of the mark as filed defines its scope of protection, and not the description of the mark provided by the applicant. This description must define what can be seen in the mark's representation. The scope of protection is also not broadened by a possible interpretation of what the applicant meant by that representation or what it had in mind (§ 112).



23/09/2020, T-796/16, [Grass in bottle / Bottle with strand of grass et al.](#), EU:T:2020:439, § 112

### **Relation between Article 7(1)(a) EUTMR and 7(1)(b) EUTMR — Adverse effect of the BoA decision — Admissibility of an action or of a cross-claim**

Where an application for a declaration of invalidity is based on the fact that the sign at issue has been registered contrary to the provisions of Article 7(1)(a) EUTMR or the provisions of Article 7(1)(b) EUTMR, it is essential to examine the first of these grounds before assessing, where appropriate, whether the mark has inherent distinctive character or whether it has acquired distinctive character through use (§ 44-48).

The invalidity applicant is adversely affected by the BoA's decision which upheld the invalidity request on the basis of Article 7(1)(b) EUTMR and remitted the case to the Cancellation Division for the assessment of Article 7(3) EUTMR, but which did not examine Article 7(1)(a) EUTMR, which was also invoked by the invalidity applicant (§ 54).

In light of the relationship between Article 4 and Article 7(1)(a) EUTMR, and of Article 7(1)(b) thereof, the Grand Board of Appeal could not dispense with the examination of the ground for invalidity under Article 7(1)(a) EUTMR and refer the case back to the Cancellation Division to decide on the possible acquisition of distinctive character by the mark following the use which has been made of it, in accordance with Article 7(3) and Article 52(2) EUTMR (§ 69).

06/10/2021, T-124/20; [DEVICE OF A REPEATED GEOMETRIC DESIGN \(fig.\)](#), EU:T:2021:668, § 44-48, 54, 69

## **2 ARTICLES 7(1)(b), 59(1)(a) EUTMR — DISTINCTIVE CHARACTER**

### **2.1 ASSESSMENT OF 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-independent examination of lack of distinctive character**

Descriptive signs within the meaning of Article 7(1)(c) EUTMR are also devoid of distinctive character (§ 68). However, this cannot be extrapolated by analogy to the application of Article 7(1)(b) EUTMR where the distinctive character is called into question for reasons other than its descriptive character (§ 68). By basing the finding of a lack of distinctiveness upon the premise of the descriptive character of the mark applied for, the Grand Board of Appeal did not examine Article 7(1)(b) EUTMR independently, and consequently failed to take into account the general interest that this absolute ground of refusal seeks to protect (§ 77).

01/09/2021, T-96/20, [Limbic® Types](#), EU:T:2021:527, § 68, 77

### **Non-distinctive — Assessment of distinctive character — Consideration of all likely types of use of the sign — Inapplicability of the Doublemint principle to Article 7(1)(b) EUTMR**

The assessment of the distinctive character of a sign cannot be carried out by simply taking into account the most probable use of that sign. Instead, it should take into account all the likely types of use of the mark applied for, that is, those types which can be practically significant (12/09/2019, C-541/18 P, #darferdas?, EU:C:2019:725, § 33) (§ 29).

The reasoning stated in case-law that a sign is regarded as being descriptive pursuant to Article 7(1)(c) EUTMR if at least one of its possible meanings designates a characteristic of the goods or services concerned (23/10/2003, C-191/01 P, Doublemint, EU:C:2003:579, § 30, 32) is not transposable by analogy to the application of Article 7(1)(b) EUTMR (§ 35).

**achtung**<sup>ii</sup> 03/09/2020, C-214/19 P, [achtung ! \(fig.\)](#), EU:C:2020:632, § 29, 35

### **Assessment of distinctive character — Delimitation of Article 7(1)(b) EUTMR and Article 7(1)(c) EUTMR**

The ambiguity of the sign is a relevant factor which must be taken into account in the context of Article 7(1)(b) EUTMR. The case-law according to which a sign is to be classified as descriptive within the meaning of Article 7(1)(c) EUTMR where at least one of its potential meanings designates a characteristic of the goods concerned is not applicable by analogy in the context of Article 7(1)(b) EUTMR where the distinctive character of the sign is called into question for reasons other than its descriptive character (03/09/2020, C-214/19 P, [achtung!](#), EU:C:2020:632, § 35) (§ 37).

In the absence of the establishment of the descriptive character of the sign and a sufficiently direct and specific link between the sign and the goods (in the sense of 'a tube remaining cold or cool') the applicant may rely on the argument as to its ambiguity (namely that the relevant public may also perceive the sign as an indication of a 'negligent' or 'pleasant' tube). The BoA was wrong to find that the sign lacked the minimum degree of distinctive character according to Article 7(1)(b) EUTMR without having established the descriptive character of the mark applied for (§ 36, 41).

16/06/2021, T-481/20, [Cooltube](#), EU:T:2021:373, § 36-37, 41

**Non-distinctive — Figurative mark used as logo attached to textiles — Distinctive character of the mark to be assessed as it was filed not as it is used**

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 — Mere promotional and laudatory message — Figurative mark used as logo attached to textiles — Irrelevance of the particular use of the sign**

The collocation of the capital letter 'I', which corresponds to the English personal pronoun of the first person in the singular, and a heart, which is commonly used as a symbol of the verb 'love', form a simple, clear and unambiguous idiomatic expression meaning 'I love' (not disputed). The relevant public will perceive the contested mark immediately and exclusively as a laudatory advertising message, which expresses a preference or affection for the goods (§ 62). The evidence submitted by the invalidity applicant demonstrates a widespread use of the sign throughout the EU in diverse formulae and combinations at the time of the application (§ 55-56, 63). Consequently, the contested trade mark is neither striking nor original, requiring at least some interpretation or the setting-off of a cognitive process in the minds of the public. The relevant public does not perceive the sign beyond its obvious advertising message or as an indication of the commercial origin of the goods (§ 63-64).

The fact that the contested trade mark is affixed to the goods as a logo or in accordance with the identification practices of the clothing sector does not invalidate this finding (§ 88). The mark must be assessed as it was filed, not as it is used (§ 90). 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. It is therefore not possible to assess the distinctive character of the contested trade mark in relation to a particular use (03/12/2019, T-658/18, DEVICE OF A CHECKERED GINGHAM PATTERN (fig.), EU:T:2019:830, § 36) (§ 90).



12/02/2021, T-19/20, [I love \(fig.\)](#), EU:T:2021:17, § 55-56, 62-64, 88, 90

**Non-distinctive — Assessment of distinctive character — Mere promotional and laudatory message — Impact of particular method of use — Applicant's burden of proof**

A sign which is immediately and without further reflection understood by the relevant public as a typical clear and unambiguous promotional message for the goods and services applied for (§ 34) is devoid of distinctive character (§ 34, 50). Where the EUTM applicant contests such a finding made by the Office, it has to show that the sign will be interpreted differently and perceived by the public to have a different meaning (§ 40, 47).

The affixing of the sign to the goods according to the relevant and significant customs of the sector concerned does not automatically lead the public to perceive that sign as an indicator of business origin (§ 56). The EUTM applicant has to show why a particular method of affixing the sign on the goods would significantly alter the meaning and perception of the sign applied for (§ 55).

### **Non-distinctive — Specific link between the meaning of the sign and the characteristics of the goods — Descriptive of one of the characteristics of the designated goods**

The English-speaking public of the EU (general consumers and professionals in the construction sector) perceives the sign 'MaxWear' as a combination of the terms 'max' and 'wear'. The element 'max' is understood as an abbreviation of the word 'maximum' and the element 'wear' as meaning, inter alia, 'deterioration through use' or 'sustainability during use' (§ 26, 31). The sign is devoid of distinctive character due to the fact that it is perceived, by a non-negligible part of the relevant public, as being descriptive of one of the characteristics of the designated goods (floors and flooring material), namely their durability in use (§ 28-29, 31).

10/03/2021, T-99/20, [MaxWear](#), EU:T:2021:120, § 26, 28-29, 31

### **Minimum degree of distinctive character — Not Descriptive**

Since a thought process involving a number of steps is necessary to establish a link between the sign **Wave** and the expressions 'wave effects' and 'wavelength' used in the market sector of aquariums, the sign **Wave** cannot be considered descriptive of a characteristic of *aquarium lights* in Class 11 (§ 26-28). Therefore, the sign **Wave** is capable of indicating the commercial origin of the goods and is not devoid of a minimum degree of distinctiveness (§ 29).

23/09/2020, T-869/19, [Wave](#), EU:T:2020:447, § 29

### **Minimum degree of distinctive character — Not descriptive — No customary nature**

The English word 'body' means 'the complete physical form of a person or animal' and the English word 'secrets' means something which is 'kept from knowledge or observation' (§ 62). In their usual meaning, those words are not laudatory (they do not refer to superior quality) (§ 63). The evidence adduced in support of the application for a declaration of invalidity does not demonstrate a direct link between the expression 'body secrets' and the goods at the time when the application for registration of the contested mark was filed. Accordingly, the expression 'body secrets' will not be perceived by the relevant English-speaking public as a promotional formula (§ 23-24, 46-51, 64).

As the legality of BoA decisions must be assessed solely on the basis of the EUTMR and, in its review of legality, the Court is not bound by the decision-making practice of the Office, the applicant's argument that the Court ought to take into account the Office's decision concerning the application for registration of the sign 'BEAUTY SECRETS' cannot succeed. In any event, the expressions 'beauty secrets' and 'body secrets' do not have the same marketing value and are not interchangeable expressions, insofar as, when faced with goods bearing the mark 'BODYSECRETS', a consumer will not be attracted by the suggestion that those goods will be special and capable of producing enhancing effects rarely found in other products on the market (§ 32, 66-67).

The reference to the words 'body secrets', always used in conjunction with other words in the titles of magazine articles adduced by the invalidity applicant as evidence, does not lead to the conclusion that, when confronted with the contested mark, the relevant public would perceive it immediately and without further thought as a description of the goods covered by it or of one of the goods' characteristics (§ 77-83).

The customary nature of the expression 'body secrets' for beauty, cosmetic and fashion products was not established at the time of the filing (§ 91-92).

### **Non-distinctive — Applicant’s burden of proof for intrinsic distinctive character**

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 — Assessment of distinctive character — Probative value of web pages**

The evidence submitted by the applicant relating to the geographical distribution of the audiences of the websites mentioned by the examiner, as well as post-dating the filing date of the application for registration, does not make it possible to draw conclusions about the relevant public, namely English-speaking professionals and the English-speaking general public in the EU. This is because, as the applicant states itself, no indication of the number of visitors to each site is given (§ 54).

13/10/2021, T-523/20, [Blockchain Island](#), ECLI:EU:T:2021:691, § 54

### **Non-distinctive — Assessment of distinctive character — Irrelevance of circumstances outside of the right conferred by the trade mark**

Circumstances outside of the right conferred by the EU trade mark, such as the price of the products for which the mark is applied, are not subject to registration and consequently cannot be taken into account in the course of the assessment of the distinctive character of a mark (12/09/2007, T-358/04, Mikrophon, EU:T:2007:263, § 34 and case-law cited) (§ 34).



09/09/2020, T-81/20, [Darstellung eines Rechtecks mit drei farbigen Segmenten \(fig.\)](#), EU:T:2020:403, § 34

### **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

### **Name of a historical building — Assessment of distinctive character**

The names of historical buildings or museums are not, in principle, excluded from signs that may constitute an EUTM (§ 20). The distinctiveness of such a mark does not depend upon whether or not the EUTM applicant owns that historical building (§ 39). A sign does not need to be fanciful to possess a minimum degree of distinctive character (§ 40). In principle, the public can perceive in a sign consisting of a name of a known historical building at the same time a reference to that

building and an indication of the commercial origin of the designated goods (§ 42). The goods' place of sale does not, as such, designate specific characteristics, qualities or features of those goods (§ 27). The goods' possible souvenir function is not an objective characteristic inherent in the nature of the product (§ 28).

24/03/2021, T-93/20, [Windsor-Castle](#), EU:T:2021:164

## 2.2 RELEVANT PUBLIC AND LEVEL OF ATTENTION

### Distinctiveness threshold — 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 (§ 14).

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

### Distinctiveness threshold — Relevant 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

### Distinctiveness threshold — Relevant public's level of attention

Neither the relevant public's level of attention nor the fact that the relevant public is a specialist one is decisive for assessing whether a sign has distinctive character. Although it is true that the level of attention of the specialist public is, by definition, higher than that of the general public, it does not necessarily follow that a weaker distinctive character of a sign is sufficient where the relevant public is a specialist one (§ 28).

13/10/2021, T-523/20, [Blockchain Island](#), ECLI:EU:T:2021:691, § 28

### English-speaking part of the EU — Not exclusively countries with English as their official language

The English-speaking part of the EU does not only consist of the countries in which English is an official language, but also of those in which, at the very least, English is widely understood, which includes, in particular, Denmark, the Netherlands, Finland and Sweden (§ 35).

The mark applied for therefore conveys a message which is capable of setting off a cognitive process in the minds of the relevant public making it easy to remember and which is consequently capable of distinguishing the applicant's goods from goods which have another commercial origin (§ 46).

20/01/2021, T-253/20, [It's like milk but made for humans](#), EU:T:2021:21, § 35, 46

## 2.3 (LACK OF) DISTINCTIVE CHARACTER OF THE SIGN IN QUESTION

### 2.3.1 Word signs

#### 2.3.1.1 Titles of books

[No key points available yet.]

#### 2.3.1.2 Single letters

[No key points available yet.]

#### 2.3.1.3 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

#### 2.3.1.4 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

#### 2.3.1.5 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).

13/05/2020, T-49/19, [Create delightful human environments](#), EU:T:2020:197, § 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

#### **2.3.1.6 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 word signs 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

### **Non-distinctive word signs**

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

25/06/2020, T-380/19, [Serviceplan solutions](#), EU:T:2020:285

23/09/2020, T-36/19, [ElitePartner](#), EU:T:2020:425

10/02/2020, T-341/20, [Radioshuttle](#), EU:T:2021:72

## **2.3.2 Figurative marks**

### **2.3.2.1 Commonplace figurative elements**

#### **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).



99-100

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

### 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, [get smarter \(fig.\)](#), 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 figurative signs

 10/10/2019, T-832/17, [achtung! \(fig.\)](#), EU:T:2019:2; 03/09/2020, C-214/19 P, [achtung ! \(fig.\)](#), EU:C:2020:632

 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

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

 25/11/2020, T-882/19, [ΑΠΛΑ! \(fig.\)](#), EU:T:2020:558

### 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



23/09/2020, T-522/19, [BBQ BARBECUE SEASON \(fig.\)](#), EU:T:2020:443

 22/10/2020, T-833/19, [DARSTELLUNG EINER GEOMETRISCHEN FIGUR \(fig.\)](#), EU:T:2020:509

 30/06/2021, T-290/20, [Goclean \(fig.\)](#), EU:T:2021:405

 Cash App 20/10/2021, T-210/20, [\\$ Cash App \(fig.\)](#), EU:T:2021:711

 Cash App 20/10/2021, T-211/20, [\\$ Cash App \(fig.\)](#), EU:T:2021:712

### 2.3.2.2 Typographical symbols

#### Non-distinctive — Symbols of the euro and of the dollar

The symbols of the euro and of the dollar, two well-known currencies within the EU, will be easily perceived by the relevant public in the mark applied for. Nothing distinguishes these symbols from the way in which they are generally used in commerce, the graphic elements of the signs are merely decorative (§ 112).

 16/12/2020, T-665/19, [€\\$\(fig.\)](#), EU:T:2020:631, § 112

### 2.3.2.3 Pictograms

#### Non-distinctive

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

### 2.3.3 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

### **Non-distinctive — Packaging of liquid goods — Sole use of the shape**

Since liquid goods must, out of necessity, be packaged for sale, the average consumer will perceive the packaging first and foremost simply as a type of container. A three-dimensional trade mark consisting of such a container is not distinctive unless it permits the average consumer of the goods concerned, who is reasonably well informed and reasonably observant and circumspect, to distinguish those goods from the goods of other undertakings without any detailed examination or comparison and without being required to pay particular attention (§ 65).

The fact claimed by the applicant, that it was the only company producing the packaging as in the EUTM applied for, does not necessary lead to a conclusion that this packaging was distinctive (§ 67).



08/09/2021, T-489/20, [FORM EINES KUGELFÖRMIGEN BEHÄLTERS \(3D\)](#), ECLI:EU:T:2021:547, § 65, 67

### **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

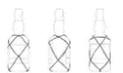
target the same consumers (§ 20-22, 50, 53-54). The mark is devoid of distinctive character for *bottles*, regardless of whether they are filled with content or empty (§ 20-22, 56-58).



24/09/2019, T-68/18, [FORM EINER FLASCHE \(3D\)](#), EU:T:2019:677, § 20-22, 40, 43-44, 50, 56-58

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

Novelty and originality are not relevant criteria in assessing the distinctive character of a trade mark. A trade mark must differ substantially from the basic forms of the product in question commonly used in trade. Furthermore, it cannot be a mere variant, or even a possible variant, of those forms. In this regard, there is no need to provide evidence of the usual character of the form used in trade in order to demonstrate the lack of distinctive character of the mark (07/10/2015, T-244/14, Shape of a face in the form of a star (3D), EU:T:2015:764, § 38 and the case-law cited therein; see, to that effect, 28/06/2019, T-340/18, SHAPE OF A FLYING V GUITAR (3D), EU:T:2019:455, § 39) (§ 39).

The presence on the market of a considerable number of shapes encountered by consumers makes it unlikely that they will regard a particular shape as belonging to a specific manufacturer rather than being just one of the variety of shapes characterising the market. The broad range of shapes with an original or fanciful appearance already present on the market limits the likelihood of a particular shape being considered as departing significantly from the prevailing norms on that market and, therefore, from being identified by consumers solely on the basis of its specificity or its originality (28/06/2019, T-340/18, SHAPE OF A FLYING V GUITAR (3D), EU:T:2019:455, § 36) (§ 40).

On the basis of relevant case law, to assess the distinctive character of a three-dimensional mark consisting of the shape of the product itself or its packaging, it is necessary to verify whether the mark differs significantly from the norm or uses in the sector concerned (12/12/2019, C-783/18 P, FORM EINER FLASCHE (3D), EU:C:2019:1073, § 24, 26 and 30) (§ 47).



25/11/2020, T-862/19, [Forme d'une bouteille \(3D\)](#), EU:T:2020:561, § 39-40, 47

## **Distinctive character — Three-dimensional EU trade mark consisting in the shape of the product itself — Criteria for assessment — Norm or customs of the sector**

The assessment of distinctive character is not based on the originality or the lack of use of the mark applied for in the field to which the goods and services concerned belong (§ 40). A three-dimensional mark consisting in the shape of the product must necessarily depart significantly from the norm or customs of the sector concerned. Accordingly, the mere novelty of that shape is not sufficient to conclude that there is distinctiveness. However, the fact that a sector is characterised by a wide variety of product shapes does not mean that a new possible shape will necessarily be perceived as one of them (§ 41). The fact that goods have a high-quality design does not necessarily mean that a mark consisting in the three-dimensional shape of those goods makes it possible for them to be distinguished from the goods of other undertakings (§ 42). Taking into account the aesthetic aspect of the mark applied for does not amount to an assessment of the attractiveness of the product in question, but aims to determine whether that product is capable of generating an objective and uncommon visual effect in the perception of the relevant public (§ 43-44).

Considering the norm and customs of the sector concerned, the shape in question is uncommon for a lipstick and differs from any other shape existing on the market, most of which represent cylindrical and parallelepiped lipsticks (§ 49). The fact that a sector is characterised by a wide variety of product forms does not imply that a possible new form will necessarily be perceived as one of them (§ 50). The shape is reminiscent of that of a boat hull or a baby carriage (§ 52). The presence of the small oval embossed shape is unusual and contributes to the uncommon appearance of the mark applied for (§ 53-55). The fact that the lipstick represented by the mark cannot be placed upright reinforces the uncommon visual aspect of its shape (§ 56). Consequently, the relevant public will be surprised by this easily memorable shape and will perceive it as departing significantly from the norm and customs of the lipstick sector and capable of indicating the origin of the goods concerned. Accordingly, the mark applied for has distinctive character (§ 57).



14/07/2021, T-488/20, [FORME D'UN ROUGE À LÈVRE OBLONGUE, CONIQUE ET CYLINDRIQUE \(3D\)](#), EU:T:2021:443, § 34-44, 57

### **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

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

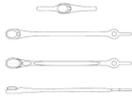


26/03/2020, T-572/19, [FORM EINES KÄSESTRANGS \(3D\) II](#), EU:T:2020:129, § 16, 21, 22, 29,

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 RÉCIPENT DORÉ AVEC UNE SORTE DE VAGUE \(3D\)](#), EU:T:2020:138, § 28

### Non-distinctive

The trade mark applied for does not depart significantly from the norms or customs of the sector (i.e. the market for double-walled cups in Class 21). The common heart form is not distinctive as it merely stands for strong, positive emotions in a general laudatory sense (§ 23-31, 35, 40). With respect to drinks in Classes 30 and 32, a cup is a necessary tool for storage and/or proper consumption. The trade mark applied for is just an insignificant variant of common double-walled cups used for drinks. It is devoid of distinctive character (§ 31, 36-40). The evidence submitted to prove that the trade mark had acquired distinctive character through use is insufficient (§ 52-54).



17/11/2021, T-658/20, [FORM EINER TASSE \(3D\)](#), EU:T:2021:795, § 23-31, 35, 40, 52-54

### 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).



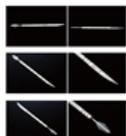
05/02/2020, T-331/19, [REPRÉSENTATION D'UNE TÊTE DE LION ENCERCLÉE PAR DES ANNEAUX FORMANT UNE CHAÎNE \(fig.\)](#), EU:T:2020:33, § 45



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

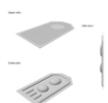
## Non-distinctive

The three-dimensional mark is devoid of distinctive character since, in the perception of the general and specialised public of the EU with an average level of attention, the sign showing a low-price everyday product does not differ significantly from the norms and customs in the sector (§ 49-51, 59).



30/06/2021, T-624/19, [FORM EINES HANDGRIFFS MIT BORSTEN \(3D\)](#), EU:T:2021:393, § 49-51, 59

## Non-distinctive



16/12/2020, T-118/20, [FORM EINER VERPACKUNGSFORM \(3D\)](#), EU:T:2020:604

### 2.3.4 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

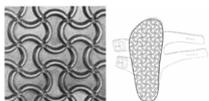
#### Non-distinctive — Three-dimensional position mark

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

## Non-distinctive — Position mark



02/06/2021, T-365/20, [FORM EINES MUSTERS EINER SCHUHSOEHLE \(3D\)](#),  
EU:T:2021:319

### 2.3.5 Pattern marks

[No key points available yet.]

### 2.3.6 Colour marks

#### 2.3.6.1 Single colours

#### Non-distinctive — Colour marks — Colour per se

In the case of a colour per se, distinctive character without any prior use is inconceivable except in exceptional circumstances, and particularly where the number of goods or services is very restricted and the relevant market very specific (21/10/2004, C-447/02 P, shade of orange, EU:C:2004:649, § 79) (§ 51).



09/09/2020, T-187/19, [Colour Purple -2587C \(col\)](#), EU:T:2020:405, § 51

#### 2.3.6.2 Colour combinations

[No key points available yet.]

### 2.3.7 Sound marks

#### Assessment of distinctive character — Sound mark — Criteria

A sound must have ‘a certain resonance’ (13/09/2016, T-408/15, SON D’UN JINGLE SONORE PLIM PLIM (sound mark), EU:T:2016:468, § 45) enabling the target consumer to perceive and consider it as a mark (§ 24). Such resonance is lacking where the sound is perceived as a functional element of the goods and services applied for (§ 24, § 41) or as an indicator without any intrinsic characteristic of its own (§ 24), for example, due to its excessive simplicity or banality (§ 27).

The target consumer must, by the mere perception of the sound mark alone – that is without its combination with other elements – be able to link the goods or services to their commercial origin (§ 25). Marketing habits in the economic sector can evolve in a very dynamic way, including as regards the use of sound marks (§ 26).

The requirement that a sign ‘departs significantly from the norm or customs of the sector’ established by case-law (07/10/2004, C-136/02 P, Torches, EU:C:2004:592, § 31) for assessing the consumer’s perception of marks consisting of the shape or the packaging of the products applied for does not apply to sound marks (§ 32).

The first element of the mark – the sound of opening a can – is perceived by the relevant consumer as purely technical and functional, as it is intrinsic to a specific technical solution for handling and consuming the beverages applied for (§ 40). Its second sound element – the sound

of fizzing bubbles – is perceived as referring to the drinks applied for (§ 42). Perceived in its entirety, the mark is not distinctive (§ 43, 48). This is so despite the silence of ten seconds between the two sound elements and the length (nine seconds) of the second sound element. Such nuances of the classic sounds made by drinks when their container is opened are perceived as mere variants of the usual sounds (§ 45). They are not sufficiently resonant to distinguish them from comparable sounds (§ 46). The mere fact that the sound of fizzing bubbles is usually shorter and follows immediately the sound of opening a can does not confer any significance on the sounds allowing the relevant consumer to identify them as indicator of business origin of the goods (§ 47). The combination of the sound elements and the silent element is not unusual in its structure. Rather, these elements correspond, as they are predictable and common on the drinks market (§ 48).

*07/07/2021, T-668/19, [KLANG EINES GERÄUSCHES, WELCHES MAN BEIM ÖFFNEN EINER GETRÄNKEDOSE HÖRT](#), EU:T:2021:420, § 24-27, 32, 41-43, 45-48*

### 2.3.8 Motion, multimedia and hologram marks

[No key points available yet.]

## 3 ARTICLES 7(1)(c), 59(1)(a) EUTMR — DESCRIPTIVE TRADE MARKS

### 3.1 ASSESSMENT CRITERIA

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

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*

#### **Assessment of descriptive character — 'Characteristic' under Article 7(1)(c) EUTMR**

A characteristic, within the meaning of Article 7(1)(c) EUTMR, must be objective and inherent to the nature of the product or service, as well as intrinsic and permanent for that product or service (07/05/2019, T-423/18, *vita*, EU:T:2019:291, § 44 and case law cited) (§ 42).

*26/02/2021, T-809/19, [EL CLASICO](#), EU:T:2021:100, § 42*

#### **Assessment of descriptive character — Possible characteristics referred to in Article 7(1)(c) EUTMR — Taste or flavour of goods — Colour of a product**

A trade mark which contains elements capable of referring to the taste or flavour of goods may be regarded as descriptive (18/01/2017, T-64/16, *Tasty Puff (fig.)*, EU:T:2017:13, § 35 (§ 48).

The colour of a product may be one of the characteristics referred to in Article 7(1)(c) EUTMR, that colour constitutes a characteristic which is objective and inherent to the nature of that product, as well as being intrinsic and permanent for that product (25/06/2020, T-133/19, *OFF-WHITE (fig.)*, EU:T:2020:293, § 43) (§ 58).

*09/06/2021, T-130/20, [SIENNA SELECTION](#), ECLI:EU:T:2021:341, § 48, 58*

## Assessment of descriptiveness of a sign with several elements — Reference to online databases as evidence

References to online databases (e.g. Wikipedia), in order to demonstrate the descriptiveness of a sign, can only be accepted if they have confirmatory value and simply corroborate information from other sources, such as scientific studies, extracts from technical publications, press articles, and statements from professionals, traders and consumers (25/09/2018, T-180/17, EM, EU:T:2018:591, § 79) (§ 38).

The descriptiveness of a trade mark which consists of several elements may be assessed, in part, for each of those elements taken separately, but must also be established for the whole that they comprise (19/12/2019, T-69/19, *Bad Reichenhaller Alpensaline (fig.)*, EU:T:2019:895, § 22) (§ 43).



23/09/2020, T-738/19, *Wi-Fi Powered by The Cloud (fig.)*, EU:T:2020:441, § 38, 43

## Descriptive — Assessment of descriptiveness — Irrelevant criteria for the assessment

The sign is descriptive, since it will be directly understood by English-speaking consumers as ‘extreme sun protection’ or ‘intensive high-quality sun protection’, corresponding to the purpose and effect of products for sun protection (§ 29-33, 47). For the assessment of descriptiveness it is irrelevant (i) whether the component ‘ULTRA’ may be perceived otherwise than ‘extreme’, (ii) whether the mark may have additional alternative meanings, (iii) whether the mark may be also perceived as a fanciful combination of word elements or (iv) whether the mark is currently in actual use as a descriptor (§ 32).

25/02/2021, T-437/20, *Ultrasun*, EU:T:2021:109, § 29-33, 47

## Criteria for assessment of descriptive and non-distinctive character — Irrelevance of prior use as a trade mark

Article 7(1)(b) and (c) CTMR [now EUTMR] relate solely to the intrinsic characteristics of a sign for which registration is sought. It is only in the context of the application of Article 7(3) CTMR [now Article 7(3) EUTMR] that the actual use of a sign for which registration is sought must be assessed. This provision allows the registration of a sign which is not originally distinctive but which has acquired distinctive character in respect of the goods or services for which registration is sought by virtue of the use made of it (§ 44).

The argument that the term ‘mastihacare’ is perceived by the Greek-speaking consumer as a distinctive sign enabling the goods bearing it to be identified as originating from the applicant, thus fulfilling the function of origin indicator of the mark applied for, must be rejected (§ 43). Similarly, the fact put forward by the applicant that the Greek authorities granted the applicant the exclusive right to exploit ‘mastiha’ and its products is not relevant to the assessment of the descriptive character of the mark applied for nor its intrinsic distinctive character. Such a circumstance has no bearing on the perception and understanding by the relevant public of the term ‘mastihacare’ with regard to the goods (§ 45). The possibility that the Greek-speaking public may recognise the terms ‘mastiha’ or ‘mastihacare’ as distinguishing the applicant’s own goods cannot, in this case, preclude the application of the absolute grounds for refusal laid down in Article 7(1)(b) and (c) CTMR [now EUTMR], as this perception of the mark applied for can be taken into account only in the context of the application of Article 7(3) of that regulation (§ 46).

29/09/2021, T-60/20, *Mastihacare*, EU:T:2021:629, § 44-46

## 3.2 RELEVANT PUBLIC AND LEVEL OF ATTENTION / RELEVANT TRADE CIRCLES

### Specialist public — No decisive influence the assessment of the descriptiveness

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).

18/06/2020, C-142/19 P, [PLOMBIR](#), EU:C:2020:487, § 41-43, 68-74

## 3.3 DESCRIPTIVE CHARACTER IF THE SIGN IN QUESTION: EXAMPLES

### 3.3.1 Word marks

#### 3.3.1.1 One word

##### 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 word marks (one word)

30/01/2019, T-256/18, [SCHUTZ](#), EU:T:2019:38  
31/01/2019, T-97/18, [STREAMS](#), EU:T:2019:43  
29/01/2020, T-42/19, [CROSS](#), EU:T:2020:15  
02/12/2020, T-26/20, [Forex](#), EU:T:2020:583  
28/04/2021, T-872/16, [REPOWER](#), EU:T:2021:230  
21/04/2021, T-282/20, [Apo](#), EU:T:2021:212  
28/04/2021, T-348/20, [Gewürzsommelier](#), EU:T:2021:228  
16/06/2021, T-215/20, [HYAL](#), EU:T:2021:371

14/07/2021, T-622/20, [Cachet](#), EU:T:2021:446  
15/12/2021, T-205/21, [Liftbot](#), EU:T:2021:953

### 3.3.1.2 Several words or word elements

#### **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

#### **Descriptive — Word mark composed of two word elements**

The English-speaking public, including end consumers in the general public, will perceive the combination of the two nouns 'Lightyoga' as designating a yoga style featuring characteristics of light (§ 46-48, 51-52, 56). The fact that the term could also be understood as 'a light form of yoga' is irrelevant, as one descriptive meaning is sufficient (§ 54-55). The trade mark applied for directly describes the subject, function, use or intended purpose in relation to a wide variety of goods and services in Classes 9, 16, 25 and 41 (§ 59-72).

10/02/2021, T-153/20, [Lightyoga](#), EU:T:2021:70, § 46-48, 51-52, 54-55, 59-72

#### **Descriptive — Word mark composed of two word elements**

The German-speaking public, including end consumers in the general public, will perceive the combination of the two nouns 'Lichtyoga' as designating a yoga style featuring characteristics of light (§ 46-48, 50-51, 54). The trade mark applied for directly describes the subject, function, use or intended purpose in relation to a wide variety of goods and services in Classes 9, 16 and 41 (§ 57-69).

10/02/2021, T-157/20, [Lichtyoga](#), EU:T:2021:71, § 46-48, 50-51, 54, 57-69

## Descriptive — Word mark composed of two word elements

Not only the individual words 'Glue' and 'Pro', but also their combination 'GluePro', are descriptive of all of the contested goods in Classes 1, 7 and 16 (§ 25, 26, 33, 36, 51). This assessment is not affected by the grammatically erroneous syntax of the mark (i.e. that it should have been structured inversely as 'pro glue' according to English linguistic rules) (§ 34-35).

19/05/2021, T-256/20, [Gluepro](#), EU:T:2021:279, § 25-26, 33, 36, 51, 34-35

## Descriptive word marks (several word elements)

17/01/2019, T-40/18, [SOLIDPOWER](#), EU:T:2019:18  
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  
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-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  
20/09/2019, T-458/18, [real nature](#), EU:T:2019:634  
19/12/2019, T-175/19, [eVoter](#), EU:T:2019:874  
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  
09/09/2020, T-626/19, [Loch- und Rissfüller](#), EU:T:2020:399  
02/09/2020, T-801/19, [PedalBox +](#), EU:T:2020:383  
18/12/2020, T-289/20, [Facegym](#), EU:T:2020:646  
09/12/2020, T-858/19, [easycosmetic](#), EU:T:2020:598  
26/02/2021, T-809/19, [EL CLASICO](#), EU:T:2021:100  
10/02/2021, T-98/20, [Medical beauty research](#), EU:T:2021:69  
07/07/2021, T-386/20, [Intelligence, accelerated](#), EU:T:2021:422  
14/07/2021, T-562/20, [Everlasting Comfort](#), EU:T:2021:464  
02/06/2021, T-183/20, [Teslaplatte](#), EU:T:2021:314  
15/09/2021, T-702/20, [Made of wood](#), EU:T:2021:589  
20/10/2021, T-617/20, [Standardkessel](#), EU:T:2021:708

### 3.3.1.3 Geographical names

[No key points available yet.]

### 3.3.1.4 Numbers

[No key points available yet.]

### 3.3.1.5 Abbreviations

#### 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 word marks (Abbreviations)

11/04/2019, T-225/17, [BIO Proof ADAPTA](#), EU:T:2019:247

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

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

09/09/2020, T-625/19, [SOS Innenfarbe](#), EU:T:2020:398

#### 3.3.1.6 Names of products

### EU word mark PLOMBIR — Descriptive character — 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).

18/06/2020, C-142/19 P, [PLOMBIR](#), EU:C:2020:487, § 41-43, 68-74

#### 3.3.2 Figurative marks

### 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



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



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



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



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



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



15/10/2020, T-38/20, [LOTTO24 \(fig.\)](#), EU:T:2020:496



23/09/2020, T-522/19, [BBQ BARBECUE SEASON \(fig.\)](#), EU:T:2020:443



15/10/2020, T-607/19, [FAKE DUCK \(fig.\)](#), EU:T:2020:491



20/10/2020, T-805/19, [ultrasun \(fig.\)](#), EU:T:2020:507



15/10/2020, T-48/19, [smart:\)things \(fig.\)](#), EU:T:2020:483



02/12/2020, T-152/20, [Home Connect \(fig.\)](#), EU:T:2020:584



03/03/2021, T-48/20, [Heartfulness \(fig.\)](#), EU:T:2021:112



27/01/2021, T-287/20, [EGGY FOOD \(fig.\)](#), EU:T:2021:46



16/06/2021, T-487/20, [imot.bg \(fig.\)](#), EU:T:2021:366



09/07/2021, T-357/20, [NASHE MAKEDONSKO PILSNER BEER MACEDONIAN PREMIUM BEER \(fig.\)](#), EU:T:2021:467



14/07/2021, T-527/20, [CUCINA \(fig.\)](#), EU:T:2021:433

### 3.3.3 Complex marks — figurative threshold

#### 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 — Descriptive verbal elements — Non-distinctive figurative elements

The graphic element of the contested mark is neither unusual nor special and does not possess any features that would allow the contested mark to be remembered (§ 45). Overall, the graphic elements of the contested mark do not alter the purely descriptive message of the word elements (§ 46). Therefore, the contested mark is descriptive as a whole (§ 47).

### 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,

32

### 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

## 3.4 DIRECT AND SPECIFIC LINK WITH THE GOODS/ SERVICES AT ISSUE

### 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 character — Non-descriptive sub-category within a broad descriptive category of goods**

The goods applied for in Class 7 comprise broad categories of goods, for which the contested mark was found to be descriptive. Even though the mark may not be descriptive for certain sub-categories falling under those broad categories of goods, it must nevertheless be refused for the entire broad descriptive categories applied for (§ 39).

17/03/2021, T-226/20, [MobileHeat](#), EU:T:2021:148, § 39

### **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 character — Sufficient direct and concrete link with the goods**

One of the possible meanings of the term ‘cachet’ in French or English is ‘tablet’ (§ 20, 21). The term ‘cachet’, when meaning ‘tablet’, signifies one of the usual pharmaceutical forms of medicinal products. It is therefore descriptive for goods generally available in tablet form (§ 25). However, regarding *sanitary preparations for medical purposes*, although these may be available in the form of ‘water-soluble tablets’, the relevant public will not perceive a direct link with the term ‘cachet’ in respect of these goods, since it perceives the term ‘cachet’ as referring to a tablet or medicinal capsule which is swallowed and not to a pastille or disinfection tablet which must be dissolved in water for purification purposes (§ 28, 40).

14/07/2021, T-622/20, [Cachet](#), EU:T:2021:446, § 28, 40

### **Lack of establishment of a direct and specific link between the sign and the goods**

The BoA did not rule on whether the word sign **Hell** (an adjective meaning ‘clear’ in German) in the absence of the German word ‘Röstung’ (a noun meaning ‘roasting’) is perceived by the German-speaking public without further reflection as referring to a characteristic of the goods, namely coffee preparations. The clear roasting is not established as a well-known fact for the relevant public (§ 39, 44-45). Therefore, the transition made by the BoA from the adjective ‘clear’ to ‘clear roasting’ does not establish a sufficiently direct and specific link between the sign and the goods to fall under the prohibition in Article 7(1)(c) EUTMR (§ 49-50).

21/04/2021, T-323/20, [Hell](#), EU:T:2021:205, 39, 44-45, 49-50

### **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 — 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 — ‘Characteristic’ under Article 7(1)(c) EUTMR — No absence of ‘Intrinsic’ characteristic that is ‘inherent to the nature’ of the goods**

The English-speaking general public of the EU will perceive the element ‘arch’ as relating to the ‘raised part of the foot formed by a curved section of bones’. In the context of footwear, the relevant public will associate the word with the human foot (§ 39). It will understand the element ‘fit’ as a verb meaning ‘to be the right shape and size for somebody/something’ (§ 40).

The combination of the words ‘arch’ and ‘fit’ will be understood as an indication that the footwear designated by the mark is designed specifically to fit the arch of the user’s foot (§ 41). Not only are the terms ‘arch’ and ‘fit’ capable, in themselves, of communicating a descriptive message relating to footwear, but so is their combined use. Taken as a whole, the grammatical structure of the expression ‘arch fit’ is not so unusual that it modifies the message communicated by each of the elements by themselves in the context of footwear (§ 44).

The link is sufficiently direct and specific for the relevant public to immediately perceive the mark, without any particular mental effort, as describing one of the characteristics of footwear (§ 45). The applicant’s argument alleging inconsistency between the case-law in Cases T-423/18 (07/05/2019, T-423/18, *vita*, EU:T:2019:291) and T-133/19 (25/06/2020, T-133/19, *OFF-WHITE* (fig.), EU:T:2020:293) and the BoA’s conclusion that there is a direct link between the mark applied for and the goods it covers is rejected as unfounded. Unlike a colour, which is a random and incidental aspect not only as regards the goods in question in Cases T-423/18 and T-133/19 but also as regards footwear, the fact that a shoe must fit the arch of a foot is one of the characteristics of those goods. It is an objective characteristic, since it is usual and expected and inherent to the nature of footwear (§ 19, 61).

21/12/2021, T-598/20, [Arch fit](#), EU:T:2021:922, § 19, 40, 44, 61

#### **Not descriptive — Descriptive character of vague terms**

The connection between the term ‘team’ and the services in question (i.e. insurance services) is too vague and indeterminate to give the term a descriptive character with regard to those services. While the teamwork suggested may benefit potential customers, this does not expressly apply to insurance services. The fact that a company advertises that the services are provided as a team is too vague and indeterminate to render that sign descriptive of the services in question (§ 84).

01/12/2021, T-359/20, [Team Beverage](#), EU:T:2021:841, § 84

#### **Not descriptive — Subjective feeling — Lack of an objective characteristic inherent in the nature of the goods**

A characteristic within the meaning of Article 7(1)(c) EUTMR, even if it is irrelevant whether that characteristic is essential or ancillary in economic terms, must nevertheless be objective and inherent in the nature of the goods or services or an intrinsic and enduring feature of those goods or services (§ 63). The feeling of being ‘unstoppable’ is, by its very nature, subjective. It cannot therefore be an objective characteristic inherent in the nature of the energy drinks and nutritional supplements covered by the contested mark (§ 64). The contested mark does not have a sufficiently direct and specific relationship with the goods in question to enable the relevant public to perceive, immediately and without further reflection, a description of the intended purpose or of any other characteristic of those goods (§ 65).

06/10/2021, T-3/21, [Unstoppable](#), EU:T:2021:659, § 63-65

#### **Not descriptive — Lawful currency exchange services**

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

## 4 ARTICLES 7(1)(d), 59(1)(a) EUTMR — CUSTOMARY SIGNS OR INDICATIONS

### Invalidity proceedings — Article 7(1)(d) EUTMR — No signs which have become customary — Relevant territory — Non-EU evidence — Nature of use

The invalidity applicant did not establish, according to Article 59(1)(a) EUTMR, that the contested mark had become customary in the current language or in the bona fide and established practices of the trade to designate the goods, such as *harness leather leads, footwear clothing and headgear, sporting articles* in Classes 18, 25 and 28 and that, therefore, at the time of the application for registration, it fell foul of the ground for refusal laid down in Article 7(1)(d) EUTMR (§ 28, 30-32, 38-39, 43, 48, 50, 52).

Such demonstration cannot be limited to isolated cases or sporadic examples (16/03/2006, T-322/03, *Weisse Seiten*, EU:T:2006:87) but must establish, in particular, the existence of 'established' practices of trade known by a significant part of the relevant public in a substantial part of the territory of the EU (11/06/2020, C-115/19 P, *CCB (fig.) / CB (fig.) et al*, EU:C:2020:469, § 57) (§ 50).

Documents originating from outside the EU can be taken into account only if they are capable of proving circumstances having a bearing on the perception of the sign by the relevant public of the EU (05/10/2004, C-192/03 P, *BSS*, EU:C:2004:587, § 42) (§ 34-35).

The fact that an undertaking uses the term 'k9' in its company name does not mean either that that undertaking uses the term 'k9' as a generic and usual term to designate the goods and services which it provides, or a fortiori that that term has become customary in the bona fide and established practices of the trade to designate the goods and services (23/10/2008, T-133/06, *Past Perfect*, EU:T:2008:459, § 55) (§ 38-39).

17/03/2021, T-878/19, [K-9](#), EU:T:2021:146, § 28, 30-32, 38-39, 43, 48, 50, 52

## 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).

10/06/2020, T-105/19, [DEVICE OF A CHEQUERBOARD PATTERN \(fig.\)](#), EU:T:2020:258, § 82-83, 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 — 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 — Colour marks — Colour per se**

The surveys to demonstrate that a sign consisting of a colour per se had acquired distinctive character through use must provide information that makes it possible to assess how representative the sample chosen was. Small samples (100-200 people) are not reliable. In addition, the colour samples should include the Pantone code used. The interviewees should be asked to choose from several images or even shades which one could spontaneously be associated with a particular undertaking (§ 101-102). Sales figures and advertising material may support surveys but, as such, they do not demonstrate that the public targeted by the goods perceives the mark as an indication of commercial origin (§ 107).



09/09/2020, T-187/19, [Colour Purple -2587C \(col\)](#), EU:T:2020:405, § 107

### **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

### **Use in combination with other marks with distinctive character — Use in a directly descriptive manner — No distinctiveness acquired by use**

The acquisition of distinctive character may result both from the use as part of a registered trade mark of an element of the mark, and from the use of another mark in combination with a registered trade mark. In both cases, it is sufficient that, as a result of this use, the interested parties actually perceive the product or service, designated by the only mark whose registration is requested, as coming from a specific company (17/07/2008, C-488/06 P, Aire limpio, EU:C:2008:420, § 49; 07/07/2005, C-353/03, Have a break, EU:C:2005:432, § 30) (§ 94).

The relevant consumers will not perceive the product designated by the sign applied for to come from a particular undertaking where the sign is either used in a directly descriptive manner of the type of product, or is always accompanied, in the evidence produced, by other marks of the applicant that themselves have distinctive character (28/01/2009, T-174/07, TDI, EU:T:2009:21, § 78; 13/09/2012, T-72/11, Espetec, EU:T:2012:424, § 57 and 78) (§ 98).

26/02/2021, T-809/19, [EL CLASICO](#), EU:T:2021:100, § 94, 98

## **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), 59(1)(a) EUTMR — SHAPE**

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

#### **Article 7(1)(e)(i) to (iii) — 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

#### **Article 7(1)(e)(i) to (iii) — Shape commonly used by most of the producers — Concept of ‘shape’ — Colours**

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).

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).



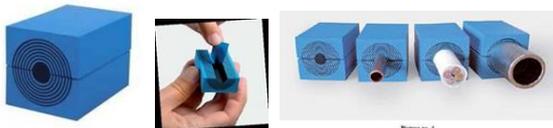
08/05/2019, T-324/18, [BOTTIGLIA DORATA \(3D\)](#), EU:T:2019:297, § 46, 54-55

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

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

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

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

The BoA was correct to conclude that the concentric circles were the only essential characteristic of the contested mark (§ 50). The colour combination serves only to enable the series of concentric circles in that mark to stand out as a result of the contrast created between the colours black and orange. It is not therefore the colour combination that is the most important element of the contested mark, but rather the series of concentric circles (§ 51).

As regards the colour orange per se, detailed examination shows that other marks filed by the applicant all contained the same series of concentric circles, but with different colour combinations. The BoA was therefore correct to note that the existence of those other marks with different colour combinations weakened the applicant's argument that the colours were an important characteristic of the contested mark (§ 52).

Moreover, the presumed perception of the contested mark by the 'independent observer unaware of the product and its function' or by 'specialised consumers', as referred to by the applicant, is not a decisive element when applying the ground for refusal set out in Article 7(1)(e)(ii) EUTMR (§ 55). The identification of the essential characteristics of a sign in the context of Article 7(1)(e)(ii) EUTMR should not necessarily be performed from the perspective of the relevant public (§ 58-60).

Since the essential characteristic of the contested mark, namely the concentric circles, is necessary to obtain the technical result sought by the product concerned, the mark falls within the scope of the ground referred to in Article 7(1)(e)(ii) EUTMR (§ 79).



15/07/2021, T-455/20, [DEVICE OF BLACK CIRCLES PLACED OVER AN ORANGE SQUARE \(fig.\)](#), EU:T:2021:483, § 52, 58-60, 79

### Functionality – Reliance on the possibility of using the sign in a non-functional way – Irrelevant under Article 7(1)(e)(ii)

When applying Article 7(1)(b) EUTMR, the competent authority must take into consideration the various ways in which a mark is likely, if registered, to be presented to the relevant public to determine whether that public will perceive the sign at issue as an indication of the commercial origin of the goods or services concerned. No such obligation may be imposed however when applying the ground for refusal set out in Article 7(1)(e)(ii) EUTMR (§ 85).

For the purposes of applying Article 7(1)(e)(ii) EUTMR, the competent authority needs only to determine, on an objective basis, whether the sign at issue consists exclusively of the shape of the product concerned which is necessary to obtain a technical result (§ 86). Accordingly, even if the applicant were to use the contested mark as a logo and that mark were to fulfil the function of identifying the origin of the goods concerned, those circumstances are irrelevant since it has been established that the contested mark fell within the scope of the ground for refusal set out in Article 7(1)(e)(ii) EUTMR (§ 87).

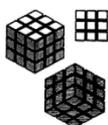


15/07/2021, T-455/20, [DEVICE OF BLACK CIRCLES PLACED OVER AN ORANGE SQUARE \(fig.\)](#), EU:T:2021:483, § 85-87

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

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

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

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.

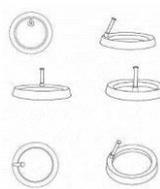
For that step, information other than that relating to the graphic representation alone, such as the relevant public's perception, may be used (§ 29-31, 37). The second step of the analysis is to establish if the essential characteristics perform a technical result. For that step, information which is 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

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

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

### Article 7(1)(e)(ii) EUTMR — Essential characteristics — Technical result — Sign consisting of a shape which does not represent a significant part of the good — Scope of protection of the mark

The GC did not err in law by holding that the BoA had unlawfully added to the shape of the mark elements which do not form part of it and which accordingly allowed it to qualify the mark as a 'representation of a tyre tread' (§ 65-66).

Since the protection of the mark is limited to the shape that it represents, it cannot prevent the use of identical or similar shapes that, combined with other elements, create a different shape (§ 77).



03/06/2021, C-818/18P, [DEVICE OF PIRELLI TYRE TREAD \(fig.\)](#), EU:C:2021:431, § 65-66, 77

## 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), 59(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

### **Contrary to public policy — Definition of public policy — Legality of the services**

EU law does not impose a uniform scale of values and acknowledges that the requirements of public policy may vary from one country to another and from one era to another. The requirements of public policy may cover protection of the various interests that the Member State concerned considers to be fundamental in accordance with its own system of values. However, account must be taken, where appropriate, not only of the particular circumstances in the individual Member State, but also of circumstances common to all Member States. The protection of health and prohibition of drugs is of fundamental interest in the EU, see Article 83 and Article 168(1), third subparagraph TFEU (12/12/2019, T-683/18, CANNABIS STORE AMSTERDAM, EU:T:2019:855, § 71, 73, 75) (§ 40-41, 44).

The word ‘weed’ is used colloquially to refer to drugs (§ 29). The legality of the services covered by the sign cannot be of any relevance to the perception of the relevant public (§ 31). The association of the term ‘weed’ with services of a therapeutic nature involves the risk that the general public gets the impression that the consumption and production of the narcotics to which the sign alludes will be tolerated or even promoted (§ 35). The BoA correctly found that the sign is contrary to public policy within the meaning of Article 7 (1) (f) EUTMR (§ 45).



12/05/2021, T-178/20, [Bavaria Weed \(fig.\)](#), EU:T:2021:259, § 29, 31, 35, 40-41, 44-45

## **8 ARTICLES 7(1)(g), 59(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), 59(1)(a) EUTMR — FLAGS AND OTHER SYMBOLS EMBLEMS, etc.

[No key points available yet.]

## 10 ARTICLES 7(1)(i), 59(1)(a) EUTMR — EMBLEMS NOT PROTECTED UNDER ARTICLE 6ter PC

### Protected geographical indications — Requirement of a misleading connection with the authority to which a badge, emblem or escutcheon of particular public interest refers

A trade mark which includes, without the competent authority's consent to that effect, a badge, emblem or escutcheon of particular public interest can only be refused pursuant to Article 7(1)(i) EUTMR for registration, or invalidated after registration, where that mark, taken as a whole, suggests to the relevant public – and thus misleads it as to – the existence of a connection between its proprietor or user and the authority to which the sign of particular public interest refers. This is, in particular, the case where the relevant public may believe that the marked goods or services originate from that authority, are approved, or certified by it, or are otherwise connected with that authority (§ 22-26, 28).

The misleading connection with the authority to which the badge, emblem or escutcheon of particular public interest refers cannot be established on the sole basis of the fact that it is included into the trade mark without the competent authority's consent. It needs to be specifically and concretely established with respect to the trade mark at hand, inter alia, in view of its size and position within that mark (§ 40, 41, 42).



01/12/2021, T-700/20, [Steirisches Kürbiskernöl g.g.A GESCHÜTZTE GEOGRAFISCHE ANGABE \(fig.\)](#), EU:T:2021:851, § 22-26, 28, 40, 41, 42

### Granting of trade mark protection to the EU's PGI symbols

Granting trade mark protection to an EU symbol such as the PGI symbol is, as a general rule, such as to adversely affect the system of protected geographical indications established by the European Union and to undermine its proper functioning. Indeed, such a grant is liable to confer on the proprietor of a trade mark including the PGI symbol a monopoly on the use of that symbol allowing him or her to prohibit the use of that symbol by any other person, contrary to Article 12 of Regulation No 1151/2012 which allows any producer to use that symbol provided that they meet the requirements for being covered by a protected geographical indication (§ 39, 45).

However, the misleading connection required for the application of Article 7(1)(i) EUTMR needs to be specifically and concretely established with respect to the trade mark at hand, inter alia, in view of its size and position within that mark (§ 40, 41, 42).



01/12/2021, T-700/20, [Steirisches Kürbiskernöl g.g.A GESCHÜTZTE GEOGRAFISCHE ANGABE \(fig.\)](#), EU:T:2021:851, § 39, 40-42, 45

## 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

### **Preliminary ruling — Article 13(1)(d) Regulation No 510/2006 — Article 13(1)(d) Regulation No 1151/2012 — Practice liable to mislead the consumer as to the true origin of the product – Reproduction of the shape or appearance of a product which has a protected name**

EU law prohibits, in certain circumstances, the reproduction of the shape or appearance of a product protected by a protected designation of origin (PDO). It is necessary to determine whether that reproduction may mislead consumers considering all the relevant factors, including the way in which the product is presented and marketed to the public and the factual context (§ 39, 41).

17/12/2020, C-490/19, [Morbier](#), EU:C:2020:1043, § 39, 41

## 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

[No key points available yet.]

## 16 EUROPEAN UNION CERTIFICATION MARKS

[No key points available yet.]

## 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 — Use of an earlier right not a necessary condition

The use of an earlier right by a third party on the internal market, at the time of application for registration of a mark, is not a necessary condition in order to rely on bad faith (12/09/2019, C-104/18P, STYLO & KOTON (fig.), EU:C:2019:724, §52) (§ 42).



09/06/2021, T-396/20, [RIVIERA AIRPORTS \(fig.\)](#), EU:T:2021:326, § 42



09/06/2021, T-398/20, [RIVIERA AIRPORT \(fig.\)](#), EU:T:2021:327, § 42

### 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

### Concept of bad faith

To hold that bad faith involves conduct that departs from accepted principles of ethical behaviour or honest commercial and business practices, and presupposes a dishonest intention or other sinister motive, would be to interpret bad faith too restrictively. In fact, 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, may be sufficient for finding bad faith by the trade mark applicant (12/09/2019, C-104/18 P, STYLO & KOTON (fig.), EU:C:2019:724, § 45-46; 29/01/2020, C-371/18, SKY, EU:C:2020:45, § 74-75) (§ 27).

Accordingly, registration of the contested mark ‘TARGET VENTURES’ not with the intention to use it but with the sole purpose of strengthening the scope of protection of the proprietor’s actually used mark ‘TARGET PARTNERS’, was inconsistent with the essential function of a trade mark to

indicate to consumers the commercial origin of goods and services (§ 25-27, 35-44). In this context, it was irrelevant whether or not the proprietor knew or ought to have known about someone else's prior use of an identical sign, so lack of proof of that knowledge could not have been a reason for dismissing the bad faith claim (§ 28-30, 46).

28/10/2020, T-273/19, [TARGET VENTURES](#), EU:T:2020:510, § 25-30, 35-44, 46

### **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).

The logo for 'Café del Mar' is written in a cursive, handwritten-style font.

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

The logo for 'Café del Mar' is written in a cursive, handwritten-style font.

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).

The logo for 'C del M' is written in a cursive, handwritten-style font.

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).

### **Bad faith — Criterion of dishonesty**

The BoA was entitled to rely on the criterion of dishonesty in order to assess the alleged proprietor's bad faith of the contested mark (§ 117).



24/03/2021, T-282/19, [Halloumi χαλλούμι Vermion grill cheese/grill est/grill kase m BELAS PREMIUM GREEK DAIRY SINCE 1927 \(fig.\) / HALLOUMI](#), EU:T:2021:154, § 117

### **Bad faith — Repeat filings of a mark — Intention at the time of filing the application — Circumstances of the concrete case — Length of obtained extension of a grace period**

There is no provision in the legislation relating to EU trade marks that prohibits the refiling of an application for registration of a trade mark. Consequently, such a filing cannot, in itself, establish that there was bad faith on the part of the trade mark applicant, unless it is coupled with other relevant evidence which is put forward by the applicant for a declaration of invalidity or by the Office. However, where the applicant admitted, and even submitted, that one of the advantages justifying the filing of the contested mark was based on the fact that it would not have to furnish proof of genuine use of that mark, such conduct cannot be held to be lawful. Rather, it must be held to be contrary to the objectives of Trade mark Regulation, to the principles governing EU trade mark law, and to the rules relating to proof of use (§ 49-55, 70).

Regardless of the length of the extension of a grace period, what matters is the trade mark applicant's intention at the time of filing the application for registration. Although the extensions of the grace periods in respect of the earlier marks are not particularly long, the fact remains that the applicant obtained the desired advantage of not having to prove use of the mark for additional periods of 2 years and 2 months and of almost 8 months in connection with the goods and services covered by the earlier marks (§ 89).

Although there is nothing to prohibit the proprietor of an EU trade mark from refiling that mark, the simple fact that other companies may be using a specific filing strategy does not necessarily make that strategy legal and acceptable. Whether or not such a strategy complies with the Trade mark regulation must be assessed on the basis of the circumstances of the particular case. It depends on whether the applicant intentionally sought to circumvent a fundamental rule of EU trade mark law, namely that relating to proof of use, in order to derive an advantage therefrom to the detriment of the balance of the system resulting from that law, as established by the EU legislature (§ 94).

21/04/2021, T-663/19, [Monopoly](#), EU:T:2021:211, § 49-55, 70, 89, 94

### **Bad faith — Contractual relationships — Interpretation of agreements — Transfer of rights — Chronology of events — Unregistered earlier right — Concealed act**

The case concerns the bad faith underlying the application for the EUTM 'TORNADO' for boats by one of the parties to an informal partnership. The other party (the invalidity applicant) is the proprietor of a corresponding unregistered sign which he had used and popularised. The EUTM proprietor claimed that the invalidity applicant had transferred his rights in the sign 'TORNADO' to the EUTM proprietor when forming the partnership. The BoA annulled the EUTM registration and the GC dismissed the appeal.

Examining the parties' correspondence, the GC found that use of the sign by the partnership was subject to the payment of royalties to the invalidity applicant, who was therefore considered the proprietor of the rights in that sign. If a transfer of rights was envisaged, it was never formalised (§ 57-64, 68). Moreover, the invalidity applicant was still monitoring the activity of the partnership (§ 65). The chronology of events supported a finding of bad faith since the contested EUTM application was filed shortly before the cessation of the relationship between the parties (§ 69). The fact that the filing of the EUTM was concealed from the invalidity applicant further supports the conclusion that the application for the contested EUTM essentially aimed to 'put up obstacles to the [invalidity applicant's] activities by preventing him from using that mark which, over time, he had made popular in the inflatable boats sector' (§ 71, 73). The fact that the invalidity applicant's rights concerned an unregistered mark is irrelevant to the extent that bad faith does not require the invalidity applicant to be the proprietor of a registered earlier mark (§ 77). The fact that use of this unregistered mark may have stopped after the establishment of the partnership is equally irrelevant: 'Even assuming that the [invalidity applicant] no longer used that sign for the purposes of marketing inflatable boats with his own company, the fact remains that that sign remained his, as he had consented to the use thereof by the [contested EUTM proprietor], in exchange for royalties paid by the latter, during the period preceding the application for the trade mark' (§ 79).



73, 77, 79

12/05/2021, T-167/20, [TORNADO \(fig.\)](#), EU:T:2021:257, § 57-65, 68-69, 71,

#### **Bad faith — Contractual acknowledgement of pre-existing right in the contested sign**

An explicit acknowledgement, in a distribution agreement, of a pre-existing right in the sign shows the EUTM proprietor's knowledge of the existence of such a right (§ 30) and deprives of any logical explanation the EUTM proprietor's claimed belief that he himself had such rights in the sign (§ 38). Such a contractual acknowledgement constitutes — as confirmed by the chronology of events and the commercial logic underlying the filing of the contested mark (§ 62-71) — an absolute indication that the EUTM proprietor made that filing in bad faith (§ 46, 51). The existence of bad faith is not excluded by the fact that the sign has not been used in the EU (§ 39, 40).

17/03/2021, T-853/19, [Earnest Sewn](#), EU:T:2021:145, § 30, 38-40, 46, 62-71

#### **Bad faith — Nature of the market — Period of use of identical or similar mark — Chronology of events constitute relevant factors for assessing the presumption of knowledge — Absence of use may be relevant when assessing the existence of dishonest intention**

Given the relatively limited nature of the market for the sale of automobile tyres in Bulgaria and the common origin in China of the tyres, the BoA was entitled to presume that, at the time of filing the application for registration, the applicant had knowledge of the activities of its direct competitor in Bulgaria and, in particular the marketing of tyres made in China under a mark highly similar to the contested mark (§ 45). The evidence provided by the intervener shows only use of the Chinese mark 'Agate' in Bulgaria between 2014 and 2017, that is to say during a period which may appear relatively short. However, the duration of use of a sign is only one of the considerations which may be taken into account to presume knowledge of it for the purposes of assessing bad faith (§ 46). Knowledge can also be established considering the chronology of the events, namely the short period between the filing of the contested mark and its registration on 7 March and 21 June 2017 respectively on the one hand, and the application for coercive measures lodged by the applicant with the Bulgarian customs authorities against the intervener and its distributor on 5 July 2017 and the infringement action filed on 6 July 2017 before the Bulgarian Patent Office against that distributor, on the other (§ 61, 63).

In the context of the assessment of bad faith, it is not the use of the contested mark that is examined, but rather whether the proprietor, at the time of filing the application for registration, intended to make use of the mark (§ 68). The absence of such an intention may be inferred from the complete absence of evidence relating to the commercial activities of the proprietor of the contested mark. Such evidence may be relevant in assessing the commercial logic underlying the filing of the application for registration of the contested mark (§ 69). Considering the circumstances of the case ‘there was no commercial logic underlying the application for registration of the contested mark’; the applicant’s only activity related to that mark was that of ‘hindering others’. Therefore, the applicant ‘pursued dishonest purposes’ (§ 72-74).

29/09/2021, T-592/20, [Agate / Agate](#), EU:T:2021:633, § 45-46, 61, 63, 68, 72-74

### **Bad faith — Scope of cancellation**

Knowledge on the part of an EUTM applicant of the prior use made of a similar sign, corresponding to a rare first name of Arabic origin, can be deduced from the reputation acquired by this sign in a third country in adjacent economic fields. Bad faith does not require use, by a third party, of an identical or similar sign within the EU (§ 31-35, 43-44).

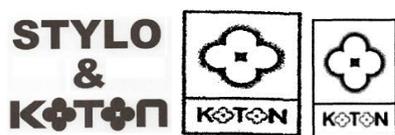
The scope of the invalidity (for all goods and services or parts of them) may depend on whether the EUTM applicant’s intention was: to harm a particular third party, in which case it is not possible to distinguish between the EUTM applicant’s motives and the registration should therefore be cancelled as a whole, or to misuse the registration system otherwise than by harming one specific operator, in which case the EUTM applicant’s intention may be partly legitimate and partly abusive, therefore justifying the conclusion that the ground for invalidity exists only in respect of some of the goods or services for which the EUTM has been registered (§ 51, 54-55).

28/04/2021, T-311/20, [Choumicha Saveurs \(fig.\)](#), EU:T:2021:219, 31-38, 43-44, 51, 54-55

## **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

### **Business relationship with an intermediary who knew of the existence of the mark — Other negligible factors**

The EUTM proprietors were not linked to the applicant and bad faith on the part of the EUTM proprietors cannot be presumed based merely on their business relationship with an intermediary who knew of the existence of the mark EGYPTIAN EARTH (§ 35-36).

The fact that the EUTM proprietors are also proprietors of other marks using the same term in different language versions suggests that the registration of that mark is not artificial in nature or devoid of logic in commercial terms and had a legitimate aim (§ 39-41).

The addition of the distinctive term 'bikor' also suggests a lack of bad faith on the part of the EUTM proprietors when filing the application for the mark (§ 42-43).

16/12/2020, T-438/18, [BIKOR EGYPTIAN EARTH](#), EU:T:2020:630, 35-36, 42-43

### **Bad faith — Contractual relations — Concealed act**

In the present case, the mere fact that the proprietor of the contested mark has interpreted the provisions of an agreement concluded with the invalidity applicant in its own favour, this does not constitute an indication of bad faith (§ 61).

Although the proprietor had not informed the invalidity applicant that it had filed the contested mark in advance, this was not a concealed act carried out to prevent the invalidity applicant from using the sign. The agreements between the parties had been terminated and were the subject of litigation long before the contested mark was filed. Indeed, the invalidity applicant knew that the proprietor of the contested mark was seeking to protect its interests by any available legal means (§ 73).

### **‘First-to-file’ principle — Absence of bad faith**

The EU trade mark registration system is based on the ‘first-to-file’ principle, laid down in Article 8(2) EUTMR, according to which a sign may be registered as an EUTM only in so far as this is not precluded by an earlier mark. On the other hand, without prejudice to the possible application of Article 8(4) EUTMR the mere use by a third party of a non-registered mark does not preclude an identical or similar mark from being registered as an EU trade mark for identical or similar goods or services. This rule is qualified, in particular, by Article 52(1)(b) EUTMR, under which an EU trade mark is to be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings, where the applicant acted in bad faith when it filed the application for the trade mark (§ 26-27).

24/11/2021, T-434/20, [dziandruk \(fig.\)](#), ECLI:EU:T:2021:815, § 26-27

## **17.3 PROOF OF BAD FAITH**

### **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

### **Bad faith — Burden of proof**

It is for the applicant of a declaration of invalidity under Article 59(1)(b) EUTMR to establish the circumstances indicating that the proprietor of an EU trade mark was acting in bad faith. There is a presumption of good faith until proof to the contrary is adduced (§ 33).

It was not mandatory for the invalidity applicant to invoke and substantiate any prior right in the contested mark. Given that the invalidity applicant had based its arguments relating to bad faith on the alleged existence of prior exclusive interests and rights in the contested sign, the Office correctly examined whether or not those arguments were well-founded (§ 73).

16/06/2021, T-678/19, [Enterosgel \(fig.\)](#), EU:T:2021:364, § 33, 73

## **17.4 RELATION TO OTHER EUTMR PROVISIONS**

[No key points available yet.]

## **17.5 EXTENT OF INVALIDITY**

### **Bad faith — Extent of invalidity**

Where the ground for invalidity exists in respect of only some of the goods or services for which the contested mark is sought to be registered, the trade mark is to be declared invalid as regards those goods or services only (29/01/2020, C-371/18, SKY, EU:C:2020:45, § 80). Therefore,

upholding the action on the basis of bad faith does not automatically mean that the mark is invalid in its entirety (§ 71).



09/06/2021, T-396/20, [RIVIERA AIRPORTS \(fig.\)](#), EU:T:2021:326, § 71



09/06/2021, T-398/20, [RIVIERA AIRPORT \(fig.\)](#), EU:T:2021:327, § 71

## CHAPTER III — RELATIVE GROUNDS FOR REFUSAL / INVALIDITY

### 1 ARTICLES 8(1)(a), 60(1)(a) EUTMR — IDENTICAL SIGNS / G&S

#### Identical signs — Identical goods and services in part — Action manifestly lacking any foundation in law

As the identity of the signs is not disputed, the BoA was right to find that the opposition had to be upheld in respect of the goods that it had found to be identical (§ 33).

The whole action is dismissed as manifestly lacking any foundation in law (§ 83).

21/05/2021, T-158/20, [Breeze / Breeze](#), EU:T:2021:288, § 33, 83

### 2 ARTICLES 8(1)(b), 60(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 as protected by the mark, not as marketed for the determination of the relevant public

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

#### Limitation of the assessment to 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

#### Limitation of the assessment to part of the relevant public with a specific linguistic profile

It is only appropriate to limit the assessment of the LOC to part of the relevant public with a specific linguistic profile where the word elements of the marks belong to the vocabulary of a particular language or where only part of the relevant public, defined by reference to the spoken language, attributes a particular meaning to it (§ 29).



28/04/2021, T-310/20, [JUMEX \(fig.\)-Zumex \(fig.\) et al.](#), EU:T:2021:227, § 29

## 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.

## Relevant public — Bulgarian consumers — Capacity of reading Latin characters

At least a large proportion of Bulgarian consumers are capable of reading Latin characters (23/10/2017, T-441/16, *SeboCalm / Sebotherm*, EU:T:2017:747, § 67; 07/02/2018, T-793/16, *Boxes [packaging]*, EU:T:2018:72, § 53-56) (§ 53).

25/11/2020, T-874/19, [Flaming forties / 40 FLAMING FRUITS \(fig.\)](#), EU:T:2020:563, § 36-38, 40, 42, § 53

## Necessity to base the assessment of LOC on the perception of the relevant public — Action manifestly well founded

The assessment of the LOC must be based on the perception of the relevant public and the principles governing the definition of the relevant public must be applied to the concrete case (24/05/2011, T-408/09, *ancotel*, EU:T:2011:241, § 29) (§ 34, 39, 43). The BoA was wrong to assess the LOC on the basis of a comparison of the signs in the abstract without identifying the relevant public, on the ground that that information did not influence the decision (§ 39-41). The action is manifestly well founded since the BoA did not identify in the contested decision the relevant public and its level of attention for the purposes of assessing the LOC (§ 43-45).

16/06/2021, T-420/20, [Gt8 / GT \(fig.\)](#), EU:T:2021:379, § 43, 39-41, 43-45

16/06/2021, T-421/20, [Gt3 / GT \(fig.\)](#), EU:T:2021:377, § 43, 39-41, 43-45

16/06/2021, T-422/20, [Gt5 / GT \(fig.\)](#), EU:T:2021:378, § 43, 39-41, 43-45

16/06/2021, T-423/20, [Gt9 / GT \(fig.\)](#), EU:T:2021:376, § 43, 39-41, 43-45

16/06/2021, T-558/20, [Gt10 / GT \(fig.\)](#), EU:T:2021:38, § 43, 39-41, 43-45

## Relevant public — International registration of the earlier trade mark that covers the EU

The relevant territory for assessing the linguistic profile of the relevant public is the entire EU because the international registration of the earlier trade mark covers the EU. Therefore, it is not appropriate to restrict the relevant public to the Turkish-speaking public located in the EU. The absence of a LOC on the part of that public cannot rule out the possibility that a LOC may exist for the non-Turkish speaking public in the EU (§ 23).



EU:T:2021:713, § 23

20/10/2021, [T-559/20, PINAR Süzme Peynir \(fig.\) / Süzme Peynir \(fig.\)](#),



20/10/2021, T-560/20, [PINAR Tam kıvamında Süzme Peynir Yumusacık ve Leziz \(fig.\) / Süzme Peynir \(fig.\)](#), EU:T:2021:714, § 23

## 2.1.2 Level of degree of attention

### 2.1.2.1 Level of attention — average (examples)

#### **Mass consumption goods — Average degree of attention**

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 not 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

### 2.1.2.2 Level of attention — high (examples)

#### **Computer including various software goods — Smart phones — High level of attention**

The level of attention of the average consumer from the general public in relation to *computers*, including various software goods and computer hardware goods, and *smart phones; mobile phones; wearable smart phones* in Class 9, is higher than in relation to everyday consumer goods, without, however, being particularly high (§ 35-36, 38).

18/11/2020, T-21/20, [K7 / K7](#), EU:T:2020:550, § 35-36, 38

#### **Advertising; business management; business administration — Higher level of attention**

*Advertising; business management; business administration* services in Class 35 are aimed at a professional public displaying a higher level of attentiveness (19/05/2015, T-607/13, 42 VODKA JEMNÁ VODKA VYRÁBĚNÁ JEDINEČNOU TECHNOLOGIÍ 42 % vol. (fig.) / 42 BELOW et al., EU:T:2015:292, § 33) (§ 38-40).

09/06/2021, T-266/20, [CCA CHARTERED CONTROLLER ANALYST CERTIFICATE \(fig.\) / CFA institute \(fig.\) et al.](#), EU:T:2021:342, § 38-40

#### **Training services — High level of attention**

The level of attention of the relevant public with regard to *training services* in Class 41 is high: these services are aimed at expanding knowledge and developing skills, usually through a commitment in terms of time and resources on the part of the relevant public; they do not satisfy a current or recurring need, but a personal or leisure interest (§ 35).

09/12/2020, T-819/19, [BIM READY \(fig.\) / BIM freelance \(fig.\)](#), EU:T:2020:596, § 35

#### **Education and training services — High level of attention**

Although the education and training services in Class 41, in general, are sometimes expensive, they may also be offered at lower prices. Furthermore, those services do not necessarily entail long-term commitments. Likewise, even though the services are not everyday consumer services, the acquisition of those services is not, as a matter of course, preceded by a long process of reflection. For those reasons, the Court has held that a 'heightened' level of attention on the part of the general public cannot be presumed for those services (24/09/2019, T-497/18, IAK (fig.) / IAK - Institut für angewandte Kreativität, EU:T:2019:689, § 32-33) (§ 28).

On the other hand, training services in Class 41 are generally aimed at expanding knowledge and developing skills, usually through a commitment of time and resources on the part of the relevant public. According to that part of the case-law, those services do not satisfy a current or recurring need but a personal or leisure interest. In principle, the general public will use them to acquire knowledge and skills for professional and functional retraining or to develop specific technical expertise. For those reasons, the Court has held that the level of attention of the average consumer in the relevant public is 'high' for those services (09/12/2020, T-819/19, *bim ready (fig.) / BIM freelance (fig.)*, EU:T:2020:596, § 35) (§ 29).

21/12/2021, T-369/20, [Cefa certified european financial analyst / Cfa et al.](#), EU:T:2021:921, § 29

### **Education/training services addressed to a specific field — High level of attention**

Where *education/training services* are addressed to a specific field, the level of attention must be considered high for both the general public and professionals (13/10/2009, T-146/08, *Redrock*, EU:T:2009:398, § 45) (§ 33-35, 45-48, 50).

09/06/2021, T-266/20, [CCA CHARTERED CONTROLLER ANALYST CERTIFICATE \(fig.\) / CFA institute \(fig.\) et al.](#), EU:T:2021:342, § 33-35, 45-48, 50

### **Education and training services relating to financial analysis — High level of attention**

As regards training services in Class 41 that are specific in nature since they concern the field of financial analysis, consumers interested in those services, even if they are part of the general public, will pay particular attention to them when choosing which programmes they prefer, usually after examining and comparing the educational offers available (09/06/2021, T-266/20, *CCA CHARTERED CONTROLLER ANALYST CERTIFICATE (fig.) / CFA institute (fig.) et al.*, EU:T:2021:342). Since consumers do not use financial training services on a daily basis, their level of attention cannot be equivalent to that which they display with regard to everyday consumer services. It must be considered to be higher (09/06/2021, T-266/20, *CCA CHARTERED CONTROLLER ANALYST CERTIFICATE (fig.) / CFA institute (fig.) et al.*, EU:T:2021:342, § 47-48) (§ 30-31).

For those reasons, the general public's level of attention is high (and not average as stated by the BoA) for the education and training services in Class 41 at issue (§ 32-35). That error vitiated all of the BoA's reasoning relating to the global assessment of any LOC (§ 36). Therefore, the contested decision is annulled (§ 49).

21/12/2021, T-369/20, [Cefa certified european financial analyst / Cfa et al.](#), EU:T:2021:921, § 30-31, 49

### **Air, rail transport or maritime services — Enhanced level of attention**

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

## **Pharmaceutical, medical and veterinary fields — Enhanced level of attention**

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, [DermaFaes Atopimed / Dermowas](#), EU:T:2019:819, § 26

28/11/2019, T-643/18, [DermaFaes / Dermowas](#), EU:T:2019:818, § 26

28/11/2019, T-644/18, [DermaFaes AtopiDerm / Dermowas](#), EU:T:2019:817, § 26

### **2.1.2.3 Level of attention — low (examples)**

[No key points available yet.]

## **2.2 COMPARISON OF THE GOODS AND SERVICES**

### **2.2.1 Scope of the list of goods and services**

#### **Irrelevance of actual use of the mark for the comparison of goods and services**

For the purposes of assessing whether there is a LOC, only the description of the goods in respect of which registration of the mark is sought is relevant; the intended or actual use of that mark cannot be taken into account, since the registration does not contain a restriction to that effect (§ 36).

27/01/2021, T-382/19, [Skylife \(fig.\) / SKY](#), EU:T:2021:45, § 36

#### **Declaration under Article 28(8) CTMR [now Article 33(8) EUTMR] — Decision of declaration of invalidity**

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 Praktiker judgment's requirements — 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

### **Registration for general indications of the class headings — Literal meaning**

If an earlier mark is registered for one of the general indications of the class heading, for example *hand tools (hand operated)* in Class 8, it is then protected for all products included in the literal meaning of that indication (07/04/2016, T-613/14, Polycart A Whole Cart Full of Benefits / POLICAR, EU:T:2016:198, § 23) (§ 43, 59)

05/10/2020, T-847/19, [Pax-SPAX \(fig.\) et al.](#), EU:T:2020:472, § 43, 59

### **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.

### **Clarity and precision of product indication (earlier mark) — Identical products — Absence of relevance of the parties’ current fields of activity**

Even if it were assumed that the product indication *software* in the earlier mark were vague, this would not affect the possibility of a comparison with the contested goods. Since the specific *software for education purposes* designated by the mark applied for is included in the general indication of *software*, the goods are found to be identical. The specific field of application of the general indication *software* cannot be inferred either from the other goods and services covered by the earlier mark or from the actual fields of activity of the parties (§ 29-33).

24/02/2021, T-56/20, [Vroom / Pop & Vroom](#), EU:T:2021:103, § 29-33

### **Consideration of the Nice classification for the purposes of interpretation**

Although the classification of goods and services under the Nice Agreement is intended to serve exclusively administrative purposes, the class which the applicant has chosen in that classification may be taken into account for the purposes of interpretation or as an indication of the precision of the designation of the goods (25/01/2018, T-367/16, H HOLY HAFERL HAFERL SHOE COUTURE (fig.) / HOLY et al., EU:T:2018:28, § 50) (§ 35).

01/09/2021, T-697/20, [Donas dulcesol / Dulcesol](#), EU:T:2021:526, § 35

## **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

### **2.2.2 Identity**

[No key points available yet.]

### **2.2.3 Similarity**

#### **Irrelevance of marketing issues for the comparison of goods and services**

When carrying out the comparison to assess whether there is a LOC, 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).

08/07/2020, T-328/19, [SCORIFY \(fig.\) / Scor et al.](#), EU:T:2020:311, § 48

#### **Relevance of the ‘market practice criterion’ for the comparison of goods and services — Criteria relating to the fact that the producers and distribution channels are the same — Lack of reasoning**

In order to compare the goods or services, all the relevant factors relating to those goods and services should be taken into account (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 23). Those factors include, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary. Other factors may also be taken into account, such as the distribution channels of the goods or services concerned or the fact that those goods or services are often sold in the same specialist sales outlets, which is likely to facilitate the perception by the relevant consumer of the close connections between them and strengthen the impression that the same undertaking is responsible for the production of those goods or provision of those services (21/01/2016, C-50/15 P, Carrera / CARRERA, EU:C:2016:34, § 21-23) (§ 44). The list of criteria is not exhaustive (§ 45).

The existence of a certain market practice may constitute a relevant criterion for the purpose of examining the similarity between goods or services in the context of Article 8(1)(b) CTMR [now EUTMR] (§ 51-54, 55).

The BoA erred in law, by ruling out, as a matter of principle, an assessment of the similarity of the goods in light of the market practices criterion put forward by the applicant. It cannot be ruled out that other criteria, besides the Canon criteria, the distribution channels and the fact that the sales outlets are the same, may be relevant in assessing the similarity between goods or services in

general and between the goods at issue in particular (§ 46-48). Since, owing to its error, the BoA did not specifically examine the relevance and then, if necessary, the impact of that criterion on its assessment of the similarity between the goods at issue, the Court cannot itself give a ruling on that issue (§ 56).

Furthermore, the BoA did not take into consideration criteria relating to the usual origin of the goods or the fact that the producers and distribution channels are the same in the analysis that led to the adoption of the contested decision (§ 59). By not stating the reasons why criteria relating to the usual origin of the goods or the fact that the producers and distribution channels are the same were not taken into account, the BoA failed to set out all the facts and legal considerations that are crucial for finding that the goods are not similar, with the result that the contested decision is vitiated by a failure to state reasons (21/07/2016, T-804/14, *Tropical*, EU:T:2016:431, § 178) (§ 62).

It is not for the Court, in its review of the legality of the contested decision, to carry out an assessment of something on which the BoA has not adopted a position, and the Office cannot substantiate the contested decision before the Court with evidence that was not taken into account for the purposes of that decision (08/09/2017, T-572/15, *GOURMET (fig.) / ORIGINE GOURMET (fig.)*, EU:T:2017:591, § 36) (§ 64). The Office's line of argument, that the application of the additional criteria would not lead, in the present case, to a finding that the goods at issue are similar, is therefore inadmissible (24/09/2019, T-356/18, *V V-WHEELS (fig.) / VOLVO (fig.) et al.*, EU:T:2019:690, § 49) (§ 65).

02/06/2021, T-177/20, [Hispano Suiza / Hispano Suiza](#), EU:T:2021:312, 44-45, § 51-54, 55-56, 62, 65

## **No need for evidence regarding the similarity of the goods and services**

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, § 51

## **2.2.4 Particular industries**

### **2.2.4.1 Chemicals, pharmaceuticals and cosmetics**

#### ***Food, nutritional, dietary and vitamin supplements — Creams for medical use — Similarity***

*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

#### ***Health food supplements — Pharmaceutical preparations — Similarity***

*Health food supplements made principally of vitamins; nutritional supplements; food supplements; dietary supplements consisting of vitamins* are similar to *pharmaceutical preparations* (§ 40-43).

16/12/2020, T-883/19, [Helix elixir / Helixor et al.](#), EU:T:2020:617, § 40-43

### **Sanitary products [...] and Capsules (filled) for medical purposes in Class 5 — Pharmaceutical preparations — Similarity**

*Sanitary products...*, excluding pharmaceutical and veterinary products included in Class 5 and the *pharmaceutical preparations* are similar to a low degree. *Capsules (filled) for medical purposes (included in Class 5)*, excluding pharmaceutical and veterinary products and *pharmaceutical preparations* are similar (§ 36).

15/10/2020, T-2/20, [BIOPLAST BIOPLASTICS FOR A BETTER LIFE \(fig.\) / Bioplak](#), EU:T:2020:493, § 36

### **Chemical reagents for pharmaceutical and veterinary purposes, dietary supplements, Sanitary preparations for medical use — Antipyretics — Similarity**

*Chemical reagents for pharmaceutical and veterinary purposes* in Class 5 are similar to *antipyretics* in the same class (§ 71).

*Dietary supplements for pharmaceutical and veterinary purposes; dietary supplements; nutritional supplements; medical preparations for slimming purposes; food for babies; herbs and herbal beverages adapted for medicinal purposes; herbal supplements; herbal creams for medical purposes; herbal creams for medical use; herbal teas for medicinal purposes; liquid herbal supplements* in Class 5 have a lower-than-average degree of similarity to *antipyretics*, also included in Class 5 (§ 56).

*Sanitary preparations for medical use; hygienic pads; hygienic tampons; plasters; materials for dressings; diapers, including those made of paper and textiles; fungicides, disinfectants; antiseptics; detergents for medical purposes* in Class 5 have a lower-than-average degree of similarity to the *antipyretics* (§ 72).

*Bee glue for human consumption, propolis, propolis for human consumption* in Class 30 have a slightly lower-than-average degree of similarity to *antipyretics* in Class 5 (§ 55).

*Teeth filling material, dental impression material, dental adhesives and material for repairing teeth* in Class 5 are dissimilar to *antipyretics* (§ 70).

05/10/2020, T-53/19, [apiheal \(fig.\) / APIRETAL](#), EU:T:2020:469

### **Cosmetic services — Sterile implantable products for filling wrinkles — Similarity**

*Cosmetic services, hygienic and beauty care for human beings* in Class 44 and *sterile implantable products for filling wrinkles, fine lines, cutaneous depressions and for adding volume to the lips* in Class 5 have an average degree of similarity (§ 33, 48). They share the same purpose, rendering the face more beautiful, they are both used within the same therapeutic beauty treatment and they can be found in the same beauty institutions (§ 40-41). They are complementary since the beauty institutions use these implantable cosmetics (§ 42). Even if some of the cosmetics were only offered in specialised clinics, these hospitals provide cosmetic treatments (§ 45). Therefore, they also share the same distribution channels (§ 47).

25/11/2020, T-802/19, [KISS COLOR \(fig.\)-Kiss et al](#), EU:T:2020:568, § 47

### **Cosmetics in Class 3 and pharmaceuticals in Class 5 — Similarity to a low degree**

*Pharmaceuticals* and *cosmetics* share the same distribution channels and target in large part the same public, namely the general consumer. Although *pharmaceuticals* are different in nature on account of their therapeutic indication, they may nevertheless include, like the *cosmetics*,

products intended to be applied to the skin, in particular in form of creams, lotions and oils. Therefore, the goods are similar to a low degree (§ 42-44).

24/03/2021, T-175/20, [Sanolie / Sanodin](#), EU:T:2021:165, § 42-44

### **Pharmaceuticals — Cosmetics — Similarity to a low degree**

*Pharmaceuticals* are similar to a low degree to *cosmetics* since: (i) the purpose of certain pharmaceuticals, such as skincare or haircare preparations with medical properties, medicated dentifrices and medicated soaps, coincides with the purpose of cosmetic creams or lotions, dentifrices and soaps not for medical use and (ii) both of these types of goods are sold in pharmacies (§ 32-33). A partial overlap between the points of sale is sufficient where there are numerous points of sale (§ 34).

30/06/2021, T-501/20, [Panta rhei / Panta rhei](#), EU:T:2021:402, § 34

### **Dietetic food supplements for medicinal use and nutritional supplements — Cosmetics — Similarity to a low degree**

*Dietetic food supplements for medicinal use and nutritional supplements* and *cosmetics* are similar to a low degree as they both have the common objective of skincare and beauty (§ 39-40, 42).

30/06/2021, T-501/20, [Panta rhei / Panta rhei](#), EU:T:2021:402, § 39-40, 42

### **Medicated nasal sprays — Medicated dental rinses — Similarity to a low degree**

*Medicated nasal sprays* and *medicated dental rinses* are similar to a low degree. They are medicinal products which are aimed at treating infections, in particular those of the respiratory system. Furthermore, it is conceivable that nasal sprays may be used to treat infections of the respiratory tract and the pharynx and that those goods may be combined. Also they share the same distribution channels (§ 28-29).

20/01/2021, T-261/19, [OptiMar \(fig.\)](#), EU:T:2021:24, § 28-29

### **Non-alcoholic dietetic beverages for medical purposes — Cosmetics — Similarity to a low degree**

*Non-alcoholic dietetic beverages for medical purposes* and *cosmetics* are similar to a low degree since the purpose of both can be to improve the physical appearance of the user. The difference in the method of use is not sufficient to prevent a finding of similarity (§ 44-45).

30/06/2021, T-501/20, [Panta rhei / Panta rhei](#), EU:T:2021:402, § 44-45

### **Non-alcoholic beverages adapted for the prevention and curative treatment of eye diseases — Cosmetics — Similarity to a low degree**

*Non-alcoholic beverages adapted for the prevention and curative treatment of eye diseases* and *cosmetics* are similar to a low degree even if the goods differ in purpose because of the similarity of their distribution channels (§ 52-53).

30/06/2021, T-501/20, [Panta rhei / Panta rhei](#), EU:T:2021:402, § 52-53

### **Perfumery, cosmetics, herbicides — Antipyretics — Dissimilarity**

*Perfumery; cosmetics; fragrances; deodorants for personal use and animals; soaps; bath herbs, not for medical purposes; dental care preparations, dentifrices, denture polishes, tooth whitening preparations, mouth washes, not for medical purposes* in Class 3 are dissimilar to *antipyretics* in Class 5 (§ 43-44).

*Preparations for destroying vermin; herbicides* in Class 5 are different to *antipyretics* in Class 5 (§ 53-54).

05/10/2020, T-51/19, [apiheal \(fig.\) / APIRETAL](#), EU:T:2020:468, § 43-44, 53-54

### **Perfumery, fragrances for personal use, perfume oils for the manufacture of cosmetic preparations — Perfume oils for the manufacture of cosmetic preparations — Dissimilarity**

There is no similarity between, on the one hand, the *perfumery, fragrances for personal use and perfume oils for the manufacture of cosmetic preparations* in Class 3 covered by the mark applied for and, on the other hand, the pharmaceutical and sanitary preparations intended for medical treatment or healthcare in Class 5 covered by the earlier mark. The goods have different purposes, different distribution channels and not the same usual origin and they are neither in competition nor complementary (§ 24-35).

15/09/2021, T-331/20, [Le-vel / Level](#), EU:T:2021:571, § 24-35

### **Polishing, scouring and abrasive preparations — Preparations for destroying vermin; fungicides, herbicides — Dissimilarity**

There is no similarity between, on the one hand, the *polishing, scouring and abrasive preparations* in Class 3 covered by the mark applied for and, on the other hand, the goods in Class 5 protected by the earlier mark, in particular the *preparations for destroying vermin; fungicides, herbicides* (§ 39-45).

15/09/2021, T-331/20, [Le-vel / Level](#), EU:T:2021:571, § 39-45

### **Flavourings for beverages [essential oils]; food flavourings prepared from essential oils — Dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals — Dissimilarity**

*Flavourings for beverages [essential oils]; food flavourings prepared from essential oils* in Class 3 and covered by the mark applied for are dissimilar to the *dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals* in Class 5 and covered by the earlier mark. The nature, intended purpose and consumers of those goods are different and the goods are neither in competition nor complementary (§ 46-51).

15/09/2021, T-331/20, [Le-vel / Level](#), EU:T:2021:571, § 46-51

### **Goods and services in Classes 1 and 42 — Pharmaceutical preparations — Dissimilarity**

The goods and services in Classes 1 (such as *chemicals used in industry, in particular pre-processed products and auxiliary agents for the manufacture of plastics; chemicals used in form of thermoplastically processable granules for pharmaceutical purposes*) and 42 (such as *scientific and technological services and research and design relating thereto in particular in the field of biodegradable plastics*) on one hand and *pharmaceutical preparations* in Class 5 on the other are

dissimilar (§ 25-30, 31-35). The mere fact that one product is used for the manufacture of another is not sufficient in itself to show that the goods are similar, as their nature, purpose, relevant public and distribution channels may be quite distinct (§ 27). The goods cannot be regarded as complementary on the sole ground that one is manufactured with the other (09/04/2014, T-288/12, Zytel, EU:T:2014:196, § 39) (§ 29). The services in Class 42 have a different nature and purpose to those of the goods in Class 5. They are neither complementary to nor in competition with each other and their respective distribution channels and methods of use are different (§ 31).

15/10/2020, T-2/20, [BIOPLAST BIOPLASTICS FOR A BETTER LIFE \(fig.\) / Bioplak](#), EU:T:2020:493, § 25-30, 31-35

***Stem cells for scientific purposes and stem cells for research purposes (...) and — Veterinary preparations; stem cells for medical purposes — Hospitals services — Dissimilarity***

*Stem cells for scientific purposes and stem cells for research purposes* in Class 1 covered by the mark applied for are different from the services *hospitals* in Class 44 covered by the earlier mark. Given the wide variety of goods capable of having a medical purpose, this factor is not sufficient to establish similarity of the goods and services (§ 70-71).

*Veterinary preparations; stem cells for medical purposes; cellular function activating agents for medical purposes; stem cells for veterinary purposes and surgical implants grown from stem cells* in Class 5 covered by the mark applied for, are not similar to the services *hospitals* in Class 44 covered by the earlier mark since they are different in nature, purpose and method of use and it is not sufficiently apparent from the evidence that the goods have the same origin and use the same distribution channels as the services *hospitals* (§ 72-73, 75-77).

22/09/2021, T-591/19, [Healios \(fig.\) / HELIOS](#), EU:T:2021:606, § 70-71, 72-73, 75-77

***Medical services relating to the removal, treatment and processing of stem cells — Medical services relating to the removal, treatment and processing of human blood — Dissimilarity***

*Medical services relating to the removal, treatment and processing of stem cells; and medical services relating to the removal, treatment and processing of human blood, umbilical cord blood, human cells, stem cells and bone marrow* in Class 44 covered by the mark applied for, have a particular nature and purpose in that they concern the transformation of the raw materials human blood, umbilical cord blood, human cells, stem cells and bone marrow. Given such characteristics, these services are normally offered by institutes or laboratories specialising in those fields and are not marketed via the same distribution channels as the services *hospitals* covered by the earlier mark (§ 82). These services are different (§ 84).

22/09/2021, T-591/19, [Healios \(fig.\) / HELIOS](#), EU:T:2021:606, § 82, 84

#### **2.2.4.2 Automobile industry**

***Accessories — Caravans, and spare parts therefor in Class 12 — Identity***

*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

### ***Bicycles and motorcycles — Parts and accessories of bicycles and motorcycles — Similarity***

*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

### ***Various bicycles and moving vehicles for children — Vehicles — Apparatus for locomotion by land — Weak similarity***

*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; mountainbikes; 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

### ***Comparison of goods in Class 12 — Electrically-powered motor scooters; mopeds; motorcycles — Bicycles — Low similarity***

The degree of similarity between *electrically-powered motor scooters; mopeds; motorcycles* and *bicycles* is low and not just below average (14/05/2019, T-12/18, Triumph, EU:T:2019:328, § 30-34) (§ 44-46, 48).

In the same vein, the degree of similarity between *non-motorised push scooters* and *bicycles* is not average but low (28/11/2019, T-736/18, Bergsteiger, EU:T:2019:826, § 86) (§ 49-52).



21/12/2021, T-159/21, [motwi \(fig.\) / Monty et al.](#), EU:T:2021:924, § 44-46, 48

#### **2.2.4.3 Electric apparatus/ instruments**

##### ***Lighting apparatus for industrial use — Electric lights and decorations — Dissimilarity***

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

### **Electric lights; electric lighting fixtures — Lighting mixers — Similarity**

There is a low degree of similarity between goods in Class 11, such as *electric lights; electric lighting fixtures; flashing strobe light apparatus* and *lighting mixers* in Class 9 (§ 50-53).

02/12/2020, T-687/19, [Marq / MARK \(fig.\) et al.](#), EU:T:2020:582, § 50-53

### **2.2.4.4 Fashion and textile industries**

#### **Luggage and bags (especially sport bags) — Golf bags — Clothing — Similarity**

*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 — Similarity**

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, 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

#### **Woven fabrics; knitted elastic fabrics for sportswear; textile goods — Clothing — Towels — Dissimilarity**

*Woven fabrics; knitted elastic fabrics for sportswear; textile goods, and substitutes for textile goods; towels of textile; face towels; bath towels; hand towels; wash cloths* in Class 24 are dissimilar to *clothing* in Class 25 (§ 40 and 44).

*Woven fabrics; knitted elastic fabrics for sportswear* (Class 24) are dissimilar to *towels* (Class 24) (§ 49).

15/10/2020, T-851/19, [SAKKATTACK \(fig.\) / Body attack et al.](#), EU:T:2020:485, § 40, 44, 49  
15/10/2020, T-788/19, [Sakkattack \(fig.\) / Attack et al.](#), EU:T:2020:484, § 46-50, 55

**Goggles for sports — Bath towels — Clothing — Similarity — Textile goods, and substitutes for textile goods — Leather and imitations of leather — Similarity**

*Goggles for sports (snow goggles, cyclists' glasses, swim goggles)* in Class 9 are similar to a low degree to *clothing* in Class 25 (§ 100).

*Bath towels* in Class 24 are similar to an average degree to *clothing items* in Class 25 because the latter goods include bath robes (§ 128).

*Textile goods, and substitutes for textile goods; fabrics; textiles, not included in other classes* in Class 24 are similar to *leather and imitations of leather* in Class 18 on the basis that they are competing in primary materials and destined to same end users (§ 130).

09/09/2020, T-50/19, [Dayaday \(fig.\) - DAYADAY et al. \(fig.\)](#), EU:T:2020:407, § 100, 128, 130

**Leather and imitations of leather — Goods made of leather and imitations of leather — Animal skins, hides — Home textiles — Dissimilarity**

*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.

**Wallets, purses, briefbags, handbags (...) and clothing for women, men, young people and children (...) — Textiles and textile goods, not included in other classes; bed covers; table covers — Dissimilarity**

The goods in Class 18 (*wallets, purses, briefbags, handbags, casual bags, shopping bags, net bags for shopping, beach bags, holdalls, wheeled bags, bags (game -) [hunting accessories], bags for campers, bags for climbers, chests, backpacks, bookbags, suitcases, pouches, keycases, cases of leather or leatherboard, boxes of leather or leatherboard, waistpacks, leather straps, straps for soldiers' equipment*) and the goods of the earlier mark in Class 24 (*textiles and textile goods, not included in other classes; bed covers; table covers*) do not have the same intended purpose (the goods in Class 18 are intended to contain, collect, transport or store things, and the goods in Class 24 are fabrics for household use; functional and decorative goods able to serve both practical and ornamental purposes). Neither do they have the same distribution channels (the goods of the earlier mark are most often displayed near or on shelving units, whereas the contested goods are often displayed on shelves or in shops specialising in luggage or in clothing accessories). Furthermore, the manufacturers of those goods are not generally the same and the use of one is not necessary or important to the use of others. The goods are not therefore complementary or in competition (§ 45).

The goods in Class 25 (*clothing for women, men, young people and children, clothing of natural and synthetic materials, knitwear (clothing), work clothing, protective clothing, waterproof clothing, beach clothing, sports clothing, gymnastics clothing; underwear for women, men, young people and children, women's suits, jackets, dresses, evening dresses, skirts, blouses, sweatshirts, clothing, costumes, uniforms, togas, cassocks, chasubles, suits, tailcoats, waistcoats, shirts, polo shirts, short-sleeve shirts (t-shirts), corsets, vests, jumpers, pullovers; trousers, trousers shorts, bermuda shorts, shorts, astronaut flight suits, tracksuits, overalls, coats, topcoats, coats, trench coats, coats, pelerines, windshirts, socks, leg warmers, stockings, body garments, tights, tights, leggings, pyjamas; robes, swimming costumes, swimming trunks, suspenders, ties, bowties, scarfs, scarves, shawls, neckerchiefs; caps (headwear), berets; veils; gloves; baby sleepsuits, layettes*) and the goods of the earlier mark in Class 24 (*textiles and textile goods, not included in other classes; bed covers; table covers*), differ in many respects, such as in their nature, intended

purpose, origin and distribution channels. The fact that these goods can be made from the same materials does not call those differences into question (§ 46).

08/09/2021, T-493/20, [Sfora wear / Sfera \(fig.\) et al.](#), EU:T:2021:540, § 45-46

### **Orthopaedic footwear and boots for medical purposes — Health shoes — Similarity**

*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

### **Gymnastic and sports articles — Games and toys — Difficult delimitation**

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

#### **2.2.4.5 Food, beverages and restaurant services**

##### **Chips — Tortillas, tacos, cereal preparations, bread — Similarity**

*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 — Dissimilarity**

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

### **Bottled drinking water; mineral water (non-medicated -); mineral water [beverages] — Alcoholic beverages (except beer); wine; sparkling wines; liqueurs; spirits [beverages]; brandy — Dissimilarity**

Due to the absence of alcohol in their composition, the nature of the goods referred to as *bottled drinking water; mineral water (non-medicated -); mineral water [beverages]* covered by the mark applied for, is different to the nature of the goods covered by the earlier mark, namely *alcoholic beverages (except beer); wine; sparkling wines; liqueurs; spirits [beverages]; brandy* (§ 40). The effects of alcohol consumption do not occur in the consumption of bottled water or mineral waters (§ 42). Moreover, for a non-negligible part of the EU public, alcohol consumption is likely to pose a genuine health problem (§ 42). The purpose and method of use of the goods in question are different. In contrast to the beverages referred to as *bottled drinking water; mineral water (non-medicated -); mineral water [beverages]*, alcoholic beverages are not generally intended to quench thirst and do not correspond to a vital need (§ 43-44). The goods in question are not complementary; they are not closely connected in the sense that the purchase of one is indispensable or important for the use of the other (§ 46-47). They are not in competition with each other (§ 56-64). In relation to the distribution channels, the fact that these goods may be sold 'in the same establishments' does not support the conclusion that the goods are similar (§ 66-68).

22/09/2021, T-195/20, [chic ÁGUA ALCALINA 9,5 PH \(fig.\) / Chic Barcelona et al.](#), EU:T:2021:601, § 40, 42-44, 45-47, 66-68

### **Beer and brewery products — Wines — Similarity to a low degree**

*Beer and brewery products* in Class 32 and *wines* in Class 33 are similar only to a low degree, not to an average degree (18/06/2008, T-175/06, Mezzopane, EU:T:2008:212, § 63-70) (§ 102-103).

23/09/2020, T-601/19, [in.fi.ni.tu.de \(fig.\) / infinite](#), EU:T:2020:422, § 102-103  
15/09/2021, T-673/20, [CÍCLIC \(fig.\) / Cyclic](#), EU:T:2021:591, § 50

### **Liqueurs — Beer and other alcoholic beverages — Similarity**

Liqueurs and beers are similar in nature since they contain a certain degree of alcohol. Their method of use and method of consumption are similar, since they may, inter alia, be served at events, their intended purpose coincides in that they are aimed at the adult public, since alcohol is normally consumed by persons over 18 years old, and their distribution channels are the same, since they are sold in the same way. Moreover, it is a well-known fact that many undertakings produce both beer and liqueurs, which are often based on beer. Admittedly, it is apparent from the case-law that mixing beer with certain alcohols, in particular tequila, does not remove the differences between those goods (03/10/2012, T-584/10, Tequila Matador hecho en Mexico EU:T:2012:518, § 55). However, as regards liqueurs, the exact purpose of some of them is to be mixed, in particular with beer or wine. The difference in composition and method of production does not affect the consumer's perception (§ 67-73).

### **Liqueurs — Preparations for the manufacture of liqueurs — Similarity**

Liqueurs and preparations for the manufacture of liqueurs are complementary. They may coincide in producers and distribution channels and may be aimed at the same public. Therefore, they are similar to an average degree (§ 75).

28/04/2021, T-31/20, [THE KING OF SOHO \(fig.\) / SOHO](#), EU:T:2021:217, § 75

### **Liqueurs — Alcoholic essences and alcoholic extracts — Similarity**

Liqueurs, on the one hand, and alcoholic essences and alcoholic extracts, on the other, could coincide in producers and distribution channels and may be aimed at the same public. They are therefore similar to a low degree (§ 74).

28/04/2021, T-31/20, [THE KING OF SOHO \(fig.\) / SOHO](#), EU:T:2021:217, § 74

### **Services for providing food and drink; coffee-shop services; restaurants — Cheese — Similarity**

The goods in Class 29, inter alia, *cheese*, are necessarily used in the serving of food and drink, with the result that those goods and those services are complementary. Firstly, cheese may be offered to the clientele of many restaurants, or even of coffee shops, by being incorporated as an ingredient in dishes which are intended to be sold on the premises or to be taken away. Secondly, cheese, without being processed as an ingredient, may be sold as it is to consumers, in particular in restaurants in which the activity is not confined to the preparation and serving of cooked dishes, but also consists of selling food which is intended to be consumed away from the place in which it is sold. Such goods are therefore used in and offered by means of *services for providing food and drink, restaurant services or coffee-shop services*. Those goods are consequently closely connected with those services (§ 45).

The complementary connection between cheese and services for providing food and drink, restaurant services and coffee-shop services must lead to the finding that there is a certain degree of similarity between, on the one hand, *services for providing food and drink; coffee-shop services; restaurants* in Class 43 and, on the other hand, *cheese* in Class 29. The possibility that the relevant public might be led to think that the services and the goods at issue have the same commercial origin cannot, from the outset, be excluded (§ 50, 51).

21/04/2021, T-555/19, [Grilloumi / Halloumi](#), EU:T:2021:204, § 45, 50, 51

08/12/2021, T-556/19, [GRILLOUMI / HALLOUMI et al](#), EU:T:2021:864, § 42-44

### **Restaurant services (food), self-service restaurants, cafeterias — Dry pasta of Italian origin — Low degree of similarity**

Despite their differences, foodstuffs, including goods in Classes 29 and 30, and restaurant services have a certain degree of similarity for a number of reasons. Firstly, the foodstuffs concerned are used and offered in the context of restaurant services, so there is complementarity between those goods and services. Secondly, the restaurant services can be offered in the same places as those in which the foodstuffs concerned are sold. Lastly, the foodstuffs concerned may originate from the same undertakings or from economically linked undertakings that market packaged goods, or from restaurants that sell ready-made food to take away (05/07/2016, T-518/13, MACCOFFEE, EU:T:2016:389, § 80) (§ 128).

Having regard to the complementarity between the goods and services, the BoA was fully entitled to conclude that there was a low degree of similarity between the *restaurant services (food), self-service restaurants and cafeterias* covered by the mark applied for and the *dry pasta of Italian origin* covered by the earlier Italian figurative mark 'ZARA' (§ 132).

01/12/2021, T-467/20, [ZARA / ZARA \(fig.\) et al.](#), EU:T:2021:842, § 128, 132

### **Prepared meals, snacks, flour, pastry, rice — Couscous (semolina) — Similarity**

*Prepared meals, snacks; ready meals primarily with meat, fish, seafood or vegetables* in Class 29 are similar at least to a very low degree to *couscous (semolina)* in Class 30 (§ 78).

*Flour; pastry; prepared meals excluding meals which contain couscous; pastry dishes and pasta dishes excluding couscous; convenience food (excluding couscous) and savoury snacks; canned pasta foods excluding couscous; baked foodstuffs* in Class 30 are similar at least to a very low degree to *couscous (semolina)* in Class 30 (§ 93-119). A limitation in the list of goods – in this case, the exclusion of couscous – does not, on its own, preclude a finding of similarity between the goods (16/05/2017, T-85/15, YLOELIS / YONDELIS et al., EU:T:2017:336, § 31) (§ 109).

Rice in Class 30 is similar to an average degree to the opponent's *couscous (semolina)* in the same class (§ 120,127).

25/11/2020, T-309/19, [Sadia \(fig.\) / SAIDA](#), EU:T:2020:565, § 78, 109, 120, 127

### **Eggs — Meat — Similarity**

The goods *eggs* and *meat* in Class 29 are similar to at least a low degree on account of their nature, purpose, use, distribution channels and business origin (§ 63-67, 70). The goods are not however complementary (§ 67-69).

23/09/2020, T-737/19, [MONTISIERRA huevos con sabor a campo \(fig.\) / MONTESIERRA](#), EU:T:2020:428, § 67-69

### **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

#### **Similarity between goods and retail services only where the former are identical or similar to the goods to which the retail services relate**

*Retail and online retail store services* in Class 35 relating to goods in Class 3 and the *advertising; business management; business administration; office functions* services, are different from the goods in Class 5 covered by the earlier mark. More specifically, those goods and services are not

complementary since the retail and online retail services relate to goods in Class 3. However, none of those goods is similar or identical to the goods in Class 5 covered by the earlier mark. Therefore, there is no close relationship between the services in Class 35 covered by the mark applied for and the goods in Class 5 protected by the earlier mark such as to establish that those goods and services were complementary (§ 52-58).

15/09/2021, T-331/20, [Le-vel / Level](#), EU:T:2021:571, § 52-58, 63

### **Food retail services — Couscous (semolina) — Similarity**

*Food retail services; retail services relating to foodstuffs* in Class 35 are similar to an average degree to *couscous (semolina)* in Class 30 (§ 136).

Similarity can be found between retail services of certain goods and goods which are not strictly identical to the goods subject to retail (09/06/2010, T-138/09, Riojavina, EU:T:2010:226, § 41-44, and 05/05/2015, T-715/13, Castello (fig.) / Castelló y Juan S.A. (fig.) et al., EU:T:2015:256, § 29-35) (§ 141).

*Information, advisory and consultancy services in relation to food retail services; retail services relating to foodstuffs* in Class 35 have a very low degree of similarity with *couscous* in Class 30 (§ 143-145).

25/11/2020, T-309/19, [Sadia \(fig.\) / SAIDA](#), EU:T:2020:565, § 136, 141, 143-145

### **Spectacles — Retail store services for sunglasses — Robes — Household textiles and linen — Similarity**

*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 — Dissimilarity**

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 — Similarity**

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

### **Scope of protection 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* — Retail sales services’ is not a vague term**

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

#### **2.2.4.8 Financial services**

[No key points available yet.]

#### **2.2.4.9 Transport, packaging and storage**

##### ***Plastic safety boxes and closures therefor* — Diverse toolboxes — Identity**

*Plastic safety boxes and closures therefor* are identical to *boxes made of plastics materials for packaging of tools and machines as well as their parts and accessories; plastics components for*

*packaging containers for tools and machines as well as their parts and accessories; boxes (packaging -) in made-up form [plastic] for tools and machines as well as their parts and accessories; sales containers of plastic for tools and machines as well as their parts and accessories; electric boxes of plastic for tools and machines as well as their parts and accessories; tool storage containers (non-metallic -) [empty], in Class 20, which are in essence toolboxes (§ 42, 53).*

15/10/2020, T-49/20, [ROBOX / OROBOX](#), EU:T:2020:492, § 42, 53

#### **Plastic safety boxes and closures therefor — Plastic inserts [trays] for tool boxes — Similarity**

*Plastic safety boxes and closures therefor are similar to plastic inserts [trays] for tool boxes; organisation systems of plastic for toolboxes; sales packaging of plastic which also services as an organisation system for toolboxes in Class 20, which are in essence plastic accessories for toolboxes (§ 43, 53).*

15/10/2020, T-49/20, [ROBOX / OROBOX](#), EU:T:2020:492, § 42, 53

#### **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

##### **Computers — Smart phones — Similarity**

*Computers and smart phones; mobile phones; wearable smart phones in Class 9 have at least an average degree of similarity (§ 50-53, 55).*

18/11/2020, T-21/20, [K7 / K7](#), EU:T:2020:550, 50-53, 55

##### **Downloadable computer programs, being intended for use in connection with musical instruments and sound recording apparatus — Security software that allows users to secure and access their mobile devices through multi-dimensional facial recognition identification — Low degree of similarity between software due to different function**

Software must be understood in relation to the operations it performs and therefore in relation to its function. As such, the consumer will be guided primarily by the specific function of the product rather than by its nature (§ 51). Almost no electronic or digital equipment works without the use of computers. As a result, there exists a multitude of software with radically different functions (§ 52).

The function criterion, and therefore the criterion of intended use, assumes overriding importance among the relevant factors to be taken into account (software to be used with musical instruments and sound recording apparatus / security software to secure and access mobile devices through multi-dimensional facial recognition identification) (§ 53).

Where the intended purpose of the goods is specified with a certain degree of precision, it helps to differentiate them beyond their common nature as software (§ 57). They are not complementary (§ 58). The same distribution channels (App Store / Google Play Store) are a factor to be taken into account, but a multitude of software with radically different functions can be found in physical/virtual stores. Consumers will not automatically believe they have the same origin (§ 60). Users generally identify the desired function and then launch a search for all the applications available that perform that function. Even if a consumer searches for the desired application by name, the search will ultimately be guided by the desired function (§ 61).

In the present case, although software is involved for both signs, the intended purpose of the goods covered by the earlier figurative mark is to edit and alter sounds while recording, whereas the intended purpose of the goods covered by the contested mark is to enable users to secure and access mobile devices through multidimensional facial recognition identification (§ 49). There is only a low degree of similarity between the goods (§ 62).

30/06/2021, T-204/20, [ZOOM / ZOOM \(fig.\) et al.](#), EU:T:2021:391, 51-53, 61-62

### **Software products — Overlap between the intended purposes — Complementarity — Competitive relationship — Similarity**

The software products under comparison are similar to an average degree. Data processing concerning real estate covered by the earlier mark requires the features of organisation and management of internal data, which are also present in the data governance software products covered by the marks applied for. The facilities management or house and/or real estate administration software products covered by the earlier mark generate a large volume of data and incorporate certain functionalities for the organisation and management of that data, functionalities which they share with data governance software products. Therefore, there is an overlap between the intended purposes of the software products (§ 93-95).

The software products covered by the earlier mark, namely real estate management and facilities management software products, and the services covered by the word mark applied for in Class 42 concerning data governance software products, are similar. All these software products may be designed and developed by the same companies and, in the field of information technology, software manufacturers will also commonly provide software services. In addition, the end users and the manufacturers of the goods and services coincide (§ 121).

22/09/2021, T-128/20 & T-129/20, [Collibra / Kolibri et al.](#), EU:T:2021:603, § 93-95, 121

### **Application software — Social services, namely arranging groups sharing interests and dating via social networks — Dissimilarity**

*Application software* in Class 9 (without an indication of the nature of the application) and *providing use of software applications through a website* in Class 41 are dissimilar to *social services, namely arranging groups sharing interests and dating via social networks* in Class 45 (§ 81-83).

23/09/2020, T-421/18, [MUSIKISS / KISS \(fig.\) et al.](#), EU:T:2020:433, § 81-83

### **Entertainment services provided via a website — Social services, namely arranging groups sharing interests and dating via social networks — Dissimilarity**

*Entertainment services provided via a website* in Class 41 are dissimilar to *social services, namely arranging groups sharing interests and dating via social networks* in Class 45. They differ in nature and immediate purpose and there is no close complementary or competitive relationship between them (§ 75-76).

23/09/2020, T-421/18, [MUSIKISS / KISS \(fig.\) et al.](#), EU:T:2020:433, § 75-76

### **Radio broadcasting services — Advertising, including online — Dissimilarity**

Radio broadcasting services in Class 38 are dissimilar to advertising, including online, in particular advertisements, for others (§ 86-87) and to employment agencies, in particular in connection with music or for those interested in music in Class 35 (§ 94-96), due to, inter alia, the different nature and purpose of these services.

23/09/2020, T-421/18, [MUSIKISS / KISS \(fig.\) et al.](#), EU:T:2020:433, § 86-87, 94-96

### **Games and toys — Interactive television and/or audiovisual games — Similarity**

Games; toys in Class 28 are similar to interactive television and/or audiovisual games in Class 9 (§ 64). In the past, the Court has already found similarity between games in Class 28 and games in Class 9 (19/04/2016, T-326/14, HOT JOKER / JOKER et al., EU:T:2016:221, § 59) (§ 61).

16/12/2020, T-863/19, [PCG CALLIGRAM CHRISTIAN GALLIMARD / GALLIMARD et al.](#), EU:T:2020:632, § 61

## **2.2.4.11 Education**

### **Teaching and instructional and teaching material — Teaching and CDs, CD-ROMs, DVDs, computer software — Similarity**

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 — Dissimilarity**

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

### **Figurines for ornamental purposes — Lamp shades, lampshade holders, lighting lamps — candlesticks — Perfume vaporizers — Similarity**

Figurines for ornamental purposes in Classes 6, 19, 20 and 21 and lamp shades, lampshade holders, lighting lamps, standard lamps, electric lamps chandeliers, ceiling lights in Class 11,

picture frames; mirrors (looking glass); decorative panels; decorative wall plaques (not of textile) in Class 20, candlesticks; candelabras (candle holders); decanters; candlesticks; fruit cups; crystal (glassware); enamelled glass; signboards of porcelain or glass; candle extinguishers; earthenware, flasks, perfume vaporizers; vases in Class 21 are similar to a low degree (§ 51).

23/09/2020, T-608/19, [Veronese \(fig.\) / VERONESE](#), EU:T:2020:423, § 51

### **Sporting activities — Gambling and gaming services — Similarity — Cultural activities — Services of editing or recording of sounds and images — Similarity**

Sporting activities in Class 41 are similar to a low degree to *gambling and gaming services* in the same class, since the services under comparison are complementary and coincide in their purpose and their marketing channels (§ 36-38, 40). *Cultural activities* in Class 41 are also similar to a low degree to the *services of editing or recording of sounds and images, sound recording services, and video entertainment and gaming services* in the same class (§ 42).

25/11/2020, T-874/19, [Flaming forties / 40 FLAMING FRUITS \(fig.\)](#), EU:T:2020:563, § 36-38, 40, 42

## **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 trademarks — Illegibles word elements**

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 (02/07/2008, T-340/06, Stradivari 1715, EU:T:2008:241, § 34).

That is so in the present case with respect to the word element 'ac' [in the sign applied for] in view of its very small size and less prominent position in the sign applied for, which make it hardly noticeable at first sight. Moreover, the average consumer will have even greater difficulty reading it because he does not proceed to analyse the various details of a mark when making a purchase (§ 41).



19/06/2019, T-28/18, [AC MILAN \(fig.\) / AC et al.](#), EU:T:2019:436, § 41, 116

### **Assessment of the similarity between the signs — Irrelevance of the distinctive character (inherent or through reputation)**

The distinctive character (inherent or through reputation) of the earlier mark is not relevant for the assessment of the similarity between the signs (11/06/2020, C-115/19 P, CCB (fig.) / CB (fig.) et al, EU:C:2020:469, § 56-59) (§ 42, 44).

16/06/2021, T-196/20, [Incoco / Coco et al.](#), EU:T:2021:365, § 42, 44

### 2.3.1.3 Weak or descriptive elements

#### No LOC — Low distinctive character of common verbal element — Respective weight of the word and figurative elements

Where a sign consists of both figurative and word elements, it does not automatically follow that the word elements must always be considered to be more distinctive than the figurative elements. In the case of a composite mark, the figurative element may, in particular on account of its shape, size, colour or position in the sign, rank equally to the word element (23/11/2010, T-35/08, Artesa Napa Valley, EU:T:2010:476, § 37, 39) (§ 68, 74, 79, 95).



23/09/2020, T-608/19, [Veronese \(fig.\) / VERONESE](#), EU:T:2020:423, § 68, 74, 79, 95

#### No LOC — Respective weight of word elements and figurative elements — Descriptive element as part of a composite mark

The public will not generally consider a descriptive or weakly-distinctive element forming part of a composite mark to be the distinctive and dominant element in the overall impression conveyed by that mark (§ 57). In a composite sign, the figurative element may therefore rank at least equally with the word element (24/10/2018, T-63/17, Bingo VIVA! Slots (fig.) / vive bingo (fig.), EU:T:2018:716, § 43 and the case-law cited) (§ 58).

The relevant Greek public's knowledge of English as a foreign language cannot, in general, be assumed. According to the submitted evidence, the Greek public has different levels of knowledge of English. The relevant Greek public will understand the word 'museum' (not disputed), however a non-negligible part of the relevant Greek public will not understand the word 'illusions' (§ 52). The existence of the 'museum of illusions' in Athens does not make it possible to conclude that the whole of the relevant Greek public knows the term 'illusions' (§ 53).

The part of the relevant Greek public that does not understand the word 'illusions' will perceive the expression which is common to the signs, namely 'museum of illusions', as referring to a museum of the same type or relating to the same theme, even though it will remain unaware of the specific type or theme of that museum (§ 54-55). Consequently, even for the part of the relevant Greek public that does not understand the word 'illusions', the expression will be perceived as being descriptive of the services, namely museum services. The expression 'museum of illusions' contained in the signs is therefore of weak inherent distinctive character (§ 56-58). Accordingly, the expression 'museum of illusions', considered as a whole, does not constitute the dominant element in the signs (as the BoA incorrectly concluded), but contributes in the same way as the figurative elements of those signs to the overall impression created by those signs (§ 59-60).



12/05/2021, T-70/20, [MUSEUM OF ILLUSIONS \(fig.\) / MUSEUM OF ILLUSIONS \(fig.\)](#), EU:T:2021:253, § 52-60

#### No LOC — Weakly distinctive elements — Degree of distinctive character to be taken into account in the comparison of the signs — Impacts of the endings of word marks

Where the endings of word marks composed of two elements possess no visual, phonetic or even conceptual similarity, they are able to compensate for the visual, phonetic and even conceptual similarities that result from the presence of the weakly-distinctive beginning component, 'natura', common to both signs (§ 43, 44, 50). Since the inherent distinctiveness of the earlier mark in the light of the two components of the word sign is weak (§ 75), the signs are globally different in the overall impression they produce in the mind of the relevant public (§ 76). There is no LOC, notwithstanding the identity of the goods (§ 77).

For a trade mark of weak distinctive character, the degree of similarity between the signs should be high to justify a LOC, otherwise there would be a risk of granting excessive protection to that trade mark and its proprietor (§ 56).

05/10/2020, T-602/19, [Naturanove-Naturalium](#), EU:T:2020:463, § 43, 44, 50, 56, 55-77

**No LOC — Common descriptive element — Degree of distinctive character to be taken into account in the comparison of the signs— Weak distinctiveness of the earlier mark**

Where the elements of similarity between two signs relate to the fact that they share a weakly distinctive component, the impact of such elements of similarity in the global assessment of the LOC is itself weak (22/02/2018, T-210/17, TRIPLE TURBO (fig.) / ZITRO TURBO 2 (fig.), EU:T:2018:91, § 73; 13/12/2007, T-242/06, El charcutero artesano, EU:T:2007:391, § 85, and 04/03/2015, T-558/13, FSA K-FORCE, EU:T:2015:135, § 49-52).

Bearing in mind the, at best, weak visual, phonetic and conceptual similarity between the signs, the fact that they share a descriptive element, the weak distinctiveness of the earlier EU trade mark and the high level of attention of the professional public, there is no LOC, even though the services in question are identical. This finding also applies to the earlier UK trade marks (§ 59).



**WORKSPACE**

28/05/2020, T-506/19, [Uma workspace / WORKSPACE \(fig.\) et al.](#), EU:T:2020:220, § 49-52, 59

**No LOC — Weak distinctive character of elements of the earlier mark — Shape marks — Application of 12/01/2006, C-173/04 P, Standbeutel, EU:C:2006:20, § 34 to relative grounds**

The BoA was right in taking into account a sector wider than that of mineral water. The earlier mark represents a transparent bottle of a common shape in the wide sector of beverage packaging and does not have any particular appearance that differentiates it from the conventional presentation of bottles on the market. Therefore, such a shape does not constitute an indication of origin, as it is not capable of individualising the relevant goods and services and distinguishing them from those having another commercial origin. It has, at most, a weak inherent distinctive character (§ 66-67).



12/05/2021, T-637/19, [Aqua Carpatica \(3D\) / VODAVODA \(3D\)](#), EU:T:2021:222, § 66-67



12/05/2021, T-638/19, [AC Aqua AC \(3D\) / VODAVODA \(3D\)](#), EU:T:2021:256, § 66-67

## **LOC — Distinctive and dominant elements — Abbreviations — Distinctive element not perceived as descriptive for a significant portion of the relevant public — Weak elements**

The element ‘hylo’ of the earlier mark is a Greek-language prefix used in relation to wood or materials. In German, it is used in the word ‘hylotrop’, which, according to the Duden online dictionary ([www.duden.de](http://www.duden.de)), relates to ‘chemical compositions that can be converted into other forms’. The use of a term in extracts from Internet sites cannot suffice to establish the frequency with which that term is used, even by a specialist public (16/12/2010, T-286/08, Hallux, EU:T:2010:528, § 47) (§ 58). For a significant portion of the relevant public, that term, which is not frequently used in German, does not have any meaning. Therefore, it is not perceived by a significant portion of that public as being descriptive of the goods of the earlier mark (§ 57, 60).

The element ‘vision’ common to the marks has a weak distinctive character (§ 66). The ‘hydro’ of the mark applied for will be perceived by the relevant public as referring to water and therefore has a weak distinctive character (§ 67). Also, the figurative element is of weak distinctive character (§ 69). All the elements of the signs have to be considered in the context of their comparison (§ 73).

The signs have an average degree of visual similarity (§ 82) and a high degree of phonetic similarity (§ 89), and are conceptually similar in part for the part of the relevant public that understands the term ‘vision’ (§ 95). Even if the earlier mark has an average degree of distinctiveness (§ 108), the identity of the goods and the similarities between the signs are sufficient to conclude that there is a LOC for the German-speaking part of the relevant public (§ 118).

**Hydrovision**

27/01/2021, T-817/19, [Hydrovision \(fig.\) / Hylo vision](#), EU:T:2021:41, § 57-60, 67, 73, 82, 95, 108, 118

### **2.3.1.4 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

### **2.3.1.5 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

### Figurative element and verbal element — Low distinctive character of common verbal element

Where a sign consists of both figurative and word elements, it does not automatically follow that the word elements must always be considered to be more distinctive than the figurative elements. In the case of a composite mark, the figurative element may, in particular on account of its shape, size, colour or position in the sign, rank equally to the word element (23/11/2010, T-35/08, Artesa Napa Valley, EU:T:2010:476, § 37, 39) (§ 68, 74, 79, 95).



23/09/2020, T-608/19, [Veronese \(fig.\) / VERONESE](#), EU:T:2020:423, § 68

### Examination of the intrinsic qualities of the figurative and word elements and their position

It is appropriate to examine the intrinsic qualities of the figurative and word elements of the mark applied for, as well as their respective positions, in order to identify, where appropriate, whether one of those elements is dominant (09/02/2017, T-82/16, TRIPLE EVOLUTION (fig.) / Evolution, EU:T:2017:66, § 35) (§ 37).



15/10/2020, T-349/19, [athlon custom sportswear \(fig.\) / Decathlon](#), EU:T:2020:488, § 37

### 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

## **Relevant public's knowledge of a language other than its mother tongue — Burden of proof — Breaking down of verbal elements — Common element**

In the absence of evidence provided by the parties, knowledge of the German language in Spain, Italy and France does not have the character of well-known fact, as is the case for English in the Scandinavian countries, the Netherlands and Finland, for example (§ 29-30).

A word sequence in a foreign language may still be remembered even though it is not easy to pronounce for the majority of the relevant public in the EU, who do not understand the language. The average consumer, perceiving a word sign, will break it down into word elements that have a concrete meaning for them, or that resemble words known to them (19/05/2011, T-580/08, Pepequillo, EU:T:2011:227, § 74) (§ 61).

23/09/2020, T-401/19, [Freude an Farbe \(fig.\) / Glemadur Freude an Farbe \(fig.\)](#), EU:T:2020:427, § 29-30  
23/09/2020, T-402/19, [Freude an Farbe \(fig.\) / Glemadur Freude an Farbe \(fig.\)](#), EU:T:2020:429, § 61

## **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

### Breaking down of verbal elements — Meaning by regrouping elements

When perceiving a word sign, the average consumer will recognise word elements which suggest a specific meaning or which resemble familiar words (08/07/2015, T-548/12, REDROCK, EU:T:2015:478, § 37). For signs composed of several word elements reproduced separately, the relevant public understands the meaning by regrouping these elements to form expressions that convey a precise meaning or resemble recognised words, especially when that understanding requires no particular intellectual effort (06/09/2013, T-599/10, Eurocool, EU:T:2013:399, § 101-109). The word element 'infinite' has a very strong resemblance to the Spanish word 'infinitud', a feminine noun used to describe the state or quality of being infinite or without limits (not disputed). Despite the separation by dots and spaces, the relevant public will immediately identify that meaning (§ 108-112).

*in · fi · ni · tu · de* 23/09/2020, T-601/19, [in.fi.ni.tu.de \(fig.\) / infinite](#), EU:T:2020:422, § 101-112

### 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

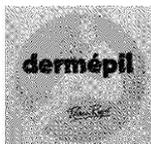
The letters 'mg' are the most distinctive element of the earlier mark (§ 35). The fact that the letters 'mg' are present in both marks is sufficient to establish the existence of phonetic and visual similarity between them, even though the position of these letters differs in the marks (§ 36). Therefore, 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

## Distinctive and dominant elements – Mark consisting of a combination of a first name and surname

The BoA was mistaken in automatically applying, without taking due account of the specific features of the present case, the rule that in certain Member States consumers remember surnames rather than first names (§ 35). MILEY CYRUS refers to the first name and surname of the famous singer and actress, who is known by that first name and that surname together, and

not by her first name or surname separately (§ 37). The two elements are equally distinctive, and one cannot therefore be considered dominant in relation to the other (§ 38).



16/06/2021, T-368/20, [Miley cyrus / Cyrus \(fig.\) et al.](#), EU:T:2021:372, § 35, 37-38

## 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).



07/02/2019, T-656/17, [Dr. Jacob's essentials \(fig.\) / COMPAL essential \(fig.\) et al.](#), EU:T:2019:71, § 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

### **Sole component of the earlier mark included in its entirety within the mark applied for**

When the sole component making up the earlier mark is included in its entirety within the mark applied for, the signs at issue are partially identical in such a manner as to create a certain impression of similarity in the mind of the relevant public (11/07/2018, T-694/17, SAVORY DELICIOUS ARTISTS & EVENTS (fig.) / AVORY, EU:T:2018:432, § 43 and case-law cited) (§ 78).



**KISS COLOR** 25/11/2020, T-802/19, [KISS COLOR \(fig.\)-Kiss et al](#), EU:T:2020:568, § 78

### **No LoC — Verbal element not discernible due to its high stylisation — Dissimilarity of the signs**

The average consumer will not spend time, in a purchasing situation, trying to analyse whether there are any letters or words hidden in the representation of a fish. Where the term ('blink') has no meaning for the relevant (German) public, it is even less likely that an average consumer will identify that word in the contested mark (§ 51).

The contested mark is perceived as the representation of a stylised fish and the relevant public does not associate that figurative element with any particular meaning other than that of a fish (§ 52). The signs are visually dissimilar and cannot be compared phonetically because it is not possible to pronounce the contested mark (§ 68). A conceptual comparison is not possible since the earlier mark has no meaning (§ 69). Therefore, there is no LOC (§ 70).



24/03/2021, T-354/20, [Representation of a fish \(fig.\) / Blinka](#), EU:T:2021:156, § 51-52, 68-70

### **No LOC — Verbal element not discernible due to its high stylisation**

The stylisation of the letters neutralises the allegation that both signs contain the letters 'GT' (§ 67-69). It is for the opponent to prove that consumers would perceive the earlier sign as reading 'GT' (19/12/2019, T-743/18, IJTII. J. TOBACCO INDUSTRY (fig.) / JTi (fig.), EU:T:2019:872) (§ 70) and proof of reputation is irrelevant in this respect (§ 71).



01/09/2021, T-463/20, [Gt racing / GT \(fig.\) et al.](#), EU:T:2021:530, § 70-71

### **LOC — Average visual similarity**

The contested mark has a fairly stylised gold font. The lower leg of the letter 'g' of the word 'king' constitutes the final letter 'o' of the word 'Soho'. The word element 'king', even written in lower-case letters, is as large as the word element 'Soho'. Placed above that word element, it is therefore read first. On account of those differences, there is only an average visual similarity. The fact that the word element 'king' has a weak distinctive character is not sufficient to call that conclusion into question (§ 98).



28/04/2021, T-31/20, [THE KING OF SOHO \(fig.\) / SOHO](#), EU:T:2021:217, § 98

## LOC — Earlier word mark — Possible use — Visual similarity to a high degree

Since the earlier mark is a word mark, it may be used by its owner in different graphic representations. In particular, there is nothing to prevent it from being presented in the same font as the mark applied for (§ 95).

 01/09/2021, T-23/20, [the DoubleF \(fig.\) / The double](#), EU:T:2021:523, § 95

## Dominant and distinctive elements — Distinctiveness of geographical names — Dominant element

The word element 'kerrygold' is the dominant element of the earlier mark, rather than its figurative elements, on account of its size and position (§ 50, 84-86, 89-94).

The word 'kerry', in relation to dairy products such as butter, milk or cheese, is likely to be understood as a reference to the geographical location of County Kerry, Ireland, by members of the European public who live in Ireland, who have visited Ireland or, possibly, who live in the UK, because of its proximity to Ireland (§ 61). However, the applicant adduced no evidence capable of establishing that the term 'kerry', associated with the goods, will be understood by the relevant European public as a whole, as a geographical indication (§ 65-69, 75, 82-83). Accordingly, there is no clear indication that the non-English-speaking public of mainland Europe would understand the term 'kerry' as a geographical indication of the goods (§ 76, 83). Therefore, the term 'kerry' included in the earlier mark has, for the majority of the relevant public, except the Irish public and possibly the UK public, distinctive character in relation to the goods for which the earlier mark was registered (§ 83).

Within the overall assessment of LOC, the combined term 'Kerrygold', which, as a whole, has no relevant meaning for a large part of the relevant public of the EU, confers an average degree of distinctiveness on the earlier mark (§ 137). The signs are visually and phonetically similar to an average degree (§ 101-107, 113-116, 138). Conceptually, the signs are not similar for the part of the relevant public that is unaware of the geographical reference contained in the term 'kerry' (§ 125). Therefore, there may be a LOC in respect of the identical or similar goods for the part of the relevant public which is not aware of the geographical reference contained in the word 'kerry' and which corresponds to a large part of the relevant public. The element 'kerry', which is common to the signs, could lead consumers to think that the mark applied for is an additional version of the earlier mark (§ 130, 137-139).

A LOC is however excluded, as the BoA correctly stated, for the dissimilar goods, namely *meat, fish, poultry and game and preserved, dried and cooked fruits and vegetables* in Class 29 (not disputed) (§ 47).



10/03/2021, T-693/19, [KERRYMAID / Kerrygold \(fig.\)](#), EU:T:2021:124, § 47, 50, 65-69, 75-76, 82-86, 89-94, 101-107, 113-116, 125, 130, 137-139

## Assessment of the visual similarity — Irrelevance of analysis of possible meanings of the signs

The assessment of the visual similarity does not presuppose, in principle, a prior intellectual effort to understand the meaning of the signs in conflict (§ 44, 56).

16/06/2021, T-196/20, [Incoco / Coco et al.](#), EU:T:2021:365, § 44, 56

### **Visual comparison of word marks — Differences in the initial parts of word marks — Different number of syllables — Syllables composed of a single vowel**

The presence in each of the word marks of several letters in the same order may be of some importance in the assessment of the visual similarities between the signs (§ 27).

Since all letters except for the first are identical and four letters are in the same order, the difference created by the differing first letters of the signs is not sufficient to offset the visual similarity resulting from the common presence of the other letters (§ 29).

Although the signs contain a different number of syllables, four and three respectively, this cannot automatically preclude the finding that there is an average degree of similarity between them. The first syllable in the earlier mark is limited to a single vowel, 'a', and thus has less of an impact on the phonetic impression created by that mark than the other syllables in the mark (§ 35).

08/09/2021, T-584/20, [Korsuva / Arosuva](#), EU:T:2021:541, § 27-29, 35

### **Low visual similarity — Similarities at the beginning of the signs offset by the differences in the middle and at the end — Short word elements — Descriptive figurative element**

The similarities at the beginning of the signs are offset by the differences in the middle and at the end, which are more significant because the word elements are short (only five letters) (§ 71).

The letter 'w' is unusual in Spanish and this confers an original character on the mark applied for, which is likely to attract the attention of the relevant public (§ 71).

Although the figurative element is descriptive, the fact that it is almost half the size of the mark means it is far from insignificant (§ 71).



21/12/2021, T-159/21, [motwi \(fig.\) / Monty et al.](#), EU:T:2021:924, § 71

#### **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).



§ 43-44x

24/09/2019, T-356/18, [V V-WHEELS \(fig.\) / VOLVO \(fig.\) et al.](#), EU:T:2019:690,

##### **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).

**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

**Three dimensional mark — Visual similarity — Phonetic dissimilarity — Conceptual dissimilarity — Necessity to carry out a global assessment of the LOC**

In light of the fact that the marks under comparison are at least visually similar, the BoA should have carried out a global assessment of the LOC, taking into consideration all of the relevant factors (04/03/2020, C-328/18 P, BLACK LABEL BY EQUIVALENZA (fig.) / LABELL (fig.) et al., EU:C:2020:156, § 75-76). The BoA should have also taken the degree of visual similarity between the signs into consideration (§ 64).



09/12/2020, T-620/19, [JC JEAN CALL Champagne ROSÉ Bottle \(3D\)-Bottle \(3D\)](#), EU:T:2020:593, § 64



09/12/2020, T-621/19, [JC JEAN CALL Champagne GRANDE RESERVE bottle \(3D\)-Bottle \(3D\)](#), EU:T:2020:595, § 64



09/12/2020, T-622/19, [JC JEAN CALL Champagne PRESTIGE Bottle \(3D\)-Bottle et al \(3D\)](#), EU:T:2020:594, § 64

### 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

##### Identical numbers placed at the beginning of the mark

The degree of phonetic similarity between the signs 5Ms (fig.) and 5J (fig.) is average since they share the number five placed at the beginning of their word elements, to which consumers generally pay greater attention and which plays a decisive part in the phonetic assessment of the mark applied for (12/12/2017, T-815/16, opus AETERNATUM / OPUS, EU:T:2017:888, § 60) (§ 49). This is all the more so when, for a significant part of the relevant public, the pronunciation of the number five is longer than the pronunciation of the second part of the word elements of the signs, i.e. the letter 'j' or the combination of the letters 'M' and 's' respectively (§ 50).



02/12/2020, T-639/19, [5MS MMMMM \(fig.\) / 5J \(fig.\)](#), EU:T:2020:581, 50

##### Phonetical comparison of the signs — Stylisation of letters — Illegible signs

Illegible signs cannot be pronounced so no phonetical comparison is possible (§ 72).



01/09/2021, T-463/20, [Gt racing / GT \(fig.\) et al.](#), EU:T:2021:530, § 72

#### 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

## Phonetic comparison not possible — Knowledge of the existence of a letter of the alphabet which does not exist in the languages understood by the relevant public

Knowledge of the existence of a letter of the alphabet which does not exist in the languages understood by the relevant public cannot be assumed (§ 39-41). As regards the pronunciation of letters which do not exist in the languages understood by the relevant public, the case-law according to which it is difficult to establish with certainty how the average consumer will pronounce a word from a foreign language in his own language, must be applied. According to that case-law, it is far from certain that the word will be recognised as being foreign and even if it is, it may not be pronounced correctly as it is in the original language. In the assessment of LOC, it will also still be necessary to establish that a majority of the relevant public is able to pronounce the word in question correctly (§ 41-42).



14/07/2021, T-399/20, [Ø \(fig.\) / DEVICE OF A CIRCLE CROSSED BY A VERTICAL LINE \(fig.\) et al.](#), EU:T:2021:442, § 39-42

## Likelihood of confusion — Phonetical comparison of figurative signs — Semantic content must immediately be associated with a specific, concrete word

A phonetic comparison of the signs is irrelevant in the examination of the similarity of a purely figurative mark with another mark (§ 69). A phonetic comparison between a figurative mark containing a word element and a purely figurative mark implies that the semantic content of the latter mark can immediately be associated with a specific, concrete term (03/05/2017, T-681/15, REPRÉSENTATION D'UNE TÊTE DE LOUP (fig.) / WOLF Jardin (fig.) et al., EU:T:2017:296, § 52-53; 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, § 34-36) (§ 71-72, 75, 80-82). In the present case, the figurative mark can be referred to orally in different ways, and it is not possible therefore to attribute a sound to it (§ 75). The BoA correctly found that a phonetic comparison was not possible (§ 83). The signs are conceptually similar to at least an average degree (§ 103).

Considering the particular importance of the visual aspect in the clothing industry (§ 111-113), there is a likelihood of confusion between the signs for the English-speaking public of the EU with an average level of attention for identical or similar goods and services (§ 120).

1<sup>st</sup> AMERICAN



21/12/2021, T-699/20, [1<sup>st</sup> AMERICAN \(fig.\) / DEVICE OF A BIRD \(fig.\)](#), EU:T:2021:928, § 48, 51, 60, 63, 69, 71-72, 75, 80-82, 83, 103, 120

### 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

## Limited role of the conceptual comparison — Common weakly distinctive word element

When the signs are conceptually similar due to a common element that only has a weak distinctive character (insofar as it describes certain characteristics of the goods covered), then conceptual similarity only plays a limited role in the assessment of LOC (26/11/2015, T-262/14, BIONECS / BIONECT, EU:T:2015:888, § 67 and case-law cited) (§ 62).



09/09/2020, T-589/19, [Fair Zone / FAIR \(fig.\)](#), EU:T:2020:397, § 62

## Limited role of the conceptual comparison — Common weakly distinctive word element

Even though the relative weight of a shared descriptive element is considerably reduced in the visual or phonetic comparison of the signs, its presence must still be taken into account in the comparison (26/11/2015, T-262/14, BIONECS / BIONECT, EU:T:2015:888, § 49 and 56) and cannot be disregarded (§ 72) (07/11/2017, T-144/16, MULTIPHARMA / MUNDIPHARMA, EU:T:2017:783, § 42 and 49) (§ 72-74).

15/10/2020, T-49/20, [ROBOX / OROBOX](#), EU:T:2020:492, § 72-74

## 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

## Lack of knowledge of the existence of a letter of the alphabet which does not exist in the languages understood by the relevant public — Consequence for conceptual comparison

Knowledge of the existence of a letter of the alphabet which does not exist in the languages understood by the relevant public cannot be assumed (§ 39-41). As regards the pronunciation of letters which do not exist in the languages understood by the relevant public, the case-law according to which it is difficult to establish with certainty how the average consumer will pronounce a word from a foreign language in his own language, must be applied. According to that case-law, it is far from certain that the word will be recognised as being foreign and even if it is, it may not be pronounced correctly as it is in the original language. In the assessment of LOC, it will also still be necessary to establish that a majority of the relevant public is able to pronounce the word in question correctly (§ 41-42).

A conceptual comparison is likewise not possible where no evidence is produced capable of demonstrating, that the relevant public would identify the marks for as a representation of a letter used in a foreign language and that that public would understand the meaning of the mark (§ 54).



14/07/2021, T-399/20, [Ø \(fig.\) / DEVICE OF A CIRCLE CROSSED BY A VERTICAL LINE \(fig.\) et al.](#), EU:T:2021:442, § 39-42, 54

### Conceptual Dissimilarity — Specific meaning — No meaning

The signs are conceptually different, since the earlier mark has a specific meaning, whereas the contested mark has no meaning (19/09/2017, T-768/15, RP ROYAL PALLADIUM (fig.) / RP, EU:T:2017:630, § 88-89) (§ 87).



02/12/2020, T-687/19, [Marq / MARK \(fig.\) et al.](#), EU:T:2020:582, § 87

### Conceptual similarity — Common element having a very low degree of distinctiveness

Where the common concept to which the signs refer is conveyed by a term which, at most, has a very low degree of distinctiveness, this does not preclude a finding that there is – to varying degrees – a conceptual similarity (§ 61).

24/03/2021, T-168/20, [Creatherm / Ceretherm](#), EU:T:2021:160, § 61

### Conceptual similarity — Imperfect recollection — No necessity of relation between concept and goods and services

From a conceptual point of view, the earlier mark 'KOLIBRI' may, in German, refer to a hummingbird. A significant part of the relevant German public may also perceive in the marks applied for, 'COLLIBRA' and 'collibra', an allusion to the concept of a hummingbird, given the similarity in the pronunciation of the words 'collibra' and 'kolibri'. The average consumer normally perceives a mark as a whole and does not engage in an analysis of its details. When perceiving a word sign however, he or she will recognise word elements which, for him or her, suggest a specific meaning or which resemble words known to him or her. The fact that the concept of a hummingbird bears no relation to the goods and services covered by the marks applied for is irrelevant given that these marks resemble the German word 'kolibri', which is known by a non-negligible part of the German public. Consequently, there is a high degree of conceptual similarity between the signs (§ 69).



22/09/2021, T-128/20 & T-129/20, [Collibra / Kolibri et al.](#), EU:T:2021:603, § 69

### Conceptual comparison requiring prior translation

'AQUA' is a common Latin term, meaning 'water', which the EU consumer may be assumed to know (28/11/2013, T-410/12, vitamin aqua, EU:T:2013:615, § 57). Furthermore, the meaning of 'aqua' will be understood by Romanian, Portuguese, Spanish, Italian and French consumers. As for the term 'VODA', it means 'water' and is understood by the part of the relevant public that understands Slovenian, Czech, Bulgarian, Polish or Slovak (§ 84-85).

For a significant part of the relevant public (namely EU consumers to whom the Latin term 'aqua' is well-known and those who understand the term 'voda') there will be a certain conceptual similarity requiring prior translation, given the identical meaning of those two terms. However, that similarity results solely from the descriptive elements 'aqua' and 'voda' which convey the same concept of 'water' in two different languages. Due to the weak distinctive character of the common concept of 'water', a conceptual comparison, requiring prior translation, is possible in these

circumstances. The signs at issue have, at most, an average degree of conceptual similarity in that they refer to the same concept of ‘water’ (§ 87-88).



12/05/2021, T-637/19, [Aqua Carpatica \(3D\) / VODAVODA \(3D\)](#), EU:T:2021:222, § 84-85, 87-88



12/05/2021, T-638/19, [AC Aqua AC \(3D\) / VODAVODA \(3D\)](#), EU:T:2021:256, § 84-85, 87-88

### Conceptual comparison — No consideration of evidence of use

In the context of the assessment under Article 8(1)(b) EUTMR, the conceptual analysis of the earlier mark must be limited to the mark as such and cannot be derived from the analysis of the evidence of use (§ 110).

 01/09/2021, T-23/20, [the DoubleF \(fig.\) / The double](#), EU:T:2021:523, § 110

#### 2.3.4.2 Names

### Conceptual comparison of signs referring to surnames or first names of persons

As regards the conceptual comparison in the case of signs referring to surnames or first names of persons, according to one line of case-law the fact that marks contain surnames or first names raises the possibility of a conceptual comparison, but does not necessarily imply that there is a conceptual similarity, which can result only from an examination of each individual case. According to a second line of case-law, a conceptual comparison between trade marks composed of surnames or first names of persons is in principle impossible and neutral, unless there are special circumstances which make such a comparison possible, for example, the celebrity of the person concerned or the semantic content of a name (16/12/2020, T-863/19, Pcg Calligram Christian Gallimard / Gallimard, EU:T:2020:632, § 101-106 and the case-law cited, under appeal) (§ 63).



30/06/2021, T-531/20, [ROLF \(fig.\) / Wolf et al.](#), EU:T:2021:406, § 63

### No LOC — Conceptual Dissimilarity — Personal name mark — Reputation of the earlier mark

Within the global assessment of LOC, the reputation or recognition enjoyed by the earlier mark must be taken into account. However, account must also be taken of whether the person who requests that their first name and surname, taken together, be registered as a trade mark is well known, since that factor may obviously influence the perception of the mark by the relevant public (24/06/2010, C-51/09 P, Barbara Becker, EU:C:2010:368, § 37) (§ 46-48).

17/09/2020, C-449/18 P & C-474/18 P, [MESSI \(fig.\) / MASSI et al.](#), EU:C:2020:722, § 46-48

## No LOC — Common first name less distinctive than family name

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).

The element ‘ferragni’ will be memorised by the consumer as a more distinctive element than the first name, taking into account that Ferragni is an uncommon surname in the Benelux territory, and rarer than the name Chiara (perceived as an Italian common name insofar as this name is known in the local language versions, i.e. the French (‘Claire’) and German (‘Klara’) versions (§ 70). The mark applied for also includes a figurative element with clear semantic content (§ 73). Taking into account the visual differences between the signs, there is no LOC (§ 84-86).



08/02/2019, T-647/17, [CHIARA FERRAGNI \(fig.\) / Chiara](#), EU:T:2019:73, § 69-70, 73, 84-86

## Distinctive and dominant elements – Mark consisting of a combination of a first name and surname

The BoA was mistaken in automatically applying, without taking due account of the specific features of the present case, the rule that in certain Member States consumers remember surnames rather than first names (§ 35). MILEY CYRUS refers to the first name and surname of the famous singer and actress, who is known by that first name and that surname together, and not by her first name or surname separately (§ 37). The two elements are equally distinctive, and one cannot therefore be considered dominant in relation to the other (§ 38).



16/06/2021, T-368/20, [Miley cyrus / Cyrus \(fig.\) et al.](#), EU:T:2021:372, § 35, 37-38

## Conceptual comparison – Mark consisting of a combination of a first name and surname – Conceptual neutralisation

Since Miley Cyrus is a public figure of international reputation known to most well-informed, reasonably observant and circumspect people who read the press, watch television, go to the cinema or listen to the radio, where they can see her or listen to her sing, or where she is regularly spoken of, the relevant public will understand the mark applied for to be the name of the famous American singer and actress (§ 51).

A conceptual comparison is possible where the first name or the surname in question has become the symbol of a concept, due, for example, to the celebrity of the person with that first name or surname, or where that first name or surname has a clear and immediately recognisable semantic content (§ 54). This is the case here. The BoA should have concluded, on the basis of its own findings, that the relevant public was likely to make a conceptual association between the group of words ‘miley cyrus’ and the name of the famous American singer and actress. Miley Cyrus has become the symbol of a concept, due to the celebrity of the person with that name (§ 56).

The mere fact that the surname Cyrus is not common, does not mean that the relevant public will perceive that word, taken alone, as referring to the famous singer and actress Miley Cyrus, who, according to the evidence, has never specifically used the name Cyrus in isolation during her career. It must therefore be held that the earlier mark has no particular semantic meaning for the relevant public (§ 58). The signs in question are therefore conceptually different (§ 59).

According to case-law, such conceptual differences may counteract, in certain circumstances, phonetic and visual similarities between the signs in question. For this to be the case, at least one of the signs must have a clear and specific meaning for the relevant public allowing them to grasp

the meaning immediately (§ 60). This is the case here. The mark applied for, 'MILEY CYRUS', has a clear and specific semantic content for the relevant public given that it refers to a public figure of international reputation, known by most well-informed, reasonably observant and circumspect people, whereas the earlier mark has no particular semantic meaning. Furthermore, the reputation of the singer and actress Miley Cyrus is such that it is not plausible, in the absence of specific evidence to the contrary, that the average consumer when confronted with the mark MILEY CYRUS designating the goods and services in question, will disregard the meaning of that sign as the name of the famous singer and actress and perceive it principally as a mark, among other marks, of such goods and services (§ 61). It follows that the conceptual differences existing in the present case between the marks at issue counteract their visual and phonetic similarities, resulting in the signs being different (§ 62-63).

The logo for Miley Cyrus, featuring the word "CYRUS" in a stylized, bold, sans-serif font. The letters "Y" and "R" are connected, and the "C" is slightly larger and more prominent.

58-60, 62-63

16/06/2021, T-368/20, [Miley cyrus / Cyrus \(fig.\) et al.](#), EU:T:2021:372, § 51, 54, 56,

### **LOC — Case-law that first name less distinctive than family name — Applicability only for signs composed of name and surname — Conceptual similarity due to common first name**

The case-law according to which the first name is less distinctive than the family name (20/02/2013, T-631/11, B Berg, EU:T:2013:85, § 48; 08/02/2019, T-647/17, CHIARA FERRAGNI (fig.) / Chiara, EU:T:2019:73, § 60) concerns only signs formed by the first name and surname of a person and is not applicable where the marks under comparison merely comprise a first name (§ 39).

The existence of a similarity between two marks does not presuppose that their common component forms the dominant element within the overall impression created by the mark applied for. In order to assess the similarity of two marks, it is necessary to consider each of the marks as a whole, although that does not rule out the possibility that the overall impression created in the mind of the relevant public by a complex trade mark may, in certain circumstances, be dominated by one or more of its components. It is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element. It is sufficient in that regard for the common component not to be negligible (27/09/2018, T-449/17, SEVENFRIDAY / SEVEN et al., EU:T:2018:612, § 28) (§ 44).

The greater or lesser degree of distinctiveness of the elements common to the mark applied for and an earlier mark is one of the relevant factors in assessing the similarity of those signs (10/11/2016, T-67/15, POLO CLUB SAINT TROPEZ HARAS DE GASSIN (fig.) / BEVERLY HILLS POLO CLUB (fig.) et al., EU:T:2016:657, § 49) (§ 60).

The signs are visually (§ 61-67) and phonetically (§ 68-70) similar to an average degree, and show some conceptual similarity (§ 71-72). The distinctive character of the earlier trade mark being normal, there is a LOC (§ 79, 89).

The logo for CARL touch, featuring the word "CARL" in a bold, sans-serif font above the word "touch" in a smaller, lowercase, sans-serif font. The "touch" is enclosed in a stylized, rounded shape.

18/11/2020, T-377/19, [Tc carl / carl touc \(fig.\) et al.](#), EU:T:2020:546, 39, 44, 60, 79, 89

### **LOC — Signs composed of an identical surnames — Addition of a first name — Conceptual similarity due to common surname**

Where marks are composed of an identical element understood as a surname, the mere addition in one of the marks of a first name, in this case 'Christian', cannot create a conceptual difference between those marks. On the contrary, those marks will be understood by the relevant public as designating the names of people and, more particularly, of people having the same surname (08/11/2017, T-271/16, Thomas Marshall Garments of legends (fig.) / MARSHALL et al., EU:T:2017:787, § 78) (§ 109).

16/12/2020, T-863/19, [PCG CALLIGRAM CHRISTIAN GALLIMARD / GALLIMARD et al.](#), EU:T:2020:632, § 109

### **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).



19/12/2019, T-743/18, [I.J. TOBACCO INDUSTRY \(fig.\) / JTi \(fig.\)](#), EU:T:2019:872,

§ 29, 31, 45

#### 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

##### Combination of number and letters — High conceptual similarity

The degree of phonetic similarity between the signs 5Ms (fig.) and 5J (fig.) is average since they share the number five placed at the beginning of their word elements, to which consumers generally pay greater attention and which plays a decisive part in the phonetic assessment of the mark applied for (12/12/2017, T-815/16, opus AETERNATUM / OPUS, EU:T:2017:888, § 60) (§ 49). This is all the more so when, for a significant part of the relevant public, the pronunciation of the number five is longer than the pronunciation of the second part of the word elements of the signs, i.e. the letter 'j' or the combination of the letters 'M' and 's' respectively (§ 50).

The signs also have a high degree of conceptual similarity since they both convey a common concept, namely that of the combination of a number and a letter, which is a consonant represented in capital letter (§ 54).



02/12/2020, T-639/19, [5MS MMMMM \(fig.\) / 5J \(fig.\)](#), EU:T:2020:581, § 50, 54

##### Dominant element due to its size and position — Conceptual similarity to an average degree because of common number – The number '42' is the most distinctive element in the earlier mark, even in respect of *alcoholic beverages* in Class 33

The number '42' dominates the overall impression of the marks, in that, first, it was significantly larger than all the other word elements that appeared in those marks and, second, it occupied a prominent position in the centre of those marks (§ 49, 83).

The signs have in common the reference to the number '42', which results in them having an average degree of conceptual similarity (§ 56, 92).

Although it might be considered that the number '42' of the earlier mark has only a weak distinctive character with regard to some of the goods in Class 33 for part of the relevant public, it nevertheless constitutes the most distinctive element of that mark. The word 'below', as an English adverb placed directly after the number '42', can play only a secondary role in that it is intended to provide additional information in relation to that number. Therefore, consumers would pay closer attention to the number '42' (§ 89).



20/01/2021, T-829/19, [Blend 42 Vodka \(fig.\) / 42 below \(fig.\)](#), EU:T:2021:18, 49, 56, 83, 89,

92



20/01/2021, T-830/19, [Blend 42 Vodka \(fig.\) / 42 below \(fig.\)](#), EU:T:2021:19, § 49, 56, 83, 89, 92, 92



20/01/2021, T-831/19, [Blend 42 First Czech Blended Vodka \(fig.\) / 42 below \(fig.\)](#), EU:T:2021:20, § 50, 59, 86, 92, 95

### 2.3.4.5 Geographical places

[No key points available yet.]

## 2.3.5 Conclusion / Other principles (can also appear in the global assessment)

### 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

#### LOC — Different beginnings of the mark — Identical parts lacking meaning

Although the first component of word marks may be more likely to catch the consumer's attention than the components which follow, that does not apply in all cases (23/10/2015, T-96/14, VIMEO / MEO (fig.) et al., EU:T:2015:799, § 35 and the case-law cited). The additional letters 'A' and 'L' in the first part of the sign applied for ('ALMEA') do not prevent consumers from perceiving the element 'MEA' contained in both the EUTM application and the earlier mark 'MEA' (§ 35).

There are many cases in which the similarity of the signs and the LOC have been confirmed, despite the identical part of the signs lacking meaning and despite the fact that the beginnings of the signs were different (see, for example, 15/06/2011, T-229/10, Syteco, EU:T:2011:273, which compared the signs 'SYTECO' and 'TECO'; 22/05/2012, T-546/10, Milram, EU:T:2012:249, which compared the signs 'MILRAM' and 'RAM'; or 23/10/2015, T-96/14, VIMEO / MEO (fig.) et al., EU:T:2015:799, § 68, which compared the signs 'VIMEO' and 'MEO') (§ 47).

 09/12/2020, T-190/20, [ALMEA \(fig.\) / MEA](#), EU:T:2020:597, § 35, 47

### 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

#### No LOC — No similarity between the signs

The marks must be compared in their forms as applied for and registered, regardless of any possible rotation in their use on the market (§ 24-30, 32, 53).



21/04/2021, T-44/20, [DEVICE OF TWO INTERLOCKING ELEMENTS \(fig.\) / DEVICE OF TWO BOLD BLACK CIRCLES OVERLAPPING \(fig.\)](#), EU:T:2021:207, § 24-30, 32, 53

#### No LOC — No likelihood of association

There is no LOC, considering the low visual and aural similarities between the signs (§ 109, 112) for goods directed at a different public, namely the general public with an average level of attention in relation to the contested goods, on the one hand, and the professional public with a high level of attention in relation to the earlier goods, on the other (§ 114).

The likelihood of association may be invoked only if two conditions are cumulatively satisfied. Firstly, the proprietor of a series of earlier registrations must furnish proof of use of all the marks belonging to the series or, at the very least, of a number of marks capable of constituting a 'series'. For there to be a likelihood of the public being mistaken as to whether the trade mark applied for belongs to the series, the earlier marks forming part of that series must necessarily be present in the market (§ 125).



Harley Benton 28/04/2021, T-284/20, [Harley Benton \(fig.\)-HB et al.](#), EU:T:2021:218, § 109, 112, 114, 125

## 2.4 DISTINCTIVENESS OF THE EARLIER MARK

### 2.4.1 Inherent distinctiveness

#### 2.4.1.1 General principles and average distinctiveness of the earlier mark

##### **Assessment of the similarity of the signs — No consideration of marketing circumstances — No consideration of the reputation or enhanced distinctiveness of the earlier mark**

Although the marketing circumstances are a relevant factor in the application of Article 8(1)(b) EUTMR, they are to be considered at the stage of the global assessment of the likelihood of confusion (LOC) and not at the stage of the assessment of the similarity of the signs. This assessment, which is only one of the stages in examination of the LOC, involves comparing the signs to determine whether they are visually, phonetically and conceptually similar. Although this comparison must be based on the overall impression made by the signs on the relevant public, account must nevertheless be taken of the intrinsic qualities of the signs (04/03/2020, C-328/18 P, BLACK LABEL BY EQUIVALENZA (fig.) / LABELL (fig.) et al., EU:C:2020:156, § 71-72 and the case-law cited) (§ 58).

The reputation of an earlier mark or its particular distinctive character must be taken into consideration for the purposes of assessing the LOC, and not for the purposes of assessing the similarity of the marks, which is an assessment made prior to that of the LOC (11/12/2014, T-480/12, MASTER, EU:T:2014:1062, § 54 and the case-law cited) (§ 59).

The BoA's analysis is not vitiated by an error of law because it compared the signs on the basis of the perception of the 'uneducated' consumer with regard to the earlier EU figurative mark and did not take into account the applicant's use of its mark (§ 60).

01/09/2021, T-463/20, [Gt racing / GT \(fig.\) et al.](#), EU:T:2021:530, § 58-60

##### **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

### Average intrinsic distinctive character of the earlier mark

The Spanish general public, when faced with the word 'prima', certainly sees the word in its regular meaning of 'female cousin' or 'bonus payment', and does not regard that word as an adjective having a simple laudatory connotation. Since the earlier mark has no meaning as regards the goods, the inherent distinctive character of that mark is average (§ 84-86).

There is a LOC considering that the marks are visually similar to an average degree and phonetically similar to a higher-than-average degree, and that the level of attention of the relevant general public in Spain is average at most, as well as that the intrinsic distinctive character of the earlier mark is average for the similar and identical goods (§ 25, 34, 51, 60-62, 107).



28/04/2021, T-584/17 RENV, [PRIMART Marek Łukasiewicz \(fig.\) / PRIMA](#), EU:T:2021:231, § 25, 34, 51, 60-62, 84-86, 107

### Distinctive character — Commonly used words

The fact that a sign is composed of words in common use does not automatically lead to the conclusion that the mark in question has a weak distinctive character (§ 122).



01/09/2021, T-23/20, [the DoubleF \(fig.\) / The double](#), EU:T:2021:523, § 122

## Distinctive character of an earlier collective mark — Criteria for assessment

Distinctiveness of an earlier EU collective mark cannot be assessed in a specific way on the ground that it is a collective mark (§ 67).



20/01/2021, T-328/17 RENV, [BBQLOUMI \(fig.\) / HALLOUMI et al.](#), EU:T:2021:16, § 67

## Distinctive character of an earlier collective mark — Criteria for assessment

When the earlier mark is a collective mark, the 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

### 2.4.1.2 Weak earlier mark

#### No LOC — Low inherent distinctiveness of the earlier mark

The earlier mark consists exclusively of a word sign, which itself consists of only two components. Although the first word component, 'natura', accounts for 60 % of the length of the sign and appears at the beginning, it is nonetheless weakly distinctive. As for the second word component, the ending 'lium', although it has a significant distinctive role in relation to the word component 'natura', neither its length, which is shorter than that of the first component, nor its visual, phonetic and conceptual characteristics are capable of strengthening the distinctiveness of the earlier mark, taken as a whole, beyond the minimum level which it necessarily has by virtue of its registration (§ 68). Therefore, taken as a whole, the inherent distinctiveness of the earlier mark is

low (§ 69).

05/10/2020, T-602/19, [Naturanove-Naturalium](#), EU:T:2020:463, § 68-69

### No LoC — Weak inherent distinctiveness of the earlier mark

The expression ‘museum of illusions’ is descriptive for the relevant Greek public, because it refers directly to the museum services and the figurative elements of the earlier mark only highlight the descriptive concept conveyed by that expression. **The earlier mark has a low degree of inherent distinctiveness** (and not an inherently normal degree of distinctive character as the BoA concluded based on its incorrect premise that the word ‘illusion’ has no meaning with regard to museum services for the relevant Greek public) (§ 75, 77, 80-81).



12/05/2021, T-70/20, [MUSEUM OF ILLUSIONS \(fig.\) / MUSEUM OF ILLUSIONS \(fig.\)](#), EU:T:2021:253, § 75, 77, 80-81

### No LoC — Earlier collective mark — Assessment of distinctiveness — Reliance on earlier case-law concerning individual or certification marks — Weak earlier mark

It is for the proprietor of an earlier collective mark to show what level of distinctiveness it has beyond the minimum level, since he intends to rely on it in support of opposition proceedings or even cancellation proceedings (§ 50).

The finding of a weak degree of distinctiveness of the earlier mark does not amount to denying the very existence of the distinctive character of a validly registered trade mark, or to depriving that mark of the rights which it confers on its proprietor, but simply to finding that it cannot confer more rights than those it draws objectively from its distinctive character (§ 54). Even supposing that the EU collective mark ‘HALLOUMI’ implicitly refers to the Cypriot geographical origin of the goods covered, that mark must still fulfil its essential distinctive function. The generic nature of the word ‘halloumi’, since that word alone constitutes the earlier mark, necessarily limits the effects of that mark in light of that function (§ 57). The need for more extensive protection on the basis of EU trade mark law does not exist in the present case, since the rules governing protected designations of origin and protected geographical indications, as laid down in Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs (OJ 2012 L 343, p. 1), could provide sufficient protection outside the scope of trade mark law (§ 58).

The BoA cannot be criticised, when assessing the inherent distinctiveness of the earlier mark, for having referred to decisions of the Court which concerned earlier rights also composed of the single word ‘halloumi’, as individual marks or certification, in proceedings relating to applications for registration or oppositions, since the assessment of the distinctiveness of the rights in question met criteria which could be perfectly transposed to the present case (§ 53).

Where the elements of similarity between two signs arise from the fact that, as in the present case, they share a component that has a weak inherent distinctive character, the impact of such elements of similarity on the global assessment of the LOC is itself low (§ 87). The rights which the applicant derives from the registration of the earlier mark cannot, in all circumstances, confer on it an exclusive right to use the word ‘halloumi’, when, moreover, the extent of its rights under that mark is determined by the distinctiveness of that mark, whether inherent or acquired through use, which is weak (§ 115).



24/03/2021, T-282/19, [Halloumi χαλλούμι Vermion grill cheese/grill est/grill kase m BELAS PREMIUM GREEK DAIRY SINCE 1927 \(fig.\) / HALLOUMI](#), EU:T:2021:154, § 50, 53-54, 57-58, 115

### **Earlier certification mark — Assessment of the likelihood of confusion**

Where the earlier marks relied on in the opposition are national certification marks, the LOC must be understood, in accordance with the rules governing collective marks, as the risk that the public might believe that the goods or services covered by the earlier trade marks and those for which protection is sought originate from persons authorised to use the earlier marks by the proprietor, or from undertakings economically linked to those persons or that proprietor (§ 29).

However, in the event of opposition by the proprietor of a certification mark, the essential function of that type of mark must be taken into account to understand what is meant by LOC within the meaning of Article 8(1)(b) Article 8(1)(b) CTMR [now EUTMR]. The fact remains that the case-law establishing the criteria for assessing the existence of such a LOC is applicable to cases concerning an earlier certification mark (§ 30).

08/12/2021, T-556/19, [GRILLOUMI BURGER / HALLOUMI et al.](#), EU:T:2021:864, § 29-30

8/12/2021, T-593/19, [GRILLOUMI BURGER / HALLOUMI et al.](#), EU:T:2021:865, § 29-30

### **Earlier EU collective mark — Assessment of the likelihood of confusion**

Where the earlier mark is an EU collective mark, the LOC must be understood, as being the risk that the public might believe that the goods or services covered by that mark and those covered by the trade mark applied for all originate from members of the association which is the proprietor of the earlier trade mark or, as the case may be, from undertakings economically linked to those members or to that association (§ 30).

Where the proprietor of a collective mark brings opposition proceedings, although account must be taken of the essential function of that type of marks, as set out in Article 66(1) CTMR [now Article 74(1) EUTMR], in order to understand what is meant by LOC, within the meaning of Article 8(1)(b) CTMR [now EUTMR], the fact remains that the case-law establishing the criteria with regard to which the existence of such a LOC must be assessed in practice is applicable to cases concerning an earlier collective mark (§ 31).

08/12/2021, T-595/19, [GRILLOUMI BURGER / HALLOUMI et al.](#), EU:T:2021:866, § 30-31

### **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

### No LOC — Weak distinctive character of the earlier mark — Shape marks — Application of 12/01/2006, C-173/04 P, Standbeutel, EU:C:2006:20, § 34 to relative grounds

The BoA was right in taking into account a sector wider than that of mineral water. The earlier mark represents a transparent bottle of a common shape in the wide sector of beverage packaging and does not have any particular appearance that differentiates it from the conventional presentation of bottles on the market. Therefore, such a shape does not constitute an indication of origin, as it is not capable of individualising the relevant goods and services and distinguishing them from those having another commercial origin. It has, at most, a weak inherent distinctive character (§ 66-67).



12/05/2021, T-637/19, [Aqua Carpatica \(3D\) / VODAVODA \(3D\)](#), EU:T:2021:222, § 66-67



12/05/2021, T-638/19, [AC Aqua AC \(3D\) / VODAVODA \(3D\)](#), EU:T:2021:256, § 66-67

## 2.4.2 Enhanced distinctiveness through use

### Low evidential value for enhanced distinctiveness through use — 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

#### Peaceful coexistence — Burden of proof — Extent

The fact that, in part of the EU (Ireland and the UK), an EU trade mark and a national mark peacefully coexist, does not allow the conclusion that, in another part of the EU, where peaceful coexistence between that EU trade mark and the sign identical to that national mark is absent, there is no LOC between that EU trade mark and that sign (20/07/2017, C-93/16, kerrygold, EU:C:2017:571, § 38) (§ 130, 134).

The burden of proof lies with the party claiming the existence of peaceful coexistence. Moreover, where the opposition to the registration of an EU trade mark is based on an earlier EU trade mark, coexistence must be proved for the entire territory of the EU (10/04/2013, T-505/10, Astaloy, EU:T:2013:160, § 49; 20/07/2017, C-93/16, kerrygold, EU:C:2017:571, § 38) (§ 159-161).



10/03/2021, T-693/19, [KERRYMAID / Kerrygold \(fig.\)](#), EU:T:2021:124, § 130, 134, 159-

161

### 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

#### Earlier certification mark — Criteria for the assessment of LOC — Scope of protection afforded by Article 8(1)(b) EUTMR in case of earlier certification marks

Where the earlier marks relied on in support of the application for a declaration of invalidity are national certification marks, the LOC within the meaning of Article 8(1)(b) EUTMR must be understood as being the risk that the public might believe that the goods or services covered by the mark applied for and those covered by the earlier marks all originate from persons authorised by the proprietor of those earlier marks to use them in the context of the certification scheme of which they are part or, where appropriate, from undertakings economically linked to those persons or to that proprietor (§ 35).

In the event of an application for a declaration of invalidity by the proprietor of a certification mark, although the essential function of that type of mark must be taken into account in order to understand what is meant by LOC, within the meaning of Article 8(1)(b) EUTMR, the fact remains that the case-law establishing the criteria with regard to which the existence of such a likelihood must be assessed in practice is applicable to cases concerning an earlier certification mark (§ 36).

The question whether the effective compliance by the proprietor of the contested mark with the characteristics guaranteed by the proprietor of the earlier certification marks forms part of the essential function of those marks is outside the scope of the protection afforded by Article 8(1)(b) EUTMR. That question concerns, at most, the use of a mark, insofar as it could harm the essential function of a certification mark and mislead the public regarding the certification of the characteristics of the goods (§ 69).



16/06/2021, T-281/19 and T-351/19, [Halloumi χαλλούμι Vermion grill cheese/grill est/grill kase m BELAS PREMIUM GREEK DAIRY SINCE 1927 \(fig.\) / HALLOUMI](#), EU:T:2021:362, § 35-36, 69

#### Dominant element — Distinctive element — Secondary role in the overall impression

If a trade mark has multiple dominant elements, some of which are distinctive and others of which are weak, the weak ones can be considered secondary in the overall impression of the sign (§ 81).

16/06/2021, T-281/19 and T-351/19, [Halloumi χαλλούμι Vermion grill cheese/grill est/grill kase m BELAS PREMIUM GREEK DAIRY SINCE 1927 \(fig.\) / HALLOUMI](#), EU:T:2021:362, § 81

## 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

## LOC — Public with high level of attention — Principle of imperfect recollection — Common descriptive word element — Limited role of the conceptual similarity

In the assessment of the LOC, the role played by conceptual similarity in the comparison of two signs is of lesser importance when that similarity is due to a descriptive element shared by both of the marks (26/11/2015, T-262/14, *BIONECS / BIONECT*, EU:T:2015:888, § 67 and the case law cited) (§ 92).

Even a public displaying a high level of attention must rely on imperfect recollection of the signs and will not examine the mark before it down to the smallest detail, or compare that mark in minute detail to another mark (16/07/2014, T-324/13, *Femivia*, EU:T:2014:672, § 48) (§ 99).

15/10/2020, T-49/20, [ROBOX / OROBOX](#), EU:T:2020:492, § 92, 99

## LOC — Public with high level of attention — Principle of imperfect recollection

The fact that the relevant public will be more aware of the identity of the producer or supplier of the product or service that it wishes to purchase does not mean that that public will examine the mark to the smallest detail, or that it will compare that mark to another mark in minute detail. Even for a public displaying a high level of attention, the average consumer only rarely has the opportunity to compare the different marks directly, and instead must rely on their imperfect recollection of them (§ 57).

10/11/2021, T-239/20, [Ruxximera / Ruximera](#), EU:T:2021:771, § 57

10/11/2021, T-542/20, [Ruximblis / Ruximera et al.](#), EU:T:2021:775, § 57

10/11/2021, T-248/20, [Ruxymla / Ruximera](#), EU:T:2021:772, § 57

## LOC — Principle of imperfect recollection — Composite marks

There is a LOC between the signs. Consumers who have to rely on the imperfect impression kept in their mind do not recall the differences between the marks. The marks share undeniable similarities in terms of their form, the positioning of the various elements and their outlines, from the point of view of the general concept conveyed. The goods are identical. The general public and professional consumers with a level of attention that varies from average to higher than average might perceive the contested mark as a variation of the earlier mark (§ 35, 37, 43-44, 50, 52, 59, 60, 69).



28/04/2021, T-615/19, [DEVICE OF STYLISED EXTENDED WINGS \(fig.\)- DEVICE OF STYLISED EXTENDED WINGS \(fig.\)](#), EU:T:2021:224, § 35, 37, 43-44, 50, 52, 59, 60, 69

### 2.6.3 Independent distinctive role

#### No LOC — Notion of independent distinctive role — No 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 — Common weakly distinctive verbal elements — Notion of independent distinctive role — No independent distinctive role

Where a sign contains a weakly distinctive verbal element common to that sign and to the sign with which it is to be compared, and another element more likely to attract the attention of consumers, the presence of the identical element in the conflicting signs cannot, by itself, render them similar (§ 41). The BoA erred in law in two aspects. First, it did not take sufficient account of the fact that the element 'Sedus', by reason of its initial position in the mark applied for, is more likely to attract the attention of consumers than the element 'ergo+'. Second, it did not take due account of the difference between the respective degrees of distinctiveness of the elements 'Sedus' and 'ergo+' (§ 57).

In order for an element with weak distinctive character in a composite mark to have an independent distinctive role within the meaning of the Thomson Life judgment (06/10/2005, C-120/04, Thomson Life, EU:C:2005:594), it must be capable of influencing the consumer's perception, in particular by virtue of its position within the sign or its size, and of being retained in the consumer's memory (see also 22/10/2015, C-20/14, BGW/BGW, EU:C:2015:714, § 40). In the present case, the element 'ergo+' of the mark applied for is not capable of influencing the consumer's perception either by virtue of its position or its size (§ 83).

13/10/2021, T-429/20, [Sedus ergo+ / Ergoplus](#), EU:T:2021:698, § 41, 57, 83

13/10/2021, T-436/20, [Sedus ergo+ / Ergoplus et al.](#), EU:T:2021:699, § 44, 60, 86

#### No LOC — Impact of weak distinctive character of the earlier mark — Impact of common weak elements — No independent distinctive position

The element 'e-power' refers to electric vehicles, electric motors and systems enabling vehicles or their components to run on electricity, which the parties do not dispute. Therefore, due to its connection to the goods in question, inter alia, vehicles, accessories or parts making up those vehicles, it has, at most, a low degree of distinctiveness (§ 44).

It is apparent from the *Medium* judgment (06/10/2005, C-120/04, Thomson Life, EU:C:2005:594), that 'where the goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another and a registered mark which has a normal degree of distinctiveness and which, although it does not determine by itself the overall impression conveyed by the composite sign in question, retains an independent distinctive role therein.' However, in the present case, the distinctive character of the element 'e-power' cannot be regarded as normal but is, at most, low, in so far as it is clear that that term alludes to the type of energy ensuring the functioning of the goods in question or

related to those goods (§ 53). Accordingly, the applicant's argument based on the *Medion* judgement must be rejected.

It follows that the visual and phonetic similarity of the conflicting signs and their low degree of conceptual similarity, on account of an element whose distinctiveness is merely low, are likely to be offset by the visual, phonetic and conceptual difference. That difference therefore carries more weight in the global assessment of the likelihood of confusion, as the relevant public will have a higher than average level of attention. The BoA correctly took into consideration the low degree of distinctiveness of that element, the differences between the conflicting signs, the identity of or degree of similarity between the goods in question and the level of attention of the relevant public in order to find that there was no likelihood of confusion on the part of that public (§ 79-80).

**e-POWER** 10/11/2021, T-755/20, [Vdl e-power / e-POWER \(fig.\) et al.](#), EU:T:2021:769, § 44, 53, 79-80

**e-POWER** 10/11/2021, T-756/20, [Vdl e-powered / e-POWER \(fig.\) et al.](#), EU:T:2021:769, § 44, 53, 79-80

### **LOC — Distinctive and dominant elements of the signs — Addition of an element that will be recognised as a surname or business identifier — No independent distinctive position**

The earlier mark consists of only one element, namely 'RAUSCH'. Therefore, the examination of the most distinctive elements is not relevant for this mark (§ 104). The element 'rausch' of the mark applied for has an enhanced inherent distinctive character for the non-German-speaking part of the general public. This part of the relevant general public will not be familiar with that surname or that word. The element 'rausch', alone or in conjunction with another element referring to the Alps, will have no meaning and will be perceived as a purely fanciful term (§ 108, 122-123).

The conflicting signs are visually and phonetically similar to an average degree (§ 137-139). The conceptual comparison is neutral since the element 'rausch' is not understood by the non-German speaking part of the relevant public (§ 140).

The applicant cannot claim that there is no likelihood of confusion relying on the *Medion* judgment (06/10/2005, C-120/04, Thomson Life, EU:C:2005:594). It is apparent from this judgment that, where the goods or services are identical, there may be a likelihood of confusion on the part of the public if the contested sign is formed by juxtaposing the applicant's company name and a registered mark which has a normal degree of distinctiveness and which, although it does not determine by itself the overall impression conveyed by the composite sign, retains an independent distinctive role therein (§ 172). However, the Court has also stated that a component of a composite sign does not retain an independent distinctive role if, together with the other component or components of the sign, that component forms a unit with a different meaning from that of the components individually (22/10/2015, C-20/14, BGW/BGW, EU:C:2015:714, § 39) (§ 173).

There is a likelihood of confusion for the non-German-speaking part of the relevant general public since, for that part, the element 'rausch' – which is common to the marks – has no meaning whether it stands alone, as in the earlier mark, or is considered together with the other elements of the mark applied for. The element 'rausch' of the mark applied for retains an independent distinctive role in that mark (§ 96, 122, 174).

21/12/2021, T-6/20, [Alpenrausch Dr. Spiller / RAUSCH](#), EU:T:2021:920, § 96, 104, 108, 122-123, 122, 140, 172-174

## LOC — Independent distinctive role

The word element 'SOHO' is not the dominant element in the contested mark, but it is completely reproduced in the contested mark. Its distinctive character is normal. It therefore meets the criteria laid down in the case-law to conclude that it has an independent distinctive role within the contested mark. The combination of the word elements 'the king of' and 'Soho' does not create a concept and a logical unit that is distinct from those of its components.

Given the average or weak similarity of the goods, the high degree of phonetic and conceptual similarities and average degree of visual similarity of the signs, and the independent distinctive role played by the common word element 'Soho', it must be concluded that the BoA was entitled to find a LOC between the marks at issue (§ 118-124).



28/04/2021, T-31/20, [THE KING OF SOHO \(fig.\) / SOHO](#), EU:T:2021:217, § 118-124

## No LOC — No 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

## No LOC — No independent distinctive role — Weak distinctiveness of the earlier mark

At no time has the applicant demonstrated that the conditions for applying the case-law stemming from the 'Thomson Life' judgment (06/10/2005, C-120/04, Thomson Life, EU:C:2005:594) were satisfied in the present case. Moreover, it must be held that the principle established by the CJ in that judgment cannot be applied in the present case, since the word 'workspace' does not have normal distinctiveness but is, at most, weakly distinctive (§ 56).

Bearing in mind the, at best, weak visual, phonetic and conceptual similarities between the signs, the fact that they share a descriptive element, the weak distinctiveness of the earlier EU trade mark and the high level of attention of the professional public, there is no LOC, even though the services in question are identical. This finding also applies to the earlier UK trade marks (§ 59).



**WORKSPACE**

28/05/2020, T-506/19, [Uma workspace / WORKSPACE \(fig.\) et al.](#), EU:T:2020:220, § 49-52, 56, 59

## 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 decoration

*Figurines for ornamental purposes* (in Classes 6, 19, 20 and 21) are marketed in such a way that the visual aspect has greater importance than the phonetic and conceptual aspects (§ 93).



23/09/2020, T-608/19, [Veronese \(fig.\) / VERONESE](#), EU:T:2020:423, § 93

### 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 LOC (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

## **Irrelevance of elements based on subjective commercial intentions — Use of the mark**

The prospective analysis of the LOC cannot be dependent on the subjective commercial intentions, whether carried out or not, of the trade mark proprietors. Accordingly, the comparison of the marks cannot be made on the basis of an element which depends on the intentions of the proprietor of one of the marks (for example, the size in which a mark can be used in practice, which cannot be objectively determined by reference to the size of the goods that it designates). The use of a trade mark is not limited to affixing it to the goods themselves, since the trade mark may also be affixed, in particular, to labels attached to the goods, to their packaging or even independently of the goods, on shop signs or advertising documents (08/11/2017, T-754/16, CC (fig.)/ O (fig.), EU:T:2017:786, § 53) (§ 92).



23/09/2020, T-608/19, [Veronese \(fig.\) / VERONESE](#), EU:T:2020:423, § 92

## 2.6.5 Neutralisation of visual and phonetic similarities by conceptual dissimilarity

### 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

### No LOC — Neutralisation of visual and phonetic similarities by conceptual dissimilarity — Conditions for counteraction

Within the global assessment of the LOC, the conceptual differences between the signs may counteract phonetic and visual similarities between them, provided that at least one of those signs has, from the point of view of the relevant public, a clear and specific meaning so that that public is capable of grasping it immediately (04/03/2020, C-328/18 P, BLACK LABEL BY EQUIVALENZA (fig.) / LABELL (fig.) et al., EU:C:2020:156, § 74-75) (§ 77-79) (§ 77).

The relevant public will immediately understand the word 'panda' of the earlier marks as referring to a black and white bear native of south-east China. That meaning is, from the point of view of the relevant public, a clear, specific meaning which can be grasped immediately by that public, whereas the sign applied for has no meaning (§ 59-60). Accordingly, the signs are conceptually dissimilar (§ 64, 78). The conceptual difference between the signs counteracts the phonetic and visual similarities between them. On account of the conceptual difference and despite the lower-than-average degree of phonetic similarity (§ 49, 52) and the average degree of visual similarity (§ 39, 45), the relevant public, which has a high level of attention, is not likely to consider that the signs originate from the same undertaking or from economically-linked undertakings, despite the enhanced distinctiveness of the earlier marks.

28/04/2021, T-191/20, [Pandem / Panda et al.](#), EU:T:2017:90, § 39, 45, 49, 52, 59-60, 64, 77-78

### Lack of consideration of possible counteraction of visual and phonetic similarities through conceptual differences — Conditions for counteraction

The word 'amen' has a clear and specific meaning which the relevant public will grasp directly (§ 56). This meaning will not be disregarded by the relevant public in the clothing sector (§ 59). The BoA erred in finding that it was not possible to carry out a conceptual comparison because the marks did not convey any clear concept capable of being grasped directly and immediately by the average consumer (§ 60, 73, 78). Consequently, the assessment of the LOC is vitiated by an erroneous examination of the conceptual similarity and by not having considered the possible application of the conceptual neutralisation (§ 78).

**.A.M.E.N.** 05/05/2021, T-442/20, [Âme / .A.M.E.N. \(fig.\)](#), EU:T:2021:237, § 56, 59-60, 73, 78

## 2.6.6 Impact of weak elements / weak earlier mark

### Common weakly distinctive elements — Impact on finding the existence of a LOC

Where the earlier trade mark and the sign whose registration is sought coincide in an element that is weakly distinctive with regard to the goods at issue, the global assessment of the LOC within the meaning of Article 8(1)(b) CTMR [now EUTMR] does not often lead to a finding that such likelihood exists (12/06/2019, C-705/17; Mats Hansson, EU:C:2019:481, § 55).



18/06/2020, C-702/18 P, [PRIMART Marek Łukasiewicz \(fig.\) / PRIMA et al.](#), EU:C:2020:489, § 53

### No LOC — Weakly distinctive elements — Endings of word marks composed of two elements that possess no visual, phonetic or even conceptual similarities

Where the endings of word marks composed of two elements possess no visual, phonetic or even conceptual similarities, they are able to compensate for the visual, phonetic and even conceptual similarities that result from the presence of the weakly-distinctive beginning component, 'natura', common to both signs (§ 43, 44, 50). Since the inherent distinctiveness of the earlier mark in light of the two components of the word sign is weak (§ 75), the signs are globally different in the overall impression they produce in the minds of the relevant public (§ 76). There is no LOC, notwithstanding the identity of the goods (§ 77).

For a trade mark of a weak distinctive character, the degree of similarity between the signs should be high to justify a LOC, otherwise there would be a risk of granting excessive protection to that trade mark and its proprietor (§ 56).

05/10/2020, T-602/19, [Naturanove-Naturalium](#), EU:T:2020:463, § 43, 44, 50, 56, 55-77

### No LOC — Impact of a common weakly-distinctive component or common component with no distinctive character — Low distinctive character of the earlier mark

Where the elements of similarity between two signs are the result of the fact that they have a common weakly-distinctive component or a common component that has no distinctive character, the impact of those elements of similarity on the global assessment of the LOC is itself low (05/03/2020, T-688/18, CORNEREYE / BACKEYE et al., EU:T:2020:80, § 38 and the case-law cited) (§ 91).

There is no LOC between the phonetically and conceptually identical signs, which are visually similar to a degree ranging from low to average (§ 66-72), considering that the visual similarity between the signs and their phonetic and conceptual identity arise solely out of the presence, in those signs, of the expression 'museum of illusions', which, on account of its descriptive nature, will only slightly attract the attention of the relevant Greek public with a level of attention that varies from average to high for identical or similar services and the low degree of inherent distinctiveness of the earlier mark (§ 91-97).



12/05/2021, T-70/20, [MUSEUM OF ILLUSIONS \(fig.\) / MUSEUM OF ILLUSIONS \(fig.\)](#), EU:T:2021:253, § 91-97

### **No LOC — Weak distinctive character of the common element — Tradition in the sector**

Because of its historical connection with the delivery of mail, the stylised device of a post horn has been used by several postal operators throughout the EU and the public will not necessarily see it as an indication of the origin of the postal services (§ 46).

The degree of distinctiveness of the earlier mark determines the extent of the protection conferred by it. Where its distinctiveness is significant, this is likely to increase the LOC (05/03/2020, C-766/18 P, BBQLOUMI (fig.) / HALLOUMI, EU:C:2020:170, § 70 and the case-law cited). Where the distinctiveness of the earlier mark is low, the extent of the protection conferred by that mark is also low, even if the existence of a LOC is not precluded (§ 49).

Where the signs coincide in an element that is weakly distinctive regarding the goods and services, the global assessment of the LOC does not often lead to a finding that such a likelihood exists (18/06/2020, C-702/18 P, PRIMART Marek Łukasiewicz (fig.) / PRIMA et al., EU:C:2020:489, § 53) (§ 50).

In view of that tradition in the sector concerned, which explains why signs which have similarities have coexisted for a long time, and of the low distinctiveness of the earlier mark, the BoA rightly found that there was no LOC between the signs, despite the fact that they have an average degree of similarity and despite the identity or similarity of the goods and services concerned (§ 55).



11/11/2020, T-25/20, [DEVICE OF A HORN \(fig.\) / DEVICE OF A HORN \(fig.\)](#), EU:T:2020:537, § 46, 49-50, 55

### **No LOC — Weak distinctiveness of the earlier mark — No independent distinctive role**

Where the elements of similarity between two signs relate to the fact that they share a weakly distinctive component, the impact of such elements of similarity in the global assessment of the LOC is itself weak (22/02/2018, T-210/17, TRIPLE TURBO (fig.) / ZITRO TURBO 2 (fig.), EU:T:2018:91, § 73; 13/12/2007, T-242/06, El charcutero artesano, EU:T:2007:391, § 85; 04/03/2015, T-558/13, FSA K-FORCE, EU:T:2015:135, § 49-52).

At no time has the applicant demonstrated that the conditions for applying the case-law stemming from the ‘Thomson Life’ judgment (06/10/2005, C-120/04, Thomson Life, EU:C:2005:594) were satisfied in the present case. Moreover, it must be held that the principle established by the CJ in that judgment cannot be applied in the present case, since the word ‘workspace’ does not have normal distinctiveness but is, at most, weakly distinctive (§ 56).

Bearing in mind the, at best, weak visual, phonetic and conceptual similarities between the signs, the fact that they share a descriptive element, the weak distinctiveness of the earlier EU trade mark and the high level of attention of the professional public, there is no LOC, even though the services in question are identical. This finding also applies to the earlier UK trade marks (§ 59).



**WORKSPACE** 28/05/2020, T-506/19, [Uma workspace / WORKSPACE \(fig.\) et al.](#), EU:T:2020:220, § 49-52, 56, 59

### **LOC — Weak distinctiveness of the earlier mark — Consideration of other factors such as position structure and dimension and global meaning**

It had not been established that the earlier mark was particularly distinctive due to its intensive use or reputation. Its distinctiveness therefore rested on its distinctiveness per se (§ 118). As the earlier mark consists of the element 'touring club', which is weakly distinctive with regard to the services, and of the element 'italiano', which is directly descriptive, the distinctive character of the earlier mark is weak. However, there is a LOC even in a case involving an earlier mark with a weak distinctive character since the services are identical and the signs are visually similar to an average degree, phonetically similar to at least an average degree, and conceptually similar to a high degree (§ 119-121).



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

EU:T:2020:31, 119-121

### **LOC — Global assessment of likelihood of confusion — Impact of weak distinctive character of the earlier mark — Impact of common weak elements**

A finding that the earlier mark has a weak distinctive character does not preclude a finding that there is a likelihood of confusion (LOC). Although the distinctive character of the earlier mark must be taken into account in assessing the LOC, it is only one factor among others involved in that assessment. Consequently, even in a case involving an earlier mark with a weak distinctive character, there may be a LOC on account, in particular, of a similarity between the signs and the goods or services covered (13/12/2007, T-134/06, Pagesjaunes.com, EU:T:2007:387, § 70 (§ 64)).

Where the earlier trade mark and the sign for which registration is sought coincide as a result of an element that is weakly distinctive or descriptive with regard to the goods or services, the global assessment of the LOC will often lead to a finding that that likelihood does not exist. However, it follows from the case-law of the Court of Justice that a finding that there is such a LOC cannot, because of the interdependence of the relevant factors in that regard, be ruled out in advance and in any event (12/06/2019, C-705/17, ROSLAGSÖL, EU:C:2019:481, § 55) (§ 65). Considering the principle of interdependence despite the weak distinctive character of the earlier mark for the English-speaking public, the BoA was right to find that there was a LOC as to the origin of the goods on the part of the relevant public (§ 74).

*Vital*

like nature



VITAL

20/10/2021, T-351/20, [Vital like nature \(fig.\) / VITAL \(fig.\)](#), EU:T:2021:719,

§ 64-65, 74

### **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

### **No LOC — Weakly distinctive elements — Common elements in almost identical fonts**

The fact that the common elements of the conflicting signs are written in an almost identical font is not decisive, but must be taken into account in the overall assessment of visual similarity. If those elements are also represented in commonly used typefaces, without any particular stylisation or decoration, this factor is unlikely to be relevant (§ 48). Considering also the different colours, the degree of visual similarity between the signs is low (§ 50).

Any LOC is excluded even for identical goods. This is because the similarities relating to the weakly distinctive elements 'essential' or 'essencial' and 'essentials' are insufficient to offset the differences resulting from the additional elements in the signs (§ 52).

 09/09/2020, T-879/19, [Dr. Jacob's essentials \(fig.\) / Compal Essencial et al.](#), EU:T:2020:401, § 48, 50, 52

### **No LOC — Weak element common to both signs — Global assessment of LOC**

Where the elements of similarity between two signs arise from the fact that they share a component which has weak inherent distinctiveness, the impact of such elements on the global assessment of the LOC is itself low (§ 64)



20/01/2021, T-328/17 RENV, [BBQLOUMI \(fig.\) / HALLOUMI et al.](#), EU:T:2021:16, § 64

### **No LOC — Weakly distinctive common elements**

Where the elements of similarity between two signs are the result of the fact that they have a weakly distinctive component in common, the impact of those elements of similarity on the global assessment of the LOC is itself low (22/02/2018, T-210/17, TRIPLE TURBO (fig.) / ZITRO TURBO 2 (fig.), EU:T:2018:91, § 73) (§ 90).



15/10/2020, T-349/19, [athlon custom sportswear \(fig.\) / Decathlon](#), EU:T:2020:488, § 90

### **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).

1<sup>st</sup> 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, [ПОШЕВ \(fig.\) / ПОМАШКИ \(fig.\)](#), EU:T:2020:195, § 90

### **Impact of multiple dominant element — Distinctive element — Weak elements — Secondary role in the overall impression**

If a trade mark has multiple dominant elements, some of which are distinctive and others of which are weak, the weak ones can be considered secondary in the overall impression of the sign (§ 81).



16/06/2021, T-281/19 and T-351/19, [Halloumi χαλλούμι Vermion grill cheese/grill est/grill kase m BELAS PREMIUM GREEK DAIRY SINCE 1927 \(fig.\) / HALLOUMI](#), EU:T:2021:362, § 81

## 2.6.7 Impact of enhanced distinctiveness of the earlier mark

### LOC — Enhanced distinctiveness of the earlier mark

Since the more distinctive the earlier mark is, the greater the LOC 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).



15/07/2020, T-371/19, [FAKEDUCK \(fig.\) / Save the duck \(fig.\) et al.](#), EU:T:2020:339, § 67

### LOC — Common weakly-distinctive element — Enhanced distinctiveness through use of the earlier trade mark

Although the marks include different terms, ‘loft’ and ‘land’ respectively, they are visually and conceptually similar to an average degree and phonetically similar to an above-average degree (§ 69-70, 75-76, 83). The fact that the common word element ‘game’ of the signs is weakly distinctive will be offset by the enhanced distinctiveness acquired through the use of the earlier mark (§ 83). At least a non-negligible part of the relevant public, made up of average English-speaking consumers, could take the view that the identical and similar services came from the same undertaking or, as the case may be, from economically-linked undertakings (§ 78, 81-85).



02/06/2021, T-17/20, [GAMELAND \(fig.\) / Gameloft](#), EU:T:2021:313, § 78, 81-85

### Global assessment of LOC — Consideration of the reputation of the earlier mark and not of the contested mark

Only the reputation of the earlier mark, and not that of the mark applied for, must be taken into account to assess whether the similarity of the goods covered by the two marks is sufficient to give rise to a LOC (03/09/2009, C-498/07 P, La Española, EU:C:2009:503, § 84 and case-law cited). That case-law is in line with the objective of Article 8(1)(b) CTMR (now EUTMR), which is to provide adequate protection for the proprietors of earlier rights against subsequent applications for identical or similar European Union trade marks (29/01/2019, T-336/17, YATEKOMOM / YA TE COMERE EL VACIO QUE TE LLENA (fig.), EU:T:2019:36, § 49) (§ 113).

10/11/2021, T-353/20, [ACM 1899 AC MILAN \(fig.\) / Milan et al.](#), EU:T:2021:773, § 113

## 2.7 CONCLUSION ON ARTICLE 8(1)(b) EUTMR

### 2.7.1 LOC



ME<T IN STYLE 14/02/2019, T-63/18, [TORRO Grande Meat in Style \(fig.\) / TORO 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 COMEREL 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



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



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



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



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



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



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

16/12/2020, T-859/19, [Alkemie / Alkmene](#), EU:T:2020:615



16/12/2020, T-860/19, [ALKEMIE \(fig.\) / Alkmene](#), EU:T:2020:616



02/12/2020, T-639/19, [5MS MMMMM \(fig.\) / 5J \(fig.\)](#), EU:T:2020:581

17/03/2021, T-186/20, [The time / Timehouse](#), EU:T:2021:147

Δ BE EDGY ∇

BERLIN

20/01/2021, T-329/19, [BE EDGY BERLIN \(fig.\) / Edji et al.](#), EU:T:2021:22



24/02/2021, T-61/20, [B-direct / bizdirect \(fig.\)](#), EU:T:2021:101



10/03/2021, T-66/20, [HAUZ LONDON \(fig.\) / Houzz](#), EU:T:2021:125



10/03/2021, T-67/20, [HAUZ NEW YORK \(fig.\) / Houzz](#), EU:T:2021:126



10/03/2021, T-68/20, [HAUZ EST 1929 \(fig.\) / Houzz](#), EU:T:2021:127



20/01/2021, T-811/19, [CABEÇA DE TOIRO \(fig.\) / Sangre de toro](#), EU:T:2021:23

BLEND  
VODKA



20/01/2021, T-829/19, [Blend 42 Vodka \(fig.\) / 42 below \(fig.\)](#), EU:T:2021:18

BLEND  
VODKA



20/01/2021, T-830/19, [Blend 42 Vodka \(fig.\) / 42 below \(fig.\)](#), EU:T:2021:19

BLEND  
VODKA



20/01/2021, T-831/19, [Blend 42 First Czech Blended Vodka \(fig.\) / 42 below \(fig.\)](#),  
EU:T:2021:20



20/01/2021, T-261/19, [OptiMar \(fig.\)](#), EU:T:2021:24

10/02/2021, T-821/19, [B.home / B-Wohnen](#), EU:T:2021:80

**Hydrovision**

27/01/2021, T-817/19, [Hydrovision \(fig.\) / Hylo vision](#), EU:T:2021:41

**JUMEX**

**zumex**

28/04/2021, T-310/20, [JUMEX \(fig.\)-Zumex \(fig.\) et al.](#), EU:T:2021:227

skylife

27/01/2021, T-382/19, [Skylife \(fig.\) / SKY](#), EU:T:2021:45



28/04/2021, T-615/19, [DEVICE OF STYLISED EXTENDED WINGS \(fig.\)-DEVICE OF STYLISED EXTENDED WINGS \(fig.\)](#), EU:T:2021:224

**PRIMART**  
Retail Performance

28/04/2021, T-584/17 RENV, [PRIMART Marek Łukasiewicz \(fig.\) / PRIMA](#), EU:T:2021:231

21/05/2021, T-158/20, [Breeze / Breeze](#), EU:T:2021:288

**BIOVÈNE**  
BARCELONA

30/06/2021, T-227/20, [BIOVÈNE BARCELONA \(fig.\) / Biorene](#), EU:T:2021:395, § 18, 69, 77, 86, 89

30/06/2021, T-232/20, [Biovène / Biorene](#), EU:T:2021:396, § 18, 69, 77, 86, 89

**IDENTY**  
BEAUTY



15/09/2021, T-688/20, [IDENTY BEAUTY \(fig.\) / IDENTITY THE IMAGE CLUB \(fig.\)](#), EU:T:2021:567

**P.I.C. Co. P!K**

10/11/2021, T-73/21, [P.I.C. Co. \(fig.\) / P!K \(fig.\)](#), EU:T:2021:777



10/11/2021, T-532/20, [Redello / CADELLO \(fig.\) et al.](#), EU:T:2021:774

17/11/2021, T-504/20, [Manòu / Manou et al.](#), EU:T:2021:789



21/12/2021, T-549/20, [Superzings / ZING \(fig.\) et al.](#), EU:T:2021:935



21/12/2021, T-571/20, [LUNA SPLENDIDA \(fig.\) / Luna \(fig.\) et al.](#), EU:T:2021:956



15/12/2021, T-69/21, [COLLINI \(fig.\) / Pollini et al.](#), EU:T:2021:893



21/12/2021, T-159/21, [motwi \(fig.\) / Monty et al.](#), EU:T:2021:924

## 2.7.2 No LOC



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



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



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 WELLPHARMA SHOP \(fig.\) / WELL AND WELL](#), EU:T:2019:248



19/06/2019, T-28/18, [AC MILAN \(fig.\) / AC et al.](#), EU:T:2019:436



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

 gastivo 12/12/2019, T-266/19; [\(fig.\) / gastivo \(fig.\) \(II\)](#), EU:T:2019:854 Aligned with Bo

 gastivo 12/12/2019, T-267/19; [\(fig.\) / gastivo \(fig.\) \(I\)](#), EU:T:2019:852

 I.J. TOBACCO INDUSTRY **JTI** 19/12/2019, T-743/18, [I.J. TOBACCO INDUSTRY \(fig.\) / JTi \(fig.\)](#), EU:T:2019:872

 Idealogistic Verhoeven  
Greatest care in getting it there.  **IDĒA** 05/12/2019, T-29/19, [Idealogistic Verhoeven Greatest care in getting it there \(fig.\) / IDĒA \(fig.\) et al.](#), EU:T:2019:841

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

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

 AIRESANO **BLACK**  
El ibérico de Teruel  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

 **TOTTO** 08/07/2020, T-633/19, [\(fig.\) / TOTTO \(fig.\)](#), EU:T:2020:312

 PANTHÉ  21/02/2021, T-117/20, [PANTHÉ \(fig.\) / P PANTHER \(fig.\) et al.](#), EU:T:2021:81

 **HB**  
Harley Benton 28/04/2021, T-284/20, [Harley Benton \(fig.\)-HB et al.](#), EU:T:2021:218

 discount  
apotheka.de  apo-discounter.de  apo.co  apo.de 20/01/20, T-844/19, [discount apotheke.de \(fig.\) / APODISCOUNTER et al.](#), EU:T:2021:25

 **COBI** 05/05/2021, T-286/20, [Gobi-COBI \(fig.\)](#), EU:T:2021:239

kugoo

19/05/2021, T-324/20, [kugoo \(fig.\) / Kuqa et al.](#), EU:T:2021:280



uni

13/10/2021, T-591/20, [UNI-MAX \(fig.\) / uni \(fig.\) et al.](#), EU:T:2021:694

 sandriver

06/10/2021, T-505/20, [sandriver \(fig.\) / SAND et al.](#), EU:T:2021:655

 DORMILLO



20/10/2021, T-596/20, [DORMILLO \(fig.\) / DORMILON El placer de dormir \(fig.\) et al.](#), EU:T:2021:721



20/10/2021, T-597/20, [Dormillo / DORMILON El placer de dormir \(fig.\) et al.](#), EU:T:2021:722

Strong

like nature

20/10/2021, T-352/20, [Strong like nature \(fig.\) / STRONG NATURE](#), EU:T:2021:720

 PINAR  
Süzme Peynir



20/10/2021, T-559/20, [PINAR Süzme Peynir \(fig.\) / Süzme Peynir \(fig.\)](#), EU:T:2021:713



20/10/2021, T-560/20, [PINAR Tam kıvamında Süzme Peynir Yumusak ve Leziz \(fig.\) / Süzme Peynir \(fig.\)](#), EU:T:2021:714

20/10/2021, T-112/20, [Televend / Televes et al.](#), EU:T:2021:710

### 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

10/06/2020, T-718/18, [PHILIBON DEPUIS 1957 www.philibon.com / PHILICON \(fig.\) et al.](#), EU:T:2020:257, § 94

#### Opposition proceedings — Competence of the BoA — Well-known trade mark within the meaning of Article 6bis of the Paris Convention

In opposition proceedings, the existence of relative grounds for refusal within the meaning of Article 8 CTMR [now EUTMR] presupposes that the mark on which the opposition is based exists and pre-dates the mark applied for. These are factors that must therefore be examined by the Office of its own motion and cannot be left to the free assessment of the parties (25/06/2015, T-186/12, LUCEA LED / LUCEO, EU:T:2015:436, § 39) (§ 57).

Pursuant to Article 19(2) CTMIR [now Article 7(2) EUTMDR] the opposing party must file proof of the existence, validity and scope of protection of his earlier mark, as well as evidence proving his entitlement to file the opposition. If the opposition is based on a well-known mark, the opponent must submit evidence showing that this mark is well-known in the relevant territory (Article 19(2)(b) CTMIR [now Article 7(2)(b) EUTMDR]) (§ 60).

Accordingly, the well-known character of the earlier mark constitutes a point of law necessary to ensure the correct application of the trade mark regulation and the BoA is entitled to examine the evidence proving its existence of its own motion (§ 61).

The public's degree of knowledge of a well-known mark is higher than for a mark that has a reputation, with the result that the standard of proof required to establish that a mark is 'well known' for the purposes of Article 6bis of the Paris Convention is higher than that applicable to marks that have a reputation within the meaning of Article 8(5) CTMR (03/05/2018, T-2/17, MASSI / MASI et al., EU:T:2018:243, § 75) (§ 80).



14/07/2021, T-197/20, [QUILAPAYUN \(fig.\) / QUILAPAYUN \(fig.\) et al.](#), EU:T:2021:429, § 57, 60-61, 80

## 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

### Scope of application of Article 8(3) EUTMR — Identity or similarity of the signs — Similarity of the goods and services

Article 8(3) CTMR applies to applications for registration by the agent or representative of the proprietor of the earlier mark, both where the mark applied for is identical to that earlier mark and where it is similar to it (§ 54-74, 91). For the purposes of applying Article 8(3) CTMR, similarity between the marks is not determined on the basis of the existence of a LOC (§ 92).

The application of Article 8(3) CTMR is not precluded where the goods or services covered by the mark applied for and those covered by the earlier mark are similar, and not identical (§ 99).

11/11/2020, C-809/18 P, [MINERAL MAGIC / MAGIC MINERALS BY JEROME ALEXANDER et al.](#), EU:C:2020:902, § 92, 99

## Scope of application of Article 8(3) CTMR [now EUTMR] — Broad interpretation of the term ‘trade marks’

Effective protection of the legitimate interests of the real proprietor pursuant to Article 8(3) requires interpreting broadly the term ‘**trade marks**’, which therefore includes pending applications, non-registered marks or well-known marks within the meaning of Article 6bis of the Paris Convention (§ 38). Consequently, the applicant’s contention that the earlier mark was also well-known does not constitute a new ground for invalidity based on Article 3(1)(a) CTMR [now EUTMR] (§ 63)

08/09/2021, T-84/20, [Eductor / Eductor](#), EU:T:2021:555, § 38, 68

08/09/2021, T-85/20, [Eductor / Eductor](#), EU:T:2021:556, § 38, 68

08/09/2021, T-86/20, [Scio / Scio](#), EU:T:2021:557, § 38, 68

## 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 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

## **Scope of examination — Burden of proof for providing information about national law — Examination of facts ex officio**

The opposition is based on an earlier right within the meaning of Article 8(4) EUTMR, invoked pursuant to the law of a Member State. However, according to Article 7(2)(d) EUTMDR, the opponent must provide a clear identification of the content of the national law relied on by adducing publications of the relevant provisions or case-law (§ 80). To that end, a mere reference in a footnote to the case-law on which the applicant intends to rely, does not suffice to fulfil the obligations arising from Article 7(2)(d) EUTMDR (§ 81).

The Office is not required to supplement the missing information on national law on its own motion, because its power of verification can be exercised only where the Office already has information relating to national law, either in the form of claims as to its meaning, or in the form of evidence submitted and whose probative value has been adduced (20/03/2013, T-571/11, Club Gourmet, EU:T:2013:145, § 41), which is not the case here (§ 83).

02/12/2020, T-35/20, [DEVICE OF CLAW-LIKE SCRATCH \(fig.\) / DEVICE OF CLAW-LIKE SCRATCH \(fig.\) et al](#), EU:T:2020:579, § 81-83

### **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 LOC 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

#### **Action for 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 — Goodwill**

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

### **Action for passing off — Goodwill — Misrepresentation**

Goodwill is normally proved by evidence of, inter alia, trading activities, advertising, and customers' accounts. Genuine trading activities, which result in acquiring reputation and gaining customers, are usually sufficient to establish goodwill (18/07/2017, T-45/16, Byron (fig.) / BYRON, EU:T:2017:518, § 49 and the case-law cited) (§ 94). The mere fact that the business of the claimant seeking to maintain an action for passing-off is very small does not of itself prevent it having goodwill since a very slight trading activity has been held to be sufficient to create goodwill (§ 95).

According to section 5(4) of the UK Trade Marks Act, as interpreted by the national courts (decision of the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc.* [1990] R.P.C. 341, 406 HL ('the Reckitt decision')), the opponent must establish, in accordance with the legal rules governing actions for passing-off, as laid down by the law of the United Kingdom, that three conditions are satisfied: namely, first, the goodwill acquired by the non-registered trade mark or the sign, second, misrepresentation by the proprietor of the subsequent mark and, third, damage caused to that goodwill (18/07/2017, T-45/16, Byron (fig.) / BYRON, EU:T:2017:518, § 43 and the case-law cited) (§ 81).

According to the national case-law (the Reckitt decision), misrepresentation must be proved by taking into account the customer base which is interested in the services provided both by the claimant in an action for passing-off and those of the defendant (11/06/2009, T-114/07 & T-115/07, Last Minute Tour, EU:T:2009:196, § 60, 92) (§ 122-124).

16/12/2019, T-535/19, [JCE HOTTINGER-HOTTINGER](#), EU:T:2020:614, § 81, 95, 122-124

## **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**

### **Undated documents — Annual financial statements**

Undated documents may, in certain cases, be used to establish use of a mark to the extent to which they serve to confirm facts inferred from other items of evidence (19/12/2019, T-383/18, businessNavi (fig.), EU:T:2019:877, § 72) (§ 46).

Annual financial statements are highly reliable and have a high evidential value because they have been audited by an independent audit firm (§ 61).

16/12/2019, T-535/19, [JCE HOTTINGER-HOTTINGER](#), EU:T:2020:614, § 46, 61

#### 5.4.2.3 Nature of the use

##### **Invalidity proceedings — Article 8(4) CTMR [now EUTMR] — Relevant public’s perception of a composite sign — No independent use in the course of trade of a sign of more than mere local significance**

The relevant public, faced with the composite sign ‘NAPAPIJRI GEOGRAPHIC’, will not perceive the non-registered sign ‘geographic’ as an independent sign under Article 8(4) CTMR [now EUTMR] (§ 26).

The non-registered sign ‘geographic’ has no actual and real independent presence on the relevant market. Only together with the sign ‘napapijri’, which is dominant, and with the Norwegian flag does it have such presence. It has not been proved that a substantial part of the relevant public would know the non-registered sign ‘geographic’ and would associate it with the goods without any effort. Therefore, the BoA was fully entitled to find that that word did not constitute an independent sign used in the course of trade (§ 38).



10/11/2021, T-517/20, [National geographic / Geographic](#), EU:T:2021:783, § 26, 38



10/11/2021, T-518/20, [NATIONAL GEOGRAPHIC \(fig.\) / Geographic](#), EU:T:2021:784, § 26, 38

## 5.5 PRECEDENCE IN TIME

[No key points available yet.]

## 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

#### Proximity between the goods for the purposes of Article 8(5) EUTMR

Article 8(5) EUTMR expressly refers to the situation where the goods are not similar and the dissimilarity between the goods designated respectively by the marks at issue is therefore not a sufficient factor in excluding the existence of a link between those marks (26/09/2018, T-62/16, PUMA (fig.) / PUMA (fig.) et al., EU:T:2018:604, § 99-100 and case-law cited) (§ 111).

There is proximity between energy drinks and alcoholic drinks since they are frequently mixed in the relevant Austrian market, especially by young members of the public, are sold in the same supermarkets, and are often mentioned on menus of bars alongside each other (§ 113-115).

28/04/2021, T-509/19, [Flügel / ... Verleiht Flügel et al](#), EU:T:2021:225, § 111, 115

### 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

[No key points available yet.]

- Relevant public

[No key points available yet.]

- Goods and services covered

#### Consideration of goods and services for which registration of the mark is sought and not those for which it is used

In assessing the degree of proximity between the goods in the context of the assessment of the existence of a link in the minds of the relevant public between the conflicting marks within the meaning of Article 8(5) CTMR [now EUTMR], account must be taken of the goods for which registration of the mark is sought and not those for which it is actually used (§ 53).



EU:T:2021:192, § 53

14/04/2021, T-201/20, [GHISU \(fig.\) / CHIANTI CLASSICO DAL 17 \(fig.\) et al.](#),

- **Relevant territory**

[No key points available yet.]

- **Relevant point in time**

### **Evidence to prove the reputation of the earlier mark — Relevant date**

Even if some documents submitted to prove the reputation of the earlier mark bear a date which is five years earlier than the filing date of the contested EUTM (the relevant date), this fact does not deprive such documents of their evidential value. It cannot automatically be ruled out that a document drawn up some time before or after the relevant date may contain useful information since the reputation of a trade mark is, in general, acquired progressively (16/10/2018, T-548/17, ANOKHI (fig.) / Kipling (fig.) et al., EU:T:2018:686, § 103-104) (§ 112).

05/10/2020, T-51/19, [apiheal \(fig.\) / APIRETAL](#), EU:T:2020:468, § 112

### **Relevant date and posterior documents to prove reputation**

The reputation of an earlier mark must be established as at the filing date of the application for the contested mark, but documents bearing a date later than that cannot be denied evidential value if they enable conclusions to be drawn about the situation as it was on that date. However, a survey carried out more than 13 years after the date of registration of the earlier mark, the results of which merely make it possible to draw conclusions on the situation as it appeared several years after that date, does not substantiate the reputation of the earlier mark at the date of registration (§ 75-77).

28/04/2021, T-509/19, [Flügel / ... Verleiht Flügel et al.](#), EU:T:2021:225, § 75-77

- **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

#### Comparison of signs — Assessment of similarity between the signs — Link between the signs — Collective mark vs. individual mark

In the context of the comparison of the signs for the purposes of Article 8(5) CTMR [now EUTMR], it is not contradictory to conclude that there is an overall similarity between the conflicting signs without taking a definitive position on that similarity in phonetic terms, provided that the overall similarity is sufficient for the public concerned to establish a link between them. Therefore, a degree of similarity, even a slight one, and even on a single level, does not, on its own, preclude the application of Article 8(5) CTMR [now EUTMR] (20/11/2014, C-581/13 P & C-582/13 P, Golden balls, EU:C:2014:2387, § 72-77) (§ 32).

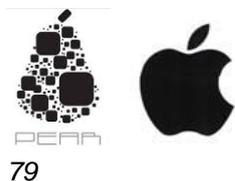
The comparison of the conflicting signs, one of which constitutes a collective mark and the other an individual mark, is based on the same criteria as those applicable to the comparison of the signs constituting two individual marks (05/03/2020, C-766/18 P, BBQLOUMI (fig.) / HALLOUMI, EU:C:2020:170, § 59). Consequently, there is nothing to prevent the conclusion that the sign making up an individual mark and that making up a collective mark convey the same or, as in the present case, a similar concept (§ 34).



14/04/2021, T-201/20, [GHISU \(fig.\) / CHIANTI CLASSICO DAL 17 \(fig.\) et al.](#), EU:T:2021:192, § 32, 34

## 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

## Lack of similarity of the signs — No damage to reputation

The marks must be compared in their forms as applied for and registered, regardless of any possible rotation in their use on the market (§ 24-30, 32, 53).



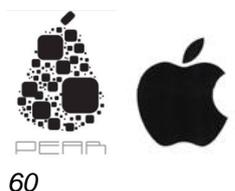
21/04/2021, T-44/20, [DEVICE OF TWO INTERLOCKING ELEMENTS \(fig.\) / DEVICE OF TWO BOLD BLACK CIRCLES OVERLAPPING \(fig.\)](#), EU:T:2021:207, § 24-30, 32, 53

### 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).



31/01/2019, T-215/17, [PEAR \(fig.\) / APPLE BITE \(fig.\) et al.](#), EU:T:2019:45, § 51,

60

#### 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

## Link between the signs — Nature and degree of proximity of the goods or services

There is a certain proximity between the contested goods in Classes 9, 11 and 17, *sanitary installations and parts and accessories of the same, bath accessories*, and the earlier right's *hotels and restaurants services* in Class 43 on account of their complementary character (§ 159-162).

In view of the identity of the signs, the proximity of the goods and services, and the higher level of attention paid by the relevant public to the contested products, there is a risk that an association may be made between the two signs (§ 171-172).

09/09/2020, T-144/19, [ADLON / ADLON](#), EU:T:2020:404, § 159-162, 171-172

## Link between the signs — Nature and degree of proximity of the goods or services

Although goods in Class 28 and *beers* in Class 32 have a different nature and are not similar in the context of Article 8(1)(b) EUTMR, there is a certain link between them according to Article 8(5) EUTMR. In establishments where beer is offered, such as pubs, it is not unusual to find terminals, machines or equipment for playing games of chance, including if they are likely to provide the player with a financial gain (§ 99, 104).

In view of the identity of the signs, the average degree of reputation of the earlier mark and the fact that there is some connection between the goods (in spite of their different nature), the relevant public, for both marks composed of professionals, could make a link between the earlier marks and the mark applied within the meaning of Article 8(5) EUTMR (§ 107-108).

### **Link between the signs — Assessment of the link according to the strength of the reputation and the distinctive character of the earlier mark**

The assessment of the link in the minds of the relevant public is likely to vary according to the strength of the reputation and the distinctive character of the earlier mark. In the present case, although the earlier mark enjoys a certain reputation, no evidence has been adduced supporting the fact that this reputation goes beyond the public concerned with the services for which it was registered (§ 98-99).

In the context of an average degree of repute of the earlier mark and having regard to the average degree of similarity between the marks, the different nature of the goods and services, the high level of attention of the public targeted by the mark applied for and the average distinctiveness of the earlier mark, it cannot be concluded that the relevant public would establish a link between the marks at issue (§ 101). In these circumstances, the fact that the earlier mark consists of an invented word and that the mark applied for reproduces it verbatim, by simply adding a descriptive word after it, is not a crucial factor in creating a link in the minds of the relevant public (§ 105).

28/04/2021, T-644/19, [VertiLight / VERTI](#), EU:T:2021:222, § 98-99, 101, 105

### **Absence of link between the signs — Lack of link between the services — Different public**

Services intended for different publics are neither complementary (22/01/2009, T-316/07, *easyHotel*, EU:T:2009:14, § 57-58 and the case-law cited) nor in competition with each other (18/02/2011, T-118/07, *PPT*, EU:T:2011:58, § 39 and 40 and the case-law cited) (§ 64).

Notwithstanding the strong reputation of the earlier figurative marks and the above-average degree of similarity between the marks, the lack of any link between the services (relating to the gambling sector in Class 41 for the earlier marks and the scientific and technological sector in Class 42 for the contested mark) and the difference between the relevant publics, one of which is a specialist public with a high level of attention, are such that the existence of a link between the marks, this being a condition for the application of Article 8(5) EUTMR, can be ruled out (§ 66).



11/11/2020, T-820/19, [Lottoland-LOTTO \(fig.\) e.a.](#), EU:T:2020:538, § 64, 66

### **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

### **Link between the marks — Exceptional reputation**

The fact that the marks are similar and that the earlier mark has an exceptional reputation cannot automatically be sufficient for a link between those marks to be found (§ 71). This is the case

even if it is established that the specialised public targeted by the goods protected by the contested mark is aware of the earlier mark, whose reputation goes beyond the public of the goods covered by the earlier mark (§ 85).

 10/03/2021, T-71/20, [Puma-system / PUMA \(fig.\)](#), EU:T:2021:121, § 71, 85

### **No obligation to exam *ex officio* the exceptionally strong reputation of a mark**

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**

#### **Requirement to establish one of the harms referred to in Article 8(5) EUTMR**

In the absence of exceptional reputation of the earlier trade mark, serious risk of one of the harms referred to in Article 8(5) EUTMR must be shown (§ 124-127).



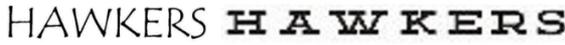
19/05/2021, T-510/19, [DEVICE OF A JUMPING ANIMAL \(fig.\) / PUMA \(fig.\) et al.](#), EU:T:2021:281, § 124-127

### **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).

 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

## Risk of unfair advantage of the distinctive character or the repute — Irrelevance of intent

The absence of any intent on the part of the proprietor of the contested mark to free-ride, even if established, is not in itself sufficient to rule out the possibility of unfair advantage being gained from the use of that mark, since subjective factors such as the commercial intentions, real or supposed, of the proprietor of the contested mark do not have to be taken into account (§ 134).

28/04/2021, T-509/19, [Flügel / ... Verleiht Flügel et al](#), EU:T:2021:225, § 134

- [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

### Preliminary ruling — Article 13(1)(d) Regulation No 510/2006 — Article 13(1)(d) Regulation No 1151/2012 — Practice liable to mislead the consumer as to the true origin of the product — Reproduction of the shape or appearance of a product which has a protected name

EU law prohibits, in certain circumstances, the reproduction of the shape or appearance of a product protected by a protected designation of origin (PDO). It is necessary to determine whether that reproduction may mislead consumers considering all the relevant factors, including the way in which the product is presented and marketed to the public and the factual context (§ 39, 41).

17/12/2020, C-490/19, [Morbier](#), EU:C:2020:1043, § 39, 41

### Use of a protected designation of origin (PDO) pursuant to Article 103(2)(a)(ii) of Regulation (EU) No 1308/2013

The mark applied for has a high degree of visual similarity and is phonetically identical in its initial element, at least in French, to the earlier protected designation of origin (PDO). The conditions for allowing a finding of 'use' of the PDO 'Porto' in the mark applied for are satisfied in that, in

accordance with the case-law, the signs are visually and phonetically similar to such a degree that the sign whose registration is contested is clearly indissociable from the earlier PDO (§ 39-44).

06/10/2021, T-417/20, [Portwo gin / Porto](#), EU:T:2021:663, § 39-44

### **Association between the trade mark applied for and the earlier PDO**

The incorporation of a PDO in a trade mark cannot be held to be capable of exploiting the reputation of that designation of origin if that incorporation does not lead the relevant public to associate that mark or the goods for which it is registered with the designation of origin or the wine product for which it is protected. In light of the strong similarities between the mark applied for and the PDO 'Porto', the degree of proximity of the goods and the exceptional reputation of the PDO, the BoA did not err in finding it probable that the relevant consumer would associate the mark applied for with that PDO (§ 45-48).

06/10/2021, T-417/20, [Portwo gin / Porto](#), EU:T:2021:663, § 45-48

### **Exploitation of the reputation of the earlier PDO**

Exploitation of the reputation of a PDO refers to any use of the PDO that seeks to take undue advantage of its reputation. The particular image and distinctive qualities that the PDO 'Porto' enjoys for wines in the eyes of the relevant public are transferable to the goods – *spirits* – covered by the mark applied for (§ 49-54).

06/10/2021, T-417/20, [Portwo gin / Porto](#), EU:T:2021:663, § 49-54

## **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

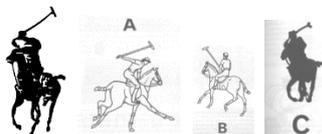
[No key points available yet.]

## 8.5 RIGHT TO PROHIBIT THE USE OF A SUBSEQUENT TRADE MARK UNDER THE APPLICABLE LAW

**Invalidity proceedings — Article 52(2)(d) CTMR [now Article 60(2)(d) EUTMR] — Earlier industrial right — Relevant date for the establishment of the right to prohibit the use of the contested mark**

It follows from the broad logic of the other provisions of the regulation concerning relative grounds for refusal that an application for a declaration of invalidity must be rejected where the cancellation applicant is unable to prove that its earlier mark continues to enjoy protection on the date on which the Office takes its decision and it is established, with certainty, that the conflict with the earlier trade mark no longer exists (§ 27-29).

In the context of Article 52(2)(d) CTMR [now Article 60(2)(d) EUTMR] the proprietor of an earlier industrial property right must therefore establish that he may prohibit the use of the contested EU trade mark not only on the date of filing or priority of that mark, but also on the date on which the Office gives a ruling on the application for a declaration of invalidity (§ 30).



02/06/2021, T-169/19, [DEVICE OF A POLO PLAYER \(fig.\) / DEVICE OF A POLO PLAYER \(fig.\) et al.](#), EU:T:2021:318, § 27-30

# 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 — Formal requirements — Expressly and timeously

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  
01/12/2021, T-359/20, [Team Beverage](#), EU:T:2021:841, § 40

#### Invalidity proceedings — Article 15 and Article 57 CTMR [now Article 18 and Article 64 EUTMR] — No obligation for proof of genuine use of the earlier mark — Declaration of invalidity

The Board of Appeal (BoA) correctly found that the conditions for requesting proof of use of the earlier mark were not satisfied since the earlier mark had been registered less than five years before the date of the application for a declaration of invalidity (§ 34).

Article 15 CTMR does not provide that a trade mark that has not been put to genuine use within a period of five years following registration can be subject to 'revocation'. For a trade mark proprietor's rights to a mark to be revoked, there are also conditions that need to be satisfied that are not laid down in Article 15 CTMR (but in Article 51(1) CTMR, which relates to the specific procedure that deals with the revocation of a mark) (§ 20-33).

21/12/2021, T-870/19, [CLEOPATRA QUEEN \(fig.\) / Cleopatra melfinco et al.](#), EU:T:2021:919, §20-34

### 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

#### No obligation on the BoA to perform an *ex officio* search of evidence

In so far as the applicant asserts that the addresses of the clients referred to in evidence could easily be found via an internet search and that the BoA failed to carry out such a search, it must be held that the burden of proving genuine use of the mark in the context of revocation proceedings rests with the proprietor of the mark (§ 77).

07/07/2021, T-205/20, [I-cosmetics](#), EU:T:2021:414, § 77

### **Genuine use to be proven for EUTMs and earlier national marks relied on in an application for a declaration of invalidity — Article 15 CTMR [now Article 18 EUTMR]**

Where the proprietor of an EUTM requests proof of genuine use to be submitted, that use constitutes a condition which must be met, under Regulation No 40/94, not only by EUTMs but also by earlier national marks relied on in support of an application for a declaration of invalidity of that EUTM. Therefore, the application of Article 43(2) of Regulation No 40/94 to earlier national marks under paragraph 3 of that article means that genuine use is to be defined according to Article 15 CTMR and not by national law (§ 98) (see, by analogy, in relation to invalidity proceedings, 12/07/2019, T-412/18, *mobile.ro (fig.) / mobile (fig.)*, EU:T:2019:516, § 23) (§ 98).



23/09/202023/09/2020, T-796/16, [Grass in bottle / Bottle with strand of grass et al.](#), EU:T:2020:439, § 98

## **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 — Trade mark identical with company name**

When a word mark is also a company name, it is possible for the company name to be used as a trade mark (15/07/2015, T-24/13, CACTUS OF PEACE CACTUS DE LA PAZ (fig.) / CACTUS, EU:T:2015:494, § 62). However, the purpose of a company name is to identify a company and is not, of itself, to distinguish goods or services. Accordingly, there is use in relation to goods or services where a third party affixes the sign constituting its company name to the goods that it markets or, even where the sign is not affixed, where the third party uses that sign in such a way that a link is established between the sign which constitutes the company of the third party and the goods marketed or the services provided by the third party (11/09/2007, C-17/06, Céline, EU:C:2007:497, § 21-23) (§ 32-33).

02/06/2021, T-17/20, [GAMELAND \(fig.\) / Gameloft](#), EU:T:2021:313, § 32-33

### **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

## **Genuine use for high-end sports cars about to be marketed — Preparatory tasks and advertising efforts**

In the market for high-end sports cars with technical specifications, the provision of sales figures or invoices is not necessary for establishing genuine use of the mark (15/07/2015, T-398/13, TVR ITALIA (fig.) / TVR et al., EU:T:2015:503, § 57) (§ 70). The existence of various preparatory tasks and advertising efforts (various Polish and international press articles) showing not only that the car was about to be marketed, but also that it was available to order, may be sufficient (§ 71).

23/09/2020, T-677/19, [SYRENA](#), EU:T:2020:424, § 70-71

## **Proof of genuine use — Public use in the course of the trade — Relevance of invoices to retailers — External use not restricted to final consumers**

Genuine use of the trade mark presupposes that it is used publicly and externally, and not only within the undertaking concerned. However, external use of a trade mark is not necessarily equivalent to use that is directed towards final consumers. Actual use of the mark relates to the market in which the proprietor of the mark carries on business and in which they hope to exploit their mark. To consider that external use of a trade mark, within the meaning of the case-law, necessarily consists of use that is directed towards final consumers would effectively exclude trade marks used solely in business-to-business relationships from protection. The relevant public to which trade marks are intended to be directed not only includes final consumers but also specialists, industrial customers and other professional users (07/07/2016, T-431/15, FRUIT, EU:T:2016:395, § 49 and case-law cited) (§ 26, 32, 36).

10/11/2021, T-353/20, [ACM 1899 AC MILAN \(fig.\) / Milan et al.](#), EU:T:2021:773, § 26, 32, 36

## **2.3 MANNER IN WHICH THE TRADE MARK IS USED IN RELATION TO THE 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

### **Use of the mark for services cannot be shown through its use on goods — Proof of genuine use of the sign that is not affixed to the product only when a link is established**

The mere fact that the mark was used in connection with the goods offered also for professionals (i.e. cosmetics) is not sufficient to establish the mark's use in respect of the services that entail the use of those goods (i.e. cosmetic services) (§ 38).

Where the sign is not affixed to a product, there is only genuine use where it is used in such a way that a link is established between that sign and the goods marketed (§ 89).

07/07/2021, T-205/20, [I-cosmetics](#), EU:T:2021:414, § 38, 89

### **Use of the different elements of the mark on different parts of the goods**

The proprietor has not demonstrated genuine use of the contested mark in the form in which it was registered since the evidence submitted concerned use of the contested mark in a form differing in elements, which altered the distinctive character of that mark from the form in which it had been registered (§ 8, 66). In particular, the use of the elements 'rich' and 'richmond' together but on different parts of the goods cannot constitute genuine use of the contested mark which does not alter its distinctive character (§ 48). The presentation of a product bearing the element 'rich' in the rather broad context of a RICHMOND catalogue or in a RICHMOND store does not permit the inference that the trade mark used on such a product consists not only of the element 'rich', but also of the element 'richmond' (§ 52).

**R I C H**

JOHN RICHMOND 14/07/2021, T-297/20, [RICH JOHN RICHMOND \(fig.\)](#), EU:T:2021:432, § 8, 48, 52, 66

### **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).

### **Use as a trade mark versus use as a company name — Definition of a subcategory of goods or services — Purpose or intended use of the product or service — Partial use**

Where the use of a company name, trade name or shop name is limited to identifying a company or indicating a business, this use cannot be considered to be 'in relation to goods or services'. By contrast, there is use 'in relation to goods' where the proprietor of the mark or a third party affixes the sign constituting its company, trade or shop name to the goods that it markets. Even where the sign is not affixed, there is use 'in relation to goods or services' where the sign is used in such a way that a link is established between the sign constituting the company, trade or shop name and the goods marketed or the services provided (§ 41-42).

Since consumers primarily search for products or services that meet their specific needs, the purpose or intended use of the product or service in question is vital in directing their choices. Therefore, the purpose or intended use of a product or service is of fundamental importance in the definition of a subcategory of goods or services (§ 79). Consequently, the BoA was right to find that the trade mark use for dried plums falls within the category of 'dried fruits' (§ 82) and use for tomatoes and broccoli falls within the category of 'fresh vegetables' (§ 84, 86).

13/10/2021, T-12/20, [Frutaria \(fig.\)](#), ECLI:EU:T:2021:702, § 41-42, 79, 82, 84, 86

### **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  
18/11/2020, T-643/19, [JUVEDERM ULTRA](#), EU:T:2020:549, § 28

### **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

## **Territorial scope of use — US Department of Defense and US military bases in the EU**

Sales of goods to the US Department of Defense and the US State Department for military bases located in Belgium and Germany, which are not impressive and are likely to merely reflect the needs of the soldiers living on those military bases, are not capable of establishing the proprietor's intention to create a commercial outlet in the EU for the goods in question (§ 37).

28/10/2020, T-583/19, [Frigidaire](#), EU:T:2020:511, § 37

## **Territorial scope of use — Small territory counterbalanced by length, periodicity and extent of use**

The fact that use of the earlier mark has been proved only in connection with small parts of Germany and France does not preclude that use from being genuine. This is particularly true because that use has been proved, not in a sporadic manner, but throughout almost the whole of the relevant period and to sufficiently significant quantities (§ 38).

24/11/2021, T-551/20; [Riviva / Rivella](#), EU:T:2021:816, § 38

## **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

### **Preliminary ruling — Article 51(1)(a) CTMR [now Article 58(1)(a) EUTMR] — Counterclaim — Revocation for non-use — Expiry of the period of five years — Date of assessment**

Article 51(1)(a) CTMR must be interpreted as meaning that, in the case of a counterclaim for the revocation of rights in an EU trade mark, the relevant date for the purposes of determining whether the continuous five-year period referred to in that provision has ended is the date on which that counterclaim was filed (§ 51).

17/12/2020, C-607/19, [Husqvarna](#), EU:C:2021:61, § 51

### **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 — Consideration of documents from just outside the relevant period**

The commercial life of a product generally extends over a period of time, and continuity of use is one of the indications to be taken into account to establish that the use was objectively intended to create or maintain a market share. Therefore, documents from outside the relevant period must be taken into account and assessed together with the other evidence, as they may provide evidence of real and genuine commercial exploitation of the mark (16/06/2015, T-660/11, POLYTETRAFLON / TEFLON, EU:T:2015:387, § 54 and case-law cited) (§ 36).

10/11/2021, T-353/20, [ACM 1899 AC MILAN \(fig.\) / Milan et al.](#), EU:T:2021:773, § 36

### **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 — Means of evidence — Catalogues**

It does not follow from the judgment *Peerstorm* (08/07/2010, T-30/09, *Peerstorm*, EU:T:2010:298), that the mere production of evidence such as catalogues is sufficient per se to establish a certain extent of use of an earlier right. As is apparent from paragraphs 41 to 44 of that judgment, the evidence produced in connection with that case, which consisted essentially of catalogues, was plentiful, displayed the mark concerned on the goods it covered, referred to a large number of items and demonstrated that they were available in 240 stores in the United Kingdom during a significant part of the relevant period. In addition, those catalogues contained specific information about the goods offered for sale under that mark, such as their price and the way in which they were marketed. It was on the basis of that evidence that the GC found in that case that the abovementioned catalogues sufficiently demonstrated the use of the earlier right for the goods covered by it (§ 33).

08/09/2021, T-493/20, [Sfora wear / Sfera \(fig.\) et al.](#), EU:T:2021:540, § 33

### **Extent of use — Means of evidence — Affidavit**

Genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark in the market concerned. An affidavit must be corroborated by other credible and objective evidence (§ 32, 41, 47, 53-54, 61).

22/09/2021, T-591/19, [Healios \(fig.\) / HELIOS](#), EU:T:2021:606, § 32, 41, 47, 53-54, 61

### **Extent of use — Means of evidence — Market for high-end sports cars with technical specifications**

In the market for high-end sports cars with technical specifications, the provision of sales figures or invoices is not necessary for establishing genuine use of the mark (15/07/2015, T-398/13, *TVR ITALIA (fig.) / TVR et al.*, EU:T:2015:503, § 57) (§ 70). The existence of various preparatory tasks and advertising efforts (various Polish and international press articles) showing not only that the car was about to be marketed, but also that it was available to order, may be sufficient (§ 71).

23/09/2020, T-677/19, [SYRENA](#), EU:T:2020:424, § 70-71

### **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

### **Means of evidence — Use for *meet* which is not merely token**

The issuing of 17 invoices for a total amount of EUR 44 988.94, concerning various clients established in different EU countries (Germany, Spain and Sweden) and different Spanish regions (such as Andalusia and Catalonia), show use of the earlier mark which is not merely token for *meat* in Class 29 (§ 38-41).

23/09/2020, T-737/19, [MONTISIERRA huevos con sabor a campo \(fig.\) / MONTESIERRA](#), EU:T:2020:428, § 38-41

### **Means of evidence — Lack of proof of genuine use**

The proprietor did not demonstrate genuine use of the contested mark for *sport bags* in Class 18 and *clothing items* in Class 25. In particular, for *ski bags*, most of the evidence was undated and turnover figures were not provided for specific goods but in an overall manner. For *tennis bags*, proven sales of only 34 bags for a total of EUR 675 to two customers in two Member States were considered too low, particularly for mass consumption products, with no advertisement expenditure provided, undated photos and turnover unspecified for the goods. As for *clothing items*, there was just a single sale of one leather jacket for a total of EUR 200, with undated photos and an unspecified turnover for the goods (§ 55, 41-50, 68-69).

14/07/2021, T-65/20, [Kneissl](#), EU:T:2021:462, § 55, 41-50, 68-69

### **Means of evidence — Seasonal products — Lack of proof of genuine use**

The evidence submitted is not sufficient to prove that the contested trade mark was put to genuine use in respect of the goods during the relevant period (§ 46). This is not called into question by the applicant's argument that less stringent requirements must be placed on the proof of genuine use of the contested trade mark due to the seasonal nature of its use, because the sausages for which the trade mark is used are sold only as seasonal products during Halloween. Even assuming that the seasonal use of the contested trade mark affects the duration of its use and the duration of the periods to be taken into account, no less stringent requirements are to be established with regard to the extent of use. The applicant did not submit pertinent evidence to prove genuine use of its trade mark at least from September to November each year during the relevant period (§ 47).

10/11/2021, T-500/20, [Hallowiener](#), EU:T:2021:768, § 46-47

### **Means of evidence — Evidence outside the relevant period — Proof of actual sales — Nature of goods — Lack of proof of genuine use**

It is possible to consider evidence that relates to use of the mark made before or after the relevant period, where this information makes it possible to confirm or better assess the extent to which the mark was used and the actual intentions of the proprietor during that period. However, this evidence can only be taken into consideration if other evidence relating to the relevant period has been produced (§ 44-45). Although evidence that does not relate to the relevant period may be taken into account and assessed in conjunction with other evidence to further substantiate proof of real and genuine commercial use of the mark, this does not mean that proof of genuine use of the mark can be based solely on evidence that does not relate to the relevant period (§ 49).

The extracts from the website 'Amazon.co.uk' merely show that the goods in question were offered for sale, but do not prove that they were actually sold and do not provide any information regarding the volume of sales. Even assuming that some of the goods were actually sold on the internet during the relevant period, since the extracts from the website 'Amazon.co.uk' do not

quantify the volume of sales, they do not prove that there was a sufficient volume of sales (§ 57-58).

In light of the nature of the goods, which are everyday consumer goods, and of their modest price, the sale of only 18 items bearing the contested mark at the end of the relevant period cannot be considered to be sufficient to prove genuine use of the mark (§ 59). The smaller the commercial volume of the use of the mark, the greater the necessity for the proprietor of the mark to produce additional evidence to dispel any doubts as to the genuineness of its use (§ 64).

13/10/2021, T-1/20, [Instinct](#), EU:T:2021:695, § 44-45, 49, 57-59, 64

### Proof of use in the case of trade mark transfer

The transfer of a mark cannot lead to its new proprietor being deprived of the opportunity to adduce proof of genuine use of the mark in the course of the relevant period during which they were not the proprietor of the mark. Any contrary finding would expose the new proprietor to the risk of revocation of their acquired rights without being able to benefit from the legitimate protection derived from the use of that mark by the former proprietor, or a third party with their consent, during the earlier relevant period prior to acquisition of the rights by the new proprietor (§ 30).

13/10/2021, T-12/20, [Frutaria \(fig.\)](#), ECLI:EU:T:2021:702, § 30

## 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**

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

### **Use not as registered — Weak distinctive character — Three-dimensional mark — Mark used only as part of a composite mark or in conjunction with another mark — Alteration of the distinctive character**

If the distinctive character of a mark is weak, its scope of protection, as defined by its graphic representation, is narrow. Moreover, where it is used solely as part of a complex trade mark or jointly with another mark, its distinctive character is easily altered by adding a component that is itself distinctive. This is all the more true in cases of 3D marks (24/09/2015, T-317/14, Shape of a cooking stove, EU:T:2015:689, § 33, 37) (§ 140, 155-156).

23/09/2020, T-796/16, [Grass in bottle / Bottle with strand of grass et al.](#), EU:T:2020:439, § 140, 155-156

## 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'

#### **Revocation proceedings — Genuine use of the mark in connection with the goods — Irrelevance of incorrect classification considering that the Nice Classification exclusively serves administrative purposes**

The BoA correctly found that the contested mark has been used for *biocompatible substances for medical purposes for reducing wrinkles* and that the incorrect registration of that mark in respect of such substances as goods in Class 10 instead of Class 5 was not a reason for granting the application for revocation in respect of those goods (§ 62).

According to Rule 2(2) CTMIR [reproduced, in essence, in Article 33(2) EUTMR], the list of goods and services must be worded in such a way as to indicate clearly the nature of the goods and services and to allow each item to be classified in only one class of the Nice Classification. According to Rule 2(4) CTMIR [now Article 33(7) EUTMR], the classification of goods and services exclusively serves administrative purposes. This means that goods and services may not be regarded as being similar to each other based on the fact that they appear in the same class under the Nice Classification, and may not be regarded as being dissimilar from each other based on the fact that they appear in different classes under the Nice Classification. The purpose of the Nice Classification is only to facilitate the drafting and processing of trade mark applications by suggesting certain classes and categories of goods and services. Moreover, the Nice Classification cannot determine, in itself, the nature and characteristics of the goods (see 28/05/2020, T-681/18, *Stayer (fig.)*, EU:T:2020:222, § 40 and the case-law cited) (§ 54).

In these circumstances, particularly considering the aims pursued by the Nice Classification, the mere fact that the contested mark was registered for *biocompatible substances for medical purposes for reducing wrinkles* designated incorrectly as goods in Class 10 instead of Class 5 cannot lead to the revocation of that mark for such goods if that mark has actually been used for those goods (§ 55).

06/10/2021, T-372/20, [Juvederm](#), EU:T:2021:652, § 54, 55, 62

### **Revocation proceedings — Lack of genuine use in connection with the goods — Possible classification of the goods in different classes of the Nice Classification — Interpretation in the light of the Nice Classification**

The BoA correctly confirmed the revocation of the contested mark as regards *dermal implants* (Class 10) (§ 32, 49-50). By choosing to register the contested mark in respect of *dermal implants* in that class, the applicant gave the description of those goods a specific meaning, which cannot be extended to *injectable dermal fillers* in Class 5 for which the mark is being used (§ 57).

Since goods described by the term *dermal implants* can be classified, according to the characteristics of the goods covered, either in Class 5 or Class 10, the BoA was required to interpret the term in the light of the class chosen by the applicant when the application for registration was lodged (§ 39).

In addition, the alphabetical list for Class 10 in force at the time when the application for registration of the contested mark was lodged already included *surgical implants*. There is nothing to indicate that the meaning of this term has evolved significantly over time. Furthermore, the addition of the words ‘artificial materials’ to the term *surgical implants* in 2001, and therefore before the contested mark was registered, merely confirms the underlying reason for the distinction between *implants* in Class 10 and those composed of living tissues in Class 5 (§ 42).

06/10/2021, T-397/20, [Juvederm](#), EU:T:2021:653, § 39, 42, 57

### **Revocation proceedings — Genuine use of the marks — Use in connection with the goods in respect of which the marks were registered — Principle that a finished product is classified in one class according to its function or purpose — Multipurpose objects**

As regards a finished product (i.e. a product ready to be marketed), the applicable General Remarks of the ninth edition of the Nice Classification first set out a principle before envisaging a specific situation (§ 37). The principle is the classification of a finished product in one class according to its function or purpose. The specific situation is that of ‘a multipurpose composite object’ which, by way of exception to the aforementioned principle, is capable of being classified in a number of classes because of its various functions or intended purposes. A dual classification of the same product is not normally possible in light of the wording of Rule 2(2) CTMIR (applicable *ratione temporis*) (§ 38).

The BoA, therefore, correctly found, in the context of the assessment of the evidence of use (in particular relating to the ‘x-presso monster’ goods), that it was necessary to refer to the principle set out in the General Remarks rather than the specific situation relating to multipurpose composite objects (§ 39).

*Energy drinks* in Class 32 are distinguished, with regard to the Nice Classification, from *coffee-based beverages* in Class 30. 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 at issue. According to the explanatory notes of the Nice Classification, non-alcoholic beverages generally fall within Class 32, whereas beverages with a coffee base which are included in Class 30 and expressly excluded from Class 32 refer to beverages in which coffee constitutes the predominant and characteristic element (§ 49). Therefore, a beverage that is merely ‘flavoured with coffee’ and not ‘coffee-based’ falls within Class 32 and not Class 30 (§ 50).

Multipurpose composite objects are goods which are sold as a whole, but in which each of the components has an independent and distinct market value and could be marketed without the other specific components sold with it. By contrast, the proprietor’s canned beverages constitute an inseparable, homogeneous product that fulfils the single main function of being a stimulating energy drink, in the present case one that is flavoured with coffee (§ 51).

Coffee-based beverages and energy drinks have different natures and do not fulfil the same main function. Coffee-based beverages are characterised by the presence of coffee, whereas energy drinks include and combine a number of ingredients, and coffee (or coffee flavouring) is given only a secondary role. Consumers are aware of those differences, which are reinforced by the proprietor's communications and promotion with regard to the 'x-presso monster' goods, which highlight the energy content of those goods (§ 52). The proprietor has not proved that the goods concerned fall within both Class 30 (*coffee-based beverages*) and Class 32 (*energy drinks*) by virtue of the exception (§ 53). The BoA correctly analysed the various items of evidence by applying the principle that a finished product is classified in one class according to its function or purpose (§ 53).

It is established, as regards the 'current market conditions for energy drinks' referred to by the BoA, that energy drinks flavoured with coffee are usually found on the same shelves as energy drinks with other flavours, whether they are the applicant's or those of other manufacturers. Consumers do not perceive any difference in function or purpose between the various flavours of energy drinks. All of those drinks fulfil the same function, which is to provide an energy boost (§ 64).

10/11/2021, T-758/20, [Monster](#) and T-759/20, [Monster energy](#), EU:T:2021:776, § 37-39, 49-53, 64

## 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

### **Subcategories of goods and services for proof of genuine use — Delimitation of *real estate affairs* and *financial affairs* in Class 36**

The BoA correctly considered that, irrespective of whether or not the EUTM proprietor is a building promoter, it proved genuine use for services related exclusively to ‘real estate affairs’ and not to ‘financial affairs’ in Class 36, although the services fall within the field of real estate investment (§ 60-61). Whereas financial services are provided by financial institutions for the purposes of managing their clients’ funds and consist of, inter alia, the holding of deposited funds, the remittance of funds, the granting of loans or the performance of various financial operations, real estate services are services connected with a property, namely, in particular, the lease, the purchase, the sale or the management of such a property (17/09/2015, T-323/14, Bankia / BANKY, EU:T:2015:642, § 35) (§ 35-37).

17/03/2021, T-114/20, [URSUS Kapital \(fig.\)](#), EU:T:2021:144, § 35-37, 60-61

### **Subcategories of goods and services for proof of genuine use — *Virtual games* do not fall under *casino games***

Virtual games do not fall under *casino games* in Class 28 (§ 37). The EUTM is used to designate a type of software containing casino games, which are presented on the screens of casino apparatus. The owner of the EUTM has not proven use for any virtual games other than this software for casino games, which is protected in Class 9 (§ 40-41).

24/03/2021, T-588/19, [Power Stars](#), EU:T:2021:157, § 37, 40-41

### **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

### **Proper reasons for non-use pursuant to Article 51(1)(a) CTMR**

In order to be classified as ‘proper reasons’, obstacles to the use of a trade mark must satisfy three cumulative conditions: (i) have a sufficiently direct link with the trade mark, (ii) make the use of the mark impossible or unreasonable and (iii) be independent of the will of the proprietor of the trade mark (§ 40).

The BoA erred in holding that the existence of national infringement proceedings against the proprietor of the contested mark was not independent of its will (§ 44). However, this error does not justify the annulment of the contested decision.

In the national court proceedings, the applicant was charged the sum of EUR 60 000 by way of damages. Therefore, the applicant’s assertion that it might be ordered to pay compensation of EUR 72 million has no factual basis and is not supported by any evidence (§ 62-65).

The applicant has not adduced proof of particular circumstances showing that the existence of the national court proceedings made it unreasonable to use the mark at issue during the relevant period (§ 76).

30/06/2021, T-362/20, [Reacciona](#), EU:T:2021:399, § 40, 44, 62-65, 76

## **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.]

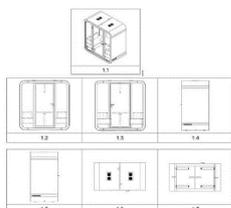
#### 1.5 REPRESENTATION OF THE DESIGN

**No requirement for the representation of the earlier design to include views reproducing it from all possible angles – Features of the earlier design must be apparent from the submitted representation**

It is not apparent from the regulation that the representation of the earlier design must include views reproducing it from all possible angles, so long as that representation allows the shape and the features of the design to be identified (§ 23).

A design may be regarded as having been disclosed when only some of its features are visible in the documents put forward to establish its disclosure (§ 39).

An infringement resulting from an improper extension of the protection of an earlier design takes place only where the BoA, in assessing the overall impression produced by the earlier design, takes into consideration features that are not apparent from the view submitted when that design was registered (§ 31).



30/06/2021, T-373/20, [Buildings \[transportable\]](#), EU:T:2021:400, § 23, 39, 31

#### 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

### Consideration of the design for the nature, intended use or function of the product

To determine the products in which a design is intended to be incorporated or applied, account should be taken not only of the relevant indication in the application for registration (06/06/2019, T-209/18, *Kraftfahrzeuge / Kraftfahrzeuge*, EU:T:2019:377, § 33), but also of the design itself, insofar as it makes clear the nature, intended use or the function of product (§ 31).



15/10/2020, T-818/19, [Support pillow](#), EU:T:2020:486, § 31

## 1.9 PRIORITY

### Scope of Article 41(1) CDR — Interpretation of Article 41(1) CDR — Time limit for priority

Although the wording of Article 41(1) CDR does not expressly refer to the claiming of a priority right under a patent, the international patent applications follow the scope of that provision. The broad interpretation of this provision corresponds to the direction of protection of the Patent Cooperation Treaty (PCT), according to which utility models and patents are to be granted equivalent protection in the case of an international application. Pursuant to Article 3(1) PCT, applications for the protection of inventions may be filed in any of the contracting states as international applications within the meaning of this treaty. Furthermore, according to Article 2(i) PCT, ‘references to an “application” ... shall be understood as references to applications for patents for invention, for inventors’ certificates, for utility certificates, for utility models, for supplementary patents or certificates, for supplementary inventors’ certificates and for supplementary utility certificates’. The PCT therefore does not distinguish between the various rights with which the various states mentioned grant protection to the invention (§ 47, 49).

Article 41(1) CDR does not regulate the case of an application for registration of a design by invoking a right of priority based on a patent application and therefore does not provide for a time limit for claiming priority in that situation. It does not exhaustively regulate the time limit within which priority may be claimed in the context of a subsequent application for a design. Therefore, the provisions of the Paris Convention must be taken into account in its interpretation (§ 56-57, 63).

It follows from the logic inherent in the priority system that the duration of the priority period is generally determined by the nature of the prior right (§ 77-80). It is already clear from the wording of Article 4(E)(1) of the Paris Convention that it constitutes a special rule, namely an exception to the principle that the nature of the earlier right is decisive for determining the duration of the priority period (§ 81).

14/04/2021, T-579/19, [Turn- oder Sportgeräte und -artikel](#), EU:T:2021:186, § 47, 49, 56-57, 63, 81

## 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

#### **Community design — No res judicata**

According to Article 52(3) CDR, an application for a declaration of invalidity shall not be admissible if an application relating to the same subject matter and cause of action, and involving the same parties, has been adjudicated on by a Community design court and has acquired the authority of a final decision.

The identity of the cause of action with that of the prior case implies not only the same legal basis (i.e. reliance on the same legal provisions in support of the applications), but also the same facts and, in particular, the same designs (§ 19-20). In the present circumstances, the parties and the subject matter of the cases are identical, since both proceedings concern an application for a declaration of invalidity of the same design. However, the cause of action differs as the invalidity of the contested design is sought in the proceedings before the Office in relation to a design that was not relied on before (nor ruled upon by) the national court (§ 21-23).

17/11/2021, T-538/20, [Paños de limpieza, Ropa de mesa](#), EU:T:2021:793, § 19-23

### 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

#### **Non-compliance with requirements for protection — Features of appearance of a product solely dictated by its technical function**

To assess whether features of the appearance of a product are solely dictated by its technical function, it has to be established that the technical function is the only factor that has determined those features, the existence of alternative designs not being decisive in that regard (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 32) (§ 16).

When the design is applied to a complex product, the answer to the question of whether those features are 'solely dictated by the technical function of the product' pursuant to Article 8(1) CDR, requires, at the outset, an examination of the technical function of each of those features and an examination of the causal link between the technical function of each of those features and the technical function of the product concerned. When there is a causal link between the technical function of the feature and the technical function of the product, that is to say where that feature does contribute to the technical function of the product, that feature is 'solely dictated' by the technical function of the product (§ 54).

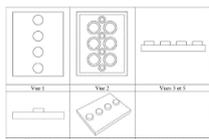
The fact that the product concerned contains several features, each of which fulfils a different function, does not exclude the application of Article 8(1) CDR: that provision does not require the features of the appearance to refer to one single technical result, and the features may produce several technical results, as long as they contribute to achieving the technical result intended by the product (§ 56).



18/11/2020, T-574/19, [fluid distribution equipment](#), EU:T:2020:543, § 16, 54, 56

### **Exception of Article 8(3) CDR — Protection of modular systems — Burden of proof — Reliance on Article 8(3) CDR for the first time before the BoA**

It is for the holder of the contested design to rely on the benefit of Article 8(3) CDR (§ 39). Neither the Regulation on Community designs nor the Rules of procedure of the BoA preclude the benefit of the exception in Article 8(3) CDR from being relied on, for the first time, before the BoA (§ 45-47, 50, 83). According to Article 60(1) CDR, the BoA has jurisdiction, inter alia, to rule on the claims of the proprietor of the contested design relating to the benefit of Article 8(3) CDR (§ 48-49).

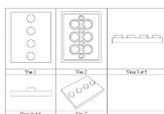


24/03/2021, T-515/19, [Building blocks from a toy building set](#), EU:T:2021:156, 45-50, 83

### **Features solely dictated by the technical function in Article 8(1) CDR and features of interconnection in Article 8(2) CDR — Applicability of Article 8(3) CDR to both features**

Article 8(1) CDR excludes protection under the law on Community designs for features of the appearance of a product where considerations other than the need for that product to fulfil its technical function, in particular those related to the visual aspect, have not played any role in the choice of those features, even if other designs fulfilling the same function exist (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 31). Features of appearance of the product covered by a design may fall within both Article 8(1) CDR and Article 8(2) CDR since they may both be solely dictated by the technical function of that product, namely to allow the connection and disconnection of that product, and constitute features of interconnection (§ 59-61, 68). However, all features of interconnection for the purposes of Article 8(2) CDR are not necessarily solely dictated by the technical function of the product covered by a design for the purposes of Article 8(1) CDR, since the interconnection of that product may not be the only factor which determined the appearance of those features (§ 62-67).

In order to preserve the effectiveness of Article 8(3) CDR, where the Office finds that the features of appearance of the product covered by the contested design fall within both Article 8(1) and Article 8(2) CDR, and where the holder of the contested design relies on the benefit of Article 8(3) CDR, it must examine whether those features are capable of benefiting from the protection of modular systems, including when the applicant for a declaration of invalidity did not rely on Article 8(2) of that regulation (§ 69-79, 80).



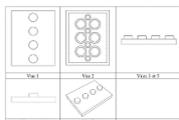
24/03/2021, T-515/19, [Building blocks from a toy building set](#), EU:T:2021:156, 59-62, 67-80

### **Article 8(1) DCR — Features of the appearance of a product solely dictated by its technical function — Burden of proof**

If at least one of the features of appearance of the product covered by a contested design is not solely dictated by the technical function of that product, the design cannot be declared invalid under Article 8(1) CDR (§ 96, 97-98).

It is for the applicant of a declaration of invalidity to demonstrate and for the Office to find that all the features of appearance of the product covered by the contested design are solely dictated by the technical function of that product (§ 99, 109).

Where the smooth surface of the upper face of a toy brick is a feature of the specific appearance of the product covered by the contested design and is not limited to a mere 'absence of studs on the upper surface of the brick' it must be taken into account (§ 105, 107).



24/03/2021, T-515/19, [Building blocks from a toy building set](#), EU:T:2021:156, 96, 97-99, 105, 107, 109

## 3.4 DESIGNS OF INTERCONNECTIONS

[No key points available yet.]

## 3.5 LACK OF NOVELTY AND INDIVIDUAL CHARACTER

### 3.5.1 Disclosure of earlier design

#### 3.5.1.1 General principles

**Preliminary ruling — Articles 4, 6 and 11 CDR — Unregistered Community designs in a (component) part of a (complex) product arising from disclosure of the overall design of the (complex) product — Requirements for the assessment of individual character**

The material conditions required for the protection of a Community design to arise, whether registered or not, namely novelty and individual character, within the meaning of Articles 4 to 6 CDR are the same for both products and parts of a product (§ 33). Provided that those material conditions are satisfied, the formal condition for giving rise to an unregistered Community design is that of making available to the public within the meaning of Article 11(2) CDR (§ 36). In order for the making available to the public of the design of a product taken as a whole to entail the making available of the design of a part of that product, it is essential that the appearance of that part is clearly identifiable when the design is made available (§ 38). However, that does not imply an obligation for designers to make available separately each of the parts of their products in respect of which they seek to benefit from unregistered Community design protection (§ 40).

The concept of 'individual character', within the meaning of Article 6 CDR, governs not the relationship between the design of a product and the designs of its component parts, but rather the relationship between those designs and other earlier designs (§ 47). In order for it to be possible to examine whether the appearance of a part of a product or a component part of a complex product satisfies the condition of individual character, it is necessary for that part or component part to constitute a visible section of the product or complex product, clearly defined by particular lines, contours, colours, shapes or texture. That presupposes that the appearance of that part or component part is capable, in itself, of producing an overall impression and cannot be completely lost in the product as a whole (§ 50).

Consequently, Article 11(2) CDR must be interpreted as meaning that the making available to the public of images of a product, such as the publication of photographs of a car, entails the making available to the public of a design of a part of that product, within the meaning of Article 3(a) CDR, or of a component part of that product, as a complex product, within the meaning of Article 3(c) and Article 4(2) CDR, provided that the appearance of that part or component part is clearly identifiable at the time the design is made available.

In order for it to be possible to examine whether that appearance satisfies the condition of individual character referred to in Article 6(1) of that regulation, it is necessary that the part or component part in question constitute a visible section of the product or complex product, clearly defined by particular lines, contours, colours, shapes or texture (§ 52).



28/10/2021, C-123/20, [Ferrari](#), EU:C:2021:889, § 33, 38, 40, 47, 50, 52

### 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

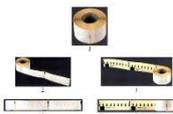
### Disclosure

Under Article 25(1)(a) and (b) CDR, a Community design may be declared invalid only in the cases set out in that provision, in particular if it does not fulfil the requirements of Articles 4 to 9 CDR. The logic underlying Article 25(1)(a) and (b) CDR is, firstly, to prevent the registration of designs that do not satisfy the conditions for protection, in particular those relating to their 'novelty' and their 'individual character' within the meaning of Article 5 and Article 6 of that regulation respectively, and not to protect an earlier design (§ 22-26). Consequently, what matters is the fact that the earlier design was disclosed, and not the extent of the protection granted to that design, which results from the validity of its registration (§ 27).

16/06/2021, T-187/20, [Lampade](#), EU:T:2021:363, § 22-27

### Disclosure

Disclosure does not impose any requirement that the earlier design must have been used for the manufacture or marketing of a product (§ 44).



10/11/2021, T-443/20, [Labels](#), EU:T:2021:767, § 44

### Community design — Res judicata

According to Article 52(3) CDR, an application for a declaration of invalidity shall not be admissible if an application relating to the same subject matter and cause of action, and involving the same parties, has been adjudicated on by a Community design court and has acquired the authority of a final decision.

The identity of the cause of action with that of the prior case implies not only the same legal basis (i.e. reliance on the same legal provisions in support of the applications), but also the same facts and, in particular, the same designs (§ 19-20). In the present circumstances, the parties and the subject matter of the cases are identical, since both proceedings concern an application for a declaration of invalidity of the same design. However, the cause of action differs as the invalidity of the contested design is sought in the proceedings before the Office in relation to a design that was not relied on before (nor ruled upon by) the national court (§ 21-23).

17/11/2021, T-538/20, [Paños de limpieza](#), [Ropa de mesa](#), EU:T:2021:793, § 19-23

## Disclosure outside of the EU — Overall impression

The BoA correctly found that previous disclosure in the United States is proven and that the earlier design could reasonably have become known in the circles specialised in the relevant sector operating within the European Union prior to the date of registration of the contested design (§ 34-40). The two designs produce an identical overall impression on the informed user, namely the average consumer, who is reasonably well informed and reasonably observant and circumspect regarding towels and table linen. The contested design does not satisfy the requirements of Article 6 CDR and, therefore, had to be declared invalid pursuant to Article 25(1)(b) CDR (§ 49-59).



17/11/2021, T-538/20, [Paños de limpieza, Ropa de mesa](#), EU:T:2021:793, § 34-40, 49-59

### 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).

27/02/2020, T-159/19, [Furniture](#), EU:T:2020:77, § 20, 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

### **Means of evidence — Disclosure — Credibility of online evidence**

The applicant for a declaration of invalidity is free to choose the evidence that they wish to present. The appearance of an image of a design on the internet constitutes an event that can be classed as 'publication' and, therefore, as 'disclosure'. The probative value of screenshots as evidence is not limited (§ 26, 32, 41).

In the present case, the screenshots of the websites clearly show the designs that are identical to the contested design, the full uniform resource locator (URL) addresses of those websites and the dates of disclosure prior to the date of filing of the contested design. In addition, one screenshot contains further information provided with a time stamp. This consists of comments from internet users that prove disclosure on 1 November 2009 (§ 33-34, 37, 39-40, 42-44).

The purely abstract possibility of the content of a website or a date being manipulated does not constitute a sufficient reason to call the credibility of the evidence into question. This credibility can only be called into question by referring to facts that specifically suggest a manipulation (§ 49). Even though the screenshot obtained from the Wayback Machine does not contain an image of the product, it is a relevant source of information that confirms the reliability of the screenshot of one of the websites in question (§ 57-58).

20/10/2021, T-823/19, [Bobby pins](#), EU:T:2021:718, § 26, 32-34, 37, 39-40, 41-44, 57-58

### **Means of evidence — Disclosure — Burden of proof of disclosure**

As regards the distribution of the burden of proof, where the applicant for invalidity produces evidence from the internet which proves the disclosure of the earlier designs, the proprietor is obliged to prove the lack of credibility of that evidence (§ 73). In this respect, it is not required to prove the manipulation of a website, but to specify credible indications of malware, such as clear references to falsification, indisputable contradictions in the information given or obvious inconsistencies that justify doubts as to the authenticity of the screenshots (§ 75).

20/10/2021, T-823/19, [Bobby pins](#), EU:T:2021:718, § 73, 75

### **Proof of disclosure — Disclosure of the earlier design**

The BoA correctly found that the holder of the contested design had not demonstrated that the circles specialised in the sector concerned, namely the food industry, had been prevented from learning of the publication of the European patent containing a representation of the earlier design. Accordingly, the patent had to be considered as having been disclosed to the public (§ 33-38).

01/12/2021, T-662/20, [Triple helicoid cheese](#), EU:T:2021:843, § 33-38

### **Proof of disclosure — Disclosure of an earlier design in China – Obligations of the Office**

Regarding the alleged obligation of the BoA to carry out *ex officio* a check with the Chinese Intellectual Property Office, it is clear from the case-law that, firstly, it is for the party that filed the application for a declaration of invalidity to provide the Office with the necessary information and, in particular, the precise and complete identification and reproduction of the design alleged to be prior art, to demonstrate that the contested design cannot validly be registered. Secondly, it is not for the Office, but for the applicant of a declaration of invalidity to provide evidence of the application of the invalidity ground. In these circumstances, the applicant cannot criticise the BoA for not having carried out, on its own initiative, checks with the Chinese Intellectual Property Office (§ 28-29).

The BoA was not obliged to invite the parties *ex officio* to supplement their own pleadings and documents before it. This applies in circumstances such as those of the present case where it is apparent from the file that the intervener, which is the other party concerned in the *inter partes* proceedings, argued in the proceedings before the Office that the applicant had not established to the required legal standard that an earlier disclosure of the Chinese design had taken place. However, despite this argument, the applicant failed to provide any further evidence concerning the disclosure. In these circumstances, there was no reason for the Office to invite the applicant to provide additional evidence in support of its application for a declaration of invalidity (§ 32-34).

22/09/2021, T-685/20, [Roller](#), EU:T:2021:614, § 28-29, 32-34

22/09/2021, T-686/20, [Roller](#), EU:T:2021:615, § 28-29, 32-34

### **Conflict of design with prior design — Irrelevance of the declaration of invalidity of the earlier design — Disclosure within the EU**

It is irrelevant that the earlier RCD was declared invalid. Neither Article 28(1)(b)(v) CDR nor Articles 5 and 6 CDR refer to the registration of the earlier design. On the contrary, Article 6 CDR refers to ‘any design which has been made available to the public’ without in any way requiring that that design be ‘registered’ (§ 21-30). Publication of an earlier design in the bulletin of any intellectual property office constitutes an event of disclosure under Article 7(1) CDR (§ 35-36).

22/09/2021, T-503/20, [Signalling apparatus and devices](#), EU:T:2021:613, § 21-30

#### **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).

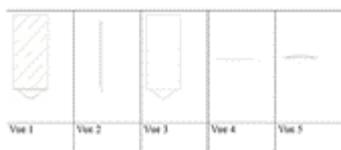
The comparison of the overall impressions produced by the designs must be synthetic in nature and cannot be confined to the analytical comparison of a list of similarities and differences (§ 49).



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

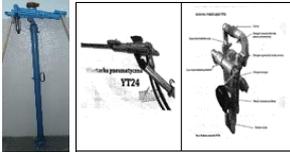
The freedom of the designer is restricted, inter alia, by the constraints of the features imposed by the technical function of the product or an element thereof, or by statutory requirements applicable to the product. Marketing trends are irrelevant. The greater the designer's freedom in developing a 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).



12/03/2019, T-352/19; [Packaging for foodstuffs](#),

EU:T:2020:94, § 28, 31, 33, 40



12/03/2019, T-353/19; [Packaging for foodstuffs](#), EU:T:2020:95,

§ 28, 31, 33, 40

### **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,

**Article 6 CDR — Different overall impression — Unprecedented character or originality of the appearance of the prior design — Individual character — Informed user**

The wording of Article 6 CDR is clear and unambiguous: For the purposes of applying Article 25(1)(d) CDR and assessing whether there is a conflict between the designs, a design is eligible for the protection afforded by the Community design if it produces on the informed user a different overall impression from that produced by a prior design (§ 37).

Neither a claimed particular ‘broad protection’ of the prior design nor the reference in Recital 14 of the CDR to the existence of a ‘clear’ difference between the overall impressions can change the assessment criteria (§ 37). The allegedly unprecedented character or originality of its appearance does not have any influence whatsoever on the assessment of the individual character of the contested design. Even if it were established that, at the date of its registration, the shape resembling the structure of a dumbbell applied to a beverage bottle would have been entirely new in the industrial sector concerned, the uniqueness of such a shape does not confer on the prior design broader protection than that which it enjoys under the CDR (§ 40).

A design has individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by the prior design. The assessment of the individual character involves taking into account all the elements that distinguish the designs, other than those which remain insufficiently significant to affect that overall impression (§ 31, 64). Even without a label, the designs have significant differences (§ 66-70). The contested design and the prior design produced different overall impressions on the informed user (§ 71).



21/04/2021, T-326/20, [Beverage bottles](#), EU:T:2021:208, 31, 37, 40, 64, 66-71

## Article 6 CDR — Conflict of design with prior design — Informed user — Lack of individual character

The BoA correctly reasoned that the main assessment of the overall impressions of the designs had to be made with regard to the front view. This section remains visible during normal use of the device and determines the overall impression produced by the device. The general appearance of the front panel is not determined by technical constraints. The designer is free to choose the shape of the panel, the configuration and position of the alert indicators, and the position of the remaining verbal and figurative elements (§ 53-59). The BoA was right to conclude that the contested design has no individual character within the meaning of Article 6(1)(b) CDR (§ 99).



22/09/2021, T-503/20, [Signalling apparatus and devices](#), EU:T:2021:613, § 53-5, 99.

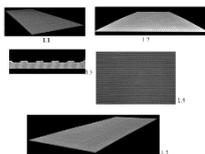
## Only the contested design is relevant in determining the sector concerned, the informed user and the designer's degree of freedom — The goods actually marketed may be taken into account, albeit only for illustrative purposes — Colours are irrelevant when the contested design is registered in black and white — Lack of individual character

The determination of the sector of the products in which the design is intended to be incorporated or applied is a necessary precondition for defining the informed user and the freedom of the designer (§ 22).

The determination of the relevant sector, the informed user and the designer's degree of freedom must be carried out only in relation to the design that's individual character is being assessed (§ 24).

The goods actually marketed that apply or incorporate the designs can only be taken into consideration for illustrative purposes to determine the visual aspects of those designs. However, this consideration is only permitted on the condition that the products actually marketed correspond to the designs as registered (§ 28-33).

When the contested design is registered in black and white, any colour used in the earlier design is not relevant to their comparison, given that no colour has been claimed for the contested design (§ 82).



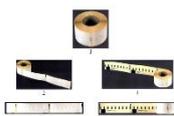
10/11/2021, T-193/20, [Panels](#), EU:T:2021:782, § 22, 24, 28-33, 82

## Overall impression — Technical features — Trade marks present on designs — Lack of individual character

Regardless of whether the feature is solely or primarily dictated by the technical function of the product, it will not contribute to the appearance of the contested design where the informed user will not focus their attention on that feature (§ 74).

The signs were composed of word and figurative elements affixed on the product to indicate its origin and did not have an ornamental or decorative function. Therefore, they were not among the features of the product that gave the goods their appearance. Those word and figurative elements

were irrelevant in the comparison of the overall impressions for the purposes of establishing the individual character of the contested design (§ 80).



10/11/2021, T-443/20, [Labels](#), EU:T:2021:767, § 74, 80

### **Community design — Degree of freedom of the designer — Article 7 CDR — No individual character — No different overall impression — Article 6 CDR**

The BoA correctly found that the contested design lacked individual character and that the overall impressions produced on the informed user by the two designs were the same. The designer's degree of freedom in developing dolls' heads is wide and that freedom is restricted only in so far as those heads must follow the basic characteristics of a human being. However, this freedom is not restricted by market preferences as regards the appearance of 'fashion dolls' (§ 39-41). What will strike the attention of the informed user is that both designs show a doll's head with an oval-shaped face, the same facial characteristics and proportions, very similar make-up, and the same expression. Considering the wide degree of freedom enjoyed by the designer, the differences between the designs are insufficiently pronounced to produce different overall impressions (§ 53-65).

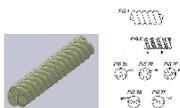


01/12/2021, T-84/21, [Doll's heads](#), EU:T:2021:844, § 53-65

### **Article 7 CDR — Individual character — Different overall impression — Article 6 CDR**

The degree of freedom of the designer of the cheeses is relatively high. The informed user to be taken into account is a consumer from the general public who shops for foodstuffs and has a certain degree of knowledge as to the shapes and sizes that cheeses may have (§ 49, 51-54).

The contested design and the earlier design produced the same overall impression on the informed user. The contested design does not have the individual character required by Article 6(1) CDR. The BoA correctly concluded that the application for a declaration of invalidity had to be upheld, without it being necessary to assess the other grounds relied on in that application (§ 57-63).



01/12/2021, T-662/20, [Triple helicoid cheese](#), EU:T:2021:843, § 49, 51-54, 57-63

### **No individual character — Lack of novelty — Different overall impression**

The BoA was fully entitled to find that the application for a declaration of invalidity under Article 25(1)(b) CDR in conjunction with Articles 5 and 6 CDR for a lack of novelty and individual character, had to be refused due to the conflicting designs' different overall impression resulting from, among other things, the diverging features of the soles and the stitches (§ 46, 62, 108, 120-121).



15/12/2021, T-682/20, [Schuhe](#), EU:T:2021:907, § 46, 62, 108, 120-121



15/12/2021, T-683/20, [Schuhwaren](#), EU:T:2021:909, § 46, 62, 108, 120-121



15/12/2021, T-684/20, [Schuhwaren](#), EU:T:2021:912, § 46, 62, 108, 120-121

### 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

#### Article 25(1)(f) CDR — Request that witnesses be heard — Action manifestly lacking any foundation in law

The BoA correctly stated that the applicant had not shown that there was a work protected by copyright and that, regarding the applicable national law, the work enjoyed protection under German copyright law. The date and place of the first publication of the work were not stated and it was not possible to identify the holder of the alleged copyright. The BoA was right in rejecting the request that witnesses be heard because the applicant had not provided an explanation as to why it had been unable to submit written witness statements or the missing documents during the procedure before the Office (§ 10, 35-38).

14/06/2021, T-512/20, [Protective covers for computer hardware](#), EU:T:2021:359, § 10, 35-38

14/06/2021, T-564/20, [Protective covers for computer hardware](#), EU:T:2021:358, § 10, 35-38

### **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 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 — 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 3(1)(b) Directive 2008/95/EC — Distinctive character — EUTM application for a sign for a service, consisting of motifs of colour and intended to be affixed to goods used to provide that service — Criteria for assessment**

The preliminary ruling concerns the interpretation of Article 3(1)(b) of Directive 2008/95/EC. The distinctive character of a sign for which registration as a trade mark in respect of a service is sought, where that sign is composed of coloured motifs and is intended to be affixed exclusively and systematically in a specific manner to a large part of the goods used for the provision of that service, must be assessed by considering the relevant public's perception of the affixing of that sign to those goods. It is not necessary to examine whether that sign departs significantly from the norm or customs of the economic sector concerned (§ 45).



EU:C:2020:813, § 45

08/10/2020, C-456/19, [Aktiebolaget Östgötatrafiken](#),

**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)(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 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](#), 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 3(1) Directive 2001/29/EC — Article 3(1) Directive 2001/29/EC  
— Concept of ‘communication to the public’ — Embedding, in a third party’s website, of a  
copyright-protected work by means of the process of framing — Work freely accessible  
with the authorisation of the copyright holder on the licensee’s website**

Article 3(1) of Directive 2001/29/EC must be interpreted as meaning that the embedding, by means of the technique of framing, in a third party website page, of works that are protected by copyright and that are freely accessible to the public with the authorisation of the copyright holder on another website, where that embedding circumvents measures adopted or imposed by that copyright holder to provide protection from framing, constitutes a communication to the public within the meaning of that provision (§ 55).

In this case which take place in the wake of Svensson and GS Media decisions, the CJ clarifies when embedding of a work by way of framing on the internet constitutes a communication to the public within the meaning of Directive 2001/29/EC.

According to the Court, where the copyright holder has imposed measures to restrict framing, the embedding of a work in a website page of a third party, by means of that (framing) technique, constitutes an act of ‘making available that work to a new public’. That act must, therefore, be authorised by the right holders concerned (such as through a new licence).

The Court further ruled that copyright holder can restrict linking (framing) by contract provided that such restriction is imposed or implemented through effective technological measures within the meaning of Article 6(1) and (3) of Directive 2001/29/EC.

09/03/2021, C-392/19, [VG Bild Kunst](#), EU:C:2021:181, § 55

**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

**Preliminary ruling — Copyright and related rights — Making available and management of a video-sharing platform or a file-hosting and -sharing platform — Liability of the operator for infringements of intellectual property rights by users of its platform — Directive 2001/29/EC — Article 3 and Article 8(3) — Concept of ‘communication to the public’ — Directive 2000/31/EC — Articles 14 and 15 — Conditions for exemption from liability — No knowledge of specific infringements — Notification of such infringements as a condition for obtaining an injunction**

In principle, operators of online platforms do not themselves make a communication to the public of copyright-protected content illegally posted online by users of those platforms, unless those operators contribute, beyond merely making the platforms available, to giving the public access to such content in breach of copyright. This is the case, *inter alia*, (i) where the operator has specific knowledge that illegal content is available on its platform and does not expeditiously remove it, (ii) where the operator, despite knowing that users are making illegal content available, does not put in place appropriate technological measures to counter copyright infringement on its platform, or (iii) where the operator participates in selecting protected content illegally communicated to the public, provides tools intended for the illegal sharing of such content, or knowingly promotes such sharing (§ 63-78, 89, 102).

Operators of platforms (such as YouTube and Cyando) can benefit from exemption from liability under Directive 2000/31/EC (Electronic Commerce Directive) provided that they do not play an ‘active role’ that gives them knowledge of, or control over, the content uploaded to their platform (§ 106, 111-118).

Directive 2001/29/EC (Information Society Directive) does not preclude a situation under national law whereby a copyright holder cannot obtain an injunction against an operator whose service has been used by a third party to infringe its rights, where that operator has no knowledge of the infringement (within the meaning of Article 14 of the Electronic Commerce Directive), unless, before court proceedings are begun, that infringement was notified to the operator who has failed to intervene expeditiously to remove the content or block access to it. It is, however, for the national courts to ensure that that condition does not result in a delay to the actual cessation of the infringement that causes disproportionate damage to the rights holder. This means that, for the Court, imposing the notification of an infringement as a condition for obtaining an injunction must conform with Article 8(3) of the Information Society Directive (§ 119, 124, 141-142).

22/06/2021, C-682/18 and C-683/18, [YouTube and Cyando](#), EU:T:2021:503, § 63-78, 89, 102, 106, 111-119, 124, 141-142

### **3.3 DIRECTIVE 96/9/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL OF 11 MARCH 1996 ON THE LEGAL PROTECTION OF DATABASES**

**Preliminary ruling — Legal protection of databases — Directive 96/9/EC — Article 7 – Sui generis right of makers of databases — Prohibition on any third party to ‘extract’ or ‘re-utilise’, without the maker’s permission, the whole or a substantial part of the contents of the database — Database freely accessible on the internet**

Article 7(1) and (2) of Directive 96/9/EC must be interpreted as meaning that an internet search engine specialising in searching the contents of databases, which copies and indexes the whole or a substantial part of a database freely accessible on the internet and then allows its users to search that database on its own website according to criteria relevant to its content, is ‘extracting’ and ‘re-utilising’ that content within the meaning of that provision, which may be prohibited by the maker of such a database where those acts adversely affect its investment in the obtaining, verification or presentation of that content, namely that they constitute a risk to the possibility of redeeming that investment through the normal operation of the database in question, which it is for the referring court to verify (§ 47).

### 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

**Preliminary ruling — Copyright and related rights — Directive 2001/29/EC — Article 3(1) and (2) — Concept of ‘making available to the public’ — Downloading a file containing a protected work via a peer-to-peer network and the simultaneous provision for uploading pieces of that file — Directive 2004/48/EC — Article 3(2) — Misuse of measures, procedures and remedies — Article 4 — Persons entitled to apply for the application of measures, procedures and remedies — Article 8 — Right of information — Article 13 — Concept of ‘prejudice’**

Uploading pieces of a media file to a peer-to-peer network, such as the one at issue, constitutes ‘making available to the public’ within the meaning of EU law (§ 43-59).

A holder of intellectual property rights (IPR) such as Mircom may benefit from the system of protection of those rights, but its request for information, in particular, must be non-abusive, justified and proportionate (§ 66-96).

Systematically registering users’ IP addresses and communicating their names and postal addresses to the IPR holder, or to a third party, to enable an action for damages to be brought, is permissible under certain conditions (§ 102-132).

17/06/2021, C-597/19, [MICM](#), EU:C:2021:492, § 43-59, 66-96, 102-132