

Alicante News

Up to date information on IP and EUIPO-related matters

Quick Links 

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open



DESIGNEUROPA
awards
2016

April
2016

The DesignEuropa Awards



Simon Malynicz Pinto talks to James Nurton



The DesignEuropa Awards – nominate or apply before July 15

The importance of design to the EU economy was underlined by the 2013 EUIPO/EPO study on [“Intellectual Property Rights Intensive Industries: contribution to economic performance and employment,”](#) which showed that design-intensive industries generate 12% of all jobs in the European Union and almost 13% of its GDP.

The Registered Community Design (RCD) has offered EU-wide protection for designs since 2003, and thousands of businesses and individuals have chosen the RCD to protect their creations.

To recognise companies and designers that have brought outstanding design to the market with the protection of the RCD, the EUIPO has launched the [DesignEuropa Awards](#).

With the entry period now open, any Registered Community Design (RCD) can be submitted for the Awards.

RCD holders can apply directly through the DesignEuropa Awards web page, or any third party can nominate a RCD.

The three categories are:

The Industry Award (for RCDs owned by companies which have more than 50 employees and over €10 million in turnover/€10 million balance sheet total)



The Small and Emerging Companies Award (for RCDs owned by companies which comply with one of the following conditions:

- Fewer than 50 employees and less than €10 million turnover/€10 million balance sheet total
- Companies established after January 1 2013, regardless of their size)

The Lifetime Achievement Award (for individual designers with a significant body of work of aesthetic value, created over the course of a career, which has also had a demonstrable impact on the marketplace. Nominees in this category must currently use or have used the RCD system during their professional careers).

Four finalists will be chosen by the jury in both the Industry and Small and Emerging Companies categories, after the entry period for the Awards closes on July 15, 2015.

The names of the finalists will be announced on October 15, 2016, through EUIPO's website and its social media channels, and will be included in official Awards publications.

The winners will be announced at the DesignEuropa Awards ceremony in Milan, on November 30, 2016, along with the winner of the Lifetime Achievement award.

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open



The James Nurton Interview



Simon Malynicz QC, Three New Square

What sparked your interest in IP?

I started studying IP as an option during my law degree. I was reading UK trade mark cases such as Neutrogena and British Sugar, and it was really easy to relate to. Everybody's got a view on whether or not a trade mark is confusingly similar to another mark. It is about immersing yourself in the facts and then reaching a decision.

Trade marks are also quite policy rich because you're trying to draw a line – which no one can ever properly draw – between IP monopolies and free competition. IP cases very quickly become about how cases of this sort should be decided.

Trade marks, copyright and designs in particular are IP rights where you can take a view.



Simon Malynicz

For example, someone can play a piece of music and then play an advertising jingle and everyone has a view about whether it's similar or not. When the Blurred Lines litigation occurred in the US last year, I sent a link to the music round our Chambers: five people said it was too close, and five people said it wasn't!

Why become a barrister?

I was always going to be a barrister. My mum tells me I wanted to do that from a very young age. When I went to school, one thing I did well was debating. I grew up in Australia and we won the state debating competition. I think I missed out the nervous gene: I've never had any problem at all getting on my feet, even with lack of preparation. I've been doing it since the age of 10 and I love it.

That said, it wasn't easy. I did pupillages at various places before eventually being taken on. But that's not unusual at the bar. In fact, a lot of successful barristers have that experience: for many it's the first setback they've had and it's the making of them.

Was it harder not having a scientific background?

It was. I applied to the Chambers I'm now at and they didn't even interview me, even though I had a First in my law degree! It's the exception rather than the rule to have a law degree rather than a science degree at the IP bar. But I've always done soft IP and done almost no patent work.

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open



The James Nurton Interview



Having said that, it's becoming more common to specialise. It used to be that solicitors and barristers were not specialised, but increasingly at the younger end people are pushed one way or the other. It's partly because the law has exploded. If you're going to be a competent trade mark or patent practitioner, you can't be doing too much else. A few people can do everything, but it's becoming more unusual.

How is being a barrister different to being a solicitor?

Fundamentally, the role of the barrister in the UK is to appear as an advocate in the higher courts. If a case is going to be resulting in a hearing, and if it is likely to require either a trial or a heavy application for interim injunction or an appeal, then using someone who only does advocacy is a good thing. Advocacy is all we do: I'm typically in court three times a week. It expresses itself in particular in things like dealing with questions from the court: barristers are trained to accept that and use it to their advantage to promote a case. Advocates from other jurisdictions who don't have that experience tend to get thrown by it.

Particularly now I'm a QC, I also advise a lot – I do opinions on international trade mark disputes where people ask: what should we do?

It's important to know what we don't do: we don't write letters to the other side, we don't deposit documents or serve the documents on the other side. We wouldn't prepare evidence, though we would review it. That said, once we're involved in

a case, of course we would be consulted on the strategy.

What is a typical week?

Last week I was in the High Court in the Cadbury colour purple case, where I was representing the intervenor Nestlé. On Thursday I was in the Court of Appeal in the Comic Enterprises (Glee Club) case. Another day I might be in the IPO in front of the appointed person. I'm in Luxembourg a lot: someone told me I have done more cases at the General Court than any other private lawyer. I'm there at least once a month.

Can you explain how barristers Chambers work?

One thing to remember is it's not uncommon to have two members of the same Chambers on opposite sides of a case. An example is the Kit Kat case – where I am representing one side and Tom Mitcheson QC, who is also in Three New Square, is representing the other. There's a friendly rivalry. I would see him having a cup of tea or at the water cooler, but we are self-employed and not sharing profits. On a case like that we have separate clerks. The only thing we are doing is effectively sharing expenses. On the other hand, a QC may often be leading a junior who is in a different chambers.

What is the cab rank principle?

It's a very important principle. Solicitors can accept or decline a case. For example, if they act for Louis Vuitton and then a replica maker wants to use the

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open



The James Nurton Interview



firm, the solicitor might say “I don’t want to sully my hand and if I fight hard I might create a precedent that will be adverse to my other clients” and they can decline the work.

Barristers are not allowed to do that. We have a firm cab rank rule and it’s unethical to go against that. It comes up a lot in trade marks – the cases are relatively small, so I’ve acted for almost every single brand owner, but sometimes I’ve got to act against them too. Provided I’ve not been privy to a specific piece of information then there is no conflict and I must take the case. In fact, it would be unethical not to.

It works well because it means you get counsel involved quickly, and they’re in the bag – and there’s a level of certainty. It also means the little guy can get in first and as long as he can afford the fees and moves quick, then he will get justice.

Which are the most significant cases you have worked on?

I regard the CJEU cases as my biggest ones, and there are four in particular. They were all ground breaking cases that changed the law, and have had an impact throughout the EU, and even beyond in countries such as Australia, Singapore and South Africa.

Arsenal basically created the concept of damage to the essential function, which is now applied to every trade mark case; Intel is the leading case on dilution; IP TRANSLATOR is about legal certainty in trade

mark specifications for goods and services, and Interflora is about all the other functions of trade marks, which people still say they don’t understand. I’m incredibly lucky to have been involved in them. In Arsenal I was acting for the defendant, Intel and IP TRANSLATOR for the government, and Interflora for the trade mark owner.

The Arsenal case looked like a standard double identity case and became something in Luxembourg so we didn’t see that coming. On the other hand, Intel was the first case on dilution and IP TRANSLATOR was clearly going to be huge. In that case, we had 14 member states make written observations, and six or seven came to the hearing. That led to the EUIPO changing its approach, and the law being changed.

Do you approach CJEU cases differently?

When it comes to the CJEU, a case has to be dealt with in a very particular way. They are deciding things not as an ultimate court of appeal, but as a policy decision as to where they think the law should be for the whole of the EU. So you need to approach it with that mind set – that you’ve got to give them policy criteria – and they’re not particularly interested in the facts of the case. For example, in trade marks they’re trying to get a definition of distinctiveness that will work across the EU for all types of cases and in all cultures. That needs a specific kind of advocacy and persuasion.

I think the CJEU is doing a much better job than they’re credited for. It’s important to remember they’re doing two jobs in trade marks and designs.

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO’s e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open



The James Nurton Interview



In EU trade mark cases, they're sitting as a final court of appeal, and those cases tend to be very fact-specific so they are of less interest to other parties. Where it gets interesting is Section 234 references from national courts, where the CJEU is trying to come up with some meaningful guidance that will work in 28 legal cultures, based upon principle and previous case law.

Stand back and look at what they've done since the first cases such as *Sabel v Puma* and *Canon* on issues such as revocation on grounds of non-use, likelihood of confusion, survey evidence, dilution, unfair advantage and ask: have they given guidance for the national courts to apply? I think they clearly have. I do many trade mark trials, and although there is a lot of law, the judges and IPOs across the EU can apply these tests daily.

The CJEU judges are criticised for a lack of clarity and consistency but on most issues we know where we are. The problem is trade marks is inherently a difficult area: there's uncertainty as to the nature of the enquiry, and there are a lot of fuzzy tests.

What are the most important issues at the moment?

In trade marks, I would say stay provisions where there are concurrent proceedings on an EU right in different member states and the EUIPO. We saw it in *Apple v Samsung* among other cases. The Directive says the second-seised court should stay unless there are "special grounds" but the way that is being interpreted is completely different. Some courts are

saying: every case is special grounds. In the UK, it's different and you have to wait, so we have what we call the EUIPO torpedo, where you have to wait until the EUIPO and Court proceedings are completed – which takes many years.

It's as good as justice denied, and I was really surprised they didn't deal with that in the reforms. They should have ameliorated "special grounds" to give courts more freedom. The CJEU will have to look at it: it's got to be a discretionary test.

In designs, I'm concerned about the way that infringement is being interpreted. People think that because you can effectively deposit them then you've got to be very careful about giving design rights any scope of protection. That means designers are lodging designs and citing them in letters, but whenever the rights are being sued upon they are not being enforced properly. That is a recipe for large companies to bully smaller companies. Either the rights are valid in which case beef them up and make sure they are enforced, or they shouldn't be there in the first place. Part of the issue is there's not enough cases to work through these issues – there's maybe one design case for every 30 trade mark cases.

How could the system in the EU be improved?

I think there are too many tiers of appeal: there are four levels, three of which have meaningful hearings. The oppositions are decided by one person on the papers, and they are inevitably appealed. One

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open



The James Nurton Interview



of those tiers is unnecessary, probably the first. Removing that would get rid of 80% of the cases, but I doubt it will happen.

The other thing is unconventional trade marks: there is too much suspicion in relation to those, especially in the UK courts. There is concern that if you allow someone to register the three-headed shaver, or the Lego brick, as a trade mark that it will lead to abusive monopolies. Why is that inherently more likely to happen with a shape than with a word? It seems to me we are being over-sensitive to what most brand owners consider to be part of their brand equity.

In the long term, I think there has to be further harmonisation. There is still too much variance in the way rules are applied. Harmonisation has worked relatively well in trade marks and designs, trade secrets is now being harmonised and I don't see why it shouldn't work well for patents too. It is absurd that patents have lived in its own cosmos, away from EU harmonisation.

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

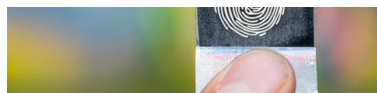
- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

European Union Trade Mark



Update on Article 28(8)

One month after the entry into force of Regulation (EU) No 2015/2424 of the European Parliament and the Council amending the Community trade mark regulation and the Office has already been receiving the first declarations under Article 28(8) EUTMR.

Article 28(8) allows for a transitional period of six months during which proprietors of EUTMs applied for before 22 June 2012 and registered in respect of the entire heading of a Nice class may declare that their intention on the date of filing had been to seek protection in respect of goods and services beyond those covered by the literal meaning of that heading.

The Office has taken a number of steps to assist users in preparing their declarations, including issuing [Communication 1/2016](#) of the President concerning the implementation of Article 28 EUTMR, together with its [Annex](#), a list of [Frequently Asked Questions](#) and by giving a [Webinar](#). The Office has also created an [online form](#) to facilitate the process and Information Centre has been responding to all of the calls and e-mails received on the matter.

One month after the first declarations were filed, the Office is now in a position to assess the impact of all the information provided and to identify areas where more information is needed.

The Office had received nearly 300 declarations by 22/04/2016, a number that is considered reasonable overall. This is an indication that affected trade mark owners have essentially understood that declarations should only be considered when there is a real interest in filing one: users should make use of the provisions of Article 28(8) only if they are actually using, or intend to use, the mark for the specific goods and services not clearly covered by the literal meaning of the class heading.

However, despite the above guidance and communication efforts by the Office, a considerable percentage of the declarations filed during these first weeks are deficient. The Office is in the process of sending out the corresponding deficiency letters identifying the issues detected but it is already clear that the vast majority of deficiencies relate either to the use of long lists of terms which include terms clearly covered by the heading of the respective class, or declarations for goods and services not contained on the alphabetical list in force at the time of filing.

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open

Community Trade Mark

It is worth remembering that, as mentioned in paragraph 8 of Communication 1/2016, the Office will object to:

- claims for the entire alphabetical list;
- the use of unclear, imprecise or unspecific expressions;
- declarations for goods and services that are clearly covered by the literal meaning of the class heading;
- declarations for goods or services not contained in the alphabetical list in question.

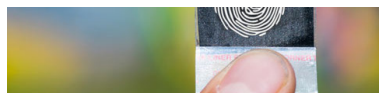
The following check-list may serve to help users avoid receiving an office objection, by verifying the requirements before filing their Article 28(8) declarations:

Formal requirements

- Declaration filed before 24/09/2016
- Correct language (Office language for EUTMs, language of the IR for IRs designating the EU)
- Representative appointed where necessary
- Mark identified
- Owner identified

Regarding the mark

- EUTM filed before 22/06/2012
- EUTM registered
- EUTM covers entire class heading



Regarding the content of the declaration

- Identifies goods and services that go beyond the literal meaning of the class heading and
- Identifies goods and services that appear on the alphabetical list in force at the time of filing the EUTM.

Users are also reminded that, in accordance with paragraph 8 of Communication 1/2016, declarations for any of the goods or services included in the Annex of examples of terms clearly not covered by the literal meaning of the respective class headings will not be objected to by the Office on the ground of being covered by the literal meaning of the class heading.

More information [here](#) and [here](#).

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open



Registered Community Design



Common Communication on the graphic representation of designs

As announced in the last Alicante News, the Common Communication on the Common Practice on the graphic representation of designs was published on 15 April 2016. At the same time, following an ad hoc revision process to allow for the Common Practice to take effect, the Guidelines for Examination of Registered Community Designs implementing the converged practice were made available on the Office's website.

The Common Practice was integrated into these Guidelines, whilst improving its current structure in part, thereby giving it full applicability for the Office's proceedings. However, in order to retain a balanced structure with its existing content, not all examples given in the Common Practice, albeit being equally valid, are reproduced in the Guidelines. Furthermore, the Guidelines do not reiterate objective 4 of the Common Practice concerning the format of views.

Objective 4 of the Common Practice presents the results of a benchmarking study on formal requirements for paper and electronic design applications in the participating Member States as well as in WIPO and EUIPO. In addition, it gives quality recommendations for representations of designs filed in the form of drawings and photographs. These recommendations on quality are equally valid for filings at the EUIPO. In view of the legal minimum

quality standards to adhere to for the purpose of according a filing date and registering a design, as set out in the Guidelines, and the difficulty to separate those from the general recommendations given under the Common Practice in the best interest of applicants, the Guidelines merely refer users to them.

The Common Practice offers an array of clarifications for the graphic representation of designs. With respect to the Office's practice, the following explanations may be noteworthy as a first introduction.

Whilst the Office continues to allow, in principle, a combination of different visual formats (e.g. a drawing and a photograph), the Office highly recommends, in accordance with the Common Practice, to represent a design using only one visual format. At application stage, the Office assesses whether there are any relevant inconsistencies between the designs as represented in different visual formats. By nature, different formats may often reveal inconsistent features and thus give rise to an objection on that account. Even if registered, the Office also notes that a combination of different visual format may give rise to legal uncertainty when determining the scope of protection of a design.

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open



Registered Community Design



Under the Common Practice, it is recommended to file so called aspect views; that is, traditional views showing the design from certain directions, such as in the following example:

RCD No 002325456-0001



When other types of views are filed, for instance views magnifying parts of the design in addition to a view showing remaining parts, applicants are advised that specific requirements as agreed under Common Practice and set out in the Guidelines may apply. Furthermore, some types of views such as exploded views or sectional views cannot be filed on their own without other types of views, typically aspect views. For the specific requirements users are referred to the Common Communication and the Office's Guidelines.

An important section of the Common Practice addresses the use of visual disclaimers. Verbal disclaimers, on the other hand, were outside the scope of the Common Practice. Whilst the Common Practices defines types of visual disclaimers, their meaning and use, it notes first of all that representations showing only the claimed design in most cases are still preferred to avoid complications in the application procedure. If the applicant chooses to include a visual disclaimer in its design representation, the use of broken lines instead of other types such as colour shading, is the recommended option.

In view of this Common Practice applicable across the vast majority of Member States and its impact on the interpretation of design representations, the Office recommends to avoid any ambiguity with the use of broken lines for other than disclaiming purposes. Whilst broken lines may constitute a feature of a design and thus continue to be applicable in that manner, applicants are in particular encouraged not to use broken lines as a means to indicate portions of the design that are not visible in that particular views (e.g. the contour of the backside of a product).

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open

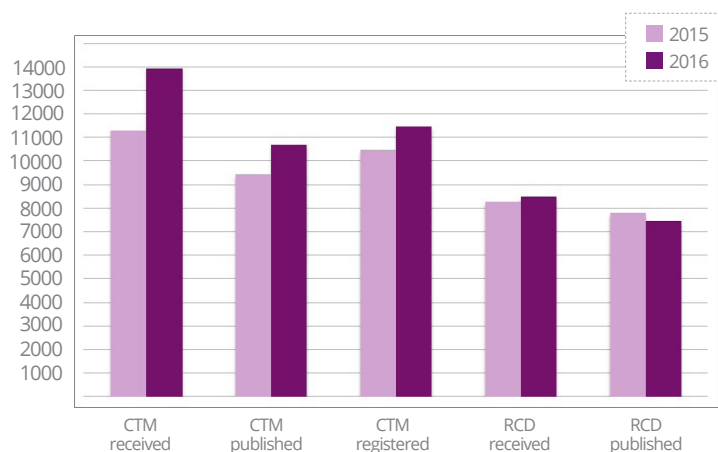


Statistical Highlights



Monthly statistical highlights March*	2015	2016
Community Trade Mark applications received	11 305	13 927
Community Trade Mark applications published	9 430	10 701
Community Trade Marks registered (certificates issued)	10 457	11 482
Registered Community Designs received	8 266	8 474
Registered Community Designs published	7 776	7 453

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



First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open



The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property (INDECOPI) joins TMclass

As of 18 April 2016, the Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property (INDECOPI) joins TMclass.

This last addition brings the total number of national and regional IP Offices, including OAPI, WIPO and EUIPO, in the tool to 59.

TMclass now offers users the opportunity to search and translate terms to and from any of the 40 available languages.

This successful integration is the result of joint effort and cooperation within the framework of the International Cooperation Programme managed by EUIPO in collaboration with its international partners.

The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

The first Common Practice on designs was agreed



by participating EU IP Offices on November 2015. As a result, a Common Communication was published on the website of all implementing offices on 15 April 2016. This simultaneous publication offers users and interested IP Offices access to the Common Practice in its entirety and complementary information, such as the precise implementation dates for each implementing EU IP Office. A compilation of Frequently Asked Questions (FAQs) was also published together with the Common Communication.

Implementing EU IP Offices have worked diligently to prepare themselves and their stakeholders for the changes (if any) implied by the new Common Practice. A seamless incorporation of the principles into the EU Design landscape has been a top priority for the project's Working Group composed of twenty-three participating IP Offices, five observers, two User Associations and the EUIPO. With that in mind, the principles of the Common Practice, the Common Communication and supporting FAQs document have been made available in all 23 EU languages.

These efforts support transparency, legal certainty and predictability in how to use, appropriate disclaimers, types of views and how to represent designs on a neutral background. As additional information for users, the Common Communication also includes an overview of the Offices' quality standards for design applications received by electronic means and by paper.

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open



More News



EUIPO's e-invoicing policy

In 2014, the Office implemented two electronic invoicing options for suppliers: a B2B connection with the e-PRIOR system, developed and provided by the European Commission, and the e-PRIOR portal, which uses an ECAS account.

These e-invoicing systems were created to allow more effective cooperation between the EUIPO and its providers. They are also part of a larger strategy of the EUIPO and European Union institutions to implement paperless working methods in all their processes, particularly in the supply chain.

Full integration of the Office in the European Commission's [e-PRIOR project](#) is intended to ease the entire procurement and purchase process, before and after the award of framework contracts, and from the launch of a call for tender to payment of the last invoice.

E-invoicing simplifies the payment process considerably, reduces paper consumption and enhances security by eliminating the risk of loss of paper invoices or any attached documentation. Using an e-platform also simplifies communications between the service recipients and their providers.

More information:

[Factsheet](#)

For further information, contact Christine Haber, EUIPO's e-invoicing agent at Christine.haber@euipo.europa.eu

25% of youngsters intentionally use illegal sources to access online content

A quarter of EU citizens aged between 15 and 24 admit to intentionally using illegal sources to access online content in the past 12 months, according to the [IP Youth Scoreboard](#), published by the EUIPO and which surveyed young people in each of the 28 EU Member States.

Most say they do this because it is free, or cheaper than accessing content from legal sources.

Films and series were the most accessed types of content from illegal sources, followed by music and games.

Nearly one in four believed that they were doing nothing wrong in accessing digital content from illegal sources for personal use, and a third considered that content from illegal sources was easier to find and quicker to access than content from legal sources.

Six out of ten young Europeans say they would stop using illegal sources to access digital content if more affordable content from legal sources was available. The report also shows a sharp difference in attitudes among young people between illegally accessing digital content and buying counterfeit goods online. Only 12% of those questioned said they have

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open



More News



intentionally bought counterfeit products online in the past 12 months, mostly counterfeit clothes, accessories and footwear, with over half saying they did so because it was cheaper than buying the real thing.

However, the vast majority of young people do not buy counterfeit products online. Over half of all those questioned say they do not trust the sites which sell counterfeit goods, and 20% say they are afraid of their data being misused if they make a purchase.

Trade in counterfeit and pirated goods: Mapping the economic impact

The worldwide trade in counterfeit goods is worth up to €338 billion – 2.5% of total world trade – based on the latest available data from 2013.

That's according to a new study, released by EUIPO and the OECD on April 18. The study also shows that in the EU, as much as 5% of all imports were of counterfeit and pirated products, worth up to €85 billion.

The report, "Trade in Counterfeit and Pirated Goods: Mapping the Economic Impact," uses data from almost half a million customs seizures across the world to calculate the economic impact of counterfeiting and piracy on international trade.

It finds that counterfeit and pirated goods can originate from all economies. Emerging economies play an important part in this phenomenon, either as producers of counterfeits or as transit zones. The report shows that almost any product can be infringed, from luxury goods, industrial products (like machines, spare parts or chemicals), and consumer goods which impact on personal safety (pharmaceuticals, food and drink, medical equipment or toys).

The data analysed in the report was supplied by the World Customs Organization, the European Commission's Taxation and Customs Union Directorate General and the United States Customs and Border Protection to give an accurate picture of the global economic impact of counterfeiting and piracy in international trade.

The report is available [through the EUIPO website](#).

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open

Case law

Luxembourg trade mark and design news

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

Case C-252/15P; Naanzen Investments Ltd v OHIM; Judgment of 17 March 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Declaration, Distortion of facts of evidence, Evidence of use, Lack of reasoning, Matters of fact appealed to CJ, Proof of use

FACTS: The EUTM represented below was revoked for non-use by Cancellation Division, confirmed by the Board of Appeal (BoA) and the General Court (GC). The EUTM proprietor filed an appeal before the European Court of Justice (CJ).

EUTM

SMART WATER

SUBSTANCE: FIRST GROUND OF APPEAL - BREACH OF DUTY TO STATE REASONS BY THE BoA. The CJ confirms that where the first instance decision is confirmed, it forms part of the context known



to the parties (Para. 31). The appellant has not disputed the sufficiency of the reasoning of the adjudicating bodies of the Office (Para. 32). The CJ further confirms that the Office's obligation to state reasons may be discharged without explicitly and exhaustively addressing all its arguments; moreover, the appellant did not identify the specific arguments which the BoA did not address, nor has it shown how the alleged failure to state reasons affected the exercise of its right of appeal (Para. 34). SECOND GROUND OF APPEAL - FIRST PART - GENUINE USE. The CJ held that the appellant contests the GC's assessment of evidential value of affidavits and is thereby asking the CJ to substitute its own assessment of the facts and evidence for that of the GC. That line of argument is inadmissible (Paras. 59-60). Findings regarding facts found by the GC which suggested that the use was not sufficient cannot be contested before the CJ (Para. 63). The same applies for the argument that the GC did not regard certain evidence as sufficient to dispel doubts as to the genuineness of use, as well as to the argument that the GC did not give proper value to the existence of non-disclosure agreements (Para. 66). Regarding the claimed distortion of facts, the appellant must indicate precisely the evidence alleged to have been distorted by the GC and show the errors of appraisal which led to that distortion; such distortion must be obvious from the documents on the Court's file, without need to carry out a new assessment of the facts and evidence (Para. 69). In the present case the appellant merely

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open

Case law



alleges distortion of facts, without explaining how this might affect the GC's assessment of genuine use in circumstances where that conclusion follows from an overall assessment of all the evidence produced before it (Para. 71). The reasons why the mark was not used more extensively are taken into account in the assessment of proper reasons for non-use but not as a relevant justification of modest commercial volume; assessment of genuine use takes into account evidence of the existence of use and not evidence explaining non-use, the latter being taken into account in the assessment of the reasons for non-use (Para. 74). Non-use referred to in the first subparagraph of Article 15 (1) and Article 51 (1) (a) of Regulation No 207/2009 must necessarily be understood as referring to a failure to put the trade mark to genuine use within the meaning of the first part of those provisions, including, therefore, both a complete failure to use a mark and limited use of a mark (Para. 78). SECOND GROUND OF APPEAL - SECOND PART - REASONS FOR NON USE. The appellant complained that the GC set the requirement of "impossible" use; the CJ clarifies that the GC did not examine whether the alleged obstacles made the use impossible, but whether it made it unreasonable (Para. 95). It is not sufficient that an obstacle is independent of the will of the trade mark proprietor; it must have sufficiently direct relationship with the mark making its use impossible or unreasonable (Para. 97). The GC stated that revocation proceedings brought against the mark does not prevent the proprietor

of that mark from using it and a possible order to pay damages is not a direct consequence of the revocation proceedings. In this regard, the appellant is in fact seeking review of the GC's appraisal of facts, such review is outside the jurisdiction of the CJ (Paras. 96-99).

B: General Court: Orders and judgments on appeals against decisions of the OHIM

Case T-683/13; Brammer GmbH v OHIM; Judgment of 2 February 2016; Language of the case: DE

RESULT: Action partially upheld (BoA decision partially annulled)

KEYWORDS: Common element, Complementary goods and services, Conceptual similarity, Dissimilarity of the goods and services, Likelihood of confusion, Nature of goods and services, Phonetic similarity, Similarity of the signs, Visual similarity, Weak element, Weak trade mark

FACTS: The applicant sought to register the word mark EUROMARKER as a CTM for inter alia services in Class 38 "providing access to database servers..." and Class 42 "creation and administration of databases...".

The opponent filed an opposition on the grounds of Article 8 (1) (b) CTMR on the basis of the earlier CTMR word mark EURIMARK, registered for

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open

Case law



services in Classes 35, 41, 42 (inter alia: “design and development of computer hardware and software...”) and 45.

The Opposition Division upheld the opposition. The EUTM applicant filed an appeal against the decision. The Board of Appeal (BoA) dismissed the applicant’s appeal. It held that the relevant public are professionals in the entire Union. The services in question are either remotely similar or similar. The signs are similar from a visual, phonetic and conceptual point of view. Although the earlier right is of weak distinctive character this does not exclude, in the present case, a likelihood of confusion. The applicant filed an action before the General Court (GC).

EUTMA

EUROMARKER

Earlier mark

EURIMARK

SUBSTANCE: The GC endorsed the findings of the BoA with regard to the relevant public and territory. Furthermore, the GC confirmed the conclusions of the BoA as to a similarity between the services “creation and administration of databases...” of the

EUTMA and “design and development of computer hardware and software...” of the earlier mark. The GC agreed with the BoA as regards the visual, phonetic and conceptual similarities of the signs. Finally, the GC clarified that the signs in dispute have to be considered as a whole rather than its individual elements and confirmed the conclusion of the BoA that likelihood of confusion cannot be excluded solely on the basis that the older right is of weak distinctive character. With regard to Class 42 the GC therefore dismissed the appeal of the applicant.

With regard to Class 38, however, the GC ruled that the BoA erred in finding a remote similarity between the services “providing access to database servers...” and “design and development of computer hardware and software...”. According to the GC, the BoA was right to conclude that these services are of a different type, do not serve the same application, its use is different, are not addressed to the same public, are not interchangeable, are neither in competition nor complement each other, but was wrong to find, despite the indicated differences, a remote similarity between these services. Moreover, the GC confirmed the findings of the BoA that there is no similarity between the remaining services of the earlier mark (in particular “scientific or legal services”) and the services of Class 38 of the CTMA.

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open

Case law



Case T-640/13; Sto SE & Co. KGaA v OHIM; Judgment of 28 January 2016; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Visual dissimilarity, Phonetic dissimilarity, Conceptual dissimilarity

FACTS: The applicant sought to register word mark CRETEO as a CTM for goods and services within Classes 1, 2, 17 and 19.

An opposition based on the earlier word marks StoCretec and STOCRETE, registered in Germany for goods in Classes 1, 2, 17 and 19 was filed on the grounds of Article 8 (1) (b) EUTMR. The Opposition Division (OD) dismissed the opposition. The Board of Appeal (BoA) confirmed this decision. The opponent filed an action before the General Court (GC).

EUTMA

CRETEO

Earlier mark

**StoCretec
STOCRETE**

SUBSTANCE: The GC rejected the only claim of infringement of Article 8 (1) (b) EUTMR. It confirmed the finding that the EUTM applied for is dissimilar to the earlier mark StoCretec and similar to only low degree to the earlier mark STOCRETE. The beginning of the earlier marks "STO" which is not present in the EUTM applied for will not be neglected by the relevant public (Para. 33 et seq). The use of the capital letter "C" in the earlier mark StoCretec cannot lead to the conclusion that the public will separate the beginning "Sto" from the part "Cretec", since the mark is protected as a word mark, thus just the sequence of letters (Paras. 36-39). The argument of the applicant, according to which the first part "Sto" of the earlier mark corresponds to its company name and according to the German case law would not be taken into account when assessing the likelihood of confusion, is not convincing. The BoA was not obliged to examine the German law, if the applicant did not prove it (Para. 46). The European trade mark law is an autonomous system and the German law not applicable to the comparison of the signs (Paras. 47, 53).

Case T-501/13; Karl-May-Verlag GmbH v OHIM; Judgment of 18 March 2016; Language of the case: DE

RESULT: Action upheld (BoA decision partly annulled)

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open

Case law



KEYWORDS: Descriptive element, Distinctive element, Nature of the goods and services, Principle of legality

FACTS: The Cancellation Division (CD) rejected a cancellation request (Article 52 (1) (a) EUTMR), which had been filed against the EUTM WINNETOU, registered for a wide range of goods and services in Classes 3, 9, 14, 16, 18, 21, 24, 25, 28, 29, 30, 39, 41, 42 and 43. The Board of Appeal (BoA) annulled the CD's decision and declared the EUTM invalid for almost all goods and services (with the exception of "printers' type; printing blocks" in Class 16).

With regard to the descriptive character the BoA stated that "WINNETOU" is the main character in a series of (19th century) novels by the German author Karl May, and the protagonist of films, radio and theatre plays. The average German consumer understands the term as a reference to a fictional, noble and good Native American Chieftain. According to the German Bundesgerichtshof "WINNETOU" is descriptive for film productions, publishing of books and magazines. Although the BoA is not bound by these findings, in this case, in so far as a higher national court has ruled that "WINNETOU" is descriptive in Germany, the contested mark had to be also regarded as ineligible for protection connected to books, radio and television, as they all (can) relate to Winnetou or have a Winnetou theme. The vast majority of remaining goods can be classified as "merchandising" goods with a direct link to "Winnetou"; certain services (e.g. transport,

accommodation) have a direct link with "Winnetou" festivals. Consequently, the BoA found the EUTM to be descriptive for the rejected goods and services. The BoA found the EUTM also devoid of distinctive character for goods and services related to a magnanimous Native American Chieftain or the book character, since the consumer will believe that the mark describes the contents or purpose of the goods and services.

The applicant filed an action before the General Court (GC), asking the GC to annul the contested decision (in so far as the BoA had upheld the declaration of invalidity). Amongst other pleas, the applicant claimed a breach of Article 7 (1) (c) and (b) EUTMR, as well as a breach of the principles of autonomy and independence of the EU trade mark system.

EUTM

WINNETOU

SUBSTANCE: The applicant claimed that the BoA infringed the autonomy of the EU trade mark system by basing the contested decision exclusively on decisions of the German Courts on the descriptiveness of "Winnetou", without an independent assessment applying the EU trade mark law criteria.

The GC emphasized at the outset that the

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open

Case law



registrability of a sign as a EUTM is to be assessed solely on the basis of the relevant EU rules. The EUTMR does not require the Office or, on appeal, the GC to come to the same conclusions as those arrived at by national administrative bodies or courts in similar circumstances. The Office may nevertheless take those decisions into consideration - without them being binding or even determinative - as indicia in the assessment of the facts of the case (Paras. 35, 36). Although in the present case, the BoA has rightly pointed out that it was not bound by case law of national courts, it however added in the same paragraph that, in the case at issue, in so far as a national Supreme Court had ruled that the term "Winnetou" was descriptive in Germany, the EUTMR had also to be regarded as ineligible for protection in respect of g&s connected to books, radio and television. Thus, the BoA accepted the findings of the German Court without carrying out an independent, autonomous assessment. Consequently, the BoA treated the decisions of the German Court not as possessing an indicative value as evidence in the context of the assessment of the facts of the case, but - erroneously - as binding as to the registrability of the contested mark (Paras. 41, 42). Consequently, the contested decision must be annulled in so far as it upheld the application for a declaration of invalidity to the extent that the error of law vitiates both the BoA's assessment of the application of Articles 7 (1) (c) and (b) EUTMR (Para. 46). Although it had not been invoked by the applicant, the GC, on its own motion, went on

discussing whether the BoA's reasoning as to the descriptiveness of "Winnetou" for all the goods and services [being perceived by the relevant public as connected with concepts of "Native American" and "Native American Chieftain"] was sufficient or rather constituted an infringement of the obligation to state reasons (Article 75 EUTMR).

The GC criticised, first, that the BoA did not carry out any specific analysis that the sign **WINNETOU**, beyond its concrete meaning as an evocation of a fictional character, was indeed perceived as connected with the concepts of "Native American" and "Native American Chieftain" (Para. 59).

Second, the BoA gave only a general statement of reasons, particularly for "merchandising" goods. A general reasoning can only extend to goods and services which have a sufficiently direct and specific link to each other to the point that they form a sufficiently homogenous category. The goods qualified as "merchandising" articles by the BoA [e.g. perfumery, jewellery, walking sticks, calculating machines, kitchen containers, meat, confectionery] do not show such a sufficiently direct and specific link as to consider them a homogeneous category of goods, for which an overall general statement would suffice. The goods rather display obvious differences as regards their nature, characteristics, intended purpose and methods of marketing (Paras. 70-72).

Moreover, the BoA's reasoning as to the direct and specific link between those goods and the sign **WINNETOU** [BoA: goods are connected to

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open

Case law

films or the book character with regard to which the consumer will assume that they are merely "Winnetou" advertising goods and will not deduce the origin of the goods] is excessively general and abstract. Such general assertions, devoid of any specific analysis in relation to the nature and characteristics of the goods in question, are inadequate and do not make it possible to understand why the BoA found a sufficiently direct and specific link of "Winnetou" with the goods concerned (Paras. 73-75). The assertions that goods such as clothing, nutcrackers or foodstuff are sold in souvenir shops or festivals do not make it possible to understand more precisely, clearly and unequivocally, the reasoning of the BoA, which led it to the conclusion that the contested mark, which, moreover, is a word mark and not a figurative mark representing a "Native American", is descriptive of those goods (Para. 79).

It must therefore be held that the contested decision is also vitiated by an inadequate statement of reasons (Para. 80).

Based on the foregoing, the GC annulled the contested decision in so far as it rejected the application for a declaration of invalidity.

Case T-692/14; PUMA SE v OHIM; Judgment of 25 February 2016; Language of the case: PL

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Visual dissimilarity



EUTM



Earlier mark



FACTS: The applicant sought to register the figurative mark represented below as a EUTM for goods within Class 5.

An opposition based on the earlier figurative mark represented below, registered for goods in Class 5, was filed on the grounds of Article 8 (1) (b) EUTMR. The Opposition Division dismissed the opposition on the basis that the trade marks were dissimilar. The Board of Appeal (BoA) dismissed the opponent's

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open

Case law

appeal and confirmed the decision as well as the finding that the marks of dissimilarity of the signs. The opponent filed an action to the General Court (GC) claiming an infringement of Article 8 (1) (b) EUTMR.

SUBSTANCE: The GC decided with a very brief reasoning (Paras. 33-36) that the BoA did not consider the coincidences between the marks (both containing a black silhouette of a jumping animal with the same line of the back) but only emphasized the differences. This contradicts the principle that the trade marks comparison is based on the overall impression (Para. 32). The decision was annulled and remitted to the BoA for a new assessment.

Case T-543/14; provima Warenhandels GmbH v OHIM; Judgment of 26 February 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Descriptive element, Distinctive element, International registration, Principle of legality

FACTS: The applicant sought to cancel the International word mark HOT SOX with extension to the European Union for "hosiery" in Class 25. The Cancellation Division's decision, rejecting the application for invalidity pursuant to Article 158



EUTMR in relation to Article 52 (1) (a) and Articles 7 (1) (b) and (c) EUTMR, was upheld by the Board of Appeal (BoA). The applicant put forward two pleas in law before the (General Court) GC.

EUTM

HOT SOX

SUBSTANCE: INFRINGEMENT OF ARTICLE 158 EUTMR, READ IN CONJUNCTION WITH ARTICLE 52 (1) (a) AND ARTICLE 7 (1) (c) EUTMR: Although the element "sox" is not an English term for socks but is rather used in the US, it cannot be excluded that the word be understood as referring to socks. "Sox" and "socks" are phonetically identical (Para. 27). In the evidence, "sox" is not used in isolation, and it does not replace the word "socks" (Para. 28). It is not enough that one of the elements of a sign is descriptive; the descriptive character must be established for the sign as a whole (Para. 29). "Hot" in its meaning of "extremely warm" or "very high temperature" is not descriptive of the goods at issue (socks) since it does not describe their characteristics. "Hot" is not a synonym of "warm". Socks are worn to keep feet warm or to warm them, but not to make them hot (Para. 33). "HOT SOX" does not mean "warming socks" (Para. 34). In stating that the definition of the word "hot" as "fashionable" was one of its least recognised meanings and that

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open



Case law



that word had too many definitions to give the word “socks” a clearly definable meaning, the BoA failed to apply settled case law according to which a word sign must be excluded from registration under Article 7 (1) (c) EUTMR if by at least one of its possible meanings it described a characteristic of the goods (Paras. 39 and 41). However, as there is no evidence on file that English-speaking consumers in the EU will immediately perceive “HOT SOX” as meaning “fashionable socks” or “currently popular socks”, it is unlikely that the contested mark, taken as a whole, serves, in normal usage from the point of view of the relevant public, to designate ‘socks currently popular or in demand’ (para. 43). It had not been established that HOT SOX could be interpreted in the sense of “fashionable socks” or “currently popular socks” on the date of filing of the contested mark (Paras. 45 and 46). It is further highly unlikely that the average consumer interprets HOT SOX as referring to “erotic or sexy socks”, since a pair of socks is not generally perceived as being sexually provocative (Para. 49). The fact that HOT SOX was registered in the UK and Ireland is more relevant than its alleged descriptiveness in Germany. The sole fact of a widespread knowledge of English on the part of the relevant public is not sufficient if English was not actually used in that context to address that public.

INFRINGEMENT OF ARTICLE 158 EUTMR, READ IN CONJUNCTION WITH ARTICLE 52 (1) (a) AND ARTICLE 7 (1) (b) EUTMR: The word “hot”, unusual for articles of hosiery, and an incorrect spelling of the word

“socks” form a sufficiently original whole to have a minimal distinctive character to avoid the absolute ground for refusal under Article 7 (1) (b) EUTMR (Para. 64).

Case T-33/15; Grupo Bimbo, S.A.B. de C.V. v OHIM; Judgment of 18 March 2016; Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Descriptive element, Distinctiveness acquired by use

FACTS: The applicant sought to register the word mark BIMBO as a EUTM for goods in Class 30.

The examiner refused the application. It found it to be descriptive for the relevant goods (“BIMBO” means “bambino” in Italian). The relevant public will consider the sign descriptive of the public to which the products are directed to. It further dismissed the claim of acquired distinctiveness through use: the applicant had not proven the acquisition of distinctiveness in Italy.

The Board of Appeal (BoA) dismissed applicant’s appeal. The applicant filed an action before the General Court (GC).

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO’s e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open

Case law

CTMA

BIMBO

SUBSTANCE: The GC dismissed all of the applicant's arguments. The GC confirms that it is possible to refuse a EUTM application after publication (Para. 20). The sign informs the relevant public of the target public of the product. Therefore, the sign presents a sufficiently direct and concrete link with the products to be descriptive under Article 7 (1) (c) EUTMR (Para. 46). This conclusion is not affected by the Italian law on labelling (Paras. 48-49), its registration in Italy (Paras. 50-52) and allegedly analogous Office registrations (Paras. 53-56).

As regards Article 7(1) (b) EUTMR, the GC considers that BoA incurred in an error for considering that Article 7 (1) (b) EUTMR was applicable by the mere fact that the sign was descriptive. However, this error has no bearing on the legality of the contested decision (Paras. 63-64).

Finally, regarding the assessment of 7 (3) EUTMR, the GC confirms the Office assessment of the evidence: it does not show acquired distinctiveness through use in Italy (Paras. 77-81). Likewise, the fact that there is judgment indicating that BIMBO is reputed in Spain does not show acquired distinctiveness in Italy. The GC draws the difference between the case law on Article 8 (5) EUTMR and the assessment of Article 7 (3) EUTMR (Paras. 82-84).



Case T-30/15; Infinite Cycle Works Ltd v OHIM; Judgment of 19 February 2016; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Conceptual identity, Figurative element, Figurative trade mark, Identity of the goods and services, Similarity of the goods and services, Likelihood of confusion, Phonetic similarity, Purpose of the goods and services, Visual similarity, Weak element

FACTS: The applicant sought to register the word mark INFINITY as a EUTMR for goods in Classes 12, 25 and 28. An opposition, based on two earlier EUTMs INFINI reproduced below and registered for goods in Classes 9, 11 and 12, was filed on the grounds of Article 8 (1) (b) EUTMR. The Opposition Division partly upheld the opposition, namely in relation to the identical and similar goods in Classes 12 and 28. The Board of Appeal (BoA) dismissed the appeal. The applicant filed an action before the General Court (GC).

SUBSTANCE: INFRINGEMENT OF ARTICLE 8 (1) (b) EUTMR: The GC confirmed the BoA's finding that exercise bicycles in Class 28 consist of similar constituent parts as outdoor bicycles in Class 12, share an identical mode of operation and are often used in a complementary way. A habitual cyclist will be likely to own an indoor bicycle in order to be able

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open

Case law



EUTM

INFINITY

Earlier marks

INFINI  *et al.*

to practice that sport irrespective of the weather conditions. The fact that these goods are classified in different classes is irrelevant since the similarity does not depend on the classification (Paras. 39-41). The GC further confirmed the similarity of the signs. Visually they share the first parts and the figurative element of the earlier mark is commonplace and banal (Paras. 46 and 47). The French-speaking public will not adopt the English pronunciation for the word "infinity" but will use French pronunciation for both words (Para. 49). The BoA was right to consider the signs conceptually identical at least in Belgium and France since the French word "infini" is the root of the English word "infinity", with the result that, for the French-speaking public, that word will be understood in the same way, without even needing to understand the corresponding English

word (Para. 50). The GC confirmed the finding of a likelihood of confusion based on partly identical and partly similar goods and a sufficiently high degree of similarity between the signs (Para. 56). The applicant's argument that the earlier marks had weak distinctive character was dismissed by the GC on the basis that the distinctive character is only one factor among others involved in the assessment of a likelihood of confusion (Para. 58).

Case T-363/15; Työhönvalmennus Valma Oy v OHIM; Judgment of 16 March 2016; Language of the case: FI

RESULT: Action dismissed

KEYWORDS: Distinctive element, Distinctiveness acquired by use, Evidence of use, Shape of the product, Survey, Three dimensional mark

FACTS: The applicant sought to register a 3-D mark reproduced below for goods in Class 28 (games). It further claimed acquired distinctiveness through use. The examiner's decision, rejecting the application pursuant to Article 7 (1) (b) and 7 (3) EUTMR, was upheld by the Boards of Appeal (BoA). The applicant appealed to the General Court (GC) and put forward two pleas in law.

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open

Case law



EUTM



SUBSTANCE: INFRINGEMENT OF ARTICLE 7 (1) (b) EUTMR: For a 3-D mark to be registered, it does not suffice that it is original, but it must differ substantially from the basic shapes of the goods in question, commonly used in the trade, and not look like a mere variant of those shapes (Para. 21). The type of wood used (Finnish birch) and the fact that the wood blocks are numbered by burning and bevelled at one end are details that are hardly noticeable on the reproduction of the sign (Para. 23). It is common that in regard to outdoor games, the goods in question are usually sold in packaging made from different materials, including wood (para. 24). While it is true that the fact that a mark may serve several purposes (including a carrying purpose) at the same time is immaterial to its distinctive character, such a mark must nonetheless be able to function as an indicator of commercial origin (Para. 26). The fact that the BoA relied on case

law dating back more than ten years is irrelevant to the outcome of the case, contrary to the allegation of the applicant (Paras. 27 and 28). The applicant failed to demonstrate that the relevant public was used to seeing the shape of the goods concerned as an indication of commercial origin at the time of the application of the mark (Para. 29).

INFRINGEMENT OF ARTICLE 7 (3) EUTMR: In line with the unitary character of a EUTM, it would be paradoxical to admit, first, that a Member State is required to refuse registration as a national mark of a sign which is not distinctive in its territory and, secondly, that that State is required to comply with a EUTM of the same sign for the sole reason that it has acquired a distinctive character in the territory of another Member State (para. 36). In cases of non-word marks the assessment of the distinctive character will be the same throughout the EU, unless there is concrete evidence to the contrary (Para. 37). Although the trade mark for which registration is sought may have been used in conjunction with another mark, the fact remains that, for the purposes of the registration of the mark itself, the applicant must prove that that mark alone, as opposed to any other trade mark which may also be present, identifies the particular undertaking from which the goods originate (Para. 51). The applicant failed to prove that the 3-D mark applied for acquired distinctiveness through use in the relevant EU territory in its own right, without an addition of the word or figurative mark MÖLLKY which appeared in the majority of the evidence.

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open

Case law

New Decisions from the Boards of Appeal

The cases [can be found on our website](#).

Please note that the full number including slash has to be entered in our database under 'Appeal N°', without the letter 'R'. e.g. Case R 219/2004-1 has to be entered under 'Appeal N°' as: 0219/2004-1

R0848/2015-2 GPTECH (fig.) / GP JOULE et al. - EN



RESULT: Decision confirmed.

KEYWORDS: Admissibility, Competence of the Boards, Declaration, Figurative trade mark, Licence agreement, New submission on appeal, Substantiation of earlier rights, Article 8(1) CTMR, Article 8(2) CTMR, Article 8(4) CTMR, Article 8(5) CTMR, Article 41(1)(a) CTMR, Article 41(3) CTMR, Article 76(2) CTMR, Article 78 CTMR, Article 15 CTMIR, , Article 17(4) CTMIR, Article 19 CTMIR, , Article 20 CTMIR, Article 22 CTMIR, Article 33 CTMIR, Article 50(1) CTMIR

FACTS: The applicant sought to register the figurative mark 'GPTECH', for goods and services in Classes 9



and 42. The opponent filed an opposition based on Article 8(1)(b) CTMR against all the goods in Class 9 and some of the services in Class 42. According to the Office's database and the certificates of registration, the owner of the earlier trade marks is not the opponent. The opponent filed observations and argued that it is the exclusive licensee of the opposing trade marks. The exclusive licence to the opponent was never registered and published at the Office. The Opposition Division rejected the opposition as unfounded and allowed the mark to proceed to registration.

SUBSTANCE: Pursuant to Article 41(1)(a) CTMR a notice of opposition to the registration of a Community trade mark may be filed by the proprietors of earlier trade marks referred to in Article 8(2) CTMR, as well as licensees authorised by the proprietors of those trade marks. In accordance with Article 41(3) CTMR, within a period fixed by the Office, the opponent may submit in support of its case facts, evidence and arguments (§ 18-19). Article 76(2) CTMR provides that the Office may disregard facts or evidence which are not submitted in due time by the parties concerned. According to recent case-law, the Office has a broad discretion to decide, while giving reasons for its decision in that regard, whether or not to take such evidence into account (§ 52 – 54). The Board considers that the discretionary competence only applies when the evidence submitted for the first time before the Board is additional or supplementary evidence (§ 62).

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open

Case law



Since the opponent has failed to prove its entitlement before the Opposition Division, there was an absolute lack of evidence at first instance. Furthermore, the Board reiterates that if the abovementioned evidence is not provided within the time-limit set by the Office, the opposition has to be rejected as unfounded. Under such circumstances, the evidence submitted for the first time before the Board cannot be considered as additional or supplementary evidence and thus it is inadmissible (§ 67–68).

Consequently, the appeal is dismissed and the opposition rejected.

R1617/2015-2 REEFLOWERS (fig.) - EN



RESULT: Decision annulled.

KEYWORDS: Figurative trade mark, International registration, Reimbursement, Representatives, Article 92(2) CTMR, Article 93(1) CTMR, Article 19 CTMIR, Article 51 CTMIR, Article 114(4) CTMIR

FACTS: By international registration No 1 202 859 dated 12 August 2013 designating the European Union, the IR holder sought protection for the figurative mark 'Reeflowers' for goods in Classes 1, 3 and 5. The Office refused protection of the

international registration for the European Union in whole because a representative had not been appointed within the time-limit.

SUBSTANCE: According to Rule 114(4) CTMIR (mention of which was, however, omitted in the contested decision), where the holder of an international registration is obliged to be represented in proceedings before the Office pursuant to Article 92(2) CTMR, and where he/she has not already appointed a representative within the meaning of Article 93(1) CTMR, the communication of the opposition to the holder of the international registration pursuant to Article 19 CTMIR shall contain an invitation to appoint a representative within the meaning of Article 93(1) CTMR within a two-month period from the date of notification of the communication. Where the holder of the international registration fails to appoint a representative within this period, the Office shall take a decision refusing protection of the international registration (§ 13).

In the present case, it is considered that by appointing a professional representative domiciled in the territory of the European Union and empowered to act in all procedures before Office, even at the appeal stage, the IR holder has remedied the deficiency which led the Office to adopt the contested decision (§ 14).

The IR holder's observations related to opposition proceedings No B 2475 740 are irrelevant for the present ex parte proceedings, nevertheless they

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open

Case law



shall be taken into account in the abovementioned opposition proceedings (§ 18).

Consequently, the appeal is upheld and the case is remitted for further prosecution as regards opposition proceedings No B 2 475 740.

R0984/2015-2

ACCUMAX QUANTUM / QUANTUM et al.

RESULT: Decision confirmed.

KEYWORDS: Burden of proof, Declaration, Dissimilarity of the goods and services, Evidence of use, Likelihood of confusion, Nature of the goods and services, Non-registered trade mark, Purpose of the goods and services, Reputation, Article 8(1)(b) CTMR, Article 8(4) CTMR, Article 8(5) CTMR, Article 76(1) CTMR, Rule 19 CTMIR.

FACTS: The applicant sought to register the word mark 'ACCUMAX QUANTUM' for goods in Classes 10, 12 and 24. The opponent filed an opposition on the basis of several earlier rights, including the non-registered trade marks 'QUANTUM' and 'QUANTUM REHAB' and the earlier signs 'QUANTUM' and 'QUANTUM REHAB' established through use, protected in all the 15 Member States of the European Union at the filing date of the opposition. The opposition was based on, as far as the mentioned earlier rights are concerned, Article 8(4) CTMR. The Opposition Division rejected the

opposition since it considered that the opponent had not substantiated Article 8(4) CTMR.

SUBSTANCE: The Board first concludes that the contested decision correctly applied Article 8(1)(b) CTMR. For Article 8(4) CTMR to apply, all the following, cumulative conditions must be fulfilled: (i) the sign must be used in the course of trade; (ii) it must be of more than mere local significance; (iii) the right to that sign must be acquired prior to the date of application for registration of a Community trade mark; (iv) the national law must confer on its proprietor the right to prohibit the use of the subsequent trade mark (§ 97).

If one of those requirements is not met, then the request must be rejected and there is no need to address the rest of the requirements (§ 110).

As to Article 8(4) CTMR as a basis of the opposition, apart from a vague reference to 'United Kingdom passing-off rights', the opponent submitted no information to the Opposition Division concerning the content of the rights invoked or the conditions to be fulfilled in order for it to be possible to prohibit the use of the contested sign under the laws in any of the Member States claimed, nor did it submit any explanation as to how that law should be applied to the present case (§ 102, 105, 118).

It is the opposing party that must claim, and submit all the necessary information to demonstrate that the earlier sign falls within the scope of application of the national law, the body of law and the legal regulation thereof according to said national law

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open

Case law

and that the latter confers the right to prohibit the use of a subsequent trade mark (§ 116). Moreover, the opponent did not cite any national case-law to illustrate or demonstrate what level of use of the earlier rights invoked may be deemed sufficient to constitute genuine use under the provisions in the different territories of the European Union (§ 123). Therefore, the contested decision was correct in rejecting the opposition insofar as based on Article 8(4) CTMR.

With regard to Article 8(5) CTMR it must be determined whether the conditions for the application of this provision are met, namely: (a) whether the earlier trade mark has a reputation, (b) whether the contested sign is identical to this earlier mark or is similar to it; (c), whether there is a risk that the use without due cause of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark; and (d) whether there is no due cause justifying the use of the mark. In the present case, the Board, after assessing the evidence, concludes that the condition related to the reputation of the earlier mark(s) is not fulfilled. Although the existence of a link between the signs at issue might not be excluded – due to, in particular, their possible similarity and a partial overlap between the relevant sections of the public – notwithstanding the differences between the goods in question, the contested sign will not call to mind the earlier marks in the absence of the earlier marks' substantial reputation (§ 92-93).



It follows from the above that the opponent's appeal must be dismissed.

R2973/2014-2 COLOURS CACTUS (fig.)



RESULT: Decision confirmed.

KEYWORDS: Distinctive element, Dominant element, Figurative element, Figurative trade mark, Proof of use, Revocation grounds, Use not as registered, Article 15(1)(a) CTMR, Article 51(1)(a) CTMR.

FACTS: The figurative mark



was registered for goods and services in Classes 31, 39 and 44. The cancellation applicant filed an application for revocation invoking Article 51(1)(a) CTMR and arguing that the contested CTM had not been put to genuine use during the last five years. The Cancellation Division revoked the registration of the CTM for all the goods and services.

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

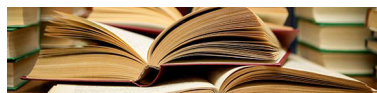
■ Applications now open

Case law

SUBSTANCE: Pursuant to Article 51(1)(a) CTMR the rights of the proprietor of the Community trade mark shall be declared revoked if, within a continuous five-year period, the trade mark has not been put to genuine use in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use (§ 16). 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 on the market concerned (12/12/2002, [T-39/01](#), Hiwatt, EU:T:2002:316, § 47). In other words, it is not sufficient for genuine use of the mark to appear probable or credible; actual proof of that use must be given (18/01/2011, [T-382/08](#), Vogue, EU:T:2011:9, § 40) (§ 20).

In the present case, none of the evidence shows use of the mark exactly as it was registered. The omission of the figurative element in some of the marks is much more than a mere variation or modernisation and clearly alters the mark's distinctive character. As to the word combinations 'Colours cactus' and 'Cactus Andalucia', they refer to two completely different concepts. (§ 29-34). Therefore, the sign in its different uses in trade differs from the form in which it was registered in more than only negligible elements (§ 35).

Consequently, the Board upholds the contested decision's finding that the CTM proprietor failed to prove use of its trade mark for the contested goods and services.



R1309/2015-5 Alumil Building excellence every day



RESULT: Appeal inadmissible.

KEYWORDS: Admissibility, Fee, Renewal, Rule 29 CTMIR, Rule 49(1) CTMIR, Article 47(2) CTMR.

FACTS: The figurative mark



was registered for goods and services in Classes 6 and 17. The mark was due for renewal, and the Office informed the CTM proprietor of this. In the absence of payment of the renewal fees the Office struck the CTM off the Register.

SUBSTANCE: Where a Community trade mark is not renewed within the basic period, the request may still be submitted and the renewal fee may still be paid, upon payment of an additional fee, within a further six-month period following the last day of the month in which protection ends (§ 10).

In the case at stake the renewal fee was not paid within the requisite time frame because a) the payment was made in Swiss francs (as opposed to euros) and b) the payment was made to WIPO whereas this being a CTM payment needed to be made to the OHIM's account (§ 15).

The Board notes that the Office is not obliged to

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open



Case law



notify the proprietor of any irregularities in the payment or afford him/her an opportunity to remedy such deficiencies within the period foreseen for payment (§ 16). As protection has ended, after the date of expiry of the six-month grace period, its effect has become final and this decision can no longer be challenged (§ 21-23). It follows that the appeal must be rejected as inadmissible.

First Page

- The DesignEuropa Awards
nominate or apply before July 15

James Nurton
Interviews | Simon Malynicz

European Union Trade Mark

- Update on Article 28(8)

Registered Community Design

- Common Communication on the graphic representation of designs

Statistical Highlights

- March 2016

ETMDN Updates

- The Peruvian National Institute for the Defense of Free Competition and the Protection of Intellectual Property joins TMclass
- The Common Communication for the CP6 Convergence Project on Graphic representation of designs is now available

More News

- EUIPO's e-invoicing policy
- 25% of youngsters intentionally use illegal sources to access online content
- Trade in counterfeit and pirated goods: Mapping the economic impact

Case Law

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



DESIGNEUROPA awards

■ Applications now open