EUIPO
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INTELLECTUAL PROPERTY OFFICE

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EU GEORGIA INTELLECTUAL PROPERTY PROJECT

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Article 59(1)(b) EUTMR : bad faith

An EU trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:

(a) where the EU trade mark has been registered contrary to the provisions of Article 7;

(b) where the applicant was acting in bad faith when he filed the application for the trade mark

Likelihood of confusion

CJUE, C-104/18 P, paras 48-57 (Stylo & Koton)

Likelihood of confusion is not a requirement for a finding of bad faith, not least because a request for cancellation on that ground can be filed by anyone without being required to be the proprietor of an earlier right

STYLO
&
KOTON

Contested EUTM (cl. 39 - transport)

Earlier mark (cl. 25, 35)

Circumstances arising outside of Europe

General Court, Cases T-3/18 et T-4/18, paras 88 and 158-161 (Ann Taylor)
General Court, Case T-795/17, para 50 (Neymar)

A deliberate strategy of misappropriation of third parties' rights may be substantiated by evidence relating to facts which occurred outside Europe and which concern the use and/or the registration of other marks.

The simple proximity or 'correlation' between dissimilar goods does not bar a finding that the applicant was acting in bad faith when applying for the mark 'Ann Taylor' in respect of watches if circumstancial evidence support the conclusion that he deliberately sought to create an association with an earlier mark proprietor enjoying market recognition in the United States in respect of clothing

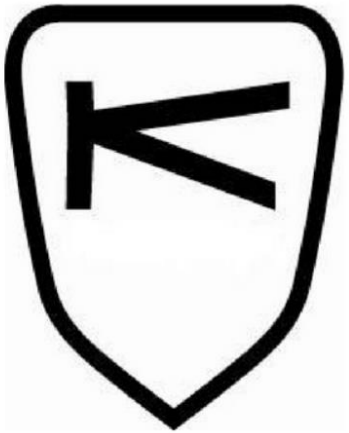
Business relationships and duty of loyalty

General Court, Case T-136/18, paras 55-57 and 68-69 (K/Kuota); Case T 772/17, paras 34 and 53-54 (Café del mar)

The existence of a contractual or pre-contractual relationships between the parties creates the presumption that the trade mark applicant was aware of the use of the mark at issue by his business partner and supposes a duty of loyalty in respect of this partner

KUOTA

Contested EUTM



Article 7(1)(c) EUTMR: Geographical names

The following shall not be registered :

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service

Reputation of the geographical name

General Court, T-869/16, paras 41-46 (Swissgear)

General Court, Case T-624/18, paras 47-53 (Gres de Aragon)

Article 7(1)(c) EUTMR requires that the geographical name be currently associated with the category of goods in question, or liable to be so in the future. This is not the case of the Spanish region of Aragon which does not enjoy reputation in respect of sandstone products. The sign *'Gres Aragon'* (sandstone from Aragon) is therefore registrable

Reputation of the geographical name

General Court, Case T-122/17, paras 45, 48 and 82 (Devin)

Article 7(1)(c) EUTMR may not apply to a geographical name, such as ‘Devin’ which is a small spa town in Bulgaria (Bulgaria being still a third country on the date of filing of the mark). This sign descriptive of the geographical origin of mineral water if the knowledge of the spa town by Europeans consumers is almost non-existent

DEVIN

Cl. 32 (mineral water)

Reputation of the geographical name

CJEU, C-488/16 P, paras 48-54 (Neuschwanstein)

Article 7(1)(c) EUTMR may not apply to a name corresponding to the name of a museum or touristic attraction where the goods applied for may be sold as souvenirs: the place of marketing may not serve as a tie connecting the goods and services covered by the contested trade mark with the place concerned, unless the name of this site is associated with 'a craft, a tradition or a climate which is a characteristic of a particular place'

Neuschwanstein

Cl. 3, 8, 14 à 16, 18, 21, 25, 28, 30, 32 à 36, 38 and 44

Article 8(2)(c) EUTMR (Well-known marks) and Article 8(5) EUTMR (marks with reputation)

Art. 8(2): For the purposes of Art 8(1), 'earlier trade mark' means :

(c) trade marks which, on the date of application for registration of the EU trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the EU trade mark, are well known in a Member State, in the sense in which the words 'well known' are used in Article 6*bis* of the Paris Convention

Art 8(5)

the trade mark applied for shall not be registered where it is identical with, or similar to, an earlier trade mark, irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered, where, in the case of an earlier EU trade mark, the trade mark has a reputation in the Union or, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned, and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark

Well-known trade marks

General Court, Case T-2/17, paras 57-58 and 75 (Messi / Massi)

The well-known character of the earlier mark must be established on the *filing da*te of the contested mark and it must subsist until the date that the action is brought. It can no longer be claimed that a 'prestigious but historical' mark, which was well-known in the 1970s in the field of racing bicycles, has a sufficient 'surviving reputation' forty years later.

A well-known status requires a higher degree of recognition of the mark than that required to establish reputation.

Marks with reputation – (i) Assessment of reputation

CJEU, Case C-564/16 P, paras 66-74 and 95-99 (Representation of a feline)

Any form of evidence is admissible when demonstrating reputation. National or EUIPO decisions can constitute 'strong indications' of this reputation. Evidence of the reputation of an earlier mark, as illustrated by EUIPO decisions, cannot be disregarded without proper reasoning. In case of doubt as to the existence of this reputation found in past decisions, EUIPO is under the obligation to ask the opponent to provide additional evidence

Cl. 7: Machines for processing of wood

Cl. 25 and 28

Marks with reputation – (i) Assessment of reputation

General Court, Case T-62/16, EU:T:2018:604, paras 67-70, 88-89 and 100-101 (Puma / Puma)

The complete dissimilarity of goods or services covered by the mark with a reputation and the contested mark is not sufficient in itself to exclude the possibility of free-riding or harm to reputation The application of Article 8(5) EUTMR therefore requires EUIPO to take a preliminary position on the degree of the reputation of the earlier mark.

PUMA

Cl. 7: machining centres; turning centre; electric discharge machine'

Cl. 25 and 28

Marks with reputation – (ii) Reputation and use in an amended form

General Court, Case T-629/16, paras 76-78 (Three stripes)

Reputation resulting from a use 'in a different form' than that of the registration, and in particular in the form of another registered mark. The reputation of a mark consisting of three stripes attached to the side of a shoe can be established by evidence concerning the use of different stripes, regardless of whether they are subject to separate registrations, taking account of their 'very close visual proximity'.

Cl. 25

Cl. 25

Marks with reputation – (iii) Taking unfair advantage of repute (free-riding)

General Court, Case T-629/16, paras 191-192 (Three stripes)

The risk of free-riding may be supported by evidence of actual commercial use of the sign applied for, including in respect of the combination of colours used for the marketing of the earlier mark's products. Thus, the use of the slogan 'Two stripes are enough' reinforces the conclusion that the use of a mark consisting of two stripes takes advantage of the repute of a trade mark of three stripes

Marks with reputation – (iv) Detriment caused to the repute of the earlier mark (tarnishment)

CJEU, Case C-505/17 P, para 87-88 (So'Bio etic/So… ?)

The risk of tarnishment requires that the goods or services for which the earlier mark has acquired reputation and those covered by the mark applied for are such that an association between them would have negative connotations for the earlier mark's goods or services

Cl 3: bleaching and cleaning products

SO…?

Cl 3: cosmetics (reputation)

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Community Designs

C-683/17, 12.9.2019 – Cofemel

C-683/17, 12.9.2019 – Cofemel

Are designs, in general, capable of being classified as copyrightable works?

- Design and copyright protection are not mutually exclusive (37-43)
- Principle of cumulation (44-47)

→ Designs are capable to be classified as works

C-683/17, 12.9.2019 – Cofemel

- Aesthetic effect does not, in itself, permit a subject matter to be characterised as existing and identifiable with sufficient precision and objectivity (53)
- Aesthetic effect does not, in itself, make it possible to determine whether that design constitutes an intellectual creation reflecting the freedom of choice and personality of its author (54)

CJUE, C-833/18, Brompton, 11.06.2020

(22)Copyright protection requires two things: (i) an original subject matter which is the author's own intellectual creation *[subjective: personal imprint of the author]* and (ii) which consists of the expression of that creation *[objective: the personal imprint is made perceptible by others by a specific form or shape or structure]*

(24) where the realisation of a subject matter has been dictated by technical considerations, rules or other constraints which have left **no room for creative freedom**, that subject matter cannot be regarded as possessing the originality required for it to constitute a work and, consequently, to be eligible for the protection conferred by copyright (CJUE, 12 Sept. 2019, *Cofemel*, C-683/17, § 31)

(26) a subject matter satisfying the condition of originality may be eligible for copyright protection, **even if its realisation has been dictated by technical considerations**, provided that its being so dictated has not prevented the author from **reflecting his personality** in that subject matter, as an **expression of free and creative choices**

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