



EU GEORGIA INTELLECTUAL PROPERTY PROJECT

Compilation of CJ/GC case law

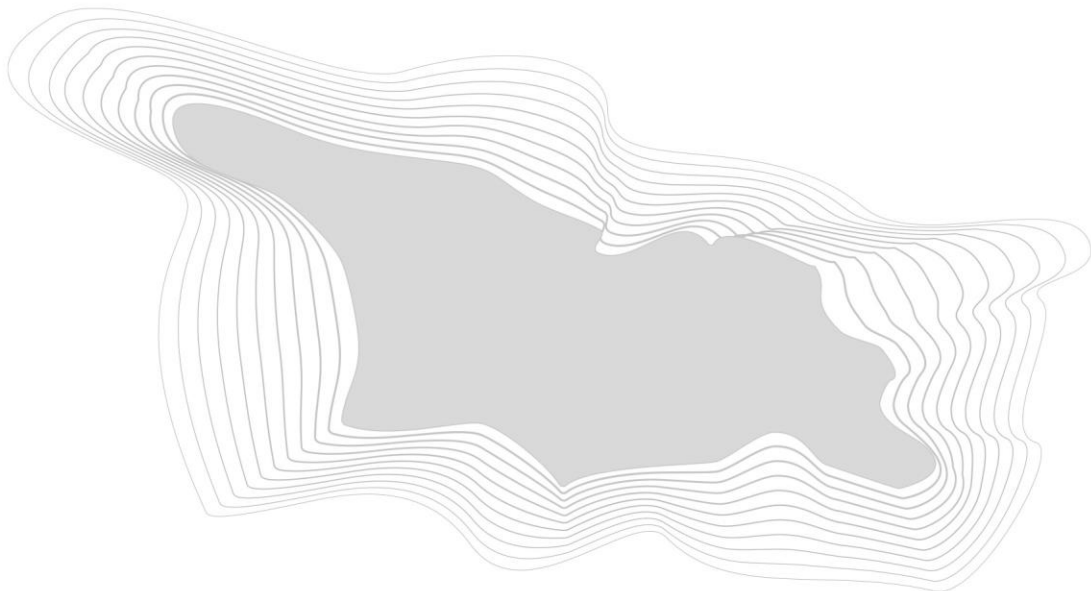


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CHAPTER I. PROCEDURAL MATTERS

PROCEEDINGS BEFORE THE COURT OF JUSTICE

Admissibility

Appeal allowed / not allowed to proceed – Article 58(a)(3) Statute – Article 170(a)(1) RPCJ [applicable as from 1 May 2019]

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

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

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

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

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

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

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

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

Interest in bringing an appeal – Appeal against GC judgment dismissing action brought against revocation decision

An appellant's interest in bringing appeal proceedings presupposes that the appeal must be likely, if successful, to procure an advantage for it (§ 16). The BoA decision, which was subsequently revoked by the contested decision, was favourable to the appellant [proprietor] insofar as the appeal lodged by the invalidity applicant against the CD's decision, which was partially favourable in itself to the proprietor, was rejected. If the present appeal were allowed and the judgment under appeal annulled, the BoA's decision would remain in force, so that the appeal would procure an advantage to the appellant [proprietor], since the latter would continue to benefit from the protection for the word mark Repower for certain goods and services (§ 17-18). This cannot be called into question by the argument that this advantage would only be temporary, because the GC implicitly stated in the judgment under appeal that it would have to annul the BoA's decision which contains an inadequate statement of reasons (§ 19).

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

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

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

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

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

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

Review of the decision of the GC

Distinction between points of law and matters of fact – Distortion of certain facts

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

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

Distortion of certain facts – No impact on the result

The CJ reveals numerous flaws in the GC's judgment: some of the facts were distorted by the GC in the judgment (§ 51-56); the GC did not justify its finding that the contested mark is similar to the sign used by the invalidity applicant and that it could be confused with it (§ 59); the GC was wrong to find that the proprietor intended to exploit the economic potential that could be mined from the name of the invalidity applicant's sign, because it is based on an unsubstantiated assertion that the signs in question are similar (§ 66).

However, despite those flaws, the CJ upholds the GC's judgment, holding that the GC had highlighted certain objective circumstances and, solely on the basis of these circumstances, it was entitled to find that the proprietor had acted in bad faith (§ 67-68).

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

Scope of the GC's duty to state reasons – Article 36 Statute – Article 53 Statute

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

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

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

PROCEEDINGS BEFORE THE GENERAL COURT

Admissibility

Representation by a lawyer who is not an independent third party

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

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

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

Time limit (e-Curia) – Article 56(a)(4) RPGC

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

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

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

Time limit – Electronic communications – Notification by eComm – *Dies a quo*

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

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

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

Admissibility of the heads of claim – No claim to issue directions to the EUIPO

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

25/06/2019, T-82/19, [EAGLESTONE \(fig.\)](#), EU:T:2019:484, § 16-18.
11/07/2007, T-443/05, [Pirañam](#), EU:T:2007:219, § 20 and case law cited.

Formal requirement of the application – General references

According to Article 21 Statute and Article 171 and Article 177(1) RPGC, any application must indicate the subject matter of the proceedings and a summary of the pleas in law relied on. The basic matters of fact and law relied on must be indicated, at least in summary form, coherently and intelligibly in the application. The summary and the pleas of law must be sufficiently clear and precise to enable the defendant to prepare its defence and the competent court to rule on the action. Although the body of the application may be supported and supplemented in relation to specific points by references to extracts from documents annexed to it, general references to other written submissions are inadmissible, even if these submissions are annexed, to the extent that they cannot be linked to the pleas and arguments put forward in the application itself (§ 11, 12).

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

Unforeseen documents in the RPGC – Request to lodge a reply

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

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

Subject matter of the proceedings before the GC

Scope of the GC's review (Principle) – Subject matter of the proceedings

The Court's task is to review the legality of the BoA's decision. The review must be carried out in the light of the factual and legal context of the dispute as it was brought before the BoA. It follows that a party cannot, by withdrawing its claims in part, alter the matters of fact and law on the basis of which the legality of the BoA's decision is examined (§ 16).

05/03/2003, T-194/01, [Soap device](#), EU:T:2003:53, § 16.

Scope of the GC's review – No alteration of the subject matter of the proceedings – Admissible plea

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

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

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

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

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

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

Inadmissible new evidence – General principle

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

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

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

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

Admissible new evidence – Evidence to refute new arguments in the contested decision – Extracts from the Office's database

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

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

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

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

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

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

Evidence relating to the Office's decision-making practice

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

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

Evidence to establish the accuracy of well-known facts

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

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

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

Pleas raised for the first time during the hearing (Principle) – Article 84(1) RPGC, Article 191 RPGC

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

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

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

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

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

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

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

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

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

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

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

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

Request for the limitation of goods and services – General conditions

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

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

Inadmissible limitation of goods and services at the oral hearing

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

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

Power of alteration – Alteration of the contested decision

The power of the Court to alter decisions pursuant to Article 72(3) EUTMR does not have the effect of conferring on that Court the power to carry out an assessment on which the BoA has not yet adopted a position. Exercise of the power to alter decisions must therefore, in principle, be limited to situations in which the Court, after reviewing the assessment made by the BoA, is in a position to determine, on the basis of the matters of fact and of law as established, what decision the BoA was required to take (16/05/2017, T-107/16, AIR HOLE FACE MASKS YOU IDIOT, EU:T:2017:335, § 45 and the case-law cited) (§ 139).

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

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

PROCEEDINGS BEFORE THE BOARDS OF APPEAL

Admissibility of the appeal

Appeal deemed not to be filed – Failure to comply with the obligation to pay the appeal fee within the prescribed period

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

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

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

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

Interest in bringing an appeal – Article 59 CTMR [now Article 67 EUTMR]

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

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

Notification of decisions – Notification by email – Notification by registered post with advice of delivery – Burden of proof

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

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

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

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

Restitutio in integrum – Representative’s duty of care – Article 67 CDR

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

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

Restitutio in integrum – Representative’s duty of care – Lawyer’s sworn declaration as evidence – Specific sudden illness – Article 97(1)(f) EUTMR

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

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

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

16/12/2020, T-3/20, [Canoleum / Marmoleum](#), EU:T:2020:606, § 51-52, 56-59.

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

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

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

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

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

Suspension of the proceedings – BoA’s broad discretion – Restricted judicial review

The right to be heard is not infringed by not giving the party that requests a stay of the opposition the opportunity to reply to the observations on that request, since there is no provision that lays down this possibility (§ 55). Pursuant to Rule 20(7)(c) and Rule 50(1) CTMIR [now Article 71(1) EUTMDR] and also case-law, the BoA has a broad discretion as to whether or not to suspend proceedings (§ 57-58). Any judicial review on its merits is restricted to ascertaining that no manifest error of assessment or misuse of powers has occurred (§ 59).

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

Essential procedural requirements

Functional continuity between the first instance and the BoA – Scope of the appeal

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

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

Right to be heard

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

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

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

Right to be heard – Scope of the principle – Well-known fact

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

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

Duty to state reasons – Article 94(1) EUTMR

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

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

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

The purpose of the obligation to state reasons is twofold: to enable the parties concerned to ascertain the reasons for the measure in order to defend their rights, and to enable the competent European court to exercise its power of review of the legality of the decision. However, in stating the reasons for their decisions, the BoA are not obliged to take a view on every argument that the parties have submitted to them. It is sufficient that they set out the facts and legal considerations having a decisive importance in the context of the decision (§ 41).

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

Duty to state reasons – Matter of public policy – *Ex officio* examination

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

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

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

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

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

In examining absolute grounds for refusal, the competent authority may use only general reasoning for all the goods or services concerned when the same ground for refusal is given for a category or group of goods and services, provided that these are interlinked in a sufficiently direct and specific way that they form a sufficiently homogeneous category or group of goods or services (§ 48-49).

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

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

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

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

Sufficiently substantiated argumentation for lack of a sufficiently direct and specific link

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

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

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

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

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

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

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

The BoA does not have to explicitly set out the reasons why it intends to depart from previous decisions that were not relied on by a party before it. Moreover, the duty to state reasons in respect of previous apparently diverging decisions is 'less stringent where the examination depends exclusively on the mark applied for than on factual findings which are independent of this mark' (§ 36-38, 48).

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

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

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

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

Decisions of national authorities – Identical marks

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

24/01/2019, T-785/17, [BIG SAM SPORTSWEAR COMPANY \(fig.\) / SAM et al.](#), EU:T:2019:29, § 83-84.

19/12/2019, T-624/18, [GRES ARAGÓN \(fig.\)](#), EU:T:2019:868, § 28-29.

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

As to the Office's practice in similar cases, although the Office is required to exercise its powers in accordance with the general principles of EU law and must take into account the decisions already taken on similar applications, the application of those principles must be reconciled with respect for the principle of legality (§ 39-43). Previous decisions at national level are irrelevant, since the EU trade mark regime is an autonomous system (§ 46).

10/10/2019, T-832/17, [achtung! \(fig.\)](#), EU:T:2019:2, § 67-69.
03/09/2020, C-214/19 P, [achtung ! \(fig.\)](#), EU:C:2020:632, § 45.
14/02/2019, T-123/18, [DARSTELLUNG EINES HERZENS \(fig.\)](#), EU:T:2019:95, § 37.
11/04/2019, T-226/17, [Rustproof System ADAPTA](#), EU:T:2019:246, § 59.
08/05/2019, T-469/18, [HEATCOAT](#), EU:T:2019:302, § 46-53.

Assessment of evidence – Evidence found by the BoA on its own motion – Article 95(1) EUTMR – Absolute grounds of refusal – Internet researches

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

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

Assessment of evidence – Discretionary power and belated evidence – Article 95(2) EUTMR – Proof of use – Discretionary power

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

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

Assessment of evidence – Invalidation proceedings – Absolute grounds for refusal – Discretionary power

Evidence submitted in due time for the first time before the BoA in invalidity proceedings, that is either evidence supplementary to that submitted in the proceedings before the CD or evidence on a new matter that could not be raised during those proceedings, is not automatically admissible. It is for the party presenting that evidence to justify why that evidence has been submitted at that stage of the proceedings and demonstrate that submission during the proceedings before the CD was impossible. Accordingly, it is for the BoA to assess the merits of the reasons put forward by the party that has submitted that evidence in order to exercise its discretion as to whether or not it should be taken into account (§ 44).

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

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

PROCEEDINGS IN FIRST INSTANCE

Ex parte proceedings

Competences of the Examiner

The Office is required to examine of its own motion the relevant facts which may lead it to apply an absolute ground for refusal (22/06/2006, C-25/05 P, Bonbonverpackung, EU:C:2006:422, § 50; 15/03/2006, T-129/04, Plastikflaschenform, EU:T:2006:84, § 16; and 12/04/2011, T 310/09 & T 383/09, Behavioural index / Behavioural indexing, EU:T:2011:157, § 29) (§ 26).

13/09/2013, T-320/10, [Castel](#), EU:T:2013:424, § 26.

Inter partes proceedings

❖ Opposition proceedings

Clear identification of the earlier mark

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

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

Substantiation – Extracts from official Databases

[The Office accepts, as evidence for both national marks and international registrations, extracts obtained through the Office's TMview portal (<https://www.tmdn.org/tmview/welcome>).]

Extracts generated through TMview reflect the information obtained directly from the competent registration authorities and therefore, qualify as documents equivalent to registration certificates from the competent registration authorities within the meaning of Article 7(2)(a) EUTMDR (by analogy, 06/12/2018, T-848/16, V (fig.) / V (fig.) et al., EU:T:2018:884, § 59-61 and 70).

T-848/16, [V \(fig.\) / V \(fig.\) et al.](#), EU:T:2018:884, § 59-61.

Substantiation – Evidence of renewal

When an earlier right on which the opposition is based reaches the end of protection after expiry of the time limit set by the Office to substantiate the opposition, the opposition is not automatically rejected in the absence of further communications or proof from the opponent. Rather a communication is issued to the opponent in which it is invited to submit evidence of renewal, which is then communicated to the applicant.

05/05/2015, T-715/13, [Castello \(fig.\) / Castelló y Juan S.A. \(fig.\) et al.](#), EU:T:2015:256, § 68 et seq.

Entitlement to file an opposition – Article 46(1) EUTMR – Licensee

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

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

Validity of the earlier right – Presumption of validity of earlier trade mark

In order to avoid infringing Article 8(1)(b) CTMR [now Article 8(1)(b) EUTMR], it is necessary to acknowledge a certain degree of distinctiveness of an earlier national mark on which an opposition against the registration of a trade mark is based (§ 47).

24/05/2012, C-196/11 P, [F1-Live](#), EU:C:2012:314, § 47, 51.

13/06/2019, T-398/18, [DERMAEPIL SUGAR EPIL SYSTEM \(fig.\) / dermépil Perron Rigot \(fig.\)](#), EU:T:2019:415, § 139-142.

Formal admissibility of an opposition based under Article 8(4) EUTMR

The fact that the applicant incorrectly checked the box entitled 'EM' did not render entirely inadmissible its opposition based on Article 8(4) CTMR [now EUTMR]. The information provided in the notice of opposition and in the attached letter made it possible to understand the nature and representation of the other earlier signs at issue, and what right those signs were supposed to confer on the applicant in the United Kingdom and in Ireland under the rules on passing off.

03/04/2014, T-356/12, [Sô:Unic](#), EU:T:2014:178, § 47.

Principles of res judicata and ne bis in idem

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

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

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

❖ Invalidation proceedings

Competences of the Cancellation Division in proceedings concerning absolute grounds of refusal

In invalidation proceedings, the Office cannot be required to carry out afresh the examination which the Examiner conducted, of his own motion, of the relevant facts which could have led him to apply the absolute grounds for refusal. It follows from the provisions of Articles 52 and 55 CTMR that the CTMR is regarded as valid until it has been declared invalid by the Office following invalidation proceedings. It therefore enjoys a presumption of validity, which is the logical consequence of the check carried out by the Office in the examination of an application for registration.

It follows from the foregoing that, in the invalidation proceedings, the BoA was not required to examine of its own motion the relevant facts which might have led it to apply the absolute ground for refusal set out in Article 7(1)(d) CTMR [now EUTMR].

13/09/2013, T-320/10, [Castel](#), EU:T:2013:424, § 27, 29.

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

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

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

Revocation Proceedings – Burden of proof – Obligation of the proprietor to submit proof of use

The absence of specific provision regarding the burden of proof in Article 51(1) CTMR can be explained easily given that the purpose of Article 51(1) CTMR, entitled ‘Grounds for revocation’, is to set out the grounds for revocation of the mark, which does not require specific provision to be made regarding the issue of the burden of proof.

Thus, it may be inferred from a combined reading of Articles 15, 42(2), 51(1) and 57(2) CTMR that, in proceedings for revocation of a mark, it is for the proprietor of the mark, and not the Office of its own motion, to establish genuine use of that mark.

26/09/2013, C-610/11 P, [Centrotherm](#), EU:C:2013:912, § 56, 62.

CHAPTER II. TRADE MARKS

ABSOLUTE GROUNDS (ARTICLE 7 EUTMR) – INVALIDITY (ARTICLE 59 EUTMR)

Article 7(1)(a) / 59(1)(a) EUTMR – EUTM Definition

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

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



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

Article 7(1)(a) / 59(1)(a) EUTMR – Sign of which an EUTM may consist – Colour as a trade mark

Combination of two colours per se – No systematic arrangement associating the colours in a predetermined and uniform way (CTMR)

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

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



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

Article 7(1)(b) / 59(1)(a) EUTMR – Non-distinctive sign

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

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

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

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

Non-distinctive – Mere laudatory message

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

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

Non-distinctive – Assessment of distinctive character – Shape marks

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

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

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

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



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

Non-distinctive (position marks)

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



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

Non-distinctive – Assessment of distinctive character – Consideration of all likely types of use of the sign

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

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



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

Non-distinctive – Assessment of distinctive character

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



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

Not distinctive – Slogan – Mere promotional and laudatory message – Figurative mark used as logo attached to textiles – Irrelevance of the particular use of the sign

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

The fact that the contested trade mark is affixed to the goods as a logo or in accordance with the identification practices of the clothing sector does not invalidate this finding (§ 88). The mark must be assessed as it was filed, not as it is used (§ 90). The applicant filed the mark applied for without adding a description to restrict the scope of protection to a logo or a label and without specifying where the mark might be positioned on its products. It is therefore not possible to assess the distinctive character of the contested trade mark in relation to a particular use (in this sense 03/12/2019, T-658/18, [DEVICE OF A CHECKERED GINGHAM PATTERN \(fig.\)](#), EU:T:2019:830, § 36) (§ 90).



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

Non-distinctive – Expression with an immediately comprehensible meaning

The figurative mark 'Simply. Connected.' is not understood as two separate and independent words but as an expression with an immediately comprehensible meaning (§ 62). In view of the obvious meaning, the typographical features, such as the fact that the words stand above and below one another, and the presence of upper-case letters and a full stop, are not pertinent (§ 63).

The global assessment confirms the dominant position of the verbal elements compared to the figurative elements that are devoid of distinctive character (§ 99-100).



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

Trade mark type determines assessment criteria of the sign's distinctive character

The distinctiveness of a sign has to be examined in the light of the type chosen by the applicant, without any possibility of the Boards of Appeal re-categorizing the mark. The trade mark type perceived by the public cannot be taken into account in such assessment; otherwise, the applicant's obligation to indicate the type of mark for which registration is sought and the impossibility pursuant to Article 49(2) EUTMR of subsequently amending it would be deprived of any practical effect.

25/10/2018, C-433/17P, [GREEN STRIPES ON A PIN \(col.\)](#), EU:C:2018:860, § 25-2.

Distinctiveness of colours – Public interest in not unduly restricting the availability of colours

The fact that the number of colours actually available is limited means that a small number of trade mark registrations for certain goods or services could exhaust the entire range of the colours available. Such an extensive monopoly would be incompatible with a system of undistorted competition, in particular because it could have the effect of creating an unjustified competitive advantage for a single trader. It must therefore be acknowledged that there is, in trade mark law, a public interest in not unduly restricting the availability of colours for the other operators who offer for sale goods or services of the same type as those in respect of which registration is sought.

06/05/2003, C-104/01, [Libertel](#), EU:C:2003:244, § 54-55.

Capacity of colours for communicating specific information

Whilst colours are capable of conveying certain associations of ideas, and of arousing feelings, they possess little inherent capacity for communicating specific information, especially since they are commonly and widely used, because of their appeal, in order to advertise and market goods or services, without any specific message.

06/05/2003, C-104/01, [Libertel](#), EU:C:2003:244, § 40.

24/06/2004, C-49/02, [Blau/Gelb](#), EU:C:2004:384, § 38.

28/01/2015, T-655/13, [Grün](#), EU:T:2015:49, § 24.

Inherent and acquired distinctive character of colours

Save in exceptional cases, colours do not initially have a distinctive character, and particularly where the number of goods or services for which the mark is claimed is very restricted and the relevant market very specific. However, even if a colour does not initially have any distinctive character, it may acquire such character in relation to the goods or services claimed following the use made of it. That distinctive character may be acquired, inter alia, after the normal process of familiarising the relevant public has taken place. In such cases, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking, and thus to distinguish that product from goods of other undertakings.

06/05/2003, C-104/01, [Libertel](#), EU:C:2003:244, § 65-66.

28/01/2015, T-655/13, [Grün](#), EU:T:2015:49, § 26.

Assessment criteria of colour marks for services

It should be noted that, according to the case-law, it is not appropriate to apply different criteria to the assessment of the distinctive character of a colour mark designating services than those applicable to colour marks designating goods.

12/11/2010, T-404/09 & T-405/09, [Grau/Rot](#) EU:T:2010:466, § 22.

Single colour and colour combinations may constitute a sign – Distinctive character of single colour and colour combinations

A single colour or a combination of colours cannot be presumed to constitute a sign. Normally a colour is a simple property of things. Yet it may constitute a sign. That depends on the context in which the colour is used. None the less, a single colour is capable, in relation to a product or service, of constituting a sign.

In order to determine whether single colour or combinations of colours are capable of distinguishing the goods of one undertaking from those of other undertakings within the meaning of Article 7 EUTMR, it must be determined whether or not those single colours or combinations of colours are capable to convey precise information, particularly as regards the origin of a product or service.

06/05/2003, C-104/01, [Libertel](#), EU:C:2003:244, § 27, 39.

24/06/2004, C-49/02, [Heidelberger Bauchemie](#), EU:C:2004:384, § 23, 37.

Same criteria applicable to trade marks consisting of a single colour and combination of colours

As a preliminary remark, it is convenient to establish that there is no need to distinguish between trade marks consisting of a single colour and those consisting of combinations of colours when taking into account the need not to unduly restrict the availability of colours for competing operators.

12/11/2010, T-404/09 & T-405/09, [Grau/Rot](#) EU:T:2010:466, § 25.

24/06/2004, C-49/02, [Heidelberger Bauchemie](#), EU:C:2004:384, § 42.

06/05/2003, C-104/01, [Libertel](#), ECLI:EU:C:2003:244, § 60.

Slogans

The Court of Justice has ruled that it is inappropriate to apply to slogans stricter criteria than those applicable to other types of signs when assessing their distinctive character

Even though no special criteria for registration apply to slogans, the relevant public's perception is not necessarily the same in relation to all types of signs and it is correct to take that into account when assessing distinctiveness.

The Court of Justice has provided the **following criteria** that should be used when assessing the distinctive character of a slogan (21/01/2010, C-398/08 P, *Vorsprung durch Technik*, EU:C:2010:29, § 47; 13/04/2011, T-523/09, *Wir machen das Besondere einfach*, EU:T:2011:175, § 37).

An advertising slogan is likely to be distinctive whenever it is seen as more than a mere advertising message extolling the qualities of the goods or services in question because it:

- constitutes a play on words, and/or
- introduces elements of conceptual intrigue or surprise, so that it may be perceived as imaginative, surprising or unexpected, and/or
- has some particular originality or resonance, and/or
- triggers in the minds of the relevant public a cognitive process or requires an interpretative effort.

In addition to the above, the following characteristics of a slogan may contribute towards a finding of distinctiveness:

- unusual syntactic structures;
- the use of linguistic and stylistic devices, such as alliteration, metaphors, rhyme, paradox, etc.

12/07/2012, C-311/11 P, [Wir machen das Besondere einfach](#), EU:C:2012:460
 21/01/2010, C-398/08 P, [Vorsprung durch Technik](#), EU:C:2010:29, § 47;

Laudatory nature of a promotional formula – No lack of distinctiveness

The mere fact that a mark is perceived by the relevant public as a promotional formula, and that, because of its laudatory nature, it could in principle be used by other undertakings, is not sufficient, in itself, to support the conclusion that that mark is devoid of distinctive character.

An advertising slogan cannot be required to display ‘imaginativeness’ or even ‘conceptual tension which would create surprise and so make a striking impression’. However, the existence of such features is an indication that the mark may be distinctive as “the presence of those characteristics is likely to endow that mark with distinctive character.

21/01/2010, C-398/08 P, [Vorsprung durch Technik](#), EU:C:2010:29, § 44-47.

Article 7(1)(c) / 59(1)(a) EUTMR – Descriptive sign

Relevant public

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

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

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

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

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

Elementary English is widely understood in The European Union

It is therefore necessary to have regard in particular to English-speaking consumers and professionals and consumers and professionals with an elementary knowledge of English, who, in any event, represent a very large proportion of European consumers and professionals (see, to that effect, 25/11/2008, T-325/07, *Surfcard*, EU:T:2008:525, § 6).

26/09/2012, T-301/09, [Citigate](#), EU:T:2012:473, § 41

Descriptive – Actual or potential characteristic of the goods

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

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

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

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

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

The finding of the descriptive character of a mark applies not only to the goods for which it is directly descriptive but also, in the absence of a suitable restriction of the trade mark by the applicant, to the general category of goods to which they belong (§ 50).

Therefore, the descriptive character is not only applicable to surgical instruments and apparatus, but also to surgical, medical, dental and veterinary apparatus and instruments (§ 52).

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

Descriptive

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

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

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

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



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

Not descriptive – Absence of ‘intrinsic’ characteristic that is ‘inherent to the nature’ of the goods

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

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

Not descriptive – Absence of ‘intrinsic’ characteristic that is ‘inherent to the nature’ of the goods

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



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

Evidence for descriptive character must relate to the trade mark’s filing date – Invalidation proceedings

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

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

Article 7(1)(d) / 59(1)(a) EUTMR – Customary sign

Article 7(1)(e) / 59(1)(a) EUTMR – Shape

Application *ratione temporis*

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

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

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

General remarks

The objective pursued by Article 7(1)(e) EUTMR is the same for all of its three grounds, namely to prevent the exclusive and permanent rights that a trade mark confers from serving to extend the life of other IP rights indefinitely, such as patents or designs, which the EU legislature has sought to make subject to limited periods

18/09/2014, C-205/13, [Hauck](#), EU:C:2014:2233, § 19-20

14/09/2010, C-48/09 P, [Lego brick](#), EU:C:2010:516, § 43;

06/10/2011, T-508/08, [Loudspeaker](#), EU:T:2011:575, § 65).

Shape commonly used by most of the producers

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



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

Essential characteristics- Article 7(1)(e) EUTMR

A sign consists ‘exclusively’ of the shape of goods or other characteristics when all its essential characteristics—that is to say, its most important elements—result from the nature of the goods (Article 7(1)(e)(i) EUTMR), perform a technical function (Article 7(1)(e)(ii) EUTMR) or give substantial value to the goods (Article 7(1)(e)(iii) EUTMR). The presence of one or more minor arbitrary elements, therefore, will not alter the conclusion

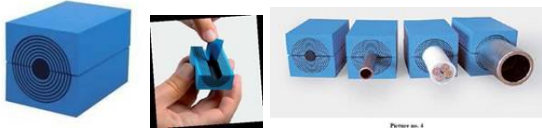
18/09/2014, C-205/13, [Hauck](#), EU:C:2014:2233, § 21-22;

14/09/2010, C-48/09 P, [Lego brick](#), EU:C:2010:516, § 51-52.

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

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

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



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

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

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

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



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

❖ Preliminary ruling – Article 3(1)(e)(ii) of Directive 2008/95

Essential characteristics – Technical result

Article 3(1)(e)(ii) of Directive 2008/95 may be applied when the graphic representation of the shape of the product allows only part of the shape to be seen, provided that the visible part of the shape is necessary to obtain the technical result sought by that product, even if it is not sufficient, on its own, to obtain that result.

Therefore, that ground for refusal is applicable to a sign consisting of the shape of the product concerned which does not show all the essential characteristics required to obtain the technical result sought, provided that at least one of the essential characteristics required to obtain that technical result is visible in the graphic representation of the shape of that product.

Essential characteristics – Functionality and the public’s knowledge

Article 3(1)(e)(ii) of Directive 2008/95/EC must be interpreted as meaning that, in order to establish whether a sign consists exclusively of the shape of goods which is necessary to obtain a technical result, the assessment does not have to be limited to the graphic representation of that sign (§ 37).

The first step of the analysis is to identify the essential characteristics of the sign. For that step, information other than that relating to the graphic representation alone, such as the relevant public's perception, may be used (§ 29-31, 37). The second step of the analysis is to establish if the essential characteristics perform a technical result. For that step, information which is not apparent from the graphic representation of the sign must originate from objective and reliable sources and may not include the relevant public's perception (§ 32-36, 37).

Shape giving substantial value to the goods – The relevant public's perception or knowledge – Decision on purchase

Article 3(1)(e)(iii) of Directive 2008/95 must be interpreted as meaning that the relevant public's perception or knowledge of the product represented graphically by a sign that consists exclusively of the shape of that product may be taken into consideration in order to identify an essential characteristic of that shape.

The ground for refusal may be applied if it is apparent from objective and reliable evidence that the consumer's decision to purchase the product in question is to a large extent determined by that characteristic (§ 39-46, 47).

Shape giving substantial value to the goods – Cumulative protection – Designs – Decorative items

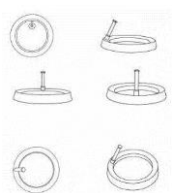
Article 3(1)(e)(iii) of Directive 2008/95 must be interpreted as meaning that that ground for refusal must not be applied systematically to a sign which consists exclusively of the shape of the goods where that sign enjoys protection under the law relating to designs or where the sign consists exclusively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



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

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

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



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

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

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



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

Article 7(1)(f) / 59(1)(a) EUTMR – Public policy / Morality

General basic principles

The concepts of ‘public policy’ and ‘acceptable principles of morality’ must be interpreted not only with reference to the circumstances common to all Member States but by taking into account ‘the particular circumstances of **individual Member States** which are likely to influence the perception of the relevant public within those States’ (para. 34).

20/09/2011, T-232/10, [Coat of Arms of the Soviet Union](#), EU:T:2011:498,

The wording of Article 7(1)(f) EUTMR is very broad and allows a great deal of room for interpretation. A judicious application of this provision necessarily entails balancing the right of traders to freely employ words and images in the signs they wish to register as trade marks against the right of the public not to encounter disturbing, abusive, insulting and even threatening trade marks.

The **rationale** of Article 7(1)(f) EUTMR is not to identify and filter out signs whose use in commerce must at all costs be prevented, but to preclude trade marks from registration where granting a monopoly would contravene the state of law or would be perceived by the relevant public as going directly against the basic moral norms of society. In other words, the Office should not positively assist people who wish to further their business aims by means of trade marks that offend against certain basic values of civilised society

If the provision is interpreted too widely, so as, for example, to include anything which a section of the relevant public is likely to find offensive, there is a risk that commercial freedom of expression in relation to trade marks would be unduly curtailed. While it is true to say that a refusal to register does not amount to a gross intrusion on the right of freedom of expression, since traders can still use trade marks without registering them, it does represent a restriction on freedom of expression in the sense that businesses may be unwilling to invest in large-scale promotional campaigns for trade marks which do not enjoy protection through registration because the Office regards them as immoral or offensive in the eyes of the public.

(06/07/2006, R 495/2005-G, [SCREW YOU](#), § 13-15).

It is the trade mark itself, namely the sign in relation to the goods or services as they appear upon registration of the trade mark, which is to be assessed in order to determine whether it is contrary to public policy or accepted principles of morality (§ 27).

The absolute grounds for refusal set out in Article 7(1)(f) EUTMR refer to the intrinsic qualities of the trade mark applied for and not to circumstances relating to the conduct of the applicant for the trade mark (§ 28).

13/09/2005, T-140/02, [INTERTOPS](#), EU:T:2005:312, § 27 and 28.

15/03/2018, T-01/17, [La Mafia se sienta a la mesa](#), EU:T:2018:146, § 40.

It is not only signs with a 'negative' connotation that can be offensive. The banal use of some signs with a highly positive connotation can also be offensive, for example terms with a religious meaning.

17/09/2012, R 2613/2011-2, [ATATURK](#), § 31.

10/09/2015, R 510/2013-1, [REPRESENTATION OF A CROSS \(fig.\)](#), § 58.

Relevant public

According to the case-law, when assessing the applicability of Article 7(1)(f) EUTMR, it is the criteria of the reasonable consumer with an average threshold of sensitivity and tolerance that needs to be taken into account.

15/03/2018, T-01/17, [La Mafia se sienta a la mesa](#), EU:T:2018:146, § 26.

05/10/2011, T-526/09, [Paki](#), EU:T:2011:564, §12.

The relevant public cannot be limited, for the purpose of the examination of the ground for refusal under Article 7(1)(f) of Regulation No 207/2009, to the public to which the goods and services in respect of which registration is sought are directly addressed. Consideration must be given to the fact that the signs caught by that ground for refusal will shock not only the public to which the goods and services designated by the sign are addressed, but also other persons who, without being concerned by those goods and services, will encounter that sign incidentally in their day-to-day lives.

09/03/2012, T-417/10, [¡Que Buenu Ye! HIJOPUTA](#), EU:T:2012:120, § 14.

15/03/2018, T-01/17, [La Mafia se sienta a la mesa](#), EU:T:2018:146, § 27.

5/10/2011, T-526/09, [PAKI](#), EU:T:2011:564, § 18.

It must also be borne in mind that the relevant public within the European Union is, by definition, within a Member State and that the signs likely to be perceived as being contrary to public policy or to accepted principles of morality are not the same in all Member States, inter alia for linguistic, historic, social and cultural reasons.

20/09/2011, T-232/10, [Coat of arms of the Soviet Union](#), EU:T:2011:498, § 31-33.

15/03/2018, T-01/17, [La Mafia se sienta a la mesa](#), EU:T:2018:146, § 28-29.

Relevant territory

It follows that, in order to apply the absolute ground for refusal laid down in Article 7(1)(f) of Regulation No 207/2009, it is necessary to take account both of the circumstances common to all Member States of the European Union and of the particular circumstances of individual Member States which are likely to influence the perception of the relevant public within those States

15/03/2018, T-01/17, [La Mafia se sienta a la mesa](#), EU:T:2018:146, § 29.
20/09/2011, T-232/10, [Coat of arms of the Soviet Union](#), EU:T:2011:498, § 34.

Values of national laws in assessing the limits of morality and public policy

In assessing the existence of the absolute ground for refusal laid down in Article 7(1)(f) EUTMR, factors arising from national law, are not applicable by reason of their normative value and are not, therefore, rules by which EUIPO is bound. However, those factors are evidence of facts which make possible an assessment of how certain categories of signs are perceived by the relevant public in that Member State.

20/09/2011, T-232/10, [Coat of arms of the Soviet Union](#), EU:T:2011:498, § 58.

Object test and not with respect to the goods and services at stake

En principio, el contexto comercial de una marca no obsta a la aplicación del artículo 7, apartado 1, letra f), del Reglamento nº 207/2009 si se demuestra que dicha marca incluye un elemento que, de manera objetiva, observa que es contrario a la moral y a las buenas costumbres.

09/03/2012, T-417/10, [¡Que Buenu Ye! HIJOPUTA](#), EU:T:2012:120, § 24.

Definition of consumer

The assessment of the existence of the ground for refusal contained in Article 7 (1) (f) of Regulation No 207/2009 cannot be based on the perception of the part of the public that is not offended by anything, nor on that of one who is easily offended, but must be done on the basis of the criteria of a reasonable person with average thresholds of sensitivity and tolerance

09/03/2012, T-417/10, [¡Que Buenu Ye! HIJOPUTA](#), EU:T:2012:120, § 21.

No harm for free speech

On the other hand, as regards the reference made by the applicant to the right to freedom of expression recognized to everyone by Article 10 of the Convention for the Protection of Human Rights and Fundamental Freedoms when stating that OHIM limited their freedom of expression by refusing to register the requested trademark, it should be noted that this refusal does not affect the possibility that the applicant has to market his products as represented in paragraph 2 (above), nor, therefore, the freedom of expression that has been claimed.

09/03/2012, T-417/10, [¡Que Buenu Ye! HIJOPUTA](#), EU:T:2012:120, § 26.

Contrary to public policy or principles of morality

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



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

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

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

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

Article 7(1)(g) / 59(1)(a) EUTMR – Deceptive sign

The test of deceptiveness – Actual deceit and sufficiently serious risk

The CJEU was referred the question of whether a mark can be considered deceptive, inter alia when a significant portion of the relevant public had wrongly believed that the mark indicated that the designer Elisabeth Emanuel was still involved in the design or creation of the goods, and, if yes, which other matters should be taken into account in the assessment (§ 13).

It stated that the circumstances for refusing registration (and mutatis mutandis for cases of invalidation as well) on the ground of deceptiveness ‘presuppose the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived’ (§ 47).

Finally, it also found that mark was not in itself deceptive since even though the average consumer might be influenced by imagining that the designer Elisabeth Emanuel was involved in the design of the garment, the quality and characteristics of the goods remained guaranteed by the trade mark holder (§ 48, 49).

30/03/2006, C-259/04, [Elizabeth Emanuel](#), EU:C:2006:215, § 13, 47-49.

The CJEU was referred inter alia the question of whether the mark, which had been used as quality label could be declared invalid as deceptive, if the proprietor fails to ensure that expectations in trade relating to the quality associated with the sign are being met by carrying out periodic quality controls at its licensees (§ 32).

In this case, the CJEU repeated approach adopted by the GC and the CJEU in previous cases (30/03/2006, C-259/04, Elizabeth Emanuel, EU:C:2006:215, § 47), stating again that the relevant criteria were the existence of actual deceit or a sufficiently serious risk that the consumer would be deceived (§ 54) and it was for the national court to decide if the mark was capable of deceiving the consumers based on those criteria (§56–57).



08/06/2017, C-689/15, [Gözze / VVB](#), EU:C:2017:434, § 32, 54, 56 and 57 / Also known as 'Cotton Flower'.

The GC confirmed the Boards' finding that the sign 'Caffé Nero' was deceptive for tea, cocoa, coffee substitutes, powdered chocolate as the consumers, when faced with the trade mark on similar packaging as coffee, were likely to believe that those goods were, or contained, black coffee, even if, in actual fact, this was not the case (§ 45).

Thus, especially when taking into consideration that such items were often bought in haste, it was likely that consumers would pick these items off the shelf with the erroneous belief that these items were made with coffee. As a result, the GC held that 'once the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived is established, it becomes irrelevant that the mark applied for might also be perceived in a way that is not misleading'. The GC concluded that if 'the mark is, on any view, of such a nature as to deceive the public, it becomes unable to fulfil its role, which is to guarantee the origin of the goods and services to which it refers' (§ 48).

27/10/2016, T-29/16, [CAFFÈ NERO](#), EU:T:2016:635, § 45 and 48.

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

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

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

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

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

Categories of deceptiveness – Quality and nature of the goods and services

The GC found the word sign 'Caffé Nero' to be deceptive for 'tea, cocoa, coffee substitutes, herb tea, tea beverages, cocoa and cocoa-based preparations, cocoa beverages, preparations and mixes for making the aforesaid goods, and powdered chocolate' in Class 30. None of these goods, as a matter of fact, contain coffee. However, the GC found that the consumers were nonetheless likely believe it to be the case when faced with the trade mark on similar packaging as coffee (§ 45).

The GC added that if the mark is, on any view [after a serious risk of deceit was established], of such a nature as to deceive the public, then it is therefore unable to fulfil its role, which is to guarantee the origin of the goods and services to which it refers (§ 48).

27/10/2016, T-29/16, [CAFFÈ NERO](#), EU:T:2016:635, § 45 and 48.

Categories of deceptiveness – Official approval

The registered collective trade mark in the name of the National Union for French Ski Instructors (SNMSF) was challenged in invalidity proceedings on, inter alia, the grounds of Article 7(1)(g) EUTMR (with regards to 'ski training services' in Class 41, on the basis that it would convey the message that the services were promoted/guaranteed somehow by the French State. The action was rejected by the Board.

The General Court confirmed the findings of the Board, and held that as the collective mark was filed by the syndicate of French Ski teachers, the figurative element (constituted by the colours of the French flag) was more likely to be understood by the public as referring to that, and not to a possible avail of the French government (§ 58) even though it also held that the combination of the colours red, white and blue with the word 'français' would be understood as a reference to France (§ 56). Moreover, the Court excluded that the public could think that the services were related to the French government, as those services were offered in a competitive market and a consumer with a high degree of attention would not be misled (§ 60).

Focusing then on the services, the Court pointed out that, as they were related to a risky sport and are rendered in a competitive environment, the consumers would not be deceived by the trade mark as they knew that all ski trainings offered in France – and not only those marketed with the trade mark – were subject to a common regulation made by the State. Last but not least, the fact that ski-a-la-français exists alone as a special technique of ski would contribute to avoid that the trade mark may deceive as regards the avail of the French government to a specific company/service (§ 60-63).



05/05/2011, T-41/10, [école du ski français](#) (fig.), EU:T:2011:200, § 56, 58, 60-63.

Categories of deceptiveness – Geographical origin

The CJEU stated in its preliminary ruling that deceptiveness cannot be automatically inferred whenever there is evocation of an earlier Geographical Indication, it has to be assessed instead by means of an autonomous examination dedicated specifically to this ground, taking into account all the relevant factors (§ 42).

In this specific case, the Court found that Cambozola, although evoking the PGI Gorgonzola, could not be considered automatically deceptive – because of that reason – and that for reaching that conclusion it was necessary to run a specific test, for which was competent the National Court (§ 43).

04/03/1999, C-87/97, [Cambozola](#), EU:C:1999:115, § 42 and 43.

The GC, applying Article 7(1)(g) in conjunction with Article 52(1)(a) EUTMR, confirmed that the word mark 'Port Charlotte' was not deceptive regarding the origin of the goods (whisky) as it did not designate a geographical region. Registration for the trade mark was originally sought for 'alcoholic beverages' but pursuant to the invalidity action, the list was limited to only 'whisky'.

The GC held that 'Port Charlotte' read as a whole and as a logical and conceptual unit, would be understood as a harbour named after a person, without any direct link to the PGO 'Porto' or port or to a port wine. This conclusion was further emphasised by the fact that Charlotte was the more distinctive element in the sign (§ 71).

Moreover, the GC added that while 'Port' was an integral part of the mark, the average consumer, even if he is of Portuguese origin or speaks Portuguese would not associate a whisky with a port wine covered by the PGO, emphasising the significant differences between port wine and whisky, in terms of, inter alia, ingredients, alcohol content and taste, of which the average consumer is well aware (§ 76).

The Court stated whenever '[the] public is not liable to associate the mere term 'port' in the contested mark with the designation of origin 'porto' or 'port' or with a liqueur wine bearing that name', then 'the relevant public will clearly be even less likely to be misled as to the nature, quality or geographical origin of a whisky marketed under that mark' (§ 87). As the public would not make such an association, it was even more unlikely that it could be misled as regards the quality, characteristics or geographical origin of a whisky marketed under that sign.

18/11/2015, T-659/14, [PORT CHARLOTTE](#), EU:T:2015:863, § 71, 76 and 87.

Appealed before CJEU, but the ground of deceptiveness was not examined – 14/09/2017, C-56/16 P, [PORT CHARLOTTE](#), EU:C:2017:693.

Article 7(1)(h) / 59(1)(a) EUTMR – Article 6ter Paris Convention

General principles

In principle, prohibition of the imitation of an emblem applies only to **imitations of it from a heraldic perspective**, that is to say, those that contain heraldic connotations that distinguish the emblem from other signs. Therefore, protection against any imitation from a heraldic point of view refers not to the image itself, but to its heraldic expression. Therefore, it is necessary to consider the **heraldic description** of the emblem at issue to determine whether the trade mark contains an imitation from a heraldic point of view,

It follows from the above that, in the course of trade mark examination, as a first step, both the protected 'emblem' and the sign applied for must be considered from a heraldic perspective.

Nonetheless, as far as 'imitation from a heraldic point of view' is concerned, a difference detected by a specialist in heraldic art between the trade mark applied for and the state emblem will not necessarily be perceived by the average consumer and, therefore, in spite of differences at the level of certain heraldic details, the contested trade mark may be an imitation of the emblem in question within the meaning of Article 6ter PC

16/07/2009, C-202/08 P & C-208/08 P, [RW feuille d'érable](#), EU:C:2009:477, § 48, 50

05/05/2011, T-41/10, [esf école du ski français](#) (fig.), EU:T:2011:200, § 25

25/05/2011, T-397/09, [Suscipere et finire](#), EU:T:2011:246, § 24-25).

To apply Article 7(1)(h) EUTMR, **it can therefore be sufficient that the average consumer, despite some differences in heraldic details, can see in the mark an imitation of the 'emblem'**. There may, for example, be imitation when the mark contains the main element of, or part of, the 'emblem' protected under Article 6ter PC. That element need not necessarily be identical to the emblem in question. The fact that the emblem in question is **stylised** or that only **part of the emblem** is used does not necessarily mean that there is no imitation from a heraldic point of view

(21/04/2004, T-127/02, [ECA](#), EU:T:2004:110, § 41

Article 7(1)(i) / 59(1)(a) EUTMR – Other emblems

Article 7(1)(j) / 59(1)(a) EUTMR – Geographical indications

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

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

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

Extent of protection of Geographical Indications

The General annulled the decision of the 4th Board which found that the word 'torta' merely indicated the round form of a cheese and not a geographical zone and consequently did not enjoyed the protection deriving from the Regulation 510/2006 (now Regulation 1151/2012).

The General Court held in essence that, according to Article 2(2) of the Regulation 510/2006 (now Regulation 1151/2012) a PDO may consist of a non- geographic traditional denomination which designates an agriculture product or foodstuff which complies with the conditions provided in § 1 of the same Article.

In essence, the General Court declared that the Office, when dealing with the registration of the EU trade marks, must examine whether the word 'Torta', as part of the PDO 'Torta del Casar', is a traditional term deserving protection.

Likewise, as a consequence of the above, the General Court makes clear that an evocation of the PDO 'Torta del Casar' may exists when reproducing the term 'Torta' in connection with cheese not certified as PDO 'Torta del Casar' As such, it is now clear that it may exist a PDO infringement when the term used is a traditional term part of the relevant PDO (such as 'Torta'), regardless of the fact that the geographical term of said PDO (in the case at hand, 'del Casar') is not used at all.

14/12/2017, T-828/16, [QUESO Y TORTA DE LA SERENA \(fig.\) / TORTA DEL CASAR et al](#), ECLI:EU:T:2017:918.

The General Court confirmed the decision of the Boards rejecting the EUTM application 'CUVÉE PALOMAR' for wines, as being in conflict with the registered Spanish GI 'Valencia' extended also to the locality 'El Palomar'. The General Court held that. Article 7(1)(j) EUTMR is applicable whenever a mark contains, or consists of, a geographical indication identifying a wine which does not originate from that area, irrespective of whether the mark constitutes a false or deceptive indication. This is also the case where the mark in question contains, or consists of, elements which enable the relevant geographical indication to be identified with certainty, without it being necessary to consider the definite (e.g. 'El') or indefinite articles which may form a part of them. To this effect, it is also irrelevant that a name which benefits from a registered designation of origin is unknown to the general public or the relevant class of persons. Furthermore, even if the trade mark applied for has several meanings or does not exactly match the expression 'El Palomar', this does not rule out the application of art. 7(1)(j) EUTMR. It would only be otherwise if the geographical indication consisted of a name of a place containing an article which is inseparable from that name and which gives that name its own autonomous meaning.

The Cuvée Palomar judgment affords a very broad protection to a GI which goes further than what is immediately identified by the protected name (Valencia), as it protects all the territory covered by the GI. The protection becomes even broader taking also into account the fact that the information regarding the extent of protection of the GI was not entirely available to the public.

11/05/2010, T-237/08, [Cuvée Palomar](#), EU:T:2010:185, § 111.

Direct or indirect commercial use

Scotch Whisky, a company marketing whisky produced in Germany under the designation 'Glen Buchenbach', infringed the GI 'Scotch Whisky', protecting Whisky. The German Court remitted the case to the Court of Justice of the EU, seeking clarification on the interpretation of the expressions 'indirect commercial use', 'evocation' and 'other misleading indication' as in Article 16(a), (b) and (c) Regulation 110/2008 (Spirit drinks Regulation).

The CJEU followed the opinion of the Advocate General and specified that there is 'indirect commercial use' of a registered geographical indication, when the disputed element is used in a form that is 'either identical to that indication or phonetically and/or visually similar to it' (§ 39). Accordingly, the Court considered it not sufficient that that element is liable to evoke in the relevant public some kind of association with the indication concerned or the related geographical area.

Furthermore, the Court has clarified that a distinction must be drawn between situations in which the use is 'direct' and those in which it is 'indirect'. "Unlike 'direct' use, which implies that the protected geographical indication is affixed directly to the product concerned or its packaging, 'indirect' use requires the indication to feature in supplementary marketing or information sources, such as an advertisement for that product or documents relating to it".

Additionally, the Court held that the scope of that provision must necessarily be distinguished from that of the other rules for the protection of registered geographical indications, which are set out in points (b) to (d) of Article 16. Point (a) must, in particular, be distinguished from the situation covered by point (b) of Article 16, which refers to 'any misuse, imitation or evocation', that is to say, situations in which the sign at issue does not use the geographical indication as such but suggests it in such a way that it causes the consumer to establish a sufficiently close connection between that sign and the registered geographical indication' (§ 33).

Finally, the Court clarified that Article 16 Regulation 110/2008 contains a graduated list of prohibited conduct in which point (c) is independent from the other provisions and must be distinguished from points (a) and (b) of Article 16 (§ 65).

07/06/2018, C-44/17, [Scotch Whisky Association](#), EU:C:2018:415, § 33, 39 and 65.

Comparable products

In **Cognac II**, the Court identified the following non-exclusive list of factors:

- whether the products have common objective characteristics, such as method of elaboration, physical appearance or use of the same material;
- which are the circumstances under which the products are consumed, from the point of view of the relevant public;
- whether they are frequently distributed through the same channels and
- whether they subject to similar marketing rules.

14/07/2011, C-4/2010, BNI [Cognac](#), :EU:C:2011:484 § 54.

Misuse, imitation or evocation

The term 'evocation' should be understood, as 'a situation where a term used to designate a product incorporates part of the protected designation, so that when the consumer is confronted with the name of the product, the image triggered in his mind is that of the product whose designation is protected' (§ 59). Evocation can be also characterised even in the absence of any likelihood of confusion. Moreover, in order to prove that a designation evokes a registered GI, the proximity of phonetic and visual similarities should be established (§ 27).

04/03/1999, C-87/97, [Gorgonzola](#), EU:C:1999:115, § 27, 59.

Article 13(1)(b) of Regulation No 510/2006 (now Regulation 1151/2012) does not limit the scope of that provision solely to the names of the products covered by those names. On the contrary, that provision requires protection against 'any' evocation, even if the protected name is accompanied by an expression such as 'style', 'type', 'method', 'as produced in' or 'imitation', on the packaging of the product concerned. According to the Court, it is important that the consumer has clear, succinct and credible information regarding the origin of the product. Said objective is further guaranteed if the registered name cannot be evoked through the use of figurative signs.

The decisive criterion to establish whether an element evokes a registered name is for the referring national court to assess specifically whether that element is capable of triggering directly in the consumer's mind the image of the product whose designation is protected, which cannot exclude the possibility that figurative signs may trigger directly in the consumer's mind the image of products whose name is registered on account of their 'conceptual proximity' to such a name.

As such, answering the preliminary question, the Court stated that Article 13(1)(b) of Regulation No 510/2006 (now Regulation 1151/2012) must be interpreted as meaning that a registered name may be evoked through the use of figurative signs.

02/05/2019, C-614/17, [Queso Manchego](#), EU:C:2019:344.

Article 16(b) Regulation No 110/2008 protects geographical indications from any 'evocation', 'even if the true origin of the product is indicated or the geographical indication is used in translation or accompanied by an expression such as "like", "type", "style", "made", "flavour" or any other similar term'.

The phonetic and visual similarity between the disputed designation and the PGI and the partial incorporation of a PGI in the disputed designation are not 'an essential condition' but just one factor to be taken into account (which seems to go further than the Parmigiano Reggiano case). Accordingly, it is possible that an 'evocation' may be found to exist even in the absence of such similarity.'

It is immaterial whether the disputed brand 'corresponds to the name of the undertaking and/or the place where the product is manufactured'.

The '*decisive criterion*' is whether the 'image triggered' in the consumer's mind, when he is confronted with the disputed designation, is that of the product whose GI is protected. In the absence of any phonetic and/or visual similarity and partial incorporation of a GI in the disputed designation, the 'conceptual proximity' between the designation and the geographical indication must be taken into account.

07/06/2018, C-44/17, [Scotch Whisky Association](#), EU:C:2018:415, § 56.

Regardless whether the name "Parmesan" is or is not the exact translation of the PDO "Parmigiano Reggiano", the **conceptual proximity** between these two terms emanating from different languages (.....) must also be taken into account'. That proximity and the phonetic and visual similarity should be such as to bring to the mind of the consumer that the term of the mark applied for brings in mind the term of the PDO or PGI.

It can, thus, be deduced from this Judgment that the concept of the 'conceptual proximity' may be applied mainly when the terms in conflict are emanating from different languages and the one is not the exact translation of the other.

26/02/2008, C-132/05, Commission / Germany (hereinafter [Parmigiano Reggiano](#)), EU:C:2008:117, § 48.

The concept of the 'conceptual proximity' was recalled in **Queso Manchego**, but in relation to figurative elements. The Court held that 'figurative signs may trigger directly in the consumer's mind the image of products whose name is registered, on account of their "conceptual proximity" to such a name' (§ 22). Thus, in **Queso Manchego** the concept of the 'conceptual proximity' was broader as it may be also applied to cases where the GI is invoked through the use of figurative signs.

The Court stated in various occasions that the concepts of misuse, imitation and evocation covered by letter b) are listed in a decreasing order, in terms of requirements. This means that there are more requirements in order to succeed in proving misuse, and, as a consequence and in comparison to misuse and imitation, there are fewer requirements for evocation.

Other relevant Judgments of the EU Judicature on the concept of 'evocation' that are worth to mention are the **Toscoro**, **Viiniverla** and **Cognac**.

02/05/2019, C-614/17, [Queso Manchego](#), EU:C:2019:344.
02/02/2017, T-510/15, [Toscoro](#), EU:T:2017:54.
21/01/2016, C-75/15, [Viiniverla](#), EU:C:2016:35.
14/07/2011, C-4/10 & C-27/10, [BNI Cognac](#), EU:C:2011:484.

The assessment of evocation is made taking the view of the European Union consumer (reasonably well informed and reasonably observant and circumspect). Such concept covers all the European consumers and not only the consumers of the Member State in which the product giving rise to the evocation is manufactured.

21/01/2016, C-75/15, [Viiniverla](#), EU:C:2016:35, § 28.
02/05/2019, C-614/17, [Queso Manchego](#), EU:C:2019:344, § 50.

Geographical Indications are independent from the trade marks' system, there can be an evocation without likelihood of confusion and there can also be evocation when the element of the GI that has been evoked does not indicate a geographical place.

04/03/1999, C-87/97, [Gorgonzola](#), EU:C:1999:115, § 26.
14/12/2017, T-828/16, [QUESO Y TORTA DE LA SERENA](#) (fig.) / TORTA DEL CASAR et al, ECLI:EU:T:2017:918, § 66.

An Italian company distributed in German territory a frozen product under the name 'Champagner Sorbet' that contained, among other ingredients, 12% of champagne. An association of Champagne producers brought proceedings against the company, claiming that the distribution of that product under that name constituted an infringement of the PDO 'Champagne'.

The Court found that incorporating in the name of the product the name of the ingredient protected by a PDO (Champagne) and openly claiming a (residual: 12%) gustatory quality connected constitutes direct use of the PDO and not an evocation, imitation or misuse (§ 57).

The Court underlined that 'the incorporation of the name of the PDO in its entirety in that of the foodstuff concerned to indicate the taste of the foodstuff does not, therefore, correspond to that situation [evocation]' (§ 58).

20/12/2017, C-393/16, [Champagner Sorbet](#), EU:C:2017:991.

Evocation is one of the factors PGIs/PGOs' provide protection against, as laid down in Article 103(2)(b) of [Regulation 1308/2013](#). Thus, it is often part of any assessment relating to PGIs/PGOs' independently of any assessment of deceptiveness. Evoking a GI is possible even where there is no likelihood of confusion

26/02/2008, C-132/05, [Commission v Germany](#), EU:C:2008:117, § 45.

The notions of misuse and imitation

The concept of 'misuse' must be interpreted as referring to 'inappropriate use' or use of the protected name in an inappropriate context which could, for instance, tarnish the repute of a quality product name.

30/11/2018, R 251/2016-1, [COLOMBIANO COFFEE HOUSE](#), § 134.

Any other false or misleading indication and any other practice liable to mislead the consumer

In **Scotch Whisky** the Court, first clarified that Article 16 Regulation 110/2008 contains a graduated list of prohibited conduct in which point (c) is independent from the other provisions and must be distinguished from points (a) and (b) of Article 16. Point (c) widens the scope of protection as it includes 'any other [...] indication' which, while not actually evoking the protected geographical indication, is 'false or misleading' as regards the links between the product concerned and that indication (§ 65).

Secondly, in light of the above, the Court held that the expression 'any other [...] indication' includes information that may be found in any form whatsoever on the description, presentation or labelling of the product concerned, including in the form of words, an image or a container capable of providing information on the provenance, origin, nature or essential qualities of that product.

Thirdly, in order to establish that this information is 'liable to convey a false impression as to [the product's] origin', it is sufficient that a false or misleading indication be included either on the description, presentation or labelling of the product concerned. As such, additional information relating, in particular, to the true origin of the product concerned is not permitted otherwise that provision would be deprived of practical effect.

Finally, the Court underlined that for the purpose of establishing that there is a 'false or misleading indication', 'account is not to be taken of the context in which the disputed element is used'.

07/06/2018, C-44/17, [Scotch Whisky Association](#), EU:C:2018:415, § 65.

As to the applicability of false or misleading indications that may convey a false impression to the geographical origin of the product, the CJEU stated that is possible under the above-mentioned provisions to prohibit both false and/or misleading indications regarding the PDO. This possibility relies, in particular, on the crucial element of taste.

If the foodstuff at issue in the present case did not have – as an essential characteristic – a taste attributable primarily to the presence of champagne in its composition – it would be possible to conclude that the foodstuff constituted a false or misleading indication within the meaning of Article 118m(2)(c) of Regulation 1234/2007 and 1308/2013. As such, the implication of the 'taste-element' supports the conclusion that a PDO is now also protected against false and/or misleading indications relating to the nature or essential qualities of the product.

20/12/2017, C-393/16, [Champagner Sorbet](#), EU:C:2017:991, § 62.

Exhaustive nature of EU GIs

In **Port Charlotte**, the Court confirmed the **Budějovický Budvar** case law according to which the system of protection for designations of origin that was provided for by Regulation No 510/2006 (now Regulation 1151/2012) was to be interpreted as being both uniform and exhaustive in nature. As a consequence of its exhaustive nature, an 'additional' protection to PDO and PGI by a national-law system, that is to say stronger protection or a higher level of protection than that arising out of the EU system is not allowed.

08/09/2009, C-478/07, [Budějovický Budvar](#), EU:C:2009:521.

14/09/2017, C-56/16 P, [PORT CHARLOTTE](#), EU:C:2017:693.

Reputation

In **Port Charlotte**, the CJEU provides guidance in situations which give rise to exploitation of the reputation regarding a protected designation of origin.

In that regard, the Court stated that designations of origin fall within the scope of industrial and commercial property rights. The applicable rules protect those entitled to use them against improper use of those designations by third parties seeking to profit from the reputation which they have acquired. Geographical indications may enjoy a high reputation amongst consumers and constitute for producers who fulfil the conditions for using them an essential means of attracting custom.

14/09/2017, C-56/16 P, [PORT CHARLOTTE](#), EU:C:2017:693.

The reputation of designations of origin depends on their image in the minds of consumers. That image in turn depends essentially on particular characteristics and more generally on the quality of the product. It is on the latter, ultimately, that the product's reputation is based. For consumers, the link between the reputation of the producers and the quality of the products also depends on their being assured that products sold under the designation of origin are authentic.

08/09/2009, C-478/07, [Budějovický Budvar](#), EU:C:2009:521, § 110.

14/09/2017, C-56/16 P, [PORT CHARLOTTE](#), EU:C:2017:693, § 81.

In **Champagner Sorbet**, a preliminary ruling, mentioned above, the CJEU stated that the use of a PDO as part of the name under which is sold a foodstuff that does not correspond to the product specifications for that PDO but contains an ingredient which does correspond to those specifications is intended to take unfair advantage of the reputation of the PDO if that ingredient does not confer on that foodstuff one of its essential characteristics (§ 50).

There is unfair advantage of the reputation of a GI' when the name of a foodstuff indicates and contains an ingredient protected by such GI, but the taste of the ingredient is not the main characteristic of the foodstuff. If the taste of the foodstuff instead is conditioned by other ingredients, then there would be no need to recall in the trade mark the ingredient protected autonomously through a GI. This balance of whether or not the ingredient is recognizable in the foodstuff as main characteristic is subject to an empiric examination that the Court said stays on the National Court (§ 52).

It is, therefore, necessary to undertake a qualitative assessment. As the Advocate General also noted, it is not a question of identifying in the foodstuff the essential characteristics of the ingredient protected by a PDO but of establishing that that foodstuff has an essential characteristic connected with that ingredient. That characteristic will often be the aroma or taste imparted by that ingredient.

Article 7(1)(k) / 59(1)(a) EUTMR – Traditional terms for wine

Article 7(1)(m) / 59(1)(a) EUTMR – Plant variety denominations

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

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

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

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

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

Article 59(1)(b) EUTMR – Absolute grounds for invalidity – Bad faith

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

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

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



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

Bad faith of a partner – Power of representation

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

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

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

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



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

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

Bad faith – Same overall impression of the signs

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

The contested mark coincides in the letters 'c' and 'm' with the initial letters of the terms of the earlier sign, in the preposition 'del', and also the typography is identical. The contested mark is the abbreviation of the earlier figurative sign and therefore the signs may produce the same overall impression (§ 49).

The bar 'Café del Mar' became well known over the course of the years and its activities expanded to include music products, clothing and merchandising bearing the figurative sign Café del Mar (§ 43, 50). It cannot be excluded that leather goods are sold within the framework of the sale of clothing and fashion accessories, and umbrellas and perfumes may be part of the merchandising goods of a cafeteria or may be offered as fashion accessories (§ 52).

Therefore, the contested mark is not completely different to the earlier figurative sign Café del Mar and is registered for goods and services at least partially similar to those distinguished by the earlier sign (§ 53).



12/07/2019, T-774/17, [C del M \(fig.\)](#), EU:T:2019:535, § 35, 37, 49, 52-53.

LOC not a prerequisite of bad faith

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



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

No need for LOC – No need for identical similar signs – No need for reputation

To prove bad faith, it is not necessary to systematically establish the existence of a LOC between an earlier trade mark and the contested mark (§ 56-57). In particular, it is not mandatory to show the presence in the European Union of a sign identical or similar to the sign for which registration is sought for identical or similar goods or services, giving rise to a LOC (§ 52-57).

A correlation between the goods or services (i.e. between watches and clothing) is sufficient (§ 58, 64-65, 69-72). Furthermore, it is not necessary to systematically establish a reputation of the earlier mark in the European Union (§ 59-61).



23/05/2019, T-3/18 and T-4/18, [ANN TAYLOR / ANNTAYLOR et al.](#), EU:T:2019:357, § 52-58, 64-65, 69-72.

Means of evidence

Bad faith can be proved on the basis of sworn written statements of the invalidity applicant's lawyers, acting as independent third parties (§ 94-99), or an email exchange between the lawyers of both parties establishing an attempt to obtain a licence agreement prior to the application of registration (§ 84-88). The use of these communications in the context of invalidity proceedings is not precluded, since they do not constitute a correspondence between lawyer and client that might be qualified as confidential (§ 102-103).

23/05/2019, T-3/18 and T-4/18, [ANN TAYLOR / ANNTAYLOR et al.](#), EU:T:2019:357, § 84-88, 102-103.

Article 7(3) / 59(2) EUTMR – Acquired distinctiveness

Distinctive character acquired through use – Territorial aspects – Assessment

In the case of a mark that does not have inherent distinctive character **throughout the European Union**, the distinctive character acquired through the use of that mark must be shown throughout that territory, and not only in a substantial part or the majority of it. Consequently, although such proof may be produced globally for all the Member States concerned, or separately for different Member States or groups of Member States, it is not, however, sufficient that the party with the burden of providing such evidence merely produces evidence of such acquisition that does not cover part of the European Union, even a part consisting of only one Member State.

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

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

Distinctive character acquired through use – Territorial aspects – Assessment

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

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

10/06/2020, T-105/19, [DEVICE OF A CHEQUERBOARD PATTERN \(fig.\)](#), EU:T:2020:258, § 82-83, 88.

Distinctive character acquired through use – Territorial aspects – Assessment

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

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

Probative value of the evidence – Declarations made by professionals

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

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

Evidence – Colour marks – Colour per se

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



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

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

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

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

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



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

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

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

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

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

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

Article 82 EUTMR – Grounds for invalidity – European Union Collective Marks

Article 92 EUTMR – Grounds for invalidity – European Union Certification Marks

Use of Cultural Heritage as Trade Mark

Trade Marks of Political Parties

Trade Marks containing names of public figures

RELATIVE GROUNDS (ARTICLE 8 EUTMR) – INVALIDITY (ARTICLE 60 EUTMR)

Article 8(1)(a) / 60(1)(a) EUTMR – Identical signs / Goods & services – Similarity of the goods with the services for identical goods

Identical signs

A registered trade mark is to be liable to be declared invalid if it is identical with an earlier trade mark, and the goods or services for which the trade mark is registered are identical with the goods or services for which the earlier trade mark is protected.

20/03/2003, C-291/00, [Arthur et Félicie](#), EU:C:2003:169, § 40.

Article 8(1)(b) / 60(1)(a) EUTMR – Likelihood of confusion – Word marks, Figurative marks, Scope of protection of the figurative marks, marks containing weak / non-distinctive elements, Role and influence of mark with reputation

❖ Relevant public and degree of attention

Likelihood of confusion

With regard to the relevant public, the Court of Justice has held that a likelihood of confusion (including a likelihood of association) exists if there is a risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings.

The Court has also held that it is the perception of marks in the mind of the relevant public of the goods or services in question that plays a decisive role in the global assessment of the likelihood of confusion.

11/11/1997, C-251/95, [Sabèl](#), EU:C:1997:528, § 23.
29/09/1998, C-39/97, [Canon](#), EU:C:1998:442, § 29.
22/06/1999, C-342/97, [Lloyd Schufabrik](#), EU:C:1999:323, § 25.

Defining the relevant public

As stated by the Court, the relevant public for the assessment of the likelihood of confusion is composed of users likely to use both the goods and services covered by the earlier mark and the product covered by the mark applied for that were found to be identical or similar.

01/07/2008, T-328/05, [Quartz](#), EU:T:2008:238, § 23; appeal 10/07/2009, C-416/08 P, [Quartz](#), EU:C:2009:450, dismissed.

Lower degree of attention

A lower degree of attention can be associated, in particular, with habitual buying behaviour. Purchase decisions in this area relate to, for example, inexpensive goods purchased on a daily basis.

The mere fact that the relevant public makes an impulse purchase of some goods (e.g. sweets) does not mean that the degree of that public's attention is lower than average.

15/06/2010, T-547/08, [Strumpf](#), EU:T:2010:235, § 43.
09/04/2014, T-623/11, [Milanówek cream fudge](#), EU:T:2014:199, § 34.

Consideration of the list of goods and services protected by the mark

The rights conferred by the mark extend to the goods and services for which it is protected. When determining the relevant public, the list of goods and services protected by the mark has to be taken into account rather than products that are actually marketed under the mark in question. As long as the list has not been amended, the commercial decisions taken by the proprietor of the mark do not influence the definition of the relevant public.

20/06/2019, T-389/18, [WKU / WKA et al.](#), EU:T:2019:438, § 39, 40.

Consideration of the part of the public with the lowest level of attention

When a section of the relevant public consists of professionals with a higher level of attention and another section of the relevant public consists of reasonably observant and circumspect average consumers, the public with the lowest level of attention must be taken into consideration for assessing LOC.

25/06/2020, T-114/19, [B \(fig.\) / b \(fig.\)](#), EU:T:2020:286, § 36.

❖ Comparison of the goods and services

Identity

Where the goods/services designated in the earlier mark are covered by a general indication or broad category used in the contested mark, these goods/services must be considered identical since the Office cannot dissect *ex officio* the broad category of the applicant's/holder's goods/services.

If the list of goods/services of the earlier right includes a general indication or a broad category that covers the goods/services of the contested mark in their entirety, the goods/services will be identical.

07/09/2006, T-133/05, [Pam-Pim's Baby-Prop](#), EU:T:2006:247, § 29.
17/01/2012, T-522/10, [Hell](#), EU:T:2012:9, § 36.

Similarity of goods and services

The Court of Justice held that in assessing the similarity of goods all the relevant factors relating to those goods themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary.

The term inter alia shows that the enumeration of the above factors by the Court is only indicative. There may be other factors in addition to or instead of those mentioned by the Court that may be pertinent, depending on the particular case such as their distribution channels, the relevant public and the usual origin of the goods/services.

29/09/1998, C-39/97, [Canon](#), EU:C:1998:442, § 23.

Complementarity between the goods and services at stake

Goods (or services) are complementary if there is a close connection between them, in the sense that one is indispensable (essential) or important (significant) for the use of the other in such a way that consumers may think that responsibility for the production of those goods or provision of those services lies with the same undertaking. Additionally, the Court stated that goods/services intended for different publics cannot be complementary.

11/05/2011, T-74/10, [Flaco](#), EU:T:2011:207, § 40.

22/06/2011; T-76/09, [Farma Mundi Farmaceuticos Mundi](#), EU:T:2011:298, § 30.

21/11/2012, T-558/11, [Artis](#), EU:T:2012:615, § 25.

04/02/2013, T-504/11, [Dignitude](#), EU:T:2013:57, § 44.

Goods and services in competition

Goods/services are in competition with each other when one can substitute the other. That means that they serve the same or a similar purpose and are offered to the same actual and potential customers. In such a case, the goods/services are also defined as ‘interchangeable’.

04/02/2013, T-504/11, [Dignitude](#), EU:T:2013:57, § 42.

Assessment – Burden of proof

When carrying out the comparison to assess whether there is a likelihood of confusion, it is necessary to take into account the services covered by the marks, not the services actually marketed under those marks. The opposing party is not obliged, in opposition proceedings, to adduce evidence as to the similarity of the services at issue.

09/02/2011, T-222/09, [Alpharen](#), EU:T:2011:36, § 22.

21/09/2017, T-620/16, [Idealogistic \(fig.\) / IDEA et al.](#), EU:T:2017:635, § 35.

08/07/2020, T-328/19, [SCORIFY \(fig.\) / Scor et al.](#), EU:T:2020:311, § 48, 51

Application *ratione temporis* of the requirements of the Praktiker judgment – Registration date – Right of priority – International registrations designating the EU

The right of priority has effect only when it is necessary to determine the priority of conflicting signs and therefore has no effect on the date of registration of a trade mark if this is not the same as its priority date.

For the application of the requirements resulting from the judgment of 07/07/2005, C-418/02, Praktiker, EU:C:2005:425, the relevant date is the date of registration of the EU trade mark concerned, namely the date of its final registration, which must be after the delivery of that judgment. Such requirements are intended to apply to international registrations designating the EU for which registration was granted after the judgment was delivered, even if the filing date of the application was earlier than that judgment, and even if the protection conferred by the registration is retroactive to the date of the application.

29/01/2020, T-697/18, [ALTISPORT \(fig.\) / ALDI et al.](#), EU:T:2020:14, § 36, 44.

Explanatory notes of the Nice Classification

Notwithstanding the fact that the Nice Classification was adopted for exclusively administrative purposes, the explanatory notes on the different classes of that classification are relevant in determining the nature and purpose of the goods and services under comparison.

09/09/2019, T-575/18, [The Inner Circle / InnerCircle](#), EU:T:2019:580, § 38.

❖ Comparison of the signs

General principles of trade mark comparison

If the signs are not identical, it must be determined whether they are similar or dissimilar. A global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by them, bearing in mind their distinctive and dominant components.

The Court has stated that if there is some similarity, even faint, between the marks, a global assessment must be carried out in order to ascertain whether, notwithstanding the low degree of similarity, there is, on account of the presence of other relevant factors such as the reputation or recognition enjoyed by the earlier mark, a likelihood of confusion between the marks.

11/11/1997, C-251/95, [Sabèl](#), EU:C:1997:528, § 23.
24/03/2011, C-552/09 P, [TiMiKinderjoghurt](#), EU:C:2011:177, § 66.

Signs to be compared and negligible elements

The signs have to be compared in the form in which they are protected, that is, in the form in which they are registered/applied for. The actual or possible use of the registered marks in another form is irrelevant when comparing signs.

The comparison should cover signs in their entirety. Consequently, it is wrong to discard comparing elements of signs just because they are, for example, smaller than other elements in the signs (unless they are negligible as explained below) or because they are non-distinctive.

Exceptionally, in the event of negligible elements, the Office may decide not to take such elements into consideration for the purposes of the actual comparison, after having duly reasoned why they are considered negligible.

09/04/2014, T-623/11, [Milanówek cream fudge](#), EU:T:2014:199, § 38.
12/06/2007, C-334/05 P, [Limoncello](#), EU:C:2007:333, § 41-42
13/12/2011, T-61/09, [Schinken King](#), EU:T:2011:733, § 46.

Relevant territory and relevant public

The unitary character of the EUTM means that an earlier EUTM can be relied on in opposition proceedings against any application for registration of an EUTM that would adversely affect the protection of the first mark, even if only in the perception of consumers in part of the European Union.

18/09/2008, C-514/06 P, [Armafoam](#), EU:C:2008:511, § 56-57.
18/09/2012, T-460/11, [Bürger](#), EU:T:2012:432, § 52.

Threshold for a finding of identity

Therefore, the EUTM application should be considered identical to the earlier trade mark 'where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer'.

20/03/2003, C-291/00, [Arthur et Félicie](#), EU:C:2003:169, § 50-54.

Identity between word marks

Whether or not a space, a punctuation mark (e.g. hyphen, full stop) or an accent, or the use of a combination of upper- and lower-case letters that departs from the usual way of writing, introduces a difference so insignificant that it may go unnoticed by the consumer is assessed on a case-by-case basis, taking into consideration the relevant language.

20/03/2003, C-291/00, [Arthur et Félicie](#), EU:C:2003:169, § 50-54.

Similarity between the signs – Distinctive elements of the marks

The Court held that '[...] (the) global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components'. Therefore, the degree of distinctiveness of the various components of composite marks is an important criterion that must be considered within the trade mark comparison.

11/11/1997, C-251/95, [Sabèl](#), EU:C:1997:528, § 23.

Distinctive character of the mark

The Court has defined distinctiveness in the following manner:

'In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (emphasis added).'

According to long-standing Case Law, it is considered that mark or, by analogy, its components will not have a higher degree of distinctive character just because there is no conceptual link to the relevant goods and services.

22/06/1999, C-342/97, [Lloyd Schufabrik](#), EU:C:1999:323, § 22.
16/05/2013, C-379/12 P, [H / Eich](#), EU:C:2013:317, § 71.

Dominant elements of the marks

With regard to the assessment of the dominant character of one or more given components of a complex trade mark, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark.

23/10/2002, T-6/01, [Matratzen + Matratzenmarkt Concord \(fig.\)](#), EU:T:2002:261, § 35; confirmed 28/04/2004, C-3/03 P, [Matratzen + Matratzenmarkt Concord \(fig.\)](#), EU:C:2004:233.

Weak distinctive element of a complex mark

The weak distinctive character of an element of a complex mark does not necessarily imply that that element cannot constitute a dominant element since, because, in particular, of its position in the sign or its size, it may make an impression on consumers and be remembered by them.

13/06/2006, T-153/03, [Peau de vache](#), EU:T:2006:157, § 32.

Illegible sign – Global assessment

Not only must a sign which is actually impossible to read or decipher be regarded as illegible, but also a sign which is so difficult to decipher, understand or read that a reasonably observant and circumspect consumer cannot manage to do so without making an analysis that goes beyond what may reasonably be expected of him in a purchasing situation.

The elements that differentiate the signs visually, phonetically and conceptually, namely the predominance of the figurative element of the sign applied for, the structure of that sign and the logical unit formed by its word and figurative elements considered as a whole, are sufficient for it to be found that, when faced with the signs, the relevant public will not make a connection between them, since those factors as a whole create a genuine dichotomy visually, phonetically and conceptually between the signs.



19/06/2019, T-28/18, [AC MILAN \(fig.\) / AC et al.](#), EU:T:2019:436, § 41, 116.

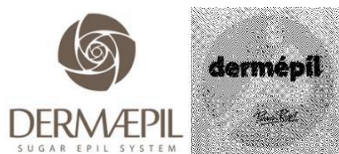
Breaking down of verbal elements – Common element

Faced with a basic verbal element that is easily understood throughout the EU, the relevant public will break down the sign into two parts, one corresponding to a word that it understands as part of everyday language and the other consisting of the rest of the sign, even if the other part does not suggest a specific meaning or does not resemble words that the relevant public knows.

03/10/2019, T-491/18, [Meatlove / carnilove](#), EU:T:2019:726, § 59, 60, 61-72.

Descriptive but dominant element

Although the relevant consumer generally does not consider a descriptive element forming part of a complex trade mark as a distinctive and dominant element, there may be special circumstances that justify the dominance of a descriptive element. This is the case, in particular, because of its position in the sign or its size, so that it may make an impression on consumers and be remembered by them, or the fact that the respective verbal elements occupy a central position in the marks at issue and dominate their overall image.



29/06/2017, T-448/16, [Mr. KEBAB \(fig.\) / MISTER K MR. KEBAP \(fig.\)](#), EU:T:2017:459, § 28.

13/06/2019, T-398/18, [DERMAEPIL SUGAR EPIL SYSTEM \(fig.\) / dermépil Perron Rigot \(fig.\)](#), EU:T:2019:415, § 128-135, 137.

Weakly distinctive or descriptive but dominant element

That an element of a composite mark has weak distinctive character does not necessarily preclude it from constituting a dominant element, since it may, on account, in particular, of its position in the sign or its size, make an impression on consumers and be remembered by them.

13/05/2020, T-63/19, [ПОШЕИ \(fig.\) / ПОМАШКИ \(fig.\)](#), EU:T:2020:195, § 46.

Sole difference between the first letters of word marks

The difference between the first letters is not sufficient to counterbalance the identity of all the remaining letters which are also placed in the same order. The signs are visually and phonetically similar to an average degree.

25/06/2020, T-550/19, [Noster / Foster](#), EU:T:2020:290, § 49, 51-53

Font – Pertinent element

The font is a pertinent element to take into consideration particularly if it is a stylised font that is not commonly used in the course of trade.



24/09/2019, T-356/18, [V V-WHEELS \(fig.\) / VOLVO \(fig.\) et al.](#), EU:T:2019:690, § 43-44.

The earlier mark's reputation and distinctive character – No impact on the comparison between the signs – No impact on the determination of dominant elements

Unlike the factor of the similarity of the signs, the factor of the earlier mark's reputation and distinctive character does not involve a comparison between signs, but only concerns the sign registered by the opponent. Since those two factors are fundamentally different in scope, examination of one of them does not allow conclusions to be drawn concerning the other. Even where the earlier mark has a high degree of distinctive character by reason of its reputation, that fact does not make it possible to determine whether, or to what extent, that mark is visually, phonetically and conceptually similar to the mark for which registration is sought.

The identification of the sign's dominant element may be relevant when comparing the signs, but it does not necessarily mean that the sign's reputation and degree of distinctive character, which concern it as a whole, make it possible to determine which of that sign's components is dominant in the relevant public's perception.

The trade mark regulation cannot be understood as meaning that a trade mark's reputation or high level of distinctive character may lead to a finding that one of its constituent elements dominates over another for the purposes of assessing the similarity of signs.



11/06/2020, C-115/19 P, [CCB \(fig.\) / CB \(fig.\) et al.](#), EU:T:2020:469, § 58, 61-62.

Signs having a name in common – One sign including a surname

When comparing signs that have in common a first name and differ in that only one of them includes a surname, it is to be considered, inter alia, how common in the relevant territory the surname is compared to the first name.

08/02/2019, T-647/17, [CHIARA FERRAGNI \(fig.\) / Chiara](#), EU:T:2019:73, § 69-70.

Short signs – Differences in one letter – Signs composed of both verbal and figurative elements

Regarding the question as to whether a difference in one letter can exclude the similarity of the marks consisting of three letters each, no general rule can be derived from case-law. Even if the relevant public may perceive differences more clearly in the case of abbreviations, whether the difference in one letter can lead to a different overall impression must be assessed on a case-by-case basis.

Where signs are composed of both verbal and figurative elements, the verbal element of the sign, in principle, has a greater impact on the consumer than the figurative element.



20/06/2019, T-389/18, [WKU / WKA et al.](#), EU:T:2019:438, § 56-58, 59.

20/06/2019, T-390/18, [WKU WORLD KICKBOXING AND KARATE UNION \(fig.\) / WKA et al.](#), EU:T:2019:439, § 56-58, 59, 73.

❖ Distinctiveness of the earlier mark

General principle – Notion of distinctiveness

The Court of Justice of the European Union (the Court) held in its judgment of 29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18, 24:

'[...] marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character.

'[...] the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion.'

The assessment of the distinctiveness of an earlier mark is especially important in cases when there is only a low degree of similarity between the signs, as it must be assessed whether this low degree can be compensated by the high degree of similarity between the products.

11/06/2014, T-281/13, [Metabiomax](#), EU:T:2014:440, § 57.

13/05/2015, T-102/14, [TPG POST / DP et al.](#), EU:T:2015:279, § 67.

According to case-law, it is necessary to distinguish between the notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark, and the notion of the distinctive character which an element of a composite mark possesses, which determines its ability to dominate the overall impression created by the mark. While it is true that it is necessary to examine the distinctiveness of an element of a composite mark at the stage of assessing the similarity of the signs [...], the degree of distinctiveness of the earlier mark is an element to be taken into account in the context of the global assessment of the likelihood of confusion. It is therefore not appropriate to take account of what may be a low degree of distinctiveness of the earlier mark at the stage of assessing the similarity of the signs.

27/04/2006, C-235/05 P, [Flexi Air](#), EU:C:2006:271, § 43.

23/01/2014, C-558/12 P, [WESTERN GOLD / WeserGold et al.](#), EU:C:2014:22, § 42-45.

25/03/2010, T-5/08 & T-7/08, [Golden Eagle / Golden Eagle Deluxe](#), EU:T:2010:123, § 65.
19/05/2010, T-243/08, [EDUCA Memory game](#), EU:T:2010:210, § 27.

Assessment of the distinctive character

In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (emphasis added).

22/06/1999, C-342/97, [Lloyd Schuhfabrik](#), EU:C:1999:323, § 22.

Any higher degree of distinctiveness acquired by the earlier mark, which is often claimed by the opponent in order to broaden its scope of protection, has to be proven by its proprietor by submitting appropriate evidence. A mark will not necessarily have a higher degree of distinctive character just because there is no conceptual link to the relevant goods and services.

16/05/2013, C-379/12 P, [H/Eich](#), EU:C:2013:317, § 71.

However, an EUTM applicant may argue that the earlier sign is distinctive to a low degree. One of the most frequent arguments brought by applicants is that the earlier trade mark or one of its components has low distinctive character given that there are many trade marks that consist of, or include, the element in question. Where this argument is supported only by the applicant referring to trade mark registrations, the Office takes the view that the existence of several trade mark registrations is not per se particularly conclusive, as it does not necessarily reflect the situation in the market. In other words, on the basis of register data only, it cannot be assumed that all the trade marks have been effectively used.

13/04/2011, T-358/09, [Toro de Piedra](#), EU:T:2011:174, § 35.
08/03/2013, T-498/10, [David Mayer](#), EU:T:2013:117, § 77-79.

When dealing with the distinctiveness of the earlier mark as a whole, the latter should always be considered to have at least a minimum degree of inherent distinctiveness. Earlier marks, whether EUTMs or national marks, enjoy a 'presumption of validity'. The Court made it clear that 'in proceedings opposing the registration of a European Union trade mark, the validity of national trade marks may not be called into question'. The Court added that 'it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character'.

24/05/2012, C-196/11 P, [F1-Live](#), EU:C:2012:314, § 40-41.

The inherent distinctiveness of the contested trade mark as a whole is not examined within the framework of the opposition proceedings, as it is the scope of protection of the earlier mark that is relevant for the purposes of likelihood of confusion. Likewise, the enhanced distinctiveness of the contested sign is also irrelevant because likelihood of confusion requires a consideration of the scope of protection of the earlier mark rather than that of the mark applied for. If an earlier mark is recognised as having a broader scope of protection by reason of its enhanced distinctiveness, the reputation acquired by the mark applied for, as a matter of principle, irrelevant for the purpose of assessing the likelihood of confusion.

03/09/2009, C-498/07 P, [La Española](#), EU:C:2013:302, § 84.

Certain degree of distinctiveness of earlier national marks

In order to avoid infringing Article 8(1)(b) CTMR [now Article 8(1)(b) EUTMR], it is necessary to acknowledge a certain degree of distinctiveness of a national mark relied on in support of an opposition to the registration of a trade mark.



24/05/2012, C-196/11 P, [F1-Live](#), EU:C:2012:314, § 47.

13/06/2019, T-398/18, [DERMAEPIL SUGAR EPIL SYSTEM \(fig.\) / dermépil Perron Rigot \(fig.\)](#), EU:T:2019:415, § 139-142.

Certain degree of distinctiveness of earlier national marks

The distinctive character of the earlier mark cannot be questioned in opposition proceedings. The earlier mark is presumed to have sufficient distinctive character to have been registered. The assessment of the LOC, in this case, should be based on the fact that the earlier mark has a low degree of inherent distinctiveness, a fact which does not exclude the LOC.



10/09/2019, T-744/18, [Silueta en forma de elipse discontinua \(fig.\) / Silueta en forma de elipse \(fig.\)](#), EU:T:2019:568, § 53, 65-66.

Proof of the weak distinctive character of the earlier mark

A list of registered marks which contain the element 'scor' is insufficient to show that the element is not distinctive or has only a weak distinctive character. The mere presence of marks containing a certain term in the Register of EU trade marks without any reference to their use on the market or to any challenge to those marks on account of the existence of a LOC, cannot prove that the distinctive character of that term has been reduced.

06/07/2016, T-97/15, [Alfredo alla Scrofa](#), EU:T:2016:393, § 39.

08/07/2020, T-328/19, [SCORIFY \(fig.\) / Scor et al.](#), EU:T:2020:311, § 84.

Evidential value – Statements of distributors – Screenshots published on Facebook or Instagram

The evidential value of the statements provided by distributors contractually tied to the applicant is lower than that of declarations provided by third parties. Where distributors are tied to the applicant as clients and performed tasks, including the marketing and promotion of the earlier mark, they cannot be regarded as independent sources.

Screenshots published as newsletters on Facebook or Instagram do not constitute conclusive evidence that the earlier mark has acquired enhanced distinctiveness through use. What matters in this regard is the effect of such activities on the recognition of the mark by the public, which is not quantifiable in the absence of data on the degree of exposure of the public to the advertising.

19/09/2019, T-378/18, [CRUZADE / SANTA CRUZ et al.](#), EU:T:2019:620, § 31, 37.

❖ Other factors

Family and series of marks

When an opposition to an EUTM application is based on several earlier marks and those marks display characteristics that give grounds for regarding them as forming part of a single 'series' or 'family', a likelihood of confusion may be created by the possibility of association between the contested trade mark and the earlier marks forming part of the series. The Courts have given clear indications on the two cumulative conditions that have to be satisfied.

23/02/2006, T-194/03, [Bainbridge](#), EU:T:2006:65, § 123-127, confirmed 13/09/2007, C-234/06 P, [Bainbridge](#), EU:C:2007:514, § 63.

Coexistence between the marks involved in the opposition

The possibility cannot be ruled out that the coexistence of two marks on a particular market might, together with other elements, contribute to diminishing the likelihood of confusion between those marks on the part of the relevant public. In certain cases, the coexistence of earlier marks in the market could reduce the likelihood of confusion that the Office finds between two conflicting marks.

11/05/2005, T-31/03, [Grupo Sada](#), EU:T:2005:169, § 86.
03/09/2009, C-498/07 P, [La Española](#), EU:C:2013:302, § 82.

Comparable situation

The earlier ('coexisting') marks and the marks at issue are identical to those involved in the opposition before the Office and cover the same goods or services as those in conflict.

11/05/2005, T-31/03, [Grupo Sada](#), EU:T:2005:169, § 86.
18/09/2012, T-460/11, [Bürger](#), EU:T:2012:432, § 60-61.
30/03/2010, R 1021/2009-1, [ECLIPSE / ECLIPSE \(fig.\)](#), § 14.

The coexistence concerns the relevant countries in the case (e.g. alleged coexistence in Denmark is irrelevant when the opposition is based on a Spanish trade mark). If the earlier trade mark is an EUTM, the EUTM applicant must show coexistence in the entire EU.

13/07/2005, T-40/03, [Julián Murúa Entrena](#), EU:T:2005:285, § 85.

The absence of a likelihood of confusion may be only inferred from the 'peaceful' nature of the coexistence of the marks at issue on the market concerned. This is not the case when the conflict has been an issue before the national courts or administrative bodies (infringement cases, oppositions or applications for annulment of a trade mark).

03/09/2009, C-498/07 P, [La Española](#), EU:C:2013:302, § 82.
08/12/2005, T-29/04, [Cristal Castellblanch](#), EU:T:2005:438, § 74.
24/11/2005, T-346/04, [Arthur et Félicie](#), EU:T:2005:420, § 64.

Irrelevant arguments for assessing likelihood of confusion – Specific marketing strategies

For this reason, specific marketing strategies are not relevant. The Office must take the usual circumstances in which the goods covered by the marks are marketed as its benchmark, that is, those circumstances that are expected for the category of goods covered by the marks. The particular circumstances in which the goods covered by the marks are actually marketed have, as a matter of principle, no impact on the assessment of the likelihood of confusion because they may vary in time depending on the wishes of the proprietors of the trade marks.

15/03/2007, C-171/06 P, [Quantum](#), EU:C:2007:171, § 59.
22/03/2012, C-354/11 P, [G](#), EU:C:2012:167, § 73.
21/06/2012, T-276/09, [Yakut](#), EU:T:2012:313, § 58.

Irrelevance of bad faith in opposition proceedings

The question whether the earlier mark was filed in bad faith is irrelevant. Bad faith is a significant factor in the context of an application for a declaration of invalidity under Article 59(1)(b) EUTMR. It is not, however, a factor that must be taken into account in opposition proceedings brought under Article 8 EUTMR (§ 16).

12/02/2019, T-231/18, [Djili \(fig.\) / GILLY](#), EU:T:2019:82, § 16.

❖ Global assessment

General principle

Likelihood of confusion must be appreciated globally, taking into account all the factors relevant to the circumstances of the case; this appreciation depends on numerous elements and, in particular, on the degree of recognition of the mark on the market, the association that the public might make between the two marks and the degree of similarity between the signs and the goods and services.

11/11/1997, C-251/95, [Sabèl](#), EU:C:1997:528, § 22.

Interdependence principle

The Court has set out the essential principle that evaluating likelihood of confusion implies some interdependence between the relevant factors and, in particular, between the previously established findings on the degree of similarity between the marks and that between the goods or services. Therefore, a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the marks and vice versa.

The interdependence of those factors is expressly referred to in recital 11 in the Preamble to the EUTMR, according to which the concept of similarity is to be interpreted in relation to the likelihood of confusion, the assessment of which depends on numerous elements and, in particular, on the recognition of the mark on the market, the association that can be made with the used or registered sign, the degree of similarity between the mark and the sign and that between the goods or services identified.

Furthermore, it is true that, by virtue of the principle of interdependence, a lesser degree of similarity between the goods or services covered may be offset by a greater degree of similarity between the marks, and vice versa. However, there is nothing to prevent a finding that, in view of the circumstances of a particular case, there is no likelihood of confusion, even where identical goods are involved and there is a certain degree of similarity between the marks at issue.

29/09/1998, C-39/97, [Canon](#), EU:C:1998:442, § 17.
10/09/2008, T-325/06, [Capio](#), EU:T:2008:338, § 72.
26/03/2020, T-343/19, [Sonance / Conlance](#), EU:T:2020:124, § 63.

Imperfect recollection

Although the average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect, account is taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks and must place trust in the imperfect picture of them that he or she has kept in mind. It should also be borne in mind that the average consumer's degree of attention is likely to vary according to the category of goods or services in question.

Even consumers with a high degree of attention need to rely on their imperfect recollection of trade marks.

22/06/1999, C-342/97, [Lloyd Schuhfabrik](#), EU:C:1999:323, § 26.
21/11/2013, T-443/12, [ancotel](#), EU:T:2013:605, § 54.

Low degree of distinctiveness of the earlier mark – Principles of imperfect recollection

The signs are visually highly similar, taking into account the overall impression given by them when recalled by the general public, whose degree of attention is average. This indirect comparison of the conflicting trade marks and their imperfect recollection is particularly important. There is a LOC even though the degree of distinctiveness of the earlier trade mark is low.



10/09/2019, T-744/18, [Silueta en forma de elipse discontinua \(fig.\) / Silueta en forma de elipse \(fig.\)](#), EU:T:2019:568, § 67-68.

Impact of the method of purchase of goods and services

The Court has stated that, when evaluating the importance attached to the degree of visual, aural and conceptual similarity between the signs, it is appropriate to take into account the category of goods or services in question and the way they are marketed.

Those factors must be taken into account at the stage of the global assessment of the likelihood of confusion and not at the stage of assessing the similarity of the signs.

22/09/1999, C-342/97, [Lloyd Schuhfabrik](#), EU:C:1999:323, § 27.
04/03/2020, C-328/18 P, [Black Label by Equivalenza \(fig.\) / Labell \(fig.\) et al.](#), EU:C:2020:156, § 70.

Impact of conceptual identity or similarity on the likelihood of confusion

A conceptual similarity between signs with analogous semantic content may give rise to a likelihood of confusion where the earlier mark is particularly distinctive.

11/11/1997, C-251/95, [Sabèl](#), EU:C:1997:528, § 24.

Short signs

The General Court held that the global assessment of the likelihood of confusion between signs consisting of a single letter (or a combination of letters not recognisable as a word) follows the same rules as that in respect of word signs comprising a word, a name or an invented term.

As to the overall assessment of likelihood of confusion, the Court made it clear that the fact that two trade marks consisting of the same letter (or of the same sequence of letters) are found to be identical from an aural and a conceptual point of view is relevant when it comes to assessing the existence of a likelihood of confusion. In such cases, it is only when the later trade mark causes a sufficiently different visual impression that a likelihood of confusion can be safely ruled out.

06/10/2004, T-117/03 – T-119/03 & T-171/03, [NL](#), EU:T:2004:293, § 47-48.
10/05/2011, T-187/10, [G](#), EU:T:2011:202, § 49, 60.

Colour marks per se

In the overall assessment, the Office takes into account the fact that there is a 'public interest in not unduly restricting the availability of colours for other traders who market goods or services of the same type as those in respect of which registration is sought'.

06/05/2003, C-104/01, [Libertel](#), EU:C:2003:244, § 52-56.
24/06/2004, C-49/02, [Blau/Gelb](#), EU:C:2004:384, § 41.

Identical goods – High level of attention of the relevant public – Phonetic identity – Low degree of visual similarity

As the goods are identical, the phonetic identity and the low degree of visual similarity of the marks serve to establish that there is a LOC, notwithstanding the high level of attention of the relevant public.



14/02/2019, T-34/18, [KALON AL CENTRO DELLA FAMIGLIA \(fig.\) / CALOON](#), EU:T:2019:94, § 52-53.

Identical services – Low distinctiveness of the earlier mark

Having regard to the identity of the services, the signs' above-average degree of visual similarity, their phonetic identity and the distinctive character, albeit low, of the earlier trade mark and the relevant public's average level of attention, there is a LOC.



07/11/2019, T-568/18, [WE \(fig.\) / WE](#), EU:T:2019:783, § 81-82.

Collective mark – Interdependence between the similarity of the trade marks and the similarity of the goods or services

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



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

No LOC – Independent distinctive role

The application of the notion of independent distinctive role deriving from the Medion judgment presupposes that the earlier mark is contained in the mark applied for. Where the earlier mark is not fully contained in the mark applied for, the element in common cannot have any independent distinctive role. In this case, the common verbal element 'caprice' is not sufficient to counterbalance the very limited similarity of the signs.



06/10/2005, C-120/04, [Thomson Life](#), EU:C:2005:594, § 37.

28/09/2016, T-574/15, [KOZMETIKA AFRODITA \(fig.\) / EXOTIC AFRODITA MYSTIC MUSK OIL et al.](#), EU:T:2016:574, § 45.

17/10/2019, T-628/18, [FRIPAN VIENNOISERIE CAPRICE PUR BEURRE \(fig.\) / Caprice \(fig.\)](#), EU:T:2019:750, § 40-42, 55.

LOC – Enhances distinctiveness of the earlier mark

Since the more distinctive the earlier mark is, the greater the likelihood of confusion will be, marks with a high degree of distinctiveness enjoy more extensive protection than those with a lower degree of distinctiveness. Therefore, the enhanced distinctiveness of the earlier mark increases LOC.



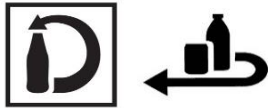
11/11/1997, C-251/95, [Sabèl](#), EU:C:1997:528, § 24.

22/06/1999, C-342/97, [Lloyd Schuhfabrik](#), EU:C:1999:323, § 20.

15/07/2020, T-371/19, [FAKEDUCK \(fig.\) / Save the duck \(fig.\) et al.](#), EU:T:2020:339, § 67.

LOC – Weak distinctive and dominant elements – Consideration of their position and their size

The figurative elements depicting symbols of an arrow and a bottle are used throughout the whole of the European Union to denote the recycling process or recycling services. Therefore, these figurative elements, as the distinctive and dominant elements of the signs, have weak distinctive character in respect of the goods and services, which all relate to the recycling of packaging (not disputed). However, on account of their position and size, the arrow and the bottle will make an impression on consumers and are likely to be remembered by them, while the can and the frame are not insignificant. In view of the average degree of visual and conceptual similarity between the signs, a LOC could not be excluded on the basis that the signs produced a different overall impression.



11/04/2019, T-477/18, [DEVICE OF A BOTTLE SILHOUETTE AND AN ARROW \(fig.\) / DEVICE OF A CAN AND A BOTTLE SILHOUETTE AND AN ARROW \(fig.\)](#), EU:T:2019:240, § 34-35, 54-57.

Article 8(2)(c) / 60(1)(a) EUTMR – Well-known marks (Art. 6bis Paris Convention) – Recognition of the trade mark as a well-know, survey polls

Relationship between well-known marks [Art. 8(2)(c) EUTMR] and trade marks with reputation [Art. 8(5) EUTMR]

Even though the terms ‘well known’ (a traditional term used in Article 6bis of the Paris Convention) and ‘reputation’ denote distinct legal concepts, there is a substantial overlap between them, as shown by a comparison of how well-known marks are defined in the WIPO Joint Recommendation Concerning Provision on the Protection of Well-Known Marks with how reputation was described by the Court of Justice concluding that the different terminology is merely a ‘... nuance, which does not entail any real contradiction [...]’.

14/09/1999, C-375/97, [Chevy](#), EU:C:1999:408, § 22.

Threshold for establishing trade mark reputation or well-known character

In practical terms, the threshold for establishing whether a trade mark is well known or enjoys reputation will usually be the same. Therefore, it will not be unusual for a mark that has acquired well-known character to have also reached the threshold laid down by the Court in *Chevy* (*General Motors*) for marks with reputation, given that in both cases the assessment is principally based on quantitative considerations regarding the degree of knowledge of the mark among the public, and that the thresholds required for each case are expressed in quite similar terms (‘known ...’ or ‘well known in at least one relevant sector of the public (Article 2(2)(b) and 2(2)(c) of the WIPO Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks)’ for well-known marks, and ‘known by a significant part of the public concerned’ for marks with reputation).

This has also been confirmed by case-law where the Court qualified the notions of ‘reputation’ and ‘well known’ as kindred concepts, underlining in this way the substantial overlap and relationship between them.

11/07/2007, T-150/04, [Tosca Blu](#), EU:T:2007:214, § 56-57.
22/11/2007, C-328/06, [Fincas Tarragona](#), EU:C:2007:704, § 17.

Well known status – Recognition of the earlier right at the date of filing

The well-known character of the earlier mark must be established on the filing date 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.

03/05/2018, T-2/17, [MASSI / MASI et al.](#), EU:T:2018:243, § 57-58, 75.

Article 8(3) / 60(1)(b) EUTMR – Trade mark filed by agent or representative

Purpose of Article 8(3) EUTMR

The unauthorised filing of the proprietor's trade mark by its agent or representative is contrary to the general obligation of trust underlying commercial cooperation agreements of this type. Such a misappropriation of the proprietor's mark is particularly harmful to its commercial interests, as the applicant may exploit the knowledge and experience acquired during its business relationship with the proprietor and, thus, improperly benefit from the proprietor's effort and investment.

06/09/2006, T-6/05, [First Defense Aerosol Pepper Projector](#), EU:T:2006:241, § 38.

Conditions of application – Nature of the relationship

In view of the purpose of this provision, which is to safeguard the legal interests of trade mark proprietors against the misappropriation of their trade marks by their commercial associates, the terms 'agent' and 'representative' should be interpreted broadly to cover all kinds of relationships based on any business arrangement (governed by a written or oral contract) where one party is representing the interests of another, regardless of the *nomen juris* of the contractual relationship between the principal-proprietor and the EUTM applicant.

13/04/2011, T-262/09, [First Defense Aerosol Pepper Projector](#), EU:T:2011:171, § 64.

Finding of a tacit cooperation agreement on the date of filing

The Court concluded that, although there was no written cooperation agreement between the parties, their relationship on the date of the application for the EUTM was, in view of the business correspondence between them, more than that of merely buyer and seller. There was, rather, a tacit cooperation agreement that led to a fiduciary obligation on the part of the EUTM applicant (§ 67).

Nevertheless, some kind of cooperation agreement has to exist between the parties. If the applicant acts completely independently, without having entered into any kind of fiduciary relationship with the proprietor, it cannot be considered an agent within the meaning of Article 8(3) EUTMR (§ 64).

09/07/2014, T-184/12, [Heatstrip](#), ECLI:EU:T:2014:621, § 67.

13/04/2011, T-262/09, [First Defense Aerosol Pepper Projector](#), EU:T:2011:171, § 64.

Pre-contractual negotiations – 'Agent-principal' relationship

Article 8(3) EUTMR requires an agreement of commercial cooperation between the parties of a kind that gives rise to a fiduciary relationship by imposing on the trade mark applicant, whether expressly or implicitly, a general duty of trust and loyalty as regards the interests of the trade mark proprietor. Article 8(3) EUTMR can apply to agreements that have expired before the date of filing of the EUTM application, provided that the duty of trust and confidentiality still existed on the filing date. After five years, it cannot be assumed that post-contractual obligations still exist. The mere existence of pre-contractual negotiations concerning commercial cooperation does not justify the application of Article 8(3) EUTMR. An ‘agent-principal’ relationship between the EUTM proprietor and the invalidity applicant cannot be based on the fact that their directors were acquainted with each other in the context of a professional relationship which, itself, cannot be characterised as an ‘agent-principal’ relationship and which, moreover, involves different companies, marks and times.

14/02/2019, T-796/17, [MOULDPRO](#), EU:T:2019:88, § 35-37.

Article 8(5) / 60(1)(a) EUTMR – Trade marks with reputation

Purpose of Article 8(5) EUTMR

The rationale behind the extended protection under Article 8(5) EUTMR is the consideration that the function and value of a trade mark are not confined to its being an indicator of origin. A trade mark can also convey messages other than an indication of the origin of the goods and services, such as a promise or reassurance of quality or a certain image of, for example, luxury, lifestyle, exclusivity, etc. (‘advertising function’).

18/06/2009, C-487/07, [L’Oréal](#), EU:C:2009:378.

Requirement of registration

According to the clear wording of the current version of Article 8(5) EUTMR, as introduced by Amending Regulation (EU) 2015/2424, this norm protects a ‘registered earlier trade mark’. Even if the requirement of registration was not expressly mentioned in the previous version of this provision, the Office interpreted it in this way, since according to its wording the applicability of the provision was restricted, indirectly but clearly, to earlier registered trade marks by prohibiting registration where [the application] was identical or similar to the earlier trade mark and was to be registered for goods and services that were not similar to those for which the earlier trade mark was registered. It follows that the existence of an earlier registration has always been a necessary condition for the application of Article 8(5) EUTMR and that, as a consequence, the reference to Article 8(2) EUTMR should be limited to earlier registrations and earlier applications subject to their registration.

11/07/2007, T-150/04, [Tosca Blu](#), EU:T:2007:214, § 55.

Conditions of application – Harm to the reputation of a mark

The following conditions need be met for Article 8(5) EUTMR to apply:

- earlier registered mark with reputation in the relevant territory;
- identity or similarity between the contested EUTM application and the earlier mark;
- use of the sign applied for must be capable of taking an unfair advantage of, or being detrimental to, the distinctiveness or the repute of the earlier mark;
- such use must be without due cause.

These conditions are cumulative and failure to satisfy any one of them is sufficient to render that provision inapplicable. Furthermore, the order in which these requirements are examined may vary depending on the circumstances of each case. For instance, the examination may start by assessing the similarities between the signs, especially where there is little or nothing to say on the subject, either because the marks are identical or because they are patently similar or dissimilar.

25/05/2005, T-67/04, [Spa-Finders](#), EU:T:2005:179, § 30.

22/03/2007, T-215/03, [Vips](#), EU:T:2007:93, § 34.

16/12/2010, T-345/08 & T-357/08, [Botolist / Botocyl](#), EU:T:2010:529, confirmed 10/05/2012, C-100/11 P, [Botolist / Botocyl](#), EU:C:2012:285.

Nature of reputation

Given the lack of statutory definition, the Court defined the nature of reputation by reference to the purpose of the relevant provisions. In interpreting Article 5(2) TMD, the Court held that the text of the TMD ‘implies a certain degree of knowledge of the earlier trade mark among the public’ and explained that it ‘is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an association between the two trade marks [...] and that the earlier mark may consequently be damaged’.

In view of these considerations, the Court concluded that reputation is a knowledge threshold requirement, implying that it must be principally assessed on the basis of quantitative criteria. In order to satisfy the requirement of reputation, the earlier mark must be known by a significant part of the public concerned by the goods or services covered by that trade mark.

14/09/1999, C-375/97, [Chevy](#), EU:C:1999:408, § 22-23.

25/05/2005, T-67/04, [Spa-Finders](#), EU:T:2005:179, § 34.

❖ Scope of reputation

Degree of recognition

Having defined reputation as a knowledge threshold requirement, the question that necessarily follows is how much awareness the earlier mark must attain among the public in order to pass this threshold. The Court held in this respect that the ‘degree of knowledge required must be considered to be reached when the earlier trade mark is known by a significant part of the public’ and added that it ‘cannot be inferred from either the letter or the spirit of Article 5(2) [TMD] that the trade mark must be known by a given percentage of the public’.

14/09/1999, C-375/97, [Chevy](#), EU:C:1999:408, § 25-26.

16/11/2011, T-500/10, [Doorsa](#), EU:T:2011:679, § 45.

Relevant public

In defining the kind of public that should be taken into account for assessing reputation, the Court held that the ‘public amongst which the earlier trade mark must have acquired a reputation is that [public] concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector’.

14/09/1999, C-375/97, [Chevy](#), EU:C:1999:408, § 24.

25/05/2005, T-67/04, [Spa-Finders](#), EU:T:2005:179, § 34, 41.

In addition to the actual buyers of the relevant goods, the notion of the relevant public extends to the potential purchasers thereof, as well as to those members of the public that only come indirectly into contact with the mark, to the extent that such consumer groups are also targeted by the goods in question.

The relevant services are stock exchange price quotation services in Classes 35 and 36, which normally target professionals. The opponent submitted evidence showing that the mark 'NASDAQ' appears almost daily in many newspapers and on many television channels that can be read/viewed throughout Europe. Therefore, the Board was right to hold that the reputation of the trade mark 'NASDAQ' had to be determined for European consumers not only among the professional public, but also in an important subsection of the general public.

10/05/2007, T-47/06, [Nasdaq](#), EU:T:2007:131, § 47, 51.

Relevant territory

According to Article 8(5) EUTMR, the relevant territory for establishing the reputation of the earlier mark is the territory of protection: the earlier mark must have a reputation in the territory where it is registered. Therefore, for national marks the relevant territory is the Member State concerned, whereas for EUTMs the relevant territory is the European Union.

The Court stated that a national trade mark cannot be required to have a reputation throughout the entire territory of the Member State concerned. It is sufficient if reputation exists in a substantial part of that territory. For the Benelux territory in particular, the Court held that a substantial part thereof may consist of part of one of the Benelux countries.

14/09/1999, C-375/97, [Chevy](#), EU:C:1999:408, § 28-29.

Relevant point in time

The opponent must show that the earlier mark had acquired a reputation by the filing date of the contested EUTM application, taking account, where appropriate, of any priority claimed, on condition of course that the priority claim has been accepted by the Office.

In addition, the reputation of the earlier mark must subsist until the decision on the opposition is taken. However, in principle it will be sufficient for the opponent to show that its mark already had a reputation on the filing/priority date of the EUTM application, while any subsequent loss of reputation is for the applicant to claim and prove. In practice, such an occurrence will be rather exceptional, since it presupposes a dramatic change of market conditions over a relatively short period of time.

In general, the closer to the relevant date the evidence is, the easier it will be to assume that the earlier mark had acquired reputation at that time. The evidential value of a particular document is likely to vary depending on how close the period covered is to the filing date. Evidence of reputation with regard to a later point in time than the relevant date might nevertheless allow conclusions to be drawn as to the earlier mark's reputation at the relevant date.

27/01/2004, C-259/02, [Laboratoire de la mer](#), EU:C:2004:50, § 31.

17/04/2008, C-108/07 P, [Ferro](#), EU:C:2008:234, § 53.

15/12/2005, T-262/04, [Briquet à Pierre](#), EU:T:2005:463, § 82.

Reputation acquired as part of another mark

To establish the reputation of a trade mark on the basis of evidence relating to the use and well-known nature of a different trade mark, the former must be included in the latter and play therein 'a predominant or even significant role'. When the earlier mark has been used as part of another mark, it is incumbent on the opponent to prove that the earlier mark has independently acquired a reputation.

21/05/2005, T-55/13, [F1H20 / F1 et al.](#), EU:T:2015:309 § 47.

12/02/2015, T-505/12, [B](#), EU:T:2015:95, § 121.

❖ Assessment of reputation

Relevant factors

Apart from indicating that '[i]t cannot be inferred from either the letter or the spirit of Article 5(2) of the [TMD] that the trade mark must be known by a given percentage of the public', the Court also held that all the relevant facts must be considered when assessing the reputation of the earlier mark, 'in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of investment made by the undertaking in promoting it'.

14/09/1999, C-375/97, [Chevy](#), EU:C:1999:408, § 25, 27.

Nature of evidence

The Court concluded that, first, the factors to be taken into consideration in order to ascertain the reputation of an earlier mark only serve as examples, as all relevant evidence in the case must be taken into consideration and, second, the other detailed and verifiable evidence produced by the intervener is already sufficient in itself to conclusively prove the reputation of its mark.

10/05/2007, T-47/06, [Nasdaq](#), EU:T:2007:131, § 52.

Trade mark awareness

The statement of the Court that it is not necessary for the mark to be 'known by a given percentage of the public', cannot be taken in itself as meaning that figures of trade mark awareness are irrelevant, or should be given a lower probative value, when assessing reputation. It only implies that percentages of awareness defined in the abstract may not be appropriate for all cases and that, consequently, it is not possible to fix a priori a generally applicable threshold of recognition beyond which it should be assumed that the mark is reputed.

04/05/1999, C-108/97 & C-109/97, [Chiemsee](#), EU:C:1999:230, § 52.

22/06/1999, C-342/97, [Lloyd Schuhfabrik](#), EU:C:1999:323, § 24.

16/11/2011, T-500/10, [Doorsa](#), EU:T:2011:679, § 52.

Comparison with the notion of 'similarity' under Article 8(1)(b) EUTMR

The relationship between the notion of 'similarity' under the two provisions was addressed by the Court in *TiMiKinderjoghurt*: 'It should be noted at the outset that ... the existence of a similarity between the earlier mark and the challenged mark is a precondition for the application both of Article 8(1)(b) [EUTMR] and of Article 8(5) [EUTMR]' (para. 51). Article 8(5) [EUTMR], like Article 8(1)(b) [EUTMR], is manifestly inapplicable if any similarity between the marks is ruled out (§ 73).

In the context both of Article 8(1)(b) and of Article 8(5) EUTMR, a finding of similarity between the marks in question requires the existence, in particular, of elements of visual, aural or conceptual similarity (§ 28).

However, those provisions differ in terms of the degree of similarity required. Whereas the protection provided for under Article 8(1)(b) EUTMR is conditional upon a finding of a degree of similarity between the marks at issue such that there is a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) EUTMR. Accordingly, the types of injury referred to in Article 8(5) EUTMR may result from a lesser degree of similarity between the marks in question, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is, to establish a link between them.

23/10/2003, C-408/01, [Adidas](#), EU:C:2003:582, § 27, 28, 29, 31.

27/11/2008, C-252/07, [Intel](#), EU:C:2008:655, § 57, 58, 66.

20/11/2014, C-581/13 P & C-582/13 P, [Golden balls](#), EU:C:2014:2387, § 73.

❖ Link between the signs

Detriment caused to the repute of the sign – Establishment of a link in the mind of the consumer

The Court has made it clear that, in order to assess whether use of the contested mark would be likely to cause detriment to, or take unfair advantage of, the distinctive character or repute of the earlier mark, it is necessary to establish – once the signs have been found to be similar – whether, given all the relevant factors, a link (or association) between the signs will be established in the mind of the relevant public. The subsequent case-law has made it clear that such an analysis should precede the final assessment of the existence of a risk of injury.

The notion of a link between the signs was addressed by the Court as follows: ‘The types of injury referred to in Article 4(4)(a) of the Directive, where they occur, are the consequence of a certain degree of similarity between the earlier and later marks, by virtue of which the relevant section of the public makes a connection between those two marks, that is to say, establishes a link between them even though it does not confuse them (see, in relation to Article 5(2) of the Directive, *General Motors*, paragraph 23; *Adidas-Salomon and Adidas Benelux*, paragraph 29, and *adidas and adidas Benelux*, paragraph 41)’.

The term ‘link’ is often also referred to as ‘association’ in other paragraphs of this part of the Guidelines as well as in case-law. These terms are, at times, used interchangeably.

The Court made it clear that the mere fact that the marks in question are similar is not sufficient for it to be concluded that there is a link between them. Rather, whether or not there is a link between the marks at issue must be appreciated globally, taking into account all factors relevant to the circumstances of the case.

27/11/2008, C-252/07, [Intel](#), EU:C:2008:655, § 30.

Establishment of a link – Relevant factors

- The degree of similarity between the conflicting marks. The more similar they are, the more likely it is that the later mark will bring the earlier mark with a reputation to the mind of the relevant public
- The nature of the goods or services for which the earlier mark is reputed and the later mark seeks registration, including the degree of similarity or dissimilarity between those goods or services, and the relevant section of the public. The goods or services may be so dissimilar that the later mark is unlikely to bring the earlier mark to the mind of the relevant public.
- The strength of the earlier mark’s reputation.

- The degree of the earlier mark's distinctive character, whether inherent or acquired through use. The more inherently distinctive the prior mark, the more likely it will be brought to a consumer's mind when encountering a similar (or identical) later mark.
- The existence of likelihood of confusion on the part of the public.

This list is not exhaustive, and a link between the marks at issue may be established or excluded on the basis of only some of those criteria.

The question of whether the relevant public will establish a link between the marks at issue is a question of fact, which must be answered in the light of the facts and circumstances of each individual case.

27/11/2008, C-252/07, [Intel](#), EU:C:2008:655, § 42, 49.

Global assessment of relevant factors

The assessment of whether a 'link' will be established must take into account all the relevant factors that will then need to be balanced. Therefore, even a faint or remote degree of similarity between the signs (which might not be sufficient for a finding of likelihood of confusion under Article 8(1)(b) EUTMR) still justifies assessing all the relevant factors to determine if it is likely that a link between the signs will be established in the mind of the relevant public.

In this respect, the Court stated the following: 'Although that global assessment implies some interdependence between the relevant factors, and a low degree of similarity between the marks may therefore be offset by the strong distinctive character of the earlier mark [...] the fact remains that where there is no similarity between the earlier mark and the challenged mark, the reputation or recognition enjoyed by the earlier mark and the fact that the goods or services respectively covered are identical or similar are not sufficient for it to be found that [...] the relevant public makes a link between them [...].

[...] It is only if there is some similarity, even faint, between the marks at issue that the General Court must carry out a global assessment in order to ascertain whether, notwithstanding the low degree of similarity between them, there is, on account of the presence of other relevant factors such as the reputation or recognition enjoyed by the earlier mark, a likelihood of confusion or a link made between those marks by the relevant public.'

24/03/2011, C-552/09 P, [TiMiKinderjoghurt](#), EU:C:2011:177, § 65-66.

Influence of the goods and services designated

The fact that the goods and services designated by the marks at issue belong to distant sectors of trade is not, in itself, sufficient to exclude the possibility of the existence of a link. The specific reputation of the earlier mark (including qualitative aspects, such as a particular image, lifestyle, or particular circumstances of marketing that have become associated with the reputation of the mark) and the degree of similarity between the marks could make it possible for the image of the reputed mark to be transferred to the contested mark notwithstanding the distance between the relevant market sectors.

However, where the goods and services designated by the marks address the general public on the one hand, and a specialised public on the other, the mere fact that members of the specialised public are necessarily part of the general public is not conclusive as to the existence of a link. The fact that a specialised public may be familiar with the earlier mark covering goods or services aimed at the general public, that is not sufficient to demonstrate that that specialised public will establish a link between the marks at issue.

PUMA

26/09/2018, T-62/16, [PUMA \(fig.\) / PUMA \(fig.\) et al.](#), EU:T:2018:604, § 45-46.

❖ Risk and types of injury

Protected subject matter

Article 8(5) EUTMR does not protect the reputation of the earlier mark as such, in the sense that it does not intend to prevent the registration of all marks identical with or similar to a mark with reputation. In addition, there must be a likelihood that use of the contested application without due cause would take unfair advantage of, or would be detrimental to, the distinctive character or the repute of the earlier mark. The Court confirmed this by stating that once the condition as to the existence of reputation is fulfilled, the examination has to proceed regarding the condition that the earlier mark must be detrimentally affected without due cause.

The Court did not set out in more detail exactly what would count as detriment or unfair advantage, even though it stated in *Sabèl* that Article 8(5) EUTMR '[does] not require proof of likelihood of confusion', thereby stating the obvious, namely that the enlarged protection granted to reputed marks is not concerned with their function of origin.

11/11/1997, C-251/95, [Sabèl](#), EU:C:1997:528, § 20.
14/09/1999, C-375/97, [Chevy](#), EU:C:1999:408, § 30.

However, in a series of previous decisions, the Court stated that apart from indicating origin, a trade mark may also fulfil other functions worthy of protection. More particularly, it confirmed that a trade mark can offer a guarantee that all the goods coming from a single undertaking have the same quality (guarantee function) and that it can serve as an advertising instrument by reflecting back the goodwill and prestige it has acquired in the market (advertising function).

17/10/1990, C-10/89, [Hag II](#), EU:C:1990:359.
11/07/1996, C-427/93, C-429/93 & C-436/93, [Bristol-Myers Squibb v Paranova A/S](#), EU:C:1996:282.
11/11/1997, C-349/95, [Ballantine](#), EU:C:1997:530.
04/11/1997, C-337/95, [Dior](#), EU:C:1997:517.
23/02/1999, C-63/97, [BMW](#), EU:C:1999:82.

Assessment of the risk of injury

The Court did not deal with the assessment of detriment and unfair advantage in great detail, as this issue was not part of the question referred to it. It only stated that it 'is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an association between the two trade marks [...] and that the earlier trade mark may consequently be damaged'.

The more immediately and strongly the earlier mark is brought to mind by the later sign, the greater the likelihood that current or future use of the sign is taking, or will take, unfair advantage of the distinctive character or the repute of the mark or is, or will be, detrimental to it

14/09/1999, C-375/97, [Chevy](#), EU:C:1999:408, § 23.
27/11/2008, C-252/07, [Intel](#), EU:C:2008:655, § 67-69.
18/06/2009, C-487/07, [L'Oréal](#), EU:C:2009:378, § 41, 43.

Taking unfair advantage of distinctiveness or repute

The notion of taking unfair advantage of distinctiveness or repute covers cases where the applicant benefits from the attractiveness of the earlier right by affixing on its goods/services a sign that is similar (or identical) to one widely known in the market and, thus, misappropriating its attractive powers and advertising value or exploiting its reputation, image and prestige. This may lead to unacceptable situations of commercial parasitism, where the applicant is allowed to take a 'free ride' on the investment of the opponent in promoting and building up goodwill for its mark, as it may stimulate sales of the applicant's products to an extent that is disproportionately high in comparison with the size of its promotional investment.

The taking of unfair advantage of the distinctive character or the repute of a mark does not require that there be a likelihood of confusion or a likelihood of detriment to the distinctive character or the repute of the mark or, more generally, to its proprietor.

The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of the mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image.

18/06/2009, C-487/07, [L'Oréal](#), EU:C:2009:378, § 41, 49-50.

Misappropriation of the distinctiveness and repute of the earlier sign

The misappropriation of the distinctiveness and repute of the earlier mark presupposes an association between the respective marks, which makes possible the transfer of attractiveness and prestige to the sign applied for. An association of this kind will be more likely in the following circumstances.

Where the earlier mark possesses a strong reputation or a very strong (inherent) distinctive character, because in such a case it will be both more tempting for the applicant to try to benefit from its value and easier to associate it with the sign applied for. Such marks will be recognised in almost any context, exactly because of their outstanding distinctiveness or 'good' or 'special' reputation, in the sense that it reflects an image of excellence, reliability or quality, or some other positive message, which could positively influence the choice of the consumer as regards goods of other producers.

The stronger the distinctive character of the earlier mark, the more likely it is that, when encountering a later identical or similar mark, the relevant public will associate it with that earlier mark.

12/07/2011, C-324/09, [L'Oréal-eBay](#), EU:C:2011:474, § 44.

06/07/2012, T-60/10, [Royal Shakespeare](#), EU:T:2012:348, § 27.

Use in an amended form – Free-riding

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'.

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.



01/03/2018, T-629/16, [DEVICE OF TWO PARALLEL STRIPES \(other\) / DEVICE OF THREE PARALLEL STRIPES \(fig.\) et al.](#), EU:T:2018:108, § 76-78, 191-192.

Assessment of reputation – Free-riding

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

26/09/2018, T-62/16, [PUMA \(fig.\) / PUMA \(fig.\) et al.](#), EU:T:2018:604, § 67-70, 88-89 and 100-101.

Detriment to the distinctive character / repute of the sign

In examining whether this condition is fulfilled, it is necessary to take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the amount spent by the undertaking in promoting it, without any requirement that it must be known by a given percentage of the relevant public or that that reputation must exist in a substantial part of the territory concerned.

14/09/1999, C-375/97, [General Motors](#), ECLI:EU:C:1999:408, § 24, 25, 27-29.
13/12/2004, T-8/03, [Emilio Pucci](#), EU:T:2004:358, § 67.

In order to satisfy the requirement relating to reputation, the earlier Community mark must be known by a significant part of the public concerned by the goods or services covered by that trade mark, that is to say, depending on the goods or services marketed, either by the public at large, or by a more specialised public such as traders in a specific sector.

It is established that unfair advantage has been taken of the distinctive character or the repute of the earlier mark where there is clear exploitation and free-riding on the coat tails of a famous mark or an attempt to trade upon its reputation, while detriment to the distinctive character of the earlier mark is usually established; the use of the mark applied for would have the effect that the earlier mark is no longer capable of arousing immediate association with the goods for which it is registered and used and, detriment to the repute is usually established where the goods for which the mark applied for is used appeal to the public's senses in such a way that the earlier mark's power of attraction is diminished.

10/05/2007, T-47/06, [Nasdaq](#), EU:T:2007:131, § 46, 55.
12/03/2009, C-320/07 P, [Nasdaq](#), EU:C:2009:146.
24/05/2012, C-196/11 P, [F1-Live](#), EU:C:2012:314.

Detriment to distinctiveness

Detriment to the distinctive character of an earlier reputed mark (also referred to as 'dilution', 'whittling away' or 'blurring') is caused when that mark's ability to identify the goods/services for which it is registered and used as coming from its proprietor is weakened because use of a later similar mark leads to dispersion of the identity of the earlier reputed mark by making it less distinctive or unique.

27/11/2008, C-252/07, [Intel](#), EU:C:2008:655, § 29.

Dilution – Establishment of a link with the earlier sign

As regards, in particular, detriment to the distinctive character of the earlier mark, also referred to as 'dilution', 'whittling away' or 'blurring', such detriment is caused when that mark's ability to identify the goods or services for which it is registered and used as coming from the proprietor of that mark is weakened, since use of the later mark leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is notably the case when the earlier mark, which used to arouse immediate association with the goods and services for which it is registered, is no longer capable of doing so.

This occurs where there is a certain degree of similarity between the earlier and later marks, by virtue of which the relevant section of the public makes a connection between those two marks, that is to say, establishes a link between them even though it does not confuse them.

In the absence of such a link in the mind of the public, the use of the later mark is not likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.

27/11/2008, C-252/07, [Intel](#), EU:C:2008:655, § 29-31.

Detriment to repute

The reputation of the earlier trade mark may be tainted or debased in this way, either when it is reproduced in an obscene, degrading or inappropriate context, or in a context that is not inherently unpleasant but that proves to be incompatible with a particular image the earlier trade mark has acquired in the eyes of the public due to the promotional efforts of its owner. The likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality that is liable to have a negative impact on the image of the mark.

18/06/2009, C-487/07, [L'Oréal](#), EU:C:2009:378, § 40.

Tarnishment

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.

28/02/2019, C-505/17 P, [SO' BiO etic \(fig.\) / SO...? et al.](#), EU:C:2019:157, § 87-88.

Article 8(6) / 60(1)(d) EUTMR – Geographical indications

Article 60(2)(a) EUTMR – Right to a name

Protection of a name under national law of a Member State

The protection of a surname requires that, used by itself, it necessarily evokes the person claiming the infringement of a right attached to it. Where a surname has been used for many years in the hotel industry by several members of the same family, it is not established that the mark refers exclusively to one member of this family. Furthermore, the person invoking the protection of his name under the national law of a Member State must prove the content of this law and produce particulars establishing how the law is applied.

29/06/2017, T-343/14, [CIPRIANI / CIPRIANI](#), EU:T:2017:458, § 96-108.

Article 60(2)(b) EUTMR – Right of personal portrayal

Article 60(2)(c) EUTMR – Copyright

Article 60(2)(d) EUTMR – Industrial property right

GROUNDS FOR REVOCATION (ARTICLE 58 EUTMR)

Burden of proof – Principle

Examination of the fact submitted by the applicant

In accordance with Article 95(1) EUTMR, the application for revocation will be examined within the scope of factual submissions made by the revocation applicant.

13/09/2013, T-320/10, [Castel](#), EU:T:2013:424, § 28.

Article 58(1)(a) EUTMR – Revocation for non-use

Period of time to be considered – Counterclaim for revocation

If the application for revocation was preceded by a counterclaim for revocation pursuant to Article 128 EUTMR between the same parties and ‘deferred’ by a court pursuant to Article 128(7) EUTMR, the time period for which genuine use must be proven is the 5 years preceding the date of the counterclaim.

17/01/2018, T-68/16, [DEVICE OF A CROSS ON A SPORT SHOE SIDE \(fig.\)](#), EU:T:2018:7, § 55-56.

Article 58(1)(b) EUTMR – Common name for a product or service / Generic term

Relevant public

An EUTM is liable to be revoked in accordance with Article 58(1)(b) EUTMR if it has become the common name for the product or service not just among some but among the vast majority of the relevant public, including those involved in the trade for the product or service in question.

29/04/2004, C-371/02, [Bostongurka](#), EU:C:2004:275, § 23, 26.

Whether a trade mark has become the common name in the trade for a product or service in respect of which it is registered must be assessed not only in the light of the perception of consumers or end users but also, depending on the features of the market concerned, in the light of the perception of those in the trade, such as sellers (§ 28).

However, in some specific circumstances, it might be sufficient that the sellers of the finished product do not inform their customers that the sign has been registered as a trade mark and do not offer their customers assistance at the time of sale, which includes an indication of the origin of the goods for sale (§ 23-25, 30).

06/03/2014, C-409/12, [Kornspitz](#), EU:C:2014:130, § 23-25, 28, 30.

Common name

The distinctive force of a trade mark is always more likely to degenerate when a sign is suggestive or apt in some way, especially if it has positive connotations that lead others to latch on to its suitability for designating not just a particular producer’s product or service but a particular type of product or service.

30/01/2007, 1 020 C, *Stimulation*, § 22, 32 et seq.

Article 12 EUTMR – Defence of the proprietor

Where the proprietor of the EUTM has done what could reasonably have been expected in the particular case, the EUTM cannot be revoked. The proprietor must then check whether its trade mark appears in dictionaries as a generic term; if it does, the proprietor can request from the publisher that in future editions the trade mark will be accompanied by an indication that it is a registered trade mark.

Article 58(1)(c) EUTMR – Use liable to mislead the public

Relationship between the geographical name and the product

A trade mark composed of, or containing, a geographical indication will, as a rule, be perceived by the relevant public as a reference to the place from where the goods originate. The only exception to this rule is where the relationship between the geographical name and the products is manifestly so fanciful (e.g. because the place is not known, and unlikely to become known, to the public as the place of origin of the goods in question) that consumers will not make such a connection.

In this regard, the trade mark MÖVENPICK OF SWITZERLAND was revoked because the goods in question were produced (according to the facts) solely in Germany, not in Switzerland.

12/02/2009, R 697/2008-1, [MÖVENPICK OF SWITZERLAND](#).

Examples – Revocation of signs susceptible to mislead the public

Where a trade mark containing the word elements 'goats' and 'cheese' and a figurative element clearly depicting a goat is registered for 'goats' cheese', and use is proven for cheese not made from goats' milk, the EUTM will be revoked.

Where a trade mark containing the word elements 'pure new wool' is registered for 'clothing' and use is proven for clothing manufactured from artificial fibres, the EUTM will be revoked.

Where a trade mark containing the words 'genuine leather' or the corresponding pictogram is registered for 'shoe wear' and use is proven for shoes not made of leather, the EUTM will be revoked.

PROOF OF USE AND ASSESSMENT OF EVIDENCE

Article 47(2) EUTMR – Genuine use of the sign

The EUTMR, the EUTMDR and the EUTMIR do not define what is to be regarded as ‘genuine use’. However, the Court of Justice (the ‘Court’) has laid down several important principles as regards the interpretation of this term.

Genuine use – General Principles of the Court of Justice

In *Minimax*, the Court established the following principles:

- genuine use means **actual** use of the mark (§ 35);
- genuine use must, therefore, be understood to denote use that is **not merely token**, serving solely to preserve the rights conferred by the mark (§ 36);
- genuine use must be consistent with the **essential function** of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling the latter, without any possibility of confusion, to distinguish the product or service from others that have another origin (§ 36);
- genuine use entails use of the mark **on the market** for the goods or services protected by that mark and not just internal use by the undertaking concerned (§ 37);
- genuine use must relate to **goods or services** already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns (§ 37);
- when assessing whether there has been genuine use, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is **real**, in particular whether such use is viewed as warranted in the economic sector concerned to **maintain or create a share in the market** for the goods or services protected by the mark (§ 38);
- the circumstances of the case may, therefore, include giving consideration, inter alia, to the **nature** of the goods or services at issue, the **characteristics of the market** concerned and the scale and **frequency** of use of the mark (§ 39);
- use need **not**, therefore, always be **quantitatively significant** for it to be deemed genuine, as that depends on the characteristics of the goods or services concerned on the corresponding market (§ 39).

11/03/2003, C-40/01, [Minimax](#), EU:C:2003:145, § 35-39.

In its order, the Court further elaborated the *Minimax* criteria as follows:

- the question whether use is sufficient to preserve or create market share for the goods or services concerned depends on several factors and on a case-by-case assessment. The **characteristics** of the goods and services, the **frequency or regularity** of the use of the mark, whether the mark is used for the purpose of marketing **all** the identical goods or services of the proprietor or merely some of them, or evidence that the proprietor is able to provide, are among the factors that may be taken into account (§ 22);

- use of the mark by a single client that **imports** the goods for which the mark is registered can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor of the mark (§ 24);
- a **de minimis rule** cannot be laid down (§ 25).

27/01/2004, C-259/02, [Laboratoire de la mer](#), EU:C:2004:50, § 22, 24 and 25.

Function of proof of use

The reason behind the requirement that earlier marks can be required to demonstrate that they have been put to genuine use is to restrict the number of trade marks registered and protected and, consequently, the number of conflicts between them.

12/03/2003, T-174/01, [Silk Cocoon](#), EU:T:2003:68, § 38.

When it comes to the requirement to prove use in opposition proceedings before the Office, it is important to bear in mind that the purpose of Article 47(2) and (3) EUTMR is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to only large-scale commercial use of the marks.

08/07/2004, T-334/01, [Hipoviton](#), EU:T:2004:223, § 32.

08/07/2004, T-203/02, [Vitafruit](#), EU:T:2004:225, § 38.

Standard of proof applied by the Office

Article 47 EUTMR requires proof of genuine use of the earlier mark. 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.

18/01/2011, T-382/08, [Vogue](#), EU:T:2011:9, § 22.

The Court has indicated that it is not possible to prescribe, in the abstract, **what quantitative threshold should be chosen** in order to determine whether use was genuine or not, and accordingly there can be no objective de minimis rule to establish a priori the level of use needed in order for it to be 'genuine'. So, whilst a minimum extent of use must be shown, what exactly constitutes this minimum extent depends on the circumstances of each case. The general rule is that, when it serves a real commercial purpose, **even minimal use of the trade mark could be sufficient to establish genuine use**, depending on the goods and services, and the **relevant market**.

23/09/2009, T-409/07, [acopat](#), EU:T:2009:354, § 35.

02/02/2012, T-387/10, [Arantax](#), EU:T:2012:51, § 42.

In other words, it is sufficient if the evidence of use proves that the trade mark owner has seriously tried to acquire or maintain a commercial position in the relevant market. However, not just any proven commercial exploitation can automatically be qualified as genuine use of the mark in question. In other words, use may still be insufficient even where commercial exploitation has been proven to a certain extent.

17/07/2014, C-141/13 P, [Walzer Traum](#), EU:C:2014:2089, § 32.

Cumulative Principle

According to Article 10(3) EUTMDR, the indications and evidence required in order to provide proof of use must concern the **place, time, extent and nature of use** of the opponent's trade mark for the relevant goods and services.

These requirements for proof of use are **cumulative** (§ 43). This means that the opponent is obliged not only to indicate but also to prove each of these requirements. However, the sufficiency of the indication and proof as to the place, time, extent and nature of use has to be considered in view of the **entirety** of the evidence submitted. A separate assessment of the various relevant factors, each considered in isolation, is not suitable (§ 31).

05/10/2010, T-92/09, [STRATEGI / Stratégies](#), EU:T:2010:424, § 43.
17/02/2011, T-324/09, [Friboi](#), EU:T:2011:47, § 31.

Nature of evidence

Evidence of use may be **of an indirect/circumstantial nature**, such as evidence about the share in the relevant market, the importing of the relevant goods, the supply of the necessary raw materials or packaging to the owner of the mark, or the expiry date of the relevant goods. Such indirect evidence can play a decisive role in the overall assessment of the evidence submitted. Its probative value has to be carefully assessed. For instance, the General Court found that catalogues in themselves could – under certain circumstances – be conclusive evidence of sufficient extent of use.

08/07/2010, T-30/09, [Peerstorm](#), EU:T:2010:298, § 42 et seq.

Relevance of evidence submitted

Material submitted **without any indication of date of use** may, in the context of an overall assessment, still be relevant and taken into consideration **in conjunction with other pieces** of evidence that are dated (§ 33).

This is the case in particular if it is common in a particular market sector for the samples of the goods and services themselves not to bear indications of time, noting that ice-cream menus are rarely dated (§ 16).

17/02/2011, T-324/09, [Friboi](#), EU:T:2011:47, § 33.
05/09/2001, R0608/2000-4, [PALAZZO / HELADERIA PALAZZO](#), § 16.

Procedural aspects

❖ General aspects

Proof of use in opposition proceedings

When it comes to the requirement to prove use in opposition proceedings before the Office, it is important to bear in mind that the purpose of Article 47(2) and (3) EUTMR is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to only large-scale commercial use of the marks.

08/07/2004, T-334/01, [Hipoviton](#), EU:T:2004:223, § 32.
08/07/2004, T-203/02, [Vitafruit](#), EU:T:2004:225, § 38.

Request for proof of use

Article 47(2) EUTMR and Rule 22 EUTMIR do not lay down any specific requirements as to the form and content of the applicant's request of proof of genuine use (§ 44-46).

28/11/2019, T-736/18, [Bergsteiger / BERG \(fig.\) et al.](#), EU:T:2019:826, § 44-46.

❖ Acquiescence – Article 61 EUTMR

Conditions of acquiescence

Four conditions must be satisfied to cause the start of the limitation period in consequence of acquiescence: (i) the later trade mark must be registered; (ii) the application must have been made in good faith by its proprietor; (iii) it must be used in the Member State where the earlier trade mark is protected; and, (iv) the proprietor of the earlier trade mark must be aware of the use of that trade mark after its registration (§ 20).

24/01/2019, T-785/17, [BIG SAM SPORTSWEAR COMPANY \(fig.\) / SAM et al.](#), EU:T:2019:29, § 20.

Relevant point in time

The plea of inadmissibility resulting from acquiescence requires demonstration of actual awareness of the use made of the more recent mark during a five-year period after its registration. The registration of the contested mark is one of the conditions which must be satisfied before the period of limitation in consequence of acquiescence pursuant to Article 61(1) EUTMR starts running. The questions of whether the contested mark was used before its registration, and whether the proprietor of the earlier trade mark was aware of such a use before registration, are irrelevant for the calculation of the time period pursuant to this provision (§ 17-18).

The fact that an earlier right holder had filed an opposition against the contested mark does not imply that this earlier right holder was necessarily aware of the subsequent use made of the contested mark. The date of filing of the opposition can therefore not constitute the starting point of the 5-year period for acquiescence (§ 36).

20/06/2019, T-389/18, [WKU / WKA et al.](#), EU:T:2019:438, § 17-18.

24/01/2019, T-785/17, [BIG SAM SPORTSWEAR COMPANY \(fig.\) / SAM et al.](#), EU:T:2019:29, § 36.

Nature of use

❖ Use of individual marks

Genuine use – Requirements

Genuine use requires that use is made as a **trade mark**:

- not for purely illustrative purposes or on purely promotional goods or services,
- in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered

11/03/2003, C-40/01, [Minimax](#), EU:C:2003:145, § 43.

Link to be established within the relevant goods

As a trade mark has, inter alia, the function of operating as a link between the goods and services and the person responsible for their marketing, the proof of use must establish a **clear link between the use of the mark and the relevant goods and services**. As clearly indicated in Article 10(4) EUTMDR, it is not necessary for the mark to be affixed to the goods themselves.

A representation of the mark on packaging, catalogues, advertising material or invoices relating to the goods and services in question constitutes direct evidence that the mark has been put to genuine use.

12/12/2014, T-105/13, [TrinkFix](#), EU:T:2014:1070, § 28-38.

❖ Genuine use of a mark in accordance with its function

Use of a sign as a business, company or trade name

For example, the presentation of the business name at the top of **order forms or invoices** may, depending on how the sign appears on them, be suitable to support genuine use of the registered trade mark (§ 44-45).

Simultaneous use of the company name and the trade mark on invoices may, when the two indications can be clearly distinguished, prove use of the sign as an indicator of the commercial origin of the services provided, irrespective of the fact that the invoices may also show other sub-brands (§ 82-84).

However, mere use of a business name at the top of invoices without a clear reference to specific products/services is not sufficient.

06/11/2014, T-463/12, [MB](#), EU:T:2014:935, § 44-45.

03/10/2019, T-666/18, [ad pepper \(fig.\)](#), EU:T:2019:720, § 82-84.

Irrelevance of the classification of a mark for the assessment of genuine use

When assessing the distinctiveness of a mark, the classification of a 'position mark' as a figurative or three-dimensional mark, or as a specific category of marks, is irrelevant (§ 42). This classification is also irrelevant in assessing the genuine use of such a mark (§ 43).

The GC correctly relied on the graphic representation of the mark, regardless of its classification, for the purpose of assessing whether there is genuine use, stating that it could be inferred directly from the graphic representation of the mark, and with sufficient precision, that the protection sought covered only a cross, consisting of two black intersecting lines, represented in solid lines (§ 41, 46-47).



06/06/2019, C-223/18 P, [DEVICE OF A CROSS ON A SPORT SHOE SIDE \(fig.\)](#), EU:C:2019:471, § 41-43, 46-47.

Indication of the company name combined with the sign

Where the trade mark is systematically placed in invoice headers as the first element above the company name 'ad Pepper media GmbH', use of the sign **ad pepper** goes beyond merely identifying the company and refers to the commercial origin of the services provided. The design of the invoices therefore allows a close connection to be made between the sign **ad pepper** and the invoiced services.

03/10/2019, T-666/18, [ad pepper \(fig.\)](#), EU:T:2019:720, § 82.

Genuine use of collective marks

The essential function of a collective mark is to distinguish the goods or services of the members of the association which is the proprietor of that mark from those of other undertakings (§ 52). Therefore, unlike an individual mark, a collective mark does not have the function of indicating to the consumer ‘the identity of origin’ of goods or services in respect of which it is registered (§ 53). Article 66 CTMR [now Article 74(1) EUTMR] by no means requires that manufacturers, producers, suppliers or traders that are affiliated with the association which is the proprietor of a collective mark, form part of the same group of companies which manufacture or supply the goods or services under unitary control (§ 54). Collective marks are, like individual marks, part of the course of trade (§ 56). Their use must therefore, in order to be classified as ‘genuine’ within the meaning of Article 15(1) CTMR [[now Article 18(1) EUTMR], be part of the objective of the undertakings concerned to create or preserve an outlet for their goods or services (§ 56).

A collective mark is used in accordance with its essential function from the moment it enables the consumer to understand that the goods or services covered originate from undertakings that are affiliated with the association, the proprietor of the mark, and to thereby distinguish those goods or services from those originating from undertakings that are not affiliated (§ 58).

The assessment of genuine use of the mark should be carried out by evaluating, particularly, whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (§ 62).



12/12/2019, C-143/19 P, [EIN KREIS MIT ZWEI PFEILEN \(fig.\)](#), EU:C:2019:1076, § 52-54, 56, 58, 62.

❖ Not suitable use in accordance with the function of a trade mark

Use as a certification mark

The essential function of a certification mark is different from the essential function of an individual trade mark: while the latter primarily serves to identify the origin of goods and services, the former serves to certify that the goods or services meet certain established standards and possess particular characteristics.

Therefore, use as a certification mark does not serve as use as an individual trade mark, because it does not guarantee to consumers that the goods or services come from a single undertaking under the control of which the goods or services are manufactured or supplied and which, consequently, is responsible for the quality of those goods or services.

08/06/2017, C-689/15, [Cotton Flower](#), EU:C:2017:434, § 45.

Use as a geographical indication

The essential function of GIs is to designate the origin of goods as being from a particular region or locality. This is in contrast with the main function of an individual trade mark, namely to serve as an indicator of commercial origin.

When a GI is contained within an individual mark that guarantees to consumers that the goods which it designates come from a single undertaking under the control of which those goods are manufactured and which is responsible for the quality of those goods, the opponent must submit proof of use as an individual mark.

Therefore, evidence of use as a GI (e.g. general statements of Regulatory Councils) cannot serve for proving use as an individual mark.

07/06/2018, T-72/17, [Steirisches Kürbiskernöl \(fig.\)](#), EU:T:2018:335, § 52.

17/10/2019, C-514/18 P, [Steirisches Kürbiskernöl \(fig.\)](#), EU:C:2019:878, § 37-43.

Descriptive use of a trade mark for specific goods

A trade mark is to be used in accordance with its essential function, guaranteeing the identity of the origin of the goods or services for which it is registered. This condition is not fulfilled where the mark affixed to an item does not contribute to creating an outlet or to distinguishing the item from the goods of other undertakings, but rather serves as a descriptive indication for the goods' ingredients.

31/01/2019, C-194/17 P, [Cystus](#), EU:C:2019:80, § 83.

Use for promotional purposes

The free distribution of the CDs, DVDs and software on which the contested trade mark is affixed, exclusively in the context of the marketing of goods (photobooks and calendars) – although it is indispensable for the order and design of these goods – does not constitute genuine use of the trade mark according to its essential function. The items are not distributed with the aim of penetrating the market for goods in the same class. Affixing the EUTM on such products does not aim at creating an outlet for them.

11/04/2019, T-323/18, [DARSTELLUNG EINES SCHMETTERLINGS \(fig.\)](#), EU:T:2019:243, § 38-39.

No use in accordance with the function of indicating origin

Where the use of an individual mark, despite certifying the geographical origin of the mark and the qualities attributable to the origin of the goods from different producers, does not guarantee to consumers that those goods or services come from a single undertaking under the control of which they are manufactured or supplied and which, consequently, is responsible for the quality of those goods or services, such use is not made in accordance with the function of indicating origin.



17/10/2019, C-514/18 P, [Steirisches Kürbiskernöl \(fig.\)](#), EU:C:2019:878, § 39.

Evidence concerning proof of genuine use

As an accumulation of items of evidence may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (17/04/2008, C-108/07 P, Ferro, EU:C:2008:234, § 36), all the evidence submitted to the BoA must make it possible to establish proof of use and each piece of evidence therefore does not necessarily have to relate to the place, duration, nature and extent of use.

13/06/2019, T-398/18, [DERMAEPIL SUGAR EPIL SYSTEM \(fig.\) / dermépil Perron Rigot \(fig.\)](#), EU:T:2019:415, § 61-63.

Statutory declarations by the managing director and the head of the HR department cannot in themselves constitute sufficient evidence of genuine use of the contested trade mark. However, they can be taken into consideration if they are supported by other evidence, without their impartiality or credibility having to be questioned.

03/10/2019, T-666/18, [ad pepper \(fig.\)](#), EU:T:2019:720, § 89-90, 92.

Proof of genuine use of earlier national marks

When the proprietor of an EU trade mark requests proof of genuine use to be provided, that use constitutes a condition which must be met, not only by EU trade marks but also by earlier national marks relied on in support of an application for a declaration of invalidity of that EU trade mark. The application of Article 64(2) EUTMR to earlier national marks under paragraph 3 of that Article means that genuine use is to be defined according to Article 18 EUTMR, and not assessed according to the relevant national law (§ 23).

The use of the sign did not alter the distinctive character of the earlier national mark (§ 28-34).

12/07/2019, T-412/18, [mobile.ro \(fig.\) / mobile \(fig.\)](#), EU:T:2019:516, § 23, 28-34.

❖ Public use in the course of trade

Public use versus internal use

The use must be public, that is to say it must be external and apparent to actual or potential customers of the goods or services. Use in the private sphere or purely internal use within a company or a group of companies does not amount to genuine use (§ 22, 37, 33).

The mark must be used **publicly and outwardly** in the context of commercial activity with a view to economic advantage for the purpose of ensuring an outlet for the goods and services that it represents (§ 39, 38).

09/12/2008, C-442/07, [Radetzky](#), EU:C:2008:696, § 22.

11/03/2003, C-40/01, [Minimax](#), EU:C:2003:145, § 37.

09/09/2015, T-584/14, [ZARA](#), EU:T:2015:604, § 33.

12/03/2003, T-174/01, [Silk Cocoon](#), EU:T:2003:68, § 39.

30/04/2008, T-131/06, [Sonia Sonia Rykiel](#), EU:T:2008:135, § 38.

Outward use of a mark – Relevant public

Outward use does not necessarily imply use aimed at end consumers. For instance, the relevant evidence can validly stem from an **intermediary**, whose activity consists of identifying professional purchasers, such as distribution companies, to which the intermediary sells products it has had manufactured by original producers (§ 25-26).

Relevant evidence can also validly come from a **distribution company** that forms part of a group. Distribution is a method of business organisation that is common in the course of trade and implies use of the mark that cannot be regarded as purely internal use by a group of companies, since the mark is also used outwardly and publicly (§ 32).

21/11/2013, T-524/12, [RECARO](#), EU:T:2013:604, § 25-26.

17/02/2011, T-324/09, [Friboi](#), EU:T:2011:47, § 32.

Genuine use of a mark depends on the market in which the EUTM proprietor pursues its commercial activities and in which it hopes to put its mark to use. Accordingly, for assessing outward use of a mark, the relevant public to which marks are addressed comprises not only end consumers, but also specialists, industrial customers and other professional users (§ 80).

The relevant public does not comprise only the end consumer, but also specialists, industrial customers and other professional users. Genuine use of the mark relates to the market in which its proprietor pursues its commercial activities (§ 38-39).

03/10/2019, T-666/18, [ad pepper \(fig.\)](#), EU:T:2019:720, § 80.

04/04/2019, T-910/16 and T-911/16, [TESTA ROSSA \(fig.\)](#), EU:T:2019:221, § 38-39.

Genuine use for goods or services already marketed or about to be marketed

Use of the mark must **relate to goods or services** already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way. Mere preparation to use the mark, such as the printing of labels, producing of containers, etc., is internal use and, therefore, not use in the course of trade for the present purposes (§ 37).

Genuine use entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way (§ 39, 51, 53).

11/03/2003, C-40/01, [Minimax](#), EU:C:2003:145, § 37.

03/07/2019, C-668/17 P, [Boswelan](#), EU:C:2019:557, § 39, 51, 53.

Commercial activity versus promotional activity

Where the mark is protected for goods or services of **not-for-profit enterprises**, and the mark has been used, the fact that there is no profit motive behind the use is irrelevant: 'The fact that a charitable association does not seek to make profit does not mean that its objective cannot be to create and, later, to preserve an outlet for its goods or services' (§ 17).

Goods and services offered **free of charge** may constitute genuine use when they are offered commercially, that is to say with the intention of creating or maintaining an outlet for those goods or services in the EU, as opposed to the goods or services of other undertakings, and therefore of competing with them (§ 67-68).

The Court held that, where promotional items are handed out as a reward for the purchase of other goods and to encourage the sale of the latter, the mark loses its commercial *raison d'être* for the promotional goods and cannot be considered to have been genuinely used on the market for goods in that class (§ 22).

09/12/2008, C-442/07, [Radetzky](#), EU:C:2008:696, § 17.

09/09/2011, T-289/09, [Omnicare Clinical Research](#), EU:T:2011:452, § 67-68.

15/01/2009, C-495/07, [Wellness](#), EU:C:2009:10, § 22.

❖ Use in relation to goods and services

Use of a sign as a business, company or trade name

Use of a sign as a business, company or trade name can be regarded as trade mark use provided that the relevant goods or services themselves are identified and offered on the market under this sign (§ 55-56).

In general, this is not the case when the business name is merely used as a shop sign (except when proving use for retail services), or appears on the back of a catalogue or as an incidental indication on a label (§ 47).

13/04/2011, T-209/09, [Alder Capital](#), EU:T:2011:169, § 55-56.
18/01/2011, T-382/08, [Vogue](#), EU:T:2011:9, § 47.

In principle, use of the sign as a **company name or trade name**, is not, of itself, intended to distinguish goods or services. The purpose of a **company name** is to identify a company, whereas the purpose of a **trade name or a shop name** is to designate a business that is being run.

Accordingly, where use of a company name, trade name or shop name is limited to identifying a company or designating a business that is being run, such use cannot be considered as being 'in relation to goods or services'.

Use of a business, company or trade name can be regarded as **use 'in relation to goods'** where:

- a party **affixes the sign** constituting its company name, trade name or shop name to the goods or;
- even though the sign is not affixed, the party uses the sign in such a way that a **link is established** between the company, trade or shop name and the goods or services (§ 21-23).

Provided that either of these two conditions is met, the fact that a word element is used as the company's trade name does not preclude its use as a mark to designate goods or services (§ 38).

11/09/2007, C-17/06, [Céline](#), EU:C:2007:497, § 21-23.
13/05/2009, T-183/08, [Jello Schuhpark II](#), EU:T:2009:156, § 31-32.
30/11/2009, T-353/07, [Coloris](#), EU:T:2009:475, § 38.

Use of a sign as a domain name or as part of a domain name

Use of a **sign as a domain name or as part of a domain name** primarily identifies the website as such. However, depending on the circumstances, such use may also be use of a registered mark (this presupposes that it connects to a site on which the goods and services appear).

The mere fact that the opponent has registered a domain name containing the earlier trade mark is not sufficient in itself to prove genuine use of the trade mark. It is necessary for the party to prove that the relevant goods or services are offered under the trade mark contained in the domain name.

EUIPO, [Trade mark guidelines](#), OPPO, Section 6 – Proof of use, Edition 2021.

Most plausible and predictable interpretation of the specification of a trade mark

When determining the extent of the protection of an earlier EU trade mark and assessing the evidence of genuine use of that mark in the context of Article 47(2) EUTMR, if two possible literal interpretations of the specification of that mark exist, but one of them would lead to an absurd result as regards the extent of the protection of the mark, the BoA must opt for the most plausible and predictable interpretation of that specification. It would be absurd to adopt an interpretation of the specification that would have the effect of excluding all of the opponent's goods, leaving only goods for which it has not sought trade mark protection as the goods protected by the earlier EU trade mark (§ 51).

Only when both possible literal interpretations of the list of goods and services designated by an earlier EU trade mark are each equally plausible and predictable, is it appropriate to apply the principle derived from the judgment of 06/04/2017, T-39/16, NANA FINK (fig.) / NANA, EU:T:2017:263, § 48, that the proprietor of an EU trade mark should not gain from the infringement of its obligation to indicate the goods and services with clarity and precision (§ 60).

17/10/2019, T-279/18, [AXICORP ALLIANCE / ALLIANCE et al.](#), EU:T:2019:752, § 51, 60.

Affixing of a trade mark in publications – Scope of protection

Where an earlier mark was registered for *business management* services and used as the title of business magazines, the General Court did not exclude that such use could be considered genuine for the services in question if it were shown that the magazine provides support for the supply of the *business management* services, i.e. if the services are provided through the medium of a magazine. The fact that there is no ‘direct bilateral link’ between the publisher and the recipient of the services does not impair such a finding of genuine use. This is because the magazine is not distributed free of charge, which could lend credibility to the claim that payment of the price of the magazine constitutes remuneration for the service provided (§ 31-35).

The affixing of a trade mark to a magazine, periodical, review, journal or catalogue is, in principle, capable of constituting ‘valid use of the sign’ as a trade mark for the goods and services designated by that mark if the content of the publications confirms use of the sign for goods and services covered by it (§ 67, 51).

05/10/2010, T-92/09, [STRATEGI / Stratégies](#), EU:T:2010:424, § 31-35.

05/02/2020, T-44/19, [TC Touring Club \(fig.\) / TOURING CLUB ITALIANO et al.](#), EU:T:2020:31, § 67.

08/07/2020, T-533/19, [sflooring \(fig.\) / T-flooring](#), EU:T:2020:323, § 51.

Scope of protection of retail sales services

The earlier Spanish mark was registered for retail sales services before the Praktiker judgment (07/07/2005, C-418/02, Praktiker, EU:C:2005:425), which required clarification of the services but did not apply retroactively. There had been a request for proof of use and the BoA found use for retail services for handbags, purses and wallets made from leather, ready-made clothing and footwear.

The GC stated that the term ‘retail sales services’ is not a vague term and covers the retail sale of any goods (§ 39) and endorsed the BoA’s finding of proof of use for retail services for handbags, purses and wallets made from leather, ready-made clothing and footwear (§ 40-41).

26/03/2020, T-653/18, [GIORGIO ARMANI le Sac 11 \(fig.\) / LESAC et al.](#), EU:T:2020:121, § 39, 40-41.

26/03/2020, T-654/18, [le Sac 11 \(fig.\) / LESAC et al.](#), EU:T:2020:122, § 39, 40-41.

Catalogues as a mean of evidence – Homogenous subcategories of goods

The evidence produced to show genuine use of the mark at issue may include catalogues. Unlike the catalogues in the present case, the catalogues submitted in ‘peerstorm’ (08/07/2010, T-30/09, Peerstorm, EU:T:2010:298) were intended for end consumers, contained clear and precise information on the items available, their prices, the shops in which they were sold, and how they were marketed. Therefore, those catalogues alone provided sufficient information as to the place, time, nature and extent of the use of the earlier mark (§ 45-46).

The goods leather and imitation of leather; animal skins, hides designate raw or semi-finished goods: photographs of bags, which are finished goods, cannot constitute evidence of use in that regard (§ 53).

Men and women's denim jeans were the only items of clothing in Class 25 for which there were invoices and evidence of use showing the goods with the signs at issue affixed: insofar as those goods constitute a consistent and homogenous subcategory, the BoA rightly carried out its examination for that specific subcategory (§ 90).

28/05/2020, T-615/18, [D \(fig.\) / D \(fig.\) et al.](#), EU:T:2020:223, § 45-46, 53, 90.

Proof of use for accessories of goods classified in different classes of the Nice Classification

The proprietor is not required to prove genuine use of the trade mark based only on the formal interpretation of the Nice Classification for accessories of goods that are classified in different classes but, in reality, concern the same goods (§ 34). The Nice Classification is, in essence, designed to reflect the needs of the market and not to impose an artificial segmentation of the goods.

28/05/2020, T-681/18, [Stayer \(fig.\)](#), EU:T:2020:222, § 40.

Irrelevance of the classification of goods according to other rules of EU law

The contested mark has been put to genuine use in connection with the goods for which it was registered, namely pharmaceutical products administered by injection for use in moisturising skin and reducing wrinkles in Class 5 (§ 29-32).

The fact that these goods are not classified as pharmaceuticals, that is to say medicines, registered and authorised in accordance with Directive 2001/83/EC on the Community code relating to medicinal products for human use, but rather as other preparations for medical use, within the meaning of that class, namely injectable dermal fillers, regulated by Directive 93/94 is irrelevant. The classification of goods according to other rules of EU law, such as that of guaranteeing the quality of the goods, is not in principle decisive with regard to their classification for the purposes of the registration of an EU trade mark (§ 27-28).

25/06/2020, T-104/19, [Juvéderm](#), EU:T:2020:283, § 27-32.

Means of evidence – Undated evidence – Scope of protection

Undated evidence of use such as labels, photographs of shop windows and posts on social media may be intended to show the range of goods in respect of which the registered mark was used and how that mark was displayed on the contested goods, and therefore do not need to be dated (§ 45).

08/07/2020, T-686/19, [Gnc live well](#), EU:T:2020:320, § 45.

Assessment of proof of use for goods and services – Notion of partial use – Coherent subcategories of goods – Criterion of the purpose and intended use of the goods

From the wording of the last sentence of Article 42(2) CTMR [now Article 47(2) EUTMR] and the principles established by case-law (11/12/2014, C-31/14 P, Premeno, EU:C:2014:2436, § 37, 39) (§ 39-42), it follows that it is important to assess in a concrete manner – principally in relation to the goods for which the proprietor of the earlier mark has submitted proof of use of the earlier mark – whether those goods constitute an independent subcategory in relation to the goods falling within the class of goods concerned, so as to link the goods for which genuine use of the earlier mark has been proved to the category of goods covered by the application for registration of that trade mark (§ 46).

The aim of the criterion of the purpose and intended use of the goods is not to provide an abstract or artificial definition of independent subcategories of goods; it must be applied coherently and specifically (11/12/2014, C-31/14 P, *Premeno*, EU:C:2014:2436, § 37, 39, 41) (§ 50). Accordingly, if the goods concerned have several purposes and intended uses, determining whether a separate subcategory of goods exists, by considering in isolation each of the purposes that those goods may have, will not be possible. Indeed, such an approach would not enable independent subcategories to be identified coherently and would excessively limit the rights of the proprietor of the earlier mark, *inter alia*, in that their legitimate interest in expanding their range of goods or services for which their trade mark is registered would not be sufficiently taken into consideration (§ 51).

16/07/2020, C-714/18 P, *tigha / TAIGA*, EU:C:2019:1139, § 46, 51.

❖ Use in advertising

Genuine use in the form of advertising campaigns

Use in advertising will generally be considered as amounting to genuine use:

- if the volume of advertising is sufficient to constitute genuine public use of the mark; and
- if a relation can be established between the mark and the goods or services for which the mark is registered.

The Court confirmed this approach in the *Minimax* case, where it held that use of the mark must relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, **particularly in the form of advertising campaigns**.

11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, § 37.

❖ Use on the internet

Criteria for the assessment

The standard applied when assessing evidence in the form of printouts from the internet is no stricter than when evaluating other forms of evidence. Consequently, the presence of the trade mark on websites can show *inter alia* the nature of its use or the fact that products or services bearing the mark have been offered to the public. However, the mere presence of a trade mark on a website is, of itself, not sufficient to prove genuine use unless the website also shows the place, time and extent of use or unless this information is otherwise provided.

EUIPO, [Trade mark guidelines](#), OPPO, Section 6 – Proof of use, Edition 2021.

No genuine use for brochure published in the internet

A connection between the website and the number of items sold could not be established where the applicant sought to prove the extent of use of its mark by submitting evidence relating to an advertising brochure published on the internet, which gives general information about its working methods, the ingredients used for its products and the product range since the goods could not be ordered online via the web page.

17/07/2014, C-141/13 P, *Walzer Traum*, EU:C:2014:2089, § 47.

Place of use

❖ Use in the European Union for EUTMs

Territorial scope of use

The Court has indicated that ‘The territorial scope of the use is only one of several factors to be taken into account in the determination of whether that use is genuine or not’ since the use of the mark in non-EU territories cannot be taken into account (§ 38, 30).

Article 42(2) and (3) CTMR [now Article 47(2) and (3) EUTMR] and Rule 22 CTMIR [now Article 10(3) EUTMDR] do not require proof of genuine use in a substantial part of the relevant territory (§ 37, 41).

The territorial scope is only one of several factors that have to be taken into account in assessing whether use of an EU trade mark is genuine. A de minimis rule for establishing whether that factor is satisfied cannot be laid down. It is not necessary that an EU trade mark be used in an extensive geographic area for the use to be deemed genuine, since such a qualification will depend on the characteristics of the goods or services concerned on the corresponding market and, more generally, on all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered (19/12/2012, C-149/11, [Onel / Omel](#), EU:C:2012:816, § 55) (§ 80).

It is not required either that the EUTM be used in a substantial part of the European Union. The possibility that the mark may have been used in the territory of a single Member State must not be ruled out, since the borders of the Member States must be disregarded and the characteristics of the goods or services concerned must be taken into account (§ 80).

19/12/2012, C-149/11, [Onel / Omel](#), EU:C:2012:816, § 38, 30.

04/04/2019, T-779/17, [VIÑA ALARDE / ALARDE](#), EU:T:2019:220, § 37, 41.

07/11/2019, T-380/18, [INTAS / INDAS \(fig.\) et al.](#), EU:T:2019:782, § 80.

❖ Use in the import or export trade

General principles

According to Article 18(1)(b) EUTMR, the affixing of the European Union trade mark to goods or to the packaging thereof in the European Union solely for **export** purposes also constitutes use within the meaning of Article 18(1) EUTMR. The mark has to be used (i.e. affixed to goods or their packaging) in the relevant market that is, the geographical area where it is registered.

Evidence relating only to the **import** of the goods in the relevant area may, depending on the circumstances of the case, suffice as proof of use in this area.

09/07/2010, T-430/08, [Grain Millers](#), EU:T:2010:304, § 33, 40 et seq.

See by analogy regarding proof of use in the course of trade of a sign, on the basis of imports from Romania to Germany.

Criteria applied for goods in transit

The Court has held that **transit**, which consists in transporting goods lawfully manufactured in a Member State to a non-member country by passing through one or more Member States, does not involve any marketing of the goods in question and is therefore not liable to infringe the specific subject matter of the trade mark (§ 27, 19).

Therefore, mere transit through a Member State cannot constitute genuine use of the earlier mark in that territory (§ 62).

23/10/2003, C-115/02, [Rioglass and Transremar](#), EU:C:2003:587, § 27.

09/11/2006, C-281/05, [Diesel](#), EU:C:2006:709, § 19.

09/12/2015, T-354/14, [ZuMEX \(fig.\) / JUMEX](#), EU:T:2015:947, § 62.

Genuine use from the export outside Europe

Genuine use may result from the export to a single operator located outside Europe, who can be an intermediary, for the purpose of selling to the end consumer in a non-EU country. Proof that the products have been put on the market in the non-EU importing country is not required.

04/06/2015, T-254/13, [Stayer](#), EU:T:2015:156, § 57-61.

Time of use

❖ Period of time to be considered in revocation proceedings

Definition of the relevant period – Article 57(2) and (3) CTMR [now Article 64(2) and (3) EUTMR]

In the context of invalidity actions, the contested mark holder may request the applicant for invalidity to submit proof that an earlier mark had been genuinely used during two distinct periods (although they may overlap), that is, firstly, ‘during the period of five years preceding the date of the application for a declaration of invalidity’, and secondly, during the period of five years preceding the *date of filing* or the priority date of the contested mark, provided the earlier mark was already registered for more than five years on this date, Article 57(2) and (3) CTMR [now Article 64(2) and (3) EUTMR].

The Office is not required to determine the relevant periods for the proof of use and to inform the invalidity applicant of them. It is therefore the invalidity applicant’s responsibility to determine the relevant period(s) during which genuine use must be proved (§ 33).

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

Article 57(2) CTMR [now Article 64(2) EUTMR], must be considered a substance provision as regards the definition of periods where genuine use must be proven (§ 20). The second relevant period must be calculated from the date of the first publication of the international registration (§ 40).

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

06/06/2019, T-220/18, [Battistino \(fig.\) / BATTISTA et al.](#), EU:T:2019:383, § 20 and 40.

06/06/2019, T-221/18, [BATTISTINO / BATTISTA et al.](#), EU:T:2019:382, § 20 and 40.

Consideration of circumstances after the relevant period

For assessing genuine use during the relevant period, it is not ruled out that account may be taken of circumstances after that period. Such circumstances may make it possible to confirm or better assess the extent to which the trade mark was used during the relevant period.

03/10/2019, T-666/18, [ad pepper \(fig.\)](#), EU:T:2019:720, § 65-69.

Means of evidence – Documents from just outside the relevant period – Consideration in combination with other evidence for extent of use

Provided that there is proof of use which relates to the relevant period, the documents from just outside that period, far from being irrelevant, can be taken into account and evaluated together with the rest of the evidence, since they can offer proof of real and genuine commercial exploitation of the mark.

08/07/2020, T-686/19, [Gnc live well](#), EU:T:2020:320, § 46.

Means of evidence – Documents from outside the relevant period – No consideration for extent of use

When assessing genuine use of an earlier mark, account may be taken, where appropriate, of evidence produced after the relevant date, in order to better assess the extent of use of the earlier mark during the relevant period (28/02/2019, T-459/18, PEPERO original (fig.) / REPRÉSENTATION D'UN BATÔNNET (fig.), EU:T:2019:119, § 63). However, a sales volume assessment cannot be called into question by taking into account invoices that postdate the relevant period by 3 months.

08/07/2020, T-533/19, [sflooring \(fig.\) / T-flooring](#), EU:T:2020:323, § 56.

Extent of use

General criteria

Extent of use has to be evaluated whether, in view of the market situation in the particular industry or trade concerned, it can be deduced from the material submitted that **the owner has seriously tried to acquire a commercial position in the relevant market**. The trade mark has to be used for goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns (§ 37). This does not mean that the opponent has to reveal the total volume of sales or turnover figures.

Concerning the extent of use made of the earlier mark, account must be taken, in particular, of the **commercial volume** of all the acts of use on the one hand and the **duration** of the period in which those acts of use occurred, as well as the **frequency** of those acts, on the other (§ 35).

11/03/2003, C-40/01, [Minimax](#), EU:C:2003:145, § 37.

08/07/2004, T-334/01, [Hipoviton](#), EU:T:2004:223, § 35.

Interdependence between factors

The assessment entails a **degree of interdependence between the factors** taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa.

08/07/2004, T-203/02, [Vitafruit](#), EU:T:2004:225, § 42.

Continuity of the use is not required

Use does not have to be made during a minimum period of time to qualify as 'genuine'. In particular, **use does not have to be continuous** throughout the relevant period of 5 years. It is sufficient if use was made at the very beginning or end of the period, provided the use was genuine.

16/12/2008, T-86/07, [Deitech](#), EU:T:2008:577.

Decisive threshold

The exact **decisive threshold** proving genuine use cannot be defined out of context. The turnover and volume of sales of the product must always be assessed in relation to all the other relevant factors, such as the volume of business, production or marketing capacity, or the degree of diversification of the undertaking using the trade mark, and the characteristics of the products or services on the relevant market. Use need not always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or services concerned on the corresponding market.

11/03/2003, C-40/01, [Minimax](#), EU:C:2003:145, § 39.
08/07/2004, T-203/02, [Vitafruit](#), EU:T:2004:225, § 42.

Sufficient turnover and figures to prove genuine use

Low turnover and sales, in absolute terms, of a medium- or low-priced product might support the conclusion that use of the trade mark in question is not genuine. However, with regard to expensive goods or an exclusive market, low turnover figures can be sufficient (§ 22). It is, therefore, always necessary to take the characteristics of the market in question into account (§ 51).

The smaller the commercial volume of the exploitation of the mark, the more necessary it is for the opposing party to produce additional evidence to dispel any doubts as to its genuineness (§ 37).

Concerning the ratio between the turnover generated by the sales of products under the earlier mark and the applicant's annual turnover, it should be noted that the degree of diversification of the activities of undertakings operating in one and the same market varies. Moreover, the obligation to produce evidence of genuine use of an earlier trade mark is not designed to monitor the commercial strategy of an undertaking. It may be economically and objectively justified for an undertaking to market a product or a range of products even if their share in the annual turnover of the undertaking in question is minimal (§ 49). Special circumstances, for example, lower sales figures during the initial marketing phase of a product, could be of relevance when assessing the genuineness of use (§ 53). The initial phase of marketing a product may last more than a few months but it cannot be prolonged indefinitely (§ 54-55).

04/09/2007, R 35/2007-2, [DINKY](#), § 22.
08/07/2004, T-334/01, [Hipoviton](#), EU:T:2004:223, § 37, 49, 51, 53.
18/03/2015, T-250/13, [SMART WATER](#), EU:T:2015:160, § 54-55; confirmed 17/03/2016, [C-252/15 P](#), SMART WATER, EU:C:2016:178.

Use by a single client – Sufficient use of the mark within a distribution network

A *de minimis* rule cannot be laid down. Use of the mark by a single client, which imports the products for which the mark is registered, can be sufficient to demonstrate that such use is genuine if it appears that the import operation has a genuine commercial justification for the proprietor of the mark (§ 24 et seq.).

Genuine use is not excluded only because all use involves the same customer, as long as the trade mark is used publicly and outwardly and not solely within the undertaking that owns the earlier trade mark or within a distribution network owned or controlled by that undertaking (§ 36).

27/01/2004, C-259/02, [Laboratoire de la mer](#), EU:C:2004:50, § 24 et seq.
08/07/2004, T-203/02, [Vitafruit](#), EU:T:2004:225, § 50.
08/10/2014, T-300/12, [Fairglobe](#), EU:T:2014:864, § 36.

Circumstantial evidence

Under certain circumstances, even **circumstantial evidence** such as catalogues featuring the trade mark, despite not providing direct information on the quantity of goods actually sold, can be sufficient by themselves to prove the extent of use in an overall assessment.

15/07/2015, T-398/13, [TVR ITALIA \(fig.\) / TVR et al.](#), EU:T:2015:503, § 57-58.
08/07/2010, T-30/09, [Peerstorm](#), EU:T:2010:298, § 42 et seq.

Different types of evidence

No rule of law requires that the proof of genuine use must consist of different types of evidence (§ 26). Genuine use can be proved by invoices only, provided they contain all the relevant indications required by Rule 22(3) CTMIR [now Article 10(3) EUTMDR], notably place, time, extent and nature of use (§ 27).

The differences between the volume of capsules and labels purchased and the number of bottles sold reinforces the assumption that the evidence submitted represents only a sample of invoices (§ 54).

A small volume of products marketed, notably 1 200 bottles of wine for a total value of EUR 4 200 can be considered sufficient to prove actual commercial activity (§ 55, 58-59).

04/04/2019, T-779/17, [VIÑA ALARDE / ALARDE](#), EU:T:2019:220, § 27, 54, 55, 58-59.

Catalogue as a mean of evidence

While a catalogue is not evidence of sales, it is, however, proof that the goods in question have been placed on the market and that those goods have actually been offered for sale to consumers.

27/06/2019, T-268/18, [Luciano Sandrone / DON LUCIANO](#), EU:T:2019:452, § 31.

Use of the mark comparing to the form it has been registered

❖ Use of the mark in the form registered

Joint use with another trade mark

The fact that the relevant public acknowledges the earlier mark, by referring to another mark designating the same products, and which is used jointly, does not mean that the earlier mark itself is not used as a source of identification (§ 74).

The condition of genuine use of a trade mark may be fulfilled when it is used in conjunction with another trade mark, provided that the mark continues to be regarded as an indication of the origin of the product in question (§ 97).

28/02/2019, T-459/18, [PEPERO original \(fig.\) / REPRÉSENTATION D'UN BATÔNNET \(fig.\)](#), EU:T:2019:119, § 74, 97.

Graphic additions for words marks

Word marks are considered to be used as registered insofar as the graphic additions do not alter the general impression that they produce.

27/06/2019, T-268/18, [Luciano Sandrone / DON LUCIANO](#), EU:T:2019:452, § 42.

Addition of the company name

The fact that the company name or the trade name of the proprietor of the earlier mark is also depicted in the representation of that mark is not such as to alter its distinctive character, since the earlier mark may clearly be perceived independently in a form that does not differ from that in which it is registered.

21/11/2019, T-527/18, [tec.nicum \(fig.\) / T TECNIUM \(fig.\)](#), EU:T:2019:798, § 34.

Registration without colour claim – Modification of banal colours – No alteration of the distinctive character of the mark

Since the earlier mark was registered without any colour claim, its representation in colour does not alter the distinctive character of the mark as registered, because the registration covers all possible colour combinations.

15/10/2019, T-582/18, [X BOXER BARCELONA \(fig.\) / X \(fig.\) et al.](#), EU:T:2019:747, § 44.

Modification of colours – No alteration of the distinctive character of the mark

The fact that the signs as used contain two separate word components ('ad' and 'pepper') is not in itself capable of affecting the distinctive character of the contested trade mark, since the relevant public will break the word down into elements that have a concrete meaning for it or that resemble words it knows (§ 39-40).

The use of different colours that are not particularly original is neither distinctive nor dominant and does not have the effect of altering a mark as registered. The figurative element of three crooked chilli peppers plays only a secondary role in the signs used by the proprietor (§ 46-50).

Whether the signs are written in upper or lower case is irrelevant, since word marks that differ only in this respect are considered to be identical (§ 55).

The additional verbal elements 'Germany', 'digital pioneers since 1999' and 'the e-advertising network' do not affect the distinctive character of the trade mark since they are placed underneath the actual sign and will be perceived by the public as descriptive additions (§ 60-68). Therefore, overall, these forms of use differ only in negligible elements from the form of the trade mark as registered (§ 69).



03/10/2019, T-666/18, [ad pepper \(fig.\)](#), EU:T:2019:720, § § 39-40, 45-50, 55, 60-68, 69.

The figurative elements in the earlier mark are limited to the presentation of the word 'brownies' in a yellow stylised font, the dot on the letter 'i' in the form of a flower and, sometimes, an uneven border (§ 66).

The word 'brownies' remains the distinctive element in the sign thus stylised and, consequently, its use in that form is to be considered use of the earlier mark (§ 68).

The fact that a figurative mark, while having a certain distinctive character, may also be used to decorate the product bearing it does not affect its ability to fulfil the essential function of a mark. That is especially true in the clothing sector, where it is not unusual for products to bear a stylised form of a mark (§ 69).



30/01/2020, T-598/18, [BROWNIE / BROWNIE, Brownie \(series mark\)](#), EU:T:2020:22, § 66, 68-69.

❖ Use of the mark in forms different from that registered

General principles

Article 18 EUTMR states that use of the mark in a form different from that registered still constitutes use of the trade mark as long as the differing elements do not alter the distinctive character of the trade mark, regardless of whether or not the trade mark in the form as used is also registered in the name of the proprietor.

The purpose of this provision is to allow its proprietor to make variations in the sign that, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned.

The General Court further mentioned that strict conformity between the sign as used and the sign registered is not necessary. However, the difference must be in negligible elements and the signs as used and registered must be broadly equivalent

23/02/2006, T-194/03, [Bainbridge](#), EU:T:2006:65, § 50.

The General Court has held that:

the assessment of the distinctive or dominant character of one or more components of a complex trade mark must be based on the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (§ 36).

With regard to **additions**:

- several signs may be used simultaneously without altering the distinctive character of the registered sign (§ 34);
- if the addition is not distinctive, is weak and/or is not dominant, it does not alter the distinctive character of the registered trade mark (§ 29-33 et seq.; 36 et seq.).

With regard to **omissions**:

- if the omitted element is in a secondary position and not distinctive, its omission does not alter the distinctive character of the trade mark (§ 37).

08/12/2005, T-29/04, [Cristal Castellblanch](#), EU:T:2005:438, § 34.

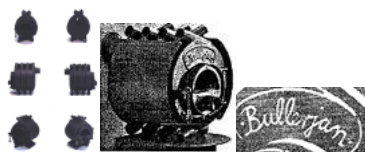
24/11/2005, T-135/04, [Online Bus](#), EU:T:2005:419, § 36-37.

30/11/2009, T-353/07, [Coloris](#), EU:T:2009:475, § 29-33 et seq.

10/06/2010, T-482/08, [Atlas Transport](#), EU:T:2010:229, § 36 et seq.

Joint use of a shape mark with a word mark

The use of a three-dimensional mark consisting of the shape of an oven together with the word mark **Bullerjan** is liable to alter the distinctive character of the shape mark unless the word part of the mark is comparatively less distinctive. This was not the case because it was found that the shape was particularly unusual, partly due to functional characteristics which contributed to its distinctive character.



23/01/2019, C-698/17 P, [SHAPE OF AN OVEN \(3D MARK\)](#), EU:C:2019:48, § 31-34, 40-45.

Addition of distinctive elements – Addition of a ‘house mark’ – Alteration of the distinctive character of the mark

The way in which the combination ‘air blue’ or ‘air blue 100’ is used in the evidence submitted alters the distinctive character of the contested mark AIR as registered (§ 32). While the word ‘blue’ is often used on the tobacco market by various manufacturers, there is no evidence that the relevant public would perceive that word or the colour blue as having a descriptive purpose indicating a milder taste. The fact that the word ‘blue’ appears on invoices in the abbreviated form ‘bl’ does not demonstrate any descriptiveness in relation to the contested goods since the descriptive character must be assessed in relation to the goods and not the details on the invoices. Moreover, the recipients of invoices are professionals and not the general public in relation to which the genuine use of the contested mark must be assessed (§ 30).

The element ‘memphis’ is always clearly visible in a dominant position in the overall impression produced by the trade mark as used. Even if that element were a ‘house mark’, it would not call into question the fact that that word alters the distinctive character of the contested mark AIR, since the relevant public no longer perceives the element ‘air’ as an indication of the origin of the goods in question (18/07/2013, C-252/12, Specsavers, EU:C:2013:497, § 26) (§ 35).



08/07/2020, T-800/19, [Air](#), EU:T:2020:324, § 30, 32, 35.

Use of a three-dimensional mark

The three-dimensional character of a mark precludes a static vision, in two dimensions, and commands a dynamic perception, in three dimensions. Therefore, the representations in perspective, and in any position, of the product (the shape of which embodies the earlier mark) are of real relevance for the purpose of appreciating its serious use and cannot be disregarded simply because they do not constitute two-dimensional reproductions of the shape.

28/02/2019, T-459/18, [PEPERO original \(fig.\) / REPRÉSENTATION D'UN BATÔNNET \(fig.\)](#), EU:T:2019:119, § 93.

Use for the goods or services for which the mark is registered, categories and subcategories

Subcategories of goods and services for proof of genuine use

When defining subcategories for which genuine use of the mark was shown, the purpose of the goods and services is a relevant factor (§ 44). The goods are dissimilar when the relevant consumers do not overlap (§ 55).

07/02/2019, T-789/17, [TecDocPower / TecDoc \(fig.\) et al.](#), EU:T:2019:70, § 44, 55.

Wine – Designation of origin of a wine

The designation of origin of a wine cannot be considered to be of systemic importance in determining whether wines with different designations of origin may constitute sufficiently defined and independent subcategories within the category ‘wines’.

30/06/2015, T-489/13, [VIÑA ALBERDI / VILLA ALBERTI](#), EU:T:2015:446, § 37.
17/01/2019, T-576/17, [EL SEÑORITO / SEÑORITA](#), EU:T:2019:16, § 45-46.

Partial genuine use

If a trade mark has been registered for a category of goods or services which is sufficiently broad to be divided into subcategories capable of being viewed independently, proof that the mark has been genuinely used in relation to a part of those goods or services affords protection only for the subcategory or subcategories to which the goods or services for which the trade mark has actually been used belong (§ 47).

The category of printed matter is broad enough to be subdivided (§ 52). The subcategory of printed matter printed with individual photos is sufficiently homogeneous (§ 53). Therefore, the protection of the contested trade mark is restricted to the subcategory printed matter printed with individual photos (§ 55).

11/04/2019, T-323/18, [DARSTELLUNG EINES SCHMETTERLINGS \(fig.\)](#), EU:T:2019:243, § 47, 52-53, 55.

Necessity to break down wide range of goods and services into subcategories for proof of genuine use – Reference to the explanatory note to the Nice Agreement – Partial genuine use

The evidence provided in the context of revocation proceedings is valid insofar as it allows clear inferences to be drawn as to the criteria provided for in Article 10(3) EUTMDR (§ 40).

The explanatory note to the Nice Agreement states that Class 20 ‘includes mainly ... plastic goods, not included in other classes’ (§ 55). With respect to the plastic goods that are not included in other classes, as is the case with ‘urns’, the sale of those goods cannot constitute proof of genuine use with respect to a category as broad as ‘articles made of plastics’ or ‘goods of water-soluble, biodegradable and compostable plastic’ (§ 56). The requirement for proof of genuine use seeks to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services (§ 57).

The contested mark’s goods in Class 20 should have been divided into subcategories and a separate analysis of the evidence provided in relation to each of those subcategories should have been carried out (§ 58).

29/04/2020, T-78/19, [green cycles \(fig.\)](#), EU:T:2020:166, § 40, 57, 58.

Use by the proprietor or on its behalf

❖ Use by the proprietor

According to Articles 18(1) and 47(2) EUTMR, it is in general the owner who has to put the earlier registered mark to genuine use. These provisions also cover use of the mark by the previous owner during its ownership.

10/12/1999, B 74 494.

❖ Use by authorised third parties

According to Article 18(2) EUTMR, use of the mark with the consent of the proprietor is deemed to constitute use by the proprietor. This means that the owner must have given its consent **prior** to the use of the mark by the third party. Acceptance later is insufficient.

Authorised use by companies economically related and distributors

Use by companies **economically related** to the trade mark proprietor, such as members of the same group of companies (affiliates, subsidiaries, etc.) is similarly to be considered as authorised use (§ 38).

Where goods are produced by the trade mark proprietor (or with its consent), but subsequently placed on the market by **distributors** at wholesale or retail level, this is to be considered as use of the mark (§ 32; § 73).

30/01/2015, T-278/13, [now](#), EU:T:2015:57, § 38.
17/02/2011, T-324/09, [Friboi](#), EU:T:2011:47, § 32.
16/11/2011, T-308/06, [Buffalo Milke](#), EU:T:2011:675, § 73.

Presumption of use by third parties

At the **evidence** stage it is prima facie sufficient that the opponent only submits evidence that a third party has used the mark. The Office infers from such use, combined with the opponent's ability to present evidence of it, that the opponent has given prior consent.

The Court pointed out that it was unlikely that the proprietor of a trade mark would be in a position to submit evidence if the mark had been used against its wishes. There was all the more reason to **rely on that presumption**, given that the applicant did not dispute the opponent's consent.

08/07/2004, T-203/02, [Vitafruit](#), EU:T:2004:225, § 25.
Further confirmed 11/05/2006, C-416/04 P, [Vitafruit](#), EU:C:2006:310.

Article 47(2) EUTMR – Justification of non-use

General criterion – Establishment of a direct relationship

According to Article 47(2) EUTMR, the opponent may alternatively prove that there are justifiable reasons for non-use of its earlier registered mark. These reasons cover, as mentioned in the second sentence of Article 19(1) of the TRIPS agreement, circumstances arising independently of the will of the owner of the trade mark that constitute an obstacle to the use of the trade mark.

As an exception to the obligation of use, the concept of proper reasons for non-use is to be interpreted rather narrowly.

'Bureaucratic obstacles' as such, that arise **independently of the will** of the trade mark proprietor, are not sufficient, unless they have a **direct relationship** with the mark, so much so that use of the trade mark depends on successful completion of the administrative action concerned.

The criterion of a direct relationship does not necessarily imply that use of the trade mark is impossible; it might suffice that use is **unreasonable**. It must be assessed on a case-by-case basis whether a change in the undertaking's strategy to circumvent the obstacle under consideration would make use of the mark unreasonable. Thus, for example, the proprietor of a mark cannot reasonably be required to change its corporate strategy and sell its goods in its competitors' sales outlets.

14/06/2007, C-246/05, [Le Chef de Cuisine](#), EU:C:2007:340, § 52.

Defensive registration

The General Court has clarified that the existence of a national provision recognising what are known as 'defensive' registrations (i.e. of signs not intended to be used in trade on account of their purely defensive function in relation to another sign that is being commercially exploited) cannot constitute a proper reason for non-use of an earlier trade mark invoked as a basis of an opposition.

23/02/2006, T-194/03, [Bainbridge](#), EU:T:2006:65, § 46.

Obstacles in sufficiently direct relationship with the trade mark

Only obstacles having a sufficiently direct relationship with a trade mark making its use impossible or unreasonable, and which arise independently of the will of the proprietor of that mark, may be described as 'proper reasons for non-use' of that mark. It must be assessed on a case-by-case basis whether a change in the strategy of the undertaking to circumvent the obstacle under consideration would make the use of that mark unreasonable.

03/07/2019, C-668/17 P, [Boswelan](#), EU:C:2019:557, § 66-73.

CHAPTER III. DESIGNS

Article 3(a) / 9 CDR – Registration proceedings

The background in a view is considered neutral as long as the design shown in this view is clearly distinguishable from its environment without interference from any other object, accessory or decoration, whose inclusion in the representation could cast doubt on the protection sought.

The requirement of a neutral background demands neither a ‘neutral’ colour nor an ‘empty’ background (see paragraph 5.2.10 below). Instead, what is decisive is that the design stands out sufficiently clearly from the background to remain identifiable.

16/04/2012, R 2230/2011-3, [Webcams](#), § 11-12.
13/09/2017, R 1211/2016-3, [Tavoli](#), § 61.

Article 25(1)(b) CDR – Invalidity proceedings

Scope of the examination

When the ground for invalidity relied on is Article 25(1)(b) CDR, it does not mean that the Office has to automatically examine all the requirements set out in Articles 4 to 9 EUTMR (§ 51), since those requirements are cumulative and the non-fulfilment of one of them can lead to the invalidity of the design (§ 54, 67).

The requirements set out in Articles 4 to 9 CDR relate to different legal criteria and, therefore, the facts and evidence submitted to prove the infringement of one are not necessarily relevant to the others (§ 68).

10/06/2020, T-100/19, *Acoplamientos para vehículos*, EU:T:2020:255, § 54, 67-68.

Application for a declaration of invalidity

When the application for a declaration of invalidity is based on the lack of novelty and individual character of the RCD, it must contain, *inter alia*, the indication and reproduction of the prior designs that could form an obstacle to the novelty or individual character of the RCD and documents proving their existence (§ 24).

Making reference to previous decisions, without elaborating further, does not satisfy the requirement to demonstrate the existence of a prior design identical to the contested design (§ 29).

It is for the applicant to make sure that all prior designs relied on are clearly identified and reproduced, given that invalidity proceedings are *inter partes* proceedings (§ 30).

17/09/2019, T-532/18, [Washing sponges](#), EU:T:2019:609, § 24, 29-30.

Lack of reasoning — Article 63 CDR — Scope of the examination in invalidity proceedings

The interpretation of Article 95 EUTMR is applicable, *mutatis mutandis*, to the examination to be carried out by the Office in invalidity proceedings pursuant to Article 63 CDR: the applicant for a declaration of invalidity must provide elements to show that the contested design does not fulfil the requirements set out in Articles 4 to 9 CDR (§ 70-71).

The dismissal of the appeal reflects a complete turnabout in the BoA's position on the application of Article 4(2) and (3) CDR to the contested RCD, as compared to the position indicated in its communication to the parties during the appeal proceedings. The BoA was obliged to clearly state the reasons for that change (§ 114), since that communication, and the subsequent observations submitted by the parties, were part of the context in which it adopted the contested decision (§ 124). Without those reasons, the applicant is not in a position to meaningfully challenge the BoA's departure from the conclusions in its communication (§ 116) and the GC is not in a position to verify the merits of those reasons or to carry out its review properly (§ 117).

10/06/2020, T-100/19, [Acoplamiento para vehículos](#), EU:T:2020:255, § 70-71, 114, 116-117, 124.

The different grounds for Invalidity – Common principles

The Community design must be compared individually with each and every earlier design relied on by the applicant. Novelty and individual character of a Community design cannot be defeated by combining features taken in isolation and drawn from a number of earlier designs, but by one or more earlier designs, taken individually.

21/09/2017, C-361/15 P and C-405/15 P, [Shower drains](#), EU:C:2017:720, § 69.

19/06/2014, C-345/13, [Karen Millen Fashions](#), EU:C:2014:2013, § 23-35.

22/06/2010, T-153/08, [Communications equipment](#), EU:T:2010:248, § 23-24.

Article 8(1) Regulation (EC) No 6/2002 – Features of appearance of a product solely dictated

Article 8(1) of Regulation No 6/2002 excludes protection on Community designs for features of appearance of a product where considerations other than the need for that product to fulfil its technical function, in particular those related to the visual aspect, have not played any role in the choice of those features, even if other designs fulfilling the same function exist (points 22-29, 31, 32, operative part 1).

Article 8(1) of Regulation No 6/2002 must be interpreted as meaning that, in order to determine whether the relevant features of appearance of a product are solely dictated by its technical function, within the meaning of that provision, the national court must take account of all the objective circumstances relevant to each individual case. In that regard, there is no need to base those findings on the perception of an 'objective observer'.

As the Advocate General stated in essence, in points 66 and 67 of his Opinion, such an assessment must be made, in particular, having regard to the design at issue, the objective circumstances indicative of the reasons which dictated the choice of features of appearance of the product concerned, or information on its use or the existence of alternative designs which fulfil the same technical function, provided that those circumstances, data, or information as to the existence of alternative designs are supported by reliable evidence (points 37, 38, operative part 2).

08/03/2018, C-395/16, [DOCERAM](#), EU:C:2018:17

Technical function of the product

In order to determine whether the essential features of the appearance of the product into which the contested Community design will be incorporated are solely dictated by the technical function of the product, it is necessary to determine what the technical function of that product is. The relevant indication in the application for registration of the design (Article 36(2) CDR) should be taken into account, but also the design itself, insofar as it makes clear the nature of the product, its intended purpose or its function.

18/03/2010, T-9/07, [Metal rappers](#), EU:T:2010:96, § 56.

When the design is applied to a complex product, the answer to the question of whether those features are 'solely dictated by the technical function of the product' pursuant to Article 8(1) CDR, requires, at the outset, an examination of the technical function of each of those features and an examination of the causal link between the technical function of each of those features and the technical function of the product concerned. When there is a causal link between the technical function of the feature and the technical function of the product, that is to say where that feature does contribute to the technical function of the product, that feature is 'solely dictated' by the technical function of the product (§ 54).

The fact that the product concerned contains several features, each of which fulfils a different function, does not exclude the application of Article 8(1) CDR: that provision does not require the features of the appearance to refer to one single technical result, and the features may produce several technical results, as long as they contribute to achieving the technical result intended by the product (§ 56).



18/11/2020, T-574/19, [fluid distribution equipment](#), EU:T:2020:543, § 16, 54, 56.

Article 5 – Novelty / Article 6 – Individual character / Article 7

Burden of proof on the applicant for a declaration of invalidity – Requirements relating to the reproduction of an earlier design

It is for the invalidity applicant to identify what the “earlier design” is, and not for the Office to deduce it from the evidence. In this case, the GC erred in criticising the BoA for not having compared the contested RCD with “the entirety of the liquid drainage device” marketed by the invalidity applicant. The GC thus erred in law when requiring the Office to combine extracts from various catalogues in order to identify the earlier design. According to Article 63(1) CDR, in proceedings relating to a declaration of invalidity the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties.

21/09/2017, C-361/15 P and C-405/15 P, [Shower drains](#), EU:C:2017:720, , § 56-60

The informed user

The concept of the 'informed user' must be understood as lying somewhere between that of the average consumer, applicable in trade mark matters, who need not have any specific knowledge and who, as a rule, makes no direct comparison between the trade marks in conflict, and the sectoral expert, who is an expert with detailed technical expertise. Thus, the concept of the informed user may be understood as referring, not to a user of average attention, but to a particularly observant one, either because of his personal experience or his extensive knowledge of the sector in question.

The very nature of the informed user means that, when possible, he will make a direct comparison between the designs at issue. However, it is conceivable that such a comparison may be impracticable or uncommon in the sector concerned, in particular because of specific circumstances or the characteristics of the devices which the designs represent. There being no precise indications to that effect in the context of Regulation No 6/2002 on Community designs, the Union legislature cannot be regarded as having intended to limit the assessment of potential designs to a direct comparison.

As regards the informed user's level of attention, although the informed user is not the well-informed and reasonably observant and circumspect average consumer who normally perceives a design as a whole and does not proceed to analyse its various details, he is also not an expert or specialist capable of observing in detail the minimal differences that may exist between the designs in conflict. Thus, the qualifier 'informed' suggests that, without being a designer or a technical expert, the user knows the various designs which exist in the sector concerned, possesses a certain degree of knowledge with regard to the features which those designs normally include, and, as a result of his interest in the products concerned, shows a relatively high degree of attention when he uses them.

21/09/2017, C-361/15 P and C-405/15 P, [Shower drains](#), EU:C:2017:720,

Assessment of novelty

The CJ criticised the GC for holding that, where a design is made up of several elements, it must be considered disclosed where those elements were disclosed, even separately, provided it is clear that these elements are intended to be combined in order to constitute a predetermined product. The CJ clarified that the contested design must be compared with earlier individualised and defined designs and not with a combination of designs that have already been made available to the public (para 61, 65, 69). However, the CJ did not invalidate the contested judgment since its operative part is well founded in other legal grounds (paras 73 to 77).

21/09/2017, C-361/15 P and C-405/15 P, [Shower drains](#), EU:C:2017:720, , § 73-77

Informed user – Individual character – Different overall impression

The informed user of vehicles is aware that manufacturers regularly submit their models to technical and visual restyling (§ 28).

If differences are sufficiently clear to conclude that the design produces a different overall impression on the informed user, a weighting of each of the characteristics and an analysis of common points is not required (§ 45).

The freedom of motor vehicle designers is limited to the extent that a motor vehicle's purpose is to transport people or products and is subject to certain legal requirements which oblige it to include elements such as headlights, stop lights, indicators and mirrors (§ 48).

Potential market expectations or certain design trends do not constitute relevant limitations on the freedom of the designer (§ 52).

06/06/2019, T-191/18, [Kraftfahrzeuge](#), EU:T:2019:378, § 28, 45, 48, 52.

Conflict of design with prior design – No individual character – No different overall impression

The classification of the products may contribute to establishing the overall impression produced by that design on the informed user for the purpose of assessing whether it has individual character in relation to an earlier design (§ 28).

The presence of visible foodstuffs inside the products in which the contested design is intended to be incorporated merely provides a better illustration of their purpose, namely as packaging for foodstuffs, as well as one of their components, specifically the transparent lid (§ 31).

The comparison of the overall impressions produced by the designs must relate solely to the elements actually protected (13/06/2017, T-9/15, Dosen [für Getränke], EU:T:2017:386, § 79). The protection conferred by the contested design relates to its appearance in that it is intended to be incorporated into packaging for foodstuffs having certain components with specific characteristics, namely a metal container that has a transparent lid with a translucent tab. The foodstuffs inside the container must not therefore be taken into consideration for the purpose of assessing the ‘overall impression’ (§ 33).

The assessment of the overall impression produced on the informed user by a design includes the manner in which the product represented by that design is used (21/11/2013, T-337/12, Sacacorchos, EU:T:2013:601, § 46). Accordingly, the informed user of the contested design, whether a consumer of the preserves or a professional of the food processing industry, will assess that design according to the purpose of the products, namely as packaging for foodstuffs, and will be able to differentiate between that packaging and its contents. Therefore, the appearance of the foodstuffs contained in the packaging in which the contested design is intended to be incorporated, as well as their specific arrangement inside that packaging, is not relevant for the purpose of assessing the overall impression produced on the informed user by the contested design (§ 40).

12/03/2019, T-352/19, [Packaging for foodstuffs](#), EU:T:2020:94, § 28, 31, 33, 40.

Disclosure of earlier design

For the purpose of Article 7 CDR, it is immaterial whether or not an earlier ‘design’ within the meaning of Article 3(a) CDR enjoys or enjoyed legal protection (as a design, trade mark, copyright work, patent, utility model or otherwise)

It is clear from Article 7(1) of Regulation No 6/2002 on Community designs, that a design is deemed to have been made available once the party relying thereon has proven the events constituting disclosure. In order to refute that presumption, the party challenging the disclosure must establish to the requisite legal standard that the circumstances of the case could reasonably prevent those facts from becoming known in the normal course of business to the circles specialised in the sector concerned.

Events taking place outside the EU – Criteria for assessment

Moreover, the presumption provided for in Article 7(1) of Regulation No 6/2002 applies wherever the events constituting disclosure took place, since it can be seen from the wording of the first sentence of that article that it is not necessary, in order for a design to be deemed to have been made available to the public for the purpose of applying Articles 5 and 6 of that regulation, for the events constituting disclosure to have taken place within the European Union.

The question whether events taking place outside the European Union could reasonably have become known to the persons forming part of the circles specialised in the sector concerned is a question of fact; the answer to that question is dependent on the assessment of the particular circumstances of each individual case.

In order to carry out that assessment, it must be examined whether, on the basis of the facts, which must be adduced by the party challenging the disclosure, it is appropriate to consider that it was not actually possible for those circles to be aware of the events constituting disclosure, whilst bearing in mind what can reasonably be required of those circles in terms of being aware of prior art. Those facts may concern, for example, the composition of the specialised circles, their qualifications, customs and behaviour, the scope of their activities, their presence at events where designs are presented, the characteristics of the design at issue, such as their interdependency with other products or sectors, and the characteristics of the products into which the design at issue has been integrated, including the degree of technicality of the product concerned. In any event, a design cannot be deemed to be known in the normal course of business if the circles specialised in the sector concerned can become aware of it only by chance (§ 26-29).

Earlier design not produced – Effect – Conditions

Article 7(1) of Regulation No 6/2002 on Community designs does not impose any requirement that the earlier design relied on by the opposing party must have been used for the manufacture or marketing of a product.

However, the fact that a design has never been incorporated into a product is significant only where the applicant has established that the circles specialised in the sector concerned do not generally consult patent registers or that the circles specialised in the sector concerned do not generally attach any weight to patents. In such scenarios, the argument that there are no umbrellas covered by the earlier patent on the market may make faintly plausible the fact that the earlier patent may have been known to the circles specialised in the sector concerned through other forms of information (§ 36, 37).

21/05/ 2015, T-22/13 & T-23/13, [UMBRELLAS](#), EU:T:2015:310, § 24, 26-29, 36,37.

Means of evidence – Proof of disclosure

To establish that there has been disclosure of an earlier design, it is necessary to carry out a two-stage analysis to examine: 1) whether the evidence submitted in the application for a declaration of invalidity shows, firstly, that there have been events constituting disclosure of a design and, secondly, that that disclosure occurred before the date of filing or priority of the contested design; 2) if the holder of the contested design has claimed the contrary, whether those events could reasonably have become known in the normal course of business to the specialised circles of the sector concerned operating within the EU, failing which, a disclosure will be considered to have no effect and will not be taken into account (§ 20).

The disclosure of an earlier design cannot be proved by means of probabilities or presumptions but must be demonstrated by solid objective evidence of actual disclosure of the earlier design on the market. In addition, the items of evidence provided by the applicant for a declaration of invalidity must be assessed in relation to each other. Although some of the items of evidence might be insufficient on their own, when combined or read in conjunction with other documents or information, they may contribute to establishing disclosure. Lastly, in order to assess the evidential value of a document, it is necessary to verify the plausibility and the accuracy of the information contained in that document (§ 22).

27/02/2020, T-159/19, [Furniture](#), EU:T:2020:77, § 20, 22.

Establishing the event of disclosure

The Invalidity Division will carry out an overall assessment of such evidence by taking account of all the relevant factors in the particular case. An event of disclosure cannot be proven by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient disclosure of the earlier design.

09/03/2012, T-450/08, [Phials](#), EU:T:2012:117, § 21-24.

In order to assess the evidential value of an affidavit, regard should be had first and foremost to the credibility of the account it contains. It is then necessary to take account, in particular, of the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, on the face of it, the document appears sound and reliable.

09/03/2012, T-450/08, [Phials](#), EU:T:2012:117, § 39-40.

Article 25(1)(d) CDR

Conflict with a prior design right

Article 25(1)(d) CDR must be interpreted as meaning that a Community design is in conflict with a prior design when, taking into consideration the freedom of the designer in developing the Community design, the design does not produce on the informed user a different overall impression from that produced by the prior design relied on.

18/03/2010, T-9/07, [Metal rappers](#), EU:T:2010:96, § 52.

Article 25(1)(e) CDR

Right to prohibit use

The applicant must establish only that it has a right to prohibit use of the subsequent Community design. It cannot be required to establish that such right has been exercised; in other words, that the applicant has actually been able to prohibit such use.

By analogy, 29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 191.

Use in a subsequent design

The notion of 'use in a subsequent design' does not necessarily presuppose a full and detailed reproduction of the earlier distinctive sign in a subsequent Community design. Even though the Community design may lack certain features of the earlier distinctive sign or may have different additional features, this may constitute 'use' of that sign, particularly where the features omitted or added are of secondary importance and are unlikely to be noticed by the relevant public. It is enough that the Community design and the earlier distinctive sign be similar.

12/05/2010, T-148/08, [Instruments for writing](#), EU:T:2010:190, § 50-52.

25/04/2013, T-55/12, [Cleaning devices](#), EU:T:2013:219, § 23.

09/08/11, R 1838/2010-3, [INSTRUMENTS FOR WRITING](#), § 43.

Where a Community design includes a distinctive sign without any disclaimer making clear that protection is not sought in respect of such feature, it will be considered that the Community design makes use of the earlier distinctive sign even if the latter is represented in only one of the views.

18/09/2007, R 137/2007-3, [Containers](#), § 20.

Article 25(1)(f) CDR – Unauthorised use of a work protected under the copyright law of a Member State

Works for the purposes of applying Article 25(1)(f) CDR

The works invoked for the purposes of applying Article 25(1)(f) CDR cannot be an accumulation of the stylised versions of a product during various decades (§ 101).

The characteristics listed by the French and Italian judgments, recognising that the work corresponding to the earlier design deserves protection as copyright, are not present in the contested design (§ 94, 104-105).

24/09/2019, T-219/18, [Ciclomotori](#), EU:T:2019:681, § 94, 101, 104-105.

CHAPTER IV. COPYRIGHT

COPYRIGHT AND RELATED RIGHTS

Article 2 to 5 Directive 2001/29/EC

Copyright protection of works – Connection with the protection of designs

Article 2(a) Directive 2001/29/EC must be interpreted as precluding national legislation from conferring protection, under copyright, to designs such as the clothing designs at issue in the main proceedings, on the ground that, over and above their practical purpose, they generate a specific, aesthetically significant visual effect (§ 58).

The subject matter protected as a design was not as a general rule capable of being treated in the same way as a subject matter constituting works protected by Directive 2001/29/EC. The principle of the system laid down in the EU is that the protection reserved for designs and the protection ensured by copyright are not mutually exclusive (§ 40, 43). Such cumulative and concurrent protection of the same subject matter can be envisaged only in certain situations (§ 52).

12/09/2019, C-683/17, [Cofemel](#), ECLI:EU:C:2019:721, § 40, 43, 52, 58.

Copyright protection of works – Shape of the product which is necessary to obtain a technical result – Folding bicycle

Articles 2 to 5 of Directive 2001/29/EC must be interpreted as meaning that the copyright protection provided for therein applies to a product whose shape is necessary (at least in part) to obtain a technical result, but where that product is also an original work resulting from intellectual creation because, through its shape, its author expresses their creative ability in an original manner by making free and creative choices so that the shape reflects their personality. It is for the national court to verify this, bearing in mind all the relevant aspects of the dispute in the main proceedings.

11/06/2020, C-833/18, [Folding bicycle](#), EU:C:2020:461, § 39.

Article 3(1) Directive 2001/29/EC / Article 8(2) Directive 2006/115/EC

Concept of ‘communication to the public’

Article 3(1) of Directive 2001/29/EC on the harmonisation of certain aspects of copyright and related rights in the information society and Article 8(2) of Directive 2006/115/EC on rental right and lending right and on certain rights related to copyright in the field of intellectual property must be interpreted as meaning that the hiring out of motor vehicles equipped with radio receivers does not constitute a communication to the public within the meaning of those provisions.

02/04/2020, C-753/18, [Stim and SAMI](#), EU:C:2020:268, § 41.

CMOs

One CMO per one category of rights

Article 3(a) of Directive 2014/26/EU of the European Parliament and of the Council of 26 February 2014 on collective management of copyright and related rights and multi-territorial licensing of rights in musical works for online use in the internal market defines a collective management organisation as ‘any organisation which is authorised by law or by way of assignment, licence or any other contractual arrangement to manage copyright or rights related to copyright on behalf of more than one rightholder, for the collective benefit of those rightholders, as its sole or main purpose, and which fulfils one or both of the following criteria: (i) it is owned or controlled by its members; (ii) it is organised on a not-for-profit basis.’

Determination of CMO royalties

Articles 30 and 36, EEC Treaty – National legislation permitting the charging of a supplementary reproduction royalty not provided for in the Member State of origin

Articles 30 and 36 of the Treaty of Rome do not preclude the application of national legislation allowing the charging of a ‘supplementary mechanical reproduction fee’ by a copyright management society in addition to a performance royalty, on the public performance of sound recordings. The aggregation of a supplementary mechanical reproduction fee to a performance fee may take place regardless of whether such a supplementary fee is provided for in the Member State where the sound recordings were lawfully placed on the market.

09/04/1987; C-402/85; [Basset](#); ECLI:EU:C:1987:197, § 13-17

Article 86 EEC Treaty – Article 102 TFEU – Abuse of dominant position – Copyright management society enjoying a de facto monopoly

The fact that a copyright management society charges a supplementary mechanical performance fee does not constitute an improper advantage of a dominant position and is thus not prohibited under Article 86 of the Treaty of Rome.

09/04/1987; C-402/85; [Basset](#); ECLI:EU:C:1987:197, § 20-21

The remuneration model used by a copyright management company, which has a de facto monopoly, seeking the payment of royalties from the organisers of music festivals for the use of musical works in its repertoire does not constitute an abuse of dominant position because the objective pursued, that is the protection of copyright, was legitimate.

Article 102 of the Treaty on the Functioning of the European Union must be interpreted as meaning that the imposition of a remuneration model for the use of copyright-protected works based inter alia on turnover by a copyright management company, which has a de facto monopoly in a Member State, does not constitute an abuse of dominant position.

25/11/2020, C-372/19, [SABAM](#), ECLI:EU:C:2020:959, § 60

Article 102 of the Treaty on the Functioning of the European Union must be interpreted as meaning that the imposition by that copyright collecting society of fees for its services which are appreciably higher than those charged in other Member States or the imposition of a price which is excessive vis-à-vis the economic value of the service provided constitute an abuse of a dominant position.

ISSUES OF INDIRECT LIABILITY (JUDICIAL PRACTICE)

Article 11 Directive 2004/48/EC

Concept of an intermediary whose services are being used by a third party to infringe an intellectual property right

Article 11 of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights must be interpreted as meaning that the tenant of market halls who sublets the various sales points situated in those halls to market-traders, some of whom use their pitches in order to sell counterfeit branded products, falls within the concept of 'an intermediary whose services are being used by a third party to infringe an intellectual property right' within the meaning of that provision.

For an economic operator to be defined as an 'intermediary' within the meaning of Article 11 of Directive 2004/48, it must be established that the economic operator provides a service capable of being used by at least one person to infringe at least one intellectual property right, however it is not necessary that the operator maintains a specific relationship with that person.

07/07/2016, C-494/15, [Tommy Hilfiger](#), ECLI:EU:C:2016:528, § 23-24, 30.

Conditions for an injunction against an intermediary

Article 11 of Directive 2004/48 provides that Member States shall ensure that rightholders are able to apply for an injunction against intermediaries whose services are used by a third party to infringe an intellectual property right.

With reference to recital 23 to Directive 2004/48, the Court ruled that it is a matter for national law to determine the rules, conditions, and procedure for the operation of the injunctions for which the Member States must provide under Article 11 of the directive.

Article 11 of Directive 2004/48 must be interpreted as requiring the Member States to ensure that the national courts with jurisdiction in relation to the protection of intellectual property rights are able to order an intermediary whose services are used by a third party to infringe an intellectual property right to take measures which contribute, not only to ending infringement of this right, but also to preventing further infringements of that kind.

The injunctions issued against intermediaries whose services are being used by a third party to infringe an intellectual property right must be effective, dissuasive, equitable, proportionate and must not create barriers to legitimate trade.

12/07/2011; C-324/09; [L'Oréal and Others](#); ECLI:EU:C:2011:474, § 135-136, 139, 140, 144

The scope of Directive 2004/48 is not limited to online marketplaces. Accordingly, Article 11 of Directive 2004/48 applies to both online and physical marketplaces.

Article 11 of Directive 2004/48 must be interpreted as meaning that the conditions for an injunction within the meaning of that provision against intermediaries in online marketplaces are identical to that for intermediaries in physical marketplaces.

07/07/2016, C-494/15, [Tommy Hilfiger](#), ECLI:EU:C:2016:528, § 36-37

PLAGIARISM

Article 2(c) Directive 2001/29/EC

Exclusive reproduction right – Sampling a phonogram

Article 2(c) of Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society states that Member States shall provide phonogram producers with the exclusive right to authorise or prohibit direct or indirect, temporary or permanent reproduction by any means and in any form, in whole or in part of their phonograms.

Article 2(c) of Directive 2001/29 must be interpreted as meaning that the producer's exclusive right to reproduce his phonogram enables him to prevent another person from taking a sound sample, even if very short, of his phonogram for the purpose of including that sample in another phonogram.

Nonetheless, where a person takes a sound sample from a phonogram in order to include it in a new work in a modified form unrecognisable to the ear, then it does not constitute 'reproduction' within the meaning of Article 2(c) of Directive 2001/29.

29/07/2019; C-476/17; [Pelham](#); ECLI:EU:C:2019:624, § 26, 27, 29, 31, 35-39

Article 9(1)(b) Directive 2006/115/EC

Copying by means of sampling

Under Article 9(1)(b) of Directive 2006/115/EC of the European Parliament and of the Council of 12 December 2006 on rental right and lending right and on certain rights related to copyright in the field of intellectual property, Member States are to provide phonogram producers with the exclusive right to make available to the public, by sale or otherwise, their phonograms, including copies thereof.

No provision of Directive 2006/115 defines the concept of 'copy' within the meaning of Article 9 of the directive. That concept is to be interpreted by considering the context and purpose of the relevant legislation.

Drawing on recital 2 of Directive 2006/115, the Court held that the protection conferred on a phonogram producer under the directive aims, in particular, to fight the production and distribution to the public of counterfeit copies of phonograms.

Only a work which reproduces all or a substantial part of the sounds fixed in a phonogram is, by its nature, intended to replace lawful copies of that phonogram and, therefore, capable of constituting a copy of that phonogram within the meaning of Article 9(1)(b) of Directive 2006/115.

Article 9(1)(b) of Directive 2006/115/EC must be interpreted as meaning that a phonogram which contains sound samples transferred from another phonogram does not constitute a 'copy' of that phonogram within the meaning of the provision since it does not reproduce all or a substantial part of it.

29/07/2019, C-476/17, [Pelham](#), ECLI:EU:C:2019:624, § 41-43, 45-47, 55

SYNCHRONIZATION

Article 8(2) Directive 92/100/EEC – Article 8(2) Directive 2006/115/EC

Synchronisation of phonograms in audio-visual works

According to Article 8(2) of the Council Directive 92/100/EEC of 19 November 1992 on rental right and lending right and on certain rights related to copyright in the field of intellectual property and Article 8(2) of Directive 2006/115/EC of the European Parliament and of the Council of 12 December 2006 on rental right and lending right and on certain rights related to copyright in the field of intellectual property, Member States are to provide a right in order to ensure that a single equitable remuneration is paid by the user if a phonogram published for commercial purposes, or a reproduction of such phonogram, is used for broadcasting by wireless means or for any communication to the public.

Article 8(2) of Directive 92/100 and Article 8(2) of Directive 2006/115 must be interpreted as meaning that the single equitable remuneration referred to in those provisions must not be paid to the performers and phonogram producers where the user makes a communication to the public of an audio-visual recording containing the fixation of an audio-visual work in which a phonogram or a reproduction of that phonogram has been synchronised (i.e. incorporated).

18/11/2020, C-147/19, [Atresmedia](#), ECLI:EU:C:2020:935, § 28, 51-52, 56

MECHANICAL RIGHTS

Article 82 EC Treaty

Remuneration for mechanical rights – Collection of royalties relating to the broadcast of musical works

Where broadcasting companies signed an affiliation agreement with a copyright management company – with a dominant position on a substantial part of the common market – by which they transferred to the latter the right to remuneration for mechanical rights (i.e. recording and duplication) of their work, it was held that the company did not abuse its dominant position by applying a remuneration model corresponding to a percentage of the broadcasting companies' revenue.

Article 82 of the Treaty establishing the European Community must be interpreted as meaning that a copyright management organisation does not abuse its dominant position where, with respect to remuneration for mechanical rights of musical works protected by copyright, it applies to broadcasting companies a remuneration model according to which the amount of the royalties is calculated partly on the basis of the revenue of those companies and in a proportional manner.

11/12/2008, C-52/97, [Kanal 5 and TV 4](#), ECLI:EU:C:2008:703, § 6-10, 33, 41

Article 5(2)(d) Directive 2001/29/EC

Ephemeral recordings of works made by broadcasting organisations by means of their own facilities and for their own broadcasts

Article 5(2)(d) of Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society provides exceptions or limitations to the reproduction right in respect of ephemeral recordings of works made by broadcasting organisations by means of their own facilities and for their own broadcasts.

Article 5(2)(d) of Directive 2001/29, read in conjunction with recital 41, must be interpreted as meaning that the exception for ephemeral recordings to authors' exclusive reproduction rights in their work applies to recordings made by a broadcasting organisation, for its own broadcasts, using the facilities of a legally independent third party, provided that such third party was acting on behalf of the broadcasting company or was under its responsibility.

27/04/2012; C-510/10; [DR and TV2 Danmark](#); ECLI:EU:C:2012:244, § 60-61, 66-67

FAIR USE

A non-harmonised concept

Fair use is a legal doctrine that can be raised in response to claims of copyright infringement. The fair use doctrine grants a broad set of exemptions, which allow a party to make use of a copyright-protected work without permission from the copyright-owner. Presently, the concept of 'fair use' has not been harmonised throughout the EU. Nonetheless, some European countries have had a similar approach to the fair use doctrine such as the UK with the concept of 'fair dealing' or Germany with the 'free use' doctrine.

DETERMINING SIMILARITY OF MUSICAL WORKS

Article 9(1)(b) Directive 2006/115/EC

Similarity – Copying a musical work

The Court questioned whether a phonogram which contained very short audio fragments transferred from another phonogram constituted a copy of the latter within the meaning of Article 9(1)(b) of Directive 2006/115/EC of the European Parliament and of the Council of 12 December 2006 on rental right and lending right and on certain rights related to copyright in the field of intellectual property.

Neither Article 9 nor any other provision of Directive 2006/115 defines the concept of ‘copy’. Building on the Advocate General’s Opinion, the Court established that only an article which reproduces all or a substantial part of the sounds fixed in a phonogram can constitute a copy of that phonogram within the meaning of Article 9(1) of Directive 2006/115. The Court added that where sound samples are transferred from a phonogram in a modified form unrecognisable to the ear for the purposes of creating a new and distinct work, then it does not amount to a copy of the phonogram.

29/07/2019, C-476, [Pelham](#), ECLI:EU:C:2019:624

DETERMINING OF AUTHORSHIP, EXCLUSIVE RIGHTS ON MUSICAL WORK, PHONOGRAM

Article 3(1) Directive 2001/29/EC

Authors' exclusive right – Concept of communication to the public

Article 3(1) of Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society provides author of musical works with the exclusive right to authorise or prohibit any communication to the public of their work, by wire or wireless means, including the making available to the public of their works in such a way that members of the public may access them from a place and at a time individually chosen by them.

Article 3(1) of Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society must be interpreted as meaning that the operator of a file-sharing platform, on which users can illegally make protected musical content available to the public, does not make a 'communication to the public' of that content, unless it contributes to giving access to such protected content.

Where the file-sharing platform facilitates access to protected musical content by, inter alia, refraining from deleting it, failing to put in place the appropriate technological measures to counter effectively copyright infringements on that platform, or promoting illegal sharing of the protected content, the platform will be deemed to have made a 'communication to the public'.

22/06/2021; C-682/18 and C-183/18; [Peterson](#); ECLI:EU:C:2021:503, § 60-62, 95, 98102

LINKING

Article 3(1) Directive 2001/29/EC

Communication to the public – Internet links giving access to protected works

Article 3(1) of Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society stipulates that Member States are to provide authors with the exclusive right to authorise or prohibit any communication to the public of their works, by wire or wireless means.

The concept of ‘communication to the public’ includes two cumulative criteria: an ‘act of communication’ of a work and the communication of that work to a ‘public’. Where a work is made available to a public in such a way that the public may access it, irrespective of whether the public actually seeks to access the work, this will amount to an ‘act of communication’.

Article 3(1) of Directive 2001/29 must be interpreted as meaning that the provision, on a website, of links giving access to protected works freely available on another website does not constitute an act of communication to the public within the meaning of the article.

13/02/2014, C-466/12, [Svensson](#), ECLI:EU:C:2014:76, § 16, 17

The court considered the possible circumstances under which posting, on a website, a hyperlink to protected works, freely available on another website without the consent of the copyright holder, could amount to a ‘communication to the public’ within the meaning of Article 3(1) of Directive 2001/29.

The Court held that it is relevant that a ‘communication’, within the meaning of Article 3(1) of Directive 2001/29, be of a profit-making nature. In order to determine whether the posting of hyperlinks to protected works, which are freely accessible on another website without the consent of the copyright holder, constitute a ‘communication to the public’, one must establish whether those hyperlinks are provided with the pursuit of financial profit.

Article 3(1) of Directive 2001/29 must be interpreted as meaning that the fact of posting hyperlinks to protected works, which are freely accessible on another website, will not constitute a ‘communication to the public’ where those links are provided without the pursuit of financial gain by a person who did not know or could not reasonably have known the illegal nature of the publication of those works on the other website.

08/09/2016; C-160/15; [GS Media](#); ECLI:EU:C:2016:644, § 25, 27, 32, 38, 54-55

CHAPTER V. ENFORCEMENT

Preliminary ruling – Article 9(7) Directive 2004/48/EC

Patent – Appropriate compensation – Compensation for losses – Preliminary injunction – Patent revocation

Article 9(7) of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights, and in particular the concept of ‘appropriate compensation’ referred to in that provision, must be interpreted as not precluding national legislation which provides that a party will not be compensated for losses which he has suffered due to not having acted as may generally be expected in order to avoid or mitigate his loss and which, in certain circumstances, results in the court not making an order for provisional measures against the applicant obliging him to provide compensation for losses caused by those measures, even though the patent on the basis of which those had been requested and granted has subsequently been found to be invalid. The court must take due account of all the objective circumstances of the case, including the conduct of the parties, in order, inter alia, to determine whether the applicant has abused those measures.

The concept of ‘appropriate compensation’ is an autonomous concept of EU law, which must be given an independent and uniform meaning throughout the territory of the European Union. Article 9(7) of Directive 2004/48/EC must be interpreted as requiring Member States to supply national courts with the authority to order the applicant, upon the request of the defendant, to provide appropriate compensation for the losses caused by the provisional measures referred to in that article. National courts must decide, on a case-by-case basis, whether compensation is appropriate, that is to say justified in light of the specific circumstances of the case..

Article 9(7) of Directive 2004/48/EC establishes as a pre-condition that the preliminary injunction is repealed or that no infringement or threat of infringement is found. However, that does not mean that compensation for losses will be automatically ordered (§ 52). Recital 22 of the Enforcement Directive which considers compensation to be ‘appropriate’ to the extent that it repairs the cost and injury suffered because of ‘unjustified’ provisional measures (§ 60). Provisional measures would be unjustified when there is no risk of delays causing irreparable harm to the rights holder (§ 61). When a generic product is marketed although a patent has been granted, there may, in principle, be such a risk. The fact that the provisional measures have already been repealed is not a decisive factor to prove that the measures were unjustified (§ 63). Otherwise rights holders could be discouraged from applying for these types of measures (§ 65). National courts must check that an applicant has not abused provisional measures (§ 70).

12/09/2019, C-688/17, Bayer Pharma, ECLI:EU:C:2019:722, § 49-50, 52, 60-61, 63, 65, 72.

Preliminary ruling – Article 8(2)(a) Directive 2004/48/EC

Internet video platform – Uploading of a film without the consent of the rights holder – Proceedings concerning an infringement of an intellectual property right – Applicant’s right of information

Where a film is uploaded onto an online video platform, such as YouTube, without the copyright holder’s consent, Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights does not oblige the judicial authorities to order the operator of the video platform to provide the email address, IP address or telephone number of the user who uploaded the film concerned. Article 8 of Directive 2004/48/EC, provides for disclosure of the ‘addresses’ of persons who have infringed an intellectual property right, but this only covers the postal address of the user concerned, not their email, IP address or telephone number (§ 38-40).

09/07/2020, C-264/19, [Constantin Film Verleih](#), EU:C:2020:542, § 38-40.

CALCULATION OF DAMAGES IN IP DISPUTES (TRADEMARKS, COPYRIGHT, DESIGNS)

Article 13(1) Directive 2004/48/EC

Rules for calculation of damages

Article 13(1) of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights provides that Member States shall ensure that the competent judicial authorities, on application of the injured party, order the infringer who knowingly, or with reasonable grounds to know, engaged in an infringing activity, to pay the rightholder damages appropriate to the actual prejudice suffered by him as a result of the infringement.

According to recitals 17 and 26 of Directive 2004/48, the measures, procedures and remedies provided against infringement of an intellectual property right shall be determined in each case by taking into account the specific characteristics of the case as well as all appropriate aspects, including any moral prejudice caused to the rightholder.

Article 13(1) of Directive 2004/48 must be interpreted as establishing the principle that the calculation of damages to be paid to the rightholder must seek to ensure that the latter was compensated in full for the 'actual prejudice suffered', which also included any moral prejudice.

For the purposes of providing compensation in full, a rightholder must be able to claim compensation for any moral prejudice which he has suffered in addition to the damages calculated on the basis of the amount of hypothetical royalties or fees lost.

17/03/2016, C-99/15, [Liffers](#), ECLI:EU:C:2016:173, § 22-27

Article 9(3) Regulation (EC) No 207/2009

The concept of reasonable compensation in respect of acts occurring after an application for registration of an EU trademark

Article 9(3) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trademark must be interpreted as not allowing the proprietor of an EU trademark from being able to claim compensation in respect of acts of third parties occurring before publication of an application for registration of a trademark.

For the purpose of determining 'reasonable compensation', within the meaning of Article 9(3) of Regulation No 207/2009, it is appropriate to exclude compensation for the wider harm suffered by the proprietor of a trademark on account of its use, including moral prejudice.

22/06/2015; C-280/15; [Nikolajeva](#); ECLI:EU:C:2016:467, § 57, 59

BEST PRACTICES RELATED TO DIRECT AND ONLINE SALES OF COUNTERFEIT/PIRATED GOODS/COPIES

Regulation (EC) No 1383/2003

Measures to prevent counterfeit or pirated goods being placed on the market

Article 2(1) of Council Regulation (EC) No 1383/2003 of 22 July 2003 concerning customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights must be interpreted as meaning that goods coming from a non-Member State, which are imitations of goods protected by intellectual property rights in the EU, are considered 'counterfeit' or 'pirated' goods where it can be demonstrated that they are intended to be sold in the EU.

As such, the holder of an intellectual property right over goods sold to a person residing in a Member State through an online sales platform located in a non-Member State territory shall enjoy his intellectual property right from the moment those goods enter the Member State.

06/02/2014; C-98/13; [Blomqvist](#); ECLI:EU:C:2014:55, § 33-35

Regulation (EEC) No 3842/86

Measures to prohibit the release for free circulation of counterfeit goods

The Court of Justice has jurisdiction to interpret whether interim proceedings granted following seizure of counterfeit goods constituted a 'provisional measure' within the meaning of Article 50 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS).

Article 50 of the TRIPS Agreement must be interpreted as meaning that a measure whose purpose is to put an end to alleged infringements of a trademark falls under the scope of a 'provisional measure' provided that (i) it is an 'immediate provisional measure whose adoption is required on 'grounds of urgency', (ii) the opposing party is summoned and heard, (iii) the decision is reasoned and given in writing, (iv) an appeal may be lodged against the decision, and (v) the decision is accepted by the parties as a 'final' resolution of their dispute.

16/06/1998; C-53/96; [Hermès](#); ECLI:EU:C:1998:292, § 33-34

INTERMEDIARIES LIABILITY IN INFRINGEMENT OF IP RIGHTS (TRADEMARKS, COPYRIGHT, DESIGNS)

Article 11 Directive 2004/48/EC

Liability of an intermediary whose services are being used by a third party to infringe an intellectual property right

Article 11 of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights must be interpreted as meaning that an intermediary whose services are being used by a third party to infringe an intellectual property right shall be held liable for infringement of such right and shall have to face legal measures aiming not only at putting an end to infringement of this right, but also to prevent further infringements of this type.

07/07/2016, C-494/15, [Tommy Hilfiger](#), ECLI:EU:C:2016:528, § 30, 36-37

STANDARD OF USE OF THE MEASURES FOR SECURING A CLAIM, WHICH SHALL BE SUBSTANTIATED/SATISFIED BY THE PLAINTIFF IN IP DISPUTES

Article 4(c) Directive 2004/48/EC

Legal standing – Collective representation of trademark proprietors

Article 4(c) of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights must be interpreted as meaning that the Member States are required to recognise a body collectively representing trademark proprietors as having legal standing to bring enforcement proceedings in its own name for the purpose of defending the rights of the trademark proprietors. However, this is on condition that the body is regarded by national law as having a direct interest in the defence of such rights and that national law allows the body to bring legal proceedings. It is a matter for the referring court to determine whether a body is regarded by national law as having a direct interest in the defence of the rights of the trademark proprietors whom it represents and whether that law allows it to bring legal proceedings.

07/08/2018; C-521/17; [Coöperatieve Vereniging](#); ECLI:EU:C:2018:639, § 34-39

Article 19(2) Regulation (EC) No 6/2002

Burden of proof – Producing evidence

Article 19(2) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs must be interpreted as meaning that the rightholder of a design shall bear the burden of proving that its alleged unauthorized use resulted from copying that design. The CJEU confirmed the general principle that the burden of proof lies with the party seeking to assert their right.

Article 19 of Regulation No 6/2002 provides no express rules on producing evidence. Such rules are to be determined according to the Member States' respective national law. Where a court finds that the burden of proof is likely to make it impossible or excessively difficult to produce evidence of copying, that court may use any rules of national law which enable the burden of proof to be adjusted or lightened. Therefore, in certain circumstances, copying may be reasonably inferred and the burden will shift to the defendant.

13/02/2014; C-479/12; [Gautzsch](#); ECLI:EU:C:2014/75, § 39, 42-44

SATISFYING A DEMAND AS A MEASURE FOR SECURING A CLAIM, WHICH COINCIDES WITH THE DEMAND OF THE APPEAL

The European courts have not handed down any decisions related to the aforementioned topic. Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights does not provide any further guidance on this topic.