



TRIBUNAL DE  
L'UNION EUROPÉENNE

# Recent case-law of the General Court EU

***Andrej Stec, référendaire (GC)***

*(The presentation is done on a personal basis and is not binding for the Institution)*

*23<sup>rd</sup> November 2018*

# Introduction – Part 1: Two cases to discuss...



- ▶ **Trademarks cases** are currently - in absolute numbers - **one of the most important parts of the case-law** of the General Court EU
- ▶ The importance of some TM-related cases can also be seen on the fact, that **judgments in this area are taken more often than in the past by a chamber in extended composition of five judges** (we will shortly analyze one example: **T-447/16, Pirelli Tyre/EUIPO – The Yokohama Rubber**)
- ▶ We will also discuss other interesting cases, in particular: **concerning the relationship between TMs and geographical places** (**T-122/17, Devin/EUIPO – Haskovo Chamber of Commerce**)

## PART 2 – Overview of other interesting cases: **similarity of the signs...**



- ▶ The case **T-261/17, Bayer/EUIPO – Uni-Pharma Kleon Tsetis, Farmakeutika Ergastiria**: in particular, on **(i) similarity of the signs** with earlier EU figurative marks representing *colored stripes in green and white* and earlier national marks *Aspirin*, on **(ii) reputation** and on **(iii) the question of an use of a sign in the course of trade of more than mere local significance**
- ▶ The case **T-537/15, Deutsche Post/EUIPO - Verbis Alfa and EasyPack**, (Application for EU figurative mark *InPost* — Earlier EU figurative marks *INFOPOST* and *ePOST* and earlier national word mark *POST* - **(i) no likelihood of confusion, (ii) no detriment to reputation and (iii) no dilution**)

# Case-law concerning a **genuine use of a trademark**



- ▶ **T-803/16 - Glaxo Group/EUIPO - Celon Pharma**  
(**Incompetence of the Board of Appeal** to examine **of its own motion** whether the earlier mark had been put to **genuine use**)
- ▶ The case **T-41/17, Lotte/EUIPO – Nestlé Unternehmungen Deutschland** (examples of **what is not sufficient use to show genuine use in a specific sector** – i.e. 7000 pieces sold, in the sector of biscuits and similar products)
- ▶ **T-72/17 – Schmid/EUIPO - Landeskammer für Land- und Forstwirtschaft in Steiermark** (Steirisches Kürbiskernöl – **Use as a trademark?**)

## Interesting developments in **design law**



- **C-217/17 Mast-Jägermeister/EUIPO** (Application for registration of designs representing beakers; **Attribution of a date of filing; Graphic representation;** lack of precision, certainty or clarity regarding **the matter to be protected**)
- **T-227/16 Haverkamp/EUIPO – Sissel** (Registered Community design representing a foot mat; **No individual character; Degree of freedom of the designer ; Proof of saturation of the state of the art**)
- **T-228/16 Haverkamp/EUIPO – Sissel** (Registered Community design representing a pebble beach surface pattern; **Earlier design – relevant language; Lack of novelty**)

## Absolute grounds for refusal – public policy/morality



- ▶ T-1/17, La Mafia Franchises/EUIPO (La Mafia SE SIENTA A LA MESA) (Absolute ground for refusal – Whether contrary to public policy or to accepted principles of morality)
- ▶ T-69/17, Constantin Film Produktion/EUIPO (Fack Ju Göhte) (Trade mark contrary to public policy or to accepted principles of morality)

## Important recent judgments of the Court of Justice



- **C-564/16 P EUIPO/Puma** (Relative grounds for refusal; **Earlier decisions of the EUIPO recognizing the reputation of the earlier trade mark; Principle of sound administration; Taking account of those decisions in subsequent opposition proceedings;** Obligation to state reasons; Procedural obligations of the Boards of Appeal of EUIPO)
- **Joined Cases C-84/17 P, C-85/17 P and C-95/17 P Société des produits Nestlé/Mondelez UK Holdings & Services Ltd** (Three-dimensional mark representing the shape of a four-fingered chocolate bar; **Evidence of distinctive character acquired through use**)

**PART 1: T-122/17, Devin/EUIPO – Haskovo Chamber  
of Commerce**



## T-122/17, Devin/EUIPO – Haskovo Chamber of Commerce

- On 21 January 2011, the applicant, Devin AD, obtained from the European Union Intellectual Property Office (EUIPO) registration of the European Union word mark DEVIN. The goods in respect of which the mark was registered fall within **Class 32** of the Nice Agreement, incl.: “**Non-alcoholic drinks; mineral water; seltzer waters; (...)**”
- On 11 July 2014, the intervener, Haskovo Chamber of Commerce and Industry (HCCI, Bulgaria), filed a request for a declaration of invalidity of the contested mark on the grounds of Article 52(1)(a) in conjunction with Article 7(1)(c), (f) and (g) of Council Regulation (EC) No 207/2009.
- The Cancellation Division of EUIPO rejected the invalidity requests based on Article 7(1)(f) and (g) of Regulation No 207/2009. However, it accepted the request for a declaration of invalidity based on Article 7(1)(c) of that regulation and declared the mark invalid.

## T-122/17, Devin/EUIPO – Position of the Cancellation div.

- Specifically, the Cancellation Division considered that the geographical name Devin fell within the scope of that provision inasmuch as, nowadays, it was understood by the general public in Bulgaria and a part of the public in neighbouring countries as a description of the geographical origin of the goods concerned and, in future, would potentially be understood by a wider European public in view of the marketing efforts being made and the growth of the Bulgarian tourism sector.
- It further observed that the applicant had provided no evidence of the distinctive character acquired by the contested mark in markets other than the Bulgarian market.

## T-122/17, Devin/EUIPO – Position of the Board of Appeal

- The Second Board of Appeal of EUIPO dismissed the appeal.
- In essence, it considered that the Bulgarian town of Devin was known to the general public in Bulgaria and a significant part of consumers in neighbouring countries such as Greece and Romania, especially as a spa town, and that the name of that town was linked by the relevant public with the designated goods in Class 32 covered by the contested mark, especially mineral waters.
- It therefore ‘*confirmed the decision [of the Cancellation Division] that, for a significant part of the relevant public outside of Bulgaria, the town of Devin is associated with the goods designated by the contested mark, ... and can, in the eyes of that public, serve to designate the geographical origin of the goods’.*
- It concluded that, for a significant part of the relevant Bulgarian and non-Bulgarian public, in particular the public of those neighbouring countries, the contested mark was descriptive of the geographical origin of the goods covered.

## T-122/17, Devin/EUIPO – The position of the Applicant

- In its first plea in law, alleging infringement of Article 52(1)(a) of Regulation No 207/2009, in conjunction with Article 7(1)(c) of that regulation, the **applicant** alleged that the Board of Appeal **erred in law in finding that the mark is descriptive** in relation to the goods in Class 32 covered by it. That plea consisted of two parts, the first relating to the **degree of recognition by the relevant public of the word ‘devin’ as a geographical name**, and the second relating to the **link between the contested mark and all the goods concerned**.
- In the second place, it alleged that to the extent that the Board of Appeal did not infringe Article 7(1)(c) of the regulation, it did infringe **Article 7(3)** of that regulation by ruling that the contested mark **has not acquired distinctiveness through use** in those parts of the European Union where it has been found descriptive.
- The General Court **annulled the decision of the Board of Appeal**.

## T-122/17, Devin/EUIPO – The position of the GC

- In point 27, the GC highlighted: “In the present case, it is common ground that Devin (...) is a town in southern Bulgaria, located in the Rhodopes mountain range.”
- “(...) the Board of Appeal provided further details, which were not contested by the parties. Accordingly, the town of Devin ‘possesses an abundance of hot springs and spa resorts’ as well as water reserves, including a V-5 (or B-5) bore-hole currently operated by the applicant under an authorisation granted by the Bulgarian State. Bulgaria’s official tourism portal, which has a section devoted to Devin, refers to ‘the development of its “spa tourism” and “famous” mineral springs’ and to the ‘healing properties’ known since antiquity.
- For its part, the applicant stated, without having been challenged, that Devin has a population of approximately 7 000 inhabitants and, as such, ranks approximately 109th among Bulgarian towns in terms of population”.

## T-122/17, Devin/EUIPO – The position of the GC

- The GC also highlighted that the Board of Appeal stated that Devin water, associated with the source ‘Devin sondazh 5’, was included in the official list of natural mineral waters recognised by Bulgaria and the other Member States, published in the Official Journal of the European Union (OJ 2010 C 65, p. 1) pursuant to Article 1 of Directive 2009/54/EC of the European Parliament and of the Council of 18 June 2009 on the exploitation and marketing of natural mineral waters (OJ 2009 L 164, p. 45).
- The GC also mentioned that the Board of Appeal referred to a geographical indication ‘Devin Natural Mineral Water’, registered in Bulgaria under number 190-01/1995, and
- an identical appellation of origin, registered under number 883/2006 in certain Member States of the European Union, including Greece and Romania, which are parties to the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration.

## T-122/17, Devin/EUIPO – The position of the GC

- In this respect, the **GC noted** that **the dispute did not concern a possible ground for refusal (or ground for invalidity) based on the new Article 7(1)(j) of Regulation 2017/1001, according to which** *‘the following shall not be registered ... trade marks which are excluded from registration, pursuant to Union legislation or national law or to international agreements to which the Union or the Member State concerned is party, providing for protection of designations of origin and geographical indications’*, **nor on Regulation (EU) No 1151/2012** of the European Parliament and of the Council *on quality schemes for agricultural products and foodstuffs* (OJ 2012 L 343, p. 1).

**It was therefore necessary to examine, under Art. 7 (1) (c):**

- **(a) the perception of the word ‘devin’ by the average consumer in the European Union and**
- **(b) the availability of the geographical name Devin.**

**(a) On the perception of the word ‘devin’ by the average Bulgarian consumers**

The General court noted that the absence of any challenge by the applicant to the recognition by the **average Bulgarian consumer of the word ‘devin’ as the geographical name of a Bulgarian town is by no means decisive in the present case**, since the applicant hastens to add that the contested mark **has acquired an increased distinctive character, and even a reputation**, for mineral waters in the mind of the average Bulgarian consumer.

35. Moreover, it should be noted that, **since the Bulgarian word mark Devin has been recognized as having a reputation by the Patent Office of the Republic of Bulgaria**, it appears, prima facie, **extremely implausible that the contested mark, namely the European Union word mark DEVIN, has not acquired there, at the very least, normal distinctive character**, without there being any need to rule on its increased distinctive character or its reputation.



- (2) Average Greek or Romanian consumers (points 36 - 61)
  - The applicant claimed that the intervener had not submitted any evidence allowing the Board of Appeal to establish that the word ‘devin’ would be perceived by consumers in neighbouring countries (Greece and Romania) as a geographical location. He claimed that the Board of Appeal, in reaching such a conclusion, **relied on unsubstantiated deductions or assumptions.**
  - The Board of Appeal relied on several sources of data relating to tourism, in particular the **Official Tourism Portal of Bulgaria** and other websites. Relying on the fact that more than 5.4 million foreign tourists visited Bulgaria in 2014, an ‘impressive’ figure bearing in mind the country’s 7.3 million inhabitants, the Board of Appeal estimated that, *‘even if it were true that most of these tourists finally elected to spend their vacations in sea-side or winter ski resorts, as argued by the [applicant], this does not rule out knowledge of other areas or other locations’.*

## (2) Average Greek or Romanian consumers (BoA)

- The **Board of Appeal** considered that ‘when a person chooses a vacation, he or she **will generally consider beforehand a variety of destinations before settling on one in particular**’ and concluded from that ‘*a person wishing to visit Bulgaria, and after considering the range of destinations on offer, will almost certainly come across lesser known or less accessible destinations even if, in the end, the potential tourist decides on a different destination*’.
- (...) The **Board of Appeal** speculated that it was ‘**very unlikely** ... that Devin, and its association with spa waters, **would not appear on internet searches** for holiday destinations in Bulgaria’.

## (2) Average Greek or Romanian consumers (GC)

- The GC found that (...) **the mere fact that the town of Devin has a detectable presence on the internet cannot suffice to establish, in line with the required legal and case-law standards, that it would be known by a significant part of the relevant public of Greece and Romania.** As the applicant points out, reasoning such as that of the Board of Appeal, taken to its extreme, **would lead to the conclusion that foreign consumers could, by simply browsing on the internet, know every town in the world, of any size, even small ones.**
- (...) **The existence of a ‘non-negligible tourist profile on the internet’, in itself, does not suffice to establish the knowledge of a small town by the relevant public abroad.** In that regard, the fact that Devin is **not** one of Bulgaria’s most popular destinations on the **‘TripAdvisor.com’** website is at the very least **relevant**, since it is reasonable to consider that **the relevant foreign public only knows the main attractions of a third country such as Bulgaria.**

## (2) Average Greek or Romanian consumers (GC)

- The GC further found that (...) the Board of Appeal relied on the ‘considerable’ or ‘substantial’ tourism infrastructure of the municipality of Devin, comprising, according to it, ‘nearly two dozen hotels in the area’, including many spa hotels and five-star luxury hotels.
- However, that simple fact, in itself, does not warrant the conclusion that an average Greek or Romanian consumer could have knowledge of the town of Devin beyond its borders or establish a direct link with it. It cannot be ruled out that that tourism infrastructure could be used mainly by the average Bulgarian consumer, whose knowledge of the town of Devin is not in dispute, and incidentally by a small proportion of average foreign consumers who visit Bulgaria as tourists.

## (2) Average Greek or Romanian consumers (GC)

- The GC further stressed that the legal criterion to be applied was not to count bit by bit the number of foreign tourists visiting the town of Devin, but to establish the perception of the word ‘devin’ by the whole relevant public of the European Union, **including those who do not necessarily visit Devin or Bulgaria**, and who constitute the majority of that public.
- The Board of Appeal’s argument does not concern that great majority of average consumers in the European Union, in particular Greeks and Romanians, who do not visit Bulgaria, but focuses on the minimal fraction of those who plan to visit that country, and above all the very small fraction of those who visit Devin or do research about it.

## (2) Average Greek or Romanian consumers (GC)

- The Board of Appeal stated that it was ‘convince[d] ... that the undoubted reputation of Devin as a spa town with natural water *does not arbitrarily stop at the Bulgarian border, but extends beyond to neighbouring countries*’ and concluded by declaring that ‘[it] would be strange ... if the considerable fame that Devin enjoys in Bulgaria for its waters should mysteriously vanish on crossing the Bulgarian-Greek border’.
- The GC found that such a declaration cannot serve as valid evidence to establish knowledge of the town of Devin ‘by a “considerable proportion” of consumers in neighbouring countries such as Greece and Romania’, as the Board of Appeal found in line with the Cancellation Division on that point. Furthermore, it should be noted that the town of Devin, which is not easily accessible and is separated from the Greek border by a mountain range, has particular geographic circumstances that render that declaration even more unlikely.

## (2) Average Greek or Romanian consumers (Conclusion)

- The reasons set out in the contested decision to demonstrate that the average consumer in **Greece** and **Romania** knew Devin as a geographical place were **neither convincing nor conclusive** (*additional proofs from the applicant were analyzed in further points*).

## (3) The average consumer in other EU Member States (p. 62-68)

- The **GC** considered, that the **Board of Appeal**, having found that the contested trade mark was **descriptive** for the average **Greek** or **Romanian** consumer, **hardly examined that issue from the point of view of the average consumer in the other Member States of the European Union.**
- The **GC** analyzed some additional proofs in that regard: including some deductions made by the Board of Appeal by extrapolation from the omnibus survey in relation to the fact (...) **that around 455 000 German consumers would perceive the word 'devin' as the name of a town or a town in Bulgaria.**

(3) **The average consumer in other EU Member States (p. 62-68)**

- The **GC** noted, that this would correspond **to less than 0.6% of the total German population, which hardly qualifies as a considerable proportion or an average German consumer of mineral water and drinks.** Further, the mere fact that consumers answered ‘town’ to a question in the survey was considered as **inconclusive**, as it cannot be equated with the knowledge of a particular town or particular direct link with the goods at issue.
- So, the **General Court** concluded that it **did not appear** from the file that the word ‘devin’ was recognized as the **designation of a geographical origin** by the average consumer in the Member States of the European Union **other than Bulgaria.**



(b) **The availability of the geographical name Devin**

- As regards the **Cancellation Division's** assertion that the geographical name Devin, **in the future, would potentially be understood by the public in the European Union as a description of the geographical origin of the relevant goods**, taking into account the marketing efforts made and the growth of the Bulgarian tourism sector, it was noted by the **General Court** that such an assertion was **not supported by the facts of the case** and was a **mere hypothesis**, in particular because the town of Devin **was not one of Bulgaria's 50 main destinations** and **benefited only very marginally from the growth of foreign tourism** in that country.
- It was therefore **not 'reasonable'**, to consider that the name Devin could, in the eyes of the public of the European Union, designate the geographical origin of the goods concerned. Moreover, **the burden of proof cannot be reversed by requiring the applicant to demonstrate a negative fact**, namely that the town of Devin could not be visited or known in the future.

## (b) The availability of the geographical name Devin

### Further arguments concerning applicant's potential monopoly

- In that regard, in the first place, **it was recalled that, under Article 12(1)(b) of Regulation No 207/2009** (now, in slightly amended form, Article 14(1)(b) of Regulation 2017/1001), *'[an EU] trade mark shall not entitle the proprietor to prohibit a third party from using in the course of trade indications concerning the ... geographical origin ... of the goods or of rendering of the service, or other characteristics of the goods or service'*.
- In particular, **a descriptive use of the name 'Devin' is thus permitted in order to promote the town as a tourist destination.** Contrary to what the intervener fears, the contested mark cannot therefore constitute an impediment to the economic efforts to develop, beyond the borders of Bulgaria, the reputation of the town of Devin for its spa waters.

## (b) The availability of the geographical name Devin

- **First, the protection of the function of indicating the origin of the trade mark, provided for in Article 9(2)(a) and (b) of Regulation No 207/2009 (now Article 9(2)(a) and (b) of Regulation 2017/1001), covers its use for identical or similar goods (or services) only and requires a risk of confusion on the part of the relevant public, which is assumed in the case of double identity of signs and goods.**
- **Secondly, the protection of the advertising function of a reputed trademark, provided for in Article 9(2)(c) of Regulation No 207/2009 (now Article 9(2)(c) of Regulation 2017/1001), also covers dissimilar products, but requires a risk of dilution, tarnishing or free-riding and, in addition, does not cover uses with a ‘due cause’.**

## T-122/17, Devin/EUIPO – The position of the GC

- In the present case, (...) the name of the town of Devin **remains available** to third parties **not only for descriptive use**, such as the promotion of tourism in that town, **but also as a distinctive sign in cases of ‘due cause’ and where there is no likelihood of confusion** excluding the application of Articles 8 and 9 of Regulation No 207/2009.
- The general interest in preserving the availability of a geographical name such as that of the spa town of Devin can thus be protected by **allowing descriptive uses of such names** and by means of **safeguards limiting the exclusive right of the proprietor of the contested mark, without requiring cancellation of that mark and the total suppression of the exclusive right that it confers** for the goods in Class 32 covered by the registration.

## T-122/17, Devin/EUIPO – The position of the GC

- Moreover, it is this **necessary balance** between the rights of the **proprietors** and the **interests of third parties** which **allows** the registration of **trade marks originating from an eponymous geographical name, such as the European Union word marks VITTEL and EVIAN** mentioned by the applicant, **under certain conditions** relating in particular to the acquisition of a **secondary meaning** and **distinctive character** by use in territories where the sign is intrinsically descriptive of a geographical origin and where that sign is not deceptive as regards that origin.

**T-447/16, Pirelli Tyre/EUIPO – The Yokohama  
Rubber**

## T-447/16, Pirelli Tyre/EUIPO – The Yokohama Rubber

- The EU trade mark in respect of which **registration was sought** is the following **figurative sign**:



The goods in respect of which registration was sought are in Class 12 of the Nice Agreement :  
**‘Tyres, solid, semi-pneumatic and pneumatic tyres, rims and covers for vehicle wheels of all kinds, vehicle wheels of all kinds, inner tubes, wheel rims, parts, accessories and spare parts for vehicle wheels of all kinds’.**

It was **registered** as a trade mark on 18 October 2002.

## T-447/16, Pirelli Tyre/EUIPO – The Cancellation Division

- On 27 September 2012, the intervener, The Yokohama Rubber Co. Ltd, filed before EUIPO an application for a declaration of invalidity of the contested trade mark for the goods ‘Tyres, solid, semi-pneumatic and pneumatic tyres for vehicle wheels of all kinds’. That application was based on Article 52(1)(a) of Regulation No 40/94, read in conjunction with Article 7(1)(b) or **Article 7(1)(e)(ii)** of that regulation.
- By decision of 28 August 2014, the **Cancellation Division** of EUIPO declared the contested mark **invalid** for the goods referred to above, as well as for ‘rims and covers for vehicle wheels of all kinds’, on the ground that the contested sign consisted exclusively of the shape of the goods concerned necessary to obtain a technical result within the meaning of **Article 7(1)(e)(ii)** of Regulation No 40/94.



## T-447/16, Pirelli Tyre/EUIPO – The Board of Appeal

- The **Fifth Board of Appeal** of EUIPO upheld the appeal in part.
- It annulled the Cancellation Division's decision **in so far as the latter had declared the contested trade mark invalid for 'rims and covers for vehicle wheels of all kinds'**. The Board of Appeal held that those goods were not covered by the application for a declaration of invalidity and that the Cancellation Division's declaration of invalidity went beyond the scope of that application.
- The Board of Appeal confirmed the decision of the Cancellation Division as to the remainder and declared the contested mark to be invalid in respect of **'Tyres, solid, semi-pneumatic and pneumatic tyres for vehicle wheels of all kinds'**.

## T-447/16, Pirelli Tyre/EUIPO – The Board of Appeal

- In that regard, first, **the Board of Appeal** considered that, in the light of the evidence submitted and the goods in question, **‘it [was] clear that the sign represent[ed] a tyre tread and, thus, the (perhaps) most crucial part of the contested goods ... at least from a technical perspective’.**
- Second, the Board of Appeal noted that the main feature of the mark at issue was an **L-shaped groove** with the following essential characteristics: an approximately 90° angle, a curved segment and two sides shifting from pointy to thick.
- Third, the Board of Appeal decided, in essence, that it was clear from the evidence submitted by the intervener that **the sign at issue played an essential role in the proper functioning of the tyres in terms of facilitating efficient traction, breaking and comfort.** (...)

## Pirelli Tyre: Article 7(1)(e)(ii) - applicable *ratione temporis*

- A preliminary point - as to the first plea in law, alleging that the contested decision is based on a version of Article 7(1)(e)(ii) which is inapplicable *ratione temporis*
- According to Article 7(1)(e)(ii) of Regulation No 207/2009, as amended by Regulation 2015/2424, signs ‘*which consist exclusively of the shape, or another characteristic, of goods which is necessary to obtain a technical result*’ are to be refused registration.
- However, according to the applicant, in the present case the existence of an absolute ground for invalidity had to be assessed on the basis of the provision in force on the date on which the application for registration of the contested trade mark was filed, that is to say, Article 7(1)(e)(ii) in the version resulting from Regulation No 40/94, which excluded from registration only signs which consist exclusively ‘of the shape of goods’ which is necessary to obtain a technical result.

## Pirelli Tyre- Article 7(1)(e)(ii) - applicable ratione temporis

- First, **EUIPO does not dispute** that it was Article 7(1)(e)(ii) in its version resulting from Regulation No 40/94 that was applicable in the present case.
- Second, it is important to point out that **Regulation 2015/2424 did in fact amend the wording of Article 7(1)(e)(ii) of Regulation No 207/2009**, which concerns a **substantive rule** and, more precisely, one of the **absolute grounds** on which a sign may be **refused registration** or (in conjunction with Article 52(1)(a) of the Regulation) may **be declared invalid**.
- However, Regulation 2015/2424 entered into force on 23 March 2016 and it is **not apparent** from its terms, its objectives or its general scheme that Article 7(1)(e)(ii) of Regulation No 207/2009, in its version resulting from Regulation 2015/2424, **should apply to situations existing before its entry into force**.

## **Pirelli Tyre: Article 7(1)(e)(ii) - applicable ratione temporis**

- It follows that Article 7(1)(e)(ii) of Regulation No 207/2009, in the version resulting from Regulation 2015/2424, **is clearly not applicable in the present case**, given that the contested mark was registered on 18 October 2002 following an application for registration filed on 23 July 2001.

### **The third plea, alleging infringement of Article 7(1)(e)(ii) of Regulation No 40/94**

- By the first part of its third plea in law, the **applicant claims** that the **contested sign does not constitute the shape of the goods** in question within the meaning of Article 7(1)(e)(ii) of Regulation No 40/94.
- In that regard, **the applicant submits that the Board of Appeal erred when it took the view that the contested sign formed an integral part of a tyre's tread** and therefore of the goods covered by the contested trade mark, namely 'tyres, solid, semi-pneumatic and pneumatic tyres for vehicle wheels of all kinds'.

## Pirelli Tyre: Position of the General Court

- The **Cancellation Division**, and subsequently the **Board of Appeal**, declared the contested mark **invalid** on the basis of **Article 7(1)(e)(ii)** of Regulation No 40/94 and did not examine whether there were grounds for invalidity based on the lack of distinctive character of that mark.

### *The nature of the contested sign*

It follows from the case-law, first, that the graphic representation of a mark must be **self-contained, easily accessible and intelligible**, in order that a sign may always be perceived unambiguously and in the same way so that the mark is guaranteed as an indication of origin.

Second, the function of the graphic representability requirement is, in particular, **to define the mark itself in order to determine the precise subject of the protection afforded by the registered mark to its proprietor.**

## Pirelli Tyre: Position of the General Court

- (...) The contested mark consists of a figurative two-dimensional sign. When abstractly analyzed, that sign resembles, for example, the shape of an inclined hockey stick, as the applicant claims, or the shape of an inclined 'L'.
- Therefore, first, it is clear that the sign, as registered, represents neither the shape of a tyre nor the shape of a tyre tread.
- Next, it is **not apparent** from the graphic representation of the contested sign that that sign is intended for use on a tyre or a tyre tread. Lastly, it is also **not apparent** from the graphic representation of the contested sign that it is a functional shape that fulfils or performs a technical function. Indeed, when it was registered, the contested sign was **not accompanied by an additional description**.

## Pirelli Tyre: Position of the General Court

- Furthermore, the applicant does not contest that some of its tyre models contain, on the surface of the tyre, a groove in the shape represented by the contested sign. (...)
- However, the fact that some of the applicant's tyre models have a groove in the shape represented by the contested sign on the surface of the tyre **does not support the conclusion that the contested sign represents a tyre or a whole tyre tread.**
- **EUIPO may take into account all information** that makes it possible to **assess the 'various types of elements of which a sign may consist' or 'the components of the sign'**. EUIPO is, therefore, entitled to identify what the shape at issue actually represents.



## Pirelli Tyre: Position of the General Court

- However, that case-law cannot be interpreted as meaning that EUIPO is permitted, in order to qualify the shape represented by a contested sign, to add to that shape elements which do not form part of the sign and which are therefore external and foreign.
- In other words, the expert's report and all the relevant items mentioned in that case-law serve to establish what the sign actually represents.
- By contrast, the expert's report and all the relevant items do not allow EUIPO to define the contested sign by including within it characteristics which it does not possess and which it does not cover.

## Pirelli Tyre: Position of the General Court

- In the contested decision, the Board of Appeal departed from the shape represented by the contested sign and modified it.
- Even if account is taken of the fact, not disputed by the applicant, that some of its tyre models contain a groove in the shape represented by that sign on their tyre tread, the Board of Appeal was not entitled to go beyond the contested sign in order to qualify it as ‘a representation of a tyre tread’.
- In other words, the Board of Appeal, by adding elements which do not form part of the contested sign — that is, on the basis of all the elements which appear on a tyre tread — took the view that that sign represented the shape of the goods in question for which it had been registered.
- This assessment is not called into question by the argument, put forward by the intervener, that certain documents in the file show that the applicant, through its agent, has already described the contested trade mark as, and thus acknowledged that it is, a ‘tread pattern design’.

## Pirelli Tyre: Position of the General Court

- On the one hand, the documents relied on by the intervener and in which the applicant allegedly acknowledged that the contested mark was a ‘tread pattern design’, refer to or show signs which are different from that mark.
- Moreover, it must be noted that the entry of a mark in the Register of EU trade marks is intended to allow the Board of Appeal to exercise its powers and to safeguard the interests of the parties to a dispute, but also to inform third parties of the specific nature of the registered rights and therefore to determine the subject of the protection afforded.
- It must be stated that, when analyzed objectively and specifically, the contested mark does not represent a tread pattern design.
- It represents, at most, an individual groove of a tyre tread.

## Pirelli Tyre: Position of the General Court

- It must be stated that the assessment of what the contested sign actually represents is a step which allows, first, its essential characteristics to be identified, and second, any potential functionality of those essential characteristics to be gauged.
- The mere fact that the Board of Appeal includes in its assessment elements which do not form part of the shape actually represented by the contested sign is capable of invalidating the conclusion that the conditions set out in Article 7(1)(e)(ii) of Regulation No 40/94 are met.
- Therefore, the general interest, which underlies Article 7(1)(e)(ii) of Regulation No 40/94, does not allow the Board of Appeal, in applying that specific provision, to go beyond the shape represented by the contested sign and to take into account elements which do not form part of the shape actually represented by that sign.

## Pirelli Tyre: Position of the General Court

- In that regard, it is true that the scope of the absolute ground for refusal provided for in Article 7(1)(e)(ii) of Regulation No 40/94 **is not limited solely to signs formed exclusively of the shape of ‘goods’ as such.**
- Indeed, as EUIPO maintains, in essence, the general interest which underlies that provision could require signs consisting of the shape **of part of a product** that is necessary to obtain a technical result to also be refused registration. That would be the case if that shape represented, **quantitatively** and **qualitatively**, a **significant part of that product.**
- However, it is important to state that, in the present case, the **contested sign represents a single groove of a tyre tread.**
- Accordingly, in the context of the goods in question, the contested sign **does not represent a tyre tread** since it does not incorporate the other elements of a tyre tread, with which that sign creates numerous shapes, which are complex and different from the shape of each of the grooves and of each of the elements considered in isolation.

## Pirelli Tyre: Position of the General Court

- Consequently, the contested sign is not made up exclusively of the shape of the goods in question or of a shape which, on its own, represents, quantitatively and qualitatively, a significant part of those goods.
- Indeed, the **evidence** submitted by the intervener and examined by the Board of Appeal **does not establish that a single groove, in the shape identical to that represented by the contested sign, is capable of producing the technical result accepted in the contested decision.**
- That evidence shows that it is the **combination** and the **interaction** of the **different elements** which form a tyre tread and which appear repeatedly across the whole of that tread, to the point where it creates a shape that is different from those elements taken individually, **which may be capable of producing the technical result noted in the contested decision.**

## Pirelli Tyre: Position of the General Court

- It follows that **the registration of the contested sign**, the protection of which is limited to the shape which it represents, is ***not liable to prevent the applicant's competitors from making and marketing tyres which incorporate an identical or similar shape to that represented by that sign when that identical or similar shape is combined with other elements of a tyre tread*** and creates, in conjunction with those other elements, **a shape that is different from each of the elements taken individually**.
- As such, the shape represented by the contested sign does not necessarily feature on a tyre tread in a manner that enables the sign to be identified.
- The Board of Appeal was therefore wrong to take the view **that the contested sign represented a tyre tread** and that that sign consisted of the 'shape of the goods' within the meaning of Article 7(1)(e)(ii) of Regulation No 40/94.

**Part 2: Quick overview of some other interesting cases**  
**T-261/17, Bayer/EUIPO – Uni-Pharma Kleon Tsetis,**  
**Farmakeutika Ergastiria**



T-261/17, Bayer/EUIPO – Uni-Pharma Kleon Tsetis, Farmakeutika Ergastiria

- The mark for which **registration** was sought (for ‘*Pharmaceuticals*’) consists of the word element ‘salospir’ and of the figurative elements in ‘green, shades of green, white, black’. It is represented as follows:



- The opposition was based (i) on two earlier German marks: **Aspirin**  
and : **Aspirin**

T-261/17, Bayer/EUIPO – Uni-Pharma Kleon Tsetis, Farmakeutika Ergastiria

- (ii) On six earlier EU figurative marks, incl. N° 7007008:



- (iii) On the following non-registered sign:



- The grounds relied on in support of the opposition were those set out in **Article 8(1)(b), (4) and (5) of Regulation No 207/2009**

T-261/17, Bayer/EUIPO – Uni-Pharma Kleon Tsetis, Farmakeutika Ergastiria

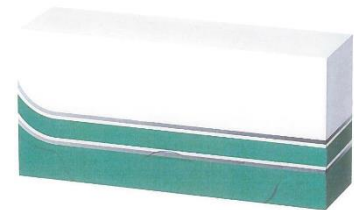
- The **Opposition Division** rejected the opposition in its entirety.
- The **Fourth Board of Appeal** of EUIPO dismissed the appeal. In particular, the Board held, that the mark applied for was different from the earlier German marks and from the earlier EU figurative marks. It also held that the applicant had not proved that German law granted protection to the non-registered sign “ASPIRIN”.
- The **General Court** dismissed the action.

Main points:

- **The dominance of the word SALOPIR** in the requested TM
- As regards the **figurative element**, the white tablet depicted in the bottom right corner was a mere illustration of the pharmaceuticals at issue and the use of white and green colour and waved lines were common graphic elements which will be perceived as merely decorative.

## T-261/17, Bayer/EUIPO – Uni-Pharma Kleon Tsetis, Farmakeutika Ergastiria

- The importance of a well-known fact: “the colour green is found in the cross used as the international pharmacy symbol and white is the most commonplace colour used on pharmaceuticals packaging” (point 42);
- Detailed evaluation, by the GC, of the pertinence of two surveys, the “neutralised packaging” survey and the “salospir” survey.
- According to the **applicant**, the survey on neutralised packaging demonstrated that the combination and configuration of the colours white and green in the mark applied for possess an independent distinctive character and the **Salospir** survey proves that **there was confusion** between the mark applied for and the applicant’s earlier marks.
- Both of only “Limited probative value” (GC)



## T-261/17, Bayer/EUIPO – Common position BoA/GC



- The third plea in law, alleging infringement of Article 8(4) of Regulation No 207/2009: **In the present case, the applicant relies on the Aspirin packaging**, on the basis of Paragraph 4(2) of the German Law on trade marks, which grants trade-mark protection to a sign used in the course of trade where such use has led to recognition of the sign in question by the relevant public ‘as a trade mark’.
- The **Board of Appeal** found that **none** of the documents submitted by the applicant **made reference to the non-registered sign relied on**. **The recognition ‘as a trade mark’ had to concern the actual sign invoked and not its individual elements which, as such, were never used in trade.**
- The **applicant** limited itself, however, to demonstrating the **reputation** of the **word mark Aspirin** and of **the neutralised packaging**, but **not** that of **the Aspirin packaging reproduced in the non-registered sign** (*which was more than a mere combination of those two elements*)

**T-537/15, Deutsche Post/EUIPO - Verbis Alfa and  
EasyPack**

## T-537/15, Deutsche Post/EUIPO - Verbis Alfa and EasyPack

- **Registration** as a mark was sought for the following figurative sign (for products and services from classes 6, 9, 35, 39):



- The opposition was based i.e. on the following earlier marks:
- German word mark **POST**
- The EU figurative trade marks:  
- The **Opposition Division** of EUIPO partially upheld the opposition on the ground that there was a likelihood of confusion with regard to the following services in Class 35: *‘Business enquiries, research surveys, organisation of exhibitions for commercial purposes’*.
- The opposition on the basis of the earlier marks **ePOST, POST** and **INFOPOST was rejected** with regard to the remaining goods and services in Classes 9, 35 and 39.

## T-537/15, Deutsche Post/EUIPO - Verbis Alfa and EasyPack

- The **First Board of Appeal** dismissed the appeal.
- In particular, it considered that, although the signs at issue shared the word element ‘post’, they showed **significant visual, aural and conceptual differences** which were sufficient to rule out a likelihood of confusion under Article 8(1)(b) of Regulation No 207/2009 or an association or mental link on the part of consumers under Article 8(5) of that regulation.
- The **GC** **dismissed the action**. Among other arguments:  
(...) **Since the term ‘post’ is likely to be seen as a mere reference to ‘postal services’ in the mark applied for, it cannot be considered to be distinctive. The common element ‘post’ does not play the same role in the two marks at issue.**

Because of the different overall impression given by the marks as a result of the **additional word** and **figurative elements**, which have no counterpart in the earlier national word mark POST and which are **more distinctive than the word element ‘post’**, that entirely descriptive element in the mark applied for is not likely to bring to mind an association with the applicant.



**T-803/16 - Glaxo Group/EUIPO - Celon Pharma**

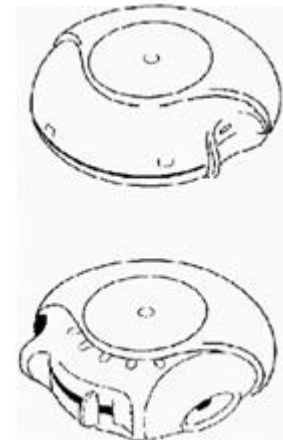
## T-803/16 - Glaxo Group/EUIPO - Celon Pharma

- **Requested** TM (for ‘*Inhalation products used for the treatment of asthma and chronic obstructive pulmonary disease*’, class 5, and ‘*inhalers*’, class 10):



- An application for **a declaration of invalidity** was based
- on several earlier national marks and, in particular, the following **French** mark No 97685112, registered on 1 July 1997

- **Registered** for the following goods in Class 10:  
‘**inhalers**’ and  
‘**medical and surgical apparatus and instruments**’.



## T-803/16 - Glaxo Group/EUIPO - Celon Pharma

- At the **intervener's request**, the **applicant** submitted documents to **establish the genuine use** of its earlier marks.
- the **Cancellation Division** upheld the application for a declaration of invalidity filed by the applicant. **For reasons of procedural economy, the Cancellation Division examined the application for a declaration of invalidity only in relation to the earlier French mark.**
- It held that **the applicant** had established that there **had been genuine use** of that mark as far as **inhalers** were concerned and that there was a **likelihood of confusion** between the earlier mark examined and the contested mark.

## T-803/16 - Glaxo Group/EUIPO - Celon Pharma

- The **Fourth Board of Appeal** annulled the decision of the Cancellation Division. **It examined of its own motion the issue of genuine use of the earlier marks, without putting questions to the parties in that regard,** and held that **the applicant had not furnished proof of such a use** in accordance with Article 57(2) of Regulation No 207/2009 (now Article 64(2) of Regulation 2017/1001).
- The **Board of Appeal** stated essentially that the applicant's goods were **marketed by listing the various medicinal substances contained in the inhaler, each time in different colours,** and **it took the view that none of the forms used were similar to the form of the contested mark.**
- It therefore held that the **applicant had failed to establish genuine use of its earlier French mark** in the form registered or in another form which did not alter its distinctive character. (...)

## T-803/16 - Glaxo Group/EUIPO - Celon Pharma

- In addition, the **Board of Appeal** distinguished between medicinal products **in Class 5 and the goods in Class 10, specifically “inhalers”**.
- According to the contested decision, the **applicant**, which does not market inhalers without medicinal products, had **failed** to prove the use of its earlier French mark for the goods for which they were registered, namely **inhalers**, but only proved the use for the respective medicinal products that they contained.
- Finally, the **Board of Appeal** held that the applicant had also **failed to prove genuine use of the other earlier marks relied on**.

## Glaxo Group/EUIPO – Position of the General Court

- In the present case, the issue of genuine use of the earlier marks was raised by the intervener before the Cancellation Division and was examined by the latter before it made an assessment of the merits of the application for a declaration of invalidity. However, the issue was not raised by the parties before the Board of Appeal:
- The intervener merely **disputed** the assessment of the Cancellation Division relating to the **existence of a likelihood of confusion** and
- The applicant **did not have a legal interest** in challenging the assessment.
- Therefore, **the issue of the genuine use** of the earlier marks was not debated in any way by the parties before the Board of Appeal, which made a ruling of its own motion on that issue.
- Furthermore, **the Board of Appeal** did not afford the parties the opportunity to state their views.

## T-803/16 - Glaxo Group/EUIPO - Celon Pharma

- Since, in the present case, the issue of the genuine use of the earlier marks had not been raised before the Board of Appeal, **it did not have competence to make a ruling of its own motion on that issue, as it was no longer the subject matter of the proceedings.**
- Such a finding is not contrary **to the principle of continuity in terms of functions between the various divisions of EUIPO**, as stated in the case-law of the Court of Justice and the General Court.
- If that continuity in terms of functions implies a re-examination of the case by the Board of Appeal, **it does not in any way imply an examination by the Board of Appeal of a case which is different from the one submitted to the Cancellation Division**, namely a case whose scope would have been extended by the addition of the preliminary issue of the genuine use of the earlier mark.

