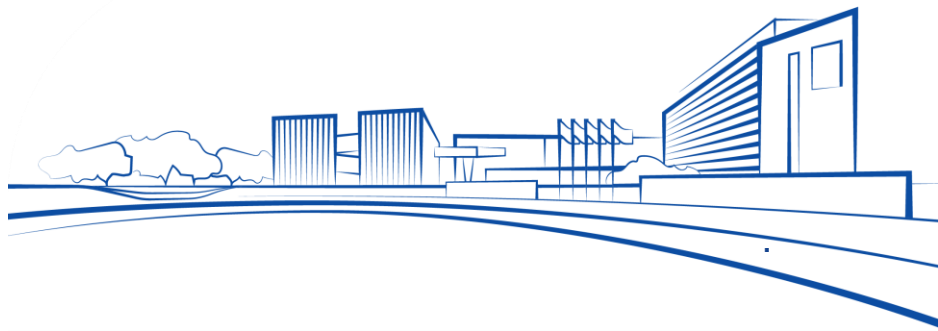


Recent EU case law on absolute and relative grounds

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Boards of Appeal Head of Cabinet, EUIPO

25 October 2024
ERA Conference



ABSOLUTE GROUNDS

08/05/2024, T-320/23, NOT MILK (fig.) (BoA confirmed)

Descriptive – Figurative mark – EUTM application rejected

- ❑ GC confirmed that the contested figurative mark is **descriptive** for milk substitutes in Class 29 and beverages consisting of a mixture of fruit and vegetable juices; vegetable juices; vegetable-based drinks in Class 32.
- ❑ EN-speaking public will immediately and directly understand the sign ‘NOT MILK’ as informing them that the goods are not a dairy product or do not contain milk.
- ❑ Moreover, the fact that the expression ‘NOT MILK’ would be perceived as a ‘**negative**’ **characteristic** of the goods concerned, that is, as information about an ingredient they do not contain, does not prevent it from being descriptive.



07/02/2024, T-220/23, CITY STADE (fig.) (BoA annulled)

CITY STADE



- 'CITY STADE' became a common name in France due to the inactivity of its proprietor
- EUTM revoked (Article 58(1)(b) EUTMR)

26/06/2024, T-595/23, representation of a hatching chick (BoA confirmed)



Non-distinctive

Audio and video devices for monitoring babies (Class 9)

Lighting devices (Class 11)

Toys (Class 28)

07/02/2024, R 2087/2023-2, VIOLETT/BLAU/OCKER/GRÜN/ROT/WEISS

Representation not clear and precise – Colour mark – EUTM application rejected

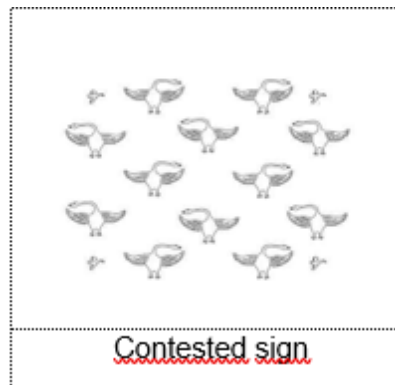
- ❑ Contested sign, applied for as a **colour mark**, cannot be registered as the **representation is not sufficiently clear and precise**.
- ❑ Representation of the colour shades in rectangles cannot constitute a restriction of the colour shades to the sequence of rectangles shown. Such a view would be inconsistent with an application for a colour mark and would have to be classified as a figurative mark.
- ❑ It is not clear which systematic arrangement of the colour shades is claimed and whether the colours are intended to have the same shape and be parallel. Neither is it clear what their proportion should be in other designs.
- ❑ Therefore, there are too many ambiguities within the application.



19/3/2024, R 1959/2023-4 DEVICE OF A PATTERN OF A GOOSE-LIKE BIRD (fig.)

Distinctive – Pattern mark – Minimum degree of distinctiveness – EUTM application allowed

- ❑ Contested sign is distinctive for the goods at issue, namely items of clothing, underwear and footwear (Class 25).
- ❑ It consists of twelve stylised representations of geese which are specific in shape, all clearly visible and a further special touch is given in the way they are arranged in an organised manner.

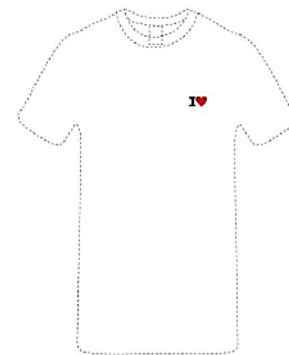


- ❑ Contested sign does not feature a level of simplicity that would rule out its protection as a trade mark and would be perceived as **more than simple decoration** on the goods at issue.
- ❑ If a trade mark has a decorative function and in addition enables the consumer to distinguish the product bearing it from the same product having a different trade origin, the mark is **not devoid of distinctive character**.

15/04/2024, R 1773/2023-1, POSITION EINES GROSSBUCHSTABENS „I“ UND EINES HERZENS AUF EINEM BEKLEIDUNGSSTÜCK

Non-distinctive – Position mark – Mere promotional and laudatory message – EUTM application rejected

- Characterisation of the contested sign as a position mark cannot establish its distinctive character in relation to clothing in Class 25.
- GC has already held in its judgment of 12/02/2021, T-19/20, I love (fig.), that the sign **I♥** lacks distinctive character throughout the EU.
- It is considered a banal, non-distinctive sign, immediately understood as ‘I love’ without further thought, with its advertising message taking precedence.
- Even if it is placed where trade marks are often affixed, consumers will not perceive it as an indication of origin.



05/04/2024, R-2246/2023-4, DEVICE OF A STICK FIGURE BEHIND A GENERAL PROHIBITION SIGN (fig.)

Distinctive – Figurative mark – Prohibition sign – Resembling pictogram – EUTM application allowed

- Contested sign is **not devoid of any distinctive character** for footwear in Class 25.
- While the stick figure's action may be associated with the goods, in the sense that it might depict the movement of bending down to put on shoes or tie laces, the contested sign clearly conveys the impression that this action is prohibited. This prohibition does not offer the perceived advantage identified by the examiner, namely, avoiding the need to bend down.
- Consequently, these elements, taken together, fail to convey the overall impression of a badge of information relating to the goods, a pictogram illustrating a function or utility or an actual instruction for use.



Contested sign



20/09/2023, R 314/2023-2, Cheese cut and arranged in the shape of a heart and 20/09/2023, R 315/2023-2, Movement of the cutting of two small cheeses



Motion mark



Cheese (Class 29)

Non-distinctive



Motion mark



16/05/2024, R 260/2021-G, COVIDIOT (fig.) (Decision by the Grand Board of Appeal)



Metal clips (Class 6)

Computer gaming software; Mobile apps (Class 9)

Board games; Toys (Class 28)



Contrary to accepted
principles of morality

Non-distinctive

RELATIVE GROUNDS



24/04/2024, T-157/23, Joyful by nature / JOY et al. (BoA confirmed)

Earlier mark	Contested sign
JOY	JOYFUL BY NATURE
Class 3: perfumery and fragrances (...)	Class 3, 4, 35, 44



- ❑ Earlier mark enjoyed high degree of reputation in the past. ‘Historical’ mark may retain a certain **‘surviving’ reputation**, including where that mark is no longer used.
- ❑ **Reputation** of a trade mark is, in general, **acquired progressively**. The same reasoning applies to the loss of such a reputation, which is also, in general, **lost gradually**.
- ❑ Unfair advantage of the repute of the earlier mark taken (Article 8(5) EUTMR)


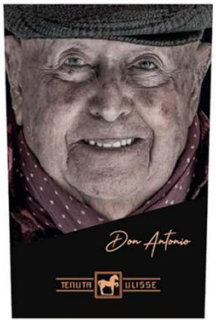
12/06/2024, T-604/22, TOUR DE X (fig.) / TOUR DE FRANCE et al. (BoA confirmed)

Earlier rights	EUTM application
<p>TOUR DE FRANCE</p> <p>(LE) TOUR DE FRANCE</p> 	
<p>Classes 9, 25, 28, 41</p> <p>Reputation claim for <i>organisation of sports competitions</i></p>	<p>Classes 25, 28 and 41</p>



- Common weak element 'TOUR DE'
- GC confirmed that there is no LoC (Article 8(1)(b) EUTMR) and no link (Article 8(5) EUTMR) with the reputed earlier marks => Opposition rejected



15/03/2024, R 10/2023-5, Don Antonio TENUTA ULISSE (fig.) / A photographic portrait of an old man (fig.)

Earlier mark	Contested sign
	
e.g. Class 33: <i>Wine</i>	Class 33: <i>Wine</i>



- ❑ Consumers would easily notice the visual differences between the two figurative signs
 - Contrasting emotional tones set by the expressions of the men, the distinct styles of attire, and the different overall colour schemes create two separate identities for each portrait
- ❑ Given the low degree of visual and conceptual similarity and the absence of enhanced distinctiveness or reputation of the earlier mark => **No LoC => Opposition rejected**


27/06/2024, R 362/2024-2, JS (fig.) / SJ (fig.)

Earlier mark - EUTM	Contested sign
	
Bags, suitcases, etc. (Class 18)	Bags and luggage of various kinds (Class 18)



- Short signs**
- No LoC, even for identical goods => Opposition rejected**

14/05/2024, R 2466/2023-2, Keralan / KERÀ (fig.) et al.

Earlier marks	Contested sign
	<p style="text-align: center;">Keralan</p>
<p>Class 3</p>	<p>Class 3</p>



- ❑ Evidence showed that the prefix ‘KERA’ refers to ‘keratin’ or to the treatment of ‘keratosis’ in the cosmetics sector
- ❑ **Verbal element ‘KERÀ’ of the earlier marks is weak and therefore has low impact on the comparison of the signs**
- ❑ Where the elements of similarity between two signs arise from the fact that they share a component which has a weak inherent distinctive character, the impact of such elements of similarity on the global assessment of the likelihood of confusion is itself low
- ❑ The signs are distinguishable => **No LoC => Opposition rejected**

06/03/2023, R 1033/2023-2, DUTCH GENQUILA / TEQUILA

Earlier PGI	Contested sign
TEQUILA	DUTCH GENQUILA
Spirit drink	Class 33: <i>Wine</i>



- Evocation of a Protected Geographical Indication ('PGI') 'TEQUILA' (Article 21(2)(b) of Regulation (EU) No 2019/787)**
- Opposition Division's decision **partially annulled**
- Opposition upheld and contested EUTM application rejected also for *wine*

Judgments by the Court of Justice and pending preliminary ruling requests

- ❑ [20/06/2024, C-801/21 P](#), EUIPO v Indo European Foods ('Basmati'), by which EUIPO's appeal was dismissed, concerning the question of continued interest in bringing proceedings before the General Court after disappearance of the earlier right during opposition proceedings.

Pending requests for a preliminary ruling before the CJEU concerning trade marks:

- ❑ [28/02/2024, C-168/24](#), by the Cour de Cassation (France) ("Castelbajac"-case) (deceptiveness of a trade mark containing the name of a designer)
- ❑ [08/05/2024, C-341/24](#), Duca di Salaparuta, by the Supreme Court of Italy (conflicts between trade marks and GIs for wines, namely 'Salaparuta' PDO from Sicily)
- ❑ [10/06/2024, C-412/24](#), Fauré Le Page, by the Cour de Cassation (France) (deceptiveness of a trade mark containing the element '1717')



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Thank you