

# EUIPO'S BOARDS OF APPEAL

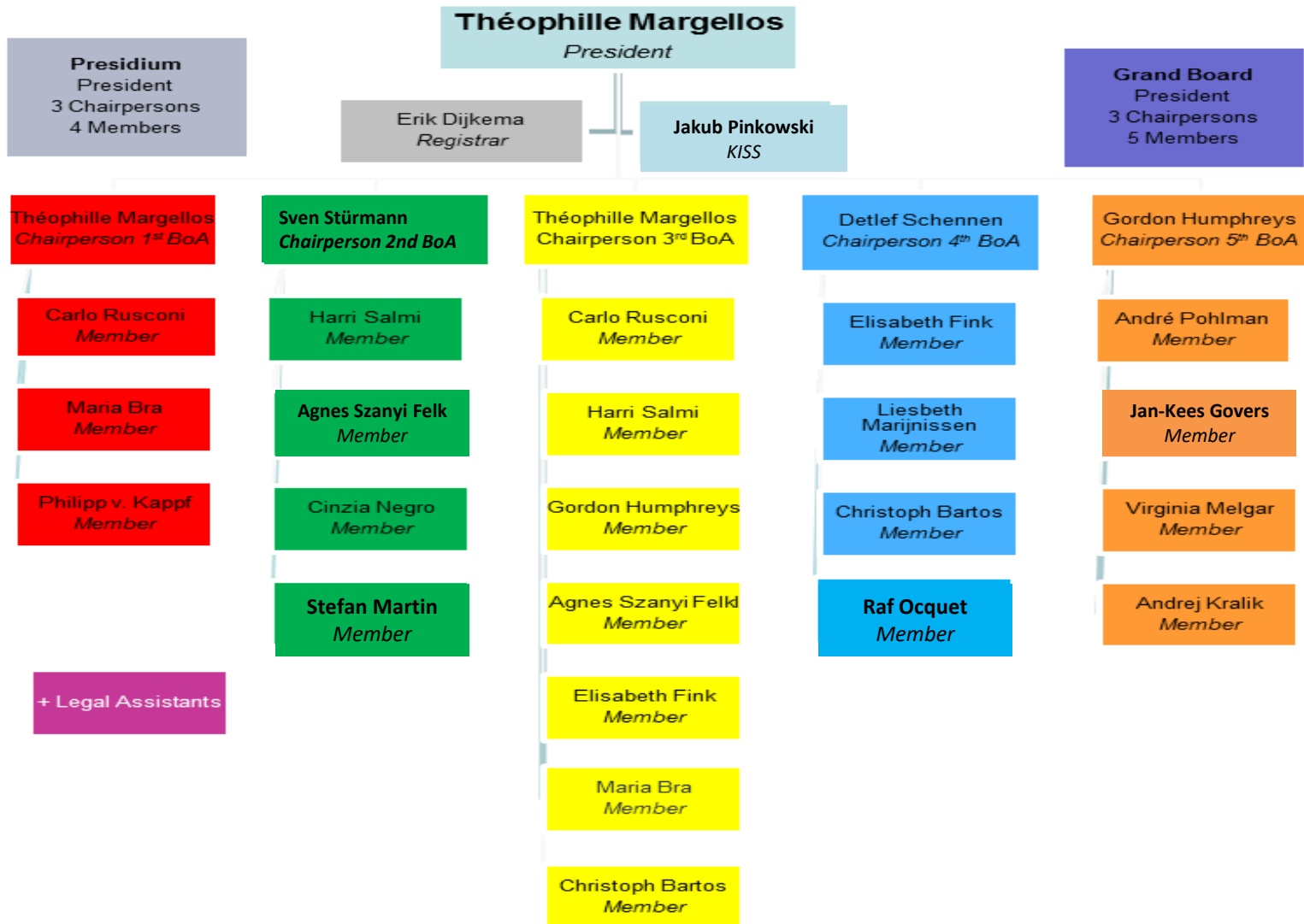
Sven Stürmann  
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Legal Assistant of the 5<sup>th</sup> Board of Appeal

AIPPI, Stockholm  
26 January 2018

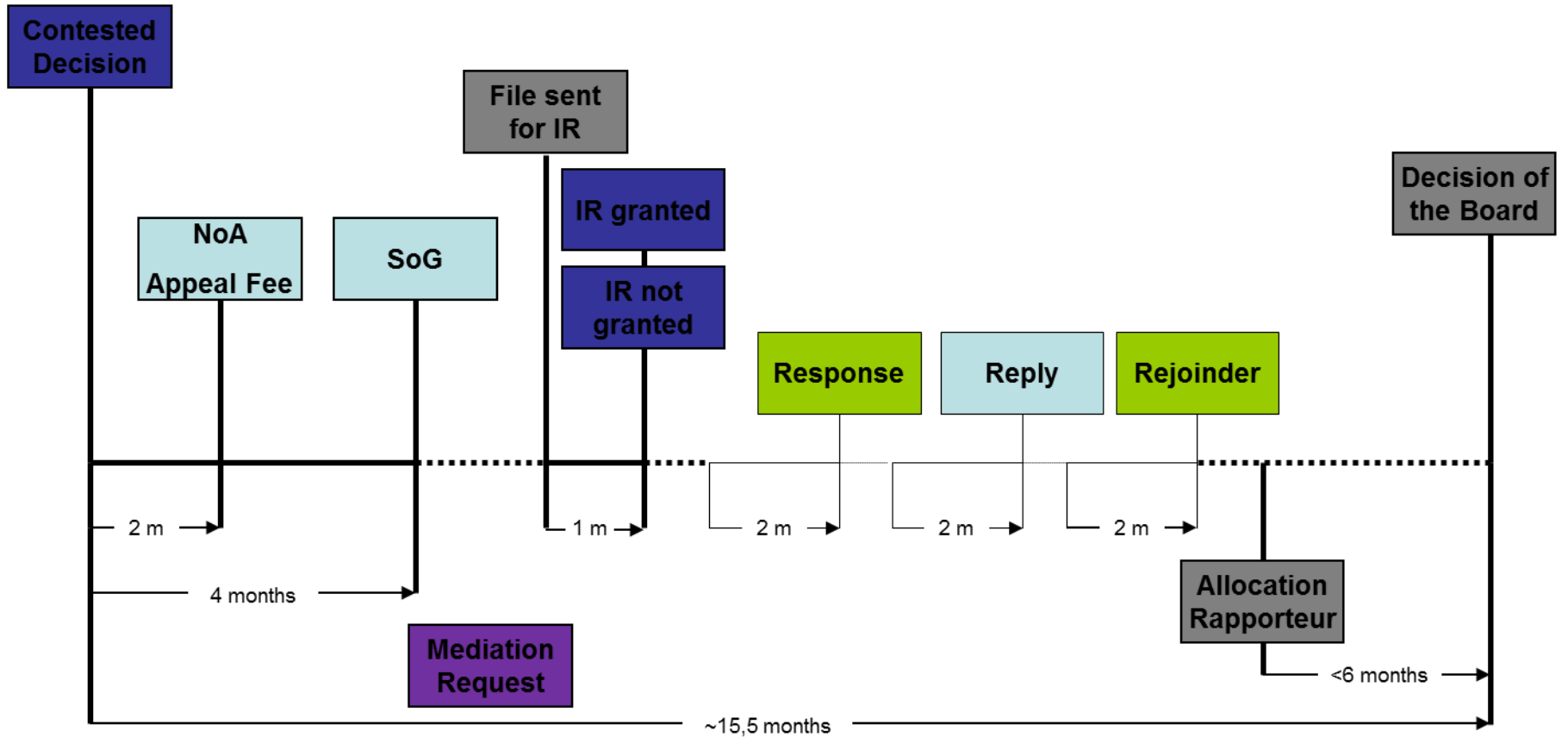
# Composition

# THE BOARDS OF APPEAL - COMPOSITION



# The Appeal procedure

# PROCEDURE IN A NUTSHELL



# EUIPO Key Figures

## SOME KEY FIGURES

	2015	2016	2017
<b>EUTMA</b>			
• Direct	108 515	135 259	111,218
• International	8 053	18 785	22 954
• By <b>Swedish</b> companies		3 283 (11 <sup>th</sup> )	3 097 (12 <sup>th</sup> )
<b>APPEALS</b>			
• Filed	2 613	2 446	2 761
• By <b>Swedish</b> appellants	36	35	26
• Decisions taken	2 911	2 884	2 699
<b>JUDGMENTS OF THE GC</b>	296	332	292
<b>APPEAL RATE OF BOA DECISIONS</b>	9.7%	9.6%	9.1%
<b>BOA DECISIONS CONFIRMED BY GC</b>	82.2%	85.7%	86%
• Ex-parte	93.2%	95.7%	92,5%
• Inter-partes	77.2%	81.4%	83.5%

# The Boards of Appeal Activities



## The Boards of Appeal Activities

- **Effective Dispute Resolution**
- **eAppeal front and back office**
- **2<sup>nd</sup> Edition of the [IP Case Law Conference](#)**

# Trade Mark Cases – Absolute Grounds

# Distinctive Trade Marks

R-362/2017-4 – 13/9/2017



Class 6 – Common metals and their alloys; Metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; Safes; common metals; Ores.  
Class 14 – Precious metals and their alloys; jewellery, precious stones; horological and chronometric instruments; precious metals.

Class 40 – Treatment of materials; treatment of precious and common metals; treatment of alloys.

‘That figurative element is neither totally insignificant in terms of position or size, nor is it commonplace, nor is it a true-to-life depiction of a human being. [...] The Board finds that this figurative element is sufficient to endow the mark with distinctive character and to add matter to the mark of such a kind that it no longer ‘exclusively’ consists of characteristics in the sense of Article 7(1)(c) EUTMR.’



Classes 16, 29, 30, 35

‘Sobald der Bildbestandteil nicht mehr selbst beschreibend ist und wenn er auch nicht aus anderen [...] Gründen, wie einer extrem geringen Größe oder einer Üblichkeit als Gestaltungsmerkmal, zu vernachlässigen ist, besteht das Anmeldezeichen nicht mehr „ausschließlich“ aus schutzunfähigen Angaben. Damit begründet in der Tat bereits der Bildbestandteil selbständig die Schutzfähigkeit des Anmeldezeichens, unbeschadet dessen, dass nachfolgend weitere Wortelemente vorhanden sind, die für sich genommen beschreibend sind.’

R 1983/2014-2 – 11/2/2015



Class 11 – Electric range for household purposes; gas range for household purposes; electric ovens; electric refrigerators.

‘Even if the image depicted were to be perceived as an allusion to the idea of cleaning, it must be seen as somewhat arbitrary. The representation is not banal, it is not a customary reproduction of an (easy to) clean coating, nor a straightforward stylised representation of one. Based on an evaluation of the mark as a whole, it cannot be denied that the figurative elements of the sign, although perhaps not highly imaginative, are sufficient to endow the mark with a minimum degree of distinctiveness.’



**megadental**

Classes 3, 5, 7, 9, 10, 11, 35

‘... dieses Bildelement [weist] aufgrund der, wenn auch banalen, Stilisierung eine minimale Unterscheidungskraft auf. Somit kann eine Eintragung des angemeldeten Zeichens nicht ausgeschlossen werden. Die Kammer betont ausdrücklich, dass die vorliegende Anmeldung einen Grenzfall darstellt, und lediglich aufgrund der minimalen Unterscheidungskraft des Bildelements als eintragungsfähig angesehen wird. Dementsprechend ist der Schutzbereich der Anmeldung sehr eng.’

# Non-distinctive Trade Marks



R-2275/2016-1 – 12/1/2017



Klasse 9 - Brillen (Optik); Brillengläser; Brillenfassungen; Sonnenbrillen; Ski- und Sportbrillen; Schutzbrillen; Brillenetuis; Kontaktlinsen; Kontaktlinsenetuis; optische Apparate und Instrumente; optische Linsen.

‘Bei Anblick dieses Zeichens muss der Verbraucher keine weiteren Überlegungen anstellen, um in Verbindung zu den verfahrensgegenständlichen Waren einen anderen Sinn in dem Bildelement als eine Brille zu erkennen. Es ist weder in der Lage, Verbraucher von der eindeutigen Aussage des Wortes „unbreakable“ im Zusammenhang zu Brillen und deren Zubehör abzulenken, noch dem Gesamtzeichen Unterscheidungskraft zu verleihen.’

R-457/2017-2 – 12/9/2017



Klasse 35 – Einzelhandelsdienstleistungen in Bezug auf Kraftfahrzeuge.

Klasse 39 – Vermietung von Garagen und Parkplätzen.

Klasse 41 – Organisation von kulturellen Veranstaltungen [Events].

‘Im vorliegenden Fall bestehen die Bildelemente im Wesentlichen aus der leicht erkennbaren Silhouette eines Kraftfahrzeugs. Im Zusammenhang mit den beanspruchten Dienstleistungen und der wörtlichen Bedeutung des Ausdrucks „Sammlerstücke“ bietet das Bildelement lediglich eine (angesichts der Art von Dienstleistungen sogar überflüssige) Klarstellung zur Tatsache, dass es sich bei den besagten Sammlerstücken um Kraftfahrzeuge handelt. Somit ist das Bildelement an sich gesehen nicht in der Lage, den beschreibenden Charakter des Wortelements im Gesamteindruck dieses komplexen Zeichens zu entkräften’

R-1329/2017-4 – 19/12/2017

Classes 1, 9, 12



‘... the figurative elements are indeed of an ancillary nature, forming a circular surrounding which serves to highlight the central and core word element of the sign, ‘ABS’. [...] regardless as to whether the design of this sign was carefully thought-out. The relevant public is unlikely to perceive these graphical elements of consisting of elements of fantasy but instead as a mere naturalistic depiction of what would appear to be a component of a circular part in a vehicle’s braking system, in banal colours. To the extent that the combination of colours, in particular the shades of grey and black, give a shiny or metallic appearance to the figurative device as a whole, this reinforces the impression as merely the depiction of a vehicle part connected to brakes. The small red section within the inner and outer circle is hardly noticeable and is insufficient to give the sign as a whole any distinctive character. The three segments of a third inner circle attached to the inner side of the inner circle are hardly noticeable, and if noticed will be perceive merely as relating to some technical function of the circular brake part as depicted.’

R-534/2016-5 – 20/11/2017

Classes: 17, 22, 24, 25, 27, 35



‘Die grafischen Elemente wiederholen und unterstreichen allesamt den Sinngehalt der Wortelemente „SWISS“ und „WOOL“ und können entsprechend nicht von der rein beschreibenden Aussage des Zeichens ablenken oder ihm sonst Unterscheidungskraft verleihen. Insbesondere die Abbildung eines Schafs vermag dem Zeichen keine Schutzfähigkeit zu verleihen.’

# Trade Mark Cases – Relative Grounds

## R 1743/2017-5 (Slovak mark vs. EUTM)

### Dobrý sirup Jupí



Earlier marks



Contested sign

Contested goods in Class 32.

§ 31: ‘... the coinciding element ‘Dobry sirup’ will be understood by the relevant Slovak public, as correctly defined by the Opposition Division, as meaning ‘good syrup’ or ‘high-quality syrup’. The additional word elements in the earlier marks, namely ‘Jupí’, will be understood as meaning ‘wahey’ or ‘hooray’ whereas the elements ‘lesna zmes’, ‘pomaranč’ and ‘malina’ will be understood as ‘mixture of forest fruits’, ‘orange’ and ‘raspberry’ or ‘raspberry fruit’ respectively, i.e. as a reference to flavour, a meaning which is further emphasised by the accompanying depictions of the respective fruits in the earlier marks...’.

§ 39: ‘... given the descriptive and non-distinctive nature of the coinciding element ‘Dobry sirup’, consumers are unlikely to award that element attention or to retain it in their minds [...]. Indeed the descriptive nature of that element does not lend itself particularly well to function as an identifier of commercial origin when viewed in isolation, and given that this component is presented in very different contexts in the marks at hand, these differences serve to neutralise any similarities .’.

R 412/2017-5, 18/8/2017 (both EUTM's)



Earlier mark

**TASTE HAPPINESS**

Contested sign

Contested goods in Class 29, 30, 32.

§ 41: '... the Board notes that the opposition was examined on the basis of non-English-speaking consumers with a lower level of attention, who, in the Board's view, are not likely to understand even very basic terms in English. Furthermore, the translation of the word 'happiness' in other EU languages does not even resemble the term in English, for example, 'szczęście' in Polish, 'felicidad' in Spanish, 'bonheur' in French, or 'Glück' in German, while the word 'taste' is respectively 'smak', 'gusto', 'goût' and 'Geschmack', which only confirms the argument that the word elements of the signs are meaningless in other EU languages, apart from English.'

§ 51: '... the contested sign may give rise to a likelihood of confusion that leads the relevant non-English-speaking part of the public to perceive the undertakings behind the marks as being economically connected or linked.'

## R 0004/2017-2, 13/12/2017 (several national marks vs. EUTM)

### **DERMAZIN**

Earlier marks  
(Romania, Poland, Slovenia,  
Bulgaria, Croatia)

### **Dermacy**

Contested sign

Contested goods and services in Class 3, 5, 44.

§ 61: 'Despite the fact that for part of the public the earlier marks are partly composed of non-distinctive elements or weak elements, i.e. 'DERM(A)', its combination together with 'CY' makes the marks distinctive'.

§ 71: 'It is true that the prefix 'DERMA' of the signs under comparison has a weak distinctiveness for the goods and services at hand. However, the low visual but high aural similarities between the respective suffixes 'CY' and 'ZIN' are sufficient in order to establish a likelihood of confusion.'



R 2029/2016-2, 20/11/2017 (EUTM vs. EUTM)



Earlier mark



Contested sign

Contested goods in Class 25, 28.

§ 28: All relevant users in the EU will understand the basic English term active. (09/12/2010, T-307/09, NATURALLY ACTIVE, EU:T:2010:509, § 25).

§ 29: The term active is descriptive for the goods at issue, indicating their purpose and intended use.

§ 50: Considering the low degree of distinctiveness of the term active, a likelihood of confusion can be excluded even for identical goods.

## CP 5, Conclusion ..

### Coincidence in element with low distinctive character

#### *no LoC unless*

- other elements of a lower (or equally low) degree of distinctive character or are of insignificant visual impact and the overall impression of the signs is similar

OR

- overall impression of signs is a least highly similar

### Coincidence in element with no distinctive character

#### *no LoC unless*

- signs contain other figurative or word elements which are similar

AND

- the overall impression of the signs is highly similar or identical



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Thank you