



Hunting with Artemis

9th Session: EU Case-Law Update

Recent case-law of the General Court EU¹

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Abstract

Trademark cases and design cases constitute a very important part of the workload of the General Court EU, as approximately one third of its judgments are given in these areas. Among the interesting subject-matters analyzed this year at the General Court, it is possible to highlight questions linked to different aspects of territoriality², questions concerning the interpretation of legal concepts like “well-known facts”³, the “neutralization” of visual and phonetic similarities by a strong conceptual difference⁴, questions relating to the understanding of a language by non-native speakers, including the possibility of an objective categorization of words pursuant to the fact, whether they could be considered as basic words of “day-to-day” use⁵, as well as issues relating to the modification of a meaning of a word or an expression in time⁶. Many cases concerned the “independent distinctive position” of an element in a composite trademark⁷ or the use of a “position mark”, without alteration of its distinctive character, in the context of a proof of a genuine use of a trademark in a revocation proceeding⁸. Interesting points concerning the proof of a genuine use were also linked to the use of a domain name, fulfilling the role of a trademark⁹. Important clarifications were given in recent case law for a better understanding of the “public policy” and “morality” grounds for refusal of a registration of a trademark¹⁰. Many judgments of the General Court dealt with procedural and substantial issues linked to the possibility to prove that a trademark had a reputation. The effects of such a reputation were also analyzed. In this area, the theoretical issues included the question, whether – and to what extent – the Boards of Appeal of the EUIPO were obliged to take into account previous decisions adopted at the

¹ Andrej Stec (Référéndaire, Cab. J. Schwarcz); all the opinions in this text are personal and not binding for the institution

² Judgments from 7th December 2017, Case T-61/16, Coca-Cola v EUIPO - Mitico (Master); from 26th January 2018, Case T-304/16, bet365 Group v EUIPO - Hansen (BET365);

³ Judgment from 3rd November 2017, Case T-36/17, Forest Pharma v EUIPO - Ipsen Pharma (COLINEB)

⁴ Judgment from 26th April 2018, Case T-554/14, Lionel Andrés Messi Cuccittini/EUIPO– J-M.-E.V. e hijos, SRL (MESSI/MASSI)

⁵ Judgment from 23rd February 2018, Case T-367/16, Brunner v EUIPO – CBM (H HOLY HAFERL SHOE COUTURE)

⁶ Judgment from 20th April 2018, Case T-439/16, holyGhost GmbH v EUIPO;

⁷ Judgments from 20th September 2017, Cases T-350/13 and T-386/15, Jordi Nogues v EUIPO - Grupo Osborne (BADTORO);

⁸ Judgment from 17th January 2018, Case T-68/16, Deichmann/EUIPO – Munich (Figurative mark representing a cross on the side of a sports shoe)

⁹ Judgment from 14th December 2017, Case T-304/16, bet365 Group v EUIPO - Hansen (BET365)

¹⁰ Judgment from 15th March 2018, Case T-1/17, La Mafia Franchises v EUIPO - Italie (La Mafia SE SIENTA A LA MESA); Judgment from 23rd February 2018, Case T-69/17, Constantin Film Produktion v EUIPO (Fack Ju Göhte)

administrative level (at the EUIPO), already confirming the existence of a reputation for a specific trademark¹¹. This issue has broader implications, as a similar logic could be transposed by analogy to other areas, for example, concerning the impact of previous administrative decisions adopted in the comparison of specific products or services, i.e. in opposition proceedings, on further cases, including on absolute grounds of refusal. Similarly, it is important to highlight that an answer was looked for as to whether previous administrative decisions adopted at the first level (i.e. by the opposition division of the EUIPO), which were not appealed, had to be considered as having a comparable impact as decisions of the Boards of Appeal of the EUIPO, in the context of the harmonization of the administrative practice on specific points of law. It might be added that in some other cases, in particular concerning the interpretation of the notions of non-registered trademarks and other signs used in the course of trade, new precisions were included, for example as to the obligation by the parties to inform about the applicable national law or as to the scope of action required from the Boards of Appeal of the EUIPO in this regard, in particular in reaction to first elements of proof given by the parties in *inter partes* proceedings¹². Still in regard of non-registered anterior trademarks, the question of whether it was necessary to prove, in an opposition proceeding, the exclusive ownership of a trademark, on which the opposition was based, was highlighted¹³. In the more typical area of the comparison of the signs in the process of analyzing the likelihood of confusion, the General Court had to deal with questions like the strength of descriptive elements in complex trademarks and the importance of a similar structure of the compared trademarks¹⁴, the eventuality of the consumer pronouncing a purely figurative trademark¹⁵, or the importance of the fact that a verbal trademark contained both upper and lower-case letters¹⁶. Finally, the question of the validity and effects of anterior national trademarks considered by some parties to the proceedings as being generic, descriptive or lacking any distinctive character, was also present in some judgments¹⁷.

The presentation will focus on a limited number of judgments of the General Court, which are, in my personal view, of fundamental interest and might have impact on further case law¹⁸.

¹¹ Judgment from 1st February 2018, Case T-105/16, Philip Morris Brands v EUIPO - Explosal (Superior Quality Cigarettes FILTER CIGARETTES Raquel); See also judgment from 9th September 2016, Case T-159/15, Puma v EUIPO - Gemma Group (Bounding feline) and the Opinion of AG Wathelet, delivered on 25th January 2018, in Case C-564/16 P, EUIPO v Puma

¹² Judgment from 24th April 2018, Case T-183/17, Menta y Limón Decoración v EUIPO-Ayuntamiento de Santa Cruz de La Palma (A man in a regional dress)

¹³ Judgment from 11th December 2017, Case T-249/15, JT v EUIPO - Carrasco Pirard (QUILAPAYÚN)

¹⁴ Judgment from 16th January 2018, Case T-398/16, Starbucks v EUIPO - Nersesyan (COFFEE ROCKS)

¹⁵ Judgment from 4th Mai 2017, Case T-25/16, Haw Par Corp./EUIPO - Cosmowell (GELENKGOLD)

¹⁶ Judgment from 20th April 2018, Case T-439/16, holyGhost GmbH v EUIPO;

¹⁷ As to allegations concerning the generic character of an anterior trademark, see, i.e., judgment from 20th February 2018, Case T-118/16, Deutsche Post AG/EUIPO– bpost NV (BEPOST)

¹⁸ Case T-554/14, Lionel Andrés Messi Cuccittini/EUIPO– J-M.-E.V. e hijos, SRL (MESSI/MASSI); Case T-105/16, Philip Morris Brands v EUIPO - Explosal (Superior Quality Cigarettes FILTER CIGARETTES Raquel); Case T-61/16, Coca-Cola v EUIPO - Mitico (Master); Case T-249/15, JT v EUIPO - Carrasco Pirard (QUILAPAYÚN)