

Use of a trade mark in a form differing from the one registered

Lina LAPINSKAITE
Legal Practice Service, ICLAD, EUIPO
ECTA workshop, Vilnius, 07/12/2017

Structure of the presentation

- I. Legal framework
- II. Main principles relating to the application of Art 18(1)(a) EUTMR
- III. Typical situations of alteration
- IV. Recent case law on Article 18(1)(a) EUTMR

Preliminary remarks

- No examination of use *ex officio*
- Means of defence:
 - Applicant for EUTM in opposition proceedings (Art 47(2) EUTMR)
 - EUTM proprietor in cancellation proceedings (Art 64(2) EUTMR)
- Means of attack:
 - Applicant for revocation of EUTM (Art 58(1)(a) EUTMR)
- Burden of proof: trade mark proprietor

Article 10(3) EUTMDR

Indications concerning place, time, extent and **nature of use** for the goods and services in respect of which the trade mark is registered

I. Legal framework

Article 18(1) EUTMR

- Trade marks must be used in the form they are registered
- [S]hall also constitute use ... use of the EU trade mark [and by analogy also of national trade mark],
in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered ,
regardless of whether or not the trade mark in the form as used is also registered in the name of the proprietor

II. Main principles of Art 18(1)(a) EUTMR

1. No strict identity between the sign as registered and the sign as used

- *Rationale*: the owner should be able to adapt the sign to marketing and promotion requirements (C-252/12, Specsavers)

2. Signs 'broadly equivalent' differing only in 'insignificant respects' or 'negligible elements' (T-194/03, Brainbridge)

3. TEST: do differences alter distinctive character of sign as registered?

- Implies a direct comparison of sign as registered and sign as used
- *Reference point* - mark as registered (not mark as used)

II. Main principles of Art 18(1)(a) EUTMR

- Assessment of distinctive character in the registered mark

- Assessment of the distinctive or dominant character of the components added:
 - Intrinsic qualities
 - Relative position within the mark

- Interdependence between the strength of the distinctive character of the mark and the effect of alterations
 - The lower is the distinctive character - the easier it will be to alter it by adding distinctive components

III. Typical situations of alteration under Art 18(1)(a) EUTMR

1. Additions

2. Omissions

3. Other alterations

Use of several marks simultaneously

1. Additions

Addition of verbal and/or figurative elements

T-426/13

AINHOA

Registered form

AINHOA BIO

AINHOA LUXE

AINHOA MINERAL



Used form

Class 3: Cosmetics

1. Additions

T-489/13



Registered form



Used form

Class 25: Clothing

T-514/10

FRUIT

Registered form

FRUIT OF THE LOOM

Used form

Class 25: Clothing

2. Omissions

Omission of verbal and/or figurative elements

T-46/13



Registered form



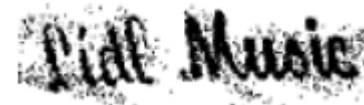
Used form

Class 25: T-shirts, beachwear

T-225/12



Registered form



Used form

Class 15: Musical instruments

2. Omissions

T-46/13



La Sabiduría del Sabor

Registered form



Used form

Class 29: Foodstuffs

Class 33: Liqueurs from Navarra

- 'Sabores de Navarra' means 'tastes/flavours of Navarra'
- 'La subiduría del sabor' means 'the wisdom of flavour'

3. Other alterations

Change of typeface, upper/lower case, colours

T-690/14



Registered form



Used form

T-83/14



Registered form



Used form

3. Other alterations

T-204/12

VILA VITA PARC

Registered form

vila vita hotel & feriendorf Pannonia

Used form

Class 39: Transport, travel arrangement

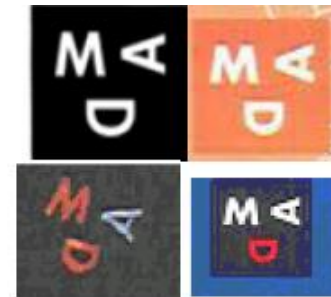
Class 43: Provision of food and drink; temporary accommodation

3. Other alterations

R 2041/2013-4



Registered form



Used form

Class 25: Clothing

Change in colour(s): Common Practice EUIPO and national offices (2014)

No alteration of trade mark's distinctive character only if:

- the main and distinctive word /figurative elements coincide
- the contrast of shades is respected
- (combination of) colour(s) not distinctive in itself
- colour is not one of the main contributors to the mark's overall distinctiveness

3. Other alterations

R 2041/2013-2



Registered form



Used form

Class 9: Data carriers
Class 16: Books

Mark used together with other signs or indications

- simultaneous use of house mark and product mark (T-29/04, Cristal)



- special case of superposition of word elements on purely figurative marks

(C-12/12, Colloseum)



IV. Recent case law on Art 18(1)(a) EUTMR

T-766/15



Registered form



Used form

Classes 29, 30, 31

IV. Recent case law on Art 18(1)(a) EUTMR

T-233/15

AD-1841-TY

Registered form



Used form

Class 25: Clothing

IV. Recent case law on Art 18(1)(a) EUTMR

T-146/15



Registered form



Used form

Class 25: Clothing

IV. Recent case law on Art 18(1)(a) EUTMR

T-333/15

N N



NÚÑEZ I NAVARRO

Oficinas Centrales
Comte d' Urgell, 230 - 08036 Barcelona
Teléfono 933.636.950 - Fax 934.107.099



Registered form

Used form

Class 36: Insurance; financial affairs; monetary affairs; real estate affairs

Thank you for your attention



www.euipo.europa.eu



@EU_IPO



EUIPO

Thank you