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RELATIVE GROUNDS

BOIP WEBINAR 2022

29 November 2022 – Eline Schiebroek & Camille Janssen





Agenda

1. Relative grounds

- Tips & tricks



2. LoC and the 2 stage assessment

- Tips & tricks



3. Reputation

- Tips & tricks

4. Agent and Agri cases

5. Questions





1. Relative grounds and tips & tricks

What are the relative grounds?

Relative grounds concern an earlier 'right'

Mentioned in Article 2.2ter BCIP:

- 1 (a) identical signs and identical goods and services
- 1 (b) identical/similar signs and identical/similar goods -> LoC
- 3 (a) identical/similar signs with reputation -> link and injury
- 3 (b) tm application agent -> no authorization/no justification
- 3 (c) protected designation of origin/geographical indication





Question 1 (Poll)

How many decisions has BOIP published this year?
(oppositions and cancellations regarding relative grounds)

A. <75

B. 75 – 150

C. >150





Tips & Tricks



Procedural differences with EUIPO



- No Boards of Appeal, straight to the Benelux Court of Justice



- BOIP is not a party, explicitly mentioned:
 - Opposition (Article 2.16 paragraph 4 BCIP)
 - Cancellation (Article 2.30ter paragraph 4 BCIP)



- BenCJ 18 October 2022, C-2022/9, point 10:
No irregularity that can be repaired, because this would mean that the appeal period would be extended



2. LoC and the 2 stage assessment



Equivalenza (C-323/18) and BenCJ ruling



- Stage 1:
 - Comparison of visual, aural and conceptual impression
 - Comparison of goods & services
- Stage 2: global assessment of the likelihood of confusion
- When and how does distinctiveness play a role?
 - BenCJ 15 June 2022, C-2020/20 (ProAffinityA2)
 - BenCJ 18 October 2022, C-2021/5 (Luxauto.lu)



Stage 1: Analysis of the elements

- Includes the distinctive character of these elements
- In general, descriptive and non/weak distinctive elements have less weight in the analysis of the similarity
- However, they cannot be ignored
- If the word element is descriptive, this could mean that the figurative element is of more importance
- Moreover, a descriptive element could be dominant in the overall impression. BUT: This must be substantiated



Stage 2: Global assessment



- Relevant public and level of attention
- Assessment of the distinctiveness of the trademarks as a whole
- Reputation and acquired distinctiveness
- Coherence between the similarity of the signs and the goods and services



Tips & Tricks

Regarding scope of the proceedings



- BenCJ 18 October 2022, C-2021/13 (Sitel)
 - Limitation of contested G&S in arguments by using bold typeface
 - BOIP involved all G&S in assessment



- BOIP opposition 19 July 2022, 2015272 (MachVoice)
 - Limitation of opposition in arguments by underlining



- Clearly indicate the goods and services on which the opposition is based and directed against.

Question 2 (poll)

What do you think of our new lay out in opposition and cancellation decisions?



A. Good improvement

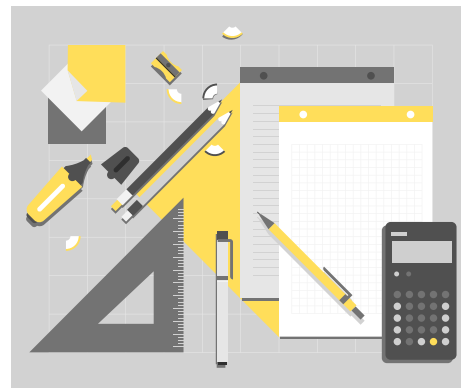


B. Could be better

C. No opinion



D. Didn't notice it yet





3. Reputation

Conditions Article 2.2ter (3)(a)

- The signs must be either **identical or similar**
- The opponent's trademark must have a **reputation**
 - **Prior** to the filing of the contested trademark (priority date)
 - With **the public** concerned
 - For the **goods and/or services** on which the opposition is based
 - In the **territory** concerned
- The public establishes a **link** between the sign and the mark.
- Risk of injury: use of the contested trademark would take **unfair advantage** of, or be **detrimental** to, the **distinctive character** or **repute** of the trademark invoked
- There is **no due cause** for the use of the contested sign



Public and G&S concerned

BenCJ 7 March 2022, C-2020/17 (URUS):



Relevant for the assessment are:

- The specific G&S for which the TM has a reputation
 - SUVs vs Financial and Business services
- The public among which the TM has a reputation
 - High level of attention
- The relevant public of the contested services
 - Level of attention higher than normal

In oppositions and cancellations factual marketing circumstances are not relevant (different from infringement)



Territory concerned

BenCJ 18 October 2022, C-2021/13 (Sitel):



- EUTM invoked with a reputation in Germany
- However, with an opposition against a BX trademark a reputation must also be shown for the Benelux
- Evidence submitted must relate to the Benelux market





Use to be shown according to the ECJ

Acquired Distinctiveness

Europolis: Use where distinctiveness is lacking

Not all use is the same

Enlarged protection

Pago/ Chevy: Local rep sufficient

Genuine use

Onel: Full territory of validity





Tips & Tricks



Regarding proof of use

- Separate request is needed for requesting proof of use
 - Rule DG 13/9/2022 (direct result of ILUNO case, C-2019/19).

Other ways to request PoU are no longer valid in cases filed after 13 September 2022.

- Additional evidence in appeal is possible
 - BenCJ 18 October 2022, C-2021/15, (BENRUS)

Already clear from ICI Paris (A 2013/1): new evidence in appeal is permitted to substantiate a ground or defense that was raised in first instance





4. Agent and Agri cases



TM application by an agent or representative

- Opposition 2016381, 22-08-2022 (NOORAYA)
- Opposition 2015752, 4-11-2022 (Ô SAVEUR)



Requirements for invoking:

- Action filed by holder of a trademark
- The earlier right does not need to be a Benelux trademark (logical).
- Opponent or claimant should demonstrate on which right the action is based

Different from bad faith (no earlier right necessary)





Requirements for granting

- Defendant is/was the agent or representative of the TM holder
- Registration is made in name of the agent/representative
- No consent for registration
- No legitimate reasons for the application
- It must concern identical or similar signs and G&S

Objective: to prevent misuse by agents or representatives by taking advantage of the knowledge they have because of the relationship with opponent

Relevant case law:

- GCEU, T-262/09 (First Defense Aerosol Pepper Projector)
- CJEU, C-809/18 P (Mineral Magic)

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Cheese + Wine = Good time





Special protection for agricultural products

- Protected designation of origin (PDO)
 - Opperdoezer Ronde
 - Beurre rose
- Protected geographical indications (PGI)
 - Jambon d'Ardenne
- Traditional speciality guaranteed (TSG)
 - Hollandse nieuwe
 - Kriek
- Traditional terms for wine (TTW)
 - Grand cru



Union legislation



- Specific Regulations decide the scope of protection
- At this moment 4 Regulations:
 - EU 1308/2013 (wines)
 - **EU 1151/2012 (agricultural products and foodstuffs)**
 - EU 2019/787 (spirit drinks)
 - EU 251/2014 (aromatised wine products)



EU 1151/2012 (agricultural products and foodstuffs)

Article 13: Protection of registered names if:

- Sub a: any direct or indirect commercial use of registered name for comparable product
- Sub b: any misuse, imitation or evocation
 - *Even if true origin is indicated (delocaliser)*

Article 14: Relation with trademarks:

- Trademark that would violate article 13 must be refused or invalidated
- Relating to a product of the same type

What is evocation?

No definition of 'evocation' mentioned in the Regulation

Relevant case law:

- Cambozola (1999, C-87/97)
- Cognac (2011, C-4/10 and C-27/10)
- Viiniverla (2016, C-75/15)
- Glen Buchenbach (2018, C-44/17)
- Queso Manchego (2019, C-614/17)

Oxford dictionary:

The act of bringing a feeling, a memory or an image into your mind



Definition of evocation

When confronted with the disputed sign:

The image triggered directly in his/her mind is that of the product whose name is protected

Presumed reaction of the consumer.



Assessment of evocation

- Visual and phonetic similarity (*beginning, ending, length*)
- Conceptual 'proximity' (*image triggered in the mind*)
- Figurative elements could also cause evocation
- Appearance of the product: objective characteristics
 - Blue cheese
- *Important: even if there is no LoC, there can still be evocation*



Question 3 (poll)

What evokes Taai-Taai?

- A. Thailand
- B. Sinterklaas
- C. Steamboat
- D. Ozosnel
- E. All of the above

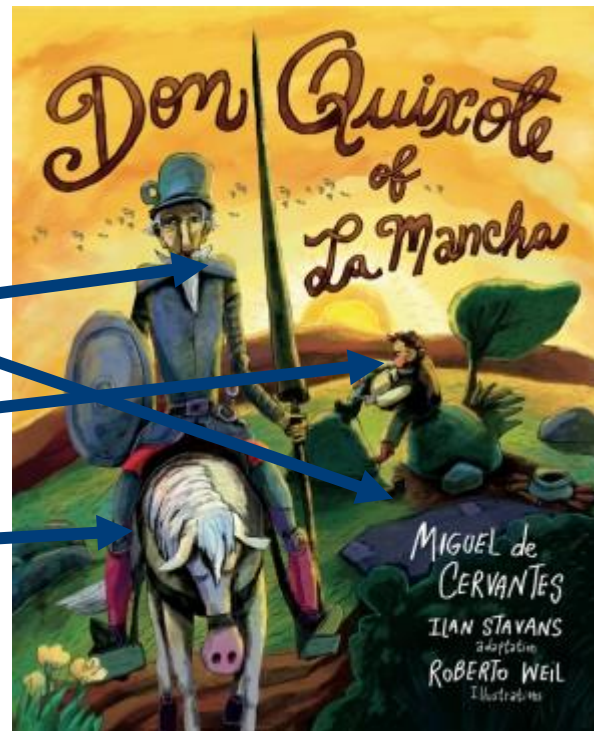




What evokes Manchego?

ECLI:ES:TS:2019:2464

- A. Cervantes
- B. Don Quijote de la Mancha
- C. Sancho Panza
- D. Rocinante
- E. All of the above



Products of the same type

- Article 14: "product of the same type" – no case law?
- Article 13 (a): "Comparable products" (Cognac):
 - Common objective characteristics
 - Consumed on largely identical occasions
 - Distributed through the same channels
 - Subject to similar marketing rules.
- Slightly different from Canon-criteria





Halloumi vs Polloumi

- Visually and phonetically similar
- Conceptual proximity
 - Image of grilled cheese
- Indication of 'Belgium' is not relevant (delocalisor)
- Goods included cheese, milk and eggs



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Q&A

Discussion, questions, answers...



Thank you for joining!

- PE Points
 - Confirmation e-mail
 - Code word (for the BMM)
- Survey, please give us your feedback
- Wishing you a great holiday season!

SNOWMAN



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Claiming PE points: In the BMM portal only!

BMM intranet.bmm.nl/nl/app/education/create

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