

# Recent Boards of Appeal case law on absolute grounds

Session with IP Practitioners

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President of the Boards of Appeal of EUIPO ad interim  
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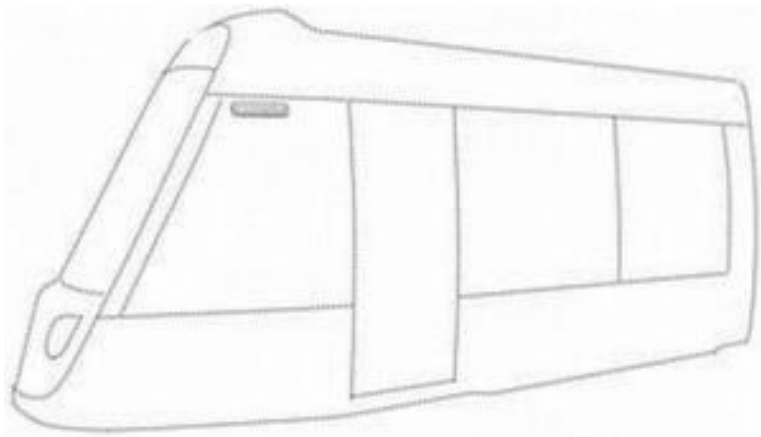
## ARTICLE 7

### ABSOLUTE GROUNDS FOR REFUSAL

1. THE FOLLOWING SHALL NOT BE REGISTERED:

(A) SIGNS WHICH DO NOT CONFORM TO THE REQUIREMENTS OF  
ARTICLE 4

15/03/2023, R 579/2022-2, POSITION D'UN WAGON DE TRAIN (final) and 13/04/2023, R 58, 59, 61/2021-2 POSITION OF A COMBINATION OF PRESENTATIONAL FEATURES (Pending before GC T-361, 362, 363, 364/23)



Classes 9 12, 37, 42  
Computer, fire extinguishers, railway wagons  
construction  
etc.



Classes 7, 12  
Agricultural, horticultural and forestry  
and machinery, machine tools,  
Tractors, trailer coupling

**15/03/2023, R 579/2022-2, POSITION D'UN WAGON DE TRAIN and 13/04/2023 (final), R 58, 59, 61/2021-2  
POSITION OF A COMBINATION OF PRESENTATIONAL FEATURES (pending before GC)**

- A position mark must be represented in a form that adequately identifies the positioning of the mark and the size or proportion in relation to the goods concerned. (Article 3(3)(d) EUTMIR).
- For a number of the goods and services applied for, the position mark is not represented in such a way that the subject matter for which protection is sought can be accurately and unambiguously identified.
- The representation does not sufficiently reflect the position of the mark and its size or its relationship to the goods and services concerned, which are not in the form of a railway wagon or soil tillage implement.
- The applications are therefore precluded by the ground for refusal in Article 7(1)(a) EUTMR in conjunction with Article 4 EUTMR.
- The signs have no distinctive character for railway wagons and soil tillage implements.

## ARTICLE 7

### ABSOLUTE GROUNDS FOR REFUSAL

1. THE FOLLOWING SHALL NOT BE REGISTERED:

(B) TRADE MARKS WHICH ARE DEVOID OF ANY DISTINCTIVE  
CHARACTER

26/04/2021, R 2326/2019-1, YFOS (fig.)

Y F O S

Classes 14, 18, 25, 35: Jewellery, leather goods, clothing, footwear, headwear, retail and wholesale services thereof.

## 26/04/2021, R 2326/2019-1, YFOS (fig.)

- Contrary to the examiner's findings, the Board considers that the sign has the minimum degree of distinctiveness.
- This term refers primarily to the character, expression or disposition of a person and does not refer to a specific quality of goods, such as clothing and accessories. It is not a synonym of the word 'style'.
- Although the contested decision cites some isolated examples of use of the term, the number of references is minimal and is not sufficient to prove widespread use of the term 'YFOS' for the goods and services, but rather proves the opposite.
- The font used is peculiar and it does not correspond to any common font known to the public. This is particularly important considering that in relation to fashion items the visual impression is impactful.

## 09/10/2023, R 1291/2023-2, POSITION OF A DESIGN ON THE SIDE OF THE SHOE



Class 9: Safety footwear

Class 25: Footwear



## 09/10/2023, R 1291/2023-2, POSITION OF A DESIGN ON THE SIDE OF THE SHOE

- Contrary to the examiner's findings, the Board considers that the application for a position mark has the minimum degree of distinctiveness.
- It is common for footwear manufacturers to use the same design on their products, which may be a design of lines, stripes, or a combination of these, always in the same place on the outside of the product, making it visible from a distance.
- In fact, it can be said that the average consumer of such a product is accustomed to this type of positional marking and can, in principle, be guided by it when purchasing the product.
- Although any sign placed in such a position will not automatically be perceived as a trade mark, the fact that the consumer identifies that particular area of the product as the one where manufacturers usually place their distinctive signs, makes it possible to reduce, to a certain extent, the threshold of complexity required for the sign.

## 13/09/2023, R 275/2023-4, TVAR VIRTUÁLNÍ STŘELNÉ ZBRANĚ (fig.)



Classes 9, 35, 4  
at virtual firearms

I services aimed

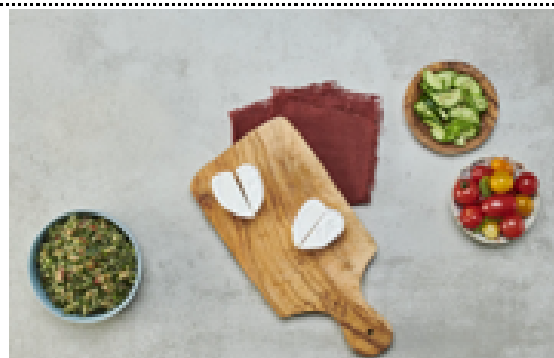
## 13/09/2023, R 275/2023-4, TVAR VIRTUÁLNÍ STŘELNÉ ZBRANĚ (fig.)

- The Board agrees with the examiner that the contested mark does not deviate in any fundamental way from the usual representation of the weapon, and therefore, merely informs the public of the nature of the goods and services at issue in the relevant classes.
- The Board highlights that unlike when purchasing a genuine firearm, where conditions such as age and other factors must be met, the purchase of a virtual firearm is subject to more accessible conditions which include professionals with a knowledge of (virtual) firearms, but also consumers who possess a lower level of attention/expertise. Therefore, the examiner was correct in holding that the level of attention of the relevant consumer is average to high.
- The word elements ('CZ BREN 2') are negligible and are not sufficient to influence the absence of distinctiveness in its figurative elements.

20/09/2023, R 314/2023-2, Fromage découpé et arrangé en forme de coeur and 20/09/2023, R 315/2023-2,  
MOUVEMENT DE LA DÉCOUPE DE DEUX PETITS FROMAGES



Motion mark



Motion mark

Cheese (c

Contested signs

## 20/09/2023, R 314/2023-2, Fromage découpé et arrangé en forme de coeur and 20/09/2023, R 315/2023-2, MOUVEMENT DE LA DÉCOUPE DE DEUX PETITS FROMAGES

- The motion marks applied for have no distinctive character.
- The arrangement of a cheese in the shape of a heart is frequently used in the cheese sector, e.g. in relation to Valentine's Day.
- The heart-shaped cutting of an unmarked oval cheese on a wooden board and surrounded by some vegetables and bread is not perceived as an indication of the commercial origin of the cheese.
- The relevant public will only perceive the applications as suggestions for a recipe or an idea for the presentation of a cheese, which is a purely promotional message.

## ARTICLE 7

### ABSOLUTE GROUNDS FOR REFUSAL

#### 1. THE FOLLOWING SHALL NOT BE REGISTERED:

(C) TRADE MARKS WHICH CONSIST EXCLUSIVELY OF SIGNS OR INDICATIONS WHICH MAY SERVE, IN TRADE, TO DESIGNATE THE KIND, QUALITY, QUANTITY, INTENDED PURPOSE, VALUE, GEOGRAPHICAL ORIGIN OR THE TIME OF PRODUCTION OF THE GOODS OR OF RENDERING OF THE SERVICE, OR OTHER CHARACTERISTICS OF THE GOODS OR SERVICE

20/10/20,R 544/2020-1, POLIS LOUTRON (fig.) & 09/11/2022, T-13/22, POLIS LOUTRON (fig.), EU:T:2022:688



Classes 3, 44: cosmetics, essential oils and human hygiene and beauty care.

20/10/20,R 544/2020-1, POLIS LOUTRON (fig.) & 09/11/2022, T-13/22, POLIS LOUTRON (fig.), EU:T:2022:688

- The sign is descriptive and non-distinctive.
- The sign is immediately perceived as a transliteration in the Latin alphabet of the equivalent Greek phrase meaning either 'the bath(s) of the city' or 'the city of (thermal) baths' or 'Loutropolis'.
- Consumers will consider it to provide information that the products in Class 3 are for use in spas, and the services (human hygiene and beauty care) are of public spas located within urban areas.
- The stylistic elements of the mark at issue are insignificant.



## ARTICLE 7

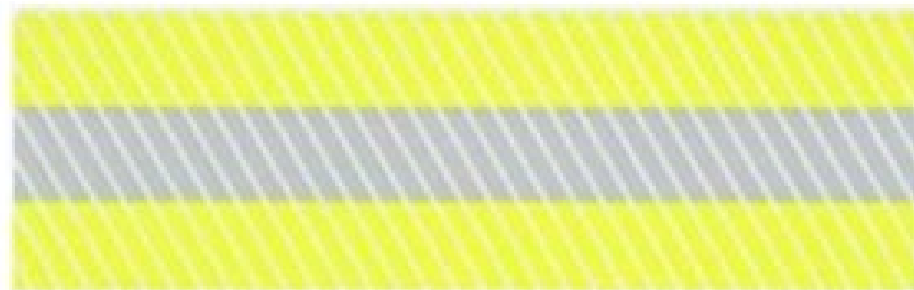
### ABSOLUTE GROUNDS FOR REFUSAL

#### 1. THE FOLLOWING SHALL NOT BE REGISTERED:

##### (E) SIGNS WHICH CONSIST EXCLUSIVELY OF:

(II) THE SHAPE, OR ANOTHER CHARACTERISTIC, OF GOODS WHICH IS NECESSARY TO OBTAIN A TECHNICAL RESULT

11/10/2022, R 1151/2018-1, Device of two luminous yellow bands with a silver grey band between (fig.)  
(confirmed by GC)



Classes 9, 1  
manufacture

er, semi-

**11/10/2022, R 1151/2018-1, Device of two luminous yellow bands with a silver grey band between (fig.)  
(confirmed by GC)**

- The goods are protective clothing for firefighters and other parts which are incorporated into such clothing.
- The Board confirms the examiner's decision and rejects the trade mark application as consisting exclusively of a technical function.
- It concludes that all the features of the application have the overall purpose of increasing the visibility of the goods by means of reflection, which is a functional feature necessary to obtain a technical result for the goods concerned, namely a visual identification indicators.

## ARTICLE 7

### ABSOLUTE GROUNDS FOR REFUSAL

#### 1. THE FOLLOWING SHALL NOT BE REGISTERED:

(F) TRADE MARKS WHICH ARE CONTRARY TO PUBLIC POLICY OR  
TO ACCEPTED PRINCIPLES OF MORALITY

21/02/2023, R 1364/2022-5, Pablo Escobar, confirmed by General Court T-255/23

# Pablo Escobar

Classes 3, 5, 9, 10, 12, 13, 14, 15, 16, 18, 20, 21, 24, 25, 26, 28, 29, 30, 31, 32,  
33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45

21/02/2023, R 1364/2022-5, Pablo Escobar, confirmed by General Court T-255/23

- The Board agrees with the examiner that the mark Pablo Escobar is against public order and morality as it will be recognised as the suspected founder of the cartel de Medellin and the presumed author of many crimes in Colombia.
- The Boards relied on the perception of the Spanish public as it is the most familiar with Pablo Escobar due to the links between Spain and Colombia.
- The Spanish public would associate the name of Pablo Escobar with drug trafficking and narco-terrorism and with the crimes and suffering resulting therefrom, rather than with his possible good deeds in favour of the poor in Colombia.
- The trade mark would therefore be perceived as running counter to the fundamental values and moral standards prevailing within Spanish society.

## ARTICLE 7

### ABSOLUTE GROUNDS FOR REFUSAL

#### 1. THE FOLLOWING SHALL NOT BE REGISTERED:

(G) TRADE MARKS WHICH ARE OF SUCH A NATURE AS TO DECEIVE THE PUBLIC, FOR INSTANCE AS TO THE NATURE, QUALITY OR GEOGRAPHICAL ORIGIN OF THE GOODS OR SERVICE

09/10/2023, R 504/2023-5, SOLAR

# SOLAR

Classes 9, 35, 42: software and electronic publications, etc.; software development services, etc; computer services; business and office management and administration services, etc. none of the aforesaid for or relating to ... energy solutions, ....



## 09/10/2023, R 504/2023-5, SOLAR

- The Board upholds the examiner's decision that the contested sign is deceptive.
- The term 'solar' will be immediately associated with solar energy, at least by the relevant English-, German-, Portuguese-, Romanian- and Spanish-speaking public.
- The contested goods and services may all relate to solar energy, such as solar energy management solutions and/or intelligent energy management.
- The applicant's negative restriction of the list of goods and services ('none of the aforesaid for or relating to [...] energy solutions'), creates a significant risk of deception.



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Thank you