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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



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# 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*

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## 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

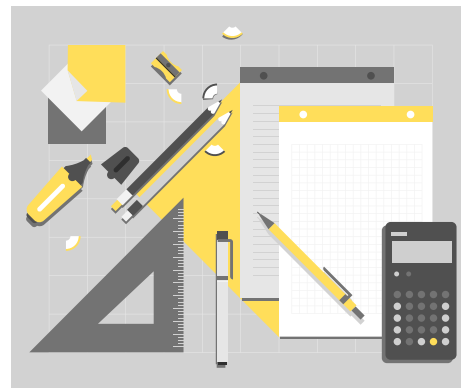


B. Could be better

C. No opinion



D. Didn't notice it yet



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## 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*



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## 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

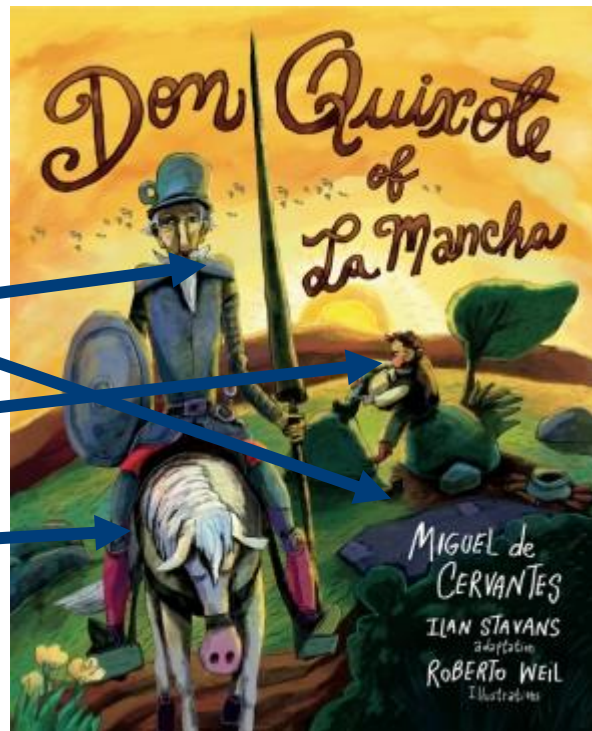




## What evokes Manchego?

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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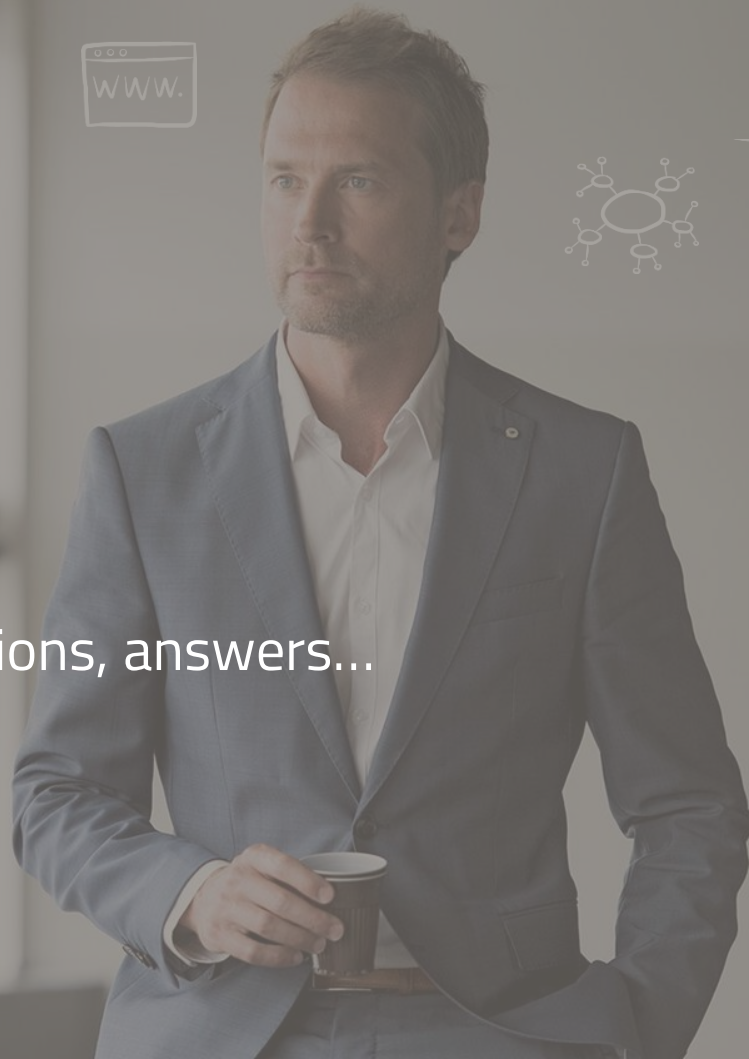
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## Q&A

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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## BMM INTRANET

### Aanmelden voor nieuwe opleidingspunten

Opleiding

Aantal punten

Omschrijving

Datum opleiding behaald

Opleidingsbewijs 1  No file chosen

Opleidingsbewijs 2  No file chosen

Opleidingsbewijs 3  No file chosen

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