



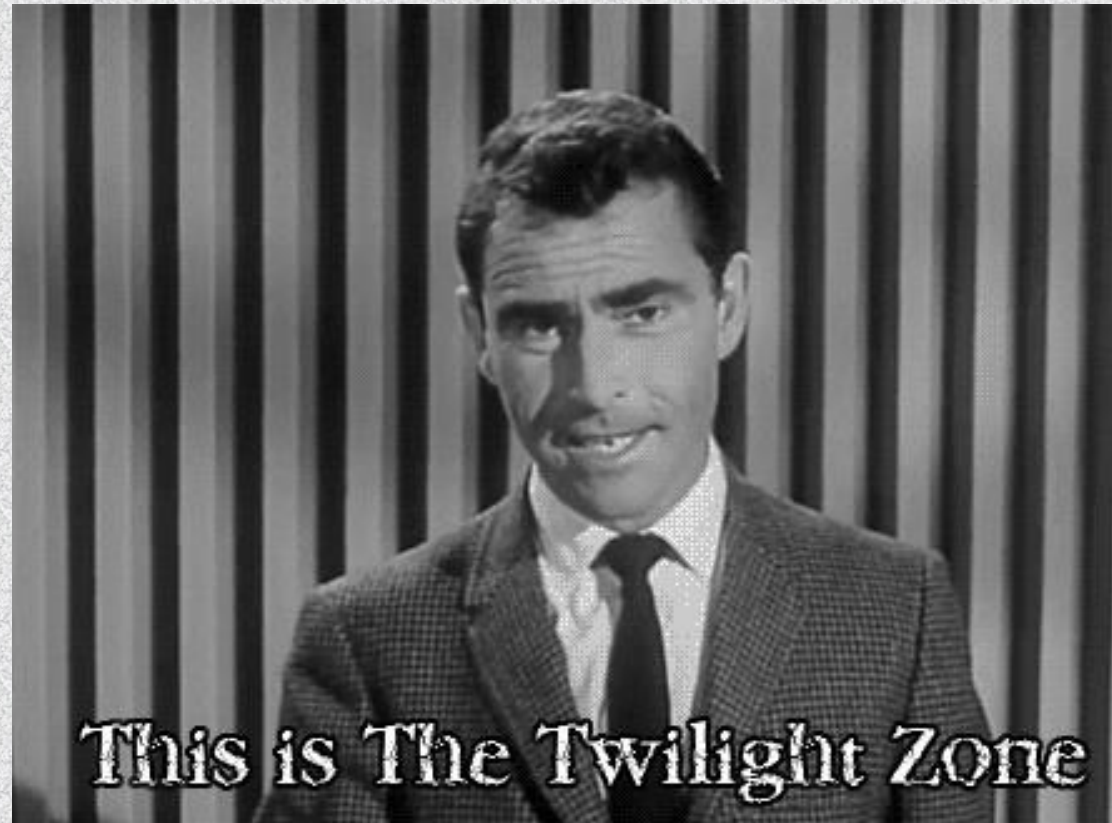
## THE TWILIGHT ZONE

# PLACING LIMITS ON ACCEPTABLE USE OF A MARK IN A FORM DIFFERING FROM THE ONE REGISTERED

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# INTRODUCTION

- The Twilight Zone?



# INTRODUCTION

- Science fiction?
- A strange situation?

# INTRODUCTION

- 'Law of permissible variations'- mechanism provided for in the texts with regard to revocation
- Paris Convention
- Regulation on the European Union trade mark - Art. 18, § 1, a)
  - Use of the European Union trade mark in a form which differs in elements which do not alter the distinctive character of the trade mark in the form in which it was registered, whether or not the trade mark is registered in the form used in the name of the proprietor.

# INTRODUCTION

- *Ratio legis*
- Preamble
  - Solution chosen for reasons of equity and legal certainty - (for competitors? For the contractor?).
  - The mechanism is designed solely for the benefit of the rights holder, who is given the opportunity to develop and modernise his trademark without having to register a new trademark and without the risk of being penalised for lack of serious use.
  - Adaptation to marketing requirements (Case T-194/03)

# INTRODUCTION

- Modification that does not alter the distinctive character - what does this mean?
  - The two marks must be considered as equivalent overall (what does this mean?).
- Letter of text - alteration of distinctive character
- Principles of interpretation (and exceptions)

Twilight Zone?

# THE METHOD

- Are the changes acceptable?
- 2 steps:
  - 1<sup>re</sup> step
    - Identification of what must be considered distinctive in the trademark, in the form in which it has been registered - determination of the elements that contribute to distinctiveness
    - "This requires an assessment of the distinctive and visually dominant character **of the elements of the mark as registered** based on the intrinsic qualities of each, their relative position within the arrangement of the mark and their interactions.
  - Dominant element? What is the relationship with distinctiveness?

# THE METHOD

- 2<sup>e</sup> step
  - Identify **the differences in the mark as used** and **evaluate the impact of the variations**. It will then be necessary to establish whether that distinctive essence of the mark as registered is present, missing or modified in the mark as used. This requires an assessment of the distinctive and dominant character **of the added, omitted or modified components in the mark as used**, based on the intrinsic qualities of each, their relative position within the arrangement of the mark and their interactions.

The degree of distinctiveness will be a determining factor in assessing possible alteration. For example, trademarks with a higher degree of distinctiveness may be less affected by certain variations than those with a lower degree of distinctiveness.

Added or omitted elements are more likely to affect the distinctiveness of trade marks with limited distinctiveness (Case T-24/17).

In addition, all the circumstances of the case must be taken into account and, in particular, the practices of the relevant commercial sector and the perception of the relevant public must also be taken into account.

## RECENT DECISIONS - ADDITIONS

- Addition of a descriptive element - no alteration
- TM Steam - for beers
- The element added to the contested mark, namely 'beer', is purely descriptive of the goods in question, i.e. devoid of any distinctive character, so that it cannot alter the distinctive character of the contested mark, even if that character were weak.
- [14/09/2022, T-609/21, Steam, EU:T:2022:563](#)



# RECENT DECISIONS - ADDITIONS

■ 19/10/2022, T-323/21, Kasite (fig.), EU:T:2022:650

■ The contested mark as used, i.e. in a secondary position and in a much smaller size than the distinctive and dominant verbal elements "Chinese dragon" and the representation of a dragon, would be perceived by the relevant public as a decorative element and not as an indication of the origin of the goods. The argument relating to usage in the wine sector, namely the use of several trade marks on the label, is considered to be irrelevant, insofar as the consumer will not perceive the Chinese characters as a trade mark, but once again as a purely decorative element.

■ Having regard to the examination of the distinctive and dominant character of the added elements, based on the intrinsic qualities of each of those elements and on the relative position of the various elements, it must be held that the variations in use shown alter the distinctive character of the contested mark as registered, as the Board of Appeal rightly found.

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# RECENT DECISIONS - ADDITIONS

■ 26/10/2022, T-273/21, SHAPE OF A BABY'S BOTTLE (3D MARK), EU:T:2022:675

■ "Confectionery; sweets; candies; sherbets.

■ The sign in question was moderately distinctive. *The goods protected by the trade mark, such as sweets and candies, had nothing to do with feeding bottles.*

■ Alteration of distinctive character is undoubtedly easier to demonstrate in the case of a 3D trademark, but this is not the case here.

■ Inconceivable from a commercial and regulatory point of view to sell the products in question only in the form of the contested mark and without any label on its surface.

■ The figurative and verbal elements affixed to the shape do not prevent the average consumer from perceiving the shape in its entirety or its interior.

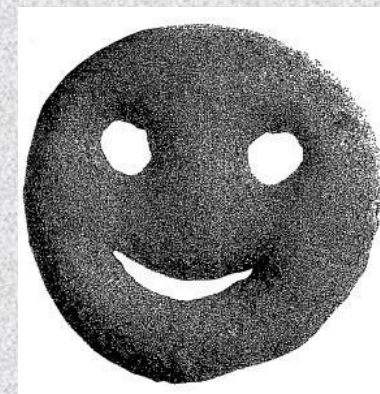
■ Verbal elements are not very distinctive for designated products



Globally  
equivalent?

# RECENT DECISIONS - ADDITIONS

- 14/12/2022, T-553/21, FORM EINES SMILEYS (3D), EU:T:2022:813
- The condition of genuine use may be met when a trade mark is used in conjunction with another trade mark, provided that the trade mark continues to be perceived as an indication of the origin of the product in question.
- Here, the element SMILES appears as an independent element and not as forming a unity with the contested mark. The addition of this word mark will not prevent the relevant public from perceiving the shape of the contested mark, which remains clearly identifiable. The addition of the smiles element has a playful or advertising effect. It is interesting to note that the Court states here that the contested sign is easily recognisable by the relevant public.



## RECENT DECISIONS - ADDITIONS



Gourmet



- 01/03/2023, T-102/22, Gourmet (fig.) / Gourmet, EU:T:2023:100
- "Tea; cocoa; sugar; rice; tapioca; sago; flour and preparations made from cereals, bread, pastry and confectionery, edible ices; honey, molasses syrup; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice cream".
- Weakly distinctive mark
- But its distinctive character was not altered as (i) it remained clearly identifiable, (ii) due to its size and position it was **dominant and would hold the public's attention**, and (iii) the additional figurative elements were also weak and thus, as a rule, less distinctive (§ 81-83).
- Moreover, a chef's hat is a banal and commonplace element in the field of food products, insofar as it indicates that the goods are made by a chef. This also applies to raw foodstuffs that can be used by a chef in their preparations (§ 84).
- Globally equivalent signs (dominant character of a non-distinctive element)?

## RECENT DECISIONS - ADDITIONS



- 12/07/2023, T-27/22, th pharma (fig.) / Th (fig.), EU:T:2023:390
- The added element was a dominant element, but the fact that it was non-distinctive did not alter the distinctive character of the mark as registered.
- *Dominant element - Distinctive element*

# RECENT DECISIONS - ADDITIONS

## Addition of a letter - no alteration

- 24/01/2024, T-55/23, SALVAJE (fig.) / SALVANA, EU:T:2024:30

- The graphic representation given to the earlier word mark 'SALVANA', namely does not constitute an alteration of its distinctive character. The additional letter 'S' may be perceived as an abbreviation of that term (§ 48-51).



- 24/01/2024, T-562/22, NOAH (fig.), EU:T:2024:23

- The addition of the letter 'Y.' before the word element 'NOAH' when used in trade does not alter the distinctive character of the earlier mark as registered because, first, that letter was already present in the figurative element of the mark and, second, it occupies a secondary position in the perception of the mark (§ 61, 67).

- Since the use of signs consisting of surnames is common in the clothing sector, the word element 'NOAH' may be perceived, both in the registered form and the modified form, as a surname that refers to Yannick Noah. The addition of the first letter of his given name merely reinforces that reference (§ 62, 66).



## RECENT DECISIONS - OMISSIONS

- *16/11/2022, T-512/21, EPSILON TECHNOLOGIES (fig.), EU:T:2022:710*
- The heart was considered to be purely decorative.
- Therefore, the omission of the figurative elements representing the heart between two square brackets and the horizontal lines in the sign used is not such as to alter the distinctive character of that trade mark as a whole (§ 38, 42)



## RECENT DECISIONS - OMISSIONS

- Inside. - Inside
- Where the element of the earlier mark as registered, which is omitted in the signs as used, is in a secondary and non-distinctive position, its omission does not alter the distinctive character of the earlier mark. The absence of a full stop at the end of the earlier mark in the proof of use constitutes a minor difference, which does not deprive the earlier mark of its distinctive character (§ 27).

## RECENT DECISIONS - OMISSIONS

- Omissions of weakly distinctive elements
- 02/03/2022, T-615/20, Mood media, EU:T:2022:109, § 36, 61-62
- Mood Media - class 9: *"Apparatus and media for the recording and reproduction of sound or images"*.
- As the word "mood" is at most weakly distinctive, the omission of the word "media", which makes up half of the sign, reinforces the weakness of the distinctive character of this variation, even though the word "mood" may be regarded as a diminutive. The omission of the word "media" effectively altered the distinctive character of the contested mark due to its weak distinctiveness.

## RECENT DECISIONS - OMISSIONS

- 28/06/2023, T-645/22, CS jeans your best fashion partner, EU:T:2023:363
- The element in question is weakly distinctive and non-descriptive.
- Because of the stylisation and size of the capital letter "J", the link this letter makes between the figurative element representing the group of capital letters "CS" and the group of letters "eans", and the size of the latter letters, and the fact that the small letter "s" in the verbal element "jeans" is very similar to the capital letter "S" in the figurative element, the size of the latter letters and the fact that the lower-case letter 's' in the word element 'jeans' is very similar to the upper-case letter 'S' in the figurative element and is therefore reminiscent of the latter, the word element 'jeans' must be regarded as having a weak distinctive character and cannot therefore be ignored.

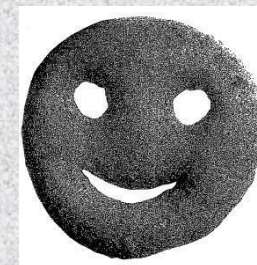


## RECENT DECISIONS - OTHER DIFFERENCES

- 23/09/2020, T-796/16, Grass in bottle / Bottle with strand of grass et al, EU:T:2020:439, § 140, 155-156
- The shapes presented in the evidence submitted differ from the protected shape of the earlier trade mark by significant variations in nature, length and position and cannot be considered 'significant' or 'broadly equivalent' to the registered shape of that trade mark within the meaning of the case law.



## RECENT DECISIONS - OTHER DIFFERENCES



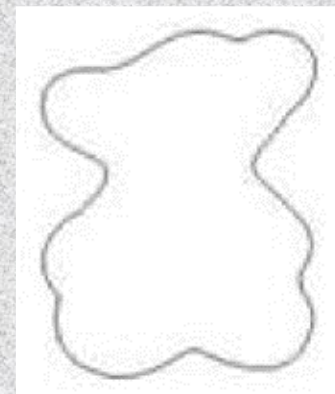
- 14/12/2022, T-553/21, FORM EINES SMILEYS (3D), EU:T:2022:813
- Use in colour does not alter the distinctive character of the contested three-dimensional mark which is registered in black and white, where the shape and size correspond to the mark as registered. A colour which corresponds to the natural colour of the goods cannot be considered as one of the main factors conferring distinctiveness to the contested mark consisting of the product shape (§ 53).

## RECENT DECISIONS - OTHER DIFFERENCES

■ 26/07/2023, T-638/21, DEVICE OF THE OUTLINE OF A BEAR (fig.), EU:T:2023:434

■ The contested sign is not so simple that the changes in question would prevent the relevant public from perceiving the contested mark clearly (§ 112).

■ Regarding the variation in colour, the contested sign as registered does not have a colour claim and the variations in that regard do not support the conclusion that the distinctive character has been altered. Regarding the outline, although it appears in multiple variants, it remains sufficiently clear and distinctive to have no impact on consumer perception. The sharpness of the outline cannot affect the perception of the sign, which remains visible irrespective of its sharpness. Furthermore, the addition of decorative precious stones, when the sign takes the form of certain goods, does not alter the distinctive character because the characteristic outline can still be seen. The various changes made to the contested sign as used, relating to its shape, colour, outline, sharpness and background, represent insignificant changes, which are decorative in nature and do not alter its distinctive character (§ 115, 116).



# CONCLUSION

- Confusion - Distinctive and Dominant? The problem.
  - Globally equivalent? Problem of terminology - vs Alteration
  - Recognition of the sign by the consumer?
  - Omissions are easier than additions.
- 
- What about alteration for non-traditional signs? Sound signs? Multimedia signs?
  - What is the method? What to suggest? - best initial approach?

THANK YOU!

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