

## European Union Trade Mark Regulation

Article-by-Article Commentary

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tion should **not positively assist** people who wish to pursue their business objectives by means of trade marks that are **contrary to certain basic values of civilised society**.<sup>354</sup>

The terms public policy and accepted principles of morality have to be seen as *Union law concepts*, to be construed from the EU perspective.<sup>355</sup> This does not mean, however, that the assessment of whether or not a sign is contrary to public policy or morality would be the same throughout the Community. On the contrary, due to the different linguistic, cultural and social backgrounds of more than 500 million EU citizens,<sup>356</sup> a sign may be found to be **contrary to principles of morality** in one part of the EU, but perceived as perfectly harmless in others. This is of particular relevance with regard to signs that are based on terms or indications that have a specific meaning in languages or dialects that are understood only in certain linguistic areas.<sup>357</sup> This is where Art. 7 (2) comes into play. The obstacle set out in Art. 7 (1)(f) does not require a breach of Union-wide accepted principles of morality and public policy;<sup>358</sup> it suffices that the obstacle obtains in only a relevant part of the Community.<sup>359</sup> Consequently, highly offensive or racist signs have rightly been refused registration, although their true meaning – and thus the violation of morality and public order – was understood only in certain language areas.<sup>360</sup>

The absolute ground for refusal in lit. (f) is very **broadly worded** and hence allows a great deal of room for interpretation. Its judicious application inevitably entails balancing the right of traders to freely choose images and words they want to include in the signs to be registered against the right of the public not to be confronted with offensive, racist, insulting or even threatening trade marks.<sup>361</sup> If the provision is construed **too widely**, so as to cover anything that could be perceived by a section of the public as disturbing or abusive, **commercial freedom of expression** could be **unduly curtailed**.<sup>362</sup> In this context, it is necessary to have regard to Art. 10 of the European Convention for the Protection of Human Rights and Fundamental Freedoms (ECHR), which guarantees freedom of expression to ‘everyone’, no distinction being made whether the type of aim pursued is profit-making or not. Therefore, information of purely commercial nature is also covered by Art. 10 ECHR.<sup>363</sup> Although it is true that a refusal to register the sign as a trade mark is not a severe intrusion on the right of freedom of expression, as traders could still use signs in commerce without registering them as trade marks, it still represents a restriction of freedom of expression in the sense that economic operators might be unwilling to invest in large-scale promotional

<sup>354</sup> S. Grand Board, *ibid*.

<sup>355</sup> *Likewise v. Kapff, in Gielen/v. Bomhard, Concise European Trade Mark and Design Law*, 2<sup>nd</sup> ed., Art. 7 EUTMR, mn. 9 (b)

<sup>356</sup> S. EUIPO website under <https://euipo.europa.eu> → about EUIPO → who we are → the office.

<sup>357</sup> OHIM Dec. of 1.6.2012 – R 254/2012-2 – *CURVE*, mn. 12, concerning a word taken from the Romanian language; s. also OHIM Dec. of 4.3.1999 – R 147/1998-2 – *KALI*, mn. 11 et seq. regarding the Greek transliteration of the word ‘Kali’; as to the relevance of dialects spoken only in parts of the EU (northern parts of Germany and parts of Belgium and the Netherlands), although in the context of the obstacle contained in Art. 7 (1)(b), OHIM Dec. of 11.10.1999 – R 298/1999-3 – *Appel*, mn. 18.

<sup>358</sup> *V. Kapff, in Gielen/v. Bomhard, Concise European Trade Mark and Design Law*, 2<sup>nd</sup> ed., Art. 7 EUTMR, mn. 9 (b).

<sup>359</sup> GC ECLI:EU:T:2017:716 *Osho* (only available in the German and French language), mn. 12; s. also GC ECLI:EU:T:2011:498 *Soviet coat of arms*, mn. 50.

<sup>360</sup> S. OHIM Dec. of 1.6.2012 – R 244/2012-2 – *CURVE*, mn. 11 et seq.: ‘curve’ is apparently a very offensive Romanian word in plural, meaning ‘sluts, whores, prostitutes’; GC ECLI:EU:T:2011:564 *PAKI Logistics v OHIM*, mn. 15, 37: the racist meaning of the word ‘paki’ was understood by the English-speaking consumers, and thus in a relevant part of the Community in the sense of Art. 7 (2).

<sup>361</sup> OHIM Dec. of 6.7.2006 (Grand Board) – R 495/2005-G – *SCREW YOU*, mn. 14.

<sup>362</sup> Grand Board, *ibid*, mn. 15.

<sup>363</sup> European Court of Human Rights, Dec. of 24.2.1994, 18 EHRR 1 (application No. 15450/89), mn. 35, 36.

activities for signs which are barred from registration because they are regarded as immoral in the eyes of the public.<sup>364</sup> The freedom of expression, however, is subject to limitations. Art. 10 (2) ECHR expressly provides that the exercise of freedom of expression, since it carries with it duties and responsibilities, may be subject to restrictions prescribed by law which are necessary in a democratic society, inter alia in the interests of the prevention of disorder or the protection of morals. Therefore, the wording and general objective of the absolute ground for refusal set out in Art. 7 (1)(f) is perfectly consonant with Art. 10 ECHR.

146 On the other hand, the obstacle under lit. (f) **must not be construed too narrowly** so as to refuse registration only to those signs that violate criminal laws. Such an interpretation would effectively abrogate the Office's responsibility to secure that the privileges of trade mark protection are not extended to signs which are strongly offensive, disgusting or potentially capable of causing outrage, but whose usage is not actually prohibited under national law. This would be inconsistent with the spirit of the provision. As is made clear by the reference to 'accepted principles of morality', the absolute bar contained in lit. (f) clearly imposes an obligation on the examiner to **exercise a degree of moral judgment** in assessing the eligibility of signs seeking trade mark registration.<sup>365</sup>

147 The Office therefore has to draw the sometimes fine line between signs that are merely distasteful or irreverent and those that are seriously abusive or deeply offensive. The former category of signs may not have to be refused, whereas EUTMs which comprise manifestly vulgar language or display gross obscenity have no place on the register. It cannot be negated that the task to ascertain whether a sign crosses the boundary from being morally questionable to violating accepted principles of morality can be extremely difficult and obviously depends on the point of view of the observer. Some people are easily offended, whereas others are absolutely unshockable. The Office must examine EUTM applications by reference to standards and values of ordinary citizens who fall between those two extremes. The yardstick thus to be used is the perception of a **reasonable person with normal levels of sensitivity and tolerance**.<sup>366</sup> Consequently, signs are not to be refused which only offend a small minority of exceptionally puritanical people; conversely, signs should not be registered simply because they would not upset the equally small minority at the other end of the spectrum that even tolerate gross obscenity and the like. Furthermore, the **context** in which the sign is **likely to be encountered** has to be taken into account. It does make a difference whether, for example, a mark is supposed to be used for goods that are sold in sex shops as opposed to signs that are likely to be promoted on prime-time television or displayed in a prominent fashion in shop windows on open streets, etc. In the latter case, a stricter approach may be appropriate, whereas in the former scenarios signs depicting a sexually explicit content such as *DICK & FANNY*<sup>367</sup> or *SCREW YOU* may be registrable.<sup>368</sup> On the other hand, the mark *Fack Ju* ('Fuck you') covering goods for everyday use and consumption was rightly seen as an insult to society.<sup>369</sup>

<sup>364</sup> OHIM Dec. of 6.7.2006 (Grand Board) – R 495/2005-G – *SCREW YOU*, mn. 15.

<sup>365</sup> OHIM Dec. of 6.7.2006 (Grand Board) – R 495/2005-G – *SCREW YOU*, mn. 18.

<sup>366</sup> OHIM, Grand Board, *ibid*, mn. 19–21.

<sup>367</sup> OHIM Dec. of 25.3.2003 – R 111/2002-4 – *DICK & FANNY*, despite the fact that in English colloquial language this word combination describes the human genitals.

<sup>368</sup> OHIM Dec. of 6.7.2006 (Grand Board) – R 495/2005-G – *SCREW YOU*, mn. 19, 21, 30: The sign *SCREW YOU* was consequently allowed registration in respect of 'condoms, contraceptives, sex toys (vibrators, dolls)' and 'artificial breasts' and 'breast pumps' in class 10, provided that the specification of goods is limited to those types that are normally sold exclusively in sex shops.

<sup>369</sup> GC ECL:EU:T:2018:27 *Fack Ju Göhte* (only available in the German and French language), mn. 33–38.

Offensive or blasphemous signs like insults or racist illustrations are excluded from registration as being contrary to accepted principles of morality.<sup>370</sup> Likewise, the sign *Bin Ladin* was rightly deemed to be a violation of public policy because it glorifies terrorism by showing a lack of respect towards the victims of a terrorist.<sup>371</sup> As a general rule, any EUTM application that can be seen to support or benefit an organized crime group has to be refused as being against public policy. For this reason, the mark *La mafia se sienta a la mesa* (in English ‘The Mafia sits down at the table’) was rightly barred from registration as it conveys a message of trivialisation of the Mafia’s significance, turning it into a ‘simple gathering around the table’; the trademark thus distorts the grave perception this name conveys.<sup>372</sup> Similarly, violations of the sense of a person’s shame or religious beliefs, and swear words of a derogatory nature are barred by lit. (f).<sup>373</sup> In contrast, the application for registration of *Die Wanderhure* (the title of a book that was translated into English as *The Whore*, while *The Wandering Whore* would be a translation closer to the German text) as an EU trade mark was ‘allowed to wander on’ – as the tenor of the decision humorously reads – because the word used in the trade mark did not embody an expression that caused offence and was contrary to accepted principles of morality; the application for registration as a trade mark did not contain any semantic statement that could refer to a specific person or group of persons, nor did it incite the public to perform a certain act.<sup>374</sup> The word *Ficken* (to fuck in English), like the word/figurative mark *Ficken* or *Ficken Liquors* applied for at the same time, which sought protection for goods in Class 25 and beers and alcoholic beverages (Classes 32, 33), on the other hand, was rightly objected to as vulgar and offensive and contrary to accepted principles of morality.<sup>375</sup> The court emphasised rightly in this context that a word does not have to be discriminatory, insulting or denigrating to have an offensive effect on part of the relevant public. It suffices if the word is perceived as obscene and offensive, for example because it clearly refers to sexuality in coarse language and is classified as vulgar.<sup>376</sup>

If a sign consists of a word that exhibits a deeply offensive and degrading character from the perspective of the English-speaking public, a violation of public morals or public policy must be assumed even if use that is not offensive is conceivable.<sup>377</sup> The EUTM as applied for has to be the basis for assessing whether the sign is in contradiction of public policy or accepted principles of morality. An overall reading of the

<sup>370</sup> E. g. GC ECLI:EU:T:2011:564 *PAKI Logistics v OHIM*, mn. 15, regarding the sign *PAKI*, which is a derogatory designation for Pakistani people in the English language.

<sup>371</sup> OHIM Decisions of 29.9.2004 – R 176 and 177/2004-2 – *Bin Ladin* (both decisions in the Spanish language) regarding the trade mark *Bin Ladin* in Latin and Arabic letters; both decisions have been appealed to the EC (Cases T-487 and 488/04, but the EUTM applications were withdrawn before the GC could adjudicate).

<sup>372</sup> BoA Dec. of 27.10.2016, R 803/2016-1 *La Mafia se sienta a la mesa* mn. 30, 31; confirmed by GC ECLI:EU:T:2018:146, mn. 45 et seq.

<sup>373</sup> E. g. OHIM Dec. of 1.6.2012 – R 244/2012-2 – *CURVE*, mn. 11 et seq.: apparently, ‘CURVE’ is a very offensive Romanian word in plural, meaning ‘sluts, whores, prostitutes’; GC ECLI:EU:T:2018:27 *Fack Ju Göhte* (only available in the German and French language), mn. 38: the success of the of the film by this name (in Germany) does not say anything about the acceptance of the insult *Fack Ju* (‘fuck you’) in society.

<sup>374</sup> OHIM, Dec. of 28.5.2015 – R 2889/2014-4 – *Die Wanderhure*, mn. 5 et seq, 13 and 14; in certain contrast to the recent decision of the GC ECLI:EU:T:2018:27 *Fack Ju Göhte*, mn. 40, the success of both the movie and the book were used as indicators that the public would not take offence from the title and the content described by it.

<sup>375</sup> GC ECLI:EU:T:2013:596 *Ficken*, mn. 18 et seq, mn. 24 and GC ECLI:EU:T:2013:593 *Ficken Liquors*, mn. 17 et seq.

<sup>376</sup> GC ECLI:EU:T:2013:596 *Ficken*, mn. 24 and GC ECLI:EU:T:2013:593 *Ficken Liquors*, mn. 19.

<sup>377</sup> GC ECLI:EU:T:2011:564 *PAKI Logistics v OHIM*, mn. 15 et seq.

various obstacles contained in Art. 7 (1) shows that they refer to the intrinsic qualities of the sign applied for and not to circumstances related to the conduct of the person applying for the trade mark.<sup>378</sup> Therefore, the absolute bar in lit. (f) does not cover the situation in which the trade mark applicant acts in bad faith.<sup>379</sup> Similarly, an application for invalidity concerning the trade mark *Intertops* based on Art. 7(1)(f), (2) EUTMR was rightly rejected because the alleged breach of public policy – specifically: the alleged lack of the licence, required under German law, to operate games of chance – had no influence on the assessment of whether the sign as such was capable of being registered as a trade mark.<sup>380</sup> It is the trade mark application itself that forms the basis for the assessment of whether a trade mark violates Art. (1)(f) EUTMR.<sup>381</sup>

150 The **sign** as applied for has to be assessed as a **whole**. As a consequence, the EUTM *ETA Earth to Air Systems*, seeking protection for specific heating and cooling units in class 11, was not denied registration, although the abbreviation ‘ETA’ is proscribed as a terrorist organisation by Spanish authorities, the EU, the US and the UN; in light of the English words ‘earth to air systems’ the consumer understands that ‘ETA’ in that particular case refers to the words ‘earth to air’, which are included in the sign below the abbreviation ‘ETA’; therefore, the relevant (Spanish) consumer is likely to recognise the choice of the letters ‘ETA’ in the composite mark as unfortunate, but not as offensive, shocking or abusive.<sup>382</sup> The EUTM has to be assessed in relation to the goods and services covered by the application.<sup>383</sup> The Office accepted the mark *Fucking Hell* as not being contrary to public policy or accepted principles of morality inter alia in respect of clothing (cl. 25) and beer (cl. 32), as the word ‘hell’ is an abbreviated designation for pale beer. Furthermore, the word combination ‘fucking hell’ is not perceived as sending someone to hell, but rather as an interjection which expresses disapproval of something without making clear about what and against whom.<sup>384</sup>

151 A brief overview of signs that were scrutinised under (f) is shown below:

152 EUTMs **not contrary** to public policy or to accepted principles of morality:

Type	Nice Classes	Mark	Case Number	Authority
Word	41, 42	OSHO	T-670/15	GC
Word	9, 16, 35, 38, 41	Die Wanderhure	R 2889/2014-4	OHIM (BoA)
Figurative	9, 16, 41		R 1224/2011-4	OHIM (BoA)
Figurative	11		R 74/2009-2	OHIM (BoA)

<sup>378</sup> GC ECLI:EU:T:2005:312 *Sportwetten GmbH v OHIM*, mn. 27, 28.

<sup>379</sup> GC ECLI:EU:T:2003:107 *Durferrit v OHIM*, mn. 76.

<sup>380</sup> OHIM, Dec. of 21. 2. 2001, R 338/2000-4 *Intertops* mn. 14; confirmed in GC ECLI:EU:T:2005:312 *Intertops* mn. 25 et seq.

<sup>381</sup> OHIM, Dec. of 21. 2. 2001, R 338/2000-4 *Intertops* mn. 14; confirmed in GC ECLI:EU:T:2005:312 *Intertops* mn. 25 et seq.

<sup>382</sup> OHIM Dec. of 29.1.2009 – R 74/2009-2 – *Earth to Air Systems v OHIM*, mn. 9, 10.

<sup>383</sup> GC ECLI:EU:T:2017:716 *Osho* (only available in the German and French language), mn. 107.

<sup>384</sup> OHIM Dec. of 21.1.2010 – R 285/2008-4 – *Fucking Hell*, mn. 5, 10; the BoA also took into account that ‘Fucking’ is the name of a town in Austria.

Type	Nice Classes	Mark	Case Number	Authority
Figurative	25, 32, 33		R 385/2008-4	OHIM (BoA)
Word	9, 10, 25, 28, 33	SCREW YOU	R 495/2005-G	OHIM (BoA)
Word	9, 16, 25	Dick & Fanny	R 111/2002-4	OHIM (BoA)

Signs **contrary** to public policy or to accepted principles of morality:

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Type	Nice Classes	Mark	Case Number/Application Number	Authority
Word	3, 9, 14, 16, 18, 21, 25, 28, 30, 32, 33, 38, 41	Fack Ju Göhte	T-69/16	GC
Word/Figurative	25, 35, 43	La Mafia se sienta a la mesa	T-1/17	GC
Word	25, 32, 33, 43	FICKEN	T-52/13	GC
Figurative	25, 32, 33, 35		T-54/13	GC
Word	11	CURVE 300	R 254/2012-2	OHIM (BoA)
Slogan	9, 41, 45	HOW TO MAKE MONEY SELLING DRUGS	R 2052/2011-5	OHIM (BoA)
Word	6, 20, 37, 39	PAKI	T-526/09	GC
Word	9, 16, 25, 38, 41	CRIME PAYZ	010975217	OHIM (Examiner)
Word	10	AIRCURVE	012042487	OHIM (Examiner)

## VII. Deceptive trade marks (lit. g)

Pursuant to Art. 7 (1)(g), trade marks are excluded from registration 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 services covered by the application. Deceptive *usage* of a trade mark by its proprietor or a third party can be successfully attacked by competitors as a misleading advertisement under the unfair competition regimes of the Member States. The underlying objective of the ground for refusal laid down in lit. (g) sets in earlier: such signs are barred from registration whose **deceptive nature** arises

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already objectively from the trade mark itself in respect of the goods/services seeking protection. In other words, the obstacle contained in lit. (g) presupposes the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived.<sup>385</sup> In order to fall foul of the law under lit. (g), the sign must contain an objective indication of characteristics of the goods or services that is clearly in contrast to the classification contained in the EUTM application, assuming that the mark would be used as filed for the goods and services claimed.<sup>386</sup> This ground for refusal is **not applicable**, however, if and insofar there is a **possible non-deceptive way of usage** for a category of goods/services embraced by the application.<sup>387</sup> This obstacle is applicable, on the other hand, if the mark applied for clearly contradicts the list of goods and services as reflected in the application.<sup>388</sup> In assessing the deceptive nature of an EUTM for which protection is sought, tribute has to be paid to the perception of the targeted public.

155 In light of these principles, **intrinsic deceptiveness** was **confirmed** for the sign *WINE OH!* in relation to the goods ‘mineral and aerated waters and other non-alcoholic drinks’, although the BoA emphasised that the term ‘OH!’ only reinforces the contradiction on account of which it is deceptive, namely that a product that is *not* wine is presented to the consumer as wine.<sup>389</sup> For similar reasons, the sign *Tea by Thé* in relation to goods not containing any tea was denied registration.<sup>390</sup> Likewise, the deceptiveness of the mark *International Star Registry* was affirmed in relation to goods and services in classes 9, 16 and 41 ‘relating to astronomy and related topics’, as the sign is likely to mislead consumers into believing that the organisation which uses the mark is an authoritative body empowered to give names to stars.<sup>391</sup>

156 In contrast, if and insofar as **non-deceptive use** of the sign is **conceivable**, intrinsic deceptiveness has to be denied.<sup>392</sup> Consequently, a trade mark consisting of a name of a fashion designer who originally personified the goods bearing that mark was not found to be liable to deceive the public, because the name in itself could not be regarded as being of a deceptive nature. The fact that the sign might be used in a fraudulent manner, and such conduct might be prohibited under unfair competition laws, does not affect the trade mark itself and, as a consequence, its prospects of being registered.<sup>393</sup> For similar reasons, the conduct by the proprietor after the registration of a mark has no bearing on the assessment whether a sign was capable per se of deceiving the consumer at the time of filing. Consequently, the CJ rightly held that a registered mark that was supposed to be used as a quality label cannot be declared invalid merely because the proprietor of the mark fails to ensure, through periodic quality controls at its licenses, that expectations relating to the quality which the public associates with the mark are being met.<sup>394</sup>

<sup>385</sup> CJ ECLI:EU:C:2006:215 *Elizabeth Florence Emanuel v Continental Shelve 128 Ltd.*, mn. 47; GC ECLI:EU:T:2016:634 *Caffè Nero*, mn. 53.

<sup>386</sup> OHIM Dec. of 7.3.2006 – R 1074/2005-4 – *WINE OH!*, mn. 19.

<sup>387</sup> OHIM Dec. of 7.3.2006 – R 1074/2005-4 – *WINE OH!*, mn. 19.

<sup>388</sup> OHIM Dec. of 13.9.2000 – R 422/1999-1 – *Titan*, mn. 18; OHIM Dec. of 7.3.2006 – R 1074/2005-4 – *WINE OH!*, mn. 19.

<sup>389</sup> OHIM Dec. of 7.3.2006 – R 1074/2005-4 – *WINE OH!*, mn. 22–24; the mark was already, however, found not to be deceptive in respect to goods and services claimed in classes 9, 25 and 43.

<sup>390</sup> OHIM Dec. of 13.6.2012 – R 426/2012-5 – *Tea by Thé*, mn. 16.

<sup>391</sup> OHIM Dec. of 4.4.2001–R 468/1999-1 – *International Star Registry*, mn. 24, 25; the sign was, however, considered eligible for registration in respect of advertising services in class 35.

<sup>392</sup> Likewise *v. Kapff, Gielen/v. Bomhard*, Concise European Trade Mark and Design Law, 2<sup>nd</sup> ed., Art. 7 EUTMR, mn. 10(b); the opposite view, taken by GC ECLI:EU:T:2016:634 *Caffè Nero*, mn. 54, according to which a possible non-deceptive use of the mark is irrelevant, is impossible to reconcile with the rationale of the obstacle in lit. (g).

<sup>393</sup> CJ ECLI:EU:C:2006:215 *Elizabeth Florence Emanuel v Continental Shelves 128 Ltd.*, mn. 20, 50.

<sup>394</sup> CJ ECLI:EU:C:2017:434 *Cotton flower* mn. 56, 57.

Similarly, the aptitude of an actual deceit or a sufficiently serious risk of such deceit was rejected with regard to the sign *École du Ski Français* as the sign in itself does not necessarily convey the message that the ski school in question is under the control of an official French authority.<sup>395</sup> Likewise, the mark *Belgian Traditional Biscuits* was not found to be deceptive with regard to ‘turkish delight’, as this is not a product necessarily elaborated on the basis of a Turkish recipe.<sup>396</sup> Furthermore, if the target public recognises subtle irony contained in a sign, the mark may be registered although – pursuant to its literal meaning – the sign could be potentially perceptive. Hence, the sign *Metal Jacket* was found eligible to be registered as a trade mark for (non-metallic) jackets.<sup>397</sup>

An overview of the registration practice of the Office and the courts concerning the 157 obstacles contained in lit. (g) is presented below:

EUTMs not found to be deceptive: 158

Type	Nice Classes	Mark	Case Number	Authority
Word	25	RUGBY	R 39/2012-2	OHIM (BoA)
Figurative	25, 28, 41		T-41/10	General Court

Signs refused because of deceptiveness: 159

Type	Nice Classes	Mark	Case Number	Authority
Word and Figurative/Word	30, 35	Caffè Nero	T-37/16 and T-29/16	GC
Figurative	30, 32		R 426/2012-5	OHIM (5 <sup>th</sup> Board of Appeal)
Word	32	WINE OH!	R 1074/2005-4	OHIM (4 <sup>th</sup> Board of Appeal)
Word	9, 16, 41	INTERNATIONAL STAR REGISTRY	R 468/1999-1	OHIM (4 <sup>th</sup> Board of Appeal)

<sup>395</sup> GC ECLI:EU:T:2011:200 *École du Ski Internationale v OHIM*, mn. 49, 50.

<sup>396</sup> Nor in relation to the goods ‘Danish butter cookies’, but the sign was barred under lit. (b) in this respect s. EUIPO, Dec. of 25.5.2017, R 272/2017-2, *Belgian Traditional Biscuits* mn. 38.

<sup>397</sup> OHIM Dec. of 23.10.2002 – R 314/2002-1 – *Metal Jacket*; agreeing Eisenführ in Eisenführ/Schennen (ed.), *Unionsmarkenverordnung*, Art. 7, mn. 259.

## VIII. Armorial bearings, flags and other State emblems (lit. h)

## 1. General; objective of Art. 6ter PC

160 Under Art. 7 (1)(h), trade marks which have not been authorised by the competent authorities are barred from registration and are to be refused pursuant to Art. 6ter of the Paris Convention. By reference to Art. 6ter PC, armorial bearings, flags and other State emblems, as well as official signs and hallmarks indicating control and warranty, are excluded from registration. The most important text passages of Art. 6ter PC, which are of relevance to the obstacles contained in Art. 7 (1)(h) and (i), read as follows:

*(1)(a) The countries of the Union agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trade marks or as elements of trade marks, of armorial bearings, flags, and other State emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view.*

*(b) The provisions of subparagraph (a), above, shall apply equally to armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations of which one or more countries of the Union are members, with the exception of armorial bearings, flags, other emblems, abbreviations, and names, that are already the subject of international agreements in force, intended to ensure their protection.*

*(c) No country of the Union shall be required to apply the provisions of subparagraph (b), above, to the prejudice of the owners of rights acquired in good faith before the entry into force, in that country, of this Convention. The countries of the Union shall not be required to apply the said provisions when the use or registration referred to in subparagraph (a), above, is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the armorial bearings, flags, emblems, abbreviations, and names, or if such use or registration is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization.*

*(2) Prohibition of the use of official signs and hallmarks indicating control and warranty shall apply solely in cases where the marks in which they are incorporated are intended to be used on goods of the same or a similar kind.*

*(3)(a) For the application of these provisions, the countries of the Union agree to communicate*

*reciprocally, through the intermediary of the International Bureau, the list of State emblems, and official signs and hallmarks indicating control and warranty, which they desire, or may hereafter desire, to place wholly or within certain limits under the protection of this Article, and all subsequent modifications of such list. Each country of the Union shall in due course make available to the public the lists so communicated.*

*Nevertheless such communication is not obligatory in respect of flags of States.*

*(b) The provisions of subparagraph (b) of paragraph (1) of this Article shall apply only to such armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations as the latter have communicated to the countries of the Union through the intermediary of the International Bureau.*

*(...)*