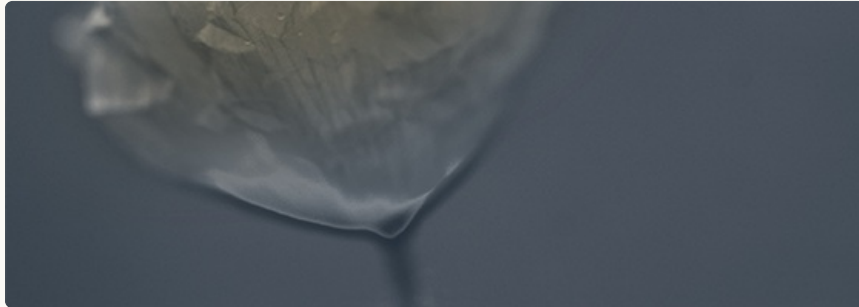


curellsuñol

INTELLECTUAL PROPERTY ATTORNEYS



[See online version](#)

News April 2023

Toblerone says goodbye to the Swiss mountains and its iconic logo

Due to the relocation of part of its chocolate production to Bratislava (Slovakia) Toblerone, the popular chocolate brand created in Bern in 1908, will no longer incorporate the image of the Matterhorn on its packaging in order to comply with Swiss legislation.



"Swissness" Legislation

On 1 January 2017, the Swissness Legislation came into force, which restricts the use of Swiss iconography on products and services that do not meet the criteria of "Swiss origin".

The core of this legislative initiative is set out in the Trademark Protection Act, which specifies the conditions under which a product or service can be considered genuinely Swiss. In the case of milk and dairy products, these must be made from 100% local raw materials, although there are exceptions for materials that cannot be produced in Switzerland, such as cocoa (Art. 48.b.2 and 3 of the Trademark Protection Act).

[Read more](#)

Show me your distinctiveness and I will tell your strength

Sometimes, when a client asks us to register a trademark, the sign to be registered, though attractive in marketing terms, is weak in terms of

distinctiveness.

The lack of distinctiveness of these marks is mainly because they are descriptive of the quality, quantity, characteristics, intended purpose, type or size of the goods or services they are intended to protect. A distinction must be made between purely descriptive marks (which are not registrable on absolute grounds) and weak marks. For example, a purely descriptive mark would be "squeezed apples" for apple juice and a weak mark would be "apple elixir" for the same product.



Terms or expressions that refer to the characteristics of goods and services are not appropriable by a single person or undertaking and must be available to competitors. Trademarks consisting only of such descriptive terms or expressions are therefore often rejected by registration offices.

In order to obtain registration of such marks, descriptive terms or expressions must be accompanied by additional words or graphic elements unrelated to the goods and services covered, which will give the mark a certain degree of distinctiveness.

[Read more](#)

Coinbase vs bitFlyer - crypto exchanges battle over the coinbase trademark in EU

The General Court reminds EUIPO that, when assessing bad faith, it must consider all the factual circumstances specific to the case that pertained at the time of filing the contested mark

The General Court of the European Union did not agree with the European Union Intellectual Property Office (EUIPO) [which does not happen every day] in its recent judgment of 22 March 2023 in *Coinbase v EUIPO - bitFlyer* (coinbase), T-366/21, ECLI:EU:T:2023:156. Instead, it sided with Coinbase, Inc., a US company that operates one of the biggest cryptocurrency exchange platforms - Coinbase, founded in 2012 with the idea that anyone, anywhere, should be able to send and receive the cryptocurrency Bitcoin easily and securely.



[Background of the case](#)

On 3 February 2016, Japanese company bitFlyer Inc., which operates the cryptocurrency exchange bitFlyer [No. 1 in Bitcoin trade volume in Japan since 2017], obtained from the WIPO the International Registration (IR) No. 1308248 for the word mark “coinbase” in relation to goods and services under Classes 9, 35, 36, 38, and 42.

On 29 June 2018, Coinbase, Inc. filed with EUIPO a request for a declaration of invalidity against the “coinbase” mark in its entirety. The grounds for invalidity relied on were those referred to in i) Article 60(1)(a) of EUTM Regulation 2017/1001, in relation to Article 8(1)(b) [likelihood of confusion], on the basis of, inter alia, earlier IR-EU 1216587 COINBASE (word), in Classes 9, 36 and 42, and ii) Article 59(1)(b) [bad faith]. To support its bad faith claim, Coinbase, Inc. argued, in essence, that bitFlyer Inc. knew or should have known about its intensive prior use of the COINBASE mark in the USA and EU for a software allowing the trade with the cryptocurrency Bitcoin.

EUIPO’s Cancellation Division declared invalid the contested mark regarding the identical and similar goods and services on the grounds of likelihood of confusion on the part of the public. It rejected the invalidity request in respect of the dissimilar goods and services. In particular, it considered that Coinbase, Inc. had not submitted concrete and persuasive evidence that bitFlyer Inc. acted dishonestly when it filed the contested mark.

Coinbase Inc. filed an appeal. In the statement of grounds of appeal, it limited the scope of the appeal to the goods and services for which the invalidity request had been rejected.

EUIPO’s Fourth Board of Appeal dismissed the appeal. It noted that the scope of appeal was limited to whether or not there had been bad faith with regard to bitFlyer Inc. having filed the mark for the dissimilar goods and services. It found that there was nothing on the file to conclude that regarding the dissimilar goods and services under appeal, bitFlyer Inc. had dishonest intentions and dishonestly attempted to block a legitimate trademark use by a competitor, such as Coinbase, Inc. Coinbase Inc. appealed before the General Court.

[Read more](#)

Is the design technical?

The Court of Justice of the European Union (CJEU) has recently issued a new decision (C-684/21; 02/03/2023) on the question of how to determine whether a feature of appearance of a registered design is solely dictated by its technical function.

This is an important topic affecting the validity of registered designs in Europe. Indeed, according to Article 8(1) of the CDR (Community Design Regulation No 6/2002), a registered design shall not subsist in features of appearance of a product (usually a shape) which are solely dictated by its technical function.

It is not always easy to assess the purely technical character of a shape. In many cases, when the designer of a product chooses a shape, he takes the visual impression into account, as well as its technical function.



[Background: the CJEU "DOCERAM" decision C-395/16 of 8 March 2018](#)

In its previous important decision "DOCERAM" (C-395/16; 08/02/2018), the CJEU held that to determine whether a feature of appearance is solely dictated by its technical function, it is necessary to show that the technical function was the only factor determining the choice of the feature of

appearance. For this purpose, the existence of alternative designs fulfilling the same function is irrelevant.

The CJEU justified the latter principle (irrelevance of alternative designs) as a way of preventing an economic operator from being able to register as a design all conceivable variants of shape for fulfilling the same technical function, thereby benefiting from exclusive protection which, in practice, would be equivalent to that conferred by a patent, without being subject to the requirements applicable for obtaining the latter.

However, in the same "DOCERAM" decision, the CJEU clarified that the existence of alternative designs, without being decisive, may be taken into account. More specifically, the assessment must be carried out taking into account, in particular, the design in question, the objective circumstances showing the reasons that governed the choice of the features of the appearance of the product in question, the data relating to its use or even the existence of alternative designs that enable the same technical function to be carried out, provided that these circumstances, these data or this existence are supported by reliable evidence.

[Read more](#)



Public Holidays

During the months of April and May our offices will be closed on the following dates:

Easter:

- **6 April** (Madrid office)
- **7 April** (all our offices)
- **10 April** (Barcelona and Alicante offices)

International Workers' Day:

- **1 May** (all our offices)

[Read more](#)

CURELL SUÑOL SLP

Barcelona - Madrid - Alicante
mail@curell.com
Tel. +34 934875166



www.curell.com

We protect your projects, we project your future.

**TOP RANKED - IP STARS - IAM 1000 - WTR 1000 -
LEADER'S LEAGUE BEST LAWYERS - FINANCIAL TIMES**

This e-mail has been sent to {{ contact.EMAIL }}
You have received this e-mail because you have contracted IP services with
CURELL SUÑOL

[Unsubscribe](#)



© 2023 CURELL SUÑOL