

CANCELLATION No 21 602 C (INVALIDITY)

Hans-Peter Wilfer, Zum Hackerhof 5, 08258 Markneukirchen, Germany (applicant), represented by **Meissner Bolte Patentanwälte Rechtsanwälte Partnerschaft MBB**, Widenmayerstraße 47, 80538 München, Germany (professional representative)

a g a i n s t

Gibson Brands, Inc., 309 Plus Park Boulevard, Nashville Tennessee 37217, United States of America (EUTM proprietor), represented by **Allen & Overy LLP**, One Bishops Square, London E1 6AD, United Kingdom (professional representative)..

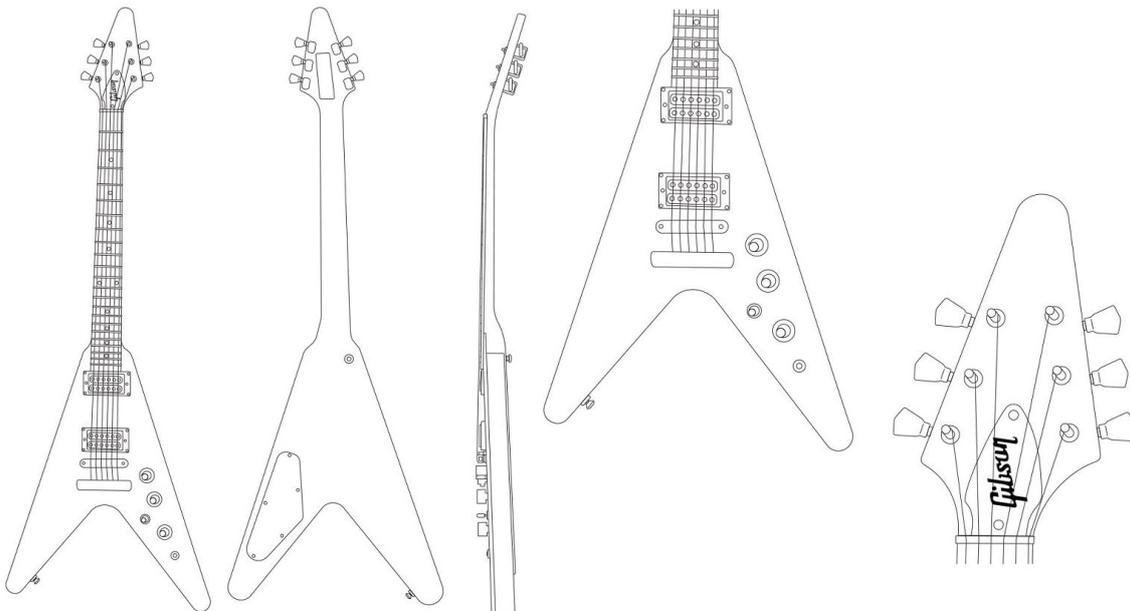
On 26/09/2019, the Cancellation Division takes the following

DECISION

1. The application for a declaration of invalidity is rejected in its entirety.
2. The applicant bears the costs, fixed at EUR 450.

REASONS

The applicant filed an application for a declaration of invalidity against European Union trade mark No 16 285 091



(3D mark) (the EUTM). The request is directed against all the goods covered by the EUTM, namely:

Class 15: *Stringed musical instruments.*

The applicant invoked Article 59(1)(a) EUTMR in conjunction with Article 7(1)(a)(b)(c)(d)(e)(f)(g)(h)(i)(j)(k)(l)(m) EUTMR.

SUMMARY OF THE PARTIES' ARGUMENTS

The applicant explains in its two submissions that the applicant and the EUTM proprietor are both manufacturers of musical instruments, in particular guitars and bass guitars and that there are a number of litigation proceedings between them in which the proprietor claims trademark protection for its guitar bodies.

The applicant first considers that the contested trade mark is contrary to Article 7(1)(b) EUTMR and recent case law has established principals for assessing the distinctive character of three-dimensional trademarks that depict the product itself. In case 27/06/2017, [T-580/15](#), 'CLIPPER' (3D) the General Court confirmed the decision of the Boards of Appeal cancelling the following trademark:



The Court found that:

“It should be noted that the application form for registration of the mark at issue contains no description of the sign in question, and that only the box ‘three-dimensional mark’ was ticked. In particular, the word element ‘clipper’, very small in size, appears in only one of the five images submitted with the application for registration. In that respect, the applicant did not indicate in any way whatsoever that the word element ‘clipper’ was an important element of the mark at issue, to which the protection afforded to that mark had to extend. That lack of precision is a firm indication of the limited value and importance placed on that word element by the applicant when it filed the application for registration of the mark at issue. (...)

Given that, in its application for registration, the applicant stated that the predominant and essential element of the mark at issue is its shape and that it did not emphasise clearly the importance of the small-size word element ‘clipper’ for the registration of the mark at issue, it is appropriate, particularly in the light of Article 4 of Regulation No 207/2009, to take the view that the essential characteristics of the mark at issue must be limited to the elements constituting the shape itself, that is to say, the elements that are themselves three-dimensional or which define the outline of the three-dimensional shape”.

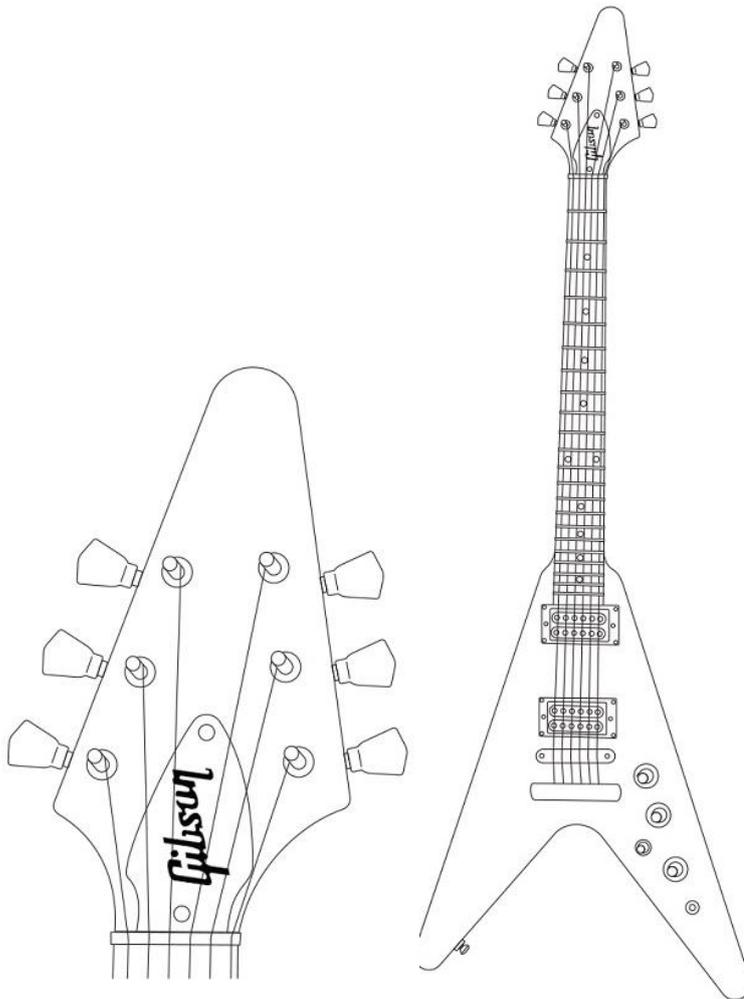
The applicant considers that in the present case, the proprietor did not indicate that the 3D-trademark includes any important verbal element but simply applied for a 3D-trademark of an electric guitar. The verbal element is of minor importance as it is of very small in size and the proprietor did not indicate that this element is of any importance to the application in describing the trade mark. Therefore, the essential characteristics of the mark at issue are limited to the shape itself.

The registration is also contrary to Article 7(1)(e)(i) EUTMR because it consists exclusively of the shape which results from the nature of the goods themselves. Finally the applicant denies that the contested trade mark has acquired distinctiveness in relation to 'musical instruments' in consequence of the use which has been made of it. The applicant also asks for an oral hearing.

In support of its observations, the applicant filed previous decisions of the Office between the same parties

- 17/05/2013, 5625 C confirmed by 06/02/2014, R 1333/2013-1,
- 21/12/2016, 9908 C confirmed by 08/03/2018, R415-2017,
- 21/07/2017, 11 911 C,
- printouts of refused EUTM applications representing shapes of guitars,
- EUIPO decision in Swedish of 13/06/2013 refusing EUTM figurative application N° 11 527 512,
- EUIPO decision in English of 09/03/2017 refusing EUTM application N° 15 607 682.

The EUTM proprietor argues in its two submissions that it is known worldwide as one of the oldest manufacturer of classical and electrical guitars and its guitars are the most iconic and best known guitars in the world. The contested EUTM filed on 26/01/2017 is inherently distinctive not only because the shape of the so called 'Fyling V' guitar departs significantly from the norm of the sector and has become iconic but also because its headstock contains, in one (in fact in two) of the five views, the distinctive elements 'Gibson' and the design of a bell.



Due to the presence of these clearly perceptible and distinctive elements, the contested trade mark is distinctive. As to 27/06/2017, [T-580/15](#), 'CLIPPER' mentioned by the applicant, it is different as 'Gibson' is clearly perceptible in the view of the contested EUTM which contains a close up of the guitar's head. The word is not small in size and the relevant public displaying a high level of attention in relation to the goods will perceive these elements which are distinctive. Word element added to a shape mark facilitates the determination of the commercial origin of the goods. Applying this

standard to the case at hand, the element  contained on the Flying V facilitates the determination of the commercial origin of the electric guitar and thus makes it distinctive. The EUTM Proprietor owns separate registrations including GIBSON:

- EUTM N° 11 581 865 GIBSON (word)

- EUTM N° 13 461 736 

In addition, the EUTM proprietor argues that trade mark has acquired distinctiveness through use and comments the evidence filed.

Finally, it considers that Article 7(1)(e) EUTMR is not applicable as it has a very narrow scope of protection.

In support of its observations, the EUTM proprietor filed confidential evidence (Enclosure 1 to 18 and with its second observations, Enclosure 1 to 3). The evidence has been properly listed by the EUTM proprietor and is available in the file. Since there is no specific evidence related to the argument of inherent distinctive character due to the affixing of figurative elements on the head of the guitar, (except from previous decisions and case law also referred to in the observations) the evidence will not be described in the present decision for economy of proceedings.

PRELIMINARY REMARK

The applicant requests an oral hearing. Article 96 EUTMR provides that the Office may hold oral proceedings. The Office can hold oral proceedings at the request of any party to the proceedings only when it considers these to be absolutely necessary. This will be at the Office's discretion (20/02/2013, T-378/11, Medinet, EU:T:2013:83, § 72 and the case-law cited therein; 16/07/2014, T-66/13, Flasche, EU:T:2014:681, § 88). In the vast majority of cases it is sufficient for the parties to present their observations in writing. In the present case, the Cancellation Division confirms that it has not been considered necessary to hold oral proceedings and the request is rejected.

ABSOLUTE GROUNDS FOR INVALIDITY – ARTICLE 59(1)(a) EUTMR IN CONJUNCTION WITH ARTICLE 7 EUTMR

According to Article 59(1)(a) and (3) EUTMR, a European Union trade mark will be declared invalid on application to the Office, where it has been registered contrary to the provisions of Article 7 EUTMR. Where the grounds for invalidity apply for only some of the goods or services for which the European Union trade mark is registered, the latter will be declared invalid only for those goods or services.

Furthermore, it follows from Article 7(2) EUTMR that Article 7(1) EUTMR applies notwithstanding that the grounds of non-registrability obtain in only part of the Union.

As regards assessment of the absolute grounds of refusal pursuant to Article 7 EUTMR, which were the subject of the ex officio examination prior to registration of the EUTM, the Cancellation Division, in principle, will not carry out its own research but will confine itself to analysing the facts and arguments submitted by the parties to the invalidity proceedings.

However, restricting the Cancellation Division to an examination of the facts expressly submitted does not preclude it from also taking into consideration facts that are well known, that is, that are likely to be known by anyone or can be learned from generally accessible sources.

Although these facts and arguments must date from the period when the European Union trade mark application was filed, facts relating to a subsequent period might also allow conclusions to be drawn regarding the situation at the time of filing (23/04/2010, C-332/09 P, Flugbörse, EU:C:2010:225, § 41 and 43)

Distinctiveness – Article 7(1)(b) EUTMR

Article 3(3)(c) EUTMIR defines shape marks as trade marks consisting of, or extending to, a three-dimensional shape, including containers, packaging, the product itself or their appearance. The term 'extending to' means that these marks cover not only

shapes per se but also shapes that contain word or figurative elements such as logos or labels.

The relevant public is composed of professional and amateur electric guitarists in the territory of the European Union. As far as concerns the level of attention of that public, it is considered to be higher than average, which must be interpreted as a fairly high degree of attentiveness in the light of the specialist nature of the goods at issue, which do not fall within the category of commonly used consumer goods.

In the present case, the contested trade mark is not exclusively composed of the shape

of the goods as in two of its views, the element '' is clearly visible, as shown above.

Therefore the contested trade mark includes another element that gives the trade mark distinctive character. As a general principle, any element that on its own is distinctive will lend the shape trade mark distinctive character as long as it is perceivable in the normal use of the product and is sufficient to render the mark registrable. It is not discussed that at least the word elements affixed to the head of the guitar 'Gibson' is distinctive.

The applicant invokes 27/06/2017, [T-580/15](#), 'CLIPPER' where this principle has not been applied by the General Court because it has been considered that although the word element Clipper was visible in one of the views of the contested 3D EUTM representing a disposable lighter, '*given that, in its application for registration, the applicant stated that the predominant and essential element of the mark at issue is its shape and that it did not emphasise clearly the importance of the small-size word element 'clipper' for the registration of the mark at issue, it is appropriate (...) to take the view that the essential characteristics of the mark at issue must be limited to the elements constituting the shape itself*'.

In the present case, the previous cases referred to by the applicant are not relevant to the present proceedings. In particular, as correctly stated by the EUTM proprietor, the present case is different from 27/06/2017, [T-580/15](#), 'CLIPPER'.

The applicant considers that in the present case, the proprietor did not indicate that the 3D-trademark includes any important verbal element but simply applied for a 3D-trademark of an electric guitar. As correctly mentioned by the EUTM proprietor, according to Article 3(2) and 3(3)(c) EUTMIR, it is not foreseen to add a description to a three dimensional trade mark which indicates that at least since the entry into force of the last EUTM Legal Reform, a description should not be considered decisive. Therefore the fact that one of the views is a close up clearly showing the distinctive element is enough to indicate that the applicant of the contested EUTM considered these elements as part of the scope of protection of the trade mark.

In addition, it can be added that the size of a word mark applied to a lighter is much smaller than the size of an element applied to the head of a guitar. Finally, the value of the respective goods is very different, one being disposable and the other being an expensive good. As mentioned by the EUTM proprietor, the level of attention when buying a guitar is higher than average. As a consequence, the trade mark affixed to the head of the guitar is likely to have a bigger impact compared to the trade mark affixed to a lighter.

While the Office does have a duty to exercise its powers in accordance with the general principles of European Union law, such as the principle of equal treatment and the principle of sound administration, the way in which these principles are applied must be consistent with respect to legality. It must also be emphasised that each case must be examined on its own individual merits. The outcome of any particular case will depend on specific criteria applicable to the facts of that particular case, including, for example, the parties' assertions, arguments and submissions.

In view of the above, it follows that, even if the previous decisions submitted to the Cancellation Division are to some extent factually similar to the present case, the outcome may not be the same.

As previously mentioned, even the standard shape of a product can be registered as a shape trade mark if a distinctive word mark or label appears on it, which is the case here. Therefore, this ground must be rejected and it is not necessary to examine whether the shape itself is distinctive.

Shape giving its substantial value to the good- Article 7(1)(e)(i) EUTMR

Under Article 7(1)(e)(i) EUTMR, signs that consist exclusively of the shape or another characteristic that results from the nature of the goods themselves cannot be registered. As previously mentioned, this contested trade mark is not exclusively composed of the shape of the goods (musical instruments) as it contains a distinctive verbal element ('Gibson') which is clearly perceptible as demonstrated above.

Therefore, this ground must also be rejected.

Other grounds invoked by the applicant

A reasoned statement on the grounds must be provided before the expiry of the substantiation period, which is the closure of the adversarial part of the revocation or invalidity proceedings (Article 16(1) EUTMDR).

In the present case the applicant did not provide any arguments or documents in support to the other grounds invoked as listed in the section 'REASONS' above. The additional grounds are therefore not substantiated and must be rejected.

Conclusion

In the light of the above, the Cancellation Division concludes that the application must be rejected.

COSTS

According to Article 109(1) EUTMR, the losing party in cancellation proceedings must bear the fees and costs incurred by the other party.

Since the applicant is the losing party, it must bear the costs incurred by the EUTM proprietor in the course of these proceedings.

According to Article 109(7) EUTMR and Article 18(1)(c)(ii) EUTMIR, the costs to be paid to the EUTM proprietor are the representation costs, which are to be fixed on the basis of the maximum rate set therein.

**The Cancellation Division**

Julie, Marie-Charlotte
HAMEL

Jessica LEWIS

Frédérique SULPICE

According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 720 has been paid.