

**DECISION  
of the Fifth Board of Appeal  
of 20 March 2023**

In case R 339/2019-5

**PRUMAPY SAS**  
145 avenue de Fontvert  
84130 LE PONTET  
France

**Apple and Pear Australia Limited**  
Suite G01 128-136 Jolimont Road  
EAST MELBOURNE Victoria 3002  
Australia

Opponents / Appellants

represented by NautaDutilh, Chaussée de la Hulpe, 120, 1000, Bruxelles, Belgium

v

**Pink Lady America**  
POBox 1420 N. 16th Ave.  
Yakima, Washington 98902  
United States of America

Applicant / Defendant

represented by Roberto Manno, Geremia di Scanno, 65, 76121 Barletta (BA), Italy

APPEAL relating to Opposition Proceedings No B 2 225 020 (European Union trade mark application No 11 701 216)

**THE FIFTH BOARD OF APPEAL**

composed of V. Melgar (Chairperson), Ph. von Kapff (Rapporteur) and A. Pohlmann (Member)

Registrar: H. Dijkema

gives the following

## Decision

### Summary of the facts

- 1 By an application filed on 29 March 2013, Pink Lady America ('the applicant') sought to register the word mark

### WILD PINK

for a list of goods in Classes 29, 30, 31, which include the following, which are the only goods still at issue in the present proceedings following parallel opposition proceedings and the limitation requested on 11 April 2022 and accepted on 30 May 2022:

Class 29: *Preserved, frozen, dried and cooked vegetables.*

Class 30: *Fruit flavourings, other than essences.*

Class 31: *Fruit, fresh, namely apples belonging to the species 'Malus domestica Borkh'.*

- 2 The application was published on 24 May 2013.
- 3 On 30 July 2013, Star Fruits Diffusion SAS, the predecessor in title to PRUMAPY SAS and Apple and Pear Australia Limited ('the opponents') filed an opposition against the registration of the published trade mark application for all the goods applied for. The grounds of opposition were those laid down in Article 8(1)(b) and Article 8(5) EUTMR. The opponents filed the opposition as owner, co-owner and, for some of the earlier marks, as authorized licensee.
- 4 The opposition was based on
  - a) the word mark

### PINK LADY

- a) EU word mark No 2 042 679, filed on 11 January 2001 and registered on 27 February 2003, for the following goods:

Class 31: *Agricultural, horticultural products including fruit, grains, plants and trees, especially apples and apple trees.*

Reputation was claimed for all the goods in the EU.

- b) EU word mark No 2 266 948, filed on 8 June 2001 and registered on 9 December 2004, for, inter alia, the following goods:

Class 29: *Preserved, dried and cooked fruits; including apples.*

Class 30: *Confectionery including apple cakes and applies pies; cereal and oat based products including health bars; breads; and pastries such as apple strudel.*

Reputation in the EU was claimed for all the goods in Classes 29 and 30.

- c) Benelux' word mark No 559 177, filed and registered on 27 July 1994 for the following goods:

Class 31: *Agricultural, horticultural and silvicultural products and grains, not included in other classes; live animals; fresh fruits and vegetables; grains, live plants and flowers; foodstuff for animals, malt.*

Reputation was claimed for all the goods in Benelux.

- d) German word mark No 2 903 690, filed on 29 July 1994 and registered on 23 March 1995, for the following goods:

Class 31: *Fresh fruits and vegetables; fodder; malt; agricultural, horticultural and forestry products and grains; live animals; seeds; live plants and natural flowers.*

Reputation was claimed for all the goods in Germany.

- e) United Kingdom word mark No 1 582 849, filed on 26 August 1994 and registered on 25 October 1996, for the following goods:

Class 31: *Fresh fruit and vegetables; seeds; plants which bear pink coloured foliage or flowers; all included in class 31.*

Reputation was claimed for all the goods in the UK.

The trade mark was registered with the following limitation:

It is a condition of registration that the mark shall not be used as a varietal name or part of a varietal name.

It contained the following disclaimer:

Registration of this mark shall give no right to the exclusive use of the word 'Pink'.

- f) French word mark No 92 420 538, filed and registered on 20 May 1992, for the following goods:

Class 31: *Apples, fruit trees and fresh fruit.*

Reputation was claimed for all the goods in France.

- b) EU figurative mark No 4 186 169



filed on 23 November 2004 and registered on 15 December 2005, for, inter alia, the following goods:

Class 29: *Preserved, dried, cooked and crystallised fruits; preparations made from preserved, dried, cooked and crystallised fruits; jams; compotes; fruit jellies; fruit salads; fruit yoghurts; fruit chips;*

Class 30: *Preparations made from cereals; cakes; biscuits; confectionery; ices, sorbets and ice-creams; sugar confectionery;*

Class 31: *Fresh fruit; apples; fruit trees; apple trees.*

Reputation in the EU was claimed for all the above mentioned goods.

- c) The figurative mark



- a) EU mark No 6 335 591 filed on 4 October 2007 and registered on 30 July 2008, for the following goods:

Class 31: *Agricultural and horticultural products; fruit, grains, plants and trees; apples and apple trees.*

Reputation in the EU was claimed for all the goods.

- b) EU figurative mark No 8 613 911, filed on 14 October 2009 and registered on 26 April 2010, for, inter alia, the following goods:

Class 29: *Preserved, dried, cooked and crystallised fruits, preparations made from preserved, dried, cooked and crystallised fruits, jams, compotes, fruit jellies, fruit salads, fruit yoghurts, fruit chips;*

Class 30: *Preparations made from cereals, cakes, biscuits, confectionery, ices, sorbets and ice creams, sugar confectionery.*

Reputation in the EU was claimed for all the goods in Classes 29 and 30.

- 5 The opponents submitted ample evidence with the aim to prove enhanced distinctive character and reputation of their earlier trade marks for some of the goods at issue, namely apples. PINK LADY is used (1) to distinguish premium applies which belong to a particular variety, namely the Community plant variety right ‘Cripps Pink’, for which Star fruits is the exclusive representative in the EU and (2) carefully selected fruit. The word ‘pink’ is unknown for a substantial part of the relevant public in the EU. In addition, apples are not pink. This was stated in the judgement of the Rechtbank van koophandel te Brussel (Commercial Court of Brussels) of 28 June 2012, A.R. 05361/2010, which should be recognised as being *res iudicata*. However, the marketing material constantly uses a dominant shade of pink. Reference is made to further opposition proceedings, in which the opponents succeeded against the trade marks Pink Blush, English Pink and Lady in Rose.
  
- 6 In reply, the applicant expressly pointed out in paragraphs 17 to 19 of its observations that the colour pink has been used to distinguish apple varieties. First, it maintained that apples are pink, arguing that that colour was one of the ‘*raisons d’être*’ of the Cripps Pink apple variety, which has been granted a United States plant patent that expressly states that the: ‘*Coloration. - Fruit has striking pink blush (absent of striping) covering 30-80% of the apple surface. The pink blush coloration develops gradually in the late season and overlies a yellow-green background. Coloration continues to increase before the harvest season and even as fruits are harvested if the fruits are exposed to sunlight. Coloration is fuller for apples exposed to full sunlight than fruit hanging in shaded areas.*’ It stated that the apple variety known as Cripps Pink is protected in the European Union by plant variety certificate No EU1640 (Application number: 19951039). Next, it produced an extract from the Apple Journal describing the apple variety Pink Lady (Cripps Pink) as having an ‘*attractive pink blush over yellow undertone*’. It also referred to the Community Plant Variety Office (CPVO) guidelines for testing apple varieties for distinctness, uniformity and stability, which stated that the apple variety Cripps Pink was ‘pink red’. Lastly, it produced an article published in 1993 in the HortScience journal, headed ‘“Pink Lady” Apple’, in which the authors, one of whom being J.E. Cripps, the inventor of the Pink Cripps variety, state that 40 to 70% of the surface of the apple is ‘solid pinkish-red’.

### **The contested decision**

- 7 By decision of 23 December 2014 (‘the contested decision’), the Opposition Division rejected the opposition, for all the contested goods on the grounds that there was no likelihood of confusion. It gave, in particular, the following grounds for its decision:
  - The opponents filed an opposition against all the goods of EU trade mark application No 11 701 216. The opposition is based on, inter alia, EU trade mark registration No 2 042 679 and EU trade mark registration No 2 266 948. The opponents invoked Article 8(1)(b) and 8(5) EUTMR.

*LIKELIHOOD OF CONFUSION – ARTICLE 8(1)(b) CTMR**No 2 042 679 and No 2 266 948*

- The Opposition Division first examined the opposition in relation to earlier word mark PINK LADY protected for the EU under No 2 042 679 and No 2 266 948.
- There is no likelihood of confusion on the part of the public. Therefore, the opposition must be rejected insofar it is based on earlier EU trade mark registration No 2 042 679 and EU trade mark registration No 2 266 948 in respect of Article 8(1)(b) EUTMR.

*a) The goods**Contested goods in Class 29*

- Like the opponents' *preserved, dried and cooked fruits*, the contested *preserved, frozen, dried and cooked vegetables* are processed foodstuffs for consumption or conservation. These products target the same end users and more often than not are sold alongside or close to each other in retail outlets. Moreover, given the same or similar way of processing, these goods often have the same commercial origin. While the goods under comparison are essentially different types of food products, the abovementioned factors warrant a conclusion that they are similar to a low degree.

*Contested goods in Class 30*

- The contested *pierozki containing mince* are dough-based, fried or baked products stuffed with minced meat. They can have the same nature as the opponents' *cereal and oat based products; breads*, namely of dough-based foodstuffs. These goods target the same consumers, are sold in the same parts of shops or in the same shops, such as bakeries, and have the same commercial origin. Accordingly, they are considered similar.
- Conversely, the contested *fruit flavourings, other than essences; fruit vinegar* are not similar to any of the opponents' goods. The fact that the contested *fruit vinegar* can be made from some of the opponents' goods in Class 31 (e.g. grapes or apples) or that the contested *fruit flavourings, other than essences* can be added to others (e.g. the opponents' *confectionery; pastries*) is not sufficient for a finding of similarity, since the opponents' goods are different in nature (fresh produce or foodstuffs versus processed products not for direct consumption) and purpose (satisfying hunger or dietary needs versus flavouring food). Furthermore, the goods at issue have different natures, producers and methods of use and are displayed in different sections of supermarkets. It follows from the above that the contested *fruit flavourings, other than essences; fruit vinegar* are dissimilar to the opponents' goods.

*Contested goods in Class 31*

- The contested *mixed fruits [fresh]; fruit, fresh; fresh fruits and vegetables; raw fruits; mandarins (fresh fruit)* are instances of various agricultural or horticultural products. As such, they are included in the broad category of the opponents' *agricultural, horticultural products*. Therefore, they are considered identical.

*b) The signs*

- Taking into account the visual, aural and, for some of the relevant the public, conceptual coincidences, the signs under comparison are similar to some degree.
- The relevant territory is the European Union.
- Visually, the signs PINK LADY and WILD PINK are similar to the extent that they coincide in the element 'PINK'. However, they differ in all their remaining components and aspects. In particular, the coinciding element is placed in different positions, namely at the beginning of the earlier marks and the end of the contested sign. In addition, the signs differ in their other components, namely 'LADY' in the earlier marks and 'WILD' in the contested signs.
- Aurally, irrespective of the different pronunciation rules in different parts of the relevant territory the pronunciation of the signs coincides in the sound of the letters 'P-IN-K' present identically in both signs, and to that extent the signs are aurally similar. The pronunciation differs in the sound of the remaining components of each sign. The fact that the common element is placed in different positions makes for a somewhat contrasting aural impression when each sign is pronounced.
- Conceptually, different scenarios can be foreseen for the public in different parts of the relevant territory.
- First, both signs are meaningful for the English-speaking part of the relevant public. The earlier marks will be understood as a 'woman, normally from a high social position or of moral character, in pink, for example dressed in such colour' whereas the contested sign will be perceived as referring to 'an intense, vivid, wild shape of the colour pink'. While both signs refer to the colour pink, their overall meanings are rather different given that the earlier marks refer to a person and the contested sign to a colour.
- For the non-English-speaking part of the public, the marks as such have no clear meaning. Nevertheless, the element 'WILD' of the contested sign will be understood by the German-speaking public as referring to something which is not domestic or processed and the element 'PINK', present in both marks, will be understood as a colour reference. The Danish-speaking public will also understand the element 'PINK' of the marks as referring to a colour, whereas for the Dutch-speaking public this word will refer to the little finger

of a hand. Finally, for the Estonian-speaking public ‘PINK’ would refer to ‘a bench’. Therefore, for the aforementioned parts of the public the marks are conceptually similar to the extent that they have the word ‘PINK’ in common.

- For the rest of the public, who will grasp no meaning in the elements of the marks under comparison, they are not conceptually similar.

*c) Distinctive and dominant elements of the signs*

- In determining the existence of likelihood of confusion, the comparison of the conflicting signs must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.
- The element ‘PINK’, present in both marks, will be associated by part of the relevant public as referring to a colour. Given that some of the earlier marks’ goods include fruit and plants (such as flowers) and that the contested goods include fruit, that element will be perceived as indicative of a characteristic of those goods, namely their colour. In this regard, the opponents’ view that fruit, and in particular apples, do not come in the colour pink cannot be upheld since, albeit not the most typical colour for that fruit, apples can come in a shade of red which is, or closely resembles, pink. It follows from the above that from the perspective of that part of the relevant public that understands it as a colour reference, the element ‘PINK’ is non-distinctive for some of the goods at issue, namely for *agricultural, horticultural products including fruit, grains, plants and trees, especially apples and apple trees* in Class 31 in respect of earlier Community trade mark registration No 2 042 679 and for *mixed fruits [fresh]; fruit, fresh; fresh fruits and vegetables; raw fruits* in respect of the contested sign.
- The marks under comparison have no elements which could be considered clearly more dominant (visually eye-catching) than other elements.

*d) Distinctiveness of the earlier mark*

- The distinctiveness of the earlier mark is one of the factors to be taken into account in the global assessment of likelihood of confusion.
- According to the opponents, the earlier mark has been extensively used and enjoys an enhanced scope of protection. However, for reasons of procedural economy, the evidence filed by the opponents to prove this claim does not have to be assessed in the present case (see below in ‘*Global assessment*’). The examination will proceed on the assumption that the earlier mark has enhanced distinctiveness.

*e) Relevant public – level of attention*

- The average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods or services in question.



- In the present case, the goods found to be identical or similar to varying degrees are directed at the public at large. Given that the goods are purchased on an everyday basis in a repetitive manner, it must be ruled that the level of attention of the relevant public is low.

*f) Global assessment, other arguments and conclusion*

- In the present case the goods were found to be identical, similar or similar to a low degree and dissimilar.
- The signs display some similarities stemming from the common element ‘PINK’.
- The Opposition Division has assumed that the earlier marks have been extensively used and enjoy an enhanced scope of protection. The examination of likelihood of confusion will, therefore, proceed on the premise that the earlier marks have an enhanced degree of distinctiveness. Indeed, the more distinctive the earlier mark, the greater will be the likelihood of confusion, and therefore, marks with a highly distinctive character because of the recognition they possess on the market, enjoy broader protection than marks with a less distinctive character (judgment of 29/09/1998, C-39/97, ‘Canon’, paragraph 18).
- The signs coincide in one of their elements and differ in the other one. With this in mind, it must be determined whether the overall impression created by each sign is such as to create a likelihood of confusion on the part of the public.
- The Opposition Division, for the reasons set out below, does not consider this to be the case.
- Firstly, the coinciding element is placed in a diametrically opposite position in the competing signs. This difference is easily noticeable, especially when taking into account the fact that the relevant public pays more attention to the beginning of a sign. In view of this, the different position of the coinciding element produces a different impression of each sign on both a visual and aural level.
- Secondly, for the part of the relevant public that understands the meaning of both signs, there are clear conceptual differences between them, even taking into account that they have the element ‘PINK’ in common. Consequently, the existing conceptual coincidence does not carry a lot of weight for establishing a likelihood of confusion between the marks.
- In addition, the coinciding element, ‘PINK’, is non-distinctive for some of the goods, notably for those found to be identical, even for that part of the relevant public that does not understand the signs as a whole. As regards the remaining goods, for which the coinciding element is of normal distinctiveness, the similarity stemming from that element is counterbalanced by the fact that some of those goods are similar to a low degree.

- Finally, it is settled case-law that a compound trade mark and another trade mark which is identical or similar to one of the components of the compound mark cannot be regarded as being similar unless that component forms the dominant element within the overall impression created by the compound mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it (see, *inter alia*, judgment of 23/10/2002, T-6/01, ‘Matratzen’, paragraphs 33-34; judgment of 06/10/2005, C-120/04, ‘Thomson Life’, paragraph 29).
- As is clear from the above paragraphs, the coinciding element does not dominate the overall impression produced by either sign on the relevant public. The opponents have not established this and do not claim it to be the case.
- Likewise, even assuming that the earlier marks enjoy an enhanced distinctiveness due to reputation, the outcome of no likelihood of confusion remains the same. Therefore, it is not necessary to examine the evidence of reputation.
- As regards the goods which were found to be dissimilar, it must be observed for the sake of completeness that as similarity of goods and services is a necessary condition for the application of Article 8(1) CTMR, the opposition based on this article and directed at these goods cannot be successful.
- Since the aforementioned national trade mark registrations are identical (word marks ‘PINK LADY’) to the ones which have been compared, the outcome cannot be different with respect to goods for which the opposition has already been rejected. Therefore, no likelihood of confusion exists with respect to those goods.
- The other earlier figurative marks invoked by the opponents are less similar to the contested sign. This is because they contain further figurative elements, such as a large pink geometrical shape, a heart and/or a stylised representation of the verbal components, none of which is present in the contested sign. Therefore, the outcome cannot be different with respect to the goods for which the opposition has already been rejected; no likelihood of confusion exists with respect to those goods.

#### *REPUTATION – ARTICLE 8(5) CTMR*

##### *Community trade mark registration No 2 042 679*

###### *a) The signs*

- The signs have already been compared above under the grounds of Article 8(1)(b) CTMR. Reference is made to those findings, which are equally valid for Article 8(5) CTMR.

*b) The 'link' between the signs*

- In the present case, the signs have some similarities. This does not necessarily mean that the relevant public is likely to establish a link between them.
  - In particular, it has been demonstrated that the coinciding element PINK does not play an independent role in the perception of either sign.
  - For that part of the public that understands both signs as a whole, the component 'PINK' forms different conceptual units with the additional element of each mark. Accordingly, the public will perceive the component as forming part of two differing expressions, which will not lead to a link being established between the marks.
  - Moreover, even assuming that some of the relevant public does not understand any of the components of the signs or understands only one of them, that public will not establish a link, not least because the coinciding element will be perceived, both visually and aurally, in combination with the additional element of each mark. In other words, it does not play an independent role in this case, either.
  - The above reasoning is further reinforced in those cases where the coinciding element is non-distinctive for some of the goods at issue.
  - Therefore, taking into account and weighing up all the relevant factors of the present case, the Opposition Division concludes that it is unlikely that the relevant public will make a mental connection between the signs in dispute, that is to say, establish a 'link' between them. Therefore, the opposition is not well founded under Article 8(5) CTMR and must be rejected.
  - As set out above by the Opposition Division in its analysis under Article 8(1)(b) CTMR, the remaining earlier marks on which the opposition is based are either identical or less similar to the contested sign, and the goods and services covered by them are the same or within a narrower scope. In view of this, the Opposition Division's conclusion in respect of those marks cannot be different and, accordingly, the opposition Article 8(5) CTMR based on those marks must equally fail.
- 8 On 9 January 2015, the opponents filed an appeal against the contested decision, requesting that the decision be entirely set aside. The appeal was assigned the case No R 87/2015-4. The statement of grounds of the appeal was received on 20 April 2015.
- The opponents filed a notice of appeal against the contested decision, followed by the statement of grounds, requesting to uphold the opposition in its entirety and to reject the mark applied for. The opponents argue that the conflicting signs are visually and aurally similar due to the common verbal element 'PINK' and their common length and structure as word marks composed of two words. The conflicting signs are conceptually similar at least for the English-speaking part of the relevant public since both signs refer to the same colour. A likelihood of confusion exists bearing in mind that the

shared term 'PINK' is highly distinctive whereas the term 'WILD' of the contested mark is very weak, if not totally descriptive, since it will be understood as an indication of the nature and the origin of the goods at issue, in particular fruits and vegetables.

- In addition, the opponents refer to the judgement of the Rechtbank van koophandel te Brussel (Commercial Court of Brussels) of 28 June 2012, A.R. 05361/2010, acting as European Union Trade Mark Court of First Instance. This judgement concerns invalidity proceedings initiated by the opponents based on some of their earlier trade marks against two Benelux trade marks of a third party, namely 'Lady in Rose' and 'English Pink'. The Commercial Court of Brussels declared both trade marks invalid. According to the appellant, this judgment must be respected as *res iudicata* by the offices and the courts within the European Union.
- 9 In its response received on 30 June 2015, the applicant requested that the appeal be dismissed. The applicant endorses the Opposition Division's analysis, requests to dismiss the appeal and to order the appellant to bear the costs.

#### **The decision of the Forth Board of Appeal in case R 87/2015-4**

- 10 By decision of 10 January 2017, the Fourth Board of Appeals dismissed the appeal.
- In the first place, the Board of Appeal stated that it intended to analyse first the similarity of the signs as this was a prerequisite for the application of both the grounds of annulment raised by the applicants, namely breach of Article 8(1)(b) EUTMR and of Article 8(5) EUTMR. In that context, it examined, first, the distinctiveness of the word element 'pink'. It observed that a Community plant variety right had been granted for a variety of apples called 'Cripps Pink', which is characterised by a pinkish red colour covering 40 to 70% of its surface, and that a short visit to any local fruit market is sufficient to show that apples exist in many shades of red, including pink. It inferred from this the word element 'pink' could be understood by the relevant public as a descriptive term indicating the colour of the goods concerned.
  - Second, the Board of Appeal concluded that the marks at issue are visually and phonetically dissimilar on account of the reversed position within the marks of the common word element 'pink' and the fact that that element is descriptive.
  - Third, it took the view that the marks at issue are conceptually dissimilar because the term 'pink lady' will be perceived as referring to a lady dressed in pink or characterised by that colour, whereas the term 'wild pink' will be understood as referring to a shade of pink that is 'somehow wild'.
  - Fourth, with regard to the comparison of the mark applied for with the earlier figurative marks, the Board of Appeal stated that the graphic features, even

though not very distinctive, added to the differences between the marks at issue.

- It concluded that the earlier word and figurative marks are different from the mark applied for and that it was necessary to reject the opposition, regardless of any reputation the earlier marks may enjoy.
  - In the second place, the Board of Appeal stated that the judgment of the Tribunal de commerce de Bruxelles (Commercial Court, Brussels, Belgium) of 28 June 2012 and other decisions relied on by the applicants could not be taken into account because the marks at issue were not the same, the parties were not the same and that it could not follow the approach adopted by the Belgian court as regards the dominant nature of the word element ‘pink’ as that element played only a minor role in the comparison of the signs.
- 11 On 14 March 2015, the opponents lodged an action before the General Court which was assigned the case No T-164/17 and requested that the appeal decision be annulled.
- 12 On 16 May 2017, EUIPO filed a response requesting that the action be dismissed.
- 13 On 19 June 2017, the applicant requested that the action be dismissed.

**Judgment of the General Court T-164/17, WILD PINK / PINK LADY et al.**

- 14 By judgement of 15 October 2018, the General Court (Second Chamber) annulled the decision of the Fourth Board of Appeal of 10 January 2017 in R 87/2015-4. The decision of the Fourth Board was annulled based on the two pleas, infringement of Articles 8(1)(b) and Article 8(5) EUTMR.
- 15 The judgement may be summarised as follows:

*THE THIRD PLEA IN LAW, ALLEGING INFRINGEMENT OF ARTICLE 8(1)(B) EUTMR*

*The relevant public*

- 51 First of all, with regard to the relevant consumer and his level of attention, the Opposition Division was correct to take the view that, bearing in mind the goods in question, the relevant consumer is the public at large and that its level of attention is low.
- 58 In the present case, the word ‘pink’ must be regarded, in the same way as the words ‘blue’ and ‘red’, as part of basic English vocabulary regularly used both in everyday life and in advertising. It is clear that the relevant public throughout the European Union has had extensive and repeated exposure to that word, as attested by the evidence, submitted by the applicant in the proceedings before the bodies of EUIPO.

*The comparison of the signs*

- 65 In the light of the applicants’ arguments, it is necessary, in the first place, to determine the distinctive and dominant elements of the signs at issue, if any.

*The distinctive and dominant elements*

- First of all, the Board of Appeal was entitled to take the view that the word element ‘pink’ is descriptive, as it indicates a specific quality of the goods in question, namely their colour (68-69). In that regard, it is necessary to reject the applicants’ argument that, as the marks at issue are registered for fruits in general, an assessment confined to apples is insufficient for all fruits as they are not interlinked in a sufficiently direct and specific way as to form a category. As EUIPO observed, the broad specification ‘fruits’ includes apples and other fruits which may be pink in colour, such as raspberries, strawberries, cherries and pomegranates. It follows that the word ‘pink’ must be regarded as descriptive of the goods for the whole of the specification. (70).
- When comparing the signs in question, account must be taken of the fact that the word element ‘pink’ does not play a negligible role in the marks at issue and cannot therefore be disregarded. (71-74).

*The visual, phonetic and conceptual comparison*

- The Board of Appeal was incorrect to take the view that the signs at issue are visually, phonetically and conceptually dissimilar. On the basis of that incorrect assessment, it considered that it was entitled to conclude that the signs at issue were dissimilar overall, without carrying out any global assessment of the likelihood of confusion. In so doing, it infringed Article 8(1)(b) EUTMR.
- The signs at issue each have only two word elements. The different word element in the signs is relatively short, namely four letters for ‘wild’ and for ‘lady’. The word ‘pink’, present in each of the signs, also has four letters.
- Visually, the signs are the same in so far as they both contain the word ‘pink’. The signs have, at least, a low degree of visual similarity.
- The signs at issue have, at the very least, a weak degree of phonetic similarity.
- The signs at issue must be regarded as having a low degree of conceptual similarity. It should be noted that, according to case-law, conceptual similarity arises from the fact that two marks use images with analogous semantic content.
- The English-speaking public of the European Union will perceive the presence of the word ‘pink’ in both the signs as denoting the colour ‘pink’. It will understand the expression ‘pink lady’ as referring to the concept of a

‘lady in pink’ and the expression ‘wild pink’ as referring to a colour, namely a kind of pink to be found in the wild. (85).

- As regards the non-English-speaking public of the European Union, it will understand the meaning of the word ‘lady’. Although English in origin, that word can be found in most dictionaries in the official languages of the European Union and it may therefore be assumed that it is known by the public in the territory in which those languages are spoken. With regard to the territories in which the word does not appear in the dictionaries of the languages spoken there, it is clear that its meaning is well known because it is a common word in English and is very widely used both in most languages of the European Union and in the media. The applicants have not shown that the Board of Appeal made an error of assessment when it stated that that fact is well known. On the other hand, it follows from the judgment of 7 March 2013, *FairWild Foundation v OHIM — Wild (FAIRWILD)* (T-247/11, not published, EU:T:2013:112, paragraph 39), that the word ‘wild’ is not regarded, a priori, as an English word known by the relevant public throughout the European Union and the intervener has failed to produce any evidence to the contrary. The relevant non-English-speaking public will thus be confronted, as regards the earlier sign, with the concept of a lady dressed in pink, or otherwise characterised by that colour, and, as regards the sign applied for, by the adjective ‘pink’, if it does not understand the word ‘wild’ (86-87).
- It is clear that both the relevant English-speaking and non-English-speaking public will perceive the presence of the word ‘pink’ in both signs as denoting the colour pink. As both signs refer to the colour pink, it cannot be ruled out that there may be said to be a degree of conceptual similarity (88).#
- With regard to the applicants’ argument that the presence of the pink square which dominates EU marks No 6 335 591 and No 8 613 991 suggests that the signs at issue are conceptually similar to an average degree, that argument must be rejected. The presence of that square does not convey any meaning other than the colour pink and cannot therefore affect the conclusions in paragraph 88 and 89 above that the signs at issue are conceptually similar to a low degree only (90).

*THE FOURTH PLEA IN LAW, ALLEGING INFRINGEMENT OF ARTICLE 8(5) EUTMR*

- As the signs cannot be considered dissimilar, the Board of Appeal erred in finding that Article 8(5) EUTMR was not applicable without carrying out an overall assessment of the marks at issue in order to determine whether, as the case may be, a low degree of similarity between the signs may nonetheless be sufficient, on account of the presence of other relevant factors, such as the renown or reputation enjoyed by the earlier mark, for the relevant public to make a link between the marks.

- 16 On 11 February 2019, the opponents filed the renewal certificates of the Benelux and German trade marks as well as of the EUTMs No 4 186 169 and No 6 335 591.

**Proceedings before the Board of appeal after remittal of the General Court**

- 17 On 11 February 2019, the Office informed the parties that the case was reallocated to the First Board of Appeals.
- 18 On 18 March 2019, the opponents filed unsolicited observations and requested that the registrability of the trade mark applied for be re-examined on absolute grounds (Article 7(1)(c) EUTMR) pursuant to Article 45 and Article 72(6) EUTMR and the present proceedings be suspended. It argued in particular as follows:
- The General Court found that the WILD PINK mark as a whole is understood by the English-speaking public as the mere description of the quality or a colour (a characteristic) of fruits for which registration is sought. The General Court found that the English-speaking public of the European Union “will understand [...] the expression ‘wild pink’ as referring to a colour, namely a kind of pink to be found in the wild” (para. 85 of the judgment). As the EUTM application WILD PINK indicates a specific quality of fruits, namely their colour (see also para. 70 of the General Court’s judgment: “the word ‘pink’ must be regarded as descriptive of the goods for the whole of the [broad] specification [‘fruits’]”). The sign ‘WILD PINK’ consists entirely of elements which are descriptive for fruits. The combination of these descriptive elements is made according to the grammatical rules of the English language and is not more than the correct juxtaposition of its parts.
  - The opponents also submitted its observations on the relative grounds of refusal of Article 8(1)(b) CTMR and Article 8(5) CTMR and filed additional evidence concerning the enhanced distinctiveness and the reputation of the earlier marks.

*Communication of the Rapporteur of 29 October 2019*

- 19 On 30 October 2019, the parties were invited to comment on the consequences following the judgement of 15/10/2018, T-164/17, WILD PINK / PINK LADY et al., EU:T:2018:678, that may include the remittal of the case to an examiner for absolute grounds of refusal and a decision on or remittal for a decision on relative grounds for refusal. The opponents were requested to suggest in which part of the European Union they consider that likelihood of confusion and the enhanced protection under Article 8(5) EUTMR is most evident. The parties were also invited to comment whether the judgment in the case 18/06/2019, T-569/18, Kordes’ Rose Monique, ECLI:EU:T:2019:421 could have an impact on the assessment of the case at hand, as there are many varieties that include ‘PINK’, including the ‘Crispp Pink’ variety.
- 20 On 3 February 2020, the opponents replied to the communication stating, in brief:



*Absolute grounds of refusal – descriptive character of wild pink*

- The Board should remit the case to the Examiner based on Articles 45(3) EUTMR and 30(2) EUTMDR, to analyse whether the trade mark applied for should be rejected on the basis of absolute grounds for refusal (Article 7(1)(c) EUTMR).
- Taken as a whole, the WILD PINK application is understood by the English-speaking public as the description of the colour of the goods, 'a kind of pink to be found in the wild' (15/10/2018, T-164/17, WILD PINK / PINK LADY et al., EU:T:2018:678, § 85). It is thus descriptive for 'wild' fruits and vegetables to be found in the wild.
- The word WILD is descriptive not only for the English-speaking public (UK, Ireland, Malta and all EU countries where it is a well-known fact that English is very well understood) but also for a substantial portion of the EU public which does not speak English. The word WILD in many other languages spoken in the EU (Dutch, German and Danish) is the same as the English language word or practically the same (Swedish: 'VILD', Luxembourgish 'WËLL'. In Austria, Belgium, Denmark, Germany, Ireland, Luxembourg, Malta, the Netherlands, Sweden and the UK). The term 'WILD' will be understood to have the same meaning in relation to the goods at issue i.e. fruits and vegetables grown in the wild.
- The descriptive character of the word 'WILD' for goods in Class 31 is confirmed by many previous decisions of the Office.
- Opposition Division's decision B 2 238 247 rejected the WILD PINK application for fruit products in class 29. It found that the WILD CRISP and WILD PINK word marks were conceptually similar due to the common element WILD which is understood by the English-speaking public and the German-speaking public.

*Relative grounds for refusal – Parts of the EU where likelihoods of confusion and enhances protection under Article 8(5) EUTMR are the most obvious*

- The opponents also made extensive submissions concerning the relative grounds for refusal and the parts of the EU where likelihoods of confusion and enhances protection under Article 8(5) EUTMR are the most obvious and filed additional evidence in this respect.

*Comments on the Kordes' Rose Monique case*

- The judgment of the General Court 18/06/2019, T-569/18, Kordes' Rose Monique, ECLI:EU:T:2019:421 on plant variety names has no impact on the present case regarding the variety 'CRIPPS PINK'. The new Regulation with Article 7(1)(m) EUTMR entered into force on 23 March 2016 and is not applicable to marks registered before that date. The opposition proceedings started in July 2013 and all the opposition basis marks were registered before that date. Moreover, 'Pink Lady' is not a plant variety denomination.

- As regards the application of Article 7(1)(m) EUTMR on WILD PINK which is not yet registered, opponents leave it up to the Board to remit the case to the Examiner in order to reopen the examination on that legal basis (Article 45(3) EUTMR). However, in the present case, the opposed sign WILD PINK does not include a variety name. ‘PINK’ as such is not a plant variety denomination. ‘WILD PINK’ is not a plant variety denomination either. The fact that a portion of a variety name, the word PINK, is found in the CRIPPS PINK variety denomination is not sufficient to apply the ground for refusal set out in Article 7(1)(m) EUTMR.

21 On 4 February 2020, the applicant replied to the communication stating, in brief:

*On the absolute grounds of refusal pursuant to Article 7(1)(c) EUTMR*

- The element ‘WILD’ within the trade mark applied for has distinctive character. In decision B 2 238 247 the Opposition Division held that the trademark ‘WILD PINK’ coincided with the earlier ‘WILD CRISP’ ‘in their first element WILD which is distinctive’.
- The word element ‘WILD’ within the trademark applied for does not convey any obvious information regarding the texture and natural growing conditions of the contested goods. Unlike the expression ‘Wild Fruit’, the verbal element ‘WILD’ within the sign applied for is not making any direct reference to fruits, neither ‘Crab’ nor ‘Wild’ apples, therefore adding distinctive character to the ‘PINK’ component.
- The word ‘WILD’ has no immediately clear meaning in relation to branded apples of the variety ‘CRIPPS PINK’, nor any obvious laudatory connotation in respect of the goods.
- The definition of ‘Wild’ in the Oxford Dictionary refers to plants ‘not kept in a house or on a farm’ ([https://www.oxfordlearnersdictionaries.com/definition/english/wild\\_1](https://www.oxfordlearnersdictionaries.com/definition/english/wild_1)). The applicant is however one of the most reputed traders both in US and internationally for fruit varieties obtained through substantial, long-standing investments carried out in the context of consistent breeding programs managed by University Research Institutions (e.g. the Washington State University and the Oregon State University) as well as other top-level breeders worldwide. Any stage of the pre-base multiplication, planting, harvesting and commercialization of the fruit varieties controlled by the applicant responds to carefully drafted licenses, aimed at assuring the most strict and precise growing and/or cultivation protocols in licensed farms, from planting to sales in retail stores.
- Contrary to the Opponents’ alleged decision (13/04/2012, B 1 829 525, BERTOLINI WILD), while plants can be ‘wild’ in principle, the fruit plants which the contested goods stem from are surely cultivated by mean of the most innovative breeding techniques, in order to comply with high quality set standard to break into the relevant market. In this sense, an apple product which is ‘to be grown in the wild’ or ‘uncultivated’ is not something which

would be considered as attractive for the target consumers involved in the present dispute.

- In decision R 2621/2017-2 (WILD CRISP), § 37, the Board of Appeal considered the element ‘WILD’ distinctive for goods in Class 30.
- The element ‘WILD’ is distinctive also in view of its secondary meaning. The word ‘WILD’ is used within the sign applied for as an adjective, depicting a colour of the contested goods which can be somehow ‘mad’ or even ‘exciting’.
- The word ‘WILD’ is placed at the beginning of the sign is likely to have a greater impact than the rest of the sign.
- Consumers in non-English speaking countries will perceive the word ‘WILD’ as a foreign term endowed with average distinctive character. A quick availability search on ‘TM View’, shows around 308 trade marks for goods and services in classes 29, 30 and 31 including the word ‘WILD’ (Annex 24), in spite of 281 trademarks including ‘LADY’. The gap referred to above is even broader in case of worldwide registrations: 632 are the registered signs including the word ‘WILD’ compared to only 339 registered trademarks including the word ‘LADY’.
- The extensive use in commerce of the word element ‘WILD’ for trademark registration purposes and repeated exposure to that word is proof of the fact that the element ‘WILD’ holds a certain degree of distinctiveness, leading to the legitimate expectation that it will dominate, by itself, the relevant public’s recollection of the trademark applied for.
- ‘WILD PINK’ is not a combination of descriptive elements in respect of the contested goods in classes 29, 30 and 31. The expression ‘WILD PINK’ cannot be deemed as a simple enumeration of adjectives but rather bears an independent distinctive character given that, depending on their position, both terms ‘WILD’ and ‘PINK’ are likely to give rise to completely different meanings in relation to the sign applied for, which is capable to offset the descriptive character of ‘PINK’.
- The sign applied for is conceived to be exclusively used in conjunction with a particular plant variety that is characterized by a ‘pinkish-red colour’; it goes without saying, that the element ‘PINK’ will be deprived of any distinctive value within ‘WILD PINK’.
- The General Court has never questioned the validity of ‘WILD PINK’ for the purposes of registration, referring the case back to the BoA for a global assessment of the similarity between the trademarks to be carried out within the meaning of Article 8(1)(b) and Article 8(5) EUTMR.

*On the relative grounds for refusal pursuant to article 8(1)(b) and Article 8(5) EUTMR*

- The applicant submitted its observation also on the relative grounds for refusal pursuant to Articles 8(1)(b) and Article 8(5) CTMR and referred to additional evidence.

*Comments on the Kordes' Rose Monique case*

- The Judgement 'Kordes' Rose Monique' is of paramount importance in relation to the assessment of the present case, as it defines the relevant factors to be taken into account when comparing trademarks for goods and services in class 31 of the Nice classification.
- 22 On 28 April 2020, the opponents filed an unsolicited communication and reiterated its request that the registrability of the trade mark applied for be re-examined on absolute grounds (Article 7(1)(c) EUTMR) pursuant to Article 45 and Article 72(6) EUTMR and the present proceedings be suspended.
  - 23 On 27 May 2020, the applicant filed observations on the opponents unsolicited communication containing the request to re-examined the trade mark applied for on absolute grounds (Article 7(1)(c) EUTMR).
  - 24 On 21 October 2021, the opponents filed its request to re-examine the trade mark applied for on absolute grounds (Article 7(1)(c) EUTMR) according to Article 45 EUTMR by document separate.
  - 25 On 29 November 2021, the applicant filed a limitation request. As the limitation expanded the list of goods this request was not acceptable and rejected by decision of 21 December 2021.
  - 26 On 9 December 2021, the applicant filed observations on the opponents' request of re-examination for absolute ground of 21 October 2021.
  - 27 On 3 January 2022, the case was reallocated from the First Board of Appeal to the Fifth Board of Appeal under the number R 339/2019-5 pursuant to Article 1 Decision 2021-17 of 02/12/2021 of the Presidium of the Boards of Appeal on the organisation of the Boards.
  - 28 On 20 January 2022, the opponents filed observations on the applicant's observations of 9 December 2021 on the request to re-examination for absolute ground and declared to maintain their request for the case to be referred to the examiner, on the basis of Article 45 EUTMR.
  - 29 On 1 April 2021, the applicant re-filed a limitation request that was amended on 11 April 2022. This limitation request has been accepted on 30 May 2022 and the amended list of goods reads as follows:

Class 29: *Preserved, frozen, dried and cooked vegetables.*

Class 30: *Fruit flavourings, other than essences, ~~Fruit vinegar; Pierozki containing mince.~~*

Class 31: *~~Mixed fruits [fresh; Fruit, fresh, namely apples belonging to the species 'Malus domestica Borkh' Fresh fruits and vegetables; Raw fruits; Mandarins (fresh fruit).~~*

- 30 On 22 June 2022, the opponents confirmed that it maintained the opposition in its entirety. The opponents requested an oral hearing due to the complexity of the case, including the consequences of the judgment of the General Court, and its long history.
- 31 On 9 August 2022, the applicant filed further comments (amended on 6 October 2022 by a missing annex that erroneously was not uploaded with the observations).

### **Reasons**

- 32 All references made in this decision should be seen as references to the EUTMR (EU) No 2017/1001 (OJ 2017 L 154, p. 1), codifying Regulation (EC) No 207/2009 as amended, unless specifically stated otherwise in this decision.
- 33 As a preliminary point, it should be noted that given the date on which the application for registration of the mark applied for was filed, namely 29 March 2013, which is decisive for the purpose of identifying the applicable substantive law, the facts of the case are governed by the substantive provisions of Regulation No 207/2009 (CTMR) (08/05/2014, C-591/12 P, Bimbo Doughnuts, EU:C:2014:305, § 12 ; 18/06/2020, C-702/18 P, PRIMART Marek Łukasiewicz (fig.) / PRIMA et al., EU:C:2020:489, § 2). According to settled case-law, procedural rules are generally held to apply on the date on which they enter into force (see (11/12/2012, C- 610/10, Commission / Spain, EU:C:2012:781, § 45).

### *Measures arising from the judgment*

- 34 In accordance with Article 72(6) EUTMR, the Office shall take the necessary measures to comply with the judgment of the General Court 15/10/2018, T-164/17, WILD PINK / PINK LADY et al., EU:T:2018:67805/10/2020, which annulled the decision of the Fourth Board of Appeal (10/01/2017, R 87/2015-4, Wild Pink / Pink Lady et al.).
- 35 Pursuant to Article 35 EUTMDR, where a decision of a Board of Appeal on a case has been annulled or altered by a final ruling of the General Court or, as the case may be, of the Court of Justice, the President of the Boards of Appeal shall, with a view to complying with that ruling in accordance with Article 72(6) EUTMR, reallocate the case to a Board of Appeal.
- 36 According to settled case-law, in order to comply with its obligation under Article 72(6) EUTMR, the Office must ensure that the appeal leads to a new decision of a Board of Appeal.

- 37 A judgment annulling a measure takes effect *ex tunc* and thus has the effect of retroactively eliminating the annulled measure from the legal system. *Res judicata extends* only to the matters of fact and law actually or necessarily settled by the judicial decision in question. Thus, in order to comply with a judgment annulling a measure and to implement it fully, the institution responsible for adopting that measure is required to have regard not only to the operative part of the judgment but also to the grounds constituting its essential basis. It is those grounds which, on the one hand, identify the precise provision held to be illegal and, on the other, indicate the specific reasons which underlie the finding of illegality contained in the operative part and which the institution concerned must take into account when replacing the annulled measure (01/09/2021, T-96/20, Limbic® Types, EU:T:2021:527, § 28, 43-44; 25/03/2009, T-402/07, Arcol II, EU:T:2009:85, § 21-23; 04/03/2010, C-193/09 P, Arcol II, EU:C:2010:121, § 55 et seq.; 13/04/2011, T-262/09, First Defense Aerosol Pepper Projector, EU:T:2011:171, § 41-42)
- 38 Where a decision of a Board of Appeal is annulled by the General Court, for the same reasons that likewise apply to the contested decision of the Opposition Decision in first instance, the Board of Appeal, now competent, may apply the same reasoning as the General Court (see in this sense 30/11/2022, R 644/2020-5, Loop, § 18-23).
- 39 This does not mean that the Office, whether an examiner or the Opposition Division or the Board of Appeal, may not subsequently reach a different conclusion on the basis of other facts and evidence which introduce new essential aspects. The General Court has in substance adjudicated on the case, as explained and detailed above, by finding that the Board of Appeal infringed Article 8(1)(b) CTMR by taking the view that the marks at issue are visually, phonetically and conceptually dissimilar, by basing its conclusion that those marks are different overall on that incorrect premiss, and by failing, therefore, to take account of the fact that the signs at issue have, at the very least, a low degree of visual, phonetic and conceptual similarity.
- 40 Therefore, the Board of Appeal erred also in finding that Article 8(5) CTMR was not applicable without carrying out an overall assessment of the marks at issue in order to determine whether, as the case may be, a low degree of similarity between the signs may nonetheless be sufficient, on account of the presence of other relevant factors, such as the renown or reputation enjoyed by the earlier mark, for the relevant public to make a link between the marks.
- 41 The contested decision of the Opposition Division also rejected the opposition in its entirety on the grounds that the signs are dissimilar and hence neither a likelihood of confusion in the meaning of Article 8(1)(b) CTMR exists nor is there any link between the signs which could lead to an unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade marks in the meaning of Article 8(5) CTMR. For reasons of procedural economy, the evidence filed by the opponent to prove that the earlier mark has been extensively used and enjoys an enhanced scope of protection was not assessed within the analysis of Article 8(1)(b) CTMR neither the conditions of Article 8(5) CTMR.

*Remittal to the Opposition Division for further prosecution*

- 42 Pursuant to Article 71(1) EUTMR, the Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.
- 43 The discretion under Article 71(1) EUTMR must be exercised on a case-by-case basis and is not subject of a general rule (15/03/2021, R 1123/2018-1, Jules Gents (fig.)/ Joules et al., § 156-160).
- 44 Recital 30 EUTMR highlights that the appeal proceedings should ensure that parties who are affected by decisions made by the Office are protected by the law in a manner which is suited to the special character of trade mark law.
- 45 Trade mark law has the particularity that it is often a complex mixture of the factual and legal assessment of a number of earlier rights.
- 46 Moreover, Recital 8 EUTMDR stresses that it should allow for an effective, efficient and, within the scope of the appeal defined by the parties, complete review of decisions taken by the Office in the first instance by means of a transparent, thorough, fair and impartial appeal procedure suited to the specific nature of intellectual property law.
- 47 If the Regulation foresaw that an EUIPO Board of Appeal should only decide on the appeal as a review body, that means following a first-instance decision on that topic, proceedings could frequently turn into endless ping-pong situations. It would not be an efficient way to deal with the proceedings, as it would oblige the Boards to take decisions on points that are not decisive for the result.
- 48 One of the most important criteria that may affect a decision on the appeal to rather remit the case to the first instance is the complete assessment of the facts. This may aid marks whose use could later successfully be challenged by means of annulment or infringement proceedings are not registered. Reasons of legal certainty and sound administration speak in favour of that approach (06/05/2003, C-104/01, Libertel, EU:C:2003:244, § 59; 13/03/2007, C-29/05 P, ARCOL / CAPOL, EU:C:2007:162, § 48).
- 49 It is particularly appropriate to remit a case to the first instance if the remaining issues have not yet been dealt with properly by the Office, and may involve the examination of facts, evidence and arguments for the first time.
- 50 This results from the institutional framework. The parties before the General Court may not change the subject matter of the proceedings before the Boards of Appeal and therefore, the General Court is only called upon to assess the legality of the decisions of the Boards of Appeal by reviewing the application of the law made by that Board of Appeal, in light of facts which were submitted in both instances (18/07/2006, C-214/05 P, Sissi Rossi, EU:C:2006:494, § 50). By contrast, the General Court cannot carry out such a review by considering matters of fact newly produced before it.

- 51 If the Boards of Appeal were to decide on facts and legal issues that had not yet been examined by the first instance, it would deprive the parties of one instance, in particular to bring forward supplementary facts, evidence or arguments.
- 52 On the other hand, Article 71(1) EUTMR also allows the Boards to decide within the competencies of the first instance. The main ground for a Board of Appeal to take a decision itself is the economy of proceedings. It is consistent with the principle of sound administration and the need to ensure the proper conduct and effectiveness of proceedings that not all cases are remitted to the first instance.
- 53 Furthermore, the legislator seems to have recently stressed the importance of the Board of Appeal's review function. On the one hand, it has clarified that specific claims cannot be examined for the first time by the Board of Appeal (Article 27(3) EUTMDR) and confirmed that facts and evidence submitted for the first time at appeal stage must, in principle, relate to submissions already made before, and to findings already made by, the first instance body whose decision is under appeal (Article 27(4)(b) EUTMR). On the other hand, it appears that the effective exercise, by the Board of Appeal, of its review function has been the legislator's main justification for drastically restricting the possibility to file further appeals against decisions of the General Court taken in respect of decisions of the Board of Appeal (Recital 4 of Regulation 2019/629 of 17 April 2019 amending Protocol No 3 on the Statute of the Court of Justice of the European Union (OJ L 111, 25.4.2019, p. 1-3) which makes reference to the fact that 'cases' decided by the first instance decision-making instances (*inter alia*) of the EUIPO 'have already been *considered twice*, initially by an independent board of appeal, then by the General Court', emphasis added).
- 54 In the light of above-mentioned criteria and given that the contested decision, that was confirmed under appeal following the same reasoning, did not examine the enhanced scope of protection of the earlier rights and rejected the existence of a likelihood of confusion according to Article 8(1)(b) CTMR based on the incorrect conclusion of dissimilarity of the signs without carrying out a global assessment of likelihood of confusion and did not examine if the conditions of Article 8(5) CTMR were met, the Board decides to remit the case to the Opposition Division.
- 55 It is not appropriate for the Board of Appeal in this case to undertake an extended examination as first instance. This would deprive the parties of a reviewing authority.
- 56 Remittal of the examination of Article 8(1)(b) CTMR and Article 8(5) CTMR affords the parties the opportunity to have two levels of review within the EUIPO and is therefore appropriate in this case.
- 57 The only possible detrimental effect of the Board of Appeal's decision to remit the case back to the first instance is the non-observance of the principle of procedural economy. If the Board of Appeal decides to remit to the first instance, the proceedings will be prolonged, the parties will have a final decision on their dispute later, the contested mark will be registered (if applicable) at a later point in time, etc. All these consequences of a remittal to the first instance may be perceived as detrimental by one or both parties.



- 58 However, the Board of Appeal's decision to decide itself for the first time on the pending issues which had not yet been assessed by the Opposition Division may satisfy the parties' wish for expedient proceedings and a quick decision on the case, but it may have more serious consequences resulting in the fact that the parties were deprived of one decision taking instance before the EUIPO and in some cases of the possibility to fully develop their case with arguments and evidence both before the first instance and before the Board of Appeal in regard of issues not related to those already dealt with by the first instance. Findings made for the first time by the Board of Appeal can only be reviewed by the General Court upon an action for annulment, in which the limitations stemming from Article 72(1) and(3) EUTMR and Article 188 of the Rules of Procedure of the General Court apply and which, in turn, impacts on the principle of procedural economy (18/12/2008, C- 16/06 P, Mobilix, EU:C:2008:739 , § 119-121 and in particular § 136-139).
- 59 It should be further noted that in the current appeal proceedings, the applicant and the opponents have submitted new evidence, i.e., evidence not presented in the proceedings before the Opposition Division and submitted for the first time before the Board. According to Article 27(4) EUTMDR and Article 95(2) EUTMR, the Board of Appeal may accept facts or evidence submitted for the first time before it if they are, on the face of it, likely to be relevant for the outcome of the case; and where they are merely supplementing relevant facts and evidence which had already been submitted in due time or examined by the first instance, or are filed to contest findings made or examined by the first instance of its own motion in the decision subject to appeal. In the present case, the additional evidence merely supplements the applicant's and opponent's arguments. Therefore, the Board views the evidence as admissible.
- 60 In light of the above, considering the parties' legitimate interest that the case be examined by both instances of the EUIPO, the case is remitted to the Opposition Division for further prosecution pursuant to Article 71, second sentence, EUTMR, in order for it to carry out a fully comprehensive and in-depth assessment of the opposition grounds invoked and taking into account the findings of the General Court in judgment of 15/10/2018, T-164/17, WILD PINK / PINK LADY et al., EU:T:2018:678 which is binding upon the Opposition Division and the evidence filed by the applicant and the opponents in the opposition and appeal proceeding.
- 61 It follows that the appeal is granted, and the contested decision is annulled in its entirety.

*Consideration of reopening of the examination of absolute grounds of refusal*

- 62 The Opposition Division may also remit the case for examination of absolute grounds for refusal.
- 63 According to established case-law of the Court of Justice, there is an interest in examination regarding absolute grounds for refusal having to be stringent and full, in order to prevent trade marks from being improperly registered and, for reasons of legal certainty and good administration, to ensure that trade marks whose use could successfully be challenged before the courts are not registered (06/05/2003,

C-104/01, Libertel, EU:C:2003:244, § 59; 21/10/2004, C-64/02 P, Das Prinzip der Bequemlichkeit, EU:C:2004:645, § 45).

- 64 Trade marks applied for must be refused pursuant to Article 7 EUTMR to the extent that there are absolute grounds for refusal. In this respect, there is a public interest and therefore the Office must investigate the relevant facts and evidence *ex officio* pursuant to Article 42(1) EUTMR and Article 95(1) EUTMR. In doing so, the examination must be thorough in order to prevent trade marks which are contrary to public interests from being registered.
- 65 As it is inferred from Article 161 in conjunction with Article 47 EUTMR, and Article 71(1) EUTMR, the Opposition Division and the Boards of Appeal do not have the competence to examine absolute grounds for refusal during opposition proceedings (18/02/2004, T-10/03, Conforflex, EU:T:2004:46, § 55, 57; 30/06/2004, T-186/02, Dieselit, EU:T:2004:197, § 71).
- 66 Such examination may be initiated at any time before registration, as expressly foreseen by Article 45 EUTMR and Article 30(2) EUTMDR.
- 67 According to Article 45 EUTMR anybody can submit third-party observations; even the opponent is entitled to do so explaining on which grounds, under Articles 5 and 7, the trade mark should not be registered *ex officio*.
- 68 The opponent repeatedly submitted that the registrability of the trade mark applied for be re-examined on absolute grounds (Article 7(1)(c) CTMR) pursuant to Article 45 and Article 72(6) EUTMR on 18 March 2019, on 3 February 2020 and on 28 April 2020. On 21 October 2021 the opponent reiterated its request according to Article 45 EUTMR to re-examine the trade mark applied for on absolute grounds (Article 7(1)(c) CTMR) by separate document complying with the formal requirements as laid down in Communication No 2/09 of the President of the Office of 9 November 2009.
- 69 The General Court stated, albeit in the context of relative grounds for refusals, that [...] ‘the broad specification ‘fruits’ includes apples and other fruits which may be pink in colour, such as raspberries, strawberries, cherries and pomegranates. It follows that the word ‘pink’ must be regarded as descriptive of the goods for the whole of the specification’ (15/10/2018, T-164/17, WILD PINK / PINK LADY et al., EU:T:2018:678 T-164/17, § 70).
- 70 The General Court further stated [...] ‘that the English-speaking public of the European Union will perceive the presence of the word ‘pink’ in both the signs as denoting the colour ‘pink’. It will understand the expression ‘pink lady’ as referring to the concept of a ‘lady in pink’ and the expression ‘wild pink’ as referring to a colour, namely a kind of pink to be found in the wild’ (15/10/2018, T-164/17, WILD PINK / PINK LADY et al., EU:T:2018:678 T-164/17, § 85).
- 71 In the light of the judgment and following the applicant’s limitation of the list of goods applied for, as accepted on 30 May 2022, to the examiner may consider whether the sign applied for ‘WILD PINK’ must be objected under Article 7(1) CTMR, as indicating the name of a colour that might constitute an objective characteristic, inherent to the nature of that products and intrinsic and permanent

with regard to the designated products (07/05/2019, T- 423/18, *vita*, EU:T:2019:291, § 44).

- 72 It cannot be ruled out *a priori* that the colour of a product may be one of the characteristics referred to in Article 7(1)(c) EUTMR (14/09/2022, T-498/21, *Black Irish*, EU:T:2022:543, § 43; 25/06/2020, T-133/19, *Off-White* (fig.), EU:T:2020:293, § 37, 43). For the ground of refusal to apply, a direct and specific link is necessary in the mind of the relevant public, not just an indirect association (07/05/2019, T- 423/18, *vita*, EU:T:2019:291, § 52). The assessment of whether the colour of a product is a characteristic of that product will depend on the circumstances of the case, namely the colour described by the sign at issue, the nature of the goods at issue, and the specific manner in which reference is made to the colour in question (14/09/2022, T-498/21, *Black Irish*, EU:T:2022:543, § 44). Therefore, the crucial question is whether the term ‘Wild pink’ – as colour indication – could reasonably be perceived in the context of the relevant goods as a significant characteristic, which is likely to be important in the choices of the consumers.

#### *Request for an oral hearing*

- 73 Article 96 EUTMR leaves it to the discretion of the Office to decide on the necessity of an oral hearing. Further, it is to be recalled that oral proceedings shall be appropriate particularly when the Office considers it necessary to hear oral evidence from the parties, witnesses or experts (20/02/2013, T-378/11, *Medinet*, EU:T:2013:83, § 72 and the caselaw cited therein; 16/07/2014, T-66/13, *Flasche*, EU:T:2014:681, § 88). As the Board does not undertake an examination as to the substance, it is not appropriate to have an oral hearing.

#### **Costs**

- 74 The General Court explicitly ordered the applicant to bear its own costs and to pay half the costs incurred by the opponent, including half the costs necessarily incurred by them for the purposes of the proceedings before the Board of Appeal of EUIPO.
- 75 The costs of the opposition proceedings shall be fixed by the competent service in its decision on the merits.

**Order**

On those grounds,

THE BOARD

hereby:

- 1. Annuls the decision;**
- 2. Remits the case to the Opposition Division for further prosecution;**
- 3. Asks the first instance to consider whether to reopen the examination of absolute grounds for refusal.**

Signed

V. Melgar

Signed

P. Von Kapff

Signed

A. Pohlmann

Registrar:

Signed

H. Dijkema

