

## CANCELLATION No C 58 927 (INVALIDITY)

**Hellenic Republic, as duly represented by the Minister of Development and Investments**, Nikis 5-7, 10180 Athens, Greece (applicant), represented by **Venieris-Alexandropoulou Law Firm**, 58 Patriarchou Ioakeim Street, 10676 Athens, Greece (professional representative); **Law Offices of Patrinos & Kilimiris**, Hatziyianni Mexi Street 7, 115 28 Athens, Greece (professional representative)

a g a i n s t

**Türkiye Turizm Tanitim ve Gelistirme Ajansi**, Esentepe Mahallesi, Büyükdere Caddesi, No:127, Astoria Kuleleri, B Blok Kat: 4, Sisli, Istanbul, Turkey (EUTM proprietor), represented by **Pons IP, S.A.**, Glorieta Rubén Darío, 4, 28010 Madrid, Spain (professional representative).

On 10/01/2025, the Cancellation Division takes the following

### DECISION

1. The application for a declaration of invalidity is upheld.
2. European Union trade mark No 18 514 376 is declared invalid in its entirety.
3. The EUTM proprietor bears the costs, fixed at EUR 1 080.

### REASONS

On 16/02/2023, the applicant filed a request for a declaration of invalidity against European

**TURKAEGEAN** 

Union trade mark No 18 514 376 (figurative mark) (the EUTM), filed on 16/07/2021 and registered on 15/12/2021. The request is directed against all the services covered by the EUTM, namely:

- Class 35: *Advertising, marketing and public relations; organization of exhibitions and trade fairs for commercial or advertising purposes; development of advertising concepts; provision of an online marketplace for buyers and sellers of goods and services; office functions; secretarial services; arranging newspaper subscriptions for others; compilation of statistics; rental of office machines; systemization of information into computer databases; telephone answering for unavailable subscribers; business management, business administration and business consultancy; accounting; commercial consultancy services; personnel recruitment, personnel placement, employment agencies, import-export agencies; temporary personnel placement services; auctioneering.*
- Class 38: *Radio and television broadcasting services; telecommunication services; providing access to the internet; news agencies.*

- Class 39: *Land, water and air transport services; rental of land, water or air vehicles; arranging of travel tours; travel reservation; issuing of tickets for travel; courier services (messages or merchandise); car parking; garage rental; boat storage; transport by pipeline; electricity distribution; water supplying; rescue operations for vehicles and goods; storage, wrapping and packaging of goods; transport and storage of trash; transport and storage of waste.*
- Class 41: *Education and training; arranging and conducting of conferences, congresses and seminars; sporting and cultural activities; entertainment; ticket reservation and booking services for entertainment, sporting and cultural events, including ticket reservation and booking services for theatres, cinemas, museums and concerts; publication and editing of printed matter, including magazines, books, newspapers, other than publicity texts; electronic publication services; production of movie films, radio and television programmes; news reporters services; photographic reporting services; photography; translation.*
- Class 43: *Services for providing food and drink; temporary accommodation; reservation of temporary accommodation, rental of banquet and social function facilities for special occasions, namely, wedding receptions, conferences and meetings; day-nurseries (crèches); boarding for animals.*
- Class 45: *Legal services, consultancy in the fields of intellectual and industrial property rights; security services for the protection of individuals and property; marriage agencies; funeral services; clothing rental; fire-fighting services; escorting in society (chaperoning); consultancy relating to workplace safety; on-line social networking services.*

The applicant invoked Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b), (c) and (f) EUTMR as well as Article 59(1)(b) EUTMR.

### **CONFIDENTIALITY REQUEST**

The applicant requests the information and evidence provided be treated as confidential towards third parties. The request was considered justified by the Office, and the documents submitted were marked as confidential in the electronic file.

Pursuant to Article 113(1) EUTMR, the Office must publish its decisions. On the other hand, according to Article 114(4) EUTMR, upon the prior request of a party with a special interest in keeping parts of the file confidential, the data concerned must be kept confidential vis-à-vis the public.

However, the justified interest of a party in keeping information confidential does not exempt the Office from the obligation to state the reasons for its decisions. Therefore, the Cancellation Division will describe this information in a merely general manner without disclosing specific data.

Finally, it has to be clarified that, notwithstanding the confidentiality of a submission or annex, data contained therein that is clearly within the public domain can be referred to in the decision.

## SUMMARY OF THE PARTIES' ARGUMENTS

The **applicant** submits that the mark is descriptive and lacks distinctiveness and that the relevant public consists of the English-speaking average consumer with a relatively low level of attention.

The word element of the contested sign comprises two elements: 'TURK' (an abbreviation for 'Turkey', 'Turkish', or the native, inhabitant or citizen of Turkey) and 'AEGEAN', which denotes 'anything of or relating to the Aegean Sea or the Aegean Islands' (a reference either to the Turkish coastline across the Aegean or the Greek islands within the Aegean and the Greek mainland coastline across the Aegean). In this respect, TURKAEGEAN means 'the part of the Aegean belonging to Turkey' or 'the Turkish Aegean' (applicant, 16/02/2023, p. 19).

The term 'TURKAEGEAN' merely designates the geographical area in which all of the contested services are provided. The Turkish coastline that borders the Aegean Sea (as well as the Greek islands in the Aegean and the Greek mainland coastline that borders the Aegean) are well-known tourist destinations, visited by numerous EU citizens and are renowned for and associated with the contested services by the relevant public. The services in Classes 39, 41 and 43 are related to tourism or are closely linked to tourist activities (such as culture, sports, entertainment). In relation to the services in Classes 35, 38 and 45, the sign is perceived as denoting their geographical provenance.

The (descriptive) heart symbol in a typical red color is a pervasive pictographic device in commercial contexts, conveying a laudatory message. The symbol commonly represents the concept of 'love' and is typically used to symbolize the proprietor's affinity for the services and the extent of its commitment to ensuring superior service quality. The blue lines that encircle the heart serve a purely decorative function, reinforcing the laudatory statement. The graphic design of the word element is designed with a standard font.

The sign as a whole merely provides information about the geographical origin and the quality of the contested services, while at the same time conveying a purely laudatory message ('I love Turkaegean' or 'love for Turkaegean'). The ability of the relevant consumer to understand the meaning of the sign does not require any interpretation or cognitive process in the mind of the relevant public.

The applicant further presents arguments in relation to why it considers the contested mark contrary to public policy and accepted principles of morality. Additionally, the applicant asserts that the EUTM was filed in bad faith. For reasons of procedural economy, these observations will only be detailed, if necessary, later in the present decision.

The applicant presents the following evidence:

Exhibits 1-3: Dictionary extracts.

Exhibits 4-8: Wikipedia, Britannica and Wordatlas extracts.

Exhibit 9: Extract from a PricewaterhouseCoopers report.

Exhibit 10: Extract from 'SETE 2019 Annual Report'.

Exhibit 11: EUROSTAT table.

Exhibits 12-53: Various (online) Press Articles.

Exhibits 54-55: Extracts from reports of the EU Commission and Parliament.

Exhibits 56-65: Various (online) Press Articles.

Exhibit 66: State Department Press Briefing.

Exhibit 67: Speech of the Greek Prime Minister.

Exhibits 68-69: Opinion polls.

Exhibit 70: Affidavit.

Exhibit 71: TGA website.

Exhibit 72: Power of Attorney.

The **EUTM proprietor** claims that the applicant is misusing the invalidity proceedings to advance the economic interests of a single country, which violates the principles of fair competition, as it attempts to monopolize tourism in a specific geographical area. It is imperative that the proceedings do not have the effect of restricting competition, particularly in the context of tourism activities, which Greece is seeking to monopolize illicitly. The applicant's position appears to be that the use of the term 'AEGEAN' should be granted exclusively to Greece. However, the Aegean Sea includes not only Greek regions, but also Turkish ones. The 'AEGEAN' trade marks registered by Greek companies serve to exemplify the applicant's intention.

The proprietor notes that the mark was registered without any objections, third-party observations or oppositions.

Neither the mark as a whole nor the term 'TURKAEGEAN' convey the straightforward and clear message 'The Turkish coasts of the Aegean Sea'. 'TURKAEGEAN' is a made-up, fanciful and imaginative neologism which is not commonly or broadly used and requires to engage in a cognitive process to interpret its meaning.

The term 'TURKAEGEAN' is not simply the sum of its parts and does not merely combine the possible meanings of its components. It is unlikely that the consumer will separate the term into two meaningful words, as this is syntactically incorrect and differs from customary combinations with the word 'AEGEAN'. The consumer would perceive the mark as a whole and will not analyze its various details. The term, as one word, provides a different visual impression than the separate components 'Turk' and 'Aegean' (which are neither prefixes nor suffixes), which are not separated by colors, a different font or a hyphen. The juxtaposition of the consonant 'k' and the vowel 'a' results in a different sound and an additional syllable.

A definition of the term 'TURK' in the Word Reference dictionary states that it refers to 'a person born or living in Turkey' and is not synonymous with 'Turkish' or 'Turkey'. It is not sufficient for an abbreviation to be derived from a descriptive term for it to also qualify as being descriptive. In the Collins Dictionary (considered an authoritative source on the English language), 'Turk' as an abbreviation for 'Turkey' or 'Turkish' is written with a dot, which is not included in the contested mark. Moreover, the usage of the English word 'TURK' appears to be on the decline over time. Therefore, the combination of the words 'TURK' and 'AEGEAN' to 'TURKAEGEAN' would signify 'the Aegean Sea of a person born or living in Turkey', which remains suggestive or allusive at most. In order to ascertain the meaning claimed by the applicant, the consumer is required to undertake a series of mental steps.

Even when the term is split into its constituent parts, 'Turk' and 'Aegean', it fails to provide any direct information and will not be understood as directly indicating a geographical origin or other characteristics of the contested services. The applicant has merely provided a general assessment without providing a reasoning for each category of the services. Even if the sign suggested that some of the services originate in the Turkish part of the Aegean Sea, the sign is not sufficiently direct and specific to enable the public to identify the geographical origin of the services without further thought.

The term 'TURKAEGEAN' is used exclusively by the proprietor. No documentation has been provided by the applicant demonstrating a descriptive use of the term. In the evidence presented, which predates the trademark application, the term 'TURKAEGEAN' is not mentioned at all. Some of the evidence submitted by the applicant postdates the date of filing.

The mark is not composed exclusively of verbal elements, but also contains an imaginative figurative element that resembles a heart in various colors which has no direct relation to the

characteristics of the services. The Office's established guidelines consider marks with similar figurative elements sufficiently distinctive.

Moreover, the sign lacks the structure of a slogan; even when the heart symbol is taken into account, it cannot be read as 'I love (or 'I like') Turkaegean' as the pronoun 'I' is missing. In particular, in relation to many of the business- and (public) infrastructure-related services the sign as a whole does not constitute a mere advertising message.

The proprietor was able to register several marks which are similar to the contested mark with the objective or promoting tourism in Turkey. National offices, including the Greek office, have registered similar marks. The Office has registered trade marks with a more explicit reference to the Aegean Sea (as EUTMs 18274487, 18274455, 18274451, 18193975) and to the Aegean region (as EUTMs 18629496, 15672504, 16393456, 11752508, 18902845, 18884431, 18877452, 11752508), many of them were filed by Greek entities. Furthermore, the Office has registered signs referring to geographical locations, such as 'Riviera'.

A minimum level of distinctive character (which was demonstrated in the present case) is sufficient for a mark to remain registered. The sign 'is gaining' acquired distinctiveness through intensive use.

Under Article 7(1)(f) EUTMR, the meaning conveyed by the mark itself must be contrary to public policy or accepted principles of morality. In relation to Articles 7(1)(b) and 7(1)(c) EUTMR the applicant claims that 'TURKAEGEAN' is a marketing slogan, referring to the Turkish coast in the Aegean Sea and intended to promote certain services. This is inconsistent with the applicant's argument in relation to Article 7(1)(f) EUTMR.

The proprietor puts forward arguments as to why it is convinced that the contested trade mark does not offend against public policy and accepted principles of morality and that the EUTM application was not filed in bad faith. For reasons of procedural economy, these arguments will only be set out in detail later in this decision, if necessary.

The proprietor submits the following evidence:

Annexes 1-2: Extracts from various websites.

Annex 3: Extracts from various publications.

Annexes 4-5: Turkaegean Assets presentations.

Annexes 6-8: Various Turkaegean promotion videos and publications.

Annex 9: Website extract.

Annex 10: Publication (Economic Reform Program).

Annex 11: Turkish Patent and Trademark Office's opinion.

The **applicant** reiterates its previous arguments and adds that the proprietor has not contested the assertion that the relevant public is composed of consumers with a basic knowledge of English throughout the EU.

The meaning of 'TURK' as an abbreviation for 'Turkish' and of 'AEGEAN' as 'everything related to the Aegean Sea or the Aegean Islands' was already well-established prior to the filing date of the contested mark and has not been contested by the proprietor. No cognitive process is required to understand that TURK and 'Turkish' mean the same. The proprietor has not demonstrated that the meanings of the terms 'TURK' and 'AEGEAN' are the result of rapid developments in language use or trends subsequent to the relevant filing date. It is sufficient for the applicant to show that 'TURKAEGEAN' refers to the wider Turkish geographical area of or relating to the Aegean Sea and/or the Aegean Islands.

The term 'TURKAEGEAN' is devoid of any fanciful features; the absence of a hyphen or space between the two words does not impede the relevant public from comprehending the descriptive semantic content. The distinction between the juxtaposed term 'TURKAEGEAN' and 'Turkish Aegean' is slight and unlikely to affect the perception of the relevant public.

The evidence presented by the applicant permits the inference of circumstances that prevailed prior to the filing date.

Regarding former registration decisions of the Office, the applicant notes that the Office has never registered a mark consisting of the terms LIGURIA – ITALIAN RIVIERA.

With regard to an acquisition of distinctive character through use, the proprietor has not presented any evidence that predates the date of filing of the contested mark. Moreover, no use of the contested mark as a trade mark is apparent from the submitted documentation. The proprietor has not provided evidence that the mark has been used throughout the relevant territory (Ireland, Malta, Cyprus, Denmark, Finland, Portugal), since the evidence relates only to Germany, Sweden, Belgium, the Netherlands, Lithuania, Latvia, Estonia, Bulgaria, France, Romania and countries outside the European Union. Moreover, the evidence presented by proprietor fails to meet the requisite qualitative and quantitative standards.

The applicant presents further arguments in support of its view that the contested trade mark is contrary to public policy and accepted principles of morality and was applied for in bad faith.

The applicant submits further evidence:

Exhibit 2.1 Partial refusal of EUTM 018008594 'TURISMO DE ANDALUCIA'.

Exhibits 2.2-2.3 Extracts from websites and online resources.

Exhibit 2.4 Dictionary extract.

Exhibits 2.5-2.6: Extracts from the proprietor's Annexes 5 and 8.

Exhibits 2.7-2.9 Extracts from various websites.

The **EUTM proprietor** reiterates previous arguments and presents further reasoning as to why it is convinced that the contested trade mark does not offend against public policy and accepted principles of morality and that the EUTM application was not filed in bad faith.

The proprietor presents further evidence:

Annexes 12-13: Extracts and printouts from various websites.

The **applicant** reiterates previous arguments and presents further reasoning why it considers that the contested trade mark is contrary to public policy and accepted principles of morality. The applicant concludes that the proprietor has presented two sets of facts: Under one set, the contested mark is non-distinctive and descriptive and under the other set the mark is contrary to public policy and accepted principles of morality and constitutes a bad faith filing.

## **PRELIMINARY REMARKS**

### **Abuse of rights**

The proprietor expresses the view that the present application for cancellation is an abuse of rights.

The Cancellation Division first notes that Article 63(1)(a) EUTMR does not require the applicant to demonstrate a legitimate interest in connection with an application for a

declaration of invalidity based on absolute grounds (25/02/2010, C-408/08 P, Color Edition, EU:C:2010:92, § 36 et seq.). This follows from the fact that the absolute grounds for invalidity, unlike relative grounds for invalidity, which protect the interests of the holders of certain earlier rights, are aimed at protecting general interests (30/05/2013, T-396/11, Ultrafilter International, EU:T:2013:284, § 17-18). In that regard, the Cancellation Division points out that the Court of Justice has ruled (references to 'OHIM' refer to the former name of the EUIPO which was in use at the time of the judgment):

*Because OHIM's assessment must be made exclusively in the light of the public interest underlying Article 7(1)(b) and (c) and Article 56(1)(a) of Regulation No 207/2009, the potential or actual economic interest pursued by the applicant for a declaration of invalidity is not relevant and, consequently, there can be no question of an 'abuse of rights' on the part of the applicant for a declaration of invalidity, as the General Court was entitled to rule. (...) The public interest safeguarded by Article 7(1)(c) of Regulation No 207/2009 is precisely that of keeping that sign freely available. (...) By contrast, (...) the rejection of the application for a declaration of invalidity on the ground of an 'abuse of rights' would preclude the effective attainment of the objectives pursued by Article 7(1)(b) and (c) of Regulation No 207/2009. Such rejection would not permit an assessment of the mark in the light of the rules governing the registrability of marks or of the existence of an absolute ground for refusal of registration. (...) In these conditions, the General Court did not err in law in ruling that the question of the abuse of rights is not relevant in invalidity proceedings under Article 56(1)(a) of Regulation No 207/2009.*

Irrespective of this, an 'abuse of rights' has not been demonstrated in the present case.

The conditions for the finding of an abusive practice are very strict (see 11/02/2020, R 2445/2017-G, Sandra Pabst, § 37); they require the clear finding of objective and subjective elements (28/07/2016, C-423/15, Kratzer, EU:C:216:604, § 38). It must be apparent from an overall assessment of the objective circumstances that, despite formal compliance with the conditions laid down by EU legislation, the objective of that legislation has not been achieved (28/07/2016, C-423/15, Kratzer, EU:C:216:604, § 39). Furthermore, it must be evident from a range of objective factors that the essential purpose of the actions in question is to obtain an unjustified advantage; the prohibition of abusive practices does not apply if the actions in question can be explained by something other than the mere desire to obtain such unjustified advantage (28/07/2016, C-423/15, Kratzer, EU:C:216:604, § 40).

In the present case, the proprietor merely claims that the applicant intends to monopolize tourism in the Aegean region through the cancellation application. However, the applicant has not provided convincing objective and subjective evidence which could (without resorting to mere presumptions) prove such an intention.

With the burden of proof the proprietor also bears the risk of not being able to demonstrate that the applicant has engaged in abusive conduct.

In light of the above, the Cancellation Division concludes that there is no abuse of rights by the applicant and this argument is dismissed as unfounded.

### **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.

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 European Union trade mark, 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. Decisions of courts or the Boards of Appeal, in particular those contained in generally accessible databases, are generally known facts which the Cancellation Division can refer to without having to communicate to the parties (08/08/2022, R 2214/2019-1, ATHLET, § 102).

It is settled case-law that each of the grounds for refusal to register listed in Article 7(1) EUTMR is independent and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration must reflect different considerations according to the ground for refusal in question (16/09/2004, C-329/02 P, SAT.2, EU:C:2004:532, § 25).

As to the applicant's argument that the mark was registered without any objection, third party observation or opposition, the Cancellation Division highlights that the registration of a European Union trade mark cannot give rise to a legitimate expectation for its proprietor with regard to the result of subsequent invalidity proceedings, since the applicable rules expressly allow for that registration to be challenged subsequently in an application for a declaration of invalidity or a counterclaim in infringement proceedings (19/05/2010, T-108/09, Memory, EU:T:2010:213, § 25). Otherwise, challenging the registration of an EUTM in the context of invalidity proceedings would, where the subject-matter and the grounds were the same, be deprived of any practical effect, even though such a challenge is permitted under the EUTMR (22/11/2011, T-275/10, Mpay24, EU:T:2011:683, § 18).

## **DESCRIPTIVENESS – ARTICLE 7(1)(c) EUTMR**

Article 7(1)(c) EUTMR prohibits the registration of 'trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service'.

The provision pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of the goods or services in respect of which registration is applied for remain freely available to all undertakings for use (15/12/2022, R 1238/2019-G, Iceland, § 98; 20/07/2016, T-11/15, SUEDTIROL, EU:T:2016:422, § 30).

As regards, more particularly, signs or indications which may serve to designate the geographical origin of the categories of goods [or services] in relation to which registration of the mark is applied for, especially geographical names, it is in the public interest that they remain available, not least because they may be an indication of the quality and other characteristics of the categories of goods [or services] concerned, and may also, in various ways, influence consumer tastes by, for instance, associating the goods [or services] with a place that may give rise to a favorable response (15/12/2022, R 1238/2019-G, Iceland, § 99). However, it must be noted that, in principle, Article 7(1)(c) EUTMR does not preclude the registration of geographical names which are unknown to the relevant public (or at least



unknown as the designation of a geographical location) or of names in respect of which, because of the type of place they designate, such persons are unlikely to believe that the category of goods or services concerned originates there (15/12/2022, R 1238/2019-G, Iceland, § 102).

In the light of the above principles, it must be examined whether the designation of a geographical location was known to the relevant public at the time of filing the trade mark application and whether the public may 'associate' the designation in question with the goods and services concerned (20/07/2016, T-11/15, SUEDTIROL, ECLI:EU:T:2016:422, § 39), i.e. in other words whether it can reasonably be expected that the indication designates the geographical origin of the goods and services (20/05/2024, R 171/2024-2, Kitzbühel (fig.), § 12).

#### *The relevant public and territory*

Account must be taken of the understanding of an average consumer of the relevant goods or services who is reasonably well informed and reasonably observant and circumspect (16/07/1998, C-210/96, Gut Springenheide, EU:C:1998:369, § 31).

The contested mark is registered for a range of services in Classes 35, 38, 39, 41, 43 and 45 that are primarily directed towards the professional (business) consumers (and the public at large with an interest in such services); the tourism-, travel-, entertainment- and education related services are mainly aimed at the general public but could also be directed at professionals. In consideration of the nature of the services at issue (and in the absence of indications to the contrary), the level of attention of the relevant public may range from average to high, depending on the specialized nature of the services, the frequency of purchase and their price. In any event, case law establishes that the level of attention of the relevant public is not a determining factor in assessing whether a trade mark conflicts with the absolute grounds for refusal relating to the lack of distinctive character or the descriptive character of a mark (22/01/2024, R 1381/2023-4, RESTORE, § 22; 10/02/2021, T-98/20, Medical beauty research, EU:T:2021:69, § 44-46).

In light of the applicant's exclusive reference to the meaning of the word element 'TURKAEGEAN' in the English language, the Cancellation Division deems it pertinent to examine the mark in relation to the English-speaking public within the European Union.

The Cancellation Division notes that Article 7(2) EUTMR excludes a mark from registration if a ground for refusal exists even in only part of the EU; accordingly, a refusal may be based on the grounds that a trade mark is descriptive and/or lacks distinctive character in any one of the official EU languages (03/07/2013, T-236/12, Neo, EU:T:2013:343, § 57). In consequence, the mere fact that a sign is descriptive or non-distinctive for English-speaking consumers is sufficient for a mark to be refused under Article 7(1) EUTMR.

#### *The descriptive character of the word element*

As regards the relevance of the meanings of the individual word elements of which the mark consists, the Cancellation Division agrees that the mark must be considered as a whole when its distinctive character is assessed. However, consideration as a whole is not incompatible with examination of each of the trade mark's individual components in turn (19/09/2001, T 118/00, Tabs (3D), EU:T:2001:226, § 59). While the Cancellation Division examines the individual components of the mark, it also establishes the meaning of the sign as a whole, as it would be perceived by the relevant public.

The absence of the term 'TURKAEGEAN' as a whole from dictionaries does not imply its lack of meaning; dictionaries are not structured to provide comprehensive coverage of all possible word combinations (23/09/2015, T-633/13, INFOSECURITY, EU:T:2015:674, § 39; 19/04/2016, T-261/15, Daylong (fig.), EU:T:2016:220, § 32).

The relevant English-speaking public perceives (and already perceived at the time of filing) the word element 'TURKAEGEAN' as consisting of the English words 'Turk' and 'Aegean'. Contrary to the proprietor's assertion, the juxtaposition of both words is (and was at the time of filing) easily recognized by the relevant public. When presented with a verbal sign, consumers will typically break it down into its constituent elements, which may evoke a concrete meaning or resemble words with which they are already familiar (13/02/2007, T-256/04, Respicur, EU:T:2007:46, § 57; 13/02/2008, T-146/06, Aturion, EU:T:2008:33, § 58). In the English language, it is common to construct words by combining two existing words, each of which possesses a distinct meaning (12/06/2007, T-339/05, Lokthread, EU:T:2007:172, § 52; 16/05/2017, T-218/16, Magicrown, EU:T:2017:334, § 22). The fact that the elements 'TURK' and 'AEGEAN' are not separated by colours, a different typeface or a hyphen does not amount to evidence to conclude that the word 'TURKAEGEAN' is capable of distinguishing the applicant's goods and services from those of other undertakings (07/06/2005, T-316/03, MunichFinancialServices, EU:T:2005:201, § 37; 13/11/2008, T-346/07, Easycover, EU:T:2008:496, § 52). The conjunction of two distinct, capitalized words, with a clear meaning in the English language does not create an impression that differs from the impression given by merely placing these words next to one another.

The restriction of the factual basis of the examination by the Cancellation Division does not preclude it from taking into consideration (in addition to the facts expressly presented by the parties) facts which are well known, that is, which may be learnt from generally accessible sources (22/06/2004, T-185/02, Picaro, EU:T:2004:189, § 29, 20/04/2005, T-318/03, Atomic Blitz, EU:T:2005:136, § 35). Such well known facts do not have to be communicated to the parties (13/09/2012, T-404/10, Mano, EU:T:2012:423, § 20; 01/02/2005, T-57/03, Hooligan, EU:T:2005:29, § 59; 19/04/2007, C-273/05 P, Celltech, EU:C:2007:224, § 39; 08/08/2022, R 2214/2019-1, ATHLET, § 101). Definitions or meanings of words taken from dictionaries come from generally accessible sources; they are well-known facts (01/02/2005, T-57/03, Hooligan, EU:T:2005:29, § 59: '*The dictionaries in the language of the relevant public may, as a rule, be taken into consideration in that respect, both by the first body at OHIM and by the Boards of Appeal, even if they have not been put to the parties, because they are, a priori, well-known facts.*').

The English word 'Turk' is (and already was at the time of filing) perceived by the relevant public as an abbreviation for 'Turkish' or 'Turkey' (*Collins Dictionary*, [www.collinsdictionary.com/dictionary/english/turk](http://www.collinsdictionary.com/dictionary/english/turk), 13/12/2024) *Cambridge Dictionary*, 13/12/2024).

As regards the proprietor's argument that the word element 'TURK' is solely recognized as an abbreviation for 'Turkey' or 'Turkish' when accompanied by a dot, the Office observes that the absence of a full stop after the word 'TURK' does not influence the perception of its meaning by the relevant public; there is no principle that an abbreviation is only interpreted as such when it is followed by a full stop (09/04/2021, R 1737/2020-2, Miniconf Academy, § 29). Moreover, *Collins Dictionary* (referred to by both parties) indicates that the term 'TURK', when used as an abbreviation for 'Turkish' or 'Turkey', has an identical meaning in American English without a dot. In this regard, the Cancellation Division emphasizes that, given the close political, economic and cultural ties and the pervasive exchange (also via electronic media) between the European Union and the United States of America, English-speaking consumers in the European Union also comprehend the meaning of American English words (12/01/2023, R 1571/2022-1, NEIGHBORHOOD FARMSTAND, § 21). According to settled case law, the Cancellation Division may take into account sources from outside the European Union to

assess the understanding of consumers (11/04/2023, R 2352/2022-1, Beyond Chocolate, § 22).

The proprietor's comments on 'word frequency' and 'recorded usage' along with the corresponding illustrations are unclear as they lack a point of reference and the exact context; even the information as to which territory this information refers to is missing.

The English word 'Aegean' is (and already was at the time of filing) perceived by the relevant public as referring to 'the part of the Mediterranean Sea that is between Greece and Turkey' (*Cambridge Dictionary*, <https://dictionary.cambridge.org/dictionary/english/aegean>, 13/12/2024) or as meaning 'of or relating to the Aegean Sea or Islands' (*Collins Dictionary*, [www.collinsdictionary.com/dictionary/english/turk](http://www.collinsdictionary.com/dictionary/english/turk), 13/12/2024).

Notwithstanding the above, the Cancellation Division is convinced that it is also clear from the evidence submitted and referred to by the applicant (*Collins English Dictionary*, provided by the applicant as Exhibits 1 and 3; also referred to by the proprietor on 05/03/2024, page 19) that the meaning of the verbal elements of the sign was understood by the relevant public at the relevant time as set out above.

While the facts and arguments presented must originate from the period in which the EUTM application was filed, facts pertaining to a subsequent period may nonetheless permit the drawing of conclusions regarding the circumstances prevailing at the time of filing (23/04/2010, C-332/09 P, Flugbörse, EU:C:2010:225, § 41 and 43; 28/11/2024, R 526/2024-2, V12X, § 64). The inclusion of a word in a dictionary signifies that this word has been employed repeatedly in a particular context until it has been accorded an accepted meaning; consequently, inferences can be derived from online dictionary entries in the present case with regard to the period preceding the filing date in July 2021 (see 25/11/2015, T-223/14, VENT ROLL, EU:T:2015:879, § 39). In the present case, there is nothing to suggest that the meaning of the words 'Turk' and 'Aegean' has changed since the filing of the application for the contested mark on 16/07/2021.

Therefore, the word element 'TURKAEGEAN' is (and already was at the time of filing) understood by at least a significant part of the relevant English-speaking public in the European Union (Ireland, Malta and all EU territories where English is adequately understood, such as Denmark, Cyprus, the Netherlands, Finland and Sweden; 26/11/2008, T-435/07, New Look, EU:T:2008:534, § 23) as meaning (as also submitted by the applicant) 'the part of the Aegean belonging to Turkey' or 'the Turkish part of the Aegean'.

The relevant characteristics of the Turkish part of the Aegean region have been demonstrated by the applicant and are also apparent from well-known facts, originating from generally accessible sources, such as the *Encyclopaedia Britannica* (see, by analogy, 15/12/2022, R 1238/2019-G, Iceland, § 125). The Turkish part of the Aegean region is not only a well-known touristic destination but also of important economic and business relevance. Exhibits 12, 13 and 14 demonstrate the touristic importance of the region (although the exhibits are dated subsequent to the relevant filing date or are undated, there is no indication that they do not provide a sufficiently accurate reflection of the situation at the time of filing). As illustrated in Exhibit 11, in 2019, 8% of all outbound trips made by EU residents outside the EU had Turkey as their destination. The Turkish part of the Aegean region is home to numerous large cities, including Izmir, the third-largest city of Turkey, which features a robust industrial economy and is the seat of one of Turkey's largest ports (*Encyclopaedia Britannica*, 13/12/2024, [www.britannica.com/summary/Izmir](http://www.britannica.com/summary/Izmir): 'On the Aegean seacoast, it is one of Turkey's largest ports and its third largest city. ... It has grown rapidly since 1945 and has a large industrial economy and a growing tourist trade. '; [www.britannica.com/place/Izmir](http://www.britannica.com/place/Izmir) : 'After World War II Izmir grew rapidly, partly because of its location, for which it was selected as the site of the headquarters of the North Atlantic Treaty Organization's command for land forces

*in southeastern Europe. It also has a teacher-training school and the Aegean University, founded in 1955. Second only to the Istanbul region in industry, it produces foods, cement, and cotton and woolen textiles and has petrochemical and engineering works. A large international trade fair is held there annually.*.)

On this basis, it can be reasonably assumed that the 'Turk Aegean', the 'Turkish part of the Aegean region', is recognized by the relevant public as a geographical designation. Consequently, the word element 'TURKAEGEAN' of the contested mark is (and already was at the time of filing) perceived by the relevant public a reference to this specific region.

It has to be noted that the registration of a geographical name as a trade mark is not only excluded where such a geographical name is either already known for, and therefore associated with, a category of goods or services (in the mind of the relevant public), but also where a reasonable assumption can be made that a place will be associated (by the relevant public) with those goods or services in the future or that a name may (in the mind of the relevant public) designate the geographical origin of that category of goods or services (15/12/2022, R 1238/2019-G, Iceland, § 101; 13/03/2024, R 2172/2023-2, Hagen/Hagen von Tronje et al., § 17).

Services such as those designated by the contested mark are in principle offered in every region of a certain level of economic importance (20/07/2016, T-11/15, SUEDTIROL, EU:T:2016:422, § 41; 15/12/2022, R 1613/2019-G, Iceland (fig.), § 161). In the present case, the geographical location at issue is not without a certain economic significance. Given that the Turkish part of the Aegean is known as an economically active and touristic region, it does not appear unlikely that the contested services originate from or are provided in this geographical area (see, by analogy, 13/03/2024, R 2172/2023-2, Hagen/Hagen von Tronje et al., § 26).

Where the contested mark is used in relation to (potentially) travel-, tourism-, entertainment- and education-related services (such as *transport, vehicle rental, boat storage, arranging of tours, travel reservation (Cl. 39), entertainment and entertainment reservation services, sporting and cultural activities (Cl. 41), temporary accommodation, provision of food and drink, rental of facilities or animal boarding (Cl. 43)*, as well as services that may be offered in connection with travel or entertainment (such as *marriage agency, clothing rental, escort and social networking services (Cl. 45)*), the relevant consumer will immediately understand that these services are provided in (or originate from) the Turkish part of the Aegean region, which is a well-known tourist, travel and entertainment destination.

In relation to (potentially) business-related services (such as *business management/administration/consultancy, accounting, statistics compilation and systemization of information into databases, office machine rental, secretarial/telephone answering services and office functions, (temporary) personnel recruitment/placement, marketing, public relations, provision of online marketplaces, import-export agency services, auctioneering, organization of fairs and exhibitions (Cl. 35), storage, wrapping and packaging of goods (Cl. 39), arranging/conducting of conferences/seminars, translation services (Cl. 41), legal services, workplace safety consultancy (Cl. 45)*), the mark is (and already was at the time of filing) perceived by the relevant consumer as indicating that these services are provided in (or originate from) the Turkish part of the Aegean region, which is known for its economic prosperity and elevated level of business activity (see, by analogy, 10/10/2014, R 574/2013-G, SUEDTIROL, § 50).

Moreover, the relevant public perceives (and already perceived at the time of filing) the mark as a reference to a specific quality of business-related services, namely that these services are tailored and adapted to the requirements of companies operating in that region, characterized by a particular political, administrative, cultural and linguistic context

(20/07/2016, T-11/15, SUEDTIROL, EU:T:2016:422, § 42; 15/12/2022, R 1613/2019-G, Iceland (fig.), § 163).

Similarly, the contested sign is (and already was at the time of filing) perceived in relation to (public) infrastructure-related services (such as *water supplying, electricity distribution, transport and storage of waste/trash, transport by pipeline, rescue operations, courier services, car parking and garage rental (Cl. 39), day-nurseries (Cl. 43), fire-fighting services, funeral services, security services (Cl. 45)*), as well as telecommunication- and media-related services (such as *providing access to the internet, broadcasting and news agencies (Cl. 38), publication services, movie/radio/television production services, photography and news/reporting services (Cl. 41)*) as indicating that these services are provided in the Turkish part of the Aegean region and specifically tailored to the needs of businesses operating in this region.

As to the proprietor's claim that the term 'TURKAEGEAN' is a syntactically incorrect, fanciful and imaginative neologism which requires an interpretative effort, triggers a cognitive process and does not provide clear and direct information about characteristics of the contested services, the Cancellation Division points out that the assessment of a mark has to be carried out in relation to the services concerned and not in the abstract (22/11/2023, R 1361/2023-2, FEEL MORE IN QATAR, § 25; 23/10/2008, R 752/2008-1, Buch24, § 16). As such this context provides a significant interpretative aid as to how consumers perceive the contested mark. Even where a mark displays minor elements of vagueness in its conceptual content, when viewed in isolation, such vague or unclear elements are minimised or eliminated when consumers are confronted with the mark in the context of the relevant goods or services (22/11/2023, R 1361/2023-2, FEEL MORE IN QATAR, § 25; 20/04/2020, R 13/2020-5, Sleep, § 36). Therefore, even though the contested mark may have vague or even several meanings in the abstract, most of such meanings would not come to the mind of the relevant consumer in connection with the contested services.

A neologism composed of elements each of which is descriptive is itself descriptive, unless there is a perceptible difference between the neologism or the word and the mere sum of its parts (12/01/2005, T 367/02 - T 369/02, SnTEM, SnPUR & SnMIX, EU:T:2005:3, § 32). The term 'TURKAEGEAN' is constituted exclusively of word elements that designate characteristics of the contested services which is arranged in a configuration that is not significantly different from that produced by the mere combination of the meanings of the words 'TURK' and 'AEGEAN'. The term 'TURKAEGEAN' is therefore simply the sum of its parts, 'Turk' and 'Aegean'. The Cancellation Division is unable to discern how the juxtaposition of the elements 'TURK' and 'AEGEAN' to form the term 'TURKAEGEAN' could result in an additional syllable or pronunciation that differs from the pronunciation of the separate verbal elements (as claimed by the proprietor).

With regard to the proprietor's claim that the term 'TURKAEGEAN' is not commonly or broadly used to designate the contested services (and that the applicant has not shown the descriptive use of the term), the Cancellation Division recalls that 'there is no such requirement under Article 7(1)(c) EUTMR that the (...) sign is the usual way to designate the goods or services, or that it is commonly used, or that it is actually in use at all (12/02/2004, C-363/99, Postkantoor, EU:C:2004:86, § 61, 97; 10/03/2011, C-51/10, 1000, EU:C:2011:139, § 38)' (09/11/2018, R 1801/2017-G, easyBank (fig.), § 75). In order for a trade mark to be caught by the prohibition set out in Article 7(1)(c) EUTMR, 'it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that

provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.’ (23/10/2003, C 191/01 P, Doublemint, EU:C:2003:579, § 32).

Even if the term ‘TURKAEGEAN’ was ‘invented’, ‘made-up’ and used only by the proprietor, the Cancellation Division notes that the ‘creation’ of a sign does not confer protection under trade mark law; its own use of the sign could only benefit the proprietor under the conditions of Article 7(3) EUTMR (27/03/2015, R 2271/2013-4, KORNSPITZ SO SCHMECKT ÖSTERREICH, § 46; 17/03/2006, R 1081/2004-4, Zipflbob, § 17; Article 7(3) EUTMR is examined below).

#### *Descriptive character not eliminated by the figurative elements*

The overall impression created by the combination of figurative and word elements in the contested mark is not sufficiently far removed from the descriptive statement of the word element to overcome the grounds for refusal under Article 7(1)(c) EUTMR for the contested services.

A red heart with radiating rays (in light and darker blue) is depicted on the upper right, adjacent to the word element (which is written in a black standard font). The size of the figurative element is much smaller than that of the word ‘TURKAEGEAN’.

The use of heart-shaped illustrations (along with radiating rays that symbolize a glow or shine, resemble sunbeams and evoke the notion of light and positive feelings) is a common practice in advertising to indicate to customers that the providers of the services follow a customer-centric approach and ensure that the services will delight the customer (16/11/2022, T-512/21, EPSILON TECHNOLOGIES (fig.), EU:T:2022:710, § 31: *‘It is apparent from the case-law that an element representing a heart is commonly used in advertising language to express a particular attachment and that it is devoid of distinctive character (...). Consequently, as EUIPO contends, that figurative element will be understood by consumers as merely a decoration or, at most, as an allusion to love or affectionate appreciation showing that that element is laudatory in relation to the services at issue. It follows that that element cannot be held to be distinctive’*; 14/07/2017, R 2357/2016-1, SIMPLY good (fig.), § 21; 18/05/2020, R 940/2019-5, DARSTELLUNG EINER HERZGESTALTUNG (fig.), § 42).

The specific depiction of the heart in the contested mark does not differ from other common heart shapes (see, by analogy, 14/07/2017, R 2357/2016-1, SIMPLY good (fig.), § 22). This is due to the subordinate role of the heart in the sign, as the verbal element ‘TURKAEGEAN’ clearly dominates the sign due to its size and position. Based on the proportions and the peripheral position of the heart image, the overall impression of the mark is clearly characterized by the term ‘TURKAEGEAN’. The heart with the radiating rays is (and already was at the time of filing) perceived by the relevant public as a mere decorative element, limited to the presentation of the word element or, at most, as emphasizing the quality of the contested services.

With regard to the proprietor’s reference to a mark with a heart shape in the Office’s guidelines, it should be noted that the mark referred to consists of a significantly more stylized heart shape (resembling an office clip) which is not comparable to the standard red heart shape in the present case. The present heart shape is more analogous to the heart shape depicted in the same section of the guidelines (IR W01116291), which is deemed (according to the guidelines) to possess ‘no distinctive character’.

Therefore, contrary to the proprietor’s opinion, the graphic design of the contested sign is devoid of distinctive character, both in isolation and when combined with the word element; it cannot divert the consumer’s attention away from the clear message conveyed by the word

element 'TURKAEGEAN' and counteract its descriptive nature.

Therefore, the contested mark was descriptive pursuant to Article 7(1)(c) EUTMR and Article 7(2) EUTMR in relation to all of the contested services at the time of its filing.

### **NON-DISTINCTIVENESS – ARTICLE 7(1)(b) EUTMR**

According to case-law, the signs referred to in Article 7(1)(b) EUTMR are signs which are regarded as being incapable of performing the essential function of an individual trade mark, namely that of identifying the commercial origin of the goods or services, thus enabling the consumer who acquired them to repeat the experience if it proves to be positive, or to avoid it if it proves to be negative, on the occasion of a subsequent acquisition (27/02/2002, T-79/00, Lite, EU:T:2002:42, § 26).

The distinctive character of a trade mark must be assessed, first, in relation to the goods or services for which registration of the sign is sought and, second, in relation to the perception of the section of the public targeted, which is composed of the consumers of those goods or services (27/11/2003, T-348/02, Quick, EU:T:2003:318, § 29).

Given that the contested sign had a clear descriptive meaning in relation to the contested services at the time of its filing, it is (and already was at the time of filing) also devoid of any distinctive character in relation to these services and therefore ineligible for registration under Article 7(1)(b) EUTMR.

The relevant consumers perceive (and already perceived at the time of filing) the sign (as a whole) to be merely informative, indicating that the contested services are provided in (or originate from) the Turkish part of the Aegean region (which is a well-known tourist, travel and entertainment destination, renowned for its elevated level of business activity) and that these services (insofar as far as they target business consumers) are tailored and adapted to the specific requirements of businesses operating in that region (which is characterized by a particular political, administrative, cultural and linguistic context). The depiction of a red heart with radiating rays (that symbolize a glow or shine, resemble sunbeams and evoke the notion of light and positive feelings) serves to further emphasize the positive attributes of the contested services, namely that the providers demonstrate a commitment to customer care and, as a consequence, provide the highest possible quality of service.

Moreover, a sign is not distinctive if its 'semantic content (...) indicates to the consumer a characteristic of the product relating to its market value which, whilst not specific, comes from promotional or advertising information which the relevant public will perceive first and foremost as such, rather than as an indication of the commercial origin of the [goods or services]' (30.06.2004, T 281/02, Mehr für Ihr Geld, EU:T:2004:198, § 31). This is the case in the present context. In relation to the contested services the sign as a whole is perceived (and was at the time of its filing) by the relevant public as a mere promotional information, unambiguously indicating favorable aspects of the contested services, namely that they are provided in (or originate from) the Turkish part of the Aegean region (and tailored to the particular requirements of businesses operating in this region) by providers that care for their clients and deliver a high service quality. Contrary to the proprietor's view this also encompasses the contested business- and (public) infrastructure-related services which can be adapted to the specific needs of foreign businesses operating in this region as well.

As illustrated above, the graphic design of the contested sign is devoid of distinctive character, both in isolation and when combined with the word element; it is therefore unable to render the sign distinctive. Therefore, the sign's overall promotional message (the verbal element 'TURKAEGEAN' in conjunction with the depicted heart with rays) is sufficiently clear for the

relevant public. In this respect, it is therefore irrelevant whether the sign has the structure of a slogan and whether an 'I' would be missing to complete the slogan 'I love Turkaegean', contrary to the proprietor's view.

Already at the time of filing the relevant public was (in relation to the contested services) unable to associate any meaning with the sign other than a purely informative and promotional one; there was (and is) no indication of commercial origin discernible from the sign.

Therefore, the contested mark was devoid of distinctive character pursuant to Article 7(1)(b) EUTMR and Article 7(2) EUTMR in relation to all of the contested services at the time of its filing.

While it is true that, as the proprietor claims, a minimum degree of distinctiveness is sufficient to register a mark, the Cancellation Division highlights that the contested sign was already at the time of filing entirely devoid of distinctive character in relation to the goods at issue. Therefore, there is no need to discuss whether a lower degree of distinctiveness might have been sufficient to render the mark registrable.

### **Earlier registrations**

As regards the national trade mark registrations referred to by the proprietor, the Cancellation Division notes that decisions of offices in countries that do not have English as their language (as for instance Greece) do not allow any conclusions to be drawn with regard to the present case, since a sign may well be distinctive in these countries without necessarily being so throughout the European Union (see 03/07/2003, T-122/01, Best Buy, EU:T:2003:183, § 40).

The Cancellation Division further notes that 'the European Union trade mark regime is an autonomous system with its own set of objectives and rules peculiar to it; it is self-sufficient and applies independently of any national system (...). Consequently, the registrability of a sign as a European Union trade mark must be assessed by reference only to the relevant Union rules. Accordingly, the Cancellation Division and, if appropriate, the Union judicature are not bound by a decision given in a Member State (...). That is so even if such a decision was adopted under national legislation harmonised with Directive 89/104 or in a country belonging to the linguistic area in which the (...) sign in question originated.' (27/02/2002, T-106/00, Streamserve, EU:T:2002:43, § 47).

Regarding earlier trade mark registrations of the Office referred to by the proprietor (as EUTMs 18274487, 18274455, 18274451, 18193975, 18629496, 15672504, 16393456, 11752508, 18902845, 18884431, 18877452, 11752508), the Cancellation Division notes that all these marks present decisive differences in comparison with the contested mark, and that such differences may justify a different outcome. The signs consist of very different word combinations, none of which contains both elements, 'Turk' and 'Aegean'; furthermore, the signs contain different figurative elements. Therefore, none of these cases is comparable to the case at hand. Furthermore, some of the marks referred to were registered years ago; therefore, the registration decisions do not reflect subsequent developments in trade mark (case) law and Office practice (as the contested mark was registered recently, in December 2021). Thus, the principles of equal treatment and sound administration do not require a different outcome; they are not affected.

Moreover, the Cancellation Division highlights that 'each mark must be considered on its own merits and an EU trade mark (...) cannot draw its distinctive character from any other mark previously registered by the Office. (...) [D]ecisions concerning registrability of a sign as an EU trade mark are adopted in the exercise of circumscribed powers and are not a matter of discretion. Accordingly, the legality of the registration must be assessed solely on the basis of



the EUTMR as interpreted by the Court's case-law and not on the basis of a previous decision-making practice.' (10/12/2019, R 1170/2019-5, Cuisine, § 76; see also 15/09/2005, C-37/03 P, BioID, EU:C:2005:547, § 47; and 09/10/2002, T-36/01, Glass Pattern, EU:T:2002:245, § 35). It also has to be noted that 'even if (...) marks were to be deemed as having been unlawfully granted, it is important to recall that, in accordance with the settled case-law of the Court of Justice, the principles of equality of treatment and of sound administration must be applied in a way that is consistent with respect for legality and, as such, a person who files an application for registration of a sign as a trade mark cannot rely, to his/her advantage and in order to secure an identical decision, on a possibly unlawful act committed to the benefit of someone else' (10/12/2019, R 1170/2019-5, Cuisine, § 72, referring to 10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 75-76; 14/06/2016, T-385/15, Shape of a toothbrush (3D MARK), EU:T:2016:348, § 33).'

### **Acquired distinctiveness – Article 7(3) and Article 59(2) EUTMR**

As to the proprietor's reference to 'acquired distinctiveness this sign is gaining through intensive use', the Cancellation Division notes that the actual use of a mark on the market is irrelevant as regards its inherent distinctive character (21/09/2023, R 730/2023-1, RED, § 31; 28/05/2018, R 2650/2017-2, real nature, § 28). The use of a mark might be relevant in connection with a claim that the mark has become distinctive due to the use which has been made of it. However, no clear claim in this regard has been presented by the proprietor; the proprietor's statement that the mark 'is gaining' acquired distinctiveness cannot be understood with sufficient clarity as a claim that the mark 'has become distinctive' as a consequence of the use which has already been made of it (Article 7(3) and Article 59(2) EUTMR).

Notwithstanding the above, the evidence submitted by the applicant would not be sufficient to demonstrate that the mark has become distinctive through use.

Under Article 7(3) EUTMR, the absolute grounds for refusal laid down in Article 7(1)(b) and (c) EUTMR do not preclude registration of a mark if, for the goods and services for which registration has been requested, that mark has become distinctive in consequence of the use which has been made of it. Furthermore, as regards cancellation proceedings, Article 59(2) EUTMR provides that where a European Union trade mark has been registered in breach of Article 7(1)(b) or (c) EUTMR, it may nevertheless not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

Therefore, the proprietor must (not only clearly claim but also) prove that the trade mark has acquired distinctive character at the latest by the date of application for a declaration of invalidity (05/03/2003, T-237/01, BSS, EU:T:2003:54, § 53). Evidence of acquired distinctiveness by the application date of the EUTM, between the application date of the EUTM and the date of registration, and between the date of registration and the date of application for a declaration of invalidity are all relevant.

The acquisition of a distinctive character through use of a mark requires that at least a significant proportion of the relevant section of the public identifies goods or services as originating from a particular undertaking because of the mark. In determining whether a mark has acquired distinctive character through its use, the Cancellation Division must globally assess the evidence that the mark has come to identify the goods and services concerned as originating from a particular undertaking, and thus to distinguish those goods or services from goods or services of other undertakings. In this context, it is necessary to consider, inter alia, the market share held by the mark; how intensive, geographically widespread and long-standing the use of the mark has been; the amount invested by the undertaking in promoting the mark; and the proportion of the relevant public who, because of the mark, identify goods

as originating from a particular undertaking (06/03/2007, T-230/05, Golf USA, EU:T:2007:76, § 79 and the case-law cited).

### **Assessment of the evidence**

As the contested mark consists of English words, it has to be shown that it has acquired distinctiveness among the relevant English-speaking public, namely consumers in the Member States of the European Union where English is the official language (Ireland and Malta) and in the Member States where English is adequately understood, as the Netherlands, Denmark, Finland, Sweden and Cyprus.

The Cancellation Division notes that, according to the General Court, a distinction must be made between 'direct proof' of acquisition of distinctive character (as surveys, evidence on the market shares held by the mark, statements from chambers of commerce and industry or other trade and professional associations) and 'secondary evidence' (as advertising material or sales volumes) that are merely indicative of the mark's recognition on the market. Though secondary evidence may serve to corroborate direct proof, it cannot substitute it. The Court confirmed 'that direct evidence such as declarations by professional associations and market studies are usually the most relevant means for proving acquired distinctiveness through use' (12/02/2018, R 2355/2017-1, SOFIA FASHION WEEK (fig.), § 51, referring to 29/01/13, T-25/11, Cortadora de cerámica, EU:T:2013:40, § 74). However, the Cancellation Division notes that the proprietor did not submit any 'direct proof' (as market studies or declarations by professional associations) in the present case.

The remaining evidence is insufficient to demonstrate that the contested mark has (or had) acquired distinctive character in the relevant English-speaking parts of the European Union as it does not clearly show (sufficient) use (or recognition) of the EUTM in relation to the contested services in the relevant territories under examination.

With regard to the online newspaper articles (as in Annexes 12 and 13), website / video excerpts and advertising publications / presentations (as in Annexes 4 to 8) submitted by the proprietor, the Cancellation Division notes that they (insofar as they mention or refer to the contested mark at all) merely show that certain information was communicated to the public (see 12/02/2018, R 2355/2017-1, Sofa Fashion Week (fig.), § 53; 06/06/2016, R 1405/2015-5, Skills to Succeed, § 21). Most businesses use websites to advertise their goods, but based on this fact alone it is not possible to conclude that the EUTM has acquired distinctiveness through use. Website excerpts do not enable to identify visits from the relevant EU member states (10/03/2016, R 944/2015-2, feelunique.com (fig.), § 72; 07/09/2015, R 1231/2014-4, PETCO (FIG), § 27); therefore, they cannot provide sufficient evidence that the relevant public perceives or perceived the contested EUTM as an indication of origin of the proprietor's services.

Regarding the document submitted by the proprietor as Annex 10, the Cancellation Division notes that it merely mentions under 'Activities planned for 2021' (page 190) that 'branding studies were executed with the Turkaegean and Turkish Riviera-Eastern Mediterranean films'. As regards Annex 11 the Cancellation Division notes that document was published in Turkish.

In essence, no sufficiently clear and conclusive evidence has been filed as to the perception of the relevant public in the Member States of the European Union where English is the official language (Ireland and Malta) or in the Member States where English is adequately understood (as the Netherlands, Denmark, Finland, Sweden and Cyprus), nor were there sufficient arguments in that respect.

The Cancellation Division concludes that the EUTM proprietor has not sufficiently demonstrated that the EUTM had acquired distinctive character in relation to the contested

services (neither before its filing date nor before the filing date of the application for invalidity) and that, therefore, the claim of acquired distinctiveness under Article 7(3) EUTMR (insofar as the proprietor's submission can be considered as such) has to be dismissed.

### **Conclusion**

The contested mark was found to be descriptive pursuant to Article 59(1)(a) EUTMR in conjunction with Article 7(1)(c) EUTMR and non-distinctive pursuant to Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b) EUTMR in relation to all of the contested services at the time of its filing. The EUTM proprietor has not demonstrated that the mark had acquired distinctive character either before its filing date or before the filing date of the application for invalidity.

In light of the above, the application is completely successful, and the contested mark is declared invalid for all the contested services.

As the application is entirely successful on the grounds of Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b) and (c) EUTMR, it is not necessary to examine the remaining grounds on which the application is based.

### **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 EUTM proprietor is the losing party, it must bear the cancellation fee as well as the costs incurred by the applicant 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 applicant are the cancellation fee and the representation costs, which are to be fixed on the basis of the maximum rate set therein.



### **The Cancellation Division**

Nicole CLARKE

Thorsten ICKENROTH

Natascha GALPERIN

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.