

# GULDE & PARTNER

NEWSLETTER  
Trademarks &  
Designs

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## Practical Tips for Right Holders

### *Using EU Trademarks*

**Ensuring ongoing protection of your EU trade mark requires genuine use in the form in which it was registered. We summarize key scenarios and offer straightforward tips for right holders to keep marks alive across the EU.**

Maintaining EU trade mark rights requires genuine use of the mark in the form in which it was registered and in connection with the goods or services listed in the registration. Minor adjustments such as a slightly different font, orientation or color scheme are generally tolerated by the EUIPO provided that the distinctive character of the mark remains unchanged and the average consumer still recognizes the mark as identical to the registered version. However, introducing new graphical elements or dramatically altering the mark's appearance risks it being treated as a different mark, which may jeopardize your protection.

Right holders often wonder whether limited use on a subset of goods or services suffices to keep the entire registration alive. In practice, use of the mark on a clearly defined subgroup – for example “organic teas” within the broader category “beverages” – will maintain protection for that subgroup and, in most cases, for the entire class, so long as the subgroup is contained within and closely related to the wider category. To avoid any argument about fragmentation, it is advisable to ensure that your branding appears uniformly across all product lines covered by the registration, even if you focus your commercial efforts on particular segments.

When it comes to second-hand or refurbished goods, genuine use can be demonstrated by your own sales of certified pre-owned items under the registered mark, especially if you control the refurbishment process or certify quality standards. Unauthorized resellers offering used goods bearing your trade mark do not count



as use by the right holder. Establishing a formal certification or refurbishment program under your direct supervision not only demonstrates continuous use but also enhances consumer confidence in the quality of pre-owned products.

Import and export scenarios also play a critical role in maintaining EU trade mark rights. Affixing your mark to goods intended solely for export outside the EU qualifies as genuine use, even if those goods do not enter the internal market. Conversely, importing marked goods into the EU only counts when you, as the right holder, or your authorized distributors actively participate in or have expressly approved the importation.

To ensure clarity, enter into written authorization agreements with any third-party importers and retain records of your involvement in the logistics or quality control of imported goods.

## Key Take-aways for EU Trade Mark Owners

- *Document every use with dated samples (labels, invoices, website screenshots)*
- *Keep core mark elements consistent across minor design updates*
- *Control pre-owned and refurbished channels through formal certification programs*
- *Use written authorizations for any third-party imports to demonstrate genuine use*

EGC, T-426/23 – Chiquita Brands vs. EUIPO

## *When Figurative Marks Fall Flat – Lessons from the Chiquita Case*

In today's crowded marketplace, a trade mark's visual appeal must go hand in hand with unmistakable distinctiveness. The European General Court's recent Chiquita decision underscores that familiar shapes and color schemes may not suffice to signal origin on their own – even when long associated with a brand. This case serves as a timely reminder for EU trade mark owners to embed unique graphic elements and robust evidence of standalone recognition into their branding strategies.

In 2008, *Chiquita Brands* registered an EU figurative trade mark for “fresh fruits” (Class 31) depicting three superposed ovals intended for application on labels and packaging:



In 2020, the *Compagnie financière de participation* sought cancellation before the EUIPO, arguing lack of distinctive character. The Cancellation Division as well as the Board of Appeal agreed with the applicant. In its judgment of 11 November 2024 (T-426/23), the General Court upheld the invalidation, finding the trade mark inherently non-distinctive and failing the test for acquired distinctiveness.

The Court found the mark to be “a minor variation of an oval, that is to say a basic geometric shape devoid of any unexpected or memorable features” and noted that such ovals are “customarily used in the fresh-fruit sector” because they “are practical for labelling curved surfaces like bananas.” Moreover, the blue-and-yellow palette was held to consist of “primary colors [...]

frequently used in connection with ‘fresh fruits’, so that neither the shape nor the colors could, on their own, create the “visual or conceptual gap” needed to signal origin to the average EU consumer.

Turning to acquired distinctiveness, the Court examined Chiquita's evidentiary dossier in minute detail. Although Chiquita submitted national sales figures, advertising spend and consumer survey results, these all related to just four Member States (Belgium, Germany, Italy and Sweden) and, crucially, “consistently showed the device alongside other elements (for example the word ‘Chiquita’)” rather than in isolation. The Court also criticized Chiquita's survey methodology: by asking respondents “To which fruit brand would you associate this logo?,” the survey “presupposed that the sign was already perceived as a brand logo,” thereby undermining its probative value. Absent convincing, EU-wide evidence that consumers identify the oval device alone as an indication of origin, the Court concluded that acquired distinctiveness had not been demonstrated.

In the meantime, the court has confirmed its strict case law on figurative marks by denying the distinctive character of the silhouette of the well-known HARIBO gold bear with similar arguments (judgment of July 16, 2025, T-215/24).

### **Key Take-aways for EU Trade Mark Owners**

- *Design with distinction: ensure device marks include unexpected contours or motifs, not just basic geometric elements.*
- *Avoid common palettes: primary or industry-standard colors, such as blue and yellow in the fresh-fruit sector, seldom confer distinctiveness alone.*
- *Gather EU-wide, standalone proof: collect consumer surveys and usage examples from multiple Member States showing the device in isolation.*



## Design Law

*Overall impressive – Recent decisions on individual character*

An EU design enjoys protection if it is new and has individual character. The latter is the case if the design produces a different overall impression on the informed user compared to the prior art. Three clarifying decisions have recently been issued on this consistently challenging issue.

**EGC, T-614/23 – Praha Alfa-Med/EUIPO**

The General Court held in its decision of 13 November 2024 that, when comparing the overall impression of an EU design, only those features visible in the registered representations may be taken into account; non-visible technical or functional aspects fall outside the assessment. The dispute concerned a cuboid control unit with a transparent housing, a lamp shaped like two connected bulbs and “broad legs”. Variations in concealed elements – such as recessed screens or internal buttons – were deemed purely technical and did not influence the design comparison.



The ruling confirms that non-visible characteristics may be considered only if they can be directly inferred from the submitted images. Right holders relying on specific features of earlier designs must ensure those elements are clearly depicted in their filings.

**EGC, T-464/23 – Lidl Digital International/ EUIPO**

When assessing the overall impression of a design, the designer's freedom of design for a specific product needs to be taken into account. According to the General Court's decision of 20 November 2024, the degree of freedom for lamp designer is high when it comes to its individual parts, but only average when it comes to the lamp as a whole.

Furthermore, features that fulfill a technical function but whose appearance is not exclusively determined by technical considerations – such as the wall mounting in the present case – cannot be excluded when comparing the overall impressions of two designs.

**Higher Regional Court Frankfurt, 6 U 27/23 – WC-Bürste**

In proceedings before the Frankfurt Higher Regional Court, the plaintiff claimed infringement of its German design



by the following toilet brushes:



The court granted relief and based its decision on a medium degree of designer's freedom for toilet brushes. In particular, coloration – in contrast to design – plays only a minor role in the overall impression, according to the court.

The court did not treat the CAD-generated images as black-and-white line drawings, but took their gray tones into account. Design applicants should therefore use drawings, as these capture all color designs and thus offer the broadest scope of protection.

## Design Law

### *Towards Greater Harmonization – The Riyadh Design Law Treaty*

In November 2024, member states of the World Intellectual Property Organization (WIPO) adopted the Design Law Treaty (DLT) in Riyadh, with the goal of harmonizing formal procedures for the registration of industrial designs. The treaty provides a unified framework to reduce administrative complexity and increase legal certainty – particularly beneficial for SMEs, individual designers, and multinational businesses operating across jurisdictions.

#### Key Features of the DLT

##### *Streamlined Application Requirements*

The treaty introduces a closed list of required elements for a design application:

- Request for registration
- Name and contact details of the applicant
- Name and contact details of representative (if any)
- Address for service (if required)
- Representation of the design
- Indication of the product
- Priority claim and supporting documents (if applicable)
- Payment of fees

No additional elements may be required, unless explicitly permitted by the Regulations (e.g., brief description, disclaimer, or claim). This framework limits arbitrary national requirements.

##### *Clear Rules for Filing Date*

A filing date must be granted if the office receives:

- An express or implied indication that registration is sought,
- A representation of the design, and
- Information sufficient to identify and contact the applicant.

This prevents loss of rights due to procedural issues and brings much-needed legal certainty.

##### *Mandatory Grace Period*

Each contracting party must provide a grace period of either 6 or 12 months for disclosures made by the applicant or a third party who obtained the design from the applicant. This enables market testing and disclosure without jeopardizing protection.

##### *Deferment of Publication*

National laws must permit applicants to defer publication of the design for a minimum of 6 months from the filing or priority date, preserving confidentiality during critical development phases.

##### *Procedural Safeguards*

The treaty obliges offices to offer relief mechanisms, such as:

- Continued processing for unintentional missed deadlines, and
- Reinstatement of rights if deadlines are missed despite due care.

##### *Abolition of Legalization and Certification Requirements*

Contracting parties may no longer require legalized signatures or certified translations in most cases, eliminating a major administrative burden for cross-border applicants.

##### *Flexibility in Representation*

Designs can be represented by photographs, drawings, combinations thereof, or other acceptable formats. Applicants may

also use visual or verbal disclaimers to clarify what is claimed.

#### Unresolved Questions and Path to Ratification

While the DLT introduces significant procedural progress, several issues remain open. The treaty does not address substantive design law, such as the criteria for novelty or originality, nor does it impose a minimum term of protection. The use of group applications or WIPO's Digital Access Service (DAS) remains optional. Provisions relating to the disclosure of traditional cultural expressions, genetic resources, or traditional knowledge are also not fully defined and left to national discretion.

For the treaty to enter into force, at least fifteen contracting states must ratify or accede to it. Until that threshold is reached, the DLT remains a framework for future alignment rather than binding law.

#### Conclusion

The Design Law Treaty is a welcome development in international intellectual property law. It promises simpler, more transparent registration procedures across jurisdictions and aligns national systems under a shared procedural baseline. While much depends on national implementation and ratification, the DLT lays the groundwork for more accessible and efficient global design protection.





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