



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

Trade Marks Department

**DECISION
of the Cancellation Division
of 24/05/2006**

IN THE JOINED PROCEEDINGS FOR A DECLARATION OF INVALIDITY

OHIM reference number 831C 000733311, 841C 00733311

Community trade mark: 000733311 FAZER

Language of the proceedings: English

APPLICANTS

Karl Johan Fazer
Hahkialantie 30 as 1
14700 Hauho
Finland

**Karl Fredrik Fazer and
Karl Otto Fazer**
Grönby Skogshult
23172 Anderslöv
Sweden

REPRESENTATIVE

**Borenus & Kempainen Attorneys
at law Ltd**
Yrjönkatu 13 A
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against

**COMMUNITY TRADE MARK
PROPRIETOR**

USP Brands Ltd
Clayton Works
Pepper Road
Leeds LS 10 2EU
United Kingdom

REPRESENTATIVE

Bailey Walsh & Co LLP
5 York Place
Leeds, West Yorkshire LS1 2SD
United Kingdom

THE CANCELLATION DIVISION

composed of Karin Kuhl, Wouter Verburg, Julia García Murillo has taken the following decision on 23/05/2006

- 1. The registration of Community trade mark No. 733 311 (FAZER) is declared invalid.**
- 2. The costs of the applicants shall be borne by the CTM proprietor.**

And has fixed the costs as follows:

The amount of costs to be paid by the CTM proprietor to the applicants pursuant to Article 81(6) CTMR in conjunction with Rule 94(3) IR shall be 2300 euro, corresponding to two invalidity fees (2x EUR 700) and representation costs (2x EUR 450).

FACTS AND ARGUMENTS

(1) On 04/03/2004 Karl Johan Fazer filed a request for a declaration of invalidity based on relative grounds against Community trade mark No 733 311, FAZER (word mark).

(2) On 04/03/2004 Karl Fredrik Fazer and Karl Otto Fazer filed a request for a declaration of invalidity based on relative grounds against Community trade mark No 733 311, FAZER (word mark).

(3) 04/03/2004, together with the requests for a declaration of invalidity, the applicants requested the proceedings be joined according to Rule 41 IR.

(4) On 14/04/2004 the Office decided to deal with both requests for declaration of invalidity in one set of proceedings.

(5) The Community trade mark was applied for on 26/01/1998 and registered on 10/07/2003. The mark is registered for:

“Luggage, bags, hand bags, holdalls, wallets, trunks and travelling bags, articles of leather and imitation leather, umbrellas, parasols, walking sticks and shooting sticks; all being golfing products or products for use in the game of golf “(class 18);

“Golf clubs, golf bags, golf balls, golf club covers, golf club grips, golf club heads, golf club shafts, golf gloves, golf mats, golf tees, golf equipment, golf games, toy golf clubs, parts and fittings for the aforesaid goods” (class 28)

(6) The applicants based their request on relative grounds. The request is based on Article 52(2) CTMR, namely on a right to a name.

(7) The applicants, in essence, claim the following:

- The contested CTM registration should be declared invalid under Article 52(2) CTMR on the grounds that the applicants, who are natural persons with the surname “Fazer” and domiciled in Sweden (Karl Fredrik and Karl Otto) and in Finland (Karl Johan) are entitled to obtain, among other remedies, a prohibition to use the contested Mark pursuant to the national laws of Sweden and Finland.
- Under the Swedish and Finnish law, an existing family name is *prima facie* both a ground for refusal during the registration procedure and also a ground for a declaration of invalidity.
- There are two holders of the family name “Fazer” in Sweden, namely, Karl Fredrik Fazer and Karl Otto Fazer with a permanent residence in Sweden and consequently they have prior rights to the name “Fazer” in Sweden.
- In Finland several members of the Fazer family name are well-known figures in their own right, further enhancing the recognition of the family name. The applicant Karl Johan Fazer enclosed press articles from the Finnish newspapers to establish the recognition of the family name “Fazer” in Finland.

(8) The arguments of the proprietor of the Community trade mark, in essence, are the following:

- The applicants have not proved that the use of the CTM is prohibited pursuant to national law governing the protection of an earlier right.
- The right to a name in Article 52(2) CTMR and Article 4(c)(i) of the Trade Marks Directive (“TMD”) means the right to protect an interest associated with a name and not a name *simpliciter*.
- The applicants’ contentions on Finnish and Swedish trade mark are wrong and even if it was not wrong the, Community law would prevail.
- The third Board of Appeal has already decided that such protection as is afforded for the family name “Fazer” by Finnish and Swedish law would not prevent use of CTM and the Swedish applicants have no legal capacity to act in these proceedings.

GROUNDINGS FOR THE DECISION

On the admissibility of the request

(9) According to Article 52(4) CTMR where the proprietor of one of the rights referred to in paragraphs 1 or 2 has previously applied for a declaration that a Community trade mark is invalid or made a counterclaim in infringement proceedings, he may not submit a new application for a declaration of invalidity or lodge a counterclaim on the basis of another of the said rights which he could have invoked in support of his first application or counterclaim.

(10) The proprietor claims that the third Board of Appeal has already decided that protection as is afforded for the family name "Fazer" by Finnish and Swedish law would not prevent use of CTM.

(11) The Third Board of Appeal decided on 16/10/2002 in case R 175/2002-3 (*Fazer*) to dismiss the appeal on the grounds, *inter alia*, that the opponent (Oy Karl Fazer AB) has not provided evidence of how, according to the laws of Finland, Sweden and Denmark, the trade name "Oy Karl Fazer AB or the name "FAZER" would be protected (*emphasis added*).

(12) It should be noted that the reference decision was based on claim under Article 8(4) CTMR and the Board of Appeal even underlined this fact by stating that "the right to a name cannot be constructed as a sign in the course of trade since Article 52(1)(c) and (2) CTMR makes a clear distinction between a right to a name and sign used in the course of trade.

(13) It should further be noted that the opponent in the Case R 175/2002-3 was Oy Karl Fazer Ab and not the applicants in the current proceedings, namely Karl Fredrik Fazer, Karl Otto Fazer and Karl Johan Fazer.

(14) In any event, the fact that the Opposition Division has issued a decision relating to the challenged Community trade mark does not exclude that once the trade mark is registered a cancellation action is filed on the same grounds and between the same parties. The principle of *res judicata* has not been foreseen in such circumstances in the Community trade mark Law.

(15) The request complies with the formalities prescribed in the CTMR and in Commission Regulation (EC) No 2868/95 implementing the CTMR ("IR") (OJ OHIM 2-3/95, p. 258) the Implementing Regulation and is, therefore, admissible.

On the substance

Legal capacity of Karl Fredrik Fazer and Karl Otto Fazer.

(16) The proprietor contests the legal capacity of *Karl Fredrik Fazer and Karl Otto Fazer* to act in these proceedings.

(17) According to Article 55 (1)(c) CTMR an application for revocation of the rights of the proprietor of a Community trade mark or for a declaration that the trade mark is invalid may be submitted where Article 52(2) applies, ...by the persons who are entitled under the national law of the Member State concerned to exercise the rights in question.

(19) The applicants contested this finding and made a reference to both Finnish and Swedish Child Custody and Parents Act.

(20) According to the Swedish Parents Act (Föräldrabalken SFS 1949:381) both parents shall act as the guardians in relation to children under custody of both parents.

(21) Together with the request for declaration of invalidity *Karl Fredrik Fazer and Karl Otto Fazer* submitted a power of attorney signed by both parents Karl Johan Fazer and Marina Rudnäs. The *locus standi* of the parents was also proved by the population extracts.

(22) Therefore it has been proven that *Karl Fredrik Fazer and Karl Otto Fazer* have been legally represented by their parents. Moreover, it has not been proven why the under aged children cannot exercise their rights if this is authorised by their legal custodians.

The right to a name in Article 52(2) CTMR and Article 4(c)(i) of the Trade Marks Directive ("TMD").

(23) According to the Article 4 (4)(c)(i) of the First Directive 89/1004/EEC of the Council of 21 December 1988 to approximate the laws of the Member States relating to trade marks, the use of the trade mark may be prohibited by virtue of an earlier right other than the rights referred to in paragraphs 2 and 4 (b) and in particular: (i) a right to a name.

(24) According to the proprietor, the right to a name in Article 52(2) CTMR and Article 4(c)(i) of the Trade Marks Directive ("TMD") means the right to protect an interest associated with a name such as trade's goodwill or a celebrity's reputation and not a name *simpliciter*. His main argument is that the context in which subparagraph (i) occurs strongly suggests that the right to a name would protect such an interest. The Cancellation Division has sympathy for this point of view. However, the text of Article 52(2)(a) CTMR does not leave any room for interpretation. If the use of a trade mark may be prohibited

pursuant to the national law governing the protection of a right to a name, the Community trade mark shall be declared invalid.

(25) According to the proprietor the grounds on which a registered trade mark would be declared invalid would be the same in all member states. However, this is contrary to the wording of the Article 4 TMD which clearly stipulates that “any Member State may furthermore provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that the use of the trade mark may be prohibited by virtue of an earlier right other than the rights referred to in paragraphs 2 and 4 (b) and in particular a right to a name...”.

(26) Therefore it is clear that the legislator has explicitly allowed Member States to retain some of their national laws.

(27) In light of the analysis mentioned above there is no reason to decide if Community law should prevail or not as the legislator included the possibility for the Member States to retain some of their national laws insofar as they do not contradict Community law. As the “right to a name” is explicitly mentioned in the Community law it would seem from the facts as presented by the applicants that the Finnish and Swedish laws protecting names *per se* are in line with the Community law.

Right to a name

(28) In accordance with Article 52(2)(a) CTMR, a Community trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings where the use of such trade mark may be prohibited pursuant to the national law governing the protection of any other earlier right and in particular (...) a right to a name.

(29) The Office treats the law of the Member State applicable by virtue of Article 52(2) CTMR as an issue of fact, i.e. the same principle applies as in International Private Law. Hence, pursuant to Article 74(1) CTMR it is for the party relying on a right to a name within Article 52(2) CTMR to provide the Office with the necessary details on how the respective national law stands, and what the required elements for establishing the respective right are.

(30) The applicants make express references to provisions of Finnish and Swedish law, and to national case law, as mentioned hereafter. According to the applicants, under both Finnish and Swedish trade mark law a trade mark must be declared invalid if it includes a name. There is no requirement that this name has been used in the course of trade or that it must have acquired repute or goodwill in order to be successfully invoked.

Finland:

- Section 3 of the Finnish Trademarks Act (7/1964 as amended) mentions that “the name or trade name of another may not be included in a trade mark”.
- Section 14 of the Finnish Trademarks Act (7/1964 as amended) mentions under (4) that a trade mark shall not be registered if it is composed of or contains anything likely to give the impression of ... being the name ... of another person.
- Section 25 the Act mentions that “if a trade mark has been registered in breach of the provisions of this Act, the registration shall be declared null and void unless the provisions of section 8 or 9 apply...”
- On page 8 of Finnish Government’s proposal 37/83 it is stated that the protection of a surname extends as far as the right to a surname, regardless of whether the person is engaged in business activities. (A “Government’s proposal” (in Finnish Hallituksen esitys) is the text accompanying the draft bill submitted to the Parliament prior to its enactment.
- In a decision of 6 October 1997 (KKO:1997:150, concerning a trade name ‘Homer’), the Finnish Supreme Court stated that the legislative materials relating to the analogous Section of the Trade Marks Act provide that the intention of the prohibition is to protect another’s right to his or her name so that it may not be attached to a trade mark of a third-party undertaking and thus bring about a presumption that the surname holder would have a connection to such undertaking using the mark. It invalidated the trade name ‘Homer’s bar Maunula Oy’ on the basis of the name ‘Eila Homer’.
- In case KKO: 1988:131 (*Vanto*) the Supreme Court of Finland prohibited the defendant to use an unregistered trade mark Wanto because it contained a Finnish surname Vanto.
- In case KHO 2380/55/78 (*Gil Bret*) the Supreme Administrative Court held that the applied trade mark GIL BRET could not be registered because the last name “Brett” was in use in Finland.

Sweden:

- Section 14(1)(4) of the Swedish Act (1960:644 as amended) mentions that if the mark contains or consists of elements which are likely to convey the impression of being another person’s trade name or the family name, artistic name or similar name of another person, or another person’s portrait, unless the name or the portrait obviously relates to a person who is long deceased, it shall be invalidated.
- Section 26 “anyone who suffers injury from a registration is entitled to bring an action in Court for the invalidation of the registration...”
- Section 25 “if a trade mark has been registered contrary to the provisions of this Act and the ground for refusing the registration still exists, the registration may be invalidated in the manner

stated below, unless the right in the mark may nevertheless be allowed to continue to exist under Articles 8 and 9...”

- In case RÅ 1991 ref. 26 (*Lerner*) the Supreme Administrative Court prohibited “Lerno Inc.” to register trade mark “LERNER” because it contained the family name “Lerner”.
- In case RÅ 1981 2:77 (*Bredel*) the Swedish Court of Patent Appeals had in the first appellate instance prohibited Bredel Machine- en Constructiebedrijf B.V. to register the trade mark “BREDEL” because it contained the family name “Bredel”. In this case the applicant also had previous registrations in the Benelux, among others.

(31) The applicants also indicate that no legal protection is extended to last names which have a secondary meaning in the standard language as such names would not be “likely to give the impression of” being last names as stipulated in Section 14(1)(4).

(32) It is noted that the last name “Fazer” is not associated with any such meaning in the Finnish language, either expressly or connotatively. The applicants enclosed, as proof, an excerpt from the Finnish Standard Language Dictionary (Suomen kielen perussanakirja) that shows that there are no dictionary references for identical or similar words.

(33) The applicants further stated that the Sections 8 and 9 referred to in Section 25 relate to instances where a proprietor of an earlier trade mark may lose its right to seek declaration of invalidity due to acquiescing in the use of the later mark, unregistered or alternatively registered, respectively.

(34) The applicants submitted copies, duly translated into the language of the proceedings, from the national population authorities that the applicants in Sweden (Karl Fredrik and Karl Otto) and in Finland (Karl Johan) are resident in these countries.

(35) The proprietor denied that the applicants have made out their case and argues that the submissions do not show that under the Swedish or Finnish national laws the CTM would not have been registered or that it would have been declared invalid if it had been. However, the proprietor did not present evidence which would give raise to doubts as to the veracity of the evidence of the applicants.

(36) On the basis of what has been presented by the parties as evidence the Cancellation Division considers that it can be concluded that a surname *per se* is an object of legal protection under the Finnish and Swedish trade mark law. A trade mark may be declared invalid where an identical or closely similar surname exists, and the use of such trade mark may be prohibited pursuant to the national laws.

(37) The CTM proprietor did not show that there are circumstances which would exclude the application of Section 25 of the respective national laws.

(38) It can be concluded from the copies of the population registers and from various newspaper articles that the surname FAZER is in use as a surname in Finland and Sweden.

(39) The contested CTM is FAZER, identical to the surname FAZER of the applicants. In view of the above, the contested CTM registration must be invalidated.

COSTS

(40) Pursuant to Article 81(1) CTMR and Rule 94 IR, the party losing cancellation proceedings shall bear the fees and costs of the other party. As the CTM is invalidated for all goods, the proprietor is the losing party.

THE CANCELLATION DIVISION

Karin Kuhl

Wouter Verburg

Julia García Murillo

Notice on the availability of an appeal:

Under Article 58 of the Community Trade Mark Regulation any party adversely affected by this decision has a right to appeal against this decision. Under Article 59 of the Regulation notice of appeal must be filed in writing at the Office within two months from the date of notification of this decision and within four months from the same date a written statement of the grounds of appeal must be filed. The notice of appeal will be deemed to be filed only when the appeal fee of 800 euro has been paid.

Notice on the review of the fixation of costs:

The amount determined in the fixation of the costs may only be reviewed by a decision of the Cancellation Division on request. Under Rule 94 (4) of the Implementing Regulation such a request must be filed within one month from the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of 100 euro (Article 2 point 30 of the Fees Regulation) has been paid.