



# **BOARDS OF APPEAL**



## **DOCUMENTATION AND SUPPORT SERVICE**

**Yearly overview of  
decisions 2006**



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## I. INTRODUCTION

In 2006, the Boards of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs) rendered 1657 decisions on appeal cases. One thousand of these decisions were taken in *inter-partes* cases and 657 in *ex parte* proceedings. Taking into account these numerous decisions, keeping oneself informed about the development of case-law of the Boards of Appeal, can present a challenge. The 2006 overview of case-law, created by the Documentation and Support Service of the Boards of Appeal, is intended to help users in this task.

The overview is structured according to various legal issues, such as procedural issues or grounds for refusal. It contains references to selected decisions of the Boards of Appeal which have been rendered in 2006 in these areas.

The reader can go directly to the section of interest by clicking on the relevant section in the index. All decisions of the Boards of Appeal cited in the document can be found in the database regarding decisions of the Boards of Appeal at the following link: [http://oami.europa.eu/search/LegalDocs/la/en\\_BoA\\_index.cfm](http://oami.europa.eu/search/LegalDocs/la/en_BoA_index.cfm).

THE PRESENT DOCUMENT WAS ESTABLISHED UNDER THE SOLE RESPONSIBILITY OF THE DOCUMENTATION AND SUPPORT SERVICE OF THE BOARDS OF APPEAL AND IS INTENDED FOR INFORMATION PURPOSES ONLY. NO STATEMENT CAN BE CONSIDERED AS BINDING ON THE BOARDS OR IMPACT ON ANY OF THE DECISIONS TAKEN BY THEM.



## **II. DECISIONS OF THE GRAND BOARD**

The legal basis for a Grand Board of Appeal (then called the Enlarged Board) was laid down in Council Regulation (EC) No 422/2004 of 19 February 2004 amending Article 130 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community Trade Mark ('CTMR'). Commission Regulation (EC) No 2082/2004 of 6 December 2004 amended the Rules of Procedure of the Boards of Appeal, including the rules for a Grand Board, such as its composition and the rules of referral of cases to it.

In 2006, the Grand Board took its first three decisions on different issues, namely the withdrawal of an application, the refusal based on accepted principles of morality and the invalidity of a shape which is necessary to obtain a technical result.

In **R 0331/2006-G OPTIMA**, the Grand Board clarified that it is permissible to withdraw a CTM application during any phase of the examination proceedings. This follows from the use of the term 'at any time' in Article 44(1) CTMR. The CTM application can also be withdrawn within the two-month appeal period without it being necessary to raise an appeal against the decision of the examiner. See also section III.C.

In **R 0495/2005-G SCREW YOU**, the Grand Board examined the concept of 'accepted principles of morality' in Article 7(1)(f) CTMR in relation to a word mark consisting of a vulgar interjection. For details, see section IV.D.1 – Article 7(1)(f) CTMR.

In **R 0856/2004-G SHAPE OF LEGO BRICK – 3D**, the Grand Board confirmed the invalidity of the registration of the shape of a brick for construction toys, based on Article 7(1)(e) and 51(1)(a) CTMR, see section IV.C – Article 7(1)(e) CTMR.



### III. PROCEDURAL MATTERS

#### A. *Admissibility of the appeal*

##### 1. **Appealable decision; Statement of grounds, *Restitutio in integrum***

###### a) **Appealable decisions (Art. 57 CTMR)**

Under Article 57 CTMR, a decision of an OHIM department can be appealed separately, if it terminates proceedings as regards one of the parties or if the decision allows a separate appeal. Whether a document constitutes a decision that terminates proceedings depends on its substance and not on its form. In **R 0331/2006-G OPTIMA**, the Grand Board considered that the examiner's letter informing the applicant that the application had been rejected in its entirety and that following the rejection of the application, there was nothing left to be withdrawn, was the notification of a decision subject to appeal. The letter informed the applicant for the first time that its request for the withdrawal of its application was refused. This letter constituted the notification of a decision that terminated proceedings as regards the applicant in this respect, even if it did not contain any communication in the sense of Rule 52(2) of Commission Regulation (EC) No 2868/95 implementing the CTMR ('CTMIR'), indicating that an appeal could be filed. [vid. Also **R 1411/2005-1 Eurostile**; **R 0274/2006-1 Cup (fig.)**]

##### 2. **Statement of grounds (Art. 59 CTMR)**

According to Article 59 CTMR, a written statement setting out the grounds of appeal must be filed within four months from the date of notification of the contested decision. The Boards consider the statement of grounds necessary in order to understand why the appellant claims that the contested decision is erroneous; therefore appeals without a statement of grounds or with a belated statement of grounds are rejected as inadmissible (see *inter alia* **R 1043/2005-2 HAVANA NIGHT / HAVANA CLUB**, **R 0091/2005-2 ECOTEL / ECOTEL (fig.) et al.**, **R 0396/2006-4 PIECES ACCESOIRES** etc.).

Following the case-law of the Court of First Instance of the European Communities ('CFI') in Case T-112/03 *L'Oréal SA v OHIM* ('Flexi Air'), the Boards have accepted a plea of non-use, which is the sole substantive part of the statement of grounds, as sufficient under Article 59 CTMR (see **R 0440/2004-4 RODEO / RODEO et al.**).

##### 3. ***Restitutio in integrum* / Continuation of the proceedings**

###### a) ***Restitutio in integrum* (Article 78 CTMR)**

In relation to *restitutio in integrum*, in 2006 the Boards confirmed that an extraneous event which happens beyond the party's control and is not a direct consequence of the breakdown of internal procedures for sending communications to the Office can justify the granting of *restitutio in integrum*. This can be the case if there is a nationwide transport strike in Spain which occurs with little warning (see case **R 1240/2005-1 TOMMY K (fig.) / THOY et al.**).

The Boards also confirmed the necessity to observe all due care required by the circumstances. An error in law committed by a professional representative does not constitute a ground for *restitutio in integrum* (see Cases **R 1027/2006-4 MISSION HILL**, **R 0628/2006-2 SIDESCAN** and **R 0074/2006-1 NEURIM pharmaceuticals (fig.) / EURIM-PHARM**). Exceptions to this rule might be considered when the law is unclear or the Office gives misleading information (see Case **R 1027/2006-4 MISSION HILL**).



**b) Continuation of the proceedings (Article 78a CTMR)**

Article 78a CTMR was inserted under Council Regulation (EC) No 422/2004. When a party to proceedings before the Office has omitted to observe a time-limit vis-à-vis the Office, it may, upon request, obtain the continuation of proceedings, provided that at the time the request is made the omitted act has been carried out. A continuation of the proceedings was accepted by the Boards in **R 0269/2006-4 ATEENWORLD**, where the applicant missed the time-limit to file a translation of the statement of grounds into the language of proceedings. The Board stressed that, while the time-limit for filing a statement of grounds is excluded from further processing (Art. 78a (2) CTMR), the time-limit for filing a translation under Rule 96(1) CTMR is not. It considered that Article 78a(2) CTMR has to be interpreted literally, that is, limited to the time-limits expressly mentioned or referred to in that provision, and cannot be extended to any other time-limit.

A continuation of proceedings is excluded for the time-limits laid down in Article 59 CTMR. This is confirmed by the Boards in **R 1151/2006-2 Á ANDALUS (fig.) / AL ANDALUS**.

**B. New facts, arguments, grounds or evidence**

**1. Not accepted before the Board**

Article 74(2) CTMR suggests that the Boards have 'discretion' as to whether to accept any facts or evidence submitted after the prescribed time-limits. In various cases in 2006, the Boards considered that discretion should not be exercised in any way which may run counter to the requirement of legal certainty or the need to avoid arbitrary or discriminatory treatment in the administration of the CTMR. Time-limits may be put aside only where there are compelling reasons for doing so (see e.g. case **R 1105/2004-2 MAN SITTING ON BOARD (fig.) / MAN SITTING ON BOARD (fig.)**; **R 0421/2005-2 GIORDANO (fig.) / GIORDANO**).

In many cases the Boards have not admitted new evidence submitted for the first time during the appeal proceedings where this evidence could already have been submitted before the first instance and the party does not provide convincing reasons why the evidence should be admitted. (see e.g. Case **R 1131/2005-1 OFF SHORE / OFF SHORE (fig.)**, and **R 1105/2004-2 MAN SITTING ON BOARD (fig.) / MAN SITTING ON BOARD (fig.)**).

In accordance with their practice and the case-law of the Court of First Instance in Case T-112/03 *L'Oréal SA v OHIM* ('Flexi Air'), which states that the applicant should, in principle, request proof of genuine use of the earlier mark within the time-limit set by the first instance, the Boards refused the request for proof of use made before them for the first time. This is illustrated in Cases **R 0035/2005-1 AGRO-LINE / AGROLIMEN**, **R 0591/2006-2 FIDES (fig.) / FIDES-QUIMICA et al.**, **R 0085/2004-4 Premium Max / Premium (fig.)** and **R 0440/2004-4 RODEO / RODEO et al.**

**2. Accepted before the Board**

**a) Additional or supplementary facts/evidence**

Making use of their discretionary power under Article 74(2) CTMR, the Boards have, on various occasions, admitted evidence produced before them for the first time, for example where it consisted in additional or supplementary evidence, completing the evidence already filed within the time-limits before the first instance. In **R 1433/2005-2 ISY PIL / EASY PEEL**, the Board accepted complementary evidence regarding the change of ownership of the earlier right, filed with the statement of the grounds of appeal, which completed the documentary evidence filed on time before the Opposition Division (in the same sense



**R 0860/2006-1 Chron / Kron**). In **R 1150/2005-1 MAGISTER BIBENDI (fig.) / BIBENDUM**, the registration certificate submitted by the opponent merely confirmed its previous submissions and complemented previously filed evidence, namely an excerpt of a private database which contained all relevant data (the status of the mark, the date of filing, the date of registration, the number, the goods covered and the data of the owner and the agent) (see in the same sense **R 0926/2004-1 MONTANA (fig.) / Montana**).

**b) New facts/evidence**

Various Board of Appeal decisions have allowed the submission of new evidence which could not be submitted at first instance, or evidence submitted in response to an argument on which the parties had not had an opportunity to express themselves at first instance. In the latter case, the refusal of such evidence might constitute an infringement of the rights of defence. In **R 0654/2005-1 REPORTER / REPORT**, for example, the Boards admitted the new evidence provided by the opponent showing the descriptive use of a term because it had been provided in response to a line of reasoning advanced *ex officio* by the Opposition Division in the contested decision to which the opponent was not given the opportunity to respond and which it did not become aware of until it was notified of the decision. In **R 1106/2000-2 GSM OFFICE / GSM**, the contested decision contained a reference to the lack of distinctive character or the very weak distinctive character of the earlier trade mark, without the opponent having been given the opportunity to submit observations in respect of a ground that would form the basis of rejection of the opposition. Before the Board, the opponent submitted evidence and proved that most of the European telecommunication operators use the trade mark 'GSM' through licence agreements. The opponent was not given the opportunity to demonstrate these facts before the OD.

In **R 0384/2005-1 JLC ANDIN'SCRISTAL (fig.) / CRISTAL et al.**, the Boards accepted copies of national decisions produced for the first time in the appeal proceedings. The Boards considered that these documents did not serve as evidence in the narrow sense, but concerned case-law to which a party is entitled to refer, even after the procedure before the first instance (see also CFI judgment of 8 December 2005 in Case T-29/04 Castellblanch, SA v OHIM, 'Cristal Castellblanch', paragraph 16).

**C. Withdrawals**

A Community trade mark application may be withdrawn at any time (Article 44 CTMR). According to the Grand Board's interpretation, this withdrawal is possible even if it is declared within the appeal period without an appeal having been filed. A decision refusing a CTM application only becomes effective if no appeal is filed before the end of the appeal deadline, if the right of appeal is waived or if the appeal is ultimately unsuccessful. In particular, it is not necessary to file an appeal merely for the purpose of withdrawing the application (see decision of the Grand Board in **R 0331/2006-G Optima**). Previous decisions of the Boards in the same sense: Case **R 0348/2004-2 'BELEBT GEIST UND KÖRPER'**, Case **R 1411/2005-1 Eurostile** and Case **R 0274/2006-1 Device of a cup (fig.)**.

A similar interpretation has also been applied in the case of the withdrawal of an opposition. In **R 0956/2006-1 SILKA / Sikla (fig.)** the Boards decided that the first instance committed an error by specifically requesting the opponent to file an appeal for its withdrawal of the opposition to be accepted. Article 44(1) CTMR permits the opposition to be withdrawn at any time, even after a decision has been issued, provided that it has not yet become legally binding (see also **R 0200/2006-2 SOUTHERN TWIST/TWIST**).



**D. Substantiation of (earlier) rights**

**1. Registration certificates / extracts from databases**

According to Rule 19(2)(a)(ii) CTMIR (as amended) to substantiate a trade mark, which is not a CTM, a registration certificate or 'equivalent documents emanating from the administration by which the trade mark was registered' is needed.

**a) Registration certificates**

The Boards, in accordance with their established criteria and the case-law of the Court of Justice, confirmed that essential details relating to earlier rights which are used to oppose Community trade mark applications must be accredited by documents of an official nature. The Boards considered that a simple indication of the essential elements of the earlier rights – such as, the dates of application and registration – by the interested party does not constitute evidence similar to registration certificates [see **R 0651/2002-4 bancopopular-e.com (fig) / (fig.)**]. It is also not sufficient only to attach a translation of the registration certificate made by the professional representatives and not the registration certificate itself. A translation of a document cannot replace the original document (see **R 0573/2005-2 SWEROCK (fig.) / rock; R 0950/2005-4 FALCON / FALCON**).

**b) Extracts from private databases**

In 2006, decisions rejected excerpts from private databases on the basis that the filing of an extract from a private database could not itself amount to a certificate of registration or to an equivalent official document (**R 0764/2005-4 AUBE / AUBE, R 0872/2004-1 Time Out / TIME et al.** and **R 0434/2005-1 Time Out (fig.) / TIME** relating to the "Säegis" database). On the other hand, excerpts of databases which contain official information provided directly by the relevant national trade mark office, have been accepted, for example excerpts from the public French ICIMARQUES on-line database which is published by 'INPI' and contains data drawn from INPI's records (see **R 0582/2006-2 AVONTEC / AVANTEC et al.; R 1477/2005-2, NextPharma / Next Nutrition**).

**2. Renewal / Validity of earlier rights**

With respect to renewals, the modified Rule 19(2)(a)(ii) CTMIR provides that within the time-limit specified by the Office, the opposing party has to, *inter alia*, file proof of the existence, validity and scope of protection of its earlier mark. As the case maybe, it might also have to provide a copy of the latest renewal certificate, namely one showing that the term of protection of the trade mark extends beyond the time-limit set by the Office.

In several cases the Boards confirmed first instance decisions rejecting the opposition because the renewal of the earlier trade mark has not been proved [see *inter alia* **R 0300/2005-1 arcontech (fig.) / AUCOTEC et al., R 0166/2004-4 FOR.A (fig.) / FORD, R 0452/2006-2 DON SEBASTIAN / SEBASTIAN'S (fig.)**].

In determining whether a mark has been renewed, the particularities of national law of the relevant Member State should be taken into account [see CFI case-law in 'ATOMIC BLITZ'<sup>1</sup>; a similar situation to ATOMIC BLITZ is: **R 0693/2005-2 luck/\*Lucky's\* (fig.)**].

In case of Benelux trade marks there is a six months grace period after the expiry date (see **R 1284/2005-2 B.S. BEST SELLER / BESTSELLER et al. (fig.)**). Therefore the Boards found that the opponent could not

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<sup>1</sup> Judgment of the Court of First Instance of 20 April 2005 in Case T-318/03 *Atomic Austria GmbH v OHIM* ('Atomic Blitz') [2005] ECR II-1319.



be required to prove the renewal of its Benelux trade mark registration prior to the date it was obliged to apply for its renewal. Equally, in accordance with Spanish trade mark law, the trade mark proprietor may request the renewal of registration within six months of its expiry. Renewal is deemed to take effect from the day following the expiry date (see **R 0868/2005-1 IMPERATOR / IMPERATOR**). The Boards confirmed that both on the date when the OD requested a renewal certificate and on the date when the decision rejecting the opposition was rendered, the opponent was still entitled, in accordance with Spanish law, to apply for renewal. He was therefore not obliged to submit a renewal certificate. Portuguese trade mark law counts the validity period from the date of registration and not from the date of the filing of the trade mark. The Boards, taking into account this national law, annulled a decision from the first instance which had taken the filing date as a reference and had rejected the opposition for failure to provide a renewal certificate [see **R 1012/2005-1 STEP 2WO/NEW STEP (fig.)**].

### 3. Translations

Rule 19(3) CTMIR provides that the information and evidence necessary to substantiate the opposition has to be in the language of the proceedings or accompanied by a translation. The failure to provide a translation within the time-limit set by the Office leads to the rejection of the opposition [see **R 0069/2005-4 INTERNATIONAL TRAVEL CONSULTING ITC (fig.) / ITS**; **R 0843/2005-1 AF-COLOR / ALCOLOR S.A. (fig.)**; **R 0148/2005-4 ULUDAG (fig.) / BURSA ULUDAG (fig.)**; **R 0710/2005-1 Fly-Bee / Bee FLY (fig.)**]

The Implementing Regulation does not specify particulars in relation to translation. The CFI decided in its *BIOMATE* judgment<sup>2</sup> that only the parts actually translated into the language of the proceedings can be taken into consideration. The Boards consider that a translation of the list of goods and services alone does not meet the translation requirement (see **R 0958/2004-2 ALPHA / Alpha Tonträger Vertriebes GmbH**; **R 0122/2005-1 IO / JO!**; **R 0917/2004-1 MEDICAL-WEB TV SICHTBAR MEHR FORTBILDUNG (fig.) / MEDICAWEB**). In their 2006 cases, the Boards have, for the most part, considered that a translation must reproduce the structure and content of the original documents (see **R 0253/2005-1 Q-TEL (fig.) / Q-TEL (fig.)**; **R 0703/2005-4 SEKURA (fig.) / PaXsecura**).

### 4. Change of name or transfer

The Boards have confirmed that a change of name is not a transfer of ownership. If the opponent merely changed its name, the opposition cannot be rejected as unsubstantiated for failure to show the entitlement to file the opposition (**R 0860/2006-1 Chron / Kron**). In **R 0906/2005-2 ATLAS VENTURE / ATLAS ESPAÑA (fig.)** the Board considered that a change of name (rather than a transfer of ownership) had taken place in a situation where the names did not coincide, but the addresses as well as the fiscal identification number (NIF) shown in the official extracts of the National Patent and Trade Mark Office were the same for both companies.

### **E. Restriction of the list of goods and services**

Under Article 44 (1) CTMR, the applicant may at any time withdraw its Community trade mark application or restrict the list of goods or services contained therein. The Court of First Instance has held that an application for a restriction must be made expressly and unconditionally. A proposal to withdraw part of the goods applied for, if the Board of Appeal considers rejecting them, is not accepted as being made

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<sup>2</sup> Judgment of the Court of First Instance of 30 June 2004 in Case T-107/02 *GE Betz Inc. v OHIM* ('Biomate') [2004] ECR II-1845.



expressly and unconditionally (see judgment of the Court of First Instance of 27 February 2002 in Case T-219/00 *Ellos AB v OHIM* ('Ellos')).

Following the case-law of the Court of First Instance, the Boards have refused restrictions which are not requested expressly and unconditionally (see Case **R 0205/2005-4 (3D)**; Case **R 0751/2006-2 VASCULAR WRAP** and **R 0162/2005-1 SOLUTION / BI-SOLUTION BS** where the applicant proposed restricting its list of goods 'alternatively').

Applying the case-law of the Court of Justice in Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* ('Postkantoor'), the Boards have refused, for reasons of legal certainty, 'negative restrictions' which try to exclude some of the goods or services, stating that they do not possess a particular characteristic (see *inter alia* **R 746/2005-4 TIKKA TIKKA**, **R 1492/2005-4 MARIN**, **R 285/2006-4 BUSINESS SIGNATURE**).

The restriction in **R 556/2005-1 ZELOXZAR / ZELDOX** by adding 'available by prescription only' was considered inadmissible. The Boards found that the clause did not constitute a restriction because it did not concern the list of goods but the way they are sold. The goods for which the mark was intended to be used remained the same.



#### **IV. ABSOLUTE GROUNDS FOR REFUSAL/INVALIDITY**

##### **A. Absolute grounds for refusal – Arts. 4 and 7(1)(a) CTMR**

Article 4 CTMR lays down two conditions for a sign to be capable of constituting a Community trade mark: the substantive requirement of distinctive character and the formal requirement of a graphical representation.

The graphical representation should be clear, self-contained, easily accessible, intelligible and objective as stated by the ECJ in judgment C-273/00 *Ralf Sieckmann v Deutsches Patent- und Markenamt*<sup>3</sup>. For the Boards, in the case of an olfactory trade mark, the description, in words, does not satisfy such criteria (see Case **R 0445/2003-4 THE SCENT OF A LEMON**).

Equally, in relation to colour marks, the Boards have rejected colour marks if they do not exhibit the necessary qualities of precision and uniformity, required by the ECJ in the judgment of Case C-104/01 *Libertel*. In **R 1004/2006-2 purple/white (colour mark)**, the Boards rejected the application in a situation where the textual description of the mark was in contrast with its pictorial representation, resulting in an ambiguous overall representation of the sign.

##### **B. Absolute grounds for refusal / invalidity: Art. 7(1)(b)-(d)/ Art. 51(1)(a) CTMR**

###### **1. Word marks**

###### **a) Letters and/or numbers**

The year 2006 included decisions, where the Boards held that individual letters did not possess distinctive character, see **R 805/2006-4 E** (for *medicines, plasters and dressings*), **R 394/2006-1 E** (for goods mainly in the area of *wind power plants* - 'E' would be seen as an indication of Energy or Electricity) and **R 1494/2005-2 'M'** for (*yeast strain*). In the cases mentioned, the Boards clarified that individual letters which lack an adequate graphical form or design or have not been used intensively and consistently in a particular stylisation lack distinctive character.

The Boards allowed the registration of the number combination 70.3 for goods in Class 25 because the combination said nothing about the properties, characteristics, or purpose of articles of clothing. However, in relation to '*organizing, conducting and presentation of athletics events involving running, swimming and biking*' (Class 41), the Boards rejected the mark as it denotes the event 'Half-Ironman triathlon', 'Tinman' or '70.3' (see **R 206/2006-2 70.3**).

###### **b) Descriptive/non distinctive, laudatory marks v. allusive marks**

The vast majority of decisions on absolute grounds in 2006 dealt with the grounds for refusal under Article 7(1)(b) and (c) CTMR. Amongst these, the Boards have dealt with and refused laudatory terms, which serve to inform the relevant public about characteristics of the goods at issue, in particular their high quality. Examples of such cases include: **R 0028/2006-4 Selection** (for *paints, varnishes, lacquers*), **R 0746/2004-4 Vitality** (for *milk-based food and drinks*), **R 0566/2004-4 EXTRA** (for *injection moulding machines*), **R 0782/2006-1 XPERT** (for *medical devices*), **R 0261/2005-4 PROTI** (for *pharmaceutical*

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<sup>3</sup> Judgment of the Court of 12 December 2002 in Case C-273/00 *Ralf Sieckmann v Deutsches Patent- und Markenamt* ('Methylcinnamat') [2002] ECR I-11737.



preparations), **R 0616/2006-2 FIRST** (for *chewing gum*) and **R 0023/2005-4 FABULOSO** (for *alcoholic beverages*).

On the other hand, evocative or allusive marks have been accepted, for example **R 0761/2005-1 VOGUE** (for *entertainment; education; training; research related to entertainment*), **R 1166/2004-4 PRONTO** (for goods relating to products which are not ready-to-eat) and **R 0546/2003-4 SLIPPERY** (for *wetsuits*).

#### **c) Geographical indications**

In relation to geographical indications the ECJ has stated that the registration of geographical names as trade marks is prohibited where the names designate places which are, in the mind of the relevant class of persons, currently associated with the category of goods in question or are liable to be used in future by the undertakings concerned as an indication of the geographical origin of that category of goods (C-108/97 and C-109/97 *Windsurfing Chiemsee*<sup>4</sup>).

In line with this case-law, in 2006, the Boards refused a number of geographical indications such as in **R 1073/2005-1 TEQUILA** (for *tequila and goods based on tequila, beverages prepared with tequila*), **R 1017/2006-4 CÖXLE** (for goods in Classes 32 and 33), because it designates in Germany an apple-based spirit derived solely from the 'Cox's Orange Pippin' apple, **R 1185/2006-1 CASABLANCA** (for wines), as it identifies a region in Chile and **R 1253/2005-1 Germania** (for *transport and arranging of travel*), as it is the Italian noun for Germany.

On the other hand, MONTANA was allowed for wines since Montana has no reputation for its limited wine production, consumers would not necessarily draw the conclusion that the appellant's wine is from the State of Montana [**R 0824/2006-2 MONTANA (fig.)**].

#### **d) Slogans and expressions**

In several judgments, the Courts in Luxembourg have held that a trade mark which consists of signs or indications which are also used as advertising slogans, indications of quality or incitements to purchase is not excluded from registration simply because of such use. Slogans are not subject to stricter criteria than those applicable to other types of signs (T-138/00 *'Das Prinzip der Bequemlichkeit'* and C-64/02 P *'Das Prinzip der Bequemlichkeit'*<sup>5</sup>).

In 2006, the Boards have, for example, accepted slogans as distinctive in **R 0727/2005-2 IT'S A TRUST THING** (for computer software, financial services and services of providing authentication of identity), **R 0704/2005-2 EVOLVE WISELY** (for computer and business related services), **R 0334/2006-2 YOU CAN WIN** (for *apparatus for recording, transmission or reproduction of sound or images*' and for *'pens*') and **R 1480/2005-2 CAMPAIGN FOR REAL BEAUTY**, which is only suggestive of the applicant's goods and services (Classes 3, 16 and 41), because a person cannot become beautiful on the basis of a campaign.

However, a slogan that limits itself to telling the consumer in clear and simple terms that an attractive offer is being made generally lacks distinctive character, see **R 0186/2005-4 ES GIBT SIE NOCH, DIE GUTEN DINGE** ('they still exist, the good things'), which was refused for goods and services in Classes 3 to 31 and

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<sup>4</sup> See judgment of the Court of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehör Walter Huber and Franz Attenberger* ('Chiemsee') [1999] ECR I-2779

<sup>5</sup> See judgment of the Court of First Instance of 11 December 2001 in Case T-138/00 *Erpo Möbelwerk GmbH v OHIM* ('Das Prinzip der Bequemlichkeit') [2001] ECR II-3739 and judgment of the Court of 21 October 2004 in Case C-64/02 P *OHIM v Erpo Möbelwerk GmbH* ('Das Prinzip der Bequemlichkeit') [2004] ECR I-10031



35, **R 0509/2005-1 TAKING YOU FORWARD**, for goods and services in Classes 9, 11, 16, 35, 36, 37, 38, 41 and 42, **R 0121/2006-1 TURNING SCIENCE INTO CARING**, for goods and services in Classes 5, 9, 10 and 44 and **R 0422/2004-4 REDUCE THE HOURS OF CRYING**, for 'preparations for reducing lactose intolerance in infants; food supplement for adding to infant milk' (Class 5).




**e) Misspellings**

The Boards refused some misspelt marks, finding that incorrect spelling, which is not or barely perceptible in the spoken language, is frequently used in all areas of life and on all markets. Thus in **R 0352/2005-4 FRESHHH**, the Boards found that the sign was descriptive for goods in Classes 29, 30 and 32. The extension of the final sound served to underline the descriptive meaning. In **R 0374/2005-1 exsellent**, the Boards found that a conscious misuse or incorrect spelling to reflect the word 'sell' in excellent did not change the laudatory meaning of the term and rejected the mark for *inter alia*, 'advertising and marketing' (Class 35), 'telecommunications' (Class 38) and 'education' (Class 41).

**2. Figurative marks**

**a) Letters**

In 2006, there have been several decisions rejecting single letters because of their lack of distinctiveness, in particular where the figurative representation of the letter was commonplace, possessed nothing unusual, had no striking figurative element, nor any graphical defamiliarisation or design (see

**R 0945/2006-2**  (N), in relation to goods in Class 6; **R 0370/2006-4**  (omega sign), for goods in the field of electro-technique and Case **R 0808/2006-4**  (alpha sign), for goods in Class 33).

**b) Words**

The Courts in Luxembourg have held that where a sign in respect of which registration as a 'figurative mark' is sought consists merely of script in a normal, common font, the script will normally be devoid of any figurative character and therefore its registrability must be assessed in line with the principles governing word marks (see T-32/00 'Electronica'<sup>6</sup>).

Cases where the Boards considered the script normal (i.e. the script did not prevent the trade mark from being considered non-distinctive) include script with a black frame (**R 0796/2005-1** **sportingbet.com** (**sportingbet.com**) for Classes 9, 35, 36, 38 and 41), hand-written script (**R 1503/2005-1** **L'Espresso** (**L'Espresso**) for 'coffee' (Class 30)), script with differently shaded letters (Case **R 0468/2006-1** **CATALONIA** (**CATALONIA**) for goods and services in Classes 9, 16, 35, and 41) or a different upright and italic script with a variation of upper and lower-case lettering (**R 0897/2005-1** **LeadIng.** (**LeadIng.**) for engineering services).






**c) Images**



In the realm of figurative marks, the Boards allowed for registration several marks on the basis that the illustration was not a realistic representation of the product itself, it did not depict the product itself or it did not merely consist of simple geometrical basic forms or of simple, commercially commonplace elements of



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<sup>6</sup> Judgment of the Court of First Instance of 5 December 2000 in Case T-32/00 *Messe München GmbH v OHIM* ('Electronica') [2000] ECR II-3829








design (see R 1290/2005-4 , R 1291/2005-4  and R 1292/2005-4  (tea pot devices),  
inter alia for 'tea' (Class 30); R 0888/2006-4  (representation of a fan) for 'air conditioning  
apparatus' (Class 9) and R 0495/2006-4  (representation of a drill) for inter alia 'hire of machines  
and machine tools and parts and fittings therefor; ...' (Class 37).



The Boards rejected as non-distinctive commonplace representations of the goods which did not present characteristics that were notably different from those commonly found in the particular commercial sector (see, for example, R 0769/2006-2  (AUTOMOBILE GRILLE) for goods in Class 12). In R 0102/2005-2  (Mozartkugeln) the CTM was cancelled for, inter alia, 'chocolate goods' because customers are used to seeing a golden frame on goods made of chocolate.

The Boards confirmed the rejection of the following pocket designs representation  (R 1464/2005-2) and  (R 0416/2005-2) in respect of goods applied for in Classes 18 and 25.

#### d) Colours

In accordance with the case-law of the European Court of Justice (see judgment of the Court of Justice of 6 May 2003 in Case C-104/01 *Libertel Groep BV v Benelux-Merkenbureau*, 'Orange'), reasons that may lead to the refusal of registrations of single colours include: (a) the limited number of shades of colour that the relevant consumer of the goods can actually distinguish because he is rarely in a position directly to compare products in the various shades of colour with one another and (b) the general interest in not unfairly limiting the availability of colours to others operating in the market (see, e.g. R 1056/2004-4  (colour 'silver') for 'glue sticks'; R 1414/2005-1  (Hellblau), R 0096/2006-1  (Lemon yellow) all for 'pad sheets for printing' (Class 16) and R 1175/2004-4  (RAL 3020 traffic red) for Classes 7, 9 and 11).

In relation to a combination of colours, see R 1475/2005-2  (Light Green and Dark Green) for i.e. 'packaging materials made from paper and plastic ...; all for kiwi fruit' (Class 16) and 'kiwi fruit' (Class 31).

A colour/number combination used as an element of a colour chart has also been found non-distinctive because the combination would be understood as a 'colour code' rather than a trade mark (see R 1472/2005-2  (yellow 743) and R 1473/2005-2  (blue 798) for 'yarns and threads for textile use').



**e) Position marks**

There are no special criteria applying to position marks. Case-law developed for three-dimensional marks<sup>7</sup> consisting of the shape and colours of the product itself, may also be relevant if the trade mark applied for is a position mark reproducing elements of the shape of the product. In such cases, the trade mark does not consist of a sign which is independent from the appearance of the product it denotes.

To assess the distinctiveness of a position mark consisting of a geometrical shape placed on a shoe, the Board took into account the fact that it is customary for manufacturers of sports and leisure shoes to display the same pattern on their goods always in the same place on the outside of the product, making it visible from a distance. Therefore the consumer is accustomed to such signs and can, in principle, be

guided by them when buying sports and leisure shoes (**R 0051/2006-4**).



). The mark was considered distinctive.

On the other hand, notches arranged in groups on the external edge of a brake drum would be perceived

as non-distinctive by specialists dealing with brake drums (**R 0394/2005-4**).



). The black and blue colours inside the holes of a pair of scissors are so commonly used that they are not capable of

distinguishing the scissors from those of competitors (**R 1476/2005-1**).



). These marks were rejected as non-distinctive.

**3. Three-dimensional marks**

**a) Shapes of products**

The Court of First Instance and the European Court of Justice have stated that, while the public is used to recognizing word marks or figurative marks as signs identifying a product, this is not necessarily so when the sign is indistinguishable from the appearance of the product itself (see *inter alia* Case T-337/99 Henkel KGaA v OHIM, and Joined Cases C-456/01 P and C-457/01 P Henkel KGaA v OHIM<sup>8</sup>).

In 2006, the Boards rejected three dimensional marks which do not depart significantly from the norms or

customs in the relevant sector, *inter alia*, in **R 0461/2006-2**



**(TOOTHBRUSH HEAD)** and

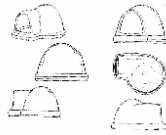
<sup>7</sup> See *inter alia* judgments of the Court of Justice of 29 April 2004 in Joined Cases C-456/01 P and C-457/01 P *Henkel KGaA v OHIM*, 'Tabs'; of 12 January 2006 in Case C-173/04 P *Deutsche SiSi-Werke GmbH & Co. Betriebs KG v OHIM*, 'Stand-up pouches'; and of 22 June 2006 in Case C-25/05 P *August Storck KG v OHIM*, 'Sweet wrapper'.

<sup>8</sup> Judgment of the Court of First Instance of 19 September 2001 in Cases T-335/99, T-336/99, T-337/99 *Henkel KGaA v OHIM* ('Tabs') [2001] ECR II-2581, 2589, 2597 and judgment of the Court of 29 April 2004 in Joined Cases C-456/01 P and C-457/01 P *Henkel KGaA v OHIM* ('Tabs') [2004] ECR I-5089.



**R 118/2005-4** (Schogetten-Stück II). In the area of washing or cleaning products, the Boards have rejected various three-dimensional shapes of a square form (with an additional shape at the core) for goods in Class 3. The relevant public is accustomed to being offered a number of similar shapes. See

**R 0841/2004-1** , **R 0848/2004-1** , **R 0840/2004-1** , **R 1069/2004-1** .



However, the following shape **(PET SHELTER)** departs significantly from the norms in the relevant sector and is sufficiently unusual to merit protection, *inter alia*, for 'pet shelters' and 'kennels' (**R 0724/2006-2**).

**b) Bottles and containers**

For goods which do not possess an intrinsic shape and must be packaged in order to be marketed, the packaging imposes its shape on the goods. Such is the case, for example, for goods manufactured in the form of granules, powder or liquid which, because of their very nature, lack a shape of their own. Only when the trade mark differs considerably from the norm or custom in the relevant sector is an average consumer able to distinguish the goods concerned from those of other undertakings (C-218/01 'washing detergent bottle'<sup>9</sup>, C-286/04 P 'Corona beer bottle'<sup>10</sup>).




In 2006, the Boards confirmed as classic forms or common shapes of bottles: the 'Bocksbeutel' ,



*inter alia*, for 'non- alcoholic drinks' and 'alcoholic beverages' (**R 0479/2004-1**); for 'vermouth'



(**R 0666/2005-1**); for vodka (**R 0677/2004-4**) and  for gin (**R 0991/2005-2**).



With respect to containers, the Boards rejected  for 'fruit drinks and fruit juices' (**R 0965/2005-4**).



They allowed the shapes , *inter alia*, for 'printed matters; photographs' (Class 16);

<sup>9</sup> Judgment of the Court of 12 February 2004 in Case C-218/01 *Henkel KGaA v Deutsches Patent- und Markenamt* ('Perwoll') [2004] ECR I-1725.

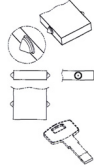
<sup>10</sup> Judgment of the Court of 30 June 2005 in Case C-286/04 P *Eurocermex SA v OHIM* ('Botella Corona') [2005] ECR I-5797.



'furniture' (Class 20) and 'ice' (Class 30), but rejected it for other goods in Classes 29 and 30 as it constituted a natural or expected form of packaging for those goods (see **R 0884/2006 4** and **R 0204/2006-4**).

**C. Absolute grounds for refusal/invalidity – Art. 7(1)(e) CTMR / Art. 51(1)(a) CTMR**

The requirement under Article 7(1)(e)(ii) CTMR that a specific technical result must be brought about by a specific design is in accordance with the public interest of keeping technical solutions free under trade mark law as emphasised by the Court in the Philips/Remington judgment<sup>11</sup>. The Boards decided in

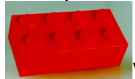


**R 0435/2006-4** that the piston rod or shovel of the key and the form which adapted to the drills was designed in such a way as to obtain a certain technical result (opening or closing the specific locks). The Board dismissed the appeal and rejected the sign applied for. The shape of the following tool box



, on the other hand, was not considered to be a 'shape necessary to obtain a technical result' (see **R 0001/2005-4**).

Article 7(1)(e)(ii) CTMR also serves to prevent the circumvention of patent law guarantees. Three-dimensional shapes whose essential characteristics perform a technical function can be protected under patent law only if they meet the strict patentability requirements and then only for a limited period. Patented inventions fall into the public domain when the patent expires. This was one of the relevant aspects in the Grand Board case **SHAPE OF A LEGO BRICK**. The Grand Board considered that the expired patents in this case were key facts of the appeal, since a prior patent is practically irrefutable evidence that the features therein disclosed or claimed are functional. The Grand Board confirmed that the Lego brick's features were adopted to perform a utilitarian function. The brick was considered wholly



functional (**R 0856/2004-G** ). Equally, in the case of the three-dimensional representation of a plunger which had the same essential technical function as a US patent filed by the same applicant, the



trade mark was rejected (see **R 0747/2005-2** ).

**D. Absolute grounds for refusal/invalidity – Art. 7(1)(f)-(k) / Art. 51(1)(a) CTMR**

**1. Art. 7(1)(f) CTMR**

Article 7(1)(f) CTMR prohibits the registration of 'trade marks which are contrary to public policy or to accepted principles of morality'. In assessing whether a trade mark falls under this prohibition, the Boards have looked at various aspects, including the kind of goods designated by the mark, the place and the

<sup>11</sup> C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd.*, 'Remington', [2002] ECR I-5475.



context in which the goods are sold, the 'sensitivity' of consumers (to be shocked or offended) and their age. A good example is the Grand Board decision in **R 0495/2005-G SCREW YOU**, where the mark was allowed, *inter alia*, in respect of 'condoms, contraceptives and sex toys' (usually sold in sex shops), but refused for goods in Classes 9, 25, 28 and 33, which are ordinary items marketed in outlets used by the general public. Further examples in 2006 include **R 0558/2006-2 REVA**, **The electricity Car (fig.)** and **R 0356/2005-4 Erotic Lounge**. In R 558/2006-2 it was decided that the word 'reva' might carry a sexual connotation, but did not transmit a rude or disrespectful message as it was to be used on environmentally-friendly electric cars. It was not to be used, for example, on T-shirts which are the type of goods where consumers often see deliberately provocative material.

## 2. Art. 7(1)(g) CTMR

Article 7(1)(g) CTMR excludes from registration as a CTM those trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services.

In 2006, the Boards found that the mark **WINE OH!** was deceptive for, *inter alia*, 'mineral waters and other non-alcoholic drinks' (Class 32), but not deceptive for goods in Classes 9, 25 and services in Class 43 (see **R 1074/2005-4**)<sup>12</sup>.

## 3. Art. 7(1)(h) CTMR

According to Article 7(1)(h) CTMR state emblems etc. that are to be refused pursuant to Article 6ter of the Paris Convention and that have not been authorised by the competent authorities cannot be registered as trade marks.


In 2006, the Boards confirmed the refusal of signs which were almost identically protected as official emblems and where no authorisation had been granted by the competent authorities (see **R 0503/2006-2**



and **R 1463/2005-1 RW.**)



On the other hand, the Boards allowed a sign which presented differences with the official emblem (see in

relation to the Maltese national shipping flag the case of a similar cross in a shield **R 1444/2005-2** ) and, in case of acronyms, a sign which included a clear explanation of the acronym so that the consumer would not link the sign to the protected emblem (see **R 0001/2006-2 CEE – Confiance Electronique Européenne** and **R 0002/2006-2 EEC – European Electronic Confidence**).

## 4. Art. 7(1)(j) CTMR

In accordance with Article 7(1)(j) CTMR, a sign shall not be registered as a trade mark for wines if it contains or consists of a geographical indication identifying wines with respect to wines not having that origin. The same applied to spirits. The Boards confirmed that a trade mark application that contains a geographical indication in respect of wine not having that origin has to be refused, without it being necessary to determine whether the trade mark as a whole is of such a nature as to deceive the public (see **R 1185/2006-1 CASABLANCA**).

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<sup>12</sup> For earlier examples of cases where the mark was considered deceptive for some goods and services, but not for others, see R 468/1999-1 International Star Registry; R 476/2003-4 SMART FUEL CELL and R 508/2004-4 HAIR THERAPY.



**E. Distinctiveness through use: Art. 7(3) CTMR**

Although there is no fixed percentage from which it can be assumed that distinctiveness has been acquired through use, Boards of Appeal decisions in 2006 have given special value to surveys and opinion polls for examining market acceptance (see, for example, **R 0001/2005-4 HILTI-KOFFER (3D)** where the result of 66% of people asked identifying the shape as coming from the applicant with only 3% wrongly attributing it in opinion polls served as conclusive evidence). Other types of evidence taken into account by the Boards include sales figures, market share, advertising expenditure and press articles [see **R 0148/2004-2 COULEUR ORANGE (fig.)**]. Marketing material or information on promotion campaigns, not supported by evidence indicative of market share, of the amounts invested or of consumer recognition were not considered enough to prove acquired distinctiveness in **R 0890/2005-1 SHAPE OF CUP (3D)**. In case of word marks, national registrations in some Member States can be of particular importance when the examiner's refusal was limited to those Member States and the national trade mark authorities had explicitly decided on the matter of acquired distinctiveness in their territory (see **R 0858/2005-2 NO MORE TEARS**).

In the case of non-word marks, such as three-dimensional or colour marks the distinctiveness acquired by use usually has to be established in all Member States, even if that use cannot and will not be equally intensive in all of them. In **R 0001/2005-4 HILTI-KOFFER (3D)** and **R 0148/2004-2 COULEUR ORANGE (fig.)** distinctiveness was proved in all MS. In **R 0986/2004-4 Surfaces covered by lines (fig.)**, on the other hand, it was not demonstrated that the sign possessed distinctive character acquired through use in the EU as a whole.

Following the case-law in the **C-353/03 'HAVE A BREAK'**<sup>13</sup> judgment, the Boards considered in a case that the fact that the sign applied for was never used by itself on the goods and services but in conjunction with other figurative or verbal components did not prevent a distinctive character from being acquired through the use of this trade mark as part of or in conjunction with a registered trade mark (see **R 0148/2004-2 COULEUR ORANGE (fig.)** for '*champagnes*').

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<sup>13</sup> See judgment of the Court of 7 July 2005 in Case C-353/03 *Société des produits Nestlé SA v Mars UK Ltd* ('Have a break') [2005] ECR I-6135.



**V. RELATIVE GROUNDS FOR REFUSAL/INVALIDITY**

**A. Relative grounds for refusal: Art. 8(1)(a) CTMR**

The Boards confirmed that the protection provided by an earlier trade mark is absolute where the two marks and the goods or services are identical (see e.g. **R 0215/2004-4 IGLOO / IGLOO** for goods in Class 21; **R 0773/2005-2 EDUNET / EDUNET** for services in Class 38 and **R 1396/2005-1 IQ / IQ**, for goods in Class 10).


In **R 1396/2005-1 IQ / IQ**, the Boards found that since it has been established that both goods and trade marks are identical, distinctiveness no longer comes into question.






**B. Relative grounds for refusal / invalidity: Art. 8(1)(b) / Art. 52(1)(a) CTMR**

**1. Marks composed of letters / acronyms / numbers**








The Boards affirmed the likelihood of confusion between marks composed of letters where there was identity between the goods and services and visual and aural similarity between the signs, especially when the beginnings of the signs under comparison were the same, see **R 1343/2005-4 FVB / FVD**; **R 1330/2005-2 DSBW / DSB**<sup>14</sup>.

Differences in one letter at the beginning can, in the case of three-letter acronyms, be sufficient to distinguish the marks visually and phonetically (**R 1220/2005-2 KCC / GCC**). The addition of one single letter might modify the visual and especially aural perception of the marks (**R 1374/2005-2 TCA / TECA**).

Where signs consisted in figurative marks depicting a single letter, the Boards have, in 2006, often considered that a single letter was inherently weak, since it might not attract consumers' attention nor could it be considered as imaginative. In any event, visual differences between the signs due to figurative elements might be capable of counteracting any phonetic or conceptual similarity (see **R 0539/2006-2** 

(H) /  (H); **R 0930/2005-1**  (i) /  (i); **R 0080/2004-4**  (X) /  (X PROJECTS).

However, where there are no such visual differences and the goods and/or services are identical or highly similar, even if the marks are single letters, the Boards have found a likelihood of confusion (see

**R 1363/2005-1**  (V) /  (V); **R 0209/2004-4**  (H) /  (H). Equally, there have been cases in 2006, where the Boards have considered a risk of confusion to exist in situations where the signs being compared consisted of the same letter combination, where the figurative differences were minimal and there was a similarity/identity of the goods and services [see *inter alia* **R 0422/2005-2** **EK!** (EK!) /  (ek); **R 0155/2005-1**  (VP) /  (VP)].

<sup>14</sup> For acronyms, see also Judgment of the Court of First Instance of 23 October 2002 in Case T-388/00 *Institut für Lernsysteme GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), 'ILS/ELS'*, [2002] ECR II-4301



In relation to numbers, trade marks consisting only of a 'figure' or of a combination of figures might have a very low distinctive character as figures are normally used to designate the quantity, weight, serial number, etc. of goods. The addition of further elements, even if they have a low level of distinctive character themselves, may be capable of removing a likelihood of confusion (**R 0385/2005-2 05 / 5, No 5**).

## 2. Earlier mark included in the CTMA and vice versa

The comparison between marks must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32)<sup>15</sup>.

It is also possible for the earlier right to have an independent distinctive role in the composite mark, without necessarily constituting the dominant element<sup>16</sup>. If the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, likelihood of confusion is established.

For examples of likelihood of confusion in cases where one mark was included in the other see: **R 0268/2005-4 FOCUS RADIO / FOCUS**; **R 0387/2005-4 FOCUS RADIO / FOCUS**; **R 0700/2004-4 FOCUS MONEY / FOCUS**; **R 0319/2005-4 Tomorrow Focus / FOCUS**; **R 0823/2005-4 SinnLeffers / Sinn**; **R 0009/2006-1 PASSION FACTS / PASSION et al.**; **R 0652/2005-1 WILD FRUITZ / WILD**; **R 0668/2005-2 PNEUMO UPDATE / PNEUMO**; **R 0175/2006 VitalOffice / VITAL**; **R 0485/2005-4 B. LAKE / Lake**; **R 0808/2004-1 Mamma Lucia / LUCIA et al** etc.).

Cases, where the Boards considered that there was no likelihood of confusion included those where the common element had only limited distinctiveness. Thus, in **R 0094/2003-4 BIO KAIKU / BIO** and **R 0566/2002-2 VICTORIA VOGUE / Vogue**, the Boards found the non-common element to be the dominant one.

When it comes to the comparison of a verbal sign with another sign, consisting of verbal and figurative elements, a general approach applies, based on the finding that the average consumer will normally more easily refer to the goods in question by quoting their name than by describing the figurative elements of the mark<sup>17</sup>. The decisions in 2006 where the Boards have decided that the dominant component is the









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<sup>15</sup> Also see the following judgments: judgment of the Court of First Instance of 16 March 2005 in Case T-112/03 L'Oréal SA v OHIM ('Flexi Air') [2005] ECR II-949; judgment of the Court of First Instance of 8 March 2005 in Case T-32/03 Leder & Schuh AG v OHIM ('Jello Schuhpark'), not published; judgment of the Court of First Instance of 6 October 2004 in Case T-356/02 Vitakraft-Werke Wührmann & Sohn GmbH & Co. KG v OHIM ('Vitakraft') [2004] ECR II-3445; judgment of the Court of First Instance of 23 October 2002 in Case T-104/01 Claudia Oberhauser v OHIM ('Fifties') [2002] ECR II-4359; judgment of the Court of First Instance of 15 February 2005 in Case T-169/02 Cervecería Modelo, SA de CV v OHIM ('Negra modelo') [2005] ECR II-505; judgment of the Court of First Instance of 4 May 2005 in Case T-22/04 Reemark Gesellschaft für Markenkooperation mbH v OHIM ('Westlife') [2005] ECR II-1559; judgment of the Court of First Instance of 25 November 2003 in Case T-286/02 Oriental Kitchen SARL v OHIM ('Kiap Mou') [2003] ECR II-4953; judgment of the Court of First Instance of 7 July 2005 in Case T-385/03 Miles Handelsgesellschaft International mbH v OHIM ('Biker Miles') [2005] ECR II-2665.

<sup>16</sup> See judgment of the Court of 6 October 2005 in Case C-120/04 Medion AG v Thomson multimedia Sales Germany & Austria GmbH ('Thomson Life') [2005] ECR I-8551.

<sup>17</sup> « *En effet, lorsqu'une marque est composée d'éléments verbaux et figuratifs, les premiers sont, en principe, plus distinctifs que les seconds, car le consommateur moyen fera plus facilement référence au produit en cause en citant le nom qu'en décrivant l'élément figuratif de la marque [voir, en ce sens, arrêts du Tribunal Fifties, précité, point 47, et du 14 juillet 2005, Wassen International/OHMI – Stroschein Gesundkost (SELENIUM-ACE), T-312/03, non encore publié au Recueil, point 37]* ». See judgment of the Court of First Instance of 27 November 2003 in Case T-348/02 Quick restaurants SA v OHIM ('Quick') [2003] ECR II-5071, at paragraph 50.




common word element include: R 0054/2005-4 MILKSTAR /  (milkstar); R 0708/2005-1 PAGESJAUNES.COM /  (LES PAGES JAUNES); R 0222/2005-2 X CITE /  (X-CITE); R 0473/2005-4 DISCOVERY /  (SOPORCEL DISCOVERY); R 0395/2005-1  (GAMELOFT.COM) / LOFT; R 0139/2005-4 MERCURY /  (MERCURY); R 1036/2005-1 EVERFLEX /  (FLEX) and R 0489/2006-1  (MAN Y ANA) / MAÑANA).


### 3. Names / surnames


The perception of signs made up of personal names may vary from country to country within the European Community. In determining whether, in a particular country, the relevant public generally attributes greater distinctiveness to the surname than the forename, the case-law of that country, although not binding, may provide useful guidelines<sup>18</sup>.

In 2006, the Boards dealt with various cases concerning names where the goods and services were identical or highly similar and where the earlier mark was reproduced in the mark applied for. The Boards considered in the cases cited that there was a likelihood of confusion as the consumer might perceive the marks as designating two different lines of products originating from the same company, see R 0808/2004-1 Mamma Lucia / LUCIA *et al.*, R 0865/2005-1 MANSO DE VELASCO / VELASCO; R 0716/2004-4 MIGUEL DE CERVANTES VIRTUAL LIBRARY / UNIVERSIDAD EUROPEA MIGUEL DE

CERVANTES; R 0533/2005-1 **Roberto c** (Roberto C) /  (roberto cavalli).

### 4. Conceptual dissimilarity v. visual and phonetic similarity

The Boards have rendered several decisions in 2006, in which the fact that one of the marks at issue had a clear and specific meaning was sufficient - where the other mark did not have a clear meaning or a totally different meaning - to counteract to a large extent the visual and phonetically similarities between the marks<sup>19</sup> (see R 1169/2005-1 ABAC / BACH; R 0031/2006-2 CANALLA / CANALI; R 0058/2006-2 **CELINE DION** (CELINE DION) /  (C. Dion); R 1418/2005-2 MIM / MIMO *et al* etc.).







However, such a conceptual difference might not always be sufficient. In R 1272/2005-1 **MANNA** /  (**MANÁ**) *et al.*, the Boards decided a case where there was a strong visual and aural resemblance between the marks and where the visual element was particularly important in the selection of the products (food). It found that the conceptual difference (MANÁ refers in Spanish to the food miraculously produced for the Israelites in the desert in the book of Exodus) did not counteract the strong visual similarity and phonetic similarity between the marks.

<sup>18</sup> See judgment of the Court of First Instance of 1 March 2005 in Case T-185/03 *Vincenzo Fusco v OHIM* ('Enzo Fusco') [2005] ECR II-715 and judgment of the Court of First Instance of 13 July 2005 in Case T-40/03 *Julián Murúa Entrena v OHIM* ('Julián Murúa Entrena') [2005] ECR II-2831.

<sup>19</sup> Interesting in the context: see judgment of the Court of First Instance of 14 October 2003 in Case T-292/01 *Phillips-Van Heusen Corp. v OHIM* ('Bass') [2003] ECR II-4335; judgment of the Court of First Instance of 22 June 2004 in Case T-185/02 *Picasso estate v OHIM* ('Picaro') [2004] ECR II-1739; judgment of the Court of First Instance of 3 March 2004 in Case T-355/02 *Mühlens GmbH & Co. KG v OHIM* ('Zirh') [2004] ECR II-791 and judgment of the Court of 12 January 2006 in Case C-361/04 P *Picasso estate v OHIM* ('Picaro') [2006] ECR I-643.









**5. Figurative element v. figurative element**

Comparing marks composed of only figurative elements, the Boards decided in various cases that, where the goods and services were identical or similar and the differences between the signs could only be perceived when both marks were carefully examined side by side (the general visual impression of the marks was very similar), there was a likelihood of confusion [see **R 0620/2005-1**  (lion rampant) /  (lion rampant); **R 0203/2006-2**  (ClassicGirl) /  (Six Dots)]. On the other hand, the Boards did not find a likelihood of confusion in a case where the only figurative element composing the marks had a completely different graphical composition and the impression given to the viewer was totally different (see **R 0273/2004-4**  (DEVICE OF A BULL) /  (DEVICE OF a moving BULL).

**C. Relative grounds for refusal/invalidity: Arts. 8(2)(c) and 8(5) / 52(1)(a) CTMR – Well-known marks and marks with reputation**

In relation to the condition ‘taking advantage of, or being detrimental to, the repute or distinctiveness of the earlier mark’ under Article 8(5) CTMR, the Boards have held in Case **R 0700/2005-1 PROTOS / Protos (fig.)** that, where there was no connexion between the goods and services, a mere statement of the standard claim that the applicant’s mark would take advantage of the reputation of the earlier mark was not sufficient.

Cases in 2006 where the Boards confirmed that the mark applied for would take unfair advantage of the repute and the consistent selling power of the earlier trade marks include the following: **R 0530/2004-2 MARIE CLAIRE / MARIE CLAIRE et al.**; **R 0301/2005-2**  (D’Nickers) /  (NIKE) et al.; **R 0825/2004-2 MINERAL SPA /**  (SPA) et al.; **R 0412/2004-4**  (SER) /  (SER), **CADENA S.E.R.**; **R 0408/2005-1 ART OF SPA / SPA et al.**; **R 0334/2005-2 DERBY QUEEN /**  (DERBI) et al.

**D. Relative grounds for refusal/invalidity: Art. 8(4) / 52(1)(a) CTMR – Non-registered marks or other signs used in the course of trade**

The OHIM may be called upon to take into account, in particular, the national law of the Member State where the earlier sign on which the opposition is based is protected. In that case, it must, of its own motion and by whatever means considered appropriate, obtain information about the national law of the Member State concerned, where such information is necessary to assess the applicability of the ground for refusal of registration in question (**R 0792/2005-1 GREMCO / GREMCO**; **R 0585/2005-2 ZETIA / ZELTIA S.A.**).<sup>20</sup>

However, it is for the opponent to prove that the use of the earlier sign in trade is of more than mere local significance in the country concerned (see **R 0624/2006-2 TURBOTURBOFLEX (fig.) / FLEX**; **R 0173/2003-4 ANONYME / Synonyme, SYNONYME DE GEORGES RECH et al.**; **R 0040/2005-2 BRAVO PH SYSTEM / BRAVO (FIG.) et al.**; **R 0300/2005-1 arcontech (fig.) / AUCOTEC et al.** etc.).

<sup>20</sup> See in this context judgment of the Court of First Instance of 20 April 2005 in Case T-318/03 *Atomic Austria GmbH v OHIM* (‘Atomic Blitz’) [2005] ECR II-1319.



In 2006, the Boards decided on two occasions that protection against unfair competition was equivalent to a right to prohibit the use of a later trade mark in the sense of Article 8(4) CTMR. Injunctions may be obtained in civil actions for unfair competition. Oppositions may be allowed based on an unregistered trade name (in Spain) and the use of the registered company name (in France) (see respectively **R 0585/2005-2 ZETIA / ZELTIA S.A.** and **R 0792/2005-1 GREMCO / GREMCO**).

**E. Other earlier rights for invalidity: Art. 52(2) CTMR**

In 2006, the Boards declared a CTM invalid on the basis of a copyright in accordance with Article 52(2)(c) CTMR in Case **R 0113/2005-2**  (**ARENA DI VERONA**) /  (**ARENA DI VERONA**).

**F. Proof of use**

The CFI has confirmed that proof of use of the earlier mark also includes use of the earlier mark in a form differing in elements which do not alter the distinctive character of the mark from the form in which it was registered<sup>21</sup>. The Boards have considered in several cases that the fact that the trade mark is accompanied, on the product, by another trade mark and figurative or colour elements is not enough to consider that the use made of the trade mark has altered its nature or its distinctive character (see **R 0216/2003-4 FLEXI DESIGN / FLEX**; **R 0090/2005-2 GO! LE GUIDE COLLECTION DI PANORAMA TRAVEL / PANORAMA**; **R 0032/2005-1** and **R 0033/2005-1 LYCOS / LICO**). This, however, may be different where the figurative element has a significant impact on the earlier trade mark (see **R 0073/2005-2 MC MARIO CORTI (fig.) / CORTTY (fig.)**).

According to the CFI in Case T-39/01, genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned<sup>22</sup>.

The means of evidence can include, *inter alia*, statements in writing sworn or affirmed or having a similar effect under the law of the state in which the statement is drawn up. The value given to an affidavit depends on its origin and the information contained therein. An affidavit produced by a party might, on its own, not be sufficient to establish use, unless it is corroborated with other evidence such as invoices, product labels etc. (see **R 0216/2003-4 FLEXI DESIGN / FLEX**; **R 0358/2004-4 MediQi / MEDICE**; **R 1094/2005-2 BUFFALO MILKE Automotive Polishing Products (fig.) / BÚFALO (fig.)**; **R 1075/2005-2 ROLCRAFT / RODCRAFT**). The Boards also found that a declaration before a notary that 'the trade mark has been used as registered' was not sufficient on its own and had to be corroborated by evidence, see **R 0073/2005-2 MC MARIO CORTI (fig.) / CORTTY (fig.)**; **R 1105/2004-2 MAN SITTING ON BOARD (fig.) / MAN SITTING ON BOARD (fig.)** and **R 316/2005-2 VITAFORME (fig.) / vita reform**. In some cases, documents of an internal nature did not provide sufficient proof of use (see **R 0005/2004-4 Smart / SMART**; **R 0475/2005-2 PINK PIRANHA (fig.) / PIRANHA**).

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<sup>21</sup> See judgment of the Court of First Instance of 9 July 2003 in Case T-156/01 *Laboratorios RTB, SL v OHIM* ('Giorgio Aire') [2003] ECR II-2789.

<sup>22</sup> See judgment of the Court of First Instance of 12 December 2002 in Case T-39/01 *Kabushiki Kaisha Fernandes v OHIM* ('Hiwatt') [2002] ECR II-5233.



The mere existence of catalogues and brochures might not prove the fact that the goods protected by the earlier mark were sold, or at least offered for sale within the relevant period (see **R 0081/2005-2 NetCom / NETCOM**)<sup>23</sup>.


In Case **R 1358/2005-1 tD TeleDonosti (fig.) / TELEDONOSTIA**, the Boards accepted the lack of administrative authorization as a 'due cause for non-use' of the mark within the meaning of Article 43(2) CTMR.


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<sup>23</sup> See also judgment of the Court of First Instance of 6 October 2004 in Case T-356/02 *Vitakraft-Werke Wührmann & Sohn GmbH & Co. KG v OHIM* ('Vitakraft') [2004] ECR II-3445.



## VI. DESIGNS

In 2006, the Third Board of Appeal, responsible for appeals on the registered Community Design ('RCD'), rendered various decisions, some of which are mentioned as follows: In **R 1001/2005-3**  /

 **(METAL RAPPERS)**, the basic issue was whether the contested RCD and the prior right produced the same impression on the informed user (in the Board's view they did not). In **R 0196/2006-3**



**(underwater motive device)** the Board examined the relationship between novelty and individual character. It also addressed the designer's degree of freedom when certain elements in the design are not dictated by any technical function.

Case **R 0784/2005-3 Getränkedosen (cans)** dealt with the issue of multiple priorities.

Decisions of the Boards of Appeal in design cases can be found on the database for decisions of the Boards of Appeal by selecting 'DD-Design Department' in the field 'contested decision': [http://oami.europa.eu/search/LegalDocs/la/en\\_BoA\\_index.cfm](http://oami.europa.eu/search/LegalDocs/la/en_BoA_index.cfm).