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Editorial Team:
Reg Rea, David García, Ian Harrington

Contributors to this edition:
James Nurton, Herbert Meister, Wouter Verburg, Petroula Vantsiouri, Nicolas Vigneron, Nicasio Agustina and Mikael Wesslegard

subscribe@oami.europa.eu
unsubscribe@oami.europa.eu

Behind the Chinese walls at OHIM's Boards of Appeal

While OHIM has many thousands of satisfied users, with applications for community trade marks and designs growing rapidly, it is inevitable that not everyone gets what they want. This month, Alicante News takes a look at what happens to the applications that OHIM rejects, and examines the Office's special relationship with its independent Boards of Appeal.

This year, OHIM will take up to 9,000 decisions that could potentially bring the Office into conflict with users. The majority are refusals to register trade marks for reasons such as "lack or distinctiveness" or because they are "purely descriptive". Even when a mark gets through the initial examination process, it may be subject to opposition proceedings, when the owner of an existing mark can put forward an objection. Whatever way the decision goes in the opposition process, someone is bound to be unhappy. And when it comes to the cancellation of a trade mark already granted, they may be very unhappy indeed.

Of course, the Office's initial decision is not always the end of the matter. Around 18-20% of examination and opposition decisions are appealed, and this rises to 45% when it comes to cancellations. In cases where users decide that they want a second opinion, OHIM's independent Boards of Appeal first send the file back for review by the part of the Office that made the disputed decision. A small number are settled at this point – if there has been a mistake, for example – but the majority are decided only after a full examination by the Boards.

This year, the Boards of Appeal expects to deal with around 2,000 cases - 20% more than in 2006 - and to hand down between 1700 and 1800 decisions. This is a record for the Office and reflects both the growth in overall applications for trade marks and designs, and efforts being made elsewhere in the Office to reduce backlogs and bring down timescales at the examination, opposition and cancellation stages. The proportion of cases being appealed has not risen overall, and has even fallen slightly when it comes to opposition cases.

The Boards have a special status. They are a part of the Office, but their President and Chairpersons are appointed by the Council of Ministers whereas the Members are appointed by the Administrative Board. Being a part of the Office they are run under the managerial responsibility of their president, Paul Maier, within the general organisational

responsibility of OHIM President Wubbo de Boer. The Boards have a statutory independence of decision-making which means they cannot be given instructions on how to deal with appeals.

Just like the rest of the Office, the functioning of the Boards is paid for 100% by the fees for trade marks and designs. Until recently there were four Boards, dividing the various types of appeals between them, but this year, in recognition of the increased number of cases, a fifth Board was set up, chaired by the boards' President.

Maier is confident that the independence in decision-making – the operation behind what are sometimes called 'Chinese walls' – is an important element in the effectiveness of the Boards. "In trade mark law there is always an element of subjectivity, whether you like it or not. We must be seen to be making our decisions in a fair and open manner, which is not influenced by the policies that are enforced in the rest of the Office."

OHIM President Wubbo de Boer agrees. "I think the fact that the Boards are within our Office and are capable of delivering an inexpensive and fast route to appeal, is a major asset. The independent aspect of their decision-making is not just useful, it is essential. It is good for the users and good for the Office."

In fact, in the majority of cases, after a thorough examination, the Boards of Appeal support the original decision taken by the Office. The Boards uphold around 83% of initial decisions for ex parte cases and 67% for inter partes cases. This high level of agreement is, for Maier, an indication that the efforts to improve the quality of initial decisions in the Office are bearing fruit.

Of course, a decision by the Boards is not the last option for an unhappy applicant or complainant. Around 9% of decisions - this year in the region of 140 cases - are taken to the Court of First Instance (CFI) in Luxembourg. In the recent past, around eight out of ten cases have been decided in favour of the Boards of Appeal.

Trade mark and design cases now represent a significant workload for the CFI, and this has led to the suggestion that perhaps a special judicial chamber should be established.

The rationale is that a specialist chamber would be more efficient and expert in dealing with trade mark and design cases, resulting in a higher quality of decision-making.



Maier's response is cautious: "I think that whether or not there is a special chamber is essentially a political decision. As far as quality of decision-making is concerned, there may have been some wrong decisions and some that we disagree with, but overall I think the CFI does a good job."

In the end, the view from both sides of the Chinese wall at OHIM turns out to be surprisingly similar. Maier says: "We don't have differences in objectives. There is a strong emphasis on efficiency, which I share, and many more decisions are being made than in the past. In today's world, the demand is always to do more, and do it better."

The James Nurton Interview with Franck Soutoul, INLEX, Paris

James Nurton is a specialist intellectual property journalist from the UK and is currently the managing editor of the leading global magazine for IP owners, Managing Intellectual Property.

How long have you been working in trade marks?

I started in 1986 as an attorney with Novamark (now Novagraaf). I have always specialised in trade marks and designs; I never handled any patents to be honest. Before that I took a degree in marketing and also a Master of Law degree. I then decided to get involved in trade marks. I spent eight or nine years at Novamark and was deeply involved in searches and validation of trade marks, and also created the Japanese department. About 60% of the job was searches, investigations and clearance for new trade mark and design projects.

Why did you start a new firm?

INLEX was created in 1995. I felt the entrance of the European trade mark and European law was a good time to create a new firm with a clear European focus. Now we are 65 people in Cannes, Bordeaux and Paris (four partners, 14 attorneys, 12 young lawyers, 18 paralegals, five in the accounting department). Around 70% of our work is for international clients, and 30% is domestic files, so we work in a variety of languages including Japanese, Czech and Spanish.

How many Community trade marks and designs do you file?

The Community design is very low – we only file 10 or 12 per year for the time being, because of the profile of our clients. But we file 15 to 20 Community trade marks per month, so over 200 a year. It is increasing a lot. French clients have been very reluctant to file OHIM marks but are now filing them for corporate names and logos, and are also doing increased searches. I don't know why they were reluctant to file – getting protection in 27 countries for the cost is very good.

What works well about the Community trade mark?

I like the quality of examination – it is a mix of a legal and a practical approach. Compared to France, I think OHIM is quite practical. For example, we recently applied for a mark for HUB TELECOM and we succeeded in registration by explaining our arguments for protection in classes 9 and 38. In France that would be more difficult.

Are there any things you would like changed with the examination?

I think they are maybe too strict with slogans, which are sometimes more distinctive. They are too close to the view of the British office. This will have to be improved as slogans are so important now. It is the same with smells and colours that have been refused. These are the new way of trade marks. So for many slogans, smells and 3D trade marks I cannot accept that they are refused. That should be changed. It is better for sounds. We filed the first CTM application with an MP3 sound file in February last year, and it was registered earlier this year, in the name of our firm. There was no problem; it was surprising. It was for the sound of dolphin music, and we filed it in classes 35, 38 and 42.

What about the speed and cost of registration?

I'm impressed with the speed, given the number of countries and translations. We are satisfied. And the cost is very reasonable. From my point-of-view, it is less positive for the registration fees that are quite expensive. I would also propose that opposition fees could be reimbursed if you win. We are disappointed with the time taken for confirmation of suspension of opposition proceedings. When the parties are in discussion, we sometimes have to wait two to three weeks to hear about the suspension when we are quite anxious. They have to improve that.

What about the use requirements?

A technical thing is that if there is use in just one country the mark cannot be cancelled. That is a nonsense for me. If you are using your mark just in Estonia, you are comfortable in all countries. It should be more countries or a percentage of the market. We are looking at a proposal and plan to publish an article to provoke discussion on it.

Do you use the Madrid Protocol?

We use that very much. I like it. But we don't recommend putting OHIM applications in the Madrid Protocol application. It can be strategically a nonsense to put it into a WIPO application.

What do you enjoy about working in trade marks?

It uses both sides of my brain – the marketing and the law. OHIM case-law means that the job is very much more interesting than before. New lawyers now are cleverer than I was at the same age. You are filing strategically now. Today when you make a search or an opposition the job is completely different. You look at different laws.

What are the biggest challenges for the future?

To find a pragmatic solution on use. We cannot continue with such a stupid practice. Something has to change urgently or some companies will block domestic use by other companies. In France, filing a trade mark is a nightmare and if we are not careful in 10 years' time OHIM will be the same. Business risk is now a strategic tool.

Do you use electronic filing?

We use it about 90% of the time now. It is very quick and good for cost reasons. We have had a few problems – a few months ago the MYPAGE system failed and OHIM didn't inform us. But we called them up and they told us.

What other challenges are there?



I think we have to stop extending the countries covered by the CTM – we have added too many countries too quickly. But it would be interesting one day to include non-EU political countries, such as Norway and Switzerland. I also have recommendations regarding the differences between France and OHIM. OHIM must increase lobbying to oblige the French office to comply with the progressive attitude of examiners in OHIM. French examiners do not follow OHIM decisions – and that is a nonsense.

Community Trade Mark

KICKERS trade mark owner wins partial invalidity ruling

The Cancellation Division has declared the registration of the figurative CTM “Kick-Point” to be partially invalid following an application by the owners of the Italian trade mark “KICKERS”.



The “Kick-Point” CTM was registered by German company, Kick-Point Spiel-, Sport-, Freizeitgeräte GmbH, in 2000, for a range of goods and services. The invalidity ruling makes the registration invalid for all contested goods, namely goods of leather and imitations of leather; trunks and travelling bags; umbrellas, parasols and walking sticks in class 18, clothing, footwear, headgear in class 25 and games and playthings; gymnastic and sporting articles in class 28. However, the CTM remains registered for all remaining not contested goods and services in classes 3, 8, 16, 32, and 41.

The applicant, Societa Italiana Calzature S.p.A, which is well known in Italy for its children's shoe range “KICKERS”, filed a request for a declaration of invalidity on the grounds that the CTM was confusingly similar to the earlier marks of the applicant (Article 8(1) (b) CTMR in conjunction with Article 52(1) (a) CTMR) and that use of the contested CTM would take unfair advantage of or be detrimental to the acquired distinctiveness and reputation of one of its earlier marks. (Article 8(5) CTMR in conjunction with Article 52(1) (a) CTMR).

The Italian company claimed that there was a likelihood of confusion between the marks in dispute due to the identity and/or similarity between the goods in question and the similarity of the marks at hand, accentuated by the fact that its earlier mark “KICKERS” enjoyed a reputation in Italy, whose core and characteristic element “KICK” was repeated in its other earlier marks “KICK'S” and “MISSKICK” and reproduced in the contested CTM. The applicant also argued that the additional word “Point” of the CTM could not carry any weight in the comparison of the marks, since it was devoid of any distinctive character because of its descriptive content as a meeting or reference point.

The Cancellation Division found that there was an overall similarity between the contested mark and the earlier word mark as, among other things, from a visual point of view the

signs coincided in the first four letters, “KICK”. Taking into account that the public in general paid more attention to the beginning of trade marks, the signs had to be considered similar at least to an average degree, in particular because this sequence of letters, namely “KICK” was unusual in the Italian language. Even though, because of the figurative elements of the contested CTM, consumers might be able to differentiate at least visually between the signs, not much importance should be attached to the fact, since the figurative elements were rather common and unimaginative.

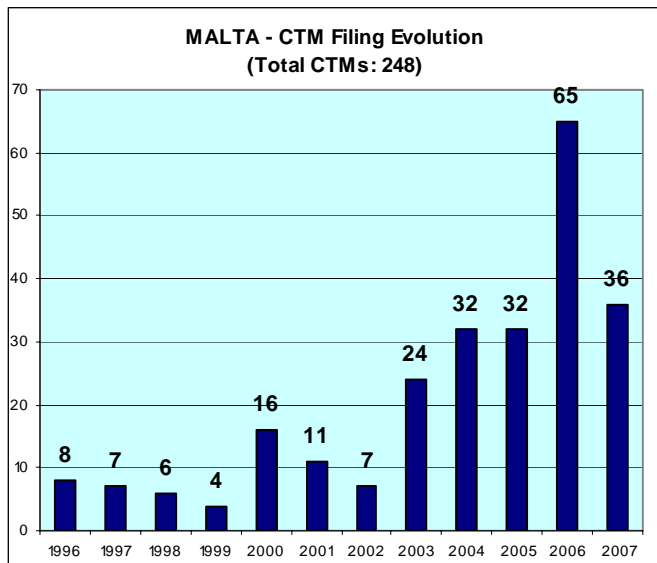
The decision found that there was a strong likelihood that the CTM proprietor would be able to ‘free-ride’ in Italy on the reputation of the earlier right by using the highly similar term ‘Kick-Point’.

The decision said: “In this respect, it must be taken into account that the earlier mark is well known in Italy and that the commercial contexts in which each party operates are sufficiently near as not to preclude the transfer of the earlier mark's brand image to the proprietor of the contested CTM. Nowadays, the fashion sector encompasses footwear, headgear, clothing, bags, umbrellas, leather articles, sporting articles even games, in short all the products that both the applicant and the CTM proprietor market. In the Office's estimation such free-riding on the coat-tails of the renowned earlier marks would amount to taking unfair advantage of both the distinctive character and of the repute of the earlier mark.”

Country Overview: Malta & the Community Trade Mark



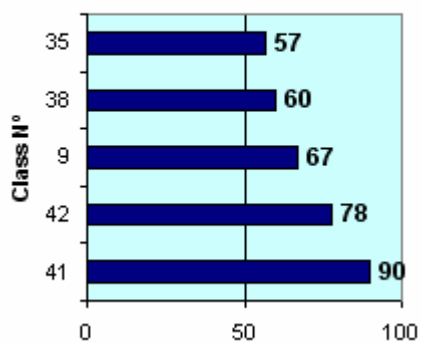
Malta joined the EU in May 2004, and has a population of 0.4m. After a sluggish performance in 2006, economic growth has picked up and was running at over 4% during the first half of 2007. The service sector accounts for almost three-quarters of GDP followed by industry (23%) and agriculture (3%). The main industries are tourism, electronics, ship building and repair, construction, food and beverages, pharmaceuticals, footwear, clothing and tobacco.



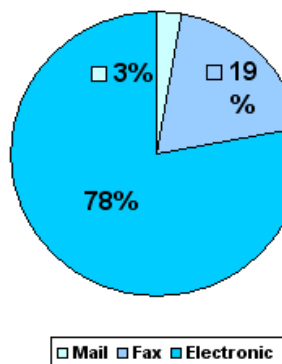
Word 56.45% **Figurative** 43.15% **3-D** 0.00% **Colour** 0.00% **Other** 0.40%

More than half the trade mark applications by Maltese enterprises are for word-based marks (56.45%), with almost all the remainder figurative marks (43.15%). The most popular goods and services applied for by Maltese businesses are in classes 41, 42, and 9.

MALTA - Top Classes Filed (Nice)



E-filing is by far the most popular route for Maltese businesses and their intermediaries, but a significant number of filings continue to be made by fax. This year, including International Registrations, 78% of all CTM filings were made electronically, while fax accounted for just over 19%.



Top 10 Maltese-based owners by number of CTMs filed

Company	CTMs
Mobisile Communications Limited	12
Simonds Farsons Cisk Plc	12
TP TUMAPHARMA Ltd	11
Central European Entertainment Service Group Limited	8
Euro Gaming Limited	7
Game Theory Limited	7
Bet United Ltd.	6
Nando's International Holding's Limited	6
Expekt.com Limited	5
blue-infinity ltd trading as b-i	4

Top 10 representatives by number of CTMs received from Maltese-based applicants

Representative	CTMs
SOCIETÀ ITALIANA BREVETTI S.P.	15
D. YOUNG & CO.	12
SATTLER & SCHANDA	11
MARKS & CLERK	10
GATT FRENDO TUFIGNO ADVOCATES	8
NÖRR, STIEFENHOFER & LUTZ	7
GROOM WILKES & WRIGHT LLP	6
ADVOKATFIRMAN DELPHI & CO KB	5
BERWIN LEIGHTON PAISNER LLP	5
HERTIN	5

Community Design US Design Patent versus RCD

The RCD is a relatively young instrument for protecting designs, but it has proved to be extremely popular in Europe. However, the view from the United States, where taking out a design patent is the method of protection, is not quite so encouraging.

Since 2003, when the RCD was created, OHIM has received more than 280,000 applications to register community designs but, despite the presence of many important US companies in Europe, a relatively small number were from across the Atlantic.

This month a group from OHIM attended the annual meeting of the American Intellectual Property Law Association (AIPLA) to try and put the case for considering the RCD when it comes to protecting designs.

Director of OHIM's design department Pedro Rodinger says that during the three-year period to 2006, 78% of all designs registered came from European businesses and just 9% from the US.

"If you compare this to the situation with CTMs, around 18-20% of all applications come from the US, which is twice the rate for RCDs. The total number of applications is also much greater in Europe than in the US. Part of the reason may be that when American companies think in terms of designs,



protection seems complicated and expensive, whereas Europeans think it is easy," says Rodinger.

Attending the AIPLA meeting is part of a long-term strategy to encourage US companies to think again about RCDs. Rodinger believes that there are differences between the US design patent protection and the RCD that need to be explained.

For example, the "novelty" requirement is stricter in a US design patent. In the US, a design is not novel if an average observer might confuse the new design with an already existing one, whereas for an RCD to fail the novelty test, it would have to be nearly completely identical. However, the "non-obviousness" requirement of the US design patent could be seen as less strict than the requirement that an RCD have "individual character".

Nevertheless, Rodinger believes that the differences between the US "novelty" and "non-obviousness" criteria and the RCD "novelty" and "individual character" are not as important as that fact that an RCD has arguably a wider application and is easier to apply for.

The fees for an RCD are around 70% lower and registration is significantly quicker – within eight weeks for an RCD compared with two years for a US design patent.

There is also no "originality" requirement for an RCD and the definition of a design is much broader, covering almost everything from products to packaging, parts of complex products, "get-ups", computer interfaces, logos and typefaces. "The usability of the RCD, which is not linked to an article of manufacture, is therefore higher, which is also reflected in the larger number of RCDs that are filed compared with US design patents", says Rodinger.

Rodinger believes that the fact that the RCD novelty examination is not carried out prior to registration is important. If companies consider that an RCD infringes their prior art, they request OHIM to declare it invalid.

"Four years of experience shows that this mechanism works. Only 400 invalidity requests have been received and in two-thirds of them the RCD was cancelled. This represents less than 0.3% of registrations", he adds.

Rodinger concedes that the US design patent and the RCD are quite different IP tools. In the US, patent attorneys might rightly advise clients that design protection was too costly and difficult. However, if a company did significant business in Europe, the situation could be different.

"Our main aim is to help US companies and their intermediaries understand the pros and cons of the RCD. We want to make sure that we are on their radar", says Rodinger.

Enlargement of a design's view: is it relevant for its assessment?

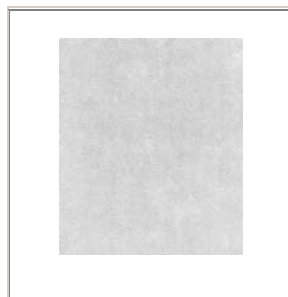
In two related decisions (ICD 3408 and ICD 3416) of 10.10.2007, the Invalidity Division of the Designs Department had to decide whether an enlargement of the view representing the design is relevant for the assessment of novelty and individual character.

The cases concerned, respectively, the registered Community designs (RCD) 583919-0005 and 603543-0002, as shown below:



Contested RCDs 583919-0005 (left) and 603543-0002 (right)
The indication of products for both contested RCDs reads "fabrics".

The claimant requested the invalidation of these two Community designs on the basis of Article 25(1)(b) CDR, arguing that they do not fulfil the requirements of novelty and individual character. As prior design the claimant pointed to the earlier Community design 398367-0001 (shown below), registered with "cloth" as an indication of products, and published prior to the contested RCDs.



Prior Community design 398367-0001

The claimant argued that the assessment of novelty and individual character should not be based on photographic enlargements of the designs, because a consumer is not able to recognize existing minimal differences between the designs with the naked eye.

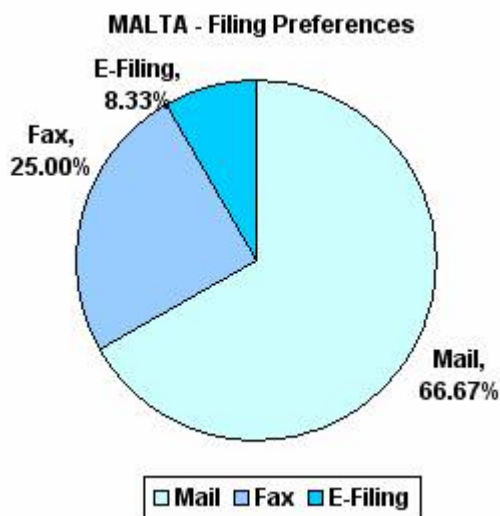
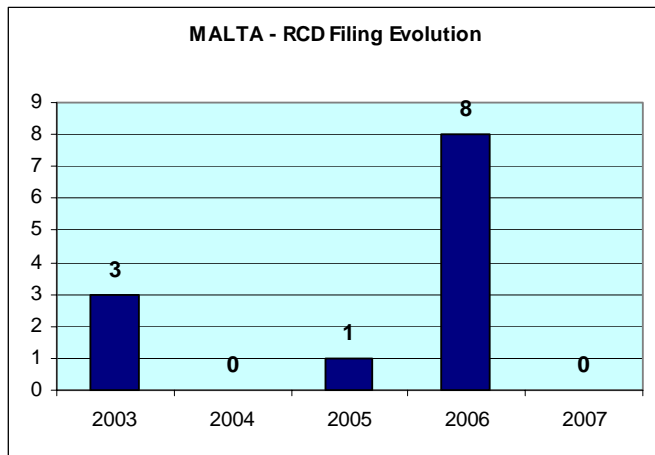
However, the Invalidity Division considered that "all features of a design discernible in the reproduction, which was based on the registration of the design as a registered Community design define the subject-matter of the protection right and therefore shall be taken into consideration in the assessment of the novelty and the individual character of the Community design. The scale of enlargement does not matter."

In comparing the two contested Community designs with the prior designs, the Invalidity Division found a number of differences which were judged to produce different overall impressions. According to the Invalidity Division, the informed user is usually a professional and, as there is a great variety of available fabrics in the market to choose from, he/she is able to recognise the differences between the designs in question. Therefore, the prior design was found to form an obstacle neither to novelty nor to the individual character of the two contested Community designs. The applications for a declaration of invalidity were rejected.

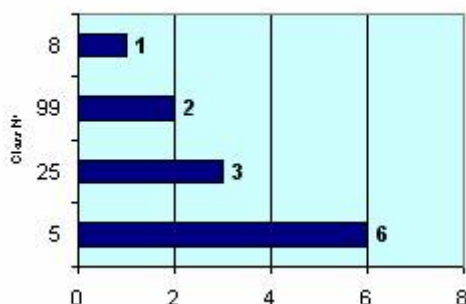


Country Overview: Malta & the Registered Community Design

Maltese filings of RCDs have been slow to take off. There were just eight filings last year, and there have been none so far in 2007. The most popular classes for Maltese design owners are 5, 25, and 99. Given the small sample it is difficult to generalise, but it seems that so far mail is the dominant route, with almost two-thirds of RCD applications arriving by post.



MALTA - Top Classes Filed (Locarno)



Top Maltese-based owners by number of RCDs filed

Owner	RCDs
LIOUBA Limited	6
Art Productions Limited.	2
POLAR Bear Trading Ltd.	2
Briks ltd	1
Caruana	1

Case-law

LATEST TRADE MARK AND DESIGN NEWS FROM LUXEMBOURG

A: ECJ European Court of Justice (ECJ): Appeals from decisions of the Court of First Instance, Article 63 CTMR

A-1: ECJ Judgments and Orders

Bainbridge/Bridge : C-234/06-P – Judgment of 13 September 2007 (appeal from T-194/03; dismissed; Office practice confirmed).

Keywords: ECJ proceedings: filing of new evidence at pending proceedings - ECJ proceedings: comparison of marks an issue of fact - Opposition: likelihood of confusion (LOC) – LOC: comparison of marks – Comparison of marks: value of aural similarity - LOC: family of marks – Family of marks: use requirement for being taken into account as “a family” – Family of marks: requirement of presence on the market - Family of marks: use: onus to show evidence on the holder of the earlier right.

The action was an appeal from the judgment of the CFI of 23. 2. 2006 in T-194/03 (Il Ponte Finanziaria v OHIM = (2006) ECR II-445) relating to CTM application 940.007, “Bainbridge” (fig.), which had been applied for in Classes 18 and 25. It had been opposed on the basis of 11 earlier Italian rights consisting of the word Bridge and combinations therewith, registered in Class 18 and/or Class 25. The opposition group concerned and the 4th Board of Appeal had rejected the application, mainly on the grounds that there is no LOC. The argument that there was a higher degree of likelihood of confusion because of the fact that the earlier rights form a family of marks had been rejected on the grounds that for most of them, no use had been shown. In its challenged decision, the CFI had confirmed these findings. The 4th Chamber of the ECJ (Lenaerts, rapporteur; Juhász; Silva de Lapuerta; Arestis and Malenovsky) dismissed the subsequent appeal.

(a) Filing of new evidence at pending proceedings

“(42) First of all, the Court rejects from the outset as inadmissible the argument by which the appellant, referring to a recent survey, effectively seeks to call into question the purely factual assessments made by the Court of First Instance at paragraphs 107 to 114 of the judgment under appeal concerning the conceptual similarities between the signs at issue. (43) Indeed, as was pointed out at paragraph 38 above, it is not for the Court, on appeal, to call into question such assessments, save where they are the result of



distortion of the documents on the file, which is not alleged in this case.”

(b) *Comparison of marks: Impact of aural similarity; comparison of marks an issue of fact*

“(33) Such a global assessment of the likelihood of confusion must be based on the overall impression created by those marks, bearing in mind, in particular, their distinctive and dominant components (see *Mülhens v OHIM*, paragraph 19, and, in particular, in respect of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 25).

(34) That global assessment means that conceptual and visual differences between two signs may counteract aural similarities between them, provided that at least one of those signs has, from the point of view of the relevant public, a clear and specific meaning, so that the public is capable of grasping it immediately (see Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-643, paragraph 20; *Mülhens v OHIM*, paragraph 35; and Case C-171/06 P *T.I.M.E ART v OHIM* [2007] ECR I-0000, paragraph 49).

(35) In that regard, as the Advocate General observed at paragraph 56 of her Opinion, the assessment of any aural similarity is but one of the relevant factors for the purpose of the global assessment. Therefore, one cannot deduce that there is necessarily a likelihood of confusion where mere phonetic similarity between two signs is established (*Mülhens v OHIM*, paragraphs 21 and 22).

(36) In the present case, the Court of First Instance considered, at paragraphs 116 and 117 of the judgment under appeal, that it cannot be concluded that there is a likelihood of confusion solely on the basis of aural similarities, the degree of aural similarity being of less importance on account of the manner in which the goods in question are marketed, so that, when making a purchase, the relevant public usually perceives visually the mark designating those goods.

(37) Thus, the Court of First Instance examined the overall impression created by the signs at issue, as regards any conceptual, visual and aural similarities between them, as part of a global assessment of the likelihood of confusion. It is in that context that it was able, without erring in law, to conclude that there was no such likelihood in the absence of any conceptual or visual similarity.

(38) Moreover, the applicant cannot require the Court to substitute its own assessment for that of the Court of First Instance. It is settled case-law that the effect of Article 225 EC and the first paragraph of Article 58 of the Statute of the Court of Justice is that an appeal lies on points of law only. The Court of First Instance thus has exclusive jurisdiction to find and appraise the relevant facts and assess the evidence. The appraisal of those facts and the assessment of that evidence thus do not, save where the facts and evidence are distorted, which is not alleged in this case, constitute a point of law which is subject, as such, to review by the Court of Justice on appeal (see, *inter alia*, Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057, paragraph 26, and Case C-412/05 P *Alcon v OHIM* [2007] ECR I-0000, paragraph 71).

(39) The findings made by the Court of First Instance at paragraphs 115 to 117 of the judgment under appeal constitute appraisals that are factual in nature. The Court of First Instance made a global assessment of the likelihood of confusion, based on the overall impression created by the conflicting marks, taking into account in particular their distinctive and dominant components.

(...)

(44) With regard, next, to the appellant's criticism concerning the Court of First Instance's assessment of the visual similarity, as set out at paragraphs 92 to 101 of the judgment under appeal, it should be recalled that, according to settled case-law, it follows from Article 225 EC, the first paragraph of Article 58 of the Statute of the Court of Justice and Article 112(1)(c) of the Court's Rules of Procedure that an appeal must indicate precisely the contested elements of the judgment which the appellant seeks to have set aside and also the legal arguments specifically advanced in support of the appeal (Case C-352/98 P *Bergaderm and Goupil v Commission* [2000] ECR I-5291, paragraph 34, and Case C-286/04 P *Eurocermex v OHIM* [2005] ECR I-5797, paragraph 42).

(45) The argument put forward by the appellant does not meet those requirements. In fact, it does not contain any legal argument to demonstrate the manner in which the Court of First Instance allegedly erred in law. The appellant does no more than reproduce the plea which it invoked before the Court of First Instance, without furnishing any further clarification and without identifying clearly the elements of the judgment under appeal that it wishes to challenge.

(46) Thus, that argument merely constitutes a request to have the action brought at first instance re-examined, in breach of the rules imposed by both the Statute of the Court of Justice and its Rules of Procedure.”

(...)

(c) *Family of marks issues*

“(62) While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a ‘family’ or ‘series’ of marks.

(63) The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.



(64) As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market.

(65) Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

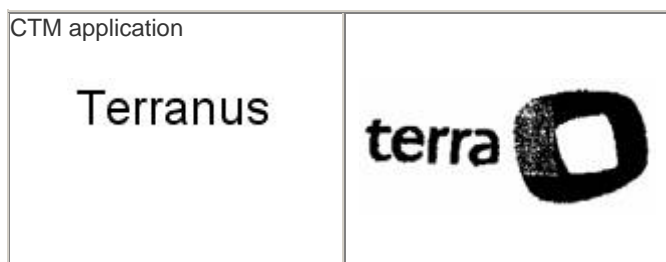
(66) It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to 'marks in a series'."

A-2: ECJ: Developments in pending cases

Terranus : C-243/07-P (appeal from T-322/05) - Office response filed (DE).

Keywords: Opposition: likelihood of confusion (LOC).

The case is an appeal from a decision of the CFI of 30. 5. 2007 in T-322/05 - Terranus/Terra. The CFI had confirmed rejection of the CTM application Terranus, in Class 36, on the basis of the earlier right "terra" (fig.), also in Class 36.



B: European Court of Justice: Preliminary Rulings

B-1: ECJ Preliminary Rulings

Benetton/G-Star : C-371/06 – Judgment of 20 September 2007 .

Keywords: Trade Marks Directive: Article 3(1)(e), 3 rd indent; Article 3(3) – 3D signs: shape which gives substantial value to the product – Substantial value: criteria: shape itself or advertising?

The case has been a reference from The Hoge Raad der Nederlanden made by decision of 12. 9. 2006 in a conflict between Benetton Group Spa and G-Star International BV regarding the marketing by Benetton of an item of clothing which, by virtue of its shape, infringes two shape marks registered by G-Star.

G-Star designs, manufactures and markets clothing (in particular jeans) of the trade mark of the same name. It is the proprietor of two shape marks for goods in Class 25, that is to say for clothing. Those two marks were registered on 7 August 1997 and 24 November 1999 . Protection was sought for each of them, respectively, on the basis of the following distinctive elements:

- Sloping stitching from hip height to the crotch seam, kneepads, yoke on the seat of the trousers, horizontal stitching at knee height at the rear, band of a contrasting colour or of another material at the bottom of the trousers at the rear, all on one garment;
- Seams, stitching and cuts on the kneepad of the trousers, slightly baggy kneepad.

Benetton manages textile trading undertakings. In the Netherlands it sells its products through franchisees. On 25 May 2000 , G-Star brought an action against Benetton before the Rechtbank te Amsterdam (Amsterdam District Court) in order to preclude any manufacture, marketing and/or distribution in the Netherlands of trousers with the mark Benetton. In support of its application, G-Star maintained that Benetton had infringed the trade mark rights attached to its Elwood design trousers by manufacturing and putting on the market, in the summer of 1999, trousers with, inter alia, an oval kneepad and two lines of sloping stitching from hip height to crotch height. Benetton challenged the application and, as a counterclaim, sought the annulment of the registered marks on the basis of the second paragraph of Article 1 of the Uniform Benelux Law on Trade Marks on the ground that the shapes at issue determined the market value of the goods to a great extent as a result of their beauty or original character. The first instance court dismissed G-Star's claims based on an infringement of its trade mark rights and Benetton's counterclaim.

On appeal, the Gerechtshof held that the Rechtbank was right to find, inter alia, that the Elwood trousers were a great commercial success, that G-Star had conducted intensive advertising campaigns to give those trousers, which have specific characteristics, recognition as a G-Star product, and that, as a result, the reputation of the Elwood trousers was largely attributable not to the aesthetic attractiveness of the shape but to the attractiveness resulting from recognition of the trade mark. The Gerechtshof pointed out that, through the extensive advertising carried out by G-Star, it had drawn particular attention to the distinctive characteristics of the trousers and the kneepad. On further appeal, the Hoge Raad der Nederlanden decided to stay the proceedings and refer the following questions to the Court of Justice for a preliminary ruling:

“(1) Must Article 3(1)(e), third indent, [of the Directive] be interpreted as meaning that the prohibition contained therein permanently precludes the registration of a shape as a trade mark where the nature of the product is such that its



appearance and shaping determine its market value entirely or substantially as a result of their beauty or original character, or does the prohibition not apply where, prior to the application for registration, the attractiveness of the relevant shape to the public has been determined predominantly by the recognition of it as a distinctive sign?

(2) If the answer to Question 1 is to the latter effect, to what extent must this attractiveness have prevailed for the prohibition no longer to apply?"

The 6th Chamber of the ECJ (Küris; Schiemann; Bay Larsen, rapporteur) answered the first question and stated that the answer would also cover the second question:

" The third indent of Article 3(1)(e) of First Council Directive 89/104/ EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks is to be interpreted as meaning that the shape of a product which gives substantial value to that product cannot constitute a trade mark under Article 3(3) of that directive where, prior to the application for registration, it acquired attractiveness as a result of its recognition as a distinctive sign following advertising campaigns presenting the specific characteristics of the product in question."

B-2: ECJ Preliminary Rulings: Developments in pending cases

Intel: C-252/07 - Reference from the UK Court of Appeal; Office contribution filed (internal document).

Keywords: Trade Marks Directive: Article 4(4): mark with reputation – Regulation 40/94 (CTMR): Article 8(5) CTMR – Reputation mark: risk of dilution.

The questions referred to the ECJ under Article 234 EC by the Court of Appeal (Civil Division) were raised in the context of national proceedings between Intel Corporation Inc. and CPM United Kingdom Ltd (CPM), on appeal from the High Court (Chancery Division), which was seized of the case on appeal from the Trade Marks Registry. Intel had lodged a request under the UK Trade Marks Act 1994, for the declaration of the invalidity of CPM's UK registration No. 2122181 of the word 'INTELMARK', which had been registered in respect of 'marketing and telemarketing services' in Class 35. The action was based on a number of earlier registrations concerning the word mark 'INTEL' and covering a range of goods and services in Classes 9, 16, 38 and 42. The grounds of invalidity were the provisions of the UK Act corresponding to Art. 4 (4) (a) of the First Council Directive 89/104/EEC of 21 December 1998 to approximate the laws of the Member States relating to trade marks ('TMD') and, more particularly, the 'dilution' of its reputed house mark 'INTEL'. According to the evidence, the mark 'INTEL' enjoys a huge reputation in respect of 'computers and computer-linked products', that is, for goods which are clearly dissimilar to the services of the contested registration and is 'unique' in the sense that it has not been used by anyone else for any other type of goods or services. By order dated 15 May 2007, the referring Court decided to stay the main proceedings and referred to the Court of Justice the following questions:

"For the purposes of Article 4 (4) (a) of the First Council Directive 89/104 of 21 December 1998 , where:

1. the earlier mark has a huge reputation for certain specific types of goods and services,

those goods and services are dissimilar, or dissimilar to a substantial degree, to the goods and services of the later mark,

the earlier mark is unique in respect of any goods or services,

the earlier mark would be brought to mind by the average consumer when he or she encounters the later mark used for the services of the later mark,

are those facts sufficient in themselves to establish (i) 'a link' within the meaning of paragraphs [29] & [30] of Adidas Salomon AG v. Fitnessworld Training Ltd, Case C-408/01, [2003] ECR I-12573 and/or (ii) unfair advantage and/or detriment within the meaning of that Article?

2. If no, what factors is the national court to take into account in deciding whether such is sufficient? Specifically, in the global appreciation to determine whether there is a 'link', what significance is to be attached to the goods or services in the specification of the later mark?

3. In the context of Article 4 (4) (a), what is required in order to satisfy the condition of detriment to distinctive character? Specifically, does (i) the earlier mark have to be unique (ii) is a first conflicting use sufficient to establish detriment to distinctive character and (iii) does the element of detriment to distinctive character of the earlier mark require an effect on the economic behaviour of the consumer?"

Céline : C-17/06 – Judgment of 11 September 2007 .

Keywords: TM Directive: Articles 5(1)(a) and 6(1)(a) – Infringement: use of identical sign – Third party sign an identical shop name – Fair use: name.

This case is a reference for a preliminary ruling under Article 234 EC by the Cour d'appel de Nancy (France) relating to a trade mark conflict between Céline SARL and Céline SA. The latter had been incorporated under that name in 1928; it is trading in the textile and fashion business. In April 1948, it filed the word Céline as a trade mark in all available classes but in particular for clothing and shoes; the right had been renewed. In September 1950, an individual, Mr Grynfogel, was registered as a trader in menswear and womenswear, trading under Céline. The latter business identifier eventually had been assigned to Céline SARL. Céline SA initiated proceedings against Céline SARL. In 2005 the referring appeal court asked:

"Must Article 5(1) of [the directive] ... be interpreted as meaning that the adoption, by a third party without authorisation, of a registered word mark, as a company, trade or shop name in connection with the marketing of identical



goods, amounts to use of that mark in the course of trade which the proprietor is entitled to stop by reason of his exclusive rights?"

The ECJ (Grand Chamber; composed of V. Skouris, President, P. Jann, C.W.A. Timmermans, A. Rosas, K. Lenaerts and R. Schintgen, Presidents of Chambers, A. Tizzano, J.N. Cunha Rodrigues, A. Borg Barthet, M. Ilešić (Rapporteur), J. Malenovský, J.-C. Bonichot and T. von Danwitz, Judges; Advocate General: E. Sharpston) gave the following answer:

"(13) By its question, the national court essentially asks whether the unauthorised use as a company, trade or shop name by a third party of a sign which is identical to an earlier word mark, in connection with the marketing of goods which are identical to those for which the mark was registered, constitutes use which the proprietor of the mark may stop in accordance with Article 5(1) of the directive. (...)

(15) In order to prevent the protection which is afforded to the proprietor varying from one Member State to another, the Court must give a uniform interpretation to Article 5(1) of the directive, in particular the term 'use' which appears there (Case C-206/01 Arsenal Football Club [2002] ECR I-10273, paragraph 45, and Case C-48/05 Adam Opel [2007] ECR I-0000, paragraph 17).

(16) As is clear from the Court's case-law (Arsenal Football Club; Case C-245/02 Anheuser-Busch [2004] ECR I-10989; and Adam Opel), the proprietor of a registered mark may prevent the use of a sign by a third party which is identical to his mark under Article 5(1)(a) of the directive only if the following four conditions are satisfied:

- that use must be in the course of trade;
- it must be without the consent of the proprietor of the mark;
- it must be in respect of goods or services which are identical to those for which the mark is registered, and
- it must affect or be liable to affect the functions of the trade mark, in particular its essential function of guaranteeing to consumers the origin of the goods or services.

(...)

(20) It is clear from the scheme of Article 5 of the directive that the use of a sign in relation to goods or services within the meaning of Article 5(1) and (2) is use for the purpose of distinguishing the goods or services in question, whereas Article 5(5) is directed at 'the use which is made of a sign for purposes other than distinguishing the goods or services' (Case C-63/97 BMW [1999] ECR I-905, paragraph 38).

(21) The purpose of a company, trade or shop name is not, of itself, to distinguish goods or services (see, to that effect, Case C-23/01 Robelco [2002] ECR I-10913, paragraph 34, and Anheuser-Busch, paragraph 64). The purpose of a company name is to identify a company, whereas the purpose of a trade name or a shop name is to designate a business which is being carried on. Accordingly, where the use of a

company name, trade name or shop name is limited to identifying a company or designating a business which is being carried on, such use cannot be considered as being 'in relation to goods or services' within the meaning of Article 5(1) of the directive.

(22) Conversely, there is use 'in relation to goods' within the meaning of Article 5(1) of the directive where a third party affixes the sign constituting his company name, trade name or shop name to the goods which he markets (see, to that effect, Arsenal Football Club, paragraph 41, and Adam Opel, paragraph 20).

(23) In addition, even where the sign is not affixed, there is use 'in relation to goods or services' within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party.

(24) In the main proceedings, it is for the national court to determine whether the use by Céline SARL of the Céline sign constitutes use in relation to those goods for the purposes of Article 5(1) of the directive (...).

On those grounds, the Court (Grand Chamber) hereby rules:

The unauthorised use by a third party of a company name, trade name or shop name which is identical to an earlier mark in connection with the marketing of goods which are identical to those in relation to which that mark was registered constitutes use which the proprietor of that mark is entitled to prevent in accordance with Article 5(1)(a) of First Council Directive 89/104/ EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, where the use is in relation to goods in such a way as to affect or to be liable to affect the functions of the mark. Should that be the case, Article 6(1)(a) of Directive 89/104 can operate as a bar to such use being prevented only if the use by the third party of his company name or trade name is in accordance with honest practices in industrial or commercial matters."

B-2: ECJ Preliminary Rulings: Developments in pending cases

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C:CFI Court of First Instance (CFI): Judgments and Orders on appeals against decisions of the OHIM, Article 63 CTMR

C-1: CFI Judgments and Orders

Aromacosmetique: T-185/04 – Case closed (as having become devoid of purpose = no need to adjudicate); Order of 11 September 2007 (FR).



Keywords: European procedural law: impact of a CFI “no need to adjudicate” order on the respective operative decision of the Office - Relative grounds for refusal – Cancellation: invalidation on relative grounds.

The action was directed against a decision of the 4th Board of Appeal of 11. 5. 2004 in R 0039/2002-4 relating to invalidity proceedings initiated against CTM 866.335, the word “Aromacosmetique”, in Class 3 for cosmetics etc. The CTM was challenged on the basis of an identical French word mark, registered in Classes 3 and 5. In the course of the proceedings, another identical national right with an even earlier priority date than the priority date of the right initially invoked was raised. This mark was registered for beauty parlours etc. in Class 42. The national mark invoked at a later point (the one for Class 42 services) was then revoked by a national court and the Office's Cancellation Division then declared the CTM invalid relying on the other earlier right which was invoked. On appeal, the CTM proprietor had claimed before the Board that proceedings should be stayed until national proceedings meanwhile initiated against the other earlier right had become final. The Board had rejected the claim and confirmed the findings of the Cancellation Division. While the CFI proceedings were pending, the remaining earlier national right was also revoked. In consequence, the 1st Chamber of the CFI (Cooke; Labucka; Prek) closed the case and stated that it had become devoid of purpose and that, in consequence, there was no need to adjudicate upon the issue. It also pointed out that in the given circumstances the decision of the Cancellation Division was without effect on the grounds that the appeal against it had suspensive effect. Regard should be had to the fact that in its Order, the Court dealt with the earlier rights invoked in the order of their priority, not in the order of their invocation (i.e. the initially invoked trade mark was referred to as the “second” and the subsequently invoked as “the first” mark).

Jako-O/Lagerfeld Jako : T-220/06 - Case closed; Order of 5 September 2007 .

Keywords: Opposition: likelihood of confusion (LOC).

The action concerned a decision of the 2nd Board of Appeal of 14. 6. 2006 in R 1178/2005-2 relating to an opposition case between Jako-O Möbel GmbH (plaintiff and CTM applicant) and P. I. Fashion B.V. The plaintiff had filed CTM application 2.395.564, word JAKO-O, for a range of goods and services in Classes 3, 8, 9, 11, 12, 14, 15, 16, 18, 20, 21, 24, 25, 28, 39 and 41. It had been opposed as regards Class 3 goods on the basis of the earlier Swedish right shown below which is registered in Class 3.



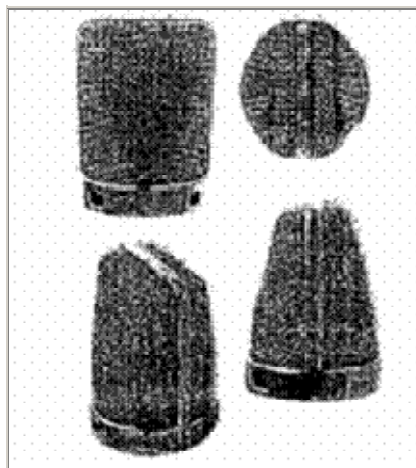
The opposition was allowed in full, i.e. as regards all claimed goods in Class 3. The CTM applicant had brought an action

against the said Board decision, but had then notified the Court that it wished to discontinue proceedings. In consequence, the case was removed from the register.

Microphone head grill : T-358/04 – Judgment of 12 September 2007 (action dismissed; Office practice confirmed).

Keywords: Absolute grounds for refusal: distinctiveness – Distinctiveness: 3D signs/shape of part of a product – Distinctiveness: impact of marketing concepts and price.

The action was directed against a decision of the 2nd Board of Appeal of 17. 6. 2004 in R 0919/2002-2, relating to the application, as a 3D mark, for the head grill of a microphone, applied for microphones, studio microphones etc. in Class 9.



It had been rejected on the grounds that the features of the sign are standard. These findings have been confirmed by the 1st Chamber of the CFI (Cooke; Garcia-Valdecasas; Labucka).

(a) *Distinctiveness: impact of marketing concepts and price?*

"(33) It is apparent from the arguments put forward by the applicant before the Court that it considers the products, in regard to which distinctive character must be assessed, to be exclusively expensive microphones, in particular, studio microphones. However, having regard to the list of products reproduced at paragraph 4 above, this view cannot be accepted. It is apparent from the use of the words 'in particular' in the description of the products that studio microphones, condenser microphones and pressure-gradient microphones were included only as examples and the list of products covered, therefore, microphones in general.

(34) In that regard, it could be that the applicant produces only expensive, high-quality microphones which, therefore, are bought only by professionals and acoustic specialists. However, as is apparent from the Court's case-law, circumstances outside of the right conferred by the Community trade mark, such as the concept of marketing and in particular the price of the relevant product, are not subject



to registration and consequently cannot be taken into account in the course of the assessment of the distinctive character of a mark (see, to that effect, Joined Cases T-324/01 and T-110/02 *Axions and Belce v OHIM* (Brown cigar shape and gold ingot shape) [2003] ECR II-1897, paragraph 36 and the case-law cited).

(35) It is not clear from the documents before the Court that the high quality or the expensive nature of the products covered by the application for registration are features necessarily imposed by the nature of those products (namely, microphones) or by the shape of the trade mark applied for, as reproduced at paragraph 2 above. On the contrary, the claim of the applicant that the affixing of a microphone head grill confirms that the product is of high value is contradicted by the arguments that the applicant itself put forward before the Board of Appeal to the effect that certain microphones of a similar design were low-quality products which were not in direct competition with those of the applicant. Nor is it clear from the documents before the Court that the shape of the mark applied for is able to be affixed only to studio microphones. On the contrary, the applicant confirms that, of itself, the head fulfils no function.

(36) Furthermore, the Court takes the view that it should not accede to the request to limit the list of products covered by the application for registration, as reproduced at paragraph 4 above, to 'studio microphones and their parts', as the applicant pleaded, by way of alternative submission, in its reply. The Court considers that this request seeks to alter the relevant public, with regard to whom the Board of Appeal analysed the distinctive character of the trade mark applied for, and as a consequence necessarily seeks to alter the scope of the dispute. It should be recalled in this regard that under Article 135(4) of the Rules of Procedure of the Court of First Instance the parties' pleadings may not change the subject-matter of the proceedings before the Board of Appeal. The task of the Court in the present proceedings is to review the legality of the decisions of the Boards of Appeal (Case T-173/00 *KWS Saat v OHIM* (Shade of orange) [2002] ECR II-3843, paragraph 13, and Case T-164/03 *Ampafrance v OHIM – Johnson & Johnson* (monBeBé) [2005] ECR II-1401, paragraphs 20 and 21).

(37) Accordingly, the distinctive character of the mark applied for must be assessed in regard to the products contained in the list set out at paragraph 4 above."

(...)

(b) Assessment of the distinctiveness of a 3D sign if it consists of the shape of the product (or part of it): specific criteria

"(41) According to established case-law, the criteria for assessing the distinctive character of three-dimensional marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade mark (C-24/05 P *Storck v OHIM*, paragraph 24 and the case-law cited). Therefore, the distinctive character of the mark applied for should be assessed with regard to the criteria mentioned at paragraph 32 above.

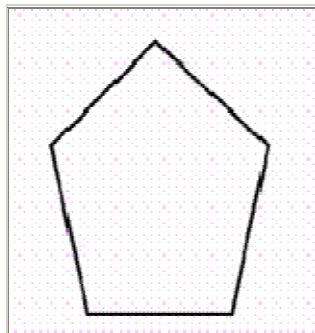
(42) None the less, for the purpose of applying those criteria, the relevant public's perception is not necessarily the same in the case of a three-dimensional mark, which consists of the appearance of the product itself, as it is in the case of a word or figurative mark, which consists of a sign unrelated to the appearance of the products it describes. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element, and it could therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark (C-24/05 P *Storck v OHIM*, paragraph 25 and the case-law cited).

(43) In those circumstances, only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94 (C-24/05 P *Storck v OHIM*, paragraph 26 and the case-law cited)."

Pentagon : T-304/05 – Judgment of 12 September 2007 (only in DE, FR; action dismissed; Office practice confirmed).

Keywords: Absolute grounds for refusal: distinctiveness – Distinctiveness: simple geometrical shape.

The action was directed against a decision of the 1st Board of Appeal of 23. 5. 2005 in R 0975/2004-1, relating to a CTM application which consisted of a pentagon (shown below), applied for in Class 33 for wine.



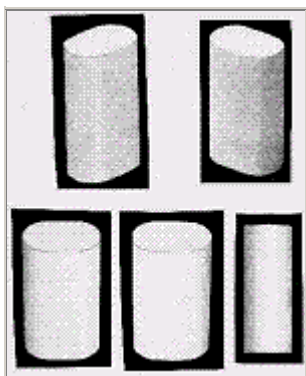
It was rejected on the grounds that the sign lacked distinctiveness for the goods claimed. The 1st Chamber of the CFI (Cooke; Garcia-Valdecasas; Cuica) confirmed these findings on the grounds that, in the wine trade, most simple geometrical shapes will not be perceived as a badge of origin.

Cigarette pack : T-140/06 – Judgment of 12 September 2007 (only in FR; action dismissed; Office practice confirmed).

Keywords: 3D signs: absolute grounds for refusal – Distinctiveness: shape of a pack of cigarettes.



The action was directed against a decision of the 4th Board of Appeal of 24. 2. 2006 in R 0075/2005-4, relating to the three-dimensional shape of a cigarette pack, for cigarettes.

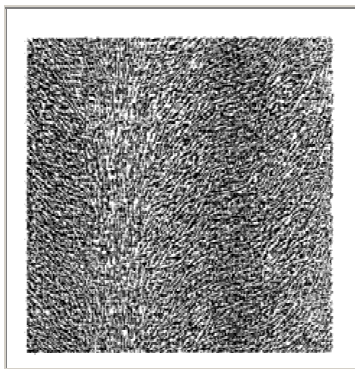


It had been rejected on the basis of standard criteria under Article 7(1)(b) CTMR. The 2nd Chamber of the CFI (Pirrung; Forwood; Papasavvas) confirmed these findings.

Patterned Glass-II or Glaverbel-II : T-141/06 – Judgment of 12 September 2007 (action dismissed; Office practice confirmed).

Keywords: CFI proceedings: claims (partial annulment) - Absolute grounds for refusal: distinctiveness – Distinctiveness: 3D sign: surface of the product – Distinctiveness acquired on the market: evidence – Acquired distinctiveness: relevant public.

The action was directed against a decision of the 4th Board of Appeal of 1. 3. 2006 in R0986/2004-4, relating to a sign claimed as a 3D mark which had been claimed as consisting of a design applied to the surface of goods. Registration was sought for Class 19: Building glass; patterned glass; glazing; glass sheets for building; glass screens and partitions, and for Class 21: Unworked or semi-worked glass (except glass used in building); patterned glass (except glass used in building); glass sheets (except glass used in building); glass sheets for use in the manufacture of sanitary installations, showers, shower walls, shower enclosures, refrigerator shelves, glazing, double glazing, building partitions, building screens, doors, cupboard doors, furniture, and kitchen cutting boards.



It had been refused on the basis of Article 7(1)(b) CTMR. The argument of acquired distinctiveness had been rejected since the filed evidence had solely contained experts' views. The 2nd Chamber of the CFI (Pirrung; Meij; Pelikánová) confirmed these findings.

(a) CFI proceedings: claims

“(14) The application for partial annulment of the contested decision submitted by the applicant is not contrary to the prohibition in Article 135(4) of the Rules of Procedure on changing, before the Court of First Instance, the subject-matter of the proceedings before the Board of Appeal (Case T-289/02 Telepharmacy Solutions v OHIM (TELEPHARMACY SOLUTIONS) [2004] ECR II-2851, paragraph 14). In addition, it should be recalled that the applicant has not changed the intended purposes of the goods in question. It is thus necessary to examine the distinctive character of the mark applied for only in so far as it concerns the goods in question.”

(...)

(b) Distinctiveness: target public

“(20) The distinctive character of a mark, including that acquired through use, must be assessed in relation to the goods in respect of which registration is applied for and in the light of the presumed perception of an average consumer of the category of goods in question, who is reasonably well informed and reasonably observant and circumspect (judgment of 15 December 2005 in Case T-263/04 BIC v OHIM (shape of a lighter with a flint), not published in the ECR, paragraph 65).

(21) First, as regards 'patterned glass (except glass used in building)' and 'glass sheets (except glass used in building)' it is clear that, contrary to the applicant's submission, those goods are not solely intended to be sold to professionals. Assessed in relation to their description, those categories also include, in addition to semi-worked glass sheets requiring processing, ready-to-use glass sheets which are likely to be bought and used by final consumers. Consequently, such consumers are part of the relevant public in respect of those two categories of goods.

(22) Second, as regards the other goods in question, namely 'glass sheets for use in the manufacture of showers, shower walls, shower enclosures, glazing, double glazing, building partitions, building screens, doors, cupboard doors and furniture', it should be pointed out that, even supposing that such goods are sold only to professionals, that finding is not sufficient, by itself, in the circumstances of the present case, to warrant the conclusion that the target public is made up exclusively of professionals.

(23) According to settled case-law, the essential function of a trade mark is to guarantee the identity of the origin of the product or service covered by the mark to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (Case C-39/97 Canon [1998] ECR I-5507, paragraph 28; Case C-517/99 Merz & Krell [2001] ECR I-6959, paragraph 22; and Case C-371/02 Björnekulla



Fruktindustrier [2004] ECR I-5791, paragraph 20). In general, the perception of consumers or end users plays a decisive role since the whole aim of the commercialisation process is the purchase of the product by those persons and the role of the intermediary consists as much in detecting and anticipating the demand for that product as in increasing or directing it (Björnekulla Fruktindustrier, paragraph 24).

(24) The consumers and end users of the goods are not necessarily those which have concluded a contract of sale with the producer. It is not uncommon for a manufacturer of goods not to be in direct contact with the final consumer.

(25) In the circumstances of this case, a final consumer who entrusts to a professional in the building industry work requiring the use of patterned glass normally chooses the design to be used. In so far as a design such as the one which makes up the mark applied for remains visible in the final product and is thus capable of having an aesthetic function, the final consumer has an interest in being involved in choosing it. Although it is true that he is helped by a professional, the fact remains that the consumer is confronted with the various designs that are available by way of a catalogue or samples, and that he chooses from them the one which suits him best. Therefore, the choice of the specific design of the glass sheet which will be used is determined, to a significant extent, by the final consumer, notwithstanding the fact that the sheet will be bought by the professional employed to carry out the work.

(26) Consequently, for all of the goods in question the target public is made up not only of professionals but also of the general public. Consequently, the applicant's first argument must be rejected." (...)

(c) Acquired distinctiveness: criteria

"(32) It is clear from the case-law that the acquisition of distinctiveness through use of a mark, under Article 7(3) of Regulation No 40/94, requires that at least a significant proportion of the relevant section of the public identifies the products or services as originating from a particular undertaking because of the mark. However, the circumstances in which the condition as to the acquisition of distinctiveness through use may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data, such as specific percentages (Case T-402/02 Storck v OHIM (shape of a sweet wrapper) [2004] ECR II-3849, paragraph 77, and the case-law cited).

(33) In assessing, in a particular case, whether a mark has become distinctive through use, account must be taken of factors such as, inter alia, the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been, the amount invested by the undertaking in promoting the mark, the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking and statements from chambers of commerce and industry or other trade and professional associations. If, on the basis of those factors, the relevant class of persons, or at least a significant proportion thereof, identifies goods as originating from a particular undertaking because of the trade mark, it must be concluded that the requirement for registering the mark laid

down in Article 7(3) of Regulation No 40/94 is satisfied (see shape of a sweet wrapper, cited in paragraph 32 above, paragraph 79, and the case-law cited).

(34) As regards the declarations from the specialised public which the applicant provided, it is common ground that they do not come from all the Member States of the European Community. The applicant has not submitted any declaration from Denmark, Finland, Sweden, Greece or Ireland.

(35) A mark can be registered under Article 7(3) of Regulation No 40/94 only if evidence is produced to show that it has acquired, through the use which has been made of it, distinctive character in the part of the Community in which it did not originally have such character within the meaning of Article 7(1)(b) (Case C-25/05 P Storck v OHIM [2006] ECR I-5719, paragraph 83).

(36) In the case of non-word marks it may be assumed that the assessment of their distinctiveness will be the same throughout the Community, unless there is concrete evidence to the contrary (Case T-399/02 Eurocermex v OHIM (shape of a beer bottle) [2004] ECR II-1391, paragraph 47, and shape of a sweet wrapper, cited in paragraph 32 above, paragraph 86).

(37) In the present case, the impression which the sign, consisting of a pattern applied to the goods themselves, may create in the mind of the consumer is in principle likely to be the same throughout the Community, as rightly submitted by OHIM.

(38) It is thus in the Community as a whole that that mark must have become distinctive through use in order to be registrable under Article 7(3) of Regulation No 40/94.

(39) The declarations from professionals in 10 of the 15 Member States of the European Community, as at the date of filing of the application for registration of the mark, are not capable of proving that the sign has acquired distinctive character in the five remaining countries of the Community.

(40) In that regard, it must be observed that the applicant's argument that the approach consisting of counting the number of countries from which evidence emanates is contrary to the need to regard the European Community as a single market cannot be upheld. Under Article 7(1)(b) of Regulation No 40/94, read in conjunction with Article 7(2) thereof, a mark must be refused registration if it is devoid of any distinctive character in part of the Community and the part of the Community referred to in Article 7(2) may be comprised of a single Member State (Storck v OHIM, cited in paragraph 35 above, paragraphs 81 to 83). The Board of Appeal thus rightly examined the evidence concerning distinctive character acquired through use for each Member State separately.

(41) As regards sales volumes and advertising material, the applicant concedes that these can be regarded only as secondary evidence which may support, where relevant, the direct proof of distinctive character acquired through use, such as provided by the declarations. The sales volumes and advertising material as such do not show that the public



targeted by the goods in question perceives the sign as an indication of commercial origin. In respect of the Member States of the Community for which no declaration has been produced, proof of distinctive character acquired through use cannot be furnished by the mere production of sales volumes and advertising material. Moreover, the applicant has not specified the market share of those goods nor the number of catalogues distributed in each of the Member States.

(42) The fact that the sign has been used in the Community since around 1970 is also not sufficient, as such, to show that the public targeted by the goods in question perceives it as an indication of commercial origin. In addition, the applicant does not specify when it started to market products bearing that sign in each of the Member States of the Community.“

Basics : T-164/06 – Judgment of 12 September 2007 (action dismissed; Office practice confirmed).

Keywords: Absolute grounds for refusal: distinctiveness. – Distinctiveness: assessment: impact of previous OHIM decisions and of national decisions. - Distinctiveness: acquired on the market: evidence.

The action was directed against a decision of the 4th Board of Appeal of 7. 4. 2006 in R 0788/2005-4, relating to CTM application “Basics” (word) which had been applied for a range of goods in Class 2, namely: Water colour paints, varnishes other than insulating varnish, lacquers in the nature of a coating, enamel coatings in the nature of paints, colouring matters in the nature of acrylic paints, acrylic primers, oils paints, water colours, artists' varnishes, pastel oil colours, liquid leaf colours, artists' alkyd colours, artists' mediums namely paint thinners and solvents, inks and dyes for use by artists or for use in handcrafts. In its decision the Board had noted that, since the word 'basics' is an English word, the relevant public was primarily made up of persons established in the Community who are native English speakers or who have a sufficient knowledge of the English language. For this public the word 'basics' refers to basic goods, that is, the most important goods, elementary goods or the goods most commonly used by artists. Therefore, the mark BASICS should be considered to be descriptive, within the meaning of Article 7(1)(c) CTMR, and accordingly devoid of distinctive character within the meaning of Article 7(1)(b) CTMR. In relation to the distinctive character which the mark BASICS was said to have acquired in accordance with Article 7(3) CTMR, the Board had found that the applicant had failed to prove its use, before the date on which the application for registration was filed, in those parts of the Community where that mark had been considered to be lacking distinctive character. The 4th Chamber of the CFI (Legal; Wiszniewska-Bialecka; Moavero Milanesi) confirmed these findings.

(a) Scope of Article 7(1)(c) CTMR

“(20) It follows that, for a sign to be caught by the prohibition set out in Article 7(1)(c) of Regulation No 40/94, there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of one of the characteristics of the goods and services in question (Case T-19/04 Metso Paper

Automation v OHIM (PAPERLAB) [2005] ECR II-2383, paragraph 25).

(21) According to the case-law, it is irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary. The wording of Article 7(1)(c) of Regulation No 40/94 does not draw any distinction by reference to the characteristics which may be designated by the signs or indications of which the mark consists and covers not only the characteristics listed but any other characteristic of the goods and services designated by the mark. In fact, in the light of the public interest underlying that provision, any undertaking must be able freely to use such signs and indications to describe any characteristic whatsoever of its own goods, irrespective of how significant the characteristic may be commercially (see, in relation to Article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), the legislative content of which is, in essence, identical to that of Article 7(1)(c) of Regulation No 40/94, Case C-363/99 Koninklijke KPN Nederland [2004] ECR I-1619, paragraph 102).

(22) In the present case, the goods for which registration of the mark BASICS is sought are paints, varnishes, lacquers, colours, thinners and other similar articles. Given their relatively frequent use and low cost, those goods may be regarded as being intended for the general consumer and, therefore, the relevant public is deemed to be the general public, as found by the Board of Appeal. Similarly, the Board of Appeal rightly considered that, since the word sign at issue is an English word, the relevant public in relation to which it is necessary to assess whether that sign has descriptive character is the English-speaking public.

(23) As found by the Board of Appeal and acknowledged by the applicant, in the English language, the word 'basics' denotes essential, fundamental or elementary elements, which constitute a basis. In reading that everyday word in the English language, the target public may thus immediately, and without further thought, perceive it as a description of one of the characteristics of the relevant goods, namely the fact that they are basic goods for the Fine Arts and for decoration. The applicant even acknowledged (paragraph 13 of the application) that the word 'basics' is intended to give potential customers the impression that the relevant goods are fundamental and easy to use. In addition, it is apparent from Annexes 13 and 14 to the application that the applicant emphasises that characteristic to market the relevant goods by presenting them as being intended for inexperienced painters and students.“

(...)

(b) Impact of previous OHIM decisions and of national decisions

“(28) Next, the applicant's argument that OHIM has, in the past, registered marks containing similar words to the word mark BASICS cannot be upheld. In the first place, the marks cited by the applicant can be distinguished from the mark for which registration is sought in that they denote goods and services other than those which are involved in this case.



Secondly, decisions concerning registration of a sign as a Community trade mark which the Boards of Appeal are called on to take under Regulation No 40/94 are adopted in the exercise of circumscribed powers and are not a matter of discretion. Accordingly, the registrability of a sign as a Community trade mark must be assessed only on the basis of the relevant Community legislation, as interpreted by the Community judicature, and not on the basis of a different approach taken in the past by the Boards of Appeal in their decisions (PAPERLAB, cited in paragraph 20 above, paragraph 39, and the judgment of 30 November 2006 in Case T-43/05 Camper v OHIM – JC (BROTHERS by CAMPER) [2006], not published in the ECR, paragraph 93).

(29) Finally, the applicant's arguments that there are national decisions registering the trade mark BASICS for identical or similar goods cannot be upheld. The Community trade mark regime is an autonomous system with its own set of objectives and rules peculiar to it; it applies independently of any national system (Case T-32/00 Messe München v OHIM (electronica) [2000] ECR II-3829, paragraph 47, and Case T-15/05 De Waele v OHIM (Shape of a sausage) [2006] ECR II-1511, paragraph 44). OHIM and, if appropriate, the Community judicature are not bound by a decision given in a Member State, or a third country, that the sign in question is registrable as a national mark. That is so even if such a decision was adopted in a country belonging to the linguistic area in which the word sign in question originated (Case T-106/00 Streamserve v OHIM (STREAMSERVE) [2002] ECR II-723, paragraph 47, and PAPERLAB, see paragraph 20 above, paragraph 37).“

(...)

(c) Article 7(3) CTMR: acquired distinctiveness on the market

“(44) As regards the documents in Annexes 10, 11 and 12 of the application, which were not submitted in the course of the administrative proceedings, it is necessary to recall that the purpose of an action before the Court of First Instance is to review the legality of decisions of the Boards of Appeal of OHIM within the meaning of Article 63 of Regulation No 40/94. It is not the Court's function to re-evaluate the factual circumstances in the light of evidence adduced for the first time before it (Case T-128/01 DaimlerChrysler v OHIM (Grille) [2003] ECR II-701, paragraph 18, Case T-320/03 Citicorp v OHIM (LIVE RICHLI) [2005] ECR II-3411, paragraph 14). Therefore, those documents must be dismissed without there being any need to examine their evidential value.

(45) As regards distinctive character acquired through use of the mark under Article 7(3) of Regulation No 40/94, it is necessary to recall the case-law, according to which the acquisition of such distinctive character requires that at least a significant proportion of the relevant section of the public identifies products or services as originating from a particular undertaking because of the mark (Case T-399/02 Eurocermex v OHIM (Shape of a bottle of beer) [2004] ECR II-1391, paragraph 42).

(46) In that regard, it must be shown that the mark had become distinctive through use before the application for registration was filed (Case T-247/01 eCopy v OHIM (ECOPY) [2002] ECR II-5301, paragraph 36, and Case T-

262/04 BIC v OHIM (Shape of a flint lighter) [2005] ECR II-5959, paragraph 66). In addition, that use must be demonstrated in the substantial part of the Community where it was devoid of any distinctive character under Article 7(1)(b) to (d) of Regulation No 40/94 (Case T-91/99 Ford Motor v OHIM (OPTIONS) [2000] ECR II-1925, paragraph 27, and BIC v OHIM, paragraph 62). In addition, the circumstances in which the requirement that a mark must have become distinctive may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data (Shape of a bottle of beer, cited in paragraph 45 above, paragraph 39, and the case-law cited).

(47) Thus, it is necessary to take account, in particular, of the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been, the amount invested by the undertaking in promoting the mark, the proportion of the relevant classes of persons who, because of the mark, identify goods as originating from a particular undertaking, statements from chambers of commerce and industry or other trade and professional associations and opinion polls (Shape of a beer bottle, cited in paragraph 45 above, paragraph 44, and the case-law cited).

(48) In the present case, the onus was on the applicant to prove, before the Board, that the mark BASICS had been used before the application for registration was filed, on 31 October 2001, in the parts of the Community where the mark has been considered to be descriptive, namely the United Kingdom and Ireland.

(49) For that purpose, the applicant produced before the Board, first, documents featuring tubes of acrylic paint bearing the mark BASICS, second, print outs of a website belonging to the applicant containing promotional material and, finally, a sworn declaration by the General Manager of the European distributor for goods designated by the mark BASICS concerning sales of acrylic paint between 1993 and 2004. The applicant also claimed that the product line 'basics' was the world market leader for fine arts acrylic paints as a result of its innovative efforts.

(50) None of the documents featuring tubes of acrylic paint bearing the mark BASICS and none of the print-outs containing promotional material contains any form of reference to the dates and places where those goods were marketed or where such material was used. Therefore, the Board rightly found that those documents were not capable of showing that the target public perceived the mark for which registration was sought to be an indication of the commercial origin of those goods.

(51) The sworn declaration referred to above shows, in addition, that no goods bearing the mark for which registration is sought were sold in Ireland before 2002. As regards the United Kingdom, those goods were not marketed before 2000, in the course of which 75 units were sold out of a total of 443 329 units sold in the European Union, whereas 1 008 sales were made in 2001 out of a total of 513 003 units sold in the European Union. In the light of that data, the Board could validly find that use of the mark BASICS in the United Kingdom and Ireland before 31 October 2001 had been minimal.

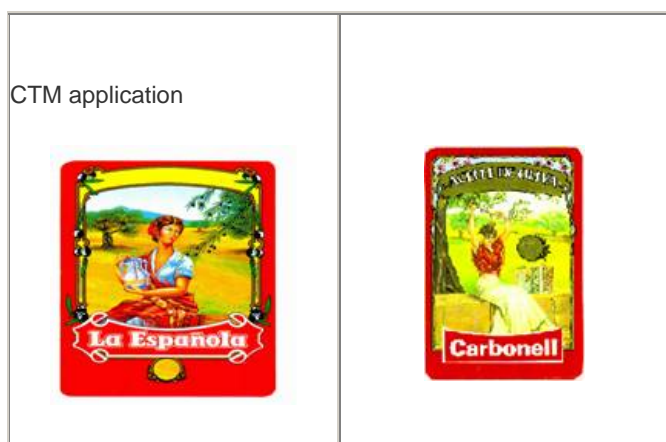


(52) As regards the applicant's assertions as to the market share held by the mark BASICS and the magnitude of its promotion, those assertions have not, as was noted by the Board, been proven."

La Española or Carbonell : T-363/04 – Judgment of 12 September 2007 (decision of the Board altered; held that the opposition is well founded).

Keywords: CFI proceedings: arg. of res judicata – Res judicata: an issue of admissibility - CFI proceedings: admissible claims - CFI proceedings: scope of power of attorney for a representative – CFI proceedings: power of the court to alter Board proceedings - Opposition: likelihood of confusion (LOC) – LOC: comparison of marks – LOC: protection of the general concept represented in a sign.

The action was directed against a decision of the 4th Board of Appeal of 11. 5. 2004 in R 1109/2000-4, relating to the CTM application depicted below which had been applied for in Class 29 for a range of products (the colour representations are set out in the Board decision). It had been opposed on the basis of the Spanish Carbonell brand, registered for olive oil in Class 29. Whereas the Board had denied LOC on the grounds that the marks at issue are sufficiently dissimilar, the 1st Chamber of the CFI (Cooke; Garcia-Valdecasas; Ciuca) altered that decision and allowed the opposition.



(a) *The admissibility of the application for a declaration by the Court that the trade mark is invalid or, if appropriate, an order refusing registration*

"(26) OHIM considers that the applicant's second head of claim, seeking a declaration that the La Española mark is invalid or, if appropriate, an order that its registration be refused, is inadmissible since the Court of First Instance is not entitled to issue directions to OHIM. It is for OHIM to draw the appropriate inferences from the operative part of this judgment and the grounds on which it is based (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 19).

Findings of the Court

(27) The applicant's second head of claim is divided into two parts. In the first part, the applicant seeks a declaration that the La Española mark is invalid. In the second part, it seeks an order refusing registration of that mark.

(28) As far as the application to annul the La Española mark is concerned, it should be recalled that Article 62(3) of Regulation No 40/94 provides that the decisions of the Boards of Appeal are to take effect, if an action has been brought before the Court of Justice, only as from the date of rejection of such action. Accordingly, as OHIM rightly states, the mark applied for has not yet been registered and cannot be annulled. Therefore, the first part all the applicant's second head of claim is devoid of purpose.

(29) As far as the second part of the head of claim is concerned, the applicant essentially requests the Court to adopt the decision that it claims OHIM should have taken, namely that the conditions for opposition have been fulfilled, in order that OHIM enforce it by refusing registration of the mark applied for.

(30) Therefore, the applicant requests that the contested decision be altered, as provided for in Article 63(3) of Regulation No 40/94. That is not a request to the Court to require OHIM to do or to refrain from doing something, which would constitute a direction addressed to the latter. On the contrary, it requests the Court to decide, on the same basis as the Board of Appeal, whether the mark applied for may be registered in the light of Article 8(1)(b) of Regulation No 40/94. Such a decision falls within the measures which may be taken by the Court of First Instance in the exercise of its power to amend decisions (see, to that effect, Case T-334/01 MFE Marienfelde v OHIM – Vétouquinol (HIPOVITON) [2004] ECR II-2787, paragraph 19, and Case T-190/04 Freixenet v OHIM (Shape of a white emerald bottle) [2006] ECR II-79, paragraph 17).

(31) It follows that the second part of the applicant's second head of claim is admissible."

(b) *The scope of the authority of the applicant's representative*

(32) The intervener submits that the authority conferred on the applicant's lawyer does not enable him to represent the applicant before the Court. According to the intervener, the power of attorney lodged by the applicant in favour of Mr Munguía Arsuaga empowers the latter to represent the applicant before the Spanish courts and not before the Community Courts. Therefore, the authority conferred on Mr Fernández de Béthencourt, the lawyer who signed the application in the name and on behalf of the applicant, by Mr Munguía Arsuaga, exceeds the powers invested in the latter.

Findings of the Court

(33) Article 44(5)(b) of the Rules of Procedure of the Court of First Instance requires that an application made by a legal person governed by private law is to be accompanied by proof that the authority granted to the applicant's lawyer has



been properly conferred on him by someone authorised for the purpose.

(34) It is clear from the power of attorney of 16 August 2004 in favour of the applicant's designated representative, Mr Munguía Arsuaga, that the latter had the power to represent the applicant himself or to instruct other lawyers in that respect, 'at both international and international level', which includes representation before the Court of First Instance. Therefore, it is surprising that the intervener argues that the authority conferred on Mr Fernández de Béthencourt by Mr Munguía Arsuaga exceeds the powers invested in the latter. That argument is clearly and manifestly contrary to the facts.

(35) It follows that this plea of inadmissibility must be rejected."

(c) Application of the principle of the authority of a final decision

(36) The intervener takes the view that the preliminary objection of the authority of a final decision laid down in Article 55(3) of Regulation No 40/94, according to which an application for revocation or for a declaration of invalidity is inadmissible if an application relating to the same subject matter and cause of action, and involving the same parties, has been adjudicated on by a court in a Member State and has acquired the authority of a final decision, is applicable in this case.

(37) The intervener considers that the judgment of 7 July 1997 of a Spanish court, namely the Audiencia Provincial de Sevilla (Provincial Court, Seville, Spain) must be regarded as having the authority of a final decision, within the meaning of Article 55(3) of Regulation No 40/94, since it concerns the same parties and the same subject-matter and cause of action as those in the present case. The judgment in question concerns a dispute between the applicant and the intervener in which the applicant tried to deprive the intervener of the use of a Spanish mark identical to the La Española mark on the basis of the prohibition on imitations provided for by Ley 3/1991, de 10 enero, de competencia desleal (Spanish Law No 3/91 of 10 January 1991 on unfair competition) (BOE No 10 of 11 January 1991, p. 959). That judgment held that the two marks in dispute were compatible and rejected the applicant's application. That judgment became final when, by order of the Tribunal Supremo (Spanish Supreme Court) of 16 February 1999, the appeal brought by the applicant was dismissed. Therefore, the intervener claims that this action is inadmissible.

(38) The applicant and OHIM submitted at the hearing that Article 55 of Regulation No 40/94 did not apply in this case because the cause of action and the subject-matter in this case are not the same as that which gave rise to the judgment of the Audiencia Provincial de Sevilla.

Findings of the Court

(39) According to settled case-law, the Community trade mark regime is an autonomous system, comprising a set of rules and pursuing objectives which are peculiar to it, and it applies independently of any national system (Case T-32/00 Messe

München v OHIM (electronica) [2000] ECR II-3829, paragraph 47, and Case T-346/04 Sadas v OHIM – LTJ Diffusion (ARTHUR ET FELICIE) [2005] ECR II-4891, paragraph 70).

(40) Therefore, the legality of decisions of the Boards of Appeal must be assessed solely on the basis of Regulation No 40/94, as interpreted by the Community Courts, and not on the basis of national law (Case T-162/01 Laboratorios RTB v OHIM – Giorgio Beverly Hills (GIORGIO BEVERLY HILLS) [2003] ECR II-2821, paragraph 53; Case T-85/02 Díaz v OHIM – Granjas Castelló (CASTILLO) [2003] ECR II-4835, paragraph 37; and Case T-115/02 AVEX v OHIM – Ahlers (a) [2004] ECR II-2907, paragraph 30).

(41) The principle of autonomy of the Community system is a fortiori applicable in situations such as that in this case, since the judgment of the Audiencia Provincial de Sevilla was not based on rules similar to those in Regulation No 40/94, but on a law relating to unfair competition.

(42) It is also important to point out that Article 55(3) of Regulation No 40/94 is an exception to the abovementioned principle. That provision merely provides that OHIM must make a finding of inadmissibility against an application for revocation or for a declaration of invalidity of a Community trade mark that has already been registered where an application having the same subject-matter, that is the revocation or a declaration of invalidity of that Community mark, has been decided between the same parties by a national court and that decision has acquired the authority of a final decision.

(43) Therefore, that provision cannot have any effect on the admissibility of this action, which does not constitute an application for revocation or a declaration of invalidity and was not brought before OHIM, but before the Court of First Instance.

(44) Finally, it must be observed for the sake of completeness that, contrary to the intervener's submissions, the case decided by the Audiencia Provincial de Sevilla in the judgment of 7 July 1997 did not have the same cause of action or subject-matter as those in the present case. As regards the cause of action, the case concerned an infringement of the Spanish Law on unfair competition, whereas this case concerns a question relating to Regulation No 40/94. As regards the subject-matter of that case, it must be observed that the judgment of the Audiencia Provincial de Sevilla was essentially based on the judgment of the Tribunal Supremo of 10 June 1987, which did not hold that the Carbonell mark was compatible with the mark applied for. None the less, the judgment of the Tribunal Supremo concerned only the question of compatibility of the intervener's mark, which showed a strong similarity with the mark applied for with the La Española mark, belonging to the applicant, registered for 'cooked pork meats' in Class 29 of the Nice Agreement. Therefore, it cannot be held that the subject-matter is the same, since the marks at issue are different from those in dispute in this case.

(45) This plea of inadmissibility must therefore be rejected."(...)



(d) LOC and comparison of goods

"(70) It must be observed, at the outset, that in the contested decision the Board of Appeal finds (paragraph 17) that the goods covered by the Carbonell mark and those covered by the mark applied for were partly identical (edible oils and fats within Class 29 of the Nice Agreement), partly very similar (salt, mustard, vinegar, sauces (condiments); spices, goods in Class 30 of the Nice Agreement) and, as far as concerns the remainder of the goods, that they were distinct.

(71) Nevertheless, as the applicant rightly submits and as OHIM and the intervener admitted at the hearing, the Board of Appeal should have limited itself to finding in the contested decision that the goods covered by the Carbonell mark were identical to those covered by the mark applied for where the latter concern olive oil, and should have held that there was a very high degree of similarity between the goods covered by the Carbonell mark and those covered by the mark applied for where the latter concern edible fats. That conclusion is inescapable following the restriction of the list of goods in the intervener's letter of 29 September 1999 and the decision adopted by the Opposition Division of 22 February 2000 in the first opposition proceedings in which the latter refused registration of the La Española mark for the goods in Class 30 of the Nice Agreement, which was confirmed by the decision of 17 February 2003 of the Fourth Board of Appeal.

(72) In those circumstances, the Court considers that the Board of Appeal wrongly failed to take account of the case-law according to which in the global appreciation of the likelihood of confusion a lower degree of similarity between the marks may be offset by a high degree of similarity between the goods (Canon, paragraph 17, and Marca Mode, paragraph 40). –

(73) Nevertheless, in the contested decision, the Board of Appeal found that there was no similarity between the marks at issue, since the figurative elements had a weak distinctive character as regards olive oil, and that the comparison of their word elements, which were completely different, thus acquired paramount importance. That is why, without applying the abovementioned case-law, the Board of Appeal held that there was no likelihood of confusion between the marks at issue."

(...)

(e) The distinctive character of the figurative elements

"(75) In paragraph 18 of the contested decision, the Board of Appeal merely notes, in order to substantiate its findings relating to the weak distinctive character of the figurative elements of the marks at issue, that they consist essentially of a person seated in a pastoral setting, more specifically, in an olive grove. That brief analysis should be understood as meaning that the Board of Appeal adopted the Opposition Division's analysis, according to which the figurative elements of the marks at issue had a lesser distinctive character because they are common place in the olive oil sector (paragraph 9, second indent, of the contested decision).

(76) In the contested decision, the Board of Appeal did not provide any details as to the reasons for which it found that the disputed image was common place in the olive oil sector and it failed mention any mark other than those in dispute, containing figurative elements similar to the marks at issue.

(77) However, it is clear from the notarised statement authenticating a photographic dossier containing brands of olive oil marketed in Spain which together account for 95% of the market supplied by the applicant, that, except for the marks at issue, none of those marks uses the image of a woman. Neither OHIM nor the intervener have challenged the veracity of that document. However, at the hearing OHIM challenged its admissibility on the ground that it had not been submitted at the stage of the administrative procedure. The document was produced with the application as required by Article 44(1) of the Rules of Procedure and claims specifically to establish that the analysis made in the contested decision relating to the typical character of the figurative elements concerned is incorrect. It is, therefore, admissible.

(78) The intervener's argument alleging that other Spanish brands of olive oil use the image of a woman, and that the image concerned is not uncommon in Spanish olive oil trade marks, cannot be accepted. It is clear from the examination of those trade marks that the image of a woman that they use is very different from that in the marks at issue. Furthermore, those marks are very unrepresentative of the Spanish olive oil market. None of those marks appears in the only document submitted to the Court which shows the distribution of the various brands of olive oil in Spain, namely the report by the market research company AC Nielsen Company SL of 18 August 2004, the veracity of which has not been challenged by any of the parties.

(79) In those circumstances, it must be held that the Board of Appeal wrongly held in the contested decision that the figurative elements of the marks at issue were common place on the Spanish market for olive oil.

(80) However, OHIM considers that the reason why the Board of Appeal held that the figurative elements of the marks at issue have a weak distinctive character was not the existence of similar marks on that market, but the same reason for which it found that there was a weak conceptual link between the marks at issue, namely that their figurative elements were connected to the agricultural nature and origin of the products referred to (paragraph 9, fourth indent, of the contested decision). Therefore, the average consumer would not see in those elements indication of the commercial origin of those goods, but a reference to its natural and traditional elaboration.

(81) Even assuming that the contested decision may be interpreted in the way indicated by OHIM, the Court cannot accept the latter's argument.

(82) In the first place, although it may be held that the representation of an olive grove refers to an element clearly linked to olive oil the same is not true as regards the representation of a seated person. OHIM itself acknowledges in its reply (paragraph 50) that the image of a seated woman in traditional costume may be distinctive for the goods concerned. The Court considers that there is no reason to



conclude that the image of a seated woman refers, in the eyes of the average consumer, to the natural and traditional origin of the goods rather than to its commercial origin.

(83) However, OHIM submits that a single competitor cannot exclusively appropriate to itself the representation of a woman. The question whether the elements which make up a trade mark may be freely used by other competitors does not form part of the examination of the distinctive character of the figurative elements of a trade mark (see, by way of analogy, Case C-329/02 P SAT .1 v OHIM [2004] ECR I-8317, paragraph 36). The only relevant issue in that examination is whether the sign examined is distinctive or not, a question which, as regards the seated woman, OHIM has already answered affirmatively.

(84) In that connection, it should be stated that the applicant does not intend to appropriate to itself any representation of an olive grove or any representation of a woman in the abstract. It claims exclusivity over a specific representation, which forms part of its mark, of a combination of those two elements. Therefore, the applicant does not oppose the use by the intervener of the representation of a woman in its trade mark, but the use of an image that it regards as too closely resembling its own.

(85) In second place, it must be observed that as regards the figurative elements of a trade mark its distinctiveness may be assessed, in part, in relation to each of its terms or components, taken separately, but must, in any event, depend on an appraisal of the whole which they comprise. Indeed, the mere fact that each of those components, considered separately, is devoid of distinctive character does not mean that their combination cannot be distinctive (see, by way of analogy, SAT .1 v OHIM, paragraph 28 and the case-law cited).

(86) OHIM and the intervener make an assessment of the distinctive character of the figurative elements of the marks at issue on the basis of a separate analysis of each of its components – in particular the representation of an olive grove and that of a seated woman, together with the subsidiary elements of the marks at issue, such as the red background and the spaces reserved for the brand names and their shapes – without taking account of the fact that certain components which in themselves are devoid of distinctive character may, once combined, have such a character.

(87) It follows from the foregoing that the Board of Appeal was wrong to conclude in the contested decision that the figurative elements of the marks at issue have a weak distinctive character.

Exantin/Eloxatin : T-4/07 – Case closed; Order of 13 July 2007 .

Keywords: Opposition: likelihood of confusion (LOC).

The action was directed against a decision of the 1 st Board of Appeal of 10. 10. 2006 in R 1302/2005-1 in opposition

proceedings between Sanofi-Aventis and Astra-Zeneca, relating to CTM application Exantin in Class 5. At pending proceedings, Astra-Zeneca withdrew the said CTM application, and, in consequence, the case was closed. In contrast to the opponent's request (plaintiff in the present action) that the CTM applicant should bear the costs, the court ordered each party to bear its own costs.

C-2: CFI Judgments and Orders: Developments in pending cases

Last Minute Tour-II : T-115/07 - Office response filed.

Keywords: Cancellation: invalidation on relative grounds – Relative grounds for refusal: earlier right within Article 8(4) CTMR - Relative grounds for refusal: likelihood of confusion (LOC) – LOC: comparison of signs – Comparison of signs: “dotcom” as an individualising addition to a generic sign.

The action was directed against a decision of the 2 nd Board of Appeal of 8. 2. 2007 in R0291/2006-2. The background is the same as in T-114/07 (below), however, in this case the applicant for cancellation had been the appellant (requesting that Class 16 should also be invalidated) who lost. In consequence, the plaintiff in this action is also the applicant for cancellation, i.e. the holder of lastminute.com.

Last Minute Tour-I : T-114/07 - Office response filed.

Keywords: Cancellation: invalidation on relative grounds – Relative grounds for refusal: earlier right within Article 8(4) CTMR - Relative grounds for refusal: likelihood of confusion (LOC) – LOC: comparison of signs – Comparison of signs: “dotcom” as an individualising addition to a generic sign.

The action is directed against a decision of the 2 nd Board of Appeal of 8. 2. 2007 in R 0256/2006-2 relating to cancellation proceedings 635.C and to CTM 1.552.231. The CTM is registered for a range of goods and services in Classes 16, 39 and 42, inter alia, for travel agencies and transport by air.



The CTM application had initially been subject to a challenge on the basis of an opposition by the same party which, however, had failed to submit sufficient evidence of use of its non-registered business identifier. Upon a subsequent request for cancellation, the CTM had been partially declared invalid as regards the registered services in Classes 39 and 42. Upon appeal by the CTM proprietor, the Board had

revoked that decision and dismissed the request for invalidation, mainly on the grounds that “last minute” is totally devoid of distinctive character for the covered services. The public will therefore be able to differentiate the challenger’s brand by the additional part “.com”. Note: the plaintiff in the action is the losing party = the applicant for cancellation and holder of the sign lastminute.com.

Color Edition : T-160/07 - Office response filed (FR).

Keywords: Cancellation: entitlement to request invalidation - Absolute grounds for refusal: distinctiveness.

The action is directed against a decision of the 2 nd Board of Appeal of 26. 2. 2007 in R 0231/2006-2, relating to CTM registration 2.965.804, word Color Edition, registered for cosmetics in Class 3. The CTM had been challenged by an association of lawyers in its own name. Whereas the cancellation group concerned had rejected the request for cancellation, the Board had declared the CTM invalid on the grounds that the sign merely describes the nature of the goods at issue.

Anew Alternative : T-184/07 - Office response filed.

Keywords: Absolute grounds for refusal: distinctiveness.

The action is directed against a decision of the 2 nd Board of Appeal of 22. 3. 2007 in R 1471/2006-2, relating to CTM application 4.357.919, word sign “ANEW ALTERNATIVE”. It had been applied for in Class 3 for soaps, perfumery, essential oils, cosmetics and hair lotions. It had been rejected on the grounds that the words “a new alternative” are unable to individualise a specific product and, thus, cannot serve as a badge of individual origin.

Cyberbourse/Cyberhome : T- 155/07 and T-178 /07 - Office response filed (FR).

Keywords: Absolute grounds for refusal: descriptiveness.

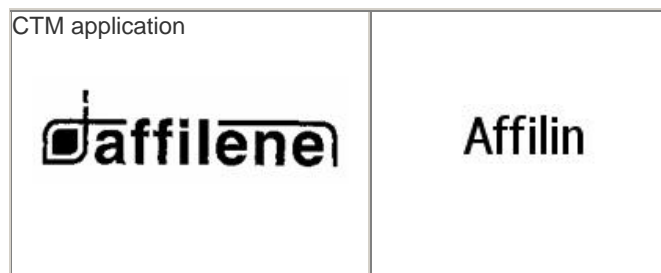
The action is directed against a decision of the 1 st Board of Appeal of 28. 2. 2007 in R 1046/2006-1, and a decision of 15. 3. 2007 in R 1249/2006-1, relating to CTM applications 4.114.682, word Cyberbourse, and 4.114.666, word Cyberhome. The signs had been applied for a range of goods and services in Classes 9, 36 and 38. Both applications had been rejected for the majority of the claimed goods and services on the grounds that the words at issue merely describe their nature (relationship with the Internet).

Affilene : T-87/07 - Office response filed.

Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of goods.

The action is directed against a decision of the 2 nd Board of Appeal of 23. 1. 2007 (modified by a corrigendum of 31. 1. 2007) in R 0010/2006-2, relating to CTM application 2.571.931 “affilene” (fig.) which had been applied for “extracts of medicinal plants for use in the pharmaceutical, cosmetic and food industries, not for diagnostic purposes” in Class 1. It had been opposed

on the basis of word mark Affilin, registered for a range of goods in Classes 1 and 5.



Whereas the opposition group concerned had allowed the opposition in full, the Board came to a different decision. The Board allowed the appeal in part, upholding the opposition in respect of “extracts of medicinal plants for use in the pharmaceutical [...] industry, not for diagnostic purposes” and rejecting it for the remaining goods, that is, for “extracts of medicinal plants for use in the [...] cosmetic and food industries, not for diagnostic purposes”. The Board held that there was a substantial degree of similarity between the signs which could give rise to confusion, in particular if those were used in respect of identical or similar goods. However, it found that LOC only existed between some of the goods concerned, namely those goods in the CTM application which are intended for use in the pharmaceutical industry.

Celia/Celta : T-35/07 - Office response filed (FR).

Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of marks.

The action is directed against a decision of the 4 th Board of Appeal of 5. 12. 2006 in R 0294/2006-4, relating to CTM application 2.977.221, “Celia” (fig.), applied for a range of goods in Class 29. It had been opposed on the basis of the word mark Celta, registered also in Class 29.



The opposition had been rejected on the grounds that the marks at issue are dissimilar; in such circumstances it does not matter that part of the goods are identical.

Biovisc : T-106/07 - Office response filed.

Keywords: Opposition: likelihood of confusion (LOC) – LOC: attentiveness of the relevant consumers – LOC/consumer view: pharmaceuticals.

The action is directed against a decision of the 2 nd Board of Appeal of 8. 2. 2007 in R 0660/2006-2 relating to CTM application 3.651.809, word BioVisc, which had been applied



for in Class 5 for sterile solutions for intra-operative eye operations. It had been opposed on the basis of the word marks Provisc and Duovisc, registered for ophthalmic pharmaceutical preparations in Class 5. Whereas the opposition group concerned had allowed the opposition in full, the Board revoked that decision.

The Board's findings may be summarised as follows: (1) Appreciating the marks globally, the overall impression of them in view of the perception of the relevant consumer leads to a finding of visual, phonetic and conceptual differences. (2) The differences between the marks are sufficient to eliminate that the relevant public will believe that the goods come from the same or economically linked undertakings, thus excluding any likelihood of confusion. (3) Bearing in mind the very specialised nature of the goods in question, these are principally intended for professionals in the field of eye surgery and therefore the relevant consumer is deemed to pay a high degree of attention. (4) Due to this higher attention, the relevant consumers will be able to distinguish smaller differences between the marks, even for identical goods.

Steadycontrol : T-181/07 - Office response filed (FR).

Keywords: Absolute grounds for refusal: descriptiveness, Article 7(1)(c) CTMR.

The action is directed against a decision of the 4 th Board of Appeal of 12. 3. 2007 in R 0008/2006-4 relating to CTM application 3.560.935, word Steadycontrol. It had been applied for in Classes 9, 12 and 38 for a range of goods and services, and had been refused as regards Classes 9 and 12, on the grounds that the sign at issue would merely describe a function of the goods at issue.

Delivering the Essentials of Life: T-128/07 - Office response filed (FR)

Keywords: Absolute grounds for refusal: distinctiveness, Article 7(1)(b) CTMR.

The action is directed against a decision of the 1 st Board of Appeal of 2. 2. 2007 in R 0811/2006-1 relating to CTM application 4.102.497, slogan "Delivering the Essentials of Life". It had been applied for in Classes 1, 9, 11, 16, 35, 36, 37, 38, 39, 40, 41 and 42 for a range of goods and services. It had been rejected on the grounds that the sign is no more than a plain advertising phrase without any individualising capacity.

Deitech : T-86/07 - Office response filed (DE).

Keywords: Opposition: earlier right – Earlier right: proof of genuine use (POU) – POU: means of evidence: German Eidesstattliche Versicherung (declaration in lieu of an oath) not sufficient.

The action is directed against a decision of the 2 nd Board of Appeal of 22. 1. 2007 in R 0791/2006-2 relating to CTM application 3.378.643 (stylised word Deitech, as shown below). It had been applied for in Class 25 (textiles, footwear and

headgear). It had been opposed on the basis of Deitex (fig.), registered for the same range of goods in Class 25.



The opposition had been rejected on the grounds that genuine use of the invoked earlier right had not been shown. The opponent had submitted three catalogues and a declaration in lieu of oath (German so-called Eidesstattliche Versicherung) of the director of the opposing company. The Board had held that filing three catalogues is insufficient and that such a deficiency cannot be rectified by an Eidesstattliche Versicherung under German law. The CTMR requires "proof" of genuine use and not making it "probable or credible" that genuine use occurred.

Prazol/Prezal : T-95/07 - Office response filed.

Keywords: Opposition: likelihood of confusion (LOC) – LOC: pharmaceutical trade – LOC/pharmaceuticals: comparison of goods – LOC/pharmaceuticals: comparison of marks – LOC/pharmaceuticals: level of attentiveness of consumers.

The action is directed against a decision of the 4 th Board of Appeal of 8. 2. 2007 in R 0302/2005-4, relating to CTM application 1.154.269, word Prazol, applied for in Class 5 for medicines, excluding veterinary products. It had been opposed on the basis of Prezal (word), registered in Class 5 for pharmaceutical, veterinary and hygienic products. After an exchange of observations between the parties, including submission by the opponent (plaintiff in present proceedings), of proof of use of the earlier mark, a first decision had been taken by an opposition division on 1. 8. 2002 by which the opposition had been rejected. On appeal (decision of 26. 2. 2004 in R 0835/2002-4) that decision was set aside, on the grounds that not all the evidence of use provided by the respondent had been taken into consideration. The case was remitted to the Opposition Division for further prosecution.

Eventually, a decision was taken, on 26. 1. 2005, allowing the opposition. Inter alia, the opposition division found that a likelihood of confusion existed in view of the identity between the goods and the similarity between the signs. The opposition division considered that the signs were visually and phonetically similar to a high extent, given that both consisted of a bi-syllabic word sharing identical consonants arranged in an identical order and, furthermore, comprised the vowel 'A'. As regards the goods, while noting that the other party had restricted the list of goods of the Community trade mark application to 'medicines excluding veterinary products', it was concluded that these goods were identical to the 'pharmaceutical products' in respect of which the earlier mark was deemed to be registered for the purpose of the examination of the opposition.

On appeal, the 4th Board, by the decision at issue here, gave its ruling in which it annulled the decision of the opposition division. In its overall assessment of the factors relevant to the case, the Board considered that the targeted consumers, with respect to the goods at issue, must be deemed to be rather attentive and observant, and to readily notice any significant difference between the particular names of the pharmaceutical preparations at issue. Given the clear phonetic dissimilarity between the signs, which outweighs their low level of visual similarity, the Board concluded that the public is not likely to consider that the goods marketed under the respective signs in question come from the same undertaking, or from economically linked undertakings. Consequently, no LOC within the meaning of Article 8(1)(b) CTMR can apply.

NEW DECISIONS FROM THE BOARDS OF APPEAL

The cases can be [found in our website](#).

Please note that the full number including slash has to be entered in our database under 'Appeal N°', without the letter 'R'.

e.g. Case R 219/2004-1 has to be entered under 'Appeal N°' as: 219/2004-1

Ex-parte – Article 7(1)(b) CTMR

Examination proceedings – absolute grounds for refusal – distinctiveness – shape

Decision of the First Board of Appeal of 14 September 2007 in Case R 1086/2006-1 (German)



R 1086/2006-1 (Rechteckiger Biskuit-Keks - 3D) – (de) – the Board held that the shape of the biscuit was not distinctive for biscuits or for other products (such as rice) since it would simply be considered a promotional item.

Ex-parte – Articles 51(1)(a) CTMR and 7(1)(i) CTMR

Cancellation proceedings – absolute grounds for invalidity – emblem – Paris Convention – authorization of competent authority – public interest – association- interpretation – ratio legis

Decision of the First Board of Appeal of 28 June 2007 in Case R 0315/2006-1 (English)



R 0315/2006-1 (D&W Repair) – (en) – the key issue was whether the orange cross used in the mark can be associated with the Red Cross emblem, used virtually worldwide and associated with humanitarian activities and protected by the Geneva Convention, which is also an emblem of 'particular public interest' within the meaning of Article 7(1)(i) CTMR.

The Board considered that the Red Cross emblem could not be said to be included in the contested CTM because of the difference in colour and because the cross of the contested CTM contains the wording 'REPAIR' which, coupled with the goods concerned (tools, car spare parts and accessories in Classes 8, 11 and 12) is likely to be associated with car and motorcycle repairs. This association makes the orange cross of the contested CTM even more distinct from the Red Cross emblem.

In relation to the emblems protected under Article 6ter (a) and (b) of the Paris Convention, cf. Article 7(1)(h) CTMR, the prohibitions should not apply when the use or registration is not of such a nature as to mislead the public as to the existence of a connection between the user and the organisation. Both Article 7(1)(h) CTMR, which relates to symbols which are protected under the Paris Convention, and Article 7(1)(i), which protects other symbols, among others the Red Cross, pursue the same objective; the use of specific emblems of public interest without the consent of the competent authorities. Therefore, the Board found that the provision of Article 6ter 1(c) of the Paris Convention applies by analogy to the present case. The Board did not find any reason to grant to trade marks covered by Article 7(1)(i) CTMR a broader protection than under Article 7(1)(h) CTMR. The appeal was dismissed and the request for cancellation rejected.

Inter-partes – Article 8(1)(b) CTMR

Opposition proceedings – relative grounds for refusal – likelihood of confusion – common element – descriptive element – dissimilar marks – identity of goods and services

Decision of the Fourth Board of Appeal of 20 August 2007 in Case R 0752/2006-4 (English)



R 0752/2006-4 (TPGPOST) / POST *et al.* – (en) – the Board held that the word 'Post' lacks distinctiveness in relation to postal goods and services such as those at issue.

Even admitting that the word 'Post' is known by the German public at issue in relation to postal goods and services as a result of a long-standing use of the earlier mark 'Post' in that country, the Board could not recognize this as an evidence that the public will attribute a unique origin to the trade-marked goods and services at issue, in view of the fact that even though postal goods and services have been carried out by a single state-owned entity for a long stretch of time in the

past, nowadays the relevant public knows that this situation is, in fact, gradually changing as a result of the end of the state monopoly in this field of activity.

Taking into account that the earlier mark POST cannot be attributed an enhanced distinctiveness, the Board found that, for the global assessment to be carried out, the visual and phonetic dissimilarities between the signs largely outweigh their similarities and prevent the relevant public from being confused with respect to the conflicting marks, even if they were used in relation to identical goods or services. The appeal was dismissed.

Inter-partes – Article 8(4)

Opposition proceedings – relative grounds for refusal – likelihood of confusion – sign used in the course of trade – passing-off – complementary evidence – assessment – use in the course of trade

Decision of the First Board of Appeal of 14 September 2007 in Case R 1117/2005-1 (English)

R 1117/2005-1

redENVELOPE

(redENVELOPE) /

Redletter

(Redletter) – (en) – the Opposition Division rejected the opponent's claim regarding rights based on use stating that the opponent did not invoke any specific ground of the law of the United Kingdom that would entitle it to prohibit the use of the contested sign. However, the Board found this formalistic approach unjustified. The opponent referred to the fact that it has built up a significant position in the market and a very significant reputation. On the retail market the parties would be competing. Referring to competition, the opponent claimed that there is a risk of confusion and claims that under UK law it would be protected by the common law of passing off. The Board found that it was clear which right the opponent claims. Accordingly, in order to decide on the opponent's rights pursuant to Article 8(4) CTMR, the Board held that the Opposition Division should continue with the examination of the evidence, evaluating the similarity between the goods and services in question and the overall assessment between the similarities/dissimilarities between the conflicting signs and their goods based on the opponent's possible common law rights taking into consideration the complementary evidence submitted before the Board.

Inter-partes – Article 8(5)

Opposition proceedings – reputation of the earlier mark – detrimental – unfair advantage – failure to provide evidence

Decision of the Second Board of Appeal of 3 September 2007 in Case R 1578/2006-2 (English)

JANE

R 1578/2006-2 JANE / **JANE** (jané) et al. – (en)

– the opponent claimed that unfair advantage would be taken of its trade mark. However, the opponent's essential argument was based on the concept of dilution: asserting that the distinctive character of its trade mark would be diminished if an identical or very similar trade mark were used in relation to dissimilar services. The Board could not accept that contention, and noted that it amounts to saying that any trade mark which has a reputation, in the sense that a high percentage of consumers recognize it, is entitled to blanket protection against the use of an identical or very similar trade mark in relation to virtually any kind of product or service. Reputation, instead of being one of several conditions which define when a trade mark enjoys protection in respect of dissimilar goods, would become the sole condition. Such an interpretation would be inconsistent with the wording of Article 8(5) CTMR and the related provisions.

The Board considered that the services claimed in the application are so far removed from the opponent's goods that unfair advantage or dilution seems improbable: a typical consumer of goods related to babies and children who is familiar with the opponent's products is unlikely to think of those products when he sees the word 'JANE' used in connection with services such as 'personnel recruitment and selection; careers consultancy and counselling, planning and outplacement (placement with another employer)'. The appeal was dismissed.

Procedural issues

Transfer – fee – reimbursement

Decision of the First Board of Appeal of 6 September 2007 in Case R 1448/2006-1 (German)

R 1448/2006-1 EVA 3000 – (de) – the Board held that there is no legal basis for the collection of the transfer fee once the modification of Article 157 CTMR entered into force, deleting the fee from the basic regulation.

Appeal proceedings – judgment of the Court of Justice – measures to comply with judgment – likelihood of confusion – dissimilarity of marks – interdependence principle – new evidence – admissibility – first time on appeal – enhanced distinctiveness

Decision of the Second Board of Appeal of 1 August 2007 in Case R 0782/2000-2 (English)

R 0782/2000-2 ARCOL / CAPOL – (en) – the crucial issue to examine and decide on was whether or not to take into account the facts and evidence submitted by the opponent for the first time with the grounds of appeal in the exercise of the discretion granted by Article 74(2) CTMR, as interpreted by the 'Arcol' judgment.

According to 'Arcol', the key factor to be considered by the Board in the exercise of its discretion is whether the new facts



or evidence are, on the face of them, likely to be relevant to the outcome of the opposition brought before it. In the present case, the Opposition Division and the Third Board of Appeal rejected the opposition on the grounds that there was no likelihood of confusion because both instances found the conflicting trade marks different enough.

This Board found no error in the reasons given by the Third Board to which it referred as the basis for the present decision. Consequently the facts and evidence submitted out of time by the opponent in order to support the allegation that the earlier mark had a highly distinctive character as a result of having become well-known through use are irrelevant to the outcome of the opposition and thus inadmissible since, even if the facts alleged were fully proven, it could not have any bearing on the application of Article 8(1)(b) CTMR in this case.

In this regard, according to the case-law of the Court of Justice, the likelihood of confusion presupposes that the signs as well as the goods and services covered are identical or similar. However, since, in this case, the conflicting trade marks cannot in any way be regarded as similar by the relevant public composed of manufacturers of food and confectionery products, the fact that the earlier mark is widely known cannot alter the global assessment of the likelihood of confusion according to well established case-law. The failure of the opposition was due to the lack of similarity of the conflicting trade marks, not to the lack of distinctiveness of the earlier mark, since the Third Board found the earlier mark inherently distinctive to a high degree as an invented word.

It was held that the error in law committed by the Third Board of Appeal with the infringement of Article 74(2) CTMR was not sufficient to warrant the annulment of its decision since, according to the case-law, annulment is not justified where it can only lead to the adoption of another decision identical in substance or when the error in the particular circumstances of the case had no effect on the operative part of the decision with adequate legal basis in other grounds.

Restitutio in integrum – due care required by the circumstances – duty of the representative – organisation of a law firm – time-limit – case-law

Decision of the Second Board of Appeal of 7 September 2007 in Case R 0413/2007-2 (English)

R 0413/2007-2 Corti / CORTTY CENTRO et al. – (en) – the Board held that the alleged cause of non-compliance with the missed time-limit was not an impediment unconnected with the party in question in the sense of Article 78(1) CTMR, but rather merely the oversight on the part of an employee of the applicant's representatives (as was admitted by the representatives and the employee concerned, who both recognised that the employee responsible for checking the time-limits at the time failed to take care of filing the observations in response to the opposition, overlooking the clear note put on their calendar of time-limits).

The CFI and this Board have stated that the error of an appellant's or representative's employee regarding a time-limit cannot be considered as an impediment or cause of non-compliance in the sense of Article 78(1) CTMR. The appeal was rejected and the contested decision confirmed.

Renewal – time limit – licence agreement – authorization – party to the proceedings – restitutio in integrum

Decision of the Second Board of Appeal of 3 September 2007 in Case R 0866/2007-2 (Spanish)

R 0866/2007-2 JURADO – (es) – the appellant appealed against the refusal of the application for *restitutio in integrum* which it filed in order to be able to renew Community trade mark No 240 218, the registered proprietor not having renewed it at the proper time with the result that the trade mark was duly cancelled and removed from the Register of Community Trade Marks.

The Board considered that once the registration of a CTM has expired because the proprietor has failed to request the renewal at the due time, a licensee cannot ask for restitution in *integrum* as a means of requesting the renewal out of time, since only the proprietor can request the renewal pursuant to Article 47(1) and only it, being a party to the renewal proceedings, is entitled to request *restitutio* according to Article 78(1) CTMR.

The fact that the Office did not observe the obligation to inform the appellant, as registered exclusive licensee, of the expiry of the registration in good time, as provided by Article 47(2) CTMR, was held to be legally irrelevant since, according to this rule, failure to give such information shall not involve the responsibility of the Office, nor does this prevent the expiry of the registration, as provided by Rule 29 CTMIR. The appeal was dismissed.

Amendment of the application – change of name – company name

Decision of the Fourth Board of Appeal of 6 July 2007 in Case R 0756/2007-4 (English)

R 756/2007-4 DESIGNATION OF APPLICANT – (en) – a 'change of name' embraces two situations, either a mistake in the original indication, such as a typing error, or a change in the sense that the applicant initially had one name and now has another name. A legal entity must indicate its legal form by law; the Office cannot delete such an indication, even if national law does not force a company to use the indication of its legal form. The Board held that the recordal request could not be granted and the appeal was dismissed.

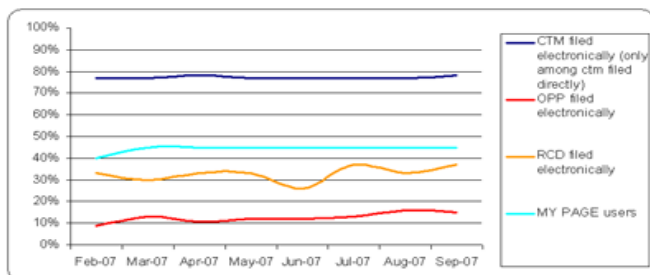


E-Business at OHIM

OHIM E-Business Roundup (2007)

Statistical summary

- The use of the CTM e-filing web form is maintained between 75% and 80%.
- The use of RCD e-filing has increased above 35%.
- 15% of oppositions against CTM applications are received electronically.



State of play of future projects

B2B e-filing CTM:

The objective of this service is to set up a system allowing the direct exchange of CTM applications from the IP management software used by the applicants and the OHIM systems. This tool will use a ST66 (www.tm-xml.org) format and offer a web service for the transmission of data.

Status - OHIM has set up its system. CPA Software Solutions (Inprotech) has completed the tests.

Service - New version of e-Communication:

Electronic communication will be expanded to include more official communications of OHIM.

Status - OHIM has started the testing phase

Service - New version of CTM E-filing:

The current [CTM e-filing](#) service will be significantly improved.

Status - OHIM has completed the requirements.

Service - New version of electronic filing of RCD applications

The current [RCD e-filing](#) service will be significantly improved with a view to solving, among other things, the problem of large attachments. RCD e-filing will also be accessible through MYPAGE and changes will be made to harmonise it with CTM e-filing.

Status - OHIM has completed the requirements.

Service - E - renewal RCD:

The objective is to provide an electronic tool for renewing registered Community designs.

Status - This new facility will be available as from 01/11/2007

Service - E-Caveat:

The objective is to provide an e-mail notification tool when specific CTM status changes.

Status - OHIM has started the development phase.

Service - Online handling of opposition procedures:

Opposition proceedings will be handled electronically via MYPAGE. It will be possible for the parties to exchange documents via this new tool.

Status - OHIM has completed the requirements.

More News

OHIM at China Trademark Association meeting

A delegation from OHIM will be taking part in the China Trademark Association's annual meeting, which takes place in the Chinese city of Changsha, in Hunan province, from 3-5 November this year.

The event, which will be attended by over 600 delegates, is the most important gathering of Chinese companies and professional intermediaries interested in international trade mark issues.

OHIM will have a stand at the meeting and Beate Schmidt, director of the trade marks and cancellations department, will be making two speeches, including a keynote talk on Community trade mark law.

"As Chinese industrialisation continues to gather pace, companies, and the Chinese Government, are becoming increasingly interested in how to ensure international protection for their own intellectual properties.

"This event is an excellent opportunity to showcase the benefits of the CTM for companies doing business in Europe," says Schmidt.

EU joins Hague international designs system

The European Union is to join the Geneva Act of the Hague Agreement dealing with the international registration of industrial designs, from the beginning of next year.

The European Community, which is the official signatory for this type of international agreement, submitted its instrument of accession to the World Intellectual Property Organisation (WIPO) in Geneva on 24 September.

Joining the Geneva Act of the Hague Agreement will allow companies, with a single application, to obtain protection of a



design not only throughout the EU with the RCD, but also in the countries which are members of the Geneva Act. It will simplify procedures, reduce the costs for international protection and make administration easier. The system will become operational for businesses on 1 January 2008.

Internal market commissioner Charlie McCreevy said: "European businesses will now be able to obtain and protect their designs internationally in a simple, affordable and effective way. This should further stimulate trade and innovation, create new commercial opportunities and boost integration within the EU Internal Market."

The Geneva Act, which is the most recent of the three treaties of the Hague Agreement, entered into force on 23 December 2003. So far 23 countries, including Singapore, Turkey and Switzerland, have become party to the Geneva Act.

Monthly Statistical Highlights* September 2007

Community Trade Mark applications received	6768
Community Trade Mark applications published	6905
Community Trade Marks registered (certificates issued)	5029
Community Trade Mark renewal applications	999
Registered Community Designs received	5114
Registered Community Designs published	5332

* Statistical data for the month in course is not definitive. Figures may vary slightly after consolidation.