



### Cooperation Fund and Convergence Programme meetings at OHIM

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... [Page 2](#)

### Interview



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#### How long have you been working in trade marks?

I have been working in the field of intellectual property for about 15 years ... [Page 2](#)

### Community Trade Mark

## CTM

- Classification Breakthrough [Page 5](#)

### Registered Community Design

## RCD

- Judgement of the General Court in case T-55/12 of 25 April 2013 [Page 5](#)

### EUTMDN Updates

- Convergence Programme working groups meet at OHIM [Page 7](#)
- Cooperation Fund: e-filing Trade Marks live in Finland [Page 7](#)
- Cooperation Fund working groups meet at OHIM [Page 7](#)
- Harmonisation of the Industrial Property Office of the Czech Republic [Page 7](#)
- Harmonisation Project – Croatia [Page 8](#)
- Croatia, Cyprus, Mexico, and Norway join TMview [Page 8](#)
- Taxonomy implemented in TMclass [Page 8](#)
- Webinar on Taxonomy – the user perspective [Page 9](#)

### More News



- António Campinos new President of CEIPI Admin Council [Page 10](#)
- Korean TMview integration [Page 10](#)
- OHIM and EU Observatory Annual Reports [Page 10](#)
- OHIM University Network – first thesis published on OHIM website [Page 10](#)
- SIPO delegation visits OHIM [Page 11](#)
- Standing Committee meeting at WIPO [Page 11](#)
- Turkey TMview implementation [Page 11](#)
- Real Time Satisfaction Survey (RTSS) on Designs [Page 11](#)
- Monthly statistical highlights May 2013 [Page 12](#)

### Case law



- Luxembourg trade mark and design news [Page 12](#)
- New decisions from the Boards of Appeal [Page 26](#)

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## Cooperation Fund and Convergence Programme meetings at OHIM

The month of June has seen significant activity at OHIM in the field of the Office's Cooperation Fund and Convergence Programme initiatives, with a number of meetings in different areas over the course of the month.

Early on, between 5 and 7 June, EU National Office experts gathered in Alicante for a series of meetings in the framework of the Convergence Programme projects.

At this first meeting, three specific projects were discussed.

The first, Absolute Grounds – Figurative Marks, aims to converge the different interpretations of the examination of absolute grounds for refusal as regards figurative trade marks with purely descriptive words expressions.

The second, Scope of Protection – Black and White Marks, aims to converge the different interpretations of the scope of protection of trade marks exclusively in black, white and/or shades of grey.

The third, Relative Grounds – Likelihood of Confusion, aims to converge the different interpretations on how to deal with non-distinctive or weak components of trademarks in the context of the examination of relative grounds for refusal.

The following week then saw another gathering of experts, again drawn from collaborating EU national and regional IP offices and user associations, for a full round of Cooperation Fund working group meetings.

The workshops covered the next stage of the Cooperation Fund's planned tool launches, including Software Package components, the second stage of Designview and Search Image.

The week's events also included technical demonstrations, presentations from project managers and national office experts and updates on tool development progress within the meeting of the Cooperation Fund Points of Contact in the National Offices.

The end of the month then saw OHIM's Alicante headquarters play host to a top-level Convergence Programme meeting on the harmonisation of classification.

Representatives from all of the national and regional IP offices of the European Union were in attendance, accompanied by experts from WIPO and from user associations Marques and INTA.

Discussions centred, among other things, on the reasoning for (non) acceptability of some of Nice class heading terms as well as the creation of a list of non-acceptable terms, agreed by all parties present.

The harmonised database and the Terminology Maintenance Tool were also on the table as participants agreed on the next steps for implementation of the Nice class heading individual terms.

### Interview



#### The James Nurton Interview

In this month's interview, Kalev Käosaar of Käosaar & Co in Estonia discusses joining the EU, the challenges of filing internationally and the value of specialised trade mark judges.

#### How long have you been working in trade marks?

I have been working in the field of intellectual property for about 15 years, most of this time dealing with legal protection of trade marks. I first studied economics, but I was more interested in law. While taking up law, I also began to work in the patent agency founded by my father Jüri and have remained there since.

I do not think that this is necessarily my true calling, but the work is challenging and connected to law, which I find fascinating. What I personally find important is the international dimension. My work gives me the opportunity to travel, make friends all over the world and work with international businesses. I'm a member of FICPI and have also travelled to APAA and made a lot of good clients and friends there.

As with any job, there are the routine duties that simply have to be taken care of, and then there are the more challenging activities that inspire me. I particularly like working with clients such as advertising agencies on developing new trade marks – for example, starting with up to 30 marks and finding the best one to protect.

#### **How big is your trade mark team? What types of work do you handle?**

There are altogether 13 employees in Käosaar & Co, of which three people are on the trade mark team. We do the same things that any other patent agency does – there are the trade mark searches during the phase of developing a new trade mark; then there are acts associated with registration, as well as settling trade mark rights infringements (using Customs and courts). And the routine duties, which include the activities connected with renewal.

#### **How many applications do you file per year?**

The EU is an important market for Estonia, and considering the favourable price of registration, the number of Community trade mark applications has been constantly growing over the years. For example, last year we filed 44 CTM applications and 100 applications in Estonia.

In addition, we have been filing worldwide applications under the Madrid Protocol system, or directly through the services of our colleagues in the target countries; I cannot give you a precise number of these applications at the moment, but there are probably around 50 to 60.

The Estonian system is quite different from the CTM: in Estonia it can take up to two years to get a registration certificate, compared with about six months at OHIM. That is partly because we still have relative grounds examination in Estonia.

#### **What has been the most unusual case you have worked on?**

I had an interesting case years ago when working on trade mark applications for an Estonian company that had developed novel probiotic animal feeds; our job was to register three trade marks in more than 50 countries worldwide. For many countries we were able to take advantage of the Madrid system, but in a number of others we had to file individual applications.

In some countries in South America or, for example, the Middle East, the registration system differs vastly from what we are used to. There were powers of attorney to be legalised but back then there were no diplomatic missions for most of the countries residing in Estonia, so we had to communicate with representations located in other countries. When sending a power of attorney to the representation of a certain South American state that I'll leave nameless, we enclosed cash to pay for the service!

#### **What do you think of OHIM and the CTM and RCD systems?**

I find both of these systems very convenient, while the relatively affordable prices allow smaller businesses to seek protection for their trade marks and designs outside Estonia.

#### **What do you think of the plans to reform the Regulation and Directive?**

Speaking of the changes already in force, my opinion on designating class headings is that protecting the entire class is unreasonable and that it limits the activities of other undertakings. As a rule, companies apply their trade marks to specific goods or services and not to an entire class. In my opinion, the US system is more justified in this respect, allowing a specific list of goods or services.

I am for reducing the fees for filing applications and for allowing the option of applying in one class only; however, the existing fee for protecting a trade mark in up to three classes should remain as it is - the current option should not be abandoned or made more expensive as a result of the reform. Our clients include several smaller businesses that are interested in limiting the scope of their trade marks to a few product groups only, so a single class would be enough. In this case, it would make sense for them if they could do so at a lower price.

In addition, there is a need for harmonisation of the examination systems of the member states and the Community trade mark. The current situation is that it is possible to register trade marks through a CTM application that could not be registered directly in Estonia, and the reasons for this are precisely the differences in the examination systems.

#### **How could OHIM improve its service?**

It is a huge organisation and thus there are inevitably certain communication problems; but as a whole, the service and the organisation itself run quite smoothly.

We have in the past had trouble sending faxes but we have learned that the best time to communicate with OHIM is early in the morning, as we are an hour ahead of most of Europe! We now use e-communication a lot, which is very

convenient. But there are still some things it is not possible to do using the electronic system, such as making a trade mark transfer or filing an international application.

**What do you think of the recent decisions of the Court of Justice of the EU?**

In my opinion, it would be correct to distinguish between a domestic registration and a CTM registration. If an undertaking wishes to protect a trade mark in just one member state and does so through the Community trade mark system, this prevents other undertakings from using a similar or identical mark in another country. We have had a few cases concerning the use of a Community trade mark in just one of the member states.

**What are the main issues/cases for trade mark lawyers in Estonia?**

The main disputes originate with trade mark registration or trade mark infringements. There is quite a large number of such court disputes. I find that the development occurring in the recent years, where Estonian courts also see some specialisation of judges in trade mark law, is quite significant. This means that, as a rule, there are judges who specifically deal with trade mark disputes.

As trade mark law is a specific field, it is important that judges have in-depth knowledge and experience in this area. This makes the course of a dispute so much easier, as both the trade mark attorneys and the judges understand the essence of the dispute. Another important development is that the majority of the disputes are settled in the form of written proceedings and there are fewer and fewer court sessions.

We always try to resolve disputes amicably, but sometimes you have to go to court. Many cases are resolved in the Board of Appeal, and in infringement cases about 60% to 70% of cases terminate when we send a cease-and-desist letter. Most cases involve local companies.

Our firm probably takes about 10 cases a year to court. We recently finished an interesting case: it was a dispute between the international retailer Bauhaus and our client, who wanted to register Bauhof. It was an opposition and it took about four to five years but finally we won. It was decided that Bauhof is registrable and the trade marks are not similar. It was important for the client because they had invested millions of euros in the business, with stores in Estonia, Latvia and Russia.

**What is the biggest change in trade mark practice you have seen in your career?**

For us, the first major change occurred when Estonia joined the Madrid system 1998. As a result, the number of domestic applications filed through agencies decreased dramatically. Another important change was, of course, becoming a member of the European Union and its trade mark system in 2004. This also decreased the number of trade mark applications.

There was also a time when the majority of our Estonian businesses were in the process of development, so most of their efforts were aimed at domestic or neighbouring markets. Today the situation has changed and a significant part of the trade mark portfolio includes trade mark applications from Estonian businesses.

**What is the biggest challenge facing trade mark owners?**

Speaking of CTMs, I find that the development and implementation of a new trade mark is becoming more and more complicated, considering the number of domestic marks and CTMs registered to date. At the same time, the markets are open for the undertakings — international sales of their goods and services are nothing unusual even for small businesses.

The options for Estonian businesses are much more limited in the domestic market (Estonia) than is the case for Polish or German businesses. Estonian companies wishing to develop and expand their activities must direct their goods or services outside Estonia (the Baltic states, Scandinavia, Russia, etc) as well.

The past few years or actually the past 10 years have brought constant change for us. The nature of our work has changed - in order to give good advice, we must now know a little more about our client's field of activity. For example, the volume of services related to filing applications has considerably decreased, while the proportion of counselling and legal services has increased.

### Classification Breakthrough

On the heels of the ABBC meeting in May 2013, OHIM is pleased to announce a major breakthrough in the Convergence Programme initiative on the Nice Class Headings Individual Terms.

This effort came about through the interest of national offices, BOIP and OHIM taking a harmonised approach in addressing the Court of Justice ruling in Case C-307/10 "IP Translator" that deemed certain general indications insufficiently clear and imprecise for classification, but did not specify which were classifiable and which were not.

In under a year, an agreement was reached which will result in the creation and publication of a Common Communication on the web sites of all participating offices envisaged by the end of this year. This communication will clearly outline the initiative results and its influence on EU IP practices, as well when and by whom this common practice will be implemented. This implementation by the EU IP Offices will happen on a voluntary basis.

OHIM would like to thank all national offices and BOIP, and the user associations involved for their dedication and commitment to realising this goal.

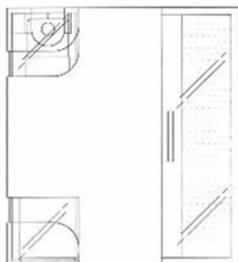
**Knowledge Circle Goods & Services**

### Judgement of the General Court in case T-55/12 of 25 April 2013

In this judgement the General Court ('GC') dismisses the action for annulment and confirms the Board of Appeal's decision declaring the invalidity of the Community Design Registration ('RCD'), namely RCD No 1027718-0001, for 'cleaning devices' on the basis of Article 25(1)(e) of Regulation No 6/2002 ('CDR').

#### *Factual and legal backgrounds*

Following registration of the RCD for 'cleaning devices':



(Contested RCD - 1 out of 7 views)

A request for a declaration of invalidity was based on Article 25(1)(e) CDR, namely '*a distinctive sign is used in a subsequent design, and Community law or the law of the Member State governing that sign confers on the right holder of the sign the right to prohibit such use*'. The invalidity applicant based its application on the following earlier three-dimensional mark:



(Earlier 3-D CTM registered for goods in Class 3)

Both the Invalidity Division and the Board of Appeal declared the RCD invalid. The Board of Appeal held that the RCD included the earlier three-dimensional sign and that use was made of the earlier mark in the contested design pursuant to Article 25(1)(e) CDR.

#### *Summary of the judgement*

As regards the notion of 'use of a distinctive sign in a subsequent design', the GC confirms the principle following which the application of Article 25(1)(e) CDR is not limited to cases in which the earlier distinctive sign is reproduced identically in the contested design. It is enough that the dominant features of the earlier sign be discernible in the contested design, regardless of omitted or added features which are of secondary importance in the perception of the average consumer, who has an imperfect recollection and who will not necessarily notice those changes vis-à-vis the earlier distinctive sign (paras. 23-24).

In this case, both shapes have a compact rectangular body rounded at the edges with a spray device attached on one side and a sponge on the other side. The differences between the shapes affect secondary elements and do not rule out the conclusion that the features of the earlier mark are discernible in the contested design (para. 28).

As regards the second plea in law alleging breach of Article 9(1)(b) of Regulation No 207/2009 ('CTMR'), the Applicant claimed that the contested design will not be perceived as an indication of the origin of the goods concerned and that there was no similarity between the earlier mark and the RCD (para. 36).

In that connection, the GC reiterates that a shape such as the contested RCD can be used for or in relation to goods within the meaning of Article 9(1)(b) CTMR, and thus as an indication of commercial origin, notwithstanding the fact that average consumers are not in the habit of making assumptions about the origin of goods on the basis of their shape or the shape of their packaging in the absence of any graphic or word element (paras. 39-40). In this case, the possibility that the contested RCD is perceived as a distinctive sign is supported by the fact that the shape of the design which incorporates the cleaning device appears to be sufficiently unusual compared to the norms of the sector and sufficiently striking (para. 40).

Moreover, the goods covered by the earlier mark in Class 3 are identical to those in which the contested design is intended to be incorporated (para. 47).

Word elements in the earlier three-dimensional mark, which are secondary or hardly legible, will have no influence on how the average consumer visually perceives the earlier mark, and hence must be ignored (para. 52).

Consequently, given the similarity between the contested design and the earlier mark and the identity of the goods covered by the earlier mark and the goods in which the design is intended to be incorporated, there is a likelihood of confusion pursuant to Article 9(1)(b) CTMR, even under the assumption that the earlier mark has only a weak distinctive character (para. 64).

**Knowledge Circle Designs**

### Convergence Programme working groups meet at OHIM

EU National Office experts gathered at OHIM from 5 – 7 June for a series of meetings in the framework of the Convergence Programme projects.

Three projects were discussed. The first, Absolute Grounds – Figurative Marks, aims to converge the different interpretations of the examination of absolute grounds for refusal as regards figurative trade marks with purely descriptive words / expressions.

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The third, Relative Grounds – Likelihood of Confusion, aims to converge the different interpretations on how to deal with non-distinctive or weak components of trademarks in the context of the examination of relative grounds for refusal.

### Cooperation Fund: e-filing Trade Marks live in Finland

On 5 June, after an extended period of testing, the new Trade Mark e-filing went live in the pilot office, PRH Finland.

This is a major milestone for the European Network, as it represents the first installation of the new core business application developed by the Cooperation Fund, which is expected to contribute significantly to the modernisation of systems across all offices.

The PRV has taken a significant risk in going first, and we are all proud to be working with them.

Watch this space: Several other offices, including OHIM, are expected to use the software by the end of 2013.

### Cooperation Fund working groups meet at OHIM

Between 10 and 14 June, experts from EU national and regional IP offices and user associations gathered at OHIM for a full round of Cooperation Fund working group meetings.

The workshops covered the next stage of the Cooperation Fund's planned tool launches, including Software Package components, the second stage of Designview and Search Image.

The events also included technical demonstrations, presentations from project managers and national office experts and updates on tool development progress within the meeting of the Cooperation Fund Points of Contact in the National Offices.

### Harmonisation of the Industrial Property Office of the Czech Republic

The Industrial Property Office of the Czech Republic is now part of the Common Harmonised Database on Classification of Goods and Services, as a result the complete Czech translations of the Common Harmonised Database is now available to all the users through the TMclass application.

This is the latest expansion in the Harmonisation Project for Goods and Services, which has been progressing positively and continuously since it was set up. The integration of the Industrial Property Office of the Czech Republic into the "Harmonisation community" is another step forward for this common project; as it grows, it creates further benefits for European users by improving predictability.

TMclass is available for free, online to all users at <http://tmclass.tmdn.org/>

## Harmonisation Project - Croatia

The Croatian version of the Common Harmonised Database on Classification of Goods and Services is now available to all users through the TMclass application.

This is the latest expansion in the Harmonisation Project for Goods and Services, which has been expanding continuously since it was set up.

The integration of the national trademark office of the Republic of Croatia (SIPO) into the "Harmonisation community" is another step forward for the database; as it grows, it creates further benefits for European users by improving predictability.

TMclass is available for free, online to all users at <http://tmclass.tmdn.org/>

## Croatia, Cyprus, Mexico, and Norway join TMview

As of 1 July 2013, four new National Offices have made their trade mark data available to the TMview search tool.

Cyprus and Croatia joined as members of the EU and Mexico and Norway as non-EU countries.

These integrations are concrete results of both the International Cooperation and Cooperation Fund programmes managed by OHIM in collaboration with its EU and international partners.

This latest extension brings the total number of offices participating in TMview to 29.

With the addition of the first trade marks from non-EU Offices, TMview now provides access to approximately 11 million trade marks in total.

Having almost completed the integration of nearly all EU Offices, including Croatia, TMview has established a new milestone to acquire a relevant critical mass of trade mark data and geographical coverage and to become a major reference search tool for trade marks.

Since its introduction on 13 April 2010, the tool has received almost 4 million searches from 196 different countries, with users from Spain, Germany and Italy among the most frequent visitors.

You can find out more at <http://www.tmview.europa.eu>

## Taxonomy implemented in TMclass

Taxonomy has been successfully implemented in TMclass, OHIM's global classification tool. Implementation took place on the first of July.

Taxonomy is a hierarchical structure based on the Nice Classification terms, with broader terms on top and more specific terms below. It takes its data from the Harmonised Database, which is a common database of acceptable terms, and one of the major achievements to date of the European Trade Mark and Design Network.

Fourteen EU national IP offices, plus OHIM, have so far had their data incorporated into the database, which currently contains around 65,000 terms of goods and services.

The structure has been integrated in TMclass to offer users an intuitive search, with easy navigation, via Taxonomy's classification tree, which allows the right term in each category to be easily found.

Taxonomy is the result of three years' hard work and consistent cooperation between EU IP national and regional offices, user associations, OHIM and WIPO, and it will be continuously updated and monitored by them.

Users have been at the centre of Taxonomy's development from its inception – their feedback and guidance were vital in the development process. Taxonomy will benefit the entire user community due to its simplicity and accessibility, as no prior classification knowledge is required: users can navigate through the tree to find the correct term. Related terms are presented together, avoiding time-consuming, repetitive searches.

Although it serves administrative purposes only, Taxonomy leads to a faster and more precise classification, making TMclass an even more powerful tool.

Taxonomy will also be integrated into the new e-filing systems being developed by OHIM's Cooperation Fund programme.

TMclass, and its new Taxonomy component, are available free of charge, at <http://tmclass.tmdn.org>

Taxonomy is already being used by WIPO, and is available at the Nice classification section of WIPO's website at: <http://www.wipo.int/classifications/nice/en/>

To further help users, a short tutorial and a live chat is available on TMclass, to assist first-timers as they navigate the tool and perform searches. The live chat, which will give on the spot answers to Taxonomy queries will run for the month of July, and can be found in the right hand corner of the TMclass homepage.

Further information resources on Taxonomy are available at OHIM's website at: <http://oami.europa.eu/ows/rw/pages/QPLUS/taxonomy.en.do>

## Webinar on Taxonomy – the user perspective

A live webinar organised by OHIM's Academy on the Taxonomy tool will take place on Wednesday, 24 July, at 11:00h CET.

The webinar will be open to all interested users at [http://directo.avanzo.com/oami\\_201307XX/](http://directo.avanzo.com/oami_201307XX/), and anyone wishing to take part can send questions to the webinar team in advance, via [ConvergenceProgramme@oami.europa.eu](mailto:ConvergenceProgramme@oami.europa.eu)

Selected questions will be answered online during the webinar, and all other questions will be answered after the event via email.

The webinar will be presented by OHIM classification expert Thom Clark.

Taxonomy is a new, hierarchical structure that allows for easier and faster classification of goods and services through the Nice Classification framework.

It has been developed by the EU national and regional IP offices and OHIM, in collaboration with WIPO.

Taxonomy is available through TMclass at <http://tmclass.tmdn.org>

More information on Taxonomy is available at <http://oami.europa.eu/ows/rw/pages/QPLUS/taxonomy.en.do>

[More News](#)

### António Campinos new President of CEIPI Admin Council

On Friday, 7 June, OHIM President António Campinos was appointed as President of the Administrative Council of the Centre d'Études Internationales de la Propriété Intellectuelle (CEIPI).

He will hold the post for a period of three years and takes over from Mr Francis Gurry, Director General of WIPO.

The ambition of CEIPI, founded in 1963 within the Faculty of Law at Strasbourg University, is to gather the best skills in the field of intellectual property, in order to face the challenges of a developing "society of knowledge".

### Korean TMview integration

OHIM played host to three Korean IT experts over a three day period between 17 and 21 June.

The delegation from the Korean Intellectual Property Office (KIPO) joined OHIM experts as they prepare to integrate the trade mark data from Korea into TMview.

The provisional go live is expected before the end of this year.

TMview is an online consultation tool allowing you to search, free of charge, the trade marks of all official trade mark offices which are participating at national, international and EU level.

### OHIM and EU Observatory Annual Reports

The [respective 2012 Annual Reports of OHIM](#) and for the [EU Observatory on the Infringements of Intellectual Property Rights](#) can be accessed on the website of the Office.

There is an online multimedia version as well as a downloadable pdf document, available in the five official languages of OHIM.

### OHIM University Network – first thesis published on OHIM website

OHIM's University Network, which encompasses 23 European Universities, brings together IP students and researchers from across the EU.

The University Network, part of the OHIM Academy, has published the first PhD thesis from one of its network members on its website.

Dr Yann Basire's PhD thesis is entitled: Les Fonctions de la Marque – Essai sur la cohérence du régime juridique d'une signe distinctif.

OHIM is particularly pleased to publish this work, which has not only received the highest marking a jury panel can award in France, but was also recently presented with an award at a PhD work competition.

Yann Basire prepared his work under the auspices of Professor Yves Reboul, the former general director of the CEIPI in Strasbourg. Dr Basire, who was appointed lecturer in law, continues his academic career in the field of IPR and was present at the OHIM on 6 & 7 May 2013 and participated in the debates of the latest Research Session of our University Network.

Publication of PhD theses from the University Network members will enable OHIM to gather an on-line, easily accessible repository of world-class research from some of the brightest young academics in the IP field, in the areas of the Community Trade Mark and the Community Design systems, and European IP enforcement issues.

## **SIPO delegation visits OHIM**

On 17 and 18 June OHIM received an expert mission on Search Image from a Delegation of the State Intellectual Property Office (SIPO) from China.

The visit took place within the framework of the International Cooperation Programme and it built on the connection between International Cooperation activities and Cooperation Fund through obtaining possible technical solutions within Search Image project.

## **Standing Committee meeting at WIPO**

The Standing Committee on Trade Marks and Designs meets regularly at WIPO.

The Committee, which in the past drafted the Trade Mark Law Treaty and the Singapore Treaty, to name some of its most recent achievements, is now drafting a treaty to harmonise the formalities for Designs, a Design Law Treaty.

The Committee also discusses issues in the Trade Mark field, this time, for example, on the protection of country names, and related issues, such as the trade mark-related aspects of the expansion of the domain system.

A very large number of delegates from all around the world participate at this event which normally lasts one full week.

## **Turkey TMview implementation**

Starting on 12 June, and until 5 July, Mr Sadrettin Kaçar from the national IP office of Turkey is at OHIM's Alicante headquarters as part of the implementation of Turkish trade mark data into TMview.

He has been working closely with his IT counterparts from OHIM, participating in technical meetings and working groups, as Turkey moves closer to full integration of TMview this year.

TMview is an online consultation tool allowing you to search, free of charge, the trade marks of all official trade mark offices which are participating at national, international and EU level.

## **Real Time Satisfaction Survey (RTSS) on Designs**

In the context of Line of Action 5, Improvement and Broadening of Quality, of the OHIM Strategic Plan , the Office will launch a new Real Time Satisfaction Surveys (RTSS) to users.

As previously carried out for Opposition Proceedings and Ex-Parte proceedings, during the months of July and August 2013, the Office will send a RTSS to those owners or representatives who have been involved in the registration procedure for one or several registered Community Designs (RCDs).

The field work for this survey will be limited to a two month period.

## Monthly statistical highlights\* May 2013 compared to May 2012

|  | 2013  | 2012  |
|--|-------|-------|
| Community trade mark applications received             | 9 547 | 9 187 |
| Community trade mark applications published            | 8 864 | 7 988 |
| Community trade marks registered (certificates issued) | 8 730 | 9 256 |
|  |       |       |
| Registered Community designs received                  | 5 906 | 7 036 |
| Registered Community designs published                 | 5 478 | 6 700 |
|  |       |       |

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

## Case law



## Luxembourg Case Law

## A: Court of Justice: Orders

Case C-379/12 P Arav Holding S.r.l. e Arav Fashion S.p.A. v OHIM; Order of 16 May 2013; Language of the case: IT

**Keywords:** Matters of fact appealed to CJ, name, similarity of the signs, likelihood of confusion, admissibility

**RESULT:** Action dismissed

**FACTS:** The applicant sought to register the mark "H.EICH" for goods in Classes 18 and 25. The opponent opposed the registration on the basis of the Italian and International figurative marks "H SILVIAN HEACH". The Opposition Division rejected the opposition. The Board of Appeal annulled the opposition decision to the extent that the signs were similar and that there was a likelihood of confusion. The General Court annulled the Board's decision given the different visual overall impression and the particular relevance of this aspect for the goods concerned and excluded any likelihood of confusion between the signs. The opponent based its appeal to the CJ on five arguments, all concerning the comparison of the signs or the overall assessment of the risk of confusion, which, in the substance, are all included in one plea in law, namely the breach of Articles 8(1)(b) CTMR.

| CTMA    | Earlier Italian and International marks |
|---------|---|
| H. EICH |   |

**SUBSTANCE:** (1) As regards the first argument, relating to the assessment of the dominant elements of the signs, the Court of Justice found that the opponent sought to substitute its own assessment of the facts carried out by the GC. The GC has exclusive jurisdiction to make findings of fact, save where a substantive inaccuracy in its findings is attributable to the documents submitted to it, and to appraise those facts. Since the opponent did not claim that the evidence was distorted by the GC, this argument was rejected as inadmissible (Paras. 42, 43). As far as the opponent argues that the GC did not correctly apply the case-law on signs composed of first names and family names, the claim was based on an erroneous interpretation of the relevant case-law, which does not establish that a surname is always more distinctive than the first name (Paras. 44, 45). This argument was thus rejected as manifestly unfounded. The arguments concerning the visual and aural comparison of the signs were rejected as manifestly inadmissible since the opponent merely criticised

the evaluation of the facts made by the GC in order to ask a new assessment of those facts by the CJ. The fourth argument concerns the distinctive character of the earlier mark, which, according to the opponent, should have been considered by the GC as higher than the average since the earlier mark bears no reference to the goods and, following Italian case-law mentioned by the opponent, these kind of marks are deemed to be “strong marks”. To the extent that this claim of the opponent may be interpreted as a misapplication of the Italian case-law, the Court of Justice states that, apart from the autonomous nature of Community law, there is no principle in the case-law of the European Union which establishes that the lack of any conceptual link to the relevant goods and services would automatically confer a higher degree of distinctive character to a CTM. The claim was rejected as manifestly unfounded. The opponent’s argument that the GC erred in excluding a conceptual similarity between the marks due to the fact that they are both composed of names of a non-Italian origin, was found by the Court of Justice to be aimed at a new evaluation of the facts. Therefore, this claim was rejected as manifestly inadmissible. The opponent’s arguments relating to the overall assessment made by the GC on the risk of confusion, namely the overall dissimilarity of the signs, taking into account their distinctive and dominant elements, was also merely directed towards a new evaluation of the findings of facts made by the GC, without any claim that the evidence was distorted by the GC. Therefore, this argument was also rejected as manifestly inadmissible.

**Case C-21/12 P; Abbott Laboratories v OHIM; Order of 17 January 2013; Language of the case: DE**

**Keywords: Matters of fact appealed to CJ, dictionary, lack of reasoning, principle of non-discrimination, admissibility**

**RESULT: Action dismissed**

**FACTS:** The CTM applicant sought the annulment of the General Court’s judgment in Case T-363/10, which confirmed the Board of Appeal’s decision refusing the CTM application RESTORE for goods in Class 10, inter alia, surgical instruments. The CTM applicant based the appeal on five pleas in law, namely the distortion of evidence, the breach of Articles 7(1)(c) and 7(1)(b) CTMR, the breach of Article 75(2) CTMR and the breach of the principle of non-discrimination.

**SUBSTANCE:** As regards the first plea in law, the Court of Justice pointed out that a distortion must be obvious from the documents on the Court’s file, without there being any need to carry out a new assessment of the facts and the evidence (Para. 55). Contrary to what was claimed by the applicant, the GC had not decided that it was general knowledge that RESTORE had a link to the field of medicine; it had merely stated that it was general knowledge, as evidenced by two cited dictionaries, that RESTORE means to “re-establish (a previous right, practice or situation)” and that it had, in one of its meanings, a direct connection to health (e.g. “she was fully restored to health”). There is no distortion of evidence (Paras. 56, 59 and 60). The CJ rejected the applicant’s arguments that the GC, by combining the meaning of the sign with the goods, in reality assessed the sign “RESTORE SOMEONE’S HEALTH” instead of the sign “RESTORE”. On the one hand, the applicant seeks a re-evaluation of facts, namely how the relevant public would understand the sign “RESTORE” (Para. 70). On the other hand, the GC has assessed the sign “RESTORE”, not any other sign. For the GC, the term as such is, with regard to the goods in issue, always connected to medical actions (Para. 73). A possible breach against Article 7(1)(b) CTMR is irrelevant as the ground for refusal in Article 7(1)(c) CTMR is applicable (Para. 77). The GC did not breach Article 75(2) CTMR. The applicant’s arguments are the same it made before the GC without any indication as to where the GC’s judgment breached the law and are therefore clearly inadmissible (Para. 85). In so far as the applicant’s arguments based on the breach of the principle of non-discrimination relate to how the Board has assessed the mark in the light of various other registrations consisting of or containing the word “RESTORE”, this seeks a review of the Board’s decision rather than arguing an error in law of the GC and is clearly inadmissible. Moreover, the GC did not state that previous OHIM practice does not need to be taken into account, but that the assessment of the earlier CTMs specified by the applicant, in itself, would not have led to another result in view of the correct assessment of the grounds of refusal by the Board in this individual case (Paras. 101, 102).

**B: General Court: Judgments on appeals against decisions of the OHIM**

**Case T-544/11; Spectrum Brands (UK) v OHMI; Judgment of 16 January 2013; Language of the case: EN**

**Keywords: Descriptive element**

**RESULT: Action dismissed**

**FACTS:** The CTM owner was granted registration for the word CTM **STEAM GLIDE** for goods in Class 9, inter alia, electric irons. The invalidity applicant applied for a declaration of invalidity on the basis of Article 52(1)(a) CTMR, read in conjunction with Articles 7(1)(b) and (c) CTMR. The Cancellation Division rejected the application for declaration of invalidity. On appeal, the Board annulled the Cancellation Division's decision and declared the CTM invalid. Before the General Court, the CTM owner claimed that the Board of Appeal had infringed Article 7(1) (c) and (b) CTMR.

**SUBSTANCE:** As regards the refusal to register a trade mark or to invalidate it based on Article 7(1)(c) CTMR, there must be a sufficiently direct and specific relationship between the sign and the goods or services in question to enable the public concerned immediately to perceive a description of the goods and services or one of their characteristics (Para. 21). It is not necessary that the signs composing the mark are in use in a way that is descriptive of the goods or services. It is sufficient that such signs and indications could be used for such purposes (Para. 24). The relevant consumer is an average consumer from the United Kingdom, Ireland and Malta (Para. 25). Each of the words of which the expression 'steam glide' is composed is descriptive of a characteristic of the goods in issue (Para. 30). The word 'steam' is directly descriptive. The term 'glide', when it is specifically associated with the goods in issue, directly describes the movement of an iron used to press clothes (Para. 29). A combination of words such as 'steam' and 'glide' is not unusual in English and it is not unusual either that the word "steam" is combined with a verb (Paras. 32, 33). There is no perceptible difference between the expression 'steam glide' and the mere sum of the words of which it is composed (Para. 35). It is sufficient that one of the absolute grounds for refusal listed in Article 7(1) CTMR applies (Para. 46). Moreover, a word mark which is descriptive under Article 7(1)(c) CTMR is necessarily devoid of distinctive character under Article 7(1)(b) CTMR.

**Case T-355/09; Reber Holding GmbH & Co. KG v OHIM; Judgment of 17 January 2013; Language of the case: DE**

**Keywords: Proof of use, time of use, place of use, extent of use, internet, sales figures, declaration, principle of legality, principle of non-discrimination**

**RESULT: Action dismissed**

**FACTS:** The applicant sought to register the figurative mark "**Walzer Traum**", shown below, for "coffee, sugar" and other goods in Class 30. The opponent opposed the registration on the basis of the German word mark, "**Walzertraum**", which was registered for "bakery products, chocolate products" and other goods in Class 30. The grounds were those laid down in Article 8(1)(b) CTMR. To prove the use of its earlier mark, the opponent submitted a declaration of its director, two photos of the window display of a coffee house/confectionery shop, monthly sales lists for chocolate products between March 2001 and December 2002 and two excerpts of the opponent's internet pages (2004 and 2007). The Opposition Division found that the opponent had proven use of its mark and that there was a likelihood of confusion. The Board annulled that decision, finding that the opponent had not proven genuine use. The opponent alleges an infringement of Article 42(2) CTMR and the principle of equal treatment.

| CTMA  | Earlier mark: DE   |
|---|--|
|  | <p data-bbox="868 1666 1027 1693" style="text-align: center;"><b>Walzertraum</b></p> |

**SUBSTANCE:** The relevant period for proof of use runs from 13 February 2001 to 12 February 2006. Contrary to the Board, which had found all pieces of the opponent's evidence to be admissible, the Court rejected the 2007 internet excerpt and the undated photos as inadmissible (Paras. 32, 33). The error of the Board has, however, no influence on the contested decision (Para. 34). The Court recalled its case-law according to which use of the mark need not always be quantitatively significant for it to be deemed genuine. However, the smaller the commercial volume of the exploitation of

the mark, the more necessary it is for the opponent to produce additional evidence to dispel possible doubts as to its genuineness (Paras. 39, 40). Chocolate products are general consumer products which are bought quickly and without much attention. The fact that the opponent's products are hand-made does not change this as they are available to the vast majority of consumers and are relatively inexpensive (Para. 42). The monthly sales lists for chocolate products show an average sale of 40 to 60 kg per year, which is low but relatively constant (Para. 37). The chocolate is sold in only one place, a coffee house/confectionery shop in a German city (18.000 inhabitants). The fact that the opponent chooses such a limited sales point as part of its marketing concept is irrelevant as marketing concepts are not part of the register (Para. 44). The advertising shown on the 2004 internet excerpt is advertising the coffee house/confectionery shop, not the chocolate called "Walzertraum". Moreover, the chocolate cannot be ordered through the internet (Para. 47). Therefore, although the evidence shows a certain continuity of use, there is only a limited amount and it is only local. This cannot be regarded as genuine use. OHIM decisions (Para. 50) and judgments of the German Federal Patent Court (Para. 52) do not change this assessment. The GC also rejected the opponent's claim of an infringement of the principle of equal treatment as the Board had assessed the evidence in accordance with the relevant objective criteria. There was no difference of assessment based on the size of the company (Para. 60).

**Case T-662/11; Thomas Müller v OHIM; Judgment of 29 January 2013; Language of the case: DE**

**Keywords: New argument, first time on appeal, modification of subject-matter before Court, identity of the goods and services, similarity of the goods and services, figurative element, complex mark, visual similarity, phonetic identity, phonetic similarity.**

**RESULT: Action dismissed**

**FACTS:** The applicant sought to register the figurative mark "**Sunless**", shown below, for goods in Classes 6, 19, 22 and 24, in alia "sunblinds". The opponent opposed the registration on the basis of the two CTMs "**SUNLESS**" and "**LONCAR-SUNLESS**", registered for goods in Classes 23 and 24 ("threads for textiles, textiles" etc.) and goods in Class 22 ("ropes, nets, tents" etc) respectively. The grounds were those laid down in Article 8(1)(b) CTMR. The Opposition Division allowed the opposition. The Board confirmed the OD's decision. The applicant alleges an infringement of Article 8(1)(b) CTMR.

| CTMA  | Earlier CTMs  |
|---|---|
|  | <p style="text-align: center;"><b>SUNLESS</b><br/><b>LONCAR-SUNLESS</b></p> |

**SUBSTANCE:** The GC rejected the applicant's arguments against identity of the goods in Classes 22 and 24 as inadmissible, because he had not argued against such identity before the Board of Appeal, but had restricted his arguments to the OD's assessment of likelihood of confusion and to the similarity of the goods in Classes 6 and 19 to those of the earlier marks. Hence, the subject-matter of the dispute before the Boards did not cover the issue of identity of the goods in Classes 22 and 24 to those of the earlier marks. The attempt to introduce this argument before the Court changes the subject-matter of the dispute (Paras. 16-19). The GC also rejected an argument of the applicant based on semantic differences between the English, German and French versions of the Nice Classification as inadmissible, because it was raised for the first time before the Court (Paras. 20-23). The relevant public is that of the EU. As the goods are comparatively expensive and consumers will not buy them every day, their level of attention is above average (Paras. 29-32). For practical reasons, the Court started with the assessment in relation to consumers in Member States, in which English is not usually spoken (confusion of part of the consumers is sufficient). The Court rejected the applicant's argument that the goods in Class 22 of the earlier mark are intermediate products and are dissimilar to the goods in Classes 6 and 19 of the CTMA. "Sunblinds" made of metal or not of metal are devices on windows that protect from light, weather conditions and observation by others, whereas "awnings" are roofs made from textiles or other materials, supported by a frame and fixed above a door or on the deck of a ship to protect from bad weather or light. The products are in competition with each other and similar or highly similar (Paras. 39-44). The Court rejected the applicant's argument that the marks are dissimilar due to the descriptive meaning of the term "sunless". Consumers in countries where English is not usually spoken might understand "sun", but won't understand "less", so that the level of distinctiveness of the earlier marks is medium (Paras. 55, 56). The figurative element of the CTMA is decorative and does not draw the attention of the consumer (Paras. 54, 59, 60). The signs are visually highly similar and phonetically identical

(SUNLESS) and visually and phonetically similar (LONCAR-SUNLESS) respectively. There is no conceptual difference between the signs. There is likelihood of confusion, even if consumers have an above average level of attention (Para. 82).

**Case T-33/12; Elke Piotrowski v OHIM; Judgment of 8 February 2013; Language of the case: DE**

**Keywords: News evidence, first time on appeal, admissibility, right to be heard, dictionary, purpose of the goods and services, abbreviation, descriptive element**

**RESULT: Action dismissed**

**FACTS:** The applicant registered the word mark **MEDIGYM** as International Registration for “medical gymnastic apparatuses” in Class 10 and designated the European Community. The examiner refused the registration on the ground that the mark was descriptive and devoid of distinctive character. The Board of Appeal confirmed this decision, stating that the mark contained a direct reference to the purpose of the goods. The applicant filed an action before the General Court.

**SUBSTANCE:** The GC rejected excerpts from Wikipedia and other webpages as well as a book, all covering the meaning of “medi”, as inadmissible, as the applicant had submitted them for the first time before the Court (Paras. 9-12). The Court furthermore rejected the applicant’s claim that its right to be heard had been infringed (Article 75(2) CTMR). The applicant was informed of all the relevant factual and legal aspects throughout the administrative proceedings. Several aspects mentioned by the applicant were already expressly stated in the examiner’s decision. The fact that the applicant had not been sent copies of the relevant pages from the Acronyms, Initialism & Abbreviations Dictionary and Collins English Dictionary does not infringe its right to be heard as they are generally available sources of information which the applicant was able to consult (Para. 25). The Board’s decision does not infringe Article 154 in conjunction with Article 7(1)(c) CTMR. The element “gym” will be understood by the English speaking public as abbreviation of “gymnasium” or “gymnastic” (not disputed) (Para. 37). “Medi” is the root of the adjective “medical” and an abbreviation of the term “medicine”. Furthermore, “medi” is a common component of numerous terms in the medical field (Paras. 38-40). Consumers of the relevant goods will understand “medi” as reference to the use of these goods in the medical field, even though the term might have other meanings in other contexts (Paras. 42-44). The elements are combined in accordance with the rules of English grammar (not disputed) (Para. 51). The relevant consumers will directly understand “MEDIGYM” as “medical gymnasium” or “medical gymnastic” and therefore as a direct reference to the purpose of the goods (Para. 55-57).

**Case T-378/11; Franz Wilhelm Langguth Erben GmbH & Co. KG v OHIM; Judgment of 20 February 2013; Language of the case: DE**

**Keywords: Seniority, figurative mark, international registration, general reference to previous submissions, lack of reasoning, identity of the signs, error by OHIM, no bearing on decision, principle of legality**

**RESULT: Action dismissed**

**FACTS:** The applicant sought to register the figurative sign **MEDINET**, shown below, as a CTM for goods in Class 33. It claimed the seniority of an earlier national and international figurative mark MEDINET, shown below, in color. The examiner refused the claim of seniority. The Board of Appeal dismissed the appeal. It considered that the CTMA and the earlier mark were not identical, as the first did not designate any specific color whereas the other was golden in color. The applicant appealed alleging an infringement of Article 34(1), Article 75 and Article 77 CTMR.

| CTMA  | Earlier Registration   |
|---|--|
|  |  |

**SUBSTANCE:** The applicant's general reference to previous submissions is inadmissible (Para. 13). The GC rejected the applicant's argument that the Board had not sufficiently reasoned its decision. The Board was not required to carry out a detailed analysis of the decisions referred to by the applicant (Para. 17). The GC also rejected the applicant's claim of seniority. In order to uphold a claim of seniority, three cumulative conditions must be fulfilled; one of them being the identity of signs (Para. 26). A sign is identical with a trade mark only where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences which are so insignificant that they may go unnoticed by an average consumer (Paras. 26, 27). A concept which is used in different provisions of a legal measure, must, for reasons of coherence and legal certainty, and particularly if it is to be interpreted strictly, be presumed to mean the same thing, irrespective of the provision in which it appears (Para. 41). Therefore, although the objectives of Article 8(1)(a) and of Article 34 are not the same, the concept of "identical" need to be interpreted in the same way in both provisions. Although the Board found that this concept did not necessarily have to be interpreted in the same way in both articles, this error does not vitiate the reasoning in the Board's decision, since the grounds for the decision are consistent with the definition used by the Court (Para. 46). The scope of protection of the marks, contrary to what OHIM submits, is not a factor to be taken into consideration in examining seniority (Para. 47). Also, the Guidelines are merely a set of rules setting out the line of conduct which OHIM proposes to adopt. It must be determined in the light of the case-law whether the difference between the signs is so insignificant that they must be regarded as identical (Paras. 50, 51). The fact that a mark is registered in colour or, on the contrary, does not designate any specific colour cannot be regarded as a negligible element in the eyes of a consumer. The impression left by a mark is different according to whether that mark is in colour or does not designate any specific colour (Para. 52). The Board was right to find that the marks were not identical (Paras. 53, 54). The Court also rejected the applicant's argument for a partial seniority, i.e. that the applicant should be able to rely, in the relevant countries, on the seniority of the mark in colour and not the seniority of the CTM for the representation in black and white. This would render meaningless the requirement that the marks have to be identical (Para. 68). Furthermore, the possibility of relying on the seniority of a part of the earlier national mark is not provided for by Article 34 CTMR (Para. 69). The GC rejected the applicant's claim that the Board should have held an oral hearing. The Board had before it all the information needed as a basis for the operative part of its decision (Para. 74).

**Case T-640/11; Boehringer Ingelheim International GmbH v OHIM; Judgment of 30 April 2013; Language of the case: EN**

**Keywords:** Laudatory mark, misspelled word mark, characteristics of the goods and services, no bearing on decision, principle of non-discrimination

**RESULT:** Action dismissed

**FACTS:** The applicant obtained an International Registration designating the EU for the sign **RELY-ABLE** for services in Classes 38, 41 and 42 relating to clinical trials. The examiner refused protection of the mark on the basis of Article 7(1)(b) and (2) CTMR. The Board of Appeal confirmed this assessment. It considered that the word mark RELY-ABLE was not distinctive, as it would be perceived as nothing more than a promotional message whose aim is to highlight an important positive aspect of the services, namely that they are reliable. The applicant appealed to the GC claiming an infringement of Article 7(1)(b) CTMR.

**SUBSTANCE:** The relevant consumer is the English speaking professional consumer in the EU who is specialised in the pharmaceutical field (Para. 15). The Court rejected the applicant's argument that the Board had disregarded the fact that the visual perception was of particular importance in relation to the services. The Board had regard to the importance of the visual perception of the sign. It argued with the spelling, which relates to visual perception (Para. 18). As regards the distinctive character, the Court emphasized that misspellings are not generally conducive to overcoming refusal of registration because the content of the sign is immediately comprehensible as laudatory or descriptive. Moreover, where the misspelling of a word mark is not perceptible phonetically, it has no effect on the possible conceptual content that the relevant public will attribute to that mark (Para. 20). The misspelling of "reliable" is perceptible visually rather than phonetically, so there is no conceptual ambiguity for the relevant public (Para. 21). Even visually, "reliable" is merely broken down into its verbal root "rely" and its adjectival suffix "able". The laudatory or promotional meaning of the sign will be immediately perceived and understood by the relevant public, in particular as it is specialised (Paras. 23, 24). The Court also rejected the applicant's argument that the Board erred in finding that misspellings were a frequent feature of promotional messages. Even if this might not be the case for services related to clinical trials, the Board's statement was included purely for completeness sake and cannot lead to the decision being set aside (Paras. 26-28). "RELY-ABLE" is not a juxtaposition of two words (and the case-law relevant to such juxtapositions therefore is not relevant) (Para. 31). The case-law on the use of a hyphen in the context of relative grounds for refusal does not offer guidance on the separate question whether an additional hyphen might render a sign distinctive for the purposes of absolute grounds for refusal

(Para. 32). The registration of other CTMs, including the mark "RE-LY", is not binding. An examination must be undertaken in each individual case separately (Paras. 33, 34).

**Joined Cases T-321/11 and T-322/11; Raffaello Morelli v OHIM; Judgments of 14 May 2013; Language of the cases: IT**

**Keyword: Domain names, internet, press articles, use in the course of trade**

**RESULT: Actions dismissed**

**FACTS:** On 26 April 2007 and 6 August 2007, respectively, two applications were filed, seeking to register as CTMs 1) the word mark **PARTITO DELLA LIBERTA'** and (2) the figurative sign represented below, both in respect of the same range of goods and services in Classes 9, 14, 16, 24, 25, 35, 36, 38, 41, 42 e 45. Two oppositions were filed based on Article 8(4) CTMR, invoking prior rights in the domain name **partitodellaliberta.it**, allegedly used in the course of trade in Italy in respect of goods and services in Classes 16, 35, 38, 41 e 45, the latter being 'political services; political propaganda aimed at achieving given political results and/or ideals'. The Opposition Division rejected the oppositions, considering that no proof had been given that the domain name had been used. The Board of Appeal dismissed the opponent's appeals. The opponent appealed to the GC.

| CTMs applied for   | Earlier Italian domain name |
|--|-----------------------------|
| 1) PARTITO DELLA LIBERTA'<br><br><br>2) | partitodellaliberta.it      |

**SUBSTANCE:** The GC rejected the opponent's argument that the fact that the domain name '[partitodellaliberta.it](http://partitodellaliberta.it)' had been formally attributed to it by the competent Italian authority was sufficient to prove the visible use of the domain name by third parties and, therefore, its use in the course of trade (Paras. 38-40). The Court noted that the domain name was under construction at the time of filing of the contested CTM applications, having therefore no content, and that the corresponding address automatically re-directed the user to another domain address, '[www.liberali.it](http://www.liberali.it)'. The GC held that, without it being necessary to examine the nature of the content available on the latter site, the re-direction mechanism was not able to prove the alleged use of the former domain name in the course of trade (Para. 44). The GC further held that the newspaper article dated 25 August 2007 and taken from the online edition of the Italian daily *La Stampa* could not prove the use of the domain name '[partitodellaliberta.it](http://partitodellaliberta.it)', since it only confirmed the mere existence of the website, but not that it had received visits thereof (Para. 46). Nor could extracts from the mentioned website dated after the filing of the two contested CTM applications be relied upon in order to prove the use of the domain name (Para. 47). The GC also confirmed the Board's finding that the above extracts did not provide any information showing that the domain name was used in the course of trade with a view to economic advantage, given that they contained a concise introduction of a political program (Para. 48). Finally, the GC held that other documents, namely articles from publications and websites, filed by the opponent, did not assist in establishing the commercial use of the domain name on which the oppositions were based (Para. 49).

Case T-353/12; *Aleris v OHIM*; Judgment of 16 May 2013; Language of the case: EN

**Keywords:** Claim for alteration of OHIM decision, proof of use, evidence of use, Nice classification, invoice, purpose of the goods and services

**RESULT:** Action partly upheld (BoA decision partly annulled)

**FACTS:** The CTM proprietor registered the word mark **ALARIS** for goods and services in Classes 10, 37 and 42. The revocation applicant filed a request for revocation on the grounds of Article 51(1)(a) CTMR. The Cancellation Division rejected the request in part. The Board of Appeal dismissed the revocation applicant's appeal. The revocation applicant appealed to the General Court.

**SUBSTANCE:** (1) As a preliminary point, the GC noted that the "ALADIN" case-law (Case T-126/03) is applicable to revocation proceedings where the cause of the revocation relied upon is the absence of genuine use of part of the goods or services for which the mark was registered (Paras. 18-20). (2) Regarding the alleged infringement of 51(1)(a) and (2) CTMR in respect of goods in Class 10, the Court upheld the Board's consideration that '*instruments and medical equipment*' formed a category sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently. However, it found that the Board had erred when it identified only one single sub-category, namely '*infusion pumps and controllers*', and bundled within it goods which were admittedly complementary, but the intended uses of which differed. The GC held that the Board extended the protection conferred by the proof of genuine use of a part of the goods in respect of which the mark was registered beyond that provided not only by the CTMR but by the relevant case-law as well (Paras. 21-23). With regard to the goods within the sub-category that have the same intended use, in particular *controllers*, the findings of the Board were confirmed. The Court also noted that genuine use for infusion systems, syringe pumps, volumetric pumps, thermometers and disposable thermometers was not contested by the revocation applicant and should therefore be deemed to have been proven (Paras. 24, 26). The GC annulled the contested decision insofar as it found that proof of genuine use was established in relation to goods covered by the mark in question falling within Class 10, other than *infusion systems, syringe pumps, volumetric pumps, controllers, thermometers and disposable thermometers* and dismissed the action as to the remainder. (3) Regarding the alleged infringement of 51(1)(a) CTMR in respect of services in Class 37, the Court rejected the revocation applicant's argument, according to which the Board found that a single invoice was sufficient proof of the actual offer of services, as factually incorrect (Para. 31). The GC found that the revocation applicant had failed to explain how the evidence submitted by the CTM proprietor and accepted by OHIM's instances established only limited use of the services at issue. It also failed to put forward any evidence in support of the wider diversification of the market in medical services and the secondary market purchasers to which it referred. Finally, the Court noted that the revocation applicant did not contest the probative character of the evidence submitted by the CTM proprietor to OHIM (Paras. 40-42). (4) As far as the application seeking alteration of the contested decision was concerned, the General Court confirmed its case-law that the exercise of the power to alter decisions must, in principle, be limited to situations in which the Court, after reviewing the assessment made by the Board of Appeal, is in position to determine on the basis of the matters of fact and of law as established, what decision the Board was required to take (Para. 44). In the case at hand, the Board erred in its analysis of the question of genuine use of the products by not identifying within the category of '*instruments and medical equipment*' various sub-categories capable of being viewed independently, and therefore it was not for the Court to carry out that analysis (Paras. 45-46).

Case T-356/11; *Christian Restoin v OHIM*; Judgment of 16 May 2013; Language of the case: FR

**Keywords:** Principle of non-discrimination, nature of the goods and services

**RESULT:** Action dismissed

**FACTS:** The applicant sought to register the word mark **EQUIPMENT** as a CTM for goods and services within Classes 3, 9, 14, 18, 25 and 35. The examiner refused the application for registration for most of the goods and for some services on the ground that the mark applied for was devoid of distinctive character for the purposes of Article 7(1)(b) and Article 7(2) CTMR. The Board of Appeal confirmed this decision. The applicant filed an action before the General Court.

**SUBSTANCE:** The Court held that the targeted public by reference to which the existence of an absolute ground for refusal must be assessed is the average English speaker consumer in the European Union. The mark applied for is composed of the term 'equipment', which is an English word that will be translated in French as "équipement" meaning "the means used in an operation or activity". The word EQUIPMENT can also be translated as the tools or means necessary to perform this activity. With this general definition in mind the Board was correct in finding that the word "equipment" constitutes information about the nature of the products meaning that they constitute elements of a whole (equipment) to be used in the performance of an activity. This analysis made by the Board could correctly be extended to

services in Class 35 as the services included in the application are closely linked to the products. Therefore, the Board did not err in its conclusion that the sign is devoid of distinctive character for the products and services. On the applicant's argument that the word mark EQUIPMENT has been registered in France, Canada, Australia, Hong Kong, USA, United Kingdom and Singapore, the General Court recalled the case-law according to which the CTM regime is an autonomous legal system which pursues objectives particular to it; it applies independently of any national system. That is so even if such a decision was adopted in a country belonging to the linguistic area from which the word mark in question originated.

**Case T-80/11; Dwarka Nath Kalsi and Ajit Nath Kalsi v OHIM; Judgment of 16 May 2013; Language of the case: DE**

**Keywords: Complex mark, specialised consumer, identity of the goods and services, dissimilarity of the goods and services, complementary goods and services, similarity of the signs, visual similarity, phonetic similarity, conceptual similarity, figurative element**

**RESULT: Action partially upheld (BoA decision partially annulled)**

**FACTS:** The applicants sought to register the figurative sign **RIDGEWOOD**, shown below, as a CTM for goods in Classes 18, 24 and 25. The opponent based an opposition, inter alia, on Article 8(1)(b) CTMR using, inter alia, the earlier figurative CTM, **River Woods**, shown below, registered for goods in Classes 18 and 25 as well as for services in Class 40. The Opposition Division rejected the opposition, finding the signs to be of only low visual and phonetic similarity. The Board annulled that decision and found that there was likelihood of confusion. It found identity of the goods in Classes 18 and 25 and similarity between the CTMA's goods in Class 24 ("Textiles and textile goods" etc.) and the services "processing and finishing skins, leather, furs and textiles" in Class 40 of the earlier right (complementarity). The Board considered the signs to be highly similar both on a visual and a phonetic level and conceptually similar for the English speaking public (conceptually neutral for the rest). The applicants appealed to the GC alleging an infringement of Article 8(1)(b) CTMR.

| CTMA  | Earlier CTM  |
|---|--|
|  |  |

**SUBSTANCE:** The consumer of the goods is the general public, whereas the consumer of the services "processing and finishing skins, leather, furs and textiles" in Class 40 is a professional consumer (not disputed). The goods in Classes 18 and 25 are identical (not disputed). The Court stated, however, different from the Board, that the goods in Class 24 of the CTMA and the services "processing and finishing skins, leather, furs and textiles" in Class 40 of the earlier right could not be complementary as they were destined for different types of consumers (general consumer v professional consumer) (Paras. 28-30). OHIM's argument that there were overlaps between the general and the professional consumer was rejected (Para. 31). The Board erred in finding these goods and services to be similar. As regards the similarity of the signs, the Court found that the signs are strongly similar on a visual level. The similarity of the word elements RIDGEWOOD and River Woods outweighs the differences between these elements (Para. 41). The figurative elements and the additional word element in the earlier mark cannot counteract that visual similarity. The word elements RIDGEWOOD and River Woods, although not dominant, have an independent distinctive role within the signs and are perceived as important elements (Para. 43). The visual similarity is also enhanced by the fact that both signs contain trees as figurative elements (Para. 44). The signs are also highly similar phonetically due to the pronunciation of the word elements RIDGEWOOD and River Woods. The additional word element "north-eastern suppliers" of the earlier mark has only a subsidiary position and is unlikely to be verbalised by the consumer (Para. 48). The verbal element "woods" combined with the figurative element of the trees leads to conceptual similarity of the signs for the English speaking public, which is not counteracted by the flag of the USA (and possible reference to the American way of life) in the earlier mark (Paras. 52-57). In view of the above, and the normal level of distinctive character of the earlier right, the GC confirmed the Board's assessment that there was likelihood of confusion with regard to the goods in Classes 18 and 25. However, it annulled the Board's decision with regard to the goods in Class 24 of the CTMA due to a lack of similarity to the services "processing and finishing skins, leather, furs and textiles" in Class 40 of the earlier right.

Case T-104/12; Verus Food v OHIM; Judgment of 16 May 2013; Language of the case: EN

**Keywords:** Restriction of the list of goods and services, admissibility, priority, identity of the signs, dissimilarity of the goods and services, retail services, competence of the Boards, right to be heard

**RESULT:** Action dismissed

**FACTS:** The applicant sought to register the word mark "VORTEX" for goods in Classes 7 and 12. An opposition pursuant to Article 8 (1)(b) CTMR was based on the CTM application of an identical trademark "VORTEX" filed for services in Classes 35 and 39. Its filing date was posterior to the filing date of the contested CTM, but it claimed the priority of a German mark, which was applied for before the CM application. The opposition was rejected due to the dissimilarity of the goods and services. Shortly afterwards, the opponent declared a partial surrender of its trademark and submitted a new list of services in Class 35 that was registered by OHIM. The opponent filed an appeal, arguing that the Opposition Division had not taken into account the limitation of its earlier mark for the comparison of the goods and services. The appeal was dismissed. The opponent filed an action to the Court claiming an infringement of Articles 29, 50, 75(2) and 8(1)(b) CTMR.

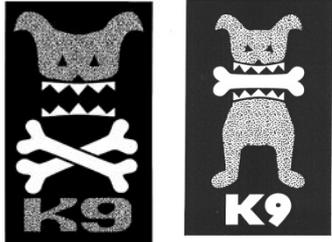
**SUBSTANCE:** The crucial issue of the case was if the Board of Appeal was correct in not taking into consideration the limitation of the services of the earlier CTM. The Board considered the limitation inadmissible since it changes (broadens) the scope of protection. The opponent challenged this finding and insisted on the fact that the change was registered and thus accepted by the Office. There was no infringement of Articles 29 and 50 CTMR. The CTM that was the basis of the opposition can be considered "the earlier trade mark" only as far as the services covered by it are identical with those of the priority mark (Para. 41). The "retail services" were, however, not covered by the original list of services of the CTM or the German priority mark. A change of the list of services in Class 35 by adding to the original "arranging and concluding of commercial contracts, including within the framework of e-commerce" a further qualification "*namely retail and wholesale services in relation to vehicles, motor vehicle wheels, chassis parts for two-wheeled vehicles, (...)*" is not admissible. As stated in the judgement C-418/02 (Praktiker), retail services include, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Thus, it is broader than "commercial contracts" only (Para. 43). The opponent does not enjoy the priority of the earlier German registration for "retail services" (Para. 46). Pursuant to Article 64(1) CTMR, the Board of Appeal is called upon to carry out a new, full examination of the merits of the opposition in terms of both law and fact (Para. 34). It was allowed to examine the admissibility of the partial surrender, since this influences the scope of the opposition and the assessment of the likelihood of confusion (Para. 34). The Board has correctly considered that the partial surrender would broaden the scope of protection of the earlier trade mark. The goods are therefore not similar (Para. 65). Article 75(2) CTMR was not infringed by the fact that the Board did not invite the opponent to file observations on the admissibility of the partial surrender. The opponent based its appeal on the fact that the surrender should have been taken into consideration, so already presented its position on its admissibility (Para. 74).

Case T-231/12; Rocket Dog Brands v OHIM; Judgment of 17 of May 2013; Language of the case: EN

**Keywords:** Complex mark, figurative element, dominant element, similarity of the goods and services, identity of the goods and services, visual dissimilarity, phonetic similarity, conceptual dissimilarity, examination of facts ex officio

**RESULT:** Action dismissed

**FACTS:** The applicant sought to register the word mark "JULIUS K9" as a CTM for goods in Classes 18 and 25. An opposition was filed on the grounds of Article 8(1)(b). It was based on the earlier figurative trade marks "K9", shown below, for goods in Classes 18 and 25. The Opposition Division rejected the opposition. The Board of Appeal dismissed the appeal. It considered that the word "Julius" was dominant in the CTMA and that the alphanumeric combination "K9" was secondary. The marks were visually dissimilar. They were not conceptually similar, because the CTMA contained no features related to dogs. Finally, the Board found that, despite the identity of the goods in Classes 18 and 25, there was no likelihood of confusion given the visual dissimilarity of the marks, the below average degree of their phonetic similarity, the average distinctiveness of the earlier marks and the normal level of attentiveness of the relevant public. The opponent appealed the case to the GC. It alleged the infringement of Article 8(1)(b) CTMR and challenged the decision only in respect of the Board's finding that there was no likelihood of confusion in relation to the marks in Class 25. The opponent claimed that the Board erred in comparing the overall impression in failing to take into account the distinctive character of the earlier marks, as well as in not taking into consideration the judgement in Case C-120/04.

| CTMA      | Earlier Marks  |
|-----------|--|
| JULIUS K9 |  |

**SUBSTANCE:** The contested goods were considered to be partially similar and partially identical (undisputed) (Para. 19). As regards the visual comparison, the GC found that the figurative elements of the earlier marks are the dominant ones (Para. 28), while the term 'julius' is the dominant element of the word mark applied for (Para. 29). Moreover, the GC considered that the principle set out in the *Medion* case (C-120/04) is not applicable to the case at hand (Para. 31). Given that the structure of the signs is also visually very different; the GC concluded that the marks are not similar (Para. 35). Phonetically, the mark applied for is composed of three syllables more than the earlier marks. Therefore, the GC endorsed the Board's opinion that the marks are similar to a below average degree (Para. 37). Conceptually, neither the combination 'K9', nor the term 'julius' of the mark applied for creates a conceptual link with dogs (Para. 39). The marks are thus conceptually dissimilar. The GC also refused as irrelevant the opponent's argument that the applicant himself had submitted the opposite opinion in a parallel case (Para. 44). Finally, the GC recalled that OHIM is required to examine the inherently distinctive character of an earlier mark and that this assessment does not require the parties to provide facts, arguments or evidence (Para. 50). If the Board did not explicitly address this question, this has to be interpreted as meaning that OHIM did not attribute, to the earlier marks, an above-average degree of distinctiveness which it should have pointed out on its own motion. Moreover, the GC considered that the earlier marks had the level of inherent distinctiveness of any mark which does not describe the goods it refers to and their level of distinctiveness is not above average (Para. 52). There is no likelihood of confusion.

**Case T-178/11; Voss of Norway ASA & Nordic Spirit AB v OHIM; Judgment of 28 May 2013; Language of the case: EN**

**Keywords: Three dimensional mark, packaging**

**RESULT: Action dismissed**

**FACTS:** The cancellation applicant filed an application for annulment of the 3D bottle CTM Number 3156163, registered for Classes 32 and 33, based on Article 52(1)(a) and (b) and Article 7(1)(a)(b)(c)(d) and (e)(i)(iii) CTMR. The Cancellation Division rejected the application in its entirety. The cancellation applicant brought an appeal before OHIM. The Board of Appeal annulled the decision and upheld the application for a declaration of invalidity. The CTM proprietor filed an action before the General Court.



**SUBSTANCE:** The Court held that the 'perfect cylinder' shape of the CTM proprietor's bottle, although somewhat original, cannot be regarded as departing significantly from the norms and customs of the sector. In relation to the non-transparent cap having the same diameter as the bottle itself, the Court confirmed that this, too, can hardly be considered to depart significantly from the norms and customs of the sector as it is well known that many bottles are closed with a cap made of a different material and colour from the body of the bottle. It also added that the diameter of the cap, which is

the same as the bottle's, is a mere variant of the existing shapes and cannot be regarded as departing significantly from the norms and customs of the sector, even though it is somewhat original. Therefore the GC concluded that the contested trade mark is made up of a combination of components, each of which is liable to be in general commercial use for packaging the goods covered by the trade mark and is therefore devoid of distinctive character. On the combination of the different elements, the Court held that the manner in which the components are combined is not capable of giving the mark distinctive character. The GC also confirmed that the Board had correctly applied the test established by case-law in order to assess the distinctive character of a 3D sign even if the decision is prior to the Freixenet judgment of the Court of Justice. As regards the argument of the CTM proprietor that the Board had failed in the assessment of the evidence submitted by the cancellation applicant, the GC held that even if the Board did not establish that there were other, similar bottles on the market which were also registered, the Board was correct in noting that bottles containing alcoholic and non-alcoholic beverages generally have a cylindrical shape and a non-transparent cap and that the CTM proprietor's bottle was a mere variant of that commonly-used shape. The General Court also confirmed that the Board did not distort the evidence in its possession in correctly finding that the lack of a neck – as argued by the CTM proprietor itself, namely the lack of narrowing towards the top of the bottle and the bottle keeping the same diameter from the base to the top – meant that the bottle was merely a variant of existing shapes of bottles sealed with a cap, which could not be viewed as departing significantly from the norms and customs of the sector. The Board of Appeal was therefore correct in finding that the registered trade mark was devoid of distinctive character and that it could not really be distinguished from the forms of packaging frequently used in the beverages sector.

**Case T-172/12; Brauerei Beck GmbH & Co. KG v OHIM; Judgment of 30 May 2013; Language of the case: DE**

**Keywords: Complex mark, figurative element, dissimilarity of signs, visual dissimilarity, phonetic dissimilarity, survey, principle of non-discrimination, burden of proof**

**RESULT: Action dismissed**

**FACTS:** The applicant filed a CTM application for the figurative mark **Be light**, shown below, for goods in Class 32. The opponent lodged an opposition based on its earlier CTM **BECK's**, registered for goods in Class 32. The Opposition Division granted the opposition on the basis of Article 8(1)(b) CTMR. The Board of Appeal annulled the OD's decision. It found that the relevant consumer would not consider the figurative element of the mark applied for as representing the letter "x" and that the signs were not similar. The opponent appealed to the GC, claiming an infringement of Article 8(1)(b) and Article 8(5) CTMR.

| CTMA  | Earlier CTM                                      |
|---|--|
|  | <p style="text-align: center;"><b>BECK's</b></p> |

**SUBSTANCE:** The relevant consumer is the average consumer in the European Union (not disputed). Neither the verbal elements nor the figurative element of the mark applied for dominate the overall impression in a way that would make the other elements negligible (Para. 23). The figurative element of the mark applied for will not be seen as a reference to the letter "x", but will immediately be perceived as a figure with stretched arms and legs (Para. 25). The GC rejected the opponent's argument based on a market study. The principle that prevails in Community law is that of the unfettered evaluation of evidence and it is only the reliability of the evidence that is decisive when it comes to its evaluation. In order to assess the probative value of a document, regard should be had first and foremost to the credibility of the account it contains and, in particular, to the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, on its face, the document appears sound and reliable (Para. 27). The GC considered that the study submitted in the present case did not contain sufficiently convincing information that the results of the study are reliable (survey via internet, low number of answers) (Para. 28). The GC also rejected the opponent's argument in relation to the figurative element based on the Vienna classification as that classification is for

administrative purposes only (Para. 29). Equally, the fact that OHIM had, at its confirmation of receipt of the application, shown the mark applied for as “beXlight” does not have any influence on the legal evaluation of the contested decision (Para. 29). The argument based on other similar applications was also rejected (Paras. 31-33). Since the marks only have the letters “b” and “e” in common and are pronounced very differently, there is no visual or phonetic similarity (Paras. 34, 35). “Be” and “light” form part of the basic English vocabulary that will be understood by a large number of the relevant consumers as a reference to the fact that the beverages in question have no negative influence on a person’s organism or might even be beneficial (Para. 36). The earlier mark has no meaning. Therefore, the signs are dissimilar and Article 8(1)(b) has not been breached. Equally, it is a condition of Article 8(5) CTMR that the signs are either identical or similar, which is not the case.

**Case T-115/12; Buzil-Werk Wagner GmbH & Co. KG v OHIM; Judgment of 30 May 2013; Language of the case: DE**

**Keywords: Admissibility, modification of subject-matter before Court, visual similarity, phonetic identity, conceptual identity, similarity of the goods and services, complementary goods and services, burden of proof, well known facts need no evidence**

**RESULT: Action dismissed**

**FACTS:** The applicant filed a CTM application for the word mark **Roca** for goods in Class 3, inter alia cleaning material for stone. The opponent lodged an opposition based, inter alia, on its earlier Spanish figurative mark **ROCA**, shown below, registered for goods in Class 21. The Opposition Division granted the opposition for some goods on the basis of Article 8(1)(b) CTMR. Upon appeal of the opponent, the Board of Appeal granted the opposition for all goods of the CTMA. The applicant appealed to the GC, claiming an infringement of Article 8(1)(b) CTMR.

| CTMA | Earlier figurative Spanish mark |
|------|---------------------------------|
| Roca | <b>ROCA</b>                     |

**SUBSTANCE:** The applicant’s claim is in part inadmissible, namely for those goods of the CTMA which had already been refused by the OD in its decision, a decision that had not been appealed by the applicant. Those goods did not form part of the subject-matter decided by the Board and their inclusion at the level of the GC would be an inadmissible modification of the subject-matter (Paras. 19-29). The signs are visually similar and phonetically and conceptually identical (not disputed). The earlier Spanish mark has a normal level of distinctive character (not disputed). The Court rejected the opponent’s argument that the relevant consumer was exclusively a professional consumer of cleaning materials. The relevant consumer is the average general consumer, even with regard to those goods of the CTMA that might be used with the help of special machines. The goods are not restricted to professional users, but are widely available in retail for a moderate price (Paras. 41-44). But even if the relevant public was made up of professional and general consumers, the Board would have had to assess the likelihood of confusion on the basis of the general consumer as he has the lower level of attention (Para. 46). The goods are similar to an average degree. Although the cleaning supplies listed in the CTMA are not of the same nature as the “brushes and sponges” for which the earlier mark is registered, the goods have an identical function (cleaning), are distributed through the same channels and are complementary to each other (brushes and sponges enable the use of the cleaning supplies mentioned in the CTMA) (Paras. 53-59). The applicant has not provided any evidence proving its allegation that its cleaning supplies are applied by use of special machines rather than through brushes and sponges. It has also never presented this argument before OHIM (Para. 62). Furthermore, the applicant’s argument that the Board had not proven that the goods are sold through the same channels was rejected. The Board could validly base itself on well-known facts. The applicant has not submitted any evidence calling the Board’s statement into question (Paras. 64, 65). In view of the high level of similarity of the signs, the similarity between the goods and the fact that the relevant consumer does not have a particularly elevated level of attention, the Board rightly found that there was a likelihood of confusion (Para. 68).

**T-126/12; Interroll Holding AG v OHIM; Judgment of 6 June 2013; Language of the case: DE**

**Keywords: Slogan mark, laudatory mark, internet, specialised public**

**RESULT: Action dismissed**

**FACTS:** The applicant sought to register the slogan “**Inspired by efficiency**” for goods and services in Classes 6, 7, 9, 20, 35, 39 and 42. The Examination Division’s decision, rejecting the CTM application based on Article 7(1)(b) and (c) CTMR, was confirmed by the Boards of Appeal. The applicant appealed to the GC.

**SUBSTANCE:** There are no different criteria for slogans. However, the relevant public’s perception is not necessarily the same in relation to marks in certain categories and it could prove more difficult to establish distinctiveness in relation to such marks (Para. 20). Marks can express an objective message, even a simple one, and still be capable of indicating the commercial origin of the goods or services, in particular, where those marks are not merely an ordinary advertising message, but possess a certain originality or resonance, requiring little in the way of interpretation by the relevant public, or setting off a cognitive process in the minds of that public (Para. 23). The case at hand: The relevant public is made up of specialist consumers. Although specialist consumers usually possess a higher degree of attentiveness, their

awareness is liable to be relatively low for purely promotional indications (Para. 27). The mark is neither grammatically incorrect nor syntactically unusual (Para. 30). The internet pages cited by the Board show that the word combination is not unusual in English. This is not changed by the fact that those pages show the words embedded in a larger text, that many of them refer to the applicant itself or that it was unclear which goods or services the internet pages refer to (Paras. 33-35). “Efficiency” refers to the efficiency of the goods and services and not, as claimed by the applicant, the efficiency of the developer of such goods (Para. 39). The fact that “inspired by efficiency” might be the company philosophy does not make it distinctive (Para. 40). Consumers will understand it as laudatory and advertising reference to the efficiency of the goods and services, not as a reference to their commercial origin (Para. 41). Contrary to the applicant’s claim, the situation of the present case differs significantly from that of “Vorsprung durch Technik”. The latter was a widely known slogan that had been used for many years. It also had a different level of originality, resonance and necessity of interpretation (Para. 43). Therefore, the GC “cannot be guided by the CJ’s decision in “Vorsprung durch Technik” in the present case” (Para. 43). As the present slogan lacks distinctive character within the meaning of Article 7(1)(b) CTMR, it is not necessary to assess it under Article 7(1)(c) CTMR (Para. 48).

**Case T-411/12; Celtipharm & Alliance Healthcare France SA v OHIM; Judgment of 6 June 2013; Language of the case: FR**

**Keywords: Beginning of mark, descriptive element, similarity of the goods and services, visual similarity, phonetic similarity, conceptual similarity, claim for alteration of OHIM decision**

**RESULT: Action upheld (BoA decision reformed)**

**FACTS:** The applicant sought to register the verbal mark **PHARMASTREET** as a CTM for goods and services in Classes 5 and 35. An opposition based on the earlier French mark **PHARMASEE**, registered for services in Classes 35, 38 and 44, was filed on the grounds of Articles 8(1)(b) CTMR. The Opposition Division upheld the opposition, partially, for pharmaceuticals and for dietetic substances for medical use in Class 5 and all services in Class 35. The Board of Appeal annulled the decision and rejected the opposition in its entirety. The opponent appealed to the GC.

**SUBSTANCE:** The Court took the view that the contested decision is wrong in the assessment of the similarity of the signs. The element “PHARMA” which is placed at the beginning of both marks has more impact than the other elements of the signs. The elements “STREET” and “SEE”, placed at the end of the signs, are shorter and draw less the attention of the relevant public. The signs are similar from a visual point of view. The jurisprudence related to the impossibility for a descriptive element to be the dominant part of a sign is not applicable in the present case. On the phonetic comparison, the General Court held that the signs share not only the pronunciation of the part “PHARMA” but also the sounds “S” and “I” in the second part. Therefore, the signs are similar from the phonetic point of view. Conceptually, the applied for sign refers to pharmacy’s street and the other is a *jeu de mots* with the French word *pharmacie*. Both signs conceptually refer to the pharmaceutical field and therefore they are similar. As the goods and services are similar (this conclusion is a confirmation of the assessment done by the contested decision) and the signs too, the fact that the element “PHARMA” is not distinctive is not an obstacle to the conclusion that there is a risk of confusion. Referring to Article 65 (3) CTMR as interpreted by the Court of Justice in the case EWIN/OHIM, the General Court takes the final decision in the present case in relation to the decision of the Opposition Division, allowing the opposition for “pharmaceutical products and dietetical substances for medical use” and some services in Class 35.

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**Decision of the Second Board of Appeal of 14 May 2013 in Case R 1925/2012-2 – (FR)****Article 7(1)(b) and (2) CTMR****The applicant sought to register the word mark****'DODO TOUTE LA DOUCEUR DU MONDE'**

for goods in Class 20: Pillows, air pillows, not for medical purposes; Mattresses, bed-bases; Bedding, except linen; Sleeping bags for camping;

Class 22: Padding and stuffing fibres and materials, natural or synthetic (except of *rubber* or plastics); Textile fibres, fibres for textile purposes, raw fibrous textile; Bedding, namely eiderdowns and in particular American eiderdowns; Feathers, down, wool and stuffing materials (except of rubber or plastics) for bedding; Flock (stuffing);

Class 24: Sleeping bags (sheeting) for adults; Eiderdowns (down coverlets), bed covers, comfort blankets, quilts, wool blankets and in general, bed blankets; Plastic material (substitute for fabrics); Pillow shams and covers for cushions; Sheets, cases and, more generally, bed linen; Household linen for adults;

and Class 25: Dressing gowns, pyjamas, nightshirts and robes for adults.

By a decision, the examiner rejected the registration of the mark on the basis of Article 7(1)(b) and (2) CTMR. She added that for bedding goods and clothes like pyjamas, there is a direct link between the word 'DOUCEUR' (softness) and sleep. The public will perceive the expression as a laudatory promotional message, not as sign of origin.

The applicant filed an appeal against this decision and put forward the following arguments:

The association and interaction of the two autonomous elements 'DODO', that the Office has already accepted as a trade mark, and 'TOUTE LA DOUCEUR DU MONDE', which is distinctive in itself, convey to the mark a higher degree of distinctive character. The combination of these two concepts softness and sleep is not usual on the market.

The Board found the appeal admissible and well founded, because the expression 'DODO TOUTE LA DOUCEUR DU MONDE', considered as a whole, in relation to the goods applied for in Classes 20, 22, 24 and 25 enjoys a minimum distinctive character, whether the word 'DODO' is understood as a word usually addressed to children indicating sleep or as the applicant's trade mark, as it states.

**Decision of the Second Board of Appeal of 3 May 2013 in Case R 878/2011-2 - IBF (Fig. Mark) / EBF - EN**

The applicant sought to register the figurative mark



The opponent filed an opposition based on earlier Spanish trade mark registration No 1 813 861 of the word mark 'EBF' for goods in:

Class 6 – Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; metal ores.

The opponent directed its opposition against part of the goods and services covered by the mark applied for, namely those in Class 6. The opponent invoked Article 8(1)(b) CTMR.

Following a limitation of the list of goods by the applicant during the course of the opposition proceedings, the contested goods are the following:

Class 6 – High thickness pipes, seamless high thickness pipes, joints, seamless joints, manifolds, all for nuclear, oil and gas plants.

The Opposition Division upheld the opposition for all the contested goods.

The Opposition Division considered that since the opponent's mark is registered for the class heading in Class 6, it is deemed to cover all goods that are to be classified in this class (see Communication of the President No 4/03 of 16 June 2003). It follows that the contested goods are identical to those covered by the earlier trade mark. Concerning the signs in conflict it stated that the visual and aural dissimilarities between the signs are not enough to counteract the visual and aural similarities. The signs in dispute both consist of three letters; both are, consequently, very short marks. However, the only different letter is a phonetically similar letter. Consequently, the fact that they coincide in two letters and that the other one is phonetically similar is a relevant factor to consider when evaluating the similarity between the signs: the signs are considered to be similar overall. Therefore, there is a likelihood of confusion for all the contested goods. The applicant filed a notice of appeal. The Board confirmed the Opposition Division's findings.

#### **Decision of the Fourth Board of Appeal of 16 May 2013 in Case R 850/2012-4 - D26 / D2 - EN**

The applicant sought to register the word mark 'D26' as a Community trade mark for the following goods:

Class 9 – Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; mobile telephone accessories; eyewear; sunglasses; goggles; swimming goggles; protective clothing; visors;

Class 14 – Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments;

Class 18 – Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; luggage; beach bags; beach umbrellas and parasols;

Class 25 – Clothing, footwear, headgear;

Class 28 – Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

The opponent filed a notice of opposition, based on:

- a) Community trade mark application No 8 651 382 for the word mark 'D2' for goods in Classes 3, 9, 14, 18 and 25;
- b) Benelux trade mark No 889 201 for the word mark 'D2' registered for goods and services in Classes 3, 9, 14, 18, 25 and 35.

The grounds for opposition were those laid down in Article 8(1)(b) CTMR. It was directed against all the goods of the application and based on all the goods and services of the earlier rights.

The Opposition Division rejected the opposition in its entirety.

The opponent filed a notice of appeal.

The Board found, in agreement with the Opposition Division, that the goods are partly identical and partly similar. Visually, all the marks are word marks. The contested mark consists of the capital letter 'D' followed by the number '26' whereas the earlier marks are composed of the capital letter 'D' followed by the numeral '2', either in superscript (earlier Community trade mark application) or in standard form (earlier Benelux mark). The signs coincide in the letter 'D' and differ in the numbers juxtaposed to it. However, the coincidence in the first letter is not enough to render such short marks visually similar. In short signs the public easily perceives all the individual elements and is less likely to overlook any differences. The numerals '26', '2' and '2', although all comprise the numeral '2', are different. In addition, the single letter 'D', which is found in all the marks, possesses little inherent distinctive character. Such a weak element has to be given relatively less weight. The same applies to numerals. Numerals as such are in themselves also not considered distinctive. This leads to the finding that the marks owe their distinctiveness exclusively to the particular way and manner of combining the letters and numbers. Taking into account that the marks are very short, the average consumer will easily grasp the differences in the numbers. The overall visual impression produced by the signs is different.

The signs are visually dissimilar.

Aurally, the signs are likewise dissimilar. The relevant public in the European Union and in the Benelux will pronounce the contested mark, according to the respective rules of pronunciation, as, for instance, [d twenty six / vingt six / sechszwanzig / zesentwintig] vs., in case of the earlier Community trade mark application, for instance [d squared, carré, Quadrat / kwadraat] and, in case of the earlier Benelux mark [d deux, twee]. Despite the fact that the marks coincide aurally in the sound of the letter [d] which is of comparatively less importance for the overall impression due to its weak distinctiveness, the differences between the second element [twenty six / vingt six / sechszwanzig / zesentwintig] and [squared, carré, Quadrat / kwadraat] or [deux, twee] will be easily perceived by the relevant public. It is very unlikely that the numeral part of the contested mark will be split into two numerals [2] and [6]. Rather it will be perceived as the number [26]. The aural comparison thus leads to dissimilarity as well.

Conceptually, the comparison remains neutral. In conclusion, the conflicting marks are dissimilar. There is no likelihood of confusion