



10 years Community Design Conference

After months of painstaking preparations and organisation, the long-awaited tenth birthday celebrations of the Community design system are just around the corner, as Alicante gets ready to host the biggest EU design event of the year.

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Interview



This month, James Nurton interviews Ortrun Günzel of Taylor Wessing in Munich about European trade mark reforms, changes to unfair competition law in Germany and the importance of geographical indications.

What is your background?

I studied at Regensburg and Münster universities... [Page 2](#)

Community Trade Mark

CTM

- Analysis of Third Party Observations (Article 40 CTMR) [Page 4](#)
- Judgment of 21 February 2013 in Case C-561/11-1 [Page 7](#)

Registered Community Design

RCD

- Recent decisions of the Boards of Appeal in *ex parte* RCD proceedings [Page 9](#)

EUTMDN Updates

- Estonian harmonisation [Page 11](#)
- Euroclass becomes TMClass [Page 11](#)
- Final working group meetings on enforcement projects [Page 12](#)
- Greek harmonisation [Page 12](#)
- Liaison meeting [Page 12](#)
- National Office contacts meet at OHIM [Page 12](#)

More News



- IP China 2013 [Page 12](#)
- Judges' Seminar at OHIM [Page 13](#)
- New mediation forms published [Page 13](#)
- OHIM cooperation with African IP Offices [Page 13](#)
- OHIM signs MoU with Norway [Page 13](#)
- User satisfaction survey 2012 [Page 14](#)
- VIRK seminar in Gothenburg [Page 14](#)
- Monthly statistical highlights February 2013 [Page 14](#)

Case law



- Luxembourg trade mark and design news [Page 15](#)
- New decisions from the Boards of Appeal [Page 29](#)

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10 years Community Design Conference

After months of painstaking preparations and organisation, the long-awaited tenth birthday celebrations of the Community design system are just around the corner, as Alicante gets ready to host the biggest EU design event of the year.

The popularity of the registered Community design is evident for all to see, given the large numbers of companies and designers across the world that have opted for this route as a way of protecting their design IP rights.

And this tenth anniversary event has proved to be highly popular as a fitting way of recognising the important role that Community designs have played in EU IP protection over the past decade, as the conference attendance figures testify.

In addition to the **fifty-five speakers** lined up for the two-day event to date, over **six hundred attendees** from across a broad spectrum of the design world have confirmed their participation.

In line with OHIM's established policy of close cooperation with its partners across the EU and beyond, **sixteen of the European Union's industrial property offices** will be represented at the April conference.

From the academic world, **six national universities** and **two design schools** from the province of Alicante will be represented, while OHIM itself is sending **75 IP experts** from its staff. In addition, more than **190 students** from the IP and design fields are also registered to attend.

The legal community will also be well represented, with top-level judges, including from the Spanish Community trade mark court, taking part in the panel discussions and breakout sessions.

There will be no shortage of institutional representation, with OHIM's founding Vice Presidents, Alberto Casado and Alexander von Mühlendahl, and three members of the European Parliament already confirmed as participants.

The Spanish government will be represented by José Manuel Soria from the Ministry of Industry, Energy and Tourism and Enrique Hernández Bento, Under-Secretary for Industry, Energy and Tourism, both of whom will give presentations on the morning of the first day.

Under the co-chairmanship of IP specialist David Stone from Simmons and Simmons (UK) and José Manuel Otero Lastres, Professor of Commercial Law at the University of Alcalá de Henares, participants will be able to attend plenary sessions on issues such as design case law, filing practice and enforcement, with top-level keynote speakers from the fields of industrial design joined by in-house specialists from OHIM itself.

The more general plenary sessions will be complemented over the course of the two days by more specific breakout sessions on a wide array of topics, from fashion and urban design, to the use of design in the world of gastronomy and technology.

With six hundred plus already bound for Alicante's sunny shores next month, the event promises to be the perfect event for IP and design specialists, academic and legal communities, so check out how you can register on the conference website at <http://www.10yearscommunitydesign.oami.europa.eu/>.

Interview



The James Nurton Interview

This month, James Nurton interviews Ortrun Günzel of Taylor Wessing in Munich about European trade mark reforms, changes to unfair competition law in Germany and the importance of geographical indications.

What is your background?

I studied at Regensburg and Münster universities and then in Belgium at Liège for one semester. My legal training continued in Regensburg and Berlin where I worked for an IP boutique.

At university there weren't any classes for IP but I was very interested in the area. I also studied history of art because I was interested in art and music, and that's how I came to IP. I wasn't interested in trade marks to begin with and my first real job was with an IP boutique in Berlin, which was really one person, and he had clients in the music business, which I found very interesting.

But half a year later the music business in Germany had a crisis and I then worked for some other IP boutiques to specialise in trade marks, unfair competition, copyright and a bit of patents. Trade marks became a bigger and bigger part of my daily work and I joined the trade mark team at Hoffmann Eitle in 2005. In January this year I joined Taylor Wessing.

Here in Munich we have five trade mark practitioners, so it is comparable in size to the department I left. We are 23 attorneys in the trade marks and designs group at Taylor Wessing Germany, nine of us partners.

What kinds of work do you do now?

The range of work we do involves all aspects such as clearance, portfolio management, licensing, litigation, Customs procedures, domain disputes, cases relating to e-commerce and social media and unfair competition issues.

It's a one-stop service. You get to know clients very well through doing prosecution work, and have a strong bond and know what they want. That's very good when it comes to enforcing the marks – and vice versa. When you enforce the marks, you know what is missing. I think clients appreciate that. Nowadays I think it is important not to be just a filing agency to give the client value for their money.

We have a mix of clients – German national clients, international direct clients and referrals from colleagues in other jurisdictions, which I think is important and helpful.

What do you think of OHIM?

I think it runs smoothly and it's important to have the CTM and RCD systems – the RCD is especially important as no one really files nationally, at least in Germany. It's a very attractive instrument: 10 years ago people in Germany didn't think about filing design applications but now the RCD is really sexy. If you sue an infringer, he has to spend a lot of money on searches for prior art so that is very powerful.

The CTM saves a lot of money for clients, and it shows how Europe is growing together. In Germany we think of our own system as well developed and sophisticated, but sometimes the decisions on Community marks are a drawback. That makes it difficult sometimes, but on the whole I think the harmonisation is important.

OHIM has the problem that the examiners rotate so often and there might be more expertise if they stayed longer. The General Court would also be better if they had a specialised chamber, though that seems unlikely to happen now.

What do you think of the draft proposals from the European Commission on trade mark reform?

Some of the changes proposed in the draft are very positive from a German point of view. For example the *Celine* decision said that use as a company name does not infringe a trade mark right, except in specific circumstances, and I'm pleased to see in the draft that use of a trade name is now expressly mentioned as an activity the trade mark owner is entitled to prevent. It also says the own-name defence should only apply to personal names, which makes sense.

I look forward to the introduction of the certification mark at the European level, and I think it would be good if it was mandatory for national trade marks laws as well. I also think the intended changes to Customs procedures help trade mark owners deal with alleged private imports and the reversing of the burden of proof for goods in transit is also welcome.

What about the suggestions regarding the pricing of CTMs?

I don't think it will have much impact to be honest. Often enough you just need more than one class. When I advise my clients now, I don't say "let's use all three classes" I say "what are your plans for the next five years?"

Getting rid of the optional search reports is good – I never recommended it because they were so poor. It's a good idea just to cut it. And the changes to national practices will streamline European practice, which is good.

Are there any major changes happening in Germany?

In terms of law, in unfair competition matters there is some draft legislation that aims to restrict the venue to the place of the domicile of the infringer. Until now you could choose the venue and so there were specialised courts with lots of expertise, and you could choose the best one.

That will be a tremendous loss of expertise and the quality of judgments in unfair competition cases will drop tremendously. I don't know why the Ministry is doing this. They said they wanted to restrict abuse for unfair advertising on the internet, but practitioners said this abuse is minimal.

It's not the first time they have cut back IP owner's powers. For example, the amount you could claim for copyright infringement after a warning letter was cut to a very small amount, and it's less than your legal fees would be. It seems to be part of the thinking that internet users are not liable because they are poor students, or kids, and IP owners are mean people! That's quite a popular feeling at the moment.

But it makes the outcome of proceedings unpredictable. We have over 100 regional courts in Germany and until now only five or six specialised in unfair competition. There are a lot of cases brought over unfair advertising, lookalikes and knock-offs. Who knows – next time it could be trade marks?

What was the first trade mark you worked on?

I can't really recall but it was for a record label in Berlin. I had to deal with a refusal on absolute grounds and I remember citing an earlier case called Yes. Nowadays I guess you wouldn't get Yes registered.

What has been the most unusual?

I handled a geographical indication case where we opposed an application for Münchner Weisswurst (Munich white sausage), arguing that it is a generic term for breakfast sausage. The former director of the DPMA set up a booth in the court together with the applicant and spoke to the papers so it became a bit political.

The applicant was a Munich-based butcher that created an association, though they were the only ones selling the sausages on their shelves. All the other producers were not in the territorial area so he would have had a monopoly. I was acting for another producer, and there were five opponents in total, including butchers' associations.

In the end we won. I believed we were right because I knew the name from my studies as everyone ate the sausages for breakfast at university! In the villages they are eaten even more than in Munich.

It was a lot of work and that got me interested in GIs – and I am now a member of the MARQUES GI Team. We are planning a workshop at the next MARQUES conference on showing trade mark owners what can happen if you don't search for GIs and to show how you can search for them – we are conducting a survey among search providers now.

I advise a lot of clients in the food sector so it's always good to have some know-how, and at Taylor Wessing the pharma/life sciences and food team are on my floor so I can work with them.

Where do you see trade mark practice going in the future?

So much has changed in the last 10 years and it is going faster and faster. It depends on the technical development, and we have to have legal instruments to keep up with the technical developments and the growth of piracy.

Community Trade Mark

CTM

Analysis of Third Party Observations (Article 40 CTMR)

Third party observations ('TPO') are a facility available to the general public for informing OHIM that a Community trade mark application ('CTMA') should be refused on the basis of a specific absolute ground for refusal. Its legal basis lies in Article 40 of Council Regulation (EC) No 207/2009 of 26/02/2009 on the Community trade mark ('CTMR') and Communication of the President No 02/09, which gives details of the procedure to follow. After receiving a third party observation, OHIM considers whether the examination of the corresponding CTMA should be reopened.

The Office considers that TPOs represent a valuable 'cooperation' tool for users (including associations) and OHIM. Given the sheer workload and OHIM's ambitious goal of increasing its timeliness standards while maintaining the high quality expected when it comes to the examination of CTMAs, it must be acknowledged that focused TPOs contribute to improving the performance of the whole system.

In order to identify trends and examine areas for improvement in TPO practice, data regarding TPOs received by the Office has been collected since 2008 by manually extracting it from CTM files and entering it into a comprehensive spread sheet. However, this data has never been presented to the public.

In that regard, the Office has prepared this article, which presents data, figures and results for the TPOs received.

Comparison of TPO statistics with general CTM statistics

The data reveals a steady increase in the numbers of CTMAs and TPO filings, with an especially sharp increase in the number of TPOs filed between 2010 and 2011, followed by a decrease in 2012 (please see Table 1).

<u>Year</u>	<u>CTMAs</u>	<u>TPOs</u>	<u>%¹</u>
2008	88 359	113	0.13
2009	88 271	117	0.13
2010	98 331	186	0.19
2011	105 897	249	0.24
2012	107 925	200	0.19

Table 1

However, it should be observed that the number of TPOs is relatively small compared with the number of CTMAs filed. This would suggest that the *ex officio* examination carried out by the Office meets expectations as a higher rate of TPOs would show that the *ex officio* examination was insufficient.

Overview of TPO trends for all TPOs

The proportion of TPOs resulting in a reopened examination (see Table 2) increased slowly from 19% to 26% between 2008 and 2011. In 2012 there was then a rapid increase as 31% of TPOs filed that year resulted in a reopened examination. On the other hand, the number of TPOs filed that year decreased.

<u>Year</u>	<u>TPOs</u>	<u>Number of TPOs resulting in a reopened examination</u>	<u>% of TPOs resulting in a reopened examination</u>
2008	113	22	19%
2009	117	26	22%
2010	186	40	22%
2011	249	65	26%
2012	200	62	31%

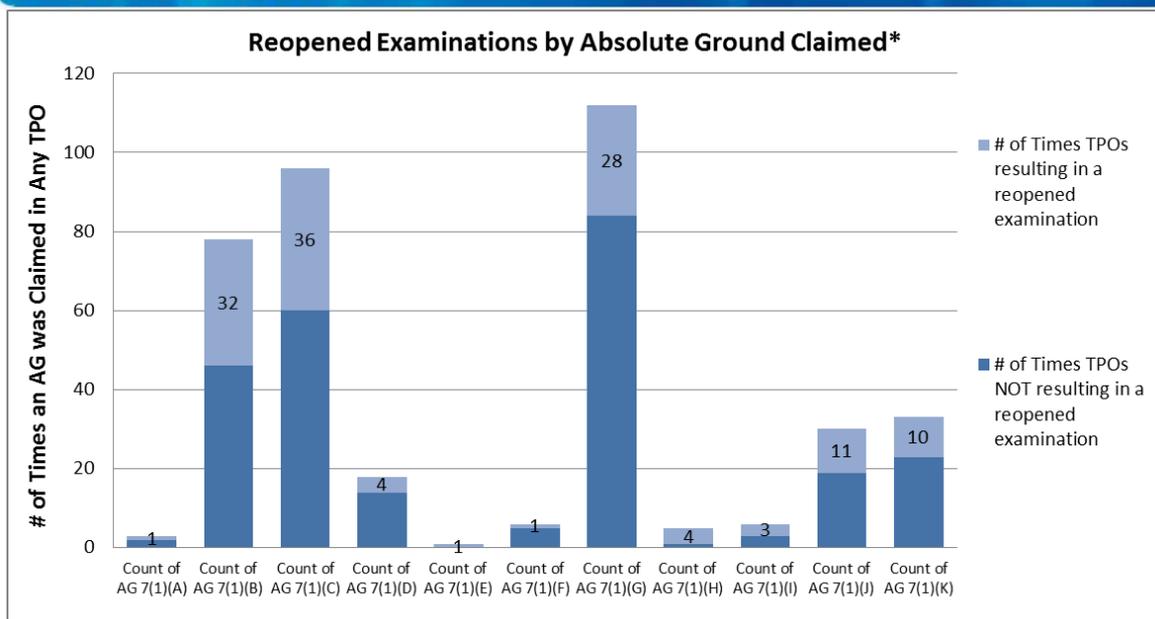
Table 2

A decrease in the absolute number of TPOs filed, combined with an increase in the percentage of those resulting in the reopening of the examination, seems to suggest that TPOs have become more focused over that period.

AG most often resulting in re-examination, for all TPOs filed in 2012

Graph 1 presents all cases in which a specific AG was claimed in a TPO, regardless of whether other AGs were also claimed in that TPO. This graph shows that the AGs most often claimed in TPO filings have been for Article 7(1)(b), 7(1)(c), and 7(1)(g) CTMR.

¹ The percentage is calculated on the basis of the number of TPOs and CTMAs.



Graph 1

*Each column represents the number of times a particular AG was claimed in a TPO; the upper, light blue section represents the number of TPOs which resulted in a reopened examination.

In order to analyse the general trends of which grounds claimed have most frequently led to the reopening of a case, Table 3 indicates the figures for AG that have led to the reopening of the examination, as well as the figures for TPOs resulting in a reopened examination on the same AG claimed.

<u>AG claimed²</u>	<u>% of TPOs resulting in a reopened examination</u>	<u>% of TPOs resulting in a reopened examination on the same AG claimed</u>
7(1)(b) – claimed 78 times	41%	97%
7(1)(c) – claimed 96 times	38%	89%
7(1)(j) – claimed 30 times	37%	91%
7(1)(k) – claimed 33 times	30%	60%
7(1)(g) – claimed 112 times	25%	21%

Table 3

The third column, therefore, shows the ‘success’ rate or focus rate in the sense that when AGs in respect of Article 7(1)(b), (c), (j) and/or (k) were claimed in a TPO, and the Office considered that re-examination was necessary, such re-examination was done on the basis of that same ground. By contrast, it can be seen that TPOs based on Article 7(1)(g), although claimed in a greater number of cases, were used as the basis for re-examination only in 21% of those that were reopened.

This can also be interpreted as indicating a higher likelihood of success as far as Article 7(1)(b), (c), (j) and (k) are concerned since, in most of the cases where the examination was reopened, it was on the basis of that same AG, and a lower likelihood of success as regards Article 7(1)(g) since, although users ask for the examination to be reopened on this basis, the Office does so in only 21% of the cases.

However, the fact that the Office decided, following TPOs raised, to reopen examination on the basis of this ground in only 21% of all reopened cases does not necessarily reflect a lower likelihood of ‘success’, but rather shows that the public’s understanding of ‘misleading’ or ‘deceptive’ is substantially broader than the corresponding concepts applied by the Office, which are much more focused and ‘technical’. The recent revision of the Manual in this respect should contribute to increased awareness, on the part of both examiners and users of the system, of how OHIM should apply this ground of refusal.

² It should be remembered that a single TPO might address various AGs.

The fact that the cases where examination was reopened following the receipt of TPOs increased over time in certain categories of grounds (e.g. Article 7(1)(b) and (c)) confirms the need to focus even more on training and guidelines for examiners, providing them with comprehensive tools to facilitate their task. To this end, the Office is now proceeding with Manual revisions and corresponding training sessions, as well as constantly updating in the light of case-law as it evolves, precisely with the aim of improving the quality of trade mark examination.

Knowledge Circle “Absolute Grounds”

Judgment of 21 February 2013 in Case C-561/11-1

Fédération Cynologique internationale v/ Federación Canina Internacional de Perros de Pura Raza

1. Parties to the case

The Fédération Cynologique internationale (the applicant, FCI) is an international association owner of CTM No 4 438 751 registered in 2006 for the following figurative sign:



The CTM is registered for services in Classes 35, 41, 42 and 44.

The Federación Canina Internacional de Perros de Pura Raza (FCIPPR) is the proprietor of many Spanish trade marks registered in 2005, 2008 and 2010 for the following figurative sign:



The Spanish trade marks are registered for goods in Class 16 and services in Classes 41 and 44.

2. Facts

On 18 June 2010, FCI filed proceedings against FCIPPR before the Juzgado de lo Mercantil n° 1 de Alicante y n° 1 de Marca Comunitaria (Commercial Court No 1 of Alicante and Community Trade Mark Court No 1) (Spain) comprising two actions:

- an action for infringement of Community trade mark No 4 438 751, held by FCI, and
- an application for a declaration of invalidity of national trade marks No 2 614 806, No 2 786 697 and No 2 818 217, held by FCIPPR, on the ground, inter alia, that those marks give rise to a likelihood of confusion with Community trade mark No 4 438 751, held by FCI.

FCIPPR denied that there was any likelihood of confusion between the signs which it uses and Community trade mark No 4 438 751 held by FCI, and, by way of a counterclaim, sought a declaration that the Community trade mark was invalid on the ground that it had been registered in bad faith and that it gave rise to confusion with earlier national trade mark, No 2 614 806.

The Juzgado de lo Mercantil n° 1 de Alicante y n° 1 de Marca Comunitaria takes the view that the dispute in the main proceedings raises the question as to whether the exclusive right which Article 9(1) CTMR confers on the proprietor of a Community trade mark, in this case FCI, may be enforced against a third party which is the proprietor of a subsequently registered Community trade mark, in this case FCIPPR, as long as the latter trade mark has not been declared invalid.

In those circumstances, the Juzgado de lo Mercantil n° 1 de Alicante y n° 1 de Marca Comunitaria decided to stay the proceedings and to refer to the Court the following question for a preliminary ruling.

3. The questions asked

'In proceedings for infringement of the exclusive right conferred by a Community trade mark, does the right to prevent the use thereof by third parties in the course of trade provided for in Article 9(1) of [the Regulation] extend to any third party who uses a sign that involves a likelihood of confusion (because it is similar to the Community trade mark and the services or goods are similar) or, on the contrary, is the third party who uses that sign (capable of being confused) which has been registered in his name as a Community trade mark excluded until such time as that subsequent trade mark registration has been declared invalid?'

By its question, the national court is asking, essentially, whether Article 9(1) CTMR must be interpreted as meaning that the exclusive right of the proprietor of a Community trade mark to prevent all third parties from using, in the course of trade, signs identical with or similar to its trade mark extends to a third-party proprietor of a later Community trade mark without the need for that latter mark to have been declared invalid beforehand.

4. Findings of the Court

The ECJ notes that Article 9(1) CTMR does not make any distinction on the basis of whether the third party is the proprietor of a Community trade mark or not. Thus, that provision grants the proprietor of a Community trade mark an exclusive right to prevent 'any third party' not having its consent from using, in the course of trade, any signs liable to infringe its mark (see, by analogy, the judgment of 16 February 2012 in Case C-488/10 'Celaya Empananza y Galdos Internacional' [2012] ECR I-0000, paragraphs 33 and 34).

The Court gave consideration to Article 54 CTMR and, interpreting this provision, held that, before the limitation in consequence of acquiescence takes effect, the proprietor of a Community trade mark is entitled both to apply to OHIM for a declaration of invalidity of the later Community trade mark and to oppose its use through infringement proceedings before a Community trade mark court.

Finally, the Court notes that neither Article 12 CTMR, relating to the limitation of the effects of a Community trade mark, nor any of the other provisions of the CTMR provides for an express limitation of the exclusive right of the proprietor of a Community trade mark in favour of the third-party proprietor of a later Community trade mark.

The answer to the question raised by the Spanish CTM court is therefore that it is apparent from the wording and the general approach of Article 9(1) of the Regulation that the proprietor of a Community trade mark must be able to prevent the proprietor of a later Community trade mark from using that latter trade mark.

The Court points out that it has already held, in the context of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1), that actions alleging infringement and actions for a declaration of invalidity are distinguished in terms of their object and effects, with the result that the fact that it is possible for the holder of an earlier registered Community design to bring infringement proceedings against the holder of a later registered Community design cannot render the bringing of an application for a declaration of invalidity against the latter before OHIM devoid of all purpose ('Celaya Emperanza y Galdos Internacional', paragraph 50).

For these reasons the Court held that the answer to the question referred is that **Article 9(1) CTMR must be interpreted as meaning that the exclusive right of the proprietor of a Community trade mark to prohibit all third parties from using, in the course of trade, signs identical with or similar to its trade mark extends to a third-party proprietor of a later registered Community trade mark, without the need for that latter mark to have been declared invalid beforehand.**

5. Comments

Together with the 'Celaya Emperanza y Galdos Internacional' judgment on RCDs, the Court has now given an interpretation of Article 9 that is the complete opposite of that given by the Tribunal Supremo Español, who, based on the theory of 'inmunidad registral', held for many years that it was enough to enjoy registration of a CTM to avoid being attacked in a counterfeiting action. The proprietor of an earlier CTM was obliged under this jurisprudence first to apply to the Office for cancellation of the CTM. The Tribunal Supremo will have to change its interpretation of the CTMR following this clear judgment.

Knowledge Circle "Enforcement"

Registered Community Design RCD

Recent decisions of the Boards of Appeal in *ex parte* RCD proceedings

Two recent decisions of the Third Board of Appeal of the Office concern issues regarding communications between the Office and the applicant (or his/her representative) and their implications on the grant of a filing date.

Decision of the Third Board of Appeal of 16 January 2013 in Case R 0732/2012-3 (unpublished)

This case relates to a design that was refused and therefore the decision is not published. No identifying details are included here in order to preserve the confidentiality of the particulars of the case.

By a Community design application, the applicant sought to register a design. The applicant claimed priority.

The Office sent an examination report by fax to the applicant in which the following was mentioned:

"...The representation of the design is deficient because it does not conform to the provisions set out in Article 4(1)(c) CDIR as it contains explanatory text which are clearly not part of the design ... These deficiencies should be remedied on or before ... If the deficiencies are not remedied within this time limit, the application will be refused."

and

"...The application did not include documents supporting the priority claim ..."

Later, the applicant filed documents supporting the priority claim.

After the expiry of the time limit, the Office issued a decision rejecting the Community design. On the same date the applicant's representative contacted the examiner and explained that they had never received the deficiency letter.

The next day the examiner confirmed that, according to the fax report of the Office, the deficiency letter was sent. The applicant filed an appeal against the contested decision.

In the present case, the applicant neither questioned that the Office was entitled to transmit the communication by fax (see, in this respect, judgment of 18 October 2011, T-53/10, 'Stapelkisten', paragraph 61 and the case-law cited therein) nor disputed that it had not remedied the deficiency.

The applicant claimed that it did not receive the Office fax communication of 19 December 2011 and argued that the Office was unable to prove, in positive terms, receipt thereof.

According to the case-law in CTM matters, a fax report may suffice to establish that a fax has been sent. Where that is the case, the obligation is on the receiver to rebut by means of evidence that it has not received it (see judgment of 19 April 2005 in Joined Cases T-380/02 and T-128/03, 'Pan & Co'). The existence of 'elements such as to cast a reasonable doubt on the receipt' may however suffice to challenge this presumption (see, in the context of CTM proceedings, judgment of 25 October 2012, T-191/11, *Automobili Lamborghini Holding SpA / OHIM*, (MIURA / MIURA), paragraph 28-37).

A party cannot be asked to submit proof of a negative fact, such as the absence of receipt of documents, given that the defect in the notification can originate from the Office itself. However, having regard to the fax transmission report, the Board of Appeal considered that the mere submission of the priority documents without the corrected representation of the design was not, in itself, sufficient evidence that the Office's communication had not been received. The appeal was therefore dismissed.

The Board of Appeal observed that the applicant's representative did not file a request for '*restitutio in integrum*' in accordance with Article 67 CDR. Therefore, the Board found that it did not have to assess whether, in spite of all due diligence, the applicant's representative had committed an excusable error or if unforeseeable events had occurred.

Decision of the Third Board of Appeal of 9 November 2012 in Case R 0461/2012-3

The representation of the design must be of a quality permitting all the details of the matter for which protection is sought to be clearly distinguished and permitting it to be reduced or enlarged to a size no greater than 8 cm by 16 cm per view for entry in the Register of Community Designs and for publication in the Community Designs Bulletin (Article 4(1)(e) CDIR).

The purpose of that requirement is to allow third parties to determine with accuracy all the details of the Community design for which protection is sought. This requirement applies equally to all applications, irrespective of the means of filing.

Applications sent by fax and e-filing, however, raise specific issues. Transmission by telecopy (fax) may not be appropriate for filing design applications, because the representation of the design may be distorted, blurred or otherwise damaged. Where an application is transmitted by fax, it is highly recommended that a paper confirmation copy be filed without delay, either by regular mail or private delivery service or by personal delivery.

Where the reproduction of a design as transmitted by fax is not of a quality permitting all details of the matter for which protection is sought to be clearly distinguished, the original date of filing will be retained if the applicant sends of its own motion or in reply to the Office's informal communication the original reproduction of the design within **one month** following the fax transmission, provided its quality permits all details of the matter for which protection is sought to be clearly distinguished (Article 66(1), second paragraph, CDIR).

On the facts of the case, the examiner informed the applicant that its application was received by fax on 3 August 2011, but that the faxed reproduction of the design was of insufficient quality. Consequently, the applicant was informed that, if a confirmation copy of the application showing a reproduction suitable for registration was not received within one month, this would affect the filing date.

The applicant claimed that on the same day that the application was sent by fax, it sent the application by post together with other applications. However, the original was received more than one month after the date of submission of the fax.

The date of filing was therefore determined by the date of receipt of the original, that is 8 November 2011. The Board of Appeal also noted that the Office had no obligation to inform the applicant of whether a confirmation copy of the application had been received or not, bearing in mind that the submission of a confirmation copy is not mandatory:

“(25) The Board notes that in order for the applicant to be granted the date of filing of the faxes of 23 August 2011 as the official filing date of the application, the confirmation copies should have reached the Office by 23 September 2011. As correctly noted by the Office, it has no obligation to immediately inform the client whether a confirmation copy of the application has been received or not. In any case it could not even be sure of such a fact until the end of the date when the time limit ends, by which time it would be too late for the applicant to re-send the confirmation copy in order to get the original filing date anyway. Therefore also whatever communications between the applicant and the Office happened after this date are irrelevant in the sense that unless the applicant could prove, which it has not, that the Office did receive the confirmation copies within this time limit, in accordance with Article 66(1) CDIR, the Office could not grant the date of filing of the faxes of 23 August 2011 as the official filing date of the application”.

Knowledge Circle “Designs”

EUTMDN Updates

Estonian harmonisation

On 13 March 2013, the Estonian office (EPA) reached the next step in the Harmonisation project by using the completely validated Estonian translations of the English Harmonised Database as the accepted list of Goods and Services.

This greatly reinforces the creation of a new and robust European Trade Mark Network based on common practice.

Euroclass becomes TMClass

The global classification tool Euroclass has changed its name to TMclass.

The tool was developed as part of OHIM's Cooperation Fund and Convergence Programme initiatives.

The rebranding decision underlines the growing importance of TMClass as a true global IP resource, which includes access to the databases of EU national IP offices and other major IP offices, including the USPTO and Japanese Patent Office (JPO).

TMClass is an online tool based on the Nice Classification system that helps users correctly classify goods and services when filing a trade mark.

It allows users to search for terms in any of the 24 languages available.

TMClass can also be used to verify lists of terms to check if they are acceptable to any of the participating IP offices.

Additionally, the tool translates equivalent goods and services terms into all available languages.

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

Final working group meetings on enforcement projects

Final working group meetings on the two Cooperation Fund enforcement projects took place at OHIM between 18 and 22 March 2013. The two enforcement tools are being developed by the CF in conjunction with experts from the EU national offices, the World Customs Organisation and key user associations. The groups will focus on the final testing of the tools developed prior to the June go-live.

Greek harmonisation

On 15 March 2013, the Greek IP office (D.C.I.P) reached the next step in the Harmonisation project.

The Greek IP office now uses the completely validated Greek translations of the English Harmonised Database as the accepted list of Goods and Services.

Liaison meeting

The 8th Liaison meeting on Technical Cooperation took place at OHIM's Alicante headquarters on 7 and 8 March 2013.

Around 70 experts from national IP offices across the EU joined OHIM staff for a number of discussions on technical issues.

The agenda included workshops on the Common Call Centre, the Enforcement Database, the Future Software Package and the Terminology Maintenance Console.

The participants were also given progress reports on the Strategic Plan, the Cooperation Fund and the Convergence Programme, with the second day of activities dedicated to the Observatory, the Academy, International Cooperation and Quality Management.

IT issues under discussion included the new website and video conferencing facilities.

National Office contacts meet at OHIM

On 21 March 2013, Cooperation Fund contact staff from all the EU national IP offices and BOIP, along with their colleagues in finance, gathered at OHIM to discuss cooperation and bilateral agreements. Also on the agenda were the planning and maintenance of CF tools. A range of OHIM experts from different departments also participated in the meetings.

Fifty people from across the CF network spent the day discussing and giving feedback on both issues.

[More News](#)



IP China 2013

OHIM officials took part in the Intellectual Property China 2013 conference, held in London on 6 March 2013.

The event included breakout sessions and panel discussions, as well as a keynote presentation on current trends in Chinese intellectual property.

Topics under discussion included working with the Chinese courts and the enforcement of IP rights against counterfeiters.

OHIM's representatives closed the sessions with an address on the conclusion of the IPR2 programme and the future of IP Key, in a presentation entitled 'Working with the Chinese government on IP'.

Judges' Seminar at OHIM

On 14 and 15 March 2013, judges from across the European Union met at OHIM's Alicante headquarters in the March 2013 Judges' Seminar.

These regular seminars provide judges dealing with IP cases with a platform for exchanging views and opinions, and help to promote unified criteria and harmonised practices across the EU.

In this edition, the judges in attendance focused on the issue of compensation and indemnification of CTM infringements.

Other matters under discussion included how the Courts will assist IPR victims in the disclosure process and the impact of Directive 2004/48 on traditional practice.

New mediation forms published

In the Mediation section of the OHIM website, the following three new request forms have recently been published:

- Mediation agreement model
- Mediation joint request form
- Mediation in Brussels (administrative charges).

The [forms are available to download](#) in the five official languages of the Office.

OHIM cooperation with African IP Offices

On Monday, 11 March 2013, OHIM kicked off a three-day study visit for the Boards of Appeals of the French speaking African Intellectual Property Organization (OAPI) and legal experts of the Moroccan Industrial and Commercial Property Office (OMPIC).

The speakers from OHIM's Boards of Appeal, Operations Department and ICLAD covered a wide range of topics such as opposition and cancellation procedures for CTMs and RCDs, recent case-law before the BoA, including cases on retail services and geographical indications, case-law before the Court of Justice of the European Union and OHIM's knowledge circles.

Both OAPI and OMPIC presented their respective Boards of Appeal.

This activity falls under the International Cooperation work programme promoting capacity-building activities with African IP organisations (Line of Action No 6 of the Strategic Plan).

OHIM signs MoU with Norway

OHIM President António Campinos and the Director General of Norwegian Intellectual Property Office, Mr Per A. Foss, met in the premises of the European Patent Office in Munich on 21 March 2013 to sign a Memorandum of Understanding, which will see cooperation between both organisations in areas such as exchange of trade mark and design data, enforcement, and harmonisation of trade mark and design practice.

The signing of the Memorandum will facilitate the execution of one of the key initiatives of the Strategic Plan of the OHIM, namely Key Initiative 33: 'Engage in cooperation activities outside the EU'.

User Satisfaction Survey 2012

OHIM launched its User Satisfaction Survey on 19 March 2013, covering the Office's activities over the year 2012.

The survey forms part of OHIM's commitment to improving the quality of its services as perceived by users, and falls under Key Initiative 25 of the Strategic Plan.

Once again, the exercise is being conducted by QUOTA Research, a company with more than 20 years' experience in the field of market research.

Users will be sent an e-mail by QUOTA Research which will include a link to access a personal web-based questionnaire in the five languages of the Office. Questions will deal with the level of satisfaction with CTM and RCD related procedures as well as issues related to complaints, information and communication services, and the Office's image.

Results are expected to be published during the second quarter of this year.

VIRK seminar in Gothenburg

Swedish IP association VIRK, made up of private practitioners and industry representatives, held a seminar in Gothenburg on 6 March 2013.

Discussions focused on the change of practice brought about by the IP Translator decision of last year, with OHIM experts in attendance to answer any questions raised by the participants.

Of specific interest were the exact nature of protection when applying for all goods in any particular class and how previously registered trade marks will be dealt with in the light of the decision.

Monthly statistical highlights* February 2013 compared to February 2012

	2013	2012
Community trade mark applications received	9 479	9 195
Community trade mark applications published	8 213	7 891
Community trade marks registered (certificates issued)	6 201	7 620
Registered Community designs received	6 584	6 951
Registered Community designs published	5 800	6 279

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



Luxembourg Case Law

A: Court of Justice: Preliminary Rulings, Judgments and Orders

Case C-561/11; Federation Cynologique Internationale v Federacion Canina Internacional de Perros de Pura Raza; Preliminary Ruling of 21 February 2013; Language of the case: ES

Keywords: Infringement, use in the course of trade, similarity of the signs, identity of the signs

The referring court was the Juzgado de lo mercantil N° 1 de Alicante y n° 1 de Marca Comunitaira (Spain). The CJ held that Article 9(1) CTMR has to be interpreted as meaning that the exclusive right of the proprietor of a CTM to prohibit all third parties from using, in the course of trade, signs identical with or similar to its trade mark extends to a third-party proprietor of a later registered CTM, without the need for that latter mark to have been declared invalid beforehand.

FACTS: The plaintiff filed proceedings for infringement of its earlier figurative CTM 'FCI FEDERATION CYNOLOGIQUE INTERNATIONALE' and for invalidity of the defendant's marks, inter alia the defendant's later CTM. The referring court asked the CJ whether Article 9(1) CTMR must be interpreted as meaning that the exclusive right of the proprietor of a CTM (here the plaintiff) to prevent all third parties from using signs identical with or similar to its trade mark extends to a third-party proprietor of a later CTM (here the defendant) without the need for that latter mark to have been declared invalid beforehand.

SUBSTANCE: The CJ declares the question referred to it to be admissible (Paras. 26-30). With regard to the substance, it notes that Article 9(1) CTMR does not make any distinction on the basis of whether the third party is the proprietor of a CTM or not. Thus, that provision grants the proprietor of a CTM an exclusive right to prevent 'any third party', not having its consent, from using any signs liable to infringe its mark (Para. 33). The CJ also gave consideration to Article 54 CTMR, which shows that, before a limitation in consequence of acquiescence takes effect, the proprietor of a CTM is entitled both to apply to OHIM for a declaration of invalidity of the later CTM and to oppose its use through infringement proceedings before a CTM court (Paras. 34-35). Finally, the CJ notes that neither Article 12 CTMR, relating to the limitation of the effects of a CTM, nor any of its other provisions provides for an express limitation of the exclusive right of the proprietor of a CTM in favour of the third-party proprietor of a later CTM (Para. 36). It is apparent from the wording and the general approach of Article 9(1) CTMR that the proprietor of a CTM must be able to prevent the proprietor of a later CTM from using that later trade mark. The provision has to be interpreted in the light of the priority principle, under which the earlier CTM takes precedence over the later CTM (Para. 39).

The Court rejected the defendant's argument that the characteristics of the registration procedure for CTMs require that, if, at the end of this procedure, the registration of the CTM is allowed, that CTM should confer on its owner a right of use that can be called into question only by an action for invalidity before OHIM or by a counterclaim in infringement proceedings. Although the registration procedure includes a substantive examination that seeks to determine whether the CTM fulfils the requirements for protection and there is a phase in which third parties may submit written observations, as well as an opportunity for owners of earlier trademarks to oppose the registration, those circumstances are not conclusive. It is not inconceivable that a sign that is liable to infringe an earlier CTM may be registered as a CTM. Moreover, the Court's finding in the context of the CDR that actions alleging infringement and actions for a declaration of invalidity are distinguished in terms of their object and effects, with the result that it is possible for the holder of an earlier registered CD to bring infringement proceedings against the holder of a later registered CD, may be applied, *mutatis mutandis*, to the context of CTMs (Paras. 47, 48). Finally, the essential function of the trade mark, which is to guarantee to consumers the origin of the goods, needs to be preserved. The right under Article 9(1) CTMR is conferred in order to enable the trade mark proprietor to protect his specific interests as proprietor, namely to ensure that the trade mark can fulfil its function. If the proprietor of an earlier trade mark, in order to prevent the use by a third party of a sign that is liable to affect the functions of its trade mark, were required to await the declaration of invalidity of the later CTM held by that third party, the protection accorded to it by Article 9(1) CTMR would be significantly weakened (Paras. 49-51).

Case C-655/11P; Seven for all mankind LLC v OHIM; Judgment of 21 February 2013; Language of the case: ES

Keywords: Number written in letters, figurative trade mark, procedural irregularity, no bearing on judgment

RESULT: Action dismissed

FACTS: The CTM applicant sought to register the word mark 'SEVEN FOR ALL MANKIND' for goods in Classes 14 and 18 (inter alia jewellery and bags). The opponent based its opposition on the figurative CTMs 'SEVEN', shown below, as well as the international registration of the figurative mark Seven for goods in Classes 16, 18, 25, 3, 9, 12, 14, 15, 16, 20, 22, 25 and 28. The Opposition Division upheld the opposition as regards 'rucksacks' in Class 18 but rejected it for the remainder of the goods. The Board of Appeal dismissed the opponent's appeal. It considered that the signs displayed significant differences and that they were not similar overall. The number SEVEN, written in letters, possesses a very weak inherent distinctive character and the public is not used to perceiving numbers as an exclusive sign of an undertaking.

CTM applied for	Earlier CTMs and IR
SEVEN FOR ALL MANKIND	

Upon appeal from the opponent, the General Court annulled the Board's decision (T-176/10). It noted that the presence of the word 'SEVEN' in both marks is an important point of similarity that cannot be overlooked. In order to assess the inherent distinctive character of the word 'SEVEN', the Board should have carried out its analysis by reference to the goods at issue. Since the word SEVEN does not have any particular link with the goods and is not commonly used in the sector concerned, it must be regarded as possessing an average degree of distinctiveness in relation to these goods. The GC considered the signs to be visually similar and found also some phonetic and conceptual similarity. The Board had made an error of assessment in not recognising that there was a certain degree of similarity between the signs.

SUBSTANCE: The CTM applicant alleged a breach of procedure, since the GC ignored a search in trade mark registers showing that there are numerous marks containing the word 'SEVEN' or the numeral 7. The CJ found that the alleged procedural irregularity, even if it had been proven, could not lead to the setting aside of the judgment under appeal, as it is not established that, in its absence, the GC might have reached a different conclusion. The GC did not commit an error in law, as it conducted a thorough and comprehensive examination of the sign for which registration is sought. The reasoning of the GC on the conceptual and phonetic similarities between the marks at issue is not vitiated by a contradiction.

Case C-266/12P; Jaroslaw Majczak v OHIM; Order of 7 February 2013; Language of the case: EN

Keywords: Order, admissibility, clarity of party submission, matters of fact appealed to CJ, new evidence, first time on appeal

RESULT: Action dismissed

FACTS: The Cancellation Division dismissed an application for a declaration of invalidity based on Article 52(1)(b) CTMR: The Taiwanese cancellation applicant claimed that the CTM proprietor applied for the CTM in bad faith in respect of 'zippers'. The cancellation applicant manufactured zippers for the CTM proprietor, who distributed them in Poland. It claimed that the CTM proprietor was aware that the cancellation applicant was already using the sign "FS" in its business paper, and as a trade name and a trade mark in Taiwan. Once the business relations between the parties stopped, the CTM was applied for and the CTM proprietor seized a shipment of zippers originating from Taiwan and bearing the cancellation applicant's acronym.

CTM applied for (Class 26)	Earlier Mark (Class 26)
	

The Board of Appeal dismissed the appeal based on six considerations set out below. First, the earlier Taiwanese marks and the contested mark are not similar on the visual level and the cancellation applicant had not proved that it had used the earlier Taiwanese marks before the filing date of the contested CTM. Second, the cancellation applicant merely manufactured zip fasteners for the CTM proprietor, in accordance with specifications provided by the CTM proprietor. Third, the CTM proprietor had started to market zip fasteners himself under the sign corresponding to the contested CTM in Poland in 2000. Fourth, the cancellation applicant had not shown that it had attempted to market zip fasteners itself in the European Union during the period between 2000 and 2005. Fifth, the cancellation applicant had not shown any interest in protecting a sign comprising the group of capital letters 'FS' in the European Union before the filing date of the CTM. Sixth, the CTM proprietor was not, as a matter of law, required to inform the cancellation applicant beforehand of his intention to apply for registration of the CTM. On that basis, the Board found, that the CTM proprietor had not acted in bad faith when filing the application.

The GC annulled the Board's decision by judgment in Case T-227/09. It held, in essence, that the decision of the Board was not supported by valid factual findings. The GC found that four of the six considerations referred to above were either based on incorrect factual findings or not substantiated by evidence in the file. The GC added that the remaining two considerations (that is, whether the cancellation applicant had shown any interest in protecting a sign comprising the group of capital letters 'FS' in the European Union before the filing date of the contested CTM and whether the CTM proprietor was required to inform the cancellation applicant beforehand of his intention to apply for registration of the contested CTM) would be incapable, standing alone, of supporting a conclusion as to whether the CTM holder had acted in bad faith.

SUBSTANCE: The CJ dismissed the CTM proprietors appeal as partly manifestly inadmissible and partly manifestly unfounded. It found that the appeal was based on arguments which were incoherent, vague or unspecific in respect of which parts of the GC's judgment were challenged (Paras. 25 to 29). The CJ also found that the appeal was based on arguments which aim at challenging the factual assessment carried out by the GC. These arguments are inadmissible, since Article 256 TFEU and Article 58 of the Statute of the Court of Justice limit appeals before the CJ to points of law (Paras. 31 to 39). Finally, the claim that the GC had failed to give a ruling on all the facts of the case is unfounded given that the CTM proprietor refers to documents which were submitted for the first time before the GC and are therefore inadmissible (Paras. 44 to 45).

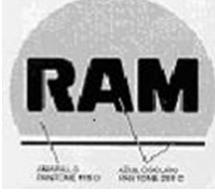
B: General Court: Judgments on appeals against decisions of the OHIM

Case T-237/11; Lidl Stiftung & Co. KG v OHIM; Judgment of 15 January 2013; Language of the case: EN

Keywords: Right to be heard, examination of facts ex officio, principle of functional continuity, similarity of the signs, visual similarity, phonetic similarity, ending of mark, similarity of the goods and services

RESULT: Action dismissed

FACTS: The CTM applicant sought to register the word mark '**BELLRAM**' as a CTM for goods and services within Class 29. An opposition based on, among others, the earlier marks '**RAM**' shown below, registered for goods in Class 29, was filed on the grounds of Article 8(1)(b) CTMR. The Opposition Division upheld the opposition on the basis of the earlier figurative mark. The Board of Appeal dismissed the CTM applicant's appeal. It found that the earlier figurative mark was not duly substantiated. However, it affirmed a likelihood of confusion on the basis of the earlier word mark, which it considered to be highly distinctive through use in the light of documents provided. The CTM applicant filed an action before the General Court claiming a breach of its right to be heard and errors in the assessment of the proof of use, the distinctiveness of the earlier trade mark and the likelihood of confusion.

CTM applied for	Earlier Marks
BELLRAM	 <p data-bbox="861 436 933 468">RAM</p>

SUBSTANCE: The Court affirmed the similarity of the marks, the conflicting goods (milk and cheese) and the likelihood of confusion on the basis of normal distinctiveness of the earlier mark (Para. 106).

On the right to be heard: The CTM applicant claimed that the Board of Appeal should have invited it to submit observations on the earlier word mark in the proceedings before it, since the Opposition Division had compared the mark applied for only with the earlier figurative mark. The Court confirmed that the Board was allowed to base its reasoning on the earlier word mark and did not breach the applicant's right to be heard by not expressly inviting it to submit observations on the earlier word mark. The Court referred to its case law that the right to be heard as a principle resulting from Articles 75 and 76 CTMR (Para. 23). It also confirmed that the effect of the appeal brought before it is that 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. 25 with a reference to T-191/07 'Budweiser'). Since the opposition was based on both, the figurative and the word mark, and the CTM applicant was invited by the Opposition Division to file its observation on it, the applicant had an opportunity to present, both before the Opposition Division and the Board of Appeal, its arguments that there is no likelihood of confusion between the mark applied for and, in particular, the earlier word mark. The applicant cannot therefore claim that it could not foresee that the Board of Appeal would base its assessment of the likelihood of confusion on the earlier word mark (Paras. 27, 28). The Board of Appeal was not required to inform the applicant of its intention to replace, in the context of the assessment of the likelihood of confusion, the earlier figurative mark with the earlier word mark. Articles 4 (2) and 10 BoA-RoP must be read in conjunction with Articles 63(2), 75 and 76 CTMR and do not impose an obligation on the Board of Appeal to inform the parties of its intention to take account, when assessing the likelihood of confusion, of one or all of the earlier marks upon which the opposition is based.

Case T-413/11; Welte-Wenu GmbH v OHIM; Judgment of 15 January 2013; Language of the case: DE

Keywords: Invalidation action, emblem, heraldic imitation, connection to IO, new evidence, first time on appeal, fixing of costs

Result: Action to a large part dismissed (annulled in relation to costs)

FACTS: The contested CTM was registered for goods in Classes 7 and 12, namely driveshafts and driveshaft spare parts for vehicles. The European Commission applied for a declaration of invalidity on the grounds of Article 7(1)(h) CTMR in conjunction with Art 6ter of the Paris Convention (PC). The Cancellation Division rejected the application for invalidity and decided that the invalidity applicant had to bear the costs. The First Board of Appeal annulled that decision and declared the contested CTM invalid. It imposed the costs of both the cancellation and the appeal proceedings on the CTM owner. The CTM owner appealed to the GC, claiming, in particular, an infringement of Article 7(1)(h) CTMR and an infringement of the rules on the fixing of costs.

CTM	Emblem of Intergovernmental Organization
	

SUBSTANCE: The GC confirmed that the CTM was registered contrary to Article 7(1)(h) CTMR. It agreed that the CTM contained a heraldic imitation of the flag of the Council of Europe/European Union, referring, in particular, to the blue background (independent of the difference in the shade of blue) (Para. 42) and the Board's consideration that the general consumer, from a heraldic point of view, would not necessarily take note of the difference in the colour of the stars (Paras. 43 and 44). The Court also agreed that the CTM was of a nature to suggest to the public that a connection exists between the CTM and the European Union. There are numerous EU Directives that apply to the relevant goods and show that the EU is active in these fields (Paras. 46 and 51). The Court agreed that the relevant public is not only composed of professionals in the sector, but also covered the general consumer, who can be the owner of a car. Such owners have an interest in having their cars fitted with parts that are in accordance with quality and safety norms (Para. 57). The mere fact that such consumers are advised by professionals when purchasing a car or parts for it does not mean that they are ignorant of marks or other signs referring to such parts, for example on the packaging, in documents or brochures (Para. 57). Moreover, even as regards professionals the possibility of making a connection between the sign and the Organization is not excluded (Para. 66). The CTM owner did not prove otherwise (Para. 68).

Different from Article 6ter (1)(a)PC, for which it is sufficient that the sign contains the emblem or its heraldic imitation, Article 6ter(1)(c) PC has to be considered in an overall assessment. It is not excluded that the other elements of the sign can lead to the overall conclusion that the public would not connect the sign to the Organization (Para. 59). The suggestion of a connection does not only include cases where the public would believe that the goods or services stem from the Organization, but also those where it could believe that they have the approval or warranty of the Organization or are linked to it in another way (Para. 61). In the present case, the other elements of the sign do not exclude the suggestion of a connection. The figurative element will be regarded as reference to the goods, while the word elements 'european' and 'services' increase the suggestion of a connection as they could be perceived as referring to approval, quality control or warranty services of an official EU agency in relation to the goods (Para. 64).

New evidence: The Court declared that the Board was right in accepting EU Directives, submitted by the invalidity applicant for the first time on appeal, as these concern legal matters that can be put forward at any stage of the proceedings and that, as part of the Community law, cannot be disregarded by the Office (Para. 33).

Costs decision: As the invalidity applicant had not appealed the costs decision of the Cancellation Division (namely that the costs were to be borne by the invalidity applicant), this aspect did not form part of the appeal proceedings and the Board was not entitled to change it. Therefore the Board's decision was annulled insofar as it stated that the CTM owner had to bear the costs of the cancellation proceedings (Paras. 75 to 77).

Case T-625/11; BSH Bosch und Siemens Hausgeräte GmbH v OHIM; Judgment of 15 January 2013; Language of the case: DE

Keywords: Descriptiveness, component of a product, characteristics of the goods and services

RESULT: Action dismissed

FACTS: The applicant sought to register the word mark 'ecoDoor' as a CTM for goods in Classes 7, 9 and 11. The Board of Appeal confirmed the refusal of the CTM application on the grounds of Article 7 (1)(b) and (c) CTMR for goods including, inter alia, electrical household and kitchen machines and appliances, automatic vending machines, heating apparatus and refrigerators. The CTM applicant filed an action to the Court.

SUBSTANCE: The General Court dismissed the appeal and decided that the CTM application had to be refused since it was descriptive of the goods, Article 7(1)(c) CTMR. As a preliminary point, the Court stated that a large part of the findings of fact made by the Board of Appeal were not in dispute, such as the definition of the relevant public, the finding that, within the mark applied for, the relevant public will distinguish the elements 'eco' and 'door', the fact that the word 'door' has its usual meaning in English, and the finding that the goods may include doors and consume energy (Para. 18). The Court confirmed that 'eco' would be perceived by the relevant public as meaning 'ecological' and referred to its judgement in case T-328/11 'EcoPerfect' (Paras. 21, 22). The meaning of the trade mark is not 'vague' as claimed by the applicant. As the element 'eco' will be perceived to mean 'ecological', and the element 'door' has its normal meaning, the Board rightly held that the term 'ecoDoor' would be understood immediately to mean 'a door the construction and mode of operation of which are ecological' (Para. 24).

With regard to the applicant's claim that, as a result of the limitation of the list of goods, the mark no longer covers components of the machines and devices, such as doors, but only the machines and devices themselves the Court observed that a sign that is descriptive of a characteristic of a component incorporated in a product can also be descriptive of the product itself (Para. 26). That is the case where, from the perception of the relevant public, the characteristic of the component described by the sign could have a significant impact on the essential characteristics of the product itself. In this case, the relevant public will, immediately and without further thought, take the characteristic of the component described by the sign to mean the essential characteristics of the product in question (Para 26). Consumers are increasingly mindful of the ecological quality of goods, including their energy consumption, and of environmentally friendly manufacturing processes. This is particularly true in relation to goods such as those applied for, especially since they consume energy. Consequently, as the applicant itself admits, the ecological character is an essential characteristic of these same products (Para. 30).

Joined Cases T-582/11 and T-583/11; Solar-Fabrik AG für Produktion und Vertrieb von solartechnischen Produkten v OHIM; Judgment of 17 January 2013; Language of the case: DE

Keywords: Laudatory mark, slogan mark, abbreviation, lack of distinctive character, characteristics of the goods and services

RESULT: Action dismissed

FACTS: The applicant sought to register the word marks 'PREMIUM L' and 'PREMIUM XL' as CTMs for goods in Classes 9 and 11. The Board of Appeal confirmed the refusal of the CTM applications on the grounds of Article 7(1)(b) and (c) CTMR. The CTM applicant filed an action to the Court.

SUBSTANCE: The General Court dismissed the appeal and decided that the CTM applications had to be refused since they lacked distinctive character, Article 7(1)(b) CTMR. The Court confirmed the understanding of the trade marks applied for which was the basis for the decision of the Board: 'premium' means 'of best quality' and 'XL' or 'L' are abbreviation used to designate 'large' or 'extra-large' (Para. 22). These abbreviations are commonly used as a designation of size also beyond the fashion industry from which they come (Para. 26). The understanding of the CTM applications as a reference to the quality and size of the goods applied for is obvious. The relevant public will understand them only as advertising slogans (Para. 22). The Court referred to its jurisprudence on slogans, according to which the registration as CTM of this kind of trademarks can be refused even if they emit an imprecise message on the quality (T-242/02 'TOP', Para. 95 and T-424/07 'OPTIMUM', Para. 26). The argument that the relevant professional public will have an enhanced level of attention was dismissed, firstly, because the message of the sign was considered obvious and, secondly, because the

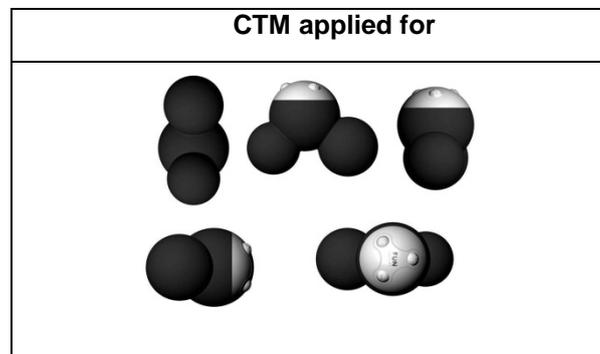
level of attention of even a professional public is relatively limited in case of advertising slogans (reference to the 'OPTIMUM' judgement, Para. 28). The Court did not decide on Article 7(1)(c)CTMR, since one ground is sufficient for the refusal of a CTM application (Para. 37).

Case T-137/12; FunFactory GmbH v OHIM; Judgment of 18 January 2013; Language of the case: DE

Keywords: Three dimensional mark, shape of the products, lack of distinctive character, functional element, weak element, descriptive word element, duty to state reasons, right to be heard, new evidence

RESULT: Action dismissed

FACTS: The applicant sought to register the 3D mark represented below as a CTM for the goods 'vibrators' within Class 10. The examiner refused to register the mark on the ground that it was devoid of distinctive character. The Board of Appeal confirmed this decision. The applicant filed an action before the GC.



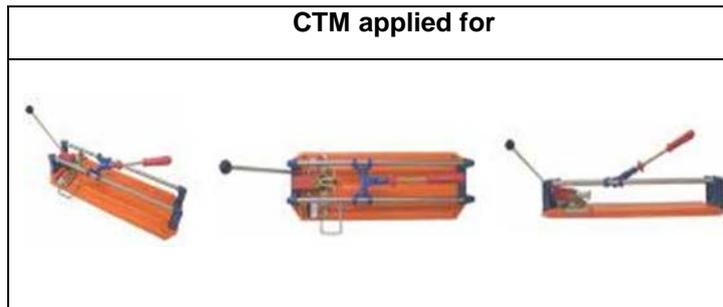
SUBSTANCE: The Court agreed that the sign is devoid of distinctive character (Para. 38). It upheld the Board's finding that the relevant public is the average consumer in the European Union who is of age (not disputed) (Para. 24). In order to determine whether the shape departs significantly from the norm or customs of the sector, all the usual shapes of the goods in the category 'vibrators' have to be taken into account. The shape cannot be individualized by narrowing down the product group (Para. 28). Even though vibrators often have a longish shape, various shapes exist in the market which have a globular, roundish or flattened shape (Para. 29). The shape applied for does not depart significantly from the norm or customs of the sector. This finding is not called into question by the composition of the aligned balls or the triangular alignment of the buttons on the differently coloured control unit (Para. 32). Furthermore, the shape of the goods has to adapt to the human body and has to answer the intended purpose. The product is intended to achieve a certain result. It is not likely that the consumer will remember the geometrical composition or the other trivial details (Para. 33). The word element 'fun' does not change the lack of distinctiveness of the 3D element (Para. 36). It is descriptive of the goods (Para. 35). The word element 'factory' was rightly not taken into account by the Board as it was not legible in the application (Para. 37). The Board did not violate the duty to state reasons in accordance with Article 75 (1) CTMR (Para. 47). It is not obliged to exhaust every argument put forward by the parties one by one (Para. 41). It is sufficient that all facts and arguments of essential importance are dealt with (Para. 42). The Board complied with the requirements in the present case. In particular, it adequately studied the shape and use of vibrators (Para. 46). The Board did not infringe the right to be heard (Article. 75 (2) CTMR) (Para. 65). If an applicant claims that a trade mark applied for is distinctive, despite OHIM's analysis, it is for that applicant to provide specific and substantiated information to show that the trade mark applied for has an intrinsic distinctive character (Para. 50). With regard to the internet evidence attached by the examiner, the applicant could not, at Court level, invoke a violation of the right to be heard, because it had failed to raise this issue before the Board (Para. 61).

Case T-25/11; Germans Boada, SA v OHIM; Judgment of 29 January 2013; Language of the case: ES

Keywords: Three dimensional mark, shape of the products, distinctiveness acquired by use, place of use, evidence of use, promotional material, invoice, sales figures, principle of non-discrimination, duty to state reasons

RESULT: Action dismissed

FACTS: The applicant sought to register the 3D mark shown below as a CTM for goods within Class 8. The examiner refused the application on the basis of Article 7(1)(b). The examiner also refused the evidence filed to show that the mark had acquired distinctiveness within the meaning of Article 7(3) CTMR. The Board of Appeal confirmed this decision. The applicant filed an action before the General Court.



SUBSTANCE: On Article 7(1)(b) CTMR: The Court agreed with the Board that the relevant public for the goods, manual cutter machines for tiles, is made-up of DIY amateurs whose level of attention is not as high as that of professionals but higher than the that of an average consumer because of the level of detail of the work required to operate the machine. The mark applied for is composed of the appearance of the product itself. The shape of the machine is banal, with no particular original feature and not easy to remember. The cutter does not depart significantly from other shapes of machines to cut tiles that are available on the market (Para. 49). Moreover the colours used are commonly used in this market and are not particularly original.

On Article 7(1)(3) CTMR: The GC confirmed that acquired distinctiveness had not been demonstrated in at least a significant part of the EU territory. The evidence filed concerns only a part of the Union's territory namely: Spain, Portugal, the United Kingdom, Poland and France (Paras. 72, 73). The Board made no mistake when it concluded that the sales figures and the budget for publicity of the applicant did not suffice to demonstrate that its mark had acquired distinctiveness. The figures do not show the market share acquired by the sign because they do not contain the sales figures and publicity budget of competitors (Para. 79). Moreover, the GC confirmed the assessment of the Board when it took note that the evidence filed by the applicant did not show the shape of the machine alone but the machine labelled with a number of verbal signs such as RUBI, RUBI TS; or RUBI T 30. The same can be said for the advertising material filed as all the reproductions of the shape are accompanied by a verbal or a figurative sign (Paras. 82-85).

On the violation of equal treatment and of Article 14 of the European Convention of Human Rights: The applicant argued that there was a violation of this provision, referring to the registration of other 3D marks. The GC confirmed that the Board did not violate these principles and that the examples mentioned by the applicant referred to products which are not comparable with the one applied for (Para. 100).

On the violation of Articles 75 and 76 CTMR: The GC held that the contested decision made it very clear on which points of fact and law the Board based its decision. Moreover, the Board reasoned the decisions in relation to all evidence filed (Paras. 109-116).

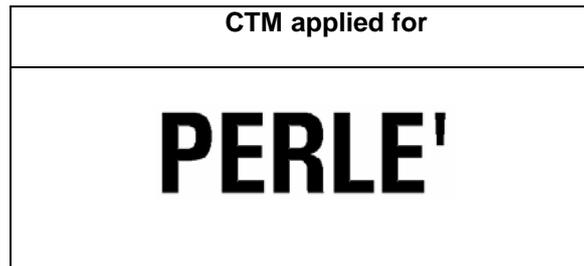
Finally, as regards the applicant's argument that the Board had examined the mark applied for under Article 7(1)(e)(ii) and (iii) CTMR, although that provision had not been raised by the examiner, the GC found that while the Board had mentioned these provisions, it was nonetheless clear from the contested decision that it was based on Article 7(1)(b) CTMR (Para. 122).

Case T-104/11; Ferrari F.lli Lunelli SpA v OHIM, Judgement of 1 February 2013, Language of the case: IT

Keywords: Figurative trade mark, descriptiveness, distinctiveness acquired by use, evidence of use

RESULT: Action dismissed

FACTS: The applicant filed an International Registration designating the EU for the figurative sign depicted below for goods in Class 33. The examiner partially rejected the sign for 'wines and sparkling wines' on the basis of Article 7(1)(b)(c), 7(2) and 7(3) CTMR. The applicant lodged an appeal. The Board of Appeal rejected the appeal on the ground that the sign was descriptive for wines and sparkling wines and that it was devoid of any distinctive character. Furthermore, the Board held that the proof submitted by the applicant pursuant to Article 7(3) CTMR was not sufficient to prove that the sign had acquired distinctiveness through use in all the Member States concerned.



SUBSTANCE: The General Court held that the term 'perlé' means a slightly fizzy wine. Since the expression belongs to both the French and the English language, the French and the English public's perception must be considered (Paras. 17, 19). In order to determine the relevant target public, the applicant contends that professionals in the wine industry are not relevant. According to the applicant, only the public at large is the final buyer of the goods concerned, without special knowledge in the field of wines. For these consumers the term 'perlé' has no meaning (Para. 20). According to the General Court, the knowledge of wine and of wine-making has a cultural impact. Therefore, at least a part of the general public is composed of average consumers that have some knowledge of wines and who know the meaning of the term 'perlé' (Para. 22). Those consumers who do not know the term 'perlé' can be advised by professionals in the field concerned and can be informed of the meaning of that term when buying wines (Para. 23). On the basis of the foregoing, the Board of Appeal was right to conclude that the term 'perlé' was descriptive for wines and sparkling wines (Para. 27). The General Court confirmed its case law according to which, in order for Article 7(1)(c) CTMR to be applied, it is not necessary that a sign is actually used for descriptive purposes in relation to the product concerned at the time of the application for registration as a trademark. It is sufficient that the sign may be used for such purposes (Para. 30). In addition, it is immaterial whether there are synonyms that allow designating the same characteristics of the products mentioned in the application for registration of the sign (Para. 31). Where a sign is found to be descriptive under Article 7(1)(c) CTMR, it is necessarily also devoid of distinctive character pursuant to Article 7(1)(b) CTMR (Para. 32). Finally, as regards the proof of use under Article 7(3) CTMR, the General Court held that the applicant failed to furnish sufficient evidence of said use in all the relevant Member States. The General Court confirmed that the distinctive character acquired through use of a sign must be demonstrated in all the Member States in which the existence of such a ground for refusal was found (Para. 38).

Case T-272/11; Coin SpA v OHIM; Judgment of 1 February 2013; Language of the case: EN

Keywords: Identity of the goods and services, visual dissimilarity, phonetic similarity, conceptual similarity, conceptual dissimilarity, descriptive element, dominant element, weak element, figurative trade mark

RESULT: Action partially upheld (BoA decision partially annulled)

FACTS: The applicant sought to register the word mark 'Fitcoin' as a CTM for goods and services in Classes 16, 25, 28, 35, 36 and 41. An opposition based, inter alia, on the earlier figurative marks shown below (Community registration, Italian registration and international registration) for goods and services in Classes 16, 25, 28, 35, 36 and 41 was filed on the grounds of Article 8 (1)(b)CTMR. The Opposition Division rejected the opposition. The Board of Appeal dismissed the opponent's appeal. The opponent filed an action before the GC, which was the subject of Case T-249/08. The Court, in its judgement of 21 April 2010, annulled the Board's decision. It held that the Board had erred in concluding that there was no likelihood of confusion on the basis of an analysis which was made exclusively in relation to the Italian public.

Implementing the judgment, the Board of Appeal upheld the opposition in part, namely for goods and services in Classes 28 and 41, but rejected it for the remainder. The opponent filed a new action before the GC (T-272/11).

CTM applied for	Earlier marks
Fitcoin	

SUBSTANCE: The goods and services covered by the CTMA are identical to those covered by some of the earlier rights (undisputed) (Para. 24). The relevant public is composed of the average consumer in the EU with respect to the goods and services in Classes 16, 25, 28 and 35, of the average Italian, German, Spanish, French, Hungarian and Slovenian consumers with respect to the services in Class 36, and of the average Italian, German, Spanish, French, Hungarian and Slovenian consumers with respect to the services in Class 41, whose level of attention must be regarded as high in respect of the services in Classes 35 and 36 and the 'education' services in Class 41 (undisputed) (Para. 25). The marks are visually different and phonetically similar only to a low degree (undisputed). As regards the conceptual comparison, the Board had found that the meaning of the English word 'fit' as 'in good health' had a link only with regard to some of the contested goods and services, namely sporting articles and activities in Classes 28 and 41. Only with regard to these goods and services, the Board had found that the common element 'coin' was the distinctive element and there was, therefore, a likelihood of confusion. The Court found that this analysis was not correct. In the Court's view, the Board should have also found that the word 'fit', in the sense of 'to be of the correct size or shape', has a limited distinctive character as regards 'clothing and footwear' in Class 25 (Para. 34), and that the similarity due to the common element 'coin' is not counteracted by the presence of the element 'fit' in the CTMA. The Board erred in finding that there is no likelihood of confusion for English consumers as regards 'clothing, including footwear and slippers' in Class 25. In contrast, the Court considered that the word 'fit' is not frequently used in relation to the other contested goods and services of the CTMA in Classes 16, 28, 35, 36 and 41, with the result that the term 'fit' is distinctive for those goods and services (Para. 37). Consequently, the Court found that the Board correctly concluded that there is no likelihood of confusion in respect of those goods and services. Therefore, the Court considered that the Board erred in rejecting the opposition as regards 'clothing, including footwear and slippers' in Class 25 and it was correct in rejecting the opposition for the other contested goods and services.

Case T-504/11; Paul Hartmann AG v OHIM; Judgment of 4 February 2013; Language of the case: EN

Keywords: Dissimilarity of the goods and services, new evidence, first time on appeal

RESULT: Action dismissed

FACTS: The CTM applicant sought to register the word mark '**DIGNITUDE**' for 'sanitary napkins, textiles for medical use and underwear' in Classes 5, 24 and 25. The opponent based its opposition on the earlier CTM and the German word mark '**DIGNITY**' for goods in Classes 5 and 10. The Opposition Division partially upheld the opposition and found that there was likelihood of confusion regarding the products in Classes 5 and 24, but dismissed it in respect of the goods in Class 25. The Board of Appeal confirmed the OD's decision. The opponent appealed to the General Court.

SUBSTANCE: The relevant public consists mostly of consumers suffering from incontinence, whose level of attentiveness is particularly high when selecting the goods at issue (Paras. 30-31).

The question put to the Court is whether the goods 'hosiery; underclothing, underpants; underwear' in Class 25 covered by the CTM application are similar to the goods covered by the earlier marks in Classes 5 and 10 (namely, napkin pants, absorbent pads for incontinence purposes, orthopaedic articles, draw-sheets for sick beds and incontinence sheets). The GC found that the conflicting goods serve a different purpose, have a different nature, different channels of distribution, and are neither interchangeable nor complementary (Paras. 37-45). The GC confirmed that the Board did not err in

finding that the goods are not similar. Therefore, the Board was correct in finding that there was no likelihood of confusion with regard to these goods.

Admissibility: The Court rejected various documents presented for the first time before it as inadmissible (Paras. 13-16).

Cases T-412/11 and T-426/11; Maharishi Foundation Ltd v OHIM; Judgments of 6 February 2013; Language of the cases: EN

Keywords: Admissibility, adversely affected, descriptiveness, new evidence, first time on appeal

RESULT: Actions dismissed

FACTS: Two CTMAs for the words 'Transcendental Meditation' and the French translation 'Méditation transcendentale' in respect of goods and services in Classes 16, 41, 44 and 45. The examiner refused the CTMAs under Article 7(1)(c) and (b) CTMR as the signs indicate to consumers that the goods and services are focused on, based on or utilize the type of meditation commonly referred to as 'transcendental meditation'. The examiner also considered that Article 7(3) CTMR could not apply as the CTM applicant had failed to submit proof of the acquisition of distinctive character of the sign applied for in the English-speaking parts of the European Union that is, the United Kingdom, Ireland and Malta. The Board of Appeal partially upheld the appeal. It found that the examiner's decision was to be annulled as far as the examination of Article 7(3) CTMR was concerned because the examiner omitted to refer to a number of Member States, other than the United Kingdom, Ireland and Malta, in which the sign applied for would be understood as being descriptive and non-distinctive. Moreover, since the applicant submitted additional proof of use of its sign in the United Kingdom, Ireland and Malta, the Board of Appeal considered it appropriate to remit the case to the examiner for further prosecution. For the remainder, the Board of Appeal confirmed the examiner's findings that the sign applied for is non distinctive and descriptive with the meaning of Article 7(1)(b) and (c) CTMR.

SUBSTANCE: On the admissibility of the appeal before the GC: OHIM had claimed that the appeal was inadmissible to the extent that the refusal of the CTMAs was not yet final, pending the examination of Article 7(3)CTMR. The GC dismissed this claim and held that, since the Board had extended the territorial scope of the refusal, the decision had negative consequences for the applicant and changed its legal position. It is therefore appealable (Paras. 24-26).

On Article 7(1)(c) CTMR: The relevant public is the public at large, with the exception of 'instructional and teaching material', which is intended for professionals in the educational sector (Para. 57). The GC confirmed that the expressions 'Transcendental Meditation' and 'Méditation transcendentale' (which exists in all languages in closely similar forms) could be understood everywhere in Europe, with the exception of Bulgaria and Greece (Paras. 61-67). The GC noted that both words have a meaning and that their combination suggested unambiguously 'the action or practice of focusing one's mind for a period of time, in silence or with the aid of chanting, for religious or spiritual purposes or as a method of relaxation, on issues relating to a spiritual realm' (Para. 72). The CTMAs are therefore descriptive of the subject-matter of '*Instructional and teaching material*' (Class 16) and of the services '*Education; providing of training; entertainment*' (Class 41), '*Medical services; hygienic and beauty care for human beings*' (Class 44) and '*Personal and social services rendered by others to meet the needs of individuals*' (Class 45) (Paras. 81-90). The CTMAs inform the public that those services are centred or based on the specific type of meditation known as transcendental meditation or that they use that type of meditation for such purposes. The GC dismissed the argument that the CTMAs are distinctive since they describe a type of meditation offered by the organisation Transcendental Meditation and to distinguish its teaching services. This does not render the CTMAs less descriptive (Paras. 91-92).

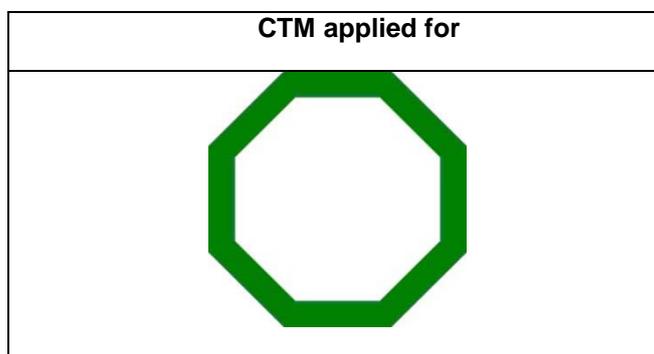
On Article 7(3) CTMR: The applicant's plea concerning the violation of Article 7(3) CTMR is inadmissible to the extent that the Board did not assess the proof of acquired distinctiveness and limited itself to refer the case back to the examiner for that purpose (Paras. 100-101).

Case T-263/11; Carsten Bopp v OHIM; Judgment of 6 February 2013; Language of the case: DE

Keywords: Fax, error by OHIM, complementary evidence, new evidence, right of defense

RESULT: Action upheld (BoA decision annulled)

FACTS: The applicant filed the figurative sign depicted below for services in Class 35. The examiner rejected the sign on the basis of Article 7(1)(b) CTMR. The applicant filed an appeal. The rapporteur of the Board of Appeal informed the applicant that he considered the sign also not registrable under Article 7(1)(c) CTMR and that the services covered by the sign were not clear. The applicant was requested to submit observations. The rapporteur's letter included a fax number at its bottom which was not the official fax number of the Office. As the applicant showed in the proceedings before the GC, he had actually sent a reply to the fax number indicated in the letter of the rapporteur. However, this letter never reached the file and was therefore not taken into account by the Board when it rendered its decision. In the decision, the Board pointed out that the applicant did not specify the services covered by the mark. The appeal was rejected on the basis of Articles 7(1)(b) and (c) CTMR. The applicant appealed to the GC.



SUBSTANCE: First, the GC pointed out that the fax report (showing that the applicant indeed sent a letter to the Board) submitted by the applicant as annex to its second brief in the proceedings before the GC was admissible (Para. 31-37). According to the GC, the applicant gave sufficient reasons why the fax report was submitted at this late stage (Para. 34-35). In particular, the GC argued that the fax report corroborated only facts which had already been brought forward in the first brief before the GC (Para. 34). The right of defence on part of the Office was not violated since the applicant's letter had been brought to the attention of the Office on two earlier occasions (Para. 35). Second, the GC did not accept the argument of the Office that the applicant's letter could be disregarded since it was not sent to the official fax number of the Office (Para. 38-43). Although the cover letter of the Registry of the Boards of Appeal included the correct fax number, the applicant could rely on the fact that the fax number shown in the letter of the rapporteur was also correct (Para. 41). Consequently, the applicant's letter should have been taken into account when deciding whether the sign at issue was apt for registration or not (Para. 45). In that letter, the applicant specified and clarified the services covered by its sign. According to the GC, it could not be excluded that the Board of Appeal would have taken a different decision if it had taken into account this clarification (Para. 49). By not considering those specified services, the Board infringed Articles 7(1)(b) and (c) CTMR (Para. 53).

Case T-50/12; AMC-Representações Têxteis Lda v OHIM; Judgment of 7 February 2013; Language of the case: EN

Keywords: Figurative trade mark, identity of the goods and services, similarity of the signs, visual similarity, phonetic similarity, distinctive element, descriptive element, circumstances of marketing, series of trade marks

RESULT: Action dismissed

FACTS: The CTM applicant sought to register the figurative mark shown below for goods and services in Classes 24, 25 and 39. The opponent based its opposition on the earlier international registration shown below with effect in BG, CS, HU, PL, RO, SL and SV, in particular for goods and services in Classes 24, 25 and 39. The Opposition Division upheld

the opposition and found that there was likelihood of confusion on the part of the target public. The Board of Appeal confirmed the OD decision and dismissed the appeal.

CTM applied for	Earlier IR
	

SUBSTANCE: The relevant public consists of the average consumer of the relevant goods. The conflicting goods are identical. The signs are visually similar as they contain the distinctive element METRO. The other word elements in the CTM applied for are elements with low distinctiveness; they are extremely commonplace and will be understood even by a public which has difficulty mastering the English language. There is an even stronger aural similarity, as the figurative elements of the signs will not be pronounced. No conceptual comparison is possible. The signs are similar overall, the goods are identical. The Board rightly found that there is a likelihood of confusion. The quality, price or details of the applicant's goods and the particular circumstances in which they are marketed, which are dependent on the commercial intentions of the person applying for the trade mark and which may therefore vary in time, cannot be relevant for the purposes on analysing the likelihood of confusion (Para. 58). The application is dismissed.

Case T-427/11; Laboratoire BIODERMA v OHIM, Cabinet Continental; Judgment of 21 February 2013; Language of the case: FR

Keywords: Descriptiveness, characteristics of the goods and services, right to be heard, well known facts need no evidence

RESULT: Action partially upheld (BoA decision partially annulled)

FACTS: The invalidity applicant sought to cancel the registration for the word mark 'BIODERMA', registered as a CTM for goods in Classes 3 and 5 and services in Class 44. The Cancellation Division rejected the application for cancellation. The Board of Appeal annulled this decision and declared the CTM invalid for all goods and services for which it was registered. The CTM owner filed an action before the General Court.

SUBSTANCE: The Court held that the Board did not violate Article 75 CTMR as the examination of the distinctiveness on the basis of the relevant Greek speaking public was not done in violation of the law. The Board did not base its assessment on elements that the parties did not have the opportunity to discuss. The perception of the contested mark by the Greek speaking public is a matter of common knowledge and therefore could be used by the Board as a basis of the reasoning. The fact that both words, bio and derma, have a Greek origin was discussed in depth by the parties during the administrative process. The Board was also right to conclude that the goods and services concerned were addressed to the average consumer who is presumed to be normally informed and reasonably attentive. As some of the goods and services concern pharmaceutical products, the public is also composed of professionals of the health sector.

The neologism BIODERMA indicates the natural origin of a product for the skin or refers to services of natural treatments for the skin. The Board was correct to find a concrete and direct link between the meaning of BIODERMA and the products in Class 3 as these products are used for the skin. This is also the case for pharmaceutical products in Class 5 as some of these products are used to treat the skin. The link exists also for hygienic products in Class 5. In relation to the services of beauty salons, advice in the field of hygiene, treatments in the field of cosmetology and dermatology, body treatments and beauty treatments, all these services relate to the treatment of the skin. It is therefore also correct that the Board found the mark to be descriptive for these services in Class 44. The GC also confirmed the assessment of the descriptiveness of the mark for those products and services that have as essential objective to preserve the skin when they are used or put in place. This is the case for lotion for the hair and perfumes in Class 3, hairdresser salons in Class 44, disinfectants or plasters in Class 5 and for preparations to clean and wash in Class 3. However, the GC took the view that this link is not direct and concrete for dietetic substances for medical use in Class 5. The link with 'skin' when they are

used is too far from the perspective of the relevant public. For this product, the Court found that the assessment of the Board under Article 7(1)(c) CTMR was incorrect. The same conclusion was reached with regard to Article 7(1)(b). The CG annulled the Board's decision as regards 'dietetic substances for medical use' in Class 5 as the word 'derma' is not used frequently in relation to such products and the CTM applied for has a minimum of distinctive character for it.

Case T-444/10; Esge AG v OHIM; Judgment of 21 February 2013; Language of the case: EN

Keywords: Identity of the goods and services, similarity of the goods and services, similarity of the signs, visual dissimilarity, phonetic similarity, ending of mark, error by OHIM, no bearing on decision

RESULT: Action dismissed

FACTS: The applicant sought to register the word mark 'KMIX' as a CTM in Classes 7 and 11. An opposition based on the earlier CTM 'BAMIX' in Classes 7 and 40 was filed on the grounds of Article 8(1)(b) CTMR. The Opposition Division rejected the opposition. The Board of Appeal dismissed the opponent's appeal. The opponent filed an action before the General Court.

SUBSTANCE: The goods covered by the mark applied for are domestic and electrical appliances used for cooking. The relevant public consists of both professional and general public, thus, it will have either an above average or a reasonable level of attention and circumspection (Paras. 18-19). The goods covered by the earlier CTM and the CTMA are identical or similar (not disputed). As regards the visual comparison, the Court followed the previous case law by stating that the consumer generally pays greater attention to the beginning of a mark than to the end and that the brevity of the marks at issue enables consumers to better grasp the variations in their spelling. The GC found that the signs are not visually similar as they have different initial letters and a different number of letters (Paras. 26-28). With regard to the phonetic aspect, the Court held that as the word element 'kmix' does not correspond to any existing word in the European Union, it may be pronounced by part of the relevant public as it is written, namely as a single syllable. However, the pronunciation of the mark applied for as a two syllable word, namely 'ka' and 'mix', is also possible. In certain languages of the European Union (in particular French and German), the letter 'k' is pronounced as 'ka' and the pronunciation 'km' is not usual. Therefore, the Board of Appeal erred by assessing that only the single syllable pronunciation "Kmix" is possible (Para. 32). The Court held that a visual similarity between signs has more weight than a phonetic similarity in the assessment of the overall similarity as greater weight will usually be attributed to visual similarity in cases where the goods covered by the mark in question are sold in self-service stores where consumers choose the goods themselves and must therefore rely primarily on the image of the trade mark applied to the goods (Paras. 36-39). This is the case here as well. Consequently, the fact that the BoA did not take into account the pronunciation of 'kamix' in the assessment of the phonetic similarity is not liable to affect the assessment of the overall similarity (Para. 40). Given the visual differences between the signs at issue, the reduced importance of their medium degree of phonetic similarity and the fact that they cannot be compared conceptually, the GC held that the BoA did not err in law by concluding that there was no likelihood of confusion (Para. 42).

Case T-422/12; Kappa Filter Systems GmbH v OHIM, Order of 20 February 2013, Language of the case: DE

Keywords: Order, admissibility, time limit, fax, original document, force majeure, unforeseeable circumstances

RESULT: Action dismissed (manifestly inadmissible)

FACTS: The OHIM examiner had refused the CTM application 'THE FUTURE HAS ZERO EMISSIONS'. The decision was confirmed by the Board of Appeal by a decision that was notified to the applicant on 13 July 2012. By fax of 13 September 2012, the applicant raised an appeal before the GC. However, the original document of the pleadings reached the GC only on 26 September 2012, i.e. after the ten-day deadline specified in Article 43 (6) ROP GC to submit the original and outside the deadline for appeal which expired on 24 September 2012 at midnight. The applicant argued that the late arrival of the original document at the GC was due to unforeseeable circumstances within the meaning of Article 45(2) of the Statute of the Court of Justice as the document had been given to the Austrian Postal Service on the same day the fax had been sent, i.e. 13 September, and the manual of the Austrian Postal Service stated that the time period for delivery to Luxembourg was 'A + 5 to 10 days'.

SUBSTANCE: The GC dismissed the action as manifestly inadmissible (Article 111 ROP GC) as the appeal had been raised outside the deadline. The GC confirmed that the deadline for submission of the pleadings was 24 September at midnight (two month from notification of decision and a period of ten days on account of distance – Article 65(5) CTMR, Articles 101, 102(2) ROP GC). The original of the fax submissions arrived outside the ten-day deadline for its submission under Article 43(6) ROP GC and outside the deadline for appeal. The GC rejected the applicant's arguments relating to the Austrian Postal Service. As regards Article 45(2) of the Statute, the GC confirmed that the concepts of *force majeure* and unforeseeable circumstances contain an objective element relating to abnormal circumstances unconnected with the trader in question and a subjective element involving the obligation, on his part, to guard against the consequences of the abnormal event by taking appropriate steps without making unreasonable sacrifices. In particular, the trader must pay close attention to the course of the procedure set in motion and, in particular, demonstrate diligence in order to comply with the prescribed time limits (Para. 16). The GC found that the start of the time period for delivery in the manual of the Austrian Postal Service was not clear and that it was not specified whether this was the usual time period or a time period guaranteed by the Austrian Postal Service (Para. 17). Even if the Austrian Postal Service would oblige itself to deliver within ten days, this does not make the delivery outside those ten days a case of unforeseeable circumstances or *force majeure* (Para. 18). The applicant did not use the diligence necessary by using the service, in particular in view of the tight timing in handing the original over to the post (Paras. 18, 19).

New Decisions from the Boards of Appeal

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

E .g. Case R 219/2004-1 has to be entered under 'Appeal N^o' as: 0219/2004-1

Designation of origin

Decision of the First Board of Appeal of 17 January 2013 in case R1425/2010-1 (ES) PURO Palapa TEQUILA / TEQUILA —



The applicant sought to register the figurative mark  for, after a limitation, the following goods in Class 33: Alcoholic beverages (except beers), namely Mexican tequila.

'El Consejo Regulador de Tequila' filed an opposition against the registration of the application based on the earlier community collective trade mark n^o 4 867 263 'TEQUILA' on the grounds of Arts. 8(1)(b) and 8(5) CTMR. It added that the applicant was not authorized to use the term 'TEQUILA' protected by the collective mark and that, therefore, the absolute ground indicated in Art. 7(1)(b) and (c) CTMR applied.

The Opposition Division refused the opposition in its entirety. The opponent filed an appeal.

The First Board of Appeal decided on an interim decision to stay the proceedings and to send the application back to the examiner, because it had serious doubts about the registrability of the application according to Art. 7(1)(j) CTMR.

The Office notified the applicant the impossibility to register the application on the basis that TEQUILA is a protected designation of origin under Art. 7(1)(j) CTMR and the existence of an agreement between the EU and Mexico to protect designations in the spirits sector, inter alia, 'tequila'.

The applicant was offered the possibility to limit the indication of the goods as indicated:

Class 33: Alcoholic beverages (except beers), namely Mexican tequila in conformity with the determinations established for the protection of the designation of origin 'tequila'.

The applicant did not answer and did not file an appeal against the Office's decision.

Therefore, the Board resumed the suspended proceedings, declared the contested decision final and therefore the CTM application rejected entirely on the grounds of under Art. 7(1)(j), and (2) CTMR and the appeal and opposition proceedings void.

Ex-parte - Procedural issues

Decision of the First Board of Appeal of 17 January 2013 in Case R1133/2012-1 -(ES) –



The applicant sought to register the figurative mark  claiming the colours 'blue and orange'. It was registered with the description of the colours 'blue and orange', as requested.

The Operations Support Department notified the applicant of its decision that the colour description had changed to 'orange and grey'.

The applicant filed an appeal and the corresponding grounds of appeal against that decision. The appellant argued that even if it is possible to confuse that particular shade of blue with grey, the specific colours claimed for the mark are Blue Pantone 282C and Orange Pantone 165 C, as explained in the annex, '*Guía de estilo de Dynasol*' (Dynasol Style Guide). It added that in these borderline cases, the indication given together with the description of the mark, in the present case, 'blue and orange', should prevail.

The Board upheld the appeal on the grounds that the Office should not change the description of a mark unless there is an obvious contradiction between the description and the representation of that mark. It supported the applicant's argument that the description of the mark given by the applicant should prevail.

Therefore, the Board annulled the contested decision.