



### OHIM's new website launched

OHIM's new website brings a new online look and feel to the Office. The site has been developed in collaboration with users, who have tested its functionalities and provided valuable feedback through the development process.

Over the past months, testing and development on the website have reached a peak. The site now includes several new functionalities which will make the filing process more user-friendly ... [Page 2](#)

### Interview



James Nurton interview Joost Muylle of De Clercq & Partners about his recent move, the problems with trade marks incorporating figurative elements, a new language at the Benelux IP Office and concerns about the changes to the CTM Regulation and Trade Marks Directive ... [Page 3](#)

### Community Trade Mark

## CTM

- Latest developments in Office's practice on Black and White Trade Marks [Page 5](#)

### Registered Community Design

## RCD

- Cases T-566/11 and T-567/11; Viejo Valle, S.A. v OHIM; Judgment of 23 October 2013; Language of the case: ES [Page 7](#)

### EUTMDN Updates

- *Greece and Morocco join TMview* [Page 9](#)
- Members of the Harmonised Database increase to 22 [Page 10](#)

### More News



- Common Communication on the Common Practice on the General Indications of the Nice Class Headings [Page 10](#)
- IP Perception Study [Page 11](#)
- ISO 9001 whole office certification in 2013 [Page 11](#)
- Morocco joins TMclass [Page 11](#)
- OHIM Administrative Board and Budget Committee meetings [Page 12](#)
- Feasibility study with SIPO on DesignView launched [Page 12](#)
- TMview and GBD smart button function [Page 12](#)
- Real Time Satisfaction Survey (RTSS) on Cancellation [Page 13](#)
- Monthly statistical highlights October 2013 [Page 13](#)

### Case law



- Luxembourg trade mark and design news [Page 13](#)
- New decisions from the Boards of Appeal [Page 22](#)

### Editorial Team:

Mark Kennedy, Mikael Wesslegard

**Contributors to this edition:** James Nurton, Alexandra Poch, María Gallar Ruiz, Knowledge Circles Coordination Team, Reg Rea

## OHIM's new website launched

OHIM's new website brings a new online look and feel to the Office. The site has been developed in collaboration with users, who have tested its functionalities and provided valuable feedback through the development process.

Over the past months, testing and development on the website have reached a peak. The site now includes several new functionalities which will make the filing process more user-friendly.

The changes of practice are described in the Manual of Trade Mark Practice, which, among others, implements the Common Communication on the Common Practice on the General Indications of the Nice Class Headings, published on 20 November 2013; that entered into force on the date of the go-live of the new website.

The roll out of the new website will see changes to the way existing users interact with the Office.

The new site aims to provide users with a full electronic experience, offering them complete and simple solutions through a wide range of online tools and related services.

The new user area replaces My Page and is a completely secure platform that lets the user monitor the lifecycle of a trade mark or design. It is possible to edit personal details, subscribe to our news feeds, set alerts for renewal or watch other CTMs, and much more.

Existing users can use their OHIM ID to create an account in the new website, which also offers an enhanced search function, a single space for all transactions and the possibility to create sub-accounts for several company members.

In addition, the new e-filing wizard will allow non-specialised users to file in five steps, using any of 23 EU languages. The application can be saved at any time during the process.

There is also an interface for IP professionals: structured into clear sections, it will now be simpler to file in cases with priority or seniority claims.

The new e-filing will also introduce other fresh navigation features, including taxonomy, an intuitive, market-oriented way of classifying Goods and Services, based on the Nice Classification.

It also presents a complete revamp of its navigation system, aimed at specialist and non-specialist users.

The navigation has been developed after rigorous user testing, and follows a simple and practical structure.

The site contents cover the whole lifecycle of trade marks and designs. Users are offered basic information on the importance of IP rights, and the most suitable type of right for different products or services. It also features animated visual aids to guide non-specialist users through the registration process.

The route to registration is clearly mapped out, with a full timeline of the registration process. The site also contains information on post-registration options.

The new site will introduce a comprehensive search engine: eSearch plus is a single, powerful search tool for all Community trade mark and design resources.

The search function allows for a basic search, for example, through trade mark name. It also allows the user to further refine the search through areas like recordal numbers, trade mark type, acquired distinctiveness, etc. Bulletins can also be downloaded in the advanced search section.

For registered users, the search generates detailed information on the selected CTM/RCD, through a timeline style to display file statuses. It also allows users to set up alerts based on the search criteria, or alerts to specific events, such as change of ownership of a trade mark or when it is due for renewal.

OHIM's e-business Help Desk teams are standing by to answer user queries during the transition period from the old to the new website, to ensure that new and existing users have all the support and information they need. Meanwhile, all the available information and learning resources on the new website have been gathered together in one single space, for ease of access.



## The James Nurton Interview

James Nurton interviews Joost Muylle of De Clercq & Partners about his recent move, the problems with trade marks incorporating figurative elements, a new language at the Benelux IP Office and concerns about the changes to the CTM Regulation and Trade Marks Directive.

### What is your background?

It goes quite a way back: I have just passed 50 so I started my career about 25 years ago. My track is unusual. I am an engineer by education. During my last year of study I had to present a Masters paper to a jury. One of the members was continually laughing and afterwards he asked me if I knew what a patent was. He said 'we'll teach you' and he became my first employer. I had used terminology that was common in patent practice like 'surprisingly found' and that was the start of my career in patent work.

This was in a large food and bakery products company. For them a patent and a trade mark were fairly identical so I inherited not only patent work but the fairly extensive trade mark portfolio. That was shortly before the entry into force of the CTM Regulation so I saw that at the early stage. This allowed me to follow the case law on Community trade marks. After a couple of years I decided to focus on trade marks and designs rather than patents.

### What do you like about trade marks?

Trade marks form part of daily life. You see them every day, whereas patents are not so apparent. Trade mark files also evolve much faster than patent work. With patent work, I didn't really like the drafting of patents, though I did enjoy oppositions. With trade marks, the work is much more varied and there is more to do. For patents, you usually stick to one technical domain whereas in trade marks you see a large number of sectors and people, particularly in private practice.

### When did you move into private practice?

I started in private practice in 1998, working as director in a major IP firm in Belgium. In 2000 I joined another European-wide competitor, based in Paris. I stayed there for a year and a half before starting a small firm, IPR Manager, which has just merged into De Clercq & Partners.

I started IPR Manager because although Paris is a very nice town to live in, it was not a nice town to work: my family was living in Belgium and I was travelling from Sunday to Friday. So we had to decide whether to relocate to Paris or stay in Belgium and I decided to come back to Belgium and do something different.

My experience in two big companies led me to think that something was missing for clients. With IPR Manager I wanted to build a system that allows each one to administer their portfolio online, with reasonable back-office tariffs. It enabled me to get extensive trade mark portfolios that were handled in-house by companies but where the portfolio management was outsourced because the price difference was limited.

IPR Manager was growing too fast and I could not attract the people I wanted to develop it. With De Clercq & Partners the resources are available. We are about 30-35 employees, including 20 attorneys and there are many young people. Today three of us work in trade marks, but that will grow. De Clercq & Partners was a patent office, and I had no patent practice, so we are complementary. We are now integrating hardware, software, accounting etc.

### What is the split in your work?

The largest area is Community trade marks, second Benelux trade marks and then international. I work a lot for companies that are not in Madrid countries so national applications are an important aspect of my work. Madrid is important for Belgian customers but CTMs are 50% of my workload.

### What do you think about the CTM?

The CTM is an example for most other EU member state offices. This is accepted by most of the national offices. As regards business processes and IT, they are way above the national offices. Their electronic platform to file and maintain trade marks is an example for national offices.

Their consistency on decisions and on provisional refusals is something else. That needs to be improved. I understand they are working on increasing consistency. They have good internal guidelines for absolute grounds or opposition decisions but sometimes you have to read the decision carefully to understand it and sometimes it is very surprising.

**Are there particular areas where it's a problem?**

Decisions incorporating figurative elements need to be improved: what is or is not the dominant part?

On absolute grounds, formerly as soon as you had even one limited figurative element CTMs were allowed. But now I have cases that even with extensive figurative elements do not pass examination. You have to be able to rely on the long term and to advise clients accordingly. If there is a surprising decision or a provisional refusal, it's hard to explain that to clients.

**How does the Benelux office compare?**

They are developing electronic platforms as well. They are developing an application and renewal system but the business processes can be lengthy, difficult and not very transparent. They are one of the best in cooperating with the CTM office and to develop their business practices, but the CTM office has developed much faster – to the frustration of the Benelux office! The Benelux office has advocated against decisions such as *Pago* and *One!* to limit the attractiveness of CTMs. There is competition between them, and they don't hide it.

**What did you think of *One!*?**

It's a good decision. I can reasonably well imagine that the use of a trade mark in a limited part of the Community may constitute genuine use, even in a small country, provided as a whole it is being used genuinely. If a product has a market share of 99% just in the Benelux, that might be considered as genuine use. If the objective is to reinforce the European Union, this interpretation will have to prevail.

**What is the most interesting case you have worked on?**

I have quite a lot of unusual trade mark cases. But one I will never forget is the Belgian Postal Services against the German Postal Services case. About five years ago the Belgian Post applied for five or six Community trade marks incorporating the verbal element 'Post' and the German Post opposed and lost, and then appealed and lost.

Remember that postal services were monopolies. Post or postal services is linked to one specific supplier or firm rendering services. Although Post was fairly descriptive, nevertheless it could be considered as being a sign that is distinctive at least in Germany for one specific corporation and the oppositions should not be allowed.

That was a very nice case and we have had to explain it many times. I was the attorney for Belgian Post, so I saw it from the beginning and wrote the written arguments and it was very nice to do.

**What other developments are there in the Benelux?**

What is interesting, and partly thanks to the influence of the OHIM, is that English has recently been adopted as an official language before the Office. So attorneys from other countries can easily file and prosecute their applications. I think this is a good development. There is some animosity about this new language but I think it is a good example for other countries. I would prefer to file my observations in France in English instead of French!

I haven't filed applications in English so far and I don't know about statistics. But the gesture to allow English is an example for other national offices as well. It will enforce cooperation between offices. It applies even to opposition proceedings.

**What do you think of the changes to the CTMR and Trade Marks Directive?**

I think the Regulation changes will not have a big impact. One thing is fees will have to be paid on the filing date, not within 30 days, and from a private practice point of view this is fairly dangerous. Sometimes you have to file as soon as you receive instructions to retain the filing date especially if priority has to be claimed. Afterwards, you seek to get your fees reimbursed and the applicant has disappeared or gone into bankruptcy. It should have been organised in a different way. The 30-day period enabled us to take some risks regarding certain new clients. Payment on application date is not so good.

Also regarding the Regulation the one fee per class for applications is a good thing. The Community register is polluted to a large extent and one-class applications would be nice.

I have certain concerns regarding the Directive, in particular the new grounds for refusal on absolute grounds and also goods entering the Community with external Customs status. This is a worry for logistic companies and big harbours who might see a big reduction in their use as a hub for redistribution. I think the current situation is correct, with the case law of the CJEU regarding infringing products. It allows Customs and the courts to be flexible. I know a case where the abolition of the Customs protection may affect one of my clients. Products that physically enter the Community and are destined for re-export are being stopped because they may infringe a trade mark in the Community, even though they may not infringe

in the destination country, which is a problem. Logistics companies will be more attentive to IP, which is a good thing, but if they have no commercial activities in the EU then their marks will expire through lack of use.

The Commission should reconsider. There are a lot of goods that transit through major European harbours worldwide. That might influence the logistic companies to go to Dubai or somewhere instead.

#### **What are the challenges ahead?**

Trade mark work will continue to grow and flourish. But private practices need to revise their fees for mere administrative work and focus on the substance. Otherwise there will be newcomers that will make it difficult for private practice in the future. There are a large number of challenges and we need to move to more sophisticated work, while providing administrative work in a more transparent manner, with a well-oiled back office that answers questions immediately with reasonable fees. This is how I see the evolution of the market.

### **Latest developments in Office's practice on Black and White Trade Marks**

On behalf of the Office, members of the Knowledge Circle Relative Grounds have been taking part in the discussions on one of the five projects launched within the Convergence Programme: the scope of protection of black and white trade marks. Up to now, trade marks registered in black and white were treated differently by the national offices in Europe. Some national offices applied the 'black and white covers all colours' approach; other offices applied the 'what you see is what you get' approach, which gives protection to the sign as it is registered, meaning that trade marks that are filed in black and white are only protected as such. This inconsistent practice caused by different approaches, resulted in an uncertain scope of protection for the trade mark owners.

A proposal for a **new common practice** as regards the scope of protection of black and white trade marks has been endorsed by OHIM's Administrative Board and Budget Committee in November. The practice takes into consideration comments from users associations and it is expected to be beneficial for both IP offices and users.

The project focuses on whether a trade mark filed in black and white and/or greyscale is identical to the same trade mark in colour with respect to priority claims and relative grounds for refusal. Moreover, the project analyses whether the use of a colour version of a trade mark filed in black and white (and vice-versa) is acceptable for the purposes of establishing genuine use. Outside the scope of the project remain matters like the assessment of similarities between colours, use of black and white trade marks in colour for the purpose of acquired distinctiveness, colour marks per se, as well as infringement issues.

The basic approach of the new common practice is that identity between a trade mark filed in black and white and/or greyscale and a sign in colour exists only when the signs are the same in all respects, or the differences are so insignificant that they may go unnoticed by the average consumer. For a difference to be insignificant, it should be noticed by the consumer only upon side by side examination.

#### ***Priority claims***

As regards priority claims, unless the differences in colour are insignificant, a trade mark registered in black and white is not considered identical to the same mark in colour.

#### ***Relative grounds for refusal***

The same approach applies as regards relative grounds for refusal. The differences between a black and white trade mark and one in colour will be noticed by the average consumer (and thus the trade marks will not be identical), unless they are insignificant, negligible and hardly noticeable.

#### ***Use***

For the purpose of genuine use however, a change only in colour does not alter the distinctive character of the trade mark, as long as several requirements are met: the word/figurative elements coincide and are the most distinctive, the

contrast of shades is respected, the colour or combination of colours does not have distinctive character in itself, and colour is not one of the main contributors to the overall distinctiveness.

### Greyscale

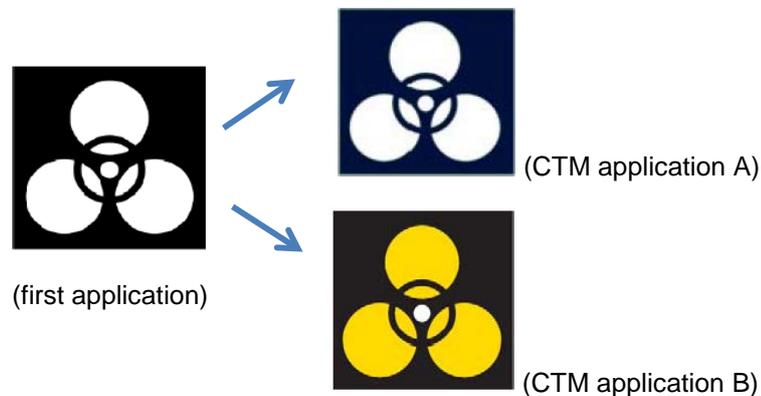
Basically the same line of reasoning is applied as regards trade marks registered in greyscale. When the differences in contrast of shades are insignificant, a sign in greyscale will be identical to the same sign registered in black and white for the purpose of priority claims and relative grounds for refusal.

### Next steps

OHIM Guidelines on trade mark practice are updated as a consequence, among others, of the outcome of the Convergence Project. Accordingly, the Knowledge Circle Relative Grounds (with regard to practice on *relative grounds for refusal and use*) together with the Knowledge Circle Proceedings (as regards practice on *priority*) will be in charge of implementing the new common practice in the next update of the Guidelines.

It is expected that the major impact on practice affects priority. The proposed change will mean that the Office will accept priority claims that it previously would have objected to.

### Example:



In the above example, under the previous practice the CTM applications A and B would have not been considered identical to the first application and the priority claim would have been refused. However, under the agreed practice, the priority claim from the first application will be accepted for CTM application A (the difference in colour is insignificant) but not for CTM application B.

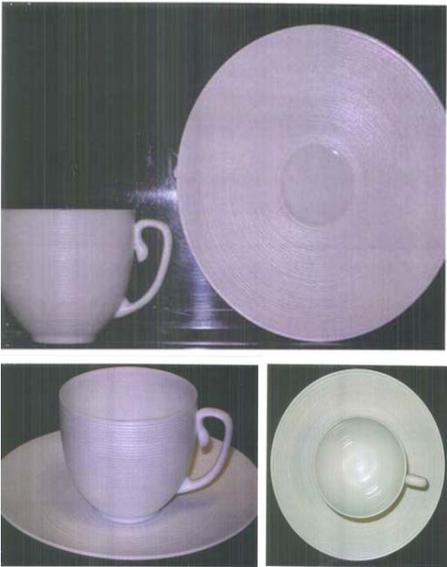
### Knowledge Circle Relative Grounds

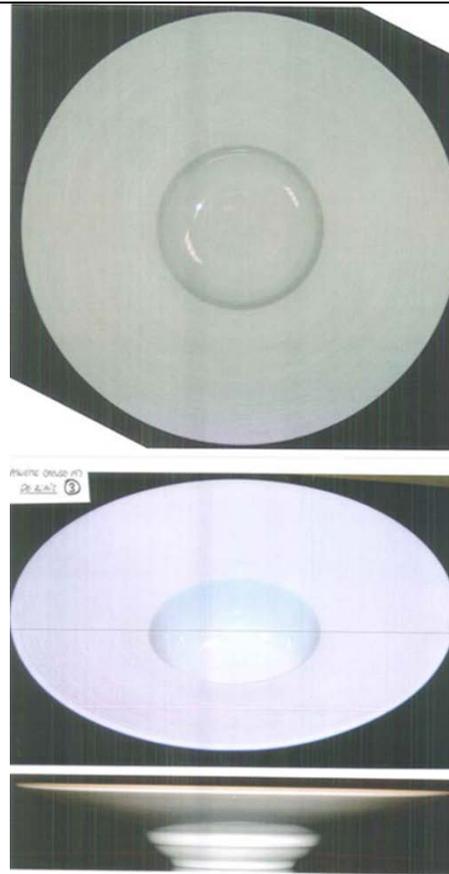
**Cases T-566/11 and T-567/11; Viejo Valle, S.A. v OHIM; Judgment of 23 October 2013; Language of the case: ES**

*The Office, the General Court and the Court of Justice are occasionally called upon to apply national law when ruling in trademark and design matters. The present cases relates to invalidation in accordance with 25(1)(f) CDR based on French copyright law.*

**RESULT: The action is dismissed**

**FACTS:** The RCD holder, Viejo Valle SA, registered the two RCDs represented below (the 'disputed designs'). The disputed designs relate to crockery. Based on the claim of the acquisition of a copyright, according to French copyright law, incorporated in a previous French design, the Invalidity Division found the contested designs invalid in accordance with Article 25(1)(f) CDR. By two decisions, the third Board of Appeal of OHIM dismissed the RCD holder's appeals (the 'contested decisions').

RCDs	Earlier Copyright
	



**SUBSTANCE:** The RCD holder presented two pleas to the General Court. The first one alleging breach of Article 28(1)(b)(iii) CDIR, on the ground that the applicant for invalidity had failed to fulfil the formal requirements for claiming invalidity based on a previous copyright (Para. 25). The second alleging breach of Article 25(1)(f) CDR, on the ground that the Board of Appeal incorrectly held that the disputed designs constituted unauthorised use of the earlier work under French copyright law (Para. 27). The RCD holder argued that the applicant for invalidity did not present the requisite information concerning the protected works, and in particular the dates on which the works were created and the identification of the actual designer (Para. 44).

The General Court held that Article 25(3) CDR and Article 28(1)(b)(iii) CDIR require that the applicant for a declaration of invalidity, who bases its action on a copyright protected under the law of a Member State, must be the holder of that copyright and it must provide OHIM with the information establishing that fact. The question of whether the applicant for a declaration of invalidity is the holder of the copyright, within the meaning of that provision, and the question of proving that right before OHIM, cannot be answered without having regard to the law of the Member State, in the present case French law, which is relied on in support of the application for a declaration of invalidity. The law of the relevant Member State serves in particular, in that context, to define the procedures for acquiring and proving copyright of the work relied on in support of the application for a declaration of invalidity. The General Court applied the solution established in the context of Article 8(4) CTMR to the substantiation of a copyright in the context of Community design-related disputes (Para. 52).

Previous rulings of the Court of Justice in the trademark framework have established that an opponent or an applicant in invalidity proceedings, relying on the protection of an earlier right under national law (under Article 8(4) or 53(2) CTMR), must provide OHIM with particulars establishing the content of that law, together with particulars showing that the conditions set by the national law for prohibiting use of the later CTM are satisfied. See hereto Case C-96/09P, Anheuser-Busch Inc. / OHIM, (BUD / bud), Para. 188-190, and Case C-263/09 P, Edwin Co. Ltd / OHIM, (ELIO FIORUCCI), Para. 50 where it is stated that 'the applicant should provide OHIM not only with particulars showing that he satisfies the necessary conditions, in accordance with the national law of which he is seeking application, in order to be able to have the use of a Community trade mark prohibited by virtue of an earlier right, but also particulars establishing the content of that law'.)

The Court held that the only relevant question is the identification of the holder of the copyright, which, according to the applicable French case-law, is the natural or legal person under whose name that work is disclosed, in the absence of a claim by the natural person who created the work (Para. 56). The General Court therefore dismissed the first plea insofar as it was based on an alleged inadequacy of information in relation to the protected works and, in particular, on the absence of evidence of the dates of creation of the works, of the identity of the natural person who designed them and of the transfer of that person's rights to the intervener (Para. 59).

On the second plea, alleging breach of Article 25(1)(f) CDR, on the ground that the Board of Appeal incorrectly held that the disputed designs constituted unauthorised use of the work of the intervener, the General Court reminded that the discussion was not about the lack of individual character but confirmed that the only relevant question was whether the applicant for invalidity was the holder of a copyright under French law and whether that copyright was the subject of unauthorised use in the disputed designs (Para. 74).

The General Court observed that the applicant for invalidity had claimed the protection under the French copyright law of two different things that is, the overall appearance of the earlier cup and saucer resulting from their shape and their decorative pattern, and the decorative pattern itself (irrespective of the shape of the product to which it is applied) (Para. 78).

The General Court noted that, under French copyright law, a decoration consisting of surface grooves was in itself apt to be protected under the condition of originality (Para. 79-80). The Board of Appeal was therefore entitled to limit its comparison of the contested RCDs with the earlier work that is, the decoration or finish of the invalidity applicant's crockery (Para. 81).

In order to assess the ground for invalidity, it was not appropriate to compare the designs at issue as a whole, but only to determine whether the work protected by copyright was used in the later designs, that is to determine whether the presence of that work could be noted in those designs, with the result that, in that context, the differences relied on by the RCD holder, such as the shape of the cup or the design of its handle or the shape of the bowl of the soup dish, were irrelevant (Para. 100).

The General Court confirmed that 'it is undeniable that the decoration of the disputed designs greatly resembles the decoration of the intervener's items of crockery, both as concerns the identical nature of the covered surfaces and as concerns the concentric nature, regularity and narrowness of the grooves. The greater thickness and the more pronounced character of the grooves, claimed by the applicant, are not sufficient to obscure that similarity' (Para. 101).

The appeal was dismissed as the RCD holder has not established, before the General Court, that the Board of Appeal erred in finding, on the basis of the elements made available to it, that the decoration of the items of crockery relied on by the invalidity applicant was protected under French copyright law and that that decoration was the subject of an unauthorised use in the disputed designs (Para. 102).

## Knowledge Circle Designs

### EUTMDN Updates

#### Greece and Morocco join TMview

On 11 November 2013, the Greek Ministry for Development and Competiveness (GGE) and the Moroccan Industrial and Commercial Property Office (OMPIC) made their trade mark data available to the TMview search tool.

The integration of OMPIC is a concrete result of the collaboration between OMPIC and OHIM established after the signing of a Memorandum of Understanding (MoU) in June 2013 as part of OHIM's International Cooperation programme.

In terms of GGE, it is the outcome of the Cooperation Fund programme managed by OHIM in collaboration with its EU partners. With GGE on board, the integration of all EU offices in TMview is complete.

This last extension brings the total number of offices participating in TMview to 32 and with the addition of nearly 230 000 Greek trade marks and almost 150 000 Moroccan trade marks, TMview now provides information and access to about 13.2 million trade marks in total.

Since the introduction of TMview on 13 April 2010, the tool has served more than 4.8 million searches from 203 different countries, with users from Spain, Germany and Italy among the most frequent visitors.

You can find out more at [www.tmview.europa.eu](http://www.tmview.europa.eu)

### Members of the Harmonised Database increase to 22

On 12 November, the German Patent and Trade Mark Office (DPMA) became part of the Common Harmonised Database of Goods and Services for trade mark classification.

As a result, the German translations of the Harmonised Database set is now available to all users through the TMclass application.

At the same time the DPMA will also offer the German translations of the Harmonised Database to their e-filing users.

On 25 November, the IP offices of Benelux, Cyprus, Hungary, Latvia and Lithuania, also integrated in the Common Harmonised Database on Classification of Goods and Services.

Thanks to the common efforts made in the framework of the Convergence Programme, the complete set of Benelux, Greek, Hungarian, Latvian and Lithuanian translations of the Common Harmonised Database are now available to all users through the TMclass application.

The Harmonisation Project has been progressing continually since its creation. With the five new members of the 'Harmonisation Community', now 22 EU IP offices form part of the Common Harmonised Database, bringing further benefits for users accross Europe by improving predictability.

More News



### Common Communication on the Common Practice on the General Indications of the Nice Class Headings

The publication of the IP Translator judgment in June 2012, led EU IP offices, IPI (Switzerland), NIPO (Norway), participating user associations, and OHIM, to discuss at length the interpretation of the Nice Class headings and the acceptability of general indications of the Nice Class headings.

Following the release of the Common Communication on the Interpretation of the 'IP Translator', EU IP offices, OHIM and NIPO have now published on their respective websites a second Common Communication on the Common Practice of the General Indications of the Nice Class Headings.

This subsequent Common Communication provides users and offices alike with a list of 11 general indications which lack clarity and precision, and consequently cannot be accepted without further specification. The Communication also details the reasons why each of these unacceptable general indications were deemed insufficiently clear and precise.

This new practice has been reflected in OHIM's Manual on Trade Mark Practice and will enter into force when OHIM launches its new website and new e-filing tool.

[http://oami.europa.eu/ows/rw/resource/documents/CTM/legalReferences/manual/part\\_b\\_3\\_classification.pdf](http://oami.europa.eu/ows/rw/resource/documents/CTM/legalReferences/manual/part_b_3_classification.pdf)

An updated Common Communication on Interpretation of 'IP Translator' has been published on the websites of EU IP offices and OHIM. It shows how each trade mark office interprets the scope of protection of their national trade marks and of Community Trade marks containing all general indications of one or more class, filed before and after the judgment, with the details displayed using an overview composed of six annexes.

## IP Perception Study

On 25 November, President António Campinos presented the study 'European citizens and Intellectual Property: perception awareness and behaviour' at the EU Parliament.

This is the first EU wide study to provide a comprehensive assessment of citizens' perceptions of Intellectual Property (IP) and its infringements, both from a qualitative and quantitative point of view.

The study, commissioned by the Office for Harmonization in the Internal Market (OHIM) acting through the European Observatory on Infringements of Intellectual Property Rights, follows the release in September of a study carried out by OHIM and the European Patent Office showing that Intellectual Property Rights-intensive industries support around 76 million jobs in the EU, and generate 39% of all EU-wide economic activity.

## ISO 9001 whole office certification in 2013

On 15 November, OHIM was awarded the ISO 9001 certificate, now covering all the activities of the Office. This follows the successful audit against the standard that was carried out by the specialist certification organisation det Norske Veritas in early October this year.

This is a major achievement for OHIM. The audit took place two years ahead of the target date as foreseen in the Strategic Plan.

By attaining ISO 9001 for all activities, the Office joins the leading and most progressive organisations in the world, in the private sector as well as the public sector. Furthermore, OHIM is the largest IP office for trade marks and designs in the world to have attained this standard for its work.

The award is due to the dedication, skill, teamwork and collaboration of everyone at OHIM. The preparation activities were significant to ensure that the Quality Management System was ready, and that the staff and service providers were ready too. More important still is the fact that everyone in the organisation now has a stronger and shared understanding of the Quality Policy and how their work contributes to satisfying OHIM's Customers and achieving OHIM's objectives.

Of course, OHIM's Quality journey does not stop at this point. In reality, the achievement is just a new starting point. OHIM's ambition is to be the best. The Office is committed to continually improving its Staff, its Quality Management System, and all of its systems so that it can deliver continually improving services to its Customers and all of its stakeholders.

ISO 9001 certification is not the only international recognised standard attained by OHIM and two further specialised certificates were successfully confirmed through the same external audit by det Norske Veritas: OHSAS 18001 Occupational Health and Safety and ISO 27001 Information Security Management.

## Morocco joins TMclass

We are very proud to announce the integration of the Moroccan Industrial and Commercial Property Office (OMPIC) into TMclass.

This latest addition brings a total of 34 national and regional IP Offices, including OHIM, into the classification of goods and services tool.

Currently OMPIC is integrated in French.

TMclass continues to allow users to search for terms in any of the 27 available languages.

The Moroccan Industrial and Commercial Property Office (OMPIC) is the first North African country to integrate into both TMclass and TMview.

The International Cooperation Programme will be in charge of the implementation of this new cooperation framework.

## OHIM Administrative Board and Budget Committee meetings

From the 19-21 November, OHIM's Administrative Board and Budget Committee met at the Office's Alicante headquarters.

The Administrative Board, at its meeting on Tuesday 19 November, re-elected Mr Mihály Ficsor as Chairperson of the Administrative Board. Delegates gave a unanimous favourable opinion on the Draft Guidelines for Examination, and attendees also endorsed the Convergence Programme project on the Scope of Protection for Black & White Marks.

The Administrative Board is composed of representatives from each Member State and from the Commission, as well as observers from WIPO, EPO and the Benelux Office for Intellectual Property (BOIP).

Following the meeting, the Administrative Board met in joint session with the OHIM Budget Committee on 20 November.

The overview of the Office's activities and progress towards the achievement in the Strategic Plan were the main points on the agenda, though discussions also took place on the new OHIM web solutions, on a number of work programmes, including the Office's Multi Annual Work Plan for the Observatory, and the Communication from the Commission to the European Parliament and the Council on Programming of Human and Financial Resources for Decentralized Agencies 2014-2020.

The Budget Committee then met on 21 November, the final day of the three-day round of meetings. The re-election of Mr Duncan Wearmouth to the post of Deputy Chairperson was followed by the approval of the Office Budget for the year 2014.

As with the Administrative Board, the Budget Committee is comprised of representatives from each Member State and from the Commission, as well as observers from WIPO, EPO and the Benelux Office for Intellectual Property (BOIP).

For all meetings user associations AIM, Business Europe, Marques, ECTA and GRUR were also present.

### **Feasibility study with SIPO on DesignView launched**

OHIM and the State Intellectual Property Office (SIPO, China) participated in their first video conference on 12 November to discuss all the issues regarding the technical documentation for the feasibility study for DesignView and on the next steps to take.

The agreement to launch the feasibility study for DesignView with SIPO was taken at the Heads meeting between President Campinos and Commissioner Tian Lipu (SIPO, China) in Munich on 17 October.

The study is expected to be completed in 2014.

### **TMview and GBD smart button function**

Following the Declaration of Intent published on 21 December 2012, WIPO and OHIM have recently enabled the first stage in the link between TMview, managed by OHIM, and the Global Brand Database managed by WIPO.

The smart button feature, which is now active in both TMview and the Global Brand Database, enables users to search in one tool and then to conduct the same search in the other tool, without the need to input the search criteria again.

This facility marks another milestone in cooperation under the Memorandum of Understanding between OHIM and WIPO, signed on 17 June 2011.

The next development phase, which will involve closer cooperation at data level to provide integrated search results, is planned for 2014.

It will continue the expansion of common functionalities and standards on structure and format of data for the benefit of users, as set out in the 2011 agreement.

## Real Time Satisfaction Survey (RTSS) on Cancellation.

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

As previously carried out for Opposition Proceedings, Ex-Parte proceedings and Designs, the Office will send a RTSS to those owners or representatives who have been involved in a cancellation procedure of any Community Trade Mark during the months of December 2013 and January 2014.

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

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

	2013	2012
Community trade mark applications received	10 568	10 146
Community trade mark applications published	9 247	7 845
Community trade marks registered (certificates issued)	9 022	8 985
Registered Community designs received	7 735	7 569
Registered Community designs published	8 374	7 323

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

## Case law



### Luxembourg Case Law

#### A: Court of Justice: Orders

**Case C-597/12 P; Isdin SA v OHIM; Judgment of 17 October 2013; Language of the case: EN**

**KEYWORDS: Dissimilar signs, Lack of reasoning, Likelihood of confusion, Nice Classification**

**RESULT: Judgment of GC set aside; Case referred back to GC**

**FACTS:** The applicant sought to register a CTM for the word **ZEBEXIR** for goods in Classes 3 and 5. The opponent challenged the application on the ground of likelihood of confusion with the previously registered word CTM **ZEBINIX**, covering, *inter alia*, goods in Classes 3 and 5. The Opposition Division found no likelihood of confusion and rejected the opposition. Subsequently, the Board of Appeal dismissed the appeal, holding that the dissimilarity of the signs is sufficient to exclude a likelihood of confusion, even for identical goods. The GC annulled the decision of the Board, finding an average degree of visual similarity, which in the particular case is especially important as regards all goods in Class 3 and most of the goods in Class 5, because they are marketed in a way that requires visual examination by the consumer. In its appeal the applicant raised several pleas in law before the CJ.

The Office (losing party before the GC) supported two of the five pleas of the applicant before the CJ and challenged the GC's judgment as failing to state reasons with regard to the likelihood of confusion.

**SUBSTANCE:** The CJ based its judgment only on the plea challenging the lack of reasoning in GC's judgment. In order to assess the degree of similarity between the marks, the GC had taken account of the marketing conditions only for a part of the goods concerned in Class 5 (Para. 22). It did not extend this reasoning to the other goods in the same Class but annulled the Board's decision for all goods in that Class (Para. 24). According to settled case-law the examination of the grounds for refusal must be carried out in relation to each of the goods or services for which TM registration is sought (Para. 25). Even though the reasoning may be general for all goods and services concerned where the same ground of refusal is given for a category or group of goods and services (Para. 26), such power extends only to goods and services which are interlinked in a sufficiently direct and specific way as to form a sufficiently homogeneous category or group of goods. The mere fact that the goods are listed in the same Class is not sufficient for a finding that such homogeneity exists (Para. 27). The GC drew a distinction between goods within the same Class on the basis of the conditions under which they are marketed; consequently it was incumbent on the GC to set out reasons with regard to each group of goods which it had established within that Class (Para. 28). Finally, the GC failed to provide adequate reasoning as to enable the parties concerned to know the grounds of the judgment and the CJ to exercise its power of review (Para. 29).

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

**Case T-320/10; Fürstlich Castell'sches Domänenamt Albrecht Fürst zu Castell-Castell v OHIM and Castel Frères SAS; Judgment of 13 September 2013; Language of the case: EN**

**KEYWORDS:** Absolute grounds for refusal, Characteristics of the G&S, Descriptive element, First time on appeal, Geographical indication

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

**FACTS:** The CTM proprietor registered the word CTM **CASTEL** for the following goods in Class 33: 'Alcoholic beverages (except beers)'. The cancellation applicant challenged the registration on grounds of the geographical indication 'Castell', protected for wines in several European countries. The Cancellation Division rejected the application for invalidity. The Board of Appeal dismissed the appeal, holding that even if the term 'Castell' is a German indication of geographical provenance for wines, the signs in conflict differ between them and the disputed mark will not be perceived by the relevant public as designating a place in Germany. It is, therefore, not descriptive of the geographical origin of the goods concerned. An appeal was lodged at the GC. Several pleas in law, alleging infringement of Article 7(1) CTMR, were put forward by the cancellation applicant. The CTM proprietor raised a number of admissibility objections of the action.

**SUBSTANCE:** On the abuse of rights the CTM proprietor claimed that the action is inadmissible because the cancellation applicant filed an application for registration of the word mark CASTEL in Germany while the invalidity proceedings before OHIM were on-going and as *abuse of rights* is a public-policy argument it may be put forward even for the first time before the GC. The admissibility objection has been rejected because it has not been submitted before the Board and '*parties' pleadings may not change the subject-matter of the proceedings before the Board of Appeal*' (Para. 16). Furthermore, the GC held that an argument alleging an abuse of rights in an action brought against a decision of the Board "*cannot play any part as regards the admissibility of that action*" (Para. 18). On the plea alleging infringement of Article 7(1)(d) CTMR, the cancellation applicant claimed that the Board had not examined the appeal in the light of Article 7(1)(d) CTMR of its own motion. The Court held that the plea was inadmissible for two reasons. Firstly, because it was submitted for the first time before the GC and, secondly, and more importantly, because in invalidity proceedings the Board is not required to examine of its own motion all the absolute grounds for refusal, but only those put forward by the applicant. The CTM enjoys a presumption of validity. Therefore, it is for the person who has requested the invalidity of the CTM to invoke, before OHIM, the specific facts which call the validity of the CTM in question. (Paras. 27 - 29). On the references to the administrative file, the CTM proprietor claimed that the general reference of the cancellation applicant to documents submitted to the Departments of OHIM is inadmissible. The GC accepted the admissibility objection since the general reference to documents submitted in OHIM's instances "*cannot be connected to the pleas and arguments developed in the application*" (Para. 35). The summary of the pleas relied on must be sufficiently clear and precise to enable the defendant to prepare its defence and the Court to rule on the action, if necessary without any other supporting information (Para. 34).

The relevant public is the average consumer of everyday consumer goods (Para. 51). The difference between the mark and the geographical indication is insignificant and unable to outweigh the resemblance between them (Para. 70). The contested CTM lacks any additional elements, able to weaken the similarity to the geographical indication (Para. 71). The word 'castel', even though used frequently in the wine sector, usually does not appear by itself and the relevant public is unaccustomed to being confronted with the term used on its own for designation of wines (Para. 73). The difference in meaning cannot alter the finding as to the absence of a perceptible difference between the two terms from a semantic point of view (minimal spelling differences) (Para. 74). Consequently, the disputed CTM will be perceived by the relevant

public as being a reference to the wine-producing municipality of Castell (Para. 76) and must be held to be descriptive of the goods it is registered for (Para. 79). Relevant factors for the above decision are the awareness of the relevant public of the earlier geographical indication (Para. 77), which results in a sufficiently direct and specific link between the disputed mark and 'alcoholic beverages (except beers)', and that the mark will be perceived by the relevant public as designating a characteristic of those goods, namely their geographical origin (Para. 78).

**Case T-285/12; The Cartoon Network, Inc. v OHIM; Judgment of 2 October 2013 Language of the case: EN**

**KEYWORDS: Coexistence of trade marks, Complementary goods and services, Declaration, Evidence of use, Likelihood of confusion, Specialised public**

**RESULT: Action dismissed**

**FACTS:** The applicant sought to register the word mark **BOOMERANG** for services within Classes 38 and 41. An opposition based on the earlier figurative mark **Boomerang**, represented below, registered for services in Class 41, was filed on the grounds of Article 8(1)(b) CTMR. The Opposition Division upheld the opposition. The Board of Appeal dismissed the applicant's appeal. The applicant filed an action before the General Court.

CTM applied for	Earlier Mark
BOOMERANG	

**SUBSTANCE:** The Court upheld the Board's finding of LOC, and dismissed the appeal. Film production services are aimed solely at professionals and not the general public (Para. 22). Although such services may be provided to broadcasters who are influenced by the general public, this does not mean that the general public is itself the target public (Para. 23). However, the Court agreed with the Board of Appeal that, owing to the existence of a strong similarity between the conflicting marks and a similarity between the services in question, there is a likelihood of confusion for professionals. The error of including the general public in the definition of the relevant public therefore had no consequence for that finding (Para. 45). Regarding the mark applied for, the Court held that those services were directed not only to the general public but also to a specialised public of broadcasting professionals. Regarding complementarity of services, the earlier mark's film 'production services' and the applied-for mark's 'broadcasting services' are different in nature and purpose (Para. 29), but the services are often carried out by the same undertakings, and film producers can develop broadcasting services (Para. 31). Further, the relevant public can coincide (Para. 32) and audio-visual content is generally produced and made so that it can then be broadcast to the public, showing a close connection between the services (Para. 33). Accordingly the services are complementary. The applicant's assertion that professionals will perceive this theoretical complementarity of content production and delivery but that they will be aware of their different positions in the 'supply chain' and will see them as distinct services, was held to be of no relevance for the assessment of their complementarity (Para. 34). The Court held that the wording used by the Board of Appeal, that the similarity between the signs 'reinforces' the degree of similarity, although not corresponding precisely to the words used in the case-law, clearly refers to the idea of the interdependence of factors and 'offsetting' in the case-law, and was not wrong in law (Para. 48). Similarly, the Board's use of the expression that a likelihood of confusion 'cannot be excluded' clearly meant no more than 'a likelihood of confusion exists' (Para. 49). Regarding the applicant's arguments of coexistence of the marks, the Court noted that to substantiate such a claim, it is necessary to demonstrate that the coexistence of the marks on which it relied was based on the absence of a likelihood of confusion on the part of the relevant public (Para. 56). However, in this case the evidence related solely to the applied-for mark with no indication of the way in which the relevant public encountered the conflicting marks on the market and the services for which they were used. Nor can use of the signs on the market be inferred from the national registers, and the affidavit from the applicant itself was held to be disputable evidence unsubstantiated by independent sources (Para. 59). The Court therefore confirmed that the Board was correct to consider that that evidence was insufficient to demonstrate the coexistence of the conflicting marks.

**Case T-379/12; Electric Bike World Ltd v OHIM; Judgment of 15 October 2013; Language of the case: EN.**

**KEYWORDS:** Likelihood of confusion, Nature of the goods and services, Purpose of the goods and services, Relative grounds, Similarity of the goods and services, Similarity of the signs

**RESULT:** Action dismissed

**FACTS:** The applicant sought to register the word mark "LIFECYCLE" as a CTM for goods in Classes 12, 18 and 25. An opposition based on the earlier word mark "LIFECYCLE", registered for goods in Class 28, was filed on the grounds of Article 8(1)(b) CTMR against all the goods in Class 12. The Opposition Division dismissed the opposition in its entirety. The Board of Appeal partly upheld the opponent's appeal. The applicant filed an action before the General Court.

**SUBSTANCE:** The GC rejected the CTM applicant's plea alleging an infringement of Article 75 CTMR so far as it did not provide any specific reasoning as regards the similarity between, on the one hand, *electric bicycles; motorised bicycles* in Class 12 and, on the other, *exercise bikes* included in the goods *machines for physical exercises* in Class 28. The GC stated that, since *regular bicycles, electric bicycles and motorised bicycles* do form part of a homogenous group, the Board of Appeal was entitled to confine itself to general reasoning for *bicycles and electric or motorised bicycles* and, therefore, the Board of Appeal fulfilled its obligation to state reasons, as provided for in Article 75 (Paras. 38, 39). With regards to the plea of infringement of Article 8(1)(b) CTMR, the GC noted that the similarities between *electric or motorised bicycles* and *exercise bikes* are sufficient to establish at least a slight similarity between those goods (Paras. 44 to 48). Therefore, since the signs are identical, the Board of Appeal correctly found that, in accordance with the principle of interdependence, the low degree of similarity between the goods is offset by the identity of the signs. Therefore, despite consumers' higher degree of attentiveness, there is a likelihood of confusion.

**Case T-453/12; Zoo Sport Ltd v OHIM and K-2 Corp.; Judgment of 16 October 2013; Language of the case: EN**

**KEYWORDS:** Conceptual dissimilarity, Conceptual similarity, Likelihood of confusion, Phonetic similarity, Visual similarity

**RESULT:** Action dismissed

**FACTS:** The applicant sought to register the word mark **ZOOSPORT** for goods and services in Classes 18 ('sport bags'), 25, and 35. The registration was opposed by the opponent based on the opponent's earlier community word mark **ZOOT** as well as its figurative mark, as displayed below, registered, *inter alia*, for goods and services in the Classes 25 and 35. The grounds relied on in support of the opposition were Article 8(1)(a) and (b) and Article 8(5) CTMR. The Opposition Division upheld the opposition for the goods in Classes 18 and 25 and rejected it as to the remainder. The applicant appealed and the opponent filed a cross appeal demanding the opposition upheld also for the services in Class 35. The Board allowed the appeal regarding 'Sport Bags' in Class 18 and dismissed it as to the remainder. The cross appeal was dismissed due to inadmissibility as it did not meet the time limits and fee requirements in Article 60 CTMR. The applicant raised a plea to the General Court alleging breach of 8(1)(b) CTMR.

CTM applied for	Earlier Mark
ZOOSPORT	

**SUBSTANCE:** The relevant public consists of the general public in the European Union. For such sports equipment the level of attention of the relevant consumer would be average and would not increase in accordance with the price (Para. 42). It is not sufficient for an applicant to state that, in a given sector, consumers are particularly attentive to marks. Such claims must be substantiated with facts or evidence (Para. 35). The goods in Class 25 are identical given that the marks cover clothing and footwear, and that 'maillots' are included in the category of clothing covered by the earlier figurative mark, just as 'sports shoes' are included in the category of footwear covered by the earlier figurative mark (Para. 44). The visual aspect plays a greater role in the global assessment of the likelihood of confusion for clothing as

the choice of the item of clothing is generally made visually (Para. 66). For each of the signs, the dominant element contains three or four letters respectively and shares the letter sequence 'z' 'o' 'o', which is visually striking in all languages of the European Union. Similarly, the two signs have the same construction, in that the dominant element is juxtaposed with the evocative word 'sport' or 'sports' which occupies a secondary position in relation to the other element. Although the symmetry characterising the earlier figurative mark is not found in the mark applied for, the signs have an average degree of visual similarity (Paras. 63, 64). The signs are distinguished by the letter 't', or possibly 'z', of the earlier figurative mark. The signs are phonetically similar to an average degree as the phonetic impact of the last letter 't' or 'z' does not offset the global similarities resulting from pronunciation of their common element 'zoo' (Para. 75). The signs have the word 'sport' or 'sports' in common, which supports the view that there is some conceptual similarity between the signs, although that conceptual similarity cannot totally neutralise the conceptual difference which exists between 'zoo' and 'zoot', or possibly 'zooz', however, no significant conceptual difference exists between the signs (Paras. 85-87). Due to the identical nature of the goods and taking account of the average visual and phonetic similarity of the signs and the fact that, conceptually, the comparison of the signs does not establish a significant difference between them, it must be held that there is a likelihood of confusion on the part of the relevant public between the mark applied for and the earlier figurative mark (Paras. 93-95).

**Case T-455/12; Zoo Sport Ltd, v OHIM; Judgment of 16 October 2013; Language of the case: EN**

**KEYWORDS: Conceptual dissimilarity, Conceptual similarity, Likelihood of confusion, Phonetic similarity, Visual similarity**

**RESULT: Action dismissed**

**FACTS:** The applicant sought to register the figurative mark **zoo sport**, shown below, for goods and services in Classes 18 ('sports bags'), 25 and 35. The opponent opposed the registration based on the CTM word mark **ZOOT** and the Figurative CTM, as displayed below. The grounds relied on in support of the opposition were those set forth in Article 8(1)(a) and (b) and Article 8(5) CTMR. The Opposition Division upheld the opposition in relation to the figurative mark pursuant to Article 8(1)(b) CTMR for all of the goods in Classes 18 and 25, and rejected the opposition as to the remainder. The opposition based on Article 8(5) was rejected as reputation had not been proved. The applicant appealed to the Board of Appeal and the opponent filed a cross-appeal requesting the opposition to be upheld also regarding the services in Class 35. The Board allowed the applicant's appeal regarding 'sports bags' and dismissed it as to the remainder. The cross appeal was dismissed due to inadmissibility as it did not meet the time limits and fee requirements in Article 60 CTMR. The applicant raised a plea to the General Court alleging breach of 8(1)(b) CTMR.

CTM applied for	Earlier Mark
	

**SUBSTANCE:** The goods are aimed at the general public and the level of attention of the average consumer must be considered normal (Para. 35). The Board did not err in finding that the level of attention of the relevant consumer would be average and would not increase in accordance with the price (Para. 42). The goods in Class 25 are identical given that the marks cover clothing and footwear, and that 'maillots' are included in the category of clothing covered by the earlier figurative mark, just as 'sports shoes' are included in the category of footwear covered by the earlier figurative mark (Paras. 44, 45). The visual aspect plays a greater role in the global assessment of the likelihood of confusion for trademarks assigned to clothing as the choice of the item of clothing is generally made visually (Para. 68). The symmetrical effect which characterises the earlier figurative mark is not found in the mark applied for. The typefaces used differ between the marks. However, the signs still have an average degree of visual similarity (Para. 65). Although the signs are distinguished by the fact that the letter 't', or possibly 'z', of the earlier figurative mark must be pronounced, which will not be the case for the mark applied for, that difference is not sufficient to reject that the signs are phonetically similar to an average degree. The phonetic impact of the last letter 't' or 'z' does not offset the global similarities resulting from pronunciation of their common element 'zoo' (Para. 77). Regarding conceptual similarity, the signs have the word 'sport' or 'sports' in common, which supports the view that there is some conceptual similarity between them although this similarity cannot totally neutralise the conceptual difference which exists between 'zoo' and 'zoot', or possibly 'zooz' (Para. 88). The signs are visually and phonetically similar to an average degree. Conceptually the signs do not reveal a

significant difference between them (Para. 91). Due to the identical nature of the goods, the average visual and phonetic similarity of the signs and the fact that, conceptually, the comparison of the signs does not establish a significant difference between them, it must be held that there is a likelihood of confusion on the part of the relevant public between the mark applied for and the earlier figurative mark (Para. 98.)

**Case T-282/12; El Corte Ingles & Nadia Mariam Sohawon v OHIM; Judgment of 16 October 2013; Language of the case: ES**

**KEYWORDS: Relative grounds for refusal, Retail services, Similarity of the goods and services, Similarity of the signs**

**RESULT: Action dismissed**

**FACTS:** The applicant sought to register the figurative mark represented below as a CTM for goods and services in Classes 25, 35 and 41. An opposition based on the earlier marks **FREE STYLE**, registered for goods in Classes 3, 18 and 25, was filed on the grounds of Article 8(1)(b) CTMR. The Opposition Division rejected the opposition on the basis of a lack of similarity of the signs, pursuant to Article 8(1)(b) CTMR. The Board of Appeal partially annulled the decision and rejected the CTMA for goods in Class 25. The opponent appealed the case to the General Court.

CTM applied for	Earlier CTM and Spanish trademarks
	<p style="text-align: center;"><b>FREE STYLE</b></p>

**SUBSTANCE:** The Court held that the Board of Appeal was correct in the finding that goods in Class 25 may be similar to retail services in Class 35 (Paras. 37-39). On the visual comparison of the signs, the General Court confirmed the Board's assessment that visually the similarity is weak (Para. 42). Phonetically, the General Court also confirmed that the similarity of the signs is average as the elements "free" and "style" will be pronounced the same way in all languages (Para. 43). As regards the element "your" of the contested mark its presence is not sufficient to conclude that the signs are dissimilar. On the conceptual side, the General Court confirmed the approach of the Board when it distinguished the consumers with good knowledge of English, those who have a basic understanding and those who have no comprehension of English at all. For those who have a good understanding of English the signs are different as the contested sign means 'Free your style' and the earlier right means 'free style'. For those who have a basic understanding of English, the semantic difference between the signs will not be perceived; the signs will therefore be similar for this public. Finally, for those who do not understand English no conceptual comparison is possible. The conceptual assessment done by the contested decision is therefore approved (Para. 44). On the comparison of goods and services, the services covered by the contested mark are similar to the goods covered by the earlier sign, however the signs have a weak similarity from the visual point of view but are similar on the phonetic side. The goods and services and the signs do not have the degree of similarity to create a risk of confusion (Para. 51). Finally, in relation to the earlier Spanish mark: As this one is identical to the CTM, the same conclusions apply in relation to the relevant Spanish public.

**Case T-328/12; Mundipharma GmbH v OHIM; Judgment of 16 October 2013 Language of the case: DE**

**KEYWORDS: Beginning of mark, Conceptual dissimilarity, Descriptive element, Distinctive element**

**RESULT: Action dismissed**

**FACTS:** Overturning the decision of the Opposition Division, the Board of Appeal decided that the remote visual and phonetic similarity between the earlier mark **OXYGESIC** and the CTMA **MAXIGESIC**, combined with their conceptual dissimilarity resulted in an exclusion of likelihood of confusion even for identical goods (pharmaceutical preparations), especially given the enhanced level of attention of the relevant public. The opponent filed an action before the Court claiming an infringement of Article 8(1)(b) CTMR.

**SUBSTANCE:** Even for identical goods there is no likelihood of confusion. The visual and phonetic similarity cannot compensate the conceptual differences between the trademarks and cannot lead to the likelihood of confusion on parts of the relevant public, whose level of attention is enhanced. The level of attention of the relevant public is enhanced, but not "very high" as submitted by the CTM applicant (intervener before the Court). As far as the CTM applicant's (intervener's) argument is to be understood as an independent plea in law based on Article 134(2) RoP, that plea is incompatible with the form of order it is seeking and must be rejected, since the intervener has not applied for the annulment or alteration of the contested decision under Article 134(3) RoP (Para. 29). Within the trademark comparison it has to be noted that the common element "-gesic" will be understood as a reference to the word "analgesic" and is descriptive for the goods in question (Paras. 35 et seq., 47). The relevant public generally does not consider a descriptive element forming part of a complex mark as the distinctive and dominant element in the overall impression conveyed by that mark (Para. 33 with reference to further case-law). The visual similarity is low, due to different beginnings (Para. 49), the phonetic similarity is average (Para. 50-52), both trademarks have different conceptual connotation, with MAXIMUM or OXYgen, respectively (Para. 53).

**Case T-417/12; SFC Jardibric v OHIM; Judgment of 23 of October 2013; Language of the case: EN**

**KEYWORDS: Acquiescence, Complementary goods and services, Conceptual similarity, Likelihood of confusion, Visual similarity**

**RESULT: Action dismissed**

**FACTS:** The CTM owner has the figurative CTM 'AQUA FLOW' for goods in Classes 6, 11, 17 and 21. A request for a declaration of partial invalidity was filed on the grounds of Article 8(1)(b) and Article 53(1)(a) CTMR. It was based on the earlier Spanish figurative mark **VAQUA FLOW**, shown below, registered for goods in Class 11. The Cancellation Division partially upheld the application for a declaration of invalidity, namely in relation to the goods in Classes 6, 11 and 21. The Fourth Board of Appeal upheld the decision of the Cancellation Division in its entirety. The CTM owner appealed the case to the General Court.

CTM	Earlier Mark
	

**SUBSTANCE:** The CTM owner alleged the infringement of Article 54(2) and of Article 8(1)(b) CTMR. As regards the first plea, the CTM owner alleged limitation in consequence of acquiescence. The General Court found, firstly, that the Board was right to refuse to take into account the late documents produced by the CTM owner (Para. 38). Secondly, the GC pointed out that the period of limitation in consequence of acquiescence starts to run from the time when the proprietor of the earlier trade mark is made aware of the use of the later CTM and not, as the CTM owner submitted, from the registration of the contested CTM. Accordingly, the CTM owner should have demonstrated that the invalidity applicant had acquiesced in the use of the contested CTM in Spain from the relevant date (Para. 40). Thirdly, the fact that the invalidity applicant was aware of the existence of the French trade mark AQUA FLOW did not mean that it had acquiesced in the use of the CTM in Spain (Para. 41). As a consequence of the above, the GC considered that the Board had not infringed Article 54(2) and rejected the CTM owner's first plea (Para. 42-43).

As far as the second plea is concerned, the GC stated, first, that the relevant public mainly consisted of Spanish professional consumers involved in the watering and irrigation industry and also of members of the general public, such as Spanish do-it-yourself enthusiasts, the degree of attentiveness of the latter being higher than average (Para. 51). As regards the comparison of the goods, it was found that, despite their different wording, the goods in Class 11 were identical (Para. 55). The goods in Classes 6 and 21 of the CTM were considered to be complementary, and thus similar, to the goods in Class 11 of the earlier mark (Para. 57).

With respect to the comparison of the signs, the GC set out that, from a visual perspective, the difference between the marks (the letter 'v' at the beginning of the earlier sign) could not counteract their similarities, with the result that there was an average degree of visual similarity (Para. 64). This conclusion could not be altered by the graphic layout and colours of the marks, likely to be perceived as decorative, non-decisive elements (Para. 65). Phonetically, the signs were found to be highly similar: Although the distinguishing feature is at the beginning of the earlier sign, this cannot counteract the overall impression of phonetic similarity (Para. 68). Conceptually, the relevant consumers would associate 'aqua flow' and 'vaqua' with the Spanish term 'agua' (water) and in that sense the signs are conceptually similar to an average degree (Para. 73). As a result, the GC concluded that there was a likelihood of confusion between the confronted signs and rejected the second applicant's plea (Para. 75).

**Case T-114/12; Bode Chemie GmbH & Laros S.r.l. v OHIM; Judgment of 23 October 2013; Language of the case: FR**

**KEYWORDS: Enhanced distinctiveness, Likelihood of confusion, Relative grounds, Similarity of the goods and services, Similarity of the signs**

**RESULT: Action dismissed**

**FACTS:** The CTM applicant sought to register the figurative mark **sterilina**, represented below, as a CTM for goods in Classes 3 and 5. An opposition based on several earlier CTMs, the relevant one being the word CTM **STERILLIUM**, registered for goods in Class 5, was filed on the grounds of Article 8(1)(b) CTMR. The Opposition Division rejected the opposition on the basis of a lack of similarity of the signs, pursuant to Article 8(1)(b) CTMR. The Board of Appeal rejected the appeal and confirmed the decision of the opposition division. The applicant appealed to the General Court.

CTM applied for	Earlier CTM
	<p data-bbox="842 1350 1007 1379" style="text-align: center;"><b>STERILLIUM</b></p>

**SUBSTANCE:** The Court held that the Board of Appeal was correct in finding that the relevant public is composed of consumers with a normal level of attention in relation to daily hygienic products or higher in relation to medical and pharmaceutical products. On the comparison of goods, some of the products included in the Classes 3 and 5 are identical or similar to the products included in the earlier registrations. Others are different.

The General Court held that the signs share a certain similarity due to the presence, in both signs, of the prefix 'steril'. Nevertheless, the signs also present some differences, in particular the endings 'INA' and 'LIUM'. The General Court took note of the presence of a white cross, a figurative element depicted in the contested sign, which because of its size and place affects the overall impression. The same effect could also be produced by the bright red colour of the contested sign. Even if these graphic elements may be considered as weak, from the point of view of distinctiveness, they are not negligible. From the visual point of view, the Board of Appeal was right when it concluded that the degree of visual similarity is weak. Phonetically, the General Court noted that the conclusion of the Board of Appeal, that the signs had only an average degree of similarity because of the different verbal elements, was not challenged by the applicant. Finally, on the conceptual side, the General Court confirmed the conclusion of the Board of Appeal that the signs share a certain degree of similarity. The prefix 'steril' shared by the two signs will be understood by the relevant public as a link to products sterilised or having the capacity to sterilise. This link is reinforced by the presence of the white cross in the

contested sign which evokes a medical context. The General Court held that the prefix 'steril' is descriptive for the products concerned and, as a consequence, has to be analysed as having a weak distinctive character. As correctly pointed out by the Board of Appeal, the suffixes of the signs will occupy a more distinctive place in the identification of the commercial origin of the goods (Para. 31). In relation to the claim of enhanced distinctiveness of the earlier verbal mark STERILLIUM, the General Court confirmed the assessment of the Board of Appeal that the documents and evidence filed did not suffice to demonstrate this argument.

The conclusion that there was no likelihood of confusion was therefore confirmed by the General Court. As the verbal mark was the closest sign to the contested CTM application the General Court did not examine the figurative earlier CTM.

**Case T-416/11; Biotronik SE & Co. KG v OHIM and Cardios Sistemas Comercial e Industrial Ltda; Judgment of 25 October 2013; Language of the case: EN**

**KEYWORDS:** Admissibility, Declaration, Evidence of use, Extent of use, First time on appeal, New evidence, Proof of use, Sales figures

**RESULT:** Action dismissed

**FACTS:** The CTM applicant sought to register the word mark **CARDIO MANAGER** for goods in Classes 9 and 10. The opponent challenged the application on the ground of likelihood of confusion on the basis of the previously registered German word mark **CARDIO MESSENGER** for goods in Classes 9 and 10. The opposition and the appeal filed before the Boards were rejected because of lack of sufficient evidence of use. In the appeal before the GC, the opponent adduced new evidence, contested the assessment of the evidence by the Board and alleged an infringement of Article 8(1)(b) CTMR.

**SUBSTANCE:** On the admissibility of new evidence, the GC held that any additional evidence, presented for the first time in the proceedings, could not be taken into account (Para. 20). The legality of a decision of a Board of Appeal of OHIM must be assessed in the light of the information available to it when it adopted that decision (Para. 19). On the admissibility of the plea in law alleging infringement of Article 8(1)(b) CTMR, the GC concluded that since the Board did not address the question whether there was LoC, the GC could not review this issue. Thus, the plea is not admissible (Para. 22).

The GC found that the opponent did not provide sufficient evidence to prove the genuine use of its registration. A reference was made to established case law, according to which genuine use is defined as use in accordance with the main function of the mark to distinguish the goods and services of one undertaking from those of other undertakings, in order to create or maintain a market for those goods and services (Para. 29). The mark must be used publicly and outwardly (Para. 30). For the assessment of genuine use, all relevant factors must be taken into account, as market share, nature of the goods, character of the market, scale and frequency of use (Para. 31). Although commercial success is irrelevant (Para. 32), solid and objective evidence of actual and sufficient use of the mark on the market concerned must be presented (Para. 33). After reviewing the material submitted before the Board (training and presentation documents, scientific publications, extracts from instruction manuals, Internet pages, packaging for products and a formal statement by the opponent), the Court concluded that they do not provide indications as to the extent of use, the volume of sales, the advertising turnover, or the market share. More precisely, the GC held that the manual relates only to the way in which the patient is to use the product and that it does not provide any additional solid evidence of use of the TM. It is not possible to extract from the manual the information necessary for verifying use, such as the place of sale, the sales systems and the quantities of goods sold. The GC held that the above finding applies also to the product packaging and to the Internet pages. Finally, as regards the affidavit comprising a statement of the opponent's Vice-President, the Court held that the value of such document is lower than the value of a statement from an independent source and the information contained in it must be supported by other information (Para. 41).

## New Decisions from the Boards of Appeal

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

Please note that the full number including slash has to be entered in our database under 'Appeal N°', without the letter 'R'.  
e .g. Case R 219/2004-1 has to be entered under 'Appeal N°' as: 0219/2004-1

### Decision of the Second Board of Appeal of 28 August 2013 in Case R0125/2013-2 - EN

*Ex parte - Article 7(1)(b) CTMR*

The applicant filed the figurative IR



with a designation to the EU, for 'footwear' in Class 25.

The examiner issued a notification of *ex officio* provisional total refusal. She stated that the mark was devoid of any distinctive character pursuant to Article 7(1)(b) CTMR.

The IR holder responded to the examiner's objection.

The examiner maintained her objection under Article 7(1)(b)CTMR and issued the contested decision, which refused protection of the international registration for the European Union because:

- A 'banal tag' on footwear is common in the footwear sector;
- Consumers are accustomed to seeing decorative elements on shoes. There is nothing 'unusual' about the mark;
- The mark ('the shield') cannot be distinguished from other geometrical elements;
- Consumers are not in the habit of making assumptions about origin based on a banal tag. It would be seen as functional or decorative.

The IR holder filed an appeal and the corresponding grounds of appeal. It is based on the following arguments:

- The mark is a so-called 'position mark'. It consists of a device element in the form of a shield, positioned on the shoe above the sole but beneath the laces. Therefore, it not only consists of a stylised shield, but also of a particular position;
- It is capable of being registered as a trade mark;
- The evaluation criteria for the distinctive character of a trade mark must be the same for all the different categories of trade marks;
- The figurative element of the stylised empty-pointed triple-bordered shield is undeniably an element entirely independent of the shape of the shoe. It is an additional element. The mark has a minimum degree of distinctiveness;
- An examination under absolute ground is not a test of novelty, in the sense of creativity;
- The device element is therefore not a 'banal tag', but a distinctive badge of trade origin.

The Board of Appeal found that the mark clearly stands out as a device of a shield positioned on the side of a sports shoe. Although not entirely clear in the representation, the shield is also enclosed within a three-parallel-lined border. It added that the mark is not a simple geometric shape like a rectangle or circle. On the contrary, it is a relatively complex structure comprising two curved sides with a bevelled pointed top. In other words, it appears as a 'shield'. In the Board's view, it cannot be dismissed as a mere 'banal tag'. Devices like the IR holder's have become increasingly common on clothing and particularly on footwear over many years. The public have become accustomed to identifying a particular brand of running shoe or sports shoe based only on a distinctive pattern or design.

The Board concluded, contrary to what the examiner decided, that although the CTM applied for is not abundant in creative effects and it is not particularly original, for a mark to be registrable, it is not necessary that it be original or fanciful. All it needs to possess to act as a functioning trade mark is a minimum degree of distinctive character. Nothing more is required. In this respect, the mark displays that necessary minimum degree of distinctive character. As noted

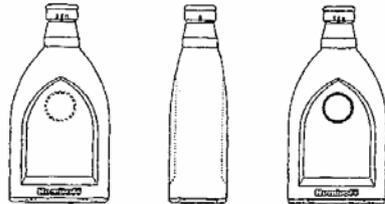
above, it does not consist of a common geometric shape; on the contrary, it is sufficiently eccentric in geometric terms to defy being described as a 'banal tag'. It is a pointed shield, positioned on the side of a shoe. The 'shield' possesses a triple-line border. Furthermore, the 'shield' does not give the impression of being a piece of functional stitching, or of being woven into the shoe as part of its necessary construction. On the contrary, it stands out as an independent design. Moreover, a shield has no particular significance for footwear and must be deemed fanciful.

For those reasons, the appeal was granted and the contested decision annulled.

### Decision from the First Board of Appeal of 5 September 2013 in case R 210/2012-1 EN

*Cancellation – Article 53(2)(c) CTMR, Article 53(1)(a) CTMR in conjunction with Article 8(1)(b) CTMR-*

The IR holder is the owner of the following three-dimensional international trade



mark registration No 850 398 claiming the word 'Nemiroff' and designating the European Union. It covers the following goods: Class 33 - Alcoholic beverages, namely vodka.

The cancellation applicant filed a request for a declaration of invalidity against the contested IR based on the following grounds:

- Article 53(1)(a) CTMR in conjunction with Article 8(1)(b) CTMR. The contested IR is confusingly similar to its earlier three-dimensional Polish trade mark No 109 294 'CK VODKA'



registered for 'alcoholic beverages' in Class 33.

- Article 53(2)(c) CTMR. The cancellation applicant claimed to be owner of an earlier copyright in a three-



dimensional design of a bottle and that this work was protected in Poland and in all Member States through the Berne Convention for the Protection of Literary and Artistic Works of 9 September 1886 and relied on the Polish Copyright Act of 4 February 1994 which was submitted as evidence.

The IR holder filed a reply and required the cancellation applicant to prove genuine use of the earlier mark. The cancellation applicant filed further observations and submitted evidence of the earlier mark's use. The IR holder filed a rejoinder asserting that the cancellation applicant had failed to prove genuine use of the earlier mark due to the lack of translations of the documents submitted.

The Cancellation Division upheld the application for a declaration of invalidity for the contested goods on the grounds of Article 53(2)(c) CTMR. It based its decision, *inter alia*, on the following reasons:

- Use of the contested IR, according to Polish copyright law would infringe the cancellation applicant's earlier copyright.
- The cancellation applicant established that the Polish Copyright Act of 4 February 1994 admits that a work consisting of a three-dimensional design may be protected as a copyright, provided that it has 'individual character'... and grants to the author (or his/her successor in title) both the exclusive right to commercially exploit the creation and the power to prohibit unauthorised use thereof by third parties;
- The cancellation applicant has established that the ornamental design was filed prior to the contested IR. Particularly, according to the protection certificate issued by the Polish Patent Office, it was filed on 18 December 1996 and claimed a priority of 12 April 1995;
- The cancellation applicant successfully showed that is the entitled successor of the right given by the ornamental design's author;
- The ornamental design at issue has particular characteristics as its sides resemble the shapes of gothic windows, which meet the criterion of 'arbitrary';
- The shapes are visually similar overall as the bottles have a nearly identical body and slightly diverging form in the cylindrical cap, which only accounts for a negligible difference.
- Since the contested IR would not be distinguishable from the most relevant features of the cancellation applicant's shape, it would be considered as an imitation of that work protected by the earlier copyright.

In the present case, the bottles are used in connection with identical products and are, therefore, directed at the same public, even if Polish law does not require this condition.

The IR holder filed an appeal.

The Board states that the IR holder submits that at most the protection of the cancellation applicant's design of a bottle is regulated under the Law of 10 July 1952 on Copyright, which granted a different term of protection, namely only 25 years from the date of the design's creation. From that, it follows that even if the existence of copyright protection for the cancellation applicant's bottle were admitted, it should have already expired. The Board also finds that, indeed, the IR holder is right in stating that without indicating the exact date of creation of the prior design, it is impossible to understand whether the shape of the bottle at issue was commonplace and thus, whether or not it complies with the requirement of a certain copyright regime in Poland. As a result, the contested decision could be considered to be based on the wrong applicable law, and consequently be annulled.

Nevertheless, the Board declared the contested CTM invalid on the basis of Article 53(1)(a) CTMR in conjunction with Article 8(1)(b) CTMR because of a likelihood of confusion, given the identity of the goods and the high similarity between the marks.

#### **Decision from the Second Board of Appeals of 6 September 2013 in Case R 1538/2012-2 101 / 501 – EN**

##### *Opposition – Article 8(1)(b) CTMR*

The applicant sought to register the word mark '**101**' for goods in Classes 13, 25 'clothing, footwear, headgear' and 28.

The opponent filed an opposition against the mark applied for based on earlier Community trade mark registration No 26 708 of the word mark '**501**,' registered for the following goods:

Class 16: Paper, cardboard and goods made from these materials (included in Class 16); printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; instructional and teaching material (except apparatus); plastic materials for packaging (included in Class 16); playing cards;,,

Class 18: Leather and imitations of leather, and goods made of these materials (included in Class 18); animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery;

and Class 25: Clothing, footwear, headgear.

The opponent invoked Article 8(1)(b) and 8(5) CTMR. It directed its opposition against part the goods of the mark applied for, namely 'clothing, footwear, headgear' and based it on all the goods of its earlier mark.

The Opposition Division issued a decision by which it rejected the opposition in its entirety and ordered the opponent to bear the costs.

The opponent filed an appeal against the contested decision.

The Board states that it is undisputed that the goods are identical. The signs are visually similar to the extent that they coincide in the digits '01'. On the other hand, a clear difference consists in that they differ in the first digit, '5' and '1', respectively. It adds that the length of the signs may influence the effect of differences between the signs. The shorter a sign, the more easily the public is able to perceive all its single elements. Thus, even small differences may frequently lead in short words (or numbers) to a different overall impression. Both signs are short marks in the case at hand. As such they are not difficult to read and each one is likely to be easy to recall. Further, the consumer's attention is usually directed at the beginning of the word. In the Board's opinion, the same would apply to marks consisting of a few numbers. As stated in the contested decision, the symmetry and asymmetry of the numbers '101' and '501', respectively, have such an impact on the overall impression that they clearly outweigh the common features, the digits '01', in the signs. The conclusion must, therefore, be that the signs are not visually similar overall.

Aurally, as correctly noted in the contested decision, irrespective of the different languages in different parts of the relevant territory, the pronunciation of the marks coincides to a varying degree depending on how the numbers '501' and '101' are pronounced. For example, in English: /five-hundred-one/ [US English], /five-hundred-and-one/ [UK English] or /five-o-one/ versus /a hundred-(and-) one/, /one-hundred-(and-)one/ or /one-o-one/. Thus, the pronunciation of the signs clearly differs in the sound of the number five versus one. Also in the aural impression the consumer's attention is usually directed at the beginning of the word. The difference at the beginnings of the marks has such an impact on the overall phonetic impression that it clearly outweighs the common features, the numbers '01', in the signs. The conclusion must, therefore, be that the signs are not aurally similar overall either. In addition, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods. This is the case with respect to the goods at issue.

Conceptually, the contested decision found that the signs have no concept in common, since according to Office practice, numbers as such have no concept. The Board notes that even if it were considered that numbers have a concept, in this case, as the marks consist of two different specific numbers, they are conceptually different.

Since overall the signs are not considered similar or identical, there can also be no likelihood of confusion in accordance with Article 8(1)(b) CTMR, even if the earlier mark were to enjoy enhanced distinctiveness.

The Board confirms that even if the goods are identical (Class 25 – Clothing, footwear, headgear), the clear differences between the marks suffice to conclude that they are dissimilar overall and to safely exclude a likelihood of confusion.

#### Article 8(5) CTMR

It follows from this provision that it must be determined, (a) whether the contested mark is identical to those earlier marks claimed by the opponent or is similar to them; (b) whether those marks have a reputation; and (c), whether the use without due cause of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade marks. Those conditions are cumulative; failure to satisfy one of them is sufficient to render inapplicable the provisions of Article 8(5) CTMR.

Due to the clear differences between the signs which have been discussed above, the Board is of the opinion that the marks are sufficiently dissimilar so that the degree of similarity is not such that the relevant public would establish a link between the two signs.

Thus, since one of the three cumulative conditions for the application of Article 8(5) CTMR are not satisfied, the appeal also has to be rejected insofar as it was based on Article 8(5) CTMR.