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INTA TMAP meeting at OHIM

By J Scott Evans, President of INTA

At the International Trademark Association (INTA), we recognize the value and importance of trademark administrators (TMAs), also known as paralegals, in the field of trademark law. We have a dedicated Trademark Administrators Committee that is focused on developing, implementing and maintaining various educational programs and resources for TMAs, as well as initiatives to enhance professional development opportunities for TMAs and elevate the prominence of TMAs within INTA and the practice area.

One of our tailored offerings is the highly popular Trademark Administrators and Practitioners (TMAP) Meeting. The TMAP Meeting offers trademark administrators, young practitioners, and legal professionals with exceptional educational programming and one-of-a-kind networking opportunities.

For the first time ever, INTA is proud to host the TMAP Meeting outside the United States in Alicante, at the premises of the Office of Harmonization in the Internal Market (OHIM). The special location of the 2015 TMAP Meeting will provide registrants with the opportunity to meet with OHIM's examiners, update and refresh their knowledge on trademark

law practice, and gain essential knowledge about the ever-evolving virtual world of social media and domain names. The TMAP Meeting takes place from October 13-15, 2015.

The educational sessions during the meeting will be led by distinguished panels of OHIM officers, judges, and practitioners from around the world. In addition, through concurrent sessions, registrants will be able to pick sessions that best suit their needs and experience. All sessions are aimed to be practical, interactive and offer a "safe place" to ask questions and listen to peers' best practices.

For more information about INTA's 2015 TMAP Meeting, please visit <http://www.inta.org/2015TMAP>.

Trademark administrators are valued by trademark attorneys both in private practice and corporations. They have become invaluable "partners" in the practice. The trademark practice involves so many responsibilities that do not require a law degree, such as research, investigation, preparing and supervising international filings, and constant policing and monitoring, that it is easy to see why the utilization of trademark administrators is absolutely essential to the efficiency and economic effectiveness of any trademark law operation.

As trademark law practice has expanded, so too has the role of the trademark administrator. Take

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the instance of international trademarks, where it is feasible that a company or law firm could be dealing with as many as 150 countries and an equal number of different trademark laws. Since no single lawyer is authorized to practice in so many jurisdictions, and it becomes necessary to seek foreign counsel, the role of the trademark administrator often is to supervise and coordinate the assistance of that foreign counsel.

The trademark administrator is an invaluable asset to a trademark team and the position provides a great opportunity for hands-on experience. The trademark practice is diverse and particularly interesting because one is often involved with developing and protecting recognizable brand names and logos, representing organizations around the world, and a trademark administrator's experience can result in an exciting and challenging career.

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The James Nurton Interview



Deborah Brincat, Procter & Gamble France

What is your background?

I studied languages at King's College London. Part of the course involved studying in France and I decided I wanted to move to Paris. I was looking for temporary work when I finished studying until I moved back to France, and I took on a full-time job at the MCPS international department in Streatham, London. So that got me into IP by accident!

When I moved to France I ended up working for CISAC, the international organisation that runs meetings for authors' societies. I was translating minutes of meetings between English, French and



Deborah Brincat

German. But this didn't work out and I left fairly soon, and the following Monday I joined P&G.

I started at P&G as a bilingual assistant and worked my way up through the ranks. I've just celebrated 25 years working in the trade mark department!

How has your job changed in that time?

I had the opportunity to do the CEIPI in Strasbourg, but I didn't like the legal side so much and didn't have time to work fully on it. My boss at the time was Ingrid Desrois and she created an opening for me to take on an administrative management role instead.

I'm now in charge of lots of things you don't have to be a lawyer to do: global trade mark renewals, with a few exceptions; due diligence on trade marks for acquisitions and their integration; divestitures – helping to prepare the data rooms and answer due diligence questions, as well as correspondence with the buyer for the transitioning of the portfolio.

I'm also on a small core team in charge of the relationship with Dennemeyer, as we use their DIAMS iQ database, so I'm highly involved in that. One person on my team does a lot of the database work. And I'm project manager for our external provider CPA Global, which handles filings and renewals, so I spend quite a lot of time on that.

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The trade mark team in Paris comprises about 10 people for whom I have an indirect managerial role. My direct team comprises three people and one outside vendor (working on the database). Our main tasks are renewals, acquisition and divestiture work, corporate change recordals, filing instructions to CPA Global and further correspondence with CPA until registration of the marks, as well as updating for any office actions or conflicts related to them. We also file CTM applications directly at OHIM and follow these through.

Outside of that, I'm vice-chair of INTA's Trademark Office Practices Committee (TOPC), and have also been on several other committees over the years. It's quite a lot of work, as the TOPC has 10 subcommittees. I also represent AIM at the liaison meetings at OHIM three times a year.

How big is your portfolio and what are the biggest challenges?

We have roughly 100,000 active trade marks and that is counting each international registration as one, even if it covers 30 countries. I have a colleague in Kronberg, Germany, who looks after certain categories.

The first challenge is when you acquire a portfolio. When we acquired Gillette we acquired about 30,000 trade marks and we had to convert the data into our current database, and renewals weren't transparent

because of inconsistent database inputting. It took us years to get through all of that. Another challenge is that you have many different people inputting data, so there is the risk of human error. We have good systems, and try to ensure that the law firms we use have the correct data in their systems as far as possible.

I remember having to renew an international registration on paper, before the days of electronic renewals. I had the trade mark certificate in front of me and I listed all the countries on the page. Shortly afterwards, I realised I should have turned the page over to read the rest of the countries! So we had to pay a late renewal fee. Nowadays I don't think that would happen.

We have issues in some Asian countries where corporate change recordals take years to be recorded. This is compounded when you change law firms and they don't always like to transfer files between each other. This can be a nightmare sometimes.

Do you try to use the Madrid System and OHIM where possible?

It depends on the category of brands. My colleagues in Kronberg use international registrations extensively, filed in the name of a German or Swiss company. We are not filing IRs in the name of the US company, partly because of the limitation of the

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goods in the US. All our prestige registrations, as well as Salon Professional and Braun, are managed out of Europe so we will file IRs and extend to OHIM. Otherwise the laundry products, diapers etc in the name of The Procter & Gamble Company we file directly with OHIM and have been doing so since 1996. I think we are one of the biggest users of the CTM system.

We handle filings with the OHIM, German PTO (partly), WIPO and the USPTO directly ourselves and the rest is outsourced to CPA.

How well do you think OHIM works?

It has improved a lot. The website catastrophe was annoying but the fact that you can do so much electronically is a big improvement on the days when you had to fax documents, and things were scanned. It is much easier now.

We also work directly with WIPO and I know they are developing similar tools, but they're not quite at the stage that OHIM is at.

What can IP offices do to improve?

I've been impressed at the amount of collaboration with the national offices, and many of them have adopted the IT tools elaborated by OHIM in connection with the Cooperation Fund. The Liaison Meetings between OHIM and the national offices provide a good forum for discussion and many

topics have been discussed further in working groups under the Convergence Programme. This is a good step forward to further collaboration and especially to a more standard practice in the EU which is to the benefit of trade mark professionals.

What's been the most unusual case you've dealt with?

Two things come to mind. One is that when we divest trade marks, we often have to convert them. Last time we converted about 20 CTMs and in some countries we had to pay the renewal fees again, even though we had paid the CTM renewal fees in 2008. In some countries, this is part of their legislation. It may not be an issue for many other companies, but I think it is a glitch in the system. It really amazed me.

The other thing is when I worked on an acquisition about 10 years ago. It was a pharmaceutical company in Barcelona called Grupo Vita and I had to go to the site to arrange for execution of the deeds of transfer. The patent documents had been sent over from Cincinnati but there were various problems, and I had to spend a couple of days making photocopies and going through all the documents and their requirements, so that was an interesting experience.

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What was the first trade mark you worked on?

That is quite easy. We had recently acquired Blendax GmbH and my current boss Danièle Le Carval arrived in Paris in 1990 accompanied by hundreds of boxes of files. Many of the marks were international registrations and many covered an enormous number of goods. For two months, the two of us sat in an office and input all these details by hand. So I got very good at knowing the names of all the goods in German!

Tell me about your committee work with INTA?

As the vice-chair of the TOPC, I have to attend 10 subcommittee meetings and various other meetings at every Annual and Leadership Meeting, so that is a lot of meetings! Our various subcommittees have been very busy: for example, the Europe-focused ones have been looking at the European reforms; the Canadian one has been involved in the changes in Canada's trade mark law; the Latin American one has been holding roundtables with government officials; in India they have been providing feedback to the Indian office on examination guidelines; and in Africa there have been some interesting discussions between users and the OAPI, in particular regarding the Madrid Protocol. Much of our work has fed into INTA's Trademark Office Benchmarking Database, which has developed over many years and includes information from over 170 trade mark offices.

We have made enormous efforts to get government officials to come to INTA and attend the subcommittee meetings and overall I'm very pleased with the progress that TOPC has made. I think now we have to improve the coordination and communication between INTA committees, which is very much part of the plan. One problem we have is that there is normally a limit of two terms for Committee membership, which is not always enough time to ensure continuity.

I am also on the Project Team for the INTA Trademark Administrators and Practitioners Meeting, which takes place in October this year in Alicante. I will be moderating and speaking at that too. It's interesting because although we don't have a paralegal role as such in Europe, like in the US, there are lots of people doing that kind of work. It looks like we will have a good number of participants, including lawyers from law firms managing formalities work. Of course there are often budget issues for companies if you are sending non-management employees.

What changes do you expect in the future?

It's interesting to see what First to File are doing in the US: you can download documents overnight from the USPTO, which cuts out a lot of the admin work and work done by providers where you have to get the documents, scan them, upload, enter and check the data. This is a big advance and I

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would hope that we could one day do this also with other offices such as the OHIM. In the future, I think this sort of electronic tool will become more and more available. One thing we have sometimes considered, but have never done, is giving outside counsel access to our systems. We decided that with the hundreds of different law firms that we use it would be a nightmare and raise many issues. By outsourcing much of this admin work to CPA we have freed up our assistants to do more “added value” work such as on trade mark clearance, watching and handling office actions and possibly conflicts with third parties. The trade mark world is forever on the move with new collaborations, new tools and new ways of doing things. These motivate trade mark professionals in their work and encourage them to be excited about the future.

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This article summarises the General Court judgment on two related cases. The judgment deals with appeals against OHIM's Third Board of Appeal decisions R 2453/2010-3 and R 2459/2010-3 on invalidity proceedings ICD 6955 for registered Community design No 000579032-0001, and invalidity proceedings ICD 6963 for registered Community design No 000579032-0002 (the RCDs).

The RCDs, registered and published in 2006 in respect of 'umbrellas' (see their representations below), were challenged in invalidity proceedings brought on the grounds of Article 25(1)(b) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (CDR) for non-compliance with the requirements of novelty and individual character. The invalidity applicant relied on a prior design disclosed by the publication of US patent No 5505221 (see the last table below).

The Invalidity Division upheld the applications for a declaration of invalidity, finding that the contested designs were new within the meaning of Article 5(1) CDR but devoid of individual character within the meaning of Article 6(1) of that regulation. Senz Technologies BV, the holder of the RCDs, brought

an appeal against each of the decisions, which was dismissed by the Third Board of Appeal.

In its decisions, the Board of Appeal considered that the earlier patent could reasonably be known to the circles specialised in the sector concerned within the European Union through the US Patent and Trademark Office register, that the overall impressions produced by the umbrella covered by the earlier patent and the umbrellas covered by the contested designs were determined principally by the underside and lateral sides, that the informed user's attention would be drawn to the basic structures and not the details, that all the umbrellas examined essentially had the same elongated, asymmetrical appearance and that they produced the same overall impression.

The holder of the RCDs lodged an appeal with the General Court, requesting that the decisions be annulled and the contested designs be declared valid, and pleading infringement of Articles 7(1) and 6(1) CDR.

Disclosure of prior design pursuant to Article 7(1) CDR

In its substantiation, the holder of the RCDs argued that the US patent could not be known to circles specialised in the sector concerned operating in the European Union because:

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- the nature of a design has nothing to do with patents, as the former concerns the appearance of a product whilst the latter concerns technical inventions;
- it is highly unlikely that the average EU designer is familiar with patent systems in general and associates the term 'patent' with designs (even many European intellectual property lawyers would not do so);
- the average EU designer cannot be presumed to have consulted patent registers, far less registers located outside the European Union, firstly because the earlier patent is not a design, and secondly because it would be beyond the financial means of designers and small enterprises to undertake excessive searches;
- the Board of Appeal held incorrectly that the United States is the European Union's principal trading partner in umbrellas;
- it is not possible to be aware of the existence of an umbrella patented in the United States if it has never been manufactured and marketed.

With respect to those circles to whose attention the prior design was supposed to be brought, the GC held the following:

...it must be examined whether, on the basis of the facts, which must be adduced by the party

challenging the disclosure, it is appropriate to consider that it was not actually possible for those circles to be aware of the events constituting disclosure, whilst bearing in mind what can reasonably be required of those circles in terms of being aware of prior art. Those facts may concern, for example, the composition of the specialised circles, their qualifications, customs and behaviour, the scope of their activities, their presence at events where designs are presented, the characteristics of the design at issue, such as their interdependency with other products or sectors, and the characteristics of the products into which the design at issue has been integrated, including the degree of technicality of the product concerned. In any event, a design cannot be deemed to be known in the normal course of business if the circles specialised in the sector concerned can become aware of it only by chance.

Stating this, the GC dismissed the arguments presented by the holder of the RCDs entirely, maintaining that they were insufficient for a finding that the earlier patent could not reasonably be known to circles specialised in the sector concerned. The main reason was that the holder of the RCDs failed to adduce any factual evidence or argument that would lead to the conclusions suggested by it.

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The GC held in particular that:

- It seems reasonable ... that the designer of a wind-resistant umbrella, before placing it on the market, will undertake searches in patent registers, as he may be deemed to know that such a product must meet not only aesthetic but also — and to a considerable extent — technical requirements, and that it is therefore reasonable and plausible that a wind-resistant umbrella may have already been patented.
- Article 7(1) CDR does not impose any requirement that the earlier design relied on by the opposing party must have been used for the manufacture or marketing of a product. However, the fact that a design has never been incorporated into a product is significant only where the applicant has established that the circles specialised in the sector concerned do not generally consult patent registers or that the circles specialised in the sector concerned do not generally attach any weight to patents, in particular American patents. In such scenarios, the argument that there are no umbrellas covered by the earlier patent on the market may make faintly plausible the fact that the earlier patent may have been known to the circles specialised in the sector concerned through other forms of information. In the present case, the fact that the umbrella designated by the earlier patent has never

been produced shows that the earlier patent could not have been known to the circles specialised in the sector concerned through advertising, marketing activities or catalogues. However, that fact does not establish that the circles specialised in the sector concerned could not have reasonably gained that knowledge otherwise, such as through an online search in the American patent register.

- The question whether or not the United States are the European Union's principal trading partner in the field of umbrellas is not per se decisive for ruling on the question whether the earlier patent could not reasonably be known to the specialised circles. Even if not, it still seems reasonable that a search might be undertaken in the American patent register, since the United States carries at least a certain commercial importance for the circles specialised in that sector operating in the European Union. As the applicant has failed to adduce evidence showing that that market plays only a very minor role in the normal course of business for the circles specialised in the sector concerned, its argument is irrelevant for the outcome of the present dispute.

According to the GC, the Board of Appeal did not err in finding that the earlier patent had been made available within the meaning of Article 7(1) CDR.

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Individual character of contested designs pursuant to Article 6 CDR

In the Court's view, in order to determine whether the contested designs have individual character in relation to the earlier patent, account must be taken of the comparisons made of different views, the degree of attention shown by the informed user and the degree of freedom of the designer in the development of the design.

As regards the definition of the informed user, a discussion was held as to whether the definition of the informed user may include third parties who see an umbrella in the street, or should extend only to persons who wish to use or purchase an umbrella.

Without coming to a conclusion, the Court accepted the argument of the holder of the RCDs that persons wishing to purchase and use an umbrella are also induced to look around themselves and observe other umbrella users. Therefore, the informed user perceives their umbrella not only from underneath, but also from all perspectives, including the perspective of a third-party observer, prior to purchase or use.

The Court accepted the definition provided by the Board of Appeal, according to which the informed user is someone wishing to use an umbrella, who needs to purchase one and who has become informed on the subject. The informed user also

knows the different models of umbrella and their usual features, and demonstrates a relatively high level of knowledge about the goods concerned.

The Court rejected the parties' arguments that the level of attention of the informed user may be affected by an unusual shape of the umbrellas or the fact that they are a fashion accessory. According to the Court, the informed user of a design is already by nature a person who has a particular interest in the design of a given product and who is interested in trends in design, art and fashion that might be behind the emergence of such a design. Furthermore, the mere fact of being faced with a particular design does not make the informed user more or less attentive, as that user's level of attention is already, by its very nature, relatively high.

As regards the designer's freedom, the Court held that an umbrella must necessarily have a shaft, a canopy resting on at least three ribs, a handle and 'eye savers'. The possibilities for varying the shape of the canopy, which in turn necessarily affects the number of ribs, are rather limited in that the designer may opt for a rectangular, polygonal, round, asymmetrical or atypical shape, such as a heart or star shape, whilst accommodating functional constraints arising from the fact that the canopy must ensure sufficient protection against rain. The designer may also vary the three-dimensional appearance of the canopy to give it a

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cupola or more flat, conical or pyramidal shape. As regards, inter alia, the handle, the eye savers, the ribs and the shaft, the possibilities for variation are limited, principally because their appearances are to a large extent dictated by the functionality of an umbrella. By contrast, the umbrellas covered by the contested designs are umbrellas intended to be highly wind-resistant. As explained by the parties at the hearing, the wind-resistant function that the umbrellas covered by the contested designs must perform places subsequent limitations on the possibilities for varying inter alia the shape and depth of the canopy, ribs and eye savers.

The Court concluded that the designer's degree of freedom is limited, with the result that, in accordance with the case-law, even minor differences between the earlier patent and the contested designs are sufficient to produce different overall impressions on the informed user.

All the umbrellas under comparison are asymmetrical in appearance, in that their shafts are positioned off-centre in relation to their canopies. The umbrellas also show differences in terms of canopy shape and panel configuration and position. It was concluded that it is the canopy shape that characterise the overall impressions produced by the earlier patent and by the contested designs, which give each of the umbrellas examined a very specific and, therefore, individual character within the meaning of Article 6(1) CDR.

The off-centre positioning in relation to the canopy, which was claimed to be the dominant feature of the earlier patent and the contested designs, with the result that it dominates the informed user's perception, is clearly perceived only if the comparison is made with a more usual, symmetrical, umbrella model. By contrast, when two asymmetrical umbrellas are compared, the mere fact that they are both asymmetrical does not preclude the overall impression produced by the umbrellas from being different.

The appearance of an asymmetrical umbrella may be regarded as innovative or even original, but it is not so striking that a user would lose sight of all the other remarkable features of the umbrella.

The fact that the user views the umbrella inter alia from underneath is also irrelevant to the assessment of the individual character of the contested designs. In attaching greater weight to the perception of the umbrellas from the perspective of underneath, the Board of Appeal disregards the fact that the designs are rights protecting the appearance as it results from specific designs and not perspectives that have not been reproduced in those designs. There is no reason to suppose that the informed user should not see an umbrella from above or the sides before making his or her purchasing decision.

The Court also observed that the CDR does not

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provide for a limitation of protection for designs and features that (also) fulfil a technical function. It is only when one or more features of a product's appearance are dictated solely by its technical function that the CDR provides that such a feature must not be taken into account for the purposes of an assessment of individual character. The Board of Appeal, therefore, erred in attaching only limited importance to the features that also resulted from the wind-resistance function of the umbrellas covered by the contested designs when assessing the individual character of those designs.

Given this reasoning, the Court upheld the appeals and annulled the contested decisions.

To see the CJEU judgment click [T-22/13](#)

Contested [RCD 000579032-0001](#)



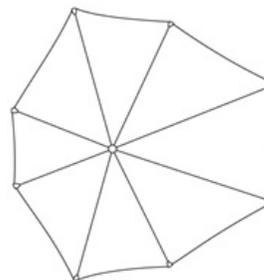
1.1



1.2



1.3



1.4

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1.6



1.7



2.1



2.2



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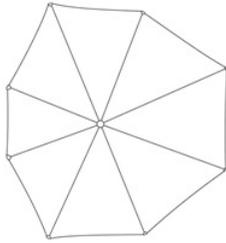
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2.4



2.7

The prior design: [US patent No 5,505,221](#)



2.5



2.6



Fig. 1

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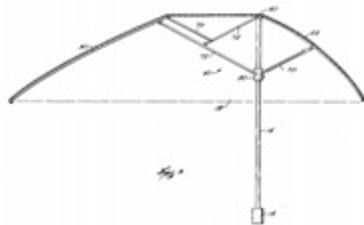
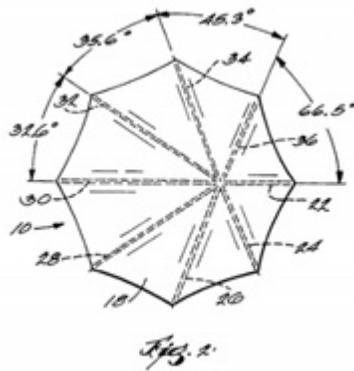
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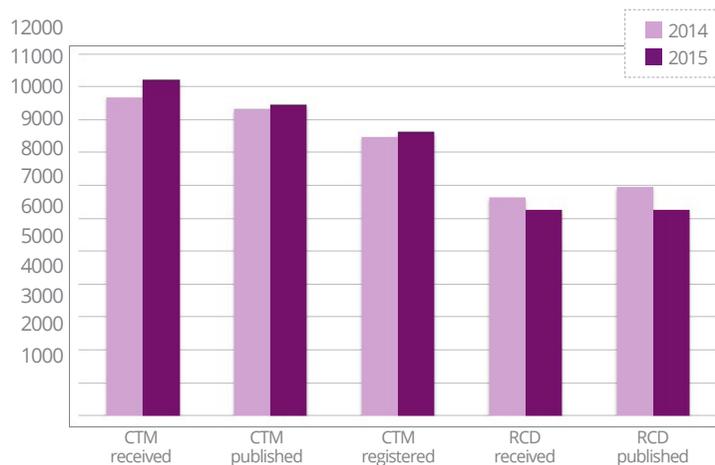


Statistical Highlights



Monthly statistical highlights May*	2015	2014
Community Trade Mark applications received	10 203	9 686
Community Trade Mark applications published	9 450	9 318
Community Trade Marks registered (certificates issued)	8 628	8 480
Registered Community Designs received	6 265	6 628
Registered Community Designs published	6 268	6 952

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



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BOIP implements trade mark e-filing

The Benelux Office for Intellectual Property (BOIP) has implemented trade mark e-filing, developed by OHIM's Cooperation Fund.

The new system is intuitive and user-friendly, and allows users to find and select all the relevant goods and/or services quickly and easily. Users receive immediate PDF confirmation in their mailboxes, with the application number and a financial overview

Poland implements Back Office

The Polish Patent Office (PPO) has gone live with the Back Office for trade marks and designs, developed by the Cooperation Fund.

The PPO is the first IP Office to go-live with the whole functionality provided by the tool, including:

- Registration process for trade marks and designs
- Oppositions/Cancellations proceedings for trade marks and designs
- Recordals for trade marks and designs
- Appeals
- International registrations for trade marks and designs
- International applications for trade marks

The overall aim of the Cooperation Fund is to benefit users across the EU by providing modern, state of the art tools and services for EU national and regional offices. The integration of the Back Office system in the PPO was possible due to the close cooperation between OHIM and Polish colleagues.

Five IP offices across the EU are already using the Back Office, including the Finnish Patent and Registration Office (PRH), which along with the PPO was a pilot office for the Back Office system and defined its core functionalities

Cooperation Fund implementations in Bulgaria and Lithuania

The wave of implementations of Cooperation Fund tools continues across the EU with Forecasting being integrated in both the Bulgarian and Lithuanian national IP offices.

Lithuania has also implemented the Enforcement Database, ACIST and the Call Centre Database in recent weeks.

ACIST is the Anti-Counterfeiting Intelligence Support Tool (ACIST), an EU-wide database which gathers statistics on detentions, at borders and within the internal market, of articles that are suspected of infringing intellectual property rights.

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Latvia implements the Back Office

The Patent Office of the Republic of Latvia (LRPV) has begun to manage its national and international trade marks with the Back Office system.

The Back Office was developed under the framework of the Cooperation Fund and is the single largest project within the Fund itself.

The implementation is the result of team work between the Latvian Office and OHIM, with particular input from the locally deployed staff on the ground in Riga.

The Back Office system supports the management of the entire trademarks and designs lifecycle by IP Offices, including Registration; Opposition/Cancellation/Invalidity; Recordals; Appeals; International Registration; International Application (trade marks only).

More Back Office implementations are expected through 2015

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Seven days on average for the publication of a Fast Track application

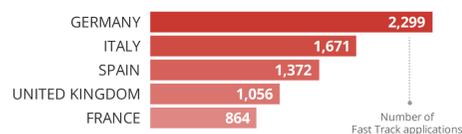
Fast Track is a free service offered by OHIM that can help speed up the publication of Community trade mark applications. Since its launch on 24 November 2014, more than 26% of all trade mark applications have been submitted via Fast Track.

During the first six months, trade mark applications accepted as Fast Track cases were published, on average, within seven days. In some cases the publication time was just two days, with 167 trade marks published in this time frame.

Trade mark applications are also processed more smoothly because Fast Track requires users to select their goods and services from a database of terms already accepted by OHIM and by all IP offices in the European Union known as the [Harmonised Database](#).

Throughout the first six months, Germany, Italy and Spain are the top filers in terms of absolute figures:

Fast Track around the world



Among the top 25 Fast Track filing countries Hungary (65.18%), Greece (65.01%) and Romania (56.55%) are the countries with the highest percentage of trade marks being submitted via Fast Track.

Administrative Board and Budget Committee meeting at OHIM

The Administrative Board and Budget Committee, OHIM's governing bodies composed of representatives of the Member States of the EU and the European Commission, held biannual meeting at OHIM's headquarters in Alicante from June 8-10.

On June 8, the Administrative Board issued a favourable opinion on the draft OHIM Guidelines for Examination in the Office for Harmonization in the Internal Market, and endorsed the Convergence Programme project on Figurative Marks containing descriptive/non-descriptive words.

At the joint meeting of the Administrative Board and the Budget Committee on June 9, OHIM President António Campinos presented the Annual Report 2014 of the Office and the EU Observatory on Infringement of Intellectual Property Rights. President Campinos also informed ABBC Members about the Office's progress towards the achievement of the goals of its Strategic Plan, the progress made on the Strategic Plan 2020, and the status of the implementation of the Interinstitutional Agreement on budgetary discipline, cooperation in budgetary matters and on sound financial management.

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On June 10, the Budget Committee gave its discharge to the President of the Office in respect of the implementation of the budget for the financial year 2013.

Annual Report 2014

The Annual Report of OHIM for 2014 is now available [here](#), with an accompanying video about the Office's activities during the course of the last year.

The Annual Report of the EU Observatory on Infringements of Intellectual Property Rights is available [here](#).

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Luxembourg trade mark and design news

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

Case T-331/10 RENV (Joined Cases T-331/10 RENV and T-416/10 RENV); Yoshida Metal Industry Co. Ltd v OHIM; Judgement of 21 May 2015; Language of the case: EN

RESULT: Actions dismissed

KEYWORDS: Functional element, Filing date, Distinctive element, Function of trade mark, Three dimensional mark, Figurative trade mark, Graphical representation, Shape of the products, Patent

FACTS: When the CTM owner registered the figurative marks represented below as CTMs for goods within Classes 8 and 21, the Cancellation Division rejected the applications for a declaration of invalidity. On appeal, the Board of Appeal (BoA) declared the registrations invalid based on Article 7(1) (e) (ii) CTMR. The CTM owner appealed to the General Court (GC). The GC upheld the appeal. In particular, the GC found that “the concave character” of the black dots is not part of the contested trade mark as filed and registered and in concluding that

the dots were concave in character, the BoA did not refer to the sign as filed, but to representations of the goods actually marketed by the applicant. The GC considered that no account could be taken of the proof of current use of the signs at issue given that ‘only the shape as reproduced in the registration application may be the subject-matter of the examination of the trade mark’. The invalidity applicant and the Office appealed to the European Court of Justice (CJ), alleging, inter alia, a breach of Article 7(1) (e) (ii) CTMR. The CJ set aside the GC’s judgments and referred the cases back to the GC holding that the possibility afforded to the competent authority when examining a 3D sign can be extended to the examination of any sign constituted by the shape of goods within the meaning of Article 7(1) (e) (ii) CTMR. Further, the requirements for the graphic representation cannot restrict the competent authority’s examination under Article 7(1) (e) (ii) CTMR in such a way as might undermine the public interest underlying that provision. The CJ also recalled that the material which, although subsequent to the date of filing the application, enables conclusions to be drawn with regard to the situation as it was on that date can be taken into consideration.

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CTMs



SUBSTANCE: Article 7(1) (e) CTMR does not define the signs which must be considered as shapes within the meaning of that provision, it may therefore apply also to 2D signs (Para. 36). With regard to its wording and to the public policy interest it pursues, Article 7 (1) (e) (ii) applies to any sign, whether two- or three-dimensional, where all the essential characteristics of the sign perform a technical function (Para. 39). Regarding the identification of the essential characteristics, there is no hierarchy that applies systematically between the various types of elements of which a sign may consist (Para. 43). The identification may be carried out by means of a simple visual analysis of the sign or, on the contrary, based on a detailed examination in which material relevant to the assessment is taken into account,

such as surveys or expert opinions, or data relating to intellectual property rights conferred previously in respect of the goods concerned (Para. 44). Thus, the BoA examined the essential characteristics of the signs correctly when taking into account the American and European patents held by the CTM proprietor and the representations of its products to the extent that it was already marketing the goods under the sign on the EU market (Para. 46). According to the GC, the essential elements of the signs are (i) the contour of the trapezium shape, and (ii) the arrays of black dots (Para. 47). The GC states that it cannot be considered that the contour of the shape has merely an illustrative purpose and is aimed at showing how the array of dots will be affixed. First, the handle contours are not dot-printed, and, second, the application for registration contains no precise detail to that effect (Para. 49). Regarding the black dots, it is clear from the material in the case file, in particular the representations of the applicant's products, that they actually represent dents (Para. 50). There is no doubt from the various patents held by the CTM proprietor that those dents do seek to incorporate a technical solution, namely, a non-skid structure (Para. 58). The GC did not consider significant the fact that the non-skid structure is not patentable or that it is a secondary characteristic of the product patented (Para. 59). It is also irrelevant that the CTM proprietor filed its patent and trade mark registration applications at the same time (Para. 60). The argument that the shape of the handle is capable of contributing — as

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much as or more than the array of dents — towards obtaining a non-skid effect cannot alter the fact that the array of dents is aimed at obtaining a technical result. It only confirms the functional character of the shape of the handle itself (Para. 61). Also, the fact that other knives fulfil a non-skid function by other means or that those dents are not necessarily incorporated into all kitchen knives is of no relevance (Para. 62). The GC concluded that the registration of the signs at issue would improperly reduce the possibilities for competitors to bring to the market alternative product shapes incorporating the same non-skid technical solution (Para. 64) and dismissed the actions.

Case T-131/12 SPA Monopole v. OHIM, Judgment of 5 May 2015, Language of the case: EN

KEYWORDS: Relative grounds, Common element, Reputation, Unfair advantage, Use without due cause

RESULT: Action upheld (BoA decision annulled)

FACTS: The applicant sought to register the word mark represented below for goods in Class 3. An opposition pursuant to Article 8 (1) (b) and 8 (5) was filed based on the earlier Benelux and German marks represented below in Classes 3 and 32. The Opposition Division (OD) upheld the opposition according to Article 8 (5), as the CTMA would take

unfair advantage of the word mark SPA covering goods in Class 32. The Board of Appeal (BoA) annulled the OD decision. No proof of reputation of the word mark SPA for goods in Class 32, no proof of harm to the distinctive character or reputation of the earlier mark, no unfair advantage.

CTMA

SPARITUAL

Earlier Marks

SPA



SUBSTANCE: The single plea was infringement of Article 8 (5) CTMR. According to the BoA, reputation was proved only for the figurative mark with the Pierrot device, which could not be 'extended' to encompass the word mark. The General Court (GC) stated that in order to prove enhanced distinctiveness or reputation, the owner of a registered mark may rely on evidence of its use in a different form, as part of another registered mark

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and reputation, provided that the relevant public continues to perceive the goods and services at issue as originating from the same undertaking (p. 33). The word mark SPA, covering goods in Class 32, has a reputation because the word component SPA is recognised by the public as distinctive for the goods marketed. Regardless of the presence or the absence of the Pierrot image, the relevant public continues to perceive the goods at issue as originating from a particular undertaking (p. 40). The BoA also erred in holding that the risk that use without due cause of the CTMA will take unfair advantage of the earlier mark had not been substantiated (p. 57). In the light of the considerable reputation of the word mark SPA for goods in Class 32, a risk of free-riding cannot prima facie be ruled out (p. 59). The BoA should examine this question and rule on it. The contested decision is annulled.

Case T-41/12; LS Fashion, LLC v OHIM, Judgment of 27 February 2015, Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Catalogue, Invoice, Sales figures, Evidence of use, Identity of the goods and services, Likelihood of confusion, Personal name mark, Phonetic similarity, Proof of use, Similarity of the goods and services, Similarity of the signs, Visual similarity, Common element

FACTS: The applicant sought to register the word mark L'Wren Scott as a CTM inter alia for goods within Class 25. An opposition based on the earlier Spanish word mark LOREN SCOTT, registered for goods in Class 25, was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division upheld the opposition. The Board of Appeal (BoA) dismissed applicant's appeal finding the genuine use of the earlier mark sufficiently proven, the goods identical or similar and the signs visually and aurally similar to an average degree. According to the BoA there was a likelihood of confusion between the signs. The applicant filed an action before the General Court (GC).

CTMA

L'Wren Scott

Earlier Marks

LOREN SCOTT

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SUBSTANCE: Infringement of Article 42 (2) and (3) CTMR:

In its first plea in law the applicant claims that the evidence submitted by the opponent in order to show genuine use of the earlier mark does not satisfy the conditions laid down by the Case-Law. The GC first of all summarises the relevant Case-Law related to the proof of use (Paras. 18-26). Subsequently, the GC provides the summary of the evidence submitted by the opponent (Paras. 29-35). According to the GC, the fact that the earlier mark does not appear in full on certain invoices in the list setting out the articles sold does not mean that they cannot be taken into consideration. The earlier mark appears at the top of the header and, through the identification of the goods mentioned on the invoice, it is clear that those goods can refer solely to the earlier mark. Further, it is not unusual for the trade mark to not even be mentioned in the list of goods sold (Para. 37). It is clear that the small amount from sales is due to the very low price of the goods marketed, with the result that, when applied to the volume of sales, it cannot be regarded as derisory, particularly since the invoices were submitted merely by way of illustration, as is apparent from the fact that their numbering and dates are spaced out and those data are coherent and chronological, and thus do not represent the amount of actual sales (Paras. 41-42). The invoices were made out to different persons which shows that the earlier mark was used publicly and externally (Para. 45). The sales effected, even though they are

not considerable, constitute use which objectively is such as to create or preserve an outlet for the goods concerned, the commercial volume of which, in relation to the period and frequency of use, is not so low that it may be concluded that the use is merely token (Para. 46). The plea was rejected.

Infringement of Article 8 (1) (b) CTMR:

Regarding the alleged failure in assessment of likelihood of confusion (LOC) the GC found that the goods covered by the signs are identical or similar (Para. 59). Visually, the signs differ only in the fact that the second letter of the earlier mark is 'o', whereas the mark applied for contains the element "w" (Para. 62). By finding a medium degree of similarity the differences have been taken into account (Para. 63). The pronunciation of the signs at issue coincides inasmuch as the common element 'scott' will be pronounced in an identical manner. The pronunciation of the first element of the signs at issue will be only slightly different for the Spanish consumer, even in situations where that consumer might hesitate over the pronunciation of the element 'l'w' (Para. 65). The degree of aural similarity is average (Para. 67). The words do not make reference to any concept (Para. 69). Even if it was established that Ms L'Wren Scott was known to certain celebrities, the documents submitted do not show that Ms L'Wren Scott herself had celebrity status in Spain for the relevant public, with the consequence that the relevant public would perceive the mark applied for as forming an autonomous conceptual unit (Para.

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73). Since the applicant has failed to establish the notoriety of the mark applied for, the mark must, in the absence of any other evidence to support its being highly distinctive, be regarded as being devoid of such distinctive character, since it amounts merely to the combination of two elements, namely 'lwren' and 'scott', which contains slight differences as compared with the combination of the elements 'loren' and 'scott' (Para. 81). LOC was found.

Case T-250/13; Naazneen Investments Ltd v OHIM, Judgment of 18 March 2015, Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Revocation grounds, Proof of use, Evidence of use, Sales figures, Used in the course of trade, Translation, Declaration, Labels, Promotional material, Lack of reasoning

FACTS: The Cancellation Division (CD) upheld the application for revocation of the registered CTM SMART WATER on the grounds of Article 51 (1) (a) CTMR for all the goods in respect of which it had been registered, The CTM proprietor filed an appeal. The Boards of Appeal (BoA) dismissed the appeal and upheld the contested decision. The BoA stated that the evidence provided by the CTM proprietor did not make it possible to establish that the mark at issue had been put to genuine use and,

concurrently, there were no proper reasons for non-use. The applicant filed an action before the General Court (GC).

CTM

SMART WATER

SUBSTANCE: INFRINGEMENT OF ARTICLE 75 CTMR: When the BoA confirms a decision of the CD in its entirety, and given the continuity in terms of function between the BoA and the CD, that decision, together with its statement of reasons, forms part of the context in which the BoA's decision was adopted (Para. 16). The BoA, in confirming the decision of the CD, could reproduce the latter's assessment; the fact that the BoA did not provide a translation of that earlier decision in the language of the case cannot constitute a failure to provide a sufficient statement of reasons (Para. 21). INFRINGEMENT OF ARTICLE 51 (1) (a) CTMR: The GC confirmed that affidavits from a person who has close links with the party concerned are of lower evidential value than those from third parties and they cannot therefore, on their own, constitute sufficient proof of use of the mark (Para. 30). Further, in regards of the assessment of the evidence on actual sales, the GC confirmed that a quantity of 15,552 bottles

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sold cannot be sufficient to establish the genuine use of trade mark in the context of the significant size of the relevant market for beverages in Class 32 which are mass consumption goods aimed at the general public (Para. 35). Regarding the imminent marketing claim, the GC recalled that use of a mark must relate to goods or services already marketed or whose marketing is imminent and for which preparations by the undertaking to secure customers are under way. In the present case, the advertising and promotional activities concerning the production of beverages and labels relate solely to the years 2006 and 2007. The applicant has not adduced any proof that the goods in question were marketed between 2007 and the end of the relevant period. An advertising campaign presupposes the use of various media, certain intensity and the possibility of reaching a large audience, and therefore advertisements in two specialist German magazines cannot suffice (Paras. 38-42). Also, the GC confirmed that non-disclosure agreements submitted by the CTM proprietor were not followed by contracts for the manufacture and delivery of the goods in question. Moreover, the extracts from the website did not show any actual commercial activity (Paras. 43-44). The CTM proprietor's claim that the BoA did not determine a minimum threshold of use, which could be considered as genuine, was also unfounded. The goods in question were for everyday use and not very expensive. The total amount of transactions over the relevant period (EUR 800), seemed to be so token as to suggest, in

the absence of supporting documents or convincing explanations to demonstrate otherwise, that use of the mark at issue could not be regarded as sufficient, in the economic sector concerned (Paras. 48-51). In relation to the assessment of the genuineness of the use, the GC pointed out that there was a gap of almost three years between the attempt to launch the mark at issue invoked by the CTM proprietor and the end of the relevant period (Paras. 53-55). When the genuine use of a mark is assessed, the evidence of the existence of such use and not evidence explaining non-use must be taken into account (Para.56) Further, no proper reason for non-use of trade mark at issue in connection with the goods in question was found. The problems associated with the manufacture of the products of an undertaking form part of the commercial difficulties encountered by that undertaking. It was for the CTM proprietor to supervise and control the manufacture of the goods in question, even though they were being manufactured by a third party. Also further products could have been manufactured and placed on the market within a reasonable period (Para. 66-69). The fact that revocation proceedings have been brought against a trade mark does not prevent the proprietor of that mark from using it (Para. 71). It is for the proprietor of a trade mark to conduct an adequate assessment of its chances of prevailing in the revocation proceedings and to draw the appropriate conclusions from that assessment as to whether to continue to use its mark (Para. 73).

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Case T-608/13; easyGroup IP Licensing Ltd, & Tui AG v OHIM; Judgment of 13 May 2015; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Relative grounds, Likelihood of confusion, Dissimilarity of the signs, Visual dissimilarity, Conceptual dissimilarity, Similarity of the goods and services, Dominant element, Laudatory element, Quality of the goods and services, Request for proof of use, Weak element, Beginning of mark, Complex mark, Figurative element, First time on appeal, Allusive trademark, Competence of the Boards, Competence of the GC/CJ, Principle of legality, Claim to reject opposition, Claim for alteration of OHIM decision

FACTS: The applicant sought to register the figurative sign easyAir-tours represented below as CTM for Classes 16, 36, 39 and 43. An opposition based on several German, international and CTM marks below, covering services in Classes 35, 36, 38, 39, 41, 42 and 43 was filed on the grounds of Articles 8 (1) (b). The CTM applicant requested that the opponent filed proof of use of those earlier marks submitted to prove of use, which was done. The Opposition Division (OD) partially upheld the opposition on the basis of Article 8 (1) (b) CTMR, finding that there was a likelihood of confusion between the marks for certain products in Class 16 and certain services in Classes, 36, 39 and 43.

The Board of Appeal (BoA) dismissed the appeal. As regards the earlier marks, it took the view that it was 'appropriate', for reasons of procedural economy, to examine the question of a likelihood of confusion on the basis of the earlier German mark referred airtours Ticket Factory, as that mark was 'the strongest' earlier mark and was not 'liable to proof of use'.

CTMA



Earlier Marks



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SUBSTANCE: ON THE RELEVANT PUBLIC AND ON THE GOODS AND SERVICES: The General Court (GC) confirmed the assessment of the BoA according to which both the general public and professionals in the travel industry in Germany will tend to display a higher than average level of attention when purchasing goods and services connected with travel arrangements, as such a purchase usually involves, even on the part of the general public, more in-depth consideration than that of everyday consumer goods or services (Para. 25). The GC also confirmed the conclusion of the BoA that the goods and services to which the appeal related are partly identical and partly similar (Para. 26).

ON THE DISTINCTIVE AND DOMINANT ELEMENTS OF THE MARKS AT ISSUE: As regards the intrinsic qualities of the word elements 'easy' and 'air-tours' for the German public, which understands basic English it held that the word 'easy' may include all kinds of goods or services, whereas the word 'air-tours' alludes to package holidays ('tours') involving air transport ('air'). That allusive element 'airtours' or 'air-tours' cannot therefore be intrinsically dominant and is at most equivalent to the laudatory element 'easy', which will be perceived and memorised as being at least equally striking, inasmuch as it does not refer to the goods and services at issue, but to an alleged quality of the goods and services covered by the mark applied for. Furthermore, both of those words have weak distinctive character, subject always to a possible increase in that distinctive character through the subsequent use of the

mark applied for, which is irrelevant at the stage of the opposition proceedings (Para. 38). Then the GC analysed the role of the respective positions of those word elements of the contested mark concluding that the position of the element 'easy' at the beginning of the sign applied would be such as to make it slightly dominant, in accordance with the Case-Law that the relevant public normally attaches more importance to the first part of words (, were it not for the greater length and the capital letter of the element 'air-tours', which offset the position of the element 'easy' at the beginning of the sign (Para. 39). In relation with the colour orange, the GC concluded that the figurative element consisting of a broad orange rectangle appears striking, both owing to its size, which is very large in relation to that of the word elements, and its bright colour, with the result that it will be clearly perceived and memorised by the relevant public, and will not be dominated by the word elements. According to the Case-Law, in a composite mark, the figurative element may occupy a position equivalent to the word element (Para. 41). In conclusion, on the contested mark, the GC held that there are three elements of major importance, none of which dominates the other — the figurative element of a broad, bright orange rectangle and also the word elements 'easy' and 'air-tours', both of which appear in white letters against that orange background (Para. 42). As a consequence the assessment of the BoA was rejected (Para. 43) and it is thus the overall impression created by that mark which must be taken into account in the comparison

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with the earlier mark (Para. 44). In relation with the earlier German mark the GC confirmed the assessment of the BoA when it decided that the word element 'airtours', in blue letters, is dominant in the earlier German mark, whereas the figurative elements and the word element 'ticket factory' appear to be distinctly secondary in that mark. (Para. 46). Moreover this earlier German mark, notwithstanding its allusive nature in respect of the goods and services concerned, has a certain, although low, degree of distinctive character (Para. 47).

ON THE VISUAL COMPARISON: The GC held that the BoA failed to take into account the additional element 'easy' - except to state that it could be distinguished from the element 'air-tours' by the capital letter 'A' - although it is an element of the mark applied for which cannot in any way be regarded as being of minor importance, particularly because it is the first word element in that mark (see Para. 39 above). Furthermore, even though it pointed out the presence of the orange rectangle in the mark applied for, it did not draw any more inference from this than it did from the distinctly secondary element 'ticket factory' in the earlier mark, although that orange rectangle also constitutes an element of the mark applied for which cannot be considered to be of minor importance. Consequently, the BoA actually took into account, in the overall visual comparison of the signs at issue, only the fact that the respective elements 'airtours' and 'air-tours' essentially 'coincide[d]', erroneously holding the

latter element to be dominant in the mark applied for and, as a result, disregarding the presence of the two other elements of major importance in the overall visual impression created by that mark (Para. 49). Therefore the GC concluded on the visual comparison of the signs that the mere presence of the respective word elements 'airtours' and 'air-tours', which are in very different colours on very different backgrounds (blue on white and white on orange) and in quite different fonts, is offset and cancelled out by the presence of the two other elements of major importance in the mark applied for, which are not in the earlier mark, namely the element 'easy' and the broad, bright orange rectangle, to such an extent that the overall visual impression of the mark applied for is different from that of the earlier mark. Furthermore, the presence of the element 'ticket factory' in the earlier mark, which is not in the mark applied for, slightly increases, in spite of its distinctly secondary nature, the overall visual difference between the signs at issue. Consequently, it held that, the signs at issue are visually different, notwithstanding the fact that they have a word element in common, and that the BoA erred in considering them to be similar (Para. 52).

ON THE PHONETIC COMPARISON: The GC held that there is an average - or even rather low, if the element 'ticket factory' is read - degree of phonetic similarity between the signs at issue and that the BoA erred in apparently considering them to be identical, notwithstanding the differences held to

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exist, relating, in particular, to the influence of the element 'easy' on the overall phonetic impression created by the mark applied for (Para. 55).

ON THE CONCEPTUAL COMPARISON: The GC held that there is a low - or even very low, if the element 'ticket factory' is taken into account - degree of conceptual similarity between the signs at issue and that the BoA erred in apparently considering them to be identical, notwithstanding the differences held to exist, relating, in particular, to the influence of the element 'easy' on the overall conceptual impression created by the mark applied for (Para. 58).

ON THE OVERALL COMPARISON: Contrary to the contested decision the GC held that the overall impression which each of them conveys to the relevant public is different. The average, or even rather low, degree of phonetic similarity and the low, or even very low, degree of conceptual similarity between them are offset and cancelled out by the overall impression of visual dissimilarity established, particularly because the marks at issue are both figurative and not word marks. In that regard, the GC followed the applicant's claim that the earlier mark is a figurative mark and, as such, should not enjoy the same scope of protection as a mark which consists only of the word 'airtours', that, whereas a word mark usually covers any type of representation, a figurative mark, by definition, includes a specific representation, which, unless it is totally negligible, must, even if it is dominated by a word element, nevertheless be taken into account in the overall assessment of the similarity between

the signs, with the result that such a figurative mark cannot, in principle, be given a scope of protection which is strictly identical to that of a word mark which consists only of its dominant word element (Para. 61) The figurative nature of the two marks at issue — which have in common only one word element, which is, moreover, not dominant in one of them, whereas their figurative elements are completely different — thus tends to reinforce the finding that they are dissimilar (Para. 63). Since the signs at issue are, considered as a whole, dissimilar in the overall impressions that they convey to the relevant public, the GC held that the BoA erred in finding, that they were similar (Para. 64).

ON THE LIKELIHOOD OF CONFUSION: The GC concluded that since the signs are, considered as a whole, dissimilar in the overall impressions that they convey to the relevant public, it may be deduced from that lack of similarity between the signs that any likelihood of confusion between the marks at issue is precluded, without it being necessary first to apply the principle of interdependence and, in particular, to examine any highly distinctive character of the earlier mark in the course of a global assessment of the likelihood of confusion (Para. 66).

ON THE CLAIM SEEKING ALTERATION: In its second head of claim the applicant sought the rejection of the opposition in its entirety, the GC held that in reality the applicant asks the GC to take the decision which, in the applicant's submission, the BoA should have taken when it had the case. The GC interpreting the second sentence of Article

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64 (1) CTMR held that the BoA may annul the decision of the Office which was responsible for the contested decision and exercise any power within the competence of that department, in the present case rule on the opposition and reject it. Consequently, that measure is one of those which may be taken by the GC in the exercise of its power to alter decisions under Article 65 (3) CTMR (Para. 20). However the GC held that the power to alter decisions pursuant to Article 65 (3) CTMR does not have the effect of conferring on that GC the power to carry out an assessment on which the BoA has not yet adopted a position. Exercise of the power to alter decisions must therefore, in principle, be limited to situations in which the GC, after reviewing the assessment made by the BoA is in a position to determine, on the basis of the matters of fact and of law as established, what decision the BoA was required to take (judgments of 5 July 2011 in *Edwin v OHIM*, C-263/09 P, ECR, EU:C:2011:452, Paragraph. 72, and in *BETWIN*, cited in Paragraph 20 above, EU:T:2013:291, Paragraph 78) (Para. 68). As for the present case, the GC decided that the conditions for the exercise of the GC's power to alter decisions, as set out in the judgment in *Edwin v OHIM*, are not satisfied. Although it is in fact apparent that the BoA was required to find that there was no likelihood of confusion between the mark applied for and the earlier German figurative mark reproduced in Paragraph 6 above, the fact remains that the BoA — since it incorrectly found that the comparison of the mark applied for with that earlier mark was sufficient

to establish that there was a likelihood of confusion capable of justifying the OD's upholding of the opposition — did not rule on whether there was any likelihood of confusion between the mark applied for and the four other earlier figurative marks (Para. 69). Moreover it held that since the issue of whether there is any likelihood of confusion between the mark applied for and the earlier marks other than that already taken into account was not examined by the BoA, it is not for the GC to examine it, for the first time, in its review of the legality of the contested decision (Para. 70). Therefore as the GC is not able to exercise its power to alter the contested decision in order to annul the OD's decision of 2 April 2012 and reject the opposition in respect of all the goods and services concerned, the applicant's second head of claim is rejected (Para. 71). What should the BoA do? the BoA will have to assess, having regard to the grounds of the present judgment, in particular as regards the overall impression created by the mark applied for, which is different from that created by an earlier mark the dominant element of which is 'airtours', whether there is a likelihood of confusion between the mark applied for and the earlier marks reproduced above, when making the decision which it is called upon to give on the appeal which is still pending before it (Para. 72).

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Case T-535/13; Vakoma GmbH Appellant v OHIM, Order of 13 January 2015, Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Admissibility, Clarity of party submission, Relative grounds, General reference to previous submissions

FACTS: The applicant sought to register the figurative mark represented below as a CTM for goods within Class 7. The opposition based on the earlier CTM represented below and registered also for goods in Class 7 was upheld due to likelihood of confusion pursuant to Article 8 (1) (b) CTMR. The Board of Appeal dismissed the applicant's appeal. The applicant filed an action before the General Court.

CTMA



Earlier CTM



SUBSTANCE: The action is obviously inadmissible and the GC can decide by a reasoned order (Para. 14). The action before the GC has to contain a summary of the pleas in law, pursuant to Article 21 (1) of the CJ Statute which applies to the procedure before the GC according to its Article 53 (1) and pursuant to Article 44 (1) Rules of Procedures of the GC. It must be sufficiently clear and precise to enable the defendant to prepare its defence and the GC to exercise its power of review (Para. 17). The present action does not contain the necessary clear and precise submissions to support the request to annul it (Para. 19). It is limited to repetitions of the contested decision itself (Para 20) or general references to applicant's submissions in administrative procedure which cannot replace the required reasoning (Paras. 20 and 21 with further Case-Law).

Case T-15/13 ; Group Nivelles v OHIM, Judgment of 13 May 2015, Language of the case: NE.

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Design, Novelty, Informed user, Individual character, Admissibility, Lack of reasoning, Ancillary appeal, First time on appeal, Principle of functional continuity, Competence of the GC/CJ, Competence of the Boards

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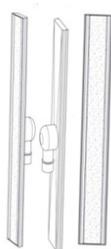
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FACTS: The design holder registered the design represented below, the product indication being 'shower drain'. An invalidity action based on prior designs - as shown below - forming part of a catalogue was filed on the grounds of Articles 52, 25 (1) (b) and 4 (1) CDR, alleging lack of novelty and individual character of the contested design. The Invalidity Division (ID) upheld the application for invalidity, declaring invalid the contested Registered Community Design (RCD) due to lack of novelty under Article 5 (1) (b) CDR. The Board of Appeal (BoA) upheld the appeal of the RCD holder. The holder of the earlier design filed an action before the General Court (GC) (the applicant) and the holder of the contested RCD filed an ancillary appeal to the GC.

RCD



Earlier design



1. The GC held, regarding the plea of inadmissibility of the claim of the applicant to confirm the decision of the ID, after eventual correction of the grounds, that it was admissible as it needed to be interpreted as falling within the powers of the GC to alter the contested decision according to Article 61 (3) CDR (Para. 20). 2. It further held that the Annex A9 to the application had been submitted for the first time at the stage of the proceedings before the GC and therefore it was inadmissible (Para. 23) 3. Regarding the admissibility of the second claim of the holder of the contested RCD to annul the contested decision for other reasons than the ones invoked by the applicant, the GC is of the opinion that it is admissible. The holder of the contested RCD, who had obtained a result that was in its favour, namely that the contested decision had concluded that its registered design did not lack novelty and therefore should not be invalidated on that basis, still had an interest in its claim as the contested decision did not take into account its arguments that the earlier design was not representing a shower drain but only consisted of a cover plate that can be used in drainage channels (Paras. 31-35). 4. Regarding the claim of the applicant to annul the contested decision the GC has concluded that it was founded. Contrary to the ID, the contested decision has held that the RCD consisted of a rectangular cover plate, the elongate slots and the thin outer edges of the shower drain, all of these being visible when the product is in normal use. The GC has concluded that this finding was correct but that it was wrong to

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compare it to only a part of the earlier design namely the cover plate, without taking into consideration its other parts that were shown in the catalogues submitted by the holder of the earlier designs (Para. 61) 5. Regarding the claim of the applicant to confirm the decision of the ID, after eventual correction of the grounds, the GC has held it was not founded. It concludes that the examination in the contested decision of the novelty of the RCD in relation to the earlier designs was incomplete, but that for the GC taking up the administrative and examination related tasks that were the responsibility of the Office, would be a breach of the institutional balance and for this reason only the annulment of the contested decision is required. The second claim of the applicant is therefore rejected. 6. Regarding the claim to annul the contested decision for other reasons than the ones invoked by the applicant the GC concludes that it is founded. The GC is of the opinion that the Office has the duty to state reasons, and to determine the product indication of the older designs which is relevant for the finding of the individual character of the later design. By indicating that the older design was applied to a shower drain and not to a broader category of drainage channels that could also be used for industrial purposes, this duty was not fulfilled (Paras. 98, 133, 138).



Case T-218/13; Nutrexpa, S.L. & Kraft Foods Italia Intellectual Property S.r.l. v OHIM, Judgment of 21 May 2015 Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Relative grounds, Similarity of the signs, visual similarity, Conceptual similarity, Similarity of the goods and services, Distinctive element

LEGAL NORMS: Article 8 (1) (b) CTMR

FACTS: The applicant sought to register the figurative sign Cuetara Maria Oro represented below as CTM for Classes 29 and 30. An opposition based on several CTM and Italian marks below, covering products in Class 30, was filed on the grounds of Article 8(1) (b). The Opposition Division partially upheld the opposition on the basis of Article 8(1) (b) CTMR, finding that there was a likelihood of confusion between the marks for certain products in Classes 29 and 30.

The Board of Appeal (BoA) dismissed the appeal and confirmed the likelihood of confusion on the basis of the earlier CTM.

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CTMA



Earlier marks



SUBSTANCE: On the relevant public and on the goods and services;

The GC confirmed the assessment of the BoA according to which both the general public in the European Union is the relevant public and also that that the goods to which the appeal related are partly identical and partly similar (Para. 31). These findings were not questioned by the applicant.

On the distinctiveness of the earlier mark

As regards the degree of distinctiveness of the term ORO, the BoA considered that for Italian and Spanish consumers the term which means that the product is of superior quality has a low degree of distinctive character. The degree of distinctiveness is average for the other consumers that do not get the meaning of the term ORO. This analysis was confirmed by the GC (Para. 36). The applicant's arguments that in a previous case the GC had already declared the low degree of distinctive character of the word ORO (judgment of 5/4/2006 Saiwa/OAMI — Barilla Alimentare (SELEZIONE ORO Barilla) (T 344/03, Rec, EU:T:2006:105) was rejected, as the applicant in this case could not show evidence of the intrinsic distinctiveness of the terms ORO in different countries (Para. 38).

On the visual comparison

The GC confirmed the BoA's assessment that both signs share some visual features due to the presence of the word ORO in capital letters with a similar font, in the contested sign since the terms CUETARA and MARIA are of minor importance (Paras. 45 and 46).

On the phonetic comparison

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The GC held that there was some sort of phonetic similarity between the signs due to the pronunciation of the word ORO (Paras. 48 and 49).

On the conceptual comparison

The GC confirmed that the BoA was right to conclude that for those consumers who do not understand the meaning of the word Oro, for those others than Italians and Spanish, the marks have no conceptual similarity (Paras. 52 and 53).

On the likelihood of confusion

The GC concluded that the BoA was right to find likelihood of confusion as the signs share some visual and phonetic similarity and the products are identical or similar (Paras. 56, 57 and 58).

Case T-271/13; Nutrexpa, S.L. & Kraft Foods Italia Intellectual Property S.r.l. v OHIM, Judgment of 21 May 2015 Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Relative grounds, Similarity of the signs, visual similarity, Conceptual similarity, Similarity of the goods and services, Distinctive element

FACTS: The applicant sought to register the figurative sign Cuetara Maria Oro represented below as CTM for Classes 29 and 30. An opposition based on several CTM and Italian marks below, covering products in Class 30, was filed on the grounds of Article 8(1) (b). The Opposition Division partially

upheld the opposition on the basis of Article 8(1) (b) CTMR, finding that there was a likelihood of confusion between the marks for certain products in Classes 29 and 30.

The Board of Appeal (BoA) dismissed the appeal and confirmed the likelihood of confusion on the basis of the earlier CTM.

CTMA



Earlier marks



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SUBSTANCE: On the relevant public and on the goods and services;

The GC confirmed the assessment of the BoA according to which both the general public in the European Union is the relevant public and also that that the goods to which the appeal related are partly identical and partly similar (Para. 31). These findings were not questioned by the applicant.

On the distinctiveness of the earlier mark

As regards the degree of distinctiveness of the term ORO, the BoA considered that for Italian and Spanish consumers the term which means that the product is of superior quality has a low degree of distinctive character. The degree of distinctiveness is average for the other consumers that do not get the meaning of the term ORO. This analysis was confirmed by the GC (Para. 36). The applicant's arguments that in a previous case the GC had already declared the low degree of distinctive character of the word ORO (judgment of 5/4/2006 Saiwa/OAMI — Barilla Alimentare (SELEZIONE ORO Barilla) (T-344/03, Rec, EU:T:2006:105) was rejected, as the applicant in this case could not show evidence of the intrinsic distinctiveness of the terms ORO in different countries (Para. 38).

On the visual comparison

The GC confirmed the BoA's assessment that both signs share some visual features due to the presence of the word ORO in capital letters with a similar font, in the contested sign since the terms CUETARA and MARIA are of minor importance (Paras. 45 and 46).

On the phonetic comparison

The GC held that there was some sort of phonetic similarity between the signs due to the pronunciation of the word ORO (Paras. 48 and 49).

On the conceptual comparison

The GC confirmed that the BoA was right to conclude that for those consumers who do not understand the meaning of the word Oro, for those others than Italians and Spanish, the marks have no conceptual similarity (Paras. 52 and 53).

On the likelihood of confusion

The GC concluded that the BoA was right to find likelihood of confusion as the signs share some visual and phonetic similarity and the products are identical or similar (Paras. 56, 57 and 58).

Case T-607/13; Granette & Starorežná Distilleries a.s. v OHIM, Judgment of 19/05/2015, Language of the case: CZ

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Common element, Dominant element, Distinctive element, Figurative trademark, Relative grounds, Graphical representation, Similarity of the signs, Similarity of the goods and services, Enhanced distinctiveness, Phonetic similarity, Number

FACTS: The applicant sought to register the figurative mark represented below as a CTM for goods and services within Classes 33 and 35. An

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opposition based on the earlier word mark '42 BELOW' and figurative mark represented below, registered for goods and services in Classes 33 and 35, was filed on the grounds of Article 8(1)(b) CTMR. The Opposition Division upheld the opposition. The Board of Appeal (BoA) dismissed the applicant's appeal. The applicant filed an action before the General Court (GC).

CTMA



Earlier marks



42 BELOW

SUBSTANCE: The GC dismissed the applicant's arguments about consumers of alcoholic beverages being very well-informed and able to distinguish the marks based on minimal details. It stated that alcoholic beverages are goods of common consumption and that the relevant public is public at large, reasonably well-informed and attentive. As regards services in Class 35, the BoA was right to state that the relevant public is composed of professionals with attentiveness higher than average. The GC reminded that it is not possible to compare the marks based on only one of their elements, unless the remaining elements are negligible. On the other hand, it found that the BoA, contrary to the claims of the applicant, did take into account all the elements of all marks and compared them based on the overall impression they create. The number 42 is significantly larger than the other verbal components of the marks and it is placed on a prominent position in the centre of the earlier mark and at the top in the contested application. Moreover, its original graphic representation (the number 4 is placed lower than the number 2) attracts the consumers' attention. The BoA did not err in finding that the number 42 is the dominant element of both figurative marks. The arguments of the applicant did not show that this finding is incorrect. It cannot be excluded that part of the public may perceive the number 42 as the indication of the amount of alcohol in the products but even if this element had low distinctiveness, the fact remains that this number, owing to its position,

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size and graphic representation, is the component of the marks which attracts the most attention. It is in any case normally distinctive in relation to the services in Class 35. The marks are similar visually, aurally and conceptually, the differences reiterated by the applicant are essentially marginal. The GC dismissed all the applicant's arguments as to possible meanings of the word 'BELOW' or its combination with the number 42 (the word 'below' is fanciful for a significant part of the public and it is not likely that the public will perceive the sign as an indication of the place of production, namely 'below the 42nd Parallel of latitude'). The GC reminded of the special importance of the phonetic similarity between the signs as regards alcoholic beverages in Class 33 since they are often ordered orally in bars and restaurants. Finally, the GC concluded that, also taking into account the enhanced distinctiveness of the earlier mark undisputed by the applicant, the differences between the marks are not sufficient to exclude the existence of likelihood of confusion. The action was dismissed.

Case T-559/13; Giovanni Cosmetics, Inc. v OHIM, Judgment of 3 June 2015, Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Beginning of mark, Common element, Conceptual similarity, Distinctive element, Identity of



goods and services, Likelihood of confusion; Name, Phonetic similarity, Relative grounds, Relevant territory, Similarity of goods and services, Similarity of signs, Visual similarity, Weak element, Complex mark, Enhanced distinctiveness, Figurative element

FACTS: The applicant sought to register the figurative mark GIOVANNI GALLI as a CTM for goods in, inter alia, Class 3. An opposition based on the earlier CTM GIOVANNI registered for goods in Class 3, was filed on the grounds of Article 8 (1) (b) CTMR. The goods in question were found to be partly identical and partly similar (not disputed). The Opposition Division rejected the opposition and the Board of Appeal (BoA) dismissed the appeal.



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SUBSTANCE: Although the General Court (GC) confirmed no likelihood of confusion, it identified several errors in the contested decision: (i) BoA was wrong to find that the first name Giovanni would be perceived as a common Italian first name by the whole of the relevant public (Para. 41). (ii) In the absence of any specific evidence provided by the Office relating to the perception of the public throughout EU, it is not appropriate to extend the Case-Law pursuant to which, in certain Member States, surnames have, as a general rule, a more distinctive character than first names so that it applies to the whole of EU (Para. 52). BoA was wrong to ascribe greater distinctiveness to the element 'galli' than to the element 'giovanni' for the whole of the relevant public (Para. 53). For the relevant public outside Italy, the inherent distinctiveness of the elements 'giovanni' and 'galli' is identical, and corresponds to an average distinctiveness (Para. 54). (iii) From the point of view of the part of the relevant public which ascribes the same distinctive character to the elements 'giovanni' and 'galli', the marks at issue have a low degree of visual similarity, an average degree of aural similarity and a low degree of conceptual similarity (Para. 99).

Enhanced distinctiveness: The mere reference to Google search results cannot establish that a CTM has enhanced distinctiveness through use. A trade mark which is well known outside EU may for that reason appear in a prominent position among the search results regardless of whether a significant part of the public in EU is also familiar with that

mark (Para. 112).

Likelihood of confusion: The presence of the same Italian first name, which is not perceived as either common or rare, in trade marks covering cosmetic preparations and perfumery does not always permit a conclusion that there is LOC (Para. 117). For cleaning products and cosmetics the visual aspect is particularly relevant. The differences in the word GALLI and a striking figurative element exclude likelihood of confusion (Paras. 129-131).

Case T-22/13 and T-23/13; Senz Technologies BV v OHIM, Judgment of 21 May 2015, Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Design, Functional element, Overall impression, Informed user, Freedom of the designer, Patent, Conflict of design with other right, Shape of the product, Specialised public, Substantiation of earlier right, Individual character

FACTS: The applicant Senz Technologies, BV filed two applications for registration of a Community design which was registered on 17th of October 2006 with the indication mentioning 'umbrellas' (hereinafter the contested design). On July 16 2009, the intervener Impliva BV, lodged an application for a declaration of invalidity based on Article 25 (1) (b), alleging that the contested designs did not

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comply with the requirements laid down in Articles 4 to 9 of CDR. The intervener invoked that the umbrellas covered in the contested design didn't have individual character as they created the same overall impression on the informed user, as a certain number of umbrellas that had an identical/similar shape and which, have been the subject of patents or designs registered and made available to the public prior to the registration of the contested designs. The earlier rights relied on included an American patent. On October 2010, the Invalidation Division upheld the intervener's applications for a declaration of invalidity. It found that the earlier patent had been made available to the public within the meaning of Article 7 (1) CDR as well as devoid of individual character within the meaning of Article 6 (1) CDR. On 14 December 2010, the applicant brought an appeal against each of the decisions adopted by the Invalidation Division. By decisions dated 26 September 2012, the Third Board of Appeal (BoA) dismissed the appeals on the ground that the contested designs did not have distinctive character. In this light, the BoA considered that the earlier patent could reasonably be known to the circles specialised in the sector concerned within the EU, since the site of the USPTO is accessible free of charge. It was also held that the informed user knows the different designs and the normal characteristics of umbrellas and has a relatively high level of attention. With regard to the freedom of the designer, the BoA held that there is some degree of freedom considering the wide range of

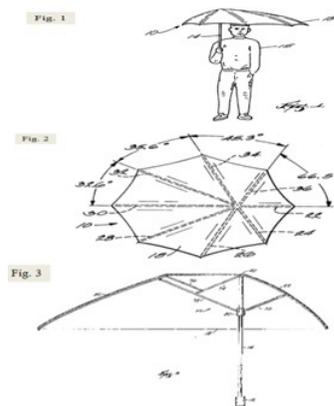


possibilities of decorating the canopy of an umbrella with patterns and colours. The applicant filed an action before the General Court (GC) in both cases T-22/13 and T-23/13 pleading for the annulment of the contested decisions.

Contested Design



US Design Patent



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SUBSTANCE: The applicant relied on two pleas in law: (i) infringement of Article 7 (1) CDR and (ii) infringement of Article 6 (1) CDR. With regard to the first plea in law, the applicant begins by criticising the BoAI for having held that an American patent could be known to circles specialised in the sector concerned operating in the European Union (Para. 19). Secondly, the applicant criticises the BoA for having held that the average EU designer of umbrellas would have known that, in the United States, the term 'patent' also refers to 'design', when even many European intellectual property lawyers are not aware of this fact (Para. 20). Thirdly, the applicant challenges the BoA's statement that 'it would be imprudent for designers seeking to register designs in the EU not to check for the existence of prior art in one of the world's major IP registers (namely the USPTO) given the almost legendary reputation of the United States as a centre of innovation and designs ...' in the sense that a small or medium sized enterprise would only search the existing market in the EU (Para. 21). The applicant's fourth point of argument was, that contrary to the BoA's finding, specialised circles in the umbrellas sector may not be aware of developments in the United States, because: (i) contrary to what the BoA held, the United States is not the European Union's principal trading partner in umbrellas; and (ii) it is not possible to be aware of the existence of an umbrella patented in the United States if it has never been manufactured and marketed (Para. 22). The GC found that it seems reasonable that the designer of a wind-resistant umbrella, will undertake searches in patent registers before placing them on the market, as she may be deemed to know that

such a product must meet not only aesthetic but also technical requirements (Para. 32). In this light, the applicant failed to substantiate the argument that specialised circles in the umbrella sector do no engage in such searches (Para. 32). With regard to the second argument concerning the fact that EU lawyers are unaware of design patents, the GC found that the applicant failed to adduce any factual evidence or argument to support such allegation (Para. 33). As to the third argument presented above, the GC found that the applicant did not provide any specific information about the companies operating in the EU umbrella sector and therefore, failed to substantiate its allegations (Para. 35). Lastly, with regard to the fourth argument presented above, the GC found that Article 7 (1) CDR does not impose any requirement that the earlier design relied on by the opposing party, must have been used for the manufacture or marketing of a product (Para. 36). The argument put forward regarding the fact that the earlier patent could not have been known by the circles specialised in the sector because it had never been produced was not accepted by the GC, since the sector concerned could have gained knowledge otherwise, namely through an online search in the American patent register (Para. 37). In addition, the GC found that even if the US are not EU's principal trading partner, such fact does not preclude the fact that the earlier patent could have been known to the specialised circles (Para. 38). In this light, the first plea in law was rejected in its entirety. With regard to the second plea in law, the GC upheld the definition of the informed user provided by the BoA, as someone wishing to use an umbrella, who needs to purchase one and who has become

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informed on the subject (Para. 41-46). With regard to the level of attention of the informed user, it was held that neither an unusual shape of the umbrellas at issue nor the fact that they may be solely a fashion accessory affects the level of attention of the informed user (Para. 53). When assessing the freedom of the designer, the GC pointed out that the umbrellas covered by the contested designs are umbrellas intended to have a wind-resistant function, which places limitations subsequently on the possibilities for varying inter alia the shape and depth of the canopy, ribs and eye savers (Para. 58). Accordingly, the GC concluded that the degree of freedom of the designer is limited resulting in the fact that even minor differences between the earlier patent and the contested designs suffice to produce different overall impressions on the informed user (Para. 59). Regarding the overall impressions produced by the earlier patent and the contested designs, the GC concluded that the canopy shapes that characterise the overall impressions produced by the earlier patent and by the contested designs are the ones that give each of the umbrellas examined a very specific and, therefore, individual character within the meaning of Article 6 (1) CDR, rejecting the arguments put forward by Office and the intervener (Para. 93-95). The GC points out that if Office's line of argument were to be followed, it would lead to a situation where the proprietor of the first design registered for a new product could prevent protection of any subsequent design concerning the same category of products on the sole ground that the new and unusual character of the design of the first model no longer allows for identification and perception of differences in subsequent models

or, that the first design protected precludes, for the duration of its protection, any future design concerning the same type of product (Para. 95). In this light, The GC concluded that the BoA erred in attaching only limited importance to the features which also resulted from the wind-resistance function of the umbrellas covered by the contested designs for the purpose of assessing the individual character of those designs (Para. 101). The GC therefore concluded that the applicant's second plea was admissible. The action was upheld and the contested decision annulled (Para. 102).

Case T-203/14; Mo Industries LLC v OHIM, Judgment of 21 May 2015, Language of the case: EN

RESULT: Action dismissed

Keywords: Absolute grounds, Laudatory mark, Figurative trademark, Descriptive element, Distinctive element, Typographical element, Graphical representation, Dissimilarity of the goods and services, Principles of non-discrimination

FACTS: The applicant sought to register the mark below as a CTM for goods within Classes 18 and 25. The examiner refused to register CTM on the grounds that the mark was descriptive and lack distinctiveness. The Board of Appeal (BoA) dismissed the applicant's appeal. The applicant filed an action before the General Court (GC).

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CTMA



SUBSTANCE: ON THE VIOLATION OF ARTICLE 7 (1) (b)

The applicant did not dispute the findings of the BoA that the goods at issue were aimed at the general public and that the average consumer of the goods at issue was deemed to be reasonably well informed and reasonably observant and circumspect. Since the sign consisted of a term which exists in English, its distinctiveness had to be assessed with respect to the English-speaking public in the European Union. The GC confirmed that those findings are correct (Para. 19). The GC confirmed the BoA's assessment that the word element in the mark applied for is composed of an ordinary word in English which means, inter alia, 'grand', 'spectacular', 'superb' or 'gorgeous' (Para. 20). Therefore the GC held that the word element 'splendid' refers clearly to goods the appearance of which presents such qualities. That word element is therefore laudatory for the sake of advertising, the purpose being to highlight the positive qualities of the goods for the presentation of which that element is used (Para. 21). The word element of the mark applied for will be perceived immediately by the relevant public as a

promotional formula which indicates to consumers that the goods covered by the mark are aesthetically superior to competing. This is particularly true since that term is commonly used in everyday language, as well as in trade, as a generic laudatory term (Para. 23). The GC confirmed the finding of the BoA when it held that although the mark applied for is presented in a typeface emulating handwriting, it does not present any striking originality which could add to the distinctive character of that mark. It added that, on the contrary, the typeface used, although stylised, cannot divert the consumer's attention from the clear message conveyed by the term 'splendid' (Para. 24). The GC admitted that the graphic style of the typeface used has certain specific features. However, cursive script is an ordinary and traditional style which is used by both children and adults, in daily life or in a professional context, and which remains largely unremarkable from the perspective of any consumer and, in the present case, of the relevant public (Para. 26). The relevant public will immediately understand the term 'splendid', applied to the goods covered by the mark applied for, as a laudatory reference to their aesthetic quality (Para. 28). In relation with the argument that the figurative element over the "i" is a Community trade mark registered in respect of goods in Class 25 and services in Class 35 the GC recalled that the assessment of the distinctive character of the mark applied for must relate to the overall impression that it produces and not to each of its elements (Para. 30). Therefore the BoA was

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correct to hold that the fact that the mark applied for contains, in place of the dot over the letter 'i', a figurative element which is a registered Community trade mark is not conclusive for the purposes of assessing the distinctive character of that mark as a whole (Para. 31). If it were to be assumed that, considered in isolation, the figurative element placed over the letter 'i' has a distinctive character, that distinctive character could not benefit the mark applied for in so far as that mark is composed of other dominant elements which are decisive in the overall impression that it produces (Para. 32). As the BoA pointed out, in the overall analysis of the distinctive character of the mark applied for, that figurative element merely replaces the usual dot over the 'i' and thus will be attributed that function within that mark. Moreover, because of its size, that figurative element plays a minor role in the mark considered as a whole (Para. 33). For the GC this assessment is supported by the fact that the average consumer must place his trust in the imperfect picture of the mark that he has kept in his mind (Para. 34).

On the alleged infringement of the principles of equal treatment and of sound administration Contrary to what may have been the position with regard to certain earlier applications for the registration of signs, the GC confirmed that the present application for registration was caught by one of the grounds for refusal set out in Article 7(1) CTMR (Para. 49). In those circumstances, in view of

the lack of distinctive character of the mark applied for, the GC held that the applicant cannot validly invoke the registration of earlier trade marks by Office (Para. 50). The arguments of the applicant that it is the proprietor of certain earlier marks registered by the Office and that the BoA did not provide any specific argument to explain why those two earlier marks did not constitute valid precedents were rejected (Para. 51). First, the BoA concluded that the mark applied for fell within the scope of the ground for refusal set out in Article 7(1)(b) CTMR after carrying out a stringent and full examination of the factual circumstances of the present case. Secondly, while it is true that the applicant does not rely on an unlawful act committed in favour of a third party when it invokes Community trademarks of which it is itself the proprietor, that fact cannot lead to the authorisation of the unwarranted registration of a trade mark which, in view of the facts of the present case, is caught by one of the grounds for refusal set out in Article 7(1) CTMR. Thirdly, the BoA, in the contested decision, analysed whether or not it should adopt an identical decision to those previously adopted by the Office in respect of the two Community trademarks of which the applicant is already the proprietor (Paras. 52, 53 and 54). However the GC recognised that contrary to what was stated by the BoA in the contested decision, the goods covered by the applicant's earlier marks are not 'substantially' different from those covered by the mark applied for. Nevertheless, there are certain differences between the goods covered by

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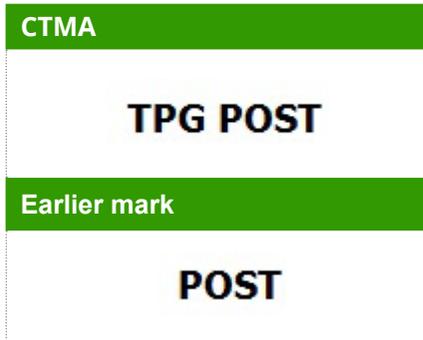
the applicant's earlier marks and those covered by the mark applied for which were pointed out by the BoA. Furthermore, in the application, the applicant acknowledges that those goods are not identical and claims solely that they are closely related (Para. 55). Moreover the GC pointed out that the trademarks of which the applicant is already the proprietor are not strictly identical to the mark applied for in the present case. The BoA which noted certain differences concerning the marks in question and the goods which they cover thus provided adequate reasons for its decision in the present case (Para. 56 and 57). The fact that the goods covered by the earlier marks invoked by the applicant are closely linked to those covered by the mark applied for cannot have the effect of authorising, in the present case, the registration of the latter (Para. 59).

Case T-102/14; Deutsche Post AG v OHIM, Judgment of 13 May 2015; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Weak element, Descriptive element, Dissimilarity of the signs, Identity of the goods and services, Company name, Beginning of mark, First time on appeal, Distinctiveness acquired by use, Visual dissimilarity, Phonetic dissimilarity, Conceptual dissimilarity, Relative grounds, Likelihood of confusion

FACTS: The applicant sought to register the word mark TPG POST as a CTM for goods and services within Classes 6, 9, 16, 20, 35, 38 and 39. An opposition based on the earlier German word mark POST, registered on account of acquired distinctiveness in 2003, and the earlier Community word mark Deutsche Post was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division dismissed the opposition and the Board of Appeal confirmed the decision.



SUBSTANCE: The GC dismissed the appeal confirming that there is no likelihood of confusion between the conflicting signs even though the CTMA partially contains the earlier national mark. THE GOODS AND SERVICES are partially (dis-)similar and for the rest identical (Para. 33). FOR THE SIMILARITY OF THE SIGNS, as follows from Case-Law, account must be taken of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially,

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account may be taken of the relative position of the various components within the arrangement of the complex mark. Account must be taken of the intrinsic qualities of each element (Para. 37). The relevant public attaches more importance to the CTMA's beginning, TPG (Para. 42). The fact that "POST" is ought to have a certain independent distinctive role on account of its registration as a national mark (C-196/11 P, 24/05/2012 Formula One Licensing/HABM) does not require to attach such a high degree distinctiveness thereto that it gives an unlimited right to oppose all trade mark applications containing it (Para. 43). A word forming part of a composite sign may be perceived differently than on its own or in combination with other elements. In this case, when following the company initials "TPG" (in accordance with the practice in this sector to use three capital letters as company signs) the word "POST" will be perceived as a reference to the postal goods and services offered by this company. Thus, it is considerably less distinctive than "TPG" (Para. 45). This finding cannot be called into question by Case-Law (C-120/04, 6/10/2005, Medion): a) the factual circumstances differ in that "life" was considered to have normal degree of distinctiveness in that Case-Law, contrary to the word "POST" (Para. 50); b) "POST" forms a logical unit together with "TPG" (Para. 51); c) the mere fact that an earlier mark is contained in a CTMA does not amount to an usurpation for which,

rather, a likelihood of confusion is required (Para. 52). The signs show visual and aural differences (Para. 54-55). This also applies conceptually since the earlier mark will be perceived as a reference to the opponent as the traditional service provider in Germany whereas the CTM evokes postal products and services offered by the company TPG (Para. 56). IN THE GLOBAL ASSESSMENT, with respect to these differences there is no likelihood of confusion taking also account of the fact that the relevant public is used to encounter various postal service providers which are using the word "POST" as part of their company signs (Para. 63-64). The claimed enhanced distinctiveness of the earlier mark was not shown and, in any event, would not give rise to a likelihood of confusion (Para. 70). The CTMA will not be considered to form part of the opponent's family of marks (INFOPOST, E EPOST, POSTKIT, etc.) since there is no evidence for the relevant public to be familiar with it and they will not be related with one another due to their different structure (Para. 72). The earlier Community word mark "Deutsche Post" is even more different than "POST" and thus a likelihood of confusion excluded.

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Case T-145/14; adidas AG v OHIM; Judgment of 21 May 2015; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

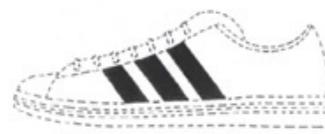
KEYWORDS: Relative grounds, Likelihood of confusion, Visual similarity, Position mark, Ornamentation, Survey, Reputation, Translation, Right to be heard,

FACTS: The applicant sought to register as a CTM the below position mark for 'footwear' in Class 25. The opponent filed an opposition based on a number of earlier Community and German registered trademarks, as well as on non-registered German trademarks. For the sake of the summary, only the earlier CTM is reproduced below. The grounds of opposition were Articles 8 (1) (b), 8 (4) and 8 (5) CTMR. The Opposition Division rejected the opposition. The Board of Appeal (BoA) dismissed the appeal, taking the view that the differences in the stripes' positioning and inclination on the shoes, as well as in their number, were sufficient to find that the signs at issue were, overall, dissimilar. The BoA considered that those differences will not pass unnoticed, because consumers are accustomed to seeing geometric designs on shoes and pay attention to the details of those products. Thus, because of the lack of similarity between the signs, the BoA found that both Articles 8 (1) (b) and 8 (5) were inapplicable.

CTMA



Earlier mark



SUBSTANCE: The General Court (GC) upheld the appeal and annulled the BoA's decision. The GC held that the BoA's finding that the differences in the stripes' positioning and inclination on the shoes will not pass unnoticed by the consumer, who pays attention to the details of sports shoes, is at odds with the fact that the consumer of those products does not demonstrate a high degree of attention (Para. 32). The presence of stripes on the outside of the shoe will be easily and immediately noticed by the average consumer as being an element of similarity, whereas the differences in the stripes' positioning and inclination are noticeable only if the consumer undertakes a closer inspection (Para. 34). The signs have a similar configuration in that they consist of Parallel stripes, equidistant and of the

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same width, which contrast with the background, and these characteristics are not elements that could be excluded from an assessment of those marks as a whole (Para. 39). The GC went on to find that the BoA had attributed too much importance to whether there were two or three stripes on the outside of the shoe, and that that difference cannot be regarded as important for the average consumer with an average level of attention (Para. 40). Taking into account the elements clearly common to the marks at issue — Parallel sloping stripes, equidistant, of the same width, contrasting with the base colour of the shoe, placed on the outside of the shoe — the GC concluded that the overall impression produced by the marks is, to a certain extent, similar (Para. 43). Noting that the BoA had considered the earlier marks to enjoy a high reputation in the sports shoes and clothing sector and that that reputation extended to a three-stripe figurative device (Para. 47), the GC held that the errors the BoA made in its assessment of the similarity of the signs are liable to have consequences on the validity of its assessment of the likelihood of confusion (Para. 49). It therefore upheld the first plea alleging infringement of Article 8 (1) (b) CTMR. Further, it held that the BoA's erroneous assessment regarding the similarity of the signs influenced all the more its analysis of the ground based on Article 8 (5) CTMR, and therefore it upheld the second plea. Finally, the GC considered it unnecessary to rule on the third plea alleging infringement of Article 8 (4) CTMR.

Case T-71/14 Swatch AG v. OHIM; Judgment of 19 May 2015; Language of the case: EN

KEYWORDS: Relative grounds, Common element, Dilution of distinctiveness, Unfair advantage, Similarity of the signs, Reputation, Nature of the goods and services, Dissimilarity of the goods and services

RESULT: Action dismissed

FACTS: An application was filed for the mark SWATCHBALL for goods and services in Classes 9, 35, 41 and 42. An opposition was filed pursuant to Article 8 (1) (b) and 8 (5) based on the earlier marks (IR and CTM) for goods in Class 14. The Opposition Division rejected the opposition. The Board of Appeal dismissed the appeal. No likelihood of confusion was found as the goods and services are dissimilar. No infringement of Article 8 (5) CTMR was found either, as the goods and services were so different that a link is unlikely, with no prove of dilution or unfair advantage.

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CTMA

SWATCHBALL

Earlier marks

SWATCH
swatch



Case T-635/14; Urb Rulmenti Suceava SA v OHIM, Judgment of 21 May 2015, Language of the case: EN

RESULT: Action is dismissed

KEYWORDS: Relative grounds, Substantiation of earlier right, Ownership, Proprietor consent, Bad faith, Infringement, License agreement, Use by another undertaking, International registration, Likelihood of confusion

FACTS: This case concerns a situation where the Romanian collective trade mark URB was once exploited by different producers of bearings, under the control of a public entity linked to the Romanian Government and which also owned those collective marks. Following the start of a privatisation process, the assets of this public entity were transferred to a private company which became the registered owner. However, several companies, including the invalidity applicant and another company of which the CTM proprietor, a physical person, was the manager and shareholder, were authorised to use the earlier collective trademarks. In 2002, following an amendment, the use regulation did no longer contain the list of undertakings authorised to use those collective trademarks. It was rather established that third parties would have the right to use them only under a franchise agreement managed by the registered proprietor of those trademarks, but the invalidity applicant never entered such an agreement. Following registration

SUBSTANCE: The GC confirms the lack of link. Although two factors weigh in favour of finding a link (similarity of the marks and high reputation of the earlier mark), other factors weigh against such a finding, like the different nature of the goods and services, the different distribution channels, the fact that they are neither interchangeable nor in competition, that they have different purposes, and that they do not occupy adjacent market segments. Furthermore, they are addressed to two separate relevant publics, the CTMA to a specialised public and the earlier marks to the general public. (Paras. 29-31).

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of the contested mark by the CTM proprietor, the invalidity applicant sought its cancellation, relying, on the one hand, on two earlier registered Romanian collective trademarks and on two International trademark registrations designating a number of Member States and, on the other, on the alleged bad faith of the CTM proprietor. The evidence showed that these four registrations stood in the name of a third company. The invalidity applicant asserted that it was authorised to use those trademarks and to file the invalidity action, as the registered owner of those trademarks, expressly requested, had declined to do so. The Cancellation Division rejected the invalidity request on the grounds that no evidence had been adduced of the bad faith of the CTM proprietor and that the invalidity applicant, which was not the proprietor of the earlier marks, was not entitled to rely on them to argue the existence of a likelihood of confusion. On appeal, the Board of Appeal confirmed the first instance's decision.

CTM



SUBSTANCE: The General Court (GC) dismissed the appeal. It was not persuaded by the invalidity applicant's argument that, given the refusal to act of the registered owner of the earlier marks, it was entitled, pursuant to the provisions of Article 22 (2) and (3) and of Article 72 CTMR, to bring invalidity proceedings. In the first place, the GC noted that under Article 56 (1) (b) CTMR, an application for a declaration of invalidity may be submitted to the Office, where Article 53 (1) applies, by the proprietors of earlier trademarks and licensees authorised by the proprietors of those trade marks (Para. 18). It did not appear from the documents before the GC that the invalidity applicant either had a licence or, in any event, had been authorised by the registered proprietor of the earlier marks to file an application for a declaration of invalidity with the Office (Para. 19).

Secondly, the GC noted that the provisions of Articles 22 (3) and 72 CTMR are not applicable to invalidity requests but only to actions for infringement, and that the same was true of the provisions of Romanian law relied on by the invalidity applicant (Para. 25). As to the alleged bad faith, the GC referred to the existing Case-Law and recalled that account may also be taken of the commercial logic underlying the filing of the application for registration of a Community trade mark. Even in circumstances where several producers were using, on the market identical or similar signs for identical or similar products, capable of being confused with the sign for which registration was sought, still the

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CTM proprietor's registration of the sign may be in pursuit of a legitimate objective (Para. 33).

The GC held that it was understandable, from a commercial point of view that the CTM proprietor wished to extend the protection of the trade mark by registering it as a Community trade mark. In that respect, the evidence on file showed that, during the period which preceded the filing, the CTM proprietor used the trademark, through a connected company, and generated turnover from goods marketed under the trademark in several Member States, which was a plausible incentive for filing an application for the registration of a Community trade mark (Para. 43). The invalidity applicant did not establish that it was the CTM proprietor's intention to exclude it from the market (Para. 46). The fact that the CTM proprietor knew or should have known that a third party (i.e. the invalidity applicant in this case) has long been using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought is not sufficient, in itself, to permit the conclusion that the CTM proprietor was acting in bad faith when filing the application (Para. 49).

Case T-183/13; Skype Ultd. v. OHIM; Judgment of 5 May 2015; Language of the case: EN

KEYWORDS: Relative grounds, Likelihood of confusion, Similarity of the signs, Visual similarity, Phonetic similarity, Conceptual similarity, Beginning of mark, Identity of the goods and services, Allusive trademark, Enhanced distinctiveness, Coexistence of trademarks, Dilution of distinctiveness, Weak element, Distinctive element, Relevant territory

RESULT: Action dismissed

FACTS: An application was filed for the word mark 'SKYPE' for 'providing voice over Internet protocol (VOIP) peer-to-peer communications, electronic transmission of data and documents over computer terminals and instant messaging services; providing a high speed access to area networks and a global computer information network' in Class 38. An opposition was filed pursuant to Articles 8 (1) (b), 8 (4) and 8 (5) CTMR based on, inter alia, the earlier CTM 'SKY' for 'telecommunications, including videoconferencing services and sharing of files, images, music, video, photos, drawings, audio-visual, text, documents and data; but excluding telegraph communications services' in Class 38. The Opposition Division upheld the opposition. The Board of Appeal (BoA) dismissed the appeal.

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CTMA

SKYPE

Earlier mark

SKY

SUBSTANCE: The General Court (GC) dismissed the appeal. It found that the relevant public consists of the public at large and professionals (Para. 22). The average consumer of the contested peer-to-peer communication services, although choosing those services with care, will have an average degree of attention (Paras. 23-24). The services are identical (Paras. 26-27). The signs are visually and phonetically similar to a medium degree (Paras. 35-37). They are also similar on a conceptual level, since the possibility cannot be ruled out that the relevant public will recognise the term 'sky' in the mark applied for (Paras. 38-39). The earlier mark 'SKY' has an enhanced distinctiveness in the United Kingdom for 'apparatus for recording, transmission or reproduction of sound and images' in Class 9, 'telecommunications' in Class 38 and 'entertainment' in Class 41. The alleged 'secondary meaning' of the contested mark 'SKYPE' (i.e. a link that would be established by consumers between that sign and the namesake applicant's provision of the services)

does not translate into a conceptual content that could offset the existing similarities. On the other hand, in the event that the term 'SKYPE' had actually acquired a meaning of its own for identifying the services covered by the mark applied for, it would be a generic term, and therefore a descriptive one, for that type of service (Para. 49). The GC recalled the established Case-Law to the effect that the (possible) recognition of the mark applied for cannot be taken into account when determining whether there is a likelihood of confusion between two marks (Para. 50). With regard to the alleged 'dilution' of the earlier 'SKY' mark, the GC noted that the applicant limited itself to general and unsubstantiated allegations and that it referred merely in an abstract way to the 'evidence' it provided. The GC stressed that it is not for the GC to research and identify which documents within the case file could serve as the basis of the applicant's arguments (Para. 54). Even if it were accepted that the earlier mark 'SKY' is inherently weakly distinctive for television broadcasting services and for goods in Class 9 directly related to those services, this limited distinctiveness would be overridden by its acquired enhanced distinctiveness for those same goods and products, on account of its recognition by the relevant public (Para. 55). The applicant's argument based on a supposed peaceful coexistence between the marks was rejected (Paras. 57-64). The GC confirmed the existence of a likelihood of confusion for the relevant public in the United Kingdom, even taking into account a higher level of attention on the part of the relevant public (Paras. 65-66).

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Case T-420/14; **Wine in Black GmbH v. OHIM;**
Judgment of 21 May 2015; Language of the case:
EN

KEYWORDS: Relative grounds, Likelihood of confusion, Visual similarity, Phonetic similarity, Conceptual dissimilarity, Common element, Identity of the goods and services, Common element, Weak element, Company name, Enhanced distinctiveness

RESULT: Action upheld (BoA decision annulled)

FACTS: The applicant sought to register the word mark represented below as a CTM for 'alcoholic beverages, (except beers), in particular: wines, brandy'. An opposition based on the earlier CTM represented below, registered for 'alcoholic beverages, (except beers)' was filed on the grounds of Article 8(1)(b) CTMR. The Opposition Division accepted the opposition in its entirety. The Board of Appeal (BoA) dismissed the applicant's appeal. The applicant filed an action before the General Court.

CTMA

Wine in Black

Earlier marks

NOVAL BLACK

SUBSTANCE: The relevant public consists of average European consumers who are English-speaking or who are deemed to have an elementary knowledge of English, with a reasonable level of attention in respect of wines and other alcoholic beverages. As regards the comparison of the goods they are identical. The signs at issue, in so far as they are composed of a different number of words and are distinguishable because of their initial parts, are visually similar to a low degree only and there is only a low degree of phonetic similarity. Conceptually, while the common word 'black' constituted an element that could give rise to similarity, the signs had to be considered as a whole. The BoA did not so with the contested mark. Even if the word 'wine' by itself was weakly distinctive (not descriptive) in respect of the goods covered, the words 'Wine in black' had an imaginative and evocative character. An expression meaning 'Wine in black' must be regarded as being capable, as a whole, of surprising the public and conveying to it the idea of a wine of elegance and distinction, like a person dressed in black, rather than suggesting to it the simple concept of a wine that is dark in colour. This was not the case with NOVAL BLACK, where the word 'black' was not accompanied by a preposition and a word with a clear meaning, but only by the meaningless word 'noval' which might at most be perceived as a company name. Accordingly the marks had no conceptual similarity, despite their common element 'black'. The word 'black' simply qualifies either an element that is completely fanciful or the

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name of a company and thus does not give rise to an expression which, considered as a whole, may be associated with the same ideas as those with respect to the mark applied for. Accordingly, it must be held that the signs at issue, each examined as a whole, have no conceptual similarity, despite their common element 'black'. The signs are conceptually different. There is no likelihood of confusion, particularly so given that the opponent did not argue an enhanced distinctiveness. No need to consider the admissibility or the merits, relating in particular to the alleged weak distinctive character of the earlier mark due to the existence of many word marks comprising the word 'black' preceded by another word.

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Decision of the Second Board of Appeal of 4 May 2015 in case R1170/2014-2 (EN)

Procedural issues – Evidence of use

The applicant sought to register the figurative mark



for goods and services in Classes 9, 28, 38, 39 and 41.

An opposition was filed invoking Article 8(1)(b) CTMR and based on an earlier right for the word mark 'PATTI PATTÁ' registered in Classes 9, 28 and 41. Following a request from the applicant, the opponent filed proof of use of the earlier CTM.

On 3 March 2014, the Opposition Division issued a decision whereby it rejected the opposition in its entirety.

The opponent appealed the Opposition Division's decision.

The Board found the following: the contested decision held that the extent of use of the earlier mark was not demonstrated with sufficient reliable evidence since the invoices did not mention the earlier mark and the other documents did not give information as to the extent of its use. However, the opponent had filed additional, complementary evidence during the opposition proceedings, namely an auditor's certificate: however, the contested decision did not make any reference to this at all. It was incumbent on the Opposition Division to give proper reasons for exercising its discretion. This it failed to do. The Board deemed the auditor's certificate admissible. There was no reason to have any doubts about the veracity of the information given in the certificate since the figures mentioned fitted with the network of distribution channels. In addition, the certificate was issued by a person independent from the opponent. All in all, the evidence showed use of the earlier mark during a sequence of years throughout the European Union for an extensive network of distribution channels.

Consequently the Board annulled the contested decision and the case was remitted to the Opposition Division for it to assess the likelihood of confusion.

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Decision of the Second Board of Appeal of 21 May 2015 in case R1085/2014-2 (SV)

Article 7(1)(b) CTMR – No relevant link to the goods and services

The applicant sought to register the figurative mark



(Device of an open square) in Classes 6, 9 and 37.

The examiner rejected the application pursuant to Article 7(1)(b) CTMR, as none of the components of the trade mark was held to be distinctive, neither alone nor combined with each other. By referring to the Office's Guidelines, it was held that the simple geometric or figure combination did not possess an inherent distinctive character. At most, the relevant public would perceive the trade mark as a decorative shape.

The applicant appealed the examiner's decision.

The Board annulled the contested decision and stated, in particular the following: the figure applied for was not so simple that it could be denied registration on the grounds cited by the examiner. The trade mark was certainly restrained in detail in its design, but taken in its entirety it was neither a simple geometric figure nor a trade mark that was entirely banal for the purposes of trade mark law.

Nor could a possible association with the symbol for an on/off button ('power symbol') mean that the mark lacked distinctive character, as such a symbol had no relevant link to the goods and services claimed in Classes 6 and 37. In relation to the goods claimed in Class 9, such a symbol could at most be seen as a suggestive reference to the high-voltage-related products applied for. The figurative mark was simple, but the specific composition could certainly be remembered and would enable the relevant public to identify the commercial origin of the goods and services.

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Decision of the Second Board of Appeal of 28 April 2015 in case R2672/2014-2 (EN)

Article 7(1)(b) CTMR – Lack of distinctive character

The applicant sought to register the figurative mark



(Device of a boy) in Classes 3, 9, 14, 16, 18, 20, 21, 24, 25, 28, 29, 30, 32, and 41.

The examiner rejected the application partially (with respect to goods in Classes 14, 16, 20, 21 and 28) pursuant to Article 7(1)(b) CTMR, as the mark

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represented the goods on which it was attached, such as a doll, sticker, decal and so on. The features were not such so as to attract the relevant public's attention. Therefore, it was found devoid of any distinctive character.

The applicant appealed the examiner's decision.

The Board found that the mark was distinctive overall for the following reasons. All the features of the figure were exaggerated sufficiently to distance it from the standard notion of a young boy. The eyes were large and unnaturally round. The face, as a whole, lacked finer details which one would normally find in a photographic image. The Board noted that the body had a slender trunk, with two brush-strokes representing the navel and the chest. The hair was drawn with straight, almost square borders. Two points hinted at kneecaps. The limbs were unnaturally slender. The boy also wore something that resembled crudely made 'trunks'. However, a normal boy would typically wear short trousers and shoes, perhaps with a school blazer or, alternatively, a t-shirt. In contrast, the boy here was virtually identical to the wild, jungle-reared boy protagonist in the famous Walt Disney film 'The Jungle Book'. In other words, the Board found that the mark was not a naturalistic reproduction of any goods which would take the form of, or incorporate, a figure of a small boy. The mark, possessed all the features of a highly stylized cartoon-figure, which departed significantly from that which relevant

consumers would consider a normal or standard representation of a boy. In conclusion, the Board considered the mark to be sufficiently distinctive to function as a badge of trade origin, which was in line with the Boards' decisions dealing with similar 'cartoon character' marks.

As a consequence the contested decision was annulled.

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Decision of the Second Board of Appeal of 21 April 2015 in case R476/2014-2 (EN)

Article 52(1)(a) and 7(1)(b)(c) CTMR - Findings made in a final decision in examination proceedings are not binding in subsequent invalidity proceedings

The CTM proprietor sought to register the word mark 'SMOKING ORGANIC' in Class 34 for cigarette papers, books of cigarette papers; lighters for smokers; cigarette tubing, cigarette filters and smokers' articles. First the examiner rejected the application partially pursuant to Article 7(1)(b), (c) and (2) CTMR, but due to the CTM proprietor's observations, the examiner withdrew his objection and the trade mark was registered.

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The cancellation applicant filed a request for a declaration of invalidity invoking Article 52(1)(a) CTMR in conjunction with Article 7(1)(b), (c), (f) and (g) CTMR.

The Cancellation Division adopted its decision declaring the challenged CTM invalid in its entirety on the basis of Article 52(1)(a) CTMR in conjunction with Article 7(1)(b) and (c) CTMR stating that there was no need to examine the other grounds invoked by the cancellation applicant further.

The CTM proprietor filed a notice of appeal against the Cancellation Division's decision.

The Board found that findings made in a final decision in examination proceedings were not binding in subsequent invalidity proceedings. It also had to be noted that findings made in a final decision in opposition proceedings could not be entirely ignored in the context of a decision in an invalidity action having the same parties, the same subject-matter and the same grounds, provided that those findings or issues decided were not affected by new facts, evidence or grounds. However, that assertion was no more than a specific expression of case-law according to which OHIM's previous decisions were a factor which may be taken into consideration in assessing whether a sign was

suitable for registration. In the Board's view, the combination of the words 'SMOKING' and 'ORGANIC' merely combined the meanings lent by the elements of which it was composed and it was not more than the sum of its parts. Accordingly, the expression 'SMOKING ORGANIC' would be immediately and clearly perceived by the relevant public – who would perceive the meaning of a mark intuitively as identifying goods used for, or in connection with, smoking, which were not made from any synthetic or chemical products.

Consequently, the Board found that the Cancellation Division had not erred in declaring the challenged CTM invalid, and therefore, dismissed the appeal.

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Decisions of the Second Board of Appeal of 29 April 2015 in cases R2981/2014-2 and R2982/2014-2 (EN)

Article 7(1)(b) and (c) CTMR – Descriptiveness and lack of distinctive character

The applicant sought to register the figurative mark



and the word mark '3x3D' in Classes 9, 10, 42 and

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44 covering a range of imaging equipment and associated goods and services.

The examiner rejected both applications for being descriptive and non-distinctive pursuant to Article 7(1)(b) and (c) CTMR.

The applicant filed appeals against the examiner's decisions.

The Board found that the contested decisions were both unintelligible and vitiated by errors of fact and law. Contrary to the examiner's assertion, the marks did not contain an 'English term', nor were they 'composed of generic words'. The marks only contained the number '3', the letter 'D' and the mathematical operator 'x' (and, in case R 2981/2014-2, also a circular black background). Nor, in the Board's view, was the objection sensible, when the examiner claimed that the marks meant 'nine dimensions' and, hence, were descriptive of the goods. The Board pointed out that given that the physical world consisted of only three spatial dimensions (height, breadth and length) and one, arguable, fourth dimension (time), the marks could be not be meaningful to anyone, let alone contain 'obvious and direct information' for the relevant public. Furthermore, when the examiner argued that none of the terms in the mark were 'lexically inventive, conceptually intriguing or surprising', this was contrary to established case-law which insisted that the registration of a sign as a trade

mark was not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness (16/09/2004, C-329/02 P, SAT.2, EU:C:2004:532, § 41). As for the other argument, that '3 x 3 D' meant 'nine dimensions', which belonged to the realm of science fiction and had no obvious meaning at all in relation to the goods and services (at least in our universe) it was impossible to describe the marks as 'laudatory'. On the contrary, 'nine dimensions' was a pure mathematical abstraction which indicated neither quality nor lack of quality, neither good nor bad, neither value for money nor lack of value.

Consequently the Board annulled both contested decisions.

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Decision of the Fifth Board of Appeal of 7 May 2015 in case R2822/2014-5 (ES)

Article 7(1)(f) CTMR – Perception of the relevant public

The applicant sought to register the figurative mark



(CONTRA-BANDO) for rum in Class 33.

The examiner rejected the application on the basis of Article 7(1)(f) CTMR being contrary to public policy

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or to accepted principles of morality.

The applicant challenged the examiner's decision before the Boards of Appeal.

The Board found that when examining a figurative CTM application as a whole it was more than globally considering the verbal elements involved. The graphic representation and the position of the different words 'CONTRA' (on the first line and at the top) and 'BANDO' (on the second line, preceded by a hyphen), having the appearance of a stamped label, had to be considered. Even though the consumer would pronounce the CTM application as a sole word 'CONTRABANDO', referring to the clandestine nature of a product, the image conveyed by the CTM application in relation to the designated goods ('rum') would not reasonably be perceived in any way as an indication of the criminal origin of the product. The CTM application wanted to attract the attention of the relevant public who would merely perceive the sign as provocative and transgressive. Article 7(1)(f) CTMR did not apply.

As a consequence the Board annulled the contested decision and allowed the CTM application to proceed to publication.

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Decision of the Fifth Board of Appeal of 18 March 2015 in case R664/2011-5 (EN)

Articles 52(1)(a) and 7(1)(e)(iii) CTMR - 3D mark - Application of the recent 'Tripp-Trapp' judgment from the CJEC

The 3D mark



(Device of a chair) was registered for paper; printed matter; stationery; instructional and teaching materials in Class 16 and for designer arm chairs in Class 20 on 1 October 2008 on the basis of evidence of distinctiveness acquired through use.

A request for a declaration of cancellation was filed on 1 April 2009 founded on Articles 52(1)(a) CTMR and 7(1)(e)(iii) CTMR – that the shape of the chair gave it substantial value.

The Cancellation Division rejected the request concluding that the chair was rather ordinary and, assessed strictly by its shape, did not draw its value exclusively or substantially from its configuration. The value in the chair arose from its history and exclusivity – from the 'Eames' name (its designers) and the chair's 'pedigree'.

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The cancellation applicant appealed and in the meantime the CJEC issued its judgment in 18/09/2014, C-205/13, Tripp-Trapp, EU:C:2014:2233. That judgment was concerned with the interpretation of Article 7(1)(e)(iii) CTMR.

The Board found that in the 'Eames chair' case, the proprietor had submitted substantial evidence when contending that its sign had acquired distinctiveness through use. This provided convincing material under each of the 'criteria of assessment' in the 'Tripp-Trapp' case that the shape of the Eames chair did, indeed, provide substantial value, resulting in the cancellation of the above registration. In particular, the marketing efforts of the proprietor emphasised the intrinsic design value of the shape of the chair, with emphasis on its position in the pantheon of design greats, as well as other characteristics, identified in the 'Tripp-Trapp' judgment. The 'Tripp-Trapp' judgment represented a broadening of criteria on which the legal test for applying Article 7(1)(e)(iii) CTMR was based. Legal comment and decision making previously had focused on the aesthetic qualities in a shape as the basis behind this provision – in 10 September 2008, R 497/2005-1, Loudspeaker, §§ 10 and 25 it was stated (§ 26) that: 'The fact that the shape may be pleasing or attractive is not sufficient to exclude it from registration. If that was the case, it would be virtually impossible to imagine any trade mark of a shape, given that in modern business there is no product of industrial utility that has not been the

subject of study, research and industrial design before its eventual launch on the market'.

The test under Article 7(1)(e)(iii) CTMR had to be strictly and critically applied before a sign could be refused on the basis of this provision. It was noted that the evidence in the present case was particularly convincing under all the 'heads' of evidence as set out in the 'Tripp-Trapp' judgment.

The Board annulled the contested decision and declared the contested CTM invalid.

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Decision of the Second Board of Appeal of 8 May 2015 in case R676/2014-2 (EN)

Article 8(4) and 76(1) CTMR – Lack of specification of the earlier right's national protection

The applicant sought to register the figurative mark



(TORNADO) for boats and vessels in Class 12.

The opponent filed a notice of opposition against all the goods based on the non-registered trade mark

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TORNADO

used in the course of trade in the European Union. The opponent invoked Articles 8(4) and 8(3) CTMR.

The Opposition Division rejected the opposition as not well founded, on the basis that the opponent had not submitted information on the legal protection granted to the type of trade sign invoked by the opponent, namely a non-registered trade mark.

The opponent filed a notice of appeal against the Opposition Division's decision.

The Board found that Article 8(4) CTMR referred to the situation in which the existence of an earlier right made it possible to prohibit the use of a Community trade mark when the earlier right was protected under national law. It was incumbent upon the parties to indicate which national law it was that enabled the opponent to prohibit the use of a subsequent trade mark based on its right. According to Article 76(1) CTMR, in all inter partes cases, the burden is on the party making a particular claim or allegation to provide the Office with the necessary facts and arguments in order to substantiate the claim. Unlike other grounds in Article 8 CTMR, Article 8(4) CTMR does not specify the conditions governing the acquisition and scope of protection of the earlier right invoked. It is a framework provision where the particulars of the applicable law must be provided

by the opponent. The opponent must, therefore, provide particulars showing that it is entitled under the national law applicable to lay claim to that right and submit all necessary information to demonstrate that the earlier sign falls within the scope of application of the national law, the body of law and the legal regulation thereof according to said national law and that the latter confers the right to prohibit the use of a subsequent trade mark. As in the present case, the opponent did not made any claim as to the meaning of the national law and no evidence was submitted, the Board of Appeal was not obliged to obtain information about national law, UK or otherwise, or to carry out research in that regard. As regards Article 8(3) CTMR the term 'trade marks' had to be interpreted broadly and had to be understood as including unregistered marks, to the extent of course that the law of the country of origin recognised the rights in such marks. However, as was already seen above, the opponent did not submit any information concerning the legal protection granted to the non-registered trade marks used in the course of trade in any of the Member States nor did it submit any explanation as to how that law should be applied to the present case.

As a consequence the Board dismissed the appeal.

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Decision of the Second Board of Appeal of 21 April 2015 in case R1678/2014-2 (EN)

Article 8(1)(b) CTMR – Likelihood of confusion

The applicant sought to register the word mark MAGICSEX for a wide range of services in Classes 38, 41 and 42.

The opponent filed an opposition based on different earlier rights.

The Opposition Division partially upheld the opposition for several services in Classes 38, 41 and 42.

The opponent filed an appeal against the Opposition Division's decision and requested that the contested CTM application be rejected for some of the services in Class 41.

The Board found that for reasons of procedural economy the Opposition Division had only examined one earlier trade mark. The Board, however, examined two other earlier trade marks as their lists of goods and services were relevant for the assessment of the likelihood of confusion and, in fact, changed the outcome, because it concluded that there was a likelihood of confusion in the sense of Article 8(1)(b) CTMR regarding all the contested services.

Consequently, the Board fully upheld the appeal and annulled the contested decision as far as it rejected the opposition in respect of certain services in Class 41.

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The Registry also recommends

Decision of the Second Board of Appeal of 28 May 2015 in case R1384/2014-2 (EN)

Article 81(1) CTMR - Rule 49(1) CTMIR – Restitution in integrum

The IR holder sought to register the word mark 'diapharm' for various goods and services in Classes 3, 5, 10, 25, 35, 41, 42, 44 and 45.

An opposition was filed against part of the goods applied for (all the goods in Classes 3 and 5) based on an earlier right, namely Italian trade mark registration No 1 270 120



(DICOFARM).

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The Opposition Division rejected the opposition in its entirety because it found that the evidence furnished by the opponent was insufficient to prove genuine use of the earlier mark.

The opponent filed a notice of appeal, but no statement of grounds was attached. The Registry of the Boards of Appeal reminded the opponent that a statement of grounds had to be filed within four months, i.e. on or before 7 August 2014.

Thereafter both parties requested a suspension of the proceedings, however, the Registry of the Boards of Appeal informed the parties that filing the statement of grounds was one of the requirements for the appeal to be considered admissible and that it was, therefore, impossible to suspend the appeal procedure at that point in time.

On 4 September 2014, the opponent filed an application for restitutio in integrum together with its statement of grounds.

The Board found that the words 'all due care required by the circumstances', in Article 81(1) CTMR, required a system of internal control and monitoring of time-limits to be put in place that generally excluded the involuntary non-observance of time-limits. It followed that restitutio in integrum would only be granted in the case of exceptional events, which could not, therefore, be predicted from experience. In the present case, the relevant

act was the filing of the statement of grounds by the opponent's representative within the time-limit provided for in the Regulation. In this respect, the Board noted that an appellant could not automatically apply to have its rights re-established merely on the grounds that its representative had failed to comply with a deadline. Where a party in proceedings before the Office chose to employ a professional representative, the duties of due diligence prescribed by Article 81 CTMR extended to that duly authorized professional representative. Accordingly, restitutio in integrum could be granted if, in spite of all due diligence, the representative himself/herself or his/her clerical staff committed an excusable error or if unforeseeable events had occurred. The opponent's representative argued in substance that the non-observance of the term for filing the statement of grounds was the result of the illness of the representative in charge of the appeal proceedings, but the representative did not explain why the deadline could not be met because of the illness of an employee in charge of the file. Therefore, the opponent's representative did not show that he organised his work in such a way that a loss of rights, due to the non-observance of the time-limit, was generally excluded.

As a consequence the Board rejected the application for restitutio in integrum, and rejected the appeal as inadmissible.

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Decision of the Second Board of Appeal of 27 May 2015 in case R2588/2014-2 (EN)

Article 4(1) CTMR – Tactile mark

The applicant sought to register the mark



(The mark applied for consisted in the tactile feeling constituted by the imprinted embossed pattern on the smooth bottle surface) for toiletries (soap, perfumery, cosmetics, etc.) in Class 3.

The examiner rejected the application on the basis of Article 7(1)(a) CTMR in accordance with Article 4 CTMR, stating that the mark was not represented graphically since it was not possible to perceive the feeling one would get when touching the mark. The requirements of graphic representability were not satisfied by the description in written words.

The applicant filed a notice of appeal against the examiner's decision.

The Board found that the Court of Justice had established clear precedents as to what conditions a representation of a mark had to fulfil: A trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that

it can be represented graphically, particularly by means of images, lines or characters and that its representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective. In the present case the vague written definition together with the visual representation filed did not fulfil the criterion of being 'self-contained'. With regard to the function of the CTM Register as a public register, the notion of 'self-contained' meant that third parties viewing the CTM Bulletin, should on their own and without additional technical means, be able to understand what this claimed 'particular sensation to the touch' was or at least have a general idea of what this 'tactile' mark was. As correctly held by the examiner, it was impossible to deduce with certainty, from the image as filed, the claimed 'tactile feeling'. For the same reason, the representation was neither clear nor intelligible.

Consequently the Board dismissed the appeal.

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Decision of the Second Board of Appeal of 29 May 2015 in case R3158/2014-2 (EN)

Rule 49(1) CTMIR - Inadmissibility of the appeal

The applicant sought to register the figurative mark

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for goods and services in Classes 6, 19 and 37.

On 1 June 2010 the opponent filed a notice of opposition based on earlier CTM No 5 574 397 for the word mark 'VIDA' registered, among others, for goods in Class 19. The opposition was directed against part of the goods of the mark applied for (Class 19), and the opponent invoked Article 8(1)(b) CTMR.

The Opposition Division issued a decision in which it upheld the opposition for all the contested goods.

On 12 December 2014, the applicant filed a notice of appeal against the Opposition Division's decision together with its 'grounds of appeal' in which it simply referred to all grounds and evidence that had been stated earlier.

The Board found that a systematic reading of the provisions laid down in Rules 48(1)(c) and (2) and 49(1) CTMR and Article 60 CTMR demonstrated that any party wishing to file an appeal before the Board of Appeal was obliged to submit, within the specified time-limit, not only the notice of appeal, but also a written statement setting out the grounds of its

appeal to the Office, and said grounds had to be more than a mere reference to the contested decision and its claim that said decision should be modified or annulled by the Board of Appeal, otherwise its appeal would be dismissed as inadmissible. In light of the above, when Article 60 CTMR compelled the appellant to submit a written statement setting out the grounds of its appeal, the appellant had to set out, in writing and in a sufficiently clear and comprehensible manner, the elements of fact and/or law justifying its request that the Board of Appeal annul or modify the contested decision. In the present case the 'statement of grounds of appeal' did not set out in any way the elements of fact and/or of law which would justify the Board annulling or modifying the contested decision.

Consequently the Board deemed the appeal inadmissible.

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