

Alicante News

Up to date information on IP and OHIM-related matters

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Five years of the Cooperation Fund

When it began, five years ago, the Cooperation Fund was the biggest single programme in OHIM's history. With a budget of €50 million, it aimed to create a set of online tools and services that would benefit users across the EU.

The 19 tools and services developed by the Fund derived from proposals made by the EU national and regional offices themselves. The tool portfolio included searchable databases, like DesignView, IP tools and services for users and national office staff like the Quality Standards tool, the Seniority tool and the Common User Satisfaction tool, as well as two enforcement tools (the Enforcement Database and the Anti Counterfeiting Intelligence Support Tool) developed for the European Observatory on Infringements of Intellectual Property Rights.

Underpinning all of this was the Software Package – at €20 million, the largest single project within the Fund. The Software Package was split up into four components: a trade mark e-filing system; a designs e-filing system; an e-services system to enable users to carry out tasks like filing renewals and cancellations online; and a powerful back office system to support the other three components.

When the Cooperation Fund first began, national and regional IP offices were invited to submit what became known as their “intents to implement” –

their willingness to share their data with a tool or integrate a particular project into their own offices or systems. Each office could implement as many or as few as it chose. Around 160 such intents were received at the start of the Fund.

Today, there have been more than 360 Cooperation Fund implementations in national and regional IP offices around the European Trade Mark and Design Network. That success has been driven by the commitment and hard work of national and regional offices themselves, many of which made strenuous efforts to implement the tools and services, as they knew it would greatly benefit their user communities.

User associations were key, too. The projects were developed through working groups – one working group per project – all of which included user association representatives to give valuable advice and feedback on tool development from the user perspective. Users also engaged in rigorous testing of the e-filing systems, for example, before they went live in national and regional IP offices.

One particular example of how trade mark e-filing, developed by the Cooperation Fund, has been integrated in an office is in the Cypriot national office (you can read more about this in the James Nurton interview on page 4).

The Fund has powered ahead over the past five years, with its tools and services are now embedded in national and regional IP offices across

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the EU, and serving users not just in the EU but also globally.

The opening up of tools like TMview, DesignView and TMclass to an international audience has meant that global search and classification is available through free, online, continuously updated databases.

The Cooperation Fund has delivered throughout its life, on time and on budget. With the assistance of a Management Board, created to advise its progress, and its emphasis on collaborative, cooperative working with partners, it has been a real engine of change at the heart of the European Trade Mark and Design Network.

The Cooperation Fund tools are available through the Common Gateway, www.tmdn.org.

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The James Nurton Interview



Maria Ioannides, Ioannides, Cleanthous & Co LLC, Nicosia, Cyprus

Tell me about your firm?

We are a fledgling law firm – we've only been around for a year and a half. I was born and studied in South Africa but I passed the bar exam in Cyprus and began working at the law firm Markides Markides & Co, which has a very good reputation, and that is how I was introduced to IP. I enjoyed IP but I felt it was too early to specialise so I moved to another law firm where I was tasked to set up the IP department but I was also introduced to corporate work, and



Maria Ioannides

gained a vast knowledge of the corporate field. But each time an IP case came along I was excited and was drawn back to it!

After about a year, my partner Marinos Cleanthous and I decided to establish this law firm. In Cyprus there wasn't really a boutique IP law firm specialising in IP and transactions connected to IP. We are now five people and we do a vast array of IP work – including not only registration of trade marks and designs but also any transactions that deal with IP. For example, young companies come to us and want advice on protecting IP and making it into an asset, so the advice begins at that stage.

Is there a good understanding of IP in Cyprus?

There is definitely room for improvement. For example, many companies we have met have their business name registered and think that means they have IP proprietary rights. We invest in seminars to local businesses to educate and promote understanding of IP – what it is and how it can become an asset for your company.

It is improving though. Ten years ago hardly any companies asked for protection or asked questions about IP. Now it has improved greatly and Cyprus companies are investing in it. If you are not protecting, you are leaving yourself open to dangers.

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The James Nurton Interview



Recently start-ups have been gaining ground in Cyprus. Angel investors request or make it important for IP to be protected before investing, and this is making people understand that it is important.

Another thing is that in 2012 Cyprus introduced an IP box which provides tax incentives not only to local but also to international companies. It can reach up to an 80% tax exemption for royalties received. This has been a big draw, including for local companies as they already meet the residency requirement.

Are clients mainly interested in Cyprus or in the EU market?

More and more they are looking at the European market. For cost reasons, they often start off with Cyprus and use the Madrid system if they want to expand further or sometimes they use the CTM. For start-ups that are promoting online, they often want trade marks in the EU, the United States, India (because they have software developers based there) and China (because of the distribution).

We have done some work ourselves at OHIM, including oppositions and arguments to defend marks. I find the OHIM website is very user-friendly, in particular the law practice section and the regulations. The manual is very clear in terms of what they look at and how they reach decisions.

E-filing is even better now because there is a fast

track system, which means an application can be granted in four months if there is no opposition or other action. It is very easy to use. Each time I've called OHIM they have been extremely friendly and to-the-point.

How well does the Cyprus office work?

I'm happy to say that about a month ago the Cyprus office implemented an online filing system, which is very similar to the CTM e-filing system. There have been some teething problems to do with IT issues and bureaucracy but it is a step in the right direction. That is also a draw for international companies to register in Cyprus.

There was a slight decrease in filing in Cyprus when the CTM was introduced. But big companies now tend to register a CTM and a national mark too if it is an important mark. And if they are using the Madrid System, if there is an office action they need to appoint a local attorney in the country.

E-filing is available for filing and renewal at the moment. We expect it to be available for the recordal system at a later time. It's a matter of technology, so we are in a bit of a trial run now.

About a month ago we were invited to a seminar by the registrar of trade marks and OHIM was present as it has been on a number of occasions. It's a great way to spend the subsidies and OHIM has assisted to a great extent.

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The James Nurton Interview



Are there any notable cases in Cyprus?

There has been a famous case recently between two popular TV channels. One channel was alleged to have copied the name of a TV show and its popular characters. An interim order was granted to stop the advertising of the programme and I believe the new show has now changed its name, but I'm not sure if the infringement case has finished yet. The case addressed trade mark and copyright issues and the publicity around it brings home to Cyprus companies the need to protect their IP – not only to stop infringement but because it might be an asset to you.

What was your first case?

I can't remember the trade mark but I remember when I first went into the office, I was asked to update the register with various recordals, including assignments and mergers, for an alcohol company. There were a lot of documents and it took me three days to sort out what happened first, when they changed their name, and when they changed address!

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

I worked on a contentious case between Crocodile and Lacoste. I remember I was in my office working on getting the affidavit ready with the evidence, when there was a knock at the door and four huge

boxes of evidence were delivered from the client. That was a bit of a shock. The litigation was going on all around the world and the boxes contained evidence of all the cases. I'm happy to say both trade mark owners now have shops in Cyprus.

What do you expect in the future?

The internet and technology will play a big role in IP. Technology is both a blessing and a curse. It means clients have to be more vigilant in protecting their IP, as there are no easier ways of violating IP. One example of that is domain names.

We also had a case recently where a Cypriot author had written and produced a song, which was used in a mobile app without permission. This is a new type of challenge, at least in Cyprus, which needs to be dealt with. The start-up culture here means that companies developing these apps want to use local music, but they don't always ask permission.

With technology advancing, we need to find more effective tools for protection, especially for copyright which is an automatic right. As there is no registry as such, it leaves it open for infringement.

Another thing would be worldwide common procedures. Having worked in various regions, you know that in some regions a trade mark will be protected but in other regions it will be difficult to enforce. Cost-wise as well, there are many countries

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The James Nurton Interview



that have not joined the Madrid System, so you have to register nationally whatever the cost. OHIM and Madrid are a step in the right direction for that.

Being in Cyprus, many of our clients require protection in the Middle East, but we can't use Madrid because the countries are not members, and even though the local agents are great, the costs are really expensive. This is something that makes our clients think twice about protecting there. We try to make Cyprus a base for doing business in the Middle East, due to its strategic position, the use of the English language, our common law tradition and of course the IP box.

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Community Trade Mark



GIs and its interface with CTMs: some basic ideas

This Article has the purpose to share some basic ideas about geographical indications (GIs) and denominations of origin (DOs) and its interface with trade marks (TMs), in particular taking into consideration the perspective of beneficiaries of protected GIs/DOs. In this light, TMs and PGIs/PDOs are both IP rights with its own set of legislation. Although they have a different scope of protection they are often interlinked. While GIs/DOs indicate the geographical origin of a product, trademarks serve as indicators of commercial origin.

Geographical terms can be protected both by TM and GI/DO legislation. Consequently beneficiaries of a GI protected under GI/DO legislation (PGI/PDO) can also seek protection for their GI/DO under trade mark law, for example through a collective TM.

Trade marks which contain or reproduce a geographical indication protected under GI legislation are also useful and effective means of protection. However, trade marks must not be in conflict with the protection granted under GI/DO legislation. For this, trade mark must comply with certain requirements, for example they must be applied for the right products. Otherwise the registration of the trade mark will be refused.

In order to safeguard the rights of PGI/PDOs beneficiaries, the Office carries out a strict ex officio examination of those Community TMs (CTMs) which may infringe the scope of protection granted to a geographical indication. For example, if a trade mark is applied for wines and contains the PDO for wines 'Bordeaux' or 'Ribera del Duero', it has to comply with the relevant specification of the DO, otherwise registration will be refused.

This protection is offered through a systematic application of the CTMR in conjunction with the GI/DO EU Regulations¹. More in particular, the CTMR contains specific provisions to ensure the protection of GIs. Articles 7(1)(j) and (k), offer said protection by preventing the registration of signs as trade marks which consist of, or contain, or constitute evocations of a PGI or a PDO if the products covered by the trade mark are not those protected by the GI/DO. The Guidelines of the Office contain a detailed explanation of the applicable legal provisions as well as the relevant case-law and examples that can illustrate the practice followed.

¹Agricultural Products and Foodstuffs Regulation (EU) No. 1151/2012 (Articles 13 and 14 – Protection); the Wine Regulation (EU) No. 1308/2014 (Articles 102 and 103) and the Spirits Regulation (EC) No 110/2008 (Articles 16 and 23 – protection of Geographical Indications).

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Since GIs are territorial rights, they enjoy protection in one or more jurisdictions according to the rules which govern their protection. In this light, the GIs that may conflict with a CTM are GIs from the EU or from third countries, which must be registered at EU level in order to enjoy protection. The same applies to GIs covered by International Agreements to which the EU is a party. In this regard, the Office has to interpret the provisions of these International Agreements in order to determine the scope of protection.

Beyond the *ex officio* examination, a GI/DO beneficiary can react to a CTM application which consists of, or contains, or constitutes an evocation of a GI/DO by filing an opposition and claiming that the GI legislation prohibits such use. Nevertheless, if a CTM is registered without a previous reaction by a TM holder, it is still possible to request the cancellation of the said registration based on the same grounds.

There is also another possibility available for a GI/DO beneficiary to protect and to enforce its rights vis-à-vis a conflicting TM. It is the so-called 'third-party observations'. They are submissions that anyone can send to OHIM, pointing out that a CTM was published but it should have been rejected, for example because it is descriptive or because it conflicts with a GI. The OHIM examines those observations and decides whether or not they should be accepted. If the observations are accepted, the TM will be refused.

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The General Court upheld the Office's Third Board of Appeal decision R 855/2012-3 on invalidity proceedings ICD 8201 for registered Community design No 001044150-0003 (the RCD).

The RCD, registered and published in 2008 for belts (see the views below), was challenged in invalidity proceedings brought on the grounds of Article 25(1)(e) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (CDR) for unauthorised use of a distinctive sign in the RCD.

The earlier distinctive sign invoked was international word mark 'DIESEL' No 608 799, registered in the applicant's name in 1993 in respect of goods included in Classes 3, 9, 14, 16, 18, 24 and 25 of the Nice Classification, and it was in force, inter alia, in Spain. In the first instance, the Invalidity Division declared the RCD invalid finding that the applicant proved genuine use of its trade mark in the decisive period of five years prior to the invalidity application filing, and that there existed a likelihood of confusion on the part of public between the mark denomination of 'DIESEL' and the sign used on the belt buckle according to the RCD.

The RCD holder appealed, requesting that the decision be annulled and the application for a declaration of invalidity be dismissed. The holder claimed that the Invalidity Division erred when it omitted to send the holder a CD containing a copy of invoices submitted by the applicant (and indicated as confidential) to prove genuine use of the trade mark. The holder further claimed that in the decision the Invalidity Division did not take into account the holder's Spanish trade mark 'S.D.D. SUPER DIESEL DAIREK', registered in respect of belts and which (by the decision of Barcelona Commercial Court No 2) had been acquiesced in the use of and had been tolerated by the applicant since 2005. Lastly, the Invalidity Division erred in the comparison of the mark and the design concluding that there was a likelihood of confusion. During the proceedings before the Third Board of Appeal the RCD holder requested a stay pending appeal for the reason that it had raised grounds for cancellation of the applicant's trade mark for non-use with respect to belts before the Commercial Courts of Barcelona.

The Third Board of Appeal rejected the request for suspension and upheld the first instance decision. In the Board's opinion, the suspension would give rise to unacceptable and unnecessary legal uncertainty due to the possible length of the proceedings and the fact that even if belts were excluded from the protection of the trade mark, the Board could rule on the basis of other goods in respect of which the trade mark was registered.

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In the decision, the Board held that the earlier trade mark was in force, inter alia, in Spain, and thus the invalidity action must have been interpreted in light of current national legislation. The conditions for the invalidity of the RCD would be met if it were found that the distinctive sign was used in the RCD without the consent of the registered trade mark's owner. Furthermore, according to national law, which encompasses the likelihood of confusion test, the trade mark owner had the right to prohibit such use.

As regards the contested proof of use of the earlier trade mark, the Board found it unnecessary to discuss the confidential nature of the CD's contents, and that proof of use was sufficiently demonstrated, at least in respect to clothing in Class 25, in other submitted materials, namely excerpts of magazines and newspapers.

The Board concluded that the goods under comparison, namely clothing (for which the trade mark was registered) versus belts (in which the RCD was incorporated), and the signs under comparison, namely the earlier mark versus the word element 'DIESEL' written in upper case letters on the belt buckle of the RCD, were found to be similar. Consequently, a likelihood of confusion on the relevant part of the public existed in terms of the commercial origin of the goods so marked; therefore, the trade mark holder had the right to prohibit use of its trade mark in the RCD and the design had to be declared invalid.

The RCD holder appealed to the General Court, pleading violation of the right to defence, error in the assessment of the request for suspension, lack of consideration for the existence of its own Spanish trade mark identical to the word elements used in the RCD, absence of probative value of evidence in the proof of use, and no likelihood of confusion between the design and the earlier trade mark.

The General Court rejected all the pleas and confirmed the contested decision. It held that the Board of Appeal had properly weighed the interests of the parties and therefore it had legitimately dismissed the request for suspension. In the assessment of genuine use of the earlier trade mark the Board had not erred because it had not relied upon the contested CD, and with reference to the submitted newspaper and magazine articles the Board was right to conclude that the earlier mark was subject to use in Spain at least as far as clothing was concerned. As regards the RCD holder's Spanish trade mark, the Court held that a lack of action from the side of the applicant to stop using the holder's trade mark was inconclusive for a finding of no likelihood of confusion between the contested design and the earlier mark in the invalidity proceedings.

As regards the final plea, the RCD holder argued that in the global assessment of likelihood of confusion between the signs, all the elements of the contested design, in particular the '@', 'sdd', 'super' and 'dairek',

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the surname of the holder of the contested design, were to be taken into account. Furthermore, according to the holder, the denomination of 'diesel' was not created by the earlier trade mark owner but it corresponded to the surname of the famous inventor of the engine bearing his name, which was not noted by the Board.

In this regard, the Court argued as follows:

- According to established case-law, invalidity based on an earlier distinctive sign may be invoked not only where an identical but also a similar sign is used. The Board found that this was the case because the word 'diesel' appeared on the belt buckle of the contested RCD.
- The Spanish trade mark law invoked gives the trade mark owner the right to prohibit use of such a sign. Insofar as it is identical or similar to the earlier distinctive sign, has goods or services covered by the earlier distinctive sign and is identical or similar in its design, there is a risk of confusion on the part of the relevant public.
- In the likelihood of confusion test, the visual, aural and conceptual similarity of signs must be assessed. In all three aspects the compared signs coincided in their use of the word 'diesel'.
- Likelihood of confusion must be based on the overall impression produced by the signs, taking into account, in particular, their distinctive and dominant components, from the perception of the average consumer of the

goods and services in question. The signs must be considered in their entirety, which does not rule out that in the mind of the relevant public a complex mark could be dominated by one or more of its components. According to the Court, the Board did not err when it noted that the '@', 'sdd', 'super' and 'dairek' elements in the design were much smaller and positioned laterally on the buckle, which allowed them to be considered of secondary importance, whereas writing the 'diesel' element in upper case, bold letters on the buckle made it more visible and dominant. Although present, the elements other than 'diesel' could not offset the visual, phonetic and conceptual similarity between the signs in the 'diesel' element.

- The 'diesel' element has no link to the goods covered by the trade mark, therefore it possesses at least normal distinctiveness with respect to the goods. The holder's note about the word's origin not being invented by the trade mark's owner did not call into question this conclusion of the trade mark's distinctiveness.
- As the earlier trade mark and the sign in the contested design were used for similar products, likelihood of confusion on the side of the Spanish consumer was established and the trade mark owner had the right to prohibit use of the sign in the contested design. Accordingly, the Board had rightly concluded that the RCD must be declared invalid.

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To see the CJEU judgment click [T-278/14](#)

Contested [RCD 001044150-0003](#)



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3.1



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Enlarged view 3.1

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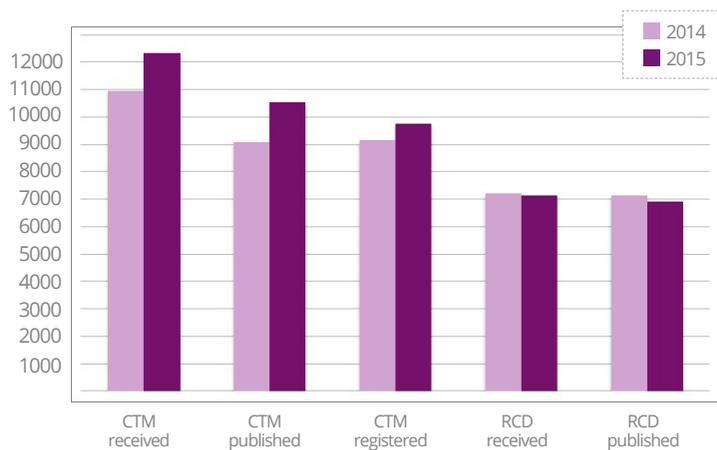


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Community Trade Mark applications published	9 091	10 541
Community Trade Marks registered (certificates issued)	9 153	9 738
Registered Community Designs received	7 220	7 132
Registered Community Designs published	7 134	6 915

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



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Japan joins TMview

As of 23 November, the Japanese Patent Office (JPO) has made its trade mark data available to the TMview trade mark search tool.

The integration of JPO is a concrete result of the International Cooperation programme managed by OHIM in collaboration with its international partners.

With JPO on-board, TMview now contains data from 51 participating offices, including those accessible through the ASEAN TMview. With the addition of more than 3.6 million trade marks from Japan, TMview and ASEAN TMview now provide information and access to more than 34.5 million trade marks in total.

Since the introduction of TMview on 13 April 2010, the tool has served more than 16.8 million searches from 151 different countries, with users from Spain, Germany and Italy among the most frequent visitors.

You can find out more at www.tmview.org

Greece-OBI implements Forecasting

On 16 November 2015, the Hellenic Industrial Property Organisation (OBI) announced implementation of the Forecasting Methodologies tool.

Under the umbrella of the Cooperation Fund, a project was launched to evaluate and test the best methods for predicting trade mark and design filings using the latest forecasting technologies.

The working group was led by a member of the Economics & Statistics service in the European Observatory on Infringements of Intellectual Property Rights, a department within OHIM, with input from forecasting experts from the EU IP offices of Denmark, Hungary, Poland, Portugal, Spain and the UK. The European Patent Office (EPO) acted as an observer.

The project resulted in the development of a forecasting tool powered by an improved forecasting methodology.

The availability and use of forecasting systems capable of generating precise forecasts of trade mark and design filings are crucial for successful strategic planning, operative management, optimal allocation of resources and budgetary design at EU IP offices.

With the addition of Greece-OBI, a total of 21 EU IP offices now successfully use the forecasting tool.

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Spain implements Seniority

The Seniority Project, developed by the Cooperation Fund, has been successfully implemented in the Spanish Patent and Trademark Office (OEPM).

The tool makes seniority information accessible online, by using harmonized terminology, the creation of a seniority field and the establishment of hyperlinks between entries in the databases of participating offices and of the OHIM

With the addition of the OEPM 21 national and regional IP offices are now using Seniority.

Cyprus implements trade mark e-filing and e-Services

The Department of Registrar of Companies and Official Receiver has implemented e-Filing for trademarks. Moreover on 27 October the office received first e-renewal application and announced implementation of e-Services. Both tools are part of the Software Package developed under the framework of the Cooperation Fund.

The new e-filing system represents a big step forward in the way trademarks are processed and registered, making applications easier, quicker and

more accessible to users of the Cyprus trade mark system.

The e-Services project aims to develop a set of web-based tools for national and regional EU IP Offices to facilitate the electronic filing of trade mark oppositions, trade mark and design registrations and renewals, trade mark cancellations and design invalidities.

More information on the Cooperation Fund tools can be found at www.tmdn.org, the online home of the European Trade Mark and Design Network.

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Successful audit of all of OHIM's activities

Following the successful audit of the ISO 27001 information security in September, OHIM has just successfully completed a full re-certification audit of all Office activities; re-certification for ISO 9001 as well as OHSAS 18001 has been achieved.

The conclusions of the audit were positive overall, clearly illustrating the effort and improvements that have been made during the year. Auditors underlined that OHIM's management systems are mature and that the Office is using those management systems to more efficiently manage the work and priorities.

Some of the conclusions relate to how well the organisation has implemented the new team work approach, based on expansion of knowledge and collaboration. A special mention was also made in relation to the use of performance metrics to improve efficiency, and the office-wide implementation of risk management and the stakeholder engagement programme.

OHIM's User Satisfaction Survey launched

Every year the Office carries out a satisfaction survey to identify goals and priorities for improvement, as well as to assess how satisfied users are with the services we provide.

Users have received an email with a personalised link to access a secure web-based questionnaire.

This questionnaire can be completed in any of the Office's five working languages (English, French, German, Italian and Spanish).

The deadline for completing the survey is 27 November, 2015.

IP Case Law Conference – registration now open

On May 5-6, the Office is holding its first ever IP Case Law Conference.

This event is dedicated to substantive and procedural issues surrounding trade mark and design dispute resolution.

The conference brings together users of the international IP systems, IP professionals, judges,

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national and European level institutions and administrations. A provisional version of the conference programme is available [here](#). The programme will be updated on a regular basis.

The event is designed to be as innovative and user-focused as possible. It will be held in an interactive format with ample opportunity for questions from the audience, and presentations on recent OHIM Boards of Appeal and EU case law topics.

A certificate of attendance will be available for all participants.

The conference is being held in the Office's headquarters in Alicante, Spain.

A registration fee of €150 will apply, and registration is available [through this link](#).

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

Case C-343/14 P; Adler Modemärkte AG v OHIM; Order of 7 May 2015 Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Conceptual similarity, Admissibility, Likelihood of confusion, Similarity of the signs, Distinctive element

FACTS: The General Court (GC) confirmed in the case T-160/12 the contested decision of the Board of Appeal and affirmed the likelihood of confusion for the following marks and goods in Classes 18 and 25, which it considered similar or identical. The CTM applicant filed an appeal before the European Court of Justice (CJ) claiming an infringement of Article 8 (1) (b) CTMR.

CTMA

MARINE BLEU

Earlier mark

BLUMARINE

SUBSTANCE: The CTM applicant (appellant before the European Court of Justice (CJ)) claimed an infringement of article 8 (1) (b) CTMR on the one hand in the assessment of the similarity of the signs and, on the other hand, in the global assessment of the likelihood of confusion. Both claims were dismissed by the CJ.

The CJ did not see any error in law in the assessment of the similarity of the signs. With regard to the argument that the descriptive character of the earlier mark influence prevents conceptual similarity the CJ recalled, that the conceptual similarity between the signs at issue must be assessed independently of their degree of distinctiveness (Para. 39).

With regard to the assessment of the likelihood of confusion the CJ rejected the CTM applicant's claim that the distinctive character of the earlier mark was not taken into consideration by the GC. The CTM applicant's approach would have the effect of disregarding the factor of the similarity of the marks in favour of that based on the distinctive character of the earlier national mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the signs in question. Such a result would not, however, be consistent with the very nature of the global assessment pursuant to Article 8 (1) (b) CTMR (Para. 61).

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Case C-215/14; Société des Produits Nestlé SA v Cadbury UK Ltd; Preliminary ruling of 16 September 2015; Language of the case: EN

KEYWORDS: Distinctiveness acquired by use, Three dimensional mark, Shape of the product, Technical result

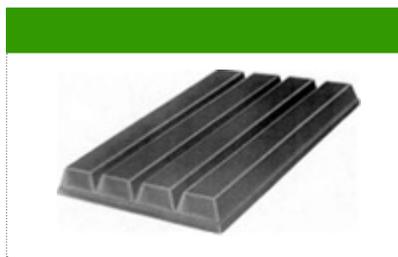
FACTS: Nestlé sought to register the shape of the “Kit Kat” cookie (see below) in the UK as a national three-dimensional trade mark.

The National office rejected the application. Nestlé appealed the decision to the High Court of Justice of England and Wales and Cadbury filed a cross-appeal. The High Court made a reference to the European Court of Justice (CJ) for a preliminary ruling asking:

1. In order to establish that a trade mark has acquired distinctive character following the use that had been made of it within the meaning of Article 3 (3) of Directive 2008/95 ..., is it sufficient for the applicant for registration to prove that at the relevant date a significant proportion of the relevant class of persons recognise the mark and associate it with the applicant's goods in the sense that, if they were to consider who marketed goods bearing that mark, they would identify the applicant; or must the applicant prove that a significant proportion of the relevant class of persons rely upon the mark (as opposed to any other trade marks which may also be present) as indicating

the origin of the goods

2. Where a shape consists of three essential features, one of which results from the nature of the goods themselves and two of which are necessary to obtain a technical result, is registration of that shape as a trade mark precluded by Article 3 (1) (e) (i) and/or (ii) of Directive 2008/95 ...?
3. Should Article 3 (1) (e) (ii) of Directive 2008/95 ... be interpreted as precluding registration of shapes which are necessary to obtain a technical result with regard to the manner in which the goods are manufactured as opposed to the manner in which the goods function?



SUBSTANCE: (2) The grounds for refusal of registration laid down in Article 3 (1) (e) operate independently of one another (para. 46). Hence, registration may be refused only where at least one of those grounds is fully applicable to the sign at issue (para. 48) Therefore, article 3 (1) (e) of Directive 2008/95 must be interpreted as precluding registration as a trade mark of a sign consisting of

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the shape of goods where that shape contains three essential features, one of which results from the nature of the goods themselves and two of which are necessary to obtain a technical result, provided, however, that at least one of the grounds for refusal of registration set out in that provision is fully applicable to the shape at issue (Para. 51).

(3) By literal interpretation, the ground for refusal provided for in Article 3 (1) (e) (ii) is restricted to the manner in which the goods function rather than to a particular method of manufacturing the shape in question (para. 54). From the consumer's perspective, the manner in which the goods function is decisive and their method of manufacture is not important (Para. 55) Moreover, the manufacturing method is not decisive in the context of the assessment of the essential functional characteristics of the shape of goods either. The registration of a sign consisting of a shape attributable solely to the technical result must be refused even if that technical result can be achieved by other shapes, and consequently by other manufacturing methods (Para. 56). It follows that Article 3 (1) (e) (ii) does not preclude registration of shapes which are necessary to obtain a technical result with regard to the manner in which the goods are manufactured.

(1) Acquisition of distinctive character may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. However, in consequence of such use, the relevant class of persons must actually perceive

the goods or services, designated exclusively by the mark applied for, as originating from a given undertaking (Para. 64). Hence for the purposes of the registration of the mark itself, the trade mark applicant must prove that that the relevant class of persons perceive the goods or services designated exclusively by the mark applied for, as opposed to any other mark which might also be present, as originating from a particular company (Para. 66-67) (emphasis added).

Case C-500/14; Ford Motor Company v Wheeltrims srl; Preliminary ruling of 6 October 2015; Language of the case: IT

FACTS: Wheeltrims sells "spare part" wheel trims bearing the trademark Ford without the authorization of the TM proprietor. Wheeltrims' aim is to enable the purchaser to make sure that his purchase matches the appearance of the rest of his car.

Ford brought an action for infringement before the Italian Tribunale di Torino. The Tribunale made a reference to the European Court of Justice (CJ) for a preliminary ruling asking:

1. Is it compatible with [EU] law to interpret Article 14 of Directive 98/71 and Article 110 of Regulation (EC) No 6/2002 as conferring on producers of replacement parts and accessories the right to use trade marks registered by third

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parties in order to allow the end purchaser to restore the original appearance of a complex product and, therefore, also when the proprietor of the trade mark applies the distinctive sign in question to a replacement part or accessory intended to be mounted on the complex product in such a way that it is externally visible and thus contributes to the external appearance of the complex product?

2. Is the repair clause set out in Article 14 of Directive 98/71 and Article 110 of Regulation (EC) No 6/2002 to be interpreted as constituting a subjective right for third-party producers of replacement parts and accessories and, if so, does that subjective right include the right for such third parties to use the trade mark registered by another party in respect of replacement parts and accessories, by way of derogation from the rules laid down in Regulation No 207/2009 and Directive (EEC) 89/104 and, therefore, when the proprietor of the trade mark also applies the distinctive sign in question to a replacement part or accessory intended to be mounted on the complex product in such a way that it is externally visible and thus contributes to the external appearance of the complex product?

SUBSTANCE: The two questions are examined jointly by the CJ.

CJ: Article 14 of Directive 98/71 and Article 110 of Regulation (EC) No 6/2002 foresee that the protection as a Community or national design which constitutes a component part of a complex product cannot be opposed to a third party who uses this design for the repair of that complex product so as to restore its original appearance. These provisions only limit the scope of protection granted by designs and models rights (Para. 39). According to recital 7 and to Article 16 of Directive 98/71 and to recital 31 and Article 96 of Regulation No 6/2002, these acts shall be without prejudice to any provision of national or EU law relating to TM (Para. 41). Therefore, Article 14 of Directive 98/71 and Article 110 of Regulation (EC) No 6/2002 do not derogate Directive 2008/95 nor Regulation No 207/2009 (Para. 42).

It follows that Article 14 of Directive 98/71 and Article 110 of Regulation (EC) No 6/2002 do not allow a producer of car replacement parts and accessories to use a registered TM for his products without the authorization of the TM proprietor on the ground that such use of the TM would be the only way to repair the car in question by restoring, as a complex product, its original appearance (Para. 45).

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

Case T-363/12; Harper Hygienics S.A. v OHIM; Judgment of 13 May 2015; Language of the case: PL

RESULT: Action dismissed

KEYWORDS: Coexistence of trade marks, Likelihood of confusion, Identity of the goods and services, Similarity of the goods and services, Dominant element, Visual similarity, Phonetic similarity, Reputation, Unfair advantage, Relevant territory

FACTS: The Opposition Division upheld the opposition pursuant to Article 8 (1) (b) and 8 (5) CTMR based on the earlier CTM represented below and registered for products in Classes 3, 14, 25 and 42 below and rejected the CTMA for goods in Classes 3, 5 and 16. The CTM applicant filed an action before the General Court (GC) claiming the infringement of Article (8) (1) (b) CTMR and Article 8 (5) CTMR.

SUBSTANCE: The GC confirmed the finding of likelihood of confusion pursuant to Article 8 (1) (b) CTMR. The goods are directed to average consumers (Para. 26). The goods are identical or similar (Para. 47). The dominant element of the CTMA is the word "CLEANIC" (Para. 57). The signs are similar visually to a low degree (Para. 65) and phonetically to a high degree (Para. 72). The conceptual comparison is not

CTMA

 **CLEANIC**
natural beauty

Earlier mark

CLINIQUE

possible as one of the marks do not have a meaning (Para. 76). With regard to the alleged infringement of Article 8 (5) CTMR the GC confirmed the findings that the earlier mark is reputed and the use of the CTM would equal to unfair advantage of its distinctive character. It rejected CTM applicant's argument regarding the co-existence of the marks, as it was claimed only for Poland, whereas the earlier mark is protected in the whole territory of the EU.

Case T-364/12; Harper Hygienics S.A. v OHIM; Judgment of 13 May 2015; Language of the case: PL

RESULT: Action dismissed

KEYWORDS: Coexistence of trade marks, Likelihood of confusion, Identity of the goods and services, Similarity of the goods and services, Dominant element, Visual similarity, Phonetic similarity,

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Reputation, Unfair advantage, Relevant territory, Figurative element

FACTS: The Opposition Division upheld the opposition pursuant to Article 8 (1)(b) and 8(5) CTMR based on the earlier CTM represented below and registered for products in Classes 3, 14, 25 and 42 below and rejected the CTMA for goods in Classes 3, 5 and 16. The Board of Appeal confirmed the decision. The CTM applicant filed an action before the General Court (GC) claiming the infringement of Article 8 (1) (b) CTMR and Article 8 (5) CTMR.

CTMA



Earlier mark

CLINIQUE

SUBSTANCE: The GC confirmed the finding of likelihood of confusion pursuant to Article 8 (1) (b)CTMR. The goods are directed to average

consumers, who, however, will pay an enhanced attention as far as pharmaceutical products are concerned (Paras. 25). The goods are identical or similar (Para. 46). The figurative element of the CTMA is purely decorative (Para. 52). The signs are similar visually to a low degree because the word “CLEANIC” in the CTMA and the earlier mark share several letters in the same sequence (Paras. 54-55) and phonetically to a medium degree (Para. 58). The conceptual comparison is not possible as one of the marks do not have a meaning (Para. 60). With regard to the alleged infringement of Article 8 (5) CTMR the GC confirmed the finding that the use of the CTM would equal to unfair advantage of the distinctive character of the earlier CTM. It rejected CTM applicant’s argument regarding the co-existence of the marks, as it was claimed only for Poland, whereas the earlier mark is protected in the whole territory of the EU (Para. 81). The reputation of the CTMA does not have any relevance for the opposition (Para. 82).

Case T-489/13; La Rioja Alta, S.A. v OHIM; Judgement of 30 of June 2015; Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Coexistence of trade marks, Conceptual similarity, Dominant element, Evidence of use, Lack of reasoning, Likelihood of confusion,

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Phonetic similarity, Proof of use, Relevant territory, Request for proof of use, Seniority, Similarity of the goods and services, Similarity of the signs, Visual similarity, Well known trade mark

FACTS: On 26 November 2004 the word sign VIÑA ALBERDI was registered as a Community trade mark (CTM) for the goods and services in Classes 30, 32 and 33.

On 5 November 2009 a request for a declaration of invalidity of the CTM against the goods in Class 33: “Alcoholic beverages (except beers)” was filed on the basis of the earlier German figurative trade mark represented below.

The CTM proprietor requested proof of use of the earlier mark and put forward that the challenge CTM claims a Spanish seniority from a well-known trade mark and claimed that the cancellation applicant has tolerated the coexistence of the marks in dispute.

The Cancellation Division declared the registration of the challenged CTM invalid for the contested goods.

The Board of Appeal (BoA) confirmed the decision of the Cancellation Division and considered there was a likelihood of confusion between the marks at issue in respect of contested goods despite of the fact that the CTM proprietor limited its list of goods to “alcoholic beverages (except beers) and except wines from Italy”.

The CTM proprietor filed an application for annulment before the General Court (GC).

CTMA

VIÑA ALBERDI

Earlier mark



SUBSTANCE: The GC dismissed the action.

The GC confirmed the conclusion of the BoA that the relevant public is the German public at large with an average level of attention. The GC concurs with the finding of the BoA that the relevant goods for the appreciation of the LOC are the limited by the CTM proprietor in Class 33 on one hand and the goods “wines from Italy” of the earlier mark on the other. The GC concluded there is an average level of similarity between the goods compared.

According to the judgement, the compared signs possess certain degree of visual, aural and conceptual similarity as in the current context the figurative element possesses low distinctive character.

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The GC subscribed the finding of the BoA that the earlier mark has an average degree of inherent distinctiveness (Para. 73). The GC dismissed the alleged by the CTM proprietor coexistence between the trade marks in the relevant territory (Para. 89) being the CTM proprietor unable to prove this argument. The GC also made reference to the case-law stating that as the marks have been subject of dispute the alleged coexistence has not been peaceful (Para. 82). Therefore there was LOC (Para. 90).

The GC ruled there was no infringement of Article 75 CTMR. In the judgement it was made reference to the Case-Law establishing that the reasoning of the BoA may be implicit, on condition that it enables the persons concerned to know the reasons for the BoA's decision and provides the competent GC with sufficient material for it to exercise its power of review (Para. 94). Moreover, the BoAs can rely on matters of common knowledge subject to the adversely affected party's proving an error in assessing that common knowledge of those matters (Para. 56).

There is no infringement of Article 52 (3) CTMR according to the GC as the BoA is not under obligation to analyse each and every product individually, providing they form part of the same category (Paras. 102, 28- 45).

Case T-33/13; Türkiye Garanti Bankasi AS v OHIM; Judgment of 5 February 2015; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Likelihood of confusion, Similarity of the signs, Conceptual similarity, Phonetic similarity, Visual similarity, Common element, Weak element

FACTS: The CTM applicant sought to register the sign as shown below as a CTM for inter alia services in Classes 35, 36 and 42. The opponent (applicant before the General Court (GC)) based its opposition on Article 8 (1) (b) CTMR using the earlier IR as depicted below, registered for services in Classes 35, 36 and 42. The Opposition Division partially upheld the opposition. The Board of Appeal (BoA) upheld the appeal from the CTM applicant and found that the signs are overall dissimilar. The opposition has been consequently rejected in its entirety. The opponent appealed to the GC, arguing an infringement of Article 8 (1) (b) CTMR.

SUBSTANCE: The GC annulled the contested decision for the following reasons:

Comparison of the signs: Visually both marks bear at their beginnings the term "bonus" which occupies the first position in both signs and cannot be considered as negligible (Paras. 29 and 30). Although there are also visual differences as stated in the contested decision, these differences may

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not counteract the visual similarities rendering the marks visually different. A certain degree of visual similarity cannot be denied (Paras. 31 and 32).

Phonetically the first two syllables which are identical create an average degree of aural similarity. The conclusions of the contested decision according to which the aural differences in the ending parts of the signs create an overall aural difference are not upheld by the GC (Paras. 33 and 34).

From a conceptual point of view the GC underlines that the term “bonus” will be understood by a significant part of the relevant public and will create a certain conceptual link between the signs. The elements that follow the term bonus in each mark will complement the meaning of bonus but not – as the BoA stated – counteract it. The fact that the meaning of “bonus” is weak does not alter this

finding (Paras. 40 to 42).

Consequently, the signs are not overall dissimilar – as concluded in the contested decision – but to the contrary have a certain degree of similarity overall. Consequently, the Office should carry out a comparison of the services and make an overall assessment on likelihood of confusion (Paras. 42 and 47).

Case T-363/13; Harper Hygienics S.A. v OHIM; Judgment of 13 May 2015; Language of the case: PL

RESULT: Action dismissed

KEYWORDS: Coexistence of trade marks, Likelihood of confusion, Identity of the goods and services, Similarity of the goods and services, Dominant element, Visual similarity, Phonetic similarity, Reputation, Unfair advantage, Relevant territory

FACTS: The Opposition Division upheld the opposition pursuant to article 8(1)(b) and 8(5) CTMR based on the earlier CTM represented below and registered for products in Classes 3, 14, 25 and 42 below and rejected the CTMA for goods in Classes 3, 5 and 16. The CTM applicant filed an action before the General Court (GC) claiming the infringement of article 8 (1) (b) CTMR and Article 8 (5) CTMR.

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CTMA



Earlier marks

CLINIQUE

Case T-566/13; Hostel Tourist World, S.L. v OHIM; Judgment of 29 April 2015; Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Conceptual identity, Descriptive element, Distinctive element, Dominant element, Figurative trade mark, Figurative element, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Similarity of signs, Similarity of the goods and services, Visual similarity

FACTS: The applicant registered the figurative mark represented below as a CTM for services within Classes 35, 39 and 43. An application for invalidity was filed based, among other earlier rights, on international Registration (IR) word mark HOSTELWORLD.COM registered for services in Classes 39 and 43. The Cancellation Division dismissed the application for invalidity and the invalidity applicant filed an appeal. The Board of Appeal (BoA) partly upheld the invalidity applicant's appeal, namely for the services in Classes 39 and 43. The CTM proprietor filed an action before the General Court (GC).

SUBSTANCE: DESCRIPTIVE CHARACTER OF THE EARLIER INTERNATIONAL REGISTRATION: The GC confirms that an analogous reasoning to that followed by the jurisprudence that states the impossibility of questioning the validity of an

SUBSTANCE: The GC confirmed the finding of likelihood of confusion pursuant to Article 8 (1) (b) CTMR. The goods are directed to average consumers, who, however, will pay an enhanced attention as far as pharmaceutical products are concerned (Paras. 25-26). The goods are similar partially to a high, partially to a low degree (Para. 46). The dominant element of the CTMA is the word "CLEANIC" (para 55). The signs are similar visually to a low degree (Para. 63) and phonetically to a high degree (para. 70). The conceptual comparison is not possible as one of the marks do not have a meaning (Para. 74). With regard to the alleged infringement of Article 8 (5) CTMR the GC confirmed the finding that the use of the CTM would equal to unfair advantage of the distinctive character of the earlier CTM. It rejected CTM applicant's argument regarding the co-existence of the marks, as it was claimed only for Poland, whereas the earlier mark is protected in the whole territory of the EU.

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CTMA



Earlier marks

HOSTELWORLD.COM

earlier IR designating the EU within an opposition is applicable to invalidity proceedings. Consequently, the BoA did not infringe Article 63-64 when it did not determine the descriptive character of the earlier IR since the IR's minimum degree of distinctiveness had to be presumed (Paras. 35-40).

LIKELIHOOD OF CONFUSION (LOC): The BoA's findings on the relevant public and of partial identity and partial high similarity of the services involved, although no contested, were confirmed by the GC; a degree of attentiveness ("neither particularly low nor particularly high") is inferred from the BoA's mere reference to a well informed and reasonably observant and circumspect consumer (Paras. 45-47). COMPARISON OF THE SIGNS: None of the elements of the CTM (figurative/verbal) is insignificant (Para. 52). The verbal elements of the marks are descriptive for the services in Class 43 and slightly distinctive for the services in Class 39; same conclusion is applicable to the figurative element (Paras. 57-58). The descriptive character of

the verbal component of a sign does not lead to a higher relevance of the figurative element when the figurative element is also descriptive or slightly distinctive (see in this regard Para. 58). The signs are found to be visually and phonetically similar to an average degree and conceptually identical (Paras. 59-65). The low distinctive character of the earlier IR does not impede the existence of LOC taking into account the degree of similarity between the services and between the signs (Para. 71).

Case T-710/13; Bundesverband Deutsche Tafel e.V. v OHIM; Judgement of 18 September 2015; Language of the case: DE

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Descriptive element, Distinctive element, Nature of the goods and services

FACTS: The trade mark TAFEL had been registered as a CTM for the applicant in 2010 for services in Classes 39 and 45. The intervener filed a cancellation action pursuant to Article 52 (1) (a) / Article 7 (1) (b) and (c) CTMR, which was rejected by the Cancellation Division (CD). Upon appeal by the intervener the Boards of Appeal (BoA) annulled the CD decision and declared the CTM invalid, as it found "TAFEL" to be descriptive for the services in question (e.g. collection and distribution of essential goods, including foodstuffs, for those in need). "TAFEL"

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can have several meanings in German, namely “table”/festive meal” on one hand, or, on the other hand, a synonym for charity projects, particularly concerning the gathering of goods/foodstuffs for those in need. Understood in the first sense “table”, the word merely describes that goods such as foodstuffs are collected and presented/served at a table. The descriptiveness of the term is confirmed by the second meaning “charity projects”, which directly describes that the services of distribution of cheap foodstuff etc. will be rendered and received by those in need in the context of a charity action at a table. As the CTM is descriptive for the services in question, it is also non-distinctive. The CTM owner filed an action before the General Court (GC), claiming a violation of Article 7 (1) (c) and (b) CTMR.

CTM

TAFEL

SUBSTANCE: At the outset, the GC underlined that the services in question concern everyday items and are targeted at the general consumers. As the sign in question consists of a German word, the meaning is to be determined with regard to the German public (Para. 21). It is acknowledged that “TAFEL” can have several meanings. As is apparent from the contested decision, the BoA has based its decision on the descriptiveness of the term “TAFEL” exclusively on

the meaning of “table” and not on the meaning of “charity project”. The second meaning was only mentioned subordinately in order “to confirm” that the expression in its first meaning is descriptive (Paras 23-30). However, “TAFEL” understood in a sense of “table” is not descriptive for the services at hand. Even though the collection and distribution of foodstuff can take place at a table, this is not necessarily always the case. Furthermore, there is a discrepancy between “table” as a synonym for a “festive/solemn meal” and the actual nature of the services, which concern the supply of the most basic foodstuffs for those in need. For these reasons, the term “TAFEL” cannot be immediately related without further thought to the services in question (Paras. 31-36). Consequently, regardless of what might have been decided on the basis of a different meaning of “TAFEL”, the BoA violated Article 7 (1) (c) CTMR when finding that “TAFEL” in the sense of “table” is descriptive (Para. 37). As the finding of a lack of distinctiveness was exclusively deduced from the - erroneous - belief that “TAFEL” was descriptive for the services, the BoA also violated Article 7 (1) (b) CTMR (Paras. 45-48). Based on the foregoing, the decision of the BoA was annulled.

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Case T-720/13; GAT Microencapsulation GmbH v OHIM; Judgment of 30 September 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Complementary goods and services, Coexistence of trade marks, Nature of goods and services, Similarity of the goods and services, Similarity of the signs, Likelihood of confusion, Specialised public, Purpose of the goods and services, Restriction of the list of goods and services

FACTS: The applicant sought to register word sign KARIS as a CTM for the goods and services in Classes 1, 5 and 35.

An opposition was filed based on the following earlier rights: the previous word CTM CARYX, registered for goods in Classes 1 and 5; the previous international word mark CARYX, designating countries within EU, registered for goods in Classes in 1 and 5 and three previous national word marks AKRIS, registered for goods in Class 5.

Following the opposition, the applicant amended the application by inserting restrictions in the list of goods and services excluding the goods and services for which the earlier marks were registered. The Opposition Division (OD) partially upheld the opposition on the ground of LOC between the CTM application and the CTM CARYX and rejected the application for part of the goods and services. The applicant filed an appeal before the Board of

Appeal (BoA). The BoA allowed the appeal in part and annulled the OD's decision to the extent that it upheld the opposition in respect of some of the goods and in Class 5. For reasons of procedural economy the other opposing earlier rights were not examined. The applicant filed an application for annulment before the General Court (GC) on the basis of infringement of article 8 (1) (b) CTMR.

CTMA

KARIS

Earlier marks

CARYX

AKRIS

SUBSTANCE: The GC considered that the relevant public are professionals and consumers with a level of attention that is at least average or may be enhanced.

The GC affirmed that the goods and services applied for are similar to the goods and services for which the earlier CTM was registered for. The applicant expressly excluded some of the goods of the heading which correspond to the goods the

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earlier mark was registered for. However, the GC ruled that such exclusion made from the applicant did not preclude a finding that the rest of the goods are similar.

The applicant failed to demonstrate how the nature and the purpose of the goods applied for differ from the goods and services the earlier mark was registered for. There is similarity of signs according to the GC.

There is no coexistence of the marks in the view of the GC, as the applicant submitted descriptive and administrative documents which failed to demonstrate an actual coexistence of the marks.

Therefore there is LOC and the action was dismissed.

Case T-642/13; Wolverine International, LP v OHIM; Judgment of 15 October 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Proof of use, Visual similarity, Phonetic identity, Conceptual similarity, Distinctive element, Identity of the goods and services, Request for proof of use, Similarity of the goods and services, Catalogue, Evidence of use, Declaration, Extent of use, Likelihood of confusion, Similarity of the signs

FACTS: The owner of several earlier German trade marks SHE filed a request for invalidity (Article 53 (1) (a) / Article 8 (1) (b) CTMR) against the figurative IR designating the EU (as displayed underneath). All trade marks are registered for identical goods, namely clothing, footwear, headgear. The IR trade mark owner requested the invalidity applicant to prove use (PoU) of its earlier marks. The Cancellation Division (CD) - without examining the submitted evidence for PoU for reasons of procedural economy - found a low degree of visual and phonetic and no conceptual similarity and denied a likelihood of confusion (LOC). Consequently, the invalidity request was rejected.

The Board of Appeal (BoA) annulled the CD decision. With regard to PoU, the BoA found genuine use of the earlier marks for clothing and footwear. As regard the comparison of signs, the BoA found the marks phonetically identical and visually and conceptually similar. In view of all those factors and the identity and similarity of the goods, the BoA found LoC despite a low distinctive character of the earlier marks.

The owner of the IR filed an application to the General Court (GC), requesting the annulment of the BoA's decision. The application was based on two pleas of law, namely a claimed infringement of Article 57 (2), (3) CTMR and of Article 8 (1) (b) CTMR.

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Contested IR (EU)

cushe

Earlier mark

SHE

SUBSTANCE: With regard to Article 57 (2) (3) CTMR (PoU), the applicant had questioned the probative value of the numerous catalogues due to the fact that they also contained non relevant goods in Class 18 (bags). The GC pointed out that the probative value of the catalogues could not be undermined by this fact, as the goods displayed were primarily relevant clothing goods (Para. 27). With regard to 38 invoices from suppliers concerning the sale of large quantities to the owner of the earlier marks, the GC held that the BoA was entitled to take them into account despite the fact that they were not addressed to end consumers. In this respect the GC stressed that an accumulation of evidence may allow the necessary facts to be established, even though each of those pieces of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts. Furthermore, taking account of the particular method of distribution that retail constitutes, it is possible to provide evidence

other than invoices addressed to end consumers (Para. 34). As the owner of the earlier marks had submitted a large number of invoices, catalogues, figures on advertisement expenditures, product samples and a sworn statement, the GC in an overall assessment deemed the evidence sufficient to demonstrate genuine use and particularly its extent (Paras. 35-38).

With regard to the alleged infringement of Article 8 (1) (b) CTMR, the GC confirmed the BoA's finding of an average degree of attentiveness of the relevant public when purchasing clothing items. The applicant's argument that the end consumer is generally very observant and circumspect when buying clothes or shoes was not corroborated by any evidence in this regard (Paras. 45, 46).

With regard to the comparison of the signs, the GC endorsed the BoA's finding of visual and conceptual similarity and phonetic identity, and thus an overall similarity. It rejected the applicant's claim that the contested mark is a compact and homogeneous sign and held that it rather is clearly divided into two parts: an initial element consisting of a curved line and a second element consisting of the word "she" in a classic typeface. Even though a part of the relevant public would analyse the curved line as the stylised script of the element "cu", that is not true for all of the public, in particular, as the word "cushe" does not exist in German (Paras. 56, 57).

As regards the global assessment of LOC, the BoA's findings are not undermined by the fact that the visual aspect admittedly plays an important

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role when purchasing clothes, as the marks, in any event, were correctly deemed visually similar (Para. 71). The correct finding of LOC is not called into question by the applicant's argument that the earlier marks SHE have a low distinctive character. The distinctiveness of the earlier marks is just one factor among others in the global assessment and does not automatically exclude LOC (Paras. 74, 75). In light of the identity/similarity of the goods and the degree of similarity of the signs, the BoA correctly concluded LOC (Para. 72).

Based on the foregoing the action was dismissed.

Case T-60/13 Reiner Appelrath-Cüpper Nachf. GmbH v. OHIM; Judgment of 23 September 2015; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Likelihood of confusion, Specialised public, Identity of the goods and services, Similarity of the goods and services, Acronym, Phonetic identity, Conceptual dissimilarity

FACTS: The applicant sought to register the figurative trade mark below as a CTM for goods and services in Classes 9, 14, 18, 25 and 35. The Opposition Division (OD) rejected the opposition. The Fourth Board of Appeal (BoA) partly upheld the appeal. The CTM applicant filed an application before the General Court (GC) for the partial annulment of the decision of the BoA.

CTMA

Earlier marks



SUBSTANCE: The relevant public is made up of the German general public (for goods in Classes 9, 14, 18 and 25) and German professionals such as businessmen and women, with regard to services in Class 35. The findings of the BoA as to the identity or similarity of the goods and services are not vitiated and uncontested by the parties.

The BoA erred in finding at least an average degree of visual similarity between the signs. There is only a low degree of visual similarity between them.

Interesting finding at (Paras. 39-40): while in the fashion sector consumers are accustomed to acronyms consisting of two or three letters being used to refer to trade marks that reproduce the

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initials of the words, the average consumer will tend not to pronounce the letters of the acronym, but the words beginning with those initials, except where the acronym is well-known.

Therefore, when pronouncing the earlier German marks, the relevant public will have the tendency to restrict itself to pronouncing the word elements “ann christine”, instead of AC or AC Ann Christine. As the mark applied for is composed of the sole word element “ac”, the BoA erred in finding that those marks were phonetically identical.

The BoA was right to find that none of the signs at issue have a meaning in German, which excludes conceptual similarity.

Given that the signs at issue are similar to a low degree only and that they have a normal degree of distinctiveness, and despite the fact that the goods and services for which the mark applied for seeks registration are partly identical and partly similar to those designated by the earlier marks, there is no LOC. The contested decision must be annulled in so far as it upheld the opposition in part.

Case T-610/13; Ecolab USA, Inc., v. OHIM; Judgment of 30 September 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Descriptive element, Nature of the goods and services, Purpose of the goods and

services, Distinctive element, Principle of legality

FACTS: The applicant sought the registration of the international word mark GREASECUTTER designating the European Community for goods in Classes 3 and 5. The Office issued a notice of provisional refusal of protection in the European Union of the word mark at issue, pursuant to Article 7 (1) (c) and 7 (1) (b) CTMR. The applicant filed a notice of appeal against that decision. The Board of Appeal (BoA) allowed the appeal in part in respect of “dentifrices” in Class 3 and “preparations for destroying vermin; herbicides” in Class 5. However, it upheld the examiner’s decision with respect to the other goods on the ground that the mark sought was descriptive of those goods within the meaning of Article 7 (1) (c) CTMR and, since it was descriptive, it lacked distinctive character according to Article 7 (1) (b) CTMR.

The applicant filed an action before the General Court (GC) alleging, respectively, an infringement of Article 7 (1) (c) and an infringement of Article 7 (1) (b) CTMR.

CTMA

GREASECUTTER

SUBSTANCE: The GC confirmed the BoA’s decision and dismissed the appeal. The GC noted, as the BoA did, that the term “greasecutter” is made up of a juxtaposition of two distinct words from the English

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language, namely “GREASE” meaning “animal fat in a soft or melted condition” and “CUTTER” meaning “a person or thing that cuts, in particular a person who cuts cloth for clothing”. In addition, the verb “to cut” means, inter alia, “to dissolve” or “to break down” and the word “greasy” was also used to refer to something that resembles grease, such as “greasy hair” or “greasy skin” (Paras. 24-26). Therefore, the GC upheld the BoA’s finding that the mark at issue could be construed by the relevant public only as a combination of the two descriptive elements of which it is composed and whose meaning does not extend beyond what each of those elements means separately. Thus, the mark sought, taken as a whole, conveys to consumers, without further thought, that the goods covered by the trade mark application are goods which cut (dissolve) or reduce animal fat or greasiness and is thus directly descriptive of their nature, properties or intended use. The GC referred to the Case-Law according to which although the term “greasecutter” does not exist per se in any language of the EU Member States, it is a neologism being composed of English words which are easily identifiable by the English-speaking public (Para. 28). The GC also stated that the mere fact, that there may be other terms which describe more precisely the characteristics of degreasers or scouring preparations, such as “degreaser”, “grease remover” or “scouring preparations”, does not rule out the application of Article 7 (1) (c) CTMR (Para. 33). The BoA’s references to the results of Internet searches on the term “greasecutter” must be viewed as being purely illustrative and not as having decisive value for establishing the descriptive character of the mark sought. It is not necessary that the sign is already

be known as being descriptive; rather, it is sufficient that it could be used for such purposes for it to come within the scope of the absolute ground for refusal in Article 7 (1) (c) CTMR (Para. 34). The general and abstract list of the goods concerned, necessarily encompasses goods which, by their nature, composition, packaging or effects, are intended specifically to remove fat or reduce greasiness. Thus, the purpose of “bleaching preparations” and “polishing and abrasive preparations” in Class 3 is to launder, wash or make clean, with the result that they eliminate or remove any greasy impurities. Although it is true that the latter goods are primarily intended to make a surface smooth, such an action will necessarily have the effect of removing any impurities, including possibly grease. “Cosmetics” and “hair lotions” in Class 3, and “disinfectants” and “fungicides” in Class 5, may have the effect of removing excess sebum produced by the skin and of removing or reducing greasiness (Para. 37). Since the applicant did not set out any limitations excluding goods used to dissolve or reduce grease, the BoA was correct in considering that the goods for which registration was refused necessarily included such goods and accordingly concluded that the mark sought was descriptive within the meaning of Article 7 (1) (c) CTMR. (Para. 38). Finally, the applicant cannot deduct any rights from prior registrations in the U.S.A or alleged Office practice, as the BoA is only bound by the law and not by prior Office practice. Besides, each case has to be judged upon its own merits (Paras. 39-44).

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Case T-624/13; The Tea Board v OHIM; Judgment of 2 October 2015; Language of the case: EN

RESULT: Action partly upheld (BoA decision partly annulled)

KEYWORDS: Collective mark, Geographical origin, Similarity of goods and services, Likelihood of confusion, Reputation, Unfair advantage, Detriment to earlier mark

FACTS: The applicant sought to register the figurative mark represented below as a CTM for goods and services within Classes 25, 35 and 38. An opposition based on the earlier collective word mark DARJEELING and the earlier collective figurative mark represented below, registered for goods in Class 30, was filed on the grounds of Article 8 (1) (b) and 8 (5) CTMR. The Opposition Division dismissed the opposition. The Board of Appeal (BoA) dismissed the opponent's appeal. The opponent filed an action before the General Court (GC).

SUBSTANCE: Regarding infringement of Article 8 (1) (b) CTMR: The GC has confirmed that the essential function of a Community collective trade mark (CCTM) is the same as that of a Community individual trade mark (CTM) (Paras. 40-46) and that the criteria for the comparison of the goods and services under Article 8 (1) (b) CTMR do not change when a CCTM is involved (Para. 49). It further points out that the possibility that the public might believe

CTMA

Darjeeling

Earlier mark

1 DARJEELING



that the goods/services covered by the signs have the same geographical origin does not constitute a criterion sufficient to establish their similarity/identity for the purposes of Article 8(1)(b) (Paras. 51-52) and that, even assuming that the (geographical) origin of the goods or services covered by the signs at issue may constitute one of the factors to be taken into account in the global assessment of the likelihood of confusion, Article 8 (1) (b) CTMR is not applicable where one of the cumulative conditions has not been met (Paras. 59-61).

Regarding infringement of Article 8 (5) CTMR: The definition of the relevant public is a necessary prerequisite for the purposes of applying Article 8

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(5) CTMR; this public varying according to the alleged type of injury (Paras. 70-71). REPUTATION AND LINK: The assessment of whether a CTM falling under Article 66 (2) CTMR has a reputation must be carried out using the same criteria as those applicable to individual marks (paras 74-76). The GC concludes that the BoA continued its analysis for the purposes of applying Article 8 (5) CTMR while relying on two hypothetical premises: the first being that the earlier trade marks enjoyed a reputation the strength of which was that which the applicant had ascribed to them, namely, exceptional, and the second that it was possible that the relevant public might establish a link between the signs at issue (Paras. 78-93). DETRIMENT TO DISTINCTIVENESS: After considering that the word element “darjeeling” can be used for marks other than those earlier marks, as is clear from the second sentence of Article 66 (2) CTMR, and that the existing unique connection between the geographical name “Darjeeling” and Darjeeling tea does not exist between that name and the goods and services covered by the contested mark, the GC confirms, in the absence of evidence to establish a serious likelihood of a change in the economic behaviour of the average consumer, that there is no risk of detriment to the distinctiveness of the earlier mark (Paras. 99-113). DETRIMENT TO REPUTATION: The GC takes into account that the applicant did not mention the characteristics of the goods or services covered by the contested mark which would be liable to have a negative impact on the image of the earlier trade marks; that none evidence

establishes that the image generally conveyed by the contested goods and services is negative or that there is antagonism between the nature or the method of use of tea and the contested goods or services; and that there is no unique connection between this region and the contested goods and services. Thus, the GC confirms that there is no risk of detriment to the reputation of the earlier mark (Paras. 114-122). UNFAIR ADVANTAGE: Even though the GC recognises that the characteristics normally associated with a mark with a reputation for tea cannot be considered to be such as to bring any advantage to a mark under which goods and services such as the contested ones are marketed, it refers to the jurisprudence that states that where an earlier trade mark with an exceptional reputation is involved, even if the goods and services covered by the signs at issue are quite different, it is not altogether inconceivable that the relevant public could be led to transfer the values of that earlier mark to the goods or services covered by the mark applied for. The GC concludes, in the light of the fact that the hypothetical premise on which the contested decision is based refers to a reputation of exceptional strength, the positive qualities evoked by the word element “darjeeling” shared by the signs at issue (the image of sophistication or exotic sensuality) are capable of being transferred to some of the goods and services covered by the mark applied for (namely the goods in Class 25 and the retail services in Class 35 related to those goods) and, as a result, of strengthening the power of attraction

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of that mark. The same cannot be said of the rest of contested services (Paras. 136-145). CONCLUSION: the contested decision is partially annulled. It is left to the BoA the re-examination of the opponent's arguments in order to reach a definitive conclusion on whether any of the earlier mark is reputed (and how strong this reputation would be) and only if so, to reach a definitive conclusion on whether there is a link between the marks in the public's mind. If the BoA concludes that the reputation is exceptionally strong and that there is a link between the marks, a risk of unfair advantage should be found in relation to some goods and services and the examination on the existence of due cause should be carried out.

Case T-625/13; The Tea Board v OHIM; Judgment of 2 October 2015; Language of the case: EN

RESULT: Action partly upheld (BoA decision partly annulled)

KEYWORDS: Collective mark, Geographical origin, Similarity of goods and services, Likelihood of confusion, Reputation, Unfair advantage, Detriment to earlier mark

FACTS: The applicant sought to register the figurative mark represented below as a CTM for goods and services within Classes 25, 35 and 38. An opposition based on the earlier collective word mark DARJEELING and the earlier collective figurative

mark represented below, registered for goods in Class 30, was filed on the grounds of Article 8 (1) (b) and 8 (5) CTMR. The Opposition Division dismissed the opposition. The Board of Appeal (BoA) dismissed the opponent's appeal. The opponent filed an action before the General Court (GC).

CTMA

Darjeeling
collection de lingerie

Earlier mark

1 DARJEELING

2



SUBSTANCE: Regarding infringement of Article 8 (1) (b) CTMR: The GC has confirmed that the essential function of a Community collective trade mark (CCTM) is the same as that of a Community individual trade mark (CTM) (Paras. 40-46) and that the criteria for the comparison of the goods and services under Article 8 (1) (b) CTMR do not change when a CCTM is involved (Para. 49). It further points out that the

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possibility that the public might believe that the goods/services covered by the signs have the same geographical origin does not constitute a criterion sufficient to establish their similarity/identity for the purposes of Article 8 (1) (b) (Paras. 51-52) and that, even assuming that the (geographical) origin of the goods or services covered by the signs at issue may constitute one of the factors to be taken into account in the global assessment of the likelihood of confusion, Article 8 (1) (b) CTMR is not applicable where one of the cumulative conditions has not been met (Paras. 59-61).

Regarding infringement of Article 8 (5) CTMR: The definition of the relevant public is a necessary prerequisite for the purposes of applying Article 8 (5) CTMR; this public varying according to the alleged type of injury (Paras. 70-71). REPUTATION AND LINK: The assessment of whether a CTM falling under Article 66 (2) CTMR has a reputation must be carried out using the same criteria as those applicable to individual marks (Paras. 74-76). The GC concludes that the BoA continued its analysis for the purposes of applying Article 8 (5) CTMR while relying on two hypothetical premises: the first being that the earlier trade marks enjoyed a reputation the strength of which was that which the applicant had ascribed to them, namely, exceptional, and the second that it was possible that the relevant public might establish a link between the signs at issue (Paras. 78-93). DETRIMENT TO DISTINCTIVENESS: After considering that the word element “darjeeling” can be used for marks other than those earlier marks, as is clear

from the second sentence of Article 66 (2) CTMR, and that the existing unique connection between the geographical name “Darjeeling” and Darjeeling tea does not exist between that name and the goods and services covered by the contested mark, the GC confirms, in the absence of evidence to establish a serious likelihood of a change in the economic behaviour of the average consumer, that there is no risk of detriment to the distinctiveness of the earlier mark (Paras. 99-113). DETRIMENT TO REPUTATION: The GC takes into account that the applicant did not mention the characteristics of the goods or services covered by the contested mark which would be liable to have a negative impact on the image of the earlier trade marks; that none evidence establishes that the image generally conveyed by the contested goods and services is negative or that there is antagonism between the nature or the method of use of tea and the contested goods or services; and that there is no unique connection between this region and the contested goods and services. Thus, the GC confirms that there is no risk of detriment to the reputation of the earlier mark (Paras. 114-122). UNFAIR ADVANTAGE: Even though the GC recognises that the characteristics normally associated with a mark with a reputation for tea cannot be considered to be such as to bring any advantage to a mark under which goods and services such as the contested ones are marketed, it refers to the jurisprudence that states that where an earlier trade mark with an exceptional reputation is involved, even if the goods and services covered

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by the signs at issue are quite different, it is not altogether inconceivable that the relevant public could be led to transfer the values of that earlier mark to the goods or services covered by the mark applied for. The GC concludes, in the light of the fact that the hypothetical premise on which the contested decision is based refers to a reputation of exceptional strength, the positive qualities evoked by the word element “darjeeling” shared by the signs at issue (the image of sophistication or exotic sensuality) are capable of being transferred to some of the goods and services covered by the mark applied for (namely the goods in Class 25 and the retail services in Class 35 related to those goods) and, as a result, of strengthening the power of attraction of that mark. The same cannot be said of the rest of contested services (Paras. 136-145). CONCLUSION: The contested decision is partially annulled. It is left to the BoA the re-examination of the opponent’s arguments in order to reach a definitive conclusion on whether any of the earlier mark is reputed (and how strong this reputation would be) and only if so, to reach a definitive conclusion on whether there is a link between the marks in the public’s mind. If the BoA concludes that the reputation is exceptionally strong and that there is a link between the marks, a risk of unfair advantage should be found in relation to some goods and services and the examination on the existence of due cause should be carried out.

Case T-626/13; The Tea Board v OHIM; Judgment of 2 October 2015; Language of the case: EN

RESULT: Action partly upheld (BoA decision partly annulled)

KEYWORDS: Collective mark, Geographical origin, Similarity of goods and services, Likelihood of confusion, Reputation, Unfair advantage, Detriment to earlier mark

FACTS: The applicant sought to register the figurative mark represented below as a CTM for goods and services within Classes 25, 35 and 38. An opposition based on the earlier collective word mark DARJEELING and the earlier collective figurative mark represented below, registered for goods in Class 30, was filed on the grounds of Article 8 (1) (b) and 8 (5) CTMR. The Opposition Division dismissed the opposition. The Board of Appeal (BoA) dismissed the opponent’s appeal. The opponent filed an action before the General Court (GC).

SUBSTANCE: Regarding infringement of Article 8 (1) (b) CTMR: The GC has confirmed that the essential function of a Community collective trade mark (CCTM) is the same as that of a Community individual trade mark (CTM) (Paras. 40-46) and that the criteria for the comparison of the goods and services under Article 8 (1) (b) CTMR do not change when a CCTM is involved (Para. 49). It further points out that the possibility that the public might believe

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CTMA

Darjeeling
collection de lingerie

Earlier marks

1 DARJEELING



that the goods/services covered by the signs have the same geographical origin does not constitute a criterion sufficient to establish their similarity/identity for the purposes of Article 8 (1) (b) (Paras. 51-52) and that, even assuming that the (geographical) origin of the goods or services covered by the signs at issue may constitute one of the factors to be taken into account in the global assessment of the likelihood of confusion, Article 8 (1) (b) CTMR is not applicable where one of the cumulative conditions has not been met (Paras. 59-61).

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type of injury (Paras. 70-71). REPUTATION AND LINK: The assessment of whether a CTM falling under Article 66 (2) CTMR has a reputation must be carried out using the same criteria as those applicable to individual marks (Paras. 74-76). The GC concludes that the BoA continued its analysis for the purposes of applying Article 8 (5) CTMR while relying on two hypothetical premises: the first being that the earlier trade marks enjoyed a reputation the strength of which was that which the applicant had ascribed to them, namely, exceptional, and the second that it was possible that the relevant public might establish a link between the signs at issue (Paras. 78-93). DETRIMENT TO DISTINCTIVENESS: After considering that the word element “darjeeling” can be used for marks other than those earlier marks, as is clear from the second sentence of Article 66 (2) CTMR, and that the existing unique connection between the geographical name “Darjeeling” and Darjeeling tea does not exist between that name and the goods and services covered by the contested mark, the GC confirms, in the absence of evidence to establish a serious likelihood of a change in the economic behaviour of the average consumer, that there is no risk of detriment to the distinctiveness of the earlier mark (Paras. 99-113): DETRIMENT TO REPUTATION: The GC takes into account that the applicant did not mention the characteristics of the goods or services covered by the contested mark which would be liable to have a negative impact on the image of the earlier trade marks; that none evidence establishes that the image generally conveyed by

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the contested goods and services is negative or that there is antagonism between the nature or the method of use of tea and the contested goods or services; and that there is no unique connection between this region and the contested goods and services. Thus, the GC confirms that there is no risk of detriment to the reputation of the earlier mark (Paras. 114-122). UNFAIR ADVANTAGE: Even though the GC recognises that the characteristics normally associated with a mark with a reputation for tea cannot be considered to be such as to bring any advantage to a mark under which goods and services such as the contested ones are marketed, it refers to the jurisprudence that states that where an earlier trade mark with an exceptional reputation is involved, even if the goods and services covered by the signs at issue are quite different, it is not altogether inconceivable that the relevant public could be led to transfer the values of that earlier mark to the goods or services covered by the mark applied for. The GC concludes, in the light of the fact that the hypothetical premise on which the contested decision is based refers to a reputation of exceptional strength, the positive qualities evoked by the word element “darjeeling” shared by the signs at issue (the image of sophistication or exotic sensuality) are capable of being transferred to some of the goods and services covered by the mark applied for (namely the goods in Class 25 and the retail services in Class 35 related to those goods) and, as a result, of strengthening the power of attraction of that mark. The same cannot be said of the rest of

contested services (Paras. 136-145). CONCLUSION: the contested decision is partially annulled. It is left to the BoA the re-examination of the opponent’s arguments in order to reach a definitive conclusion on whether any of the earlier mark is reputed (and how strong this reputation would be) and only if so, to reach a definitive conclusion on whether there is a link between the marks in the public’s mind. If the BoA concludes that the reputation is exceptionally strong and that there is a link between the marks, a risk of unfair advantage should be found in relation to some goods and services and the examination on the existence of due cause should be carried out.

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RESULT: Action partly upheld (BoA decision partly annulled)

KEYWORDS: Collective mark, Geographical origin, Similarity of goods and services, Likelihood of confusion, Reputation, Unfair advantage, Detriment to earlier mark

FACTS: The applicant sought to register the figurative mark represented below as a CTM for goods and services within Classes 25, 35 and 38. An opposition based on the earlier collective word mark DARJEELING and the earlier collective figurative mark represented below, registered for goods in

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Class 30, was filed on the grounds of Article 8 (1) (b) and 8 (5) CTMR. The Opposition Division dismissed the opposition. The Board of Appeal (BoA) dismissed the opponent's appeal. The opponent filed an action before the General Court (GC).

CTMA

Darjeeling

Earlier marks

1 DARJEELING



SUBSTANCE: Regarding infringement of Article 8 (1) (b) CTMR: The GC has confirmed that the essential function of a Community collective trade mark (CCTM) is the same as that of a Community individual trade mark (CTM) (Paras. 40-46) and that the criteria for the comparison of the goods and services under Article 8 (1) (b) CTMR do not change when a CCTM is involved (Para. 49). It further points out that the possibility that the public might believe that the goods/services covered by the signs have the same

geographical origin does not constitute a criterion sufficient to establish their similarity/identity for the purposes of Article 8 (1) (b) (Paras. 51-52) and that, even assuming that the (geographical) origin of the goods or services covered by the signs at issue may constitute one of the factors to be taken into account in the global assessment of the likelihood of confusion, Article 8 (1) (b) CTMR is not applicable where one of the cumulative conditions has not been met (Paras. 59-61).

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the geographical name “Darjeeling” and Darjeeling tea does not exist between that name and the goods and services covered by the contested mark, the GC confirms, in the absence of evidence to establish a serious likelihood of a change in the economic behaviour of the average consumer, that there is no risk of detriment to the distinctiveness of the earlier mark (Paras. 99-113). **DETRIMENT TO REPUTATION:** The GC takes into account that the applicant did not mention the characteristics of the goods or services covered by the contested mark which would be liable to have a negative impact on the image of the earlier trade marks; that none evidence establishes that the image generally conveyed by the contested goods and services is negative or that there is antagonism between the nature or the method of use of tea and the contested goods or services; and that there is no unique connection between this region and the contested goods and services. Thus, the GC confirms that there is no risk of detriment to the reputation of the earlier mark (Paras. 114-122). **UNFAIR ADVANTAGE:** Even though the GC recognises that the characteristics normally associated with a mark with a reputation for tea cannot be considered to be such as to bring any advantage to a mark under which goods and services such as the contested ones are marketed, it refers to the jurisprudence that states that where an earlier trade mark with an exceptional reputation is involved, even if the goods and services covered by the signs at issue are quite different, it is not altogether inconceivable that the relevant public

could be led to transfer the values of that earlier mark to the goods or services covered by the mark applied for. The GC concludes, in the light of the fact that the hypothetical premise on which the contested decision is based refers to a reputation of exceptional strength, the positive qualities evoked by the word element “darjeeling” shared by the signs at issue (the image of sophistication or exotic sensuality) are capable of being transferred to some of the goods and services covered by the mark applied for (namely the goods in Class 25 and the retail services in Class 35 related to those goods) and, as a result, of strengthening the power of attraction of that mark. The same cannot be said of the rest of contested services (Paras. 136-145). **CONCLUSION:** the contested decision is partially annulled. It is left to the BoA the re-examination of the opponent’s arguments in order to reach a definitive conclusion on whether any of the earlier mark is reputed (and how strong this reputation would be) and only if so, to reach a definitive conclusion on whether there is a link between the marks in the public’s mind. If the BoA concludes that the reputation is exceptionally strong and that there is a link between the marks, a risk of unfair advantage should be found in relation to some goods and services and the examination on the existence of due cause should be carried out.

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Case T-364/13; Eugenia Mocek, Jadwiga Wenta KAJMAN Firma Handlowo-Uslugowo-Produkcyjna v OHIM; Judgment of 30 of September 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Conceptual similarity, Figurative element, Figurative trade mark, Identity of the goods and services, Likelihood of confusion, , Similarity of the goods and services, Distinctive element, Reputation, Unfair advantage

FACTS: The applicant sought to register figurative sign represented below as a Community trade mark (CTM) for goods and services in Classes 18, 20, 22, 25 and 36.

An opposition was filed against the registration on the basis inter alia of the earlier figurative CTM represented below, which cover inter alia goods and services in Classes 18, 20, 24 and 25.

The Opposition Division (OD) rejected the opposition.

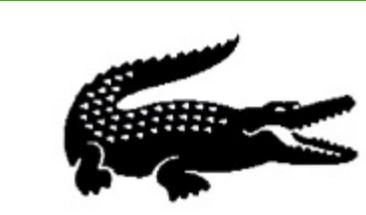
The Board of Appeal (BoA) annulled the decision of the OD in part. The BoA considered there was a likelihood of confusion between the marks at issue in respect of goods in Classes 18 and 25.

The applicant filed an application for annulment and the opponent filed an application for annulment in part and alteration before the General Court (GC).

CTMA



Earlier mark



SUBSTANCE: The GC confirmed the conclusion of the BoA that the relevant public are the consumers with an average level of attention and that the goods and services were identical or similar (Paras. 28 and 30). In relation to the signs the GC made the following conclusions: the degree of visual similarity is low, it cannot be concluded on the phonetic similarity as the earlier mark is lacking a word element, and there is conceptual similarity between the signs. GC concluded that the CTM possess highly distinctive character for leather goods, in particular “bags” in Class 18 and for “clothing and footwear” in Class 25 acquired by use. Therefore there is LOC for the goods and services in Classes 18 and 25. The GC rejected the argument of the applicant

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that the BoA's decision is granting the opponent an unjustified monopoly of the representation of a reptile of the order of crocodylians, regardless of its degree of artistic stylisation. The GC stated that the advantage of the legal regime of the CTM lies precisely in the fact that it enables holders of an earlier trade mark to oppose the registration of later marks which take unfair advantage of the distinctive character or the repute of the earlier trade mark (Para. 72). GC considered the opponent's complain on the high degree of inherent distinctiveness of the earlier mark for goods and services in Class 20 to be out of time and therefore inadmissible (Para. 87). The GC dismissed both the action of the applicant and the application for annulment in part and alteration of the opponent.

Case T-525/13; H&M Hennes & Mauritz BV & Co. KG v OHIM; Judgment of 10 September 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Conflict of design with prior design, Individual character, Freedom of designer, Overall impression, Visible features of design

FACTS: The Registered Community Design (RCD) proprietor registered a design for handbags in Class 03-01.

The invalidity applicant claimed that the contested

design lacked individual character within the meaning of Article 6 CDR, invoking his earlier design reproduced below.

The Cancellation Division (CD) rejected the application. The invalidity applicant appealed the decision and its appeal was dismissed by the Third Board of Appeal (BoA).

Before the General Court (GC), the invalidity applicant alleges that: 1) the BoA did not sufficiently state why the high degree of freedom of the designer did not have any impact on the finding that the designs at issue produced a different overall impression 2) the BoA erroneously concluded that the high degree of freedom of the designer did not have any impact on the finding that the designs at issue produced a different overall impression and that the differences between the designs at issue were significant enough to create a different overall impression, failing to identify and correctly assess the similarities between the designs.

SUBSTANCE: The BoA did not fail to state the reasons of its decision since its reasoning is sufficiently clear and unequivocal. The invalidity applicant's claim is therefore rejected as unfounded (Para. 18).

The assessment of the designer's degree of freedom does not necessarily constitute a preliminary and abstract step in the comparison of the overall impression by each design at issue (Para. 33). The BoA correctly found that was the designer's degree of freedom was a factor which made it possible to moderate the assessment of the individual

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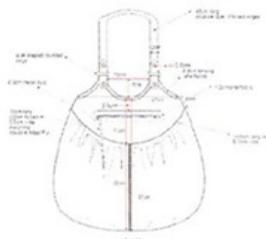
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Registered RCD



Earlier design



character of the contested design (Para. 35). The BoA correctly stated that the overall impressions produced by designs differed as to three features which decisively influenced their overall visual appearance, namely the overall shape, structure and surface finish of the bag (Para. 36). The assessment of the overall impression produced by a design includes the manner in which the product represented by that design is used. The contested design represents a bag to be carried solely by hand,

whereas the earlier design represents a bag to be carried on the shoulder. Accordingly, the features that are common to the two designs at issue, namely their upper contour and the presence of a handle in the form of a strap or straps attached to the body by a system of rings reinforced by rivets, do not suffice to confer the same overall impression (Para. 39). Even assuming that the invalidity applicant's claim is admissible, it is wholly unfounded. The action must therefore be dismissed in its entirety (Paras. 44-45).

Case T-526/13; H&M Hennes & Mauritz BV & Co. KG v OHIM; Judgment of 10 September 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Conflict of design with prior design, Individual character, Freedom of designer, Overall impression, Visible features of design

FACTS: The Registered Community Design (RCD) proprietor registered a design for handbags in Class 03-01.

The invalidity applicant claimed that the contested design lacked individual character within the meaning of art. 6 CDR, invoking his earlier design reproduced below.

The Cancellation Division (CD) rejected the application. The invalidity applicant appealed the decision and its appeal was dismissed by the Third

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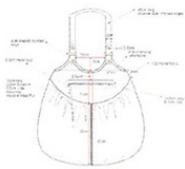
Board of Appeal (BoA).

Before the General Court (GC), the invalidity applicant alleges that: 1) the BoA did not sufficiently state why the high degree of freedom of the designer did not have any impact on the finding that the designs at issue produced a different overall impression 2) the BoA erroneously concluded that the high degree of freedom of the designer did not have any impact on the finding that the designs at issue produced a different overall impression and that the differences between the designs at issue were significant enough to create a different overall impression, failing to identify and correctly assess the similarities between the designs.

Registered RCD



Earlier design



SUBSTANCE: The BoA did not fail to state the reasons of its decision since its reasoning is sufficiently clear and unequivocal. The invalidity applicant's claim is therefore rejected as unfounded (Para. 18).

The assessment of the designer's degree of freedom does not necessarily constitute a preliminary and abstract step in the comparison of the overall impression by each design at issue (Para. 33). The BoA correctly found that that was the designer's degree of freedom was a factor which made it possible to moderate the assessment of the individual character of the contested design (Para. 35).

The BoA correctly stated that the overall impressions produced by designs differed as to three features which decisively influenced their overall visual appearance, namely the overall shape, structure and surface finish of the bag (Para. 36).

The assessment of the overall impression produced by a design includes the manner in which the product represented by that design is used. The contested design represents a bag to be carried solely by hand, whereas the earlier design represents a bag to be carried on the shoulder. Accordingly, the features that are common to the two designs at issue, namely their upper contour and the presence of a handle in the form of a strap or straps attached to the body by a system of rings reinforced by rivets, do not suffice to confer the same overall impression (Para. 39).

Even assuming that the invalidity applicant's claim is admissible, it is wholly unfounded. The action must therefore be dismissed in its entirety (Paras. 44-45).

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Case T-222/14; Deluxe Laboratories, Inc. v OHIM; Judgment of 4 June 2015; Language of the case: ES

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Descriptive element, Distinctive element, Distinctiveness acquired by use, Evidence of use, Figurative trade mark, Figurative element, Lack of reasoning, Laudatory mark, Legitimate expectations, Principle of legality

FACTS: The applicant sought to register the figurative mark represented below as a CTM for goods and services within Classes 9, 35, 37, 39, 40, 41, 42 and 45. The examiner refused to register the word as a CTM on the ground that it is descriptive and devoid of distinctive character. The Board of Appeal (BoA) dismissed the applicant's appeal. The applicant filed an action before the General Court (GC).

CTMA



SUBSTANCE: ARTICLE 75 THE DUTY TO STATE REASONS: The GC refers to the jurisprudence that establishes the BoA's duty, when refusing registration of a trade mark, to state in its decision its conclusion for each of the goods and services specified in the application for registration, and its possibility, where the same ground for refusal is given for a category or group of goods or services, to limit itself to using general reasoning for all of the goods or services concerned. It further refers to the jurisprudence that specifies that the option for the BoA to use general reasoning for a series of goods or services can extend only to goods or services which have a sufficiently direct and specific link to each other to the extent that they form such a sufficiently homogenous category as to enable all the factual and legal considerations constituting the grounds of the decision in question, first, to explain adequately the reasoning followed by the BoA for each of the goods and services belonging to that category and, second, to be applied without distinction to each of the goods or services concerned (Paras. 16-17). In this case, the GC concluded that the differences among the goods and services applied for do not allow considering them as a homogeneous category that permits the BoA to use a global reasoning and points out that the BoA used a global reasoning without indicating the existence of a sufficiently direct and specific link among the goods and services that justifies it. The fact that the term "deluxe" is a laudatory and promotional term that can be applied to all the goods and services at issue, even if proven, is irrelevant (Paras. 20-27).

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Decision of 14 September 2015 – R 1207/2013-G – KOLIBRE / KOLIBRI; Language of the case: EN

RESULT: Closed without decision.

KEYWORDS: *Costs*.

FACTS: The applicant sought to register the word mark for various goods and services in Classes 9, 41 and 42. The opponent filed a notice of opposition pursuant to Article 8(1)(b) CTMR, which was rejected by the Opposition Division. The President of the Boards of Appeal referred the case to the Grand Board, which discussed the case at its meeting in November 2014. The Rapporteur of the case sent a communication to the President of OHIM requesting his legal opinion. After the President's reply was sent to the parties, the opponent withdrew its opposition.

SUBSTANCE: As a consequence of the withdrawal of the opposition, both the opposition and appeal proceedings had lost their purpose and were closed accordingly.

[Link to eSearch Case Law](#)

Decision of 28 September 2015 – R 2491/2014-5 – Cremcafé by Julius Meini (FIG. MARK) / café crem (FIG. MARK); Language of the case: EN

RESULT: Decision annulled.

KEYWORDS: *Catalogue, Complex mark, Declaration, Evidence of use, Figurative trade mark, Nature of the goods and services, Nature of use, Place of use, Press articles, Promotional material, Proof of use, Relevant territory, Request for proof of use, Sales figures, Substantiation of earlier right*.

FACTS: The applicant sought to register a figurative mark as represented below for goods and services in Classes 21, 30 and 35. The opponent filed an opposition against the registration of the contested Community trade mark application (CTMA) invoking Article 8(1)(b) CTMR (a likelihood of confusion). The opposition was based on the opponent's figurative mark represented below and was directed against all the goods in Class 30. The Opposition Division upheld the opposition in its entirety, which was appealed by the applicant.

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CTMA



Earlier CTM



SUBSTANCE: The Board found that the earlier CTM was under the requirement of proof of use. The material was not convincing. It could be argued whether the nature of use was acceptable. The only catalogue which showed the nature of use was undated. As regards the extent of use, the geographical extent was reduced to northern Spain, the arguments concerning exclusive Spanish use were unsatisfactory, taking into account the huge EU market for coffee, tea and sugar. Quantitatively the evidence submitted was also unsatisfactory. The affidavits, the invoices and the undated catalogue bundled products in such a way that presented favourable sums, but were contradictory on a number of points. Since all the data could be questioned, especially that submitted

in the affidavits, the evidence, on the whole, was unacceptable. The Opposition Division incorrectly considered that the evidence submitted by the opponent was sufficient to prove genuine use of the earlier CTM, consequently, the contested decision was annulled and the opposition rejected in its entirety.

[Link to eSearch Case Law](#)

Decision of 24 September 2015 – R 999/2014-2 – DEVICE OF CIRCLES SURROUNDING A HEXAGON (fig.); Language of the case: EN

RESULT: Decision annulled.

KEYWORDS: *Distinctive element, Figurative trade mark, Minimum degree of distinctiveness, Nature of the goods and services, Restriction of the list of goods and services, Shape of the product.*

FACTS: The examiner refused the registration of the figurative mark 'DEVICE OF CIRCLES SURROUNDING A HEXAGON' (as represented below) for goods in Class 9 on the basis of Article 7(1)(b) CTMR. The examiner found that the figurative mark applied for merely provided an abstract, suggestive illustration of the product itself, and which, as such, did not allow it to perform a trade mark function because – due to its visual characteristics – it would not be recognized by the relevant public as an indicator of trade origin.

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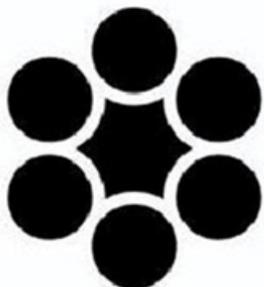
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CTMA



SUBSTANCE: The Board found that the figurative mark applied for was not typical of the shape of the goods in question, nor a basic geometric figure. The hexagon represented was not banal as it had curved sides and the specific combination of the six black circles around this hexagon was sufficiently distinctive when applied to batteries, accumulator boxes etc. in Class 9 (which, after a limitation before the Board, excluded goods for electric vehicles). Consequently, the Board concluded that the mark applied for had, at least, the minimum degree of distinctiveness necessary for it to surmount the barrier posed by Article 7(1)(b) CTMR. Consequently, the contested decision was annulled and the mark was accepted for publication for the specification of goods as amended.

[Link to eSearch Case Law](#)

Decision of 30 September 2015 – R 1789/2014-2 – TWO STRIPES (fig.) / COMBINATION OF GEOMETRIC SHAPES (fig.) et al.; Language of the case: EN

RESULT: Decision annulled.

KEYWORDS: *Coexistence of trade marks, Dissimilarity of signs, Distinctive element, Dominant element, Figurative element, Figurative trade mark, Identity of the goods and services, Likelihood of confusion, Minimum degree of distinctiveness, Nature of the goods and services, Passing off, Visual dissimilarity.*

FACTS: An opposition was filed against the CTMA to register the figurative mark represented below for 'clothing' in Class 25. The opposition was based on the earlier CTM (as represented below) registered for 'clothing, footwear, headgear' in Class 25. The Opposition Division upheld the opposition in part for goods and services in Classes 11 and 35.

SUBSTANCE: The Board found that the goods in question in Class 25 were identical. The contested decision considered that the graphic elements depicted in both signs were stripes. However, the present case concerned purely figurative signs, namely stripes versus geometric shapes (a rhomb and two rhomboids). There were significant visual differences between the signs as the earlier mark depicted a grey rhomb which contained two coloured rhomboids (blue and red), whereas the

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CTMA



Earlier CTM



contested sign depicted two coloured stripes (red and blue) which were not framed (unlike the blue/red shapes of the earlier mark). The order (blue, red / red, blue), the inclination of the graphic elements (right / left) and the shapes and contours of these two coloured elements were different between the signs. Also, the earlier mark covered dark tones of blue and red, whereas the contested sign covered bright tones of red and blue (although this discrepancy would not be retained by the average consumer). The earlier mark, being a mere abstract graphic sign composed of basic coloured geometric shapes,

was imbued with a weak distinctive character. The graphic dissimilarities found clearly outweighed any remote similarity. Contrary to the finding of the contested decision, which was therefore annulled, there was no likelihood of confusion within the meaning of Article 8(1)(b) CTMR.

[Link to eSearch Case Law](#)

Decision of 23 September 2015 - R 2226/2014-1 - CURY WORLD CONGRESS ON CONTROVERSIES IN UROLOGY (fig.) / CURY (fig.) et al.; Language of the case: EN

RESULT: Decision confirmed.

KEYWORDS: *Complex mark, Declaration, Figurative trade mark, Proprietor consent.*

FACTS: After the Opposition Division rejected an opposition against the contested figurative mark, the opponent filed an appeal. The First Board of Appeal partially annulled the contested decision as far as the ground under Article 8(3) CTMR was concerned and remitted the case back to the Opposition Division for further prosecution. The Opposition Division upheld the opposition on the ground of Article 8(3) CTMR and rejected the application for certain services in Class 41. The applicant filed an appeal against this decision.

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SUBSTANCE: The Board confirmed the contested decision. The terms 'agent' and 'representative' had to be interpreted broadly, so as to cover all kinds of relationships based on a contractual arrangement under which one party was representing the interests of the other, regardless of how the contractual relationship between the proprietor or principal, on the one hand, and the applicant for the Community trade mark, on the other, was categorised. It was sufficient for the purposes of Article 8(3) CTMR that there was some agreement of commercial co-operation between the parties of a kind that gave rise to a fiduciary relationship by imposing on the trade mark applicant – whether expressly or implicitly – a general duty of trust and loyalty as regards the interests of the trade mark proprietor (T-262/09, First Defense Aerosol Pepper Projector). This had to be assessed on a case-by-case basis, and the decisive factor had to be whether it was still possible for the applicant to take commercial advantage of his or her expired relationship with the trade mark proprietor by exploiting the know-how and contacts he acquired because of his position.

In the present case, the evidence submitted (court decision and several affidavits by the parties themselves and third parties) highlighted that the opponent was a chairman of this partnership. Various statements reflected further on the opponent's key role in the context of the organization of congresses. Therefore, the Board concluded that the Opposition Division was correct in finding that the conditions of Article 8(3) CTMR were fulfilled.

[Link to eSearch Case Law](#)

Decision of 13 October 2015 – R 236/2015-4 – FASHION X; Language of the case: EN

RESULT: Decision annulled.

KEYWORDS: *Admissibility, Complex mark, Figurative trade mark, Representative.*

FACTS: The Office received a request for revocation of the registered CTM on the ground of non-use based on Article 51(1)(a) CTMR. The Cancellation Division upheld the request and revoked the contested CTM. The CTM proprietor appealed this decision and filed evidence of genuine use. In reply to the statement of grounds of appeal a written communication was filed by a representative on behalf of the cancellation applicant. The Registry of the Boards of Appeal invited the individual to file (a) an authorisation on his behalf, (b) evidence that he was an employee of the representative, and (c) evidence on an economic link between the representative and the cancellation applicant.

SUBSTANCE: The Board rejected the request for revocation as inadmissible because the cancellation applicant (with its seat in Hong Kong and an obligation to be represented before OHIM) was not duly represented. No evidence was received proving that the person signing the letters was a professional representative under the conditions of Article 93 CTMR, nor that he was an employee of a legal person having his or her seat in the EU and

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that that legal person had economic connections with the party to the proceedings under the conditions of Article 92(3) CTMR. In addition, no written authorisation according to Rule 76(2) CTMR was filed. The Board hence rejected the cancellation request as inadmissible because it was not filed by a person authorised to do so. The contested decision was annulled and the CTM remained registered without the need to take a decision on the merits of the cancellation request. The Board pointed out that the appeal decision should be notified to the cancellation applicant to its address in Hong Kong.

[Link to eSearch Case Law](#)

Decision of 20 October 2015 – R 938/2015-4 – IOPSYS / OPSIS; Language of the case: EN

RESULT: Appeal inadmissible.

KEYWORDS: *Admissibility, Complex mark, Figurative trade mark, Likelihood of confusion, Restriction of the list of goods and services, Statement of grounds.*

FACTS: An opposition was filed against a Community trade mark application on the basis of Article 8(1) (b) CTMR. The Opposition Division upheld the opposition and rejected the CTM application in part. The applicant filed a notice of appeal, which was followed by a writ stating that the applicant wished to restrict the list of goods and services.

SUBSTANCE: The Board found the appeal to be inadmissible under Article 60 CTMR and Rule 49(1) CTMR. With its statement of grounds the appellant/applicant merely sent a limitation of the list of goods and services, but not a statement giving specific reasons for the annulment of the contested decision. In particular, the applicant did not explain what effects such a limitation, if accepted, would have on the comparison of the goods and services and the merits of the opposition. The Board had to remain neutral and it was not the Board's duty or, even, right to make assumptions as to what the applicant wanted to achieve with the proposed limitation. A limitation to the list of goods and services is merely a procedural motion which the applicant for a CTM can make at any time in accordance with Article 43(1) CTMR.

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