

Alicante News

Up to date information on IP and OHIM-related matters



#CF300 - a milestone for the Cooperation Fund



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First Page

CF300 – a milestone for the Cooperation Fund

On December 16, 2014, the Cooperation Fund marked 300 implementations by national and regional IP offices of its tools and services.

The Cooperation Fund began operations following an extraordinary meeting of OHIM's Administrative Board and Budget Committee in 2010, and with a €50 million budget, is OHIM's largest single project to date.

The Fund is run in partnership with the EU national and regional intellectual property offices, all of whom play a vital role in developing its tools and services, which are designed to harmonise working methods at national and regional office level across the EU-28.

To date the Cooperation Fund has delivered 21 products and e-service solutions; all designed at the outset to be one-off activities, delivering clear benefits, with concrete outputs and defined start and delivery dates.

The projects were conceived around suggestions received from EU national and regional offices, and user groups. Those suggestions were coalesced into projects, each of which was supported by a working group made up of experts from the EU national and regional offices plus users and observers.

The Cooperation Fund tools support every part of the trade mark and design life cycle. They include free, online search tools like Designview; modernised back and front office systems for national offices, including e-filing for trade marks and designs; specialised tools designed for the enforcement community; quality standards tools to support the drive for greater user-centred quality across the EU national and regional offices which make up the European Trade Mark and



Design Network, and examiner support tools.

Over the past few months, the Fund has been on the move, across the EU, implementing e-filing tools and back office systems across the EU national and regional office network. On November 17, 2014, for example, the Finnish Patent and Registration Office began managing its national and international trade marks with the new Back Office system, becoming the first office to implement a full go-live with the tool.

The implementation was the rest of more than two years of team work among the two pilot offices for the tool – Finland and Poland. A further ten European IP offices have expressed their intention to implement the Back Office during 2015, which supports the management of the entire trade mark and design lifecycle in an IP office.

Equally, the Latvian and Greek office has recently implemented trade mark e-filing, while the Lithuanian, Spanish and Romanian offices all went live with design e-filing. The Slovenian office has implemented both in the past few months.

The achievement of 300 implementations has been a collective one. Over 300 IP experts, drawn from every EU national and regional IP office, plus user representatives, have worked alongside OHIM colleagues to develop and install the Fund's tools and services.

The Cooperation Fund is due to run until 2015, as initially planned at its inception. Currently a further 50 implementations, making a total of 350, are due to take place before it is wound up.



The James Norton Interview



Juan Vanrell, President, ASIPI

Tell me a bit about ASIPI?

The association was born in Mexico in 1964 so we are celebrating our 50th anniversary this year. The founding members started in Acapulco and they went to Mexico City to write the documents of association. This year our annual meeting is again in Mexico City, so in a sense we have come back to where we started.

In 1964 there was no IP association for the Americas. ASIPI was set up to cover all the countries from Canada in the north to Chile in the south, including the Caribbean islands. In 1964 the first meeting had 25 lawyers, who were all well-known lawyers at the time. There were at least four or five American lawyers representing some of the biggest US firms. We were following in the footsteps of associations such as AIPPI and FICPI that were much more well-established.

Are there particular issues in IP in the Americas?



Peter O'Byrne,

There have always been different topics in the north and the south of the world. I think the topics we were discussing in 1964 were very different to those being discussed in Europe and the US at the time. But today we are discussing the same topics as a lot of the associations that cover the whole world. At our conference this year we have speakers from AIPPI, AIPLA, ARIPO and INTA as well as important people like former Chief Judge Randall Rader from the United States. They are coming here to discuss topics with us.

We are observers in WIPO and we are trying to become one of the users groups represented at OHIM. I was at the meeting to mark the 20th anniversary of OHIM in Alicante in November and met the President and senior staff to discuss that. We want to see ASIPI at the heart of discussions about IP.

ASIPI is now very different compared to 10 years ago. We can talk face to face with all the worldwide IP associations. This year we have signed memorandums of understanding with ITechLaw, the John Marshall Law School and INTA. Now we have to follow up on these. With INTA, we have plans to build on the MoU in particular on an education programme. We have an education programme, ASIPI Educa, focused on kids aged five to 16 and we are working with INTA on their Unreal Campaign against counterfeiting.

Our education programme has been focused on: what is IP? What can you do or not? In the South, all the kids think you can download everything for free from the internet. We need to say: sometimes you have to pay for it. We have to fight for anti-counterfeiting and that starts with educating about what is IP.

Why does ASIPI want observer status at OHIM?

We have a lot of members in the Americas, but also beyond. In particular, we have members in Spain and Portugal so it will be good to be involved in discussions at OHIM and to be able to listen to the topics being discussed. A lot of those topics later come to America.



The James Nurton Interview



What do people in the Americas think about the CTM?

We really like the harmonisation of law. The only point that some people find difficult to understand is the economic asymmetry of countries. When you sign a treaty, you need to check the countries are symmetrical: Uruguay is not the same as Brazil. The conditions have to change depending on the country. It's very difficult to tailor all the treaties to accommodate that.

Would there ever be a CTM-style system in Latin America?

There is a regional cooperation group called PROSUR that is working towards something like that. But Europe has 3,000 years of history. We have only 500 years! It's very difficult to build something and it might be difficult for example for one country to accept that the office might be in another country.

What about services such as TMView?

We use that and we would like to help more countries join that system. Having centralised searches and databases is very useful for all of us. We all need information now, not in a week's time. Mexico is already part of TMView and I expect more offices from this region will join.

What's your background?

I have been involved with ASIPI since 2003 when I joined the Board – I was also the first non-US Treasurer of the association.

I began working in 1988 in an IP boutique law firm in Uruguay. I always specialised in IP. In March 2013 I started my own firm with some colleagues and fulfilled my dream of being my own boss!

I cover all areas of IP, but there is more trade mark work in Uruguay. We are not in the PCT yet – though we might be in the next one or two years. Five countries in Latin America are still not in the PCT: I think they will join eventually but it will probably depend on the politics. Undoubtedly the PCT would be a good thing in the long-term.

Latin American professionals must understand: the treaties

are coming so you must prepare for them. Don't fight that. I'm talking about the Madrid Protocol – it will come sometime – maybe one year, maybe five years, maybe 10. We need to be ready for that and perhaps we can learn from the experience of firms in Europe. We have discussed that in ASIPI.

ASIPI has a position on the Madrid Protocol, which we adopted in 1994. But since then the member states of the Protocol have changed a lot of rules, including introducing the Spanish language, so it has become more attractive for countries in the Americas. The US, Colombia, Mexico and Cuba have already joined and Canada is working on it so they have managed to adapt. We now have members on both sides.

Does your work mainly come from overseas?

In all Latin American countries, except Brazil, we receive more work than we send. I think that will probably continue to be the case for a while, but we are seeing a bit more work come from local clients.

What's been the most interesting case you have worked in during your career?

I worked on an interesting case for ZARA, the Spanish store. The company wanted to expand to Uruguay. But there was already a well-known mark for mate (tea) called SARA and they had a registration since 1920.

So ZARA had to buy all the marks except for those in international classes 29, 30, 31, 32 and 33 and we had a very interesting negotiation with a man who was Spanish and who owned the rights. The negotiations took about a year and during that time ZARA could not open in Uruguay. But it was finally resolved to everyone's satisfaction.

That case is typical of a more common problem that we are seeing. Say you have a trade mark in France that is very well known, and you want to expand in another country, but there is another mark there that is well known in that country. And then it becomes more difficult when you want to export to neighbouring countries. Until you have a proper international trade mark, these difficulties will always arise.



Community Trade Mark



OHIM's New Guidelines

During 2014, OHIM's vision of transforming its Manuals into a brand new set of Guidelines was fulfilled. The idea was to have a unique source of reference, updated on a regular basis by bringing together, in a systematic manner, the practice principles derived from the **case-law** of the European Court of Justice, the **jurisprudence** of OHIM's Boards of Appeal and the **decisions** of OHIM's operational departments. Work Package 1 (WP1) for 2014 was adopted in Decision of the President No EX-13-5, and Work Package 2 (WP2) was adopted by Decision of the President EX-14-1. WP1 is already available in all 23 languages of the European Union. WP2 is currently available in the 5 Office languages (English, French, German, Italian, Spanish) and is in the process of being translated into the remaining languages of the EU.

The work of the Office's Knowledge Circles, the teams of experts entrusted with keeping Office practice up-to-date, continued throughout 2014 with the review of the already adopted Guidelines in WP1.

That review process starts with the Knowledge Circle members analysing the **most recent case-law**, studying the conclusions of the **convergence projects** and taking into consideration the comments received from the Office's users, internal stakeholders and National IP Offices. As the next step, the Knowledge Circles draft the guidelines and discuss the texts amongst the various units and departments of the Office. The draft texts are sent for translation and published on the OHIM's dedicated webpage. Immediately after the publication, OHIM informs all the National IP Offices and the users' associations and they are all given several weeks to send their feedback on the draft texts. All comments are sent to the relevant Knowledge Circles for consideration. The changes

resulting from this consultation process are introduced into the texts and translated and then presented at the ABBC in May and November each year. The President then adopts them in a Decision of the President.

The WP1/2015 review process has now been completed. All of the Parts, Sections and Chapters of the Guidelines contained in WP1 have been reviewed by the Knowledge Circles, approved by internal and external stakeholders and adopted by the President in Decision EX-14-4. **They will enter into force on 01/02/2015.**

Parts of the Guidelines contained in WP1/2015

COMMUNITY TRADE MARK:

Part B: Examination

Section 2, Formalities

Section 4, Absolute Grounds for Refusal 7(1)(a)

Section 4, Absolute Grounds for Refusal 7(1)(b)

Section 4, Absolute Grounds for Refusal 7(1)(c)

Section 4, Absolute Grounds for Refusal 7(1)(d)

Section 4, Absolute Grounds for Refusal 7(1)(e)

Section 4, Absolute Grounds for Refusal 7(3)

Part C: Opposition

Section 0, Introduction

Section 1, Procedural Matters

Section 2, Double identity and Likelihood of confusion

Chapter 1, General Principles and Methodology

Chapter 2, Comparison of Goods and Services

Chapter 3, Comparison of Signs

Chapter 4, Distinctiveness

Chapter 5, Dominant character

Chapter 6, Relevant public and degree of attention

Chapter 7, Other factors

Chapter 8, Global assessment

Section 6, Proof of Use



Community Trade Mark



Part E: Register Operations

Section 2, Conversion

Section 4, Renewal

Section 5, Inspection of files

Section 6, Other entries in the Register

Chapter 1, Counterclaims

REGISTERED COMMUNITY DESIGN

WP1

Examination of Design Invalidity Applications

General changes

All changes made appear in legal blackline so our users can easily see what has been updated.

In general the changes concern modifications to the format and structure, updated case-law and cross-references, corrections of errors and clarifications in wording.

Change in practice

Translations of the CTM application submitted by the applicant

This practice change concerns translations of the CTM application into the second language that are submitted by the applicant on its own motion. The Office will not check the accuracy of these translations. It is the applicant's responsibility to ensure that the translation corresponds to the first language. Furthermore, the Guidelines give now guidance on partial translations of multilingual elements. Where the applicant does not remedy the deficiency and does not provide a complete translation, the Office will disregard the partial translation.

This change in practice is reflected in:

- Part B: Examination. Section 2. Formalities.

Corrections of mark types done by OHIM

OHIM will correct indications of the mark type that are clearly wrong or where there is an obvious contradiction between the selected mark type and the submitted representation of the mark.

This change in practice is reflected in:

- Part B: Examination. Section 2. Formalities.

Scope of protection of black and white trade marks

Originally a fast-track change which came into force on 02/06/2014, this change in practice has now been approved by our internal and external stakeholders and adopted by the President. The change in practice comes as a result of the outcome of a convergence project (CP4).

In the framework of the European Trade Mark and Design Network, the Office and a number of Trade Mark Offices in the European Union have agreed on a common practice with regard to the scope of protection of earlier B&W or greyscale marks.

These conclusions affect the assessment of the identity of trade marks in priority and relative grounds for refusal as well as the assessment of genuine use of trade marks registered in B&W or greyscale but used in colour (or vice-versa).

The offices have concluded that, a trade mark filed in black and white, for the purposes of assessing priority, is not identical



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to the same mark filed in colour unless the differences in colour are so insignificant that they could go unnoticed by the average consumer.

An insignificant difference between 2 trade marks is one that a reasonably observant consumer will perceive only upon examination of the marks side by side.

The change in practice has been implemented in the chapters of the guidelines relating to:

- Part B, Section 2. Formalities: in the assessment of the identity of the marks for priority (practice also extended to seniority claims)
- Part C. Section 2. Chapter 3 Comparison of the signs: where in relation to the examination of the identity of the marks, a new paragraph has been included to explain the practice when comparing an earlier black and white mark with a colour mark application
- Part C. Section 6. Proof of use: where in relation to whether the use of a mark in colour, while being registered in black and white (and vice-versa), alters the distinctive character of the mark.

Maximum duration of suspensions due to negotiations

The maximum duration of a suspension due to ongoing negotiations has been limited to three years.

The change in practice is reflected in:

- Part C: Opposition. Section 1. Procedural Matters.

Admissibility of belated evidence in Proof of Use

Another fast-track change that came into force on 02/06/2014, and that has now been adopted by the President concerns a change in practice following judgments C-621/11P 'Fishbone' and C-610/11P 'Centrotherm'.

Fishbone and Centrotherm had been on the OHIM's radar for a while, awaiting the outcome of the case before the Court of Justice. With the Fishbone judgment we now have a clear trend that establishes that under certain circumstances, additional evidence submitted after the deadline for filing evidence of genuine use have to be taken into account and the Office has modified its practice accordingly.

The Guidelines on opposition proceedings clarify in which cases additional evidence may be filed at the Office even after the expiry of the corresponding time limit namely:

1. When already relevant evidence has been sent within the time limit
2. When the additional evidence merely strengthens and clarifies the prior relevant evidence submitted within the time limit.

For the time being only the additional evidence in the field of proof of use has been dealt with.

The change in practice is reflected in:

- Part C: Opposition. Section 1 Procedural Matters.
- Part C: Opposition. Section 6 Proof of use.

Contested goods and services in cancellation proceedings

A practice change has been introduced concerning the contested goods and services. Should the applicant direct its





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application for cancellation against a part of the goods and services of the CTM, only one round will be granted to clearly list these. In case the applicant does not respond appropriately the application will be rejected as inadmissible.

The change in practice is reflected in:

- Part D: Cancellation. Section 1. Proceedings.

Other clarifications of practice

As mentioned above, all changes are reflected in legal blackline in the relevant sections of the Guidelines published [here](#) and [here](#). However, certain sections of the guidelines have seen substantial changes, which, whilst not resulting in a change in practice as such, are certainly worthy of mention:

Part B. Examination

Correspondence language

The Guidelines now clarify that the correspondence language cannot be changed to the second language of the CTM application once the Office has issued a deficiency or objection letter in the first language

Pattern marks

Pattern marks are now dealt with under figurative marks.

Colour per se marks

The requirements for colour per se marks have been clarified.

These clarifications are reflected in:

- Part B: Examination. Section 2. Examination of Formalities.

Assessment of the descriptive character

In relation to the assessment of the descriptive character in Absolute Grounds examinations, a number of issues have been developed or newly introduced. For instance, the question of the assessment of the descriptive character in languages other than EU official languages.

Combination of words

Further guidance is given in respect of 'combination of words'. As regards the examination of figurative marks, some examples taken from the work done so far in the context of the CP3 convergence project have been incorporated in the Guidelines. A new section on the assessment of TMs consisting of names of hotels or banks has been introduced. Finally, the practice on TMs consisting of the name of a place and a year has been clarified

Length of use

The section on 'length of use' in Article 7(3) has been modified to cover exceptional cases where distinctiveness is acquired in a very short period of time

These clarifications of practice are reflected in:

- Part B: Examination. Section 4 Absolute grounds for refusal. Subheading 2.3
- Part B: Examination. Section 4 Absolute grounds for refusal. Subheading 2.6.8.9.



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Part C. Opposition

Suspension

The whole paragraph on suspension has been re-drafted to improve its structure and content.

Time limits

Case law on time limits has been introduced and it is clarified that a request for extension must be filed and received before the original time limit expired.

These clarifications are reflected in:

- Part C: Opposition. Section 1. Procedural Matters.

Substance

Some wording has been clarified to further explain current practice in certain areas.

Further guidance has been given in relation to the correct application of the CANON criterion "complementarity" when comparing goods and/or services. Also more practical and present-day explanations are given in relation to the Information Technology industry.

In relation to Distinctiveness, the text has been clarified regarding the dissection of trade marks into components (to avoid artificial splits), allusive trade marks (does not always affect distinctiveness), the Office practice on the distinctiveness of single letters and the consequence of disclaimers. Moreover, the description of some of the examples has been revised.

In relation to the Definition of the Relevant Public and its

degree of attention, the section has been restructured and revised to avoid inconsistent use of different concepts. A distinction between a general public or public at large and a professional or specialised public (or business consumers) is pointed out and presented in a graphic. As regards the section on definition of the degree of attention, the introduction has been substantially modified in order to make clear the factors that should be taken into account when defining the degree of attention and the impact on likelihood of confusion.

In relation to Other factors, the section on "Family of marks" has been thoroughly revised although there is no change of practice, and regarding the "coexistence of the conflicting marks on the market in the same territory", the paragraph regarding the effect of private agreements between the parties has been deleted as it was considered that the effects of such agreements require a case-by-case approach.

In relation to the Global Assessment and the impact of the conceptual similarity of the signs on likelihood of confusion, it has been long-standing practice that mere conceptual similarity (that is based on analogous semantic content of the signs) can only lead to a likelihood of confusion with proof of enhanced distinctiveness. It has been clarified, in accordance with case-law, that there may be a likelihood of confusion even in the absence of a claim or proof of enhanced distinctiveness, if the signs have the same (not merely similar, analogous) distinctive concept in common, if accompanied by visual similarities between the signs. References to T-81/03, T-82/03 and T-103/03 'VENADO' and T-183/02 and T-184/02 'MUNDICOR' have been added.

In the part on single letter marks and two-letter combinations, the wording has been clarified without any change of practice. In particular, the impact of the enhanced distinctiveness of



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the earlier trade mark (single letter) will have to be carefully assessed.

On names/surnames, the explanations in the examples have been clarified in order to focus on the relevance of the distinctiveness of names. Moreover, the example "elite by MONDARIZ" has been removed from the Guidelines.

This section also implements the Common Practice on the impact of weak or non-distinctive components on likelihood of confusion agreed by the Office and a number of Trade Mark Offices of the European Union (CP5).

Finally, in relation to Proof of use, regarding the use as a mark and following decisions from the Boards of Appeal, the cases of Certification marks and of Protected Geographical Indication/Protected Denomination of Origin have been added as further examples where the sign is not used a trade mark. Moreover, some case-law has been added also in relation to the use made by intermediaries (and not end users) to clarify that such use may satisfy the requirement of use made publicly and outwardly.

In relation to the use of a mark in form different from that as registered, the judgments C-12/12 "Levi's" and C-252/12 "Specsavers" have been added to clarify that the distinctive character may not be altered even when a mark is used in conjunction with another one (as part of it or superimposed to it) and this combination is itself registered as a mark.

Some amendments and additions of examples from the case-law have been made in relation to import/export sales and acceptable or unacceptable additions or omissions (Herba Shine, VILLA ALBERTI). Examples have been replaced by others, deemed to be more appropriate (FANTASIA/HALDER, CASTILLO PERELADA/PELASPAN PAC, CLOREX/ROYAL, WEEK END/TAVERNA).



These clarifications of practice are reflected in:

- Part C: Opposition. Section 2. Chapter 2 Comparison of goods and services
- Part C: Opposition. Section 2. Chapter 4 Distinctiveness
- Part C: Opposition, Section 2. Chapter 6 Relevant Public and Degree of Attention
- Part C: Opposition. Section 2. Chapter 7 Other factors
- Part C: Opposition. Section 2. Chapter 8 Global Assessment
- Part C: Opposition. Section 6. Proof of use

Part D. Cancellation

The wording of the examples for absolute admissibility deficiencies has been improved, especially the example for res judicata.

This clarification of practice is reflected in:

- Part D: Cancellation. Section 1. Proceedings

Part E. Register operations

The Section on Inspection of Files has been completely updated to include all aspects of the practice for inspecting Community Designs files and requesting certified or uncertified copies of file documents, register extracts or registration certificates.

These clarifications of practice are reflected in:

- Part E: Register Operations. Section 5. Inspection of files



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REGISTERED COMMUNITY DESIGNS

Examination of Design Invalidity Applications

Compliance with time limits

Clarifications have been provided as to how the Office will deal with confirmation copies in cases where the party originally filed submissions by fax.

Facts, evidence and arguments

Clarifications have been provided as to which types of documents the Office will accept when it comes to the substantiation of the earlier rights.

Not a design

Clarifications have been provided as to how the Office will deal with designs which do not correspond to the definition of a design under Article 3(a) CDR (living organisms, ideas and methods of use).

Disclosure of prior design

Clarifications have been provided of the interpretation of the notion of the circles specialised in the sector concerned.

Individual character

Clarifications have been provided on the notion of informed user.

These clarifications of practice are reflected in:

- Examination of Design Invalidity Applications. Paragraph 2.4
- Examination of Design Invalidity Applications. Paragraph 3.9.2
- Examination of Design Invalidity Applications. Paragraph 5.1
- Examination of Design Invalidity Applications. Paragraph 5.5.1
- Examination of Design Invalidity Applications. Paragraph 5.5.2.3



Registered Community Design

Judgment of the Court of Appeal of Paris of 05/12/2014, 14/03506, 'Forks'

his judgment rules on the appeal against the decision of the High Court of Paris of 17/01/2014, 11/11393 in relation to the infringement of two Community designs, namely Community design No 001647769-0001, as represented in the four views below (figs 1.1 to 1.4), and Community design No 001647769-0002, as represented in the two views below (figs 2.1 and 2.2), hereinafter referred to as RCDs.

The RCDs were registered and published in 2009 in the name of the company EUROPLASTIQUE. In April 2011, EUROPLASTIQUE brought an action before the High Court of Paris, claiming infringement of its Community design rights by the company GERMAY PLASTIC. According to EUROPLASTIQUE, GERMAY PLASTIC manufactured, offered for sale and marketed plastic forks for pasta dishes (images not available), which were identical to the forks protected by the two registered Community designs.

The High Court found EUROPLASTIC's RCDs to be valid and that the GERMAY PLASTIC forks were infringing EUROPLASTIC's rights. GERMAY PLASTIC appealed, claiming that the RCDs should be declared invalid.

In the counterclaim, GERMAY PLASTIC challenged the validity of the RCDs on the grounds of Article 25(1)(b) Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (CDR) for non-compliance with the novelty and individual character requirements of Articles 5 and 6 CDR and on the grounds of being excluded from protection because some features of the RCDs' forks were solely dictated by technical function, as stipulated in Article 8(1) CDR. GERMAY PLASTIC relied on several designs from prior art as shown below. It mainly argued that the informed user of cutlery marketed together with processed food does not pay close attention to the utensils attached to the food and, therefore, the cited



prior art constitutes an obstacle to the novelty and individual character of the RCDs.

The High Court upheld the first instance decision. In the judgment it:

- rejected the undated drawings and technical sheets for 'fork-spoon' and 'fork spatula' developed by the SODEBO company, supported by the statement of the company's purchase manager, as insufficient evidence of the earlier disclosure of these designs;
- held that the RCDs' characteristic feature of profile symmetry between the ends of the forks and the curved portion at the other end, did not form part of the prior art;
- defined the informed user as any buyer of pasta dishes sold with a fork;
- confirmed that GERMAY PLASTIC had failed to prove that the forks contained features dictated by their technical function; it stated that there were many plastic forks on the market, foldable or not, from which the RCDs differ in both effect and appearance;
- ruled that, like the RCDs, the infringing forks had four teeth, an almost unvarying handle width and a slightly rounded tip designed as an extension of the handle, and that the variance of the handle thickness was not likely to produce the same overall impression as the RCDs, therefore the forks infringe EUROPLASTIQUE's designs;
- summarised that the damage amounted to EUR 20 775, for 559 200 marketed products and 271 875 stocked GERMAY FORKS in 2011, multiplied by the unit price of EUR 0.025.



Registered Community Design



Registered Community designs:

001647769-0001

001647769-0002



1.1



1.2



2.1



1.3



1.4



2.2



Registered Community Design



Prior art:

US D535 857

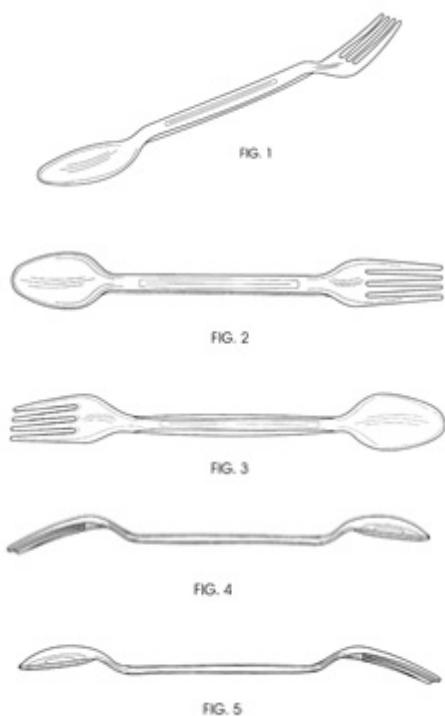
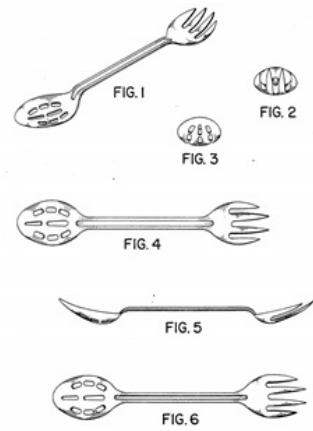


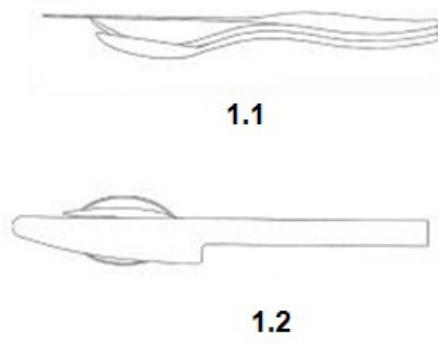
FIG. 6

FIG. 7

US Des. 325,855



RCD 000005517-0001



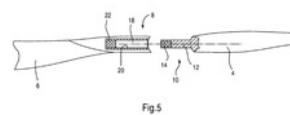
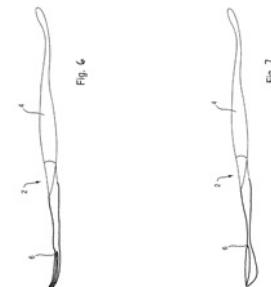
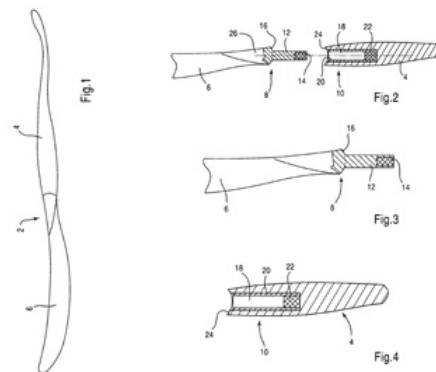
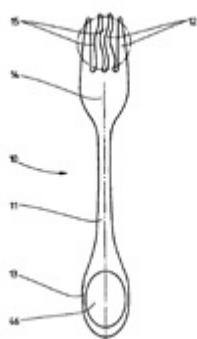
1.2



Registered Community Design



DE 298 11 134 U1



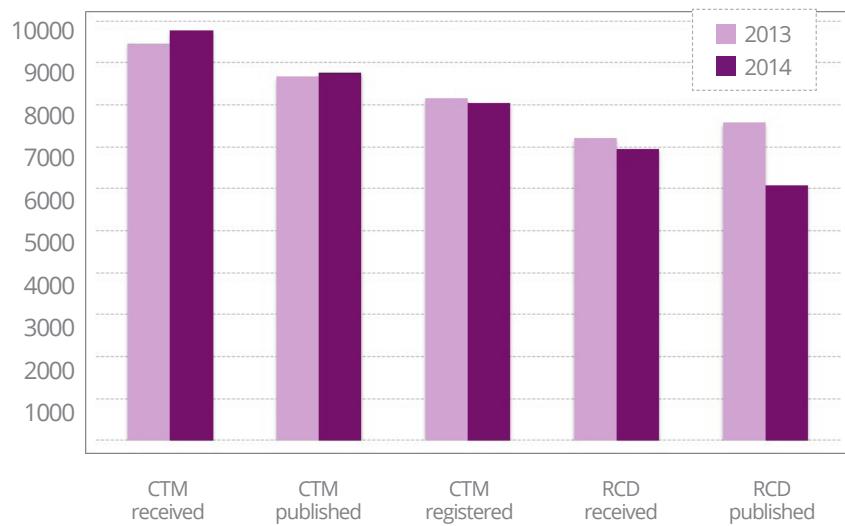


Statistical Highlights



Monthly statistical highlights November*	2013	2014
Community Trade Mark applications received	9 447	9 780
Community Trade Mark applications published	8 665	8 773
Community Trade Marks registered (certificates issued)	8 165	8 043
Registered Community Designs received	7 211	6 958
Registered Community Designs published	7 572	6 078

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





ETMDN Updates

More Designview implementations – inside and outside the EU

On December 8, 2014, the Danish Patent and Trademark Office (DKPTO), the Mexican Institute of Industrial Property (IMPI), the Moroccan Industrial and Commercial Property Office (OMPIC), the Norwegian Industrial Property Office (NIPO) and the Federal Service for Intellectual Property of Russia (Rospatent) all made their design data available to the Designview search tool.

The next day, December 9, 2014, the Austrian Patent Office (ÖPA) followed suit, and on December 15, the Korean Intellectual Property Office and the Irish Patents Office became the newest members of the Designview club.

DesignView is the largest free search tool for registered designs available. With KIPO and IPO on-board, there are now 26 participating offices in DesignView. And with the addition of more than 840,000 Korean designs and almost 2,000 Irish designs, DesignView now provides information and access to about 3.6 million designs in total.

Since its introduction on 19 November 2012, the tool has served more than 800,000 searches from 135 different countries, with users from Spain, Germany and the UK among the most frequent visitors.



Cooperation Fund technical handover meeting in OHIM

Throughout the first week of December, technical experts from the EU national and regional IP offices met at OHIM's headquarters in Alicante for the Cooperation Fund Technical Handover meeting.

The meeting came in the context of the Cooperation Fund's maintenance model, which will see maintenance of the tools and services in the programme passing directly to the national and regional IP offices.

The week long session also gathered OHIM's network of deployed project managers and deployed developers, who are based in the national and regional IP offices.



More News

Update of the performance achieved by OHIM.

OHIM has published the results of its services during the third quarter of 2014, in terms of timeliness, quality and accessibility.

Overall timeliness of operations is improving even though the number of filings is increasing. Accessibility also reached very high levels of effectiveness during the second quarter.

The e-filing rates have all improved as regards to the first quarter, reaching almost 90% in eRCD, compared to below 85% at the end of the first quarter.

Opposition admissibility timeliness keeps improving as the result of the decline in opposition filing, as well as the notification of Opposition decisions which on average improved from 8 to 4 weeks in the second quarter. The quality of those decisions is also closely monitored and the co-signing process has been revised to guarantee that the quality is maintained and shortly improved.

The timeliness of the notification of Cancellation decisions also shows a strong improving trend, moving from 26 weeks by the end of 2013 to 12 weeks nowadays, maintaining the highest level of quality just over 95% for the second consecutive quarter.

Regarding Appeals, the trend keeps improving, showing that the Inter Parte cases are now settled in 10 months maximum. For any comment or suggestions, please contact the Corporate Governance Service at CGS@oami.europa.eu.



TM5 meeting in Tokyo

The annual Trade Mark 5 (TM5) meeting was held in Tokyo, Japan from December 3-5.

The TM5 is the name given to the group which includes OHIM, the United States Patent and Trademark office (USPTO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO) and the State Administration for Industry and Commerce of the People's Republic of China (SAIC).

Together the five offices are responsible for 60% of the world's internationally filed trade marks.

The three day meeting involved parallel trade mark and design sessions. In the trade mark sessions, the partners presented the overview and next steps of their respective leading projects.

Among 12 on-going projects, OHIM reported the current status of "Common Statistical Indicators", "User-friendly Access to Trade Mark Information (TMview)" and "Taxonomy and TMclass link" projects.

The design sessions included OHIM's report on the "View and Drawing Requirements for Designs" project among other topics of mutual interest.

Webinar – eSearch Case Law

On December 16, OHIM held a webinar on its case law database.

eSearch Case Law features OHIM's decisions, judgements of the General Court, the Court of Justice and national courts.

A recording of the webinar will be made available shortly via the OHIM Academy Learning Portal



Case law

Luxembourg trade mark and design news

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

Cases C-581/13 P + C-582/13 P, Intra-Press SAS + OHIM v. Golden Balls Ltd, Judgement of 20 November 2014, Language of the case: EN

RESULT: Partially upheld (General Court judgment partially annulled).

KEYWORDS: Claim for rejecting opposition, Claim for alteration of OHIM decision, Conceptual similarity, Detriment to earlier mark, Distortion of facts, Essential element to be translated, Lack of reasoning, Phonetic dissimilarity, Relative grounds, Relevant language, Reopening of OHIM first instance proceedings, Reputation, Similarity of the goods and services, Unfair advantage, Visual dissimilarity.

FACTS: The CTM applicant filed two CTM applications to register the word sign **GOLDEN BALLS** in relation to various goods and services. Two oppositions were filed based on Article 8 (1) (b) and Article 8 (5) CTMR. The Opposition Division (OD) rejected both oppositions, finding there was no similarity between the signs and no likelihood of confusion. The Board of Appeal (BoA) overturned that finding: the signs were deemed to be similar overall and likelihood of confusion was found in relation to identical or similar goods (Para. 15). However, the BoA did not consider the opponent's argument on the reputation of its earlier CTM under Article 8 (5) CTRM and did not conduct the required assessment in relation to dissimilar goods. The General Court (GC) annulled the BoA's decisions and found the signs globally dissimilar: even for goods which are identical, the weak, or very weak, conceptual similarity between the

signs, which requires a prior translation, cannot suffice to compensate for the visual and phonetic dissimilarities (Para. 58). The opponent filed before the European Court of Justice (CJ) an action based on 3 pleas in law.

CTM 1
GOLDEN BALLS
CTM 2
GOLDEN BALLS
Earlier TM
BALLON D'OR

SUBSTANCE: The CJ partially upheld the appeals and remits the case to the Office to examine the opposition under Article 8 (5) CTMR.

(I) distortion of the facts in the assessment of the abilities of the relevant public (including the average francophone consumer) to understand English

The CJ rejected the ground of appeal as being inadmissible: it is not obvious from the documents that the GC distorted the opponent's position concerning the average level of knowledge of the English language among French-speaking consumers (Para. 40).

(II) infringement of Article 8 (1) (b) CTMR

Firstly, the CJ rejected as being manifestly unfounded the arguments on the incorrect assessment of the relevant public (Para. 55): it does not emerge from the judgements that the relevant public was limited to the average French-speaking consumer by the GC (Para 47-52), the GC did not fail in its duty to state reasons since it analysed the signs, justified the assessment of conceptual dissimilarity, considering the public's perception (Paras. 53, 54).

Secondly, the CJ dismissed the arguments concerning the significance placed on the prior translation for the purpose of





Case law

assessing the conceptual similarity of word marks which are in different languages: this is an attempt to request the CJ a re-examination of the factual assessment conducted by the GC (Paras. 61-63).

Thirdly, the CJ rejected the argument about the incorrect assessment of the distinctiveness of the earlier mark, considering that it was based on an incorrect reading of the GC's decision: the GC took into account the distinctiveness of the opponent's trademark, concluding that "in any event" a higher distinctiveness would not have affected the overall assessment of the likelihood of confusion on the relevant public (Paras. 64-67).

(III) *Infringement of Article 8 (5) CTMR*

The CJ, endorsing the arguments raised by the opponent, held that the GC erred in ruling out the application of Article 8 (5) CTMR since it did not exclude that the marks at issue were similar enough for them to be linked: a low degree of conceptual similarity was found (Paras. 75-78).

(IV) the action at First Instance

The CJ remits the case for the Office to examine the opposition under Article 8 (5) CTMR (Paras. 82-85).

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

Joined Cases T-303/06 RENV and T-337/06 RENV; (referred to the General Court (GC) by the European Court of Justice (CJ) in Case C-0317-10P) UniCredit SpA v OHIM, Judgment of 25 November 2014, Language of the case: IT.

RESULT: Actions dismissed

KEYWORDS: Relative grounds, Likelihood of confusion, Likelihood of association, Series of trademarks, Similarity of the goods and services, Complementary goods and services, Nature of the goods and services, Purpose of the goods and services, Similarity of signs, Visual similarity,



Phonetic similarity, Conceptual similarity, Distinctive element, Principle of legality

FACTS: The applicant sought to register the word marks represented below as CTMs for services within Class 36 (these being 'banking business; financial affairs; monetary affairs; insurance; real-estate affairs; financial and insurance consultancy and information; credit/debit card services; banking and financial services via the Internet' for UNIWEB and 'banking business; financial affairs; monetary affairs; assurance; real-estate affairs; financial information' for UniCredit Wealth Management). The opponent filed two oppositions based on the three earlier German word marks represented below and registered for 'placement of funds' in Class 36. The opponent also invoked the existence of a family of marks in Germany, all characterized by the initial element 'UNI' and all used to distinguish 'placement of funds'. The ground invoked was based on Article 8 (1) (b) CTMR. The Opposition Division upheld the oppositions in respect of all of the contested services with the exception of 'real estate affairs', which were considered to be dissimilar to 'placement of funds'. The Board of Appeal (BoA) dismissed the appeals filed by the opponent and the applicant, respectively. The applicant filed two actions before the General court (GC). By a first judgment, the GC annulled the BoA's decisions, holding that the latter had erred by not properly assessed the issue of the family of marks and by finding that, given its lack of distinctive character, the common element 'UNI' could not trigger in the consumers' minds an association between the contested applications and the opponent's family of marks. Following an action lodged by the opponent (and supported by the Office with a cross appeal), the European court of justice (CJ) annulled the GC's judgments, holding that the latter had erred in law in the application of Article 8 (1) (b) CTMR. The CJ remitted the cases to the GC for a new assessment (C-0317/10P).



Case law



CTMAs

UNIWEB

UniCredit Wealth Management

Earlier German marks

UNIFONDS

UNIRAK

UNIZINS fig.

SUBSTANCE: the GC dismissed the actions filed by the applicant and confirmed the BoA's decisions to the extent that it upheld the oppositions for all of the contested services with the exception of 'real estate affairs'. The relevant public consists of the German consumer of financial services, whose level of attention is above average (Para. 48). The services (with the exception of 'real estate affairs') are similar and this has not been disputed by the applicant. The signs are also similar to a certain degree, to the extent that they all consist of the initial element 'UNI' followed by descriptive or non-distinctive terms such as RAK, FONDS and ZIN (all meaningful in German when it comes to the opponent's services 'placement of funds' or 'Wealth', 'Management' and 'Web', the use of English being widespread in the financial sector (Para. 53). The signs present a certain similarity also on a conceptual level, given their highly similar structure (Para. 54). Turning to the issue of the family of marks, the GC recalled the established Case-Law, in particular the judgment in Bainbridge (C-234/06), and held that the opponent had proven the use of a family of marks on the German market of 'placement of funds'. Contrary to what had been argued by the applicant, the opponent was not required to prove that the German consumers would perceive

the earlier marks as forming a family of marks (Paras. 65-66). Although the three earlier marks on which the opponent expressly relied are limited in number, they are sufficient to consider that they form a family of marks (Para. 74). The fact that the conflicting signs have a common structure and that the common element 'UNI' is placed at the beginning is sufficient to trigger a link in the consumers' minds between the contested applications and the opponent's family of marks (Paras. 80-81), also considering that the common element 'UNI' has a certain degree of inherent distinctiveness when it comes to financial services, as it does not refer to specific characteristics of the latter (Paras. 84-87). The finding that 'UNI's is distinctive is also supported by decisions rendered by the German Patent and Trademark Office and by judgments rendered by German Courts, which had been relied upon by the opponent. The GC confirmed that both the parties to a procedure and the GC can refer to national Case-Law when interpreting European law (Para. 91). The GC, recalling the principle of legality, dismissed the argument of the applicant that the Office itself would have denied, in certain decisions, the inherent distinctiveness of the element 'UNI'. The GC noted that decisions of the Office do not reflect a uniform approach, and that there is a significant number of decisions where the distinctiveness of 'UNI's has been acknowledged (Para. 97). However, the GC dismissed the opponent's argument that 'placement of funds' and 'real estate services' would be similar. It found that they differ in terms of their nature and intended purpose, and that they are neither in competition nor complementary. In this respect, the GC dismissed the opponent's argument that, to the extent that 'placement of funds' also covers those funds that specialize in real estate, there would be a clear link, and similarity, between these services (Paras. 109-116). Finally, and in relation to an argument that had been raised, the GC acknowledged that, due to the context of financial crisis, there is a certain tendency among banks to operate also in markets adjacent to the financial one, including real estate. However, since the opponent had not proven that this tendency is well-established and that consumers would find it usual that banks



Case law



also offer real estate services, the existence of such a tendency cannot be taken into account when it comes to comparing the services (Para. 118).

Case T-10/09 RENV; Formula One Licensing BV v. OHIM (F1-Live / F1 et al.); Judgement of 11 December 2014; Language of the case: EN

RESULT: Action upheld (Board of Appeal decision annulled)

KEYWORDS: Likelihood of confusion, Dominant element, Distinctive element, Relative grounds, Competence of the Boards, Common element, Abbreviation, Reputation, Similarity of signs

FACTS: The Board of Appeal (BoA) had dismissed the opposition under Article 8 (1) (b) CTMR on account of the differences between the signs and the intrinsic descriptiveness of the word mark "F1". The opposition was dismissed under Article 8 (5) CTMR because there cannot be any of the misconducts envisaged by this provision where the signs only coincide in a descriptive element that is, the word element "F1". In its first judgment, the General Court (GC) confirmed that the common element 'F1', taken to mean racing cars and by implication car races, is perceived as a descriptive element denoting the subject of the printed matters and telecommunications services covered by the mark applied for, this element alone cannot be interpreted as a reference to a commercial origin and thus cannot lead to a risk of confusion (GC, Judgment of 17 February 2011, Case T-10/09, Formula One Licensing BV / OHIM, (F1-LIVE / F1), paras 46-50 and 57).

On appeal, the European Court of Justice (CJ) did not deny that the Office must 'verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign'. However, the Office exceeds its

competence where it characterises an earlier mark as being descriptive or generic since this is equivalent to denying it any protection. It is therefore necessary to acknowledge a certain degree of distinctiveness of an earlier national mark on which an opposition against the registration of a Community trade mark is based. The CJ thus annulled a GC judgment which excluded any risk of confusion between the earlier word mark 'F1' and the figurative CTM application 'F1-Live' on account of the purely descriptive nature of the common element of the signs in respect of printed matters and telecommunication services. By doing so, the GC called into question the validity of the earlier trade mark and therefore infringed Article 8(1) (b) CTMR (CJ, 24 May 2012, Case C-196/11 P, Formula One Licensing BV / OHIM, (F1-LIVE / F1), para. 41-44 and 49-52). The case was remitted to the GC.

CTMA

Earlier marks

SUBSTANCE: The GC observes that the 'f1' word element is the usual abbreviation of the expression 'Formula 1'. This common element has therefore a weak distinctive character (para. 38). Moreover, this element is not dominant in the CTMA which forms a complex sign and which will be perceived visually as



Case law

a whole (para. 39). The reputation claimed in respect of the earlier marks is in fact limited to the earlier figurative mark (para 40 and 48). The elements of differentiation do not totally outweigh the similarity resulting from the common element 'F1' (para. 45), which is not negligible in the CTMA (para. 51). The GC establishes LOC on account of the fact that the combination of the word 'Live' with the word 'f1' "helps to anchor in the mind of the relevant public the image of Formula 1 motor racing conveyed by that word element" (para. 51). Because the F1 mark is reproduced identically, the public will interpret the mark applied for as a variant of that earlier mark and, accordingly, as having the same commercial origin (para. 52).

Case T-450/09; Simba Toys GmbH & Co. KG v OHIM (Cubes); Judgment of 25 November 2014; Language of the case: EN

RESULT: Action dismissed.

KEYWORDS: Three dimensional mark, Absolute grounds, Shape of the products, Substantial value, Technical result, Examination of facts ex officio, Distinctive element, Lack of reasoning, Descriptive element, Competence of the Boards

FACTS: The 3D sign reproduced below was registered for goods in Class 28 (three-dimensional puzzles).

A request for a declaration of invalidity pursuant to Article 52(1) (a) CTMR in conjunction with Article 7(1)(a) to (c) and (e) CTMR was filed. The Cancellation Division rejected the application for a declaration of invalidity in its entirety. The Board of Appeal (BoA) dismissed the appeal against the decision of the Cancellation Division as unfounded finding that (i) the contested mark was adequately graphically represented; (ii) there were no manifest reasons to consider the cubical grid structure not distinctive; (iii) the invalidity applicant had not adduced significant evidence that a cubic grid structure constitutes a "norm" in the sector of 3D puzzles; (iv) 'the



cubic grid structure' gives no indication as to its function, it is impossible to conclude that it may impart some technical advantage or effect in the domain of 3D puzzles and it cannot be considered that the shape results from the nature of the goods themselves; and (v) a mere cubic grid as depicted in this case cannot be deemed to possess a shape which gives substantial value to the goods. The invalidity applicant filed an action before the General Court (GC) relying on eight pleas in law.



SUBSTANCE: The first plea alleging the infringement of the First sentence of Article 76(1) CTMR was rejected as unfounded. Firstly, although the invalidity applicant alleged a procedural violation, it seeks more to call in question the merits of the substantive assessment by the BoA (para. 19). Secondly, in invalidity proceedings, even when they relate to absolute grounds, the BoA is not required to examine of its own motion the facts. Even though the BoA cannot be prevented, if it considers it necessary, from taking into account of its own motion any matter relevant to its analysis, there was no such necessity in this case (Para. 25). By the second plea the invalidity applicant alleged infringement of Article 7(1)(e)(ii) CTMR. In this regard, the GC recalled that the examining authority must first of all identify the essential characteristics (i.e. the most important elements) of the sign. This identification may be either carried out by means of a simple visual analysis of the sign or based on a detailed examination in which relevant criteria of assessment are taken



Case law

into account, such as surveys or expert opinions, or data relating to intellectual property rights conferred previously in respect of the goods concerned (para. 38 and 40). Further, the GC reiterated that Article 7(1)(e)(ii) cannot be applicable where the trade mark application relates to a shape of goods in which a non-functional element, such as a decorative or imaginative element, plays an important role (para. 41). The grounds for invalidating a 3D trade mark pursuant to Article 7(1)(e)(ii) must be founded only on the examination of the representation of the mark as filed and not on any alleged or supposed invisible features (Para. 49). It is necessary to establish in order to apply the Article 7(1)(e)(ii) that the essential characteristics of the mark at issue themselves perform the technical function of the goods at issue and have been chosen to perform that function (i.e. the shape of the goods is technically causal of the intended technical result), and not that those characteristics are the result of that function (Para 53). The cube in question, contrary to invalidity applicant's claim, will not necessarily be perceived as having elements capable of being moved in the alleged way (Para. 57). The invalidity applicant's line of argument is based on knowledge of the rotating capability of the vertical and horizontal lattices of the Rubik's Cube. However, it is clear that that capability cannot result from the black lines in themselves or, generally, from the grid structure which appears on each surface of the cube in question, but at most from a mechanism internal to that cube, which is invisible on the graphic representations of the contested mark and which cannot constitute an essential characteristic of that mark (Para. 58). Accordingly, although the BoA cannot be prevented from drawing inferences for the purpose of its analysis of the functionality of the essential characteristics of the contested mark, it is still necessary that those inferences be drawn as objectively as possible from the shape in question, as represented graphically, and that they not be purely speculative, but sufficiently certain (Para. 59). It was not the intention of the legislature that a shape of goods would be refused registration as a trade mark solely on the ground that it has functional characteristics since any shape of goods is,



to a certain extent, functional (Para. 60). The contested mark may not be relied on by its proprietor in order to prohibit third parties from marketing 3D puzzles that have a rotating capability. The registration of that mark protects solely the shape of a cube the surfaces of which bear a grid structure, which gives it the appearance of a 'black cage' (Para. 64). The graphic representations of the contested mark do not make it possible to determine whether the shape in question involves any technical function or, if so, what that technical function might be (Para. 72). Finally, it is irrelevant, as regards the examination of the functionality of the essential characteristics of a shape, whether or not there are other shapes which could achieve the same technical result (Para. 75).

The third plea on infringement of Article 7(1)(e)(i) was rejected, since the nature of 3D puzzles (the goods concerned) in no way requires that they have the shape of a cube with surfaces that have a grid structure (Para. 82).

The fourth plea alleging infringement of Article 7(1)(e)(iii) was rejected, since the invalidity applicant based its argument on the idea that substantial value is conferred on the goods concerned by certain functional features that the shape in question allegedly possesses without demonstrating or at least claiming that such substantial value flows from the aesthetic aspect of the shape (Para. 88).

In respect of the fifth plea alleging infringement of Article 7(1)(b) the GC stated that the relevant public's perception is not necessarily the same in the case of a 3D mark, which consists of the appearance of the goods themselves, as it is in the case of a word or figurative mark (para. 97). Since a registered CTM is presumed to be valid, it is for the invalidity (or revocation) applicant to adduce evidence in support of its application (Para. 103). Article 7(1)(b) cannot be interpreted as meaning that if a 3D mark resembles the product in question, it is 'implied by fact' that customers will not perceive that mark as an indication of origin unless it departs significantly from the norm or customs of the sector (Para. 104). The mere fact that there exists on the market a puzzle which resembles the CTM proprietor's one does not suffice to demonstrate that



Case law

the shape of the contested mark is the norm in the sector of 3D puzzles (Para. 106). Even if the shape in question were perceived by consumers as representing a 3D puzzle, it would still only be associated with the specific product marketed by the CTM proprietor, namely the Rubik's Cube, and not with a generic sub-section of 3D puzzles (Para. 109).

Under the sixth plea alleging infringement of Article 7(1)(c) the invalidity applicant claimed that the contested mark is merely descriptive of a 3D puzzle in the shape of a 3x3x3 cube (Para. 114). For a sign to fall under the prohibition laid down by that provision, there must be a sufficiently direct and specific link between the sign and the goods and services in question to enable the relevant public immediately to perceive, without further thought, a description of those goods or services or of one of their characteristics which is not the case at issue. The relevant public will not spontaneously perceive, in particular, without prior knowledge of the Rubik's Cube, unambiguously and without at least some reflection or analysis, the characteristics of the contested mark which are relied on by the applicant (Para. 119 and 123).

The seventh plea alleging Article 7(3) was rejected as unfounded, since the contested mark was inherently distinctive (Para. 131).

The eighth plea alleging insufficient reasoning of the BoA was rejected. The reasoning may be implicit, on condition that it enables the persons concerned to know the reasons for the BoA's decision and provides the competent Court with sufficient material for it to exercise its power of review (Para. 137).

Case T 549/10; Natura Selection SL v. OHIM, Judgment of 13 November 2014, Language of the case: EN

RESULT: Decision annulled

KEYWORDS: Claim for rejecting CTM application, Relative grounds, Similarity of signs, Similarity of the goods and services, Likelihood of confusion, Retail services

FACTS: The applicant sought to register the word mark natur as a CTM for goods and services within Class 24 corresponding to the following description of goods: Textiles and textile



goods, not included in other classes; bed and table covers. An opposition was based on the earlier figurative CTMs represented below: The CTMs were registered for goods in Class 20 and the following services in Class 35: Commercial retailing and via worldwide telematic networks; import and export services; advertising services; all the above relating to inter alia textiles and textile goods, not included in other classes; bed and table covers; clothing, footwear, headgear. The opposition was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division upheld the opposition in respect of some of the disputed goods and rejected the opposition in respect of table covers in Class 24. The Board of Appeal (BoA) dismissed the opponent's appeal finding that the goods 'table covers' in Class 24 covered by the mark applied for were lowly similar to services of 'commercial retailing..... relating to ... table covers' in Class 35, covered by earlier marks. The opponent filed an appeal before the General Court (GC).

CTMA

natur

Earlier marks



natura casa

natura



Case law

SUBSTANCE: There is a similarity between goods and retail services which relate to those goods (Para. 33). The services in Class 35 covered by the earlier application for the mark 'natura' relate to the goods in Class 24 covered by the mark applied for. Consequently, there is a similarity between the commercial retailing and via worldwide telematic networks of table covers covered by the earlier application for the mark 'natura' and the table covers covered by the mark applied for (Para. 34). Moreover, the services covered by the earlier application for the mark 'natura' constitute one of

the possible distribution channels for the goods covered by the mark applied for. That fact thus accentuates their similarity (Para. 35). The GC thus found that the BoA erred in finding there was a low degree of similarity between the disputed goods and services and, consequently, it erred in concluding there was no likelihood of confusion (Paras. 36 and 37). The single plea of the opponent was upheld.

Cases T-153/11 and T-154/11; Cantine Broglie 1 Srl v OHIM, Judgments of 27 November 2014, Language of the case: IT.

RESULT: Actions dismissed

KEYWORDS: Relative grounds, Likelihood of confusion, Identity of the goods and services, Similarity of signs, Visual similarity, Phonetic similarity, Conceptual similarity, Weak trademark

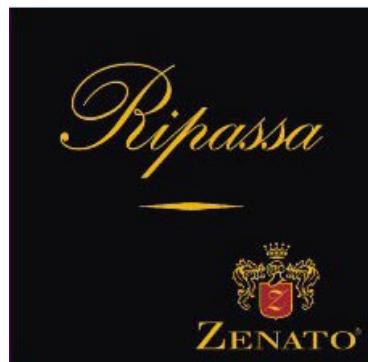
FACTS: The applicant sought to register the marks represented below as CTMs for 'alcoholic beverages (except beers)' in Class 33. Oppositions were filed based on the earlier Italian word mark RIPASSO, registered for 'wines, spirits and liqueurs' in Class 33. The ground invoked was based on Article 8 (1) (b) CTMR. The Opposition Division, having found that the earlier mark had been genuinely used only for 'wines', dismissed the oppositions, finding the signs to be overall dissimilar. The

Board of Appeal (BoA) upheld the appeals and the oppositions, finding likelihood of confusion. The applicant filed two actions before the General Court (GC).

CTMAs

ZENATO RIPASSA

(Case T-153/11)



(Case T-154/11)

Earlier marks

RIPASSO

SUBSTANCE The GC dismissed the actions and confirmed the BoA's findings. The goods concerned, wines, are mass consumer goods, which are purchased not only in wine shops and specialist establishments but also in supermarkets, grocery shops, etc. and which target the average consumer of large consumption goods (Para. 22). Therefore,

the relevant public's level of attention will not be particularly



Case law

high (Para. 24). As for the applicant's claim that the wine in question coming from Valpolicella are particularly costly, it is enough to note that this circumstance is not evident from the specification of the earlier mark (Para. 23). The GC dismissed the applicant's argument that there could be no likelihood of confusion, given the very limited distinctiveness, if any, of the earlier mark 'RIPASSO', which years back had been refused by the Office on the grounds that it was descriptive of a re-fermenting method, used in the Valpolicella area (in the Veneto region). The GC noted that, since the earlier 'RIPASSO' trade mark is validly registered in Italy and is assisted by a presumption of validity, it must be considered to have at least a certain degree of inherent distinctiveness (Paras. 32-36). The GC confirmed the BoA's reasoning that the above-mentioned technical meaning of the term 'RIPASSO' in relation to the wine sector would not be known to the majority of the Italian public, consisting particularly of less-knowledgeable end consumers not from the Veneto region. Consequently, for such end consumers the term 'RIPASSO' does not have any relationship with the goods in question. The GC also found that there is no contradiction between the decision of the Office, at the time, to refuse the CTM application 'RIPASSO' on the ground of its descriptive nature and the later decisions to uphold two oppositions based on an earlier registered national mark 'RIPASSO' (Para. 39). In this respect, the GC noted that for 'RIPASSO' to be considered descriptive under Article 7 (1) (c) CTMR, it is sufficient if the interested circles, consisting of wine professionals, connoisseurs having a higher degree of awareness and consumers from the Veneto region, are likely to perceive it as referring to a method for re-fermenting wine (meaning that it is sufficient if the descriptive nature of the trademark is perceived by a part of the relevant public). On the other hand, in the context of Article 8(1)(b) CTMR, upholding the oppositions is justified since the above technical meaning of 'RIPASSO' would not be known to the majority of the Italian public, not originating from the Veneto region and consisting of average consumers with a normal level of attention (Para. 41). The conflicting signs 'RIPASSO' and 'ZENATO RIPASSA' have



a low degree of visual and aural similarity and are conceptually similar to the extent that they both make reference to the same concept, 'ripasso' being a noun meaning 'the act of passing again; revision' and 'ripassa' being a verbal form having the same root and meaning '(he/she) passes again; (he/she) revises' (Paras. 49-57). Finally, the GC held that, even assuming the earlier mark 'RIPASSO' was inherently weak, still there is a likelihood of confusion on account of the identity between the goods and the degree of similarity between the signs (Para. 66).

Case T-543/12; Xavier Grau Ferrer v OHIM, Judgment of 24 October 2014, Language of the case: ES

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Certificate of registration, Complementary evidence, Database printout, Distinctive element, Dominant element, Elements which alter distinctiveness, Evidence of use, Figurative trade mark, Graphical representation, Identification earlier right, Invoice, Lack of reasoning, Nature of use, New evidence, Principle of functional continuity, Proof of use, Relative grounds, Substantiation of earlier right, Used not as registered, Weak element, Competence of the Boards

FACTS: The applicant sought to register the figurative mark represented below as a CTM for goods and services within Classes 31, 35 and 39. An opposition based on the earlier figurative marks represented below, registered for goods in Class 31 (Spanish trade mark) and Classes 31, 32 and 39 (CTM), was filed on the grounds of Article 8 (1) (a) and (b) CTMR. A database printout (Sitadex) corresponding to the earlier Spanish mark, that identifies its figurative nature and colours but without a graphical representation, was attached to the notice of opposition. The Opposition Division partially upheld the opposition on the basis of the only earlier mark considered to be substantiated, i.e. CTM, and found likelihood



Case law

of confusion after having previously determined that its genuine use for part of the goods had been proven. Both parties appealed. The opponent submitted a new Sitadex printout showing a graphical representation of the Spanish mark. The Board of Appeal (BoA) confirmed the CTM as the only substantiated earlier mark and found genuine use of that mark as registered had not been proven. The BoA dismissed the opponent's appeal and upheld the applicant's appeal. The opponent filed an action before the General Court (GC). During the proceedings before the GC, the judgments of the PROTI cases (C-121/12P and C-122/12P) were adopted and the GC asked the Office if it maintained the position defended in its initial response.

SUBSTANCE: The GC annuls the decision to the extent that: (1) The BoA erred when it did not exercise its discretionary power to decide on the admissibility of the 'complete' Sitadex regarding to the ES mark submitted before it. The GC finds that a discretionary power existed in this case and leaves the decision on whether or not to take the 'complete' Sitadex into account to the BoA since no mention on that issue was in the contested decision (Paras 49-52). The GC (i) points out that the BoA decided not taking into account the belated document without examining whether it was 'new' or 'additional' (Para. 43); (ii) considers that the graphical representation was not 'completely' new (because the first 'incomplete'

Sitadex identified the colours of the sign and because the B&W representation of the sign had been reproduced in the opponent's arguments for the opposition) (Para. 44); and (iii) as subsidiary in its reasoning, refers to PROTI judgments (Para. 45). (2) Genuine use of the earlier figurative CTM was proven. The nature of use becomes the issue. Even though the evidence does not contain the earlier mark as registered, the GC finds that the three versions of the sign shown by the evidence (see above) differ from the earlier mark in insignificant elements, they being, therefore, 'globally equivalent' (Para. 86). The global impression of the ER is dominated by the distinctive



term 'BUGUI', the remaining elements being secondary (descriptive/common/ornamental) (Paras. 81-85).

CTMA



Earlier marks



Forms in which earlier CTM was used





Case law



Case T-445/12; Koscher + Würtz GmbH, v OHIM; Judgment of 26 September 2014; Language of the case: DE

RESULT: Decision annulled

KEYWORDS: Likelihood of confusion, Relative grounds, Proof of use, Error by OHIM, Request for proof of use, Similarity of marks

FACTS: The applicant designated the EU for its International Registration "KW Surgical" for goods in Class 10. The intervener filed an opposition based on Article 8 (1) (b) CTMR using the earlier German mark "Ka We", registered for goods in Class 10. The Opposition Division rejected the opposition because the similarity of the signs was held to be insufficient. For reasons of procedural economy the evidence intended to show the proof of use of the earlier mark has not been examined. The Board of Appeal (BoA) upheld the appeal of the intervener, finding that there was likelihood of confusion, taking into account, the identity of the goods and the similarity of the signs. The BoA did not examine the evidence intended to show the proof of use of the earlier mark. The applicant appealed to the General Court (GC), arguing an infringement of Article 8 (1) (b) CTMR.

Contested IR



Earlier German mark

Ka We

SUBSTANCE: As regards the plea for annulment of the contested decision, with reference to the request for proof of use, the GC deeply analyses this issue from a procedural point of view. It confirms the Case-Law that the genuine use of the earlier mark is a matter which, once raised by the applicant for the trade mark, must be settled before a decision is given on the opposition proper. The request for proof of genuine use of the earlier mark therefore adds to the opposition procedure a specific and preliminary question and in that sense changes the content thereof (Para. 30). Moreover, it follows from that continuity in terms of their functions between the different departments of the Office that, in the context of the review which the BoA must undertake of the decisions taken by the Office units which heard the application at first instance, the BoA are required to base their decisions on all the matters of fact and of law which the parties put forward either in the proceedings before the department which heard the application at first instance or in the appeal (Para. 28). The GC concludes that even if the applicant would not have raised before the BoA the question whether the Intervener has shown genuine use of its earlier mark, this issue has to be examined (Para. 29). As a consequence the GC annulled the decision because the evidence intended to show genuine use of the earlier mark has not been examined. As regards the plea for alteration of the contested decision in the sense that there is no likelihood of confusion The GC proceeded to examine the comparison of the signs in the contested decision. It agrees with the BoA that the signs are visually similar in a low degree because of the coincidence of the letters "K" and "W" contained in both marks (Para 55). From a phonetic point of view the GC coincides with the contested decision and states that there is a high degree of aural similarity or even an aural identity, in case that the public would not pronounce the terms "surgical instruments" of the younger mark (Para. 61 and 63). From a conceptual point of view the terms "surgical instruments" will be understood at least by the English speaking consumers with specific knowledge in the medical field. The GC proceeds with the analysis if this conceptual meaning of "surgical



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instruments" together with the graphical features contained in the younger sign are enough to exclude any likelihood of confusion (Para 66). The GC finally reaches the conclusion that the differences between the signs would not be sufficient in order to safely set aside any likelihood of confusion. The meaning of "surgical instruments" may not neutralize and counteract the visual and in particular aural similarities between the signs (Para. 73). The BoA did not commit any mistake when it concluded that there would be a likelihood of confusion between the signs (Para 75). The plea for alteration has been rejected (Para. 82). The Office has to examine the evidence intended to show the proof of use of the earlier sign and then assess if there is likelihood of confusion between the marks (Para. 83).

Case T-556/12, Royalton Overseas Ltd v OHIM + S.C. Romarose Invest Srl, Judgement of 25 November 2014, Language of the case: EN

RESULT: Decision annulled

KEYWORDS: Bad faith, Figurative trademark, Suspension of the proceeding, Competence of the Boards, Parallel proceedings, Relative grounds, Principle of party disposition

FACTS: The applicant filed an application for the figurative trade mark 'KAISERHOFF' for goods in Classes 1 and 8. The opponent relied on an earlier Romanian mark 'KAISERHOFF' for goods and services in Classes 11, 21 and 35. The Opposition Division (OD) partially upheld the opposition. The applicant filed an appeal against the OD's decision and requested the suspension of the proceeding since a cancellation proceeding against the earlier right was pending before the Romanian Tribunal. The Board of Appeal (BoA) refused the request for suspension (Para. 12) and dismissed the appeal (Para. 13). The applicant brought an action before the General Court (GC) based on two pleas in law (Para. 20).



CTMA

KAISERHOFF

Earlier mark

KAISERHOFF

SUBSTANCE: The GC upheld the first plea in law and annulled the BoA decision. As regards the first plea, the BoA did not take into account the evidence produced by the applicant in support of its request for suspension. Under Rule 20 (7) CTMIR, the Office has a wide discretionary power when deciding or not to suspend the proceedings. When reviewing the legality of an administrative decision based on such an appraisal, the GC must not substitute its own assessment for that of the BoA. Consequently, judicial review in such matters must be limited to verifying that the measure in question is not vitiated by any manifest errors or misuse of powers. A refusal to suspend the appeal proceedings may not be vitiated by any manifest error even where the validity of the earlier mark is challenged before a national court. This is because the decision on the suspension must take into account the balance between the parties' respective interests, including the opponent or cancellation applicant's interest to obtain a decision within a reasonable period of time (Paras. 31-36). The GC examined whether the BoA had correctly balanced the parties' interests. It replied in the negative. First, the fact that the cancellation action against the earlier mark was lodged after lodging the appeal before the BoA is not a proper justification for refusing the suspension (Para. 42). The holder of the earlier mark has no interest in pursuing the opposition if its earlier mark is cancelled: even if the CTMA was refused, it could not oppose a fresh filing (Para. 41). The CTM applicant has no interest in delaying the adoption of a decision because it does not enjoy an effective protection until the CTMA is



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registered (Para. 47). As regards the second plea, the BoA did not take into account the evidence produced by the applicant as grounds for rejecting the opposition, the GC deemed being not necessary to appraise the second plea in law, considering that (i) the examination of the question whether to suspend the proceeding is preliminary to the analysis regarding the likelihood of confusion between the trademarks and (ii) the GC is unable to determine the "soundness of the analysis carried out by the BoA in the contested decision" (Paras. 52, 53).

Case T-515/12 El Corte Inglés S.A. v. OHIM, Judgment of 15 October 2014, language of the case: ES

RESULT: Action dismissed

KEYWORDS: Relative grounds, Reputation, Visual dissimilarity, Phonetic dissimilarity, Conceptual similarity, Dissimilarity of signs, Likelihood of confusion

FACTS: The other party sought to register the verbal sign THE ENGLISH CUT for goods in Class 25. El Corte Inglés filed an opposition pursuant to Article 8 (1) (b) CTMR and Article 8 (5) CTMR, based on the word and figurative marks reproduced below, covering namely goods in Class 25. Both the Operations Department and the Board of Appeal (BoA) dismissed the opposition. Before the General Court (GC), the applicant alleges an infringement of Article 8 (1) (b) and of Article 8 (5) CTMR.

SUBSTANCE: The GC ruled no visual or aural similarity, only a slight conceptual similarity for the Spanish public (Paras. 28-29). The signs are globally dissimilar. No likelihood of confusion. Since the signs are not similar, Article 8 (5) CTMR cannot be applicable.

CTMA

THE ENGLISH CUT

Earlier marks: CTMs and ES



Case T-278/12; Inter-Union Technohandel GmbH v. OHIM, Judgment of 9 December 2014, language of the case: EN

RESULT: Action upheld (BoA Decision annulled)

KEYWORDS: Relative grounds, Proof of use, Evidence of use, Extent of use, Declaration, Press articles, Catalogue

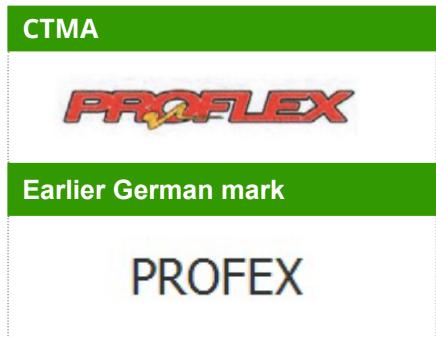
FACTS: The applicant sought to register the figurative sign reproduced below for goods in Classes 9, 12 and 25. An opposition was lodged pursuant to Article 8(1)(b) CTMR, based on the mark reproduced below, covering goods in Classes 6, 8, 9, 11, 12, 16, 17 and 21. Following a request of proof of use, the Opposition Division (OD) rejected the opposition in its entirety, finding that the opponent had not produced sufficient evidence



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to prove genuine use of the earlier trade mark. On appeal, the Board of Appeal (BoA) annulled that decision and referred the case back, holding in essence that, by failing to consider certain evidence adduced by the opponent, the OD had relied on an incomplete factual basis in taking its decision. The OD gave a new decision in which it concluded that genuine use of the earlier mark had been established with regard to some of the goods for which it was registered, namely, various types of accessories for bicycles and motor vehicles. The OD then examined the likelihood of confusion and partially upheld the opposition in respect of a range of goods in Classes 9 and 12. On appeal, the BoA found that, contrary to the finding made by the OD, the opponent had not demonstrated the extent of the use and had consequently failed to prove genuine use of the earlier mark. Before the General Court (GC), the opponent alleged an infringement of Article 42(2) and (3) CTMR and Rule 22 CTMIR and an infringement of Article 76(1) CTMR.



SUBSTANCE: The GC annulled the BoA's decision. It noted that the evidence of use examined by the BoA included, among other, (i) an affidavit, dated and signed by a representative of the opponent, appended to which were tables, also signed and dated, displaying information on the turnover from the sale of a number of bicycle and motor vehicle accessories marketed under the earlier mark; (ii) three articles in the monthly magazine test, published by the Stiftung Warentest (the official German foundation for product testing) which referred to

bicycle helmets on the one hand and car seats on the other marketed under the earlier mark, and (iii) dated catalogues referring to bicycle and motor vehicle accessories marketed under the earlier mark and where reference was made to the articles in the Stiftung Warentest's magazine tests. The GC confirmed the BoA's finding that, given the links between the signatory of the affidavit and the opponent, probative value could not be attributed to that statement unless it was supported by other evidence (Paras. 52-53). However, the BoA was under a duty to consider whether the evidence, other than the affidavit, substantiated the information given in that statement and should not have confined itself to considering whether that evidence — in itself, without the affidavit — established the extent of the use of the earlier mark (Para. 63). The articles on product testing published in Stiftung Warentest's magazine test are different in nature and function from the advertising material at issue in the judgment in case T-298/10 BIODANZA (on which the BoA had relied and where the advertising material was the only evidence of use) (Para. 72). The function of the articles concerning Stiftung Warentest's magazine test is not to advertise a product, but to present its advantages and disadvantages and to compare it with identical products marketed under other trademarks, in order to help consumers in their choice of purchase. These articles - whatever the extent of their distribution to the public (a point which had been extensively debated by the parties) relate to products which are already on the market and they contain information on the average price of the products on the market. The BoA should have considered both those articles (which provide information concerning the extent of the use of the earlier mark in relation to the products tested) and the references, in the advertising catalogues submitted, to tests carried out by Stiftung Warentest, and should have assessed them in the light of the information given in the affidavit (Paras. 74-77). Given that the first plea in law raised by the opponent must be upheld and that the contested decision must be annulled, there is no need to examine the second plea (Para. 78).



Case law

Case T-171/12; Peri GmbH v OHIM, Judgment of 25. September 2014, Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Absolute grounds, Three-dimensional mark, Restriction of the list of goods and services, Modification of subject-matter before Court, Specialized public, Shape of the product

NORMS: Article 7 (1) (b) CTMR, Article 7 (1) (e) CTMR, Article 65 (2) CTMR, Article 135 § (4) Rules of Procedure of the General Court

FACTS: The Board of Appeal (BoA) dismissed the appeal against the examiner's decision refusing registration of a three-dimensional trade mark in the shape of a turnbuckle, as represented below, for goods in Classes 6 and 19 which it considered devoid of distinctive character pursuant to Article 7 (1) (b) CTMR. The BoA observed that the CTM application consist in a usual make variation of a turnbuckle which forms part of the goods covered by the application ("concrete formworks"). The CTM applicant filed an action before the General Court (GC), claiming an infringement of Articles 7 (1) (b) and 7 (1) (e) CTMR. During the GC procedure it requested a limitation of the goods applied for.



SUBSTANCE: On the subject of proceedings: The limitation of the goods initially applied for ("concrete formworks") to "concrete formworks except turnbuckles" made during the GC proceedings exceeds the subject of the judicial control pursuant to article 65 (2) CTMR and would change the subject matter of the dispute against article 135 § 4 Rules of Procedure. It cannot be taken into consideration (para. 13 et seq. with reference to previous Case-Law). On the claimed infringement of Article 7 (1) (b) CTMR: The goods applied for are directed to specialised public with an enhanced level of attention (para.38). The Case-Law according to which a three dimensional trade mark consisting of a shape of the goods applied for must depart significantly from the norm or customs of the sector is applicable when the relevant public is the professional one (para. 42). The CTM applied for shows differences to the shapes of turnbuckles analysed in the contested decision of the BoA, but these differences are not significant enough to make the mark distinctive. The mark appears rather as a possible make variation of the goods covered by the application (para.44). On the claimed infringement of Article 7(1)(e) CTMR: The contested decision was not based on Article 7 (1) (e) CTMR but on Article 7 (1) (b) CTMR. For this reason the claim of an infringement of this provision is ill-founded.

Case T-463/12 Eugen Popp and Stefan M. Zech v OHIM; Judgment of 6. November 2014; Language of the case: DE

RESULT: Action dismissed

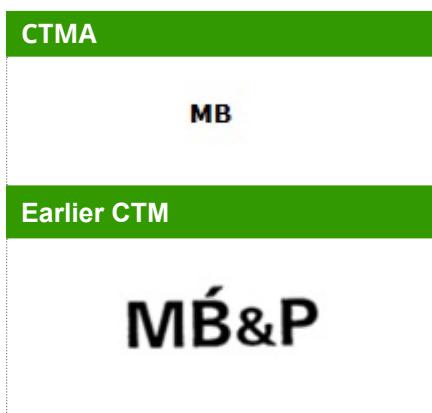
KEYWORDS: Admissibility of defence, New argument, Proof of use, Nice Classification, Weak trade mark, Declaration, Similarity of signs, Identity of goods and services, Likelihood of confusion, Relative grounds

FACTS: The applicant sought to register the word mark represented below as a CTM for "services of a patent attorney's



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“office” within Class 45. An opposition pursuant to article 8 (1) (b) CTMR was filed on the basis of an earlier CTM represented below and protected for services in class 35 and 42. The CTM applicant requested proof of use. The Opposition Division rejected the opposition due to the differences between the marks. The Board of Appeal (BoA) allowed the opposition in its entirety. It considered that the proof of use was sufficient for “services of a patent attorney” in Germany and found the likelihood of confusion. The applicant filed an action before the Court claiming infringements of Article 42 (2) CTMR and Article 8 (1) (b) CTMR.



SUBSTANCE: As far as the applicant contests the probative value of the affidavit provided as proof of use for the first time in the reply, it is not a new plea in the meaning of Article 48(2) of the Rules of Procedure, but an extension of its plea based on Article 42(2) CTMR which was raised in the application. It is admissible.

On Article 42 (2) and 15 (1) CTMR:

The numerous invoices filed by the opponent prove together with the business cards and the correspondence the use of the earlier mark for the “services of a patent attorney” for which it is registered in Class 42. The invoices list typical services of a patent attorney (Paras. 38 et seq.). This cannot be questioned by the fact that the invoices contain also opponent’s company



name. There is no requirement that a trade mark has to be used in isolation (Para. 43 with a reference to further judgments). Further documents, as business cards and correspondence were filed (Para. 49). The affidavit was made by the partner of the opponent company which could reduce its probative value (Para. 54) unless it is supported by further documents as it was in this case (Para. 58).

On Article 8 (1) (b) CTMR:

There is an identity between the “patent attorney’s services” in Class 42 and the “services of a patent attorney office” in Class 45. The classification has only administrative purposes pursuant to rule 2 (4) CTMIR (Para. 75).

The earlier mark has a normal distinctiveness (para. 88). According to the Case-Law, the assessment of the likelihood of confusion in the case of marks consisting of short sequences of letters follows the general rules, even if the sequence is not pronounceable (Para. 90).

The fact that the earlier mark is contained in the CTM application leads to a similarity. The Case-Law does not support the applicant’s assumption that the similarity is excluded already by small differences if the signs are short. Even for short signs the differences have to be sufficient (Para. 97).

There is a likelihood of confusion even taking into consideration the enhanced level of attention that the public will show in the case of patent attorney’s services. The public will perceive the CTM application as a variation of the earlier one (Para. 148)

Cases T-504/12; Murnauer Markenvertrieb GmbH v OHIM; Judgments of 12 November 2014; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Complex mark, Principle of legality, Principle of non-discrimination, Absolute grounds, Relevant language, Figurative element



Case law

FACTS: The applicant sought to register the figurative mark 'NOTFALL CREME', represented below as CTM for goods within Classes 3 (in essence beauty products) and 5 (herbal products). The application was rejected. The applicant filed an action before the General Court (GC), claiming the infringement of Article 7(1) (c), 7 (1) (b) and 83 CTMR.



SUBSTANCE: The relevant consumer is the average German speaking consumer. The GC confirmed the view of the Board of Appeal that 'Notfall' (emergency) also referred to situations in which something is urgently needed, not just, as argued by the applicant, to life or limb threatening situations (Para. 21). In the context of the sign in issue, the term is descriptive for products that are useful or necessary to prevent or solve an urgent beauty care problem either because the goods are specifically tailored towards such problems in their composition or effects or because they can cover a situation in which the usual products are not available (Para. 23). Moreover, such products can have the function of protecting, calming or regenerating the body, in particular skin and mucus membranes, against irritants as well as internal and external attacks (Para. 24). 'CREME' describes that the products are either creams or contain cream additions. The combination of 'NOTFALL' and 'CREME' is in no way unusual in the structure of the German language (Para. 28). The CTM applied for is descriptive. The figurative element is banal and does not make the sign distinctive. Hence, the sign also lacks distinctive character. As regards an infringement of Article 83 CTMR, the GC found that there had been no breach of the principle of equal treatment through the registration of other CTMs that the applicant considered similar (Para. 43).



Cases T-122/13, T-123/13 and T-77/13; Laboratoires Polive v OHIM, Judgments of 8 October 2014, Language of the cases: EN

RESULT: Decisions annulled.

KEYWORDS: Claim to reject CTM application, Relative grounds, Similarity of the goods and services, Similarity of signs, Phonetic similarity, Visual similarity, Likelihood of confusion, Figurative element, Distinctive element, Parallel proceedings, Competence of the GC/CJ

FACTS: In joint cases T-122/13 and T-123/13, the applicant sought to register two figurative marks represented below as CTMs for goods within Classes 3, 5, 8, 10, 11, 16, 18, 21, 25 and 28. Oppositions, based on the earlier Spanish and Portuguese word marks DODOT covering goods in Class 3, 5, 10, 12, 16, 18, 20, 21, 24, 25, 28 and 44, were filed on the grounds of Article 8 (1)(b) and Article 8 (5) CTMR. The Opposition Division (OD) partially upheld the oppositions on the basis that there was a likelihood of confusion between the marks at issue in respect of some of the goods in Classes 3 and 18 and accepted the CTMA in respect of the rest of the goods. The Board of Appeal (BoA) annulled the decisions of the OD and partially upheld the oppositions on the basis that there was a likelihood of confusion between the marks at issue also as regards some of the goods. The applicant filed an action before General Court (GC) alleging infringement of Article 8 (1) (b) CTMR. In the Case T-77/13, the applicant sought registration of the word sign DODIE for goods within Classes 3, 5 and 10. The opposition was based inter alia on earlier Spanish word mark DODOT registered for the goods within Classes 3, 5, 10 and 16 and on earlier Community word mark DODOT registered for the goods within Classes 16, 24 and 25). The opposition was based on the same grounds as in the joint cases outlined above and the action alleged also infringement of Article 8 (1) (b) CTMR.



Case law



CTMAs



Earlier mark

DODOT

SUBSTANCE: In joint cases T-122/13 and T-123/13 GC observed that the goods covered by the marks applied for were aimed at the general public except in the case of certain goods related to health in Classes 5 and 10, which were aimed at a public with a higher level of attention. The GC did not accept the argument of the applicant that in the case of personal care products and, in particular, baby care products, the level of attention of consumers is higher, since while the group of average consumers for that category of goods will also include careful parents, it will not in any way consist exclusively of such consumers (Paras. 23 and 25). In regards of the visual similarity the GC found that the final part of the trademarks applied for with the diphthong 'ie' as well as the final part 'ot' of the earlier trademarks is very unusual in both Spanish and Portuguese and will attract more attention from the relevant public (Para. 40). Additionally, the figurative element which is not negligible weakens more the similarity of the signs (Para 42). When comparing the marks at issue phonetically, the rules of pronunciation of Spanish and Portuguese should be applied (Para. 47). Notwithstanding the same initial sequence of letters 'd', 'o' and 'd', the rhythm of pronunciation of each of the marks is different, or at least, the intonation falls on the parts of the marks at issue that are different (Para. 49).

The signs at issue had no concept in common (Para. 51). The GC found the signs at issue being similar to only a very low degree (Para. 53). The low degree of similarity of the signs does not support the conclusion that there is a likelihood of confusion in the present case, notwithstanding the similarity, if not the identity of the goods and even having regard to the public, which does not display a particularly high degree of attention (Para. 57). Even if the earlier marks have enhanced distinctiveness (as claimed by the opponent) that cannot compensate for the fact that there is no likelihood of confusion between the signs at issue within the meaning of Article 8 (1) (b) CTMR (Para. 63). The substantive part of Case T-77/13 is quasi identical with the cases T-122/13 and 123/13, at least as regards the comparison of the signs. In this case, besides the annulment of the BoA decision, the applicant sought also rejection of the opposition in its entirety. In this regard the GC stated that its power to alter decisions pursuant to Article 65(3) CTMR does not have the effect of conferring on the GC the power to carry out an assessment on which the BoA has not yet adopted a position. Exercise of the power to alter decisions must, in principle, be limited to situations in which GC, after reviewing the assessment made by the BoA, is in a position to determine, on the basis of the matters of fact and of law as established, what decision the BoA was required to take (Para. 62). As in the present case the BoA did not examine whether there was a likelihood of confusion between the mark applied for and any of the other earlier rights relied on by the intervener, the conditions for the exercise of GC's power to alter decisions are not satisfied and applicant's claim was rejected (Paras. 62 and 63).



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Case T-341/13; Groupe Léa Nature SA v OHIM (SO'BiO etic / SO...? et al); Judgment of 23 September 2014; Language of the case: EN

RESULT: BoA decision annulled.

KEYWORDS: Claim for rejecting CTM application, Proof of use, Similarity of the goods and services, Likelihood of confusion, Right to be heard, Principle of legal certainty, Principle of legitimate expectations, Detriment to earlier mark, Reputation, Enhanced distinctiveness, Extent of use, Nature of use, Time of use, Beginning of mark, Ending of mark, Laudatory mark, Phonetic similarity, Weak element, Figurative element, Visual dissimilarity, Dissimilarity of signs, Dominant element, Complex mark

FACTS: The applicant sought to register the figurative mark reproduced below for goods in Classes 3 and 25. An opposition was filed based on the earlier marks: (i) Community trademark SO...?, registered for goods in Class 3, and (ii) UK trademark SO...?, registered for goods in Class 25, on the grounds of Article 8 (1) (b), Article 8 (4) and (5) CTMR. The Opposition Division (OD) rejected the opposition. The Board of Appeal (BoA) annulled the decision of the OD and rejected the CTM application. According to the BoA, the OD failed to examine whether genuine use had been proven. Further, it found that there was a likelihood of confusion between the signs at issue in relation to identical or similar goods. Finally, it held that, with regard to 'bleaching preparations and other substances for laundry use', there was a risk that the sale thereof would be detrimental to the reputation of the earlier marks within the meaning of Article 8 (5) CTMR. The applicant filed an action before General Court (GC) relying on four pleas in law.

CTMA



Earlier mark

SO...?

SUBSTANCE: According to the first plea the BoA has erred in law in the choice of the legal basis of the contested decision and therefore has breached the principles of legal certainty, legitimate expectations and the right to fair hearing because the contested decision was based on the Regulation 207/2009 and not on the Regulation 40/94 which was in force when the CTMA was filed. This plea was rejected as Regulation No. 207/2009 only codified Regulation No 40/94 and the relevant provisions thereof did not undergo any amendment in the course of that codification (Para. 18). GC also excluded the application of the right to a fair 'hearing' in proceedings before the BoA of the Office, since proceedings before the BoA are administrative and not judicial in nature (T-273/02 CALPICO) (Para. 25). The second plea alleging an error of law in the assessment of the genuine use of the earlier marks was also rejected. The concept of use of a mark on the market, as a factor of enhanced distinctiveness or reputation, does not have the same scope as the concept of genuine use for the purposes of Article 42 (2) CTMR. The examination relating to whether the earlier mark is distinctive makes it possible, where that mark is found to be distinctive, to strengthen a finding that there is likelihood of confusion with the mark applied for and occurs at the same time as or after the comparison of the signs at issue. By contrast, the examination relating to whether there



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has been genuine use of the earlier mark takes place at an earlier stage, at the request of the applicant for a trade mark, and is decisive for the examination of the opposition. The BoA did not err in law in finding that the OD had not examined the question of genuine use of the earlier marks and on adjudicating itself on that question (Paras. 35 and 37). For the purposes of Article 42 CTMR it is sufficient that a trademark has been put to genuine use during a part of the relevant period for it. Producing evidence relating to the place time, extent and nature of use of the trademark in connection with the goods covered, during a specified period, is necessary (Para. 46 and 47). It is sufficient that the opposition is justified on the basis of one earlier right for the registration of that application to be refused (Para. 52). The third plea alleging an infringement of Article 8 (1) (b) was upheld. According to the GC, since, in relatively short word signs, the elements at the beginning and end of the sign are as important as the central elements, it cannot be inferred from the position occupied by the element 'so' in the earlier marks that it will attract consumers' attention more (Para. 71). The element 'so' has a laudatory function and has only weak inherent distinctiveness to the goods at issue (Para. 73). The earlier marks are not composite marks therefore a comparison of the signs at issue on the sole basis of their dominant element is not possible (Para. 74). When a mark, such as the mark applied for, is composed of word elements and figurative elements, the word element of the mark is, as a rule, more distinctive than the figurative element, since the average consumer will more easily refer to the goods in question by citing the name rather than describing the figurative element (Para. 75). Notwithstanding that, GC found that the signs at issue have a different length and structure and that, apart from the word element 'so', which does not dominate the overall impression, they are not visually similar (Para. 79). The signs at issue are phonetically similar to a low degree since their length, rhythm and intonation are different even though the word 'so' is placed at the beginning of the sign applied for and that the consumer is deemed generally to pay greater attention to the beginning of a mark (Para. 81 - 84).



The GC did not find a conceptual similarity (Para. 89). Based on the foregoing, the GC found that the signs are not similar (Para. 91). The fourth plea alleging infringement of Article 8 (5) CTMR was upheld, since the similarity of signs at issue, one of the requirements for application of this provision, is not met.

Case T-308/13; Repsol, S.A. & Josep Maria Adell Argiles v.OHIM; Judgment of 18 November 2014; Language of the case: ES

RESULT: Decision partially annulled

KEYWORDS: Relative grounds, Likelihood of confusion, Similarity of goods and services, Identity of signs, Complementary goods and services, Principle of legality

FACTS: The applicant sought to register the verbal sign ELECTROLINERA as a CTM in Classes 4, 37 and 39. An opposition based on a Spanish earlier mark ELECTROLINERA for goods in Classes 12 and 9 was filed on the grounds of Article 8 (1) (b) CTMR. The opposition was directed against all goods of the CTM. The Opposition Division (OD) partially upheld the opposition. The Board of Appeal (BoA) partially annulled the decision of the OD. For industrial oils, greases, lubricants and fuels in Class 4 it held that there was a weak but non negligible similarity with vehicles in Class 12 of the earlier mark. It held that there is a certain similarity between electricity in Class 4 and the apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity in Class 9 of the earlier mark. For gas stations services in Class 37 it held that there is a certain degree of similarity with apparatus in Class 9 of the earlier mark. Finally the services of providing, distributing and stocking energy for vehicles in Class 39 of the contested mark were found to be similar to vehicles of Class 12 and to apparatus of Class 9 of the earlier marks. The signs being identical, likelihood of confusion was found with regard to the similar products and services.



Case law



CTMA
ELECTROLINERA
Earlier mark
ELECTROLINERA

SUBSTANCE: The relevant public is composed of the average public and the professional public in Spain (Para. 27). Regarding fuels in Class 4 and vehicles in Class 12, the General Court (GC) held that the complementarity link between the two products is not enough to conclude to similarity (Para. 39). As to industrial oils, greases and lubricants in Class 4 and vehicles in Class 12, the BoA was not correct to conclude that the products were similar (Paras. 47 and 53). On electricity in Class 4 and apparatus in Class 9, the BoA was correct to establish that the products were similar (Para. 52). In relation to the services of Class 37 and the apparatus of Class 9, the BoA was correct to conclude to a certain degree of similarity (Para. 61). On the services of Class 39 and the vehicles of Class 12, the GC held that the BoA was not correct to conclude that they are similar (Para. 69). On the services of Class 39 and the apparatus of Class 9, the BoA was correct to find a certain similarity (Para. 74). In the global assessment of the likelihood of confusion, although the GC criticises (Para. 69) the similarity found by the BoA in relation with services of Class 39 and vehicles of Class 12, in Para. 84 the GC held that the mistake pointed out in this respect was without consequences in the legality of the BoA decision and annuls the decision only in so far as concerns the conclusion that industrial oils greases and lubricants are similar to vehicles in Class 12 (Para. 86).

Case T-506/13; Urb Rulmenti Suceava SA v OHIM; Judgment of 7 November 2014; Language of the case: EN

RESULT: The action is dismissed

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

FACTS: This case concerns a situation where the Romanian collective trade mark URB were once exploited by different producers of bearings, under the control of a public entity linked to the Romanian Government and which also owned those collective marks. Following the start of a privatisation process, the assets of this public entity were transferred to a private company which became the registered owner. However, several companies, including the invalidity applicant and another company of which the CTM proprietor, a physical person, was the manager and shareholder, were authorised to use the earlier collective trademarks. In 2002, following an amendment, the use regulation did no longer contain the list of undertakings authorised to use those collective trademarks. It was rather established that third parties would have the right to use them only under a franchise agreement managed by the registered proprietor of those trademarks, but the invalidity applicant never entered such an agreement. Following registration of the contested mark URB by the CTM proprietor, the invalidity applicant sought its cancellation, relying, on the one hand, on two earlier registered Romanian collective trademarks and on two International trademark registrations designating a number of Member States and, on the other, of the alleged bad faith of the CTM proprietor. The evidence showed that these four registrations stood in the name of a third company, The invalidity applicant asserted that it was authorised to use those trademarks and to file the invalidity action, as the registered owner of those trademarks, expressly requested, had declined to do so. The Cancellation



Case law

Division rejected the invalidity request on the grounds that no evidence had been adduced of the bad faith of the CTM proprietor and that the invalidity applicant, which was not the proprietor of the earlier marks, was not entitled to rely on them to argue the existence of a likelihood of confusion. On appeal, the Board of Appeal confirmed the first instance's decision.

SUBSTANCE: The General Court (GC) dismissed the appeal. It was not persuaded by the invalidity applicant's argument that, given the refusal to act of the registered owner of the earlier marks, it was entitled, pursuant to the provisions of Article 22(2) and (3) and of Article 72 CTMR, to bring invalidity proceedings. In first place, the GC noted that under Article 56(1)(b) CTMR, an application for a declaration of invalidity may be submitted to the Office, where Article 53(1) applies, by the proprietors of earlier trademarks and licensees authorised by the proprietors of those trade marks (Para. 17). It did not appear from the documents before the GC that the invalidity applicant either had a licence or, in any event, had been authorised by the registered proprietor of the earlier marks to file an application for a declaration of invalidity with the Office (Para. 19). Secondly, the GC noted that the provisions of Articles 22(3) and 72 CTMR are not applicable to invalidity requests but only to actions for infringement, and that the same was true of the provisions of Romanian law relied on by the invalidity applicant (Para. 20). As to the alleged bad faith, the GC referred to the existing Case-Law and recalled that account may also be taken of the commercial logic underlying the filing of the application for registration of a Community trade mark. Even in circumstances where several producers were using, on the market identical or similar signs for identical or similar products, capable of being confused with the sign for which registration was sought, still the CTM proprietor's registration of the sign may be in pursuit of a legitimate objective (Para. 35). The GC held that it was understandable, from a commercial point of view that the CTM proprietor wished to extend the protection of the URB trade mark by registering it



as a Community trade mark. In that respect, the evidence on file showed that, during the period which preceded the filing, the CTM proprietor used the trademark, through a connected company, and generated turnover from goods marketed under the trademark in several Member States, which was a plausible incentive for filing an application for the registration of a Community trade mark (Para. 41). The invalidity applicant did not establish that it was the CTM proprietor's intention to exclude it from the market (Para. 44). The fact that the CTM proprietor knew or should have known that a third party (i.e. the invalidity applicant in this case) has long been using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought is not sufficient, in itself, to permit the conclusion that the CTM proprietor was acting in bad faith when filing the application (Para. 47).

Case T-188/13, Murnauer Markenvertrieb GmbH v OHIM; Judgments of 12 November 2014; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Principle of legality, Principle of non-discrimination, Absolute grounds

FACTS: The CTM owner had registered the verbal mark 'NOTFALL' for various goods within Classes 3, 5 and 30. Upon request, the CTM was declared invalid for the goods in Class 5 (dietetic products, medicinal product, herbal products etc.). The CTM owner filed an action before the General Court (GC), claiming the infringement of Article 7 (1) (c), 7 (1) (b) and 83 CTMR.

SUBSTANCE: The relevant consumer is the average German speaking consumer as well as the medical and care professional. The General Court (GC) confirmed the view of the Board of Appeal that 'Notfall' (emergency) also referred



Case law

to situations in which something is urgently needed, not just, as argued by the CTM owner, to life or limb threatening situations (Para. 24). In the context of the sign in issue, the term is descriptive for products that are useful or necessary to prevent or solve an urgent dietary, care or health problem either because the goods are specifically tailored towards such problems in their composition or effects or because they can cover a situation in which the usual products are not available (Para. 26). The CTM is descriptive and lacks distinctive character in relation to the relevant goods. As regards an infringement of Article 83 CTMR, the GC found that there had been no breach of the principle of equal treatment through the registration (continued existence) of other CTMs that the CTM owner considered similar (Para. 42).

Cases T-524/11 and T-525/11; Volvo Trademark Holding AB v OHIM, Judgment of 12 November 2014, Language of the case: EN.

RESULT: Action dismissed

KEYWORDS: Claim for rejecting CTM application, Relative grounds, Similarity of signs, Dissimilarity of the signs, Beginning of mark, Ending of mark, Detriment to earlier mark, Phonetic dissimilarity, Visual Dissimilarity, Figurative element, Admissibility, First time on appeal

FACTS: The applicant sought to register the marks represented below as CTMs for goods and services within Classes 7 and 12. Oppositions based inter alia on the earlier word mark VOLVO and the earlier figurative trademarks represented below, registered inter alia for goods in Classes 7 and 12. The grounds invoked were based on Article 8 (1) (b) and 8 (5) CTMR. The Opposition Division dismissed the oppositions. The Board of Appeal (BoA) dismissed the opponent's appeals. The opponent filed two actions before the General Court (GC) alleging infringement only of Article 8 (5) CTMR. GC's reasoning in both cases was identical.



CTMA

LOVOL

(case T-524/11)

LOVOL

(case T-525/11)

Earlier Mark/Sign



SUBSTANCE (references made to the case T-525/11): The types of injury referred to in Article 8 (5) CTMR are the consequence of a certain degree of similarity between the earlier and the later marks, by virtue of which the relevant public establishes a link between them even though it does not confuse them (Para. 17). The signs VOLVO and LOVOL are not composed of words which have a particular meaning and can be understood by the relevant public. Similarly, there is nothing in the way the letters are arranged in 'LOVOL' to suggest that the average consumer would divide it into two syllables and look at each



Case law

separately. Moreover, even if the average consumer were to do so, there is nothing to suggest that, contrary to the normal practice for reading Roman letters, he would then read the first three letters 'l', 'o', and 'v' in reverse order, as 'vol' (Para. 31). Further, both the first and the last letters

of those signs are different and the mark applied for contains two 'l's, whereas the trade mark VOLVO contains two 'v's (Para. 33). The figurative elements of the earlier figurative marks further distinguish those marks from the mark applied for (Para. 36). Regarding the aural perception, the letters 'l' and 'v' are pronounced quite differently: 'l' is an alveolar consonant, whereas 'v' is a labiodental consonant. The signs at issue have a different rhythm of pronunciation (Paras. 43 and 44). As regards the conceptual similarity, the opponent submitted a scientific article before the GC. The Office contended that the article was lodged for the first time before the GC. The Office held that it was not appropriate to determine whether the evidence represented by the article in question is admissible, given that, in any event, it does not support the opponent's arguments (Para. 53). The mere fact that the signs at issue contain the letters 'v', 'l', and 'o' and include the letter combination 'vol' is not capable of creating a connection between the signs in the mind of the relevant public or establishing a link between them (Para. 55).

Case T-272/13 Max Mara Fashion Group Srl v. OHIM; Judgment of 3 December 2014; language of the case: EN

RESULT: Action dismissed

KEYWORDS: Relative grounds, Likelihood of confusion, Common element, Distinctive element, Visual dissimilarity, Phonetic dissimilarity, Conceptual dissimilarity, Distinctiveness acquired through use, Similarity of goods and services, Dissimilarity of signs



FACTS: The other party sought to register the figurative sign reproduced below for goods and services in Classes 25 and 35. Opposition pursuant to Article 8(1)(b) and Article 8(5) CTMR, based on the figurative marks reproduced below, covering goods and services in Classes 18, 24, 25, 35 and 42. Both the Operations Department (OD) and the Board of Appeal (BoA) dismissed the opposition. Before the General Court (GC), the applicant alleges an infringement of Article 8 (1) (b) CTMR.

CTMA

M&Co.

Earlier marks: CTMs and IT

MAX&Co.

SUBSTANCE: The GC ruled: that the BoA did not consider negligible the common element '&Co'. It took due account of it and was right in finding that it has a weak distinctive character and precisely because the signs are short, the relevant public will perceive the differences between them more clearly. The letters 'AX' in the earlier signs differentiate the signs visually, phonetically and conceptually. The fact that a mark [like MAX&Co.] has acquired an enhanced distinctive character through use does not mean that it or the elements of which it is composed must be recognised as having an inherently high degree of distinctiveness. The highly distinctive character of a mark must be ascribed to the mark as a whole and not to all the elements of which it is composed, in particular to those elements which are inherently weak, like '&Co.' in the present case (Para. 61). The signs are not similar. The goods are identical or similar. There is no likelihood of confusion.



Case law



Case T-595/13; BSH Bosch und Siemens Hausgeräte GmbH v OHIM; Judgement of 4 December 2014 of; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Relative grounds, distinctive element, likelihood of confusion, Figurative element, Visual similarity, Conceptual similarity

FACTS: The CTM applicant sought to register the mark represented below for goods and in Class 7, 9 and 11. An opposition based on the earlier mark represented below, registered for similar and identical goods in Class 7, 9 and 11, was filed on the grounds of Article 8 (1)(b) CTMR. The Opposition Division (OD) upheld the opposition for the goods found to be similar and identical. The Board of Appeal (BoA) dismissed the applicant's appeal and rejected the CTM application for further goods, which were found similar contrary to the OD's opinion. The applicant filed an action



before the General Court (GC).

SUBSTANCE: The goods at issue are partly identical, partly similar (not disputed). The CTM applicant argued that the distinctiveness of the element KOMPRESSOR, at least for goods that can contain a compressor (such as e.g. vacuum cleaners/air condition apparatus) is only minimal. Therefore, for these goods, even the slightest differences will prevent a likelihood of confusion. The GC emphasized that, first, a certain degree of distinctiveness has to be attributed to national marks (Para. 26), and second that the distinctiveness of the earlier mark(s) is just one element of the assessment of likelihood of confusion (Para. 27). The CTM applicant's approach would lead to the result of the distinctiveness of the earlier mark neutralizing the similarity of signs and, thus, giving undue weight to the distinctiveness in the overall assessment (Para. 31). The BoA has seen and included the differences between the marks in its global assessment, but in light of the decorative figurative element and the secondary position of the element "technology" within the CTMA was right in its assessment that the difference in the first letters "C/K" are not sufficient to compensate for the similarity of the word elements "KOMPRESSOR"/"compressor" (Para. 34). Even if the aural similarity was considered secondary in the present case, the visual and conceptual similarities suffice to come to the conclusion of a likelihood of confusion (Para. 35). Based on the foregoing, the action was dismissed.

Case T-498/13 Nanu-Nana Joachim Hoepp GmbH & Co., v. OHIM; Judgment of 11 December 2014; language of the case: EN

RESULT: Action dismissed

KEYWORDS: Declaration, First time on appeal, Admissibility, Extent of use, Labels, Proof of use, Sales figures

FACTS: The other party before the Board of Appeal (BoA), Vincci



Case law

Hoteles SA sought to register the word mark NAMMU for goods and services in Classes 3 and 44. The sign was registered as a CTM in 2007. Nanu-Nana applied for a declaration of invalidity of the CTM, based on the earlier German word mark NANU, registered inter alia for goods in Class 3. The CTM owner requested that the applicant furnish proof of genuine use of the earlier mark. The Cancellation Division (CD) rejected the application for a declaration of invalidity, on the ground that genuine use of the earlier mark had not been proved. The BoA dismissed the appeal. The evidence of use was insufficient, as the affidavits set out only global turnovers for goods in Class 3 without any further detail. Furthermore, the photographs were inconclusive and did not show that the goods were marketed in Germany during the relevant period and the argument that it had been unable to submit other documents



are almost all in English or in languages other than German, so that they do not show on their own that the earlier mark was in fact used in Germany. An overall assessment of the evidence submitted shows that proof of genuine use has not been furnished. This conclusion is not called in question by the DEITECH Judgment (Case T-86/07), which can be clearly distinguished from this case. In DEITECH, in addition to the written statements of its employees, the applicant submitted brochures which constituted sufficiently solid and objective supporting evidence. Furthermore, precise particulars were also submitted as to the volumes of sales of shoes and the turnover generated and the difficulties in providing other evidence were plausible, contrary to what happens in the current case (paragraphs 51-53). The application is dismissed.

CTMA
NAMMU
Earlier Marks
NANU

like invoices or catalogues was inconclusive.

SUBSTANCE: The General Court (GC) finds that the third affidavit and the accompanying data, submitted for the first time before the GC, are not a confirmation of the first and second affidavit. They are thus inadmissible (paragraph 37). Figures in the 1st and 2nd affidavits concern goods in Class 3 generally and do not make it possible to ascertain what use was in fact made of the earlier mark, particularly because they do not show the extent of use in Germany during the relevant periods. The labels affixed to the goods in the photographs

Case T-712/13, Monster Energy Company v. OHIM; Judgment of 11 December 2014; language of the case: EN

RESULT: Action dismissed

KEYWORDS: Absolute grounds, Descriptive element

FACTS: The examiner refused registration of the word sign REHABILITATE for goods in Classes 5, 30 and 32, on the basis of Article 7 (1) (b) and (c) and Article 7 (2) CTMR, as it would immediately inform consumers, without further reflection, that the goods were nutritional supplements and drinks which helped restore consumers to health. The Board of Appeal dismissed the appeal.

CTMA

REHABILITATE



Case law

SUBSTANCE: The General Court notes that one of the meanings of the word REHABILITATE is to bring a person back to a good state of health or to enable him to return to a good physical condition, which is something that nutritional supplements in Class 5 and drinks in Classes 30 and 32 are supposed to help to do. The fact that this word may have other meanings does not rule out its descriptive character. In particular for the part of the relevant public engaged in intense physical exertion, the word REHABILITATE contains obvious and direct information on the purpose of the relevant goods. The application is dismissed.

Case T-176/13 DTL Corporación, S.L. v. OHIM; Judgment of 9 December 2014; language of the case: ES

RESULT: Action dismissed

KEYWORDS: Relative grounds, Right of defence, Right to be heard, Likelihood of confusion

FACTS: The applicant sought to register the word sign GENERIA for goods and services in Classes 9, 35, 37, 40, 41 and 42. Opposition pursuant to Article 8 (1) (b) CTMR, based on the figurative mark reproduced below, covering goods and services in Classes 7, 35 and 40. The Opposition Division (OD) partially upheld the opposition with regard to all the products and services, except for some of the services in Class 35. The Board of Appeal (BoA) dismissed the appeal. Before the General Court (GC), the applicant alleges an infringement of the right of defence and of Article 8 (1) (b) CTMR.

SUBSTANCE: The applicant alleges a breach of the right of defence and the right to be heard because the OD found that G&S applied for in Classes 9, 37 and 42 were similar to goods of the earlier mark in Class 7, but the BoA found them similar to services of the earlier mark in Class 40, without giving the



applicant the opportunity to file observations. The GC stated that it follows from Article 64 (1) CTMR that the BoA is called upon to carry out a new, full examination of the merits of the opposition, in terms of both law and fact. Since the services in Class 40 were invoked in the notice of opposition, the applicant had the opportunity, both before the OD and the BoA, to file its observations with regard to the lack of similarity between all the goods and services at hand. Within the framework of such full examination, the BoA was entitled to compare the relevant goods and services of the CTMA with the services of the earlier mark in Class 40 (paragraph 31). The BoA is not under the obligation to ask the parties for their observations on the similarity of the goods and services that the OD did not take into account but which were validly invoked in support of the opposition (paragraph 32). The GC confirms the comparison of the goods and services and of the goods, with some nuances. There is a likelihood of confusion (LOC). The application is dismissed.

CTMA

GENERALIA

Earlier marks: CTMs and IT





Case law

New Decisions from the Boards of Appeal

The cases can be found on our website.

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

Decision of the Second Board of Appeal of 29 October 2014 in case R 2166/2013-2 (EN)

Absolute grounds for refusal – Article 7(1)(b), 7(1)(c) and 7(2) CTMR – procedural issues - non-appealable decisions and confirmatory decisions

The applicant sought to register the word mark 'SATIN LIPS' for the specified goods in Class 3, namely 'cosmetics; non-medicated skin care preparations, fragrances for personal use'.

The examiner partially rejected the application under Article 7(1)(b), (c) and 7(2) CTMR in respect of 'cosmetics; non-medicated skin care preparations' applied for in Class 3, *inter alia* on the ground that the trade mark was descriptive and lacked distinctive character; and further on the ground that the applicant had already filed two earlier CTM applications for the identical sign 'SATIN LIPS'. One application, *inter alia*, for 'cosmetics' in Class 3, which was refused pursuant to Article 7(1) CTMR and was not appealed by the applicant, and



another application for 'lip care products' in Class 3, which was also refused pursuant to Article 7(1) CTMR – the refusal was appealed and confirmed by the Boards of Appeal. The current application was partially inadmissible because triple identity occurred for some of the specified goods applied for (*i. e.* the applicant, the sign and the goods were identical).

The applicant appealed the examiner's decision and requested that the Board reconsider the examiner's assessment of the distinctive character of the mark, reverse the examiner's decision and accept the applicant's trade mark for registration in relation to all of the specified goods.

The Board held that it must be assessed whether or not (1) the party to the proceedings at issue, (2) the relevant matters of law and fact characterizing those proceedings and (3) the operative parts of those decisions are identical.

A decision is regarded as a mere confirmation of an earlier decision if it contains no new factors as compared with the earlier decision and is not preceded by any re-examination as regards the situation of the addressee of the earlier decision. The contested application for registration, insofar as it related to cosmetics, was not based on new factors which could affect the operative part of the earlier decisions and the grounds constituting the essential basis thereof, and neither was the applicant's situation re-examined. The mere act of submitting newly drafted reasoning as to why the contested sign should be considered distinctive and non-descriptive, was not a new factor in itself. Further, the applicant's submissions in the examination proceedings did not refer to any new case-law that would affect the assessment on the grounds of Article 7(1)(b), (c) and 7(2) CTMR.

It was undisputed that the applicant had not appealed the first decision. It had, therefore, become definitive and its legality could no longer be challenged before the higher instance. It had to be considered that the Examination Division definitively ruled, in its first decision, on the subject-matter of the dispute determined by the first CTM application, which



Case law

sought to have the word combination 'SATIN LIPS' registered as a Community trade mark in respect of 'cosmetics' in Class 3. Since the operative part of that decision was capable of producing legal effects and, as a consequence, of adversely affecting interests, the applicant had to challenge it within the mandatory prescribed time-limit or become time barred.

The Board concluded that the Examination Division could and should have rejected the contested CTM application in respect of 'cosmetics' in Class 3 as inadmissible since, as has been previously stated, the first decision became definitive and had not been appealed insofar as Article 7(1)(b), (c) and 7(2) CTMR were concerned. This could not be circumvented by subsequently filing one or more identical CTM applications, also considering the fact that the applicant did not allege or substantiate any new factors capable of affecting the operative part of the first decision and the grounds for refusal constituting the essential basis thereof.

Consequently, the Board dismissed the appeal.

[Link to eSearch Case Law](#)

Decision of the First Board of Appeal of 4 September 2014 in case R 483/2014-1 (DE)

Formalities examination – procedural issues – Rules 3 and 9 CTMIR –figurative mark with colour indication – grey as a colour

The applicant sought to register the figurative mark



for goods in Class 29. The application contained the colour



indication 'black, white'.

In the course of the formalities examination the examiner objected to the colour indication pursuant to Rules 9(3) and 3(5) CTMIR because the colour 'grey' was missing. In response to the objection the applicant clarified that the words 'black, white' were supposed to indicate that no colour was claimed and requested that the application as filed be upheld.

The figurative mark was published with the colour indication 'black, white, grey' in accordance with the applicant's auxiliary request, whereupon the applicant requested that the Office correct the colour indication to 'black, white'

By a decision, the examiner rejected the applicant's request to correct the colour indication.

The applicant filed an appeal against the examiner's rejection and requested that the figurative mark be registered as a black and white mark as filed.

The Board held that the figurative mark applied for was depicted in black, white and various shades of grey. A representation of the mark in black and white only was not submitted. That the description of the mark complies with its depiction is a requirement. Therefore, the applicant could not file a coloured representation of the mark and claim a registration in black and white. The Board ruled that the indication 'black, white, grey' corresponded with the mark as filed.

Consequently, the Board dismissed the appeal.



Case law



Decision of the First Board of Appeal of 2 October 2014 in case R 1866/2013-1 (EN)

Opposition – Article 8(1) CTMR - procedural issues – goods and services specified, items in the alphabetical list that do not fall within the natural and usual meaning. Opposition Division decided ultra petita



The applicant sought to register the figurative mark for, inter alia, the following goods:

'Class 25 - Clothing, footwear, headgear; clothes for sports, tracksuits, sports shoes, clothing for cycling, footwear for cycling, shorts, shorts for cycling, sports jerseys, singlets for cycling'

The opponent filed an opposition pursuant to Article 8(1)(a) and (b) CTMR based on three earlier CTMs: Three figurative marks claiming different colours and different classes. The opposition was filed, inter alia, against the following goods:

'Class 25 Clothing, footwear, headgear; clothes for sports, tracksuits, sports shoes, clothing for cycling, footwear for cycling, shorts, shorts for cycling, sports jerseys, singlets for cycling'

The OD considered that the applicant's intention was to cover all the goods and services included in the alphabetical list of the classes concerned. Therefore, the OD compared the goods and services of the earlier marks with both (i) the general indications specified and (ii) any items in the alphabetical lists that did not fall within the natural and usual meaning of these general indications. The OD identified, inter alia, the following items in the alphabetical which were covered by the contested CTM but did not fall within the natural and usual meaning of these general indications:

'Class 25 – Boot uppers; cuffs; fittings of metal for shoes and boots; footwear uppers; hat frames [skeletons]; heelpieces for boots and shoes; heelpieces for stockings; heels; inner soles; non-slipping devices for boots and shoes; ready-made linings [parts of clothing]; shirt yokes; soles for footwear; studs for football boots [shoes]; tips for footwear; welts for boots and shoes;'

The general indications specified and the items listed above were compared with the earlier rights.

The Opposition Division by its decision partially upheld the opposition and rejected the contested trade mark for, inter alia, the following goods:

'Class 25 – Clothing, footwear, headgear; Clothes for sports, Tracksuits, Sports shoes, Clothing for cycling, footwear for cycling, Shorts, Shorts for cycling, Sports jerseys, Singlets for cycling. Boot uppers; cuffs; fittings of metal for shoes and boots; footwear uppers; hat frames [skeletons]; heelpieces for boots and shoes; heelpieces for stockings; heels; inner soles; non-slipping devices for boots and shoes; ready-made linings [parts of clothing]; shirt yokes; soles for footwear; studs for football boots [shoes]; tips for footwear; welts for boots and shoes.'

The applicant filed an appeal against the decision.

The Board found that the applicant determines the list of goods and services protection is sought for and the opponent defines the extent of the opposition by determining the contested goods and services. The Opposition Division was not called on to decide as regards the goods and services that were not opposed by the opponent (Article 41 CTMR) or as regards goods and services the applicant did not apply for (Article 26 CTMR). The Opposition Division considered that the application would cover, in addition to the goods specified, further goods as listed by the Opposition Division, and further, that the opposition was also directed against those additional



Case law



goods. The Board held that with respect to the additional items, the Opposition Division decided beyond the request (*ultra petita*).

The Board noted that the scope of the application and the extent of the appeal were limited to the goods and services listed by the applicant and the opponent, respectively. The application could not be rejected for the additional goods, which did not form part of the application and were not objected to by the opponent:

'Boot uppers; cuffs; fittings of metal for shoes and boots; footwear uppers; hat frames [skeletons]; heelpieces for boots and shoes; heelpieces for stockings; heels; inner soles; non-slipping devices for boots and shoes; ready-made linings [parts of clothing]; shirt yokes; soles for footwear; studs for football boots [shoes]; tips for footwear; welts for boots and shoes.'

The Board partially annulled the contested decision and dismissed the appeal for the remainder.

[Link to eSearch Case Law](#)

Decision of the First Board of Appeal of 2 October 2014 in case R 2015/2013-1 (DE)

Absolute grounds for refusal – Article 7(1)(b), 7(1)(c) and 7(2) CTMR – distinctiveness – descriptiveness – figurative mark – composed of distinctive and non-distinctive elements - disclaimer

The CTM applicant sought to register the figurative mark



for services in Class 35, namely 'marketing consultancy'. The colours 'black, magenta, cyan' were claimed.

The examiner rejected the application under Article 7(1)(b), (c) and 7(2) CTMR on the ground that the trade mark was descriptive and lacked distinctiveness for the services claimed.

The applicant appealed the examiner's decision and requested that the Board annul the contested decision.

The Board held that a trade mark composed of a distinctive figurative element and a non-distinctive slogan may be registered. In order to clarify the scope of protection, a disclaimer was requested by the Board. Thereupon the applicant waived protection for the word element 'Science for Brands'. The scope of protection of the application was correspondingly narrow. The application did not grant exclusive rights for the word element 'Science of Brands'.

The Board upheld the appeal and annulled the contested decision.

[Link to eSearch Case Law](#)

Decision of the Second Board of Appeal of 20 October 2014 in case R 569/2014-2 (EN)

Absolute grounds for refusal – Article 7(1)(b) and 7(2) CTMR – distinctiveness – meaning of the word elements

The CTM applicant sought to register the figurative mark



for various goods.

The examiner partially rejected the application under Article 7(1)(b) and 7(2) CTMR on the ground that the trade mark lacked distinctiveness for some of the goods covered.



Case law



The applicant appealed the examiner's decision.

The Board held that the message that the mark may have transmitted was somewhat strange and not exactly clear. Even if the mark were understood as 'ecological strength', 'ecology' was not basically something that might possess strength. The Board found that the expression 'ECO FORCE', as a whole, had a suggestive rather than a straightforward link in relation to the goods objected to.

The Office had also previously registered the word mark 'ECO-FORCE' under CTM registration No 8 777 005 covering partly identical goods. The Office had also registered the very slightly figurative mark *ecoforce* under CTM registration No 11 123 924 covering identical goods. Moreover, the Board noted that the General Court in 06.12.2013, T 361/12, Ecoforce, EU:T:2013:630, § 43 stated that the word elements of the marks 'ECOFORCE' and 'ECO FORTE' would be perceived as invented words overall, as they did not have an inherent meaning in any of the languages of the European Union.

Consequently, the Board upheld the appeal and annulled the contested decision. The trade mark was accepted for all the goods applied for.

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Decision of the Second Board of Appeal of 24 November 2014 in case R 719/2014-2 (EN)

Absolute grounds for refusal – Article 7(1)(b) CTMR – distinctiveness – meaningful expression

The CTM applicant sought to register the word mark 'MINIMAL FRAME, MAXIMUM EXPERIENCE!' for goods in Classes 8, 9, 21 and 28.

The examiner rejected the mark under Article 7(1)(b) CTMR for a range of goods in Classes 9 and 28, because it constituted a 'meaningful expression' which referred 'to the fact that the smallest frame may give or convey the greatest experience'.

The applicant appealed the contested decision and requested that the Board withdraw the objections raised against the refused goods.

The Board found that even after considerable reflection, the mark remained opaque to any sensible interpretation. The first clause in 'MINIMAL FRAME, MAXIMUM EXPERIENCE!' referred to an object; but what that object might be remained unclear. The second clause referred to a subjective experience, but what the nature of that experience was, was also unclear. Furthermore, the examiner did not explain how a 'frame' might cause an 'experience'. The Board also added that even if some kind of sense were made of the objection, it was impossible to relate it to, inter alia, 'ink cartridges', 'toner cartridges', 'switches'; 'microphones', 'magnetic tape cassettes', which were just a few of the wide range of goods for which the mark was rejected. Such goods were not frames, nor related to frames, nor triggered a 'maximum' experience'. In fact, the examiner did not establish any meaningful link with the mark for any of the goods in question. In the Board's view, the mark 'MINIMAL FRAME, MAXIMUM EXPERIENCE!' had no clear, direct or sensible meaning with respect to the goods, either laudatory or otherwise. Taken as a whole, the mark was vague and non-specific. How could a 'small frame' of data give a 'maximum experience'? Something vital was missing to endow the mark with a sensible meaning. Consumers would remain guessing as to its import. Moreover, the mark was not without a degree of fancifulness. The adjectives 'MINIMAL' and 'MAXIMUM' formed a playful verbal antithesis that would catch the consumer's eye. The expression was puzzling, playful and with an element of surprise. The public would have to make a mental effort to interpret the mark; and even then,



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they would likely remain unsure as to its meaning. Although the existence of features that were surprising or unexpected were not a necessary condition for establishing that a slogan had distinctive character, the fact remained that, as a rule, the presence of such characteristics would endow a mark, as in this case, with distinctive character. Thus the mark in question was found to possess distinctive character for the goods in question.

Consequently, the Board upheld the appeal and annulled the contested decision.

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Decision of the Fifth Board of Appeal of 17 October 2014 in case R 1580/2014-5 (DE)

Absolute grounds for refusal – Article 7(1)(b) and 7(2) CTMR – lack of distinctiveness – figurative mark – lack of reasoning Article 75(1) CTMR

The CTM applicant sought to register the figurative mark



for goods and services in Classes 7, 9, 11 and 42.

The examiner rejected the application under Article 7(1)(b) and 7(2) CTMR on the ground that the trade mark lacked distinctiveness for the goods and services covered.

The applicant appealed the examiner's decision.

The Board annulled the contested decision due to its lack of reasoning since it stated that the figurative CTM lacked distinctiveness without examining each of the claimed goods



and services.

The Board remitted the case to the Examination Division for further prosecution and ordered the reimbursement of the appeal fee.

[Link to eSearch Case Law](#)

Decision of the First Board of Appeal of 8 October 2014 in case R 727/2013-1 (EN)

Opposition – Article 8(1)(b) CTMR – limitation request in Class 35 not allowed

The CTM applicant sought to register the figurative mark



for goods and services in Classes 32, 33 and 35.

The opponent filed an opposition pursuant to Article 8(1)(b)



CTMR based on an earlier figurative mark registered in Spain for goods and services in Classes 33 and 35.

The Opposition Division partially rejected the contested trade mark on the ground that there was a likelihood of confusion for part of the contested goods in Classes 32 and 33. The application was allowed to proceed for the remaining goods and services in Classes 33 and 35.

The applicant first requested the limitation of the services in Class 35 and then filed an appeal against the contested decision. It requested that the Board set aside the decision in its entirety. The opponent did not file an ancillary appeal.



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The Board stated that Article 8(3) BoA-RP allows an extended defence to the respondent to the appeal for the goods and services where it could have filed its own appeal but did not (a so-called 'ancillary appeal') however, only in the observations to the appeal, no later. In this case the defendant remained silent when requested to file observations in reply to the appeal, but then it replied to a communication from the Rapporteur and requested that the decision be annulled for the goods and services it had lost. This request was belated. Further, the Board held that the applicant of the trade mark application, e-wine, wished to limit the services that were reproduced in the class heading of Class 35 to specific retail services for wine. However, such a limitation was not allowed as a) the services were not covered by the literal meaning of the services mentioned in the application, and b) were neither in the alphabetical list. Interpretation of the 'Praktiker', 'IP Translator' and 'Netto' judgments, *inter alia*.

Consequently, the Board rejected the applicant's limitation and appeal.

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Decision of the First Board of Appeal of 3 November 2014 in case R 2063/2013-1 (EN)

Opposition – Article 8(1)(a) and (b) CTMR – distinctive force of an earlier trade mark different at the date of filing than at the date of the opposition

The CTM applicant sought to register the word mark 'PostModern', for, *inter alia*, services in Class 39.

The opponent filed an opposition pursuant to Article 8(1)(a) and (b) CTMR based on the earlier word marks 'POST' and 'Deutsche Post' registered for, *inter alia*, services in Class 39.



The Opposition Division partially rejected the contested trade mark on the ground that there was a likelihood of confusion for part of the contested services in Class 39.

The applicant filed an appeal against the contested decision. It requested that the Board annul the opposition in its entirety.

The Board held that the distinctiveness of a trade mark may have been sufficient for registration at its filing date (and cancellation, therefore, was not possible). However, at the relevant date of the opposition based on that trade mark, its distinctive force might be lower. Thus, there was no likelihood of confusion between 'PostModern' and 'Post'.

Consequently, the Board upheld the appeal and annulled the contested decision.

[Link to eSearch Case Law](#)

Decision of the Fifth Board of Appeal of 13 November 2014 in case R 779/2014-1 (EN)

Opposition – Article 8(1)(a) and 8(5) CTMR – effect of reputation

The CTM applicant sought to register the figurative mark



for goods in Class 9.

The opponent filed an opposition pursuant to Article 8(1)(b) CTMR (likelihood of confusion) and Article 8(5) CTMR (extended protection for trade marks with reputation) based on the earlier rights 'VOLVO' registered for a wide range of goods and services, *inter alia*, 'computer software' in Class 9.

The Opposition Division rejected the opposition in its entirety



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on the ground that the signs at issue were not similar.

The opponent filed an appeal against the contested decision.

It was the Boards' third decision in the 'Solvo' case, after two annulments by the General Court.

The Board examined the effect of the 'Volvo' trade mark's reputation, following the steps of an examination set out in T-586/10 'Only Givenchy', in accordance with C-252/07 'INTEL'. A global assessment of five factors had to be carried out in order to establish the presence or absence of a link between the CTM applied for and the earlier 'VOLVO' marks. In the present case the Board found that the necessary link for applying Article 8(5) CTMR was missing.

Consequently, the Board dismissed the appeal and allowed the application to proceed to registration.

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Decision of the First Board of Appeal of 3 November 2014 in case R 1774/2013-1 (EN)

Opposition – Article 8(1)(b) and 8(5) CTMR – IP Translator case, goods and services not covered by any of the class headings

The CTM applicant sought to register the word mark 'Vinagra' for goods and services in Classes 32, 33, 35 and 39.

The opponent filed an opposition pursuant to Article 8(1)(b) CTMR (likelihood of confusion) and Article 8(5) CTMR (extended protection for trade marks with reputation) against all the goods and services based on the earlier CTM 'VIAGRA' filed for Class 5.

The Opposition Division partially upheld the opposition and



rejected the contested trade mark for some of the goods in Classes 31, 32 and 33.

The opponent filed an appeal against the opposition decision.

The Board held that the Opposition Division strayed off the right track listing goods not covered by any of the class headings of the applicant (who did not reply to the President's communication or any other communication) and mentioned the goods not covered by any of the class headings of a different class which the applicant had never applied for. The Opposition Division rejected the opposition in part, including those goods not covered by any of the class headings. The case aptly illustrates why the class heading without a clearly defined list of goods and services does not work.

The Board annulled the contested decision to the extent that it allowed the application to proceed and rejected the application for all the remaining goods and services.

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Decision of the Grand Board of Appeal of 10 October 2014 in case R 574/2013-G (DE)

Cancellation proceedings – Articles 52(1)(a) and 7(1)(c) CTMR – geographical indication

The CTM proprietor registered the word mark 'SUEDTIROL' for services in Classes 35, 39 and 42.

The cancellation applicant filed a request for a declaration of invalidity against the CTM based on Article 52(1)(a) in conjunction with Article 7(1)(c) CTMR. The request was based on the ground that 'SUEDTIROL' is a geographical indication for the region 'Südtirol' in northern Italy.

The Cancellation Division rejected the declaration of invalidity



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on the ground that 'SUEDTIROL' was not understood as a geographical indication for the services claimed.

The cancellation applicants filed an appeal.

The First Board referred the appeal to the Grand Board to clarify the issue of the registrability of geographical indications, in view of the Cancellation Division's earlier contradictory decision 'Alto Adige'.

The Grand Board held that 'SUEDTIROL' may be understood as the geographical indication of the services covered.

The Grand Board upheld the appeal and declared the CTM invalid for all the services registered.

Decision of the Fifth Board of Appeal of 13 November 2014 in case R 40/2014-5 (ES)

Cancellation proceedings – Articles 52(1)(a), 7(1)(a) and (b) CTMR – indication of origin

The CTM proprietor registered the figurative mark



for goods in Classes 14, 20 and 21 (a representation of a mosaic in several colours, which was to be applied to the surface of the goods covered).

The cancellation applicant filed a request for a declaration of invalidity against the CTM based on Article 52 CTMR in conjunction with Article 7(1)(a) and (b) CTMR.

The Cancellation Division rejected the declaration of invalidity.

The cancellation applicant appealed the Cancellation Division's decision.

The Board found that the CTM depicted a mosaic which was no different from a common mosaic according to its definition. The multiple colourful pieces in the mosaic did not follow a systematic structure. The borders of the device were not clearly defined, so that it would be perceived as a part of a larger mosaic. The mosaic would be perceived as having a decorative or aesthetic function (although not a pattern), but would not serve as an indication of commercial origin. The CTM proprietor did not demonstrate distinctiveness acquired through use (Article 7(3) CTMR) with the documents submitted.

The Board annulled the Cancellation Division's decision and rejected the CTM registration in its entirety.

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Decision of the Third Board of Appeal of 10 October 2014 in case R 1682/2013-3 (EN)

Registered Community Design – invalidity proceedings – Articles 4 to 9 CDR and Article 25(1)(3) CDR – trade mark elements on design, plain packaging versus packaging with verbal and graphic elements

The design holder was the holder of the registered and published Community design for 'packaging for food' represented with the following view:



The invalidity applicant filed an application for a declaration of invalidity pursuant to Articles 4 to 9 CDR and Article 25(1)



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(e) CDR. Amongst others, the invalidity applicant filed the following earlier international TM as evidence:



The Invalidity Division rejected the application for invalidity on, *inter alia*, the grounds that the RCD had a thin colourful foil lid and a colourful label on its side. Therefore, the designs were held to be sufficiently dissimilar.

The invalidity applicant filed an appeal against the Invalidity Division's decision and requested that the Board annul the contested decision.

The Board found that the informed user did not take into account trade mark information on the packaging when comparing it with plain packaging in the overall impression.

Therefore, the Board upheld the appeal and declared the RCD invalid.

[Link to eSearch Case Law](#)

Decision of the Third Board of Appeal of 8 September 2014 in case R 1408/2012-3 (DE)

Registered Community Design – invalidity proceedings – Articles 5 and 6 CDR and Article 25(1)(3) CDR – proportions of design not necessarily lead to a different overall impression

The design holder was the holder of the registered and published Community design for 'cans [for beverages]' represented with the following view:



The invalidity applicant filed an application for a declaration of invalidity pursuant to Articles 5 and 6 CDR and Article 25(1) (b) CDR. Amongst others, the invalidity applicant filed the following earlier designs as evidence:

The Invalidity Division rejected the application for invalidity.



The invalidity applicant filed an appeal against the Invalidity Division's decision and requested that the Board annul the contested decision.

The Board found that the informed user was a person involved in the beverage industry who dealt with the bottling of beverages. The freedom of the designer was limited to the extent that the standard form of cans is cylindrical. The different proportions of the designs did not necessarily lead to a different overall impression. A group of cans was not a design within the meaning of Article 3(a) CDR.

Consequently, the Board annulled the contested decision and declared the RCD invalid because of its lack of individual character.

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