

Alicante News

Up to date information on IP and OHIM-related matters



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Community trade mark applications will now only be examined after they are paid for

We are changing our examination workflow to increase efficiency

From November 24, OHIM will only examine trade mark applications and process any mail related to them after they are paid for. This means we can be more efficient as an Office, as we will no longer examine applications that ultimately will never be paid for.

OHIM is a European Union agency that serves businesses across the EU. We have a duty to all those who use our services to be as efficient as possible – and to pass those efficiency gains back to our users.

Historically 4% of the Community trade mark applications we receive are examined but not paid for – and this figure is increasing. That means we lose time and we lose efficiency.

By linking the examination of an application to its payment, we will be making sure that files that are paid for are treated in a timely manner and we will avoid examining files that will never be paid for.

Fast Track processing of trade mark applications

From November 24, and coinciding with this change, our users will have the option of having their applications published more quickly with our new “Fast Track” procedure, free of charge. The Fast Track means that the trade mark application will be published in half the time or less, as compared to regular applications (which are published in 8 to 11 weeks after payment).



The Fast Track also means no classification deficiencies – our users have to select their goods and services from a database of terms already accepted by OHIM and by almost all national intellectual property offices of the European Union.

For an application to qualify for, and remain in, Fast Track applicants need to, among other conditions:

- Select the goods and services from OHIM's harmonised database, which contains pre-validated and pre-translated terms.
- Pay at the end of the application process or immediately after submission.

Additionally, the application should not trigger any deficiency finding at the time of submission or during its examination by OHIM staff.

More details will be available soon. Check the news section of OHIM website or your User Area's news tab.

FREQUENTLY ASKED QUESTIONS

Examination workflow change

1. I would like my application to be examined as soon as I submit it, what can I do?

To have your application examined immediately, you need to pay at the payment step of the application process or, if you are paying by bank transfer you need to pay immediately after submitting your application.

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You can pay via:

- **Credit card:** The payment will be deemed as paid immediately and we will process your trade mark application as soon as we get it.
- **Bank transfer:** You will need to transfer the fee immediately after applying. Please also bear in mind that we do not issue a request for payment. It is up to you to take the appropriate steps to order the transfer. Please also ensure that you indicate the code provided in the online form in order to ensure the identification of your payment.
- **OHIM current account:** Current account users are generally debited all fees and charges automatically on the very last day of the payment period. If you are a current account user and you would like your application to be examined as soon as you file it, you need to ensure that the 'Debit now' box is ticked in the payment step.

2. I am a current account user, how can I pay before the end of the one-month period?

If you are a current account user and you would like to be debited before the end of the one-month period, you should indicate this by leaving the 'Debit now' box ticked. If you have already submitted your application, use a dedicated action in electronic communications 'Debit Now Request (Current Account Holders only)', indicating the application number and requesting the immediate debit of your current account. Do not forget to leave the 'Debit now' box ticked for future applications.

3. Do I still have one month to pay for my application?

Yes, you do. Trade mark applicants can wait until this one-month period elapses. However, our examiners will deal with the applications and their related communications only when they have been paid.

4. If a deficiency is raised regarding my application, can I get my money back?

No, once the fee is paid it will not be refunded.

Fast Track processing of applications

5. How can my application be Fast Tracked?

To have your application processed as Fast Track, you will need to pay at the moment of filing or immediately afterwards in case of payment by bank transfer. You will also need to use OHIM's database of accepted terms for classification purposes.

This service will be available from November 24.

6. How do I know that my application has been put on the Fast Track?

The Five-step form has been designed for the Fast Track, so it presents you with mandatory fields and default options that ensure your application can be processed as swiftly as possible.

Our Advanced form has been designed to alert you when your application is a Fast Track one and when it is not. If your application does not fulfil any of the Fast Track conditions, the form will flag this up. You can then decide whether to make the corrections indicated in the form or just proceed with a regular application. Regular applications are normally published 8 to 11 weeks after payment.

7. Can an application drop out of the Fast Track?

Although some applications may comply with the conditions of Fast Track at the time of filing, they may lose their Fast Track status later on. This can result from a deficiency found during the absolute grounds examination, for example, like the fact



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that the trade mark you would like to register is not **distinctive enough**.

Other reasons can be, for example:

- Late payment
- A request of limitation of goods and services
- Other deficiencies (like missing priority or seniority attachments)

Fast Track: Full conditions

1. The applicant needs to be domiciled in the European Union (EU) or, if not in the EU, a **valid representative** has been identified.
2. The trade mark should not be a collective trade mark.
3. You do not request a National Search in your application.
4. Regarding priority or seniority claims, either:
 - There are no priority / seniority claims, or
 - If a priority / seniority claim is indicated, the trade marks on which the claim is based can be imported from the TMView database during the application process, or
 - If a priority / seniority claim is indicated and the associated trade mark(s) are not in **TMView**, the corresponding certificate needs to be attached.
5. If exhibition priority is claimed, a Fast Track application is still possible if an attachment containing the corresponding certificate is provided.
6. The trade mark is one of the following types: word mark / figurative / 3D / sound.
7. When the trade mark is figurative or 3D and the colours are claimed, only the colours as written in the form can be used (you cannot specify a custom color).
8. When the trade mark is figurative, 3D or sound, the relevant attachments are included.
9. No mark description has been provided.
10. No disclaimer has been provided.
11. All the terms in the list of goods and services are selected from the database of terms already accepted by OHIM.
12. Payment can be made via any of the accepted payment methods. However, payment via a third party's current account is NOT compatible with the Fast Track option.
13. The following conditions shall apply in the payment of fees:
 - Credit card: no particular requirement.
 - For bank transfers: the applicant shall 1) use the Payment Transaction Code generated by the form and the trade mark number to identify the file, (2) shall commit to order the transfer immediately, and (3) it is recommended to provide a separate payment for each application submitted.
 - For current account holders the applicant has to select "Debit now" in the payment form.
14. When the language of the application is not one of the five languages of OHIM, the applicant accepts the translation provided by the Office in a second language selected from one of the accepted five languages.



The James Nurton Interview



Gert Würtenberger, WürtenbergerKunze, is the new President of German IP association GRUR. He tells James Nurton how he has helped shape European trade mark law, why he is passionate about plant varieties and why he believes IP lawyers must specialise more and more.



Gert Würtenberger

How did you become interested in IP?

My background is in legal studies at the Ludwig Maximilian University in Munich. I first became acquainted with IP law early in my studies when I attended a lecture by the late Director of the Max Planck Institute, Professor Baier, in 1976. The aim of the lecture was to introduce young students to IP law. Only about six or eight students attended.

After my exams I became re-acquainted with IP law, when I worked for a Japanese law firm in Tokyo, which advised on the merger of Yashica and Kyoto Ceramics to become Kyocera, in which IP rights played a major role. At the end of 1983 I decided to concentrate on IP and related subjects.

I joined a patent firm in 1984 and became an equity partner in 1989. I left two years ago with one of my partners, also a lawyer, to set up our own firm, WürtenbergerKunze.

Why did you set up your own firm?

We think the IP profession faces some major challenges in the next five to 10 years. Patent attorneys are driven by different aspects, as they focus on prosecution, whereas we focus equally on prosecution and litigation. We think that the overlap between prosecution and complex litigation will increase further. Moreover, to my perception, certain branches of industry, such as those in the electronics or crop sciences field, tend to file fewer patents than they did in the past and tend to concentrate more vigorously on the defence of those patents for which they have obtained protection.

I've observed this trend in my practice. In 1985 there were hardly any litigation issues, but the number of cases multiplied drastically over the past 10 years. I also think that in the future even more specialisation will be necessary than is the case today. It will no longer suffice to be a general IP lawyer.

What issues do you expect to become more important?

One aspect is the overlap of trade marks and other IP rights, which is actually the subject of an INTA conference in Munich in December. This is a somewhat unclarified field of law, which will present a big challenge in the future. There is potential overlapping between trade marks and designs, but also between trade marks and company names, and trade marks and copyright (especially as concerns device trade marks).



The James Nurton Interview



The point to remember is that different rights have different aims: a trade mark indicates source, whereas a design right protects, for example, the aesthetic appearance. In Germany, the overlap between copyright and designs was recently addressed by the Federal Supreme Court in the *Geburtstagszug* (Birthday train) case, which substantially broadens what is protectable under the copyright law. This had not been expected by everyone.

What kind of IP work do you do?

Our firm's practice focuses on trade mark prosecution and litigation as well as unfair competition litigation. While my emphasis is on plant variety prosecution and litigation, my partner focuses mostly on copyright and patent work. We have a strong international business and I spend about half my time on prosecution, and half on litigation.

What do you think of the Community trade mark system?

On the whole it works very well. As with all systems, there are always new developments to which the system has to be adjusted. The revision of the Community law on trade marks shows that there are certain aspects that need to be improved. The Commission proposal on the revision of the CTMR and the Harmonisation Directive suggests many good amendments, though specific aspects still need more scrutiny. One concern is that it does not take up the issue of rights to a company name in relation to trade marks. For complete harmonisation, this must be included.

Another issue is goods-in-transit. I recently spoke on this topic in Japan and it is clear that this is an issue of major interest. One other area concerns sanctions under Article 102. Injunctions are regulated, but all other claims are subject to the national law of the Community trade mark court. I think if you want to achieve harmonisation, you have to provide unified sanctions.

What about the practical aspects at OHIM?

The Office has considerably improved in terms of speed and customer support. Moreover, the opposition procedure is well organised. One thing that is rather problematic is that objections from examiners often give the impression that the opinion is based on copy-and-paste without addressing the actual concerns about the specific trade mark. That is particularly a problem for non-European applicants who are accustomed to examiners who provide broader explanations.

What about the CJEU?

It appears that the Court has developed a better feeling for the importance and the objectives of IP rights than was the case at the introduction of the European IP protection system.

A very big problem is the timeframe. I'm awaiting a judgment in a plant variety matter, for which the Advocate General's Opinion will need seven to eight months and a further two to three months for issuance of the judgment. This matter arises from proceedings that commenced in 2008. The problem lies in the system: it is an enormous organisation and the work, in particular translation, takes time.

What have been some of the interesting cases you have worked on?

I handled one of the first colour trade mark cases after *Libertel* – the *KWS Saat* case – and also the *Kaul* case, which forced OHIM to change its practice with regard to submitting new evidence in appeal proceedings. It is now at the Boards' discretion to accept new evidence, and if you have reasonable grounds they will normally do so.

I am also working on a referral to the CJEU of a matter pending before the Court of Appeal in Düsseldorf, which I think will be the first case where the CJEU has the opportunity to interpret the damages to be awarded in the light of Article 13 of the



The James Nurton Interview



Enforcement Directive. It is a plant variety infringement case, where the claim is for additional damages, above the licence fee. This decision should help to develop an EU-wide concept of damages.

What led to your interest in plant varieties?

The founding attorney of my previous firm worked in this area. When he retired, as nobody else appeared to be interested in assuming this role, I did! I found it to be a fascinating area of law, which is fast developing (I have about five or six matters pending at the EU courts). There is also the overlap in the biotech field between patents and plant varieties: what is the appropriate protection for certain inventions?

I have written and researched in this area quite a bit in recent years. Most of my academic interests have arisen either from my practice or from reading contributions in legal journals, such as the IP Quarterly, JIPLP or the GRUR magazines, which sometimes left issues unanswered or included thoughts with which I disagreed.

Certain disputes have a deep root in the system and benefit from thorough research on the scientific side, especially where the law is developing rapidly. You could say this scientific work is the salt in the soup of my everyday practice!

What does your role as GRUR President involve?

It was a great privilege to be appointed President of GRUR in September. GRUR is a very important organisation, with members who are academics and practitioners. Its mission is not only to promote education about IP but, in particular, also to issue position papers on draft legislation, directives and treaties and to actively contribute to the development and application of law. The work is determined by special committees and working groups and covers all areas relevant to the protection of intellectual property, including trade marks, unfair competition, patents, copyright and plant

varieties, as well as questions of EU and international law.

My term as President lasts for three years. It is a serving position to assist those committees and groups in maintaining and developing their task. We have a discussion scheduled for the last week of October, when we will review upcoming projects. I expect these will include the Unitary Patent and UPC, as well as the trade mark reforms and the proposal for a directive on trade secrets.

I think what makes GRUR different is its neutrality: it is not driven by industry or interest groups, but takes a purely scientific approach to practical problems. The President's role is, *inter alia*, to foster the organisation's reputation and its unique role as a neutral source of valuable input in the development of IP law. It took me a couple of weeks to think about whether the former President's shoes were too big to fill. However, I received a great deal of encouragement from within the IP community and now look forward to this challenging task.



Community Trade Mark



OHIM clarifies its practice regarding the proof of applicable law in Article 8(4) cases

In addition to the earlier trade marks specified in Article 8(2) CTMR, non-registered trade marks and other signs protected at Member State level used in the course of trade as 'business identifiers' of more than mere local significance can be invoked in an opposition provided that such rights confer on their proprietors the right to prohibit the use of a subsequent trade mark. Article 8(4) CTMR governs this relative ground for refusal.

Unlike other grounds, Article 8(4) CTMR does not describe the conditions applicable to the acquisition and scope of protection of the earlier right being invoked. The particulars of such conditions and scope of protection have to be found in the (national or EU) law protecting the earlier right.

On 27/03/2014, the judgment **C-530/12 P, 'Representation of a hand'** was delivered by the Court of Justice. The judgment deals, among others, with the Office application of national law.

In light of this judgment, the KC Relative Grounds has considered necessary to clarify its practice on the proof of applicable law governing the sign in Article 8(4) CTMR cases. The modifications, introduced in the Guidelines under Part C: Oppositions, Section 4: Rights under Article 8(4) CTMR, intend to make clear who bears the burden of proof of the applicable law, the means of evidence and the standard of proof in light of the case-law of the Court and the decisions of the Boards of Appeal.

As regards the **burden of proof**, the Guidelines follow well-established case-law and Office practice that it is the opponent who bears the burden of providing the relevant national law

and showing that its claim would succeed under national law. The conclusions of the 'Representation of a hand' judgment have also been incorporated: the Court has indicated that the Office enjoys a **power of verification** of the particulars of the national law claimed by the opponent. Such power of verification may imply introducing new and/or additional elements, respecting the parties' rights to be heard. However, it does not discharge the opponent from the burden of proof.

Regarding the **means of evidence and standard of proof**, the Guidelines now provide very detailed information on what an opponent must provide in terms of:

- **The applicable law:** the opponent must submit the relevant provisions on the conditions governing the acquisition of the rights and on the scope of protection of the right. The Guidelines include information on the precise form in which the particulars of the applicable law have to be submitted. Except in cases where European Union legislation is being invoked, a copy of the relevant provisions of the law in the original language and a translation are required.
- **The fulfilment of the conditions:** the opponent must put forward a coherent line of argument as to why it fulfils the conditions related to the acquisition and scope of protection of the right. In line with current Office practice, a mere reference to the applicable law itself is not considered sufficient.

For the purposes of clarity in the application of these rules, the Guidelines list a **number of situations** where the Office would reject an opposition because any of the above requirements is not met. For instance, an opposition will be rejected if:

- The opponent invokes a right but does not include a reference to any specific national law and/or legal provision protecting that right (e.g. the opponent only



Community Trade Mark



indicates that the opposition is based on a commercial designation in Germany or that the opposition based on a commercial designation in Germany is protected under DE TMA); or

- The opponent provides the content of the legal provision only in the language of the proceedings but not in the original language (e.g. the language of the proceedings is English but the text of the DE TMA is submitted only in English, not in German).

Finally, in line with current practice, the **Table on national rights that constitute 'earlier rights' in the sense of Article 8(4) CTMR** is included at the end of this section of the Guidelines. It should be noted that this table, based on information and feed-back received from trade mark offices and user associations, is made available **for information purposes only** and does not discharge the opponent from the duty of providing evidence of the applicable national law.

The revised section of the Guidelines will enter into force on **01/12/2014**. National offices and users associations will be able to comment in any event in the framework of the normal revision cycle. The new practice will be applicable to pending and future proceedings where a final decision has not been adopted yet.



Registered Community Design



Judgment of the General Court of 9 September 2014 in Case T-494/12, 'Biscuit'

Judgment of the General Court of 9 September 2014 in Case T-494/12, appeal against the decision of the Third Board of Appeal of OHIM in Case R 914/2011-3 in relation to invalidity proceedings (case ICD 7120) of registered Community design No 001114292-0001 (RCD), as represented in a single view below.

The RCD, registered and published in 2009, was challenged in invalidity proceedings 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 for falling in the exclusion from protection of designs solely dictated by their technical function pursuant to Article 8(1) CDR. The applicant submitted a range of earlier designs, alleging that they were an obstacle to the novelty and individual character of the RCD (three are shown below). The applicant also claimed that the appearance of the design was solely dictated by its technical function, as the only reason for registering the biscuit in the view showing it broken in half was to demonstrate that it had a chocolate filling, a feature which would not be visible if the biscuit were portrayed unbroken.

The grounds of invalidity were found to be unjustified and the invalidity application was dismissed, mainly because the claimed technical function referred to the representation of the design rather than to the product in which the design was incorporated; the earlier designs were not found identical, and the RCD was also found to produce a different overall impression on informed users over all the earlier designs submitted. The decision was appealed.

The Third Board of Appeal found that the RCD lacked individual character with respect to the earlier designs shown below and declared the RCD invalid. The issue of technical function was abandoned in favour of the argument that the chocolate filling shown in the representation of the design was not visible in the biscuit during normal use pursuant to Article 4 CDR. The Third Board of Appeal confirmed that the filling did not contribute to the appearance of the whole biscuit when unbroken, and it did not take this into consideration in its assessment of individual character. According to the Third Board of Appeal, the RCD did not produce a different overall impression on informed users from that produced by the earlier designs.

The RCD holder appealed to the General Court, contesting the assessment of the individual character of the RCD. The holder further claimed that the Third Board of Appeal, when excluding the biscuit filling, applied incorrectly Article 4(2) CDR because the biscuit was not a complex product and alternatively, even if Article 4(2) CDR and the notion of 'normal use' were to apply in the case, the filling was part of the normal presentation of the biscuit when advertised, to show customers what was inside, and therefore the filling contributed to the appearance of the product and should be taken into consideration.

The General Court confirmed the decision of the Third Board of Appeal and dismissed the appeal. It found that:

- The concept of 'normal use' is relevant only when an assessment is to be made of whether protection may be given to a design applied to or incorporated in a product which constitutes a component of a complex product within the meaning of Article 3(c) CDR.



Registered Community Design

- The biscuit was not a complex product because it was not composed of multiple components which could be replaced permitting disassembly and re-assembly.
- The scope in which the biscuit had to be assessed was therefore defined as under Article 3(a) CDR rather than Article 4(2).
- Although the contested decision referred to Article 4(2) incorrectly, the conclusions in the given decision were not affected by this.
- The chocolate filling inside the biscuit became visible only if the biscuit was broken, therefore it did not contribute to the appearance of the product.
- Only the visible characteristics of the product portrayed by the contested design may be taken into account in the assessment of its individual character.
- The irregular, rough surface on the outside of the biscuit, its golden colour, round shape and the presence of chocolate chips were characteristics that were common to the RCD and the earlier designs and decisive for the overall impression on informed users, as people familiar with this type of product, offering or eating it regularly.
- The smoother surface of the contested design when compared to the first and third designs, together with the differences relating to the number, specific dimensions and somewhat prominent presence of the chocolate chips on each of those designs and on the contested design did not confer individual character on the latter. In view of the designer's considerable freedom, these differences were not liable to produce a different overall



impression on informed users in such a way as to benefit the contested design. The Third Board of Appeal, therefore, did not err in finding that the contested design lacked individual character.

The CJEU judgment is in [French](#) and in [English](#)



Contested RCD 001114292-111



Three earlier designs

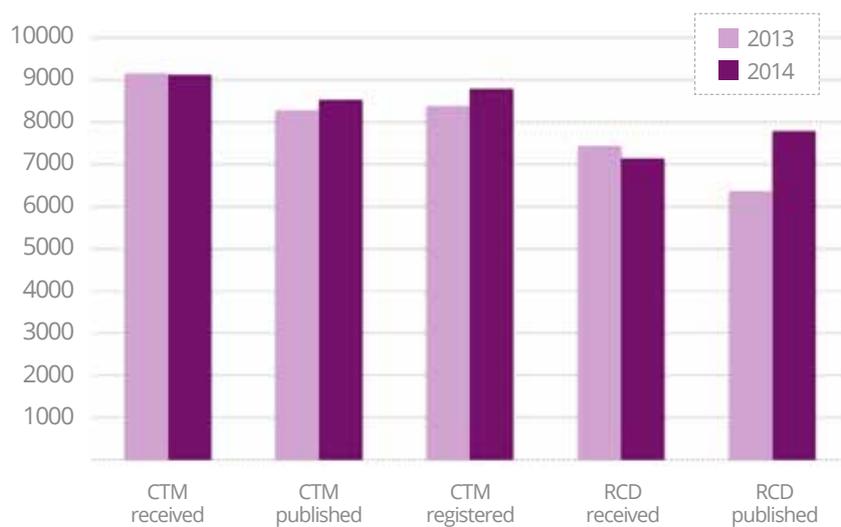


Statistical Highlights



Monthly statistical highlights September*	2013	2014
Community Trade Mark applications received	9 151	9 126
Community Trade Mark applications published	8 271	8 528
Community Trade Marks registered (certificates issued)	8 378	8 785
Registered Community Designs received	7 435	7 129
Registered Community Designs published	6 354	7 786

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





ETMDN Updates



TMClass additions

As of 20 October 2014, the Icelandic Patent Office ([ELS](#)) and the Intellectual Property Office of Montenegro ([IPOM](#)) have joined [TMclass](#), the goods and services classification tool.

These latest additions bring a total of 41 national and regional IP Offices, including OHIM and WIPO, into the tool.

TMclass now offers users the opportunity to search and translate terms to and from any of the 31 available languages, including Icelandic and Montenegrin.

First trade marks in Arabic now searchable in TMView

The National Institute for Standardization and Industrial Property of Tunisia ([INNORPI](#)) has recently made its trade mark data available to the TMview search tool.

This last extension brings the total number of offices participating in TMview to 36 and with the addition of more than 65.000 Tunisian trade marks, TMview now provides information and access to almost 24,5 million trade marks in total.

Since the introduction of TMview on 13 April 2010, the tool has served more than 9 million searches from 214 different countries, with users from Spain, Germany and Italy among the most frequent visitors.

You can find out more on TMview at <https://www.tmdn.org/tmview>

New Cooperation Fund implementations

A wave of Cooperation Fund implementations has taken place throughout October across EU national IP offices. [Latvia](#) implemented trade mark e-filing, while the [Lithuanian](#) and [Romanian](#) national IP offices both went live with design e-filing. This means that these offices now have a completely new front office system, offering a full electronic filing experience for their users.

Meanwhile the [Austrian IP office](#) has gone live with CESTO – the Common Examiner Support Tool. CESTO provides examiners with automated searches performed in several databases to help them in gathering all information relevant to absolute grounds examination.

The tool also searches in the international non-proprietary names database for pharmaceuticals, geographical indications and data from the Common Plant Variety Office, emblems and other entries registered by WIPO and other national databases for the examiners working on absolute grounds.

The latest wave of implementations was carried out by national office experts in conjunction with teams from the [Cooperation Fund](#).



More News



13th Design Liaison Meeting

The 13th Liaison Meeting on Designs between OHIM and experts from the national and regional IP offices took place at OHIM on 13 and 14 October.

Among the topics on the agenda, participants received an update on the convergence projects on designs (CP6 & CP7), recent developments of the cooperation fund activities and on the process for the revision of the Guidelines of the Office.

12th Liaison Meeting on Trade Marks

The 12th Liaison meeting on trade marks between the Office for Harmonisation in the Internal Market and experts from national and regional IP offices took place on 7-8 October in OHIM's headquarters in Alicante.

Delegates heard updates on the convergence programme projects (harmonisation of TM classification practice of Goods and Services; Absolute Grounds - Figurative Marks; Relative Grounds - Likelihood of Confusion; convergence projects on designs).

Presentations were also given on a number of other topics including the cooperation fund and international collaboration projects. All EU national and regional IP offices attended the meeting, along with representatives from six non-EU countries, the European Commission and WIPO.

Representatives from four user associations also attended the event.

Common Communication on the Common Practice (Likelihood of Confusion)

As from 2 October 2014, the IP offices implementing the Common Practice have published on their respective websites a Common Communication detailing the Common Practice of the 25 EU and three non-EU implementing offices.

To arrive at a Common Practice, participating offices closely analysed and converged regarding non-distinctive/weak components of marks for the purpose of assessing likelihood of confusion, assuming that the good and/or services are identical, in particular:

- Define what marks are subject to assessment of distinctiveness
- Determine the criteria to assess the distinctiveness of the mark
- Determine the impact on Likelihood of confusion when the common components have a low degree of distinctiveness
- Determine the impact on Likelihood of confusion when the common components have no distinctiveness

The details of the Common Practice can be found in the [Common Communication document](#).

The Common Practice is the result of collaboration between trade mark offices in the EU in the context of the Convergence Programme and aims at increasing transparency, certainty and predictability for examiners and users alike.

OHIM will incorporate the Common Practice in its Guidelines. In particular, the Common Practice will be reflected in the following sections of the Guidelines:

- Part C, Opposition, Section 2 Double identity and Likelihood of Confusion, Chapter 4 Distinctiveness
- Part C, Opposition, Section 2 Double identity and Likelihood of Confusion, Chapter 8 Global Assessment



More News



Business in the Cloud: the 11th OHIM INTA Industry Training Seminar

OHIM hosted the 11th edition of the annual OHIM-INTA Industry Training Seminar on 6 October in Alicante. The theme chosen for this year's seminar was "**Business in the Cloud**", the aim being to get a better understanding of this new and dynamic economic sector. Industry was represented by IBM, ATOS, Microsoft and Oracle.

As usual, the industry speakers accepted to share with us their business strategies related to IP (searching and filing tactics, prosecution matters etc.) to allow participants from OHIM and IP Offices to get an insight into the IP needs of our business users.



Case law



Luxembourg trade mark and design news

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

Case C-435/13 P; Erich Kastenholtz v OHIM, Judgment of 18 July 2014, Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Admissibility, Burden of proof, First time on appeal, General reference to previous submissions, Lack of reasoning, Copyright, Design

FACTS: The General court (GC) confirmed the decision of the Board of Appeal (BoA) which rejected the invalidation request against a registered Community design in the case T-68/11. The invalidity applicant filed an appeal to the European court of justice (CJ) claiming the infringement of Article 5 and Article 6 CDR.

RCD



SUBSTANCE: The CJ rejected the first plea (infringement of Article 5 CDR) as inadmissible, as it was directed against the decision of the BoA and not against the judgment under appeal, being a mere repetition of the appellant's submission before the GC (Para. 30 et seq.) The second plea (infringement of Article 6 CDR) was rejected as inadmissible as it did not contain a reasoning in which an error in law was claimed, and was directed against the decision of the BoA and concerned a

question of facts (Para. 44 et seq.) The third plea (infringement of Article 25 (1) (f) CDR), in which the appellant claimed an erroneous application of the German copyright law, was considered obviously unfounded. It was for the invalidity applicant (now the appellant before the CJ) to prove the applicability of the provision of the national law he relied on (Para. 55).

Cases C-308/13 P and C-309/13; Società Italiana Calzature SpA v OHIM; Judgments of 18 September 2014; Language of the cases: IT.

Key words: Relative grounds, Likelihood of confusion, Name, Complex mark, Dominant element, Distinctive element, Figurative element, Visual dissimilarity, Phonetic similarity, Conceptual similarity, Matters of fact appealed to CJ, Admissibility, First time on appeal

RESULT: Actions dismissed

FACTS: The applicant sought to register the marks represented below as CTMs for goods within Classes 18 and 25. Two oppositions based (in Case C-308/13) on the two below trademarks, registered in the Community for goods in Class 25 and in Italy for goods in Classes 18 and 25 respectively, and only on the below CTM (in Case C-309/13) were filed on the grounds of Article 8(1)(b) CTMR. The Opposition Division upheld the oppositions partially. The Board of Appeal (BoA) upheld the applicant's appeals, considering that the signs are visually and phonetically dissimilar, thus offsetting the existing degree of conceptual similarity due to the presence in the signs of the surname Zanotti. Thus, the BoA held that one of the basic requirements for a finding of likelihood of confusion had not been met. The opponent filed an action before the General court (GC). The GC confirmed the BoA's findings of no likelihood of confusion, considering that the signs are visually dissimilar, given that in the CTMAs the



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signature dominates the overall impression and that the element 'ZANOTTI', given its position, is only a secondary element, devoid of any autonomous distinctive role. The GC held that the combinations 'GIUSEPPE ZANOTTI DESIGN' on the one hand and 'BY GIUSEPPE ZANOTTI' on the other inform the public as to the person responsible for the appearance of the goods, playing as such a marginal role compared to the figurative element consisting of a handwritten signature, which dominates the overall impression produced by the applied for trademarks.

CTM applied for



Earlier marks

ZANOTTI

(CTM)

(Italian)

SUBSTANCE: The European court of justice (CJ) confirmed that the GC, by finding that the figurative elements of the applied for trademarks are dominant and that their verbal elements, whilst not negligible, play a secondary role in the overall impression produced by these signs, so that there is no likelihood of confusion, has correctly applied the relevant legal criteria (Para. 46). Contrary to what argued by the opponent, there is no rule by which the verbal element of a complex mark would be more distinctive and dominant than the figurative element (Para. 47). The opponent's arguments as to the distinctive character of the surname Zanotti, the diffusion of the latter and the conceptual and phonetic similarity of the conflicting marks all relate to factual assessments, which cannot be reviewed by the CJ, so that these arguments are inadmissible (Para. 48). The CJ also declared inadmissible the opponent's argument as to the enhanced distinctiveness of the earlier marks, since this argument had not been raised before the GC and admitting it at such belated stage would alter the subject matter as brought before the lower instance (Paras. 50-51). The CJ then dismissed the opponent's argument that the element 'ZANOTTI' in the applied for marks would have an independent distinctive role, so as to justify a finding of likelihood of confusion. In this respect, the CJ found that an element of a complex mark does not maintain an independent distinctive role if, considered together with the other element/s of the complex mark, it forms a (semantic) whole having a different meaning than the meaning attached to each individual element considered in isolation (Para. 62). Since, in the present case, the GC found that the expressions 'GIUSEPPE ZANOTTI DESIGN' and 'BY GIUSEPPE ZANOTTI' could be perceived by the relevant public as a unitary whole referring to the designer of the products concerned (Para. 63), the CJ found that the GC correctly held that the above verbal expressions (of which the element 'zanotti' is part) have a merely informative, and therefore secondary, role in the applied for trademarks, so that a likelihood of confusion can be safely excluded (Para. 64).



Case law



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

Case T-450/11; Galileo International Technology LLC v OHIM; Judgment of 11 September 2014; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Complementary goods and services, Dissimilarity of goods and services, Lack of reasoning, Likelihood of confusion, Nature of the goods and services, Principle of functional continuity, Relative grounds, specialized public

FACTS: The interveners sought to register the figurative mark represented below as a CTM for “research and development in the field of satellite radio navigation” within Class 42. An opposition based on the earlier word marks GALILEO, registered for goods and services in classes 9, 16, 35, 38, 39, 41, 42 was filed by the applicant on the grounds of 8(1)(b) CTMR. The Opposition Division (OD) dismissed the opposition insofar as the goods and services were deemed to be dissimilar. The Board of Appeal (BoA) dismissed the applicant’s (opponent’s) appeal. The applicant filed an action before the General Court (GC).

CTM applied for



Earlier mark

GALILEO

SUBSTANCE: Regarding the subject-matter of the proceedings, the GC emphasized that it is not for the GC to remedy the shortcomings of the application since that would deprive the other parties of the opportunity to defend their views. It thus ruled that the applicant could not rely on all of the earlier rights despite having based its arguments on only two of them ‘for reasons of procedural economy’ (Paras. 15-17). The GC reiterated its jurisprudence according to which the obligation to state reasons must be distinguished from the reasoning being well-founded and stressed that, since the BoA upheld the OD’s decision in its entirety, the latter and its reasoning form part of the contested decision. It therefore rejected the applicant’s claim that the contested decision’s findings as regards similarity of goods were insufficiently reasoned (Paras. 31-32, 34-37). While reviewing the merits of the contested decision with respect to the comparison of goods and services, the GC pointed out that ‘research and development in the field of satellite radio navigation’ is not an industrial activity or service aimed at the production of goods, but is focused on scientific innovation (Para. 55). The goods covered by the first of the earlier marks in Class 9 and the services covered by the mark applied for in Class 42 were found to be dissimilar, since goods are generally dissimilar to services and even though in some cases they may be complementary, they still have to be regarded as different if they are intended for different publics (Paras. 63-64). As for the goods in Class 9 and the services in Classes 35 and 38 for which the second of the earlier marks enjoyed protection were deemed to be different in nature, not in competition with and not complementary with the services applied for in Class 42 (Para. 85). They were therefore dissimilar.



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Case T-484/12; CEWE Stiftung & Co. KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM); Judgment of 25 September 2014; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Absolute grounds, Principle of legal certainty, Principle of legality

FACTS: The applicant sought to register the sign SMILECARD (word) as a Community trade mark. Protection was claimed for goods and services in classes 9, 16 and 40. The sign was refused under Article 7(1) (c) and (b) CTMR. The appeal filed by the applicant was rejected.

CTM applied for

SMILECARD

SUBSTANCE: The General court (GC) confirms the reasoning of the Board of Appeal (BoA) as to the merely descriptive character of the sign under Article 7 (1) (c) CTMR. The goods and services covered by the application are directed to the general public. The reasonably well informed, circumspect and attentive consumer is to be taken into account when evaluating the registrability of the sign at issue (Para. 20). Moreover, the English-speaking public has to be considered in this context since the sign consists of two English words. According to Article 7(2) CTMR, it is sufficient if the absolute ground for refusal exists only in a part of the European Union (Para. 21). The words “smile” and “card” belong to basics in English vocabulary. The relevant public will immediately understand the meaning of the combined term “SMILECARD” as referring

to a card (postcard, greeting card) that makes its addressee smile (Para. 23). The combination “SMILECARD” follows the syntax and grammar rules of the English language and its structure is not unusual (Para. 25). The sign “SMILECARD” is purely descriptive in relation to all goods and services covered by the application: The goods in Class 16 include postcards or greeting cards or material of which those cards are made of like paper, cardboard or photographs. Being confronted with the word “SMILECARD” for those goods, the relevant public will immediately assume that the goods are postcards which make their addressee smile or serve to create those kinds of greeting cards (Para. 27). The computer software in Class 9 may also serve to create electronic postcards or greeting cards (Para. 28). Likewise, the services in Class 40 of the application may have the purpose of designing and producing such kinds of postcards (Para. 31). As regards the previous Community trade mark registered by the applicant, it is true that the Office has to consider previous comparable marks pursuant to the principle of equal treatment (Para. 35). However, the principle of equal treatment must be consistent with respect for legality. For reasons of legal certainty and of sound administration, the examination of any trade mark application must be stringent and full, in order to prevent trade marks from being improperly registered (Para. 36). In those circumstances, the BoA was entitled to find that registration of the sign “SMILECARD” as a mark in respect of the goods and services referred to in the application was incompatible with Article 7(1) (c) CTMR (Para. 37 and 39).



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Case T-474/12 Giorgio Giorgis v OHIM; Judgment of 25 September 2014; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Absolute grounds, Three-dimensional mark, Acquired distinctiveness by use, Shape of a product, Ornamentation, Packaging, Used in the course of trade, Distinctive element.

FACTS: The Board of Appeal (BoA) had upheld a cancellation action against the applicant's three-dimensional CTM, for certain Class 30 goods, namely 'Ice, flavoured ices, mixed sorbets, ice sorbets, ice creams, ice-cream drinks, ice-cream goods, ice-cream desserts, semi-frozen desserts, desserts, frozen yoghurt, pastry'. The applicant appealed, alleging errors regarding the findings of level of attention and the test for distinctiveness, as well as alleging the wrongful rejection of evidence of acquired distinctiveness in 8 EU Member States. The General court (GC) dismissed the action.

CTM applied for



SUBSTANCE: As to the 1st plea – Article 7(1) (b) CTMR, in rejecting applicant's argument that the relevant public for ice-creams had a high attention level due to the large number of flavours, the GC held that these are inexpensive everyday consumer food products, regardless of taste preferences



there is no pre-purchase "lengthy period of reflection." (Para. 17) With regards to distinctive character, the BoA had correctly considered the individual features and overall impression, finding that the shape does not depart substantially for the norms in packaging of the sector, which is used to convey a certain image (handmade and quality). It did not unduly restrict the norm and customs (Para. 30) in finding the features normal or ornamental, and the presence of other shapes of packaging is not relevant – it is not necessary for a shape to be the most common form in order to be normal in the sector (Para. 40). The BoA's mention of 'differ substantially' was in reply to an argument of the applicant, after it had already made a finding on the basis of the correct "departs significantly" test (Paras. 45 and 46). As to the 2nd plea – Article 7(3) CTMR, the evidence for acquired distinctiveness had been rejected by the BoA since it only showed 8 Member States and moreover the 3D packaging was always used with the sign LA GELATERIA DI PIAZZA NAVONA printed on that packaging. The GC held that the applicant had no proven perception of the 3D packaging alone as a trade mark. Although it may be possible for a 3D mark used with a word or fig mark may acquire distinctive character (Para. 55), the public must first be familiarised with this and not every use of the mark necessarily amounts to trade mark use (Para. 56). Here, it would have been at least necessary for the applicant to show that the shape of the packaging was particularly retained by the relevant public as an indication of origin, which it did not (Para. 57). The merits of the argument that 8 Member States were a substantial portion of the EU were not examined, since the applicant failed on the first test, to show use as a trade mark of the shape alone (Para. 58).



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Case T-425/12; Sport Eybl & Sports Experts GmbH OHIM, Judgment of 11. Juli 2014, Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Letter mark, Complementary goods and services, Visual similarity, Phonetic identity, Distinctive element, Figurative element, Nice Classification, Graphical representation

FACTS: The applicant sought to register the figurative mark represented below as a CTM for goods and services within Classes 9, 12, 18, 22, 25, 28 and 42. The opposition based on the earlier CTM represented below, which is protected among others for goods in classes 9, 12, 18, 25 and 28 was rejected. The Opposition Division excluded the likelihood of confusion without the entire examination on the basis of the assumption of the identity of products with the reasoning that even for such products the signs are sufficiently apart from each other and that the protection of a single letter sign is limited to its graphical representation. The Board of Appeal (BoA) partially annulled the decision and rejected the CTM application. If found a likelihood of confusion for identical goods (those in classes 9, 12, 25, 18 and 28) and for those found similar (Class 22). It found the services in Class 42 dissimilar to the products protected by the earlier CTM and rejected the opposition to that extent. The CTM applicant filed an action to the General court (GC). The action was directed against the decision as far as it rejected the opposition and based on article 8 (1) (b) CTMR.



CTM applied for



Earlier mark



SUBSTANCE: The GC confirmed the finding of likelihood of confusion. Within the claim of infringement of Article 8(1) (b) CTMR the applicant challenged the similarity of goods in Class 22, the similarity of the signs and the assessment of the likelihood of confusion (Para. 16). The GC confirmed the BoA's decision in all these points: The goods applied for "tents and climbing ropes" in Class 22 are similar to the "sporting articles" in Class 28. The classification in different classes is not an argument against the similarity since the Nice Classification has administrative purposes only, Rule 2 section 4 CTMIR (Para. 28 with a reference to further Case-Law). The fact that the goods are sold in the same shops is a valid criterion according to Canon-judgement (C-39/97) (Para. 29 with a reference to further Case-Law). Also, goods or services which are complementary are those where there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (Para. 30 with a reference



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to further Case-Law). It cannot be excluded that the goods applied for are complementary to those protected since climbing robes as well as tents can be used together with various sport articles (Para. 30). The signs are visually similar. The graphical presentation cannot detract from the same impression made by the letter "e" in both signs (Para.37). They are phonetically identical (Para. 38). They have no meaning making the conceptual comparison impossible (Para. 40). Even if the applicant was right claiming that the earlier mark has a limited distinctiveness, the likelihood of confusion could not be excluded (par. 47).

Case T-195/12; Nuna International BV, Nanu-Nana Joachim Hoepf GmbH & Co. KG, v. OHIM; Judgment of 23 September 2014; Language of the case: EN

RESULT: Decision partially annulled

Keywords: Relative grounds, Likelihood of confusion, Similarity of the goods and services, Similarity of signs, Figurative mark, Purpose of the goods and services, Complementarity of the goods and services, Visual similarity, Ending of a mark, Phonetic similarity, Conceptual similarity, Common element.

FACTS: The applicant sought to register the figurative sign represented below as a CTM for classes 12, 18, 20, 21, 25 and 28. An opposition based on CTM's registrations for goods in classes 18, 20, 21, 25 and 28 33 was filed on the grounds of Article 8(1) (b) CTMR. The opposition was directed against all goods of the CTM. The Opposition Division rejected the opposition on the ground that there was no likelihood of confusion. The Board of Appeal (BoA) upheld the appeal. It concluded that there was a likelihood of confusion between the sign applied for and the earlier marks with respect to all the goods covered by that sign.



CTM applied for

Earlier marks

NANA

NANU-NANA

SUBSTANCE: The General court (GC) stated that although, as the applicant submits the parents of babies and young children may have a high level of attention when purchasing the goods covered by the mark applied for, the group of average consumers of those goods will not in any case consist exclusively, or even principally, of particularly attentive parents. The target public for the goods covered by the mark applied for consists not only of parents, but also of persons who wish to buy those goods as gifts (Paras. 24 and 25). On the comparison of goods in classes 18, 21 and 28 the GC held that the BoA did not make an error of assessment in finding that the goods in classes 18 and 28 covered by the mark applied for were identical to the goods in those classes covered by the earlier marks. The BoA correctly pointed out, that the goods in Class 21 covered by the mark applied for could be made of glass. Parents may choose not to use cups and bowls made of plastic for their children and prefer the use of cups and bowls made of glass that are manufactured by the same undertakings as those that produce cups and bowls for adults and are marketed through the same distribution channels (Paras. 41 and 42). Therefore the GC held that the BoA cannot be



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criticised for finding that the goods in Class 21 covered by the mark applied for were identical to the goods in that class covered by the earlier marks (Paras. 43 and 44). As for the goods in Class 25 the BoA did not err in finding that the 'diapers (textile)' and 'foot muffs for baby and children' in Class 25 were identical to the 'clothing for children' covered by the earlier mark NANU-NANA. The BoA was also right in finding that the 'foot muffs for push-chairs and infant car seats' were similar to the clothing covered by that earlier mark (Para. 49). In relation with the goods in Class 12 the GC held that 'strollers, buggies [and] safety car seats for children' make it possible to transport or carry babies or children. By contrast, the goods in Class 28 covered by the earlier marks provide a means for babies or children to play and are thus used for recreational purposes. The intended purpose and method of use of the goods in question must therefore be held to be different. The goods in question are not interchangeable and are not therefore in competition with each other (Paras. 51 and 52). However the GC found that (Para. 53) when the BoA stated that playthings for babies were usually physically attached to strollers, buggies or safety car seats for children it erred as that fact alone does not make it possible to conclude that there is a complementary connection between the goods in question. It also admitted that some playthings covered by the earlier marks can be fastened to the goods in Class 12 covered by the mark applied for, namely strollers, buggies and safety car seats for children. However, the actual use of the playthings is optional and is not therefore indispensable or important for the use of strollers, buggies or safety car seats for children. It added that although it is true that the goods in question may be used together and that playthings may be designed to be fastened to strollers, buggies and safety car seats for children, that argument is too general to justify, on its own, the finding that those goods are complementary (Paras. 55 and 56). The contested decision does not show that a large number of the manufacturers of both of the categories of goods are the same and that consumers perceive manufacturers of strollers, buggies and safety car seats for children as also producing playthings. It

does not, in addition, show that consumers consider it normal for the goods in Class 12 covered by the mark applied for and the goods in Class 28 covered by the earlier marks to be marketed under the same trade mark (Para. 58). Lastly, it pointed out that the fact that the goods in question may be sold in the same commercial establishments, such as department stores or supermarkets, is not particularly significant, since very different kinds of goods may be found in such shops, without consumers automatically believing that they have the same origin, or even a complementary connection (Para. 59). The BoA therefore erred in finding that there could be a complementary connection between the 'strollers, buggies [and] safety car seats for children' in Class 12 and the 'playthings' and 'games and playthings, dolls' in Class 28 covered by the earlier marks (Para. 60). The BoA made an error of assessment when it found that the goods in question were similar (Para. 61). On the goods in Class 20 the GC held that the BoA did not show that the goods in Class 20 covered by the mark applied for were similar to playthings, inter alia on the basis of their nature, their intended purpose, and their method of use or on the basis of whether they are in competition with each other or are complementary (Para. 65). The BoA erred in finding, in Paragraphs 35 and 36 of the contested decision, that there was a similarity between, on the one hand, the 'sleeping bags for baby and children', 'baby walkers', 'cribs; high chairs; bouncing seats; baby rocking chairs and carry cots' in Class 20 covered by the mark applied for and, on the other hand, the 'playthings' in Class 28 covered by the earlier marks (Para. 67). However the GC held that the BoA assessment is correct in so far as it found that the 'cribs; high chairs; bouncing seats; baby rocking chairs and carry cots' in Class 20 covered by the mark applied for were similar to the 'furniture' in that class covered by the earlier marks. On the visual comparison of signs first with the earlier mark NANA, the GC confirmed the assessment of the BoA when it held that that there was a visual similarity between the sign applied for and the earlier sign NANA (Para. 84). As regards the earlier sign NANU-NANA, the BoA was correct when it found that there



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was a visual similarity after pointing out, first, that the letters 'n', 'u' and 'a' of which that earlier sign consists were also present in the mark applied for and, secondly, that there was a similarity between, on the one hand, the elements 'nanu' and 'nana' of which the earlier sign consists and, on the other hand, the sign applied for. In relation with the aural comparison, the sign NANA and the sign applied for have two syllables, are of the same length and will be pronounced according to the same rhythm. Furthermore, the GC held that the similarity between the two signs results not only from the use of the same consonant 'n', which occupies the same position in both signs, but also from the fact that one of the two syllables, 'na', is identical. It is difficult to dispute that that fact has a particular phonetic impact on account of the shortness of the words of which the signs consist and the final position of that syllable. Those similarities thus offset the difference observed at the beginning of the sign (Para. 89). For the other earlier sign NANU-NANA the fact that the number of syllables is different is not sufficient to rule out a phonetic similarity between the signs (Para. 91). Even though the signs at issue are of a different length and consist of a different number of words, the overall impression which they produce leads to the finding that there is a certain phonetic similarity between them owing to their common component. In those circumstances, the BoA was right to find that there was a phonetic similarity between the signs at issue (Paras. 92 and 93). In relation to the conceptual comparison the GC held that the BoA did not err in finding, in the contested decision, that the sign applied for was similar overall to the earlier sign NANA and that its degree of similarity with the earlier sign NANU-NANA was slightly lower (Para. 97). In the global assessment of the likelihood of confusion done, the BoA was right to find that there is a likelihood of confusion between the marks at issue as regards the goods in classes 18, 21, 25 and 28 and the 'cribs; high chairs; bouncing seats; baby rocking chairs and carry cots' in Class 20 covered by the mark applied for (Para. 105). By contrast, the 'strollers; buggies; safety car seats for children' in Class 12 and the 'baby walkers' and 'sleeping bags for baby

and children' in Class 20 may not be regarded as identical or similar to the goods covered by the earlier marks (Para. 106). The contested decision is annulled in so far as the BoA found that there was a likelihood of confusion as regards, first, the 'strollers; buggies; safety car seats for children' in Class 12 and, secondly, the 'baby walkers' and 'sleeping bags for baby and children' in Class 20 (Para. 108).

Case T-51/12 Scooters India Ltd, v. OHIM; Judgment of 30 September 2014; language of the case: EN

RESULT: Decision annulled

KEYWORDS: Proof of use, Nice Classification, Principle of legitimate expectations, Principle of legal certainty, Evidence of use, Revocation grounds, Communications of the President

FACTS: The applicant is the owner of the Community word mark LAMBRETTA since 2002, for goods in classes 3, 12, 14, 18 and 25. In 2007, the intervener applied for partial revocation of the CTM for the goods in classes 3, 12 and 18 (no genuine use). The Cancellation Division partially revoked the mark as from 2007 in respect of the relevant goods, except for some goods in Class 3. The Board of Appeal (BoA) stated that the goods protected in Class 12 coincided with the class heading (vehicles; apparatus for locomotion by land, air or water). Since the evidence of use related only to spare parts, but not to vehicles, apparatus for locomotion by land, air or water, the BoA did not examine it and confirmed revocation for the whole Class 12. The decision was adopted in December 2011, before IP Translator judgment.



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CTM applied for

LAMBRETTA

SUBSTANCE: The question at issue was whether the indication of the class heading of Class 12 was to be understood by the Office as referring solely to 'vehicles; apparatus for locomotion by land, air or water' *stricto sensu*, or more generally, to all the goods in Class 12. In the meantime, the IP Translator preliminary ruling stated that class heading can be used to identify the goods and services covered by the trade mark application, provided that such identification is sufficiently clear and precise (Para. 56). Furthermore, if all the general indications of a particular class heading are used to identify the G/S for which protection is sought, the applicant has to specify whether the application covers all the G/S included in the alphabetical list or only some (in such case: specify those covered). The IP Translator judgment guidance must be applied by the courts even to legal relationships arising and established before the judgment (Para. 24). As far as the Office's Communication of 2/2012, for CTMs registered before 21.6.12, use of all the general indications in the class heading implies protection of all the G/S included in the alphabetical list of that class. The President of the Office justified this approach by referring to an earlier Communication of April 2003. The Communication of 2/2012 applies the principles of legitimate expectations and of legal certainty. A legitimate expectation had been created by the Office (Para. 27) The fact that the CTM at issue had been registered before the publication of the Communication of 4/2003 could be relevant in the light of the principle of legitimate expectations, but not in the light of the principle of legal certainty, which protects the interest of the public (and not only of TM proprietors) in the possibility of establishing with certainty the scope



of the protection conferred by earlier registrations (Para. 29). In any case, there is no limitation in Communication 2/12 regarding marks registered before the publication of Communication 4/03 (Para 30). Furthermore, Communication 4/03 was intended 'to explain and clarify' the practice of the Office and states that the rules 'will continue to be applied in the various proceedings'. Therefore, Communication 4/03 was not intended to introduce a new practice, but to explain and clarify the previous practice of the Office (Para. 31). Even if Communication 2/12 is disregarded, the General court has already recognised that the principle of legal certainty requires the conclusion that the owner of a CTM is using all the general indications in a class heading. Therefore, the words 'vehicles; apparatus for locomotion by land, air or water' in the case at hand must be interpreted as protecting the mark for all the goods in the alphabetical list of Class 12. The BoA was required to examine the genuine use of the mark LAMBRETTA in relation to the spare parts included in the alphabetical list.

Case T-132/12 Scooters India Ltd, v. OHIM; Judgment of 30 September 2014; language of the case: EN

RESULT: Decision annulled

KEYWORDS: Proof of use, First time on appeal, Evidence of use

FACTS: The applicant is the owner of the Community word mark LAMBRETTA since 2001, for goods in classes 6, 7 and 28. In 2007, the intervener applied for partial revocation of the CTM for all the goods (no genuine use). The Cancellation Division (CD) revoked the mark as from 2007 in respect of all the goods. The Board of Appeal (BoA) dismissed the appeal, as it found that the evidence was not sufficient to prove genuine use.



Case law

CTM applied for

LAMBRETTA

SUBSTANCE: The applicant claims that the BoA examined the new evidence submitted to the BoA in isolation, not in conjunction with the evidence already provided to the CD. The General court (GC) stated that the BoA is bound to examine whether or not, in the light of all the relevant matters of fact and of law, a new decision with the same operative part as the decision under appeal may be lawfully adopted at the time of the appeal. In order to examine whether an earlier mark has been put to genuine use, a global assessment must be carried out, taking into account all the relevant factors. An accumulation of evidence may allow the necessary facts to be established (Para. 25). However, the BoA exclusively assessed the new evidence. It did not even mention the evidence previously submitted to the CD. Furthermore, the BoA did not formally adopt the assessment made by the CD (Para. 26). The GC concluded that the BoA infringed its obligation to carry out a global assessment which took into account all the relevant factors of the particular case.

Case T-218/12 Micrus Endovascular LLC v. OHIM; Judgment of 10 September 2014; language of the case: EN

RESULT: Action dismissed

KEYWORDS: Identity of signs, Purpose of the Goods and Services, Likelihood of confusion, Relevant public, Complementary of the goods and services.

FACTS: The applicant sought to register the word mark DELTA



for 'Medical and surgical devices, namely, microcoils used for endovascular surgery for the treatment of aneurysms' in Class 10. An opposition was filed based, inter alia, on the Portuguese trademark reproduced below, which covers pharmaceuticals and other products in Class 5, cf. Articles 8(1) (b) and 8(4) CTMR. The Opposition Division (OD) upheld the opposition. On appeal, the Board of Appeal (BoA) upheld the opposition and rejected the CTM application. Before the General court (GC), the applicant alleges an infringement of Article 8(1) (b) CTMR.

CTM applied for

DELTA

Earlier mark

DELTA
PORTUGAL

SUBSTANCE: The BoA was right to define the relevant public as composed of 'professionals in endovascular surgery', without narrowing that category further to encompass 'brain surgeons' only. As the Office claimed, endovascular surgery is not limited to the brain, but is also used to treat abdominal aortic aneurysms (Paras. 42-43) These highly specialised professionals use the 'pharmaceutical products' of the earlier mark, namely if they have to administer those medicines to a patient before, during or after a surgical operation (Para. 48) It is common knowledge that large hospitals usually centralise



Case law

orders for medicines, equipment and specialised work tools (Para. 62). However, this does not mean that the distribution channels are identical or that administrators in the central purchasing department are the relevant public (Para. 63). Professionals in endovascular surgery ultimately decide which products must be ordered (Para. 64). The goods are complementary because of their common intended purpose (use in the performance of endovascular surgical operations and in the context of pre-operative or postoperative care, or in preventive medicine). Furthermore, they are co-manufactured namely by pharmaceutical conglomerates (Para. 68). The signs are identical or highly similar and thus a likelihood of confusion.

Case T-536/12; Aroa Bodegas, S.L & Bodegas Muga v.OHIM; Judgment of 11 September 2014; Language of the case: ES

RESULT: Action dismissed

Keywords: Likelihood of confusion, Similarity of goods and services, Similarity of signs, Figurative marks, Coexistence of trademarks

FACTS: The applicant sought to register the verbal sign represented below as a CTM for class 32 (beers, mineral water and non-alcoholic beverages and Class 33 (wines, alcoholic beverages with the exception of beers). An opposition based on a Spanish earlier trade mark Registration for goods in Class 33 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) upheld the opposition refusing registration of the mark applied for in relation to all the goods concerned. The Board of Appeal (BoA) partially annulled the decision of the opposition division and rejected the opposition for non-alcoholic beverages, fruits juices and drinks made of fruits as these goods were not similar to the earlier mark goods. For the rest of the goods it found that the OD had



correctly upheld the opposition since a likelihood of confusion could not be excluded due to the identity or similarity of the goods covered by the mark applied for, namely, wines, alcoholic drinks and beers, protected by the earlier Spanish figurative mark and the similarity of the signs at issue.

CTM applied for

Earlier mark

SUBSTANCE: The General court (GC) took note of the fact that the applicant does not challenge the findings of the BoA concerning the definition of the relevant public, composed of the average public in Spain (Para. 22). On the visual comparison of signs the GC held that the BoA was correct in concluding that the signs are visually similar to a low degree. Both signs are mainly composed of verbal elements and the elements "Aroa" and "Aro" are the most distinctive ones (Paragraph 39) as the figurative elements and the colours are frequent in marks in the wine sector (Paras. 35 and 36). On the aural comparison the GC confirmed the assessment of the BoA when it held that the signs to be compared which are "aro" and "aroa" present an average similarity, as they share the sounds "a, r and o"



Case law

and they only differ in the “a” sound of the beginning of the contested sign (Paragraph 46). In relation to the conceptual comparison the GC held that the BoA was correct when it declared that both signs have different conceptual meanings. The word “aro” in Spanish language has a clear meaning whether “aroa” even if it was used as a female name has no meaning (Para. 48). In the global assessment of the likelihood of confusion done, the BoA did not infringe Article 8(1) (b) CTMR as the goods are either identical or similar. The earlier mark has an average degree of distinctiveness, the word ARO in Spanish means “ring” and therefore has no connection with the goods (Paras. 51 and 52). In relation with the signs they have some similarity in particular because of their phonetic similarity. For these kind of products that are ordered in a noisy environment the phonetic similarity has a certain importance (Para. 53). The different sound of the final letter A of the contested mark could not be perceived clearly in these surroundings. Therefore the BoA was correct to hold that the phonetic similarity in this case was of more importance (Para. 56) and a risk of confusion is not to be excluded. Finally on the argument of a supposed peaceful coexistence between the contested sign and the mark AROA LAKET the GC held that the mark invoked is not similar to the marks at stake (Para. 62), moreover the opponent did not bring any evidence of this peaceful coexistence and this argument was correctly rejected.

Case T-576/12 Grzegorz Łaskiewicz v OHIM; Judgment of 15. July 2014; Language of the case: PL

RESULT: Action dismissed

KEYWORDS: Visual similarity, Phonetic similarity, Conceptual similarity, Graphical representation, Distinctive element, Examination of facts ex officio, Principle of party disposition, Lack of reasoning



FACTS: The applicant sought to register the figurative mark represented below as a CTM for goods within classes 6 and 9. The application was entirely rejected upon an opposition based on the earlier Community word mark represented below, registered for goods in Class 9. The Board of Appeal (BoA) confirmed the decision. The applicant filed an action before the General court (GC), claiming the infringement of Article 8(1) (b) CTMR and articles 75 and 76 CTMR.

CTM applied for

PROTEKT

Earlier mark

PROTECTA

SUBSTANCE: The GC rejected the documents which were not presented in the administrative proceedings as inadmissible (Para. 15 et seq.) There was no infringement of Article 8(1) (b) CTMR. The similarity or identity of the goods is not under dispute (Para. 36) The signs are visually similar sharing characters “P-R-O-T-E—T-” in the same sequence. The graphical elements are minor, therefore that emphasizes that the verbal elements are generally more distinctive than the figurative ones applies (Paras. 38 and 40). They are phonetically highly similar, differing only in the sound “a” since the letters “c” and “k” are pronounced identically (Para. 42). Both signs refer to the English basic word “protect” and are conceptually similar (Para. 48). A likelihood of confusion exists if the similarity of the products and the similarity of the signs are together sufficiently high, as in the case at hand (Para. 46



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et seq.) The BoA enhanced level of attention corresponding to the fact that goods in question are meant to protect workers was considered by the BoA (Para. 49). The argument of the applicant that the earlier mark has a descriptive character referring to the concept of “protection” and does not enjoy any protection is not valid. Even if the earlier mark was registered incorrectly, the possible breach of article 7 CTMR cannot be taken into account in the opposition proceedings (Para. 55 with a reference to further). The earlier national mark always has [is deemed to have] some level of distinctive character (Para. 56 with a reference to C-196/11 P “Formula One Licencing”). Even if the earlier mark had a limited distinctiveness, it is only one of the factors taken into account when assessing the likelihood of confusion and cannot exclude it (Para. 59 with a reference to further). There was no infringement of article 75 and 76 CTMR. The applicant did not substantiate its argument that the OHIM applied the rules of the factual assessment pursuant to Article 76(1) CTMR incorrectly, so this argument must be dismissed (Para. 71). As to the claimed breach of Article 75 CTMR the GC emphasized that BoAs cannot be required to take a position on any argument raised by the parties. The reasoning has to present the facts and considerations that were substantial for the decision (Paras. 77 and 78 with the reference to further).

Case T-18/13; Grzegorz Łaskiewicz v OHIM, Judgment of 15. July 2014, Language of the case: PL

RESULT: Action dismissed

KEYWORDS: Visual similarity, Phonetic similarity, Conceptual similarity, Graphical representation, Distinctive element, Examination of facts ex officio, Principle of party disposition, Lack of reasoning

FACTS: The applicant sought to register the figurative mark represented below as a CTM for goods within classes 6 and 9. The application was entirely rejected upon an opposition based on the earlier Spanish word mark represented below,



registered for goods in class 9. The Board of Appeal (BoA) confirmed the decision. The applicant filed an action before the General court (GC), claiming the infringement of Article 8(1) (b) CTMR and articles 75 and 76 CTMR.

CTM applied for

Earlier mark

PROTEK

SUBSTANCE: There was no infringement of Article 8(1) (b) CTMR. The goods are similar, having the same character, method of use and purpose and being complementary (Paras. 35 and 40). The signs are visually similar sharing 6 characters in the same sequence. The graphical elements are minor, thus the Case-Law that emphasizes that the verbal elements are generally more distinctive than the figurative ones applies (Paras. 43 and 45). They are phonetically highly similar (Para. 47). Both signs refer to Spanish word “proteger” and are conceptually similar (Para. 48). The BoA considered an enhanced level of attention corresponding to the fact that goods in question are meant to protect workers (Para. 53). The argument of the applicant that the earlier mark has a descriptive character referring to the concept of “protection” and does not enjoy any protection is not valid. Even if the earlier Spanish mark was registered incorrectly, the possible breach of Article 7 CTMR cannot be taken into account in the opposition proceedings (Para. 56 with a reference to further Case-Law). The earlier national mark always has [is deemed to have] some level of distinctive character (Para. 57 with a reference to C-196/11 P “Formula One Licencing”). Even if the earlier mark had a limited distinctiveness, it is only one of the factors taken into account when assessing the likelihood of



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confusion and cannot exclude it (Para. 60 with a reference to further Case-Law). There was no infringement of articles 75 and 76 CTMR. The applicant did not substantiate its argument that the Office applied the rules of the factual assessment pursuant to Article 76(1) CTMR incorrectly, so this argument must be dismissed (Para. 70). As to the claimed breach of Article 75 CTMR the GC emphasized that BoAs cannot be required to take a position on any argument raised by the parties. The reasoning has to present the facts and considerations that were substantial for the decision (Paras. 72 and 73 with the reference to further Case-Law).

Case T-199/13; DTM Ricambi Srl vs. OHIM, Decision of 10th September 2014: Language of the Case: IT

RESULT: Action dismissed

KEYWORDS: Relative grounds, Likelihood of confusion, International registration, Nice Classification, Identity of goods & services, Similarity of goods & services, Complementarity of the goods & services, Dominant element, Similarity of signs, Complex mark, Figurative element, Conceptual identity, Laudatory mark, Distinctive element.

FACTS: The applicant sought to register the figurative mark represented below as CTM for goods in classes 7, 9 and 12. The contested goods in Class 12 include, inter alia, motors and engines for land, air and water vehicles, machine coupling and transmission components for said vehicles. An opposition was filed on the grounds of Article 8(1) (b) CTMR. It was based on the earlier International figurative mark below registered for goods in classes 12, 38, 39 e 42.



CTM applied for



Earlier IR



SUBSTANCE: The Board of Appeal (BoA) found identity between the contested goods and the goods of the earlier mark in Class 12 and a high degree of similarity between the contested goods in classes 7 and 9 and engines for vehicles in Class 12 the earlier marks. The General court (GC) noted that, according to the explicatory notes of the Nice Classification, the contested air and water vehicles, machine coupling and transmission components for said vehicles in Class 12 do not fall in this class but in Class 7. Therefore, constitutive parts of boats and airplanes, protected by the earlier mark in Class 12, do not cover engines for air and water vehicles, machine coupling and transmission components for said vehicles. Therefore there cannot be identity between the above goods (Paras. 34-37). On the other hand, since Nice Classification serves administrative purposes only, it has to be found that the above goods in comparison are similar to a high degree even if belonging to different classes. Indeed, the goods engines for air and water vehicles, machine coupling and transmission components for said vehicles of the mark applied for, erroneously included in Class 12, are as the goods constitutive parts of boats and airplanes protected by the earlier mark, all components of air and water vehicles and



Case law

these goods belong to the same industrial sector and are targeted to the same public, There is a high degree of similarity also in relation to the contested goods in classes 7 and 9, which are all parts or accessories of engines, and the goods of the earlier mark since as far as their nature, purpose and method use are concerned and they also are complementary. Therefore, the BoA failed in finding that there was identity between the above goods (which belong to different classes) instead of a high degree of similarity (Paras. 41 and 42). The GC confirmed that "STAR" is visually the dominant element of the earlier mark, due to its size and its central position, even when considered as having a low distinctive character (Paras. 49 and 50). The same conclusion is valid in relation to the contested mark since "STAR" is the only word element and it is the bigger element of the mark. Therefore, the marks are similar but to a low degree only due to the presence of different figurative and word elements which are secondary but not negligible in the overall impression of the signs (Para. 53). Phonetically, the marks are similar but not to a high degree, as found in the contested decision. The word "LODI" would not be omitted by the consumers in the pronunciation of the earlier mark (Para. 58). The BoA correctly found that there is identity from a conceptual point of view due the coincidence of the element "STAR" which will be understood by the EU consumers, including those of not English-speaking territories. Indeed a part of the public would find no meaning in the word "LODI" (Para. 61). As far as the distinctive character of the earlier mark is concerned, the GC found that "STAR" will be perceived as a laudatory element following the Case-Law of the GC. Therefore, the distinctive character of the earlier mark is weak at least for a significant part of the public (Para. 68). The distinctive character of the earlier mark is however only one of the factors to be taken into account in the assessment of the likelihood of confusion. Therefore, taking into account the identity and the high degree of similarity between the goods, and the degree of similarity between the signs, there is a likelihood of confusion, notwithstanding the low distinctiveness of the earlier mark and the attention of the



relevant professional public. Therefore, the errors in relation to the identity of some of the goods and to the phonetic comparison of the signs in the contested decision do not lead to an annulment of the decision at issue (Para. 76).

Case T-185/13; Continental Wind Partners LLC v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM); Judgment of 11 September 2014; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Admissibility; Beginning of mark; Competence of the Boards; Conceptual similarity; International registration; Likelihood of confusion; Minimum degree of distinctiveness; Phonetic similarity; Principle of functional continuity; Relative grounds; Similarity of signs; Similarity of the goods and services; Specialised public; Visual similarity.

FACTS: The applicant sought to register the figurative mark CONTINENTAL WIND PARTNERS as a CTM for goods and services in classes 7, 9, 11, 35, 39 and 40. The opponent lodged an opposition against the application on the basis of the EU designation of its international registration Continental (fig.) for goods and services in classes 7, 9, 35 and 40. The Opposition Division (OD) upheld the opposition partly on the basis of Article 8(1) (b) CTMR. The appeal filed by the applicant was dismissed.



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CTM applied for



Earlier mark



SUBSTANCE: The General court (GC) considered the application lodged before the GC partly inadmissible, namely insofar as the applicant simply referred to previous briefs filed in the administrative proceedings before the Office without bringing forward any arguments (Paras. 16-19). As to the existence of a likelihood of confusion between the marks, the goods and services are directed to a specialised public with specific knowledge in the area of renewable energies. The degree of attention is high (Para. 25). As regards the comparison of the goods and services, the Board of Appeal (BoA) had confined itself to referring to the arguments of the OD. The GC confirmed the comparison of the goods undertaken by the OD as far as that evaluation was contested by the applicant (Paras. 37-39). Since the applicant did not explain – before the BoA or before the GC – why the assessment of the comparison of goods was not correct (Para. 40) the BoA did not commit any error by referring to the arguments of the OD (Para. 41). The conflicting signs are visually similar to a low degree and phonetically similar to a medium degree (Paras. 49-51). Conceptually, the contested decision erroneously stated that the signs were identical from the perspective of those consumers who did not understand the meaning of the elements “Wind” and “Partners” (Para. 55). Since the goods and services are directed

to a specialised public one can assume that those terms are understood by those specialists throughout the EU (Para. 56). The signs are conceptually similar to a low or medium degree (Para. 71). However, the error committed by the BoA would only lead to the annulment of the contested decision if it had an impact on the outcome (Para. 70) which is not the case. The argument of the applicant that the term “Continental” was not apt for registration due to its alleged descriptiveness was rejected by the GC. According to the GC, the validity of the earlier mark must not be questioned (judgment C-196/11 P of 24 May 2012, Formula One Licensing/OHIM, applied by analogy). Consequently, one has to concede a minimum degree of distinctiveness to the earlier mark (Paras. 59-64). The opposing mark even enjoys at least an average degree of distinctiveness (Para. 68). In view of the visual, phonetic and conceptual similarity between the signs and the identity or similarity of the goods and services at issue, there is a likelihood of confusion between the marks within the meaning of Article 8(1)(b) CTMR (Paras. 71-73).

Case T-127/13 El Corte Inglés S.A. v. OHIM; Judgment of 11 September 2014; language of the case: ES

RESULT: Decision partially annulled

KEYWORDS: Likelihood of confusion, Complementary goods and services, Conceptual similarity, Nature of the goods and services, Similarity of signs, Common element, Weak trademarks

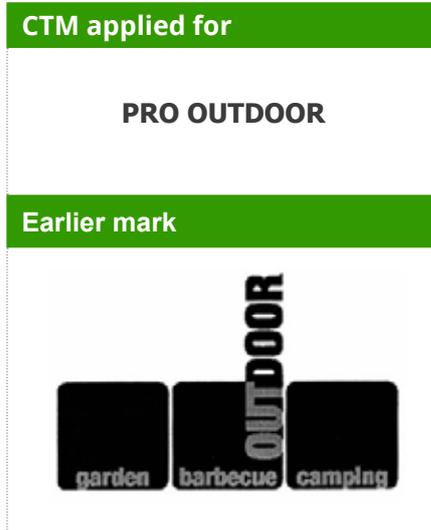
FACTS: The applicant sought to register the word mark PRO OUTDOOR in Classes 9, 12, 14, 18, 22, 24, 25, 28 and 35. Opposition based on the CTM figurative mark reproduced below, for goods in Classes 12, 18, 22, 24, 25 and 28. As to Article 8(1) (b) CTMR, the Opposition Division partially upheld



Case law



the opposition for the goods in Classes 9, 12, 18, 22, 24, 25 and 28. The Board of Appeal (BoA) dismissed the appeal.



SUBSTANCE: The BoA took the view that the applicant had limited its appeal to 'computers and data processing equipment' in Class 9. Before the General court (GC), the applicant claims that the appeal referred to all the products for which the opposition had been upheld. Although the drafting of the appeal before the BoA was not clear, the GC takes the view that, examined in its context, it is clear that the applicant did not intend to limit the appeal to the goods mentioned by the BoA. The contested decision is partially annulled. The BoA must examine the appeal in relation to all the remaining goods (in another Paragraph). For the rest, the GC confirms that data processing equipment have a similar nature to games and toys, which include toy computers and interactive games that use software. These products may be addressed to the same public, may share the same distribution channels and they often have the same intended purpose, so that they can substitute each other. The relevant public includes EU professional and private consumers, whose degree of

attention is higher than the average (Para. 43). The signs are visually and aurally similar, as they share the common element OUTDOOR. Conceptually, the signs are similar for the English speaking public. However, for the part of the relevant public who don't understand the term OUTDOOR the marks are conceptually different, as they will understand the meaning of the terms PRO, CAMPING, BARBECUE AND GARDEN. There was a likelihood of confusion for the whole of the relevant public, even more important for the English speaking public, for which the signs are also conceptually similar.

Case T-11/13; Tegometal International AG v OHIM; Judgment of 23. September 2014; Language of the case: DE

RESULT: Decision annulled

KEYWORDS: Res judicata, Relative grounds, Likelihood of confusion, Parallel proceedings,

FACTS: An invalidity request pursuant to Article 52(1) (a) CTMR in conjunction with Article 8(1) (b) CTMR was filed against the CTM MEGO which was registered in classes 6 and 20. The request was based on several national and Community trademarks TEGO and TEGOMETAL. The Cancellation Division rejected the request finding the marks dissimilar. An appeal filed by the invalidity applicant was dismissed as inadmissible. The Board of Appeal (BoA) considered that since previously an opposition was filed against the same CTM mark and that opposition was based on the same ground and the same earlier trademarks as the invalidity request, and, furthermore, that the previous decision of the BoA confirmed the rejection of this opposition and this decision of the BoA had become final, the current proceedings were inadmissible. The invalidity applicant filed an action before the General court (GC) claiming an erroneous application of the res judicata principle, an infringement of Article 34 (2) CTMR and of Article 8(1) (b) CTMR.



Case law

CTM applied for

MEGO

Earlier mark

**TEGO
TEGOMETAL**

SUBSTANCE: The first plea led to the annulment of the decision of the BoA. The GC decided that the principle of res judicata which prohibits a final decision being called in question, was not applicable so far as concerns the relationship between the final decision in an opposition proceedings and an application for the declaration of invalidity, given, inter alia, that proceedings before the Office are administrative not judicial and that the relevant provision of Article 53(4) CTMR and Article 100(2) CTMR lay down no rule to that effect (Para. 12 with a reference to further judgements). The GC did not decide on the other pleas.

Case T-605/13 Alma-The Soul of Italian Wine LLLP v. OHIM; Judgment of 25 September 2014; language of the case: EN

RESULT: Decision annulled

KEYWORDS: Proof of use, Figurative trademark, Distinctive element, Lack of reasoning, Principle of legality.

FACTS: The applicant sought to register the figurative mark reproduced below for 'wines' in Class 33. Opposition based on the ES and CTM word mark VIÑA SOL, as well as the figurative ES mark reproduced below and the CTM word mark SOL, all for wines or alcoholic beverages (except beers). As regards



Articles 8 (1) (b) and 8 (5) CTMR, the Opposition Division (OD) upheld the opposition on the basis of the word mark SOL, cf. Article 8 (1) (b). On appeal, the Board of Appeal (BoA) upheld the opposition and rejected the CTM application, but referred to 8 (5) and the CTM VIÑA SOL. Before the General court (GC), the applicant alleges an infringement of Articles 64, 8(1) (b), 8(5) and 75 and 76(1) CTMR.

CTM applied for



Earlier mark

**VIÑA SOL
SOL**



SUBSTANCE: On the infringement of Article 75 and Article 76(1) CTMR the applicant claims that BoA did not take into account evidence intended to establish that consumers in the EU are used to marks for wine containing the words 'sol', 'sole', 'soleil' or 'sun' and/or images of the sun and to show that the word 'sol' and translations have a very weak distinctive character in the wine sector. The General court (GC) stated



Case law

that the reasoning of the decision may be implicit, on condition that it enables the persons concerned to know the reasons for the BoA's decision and provides the GC with sufficient material to review legality (Para. 19). Neither OD nor BoA mentions the evidence provided by the applicant. It cannot be held that even implicitly the BoA analysed the evidence in order to respond to the applicant's arguments (p. 21). The BoA acted in breach of its duty to provide a statement of reasons (Para. 23) and therefore the decision was annulled.

Case T-39/13; Cezar Przedsiębiorstwo Produkcyjne Dariusz Bogdan Niewiński v. OHIM; Judgment of 3 October 2014; language of the case: EN.

RESULT: Decision annulled

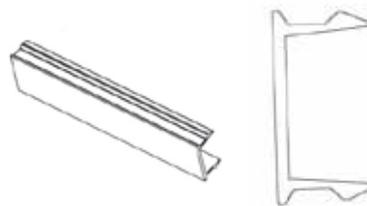
KEYWORDS: Design, Conflict of design with prior design, Novelty, Design: Overall impression, Catalogue, Individual character, Component part of design, Normal use of design, Visible features of design.

FACTS: The holder obtained registration for the design shown below, in respect of 'skirting boards'. The invalidity applicant filed an application for a declaration of invalidity, relying on Article 25(1)(b) of Regulation No 6/2002, read in conjunction with Articles 4, 5 and 6 of that regulation, and arguing that the contested design was not new, because it was anticipated by a third party's earlier design, as shown below. The Cancellation Division upheld the application for a declaration of invalidity. The Board of Appeal (BoA) dismissed the appeal, holding that the contested design lacked novelty and individual character. In particular, the BoA found that the contested design was part of a complex product as defined in Article 3(c) of Regulation No 6/2002 and that the only visible part of that design during normal use was the flat surface of its base part. Since the flat surface of the contested design was the same as the flat surface of the earlier design, the BoA concluded that the two

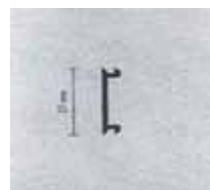


designs were identical and that, consequently, the contested design was not new and did not produce a different overall impression.

RCD



Earlier design



SUBSTANCE: The General court (GC) rejected the holder's arguments that (i) the contested design is a multifunctional product capable of being used in two potential ways (i.e. to cover a recess in a skirting board and to be cover a channel in a floor or wall), so that its use cannot be restricted to use as a component part of a complex product, and that (ii) Article 3(c) of Regulation No 6/2002 must be narrowly construed and that, consequently, a design must not be regarded as constituting a component part of a complex product unless that is the only reasonable way in which to use it. The GC found that from the file it was clear that the contested design constitutes a component part of a complex product, being intended to cover a recess in a skirting board (Para. 27), and the purely hypothetical use of the contested design in order to cover a channel in a floor or wall cannot be taken into account. The



Case law

GC then addressed the issue of whether the earlier design is visible during normal use and found that, although the BoA had held that the only visible feature of the earlier design was (as in the case of the contested design) the flat front surface, the catalogue which had been submitted by the invalidity applicant to prove the disclosure of the earlier design showed that this is to be attached to the back part of a skirting board (i.e. not used to cover a recess in a skirting board), so that it is not visible during normal use of the complex product of which it is a part (Para. 49). The GC thus annulled the BoA's decision, finding that an application for a declaration of invalidity cannot be based on an earlier design which, as a component part of a complex product, is not visible during normal use of that product by the end user (which in the case of skirting boards is the person occupying a room where skirting boards have been installed), this normal use excluding maintenance, servicing or repair work such as the installation or the replacement of cables in a recess of a skirting board, operations which would be carried out by specialists and not by the end user as defined above (Para. 53).

Case T-265/13; The Polo/Lauren Company, LP v. OHIM; Judgment of 18 September 2014; language of the case: EN

RESULT: Decision annulled

KEYWORDS: Relative grounds, Likelihood of confusion, Similarity of signs, Visual similarity, Conceptual similarity, Graphical representation

FACTS: The applicant sought to register the figurative mark shown below in Classes 18, 25 and 28. The opponent filed an opposition under Articles 8(1) (b) and 8(5) CTMR based on the two earlier marks shown below and covering, among other, goods in classes 18 and 25. The Opposition Division rejected the opposition. On appeal, the Board of Appeal (BoA) dismissed the appeal, finding that the signs at issue were dissimilar overall and that there could therefore be no



likelihood of confusion. Furthermore, in view of the fact that the signs at issue were not similar, the BoA found that one of the cumulative conditions for the application of Article 8(5) CTMR was not satisfied.

CTMA



Earlier marks





Case law



SUBSTANCE: The General court (GC) annulled the BoA's decision, considering that the signs at issue have, at least, a low degree of visual and conceptual similarity. In particular, the GC pointed out that in the applied for mark the graphic representation of a bicycle occupies an amount of space similar to that of the graphic representation of a person holding a polo mallet in the earlier marks, with the result that one of those representations cannot be given more weight than the other. Furthermore, the fact that the polo mallet is situated above the polo player has the effect of making that accessory clearly visible in the representation of the signs at issue. That element cannot be regarded as negligible (Para. 25). The similarities between the signs cannot be categorised as negligible or insignificant. In particular, the signs represent a person holding a polo mallet in the air. In both cases, the person is not represented in any specific colour and is represented head on, but slightly in profile, at quite similar angles. The same is true of the angle formed by the polo mallet. Furthermore, in both cases, the graphic representation gives the impression that the persons are in motion, which the intervener does not, moreover, dispute. Lastly, the relative dimensions of the signs at issue (that is to say, the ratio between the height and the width of the signs) are quite similar. Although the horse is galloping towards the left, whereas the bicycle is going towards the right, given the angles used, including that used for the polo mallet, and the relative dimensions of the signs at issue, a visual comparison of those signs gives the impression of a certain symmetry (Para. 26). On a conceptual level, the GC dismissed the applicant's argument that the contested mark would refer to bicycle polo, a sport which would be different from traditional polo. In that respect, the GC noted that there was no evidence in the file to suggest that bicycle polo is a sport or game that is sufficiently known to the relevant public for the graphic representation in question to have a clear and specific meaning so that that public will be capable of grasping it immediately. There is, therefore, necessarily a conceptual similarity between the signs, which may be categorised, at least, as low (Paras. 29-31). It must be held that, contrary to

the BoA's finding, the signs have a certain degree of similarity which may be categorised, at least, as low (Para. 32). The GC found that, since the BoA's finding was based exclusively on an absence of similarity between the signs, the arguments put forward by the opponent and alleging infringement of Article 8(5) CTMR must also be upheld (Para. 39).



Case law



New Decisions from the Boards of Appeal

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Decision of the First Board of Appeal of 5 September 2014 in case R 2332/2013-1 (ES)

Opposition – Article 8(1)(b) CTMR – Comparison of the goods in Class 33 – practice of dismissing oppositions and allowing CTM applications to proceed to registration in respect of goods which the applicant did not designate in the application form



The CTM applicant sought to register the figurative mark, for the following goods in Class 33: Alcoholic beverages, except beers.

The opponent filed an opposition on the basis of Article 8(1)(b) CTMR based on the earlier Community trade mark "EL ORIGEN", registered for wines in Class 33.

The Opposition Division upheld the opposition for the contested goods in Class 33 'alcoholic beverages, except beers'. However, the opposition was rejected for the following goods in Class 33 'alcoholic essences; alcoholic extracts; fruit extracts, alcoholic'. The Opposition Division considered that it was the applicant's intention to apply for the latter goods also. However, these goods and the earlier goods were considered by the Opposition Division to be dissimilar.

The opponent filed an appeal in which it requested that the Board also grant the opposition for the goods for which the opposition was rejected, namely the goods in Class 33 'alcoholic essences; alcoholic extracts; fruit extracts, alcoholic'. It argued that these goods and the earlier goods, wines, are similar.

The Board found, contrary to the contested decision, that the practice of dismissing oppositions and thereby allowing CTM applications to proceed to registration in respect of goods and services which the applicant did not designate in the application form and which were not published in the CTM Bulletin is incompatible with several, sometimes fundamental, norms of the CTMR (Articles 75, 76 and 83 CTMR).

Consequently, the Board annulled the contested decision as far as it allowed the contested sign to proceed for the following goods in Class 33: 'alcoholic essences; alcoholic extracts; fruit extracts, alcoholic'. The Board also ordered the reimbursement of the appeal fee.

Decision of the Fifth Board of Appeal of 16 September 2014 in case R 1369/2013-5 (EN)

Opposition – Article 8(1)(b) and (4) CTMR – effects of the revocation for non-use of an earlier CTM – examination of the claim of a non-registered sign, namely a movie title taken from the name of the opponent's restaurant in the USA.



Case law



The applicant sought to register the word mark 'COYOTE UGLY', for services in Classes 41 and 43.

The opponent filed an opposition on, inter alia, the basis of Article 8(4) CTMR based on a non-registered word trade mark, 'COYOTE UGLY', used in the course of trade in all the Member States.

The Opposition Division rejected the opposition. As to the earlier Community trade mark invoked, it stated that it was revoked by a final decision of the Office. It follows that the declaration of the revocation of the earlier mark on which the opposition is based means that the trade mark is no longer a valid earlier trade mark within the meaning of Article 8(2) CTMR and so cannot constitute a valid basis of opposition. Therefore, the opposition based on this earlier right and Article 8(1) and 8(5) CTMR is rejected. As far as the opposition is based on Article 8(4) CTMR, the Opposition Division ruled that the evidence submitted by the opponent is insufficient to prove that the earlier sign was used in the course of trade of more than local significance before the filing date of the contested trade mark in connection with the goods and services on which the opposition is based.

The opponent filed an appeal in which it requested that the Board annul the contested decision and reject the contested application. It is clear from the CTMR that the cancellation of an earlier Community trade mark which follows a request for revocation has no retroactive effect and does not continue to constitute a valid earlier right. With regard to the claims made in respect of Article 8(4) CTMR, the evidence of use was wrongly assessed by the Opposition Division. The alleged rights acquired by Disney/Touchstone were in respect of the personal life story of Liliana Lovell and of the bar that she operated in New York, but these solely allow the company

to make a movie based on that story/book. This should not restrict the overall rights the opponent possesses.

As a preliminary remark, the Board ruled that it is clear that according to Article 55(1) CTMR, in the event of revocation, and to the extent that the rights of the proprietor have been revoked, the earlier Community trade mark will be deemed not to have the effects specified in the CTMR as from the date of the application for revocation. It is evident that the opponent's mark was no longer valid at the filing date of the present opposition with the consequence that it could not be validly claimed in these proceedings. As to the opposition ground based on Article 8(4) CTMR, the Board decided that the evidence submitted does not prove any use of the claimed earlier non-registered mark in the course of trade which can be considered as use on behalf of the opponent in the EU territory in connection with the relevant goods and services claimed. In sum, the evidence is insufficient to establish a non-registered trade mark right for the opponent's claimed goods and services in any of the Member States which pre-dates the filing date of the contested mark. As the opponent has not established that it owned the claimed non-registered trade mark rights in the mark 'COYOTE UGLY' at the time of filing the contested mark, the opponent has not proven that it has a prior right which confers on it the right to prohibit the use of the contested mark.

In conclusion, the Board dismissed the appeal.



Case law



Decision of the Second Board of Appeal of 9 September 2014 in case R 783/2014-2 (SV)

Absolute grounds for refusal – figurative mark – Article 7(1)(b) CTMR – distinctiveness – goods in Class 25.

The CTM applicant sought to register the figurative mark



for goods in Class 25.

The examiner rejected the mark applied for under Article 7(1)(b) CTMR on the ground that the trade mark is not distinctive.

The Board referred to the fact that the trade mark applied for principally consists of circles that cannot be said to be commonplace or a pattern which typically can be repeated regularly on a surface or which commonly occurs as a decoration on different garments. The Board emphasised that it is not uncommon for players in the fashion sector to use, alongside word marks, also simpler figurative elements, logos or other symbols to indicate the commercial origin of the goods. The Board also held that the mark displays a certain degree of imaginativeness and inventiveness, not least through its concentric construction which creates an optical effect. In addition, the horizontal line which emerges at the centre of the middle element is visually prominent and contributes to the trade mark's overall impression. As the trade mark is constructed, viewed in its entirety, it is capable of being remembered, and enables the target group to identify the origin of the goods concerned and to distinguish them from those of other undertakings.

Consequently, the Board annulled the contested decision.

The Registry also recommends

Decision of the Fourth Board of Appeal of 15 September 2014 in case R 2519/2013-4 (EN)

Opposition – Article 8(1)(b) CTMR – level of protection to be awarded to trade marks devoid of distinctive character.

The applicant sought to register the word mark 'Neofon', for goods and services in Classes 9 and 38.

The opponent filed an opposition, inter alia, on the basis of Article 8(1)(b) CTMR based on several national and Community trade marks which comprise the name 'FON'.

The Opposition Division rejected the opposition in its entirety. The Opposition Division ruled that despite the identity between the goods and services, there is no likelihood of confusion considering that the relevant public understands the term 'FON' as referring to the term 'telephone' which is, therefore, weak and the public will not pay much attention to this element. Also the word 'NEO' will be considered weak for the goods and services at hand.

The opponent filed an appeal in which it requested that the Board annul the contested decision and reject the contested application. The opponent argued that the coinciding word in the earlier signs and the sign applied for, 'FON', could induce the public to believe that it comes from the same undertaking as the earlier rights, and would create a likelihood of confusion given that the former includes the latter in its entirety, adding to it the non-distinctive word 'NEO'.

The Board first ruled that the fact that an earlier trade mark no longer possesses, namely on the date of filing the opposed CTM, any distinctive character and is descriptive for the goods and services for which it is registered do not have any impact on its validity. In opposition proceedings, an earlier trade



Case law



mark's distinctive character must be assessed with respect to the date of application of the CTM applied for, or where applicable the date of priority. It has, therefore, no impact on the registrability of a trade mark, since any absolute grounds of refusal under the CTMR or national law must be assessed with respect to the date of application of that trade mark. The fact that a term is nowadays not distinctive also has no impact on possible revocation proceedings based on Article 51(1)(b) CTMR or the relevant provisions of national trade mark laws, since further factors such as the proprietor's behaviour, must be taken into consideration. The Board, furthermore, ruled that even though the goods and services are identical, other factors, such as the non-distinctive character of the earlier trade mark, are sufficient to exclude any likelihood of confusion, including the risk of association; a risk of association cannot be based on a non-distinctive element. In the application of the interdependence principle, it must be found that the identity of the goods and services is counteracted by the low degree of similarity between the signs and the differences arising from the additional element 'NEO' in the sign for which the CTM applied for seeks protection, which has no counterpart in the sign for which the earlier trade mark is protected.

In conclusion, the Board dismissed the appeal.