

# 10 years community design

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## A Decade of Registered Community Designs

A On 1 April 2003, the first registered Community design (RCD) applications began to arrive at OHIM's Alicante headquarters. By the end of that very first year, the Office would have received and processed almost 40.500 design applications.

Since then, and after a decade since the first designs came in, OHIM has received more than 690.000 applications, consolidating the registered Community design as a respected and highly valued IP asset by designers and companies around the world... [Page 2](#)

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## A Decade of Registered Community Designs

On 1 April 2003, the first registered Community design (RCD) applications began to arrive at OHIM's Alicante headquarters. By the end of that very first year, the Office would have received and processed almost 40.500 design applications.

Since then, and after a decade since the first designs came in, OHIM has received more than 690.000 applications, consolidating the registered Community design as a respected and highly valued IP asset by designers and companies around the world.

In celebration of this success story, and in recognition of the importance of the registered Community design right, OHIM will be hosting an international design conference in Alicante on 8 and 9 April this year.

The event has already attracted top figures from different areas of the international design community, with names such as Javier Mariscal (Estudio MARiscal), Quique Dacosta (Quique Dacosta Restaurante), Nuria Basi Moré (President Armand Basi) and Luis Chicho Guzmán (DG Hispánitas) already signed up as speakers.

The conference aims to bring together experts not only in the field of designs, but also from the legal world, from industry and academics, all of whom have been pivotal in making the registered Community design such a resounding success.

Under the co-chairmanship of IP specialist David Stone from Simmons and Simmons (UK) and José Manuel Otero Lastres, Professor of Commercial Law at the University of Alcalá de Henares, participants will be able to attend plenary sessions on issues such as design case law, filing practice and enforcement, with top-level keynote speakers from in the fields of industry design joined by in-house specialists from OHIM itself.

The more general plenary sessions will be complemented over the course of the two days by more specific break-out sessions on a wide array of topics, from fashion and urban design, to the use of design in the world of gastronomy and technology.

Prestigious UK professor of IP Law, Sir Robin Jacob, will open Day One's proceedings with a rundown of the achievements of the registered Community design over the past ten years. He will be joined by other top names, including the Head of the EU Observatory on the Infringements of Intellectual Property Rights and former Chairman of the Boards of Appeal, Paul Maier, renowned IP expert David Musker of Jenkins & Co. (UK) and Grégoire Bisson, Director of the Hague Registry, Brands and Designs Sector, WIPO.

The complex world of spare parts will also come under discussion, in a session chaired by World Trademark Review editor, Trevor Little, while Jeremy Phillips, well-known editor in chief of the Journal of Intellectual Property Law and Practice in the UK, will cover issues relating to urban design.

The conference provides a unique opportunity for design specialists, legal practitioners, academics and entrepreneurs to come together for in depth discussions with world experts on the latest trends and topics in the design field, and also to understand better the ins-and-outs of the registered Community design right as an essential IP asset for designers and companies across the globe.

More detailed information on the event, as well as the full downloadable programme and the registration form is available on the <http://10yearscommunitydesign.oami.europa.eu> website.

### Interview



#### The James Nurton Interview

This month James Nurton talks to David Stone, a partner of Simmons & Simmons in London, about ambush marketing, advising charities on IP and the forthcoming conference marking 10 years of the registered Community design.

#### When did you become interested in IP?

I studied IP at university in Australia and then went to work as a judge's associate at the Federal Court. The judge had one of the early Levi's cases where a third party had been selling what they called REVISE LEVI'S, taking second-hand

jeans and altering them with things like paint and dye. We were straight into some tricky trade mark exhaustion issues and famous marks such as the red tab and arcuate pocket stitching.

After that I worked in Freehills' IP group and handled a broad range of court cases including the only case to get to court on the Olympics IP legislation for the Sydney Olympics 2000. We acted for Ansett, which was the official airline, but about 60% of Australians thought Qantas was the official airline because of some fairly clever advertising using athletes. But they overstepped the line and Ansett was able to get redress.

The legislation was successful and was adopted for the Athens, Beijing and London games.

### **What brought you to Europe?**

I came to help open the Howrey London office and I was there from 2001 to 2008.

During that time, I was seconded to The Coca-Cola Company for just over 12 months as their IP counsel for western Europe. It was an interesting time for me to see things from the in-house counsel perspective. I hope it's made me a better outside counsel seeing some of the challenges that in-house counsel face and the importance of providing advice that is commercial, brief and clear.

### **What are the differences?**

In-house counsel are always closer to the business and will always know more about how it ticks. It involves a great deal more commerciality. That said, as outside counsel I aim to give clients commercial, realistic options for resolving problems.

### **What was Coca-Cola like to work at?**

It was fascinating. My work covered clearance, filing, oppositions and enforcement for all of western Europe. It's an honour and a privilege to help protect a \$77 billion brand. I've been lucky enough to work for them as outside counsel ever since.

### **What does your work cover now?**

I'm a member of the IP group at Simmons & Simmons in London, and we offer a one-stop shop for everything from clearance through to enforcement. Personally, as a soft IP lawyer, I cover everything apart from patents. But the role is broader than just the law: I'm responsible for the firm's international brands group with lawyers in Europe and Asia. To give you an idea of numbers, last year I did 27 performance appraisals.

I'm also responsible for the firm's art collection and I sit on the firm's *pro bono* committee and the diversity committee.

### **Do you mainly do contentious work?**

We very much encourage our team to do both contentious and non-contentious work. The team in London is a mix of solicitors and trade mark attorneys which we hope meets clients' needs in a cost-effective way. My feeling is that many law firms are moving that way. American clients in particular want a one-stop shop and don't understand why in England and Wales you need three people to do a job that's done by one person in the US.

I've been sitting at my desk doing clearances today. It's important for anyone doing enforcement to know the other end of the spectrum and vice versa. If you're doing clearance you need to know what the courts are going to say about similarity.

### **What kinds of clients do you have?**

Simmons & Simmons has a sector focus that includes life sciences and TMT, but a trade mark practice is always going to be mostly about fast-moving consumer goods. We act for clients as diverse as James Bond and Abercrombie & Fitch. I've a case in the High Court at the moment about the Glee television programme. I'm also proud of the *pro bono* work we do for Frieze Art Fair, English National Ballet, the Centre for Recent Drawing and Schools Out, a charity about bullying in schools, among others.

When they first come to us, a lot of charities haven't thought about registering their rights. Over time many develop new logos and we also work with them on their internet presence to make sure they protect their own rights and don't infringe those of others.

### **What do you think of OHIM?**

OHIM is doing well. There must be extraordinary challenges coordinating what will soon be 28 member states using 24 official languages (when Croatia joins), and building a common work culture. OHIM is efficient and cost-effective in registering rights.

The Observatory is a new challenge as it involves some new IP rights and, for the first time, OHIM will be looking at enforcement. Paul Maier is an inspired choice to head it and he will do a great job.

**What things would you like to see improved?**

One of them is the consistency of decision-making. There has been a tendency for examiners and members of the Boards of Appeal to consider themselves not bound by precedent. The purpose of precedent is predictability: that helps practitioners to advise clients and helps rights owners know where they stand without having to litigate. Precedent keeps costs down.

It's up to the parties to draw the relevant decisions to the attention of the relevant tribunal. After that, it's helpful for the tribunal to say "I'm following that decision" or "I'm not following it because the facts are different" rather than the current response that they don't follow precedent because they don't feel bound by it.

The issue is mostly with examiners and the Boards of Appeal. The statistics bear out that in many cases it's worth another roll of the dice to get a different answer on appeal. Until that changes, many parties will continue to do that to get the answer they want.

**Are you happy with the administrative procedures?**

You can file a RCD for €350 and get a registration number that afternoon: it's hard to think of any other IP right that does that, let alone one that covers 500 million people.

There are still improvements to be made in contested areas: often opposition proceedings can take too long and cases that go to the Court of Justice take far too long by any standard: a five to 10 year delay is unacceptable.

**Do you think any really big CTM issues are outstanding?**

I'd like to see the Court move away from its 'functions of a trade mark' jurisprudence. It was raised to deal with some particular problems but it creates difficulties. I heard someone mention that there might be as many as 15 functions, but I couldn't tell you what they all are.

It creates difficulties in jurisdictions that take the Court at its word. In identical mark, identical goods situations you now have to prove that it affects the functions of the mark, and that can significantly increase the costs of litigation, which is not what I imagine the Court intended.

If we start to get into the notion of the essential functions of a design in design law, that would be very problematic, so I'm hoping that won't happen.

**How did you become particularly interested in designs?**

It's not often that you see the birth of an IP right, so to watch that happen 10 years ago was remarkable.

Early on there was not a great deal of understanding how it worked. I chair the Designs Team of MARQUES. When we reviewed the first 150 RCD invalidity decisions, it was apparent that many cases were failing because they were poorly evidenced and poorly argued.

So I was delighted when Oxford University Press asked me to write a book on the subject – and the result, *EU Design Law: A Practitioner's Guide*, came out just before Christmas. The book is about registered and unregistered Community rights – looking at both the Regulation and the Directive.

I've tried to pull cases from across the EU from Ireland to Poland; Finland to Italy, as well as the Court of Justice, General Court and OHIM decisions. The idea is to put some bones on the legislation, especially those bits that may not have been thought about too much when they were copied over from other sources.

**How did you find the cases?**

The cases were incredibly difficult to find, and many are only in the original language. Trying to pull together some jurisprudence was enjoyable but challenging. Basic things like the format of judgments are very different across the EU so it can be hard to find the legal nuggets. I looked at about 900 cases altogether, including a high number of invalidity decisions before OHIM and about 150 Boards of Appeal cases.

I couldn't finish the book until the CJEU had published its decision in the *PepsiCo* case – the court's first major look at RCDs. Obviously the law will continue to develop so maybe another edition will be needed in due course.

**Tell me more about the Designs Conference in Alicante in April this year.**

The aim is partly to be a celebration but also for people to learn something. We hope to attract judges, practitioners, designers, students and rights owners to network and to leave with a better understanding of design and design rights. There are plenary sessions, and then two parallel breakout streams – one of which is legally focused and one less so. For example, there are sessions on gastronomic design, fashion design and urban design as well as specific legal issues such as the Hague Agreement and what's happening with mobile devices and spare parts.

The conference in the new auditorium in Alicante, which is a really beautiful venue. It takes place on April 8 and 9, almost exactly 10 years after the RCD was launched, and it's priced so as not to exclude anyone.

**Do you think there's a good understanding now of design rights in Europe?**

There have been improvements but there's still quite a way to go.

The unregistered right is perhaps used less often than was expected. Many fashion houses file each season's products as registered designs anyway even if they'll only be on the shelves for three years.

Designers in the US are always shocked that these rights are issued without substantive novelty examination. But anyone who thinks they can put their head in the sand and ignore design rights is mistaken: they are commercially very important, as the Apple-Samsung litigation has shown.

**So many things can be registered as designs. What are the most unusual you have seen?**

Moving designs have become more popular than I expected, for example for computer graphics. OHIM allows seven views, and these can be used to show the movement of an object. That's an innovative use, and OHIM has been registering them.

The inclusion of logos can be particularly useful and trade mark owners ought to give thought to registering new logos as designs, particularly because designs don't require you to specify goods and services. Many rights owners double file logos as trade marks and designs.

Anyone can see examples on the register of RCDs that are clearly not valid. For example, there's one for a slice of bread. But the existence of some invalid rights is not a reason to dismiss the system. It is a reason to be watching the system and ensuring that relevant invalid designs are invalidated rather than waiting for the owner to bring proceedings. That's particularly important with Customs seizures where by the time you challenge the seizure, perishable goods may be past their sell-by date. It would be sensible to have a watching service for designs just as you do for trade marks.

**What do you think the future holds?**

The biggest challenge is that more IP rights are going to collide as the world becomes one marketplace. We've seen phones turn into cameras, and we've seen music and technology collide. That will continue to lead to disputes.

Our role in the IP profession will become more and more globalised. So it's important to establish networks through associations such as INTA and MARQUES so as to have local contacts throughout the world.

Community Trade Mark

CTM

**CORRIGENDUM of the Manual Revision of Part A, Section 4: Language of Proceedings as announced in Alicante News of November 2012:**

The announced change of practice in the sense that in *ex parte* proceedings both the applicant and the Office are bound by the first language of the application, irrespective if it is one of the five languages of the Office or not, will for the time being not be implemented. The Office will further study the issue and keep this practice change on hold. In case that this change will be implemented, it will be communicated on time.

Consequently, as far as the *ex parte* proceedings are concerned the language regime will stay with the practice as we had before which is:

*The applicant may use: a) if the first language is one of the languages of the Office, only the first language; b) if the first language is not one of the languages of the Office, also the second language, at his free choice.*

*The Office will use: a) if the first language is one of the languages of the Office, only the first language, b) If the first language is not one of the languages of the Office, following the ECJ judgment "Kik", the Office will only use the first language, unless the applicant has declared in writing his consent to the use, by the Office, of the second language, in which case the Office will proceed accordingly. The consent to the use of the second language must be given for each individual file; it may not be given for all existing or future files.*

## Manual on Counterclaims

Within the framework of the revision of the Manual of Trade Mark Practice, the Knowledge Circle Register and other issues has created Part E, Section 6, Chapter 1 of the Manual on Counterclaims.

This manual is completely new and aims to give a detailed account of the steps involved in recording a counterclaim before the Office.

Counterclaims, as ruled in Article 100 CTMR or Article 84 CDR, are defence claims brought by a defendant who is sued for the infringement of a CTM or RCD. By way of such a counterclaim the defendant asks the Community trade mark court or Community design court to declare the revocation or invalidity of the CTM or the invalidity of the RCD which he is supposed to have infringed.

The Regulations state that the Community trade mark court or Community design court shall inform the Office of the filing of a counterclaim and, in case of a final judgment on it, provide the Office with a copy of the judgment.

However, the Office makes use of an extensive and non-restrictive interpretation and allows also the parties of the infringement procedure, in the context of which the counterclaim has been filed, to request the recordal of the filing of the counterclaim and of the final judgment on the counterclaim in the Register of the Office.

For this purpose the recordal applicant must provide the necessary information which is detailed in this new part of the manual dealing with the entries in the Register of the filing and final judgment of counterclaims. In any event, in the case of doubt or if information is missing, the Office will contact the Community trade mark or Community design court or the parties concerned.

The underlying idea for permitting the parties to request the recordal of the filing and the final judgment of the counterclaim in the Register of the Office, lies in the general interest to make all the relevant information on counterclaims concerning CTMs and RCDs available in the Register of the Office, in particular the final judgments thereof. In this way the Office may implement these final judgments, in particular those which declare the total or partial revocation or invalidity of CTMs as well as the total invalidity of RCDs. This procedure ensures that, where the Community trade mark court or Community design court does not inform the Office of the filing of a counterclaim or a final judgment thereof, this important information may still reach the Office and its Register through an application by another party. Consequently the Register will reflect the CTMs or RCDs which have been declared to be totally or partially revoked or invalid, thus complying with the principles of conformity to truth, public faith and the legal certainty of a public Register.

The Office has also updated its FAQ in this field.

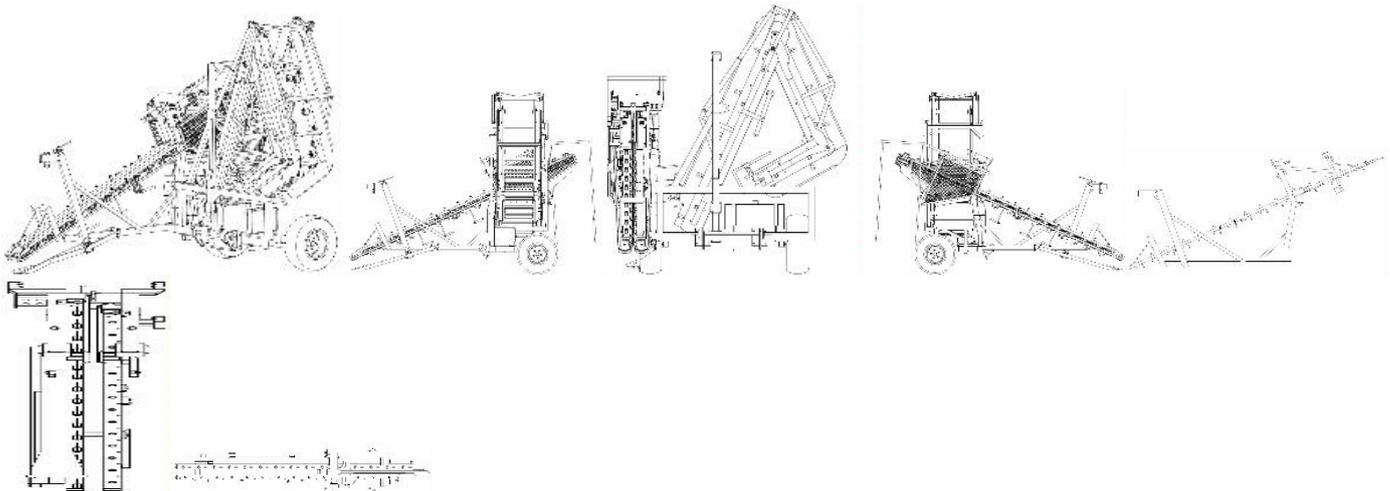
The new text will enter into force one month after publication.

**Decision of the Third Board of Appeal of OHIM in case No R 971/2011-3 of 20 December 2012**

In this decision the Third Board of Appeal upholds the appeal and annuls the Invalidity Decision declaring the invalidity of the Community Design Registration ('RCD'), namely RCD No 1 603 382-0001, for 'combine harvesters'.

*Factual and legal backgrounds*

A Polish company, Marzena Karczmarek, Agrotop-Karczmarek, was granted registration for the following RCD for 'combine harvesters':



The registration was subsequently the subject of an application for invalidity, based on the claim that the contested RCD was not new and lacked individual character because of prior designs. The invalidity applicant based its application on the following earlier design, known under the trade name 'Alina Supernova':



The Invalidity Division upheld the application for invalidity. It did so essentially, on the basis of Article 25(1)(b) in conjunction with Article 8(1) CDR. In this respect the Invalidity Division held that the Invalidity Applicant made a direct relation between the contested RCD of the harvester and its technical function. This line of arguments supported the claiming of Article 25(1)(b) in conjunction with Article 8 CDR as ground for the invalidity application. Thus, the Invalidity Division held that the appearance of the contested RCD was dictated by a number of essential technical features which were chosen with a view to achieving the best possible technical function (Para. 6).

*Summary of the Appeal decision*

The RCD proprietor lodged an appeal before the Board of Appeal on the following grounds: not all the features of the combine harvester are solely dictated by technical needs for the functioning of the machine concerned. The Invalidity Applicant did not invoke Article 8 CDR. To the contrary, the grounds for the application of invalidity were those of lack of novelty and individual character of the RCD. Therefore, the contested Decision was issued also in breach of Article 62 CDR and Article 38 CDIR.

The Third Board of Appeal upheld the appeal and annulled the contested decision.

As a first remark, the Board addressed the issue whether the Invalidity Division was legally entitled to base its decision on Article 25(1)(b) CDR in conjunction with Article 8(1) CDR. In this regard the Board held that it was apparent from the examination of the invalidity claims that the absolute requirement of registrability under Article 8 CDR was not invoked by the Invalidity applicant. Thus, the Invalidity Division erred in having based its decision on a ground which was not raised by the Invalidity applicant (Paras. 14, 18). As to the remaining, the invalidity claim challenging the lack of novelty and individual character of the contested RCD was found to be admissible. In assessing the said criteria, the Board took into account the nature of the product in which the design is incorporated, the specificities of the industrial sector concerned and the degree of freedom of the designer in developing the design (Para. 27).

As regards the nature of the product concerned, the Board made it clear that even though a harvester's outer appearance is secondary to its technical value, this does not prevent the producers from protecting it as a Community design. In fact, a design does not need to fulfil specific aesthetic requirements as a necessary criterion for protection (Para. 28).

As regards both the examination of the degree of freedom of the designer and the features that may or may not be regarded as the source of an individual character of the RCD, the Board held that it was necessary to assess the general technical characteristics of the machine concerned (Para. 30).

The Board stated that the colour of the harvesters was not relevant since the contested RCD was protected in black and white and the colours used on a model for sale on the market fell outside of the analysis. As to the similarity in length and construction of the rubber belts used on the up-lifter arm of the harvester, said technical detail was not apparent in the contested RCD, thus, falling outside of its scope of protection (Para. 32). As regards the remaining relevant parts of the designs under comparison, the Board concluded that their presence was dictated by technical necessity and, thus, could not be regarded as a design element *per se*. Therefore, the individual character had to be examined in the details of said three major parts taken individually (Para. 33). According to the Board, the similarities found between the designs under comparison were due to the overall identical technical solutions. Nevertheless, the degree of freedom of the designer was limited to the construction details of the machine's main elements. With that in mind, the Board considered that the contested RCD was endowed by a certain individual character and that, although to the effect of assessing the individual character in the specific sector concerned, it involves a certain technical knowledge, the informed user was deemed to possess such knowledge (Paras. 37, 38).

**Knowledge Circle "Designs"**

## EUTMDN Updates

### Bulgaria database harmonisation

The Harmonisation Project for Goods and Services has taken another important step forward with the integration of the Bulgarian Office into the "Harmonisation Community".

As a consequence, the Bulgarian version of the Common Harmonised Database on Classification of Goods and Services is now available to our users through the Euroclass application.

### A full house for EuroClass

All EU National Offices, including Croatia, are now integrated into EuroClass, with the final EU office – Latvia – joining at the end of December 2012.

The EuroClass tool brings together the classification databases (Goods and Services descriptions or terms) of each Participating trademark Office to facilitate the process of classifying Goods & Services.

The United States Patent and Trademark Office (USPTO), the Japan Patent Office and the Swiss Federal Institute of Intellectual Property are also integrated into the tool, which is available in 24 languages, including Japanese.

Following this latest integration, and in line with OHIM's Strategic Plan, final steps will be taken later this year to implement the name change of EuroClass to TMClass.

## Declaration of intent to link TMview and Global Brand database

OHIM and WIPO have published their Declaration of Intent to link TMview and WIPO's Global Brand Database.

The publication is in accordance with the Memorandum of Understanding between OHIM and the International Bureau of WIPO, signed on June 17 2011.

The two offices have pleasure in declaring that they intend to reinforce their cooperation, in order to promote their common objectives and policy on trademark information dissemination, with a view to enhancing the value and flow of such information among their respective member states, stakeholders and users.

OHIM and WIPO will therefore seek to provide users with access to a broader range of data through a link between TMview, managed by OHIM, and the Global Brand Database, managed by WIPO.

The aim of the linkup is to facilitate transparent and comprehensive information useful to trade mark applicants and owners at global level.

The declaration of intent can be accessed via the OHIM website.

More News



## A new Video Conferencing Network for OHIM

OHIM has now put its new Video Conferencing initiative in place, linking the Office with all the Industrial Property Offices of the EU. This means, in effect, that a new, EU-wide telepresence network has been born.

To make this happen, the videoconferencing team have been testing existing facilities at other IP offices – and in some cases making equipment available to offices that had none. Now, staff can enjoy more frequent – and efficient – “face to face” exchanges with national office IP colleagues, as well as reducing the amount of days they spend away on mission.

This will, of course, have a better impact on work-life balance here at OHIM and will help reduce the Office's environmental footprint.

## ANDEMA meet with OHIM

A delegation from Spain's national association for the defence of trade marks (ANDEMA) met recently with OHIM officials in Alicante to discuss a range of IP issues affecting their members.

ANDEMA is a non-profit-making association representing companies from a range of sectors and has a countrywide network of contacts in Spain that includes leading public bodies dealing with various aspects of brand protection and many private sector associations. At present, it has over 70 members, of all sizes and financial stature.

The meeting with OHIM touched on issues relating to Counterfeiting, efficient registration procedures and the role of the EU Observatory on the Infringements of Intellectual Property Rights.

**OHIM Service Charter updated**

The Office has published the latest Service Charter figures for the 4th quarter of 2012, which can be accessed via the [Office's website in the 'quality plus' section](#).

The OHIM Service Charter sets out concrete and measurable standards in the areas of accessibility, timeliness and quality of decisions - which guide the service policy of the Office.

**Texts from OHIM President**

The President of OHIM has issued Communication 4/12 concerning the enlargement of the European Union to Croatia and Decision EX-12-6 concerning the extension of time limits.

[Both texts are available on the Office's website.](#)

**Monthly statistical highlights\* December 2012 compared to December 2011**

	2012	2011
Community trade mark applications received	8 656	9 776
Community trade mark applications published	7 205	7 425
Community trade marks registered (certificates issued)	7 255	7 367
Registered Community designs received	7 129	6 366
Registered Community designs published	3 965	4 714

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

**Case law****Luxembourg Case Law****A: Court of Justice: Judgments and Orders**

**Joined Cases C-101/11 P and C-102/11 P; OHIM v José Manuel Baena Grupo, S.A.; Judgment of 18 October 2012; Language of the case: ES**

**Keywords: Design, overall impression, informed user, conflict of design with prior trade mark, duty to state reasons**

**RESULT: Action dismissed**

**FACTS:** The Cancellation Division declared the invalidity of the contested design on the basis of Article 25(1)(e) CDR. The Board of Appeal confirmed the invalidity of the contested design but for another reason, namely lack of individual character. The GC annulled the decision of the Board, finding that the differences between the two silhouettes are sufficiently significant to create a different overall impression on the informed user. The matter was appealed to the Court of Justice.

CTM n° 1312651, basis of the invalidity action	RCD n° 000 426 895-0002
	

**SUBSTANCE:** The GC did not exceed the limits of its review, nor did it substitute its own assessment for that of OHIM. The Office has not established that the assessment in question required highly technical assessments that justify the recognition of some latitude, such that the scope of the GC’s review is limited to manifest errors.

The concept of the ‘informed user’ must be understood as lying somewhere between that of the average consumer, applicable in trade mark matters, who need not have any specific knowledge and who, as a rule, makes no direct comparison between the trade marks at issue, and the sectorial expert, who is an expert with detailed technical expertise. Thus, it may be understood as referring, not to a user of average attention, but to a particularly observant one, either because of his personal experience or his extensive knowledge of the sector in question (Para. 53). When comparing the earlier mark and the contested design, the GC did not err in law by basing its reasoning on the informed user’s imperfect recollection of the overall impression produced by the two silhouettes.

The reasoning followed by the GC in the judgment under appeal is in itself clear and intelligible and enables the reasons to be known why the GC upheld the single plea put before it by the holder of the RCD (Para. 81).

**Case C-611/11; Para AG v OHIM; Order of 10 October 2012; Language of the case: FR**

**Keywords:** Admissibility, alteration of subject-matter, duty to state reasons, letter mark, figurative trade mark

**RESULT:** Action dismissed

**FACTS:** The CJ rejects as manifestly unfounded an appeal against a GC judgment which had confirmed the legality of a decision whereby the Board of Appeal had dismissed likelihood of confusion between the marks shown below (letter A). The GC had confirmed that the ‘very specific graphic appearance’ of the CTMA neutralised the coincidence in the letter ‘A’ and rendered the signs similar to a low degree only, visually. The GC found that the signs could not be pronounced. Likelihood of confusion was dismissed given that a single letter without any graphic element has a limited distinctive character *per se*.

CTMA (Classes 16, 18, 25)	Earlier German registration (Classes 18, 25)
	<p style="text-align: center;">A</p>

**SUBSTANCE:** On appeal, the CJ confirms that the reasoning adopted by the GC was adequate (Paras. 37-38, 49 and 52) and found that the remaining arguments submitted by the appellant (which challenged the evaluation of the degree of attentiveness of the public and of the risk of confusion) related exclusively to the factual assessment made by the GC – such factual findings being insusceptible to being reviewed by the CJ (Paras. 42-47). The CJ also dismisses as inadmissible a plea which had not been submitted before the GC (namely that the GC should have annulled the Board’s

decision on account of a breach of Article 76 CTMR), the effect of which was to alter the subject matter of the dispute (Para. 58).

**Case C-649/11 P; Cooperativa Vitivinícola Arousana, S. Coop. Galega v OHIM; Order of 29 October 2012; Language of the case: ES**

**Keywords: Admissibility, duty to state reasons, right of defence, name**

**RESULT: Action dismissed**

**FACTS:** The applicant applied for the CTM **ROSALIA DE CASTRO** (word mark) for goods and services in Classes 32, 33 and 35. An opposition was raised based on the Spanish word mark **ROSALIA** for goods in Class 33. The OD rejected the opposition. However, the Board of Appeal found a likelihood of confusion between the signs. The General Court confirmed the existence of likelihood of confusion. The matter was appealed to the Court of Justice.

**SUBSTANCE:** The appeal is in part manifestly inadmissible and in part manifestly unfounded. The GC did respect its duty to give reasons and did not breach the right of defence. Furthermore, it did not err in applying Article 8(1)(b) CTMR.

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

**Case T-357/09; Emilio Pucci International BV v OHIM; Judgment of 27 September 2012; Language of the case: ES**

**Keywords: Proof of use, complementary goods and services, reputation, unfair advantage, detriment to earlier mark, error by OHIM**

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

**FACTS:** The applicant sought to register the figurative mark **EMIDIO TUCCI** for products in Classes 1-45. The opponent based its opposition on its Italian and Community word and figurative reputed marks **EMILIO PUCCI**. The Opposition Division partly allowed the opposition. The Board of Appeal partly annulled the OD's decision with regard to some categories of goods in Classes 3, 9, 20, 21 and 22. The opponent appealed to the General Court.

**SUBSTANCE:** The Board erred in not finding that genuine use had been proved with regard to 'spectacles' in Class 9. The GC dismissed the alleged infringement of Article 8(1)(b) CTMR. Regarding Article 8(5) CTMR, the GC confirms the reputation of the Italian mark in relation to 'clothes and shoes for women'. The contested decision found that the registration of the sign applied for in relation to 'perfumes and cosmetics' in Class 3 would allow the applicant to take unfair advantage of the repute of the opponent's earlier Italian mark of 1966. The GC found that the contested decision should have applied the same reasoning to 'spectacles' in Class 9, as well as to 'jewellery, costume jewellery and watches' in Class 14. The contested decision held that the registration of the sign applied for in relation to 'household products' in Class 3 as well as 'articles for cleaning purposes and iron wool' in Class 21 could be detrimental to the image of exclusivity and high quality associated with the earlier mark. The GC found that the Board erred in not applying the same reasoning and conclusion to 'non-perfumed toilet paper' in Class 16.

**Joined Cases T-83/11 and T-84/11; Antrax It Srl v OHIM; Judgment of 13 November 2012; Language of the case: IT**

**Keywords: Freedom of designer, individual character, Locarno classification, informed user, circles specialized in the sector, lines of design, duty to state reasons**

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

**FACTS:** The RCD holder was granted registrations as Community Design ('RCD') for 'radiators for heating' in Class 23-03 of the Locarno Classification. The registrations were subsequently the subject of an application for invalidity, based on the claim of lack of novelty and individual character. The Invalidity Division upheld the application for the declaration of invalidity. It did so essentially, as regards novelty, on the basis that the prior design and the contested RCD were substantially identical since they showed differences which only concerned immaterial details. The Board of Appeal annulled the Invalidity Decision and declared the RCD invalid for lack of individual character pursuant to Article 6 CDR, rather than for lack of novelty. The RCD holder filed an action before the General Court, alleging infringement of Article 6 CDR.

**SUBSTANCE:** As regards the definition of informed user, the General Court confirmed that the informed user has to be understood not as a user of average attention, but as a particularly observant one, either because of his personal experience or of his extensive knowledge of the sector concerned. This does not imply that the informed user is able to distinguish those elements of the appearance of a product which are merely dictated by its technical function from those that are arbitrary (Paras. 39, 40).

As regards the scope of protection of a design registration, the General Court clarified that the indication of the product and the classification thereof, is only used by the OHIM for administrative purposes. That being the purpose of the terms used by the OHIM to indicate the products in which the design is intended to be incorporated, such an initiative does not replace nor invalidates the description indicated in the application for design registration. Moreover the protection afforded by the design is not about the concrete size of a product to which the design is intended to be applied (Paras. 56, 57).

As regards the assessment of the individual character of the contested designs, the General Court considered the use of broken lines as meaning that those parts of the designs, namely the ends of the collectors, fell outside of the scope of protection (Para. 55). Therefore, according to the General Court, in this case, what is relevant, are the differences in proportions (Para. 71).

The General Court took the view that the Board of Appeal failed to give reasoning on a point raised by the parties before the OHIM, namely that of the density of the field concerned (Paras. 77, 79, 98). In this respect the Court shed light on the relevance of the density of the prior art in the field concerned for the assessment of the individual character of a design. In this case the degree of freedom of the designer was not limited since the RCD holder failed to prove any technical or legal constraints (Para. 50). However the Board of Appeal should have considered the claim raised by the RCD holder before the OHIM, following which the field of the radiators for heating has a high density in terms of designs displaying similar features. This fact has an effect on the perception of the informed user so that the differences in internal proportions of the designs concerned, would be immediately perceived by the informed user and would therefore lead to different overall impressions (Para. 77). The General Court clarified that the reduced degree of freedom of the designer, due to the existence of technical or regulatory constraints, is a different matter from that of the density of the field concerned. In fact, according to the Court, if a specific sector is considered to be characterised by high density of the prior art, this is for the party alleging it to prove that the informed user is deemed to be more attentive to the differences between the designs in question (Para. 89). The General Court clarified that the question whether a design does or does not follow a general design trend, is relevant in relation to the aesthetic perception of the design and can, therefore, possibly have an influence on the commercial success of the product (Para. 94). However the existence of any such design trends cannot be treated as a valid factor to limit the degree of freedom of a designer who, by contrast, has the freedom to discover new forms, new trends and even to innovate within an existing trend. For such evaluation, the aesthetic considerations or considerations related to the commercial success of a product in which the design is incorporated do not count (Paras. 95, 96).

**Case T-22/12; Fomanu AG v OHIM; Judgment of 11 December 2012; Language of the case: DE**

**Keywords: Slogan, laudatory mark, function of a trade mark**

**RESULT: Action dismissed**

**FACTS:** The applicant sought to register the slogan **Qualität hat Zukunft (quality has future)** for goods and services in Classes 9, 16 and 40, inter alia, 'CDs, DVDs, computer programmes and software, paper, printed matter, printing services'. The Examination Division's decision, rejecting the CTM application based on Article 7(1)(b) CTMR, was confirmed by the Boards of Appeal. The CTM applicant appealed to the GC.

**SUBSTANCE:** The GC confirmed its jurisprudence with regard to slogans. The registration of marks made up of signs that are also used as advertising slogans is not excluded as such by virtue of such use (Para. 15). There are no different criteria for slogans. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories (Para. 17). It cannot be excluded that this could be the case with regard to advertising slogans as well, in particular, if it were established that the sign served a promotional function consisting, for example, of commending the quality of the product in question and that the importance of that function was not manifestly secondary to its purported function as a trade mark, namely that of guaranteeing the origin of the product. In such a case, the authorities may take account of the fact that average consumers are not in the habit of making assumptions about the origin of products on the basis of such slogans (Para. 18). As regards the case at hand, the GC agreed with the Board of Appeal that the relevant public (German speaking average and specialist consumers) would understand the sign as the statement that the goods and services to which it is applied are of high quality and durable.

They have no reason to understand the sign as a reference to the commercial origin of the goods and services (Para. 29). The sign contains a promotional message, in relation to which the relevant public will have only a low level of attention and which will not make them think about different interpretations or commit the sign to memory (Para. 30). Contrary to the applicant's claim, the Board of Appeal did not consider that a slogan had to be reputed to be registrable. The Board merely referred to its' understanding that the resonance (Prägnanz) of the slogan in case C-398/08 (Vorsprung durch Technik) followed, inter alia, from the fact that the sign was famous and had been used for many years. The GC agreed with the Board's interpretation of the judgment in C-398/08 (Para. 33).

**Case T-34/10; Hairdreams HaarhandelsgmbH v OHIM; Judgment of 13 December 2012; Language of the case: DE**

**Keywords: Identity of the goods and services, similarity of the goods and services, beginning of mark, error by OHIM, no bearing on decision**

**RESULT: Action dismissed**

**FACTS:** The CTM applicant sought to register the word mark **MAGIC LIGHT** for hair-related goods and services in Classes 3, 8, 10, 21, 22, 26 and 44. The opponent based its opposition on the earlier German word mark **MAGIC LIFE**, registered for goods in Class 3. The Opposition Division partly upheld the opposition, namely in relation to the goods and services in Classes 3 and 44. The Board of Appeal dismissed the applicant's appeal as there was a likelihood of confusion. The applicant appealed to the General Court.

**SUBSTANCE:** The relevant public is composed of the average German consumer. The goods in Class 3 are identical and the services in Class 44 are similar to the goods of the earlier mark in Class 3 (not disputed). The consumer generally pays greater attention to the beginning of a mark than to the end (Para. 28). In the present case, the consumer will pay greater attention to the term 'Magic'. The terms 'life' and 'light' are not dominant. Even though the ending of the second word in both marks differs, there is strong visual similarity (Paras. 29 and 30). The applicant does not contest the Board's finding that there exists a strong phonetic similarity between the marks. The typo in the Board's finding on conceptual similarity (the Board mentioned MAGIC HAIR instead of MAGIC LIGHT) is of no consequence (Paras. 33 and 34). It does not mean that the Board compared the wrong marks. The marks are conceptually similar based on the term 'Magic' which the consumer would connect to the German adjective 'magisch' (Para. 36). The conceptual differences between the marks based on their second word components are not sufficient to neutralize the strong visual and phonetic similarity between the signs (Para. 40). Although the goods relevant in the present case are usually purchased after having been seen by the consumer (rarely ordered orally), in view of the strong visual similarity between the signs, this argument by the applicant does not change the assessment that there is a likelihood of confusion (Para. 43).

**Case T-461/11; Natura Selection, SL v OHIM; Judgment of 13 December 2012; Language of the case: ES**

**Keywords: Identity of the goods and services, similarity of the goods and services, visual similarity, phonetic identity, conceptual identity, figurative trade mark, request for proof of use, beginning of the mark, complex mark**

**RESULT: Action dismissed**

**FACTS:** The CTM applicant sought to register the figurative mark **natura** (shown below) for goods in Class 20, inter alia, furniture. The opponent based its opposition on the earlier word CTM **NATURA**, registered for goods in Class 20. The Opposition Division upheld the opposition. The Board of Appeal dismissed the applicant's appeal as there was a likelihood of confusion. The applicant appealed to the General Court.

CTMA	Earlier Spanish mark
	<p data-bbox="906 1758 1013 1787">NATURA</p>

**SUBSTANCE:** The relevant public is composed of the average consumer in the EU (not disputed). As regards the comparison of the goods, the GC rejected the applicant's argument that the opponent used its mark for furniture made from other materials than those for which the applicant used the mark applied for. The products have to be compared as

applied for/registered, not as used (unless the opponent has to prove use following a request of the applicant) (Para. 31). The goods designated in the CTM application are in part identical and in part similar to the goods protected by the earlier right (Para. 34). The Board did not err in according the earlier right an average level of distinctive character. Although some of the products could be made from natural materials or be produced in such a way as to not pollute nature, there is, however, no direct and concrete link to the products in question (Paras. 41 and 42). The signs are visually similar. Although the figurative element of the mark applied for is not insignificant and needs to be taken into account in the comparison of the marks, the differences are insufficient to counterbalance the similarities, namely the identical word element, placed at the beginning of the mark and thus having a greater impact (Paras. 49 and 50). The marks are phonetically identical. They are also conceptually identical. The figurative element in the mark applied for reinforces the reference to nature (Para. 54). The Board rightly found that there was a likelihood of confusion. A possible reputation of the CTM applied for is not relevant for this assessment (Para. 62).

**Admissibility:** The GC declared the applicant's plea to accept the CTM applied for in relation to the goods in Class 20 to be inadmissible as it was directed towards the Court declaring that the mark had to be registered. The GC does not order OHIM to register a CTM (Paras. 13 and 14). The Court furthermore declared the applicant's request for the opponent to prove the use of the earlier mark to be inadmissible as it had been raised for the first time before the Court (Para. 18).

**Case T-357/11; Bimbo, SA v OHIM; Judgment of 14 December 2012; Language of the case: ES**

**Keywords: Reputation, dissimilarity of goods and services, survey, unfair advantage, detriment to earlier mark**

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

**FACTS:** The CTM applicant sought to register the figurative mark **GRUPO BIMBO** reproduced below for goods and services in Classes 5, 29, 31 to 32, 35 and 43. The opponent opposed the registration on the basis of several marks, in particular the Spanish word mark **BIMBO** for products in Classes 5, 29 and 30. The grounds were those laid down in Article 8(1)(a) and (b) and 8(5) CTMR. The OD upheld the opposition. On appeal, the Board partially upheld the appeal and allowed the registration to proceed for a number of goods and services in Classes 5, 31, 32, 35 and 43. The Board considered that there was a likelihood of confusion for the products and services found identical, but that there was no evidence of an unfair advantage or prejudice ex Article 8(5) CTMR. Before the General Court, the opponent claims that Article 8(5) CTMR was incorrectly interpreted and applied.

CTMA	Earlier Spanish mark
	

**SUBSTANCE:** The GC confirms the similarity of the signs (Para. 35) as well as the finding that the Spanish public will perceive the element GRUPO in the CTM applied for as a reference to the kind of company rather than as a mark (Para. 33). The Board of Appeal declared that the reputation of the earlier mark had been proved for 'industrial bread'. During the examination under Article 8(1)(b) CTMR it also declared that BIMBO is the number one in Spain regarding 'industrial bread' and that an opinion poll showed in 2004 that 77% of the people mentioned BIMBO first when they were asked about industrial bread. The Board concluded that BIMBO has a 'very strong distinctive character' for this product.

The GC states that, the stronger and more immediate the evocation of the earlier mark by the CTM applied for, the bigger is the risk that with its current or future use it will take unfair advantage of the distinctive character or of the reputation of the earlier mark. It is therefore possible, particularly in the case of an opposition based on a mark with an exceptionally high reputation, that the probability of a future, non-hypothetical risk of detriment to the earlier mark or of unfair advantage being taken of it by the mark applied for is so obvious that the opposing party does not need to put forward and prove any other fact to that end (see Judgment of 17 March 2010, Case T-63/07, Mäurer + Wirtz GmbH & Co. KG / OHIM (tosca de FEDEOLIVA / TOSCA), ECR II-957, Para. 40)). Therefore, when the opponent claims an exceptionally high reputation of its earlier mark, the Board of Appeal must first verify the exact degree of such reputation. Should it prove to be exceptional, the Board must examine whether such reputation is enough to consider that there exists a non-hypothetical risk of detriment or of unfair advantage with regard to each of the goods and services which are not similar to those covered by the earlier mark. The Board should have carried out such examination (Paras. 43 and 44).

Furthermore, the GC found in the Board's file some documents that prove that the reputation of the earlier mark is even higher (Paras. 45 and 46).

The Board of Appeal infringed Article 8(5) CTMR because it did not globally appreciate the effects of the use of the CTM applied for on the reputation of the earlier mark, taking into consideration, in particular, the degree of similarity of the signs, the intensity of the reputation and the degree of distinctiveness of the earlier mark, as well as the nature and degree of proximity of each of the products and services at hand (Para. 50).

### New Decisions from the Boards of Appeal

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### Opposition – Article 8(1)(b) CTMR

**Decision of the Second Board of Appeal in Case R 2480/2011-2 of 18 October 2012 - IDO / <sup>يودو</sup> U-DO (U-DO – fig.) – en**

The applicant sought to register the word mark **IDO** for a list of goods in Classes 3, 5, 11, 20 and 21.

The opponent filed a notice of opposition against the registration of the CTM applied for, for part of the goods, namely the following goods in Class 3:

Class 3 – Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps

based on Community trade mark No 3 902 277 of the figurative mark

**يودو**  
**U-DO**

registered for Class 3 – Preparations for use in unblocking drains; cleaning preparations for general use; soap.

The Opposition Division adopted the contested decision by which it rejected the opposition.

The opponent filed a notice of appeal against the contested decision.

The Board considered that, taking into account, in particular: the identity and similarity of the conflicting goods (Class 3); the principle of imperfect recollection in the consumer's mind; the consumer's level of attentiveness in the purchase of the goods in question, which is not particularly high; the visual similarity and the rather high phonetic similarity (which are not counteracted by any conceptual difference) of the two marks, at least for French-speaking consumers of the European Union, the Board considers, contrary to what was found in the contested decision, that a likelihood of confusion cannot be excluded, at least for part of the above-mentioned consumers,. In other words, those consumers are likely to believe that the identical and similar goods marketed under the marks in dispute come from the same undertaking or, as the case may be, from economically-linked undertakings.

Therefore, it upheld the appeal and annulled the contested decision.

**Cancellation – Articles 52(1)(b) and 53(2)(c) CTMR****Decision of the First Board of Appeal in Case R1163/2011-1 of 31 October 2012 - TONY MONTANA – en**

The CTM proprietor registered the word mark **TONY MONTANA** for goods and services in Classes 3, 18, 25 and 35.

The cancellation applicant claimed that it is the owner of registered copyrights on the name 'Tony Montana', who is the main character in the famous motion picture 'Scarface' directed by Brian De Palma. The movie was created in November 1983 and registered at the U.S. Copyright Register on 27 February 1984. According to the cancellation applicant's claim, the copyrights on this cinematographic work are also automatically protected in the EU Member States under the 'Berne Convention', to which both the United States and the European Union are party.

The cancellation applicant invoked the absolute ground of Article 52(1)(b) of the Community Trade Mark Regulation ('CTMR') alleging the bad faith of the CTM proprietor at the moment of filing the contested CTM and the relative ground of Article 53(2)(c) CTMR in conjunction with Article 9(1)(c) of Spanish Trademark Law No 17/2001 of 7 December 2001 ('STL').

The cancellation applicant relied on Article 9(1)(c) STL in conjunction with Article 5(2) of the Berne Convention, which bars the registration as a trade mark of signs that reproduce, imitate or adapt works protected by a copyright. Moreover, Article 52 STL states that a trade mark registration shall be declared invalid where it has been made contrary to the provisions of Article 9 of the same law. The cancellation applicant argued that, on the other hand, Spanish Copyright Law No 1/1996 of 12 April 1996 ('SCL') does not require a copyright to be registered and protects (*inter alia*) cinematographic works because of the sole fact of their creation (Articles 1 and 1.10). Finally, the cancellation applicant claimed that Article 17 of the SCL confers on the author the exclusive right to make any commercial use of the creation and to prohibit any unauthorised use by third parties.

Therefore, the cancellation applicant argued that Spanish case-law acknowledges that copyrights entitle their holders to challenge trade mark registrations or applications. It also attached further documentation which in its opinion establishes that the character, 'Tony Montana', is a name which not only belongs to a protected work, but also enjoys reputation as such in various EU countries. It also cited a decision issued by the Cancellation Division in Case 1509 C stating that although the use of the copyright in a sign is not a condition for the existence of the copyright, the fact that the sign was used is to be considered as proof that the copyright existed prior to the date of filing of the challenged CTM.

The Cancellation Division adopted the contested decision revoking the challenged CTM in respect of all the registered goods and services.

By its appeal, the CTM proprietor contests the Cancellation Division's finding that the cancellation applicant holds copyrights on the fictional character's name 'Tony Montana' since, in its opinion, this is a mere name and copyright protection for mere names shall be excluded. In addition, the CTM proprietor insists on the fact that in its view the name 'Tony Montana' lacks originality.

The Board considers that the evidence filed is sufficient to confirm that copyright on the cinematographic work 'Scarface' existed since 1984, that is prior to 24 November 2006 which is the filing date of the CTM application. The evidence in question shows also that the cancellation applicant is currently entitled to this copyright and that such copyright on this motion picture exists and is protected in Spain.

The Board acknowledges that, in principle, copyright protection on a cinematographic or literary work is not automatically extended to its characters. However, this does not mean that under certain circumstances said extension of protection of a fictional character, including his/her name when it is commonly used as identification, is possible. It shares the Cancellation Division's consideration that to warrant copyright protection, a fictional character must be specifically described and fully developed in order that his/her characteristics and features are capable of reproducing the expression of the intellectual creation of his/her author. Likewise, the Board endorses the cancellation applicant's argument that, in most cases, the names of fictional characters are indivisible from the characters themselves.

The evidence submitted by the cancellation applicant corroborates the argument that the cinematographic work 'Scarface' portrays the uniqueness of a particular character, namely that of the drug lord and Cuban gangster 'Tony Montana'. Said character has a specific and not banal name, a certain, defined, physical appearance and a recognizable attitude.

Furthermore, the evidence shows that the fictional character in question is also notorious.

Taking into consideration Spanish doctrine as well as the Spanish Court's decisions regarding the protection of fictional characters under Spanish law which have been provided by the cancellation applicant, the Board confirms that the fictional character in question, *per se*, can be subject to protection as intellectual property since it is able to represent specific content of the cancellation's applicant cinematographic work.

The Board concludes that the Cancellation Division correctly assessed that the challenged CTM must be considered contrary to the cancellation applicant's earlier right under Article 52 STL in conjunction with Article 9 of said law, reference to which was made as national law governing the earlier right by virtue of Article 53(2) CTMR.

As a result, the registration of the challenged CTM is contrary to the cancellation applicant's earlier copyright on the fictional character and name of 'Tony Montana' pursuant to Article 53(2)(c) CTMR and the contested decision on that point must be confirmed.

Moreover, the Board also finds that the cancellation applicant's claim pursuant to Article 52(1)(b) CTMR (bad faith) must be upheld for the following reasons: the Board finds that in 2006 the CTM proprietor had at least knowledge of the existence of the cancellation applicant's motion picture as well as the iconic 'Tony Montana'; in 2006 the challenged CTM for the name 'Tony Montana' had been registered for goods and services in Classes 3, 18, 25 and 35, which are all the goods and services commonly used in merchandising such as, for instance, clothing or perfumery. Therefore, it is reasonable to believe that by filing and registering the challenged CTM, the CTM proprietor attempted to hinder the merchandising activity of the cancellation applicant and take unfair advantage of the notoriety of the character, 'Tony Montana'.