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Five years of TMview

In April 2015, TMview marked its fifth year of existence. When it began, in 2010, it had around 4 million trade marks and data from eight EU national and regional IP offices, plus OHIM and WIPO. On its fifth birthday, that figure had increased to 25.4 million trade marks and 38 offices across the globe.

By August of 2010, the total number of searchable trade marks was around five million. Spain had joined, bringing the total number of IP offices covered to nine – and already the tool was proving its popularity with users. During the first few months of its existence, it had already had tens of thousands of searches in its database, with users from Denmark, Italy and Spain among the most frequent visitors.

The tool grew incrementally over the next few years, adding EU national IP offices and growing in volume as it did so. But in July 2013, TMview made its first big leap beyond the EU, with the incorporation of trade marks from the Norwegian and Mexican IP offices. Norway and Mexico formed part of a 1.1 million increase, along with Cyprus and the EU's newest member, Croatia.

The integration of the Turkish IP Office in September 2013 brought another million trade marks into TMview, while Morocco's integration in late 2013 saw the tool add an Arabic interface, which opens TMview up to the Arab speaking world.

Its Spanish interface opens it up not just to Spain and Mexico, but to Latin America and the international Spanish-speaking community. The tool is always



available in at least one official language of each integrated office.

At the end of December 2013, TMview had its single biggest wave of integrations. The inclusion of the Russian national IP office Rospatent and the United States Patent and Trademark Office brought in 400,000 Russian marks and 6.8 million US marks, boosting TMview's total to more than 20 million marks. At the start of 2014, Korea became the latest office to join, with 2.7 million Korean trade marks.

Since then a further wave of implementations has taken place. Iceland, the Philippines and Tunisia have all added their data to TMview, and further expansions are planned.

Users from the ASEAN group of countries are also served by [ASEAN TMview](#), which is the common online trademark information platform of the ASEAN Member States aimed at making ASEAN trademark data widely available and easily accessible to all interested stakeholders. It is available in English and in six languages of the region.

Like TMview itself, ASEAN TMview is free to use. It currently contains nearly 2.6 million trade marks from eight participating ASEAN countries, and has been developed by the Intellectual Property Offices of the ASEAN Member States themselves, with the support of the EU-ASEAN Project on the Protection of Intellectual Property Rights (ECAP III Phase II) administered by OHIM.

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The James Nurton Interview



Peter Ruess, Partner, Arnold Ruess, Düsseldorf; and Professor of Law, International School of Management, Dortmund and Frankfurt/Main

What is your background?

I became interested in IP very early. I had excellent professors at law school and I was captivated by it and it was fun. I took a course in IP and then I had the chance to stay on at university as an assistant lecturer for two years and did my doctorate and I was really happy to do so. This specialisation developed into an LLM in IP Law, which I did at George Washington University in the United States, and then I was an intern at the Court of Appeals at the Federal Circuit in Washington DC.



Peter Ruess

The two professors that really inspired me were Professor Dr Olaf Sosnitza at the University of Würzburg and my doctoral supervisor Professor Dr Peter W. Heermann of the University of Bayreuth.

What appealed about IP?

What I liked about IP was that the teachers came into the classroom with objects. Right up to today I like the fact that we deal with real things. In our office today we have the Heinz ketchup bottle, the Sony Playstation, travel catalogues and so on. You have products you can touch and use and which you see in the supermarket. That's very different to, say, financial law. It's a living thing. Most of what we do is litigation and it starts with a test purchase of a product. So you are literally starting with the real product.

How do you combine practising and teaching law?

Ten years ago I joined Freshfields in Düsseldorf as a lawyer. But I've always remained interested in the academic side of things and luckily I was able to be a fully tenured professor for two years, which I still do on a part-time basis.

Five years ago we left Freshfields and started our own firm specialising in IP. Personally I do trade marks, unfair competition and licensing. We have three partners, two of which do mostly patent

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The James Nurton Interview



litigation. In total we are eight lawyers, including one we have just hired.

Because we were a Freshfields spin-off, we still have rather large clients, about 80% of them international clients, with a strong focus on the US, UK and Japan. We do prosecution on a limited basis. Our bigger clients do that work in-house or use a specialist prosecution firm, but we are happy to do trade mark registration if the client asks for it. We also do a lot of strategic advice on multinational litigation, where there are cases going on in several countries and we are working with firms in other countries. For example I recently worked on the Sony v Singster case, which originated in Denmark. We have patent cases that are being litigated in four or more jurisdictions at the same time.

When I became a professor, my idea was to do it full-time but the demand from clients was such that I now spend less time teaching, though it varies during the year. I teach economists and try to focus on things that are relevant to them rather than hypothetical discussions. The aim is to give them the tools to use in their careers, whatever they may be.

What IP issues do you think are most relevant at the moment?

The essential challenge to safeguard the trade mark will always be the same, to make sure your mark

works as a source indicator and is not watered down, despite changes in the way products are being offered. Two changes in particular come to mind.

One challenge is technical: what about ISP liability?

That's still a big issue and has been for 10 years. It never dies, even though we thought it might, but it does evolve. I expect the next topic in this area will be an increased focus on search engines.

The other challenge is you have to come to terms with finding international answers to an ever more globalised problem. We see that in the recent Rolex v Blomquist decision. People produce things outside our borders so the normal rules do not apply. You can send warning letters to China but that may just be a waste of paper!

Another emerging issue that we have seen in the German courts was the alleged infringement of a word mark by a 3D mark. The case involved Lindt and Haribo: the latter had the Gold Bear word mark while the former had a gold bear 3D mark. The products are, when you take a first look, not alike, so it is a difficult issue to judge. Nobody years ago would have thought of that issue.

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Are the courts doing a good job of grappling with these sorts of issues?

I think it depends on the court. The national courts seem to be doing a good job from what I know. The usual complaint among the trade mark bar is that the CJEU tends to be arbitrary and that is valid to some extent. But it's worth pointing out that the CJEU is the only court that has an agenda as such, which is to construe the rules as EU-friendly as possible. Imagine if a national court had a rigid rule like that to construe the law broadly!

For example, in the DHL v Chronopost decision, the Court went very far in assessing remedies and whether they are alike or not and it's so not the issue the CJEU has to deal with. It's civil procedure and has to be ruled on by the member states.

Sometimes this approach can help trade mark owners; for example, you get a decision like L'Oreal. In a way, the CJEU is predictable as they try to be EU-friendly but on the other hand it's not predictable if you are interested in a particular area of law and want the law to make sense and evolve consistently in that area. The CJEU is often on a different page and that can be frustrating sometimes.

What do you think the answer is?

The various suggestions that have been made are good but are not realistic. Another tribunal in Luxembourg would be subject to the same rules.

We want the CJEU to be aware that they do not necessarily have to construe things in the broadest way possible but consistently – but that's me as an academic talking.

The only real answer is restraint. The CJEU should try to stick to issues that they absolutely have to rule on, and not tackle others.

To what extent does trade mark law really reflect consumers' experience of using marks?

A trade mark is an indicator of origin and if something cannot function as an indicator of origin it should not be a trade mark. But of course you can have non-traditional trade marks. In Germany we have a jingle for Deutsche Telekom, the telecommunication company, which everyone recognises. If something can function as an indicator of origin and can be depicted graphically, then it can be a trade mark.

There are some valid concerns that you shouldn't overdo it but those tend to overlook that the consumer can be educated and something can become a source indicator over a period of years. For example, if you see a McDonald's sign on a billboard it communicates many things, such as the menu, the cleanliness, the level of service – that's all from just one sign.

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The counter-argument goes: we protect too much so options are not available to other companies. It's a good argument in theory but I don't see it in practice. Many colours are protected but I don't see anyone who couldn't start a business because the colour he wanted wasn't available.

Does that mean consumer surveys should play a role in trade mark cases?

I think it makes sense to have some factual elements, particularly if you look at OHIM decisions. I had a case a few years ago where I had a trade mark for a US client that was registered in the US, UK and New Zealand and no one found it descriptive in the English language. At OHIM, a Spanish-speaking examiner said it was descriptive. We challenged this and got a response saying this is a question of law with no further explanation. I disagree with this approach: there is at least a factual element whether something is descriptive or not. So that is a case where conclusive survey evidence should be permitted to override the examiner. OHIM however would prefer to treat each case de novo.

I would say to OHIM: look at the TTAB in the US, which has a precedential system so you can point to earlier decisions and that increases predictability. This notion cannot simply be ruled out by hinting at the fact that we do not have a common law system at OHIM. Consistency is not for common law only. However, I wouldn't go as far as to say a survey

should replace a judge because we know you can manipulate surveys.

How do you think OHIM has done in general in developing the CTM system?

Overall it's certainly a success story. The numbers speak for themselves. We are a small continent – from Düsseldorf I can be in two or three other countries within a couple of hours' drive – and it's necessary to have an efficient approach. Nowadays you don't even have to provide translations; everything is online; tools like TMview are excellent. It is very well run but I would like to see more predictability. OHIM could use the databases they have and it would help them too because it would increase predictability and efficiency.

What's been your most interesting case?

Many years ago I worked on Rolex v eBay decision, one of the first decisions against eBay brought by a trade mark owner. That involved very complex legal issues at the time. It was one of a few Federal Supreme Court cases that addressed ISP liability.

Another interesting case on unfair competition went through seven courts including the Federal Supreme Court and concerned tobacco vending machines equipped with biometric recognition data. It raised issues about safeguarding the data and unfair competition.

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What do you think the future will hold?

I think we will always have the same issue: how to safeguard the source indicator function. But the world around changes and the usual protection mechanisms have to be modified. Keyword advertising, and before that meta-tags, are good examples. Next it will be some other technical gadget. It's always about how can I protect that function?

The other functions mentioned by the CJEU such as the advertising function and the investment function are auxiliary. The investment function is particularly important, especially in keyword cases, so it is good to see these are acknowledged by many courts, but the auxiliary functions will never be on the same level as the source-indicator function.

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The Third Board of Appeal recently issued two decisions ruling on the appeal against the suspension of invalidity proceedings. The appeals were filed in invalidity proceedings ICD 9 379 and ICD 9 380, concerning registered Community designs No 000607841-0002 and 000607841-0001, respectively, but as both decisions deal with the same issue and the outcome is the same, reference is made to both generally.

The RCDs, registered for cigarette papers in 2006 and published in 2007, enjoying US priorities, have been challenged in the said invalidity proceedings for non-compliance with the provisions of Article 25(1)(b) Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (CDR). In the course of the invalidity proceedings, the RCDs' holder requested the suspension of the proceedings because invalidity proceedings against the RCDs were pending before the court in Athens and, according to Article 91(2) CDR, the Office shall, unless there are special grounds for continuing the hearing, stay the proceedings where the validity of the registered Community design is already in issue on account of a counterclaim before a Community design Court.

The Office suspended the proceedings and informed the parties accordingly. The invalidity applicant filed a notice of appeal.

The invalidity applicant claimed that it had not been informed about the request to suspend the proceedings and that consequently it had not been able to file its arguments. Moreover, it claimed that the actions before the Court in Athens had not been filed in the form of valid counterclaims, pursuant to Article 91(2) CDR, but in the form of isolated invalidity actions, pursuant to Article 81(c) CDR. It claimed that the actions were inadmissible for procedural reasons and that there were therefore no parallel proceedings pending and that the invalidity proceedings before the Office should not be suspended.

The invalidity applicant also argued that the condition of special grounds for continuing the hearing is met where the registered Community design is obviously invalid and this was the case here. In the invalidity applications, it clearly showed that the RCDs were entirely dictated by their technical function and clearly lacked individual character compared with numerous prior designs.

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The Third Board of Appeal dismissed the appeals for the following reasons:

- Pursuant to Article 55(2) CDR, a decision which does not terminate proceedings as regards one of the parties can only be appealed together with the final decision, unless the decision allows separate appeal, which was not the case here. The Board of Appeal put aside the question of whether or not the notifications of suspension issued by the Office were decisions. In any case, allowing or rejecting a suspension of proceedings does not terminate these proceedings.
- The Board of Appeal supported its finding by quoting Community trade mark case-law stating that, as in opposition proceedings, the Office sets the framework for the proceedings, including fixing the deadlines for the parties, and suspending them or lifting the suspension, where appropriate (23/11/2006, R 1169/2006-4, 'MYTHBUSTERS/MYTHBUSTERS' paragraph 14).
- The Boards did not take any view on special conditions justifying continuation of a hearing where a counterclaim is pending before a national design Court.

The Board of Appeal remitted the case to the first instance for further prosecution. In the course of the appeal proceedings the invalidity applicant delivered the English translation of the decision of the Court in Athens. The Board of Appeal noted on this point that the suspension may be lifted as soon as the Office obtains the original decision.

To obtain the published decisions use the [eSearch Case Law](#) database.

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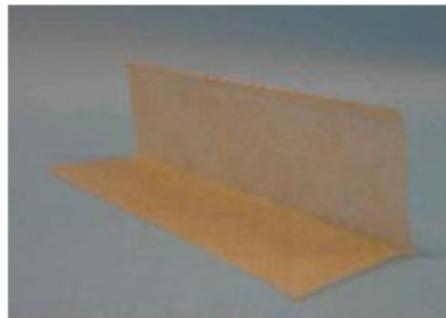
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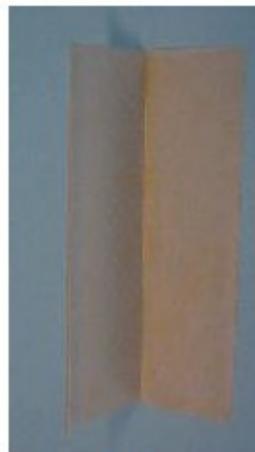


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Contested [RCD 000607841-0002](#)



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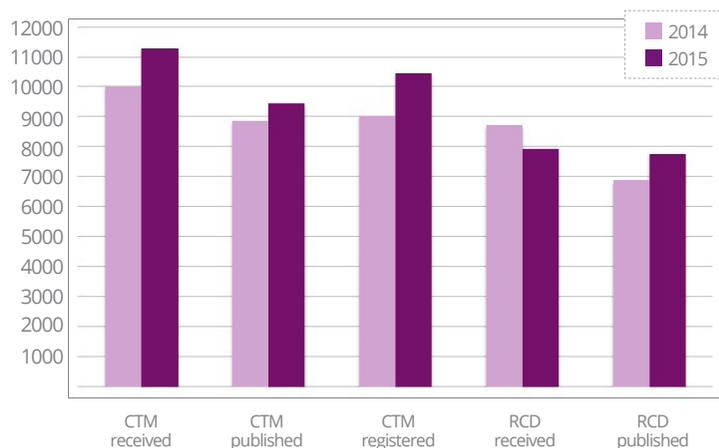


Statistical Highlights



| Monthly statistical highlights March* | 2015 | 2014 |
|--|--------|--------|
| Community Trade Mark applications received | 11 281 | 10 015 |
| Community Trade Mark applications published | 9 343 | 8 856 |
| Community Trade Marks registered (certificates issued) | 10 461 | 9 027 |
| Registered Community Designs received | 7 935 | 8 729 |
| Registered Community Designs published | 7 767 | 6 882 |

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



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New Designview members

As of 16 March 2015, the Turkish Patent Office (TPI) has made its design data available to the Designview search tool. And as of 20 April 2015, the Tunisian National Institute for Standardization and Industrial Property (INNORPI) joined. With INNORPI on-board, there are now 29 participating offices in Designview. With the addition of more than 12,000 designs from INNORPI, Designview now provides information and access to almost 4,2 million designs in total.

Since the introduction of Designview on 19 November 2012, the tool has served about 880,000 searches from 139 different countries, with users from Spain, Germany and the UK among the most frequent visitors

Philippines joins TMview

As of 23 March 2015, the Intellectual Property Office of the Philippines (IPOPIL) has made its trade mark data available to the TMview search tool.

IPOPIL first joined ASEAN TMview which was developed by the Intellectual Property Offices of the ASEAN Member States with the support of the EU-ASEAN Project on the Protection of Intellectual Property Rights (ECAP III Phase II) administered by OHIM.

This latest extension brings the total number of

offices participating in TMview to 38 and with the addition of about 325,000 trade marks from the Philippines TMview now provides information and access to almost 25.3 million trade marks in total.

Since the introduction of TMview on 13 April 2010, the tool has served more than 12,1 million searches from 151 different countries, with users from Spain, Germany and Italy among the most frequent visitors.

You can find out more at www.tmview.org

Three national IP Offices from the Balkan region join TMclass

As of 20 April 2015, the IP Offices of the Intellectual Property Office of the Republic of Serbia (IPORS), the Institute for Intellectual Property of Bosnia and Herzegovina (IIP BIH) and the State Office of Industrial Property (SOIP) of the Former Yugoslav Republic of Macedonia (FYROM), have joined TMclass.

These latest additions bring a total of 45 national and regional IP Offices, including OHIM, WIPO and OAPI, into the tool.

TMclass now offers users the opportunity to search and translate terms to and from any of the 34 available languages, including Serbian Cyrillic, Bosnian and Macedonian.

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Italy implements Similarity

The Italian IP Office, Ufficio Italiano Brevetti e Marchi (UIBM), implemented the Similarity project on April 21, 2015.

The implementation work began in the framework of a two day workshop that took place at the UIBM headquarters in Rome, at which OHIM and UIBM experts validated 6,800 pairs of goods and services. One week later, 11,000 terms were validated and as a consequence, the project is considered to be implemented.

The Similarity tool, developed by the Cooperation Fund, gathers and shows assessments from the participating IP offices on similarities between goods and services

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DON'T FORGET - OHIM will be exhibiting at INTA's annual meeting, San Diego, 2-6 May, 2015

This year at INTA, OHIM will be demonstrating its global trade mark and design tools and solutions, from its booth number 1528.

Throughout the week, our experts will be presenting free, online databases like TMview, with more than 25 million searchable trade marks from IP offices worldwide, TMclass, the global goods and services classification tool, and the Enforcement Database, which links rights holders and enforcement authorities across the EU, via a series of workshops in English and Spanish. Click [here](#) to see our timetable and everyone is cordially invited to join in as many workshops as they can manage during their busy stay in San Diego.

The **OHIM information meeting**, on **Sunday May 3, 13:30-15:30, Room 10, SDCC**, offers INTA delegates the chance to get an insight into how practices and working methods are converging across the EU, and to hear about the latest developments in the fight against IP infringements. You can see the agenda contents [here](#) and we would be delighted if you could join us.

OHIM's delegation looks forward to meeting up with as many INTA participants as possible during the 137th annual meeting.

New features in our inspection of files online form

OHIM's new online form went on line on April 22. It offers a more extensive range of documents that users can download free of charge. These include extracts and copies of CTM documents and extracts and applications of registered Community designs. The new form now includes the option to pay by credit card, and is structured in two sections:

- Download documents section: here users can download most documents related to a particular file free of charge. It is the first option on the online form.
- Request inspection of files: here users can request an inspection of file to be sent to them for a fee via eComm (in their User Area inbox) or by post. If eComm is selected, only one copy can be requested at a time.

Please note that only RCD application forms filed online after March 29, 2009, can be downloaded.

Like the trade mark online form, the new online inspection of files form features an automatic calculator so that users can see the total cost of their inspection requests at all times. The only amount not calculated automatically is that generated by the option of copies of documents. An OHIM examiner will confirm the total fee in writing.

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All certified copies now have identification codes so that users can view the original document in [OHIM's website](#). If an inspection of files request is made for different types of documents, the receipt will reflect each type with different identification codes. The total fee is the sum of all types of documents. For more information visit OHIM's [online Help Centre Inspection page](#).

Orphan Works Database - Meeting with the Competent National Authorities

On 14 April OHIM held a first meeting with the competent national authorities designated for the Orphan Works Database and for the Orphan Works Directive.

A competent national authority is an organisation designated in each EU Member State and EEA country which is responsible for forwarding information about orphan works to the Orphan Works Database. Different organisations have been designated as competent national authorities in EU Member States and EEA countries.

The main purpose of the meeting was to discuss and agree on the implementation of good practices for collaboration with the competent national authorities in promoting the Orphan Works Database at national level.

OHIM is responsible for the setting-up and management of the Orphan Works Database which provides a single harmonised point of access to information about orphan works in EU Member States and EEA countries. The database was launched on 27 October 2014 and is accessible on [OHIM's website](#)

New IP course for paralegals

OHIM hosted a course for paralegals from 27 to 29 April in Alicante. This two-and-a-half day training course covered topics ranging from an introduction to the Community trade mark system and the technicalities of online applications, to post-registration actions such as cancellations and appeals.

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

Case C-35/14 P; Enercon GmbH v. OHIM + Gamesa Eólica SL, Judgement of 12 February 2015, Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Admissibility, Entitlement to appeal, Colour mark

FACTS: The CTM applicant registered as a colour mark the sign indicated below for “Wind energy converters and their parts” in Class 7. An application for cancellation was filed. The Cancellation Division (CD) upheld the application on the grounds of Article 7 (1) (b) and Article 52 (1) (a) CTMR. The CTM applicant filed an appeal against the CD’s decision. The Board of Appeal (BoA) upheld the appeal considering that the contested mark was composed of a figurative sign consisting of a two-dimensional shape with colours and had a sufficient distinctive character. The Cancellation applicant filed an application for annulment before the General Court (GC) which upheld the first plea. According to the GC, the BoA’s assessment and decision were based on an erroneous understanding of the nature of

the mark: it is a colour mark, not a figurative one. Having found that error, the GC did not examine the distinctive character. The CTM proprietor lodged an appeal before the CJ. The grounds of appeal before the CJ were (i) the violation of the TM right due to the violation of a procedural rule and (ii) the violation of Article 7 (1) (b) CTMR.

CTM



SUBSTANCE: The European Court of Justice (CJ) dismissed the appeal as manifestly inadmissible pursuant to Article 181 of the Rules of Procedure of the CJ (RPCJ). The CJ held that the CTM proprietor did not acquire the status of “intervener” before the GC and, therefore, he was not entitled to bring an appeal against the GC’s decision before the CJ pursuant to Article 56 of the Statute of the CJ (Paras 24-25). The CJ stated that the CTM proprietor should have lodged a response to the application for annulment pursuant to Article 134 and Article 135 RPCJ (Paras. 22-23), in which case it would have acquired the status of an “intervener”. The fact that the CTM proprietor

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had sent the mandate given to his lawyer and the acceptance of the language of the proceeding to the GC is not relevant in order to acquire the status of “intervener” (Para. 24). The CTM proprietor had not participated in the proceeding before the GC, especially since it had neither submitted its own conclusions nor supported those of one of the parties (Para. 25).

Case C-182/14 P; MEGA Brands International v OHIM, Judgment of 19 March 2015, Language of the case: EN

RESULT: Actions partially upheld (Judgments in T-292/12 and T-604/11 sat aside and remitted to the General Court)

KEYWORDS: Relative grounds, Likelihood of confusion, Figurative element, Dominant element, Relevant language, Lack of reasoning

FACTS: The appellant sought to register the word mark MAGNEXT (Case T-292/12) and a figurative mark (Case T-604-11) represented below as CTM for Class 28 Toys and playthings, in particular multi-part construction toys, its parts, its accessories and its fittings. An opposition based on among others a Spanish earlier mark below, covering goods om Class 28, games, toys, gymnastic and sports articles not included in other classes; decorations for Christmas tree was filed on the grounds of Articles 8 (1) (b). The Opposition Division (OD) upheld the opposition on the basis of Article 8 (1) (b) CTMR in both cases, finding that there was a likelihood of

confusion between both the figurative mark and the wordmark. The Board of Appeal (BoA) confirmed the OD decisions. On appeal by the CTM applicant, the General Court (GC) joined the two cases to the effect as held in a judgment of 4 February 2014 (T-604/11) that the BoA had made an error of assessment by recognising a likelihood of confusion between the figurative mark applied for and the earlier mark and in case T-292/12 confirmed the BoA Decision. An appeal was filed by the CTM applicant specifically directed towards Case T-292/12 as regard the wordmark.

CTMAs

MAGNEXT

(Case T-292/12)



(Case T-604/11)

Earlier Marks

MAGNET 4

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SUBSTANCE: On the argument that the GC failed to take into account the element 4 of the earlier mark, the European Court of Justice (CJ) considered that the GC confined itself to establishing that the word mark in respect of which registration was sought, differs from the element 'magnet' in the earlier mark, MAGNET 4, only through the capital letter 'X' (Para. 36). The CJ explained that the failure to take account of the figure '4', present in the mark MAGNET 4, must be seen in the light of the categorisation, expressly made in paragraph 25 of the judgment under appeal, of the element 'magnet' as being the dominant element of that mark (Para. 37). The CJ reminded that in some circumstances, the assessment of the similarity may be made solely on the basis of the dominant element of a composite mark. However, that Case-Law concerns only exceptional situations (Order in Repsol v OHIM, C 466/13 P, EU:C:2014:2331, Para. 83), and it is only if all the other components of the mark are negligible in the overall impression conveyed by it that the assessment of the similarity can be carried out solely on the basis of the dominant element (see, inter alia, judgments in Aceites del Sur-Coosur v Koipe, C 498/07 P, EU:C:2009:503, Para. 62, and United States Polo Association v OHIM, EU:C:2012:550, Para. 57) (Para. 38). In paragraph 25 of the judgment under appeal, the GC merely confirms the dominant character of the element 'magnet' in the earlier mark, without providing any analysis whatsoever of the characteristics of the other element present in that mark, namely the figure '4'; consequently,

that latter element is negligible (Para. 39). Para. 22 of the judgment under appeal mentions only the finding, by the GC, of the fact that the figure '4' is not present in the figurative mark applied for and does not contain any assessment of the visual impression produced by that figure in the context of the earlier mark, from which it follows that that impression is negligible (Para. 40). In relation with the phonetic similarity of the figurative mark applied for and the earlier mark, also referred to in paragraph 25 of that judgment, it makes no mention of the presence of the figure '4' in the earlier mark. In particular, it does not contain any reference to the pronunciation of that figure in the form of 'cuatro', which is that of the Spanish language used by the public considered to be relevant for that mark, and also contains no assessment from which it follows that the phonetic impression produced by that sound is negligible (Para. 41). Accordingly, the CJ concludes that the GC erred in law in not carrying out the comparison of the marks at issue by considering each of them in its entirety (Para. 42). As to the failure to provide reasons in the judgment under appeal, the CJ takes note that Para. 35 of the judgment under appeal, in which the GC finds that there is a likelihood of confusion between the signs at issue, is a conclusive point which relies implicitly, but clearly, on the findings made in the previous paragraphs of that judgment, first, as to the visual, phonetic and conceptual similarity between the word mark applied for and the earlier mark and, second, as to the distinctive character of that earlier mark (Para.

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55). Moreover the CJ states that the GC has not provided any reasoning, not even implicitly, which makes it possible to understand why it categorised the element 'magnet' as dominant (Para. 57). And the GC has also failed to provide any reasoning, even if only implicit reasoning, for its decision not to include the figure '4' in its assessment of the similarity of the signs at issue (Para. 58). Therefore in so far as it is based on an assessment of the visual and phonetic similarity of the signs at issue which is marred by a lack of reasoning, the GC finding that there was a likelihood of confusion, in Para. 35 of the judgment under appeal, is itself insufficiently substantiated (Para. 59).

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

Case T-611/11; Spa Monopole, compagnie fermière de Spa SA/NV v. OHIM (Manea Spa / Spa), Judgement of 17 March 2015, Language of the case: FR

RESULT: Action upheld (BoA Decision is annulled)

KEYWORDS: Admissibility, Entitlement to appeal, First time on appeal, Relative grounds, Likelihood of confusion, Dominant element, Enhanced distinctiveness, Reputation, Identity/Similarity of the goods and services, Complementary goods and services, Similarity of signs, Substantiation of earlier rights, Evidence of use

FACTS: The CTMA MANEA SPA (word mark), in Classes 3, 24, 25, 43 and 44, was opposed on the basis of inter alia 2 earlier Benelux registrations of the word SPA in Classes 3 and 32. Enhanced distinctiveness and reputation were claimed in respect of mineral water. The grounds of the opposition were Article 8 (1) (b) and Article 8 (5) CTMR. The Opposition Division (OD) upheld the opposition in respect of G&S in Classes 3 and 44 (beauty and wellness services, hammam, spa services etc.) Both parties lodged an appeal. The BoA upheld the CTM applicant's appeal and dismissed the opposition both under Article 8 (1) (b) and Article 8 (5) CTMR. It found in substance that the signs were dissimilar given that the word "SPA" is descriptive of hydrotherapy services. The Board of Appeal (BoA) also dismissed the claim that the earlier word mark in Class 32 had acquired reputation given that the vast majority of the evidence related to a figurative mark which is the object of a separate registration and in which the logo of a clown was found to surpass in importance the word element. The BoA relied for that purpose on the guidance of the European Court of Justice in *Bainbridge* (C-234/06P, 13/09/07).

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CTMA

MANEA SPA

Earlier Marks

SPA

SUBSTANCE: As to the procedural issues, the GC holds that the intervener, which has the same rights as the main parties, can question the admissibility of the appeal before the GC even if the Office did not do so (Para. 22). The GC however confirms that the appeal was lodged on time (Para. 24). According to the Case-Law, the submission of national judgments for the first time before the GC is admissible, regardless of whether these documents were prior or later than the contested decision if they are merely submitted as illustrative Case-Law precedents (for instance, in the GC judgment of 1 February 2012, T-291/09, POLLO TROPICAL CHICKEN ON THE GRILL, (Paras. 34-35). However, if the national judgments are relied on as facts or evidence in support of a previously stated claim, they are inadmissible. In this case, two national judgments were submitted for the first time before the GC in support of the reputation claim, those judgments establishing this reputation in the Benelux countries. They are

therefore inadmissible (Para. 29). Even if the parties concentrated their submissions, before the BoA, on Article 8 (5) CTMR, the BoA was called to adjudicate on Article 8 (1) (b) CTMR because the appeals lodged by the parties concerned both grounds. It follows that the opponent is not altering the subject-matter of the dispute by contesting before the GC the way Article 8 (1) (b) CTMR was applied by the BoA (Paras. 31-35). Further to the substance of the case (Article 8 (1) (b) CTMR) the goods in Class 3 are identical and the services in Class 44 are similar to the Class 3 goods (Para. 49). The BoA did not make any express statement in respect of the services in Class 43 (Restaurant services (food); temporary accommodation; bars; hotel services; catering services; hotel room reservations) but it implicitly considered these services to be similar to the beverages in Class 32. The GC however confirms that the services in Class 43 are similar to the beverages in Class 32 in view of their complementarity (Para. 52). The signs are visually and aurally similar to a low degree (Paras. 61-62). Conceptually, the signs coincide in the reference to hydrotherapy centres (Para. 65). The overall similarity is not weak given that the earlier mark is fully reproduced in the CTMA the two components of which do not form a “unitary whole” (Para. 66). The word mark “SPA” is normally distinctive in respect of cosmetics in Class 3 (Para. 71). Moreover, the BoA erred in denying that the evidence could not serve to establish the reputation of the earlier word mark “SPA” in Class 32. Reputation can be acquired as part of another

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complex mark, notwithstanding the fact that the complex mark is also registered (CJ, 25 October 2012, Case C-553/11, Bernhard Rintisch / Klaus Eder, Para. 29-30). The Bainbridge judgment only applies to situations in which an earlier right holder relying on a family of trade marks is requested to demonstrate genuine use of one or of some of them, having in mind that use of a sufficient number of trade marks is a requirement for substantiating the existence of a series. This was not the case here (Paras. 77-79). The reputation of the word mark "SPA" can therefore be established on the basis of a complex figurative sign associating the word "SPA" with the device of a clown. This is so because the word element holds a predominant position in the complex sign (Para. 83). The statement of a director of the opponent, according to whom the clown is the "brand ambassador", does not contradict this finding (Para. 82). Use of the word "SPA" in the press also corroborates the finding that this word alone is reputed (Para. 84-85). As to the conclusion on likelihood of confusion (LOC), there was LOC in respect of the G&S in Classes 3 and 44 given the identity/similarity of the goods, the similarity of the signs and the average degree of distinctiveness of the earlier mark. There was LOC in Class 43 given the enhanced degree of distinctiveness of the earlier mark in Class 32 and the complementarity of the G&S. The CTMA is thus refused in respect of G&S in Classes 3, 43 and 44.

Case T-395/12; Fetim BV v OHIM, Judgment of 11 February 2015, Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Relative grounds, Likelihood of confusion, Visual similarity, Phonetic similarity, Conceptual similarity, Similarity of signs, Identity of good and services, Similarity of goods and services, Dominant element, Weak element, Beginning of mark

FACTS: The applicant sought to register the figurative mark "Solidfloor The professional's choice", shown above, as a CTM, for goods within Class 19 ("building materials, not of metal, parquet flooring of plastic and wood, flooring of wood, cork and laminate, subfloors, transportable floors, not of metal"). The opponent based an opposition on Article 8 (1) (b) CTMR using the earlier figurative trade mark "SOLID floor", represented above, registered in the United Kingdom for goods and services in Class 19 ("solid wood flooring, wooden parquet flooring") and in Class 37 ("installation of wood flooring"). The Opposition Division (OD) rejected the opposition and the applicant filed an appeal. The Board of Appeal (BoA) upheld the appeal, annulled the OD decision and rejected the CTM application in its entirety, because it found that the trade mark applied for and the earlier trade mark were highly similar overall and the goods and

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services in question were partially identical and partially similar. The applicant filed an action before the General Court (GC).

CTMA



Earlier Marks



SUBSTANCE: Concerning the Article 8 (1) (b) CTMR the GC further stated that the attentiveness of relevant public was average and confirmed the BoA finding of partial identity and partial similarity of the goods and services at issue (Paras. 22-23). Contrary to the applicant's conclusion, GC found that word element "solid floor" constitutes the dominant element of both the mark applied for and of the earlier mark. In accordance with the GC's ruling in Case T-134/06 (PAGESJAUNES.COM) it was pointed out that the weak distinctive character of the word element "solid floor" can't automatically prevent

the perception of this element as a dominant one. Consequently, it was necessary to take into account the mentioned word element when the trade marks at issue were compared (Paras. 29, 32-33). The GC also confirmed the conclusions of the BoA regarding the word element "The professional's choice", which is not particularly striking and would not be perceived as a badge of origin (Para. 34). On the basis of that the GC considered that the trade marks at issue are visually similar (Paras. 35-36). These marks are also highly similar from the phonetic point of view because consumers pay greater attention to the beginning of the marks - in this case dominant word element "solid floor", which contain both of them (Paras. 37-38). Conceptually, it is clear that a high level of similarity exists there too, because consumers would perceive the terms "solid" and "floor" in the trade marks at issue identically (Paras. 39-40). In light of those facts, the GC upheld the BoA finding that there was a likelihood of confusion and also, the fact that the earlier mark has a weak distinctive character does not preclude a finding of likelihood of confusion (Paras. 45 and 46). There is no infringement of Article 8 (1) (b) CTMR.

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Case T-287/13; Husky CZ s.r.o. v OHIM, Judgment of 13 February 2015, Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Extension of the time limit, Catalogue, Distinctive element, Invoice, License agreement, Promotional material, Proof of use, Time limit, Translation, Use by another undertaking, Use not as registered, Sales figures, Revocation grounds

FACTS: The CTM proprietor registered the word mark HUSKY as a CTM for goods within Classes 3, 9, 14, 16, 18 and 25. An application for revocation was filed based on the ground that the mark at issue had not been put in genuine use in connection with the goods in respect of which it had been registered. The Cancellation Division (CD) has extended, on the request of the CTM proprietor, several times the time-limit for the submission of the evidence proving genuine use. The CD granted in part the application for revocation. It decided that the mark could remain registered for “bags” in Class 18 and “shirts, trousers, jackets, coats, waistcoats, jumpers, pullovers, sweaters, boots, shoes, tops, jeans, belts and footwear” in Class 25. The Board of Appeal (BoA) dismissed applicant’s appeal. The revocation applicant filed an action before the General Court (GC).

CTM

HUSKY

SUBSTANCE: As to the first plea in law (interpretation of Rule 71(2) CTMIR), the GC has clarified the existing ambiguity as regards the divergent wording of this Rule in the different EU languages. The English version (and certain other languages versions) states that in inter-partes proceedings the Office may extend a time-limit subject to the agreement of the other parties. The German, Spanish, French and Italian versions state that in inter-partes proceedings the Office may subject the extension to the agreement of the other parties. The BoA has interpreted this provision according to the wording of the German, Spanish, French and Italian versions. The GC, making a teleological interpretation, has given reason to BoA’s interpretation (Paras. 37-45). It concluded in Para. 46 that Rule 71 (2) is to be interpreted as meaning that when a party in inter-partes proceedings requests an extension of time “OHIM may, but it is not required, to seek the consent of the other party and that this provision has to be read in conjunction with Rule 71(1), from which it follows that the Office, in particular when it decides not to seek the other party’s consent, must take account of the circumstances surrounding the request for an extension of time”. In regards to

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the second plea in law (untranslated documents), according to the GC, Rule 22(6) CTMIR supplements and further elaborates on the provisions of Rule 22(2) to (4) CTMIR (Para. 55). Under Rule 22(6) CTMIR, the Office is able to request of the party submitting documents that they be translated where the documents submitted are not in the language of the proceedings (Para. 56). In this case, the Office did not err in not requesting an English translation of documents provided in Italian. First, the revocation applicant did not itself request, during the revocation proceedings, that the CTM proprietor provide a translation of those documents. Second, the revocation applicant's arguments focus on extracts from online dictionaries, which show translations of words from English into Italian or from Italian into English, which renders any request for translation nugatory (Para. 57). As to the third plea in law (undated documents), Rule 22 CTMIR (applicable to revocation proceedings in accordance with Rule 40(5) CTMIR) refers to indications concerning the place, time, extent and nature of use, and gives examples of acceptable evidence; that rule does not state that each item of evidence must necessarily give information about all four elements to which proof of genuine use must relate (Para. 65). An accumulation of items of evidence may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (Para. 66). The fact that invoices do not specify whether they relate to goods covered by the

mark does not mean that they relate ipso facto to other trademarks. At the very most, in analysing the accumulated evidence, the probative value of those invoices may be qualified, but not dismissed (Para. 69). In order to establish use, the proprietor of a mark may legitimately rely on the fact that it is used in a form which differs from the form in which it was registered, without the differences between the two forms altering the distinctive character of that trade mark, and even though that different form may itself be registered as a trade mark (Para. 72).

Case T-499/13; nMetric LLC v OHIM, Judgment of 5 February 2015, Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Absolute grounds, Slogan mark, Distinctive element, International registration, Laudatory mark, Minimum degree of distinctiveness, Principle of legality, Relevant language, Specialised public

FACTS: The applicant was granted an international registration with the designation of European Community for the word mark SMARTER SCHEDULING for goods within Class 9. The examiner refused to register the word mark as a CTM on the ground that the trade mark was devoid of distinctive character. The Board of Appeal (BoA) dismissed applicant's appeal. The applicant filed an action before the General Court (GC).

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CTMA

SMARTER SCHEDULING

SUBSTANCE: The GC recalls that there is a measure of overlap between the scope of Article 7 (1) (b) CTMR and the scope of Article 7 (1) (c) CTMR, Article 7 (1) (b) nevertheless being distinguished from Article 7 (1) (c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings (Para. 23). The BoA was correct in its finding that the trade mark applied for simply informed the relevant public that the software covered by that mark assisted with scheduling, in which planning, coordination, and execution may be considered essential steps, in a more intelligent manner than other systems (Para. 33). Moreover, the applicant's website clearly indicates — through the use of expressions such as 'schedule more effectively and more realistically' or 'schedule faster and more easily', which give direct information on the nature of the goods concerned — that one of the main characteristics of the software covered by the trade mark applied for is to make the job of scheduling easier (Para. 34). The fact that the term 'smarter scheduling' may possibly be associated with other goods or services of other brands is ineffective (Paras. 35-36). In the case of a trade mark composed of a number of word elements, distinctiveness may,

in part, be examined in relation to each of those terms or elements, considered separately, but must in any event depend on an appraisal of the whole which those terms or elements go to make up (Para. 40). A word mark consisting of an advertising slogan cannot be required to display 'imaginativeness' or even 'conceptual tension which would create surprise and so make a striking impression' in order to have the minimal level of distinctiveness required under Article 7 (1) (b) CTMR. However, although the existence of such characteristics is not a necessary condition for establishing that an advertising slogan is distinctive the fact remains that, as a rule, the presence of those characteristics is likely to endow that mark with distinctive character. The GC thus confirms the BoA's finding that the term 'smarter scheduling' contains no fanciful element which, beyond its obvious promotional meaning, could enable the relevant public to memorise it easily and instantly as a distinctive mark for the goods concerned (Paras. 43-45).

Case T-558/13; FSA Srl v OHIM; Judgment of 4 March 2015, Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Common element, Conceptual similarity, Distinctive element, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Reputation, Similarity of the signs, Visual dissimilarity, Relative grounds, Weak element

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FACTS: The applicant registered the word mark FSA K-FORCE as a CTM for goods within Classes 9 and 12. An application for a declaration of invalidity based on the earlier word mark FORCE-X, registered for goods in Classes 9 and 12, was filed on the grounds of Article 8 (1) (b) CTMR. The Cancellation Division declared the registration of the CTM invalid. The Board of Appeal dismissed the CTM proprietor's appeal finding that there exists a likelihood of confusion between the two marks, since the goods covered by them were identical and the signs were similar to a low degree visually, and to a certain degree phonetically as well as, for the part of the public understanding the meaning of the word 'force', conceptually. The CTM proprietor filed an action before the General Court (GC).

| |
|----------------------|
| CTM |
| FSA K-FORCE |
| Earlier Marks |
| FORCE-X |

SUBSTANCE: Firstly, the GC stated that the attention of the relevant public in respect of bicycle helmets must be classified as higher than average, since the product at issue concerns consumer safety (Para. 26). As regards the goods in Class 12,

the relevant public, whether professional or the final consumer will pay particular interest to the choice of a bicycle or its spare parts and accessories used in its assembly, owing to the technical and aesthetic characteristics of those goods, therefore the level of attention must be also considered to be higher (Para. 27). In regards of the similarity of the signs, the GC pointed out that the word 'force' can describe one of the characteristics of the goods concerned and for some of the goods in Class 12 it may also designate one of their purposes (Para. 38). Even though the word 'force' has a weak distinctive character, it cannot be disregarded completely for the purposes of the comparison of the signs at issue (Para. 42). Visually, the marks at issue have the element 'force' in common. The other elements, namely 'fsa-k' for the contested mark and 'x' for the earlier mark, are different. The element 'force', however, has a weak distinctive character in respect of the goods concerned. Consequently, it must be held that the marks at issue give a different overall impression (Para. 46). Phonetically, the pronunciation of the marks differs in length and the word 'force' has a weak distinctive character for the goods concerned, therefore the marks at issue must be held to be phonetically similar to a low degree (Para. 49). The conceptual similarity of the marks for a not inconsiderable part of the relevant public, resides in the element with a weak distinctive character. Consequently, the conceptual similarity of the marks at issue must be characterised as low (Para. 52). Since (i) the relevant public's level of

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attention in the present case is higher than average, and (ii) the word 'force', due to its descriptive character and its banality inter alia on the European market, has a weak distinctive character in respect of the goods concerned, the marks at issue, taken as a whole, have only a low degree of similarity (Para. 55). Consequently, despite the identity of the goods covered by the marks at issue, there is no likelihood of confusion between those marks (Para. 56).

Case T-379/13; Innovation First, Inc. v OHIM; Judgment of 10 February 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Absolute ground, Characteristic of goods and services, Descriptive element, Right to be heard, Lack of reasoning

FACTS: The applicant sought to register the word mark NANO as a CTM, for goods and services in Classes 9, 28 and 41. The examiner rejected the CTM application for goods in Classes 9 and 28 on the ground of Article 7 (1) (b) and 7 (1) (c) CTMR and the applicant filed an appeal. The Board of Appeals (BoA) dismissed the appeal and upheld the contested decision. The BoA stated that consumers would perceive the word "NANO" as "extremely small", "involving the use of nanotechnology" or as a mathematical prefix. It is not unusual that the consumers associate this term with the extremely small size of the goods in question and, consequently,

the mentioned term becomes a direct reference to that characteristic. Therefore, the term "NANO" has a descriptive character within the meaning of Article 7 (1) (c) CTMR. Concurrently, there is nothing vague or unusual about the word "NANO" in relation to the goods for which registration is sought. This term is devoid of any distinctive character within the meaning of Article 7 (1) (b) CTMR. The applicant filed an action before the General Court (GC).

CTMA

NANO

SUBSTANCE: Contrary to the applicant's claim, the GC found that there was not an infringement of the right to be heard (the first plea). The Office did set out, from the stage of the proceedings before the examiner, its position which was understood by the applicant, who responded to it in its statement setting out the grounds of its appeal against the examiner's decision. The Board of Appeal (BoA) responded to the applicant's comments in the contested decision (Paras. 21). Further, the GC also disagreed with the applicant's claim that the BoA infringed the obligation to state reason (the second plea). The finding that the trade mark applied for will be perceived by the relevant public, in relation to the goods at issue, as referring to their small size, are not contradictory (Paras. 24-28). As well, the applicant argued that the BoA did not refer to the word "NANO" as such, but to the prefix "NANO-", used in compound words only, and that there is no

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evidence showing that the meaning of this prefix, as a reference to the extremely small size of the goods or to the use of nanotechnology, may be applied to the term “NANO” when used alone (the third plea). In accordance with the BoA’s findings, the GC remarked that the applicant has not adduced any evidence to show that the relevant public would not understand the word “NANO”, when used alone, as having the same meaning as the prefix “NANO-”, and, accordingly, as referring either to the size of the goods or to the use of nanotechnology. Therefore, the infringement of Article 76 CTMR was not found (Paras. 46-54). As the BoA correctly found, the trade mark applied for refers to the “extremely small size” of the goods at issue, but the applicant did not agree that this fact constitutes a descriptive indication within the meaning of Article 7 (1) (c) CTMR (the fourth plea). However, it is clear that the term “NANO” is understood by the relevant public as referring to the size of the goods. It has acquired a meaning which diverges from its mathematically exact definition and, accordingly, from the reference to an “extremely small size” and denotes, more generally, a “small” size (Para. 56). According to the GC, the BoA was entitled to base its findings on facts arising from practical experience generally acquired from the marketing of goods. The trade mark applied for may designate a characteristic of the goods at issue, which entails that it is descriptive of those goods, within the meaning of Article 7 (1) (c) CTMR (Paras. 57-59). In those circumstances, there was not a need to assess the infringement of Article 7 (1) (b) CTMR (the fifth plea) (Para. 65). In the light of those facts, the GC upheld the contested decision.

Case T-378/13 Apple and Pear Australia, Star Fruits Diffusion v. OHIM, Judgment of 25 March 2015, Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Relative grounds, Lack of reasoning, Res judicata, Reputation, Likelihood of confusion, Enhanced distinctiveness, Principle of legal certainty, Principle of legitimate expectations, New evidence

FACTS: The other party sought to register the word mark ENGLISH PINK for goods in Class 31. Opposition pursuant to Article 8 (1) (b) and Article 8 (5) CTMR, based on the word CTM PINK LADY as well as on the following figurative CTMs, all covering goods in Class 31. The Opposition Division (OD) dismissed the opposition. One year before adopting the contested decision, the Board of Appeal (BoA) was notified a final judgment of the Belgian CTM Court –Tribunal de Commerce de Bruxelles (TCB) –cancelling the Benelux mark ENGLISH PINK (which had been applied for at the same time as the identical ENGLISH PINK CTM) because of likelihood of confusion (LOC) with the earlier PINK LADY CTM and Benelux trademarks. The TCB found that the Benelux mark ENGLISH PINK infringes the PINK LADY marks (both CTMs and Benelux) and prohibited the other party from using the sign PINK LADY within the EU. The TCB ruled that the PINK LADY CTMs enjoy a high degree of protection and that there is a significant LOC between PINK LADY and ENGLISH PINK. The BoA transmitted the judgment and its translation to the other party, but the contested decision did not even mention it in the summary of

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the facts. The BoA rejected the opposition, thereby taking the opposite view to the TCB: no enhanced distinctiveness, no Article 8 (5), no LOC. Before the General Court (GC), the applicant alleges seven pleas, the ones examined by the GC being: 1) Breach of the duty to state reasons regarding the inferences to be drawn from the judgment of the Belgian CTM Court. 2) Breach of *res judicata*. 3) Breach of the general principles of legal certainty, sound administration and protection of legitimate expectations.

CTMA

ENGLISH PINK

Earlier marks



SUBSTANCE: The GC stated the BoA had been duly notified on several occasions of a new fact (the judgment of the TCB) several months before the adoption of the contested decision. But nowhere does the BoA refer to its existence or explain why it does not take the new fact into consideration (Para. 32), although it was required to state reasons. The BoA infringed Article 75 CTMR (Para. 36). The GC stated that the judgment of the TCB is, *prima facie*, a relevant factual element for resolving the

case at hand. There are essential common points between the factual aspects at issue (Para. 47). That judgment was delivered by a CTM court, which is part of the autonomous EU trade mark regime (Para. 48). In failing to assess the potential impact of this judgment for the outcome of the dispute before it, the BoA failed to assess all the relevant factual aspects of the case with the required diligence and infringed the principle of sound administration. This lack of diligence leads to the annulment of the contested decision (Paras. 50-52). The GC stated further the judgment of the TCB is not in itself sufficient to enable the GC to alter the contested decision and to ascertain which decision the BoA was required to take (Para. 57). When exercising its exclusive jurisdiction over registration of CTMs and when examining oppositions lodged against CTM applications, the Office is not bound by a decision of a CTM court delivered in an action for infringement (Para. 60). The unitary character of the CTM does not mean that the principle of *res judicata* precludes the Office and, consequently, the European courts, from examining the possible existence of a LOC in the context of the opposition proceedings concerning the registration of a new CTM, even though it is identical to a national mark which has been held by a CTM court to undermine the earlier CTM (Paras. 62-64).

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Case T-665/13 Zitro IP Sàrl v. OHIM; Judgment of 25 January 2015; language of the case: EN

KEYWORDS: Relative grounds, Common element, Complex mark, Dissimilarity of the signs, Identity of the goods and services, Similarity of the goods and services, Characteristics of the goods and services, Descriptive element

RESULT: Action dismissed

CTMA



Earlier word marks

ZITRO SPIN BINGO

FACTS: An application for a figurative mark in Classes 9, 41 and 42 was filed. An opposition pursuant to Article 8 (1) (b) was filed based on an earlier word mark for goods and in Classes 9, 28 and 41. The Opposition Division partially upheld the opposition for all the goods identical or similar. The Board of Appeal annulled that decision and rejected



the opposition in its entirety. It found a low degree of visual, aural and conceptual similarity between the signs, despite the fact that they contain the expression 'spin bingo', descriptive of an essential characteristic of the goods and services.

SUBSTANCE: The General Court confirms the descriptive character of the expression SPIN BINGO (Paras. 31-33). The public is often confronted with terms, expressions or acronyms regarded as descriptive even if their exact meaning is not grasped (HTML, Wi-Fi, ISDN... and also SPIN). They will not be perceived as an indication of commercial origin of the goods and services (Para. 38). The action is dismissed.

Case T-596/13; Emsibeth SpA v OHIM, Judgment of 26 March 2015, Language of the case: IT **RESULT:** Action dismissed

KEYWORDS: Relative grounds, Likelihood of confusion, Dominant element, Distinctive element, Figurative element, Visual similarity, Beginning of mark, Relevant language, Similarity of the signs, Identity of the goods and services

FACTS: The applicant sought to register the figurative mark as a CTM for a range of goods in Class 3 namely: soaps, perfumery, essential oils, cosmetics, hair lotions, preparations for colouring and de-colouring hair; shampoos. An opposition was based on the earlier word mark Mc Neal, registered for soaps, perfumery, essential oils, cosmetics, hair

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lotions, dentifrices in Class 3. The opposition was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division (OD) dismissed the opposition on its entirety. The Board of Appeal (BoA) upheld the appeal and annulled the OD decision. The applicant filed an action before the General Court (GC) arguing an infringement of Article 8 (1) (b) CTMR.



SUBSTANCE: The GC firstly held that, notwithstanding the applicant had not disputed the identity of part of the goods at issue before both the OD and the BoA, its arguments against the finding of identity of part of the contested goods are admissible before the GC (Paras. 32-36). As far as the relevant public is concerned, the BoA was right in finding that it is the general public. Firstly, when the contested goods and services are destined to public as a whole, the relevant public is composed of the average consumer. Secondly, even though cosmetics, perfumes and goods for hair care in Class 3 can be purchased also by professionals, they are goods targeted to the public as a whole.

Therefore, the level of attention of the consumers is average (Paras. 25-28). As regards the similarity of signs, the GC held that, visually, the element “Neal” will have a greater impact on the public attention because of its length. On the contrary, the element “mc” will be perceived, by the part of the consumers ignoring English language, just as the combination of two letters devoid of any meaning. Therefore, the element “Neal” has a distinctive and dominant position in the earlier mark. The figurative elements of the contested mark, although being minimal, are not negligible. Therefore, the BoA erred in finding that the marks are visually highly similar. On the contrary, they are visually similar to an average degree (Paras 46-47). Phonetically, the GC confirmed the BoA’s finding that, in reason of the similarity of the letters “ea” and “ae”, there is a low degree of phonetic similarity between the marks at issue in German, Spanish and French (Para 49). On the conceptual similarity, the GC found that the English speaking part of the public will identify “Mc Neal” as a Scottish surname. “Nael” is a personal name very rare in France and it means “nail” in Estonian. It follows that only the persons that know both Estonian and English or English and French may compare the marks conceptually. Since those consumers do not represent a significant part of the relevant public, and for the vast majority of the public the signs are devoid of any concept, a conceptual comparison is not possible (Para. 50). On the overall assessment, the GC referred to the Case-Law according to which the visual similarity is more important for goods, such as the ones at issue, that are purchased directly by the consumer to the extent that the image of the mark as affixed

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on the product is the most important factor in the consumer's choice (Paras. 52-53). In light of the above, and according to the interdependence principle between the degree of similarity of the goods and services and that of the signs, there is a likelihood of confusion between the marks at issue. Therefore, the only claim of the applicant has to be dismissed.

Case T-257/14; Novomatic AG v OHIM, Judgment of 6 March 2015, Language of the case: DE

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Beginning of mark, Common element, Conceptual dissimilarity, Figurative trade mark, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Relative grounds, Relevant territory, Specialised public, Visual similarity

FACTS: The applicant sought to register the figurative mark represented below as a CTM for goods within Class 28. An opposition based on the earlier word mark BLACK TRACK and on the earlier figurative represented below, registered for goods in Classes 18, 25 and 28, was filed on the grounds of Article 8(1)(b) CTMR. The Opposition Division dismissed the opposition. The Board of Appeal (BoA), taking into account the earlier word mark, upheld the opponent's appeal finding that there exists a likelihood of confusion between the two marks, since the goods covered by them were identical or highly similar and the signs at issue had

a high degree of visual and phonetic similarity and an average degree of conceptual similarity for the English speaking public. The applicant filed an action before the General Court (GC).

CTMA



Earlier mark



SUBSTANCE: With regards to the examination of the similarity of the goods, the GC confirms that the goods covered by the mark applied for in Class 28, being hazard games or gaming apparatus, must be considered as included in the broader category of "games" (Para. 21) and therefore the goods covered by the marks at issue are identical (Para. 22). The BoA was not obliged to take into account the market reality, since the assessment of the likelihood of confusion must be based on taking into account the goods and services applied for in the CTMA and the goods and services registered under the earlier mark (Para. 25). As regards the similarity of signs, for the relevant public the mark applied for "BLACK JACK TM" has a clear meaning of cards game and this meaning is even strengthened by the image of two cards (Para. 38). The relevant public will not

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divide this mark into its individual elements and also, the relevant public, or its English speaking part, will not perceive the word “black” as independent from the expression “black jack” (Paras. 39). The mark “BLACK TRACK” has also a clear meaning for the English speaking consumer and will be perceived as a dark path (Para. 40). Since each of the marks in conflict form for an English speaking consumer an expression with a clear and distinct meaning, the BoA made an error when finding a conceptual similarity in the present case (Para. 41-43). Such an error is capable of being decisive for the validity of the assessment of likelihood of confusion, since the conceptual differences between two signs may neutralise the visual and phonetic similarity between them (Para. 44). The GC returned the case back to the BoA for further examination on this point (Para. 45).

Case T-505/14 Seven For All Mankind LLC v. OHIM, Order of 23 February 2015; language of the case: EN

KEYWORDS: Relative grounds, Likelihood of confusion, Enhanced distinctiveness, Common element, Complex mark, Descriptive element, International registration, Similarity of signs, Res judicata

RESULT: Action dismissed

FACTS: An application for a mark for goods in Classes 14 and 18 was filed. An opposition pursuant to Article 8 (1) (b) was filed for a figurative mark for

goods also in Classes 14 and 18. After judgments of the General Court and the European Court of Justice (CJ), the case went back to the Board of Appeal, which found likelihood of confusion between the signs. The applicant challenges the findings that are now res judicata (Para. 27), or which are irrelevant.

CTMA

SEVEN FOR ALL MANKIND

Earlier marks (CTM & IR)

**Seven
Seven**

SUBSTANCE: The single plea in law is rejected as manifestly unfounded. The action is dismissed in its entirety as manifestly lacking any foundation in law.

Case T-233/14; Intesa Sanpaolo SpA v OHIM, Order of 5 March 2015; Language of the case: IT
RESULT: Action dismissed

KEYWORDS: Absolute grounds, Distinctive element, Lack of reasoning, Adversely affected, Entitlement to appeal

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FACTS: The applicant sought to register the word mark NEXTCARD as a CTM for a range of goods and services in Classes 9 and 36, including magnetic data carriers in Class 9 and financial and monetary services in Class 36. The examiner refused to register the sign as a CTM on the ground that it was descriptive and devoid of distinctive character in relation to the above mentioned goods and services. The Board of Appeal (BoA) dismissed the applicant's appeal. The BoA found that the word "NEXTCARD" would be perceived by the relevant public with the meaning of "the most advanced card on the market" in relation to magnetic bank cards (included in the category of magnetic data carriers). As far as the services in Class 36 are concerned, the consumers will perceive that they are related to or offered together with those cards. Therefore, the sign was found to be devoid of distinctive character under Article 7 (1) (b) CTMR. The applicant filed an action before the General Court (GC) arguing, an infringement of Article 75 CTMR. In particular, the applicant first claimed that the BoA did not motivate why it refused the mark applied for in relation to magnetic data carriers, which are different to bank cards. And, secondly, that the BoA did not motivate why it refused the sign for financial and monetary services, among which there are also services not related to bank cards.

CTMA

NEXTCARD

SUBSTANCE: The GC dismissed the appeal. The decision was well reasoned. The GC recalled the Case-Law according to which the Office has in principle to motivate the refusal in relation to each of the relevant goods and services. However, a global reasoning is admitted when it refers to goods and services which show a sufficiently direct and objective link to the extent that they form a homogeneous category or group. Furthermore, when some goods and services belong to a specific category listed in the mark applied for, the Office may focus on the category as a whole and does not need to analyse any single good or service covered by the category (Paras. 16-18). Therefore, since bank cards in Class 9 and financial and monetary services (related to bank cards) in Class 36 are included in the wider categories of the mark applied for and the applicant did not limit the list of goods and services, it is not up to the Office to focus specifically on those more restricted categories of goods and services (Paras. 20-21). In relation to some goods in Class 9 (CD disks, DVD and other digital recording media), the applicant's claim is unfounded because those goods had been accepted for registration. Therefore, the contested decision cannot be appealed with reference to those goods, under Article 65 CTMR, since the applicant was not adversely affected by the decision (Paras. 19-20). In the light of above, the claim of applicant is manifestly unfounded.

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Decision of the Second Board of Appeal of 27 February 2015 in case R1948/2014-2 (FI)

Procedural issues – Rule 96(1) CTMIR, Admissibility, language of proceeding

The applicant sought to register the word mark 'COOKIE' for goods in Class 31.

The examiner refused the application under Article 7(1)(b), (c) and (2) CTMR.

The applicant appealed the examiner's decision.

The Board found that the appeal was formally admissible despite the fact that the notice of appeal was submitted in English. However, Finnish remained the language of proceedings. Nevertheless, the notice of appeal submitted in English fulfilled the

formal requirements for an appeal to be admissible. Under the third sentence of Rule 96(1) CTMIR, where it is stated that where the applicant for a Community trade mark is the sole party to proceedings before the Office and the language used for the filing of the application for the Community trade mark is not one of the languages of the Office, the translation may also be filed in the second language indicated by the applicant in its application. In the present case, the second language of proceedings was English and the appellant submitted its notice of appeal in that language. The appeal was also well founded. There was no sufficiently direct and specific relationship between the word sign COOKIE and the goods 'malts'.

The Board upheld the appeal.

[Link to eSearch Case Law](#)

Decision of the Fourth Board of Appeal of 16 March 2015 in case R2893/2014-4 (DE)

Procedural issues – language of proceeding

The applicant sought to register the word mark 'Straight Line' for goods in Classes 6 and 19.

The examiner refused the application under Article 7(1)(b) and (c) CTMR.

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The applicant appealed the examiner's decision.

The Board noted that the application was filed in English. The first language of the proceedings was English and the second German. The examiner's decision incorrectly used German, the second language of the proceedings. The applicant was allowed to file the appeal in German as the language in which the contested decision was taken. The Board found the appeal to be admissible and also well founded. The examiner incorrectly used German against Article 119(4) CTMR, which requests that the language of ex-parte proceedings be the language used for filing the application for a CTM (as long as the first language is a language of the Office).

The Board upheld the appeal and remitted the case back to the examiner.

[Link to eSearch Case Law](#)

Decision of the Second Board of Appeal of 10 February 2015 in case R1053/2014-2 (EN)

Absolute grounds for refusal – Article 7(1)(b) and 7(2) CTMR – figurative mark, distinctiveness

The applicant sought to register the figurative mark



for goods and services in Classes 9 and 42.

By a decision the examiner partly rejected the application for some of the goods in Class 9 as being ineligible for registration under Article 7(1)(b) and 7(2) CTMR.

The applicant filed an appeal against the examiner's rejection.

The Board confirmed the examiner's finding that a representation of a magnifying glass had become the standard icon for a 'search' or 'zoom' function found on countless computer- or web-based applications. The vast majority of people who have used computer applications, or have accessed the Internet, would be well accustomed to the magnifying-glass icon and its dual function either as a 'zoom' or 'search' tool. The applicant's device hardly differed from the typical search-tool icon. The Board recalled that if a mark does not depart significantly from the norm or customs of the sector it cannot fulfil its essential function of indicating origin and is hence devoid of any distinctive character within the meaning of Article 7(1)(b) CTMR. It became clear that the applicant's magnifying glass, being little different from the 'search' or 'zoom' icon used on countless applications, could not serve as a badge of trade origin for software goods, since consumers would not, on the basis of this mark alone, be able to distinguish the applicant's goods from those of competitors whose goods also featured the same or a similar icon. In other words, the mark could not function as a badge of origin and be called to

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mind by the consumer on a subsequent occasion when desiring to repeat—or avoid—the experience of a previous purchase. Indeed, the relevant public, being accustomed to seeing this icon on software goods, and having been educated into recognising it as denoting a search or zoom tool, would fail to perceive it as designating trade origin. For these reasons, the mark applied for was rejected for all the software goods covered in Class 9 of the CTM application. However, the mark was allowed to proceed for the remaining goods, which did not consist of, or include, software.

The Board partly upheld the appeal.

[Link to eSearch Case Law](#)

Decision of the Second Board of Appeal of 18 February 2015 in case R1078/2014-2 (SV)

Absolute grounds for refusal – Article 7(1)(b) and (c) and 7(2) CTMR – figurative mark, disclaimer

The applicant sought to register the figurative mark



for goods and services in Classes 16, 35, 36, 41 and 45.

The application was partially refused for goods and

services in Classes 16, 35 and 41 pursuant to Article 7(1)(b) and (c) and 7(2) CTMR.

The applicant appealed the decision and specified the scope of protection through a disclaimer for the words in the mark.

Following this restriction, the Board found that the trade mark could be registered, as it was now clearly defined that the area of protection did not cover the words GLOBAL CHILD FORUM but only the figurative mark applied for as an entity. The Board referred to the fact that the mark provided the relevant public with an appealing entity which could create a lasting memory, thus functioning as an indication of origin and that the trade mark had to, therefore, be considered to have the minimum level of distinctive character required for registration. The Board added that nowadays the trend in design was for simplicity. The trade mark applied for was not an exception but was designed in accordance with this. It also had to be possible for such marks to have a right to protection, even if it followed from that simplicity that the scope of protection was usually very limited.

The Board upheld the appeal.

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Decision of the Second Board of Appeal of 18 February 2015 in case R1078/2014-2 (SV)

Absolute grounds for refusal – Article 7(1)(b) and (c) and 7(2) CTMR – figurative mark, minimum degree of distinctiveness

The applicant sought to register the figurative mark



for goods in Class 11.

The examiner rejected the application for all the goods applied for pursuant to Article 7(1)(b) and (c) and 7(2) CTMR.

The applicant filed an appeal against the decision.

The Board found that in light of the definitions of the words 'EASY', 'CLEAN' and 'COATING' given by the examiner, as well as the type of goods in question, the combination of the words was no more than the mere sum of those parts. However, the applicant also argued that the contested mark was distinctive because of the additional figurative element. In the Board's view it was not immediately clear what kind of message the image was trying to convey. Furthermore, the Board was of the opinion that the figurative elements of the mark applied for could not be seen to be a mere variation on a basic shape commonly used for the goods. Even

if the image depicted were to be perceived as an allusion to the idea of cleaning, it had to be seen as somewhat arbitrary. The representation was not banal, it was not a customary reproduction of an (easy to) clean coating, nor a straightforward stylised representation of one. Based on an evaluation of the mark as a whole, it could not be denied that the figurative elements of the sign, although perhaps not highly imaginative, were sufficient to endow the mark with a minimum degree of distinctiveness.

The Board upheld the appeal and annulled the contested decision.

[Link to eSearch Case Law](#)

Decision of the Fifth Board of Appeal of 6 February 2015 in case R2804/2014-5 (EN)

Absolute grounds for refusal – Article 7(1)(f) CTMR – public policy and morality

The applicant sought to register the word mark 'MECHANICAL APARTHEID' for goods and services in Classes 9, 16 and 41, primarily computer games, computer game strategy guides and computer game services.

By a decision the examiner rejected the application for being ineligible for registration under Article 7(1) (f) and 7(2) CTMR.

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The applicant filed an appeal against the examiner's rejection.

The Board confirmed that the application was contrary to public policy and accepted principles of morality pursuant to Article 7(1)(f) CTMR. The relevant public would understand 'Apartheid' as referring to a racist and inhuman system which denied human dignity. The addition 'Mechanical' did not diffuse or transform the semantic content of the term 'Apartheid', but, in fact, reinforced it. The sign 'MECHANICAL APARTHEID' used on the goods and services claimed appeared to trivialize a racist and inhuman regime and offended the victims of the 'Apartheid' system.

The Board dismissed the appeal in its entirety.

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Decision of the Second Board of Appeal of 30 January 2015 in case R0073/2014-2 (EN)

Opposition –Article 8(1)(b) CTMR and Article 8(2)(c) in conjunction with Article 8(1)(b) CTMR – figurative mark, likelihood of confusion

The applicant sought to register the figurative mark



for goods in Classes 18 and 25.

The opponent filed an opposition based on earlier



figurative CTMs, IRs and national rights

CARAMELO



registered for, inter alia, goods in Classes 18 and 25.

The Opposition Division rejected the opposition.

The opponent filed an appeal against the decision.

The Board found that as to the comparison of an earlier, sole device, mark (in this case an international registration consisting of a bird-like device) and a composite mark (consisting of a verbal element and a figurative element representing a bird-like device), where a composite mark was composed by juxtaposing one component and another trade mark, that latter mark, even if it were not the dominant component in the composite mark, might still play an independent distinctive role in the composite mark. The size and the position in the sign of the figurative element had to be taken into account. The dissimilarity between the marks was insufficient to counteract the similarity deriving from the highly similar bird-like/eagle device in the marks at issue and bearing in mind this figurative element was the only element of the earlier mark. In addition, the slight differences between the figurative elements in question were incapable of altering the fact that consumers would remember the image of a bird-like device/eagle. The opposition ground of Article 8(1)(b) CTMR was not only

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based on the opponent's abovementioned earlier international registration in the sense of Article 8(2) (a)(i) CTMR but also on its earlier well-known trade mark in the sense of Article 8(2)(c) CTMR claiming its well-known status for Austria, the Benelux, Germany, France, Italy, Portugal, the UK and Greece and the goods in Class 25. As the goods were identical or were encompassed in the list of goods in Class 25 covered by the international registration, which had already been compared to the trade mark applied for, the outcome could not be any different even if the marks were to be found to be well known in the relevant territories. As to the comparison of two composite marks both containing figurative and verbal elements, in that regard, it had to be observed that it was unlikely that the public would easily recognise and ascribe an origin to the figurative elements (in particular, the bird-like device) of those composite marks. This differed from the earlier international registration which only consisted of a figurative element. The differences in structure and representation of the marks were too substantial to create any impression of similarity. In this respect, since the earlier marks were found to be dissimilar overall to the mark applied for, it could not assist the opponent to rely upon the existence of well-known marks in Spain and the European Union for goods in Class 25, pursuant to Article 8(2)(c) CTMR.

The Board confirmed the contested decision's finding as concerns the assessment on the well-known marks, given that the overall global

impression of the marks was dissimilar and so precluded a likelihood of confusion.

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Decisions of the Fifth Board of Appeal of 24 March 2015 in case R565/2014-5 (EN)

Opposition – Article 8(1)(b) CTMR – likelihood of confusion

The applicant sought to register the word mark 'EURANET' for goods and services in Classes 9, 16, 35 and 41.

The opponent filed an opposition according to Article 8(1)(b) CTMR based on the earlier Spanish trade mark registration for the word mark 'EDITORIAL UNIVERSITARIA RAMON ARECES – EURA' for goods and services in Classes 16, 35, 38 and 41.

The Opposition Division partially upheld the opposition for some of the goods and services.

The applicant filed an appeal against the Opposition Division's decision.

The Board found that although the contested sign contained one element of the earlier mark, still there could be no likelihood of confusion. The contested sign was a short one. The earlier mark

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consisted of five words, four of which would be immediately understood and easily memorised by the relevant Spanish consumer. It also contained a not very frequent, distinctive name. The last word was meaningless. It was also not enhanced by any graphic means. There was no reason for the public to remember it. As a result, this element was unlikely to be recognized when bundled into another mark.

The Board upheld the appeal and rejected the opposition in its entirety.

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Decisions of the Fifth Board of Appeal of 13 and 27 February 2015 in cases R909/2014-5, R1019/2014-5 and R1136/2014-5 (EN)

Opposition – Article 8(1)(b) CTMR – three parallel decisions relating to belated evidence, likelihood of confusion, reputation of the earlier mark

The applicant sought to register the word mark and figurative mark 'BARISTA PRIMA COFFEEHOUSE' and the word mark 'BARISTA PRIMA' for goods and services in Classes 29, 30 and 35.

The opponent filed oppositions against the applications based on its earlier Polish figurative trade mark 'PRIMA' for, inter alia, goods in Class 30. The opponent alleged a likelihood of confusion

between the marks but did not claim the earlier mark's enhanced distinctiveness due to its extensive use on the Polish market.

The Opposition Division rejected the oppositions in their entirety because no likelihood of confusion existed.

The opponent filed appeals against the decisions.

The Board rejected the evidence of reputation submitted for the first time before the Board, for the following reasons: 1) the argument that the earlier mark was reputed had never been raised by the opponent before and no evidence in support of this had ever been filed (no additional evidence). 2) The opponent had ample opportunity to submit evidence before the Opposition Division. Even if this evidence had been acceptable, it did not prove the earlier mark's alleged reputation.

The Board dismissed the appeals.

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Decisions of the Second Board of Appeal of 27 February 2015 in case R1865/2014-2 (EN)

Opposition – Article 8(1)(b) CTMR – proof of use, lack of reasoning, late evidence

The applicant sought to register the word mark 'MODULTEC' for goods and services in various classes.

The opponent filed an opposition according to Article 8(1)(b) CTMR based on an earlier CTM for the word mark 'MODUTE' for goods and services in overlapping classes.

The Opposition Division rejected the opposition because the opponent had failed to provide proof of use of its earlier mark in accordance with Article 42(2) CTMR.

The opponent filed an appeal against the Opposition Division's decision.

The Board noted that in the grounds of appeal, the opponent merely stated that it 'did not agree with it [the contested decision]'. However, it did not refer to specific parts of the decision, or offered counter arguments. It did not even make a cursory reference to the exhibits submitted during the opposition proceedings and made no effort to convince the Board of their sufficiency as proof of use. In short, the opponent failed to provide a reasoned rebuttal

of the Opposition Division's finding, vis-à-vis the insufficiency of the proof of use for the earlier mark. Although, on appeal, the opponent filed further evidence of use, this was also deemed insufficient. The opponent simply 'lumped' together exhibits, belatedly, without comment or explanation, and without giving reasons for their late submission. The Board noted that the opponent gave no explanation why the new invoices filed on appeal – generally so important in the proof of use assessment – were not filed within the set time-limit. Secondly, the Board noted that the opponent did not discuss, refer to, analyse, appraise or justify any of the proof of use evidence for the earlier mark, neither that filed before the Opposition Division, nor that filed belatedly on appeal. Instead, it merely indicated a new annex bearing the heading 'the commercialisation, by the invoices, of the mentioned goods'. Nevertheless, the Board noted that the opponent had simply joined a mass of new materials to its grounds of appeal, without making the slightest effort to explain it, or how, in conjunction with the other evidence, it might have served to show proof of use of the earlier mark. The Board concluded that the new evidence submitted on appeal was not admissible because it was insufficient for the opponent merely to attach a bundle of documents, without explaining their purpose and without explaining how they combined with the other materials to form a convincing body of proof of use, and, indeed, without making a single reference to their content or significance.

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The Board confirmed the contested decision and dismissed the appeal.

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Decision of the Fifth Board of Appeal of 23 March 2015 in case R1125/2014-5 (ES)

Opposition – Article 8(1)(b) and 8(5) CTMR - figurative mark, proof of use

The applicant sought to register the figurative mark



for goods in Classes 3, 10, 12, 21, 25 and 28.

The opponent filed an opposition pursuant to Article 8(1)(b) and 8(5) CTMR, based, inter alia, on earlier international registration



for goods in Classes 3, 10, 12, 21, 25 and 28.

The Opposition Division dismissed the opposition in its entirety.

The opponent filed an appeal against the decision. The Board rejected the grounds of opposition laid down in Article 8(5) CTMR because the evidence (filed with no compiling effort, with no numbered

list or explanations of the annexes) was considered insufficient to prove reputation of the earlier mark. The same evidence was nonetheless sufficient to prove genuine use, at least in Spain, which was one of the Member States designated in the earlier international registration. In that respect, reference was made to case-law assimilating international trade mark registrations to national registrations as to proof of use issues. The grounds of opposition laid down in Article 8(1)(b) CTMR were also rejected because the aural similarity between the marks for a part of the consumers was counteracted by the visual and conceptual differences. The Board dismissed the appeal.

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Decision of the Forth Board of Appeal of 9 March 2015 in case R1506/2014-4 (DE)

Cancellation proceedings – Article 51(1)(a) CTMR – revocation, genuine use, variation of trade mark

The CTM proprietor registered the figurative mark



in black and white.

The cancellation applicant filed an application for revocation on the basis of non-use pursuant to

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Article 51(1)(a) CTMR.

The Cancellation Division partially rejected the application for revocation as the proprietor could have proved use of the figurative mark for some of the goods and services claimed – even though another banal element (circle)  was added.

The cancellation applicant appealed the Cancellation Division's decision.

The Board decided that an extremely simple figurative element A (the figurative mark) was used together with an extremely simple figurative element B (circle) in such a way that A and B blended into a new sign. No use of the trade mark or an 'acceptable variation' of it in terms of Article 15(1)(a) CTMR was proven.

The Board annulled the contested decision and revoked the CTM in its entirety.

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Decision of the Second Board of Appeal of 25 February 2015 in case R1856/2013-2 (EN)

Cancellation proceedings – Article 51(1)(a) CTMR – well-known titles of books

The CTM proprietor registered the word mark

'PINOCCHIO' for goods and services in Classes 3, 9, 14, 16, 18, 20, 21, 24, 25, 28, 30 and 41.

The cancellation applicant filed a request for a declaration of invalidity on the basis of absolute grounds pursuant to Article 52(1)(a) CTMR, namely that the CTM had been registered in breach of Article 7(1)(b) CTMR.

The Cancellation Division rejected the request for a declaration of invalidity.

The cancellation applicant appealed the Cancellation Division's decision.

The Board found that in invalidity proceedings, the Boards of Appeal could not be required to carry out afresh the examination which the examiner conducted, of his/her own motion, of the relevant facts which could have led him/her to apply the absolute grounds for refusal. It was, therefore, for the cancellation applicant for a declaration of invalidity to adduce evidence in support of its application for revocation or for a declaration of invalidity. It was true that the mark in question, 'PINOCCHIO', belongs to the category of titles of books which are well known. However, titles or fictional character names could commonly be trade marks and were assumed to function as prima facie indicators of trade origin. The criteria for the assessment of the distinctive character of such marks had to be the same as those applicable to the other categories of trade

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mark. The question was, therefore, whether the famous book title or name of the fictional character was distinctive in respect of the goods and services in question covered by the mark. There was nothing to say that 'PINOCCHIO' was incapable of being distinctive for paint, clothing or pencils. Indeed, the relationship between 'PINOCCHIO' and such goods was, if anything, an indirect one. However, and in line with the Office's practice it was incapable of performing a distinctive role in relation to certain goods and services (for example video game discs, books, action figures and entertainment services) in Classes 9, 16, 28 and 41, since consumers would simply think that these goods and services referred to the story of 'PINOCCHIO', this being the only meaning of the term concerned. The subject-matter of those goods and services was clearly the title and also the fictional character from a well-known children's book. As regards the remaining goods and services there was no information provided by the cancellation applicant to show that the contested mark had become customary in any language of the European Union, and therefore incapable of distinguishing the goods and services for which registration was sought. Even in the event that the word 'PINOCCHIO' were to have been found in current dictionaries, as claimed by the cancellation applicant, and could have been understood, the Board considered that the relevant public would perceive in it a message that went further than its literal meaning in relation to the goods and services involved. The cancellation applicant failed to show

the connection between the contested mark and the goods and services at issue.

Consequently, the Board partially allowed the appeal and declared the CTM invalid in respect of certain goods and services in Classes 9, 16, 28 and 41. The Board partially annulled the contested decision, in respect of the remaining goods and services.

[Link to eSearch Case Law](#)

Decision of the Fifth Board of Appeal of 4 March 2015 in case R2127/2014-5 (EN)

Cancellation proceedings - Article 51(1)(a) CTMR - revocation, genuine use

The CTM proprietor registered the word mark 'CYCLES' for wine in Class 33.

The cancellation applicant filed a request for revocation against the contested CTM based on Article 51(1)(a) CTMR claiming that the trade mark had not been put to genuine use within a continuous five-year period.

The Cancellation Division took a decision by which it rejected the application for revocation.

The CTM proprietor appealed the Cancellation Division's decision.

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The main issue of the case was the question of whether the trade mark had been used as registered. The decision examined and distinguished the use in a stand-alone form, use of a house brand together with a sub-brand, use of a family of marks and use of a combination which altered the distinctive character. The Board came, first, to the conclusion that the evidence did not show use of the mark in a stand-alone form. Although the name 'CYCLES' was written on the invoices in a stand-alone basis it followed from the further evidence (written statement, pictures of wine bottle labels), that the mark had always been used with further elements such as 'GLADIATOR', 'CLEMENT' and 'FALCON'. Second, the Board found that 'CYCLES' was not used as a house brand together with sub-brands. The owner argued that the fact that 'CYLCES' was perceived as a house mark resulted from the statement 'VINTED & BOTTLES BY CYCLES WINERY. NAPA. CA' on every back label. The Board found that the indication 'CYCLES WINERY', if it were noticed at all, would be perceived as a company name since the verb 'bottled' referred by definition to the act of a person, whether physical or moral. Third, the Board held that the owner failed to prove that it owned a family of 'CYCLES' marks. Finally, the Board concluded that the used form 'CYCLES GLADIATOR' altered the distinctive character of 'CYCLES' since 'Gladiator' was at least a distinctive for wines as 'CYCLES'.

As a consequence the Board annulled the contested decision and revoked the CTM.

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Decision of the Second Board of Appeal of 24 February 2015 in case R267/2014-2 (EN)

Cancellation proceedings – Article 53(1)(a) CTMR, Article 8(1)(b) CTMR – invalidity, acquiescence, proof of use

The CTM proprietor registered the word mark 'BONA' for goods in Classes 1, 2, 3, and 7.

The cancellation applicant filed a request for invalidity against the CTM on the basis of relative grounds, namely that the CTM was confusingly similar to the cancellation applicant's earlier mark



within the meaning of Article 8(1)(b) CTMR, in conjunction with Article 53(1)(a) CTMR.

The Cancellation Division declared the CTM partially invalid for some of the contested goods.

The cancellation applicant appealed the Cancellation Division's decision.

The Board found that less than five years had passed

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between the end of the verbal agreement between the CTM proprietor and the cancellation applicant – allowing for the coexistence of the trade marks at least in the United Kingdom – in other words from the moment when the cancellation applicant gained the option of not acquiescing in the use of the contested CTM, and the application for a declaration of invalidity. On the other hand, even if it were considered that the verbal agreement between the parties had not been breached and ceased when the CTM proprietor filed the opposition against the CTM application, the verbal agreement would in that case, have to be considered as still being valid. Therefore, the proprietor of the earlier trade mark still did not have the option of not acquiescing in the use of the latter CTM in the United Kingdom. Therefore, the claim of acquiescence was rejected. As to the proof of use, the CTM proprietor did not mention any specific evidence which would show that the goods and services were only limited to swimming pool surrounds, changing rooms and wet leisure areas. On the contrary, the Board, having studied the evidence, noted that even though use of the products and the services included swimming pool surrounds, changing rooms and wet leisure areas and use for these specific areas was in some cases recommended, these were not the only kinds of areas where the goods and services could be used and were offered. As could be seen from the evidence provided, almost all of the floor cleaners, treatments, etc. could be used on various kinds of floors, walls, tiles and other hard surfaces, including,

for example, in kitchens and station platforms. Therefore, this argument of the CTM proprietor also failed. As the goods and services were identical and similar and the marks were similar, there was likelihood of confusion.

The Board dismissed the appeal.

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Decision of the Fifth Board of Appeal of 2 February 2015 in case R881/2014-5 (DE)

Cancellation proceedings – Article 52(1)(b) CTMR, Articles 7(1)(b) and (c) CTMR – bad faith, book title, copyright protection

The CTM proprietor registered the word mark 'Der kleine Hey' for goods and services in Classes 9, 16 and 41.

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

The Cancellation Division rejected the declaration of invalidity.

The cancellation applicant appealed the Cancellation Division's decision.

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In the grounds of appeal the cancellation applicant argued that the CTM proprietor had tried to monopolize the book title 'Der kleine Hey' by filing the title as a CTM, although the right to the title was due to expire a couple of months after the trade mark's filing date. The Board rejected this argument because the CTM proprietor was the right holder of a second book – also called 'Der kleine Hey' – which enjoyed copyright protection until 2040. Nothing spoke against acquiring additional trade mark protection for this book title. The cancellation applicant, therefore, failed to prove bad faith.

The Board dismissed the appeal.

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Decision of the Fifth Board of Appeal of 27 February 2015 in case R1821/2014-5 (DE)

Cancellation proceedings – Article 53(1)(a) CTMR, Article 8(1)(b) CTMR –acquiescence, proof of use, belated evidence

The CTM proprietor registered the word mark 'life light' for goods in Classes 3, 5, 29, 30, 31 and 32.

The cancellation applicant filed a request for a declaration of invalidity on the basis of Article 53(1) (a) and (c) CTMR in combination with Article 8(1)(b) CTMR and Article 8(4) CTMR. Amongst others, the



request was based on the earlier figurative mark



The Cancellation Division took a decision by which it rejected the request for a declaration of invalidity because the cancellation applicant had not evidenced genuine use of the earlier trade mark sufficiently.

The cancellation applicant appealed the Cancellation Division's decision.

The Board exercised its discretion and accepted the additional evidence proving genuine use of the earlier national trade mark filed before the Board. Nevertheless, the additional evidence – one affidavit and product catalogues – was insufficient proof of use for a period of five successive years. The content of the affidavit was not supported by further documents and the product catalogues covered only the last six months of the relevant period.

As a consequence the Board dismissed the appeal.

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Decision of the Second Board of Appeal of 18 February 2015 in case R1991/2013-2 (EN)

Cancellation proceedings – Article 52(1)(b) CTMR and Article 53(2)(c) CTMR – invalidity, bad faith, registered copyright

The CTM proprietor registered the word mark 'PlayNow' for goods and services in Classes 9 and 38.

The cancellation applicant filed a request for a declaration of invalidity in respect of all the goods and services on the basis of Articles 52(1)(b) CTMR (bad faith) and Article 53(2)(c) (registered copyright).

The Cancellation Division rejected the request for a declaration of invalidity.

The CTM proprietor appealed the Cancellation Division's decision.

The Board noted that the cancellation applicant, a Mexican individual, claimed that she owned the copyright in the name 'PLAYNOW'. However, it was doubtful whether the denomination 'PLAYNOW' was sufficiently original to be protected by a copyright, given that it was the simple combination of the English verb 'to play' and the adverb 'now'. Further, it was not shown that the sign 'PLAYNOW' had been used in either Mexico or the EU. A fortiori it was not shown that the right invoked enjoyed reputation in the EU. It could not be presumed

that the CTM proprietor had any knowledge of the cancellation applicant's business in connection with 'PLAYNOW' prior to the filing of the contested CTM. At best, the CTM proprietor might have been aware of the existence of the Mexican mark on the Mexican register but this did not imply that it was acting in bad faith when filing the contested mark, even less so in a different territory, namely the EU. Furthermore, the fact that the CTM proprietor might have filed an invalidity request for non-use against the cancellation applicant's Mexican mark, which was not proven, did not demonstrate that the CTM proprietor had the intention of preventing the cancellation applicant from using the sign 'PLAYNOW'.

Therefore, the Board confirmed that the CTM proprietor did not act in bad faith at the time of applying for the registration of the contested mark.

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The Registry also recommends

Decision of the First Board of Appeal of 12 March 2015 in case R2577/2013-1 (EN)

Procedural Issues – Article 8(1)(b) CTMR, Article 41(1)(a) CTMR – admissibility of opposition, entitlement to file an opposition, authorised licensee

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The applicant sought to register the word mark 'KUROSHIRO' for goods in Classes 12, 18 and 25.

The opponent filed an opposition against part of the goods in Class 25 based on the earlier word mark 'kuro' due to a likelihood of confusion. The opponent and the proprietor of the earlier mark were represented by the same representative. According to the representative the opponent entered the opposition as an authorised licensee of the proprietor of the earlier mark, pursuant to Rule 15(2)(h)(iii) CTMIR.

The Opposition Division rejected the opposition pursuant to Rule 20(1) in conjunction with Rule 19(1) CTMIR, inter alia, because of missing evidence proving its entitlement to file the opposition.

The opponent filed an appeal against the Opposition Division's decisions.

The Board found that the opponent's and its licensee's representative was one and the same person and the fact that that representative confirmed this should have been sufficient to demonstrate the opponent's entitlement beyond any doubt.

The Board annulled the contested decision and remitted the case back to Opposition Division.

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Decision of the Fourth Board of Appeal of 6 March 2015 in case R707/2014-4 (EN)

Procedural Issues -- Article 17(1) and from Article 17(5) to Article 17(7) CTMR, Article 32(4) CTMR - renewal, partial surrender, partial transfer

The CTM proprietor registered the word marks 'Doulton' and 'Royal Doulton' for Classes 11, 21 and 24. Before the expiry of the CTMs, the CTM proprietor requested a renewal limited to the goods in Classes 21 and 24 and the renewal was registered on 15 September 2013. The CTMs were partially transferred to an assignee on 11 April 2013 for the goods in Class 11 and the assignee requested a partial renewal of the CTMs for the goods in Class 11 on 20 September 2013.

The Office rejected to record the assignee as the new proprietor and referred to the fact that the partial renewal requested by the assignee as regards Class 11 had been refused, therefore the goods in Class 11 could no longer be transferred to a new proprietor.

The assignee filed an appeal against the above decision.

The Board found that the partial transfer led to a 'division' of the CTM but not by virtue of Article 49 CTMR, but as a natural consequence of the partial transfer. Therefore, there was no longer any basis,

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at that stage of the proceedings, to record the appellant as the owner of the CTMs in respect of Class 11 goods as those goods were no longer covered by the CTMs when the request for transfer was made.

The Board dismissed the appeal.

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Decision of the First Board of Appeal of 12 March 2015 in case R2029/2014-4 (EN)

Procedural Issues – Article 8(1)(b) CTMR, Article 41(1)(a) CTMR – opposition, substantiation of earlier right (para 16)

The applicant sought to register the figurative mark



for goods in Classes 29 and 30.

The opponent filed an opposition against part of the goods in Class 29 based on the earlier Spanish trade mark 'FRESHUP' due to a likelihood of confusion pursuant to Article 8(1)(b) CTMR.

The Opposition Division rejected the opposition because the opponent had not proven the existence,

validity and scope of protection of the earlier mark.

The opponent filed an appeal against the Opposition Division's decisions.

The Board ruled that an extract from the database of the Spanish trade mark office (SITADEX), which the opponent submitted within the period to substantiate the opposition, left no doubt about the authenticity of the document. The source of the document was obvious from the structure and the content of the extract, even though it made no reference to the SITADEX database. The source was also confirmed by the opponent and a translation was filed in time. Thus, the opponent had substantiated the earlier right sufficiently.

The Board annulled the contested decision and remitted the case back to Opposition Division.

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