

# Alicante News

Up to date information on IP and OHIM-related matters

Quick Links 

## First Page

---

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

---

## Community Trade Mark

---

■ Clarifying your list of goods and services under Article 28(8)  
KCG&S Issues

## Registered Community Design

---

■ Elements external to the Community design

## Statistical Highlights

---

■ January 2016

## ETMDN Updates

---

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

---

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

---

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open



**March 23, 2016  
from OHIM to EUIPO**

Sandra Martins Pinto talks to James Nurton

## First Page



### March 23, 2016 – from OHIM to EUIPO

The countdown to the changes brought about by the entry into force of the amending EU trade mark Regulation is well underway.

After its publication on December 24, 2015, the amending Regulation enters into force on March 23, 2016, bringing with it a series of changes for the Office and its users.

As a result, on March 23, the Office will officially change its name to the European Union Intellectual Property Office (EUIPO), with its website address being [www.euiipo.europa.eu](http://www.euiipo.europa.eu) and all its contact email addresses reflecting the new name (for example, [information@euiipo.europa.eu](mailto:information@euiipo.europa.eu)).

It is important to note that the old email addresses will run parallel to the new ones for some months, but users are kindly reminded to update their contact lists as and from March 23. Meanwhile, work is being carried out to update all the Office's web systems and e-business tools, including the fee calculators, to reflect the changes in the amending Regulation.

On the day the amending Regulation was published in the Official Journal of the EU, the Office launched a [special section in its website](#) dealing with the changes that would be implemented under its provisions.

Grouped under the three key headings: technical changes; fees changes; and institutional changes, the web section provides a quick guide for users to the post-March 23 landscape.

The section now also contains resources for users on the implementation of the new Article 28(8) of EUTMR, including links to the Communication of the President, an Annex to the Communication containing a non-exhaustive list of examples of goods and services clearly not covered by the literal meaning of the general indications of the Nice classification (6th to 10th editions), and a set of frequently asked questions to aid users.

On March 23, an updated version of the [Guidelines for Examination](#) will also enter into force, which will reflect the changes introduced by amendments in the Office's trade mark examination practice.

It is important to note that not all changes in the amending Regulation will enter into force on March 23. Changes such as the removal of the graphical representation requirement and the EU certification mark are set to enter into force on October 1, 2017, 21 months after publication. The amending Regulation foresees that the Commission will issue secondary legislation to complement and develop some of the provisions of the basic Regulation.

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8)  
KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



## First Page



Once the secondary legislation has been approved and published, the [Guidelines for Examination](#) of the Office will again be updated to reflect Office examination practice in the light of these additional changes in time for their entry into force on October 1, 2017.

In the run up to the change of name of the Office, we ask our users to kindly remember that the Office never sends its users invoices or letters requesting direct payment for services. If you have any doubts about anything that you receive, please contact us at [information@oami.europa.eu](mailto:information@oami.europa.eu).

## First Page

---

- March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

---

## Community Trade Mark

---

- Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

---

- Elements external to the Community design

## Statistical Highlights

---

- January 2016

## ETMDN Updates

---

- Consultation on European Cooperation Projects
- The Harmonised Database celebrates its first full year

## More News

---

- Public consultation on the Office's Strategic Plan 2020
- DesignEuropa Awards: celebrating design in the EU
- Ninth judges' symposium report available now

## Case Law

---

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open



## The James Nurton Interview



Sandra Martins Pinto, SGCR, Porto, Portugal

### What is your background?

I have a law degree and a masters degree in intellectual property. I didn't study IP in my law degree but after finishing it I was reading about some fierce debates around specific IP topics. These debated issues such as the legality of peer-to-peer networks and open source software products, and these topics intersected with interests of mine such as privacy and civil rights. I wanted to take part in those debates so I decided to do specialised studies in the IP area.

A few years ago I went back to university to study computer science, which has been an interesting but challenging experience. It's a very interesting area: one topic that I studied in my masters was software patents so I wanted to get to know the software area a bit better.



Sandra Martins Pinto

After I finished my masters the opportunity arose to join SGCR.

### What kind of work do you do?

Mainly trade marks and designs. Since 2008 I have been in charge of our Porto office. We noticed that many of our clients came from northern Portugal so we expanded with an office here. I embraced the opportunity to come to my home town from Lisbon. We are currently 20 people in Portugal, with just two people here in Porto.

We represent clients in all aspects of trade mark and design law and practice. We have local clients in industries such as shoes, cork and wines. We are also national representatives for multinational companies in many areas, such as pharmaceuticals, tobacco, personal hygiene products, and in the tertiary sector such as banking and tourism. Our client portfolio represents many of Portugal's strongest sectors: furniture, tourism and football of course!

IP knowledge in Portugal is improving. There is a lot of research and development in some companies and institutions, some of which are connected with universities and some with specialised research centres. There are a lot of sector-specific technology centres and they tend to do training courses for SMEs, so knowledge is improving.

## First Page

- March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

- Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

- Elements external to the Community design

## Statistical Highlights

- January 2016

## ETMDN Updates

- Consultation on European Cooperation Projects
- The Harmonised Database celebrates its first full year

## More News

- Public consultation on the Office's Strategic Plan 2020
- DesignEuropa Awards: celebrating design in the EU
- Ninth judges' symposium report available now

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open



## The James Nurton Interview



### Is there still a demand for national rights in Portugal?

It depends on the client and the size of the client. There are a lot of SMEs that still want national rights.

There are some differences between the Portuguese trade mark office and OHIM, though they tend to be fewer and fewer. For example, our trade mark office in Portugal still performs an ex officio relative grounds check. Another difference is the absolute grounds check is done after publication.

Examination has become very quick, and is now done in about six to eight months. It used to take about two years to registration, so it is improving. The office has improved its databases and hired more examiners. Everything is digitised now too.

### How well do you think the CTM and RCD work?

They are still popular with practitioners and clients, and are very user-friendly. I have seen steady willingness on the part of OHIM to improve over the past 10 years, especially on the databases.

The size of the EU is a problem, as many CTMs are not in fact used and yet may prevent registrations even in national registers. We see this in Portugal, regardless of oppositions. So clients find it increasingly difficult to find a mark that is available.

But I believe the recently agreed changes to official fees and the specification of goods and services will help with this. I think Portuguese companies prefer to pay just strictly for the goods and services they are interested in so overall there should be lower costs.

There are some changes that we can't predict the results of. I'm curious to see whether the abolition of the graphical representation requirement will lead to more non-traditional trade marks. I think there will be an increase but there may be problems at first. There will be interesting times.

In Portugal the biggest changes will be the request for proof of use in the context of opposition proceedings and the introduction of administrative procedures for the invalidation of trade mark registrations. Before now, we had to go to the IP Court. In terms of timings and formalities and costs, this will be an improvement. I think the change will be done faster than the eight years allowed. The Office is already active and we already have a cancellation procedure in the trade mark office which works ok so I don't think it will be a problem.

## First Page

- March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

- Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

- Elements external to the Community design

## Statistical Highlights

- January 2016

## ETMDN Updates

- Consultation on European Cooperation Projects
- The Harmonised Database celebrates its first full year

## More News

- Public consultation on the Office's Strategic Plan 2020
- DesignEuropa Awards: celebrating design in the EU
- Ninth judges' symposium report available now

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open



## The James Nurton Interview



### Have there been any significant recent developments in Portugal?

There have been two important changes. The first was the creation of a specialised IP Court in Lisbon in 2012. It is very important to have a specialised jurisdiction for a subject matter as specific as IP. I think it's working well so far but it's too early to make conclusions. It does mean our local clients in Porto have to go to court in Lisbon but it's not a big problem as they don't have to physically be there, and most decisions appealed from the trade mark office were already in the Lisbon Commercial Court, so it's not a big change.

The second change was the introduction in 2011 of a compulsory arbitration procedure for conflicts regarding reference medicines and generic medicines. This procedure has put an end to a long controversy by clarifying that the granting of a marketing authorisation, or the authorisation of a consumer sales price or the decision to have it covered by a government contribution does not infringe patent rights or rights derived from an SPC. This was a big deal in terms of legal certainty for pharmaceutical companies so now they can draft their strategic plans in Portugal another way. It's working very well and has solved a problem that was clogging our courts, with beneficial results for everyone.

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

I don't think I can single out a specific case. But over the years I have found the most interesting cases are those which require me to learn something new particularly in subjects that lie outside IP, which may not even be juridical. For example, the history of Portuguese Jewish families, the architecture of optical fibre networks and the history behind the badge of a well-known Portuguese football team. This has always attracted me to IP in the first place. This is what is most interesting about my work: you are always learning and always in touch with creative people. It is a privilege to learn about cutting-edge innovation before it becomes well-known.

### Are there any particular issues that arise in the wine industry?

Sometimes it happens that there are some protected geographical indications (PGIs) around Port wine, Douro etc and sometimes they conflict with trade marks, for example when we have a CTM application. With the changes to the Regulation, GIs will have stronger protection so I think those kinds of conflicts will happen more.

Nowadays the wine industry has a good understanding of IP rights and many enterprises are protecting their brands all over the world.

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open



## The James Nurton Interview



### What do you think the future holds?

I can only imagine that IP will grow more important. The world is more tech-oriented than ever and companies need to protect their investments. Brands are becoming more than words, they are tokens and part of the way that people connect with each other and have become part of our lifestyle.

One of the biggest challenges will be to ensure that we keep a proper balance between IP rights on one hand and privacy and freedom of speech on the other hand. Given my background, I think balance is important. Subjects such as trade marks and parody have not been fully explored yet, not just by practitioners but by civil society in general.

## First Page

---

- March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

---

## Community Trade Mark

---

- Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

---

- Elements external to the Community design

## Statistical Highlights

---

- January 2016

## ETMDN Updates

---

- Consultation on European Cooperation Projects
- The Harmonised Database celebrates its first full year

## More News

---

- Public consultation on the Office's Strategic Plan 2020
- DesignEuropa Awards: celebrating design in the EU
- Ninth judges' symposium report available now

## Case Law

---

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Community Trade Mark

### Clarifying your list of goods and services under Article 28(8) KCG&S Issues

Following the Judgment of 19/06/2012 in Case C-307/10 'IP TRANSLATOR' in which the Court of Justice ruled on the standards of clarity and precision to be applied to the classification of goods and services, the practice of the Office changed.

The previous practice had been to interpret applications for the entire class heading of a Nice class as constituting a claim to all the goods or services falling within the relevant class. This practice was amended by Communication of the President 2/12 concerning the use of class headings in lists of goods and services. According to that Communication the Office interpreted the use of all the general indications in the class heading as follows:

- EU Trade Marks applied for on or before 20/06/2012 and registered for all the general indications listed in the class heading of a particular class, were considered by the Office to cover not only the literal meaning of the general indications but also the goods or services included in the alphabetical list of that class in the edition of the Nice Classification in force at the time of filing.



- EUTMs applied for after 21/06/2012 for all the general indications of a particular class heading of the Nice Classification were interpreted by the Office following a literal approach.

[Regulation \(EU\) 2015/2424](#) amending the CTMR aims to bring the Register up to date, in line with the IP Translator judgment, bringing clarity and precision to the Register and thus allowing competent authorities and economic operators to determine the extent of protection sought.

Article 28(8) EUTMR allows for a transitional period of six months during which proprietors of EUTMs applied for before 22 June 2012 and registered in respect of the entire heading of a Nice class may declare that their intention on the date of filing had been to seek protection in respect of goods and services beyond those covered by the literal meaning of that heading.

In essence, this means that from the end of the transitional period, all trade marks containing class headings will be interpreted according to their literal meaning regardless of their filing date.

On 08/02/2016 the President issued Communication [1/2016](#) on the implementation of Article 28 EUTMR. This Communication sets the framework for proceedings before the Office for entering a declaration under Article 28(8) EUTMR in the Register. It also provides an [Annex](#) containing

## First Page

- March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

- Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

- Elements external to the Community design

## Statistical Highlights

- January 2016

## ETMDN Updates

- Consultation on European Cooperation Projects
- The Harmonised Database celebrates its first full year

## More News

- Public consultation on the Office's Strategic Plan 2020
- DesignEuropa Awards: celebrating design in the EU
- Ninth judges' symposium report available now

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open



## Community Trade Mark



a non-exhaustive list of examples of goods and services clearly not covered by the literal meaning of the general indications of the Nice class headings for each of the editions of the Nice classification concerned (6th to the 10th edition) to assist users in making their declarations.

In addition, the Office has prepared a list of [Frequently Asked Questions](#) which should help guide users in making their declarations.

Finally, a [webinar](#) was broadcast on 02/02/2016 on the Questions and Answers on the new EU trade mark Regulation. This webinar includes 50 minutes of questions and answers on Article 28(8) declarations.

Before rushing to file a declaration under Article 28(8), users should first check that their trade mark fulfils the requirements of Article 28(8) EUTMR, namely:

- that it was filed before 22/06/2012
- that it is registered for at least one entire class heading of the Nice classification

Users should also consider whether they have a real interest in filing a declaration. Declarations are limited to goods and services that **go beyond** the literal meaning. The Office has provided a list of terms considered to be clearly **not** covered by the literal meaning and these should serve as guidance to users and to show that the literal meaning of

the class heading, in many cases, is considered to cover all goods in the alphabetical list of that class. In Office practice, there are relatively few classes for which the literal meaning of the class heading does not cover all the goods in the alphabetical list, or relatively few terms that are considered to be clearly not covered by the literal meaning.

Furthermore, users should be aware of the limitations to Article 28(8), and in particular those of Article 28(9). Specifically, any goods or services declared will still be subject to the use requirements of Article 42(2) EUTMR from their filing or priority date, and many of the marks concerned were already filed over five years ago. In addition, the goods and services declared may not be used in opposition or invalidity proceedings against a mark that was filed before the declaration was entered in the Register.

The Office encourages users to make use of the provisions of Article 28(8) if they are actually using, or intend to use, the mark for the specific goods and services not clearly covered by the literal meaning.

If the user decides to file a declaration, they should do so **between 23/03/2016 and 24/09/2016** inclusive, using the [online form](#) provided for that purpose. Users are reminded that the declaration must be for goods or services that go **beyond the literal meaning** and that are **contained in the alphabetical list of the Nice classification in force on the date of filing**.

## First Page

- March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

- Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

- Elements external to the Community design

## Statistical Highlights

- January 2016

## ETMDN Updates

- Consultation on European Cooperation Projects
- The Harmonised Database celebrates its first full year

## More News

- Public consultation on the Office's Strategic Plan 2020
- DesignEuropa Awards: celebrating design in the EU
- Ninth judges' symposium report available now

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open



## Registered Community Design



### Elements external to the Community design

One of the main objectives of the Community design system is to present minimum cost and difficulty to the applicants. However, the filing of a correct design representation is extremely important for the application procedure as well as the design's scope of protection once registered. As a design representation, once filed, in principle cannot be altered, it falls within the applicant's responsibility to submit correct and complete ones (*Guidelines for Examination in OHIM on RCD, Examination of Applications for Registered Community Designs, 5.2 Consistency of the views*).

The representation of the design filed must consist of a graphic or photographic reproduction on a neutral background which permits all the details of the matter for which protection is sought to be clearly distinguished (Article 4(1) CDIR).

Nevertheless, often the representations of the designs filed before the OHIM include elements external to the design which do not permit to clearly determine for which the applicant seeks protection.

In principle, views should not include external and foreign matter to the design (*Guidelines for Examination in OHIM on RCD, Examination of Applications for Registered Community Designs, 5.2.6 Elements external to the design*). Those "external

elements" shall be distinguished from the elements the inclusion of which – as an exception – does not cast any doubts on the protection sought and serve only an illustrative purpose, such as a part of human body wearing a piece of clothing, the shape of which would not be easy to demonstrate otherwise, or vegetation in the background of a product which, under normal circumstances, could not be photographed on a neutral background.

An example for the improper inclusion of external elements is if an applicant seeks to register a Community design for a "Picnic basket", but the representation shows additionally a cutlery set, the matter for which protection is not sought. Even if the cutlery set is additionally added as a product indication and the application may thus be acceptable (subject to the payment of a fee if a multiple application must be divided for this reason), the representation may not be aligned with what the applicant actually sought to protect, namely the design of the "Picnic basket" only.

Although the applicant of a design showing "external elements" may disclaim part of the design following an objection of the Office based on the above described discrepancy between the representation of the design and the product indication, in the course of the registration procedure, this could affect the filing date of the design and, in addition, doubts on the subject matter may remain when registered.

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open



## Registered Community Design



In conclusion, for the application to comply with the legal requirements established and in order to allow third parties to determine with accuracy all the details of the Community design for which protection is sought, if possible the representation should be filed free from any elements external to the design.

## First Page

- March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

- Clarifying your list of goods and services under Article 28(8)  
KCG&S Issues

## Registered Community Design

- Elements external to the Community design

## Statistical Highlights

- January 2016

## ETMDN Updates

- Consultation on European Cooperation Projects
- The Harmonised Database celebrates its first full year

## More News

- Public consultation on the Office's Strategic Plan 2020
- DesignEuropa Awards: celebrating design in the EU
- Ninth judges' symposium report available now

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

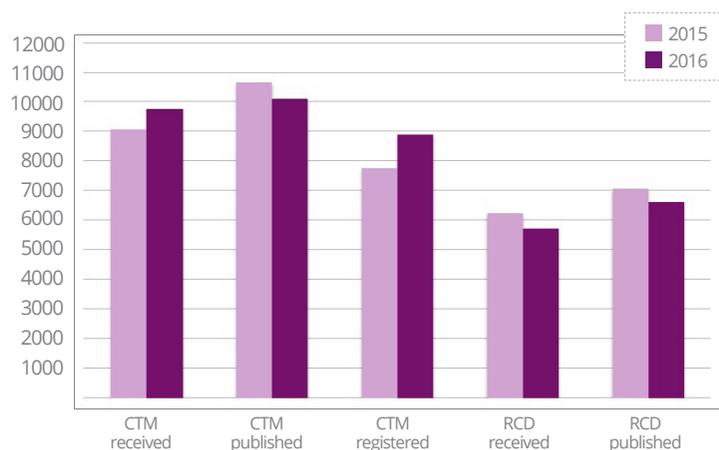


## Statistical Highlights



Monthly statistical highlights January*	2015	2016
Community Trade Mark applications received	9 059	9 768
Community Trade Mark applications published	10 645	10 111
Community Trade Marks registered (certificates issued)	7 762	8 899
Registered Community Designs received	6 237	5 728
Registered Community Designs published	7 059	6 608

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



## First Page

- March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

- Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

- Elements external to the Community design

## Statistical Highlights

- January 2016

## ETMDN Updates

- Consultation on European Cooperation Projects
- The Harmonised Database celebrates its first full year

## More News

- Public consultation on the Office's Strategic Plan 2020
- DesignEuropa Awards: celebrating design in the EU
- Ninth judges' symposium report available now

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



DESIGNEUROPA awards

Applications now open



## Consultation on European Cooperation Projects

In parallel to the ongoing [consultation on the Strategic Plan](#) (2016-2020), the Office is now launching a consultation on European Cooperation Projects.

One of the objectives of the proposed Strategic Plan is to intensify network engagement, among others, by implementing a suite of projects of interest to the European Union and its Member States, so as to promote convergence of practices and tools in the field of trade marks and designs.

The Office aims to gather views and suggestions from its stakeholders, as well as from the general public. This consultation will run from Tuesday 9 February to Tuesday 22 March 2016.

The consultation is being launched to consider the full effects of the [Regulation amending the EU trade mark](#), published on 24 December 2015, in particular by consulting user representatives during definition phase of the projects. More details, including the response form, are available on the dedicated [European Cooperation web page](#).

## The Harmonised Database celebrates its first full year

This month marks the one-year anniversary of the Harmonised Database (HDB) including data from every national and regional IP office in the European Union.

Work on the HDB began in 2009 with the goal of creating one common database of pre-approved goods and services and developing an organisational system known as Taxonomy to help users find the terms they need quickly and efficiently.

Seven years on, and the HDB is now the world's largest multilingual database of descriptions of goods and services. It has nearly 1.5 million terms in 23 languages, with more added all the time using terminology taken from real applications. The HDB incorporates the Nice Classification system; the ID list of pre-approved list of terms from the TM5 IP offices of China, Japan, OHIM, South Korea and the United States; and the Madrid Goods and Services – the pre-approved database of terms from WIPO for Madrid applications.

All HDB terms are pre-approved, which means that they are automatically accepted by every EU national and regional IP office and OHIM. For example, last year saw almost 80% of goods and services terms automatically accepted by OHIM.

The HDB aids trade mark offices in the EU by allowing them to draw from one EU-wide database when they validate, examine and translate lists of goods and services provided by applicants.

## First Page

- March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

- Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

- Elements external to the Community design

## Statistical Highlights

- January 2016

## ETMDN Updates

- Consultation on European Cooperation Projects
- The Harmonised Database celebrates its first full year

## More News

- Public consultation on the Office's Strategic Plan 2020
- DesignEuropa Awards: celebrating design in the EU
- Ninth judges' symposium report available now

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open



## More News



### Public consultation on the Office's Strategic Plan 2020

The Office is launching its [second consultation on the Strategic Plan 2020](#).

The aim of this second process of consultation is to understand the full effects of the [Regulation amending the EU trade mark](#), and to gather ideas and suggestions from all of the Office's stakeholders on the vision and strategic goals set by the Office for the coming five years.

### DesignEuropa Awards: celebrating design in the EU

Applications are now open for the inaugural edition of the [DesignEuropa Awards](#).

The DesignEuropa Awards celebrate excellence in design and design management among [Registered Community Design \(RCD\)](#) holders, whether they are individual right holders, SMEs or large enterprises.

#### The DesignEuropa awards have three categories:

- Industry (firms with 50 or more employees and/or with a turnover or balance sheet total of EUR 10 million or more);

- Small and Emerging companies (firms with fewer than 50 employees and/or a turnover or balance sheet total of less than EUR 10 million, or companies established after January 1, 2013);
- A special Lifetime Achievement Award

The application period runs from February 1 to July 15 2016. Application and nomination forms, plus rules and conditions are available on the [DesignEuropa Awards](#) section of OHIM's website. Finalists will be announced in October 2016.

The award ceremony will take place in Milan, Italy, on November 30, 2016, and is presented in cooperation with the [Ufficio Italiano Brevetti e Marchi \(UIBM\)](#), the Italian national industrial property office, a Directorate general of the Italian Ministry of Economic Development.

### Ninth judges' symposium report available now

The report of the ninth judges' symposium organised by the Office for Harmonization of the Internal Market through the Observatory from 5 to 6 November 2015 is [now available](#).

## First Page

- March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

- Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

- Elements external to the Community design

## Statistical Highlights

- January 2016

## ETMDN Updates

- Consultation on European Cooperation Projects
- The Harmonised Database celebrates its first full year

## More News

- Public consultation on the Office's Strategic Plan 2020
- DesignEuropa Awards: celebrating design in the EU
- Ninth judges' symposium report available now

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal





## More News



This ninth judges' symposium went in depth into issues such as: the impact of trade marks with weak/non-distinctive elements on likelihood of confusion; trade mark law and PDOs (protected designation of origin) and PGIs (protected geographical indication); IPR crime in the real and virtual worlds and publication of designs.

## First Page

---

- March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

---

## Community Trade Mark

---

- Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

---

- Elements external to the Community design

## Statistical Highlights

---

- January 2016

## ETMDN Updates

---

- Consultation on European Cooperation Projects
- The Harmonised Database celebrates its first full year

## More News

---

- Public consultation on the Office's Strategic Plan 2020
- DesignEuropa Awards: celebrating design in the EU
- Ninth judges' symposium report available now

## Case Law

---

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



**DESIGNEUROPA awards**

■ Applications now open

## Case law



### Luxembourg trade mark and design news

**B: General Court: Orders and Judgments**

**Case T-209/14; Carsten Bopp v OHIM Judgment of 25 September 2015, Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Distinctive element, Figurative trade mark, Specialised public

**FACTS:** The applicant sought to register a green octagon, namely the figurative sign represented below for the services “advertising and public relations in the form of customer information through labelling of the properties of goods and services” in Class 35. The examiner refused to register the application under Article 7 (1) (b) CTMR. The Board of Appeal (BoA) in its first decision (R 605/2010-4) dismissed the appeal holding that the application lacks distinctiveness for all services in Class 35 regardless of the services at hand which the applicant did not determine with sufficient clarity. The General Court (GC) set the decision aside (T-263/11), reasoning that the BoA infringed the principle according to which the distinctiveness of a sign must be assessed with regard to the specific goods and services. The BoA in its second decision dismissed the appeal as the octagon is a simple geometrical shape in green, a common used signal

colour, with respect to the services at hand. The GC dismissed the appeal.



**SUBSTANCE:** INFRINGEMENT OF ARTICLE 65 (6) CTMR: The BoA was competent to dismiss the appeal on the ground of a lack of distinctiveness. The GC in its previous decision did not render any finding determining the final outcome of the assessment under Article 7 (1) (b) CTMR (Paras. 28-31). There is no principle in European Union law according to which the Office must, following a judgment allowing two different interpretations, choose the most beneficial interpretation for the party concerned (Para. 32). INFRINGEMENT OF ARTICLE 7 (1) (b) CTMR: The services are directed at professionals taking decisions on their marketing activities relevant for their success. They will thus select the services with a high of attention, in average (Paras. 47-48). It is therefore irrelevant whether the consumers of the goods and services marked are acquainted with the sign at hand as a seal of quality (Para. 50). Green is a common colour not suitable to endow the octagon with distinctive character. The octagon is a simple geometrical shape like a pentagon, a rectangle, a triangle or a

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law

circle. An octagonal frame does not draw more attention than a simple octagon. The same applies with regard to the fact that the octagon's inner part is not coloured and contains no figurative element. This would only attract the public's attention if the sign would be placed against different backgrounds. However, such considerations concerning the sign's actual use cannot be relevant for the assessment at hand (Paras. 53-56). The sign will be perceived as a decorative element, as a seal or label (Para. 59).

**Case** T-60/14; **B.M.V. Mineralöl Versorgungsgesellschaft mbH v OHIM**; **Judgment of 17 June 2015**; **Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Likelihood of confusion, Dissimilarity of the goods and services

**FACTS:** The applicant sought to register the figurative sign shown below as a CTM for inter alia goods and services in Classes 9, 35 and 36. The opponent based its opposition on Article 8 (1) (b) CTMR using the earlier CTM shown below, registered for goods in Classes 4, 19, 35, 39 and 42. The Opposition Division upheld the opposition in part for the services in Class 35. The Board of Appeal (BoA) dismissed the opponent's appeal, finding that there was no likelihood of confusion, since the goods and services are dissimilar. The opponent appealed to



the General Court (GC), arguing an infringement of Article 8 (1) (b) CTMR.

### CTMA



### Earlier mark



**SUBSTANCE:** The applicant puts forward that the findings of the BoA as to the dissimilarity of the goods and services is wrong. It contends in particular that the "fuel cards" in Class 9 are similar to the opposed services in Class 36 and the fuel (Class 4).

The GC confirms the BoA that the contested goods "Magnetic and machine-readable cards containing encoded information; Cards with built-in facilities for storing and processing data (smart cards); Apparatus for reading and writing encoded information on cards; Encoded cards for use when buying petrol; Payment cards; Apparatus for data

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law

processing; Recorded computer programs; Encoded cards, in particular fuel cards" are dissimilar to the earlier services in Class 36 and "fuel" in Class 4. Although the distribution channels and the consumers are the same, since the confronted goods may be acquired by car drivers in a patrol station, the goods are not complementary, since there is no need for a fuel card in order to buy fuel (Paras. 31-33).

Further on, the goods are usually not produced by the same entities and the public will not consider the goods as coming from the same undertaking (Para. 34).

Consequently, the BoA was right to exclude likelihood of confusion between "encoded cards for use when buying fuel; encoded cards, in particular fuel cards" (Class 9) and "fuel" (Class 4), since these goods are dissimilar (Para. 35).

**Case T-242/14; The Smiley Company SPRL v OHIM; Judgment of 7 October 2015; Language of the case: EN**

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

**KEYWORDS:** Shape of the product, Three dimensional mark, Minimum degree of distinctiveness, Nature of goods and services



**FACTS:** The CTM applicant sought to register the three-dimensional sign above for goods in Classes 29 and 30. The examiner rejected the application. The First Board of Appeal (BoA) dismissed the appeal.

The CTM applicant filed an application before the General Court (GC) for the annulment of the decision of the BoA.

### CTMA



**SUBSTANCE:** The criteria for assessing the distinctive character of three-dimensional marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade mark. Nonetheless average consumers are not in the habit of making assumptions about the origin of goods on the basis of their shape or the shape of their packaging in the absence of any graphic or word element. Only a mark which departs significantly from the norm or customs of the sector is not devoid of any distinctive character (Paras. 32-34).

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law



The onus is on the CTM applicant to provide specific and substantiated evidence that the trade mark applied for has distinctive character, since it is much better placed to do so, given its thorough knowledge of the market (Para. 36).

In relation to “jellies” in Class 29 and “preparations made from cereals, pastry, confectionery, ices” in Class 30, consumers who are used to a very wide variety of goods such as the ones at issue, and the shapes and decorations of such goods, will perceive the constituent elements of the mark applied for taken individually and the shape created taken as a whole as possible — or even common — variants of the presentation and decoration of those goods. This is true even if the face shape at hand were to be intended to convey positive feelings or curiosity. (Paras. 41-45).

Moreover, average consumers accord confectionery and pastry goods only fleeting attention. The same is true in the sectors of preparations made from cereals, jellies and ices, and particularly true of ice lollies. (Para. 46).

It is not widely known that “preserved, frozen, dried and cooked fruits and vegetables; milk products” in Class 29 are also offered with a variety of decorative elements, let alone ornaments as elaborate as faces and other anthropomorphic or zoomorphic elements, contrary to what the BoA essentially stated. Liquid or creamy milk products, such as yoghurts, cannot take such a shape. Preserved, frozen, dried and cooked fruits and vegetables are usually packaged and presented in their natural

form, chopped, as coulis or in classic or functional geometric shapes, such as cubes, discs, pebbles, tiles, balls or coils. The exceptional nature of the habits in the sectors concerned involving presenting those goods in the shape of the mark applied for renders that mark capable of indicating the commercial origin (Paras. 56-60).

**Case T-243/14; The Smiley Company SPRL v. OHIM; Judgment of 7 October 2015; Language of the case: EN**

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

**KEYWORDS:** Shape of the product, Three dimensional mark, Minimum degree of distinctiveness, Nature of the goods and services

**FACTS:** The CTM applicant sought to register the three-dimensional sign above for goods in Classes 29 and 30. The examiner rejected the application. The First Board of Appeal (BoA) dismissed the appeal.

The CTM applicant filed an application before the General Court (GC) for the annulment of the decision of the BoA.

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law



### CTMA



**SUBSTANCE:** The criteria for assessing the distinctive character of three-dimensional marks consisting of the appearance of the product itself are no different from those applicable to other

categories of trade

mark. Nonetheless average consumers are not in the habit of making assumptions about the origin of goods on the basis of their shape or the shape of their packaging in the absence of any graphic or word element. Only a mark which departs significantly from the norm or customs of the sector is not devoid of any distinctive character (Paras. 32-34).

The onus is on the CTM applicant to provide specific and substantiated evidence that the trade mark applied for has distinctive character, since it is much better placed to do so, given its thorough knowledge of the market (Para. 36).

In relation to “jellies” in Class 29 and “preparations made from cereals, pastry, confectionery, ices” in Class 30, consumers who are used to a very wide

variety of goods such as the ones at issue, and the shapes and decorations of such goods, will perceive the constituent elements of the mark applied for taken individually and the shape created taken as a whole as possible — or even common — variants of the presentation and decoration of those goods. This is true even if the face shape at hand were to be intended to convey positive feelings or affection. (Paras. 41-45).

Moreover, average consumers accord confectionery and pastry goods only fleeting attention. The same is true in the sectors of preparations made from cereals, jellies and ices, and particularly true of ice lollies (Para. 46).

It is not widely known that “preserved, frozen, dried and cooked fruits and vegetables; milk products” in Class 29 are also offered with a variety of decorative elements, let alone ornaments as elaborate as faces and other anthropomorphic or zoomorphic elements, contrary to what the BoA essentially stated. Liquid or creamy milk products, such as yoghurts, cannot take such a shape. Preserved, frozen, dried and cooked fruits and vegetables are usually packaged and presented in their natural form, chopped, as coulis or in classic or functional geometric shapes, such as cubes, discs, pebbles, tiles, balls or coils. The exceptional nature of the habits in the sectors concerned involving presenting those goods in the shape of the mark applied for renders that mark capable of indicating the commercial origin (Paras. 56-60).

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law



### Case T-244/14; The Smiley Company SPRL v OHIM; Judgment of 7 October 2015; Language of the case: EN

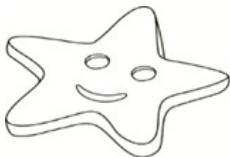
**RESULT:** Action partially upheld (BoA decision partially annulled)

**KEYWORDS:** Shape of the product, Three dimensional mark, Minimum degree of distinctiveness, Nature of the goods and services

**FACTS:** The CTM applicant sought to register the three-dimensional sign above for goods in Classes 29 and 30. The examiner rejected the application. The First Board of Appeal (BoA) dismissed the appeal.

The CTM applicant filed an application before the General Court (GC) for the annulment of the decision of the BoA.

#### CTMA



**SUBSTANCE:** The criteria for assessing the distinctive character of three-dimensional marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade

mark. Nonetheless average consumers are not in the habit of making assumptions about the origin of goods on the basis of their shape or the shape of their packaging in the absence of any graphic or word element. Only a mark which departs significantly from the norm or customs of the sector is not devoid of any distinctive character (Paras. 32-34).

The onus is on the CTM applicant to provide specific and substantiated evidence that the trade mark applied for has distinctive character, since it is much better placed to do so, given its thorough knowledge of the market (Para. 36).

In relation to “jellies” in Class 29 and “preparations made from cereals, pastry, confectionery, ices” in Class 30, consumers who are used to a very wide variety of goods such as the ones at issue, and the shapes and decorations of such goods, will perceive the constituent elements of the mark applied for taken individually and the shape created taken as a whole as possible — or even common — variants of the presentation and decoration of those goods. This is true even if the face shape at hand were to be intended to convey positive feelings or affection. (Paras. 41-45).

Moreover, average consumers accord confectionery and pastry goods only fleeting attention. The same is true in the sectors of preparations made from cereals, jellies and ices, and particularly true of ice lollies (Para. 46).

It is not widely known that “preserved, frozen, dried and cooked fruits and vegetables; milk products” in

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law

Class 29 are also offered with a variety of decorative elements, let alone ornaments as elaborate as faces and other anthropomorphic or zoomorphic elements, contrary to what the BoA essentially stated. Liquid or creamy milk products, such as yoghurts, cannot take such a shape. Preserved, frozen, dried and cooked fruits and vegetables are usually packaged and presented in their natural form, chopped, as coulis or in classic or functional geometric shapes, such as cubes, discs, pebbles, tiles, balls or coils. The exceptional nature of the habits in the sectors concerned involving presenting those goods in the shape of the mark applied for renders that mark capable of indicating the commercial origin (Paras. 56-60).

**Case T-292/14; Republic of Cyprus v OHIM; Judgment of 7 October 2015; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Minimum degree of distinctiveness, Descriptive element

**FACTS:** The CTM applicant sought to register the sign below for "Cheese; milk and milk products" in Class 29. The examiner rejected the application. The Board of Appeal (BoA) dismissed the appeal. The CTM applicant filed an application before the General Court (GC) for the annulment of the decision of the BoA.



### CTMA

**XΑΛΛΟΥΜΙ**

**SUBSTANCE:** The finding of the BoA that the words "HALLOUMI" and "ΧΑΛΛΟΥΜΙ", in capital letters, refer to a speciality cheese from Cyprus and therefore directly describe, for the Cypriot public, the kind and geographical origin of the cheese, milk and milk products applied for must be upheld (Paras. 20-21). Certification marks could be registered as Community trade marks provided that there were no absolute grounds, within the meaning of Article 7 (1) of Regulation No 207/2009, preventing their registration. The applicant's argument that the BoA failed to mention that Regulation No 207/2009 did not preclude the registration of certification marks must, in any event, be rejected (Para. 34).

The fact that the applicant has been the proprietor of identical certification marks since 1992 has no bearing on the descriptive character of the signs at issue (Para. 43). Even if some Cypriot consumers have for several years been perceiving the signs at issue as certification marks guaranteeing compliance with a specific set of legal requirements, that perception does not affect the descriptive character, for the purpose of Article 7 (1) (c) of Regulation No 207/2009, of the marks at issue for those consumers or, a fortiori, for other consumers, who do not make the connection with the certification mark (Para. 46).

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



**DESIGNEUROPA awards**

■ Applications now open

## Case law

The general interest or public interest in keeping descriptive marks free for third parties to use is pre-established and presumed. It follows that, where the mark applied for is descriptive, it is sufficient for the BoA to make the finding of that descriptive character without, however, having to examine the question whether, notwithstanding its descriptive character, there is in fact a public interest in keeping the mark applied for free for third parties to use (Para. 55).

**Case T-293/14; Republic of Cyprus v. OHIM; Judgment of 7 October 2015; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Minimum degree of distinctiveness, Descriptive element

**FACTS:** The CTM applicant sought to register the sign below for "Cheese; milk and milk products" in Classes 29. The examiner rejected the application. The Board of Appeal (BoA) dismissed the appeal. The CTM applicant filed an application before the General Court (GC) for the annulment of the decision of the BoA.

**SUBSTANCE:** The finding of the BoA that the words "HALLOUMI" and "ΧΑΛΛΟΥΜΙ", in capital letters, refer to a speciality cheese from Cyprus and therefore



CTMA

**HALLOUMI**

directly describe, for the Cypriot public, the kind and geographical origin of the cheese, milk and milk products applied for must be upheld (Paras. 20-21). Certification marks could be registered as Community trade marks provided that there were no absolute grounds, within the meaning of Article 7 (1) of Regulation No 207/2009, preventing their registration. The applicant's argument that the Board of Appeal failed to mention that Regulation No 207/2009 did not preclude the registration of certification marks must, in any event, be rejected (Para. 34).

The fact that the applicant has been the proprietor of identical certification marks since 1992 has no bearing on the descriptive character of the signs at issue (Para. 43). Even if some Cypriot consumers have for several years been perceiving the signs at issue as certification marks guaranteeing compliance with a specific set of legal requirements, that perception does not affect the descriptive character, for the purpose of Article 7 (1) (c) of Regulation No 207/2009, of the marks at issue for those consumers or, a fortiori, for other consumers, who do not make the connection with the certification mark (Para. 46). The general interest or public interest in keeping descriptive marks free for third parties to use is pre-

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



**DESIGNEUROPA awards**

■ Applications now open

## Case law

established and presumed. It follows that, where the mark applied for is descriptive, it is sufficient for the Board of Appeal to make the finding of that descriptive character without, however, having to examine the question whether, notwithstanding its descriptive character, there is in fact a public interest in keeping the mark applied for free for third parties to use (Para. 55).

**Case T-431/14; Volkswagen AG v OHIM; Judgment of 22 October 2015; Language of the case: DE**

**RESULT:** Appeal dismissed

**KEYWORDS:** Distinctive element, Specialised public, Quality of the goods and services, Laudatory mark

**FACTS:** The applicant sought to register the word mark CHOICE as a CTM for goods and services in Classes 12, 28, 35 and 37. The examiner refused the application in its entirety, based on Article 7 (1) (b) and (c) CTMR. The Board of Appeal (BoA) dismissed the appeal on account of Article 7 (1) (b) and stated that the CTMA lacked distinctiveness due to its laudatory character. The CTM applicant filed an action before the General Court (GC), claiming a violation of Article 7 (1) (b) CTMR.



### CTMA

#### CHOICE

**SUBSTANCE:** The GC confirmed that the goods and services in question are addressed to general consumers as well as to a specialised public. Despite the fact that a specialised public generally has a higher degree of attention, the attention can nevertheless be relatively low with regard to promotional statements, if they are not decisive for the specialised public (Para. 20). As the sign in question consists of an English word, the meaning is to be determined with regard to the English speaking public (Para. 21). “CHOICE” can be understood as an adjective (“worthy of being chosen”, “select”, “exquisite”, “of picked quality”) or as a noun (“Selection”, “preferential determination between things proposed”). The term can either be understood as referring to the superior quality of the products or as indicating that the purchase of these products is a good consumer choice (Para. 23). In both understandings “CHOICE” is of laudatory character. It immediately suggests to the consumers that the products have additional, positive features to the ones usually to be expected from comparable products (Paras. 28-30). The fact that the CTMA might not be descriptive (Article 7 (1) (c) CTMR) is irrelevant, as the BoA based the rejection exclusively on a lack of distinctiveness of the CTMA (Article 7 (1) (b) CTMR) (Paras. 37-38). Based on the foregoing, the action was dismissed.

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law



**Case T-822/14; Geilenkothen Fabrik für Schutzkleidung GmbH v OHIM, Judgment of 23 October 2015, Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive element, Specialised public

**FACTS:** The applicant sought to register the word mark Cottonfeel for the goods “protective clothing for rescue services, care services and disaster protection” in Class 9. The examiner refused to register the word as a CTM on the ground that it indicates the comfort offered by the protective clothing, namely to feel like cotton. The Board of Appeal (BoA) dismissed the applicant’s appeal, and so did the General Court (GC).

CTMA

**Cottonfeel**

**SUBSTANCE:** INFRINGEMENT OF ARTICLE 7 (1) (c) CTMR: The goods are directed at professionals with a high degree of attention. For the purpose of the assessment, the relevant public consist of the English speaking part of the EU (Para. 21). “Cottonfeel”, a simple juxtaposition of two easy to understand terms combined in accordance with rules of syntax and grammar (Para. 34), will be understood as a reference to the protective

clothing’s material, which is similar to cotton and feels like it (Para. 26). Contrary to the applicant’s claim, the BoA did not base its finding on the fact that the protective clothing is actually made from cotton, which, incidentally, could be the case as shown by the applicants’s own website offering protective clothing made from cotton (Para. 27). Protective clothing is worn instead of or complementary to normal clothing and must thus be equally comfortable and ergonomically, which is important during emergency operations which may last hours or even days (Para. 29).

**Case T-21/14; NetMed Sàrl v OHIM; Judgment of 29 October 2015; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Proof of use, Likelihood of confusion, Evidence of use, Extent of use, Specialised public, Purpose of the goods and services, Similarity of the signs, Coexistence of trade marks

**FACTS:** The CTM applicant sought to register the word mark SANDTER 1953 for goods in Classes 3, 5 and 10. An opposition was filed on the grounds of Article 8 (1) (b) CTMR, based on the earlier German word mark SANDER, registered for goods in Classes 5, 10 and 25. Upon request of the CTM applicant, the owner of the earlier mark provided evidence to prove genuine use of its mark. The

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office’s Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges’ symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



**DESIGNEUROPA awards**

■ Applications now open

## Case law



Opposition Division (OD) found genuine use proven for “Fingerlinge” “[rubber protection for fingers] for medical purposes”, belonging to the category of “bandages” in Class 10. The signs were held to be confusingly similar and, consequently, the CTMA was partly rejected for the goods deemed to be similar/identical to “bandages”. The Board of Appeal (BoA) confirmed the OD decision.

The CTMA applicant filed an Application before the General Court (GC), claiming infringement of Article 42 CTMR and Article 8 (1) (b) CTMR.

CTMA

**SANDTER 1953**

Earlier mar

**SANDER**

**SUBSTANCE:** With regard to the extent of use, the opponent has - amongst others - provided 20 invoices documenting the sale of up to 10000 “Fingerlinge” to four different companies during the relevant period. The fact that the prices were blackened in the invoices (thus not conveying any information about the actual turnover) is not decisive, as the further material (product packaging, price lists, witness statement) allows the safe conclusion that the use was not merely symbolic and the owner of the earlier mark seriously aimed

to acquire a commercial position in the market (Paras. 29-34). It is also irrelevant that “Fingerlinge” are cheap, mass consumption products with low revenues, as proof of use is not about evaluating the commercial success or the business strategy of a company. A de minimis rule with regard to the extent of use cannot be established (Paras. 35-38). Even though “Fingerlinge” are mainly used for risk prevention and not as sanitary/first-aid products, the “medical purpose” (Class 10) has to be interpreted broadly (Paras. 39-46). The applicant’s claim that “Fingerlinge”, if used in the medical field, are required by law to display a “CE-certification” (which in the present case was undisputedly not the case) might be true but mixes up two sets of different rules. Rules about the safety of medical equipment have different aims and purposes than the Nice classification (Paras. 47-50). Finally, “Fingerlinge” form part of the general term “bandages” and are not completely different products, as claimed by the applicant. Both can serve to cover and protect injured body parts, they address the same public, have the same functioning methods and are classified in the same class (Paras. 54-59). It follows that the first plea of law must be dismissed.

With regard to Article 8 (1) (b) CTMR, the applicant’s claim is to be rejected that the goods at issue in the medical field (Class 10) are obviously exclusively addressed to a specialized, highly attentive public. Certain medical goods, and particularly “bandages” are also bought by the general public with an average degree of attentiveness and are available

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
 ■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office’s Strategic Plan 2020  
 ■ DesignEuropa Awards: celebrating design in the EU  
 ■ Ninth judges’ symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
 ■ New decisions from the Boards of Appeal



**DESIGNEUROPA awards**

■ Applications now open

## Case law



not only in pharmacies, but also in drugs stores or department stores (e.g. blood pressure equipment) (Paras. 71-73). "Bandages" are similar to "Fist-aid kits", "Plasters" "disinfectants" etc., as they are either contained in these kits or are used with the same purpose of health protection/treatment of diseases (Paras. 80-85).

With regard to the similarity of signs, the BoA's assessment of a low distinctiveness of the element "1953" is to be confirmed. Four-digit numbers, which begin with 20, 19, 18..., will usually be perceived as a reference to a year (in particular to the founding year of the company), if they are used in connection with other elements such as a company name and are positioned behind the company name (Paras. 91-96). Overall, the signs are confusingly similar. This is not put into question by the claimed peaceful co-existence of the marks, as it was not sufficiently demonstrated how the public was confronted with the marks at issue and for which goods the marks were used (Paras. 101-103).

Based on the foregoing, the action was dismissed.

**Case T-223/14; Ewald Dörken AG v OHIM; Judgment of 25 November 2015; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Specialised public, Descriptive element, Burden of proof

**FACTS:** Upon request, the Cancellation Division (CD) declared the CTM VENT ROLL (applied for in 2004; registered in 2005) invalid for goods in Classes 6, 17 and 19, as the trade mark was deemed descriptive ("ventilation roll") and non-distinctive for the goods at issue. The Board of Appeal (BoA) confirmed the decision.

The applicant filed an action before the General Court (GC), claiming a violation of Article 7 (1) (b) (c) as well as a violation of Article 76 CTMR in several respects.

CTM

**VENT ROLL**

**SUBSTANCE:** At the outset, the GC confirmed that the relevant public consists of English speaking specialists in the field of construction (Para. 26). The GC went on affirming that "Vent" in combination with "Roll" has a descriptive connotation, as the neologism "VENT ROLL" describes possible characteristics of the goods (air permeability; ridges produced in the form of rolls). The fact that the relevant public would not use the term "VENT ROLL" to qualify air permeable ridges, but rather "Ridge Vent" or "Roll Ridge Vent", does not alter this finding. It is sufficient that a sign may in the future serve to describe possible characteristics of the goods. In this respect it is also irrelevant that the descriptiveness of the trade mark could not be proven with certainty

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



**DESIGNEUROPA awards**

■ Applications now open

## Case law



for the time of application (2004) but only for a later point in time (a dictionary excerpt from 2011 was provided). A rejection according to Article 7 (1) (c) CTMR is not dependent on the condition that the trade mark was actually used descriptively at the time of application. Besides, the inclusion of expressions into dictionaries is usually the consequence of frequent prior use of the expression over a longer period of time (Paras. 38-41).

With regard to the applicant's claim of a violation of Article 76 CTMR (burden of proof for the meaning of "VENT ROLL" in 2004 for the cancellation applicant): The presumption of validity of a registered mark cannot prevent the Office from taking into account well-known facts, which have not been dealt with by the Cancellation Division (Paras. 58-61)

Based on the foregoing, the action was dismissed.

**Case T-181/14; Nürburgring GmbH v OHIM; Judgment of 26 November 2015; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Likelihood of confusion, Visual similarity, Phonetic similarity, Conceptual similarity, Distinctive element, Dominant element, Common element

**FACTS:** The CTM applicant sought to register the word mark Nordschleife for goods and services in

- amongst others - Classes 9, 16, 25, 28 and 41. The opponent filed an opposition based on the earlier German trade mark Management by Nordschleife, registered for identical and similar goods. The opposition was based on Article 8 (1) (b) CTMR and directed against all the goods and services of the CTMA.

The Opposition Division (OD) found likelihood of confusion (LOC) with respect to all identical/similar goods and services.

The Board of Appeal (BoA) dismissed the appeal and found LOC as well. It found the signs to be visually and aurally similar at least to an average degree. Conceptually, the comparison could -at best- be considered neutral. The BoA further held that the element "Management by" of the earlier mark was only of reduced distinctiveness, while the -fully distinctive - element "Nordschleife" dominated the earlier sign.

The CTM applicant filed an application to the General Court (GC), based on a claimed violation of Article 8 (1) (b) CTMR, requesting the annulment of the BoA's decision.

<b>CTMA</b>
<b>Nordschleife</b>
<b>Earlier mark</b>
<b>Management by Nordschleife</b>

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
 ■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
 ■ DesignEuropa Awards: celebrating design in the EU  
 ■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
 ■ New decisions from the Boards of Appeal



**DESIGNEUROPA awards**  
 ■ Applications now open



## Case law



**SUBSTANCE:** The GC confirmed the BoA's reasoning that "Nordschleife" is the dominant element of the earlier mark. The basic English word "Management" will be understood by the relevant German public as referring to a way of organizing/administering, the further element "by" points towards the entity, which is responsible for the organisation/administration - in the present case "Nordschleife". Therefore, "Management by" will be understood as a general reference to the origin of the respective goods and services and to the responsibility for their production or rendering. The distinctiveness of these elements is therefore limited in comparison to the further element "Nordschleife", which dominates the earlier sign (Paras. 31-36).

With regard to the visual and aural comparison, the BoA was right to assume (at least) an average degree of similarity. The signs coincide in their most distinctive element "Nordschleife", which is the only element of the CTMA. The fact that the CTMA is fully incorporated into the earlier mark and that this element is the most distinctive element of the earlier mark suffices to conclude an average degree of visual and aural similarity (Paras. 49-62). Conceptually, the signs - due to the identity in the most distinctive element "Nordschleife" - share at least a low degree of similarity, regardless of whether the relevant public associates a special management method with the earlier sign or not (Paras. 64-70). In light of an average visual/aural degree of similarity, a low conceptual similarity, identity and similarity of the goods and services

and a normal degree of distinctiveness of the earlier mark as a whole, the BoA was right to conclude a likelihood of confusion (Paras. 71-78). Based on the foregoing, the action was dismissed.

**Case T-718/14; Hong Kong Group Oy v OHIM; Judgment of 30 November 2015; Language of the case: EN**

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

**KEYWORDS:** Dissimilarity of signs, Distinctive element, Dominant element, Figurative element, Figurative trade mark, Likelihood of confusion

**FACTS:** The applicant sought to register the figurative mark depicted below for inter alia goods in Classes 25 and 35. An opposition was filed based on the earlier Community word mark WE, registered for goods and services in Classes 25 and 35. The grounds for the opposition were based on Article 8 (1) (b) CTMR. The Opposition Division (OD) upheld the opposition in its entirety. The applicant filled an appeal against the OD's decision which was dismissed by the Second Board of Appeal (BoA). It found that the goods in Class 25 and the services in Class 35, limited to those to which the opposition relates, covered by the mark applied for and the goods in Class 25 and the services in Class 35 covered by the earlier mark were identical and similar respectively. Furthermore, it found that the

## First Page

■ March 23, 2016 - from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



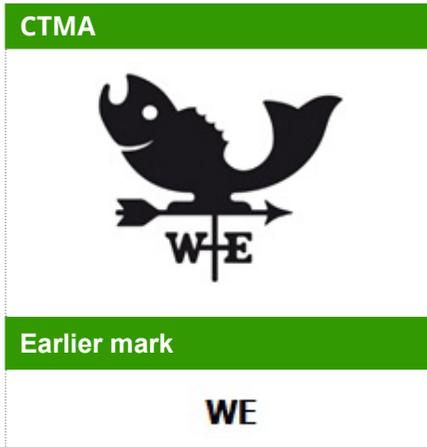
DESIGNEUROPA awards

■ Applications now open

## Case law



signs at issue were visually and phonetically similar and that it is possible that, for a part of the Spanish-speaking public, they were also conceptually similar, concluding that there was a likelihood of confusion within the meaning of Article 8 (1) (b) CTMR. The applicant filed an appeal to the General Court (GC).



**SUBSTANCE:** The applicant relied on one single plea in law, alleging the infringement of Article 8 (1) (b) CTMR.

The applicant submits that the BoA erred in concluding that the services in Class 35 covered by the mark applied for and the services in Class 35 covered by the earlier mark were similar. Secondly, the BoA erred in concluding that the signs at issue were similar. Thirdly, the applicant submits that, in the present case, there is no likelihood of confusion (Para. 22).

With regard to the dominant element of the mark applied for, the GC stated that the elements “w” and “e”, together with the figurative element, form a unit having a different meaning as compared with the meaning of those elements taken separately (Para. 43). Therefore, it found that although the verbal elements cannot be regarded as negligible in the overall impression created by the mark applied for, the dominant element of the mark is its figurative element (Para. 45).

When assessing the visual comparison of the signs, the GC pointed out that the structures of the signs at issue are very different since the mark applied for is a figurative mark in which the figurative element is the dominant element, while the earlier mark is a verbal mark consisting only of the word “we” (Para. 48). Also, the fact that the earlier mark and the mark applied for contain the letters “w” and “e” is not in itself sufficient to justify the conclusion that the conflicting signs are visually similar (para. 49). In this light, the GC found that the signs were visually dissimilar (Para. 51).

In the phonetic comparison of the signs, the letters “w” and “e” of the mark applied for will not be perceived by the relevant public as composing a word, but as two individual letters, separated by the axis of the weather vane (Para. 54). Also, it found that the relevant public could refer to the letters as “west” and “east”, in reference to the cardinal points they represent (Para. 56). Therefore, the GC found the signs to be phonetically dissimilar (Para. 57). In the conceptual comparison of the signs at issue,

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
 ■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office’s Strategic Plan 2020  
 ■ DesignEuropa Awards: celebrating design in the EU  
 ■ Ninth judges’ symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
 ■ New decisions from the Boards of Appeal

 **DESIGNEUROPA awards**  
 ■ Applications now open

## Case law



the GC found that the mark applied for taken as a whole, would be understood by the Spanish-speaking public as referring to a weather vane, and would understand the elements “w” and “e” as the cardinal points for east and west. Also, it found that the relevant public would not perceive the verbal elements of the mark applied for as constituting a word (Para. 60). In this light the GC found that the signs are conceptually dissimilar overall (Para. 61) concluding that the signs at issue are dissimilar overall (Para. 62).

In light of the above, the GC found that there was no likelihood of confusion since there was no similarity of the signs at issue and therefore there was no need to examine the similarity of the goods and services at issue (Para. 64).

**Case T-525/14; Compagnie générale des établissements Michelin v OHIM; Judgment of 8 December 2015; Language of the case: EN**

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

**KEYWORDS:** Likelihood of confusion, Visual similarity, Phonetic similarity, Distinctive element, Common element, Dominant element, Laudatory mark

**FACTS:** The CTM applicant sought to register the figurative mark XKing for goods in Classes 12 (tyres). The opponent filed an opposition based on,

amongst others, the earlier figurative French mark X, registered for identical and very similar goods in Class 12. The opposition was based on Article 8 (1) (b) CTMR and Article 8 (5) CTMR and directed against all goods of the CTMA.

The Opposition Division (OD) upheld the opposition and found likelihood of confusion (LOC) pursuant to Article 8(1) (b) CTMR.

The Board of Appeal (BoA) found the appeal to be well founded, annulled the OD decision and rejected the opposition in its entirety. It found the element “King” of the contested CTMA - in the particular context with the letter “X” - to be distinctive and not laudatory, as no such thing as a “King/best of X” exists. The signs were considered visually similar only to a low degree and phonetically similar to a degree below average. As single letters do not convey a concept, the marks were deemed not to present any conceptual similarities. The opponent could not sufficiently prove enhanced distinctiveness, the inherent distinctiveness of the earlier mark was considered low, as single letters are frequently used in the tyre industry to denote characteristics of the goods. In light of differing stylizations of the letter “X” and the previously mentioned factors, the BoA found no LOC. Article 8 (5) CTMR was discarded, as the evidence could not satisfactorily prove reputation of the earlier mark.

The owner of the earlier mark filed an application to the General Court (GC), based on a claimed violation of Article 8 (1)(b) CTMR and Article 8 (5) CTMR and requested the annulment of the BoA’s decision.

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office’s Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges’ symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law



### CTMA

**XKING**

### Earlier mark

**X** *et al.*

**SUBSTANCE:** With regard to the distinctiveness of the element “KING” of the CTMA the GC stated – contrary to what the BoA had held - that this basic English word will be perceived by the French public as meaning “king” or “the best”, and thus, as a laudatory term for the goods in question. The fact that “X” has no meaning will not prevent consumers from perceiving that laudatory message. It follows that, contrary to what was held by the BoA, the word “king” in the CTMA is weakly distinctive and the letter “X” will be perceived as the dominant element of the CTMA (Paras. 32-34).

With regard to the visual comparison, the letter “X” as the dominant element of the CTMA carries more weight than the further element “KING” – although this further element is not negligible. The letters “X” in both marks are both white and outlined in black and therefore similar. Overall, there is an average – not only low - degree of visual similarity (Paras. 37-

44). Since the marks at issue share the same first syllable, the marks are phonetically similar to an average – not below average – degree. As the earlier mark “X” has no meaning, a conceptual comparison is not possible (Paras. 46-51).

Contrary to what the BoA has held, the inherent distinctiveness of the earlier mark “X” must be deemed as normal, and not merely low. Although it is true that letters are often displayed on tyres to designate a characteristic of tyres [e.g. “r” (radial tyre); “v” (speed) etc.], it is not apparent from the evidence that the letter “x” designates a characteristic of tyres. In addition, the letter “X” of the earlier mark is not a standard letter “X”. It is white and has a double outline in black. Accordingly, that stylized letter will not be perceived as designating a characteristic of the goods at issue (Para. 55).

In light of the identity/similarity of goods, the average degree of similarity between the marks and the normal inherent distinctiveness of the earlier mark, there is LOC, even if the relevant public’s attentiveness is high. Consequently, the BoA was wrong to conclude no LOC (Paras 57, 58). Based on the foregoing, the BoA decision was annulled.

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
 ■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office’s Strategic Plan 2020  
 ■ DesignEuropa Awards: celebrating design in the EU  
 ■ Ninth judges’ symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
 ■ New decisions from the Boards of Appeal

 **DESIGNEUROPA awards**  
 ■ Applications now open

## Case law



**Case T-624/14; Bice international Ltd v OHIM; Judgment of 17 December 2015; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Proof of use, Extent of use, Place of use, Sales figures, Declaration, Nature of the goods and services, Lack of reasoning, Admissibility

**FACTS:** The owner of the earlier figurative Spanish trade mark Bice (as displayed underneath) in Class 42 filed a request for invalidity (Article 53 (1) (a) / Article 8 (1) (b) CTMR) against the CTM bice (word mark, registered for goods in Classes 29, 30 and 43). Upon request of the owner of the contested CTM, the owner of the earlier Spanish mark provided evidence of genuine use.

The Cancellation Division (CD) rejected the invalidity request in its entirety as it deemed genuine use of the earlier mark not proven. This decision was confirmed by the Board of Appeal (BoA), which emphasized the limited geographic expansion of use (in one single restaurant in Madrid only) and the lack of solid evidence with regard to the extent of use.

The CTM owner filed an application to the General Court (GC), requesting the annulment of the BoA's decision. The application was based on one plea of law, namely a claimed infringement of Article 57 (2) (3) CTMR /Article 42 (2) CTMR. In the oral hearing, the applicant raised a second plea of law, namely a violation of Article 75 CTMR (duty to state reasons).

CTM

bice

Earlier mark



**SUBSTANCE:** With regard to the claimed violation of Art. 75 CTMR (duty to state reasons), which was raised for the first time during the oral hearing, the GC refrained from examining the admissibility of the plea of law, but held that the BoA had in any event sufficiently explained why it deemed the proof of use insufficient, namely because of a very limited geographical dimension of use in conjunction with a marginal extent of use (Paras. 22-30).

With regard to the claimed violation of Article 42 CTMR, the GC confirmed that a statutory declaration of the General Manager of the applicant, which furthermore only contained very vague and unspecified explanations regarding the extent of use, is no sufficient evidence on its own to prove genuine use, but must rather be corroborated by further documentation (Paras. 54-59). The GC considered that the only reliable evidence to prove

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
 ■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
 ■ DesignEuropa Awards: celebrating design in the EU  
 ■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
 ■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law

the extent of use of the earlier mark consisted of 19 invoices for restaurant services in one establishment over a period of 6 years, displaying a total turnover of 14 278 EUR. In light of the nature of restaurant services (being everyday services) the proven extent of use was deemed insignificant (Paras. 69-74). Furthermore, the applicant could not demonstrate a geographical dimension of use of its mark beyond one single restaurant in Madrid. As a finding of genuine use cannot be based on presumptions and suppositions, the BoA was right to reject the proof of use as insufficient (Paras. 82-85).

Based on the foregoing the action was dismissed.

**Case T-647/14; Infusion Brands, Inc. v OHIM; Judgment of 3 December 2015; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Figurative trade mark, Figurative element, Descriptive element, Principle of legality

**FACTS:** The applicant sought to register the figurative mark for goods and services in Classes 7, 8 and 35. The Examination Division's decision, partially rejecting the CTM application based on Article 7 (1) (b) and (c) and 7 (2) CTMR, was confirmed by the Boards of Appeal (BoA). The applicant appealed to the General Court (GC).



CTMA

DUALSAW

**SUBSTANCE:** The GC dismissed both pleas, on which the action was based, namely the alleged infringement of Article 7 (1) (b) and (c) CTMR.

ON ARTICLE 7 (1) (c) CTMR: BoA was right that both words "DUAL" and "SAW" must be regarded as common, everyday words which may be understood by every English speaker. The mark as a whole covers specific cutting tools having a twofold, or double, character or nature. The services in Class 35 are merely wholesaling and retailing services in respect of the same goods (Paras. 22-23). The figurative elements and colour of the CTMA are in no way fanciful or arbitrary. The mark is completely unambiguous and contains no hidden meaning which could diminish the clearly descriptive message conveyed (Para. 24). Although the sign consists of a single word element, the English-speaking public will immediately break it down into two words that it knows, helped by the fact that "dual" and "tools" appear in different colours. Moreover, those words are common, everyday words, which are easily understood by the English-speaking public (Para. 27). The argument that the sign applied for has a very highly figurative component which determines its overall impression and dominates the mark applied for as a whole is rejected (Para. 31). The examination must be undertaken in each

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law



individual case. The registration of a sign as a mark depends on specific criteria, which are applicable in the factual circumstances of the particular case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal (para. 33). The argument relating to the registration by the United States Patent and Trademark Office of the figurative mark DUALSAW for several identical goods in the USA with no objection is rejected (Para. 35). The CTM regime is an autonomous legal system which pursues objectives peculiar to it. It applies independently of any national system. The Office and, as the case may be, the EU judicature are not bound by a decision given in a Member State, or indeed a third country, that the sign in question is registrable as a national mark. That is so even if such a decision was adopted in a country belonging to the linguistic area in which the word mark in question originated (Para. 36).

ON ARTICLE 7 (1) (b) CTMR: As is clear from Article 7 (1) CTMR, it is sufficient that one of the absolute grounds for refusal listed in that provision applies in order for the sign not to be registrable as a CTM. Consequently, there is no need to examine the substance of Article 7 (1) (b) CTMR (Paras. 39-40).

**Case T-648/14; Infusion Brands, Inc. v OHIM; Judgment of 3 December 2015; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Figurative trade mark, Figurative element, Descriptive element, Principle of legality

**FACTS:** The applicant sought to register the figurative mark for goods and services in Classes 7, 8 and 35. The Examination Division's decision, partially rejecting the CTM application based on Article 7 (1) (b) and (c) and 7 (2) CTMR, was confirmed by the Boards of Appeal (BoA). The applicant appealed to the General Court (GC).



**SUBSTANCE:** The GC dismissed both pleas on which the action was based, the alleged infringement of Article 7 (1) (b) and (c) CTMR.

ON ARTICLE 7 (1) (c) CTMR: BoA was right that both words "DUAL" and "TOOL" must be regarded as common, everyday words which may be understood by every English speaker. The mark as a whole covers tools having a twofold, or double, character or nature. The services in class 35 are merely wholesaling and retailing services in respect of the same goods (Paras. 22-23). The figurative elements and colour of the CTMA are in no way fanciful or arbitrary. The mark is completely unambiguous and contains no hidden meaning which could diminish the clearly descriptive message conveyed (Para. 24). Although the sign consists of a single word element, the English-speaking public will immediately break

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



## Case law



it down into two words that it knows, helped by the fact that “dual” and “tools” appear in different colours. Moreover, those words are common, everyday words, which are easily understood by the English-speaking public (Para. 27). The argument that the sign applied for has a very highly figurative component which determines its overall impression and dominates the mark applied for as a whole is rejected (Para.31). The examination must be undertaken in each individual case. The registration of a sign as a mark depends on specific criteria, which are applicable in the factual circumstances of the particular case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal (Para. 33). The argument relating to the registration by the United States Patent and Trademark Office of the figurative mark DUALTOOLS for several identical goods in the USA with no objection is rejected (Para. 35). The CTM regime is an autonomous legal system which pursues objectives peculiar to it. It applies independently of any national system. The Office and, as the case may be, the EU judicature are not bound by a decision given in a Member State, or indeed a third country, that the sign in question is registrable as a national mark. That is so even if such a decision was adopted in a country belonging to the linguistic area in which the word mark in question originated (Para. 36).

ON ARTICLE 7 (1) (b) CTMR: As is clear from Article 7 (1) CTMR, it is sufficient that one of the absolute grounds for refusal listed in that provision applies in order for the sign not to be registrable as a CTM.

Consequently, there is no need to examine the substance of Article 7 (1) (b) CTMR (Paras. 39-40).

**Case T-558/14; Research Engineering & Manufacturing, Inc. v OHIM; Judgment of 18 November 2015; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive element, Specialised public, Quality of the goods and service, Descriptive element, Nature of the goods and services

**FACTS:** The applicant sought to cancel the word mark TRILOBULAR for goods in Class 6. The Cancellation Division's decision, rejecting the application for invalidity pursuant to Article 52 (1) (a) in relation to Articles 7 (1) (b) and (c) CTMR, was annulled by the Boards of Appeal (BoA) and the contested CTM was declared invalid. The applicant appealed to the General Court (GC).

CTM

TRILOBULAR

**SUBSTANCE:** The single plea in law, based on the infringement of Article 7 (1) (c) CTMR was dismissed by the GC.

Although, the goods in question, “metal threaded fasteners”, are intended for professionals and

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open



## Case law



general consumers, the former represent a larger part of the relevant public than the latter, in so far as they use those goods on a daily basis and those goods are a necessary part of the normal and regular course of their professional activity (Para. 20). Therefore, the Office is entitled to take account of the presence, within the general public, of a narrower class, composed of persons to whom the goods or services covered by the mark for which registration is sought are particularly intended (Para. 23). TRILOBULAR could be understood not only by German-speaking professionals but also professionals from other Member States as describing the fact that the screw is made up of three lobes, and thus describes a quality or characteristic, which is, moreover fundamental, of those goods (Para. 32). Even assuming that the general public pays a normal level of attention when purchasing the goods in question, the specialist public may demonstrate a higher level of attention when buying large quantities of such products which might prove to be unusable, if not properly selected (Para. 37). The evidence put forward in support of the application for a declaration of invalidity establishes that, as early as 1982, the word “trilobular” described the nature and the technical function of the goods in question, which is a more generic expression for screws (Para. 43). Furthermore, it is not necessary that the signs and indications composing the mark that are referred to in Article 7 (1) (c) CTMR actually be in use at the time of the application for registration in a way that

is descriptive of the goods or services. It is sufficient, that such signs and indications could be used for such purposes (Para. 45). The GC clarifies that contrary to the applicant’s interpretation of Case T-256/06, “HONEYCOMB”, namely that the lack of specific meaning on the technical level of the trade mark for which registration was sought necessarily resulted in its lack of descriptive character, the lack of specific meaning in strictly technical terms was not relevant in the context of the assessment of the descriptive character. This, however, does not mean that the existence of a technical meaning cannot have as its result the existence of a descriptive character (Para. 49).

**Case T-628/14; Hewlett Packard Development Company LP v OHIM; Judgment of 3 December 2015; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive element, Purpose of the goods and services, Quality of the goods and services, Principle of legality

**FACTS:** The applicant sought the registration of the Community word mark FORTIFY for the following goods in Class 9: “software for analysing source code; software for detecting and describing vulnerabilities and associated mitigation techniques based on an analysis of source code; software for preventing hacking of or attacks on computer

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office’s Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges’ symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law



programs and software systems based on runtime analysis of software behaviour and use; computer software". The examiner refused the trade mark application in respect of all the goods concerned, on the ground that the mark applied for was descriptive and devoid of any distinctive character under Article 7 (1) (b), (c) and Article 7 (2) CTMR.

The examiner's decision was confirmed by the Second Board of Appeal (BoA) holding that the application had to be rejected in respect of all the goods in question under the absolute ground for refusal in Article 7 (1) (c) CTMR. It held that there was no need to determine whether the mark applied for had also to be refused registration under Article 7 (1) (b) CTMR. The applicant filed an action before the General Court (GC) alleging an infringement of Articles 7 (1) (b), (c) and 7 (2) CTMR.

CTMA

**FORTIFY**

**SUBSTANCE:** The GC confirmed the BoA's decision and dismissed the appeal. The GC pointed out that the BoA was correct in finding that the term "fortify" designated an intended purpose of the goods concerned, namely to strengthen or reinforce a computer system. Thus, by means of software dedicated, inter alia, to detecting vulnerabilities and preventing hacking of or attacks on computer programs and software systems, the operation or

performance of a computer system is improved and that system may be regarded as "fortified". Therefore, when faced with the goods covered by the trade mark application, the relevant public will immediately and without further reflection perceive that the word "fortify" refers to the intended purpose of those goods (Paras. 25-27).

That conclusion is not called into question by the applicant's argument that, since software does not alter computer systems, but only protect them from the outside, it is not capable of "making them stronger". Therefore, the relevant public would not directly and without further reflection establish a connection between the sign at issue and the meaning ascribed to it by the BoA, since a further mental step would be necessary (Paras. 28-29). The GC found that the distinction drawn by the applicant between fortifying a computer system through an alteration and protecting it from the outside has not been substantiated. As the Office has observed, those two actions have the same intended purpose, namely to improve in some way the operation or performance of a computer system. The fact that the interventions take place from the inside or from the outside of a computer system does not alter the fact that the sign at issue will be perceived as descriptive by the relevant public, consisting of average consumers. The further argument's of the applicant, that the fact that no descriptive use of the term "fortify" has been established in practice in relation to the goods concerned constitutes evidence that that term is not suitable for describing

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law



the goods in question, was also rejected by the GC. The GC recalled the Case-Law according to which it is not necessary that the sign actually be in use at the time of the application in a way that is descriptive of goods or of characteristics of them to be refused under Article 7 (1) (c) CTMR. It is sufficient that such signs and indications could be used for such purposes, as in the present case. Therefore, the BoA did not have to look for actual use of the sign at issue in a descriptive way and the absence of such actual use cannot be regarded as evidence that the sign at issue is not descriptive (Paras. 28-32).

Finally, the GC found that the applicant cannot successfully rely, for the purposes of casting doubt on the conclusion reached by the BoA, on the Office's previous decisions and, a fortiori, on decisions of other courts. To this aspect, it recalled that, according to the Case-Law, the application of the principles of equal treatment and sound administration must respect the law. Moreover, the BoA duly gave its reasons for not following the previous decisional practice relied on by the applicant (Paras. 33-37). As regards the second plea in law, the GC recalled that, since according to settled Case-Law, it is sufficient that one of the absolute grounds for refusal listed in Article 7 (1) CTMR applies for the sign at issue not to be registrable as a Community trade mark, there is no need to give a ruling on the substance of the alleged infringement of Article 7 (1) (b) and Article 7 (2) CTMR.

**Case T-529/14; adp Gauselmann GmbH v OHIM; Judgment of 2 December 2015; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive element

**FACTS:** The applicant sought to register the word mark Multi Win for goods and services in Classes 9, 28 and 41, related in particular to game software, games, toys, rental of game devices for casinos, lotteries. The examiner refused to register the application under Article 7 (1) (b) and (c) CTMR. The Board of Appeal (BoA) dismissed the appeal holding that the sign will be understood as multiple prize or multiple prize opportunity. The General Court confirmed the BoA decision based on Article 7 (1) (c) CTMR.

CTMA

**Multi Win**

**SUBSTANCE:** The BoA took account of English speaking visitors of amusement halls, casinos and other entertainment sites as well as professionals running such places. "Multi" can signify multiple, forming adjectives with the meaning "more than one, several, many" (Para. 29). The term "win" is common in English and refers to "to win" or "prize"

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law



(T-258/09 – BETWIN) (Para. 30). In correct English, “multi” is connected by means of a hyphen with the combined word or both are written in one word. However, the word order is correct, corresponding to terms such as “multicapital”, “multimachine” or “multi-disc”, and the difference to the correct English structure thus insufficient to give the sign a meaning which sufficiently departs from the sum of its parts (Para. 32). Given that the goods and services form a homogenous group related to entertainment, the BoA was entitled to apply the same reasoning to all of them (Paras. 33-35). “Multi Win” constitutes a promotional but sufficiently descriptive term in relation to a main characteristic of the goods and services in that it evokes the idea of a multiple prizes to be won by the gambler (Para. 36).

**Case T-321/14; Volkswagen AG v OHIM; Judgment of 10 September 2015; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive element, Function of trade mark, Legal certainty, Minimum degree of distinctiveness, Slogan mark, Specialised public, Principle of legality

**FACTS:** The applicant sought to register the word mark STREET as a CTM for the goods and services within Classes 12, 28 and 35. In accordance with Article 7 (1) (b) and 7 (1) (c) CTMR, the examiner refused to register the word as a CTM

for all the goods applied for. The Board of Appeal (BoA) dismissed the applicant’s appeal on the ground that the sign does not possess the necessary minimum degree of distinctiveness and is descriptive for all the goods and services in respect of which protection was sought. The applicant filed an action before the General Court (GC).

CTMA

STREET

**SUBSTANCE:** The GC confirmed the BoA’s analysis of the relevant public, as consisting both of the average consumer with an average level of attention and of professionals in the vehicle construction sector whose level of attention is higher due to the impact of the characteristics and the quality of the goods and services concerned on the range of items and facilities that they themselves offer. According to the Judgment, the relevant public is the English-speaking public in the European Union (Paras. 14, 15).

The GC carried out an exhaustive analysis of the goods and services for which registration was sought and ruled that the sign is descriptive for all of them (Para. 19 et seq.). The GC made reference to the Case-Law and confirmed the applicant’s argument that the registration of marks which also are used as advertising slogans, indication of quality or

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office’s Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges’ symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law



incitements to purchase the goods and services is not excluded as such by virtue of such use. However, according to the GC, this argument is not sufficient for the applicant to demonstrate the distinctive character of the sign, which is a banal English word, not capable of performing its essential function for the goods for which registration was sought (Paras. 44-46).

The GC ruled that the applicant cannot invoke the previous BoA decisions as, for reasons of legal certainty and sound administration, each trade mark application has to undergo, individually, a stringent and full examination. Moreover, contrary to what may have been the case for certain earlier applications, the present application was caught by two of the grounds for refusal of Article 7 (1) CTMR (Paras. 52-54).

**Case T-78/14; Benediktinerabtei St. Bonifaz Körperschaft des öffentlichen Rechts v OHIM; Judgment of 8 October 2015; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Likelihood of confusion, Visual similarity, Phonetic similarity, Conceptual similarity, Similarity of the signs, Dominant element, Weak element, Descriptive element, Common element, Lack of reasoning

**FACTS:** The applicant sought to register the figurative mark, shown below, inter alia for “milk and milk products” in Class 29. The opponent based an opposition on Article 8 (1) (b) CTMR, directed against said goods, relying on the earlier figurative Community mark represented below, registered for identical goods. The Opposition Division uphold the opposition because it found that there is likelihood of confusion between the CTMA and earlier Community mark. The Board of Appeal (BoA) dismissed the appeal. The applicant filed an action before the General Court (GC).

### CTMA



### Earlier marks



## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
 ■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
 ■ DesignEuropa Awards: celebrating design in the EU  
 ■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
 ■ New decisions from the Boards of Appeal



**DESIGNEUROPA awards**

■ Applications now open

## Case law



**SUBSTANCE:** INFRINGEMENT OF ARTICLES 75 AND 76 CTMR: By way of assessing the distinctive character of the CTMA's elements and referring to the relative size of "Andechs", the BoA gave sufficient reason as to why this word possesses a normal distinctive character, dominates the CTMA and

has an independent distinctive role therein (Paras. 17-23). Furthermore, as far as Article 76 CTMR is concerned, the BoA was entitled to consider it a well-known fact that the average consumer is acquainted with images or names of monks or cloisters being depicted on milk products and beverages. The BoA was not obliged under Article 75 CTMR to allow the parties to make observations on this well-known fact before rendering the decision (Paras. 24-30). INFRINGEMENT OF ARTICLE 8 (1) (b) CTMR: The relevant public consists of average consumer in the EU, paying an average attention (Para. 36). Visually, the letters "Andechs" stand out in both signs (complemented by the letters "ER" on part of the earlier mark). In addition, the signs have the word "SEIT" in common. However, the relevant public will pay little attention to it. The remaining elements are dissimilar but insufficient to counterbalance said similarity. The CTMA's scenery is decorative and common for agricultural products. The other word elements have a minor role due to their positioning and smaller size. On part of the earlier mark, only the element "NATUR" has a similar size but will be perceived as a common term in relation to foodstuffs in the EU. Overall, the signs are visually similar (Paras.

43-49). The aural similarity is higher regardless of the exact pronunciation of "Andechs(er)" (Para. 50). A conceptual comparison cannot be made for those parts of the relevant public which do not speak German (Para. 51-54). Only a minor part of the relevant public will recognize "ANDECHSER" as a term indicating a geographical origin. Moreover, there is no apparent connection between the goods and such origin. Hence, it is not descriptive (contrary to the applicant's principle claim). Overall, there is therefore a likelihood of confusion (Paras. 60-70).

**Case T-591/14; BSH Bosch und Siemens Hausgeräte GmbH v OHIM, Judgment of 25 September 2015, Language of the case: DE**

**RESULT:** Decision partially upheld (BoA decision partially annulled)

**KEYWORDS:** Descriptive element, Principle of legality, Lack of reasoning, Specialised public, Laudatory mark, Legal certainty

**FACTS:** The applicant sought to register the word mark, PerfectRoast for inter alia goods in Classes 7 and 11. Both instances refused partially registration for the above goods according to Article 7 (1) (b) and (c) CTMR. The applicant appealed before the General Court (GC) alleging infringement of Article 7 (1) (b) and (c) and of Article 75 CTMR.

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law



CTMA

### PerfectRoast

**SUBSTANCE:** Article 7 (1) (c) CTMR: The GC states as to the meaning of the applied for sign PerfectRoast that the BoA was right in saying that it could be understood as a “perfectly well elaborated roast” or in the sense of the activity of “perfectly roasting”. This meaning is obvious irrespective for the professional public as well as for the average consumers. As to the second meaning the GC stresses that the relevant consumers consist also of those who do not perfectly well understand the English language, so that they may perceive the term “roast” as substantive or as adjective as well (Para. 22).

The GC further asserts that the goods for which registration has been refused may be grouped according to the degree of the connection to the activity of roasting or the preparation of a roast (Para. 23).

The goods in Class 7 consist of kitchen apparatus for the purpose of roasting as for example raclette grills. The BoA therefore correctly found a direct link between the meaning of the sign and those goods, as the mark informs in a laudatory way that these goods may serve for preparing a perfect roast (Para. 24).

The majority of the goods in Class 11 are - as the BoA said - all kind of cooking apparatus, which might have a different degree of connection with

the activity of roasting. The GC stresses that in order to be descriptive, it is not relevant that these goods serve directly for the roasting but it may be enough that they are in a sufficiently close relation to this activity. Indeed, these goods may serve for the preparation of a roast or for maintaining it or its ingredients warm or for preparing sauces. To this extent the sign describes a characteristic of these goods in the sense that they specifically are intended to be used in the context of the preparation of a perfect roast (Paras. 25 and 26).

However, for the goods “water heaters, immersion heater and egg cooker” (Class 11) the GC finds that the situation is different. For the first two categories of goods the connection with roasts or the preparation thereof is not as strong as for the other goods mentioned in the preceding paragraphs. Also in relation with “egg cookers” which are in principle used to boil water, the contested decision did not explain to which extent there would be a specific link with the cooking or preparation of a perfect roast. Consequently, for those three categories the BoA did not correctly apply Article 7 (1) (c) CTMR (Paras. 29 to 31).

For the goods “water heaters, immersion heater and egg cooker” (Class 11) the GC found that also Article 7 (1) (b) CTMR is not applicable, since the meaning of the applied for sign does not convey a direct connection to those categories resulting in a certain originality, so that the consumers would require an interpretative effort in order to grasp any relation between the goods and the meaning of the sign (Para. 46).

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law



The applicant's plea that the BoA did infringe Article 75 CTMR by not considering the registered CTM perfectBake the GC states that indeed the Office must take into account the decisions already taken in respect of similar applications and consider with especial care whether it should decide in the same way or not. The way in which those principles are applied must, however, be consistent with respect for the principle of legality. Consequently, a person who files an application for registration of a sign as a trade mark cannot rely, to his advantage and in order to secure an identical decision, on a possibly unlawful act committed for the benefit of someone else. Moreover, for reasons of legal certainty and, indeed, of sound administration, the examination of any trade mark application must be stringent and full, in order to prevent trade marks from being improperly registered. Such an examination must therefore be undertaken in each individual case. The registration of a sign as a mark depends on specific criteria, which are applicable in the factual circumstances of the particular case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal (Paras. 65 and 57).

Moreover as the BoA correctly stated that the cases may not be directly compared and the link between the meaning of the sign and the goods is stronger for the case at hand than the other case submitted by the applicant (Paras. 51 and 58).

### **Case T-264/14; Robert Hansen v OHIM; Judgment of 23 October 2015; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive element, Principle of legality, Lack of reasoning, Laudatory mark, Well-known facts need no evidence

**FACTS:** The applicant sought to register the word mark, WIN365 for inter alia services in Classes 36 and 41. Both instances refused registration for the above services according to Article 7 (1) (b) CTMR. The applicant appealed before the General Court (GC) alleging infringement of the above provision.

CTMA

**WIN365**

**SUBSTANCE:** ARTICLE 7 (1) (b) CTMR. As a preliminary remark the GC states that the applicant's complaint that the Board of Appeal (BoA) did not sufficiently explain the meaning of the number 365 as referring to the days of a calendar year is to be refused. It is a well-known fact that this number will be perceived as a reference to all the days of one year and consequently, there was no obligation for the BoA to further explain this meaning of the number "365". Moreover, the applicant itself admitted during the administrative proceedings that the number "365" could be perceived as referring to the days of one

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



**DESIGNEUROPA awards**

■ Applications now open

## Case law



calendar year. Consequently, there is no lack in the reasoning of the contested decision (Paras. 18–22). The second element in the applied for sign, “WIN” clearly indicates the obvious relation between the services and the possibility of winning. This possibility is the reason why the consumers are interested in those services (Para. 23).

The combination “WIN365” as a whole merely makes reference to the possibility of winning every day in connection with the services in Classes 26 and 41 and consequently, the BoA was right to conclude that such a laudatory message is devoid of distinctive character (Paras. 24 and 25).

Concerning the earlier registrations at national level the GC confirms the Case-Law that the Community trade mark regime is an autonomous system with its own set of objectives and rules peculiar to it; it is self-sufficient and applies independently of any national system. Consequently, the registrability of a sign as a Community mark must be assessed by reference only to the relevant Community rules. Accordingly, the Office and, if appropriate, the Community judicature are not bound by a decision given in a Member State, or indeed a third country, that the sign in question is registrable as a national mark (Para. 30).

Concerning the earlier CTM WIN3000 (Nr. 4 919 148) the GC states that this mark is different because the number “3000” has no meaning as the number “365” in the case at hand (Para. 33).

Concerning the earlier CTM WIN365 (Nr.: 5928346) the GC agrees with the Office that this mark has

been accepted according to Article 7 (3) CTMR after showing the acquired distinctiveness in the relevant markets (Para. 34).

The GC further underlines that even if the decision in the above case would be wrong, it is has become final and may only be challenged in the framework of an invalidity action but not in the current proceedings (Para. 37).

Although, the Office must take into account the decisions already taken in respect of similar applications and consider with especial care whether it should decide in the same way or not. The way in which those principles are applied must, however, be consistent with respect for the principle of legality. Consequently, a person who files an application for registration of a sign as a trade mark cannot rely, to his advantage and in order to secure an identical decision, on a possibly unlawful act committed for the benefit of someone else.

**Case T-520/14; bd breyton-design GmbH v OHIM; Judgment of 25 November 2015; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Abbreviation, Descriptive element, Specialised public

**FACTS:** The applicant sought the registration of the CTM RACE GTP (word) for goods in Class 12.

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law



The First Instance refused the application as being descriptive and without the necessary distinctive character (Article 7 (1) (b) and (c) CTMR). The Board of Appeal upheld that decision.

CTMA

**RACE GTP**

**SUBSTANCE:** Article 7 (1) (c) CTMR: The General Court (GC) states as to the relevant public and its attention, that the goods “aluminium rims not for car races or for motor vehicles without approval for road service” (Class 12) are nowadays standard accessories of cars so that the target public are all consumers interested in cars. This category includes car fanciers, also those who like car racing and fanciers of car tuning. Moreover the goods are also directed at experts in the car market, in particular car producers and car suppliers as well as professionals in the car tuning sector (Para. 20).

The GC clarifies that even for the public with an average knowledge on cars and without being a professional the attention will be rather high than average, as claimed by the applicant. The goods will not be acquired constantly, require a certain economic effort and have an aesthetic character. With more reason will have the car fanciers and the experts in the automobile sector an even higher degree of attentiveness (Paras. 22 and 23).

With respect of the meaning of the applied for

sign and on how the public will perceive it, the GC states that the term “RACE” will be understood with respect of the goods as “sportive driving or design” and as “racing cars” in general (Para. 28).

The GC further concludes that the letters “GT” denote in the field of automobiles “Grand Tour” or “Gran Turismo”. This meaning will be understood at least by the experts in the field and since this public is not an insignificant part of the relevant consumers, it is not necessary to further examine if the other sectors of the public will also have the same understanding (Para. 29).

The abbreviation “GTP” refers - as the BoA has stated - to “Gran Turismo Prototype” and describes a certain type of racing car which has been used in a racing series in the USA between 1981 and 1993 (Para. 30).

The applicant contends that these races belong to the past and are therefore forgotten and secondly that these races were in the USA and not in the relevant market, namely the EU. The GC rejects these arguments, because those who like car races will know this racing series even if it referred to the USA. These circles are not only interested in car races within the EU but also in others held outside the Internal Market (Paras. 31 to 35).

The GC finally concludes that for those consumers who know the GTP car racing series the sign “RACE GTP” directly refers to the goods, because it informs the consumers about the technical characteristics of the rims in the sense that they share the same design of the rims used in the GTP-racing series.

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office’s Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges’ symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law



Consequently, the BoA correctly concluded that the applied for sign is descriptive (Paras. 40 to 42). The arguments of the applicant that "RACE GTP" is not the official denomination and that the abbreviation of "GTP" has many different meanings has been refused by the GC. They do not counteract the understanding of a part of the consumers that the sign directly describes the goods. The inclusion of the term "RACE" directly establishes a link to the racing series "Gran Tour Prototype" (Paras. 44 and 45).

Finally also the exclusion of racing cars in the specification of the goods does not avoid the descriptiveness of the sign. The public will still believe that the rims in the cars are inspired on the sport cars used in the GTP-racing series, which is quite common in the automobile market sector (Para. 47).

**Case T-544/14; Société des produits Nestlé SA v OHIM; Judgment of 12 November 2015; Language of the case: DE**

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

**KEYWORDS:** Grace period, Suspension of proceedings, Obvious mistake, Evidence of use, Claim for alteration of OHIM decision

**FACTS:** The CTM applicant sought to register the word mark ALETE for products in Classes 5, 29,

30 and 32. The Opposition Division upheld the opposition. The applicant appealed the decision and asked for a suspension of the proceedings invoking parallel revocation proceedings. The Board of Appeal (BoA) did not suspend the proceedings and dismissed the appeal.

The CTM applicant filed an application before the General Court (GC) for the alteration of the decision of the BoA or, in the alternative, to annul the contested decision.



**SUBSTANCE:** The fact that the genuine use of the earlier mark for a medicine for the treatment of Parkinson's disease is uncontested by the CTM Applicant in the parallel revocation proceeding does not prove genuine use of the earlier mark for the remainder of the products covered by the earlier mark and, therefore, does not constitute a factor justifying the refusal to stay the proceedings before the Office (Paras. 29-33).

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



**DESIGNEUROPA awards**  
■ Applications now open

## Case law



The BoA failed to consider several relevant elements of the case:

1. The CTM applicant claimed that it made some researches on the use of the earlier mark and that the only use it could find was for a medicine for the treatment of Parkinson's disease (Para. 36).
2. The CTM applicant put forward that the opponent was not using in a significant way its mark and that a search of the word "aleta" on the opponent's website did not show any result. Even if such arguments were developed by the CTM applicant in order to rebut the enhanced distinctiveness acquired through use of the earlier mark, the opponent did not challenge them (Para. 37).
3. When a request for the suspension of proceedings has been filed before the opponent could defend itself in the revocation proceedings, it is, by definition, hard for the CTM applicant to establish a negative fact such as the lack of genuine use (Para. 38).

It follows that the BoA committed an obvious mistake when it refused to stay the proceedings (Para. 40). The contested decision is therefore annulled without it being necessary to rule on the other pleas (Paras. 45-47).

**Case T-545/14; GEA Group AG v OHIM; Order of 6 October 2015; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Admissibility

**FACTS:** The applicant appealed the examiner's decision to refuse the application for the mark engineering for a better world under Article 7 (1) (b) CTMR. The Board of Appeal (BoA) dismissed the appeal on the same ground ("first BoA decision"). The applicant filed a second application for an identical mark and, afterwards, an action to the General Court (GC) against the first BoA decision. Regarding the second application, the examiner refused it on the basis of an assessment of Article 7 (1) (b) CTMR. Following the applicant's appeal against this second refusal, the BoA, after noting that the second application is identical to the first application, referred to the first BoA decision and reiterated it in part, by reason of which the appeal was rejected ("second BoA decision"). The applicant filed another action to the GC against the second BoA decision. Thereafter, the GC rejected the action concerning the first BoA decision by order as it was filed belatedly.

**CTMA**

**engineering for a better world**

## First Page

- March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

- Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

- Elements external to the Community design

## Statistical Highlights

- January 2016

## ETMDN Updates

- Consultation on European Cooperation Projects
- The Harmonised Database celebrates its first full year

## More News

- Public consultation on the Office's Strategic Plan 2020
- DesignEuropa Awards: celebrating design in the EU
- Ninth judges' symposium report available now

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



**DESIGNEUROPA awards**

■ Applications now open



## Case law



**SUBSTANCE:** As is recognised in Case-Law, a decision which merely confirms an earlier decision not challenged in due time is not an actionable measure. For the purpose of not allowing the time-limit for bringing an action against the confirmed decision to recommence, an action against such a confirmatory decision must be declared inadmissible. A decision is regarded as a mere confirmation of an earlier decision if it contains no new factors as compared with the earlier measure and is not preceded by any re-examination of the situation of the addressee of the earlier measure (T-188/95 – INSULATE FOR LIFE) (Paras. 15-16). The first and the second BoA decision have the same subject-matter. The latter does not assess any further issues and was not preceded by a re-examination of the applicant’s mark (Para. 19). The applicant’s new reference to the registrations of other marks, in the second set of proceedings, cannot be qualified as substantial new facts. To be of such nature, that factor must be capable of substantially altering the conditions which governed the earlier measure, such as a factor that raises doubts as to the merits of the approach adopted by that measure (Paras. 21-22). For doubts of this sort, it is insufficient that the BoA did not follow the Office’s decision-making practice because each application is to be assessed on a case-by-case basis (Para. 23). Since the applicant merely listed other registrations despite the comprehensive reasoning given in the first BoA decision, the BoA was not obliged to re-examine the application. In fact, the BoA did not do so because it merely declared the

other registrations to be irrelevant in view of the first BoA decision. In any event, addressing new facts cannot be considered as a re-examination of a former decision if there is no corresponding obligation to (Paras. 24-25). Said other registrations do not post-date the first BoA decision. In addition, the obligation to re-examine an application can only arise from the applicant’s submissions given that a trade mark application must be motivated and documented according to Article 26 CMTR and Rule 1 CTMIR. Moreover, it would promote the possibility of a misuse of proceedings if an application would trigger such obligation. Case-Law, however, does not allow the filing of applications with the aim to contest the respective decision (Para. 27). It is irrelevant that the examiner’s decision preceding the second BoA decision was not merely a confirmatory act because only the second BoA decision is subject of the court proceedings (Para. 28). It follows from the above that the second BoA decision merely confirms the final first BoA decision (Para. 29). The belated action against the first BoA decision, which was still pending when the second BoA decision was rendered, does not deprive it of its final character. Otherwise, it would render the Case-Law concerning confirmatory act of any effect, which has been developed in order to prevent that, by way of bringing of an action, an expired period for filing an action begins to run again (Paras. 30-33). For these reasons, the action is inadmissible.

## First Page

- March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

- Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

- Elements external to the Community design

## Statistical Highlights

- January 2016

## ETMDN Updates

- Consultation on European Cooperation Projects
- The Harmonised Database celebrates its first full year

## More News

- Public consultation on the Office’s Strategic Plan 2020
- DesignEuropa Awards: celebrating design in the EU
- Ninth judges’ symposium report available now

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law



**Case T-334/14; Roca Sanitario S.A. v OHIM; Judgment of 29 October 2015; Language of the case: ES**

**RESULT:** Action dismissed

**KEYWORDS:** Design, Novelty, Individual character, Freedom of designer, Overall impression, Informed user

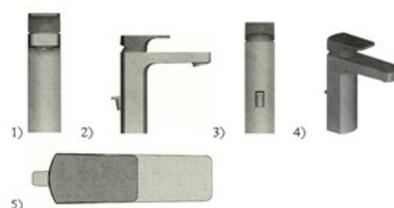
**FACTS:** The Cancellation Division (CD) annulled the registered community design (RCD) for lack of novelty.

The Board of Appeal (BoA) annulled the CD decision, as the designs are not identical but there are significant differences which are not insignificant details. On the other hand, it found that the RCD lacked individual character and annulled it on the basis of Article 25 (1) (b) RCDR in relation to Article 6. It found that the degree of freedom of the designer is not limited and that, for the informed user (who is the general consumer who chooses taps for his house), the general impression produced by both designs is very similar. The differences are not enough to produce a different general impression on the informed user.

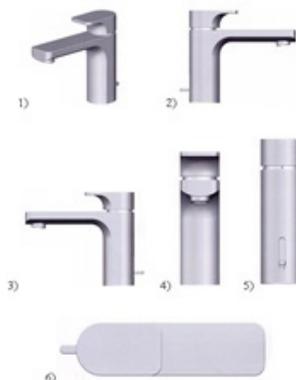
**SUBSTANCE:** Single plea: infringement of Article 6 RCDR in relation to Article 25 (1) (b).

The General Court (GC) confirms that the degree of freedom of the designer is not limited (Para. 46), that the general impression produced by both

### RCD - taps



### Earlier RCD - taps



designs is very similar (Para. 81), and that there is no crowded art (Para. 90). The action is dismissed.

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



**DESIGNEUROPA awards**

■ Applications now open

## Case law



**Case T-615/14; Fútbol Club Barcelona v OHIM; Judgment of 10 December 2015; Language of the case: ES**

**RESULT:** Action dismissed

**KEYWORDS:** Distinctive character, Minimum degree of distinctiveness, Figurative mark

**FACTS:** The applicant sought to register the figurative mark represented below as a CTM for goods and services in Classes 16, 25 and 41. The examiner refused to register the mark as a CTM on the ground of Article 7 (1) (b) CTMR and took the view that the conditions of Article 7 (3) were not fulfilled. The Board of Appeal dismissed the applicant's appeal. The applicant filed an action before the General Court (GC).

CTMA



**SUBSTANCE:** The GC confirms that none of the characteristics of the sign applied for contains an element that could attract the consumers' attention. It will rather be perceived as a simple shape that

cannot distinguish the goods and services of the applicant from those of other companies (Para. 33). The average consumer can only perceive the differences with shields of other football clubs upon direct comparison. The details in the CTMA will hardly remain in the average consumer's memory (Para. 36).

Shields and similar shapes are often used for products in Class 16 and for services in Class 41 as simple decorative elements, without a trade mark function. They are also used on shoes and clothes (Class 25) as decorative elements or as labels.

Article 7 (3) CTMR is not applicable. The sign appears in the evidence in combination with other marks (namely, with the proper shield of the FC Barcelona). However, this evidence is not relevant, because the CTMA cannot be clearly differentiated from the other marks (Paras. 61-62), contrary to the situation in "Have a break... have a Kit Kat", where "have a break" could be clearly differentiated from the other part of the mark in combination with which it had been used (Paras. 61-62).

**Case T-763/14; Holding Soprema v OHIM; Judgment of 25 November 2015; Language of the case: FR**

**RESULT:** Action dismissed

**KEYWORDS:** Likelihood of confusion, Specialised public, Relevant territory, Identity of the goods

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law



and services, Similarity of the goods and services, Purpose of the goods and services, Distinctive element, Weak element, Descriptive element, Visual similarity, Phonetic similarity, Conceptual dissimilarity, Similarity of the signs

**FACTS:** The IR holder obtained the International registration designating the European Union for the word mark SOPRAPUR for goods in Classes 1, 3, 17 and 19. An opposition was filed, based, in particular on the earlier Community trade mark Sopro, for goods and services in Classes 1, 2, 3, 6, 17, 19, 24, 27, 37 and 39. The opposition was based on Article 8 (1) (b) CTMR. The Opposition Division (OD) upheld the opposition for all the contested goods. The Board of Appeal (BoA) dismissed the IR Holder's appeal and confirmed the decision, found a likelihood of confusion and, based on Article 8 (1) (b) CTMR, rejected the IR (EU) in its entirety. The IR holder filed an action before the General Court (GC).

### IR designating the EU

**SOPRAPUR**

### Earlier mark

**Sopro**

**SUBSTANCE:** The GC noted at the outset that the BoA had rightly considered the relevant territory to be the EU and confirmed that the public consisted in the reasonably well-informed, observant and circumspect general public for goods in Class 3 as well as a professional public with a higher level of attention for the remaining contested goods. The GC found that the BoA rightly stated that the German part of the public was an important part while correctly defining the relevant public as the public of the EU. The GC concluded that there was no lack of reasoning in the BoA's focus on the German part of that relevant public.

The BoA correctly differentiated the various categories of goods targeting different consumers and rightly discerned different degrees of attention (Para. 23).

The GC considered that when referring to OD's line of reasoning regarding the conceptual comparison, the BoA recognised that the signs were not conceptually similar and implicitly considered that the element "pur" held a conceptual connotation which was not sufficient to outweigh the visual and phonetic similarities (Para. 25). Consequently, the legal considerations were clearly set out in the contested decision. The latter informed the applicant of the justification for the contested decision and enabled the GC to exercise its power to review the legality of the decision (Para. 26).

The GC endorsed the BoA's definition of the public and considered well founded that the BoA assessed the existence of a likelihood of confusion on the

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



**DESIGNEUROPA awards**

■ Applications now open

## Case law



important part of the public which understands the word “pur” as a reference to the purity of the goods, such as the German speaking public.

The BoA adopted OD’s conclusion regarding the comparison of goods which were either identical, highly similar or similar to the earlier goods (Paras. 37-38). This conclusion, which was not contested by the applicant, is confirmed by the GC.

Regarding the sign SOPRAPUR, an important part of the German speaking public will identify the German word “pur”. It is therefore correct to assess the likelihood of confusion on this significant part of the public. The element “pur” is descriptive of part of the products as it refers to the purity of the products or to their purpose (to give to objects or surfaces their pure cleanliness) and is weakly distinctive for the other part as it consists in a laudatory term to promote a superior quality of a given product. The beginning “sopra” has a normal distinctive character thus has more weight than “pur” in the perception of the German speaking part of the public. However, this does not mean that “pur” will be neglected in the overall impression. The BoA did a correct assessment of the overall impression and took account of all the elements of the signs, even though it did not specifically identify the degree of visual, phonetic and conceptual similarity and only stated that the signs were similar globally (Para. 53). The consumers pay more attention to the beginning of the sign which may have a stronger impact than the rest of the sign (Para. 54).

The fact that the earlier trade mark begins with a

capital letter “S” followed by lower case letters has no impact on the visual comparison given that a word mark is protected for the word, not for the graphic or stylised aspects of it (Para. 56). Phonetically, a weakly distinctive element of a complex mark has only a limited impact on the phonetic similarity (Para. 61). The element “sopra” will draw more attention than the element “pur” (Para. 62 in fine). “Sopro” and “sopra” are highly similar visually and aurally. The element “pur”, although not negligible, is not sufficient to substantially diminish the strong similarity of the element “sopra” with the earlier mark.

The element “pur” is descriptive of part of the products or weakly distinctive for the other part thus will impact only to a limited extent the phonetic similarity. Based on the imperfect recollection, the signs are visually and phonetically similar to at least an average degree. Conceptually, the signs are not similar. SOPRAPUR does not carry a clear concept per se. In its overall assessment, in light of the identity and similarity of the goods and the visual and phonetic similarities, the BoA was right to conclude that a likelihood of confusion existed. The action was dismissed.

**Case T-202/15; Zitro IP Sàrl v OHIM; Order of 20 November 2015; Language of the case: ES**

**RESULT:** Action unfounded

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office’s Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges’ symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law



**KEYWORDS:** Descriptive element, Minimum degree of distinctiveness, Figurative trade mark, Figurative element

**FACTS:** The CTM applicant sought to register the figurative sign represented below for goods in Classes 9, 28 and 41.

The examiner rejected the application. The First Board of Appeal (BoA) dismissed the appeal.

The CTM applicant filed an application before the General Court (GC) for the annulment of the decision of the BoA.



**SUBSTANCE:** When a trademark's verbal element is descriptive, the mark as a whole is descriptive if its figurative elements do not allow the public to detach from the descriptive message conveyed by the verbal element. The BoA correctly found that the expression "world of bingo" is descriptive and that the figurative elements were not perceived as indicating commercial origin. The trade mark is therefore descriptive (Para. 22).

The trade mark being descriptive, there is no need to rule on the distinctiveness of the signs (Para. 26).

**Case T-203/15; Zitro IP Sàrl v OHIM; Order of 20 November 2015; Language of the case: ES**

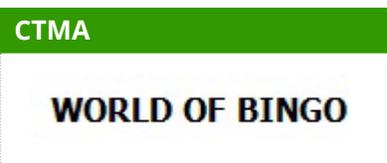
**RESULT:** Action unfounded

**KEYWORDS:** Descriptive element, Minimum degree of distinctiveness

**FACTS:** The CTM applicant sought to register the word sign WORLD OF BINGO for goods in Classes 9, 28 and 41.

The examiner rejected the application. The First Board of Appeal (BoA) dismissed the appeal.

The CTM applicant filed an application before the General Court (GC) for the annulment of the decision of the BoA.



**SUBSTANCE:** The BoA correctly found that the expression "world of bingo" is descriptive, as consumers will clearly perceive it as meaning that the marked products and services are related to the game of bingo (Para. 18).

The trade mark being descriptive, there is no need to rule on the distinctiveness of the signs (Para. 23).

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



## Case law

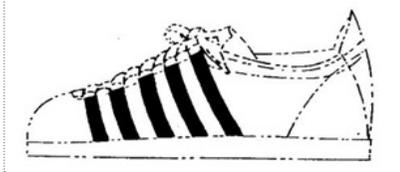
Case T-3/15; K-Swiss v OHIM; Judgment of 4 December 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Distinctive element, Minimum degree of distinctiveness, Figurative trade mark

FACTS: The applicant sought to register the figurative mark represented below as a CTM (designation of the EU for IR 932758) for goods and services within Class 25. The examiner refused to register the mark as a CTM on the ground of Article 7 (1) (b) CTMR. The Board of Appeal (BoA) dismissed the applicant's appeal. The applicant filed an action before the General Court (GC).

### CTMA



**SUBSTANCE:** FIRST PLEA IN LAW: INFRINGEMENT OF ARTICLE 7 (1) (b) CTMR: The GC took the view that the mark applied for is presented in the form of a design intended to be placed on part of the goods concerned, and not in the form of a two-dimensional representation of a shoe, in spite the discrepancy in the French description of the mark (Para. 16). Stripes are nothing more than a rather



banal generic embellishment (Para. 18). The mark applied for consists of a simple juxtaposition of five sloping, parallel stripes, the size of which varies so as to correspond to that of the side of the shoe (Para. 19). Many manufacturers of sports shoes use relatively simple patterns of lines of stripes which they also place on the side of the shoe; the fact that the sign in question extends to the full height of the side of the shoe confirms its lack of originality (Paras. 21-22). Although the applicant showed that many manufacturers have developed a practice of placing their mark on the side of the shoes and the sellers display in shops the side of the shoes on which the mark appears, that information still does not make it possible to determine that the average consumer has learnt to establish an automatic link between the sign and a particular manufacturer (Para. 26). Even if it were accepted that the average consumer pays particularly close attention to the shapes placed on the side of the shoe, to the point that that consumer considers that those shapes generally constitute trade marks, the applicant has not adduced sufficient evidence to establish that, in view of the banal nature of the sign at issue, the average consumer would consider that sign to be an indication of the origin of the goods at issue and not a mere decorative element (Para. 33). As regards attentiveness of the public, while it is possible that the consumer may be more attentive to the choice of mark when he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law



evidence with regard to all goods in that sector; this also applies to the sector of sports shoes and casual shoes (Paras. 36-37). SECOND PLEA IN LAW: INFRINGEMENT OF ARTICLE 76(1) CTMR: The applicant claimed that the BoA ought to have supplemented the evidence at its disposal. The GC stated that if an applicant claims that the trade mark applied for is distinctive, despite the Office's analysis, it is for that applicant to provide specific and substantiated information to show that the trade mark applied for has an intrinsic distinctive character (Para. 45). It was therefore not for the BoA to supplement the evidence that was available to it (Para. 46).

**Case T-63/15; Shoe Branding Europe BVBA v OHIM; Judgment of 15 December 2015; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Distinctive element, Minimum degree of distinctiveness, Position mark

**FACTS:** The applicant sought to register the figurative mark represented below as a CTM for goods and services within Class 25. The examiner refused to register the mark as a CTM on the ground of Article 7(1)(b) CTMR. The Board of Appeal dismissed the applicant's appeal. The applicant filed an action before the General Court.

### CTMA



**SUBSTANCE:** Although the patterns and simple designs affixed to the products applied for or, more generally, on sports products, may be perceived in some cases as indications of commercial origin that does not mean that any pattern would be perceived that way (Para. 17). The pattern concerned is very simple and ordinary which, as such, lacks distinctive character (Para. 20). The applicant had not established that such a pattern would acquire a distinctive character from the fact that it was affixed on a specific part of the shirt (Para. 21). Even if it is accepted that the average consumer pays particularly close attention to simple geometric shapes positioned on clothing — especially on the outside of the sleeves of shirts — to such an extent

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law



that he considers that such shapes are generally trade marks, the applicant has not produced sufficient evidence to establish, given the ordinary nature of the sign at issue, that the average consumer would regard the sign as an indication of the origin of the products at issue and not as a mere decorative element. (Para. 28) Accepting that any geometric shape, including the simplest one, has a distinctive character because it is affixed to a particular portion of the sleeve of a sport shirts would result in some manufacturers being able to appropriate simple, primarily decorative, shapes, which must remain accessible to all, except where the distinctive character of the sign has been acquired through use (Para. 29).

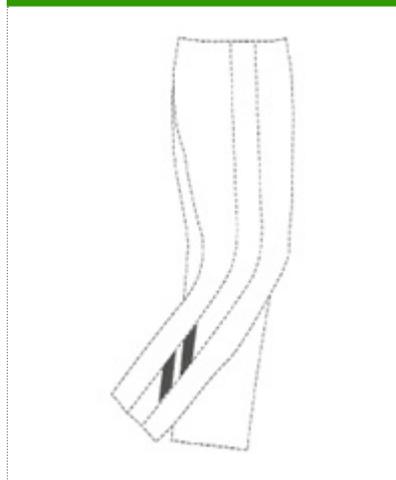
**Case T-64/15; Shoe Branding Europe BVBA v OHIM; Judgment of 15 December 2015; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Distinctive element, Minimum degree of distinctiveness, Position mark

**FACTS:** The applicant sought to register the figurative mark represented below as a CTM for goods and services within Class 25. The examiner refused to register the mark as a CTM on the ground of Article 7 (1) (b) CTMR. The Board of Appeal dismissed the applicant's appeal. The applicant filed an action before the General Court.

### CTMA



**SUBSTANCE:** Although the patterns and simple designs affixed to the products applied for or, more generally, on sports products, may be perceived in some cases as indications of commercial origin that does not mean that any pattern would be perceived that way (Para. 17). The pattern concerned is extremely simple which, as such, lacks distinctive character (Para. 20). The applicant had not established that such a pattern would acquire a distinctive character from the fact that it was affixed, at a certain angle, to a specific part of the pants (Para. 21). Even if it is accepted that the average consumer pays particularly close attention to simple geometric shapes positioned on clothing to the point

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law



that he considers that those shapes are in general marks, the applicant has not produced sufficient evidence to establish, given the ordinary nature of the sign at issue, that the average consumer would regard the sign as an indication of the origin of the products at issue and not as a mere decorative element. (Para. 28) Accepting that any geometric shape, including the simplest one, has a distinctive character because it is affixed to a particular portion of the side of a pair of sport pants would result in some manufacturers being able to appropriate simple, primarily decorative, shapes, which must remain accessible to all, except where the distinctive character of the sign has been acquired through use (Para. 29).

## First Page

---

- March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

---

## Community Trade Mark

---

- Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

---

- Elements external to the Community design

## Statistical Highlights

---

- January 2016

## ETMDN Updates

---

- Consultation on European Cooperation Projects
- The Harmonised Database celebrates its first full year

## More News

---

- Public consultation on the Office's Strategic Plan 2020
- DesignEuropa Awards: celebrating design in the EU
- Ninth judges' symposium report available now

## Case Law

---

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



**DESIGNEUROPA awards**

■ Applications now open



## Case law



### New Decisions from the Boards of Appeal

The cases [can be found on our website](#).

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

**Decision of 18 December 2015 – R 552/2015-2 – Thinking People First; Language of the case: EN**

**RESULT:** Decision confirmed.

**KEYWORDS:** Laudatory mark, Minimum degree of distinctiveness, Slogan mark, Article 7(1)(b) CTMR.

**FACTS:** By means of an international registration, the applicant sought protection in the European Union for the word mark 'Thinking People First' for services in Class 36. The examiner refused protection for the European Union because the trade mark was not eligible for registration under Article 7(1)(b) CTMR.

**SUBSTANCE:** The Board found that even though 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, a slogan that is banal, commonplace or directly descriptive of a characteristic of the relevant goods or services is unlikely to possess any distinctive character because it probably will not be perceived immediately as an indication of the commercial origin of the goods or services in question. The Board confirmed that the joint use of the words 'Thinking People First' conveys a clear message with laudatory connotations in relation to the positive aspects of the services concerned, namely that they will be rendered while considering the needs or wishes of persons before all others or before everything else.

Furthermore, the Board pointed out that the contested services are sufficiently interlinked for the objection under Article 7(1)(b) CTMR to apply to all of them, therefore the Case-Law regarding general reasoning for homogeneous categories can apply in the present case (23/09/2015, T-633/13, INFOSECURITY, EU:T:2015:674, § 47-48). Even when classified in a limited number of categories or groups, 'monetary or financial affairs' on the one hand, 'insurance services', on the other, the sign applied for conveys a clear message with laudatory connotations. It is for the applicant to identify the contested services to which the absolute ground of refusal, in its opinion, does not apply. Consequently, the appeal was dismissed and the protection for the European Union rejected.

[Link to eSearch Case Law](#)

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law



### **Decision of 5 June 2015 – R 322/2014-2 – TOSCORO; Language of the case: EN**

**RESULT:** Decision partially annulled.

**KEYWORDS:** Ancillary appeal, Scope of proceedings, Geographical origin, Article 7(1)(k) CTMR, Article 164 CTMR.

**FACTS:** The cancellation applicant filed an invalidity action against the CTM 'TOSCORO' registered for goods in Classes 29 and 30 pursuant to Article 52(1) (a) and Article 7(1)(c), (g) and (k) CTMR, based on the Protected Geographical Indication 'TOSCANO'. The Cancellation Division partly rejected the CTM registration. The CTM proprietor appealed the contested decision and the cancellation applicant filed an ancillary appeal.

**SUBSTANCE:** The CTM proprietor argued that Article 7(1)(k) CTMR was added by Amending Regulation (CE) No 422/2004 of 19 February 2004 and therefore not applicable to the contested CTM registered on 5 January 2004 before that provision came into force (§ 20). However, the Board pointed out that although Article 7(1)(k) CTMR was not applicable because it was not in force at the filing date of the contested CTM (17/06/2002), the applicable law (Council Regulation (EC) No 40/94 of 20 December 1993) already included Article 142 CTMR (now Article 164 CTMR) (§ 21) which, on substance, reverted to Article 13 of Council Regulation (EEC) No 2081/92 and later

to Article 13 of Council Regulation (EC) No 510/2006, which in turn had been replaced by Regulation No 1151/2012 of 21 November 2012 on quality schemes for agricultural products and foodstuffs and in parallel codified in Article 7(1)(k) CTMR. The challenged CTM registration 'TOSCORO' was covered by one of the situations described by Article 13(1) of Regulation No 2081/92 and so had to be declared invalid for certain products pursuant to Article 14(1) of that Regulation.

Indeed, 'TOSCANO' is a protected geographical indication in the European Union, within the legal framework established by Regulation No 2081/92. The PGI was granted on 21 March 1998 by Commission Regulation (CE) No 644/98, which guarantees the origin and the quality of extra virgin olive oil produced in Tuscany, Italy. The challenged CTM is 'TOSCORO', which bears a critical resemblance to the PGI 'TOSCANO'. The beginning of each sign is identical, consisting of 'TOSC-'; this is a significant factor in the assessment of similarity bearing in mind that consumers generally take more note of a mark's beginning than of its ending. 'TOSCORO' must be regarded, in the sense of Article 13(1)(b) of Regulation No 2081/92, as an evocation of the PGI 'TOSCANO' with respect to the following goods: Class 29 □ Edible oils fats; edible vegetable oils, notably olive oils; green and black olive creams. It follows that the challenged CTM 'TOSCORO' must be deemed invalid for the said goods. However, the Board found that mayonnaise bearing the sign 'TOSCORO' will not evoke the olive oil covered by

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law



the 'PGI' 'TOSCANO' and consequently dismissed the cross-appeal on this point.

Moreover, the Board annulled the contested decision insofar that it found the challenged mark invalid for 'products for flavouring or seasoning foodstuffs, salad dressing' in Class 30. Oils, including olive oils, do not fall in this class. Although some of these goods, such as 'salad dressing', might contain oil as an ingredient they cannot be deemed the same type of goods as 'olive oil' for the same reasons that 'mayonnaise' is not the same as olive oil.

[Case under appeal before the General Court (T-510/15)]

[Link to eSearch Case Law](#)

**Decision of 11 January 2016 – R 52/2015-1 – pi;**  
**Language of the case: EN**

**RESULT:** Decision partially annulled.

**KEYWORDS:** Proof of use, Revocation grounds, Article 15(1)(a) CTMR, Article 26(1)(c) CTMR.

**FACTS:** The cancellation applicant filed an application for revocation against all the goods and services of the CTM registered for Classes 9 and 42 on the basis of Article 51(1)(a) CTMR. The Cancellation Division revoked the CTM in its entirety.

**SUBSTANCE:** The Board found that the CTM protects 'computer software' in Class 9 and the evidence

filed by the CTM proprietor is sufficient to show a genuine use of the trade mark. However, 'computer software' in Class 9 can comprise a whole range of different software applications. As the evidence given does not show use of the trade mark other than for software for the construction industry it is appropriate to limit the protection of the trade mark to certain sub-categories for which the CTM proprietor succeeded in giving evidence for the genuine use of its trade mark. As a consequence the appeal has to be upheld in as far as the contested decision revoked the Community trade mark in its entirety.

[Link to eSearch Case Law](#)

**Decision of 30 October 2015 – R 588/2015-1 – ats (fig.);**  
**Language of the case: IT**

**RESULT:** Decision annulled.

**KEYWORDS:** Ownership of IP right, Transfer of IP right, Article 17 CTMR, Rule 31 CTMIR.

**FACTS:** Regarding a registered CTM the Register Service of the Office recorded the transfer of the trade mark to a new owner ('the appellant'). Then, five months later, on the basis of the application submitted by the previous owner, the Register Service recorded the transfer back to the original owner of the CTM. The new owner requested this entry to be cancelled stating that it never

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open

## Case law



transferred the CTM back to the original owner. The Operations Department of the Office decided not to cancel the second transfer within the meaning of Article 80 CTMR reasoning that the Office does not rule on contractual or legal matters arising from national laws, and in the event of any doubt, it is up to the national courts to verify the legitimacy of the transfer itself. The appellant filed notice of appeal against the decision, within the meaning of Article 59 CTMR, requesting that the entry of the transfer of the trade mark to the original owner be cancelled, arguing that this transfer had been made on the strength of a document (deed of transfer) with a forged signature.

**SUBSTANCE:** The Board found that both Article 17 CTMR and Rule 31 CTMIR make a distinction between a trade mark transfer document and an application for the registration of the transfer of a trade mark in the Register. A trade mark transfer document is a document through which one party transfers ownership of a trade mark to another party. An application for registration of a transfer is a request made by one party (or both parties) to the Office for it to enter the transfer in the Register of Community Trade Marks, in order to record the new ownership.

Sending a trade mark transfer document to the Office is not enough to have that transfer entered in the Register. In order for such an entry to be made possible, a 'request' or 'application' to that effect must also be submitted, pursuant to Article 17

CTMR and Rule 31 CTMIR. In this respect, the Board cannot fail to observe that the sheet of paper which the parties supposedly signed, even though it uses the verb 'to ask', is not an 'application for registration of a transfer' within the meaning of Rule 31(1) and (5) CTMIR.

In light of the foregoing, the Registry Service clearly made an error when it registered the transfer – and changed the ownership – of the Community trade mark on the strength of that document alone, without checking whether it complied with Article 17 CTMR and Rule 31 CTMIR. Consequently, the appeal was upheld and the contested decision annulled.

[Case under appeal before the General Court (T-5/16)]

[Link to eSearch Case Law](#)

## First Page

■ March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

■ Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

■ Elements external to the Community design

## Statistical Highlights

■ January 2016

## ETMDN Updates

■ Consultation on European Cooperation Projects  
■ The Harmonised Database celebrates its first full year

## More News

■ Public consultation on the Office's Strategic Plan 2020  
■ DesignEuropa Awards: celebrating design in the EU  
■ Ninth judges' symposium report available now

## Case Law

■ Luxembourg trade mark and design news  
■ New decisions from the Boards of Appeal



DESIGNEUROPA awards

■ Applications now open



## The DesignEuropa Awards – nominate or apply before July 15

The DesignEuropa Awards celebrate excellence in design and design management among Registered Community Design holders.

Organised by OHIM, the DesignEuropa Awards are geared towards firms and/or individuals who have, and who successfully use, RCDs. The Awards differ from other design competitions in that they focus on the RCD itself. They seek to recognise companies and designers who have brought outstanding design to the market using the protection of the Registered Community Design.

There are two ways to enter.

RCD holders can **apply directly themselves**, via the application form on the [DesignEuropa Awards website](#), or they can be **nominated by a third party** via the nomination form which is also available on the website.

The Awards have three categories:

**The Industry Award** – for RCDs owned by companies which have more than 50 employees and over €10 million in turnover/€10 million balance sheet total

**The Small and Emerging Companies Award** – for RCDs owned by companies which comply with one of the following conditions:

- Fewer than 50 employees and less than €10 million turnover/€10 million balance sheet total
- Companies established after January 1 2013, regardless of their size

**The Lifetime Achievement Award** – for individual designers with a significant body of work of aesthetic value, created over the course of a career, which has also had a demonstrable impact on the marketplace. Nominees in this category must currently use or have used the RCD system during their professional careers.

Applications and nominations can be sent using the forms on the DesignEuropa Awards website ([www.designeuropawards.eu](http://www.designeuropawards.eu)).

Shortlisted finalists will be announced on October 15, with the award ceremony taking place in Milan, Italy, on November 30.

## First Page

- March 23, 2016 – from OHIM to EUIPO

James Nurton Interviews | Sandra Martins Pinto

## Community Trade Mark

- Clarifying your list of goods and services under Article 28(8) KCG&S Issues

## Registered Community Design

- Elements external to the Community design

## Statistical Highlights

- January 2016

## ETMDN Updates

- Consultation on European Cooperation Projects
- The Harmonised Database celebrates its first full year

## More News

- Public consultation on the Office's Strategic Plan 2020
- DesignEuropa Awards: celebrating design in the EU
- Ninth judges' symposium report available now

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

 **DESIGNEUROPA awards**  
■ Applications now open