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Public consultation on the OHIM Strategic Plan 2020

As the OHIM Strategic Plan 2011-2015 is drawing to an end, the time has come to further the work that has been done and develop a strategy for the future. OHIM is launching a consultation for the Strategic Plan 2020. By accessing this link you will find the consultation document as well as information on how to submit your contribution.

Work on the OHIM Strategic Plan 2020 began in 2014 via a consultation process that involved OHIM Staff, and Members and Observers of the Administrative Board and Budget Committee. The contributions received to date have resulted in a set of draft Guiding Principles and an Outline of the plan being developed.

The objective of this public consultation is to seek suggestions and ideas from all OHIM stakeholders and general public on the vision and strategic goals set by the Office for the coming years.

The context of the new Strategic Plan

Although much has been achieved against the strategic goals of the OHIM during the last five years, and the vision of creating the European Trade Mark and Design Network has been successful, the future will continue to pose challenges for the Office.

Externally, OHIM will be affected by the financial constraints imposed through the Multiannual Financial Framework that was adopted by the EU institutions for 2014-2020, in response to continued austerity in the EU. Additionally, the demand on resources due to new competencies, such as the European Observatory on Infringements of Intellectual Property Rights, increased Community trade mark and design applications, and the proposed reform of the CTM system, will further challenge the way OHIM operates.

Internally, considerable improvements were registered in driving organisational excellence and creating a collaborative working environment. Nevertheless, more actions will be taken to embed a performance and service oriented culture across the entire Office if it is to meet user's expectation and improve user experience. Likewise, now that the Observatory is fully integrated into OHIM, more must be done to promote awareness and knowledge of the intellectual property (IP) systems among users, IP office officials, customs staff, police, judges, academics and members of society in general.

Finally, as businesses are increasingly looking beyond the European Union (EU) for growth, OHIM will be collaborating with the European Commission to provide support to European companies,

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particularly small businesses, to help them compete in the global marketplace and enforce their IP rights. To ensure OHIM is resilient to such challenges and able to support a user-driven European Intellectual Property Network with a global focus, it is important that the Strategic Plan 2020 is established for the benefit of all users and stakeholders.

OHIM values the opinion of its stakeholders and therefore invites them to review the Guiding Principles and Outline of the Strategic Plan 2020 and provide feedback.

How to submit your contribution?

You can submit your feedback and any other suggestions you may have by email. Contributions will be treated confidentially. See our privacy statement for information on how your personal data and contribution will be dealt with.

Results and next steps

This consultation will run until the 23rd of February. After this date no further contributions will be considered. All inputs received on time will be reviewed and taken into account for the final draft of the Strategic Plan 2020.

The results of the consultation will be summarised and published in the OHIM website. The final version of the Strategic Plan 2020 will be published during 2015.

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The James Nurton Interview

Dieuwerke van der Schalk, Senior Manager Trademarks Group, D.E. Master Blenders 1753, Amsterdam

How did you get into IP?

I studied law for quite a long time at the University of Amsterdam, but it wasn't until I went to the faculty of intellectual property that I got really interested in the subject. That's when my passion for IP started and I knew I wanted to work in the field.

Dieuwerke van der Schalk

I studied at the University of Kent at Canterbury in the UK for a year and then came back to the Netherlands to do my thesis. After that someone pointed out there was a vacancy in the trade marks department of Sara Lee. I applied and had many interviews and then got the job. That was in the year 2000.

What did you like about IP?

A lot of areas of law are dry whereas IP is about what you see on television and what you see every day. To me it made it more practical; I'm not someone who sits and reads law books for fun!

What do you like about working in-house?

Knowing what I know now, I think I landed in exactly the right place. It's good for me because I like the interaction with marketing, advising them on how to develop their strategies as well as with tax and other departments. You're like a spider in the web rather than giving advice and then not being involved any more. It was my first job and I had all the space to grow.

When I joined Sara Lee it was a big trade department, with two trade mark attorneys and several administrative staff. We were 10 people at the most. The first trade marks I was in charge of were the meat trade marks in Europe, which was funny as I have been a vegetarian since I was 12!

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At the time we had a household and bodycare division and a coffee, tea and food division. The first went from shoecare to things such as skin-lightener. In food we had rice cakes, nuts and so on.

In the end I looked after the Kiwi shoe care brand for a long time. It's surprising to some people that both the Ambi Pur air freshener and Kiwi shoe polish faced a lot of counterfeiting. It must be because they are easy to reproduce, though in poor quality, and they sell well in places like Africa. I worked very closely with the brand integrity manager to get the right level of protection and make sure we protected the elements that were copied the most. We faced a lot of issues in China, and it was very difficult to predict the outcome of cases.

I've also been on the MARQUES Council for many years. MARQUES is a great platform where you as a trade mark owner have the opportunity and the room to talk to your peers and to exchange processes and ways of working and views on things. Otherwise you basically rely on suppliers who want to sell things.

How has your role changed?

Sara Lee started divesting about five years ago and everything changed a lot. Our department was cut in half. Then I took over the coffee and tea portfolio. We were spun out from Sara Lee as a pure tea and coffee company and went to the stock exchange and were then bought by JAB. A lot of people have changed their jobs; I never had to because my job changed!

We are a very focused company and it's nice to deal with one product really well. We are four people and we deal with all the trade marks, designs and domain names worldwide. We don't have a lot of counterfeits in coffee and tea so that is less of an issue.

Design rights are important in relation to the coffee machines, which are sometimes co-owned with Philips, as well as specific packaging sometimes (though that can be more difficult), and also the accessories such as special cups and saucers designed for our products. One example of that is one of our subsidiaries called Tea Forté Inc, a Boston-based company, which sells very exclusive tea bags, and they have special porcelain designed for the teabag. The bag is pyramid-shaped, with a square base, and the leaf sticks out.

How many trade marks and domain names do you have?

We have about 10,000 trade mark and design records, including every designated country. It might soon double due to our planned partnership with Mondelez. Sometimes I feel more like a change manager than a trade mark attorney! It takes a lot of time to get the portfolio organised, and as

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lean and cost-efficient as possible when you have a reorganisation. If you're not careful you are spending millions.

We have a lot of domain names too. In the past there wasn't a centralised policy; now we're trying to steer that a bit more. If you're not careful you have a domain name for every day of the week, and the portfolio and the costs multiply. We have centralised most of them and we have a policy that you have to register through us, and we work closely with the IT department.

With the new gTLD issue, it took some time for us to get clarity about what we will do. The danger is before you know it you are chasing anyone who does anything with your trade marks. You have to consider the commercial impact of the use – is it linking to your products or taking advantage of your reputation or is it just a site that doesn't do anything? We monitor websites to see if they have traffic on them and test what the commercial value is.

The trouble with defensive registrations is that for every typo you can think of they can think of another one. We do act against the people that really take advantage and then there is no mercy.

How do you protect the trade marks?

We have always been very Madrid- and OHIM-oriented. If you are an international company, and you have global brands, it makes sense to use those systems. What we often do is apply for a Benelux registration, base our Madrid application on it and designate a CTM.

How well do you think the Madrid system and CTM work?

In general they work well, though there are things that can be improved. It's common sense that with Madrid provisional refusals may be different the further you go from home.

As regards the CTM, we talk a lot about harmonisation, but how far have we really got? If you compare which CTMs that are accepted and which national marks are refused, there is quite a gap there. If you go to certain countries, they don't speak English so if you have English-based words that is a problem for registration. But if you have oppositions in Europe, sometimes they say it's a better understood word and there's no risk of confusion. So in opposition cases the consumer does understand the English but when the trade mark was applied for they didn't? I think there's a bit of a gap there.

National offices have their own identities but OHIM now has a lot of programmes to promote unity, so I hope we are working towards that. If something gets refused in the Benelux, and you apply for a CTM, we would all benefit if the systems were the same. If something is descriptive in our searches, which we all do, it's getting more difficult to find available marks. As long as there's a difference

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between offices you have to balance whether it is descriptive or not.

I think the cooperation programmes are fantastic and that is the way forward. They have the surplus so let them spend it well. We will all benefit.

What's the most unusual trade mark you've worked on?

For a few years I was dealing with the Bimbo bakery portfolio of trade marks. I was quite embarrassed to find out there were some designs registered for a triangle, square and round piece of bread in our portfolio. We hadn't managed the portfolio, we had let the local business talk to the local agent in Spain. We also sold donuts, but it turned out a competitor had a trade mark registration for Donuts, which was interesting.
T
hat portfolio was sold in the end, so we didn't have to deal with those issues, but it does show how important a role local practitioners can play in the business. A proper trade mark attorney in-house can really add value because one of your jobs is to say: "No, you don't need protection, because it doesn't add value." One of the challenges for in-house attorneys is that marketing is much faster than it was, so you don't always have time for full searches or to go in-depth into all the possibilities, and there are also budget restraints. I hear that from other trade mark attorneys in-house too.

You can create a new product and it can be on the shelf within a few months, rather than half-a-year or a year. But from an attorney point-of-view we settle a lot of opposition issues by asking for the specification of goods to be restricted so you need that time to agree a settlement.

What other challenges do you see on the horizon?

Domain names and what happens on the web remains a challenge. It bothers you because you don't want other people to take advantage of your trade marks, and yet more and more things are moving to the web. And it generates costs.

Another is protected geographical indications (PGIs), and how they affect and relate to trade marks. In our industry we have Darjeeling and Café de Colombia for example and our scope as trade mark attorneys has become much wider. I work closely with our regulatory affairs – food law, we call it – person.

We have the DOOR database but the issue is you have to check every PGI itself to see what is in the file and what the rules are, and they can put a lot of things in there. For your labelling of products it can be difficult. On the other hand we benefit because more products are sold. Like many things, it's balance.

Do you drink a lot of tea and coffee?

I drink a lot of tea and our go to our 10th floor where we have a barista who makes the most exquisite coffees, so I am spoiled!

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Community Trade Mark

State of Play of the Trade Mark Legal Reform

After some extensive preparatory work and studies on how to improve the European Union trade mark system (including notably the Max Planck Institute's Study on the Overall Functioning of the Trade Mark System in Europe), on 27/03/2013 the Commission launched two legislative proposals to amend both the Community Trade Mark Regulation (COM (2013) 161 final) and the Trade Mark Directive (COM (2013) 162 final). The proposals seek to modernise the existing system, both at EU and at national level, by making it more effective, efficient and consistent overall.

On 25/02/2014, acting in accordance with the ordinary legislative procedure, the European Parliament adopted its position at first reading, which included a series of proposed amendments to each of the Commission proposals.

On 23/07/2014, the Committee of Permanent Representatives agreed on a Council common position on the two trade mark reform proposals and mandated the Presidency of the Council to enter into negotiations with the European Parliament with a view to concluding a swift agreement.

During the autumn of 2014 all three institutions of the European Union (European Parliament, Council and Commission) have being negotiating the trade mark reform package. According to a Joint Statement of the European Parliament negotiating team and the Presidency of the Council, published in December 2014, an agreement has already been reached on many areas, but some additional time is still needed in order to be able to arrive at a final conclusion on all essential elements of the package. The institutions will continue negotiating with the aim of trying to reach a final and complete agreement in the first months of 2015, which would then lead to the adoption and publication of the corresponding legal instruments.

Meanwhile, OHIM has been working internally with the three different proposals in order to be well prepared for implementing the legal reform as soon as it comes into force.

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Registered Community Design

Judgment of Tribunal de Grande Instance, Paris, 18/12/2014, 13/04545, 'RHIA T-shirt'

This judgment rules on the infringement of the copyright work and unregistered Community design subsisting in a T-shirt displaying a stylised image.

The plaintiff in this case, the company ELEVEN, claimed ownership to copyright work in a series of T-shirts with images of personalities' faces. These personalities can be seen placing an extended middle finger above their top lip; a moustache is tattooed on the side of the finger and lined up below the nose in a position where a moustache would usually be. The infringement claim was based on a T-shirt design with an image of Rihanna's face and a moustache-tattooed middle finger in the position described, hereinafter referred to as RHIA T-shirt (see the image below). The T-shirt was claimed to be part of ELEVEN's Fall/Winter 2010/2011 collection.

In February 2013 the plaintiff managed to gain seizure of 37 RHIA T-shirts from the defendant, the company HK & CITY. The plaintiff filed an infringement action of its copyright and unregistered Community design rights, and alternatively of unfair competition.

In defence, HK & CITY did not dispute the ownership of ELEVEN's copyright and design rights. However, the defendant denied the original character of the T-shirt and consequently the existence of any copyright in it. According to HK & CITY, the alleged copyright work simply copied 'finger moustache tattoo' photographs and transposed them to the portrait of the singer Rihanna. Such an act did not constitute a creative effort requiring protection by copyright law.

The plaintiff submitted that the choice of personality, whose image appears on the garment, the particular form and placement of the moustache and the position of the middle finger, reflect the author's personality choice and aesthetic preference.

Regarding the claimed rights in unregistered Community design, the plaintiff submitted that HK & CITY did not make any defence with respect to the claimed right, and therefore the right is valid.
The High Court ruled the following:

- According to the French Intellectual Property Code, copyright is conferred on the author of any work of the mind, by the mere fact of its creation, whatever the kind, form or expression, merit or purpose may be, and it is enforceable against all persons. This right shall include attributes of an intellectual, moral and economic nature. According to the Court, the choice of personality whose face is displayed on the clothing, the shape of the moustache and its position on the middle finger constitute

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Registered Community Design

a combination and a particular arrangement which is appreciated globally (as shown in a survey conducted by the plaintiff), conferring on the clothing a specific physiognomy, which demonstrates a creative effort, bearing the stamp of the author's personality. Accordingly, the plaintiff is entitled to act on the grounds of infringement of copyright work.

- To benefit from the protection of an unregistered Community design right, no earlier design may be reasonably known to professionals in the sector concerned conveying the same overall impression to the informed user, in the present case the clothing consumer, in at least one of the essential elements of the claimed design. The burden of proof of existence of such an earlier design is on the defendant, who did not submit any prior art, therefore the design was considered new. Concerning the individual character, it was clear from the description of the RHIA T-shirt design that the choices made, namely of the personality whose face is displayed on the garment, the shape of the moustache and the position of the finger, formed a combination and a particular arrangement that demonstrated the existence of an individual character of the design to allow the user of the clothing to identify that product from another of the same or similar nature, even without their direct comparison as proved by the said survey. The product was marketed in a substantial part of the territory of the EU, namely in France. It followed that the RHIA T-shirt met the requirements imposed by EU design law and, therefore, could be protected by virtue of the unregistered Community design.

- As the defendant, HK & CITY, did not dispute that the sold T-shirts were slavish copies of the RHIA T-shirt, the infringement was established.

- The subsidiary claim of unfair competition was irrelevant with regard to the decision.

- The finding of infringement on the two grounds, namely the copyright and the unregistered Community design, did not imply the multiplication of damages suffered, as the damage of the product's value took place only once whichever of the two grounds was chosen. As no exact figures could be established regarding the amount of marketed infringing products during the seizure operations due to the act of the defendant, the Court established that the plaintiff ELEVEN is entitled to the lump sum of EUR 50 000 for damages caused by the infringement of its copyright and the rights in the unregistered Community design.

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RHIA T-shirt (image taken from the darts-ip database):

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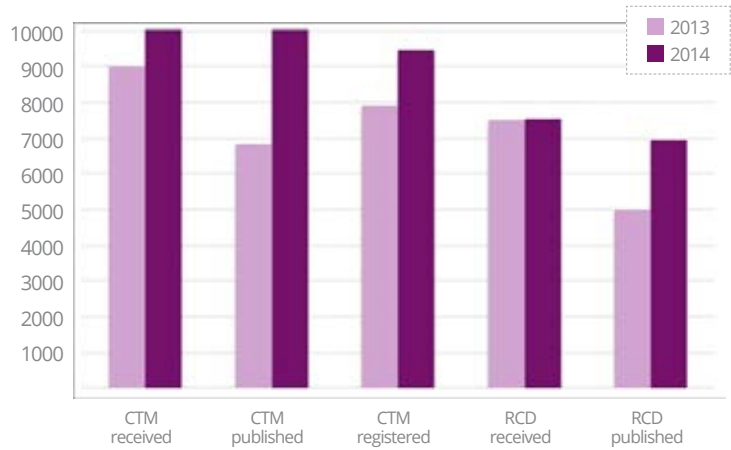
Community Trade Mark applications received	8 988	10 468
Community Trade Mark applications published	6 832	11 039
Community Trade Marks registered (certificates issued)	7 905	9 442
Registered Community Designs received	7 491	7 533
Registered Community Designs published	4 989	6 942

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



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More offices join DesignView

The Korean Intellectual Property Office (KIPO) and the Irish Patents Office (IPO) are **new members** of DesignView, the registered designs search tool, after making their design data available as of 15 December 2014.

DesignView is the **largest free search tool for registered designs** available. With KIPO and IPO on-board, there are now **26 participating offices** in DesignView. And with the addition of more than 840,000 Korean designs and almost 2.000 Irish designs, DesignView now provides information and access to about **3,6 million designs** in total.

The integration of IPO is a concrete result of the Cooperation Fund programme managed by OHIM in collaboration with its European partners.

The incorporation of KIPO is due to the efforts of the International Cooperation programme managed by OHIM in collaboration with its international partners.

Since its introduction on 19 November 2012, the tool has served more than 800.000 searches from 135 different countries, with users from Spain, Germany and the UK among the most frequent visitors.

OAPI joins TMclass

L'organisation Africaine de la Propriété intellectuelle (OAPI) joined TMclass the global, free, goods and services classification tool as from January 15.

OAPI represents 17 African Member States: Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Comoros, Congo, Côte d'Ivoire, Gabon, Guinea, Equatorial Guinea, Mali, Mauritania, Niger, Guinea Bissau, Senegal and Togo.

OAPI registers trademarks in both French and English.

OAPI's integration into TMclass means that a total of 42 national and regional IP offices, including OHIM and WIPO, have now incorporated their data into the tool.

TMclass now offers users the opportunity to search and translate terms to and from any of the 31 available languages

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OHIM reorganisation

Over the past few months, OHIM has been working on a process of internal reorganisation, to create an even stronger internal structure to better serve users and implement its mission.

From October, the Office has implemented a flatter management structure, to increase the agility of operational areas and speed up decision making. This change will benefit users by making the Office more reactive and quality-focused. It is designed to help OHIM meet the expectations of its users, and its commitment to them, with confidence and security.

The reorganisation sees the creation of a Customer Services Department, which encompasses customer experience and management, online business solutions, databases and information solutions, linguistic services and back office activities.

The Operations Department has been restructured to enhance user experience, quality, predictability, consistency and timeliness in times of increasing workloads. Horizontal tasks such as core policy practice, quality, the expansion of knowledge etc. shall also be ensured through the involvement of all OD teams in a matrix structure.

The new organisation is underpinned by small coherent teams in order to tap into the performance gains of high performance teams and to respect the Office's service standards for each individual action filed by our users. Quality will be ensured through balanced ex ante controls.

Moreover, in line with the commitment given in OHIM's Strategic Plan, as a result of the reorganisation, 30% of management posts at OHIM are now held by women, as opposed to 15% in 2010.

- Administrative Decision
- Organisational Chart

OHIM's paper filing fee applies to online applications with additional lists of goods and services

Adding a list of goods and services to your online application, whether as an attachment or by fax, means that our staff processes the application manually. As a result, the reduced online fee (900 EUR) cannot be applied and the paper filing fee is applied instead (1 050 EUR).

Those users inserting additional lists of goods and services will receive a notification in writing asking them to pay the paper fee (+EUR 150). The additional list of goods and services will therefore

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be considered as not filed until this paper fee is paid. This has particular significance for those filers who do not select or include any goods and services in their online application, as the filing date of their trade mark might change.

If payment of the paper fee (+EUR 150) is made within one month from the filing of the application, the initial filing date will be kept. If, however, this payment is made at a later date but still within the two month time limit set in the notification, the filing date will change to the day on which the full fee is paid.

OHIM strongly recommends that applicants insert their goods and services in the designated field of our online form. Not doing so will result in additional costs, as well as a deficiency that will slow down the processing of the trade mark. It could also result in a change of your application's filing date.

OHIM - Je suis Charlie

As a general rule, OHIM's policy is not to comment on any individual cases of trade mark or design applications either before examination or at any stage of the application and registration cycle.

However, the IP issues surrounding the registration of the "Je suis Charlie" mark could be considered to be of overriding public interest.

Therefore, according to OHIM's Guidelines for Examination on Community Trade Marks (Part B, Section 4), an application which consisted of or which contained the phrase "Je suis Charlie" would probably be subject to an objection under Article 7 (1) (f) of the Community Trade Mark Regulation, due to the fact that the registration of such a trade mark could be considered "contrary to public policy or to accepted principles of morality" and also on the basis of Artice 7(1)(b) as being devoid of distinctive character.

European IPR Helpdesk Ambassadors' Seminar

OHIM, through the EU Observatory on Infringements of Intellectual Property Rights, organised the first "European IPR Helpdesk Ambassadors' Seminar" at OHIM on 8 and 9 December 2014.

The European IPR Helpdesk is a European Commission (Directorate-General Enterprise and Industry) funded project, with the aim of supporting EU small and medium enterprises (SMEs) in intellectual property matters. One of the objectives of the Helpdesk is to raise IP awareness

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and build capacities among SMEs all across Europe.

For this reason an "Ambassador's Scheme", composed of its regional partners, has been recently established and the kick-off seminar took place at OHIM. The seminar aimed to foster the network of ambassadors, and additionally to provide training to the participants on IP, including CTM and RCD systems. The two-day event brought together speakers from the Executive Agency for Small and Medium-sized Enterprises (EASME), DG Enterprise and Industry, the European IPR Helpdesk, the European Patent Office (EPO), the private sector and OHIM.

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

Case T-605/11; Novartis AG v. OHIM + Dr Organic Ltd, Judgement of 10 December 2014; Language of the case: EN

RESULT: Action upheld (Board of Appeal decision annulled)

KEYWORDS: Beginning of mark, Common element, Complex mark, Conceptual similarity, Dominant element, Phonetic similarity, Relative Grounds, Similarity of the signs, Similarity of the goods and the services, Visual similarity, Weak element, Likelihood of confusion

FACTS: The CTM applicant filed an application for the word mark BIOCERT for goods in Class 5. The opponent relied on an earlier Austrian mark BIOCEF for goods in Class 5. The Opposition Division (OD) dismissed the opposition. The opponent filed an appeal against the OD's decision. The Board of Appeal (BoA) dismissed the appeal. The CTM applicant brought an action before the General Court (GC) based on two pleas in law.

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BIOCERT
Earlier marks
BIOCEF

SUBSTANCE: On the infringement of Article 8 (1) (b) CTMR. The GC endorsed the BoA's finding that the average consumer shows a heightened level of attention when choosing pharmaceutical products (Paras. 20-24). The GC reversed the BoA's finding with regard to the comparison of the signs and, given the identical or similar nature of the products, it found likelihood of confusion between the marks (Para. 60). In particular, the GC held that the signs have an average degree of visual (Paras. 33-40) and phonetic similarity (Paras. 41-46) and also a certain degree of conceptual similarity (Paras. 47-51). The GC held that the BoA erred in not considering the relevance of the element "BIO" (Para. 34). Even though it is descriptive in respect of the goods covered by the marks at issue, it can still attract the public's attention due to its position at the beginning of the signs. Moreover, the GC pointed out that the common element is constituted by

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"BIOCE" which is longer than "BIO" and, thus, more likely to catch the public's attention (Paras. 36-38). On the infringement of Article 76 (1) CTMR. The GC deemed it not necessary to appraise that plea in law considering that the other plea must be upheld and the contested decision must be annulled (Para. 61).

Case T-480/12; The Coca-Cola Company v. OHIM, Judgment of 11 December 2014, language of the case: EN

RESULT: Action upheld (Board of Appeal decision annulled)

KEYWORDS: Relative grounds, Likelihood of confusion, Figurative element, Common element, Typographical element, Visual similarity, Phonetic dissimilarity, Conceptual dissimilarity, Reputation, Well-known trademark, Similarity of signs, Packaging, Principle of legal certainty, Unfair advantage

FACTS: The other party sought to register the figurative sign reproduced below for goods in Classes 29, 30 and 32. Opposition pursuant to Article 8 (1) (b) and Article 8 (5) CTMR, based on the figurative marks reproduced below, covering identical and similar goods and services in Classes 30, 32, 33 and 43. Both the Opposition Division and the Board of Appeal (BoA) dismissed the opposition. Before the General Court (GC), the applicant alleges an infringement of Article 8 (5) CTMR.

CTMA

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UK

CTMs

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SUBSTANCE: The applicant claims that the BoA wrongly conflated the matter of the similarity of the signs under Article 8 (1) (b) and under Article 8 (5). The GC stated that the types of injury referred to in Article 8 (5) may be the consequence of a lesser degree of similarity of the signs, provided that it is sufficient for the relevant public to make a connection between those marks, that is to say, to establish a link between them (Para. 32). Only if there is some similarity, however faint, between the conflicting marks, a global assessment must be carried out in order to ascertain whether, notwithstanding the low degree of similarity between the signs, there is, on account of the presence of other relevant factors such as the reputation or recognition of the earlier mark, a likelihood of confusion (LOC) or a link made between those marks by the relevant public (Para. 33). Food products in Classes 29 and 30 are normally purchased in supermarkets and are selected directly from the shelf by consumers, who are guided more by the overall visual impression. Thus, the figurative elements of a sign are deemed to play a more important role than its word elements. As a result, the common figurative element ('tail') is at least as important as the finding that there is no textual overlap between the word elements of the signs (Para. 52). The BoA failed to carry out a global assessment taking into account that both signs are written in Spenserian script and failed to establish that element of visual similarity between them (Para. 59). Visually, the signs do not only have clear differences, but also elements of similarity, owing to the 'tail' flowing from their first letters ('c' and 'm' respectively) in a signature flourish and to their shared use of the Spenserian font, which is not commonly used in contemporary business life (Para. 64). There is a low degree of visual similarity between the signs. As the relevant goods are usually sold in self-service stores, the elements of visual similarity and dissimilarity are of greater importance. Overall, there is a low degree of similarity between the signs, as their aural and conceptual differences are cancelled out by the elements of overall visual similarity (Para. 70). Given the degree of similarity, however faint, between the signs, there is a risk that the relevant public might establish a link between the marks at issue. There is a sufficient degree of similarity between the signs for the relevant public to make such connection, for the purposes of the Case-Law according to which the types of injury referred to in Article 8 (5) may be the consequence of a lesser degree of similarity between the earlier and later marks (Para. 74). The BoA should therefore have examined the other conditions for applying Article 8 (5). As the decision is annulled, the BoA will have to examine such conditions. The risk of free-riding may be established on the basis of logical deductions resulting from an analysis of the probabilities and by taking account of the usual practices in the relevant commercial sector as well as all the other circumstances of the case, including the use, by the proprietor of the mark applied for, of packaging similar to that of the goods of the proprietor of the earlier mark. The Case-Law allows taking account

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of any evidence intended to facilitate the analysis of the probabilities as regards the intention of the proprietor of the CTM applied for and -a fortiori - any evidence relating to the actual commercial use of the mark applied for (Para. 88). The BoA erred in disregarding the evidence produced by Coca-Cola relating to the commercial use of the mark applied for. The purpose of opposition proceedings is to ensure −for reasons of legal certainty and sound administration− that trademarks whose use could successfully be challenged downstream before the courts are not registered upstream (Para. 91). It is for the BoA to examine the evidence. The contested decision is annulled

Case T-494/12; Biscuits Poult SAS v OHIM + Banketbakkerij Merba BV; Judgement of 9 September 2014; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Design: overall impression, Design: Informer user, Element of a design, Visible features of a design, Freedom of designer, Individual character.

FACTS: The applicant filed an application for the registration of RCD. The design in respect of which registration was sought, intended to be applied to 'cookies', is represented below.

The intervener applied for a declaration of invalidity of the design pursuant to Article 25 (1) (b) CDR read in combination with Article 6 CDR. The Cancellation Division dismissed the application. The Board of Appeal (BoA) declared the contested design invalid on the ground that it lacked individual character. The applicant brought an action before the General Court (GC), alleging the infringement of Article 6 CDR.

RCD

SUBSTANCE: The GC dismissed the action and endorsed the BoA's findings. The BoA did not err in finding that the contested design had to be declared invalid on the ground that it lacked individual character (Para. 35). In particular, the GC observed that: the BoA did not err in stating that the non-visible characteristic of the product (the layer of chocolate filling inside the cookie) does not relate to the appearance and cannot take into account in the examination of the requirements to fulfil for

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register a design (para 25, 29 and 31); the applicant misunderstood the meaning and the function of Article 4 (2) and (3) of RCDR which relate to a "complex product" and are ineffective in the current proceeding: the product at issue is not a "complex product" (Paras. 27 and 28); the BoA did not err in the assessment of individual character. Given the designer's considerable freedom in the sector, the differences highlighted by the applicant (such as number, dimensions and prominent presence of chocolate chips, smoother surface) are not liable to produce a different overall impression on an informed user (Paras. 32-34).

Case T-235/12; CEDC International sp. z o.o. v OHIM, Judgment of 11 December 2014, Language of the case: DE

RESULT: Action upheld (Board of Appeal decision annulled)

KEYWORDS: Proof of use, Complementary evidence, Lack of reasoning, Three-dimensional mark, Shape of the products, Labels, Principle of legality, First time on appeal, Competence of the Boards, Relative grounds

FACTS: The applicant sought to register a 3D mark represented below as a CTM for goods within Class 33. An opposition was filed. Based among others on the earlier French mark represented below protected for goods in Class 33 with the following description: 'a bottle as represented above inside which a blade of grass is placed almost diagonally in the body of the bottle'. The Opposition Division (OD) considered the proof of use of the earlier mark insufficient and rejected the opposition pursuant to article 42(2) CTMR. With the appeal the opponent filed further documents. The Board of Appeal (BoA) dismissed the appeal confirming the finding that the proof of use was insufficient. It found that that the proof of use showed bottles in two different shapes but always with the same striking non-transparent 'ZUBROWKA BISON VODKA' label covering a large part of the bottles, and that the diagonal line was not affixed to the outside surface and did not appear on the label itself. It further found that, as a result of the presence of the label, it was impossible to see what was behind it on or in the bottles. The opponent filed an action before the General Court (GC) claiming the (i) infringement of the principle of legality and the Manual of Trade Mark Practice of the Office; (ii) infringement of Article 15(1) CTMR and Rule 22(3) of Regulation CTMIR and of Article 8(1) (a) and Article 42(2) and (3) CTMR; and (iii) infringement of Article 75 and Article 76 (1) and (2) CTMR.

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CTMA

Earlier marks

SUBSTANCE: The GC annulled the decision following the third plea alleging infringement of Article 75 and Article 76 (1) and (2) CTMR. The BoA failed to examine evidence adduced for the first time before it and to provide reasons in that regard (paras. 41, 54). Article 76 (2) CTMR grants the Office a wide discretion to decide, while giving reasons for its decision in that regard, whether or not to take such information into account (Para. 45). In the present case, it is clear that the BoA did not exercise the discretion conferred on it to decide whether or not to take into account evidence of use produced for the first time before it and did not give any reasons for its decision in that regard (Para. 61). In addition to that obligation to give reasons, the Case-Law has laid down criteria for the exercise of the Office's discretion for the purposes of potentially taking into account evidence submitted out of time. Thus, taking such facts or evidence into account is particularly likely to be justified where the Office considers, first, that the material which has been produced late is, on the face of it, likely to be relevant to the outcome of the opposition brought before it and, second, that the stage of the proceedings at which that late submission takes place and the circumstances surrounding it do not argue against such matters being taken into account (Para. 62) In the present case, the evidence produced out of time met the two requirements for being taken into account by the Office (Para. 63). The stage in the proceedings at which the late production of evidence arose and the circumstances surrounding it do not argue against such evidence being taken into account by the Office, since the applicant produced it together with its statement setting out the grounds of its action before the BoA, thereby allowing the BoA to exercise its discretion in an objective, reasoned manner to decide whether or not to take the evidence into

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account (Para. 67). In relation to the arguments brought by the Office before the GC that were not taken into account for the purposes of that decision, it must be pointed out that such additional reasons cannot be successfully relied on before GC in order to make perfect potentially inadequate reasoning in the contested decision (Para. 71). Following was also found wrong: Rule 22(2) CTMIR does not prevent the BoA from exercising the discretion conferred on it by Article 76(2) CTMR in order to take into account any supplementary evidence produced for the first time before it (Para. 86). The Case-Law does not require a material connection between the supplementary evidence and the earlier evidence. It requires only that evidence submitted after expiry of the time-limit set by the OD not be the first and only proof of use, but that it be 'complementary' or 'supplementary' to relevant evidence which was lodged within the time-limit set (Para. 89). The fact that the applicant did not explain how the evidence produced for the first time before the BoA was complementary to the evidence adduced previously, nor why it had not adduced it by the time-limit set, is irrelevant since such an explanation is not required by the Case-Law (Para. 92 and 93). It is not necessary that the party concerned be unable to submit evidence within the time-limit in order for additional evidence of use of the mark submitted after expiry of the time-limit referred to in Rule 22(2) CTMIR to be taken into account (Para. 95). The Case-Law relied on by the Office, to the effect that a lack of statement of reasons, does not per se lead to annulment of the contested decision where it has no bearing on the issue of whether the contested decision is well founded, is ultimately inapplicable to the present case precisely because that condition is not met (Para. 99)

Case T-12/13 Sherwin-Williams Sweden AB v. OHIM; Judgment of 11 December 2014; language of the case: EN

RESULT: Action dismissed

KEYWORDS: Relative grounds, Likelihood of confusion, International registration, Figurative element, Typographical element, Well-known facts need no evidence, Identity of the goods and services, Dominant element, Visual similarity, Phonetic similarity

FACTS: The applicant sought to register the figurative mark reproduced below for goods in Class 2. An opposition based on the Benelux and International registration (with effect in ES and FR) of the word mark ARTITUDE, which cover goods in Class 2 was filed. As regards Article 8 (1) (b) CTMR, the Opposition Division (OD) upheld the opposition on the ground that there was likelihood of confusion (LOC) in the Benelux. The Board of Appeal (BoA) dismissed the appeal and found also LOC in France. Before the General Court (GC), the applicant alleges an infringement of Article 8 (1) (b) CTMR.

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CTMA

ARTI

Earlier marks: Benelux and IR (ES, FR)

ARTITUDE

SUBSTANCE: The GC notes that the level of attention of the relevant public is a legal parameter that has to be examined by the BoA even if the applicant does not raise it. Therefore, the applicant can raise it before the GC and is not required to adduce evidence in that regard, as the fact that the average consumer does not regularly buy goods such as paints, varnishes, lacquers etc. is a matter of common knowledge (Para. 37). The GC refers to the Case-Law according to which the fact that a type of product is not purchased regularly by the average consumer suggests that that consumer's level of attention will be fairly high. The BoA incorrectly found that the relevant public had an average level of attention. The goods are in part identical and in part highly similar. Not disputed by the applicant. Since the BoA held that the figurative elements of the CTMA are as important as the word element, the argument according to which nothing prevents the representation of the earlier word marks from being of the same colour and in the same typeface as the CTMA cannot be applied. Such premise is only relevant where the word element of the figurative mark is considered the dominant element and the figurative elements are secondary (Para. 61). There is a weak visual similarity, an average aural similarity and a weak conceptual similarity between the signs and thus there is a likelihood of confusion

Case T-50/13 Think Schuhwerk GmbH v. OHIM; Judgment of 18 November 2014; language of the case: DE

RESULT: Action dismissed

KEYWORDS: Absolute grounds, Descriptive element, Distinctive element, Lack of reasoning, Bad faith, Filing date, Priority

FACTS: The applicant sought the declaration of invalidity of the CTM VOODOO (word) registered for several goods in Class 25 based on Article 52 (1) (a) in conjunction with Article 7 (1) (b) and (c) CTMR and on Article 52 (1) (b) CTMR. The First Instance rejected the request for declaration of invalidity. The Board of Appeal (BoA) upheld that decision.

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VOODOO

SUBSTANCE: As regards descriptiveness and lack of distinctive character, the applicant contends that the term "VOODOO" in connection with goods in Class 25 would describe a specific style of clothing or footwear which is used in the Voodoo-religion. Consumers would immediately understand this relation and consider the registered mark as descriptive. The General Court (GC) confirms the conclusions in the contested decision that the evidence submitted by the applicant does not show that it is reasonable to believe that it will actually be recognised by the relevant public as a description of one of the characteristics of the goods (Para. 32). The applicant could not show that the BoA was wrong in concluding that the mark will be seen as a fantasy term which only has a vague reference to something occult or cultic (Para. 33). Consequently, the mark may not be considered as directly descriptive term nor does it constitute a laudatory message or an abstract indication of quality of the goods (Para. 51). In respect of the burden to show the applicability of the invoked absolute grounds, the applicant claimed that the BoA infringed Article 76 CTMR by saying that the applicant would have to show the applicability of the invoked absolute grounds for refusal. The GC interpreted this plea in the sense that the BoA had not taken into consideration some of the evidence put forward by the applicant and that it did don't undertake some further investigation (Para. 39). The GC concludes that the BoA did take into account all the evidence submitted during the administrative procedure as well as the information which may be generally accessed (Para. 41). Consequently, there is no infringement of Article 76 CTMR (Para. 42). On the bad faith issue, cf. (Article 52 (1) (b) CTMR), the first argument put forward by the applicant was that the CTM proprietor knew that the applied for mark would lack distinctive character, because the German Trademark Office (DPMA) refused registration of the same mark has been rejected by the GC. The refusal decision from the German Trademark Office has been notified after the relevant date for the assessment of bad faith, which is the date of filing (Para. 58). The applicant further contends that the intervener was in bad faith because it claimed also a priority based on the German mark which has been found not distinctive by the German Trademark Office. The GC refused that argument because a priority may be lawfully claimed from an application being the subsequent outcome of that application irrelevant (see Article 29 (3) CTMR) (Para. 59). Finally, the applicant inferred bad faith from the fact that the Intervener tried to circumvent the obligation of use of its prior CTM registration "VOODOO" for Class 25 (No. 1 911 742). It is interesting that the GC upheld in this respect

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the argument of the Office that there would be no bad faith, since the earlier CTM is registered for the Class headings whereas the later CTM has been registered for specific goods in Class 25. Therefore the Intervener applied for the second mark for the sake of clearness and preciseness of the scope of protection of its "VOODOO" mark and not in a fraudulent way (Para. 60).

Case T-405/13; Le Comptoir d'Épicure, A-Rosa Akademie Gmbh v. OHIM; Judgment of 12 December 2014; Language of the case: FR

RESULT: Action dismissed

KEYWORDS: Relative grounds, Similarity of goods and services,, Similarity of signs, Figurative marks, Admissibility, Proof of use, Right to be heard, First time on appeal, Phonetic similarity, Lack of reasoning, Conceptual similarity, Complementary goods and services, Nature of goods and services, Purpose of the goods and services, Co-existence of trademarks

FACTS: The applicant sought to register the figurative sign represented below as a CTM for Classes 29, 30 and 43. An opposition based on CTM and national registrations for goods in Classes (i.e.) 30 and 43 was filed on the grounds of Article 8 (1) (b) CTMR. The opposition was directed against all goods of the CTM. The Opposition Division partially upheld the opposition on the ground that there was likelihood of confusion. The Board of Appeal (BoA) confirmed the opposition decision. It concluded that there was a likelihood of confusion between the sign applied for and the earlier marks with respect to the identical or similar goods and services.

CTMA

Earlier marks

AROSA

SUBSTANCE: On the argument about the coexistence of trademarks, the General Court (GC) held that the arguments of the applicant did not fulfil the criteria of Article 44, Rules of Procedure (ROP)

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of the General court (GC), and they were therefore declared inadmissible and un-founded. On the proof of use issue, the GC considered that the request of proof of use as filed for the first time before the BoA was belated and therefore could not be considered admissible. (Para. 54) On the obligation to motivate, the GC held that the argument of the applicant that the BoA could not base its decision on judgments not published was not founded. Judgments are indeed published some minutes after they are pronounced in the web site of the European Court of Justice (CJ). Moreover the BoA's decision was well motivated and complied with the obligation provided in Article 75 CTMR. On the violation of Article 6 of the European Human Rights Convention (right to a fair trial), the GC confirmed that this provision is not applicable to the procedures before the BoA of the Office. On the relevant public and the level of attention, the assessment of the BoA was confirmed. The relevant public is the average consumer as the goods in question are daily consumption products. In regard to the comparison of goods in Classes 29 with services of Class 43, the GC held that the BoA did not make an error of assessment in finding that the goods in Class 29 are complementary with the services of Class 43 (Para. 96) in spite of their different nature, their different destination and their different utilisation. On the comparison between milk and milk products of Class 29 and cacao of Class 30, the BoA correctly concluded that there was a certain degree of similarity (Para. 99). On the comparison between jellies, jams and compotes of Class 29 and honey of the earlier CTM, the GC confirmed the BoA's approach that although these goods are different they can be used for the same purpose in pastry so there is a possible competition and interexchange between both and therefore a certain similarity (Paras. 100 and 102). On the comparison between vinegar in Class 29 and wine in Class 33, the GC confirmed the BoA's assessment that there is a low degree of similarity between these goods although one derives from the other and both can be used in cooking (Para. 105). On the comparison between treacle and honey in Class 30, the BoA's conclusion that both products have some degree of similarity was confirmed (Para. 107). On the visual comparison of signs, only the verbal earlier CTM AROSA was considered. Both signs share five letters in an identical order the last four being the word ROSA so this will attract the attention of the public. The signs are therefore partially identical (Para. 118). The rose in the contested CTM will be perceived as a decoration. In relation with the aural comparison, the assessment of the BoA that the signs share some phonetic similarity was confirmed (Para. 126). In relation to the conceptual comparison, the GC held that the BoA did not err in finding, in the contested decision, that the signs share a partial degree of conceptual similarity both signs having a connexion with the female name ROSA or the flower rose (Para. 128). Finally, in the global assessment of the likelihood of confusion done, the BoA was right to find that there is a likelihood of confusion between the marks at issue (Para. 134).

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Case T-591/13; Groupe Canal + Euronews v. OHIM, Judgment of 12 December 2014, Language of the case: FR

RESULT: Action dismissed.

Keywords: Relative grounds, Similarity of signs, Weak element, Identity of goods and services, Conceptual similarity, Phonetic similarity

FACTS: The intervener sought to register the verbal sign represented below as a CTM for Classes 35, 38 and 41. An opposition based on a French registration for services in Classes 35, 38 and 41 was filed on the grounds of Article 8 (1) (b) CTMR. The opposition was directed against all services of the CTM. The Opposition Division rejected the opposition on the ground that there was no likelihood of confusion. The Board of Appeal (BoA) confirmed the opposition decision. It concluded that there was no likelihood of confusion between the signs even for identical services.

CTMA
NEWS+
Earlier french marks
ACTU+

SUBSTANCE: Initially, on the relevant public and the level of attention, the assessment of the BoA was confirmed. The relevant public is not only the average consumer but also the professionals who have a higher level of attention. On the comparison of services, the General Court (GC) took note that the assessment of the BoA was not challenged by the applicant. In regard to the visual comparison of signs, the signs only share the sign +, although both signs have four letters none of them is in common. The presence of the sign+ in both signs cannot generate a visual similarity as this is mathematical symbol which implies a concept of increase so it only enjoys a weak distinctive character (Para. 29). In relation with the aural comparison, the assessment of the BoA that the signs do not share any phonetic similarity was not followed the GC estimated that the signs share a weak similarity on the phonetic side because of the presence of the sign + (Paras. 35 and 36). In relation to the conceptual comparison, the GC held that the BoA erred in finding, in the contested decision, that the signs do not share a conceptual similarity (Para. 47). In the global assessment of the likelihood of confusion done, the GC found that the services being identical, the weak phonetic similarity and the very strong conceptual similarities of the signs were neutralised by the visual differences between the signs that produce a

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different visual impact (Para. 51). Furthermore the sign+ has a weak distinctive character so there is no likelihood of confusion. The decision of the BoA was confirmed in spite of the errors in the assessment of the phonetic and conceptual similarity (Para. 53). A further argument in favour of the absence of the likelihood of confusion is in the fact that ACTU+ is a sign with a weak distinctive character for the services concerned (Para. 54).

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

RESULT: Action dismissed

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

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

CTMA
NAMMU
Earlier marks
NANU

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

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

Case T-75/13; Boehringer Ingelheim Pharma GmbH & Co. KG v OHIM; Judgment of 2 December 2014; Language of the case: EN

RESULT: Action partially upheld (Board of Appeal decision partially annulled)

KEYWORDS: Likelihood of confusion, Phonetic similarity, Relative grounds, Similarity of the goods and services, Similarity of signs, Visual similarity, Lack of reasoning

FACTS: The applicant filed a CTM application for the word mark Momarid for goods in Class 5. An opposition was lodged based on the earlier Community word mark LOMARID, registered for goods in Class 5. The Opposition Division (OD) partially upheld the opposition on the basis of Article 8(1) (b) CTMR. The Board of Appeal (BoA) partially annulled the OD decision to the extent that it had upheld the opposition for certain goods in Class 5. In particular the BoA considered the level of attention of the relevant public to be above average for pain- and fever-reducing medications (also available without prescription), and that the 'chemicals for pharmaceutical use' covered by the mark applied for were dissimilar to the goods covered by the earlier mark. The BoA found that the signs had a degree of visual and phonetic similarity slightly above average. The BoA stated that there was a likelihood of confusion as regards the identical goods but it ruled out the existence of a likelihood of confusion in respect of the goods which were similar to a low degree or dissimilar. The opponent filed an action before the General Court (GC) arguing an infringement of Article 75 and Article 8 (1) (b) CTMR.

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CTMA

Momarid

Earlier marks

LOMARID

SUBSTANCE: In relation to Article 75 CTMR, the GC argued that, in spite of the brevity of the BoA statement of reasons in regard of the degree of attention of the public, the applicant was, in view of the wording of the contested decision, in a position to understand that the level of attention was above average on the ground that all of the goods at issue related to the health of the end consumers. It follows that the statement of reasons for the contested decision was sufficient to enable the applicant to dispute the merits of such an assessment, which it has, moreover, done. The first plea put forward by the applicant, alleging infringement of Article 75 CTMR, was therefore rejected (Paras. 25, 26). In relation to its second claim, the applicant submitted in particular that the level of attention of end consumers of preparations for the reduction of pain and fever, such as those covered by the earlier mark, and also for dietetic products was to be regarded as low. The GC stated that, according to the Case-Law, medicines, whether or not issued on prescription, can be regarded as receiving a heightened degree of attentiveness by consumers who are reasonably well informed and reasonably observant and circumspect. Therefore, the applicant's argument was rejected (Para. 41). As regard the comparison of the goods, the GC found that, contrary to what was stated in the contested decision, the 'chemicals for pharmaceutical use' covered by the mark applied for may fall within the category of pharmaceutical preparation which include pharmaceutical preparations for the reduction of pain and fever covered by the earlier mark. Consequently, the BoA erred in finding that the 'chemicals for pharmaceutical use' covered by the mark applied for were dissimilar to the goods covered by the earlier mark (Paras. 75-78). In respect to the comparison of the signs, the GC found that the BoA was right in finding that the degree of visual and phonetic similarity between the signs at issue was slightly above average. As regard the global assessment, the GC confirmed that there was no likelihood of confusion between the marks at issue in respect of the goods which were considered to be similar to a low degree (Paras. 89, 94)

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Case T-440/13; Zakład Wyrobów Cukierniczych „Millano" Krzysztof Kotas v OHIM, Judgment of 11. December 2013, Language of the case: PL

RESULT: Action dismissed

KEYWORDS: Claim for allowing/rejecting CTM application/registration, Minimum degree of distinctiveness, Shape of the products, Three-dimensional mark, Admissibility, Competence of the GC/CJ, Competence of the Boards

FACTS: The applicant sought to register the 3D mark represented below for goods in Class 30 ("chocolate boxes"). The Board of Appeal (BoA) confirmed the refusal of the CTM application by the examiner pursuant to Article 7 (1) (b) CTMR with the reasoning that the mark consists of the usual shape of the product. The applicant filed an action before the General court (GC) claiming the infringement of Article 7 (1) (b) CTMR.

CTMA

SUBSTANCE: The head of claim requesting the registration of the CTM by the GC is inadmissible. The GC has no competence to give instructions to the Office (Para. 11). This request does not fall into the GC competence to alter the decision as the BoA was not competent to register the mark (Para. 12). There is no infringement of article 7 (1) (b) CTMR. The GC recalled its Case-Law related to the assessment of the distinctive character of the signs consisting of the shape of the product (paras. 18-20) and decided that the CTM applied for does not depart significantly from the usual shapes of the products on the market (Para. 24 et seq.) Even if the applicant was, as it claimed, the only producer using this shape of the product, it would not mean that the shape has the required distinctive character (Para. 28).

Case T-43/14; Heidrick & Struggles International Inc. v OHIM, Judgment of 12 December 2014, Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Absolute grounds, Descriptive element, Characteristics of the goods and services

FACTS: The Board of Appeal (BoA) had confirmed the refusal, on the basis of Article 7 (1) (c) (and therefore on Article 7 (1) (b) too, of the CTMA for the sign THE LEADERSHIP COMPANY for services in Classes 35

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and 44, namely: Class 35: 'Executive recruitment services; recruitment, business management and business administration consultation services' – Class 44: 'Psychological consultation services; including assisting individuals, organizations and communities identify goals and develop strategies for working towards and accomplishing those goals'. The BoA had considered that the appeal was directed against only 'executive recruitment services' and 'recruitment consultation services' in Class 35. The applicant lodged an appeal to the General Court (GC), asserting that the relationship between the sign and the services was not direct and specific, and could not be established without further consideration. The services applied-for are not leadership services. Moreover, recruitment can concern many low-level employees who are not considered leaders. It argued that no direct link exists in the relevant public's mind.

CTMA

THE LEADERSHIP COMPANY

SUBSTANCE: The GC rejected all these arguments, recalling that a sign can be refused registration on the basis of Article 7(1) (c) of Regulation No 207/2009 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (Judgment in C-51/10P Agencja Wydawnicza Technopol v OHIM). For the relevant English-speaking public, with a high degree of attention, THE LEADERSHIP COMPANY is, from the relevant public's point of view, descriptive of 'executive recruitment services' and 'recruitment consultation services'. It is irrelevant if leadership is equally important in many other services. Moreover, the existence of weaker or lower-level candidates does not negate the existence and value of top-level ones. The application was dismissed and the applicant ordered to pay costs.

Case T-69/14; Research and Production Company « Melt Water » UAB v OHIM, Judgment of 14 January 2015, Language of the case: LT

RESULT: Action dismissed

KEY WORDS: Absolute grounds, Characteristics of the goods and services, Figurative element, Labels, Dominant element

FACTS: The applicant sought to register the figurative mark for goods in class 32. The examiner refused to register the sign as a CTM on the basis of Article 7 (1) (b) and (c) CTMR. The Board of Appeal (BoA) dismissed the applicant's appeal. The applicant filed an action before the General Court (GC).

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CTMA

SUBSTANCE: The GC based its analysis on Article 7 (1) (c) CTMR and confirmed the assessment of the BoA. The relevant public is the English speaking public of the EU and the average consumer of the EU (Para. 23).The meaning of the verbal elements of the signs MELT WATER and ORIGINAL point the consumers to the goods in question, the mark informs the relevant public that the products of Class 32 are made of natural pure water coming from glacier melted water (Para. 26). In relation with the figurative elements of the sign the GC approved the conclusion of the BoA that they are not distinctive, the rectangle is a form used in labels and that the font of the word original is usual in labels of beverage packaging. As regards the colour blue it is not a particular colour for the goods in question. Pure water is often described as being blue (Para. 36).The GC concluded that the figurative elements were not more dominant than the verbal ones (Para. 27). The sign is therefore descriptive for the goods on the basis of Article 7(1) (c) CTMR. As one of the absolute grounds is enough to reject the application the BoA was correct in omitting to examine the ground of the violation of Article 7(1) (b) CTMR.

Case T-70/14; Research and Production Company « Melt Water » UAB v OHIM, Judgment of 14 January 2015, Language of the case: LT

RESULT: Action dismissed

KEY WORDS: Absolute grounds, Three-dimensional mark, Distinctive element, Shape of the product

FACTS: The applicant sought to register the 3-D mark for goods in Class 32.The examiner refused to register the sign as a CTM on the basis of Article 7(1) (b) considering the shape did not depart significantly from shapes of the relevant market. The Board of Appeal (BoA) dismissed the applicant's appeal. The applicant filed an action before the General Court (GC).

CTMA

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SUBSTANCE: The GC confirmed the assessment of the BoA. The relevant public is the average consumer of the EU (Para. 24).The GC analysed the different elements of the bottle claimed to be different from the shapes available in the market, reproducing the Case-Law on 3-D marks. The GC confirmed that neither the shape (Para. 30) of the bottle nor the neck (Para. 31) or the height (Para. 32) is very different from bottles available in the market. The GC remarked that the reproduction of the mark did not allow the perception of the size of the bottle in comparison with other bottles available in the market. In relation with the upper part of the bottle claimed to have a diamond shape the GC confirmed that this element did not depart significantly from other bottles of the market (Para. 34). It also confirmed that contrary to the statement of the applicant, the assessment of the BoA was made in conformity with the Case-Law reproduced and summarised in paragraphs 21 and 22 of the judgment. The 3-D mark lacks therefore distinctive character and was correctly refused on the basis of Article 7 (1) (b) CTMR.

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Decision of the Second Board of Appeal of 26 November 2014 in case R 799/2013-2 (EN)

Absolute grounds for refusal – Article 7(1)(b) and 7(3) CTMR – distinctiveness and acquired distinctiveness

The applicant sought to register the following 3D mark

for goods in Class 33, namely 'Alcoholic beverages excluding beers'.

The examiner rejected the application under Article 7(1)(b) CTMR stating that the trade mark lacked distinctive character. As to Article 7(3) CTMR, the applicant referred to market research regarding the consumer's perception regarding the MALIBU brand, and provided sales and advertising figures for the original MALIBU brand. The examiner stated, inter alia, in this respect that the questions answered in the market research referred to the original MALIBU brand as such and not solely to the bottle shape now at issue and that each mark had to be examined on its own merits.

The applicant appealed the examiner´s decision.

With regard to Article 7(1)(b) CTMR, the Board held that the examiner committed no error in finding that the average consumer in the European Union would perceive the contested trade mark, as a whole, merely as a variant of the shape of the goods for which registration of that trade mark was sought. Thus, the Board found that it had not been documented that the mark departed sufficiently from what was customary in the sector. The argument that the Office had already registered a very similar bottle – an outdated version of the bottle now at issue – was not decisive, especially since this registration was based on acquired distinctiveness through use. Also, the acceptance of the bottle here

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applied for in the United Kingdom, although clearly taken into consideration, could not change these conclusions.

In relation to acquired distinctiveness, Article 7(3) CTMR, the Board argued that the core features of the earlier registration and the MALIBU bottle, subject of the present application, were practically identical with the exception of an additional feature, the transparent section at the base. Thus, the only different essential element was an element which enhanced the distinctiveness of the earlier bottle and based on which the mark here applied for was accepted for registration per se in the United Kingdom. Based on this, it seemed reasonable to also take into consideration the documentation as regards acquired distinctiveness in relation to the earlier registered bottle. The applicant filed a huge amount of additional evidence before the Board, so the background for the evaluation by the Board was not the same as before the examiner. Firstly, it showed impressive and long-standing sales of very large quantities for very considerable amounts, and also sales in all the countries of the European Union. Secondly, the applicant presented a report from Nielsen Global AdView regarding the advertising expenses during the years 2006 to 2012. Thirdly, in the spirits world ranking lists, the ranking of MALIBU was, during a number of years preceding the application, at No 5 within the category 'flavoured spirits brands'. Fourthly, the applicant showed, by market analysis in two of the largest EU countries, that the earlier registered bottle was well known and functioned as a trade mark. It was emphasized that there should be no absolute requirement that the relevant public states that the bottle is Malibu, but the test was if the bottle alone was perceived as an indication of origin. These market analyses could be extrapolated, taking the impressive sales and advertising figures into consideration, and the fact that that perception was confirmed by declarations from trade organisations. Fifthly, the applicant filed statements from the Spanish and Swedish associations for producers and distributors of spirits according to which the naked bottle allowed a consumer to identify it as a bottle of Malibu. Although alcoholic beverages are sold in every conceivable form of bottle, those bottles were normally not white, as the bottle here at issue. Furthermore, the transparent 'window' at the bottom was unusual. One could, therefore, expect that the design of the bottle here at issue was so special in its entirety that it would be easier for it to acquire distinctiveness through use and thereby serve as a sign to identify the origin of the goods. The fact that the bottle was accepted as inherently distinctive in the United Kingdom also spoke in favour of the mark applied for being a borderline case, which meant that the evidence in relation to acquired distinctiveness could not be required to be as comprehensive as regards a completely descriptive word mark. At least a significant part of the relevant public identified the goods as originating from a particular undertaking because of the mark. The mark applied for was,

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consequently, found capable of distinguishing the goods in question from those of a different commercial origin.

Therefore, the Board annulled the contested decision.

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Decision of the Fifth Board of Appeal of 8 December 2014 in case R 1226/2014-5 (DE)

Opposition – Article 8(1) CTMR – lack of reasoning – Article 75 CTMR

The applicant sought to register the word mark 'BREWNADE' for goods and services in Classes 20, 32 and 43.

The opponent filed an opposition pursuant to Article 8(1)(b) and (5) CTMR based on two earlier 'BIONADE' CTMs.

The Opposition Division rejected the opposition as to Article 8(1)(b) CTMR because of a lack of likelihood of confusion. As to Article 8(5) CTMR, the Opposition Division ruled that the opponent had not complied with all its requirements.

The opponent filed an appeal against the decision.

The Board found that the case should be remitted to the Opposition Division due to its lack of reasoning pursuant to Article 75 CTMR. The Opposition Division took the contested decision before the end of the opponent's deadline to file a statement. Apart from that the contested decision's reasoning was contradictory and incomprehensible. The decision on appeal outlined how to comply with the duty to state reasons and the consequences that flow from a lack of reasoning.

The Board, therefore, annulled the contested decision and remitted it to the Opposition Division.

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