

Alicante News

Up to date information on IP and OHIM-related matters

Quick Links 

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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



**IP Caselaw
Conference at
OHIM**



IPCLC
IP Case Law Conference

Sakari Salonen talks to James Nurton

First Page



IP Case Law Conference at OHIM

The world of IP case law is a vibrant and constantly moving one.

Every year, thousands of pages of analysis are devoted to judgements and decisions that in turn contribute to a dynamic and growing jurisprudence at EU, regional and national level.

With over 2,700 decisions during 2014 – a figure that is growing year on year – the Boards of Appeal at OHIM is a strong contributor to the body of IP case law in the EU.

As a result, the first ever IP Case Law Conference at OHIM, which takes place on May 5 and 6, 2016, is being organised by the Boards of Appeal.

The conference is dedicated to substantive and procedural issues surrounding trade mark and design dispute resolution, and brings together an array of senior figures in the world of IP to discuss and debate important issues at EU, national and international level.

The event brings together together users of the international IP systems, IP professionals, judges, national and European level institutions and administrations.

The format of the conference is innovative and user-focused, and continues the format used in the successful IP Mediation Conference held in Alicante in 2014. Seasoned moderators will lead discussions among panelists, before moving on to questions from the floor.

The aim is to make the event as participative and as interactive as possible, with presentations on recent OHIM Boards of Appeal and EU case law topics.

The conference will take place in OHIM's headquarters in Alicante, Spain. Registration is now open through a dedicated web page and a registration fee of €150 will apply. All delegates will receive a certificate of attendance.

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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



The James Nurton Interview



Sakari Salonen, Castrén & Snellman, Helsinki

When did you become interested in IP?

I really became interested in IP law while I was an exchange student at the University of Maastricht in the Netherlands. It was a great place to study and I took IP courses as I wanted to try something new. I found both patent and trade mark law very interesting.

When I returned to Finland I decided to explore IP further and got a trainee position in a major firm in Helsinki. I have now been working in IP for many years and I love it. I am a lawyer so I mainly focus on litigation and commercial matters in all areas of IP,



Sakari Salonen

including advertising and marketing law, franchising and anti-counterfeiting work. I used to chair the Finnish Anti-Counterfeiting Group.

I also do some prosecution work, though luckily I have colleagues who specialise in that. Our IP group includes 12 lawyers and two trade mark and design attorneys. We launched an IP prosecution practice last November due to clients' needs. It is a trend in the Finnish market: many patent and trade mark attorneys have hired litigation lawyers, and the lawyers are now hiring trade mark and design attorneys! I think clients are attracted by the full-service one-stop shop.

Is there a lot of anti-counterfeiting work in Finland?

Anti-counterfeiting was really a big issue for many years. But after the Nokia and Philips cases at the CJEU, Finnish Customs basically stopped seizing fake goods in transit. We used to see a lot of goods coming from China into Helsinki harbour, which were being shipped on to Russia.

The development in the case law gave a real problem for Customs and IP proprietors, so the amount of work has decreased a lot. Instead, brand owners have to take action in the country where the products end up – which is Russia in many cases.

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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



The James Nurton Interview



Now the new EU reforms provide that goods in transit can be seized, provided they are infringing in the final destination. We look forward to seeing if it has any real effect. We hope that it does.

How does the Finnish IP office compare with OHIM?

There are some differences actually. The main one is that the Finnish office examines earlier national and CTM rights of its own motion, so the examination is more thorough. That is quite different from OHIM, where only the proprietor of the earlier mark can raise this issue by filing an opposition or an application for a declaration of invalidity on relative grounds.

One problem we have in Finland is that third-party oppositions can take a lot of time, even many years. I think that is just down to lack of resources and the number of cases we have.

Are people happy with relative grounds examination?

At the moment I think we are somewhat happy with the relative grounds system. It means the registered right has been properly handled and there are fewer issues regarding invalidation: you can be fairly certain that you have a valid right once it is granted. One issue that we have noted, however, is that the Finnish office evaluates figurative marks almost like word marks in connection with refusal decisions which creates more work and costs for proprietors.

I saw there have been some recent changes to the fees in Finland?

Yes. For example, if you need to change the representative details, it used to cost €50 per mark, but now it is free. This was very positive change.

On the other hand, for litigation at the Market Court, which now handles all IP cases, the fees have just been increased and the trial fee for companies is now €2,000. That is quite high but probably not enough to make you think twice about litigating.

How well is the Market Court working?

It is very good. They have hired IP specialists as judges and you can basically get a final judgment in a trade mark case in about a year and in a patent case in about one-and-a-half to two years. That judgment in most cases is final, because the only appeal is to the Supreme Court, and the Supreme Court only gives leave to appeal in less than 10% of cases.

What do you think of OHIM?

We are very satisfied with the speed of handling of applications and I think the decisions and office actions are well drafted. I would like to see the Finnish Office give similar well-reasoned decisions.

OHIM is a wealthy office and I would love to see more investment in electronic services. For example,

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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



The James Nurton Interview



we still have to use fax for certain communications, such as limiting the list of goods and services, or proving use of the mark in opposition proceedings.

I love e-filing: I find it very quick and easy, so I would like to see it extended to all actions after the filing. The Finnish office has been developing these services too, which is welcome. We can do a lot of things by email, and the Office has invested money in becoming more proactive and more customer-friendly.

Are there any interesting cases in Finland at the moment?

There have been quite a few unfair competition cases. According to the law you can combine claims for trade mark infringement and unfair competition whereas before that required two different proceedings. And the way the Market Court interprets unfair competition law has been very useful. For example, in cases involving trade names or domain names, you can include unfair competition so you don't have to rely solely on a specific IP law. That is also useful for cases involving well-known trade marks.

Are there any other important developments that you see?

In Finland we are looking closely at the EU trade mark reforms. I think the amendments are generally very good, especially the need to specify goods and

services. This should help address the cluttering of the registers; the use of class headings has created a lot of obstacles, so it is good that you will have to specify exactly what you want to use the mark for.

Another issue is the increasing importance of services thanks to digitalisation. More and more businesses are competing on who offers the best service, so they have to be careful to ensure that is protected in their trade mark portfolio.

Three-dimensional trade marks are also a big issue in Finland. We have successfully prosecuted two or three cases in Finland, but OHIM is still very reluctant to accept any 3D trade marks. We have one case pending before the CJEU where the CTM application was not accepted, though the mark was already registered in Finland. This case involves a product packaging, where over 90% of the Finnish consumers recognised the shape. Another was for the Crocs shoes, which was registered in 2008 without any logos and is still valid. Of course, you need to have very good consumer surveys to get these registrations.

What has been the most interesting case you have worked on?

The largest I case I have worked on was at my previous firm, and involved two big Finnish listed companies in a major trade mark and trade name dispute. They had essentially the same brand and

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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



The James Nurton Interview



there were also some geographical name issues. It was an international dispute with proceedings in different courts in Russia, Switzerland, South Africa and the UK and multiple office actions. I think the final damages claim in Finland was €17 million and the case was eventually settled.

We had several lawyers working on just that one case for over two years and it was very interesting work as it involved almost all aspects of trade mark law, such as well-known trade marks and hostile filings. It was also widely covered in the media.

What do you expect for the future?

I think the workload will increase, especially with the changes coming in. Litigation has become active as companies understand the value of IP more than they used to and are more willing to enforce their rights. That is true of trade marks and patents and especially designs: we are seeing more design infringement cases and there are several involving RCDs in Finland at the moment. For example, we acted for BMW in an interesting case against replica rim sellers, which also addressed several tricky questions about spare parts.

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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



Community Trade Mark



Nice 10/2016: KCG&S Issues

On 1st January the 2016 version of the 10th edition of the Nice Classification comes into force (see [Communication No 2/15](#) of the President of the Office). As this is a new version (annual), not edition (every five years), the changes are limited to additions to, and deletions from, the alphabetical list and small modifications or corrections to the wording of existing entries.

The most significant change, as already anticipated in the May 2015 edition of [Alicante News](#), is to the class headings. Class heading indications which were seen as being imprecise in eleven classes have been amended or deleted, mainly to: (i) avoid the use of vague terms or (ii) to remove the phrase “not included in other classes” which does not add any value to the terms it follows.

In many cases, the indications which were changed or deleted correspond to the class heading indications already objected to by the Office (see the Guidelines Part B, Section 3, Classification, paragraph 4.2, available [here](#)). The [Common Communication on the Common Practice on the General Indications of the Nice Class Headings](#) will be updated to reflect this new practice- the number of class headings affected in this Communication will be reduced accordingly. The Explanatory Notes of the classes that have been amended have also been expanded in order to represent the indications that have been removed from the class headings.

Some of the additions to the terms in the alphabetical list concern the area of wearable technology: the term smartwatches has been added to Class 9. These goods are seen as having the function more of communication devices than horological instruments; other similar additions are the terms wearable activity trackers, connected bracelets [measuring instruments] and smartglasses, all of which clearly show that the primary function and purpose of the goods dictates their classification. And, up-to-the-minute as ever, the Nice Classification will now include selfie sticks in Class 9.

Other additions illuminate areas which previously may not have been so clear: a number of terms in Class 1 make it clear that this is the class for ingredients for use in manufacture. These terms include proteins for use in manufacture, vitamins for the food industry and collagen for industrial purposes. The inclusion of these terms shows that there is a clear division between products which are destined to be used as an ingredient, and those which will be consumed by the end user.

All of the new additions have been included as Nice terms from 1st January in the HDB (Harmonised Database), which may be accessed via TMclass, and they will be automatically accepted in new applications from that date. As set out in the Communication of the President, no reclassification of existing marks will be possible: the filing date of the application will dictate the version and edition of the Nice Classification applicable.

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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



Registered Community Design



Déjà Vu Reference

The last edition of [Alicante News](#) reported on the amendments to the Office's Guidelines on the Examination of Design Invalidity Applications, which entered into force on 1 February 2016. The report noted that the reference to a "déjà vu" given in respect of how to determine an "individual character" has been eliminated in order to prevent the wrong impression that a "déjà vu" is the central and established test in assessing individual character, which has not sufficient support in case-law.

In the wake of this report the Office was approached as to whether this deletion entails any change of practice, as posted on the design law blog of a user association.

In response, we would like to clarify that the omission of said "déjà vu" reference does not reflect any intention to change the Office's examination practice under Article 6 CDR.

The [1993 proposal of the European Commission](#) for Article 6 CDR mentioned in the explanatory memorandum the "déjà vu" in brackets, following the statement that the overall impression of two designs may be one of similarity even despite an important number of details. This reference to a "déjà vu" was echoed in passing in a judgement of the General Court (judgment of 7/11/2013, [T-666/11](#), 'Gatto domestico', para. 29). However, this concept was not reiterated in subsequent case-law, let alone elaborated on.

In the Office's view, it remains a fairly vague concept bearing in mind the generally accepted definition of a "déjà vu" as the feeling of having exactly the same experience as one you have had before. More importantly, it proved to be of little help for examiners assessing individual character and consulting the Guidelines, the primary aim of which is to be of practical use both to Office staff in charge of the various procedures and to users of the Office's services. On the contrary, for trade mark examiners accustomed to a comparison of trade marks based on the relevant consumer's imperfect recollection, who are being trained to also render decisions on design invalidity cases, the Guidelines' former reference to the "déjà vu" right at the outset of the section explaining the individual character test may well have been confusing. It evoked the idea that two designs, like two trade marks, are compared based on the informed user's memory. Whilst the case-law does not rule out that a direct comparison may be impracticable or uncommon in the sector concerned (see judgment of 18 October 2012, [C-101/11 P](#) and [C-102/11 P](#), 'Ornamentación', para. 54), in principle, the individual character is assessed based on a side-by-side comparison of the conflicting designs.

For the time being, monitoring the further development of the case-law, the Office therefore decided to simply delete the reference to the "déjà vu", following also the suggestion by a user association.

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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

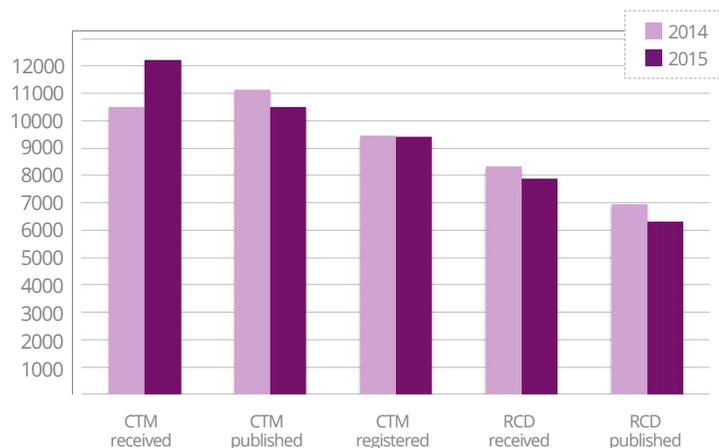


Statistical Highlights



Monthly statistical highlights December*	2014	2015
Community Trade Mark applications received	10 496	12 217
Community Trade Mark applications published	11 114	10 506
Community Trade Marks registered (certificates issued)	9 439	9 403
Registered Community Designs received	8 316	7 881
Registered Community Designs published	6 942	6 307

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



First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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



The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

As of 19 January 2016, the Brazilian National Institute of Industrial Property (INPI-BR) has joined TMclass.

This last addition brings the total number of national and regional IP Offices, including OAPI, WIPO and OHIM, in the tool to 58.

TMclass now offers users the opportunity to search and translate terms to and from any of the 40 available languages.

This successful integration is the result of the joint effort and cooperation within the framework of the International Cooperation Programme managed by OHIM in collaboration with its international partners.

You can find out more at www.tmdn.org and <http://oami.europa.eu/ec2>

Changes to trade mark and design fees in Finland

The Finnish Patent and Registration Office (PRH) has announced changes to its fee structure for trade marks and designs.

Some changes to registered trademarks are now free of charge, such as changes to the owner's name or domicile, and changes of representative. The fee for other changes, such as transfer or pledging, has been raised from 50 to 100 euros.

For renewals of trademarks and collective marks, PRH has introduced a two-tier pricing system, in which the fees for renewals done online in Finnish or in Swedish are lower than if conducted via paper forms. The renewal fee is 275 euros if done online, and 300 euros if done via paper forms.

Designs have undergone a similar fee revision, with some services now free of charge and an adjustment in the fee for other changes, as in the case of trade marks.

The design application fee is now 215 euros if conducted online and 250 euros if conducted via paper forms. The fee for multiple registrations has been raised for applications and renewals.

For more information on these and other changes, in Finnish, Swedish and English, please consult PRH's website at: <https://www.prh.fi/fi/index.html>

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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



EU trade mark reform legislative package published

The package comprises a new EU Trade Mark Directive (harmonising the trade mark laws of the EU Member States) and a series of amendments to the EU Trade Mark Regulation (which sets out the rules applicable to EU trade marks and to the Office). It marks the culmination of the work that has been carried out during the last seven years on the reform of the EU trade mark system.

Under the provisions of the amending **Regulation (2015/2424)**, the name of the Office for Harmonization in the Internal Market (OHIM) will change to the **European Union Intellectual Property Office (EUIPO)**. This change will come into effect on March 23, 2016, when the legislation enters into force.

The Community trade mark, administered by the OHIM since 1996, will be renamed the European Union trade mark on March 23, 2016. On that date all Community trade marks will automatically become **European Union trade marks**; users do not have to take any action.

The **fees** payable to the Office will also change under the amending Regulation. There will be:

- A new one-fee-per-class system for trade mark application and renewal fees
- An overall decrease in trade mark application and renewal fees payable to the Office.

More detail on the revised fee structure, and the other technical changes which will enter into force on March 23 are available on [OHIM's dedicated website section](#).

Moreover, on March 23, 2016, the date of entry into force of the amending Regulation, all the Office's online tools and services will be fully updated to reflect the changes in the fee structure. The online fee calculator and list of fees payable will also be updated. On March 23, 2016, an updated version of the Guidelines for Examination will also enter into force, which will reflect the changes introduced by its amendments in the Office's trade mark examination practice.

The new **Directive (2015/2436)** entered into force 20 days after its publication in the Official Journal, but the Member States have three years to transpose them into their national law (seven years as regards the provision of an administrative procedure for the cancellation of national marks).

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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



More News



Communication of the President of OHIM: renewal fees

In view of the entry into force of the amending EU trade mark Regulation on March 23 2016, the President of OHIM has published a [Communication](#) concerning the calculation of the amount of renewal fees.

The Communication states that the due date for the purpose of calculation of a renewal fee is the date of expiry of the CTM to be renewed.

CTMs expiring before March 23 2016 will be subject to the fees established in the [current fee structure](#), even in the event that renewal is requested and paid for after March 23, 2016.

CTMs expiring on or after March 23, 2016 will be subject to the fees structure established in the [amending EU trade mark Regulation](#), even in the event that renewal was requested and paid for before the entry into force of the Communication (on February 1, 2016).

Reimbursements to users: renewal fees

The Office is committed to reimbursing its users who have already paid for the renewal of a trade mark expiring after March 23, 2016 under the CTM fee schedule.

These users will be refunded the excess fee they have paid; equal to the difference between the CTM fee schedule and the EUTM fee schedule.

The reimbursement method will vary according to the payment method

- Users who have indicated “debit later” will see a correction in the “Pending Debit “ tab of Current Account information in the User Area, once the Office has corrected the expected debit (during February and March 2016). No individual communication will be sent to these users.
- Users who have paid by the “debit now” method will be directly reimbursed in their current account, and a letter informing them about the reimbursement will be sent to them.
- Users who have paid by bank transfer or credit card will receive a letter from the Office requesting bank details through which the reimbursement can be paid.

Letters informing about current account reimbursement or requesting bank details will be sent during the months of April to August following a First Paid, First Reimbursed approach.

Reimbursement to users having paid with bank transfer or credit card will be done within two months after the reception by the Office of their bank details.

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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



More News



The [Communication of the President of OHIM](#) on the calculation of the amount of renewal fees in view of the entry into force of the amending EU trade mark Regulation is available here.

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 Award 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 intellectual property office, a division of the Italian Ministry of Economic Development.

New EU trade mark Regulation – resources for users

To prepare our users for the amending EU trade mark Regulation, which enters into force on March 23 2016, the OHIM Academy has organised a webinar on February 2 at 11:30-13:30 CET entitled “Questions and Answers on the new EU trade mark Regulation: Changes entering into force within 90 days of publication.”

The broadcast will cover issues related to Absolute Grounds, Relative Grounds, Proceedings, the Register, Goods and Services, Appeals and the content of the new Regulation itself. The webinar will be available through [this link](#).

More details on the amending Regulation can be found on our [dedicated web page](#), which carries information on the changes that will be applicable

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



More News



to the Office under the amending Regulation, plus a selection of resources. In addition, [our 2016 workshop series](#) gives users a chance to learn more about the changes under the amending Regulation, with a programme of events planned across the EU.

Publication of online advertising study

A new study, "[Digital Advertising on Suspected Infringing Websites](#)" has been published by the EU Observatory on Infringements of Intellectual Property Rights.

The study looks at how digital advertising supports suspected infringing websites and quantifies the prevalence and profile of that advertising.

It analyses the brands and sectors supporting the websites with their advertising and the ad companies placing those ads.

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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

Case law



Luxembourg trade mark and design news

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

Case C-270/14P; Debonair Trading Lda v OHIM; Judgment of 15 October 2015; Language of the case: EN

RESULT: Appeal dismissed

KEYWORDS: Likelihood of confusion, Common element

FACTS: The CTM applicant sought to register the word mark SÔ:UNIC as a CTM for goods in Class 3. The Opposition Division (OD) rejected the opposition. The Board of Appeal (BoA) dismissed the appeal. The General Court (GC) partially annulled the BoA's decision (insofar as it rejected as inadmissible the opposition based on some of the earlier rights) and dismissed the action as to the remainder. The opponent filed an application before the European Court of Justice for the partial setting aside of the judgement under appeal (insofar as it dismissed its action).

CTMA

SÔ:UNIC

Earlier marks

1. SO...?
2. SO...? ONE
3. SO...? CHIC

SUBSTANCE: If the likelihood of confusion with regard to a family of marks results from the possibility that the relevant public may believe that a mark in respect of which registration is sought is part of the same family as that formed by earlier trade marks, it is then necessary, in order for that likelihood of confusion to exist, that the mark concerned should have characteristics which might suggest that it belongs to the family of marks in question. The BoA's approach cannot be regarded as incorrect in itself in so far as it initially consisted of ascertaining whether there was an element enabling the mark applied for to be associated with the family of marks relied on in order subsequently to examine, in the context of a global assessment, whether consumers were likely to establish a connection between that

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



Case law



mark and that family of marks, and whether there was a possibility that consumers might perceive the former as a new member of the latter (Paras. 34-35). In order to arrive at the conclusion that the mark applied for could not be associated with the family of marks relied on, the GC correctly relied, first, on the finding that the element “so...?” shared by the earlier trade marks liable to form the family of marks relied on did not coincide with the element “sô:” of the mark applied for and, second, on the lack of any other factor connecting the marks concerned (Para. 36).

However, the existence of a likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case. In order to complement its assessment, the GC correctly emphasised the fact that the BoA had drawn attention to differences between the mark applied for and the family of marks relied on relating to, inter alia, the perception of the marks at issue from a conceptual point of view, and explained that the conceptual point of view was an essential element in the context of a family of marks. The GC also examined the structure of the marks under comparison, taking into consideration the influence of both the shared element of those marks, which it identified as being the modifier “so”, and the element specific to the mark applied for — the term “unic” — on the perception that the relevant public might have of those marks. In the context of that examination, it found that there were substantial structural differences between the marks in question (Paras. 37-39).

Case C-20/14; BGW Beratungs-Gesellschaft Wirtschaft mbH v Bodo Scholz; Preliminary ruling of 22 October 2015; Language of the case: DE

KEYWORDS: Abbreviation, Acronym, Common element, Descriptive element, Dominant element, Figurative trade mark, Function of trade mark, Likelihood of confusion, Similarity of the goods and services, Suspension of the proceedings

FACTS: On 11 December 2006, the word mark BGW Bundesverband der deutschen Gesundheitswirtschaft was registered at the German Patent and Trade Mark Office inter alia for goods and services in Classes 16, 35, 41 and 43. BGW brought an opposition to that registration, on the basis of the German word and figurative mark, registered for goods and services in Classes 16, 35 and 41 and represented below.

The German Patent and Trade Mark Office upheld the opposition brought by BGW in part and partially cancelled the registration of the later mark.

BGW brought an action for annulment of that decision before the Federal Patents Court who decided to stay the proceedings and to refer the following question to the European Court of Justice (CJ) for a preliminary ruling:

“Must Article 4 (1) (b) of Directive 2008/95 be interpreted as meaning that, in the case of identical and similar goods and services, there may be taken to be a likelihood of confusion for the public if a

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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

Case law



distinctive sequence of letters which dominates the earlier word/figurative trade mark of average distinctiveness is made use of in a third party's later mark in such a way that the sequence of letters is supplemented by a descriptive combination of words relating to it which explains the sequence of letters as an abbreviation of the descriptive words?" The Federal Patents Court has asked that question in the light of the doubts which it has as regards the application of the judgment in Strigl and Securvita (C-90/11 and C-91/11, EU:C:2012:147).

Later mark

BGW Bundesverband der deutschen Gesundheitswirtschaft

Earlier mark



SUBSTANCE: The CJ agrees with the national court that the relevant public's perception of a sign cannot be dependent on the ground for refusal of registration in question. However, the CJ states

that the angle from which that perception is viewed varies according to whether what is being assessed is the descriptiveness of a sign or the existence of a likelihood of confusion (Para. 27).

The CJ also rules that in the light of the different legal context of the cases which gave rise to the judgment in Strigl and Securvita (C-90/11 and C-91/11, EU:C:2012:147) and the scope which must be attributed to that judgment, the findings in it are not capable of being applied to the main proceedings for the purposes of assessing whether there is a similarity between the two marks at issue (Para. 34). The CJ insists that in the present case, it will be for the national court to ascertain the overall impression made on the relevant public by the later mark (Para. 41), in particular the national court shall examine, if necessary, whether the elements of which the later mark consists, taken as a whole, form a separate logical unit which has a different meaning from that of those elements taken separately (Para. 43).

However, according to the CJ the mere fact that the later mark consists of a sign reproducing the letter sequence that constitutes the only word element of the earlier mark and of a combination of words the initial letters of which correspond to that sequence cannot, on its own, preclude a likelihood of confusion with that earlier mark (Para. 42).

Finally, the answer to the question referred is that Article 4 (1) (b) of Directive 2008/95 must be interpreted as meaning that, in the case of identical or similar goods and services, there may be a likelihood of confusion on the part of the relevant

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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

Case law



public between an earlier mark consisting of a letter sequence, which is distinctive and is the dominant element in that mark of average distinctiveness, and a later mark which reproduces that letter sequence and to which is added a descriptive combination of words, the initial letters of which correspond to the letters of that sequence, with the result that that sequence is perceived by that public as the acronym of that combination of words (Para. 44).

Case C-603/14P; El Corte Inglés SA v OHIM; Judgment of 10 December 2015; Language of the case: ES

RESULT: Action partly upheld (BoA decision partly annulled)

KEYWORDS: Admissibility, Conceptual similarity, Infringement, Reputation, Similarity of the signs, Unfair advantage, Likelihood of confusion

FACTS: The applicant sought to register the word sign The English Cut as a CTM for goods and services within Class 25.

An opposition based, inter alia on the earlier word mark El Corte Inglés and the Community figurative marks represented below was filed.

The Opposition Division dismissed the opposition and the Board of Appeal (BoA) dismissed the appeal. The General Court (GC) found a “low” degree of conceptual similarity between the signs, but took

the view that the signs were dissimilar overall. As a consequence, Article 8 (1) (b) cannot be applied because there is no likelihood of confusion (LOC) and Article 8 (5) CTMR is not applicable either. The opponent filed an appeal before the European Court of Justice (CJ).



SUBSTANCE: The CJ found no distortion of facts and declared inadmissible the alleged infringement of Article 8 (1) (b) CTMR.

The CJ upheld the third ground of appeal alleging infringement of Article 8 (5) CTMR. The GC erred in law in ignoring that the degree of similarity of the signs necessary to apply Article 8 (1) (b) and 8 (5)

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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

Case law



CTMR is different (Para. 41), as the latter does not request a finding of LOC, but just a link between the signs (Para. 42).

Since a certain degree of (conceptual) similarity was found between the signs, the GC should have examined whether that degree of similarity, albeit low, was not sufficient, on account of the presence of other relevant factors such as the renown or reputation of the earlier mark, for the relevant public to establish a link between those signs, for the purpose of Article 8 (5) CTMR (Paras. 43-48) (see Golden Balls, C-581/13P and C-582/13P, Para. 73).

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

Case T-278/10RENV; riha WeserGold Getränke GmbH & Co. KG v OHIM; Judgment of 24 November 2015; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Enhanced distinctiveness, Res judicata, Scope of proceedings, Functionality continuity, Lack of reasoning, Right to be heard

FACTS: The applicant sought to register the word mark WESTERN GOLD for goods in Class 33. The opponent based an opposition on Article 8 (1) (b) CTMR relying inter alia on the earlier Community

word mark WeserGold registered for goods in Classes 29, 31 and 32. The Opposition Division (OD) upheld the opposition. The Board of Appeal (BoA) set the OD decision aside finding that there is no likelihood of confusion (low similarity of goods in Classes 32 and 33; signs are visually and aurally similar but conceptually dissimilar; earlier mark's distinctiveness below average due to element "Gold" with low distinctive character). The opponent filed an action before the General Court (GC) based on an infringement of Article 8 (1) (b) CTMR and three further pleas with respect to Articles 64 and 75 CTMR. The GC annulled the BoA decision (T-278/10). After holding that the signs are dissimilar on account of their clear conceptual difference, the GC based its ruling on the fact that the BoA failed to assess the claimed enhanced distinctiveness of the earlier mark. Upon the Office's appeal, the European Court of Justice (CJ) annulled the GC decision holding that the omitted assessment of the earlier mark's distinctiveness could have had no bearing on the outcome since the GC considered the conflicting signs to be dissimilar. The CJ remitted the case to the GC noting that it cannot be adjudicated upon as the GC merely assessed the first out of four pleas.

SUBSTANCE: INFRINGEMENT OF ARTICLE 8 (1) (b) CTMR: The CJ annulled the GC decision without specifying the exact extent thereof. However, in accordance with established Case-Law the operational part must be read in conjunction with the reasoning. The CJ merely reasoned that

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



CTMA

WESTERN GOLD

Earlier marks

WeserGold

Wesergold

WESERGOLD

the annulment follows from the fact that the GC considered the BoA to be obliged to assess the enhanced degree of distinctiveness despite holding the signs to be dissimilar beforehand. Hence, the CJ did not put into question the factual findings concerning the signs' similarity. Therefore, the assessment of the first plea before the GC was final. Otherwise, in case the GC in the present case would query the signs' similarity, it would act as an appeal court in relation to the prior GC finding. Furthermore, it would deprive the CJ decision its binding effect since an annulment in the present case cannot go beyond that of the CJ and render moot facts on which the CJ reasoning rests (Paras. 36-45). INFRINGEMENT OF ARTICLE 64 CTMR: Contrary to the applicant's claim, the BoA assessed all invoked earlier marks as follows in particular from the references to the relevant publics for the earlier

Community, German and International registration (Paras. 46-53). INFRINGEMENT OF ARTICLE 75 S. 2 CTMR: The applicant's right to be heard is not infringed by the fact that the BoA assessed all earlier marks (as opposed to the OD decision which was based on the earlier Community mark only) without informing the applicant about this beforehand due to the continuity of function between the Office's instances (Paras. 54-66). INFRINGEMENT OF ARTICLE 75 S. 1 CTMR: The BoA gave sufficient reasons with respect to all earlier marks by way of referring to "the earlier marks", mentioning them and noting that the differences in the writing of word marks are irrelevant (Para. 72).

Case T-374/13; KSR Kunststoff Rotation GmbH v OHIM; Judgment of 4 February 2015; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive element, Principle of legality

FACTS: The contested trade mark was the registered CTM Moon (word) (for "lightening apparatus, in particular exterior and interior lights" (Class 11)). Both instances cancelled the CTM as being descriptive according to Article 7 (1) (c) CTMR. Procedure before the General Court (GC): The GC confirmed the Case-Law that the authorisation for

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



the lawyer to file an application may be filed during the proceedings, as long as it is shown that at the moment of filing the lawyer was authorised by the party (Paras. 11 and 12).

CTM

Moon

SUBSTANCE: The GC states that the submission of the intervener that the term, “moon” would be descriptive outside of Germany is to be refused, since the evidence submitted during the administrative proceedings refers only to Germany. However the GC confirms that for the application of the absolute grounds of refusal it is enough if a sign is descriptive in only a part of the EU (Para. 24).

The GC states that the relevant point of time for the assessment in cases of cancellations based on absolute grounds for refusal is the filing date, however facts and circumstances after that moment may be taken into account if they give information on the situation at the relevant date (Paras. 28 and 29).

In the case at hand there is evidence referring directly to the relevant date and also some evidence relating to a later moment but which confirms the descriptiveness of the term “moon” at the relevant date (Paras. 30 and 31).

The GC rejects the applicant’s argument that the

mark has been used as trade mark and not in a descriptive way. It makes clear that the fact that a sign is used as a mark does not mean that it is not descriptive in case of use in an isolated manner. The potential descriptive use of such a sign is enough for being considered as descriptive in the sense of Article 7 (1) (c) CTMR (Paras. 42-44).

The CTM system (Article 7 (3) CTMR) provides for situations where a descriptive term is perceived as a trade mark because of the use made thereof. This Article has not been invoked by the applicant (Para. 45).

The GC makes clear that previous decisions are not binding and may not affect a decision, which is well reasoned and in conformity with the law (Paras. 47 and 48).

Joint Cases T-707/13 and T-709/13; Steinbeck GmbH v OHIM; Judgment of 30 April 2015; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Laudatory mark, Slogan mark, Principle of legality

FACTS: The applicant for invalidity requested the declaration of invalidity of two CTMs, consisting both of the expression BE HAPPY (word) and covering goods in Classes 9, 11, 16, 18, 21, 28 and 30. The registration would have been in breach of Article 7

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



(1) (b) CTMR. Both instances cancelled the CTMs as being devoid of distinctive character.

CTMs

BE HAPPY

SUBSTANCE: The General Court (GC) confirms the Boards of Appeal (BoA) in the sense that the sign conveys a clear message, namely “to be happy” which will be understood also by the German speaking public. Moreover this expression is also customary in Germany and often used in trade (Para. 27).

The applicant’s argument that the expression is unusual and does not say anything is therefore rejected as unfounded. The expression is grammatically correct and understood as an invitation to be happy and consequently is a promotional message to buy the goods covered by the mark (Paras. 30, 31 and 33).

The further argument that the expression would be original and short and as such remembered by the consumers as an indication of the origin of the goods is rejected by the GC. It is a laudatory phrase in common parlance which immediately refers to a positive feeling related to the goods (Paras. 39 and 40).

The fact that the marks have been used as trademarks is irrelevant, since the assessment as to the absolute grounds for refusal is independent

from the use of the sign (Para. 52).

The GC further confirms the approach taken by the BoA that the marks may be used by anyone in a descriptive manner which means that the consumers will establish directly a link to the goods and not to the producer (Para. 59).

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. 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. 62-65).

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



Case T-258/13; Matratzen Concord GmbH v OHIM; Judgment of 16 April 2015; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Proof of use, Use by another undertaking, Use not as registered, Evidence of use, Proprietor consent

FACTS: The applicant before the General Court (GC) requested the revocation for non-use according to Article 51 (1) (a) CTMR of the CTM, ARKTIS, registered for goods in Classes 20 and 24. The Cancellation Division revoked the mark partially for the goods in Class 20. It found that for the goods in Class 24 the CTM has been used. The Board of Appeal (BoA) confirmed the first instance decision.

CTM

ARKTIS

SUBSTANCE: The applicant put forward that the evidence showing use of the mark does not clearly establish a sufficient volume of use nor does it show that the invoices related to the contested goods in Class 24.

The GC states that the references in the invoices and delivery bills relate to the contested goods. There might be slight discrepancies but in general there is

no incoherence, so that it may be established that the invoices and delivery documents refer to those goods. The discrepancies in the criteria for the purpose of referring to the goods denotes a certain lack of systematic but is not an incoherence and therefore does not diminish the probative value of the documents (Paras. 20 to 24).

The GC stresses that also that evidence which does not directly establish a link with the contested goods as for example the purchase of tags bearing the contested mark is an indication which has to be taken into account in an overall assessment. Moreover, the catalogues show that in the relevant market sector the marketing with a tag on the product bearing the mark is usual (Paras. 29- 31).

The GC examines further if the use is to be considered as genuine and states that the volume of 3 490 “pillows and sleeping bags” (Class 20) confirms the position of the BoA that this shows a sufficient volume of use and cannot be considered as token use.

A further argument of the applicant, namely that the addition of the term “line” would alter the distinctive character of the sign as used, is rejected by the GC. This expression will also be understood in Germany, where the mark has been used, in the sense as product line. The GC quotes also the Case-Law (case: T- 19/99 Companyline; or T-273/10 O-live). The addition is subordinated and the term “ARKTIS” is dominant. (Para. 26 – 27).

Finally, the applicant contends that according to the evidence it has not been only the proprietor of

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



the contested mark which used it but also another company and such use must not be taken into account. The GC confirms the Case-Law that from the fact that the proprietor has the information referring to the use of another company may be inferred that such use has been done with its consent (Para. 43).

Additionally, according to the GC the applicant contested this issue for the first time before the GC and such new plea would alter the subject matter of the contested decision and is inadmissible (Paras. 46-48).

Case T-282/13; Iglotex SA v OHIM; Judgment of 23 April 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Conceptual similarity, Phonetic similarity, Weak element, Similarity of the goods and services, Identity of the goods and services, Figurative element, Common element

FACTS: The CTM applicant sought to register the figurative mark as depicted below for goods in Classes 29 and 30. The opponent based its opposition on Article 8 (1) (b) and 8 (5) CTMR using among others the earlier CTM shown below, registered for goods in Classes 29 and 30. The opposition was directed against all the goods

covered by the application. The Opposition Division upheld the opposition on Article 8 (1) (b) CTMR. The Board of Appeal (BoA) dismissed the appeal, finding that the goods to be compared are identical or similar and the signs similar overall. The opponent appealed to the GC, arguing an infringement both of Article 8 (1) (b) CTMR.



SUBSTANCE:PROCEDURE: The applicant's statement that the goods would be dissimilar or slightly similar has been rejected as inadmissible, because this plea was not substantiated. Consequently, Article 44 of the Rules of procedure of the General Court (GC), which states that an application has to be clear and precise to enable the defendant to prepare his defence and the GC to rule on the action, has not

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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

Case law



been observed (Para. 31- 33).

Article 8 (1) (b) likelihood of confusion. The GC confirms the BoA that the level of attention is normal, if not low (Para. 27). The GC further considers that the comparison of goods carried out by the BoA is correct, and that the goods are identical or highly similar (Paras. 35-38).

Concerning the comparison of the signs, the BoA the GC points out that the figurative elements in the application are not dominant and that the verbal part "IGLOTEX" is clearly visible and as verbal element in principle more distinctive than the figurative parts (Paras. 52-54). The GC holds that – contrary to the submissions of the applicant - the BoA took into account the overall impression of the marks and that the reference to the independent distinctive role of "IGLOTEX" in the applied for sign has as such not lead to any relevant conclusion in the decision (Paras. 55 and 56).

Visually the GC states that due to the fact that the earlier mark, consisting of the term "IGLO" is fully included at the beginning of the verbal element in the contested mark IGLOTEX and having regard that the part "TEX" is a short suffix, there is a certain degree of visual similarity, in spite of the figurative elements in the application (Paras. 65-68).

Phonetically, the GC confirms the BoA's assessment that the first two syllables of the application reproduce entirely the earlier mark which leads to an aural similarity. The argument of the applicant, that the phonetically "powerful" letter "x" at the end of the application influences the aural similarity has

been dismissed (Paras. 70-77).

Conceptually the GC endorses the findings of the BoA to the extent that the public, or at least part of it, will recognise the concept of an "igloo" in both marks. The expression "IGLOTEX" in the opposed mark will be broken down into the elements which have a meaning to the public and therefore they will see therein the concept of an igloo as in the earlier mark (Paras. 84-86).

Moreover, also the penguin and the snowflake would reinforce the same idea of cold, snow and winter as the concept of "igloo", conceptually the signs are similar too (Paras. 87 and 88).

As far as the overall assessment is concerned, the GC stresses that the certain degree of visual similarity which might be more important for the goods at hand which will be displayed in supermarkets and shelves, might still be sufficient for the finding of likelihood of confusion (Paras. 97-100).

The visual differences are in the case at hand attenuated by the identity of high similarity of the goods and the average or even low degree of attention of the public (Paras. 101 and 102).

The GC found that the earlier mark's meaning of "igloo" is linked to a descriptive meaning of the goods in the sense that they are frozen or refrigerated leading to a weak distinctive character (Para. 107).

However, even as a weak mark the overall assessment of the case points to a likelihood of confusion as correctly has been stated by the BoA (Para. 109).

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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

Case law



Case T-585/13 (joint with T-586/13); H.P. Gauff Ingenieure GmbH & Co.KG – JGB v OHIM; Judgment of 16 June 2015; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Restitutio in integrum

FACTS: Against a decision of the Opposition Division an appeal has been filed. The appeal has been filed belated after the period of two month for filing an appeal. The Applicant before the General Court (GC) filed a request for restitutio in integrum according to Article 81 CTMR. It explained that the delivery service provider has confirmed the delivery of the appeal on time. The BoA rejected the restitutio in integrum request because the only evidence was a sworn statement by the representative.

CTMA



SUBSTANCE: The General Court (GC) states that for the assessment of the due care criteria for the restitutio in integrum in case of representation the behaviour of the representative chosen by the party is relevant (Para. 23).

The GC further reiterates that the observance

of deadlines is a matter of public policy and the restitutio in integrum may attempt against legal certainty. Consequently, the conditions laid down in Article 81 CTMR must be applied strictly (Para. 25). The GC states that the declaration from the representative comes from the interested party and has therefore a lower probative value. The consequence is that such declarations must be supported by further evidence in order to show the facts which are intended to be proven. (Para. 27–30). In the absence of any further evidence the contested decision was right in dismissing the request for restitutio in integrum (Para. 31).

Case T-586/13 (joint with T-585/13); H.P. Gauff Ingenieure GmbH & Co.KG – JGB v. OHIM; Judgment of 16 June 2015; language of the case: DE

RESULT: Action dismissed

KEYWORDS: Restitutio in integrum

FACTS: Against a decision of the Opposition Division an appeal has been filed. The appeal has been filed belated after the period of two month for filing an appeal. The Applicant before the General Court (GC) filed a request for restitutio in integrum according to Article 81 CTMR. It explained that the delivery service provider has confirmed the delivery of the

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



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CTMA



SUBSTANCE: The General Court (GC) states that for the assessment of the due care criteria for the restitutio in integrum in case of representation the behaviour of the representative chosen by the party is relevant (Para. 23).

The GC further reiterates that the observance of deadlines is a matter of public policy and the restitution in integrum may attempt against legal certainty. Consequently, the conditions laid down in Article 81 CTMR must be applied strictly (Para. 25).

The GC states that the declaration from the representative comes from the interested party and has therefore a lower probative value. The consequence is that such declarations must be supported by further evidence in order to show the facts which are intended to be proven. (Paras 27-30).

In the absence of any further evidence the contested decision was right in dismissing the request for restitutio in integrum (Para. 32).

Case T-387/13; Federación Nacional de Cafeteros de Colombia v OHIM; Judgment of 18 September 2015; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Figurative trade mark, Geographical origin, Lack of reasoning, Priority, Sign used in the course of trade, Similarity of the goods and services, Used in the course of trade

FACTS: The applicant sought to register/registered the figurative sign represented below as a CTM for goods and services within Class 43 "Services for providing food and drink; restaurants, bars and cocktail bar services; catering services; stores administering of food and drink indoor or take away; food and beverage services; sandwich bars, snack bars".

An opposition based on the earlier the Protected Geographical Indication (PGI) Café de Colombia, registered in the European Union for "coffee", was filed on the grounds of Article 8 (4) CTMR.

The Opposition Division dismissed opposition.

The Board of Appeal (BoA) dismissed opponent's appeal on the basis of Article 8 (4) CTMR and Article 14 of Regulation No 510/2006. The opponent filed an action before the General Court (GC).

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



CTMA

COLOMBIANO
HOUSE

Earlier sign

Café de Colombia

SUBSTANCE: The GC rejected the plea in law alleging infringement of the BoA the obligation to state reasons. According to the GC, the BoA presented sufficiently clearly the reasons for the decision (para 20).

The GC ruled that in order for the earlier sign to be valid basis for an opposition under 8 (4) CTMR, it must confer on its proprietor the right to prohibit the use of a subsequent trade mark, but there is no requirement that the sign in question must confer on its proprietor the right to prohibit the registration of the trade mark (Para. 42).

The GC ruled that it is Article 13 of Regulation No 510/2006 which shall be regarded as relating to opposition proceedings based on Article 8(4) CTMR and rejected the argument that Article 14 of Regulation No 510/2006 constitutes *lex specialis* for the conflicts between PGI and trade mark application in inter partes proceeding. According to

the GC, Article 14 of Regulation No 510/2006 must be regarded as concerning the proceedings relating to the absolute grounds for refusal based on Article 7 (1) (k) CTMR (Para. 52). Consequently in the view of the GC, the Board of Appeal erred in applying the provisions of Article 14 of Regulation No 510/2006 in the context of the opposition on the basis of Article 8 (4) CTMR (Para. 44).

In its judgement, the GC took into consideration the guidelines relating to proceedings before OHIM, as consolidated set of rules setting out the line of conduct which OHIM itself proposes to adopt (Para. 46).

The GC ruled that the error committed by the BoA in so far as it applied Article 14 of Regulation No 510/2006 and not Article 13 of Regulation No 510/2006 is liable to have a decisive effect and therefore the decision of the BoA must be annulled. According to the GC the concept of “same class of product” in Article 14 of Regulation No 510/2006 in the decision of the BoA and “comparable product” in Article 13 (1) (a) of Regulation No 510/2006 could be identical in part of the situations invoked by the opponent in support of its opposition. However, the outcome of the decision according to the GC could differ if the other situations invoked by the opponent under 13 (1) (a) were examined by the BoA.

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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

Case law

Case T-656/13; The Smiley Company SPRL v OHIM; Judgment of 7 October 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Function of trade mark, Legitimate expectations, Minimum degree of distinctiveness, Nature of goods and services, Shape of the product, Three dimensional mark

FACTS: The applicant sought to register the three dimensional mark represented below as a CTM for goods and services within Class 29 and Class 30. The examiner refused to register the trade mark in respect of the goods "Preparations made from cereals, bread, pastry and confectionery" on the ground that the mark applied for was devoid of any distinctive character within the meaning of Article 7 (1) (b) CTMR.

The Board of Appeal (BoA) dismissed the applicant's appeal on the ground that the sign applied for shows the shape of the goods themselves. The applicant filed an action before the General Court (GC).

CTMA



SUBSTANCE: The GC ruled that the applicant's argument that the BoA did not assess the mark applied for as a whole had no factual basis (Para. 31).

In relation to the relevant public, the GC stated that the applicant had not disputed the finding that this is average consumer who is deemed to be reasonably well informed, observant and circumspect (Para. 33).

According to the GC, the constituent elements of the mark applied for taken individually and the shape created taken as a whole will be perceived by the relevant consumer as possible- or even common-variants of the presentation and decoration of the designed goods or as communicating a positive message (Paras. 36, 37). Therefore did not have distinctive character in respect of these goods (Para. 41).

The GC rejected the applicant's argument alleging breach of the principle of non-discrimination and of legitimate expectations by making reference to the case- law establishing that examination must be undertaken in each individual case and the registration of a sign as a mark depends on specific criteria even if the sign applied for is composed in a manner identical to a mark already registered by the Office (Paras. 46, 47).

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law

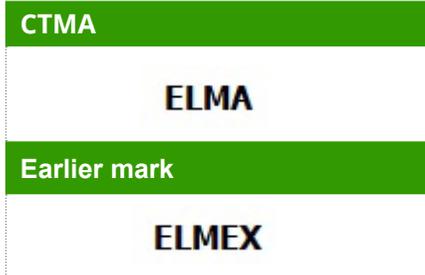


Case T-309/13; Enosi Mastichoparagogon Chiou v OHIM; Judgment of 22 October 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Similarity of the signs, Visual similarity, Phonetic similarity, Purpose of the goods and services

FACTS: The applicant sought to register the word sign ELMA as a CTM for goods in Class 5. The Opposition Division upheld the opposition on the basis of Article 8 (1) (b) CTMR. The Fourth 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 commercial choices made or which may be made by the proprietors of the marks at issue are factors which cannot affect the relevant public to be taken into account when assessing

whether there is a likelihood of confusion. As regards the assessment of the likelihood of confusion, the public with the lowest attention level must be taken into consideration. Thus, even if it were accepted that the goods covered by the mark applied for are also purchased by certain consumers who select them with particular care, for medical reasons, that does not alter the fact that they are intended for all consumers, the great majority of whom display only an average level of attention when purchasing such goods (Paras. 29-31).

The goods covered by the mark applied for contain Chios mastic, a resin produced by the mastic tree which grows on the island of Chios and possesses properties suitable for oral and dental hygiene. However, notwithstanding their medicinal properties, these goods contribute, to the same degree as those covered by the earlier mark (inter alia, pharmaceutical and hygienical products and preparations; products and preparations for buccal and dental care) to dental and oral hygiene and care. Plus, although these goods are, according to the applicant, sold mainly in specialist shops known as “mastishops”, they may also be sold alongside other goods which do not contain Chios mastic, in particular in supermarkets, drugstores and pharmacies, and do not require a prescription. Accordingly, it must be concluded that the goods in question are likely to share the same distribution channels. It follows that Chios mastic must be considered a basic ingredient of the contested goods, which does not change their intended

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



Case law



purpose, use or distribution channels and which, therefore, has no effect on the assessment of the similarity between goods. The fact that that chewing gum has PDO status cannot affect the assessment of its similarity to the goods covered by the earlier mark. PDO merely designates the geographical origin of a product and must therefore be considered irrelevant to the assessment of similarity between the goods. Thus the BoA was right to conclude that the goods in question are highly similar (Paras. 43-50).

The signs are relatively short word, the first parts of which are visually identical, and the difference between the end letters is not sufficient to counterbalance that identity. Thus there is an average degree of visual similarity (Paras. 58-59).

Phonetically the marks at issue are similar in so far as they have two syllables and share the same first syllable. Furthermore, the second syllable of each mark starts with the letter 'm', which is pronounced in the same way for both marks. The fact that the common syllable, "el", appears at the start of the words increases the phonetic, while the difference in the endings of the words is not sufficient to outweigh that similarity. In addition, it is not possible to establish how the relevant public will pronounce the word "elmex", which constitutes the earlier mark. Thus, from a phonetic perspective, the marks display an average degree of similarity (Paras. 60-62).

Given that the word "elmex" has no meaning, it is not possible to make a conceptual comparison of

the signs. The fact that the word "elma" corresponds to the Greek abbreviation "ΕΛΜΑ", which derives from the expression "Ελληνική μαστίχα" meaning "Greek mastic" presupposes that the relevant public not only knows the Greek alphabet but also recognises that abbreviation. Since that alphabet is known outside Greece and Cyprus only by a more erudite category of consumers, most European consumers will not be in a position to establish such a connection. Hence, the conceptual comparison of the marks is not possible (Paras. 64-66).

Case T-597/13; Calida Holding AG v OHIM; Judgment of 23 October 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Dominant element, Enhanced distinctiveness, Figurative element, Likelihood of confusion, Visual similarity

FACTS: The CTM proprietor registered the figurative mark represented below as an international registration designating the EU for goods within Class 25.

On 14 July 2011 an application for invalidity was filed based on the earlier CTM word mark CALIDA, registered for goods in Class 24 and 25, was filed on the grounds of Article 53 (1) (a) and Article 8 (1) (b) CTMR.

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



The Cancellation Division dismissed the application for invalidity in its entirety, on the ground that there was no likelihood of confusion between the marks. While the goods were either similar or identical, the comparison of the signs, namely the low degree of similarity of the signs offset by considerable visual differences, led to the conclusion that no likelihood of confusion existed. This finding would not be altered even if enhanced distinctiveness of the earlier mark was proven and therefore the evidence submitted in support of the enhanced distinctiveness claim was not examined.

The Board of Appeal (BoA) dismissed the invalidity applicant's appeal, concluding that the marks were visually dissimilar, aurally similar to an average degree and conceptually neutral. BoA assessed the evidence and concluded that the earlier mark lacked enhanced distinctiveness and therefore had a normal degree of distinctiveness.

The invalidity applicant filed an action before the General Court (GC) contesting BoA's assessment of visual similarity, the assessment of the distinctive character, and the outcome of likelihood of confusion.

SUBSTANCE: The GC dismissed the action. As regards the visual similarity, the invalidity applicant claimed that the marks were similar to at least an average degree. However, the GC found that the word elements were visually different, the figurative element of the bear playing the trumpet was co-dominant with the word element "dadida", and

IR designating the EU



Earlier mark

CALIDA

the Chinese calligraphy characters completed the different overall impression between the marks (Paras. 25-29)

Concerning the enhanced distinctive character, the invalidity applicant declared that the evidence proved that the earlier mark had enhanced distinctive character, and that this had been concluded in two previous decisions of the BoA between the same parties. The GC confirmed BoA's decision to refute this argument as the applicant had failed to adduce all of the facts of these separate administrative proceedings and therefore the outcome of the previous cases could not be relied on in the case at hand (Paras. 43-49). The GC assessed the evidential value of the evidence submitted and concluded that the documents submitted did not prove any enhanced distinctive character (Paras. 60-66).

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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

Case law



The GC concluded (Paras. 74-76) that mere phonetic similarity is insufficient to lead to a finding of likelihood of confusion, and that even if acquired enhanced distinctive character were proven, it would not alter this finding.

Case T-414/13; Kenzo Tsujimoto v OHIM, Judgment of 2 December 2015, Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Competence of the Boards, Reputation, Evidence of use, Dissimilarity of the goods and services, Unfair advantage, Substantiation of earlier right, Similarity of signs, Personal name mark, Due cause

FACTS: The CTM applicant filed an application for the word mark KENZO for services in Classes 35, 41 and 43 (all wine-related). The opponent relied on the earlier CTM KENZO claiming reputation for goods in Classes 3, 18 and 25. The Opposition Division (OD) dismissed the opposition stating that reputation was not proven. The Board of Appeal (BoA) upheld the appeal of the opponent. The CTM applicant brought an action before the General Court (GC) based on two pleas in law.

CTMA

KENZO ESTATE

Earlier mark

KENZO

SUBSTANCE: ON THE INFRINGEMENT OF ARTICLE 76 (2) CTMR: The GC dismissed the applicant's claim that the BoA was wrong to have taken into account the evidence of use filed outside the substantiation period to prove reputation and failed to exercise its discretion power. The GC referred to Case C-120/12 P Rintisch v OHIM and T-393/13 Tsujimoto v OHIM and made it clear that it is the third subparagraph of Rule 50 (1) CTMIR which must be applied in proceedings before the BoA and not Rule 20 (1) CTMIR (Para. 18). Furthermore, the BoA exercised its discretion under Article 76 (2) CTMR to decide that it was appropriate to take that evidence into consideration and, by finding that such evidence was genuinely relevant for the purposes of assessing the earlier trade mark's reputation, provided a statement of reasons for taking that evidence into account (Paras. 22-23). ON THE INFRINGEMENT OF ARTICLE 8 (5) CTMR: The fact that the contested mark consisted exclusively of the earlier mark, to which another non-distinctive word (ESTATE) was

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law

added, made the two marks similar (Paras. 31-33). The evidence filed during the substantiation period together with the evidence filed to prove use clearly showed reputation of the earlier mark in a significant part of the relevant territory (Para. 41). The BoA also correctly established a risk of an unfair advantage by taking into account the iconic image conveyed by the earlier trade mark which can be transferred to the wine sector and by finding that it was highly likely that the mark applied for would ride on the coat-tails of the earlier trade mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the owner (Para. 54). As to the due cause, the CTMR does not provide any unconditional right to register a surname as a CTM, let alone to register a forename as a trade mark. Consequently, the fact that the applicant's forename is Kenzo is not enough to constitute due cause for the use of the mark applied for, for the purposes of Article 8 (5) (Para. 58).

Case T-547/13; Rosian Express SRL v. OHIM; Judgment of 8 October 2015; Language of the case: RO

RESULT: Action dismissed

KEYWORDS: Shape of the product, Three dimensional mark, Minimum degree of distinctiveness



FACTS: The CTM applicant sought to register the sign below for goods in Classes 28 and 35. 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 goods at issue fall within the category of games and toys. They are intended for general consumption and not only for professionals or enthusiasts since anyone is likely, at some time or another, to acquire such goods either regularly or occasionally. The applicant's arguments that the BoA should have held that the relevant public had only a high level of attention when it comes to durable goods for long-term use were, therefore, incorrect (Para. 42).

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



It is common knowledge that the goods at issue are often presented in a rectangular wooden box. Similarly, the way of unfolding and assembling the box the shape of which constitutes the mark in question does not depart significantly from the norms or customs of the sector. It is well-known that similar sliding systems exist to enable the goods at issue to be put away and to be assembled. Seen as a whole the different characteristics of the mark applied for likewise do not enable the mark applied for to be considered as differing significantly from the norms and customs of the sector. Consequently, it must be held that the mark applied for is not distinctive (Para. 46).

The lack of distinctive character of a mark is not affected by how many similar shapes are already on the market, nor by the absence on the market of shapes identical to those in respect of which registration is requested (Para. 49). It follows, in particular, that the claims of the applicant that the BoA erred in making reference to other goods on the market, although the latter were counterfeit, is irrelevant (Para. 51).

Case T-633/13; Reed Exhibitions Ltd v OHIM, Judgment of 23 September 2015, Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Specialised public, Relevant territory, Descriptive element, Abbreviation, Distinctiveness acquired by use, Proof of use, Declaration

FACTS: The applicant sought to register the word mark INFOSECURITY for goods and services in Classes 16, 35 and 41. The examiner refused to register the word as a CTM for most of them on the ground that it is descriptive and devoid of any distinctive character. The Board of Appeal (BoA) dismissed the applicant's appeal, and so did the General Court (GC).

CTMA

INFOSECURITY

SUBSTANCE: INFRINGEMENT OF ARTICLE 7 (1) (c) CTMR: The target public, both average consumers and professionals, has a sufficient knowledge of the English language even if they were not native English speakers, with the whole EU being the relevant territory (Para. 26). The simple combination of the words "info" and "security", each of which is respectively descriptive of the content and subject-matter of the goods and services concerned, is itself descriptive thereof. It is not uncommon in English to link abbreviations with nouns (Para. 37). Having carried out an overall examination covering all the goods and services refused registration, the BoA was entitled to formulate a single conclusion based

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



on the same ground for refusal covering all the goods and services concerned, without infringing its obligation to state reasons. The reasoning based on subject-matter and content of the goods and services applies to all of them because there is a sufficiently direct and specific link in that they are all media for the dissemination of information in writing (including in print or electronically) or orally (including organisation of conferences, fairs and exhibitions) (Paras. 47-48). INFRINGEMENT OF ARTICLE 7 (3) CTMR: In relation to the actual use



the addition of the element “europe” to the element “infosecurity” alters how the mark applied for, as a mark, is perceived by the relevant public, since its association with the term “infosecurity” may be perceived as a reference to the European edition of the Infosecurity exhibition, and not as a trade mark (Para. 82). The applicant cannot reasonably claim that use of the mark applied for as a trade name may lead to the acquisition of distinctive character. The applicant cannot rely on the mark applied for having acquired distinctive character as a result of its use as a trade name while disputing, in the case in point, the existence of such use (Para. 86). Even if that use did take place, such use as a trade name does not suffice on its own to establish that a significant proportion of the relevant public perceives a link between the services delivered under the sign at issue and a particular undertaking.

Indeed, unlike a trade mark, the purpose of a trade name is not, of itself, to distinguish goods or services (Paras. 88-89). The fact that an exhibition is successful does not mean that its title is perceived as a trade mark in the sense that it would enable the relevant class of persons immediately to identify the undertaking behind that exhibition and to dissociate that exhibition from exhibitions of other undertakings on identical subjects. That is a fortiori the case where the title of the exhibition is directly descriptive of its content (Para. 93). As regards two statements filed, the fact that they were signed after the application for registration was filed does not mean that they are devoid of evidential value for the purposes of assessing the acquisition of distinctive character through use as at the date when the application for registration of the contested mark was filed. Similarly, as regards the BoA’s objection as to the absence of spontaneity on the part of those making the statements and the applicant’s role in the drawing up of the statements submitted, it is important to point out that — contrary to what is suggested in the contested decision — the fact that those statements were made following a request by the applicant and that the applicant may have coordinated the preparation of those statements does not, in itself, cast doubt on their content and evidential value. However, it is clear that the BoA was correct in regarding those two statements as insufficient ‘[a]s sole evidence of the relevant public’s actual perception of the mark’. Regardless of the circumstances in which they were drawn

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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

Case law



up and, in particular, of their date, they express an opinion only as to how the sign is perceived by professionals, whereas the relevant public also includes final consumers. In those circumstances, they do not establish that the mark applied for acquired distinctive character through use for average consumers, which consumers form part of the relevant public (Para. 101). The reference made by the applicant, in the form of a summary, to the “evidence” claimed to have been provided during the administrative proceedings must be dismissed as unsubstantiated in so far as it is supported only by a general and implicit reference to evidence submitted in the administrative proceedings (Para. 112). In any event, even if the evidence to which the applicant refers could be taken into account, it would not be sufficient for the mark applied for to be regarded as having acquired distinctive character through use. In the first place, the applicant’s possible position as leader on the market in question, even if it were established, does not necessarily lead to the relevant public identifying the commercial origin of the Infosecurity exhibition because of its title, as it might do because of a trade mark, particularly where the sign INFOSECURITY may be used as a trade name or in order to designate the title of an exhibition. The same is true of the evidence relating to attendance at the Infosecurity exhibition (Paras. 113-114). In the second place, the applicant’s advertising and marketing investments are allocated to specific sectors such as the information security sector, but also to the banking, finance and government

administration sectors. That does not prove that the average consumer, who also forms part of the relevant public, is — like the professional public — also targeted by that advertising. Moreover, as regards the sums invested by the applicant, it is impossible, in the present case, to measure the relative significance of the applicant’s advertising investments in the absence of data which make it possible to compare them with the overall volume of advertising on the market for the goods and services at issue in the European Union (Para. 115). In so far as the applicant relies on ownership and management of websites (www.infosecurity.be, www.infosecurity.nl and www.infosecurity.co.uk), it is clear that since the mark applied for corresponds to a domain name, the fact that internet users visit the site on which the goods and services are offered does not suffice to prove that that mark has been “used” within the meaning of Article 7 (3) CTMR (Para. 117).

Case T-253/13; Orthogen AG v OHIM; Judgment of 12 November 2015; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive element, Distinctive element, Specialised public, Competence of the Boards, Abbreviation

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



FACTS: The contested trade mark was the registered CTM IRAP (word) for goods and services in classes 1, 10, 42 and 42. The Cancellation Division cancelled the CTM as being descriptive and devoid of distinctive character according to Article 7 (1) (b) and (c) CTMR. The Board of Appeal (BoA) confirmed the First Instance to the extent that it found that the mark is devoid of distinctive character.

CTM

IRAP

SUBSTANCE: a) Infringement of Article 52 (1) (a) in connection with Article 64 (1) CTMR: The applicant put forward that in proceedings for declaration of invalidity based on absolute grounds for refusal the Office would be bound by the use of the discretionary power of the Office when it accepted the mark for registration (Para. 18). According to Article 64 (1) CTMR the BoA is called to carry out an examination by exercising any power within the competence of the department which was responsible for the decision appealed. This involves a full examination as to the merits both as to the factual and legal framework of the case. Consequently, the applicant's plea has to be rejected (Paras. 18 to 22).

b) Infringement of Article 7 (1) (b) CTMR: The BoA was right in concluding that the target public is mainly a specialized public with specific knowledge in the filed because the goods and services are very specific (Para. 31). Furthermore the BoA was

right in assessing that the term "IRAP" may be understood by this public as referring to a protein called "Interleukin-1 receptor antagonist protein". This conclusion is supported by the documents in the file (Para. 33). With respect to the submission of the applicant that the BoA unlawfully relied on publications coming from the United States, the GC states that the specialized public within the EU will understand the English language which is predominant in the field and that this public will also consult publications from outside the EU (Paras. 34 and 35). The further argument of the applicant that private consumers will not grasp any meaning when they are confronted with the sign, the General Court (GC) states that it is sufficient that a substantial part of the target consumers perceives the sign as not distinctive (Para. 36). Moreover, it is reasonable to assume that they will receive advice from the specialists when they acquire those kind of goods and services (Para. 37). The applicant contended that even if the expression "IRAP" would be perceived as an abbreviation of "Interleukin-1 receptor antagonist protein" this would not be descriptive for the goods and services, as there is no clear and direct link between those goods and services and the meaning of "IRAP" (Para. 42). As to this plea, the GC underlines the fact that the contested decision invalidated the mark based on Article 7 (1) (b) CTMR, which means that there is no need to show a direct descriptive character but rather to establish if the expression "IRAP" has the required distinctive character (Para. 44).

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



The BoA established for the different categories of goods and services how the protein (IRAP) could function and concluded that there would be a connection there between. The sign therefore gives information on the goods and services and without being directly descriptive it lacks therefore the distinctive character in order to be acceptable under Article 7 (1) (b) CTMR (Paras. 51 to 58).

Case T-649/13; TrekStor Ltd v OHIM; Judgment of 23 October 2015; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive element, Minimum degree of distinctiveness, Distinctiveness acquired by use

FACTS: The CTM applicant sought registration of the word mark SmartTV Station for products in Classes 9 and 28. 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

SmartTV Station

SUBSTANCE: It is necessary to rely on the understanding of the public of the United Kingdom and Ireland, as the terms composing the sign are in English (Para. 22).

The word “smart” means “seemingly intelligent, showing a certain autonomy” and is often used in the computer field to hint to the level of elaboration and intelligence of a program or of a machine. This is also true in the electronics field, which is largely overlapping with the computer one (Para. 27).

The expression “smarttv” is extremely common to indicate multifunction televisions offering complementary computer features (Para. 28).

Given the meaning of term “station” in the ordinary language and the fact that such a term is already used in the English electronic language, in particular in the expression “workstation”, the term “station”, is commonly known in the technical and computer field, as referring to a technical system as a whole, of a local apparatus or of a control center carrying out or controlling important functions and procedure (Para. 32).

The combination of the terms “smarttv” and “station” will be understood as indicating an apparatus or a multifunctional center of control, highly developed on a technical level and intelligent, offering a television feature as well as complementary autonomous interactive computer features, including the possibility to surf the Internet (Para. 40). There is no perceptible difference between the expression “smarttv station” and the sum of its parts (Para. 43). The sign is descriptive of the

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



products covered by the mark as it can indicate their kind, intended purpose, way of functioning, quality. Indeed, the Board correctly held that such products consist either in interactive television terminals or in elements of such television terminals and of the network to which they are connected (Para. 44). The term “station” does not necessarily refer to a fixed or stationary entity (Para. 42).

It is irrelevant whether web surfers use the term “smarttv station” as a search term in search engines, since it suffices that the expression “smarttv station” can be understood as a descriptive indication of the products. Likewise, it is irrelevant whether the signs composing the mark are actually used for descriptive purposes at the time of the TM application (Paras. 51-53).

The mark is descriptive also in respect of magnetic data carriers, as they are necessary for the use of a television terminal such as that marketed by the CTM applicant under the name of SmartTV Station (Para. 60).

Even if the CTM applicant produced copies of its product sheets, screenshots of the search results of Google, excerpts of the online encyclopedia Wikipedia, a list of products linked to the sign sold on the online shop and screenshots relating to products linked to the sign from the site Amazon, such documents do not suffice to prove that the sign had acquired distinctive character through use (Paras. 68-71).

Case T-636/13; TrekStor Ltd v OHIM; Judgment of 23 October 2015; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Descriptive element, Minimum degree of distinctiveness

FACTS: The CTM proprietor registered the word mark MovieStation for products in Class 9. The invalidity applicant claimed that the mark was invalid. The Cancellation Division upheld the application. The Board of Appeal (BoA) dismissed the appeal. The CTM proprietor filed an application before the General Court (GC) for the annulment of the decision of the BoA.

CTM

MovieStation

SUBSTANCE: It is necessary to rely on the understanding of the public of the United Kingdom and Ireland, as the terms composing the sign are in English (Para. 21).

Given the meaning of term “station” in the ordinary language and the fact that such a term is already used in the English electronic language, in particular in the expression “workstation”, the term “station”, is commonly known in the technical and computer field, as referring to a technical system as a whole, of

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



a local apparatus or of a control center carrying out or controlling important functions and procedure (Para. 27).

The combination of the terms “movie” and “station” will be understood as indicating an apparatus, a center of control for films, that is for their display and management (Para. 35). There is no perceptible difference between the expression “moviestation” and the sum of its parts (Para. 38). The sign is descriptive of the products covered by the mark as it can indicate their kind, intended purpose, way of functioning, quality. Indeed, the BoA correctly held that such products consist in apparatus (centers of control) for films the display and management of films (Para. 39).

It is irrelevant whether the term “station” could refer to a fixed or stationary entity, since it suffices that the sign is descriptive in at least one of its meanings (Para. 42).

It is irrelevant whether web surfers use the term “MovieStation” as a search term in search engines, since it suffices that the expression “moviestation” can be understood as a descriptive indication of the products. Likewise, it is irrelevant whether the signs composing the mark are actually used for descriptive purposes at the time of the TM application (Paras. 46-48).

It is irrelevant whether the mark is descriptive only in respect of a small part of the products covered by the mark, since it suffices that the relevant products could be of such a nature as to read films (Paras. 51-52). Even if the CTM proprietor produced copies

of its product sheets, screenshots of the search and query results of Google on the presumed behavior of Internet users, excerpts of the online encyclopedia Wikipedia and offers of similar products by other undertakings, it did not show how such documents would prove that the sign had acquired distinctive character through use (Paras. 61-63).

Case T-517/13; Editions Quo Vadis v OHIM; Judgment of 29 October 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Common element, Reputation , Nature of the goods and services, Purpose of the goods and services, Distinctive element, Detriment to earlier mark, Unfair advantage

FACTS: Opposition pursuant to Article 8 (1) (b) and 8 (5) CTMR. The opposition Division (OD) partially upheld the opposition ex Article 8 (5) CTMR with regard to some products in Class 33 and some services in Class 35. The Boards of Appeal (BoA) annulled the OD decision and rejected the opposition also regarding Article 8 (5) CMR, since there was no link between the contested mark, which was used in relation to “alcoholic beverages and the retailing of wine”, and the earlier mark, which was used in relation to “time planners”.

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



CTMA

QUO VADIS

Earlier mark

QUO VADIS

SUBSTANCE: Single plea: infringement of 8 (5) CTMR. The General Court (GC): confirms the absence of any proximity or link between, on the one hand, “alcoholic beverages and the retailing of wine” and, on the other hand, “time planners”. They have a completely different nature, purpose and method or use. Their producers and suppliers are active in completely different fields of business without the slightest overlap or link (Para. 30).

Furthermore, the publics at which the goods and services covered by the marks at issue are aimed do not overlap. The earlier goods and services target youngsters or teenagers, whereas the contested goods and services are not, by definition, mentioned in relation to youngsters or teenagers (Para. 32).

The distinctive character of the earlier mark is at most average, as the expression “QUO VADIS” is a Latin phrase meaning “Where are you going?” which is used by third parties in various sectors in connection with other goods and services (Para. 35). Since no link between the marks at issue may be

established, the use of the mark applied for is not likely to take unfair advantage of or be detrimental to the distinctive character or the repute of the earlier word mark.

The action is dismissed.

Case T-216/14; Volkswagen AG v OHIM; Judgment of 28 April 2015; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Laudatory mark, Slogan mark, Principle of legality, Distinctive element, Quality of the goods and services

FACTS: The applicant sought the registration of the CTM EXTRA (word) for goods and services in Classes 12, 28, 35 and 37. The First Instance refused the application as being devoid of distinctive character (Article 7 (1) (b) CTMR). The Board of Appeal (BoA) upheld that decision.

CTMA

EXTRA

SUBSTANCE: The General Court (GC) states that the relevant public is partially the general public and partially a more sophisticated public. However, even a highly attentive public is normally when

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



confronted with a slogan as in the case at hand less attentive (Para. 20).

The GC further confirms the BoA that the meaning of the applied for sign, will be immediately understood as “addition”, “special” “extraordinary”, so that in conveys a direct indication as to the high quality of the goods and services. The expression is often used in advertising (Para. 22).

The GC refers to the case-law that the expression “extra” without being precise just denotes a high quality (see T-81/13 “BigXtra” (Para. 23).

The GC therefore rejects the applicant’s argument that the term does not give a clear idea about any characteristic of the goods or services (Paras. 27 and 28).

Finally, the refusal does not infringe the principle of equal treatment or sound administration. Earlier decisions are not binding and the contested decision gives sufficient reasons for the refusal and is in line with the applicable law (Paras. 30-33).

Consequently, the applied for sign is devoid of distinctive character and may therefore not indicate the origin of the goods or services.

Case T-94/14; EE Ltd. v OHIM; Judgment of 10 September 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Admissibility, Distinctive element, Colour mark, Figurative trade mark, Function of trade mark

FACTS: The applicant sought to register the figurative mark for goods and services in Classes 7, 9, 16, 25, 35 to 39, 41, 42 and 45. The examiner’s decision, rejecting the application for registration in its entirety based on Article 7 (1) (b) CTMR, was confirmed by the First Board of Appeal (BoA). The applicant filed an action before the General GC (GC).

CTMA



SUBSTANCE: The CTM applicant claimed infringement of Article 7 (1) (b) CTMR in consequence of failure to assess the sign as a whole and non-consideration of each of the goods and services individually by the (BoA). The applicant maintained that the distinctive character of the sign has been proven before the BoA.

The action was dismissed in its entirety by the GC. The GC pointed out that where a sign is composed of a number of features, each one of which is devoid of distinctive character, the distinctive character of the sign as a whole depends on whether the overall impression is greater than the mere sum of its parts (Para. 34). The BoA was correct in finding that the contested sign does not

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law

denote a connection with a specific undertaking since it is a mere banal combination of two non-distinctive and barely memorable or noticeable features (Para. 46). However, the GC ruled that the provision of description of the figurative mark before the GC cannot be considered a new argument. The description of such mark is not a mandatory requirement. (Paras. 52, 53). According to the judgement, there is no need for each of the goods and services to be assessed and they may be grouped for the purpose of the examination and general reasoning may be applied where they form a category or groups sufficiently homogenous to permit such general reasoning (Para. 59). The sign described by the applicant will not be perceived by the relevant consumer as an indication of origin. In this sense, the GC mentioned the importance of the ability of a sign to distinguish the service of one undertaking from those of other undertakings rather than its ability to be associated with a particular service (Para. 63). The GC concluded that high degree of attentiveness with regard to some of the goods and services of the relevant public does not alter the fact that the colour possesses little inherent capacity for communicating specific information (Para. 69).



Case T-144/14; EE Ltd. v OHIM; Judgment of 10 September 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Admissibility, Distinctive element, Colour mark, Figurative trade mark, Function of trade mark

FACTS: The applicant sought to register the figurative mark for goods and services in Classes 7, 9, 16, 25, 35 to 39, 41, 42 and 45. The Examiner's decision, rejecting the application for registration in its entirety based on Article 7 (1) (b) CTMR, was confirmed by the First Board of Appeal (BoA). The applicant filed an action before the General GC (GC).

CTMA



SUBSTANCE: The CTM applicant claimed infringement of Article 7 (1) (b) CTMR in consequence of failure to assess the sign as a whole and non-consideration of each of the goods and services individually by the (BoA). The applicant maintained

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



that the distinctive character of the sign has been proven before the BoA.

The action was dismissed in its entirety by the GC. The GC pointed out that where a sign is composed of a number of features, each one of which is devoid of distinctive character, the distinctive character of the sign as a whole depends on whether the overall impression is greater than the mere sum of its parts (Para. 34). The BoA was correct in finding that the contested sign does not denote a connection with a specific undertaking since it is a mere banal combination of two non-distinctive and barely memorable or noticeable features (Para. 46). However, the GC ruled that the provision of description of the figurative mark before the GC cannot be considered a new argument. The description of such mark is not a mandatory requirement (Paras. 52, 53). According to the judgement, there is no need for each of the goods and services to be assessed and they may be grouped for the purpose of the examination and general reasoning may be applied where they form a category or groups sufficiently homogenous to permit such general reasoning (Para. 59). The sign described by the applicant will not be perceived by the relevant consumer as an indication of origin. In this sense, the GC mentioned the importance of the ability of a sign to distinguish the service of one undertaking from those of other undertakings rather than its ability to be associated with a particular service (Para. 63). The GC concluded that high degree of attentiveness with regard to some

of the goods and services of the relevant public does not alter the fact that the colour possesses little inherent capacity for communicating specific information (Para. 69).

Case T-278/14; Mansour Dairek Attoumi v OHIM; Judgment of 09 of September 2015; Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Conceptual similarity, Conflict of design with prior trademark, Design, Evidence of use, Likelihood of confusion, Phonetic identity, Proof of use, Request for proof of use, Right of defence, Similarity of the goods and services, Suspension of the proceedings, Visual identity, Representation of a design

FACTS: The invalidity applicant is a proprietor of the earlier international word trade mark represented below, with effect in Spain and other EU countries, registered for the goods and services within Classes 3, 9, 14, 16, 18, 24 and 25.

On 12 of August 2010, on the basis of the earlier international word trade mark, the invalidity applicant filed an application for declaration of invalidity of the registered community design represented below, registered for the products "belts" in Class 02.07 Locarno Classification.

The RCD proprietor requested a proof of genuine

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



use of the earlier trade mark to be furnished. The Invalidity Division (ID) declared the invalidity of the RCD. The Board of Appeal (BoA) decided not to stay the proceedings on the basis of the invalidity application filed by the RCD proprietor against the earlier trade mark before the national court. The BoA confirmed the decision of the ID. The RCD proprietor filed an action before the General Court (GC).

The GC dismissed the action of the RCD proprietor in its entirety.



SUBSTANCE: the GC considered that the BoA adequately examined the interests of the parties and correctly dismissed the application of suspension of the proceedings (Para. 29). The GC referred to the case-law stating that the judicial review of the discretion of the BoA to suspend proceedings is restricted to ensuring that there is no manifest error of assessment or misuse of powers (Para. 26).

There is no infringement of the right of defence

of the party although part of the evidence was not provided to the RCD proprietor. According to the GC, there was no indication that the outcome of the proceedings could have been different in the contrary case as the BoA did not base any conclusions on this particular evidence (Para. 35).

According to the GC sufficient evidence has been provided and the genuine use of the earlier mark has been proven for part of the goods and services (Para. 58).

The GC ruled that the RCD proprietor could rely on the coexistence in the Spanish market of a trade mark identical to the earlier trade mark in order to show lower LOC between the RCD and the earlier trade mark. However, the RCD proprietor was unable to prove that the LOC is lower. The GC stated that the mere lack of action by the invalidity applicant against the coexisting mark is not sufficient to support this allegation. According to the GC, the relevant public is the average Spanish consumer and there is similarity between the goods and services. The GC ruled that the earlier trade mark and the word element represented on the RCD are visually and phonetically identical and possess at least average degree of conceptual similarity; therefore there is LOC (Paras. 78-103).

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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

Case law



Case T-608/14; Laverana GmbH & Co. KG v OHIM; Judgment of 10 September 2015; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Distinctive element, Figurative trade mark

FACTS: The Board of Appeal confirmed the decision of the examiner rejecting the registration of the CTM application represented below for goods in Classes 3 and 5 pursuant to Article 7 (1) (b) and 7 (1) (c) CTMR. The word elements are descriptive and the figurative elements do not add to a distinctive character of the sign. The CTM applicant filed an action to the General Court (GC) claiming the infringement of Article 7 (1) (b) and 7 (1) (c) CTMR.

CTMA



SUBSTANCE: The GC dismissed all arguments of the CTM applicant. The verbal elements have a clear semantic meaning related to characteristics of the goods (Para. 17). The reasoning of the challenged decision addresses homogenous groups of claimed goods (Para. 19). The graphical elements cannot distract from the descriptive character of the verbal element (Para. 20 with broad indications of further Case-Law).

The previous registrations on which the CTM applicant relies are not comparable and not binding for the Office. The GC referred to the Case-Law of the European Court of Justice and its own Case-Law and emphasized that there is no right to “equality in injustice” (Para. 22 and 23).

Case T-609/14; Laverana GmbH & Co. KG v OHIM; Judgment of 10 September 2015; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Distinctive element, Figurative trade mark

FACTS: The Board of Appeal confirmed the decision of the examiner rejecting the registration of the CTM application represented below for goods in Classes 3 and 5 pursuant to Article 7 (1) (b) and 7 (1) (c) CTMR. The word elements are descriptive and the figurative elements do not add to a distinctive

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



character of the sign. The CTM applicant filed an action to the General Court (GC) claiming the infringement of Article 7 (1) (b) and 7 (1) (c) CTMR.

CTMA



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Case T-610/14; Laverana GmbH & Co. KG v OHIM; Judgment of 10 September 2015; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Distinctive element, Figurative trade mark

FACTS: The Board of Appeal confirmed the decision of the examiner rejecting the registration of the CTM application represented below for goods in Classes 3 and 5 pursuant to Article 7 (1) (b) and 7 (1) (c) CTMR. The word elements are descriptive and the figurative elements do not add to a distinctive character of the sign. The CTM applicant filed an action to the General Court (GC) claiming the infringement of Article 7 (1) (b) and 7 (1) (c) CTMR.

CTMA



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First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



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The previous registrations on which the CTM applicant relies are not comparable and not binding for the Office. The GC referred to the Case-Law of the European Court of Justice and its own Case-Law and emphasized that there is no right to “equality in injustice” (Paras. 22 and 23).

Case T-30/14; Laverana GmbH & Co. KG v OHIM; Judgment of 10 September 2015; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Complex mark, Descriptive element, Figurative element, Principle of legality

FACTS: The applicant sought to register the figurative mark was depicted below for inter alia goods in Classes 3 and 5. Both instances refused registration of the mark according to Article 7 (1) (b) and (c) CTMR.

CTMA



SUBSTANCE: Article 7 (1)(c) CTMR. The General Court (GC) states as to the meaning of the expression “bio” that it refers clearly to a production with natural ingredients or to the respect of ecological values. See cases T-586/08 “BIOPIETRA” and T-427/11 “BIODERMA” (Para. 20).

The GC further points out that the Board of Appeal (BoA) correctly assessed the meaning of the verbal parts with respect to the goods in the sense that they are ecological contain vegetal ingredients and are produced by the proprietor itself (Para. 21).

The GC rejects the plea of a deficient reasoning, because the contested decision identified the different homogenous groups with the goods and reasoned why the sign is descriptive for each of those categories (Para. 22).

As far as the applicant’s plea that the figurative elements have not been taken into account is concerned, the GC notes that they are banal or merely reinforce the descriptive meaning of the verbal elements. Following the constant Case-

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



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The applicant's complaint that the BoA held the sign as being a quality emblem has been rejected since the BoA did not do such a categorization of the sign which in any case was not decisive for the assessment as descriptive sign (Para. 24).

Concerning the previous decision to which the applicant refers to, the following applies:

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. 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 (Para. 25).

Case T-568/14; Laverana GmbH & Co. KG v OHIM; Judgment of 10 September 2015; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Complex mark, Descriptive element, Figurative element, Principle of legality

FACTS: The applicant sought to register the figurative mark was depicted below for inter alia goods in Classes 3 and 5. Both instances refused registration of the mark according to Article 7 (1) (b) and (c) CTMR.

CTMA



First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



SUBSTANCE: Article 7(1)(c) CTMR. The General Court (GC) states as to the meaning of the expression “bio” that it refers clearly to a production with natural ingredients or to the respect of ecological values. See cases T-586/08 “BIOPIETRA” and T-427/11 “BIODERMA” (Para. 17).

The GC further points out that the Board of Appeal (BoA) correctly assessed the meaning of the verbal parts with respect to the goods in the sense that they are ecological contain a plant fluid and are produced by the proprietor itself (Para. 18).

The GC rejects the plea of a deficient reasoning, because the contested decision identified the different homogenous groups with the goods and reasoned why the sign is descriptive for each of those categories (Paras. 19 and 20).

As far as the applicant’s plea that the figurative elements have not been taken into account is concerned, the GC notes that they are banal or merely reinforce the descriptive meaning of the verbal elements. Following the constant Case-Law, these elements are not able to distract from the descriptiveness conveyed by the sign and will therefore not attract sufficiently the attention of the consumers. Due to the meaning of the verbal elements the consumers will perceive the sign as descriptive (Para. 20).

The applicant’s complaint that the BoA held the sign as being a quality emblem has been rejected since the BoA did not do such a categorization of the sign which in any case was not decisive for the assessment as descriptive sign (Para. 21).

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As to the alleged abuse of the discretionary power by refusing the registration based on considerations of unlawful competition, the GC states that this has not been substantiated and secondly the correct application of Article 7 (1) (c) CTMR serves the interest of the protection of competitors (Para. 26).

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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

Case law



Case T-569/14; Laverana GmbH & Co. KG v OHIM; Judgment of 10 September 2015; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Complex mark, Descriptive element, Figurative element, Principle of legality

FACTS: The applicant sought to register the figurative mark was depicted below for inter alia goods in Classes 3 and 5. Both instances refused registration of the mark according to Article 7 (1) (b) and (c) CTMR.

CTMA



SUBSTANCE: Article 7 (1)(c) CTMR. The General Court (GC) states as to the meaning of the expression “bio” that it refers clearly to a production with natural ingredients or to the respect of ecological values. See cases T-586/08 “BIOPIETRA” and T-427/11 “BIODERMA” (Para. 17).

The GC further points out that the Board of Appeal (BoA) correctly assessed the meaning of the verbal parts with respect to the goods in the sense that they are ecological contain a plant complex with proteins and are produced by the proprietor itself (Para. 18).

The GC rejects the plea of a deficient reasoning, because the contested decision identified the different homogenous groups with the goods and reasoned why the sign is descriptive for each of those categories (Para. 19).

As far as the applicant’s plea that the figurative elements have not been taken into account is concerned, the GC notes that they are banal or merely reinforce the descriptive meaning of the verbal elements. Following the constant case-law, these elements are not able to distract from the descriptiveness conveyed by the sign and will therefore not attract sufficiently the attention of the consumers. Due to the meaning of the verbal elements the consumers will perceive the sign as descriptive (Para. 20).

The applicant’s complaint that the BoA held the sign as being a quality emblem has been rejected since the BoA did not do such a categorization of the sign which in any case was not decisive for the assessment as descriptive sign (Para. 21).

Concerning the previous decision to which the applicant refers to, the following applies: Although, the Office must take into account the decisions already taken in respect of similar applications and consider with especial care

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law

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As to the alleged abuse of the discretionary power by refusing the registration based on considerations of unlawful competition, the GC states that this has not been substantiated and secondly the correct application of Article 7 (1) (c) CTMR serves the interest of the protection of competitors (Para. 26).

Case T-570/14; Laverana GmbH & Co. KG v OHIM; Judgment of 10 September 2015; Language of the case: DE

RESULT: Action dismissed



KEYWORDS: Complex mark, Descriptive element, Figurative element, Principle of legality

FACTS: The applicant sought to register the figurative mark was depicted below for inter alia goods in Classes 3 and 5. Both instances refused registration of the mark according to Article 7 (1) (b) and (c) CTMR.

CTMA



SUBSTANCE: Article 7 (1)(c) CTMR. The General Court (GC) states as to the meaning of the expression “bio” that it refers clearly to a production with natural ingredients or to the respect of ecological values. See cases T-586/08 “BIOPIETRA” and T-427/11 “BIODERMA” (Para. 17).

The GC further points out that the BoA correctly assessed the meaning of the verbal parts with respect to the goods in the sense that they are ecological contain a plant fluid and are produced by the proprietor itself (Para. 18).

The GC rejects the plea of a deficient reasoning,

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



Case law



because the contested decision identified the different homogenous groups with the goods and reasoned why the sign is descriptive for each of those categories (Para. 19).

As far as the applicant's plea that the figurative elements have not been taken into account is concerned, the GC notes that they are banal or merely reinforce the descriptive meaning of the verbal elements. Following the constant case-law, these elements are not able to distract from the descriptiveness conveyed by the sign and will therefore not attract sufficiently the attention of the consumers. Due to the meaning of the verbal elements the consumers will perceive the sign as descriptive (Para. 20).

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As to the alleged abuse of the discretionary power by refusing the registration based on considerations of unlawful competition, the GC states that this has not been substantiated and secondly the correct application of Article 7 (1) (c) CTMR serves the interest of the protection of competitors (Para. 26).

Case T-571/14; Laverana GmbH & Co. KG v OHIM; Judgment of 10 September 2015; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Complex mark, Descriptive element, Figurative element, Principle of legality

FACTS: The applicant sought to register the figurative mark as depicted below for inter alia goods in Classes 3 and 5. Both instances refused registration of the mark according to Article 7 (1) (b) and (c) CTMR.

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



CTMA



SUBSTANCE: Article 7 (1)(c) CTMR. The General Court (GC) states as to the meaning of the expression “bio” that it refers clearly to a production with natural ingredients or to the respect of ecological values. See cases T-586/08 “BIOPIETRA” and T-427/11 “BIODERMA” (Para. 17).

The GC further points out that the BoA correctly assessed the meaning of the verbal parts with respect to the goods in the sense that they are ecological contain a plant fluid and are produced by the proprietor itself (Para. 18).

The GC rejects the plea of a deficient reasoning, because the contested decision identified the different homogenous groups with the goods and reasoned why the sign is descriptive for each of those categories (Para. 19).

As far as the applicant’s plea that the figurative elements have not been taken into account is concerned, the GC notes that they are banal or merely reinforce the descriptive meaning of the

verbal elements. Following the constant Case-Law, these elements are not able to distract from the descriptiveness conveyed by the sign and will therefore not attract sufficiently the attention of the consumers. Due to the meaning of the verbal elements the consumers will perceive the sign as descriptive (Para. 20).

The applicant’s complaint that the BoA held the sign as being a quality emblem has been rejected since the BoA did not do such a categorization of the sign which in any case was not decisive for the assessment as descriptive sign (Para. 21).

Concerning the previous decision to which the applicant refers to, the following applies:

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.

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,

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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

Case law



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As to the alleged abuse of the discretionary power by refusing the registration based on considerations of unlawful competition, the GC states that this has not been substantiated and secondly the correct application of Article 7 (1) (c) CTMR serves the interest of the protection of competitors (Para. 26).

Case T-572/14; Laverana GmbH & Co. KG v OHIM; Judgment of 10 September 2015; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Complex mark, Descriptive element, Figurative element, Principle of legality

FACTS: The applicant sought to register the figurative mark was depicted below for inter alia goods in Classes 3 and 5. Both instances refused registration of the mark according to Article 7 (1) (b) and (c) CTMR.

SUBSTANCE: Article 7(1)(c) CTMR. The General Court (GC) states as to the meaning of the expression “bio” that it refers clearly to a production with natural ingredients or to the respect of ecological values. See cases T-586/08 “BIOPIETRA” and T-427/11

CTMA



“BIODERMA” (Para. 17).

The GC further points out that the BoA correctly assessed the meaning of the verbal parts with respect to the goods in the sense that they are ecological contain a plant extract and are produced by the proprietor itself (Para. 18).

The GC rejects the plea of a deficient reasoning, because the contested decision identified the different homogenous groups with the goods and reasoned why the sign is descriptive for each of those categories (Para. 19).

As far as the applicant’s plea that the figurative elements have not been taken into account is concerned, the GC notes that they are banal or merely reinforce the descriptive meaning of the verbal elements. Following the constant Case-Law, these elements are not able to distract from the descriptiveness conveyed by the sign and will therefore not attract sufficiently the attention of the consumers. Due to the meaning of the verbal elements the consumers will perceive the sign as

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



Case law



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As to the alleged abuse of the discretionary power by refusing the registration based on considerations

of unlawful competition, the GC states that this has not been substantiated and secondly the correct application of Article 7 (1) (c) CTMR serves the interest of the protection of competitors (Para. 26).

Case T-382/14; Bernhard Rintisch v OHIM; Judgment of 24 September 2015; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Admissibility, Adversely affected, Ancillary appeal, Lack of reasoning, Proof of use

FACTS: The holder of the international Registration (IR) designating the EU sought to register the word mark shown below for inter alia goods in Classes 5 and 29. The opponent based its opposition on Article 8 (1) (b) CTMR using inter alia the earlier German mark shown below, registered for goods in Classes 29 and 32. The applicant requested the opponent to show genuine use of its earlier marks. The Opposition Division (OD) upheld the opposition in part for the goods in Classes 5 and 29. The Board of Appeal (BoA) partially annulled the First Instance by rejecting the opposition for all of the goods in Class 5 and some of Class 29. The opponent appealed to the GC alleging inter alia infringement of Article 75 CTMR (obligation to state reasons).

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



CTMA

PROTICURD

Earlier mark

PROTI *et al.*

SUBSTANCE: ADMISSIBILITY: The OD found that genuine use of the earlier marks was proven for “protein concentrates as food supplements for the field of sport and fitness” in Class 29 and “protein concentrates as food supplements for the field of sport and fitness, for beverage preparation” in Class 32 (Para. 20).

The applicant before the General Court (GC) argued that it could not challenge this assessment, since the OD upheld the opposition for the controversial part, namely the goods in Classes 5 and 29 and consequently, it was not adversely affected by the decision (Para. 17).

The GC reminds the principle that the BoA is called upon to carry out a new, full examination of the merits of the opposition, in terms of both law and fact. However, the question of proof of use is a specific and preliminary issue to the examination of the opposition and consequently the new and full review of the BoA does not extend to this question (Para. 24 and 25).

The GC further concludes that in case that the

applicant wanted to challenge the assessment of proof of use carried out by the OD, it should have filed a cross appeal according to Article 8 (3) Rules of Procedure of the BoA. To this respect it is also adversely affected by the First Instance decision, because it contained an assessment, which was specific and preliminary to the examination of the opposition, that genuine use of the earlier mark PROTI had not been proven in connection with the other goods in Class 29 [which are more similar to the contested goods] (Para. 29 to 32).

Consequently, in accordance with Article 188 of the Rules of Procedure of the GC, the applicant’s arguments concerning other goods in Class 29 for which no proof of use has been found by the Opposition Division goes beyond the subject matter of the proceedings before the GC and are inadmissible (Para. 36).

The BoA found that as regards genuine use of the earlier mark in essence, that it was possible to infer from the documents submitted by the applicant that he had, in respect of the relevant period (which ran from 17 May 2004 to 16 May 2009), proved genuine use of the earlier mark with respect to “preparations, particularly proteins, also supplemented with vitamins and/or mineral salts as well as carbohydrates, each particularly in powder form, for beverage preparation” in Class 32 (Para. 12).

However, the other goods for which the OD has genuine use, namely: “dietetic foodstuffs not for medical purposes, as included in Class 29, namely

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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

Case law



protein, also supplemented with vitamins and/or mineral salts as well as carbohydrates, always in particular in powder form” (Class 29) form also part of the subject matter of the proceedings before the BoA and of the GC (Para. 56).

The GC concludes that the BoA did not, in its assessment of the evidence of use submitted by the applicant, provide any reasoning which expressly referred to any product in Class 29, in order to either acknowledge or deny that there had been genuine use of the earlier marks in connection with such goods (Para. 57).

Moreover, the BoA also did not rule on some claims of the parties, in particular the intervener’s claim that one product cannot fall within two classes (Para. 60).

Consequently, the GC affirms that the contested decision does not state the reasons why for the goods in Class 29 which are the subject matter of the proceedings there has not been proven use of the earlier marks (Para. 63).

The GC finally reminds that it is not for the GC to examine that question, for the first time, in the framework of its of the lawfulness of the contested decision (Para. 66).

Case T-211/14; Bernhard Rintisch v OHIM; Judgment of 24 September 2015; Language of the case: DE

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Proof of use, Use not as registered, Three dimensional mark

FACTS: The applicant for cancellation requested the revocation for non-use of the 3-D-mark shown below. The CTM is registered for “ovens” (Class 11). The proprietor of the CTM filed evidence of use of the CTM which contained the shape of the CTM with the additional word element “Bullerjan” on it. Both instances found that the use requirements have been satisfied and rejected the request for declaration of revocation for non-use. The applicant for cancellation appealed to the GC alleging infringement of Article 15 (1) (a) CTMR.



SUBSTANCE: The GC departs from the statement that in a proceeding of declaration of revocation based on non-use, it might not be assumed that the registered mark is devoid of distinctive character or

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



necessary to obtain a technical result (Paras. 19 and 20).

The applicant puts forward that in case to a shape of the goods a distinctive word element is added, the shape cannot fulfil anymore the origin function of a mark. Secondly the Applicant contends that the addition of the word element would alter the distinctive of the mark as registered (Para. 25).

The GC refers to the case-law that a mark can be used as such also in the context of a complex mark, in the sense that two marks may be used at the same time in one complex mark containing both of those marks (Para. 29).

However, according to the Case-Law, in the above case, the use of a mark in a more complex mark shall not influence the mark as registered and for the purpose of this assessment, the intrinsic distinctive character of the mark as registered shall be examined and then compared to the distinctive character of the additional elements included in the mark a used (Paras. 32-33).

For the case at hand the GC concluded that the shape is unusual and reminds an engine of an aeroplane rather than an oven. The distinctive character is therefore high (Para. 38).

The distinctive character of the word element "Bullerjan" is average (Para. 40).

Under the given circumstances the distinctive character of the mark as used does not alter the distinctive character of the mark as registered and is to be considered as an acceptable variant thereof according to Article 15 (1) (a) CTMR.

Case T-317/14; Bernhard Rintischjuj v OHIM; Judgment of 24 September 2015; Language of the case: DE

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Proof of use, Use not as registered, Three dimensional mark, Distinctive element

FACTS: The applicant for cancellation requested the revocation for non-use of the 3-D-mark shown below. The CTM is registered for "ovens" (Class 11). The proprietor of the CTM filed evidence of use of the CTM which contained the shape of the CTM with the additional word element "Voxka" on it. Both instances found that the use requirements have been satisfied and rejected the request for declaration of revocation for non-use. The applicant for cancellation appealed to the GC alleging infringement of Article 15 (1) (a) CTMR.

CTM



First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



SUBSTANCE: The GC departs from the statement that in a proceeding of declaration of revocation based on non-use, it might not be assumed that the registered mark is devoid of distinctive character or necessary to obtain a technical result (Para. 19 and 20).

The Applicant puts forward that in case to a shape of the goods a distinctive word element is added, the shape cannot fulfil anymore the origin function of a mark. Secondly the Applicant contends that the addition of the word element would alter the distinctive of the mark as registered (Para. 25).

The GC refers to the case-law that a mark can be used as such also in the context of a complex mark, in the sense that two marks may be used at the same time in one complex mark containing both of those marks (Para. 29).

However, according to the case-law, in the above case, the use of a mark in a more complex mark shall not influence the mark as registered and for the purpose of this assessment, the intrinsic distinctive character of the mark as registered shall be examined and then compared to the distinctive character of the additional elements included in the mark a used (Paras. 32-33).

For the case at hand the GC concluded that the shape is unusual and reminds an engine of an aeroplane rather than an oven. The distinctive character is therefore high (Para. 38).

The distinctive character of the word element "Voxka" is average (Para 40).

Under the given circumstances the distinctive

character of the mark as used does not alter the distinctive character of the mark as registered and is to be considered as an acceptable variant thereof according to Article 15 (1) (a) CTMR.

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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

Case law



New Decisions from the Boards of Appeal

Decision of 20 November 2015 – R 626/2015-1 – CLEANER PLEASURE; Language of the case: EN

RESULT: Decision annulled.

KEYWORDS: Reimbursement, Substantial procedural violation.

FACTS: The applicant sought to register the word mark 'CLEANER PLEASURE' for goods in Classes 9, 11 and 34. The examiner issued a provisional partial refusal of the application. In response to a request from another examiner relating to the classification of the goods, the applicant amended the specification of the goods in Classes 9 and 34. Thereafter other amendments were requested as regards the applicant's list of goods by the examiner dealing with classification. The previous examiner issued the contested decision partially rejecting the application for goods in Classes 11 and 34 pursuant to Article 7(1)(b), 7(1)(c) and Article 7(2) CTMR. The applicant appealed the contested decision.

SUBSTANCE: The Board annulled the contested decision because the classification of the goods and absolute grounds were examined in parallel and the contested decision did not take into account the amendments made to the specification. The decision, therefore, lacked reasoning and constituted an infringement of Article 75 CTMR. The

case was remitted to the examiner, in particular, to examine the absolute grounds of refusal on the basis of the application's actual list of goods.

[Link to eSearch Case Law](#)

Decision of 6 November 2015 – R 954/2015-1 – CAFFÈ NERO (fig.); Language of the case: EN

RESULT: Decision confirmed.

KEYWORDS: Deceptive element, Descriptive element, Distinctive element, Figurative element, Figurative trade mark.

FACTS: The applicant sought to register the figurative mark represented below for various goods and services in Classes 30, 35 and 43. The examiner rejected it, under Article 7(1)(b), (c) and (g), and Article 7(2) CTMR, for the goods in Classes 30 and 35. The applicant filed a notice of appeal.

CTMA



SUBSTANCE: With regard to Article 7(1)(b) CTMR, the Board found that the typeface, the size of the letters and the colours, as well as the overall composition of the sign did not depart significantly from those

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



commonly used in trade. The Board considered that they would not make an immediate and lasting impression on the relevant public.

Moreover, in the context of the goods refused under Article 7(1)(c) and Article 7(2) CTMR, the expression 'CAFFÈ NERO' would be understood as an indication that they were, or contained, black coffee or possessed a black coffee flavour. With regard to the services related to foodstuffs, the term would also be understood as an indication that the foodstuffs were or contained black coffee or possessed a black coffee flavour. Therefore, the expression 'CAFFÈ NERO' was a direct and obvious reference to the nature of these foodstuffs and these services related to foodstuffs.

The Board also held that the CTM application was to be rejected under Article 7(1)(g) CTMR in respect of the goods 'tea, cocoa, coffee substitutes; herb tea; tea beverages; cocoa and cocoa-based preparations; cocoa beverages; preparations and mixes for making the aforesaid goods; powdered chocolate' in Class 30. The Board considered that consumers were likely to believe that these goods were or contained black coffee while this would not in fact be the case. The goods were sold in packaging which was quite similar to that used for coffee. Consumers might often buy these goods rather hastily and would not indulge in analysing the wording on the packaging. It was, therefore, likely that they would choose these goods from the shelf in the erroneous

belief that they were or contained coffee. Therefore, the sign applied for would be deceptive in respect of the abovementioned goods.

[Link to eSearch Case Law](#)

Decision of 12 November 2015 – R 2860/2014-1 – ORACOMEGA / OMEGA; Language of the case: EN

RESULT: Decision confirmed.

KEYWORDS: Dissimilarity of the goods and services, Likelihood of confusion, Nature of the goods and services, Nature of use, Purpose of the goods and services.

FACTS: The applicant sought to register the word mark 'ORACOMEGA' amongst others, for goods in Class 5. The opponent filed an opposition based on Article 8(1)(b) CTMR against the mark on the basis of earlier CTM registration 'OMEGA'. The opposition was based on goods in Classes 29, 30 and 32. The Opposition Division rejected the opposition in its entirety, because it found the contested goods and the opponent's goods to be dissimilar on the grounds of their different purposes, producers, distribution channels and because neither were complementary to, nor in competition with, each other. The opponent filed an appeal against the contested decision.

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



SUBSTANCE: The Board found that the goods in Class 5 'food and dietary supplements; nutritional preparations and substances; herbal and marine substances, enzymes, plant and fish oils' were dissimilar to common foodstuffs in Classes 29 and 30 and beverages in Class 32. They had a different purpose (balancing nutritional deficiencies and medical purposes vs. satisfying basic human needs and quenching thirst). They were not complementary to, or in competition with, each other and were not offered in the same outlets. The public was aware that the producers differed.

[Link to eSearch Case Law](#)

Decision of 26 November 2015 – JOINED CASES R 112/2015-2 & R 190/2015-2– WIDIBA / ING DiBa (fig.) et al.; Language of the case: EN

RESULT: Decision annulled.

KEYWORDS: Complementary goods and services, Likelihood of confusion, Similarity of the goods and services, Used in the course of trade.

FACTS: The applicant sought to register the word mark 'WIDIBA' for goods and services in Classes 9, 16, 36 and 38. The opponent filed an opposition against all the goods and services of the application on the basis of, inter alia, German trade mark registration 'DiBa' for services in Classes 36, 38 and

42. The grounds of the opposition were those laid down in Article 8(1)(b) CTMR. The applicant filed a notice of appeal.



SUBSTANCE: In the Board's view, 'financial services' were not only related to 'credit cards', they were indispensable and crucial for them, and the only reason for the existence of 'credit cards', and therefore their only intended purpose, was to be used in the course of 'financial services'. For the end consumer, the usual origin of a 'credit card' was a bank, despite the fact that they did not produce them. The contested 'credit cards' and the earlier 'financial affairs' were complementary, and as a consequence, similar to each other. The Board considered that the Office's Guidelines in this respect, particularly the part that dealt with the comparison between 'credit cards' in Class 9 and 'financial services' in Class 36 (Title 8.3, in the Annex to Chapter 2 'comparison of goods and services' of Part C, Section 2) could not be followed. The contested decision's reasoning and conclusion,

First Page

■ IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

■ Nice 10/2016: KCG&S Issues

Registered Community Design

■ Déjà Vu Reference

Statistical Highlights

■ December 2015

ETMDN Updates

■ The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass

■ Changes to trade mark and design fees in Finland

■ EU trade mark reform legislative package published

More News

■ Communication of the President of OHIM: renewal fees

■ Reimbursements to users: renewal fees

■ DesignEuropa Awards: celebrating design in the EU

■ New EU trade mark Regulation – resources for users

■ Publication of online advertising study

Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

Case law



namely that the signs under comparison were similar, were endorsed. Taking into account that when confronted with financial services, the general public also displayed a higher level of attention, the Board concluded that the relevant consumer, when confronted with the applicant's 'credit cards' bearing the mark 'WIDIBA', would erroneously believe that they were issued in the course of the opponent's earlier 'financial affairs' under the mark 'DiBa'. Therefore, a likelihood of confusion existed and the opposition succeeded.

[Link to eSearch Case Law](#)

First Page

- IP Case Law Conference at OHIM

James Nurton Interviews | Sakari Salonen

Community Trade Mark

- Nice 10/2016: KCG&S Issues

Registered Community Design

- Déjà Vu Reference

Statistical Highlights

- December 2015

ETMDN Updates

- The Brazilian National Institute of Industrial Property (INPI-BR) joins TMclass
- Changes to trade mark and design fees in Finland
- EU trade mark reform legislative package published

More News

- Communication of the President of OHIM: renewal fees
- Reimbursements to users: renewal fees
- DesignEuropa Awards: celebrating design in the EU
- New EU trade mark Regulation – resources for users
- Publication of online advertising study

Case Law

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