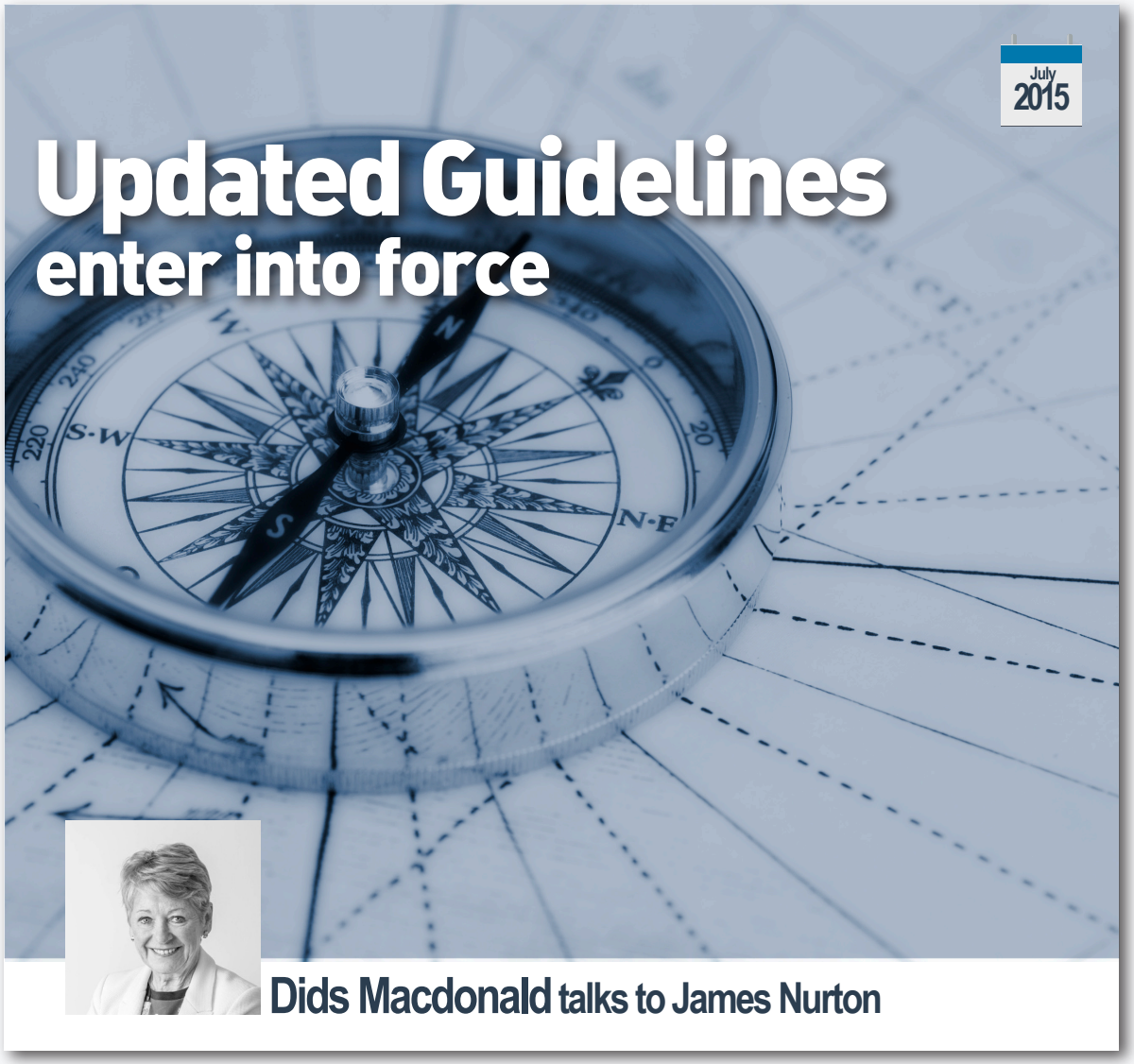
Alicante News

Up to date information on IP and OHIM-related matters



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Updated Guidelines enter into force

This month's edition of Alicante News contains summaries of the second set of OHIM's updated Guidelines, which provide users with an overview of the modifications that the Office has implemented.

On 1 August 2015, the second set of the updated Guidelines entered into force, following their adoption by the President of the Office on 8 July 2015 (Decision EX-15-2).

The corresponding documents are available on the website's Current trade mark practice page and the Current designs practice page.

The texts can be accessed in English, French, German, Italian or Spanish under a clean version or under a track-changed version. Users can clearly distinguish the changes that have been implemented since the version adopted last year by the President by using the track-changed version.

In 2013, the Office's Knowledge Circles, involving staff from different departments and the Boards of Appeal took the first concrete steps towards uniting what were previously separate Manuals of trade mark and design practice and 'official' Guidelines into a single set of published Guidelines.

The Knowledge Circles now thoroughly review and update the Guidelines in a cyclical process, taking account of case-law from the Boards of Appeal and the Court of Justice, the operational needs of the Office and the outcome of the various convergence projects, such as the harmonisation of classification project (CP1). User associations and national and regional IP offices can comment on the Guidelines, and they are invited to send observations on the drafts. The Knowledges Circles then take their feedback into consideration.

The first half of the updated Guidelines was adopted in December 2013 and entered into force at the beginning of February 2014. This was followed by the presentation of the second half of the Guidelines at the May meeting of the Administrative Board, and their subsequent adoption in July 2014.

The revision of the Guidelines will increase consistency and predictability for users, and is

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aligned with the goals of OHIM's Strategic Plan.

The previous Manuals for Trade Mark and Design practice were phased out last year and the entire Office practice is available in a full set of updated Guidelines.

On 9 September 2015, a webinar on the new Guidelines will be broadcast live. Further information will be available at the beginning of September.
The full cycle of revision has now been completed and the Office is already in the process of reviewing the first work package of the Guidelines.

The OHIM Guidelines are the main point of reference for users of the Community trade mark system and professional advisers who want to make sure they have the latest information on OHIM's examination practices.

They have been drawn up to reflect Office practice in the most frequent scenarios. They contain general instructions, which have to be adapted to the particularities of a case. They are not legislative texts and, therefore, they are not binding.

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The James Nurton Interview

Dids Macdonald, CEO of Anti Copying in Design (ACID)What is your background?

Tell me a bit about what ACID is and why you started it?

My history is as an interior designer and then a product designer. Every time I brought out a new product or product range one of the greatest challenges was infringement of our rights. In 1996 there was very little one could do – design law seemed unbelievably complex, and access to lawyers who could speak the same language as me seemed very difficult.

Dids Macdonald

We started a small roundtable action group of people with the same concerns in 1996-97, which was voluntary at first. We formalised it in 2000 and today we represent thousands of designers in the UK.

Our main aims are education and raising awareness, which is ongoing. When I started I wanted to simplify the communication of what it means in terms of being IP savvy, to deter IP theft by providing practical help, to provide support when things go wrong – including access to opinions and practical help and support to make things go right in terms of having an IP strategy, and lastly to campaign for design law reform.

Do you think the environment for designers has improved since 1996?

When I started in this area, design wasn't even included in the dialogue about IP rights nationally or globally. I think ACID has contributed a lot to the conversation nationally and internationally to recognise the huge contribution that design makes – that's not just about design rights but also trade marks and copyright and patents to a lesser degree. Design is much more on the radar now.

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Have the introduction of RCDs and unregistered designs helped?

The introduction of the RCD was a great step forward. I don't necessarily think OHIM has done an awful lot to market it. There are only 5,500 registrations from the UK which is pretty poor. The unregistered right is a good initiative but it is only for three years and doesn't seem to harmonise with copyright.

In the UK you don't have the advantage that unfair competition kicks in where IP fails, so British designers are at a disadvantage. The UK national office only has about 4,500 registrations and that hasn't really improved in the last decade.

So I think there is a lot that can be done to simplify registrations so that they are designed for designers not lawyers. I'm working with the UK IPO to help them do that. Some forms are a complete inhibitor to registration.

Our own Design Databank has about 18,000 to 25,000 designs lodged very year. That shows there is demand for protection and we're not doing enough to meet that nationally or in Europe.

And yet the cost of design rights is relatively low, and the process is quick?

But it is complicated. And designers think visually, not in a linear way. When you say it's not expensive, consider that the average earnings of a designer are £14 to £19 an hour. There are 350,000 in the UK and the majority have less than 10 employees, 60% have less than four employees, so it is an expense. The design spend in the UK is £33.5 billion, but it is mainly micro and SMEs, so the system needs to be user-friendly for people at the very low end of the spectrum.

I'd like to see design applications becoming much cheaper. There is no examination involved. It's just a process. Professor Hargreaves in his review was right to say it's been neglected, and it still is.

Can you tell me a bit more about the Design Databank?

When we started ACID, there was nothing at grass roots to help designers, so I created an unofficial Design Databank. It's not a register, but it's a Databank where you can send designs and the date is lodged by a third party. That is available and it's been used as evidence in the IP Enterprise Court and elsewhere to substantiate dates. It gives confidence to know someone is holding your design in a secure place.

We have also developed the ACID Marketplace, which is a conduit like the Copyright Hub where designers can put their designs out there before design buyers. It can provide a conduit to build collaborative relationships using tradeable

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intellectual property. It's one of the key benefits of ACID.

Another benefit was that we worked out that most copying was at exhibitions, so we developed a service at exhibitions, and we've done about 3,500 of those. 97% of those have provided solutions: either a licensing deal has been brokered, companies have given undertakings not to produce knock-offs, or there has been a collaborative relationship.

Litigation is not a luxury micro-designers can afford. Look at the equation between £14-£19 and hour and £200-£400 an hour: there is no connection. That's why we emphasise education, deterrent and support.

Is there a long-term solution to the imbalance between small designers and big industry?

Large retailers have a lot of questions to answer. Designs give them a competitive edge but many don't respect the rights of small designers. They copy and change designs just sufficiently so they can't be challenged. Small designers haven't got a hope in hell: it's a David-and-Goliath situation.

My plea to major retailers is: there's an amazing resource here, why don't you commission designs and support the originators? It should be part of corporate social responsibility that comes from the top down. We are known for our design industry in this country but a lot of it is being stolen by those who purport to be respectable.

We've had a dialogue with some retailers, but it's fallen on stony ground. It needs a change in the culture at director level.

One thing you campaigned for was the criminalisation of registered design infringement, in the 2014 IP Act. Has that had a positive impact?

We wanted the criminalisation of registered and unregistered designs to be on a level footing with trade marks and copyright. It was never about putting people in prison but about supporting designers and having a deterrent effect. It's early days, but I believe the fact that directors may be liable is another point that may influence board strategies and make them think before intentionally infringing designs. Now the work starts again to see if we can get unregistered designs included.

I was surprised at the opposition, especially from design leaders such as James Dyson. But then we realised that for members of the IP Federation the ratio of patents to designs was 40:1! They're very big organisations and they have means to obtain and enforce patents. Designers don't have that luxury.

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Big companies should have strategies in place to make decisions to ensure they do not infringe. It would be very unlikely for someone to be criminalised because they have unintentionally copied a design, and the Act made that clear. So I would like to have seen big companies support the SME and micro community.

Are there other issues where you think reform is needed?

One area where we've had a lot of feedback is that IP disputes are still quite expensive for small companies. We need to make designers aware of the small claims track, which is under-used. There hasn't been much take up of the UK IPO mediation services, so I think there could be more done to improve access to mediation and even make the requirement to go to mediation higher up the scale.

Mediation has been very successful at the grass roots. No two mediations have been the same. It's more often than not a commercial situation, not just about the application of the law. It's about getting two people in a room together to work out a compromise.

We have our own model with timed mediations of three hours. We get people round a table. We had one recently with two people in the furniture industry who had spent £18,000 to £20,000 on various letters and weren't speaking to each other. At the end of the day they left in a taxi together having agreed a way of working.

More could be done with buy-in form the institutions, law societies etc to make it a more user-friendly process from the beginning.

Are you still active as a designer?

No, not since we formalised ACID. We now have a small team supported by lawyers who provide an opinion service pro bono: that means designers can work out if they've got a strong case and if it's worth taking legal action.

I have done some designing in recent years though: I turned a ruin into a home in Provence, but that was very much in my spare time. I was recently made a fellow of the British Institute of Interior Design and I work very closely with design organisations in the UK.

When I worked as a designer, one of the most prestigious jobs was to design the Crown Prince of Abu Dhabi's apartments behind Harrods in London. I had previously worked as airline cabin crew on Concorde and I retired from that to take up design. This was the first job we got – no other designer would touch it because of the short lead-time. They had a quantity surveyor so the budget was tightly controlled. It was a wonderful job to do as a platform for our business.

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And you were recently made an Officer of the Order of the British Empire (OBE). Can you tell us about that?

I'm thrilled to bits about it. It is recognition of some fantastic designers and the intellectual capital that underpins our fantastic sector.

Between September and November I will go to either Buckingham Palace or Windsor Castle and receive the OBE from the Queen, Prince Charles or Prince William. My father also got an OBE in fact so I am following in his footsteps!

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Work Package 2/2015 Review and changes of practice (CTM)

In 2015, the work of the Knowledge Circles, the teams of experts entrusted with keeping the Office practice up to date, continued with the review of the existing **Guidelines**.

The idea is to keep the unique source of reference, the Guidelines, up to date on a regular basis by bringing together, in a systematic manner, the practice principles derived from the **case-law** of the European Court of Justice, the **jurisprudence** of OHIM's Boards of Appeal and the **decisions** of OHIM's operational departments as well as the conclusions of the **Convergence Programmes**.

The cycle to review these Guidelines is divided in two work packages.

The revision of the first work package was completed at the end of 2014 and the text entered into force on 1 February 2015 further to the decision of the President EX-14-4.

Now, the review process of work package 2 has been completed. All Parts, Sections and Chapters of the Guidelines contained in this work package have been reviewed by the Knowledge Circles and have been approved by the internal and external stakeholders. They are adopted by the President by means of Decision EX-15-2 and will enter into force on 1 August 2015.

Parts of the Guidelines contained in WP2/2015

Part A: General Rules

- Section 1, Means of communication, time limits
- Section 2, General principles to be respected in proceedings
- Section 4, Language of proceedings
- Section 6, Revocation of decisions, cancellation of entries in the Register and correction of errors
- Section 7, Revision
- Section 8, Restitutio in Integrum
- Section 9, Enlargement

Part B: Examination

- Section 1, Proceedings
- Section 3, Classification
- Section 4, Absolute Grounds for Refusal 7(1)(f), (g), (h), (i), (j), (k) and collective marks

Part C: Opposition

- Section 3, Unauthorised filing by agents of the TM proprietor (Article 8(3) CTMR)
- Section 4, Rights under Article 8(4) CTMR
- Section 5, Trade marks with reputation Article 8 (5) CTMR

Part D: Cancellation

- Section 2, Substantive provisions

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Part E: Register Operations

- Section 1, Changes in a registration
- Section 3, CTMs as objects of property
- Chapter 1, Transfer
- Chapter 2, Licences
- Chapter 3, Rights in rem
- Chapter 4, Levy of execution
- Chapter 5, Insolvency proceedings or similar proceedings

Part M: International marks

Registered Community Designs

- Examination of Applications for Registered Community Designs
- Renewal of Registered Community Designs

General changes

All changes made appear in legal blackline (with track-changes) so our users can easily see what has been updated.
In general the changes concern modifications to the format and structure, updated case-law and cross-references, corrections of errors and clarifications in wording.

Change in practice

Part B. Examination

Part B: Examination. Section 1, Proceedings

Withdrawal/restriction of the CTM application

The Guidelines specify that a CTM can be withdrawn or restricted at any time until a final decision is taken on the subject matters. The time limit for withdrawals and restrictions has been extended considering the "délai de route" of 10 days to so bring it in line with the appeal period before the General Court and the Court of Justice. This means that the users have now two months + 10 days to withdraw or restrict their CTM application. This practice change is due to the order of the General Court in case T-15/03.

Part B: Examination. Section 3, Classification

Requirements of clarity and precision and services

In the 'Netto Marken-Discount' Judgment C-420/13 of 10/07/2013 the Court confirmed that the bringing together of services is an activity which is entitled to protection. As a result, the Guidelines on Classification have been elaborated to give details as to the exact wording to be used when seeking protection for these kinds of activities in order to identify specifically and precisely both the services rendered which constitute the bringing together

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service and the services brought together.

The Guidelines clarify that the services being brought together must satisfy the fundamental requirements of clarity and precision.

Furthermore, in order to frame the services being brought together, the Office will accept wording such as "the bringing together, for the benefit of others, of a variety of legal services, enabling customers to conveniently compare and purchase those services." On the other hand, wording such as "retail services connected with the sale of legal services" will not be accepted because this latter does not clearly distinguish between the retail trade of services and the provision of those services, in substance and in scope, in their own right.

Other clarifications of practice

As mentioned above, all changes are reflected in legal blackline (with track changes) in the relevant sections of the Guidelines published here and here. However, certain sections of the guidelines have seen substantial changes, which, whilst not resulting in a change in practice as such, are certainly worthy of mention:

Part A: General Rules

Part A: General Rules. Section 1, Means of communication, time limits

Date of notification and communication of documents

The Guidelines now clarify that the relevant date of notification and communication of a document is the date on which the addressee (including OHIM) receives this document or the date when a document is deemed to be received. This clarification is in line with recent case law of Court of Justice (C-324/13-P).

Continuation of proceedings

The paragraph on continuation of proceedings has been re-drafted in order to clarify to which time limits continuation of proceedings is NOT applicable.

Part A: General rules. Section 2, Principle to be respected in proceedings

Adequate reasoning/Right to be heard/General principles of EU law

All of these paragraphs have been re-drafted in order to improve their structure and content so that they clarify the related implications according to recent case law.

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Means of taking evidence and oral proceedings

The paragraph on affidavits has been improved and case law has been added.

Part A: General Rules. Section 6, Revocation of decisions, cancellation of entries in the Register and correction of errors

Who decides on requests for revocation/cancellation?

It has been added that a decision on revocation/cancellation of an entry in the Register can be appealed.

Error notified by the affected party or one of the parties

The Guidelines now clarify that in case the applicant/owner of a Community trade mark or the party adversely affected inform about an error, the Office will understand this as a request for revocation/cancellation.

Part A: General Rules. Section 8, Restitutio in integrum

Re-drafting of a whole part of the Guidelines

Due to comments from User Associations the part on Restitutio in integrum has been completely re-drafted. The principles of Restitutio in integrum have been clarified and examples for "taking due care" have been introduced.

Part B: Examination

Part B: Examination. Section 4, Absolute grounds for refusal

Changes to the sections of the Guidelines dealing with public policy and morality, deceptiveness, PGIs and flags and other symbols (Article 7(1)(f) to (k) CTMR) have not been substantially amended: only some parts of the text have been slightly reworded and some examples have been modified.

With respect to Collective Community Trade Marks (CCTM) section, it has been specified that the regulations provided by the applicant governing the use of CCTM mark must cover the use of the CCTM for all the goods and services included in the list applied for under the CCTM. For CCTM conflicting with PGIs/PDOs, it has been further clarified that the regulations governing the use of a CCTM should accurately reflect any limitation introduced to overcome such conflict.

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Part C: Opposition

Part C: Opposition. Section 3, Unauthorised filing by agents of the TM proprietor (Article 8(3) CTMR)

A clarification of the nature of the relationship between the parties required for the application of art. 8(3) CTMR and replacement of the term "agency agreement" with "co-operation agreement" following the Judgment of 09/07/ 2014, T 184/12 ´Heatstrip'. Following this judgment further indications for the existence of such an agreement (exclusivity, anti-competition clause) were clarified as well as the question of the justification on the part of the applicant.

Part C: Opposition

Part C: Opposition. Section 4, Rights under Article 8(4) CTMR

New case-law has been incorporated, e.g. T-321/11 and T-322/11 "partidodellaliberta.it" with regard to domain names as a kind of other business identifiers, T-579/10 "makro" clarifying when the right invoked is an "earlier " one (the relevant date of acquisition of exclusive rights under the national law is decisive) and T-506/11 'Peek & Cloppenburg` emphasizing that the question whether the use of a non-registered sign is of more than mere local significance will be answered by applying a uniform European standard.

Part C. Opposition

Part C: Opposition. Section 5, Trade marks with reputation Article 8 (5) CTMR

There is a change in the terminology since the term "encroachment" has been replaced by the "risk of injury".

New case-law has been incorporated namely C-65/12, 'The Bulldog', with regard to the due cause. The Court of Justice ruled in the context of Article 5(2) of Directive 89/104 (whose legislative content is essentially identical to that of Article 8(5) CTMR) that the proprietor of a trade mark with a reputation might be obliged, pursuant to the concept of 'due cause' within the meaning of that provision, to tolerate the use by a third party of a sign similar to that mark in relation to a product that was identical to that for which that mark had been registered, if it was demonstrated that that sign was being used before that mark had been filed and that the use of that sign in relation to the identical product was in good faith.

The section on "affidavits" was aligned with other parts of the Guidelines, especially for the reasons of consistency with the Chapter on "Proof of Use".

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Part D: Cancellation. Section 2, substantive provisions

Editorial changes have been implemented: Titles have been aligned across section and examples from the case-law have been deleted, as far as they are covered by the cross-references to other parts of the Guidelines (on "Double identity or Likelihood of Confusion" or on "Proof of Use") and were not adding anything particular to the Cancellation itself.

The section on "res judicata" has been clarified.

The section on "bad faith" has been improved by introducing recent case-law. In particular, it has been stressed that the concept of bad faith is a concept of EU law, in light of the case C-320/12 'Malaysia Dairy Industries'. Moreover, the section on the factors likely to indicate the existence of bad faith has been revised and improved with the judgments given in T-327/12 'Simca', T321/10 'Grupo Salini' and T-33/11 'BIGAB'.

As regards invalidity proceedings based on absolute grounds, the concept of relevant public has been re-defined as a consequence of the judgment in C-409/12 'Kornspitz'. The burden of proof section has been updated with a reference to T-320/10 'Castel': the Office limits its assessment to facts and arguments put forward by the invalidity applicant. A new text has been proposed regarding the "defence against a claim of lack of distinctiveness" explaining that the burden of proof is on the CTM proprietor.

Part E: Register Operations

The majority of the amendments affecting the different sections of 'Register Operations' is quite concrete and usually refer to specific particulars of this part of the Guidelines.

Part E: Register Operations. Section 1, Changes in a registration

Some minor clarifications have been inserted in the text, some legal references have been added and references to "mark" have been changed to "CTM".

In point 2.3.2 "Examples of unacceptable alteration the whole text has been deleted, because it was repetitive. In Point 5.2.3 instead of application it has been corrected to read "registration". In Point 5.3 the first bullet point has been clarified. In point 6.4.2 the notion of "identity of marks" as seen by the General Court has been clarified and a reference to the Guidelines, Part B, Examination has been inserted. In Point 6.5 concerning the data which will be published in the context of the registration of a seniority claim, it has been added: registration date and date of priority.

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Part E: Register Operations. Section 3, CTMs as objects of property. Chapter 1, Transfer

In several places, the possibility to file an appeal has been inserted.

In the first point, some subtitles as: Assignment, Inheritance, Merger and Applicable Law have been created.

In point 2 a BoA decision has been added, according to which the change of country is not always to be considered as a transfer but depending on the applicable law may be a mere change of name.

Under point 3.4.4 it has been inserted that in case of co-ownership, as formal requirement all co-owners must sign the request.

Under 3.5 it has been inserted that in case of several transfers and/or changes of name it may be requested to record in the Register the "last" proprietor without asking for the intermediate steps. The chain of transfers and/or changes of name has to be explained in such a case.

In has been further clarified by adding that in cases where the transfer may not be filed by the original proprietor which may happen when the CTM or RCD is subject to a right in rem, levy of execution or insolvency, the application for the assignment must be accompanied by the pertinent decision from the national authority, as for example the Court judgment which decides on the assignment. .

Under point 3.6 with respect to the provision about the misleading transfer (Art. 17 (4) CTMR) the substantive part has been deleted.

Part E: Register Operations. Section 3, CTMs as objects of property. Chapter 2, Licences

In the part concerning licences there have been no substantial changes as to the content. In several places, it has been added that some decisions with final character may be appealed before the Boards of Appeal.

Under points 2.4.3.1. and 2.4.3.2. it has been inserted that in case of co-ownership, as formal requirement all co-owners must sign the request.

Part E: Register Operations. Section 3, CTMs as objects of property. Chapter 3, Rights in rem

In several places, the possibility to file an appeal has been inserted.

In the first point, some subtitles as: Applicable Law and Advantages have been created.

Under points 2.4.3.1. and 2.4.3.2. It has been inserted that in case of co-ownership, as formal requirement all co-owners must sign the request.

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Part E: Register Operations. Section 3, CTMs as objects of property. Chapter 4, Levy of execution

In several places, the possibility to file an appeal has been inserted.

In the first point, some subtitles as: Applicable Law and Advantages have been created.

Under points 2.4.3.1., it has been inserted that in case of co-ownership, as formal requirement all co-owners must sign the request.

Under Point 5 it has been clarified that OHIM's Recordal Application must be used for the request of a levy of execution of an International Mark.

Part E: Register Operations. Section 3, CTMs as objects of property Chapter 5, Insolvency proceedings or similar proceedings

In several places, the possibility to file an appeal has been inserted.

In the first point, some subtitles as: Applicable Law and Advantages have been created.
Under Point 5 it has been clarified that OHIM's Recordal Application must be used for the request of an insolvency of an International Mark.

Part M: International marks

Under point 2.1.3.2: For the identity between the basic mark and the International mark a reference to the Guidelines in Part B, Formalities has been added.

Under point 3.3.3 Formalities: It has been inserted the new Practice that the Office will examine the list of goods and services weather they meet the requirements of clarity and precision as described in the Guidelines Part B, Classification.

The new Point 3.3.3.4 has been inserted explaining the notion of "Vague terms" which will be examined by OHIM. In case that the deficiency is not overcome the Office confirms the provisional refusal. This decision is appealable.

Under points 3.4 and 3.6.8 Absolute Grounds for Refusal, some clarification as to the ex Officio examination and the procedural flow have been included. Moreover, the new examination as to vague terms has been incorporated also in these sections.

Under point 4.4.3 concerning the procedure for the replacement of an International Mark, it has been included that in case that the list of goods and services is narrower a deficiency will be issued. It may be overcome by surrendering the goods and services outside the scope of the International Mark.

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Examination of Applications for Registered Community Designs

More information with reference to case law has been added in section 4.1.7 as concerns examination of application where the subject matter is a living organism. The Office would not accept a living organism even if it deviated from a common form, unless it would be proved that it is a result of a manual or industrial process.

In section 6.2.1 concerning the examination of priority claims the Office will, modifying its previous practice, invite the applicant to submit comments where it would be found that the priority claim does not concerns a design or a utility model, and where it would be found that the previous application is not a first filing.

In section 2.7 concerning registration requirements a note has been added that payment by credit card is an option.

In section 12.2.2.7 it has been specified that a deficiency communicated by the Office in the examination of an international design with EU designation may be remedied not only by overcoming the objections raised by the Office but also by a withdrawal of the application.

No changes

The following parts have not been changed during the last revision cycle:

- Part A: General rules.Section 4, Language of proceedings
- Part A: General rules.Section 7, Revision
- Part A: General rules.Section 9, Enlargement
- Renewal of Registered Community Designs

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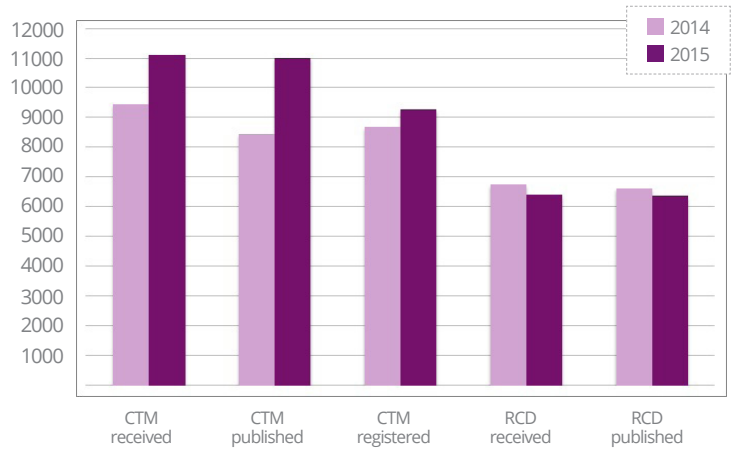
Monthly statistical highlights June*	2014	2015
Community Trade Mark applications received	9 443	11 110
Community Trade Mark applications published	8 454	11 008
Community Trade Marks registered (certificates issued)	8 676	9 265
Registered Community Designs received	6 739	6 408
Registered Community Designs published	6 625	6 366

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



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Close to 5 000 new goods and services from the Madrid system now available in our online services

This enlarged classification database became available as from 1 July in our online services – the Five-step form, the Advanced form and the Goods and Services Builder – as well as in TMclass.

The terms have been provided by the World Intellectual Property Office (WIPO) and they are pre-approved for International Applications in the Madrid System. They have been added to the 65 000 terms of our classification database, known as the Harmonised Database, whose terms are pre-approved by all the European Union (EU) intellectual property offices.

This is the first time goods and services from the Madrid System have been added to our classification database. In the future, we will add new terms from the Madrid Goods and Services regularly, so that users of the Community registration system can benefit from the advantages of having terms that are accepted at international level.

With the addition of the goods and services from the Madrid System, the Harmonised Database expands its geographical and language coverage even further.
Our classification solutions: multilingual, close to the market and built for smoother registration

Ireland implements Quality

The Irish Patents Office (IEIPO) has implemented the Quality tool, developed by the Cooperation Fund.

The Quality tool provides a common statement of transparent service commitments for end users, which are structured to enable adoption by any European Industrial Property office.

Quality standards are divided by category and measure timeliness, quality, accessibility and consistency of the services as perceived by the users.

BOIP implements e-filing for trade marks

The Benelux Office for Intellectual Property (BOIP) has implemented trade mark e-filing developed by the Cooperation Fund.

Users of BOIP's services will be able to avail of the following benefits:

- An intuitive and user-friendly interface
- Quick and easy to find and select all the relevant goods and/or services
- Immediate PDF confirmation in user mailboxes, with the application number and a financial overview

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The overall aim of the Cooperation Fund is to benefit users across the EU by providing modern, state of the art tools and services for EU national and regional offices. The integration of the trade mark e-filing system in BOIP was possible due to the close cooperation between OHIM and Benelux colleagues.

The Harmonised Database

The Harmonised Database is the world's largest multilingual database for goods and services. The terms it contains are pre-approved by all EU national and regional IP offices, including OHIM.

Whenever you select a term from the Harmonised Database, you can be sure it will be accepted when your application is examined. It will also mean that the term is already translated into all other EU languages (except Irish). Your application can therefore be processed more smoothly.

Serbia joins TMview

As of 06 July 2015, the Serbian Intellectual Property Office (IPORS) has made its trade mark data available to the TMview search tool.

The integration of IPORS is a concrete result of the International Cooperation programme managed by OHIM in collaboration with its international partners.

This latest extension brings the total number of offices participating in TMview to 39 and with the addition of almost 46,000 trade marks from Serbia, TMview now provides information and access to more than 27.8 million trade marks in total.

Since the introduction of TMview on 13 April 2010, the tool has served more than 14 million searches from 144 different countries, with users from Spain, Germany and Italy among the most frequent visitors.

You can find out more at www.tmview.org

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Over €26 billion and up to 363,000 jobs lost every year in the EU due to counterfeiting of clothes, shoes and accessories

The manufacture and distribution of fake clothes, shoes and accessories (such as ties, scarves, belts and gloves) takes over €26 billion every year from legitimate EU businesses, according to the results of a new OHIM study.

The report, released as part of the Quantification of Infringement series of studies released through the European Observatory on Infringements of Intellectual Property Rights, shows that the sale of fake clothes, shoes and accessories in the EU equals nearly 10% of the total sales in the sector throughout the EU-28.

That lost revenue translates into 363,000 lost jobs, as the legitimate manufacturers and retailers make and sell less than they would have done in the absence of counterfeiting, and therefore employ fewer workers.

The study also assesses the indirect effect of the counterfeit trade. When the knock-on effects on suppliers are taken into account, legitimate businesses across the EU lose €43.3 billion of sales revenue because of counterfeiting, with around 518,000 jobs lost. Since producers and sellers of fakes do not pay tax, social contributions and VAT, over €8 billion of government revenue across the EU-28 is not collected.

Update of the performance achieved by OHIM

OHIM has published the performance result of its services for the first quarter of 2015, in terms of timeliness, quality and accessibility.

Overall timeliness of operations is improving even though the number of filings is increasing compared to last year. Accessibility also got very high levels of effectiveness during the first quarter maintaining the global performance reached during last year.

The launch of CTM fast track in November 24th 2014 also allowed us to register faster. The first fast track applications were registered in March with a maximum registration time of 16 weeks, while the regular track also improved from 22 weeks last year to 21.3 weeks keeping the excellence level over the first quarter.

The new team oriented structure established at the Office with smaller teams and shorter feedback loops has increased the agility. A more frequent monitoring with early warnings issued to examiners within their teams and a new consultation procedure

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with more reference persons addressing the legal and practical issues, has contributed to the global improvement shown in both Fast track and Regular Track RCD group of indicators.

A new indicator is now part of the Service Charter. It measures the average time to accomplish the payments to the Office suppliers. The performance of the first quarter is 12 days, a result relatively close to our 18 days excellent commitment.

Regarding Appeals, the trend keeps improving achieving a very high performance for Appeals Reception with 5 days maximum time and 2 days average time for 90% of the cases.

For any comment or suggestions, please contact CGS@oami.europa.eu.

Report on protection and enforcement of IP rights in third countries

The European Commission has published its biennial report on protection and enforcement of intellectual property rights (IPR) in key third countries.

The report is part of the European Commission's Strategy for the Enforcement of Intellectual Property Rights in Third Countries. It is largely based on an EU survey on the protection and enforcement of IPR throughout the world, carried out by the Office for Harmonization in the Internal Market, and will help the Commission to update its list of 'priority countries' on which to focus its activities and efforts for improving protection and enforcement of IPR. It will also benefit third country authorities' understanding of the perception of EU users of their IPR systems, particularly in regard to potential areas for improvement.

Despite positive developments and comprehensive legal reforms, enforcement initiatives and the creation of specialised IP Courts, two thirds of goods detained in 2013 at EU borders due to suspected IPR-infringement originated in mainland China. China therefore retains its status as a priority country. The EU has, however, over the years developed close cooperation with China on IP matters and recently signed a Memorandum of Understanding to reinforce this cooperation.

India also remains a big concern for the Commission, in particular its lack of effective patent protection. The report also highlights a general worsening of IPR protection and enforcement in Argentina, Russia and Ecuador compared to the last report in 2013. Accordingly, the Commission has moved these countries up its priority list. Compared to the situation in 2013, the report identifies notable improvements in Israel and the

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Philippines. Israel has improved its protection of pharmaceutical products, while the Philippines have taken significant steps to improve the IPR environment, particularly in legislation and enforcement.

The report provides valuable information for EU rights' holders on the effectiveness of IPR regimes in countries outside the EU. It will also enable right holders – in particular small and medium-sized firms – to improve their business strategies and operations to protect their corporate value in intangibles based on intellectual property they own. In particular, they will be able to better manage risk around their IPR when doing business in or with certain third countries.

Click here to see the full report.
Source: European Commission

Visit of SIPO's Deputy Commissioner to OHIM

On 2 July, OHIM received a visit from Deputy Commissioner Head of the Chinese State Intellectual Property Office (SIPO).

SIPO is the Chinese office in charge of, among other responsibilities, registering designs in China.

Vice President Archambeau briefed Deputy Commissioner He on a number of issues of mutual interest, including the possibility of performing a Chinese IP Study on the economic contribution of designs and the new ID5 forum, a forum exclusively dedicated to designs with China (SIPO), Japan, South Korea, USA and OHIM.

The revised status of the Chinese Patent Law was discussed and OHIM gave a presentation on design trends in RCD applications.

Also discussed were the current bilateral activities, such as training on RCD offered to SIPO staff; and new cooperation areas for the future, including new roving seminars, sharing knowledge on quality management and project management.

Another topic was the IP Key project status and the progress of Chinese design data integration into Designview. Complete integration and go-live of the tool is expected in mid-September 2015.

10 Year Anniversary of the EU-China IP Dialogue Mechanism

OHIM, acting as the implementing agency of IP Key, organised a high-level event in Brussels on the 29th of June to celebrate the 10th anniversary of the EU-China IP Dialogue Mechanism run by the Ministry of Commerce of the People's Republic of

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China, (MOFCOM), and DG Trade of the European Commission.

Commissioner Malmström opened the flagship event by announcing the signing of a new Memorandum of Understanding that reinforced cooperation on IP.

OHIM was represented by Vice-President Archambeau who together with speakers from SAIC, the EPO and SIPO, as well as representatives from EU and Chinese industry, highlighted the importance of EU-China relations on IP matters. For a full list of speakers click here.

Please visit the 10 year anniversary website for updates and multimedia
More information on the Timeline of the 10 year anniversary of the EU-China IP Dialogue Mechanism (2005-2015)

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

Case T-404/10 RENV; Gambling Commission (formerly National Lottery Commission) v OHIM; Judgment of 30 June 2015; Language of the case: EN.

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Copyright, Burden of proof, Right to be heard, Figurative trade mark, Competence of the Boards

FACTS: On 2 October 2007, the CTM proprietor obtained the registration of the CTM figurative mark represented below. On 20 November 2007, two applicants filed a joint invalidity request on the basis of Article 52 (2) (c) CTMR, invoking a prior copyright, under the Italian law, in the figurative sign reproduced below. The invalidity applicants relied on an agreement dated 16 September 1986 (the date resulting from a post office stamp affixed to it) under which a third party purporting to be the author of the allegedly earlier copyright claimed that he had assigned to one of them his rights to reproduce and use the work in question. The CTM proprietor argued that the mentioned agreement presented certain anomalies that she doubts as to the reliability of the date resulting from the post office stamp affixed to the document and, therefore, on whether

CTMA

Earlier Copyright

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SUBSTANCE: THE DECISION OF THE CANCELLATION DIVISION (CD): the CD granted that application for a declaration of invalidity on the ground, in essence, that the applicants for a declaration of invalidity had demonstrated the existence of an earlier copyright protected by Italian legislation and which was virtually identical to the contested trade mark. THE DECISION OF THE BOARD OF APPEAL (BoA): the BoA dismissed the CTM proprietor's appeal, holding that the anomalies invoked by the CTM proprietor did not give grounds for doubting the veracity of the content of the 1986 agreement. In that context, the BoA considered, in essence, that it was not competent to assess the validity of the 1986 agreement and that this could only be challenged by bringing a separate judicial proceedings for declaration of forgery. The CTM proprietor filed an action before the General Court (GC). The judgment of the GC: the GC granted the appeal, holding on the one hand that the BoA had infringed Article 53 (2) (c) CTMR in so far as it had found that the existence of an earlier copyright had been proved by the invalidity applicants and, on the other, finding that the BoA had incorrectly assessed its powers to determine whether that agreement was authentic. In particular, the GC referred to an Article of the Italian Civil Code and a judgment of the Italian Supreme Court of Cassation interpreting that Article - both of which had not been invoked and relied upon by the parties before the Office - and held that, in accordance with that judgment, it was open for the CTM proprietor, without it being necessary to bring separate proceedings for a declaration of forgery, to adduce proof that, in fact, the 1986 agreement had been drawn up on a date other than that shown on the post office stamp. The GC therefore inferred from this that the BoA had misinterpreted the national law applicable pursuant to Article 53 (2) CTMR and therefore had failed to assess accurately the precise scope of its own powers. Had the BoA considered itself competent to assess the validity of the 1986 agreement, it might have come to a different conclusion. THE APPEAL LODGED BY THE OFFICE: the Office filed an appeal to the European Court of Justice (CJ), raising three pleas in law and alleging (i) infringement of Article 76 (1) CTMR and of Rule 37 CTMIR; (ii) infringement of the right to be heard, insofar as the Office's right to be heard regarding the judgment of 14 June 2007 was not observed; and (iii) manifest inconsistency and distortion of the facts which affect the reasoning followed and the conclusion reached by the GC. The Office argued that it read the judgment of the CJ in Case C-263/09 P Edwin v OHIM as confirming that it is for the party relying on national law to provide the Office not only with particulars showing that he satisfies the necessary conditions, in accordance with the national law of which he is seeking application, in order to be able to have the use of a CTM prohibited by virtue of an earlier right, but also particulars establishing the content of that law. THE JUDGMENT OF THE CJ: the CJ held that it is not apparent from the judgment in Edwin v OHIM that a rule of national law, made applicable by a reference such as that in Article 52 (2) CTMR,

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should be treated as a purely factual matter, the existence of which the Office and the GC merely establish on the basis of the evidence before them (Para. 37). The review by the Office and by the GC must be conducted in the light of the requirement of ensuring the practical effect of the CTMR, which is to protect registered CTMs (Para. 40). The scope of the Office's decision is called to take in an invalidity scenario necessarily implies that the Office's role cannot be of mere validation of the national law as submitted by the invalidity applicant (Para. 43). The GC must be able to confirm, beyond the documents submitted, the content, the conditions of application and the scope of the rules of law relied upon by the applicant for a declaration of invalidity (Para. 44). The GC did not err by holding that the Office must - of its own motion and by whatever means considered appropriate - obtain information about the national law of the Member State concerned, where such information is necessary for the purposes of assessing the applicability of a ground for invalidity relied on before it and, in particular, for the purposes of assessing the accuracy of the facts adduced or the probative value of the documents submitted (Para. 45). Since the parties before the GC were not given the opportunity to submit their observations on the above mentioned judgment of the Italian Supreme Court of Cassation (ISCC), the GC infringed the Office's right to be heard (Paras. 57-60). The CJ therefore set aside the judgment of the GC and referred the case back to the lower instance for a ruling on the merits of the action.

NEW JUDGMENT OF THE GC: the GC issued a new judgment, again rejecting the Office's arguments and noting that the above mentioned judgment of the ISCC necessarily implies greater freedom on the BoA's part in the assessment of the evidence. Thus, the GC annulled the decision of the BoA, holding that it could not be excluded that the BoA would have reached a different conclusion had it considered itself fully competent to assess the validity of the 1986 agreement, which had been filed to prove the existence of the alleged earlier copyright.

Case T-660/11; Polytetra GmbH v OHIM; Judgment of 16 June 2015; Language of the case: EN

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Likelihood of confusion, Proof of use, Catalogue, Reputation, Lack of reasoning, Function of trade mark, Evidence of use

FACTS: The applicant sought to register the word mark POLYTETRAFLON in respect of a range of goods and services in Classes 1, 11, 17 and 40. An opposition based on the earlier CTM TEFLON, registered for goods and services in Classes 1, 11, 17 and 40, was filed on the grounds of Articles 8 (1) (b), 8 (2) (c) and 8 (5) CTMR. The Opposition Division (OD) dismissed the opposition. The Board of Appeal (BoA) upheld the appeal under Article 8 (1) (b) CTMR, annulled the OD's decision and rejected the

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trade mark application in respect of all the goods and services in question. It held that the opponent had proved use of the earlier mark TEFLON for the goods in Classes 1, 11 and 17, particularly in light of the fact that the non-stick material marketed by the opponent under that mark had been used by numerous undertakings in the European Union (EU) in the manufacture of a wide range of final products and that that mark had been prominently displayed in brochures and advertisements for those products. In particular, the BoA found that genuine use of the earlier mark TEFLON had been proved for "chemicals used in industry and science, unprocessed artificial resins, unprocessed plastics; adhesives used in industry" in Class 1, "apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes" in Class 11 and "plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal" in Class 17, on which the opposition was based. In order to justify its finding, the BoA stated that the coatings produced by the opponent were used, under licences, in a number of final products of third parties, these coatings being integral to the makeup and structure of the final goods and that that mark had been displayed in a prominent position in the brochures and advertisements for those goods. By contrast, according to the BoA, use of the earlier mark had not been proved as regards the services "treatment of materials" in Class 40. The BoA moreover found that the earlier mark TEFLON enjoyed an exceptional, worldwide reputation, including in the EU, not only in respect of non-stick materials in Class 1, but also in respect of the above listed (final) goods in Classes 11 and 17 for which it was registered. The BoA held that the goods covered by the mark applied for were in part identical and in part highly similar to the goods covered by the earlier mark for which genuine use had been proved and that, in contrast to what the OD had found, the signs at issue were similar. Consequently, according to the BoA, there was a likelihood of confusion within the meaning of Article 8 (1) (b) CTMR.

CTMA

POLYTETRAFLON

Earlier marks

TEFLON

SUBSTANCE: The General Court (GC) upheld the appeal and annulled the BoA's decision. ON THE DUTY TO STATE REASONS (Article 75 CTMR) - the GC found that the BoA's decision was vitiated by inadequate reasoning since it does not enable the GC to understand the extent to which the pieces of evidence produced by the opponent and relied on by the BoA allegedly proved genuine use of the earlier mark for each of the goods among those for which

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that mark had been registered (Paras. 19-36). ON THE PROOF OF USE: the GC found that the fact that the earlier mark **TEFLON** was used in respect of third parties' final products incorporating the opponent's coating does not permit the conclusion that it has been used for the final products for which that mark was registered. Even in the event that third parties' final products incorporate the opponent's non-stick materials or if their coating is manufactured from those materials, they, both by their nature and by their intended purpose, are essentially different from non-stick materials and do not belong to the same group (Paras. 68-69). Thus, the **TEFLON** mark used by third parties in respect of their final products does not perform the essential function of guaranteeing the origin of those final goods (Para. 81). The presence of the earlier mark, identifying a component of the product, in advertisements, brochures or even on the product itself is a commercial strategy of the manufacturer of the final product indicating certain functional characteristics of that product due to the presence of a component identified by the **TEFLON** mark. Use of the **TEFLON** mark in respect of third parties' final products may thus result in that mark performing an advertising or communication function aimed at informing or persuading the consumer. Nevertheless, it does not thereby perform the essential function of guaranteeing the origin of the final product, the only relevant factor for the assessment of genuine use of a mark within the meaning of Article 42 (2) and (3) CTMR (Paras. 85-86). The GC therefore concluded that the BoA's decision was vitiated by an error of law in that the BoA wrongly found that the opponent had proved use of the earlier mark for final products on account of the fact that the coating produced by the opponent was integral to the makeup and structure of third parties' final products and that the earlier mark had been displayed in brochures and advertisements for those goods (Para. 91).

Case T-166/12; Juan Bolívar Cerezo v OHIM, Order of 14 January 2015, Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Admissibility, Likelihood of Confusion, Priority, Substantiation of earlier right, Identity of the goods and services, Similarity of signs

FACTS: The applicant sought to register a Community trade mark represented for the goods and services within Classes 11, 25, 35, 36, 37 and 41. The mark applied for was the word mark Renovalia. The opponent, Renovalia Energy, S.A. filed an opposition based on Article 8 (1) (a) and (b) CTMR. The Opposition Division (OD) found partial likelihood of confusion for Class 36. The applicant filed an appeal before the Board of Appeal (BoA) claiming to the owner of the Spanish earlier trade mark Renovalia. The BoA dismissed the appeal finding that the applicant could not claim the right of priority of its Spanish trade mark according to Article

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29 CTMR. It also found that the signs were similar which lead to the finding of likelihood of confusion in the sense of Article 8 (1) (b). The applicant filed an action before the General Court (GC) relying on two pleas in law.

CTMA
Renovalia
Earlier marks
Renovalia RenovaEnergy Renova Energy

SUBSTANCE: The applicant's request to declare the mark applied for to be registered was found manifestly inadmissible as it exceeds the powers of the GC, according to Article 65 (6) CTMR (Paras. 16-17). The applicant claimed an infringement of Article 8 (1) (b) CTMR, in the sense that the mark applied for in Class 36 had priority over the earlier marks (Para. 18). In addition, the applicant claimed that there was a likelihood of confusion between his Spanish mark Renovalia and the marks RenovaEnergy and Renova Energy, since the services are identical and the signs are similar (Para. 19). The applicant informed the GC of its intention to request the invalidity of the marks used as a basis of the Opposition (Para. 20). The GC dismissed these arguments and pointed out that the OD took into account in its decision the earlier Spanish marks (Para. 21). In this light, it was found that the BoA decided correctly in the sense that the arguments put forward by the applicant were unsubstantiated. In this regard, the invalidity claim of the contested marks was based on the applicant´s alleged right of priority of his Spanish mark. However, it was found that there was no application before the competent national Courts seeking the annulment of the referred marks (Para. 22). Also, the GC found that there was no error in law in the contested decision with regard to the claimed priority of the applicant´s earlier mark. Furthermore, the applicant never claimed a priority right in the application for registry of the mark in compliance with Article 30 CTMR (Para. 22). It was pointed out that more than six months passed between the filing date of the application for the earlier Spanish mark and the application for a CTM (Para. 23). The GC found that although the applicant filled an action for the annulment of the earlier marks before the competent National court, it was filed after the contested decision. No evidence was provided regarding the finding of invalidity of earlier marks (Para. 24). Moreover, the applicant did not refute the findings of the BoA with regard to likelihood of confusion (Para. 26). In this light, the GC dismissed the appeal, as it was found manifestly inadmissible and partly lacking foundation in law (Paras. 25-27).

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Case T-423/12; Skype Ultd. v. OHIM; Judgment of 5 May 2015; Language of the case: EN

KEYWORDS: Likelihood of confusion, Similarity of the signs, Visual similarity, Phonetic similarity, Conceptual similarity, Identity of the goods and services, Enhanced distinctiveness, Coexistence of trademarks, Dilution of distinctiveness, Weak element, Distinctive element, Relevant territory, Figurative trade mark, Specialised public, Figurative element, Descriptive element

RESULT: Action dismissed

FACTS: An application was filed for the figurative mark shown below for a range of goods and services in Classes 9, 38 and 42. An opposition was filed pursuant to Articles 8 (1) (b), 8 (4) and 8 (5) CTMR based on, inter alia, the earlier CTM SKY for a range of goods and services in Classes 9, 38, 41 and 42. The Opposition Division upheld the opposition in respect of all the goods and services in question, on the basis of Article 8 (1) (b) CTMR.

The Board of Appeal (BoA) dismissed the appeal.

CTMA

Earlier marks

SUBSTANCE: The General Court (GC) dismissed the appeal. It found that the relevant public consists of the public at large and professionals (Para. 22). The average consumer of the contested peer-to-peer communication services, although choosing those services with care, will have an average degree of attention (Paras. 23-24). The services are identical (Paras. 26-27). The impact of the figurative element of the mark applied for is minimal, in that it merely highlights the word element, specifically on account of the fact that it appears as a border that closely traces the contours of the word "skype" (Para. 30). The signs are visually and phonetically similar to a medium degree and they are also similar on a conceptual level, since the possibility cannot be ruled out that the relevant public will recognise the term "sky" in the mark applied for (Paras. 39-45). The earlier mark SKY has an enhanced distinctiveness in the United Kingdom for "apparatus for recording, transmission or reproduction of sound and images" in Class 9, "telecommunications' in Class 38 and "entertainment" in Class 41 (Paras. 50-51). The alleged "secondary meaning" of the contested mark skype (i.e. a link that would be established by consumers between that sign and the namesake applicant's provision of the services) does not translate into a conceptual content that could offset the existing similarities. On the other hand, in the event that the term "SKYPE" had actually acquired a meaning of its own for identifying the services covered by the mark applied for, it would be a generic term, and therefore a descriptive one, for that type

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of service (Para. 55). The GC recalled the established Case-Law to the effect that the (possible) recognition of the mark applied for cannot be taken into account when determining whether there is a likelihood of confusion between two marks (Para. 56). With regard to the alleged "dilution" of the earlier SKY mark, the GC noted that the applicant limited itself to general and unsubstantiated allegations and that it referred merely in an abstract way to the 'evidence' it provided. The GC stressed that it is not for the GC to research and identify which documents within the case file could serve as the basis of the applicant's arguments (Para. 60). Even if it were accepted that the earlier mark SKY is inherently weakly distinctive for television broadcasting services and for goods in Class 9 directly related to those services, this limited distinctiveness would be overridden by its acquired enhanced distinctiveness for those same goods and products, on account of its recognition by the relevant public (Para. 61). The applicant's argument based on a supposed peaceful coexistence between the marks was rejected (Paras. 66-69). The GC confirmed the existence of a likelihood of confusion for the relevant public in the United Kingdom, even taking into account a higher level of attention on the part of the relevant public (Paras. 71-72).

Case T-172/13; Novomatic AG, v OHIM; Judgment of 22 January 2015; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Declaration, Distinctive element, Descriptive element, Evidence of use, Extent of Use, Lack of reasoning, Likelihood of confusion, No bearing on decision, Proof of use, Purpose of the goods and services, Similarity of the goods and services, Similarity of signs, Catalogue, Evidence of use, Sales figures, Visual similarity, Phonetic similarity

FACTS: The CTM applicant (= applicant before the GC) sought to register the word mark AFRICAN SIMBA for goods and services in Classes 9, 28 and 41. The opponent based its opposition inter alia on Article 8 (1) (b) CTMR using inter alia the earlier German figurative mark as depicted below, registered for goods in Class 28. The opposition was directed against all the goods and services covered by the CTMA. The Opposition Division upheld the opposition partially for the contested goods in Classes 9 and 28. The Board of Appeal (BoA) dismissed the applicant's appeal, finding that there was likelihood of confusion (for the goods in Classes 9 and 28), taking into account, the identity of the goods and the similarity of the signs. The applicant appealed to the General Court (GC), arguing an infringement of Article 42 (2) and (3), Article 75 and Article 8 (1) (b) CTMR.

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CTMA

AFRICAN SIMBA

Earlier mark

SUBSTANCE: INFRINGEMENT OF ARTICLE 42 (2) AND (3) CTMR. The GC confirmed the BoA assessment on proof of use (PoU). An affidavit confirming that the earlier mark has been used during the relevant period, is not prima facie without any probative value, even if it comes from the sphere of the interested party. In case that it is corroborated by objective evidence, it may have a certain probative value. (Paras. 30 and 31). In the case at hand, the affidavit is confirmed by a catalogue and several invoices attesting use of the earlier mark in Germany (Para. 33). The catalogues and the invoices show use for several playthings and they show also the earlier mark. They cover also a period of 3 years encompassed within the relevant period and they show within these 3 years a constant and continuous use (Para. 35). The GC stresses also the fact that the invoices which are numbered are only a selection of the invoices within the said period. Consequently, they do not reflect the full turnovers and therefore they corroborate the content of the affidavit in terms of volume (Para. 40).

INFRINGEMENT OF ARTICLE 75 CTMR. Concerning the duty to state reasons, the GC confirms the constant Case-Law that the reason behind this procedural requirement lies in two main aspects. One is to explain to the parties the reasons for the decision and the measure taken in it and secondly to enable the control of the legality to the higher instances (Para. 45). However, it has to be distinguished between the lack of reasoning and the wrong reasoning. A wrong reasoning is not equivalent to the lack of any reasoning and does not lead automatically to the annulment of the contested decision (Para. 46). The GC notes that the contested decision stated in (Para. 30) that the application would consist of the depiction of the head of a lion and the stylised reproduction of the word elements. However, the BoA further concluded that the figurative elements would not have a great impact on the marks (Para. 54). The GC concluded that this procedural error has no impact on the understanding of the reasons set out in the contested decision. The conclusions drawn by the BoA are still applicable to the case at hand and enable to understand the outcome and to review its legality (Paras. 56 to 58).

INFRINGEMENT OF ARTICLE 8 (1) (b) CTMR. Concerning the comparison of the goods in Class 28 the contested decision stated that the goods covered by the application, namely "lottery game

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machines" are encompassed in the broad category of "games and plaything except plush toys" (German: "Spielwaren, ausgenommen weichgestopfte Spieltiere") covered by the earlier German mark. To this extent the GC states that the contested goods do not fall within the natural meaning of the earlier goods. Furthermore, the use of some of the headings does not comply with the criteria of IPT to consider that the earlier mark covers all the goods included in the alphabetical list. This applies even more, taking into account that the earlier goods contain an exclusion of plush toys. (Paras. 85 to 88). Consequently, the goods in class 28 are not identical (Para. 89). The GC proceeds with its examination to see if this error has an impact on the outcome of the contested decision (Para. 90). The GC concludes that the goods under comparison have the same purpose of entertaining, although the contested goods reach this aim in a different way because of the chance to win money. Secondly there is a certain "fluid transition" between the slot machines as toys and the real slot machines, so that a clear distinction between these goods cannot be made. Also the material out of which the goods can be made is the same. Consequently the goods are similar to a certain degree (Paras. 94 to 101). Similarly, also the contested goods in class 9 are similar to the earlier goods, although only in a low degree (Para. 112). Concerning the comparison of the signs the GC stresses that both the verbal element, "SIMBA" as well as the figurative element "the depiction of the elephant" are equally distinctive. However the word element is in the first position, stylised and constitutes a phantasy term will attract the consumer's attention (Paras. 130 and 131). The contested sign bears the term "African" which is not descriptive but still evokes an African origin of the latter term "SIMBA" which as phantasy term and will attract the consumer's attention more than the first word element (Paras. 137 to 142). The signs have therefore, as the BoA correctly stated, visual and aural similarities. Conceptually, the term "Simba" has in German no concept and the applicant has not shown that the relevant public will consider this term as the "lion" (meaning in Swahili (Para. 151). In the examination of the overall assessment the GC concludes that the target public for the case at hand is the general public which buys the earlier games and playthings and uses the contested slot machines. The attentiveness will therefore be average (Paras. 161 to 163). Since the word element has an independent role within the contested mark reinforcing the similarity between the marks there is likelihood of confusion taking all the relevant factors into account (Paras. 170 to 172). Consequently, the error in the comparison of the goods in the contested decision does not affect the outcome and does not lead to its annulment (Para. 173).

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Case T-377/13; ultra air GmbH v OHIM; Judgment of 9 March 2015; Language of the case: DE

RESULT: Action partly upheld (BoA decision partly annulled)

KEYWORDS: Abbreviation, Descriptive element, Distinctive element, Lack of reasoning, Laudatory mark, Principle of legality, Quality of the goods and services, Right to be heard, Specialised public

FACTS: The applicant registered the word mark Ultra.air ultrafilter as a CTM for goods and services within Classes 7, 9, 11, 37 and 42. An application for invalidity was filed based on the grounds of Article 7 (1) (b) and (c) CTMR. The Cancellation Division (CD) dismissed the invalidity application. The Board of Appeal (BoA) annulled the decision of the CD finding that the term "ultrafilter" is descriptive of all the goods and services covered by the contested mark. In addition, "ultra.air" is understood to mean a superior air, so that these terms are seen as praise for quality filtration products covered by the contested mark and for the other products covered by the same mark which may be part of an air filtration system. The services in Classes 37 and 42 set out in (Para. 2) above may also cover air production facilities. The juxtaposition of two descriptive elements composing the contested mark was descriptive of an equally high quality air achieved through an "ultrafilter" and the distinctiveness of the mark at issue also causes the lack of distinctive character. The applicant filed an action before the General Court (GC).

CTMA

Ultra.air ultrafilter

SUBSTANCE: The relevant public consists of English-speaking professionals from the filtration sector (Para. 17). The GC confirmed that the element "ultra.air" will be perceived by the relevant public as referring to air of an excellent quality. Followed by the word "ultrafilter", the terms used will be perceived as meaning "air of excellent quality achieved through an ultrafilter" (Para. 18). Even though the word "air" does not evoke a quality or condition as would do an adjective, the words "ultra" and "air" are together perceived as an abbreviated version of a phrase such as e.g. "ultra pure air" which understanding is not changed by inserting the dot in between the two words. Further, this understanding becomes more likely because the relevant public consists of professionals in the filtration sector. Moreover, the existence of "ultrafilter" demonstrates that the association between ultra and a noun is not excluded (Para. 19). In this context, it is irrelevant whether the BoA made an accurate translation of the definition of "ultra" to German, since the conclusions of understanding of this word by English public are not affected by the accuracy of the translation of the definition (Para. 21). It is thus

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clear that the mark described the quality as well as the destination of filters and its parts, filtration media, apparatus and installations for filtering liquids, gas and air and apparatus and installations for evacuating and processing condensate from the drying and filtering of gases and air (Para. 21). The BoA also did not err when referring to the compressors in general in relation to compressors for cooling installations and parts therefor (Para. 23). The contested decision, however, lacks reasoning in regards of the time control systems which are not mentioned at all. This conclusion cannot be altered by the general reference to the lack of distinctive character (Para. 24). With regards to the services covered, the GC recalled that the fact that a sign is descriptive only in relation to part of the goods or services covered by a broader category listed in the application does not prevent the sign from being refused the registration (Para. 25). In regards of the perception of the element "ultra.air" by the relevant public, it is clear from the contested decision, that the applicant was able to present his arguments in this regard. Thus, no violation of the right to be heard can be found merely because the BoA did not communicate to the applicant the definition of "ultra" in Oxford English Dictionary (Paras. 36-37). Based on the foregoing, the contested decision was partly annulled in respect of the time control systems (Para. 42).

Case T-604/13; Levi Strauss & Co. v. OHIM; Judgment of 3 June 2015; Language of the case: DE

RESULT: Action upheld (BoA decision annulled)

KEYWORDS: Similarity of signs, Identity of goods and services, Visual similarity, Phonetic similarity, Likelihood of confusion, Enhanced distinctiveness, Reputation, Numerical mark

FACTS: The applicant sought to register the word mark 101, displayed underneath, inter alia, for goods in Class 25 "clothing, footwear, headgear". The opponent filed an opposition based on the earlier Community word mark 501 (CTM) as displayed underneath, registered, inter alia, for identical goods in Class 25. The opposition was based on the grounds of Article 8 (1) (b) CTMR and Article 8 (5) CTMR and directed only against the goods in Class 25. The Opposition Division rejected the opposition in its entirety. Despite finding the marks visually and aurally similar in as far as they coincide in the numerals "01", a likelihood of confusion or encroachment was ruled out, even assuming an enhanced distinctiveness/reputation of the earlier mark.
The Board of Appeal (BoA) dismissed the appeal, but with a different reasoning. It found, that the signs are dissimilar overall. Visually, the coincidences in the two numerals "01" are counteracted by the differing first numeral and the "symmetric" impression of

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the CTMA, which does not have any counterpart in the "asymmetric" earlier mark. The differing first numeral also leads to a different aural impression. As numbers as such do not have a concept, the marks are not conceptually similar. Even if numbers were assumed to have a concept, the concept of 501 and 101 would be different. As the signs are dissimilar overall, it is immaterial whether the earlier mark possesses enhanced distinctiveness/reputation. If the signs are dissimilar overall, Article 8 (1) (b) CTMR or Article 8 (5) cannot succeed, regardless of identical goods and/or enhanced distinctiveness/ repute of the earlier mark.

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

CTMA
101
Earlier mark
501

SUBSTANCE: The GC pointed out at the outset, that the relevant public consists of reasonably informed and circumspect average end consumers and that it is also undisputed that the goods at issue are identical.

With regard to the visual comparison, the GC stressed that, with regard to two signs consisting of three numerals each, dissimilarity in one numeral cannot lead to a different overall impression without further, special circumstances. The mere difference in the first numeral cannot be seen as such a special circumstance, which would - without further analysis of the specifics of the differing number - lead to a different overall impression. The contested decision contains nothing that would allow the conclusion that the difference in the first numeral would clearly be perceived as a different structure ("symmetric" v. "asymmetric") and as such lead to a different visual overall impression. The BoA committed an error in considering the signs visually dissimilar overall. Rather, the signs have a certain degree of similarity (Paras. 35-40).

The BoA was right to hold that in the clothing sector the aural comparison is usually of secondary importance compared to the visual comparison, as the goods are bought upon visual inspection. However, in the present case, the identical elements "01" form the longer part of the signs compared to the differing first element "1"/"5". In the French language, the pronunciation of the younger mark is even fully contained in the earlier mark. The BoA has not sufficiently demonstrated that the overall aural impression caused by the different initial numerals would be altered in such a way that the signs could be deemed aurally dissimilar. As a matter of fact, the marks have indeed a low degree of aural similarity

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(Paras. 41-44).
Conceptually, the BoA was right to conclude that a comparison between the signs is not possible as numbers as such do not have a concept (Paras. 45-47).
Overall, the signs at issue are not dissimilar but have a certain degree of similarity. As the BoA´s finding of no likelihood of confusion was based on the wrong assumption of dissimilarity between the signs, the contested decision is to be annulled already for this reason without the need to examine a violation of Article 8 (5) CTMR (Paras. 50-51).

Case T-448/13; 3 June 2015, Bora Creations, SL, v. OHIM, Language of the Case – EN

RESULT: Action dismissed

KEYWORDS: Descriptive element, Quality of the goods and services, Scope of proceedings, Nature of goods and services, Restriction of goods and services

FACTS: The word mark ESSENCE was granted registration for a range of goods in Class 3. An application for invalidity was rejected by the Cancellation Division. The Board of Appeal (BoA) partially upheld the appeal and annulled the Cancellation decision by declaring invalid the CTM registration for "hair colorants and hair tinters, soaps, perfumery, essential oils, cosmetics, hair lotions, preparations for cleaning, care and beautification of the skin, scalp and hair, decorative cosmetics, nail varnishes, nail varnish removers and nail care products" in Class 3. The CTMR's owner filed and appeal to the General Court (GC) against the BoA's decision as a whole. At the hearing, however, the owner limited the scope of its appeal to "decorative cosmetics and nail varnishes". The GC dismissed the appeal.

CTMA

ESSENCE

SUBSTANCE: The GC confirmed the finding that the relevant public has an average level of attention. According to the dictionary definitions given by the BoA (in English and French), the word ESSENCE refers to plant extracts which can be used as a scent or perfume and could also refer to a concentrate of such an extract. Thus, in its view, an "essence" could be a more concentrated version of the main product (like a face cream), or a product consisting of a scent (like an eau de toilette), or could also be used in conjunction with a product which is scented and chosen on the basis of its scent, even though it may primarily serve other needs (like a soap). Furthermore, the word "essence" is not an unusual or rarely used word and conveys a clear and unequivocal message concerning an attribute of the products in question (Para. 26).

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The GC confirmed the Case-Law according to which a sign may be refused registration on the basis of Article 7 (1) (c) CTMR only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics. In the present case the goods concerned are cosmetic products and as such can contain or consist of extracts, in particular plant extracts, perhaps in the form of a concentrate or a perfume. Consequently, the BoA was entitled to hold that one of the possible meanings of the mark at issue would be a product manufactured on the basis of an essence or containing an essence, and that the connection between this meaning and the goods concerned is sufficiently direct and real to allow the relevant public to recognise directly, and without the need for further thought, the description of such a quality of the goods concerned, indeed of their nature (Paras. 31 and 32). More particularly, the BoA considered that for decorative cosmetics the word "essence" [was] descriptive not because those goods are necessarily scented but in the sense of it being a concentrate and that upon seeing these goods bearing the word "essence", the public will perceive that they consist of a concentrated version of a cosmetic preparation or active ingredient (which usually also exists in an ordinary, non-concentrated form). As to "nail varnishes" the BoA determined that they could also be produced from an extract that has fundamental properties of a substance in concentrated form and that therefore the word "essence" merely indicated the nature and content (an essential characteristic) of the product at issue (Para. 35). Contrary to what the applicant stated, the mark at issue could be descriptive of decorative cosmetics also in the sense that those products can be perfumed. Further, it is to be noted that those goods represent a very broad category of products and not only those mentioned by the applicant during the hearing. In any event, "decorative cosmetics and nail varnishes", as cosmetic goods, can contain or consist of extracts, in particular plant extracts, possibly in concentrated form, or be perfumed. This characteristic constituting a significant property, indeed quality, of the goods concerned, it creates a direct real link between the mark at issue and the goods concerned (Paras. 39, 40). Therefore, the BoA did not err in finding that the mark at issue was descriptive of "decorative cosmetics and nail varnishes" for the purpose of Article 7 (1) (c) CTMR. As is evident from Article 7 (1) CTMR, it is sufficient that one of the absolute grounds for refusal applies in order for the sign at issue not to be registrable as a Community trade mark, there is no need to adjudicate on the second plea, alleging infringement of Article 7 (1) (b) CTMR.

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Case T-55/13; Formula One Licensing BV v. OHIM + Idea Marketing SA; Judgment of 21 May 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Abbreviation, Acronym, Common element, Distinctive element, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Visual similarity, Conceptual dissimilarity, Dissimilarity of signs, Reputation, Enhanced distinctiveness, Figurative trade mark

FACTS: The applicant sought to register the word mark F1H2O as a CTM for goods and services within Classes 9, 25, 38 and 41. An opposition based on the earlier registrations (at national, international and Community level) concerning the word mark F1 "the earlier word mark" and the figurative marks represented below "the earlier figurative mark", registered for goods in the same classes, was filed on the grounds of Articles 8 (1) (b) and 8 (5) CTMR. The Opposition Division rejected the opposition. The Board of Appeal (BoA) dismissed the CTM applicant's appeal. The applicant filed an action before the General Court (GC), alleging two main pleas in law: the infringement of Article 8 (1) (b) CTMR and the infringement of Article 8 (5) CTMR.

CTMA

F1H2O

Earlier marks

F1

SUBSTANCE: The GC confirmed the decision of the BoA. In first place, it rejected the first plea in law as unfounded. The GC stated that the BoA had correctly defined the relevant public (Paras. 31 and 32) and noted that the BoA's finding as to the identity of the goods and services was not disputed by the parties (Para. 33). As to the comparison of the word signs, the GC confirmed the BoA's finding. On the visual comparison, the relevant public would not split the mark applied for into two distinct elements: the length of the mark applied for and the equal

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position which the elements "F1" and "H2O" occupy in that mark imply a weak visual similarity between the marks at issue (Paras. 35-39). On the phonetic comparison, the GC confirmed that there was a weak similarity: the fact that the beginning of the mark applied for is pronounced in the same way as the earlier word marks is not sufficient to offset the difference in length and the composition of the marks at issue (Para. 40). On the conceptual comparison, the GC endorsed the BoA's finding that the signs were conceptually different. The mark applied for has no clear meaning, but it will be perceived either as a sequence of letters and figures or as a chemical formula: the fact that the mark applied for contains the well-known chemical formula for water ('H2O') strengthens this conclusion. Moreover, contrary to the applicant's argument, this is not contradictory, since the fact that consumers recognise the chemical formula for water does not prevent them from perceiving the mark applied for as a chemical formula of which water forms part (Paras. 41-44). Moreover, the GC found that the BoA was correct in analysing the evidence and finding that the earlier word marks enjoyed neither a reputation, nor an enhanced distinctiveness, but had a weak level of distinctiveness: in the case at issue, F1 does not play a "predominant or even significant" role (Paras. 45-47). The GC therefore confirmed the BoA's findings that there was not likelihood of confusion (Paras. 48-51). As to the comparison with the earlier figurative signs, the GC found that there are no visual and conceptual similarities, but only a weak phonetic similarity and concluded that there was not likelihood of confusion (Paras. 52-57). The GC rejected even the second plea in law. First of all, it highlighted that the applicant has not proved the reputation of the earlier word mark relied on. Moreover, it stated that the relevant public would not establish a link between the earlier figurative marks and the mark applied for because of the several abovementioned differences.

Case T-562/14; Yo holdings Ltd v OHIM; Judgment of 4 June 2015; Language of the case: EN

RESULT: Action dismissed

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

FACTS: The applicant sought to register the mark represented below as a CTM for services within Class 43. An opposition based on the earlier mark below, registered in Germany for goods in Classes 29, 30, 32 was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division (OD) rejected the opposition. The Board of Appeal (BoA) annulled in part the OD's decision and refused the trade mark applied for for the following services: "restaurant services; bar services; café, cafeteria, canteen, snack bar and catering services; lounge and bar services; services for providing food and drink". The applicant filed an action before the General Court (GC).

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CTMA
YOO
Earlier mark
YO

SUBSTANCE: The GC affirmed that there was a likelihood of confusion in the EU. It was not disputed by the parties that the relevant public was the general public whose level of attention is not higher as the average in the EU and Germany. The assessment of the BoA regarding the comparison of goods and services, the comparison of the signs and the existence of a likelihood of confusion was disputed. Regarding the comparison of the goods, the GC found, as the BoA did, that the goods of the earlier mark in Class 30 and 32 namely "pastries, chocolate products and non-alcoholic beverages" were complementary to the services in Class 43, as such goods are used an offered in the context of restaurant, catering, bar, café, cafeteria, canteen and snack bar services. Those goods are therefore closely related to those services. In the same way, it commonly happens that pastries are offered for sale in places which provide food and drink (Para. 25-27). The goods and services are therefore similar to a certain degree. Regarding the comparison of the signs the applicant considers that the BoA had overestimated the similarity of the signs at issue. The GC however confirmed the findings of the BoA that the signs were visually highly similar, phonetically very similar and that the conceptual comparison was irrelevant except for the Spanish and the English speaking public. As regards the likelihood of confusion, the GC has concluded that given the certain degree of similarity between the goods and services and high degree of similarity of the signs at a visual and phonetic level, a likelihood of confusion exists.

Case T-56/14; Evyap Tag Gliserin Sanayi ve Ticaret A.S. v OHIM, Judgement of 21 May 2015 Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Figurative trade mark, Figurative element, Letter mark, Likelihood of confusion, Similarity of the signs, Visual dissimilarity, Phonetic similarity, Ending of mark

FACTS: The applicant registered the figurative mark nuru represented below as a CTM for goods and services within Class 3. An opposition based on the earlier figurative mark DURU registered for goods in Class 3, was filed on the grounds of Article 8 (1) (b) CTMR.

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The Opposition Division dismissed the opposition in its entirety. The applicant filed an appeal to the Fourth Board of Appeal (BoA) which dismissed the request of the applicant for a limitation of the goods and dismissed the action. The BoA held that the marks at issue viewed as a whole were dissimilar. The applicant filed an action before the General Court (GC) relying on a single plea in law.

CTMA

nuru

Earlier mark

DURU

SUBSTANCE: In its single plea in law, the applicant raised two complaints, the first alleging that the BoA exceeded its discretion and the second alleging an error of assessment of the likelihood of confusion between the marks at issue (Para. 15). With regard to the first complaint, the applicant claims that the BoA exceeded its discretion by considering that the mark applied for was a figurative mark and not the mark nuru in stylised letters (Para 17). The GC rejected this argument stating that, where it determines the relevant public's perception of the mark applied for, the BoA is by no means bound by the explanations given by the parties. It further noted that it is for the BoA to make its own interpretation of the marks at issue (Para. 21). With regard to the second complaint, when assessing likelihood of confusion the applicant claimed that the BoA erred in finding that the mark applied for "[was] composed as a wiggly line divided into four stylised elements", which would not be perceived by the public as the sequence of letters "n-u-r-u" written in a stylised font. Instead, the applicant claims that it should have taken into account that the mark applied for would be perceived by the relevant public as a stylised version of the letters "n", "u", "r" and "u" (Para. 24). The GC found that in view of the goods concerned and for the mark applied for, the relevant public´s attention cannot be regarded as low, even when the goods are of mass consumption (Para. 32). With respect to the visual comparison of the signs, the GC found that the BoA correctly found that the mark applied for would be generally perceived as a whole as a mark composed of four figurative elements devoid of meaning as well as a figure forming a wiggly line and not as a sequence of letter forming a word (Para. 35). Moreover, the earlier marks are composed of a single word "duru", which is not divided into several elements (Para. 37). Furthermore, it was held that the marks at issue present similarities in the sense that the second and last figurative elements of the mark applied for resemble the letter "u" present

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in the earlier marks. However, those similarities cannot offset the overall visual differences in the conflicting marks (Para. 38). In this light, the GC found that the marks have a low degree of visual similarity even in a situation where the relevant public would perceive the mark applied for as a sequence of letters (Para. 39). As regards the aural comparison of the marks, the GC found that for the part of the relevant public that will seek to interpret the mark applied for, there will be some similarity with the earlier mark (Para. 40). It was found that the signs have a low degree of aural similarity (Para. 41). With regard to the conceptual comparison, the GC found that there was no evidence filed that could call into question the BoA´s conclusion that the mark applied for is devoid of meaning for the relevant public which would perceive it as being composed of several figurative elements. Therefore, owing to the lack of meaning of the marks in conflict a conceptual comparison of the marks is not possible (Para. 42). In this light, the GC found that the BoA´s assessment of likelihood of confusion between the signs at issue should be examined (Para. 43). The GC pointed out that the goods at issue are sold over the counter in supermarkets and customers can choose themselves which leads to the choice of the products at stake being made visually. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion. The GC concluded that the BoA was right in finding that there was no likelihood of confusion, even if the goods at issue were identical (Para. 47).

Case T-337/14; Rezon OOD v OHIM; Judgment of 22 April 2015; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Request for proof of use, Likelihood of confusion, Lack of reasoning, Admissibility

FACTS: The Cancellation applicant filed an invalidity action against the Community trade mark mobile. de proMotor, applied for on 8 February 2006 (and registered in 2008) for services in Classes 35, 38, 41 and 42. The invalidity request [Article 53 (1) (a) / Article 8 (1) (b) CTMR] was based on the earlier Bulgarian trade mark as displayed underneath, registered on 20 April 2005 for services in Classes 35, 39 and 42. The owner of the earlier Bulgarian mark was requested to provide proof of use (PoU). The Cancellation Division (CD) dismissed the invalidity action due to a lack of PoU of the earlier mark. The Board of Appeal (BoA) dismissed the appeal without going into the substance of PoU, but rather (solely) based on Article 165 (4) (b) / Article 165 (1) CTMR: According to these provisions a CTM, which was applied for before the date of the accession of a "New Member State", cannot be declared invalid pursuant to Article 53 (1) CTMR, if the earlier national right was applied for in the New Member State prior to the date of accession [Accession date Bulgaria: 1 January 2007]. As both the contested CTM and the earlier Bulgarian mark had been applied for / registered before the accession date of Bulgaria, the

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CTM could not be declared invalid.

The cancellation applicant filed an application to the General Court (GC). It claimed 1) several errors of law of the CD decision with regard to the assessment of PoU and likelihood of confusion (LOC); 2) a lack of reasoning of the BoA decision concerning the applicability of Article 165 (4) (b) CTMR; 3) a wrong application of Article 165 (4) (b) CTMR; 4) a violation of Article 53 (1) (a) / 8 (1) (b) CTMR, as the BoA did neither examine PoU nor LOC.

CTMA

mobile.de proMotor

Earlier mark

mobile

SUBSTANCE: The GC dismissed the application in its entirety.

1) With regard to the alleged errors of the decision of the CD the GC pointed out the inadmissibility of the claim. According to Article 65 (1) CTMR, only decisions of the BoA are subject to an appeal before the GC. (Para. 23).

2) Concerning the alleged lack of reasoning with regard to the applicability of Article 165 CTMR, the GC confirmed that the BoA had explained in sufficient detail the content of the provision and why it was applicable in the present case (both marks applied for / registered before the accession of Bulgaria to the EU) (Paras. 24-27).

3) The applicant claims that the - undisputed - knowledge of the CTM owner of the existence of the earlier Bulgarian mark should have been taken into account and that this positive knowledge prevents an application of Article 165 (4) CTMR. The GC stressed in this respect that the wording of Article 165 (4) CTMR is very clear to the contrary and that a "lack of knowledge" of the earlier mark cannot be construed as an additional necessary condition for the applicability of this provision. In other words, it is irrelevant in the context of Article 165 (4) CTMR, whether the CTM owner at the time of the CTM application knew about the existence of the earlier national mark or not. This does not lead to an undue protection of the CTM vis-a vis earlier national marks as Article 165 (5) CTMR in conjunction with Article 110 / 111 CTMR provides for the possibility for the owner of the earlier national mark to prohibit the use of a later CTM, if the earlier national mark was applied for, registered or acquired in good faith in the New Member State prior to the date of accession of that State. Therefore, Article 165 CTMR provides a fair balance between the interests of the CTM owner and the interests of the owner of the earlier national mark (Paras. 28-34).

4) The claimed violation of Article 53 CTMR / 8 (1) (b) CTMR is based on the wrong premise that the appeal before the BoA was rejected according to these provisions. However, the BoA did not reject the appeal on account of these provisions, but rather on account of Article 165 (4) (b) CTMR.

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Please note that the full number including slash has to be entered in our database under 'Appeal Nº', without the letter 'R'. e .g. Case R 219/2004-1 has to be entered under 'Appeal Nº' as: 0219/2004-1

Decision of the First Board of Appeal of 11 June 2015 in case R1840/2011-1 (EN)

Procedural issue – Rule 22 CTMIR – Evidence of use – Structuring and indexing of documents

The word mark 'GALILEO' was registered for goods and services in Classes 9, 16, 35, 38, 39, 41 and 42.

The cancellation applicant filed a revocation request against the CTM in accordance with Article 50(1)(a) CTMR on the ground that it had not been put to genuine use for an uninterrupted five-year period for most of the registered goods and services.

The Cancellation Division notified the CTM proprietor of the application for revocation and invited it to prove use of the mark. In several batches the CTM proprietor submitted 96 exhibits, totalling nearly 9 500 pages of documents (in both printed and digitalised formats). The documents were neither indexed nor accompanied by explanations as to their content and relevance.

By decision of 11 July 2011, the Cancellation Division revoked the CTM for certain goods in Classes 9, 16 and 39.

The cancellation applicant appealed the decision stating that the CTM should have been revoked for all the contested goods and services.

The Board found that the documentation proving use of a mark should not be submitted in bulk but in a manner that made it possible (for the other party, the Office and, possibly, the General Court) to link it with the indications (place, time, extent and nature) required by Rule 22 CTMIR. In addition, when the goods and services were numerous, linking the evidence with these indications had to be made in respect of each individual good and service (or homogeneous groups thereof). Otherwise, the proof of use would have to be dismissed as lacking compliance with Rule 22 CTMIR.

The Board annulled the contested decision and revoked the CTM for all the contested goods and services.

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Decision of the Second Board of Appeal of 2 June 2015 in case R854/2014-2 (EN)

Substantial procedural violation – Article 80(1) CTMR – Colour mark, lack of representation in colour

The IR holder sought to register the figurative mark

by means of an international registration in Classes 18, 25 and 35.

The opponent filed a notice of opposition based on two earlier rights. The grounds of the opposition were those laid down in Article 8(1)(b) CTMR.

The Opposition Division rejected the opposition in its entirety.

The opponent filed a request for the revocation of the decision based on a procedural error made by the Opposition Division under Article 80(1) CTMR, which was rejected by the Office.

The Board found that the opponent based its opposition on earlier Irish trade mark registrations, being two series of figurative marks, some of which were in colour. Rule 15(2)(e) CTMIR provides as a condition for the admissibility of the opposition, that the notice of opposition shall contain a representation in colour of the colour mark. This requirement applies, inter alia, to earlier national or international trade mark applications or registrations invoked under Article 8(1)(a) or (b) CTMR. However, in cases where the opposition presents certain deficiencies, Rule 17(4) CTMIR provides the following: 'If the notice of opposition does not comply with the other provisions of Rule 15, the Office shall inform the opposing party accordingly and shall invite him to remedy the deficiencies noted within a period of two months. If the deficiencies are not remedied before the time limit expires, the Office shall reject the opposition as inadmissible.' Thus, if the proper representation were not to have been enclosed in the opposition notice, the opponent should have been notified of the deficiency and invited to remedy it within a two-month period. Only if the deficiency were not to have been remedied before the expiry of the time-limit established by the Office for this purpose, could the opposition be rejected as inadmissible. In the present case, the Office did not transmit to the opponent any notification concerning a deficiency with respect to the lack of representations in colour of the earlier Irish trade marks, and did not invite it to remedy this deficiency, in accordance with Rule 17(4) CTMIR. This error constituted a substantial procedural violation which led to the annulment of the contested decision rejecting the opposition based on the Irish trade mark registrations.

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

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Decision of the Second Board of Appeal of 21 May 2015 in case R877/2014-2 (EN)

Procedural issue – Article 8(1)(b) and 8(4) CTMR – Advance payment of appeal costs before taking appeal decision

The applicant sought to register the word mark 'luvo' for 'mobile phones; tablets; computers; portable communication devices' in Class 9.

The opponent filed a notice of opposition against the registration of the trade mark. The opposition was based on a CTM registration and non-registered UK trade marks. The opponent invoked Article 8(1)(b) CTMR with respect to its earlier CTM and Article 8(4) CTMR with respect to its earlier non-registered rights.

The Opposition Division accepted the opposition, rejected the contested trade mark for all the contested goods and ordered the applicant to bear the costs.

The applicant appealed the Opposition Division's decision.

Before the Board the opponent stated its concern that, since the applicant was located on the Isle of Man, if the appeal were dismissed, it would not be able to enforce any cost award. Therefore, the opponent requested that the Board exercise its discretion and require the applicant to make a payment in security of costs before making any decision. Apart from the fact that the applicant's observations on this issue were received outside the time-limit to submit observations, thus this request could not succeed; the European Union legislator did not give the Board the competence to require a party to advance a payment in security of costs.

The Board dismissed the appeal.

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Decision of the Second Board of Appeal of 21 May 2015 in case R1480/2014-2 (EN)

Opposition – Article 8(1)(b) and 8(4) CTMR – Comparison of goods in Class 9 and services in Class 38 with services in Classes 35 and 42 – functional complementarity

The applicant sought to register the word mark 'luvoworld' for goods and services in Classes 9 and 38.

The opponent filed a notice of opposition against the registration of the published trade mark. The opposition was based on a CTM registration and non-registered UK trade marks. The opponent invoked Article 8(1)(b) CTMR with respect to its earlier CTM and Article 8(4) CTMR with respect to its earlier non-registered rights.

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The Opposition Division accepted the opposition, rejected the contested trade mark for all the contested goods and ordered the applicant to bear the costs.

The applicant filed a notice of appeal against the Opposition Division's decision.

The Board found, as correctly pointed out by the applicant, that the Opposition Division compared the contested goods and services with Class 38 services which were not covered by the earlier CTM as registered. This was a substantial procedural violation. Insofar as the applicant argued that none of contested goods and services were held similar to the services in Classes 35 and 42 of the earlier mark, the Board noted that the Opposition Division had not assessed the contested goods and services with the earlier mark's Class 35 and 42 services. It only compared the contested goods and services with Class 38 services contained in the earlier mark when it was applied for. In any event, it follows from Article 64(1) CTMR that the effect of any appeal brought before it, is that the Board of Appeal is required to carry out a new, full examination of the merits of the opposition, in terms of both law and fact. As regards the issue of the similarity between the goods and services, an opposition based on the existence of a likelihood of confusion within the meaning of Article 8(1)(b) CTMR requires the Office to adjudicate on whether the goods and services covered by the marks in question are identical or similar. In the context of the Board's new and full examination of the merits of the case, the outcome of the appeal depends on whether a new decision with the same operative part as the decision under appeal may be lawfully adopted at the time of the ruling on the appeal. Accordingly, where a new decision with the same operative part as the decision under appeal may be adopted at the time of the ruling on the appeal, that appeal must, in principle, be dismissed even if the decision under appeal is unlawful on account of a procedural error. Since the applicant was located on the Isle of Man, the opponent stated that it was concerned that if the appeal were dismissed it would not be able to enforce any cost award. Therefore, it requested that the Board exercise its discretion and require the applicant to make a payment in security of costs before making any decision. This request could not succeed; the European Union legislator did not give the Board the competence to require a party to advance a payment in security of costs.

The Board dismissed the appeal.

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Decision of the Second Board of Appeal of 15 May 2015 in case R66/2015-2 (EN)

Article 7(1)(b) and (c) CTMR – Refiling of identical CTMA for identical goods – Inadmissibility of appeal

The applicant sought to register the figurative mark

(SUPER GLUE) for goods in Classes 1 and 16.

The examiner rejected the application because it was descriptive and non-distinctive pursuant to Article 7(1)(b), (c) and 7(2) CTMR.

The applicant filed a notice of appeal against the examiner's decision.

The Board found that the applicant, before filing the application at issue, had filed the same mark for the same goods for registration. By decision of 22 May 2013, the Fourth Board of Appeal considered, hereby confirming the Cancellation Division's decision of 19 December 2011 in this respect, that the Community trade mark in question was descriptive and devoid of distinctive character for the above goods for which the trade mark was declared invalid. On 7 May 2014, the applicant refiled the identical trade mark for identical goods in Classes 1 and 16, which was in turn rejected by the examiner and which now formed the subject-matter of these appeal proceedings.

The Board found that the appeal was inadmissible since it was filed against a merely confirmatory decision of the examiner. Refiling a CTM after a final decision from the Office that had refused the same trade mark or declared it invalid for the same goods or services was a mala fide practice where there were no new factors (e.g. acquired enhanced distinctiveness) that would justify such a refiling.

Consequently the Board dismissed the appeal as inadmissible.

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Decision of the Second Board of Appeal of 2 June 2015 in case R1919/2014-2 (EN)

Article 7(1)(b) CTMR – Simple, abstract figurative mark

The applicant sought to register the figurative mark

(DEVICE OF A SHARK'S TOOTH) for goods in Class 25.

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The examiner rejected the application on the basis of Article 7(1)(b) and (2) CTMR.

The applicant filed a notice of appeal against the examiner's decision.

The Board found that it could not be said that the mark applied for was a sign of extreme simplicity, much less that it would amount to a basic geometric figure, on account of its curved lines, several rounded edges and the sharp extension pointing downwards. It was recalled that the registration of a sign as a trade mark was not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. The trend was for figurative marks to be simple and stylised in their design. Consumers were, therefore, accustomed to perceiving relatively simple figurative marks, even abstract ones, as signs. The mark as a whole indicated that it was a trade mark and not an overly simple sign, or a banal depiction that would indicate the intended use of the goods applied for, nor could it be said that the mark applied for was customary for the goods for which it sought registration. The bar for what did not count as extremely simple or overly abstract was set too high in the contested decision. As the applicant claimed, the mark applied for had to be considered as being capable of distinguishing the goods in question from those of a different origin. Further, it was not a requirement for registrability that a purely figurative sign had to consist of a figure that would be immediately perceived as representing a clearly recognizable object. The mark applied for was allowed to be registered as a Community trade mark under Article 7(1)(b) CTMR for all the goods covered by the application.

The Board upheld the appeal and annulled the contested decision.

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Decision of the Second Board of Appeal of 8 May 2015 in case R2011/2014-2 (SV)

Article 7(1)(b) CTMR – lack of distinctiveness – threshold for banality

The applicant sought to register the figurative mark

(Device of a dog and a cat) for goods and services in Classes 3, 5, 10, 18, 31, 35, 41 and 44.

The application was refused in its entirety pursuant to Article 7(1)(b) CTMR.

The applicant filed a notice of appeal against the decision.

The Board found that the mark was not the ordinary

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and realistic representation of a dog and a cat. On the contrary, the overall impression of the trade mark applied for was of a stylised image of a dog and a cat in a specific composition that was not commonly found on the market. The positioning of the cat on the dog's back was not natural. The combination of the particular design of the cat and dog, their positioning and above all how the white contours and proportions of the two animals interacted and blended together in a balanced way to create a harmonious overall impression made the mark sufficiently stylised to function as an indication of origin. The trend nowadays was for figurative marks to be simple and stylised in their design. Consumers were, therefore, accustomed to perceiving relatively simple figurative marks as signs. The combination of the two trade mark components – the dog and the cat – and how these were integrated with each other, meant that the trade mark applied for was able to function as an indication of origin. The mark as a whole indicated that it was a trade mark and not a simple and banal depiction of the intended use of the goods or services. Trade mark protection for the specific design did not mean that others could not use a dog or cat in a different design; the need to retain availability did not need to be taken into account. The bar for what did not count as banal was set too high in the contested decision. The manner in which the figurative components were integrated with each other could by no means be regarded as banal.

The Board upheld the appeal and annulled the contested decision.

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Decision of the Second Board of Appeal of 10 June 2015 in case R1367/2014-2 (EN)

Article 7(1)(b) and (c) CTMR – Descriptiveness and lack of distinctive character

The applicant sought to register the word mark 'EL ESPIRITU DE CUBA' for goods and services in Classes 33, 35 and 43.

The examiner partially rejected the application for the goods in Class 33 ('alcoholic beverages, namely rum and rum-based alcoholic beverages'), on the basis of Article 7(1)(b), (c) and 7(2) CTMR.

The applicant filed a notice of appeal against the examiner's decision.

The Board found that in Spanish, the expression 'EL ESPIRITU DE CUBA' would be expected to be first understood as the subtlest vapour that was exhaled from rum and rum-based alcoholic beverages from Cuba. It described the nature, content and geographical origin of 'alcoholic beverages, namely rum and rum-based alcoholic beverages' in Class 33. Consequently, it was descriptive and lacked

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distinctiveness. Second, as held by the examiner and the applicant itself, 'EL ESPIRITU DE CUBA' could be understood as the essence of Cuba, 'espíritu' (spirit) referring in that case to the feeling, quality characterizing something (Cuba). The applicant itself claimed that the spirit of Cuba was characterized by 'Cuba island's historical culture and past glamorous "mood/state of mind" as well as past exciting day and nightlife of the mid-1930s/1950s'. The relevant public would not, without prior knowledge, perceive it other than in its promotional sense, namely that the rum and rum-based alcoholic beverages were typical of Cuba. Consequently, also for this reason, the mark applied for could not be expected to be perceived as an indication of origin.

The Board dismissed the appeal.

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Decision of the Second Board of Appeal of 12 June 2015 in case R1336/2014-2 (EN)

Article 7(3) CTMR – Distinctiveness acquired by use

The applicant sought to register the word mark 'THE DONKEY SANCTUARY' for goods and services in Classes 6, 9, 16, 18, 25, 28, 35, 36, 41, 43 and 44.

The examiner partially rejected the application for all the contested services based on Article 7(1)(b), (c) and 7(2) CTMR.

The applicant filed a notice of appeal against the examiner's decision.

The Board found that the mark 'THE DONKEY SANCTUARY' was descriptive and non-distinctive for 'boarding for animals' in Class 43. The proportion of the total possible market for the services for which registration was sought taken up by Malta was very small (the English-speaking Maltese population represented less than 0.6% of the English-speaking population of the EU and the Maltese donkey population constituted only around 0.1-0.2% of the donkey population of the English-speaking part of the EU). On the contrary, UK and Ireland, where extensive use was proven, represented the substantial part of the relevant territory. The CTMA had acquired distinctive character through use.

The Board annulled the contested decision in its entirety and declared that the CTM application should proceed to publication.

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Decision of the Second Board of Appeal of 28 May 2015 in case R1084/2014-2 (EN)

Article 8(1)(b) CTMR – Likelihood of confusion – Level of distinctiveness of a 3D mark

The applicant sought to register the figurative mark

(BEST LOCK 100% COMPATIBLE) claiming the colours red, yellow and black for goods and services in Classes 16, 25, 28, 35 and 41.

The opponent filed an opposition based on different earlier rights.

The Opposition Division partially upheld the opposition for all the goods and services in Classes 16, 25, 35 and 41 and part of the goods in Class 28. The application was allowed to proceed for the remaining goods in Class 28 namely 'games and playthings'. It ordered each party to bear its own costs.

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

The Board found that in relation to the distinctive elements of the marks, the contested decision deemed that the opponent's three-dimensional trade mark

which consisted only of the shape of a rectangular toy brick with no verbal elements, and the rectangular toy brick of the contested sign had a normal degree of distinctive character for all the relevant goods, except for, in the case of the contested mark, games and playthings in Class 28. This was because, under the category of games and playthings, a wide variety of goods were included, such as construction toys. However, the Board noted that in the judgment of the Court referred to in the contested decision, C-48/09 P, Lego brick, the Court only found the toy brick in that case to be non-distinctive for 'construction toys'. The mark in question in that case remained on the register for other 'games and playthings'. In the case at hand, the contested mark also covered 'games and playthings' and the earlier mark covered only 'playing cards', which were the goods that coincided. For these goods the Board saw no reason to find that a three-dimensional or figurative mark containing a toy brick would have a lower level of distinctiveness. The representation of the rectangular toy brick constituted the opponent's mark in its entirety and the toy brick in the contested sign played a separate, dominant, role in that sign. Even though the wording '100% COMPATIBLE' was also included in the contested sign, this expression was considered to be non-distinctive for

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a substantial part of the relevant public. The further differences in the signs, in other words, the fact that the toy brick in the contested mark was in colour; contained the words 'BEST LOCK' embossed on the studs of the brick of the contested mark, which were not eye-catching; and the square yellow background in the contested mark were insufficient, in the Board's view, to exclude a likelihood of confusion for the goods concerned. There was a likelihood of confusion for the identical goods.

The Board upheld the appeal and annulled the contested decision to the extent that it rejected the opposition and accepted the CTM application in respect of the goods 'games and playthings' in Class 28; and rejected the contested CTM application in its entirety.

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Decision of the Fifth Board of Appeal of 16 June 2015 in case R1456/2014-5 (EN)

Article 8(1)(b) CTMR – Likelihood of confusion – Similarity of goods in Class 16 and services in Class 42

The applicant sought to register the word mark 'ADM-Exchange' for goods and services in Classes 9, 35 and 42.

The opponent filed an opposition based on different earlier rights. The grounds of the opposition were those laid down in Article 8(1)(b), 8(4) and 8(5) CTMR.

The Opposition Division partially upheld the opposition for all the goods and services in Classes 9 and 35, and dismissed the opposition for all the services in Class 42.

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

The Board found that the Opposition Division had allowed the opposition partially, with the exception of the services applied for in Class 42. In parallel proceedings, where the contested CTMA was 'ADM Solutions', the Opposition Division also decided in favour of the opponent for the said services in Class 42. The opponent appealed and pointed out the inconsistency of the first-instance decisions. The Board found that the appeal was justified. The services at issue comprised the design and development of products including promotional products and gifts, and advice relating to the procurement of marketing materials in Class 42. The specification, even after numerous limitations included a range of services targeting business customers who would order such promotional products or seek advice as regards the procurement of marketing materials. The services also included 'design and development of products' in general. This covered a very wide variety of products, even if it was strictly limited to the procurement of

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tangible marketing materials and excluded the development of various software products. Tangible marketing materials could include all kinds of paper advertisements, newsletters, bulletins, brochures, reference calendars, pens, small toys, key rings etc. The opponent's CTM No 3 151 586 'ADM' covered quite a number of such items in Class 16, namely 'printed matter and materials; newsletters, bulletins, brochures, pamphlets, leaflets, reference calendars'. All of these items might be seen as the final products resulting from the design and development services provided by the applicant. Since small marketing products were usually designed and produced by the same manufacturers, these goods, and the services responsible for their design and development were thus deemed to be similar to each other to a normal degree. This led to a likelihood of confusion, due to the similarity between the signs. The opponent was also correct to point out that the comparison of the goods and services could not be limited to the comparison of the services contained in the classes having the same number, as in Class 42 in the case at hand, but it had to also include the comparison of the contested services to the other goods and services protected by the earlier mark.

The Board annulled the contested decision to the extent that it rejected the opposition with respect to all the services applied for in Class 42; and also upheld the opposition for the services listed above.

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Decision of the Second Board of Appeal of 3 June 2015 in case R2216/2014-2 (EN)

Article 8(4) CTMR – Substantiation of earlier rights

The applicant sought to register the figurative mark

Sonicell

for goods and services in Classes 7, 9, 37 and 40.

The opponent filed an opposition based on different earlier rights. The grounds of the opposition were those laid down in Article 8(4) CTMR.

The Opposition Division rejected the opposition in its entirety.

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

The Board found that the opponent had based its opposition on Article 8(4) CTMR and on the use made of a Portuguese company name and two Portuguese establishment names, which were rejected by the Opposition Division stating that they did not meet the minimum threshold of 'more than local significance'. The Board examined whether the opponent had complied with the cumulative conditions of Article 8(4) CTMR and concluded that (i) the earlier rights were acquired before the application date of the contested sign and that the

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documents submitted also evidenced the continued use of these rights, (ii) the opponent provided sufficient information concerning both the content of the rights invoked and the conditions to be fulfilled in the present case in order for it to be possible to prohibit the use of the contested trade mark under Portuguese law, (iii) with respect to prior use in the course of trade of more than local significance, the evidence submitted before the Opposition Division was indeed insufficient to establish such use. However, for the first time before the Board, the opponent filed new evidence regarding the prior use of its signs in the course of trade of more than mere local significance. With respect to the admissibility of this new evidence, the Board considered that it was particularly important to note that before the Opposition Division and within the time-limit laid down, the opponent proved that its earlier rights were acquired prior to the application date of the contested CTM and that the national law conferred on it the right to prohibit the use of the subsequent mark. Moreover, the documents filed before the Opposition Division concerned relevant evidence that was intended to prove use of more than local significance and the opponent believed, in good faith, that it was sufficient to substantiate its claims. The new evidence was filed in response to specific findings raised in the contested decision, was complementary to the materials adduced before the Opposition Division, and was also likely to be relevant for the outcome of the proceedings. The Board, when exercising its discretionary power granted by Article 76(2) CTMR, therefore took the evidence into account and proceeded with the examination of it, to conclude that the evidence as a whole now allowed the Board to ascertain that use had been of more than local significance. Since the contested decision only concerned itself with the issue of the substantiation of the earlier rights, and did not touch on the matter of a likelihood of confusion, the Board remitted the case to the Opposition Division for further prosecution.

The Board annulled the contested decision and remitted the case to the Opposition Division for further prosecution.

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The Registry also recommends

Decision of the Fourth Board of Appeal of 29 June 2015 in case R866/2014-4 (EN)

Article 119(5) and (6) CTMR – Time-limit for providing a translation of the list of services

The applicant sought to register the figurative mark

(CocoBeach IBIZA) for, inter alia and insofar as was relevant for the appeal proceedings, 'performance

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of music; theatrical performances, music performances' in Class 41.

An opposition based on the earlier French trade mark registration for the word 'COCOBEACH PARTY' was filed against part of the goods and services of the application based on Article 8(1)(b) CTMR.

The Opposition Division rejected the opposition as inadmissible.

The opponent filed a notice of appeal against the Opposition Division's decision.

The Board found that the Opposition Division correctly rejected the opposition as inadmissible as the opponent had failed to comply with his obligation to file the entire notice of opposition in the language of proceedings, namely English. The opponent was informed by the Opposition Division of this deficiency and was given a two-month period, in accordance with Rule 17(4) CTMIR, in which to remedy it by providing an English translation of the list of services upon which he based the opposition. The opponent did not provide the necessary translation within this period, and the contested decision correctly dismissed the opposition as inadmissible. The Board observed that the contested decision in fact gave the opponent more time to remedy this deficiency than he should have had. In accordance with Article 119(5) and (6) CTMR, if the language chosen as the language of opposition is an Office language but not the first or second language of the contested application, the opposing party shall be required to produce, at his own expense, a translation either into the language of the application for a trade mark, provided that it is a language of the Office, or into the second language indicated when the application was filed. The translation shall be produced within the period prescribed in the Implementing Regulation. Rule 16 (1) CTMIR states that this time-limit shall be one month from the expiry of the opposition period. In the case at hand, as the relevant information in the opposition notice was filed in French, although an Office language but not the first or second language of the CTM application (German or English), the opponent was thus under the obligation to file a translation of the list of services on his own volition within one month counted from the expiry of the opposition period. Since the opponent himself checked 'English' as the language of proceedings on the opposition notice, this translation was required in English. The Opposition Division applied Rule 15 CTMIR in conjunction with Rule 17(4) CTMIR. That had no basis. Rule 17(3) CTMIR is a lex specialis and explicitly states that its provisions apply when a translation is not submitted as required under Rule 16 (1) CTMIR. Moreover, as concerns the reference in Rule 17(4) to Rule 15, nothing in Rule 15 CTMIR refers to languages. Nevertheless, nothing turns on this point since the opponent in fact failed to file the required translation even within this longer time-limit.

As a consequence the Board confirmed the decision of the Opposition Division to reject the opposition as inadmissible.

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