

Alicante News

Up to date information on IP and OHIM-related matters



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The start of a new life for Creative Works

A new database for “orphan works” has just been launched by the Office for Harmonization in the Internal Market (OHIM).

Orphan works include books, films, newspaper articles and other creative material that are protected by copyright, but whose owner cannot be found.

There are millions of orphan works in libraries, museums, public broadcasters’ archives and other public institutions in the EU.

- the [British Library](#), for example, which holds over 150 million items, estimates that up to 40% of creative works in its collections could be orphans.

But without permission from the author or the author’s heirs, nobody can digitise or disseminate these works.. This also applies to cultural institutions.

The EU Directive on Orphan Works which entered into force at the end of 2012, is designed to solve this problem by setting out common rules for the digitisation and online display of orphan works which had been first published in the EU. Under the Directive, such works which have been identified as orphan after a diligent search on their authorship may be used by public institutions. All orphan works must be included in an EU-wide data base; the creation of which was entrusted to OHIM.

As a consequence, OHIM has been nurturing these orphan works, under the guidance of a copyright specialist.

WHAT INFORMATION IS AVAILABLE IN THE DATABASE?





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The preparatory phase included consultations with stakeholders to define the data and workflow of the database. At the beginning of 2014 the tool was designed and developed by OHIM's IT department, and the implementation of the bulk of the data upload process was achieved.

In July 2014, stakeholders helped with the database's testing phase and in mid-August the database went live on a restricted basis.

The database became fully operative at the end of October and continues to thrive with support from stakeholders, training programmes and communication activities. Two new releases are planned in 2015.

This single publicly accessible online platform aims to collect information about orphan works which are part of the collections currently held at national level by public libraries, museums, archives, film and audio heritage institutions and public service broadcasting organisations all over Europe.

These cultural bodies that hold works must first conduct a diligent search on the authors of the works and, if such a search is fruitless, they must record the information about the work in the database.

Once identified as an orphan in one country, these works are recognised as orphan across the European Union. This means that any cultural organisation having these works in its archives may digitise them and make them available across the EU. Such rules are an exception to copyright, and authors who recognise one of their works in the data base may of course request a change of status and to get back their full rights on the work in question.

Digitisation remains a challenge, with only a fraction of Europe's collections digitised so far (around 12% on average for libraries and less than 3% for films). The lack of data on the works is a major obstacle to digitising and making such works

available online.

The Orphan Works database has already been broadly welcomed by copyright specialists and cultural institutions across the EU. Dr. Péter Lábodý, head of the Copyright Department at the Hungarian Intellectual Property Office, believes that the database *"will be a very useful tool: a transparent and also manageable interface on which the users of orphan works, their right holders and also the competent national authorities can rely on"*.

The database, described as a "small, but important, step towards making Europe's cultural heritage digitally available" by Benjamin White, Head of Intellectual Property at the British Library, enables cultural institutions to prevent duplication of effort. "It will encourage knowledge sharing and dissemination of best practice, [and]...will encourage innovation across Europe, while protecting and promoting the interests of creators", he added.

For readers who want to know more:

The Orphan Works Database can be accessed from the [Observatory web](#) site and there's a video available or go directly to [OAMITubes](#)

If you would like to receive more information about or get involved in the Orphan Works database, please contact: observatory.orphanworks@oami.europa.eu



The James Nurton Interview



Peter O'Byrne, Group Counsel - Brand and Marketing, The Body Shop International.

What is your background?

I'm from a small coastal town in Australia called Torquay, which is very big in the world surf scene. In fact two global brands started there - Rip Curl and Quiksilver.

I went to Melbourne University and did a double degree in Law and Arts. I studied IP as part of that and went on exchange to University College Dublin in Ireland where I also studied IP. It was the area of law that was closest to the things I love - classical music, history and the arts.

I took articles with the law firm Allens Arthur Robinson in Melbourne. At the time I was a radio presenter on a Melbourne classical music station, which I did for five or six years during and after university. The firm started me with the competition law guru because he listened to my music station!



Peter O'Byrne,

Then I moved into IP. I was always clear that law was the career I would follow, but the radio presenting was a great outlet for my love of music.

Like a lot of Australians, I wanted to come over to Europe for a period of time so I moved to London and joined Baker & McKenzie's IP department. In Australia I had done a range of IP matters, particularly enforcement, and that continued at Baker & McKenzie. Australian law is a child of English law, so it was relatively familiar, and of course there is a lot of harmonisation in IP. But the EU dimension to practice was a very interesting change.

What kind of work did you do?

Quite a bit of work at Baker & McKenzie was for the company I've now joined, as well as other brands within the L'Oréal Group. For example, I worked on L'Oréal v Bellure - the lookalike and smellalike fragrances case - for about six years, which included a reference to the CJEU. It was a great result for the fragrance industry, which experiences a large parasitic trade. It clearly raised issues that weren't fully aired and clarified in the English courts. We got quite a clear judgment from the EU because of the stark nature of this parasitic industry.

I also worked on the Special Effects matter, which was very important particularly for trade mark oppositions, and I think was the first time INTA intervened in any European court proceedings. The case could have meant quite a large change in the use of oppositions: the issue was whether you couldn't raise invalidity in court if you had already argued it in an opposition. Fortunately we were successful so that issue didn't bite.



The James Nurton Interview



How is working in-house different from private practice?

I actually acted for The Body Shop a lot while in private practice, so there was already a good relationship and I respected the company.

But it is a slightly different way of life. In some ways it's simpler but not for the reasons people always air. It's helpful to see the internals of the business, and match your advice to a specific business and its requirements. As a private practitioner, some of the advice you give can be slightly abstract. Managing the internal relationships and dovetailing what you're doing with the needs of the business is key. And maximising the effect of the budget, as well as having efficient relationships with law firms around the world is critical.

But in terms of time and pressure, it's not very different working in-house compared to private practice in my experience.

What does your role involve?

My title is Group Counsel - Brand and Marketing at The Body Shop International, based in London. I direct the IP function for the company internationally. We are in 70 markets, and we have trade mark registrations in 150 countries or more. In addition to the IP aspects, I provide support on advertising, social media and some commercial matters.

In IP there's a busy internal team of three, and there is a large volume of work. We spend a lot of time coordinating a worldwide network of lawyers and non-legal service providers.

As well as trade marks, we routinely address copyright and design issues as well as domain names. And we coordinate our activities with the rest of the L'Oréal Group.

Do you have many different trade marks?

Historically The Body Shop has very much relied on its core house marks, with relatively descriptive names for products. That may be changing, but the core house marks are the principal marks we protect, even though there are an increasing number of products.

We have registrations for the name and logo in most countries. It's a mature business, started in the 1970s, and it took a very different approach to cosmetics. It's very much an activist company, which is good for the recognition of the brand. The challenges often come in new trading markets.

Success attracts unwanted attention so it's important to be on the front foot as much as possible with your protection. There are situations where people try to register your rights in advance and you have to take the necessary steps. It comes with being so well known.

There's a lot of variety in the law. It means you need to work with your local lawyers very closely.

What is the impact of social media?

Every year more of the classic IP abuse and illicit trade occurs on social media. We need to monitor and address that as well as other infringing activity online.

It's also important to make sure the company is managing the risks in social media, which is not just strictly IP. Employees should be aware of a policy on social media use. Social media managers have to respond quickly and informally so it's important they understand the risks so they can escalate issues if necessary. There is a balance to be struck. We monitor the activity the company is doing, and I think that works well.

In the advertising area, bloggers and vloggers are increasingly important in the fashion and cosmetics businesses. Some



The James Nurton Interview



of them are more important than traditional media and businesses need to work out how to relate to them, and how the regulations apply. Regulators themselves are also thinking about where to put the bar with this activity.

One of the questions is: when do you enforce your rights as an IP owner when the use is non- or quasi-commercial? And when is it best to do nothing? It's partly about resource but also PR management in handling fan-type activity.

It's not new of course but it's more visible and the volume is greater. In fact, the first trade mark file I had in Australia was for a drinks manufacturer and we worked with them to decide when they jumped in to deal with infringing activity and when not to.

You can take a broad approach but ultimately you need to look at each individual case. It's one of the fundamental challenges because volume is a factor.

What about domain names?

We have about 300 or so domain names, focused on our core brand in various top-level domains. We've monitored the new gTLDs as they are released, and we've taken a fairly conservative approach using some defensive registrations and some of the blocking mechanisms available.

What do you like about working in IP, and what is most challenging?

The best thing about working in IP is the global remit. It's constantly fascinating, not just the differences in law, which mean you are always learning, but also the different languages and cultures and ways of working. Sometimes geopolitics is a big factor in what you do as an IP lawyer.

That's the most rewarding thing, but also the most challenging. In the EU we have a sophisticated regime and a high level of

protection, but in other parts of the world things are very different. It requires a lot of focus, and that you have a really good team worldwide.

We use the Madrid System for international registrations, but not exclusively. We take different views for different countries. If it could expand further, that would be attractive. In some countries where we want to have more direct control of the mark, or if we expect specific issues, we will not use the Madrid System.

Are there particular improvements you would like to see in Europe?

There are two things to highlight. One is that from the Bellure case came this expanded range of functions of a trade mark, such as investment and advertising, as well as the classic origin function. Going forward, one of the most important things is how they are defined and what weight is given to them. That will be very important to how well protected brands are in the future. The keywords case law that came after has shown that something as counter-intuitive as your direct competitor using your house mark to trigger their advertising shows that the advertising function is not necessarily given weight.

In the context of a trade mark directive that offers protection for taking unfair advantage of a trade mark, these functions have to be there. The provision doesn't have an obvious connection to the guaranteeing origin function. So they are there and it's important that the CJEU started to define them. For brand owners, a trade mark is something you invest in and it has an advertising function. That is obvious and needs to be recognised in the law.

The other area is counterfeiting. It's really important that counterfeits are seen to be a public issue, not just an issue for the specific brand involved at that time. There is some good progress, but there is still work to be done. Police and Customs are working together, and it is critically important



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that intermediaries take responsibility and take technical steps to address counterfeit activity where they can. There are positive indications, such as the recent High Court decision in *Cartier v BskyB* where due weight was given to the public interest in stopping counterfeits. And the OHIM Observatory generates the kind of data that can be very persuasive when speaking to policy makers in Brussels.

What do you expect to be the big trade mark issues in the future?

One question will be: how much does the scope of fair use of trade marks expand? This relates to the question about functions. There's a debate about parody and copyright, but in a broader sense there's the keywords example. The law seems to suggest that's a fair use for a competitor to use a brand owner's trade mark to trigger an advertisement. That's an expansion. Whether it's online or elsewhere, the extent to which that continues to expand is a key issue.

Another issue, as we've discussed, is for IP owners: when we have rights should we always take action? Where the activity is non-commercial, there is a responsibility on IP owners to consider how to enforce their rights.

We have also discussed counterfeiting which will remain a very big issue. The question is how will the various pieces of the puzzle be brought together, and how do the various players contribute going forward?

Finally, for the cosmetics business, clearing and protecting new product names and designs is a core activity. So registry crowding – and to what extent that can be avoided – is a key problem. Non-use is one issue: there are so many marks that are not used, and the approach to removal varies around the world, even on questions such as who has standing? The public policy argument that marks not being used should not be on the register is quite clear, and we should make removing those marks as simple as possible. It's a worldwide rather than a national or European problem.



Community Trade Mark



Don't forget to keep the Register up to date!

Has your company changed name recently? Have you moved? Have you transferred your trade mark, or licenced it? All of these are important changes that affect your mark and should be reflected in the Register, this way you can help keep the Register up to date and maintain its veracity and benefit from its publicity.

If you've **changed name or address, correspondence address or contact information**, you can update these directly via your User Area. Any changes you make here will apply to all CTM proceedings that are being conducted under the same OHIM ID number.

Modifying your name and/or address will trigger an entry in the Register (a "recordal") that will be processed by OHIM.

If you haven't yet signed up to a [User Area](#), you can [file the form](#) to change your name or address.

All the information you need on the requirements for changing a name or address can be found in the [Guidelines Part E, Section 1 Changes in a registration](#).

If instead of a change of name you have actually transferred the ownership of your mark, you will need to submit a request to **register a transfer**.

A total transfer is the change of ownership of a CTM application or registration. A partial transfer is the transfer of some of the goods and/or services related to a CTM application or registration essentially resulting in the original mark being split in two, or more, separate marks that maintain the original filing date.

The process is simple and free of charge: there is no need to send documentary evidence of the transfer (e.g. a deed of assignment) when the representative signing the request checks the box 'Representative for both parties' and provided

they are listed as the representative appointed by the original owner in our database and are also appointed as the representative of the new owner/beneficiary.

In all other cases, the recordal application must be accompanied by a declaration signed by both parties, evidence of the transfer, etc.

To record a transfer of ownership with the Office you will need to fill in the Recordal application form which is available in its online and downloadable versions on the [forms and filings](#) page.

All the information you need on the requirements for recording a transfer of ownership can be found in the [Guidelines Part E, Section 3, Chapter 1 Transfer](#), including a useful explanation on the difference between change of name and transfer.

If you would like to **record a licence** you have granted for your mark, or that you have acquired for a mark, in the Register you can do this for a small fee of €200. Licences can be total or partial (relating to only some of the goods and services), territorially limited (to a specific part of the European Union), or limited in time (for a specific duration) or even exclusive (for a single licensee). Even sub-licenses can be recorded in the register.

Requests to record a licence in the Register can be filed by the licensor or the licensee, or their representatives, using the online or downloadable recordal application forms provided.

For full details on the indications and evidence needed, please consult the [Guidelines Part E, Section 3, Chapter 2 Licences](#).

Perhaps you are the liquidator of a company involved in **insolvency proceedings**.

Recording such details in the Register is very important vis-



Community Trade Mark



à-vis third parties who may have acquired rights in the trade mark (Article 23 CTMR). It also means that the CTM proprietor will lose its right to act and may not perform any actions before the Office such as surrendering, or transferring the mark. Furthermore, if an insolvency is recorded in the register the Office will notify the liquidator when the trade mark is due for renewal.

Recording an insolvency judgment in the register is free of charge and requires the completion of the online or downloadable form and for the recordal applicant to submit a copy of the insolvency judgment. The Office strongly recommends that liquidators withdraw, surrender or transfer the CTMs and CTMAs subject to insolvency proceedings prior to the final winding up. The dissolution of a company that is still the owner of assets (such as trade marks) is not normally allowed in the law of the Member States and could lead to the liquidator being found responsible for damages.

Full information on recording insolvency and the like proceedings in the Register can be found in the [Guidelines Part E, Section 3, Chapter 5 Insolvency proceedings](#).

Keeping the Register up-to-date is also very important when it comes to notifying you that your trade mark is due to expire. Keeping your personal details updated, but also making sure that any rights in rem, or licences are recorded in the Register will mean that the notifications from the Office will reach you, and affected third parties, correctly.



Registered Community Design



GC judgment of 03/10/2014, T 39/1, 'Skirting board'

This judgment rules on the appeal against the decision of OHIM's Third Board of Appeal, R 1512/2010-3, in relation to invalidity proceedings (ICD 4927) for registered Community design No 000070438-0002 (RCD), as represented in two views below (figs 1 and 2).

The RCD, registered and published in 2003, was challenged in invalidity proceedings on the grounds of Article 25(1)(b) Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (CDR) for non-compliance with the novelty and individual character requirements of Articles 5 and 6 CDR, on the grounds of being excluded from protection as it was a design incorporated in a component part of a complex product that is invisible during normal use, pursuant to Article 4(2) CDR, and on the grounds of being excluded from protection due to the fact that some features of the design were solely dictated by their technical function, pursuant to Article 8(1) CDR. The applicant mainly claimed that the contested RCD relates to an insert in the U form, consisting of six pieces, which plugs into and covers a recess in a skirting board and therefore it is a component part of a complex product, which is only partly visible when assembled. The invisible parts, which are the two protrusions extending from the flat base, are hidden in the recess of the skirting board and they are therefore excluded from protection pursuant to Article 4(2) CDR. They are also excluded from protection pursuant to Article 8(1) CDR as they are solely dictated by their technical function. The applicant relied on two earlier disclosed designs relating to component parts of skirting boards, as shown below (figs 3 and 4), alleging that they were an obstacle to the novelty and individual character of the RCD.

The grounds for invalidity were found to be justified and the invalidity application was upheld. It was ruled that the two parallel protrusions extending from the flat base of the insert

relating to the RCD were not solely dictated by their technical function but they were invisible when the product was assembled on the skirting board. The RCD relates to a product which is a component part of a complex product and its only visible part during normal use is the flat surface of the base. In this element the RCD is identical with the earlier disclosed design shown in fig. 3 below and therefore it lacks novelty. The decision was appealed.

The Third Board of Appeal upheld the first instance decision, finding that the RCD lacked novelty and individual character compared with the earlier design.

The RCD holder appealed to the General Court, claiming inter alia infringement of Article 25(1)(b), namely assessment of the nature, normal use, visibility, novelty and individual character of the RCD. The holder claimed that the RCD related to a multifunctional product capable of being used in a number of ways and that its use could not be restricted only to use as a component part of a complex product. The RCD could be used to cover a recess in a skirting board, as shown below (fig. 5), and incorporated in a floor or wall, in which case neither a wall nor a floor could be regarded as a product. If this is not the only use of the product relating to the contested Community design, Article 3(c) CDR should not be applied.

The holder further submitted that, even if the RCD were considered to be incorporated in a component part of a complex product, it would remain fully visible when, as demonstrated, it was made from a transparent material, covered the recess of the skirting board, was removed when cables were installed in the skirting board, or when the ends of the skirting board were not covered.

Furthermore, according to the holder and contrary to the Third Board of Appeal's finding, the product relating to the RCD cannot be used with a skirting board such as the one depicted in the Döllken catalogue; it cannot be attached to a



Registered Community Design



wall and covered by a skirting board clipped into it because the product relating to the RCD does not fit the corresponding parts of such a skirting board.

As regards the earlier designs, the holder claimed that the front views were not shown sufficiently to be able to assess the novelty and individual character of the RCD.

The General Court upheld the holder's plea. In essence, it found that:

As recital 12 CDR states that protection should not be extended to those component parts which are not visible during normal use of a product or to any features of such a part which are not visible when the part is mounted, it is not necessary to determine in the present case whether the recesses that the contested design is supposed to cover are located in a 'product' in the strict sense of Article 3 of Regulation No 6/2002 but rather to determine which features are visible during normal use.

Applying this argument on the use of the product relating to the RCD clipped into skirting boards such as those demonstrated by the state of the art (figs 3 and 4 below), the Court concludes that 'it would be impossible to protect the use of the design as an attachment to the back part of a skirting board because in that case the component part related to the RCD remains invisible'.

The contested design constitutes a component part of a complex product where it is intended to cover a recess in a skirting board and, incidentally, a recess in a wall or floor. While maintaining that the contested design is a multifunctional product, the Court contends that these are the only ways in which the product relating to the RCD is used that were truly demonstrated by the holder.

Regarding the visibility of the design when used in the ways demonstrated, according to the Court the Third Board of Appeal was not wrong in concluding that the only visible feature of the RCD during normal use is the front surface. The holder did not prove in the submitted evidence that, when the product relating to the RCD is made of a transparent material and inserted to cover a recess in a skirting board or wall, the protrusions of the RCD are visible. Moreover, the registration does not claim any particular material and therefore the design could be applied to products made of various materials, not just transparent ones.

The Board of Appeal was also right to conclude that the representation of the design displayed in the Döllken catalogue was clear enough for the purpose of assessing the novelty and individual character of the RCD because a perspective view of neither the RCD nor the earlier design is required as long as that graphic representation allows the shape and the features of the design to be identified, which was met in the present case.

The Court mainly ruled that the earlier design, which constituted the obstacle to the novelty and individual character of the RCD in the appealed decision, is not visible during normal use of the complex product of which it is a part as it is intended to be attached to the back of a skirting board. Therefore, in the same way as found above in relation to the visibility of the RCD, it has to be disregarded. Since a design constituting a component part of a complex product which is not visible during normal use of that complex product cannot be protected under Article 4(2)(a) CDR, the novelty and individual character of a Community design cannot be



Registered Community Design



assessed by comparing that design with an earlier design which, as a component part of a complex product, is not visible during normal use of that product. The Third Board of Appeal therefore erred in identifying correctly the visible elements of the prior design.

To see the CJEU judgment click [here](#)

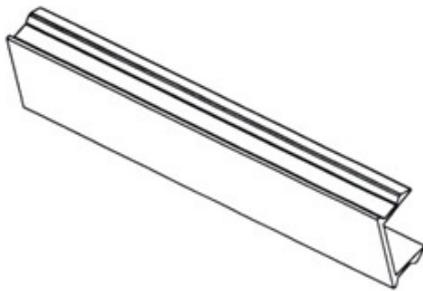


Fig. 1



Fig. 2

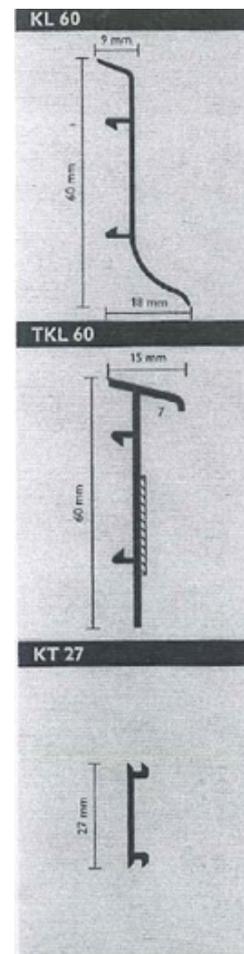


Fig. 3

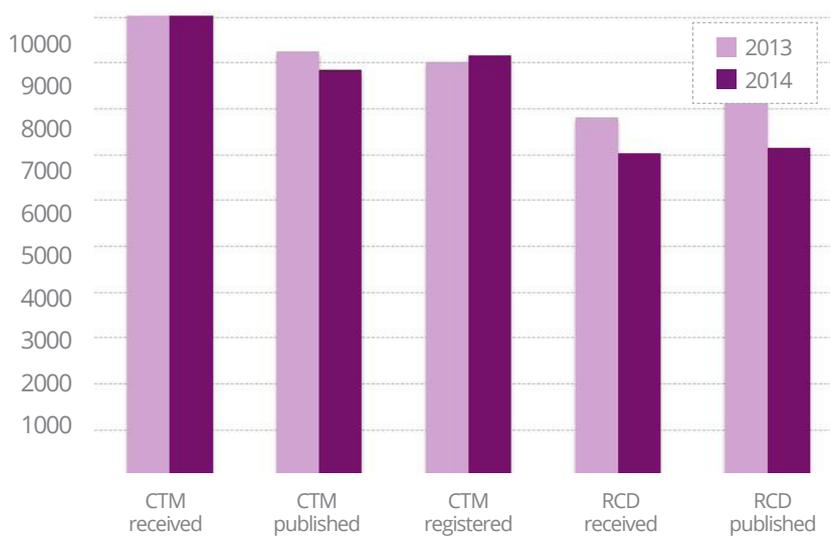


Statistical Highlights



Monthly statistical highlights October*	2013	2014
Community Trade Mark applications received	10 576	10 856
Community Trade Mark applications published	9 244	8 836
Community Trade Marks registered (certificates issued)	9 017	9 154
Registered Community Designs received	7 808	7 031
Registered Community Designs published	8 372	7 142

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





ETMDN Updates



e-filing Designs go live in Spain

Developed under the framework of OHIM's Cooperation Fund, the **Spanish Patent and Trade Mark Office (OEPM)** has implemented **e-filing for designs**.

e-filing for designs is one of the components of the Software Package project – the largest single project in the €50 million Cooperation Fund. It offers a simple and intuitive online registration process, making the design application process easier and quicker for users.

The implementation of the new system is the result of the joint work and collaboration between OHIM and OEPM experts.

The new OEPM e-filing system is available at <https://tramites3.oepm.es/sp-ui-dsefiling>

Greece implements trade marks e-filing

The Trademark Office of Greece has implemented e-filing for trade marks, a tool developed under the framework of the **Cooperation Fund** in collaboration with OHIM.

The new e-filing system represents a big step forward in the way trade marks are processed and registered. It offers an online registration process that makes trade mark applications easier, quicker and more accessible, benefiting all users of the Greek trade mark system.

A key member of the European Trade Marks and Design Network, Greece has been actively involved in the Cooperation Fund since the very beginning, contributing to the development and implementation of the majority of the tools developed within the Programme.

Slovenia implements e-filing for trade marks and designs

The Slovenian Intellectual Property Office (SIPO) has implemented e-filing for trade marks and designs. The e-filing tool is part of the Software Package developed under the framework of the Cooperation Fund.

The implementation of the new system is the result of the joint work and collaboration between OHIM and SIPO experts.

The new SIPO e-filing system is available at <http://www.uil-sipo.si/uil/dejavnosti/e-vloge/>

Cyprus joins DesignView

As of 10 November 2014, the Department of the Registrar of Companies and Official Receiver (**DRCOR**) which is part of the Ministry of Commerce, Industry and Tourism of the Republic of Cyprus has made its design data available to the **DesignView** search tool.

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

This last extension brings the total number of offices participating in DesignView to 18. Besides Cyprus these are: Bulgaria, Benelux, Czech Republic, Estonia, Spain, France, Greece, Italy, Lithuania, Latvia, Malta, Portugal, Romania, Sweden, Slovenia, Slovakia and OHIM.



ETMDN Updates



With the addition of more than 300 Cypriot designs, DesignView now provides information and access to almost 2,5 million designs in total.

Since the introduction of DesignView in November 2012, the tool has served more than **730.000 searches** from 133 different countries, with users from Germany, Spain, the UK and France among the most frequent visitors.

Iceland joins TMview

As of 24 November 2014, the Icelandic Patent Office ([ELS - IPO](#)) has made its trade mark data available to the [TMview](#) search tool.

This last extension brings the total number of offices participating in TMview to **37** and with the addition of more than 47,000 Icelandic trade marks, TMview now provides information and access to **almost 24,6 million** trade marks in total.

Since the introduction of TMview on 13 April 2010, the tool has served more than **10 million searches** from 214 different countries, with users from Spain, Germany and Italy among the most frequent visitors.

Back Office go-live in Finland

As of 17 November 2014, the Finnish Patent and Registration Office ([PRH](#)) started managing its national and international trade marks with the new Back Office system developed under the framework of the [Cooperation Fund](#). PRH is the first Office with a full go-live with the tool, which is the largest project of the Cooperation Fund.

The implementation is the result of more than two years of team work among the two pilot Offices (Finnish and Polish IP Offices) and OHIM. The Polish IP Office is very close to the full deployment of the system.

The Back Office system supports the management of trade marks and designs' lifecycle by IP Offices, including the following procedures:

- Registration
- Opposition/Cancellation/Invalidity
- Recordals
- Appeals
- International Registration
- International Application (trade marks only)

Apart from the two pilot offices, 10 more European IP Offices have expressed their intention to implement Back Office during 2015.



More News



Guidelines available in 23 official languages

This month we are delighted to officially inform you that the Guidelines, our unique source of reference on Office practice for OHIM's examiners, open and available to users, are now available in all EU languages.

You may remember that by virtue of the Decision of the President of OHIM ([Decision No EX-13-5](#)) one set of Guidelines for Examination on Community Trade Marks and on Registered Community Designs was adopted, and on the 02/01/2014 they were published in OHIM's 5 languages – English, French, German, Italian and Spanish.

We are now pleased to inform you that as from 17/11/14, that same set of Guidelines (which corresponds to Work Package 1 (WP1) has been made available in all 23 languages of the European Union.

A lot of work has been done to translate them: we are talking about 2000 pages in 23 languages, which makes the impressive amount of 46.000 pages! You can understand how happy we are to share this important news with you all.

But the news don't end there, as the remaining parts of the Guidelines (the set of Guidelines that were adopted by the President on 13 June 2014 ([Decision No EX-14-1](#)), which corresponds to Work Package 2 (WP2) , will also be available in the 23 languages of the European Union before the end of the year.

Many users have been waiting for this moment, and the OHIM has made this possible. From translators to revisers, proofreaders and coordinators, there has been a lot of dedication and effort put in this work. Congratulations to all of them and of course to you, as you can now read these unique Guidelines in your mother tongue.

Administrative Board and Budget Committee meeting at OHIM

OHIM's governing bodies, its Administrative Board and Budget Committee, met in Alicante from 18 to 20 November 2014.

The Administrative Board and Budget Committee are composed of representatives of the Member States of the EU and the European Commission, and gather at OHIM twice a year

On November 18, the Administrative Board issued a favourable opinion on the revised OHIM Guidelines for Examination in the Office for Harmonization in the Internal Market. At the joint meeting of the Administrative Board and the Budget Committee on November 19, OHIM President António Campinos informed ABBC Members about the Office's progress towards the full achievement of the goals of its Strategic Plan; the Work Programme of the Office and the Work Programme of the EU Observatory on Infringements of Intellectual Property Rights and the status of the implementation of the Interinstitutional Agreement on budgetary discipline, cooperation in budgetary matters and on sound financial management.

Delegates also exchanged views on the OHIM Strategic Plan 2020.

On November 20, Ms Anne Rejnhold Jørgensen of the Danish Patent and Trademark Office was re-elected as Chairperson of the Budget Committee. OHIM briefed committee members on the implementation of the 2014 budget and the Office's Anti-Fraud Strategy.

The Budget Committee approved the 2014 amended budget and adopted the budget of the Office for 2015.



More News



Observatory Plenary meeting

Representatives from the Member States of the European Union, the European Commission services, as well as representatives from the private sector, civil society and international organisations met in OHIM's premises on 28-29 October.

The plenary meeting is the opportunity to present and discuss the ongoing work of the Observatory. It is also a chance for the Observatory stakeholders to agree on future activities and deliverables for this network of experts.

Participants were able to share their views and experience in discussion panels. There was a panel centred on small and medium enterprises, one focused on awareness raising amongst youngsters and one on enforcement and reducing intellectual property (IP) infringements. Discussions also centred on the tools and studies, with the recently launched Orphan Works Database featuring prominently.

Specific attention was also given to legal and international cooperation matters in IP, as well as new ways forward within the OHIM Academy.

OHIM, Europol and Eurojust conference on IPR infringements on the internet

On 5 November the Office, Europol and Eurojust co-hosted a major three-day conference in Alicante to help Member States and third countries deal with the phenomenon of fighting intellectual property crime on the internet and to strengthen cooperation between agencies in this field.

The conference brought together experienced investigators

from customs and police, public prosecutors, private stakeholders - such as brand protection managers from industry - policy makers and representatives from the judiciary and from Europol, Eurojust and OHIM. They exchanged ideas and discussed how IP and the internet could be mutually beneficial to consumers and legitimate business and what models and best practices can be developed to foster this balance and further combat counterfeiting and piracy.

This event is part of a series of knowledge-building conferences which already addressed fake pesticides, fake medicine, counterfeit household products and fake automotive parts as well as IP crime in sport. See the Observatory website for more information on past conferences.

FICPI at OHIM

On Friday 31 October, OHIM hosted a meeting with members of the Fédération Internationale des Conseils en Propriété Intellectuelle.

Delegates were welcomed by the President of OHIM, António Campinos, and were given a briefing on the recent work of the Office, including the new OHIM guidelines, the work of the EU Observatory on Infringements of Intellectual Property Rights, the work of the OHIM Academy and the OHIM website and online solutions.

Delegates also heard updates on the Cooperation Fund and Convergence Programme.

FICPI's membership is drawn exclusively from IP attorneys in private practice, and has more than 5,000 members in 80 countries around the world



Case law



Luxembourg trade mark and design news

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

Case C-521/13 P; Think Schuhwerk GmbH v OHIM; Judgement of 11 September 2014; Language of the case: IT

RESULT: Action dismissed

KEYWORDS: Position mark, Minimum degree distinctiveness, Design, Right to be heard, General reference to previous submissions, Lack of reasoning, Principle of non-discrimination, Burden of proof, Admissibility, Absolute grounds

FACTS: The CTM applicant sought to register the trade mark represented below. The examiner refused the application under Article 7 (1) (b) CMTR. The Board of Appeal (BoA) confirmed that the trade mark lacked distinctiveness to the extent that it would be perceived by the public as a variation in shoe design rather than as a badge of origin (para. 9). The CTM applicant filed before the General court (GC) an action grounded on 4 pleas in law: (i) lack of reasons within the meaning of Article 75 CTMR; (ii) infringement of Article 76 CTMR; (iii) incorrect application of Article 7(1) (b) CTMR; (iv) breach of the principle of equal treatment. The GC dismissed the action. The CTM applicant then filed before the European court of justice (CJ) an action based on 4 pleas in law: (i) infringement of the right to a fair hearing; (ii) breach of the duty to state reason; (iii) infringement of Article 76(1) CTMR; (iv) Infringement of Article 7(1) (b) CTMR.

CTMA



SUBSTANCE: The CJ dismissed the appeal pursuant to Article 181 RPCJ (order). (i) On the infringement of the right to a fair hearing, pursuant to Article 122(1) RPGC, "If a defendant on whom an application initiating proceedings has been duly served fails to lodge a defence to the application in the proper form within the time prescribed, the applicant may apply to the General Court for judgment by default". (ii) On the breach of the duty to state reasons, the CTM applicant criticised the GC for failing to sanction a breach of the duty to state reasons by the BoA. It would have grounded the decision on generally known facts without describing such facts and explaining their impact on the distinctive character of the mark (para. 25). The CJ dismissed the ground of appeal as manifestly unfounded, relying on settled Case-Law (para. 27, para. 28, para. 29): (i) the appeal criticises the BoA's decision rather than the GC's judgement, (ii) it does not indicate precisely the contested elements of the GC's judgement and (iii) it merely reproduces the pleas in law and arguments previously submitted to GC in order to obtain a re-examination (para. 30). (iii) On the infringement of Article 76 (1) CTMR. The CTM applicant criticised the CG for failing to sanction a breach of Article 76 (1) CTMR by the BoA. It would have not demonstrated the reasons why the mark had not distinctiveness (p. 31). According to the Office, the GC gave a ruling on the same ground of appeal; anyway the applicant has the burden to prove distinctiveness (Para. 32). The CJ dismissed the ground of appeal as manifestly unfounded, relying on arguments and Case-Law set out with regard to the previous plea (Para. 33, Para. 34). (iv) On the



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infringement of Article 7 (1) (b) CTMR, the applicant of the CTM criticised the GC for this infringement of Article 7 (1) (b) CTMR by not accepting that the Office infringed the aforesaid provision (p. 35). The main sets of arguments (Paras. 36-40) were: Error of law by the GC. It would have incorrectly applied legal criteria and referred to wrong Case-Law; Criticism of the finding results from the factual assessment conducted by the GC. It would have not taken into account the level of attention of the relevant public and the diversity of the design of shoes and laces in relation to the market. The CJ dismissed the plea as being manifestly unfounded – referring to (a) - and manifestly inadmissible – referring to (b) (Para. 61): The GC validated the decision without committing an error of law. Since it had stated that the mark would be indistinguishable from the appearance of the product, correctly applied Case-Law developed and ascertained whether the sign departed significantly from the norms or customs of the sector (para. 50); The argument implies an assessment of the facts which is a matter reserved to the jurisdiction of the GC (Paras. 43, 44).

Case C-450/13P; Donaldson Filtration Deutschland GmbH v. OHIM + Ultra Air GmbH; Judgement of 19 June 2014; Language of the case: IT

RESULT: Action dismissed

KEYWORDS: Absolute grounds, Claim for rejecting CTM registration, Bad faith, General principles of law, Scope of proceedings

FACTS: The CTM applicant Donaldson Filtration (formerly Ultra Air) sought to register the word trade mark indicated below. The Examiner rejected the application, considering that the trade mark was descriptive and lacked distinctiveness. Donaldson Filtration filed an appeal and the Board of Appeal (BoA) annulled the decision, considering that the trade mark had acquired distinctiveness in consequence of the use.

Afterwards, Ultra Air filed an action before the Office for invalidity of the registered CTM. The Cancellation Division (CD) declared invalid the registered TM. Donaldson Filtration filed an appeal and the BoA annulled the decision of the CD, considering that Ultra Air's action was inadmissible on the ground of abuse of rights. Ultra Air filed an action for the declaration of invalidity in order to use the same trade mark for similar goods in its business. Ultra Air filed before the General court (GC) an action grounded on 2 main pleas: (i) infringement of Article 52(1) (a) CTMR and (ii) infringement of Article 56 (1) (a) CTMR. The GC annulled the BoA's decision, considering (i) that neither an interest in bringing proceeding nor good faith are required to file an application for a declaration of invalidity based on an absolute ground for invalidity, (ii) that the Office breached its obligation to examine the validity of the trade mark during a proceeding for declaration of invalidity and (iii) the fact that Ultra Air had previously filed an application for the registration of the trade mark did not preclude a subsequent application for a declaration of invalidity (para. 14-25). The CTM applicant and the Office filed before the European court of justice (CJ) an action based on two pleas in law: (i) infringement of the general legal principle of abuse of rights and (ii) error of law by not considering the relevance of the unfair and inconsistent behaviour of Ultra Air.

CTMA

Ultrafilter International

SUBSTANCE: The CJ dismissed the appeal pursuant to Article 181 RPCJ (order). (i) On the infringement of the general legal principle of abuse of rights, the CTM applicant criticised the GC for disregarding its arguments on the breach of the general legal principle and failing to ascertain and sanction the abuse of rights by Ultra Air. The CJ dismissed the ground of appeal given that it was based on an incorrect reading of the judgement under appeal. The BoA erred in dismissing the appeal as inadmissible, without providing an adequate evaluation of the



Case law



validity of the trade mark. Defending the need to keep a sign free from IPR in order to use it in trade does not constitute an abuse of right: this is deduced from the spirit of Article 7 (1) (c) CTMR (Para. 37, Para. 43). (ii) On the error of law by not considering the relevance of the unfair and inconsistent behaviour of Ultra Ai, the CTM applicant, supported by the Office, criticised the GC for committing an error of law by not considering the relevance of the unfair and inconsistent behaviour of Ultra Air which had previously supported the registration of the trade mark (Paras. 51-56). The CJ dismissed the ground of appeal as manifestly unfounded. The GC took into account the behaviour of Ultra Air, considering that it could not preclude an application for a declaration of invalidity based on an absolute ground for invalidity: this is justified by the aim, the nature and the object of such proceedings (Paras. 65-69).

Case C-468/13P; MOL Magyar Olaj- cs Gazipari Nyrt. v. OHIM + Banco Bilbao Vizcaya Argentaria SA; Judgement of 17 July 2014; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Relative grounds, Burden of proof, General reference to previous submissions, New evidence, Similarity of the goods and services, Similarity of signs, Admissibility, First time on appeal, Colour mark, Serie of trademarks, Likelihood of confusion

FACTS: The CTM applicant sought to register the word trade mark indicated below. Banco Bilbao – the owner of the earlier CTM BLUE for the same services - filed an opposition based on the likelihood of confusion (Article 8 (1) (b) CTMR). The Opposition Division (OD) rejected the opposition. The opponent filed an appeal against the OD's decision. The Board of Appeal (BoA) upheld the appeal and rejected the CTM application. The CTM applicant filed before the General court (GC) an action for annulment of the BoA's decision. The GC dismissed the actions as unfounded, considering (i)

that the general reference made by the CTM applicant to the arguments already raised before the Office was inadmissible, (ii) that evidence annexed to the application and presented for the first time before the GC (the existence of a family of "MOL" marks) was inadmissible, (iii) that the findings concerning the factual assessment conducted by the BoA (similar services, similar marks, LOC) were correct. The CTM applicant filed before the European court of justice (CJ) an action grounded on 3 pleas in law: (i) infringement of Article 44 of RPGC and Article 21 of SCJ, (ii) infringement of Article 65 (2) CTMR and Article 135(4) RPGC (iii) infringement of Article 8 (1) (b) CTMR.

CTMA

MOL Blue Card

Earlier marks

Blue

Blue BBVA

Tarjeta Blue BBVA

SUBSTANCE: The CJ dismissed the appeal pursuant to Article 181 RPCJ. On the infringement of Article 44 RPGC and Article 21 SCJ, the CTM applicant criticised the GC for declaring inadmissible the arguments raised before the Office and referred to in its appeal as long as it was a mere technical reference (Para. 27, Para. 28). The CJ, endorsing the Office's arguments, dismissed the ground of appeal, considering the GC's finding as correct and the CTM applicant's argument as an attempt in vain to reclassify the general reference (para. 31, para. 32). On the infringement of Article 65(2) CTMR and Article 135(4) RPGC, the CTM applicant criticised the GC for declaring inadmissible evidence annexed to the appeal



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in so far they were presented for the first time before the GC: facts and arguments were not new because they were included in written observations submitted before the Office (Para. 36). The CJ, endorsing the Office's arguments, held that the CTM applicant duly set out facts and arguments, but it did not provide the Office with evidence (Para. 40). The principle following which new documents are inadmissible when submitted for the first time before the GC is therefore reiterated. On the infringement of Article 8 (1) (b) CTMR, The CTM applicant criticised the finding results from the factual assessment conducted by the GC, noting that it failed to consider (i) the high level of attention of the relevant public, (ii) the partial dissimilarity between the services referred to the earlier trade mark and the ones referred to the contested trade mark, (iii) the weak distinctive character of the element "blue". The CJ, endorsing the Office's arguments, held that the ground of appeal must be rejected as manifestly inadmissible in so far as the CTM applicant seeks to obtain a re-examination by the CJ of the GC's findings (Para 51).

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

Case T-453/11; Gilbert Szajner v. OHIM Judgement of 21 October 2014; Language of the case: FR

RESULT: Decision partially annulled

KEYWORDS: Relative grounds, Sign used in the course of trade, Company name, Dominant element, General principle of law, Similarity of the goods and services, First time on appeal, Admissibility, Principle of legality, New evidence, Complementary goods and services, Similarity of signs, Likelihood of confusion, Distinctive element, Descriptive element, Visual similarity, Phonetic similarity, Reputation, Generic mark

FACTS: The term Laguiole is the name of a small city in France known for its production of cutlery, and the generic name of a specific knife. The CTM Laguiole had been refused in respect of "side arms" in Class 8. It was however registered for G&S in Classes 8, 14, 16, 18, 20, 21, 28, 34 and 38. A request for cancellation was filed by the French company Forge de Laguiole on the basis of the earlier rights held on its corporate name (Article 53(1) (c) and 8(4) CTMR). The protection was claimed in respect of the activities mentioned in the company's articles of incorporation that is, "production and sale of all articles of cutlery, scissors, presents which are all articles related to tableware".

The request for cancellation was dismissed in its entirety by the Cancellation Division. On appeal, the Board of Appeal (BoA) annulled this decision and declared the CTM invalid for all G&S except services in Class 38. The BoA considered that, according to the French law (including its Case-Law) a corporate name is protected in respect of all activities carried out in accordance with its articles of incorporation, provided such activities are sufficiently specified therein. This was the case of "production and sale of all articles of cutlery, scissors". Regarding activities which might be too unspecific ("production and sale of presents – all articles related to tableware"), the BoA had regard to the concrete activities for which the cancellation applicant had engaged business. It found in particular that the cancellation applicant had been active in the trade of products relating inter alia to tableware, hunting, wine tasting, golf and smoking. According to Article L711-4 of the French IP Code, a corporate name is protected against use of a later mark under the condition of the existence of a risk of confusion.

The BoA considered that, as descriptive as it may be the word Laguiole was co-dominant in the earlier corporate name and that the goods and services for which the CTM is registered are identical or similar to the activities for which the earlier corporate name is protected. In its application before the General court (GC), the CTM holder claimed a violation of Article 53 (1) (c) CTMR and 8(4) CTMR. In particular, it claimed



Case law



that the protection of corporate names according to the French law was subject to the principle of specialty, as for trademarks, and was limited to the specific activities currently carried out by a company (without regard being due to the activities mentioned in the articles of incorporation). The CTM holder therefore contented that the earlier right should not be protected beyond the activity of cutlery and that none of the contested good and services were similar to cutlery.



SUBSTANCE: As regards the admissibility of a national judgment rendered after the contested decision and its impact on the review of legality, the CTM holder submitted, for the first time before the GC, a judgment of the French Supreme Court adopted after the Board's decision and which supported its view, as well a number of other documents. While the latter was considered inadmissible (para. 23), the former was considered admissible (para. 24).

The principle following which the party who relies on 8(4) must submit the content of the national law (C-263/09 Fiorucci) does not exclude the possibility to control the legality of the Board's decision in the light of a national decision which has been adopted on a subsequent date (para. 24 and 45). This is all the more so where a judgment merely clarifies the Case-Law (para. 46). Interpretative judgments have a retroactive effect: the Case-Law in force on a given date does not lead to acquired rights (para. 48). Even if the French Supreme Court's

judgment is, as such, a "new fact", it interprets the French law as the Board should have done on an earlier date and as the GC must now do (para. 50).

In regard to Scope of protection of a corporate name according to the French law the GC does not question that the right to oppose or cancel a later trade mark (as foreseen under Article L711-4 of the French IP Code) includes the right to prohibit its use, within the meaning of Article 8(4) (para. 37). The GC further observes that the issue of the scope of protection of corporate names was debated in the French Case-Law until the French Supreme Court adopted a judgment on 10 July 2012 by which it held that "the corporate name is protected only in respect of activities currently carried out by the company rather than for those listed in the articles of incorporation" (para. 43).

The conclusion is therefore that the protection of the corporate name "Forge de Laguiole" must be limited to the activities which were concretely carried out by the cancellation applicant on the date of which the contested CTM was filed (para. 51). The GC challenges that this corporate name was ever used in activities other than cutlery and forks (para. 72). Use in respect of boxes for knives, casings, bottle-openers or multi-functional knives (that is, mere accessories rather than "autonomous products") cannot extend the scope of protection recognised to the corporate name (para. 60-66).

On likelihood of confusion, the GC examined likelihood of confusion in the light of the principles set by the French Case-Law that is, an overall examination of relevant factors including the similarity of the signs, the degree of similarity of the economic sectors covered by these signs and the higher or lower inherent degree of distinctiveness of the earlier sign (Para. 78). The GC confirmed that the "Hand tools and implements (hand operated); spoons; saws; razors, razor blades; shaving cases; nail files and nail nippers, nail-clippers; manicure sets" in Class 8 and "paper-cutters" in Class 16 are similar to the cutlery activity of the cancellation applicant



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(Para. 85-94). “Screwdrivers” are however dissimilar (Para. 93). “Shaving brushes, fitted vanity cases” in Class 21 are complementary to sharp instruments such as knives and can be sold in the same outlets. They are therefore similar (Para. 85). “Corkscrews; bottle-openers” are similar to the cancellation applicant’s knives equipped with cork-screws (Para. 97). However, kitchen utensils, earthenware and recipients are dissimilar, having in mind that the earlier right cannot claim protection for “tableware” in general (Para. 96). “Precious metals; precious stones, boxes in precious metals” in Class 14 are dissimilar to cutlery (Para. 99). The same conclusion applies to “leather goods, cases, boxes” in Class 18. The fact that casings for knives can be made of leather does not suffice to establish a degree of similarity given that leather is a raw material addressed at manufacturers whereas knives are addressed at the end users (Para. 101). Likewise, all goods in Class 16 are dissimilar to the cancellation applicant’s activity, except “paper-cutters” and “envelopes” (to a low degree). The sole fact that paper products, including catalogues, are necessary for carrying out a company’s business does not create a degree of similarity. Equally, the fact that papers and printed matters can be sold in the same retail outlets as “paper-cutters” is not decisive given that stores selling writing instruments usually offer for sale a vast assortment of products (Para. 104). The same conclusion applies to jewellery, bags, frames etc. (Para. 106), sport articles, smoking articles (Paras. 107 and 110) with the exception of “cigar cutters; pipe cleaners” in Class 34 (this is because the cancellation applicant had shown use for a cigar cutter, Para. 109).

Regarding the comparison of the signs, the GC noted that the word “Laguiole” has a descriptive nature in respect of knives and, more generally, in respect of the core activity of the cancellation applicant. However, the same can be said about the word “Forge” (Para. 124). Taken on their whole, the signs have a medium degree of visual and aural similarity, and a high degree of conceptual similarity (Paras. 125-127).

The GC assessed the distinctiveness acquired by use of the earlier corporate name in the same manner as it would do for trade marks (Paras. 132-133). However, the cancellation applicant did not substantiate a reputation for its corporate name (Paras. 159-160), notwithstanding the awards it received for its knives and collaborations with celebrities (Paras. 143, 148, 155). The media exposure given to the cancellation applicant was limited (Para. 157). Likelihood of confusion is established in respect of goods which have a high or medium degree of similarity with the cancellation applicant’s activities, that is, “Hand tools and implements (hand operated); spoons; saws; razors, razor blades; shaving cases; nail files and nail nippers, nail-clippers; manicure sets” in Class 8; “paper-cutters” in Class 16, “corkscrews; bottle-openers; shaving brushes, fitted vanity cases” in Class 21 and “cigar cutters; pipe cleaners” in Class 34 (Paras. 162-163). The CTM is annulled in respect of such goods. Likelihood of confusion is excluded for all other goods, including “envelopes” which have only a remote degree of similarity with the cancellation applicant’s paper-cutters and its activity of production of knives (Para. 164).

Case T-342/12 Max Fuchs v. OHIM; Judgment of 8 October 2014; language of the case: EN

RESULT: Action dismissed

KEYWORDS: Relative grounds, Likelihood of confusion, Revocation of a decision, Figurative trademarks, Similarity of signs, Parallel proceedings, Distinctive element, Visual similarity, Conceptual identity, Similarity of the goods and services, Admissibility, Adversely affected

FACTS: The applicant sought to register the figurative mark reproduced below in Classes 18, 24, 25 and 26. Opposition



Case law



based on the CTM and French figurative marks reproduced below, for goods in Classes 18, 24 and 25 (FR). On Article 8(1) (b) CTMR, the Opposition Division rejected the opposition for the goods in Class 24 and allowed the opposition in respect of all the other goods. The Board of Appeal (BoA) dismissed the appeal.

CTMA



Earlier marks and FR marks



SUBSTANCE: After the adoption of the contested decision by the BoA, a final decision of the Cancellation Division revoked the earlier CTM as from 24 June 2013. The applicant claimed that the opposition should be considered devoid of purpose to the extent that it was based on the earlier CTM. On its own motion, the General court (GC) rules on whether the applicant continues to have an interest in bringing the action, i.e. on whether the annulment of the contested

decision, to the extent that it is based on the revoked CTM, is still capable of procuring an advantage to the applicant. The applicant's interest in bringing proceedings must, in the light of the purpose of the action, exist at the stage of lodging the action (failing which, the action is inadmissible). That purpose must continue, like the interest in bringing proceedings, until the final decision (failing which, there will be no need to adjudicate). If the applicant's interest in bringing proceedings disappears in the course of proceedings, a decision of the GC on the merits cannot bring him any benefit. However, the lapsing of the contested decision occurred after the lodging of the action, does not in itself place the GC under the obligation to declare that there is no need to adjudicate (Para. 23). A CTM revoked ex Article 55(1) CTMR is deemed not to have had the effects provided for under the CTM as from the date of the application for revocation (ex nunc). If those effects start after the adoption of a decision of the BoA allowing an opposition based on that mark (like in the case at hand), revocation does not constitute either a withdrawal or a repeal of that decision (Para. 24). Notwithstanding the intervention of a definitive decision revoking the earlier CTM on which the opposition was based, the applicant retains an interest in challenging the contested decision, including to the extent that that decision rules on the opposition based on that mark for the goods in Class 18 (Para. 29). On the merits, the goods are identical or similar and the signs are visually similar and conceptually identical. A likelihood of confusion was therefore found, despite the weak distinctive character of the earlier mark.



Case law



Case T-263/13; Lausitzer Fruchteverarbeitung GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM); Judgment of 1 October 2014; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Beginning of mark; Common element; Conceptual similarity; Distinctive element; Likelihood of confusion; Phonetic similarity; Relative grounds; Similarity of signs; Visual similarity, Similarity of goods and services, Typographical element, International registration

FACTS: The applicant sought to register the figurative mark seen below as a CTM for goods in Classes 32 and 33. The opponent lodged an opposition against the application on the basis of, inter alia, the designation in BLX, DE, ES, FR, IT and AT of its international registration for goods in Classes 32 and 33. The Opposition Division (OD) dismissed the opposition in its entirety. The appeal filed by the applicant was granted: The Board of Appeal (BoA) annulled the decision of the OD and granted the opposition on the basis of Article 8(1) (b) CTMR.

CTMA

Earlier IR

SUBSTANCE: The General court confirmed the existence of likelihood of confusion between the conflicting marks. The goods in Classes 32 and 33 are directed to the general public. The degree of attention is average (Para. 21). The beverages covered by the marks are identical or similar (Para. 22). The conflicting signs are visually and phonetically similar to a medium degree (Para. 49 and 58). The fact that the marks coincide in the element “Michel” is an indication of their visual and phonetic similarity (Para. 33 and 53). It is not unusual to use an antique font as shown in the contested sign in relation to beverages. The font of the mark applied for will therefore not be perceived as being capable of distinguishing the signs (Para. 37). Moreover, although it is true that consumers tend to pay particular attention to the beginning of a mark, the common element “Michel” will also be noticed and remembered by the public (Para. 39-41 and 55). Conceptually, the relevant German speaking public will associate the term “Michel” with a male first name. To that extent, the signs are conceptually similar (Para. 65 and 69). The word “Holz” means “wood” in German. The combined term “Holzmichel” will be understood - at least by a part of the German speaking consumer - as a reference to a person named Michel who is somehow connected with “wood” (Para. 66). The earlier mark enjoys a normal degree of inherent distinctiveness for beverages (Para. 76). Although the first element “Holz” of the contested sign is also distinctive the mark is not dominated by that term. The word “Michel” plays an independent distinctive role in the mark applied for (Para. 88). In view of the visual, phonetic and conceptual similarity between the signs and the identity or similarity of the goods at issue, there is a likelihood of confusion between the marks within the meaning of Article 8(1) (b) CTMR (Para. 89-91).



Case law

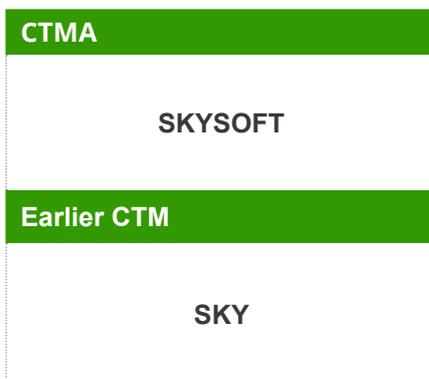


Case T-262/13; Skysoft Computersysteme GmbH v. OHIM; Judgment of 15 October 2014; language of the case: EN

RESULT: Action dismissed

KEYWORDS: Relative grounds, Likelihood of confusion, Identity of the goods and services, Similarity of the goods and services, Competence of the Boards, Complementary goods and services, Similarity of signs, Dominant element, Distinctive element, Descriptive element, Visual similarity, Phonetic similarity, Conceptual similarity, Enhanced distinctiveness, Dilution of distinctiveness, Reputation

FACTS: The applicant sought to register the word sign 'SKYSOFT' for goods and services in Classes 9, 35, 37, 38 and 42, including 'maintenance and repair of data processing equipment and computer installations' in Class 37. The opponent filed an opposition based on the earlier Community word mark 'SKY', covering goods and services falling within Classes 9, 16, 18, 25, 28, 35, 38, 41 and 42, including 'data processing equipment and computers' in Class 9. The Opposition Division upheld the opposition under Article 8(1) (b) in respect of all the contested goods and services. The Board of Appeal (BoA) dismissed the appeal.



SUBSTANCE: The General court (GC) confirmed the decision of the BoA. In first place, it stated that the BoA had correctly defined the relevant public as consisting of both the general public and the professional public in all the Member States of the European Union, in particular the English-speaking public residing in the United Kingdom with average or above average level of attentiveness (Para. 21). The GC then noted that the BoA's finding as to the identity of the goods and services falling under Classes 9, 35, 38 and 42 was not disputed by the applicant. The GC went on to confirm the BoA's finding that 'maintenance and repair of data processing equipment and computer installations (including equipment for access to networks and computer databases)', as covered by the mark applied for, and 'data processing equipment and computers (including data storage apparatus and instruments, software and data storage software, and software for video-conferencing)', as covered by the earlier mark, are complementary, since those services refer specifically to the above goods and ensure their proper functioning. The GC added that those goods and services often share the same distribution channels and are offered in the same sales outlets specialising in IT (Paras. 24-25). As to the comparison of the signs, the GC endorsed the opponent's argument that the relevant English-speaking public would perceive the element 'soft' as an abbreviation of the word 'software', being therefore descriptive of some of those goods — including software — and services, which further diminishes its importance compared to the element 'sky', which does not have such a descriptive character. Already on a visual comparison, the relevant public may perceive the latter sign as being derived from the first sign (Para. 30). The signs present an average phonetic similarity of the signs at issue by reason of the identical pronunciation by the relevant English-speaking public of the common syllable 'sky' (Para. 31). The signs are also similar to an average degree from a conceptual point of view, due to their common element 'sky' (Para. 33). The GC dismissed the applicant's argument that Office is not entitled to take into account decisions of national authorities as factors relevant to its assessment, as the BoA did in the



Case law



present case by referring to two decisions of the UKIPO (Para. 39) and also dismissed as vague and ineffective the applicant's argument that the distinctiveness of the earlier mark would be 'diluted' by the approximately 600 entries containing the word 'sky' in the UKIPO's register. The GC then confirmed the BoA's assessment that the earlier trade mark 'SKY' had a substantial reputation in the United Kingdom for some of the goods and services in question (Para. 40). The GC therefore confirmed the BoA's finding that, in the mind of the relevant English-speaking public residing in the United Kingdom, and even taking into account a greater level of attentiveness than average on its part, there was a likelihood of confusion

Case T-215/12; MPM-Quality v.o.s. and Eutech a.s. v OHIM; Order of 02/10/2014; Language of the case: CS

RESULT: Action dismissed

KEYWORDS: Proof of Use, Bad faith, First time on appeal, General principle of law, Admissibility, Declaration, International registration, License agreement, Number, Figurative trademark, Relative grounds, Ownership

FACTS: An application for invalidity was filed against the figurative CTM represented below and registered for goods in Classes 9, 14 and services in Class 35, based on Articles 52(1) (b) and 53(1)(a) CTMR (bad faith filing and relative grounds for invalidity (likelihood of confusion, unfair advantage/detriment)).

The Cancellation Division rejected the request, stating that the application for invalidity was inadmissible according to Article 165(4) (b) insofar as it was based on Czech and Slovak earlier trademarks. Regarding the invoked earlier international trade mark, the submitted evidence was not enough for proving genuine use. Bad faith was not proven in the proceedings either; mere knowledge of the earlier marks is not sufficient,

in itself, to conclude that the applicant was acting in bad faith. The Board of Appeal (BoA) dismissed the applicants' appeal. The applicants filed an action before the General court (GC).

CTM



SUBSTANCE: the GC rejected the action as partially manifestly inadmissible and partially manifestly lacking any foundation in law. The action was found to be unclear and poorly structured (par 22); the GC nevertheless identified six pleas in law: (1) breach of Article 8(1)(a)(b) CTMR; (2) breach of Article 8(5) CTMR; (3) breach of Article 54 and 165(4) CTMR; (4) breach of Article 56 and 41 CTMR; (5) incorrect assessment of evidence of use of earlier international registration; (6) breach of Article 52(1)(b) CTMR. The first two pleas in law were rejected as irrelevant, because the applicants requested the Court to carry out a substantial assessment of Articles 8(1) and (5), which was not carried out by the BoA. The third plea in law was found to be manifestly lacking any foundation in law. A CTM cannot be declared invalid if the earlier national right was registered, applied for or acquired in a new Member State prior to the date of accession (Art 165(4) CTMR). Article 54 invoked by the applicants was not at all mentioned in the BoA's decision. The fourth plea in law is manifestly inadmissible. The arguments of the applicants stating that the assertions of the Office regarding joint ownership of the earlier marks are "totally irrelevant and unfounded" are not sufficiently clear and precise to enable the defendant to prepare its defence and the GC to exercise its power of judicial review. Regarding the fifth plea, the part of applicants' argumentation where they state that the Office "essentially erred in law" as it did not attribute



Case law



sufficient weight to the evidence provided (one affidavit), is considered manifestly inadmissible, as it is too general to enable the defendant to prepare its defence and the GC to exercise its power of judicial review. The applicants' argument that the submitted affidavit was "incorrectly assessed by the Office" is considered manifestly unfounded; it is evident that the BoA duly examined the affidavit in question before concluding that it was not enough to prove use of the earlier international registration. The sixth plea is partially manifestly inadmissible and partially manifestly unfounded. Firstly, the applicants' arguments are very short, unclear and imprecise. The applicants criticise the Office for not having taken into account the evidence submitted by them and for not having given appropriate weight to such evidence. This criticism is again too vague and hence manifestly inadmissible. The arguments regarding previous knowledge of the applicants' marks by the CTM proprietor are manifestly unfounded. Firstly, this fact became clear during the proceedings and secondly, mere knowledge is not sufficient, in itself, to conclude that the applicant was acting in bad faith. The applicants' assertions that the BoA did not deal with the issue of licence agreements between the parties is erroneous, because the BoA dealt with this issue in paragraph 41 of the contested decision. Regarding the inclusion of numeral 1949 in the contested CTM, supposedly giving a wrong impression about the company's history and hence inserted in bad faith, the GC stated that mere insertion of a year in the contested CTM cannot be on its own conclusive about any bad faith on the part of the CTM proprietor. This argument is manifestly unfounded.

Case T-444/12; Novartis AG v. OHIM; Judgment of 16 October 2014; language of the case: EN

RESULT: Decision annulled

KEYWORDS: Relative grounds, Likelihood of confusion, Similarity of the goods and services, Nature of the goods and services, Purpose of the goods and services, Complementary goods and services,

Similarity of signs, Visual similarity, Phonetic similarity, Internet, Well-known facts need no evidence.

FACTS: The applicant sought to register the word sign 'LINEX' for 'pharmaceutical preparations, containing lactobacillus acidophilus' in Class 5. The opponent filed an opposition based on the earlier Italian word mark 'LINES PERLA', registered for 'ladies hygienic diaper; hygienic napkins for incontinents' in Class 5, 'disposable napkins made of paper or celluloid, paper tissues' in Class 16 and 'napkins in the form of underpants' in Class 25. The grounds relied on in support of the opposition were, inter alia, those referred to in Article 8(1) (b) CTMR. The Opposition Division (OD) upheld the opposition under Article 8(1) (b) in its entirety.

The Board of Appeal (BoA) dismissed the appeal. It held that that (i) the relevant public was the Italian general public consisting of consumers exposed to health problems while taking the view that their level of attention varied from high to above average, (ii) there was a high degree of similarity between 'ladies' hygienic diapers' and 'pharmaceutical preparations containing lactobacillus acidophilus', since they belonged to the same general category of goods for healthcare, their purpose was to be used in medical treatments or in surgical operations relating, in particular, to urinary incontinence, and they could contain lactobacillus acidophilus, a bacterium which is naturally present in the vagina and is beneficial in combatting yeast infections. In particular, the BoA found that the absence of that bacillus in that part of the body can be remedied by diapers to which lactobacillus acidophilus is added in order to combat a possible yeast infection. In addition, the contested goods are sold, inter alia, in pharmacies and are targeted at end consumers with health problems linked to urinary incontinence. Taking into account the visual and phonetic similarities of the marks, the BoA found that there was a likelihood of confusion.

SUBSTANCE: The General court (GC) annulled the BoA decision. The GC held that the BoA had erred in defining the



Case law



relevant public and that the conflicting signs targeted Italian women exposed to gastro-intestinal risks or problems and patients of either sex exposed to both gastro-intestinal risks or problems and problems related to urinary incontinence, the level of attention of the former being high and the one of the latter being above average (Paras. 24-25). The GC endorsed the BoA's finding that it is well known that a large number of pharmacies, and not just in Italy, sell also hygienic diapers (Para. 34). It found, however, that the nature and manner in which the above goods are used are dissimilar.

The GC then dismissed the opponent's argument that the conflicting goods are highly similar in that they belong to similar categories, namely 'pharmaceutical preparations' and 'sanitary preparations'. The GC stated that its established Case-Law to the effect that there is a relatively high degree of similarity between the broadly worded categories 'sanitary preparations for medical purposes and for personal hygiene' and 'pharmaceutical preparations' does not entail that the same finding should apply to very specific goods such as those at issue here, although they belong to those broad categories (Para. 39). The GC held that the evidence on file did not allow establishing, as the BoA had found, that lactobacillus acidophilus is a medicinal product designed to treat incontinence or urinary tract or vaginal infections which may cause incontinence related problems. The mere fact that that bacterium is recommended in addition to a treatment against incontinence, in so far as its inclusion is recommended in a general change in dietary habits which a patient who suffers from incontinence should make, is not sufficient to allow the conclusion that it has a medicinal or therapeutic purpose (Para. 46).

The GC reiterated its settled Case-Law pursuant to which facts alleged on the basis of information taken from Wikipedia must be disregarded since they lack certainty (Para. 47). The GC added that the therapeutic benefits of lactobacillus acidophilus as a treatment for incontinence may not be considered to be either proven or well-known and that 'pharmaceutical preparations containing lactobacillus acidophilus' are not

connected with the medical treatment for incontinence (Para. 48). As to the BoA's finding that the absence of lactobacillus acidophilus in the vagina can be supplemented by napkins to which this bacillus is added in order to combat an eventual yeast infection', the GC noted that (i) when the BoA adopted its decision, it had not been established that medicated hygienic diapers existed, (ii) the existence of such products could not be considered to be a well-known fact, (iii) it had not been demonstrated that it is possible to place a bacterium into the vagina by means of a hygienic diaper or napkin (Para. 53). The BoA therefore should not, on the basis of the evidence available, have found that such a product existed. The GC found only a very low degree of similarity between 'pharmaceutical preparations, containing lactobacillus acidophilus' and 'ladies hygienic diapers' and 'hygienic napkins for incontinents', which do not have the primary objective of caring for the body or improving health, but rather of protecting clothing in cases of incontinence or loss of blood (Para. 55). The GC dismissed the opponent's argument that the conflicting goods would be complementary (para. 56). The marks at issue have a relatively low degree of visual similarity and a low degree of phonetic similarity (Paras. 62-63). The GC thus excluded the existence of a likelihood of confusion, taking into account the high/above average level of attention of the consumers concerned, the very low degree of similarity between the contested goods, the average distinctive character of the earlier Italian mark and the rather low degree of visual and phonetic similarity between the marks (Para. 70).

Case T-297/13; Junited Autoglas Deutschland GmbH & Co. KG v OHIM; Judgment of 16 October 2014; Language of the case: EN

RESULT: Action dismissed

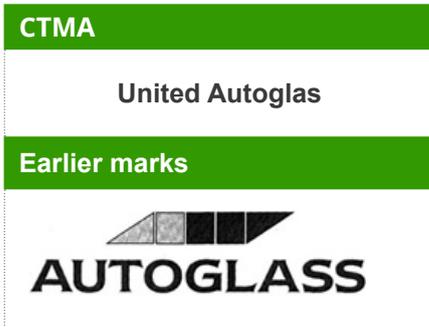
KEYWORDS: Beginning of mark, Common element, Conceptual similarity, Distinctive element, Descriptive element, Figurative element, Likelihood of confusion, Phonetic similarity, Relative grounds, Relevant language, Similarity of goods and services, Similarity of signs, Visual similarity



Case law



FACTS: The applicant sought to register the word mark United Autoglas as a CTM for goods and services, inter alia, in Classes 12 and 37. An opposition based, inter alia, on the earlier Polish figurative mark seen below registered for goods and services in Classes 12, 21 and 37, was filed on the grounds of Article 8(1)(b) CTMR. The Opposition Division upheld the opposition and the Board of Appeal dismissed the appeal.



SUBSTANCE: The General court confirmed the existence of likelihood of confusion between the conflicting marks. The goods and services covered by the marks are directed mainly at the general public in Poland (Para. 22) and are identical and similar (Para. 24). The Polish equivalent of the German word "Glas" ("glass" in English) is "szkło". Although many consumers in the European Union know basic English vocabulary (such as the English terms 'star', 'snack' and 'food'), the term 'glass' does not form part of such basic vocabulary (Para. 32). The term "autoglas" cannot be considered to be descriptive for the part of the Polish consumers who do not have a certain level of English or German. Since the term "glas" has no meaning for the part of the relevant public, the term "autoglas" is of medium distinctive character (Para. 35-36). The English word 'united' is not elementary English vocabulary either. Even though the average Polish consumer might recognise the term 'united' knowing companies such as 'United Airlines' or the name 'the United States of America', there is nothing

to suggest that he also understands its meaning (Para. 42-43). CTMA does not contain any element which might be considered to be manifestly more distinctive or dominant in comparison with the other elements (Para. 45). Having regard to the high similarity between the second element of the CTMA and the only word element of the earlier mark, but also to the differences between them in the remaining elements, including figurative, there is a low degree of visual similarity (Para. 51-53). Given the identical pronunciation of the term "autoglas(s)" in both marks, there is a medium phonetic similarity (Para. 56). Although the term "autoglas(s)" will not be associated with glass for automobiles by those of the average Polish consumers who do not have a certain level of English or German, both marks contain the term 'auto' and will therefore evoke, from the point of view of the relevant public, either automobiles or automatic devices. Even if, as the applicant asserts, the average Polish consumer associates the term "auto" only with automobiles, the fact remains that the marks at issue are conceptually similar in this respect (Para. 58). The presence of the element 'united' in the CTMA does not rule out the possibility that the consumer might consider the trade mark sought to constitute a mere variant of the earlier mark on account of the presence of the element "autoglas", which is almost identical to the sole word element in the earlier mark (Para. 64). Even a high level of attention on the part of the relevant public would not call into question a risk that a consumer may think that the trade mark sought is a variant of the earlier mark (Para. 66).



Case law



Case T-490/12; Arnoldo Mondadori Editore SpA, v OHIM;
Judgment of 26 September 2014; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Dilution of distinctiveness, Dissimilarity of the goods and services, Identity of signs, Likelihood of confusion, Reputation, Unfair advantage, Detriment to earlier mark, Relative grounds, New evidence, First time on appeal, Admissibility, Figurative trade mark, Competence of the Boards, Survey, Promotional material, Weak element, Well known trademark, Use without due cause

FACTS: The CTM applicant sought to register the word mark GRAZIA for services in Classes 35, and 36. The opponent based its opposition on Article 8 (1) (b) and 8 (5) CTMR using among others the earlier Italian mark shown below, registered for goods and services in Classes 3, 9, 16, 18, 25 and 38. The opposition was directed against all the services covered by the application. The Opposition Division rejected the opposition. The Board of Appeal (BoA) dismissed the appeal, finding that the goods and services to be compared are dissimilar for which reason no likelihood of confusion may occur. As for the other ground invoked, the BoA found that the opponent did not show the alleged reputation for the earlier marks nor did it show the necessary link between the confronted marks in order to apply Article 8 (5) CTMR. The opponent appealed to the General court (GC), arguing an infringement both of Article 8 (1) (b) and 8 (5) CTMR.

CTMA

GRAZIA

Earlier Italian mark

GRAZIA

PROCEDURE: The applicant referred in the application before the GC to documents, which were not produced before the Office, and additionally proposed to submit further evidence if needed. The GC refused those submissions and the proposal as inadmissible. It confirmed the Case-Law that, since it is held to review the legality of the contested decision of the BoA, it must not re-evaluate the facts in the light of evidence submitted for the first time before it. (Para. 42 – 44). The applicant's claim that the BoA should not have concluded that the earlier figurative mark is not well known as its reputation had not previously been called into question must be rejected as unfounded. Following Article 64 (1) CTMR the BoA is to decide on the appeal and, in doing so, it may 'exercise any power within the competence of the department which was responsible for the decision appealed', that is to say, in the present case, give a decision itself on the opposition. It therefore follows from that provision that the effect of any appeal brought before it is that the BoA is required to carry out a new, full examination of the merits of the opposition, in terms of both law and fact (Para 45).

SUBSTANCE: In relation to Article 8 (1) b, likelihood of confusion, the GC confirmed the BoA finding on the dissimilarity between the confronted goods and services.



Case law



They are different in nature, intended purpose and method of use and there is no complementarity or competition between them (Para 27). In particular the applicant's argument that the goods and services covered by the marks have clients in the fashion sector in common, is not sufficient to render them similar (Para 29). The GC concluded that the simple fact that the goods and services covered by the marks at issue are not similar makes it possible to rule out any likelihood of confusion, and that conclusion cannot be affected by any finding that the earlier figurative mark is highly distinctive per se or that it is well known to the relevant public (Para 31). As to Article 8 (5) on unfair advantage/detriment, the GC stated at the beginning that the conditions for the application of Article 8 (5) CTMR are a) the marks at issue must be identical or similar; b) the earlier mark cited in opposition must have a reputation; and c) there must be a risk that the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark (Para. 36). As to a) the marks being identical or similar, the first condition is met, since the marks are identical, as also stated in the contested decision (Para. 38). As to b) the reputation of the earlier mark, the GC held contrary to the BoA that the applicant has shown that its earlier mark enjoys a reputation for magazines (Class 16), although that reputation is not to be considered as strong (Para. 68). The GC stressed the fact that the long use of the earlier mark for magazines (since 1938) is a relevant factor (Para. 47). It went on to analyse the further evidence, and found that GRAZIA is the leading weekly magazine in Italy in terms of distribution. The documents in support have a probative value. This wide distribution may also be inferred from the advertising revenue. Moreover, from the market survey produced by the applicant it may be acknowledged that 51% of the relevant public knew that the GRAZIA magazine deals with beauty, etc. The applicant's large promotional activity, although it does not directly refer to the magazines, still is to be taken into consideration as far as the knowledge of GRAZIA is concerned (Para. 47 – 63). As to c) the link between the marks, the GC exposed the factors for the

assessment of the link between the marks, which are: (i) the degree of similarity between the marks at issue; (ii) the nature of the goods or services concerned by the marks at issue, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public; (iii) the strength of the earlier mark's reputation; (iv) the degree of the earlier mark's distinctive character, whether inherent or acquired through use; and (v) whether there is a likelihood of confusion on the part of the public (Para. 71). The GC concluded finally that although the signs are identical and there is a certain overlap of the public to which the contested services and the earlier goods magazines (Class 16) are directed, the other factors are not complied with in the present case. The goods and services have no connection at all, in particular the business consultancy and financial services do not evoke the same image as the earlier magazines. The earlier mark is reputed but not strongly and has a weak inherent distinctive character for beauty magazines. Finally, there is no likelihood of confusion between the marks (Para. 78). Since one of the conditions for the application of Article 8 (5) CTMR is not met, the action is unfounded.

Case T-567/12; Kaatsu Japan Co. Ltd. v OHIM; Judgment of 7 November 2014; Language of the case: EN

RESULT: Action is dismissed

KEYWORDS: Absolute grounds, Descriptive element, Lack of reasoning, Right to be heard, Relevant territory, Specialised public,

FACTS: The applicant sought to register the word mark KAATSU for goods and services in Classes 9, 10, 16, 28, 41 and 44. The examiner rejected the application for registration because the mark applied for was caught by the ground for refusal set out in Article 7(1) (c) and Article 7(2) CTMR. On the appeal of the applicant the Board of Appeal (BoA) dismissed the appeal. It held that the mark applied for related to an exercise method



Case law



or technique to build muscle quickly, and that the term 'kaatsu' referred to that method and informed the consumer directly and without the need for further reflection on his part about the goods and services in question. The BoA went on to say, that the mark applied for was neither merely suggestive nor allusive, but directly descriptive of certain characteristics of the goods and services offered by the applicant. The BoA also held that the applicant had failed to show that the mark applied for had acquired distinctiveness through use.

CTMA

KAATSU

SUBSTANCE: As regards the relevant public, the General Court (GC) held that as is clear from point 18 of the contested decision, which has not been challenged by the applicant, the goods and services referred to are intended not only for the general public, but also for a specialist public, which is represented, in particular, by professionals and companies specialised or operating in the medical field, trainers and fitness centres for personal training and body-building. Furthermore, the BoA's finding that the relevant public was that of the European Union because the mark applied for was capable of being understood in any Member State of the Union was confirmed. On the descriptive character, the fact that the mark applied for was created by the applicant's chairman, namely Professor S., in order to designate a particular exercise method (constituting an invented word for the EU public) does not mean that the mark in question must automatically benefit from Community registration. Pursuant to the Case-Law the mark applied for must, in order to be able to benefit from Community registration, enable the relevant public immediately to perceive the mark as an indication of goods or services offered by the holder of that mark and thus to distinguish them from the same goods

and services that have a different commercial origin. The GC held that, since the sign KAATSU is presented as a particular exercise method and not as an indicator of goods and services offered by the applicant, it follows that the BoA was correct to refuse registration of the mark applied for on the basis of Article 7(1) (c) CTMR. The mark applied for will be understood as containing direct information as to the nature and subject-matter of the goods and services referred to, namely goods or services whose purpose is to build muscle quickly. Since the term KAATSU can be used to designate a particular method or technique of physical exercise and to inform the consumer, directly and without the need for further reflection on his part, that the goods or services in question concern that method or technique of physical exercise, that term must, having regard to the public interest that underlies Article 7(1) (c) CTMR, remain available for public use and not become the subject of a monopoly, even if the term is not yet commonly used. On the breach of the rights of the defence, the BoA held that the evidence upon which the examiner had based his conclusion was sufficient to establish the descriptive nature of the mark applied for. In referring to the fact that other evidence of descriptiveness existed, the BoA did not state that it was taking that evidence into consideration, but merely pointed out that other evidence existed so that the evidence upon which the contested decision was based was not exhaustive. Therefore, the GC held that it cannot properly be inferred from that passage that other evidence, which was not made available to the applicant, was taken into consideration in the administrative proceedings.



Case law

Case T-531/12; Tifosi Optics, Inc. v. OHIM (T / T); Judgement of 7 October 2014; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Relative grounds, Letter mark, Similarity of the goods and services, Similarity of signs, Likelihood of confusion, Figurative trademark, Admissibility, First time on appeal, Translation, Representative, Nice Classification, Visual similarity, Phonetic identity, Distinctive element

FACTS: The registration of Community trademark was sought by Tifosi Optics, Inc. (the “applicant”) for a figurative sign reproduced below, for the following goods: - Class 9: ‘Optical apparatus and instruments; spectacles; sunglasses; frames; cases; hinges; arms and lenses for spectacles and sunglasses, parts and fittings therefor; visors; binoculars; ski masks; protective helmets and goggles, parts and fittings therefor; contact lenses and containers therefor’; - Class 25: ‘Clothing, footwear, headgear’. Tom Tailor GmbH (the “opponent”) filed a notice of opposition, pursuant to Article 41 CTMR, to registration of the mark applied for in respect of all the goods based on the earlier Community figurative mark reproduced below, for the following goods: - Class 9: ‘Optical apparatus and instruments; eyewear; eyeglasses; sunglasses; lenses; eyeglass cases and sunglass cases; parts and fittings for all the aforesaid goods’; - Class 25: ‘Men’s and women’s clothing; t-shirts, shirts, jeans, pants, shorts, leather pants, chaps, sweaters, jackets, vests, skirts, dresses and footwear; articles of outer clothing’. The opposition relied on the grounds set out in Article 8(1) (a) and (b) CTMR. The opposition was rejected by the Opposition Division (OD). Afterwards, based on an appeal of the opponent, the Board of Appeal (BoA) annulled the OD’s decision and refused the Community trademark application for all the goods concerned. The BoA appeal stated that the goods covered by the earlier trademark were either identical or similar and the marks were visually similar and aurally and conceptually identical. The applicant brought an action



alleging infringement of Article 8(1) (b) CTMR and challenging the conclusion of the BoA, initially, that the goods in question were similar or identical; subsequently, that the signs at issue were visually, aurally and conceptually similar; and, lastly, that there was a likelihood of confusion between the marks at issue.

Procedural issues: As to the admissibility issue, annexes A10 to A13 to the application were submitted for the first time before the General court (GC), and not during the proceedings before the Office. Since such evidence is contrary to Article 135(4) of the Rules of Procedure of the GC, these annexes were not found admissible (Para. 17 and 18). The applicant further submitted certificates showing that its representatives are members of the Bar, however, not translated to the language of the case. The GC found these certificates admissible, since they are not documents supporting written pleadings and therefore do not need to be translated in accordance with the Article 135(3) of the Rules of Procedure. The GC must verify on its own motion if the parties are properly represented; for such purposes the translation into the language of the case is not necessary (Para. 22).

CTMA



Earlier mark





Case law



SUBSTANCE: The relevant public in the present case consists of both professionals and the general public. The relevant public's degree of attention is higher than average for some of the goods in Class 9. The GC found the goods in Class 25 of the contested trademark to be identical with the goods covered by the earlier mark. In regards of the goods in Class 9, GC found the majority of the goods identical to goods covered by the earlier mark. In respect of "protective ... goggles" The GC did not agree with the argument of the BoA stating that these goods are identical to the "optical apparatus and instruments" covered by the earlier trade mark: the latter category, according to the GC, covers goods which are far more technically complex than spectacles, such as microscope. By contrast, the "protective ... goggles" covered by the mark applied for appear to be similar goods to the "sunglasses" covered by the earlier trade mark in view, inter alia, of the method of use and intended purpose of both categories of goods (Para. 48). The GC found that the BoA was right to conclude that the "visors; ... ski masks; protective helmets ..., parts and fittings therefor" in Class 9 covered by the mark applied for were similar to the "articles of outer clothing" in Class 25 covered by the earlier trade mark. The GC highlighted that the classification of goods and services under the Nice Agreement is intended to serve exclusively for administrative purposes. Goods may not therefore be regarded as being different from each other solely on the ground that they appear in different classes: the benchmark is whether, from the relevant public's perspective, the goods in question may have a common commercial origin (PiraÑAM diseño original Juan Bolaños, T-443/05). Furthermore, these two categories of articles are closely connected because of their producers, points of sale and purpose. The GC concluded that the majority of the goods covered by the marks at issue are identical and the rest are similar (Paras. 51 to 53). When comparing the signs, the GC found the signs, despite some slight differences between them, visually similar. The overall impression is determined, according to the GC, by the capital letter 'T' and the oval which surrounds it. On the contrary, the graphic stylisation of the signs is clearly secondary and

requires a detailed examination on the part of consumers which is unlikely considering that the mark, when placed on goods at issue, is usually relatively small and that the marks concerned are single-letter signs (Para. 62 and 63). GC found, in line with the Board of Appeal, that the marks are orally identical and rejected the applicant's argument that consumers will inevitably make the connection between the sign and the name of the company which owns the brand since such a factor has no bearing on the aural impression conveyed by the marks as filed (Para. 72). In regards of conceptual similarity, GC stated that it is not possible to compare the signs at issue conceptually, since it was not established that the capital letter 'T' had a particular meaning in one of the languages of the European Union; nor it was indicated what concept would be conveyed by the capital letter 'T' in the present case (Para. 81). The question whether an individual letter of the alphabet may convey a concept in general has, however, still not been unambiguously answered. The GC concluded that the signs are highly similar for the relevant public (Para. 84). Finally, the GC found that the BoA was right to find that the impression of the marks at issue likely to be retained by the relevant public would be largely determined by their memory of a capital letter 'T' inside an oval (Para. 90). Further, the degree of similarity between the signs and the degree of identity or similarity between the goods concerned are such that there is a likelihood of confusion even in the event that the relevant public has a high level of attention (Para. 92). Lastly, even if it is accepted that the earlier trade mark has a weak distinctive character, the degree of identity and similarity between the goods and the degree of similarity between the marks are, considered cumulatively, high enough to warrant the conclusion that there is a likelihood of confusion (Para. 96).



Case law

Case T-300/12; Lidl Stiftung & Co. KG v. OHIM (FAIRGLOBE / GLOBO PORTUGAL et al); Judgement of 8 October 2014;
Language of the case: EN

RESULT: Decision annulled

KEYWORDS: Relative grounds, Request for proof of use, Extent of use, Invoice, Sales figures, Similarity of signs, Similarity of goods and services, Likelihood of confusion

FACTS: The registration was sought for a figurative sign reproduced below, for the goods in Classes 29 and 30. An opposition was filed by A Colmeia do Minho Ld^a, based on two earlier national marks: (i) Portuguese word mark GLOBO, registered in 1996 for goods in Class 29; and (ii) Portuguese word mark GLOBO registered in 2001, inter alia, for goods in Classes 29 and 30. The opposition relied on the ground set out in Article 8(1) (b) CTMR. At the applicant's request, the opponent was required to provide proof of genuine use of the earlier trademarks in accordance with the Article 42 (2) and (3) CTMR. The opponent referred for this purpose to six invoices provided already in its observation and did not submit any further evidence. The Opposition Division (OD) found that the genuine use of the earlier trademarks had been established for some of the goods referred to and that there was a likelihood of confusion between those marks and the mark applied for concerning the goods at issue which were identical or similar. Based on an appeal filed by the applicant, the Board of Appeal (BoA) granted the appeal in part. The OD as well as the BoA found, in relation to part of the goods, that the opponent had demonstrated to the requisite legal standard that the earlier marks had been put to genuine use in Portugal considering the sales figures contained in the invoices to be sufficient for the purposes of proof of genuine use.



CTMA



Earlier marks

GLOBO

SUBSTANCE: As regards the probative value of the six invoices, the General court (GC) highlighted the low level of legibility of those invoices and found that the BoA was wrong merely to rely on the total amounts of the invoice (Para. 39 and 45). Since proof of use must concern each good and service individually or homogeneous groups of goods and services, the BoA erred in taking into account an aggregation of sales relating indiscriminately to distinct products: "the Board of Appeal took into account the total amounts of each invoice corresponding to the aggregation of the sales figures for all the items referring to the sign GLOBO, even though the goods referred to in those invoices did not all come within the same coherent and homogeneous category of goods" (para. 49). Even if account was taken of the detailed sales figures relating to the categories and subcategories of goods, those figures amount only to hundreds of euros for each product – which is insufficient (para. 52). Although use does not have to be quantitatively significant in order for it to be deemed genuine,



Case law

it must still be proved by use which objectively is such as to create or preserve an outlet for the goods. In the present case, the sales figures were very low and therefore not enough to exclude the possibility of use that is merely token (Para. 53). It is necessary for a proprietor relying on invoices as evidence to submit a quantity of examples which makes it possible to discount any possibility of merely token use of that mark and, consequently, is sufficient to prove that it has been genuinely used (Para. 55). The submission of number of invoices may support the finding that use was sufficiently important because they were submitted 'for illustrative purposes', thus not reflecting the entirety of the sales generated over the relevant period. However in this case, since the opponent did not submit a sufficient quantity of invoices, the low volume of sales in the six invoices cannot constitute conclusive evidence of use which is not minimal at the level of actual sales. The invoices are, therefore, not illustrative of actual amounts (Para. 56). Since the six invoices prove only four specific acts of use over a period of 22 months, it cannot be concluded that there was high intensity or certain constancy over time in the use of those marks (Para. 63). Further, the nature of the goods in question cannot explain the low commercial volume demonstrated in the present case (Para. 65). The GC referred to the judgment CENTROTHERM, T-427/09, in which the GC found that invoices which showed only a low degree of use that was limited in time, even accompanied by other documents, admittedly of low probative value, did not enable the BoA to find that the evidence of genuine use was sufficient. It can be concluded, a fortiori, that in the present case the six invoices alone, demonstrating only four specific acts of use and a low volume of sales, respectively, for each coherent and homogeneous category of goods, do not make it possible to establish, to the requisite legal standard, the genuine nature



of the use (Para. 76). Based on the aforesaid, the first plea of the applicant was accepted and the GC therefore annulled the BoA's decision in that it found that genuine use of the earlier marks had been demonstrated to the requisite legal standard.

Case T-267/13; El Corte Inglés, S.A. v OHIM, Judgment of 18 September 2014, Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Relative grounds, Dissimilarity of signs, Visual dissimilarity, Phonetic dissimilarity, Conceptual dissimilarity, Weak element, Dominant element, Distinctive element, Likelihood of confusion, Beginning of mark, Number, Identity of goods and services, Relevant language

FACTS: The applicant sought to register word mark BAUSS represented below as a CTM for goods and services within Class 18, 25 and 35. The Opposition Division dismissed the opposition for all the contested goods and services. The Board of Appeal (BoA) dismissed opponent's appeal. The opponent filed an action before the General court (GC).

CTMA

BAUSS

Earlier mark (CTM) el al

BASS³TRES



Case law



SUBSTANCE: The GC confirmed that the relevant public is the average consumer of the European Union (Para. 29). The identity of the goods and services in question has been expressly recognized by the applicant (Para. 32). It is undisputed that the earlier trade mark has an average distinctive character (Para. 36). 'BASS' is not the most distinctive element of the earlier trade mark; the element 'TRES' on its verbal and numerical form is equally important from the visual perspective (Para. 42). Arguments on the weak distinctive character of the element 'TRES' are to be dismissed, it is not quite plausible that this element would be seen by consumer as indicating that these goods are addressed to children of three years old; it is even less the case as to the contested goods in Class 18 and services in Class 35 (Para. 43). Importance of beginnings of the mark shall be conciliated with overall impression of the signs (Para. 44). Even if the CTM application is aurally reproduced in a single syllable, the appearance in the earlier mark of the letter 'U' generate a notable pronunciation and intonation difference in the Spanish language (Para. 51). Phonetic differences are increased by the presence of the element 'TRES' reproduced in words and numbers in the earlier mark (Para. 52). It is not disputed that the signs are not conceptually similar (Para. 54). The important differences that exist between the signs from the visual and aural perspective, in addition to the conceptual dissimilarity, would not create a likelihood of confusion for the relevant public even when applied to identical goods and services (Para. 59).

Case T-90/13; Herdade de S. Tiago II — Sociedade Agrícola, SA v. OHIM; Judgment of 18 September 2014; language of the case: EN

RESULT: Action dismissed

KEYWORDS: Relative grounds, Likelihood of confusion, Similarity of signs, Dominant element, Figurative element, Weak element, Visual similarity, Conceptual identity, Coexistence of trademarks, Enhanced distinctiveness, Reputation, Detriment to earlier mark

CTMA



Earlier CTM, UK and BX marks



FACTS: The applicant sought to register the figurative mark shown below in Classes Classes 3, 18, 25, 28, 41 and 43. The opponent filed an opposition under Articles 8(1)(b) and 8(5) CTMR based on three earlier marks (a CTM, a UK and a Benelux trade mark) shown below and covering, among other, goods in Classes 9, 18, 20, 21, 24, 25 and 28. The Opposition Division (OD) partially upheld the opposition, rejecting the Community trade mark application under Article 8(1)(b) in respect of 'games and playthings' in Class 28 and all of the goods in Classes 18 and 25, with the exception of 'whips, harness and saddlery' in Class 18. It also rejected, on the basis of Article



Case law



8(5), the Community trade mark application in respect of 'soaps, perfumery, essential oils, cosmetics and hair lotions' in Class 3, 'gymnastic and sporting articles not included in other Classes' in Class 28 and 'sporting activities, organisation of exhibitions for sporting purposes; sporting activities, including organisation of sports competitions' in Class 41. By contrast, the opposition was rejected in respect of the other goods and services. On appeal, the Board of Appeal (BoA) confirmed the reasoning and finding of the OD.

SUBSTANCE: The General court (GC) confirmed the BoA decision. In first place, it noted that the goods in Classes 18 and 25 covered by the mark applied for and by the earlier CTM and the goods in Class 28 covered by the mark applied for and by the earlier Benelux mark are identical. The GC then confirmed the BoA's finding that the signs are visually similar to a medium degree. The GC found that the figurative element representing a polo player has an independent distinctive role in the mark applied for and that, due to its position and size it cannot be regarded as negligible in the overall impression created by that mark. The differences in the polo players as represented in the two signs do not make it possible to come to the conclusion that there is no similarity between the figurative elements in the signs at issue. In particular, the relevant consumer will distinctly identify, and remember, a polo player (Para. 34). Although the letter 'v', which is used in the mark applied for, also plays a non-negligible role in that mark, in view of its position and size, it is not, however, the dominant element. In addition, since the letter 'v' is placed in the background of the mark applied for, it has the effect of highlighting the figurative representation of the polo player (Para. 35). The signs are also conceptually identical since they both refer to the sport of polo (Para. 38). The GC confirmed the BoA's finding that the earlier marks had enhanced distinctiveness or a reputation in relation to a number of goods in Class 18 and to all the goods in Class 25 (Paras. 39-42). In a global assessment, although the figurative element of which the earlier marks consist is not inherently particularly distinctive in relation to 'clothing, footwear, headgear' in Class 25, the earlier marks have acquired enhanced distinctiveness through use in respect of those goods. By contrast, that is not

true of the 'whips, harness and saddlery' in Class 18. Thus, there is a likelihood of confusion between the signs at issue in respect of 'games and playthings' in Class 28 and in respect of all the goods in Classes 18 and 25, with the exception of 'whips, harness and saddlery' in Class 18 (Para. 43). Concerning the alleged co-existence between the signs in Portugal, even if it were established, it would apply only to a part of the relevant public, as regards the earlier Community trade mark, and would have no effect as regards the relevant public for the earlier marks registered in the United Kingdom and Benelux (Para. 46). As regards Article 8(5) CTMR, the GC confirmed the BoA's finding that the use of the mark applied for would be detrimental to the repute of the earlier marks when it comes to 'soaps, perfumery, essential oils, cosmetics and hair lotions' in Class 3, 'gymnastic and sporting articles not included in other Classes' in Class 28 and 'sporting activities, organisation of exhibitions for sporting purposes; sporting activities, including organisation of sports competitions' in Class 41. In that respect, the GC, dismissing the applicant's argument that the above services are not related, directly or indirectly, to the goods covered by the earlier marks, held that there is a certain degree of closeness between the goods and services at issue inasmuch as 'clothing, footwear, headgear' include goods relating to sport. Those goods may therefore be used in the 'sporting activities, organisation of exhibitions for sporting purposes; sporting activities, including organisation of sports competitions' covered by the mark applied for (Para. 57).



Case law



New Decisions from the Boards of Appeal

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Decision of the Second Board of Appeal of 26 September 2014 in case R 492/2014-2 (EN)

Opposition – Article 8(1)(b) CTMR - Rule 80(2) and 82(2) CTMIR - communication 'by electronic means' is 'incomplete or illegible' - evidence of use filed on CD-ROMs which were found to be unreadable



The CTM applicant sought to register the figurative mark .

The opponent filed an opposition pursuant to Article 8(1)(b) CTMR based on various trade marks.

The opponent submitted evidence of use of its opposing marks filing two CD ROMs containing exhibits. However, on their reception at the Office, the discs were found to be

damaged and hence unreadable.

The Opposition Division rejected the opposition on the basis that no evidence of use had been filed within the set time-limit pursuant to Article 42(2) and (3) CTMR and Rule 22(2) CTMIR.

The opponent filed an appeal against the contested decision and requested that the Board allow the opposition to proceed.

The Board found, contrary to the contested decision, that Rule 80(2) and 82(2) CTMIR states that where a communication 'by electronic means' is 'incomplete or illegible, or where the Office has reasonable doubts as to the accuracy of the transmission, the Office shall inform the sender accordingly and shall invite him, within a period to be specified by the Office, to retransmit the original by telecopy or to submit the original...'. Since, however, the Opposition Division failed to comply with this obligation, it was in breach of the Regulation.

Consequently, the Board upheld the appeal and remitted the case to the Opposition Division for further prosecution. The Board also ordered the reimbursement of the appeal fee.

Decision of the First Board of Appeal of 11 September 2014 in case R 2139/2013-1 (EN)

Opposition – Article 8(1)(b) – Article 42(2) – proof of use by evidence of reports, certifying a service performed

The applicant sought to register the word mark 'GIH', for goods and services in Classes 16 and 42.

The opponent filed an opposition on the basis of Article 8(1)(b) CTMR based on several Community trade marks comprising the name 'GIA' registered, inter alia, for goods and services in Classes 16 and 42. The applicant requested the opponent to



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furnish proof of genuine use of the earlier marks pursuant to Article 42(2) CTMR.

The Opposition Division rejected the opposition because, even though the goods and services were found to be identical or similar, no likelihood of confusion existed. As to the proof of use, the Opposition Division ruled that the evidence, namely the invoices and grading reports, submitted by the opponent showed genuine use of the earlier marks only in relation to 'printed matter' in Class 16 and 'gemological services, namely, grading precious gems and registering precious gems' in Class 42.

The opponent filed an appeal against the contested decision concerning the likelihood of confusion under Article 8(1)(b) CTMR but not expressly on the proof of use assessment under Article 42(2) CTMR. Therefore, the opponent did not dispute the contested decision insofar as the earlier marks were only put to genuine use in relation to parts of the goods and services in Classes 16 and 42. However, the applicant disputed these findings and pointed out deficiencies in the evidence.

The Board stated that the reports and respective invoices submitted by the opponent were headed by a sign corresponding to one of the earlier marks and that they proved use in relation to grading reports, which listed the services performed, namely the certification of diamonds. Therefore, the evidence showed use in relation to the services in Class 42. However, the evidence did not prove use in relation to 'printed matter' in Class 16. The reports merely incorporated the results of the previously commissioned services. The opponent did not show that it traded the reports as goods independently from the services.

Therefore, the Board assessed the likelihood of confusion solely on basis of the services in Class 42 which are registered for the earlier mark.



Contrary to the Opposition Division, the Board found that there was a likelihood of confusion within the meaning of Article 8(1)(b) CTMR. In conclusion, the Board upheld the appeal, annulled the contested decision and rejected the contested CTM.

Decision of the Second Board of Appeal of 6 October 2014 in case R 38/2014-2 (EN)

Opposition – Article 8(1)(b) – Article 42(2) – proof of use after the 'ONEL' judgement

The applicants sought to register the figurative mark



for goods in Classes 3 and 8.

The opponent filed an opposition on the basis of Article 8(1)(b) CTMR based on the earlier Community trade mark 'EDGE' registered for goods in Class 3. The opponent directed the opposition against part of the goods of the mark applied for in Classes 3 and 8. The applicants requested that the opponent submit proof of use of the earlier Community trade mark.

The Opposition Division partially upheld the opposition and rejected the Community trade mark application for part of the goods. It found that although the evidence submitted by the opponent was not particularly exhaustive, it was enough to establish genuine use of the earlier trade mark during the relevant period and in the relevant territory for 'shaving preparations' in Class 3.

The applicants filed an appeal against the contested decision, disputing inter alia that the opponent had provided sufficient



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evidence to prove genuine use for 'shaving preparations'.

The Board ruled that the invoices, the issue dates of which were very close together, showed that the marketing period for the products referred to in those invoices was particularly short, less than four months.

The Board also found that, considering the relevant market, use was small in terms of quantity. Further, the Board stated that the evidence lacked complementary means such as advertisements, correspondence with clients, declarations from providers, etc. The low volume of sales was not justified, or compensated for, by any other items of evidence which may have shown, for example, a higher frequency of use over a longer time period. The invoices submitted concerned a limited territorial extent (only Spain) and a low sales volume over a very short period of time (less than four months) which fell into less than the last year of the five-year period. For the whole EU this was quantitatively insignificant, given the relatively low standard price of shaving preparations in general; a significant volume of sales was usually needed in order to create and maintain an effective market share. Furthermore, the relevant public was the public at large throughout the entire EU and shaving preparations were usually sold through supermarkets. Consequently the relevant market was huge. Therefore, the Board stated that in view of the large scale of the market for these types of products, the evidence provided by the opponent as regards the extent of such use was insufficient to establish genuine use.

Consequently, the Board upheld the appeal and annulled the contested decision.

Decision of the Fifth Board of Appeal of 8 September 2014 in case R 970/2014 5 (DE)

Absolute grounds for refusal – Article 7(1)(b), 7(1)(c) and 7(2) CTMR – distinctiveness – descriptiveness – goods in Class 25.

The CTM applicant sought to register the word mark 'GREENTONGUE' for goods in Class 25, inter alia.

The examiner rejected the application under Article 7(1)(b), (c) CTMR and Article 7(2) CTMR on the ground that the trade mark was descriptive and lacked distinctiveness.

The applicant appealed the examiner's decision and requested that the Board annul the contested decision and allow the application to publication for the goods applied for.

The Board stated that this was one of the rare cases where the words were potentially descriptive in their individual components but were not descriptive as a whole. Furthermore, the word mark was distinctive.

The Board upheld the appeal and annulled the contested decision.

Decision of the Second Board of Appeal of 10 October 2014 in case R 2370/2013-2 (EN)

Absolute grounds for refusal – Article 7(1)(b), 7(1)(c) and 7(2) CTMR – distinctiveness – descriptiveness – goods and services in Classes 32, 35 and 43.

The IR holder designated the European Union to claim protection for its international word mark registration 'Lapacho' for goods and services in Classes 32, 35 and 43.

The examiner partially rejected the application pursuant to



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Article 7(1)(b), (c) CTMR and Article 7(2) CTMR on the grounds that the trade mark was found descriptive and lacking distinctive character.

The IR holder filed an appeal against the contested decision and requested that the Board annul the contested decision and allow the application to proceed.

The Board stated that it was not convinced that presently, nor at the time the IR holder claimed protection for the contested sign, the relevant general public in Spain, the English- or German-speaking Member States, or, for that matter, in any other Member State of the European Union, or the European professional public, could be deemed to be aware of the meaning(s) of the word 'LAPACHO', or would be able to make a direct and specific association between the mark applied for and the contested goods and services (see judgments of 22.06.2005, T 19/04, Paperlab, EU:T:2005:247, § 25 or of 27.02.2002, T 106/00, Streamserve, EU:T:2002:43, § 40) with the consequence that the link between the expression and the goods and services would be sufficiently close for the mark applied for to be deemed descriptive. As follows from the above, the word appeared to have entered Latin American Spanish through an Indian language. The Board received no information confirming that the sign, at the moment protection was applied for within the European Union, was known by the relevant public within the European Union, to the extent that, as the contested decision stated, the word would immediately inform at least the English-speaking public without further reflection that the goods and services were, or related to, a plant used in herbal medicine or an extract from such a plant.

Consequently, the Board did not agree with the contested decision's finding that the expression, taken as a whole, would be perceived as a meaningful one by the relevant public. Given the above, it was much more likely that the vast majority of the relevant general and professional public would

simply perceive the mark applied for as a fanciful term.

To the extent the contested decision meant that the word 'LAPACHO' might, at a later stage, gain economic relevance, even for the goods applied for in Class 30, mostly beers, non-alcoholic beverages, fruit drinks and syrups and/or for contested services, the Board noted, first, that the proprietor of the CTM 'LAPACHO' when registered for the goods and services presently contested would not be handed a monopoly to the extent that it could prevent others from entering the market with goods that contained extracts from Lapacho trees, since, as stated, descriptive use of a term would be allowed: anyone remained able to freely use the word in a descriptive way, or to manufacture and trade in goods and services that consisted of, or related to, extracts from Lapacho trees.

Second, the cited decision of the Board of Appeal (23 May 2005, R 888/2005 4, 'HIMALAYAN GOJI') was not comparable to the present case. There, the term had a clear and plain meaning in English in respect of the contested goods, which could not be said in the present case.

Third, no information was made available indicating that the mark applied for was known, if even to a very low degree, by the relevant general or professional public and that it was being used in respect of beers, non-alcoholic beverages, fruit drinks and syrups, or in respect of the related services in Classes 35 and 43. In addition, some case-law was available that confirmed that it was simply not sufficient to rely on general suppositions that the term might be used in the future (12.03.2008, T 341/06, Garum, EU:T:2008:70, § 41).

Consequently, the Board upheld the appeal and annulled the contested decision.



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Decision of the Second Board of Appeal of 25 September 2014 in case R 531/2014-2 (EN)

Absolute grounds for refusal – Article 7(1)(b), 7(1)(c) and 7(2) CTMR – distinctiveness – descriptiveness – goods in Class 9

The CTM applicant sought to register the figurative mark



which contains the words 'MAYDAY MAYDAY' for goods in Class 9, inter alia.

The examiner rejected the application under Article 7(1)(b), (c) and Article 7(2) CTMR in respect of the goods applied for in Class 9, namely 'apparatus for transmission or reproduction of sound or images' on the ground that the trade mark was descriptive and lacked distinctive character.

The applicant appealed the contested decision and requested that the Board withdraw the objections raised against the refused goods. Further the applicant requested a limitation, so that the specification relating to the refused goods would read: 'apparatus for transmission or reproduction of sound or images, not for aquatic lifesaving'.

After the restriction of the goods, not to include goods for aquatic lifesaving, the Board found no evidence that the sign at issue would be commonly used in relation to the goods 'apparatus for transmission or reproduction of sound or images' in Class 9. The Board found that the device mark as a whole was an allusive expression with a suggestive link in relation to the goods concerned. The device mark 'MAYDAY MAYDAY' would not be considered descriptive and as a whole it had a minimum degree of distinctive character.

Consequently, the Board upheld the appeal and annulled the contested decision.

Decision of the Second Board of Appeal of 11 September 2014 in case R 757/2014-2 (EN)

Absolute grounds for refusal – Article 7(1)(b), 7(1)(c) and 7(2) CTMR – distinctiveness – descriptiveness – Classes 35, 38 and 41

The CTM applicant sought to register the word mark 'BABES.COM' for services in Classes 35, 38 and 41.

The examiner rejected the application under Article 7(1)(b), (c) and Article 7(2) CTMR on the basis that the mark described a range of retail, telecommunications and entertainment services in Classes 35, 38 and 41. The examiner found that 'BABES', being the plural of 'babe', meant a 'young woman or man perceived as being sexually attractive'. Hence the mark, as a whole, which followed the structure of a domain name, informed consumers 'immediately' and 'without further reflection' that the services in question were accessed on 'an Internet site at which customers can obtain some kind of goods or services (clothing, images, videos, publications) relating to young women or men perceived as sexually attractive [sic]'.

The applicant appealed the contested decision and requested that the Board allow the mark to proceed in its entirety.

The Board found the objection to be unintelligible. It was not true to state that members of the general public would 'immediately' and 'without further reflection' make the link between 'BABES.COM' and men or women who were 'perceived as being sexually attractive'. Apart from the grammatical and semantic structure of the objection, which was highly artificial, it was not clear how it constituted a reason for refusal framed under Article 7(1)(c) CTMR. Furthermore,



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the dictionary definitions of 'babe' adduced by the examiner did not faithfully convey the meaning of the word in the eyes of English speakers. Although the Board accepted that in recent years a new meaning may have adhered to the word 'babe', it had by no means supplanted, or become on equal terms with, the more traditional acceptable terms, i.e. 'baby' or 'naive person' or as an affectionate term for a friend or a loved one. Therefore, it was impossible to maintain, even when the nature of the services was known, that a consumer would, 'immediately' and 'without further reflection', perceive the domain name 'BABES.COM' — the examiner's reasoning remained obscure on this point — as somehow relating to 'sexually attractive' people. They would be far more likely think of 'babies' or an affectionate term for a friend. There was no reason to believe that the relevant consumer, a member of the general public, would unhesitatingly jump to such a barely known interpretation of the word 'BABE', when there was nothing in the wording of the specification to prompt such an action. Even if the word 'BABE' were immediately perceived to refer to 'young men and women perceived as sexually attractive'— which, however, the Board doubted — it by no means described the nature of the services or their characteristics. The term 'young men and women perceived as sexually attractive' might describe potential customers, but it did not describe the services or characteristics thereof. The term at best alluded to 'adult entertainment', but was not descriptive of it. Finally, since the objection raised under Article 7(1)(b) CTMR was merely derived from the mark's alleged descriptiveness, this too had no foundation.

Hence, the Board upheld the appeal and annulled the contested decision.

Decision of the Second Board of Appeal of 9 September 2014 in case R 2315/2013-2 (SV)

Absolute grounds for refusal – Article 7(1)(b), 7(1)(c) and 7(2) CTMR – distinctiveness – descriptiveness – services in Class 39

The CTM applicant sought to register the word mark 'PANORMA' for, inter alia, services in Class 39.

The examiner rejected the application in respect of the services applied for in Class 39, namely 'transport' and 'travel arrangement' based on Article 7(1)(b), (c) and Article 7(2) CTMR. The examiner stated, 'PANORAMA' was a noun in many European countries with its primarily meaning being 'extensive view'.

The applicant appealed the contested decision.

The Board found the mark registrable in relation to the refused services as – although it was very clearly a suggestive word, which might allude to the fact that a journey might take place through a landscape with magnificent views - it could not be said to directly indicate a characteristic of transport or travel arrangements. To the meagre extent that 'extensive view' could be regarded as being descriptive of 'transport' or 'travel arrangement', the same applied to 'PANORAMA'. There was, therefore, no need to keep the term freely available in connection with the fact that trade mark applied for was used in respect of the refused services. The Board, therefore, also found that the trade mark applied for was capable of distinguishing the origin of the relevant services. It was to be expected that the relevant public would perceive the sign, in relation to these services, as a commercial indication, and not exclusively as a message concerning an important characteristic of the services.

The Board upheld the appeal and annulled the contested decision.



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Decision of the Second Board of Appeal of 17 September 2014 in case R 2365/2013-2 (EN)

Opposition – Article 8(1)(b) CTMR – IP Translator case

The CTM applicant sought to register the figurative mark

AT-20

for goods and services in Classes 18, 25 and 35.

The opponent filed an opposition pursuant to Article 8(1)(b) CTMR based on several earlier rights for Classes 18 and 25.

The Opposition Division partially upheld the opposition and rejected the contested trade mark for part of the goods in Classes 18 and 25. Further, it considered that the application could proceed for the remaining goods applied for in Class 25, not expressly specified in the contested CTM, namely the following: 'boot uppers; fittings of metal for footwear; footwear uppers; hat frames [skeletons]; heelpieces for footwear; heelpieces for stockings; heels; non-slipping devices for footwear; ready-made linings [parts of clothing]; shirt yokes; studs for football boots; tips for footwear; welts for footwear'.

The applicant filed an appeal against the contested decision and requested that the Board reject the opposition. The opponent filed an ancillary appeal according to Article 8(3) BoA-RP.

The Board upheld the ancillary appeal and annulled the contested decision to the extent that it accepted or refused the CTM application in respect of goods that were not expressly specified in the contested CTM application.

Decision of the First Board of Appeal of 17 September 2014 in case R 45/2014-1 (EN)

Cancellation proceedings – Article 8(1)(b) CTMR - procedural issues – suspension due to request for revocation; excessive amount of evidence

The CTM proprietor registered the figurative mark

PROTOCOL

The cancellation applicants filed a request for a declaration of invalidity against the CTM based on Article 53(1)(a) in conjunction with Article 8(1)(b) CTMR, and Article 53(1)(c) in conjunction with Article 8(4) CTMR. The request was based on several earlier rights.

The Cancellation Division rejected the declaration of invalidity on the ground that the cancellation applicants had failed to prove use of their earlier marks.

The cancellation applicants filed an appeal and requested that the Board annul the contested decision. At the same time, the cancellation applicants launched revocation proceedings against the CTM proprietor's mark and requested that the Board suspend the current invalidity and appeal proceedings.

The Board found that the cancellation applicants, who had lost at first instance and appealed before the Board, could not obtain that the invalidity (and appeal) proceedings be suspended on the ground that they had just applied for the revocation of the same CTM. The question of the CTM's validity had to take precedence over the question of whether that CTM might continue to stay on the Register. Also, the notion of evidence being 'complementary' - thus admissible at the appeal stage - required a reasonable proportion between what was filed/proved at first and second (appeal) instance: there was no such proportion when a party submitted less than 20 pages at first instance and 1 500 at the appeal stage or proved 5% of



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the requirement about time of use at first instance and the remaining 95% at the appeal stage. Submitting an excessive amount of evidence at the appeal stage was contrary to the good faith and correctness that should inspire the behaviour of parties in proceedings before the Office.

The Board dismissed the appeal and ordered the cancellation applicants to reimburse the CTM proprietor's costs.

Decision of the Third Board of Appeal of 7 October 2014 in case R 1864/2013-3 (EN)

Registered Community Design – invalidity proceedings – Article 5 CDR – lack of novelty – evidence, Amazon webpage, AutoCAD – disclosure, grace period

The design holder was the holder of the registered and published Community design for 'cases for portable computers' represented, amongst others, with the following views:



The invalidity applicant filed an application for a declaration of invalidity pursuant to Article 25(1)(b) CDR on the grounds that the contested RCD was not novel with the meaning of Article 5 CDR. The invalidity applicant provided as evidence, inter alia, copies of offers on Amazon webpages.

The Invalidity Division declared the RCD invalid due to lack of novelty.

The design holder filed an appeal against the decision of the Invalidity Division and requested that the Board annul the contested decision.

The Board found that the 'date of availability' indicated on an Amazon webpage submitted as evidence was in itself insufficient to prove the date of disclosure of a prior design. However, taking into account the subsequent video reviews uploaded on YouTube and the sale of 5 000 units, there was sufficient evidence of disclosure before the RCD's priority date. The RCD holder failed to prove that he had disclosed the design within the grace period. There was no evidence as to why sales of 147 units in China and Hong Kong should have reasonably become known to the relevant trade circles in the European Union. Further, the Board noted that AutoCAD drawings did not prove creatorship.

Therefore, the Board dismissed the appeal and confirmed the invalidity of the RCD because it lacked novelty.

The Registry also recommends

Decision of the Fourth Board of Appeal of 6 October 2014 in case R 423/2014-4 (EN)

Opposition – Article 8(1)(b) CTMR – comparison of goods and services – class heading – IP Translator

The CTM applicant filed the word mark 'CLOSET' for the class heading of Class 25, namely 'clothing, footwear, headgear'.

The opponent filed an opposition pursuant to Article 8(1)(b) CTMR based on an earlier Community trade mark for the word mark 'CLOSED' registered for specified goods in Class 25.

The Opposition Division compared not only the class heading, but also all goods covered by the alphabetical list of the Nice Classification in Class 25 with the earlier mark's specified goods. As a result, the contested CTM was rejected by the Opposition Division not only for the goods the applicant



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applied for but also for others mentioned in the alphabetical list of Class 25.

The applicant filed an appeal against the contested decision.

The Board ruled that the comparison of goods as performed by the Opposition Division was incorrect because only the goods and services applied for should have been compared with those of the earlier mark.

Nevertheless, the appeal was dismissed in view of the identity or similarity of the goods and services and the high degree of similarity of the signs so that a likelihood of confusion could not be excluded.