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Up to date information on IP and OHIM-related matters

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OHIM User Satisfaction Survey to be launched during October

OHIM is committed to providing the highest quality standards to its users and has been incrementally stepping up its efforts to achieve maximum satisfaction in all areas.

Our users' point of view is paramount in all of our activities and thus user feedback is crucial to the ongoing process of improving quality for everyone. The Office's Quality Management System is based on ISO 9001:2008, an international standard whereby organisations need to demonstrate their ability to meet user expectations and establish continual improvement procedures. User feedback is one of the fundamental principles of the OHIM Quality Management System, Quality Policy and objectives of the Office.

Since 2005, the Office has been measuring levels of user satisfaction through large-scale satisfaction surveys and also through more granular and specific surveys to obtain feedback on finer details and satisfaction with concrete proceedings, decisions and handling of files. These survey results help us to shape our strategic and operational objectives.

The general user satisfaction survey 2014 will be launched during October and, like any survey, the higher the participation of users the more helpful the results will be to guide the Office's quality

strategy and future efforts. It will measure user views across a wide range of topics, such as satisfaction with OHIM's registration procedures, customer and information services, appeal decisions and complaints handling.

Users who have done business with the Office during 2014 will soon receive an e-mail with a link to a web-based, easy to navigate, questionnaire. Please help us by completing and returning the survey by the deadline for the receipt of responses which will be indicated in your personalised invitation.

The information collected in this survey is only used for statistical purposes and is in accordance with the provisions of the Law 15/99 on the Protection of Personal Data.

Readers wishing to see past annual user satisfaction surveys or specific proceedings survey results, can find them on our website at <https://oami.europa.eu/ohimportal/en/quality>



The James Nurton Interview



Professor Spyros Maniatis,
Professor of Intellectual Property
Law and Head of CCLS, Queen
Mary University of London



Professor Spyros Maniatis

What is your background?

I studied at the University of Athens and then I did an LL M at LSE. I was taught intellectual property by Bill Cornish, Gerald Dworkin and David Llewellyn. I found trade marks particularly interesting because it appears to be a straightforward subject but it's not. What I find fascinating as a civil lawyer is that everything is context- and fact-specific so you can argue whatever you need to.

After the LL M, I went back to Greece and practised tax law which I didn't like very much so I came back to London to do a PhD (supervised by Alison Firth and Gerald Dworkin) on different aspects of how trade marks function in society and economics and how this affects the way they are protected. It took me a long time to complete – it was a much more liberal environment back then. At the same time I did some work with the lawyer John Olsen on a looseleaf publication on global trade mark law and practice, and I also started teaching at Kent and then Queen Mary – where I have stayed.

My first experience of teaching was the Certificate in Intellectual Property. A number of people were avoiding it, probably because it was quite demanding and intimidating to teach IP professionals, but I was not aware of that at the time. It was a big class – about 120 people – and I suddenly realised most of them were older than I was and had very good degrees from good universities. I decided if I could teach this I could teach anything!

I started to teach trade marks from an international and comparative perspective and have been doing that for the past 25 years. Academia is like a sickness – it grows on you. IP also gives you the opportunity to pick up practical work outside – I've been doing consultancy work for a couple of law firms. It has been very useful to understand how things work in practice. It influences the way I teach. And the



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academic experience hopefully allows you to give more rounded advice.

We still teach the LLM trade mark course across the three colleges of the University of London – Kings, UCL, and Queen Mary. Sometimes students have three or four lecturers from the different colleges arguing with each other. I also teach the new Certificate in Trade Marks with Imogen Wiseman. I think it makes teaching better if there is more than one teacher.

What are your main research interests?

I'm working on the third edition of a book on the European trade mark jurisprudence. I am doing that with Alexander von Mühlendahl, Dimitris Botis and Imogen Wiseman. You have four people with very different experiences working together. It's fascinating to work with Alex in particular, because he is in many ways the man behind trade marks in Europe. He formed trade mark law, he challenged it as a practitioner, he reviewed it with the Max Planck Study, and now he has an opportunity to write about it!

I'm also doing a book on the economics of trade marks, working with a number of authors. I see it as a companion to the trade mark jurisprudence book. We're trying to come up with a toolkit that will help interpret and apply economic concepts to trade mark law. I am working with an economist,

Kokkoris, and a number of other authors, including Firth, Griffiths and Shemtov,

What have been the biggest changes in trade marks in Europe?

The whole system has become very liberalised. I use a balloon analogy: 25 years ago you had very few balloons that were very strong. Today you have many balloons which could grow and burst, or could suffocate the market place. But I'm not paranoid about the scope of trade mark protection.

There's a lot of harmonisation, which was required. IP rights are no longer barriers to trade. Many more people understand what IP is all about today – even the critics understand that there is something there called IP. There are misunderstandings on both sides of the line – it is normal for a trade mark proprietor to try to get as much protection as possible, and normal for people on the other side to try to break it down. This is what makes law move forward.

It is natural to have so many cases because everything is fact- and context-specific. Law is running after business. Look at the Court of Justice jurisprudence: the Court can't say "No" to referrals like the US Supreme Court can, so we have hundreds of cases. The Court has to adapt the basic principles as cases develop, so you only get the proper test when you see the whole body of jurisprudence on a particular issue. Now the Court I think is taking a step back and



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asking the national courts to apply the tests, rather than itself getting drawn into and deciding the cases. It might have been much simpler if in the early days the Court of Justice had said clearly “this is the test”.

The judges don’t know everything about everything. For us, trade mark law is everything but it’s not the case for everyone. A problem with specialist courts is that you have a small circle of people that think they know all there is to know about trade mark law but forget the bigger context. We risk becoming technicians, like plumbers who can only deal with one particular type of boiler. There is a bigger context – constitutional, free trade and competition – which is very important.

Because there is so much case law, lawyers don’t always understand the nuances of each case. Sometimes trade mark cases need to be argued in a more intelligent, nuanced way.

What have been the most important cases?

I think Philips was a very important case, as it addressed so many things. I think it’s unfortunate that Philips was re-examined in Lego. It discusses distinctiveness, capacity to distinguish, functionality, evidence of distinctiveness and the competition aspects that are important. The opinion of the Advocate General and the judgment are brilliant and I think the outcome was correct.

The Intel case is very important too because the Court attempts to deal with dilution in a holistic way. And the Wolf case is also important because it’s an attempt to set limits for the General Court and provide basic principles for the way forward.

If you go back and read BabyDry and Doublemint, you understand how the Court behaves: it’s the same test, it’s valid but slightly developed. You simply need to apply the test to the facts of your case. Forget about the outcomes – whether the trade mark is registered or not: that’s irrelevant for the law.

Is trade mark law now in a clear place in Europe?

At this stage we are clear about what is protectable to a great extent. The Apple Retail Store case gives us the basic principle that if you can describe it as a trade mark and if it functions as a trade mark, it is a trade mark.

What will be interesting is to see the extent of protection: there will be challenges there. There will be arguments about competition, free speech and parody as well as dilution and free ride that will keep us busy for the next five or ten years.

Looking at the freedom of speech and language elements of trade marks is very interesting. To what extent a company that has to defend its trade marks has the



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same rights as an individual attacking the property – that will be a fascinating issue from a legal perspective. There will be more cases where the concepts of dilution and free ride will be challenged.

Another area is the interface between trade marks and designs: one thing that may have an impact on IP rights is 3D printing. That could challenge basic concepts in IP. I think the market will change the way it works; and law responds to market changes, even if the principles remain the same.

What about the TMD and CTMR changes proposed?

They are sensible. Perhaps trade mark cluttering is an issue in particular industries. Perhaps we should be a bit stricter with the use requirement: setting a time threshold where use is automatically tested is not a bad idea.

What are students like today?

I became head of CCLS six years ago but continuing to teach keeps me sane. My LL M class is very international: they come from 90 jurisdictions. It's like teaching the United Nations. When they participate, you get so many different views. Teaching the Certificate is a different challenge because people come from different backgrounds, so you are discussing the application of basic principles at different levels and from diverse perspectives.

Students have become more vocal. I have students from China who participate very actively, which wasn't the case before. At CCLS, we're exploring opportunities to develop commercial and IP law around the world. We're developing a joint LL M programme in Singapore and we are looking at China and India. We have also started an LL M in Paris, which is very successful and the French academic and practitioner worlds have been very open, APRAM in particular.

On the LL M course, both in London and in Paris, we look at trade marks from an international comparative perspective. In the vast majority of cases the outcome is the same, even if the approach is different, but in some areas there is divergence and we want to look at where and why. For example, 3D trade marks: we want to have a roundtable in Paris and look at how they are dealt with in different jurisdictions and look at the practice of trade mark law to see whether there is convergence or not.

Can you tell who will become good lawyers when teaching?

Students who want to argue for the sake of arguing will not necessarily be good lawyers. You have to decide when to argue, you must develop a strategy and many alternative roadmaps.

Community Trade Mark



OHIM begins examining the list of goods and services of IRs designating the EU

From the 1st of October OHIM's change in practice identified in the fast-track change to the Guidelines, Part M [International marks](#), published on 1st of July, will come into force.

This means that, from Wednesday, OHIM examiners will now be issuing provisional refusals for International Registrations designating the EU that have been notified by WIPO to the OHIM on or after the 01/10/2014 and that contain vague terms lacking in clarity and precision, as defined in the Guidelines, Part B, Section 3, [Classification](#), and in particular to the 11 terms contained in the [Common Communication on the Common Practice of the General Indications of the Nice Class Headings](#).

These provisional refusals will set a deadline of 2 months during which the holder may submit observations further specifying the vague terms to make them clear and precise (appointing a representative before OHIM where applicable), or respond via WIPO using the MM6/MM8 forms to limit the specification by removing the terms objected to.

Tools such as [TMclass](#) are available to determine whether the particular category of goods and

services needs this further specification or not. TMClass is a harmonised database containing terms that will automatically be accepted for classification purposes. Using these pre-approved terms will facilitate a smoother trade mark registration process.

The change in practice comes about following Case C-307/10 "IP Translator" and aims to align the practice of International Registrations designating the EU with that of direct filing CTMs.

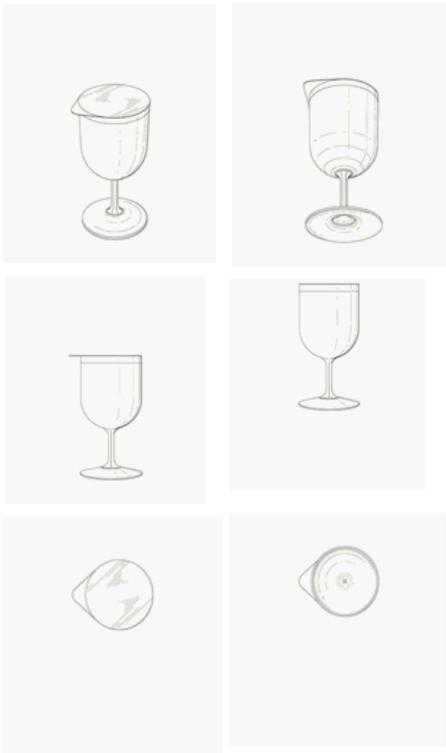


Registered Community Design



Decision of the Third Board of Appeal of 10 June 2014 in Case R 810/2013-3 (Wine Innovations Ltd / Guy Jackson-Ebben)

The contested registered Community design (RCD) was applied for on 1 April 2009 and registered for 'beverage containers' in Class 09-03 of the Locarno Classification. It is represented as follows:



An application for a declaration of invalidity was filed under Article 6 of the Community Design Regulation (CDR) on the basis of an earlier design disclosed in articles published on the Internet before the date of filing of the contested design:



The Invalidity Division upheld the application for invalidity and declared the contested RCD invalid for lack of individual character. The Invalidity Division noted that the main difference between the designs concerned the stem of the glass, which is multifaceted in the case of the contested design and apparently round in the earlier design). The Invalidity Division considered a well-known fact that 'There is a big variety of the products, thus the informed user is aware of the density or "saturation" of the state of the art in the sector concerned, and the fact that even smaller differences from the prior design can render the individual character to the RCD'. However, in this specific case, the Invalidity



Registered Community Design



Division concluded that, in view of the broad degree of freedom enjoyed by the designer when creating the design of a wine glass, the two designs will not produce a different overall impression on the informed user in view of the fact that the designs are identical in the proportions of their parts, and in the shape of bowl, lid and the base. The Invalidity Division therefore found that the only difference affecting the stem of the compared designs was insufficient to conclude that the contested RCD departs substantially from the prior design.

he RCD holder lodged an appeal which was dismissed by the Third Board of Appeal.

The disclosure of the earlier design, within the meaning of Article 7 CDR, was not challenged.

The Board of Appeal observed that 'the product which the contested RCD represents is a sealed beverage container in the shape of a wine glass' (para. 17). It considered that the informed user consisted, not of the end user of such packaging, but rather of the 'the person in charge of the packaging working in the for example, wine packaging industry, and uses the container in order to fill it with beverages' (para. 17).

The Board of Appeal also noted that, if a design applied to such containers must include a number of features in order to contain liquid, to be held in one's hand, to be sealed and to allow for the ingestion of that liquid, this does not restrain significantly the

degree of freedom of the designer (para. 21).

The two designs coincide in a number of features that is, (i) a bowl having straight walls; (ii) a circular base; (iii) stem linking the bowl to the base; and (iv) a removable lid covering the bowl. They only differ as regards the shape of their stem but 'this does not affect the overall impression because it is a thin element that occupies a relatively small part of the glass' (para. 27). In other words, the overall impression left by the designs is essentially dictated by the remaining features and in particular the shape of the bowl and the base, the presence of a thin stem linking the bowl to the base, a lid and the proportions of these elements (para. 28).

Addressing the issue of the 'saturation of the state of the art', the Board of Appeal corrected the conclusion reached by the Invalidity Division. The Invalidity Division considered that many designs existed in the field of wine glasses, which is likely to impact of the informed user's capacity to discern details between designs. However, the Board of Appeal held that the relevant industrial sector was not that of 'wine glasses' but the broader field of sealed 'beverage containers'. In addition, the Board of Appeal noted that the RCD proprietor had not submitted evidence in support of the argument about a high density of the *design corpus* in the field of sealed beverage containers (para. 29).



Registered Community Design



Comments

The notion of 'saturation of the state of the art' (or crowded prior art) is relatively new in the context of disputes relating to Community designs.

The General Court held that the degree of freedom of the design is not affected by the fact that similar designs co-exist on the market and form a 'general trend' or co-exist on the registers of Industrial Property Offices (judgment of 22/06/2010, T-153/08, 'Communications Equipment', para. 58; decision of 01/06/2012, R 0089/2011-3 – 'Corkscrews', para. 27).

However, the general Court acknowledged that proof of the existence of a number of existing designs having characteristics similar to those of the two compared designs can be relevant in that it can render the informed user more attentive to details such as differences of proportions (judgment of 13/11/2012, joined cases T-83/11 and T-84/11, 'Radiators', para. 89).

As the Board of Appeal said, in order to determine which specific industrial sector is concerned by the 'saturation' of designs, the indication in the application for registration of the design (Article 36(2) CDR) should be taken into account, but also, where necessary, the design itself, in so far as it makes clear the nature of the product, its intended purpose or its function (see by analogy, judgment of 18/03/2010, T-9/07, 'Representation of a circular

promotional item', para. 56).

Moreover, the Board of Appeal recalls that the examination of requests for invalidity is restricted to the facts, evidence and arguments provided by the parties (Article 63(1) CDR). The party which claims that the prior art is crowded or 'saturated' must therefore submit evidence in support of such claim.

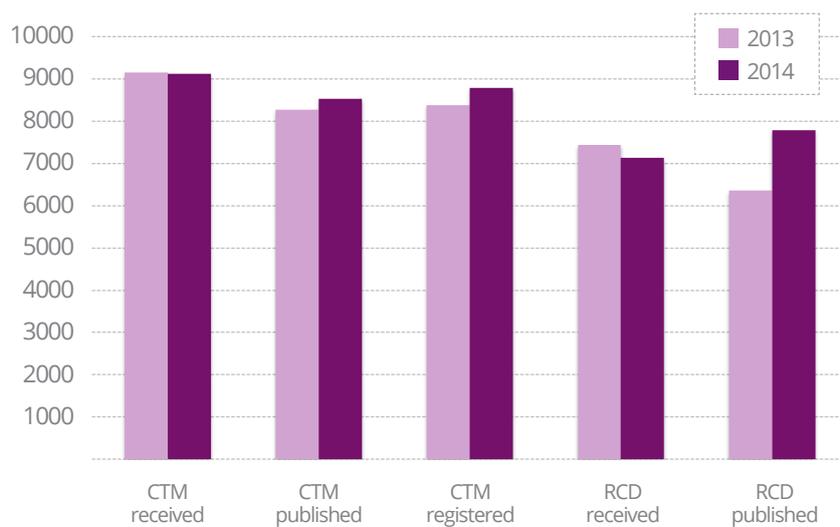


Statistical Highlights



Monthly statistical highlights September*	2013	2014
Community Trade Mark applications received	9 151	9 126
Community Trade Mark applications published	8 271	8 528
Community Trade Marks registered (certificates issued)	8 378	8 785
Registered Community Designs received	7 435	7 129
Registered Community Designs published	6 354	7 786

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





ETMDN Updates



ASEAN TMview

The new ASEAN online trademark information tool, has officially been launched on 26 August 2014 in Singapore, on the occasion of the celebration of the IPOS IP week.

The launch ceremony took place at the ASEAN IP Ecosystem Fair in the presence of Dr Michael Pulch, Ambassador of the European Union to Singapore, Mr Yih San Tan, Chief Executive of the Intellectual Property Office of Singapore (IPOS) and Chairperson for the ASEAN Working Group for Intellectual Property Cooperation (AWGIPC) and Mr Ernesto Rubio, OHIM's Special projects Coordinator.

ASEAN TMview contains more than 2.2 million trademark applications and registrations having effect in the participating ASEAN countries. These are Brunei Darussalam, Cambodia, Indonesia, Lao PDR, Malaysia, Philippines, Singapore and Thailand. It is expected that Myanmar and Vietnam will also join soon.

The ASEAN TMview interface is currently available in five languages: English, Bahasa Indonesia, Khmer, Lao and Thai. It offers the possibility for users to explore the trademark landscape in the ASEAN region in a user-friendly and powerful way.

ASEAN TMview has been developed within the framework of ECAP III Phase II, the EU-ASEAN

Project on Intellectual Property Cooperation, for which OHIM is the implementing Agency.

We invite you to visit ASEAN TMview at <http://www.asean-tmview.org/tmview/welcome.html> or through the link in [TMview](#).

Finland now part of the Harmonised Database

As of 8 September, the Finnish Patent and Registration Office (PRH) has joined the Common Harmonised Database of Goods and Services for trade mark classification.

The Finnish translations of the Harmonised Database are therefore now available to users through the TMclass application. The Swedish translations in the Harmonised Database were also accepted by PRH from 8 September. This successful harmonisation is a result of joint effort and collaborative work within the framework of the European Trade Mark and Design Network, and will further benefit users by improving predictability.

This initiative is part of the [Convergence Programme](#), which links EU IP Offices and User Associations in an effort to reach common ground in areas where Offices have different practices.



ETMDN Updates



Canada and Norway join TMclass

[CIPO – OPIC](#) (Canadian Intellectual Property Office / Office de la propriété intellectuelle du Canada) and [NIPO](#) (Patentstyret, Norwegian Industrial Property Office) have been integrated into [TMclass](#).

These latest additions bring a total of 39 national and regional IP Offices, including [OHIM](#) and [WIPO](#), into the classification of goods and services tool.

TMclass now allows users to search for terms in any of the 29 available languages, including Norwegian. The integration of [CIPO – OPIC](#) and [NIPO](#) is a concrete result of the [International Cooperation](#) programme managed by OHIM in collaboration with its international partners.

EuropeanTMDN News 3 available in 23 languages

The latest edition of ETMDN News – the newsletter of the European Trade Mark and Design Network – is now available in 23 EU languages: [BG](#) [CS](#) [DA](#) [DE](#) [EN](#) [EL](#) [ES](#) [ET](#) [FI](#) [FR](#) [HR](#) [HU](#) [IT](#) [LT](#) [LV](#) [MT](#) [NL](#) [PL](#) [PT](#) [RO](#) [SK](#) [SL](#) [SV](#)

EuropeanTMDN news is edited by OHIM and is aimed at Europe's intellectual property community. It presents a review of the Network's drive to share best practice, harmonise working methods and remove barriers from business.



More News



OHIM Impact Study released

On Friday 12 October a report on the impact of OHIM in the Valencian Community was launched at an event in OHIM. Members of the press and representatives of the business and non-profit and voluntary sector communities in Alicante attended the event.

The report, carried out by the Alicante Chamber of Commerce, analysed the social as well as the economic impact of OHIM in the area. The report indicates that in 2013, OHIM's direct and indirect impact on regional output was around 323 million euro. The Office's contribution to the GDP of the Valencian Community amounted to 184 million euro in 2013, an increase of 26% from 2009.

On a social level, for 93% of those questioned, OHIM reflected a very positive image of the EU and the EU institutions. [Link to the report](#)

Optimising our TM efilng

The OHIM website programme board has approved the release of an optimised TM efilng. The release comes after a period of sustained testing and system checks, to ensure the best possible performance for our users.

The system was available from Monday, August 18, and represents the biggest change to the OHIM website since its launch in December 2013.

The new streamlined efilng is more stable and reliable than the previous application and has parallel service systems, which will ensure maximum availability.

We believe our new efilng will improve our users' registration experience. For more information on our OHIM website, visit '[Inside OHIM online](#)', our single entry point for news, tutorials and much more.

95 years of the Industrial Property Office of the Czech Republic

The Czech Industrial Property Office began life in May 1919, with the establishment of the national patent office in Prague.

To mark the 95th anniversary of the Industrial Property Office of the Czech Republic, a major conference entitled "Protection of Intellectual Property in Europe", was held in Prague on 9 September. A full range of international speakers included the Director General of the World Intellectual Property Organisation (WIPO), Francis Gurry, OHIM President António Campinos and Benoît Battistelli, the President of the European Patent Office (EPO).



More News



Now available: double electronic signature for joint requests in oppositions

No more attachments and no scanning needed, OHIM's double electronic signature for joint requests can help you save time. If you are involved in an [opposition](#), you and the other party can electronically submit a joint request to OHIM to ask for a change in the proceedings.

Even in an opposition process, the two opposing parties may agree on certain issues. Very often, the two parties agree on matters such as the extension of the cooling-off period or the extension of time limits. In other cases, they would like to request a suspension of the proceedings or even extend this suspension. According to OHIM's legal practice, when this type of request is submitted by the two parties and the request observes the established time limits, it is accepted by the Office.

However, until the new website was launched, the party submitting the request electronically also had to attach two manuscript signatures. This can now all be done electronically.

This change makes the process simpler. First, you do not have to ask the other party to send you a manuscript signature. Second, you do not have to juggle with any attachments or scan any

documents. One click and your request for joint signature is sent to the other party.

With the double electronic signature, data does not need to be keyed in at OHIM, so the Office can deal with your request swiftly.

For further details and explanation please refer to our website's News dated September 09, 2014 at <https://oami.europa.eu/ohimportal/en/web/guest/news/-/action/view/1460120>



Case law



Luxembourg trade mark and design news

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

Case C-420/13; Netto Marken-Discount AG & Co. KG v Deutsches Patent- und Markenamt, Preliminary ruling of 10 July 2014, Language of the case: DE
KEYWORDS: Nice Classification, Preliminary ruling, Retail services, Admissibility.

FACTS:



On 10 September 2011, Netto Marken-Discount filed the German trade mark application for *inter alia*, retail services in relation to “services, particularly services provided by retail stores, wholesale outlets, through mail order catalogues or by means of electronic media, for example websites or television shopping programmes, in relation to the following services: in Class 35: Advertising; business management; business administration; office functions; in Class 36: Issue of vouchers or tokens of value; in Class 39: Travel arrangement; in Class

41: Entertainment; in Class 45: Personal and social services intended to meet the needs of individuals” in Class 35. The German Patent and Trademark Office (DPMA) rejected the application for Class 35 on the basis that the services in that class could not be clearly distinguished from other services in either their substance or scope. Netto Marken-Discount brought an action for annulment of that decision before the German Federal Patent Court (*Bundespatentgericht*). The German Federal Patent Court referred three questions to the European court of justice (CJ) concerning the interpretation of Article 2 TMD. By the first question, the referring Court asks whether “retail services for services” could fall under the concept of “services” in the meaning of Article 2 TMD. By its second question, the German Federal Patent Court asks whether Article 2 TMD requires that a trade mark application for retail services must identify specifically and precisely both the services rendered which constitute the retail service and the services to which the retail service refer. The third question seeks guidance whether the retail services extend even to services provided by the retailer itself.

SUBSTANCE: The CJ considered the third question inadmissible as it relates to the scope of protection conferred by a trade mark and bears no relation to the issue in the main proceedings. As regards the first two questions, the CJ replied as follows: 1) Services rendered by an economic operator which consist in bringing together services so that the



Case law



consumer can conveniently compare and purchase them may come within the concept of 'services' referred to in Article 2 of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (Para. 40). 2) Directive 2008/95 must be interpreted as imposing a requirement that an application for registration of a trade mark with respect to a service which consists in bringing together services must be formulated with sufficient clarity and precision so as to allow the competent authorities and other economic operators to know which services the applicant intends to bring together (Para 53).

Case C-126/13, BSH Bosch und Siemens Hausgeräte GmbH v OHIM, Judgement of 10. July 2014, Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Absolute grounds, Descriptive element

FACTS: The General court (GC) confirmed (T-625/11, BSH Bosch und Siemens Hausgeräte GmbH / OHIM, (ecoDoor), 15 January 2013) the refusal of the mark ecoDoor for goods in Classes 7, 9 and 11. According to the GC, a sign that is descriptive of a characteristic of a component incorporated in a product can also be descriptive of the product itself. That is the case

where, from the perception of the relevant public, the characteristic of the component described by the sign could have a "significant impact on the essential characteristics of the product itself". Thus the sign **ecoDoor**, which describes the ecological qualities of doors, is descriptive in respect of products equipped with doors, such as dishwashers, washing machines, vending machines, apparatus for cooking etc. The CTM applicant claimed an infringement of article 7(1) (c) CTMR.

SUBSTANCE: The European court of justice (CJ) dismisses the appeal. It held that a characteristic of a part of the product is susceptible to fall within Article 7(1) (c) CTMR, if it is "the specificity of an equipment of a product which constitutes a significant property of this product" (para. 24). In this case, the GC had observed that the quality of doors have a "decisive importance" for the goods for which the CTM application was rejected (Para. 25). The GC did therefore not make any error in law when holding that the sign is descriptive since it is descriptive of an equipment, which in the perception of the public, is likely to have "a significant impact on an essential characteristic of the product itself" (Para. 27).

Case C-535/13; Honda Giken Kogyo Kabushiki Kaisha v. Maria Patmanidi AE, Preliminary Ruling Order of 17 July 2014.

KEYWORDS: Preliminary Ruling, Infringement,



Case law



Proprietor consent, Right of defence, Agreement

FACTS: HONDA is the owner of national and community trade marks for its products, mainly cars. Honda sued Maria Patmanidi AE in front of the *Monomeles Protodikeio Athinon* (first instance court in Athens sat by a single judge). HONDA claims that this company imports to Greece authentic cars manufactured by Honda in Thailand that are targeted at the Asian market. This parallel import is infringing HONDA's exclusive right. The *Monomeles Protodikeio Athinon* questions the Case-Law on parallel imports based on the judgment in case *Silhouette International Schmied* (C-355/96, EU:C:1998:374), in particular wonders if this Case-Law is applicable in spite of the entry into force of Articles 101 and 102 TFUE. The questions were and therefore referred by the Greek court to the European court of justice (CJ).

SUBSTANCE: The CJ reminds that its substantial Case-Law on parallel imports remains unchanged. When the products have never been put into the market with the consent of its trademarks owner this one can oppose it. Articles 101 and 102 of the TFUE have not changed the interpretation of Article 7 of Directive 89/104 or 13 of the CTMR. In relation with the TRIPS agreement the Court held that the Treaty did not contain rules on exhaustion of rights as stated in Article 6 of the TRIPS. In conclusion the Court answered the national Court that Articles 5 and 7 of Directive 89/104 and Articles 9 and 13 of

the CTMR must be interpreted in the sense that the owner of trade mark may oppose the first place into the EU market if its products holding its trademarks have been done so without his consent.

Case C-421/13; Apple Inc. v Deutsches Patent- und Markenamt, Preliminary ruling in Judgment of 10 July 2014, Language of the case: DE

KEYWORDS: Admissibility, Retail services, Distinctive element, Characteristics of the goods and services, Design, Three dimensional mark, Preliminary Ruling.

FACTS: Apple obtained from the United States Patent and Trademark Office the registration of a three-dimensional trade mark consisting of the representation, by a design in colour (in particular, metallic grey and light brown), of its flagship stores for services within the meaning of Class 35, namely for 'retail store services featuring computers, computer software, computer peripherals, mobile phones, consumer electronics and related accessories and demonstrations of products relating thereto'. Subsequently, Apple sought to extend this trade mark internationally under the Madrid Agreement. That extension was accepted in some States and refused in others. *Inter alia*, the *Deutsches Patent- und Markenamt* (German Patent and Trade Mark Office, 'the DPMA') refused the extension of that three-dimensional international trade mark to German territory on the ground that the depiction of the space devoted to the sale of the undertaking's

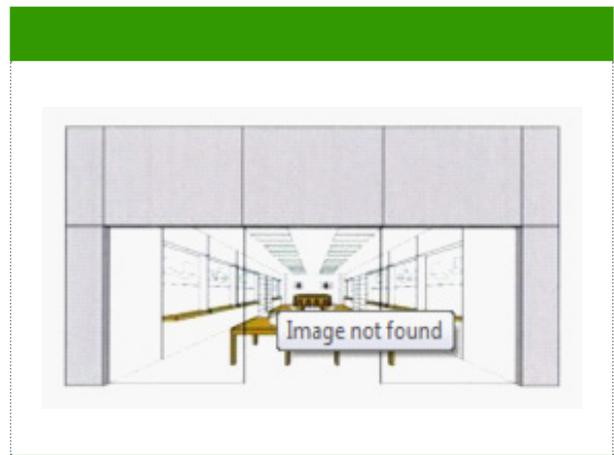


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products was nothing other than the representation of an essential aspect of that undertaking's business. The DPMA considered that while it is true that consumers may perceive the layout of such a retail space as an indication of the quality and price bracket of the products, they would not see it as an indication of their commercial origin. Besides, it considered that the retail store depicted in the case before it was not sufficiently distinguishable from the stores of other providers of electronic products. Apple appealed to the *Bundespatentgericht* court against the DPMA's refusal decision. Although that court considered that the layout depicted by the three-dimensional trade mark has features that distinguishes it from the usual layout of retail stores in that electronic sector, it decided to stay the proceedings and to refer the following 4 questions to the Court of Justice: 1-3) Whether Articles 2 and 3 of the Directive 2008/95 must be interpreted as meaning that the representation, by a design alone, without indicating the size or the proportions, of the layout of a retail store may be registered as a trade mark for services which comprise various services aimed at inducing the consumer to purchase the products of the applicant for registration and, if so, whether such a 'presentation of the establishment in which a service is provided' may be treated in the same way as 'packaging'? 4) Is Article 2 of Directive 2008/95 to be interpreted as meaning that the scale of the protection afforded by a trade mark for retail services also extends to the goods produced by the retailer itself?



Representation of a design: 'the distinctive design and layout of a retail store'



SUBSTANCE: The answer to the first to third questions: Article 2 of Directive 2008/95 does not forbid a graphic representation, such as a design, which depicts the layout of a retail store by means of an integral collection of lines, curves and shapes, from constituting a trade mark provided that it is capable of distinguishing the products or services of one undertaking from those of other undertakings (Paras. 18-20). With the exception of Article 3(1) (e) of the Directive, which exclusively covers signs for which registration is sought consisting of the shape of the goods and is thus irrelevant for the resolution of the dispute in the main proceedings, the provisions of Article 3(1) make no explicit distinction between different categories of trade mark (Linde



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and Others, C-53/01, 2003 I-03161, paragraphs 42 and 43), (Para. 24). Therefore, if none of the grounds for refusing registration set out in Directive 2008/95 preclude it, a sign depicting the layout of the flagship stores of a goods manufacturer may legitimately be registered not only for the goods themselves but also for services falling within one of the Classes under the Nice Agreement concerning services, where those services do not form an integral part of the offer for sale of those goods. Certain services, such as those referred to in Apple's application and clarified by Apple during the hearing, which consist of carrying out, in such stores, demonstrations by means of seminars of the products that are displayed there, can themselves constitute remunerated services falling within the concept of 'service' (Para. 26). The answer to the fourth question: The scale of the protection granted by a trademark for retail services manifestly bears no relation to the subject-matter of the main proceedings, which are concerned exclusively with the refusal by the DPMA to register the given sign as a trade mark. Consequently, according to the established Case-Law, a request for a preliminary ruling from a national court must be rejected where it appears to be quite obvious that the interpretation of Union law sought bears no relation to the facts or purpose of the main proceedings (see, inter alia, Cipolla and Others, C-94/04, 2006 I-11421, paragraph 25, and Jakubowska, C-225/09, 2010 I-12329, paragraph 28), therefore, the fourth question must be declared inadmissible (Para. 29-30).

Case C-490/13P; Cytochroma Development Inc. v OHIM, Order of 17 July 2014, Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Order, Likelihood of confusion, Relative grounds, Entitlement to appeal, Principle of legal certainty

FACTS: Ineos Healthcare Ltd (Cytochroma Development's predecessor in law) brought an appeal before the Office against that decision of the Opposition Division (OD). Cytochroma Development - filed a CTM application of the word sign **ALPHAREN** for goods in the pharmaceutical and veterinary fields. The opposition of Teva, the proprietor of the earlier word mark **ALPHA D3**, based on the ground that there was a likelihood of confusion, was upheld. The Second Board of Appeal (BoA) dismissed the appeal brought against the decision of the OD by the Cytochroma Development, concluding that there was a likelihood of confusion. Subsequent action for annulment brought by the Cytochroma Development before the General court (GC) was upheld in part, which resulted in annulment of the BoA decision in part. The case was remitted to the First BoA, which rendered that there was a likelihood of confusion between the marks at issue. Subsequently, Cytochroma Development raised an



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action for annulment against that decision, which resulted in its annulment by the GC on the ground that one of the members of the Second BoA that had adopted the previously annulled decision had also sat on the First BoA that had adopted the following contested decision. Although the judgment annulled the contested decision, the Cytochroma Development raised an appeal claiming that since its action was successful only in part, it has a genuine interest in bringing an appeal before the European court of justice (CJ) on the grounds of infringement of: (1) Article 65(6) of Regulation No 207/2009 and Article 1d(1) of Regulation No 216/96 regarding the measures to be taken in order to comply with the first judgment, stating that the GC should have held that the Office may carry out a new examination of a case only in exceptional circumstances and that such an examination was not justified in the present case, and 2) infringement of the principle of legal certainty and of Article 17 of the Charter of the Fundamental Rights of the European Union.

SUBSTANCE: The CJ stated that under Article 169(1) of the Rules of Procedure, an appeal is to seek to have set aside, in whole or in part, the operative part of the decision of the GC (Para. 29). If the GC annulled the contested decision in the operative part of the judgment under appeal, that annulment, which is unrestricted, therefore concerns the decision in its entirety (Para. 30). In accordance with Article 169(1) of the Rules of Procedure, an appeal could therefore only seek to challenge the annulment of the

contested decision and, accordingly, the very result sought by Cytochroma Development in bringing an action before the GC (Para. 32). The CJ held that it is clear from the analysis of the two grounds relied on by Cytochroma Development in support of its appeal that it actually seeks to challenge, not the operative part of the judgment under appeal, but certain reasons stated in that judgment, namely (i) those concerning the application of Article 65(6) of Regulation No 207/2009 and Article 1d(1) of Regulation No 216/96 and (ii) those concerning the principle of legal certainty and Article 17 of the Charter (Para. 33-34). Therefore, according to Article 181 of the Rules of Procedure, where the appeal is, in whole or in part, manifestly inadmissible or manifestly unfounded, the CJ may at any time, acting on a proposal from the Judge-Rapporteur and after hearing the Advocate General, decide by reasoned order to dismiss that appeal in whole or in part (Para. 26).

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

Case T-184/12; Moonich Produktkonzepte & Realisierung GmbH v OHIM, Judgment of 9 July 2014, Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Relative grounds, Substantiation



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of earlier rights, Non-infringement, Well-known facts need no evidence, Reputation, Right to be heard, Principle of equal treatment, Agent, Representative, Agreement

FACTS: The applicant sought to register the word mark **HEATSTRIP** for goods in Classes 9, 11 and 35. An opposition was filed pursuant to article 8(3) and 8(4) CTMR based on an earlier unregistered trade mark **HEATSTRIP**. The opponent claimed to be the proprietor of the unregistered mark **HEATSTRIP** protected in Australia, Canada, United States and United Kingdom in relation to 'heating apparatus and parts thereof; thermostats, timers and electric controllers for heating apparatus' and offered evidence regarding the use in these countries and its relation with the applicant. The Opposition Division rejected both grounds of opposition as unsubstantiated. The Board of Appeal (BoA) annulled this decision and allowed the opposition pursuant to article 8(3) CTMR. It considered that in the light of the evidence provided, the opponent owns the earlier unregistered trade mark in Australia and that there existed a fiduciary relationship between the parties. The applicant filed an action to the General court (GC), claiming an infringement of article 76 (1) CTMR, 75 (2) CTMR and 8(3) CTMR:

SUBSTANCE: The General court (GC) rejected all claims. On article 76(1) CTMR: The BoA did not infringe this provision by undertaking its own investigation as to the applicable Australian

law. According to this rule, it is in general for the applicant to provide OHIM not only with particulars showing that he satisfies the necessary conditions, in accordance with the national law of which he is seeking application, in order to be able to have the use of a Community trade mark prohibited by virtue of an earlier right, but also particulars establishing the content of that law (Para. 19 with a reference to C-263/09 "ELIO FIORUCCI"). Restricting the factual basis of the examination by the Office does not preclude it from taking into consideration, in addition to the facts which have been expressly put forward by the parties to the opposition proceedings, facts which are well known, that is, facts which are likely to be known by anyone or which may be learnt from generally accessible sources (Para. 20 with references to further Case-Law). The opponent provided information on Australian law taken from World Trademark Yearbook 2006. According to it a trade mark acquires protection in Australia, if it has acquired reputation, but do not give a definition of this term. The BoA was correct, however, in its assumption that this term corresponds to the concept of "goodwill" in the Common law systems rather than to the "reputation" in the meaning of article 8(5) CTMR. Firstly, the documents provided show rather that the requirement of the reputation is fulfilled when the mark "has come to the attention of the relevant public and has attained a level of significance in the public mind" (para 28). Furthermore, the concepts of "goodwill" and "reputation" are close terms of the Common law



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that are known to the OHIM and were interpreted by the Court (Para. 30 with a reference to further Case-Law). On article 75 second sentence CTMR in conjunction with the principle of equal treatment: The BoA was not obliged to invite the applicant to present further arguments or inform it about its preliminary assessment of the case. The right to be heard extends to all the factual and legal material which forms the basis of the decision, but not to the final position which the authority intends to adopt (Para. 37 with a reference to further Case-Law). The applicant cannot rely on the principle of equal treatment and the fact that the Board sent a communication requesting further explanations. In any event, this request concerned article 8(4) CTMR, whereas the CTM application was refused pursuant to article 8(3) CTMR. On article 8(3) CTMR, the relationship between the CTM applicant and the opponent was based on cooperation that resulted in fiduciary obligations. As regards the terms 'agent' and 'representative' as used in Article 8(3) CTMR, it must be found that those terms must be interpreted broadly, so as to cover all kinds of relationships based on a contractual arrangement under which one party is representing the interests of the other, regardless of how the contractual relationship is categorised. It is sufficient for the purposes of Article 8(3) CTMR that there be some agreement of commercial co-operation between the parties of a kind that gives rise to a fiduciary relationship by imposing on the trade mark applicant – whether expressly or implicitly – a general duty of trust and

loyalty as regards the interests of the trade mark proprietor. Nevertheless, some kind of agreement has to exist between the parties. If the applicant acts completely independently, without having entered into any kind of relationship with the proprietor, he cannot be treated as an agent for the purposes of Article 8(3) CTMR. Thus, a mere purchaser or client of the proprietor cannot be regarded as an 'agent' or as a 'representative' for the purposes of that provision, since such persons are under no special obligation of trust to the trade mark proprietor (Paras. 58, 59 with reference to T-262/09 FIRST DEFENSE). The absence of a formal distribution or agency contract signed by the parties does not exclude the existence of a de facto relationship that would be relevant within the context of Article 8(3) CTMR. A binding contractual relationship can be established by means of business letters exchanged by the parties (Para. 60). As considered by the BoA, these emails show that both parties were actively cooperating in the promotion of the product, by advertising it in brochures and exhibiting it at a fair, in order to create the best conditions for a successful marketing: the opponent supplied the material for these purposes and the applicant adapted it to the German market. The BoA was therefore correct in the assessment that the relationship between the parties on the date of the application for the CTM was more than that between the seller and purchaser, but rather a tacit cooperation agreement and lead to fiduciary obligation for the CTM applicant (Para. 67). Such a cooperation can exist even if it is not exclusive (Para.



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69) and despite the fact that the CTM applicant was not a part of the distribution structure of the opponent (Para. 70).

Case T-273/12; Unister GmbH v OHIM, Judgment of 24 June 2014, Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Absolute grounds, Slogan mark, Distinctiveness acquired by use, Relevant language.

FACTS: The applicant sought to register the word mark **AB IN DEN URLAUB** as a CTM for services within Classes 35, 39, 41 and 43. The examiner explained the meaning of the CTM applied for as “[lets go] on holidays” and emphasized, that all services are related to travelling. The Board of Appeal (BoA) confirmed the refusal of the CTM application pursuant to article 7(1) (b) CTMR and considered the proof of acquired distinctiveness filed in the appeal proceedings as not sufficient. The CTM applicant filed an action before the General court (GC) claiming the infringement of Articles 7(1) (b) and 7(3) CTMR.

SUBSTANCE: The GC rejected both claims: On

Article 7(1) (b) CTMR, the GC repeated the principles on the assessment of the distinctiveness of slogans (Paras. 17-20). In the case on file the BoA correctly assessed that the CTM consisted of German words which would be understood in Germany, Austria, Luxemburg and parts of Belgium and Denmark and Italy (Para. 21). The BoA did not express a requirement that a slogan had to be fanciful, surprising or unexpected to be registered as a trade mark, but merely stated that the word combination applied for does not have these characteristics (Paras. 22-23). As established in the Case-Law of the CJ, although the existence of such characteristics is not a necessary condition for establishing that an advertising slogan has distinctive character, the fact remains that, as a rule, the presence of those characteristics is likely to endow that mark with distinctive character (Para. 23). On Article 7(3) CTMR, the BoA was correct when requiring the proof of the acquired distinctiveness in all German-speaking countries, which means Germany, Austria, Luxemburg and parts of Belgium and Denmark and Italy (Para. 39).

Case T-520/12, Pågen Trademark AB v OHIM, Judgment of 9 July 2014, Language of the case: SV
RESULT: Action dismissed

KEYWORDS: Figurative mark, Absolute grounds, Descriptive element, Minimum degree of distinctiveness, Acquired distinctiveness through



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use, Relevant language, Complex mark

FACTS: The trade mark reproduced below was applied for in relation to, amongst others, 'Bread, biscuits, rusks, cakes, baked goods, pastries and confectionaries' in Class 30. The examiner refused the trade mark in relation to the above mentioned goods on the basis of Article 7(1)(b) and (c) and 7(2) CTMR in relation to the Swedish speaking consumers in the EU. In its appeal, the applicant raised the claim

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of acquired distinctiveness through use, Article 7(3) CTMR. The Board of Appeal (BoA) rejected the appeal as unfounded and confirmed that the sign is descriptive and without the necessary distinctive character. In addition, the BoA found that the trade mark had not acquired distinctiveness through use. The applicant filed an action before the General court (GC).

SUBSTANCE: The GC starts off by confirming that the relevant public consists of both Swedish and Finnish consumers since even Finnish consumers know Swedish (Para. 20). Furthermore, it is undisputed that the Swedish word 'giffjar' is plural for a type of croissant made from a wheat dough, and that

this word is descriptive for the relevant goods. In addition, the GC refuses the applicant's arguments that the sign as a whole, in its figurative form, is not descriptive and instead distinctive. The GC cites Case-Law where it is stated that when a composite mark consists of descriptive and non-descriptive elements, the trade mark can nevertheless be considered descriptive if the non-descriptive elements do not divert the attention of the relevant public from the descriptive message the descriptive elements convey (Para. 24). The GC also dismisses the applicant's arguments that the trade mark 'giffjar' is not descriptive for the actual product sold, which is not a croissant but instead a cinnamon roll tipped on its side. In this regards, the GC states that even if the trade mark is not descriptive for the actual product, it can still be used in relation to all goods covered by the application for which it is descriptive (Para. 29). Therefore the BoA was correct in refusing the mark under Article 7(1) (c) CTMR and there is no need to assess the case under Article 7(1) (b) CTMR. In relation to the claim of acquired distinctiveness the GC notes that it is undisputed that all evidence consists of the applied sign 'giffjar' is used in combination with the trade mark 'Pågen' (Para 41). From the evidence, it is apparent that the word 'giffjar' is used as a designation for a type of small breads. This word is, in all the product packages submitted by the applicant, used in combination with a word describing the flavour of said breads, for example cinnamon ('giffjar kanel'), vanilla ('giffjar vanilj') and chocolate ('giffjar choko').



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The evidence further shows that the word 'gifflar' is used in a descriptive way by the competitors of the applicant (Para. 44). In addition, the fact that the word 'gifflar' is always used in combination with the applicant's trade mark 'Pågen', differs in its stylisation from 'Pågen', and has a prominent position on the packages, does not mean that the relevant consumers understand the word 'gifflar' as the commercial origin of the goods. The fact that the word 'Pågen' is the company name of the applicant means that this trade mark, and not the sign 'gifflar', designates the commercial origin of the goods (Para. 45). The applicant's arguments were therefore dismissed and the claim was rejected.

Case T-204/12; Vila Vita Hotel und Touristik GmbH & Viavita v OHIM, Judgment of 14 July 2014, Language of the case: FR

RESULT: Action dismissed

KEYWORDS: Relative grounds, Likelihood of confusion, Request for proof of use, Distinctive element, Figurative element, Complex mark, Descriptive element

FACTS: The intervener sought to register the word sign **VIAVITA** represented below as CTM for Classes 36 to 45. An opposition based on an Austrian and a German earlier marks below, covering services in Classes 39 and 42 (the Austrian earlier mark)



CTM applied for

VIAVITA

Earlier CTM

VILA VITA PARC



and 3, 35, 37, 39 and 41 (the German earlier mark) was filed on the grounds of Articles 8(1) (b). The CTM applicant requested that the opponent filed proof of use of both earlier marks. The Opposition Division (OD) partially upheld the opposition on the basis of Article 8(1) (b) CTMR finding that there was a likelihood of confusion between the marks for certain services in Class 43.

The Board of Appeal (BoA) annulled the OD decision and considered that the opponent did not prove the use of the earlier signs as the forms in which the marks were used were under a form which substantially differed from the ones that were registered.



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SUBSTANCE: On the earlier Austrian mark the argument of the opponent that there was use of the essential part of the mark namely the VILA VITA element was rejected by the General court (GC). It confirmed the assessment of the BoA which held that the PARC element of the mark was not negligible, being a distinctive element not in relation with the services at stake. The GC took note that in fact the earlier Austrian mark had been used as vila vita hotel & ferierendorf Pannonia. If the element ferierendorf which means holiday village could be descriptive of the services in question it was not the case of the element Pannonia. The BoA was therefore correct in concluding that the form in which the earlier Austrian sign was used differed substantially of the form in which the mark was registered. On the earlier German mark, the GC noted that the figurative elements contained in the mark as registered (a representation of the planet Earth and phone numbers) were not taken in the mark as used, they were replaced by other figurative elements such as a butterfly, different types of palm tree leaves and other verbal elements. These changes are so that they do not allow recognizing the mark as registered. The figurative elements used are above the verbal element VILA VITA and occupy the same important place as the verbal elements. These figurative elements enjoy also a distinctive character as they do not describe the services in question. The verbal elements contribute also to modify the size of the sign and therefore change

also the appearance of the mark as registered. The fact that the element Vila Vita is also reproduced in the mark does not alter the correct conclusion of the BoA that the use of this unique verbal element is not enough. The BoA was then correct to hold that the omission of the representation of the planet Earth and the addition of figurative and verbal elements that were not in the registration substantially modified the mark as registered. As the opponent was not able to demonstrate genuine use of the mark the opposition is rejected.

Case T-1/13; Advance Magazine Publishers, Inc., v OHIM, Judgment of 4 July 2014, Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Admissibility, Relative grounds, International registration, Identity of goods & services, Similarity of signs, Visual similarity, Phonetic similarity, Principle of legal certainty

FACTS: The CTM applicant sought to register the word mark **GLAMOUR** for goods in Classes 12, 14 and 18. The opponent based its opposition on Article 8(1) (b) CTMR using the earlier international word mark **TUDOR GLAMOUR** with effect in the EU, registered for goods in Class 14. The opposition was directed against the goods in Class 14. The Opposition Division upheld the opposition. The



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Board of Appeal (BoA) dismissed the appeal, finding that there was likelihood of confusion, taking into account, the identity of the goods and the similarity of the signs. The CTM applicant appealed to the General court (GC), arguing an infringement of Article 8(1) (b) CTMR.

ADMISSIBILITY: The applicant claimed incidentally an infringement of Article 7 (1) (b) CTMR. The GC found that the applicant did not explain how this article would be applicable and said that in any case in an opposition procedure such a claim, even if it was held to be admissible, would be ineffective (Para. 15 and 16).

SUBSTANCE: The GC confirmed the BoA concerning the finding of identical goods in Class 14. It confirmed also the practice that the goods in Class 14 are targeted at the average consumers who are in view of the nature of the goods highly attentive (Para. 23-25). As far as the signs are concerned, the GC stated that both word elements of the earlier mark are equally relevant and that on account of the second word which coincides with the contested mark there is a visual and phonetic similarity which is not ruled out by the first different word in the earlier mark (Para. 31). Conceptually the GC upheld the BoA finding that for a part of the public there is no conceptual meaning (Para. 35). In a global assessment, the GC confirmed the contested decision to the extent that taking into account the identity between the goods and the visual and aural



similarities between the signs which for part of the public are not affected by any conceptual difference, there is likelihood of confusion. Under the given circumstances the GC did not consider it necessary to enter the question if the criteria in the MEDION judgement (Thomson Life) were applicable

or not (Para. 44). Finally the GC stated that the academic writings and the Case-Law of the German supreme courts have no binding effect (Para. 45-46) and the cases on which the applicant relied were not comparable to the case at hand (Para. 47 - 49).

Case T-196/13; Nanu-Nana Joachim Hoepf GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM); Judgment of 16 July 2014; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Burden of proof, Complementary evidence,

CTMA



Declaration, Evidence of use, Extent of use, Request for proof of use, Proof of use, Labels, Promotion, Sales figures, Invoices, Principle of legal certainty.

FACTS: The other party filed the CTM application for goods in Classes 16, 20 and 24. The mark was registered on 26 May 2010. On 14 December 2010, the applicant filed a declaration for invalidity based on the earlier German word mark "NANA", registered for, inter alia, goods in Classes 16, 20 and 24. The



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other party requested proof of use of the earlier German mark. The Cancellation Division rejected the application for invalidity on the ground that the applicant did not prove genuine use of the earlier mark. The appeal filed by the applicant was dismissed.

SUBSTANCE: The General court (GC) confirmed the reasoning of the Board of Appeal (BoA) as to the insufficient proof of use of the earlier German mark "NANA". The evidence submitted by the applicant consisted of two affidavits signed by an employee of a company belonging to the same group as the applicant, and various photos, including one of a Nanu-Nana shop front, and others, undated, of various goods such as folded paper boxes, albums, calendars, stickers, blocks, artists' materials, cards and other paper products, napkins, recipe books, furniture and home décor articles. The goods depicted all bear labels and stickers with the earlier mark on their packaging. The accompanying documents are not sufficient to corroborate the information given in the affidavits. In particular, the applicant did not furnish other evidence to supplement the turnover figures given in the affidavits (Para. 33). Moreover, the content of the affidavits was not sufficiently specific as regards the time and extent of use in relation to the goods covered by the mark. For example, in 2007, it is stated in the affidavits, in respect of Class 16, that the applicant sold 287 types of goods and around 9 million products, with a total turnover of approximately EUR 17 million. Apart from quantitative indications, the affidavits did not contain any additional details as regards the goods or types of goods sold (Para. 34). The statements in the affidavits relating to the turnover in respect of Classes 16, 20 and 24 did not make it possible to determine for which goods or which part of the goods in those Classes the earlier mark had been used (Para. 37). It should not have been difficult for the applicant to obtain additional documents like, for example, invoices, catalogues or newspaper advertisements (Para. 39). The 'Deitech' judgment (T-86/07) quoted by the applicant is not a valid precedent for various reasons: First, the affidavits submitted

in 'Deitech' are not comparable to those in the present case because the goods for which the mark had been used, namely footwear, were mentioned specifically in the affidavits (Para. 45). Secondly, the brochures provided in 'Deitech' confirmed the affidavits as regards the place, time and nature of use in respect of the goods concerned (Para. 46). Furthermore, as regards the alleged inability on the part of the applicant to provide other evidence, the fact that the sales slips provided to consumers and delivery notes issued by the manufacturers and suppliers of the goods did not refer to the earlier mark does not preclude the applicant from, for example, providing such documents in order to show, at the very least, the types of goods marketed and also the extent and duration of marketing of the goods. In 'Deitech', the applicant claimed that it was impossible for it to provide invoices and delivery notes to retailers because it was both the manufacturer and the retailer of its footwear, which it distributed by means of its own subsidiaries, hence the impossibility of providing delivery notes. That is not the case here (Para. 48).

Case T-404/13 NIT Insurance Technologies Ltd. v. OHIM; Judgment of 14 July 2014; language of the case: DE

RESULT: Action dismissed

KEYWORDS: Absolute grounds, Distinctive element, Free movement of goods, Principle of non-discrimination, Principle of legal certainty, Principle of legality.

FACTS: The applicant sought the registration of the CTM **SUBSCRIBE** (word) for goods and services in Classes 9, 16 and 42. The First Instance refused the application for most of the goods and services as being devoid of distinctive character (Article 7 (1) (b) CTMR). The Board of Appeal (BoA) upheld that decision.

SUBSTANCE: The General court (GC) holds that the meaning



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of the English term “subscribe” as referring to payment for consecutive issues of goods or services as for example newspapers was undisputed (Para. 23). Since the goods and services for which registration has been refused may be purchased via subscription, the consumers will consider the applied for sign as an indication on the possibility to subscribe to those goods or services (Para. 30). Although, the sign does not give further information or details on the subscription, it may not be seen as an indicator of the origin for the affected goods and services (Para. 31). The applicant indicated some similar CTMs which have been registered and argues an infringement of equal treatment. The GC refuses that argument and referred to the constant Case-Law. The BoA correctly concluded that the sign is devoid of distinctive character and consequently this finding may not be put in question because similar marks have been accepted (Paras. 47 to 49): Although, the Office must take into account the decisions already taken in respect of similar applications and consider with especial care whether it should decide in the same way or not. The way in which those principles are applied must, however, be consistent with respect for the principle of legality. Consequently, a person who files an application for registration of a sign as a trade mark cannot rely, to his advantage and in order to secure an identical decision, on a possibly unlawful act committed for the benefit of someone else. Moreover, for reasons of legal certainty and, indeed, of sound administration, the examination of any trade mark application must be stringent and full, in order to prevent trade marks from being improperly registered. Such an examination must therefore be undertaken in each individual case. The registration of a sign as a mark depends on specific criteria, which are applicable in the factual circumstances of the particular case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal. The GC dismissed also the applicant’s plea that the acceptance of certain marks and at the same time the refusal of similar marks would distort the free competition on the market and restricts the free movement of goods or services. On



the contrary, the decision of a BoA, such as that given in the present case, which rightly concludes, in accordance with the provisions of Article 7(1) CTMR, that a sign cannot be registered as a Community trade mark, cannot be regarded as constituting an obstacle to free competition, or to the freedom to provide services. The role of OHIM departments of verifying that a trade mark applied for complies with the legislation governing the registration of Community trademarks serves rather to guarantee undistorted competition than to restrict competition (Paras. 57 to 58).

Case T-66/13, Franz Wilhelm Langguth Erben GmbH & Co KG. vs OHIM, Judgment of 16 July 2014, Language of the case: DE.

RESULT: Action dismissed

KEYWORDS: Three dimensional mark, Shape of the products, Descriptive element, Admissibility of defence, General reference to previous submissions

FACTS: The applicant applied for a ‘figurative mark’ for goods in Class 33 – ‘alcoholic beverages (except beers), blackberry liqueur’. On the bottom of the bottle it is indicated “Echte Kroatzbeere’ (real blackberry liqueur). The application was rejected on the ground of non-distinctive character, Article 7(1) (b) CTMR. After appeal the Board of Appeal (BoA) confirmed the rejection. The applicant filed an action before the General court (GC).

PROCEDURE: The applicant argued that the response of the Office was not signed and should be disregarded. The GC indicated that Article 43(7) of the Rules of procedure constitutes the basis for a decision of the GC in 2011 to submit briefs electronically through e-Curia. E-Curia was used by the Office (Paras. 10-16). The GC confirms its ruling that a general reference to arguments presented in the administrative procedure cannot substitute the indication of the substantial legal arguments in the plaintiff’s action brief (Paras. 17-20).



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SUBSTANCE: The applicant applied for a 'figurative mark'. It follows however from the three-dimensional shape of the mark and the arguments put forward in regard to a bottle as a shape or packaging for the goods that a three-dimensional mark has been applied for (Paras. 21-24). The GC confirmed settled Case-Law that three dimensional marks which consist of the shape of the product itself are not necessarily perceived in the same way as marks which are independent from the shape of the product (Para. 37). In particular, in the case of a shape of a bottle distinctiveness can be conferred only if the shape departs from others available on the market (Paras. 38, 39). The shape of the bottle applied for is banal and does not depart significantly from other bottles available on the marketplace. The expression '*Echte Kroatzbeere*' (real blackberry) at the bottom of the bottle is, if noticed, perceived by the German consumers only as descriptive indication of the content of the bottle, i.e. that it is made of real berries (Paras. 42-44). Also the combination of both, the bottle and the expression '*Echte Kroatzbeere*', does not confer distinctiveness (Para. 51). The GC confirmed the discretion conferred to the Office for the arrangement of an oral hearing (Paras. 85-91). The applicant did not indicate circumstances which can be considered under the concept of misuse of powers (Paras. 92-96).

Case T-324/13; Endoceutics, Inc. v OHIM; Judgment of 16 July 2014; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Conceptual similarity, Distinctive element, Identity of the goods and services, Phonetic similarity, Relative grounds, Relevant language, Relevant territory, Request for proof of use, Similarity of the signs, Visual similarity, Weak element

FACTS: The applicant sought to register the word mark



CTMA



FEMIVIA as a CTM for "pharmaceutical preparations for the prevention and treatment of medical conditions related to the menopause" within Class 5. An opposition based, inter alia, on the earlier international registration of the figurative mark represented below, registered for "pharmaceutical preparations" and other goods in Classes 5, 29 and 30, was filed on the grounds of 8(1)(b) CTMR. The Opposition Division rejected the opposition in its entirety due to lack of likelihood of confusion (LOC), insofar as the similarity of the signs was based on the prefix "femi" which is weak for the goods at issue. The Board of Appeal (BoA) upheld the opponent's appeal. The applicant filed an action before the General court (GC).

SUBSTANCE: The GC rejected the applicant's complaint that the opponent should have proven use of the earlier CTM, reminding that the BoA based its examination of LOC on the earlier international registration (IR) of a figurative mark, which was not under obligation of use (Para. 17). The applicant's criticism regarding the relevant public did not prosper; the GC pointed out that since the marks cover all EU Member States, examination should not be limited to the English-speaking public. It also reiterated that the principle according to which registration of a mark can be refused if an absolute ground for refusal exists only in part of the EU also applies by analogy to relative grounds. The BoA was therefore entitled to restrict assessment to the Spanish-speaking portion of the public for reasons of procedural economy (Paras. 26-27). The GC found



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that, in the context of the goods covered by the mark applied for, the prefix “fem” will be understood by the relevant public as an abbreviation of “femenino”, which describes the intended purpose of the goods in question. The prefix thus has a weak distinctive character for those goods; however, such elements may hold an autonomous position in the overall impression created by a mark and therefore account should be taken of the conflicting signs as a whole (Paras. 33, 35-36). The BoA’s conclusions regarding the average degree of visual similarity and the high degree of phonetic similarity between the signs were confirmed by the GC (Paras. 39 and 41). However, the finding that the conceptual comparison is neutral was not upheld: the GC ruled that because of the element “fem” (which evokes the words “femenino” and “femina”) and the elements “ivia” and “ibion” which lack meaning for the relevant public, the signs should be regarded as conceptually similar to a certain degree (Para. 43). In view of the identity of the goods, the similarity of the signs on all levels of comparison and the normal inherent distinctive character of the earlier IR, the GC confirmed LOC (Paras 46 et seq.). Finally, the GC pointed out that the fact the relevant public will be more attentive to the identity of the producer or provider of the goods it wishes to acquire does not mean, however, that it will examine the mark before it in the slightest detail or compare it in great detail to another mark (Para. 48).

Cases T-686/13 and T-687/13; *Unibail Management v. OHIM (Four stars and Five stars)*, Judgement of 3 September 2014, Language of the case: FR

RESULT: Action upheld

KEYWORDS: Lack of reasoning, Substantial procedural violation, Absolute grounds, Distinctive element, Figurative element

FACTS: The Board of Appeal (BoA) confirmed that the two CTMAs lacked distinctiveness to the extent that they would be



perceived by the public at large and the professional public as a badge of guarantee that all G&S are of such a quality that they would comply with a “four star” label or the highest quality standards or have a high degree of prestige.

SUBSTANCE: The Case-Law recognises the possibility for

CTM applied for

FEMIVIA

Earlier CTM

femibion

the Office to use only general reasoning for all of the goods and services concerned where the same ground of refusal is given for a category or group of goods or services. The General court (GC) however considers that this possibility is exclusively limited to the circumstance in which the G&S are homogeneous (Para. 15 and 26). This is not the case as far as G&S in Classes 16, 35, 36, 38, 41 and 42 are concerned (Para. 21). The BoA erred in failing to provide an adequate statement of reasons in relation to the lack of distinctive character of the signs at issue for each homogeneous category of the goods and services, apart from those in Class 43 (Para. 23). According to the GC, the BoA violated the essential requirement for any decision to be subject to judicial review. In particular, the GC is not in a position to assess the reasons why the BoA found that the CTMAs would be perceived as a badge of compliance



Case law



with a “four star” label in respect of printed matters, financial services, or the service of rental of access time to global computer networks. Without making a distinction between the different categories of G&S, it is impossible to assume that the perception of the signs would be the same. This is because the lack of distinctive character cannot be the object of presumptions (Para. 26). Finally, the GC rebuts the relevance of past judgments cited by the Office in which the GC suggested that global reasoning could be appropriate where the general message conveyed by the signs is susceptible to be perceived equally in respect of all G&S (Para. 27). The decision of the BoA is thus annulled insofar as G&S in Classes 16, 35, 36, 38, 41 and 42 is concerned. The refusal of the CTMA in respect of the services in Classes 39 and 43 has become final since it was not challenged before the GC.



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CTMA 1 (Classes 16, 35, 36, 38, 41 and 42)

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CTMA 2 (Classes 16, 35, 36, 38, 41 and 42)

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Case law



New Decisions from the Boards of Appeal

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

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

Decision of the Fifth Board of Appeal of 28 July 2014 in case R 1998/2013-5 (EN)

Opposition proceedings – Article 8(1)(b) and 8(5) CTMR – Comparison of goods in Classes 24 and 8 – Definition of unfair advantage and the inapplicability of the 'WOLF' judgment (concerning dilution) to an unfair advantage claim

The CTM applicant sought to register the word mark 'TIFANY', for goods and services in Classes 8, 16, 21, 24, 28 and 40.

The opponent filed an opposition on the basis of Article 8(1)(b) and (5) CTMR based on several earlier rights.

The Opposition Division upheld the opposition for all the contested goods and services. It concluded that the contested goods in Class 24, inter alia, household linen; table runners, coasters (table linen); table linen (textile), table cloths not of paper, etc. were dissimilar to the opponent's goods in Class 8, inter alia, cutlery, tableware, etc. and rejected the opposition as far as it was based on Article 8(1) (b) CTMR. As to Article 8(5) CTMR, the Opposition Division held that the contested mark would unfairly take advantage of this luxurious image, which, as the opponent claimed, might be transferred to these goods, as the public were likely to make a link between the signs.

The applicant filed an appeal in which it requested that the Board reject the opposition and annul the contested decision in its entirety. In the statement of grounds, it argued that the Opposition Division was right to consider the goods in Classes 24 and 8 dissimilar. As to Article 8(5) CTMR, however, the applicant claimed that the Opposition Division's assessment, carried out under Article 8(5) CTMR, lacked an assessment of whether use of the mark applied for would have an impact on consumers' behaviour.

The Board found, contrary to the contested decision, that the applicant's goods in Class 24 and the earlier goods in Class 8 were similar to a low degree. Those goods were, to a certain degree, complementary considering that they could be used together



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such as to match one another in a particular style. Furthermore, since they were essential for preparing a table in order to eat a meal, they shared this final purpose and satisfied the same general needs. They also might be sold together and they were likely to be found in the same outlets. They could coincide in producers and they often shared distribution channels albeit they differed in nature and method of use. Therefore, the Board upheld the opposition for these goods also on the basis of Article 8(1)(b) CTMR.

With regard to Article 8(5) CTMR, and with reference to the applicant's argument that the Opposition Division's assessment made under Article 8(5) CTMR lacked an assessment of whether the use of the mark applied for would have an impact on consumers' behaviour, the Board pointed out that since the opposition was upheld on the ground of Article 8(5) CTMR not on the basis of detriment to distinctive character (dilution) but on unfair advantage taken of the earlier mark's reputation (free-riding), the alleged factor of consumers' behaviour remained irrelevant for the case at hand. In fact, the applicant overlooked the fact that the Opposition Division only decided that the contested CTM would take unfair advantage of the luxury image of the opponent's earlier mark which might be transferred to these goods. The Opposition Division did not decide upon the possible detriment to the earlier mark's distinctive character. This latter point was only discussed once in the 'WOLF' judgment cited by the

applicant. The decision referred to, therefore, had no impact on the question of misappropriation.

Consequently, the Board dismissed the appeal and confirmed the contested decision.

Decision of the Fifth Board of Appeal of 30 July 2014 in case R 2256/2013-5 (EN)

Opposition proceedings – Article 8(4) CTMR – Proof of national German law

The applicant sought to register the word mark '(+) ENERGY', for goods and services in Classes 3, 9, 14 and 35.

The opponent filed an opposition on the basis of Article 8(4) CTMR based on a non-registered German trade mark.

The Opposition Division partially upheld the opposition and rejected the CTM application for some goods and services. It concluded that the opponent's signs were used in the course of trade of more than local significance in Germany for different types of jewellery, before the filing date of the contested trade mark. According to the Opposition Division, the opponent had acquired the right to prevent the use of a subsequent trade mark under the conditions of German law.

The applicant filed an appeal in which it requested



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that the Board reject the opposition and annul the contested decision in its entirety. In the statement of grounds, it argued, inter alia, that the opponent had failed to show that the extent of use of the mark in Germany would qualify it as sufficient under national law to afford it unregistered rights in that territory. The opponent filed no case-law evidencing that use of the mark made by the opponent in Germany would be sufficient to prevent use of later conflicting marks. The Opposition Division did not conduct its own in-depth research in relation to national law and it submitted that it could not have the requisite knowledge of German law to enable it to come to a decision as regards whether use of the mark 'ENERGETIX' would be considered to have conferred unregistered rights on the opponent in that territory.

The Board found, contrary to the contested decision, that there were grave deficiencies in the presentation of the national provision which formed the opposition's legal basis. Firstly, the opponent failed to cite, either in whole or in part, the relevant national provisions it sought to invoke; it did not even provide a summary of these provisions. The mere reference to the section headings 4(2), 14(2) and 12 of German Trade Mark law did not allow one to know about the scope of protection granted to an unregistered mark and in what conditions it might prohibit the use of a later mark. Secondly, the opponent did not cite any national case-law to demonstrate what level of use of the unregistered

mark might be deemed sufficient to constitute genuine use under the German provisions.

Although the Board must — of its own motion and by whatever means considered appropriate — obtain information about the national law of the Member State concerned, where such information is necessary for the purposes of assessing the applicability of a ground relied on before it (see *mutatis mutandis* judgment of 27 March 2014, C-530/12 P, 'Mano', para. 45). Nevertheless, first it is necessary for the said ground/provision to be presented before the Office adequately. However, in this instance, the opponent did not do so. In the Board's view, the opponent did not discharge its duty in providing sufficient information about the national law. On this point, the Court has held that a party to proceedings who relies on the particulars of national law has the burden of providing the Office with particulars showing that he or she satisfies the necessary conditions, in accordance with the national law of which he or she is seeking the application, in order to be able to have the use of a Community trade mark prohibited by virtue of an earlier right. He or she is also obliged to provide particulars establishing the content of that law (see, *mutatis mutandis*, judgment of 27 March 2014, C-530/12 P, 'Mano', para. 34).

In conclusion, the Board annulled the contested decision and rejected the opposition.



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Decision of the Fifth Board of Appeal of 17 June 2014 in case R 107/2014-5 (EN)

Opposition proceedings – Article 8(5) CTMR – reputation of the earlier mark – Rule 19(1)(c) CTMIR – Translation of evidence

The CTM applicant sought to register the figurative mark for goods in Classes 29, 32 and 33.



The opponent filed an opposition on the basis of Article 8(5) CTMR based on several earlier marks.

The Opposition Division partially rejected the opposition for some of the contested goods which were considered to be dissimilar. As the opponent failed to prove that its trade marks had a well-known character/reputation in Spain, the opposition had to be rejected insofar as it was based on the earlier well-known marks and on Article 8(5) CTMR.

The opponent filed an appeal and requested that the Board annul the contested decision and uphold the opposition as far as it was rejected for the

dissimilar goods. It argued that use of the contested mark would take unfair advantage of the earlier trade marks' distinctive character or repute due to the high similarity between the marks and the link between the conflicting goods

The Board, first, recognised that the earlier trade marks had gained a certain position and recognition on the relevant Spanish market in relation to 'jams and marmalades' due to their extensive use. However, the evidence filed (before the Opposition Division as well as before the Boards – the latest however being belated) was not found sufficient to allow the Board to conclude that the marks were known by a significant part of the public to amount to reputation. To this extent, the Board recalled that the existence of an unusually high level of distinctiveness as a result of the public's recognition of a mark on the market necessarily presupposed that at least a significant part of the relevant public was familiar with it, without it necessarily having to have reputation within the meaning of Article 8(5) CTMR. Furthermore, the Board concurred with the Opposition Division that it could not accept the evidence of reputation to the extent that it was not translated correctly. In fact, the evidence for the substantiation of the opponent's earlier right (Rule 19(1)(c) CTMIR) could not be taken into account to the extent that it was in a language other than the language of the proceedings and had not been translated into the language of the proceedings, within the time-limit set by the Office.



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Consequently, the Board dismissed the appeal as far as it was directed against the contested decision`s reasoning with regard to Article 8(5) CTMR.

Decision of the First Board of Appeal of 2 July 2014 in case R 2592/2013-1 (EN)

Absolute grounds for refusal – word mark – Article 7(1)(b), (c) and 7(2) CTMR – distinctiveness – descriptiveness – goods in Class 30

The CTM applicant sought to register the word mark 'BLONDE' for goods in Class 30.

The examiner rejected the mark applied for under Article 7(1)(b) and (c) CTMR in conjunction with Article 7(2) CTMR on the ground that it described a characteristic of the goods at issue, since it referred to a specific blend of coffee which was demonstrated clearly in the Office's previous communication, in which coffee roast was described as 'blonde' or 'light'. Thus, the mark did not only give direct information about the colour of the coffee, but also specific information about the nature of the coffee roast used for the brew.

The Board stressed that it was reasonable to assume that coffee might have a lighter tint than its more common dark brown colour. Coffees could have a lighter or darker hue, depending on the intensity or strength of the roasting process.

An intense roasting process would usually lead to a darker coffee; whereas a less intense and shorter roasting process would result in a lighter, i.e. blonde coffee (see also the websites cited by the examiner). Consequently, consumers might perceive the mark as indicating the coffee's colour and would perceive the mark as describing the nature and colour of the goods applied for.

The Board dismissed the appeal and confirmed the contested decision.

The Registry also recommends

Decision of the Second Board of Appeal of 10 July 2014 in case R 1710/2013-2 (EN)

Opposition proceedings – Article 8(3) BoA-RP – ancillary appeal

The applicant sought to register the word mark 'polo-moto', for goods and services in Classes 9, 12, 18, 25, 35 and 43.

The opponent filed an opposition on the basis of Article 8(1)(b), (4) and (5) CTMR based on several earlier rights.

The Opposition Division partially granted and partially upheld the opposition.

Only the applicant filed an appeal against the



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contested decision. The opponent, within its observations, requested that the Board not only uphold the part of the contested decision which partially granted the opposition and rejected the CTM application pursuant to Article 8(1)(b) CTMR, but also uphold the opposition under Article 8(5) CTMR and also reject the CTM application for the remaining services in Classes 35 and 43 for which the opposition was rejected by the Opposition Division, by means of an ancillary appeal according to Article 8(3) BoA-RP. Although considering the ancillary appeal admissible, the Board rejected it as unfounded as the opponent patently failed to demonstrate that use of the contested mark would take unfair advantage of, or be detrimental to, the earlier trade mark's distinctive character or repute.

Decision of the Second Board of Appeal of 11 July 2014 in case R 2597/2013-2 (EN)

Absolute grounds for refusal – figurative mark – Article 7(1)(b) and (c) and 7(2) CTMR – distinctiveness – descriptiveness – goods in Class 11

The CTM applicant sought to register the figurative mark

HOTHANDS

for goods in Class 11.

The examiner rejected the mark applied for under Article 7(1)(b) and (c) CTMR in conjunction with Article 7(2) CTMR on the ground that the word elements would be immediately understood together and their descriptive meaning clearly perceived by consumers as 'causing or having a sensation of heat in the hands'. With regard to the figurative element, the examiner ruled that the quite banal stylisation of the figurative elements did not endow the trade mark applied for as a whole with any distinctive character.

The Board, however, concluded that the word 'hot' when attributed to the contested goods was unnatural, undesirable and not a true characteristic of the goods. The potential consumer would be puzzled in trying to make any sense out of it. Therefore, when interpreted as 'high temperature hands' the expression 'HOT HANDS', was fanciful and did not immediately inform the relevant public about the characteristics of the goods applied for, but required at least certain mental steps, in order to render that expression meaningful. The stylisation of the words 'HOTHANDS' and the two horizontal stripes, which were banal, in no way affected the previous sentence's findings.

Consequently, the Board annulled the contested decision.