



OHIM at INTA's 135th Annual Meeting Dallas - Texas, May 4-8, 2013



OHIM at INTA 2013 Annual Meeting

For over a decade, the Office for Harmonization in the Internal Market has been a regular visitor to the Annual Meetings of the International Trade Mark Association (INTA).

OHIM has manned a stand at this annual event since the Washington meeting of 2002 and last year, for the first time, the Office was accompanied by representatives of other EU offices as part of the European Trade Mark and Design Network

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This month James Nurton talks to trade mark attorney Tania Clark of Withers & Rogers in London about topics including moving image marks, the Specsavers case and how the Madrid Protocol is driving harmonisation.

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OHIM at INTA 2013 Annual Meeting



OHIM Booth at INTA

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OHIM has manned a stand at this annual event since the Washington meeting of 2002 and last year, for the first time, the Office was accompanied by representatives of other EU offices as part of the European Trade Mark and Design Network.

This partnership with other IP offices from EU member states will be repeated in Dallas, Texas, in the first week of May 2013, as OHIM goes to the States once again to enhance the reputation and visibility of the Office and the European Trademark and Design Network as well as to promote further harmonisation and convergence of practices within the European Union and with external partners.

As with previous meetings, OHIM's presence this year will revolve around its stand in the main exhibition area, booth number 319, with a top delegation on hand to attend to enquiries from visitors to the Dallas Convention Center at 650 South Griffin Street.

OHIM experts will be on hand to showcase a number of IP tools recently launched as part of the Office's Cooperation Fund initiatives, namely: Taxonomy, DesignView, Search Image and the Goods & Service Similarity database, as well as the new OHIM website.

Visitors to the booth will be able to see live demonstrations of how these new interfaces work in a specially dedicated seating area, and can consult OHIM staff on any aspect of their functionality.

Leaflets and brochures will be available at the booth outlining the aims and achievements of the EUTMD Network, as well as electronic copies of the OHIM Annual Report for 2012.

This year, for the first time the Office will be hosting a new-format Information Meeting which will be open to all INTA visitors.

The meeting will be held in room C142 of the Dallas Convention Center between 2pm and 4pm on Sunday 5 May, with a maximum capacity for 100 people, so attendance will be on a first-come-first-served basis.

The meeting will provide INTA attendees with the ideal opportunity to get all the latest information first-hand on how OHIM and the European Trade Mark and Design Network is developing.

Another long-standing part of OHIM's participation at INTA Annual Meetings is the numerous Table Topics hosted by members of OHIM staff. This year will be no different, with three main topics under discussion in Dallas: The Bridge between Classification and Identification, Absolute and Relative Grounds in CTM Examination and open questions on the registered Community design.

Behind the scenes and out of the public eye, OHIM will be participating in a number of official meetings with international partners, particularly with the TM5 group, comprising OHIM, USPTO, KIPO, JPO and SAIC, and with the OHIM Sub-Committee.

For regular updates on OHIM's participation at the Dallas event, the Office's Twitter account [@oamitweets](https://twitter.com/oamitweets) will be posting regular notifications, and the official hashtag this year is #INTA13.

Interview



The James Nurton Interview

This month James Nurton talks to trade mark attorney Tania Clark of Withers & Rogers in London about topics including moving image marks, the Specsavers case and how the Madrid Protocol is driving harmonisation

What is your background?

It's unusual. I qualified as a barrister having done a postgraduate diploma in IP. But I didn't have a science background which made it very difficult to get work at the bar in those days. So I joined a firm of solicitors doing contentious and non-contentious work in patents, copyright and a bit of designs. I later worked in-house for a subsidiary of Total, doing various bits of legal work including IP.

After a short career break about 17 years ago I decided to change course and become a trade mark attorney. I was told the exams wouldn't take long but they took five years as I was doing them part time. I qualified with the firm TMOA (which later became Hallmark) then worked at Haseltine Lake before joining Withers & Rogers about seven years ago.

Now 95% of my work is trade marks, and I do a little bit of designs. I mainly do prosecution work predominantly for UK clients of varying sizes. But clients also have lots of questions about things like agreements and sometimes pick my brains on those.

In my previous role, handling legal work, some matters would swallow you up for weeks on end. But as a trade mark attorney typically 25 files will pass my desk in one day so it is quite different. I also like the international aspect of the work: I speak French and Spanish, I went to A French school in London and also studied French law. There is a lot of reciprocity in trade mark work and it helps to understand the different approaches in different countries.

How big is your team?

The firm has 27 partners in total, four of whom work in trade marks. We also have two attorneys and two trainees, making a team of eight plus support staff. We are split over three of the firm's four UK offices and we think it is good to be spread in that way. At Withers & Rogers the patent attorneys don't do trade mark work and over time design work has migrated from patent to trade mark attorneys.

How many trade marks do you file?

Across the firm we file about 300 CTMs a year. I don't file many applications in the UK: we normally only do that as the basis for an international application. The reason is the nature of our clients' business: they want protection at least in the EU, and generally also in the US, Japan and China and maybe elsewhere.

But a UK registration can be useful for the international route as it is fast and has a short opposition period. We would normally designate the EU too and then drop the UK after 10 years.

What do you think of the CTM?

I think it has improved hugely: it is a lot more efficient and things seem to be coming back faster. The online mechanism works well, and has improved on the specifications side.

But the lack of consistency is still a big problem: you can file two similar applications on the same day for the same client but they will go to different examiners and there will be a different result. Many of the absolute objections are quite spurious and often the best thing is to go straight to an appeal as you know the examiner won't respond to your objections.

I think it's regrettable that the examiners take a very black-and-white approach. It's probably inevitable given they come from different backgrounds but more training and supervision would be helpful. It seems more automated than the UK IPO, for example, where you have the impression they are more willing to review things where there are objections.

With appeals, the main frustration is the delay. I just had a case that took a year and a half. With the long cooling-off period, we all tend to let things slide. Clients want a registration that they can enforce, but all you can say is: 'It may take nine months, or it may take three years.'

By contrast, RCDs are extraordinary – you can get a registration in 24 hours. They are a great add-on for protecting trade marks and also for clients in the retail sector: you can protect things like packaging and boxes and get 70 or 80 designs with one application. You would still want to get a trade mark but an RCD serves you well in the short-term.

What interesting cases have you worked on?

I did a lot of work for Tesco at one stage and we tried to get a registration for the stylised mark *Finest*. It was very difficult but one of the best things about a client like that is they have lots of evidence of use in the form of advertising even in a short time, which makes the job a lot easier. Other clients aren't always as diligent at collating evidence. We didn't get the registration on the first attempt but we did eventually.

I've also worked on some colour trade mark issues, including the colour lilac for Kraft in a case that pitched normal eating chocolate against dog chocolate. It is easier to enforce these kinds of marks where they are so well-known.

I think the next challenge will be moving images: clients are getting quirky with their logos, the visual aspect is very important and even billboards now have moving images. But you can't file a moving image trade mark – you have to use stills from a moving image which don't fully reflect the movement.

What do you think of the CTMR and TMD reform proposals?

Removing the graphical requirement may help with the registration of moving images, sounds and smells. We do get some enquiries in this area, particularly about protecting smells. Marketers want to catch the consumer's imagination and I think they will become more innovative as we move out of recession and advertising budgets increase. But for this to work the offices need to move even more towards email or online communication rather than fax.

Another change is the reduction in fees for filing in one or two classes. I don't think the difference is that big and I expect most clients will still want the extra protection of three classes. You can always drop it if you have an opposition.

What do you think about the recent and pending CJEU cases?

I fear *IP Translator* has created new problems, and perhaps OHIM should have waited to confirm its policy. The big question is: what will happen with enforcement? Will there be many more cases and cancellations? It will be worse in some countries, where they followed the old OHIM practice, than in the UK.

There is a similar problem following *One!l*: how do you advise a client? The Court says that use in one country may be enough, depending on the extent, but that doesn't help me tell a client whether their sales in the UK are sufficient. It may drive people back to filing national marks.

Looking forward, the *Specsavers* case, which has been referred from the UK courts, will be interesting. It concerns whether overlapping use constitutes use of a mark, and also use in different colours. We often register marks in black-and-white that are used in different colours and have never worried about it until now. Should you register in black-and-white if you are using in one bold colour? Or should you register in different colours and then let the marks lapse over time? You have to consider how to make it safe for enforcement.

In the UK, you can register for a series of marks, but unfortunately OHIM has never recognised that.

What are important developments in the UK?

One thing we are watching is the consultation on designs and having a mediation service, which might make UK designs more attractive. I have never filed a UK design and it can be confusing having these different rights – EU, UK, registered, unregistered - with different terms of protection. Abolition of the UK unregistered design right is one possibility.

Another recent development is the relaunch of the Patents County Court (which actually handles all IP rights) and in particular the small-claims track. This is definitely something for clients to think about, particularly for straightforward cases such as identical trade mark infringement. The PCC provides quick, cheap litigation and the decisions so far have been very good. We should shout about it a bit more!

What trends do you expect in the future?

Plain packaging is a bit of a worry. I don't have clients in the tobacco industry but you do wonder how far it is going to go. Where will they draw the line?

Another growing concern is trade mark squatting, particularly as clients outsource design or manufacturing to companies in other countries. We have to warn them not to tell anyone about their trade mark plans before filing an application, or you may find someone else has registered it.

On a more positive note, I welcome the expansion of the Madrid System. I hope more countries will join particularly in the Americas, now that Colombia and Mexico have led the way. There is a lot of commercial interest in the Middle East so we would like to see expansion there too. Not only does Madrid bring cost savings but it also brings countries slightly more in line on things like classification, fees and the 18-month rule. In 10 years, it will be interesting to see what divergences remain. As I said at the beginning, it's the international nature of the work that makes this such an interesting job!

Community Trade Mark

CTM

Leno Merken case

In C-149/11 'Leno Merken', the Court of Justice (CJ) was requested to indicate whether Article 15(1) CTMR should be interpreted as meaning that use of a Community trade mark within the borders of a single Member State is sufficient to constitute genuine use of that trade mark. In the event of a negative answer, the CJ was asked whether use in a single Member State could never be regarded as 'genuine use' in the Community. In the alternative, the CJ was asked whether the assessment of genuine use should be carried out wholly in the abstract, without reference to the borders of the individual Member States.

In its judgment of 19/12/2012, the CJ ruled that:

- (i) the territorial borders of a Member State are irrelevant for the assessment of genuine use,
- (ii) a CTM is put to 'genuine use' when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the EU for the goods or services covered by it and
- (iii) it is for the decision-making authority to assess the genuine character of the use, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.

Impact on Office practice

In view of the above, the Office has decided to amend its Manual on Proof of Use to align it with the statements of the CJ:

- The revised version of the Manual now spells out the principle that the **territorial borders of the Member States should be disregarded** in the assessment of whether a CTM has been put to 'genuine use in the Community'.
- Moreover, the previous reference to the **Joint Statements** by the Council and the Commission has been deleted. According to these Statements, 'use which is genuine within the meaning of Article 15 in one country constitutes genuine use in the Community'. Such an automatic assumption can no longer stand.
- Finally, the exact territorial extent of the use that is needed in a particular case to meet the genuine use test has to be determined on a **case-by-case basis**, taking into account all the relevant facts and circumstances.

The revised version of the Manual will enter into force immediately after publication.

10 Years of RCD - celebrations in Alicante

OHIM organised an international design conference in Alicante to celebrate the 10th anniversary of the registered Community design. For two days, on 8 and 9 April, close to 700 participants attended sessions on a wide range of issues relating to the registered Community design, and to IP protection in general, with a number of notable highlights.

Javier Mariscal's magical journey through the world of colours left a packed auditorium spellbound on day one while three-Michelin-star chef, Quique da Costa, delighted those present with an insight into design in gastronomy.

Sessions on spare parts, fashion and mobile devices were just some of the other sessions, along with various rundowns of case law at the hands of some of the most prestigious IP judges in the world.

The resounding success of this event, both in terms of the large number of attendees as well as the quality of the speakers, is a fitting tribute to the ever popular registered Community design.

Many of the speakers have kindly made their presentations available on the conference website:

<http://www.10yearscommunitydesign.oami.europa.eu/speakers/download-speakers-ppts>, where they can be easily downloaded.

**Types of Views****1. Forms**

Presently, OHIM accepts two forms of views: drawings and photos; they can be either in black and white or in colour.

In the absence of any legal restrictions OHIM accepts all forms of drawings, including hand-made drawings.

Photos are ordinarily permitted by OHIM and widely used because they are a fast and simple means for reproducing designs. The photos generated by digital cameras are in .jpeg format and, hence, can be used directly in e-filing applications.

The reproduction of a design may combine drawings and photos. The combination may include drawings showing only the contours of the product and colour photos/drawings showing the final product. The combination of black and white views with colour views is not allowed.

Colours can only be claimed in a registered Community design by showing them directly in the views, that is, by submitting colour ink drawings or colour photos. Where a drawing is made exclusively of black-ink lines and grey shades, it is considered to be a black and white view.

In computer aided drawings (CAD), colours are sometimes used to highlight different parts of a design. The highlighting of parts could be understood as claiming colours for these parts. This understanding could result in a limitation of the scope of protection of the registered design. However, OHIM does not intervene because it has neither a reason nor a legal basis to do so. The responsibility for an appropriate scope of protection lies with the applicant.

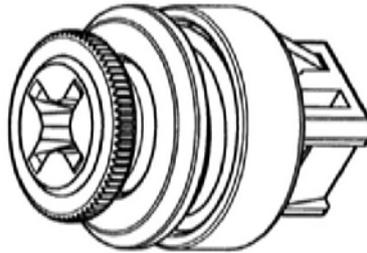
2.Styles

Drawings and photos may show designs in different styles, for example, perspective, exploded, cross-section etc. An applicant may combine different styles; the only restriction is that the views of a design must be compatible with each other, that is, they must show one and the same (identical) design.

The various styles of views accepted by OHIM are briefly described below.

Aspect views

The most common way of representing a design is to show it from certain aspects (angles), such as front, side, top, bottom and/or perspective views. RCD 001116529-0002 (designed by Dieter Ramsauer) registered for 'fittings' contains an example of a perspective view:



Where an applicant seeks protection for the design of a three-dimensional product, they may choose to show it from some sides or from all sides. Obviously, a design for a two-dimensional product, such as an icon, can only be shown from one aspect, namely the front.

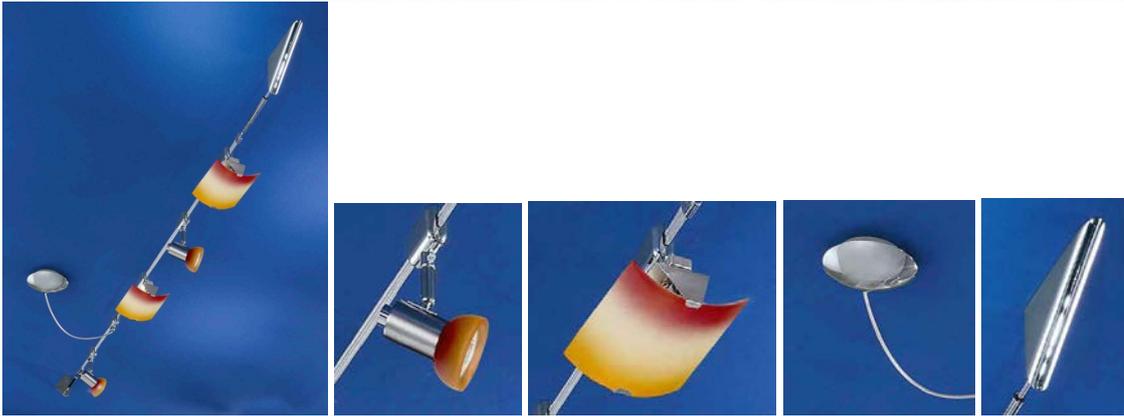
Partial views

Details of a design may be shown in partial (fragmentary) views, provided they are combined with at least one aspect view showing the design in its entirety.

Partial views are helpful to show the elements of a set of articles individually for enhancing details. However, the first view must show the whole set. RCD 002161497-0001 is an example showing the design of a 'cappuccino set':



Likewise, the design of a complex product composed of various parts may be shown in a series of views, the first view showing the complex product fully assembled and the other views showing some of the characteristic parts individually. An example is RCD 000238092-0001 registered for 'ceiling lights' with the following views:



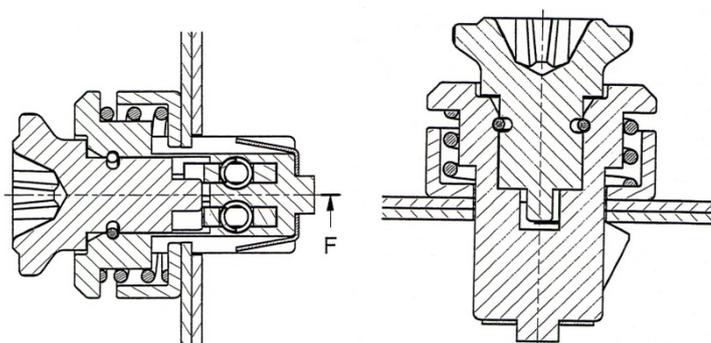
Partial views are also helpful for reproducing the design of a two-dimensional product, such as a surface pattern, where the first view shows the entire pattern and the partial views some enlarged details, such as in RCD 000647920-0069 for 'fabrics':



Sections

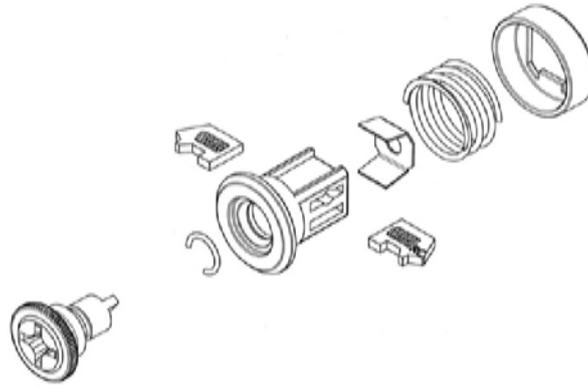
Sectional views such as cross sections and cut-offs are different from aspect and partial views because they show aspects and parts of a design which are definitely not visible in the normal use of the product to which the design applies. Nevertheless, it could be helpful to show a cross section of a product in order to illustrate its outer (visible) contours.

The Regulations exclude protection for the non-visible component parts of a complex product. However, showing features of a design excluded from protection is not a reason to object to the registration of the design. RCD 001116529-0002 (designed by Dieter Ramsauer) gives an example:



Exploded views

The designs of complex products consisting in a variety of component parts may be shown in exploded views. Exploded views are of particular interest for registering Community designs of complex products with more than six component parts because in an exploded view all the component parts can be shown separately but in a single view. RCD 001116529-0002 (designed by Dieter Ramsauer) gives an example:



Snapshots

Snapshots are used to show a design at specific moment in time. A series of snapshots may be used to reproduce an animated design, such as an animated icon or a graphical user interface.

An applicant has the right to number the views and thereby fix the sequence in which the views are registered and published. The example below shows RCD 001158471-0001 (designed by Stefan Pigur) registered for 'animated graphical user interfaces' with a series of seven views which are registered and published in the sequence given by the applicant:

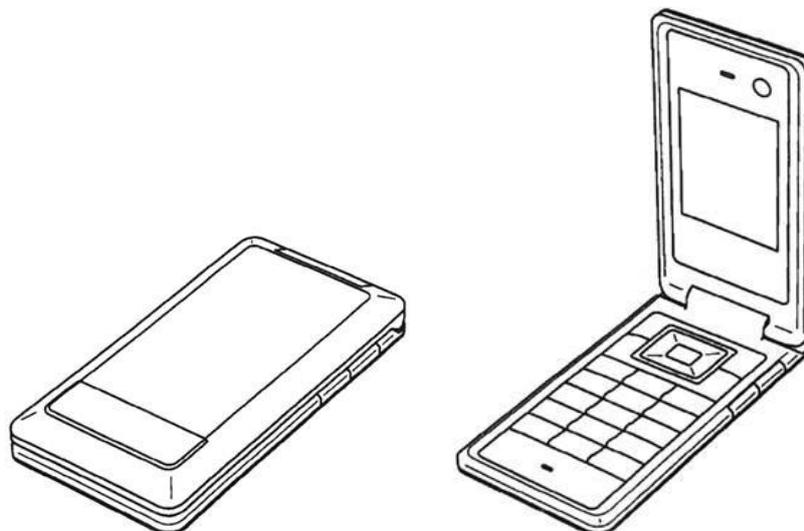


Alternate positions

Alternate-position views are applicable where design protection is sought for a convertible product, such as a sofa bed or a convertible.

Alternate-position views are similar to snapshots because they show the product at different moments in time. However, in contrast to snapshots, the sequence of the alternate-position views does not matter.

An example of a design shown in alternate position views is RCD 588694-0012 (designed by Hideki Hino and Yukie Chiba) for 'mobile phones' as depicted below:



Typographic typefaces

An application for registering a Community design may concern a typographic typeface. The representation of the design of a typographic typeface must consist in a string of all the letters of the alphabet, in both upper and lower case, and of all the Arabic numerals, together with a text of five lines in that typeface, both letters and numerals must be in the font size 16. An example is RCD 000130299-0001:

ABCDEFGHIJKLMN OPQRSTUVWXYZ

abcdefghijklmnopqrstu v wxyz

1 2 3 4 5 6 7 8 9 0

Bei einer Sammelanmeldung ist in diesem Feld die Anzahl der in der Anmeldung enthaltenen Geschmacksmuster in arabischen Ziffern abzugeben. Die Anzahl der Geschmacksmuster ist nicht zu verwechseln mit der Anzahl der Ansichten, die die

EUTMDN Updates**Malta joins Similarity project**

OHIM has announced the integration of the Maltese IP Office (CD IPRD) into CF Similarity.

This takes the total number of EU offices, including OHIM, in the CF Similarity project to seven.

Observatory – IP in the Digital World working group meets

The EU Observatory on Infringements of Intellectual Property Rights working group on IP in the Digital World has held its first meeting.

Working group members gathered in Brussels to discuss projects and the continuation of work to be carried out.

In February, working groups on public awareness, economics and statistics, legal affairs and enforcement met for discussions and updates on progress made so far in the Observatory's projects.

The working groups consist of private and public sector stakeholders from all across the EU.

Trade mark liaison meeting

The 9th Liaison Meeting on trade marks was held in Alicante on 23 and 24 April.

35 international Industrial Property Offices, including WIPO and all of the EU national offices, met with OHIM officials to discuss issues including the Harmonisation of TM Classification practice of G&S and Convergence of Class headings.

Also on the agenda were updates in the areas of Figurative Marks, the Scope of protection of B&W Marks and the Likelihood of Confusion.

Four User Associations also attended the two-day meeting.

More News



Fordham IP Conference

OHIM President António Campinos attended the 21st Annual Fordham Intellectual Property Law and Policy Conference.

The event took place in New York. It was also attended by WIPO Director General Francis Gurry and former USPTO Director David Kappos.

This prestigious annual event brings together IP experts from around the world over two days, with key-note speeches and open debates on a wide range of IP-related topics.

New OHIM Information Meeting at INTA Annual Meeting

OHIM will be attending INTA's Annual Meeting in Dallas in May, accompanied by a number of its EU partners.

As well as the usual stand, which is number 319 this year, for the first time OHIM will be hosting, a new-format Information Meeting which is open to all INTA visitors.

It will take place in room C142 of the Dallas Convention Center between 2pm and 4pm on Sunday 5 May, with a maximum capacity for 100 people, so attendance will be on a first-come-first-served basis.

The meeting will provide INTA attendees with the ideal opportunity to get all the latest information first-hand on how OHIM and the European Trade Mark and Design Network is developing.

For more information, check out the editorial on Page 2.

Increased availability of OHIM Information Centre

OHIM's Information Centre is now available to callers from 09:00 to 13:00 and from 14:00 to 17:00 daily.

The extended hours are part of OHIM's policy of continuously improving user access to its services.

The extension also takes into account suggestions received from service users.

Russian TM and Design seminar

On 30 April, OHIM hosted a seminar entitled 'Trade Mark and Design Protection in the Russian Federation and Related Issues' in Barcelona.

Innovative European companies are always seeking new opportunities in rising economies such as that of Russia, which is one of the most important markets for companies from the EU.

This seminar, aimed at EU businesses and users of trade mark and design protection systems, dealt with matters such as how to obtain protection for trade marks and designs in Russia and current cooperation activities undertaken by both offices, and the European Commission, aiming at the approximation of the IP systems.

Participants also heard of first-hand industry experience on the best strategies for IP protection, and received an update of the impact of the important recent events and changes, such as the accession of the Russian Federation to the World Trade Organisation and the formation of the Customs Union of Russia, Belarus and Kazakhstan.

Speakers at the event included OHIM President, António Campinos, and the Director General of Rospatent, the Russian Patent Office, Mr. Boris Simonov, as well as representatives from various industry sectors.

Monthly statistical highlights* March 2013 compared to March 2012

	2013	2012
Community trade mark applications received	9 799	10 289
Community trade mark applications published	9 117	8 966
Community trade marks registered (certificates issued)	8 256	8 309
Registered Community designs received	7 768	7 440
Registered Community designs published	6 810	6 671

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

Case law



Luxembourg Case Law

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

Case T-159/11; Marek Marszałkowski v OHIM; Judgment of 4 February 2013; Language of the case: PL

Keywords: Figurative trade mark, complex mark, similarity of the goods and services, identity of the goods and services, dominant element, descriptive element, geographical origin, similarity of the signs, visual similarity, phonetic similarity, new argument, first time on appeal

RESULT: Action dismissed

FACTS: The CTM applicant sought to register a figurative mark **WALICHNOWY MARKO** (represented below) as a CTM for goods in Class 29, among others. The opponent filed an opposition invoking its earlier word CTM **MAR-KO**, protecting goods in Class 29. The opponent relied on Article 8(1)(b) CTMR. The Opposition Division dismissed the opposition considering that there was no likelihood of confusion. Upon the opponent's appeal, the Board of Appeal allowed the appeal and the opposition considering that there was a likelihood of confusion on the part of the Polish public. The Board found, in particular, that the term 'WALICHNOWY' was a geographical name so it was likely to be seen as relating to the origin of the products. The words MAR-KO and MARKO were highly similar and the figurative elements of the CTM applied for were not particularly striking. The CTM applicant appealed to the GC.

CTM applied for	Earlier CTM
	MAR-KO

SUBSTANCE: The GC confirmed its jurisprudence in relation to Article 8(1)(b) CTMR. It stressed the unitary character of the Community trade mark and recalled that the existence of grounds for refusal in one territory (in this case Poland) was sufficient to refuse the CTM application (Para. 35). The relevant public consisted of average Polish consumers (Para. 35). The GC dismissed the applicant's argument that the consumers would exercise a higher degree of attention with regard to the goods at issue (meat and charcuterie). The GC considered that although the quality and origin of such products might be of importance for the consumers, it is clear that these goods are purchased on regular basis; their price is not too high so they do not significantly affect the family budget and their purchase is not preceded by long hesitation and comparisons of various offers (Para. 37). The GC agreed that the goods were similar and, in part, even identical. The element MARKO of the CTM application is visually dominant. The word WALICHNOWY is less prominent and it will be perceived by Polish consumers as indicating the geographical origin of the goods (Para. 41 and 42). The GC referred to its jurisprudence and confirmed that in case of marks composed of figurative and word elements, it is usually the word element that is dominant (Para. 40). Therefore, the Board was correct in giving more importance to the element MARKO. The marks were visually and aurally similar and the conceptual comparison did not affect the likelihood of confusion in this case (Paras. 44 and 45). The GC also dismissed the applicant's argument relating to the reputation of the mark applied for. The GC confirmed that the reputation of the mark does not affect the assessment of the likelihood of confusion when it concerns the mark applied for (Para. 48). In any case, this argument was invoked for the first time before the GC and could not be subject to review in the proceedings. There is likelihood of confusion between the marks.

Cases T-224/11, T-225/11 and T-631/11 Caventa AG v OHIM; Judgments of 20 February 2013; Language of the case: DE

Keywords: Clarity of party submission, admissibility, restriction of the list of goods and services, modification of subject-matter before Court, similarity of the goods and services, identity of the goods and services, similarity of signs, name, distinctive element, ending of mark

RESULT: Actions dismissed

FACTS: The applicant sought to register three figurative marks 'BERG', represented below, as CTMs for goods within Classes 25 and 28. All applications were opposed to based on the earlier mark 'Christian Berg', registered for goods and services in Classes 3, 18, 25 and 35 on the grounds of 8(1)(b) CTMR. The Opposition Division upheld the opposition in all cases. The Board of Appeal dismissed the CTM applicant's appeals. The applicant filed an action before the General Court. In the Court proceedings, the applicant requested a limitation of the list of goods.

CTM applied for	Earlier CTM
<p data-bbox="331 1480 405 1507">BERG</p> 	<p data-bbox="1026 1547 1211 1574">Christian Berg</p>

SUBSTANCE: The Court found the appeals admissible, considered the limitation of goods in the course of the Court proceedings partially inadmissible and affirmed the likelihood of confusion.

Admissibility: The Court recalled that a party appealing to it has to state the reasons for its action according to Article 44 § 1 GC RoP clearly and precisely enough to allow the preparation of the defence (see T-127/02, Para. 17) but does not need to quote the particular norm, if it can be inferred from its submissions (see T-279/03, Para. 41).

Limitation of the goods: The Court confirmed its jurisprudence on the admissibility of the limitation of the goods after the decision of the Board. It recalled that the legality of the BoA decision is the subject matter of the Court proceedings. A limitation of goods would change the subject matter and is inadmissible (Article 135 § 4 GC RoP), unless it can be interpreted as a statement that the contested decision was being challenged only in so far as it covered the remainder of the goods concerned. Such an interpretation of a limitation is possible only if the applicant confines itself to withdrawing one or more goods or services from the list, or one or more categories of goods or services. In such a case, it is clear that the Court is in fact being asked to review the legality of the Board of Appeal's decision not in so far as it relates to the goods or services withdrawn from the list but only in so far as it relates to the other goods or services remaining on that list (Paras. 15, 16). The limitation of the goods 'sport clothing' to 'Sport clothing for boxing' (Class 25) and the addition of 'boxing gloves' to the originally claimed „sporting articles and equipment' in Class 28 is an alteration of the subject matter and, therefore, inadmissible (Para. 18).

Likelihood of confusion: The GC found the goods to be similar or identical and the trade marks similar, affirming the likelihood of confusion. The GC took into consideration that the earlier trade mark can be perceived as a forename and a surname (Para. 47). It referred to the case law regarding family names and repeated that their perception can be different in different countries. In some countries, the family name is more important than the forename (Para. 48). However, the GC emphasized that this general rule allows exceptions and needs to be assessed on a case by case basis (Paras. 48 and 50), taking especially into account how widespread the name/forename is (Paras. 48 and 49). The GC affirmed that CHRISTIAN is a very popular forename, whilst BERG is used (and recognizable) as family name but is not very widespread. For this reason, this part of the earlier mark is more distinctive (Para. 52) and the fact that the CTM applications take up this part leads to a similarity (Para.58).

Case T-247/11; FairWild Foundation v OHIM; Judgment of 7 March 2013; Language of the case: DE

Keywords: International registration, identity of the goods and services, similarity of the goods and services, similarity of the signs, visual similarity, phonetic similarity, ending of mark, relevant territory, new evidence, internet, first time on appeal

RESULT: Action dismissed

FACTS: The applicant designated the EU in its International Registration of the word mark **FAIRWILD** for, amongst others, goods in Classes 3, 5, 29 and 30. The opponent filed an opposition invoking its earlier word CTM **WILD**, protected for goods in Classes 3, 5, 29, 30 and 32. The opponent relied on Article 8(1)(b) CTMR. The Opposition Division partially allowed the opposition and rejected the CTM for the applicant's goods in the Classes mentioned above. The Board of Appeal rejected the applicant's appeal, finding a likelihood of confusion based, inter alia, on a visual and phonetic similarity of the signs and an average level of distinctive character of the earlier right. The applicant appealed to the GC.

SUBSTANCE: The relevant consumer is both the general consumer with an average level of attention and the professional consumer with a higher level of attention (not disputed). The assessment of likelihood of confusion needs to be based on the consumer with the lowest level of attention, here the general consumer (Para. 19). The goods are in part identical, in part similar (not disputed). Where a mark is formed by including the earlier right and adding another component to it, this points to a similarity between the signs (Para. 31). The element 'WILD' is contained in its entirety in the sign 'FAIRWILD'. The general assumption that the consumer focusses more on the beginning of a mark does not always hold true. It needs to be assessed in the context of the case at hand (Para. 33). The Court rejected the applicant's argument that the element 'WILD' had a low level of distinctiveness due to being part of the basic English vocabulary. First of all, it rejected the internet pages of advertising submitted to it by the applicant for the first time (Para. 38). It also considered that those documents did not support the applicant's claim that 'WILD' was part of the basic English vocabulary as it did not prove that the consumer to whom that advertising was directed would understand the term (Para. 39). Moreover, the documents referred only to some EU Member States and not to others and therefore did not prove the applicant's claim that 'WILD' in the CTM has only a low level of distinctive character (Para. 40). As a not irrelevant part of EU consumers do not speak any German or English, or only very little, and will not understand the meaning of the German/English term 'wild', it was correct to find that the earlier CTM had an average level of distinctiveness and not, as claimed by the applicant, a low level (Para. 41). The element 'WILD' cannot be ignored in the comparison of the signs and the Board of Appeal was correct in stating that it created an average visual and phonetic similarity between the signs (Para. 42). A conceptual comparison is not relevant as the term 'FAIRWILD' will be understood as a fantasy term (Para. 43). Taking into account the above as well as the fact that the element 'WILD' has an independent distinctive role in the composite sign (Paras. 49 and 50), the Court confirmed that there was a likelihood of confusion.

Case T-498/10; David Mayer Naman v OHIM; Judgment of 8 March 2013; Language of the case: IT

Keywords: Name, admissibility, new grounds, first time on appeal, request for proof of use, lack of reasoning, similarity of the signs, similarity of the goods and services, visual similarity, phonetic similarity, conceptual similarity, co-existence of trademarks, distinctive element, dominant element

RESULT: Action dismissed

FACTS: The CTM owner registered at OHIM the figurative mark **David Mayer**, shown below, as a CTM for goods in Classes 18 and 25. An invalidity action was filed based on the earlier Italian word mark **DANIEL & MAYER MADE IN ITALY**, registered for goods in Class 25. The Cancellation Division partially upheld the invalidity action and cancelled the contested CTM in respect of part of the goods in Class 18 and all of the goods in Class 25. The Board of Appeal dismissed the CTM owner's appeal. The CTM owner appealed to the GC.

Contested CTM	Earlier Italian Mark
David Mayer	DANIEL & MAYER MADE IN ITALY

SUBSTANCE: The GC rejected as inadmissible the CTM owner's plea, raised for the first time at the hearing before the Court, alleging that the invalidity applicant would have acquiesced in the use of the contested CTM and would therefore be precluded, under Article 54(2) CTMR, from seeking its cancellation. The GC noted that the claim had not been included in the application to the Court, nor had it been raised before the Board during the administrative proceedings. The GC referred to Article 48(2) of its Rules of Procedure, according to which no new plea in law may be introduced in the course of proceedings unless it is based on matters of law or of fact which come to light in the course of the procedure (Paras. 23-27). The GC also rejected the CTM owner's plea based on an alleged infringement of Article 57(2) and (3) CTMR, in that the Board should have considered that genuine use of the earlier mark had not been proven. The CTM owner had only belatedly requested before the Board that the invalidity applicant prove genuine use of its earlier mark. Such a belated request is inadmissible. The Court also rejected the CTM owner's claim that it should have been allowed to seek, before the Board and by means of a procedural exception, a declaration of partial revocation for non-use of the earlier mark (Paras. 28-40). Finally, the GC rejected the CTM owner's plea alleging an infringement of Article 53(1)(a) in combination with Article 8(1)(b) CTMR, to the extent that the Board would have failed to make a sufficiently motivated comparison of the goods concerned and would have wrongly concluded that a likelihood of confusion existed. The Court noted that the Board had expressly referred to the more detailed comparison of goods made by the Cancellation Division and that, by means of this express reference, the detailed analysis formed part of the Board's contested decision (Paras. 56-59). As regards the signs, the GC stated that the surname Mayer is not common in Italy and is therefore inherently distinctive from the standpoint of the Italian public (Paras. 76-79). The signs present visual, aural and conceptual similarities and evoke, in the consumers' minds, the reference to a natural person having a name of Jewish origin (Daniel and David, respectively) and a German surname (Mayer) (Paras. 81-99). The Court rejected the CTM owner's arguments concerning (i) the alleged reputation of the contested CTM, (ii) the lack of confusion due to the specific distribution channels used by the parties and (iii) the alleged coexistence between the signs. In this last respect, the Court noted that the invalidity applicant had filed evidence relating to on-going lawsuits between the parties before the Italian Courts and stated that judgments by national courts can prove the absence of peaceful coexistence. Finally, the GC recalled the judgment in Case T-185/03, ENZO FUSCO/ANTONIO FUSCO and concluded that in the present case there is a likelihood of confusion between the signs, which share the same surname and whose other distinctive and dominant elements, Daniel and David, are similar (Paras. 102-155).

Case T-624/11; Yueqiong Onesto Electric Co. Ltd, Ensto Oy v OHIM; Judgment of 19 March 2013; Language of the case: EN

Keywords: Identity of the goods and services, similarity of the signs, visual similarity, phonetic similarity, ending of mark

RESULT: Action dismissed

FACTS: The applicant sought to register the figurative mark **ONESTO**, represented below, as a CTM for goods within Class 9. An opposition based on the earlier mark **ENSTO**, shown below, registered for, among others, goods in Classes 7,9 and 11, was filed on the grounds of Article 8(1)(b) CTMR. The Opposition Division rejected the opposition in its entirety. The Board of Appeal upheld the appeal and annulled the OD's decision stating that there was likelihood of confusion. The applicant filed an action before the GC.

CTM applied for	Earlier Mark
	

SUBSTANCE: The relevant public is the general and professional public (not disputed). The GC confirmed that '*signal lanterns*' covered by the mark applied for were included in the category of '*signalling apparatus and instruments*' in Class 9 covered by the earlier mark. These goods are identical. In so far as concerns the other goods covered by the mark applied for they are included in the category of '*electric apparatus and instruments*' in Class 9 covered by the earlier mark and are, therefore also identical. Visually, the signs differ in relation to their first letters, namely 'o-n-e' in the sign applied for and 'e-n' in the earlier sign. The GC also noted that the letters 'e' and 'n' are reversed in the sign applied for as compared to the earlier mark and, thus, the only visually noticeable difference is that the sign applied for begins with an 'o'. Similarly, the difference in the length of the signs, six letters in the sign applied for as compared to five in the earlier sign, is not important enough to be decisive in the present case. The visual similarity of the signs is rather low. The sign applied for will be pronounced in three syllables, whereas the earlier sign will be pronounced in two. They will be pronounced, respectively, as 'o-nes-to' and 'ens-to' or 'en-sto'. Although the pronunciation of the letters 'o' and 'en', situated at the beginning of the respective signs, is not identical in French, it may nonetheless be very similar. Thus, for the French speaking public, the only noticeable phonetic difference between the signs resides in the third letter of the sign applied for, namely 'e', which does not feature in the earlier sign. The GC also noted, as did the Board of Appeal, that the ending 'sto', common to both signs, is quite unusual for the French speaking public, with the result that those endings that coincide will be easily noticed. Consequently, there is a high level of aural similarity for the French speaking public. In so far as concerns the non-French speaking public, the signs have only a low degree of aural similarity since only the final syllable is the same in the two signs. Finally, on the conceptual comparison, the GC confirmed that the signs have no meaning, except for the Italian speaking public, for whom the word 'onesto' means 'honest'. Bearing in mind that the goods covered by the opposing marks are identical, that the signs are both visually and aurally similar, that for French speaking consumers the signs are highly similar from an aural point of view, that the sign applied for has a meaning for the Italian speaking public (whereas it does not in any of the other languages of the European Union), there is a likelihood of confusion between the opposing marks.

Case T-277/12; Bimbo SA / OHIM; Judgment of 20 March 2013; Language of the case: EN

Keywords: Well-known trade mark, identity of the goods and services, similarity of the goods and services, similarity of the signs, ending of mark, adversarial principle, competence of the Boards, figurative element, lack of reasoning, right to be heard, principle of party disposition, principle of functional continuity

RESULT: Action dismissed

FACTS: The opposition was based, inter alia, on an unregistered mark claimed to be well-known in Spain within the meaning of Article 6 bis of the Paris Convention. The Opposition Division upheld the opposition in part, namely for '*flour and preparations made from cereals, bread, pastry and confectionery, ices; yeast, baking powder*' in Class 30. The Board of Appeal upheld the appeal in part, and upheld the opposition in part. It found that the applicant's '*preparations made from cereals and bread*' and '*pastry*' are identical or similar to the '*packaged sliced bread*' for which the well-known character of the earlier mark 'BIMBO' was established. The Board dismissed the opposition for the remainder, finding that the applicant's '*flour, ices, yeast and baking-powder*' are dissimilar to the opponent's '*packaged sliced bread*'. Although the former are important ingredients of bread, they have a different nature, purpose and method of use. The Board also held that the applicant's '*confectionery*' and '*ices*' differ in nature, purpose and method of use from the opponent's '*packaged sliced bread*'. Likelihood of confusion was therefore limited to the applicant's '*preparations made from cereals, bread and pastry*'. The opponent appealed to the GC.

CTM applied for	Unregistered mark well-known in Spain for 'packaged sliced bread'
	<p style="text-align: center;">BIMBO</p>

SUBSTANCE: On the violation of Articles 64, 75 and 76 CTMR: The opponent had claimed that its earlier mark was well-known, not only in respect of '*packaged sliced bread*' but, more generally, in respect of '*cereals, milling industry, baking, pastry and starch*', such a fact being accepted by the applicant and unchallenged before the Board. The GC noted that, through the effect of the appeal brought before it, the Board of Appeal is called upon to carry out a new, full examination of the merits of the opposition, in terms both of law and fact, even on points on which the parties have not put forward a view and even if the first instance department of the Office has omitted to rule on that aspect. The Board of Appeal was therefore under an obligation to reassess the scope of protection of the earlier mark (Paras. 33-34) and the comparison of the goods (Paras. 40-42). The GC reiterates that the Office is not bound by the points which are not challenged by the parties: 'The issues of the existence and the scope of an earlier mark are thus not factors which can be left to the free assessment of the parties' (Para. 35). The decision is sufficiently reasoned (Article 75 CTMR) and the right to be heard was complied with (Paras. 45-46). On the violation of Article 8(1)(b) CTMR: The GC notes that the opponent contradicts the Board's finding without putting forward convincing facts or evidence in support of the claim that '*flour, ices, yeast, baking-powder, confectionery, ices*' are similar to '*packaged sliced bread*' (Paras. 57-59). The GC concludes that the reasons given by the Board of Appeal are sound and justify that the opposition be upheld only in respect of '*preparations made from cereals, bread and pastry*' in Class 30.

Case T-571/11; El Corte Inglés, S.A. v OHIM; Judgment of 20 March 2013; Language of the case: ES

Keywords: Nice Classification, examination of facts ex officio, new argument, first time on appeal

RESULT: Action dismissed

FACTS: The applicant sought to register the word mark **CLUB GOURMET** as a CTM for goods in various Classes. An opposition was filed on the grounds of Article 8 (1)(b) and 8(5) CTMR. It was based on the earlier Spanish mark **CLUB DEL GOURMET EN EL Corte Inglés**, shown below, registered for services in Class 35, namely: 'An advertising sentence. It will be applied to the products covered by the trade marks Nos 1013156 (Class 29), 1013157 (Class 30) and 1815538

(Class 31), 1815539 (Class 32), 1013158 (Class 33), 1815547 (Class 42) 'El Corte Inglés' (figurative)'. The Opposition Division rejected the opposition. The Board of Appeal dismissed the appeal. It considered that the description of the services of the earlier mark did not allow any comparison with the goods designated by the mark applied for.

CTM applied for	Earlier Spanish Mark
CLUB GOURMET	CLUB DEL GOURMET, 

SUBSTANCE: The opponent argued, for the first time before the GC, that the earlier mark also covers the goods designated by the other Spanish marks which are cited in the list, as constituting the scope of application of 'advertising sentence'. It also claimed a specific practice of the Spanish TM Office concerning the treatment of the so-called 'slogan marks' until 1997, a practice which, in its' view, would extend the scope of protection of the earlier mark to the goods covered by the other Spanish marks cited (Para. 20). The Court noted that the earlier sign's list of services identifies a single service in Class 35, namely 'an advertising sentence'. It is not apparent from the description that the earlier mark is supposed to cover also the goods designated by the other Spanish marks. Moreover, it is not possible to know which goods are designated by those marks (Para. 24). There was no evidence that the opponent had submitted, during the administrative procedure, that the protection conferred by the earlier mark was supposed to extend beyond the services in Class 35 (Para. 33). The GC examined whether OHIM was required to take into account, of its own motion, the fact that, under Spanish national law, the protection conferred by the earlier mark extended to the goods designated by the marks referred to in the description of services (Para. 34). It noted that only EU law falls within the area of law, in which the maxim *iura novit curia* applies, whereas national law is an issue of fact whose content must be demonstrated where necessary (Para. 35). It also results from Rules 19(2) and 20(1) CTMIR that it is for the opponent to file proof of the scope of protection of the earlier mark and not for OHIM to investigate it (Para. 36). As a rule, it is therefore for the party relying on national law to show that it supports his claims (Para. 38). Nonetheless, OHIM must in certain cases obtain, on its own motion, information about the national law of a Member State. That obligation is subject to two conditions: first, that such information is necessary to assess the applicability of a ground for refusal and, in particular, the accuracy of the facts and the evidence submitted; and second, that OHIM already has information relating to national law, either in the form of claims as to its meaning, or in the form of evidence submitted and whose probative value has been adduced (Paras. 39 and 41). In the case at hand, the opponent had not expressly argued that the earlier mark was protected for goods and services other than those in Class 35. Consequently, OHIM was not required to obtain information about Spanish national law or to carry out investigations (Para. 43). The GC confirmed that the description of the services of the earlier mark does not allow them to be compared with the goods designated by the mark applied for and that the opposition had to be rejected for that reason (Paras. 54-55).

Case T-353/11; Event Holding GmbH & Co. KG v OHIM; Judgment of 21 March 2013; Language of the case: EN

Keywords: Similarity of the goods and services, dissimilarity of the goods and services, similarity of the signs, complex mark, visual similarity, phonetic similarity, conceptual similarity, specialised public, no bearing on decision, new evidence, first time on appeal

RESULT: Action dismissed

FACTS: The applicant sought to register a figurative mark **EVENTER EVENT MANAGEMENT SYSTEMS** (represented below) as a CTM in Classes 35 and 41. An opposition based on the earlier German word mark **EVENT** in Class 43 was filed on the grounds of Article 8(1)(b) CTMR. The Opposition Division rejected the opposition. The Board of Appeal dismissed the opponent's appeal. The opponent appealed to the GC.

CTM applied for	Earlier German Mark
	<p style="text-align: center;">EVENT</p>

ADMISSIBILITY: The internet printouts provided by the opponent are inadmissible as they were produced for the first time before the GC. The extracts from decisions of the Bundespatentgericht, although they were produced for the first time, are admissible since they were not evidence in the narrow sense but national case-law which was useful for the purposes of interpreting the CTMR (Paras. 22-23).

SUBSTANCE: The Court held that the relevant public for all services in Class 35 and the services related to arranging and conducting exhibitions in Class 41, covered by the mark applied for, and for 'development of hotels' in Class 35, covered by the earlier mark, consisted of professionals with a high level of attention whereas the relevant public for the other services was the general public. The relevant territory was Germany (Paras. 31, 32, 38). With regard to the comparison of services, the Court upheld the Board's assessment that *'development of hotels'* and *'services of business management; business administration'* are similar and not identical as the opponent has claimed. These services do not fully cover the same field of activities as 'development', unlike 'management', refers to a process of growth (Para. 44). *'Operation of hotels'* was found to be dissimilar to *'office functions'*, as the former involves services such as the reception, cleaning, the stocking and supply of foods and drinks, which are different from typical office functions. Within hotels, the latter are usually performed by the hotel staff, not by third parties (Paras. 46-47). *'Advertising; organisation and conducting of exhibitions and events for commercial or advertising purposes; publication of publicity texts'* services were also found to be different from the services covered by the earlier mark, since the operation of hotels – although involving the promotion of hotels and the activities they offer – remains an internal activity and does not target third party undertakings. Furthermore, while it is true that during publicity events restaurant or accommodation services can be provided, the connection between those services and the services relating to the organisation of said events cannot be treated as complementarity (Para. 51). Finally, *'education; providing of training; entertainment; sporting and cultural activities; arranging and conducting of congresses, seminars, symposia and conferences'* are not similar to *'restaurant and accommodation'* services. In the majority of cases, the former are provided by separate undertakings having commercial links to the hotels; when hotels organize such activities themselves they target their own customers and not the general public. Moreover, while these activities can be organized in hotels, hotel managers usually restrict themselves to hiring out their premises. Restaurant services provided during said activities are merely accessory and not complementary to those covered by the contested mark (Paras. 54-55). Regarding the opponent's argument that the German Federal Patents Court had found similarity *between 'entertainment; sporting and cultural activities' and 'restaurant and accommodation services'*, the GC emphasized the autonomy of the CTM regime and recalled that national case-law could not call into question the contested decision (Paras. 56-58). As far as the similarity of the signs is concerned, the Court found a low degree of visual similarity, stating that the relevant public would not fail to notice the ending 'er' in the first element of the contested mark, as well as its additional word and figurative elements (Para. 66). From a phonetic point of view, the GC held that the marks were similar as the words 'event management systems' would probably not be pronounced (Para. 69). Since the relevant public could understand the meaning of the English word 'event' and associate the word 'eventer' to the idea of an event, the signs were found to be also conceptually similar (Paras. 77-78). The Board's finding that the word 'event' was descriptive and thus that the earlier mark had a weak distinctive character for those services considered similar was not followed (Para. 89). However, even assuming a normal level of distinctive character of the earlier right, the Board had not erred in its global assessment, since the similarities between the signs were insufficient to create likelihood of confusion for similar services, given the high degree of attentiveness of the professional public (Para. 92).

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Decision of the Fourth Board of Appeal of 6 March 2013 in Case R 1296/2011-4 (EN)

Article 52(1)(a) CTMR- Article 7(1)(h) CTMR

The applicant sought to register the figurative mark in the colours 'blue, grey and



yellow':

for goods and services in Classes 32, 35, 41 and 43.

Following the publication of the application, third party observations were submitted by the European Union, represented by the European Commission ('the cancellation applicant'). The Office was invited to reject the contested mark in accordance with Article 7(1)(h) and 7(1)(c) CTMR on the ground that the mark was an imitation of the official flag of the European Union. The relevant protected emblem is one of the official emblems of the European Union:



However, the examiner found that these observations did not give rise to serious doubts concerning the eligibility of the trade mark for registration and the mark was eventually registered.

The cancellation applicant filed an application for a declaration of invalidity against the registration, which was based on Article 52(1)(a) CTMR in relation with Article 7(1)(h) CTMR and Article 6*ter* of the Paris Convention because it was an imitation of the emblem of the European Union. It also claimed Article 7(1)(c) CTMR.

The Cancellation Division rejected the application for invalidity as unfounded stating, *inter alia*, that the contested mark could not be considered as a heraldic imitation of the European emblem from the perspective of the public targeted by the goods and services. The arrangement of the twelve mullets with one spike pointing vertically upwards, in a circle arranged according to a clock face on an azure field constituted an important part of the heraldic expression of the emblem. However, the contested mark contained only eleven stars, the mere partial colouring in blue did not correspond with the azure field of the European emblem and the word 'EUROPEAN' did not necessarily allude to the European Union as it formed part of the expression 'EUROPEAN DIAMONDS' which was conceptually linked with the graphic representation of a diamond. The Cancellation Division failed to see any specific link to the European Union and concluded that the contested mark could not be qualified as a heraldic imitation of the European emblem within the meaning of Article 6*ter* of the Paris Convention.

The cancellation applicant filed a notice of appeal against the contested decision together with a statement of grounds.

The Board found, contrary to the Cancellation Division's decision, that the CTM had been registered in breach of Article 7(1)(h) CTMR, which provides that 'trade marks which have not been authorised by the competent authorities and are to be refused pursuant to Article 6*ter* of the Paris Convention' shall not be registered as CTMs.

Article 6*ter* of the Paris Convention prohibits the registration of trade marks which consist of – or contain 'as elements of the trade marks' – flags, emblems and coats of arms of countries as well as those of international intergovernmental organisations, or are heraldic imitations thereof.

The mark is not an exact reproduction of the emblem but contains a circle of yellow stars. In accordance with Article 6*ter* of the Paris Convention, the question arises whether, in the present case, the contested mark contains an element which may be regarded as the European emblem or an imitation of it, as a whole or in its heraldic connotation.

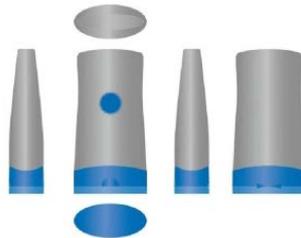
However, as pointed out in long-standing case-law, it is irrelevant that the circle of stars in the mark sought is not identical to that of the European emblem since the relevant public may have the impression that it is an imitation of that circle. The fact that the stars are not exactly the same size as those represented in the emblem is not decisive.

The Board annulled the contested decision and, therefore, declared the CTM invalid.

Decision of the Second Board of Appeal of 6 March 2013 in case R 784/2012-2- (ES)

Article 7(1)(b) CTMR

The applicant sought to register the following three-dimensional mark:



for products in Class 3.

The examiner decided that this 3D mark could not be registered as a CTM for goods in Class 3, on the grounds of Article 7(1)(b) CTMR, because it lacked distinctiveness for those types of goods.

The applicant filed a notice of appeal against the contested decision together with a statement of grounds.

However, the Board considered that it is clear from the wording of Article 7(1)(b) of Regulation No 40/94 that a minimum degree of distinctive character is sufficient to render inapplicable the ground for refusal set out in that article.

The Board added that the average consumer of goods in Class 3 is quite capable of perceiving the shape of the packaging of the goods concerned as an indication of their commercial origin, in so far as that shape presents characteristics which are sufficient to hold his/her attention.

The Board also pointed out that as regards the question of determining whether the mark applied for does or does not lack distinctive character, it is necessary to take into consideration the overall impression that it creates, which is not incompatible with a successive examination of the different presentational features used by this mark. It may be useful, in the course of the overall assessment, to examine each of the constituent features of the trade mark.

In this sense, the Board considered it important that the mark applied for contains a figurative element which has sufficient distinctive character *per se*, consisting of an irregular circular shape which simulates a rotatory movement:



As a consequence, the Board annulled the contested decision and accepted the CTM.