



### OHIM at INTA: Hong Kong

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### Editorial Team:

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**OHIM at INTA: Hong Kong**

The INTA Annual Meeting is a key date in the annual international IP calendar. It gathers together IP professionals from all over the world for discussion, debate and networking – and has become a fixture on the world IP circuit.

The fact that INTA 2014 is being held in Hong Kong underscores the fact that the Asia Pacific region is firmly centre stage. OHIM, which already has a number of projects running in the region, with national IP offices and the European Commission, will have a presence in Hong Kong, of course, and the Office has a full calendar of events planned while at INTA.

This month's Alicante News, therefore, has a distinctly Asian flavour. The editorial contains an interview with INTA CEO, Etienne Sanz de Acedo, ahead of the Hong Kong meeting. Inside the newsletter, you'll also find an analysis of design invalidity proceedings before the Patent Re-Examination Board of the State Intellectual Property Office of China. In our ETMDN News section, which is dedicated to OHIM's international cooperation, you'll also find all the details of OHIM's programme of activities at INTA 2014.

*Interview with Etienne Sanz de Acedo, CEO, INTA*

*The INTA Annual Meeting is the highlight of the international IP calendar: how important are these meetings, and what benefits can they bring for the users of IP rights in general?*

We're now operating in a global marketplace that is becoming increasingly integrated. Despite the fantastic technology at our disposal, nothing beats face to face interaction with clients. The Annual Meeting brings over 8,000 trademark practitioners together in one place. It also provides a unique opportunity for users to work with representatives from their IP Offices and vice versa. At the upcoming Annual Meeting, the JPO, OHIM, WIPO, the TM5 and a number of regional IP Attachés are hosting such sessions. This, I believe, is one of the key motivations for IP practitioners to attend the Annual Meeting: They can actually conduct much of their work for the year in just one week.

- *What is the relevance of hosting this year's inaugural INTA Annual Meeting in Asia as opposed to the usual North American circuit?*

The 2014 Annual Meeting in Hong Kong is already shaping up to be one of the Association's largest ever meetings. With four weeks to go to the event, we already have more than 8,000 attendees registered making it our biggest event ever outside from the US, this includes record turnout from Asia, with more than 2,400 attendees from that region.

Over the past decade, Asia-Pacific economies have come to play an increasingly important role in the global marketplace. The region is home to many established export economies, including Japan, South Korea and Taiwan. There are also a number of young consumer markets, such as Indonesia and Myanmar, where the middle classes are expected to expand dramatically over the next decade. And some countries, like China, are both major exporters and engines of consumer growth. IP activity in the region reflects this economic growth, with domestic and international filings in Asia-Pacific increasing sharply over the past few years.

- *INTA's broad global reach is one of its strengths. How does the European Trade Mark and Design Network, and its contribution to the world of Intellectual Property, fit with INTA's Mission Statement?*

The protection of trademarks is at the core of INTA's mission. Our mission statement was updated in January 2014 with the launch of our 2014-2017 strategic plan and the first of four strategic directions outlined in this plan is the protection of trademarks. In terms of protecting trademarks, harmonisation is highlighted specifically. Harmonisation has, and will always be, a priority for INTA and this is why INTA is a strong supporter of the European Trademark and Design Network.

- *How would you evaluate OHIM's long running participation at these annual meetings and how important is the OHIM-INTA partnership?*

The OHIM-INTA partnership is very important to INTA, and a real benefit to both OHIM users and INTA members alike. Over the years we have increasingly become more involved in OHIM's activities. In addition to our participation at the yearly OHIM Users Group meeting, we are now attending the twice-yearly meetings of the OHIM Administrative Board and Budget Committee, OHIM Liaison Meetings, and participating in the working groups of the Cooperation Fund and Convergence Programme as well as the Observatory. In the past few years the opportunities for INTA and other stakeholders to get involved with OHIM's activities, especially cooperation initiatives with EU national offices, has greatly expanded.

OHIM's participation in the INTA annual meetings is of real value to practitioners from around the world and provides a unique set of opportunities to learn more about trademarks in the EU. The OHIM booth in the Exhibition Hall is always very popular among attendees, who appreciate the opportunity to interact with OHIM staff as well as the OHIM industry update session. In addition to this, INTA officers will meet OHIM officials and the OHIM Observatory will be updating INTA members on the studies issued earlier in 2013.

- *Now that you have passed your 100 days as CEO of INTA, what are the challenges you face in your new role in the immediate and medium term?*

Well, approximately 300 days have already passed. The main challenge is to make sure we properly serve our members worldwide by defending and advancing trademark rights. To do so, we need to increase our advocacy efforts, expand our communications and initiate collaboration with new partners, and do so globally.

We recently launched our 2014-2017 strategic plan focused in four main areas: (1) the protection of trademarks, (2) communications, (3) international expansion, and (4) member satisfaction. This plan will guide INTA's activities and engagements for the next four years, and keep the Association mission-focused.

- *Can we expect to see INTA organising an event in OHIM's host city Alicante at any time in the future?*

Last September INTA hosted its Board of Directors meeting in Alicante for the first time - my first as INTA CEO. With so much happening in the EU, it was opportune for us to be at the home of the Community Trade Mark. This meeting was followed by a Government Relations Program that addressed many of the key issues relating to and impacting OHIM and EU national offices, as well as users of these systems. OHIM was a tremendous host to INTA for our Board Meeting and the Government Relations Program. The entire Board appreciated the value of hosting events in Alicante and of the special relationship between OHIM and INTA.

Next year INTA will host, for the first time ever, its TMAP (Trademark Administrators and Practitioners) meeting in Europe. This meeting will take place from 14 to 15 October 2015, and will be a major meeting for paralegals from Europe and around the world.

INTA is extremely thankful to OHIM and its President Mr. Campinos for hosting us. Alicante has become an IP hub in Europe. INTA is always pleased to come and visit OHIM and, and on a personal level, I am always happy to return to Alicante!

## Interview



### The James Nurton Interview

James Nurton speaks to Austrian trade mark lawyer Martin Reinisch of Brauneis Klauser Prändl Rechtsanwälte GmbH in Vienna about trade mark exhaustion, Customs enforcement and protracted litigation.

#### How did you become involved in trade marks?

I've been working in trade marks for more than 16 years. My first legal contact with trade marks was at the University of Amsterdam where I went on an Erasmus programme, and wrote a paper on the EU Trade Mark Directive. Then, after finishing my studies, I had an internship at the CJEU in Luxembourg in the Chambers of the Austrian judge.

It was at the time the *Silhouette* case was decided, and we were aware that this was an important decision with far-reaching consequences for the question of exhaustion of rights. As we know it came down in favour of the principle of European exhaustion, so this was a historic moment, which has had an impact on many subsequent trade mark cases in my later private practice.

Another benefit of that CJEU experience was that the working language of the Court is French so I had the opportunity to practise my language skills, which a lot of my French clients now appreciate!

**What were the first trade mark cases you worked on?**

After Luxembourg, I returned to Vienna and joined a law firm where right from the beginning I have been working in the field of trade mark law. One of the first trade mark cases I was involved with was for Versace. We were faced with a café that used the Versace name but without a licence: as the Trade Mark Directive was at that point not yet implemented in Austria regarding trade marks with a reputation, we still had to rely at that time on the unfair competition law to protect the reputation of the mark.

Also among my first trade mark cases was one for Jean-Paul Gaultier perfumes and concerned packaging that had been altered by parallel importers or had been imported from outside the EEA. This addressed the question of the territorial exhaustion of trade mark rights following *Silhouette*.

**What's the most unusual case you have worked on?**

As for the most unusual case I have been involved in, it has been going on for about 10 years and is still continuing so I cannot say too much. The last part of the first instance hearing was about two weeks ago and we are waiting for the judgment. If there are further instances, which is likely, the case could last 15 years in total!

It is part of a worldwide litigation (with cases for example in the US, Australia, Brazil and the Netherlands) about trade mark ownership in the beverage sector and involves many interesting arguments in different fields of law – not just trademark law, but also private international law, public international law, Soviet and Russian law and even human rights issues.

That is particularly interesting for me because my background is as a general lawyer and in Austria we have, at least to start with, to work in diverse areas to pass the bar exam, as well as having some experience in court. Therefore, in my first years as an associate I also worked for example in commercial law, private law and even asylum law. That broad background is beneficial when you have cases like this one.

**What kind of work do you do?**

We are a general practice law firm, and IP is one of our main fields of focus. Our IP department, which I head, consists of two lawyers, two associates and three paralegals. We do mainly IP litigation for international brand owners, but also some prosecution before OHIM and the Austrian office. I am now working on two cases referred to the CJEU General Court from OHIM, which have interesting multi-national issues concerning unregistered rights some of which enjoy reputation. The two cases involve each party opposing the other side's trade mark.

**What about prosecution work?**

Most of the trademark prosecution work we do is before the Austrian Patent Office for local clients. We also do work before OHIM regularly and I think the quality of its decisions is very good. One criticism is that OHIM's understanding of prior rights under national law could sometimes be improved in my view.

But overall I would say OHIM compares very favourably with the Austrian office for predictability and timeliness: OHIM has improved in this respect in recent years.

There have been some changes to improve the system in Austria, and a recent change in competencies has moved the second instance from the Patent Office to the civil courts along with the third instance. That should help improve consistency and timeliness, and we will see the results soon.

**What issues are you facing now?**

One hot topic where we are seeing a lot of work is new gTLDs, which can be a big threat for many trade mark owners. There is lots of potential for abuse, and many clients are not aware enough of the problem. You have to strike a balance between the cost and the business risk, which in my experience is often underestimated.

Another trend is anti-piracy. We act for a large mobile phone producer and we have seized more than 100,000 items in the last four months, which is more than in the whole of 2013 in Austria. Many of these come from the Far East via Vienna airport but destined to some extent also for the Czech or Slovak Republics.

Customs are very proactive in making seizures, they are well-resourced and have a good database. The Customs offices are very cooperative and knowledgeable, which makes it easier for us to get the necessary evidence together before going to court. We are also part of a network of firms handling Customs work in Europe so we can coordinate and offer clients to cover the whole EU and other parts of Europe with just one point of contact.

Another benefit we have had in Austria for many years already is the concept of implied consent to destruction, so if the other side does not object it is easy to get the goods destroyed.

**What long-term trends do you see?**

I think the single biggest thing is the internet, not just with the launch of new gTLDs, but because it makes it much easier for infringers to abuse trade marks. That will be more and more important. Both the national and European legislation bodies as well as IP holders will have to adapt quickly to the growing threat of internet infringers. It is often said that the law is one step behind the technology, which is true. In fact, in Europe you could say it is often two steps behind because of the complexity of passing EU legislation.

Community Trade Mark

CTM

**Third Party Observations**

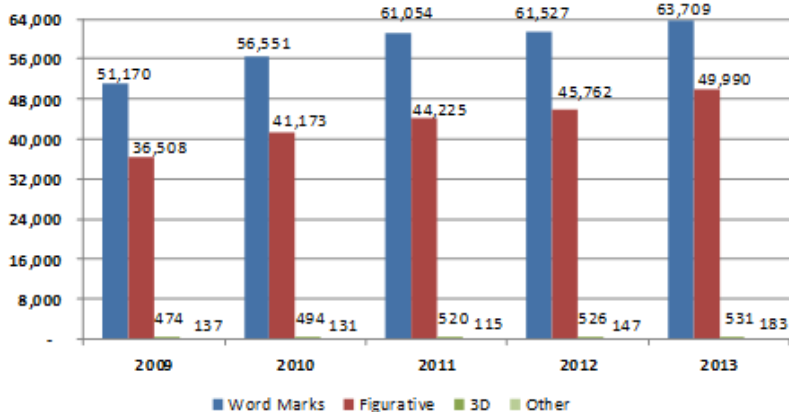
Third party observations (TPOs) are an option available to the general public for informing OHIM that a Community trade mark application ('CTMA') should be refused on the basis of a specific absolute ground for refusal. Its legal basis lies in Article 40 of Council Regulation (EC) No 207/2009 of 26/02/2009 on the Community trade mark ('CTMR') and the Communication of the President No 02/09. After receiving a TPO, the Office for Harmonization in the Internal market (OHIM) analyses whether the examination of the corresponding CTMA should be reopened.

The purpose of this article is to provide an in-depth analysis of the trends of the Third Party Observations filed during the year concerned and a comparison with previous years.

1. TPOs filed

The following chart shows an overall analysis of the CTMAs per type filed during the period 2009-2013.

Chart 1. Total CTMAs filed per type

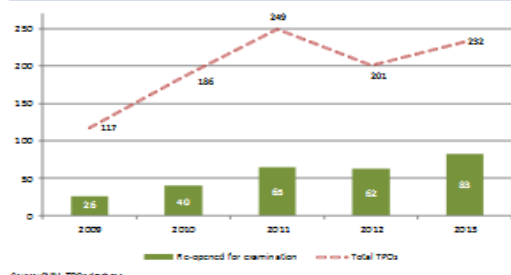


Source: OHIM, Quality Management Service Department Statistics

	Total CTMAs	TPOs filed	%
2009	88,289	117	0.13%
2010	98,349	186	0.19%
2011	105,914	249	0.24%

From 2009 to 2011 there was an increase in the percentage of CTMAs that received TPOs; however, in 2012 this behaviour changed. In 2013, TPOs represented only 0.20% of the total CTMAs filed, which shows a similar tendency compared to 2012.

Chart 2. TPOs re-opened for examination 2009 - 2013



Source: OHIM, TPO database

2. TPOs that re-opened the examination



During 2009 and 2010, 22% of the total TPOs led to a re-opening of the examination; however, 2011, 2012 and 2013 showed a significant increase of 26%, 31% and 36% of re-opened examinations, respectively. This tendency suggests that TPOs have tended to become more focused in recent years.

Despite the fact that there was a significant increase of re-opened TPOs, it is important to bear in mind as stated previously in this report that the total number of TPOs represents only 0.13%- 0.24% of the total CTMAs filed.

### 3. Geographic TPOs

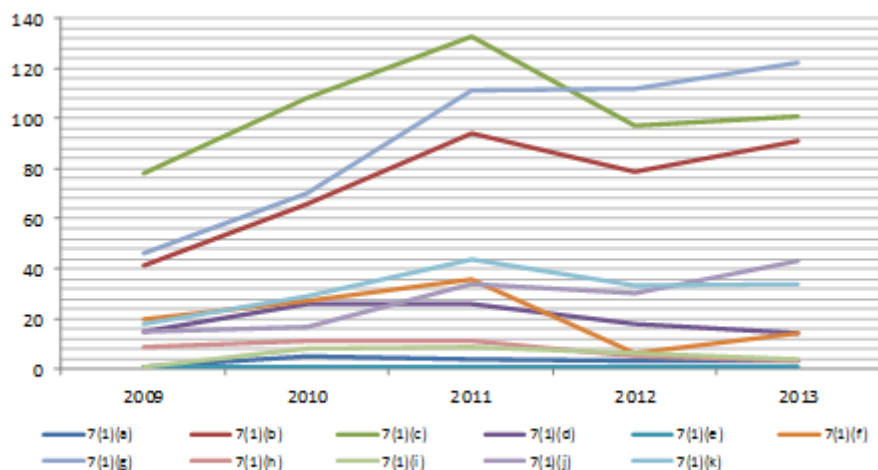
From 2009 to 2013 a total of 985 TPOs were filed, of which 39% involved a Geographic term.

In 2013 a total of 102 geographic TPOs were filed, that is 44% of the total TPOs filed that year, 6% less than the previous year.

### 4. TPOs filed by Absolute Grounds

Most of the TPOs filed from 2009 through 2011 were under the absolute ground for refusal of Article 7(1)(c). However, from 2012 TPOs were principally based on the Article 7(1)(g). On the other hand, Article 7(1)(e) was the absolute ground for refusal that had the lowest TPOs registered during the same period.

Chart 4. TPOs per Absolute Ground 2009-2013



Source: OHIM, TPOs database

In 2013, most of the TPOs filed were under the grounds for refusal of Article 7(1)(g), Article 7(1)(c) and Article 7(1)(b).

The following table shows the number of TPOs that the OHIM received from 2009 to 2013 per Absolute Ground.

	2009	2010	2011	2012	2013
7(1)(a)	1	5	4	3	3
7(1)(b)	41	66	94	79	91
7(1)(c)	78	108	133	97	101
7(1)(d)	15	26	26	18	14
7(1)(e)	1	1	1	1	1
7(1)(f)	20	27	36	6	14
7(1)(g)	46	70	111	112	122
7(1)(h)	9	11	11	5	3
7(1)(i)	1	8	9	6	4
7(1)(j)	15	17	34	30	43
7(1)(k)	18	29	44	33	34

Source: OHIM, TPOs database

In summary, the number of TPOs is rather small compared with the number of CTMAs. At the same time, recent years figures show an increase of re-opened examinations. In combination, it may be concluded that while the ex-officio examination carried out by the Office meets expectations, TPOs are indeed a successful means of pointing out discrepancies affecting other parties' interests.

## Design Invalidity Proceedings before the Patent Reexamination Board of the State Intellectual Property Office of the P.R. China

*The following article is a summary of a presentation given by Yang Fengyun to the members of the KC Designs. Yang is a member of the Patent Reexamination Board and has come to OHIM for a five month stay at the Board of Appeals in the framework of bilateral cooperation with China (organised by OHIM's Cooperation Programmes Service) in order to study the appeal procedure in relation to invalidity proceedings.*

The Patent Reexamination Board (PRB) is affiliated to the State Intellectual Property Office of P.R.C. Up to now, PRB has over 400 staff members and is composed of 6 functional offices, a registry division, a litigation division and 14 examination divisions. Every examination division deals with two types of cases, namely re-examination cases (ex parte) and invalidation cases (inter partes). For invalidation cases, PRB is the first instance.

Since 2010, the number of members of the Design Division has been continuously increasing with four or more experienced patent examiners entering as new members every year. At present, the Design Division comprises 26 members and one secretary. Contrary to other examination divisions of the PRB, most cases dealt with by the Design Division are invalidation cases and only a few are re-examination cases. Most re-examination cases are decided in written proceedings. In the majority of invalidation cases oral hearings are held either in Beijing or in some of the provinces outside of Beijing.

Most cases are examined by a board composed of three members, including a chairperson, a first member (rapporteur) and a second member. Cases involving legal or economic aspects of particular importance will be examined by a panel of five members. After at least two years of membership members can apply to work also as a chairperson. There are many chances to be a chairperson in each year.

As regards invalidation cases, the first member usually decides whether or not to hold an oral hearing. Before the hearing, the board deliberates the case and identifies the main issues to be investigated. Oral hearings are open to the public and presided by the chairperson with the other members having the possibility to ask questions to the parties. Sometimes, the first member may preside over the investigation of the evidence. After the hearing, the first member drafts the decision which is then circulated electronically among the members of the board in two rounds.

Examination of design cases by the PRB is governed by the Chinese Patent Law, the Patent Law Implementing Regulation and the Patent Guidelines. Applications for a declaration of invalidity can be based on Articles 2, 5, 9, 23, 25, 27 and 33. Article 27 relates to clear representations and clear scope of protection. Article 25.1(6) relates to two dimensional printing goods which serve mainly as indicators of trade origin, for example labels, the main purpose of which is to help the public to identify the origin of the related products or services. They are exempted from design protection with the intention to draw a line between design rights and trade mark rights. There are no articles corresponding to Article 27 and Article 25.1(6) to be found in the Community Design Regulation. On the other hand, there exist no provisions in China regarding the notions of 'visibility' and 'normal use' (Article 4(2) CDR) or the 'technical function' of a design (Article 8 CDR).

One of the central provisions is Article 23 which was amended in 2008 and reads as follows:

- (1) Any design for which a patent right may be granted shall not be a prior art design, nor has any entity or individual filed before the date of filing with the patent administrative department under the State Council an application relating to the identical design disclosed in patents documents announced after the date of filing.*
- (2) Any design for which a patent right may be granted shall significantly differ from prior designs or combination of prior design features.*
- (3) Any design for which a patent right may be granted must not be in conflict with the legitimate right obtained before the date of filing by any other person.*
- (4) The prior design referred to in this Law means any design known to the public before the date of filing in China or abroad.*

The first paragraph is equivalent to the test of 'novelty' and the second paragraph is equivalent to the test of 'non-obviousness'. The third paragraph addresses the conflict with prior rights, including trademarks, copyrights and so on. According to the second paragraph, the contested design may be declared invalid based on combination of prior design features, a possibility not foreseen in the CDR.

The Guidelines provide for the important concept of the 'normal user' who is a fictional person. A normal user should have common knowledge of designs and commonly used methods in relation to the same or similar products and have a certain capability of distinguishing the different features without paying attention to the minor differences in shape, pattern or colour of products. A normal user will examine the designs following the important principle of global observation and comprehensive assessment. Based on the fictional person of the normal user and this principle, the board takes the design corpus into consideration and assesses the weight of different features in the whole overall impression.

In the last three years the number of invalidation cases received by the PRB keeps gradually increasing. In 2012 a peak was reached with over 1000 invalidity applications filed. The average number of cases closed is about 700 per year which corresponds to 50 cases closed by every member in his/her role as first member.

A member of the PRB has several roles to play, first member, second member, chairperson, representative in court, quality inspector and researcher. In case a decision issued by the PRB is appealed, members of the board, in particular the first member will appear in court as a first representative of the PRB together with a second representative from the legal department of the PRB. Every year, a group of members devote time to in-depths studies of specific topics of design law taking into account the Design Guidelines of the Japanese Patent Office, the Guidelines of US Patent and Trade Mark Office and the decisions of the 3<sup>rd</sup> Board of Appeal of OHIM.

Since there are many differences between the PRB and the Boards of Appeal at OHIM, there are many issues worthwhile to be discussed and studied and I hope that this exchange of ideas and experiences between the two institutions will continue.

## EUTMDN Updates

### OHIM at INTA

The Office has over many years been an enthusiastic exhibitor at the INTA annual meeting and this year is no exception. Accompanied by two National Office representatives from Poland and Spain, OHIM's experts will be keen to meet as many conference-goers at their stand – number 323 – as possible. There will be live demonstrations of OHIM's online global tools as part of the European Trade Mark and Design Network, and OHIM experts will be on hand to answer any questions.

The OHIM actively engages in INTA's educational programme by moderating three Table Topic sessions during the annual meeting. TM67 will update participants on Community trade mark absolute and relative grounds for refusal; TT70 will report on Registered Community designs and a new topic this year, TW67, will outline the Observatory's most recent developments.

On Sunday May 11 for two hours starting at 14:30 in Convention Hall A the Office holds its OHIM information meeting. From the new Guidelines to the new website, from recent changes in practice to a review of the most important Court of Justice decisions, all will be covered in the presentations. Audience members are invited to ask questions and join in the debate.



## Denmark joins the Harmonised Database

The Danish Patent and Trademark Office (DKPTO) has joined the Harmonised Database of Goods and Services.

More than 60,000 terms are shared by the participating offices. DKPTO is the 24th office to integrate into the database. As a result, the Danish translations of the Database are now available to all users through TMclass.

More News



## Visit of President Barroso

The President of the European Commission, Jose Manuel Durão Barroso, visited OHIM on April 10. It was President Barroso's first visit to OHIM, and in the course of a full itinerary, he met OHIM staff and the Office's President, António Campinos, and inaugurated the auditorium in the Office's new wing as "Auditorio Europa".

## 11th Liaison Meeting on Trade Marks

OHIM hosted the 11th Liaison Meeting on Trade Marks in its Alicante headquarters from 8-9 April. Representatives of 32 international industrial property offices, including WIPO, and five user groups, received updates on the progress of the five Convergence Programme projects and the achievements of the Cooperation Fund. Delegates also heard updates on the work of the EU Observatory on Infringements of Intellectual Property Rights, a department within OHIM, and the OHIM Academy.

## OHIM's updated Service Charter published

OHIM's Service Charter, updated for the last quarter of 2013, has been published, and can be accessed here

The Office's Service Charter measures performance against timeliness (how long it takes to deliver services like registration, cancellation, opposition or appeals); accessibility (how quickly and how well the Office makes services available to users via phone and e-mail, and how available its e-business services have been) and quality of decisions (how its decisions measure up against agreed quality standards).

There have been some slight changes to the Service Charter in the last quarter of 2013. The calculation of the 'e-Business Availability Indicator' has been adapted to display an 'availability as perceived by users' – putting more emphasis on the times when a greater number of users were logged on to the OHIM website. This change was done to give an accurate picture of the impact that the problems with the new OHIM website, which started on December 2, 2013, had on users. It did show that despite only 93% availability in December, the overall quarter outcome was only slightly down compared to the rest of the year.

Similarly, the issues associated with OHIM's website led to a jump in calls and emails to the Office's user contact service. However, the Office increased the number of staff in the service, allowing the response time for calls, emails and complaints to still respect the timeliness standards, despite the increased volume.

In the Quality indicators section there is a change too. Since October 2013, quality checks have been extended to cover the full range of examination proceedings, including classification, formalities, priorities/seniorities and general processes like withdrawals and limitations. The figure for quarter 4 2013 represents the quality check results of all those examination processes.

## Nice & Vienna Classification Training for ASEAN IP officials

OHIM hosted a number of IP officials from ASEAN countries on April 2 and 3.

Delegates from all ten ASEAN countries - Brunei, Cambodia, Indonesia, Laos, Singapore, Thailand, Malaysia, Philippines, Myanmar and Vietnam attended training courses enabling participants to acquire and exchange knowledge and practices in the classification field of trade marks.

OHIM is the implementing agency for the ECAP III project and also supports the ASEAN IPR Action Plan 2011-2015.

## Launch of survey on protection and enforcement of Intellectual Property Rights outside the EU

The EU Observatory on Infringements of Intellectual Property Rights has launched [a survey](#) of EU businesses and EU IP professionals who have an interest in the protection and enforcement of Intellectual Property Rights (IPR) in non-EU countries. The Observatory is carrying out the survey on behalf of the EU Commission (DG Trade) which has carried out similar surveys in the past.

The purpose of the survey is to gather information, from those involved with and interested in IP rights in non EU countries, in order to build up a picture of the reality of IPR protection and enforcement in countries outside the EU.

The Observatory will collate the responses and send them to DG Trade, which will then use them, along with information from other sources, to put together analyses of the situation in non EU countries.

DG Trade will also use this information to compile its own reports on the general IPR enforcement scene in non-EU countries, as well as the situation in individual countries.

[The survey is](#) open until June 10, and will be one of the tools used to help improve the IPR enforcement scene in non-EU countries, so the views of EU businesses and EU IP professionals with experience or interest in this area would be particularly welcome.

## OHIM's IP Mediation Conference – registration now open.

There is still time left to register for OHIM's first ever IP Mediation Conference, which will take place in Alicante on May 29 and 30.

The theme of the conference is "bringing stakeholders together", and with a wide range of speakers from the public sector, the private sector and users of mediation services, the two days of discussion and debate promise to be interesting and thought-provoking.

The conference programme is [available here](#).

The conference focuses on the practical uses of mediation, with experts from WIPO, the EPO, OHIM, the UK Intellectual Property Office and the Portuguese Industrial Property Office, among others.

Key user associations, like INTA and ECTA, will also contribute to the conference, giving the user perspective on mediation in IP.

Experts from private practice and from the world of mediation training will share their experiences and views.

The registration cost is €150.

## Monthly statistical highlights\* March 2014 compared to March 2013

	2014	2013
Community trade mark applications received	9 938	9 797
Community trade mark applications published	8 417	9 229
Community trade marks registered (certificates issued)	9 030	8 246
Registered Community designs received	8 000	7 890
Registered Community designs published	6 882	6 809

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

## Case law



### Luxembourg Case Law

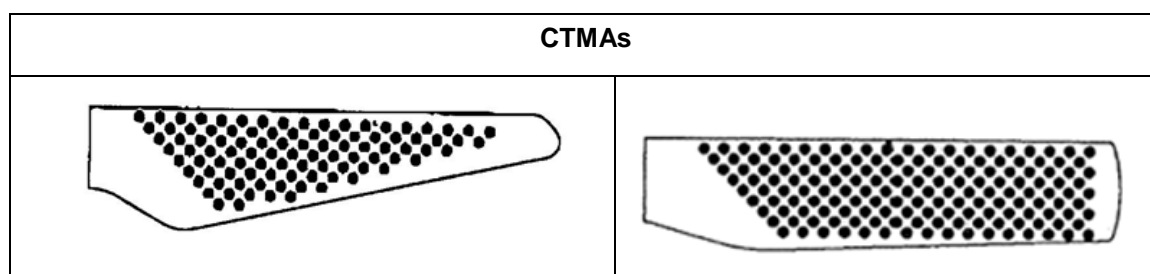
#### A: Court of Justice: Orders, Judgments and Preliminary Rulings

**Case C-337/12P; (Joined Cases C-337/12P to C-340/12P); Pi-Design and Others v Yoshida and OHIM (C-337/12P and C-339/12P) and OHIM v Yoshida (C-338/12P and C-340/12P); Judgement of 6 March 2014. Language of the case: EN**

**RESULT: Actions upheld (GC Judgments set aside)**

**KEYWORDS: Filing date, Distinctive element, Function of trade mark, Three dimensional mark, Figurative trade mark, Contrary to public policy, Graphical representation, Geographical origin, Shape of the products**

**FACTS:** When the CTM owner registered the figurative marks represented below as CTMs for goods within Classes 8 and 21, the Cancellation Division rejected the applications for a declaration of invalidity. On appeal, the Board of Appeal (BoA) declared the registrations invalid based on Article 7(1) (e) (ii) CTMR. The CTM owner appealed to the General Court (GC). The GC upheld the appeal. In particular, the GC found that “the concave character of the black dots is not part of the contested trade mark as filed and registered. There is nothing in the graphic representation of the contested mark to suggest that the black dots in question represent dents rather than a figurative pattern. Likewise, the registration of the contested mark was not accompanied by any description to that effect. Therefore, in concluding that the dots were concave in character, the Board of Appeal did not refer to the sign as filed, but to representations of the goods actually marketed by the applicant’. The GC considered that no account could be taken of the proof of current use of the signs at issue given that ‘only the shape as reproduced in the registration application may be the subject-matter of the examination of the trade mark’. The invalidity applicant and the Office appealed to the CJ, alleging, inter alia, a breach of Article 7(1) (e) (ii) CTMR.



**SUBSTANCE:** Article 7(1) (e) (ii) CTMR: It is necessary to assess the essential characteristics of the signs at issue and their technical function (Para. 68). The possibility afforded in *Lego Juris v OHIM* (C-48/09) to the competent authority when examining a three-dimensional sign can be extended to the examination of any sign constituted by the shape of goods within the meaning of Article 7(1) (e) (ii) CTMR (Para. 55). However, the requirements which must be satisfied by the graphic representation in order to fulfil its function cannot restrict the competent authority's examination under Article 7(1) (e) (ii) CTMR in such a way as might undermine the public interest underlying that provision (Para. 58). When determining the essential characteristics of a sign, account can be taken of the actual use made of the trade mark following its registration (Para. 61). The European Court of Justice (CJ) referred in this respect to the Case-Law of the GC, in which it stated that the material which, although subsequent to the date of filing the application, enables conclusions to be drawn with regard to the situation as it was on that date can be taken into consideration (Orders in C-192/03 P *Alcon v OHIM* (Para. 41) and Case C-5/10 P *Torresan v OHIM*) (Para. 60). In addition, the CJ noted that some of the evidence submitted by the invalidity applicant predated the filing date of the contested CTMs (Para. 63). Since the GC did not apply the provision of Article 7(1) (e) (ii) CTMR correctly, there was no reason to examine further grounds of appeal (Para. 66).

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

**Case T-513/12 NCL Corporation Ltd. v OHIM; Judgment of 23 January 2014; Language of the case: DE**

**RESULT: Action dismissed**

**KEYWORDS: Absolute Grounds, Descriptive element, Distinctive element, Distinctiveness acquired by use, Series of trademarks**

**FACTS:** The applicant sought the registration of the CTM **Norwegian Getaway** for services in Class 39. The examiner held that the mark is descriptive and lacks distinctive character (Article 7 (1) (b) and (c) CTMR). The Board of Appeal (BoA) upheld that decision.

**SUBSTANCE:** The General Court (GC) confirms that the target public of services as "arranging of cruises" and "Cruise ship services" in Class 39 is composed, inter alia, of the average attentive public. The argument of the applicant, that cruises are very expensive and, therefore, the attentiveness of the public would be very high, has been refused. These kind of cruise travels may not be considered, compared to other ways of travelling, as that expensive (Para. 27). The applicant puts forward that the term "Norwegian" would refer to the applicant itself, since it has a series of marks containing that word and the public would recognize it as referring to the applicant's travel undertaking. The GC stated that the applicant did not invoke Article 7 (3) CTMR which, following the systematic of Article 7 CTMR, is the only provision on which the use of a sign may be relied on for the purpose of that Article (Paras. 35 and 36). The alleged infringement of Article 7 (1)(c) CTMR by not investigating, on its own motion, if the expression "Norwegian" would be seen as a reference to the applicant has been rejected by the GC. The reputation of the applicant is not relevant for the application of that ground for refusal and the BoA rightly concluded that the term "Norwegian" is purely descriptive (Paras. 40 and 41). The GC also concluded that the sign as a whole merely refers to a short holidays ("Getaway") together with a territorial reference to Norway ("Norwegian") (Paras. 49, 54). The GC confirms the case-law according to which decisions from authorities outside the EU are not binding for the assessment of whether a sign may be registered as a CTM (Para. 63).

Case T-514/12 NCL Corporation Ltd. v OHIM; Judgment of 23 January 2014; Language of the case: DE

**RESULT:** Action dismissed

**KEYWORDS:** Absolute Grounds, Descriptive element, Distinctive element, Distinctiveness acquired by use, Series of trademarks

**FACTS:** The applicant sought the registration of the CTM **Norwegian Breakaway** for services in Class 39. The examiner held that the mark is descriptive and lacks distinctive character (Article 7 (1) (b) and (c) CTMR). The Board of Appeal (BoA) upheld that decision.

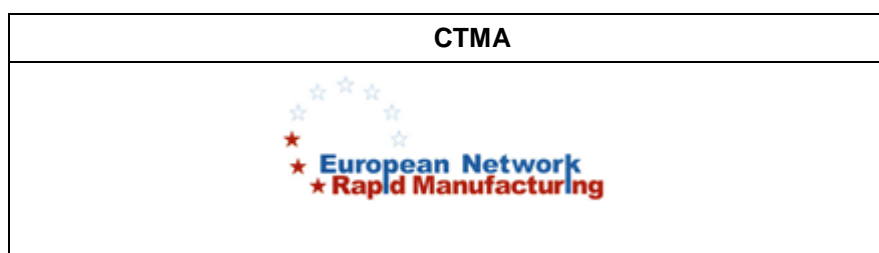
**SUBSTANCE:** The General Court (GC) confirms that the target public of services as “arranging of cruises” and “Cruise ship services” in Class 39 is composed, inter alia, of the average attentive public. The argument of the applicant, that cruises are very expensive and, therefore, the attentiveness of the public would be very high, has been refused. These kind of cruise travels may not be considered, compared to other ways of travelling, as that expensive (Para. 27). The applicant puts forward that the term “Norwegian” would refer to the applicant itself, since it has a series of marks containing that word and the public would recognize it as referring to the applicant’s travel undertaking. The GC stated that the applicant did not invoke Article 7 (3) CTMR which, following the systematic of Article 7 CTMR, is the only provision on which the use of a sign may be relied on for the purpose of that Article (Paras. 35 and 36). The alleged infringement of Article 7 (1)(c) CTMR by not investigating, on its own motion, if the expression “Norwegian” would be seen as a reference to the applicant has been rejected by the GC. The reputation of the applicant is not relevant for the application of that ground for refusal and the BoA rightly concluded that the term “Norwegian” is purely descriptive (Paras. 40 and 41). The GC also concluded that the sign as a whole merely refers to a short holidays (“Breakaway”) together with a territorial reference to Norway (“Norwegian”) (Paras. 49, 54). The GC confirms the case-law according to which decisions from authorities outside the EU are not binding for the assessment of whether a sign may be registered as a CTM (Para. 63).

Case T-430/12; Heinrich Beteiligungs GmbH v OHIM; Judgment of 13 March 2014 Language of the case: DE

**RESULT:** Action dismissed

**KEYWORDS:** Absolute grounds, Emblem, Figurative trademark

**FACTS:** The Board of Appeal confirmed the rejection of the CTM application for the mark for goods in Classes 6, 7, 12, 17 and 42 pursuant to Article 7(1)(h) CTMR in conjunction with Article 6ter Paris Convention. It decided that the CTM application contained a heraldic imitation of the European emblem and that the use of the latter may suggest a connection between the CTM applicant and the European Union. The CTM applicant filed an action to the General Court.



**SUBSTANCE:** The General Court confirmed the decision. The European Emblem is protected as an emblem of an international organisation against the use of a heraldic imitation thereof in a trade mark under the condition that this use



can suggest to the public that a connection exists between the European Union and the user, Article 6ter (1) (c) Paris Convention (Para. 21). The comparison has to be based on the heraldic description of the emblem (Para. 36). The assessment if the trade mark contains a heraldic imitation of an emblem has to be made from the perspective of the relevant public that may not notice every difference that would be noticed by a professional from the field of heraldic (Para. 38 with a reference to previous case-law). Different artistic interpretations of an emblem with the same heraldic descriptions are possible (Para. 39). Use of a part of an emblem in the trade mark can be a heraldic imitation (Para. 40). The CTMA contains an imitation from the heraldic point of view of the European emblem, as it takes over its only motive – the circle of stars (mulletts) which ends do not touch each other (Para. 44). Even if only nine stars are presented in the trade mark, the public will realise that the other three are covered by the word element (Para. 45). The public will perceive the circle of stars (mulletts) as the European emblem even if some of them are red and some white with blue contours (Para. 48). It is sufficient that a trade mark contains an element the description of which could be confused with the description of an emblem to conclude it contains a heraldic imitation of that emblem (Para. 51). The protection of the emblem of an international organisation applies first, when its use in the trade mark in connection with the relevant goods and services could mislead the public to think that those goods and services come from the international organisation. It applies, however, also in situations, when the public could believe that the goods and services are offered under a guarantee of the international organisation or that there is another kind of connection (Para. 62). In order to conclude if the public may be misled about a connection between the trade mark owner and the international organisation an overall assessment of the trade mark is necessary (Para. 63). In the case at hand, the mark contains a figurative element (a heraldic imitation of the emblem) and a word element “European” and that lets the public think about the European Union (Paras. 65-67). The relevant goods and services fall within the scope of the competences of the European Union (Para. 68).

**Case T-291/12; Deutsche Bank AG v OHIM; Judgment of 25 March 2014 Language of the case: EN**

**RESULT: Action dismissed**

**KEYWORDS: Absolute grounds, Laudatory mark, Slogan mark, Principle of non-discrimination**

**FACTS:** The applicant sought to register the word sign **PASSION TO PERFORM** as a CTM for services in Class 35 (e.g. advertising), 36 (e.g. insurance, financial affairs), 38 (telecoms), 41 (e.g. education) and 42 (e.g. scientific and tech services). The examiner rejected the CTMA on the basis of Article 7(1) (b) CTMR. The Board of Appeal (BoA) dismissed the appeal, finding that the sign was devoid of distinctive character. The applicant appealed to the General Court, arguing an infringement of Article 7 (1) (b) CTMR.



**SUBSTANCE:** The BoA did not apply overly strict criteria for establishing the distinctive character of an advertising slogan, and it properly held that the CTMA would not be immediately perceived as an indication of commercial origin of the services in question, but would be perceived merely as a laudatory statement (Para. 22), conveying a clear message to the Anglophone public (Para. 41) that the applicant promised its clients that it would perform with passion (Para. 40). Each category of services was properly analysed (Para. 24). Nor did the Board err as to the assessment of the level of attention of relevant public, (Para. 29) the public at large including professionals, noting that the word combination was common parlance and not specialist terminology (Para. 30). Even if the level of attention of the relevant public can vary according to the goods or services claimed, the Court held that the relevant public here had a low level of attention given the promotional nature of the mark at issue (Para. 33). Nor did the Board err in finding no plausible various meanings of the word combination (Para. 42) Taken as a whole, and in light of the services, it could only have one meaning (Para 55: the meaning is clear and precise in relation to the services). Further, with regard to the alleged ‘resonance’, neither the alleged alliteration (Para. 49), the ‘emotional’ content (Para. 53), the shortness of the phrase (Para. 52) nor its incomplete nature (Para. 52) were sufficient to imbue the word sign with distinctiveness, since such aspects were normal in promotional phrases and the phrases respect the semantic and grammatical rules of English (Para. 52). Additionally, the applicant’s arguments were rejected concerning the earlier use and national registrations. The CTM regime is autonomous (Para. 59) and, in any case, the applicant gave no details regarding the grounds on which national authorities had made decisions (Para. 60). Breach of principle of equality: C-51/10 P Agencja Wydawnicza Technopol obliges the Office to take into account CTM registration decisions in respect of similar applications and consider with special care whether to decide in the same way (Para. 65), but this cannot result in taking advantage of a possibly unlawful act (Para. 66) and here the Board carried out a comprehensive and specific examination of the CTMA, and another finding was not possible (Para. 68).

Joined Cases T-534/12 and T-535/12; Still GmbH v OHIM; Judgment of 26 March 2014; Language of the cases: DE

**RESULT:** Actions dismissed

**KEYWORDS:** Absolute grounds, Complex mark, Figurative element, Specialized public, Internet, Right to be heard, First time on appeal

**FACTS:** The applicant sought to register the complex marks 'Fleet Data Services' and 'Truck Data Services', shown below, as CTMs for goods and services within Classes 9, 12, 35, 36, 37 and 39. The examiner refused the signs on the basis of Article 7(1) (c) and (b) CTMR and was confirmed by the Board of Appeal (BoA). The applicant appealed to the General Court (GC).

T-534/12	T-535/12
	

**SUBSTANCE:** The GC focused its analysis on Article 7(1) (b) CTMR. It agreed that the signs lacked distinctive character. The goods and services (*inter alia*, industrial cargo vehicles, management of vehicle fleets using software etc.) are directed at a professional public (Para. 13, undisputed), including consumers in those Member States in which English is an official language as well as professionals in the area of vehicle fleet management in the entire EU (Para. 13, undisputed). The relevant public would not understand the signs as a reference to the commercial origin, but as (advertising) indications in relation to the goods and services. They show that the goods and services serve the collection of data in relation to vehicle fleets and trucks and thereby allow an increase in efficiency of those vehicle fleets, an important characteristic of modern transport companies and fleets (Para. 16). The word element of the signs is easily understandable and has no originality in relation to the English language (Para. 23). The GC rejected the applicant's argument that the signs are distinctive through the addition of the figurative element. The figurative element has a direct connection to the meaning of the word elements (Para. 23) as it is made up of radio waves (Para. 22) and merely shows a network connection (Para. 25). The figurative element does not make the combination into more than the mere sum of its components. Since the signs lack distinctive character under Article 7(1) (b), it is not necessary to decide on Article 7(1) (c) CTMR (Para. 30). Finally, as regards the applicant's argument that the Board had breached its right to be heard by stating, for the first time in the BoA decision, that the figurative element shows radio waves, the GC found that, as the applicant itself states that the figurative element shows radio waves, it could not have defended itself any better, if it had known before the BoA decision that the Board would make this statement (Para. 35). The Board's statement that the figurative element, by itself, is not registrable is only supplementary and has no bearing on the decision to reject the complex signs for lack of distinctive character (Para. 36).

Case T-356/12; Debonair Trading Internacional Ld<sup>a</sup> v OHIM; Judgment of 3 April 2014; Language of the case: EN

**RESULT:** Action partly upheld (BoA decision (partly) annulled)

**KEYWORDS:** Admissibility, Likelihood of confusion; Series of trademarks, Substantiation of earlier rights, Sign used in the course of trade, Reputation, Passing off, Proof of use, Error by party, Non-registered trademark, Multiple applications, Dissimilarity of signs

**FACTS:** An opposition was filed against CTMA "SÔ: UNIC" on the grounds of Articles 8(1) (b) and 8(4) CTMR. It was based on 24 earlier national or Community marks, all containing the word element "so... ?", including "SO... ? ONE", "SO... ? CHIC" and a number of non-registered word marks, protected in the European Union. The Opposition Division

dismissed the opposition under Article 8(1) (b) CTMR, in so far as there was no likelihood of confusion and, in relation to Article 8(4) CTMR, because the use of certain of the earlier signs had not been proven, other signs were considered not similar to the mark applied for and for other signs the national law was not applicable. The Board of Appeal dismissed the opponent's appeal, as far as Article 8(1) (b) CTMR was concerned, because there was no likelihood of confusion between the signs. In relation to Article 8(4) CTMR, the Board held that the opposition was not admissible according to Rule 15(2) (b) (iii) CTMIR, since the applicant had indicated that the opposition was based on non-registered marks in the European Union, whereas such a category of intellectual property rights did not exist. The opponent filed an action before the General Court.


**SUBSTANCE:** The General Court partly dismissed the appeal. It found that the Board did not err in finding that the element 'so...?', common to the earlier marks, was not reproduced identically in the mark applied for and, in particular, the element 'unic' in the mark applied for was not an English expression like those of the earlier marks. Therefore, the Board correctly found that the family of marks argument raised by the opponent was to be dismissed and that a risk of confusion was to be excluded (Paras.-20 to 31). Regarding the alleged infringement of Rule 15(2) (b) (iii) CTMIR, the Court firstly noted that it is not true that the opponent had not provided a representation of the earlier signs used in the course of trade. Since they are word signs, the reference to them in the corresponding pages of the notice of opposition must be considered to be a representation of those signs (Para. 43). Then the Court noted that in the letter attached to the notice of opposition the opponent claimed that "Leaving aside the registrations of the opponent's marks, the opponent has the right to prevent use of the mark applied for in the UK and Ireland at least on the basis of the law of passing off and in other Community [S]tates on the basis of the law of unfair competition having regard to the extensive goodwill and reputation earned". In light of the above, the GC held that the opponent incorrectly checked the box entitled 'EM'. This fact, however, did not render entirely inadmissible its opposition based on Article 8(4) CTMR. The information provided in the notice of opposition and in the attached letter made it possible to understand that it was claiming protection for the non-registered marks in the United Kingdom and in Ireland under the rules on passing off (Paras. 44 to 48). Therefore, the Board erred in declaring inadmissible the opposition founded on Article 8(4) CTMR.

**Case T-568/12 Sofia Golam v OHIM; Judgment of 4 April 2014; Language of the case: EN**

**Keywords:** Relative grounds, Relevant territory, Identity of goods & services, Visual similarity, Phonetic similarity, Conceptual similarity, Likelihood of confusion, Bad faith

**RESULT:** Action dismissed

**FACTS:** The applicant sought to register the figurative mark **FOCUS** reproduced below for goods in Class 25. The following opposition was based on the German word mark **FOCUS**, which covers identical goods in Class 25. In so far as Article 8(1) (b) CTMR was concerned, the Opposition Division upheld the opposition. On appeal, the Board of Appeal dismissed the appeal and before the General Court (GC), the applicant alleges an infringement of Article 8(1) (b) CTMR, unlawful exercise of the right to opposition and infringement of Article 8 (5) CTMR.

CTMA	Earlier German mark
	<p style="text-align: center;"><b>FOCUS</b></p>



**SUBSTANCE:** It is not contested that the relevant public is the general public in Germany. The goods are identical. The signs are visually similar to a degree above average and phonetically and conceptually similar to an average degree. There is likelihood of confusion. The GC declares that the applicant cannot claim that the opposition filed by the opponent was abusive, brought in bad faith and contrary to 'business ethics' (Para. 54). The plea alleging infringement of Article 8(5) CTMR is also rejected.

Case T-386/12 Elite Licensing Company, S.A. v OHIM; Judgment of 9 April 2014; Language of the case: ES

**RESULT:** Action upheld (BoA decision annulled)

**KEYWORDS:** Admissibility, Language of proceedings, Translation, Time limit, General principles of law, Identity of goods & services, Similarity of goods & services, Dominant element, Phonetic similarity, Conceptual similarity, Common element, Similar signs, Distinctive element, Error of OHIM

**FACTS:** The applicant sought to register the figurative mark reproduced below for goods in Class 32 and services in Classes 38 and 39. The opposition was based on the International mark and on the figurative CTM application reproduced below, which covers goods and services in a number of Classes and is well-known in ES, FR and the Benelux for services in Classes 35 and 41. Article 8(1)(b) and Article 8(5). The OD upheld the opposition in its entirety. On appeal, the Board dismissed the opposition in its entirety. Before the GC, the opponent alleges an infringement of the procedural rules, of Article 8(1)(b) and of Article 8(5) CTMR.

CTMA	Earlier marks: CTMA, International mark
	

**SUBSTANCE:** On the infringement of Rules 48(2), 49(1) and 96(1) CTMIR: The appeal was filed in ES (language of the proceedings EN). No translation was filed within the deadline. The Office notes that the official form was used, by ticking boxes and adding personal data which does not need to be translated. The General Court (GC) considered this a breach of Rule 48(2) CTMIR. The notice of appeal should have been filed in the language of the proceedings (EN) or translated into it. However, the judgment of 17/9/08 (T-218/06, Neurim Pharmaceuticals) is no longer a valid legal precedent, as the Court of Justice took a different view in its judgment of 19/1/12 (C-53/11P, OHIM v. Nike, R10). Rule 96(1) CTMIR applies only 'unless otherwise provided for in these Rules'. Rule 49(1) CTMIR 'provides otherwise', as it indicates that a deficiency can be remedied before the expiry of the deadline in Article 60 CTMR (two or four months). In its Judgment, the European Court of Justice (CJ) established that the 4 months deadline should be taken into account in order to have a real possibility to remedy the deficiency. Since the grounds of appeal were submitted in the language of the proceedings within such deadline, this can remedy the deficiency, as it contains all the necessary data for the appeal. The GC dismissed OHIM's submission that a notice of appeal not filed in the language of the proceedings can be declared admissible when the appellant only needs to tick boxes in order to fill it (Paras. 28 to 31) On the infringement of Rule 95 CTMIR, the GC dismisses the Boards practice according to which Rule 95 (b) CTMIR not only applies to registered CTMs, but also to CTMs applied for. Rule 96 constitutes *lex specialis* in relation to Rule 95. The Board should have based its decision on the admissibility of the appeal on Rule 96, but this error does not lead to the annulment of the contested decision. On the infringement of Article 8(1)(b) CTMR: The relevant public is the average EU consumer. There is partial identity and partial similarity of the goods and services. MONDARIZ is the dominant element of the contested CTM. There is low – or very low - visual similarity and average aural similarity. The GC does not uphold the BoA's finding of a low conceptual similarity. The GC finds a high –or very high - conceptual similarity because of the common element ELITE (Paras. 92 to 99). The aural and conceptual similarity counteracts the visual dissimilarities. The signs are similar overall. ELITE is not descriptive, but evokes a positive connotation. Its distinctive character is slightly below average. There is likelihood of confusion.



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e.g. Case R 219/2004-1 has to be entered under 'Appeal N<sup>o</sup>' as: 0219/2004-1

**Decision of the Second Board of Appeal of 11 February 2014 in case R 410/2013-2 (EN)**

*Opposition proceedings – Article 8(1)(b) CTMR – comparison of the goods – IP translator*

The CTM applicant sought to register the word mark 'NARIN', for goods and services in Classes 29, 30 and 35.

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

The Opposition Division concluded that a likelihood of confusion exists with respect to all the goods and services against which the opposition was directed. However, since the contested decision considered the contested sign to have been filed for all the goods appearing on the alphabetical list of the Nice Classification in Classes 29 and 30, it proceeded in comparing the additional goods to the earlier goods and considered them to be dissimilar. As a consequence, it allowed the contested sign to be registered for the goods that were compared additionally.

The opponent filed an appeal in which it requested that the Board reject the CTM applied for in its entirety. In the statement of grounds, it argued that the Opposition Division mistakenly assumed that the opposition was only based on the earlier goods in Classes 29 and 30. It did not take into account that the opposition was also based on goods in Classes 3, 5, 31, 32 and 33 of the other earlier right.

The Board found that the comparison of goods and services in the contested decision has gone beyond the scope of the opposition. In fact, the opposition fully succeeded as it was allowed in respect of all the goods and services against which it had been directed. The Board recalled that, as follows from Article 41(1) CTMR, in connection with the grounds for opposition laid down in Article 8 CTMR, that an opposition can be filed only against the goods and services as published, which is further reflected by Rule 13(4) CTMR, which provides for a new opposition period if the publication of the application is amended. Furthermore, the Board pointed out that the Court, in the 'IP Translator' judgment, not only emphasized the requirement, which pertains to the applicant for registration, to define sufficiently clearly and precisely the extent, in terms of goods and services of the application for registration, but also the need for legal certainty. The aim of legal certainty becomes frustrated when a CTM application, during opposition proceedings, is deemed to have been applied for goods and services that have not been listed in the application for registration, or in the publication thereof. In this respect, the Board reiterated that an opposition can only be based on the grounds laid down in Article 8 CTMR and not on the basis of classification or other filing formalities.

The Board found that allowing the opposition beyond the scope as defined by the opponent in its notice of opposition constitutes a substantial procedural violation by the contested decision.

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

**Decision of the First Board of Appeal of 21 February 2014 in cases R 590/2012-1 and R 591/2012-1 (EN)**

*Cancellation proceedings – absolute grounds for refusal – Article 52(1)(b) CTMR – relative grounds for refusal – Article 53(1)(a) CTMR – Article 8(1)(b) CTMR – Article 53(1)(b) CTMR – Article 8(3) CTMR – procedural issues – under UK law, assets of dissolved companies belong to the crown (bona vacantia)*

The CTM proprietor registered the word mark 'BIBA' for goods in Classes 4, 30, 32 and 34. By another application, the CTM proprietor registered the word mark 'BIBA' for goods in Classes 2, 21, 24 and 27.

Following their publication, the CTM proprietor's former representative informed the Office that the CTM proprietor was 'in administration'. It declared the administrator as being Grant Thornton UK LLP.

The cancellation applicant filed a request for a declaration of invalidity against both CTMs on the basis of the absolute ground for refusal contained within Article 52(1)(b) CTMR, namely, that the CTM proprietor had acted in bad faith when filing the applications and on the basis of the relative grounds for refusal contained within under Article 8(1)(b) CTMR, in



conjunction with Article 53(1)(a) CTMR, namely, that the CTMs are confusingly similar to the cancellation applicant's earlier 'BIBA' marks, and within Article 8(3) CTMR in conjunction with Article 53(1)(b) CTMR, namely, that the contested CTMs were filed by the cancellation applicant's agent without its consent.

The Cancellation Division rejected the request for a declaration of invalidity for both Community trade marks. It dismissed the ground of invalidity based on Article 8(1)(b) CTMR as it found that the conflicting goods were dissimilar. With reference to the ground of invalidity based on Article 8(3) CTMR, the Cancellation Division dismissed it since the goods in conflict could not be considered to be closely related or equivalent in commercial terms, thus, the first condition for the application of Article 8(3) CTMR, namely the existence of an identical or similar earlier mark, was not fulfilled. The ground under Article 52(1)(b) CTMR was dismissed since the cancellation applicant had not proved that the CTM proprietor had been acting in bad faith at the time of filing the CTMs.

The cancellation applicant filed two appeals against the contested decisions.

The CTM proprietor's representative notified the Office that the CTM proprietor was insolvent, that its liquidation had been completed and that the company had subsequently been dissolved. Upon request by the Registry, the representative added that it would appear that none of the marks is the subject of any disposal or sale transactions whilst the company was in administration or liquidation.

After the Rapporteur had heard the parties about the English law of succession in the case of the dissolution of a company, it addressed a communication to the cancellation applicant and the Treasury Solicitor's Office, to whom the ownership passed once the CTM proprietor had been dissolved.

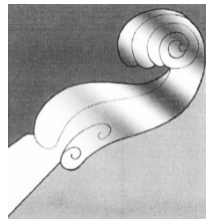
Subsequently, the CTM registrations at issue were assigned from the Treasury Solicitor, to the cancellation applicant and as a consequence, it withdrew the request for cancellation.

Consequently, the Board took note of the withdrawal of the cancellation requests and declared the cancellation proceedings closed as they had lost their purpose.

### **Decision of the Second Board of Appeal of 12 March 2014 in case R 1262/2013-2 (EN)**

*Absolute grounds for refusal – figurative mark – Article 7(1)(b) and 7(2) CTMR – distinctiveness – goods in Class 15*

The IR holder designated the European Union to claim protection for the international registration of the figurative mark



for goods in Class 15.

The examiner rejected the mark applied for under Article 7(1)(b) CTMR in conjunction with Article 7(2) CTMR on the ground that the features of the shape of the mark applied for, taken alone or combined with each other, are not distinctive: the graphic representation clearly indicates that the claimed goods are designed or manufactured for instruments, like violins, for example.

The Board concluded that the mark's representation as a whole gives the impression of an uncarved and unfinished artisanal part of a bowed string instrument which cannot be regarded as departing significantly from the norms and customs of the sector throughout the entire European Union. As a result, it agreed with the examiner's finding that the graphic representation of the mark at issue clearly and immediately indicates that the contested goods are designed or manufactured for bowed string instruments.

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

**The Registry also recommends****Decision of the Fourth Board of Appeal of 17 March 2014 in case R 2144/2013-4 (EN)**

*Absolute grounds for refusal – word mark – Article 7(1)(b)(c) and 7(2) CTMR – distinctiveness – descriptiveness – goods in Classes 9, 18 and 25*

The CTM applicant sought to register the word mark 'CATRIN' for goods in Classes 9, 18 and 25.

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 that the word 'CATRIN' will be understood by part of the Romanian public with the meaning of 'stamba' which is equivalent to 'patterned cotton fabric' ([www.dexonline.ro](http://www.dexonline.ro); [www.wordreference.com](http://www.wordreference.com)). Consequently, as such, it conveys obvious and direct information regarding the kind of material of which the objected goods are composed.

The Board stressed that the source cited by the examiner also indicates, due to the abbreviation 'reg.', that the term is only used regionally in Romania. It also pointed out that the examiner did not indicate in which region of Romania the word is or has been in use. The Board checked various language books in which no meaning was found for the word 'CATRIN'. On the basis of such reasoning, it concluded that the examiner's reasoning is not based on sufficiently concrete information according to which the Romanian public, or at least a significant part of it, would understand the term 'CATRIN'.

Consequently, the Board upheld the appeal, annulled the contested decision and accepted the mark for publication for all the goods applied for.

**Decision of the Fifth Board of Appeal of 26 February 2014 in case R 527/2013-5 (EN)**

*Opposition proceedings – Article 8(1)(b) CTMR – procedural issues – Opposition Division's obvious mistake*

The CTM applicant sought to register the word mark 'NATURE FASHION' for goods in Classes 5, 16, 29, 30 and 32.

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

The Opposition Division partially upheld the opposition, namely with regard to all the goods in Class 29 and part of the goods in Classes 30 and 32, which were found partly identical, partly highly similar and partly similar to those of the earlier trade mark.

The applicant filed an appeal and requested that the Board partially cancel the contested decision to the extent that the opposition was upheld.

The Board noted that the Opposition Division obviously erred in its order by indicating among the rejected goods 'salt, mustard, vinegar' which were found to be similar to a low degree and accordingly allowed them to registration in the contested decision's reasoning (those goods are expressly mentioned among the goods in relation to which the opposition was unsuccessful). The contested decision was appealed insofar as it rejected the CTM applied for with respect to the contested goods 'meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats' in Class 29, 'coffee, tea, cocoa, artificial coffee, ices; honey, treacle; ~~salt; mustard; vinegar~~ (see above mentioned), sauces (condiments); spices' in Class 30 and 'fruit drinks and fruit juices' in Class 32.

Consequently, the appeal must be partially upheld and the contested decision partially annulled only to the extent that the CTM applied for was rejected for 'salt, mustard, vinegar', owing to the obvious mistake in the order as pointed out *supra*. The appeal was dismissed and the contested CTM rejected for the remaining disputed goods.