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OHIM's new website launched

From its earliest days, OHIM has embraced the rapidly evolving world of technology, and was one of the very first international IP offices to launch a website, back in 1998, with the very first iteration of what would become the hugely popular OAMI Online.

This was a truly pioneering step for an organisation like ours, at a time when e-mails and internet were not the staple of every business and domestic environment as they are today.

This philosophy of harnessing the potential offered by the ever-advancing online potential underpins the way we do work here at OHIM, both in the development of internal IT systems and in the creation of electronic tools and services to bring the world of IP rights closer to the users of the Community design and Community trade mark systems.

With this in mind, and after a long and intensive process of consultation with our users, the Office has now launched a new version of the website, representing not only a major image change in terms of the new graphic design layout of the new website, but also a change in the mind-set of the Office, creating a virtual space where our users could interact with us on a number of different levels.

But, as is the case with many ambitious and pioneering ventures, ours has not been without its share of setbacks, and a number of technical hitches have had us on the back foot for the past couple of weeks.

Initial teething problems were accentuated by the enormous popularity the new launch has generated, with our servers overloading at some points during the first few days, as many thousands of users tried to log on simultaneously.

The increase in traffic, among other technical problems, also affected the stability of the CTM e-filing system and our e-communications and e-search interface, eventually leading to a number of crashes over the course of the first week.

But as an Office which puts its users at the forefront of its work, we were quick to identify the technical problems in question, and have been working round the clock to provide lasting solutions and to get the web running as it should.

Not only are specialist staff working day and night, seven days a week, to ensure the restoration of all of the web's tools and services, but we have also put in place a specific communication plan to inform users in a fully transparent manner about the progress being made through a series of daily website updates, posted in the News section of the site.

Users were directed to our special e-business information hotline, where extra staff has been drafted in to handle queries relating to the new web.

Meanwhile, over the weekend of 7 & 8 December, the hard work of our IT experts resulted in a number of improvements, reducing the previously experienced downtime and bringing some stability to the CTM e-filing system. These improvements included doubling the number of servers for e-searched from two to four, to cope with the large increase of searches and access to CTM and RCD related information.

At the same time, CTM Opposition e-filing, RCD e-filing and the new Opposition action communication facility, as well as the new online service for filing recordals were all working normally and receiving applications.

Nevertheless, and despite the efforts of increasing numbers of OHIM staff behind the scenes, the instability issues continued over the following days, as our experts carried on unrelentingly to bring a quick solution to the problem.

As of December 11, our teams had managed to increase the stability of the affected systems, particularly CTM e-filing, while still working in other areas to guarantee full service as soon as possible.

Now, thanks to the feedback collected from our users, combined with the concerted efforts of our technicians, we have been able to achieve a much higher level of stability in the online services, with CTM e-filing now operating correctly and the number of filings at their normal level.

In recognition of the decision taken by a number of our users to stop using our electronic filing system during this period of instability, opting instead for paper or fax filings, the Office has decided that all CTM applications filed between 2 December and 17:00h CET on 18 December will benefit from the lower, e-filing fee, regardless of how the application was filed.

Though some functionalities of the new web require further improvement, it is now stable and a number of critical defects have been corrected to ensure the expected level of quality.

This has been achieved largely through the round-the-clock effort of OHIM staff to rectify our errors and deliver the top quality, fast and efficient services we have led our users to expect from us. It is also thanks to the input from our users through their valued interaction and assistance throughout this period.

We thank our users for this, and apologise for the inconvenience caused, and at the same time remind them that we continue our work to restore the site to full operational service as soon as possible.

James Joyce once said that 'mistakes are the portals of discovery'. Let's hope that by learning from the mistakes uncovered in the launch of our very own portal, we finally attain the top quality services we aim to deliver to our users.

Interview



The James Nurton Interview

Last month Kerstin Gründig-Schnelle of Lichtenstein, Körner & Partners won INTA's Volunteer Service Award. She tells James Nurton why she welcomes cooperation and what she thinks about the EU trade mark reforms and also recalls an interesting case involving Playboy.

What is your background?

Trade marks don't play a big role in our legal education in Germany. But during my last year at university I had a course on economy and financial law, which included trade marks and unfair competition. Our teacher was a fascinating attorney and he brought examples of product imitation, for example I remember two bathroom rubbish bins with nice product shapes. This attracted me and I decided I wanted to deal with these kinds of issues.

I joined the firm that I still work with today. I lived in Stuttgart and this firm seemed like the place to go for trade mark work.

Tell me about your firm?

We are an IP boutique. We have 15 lawyers: 12 of them work in IP while the other three work for domestic clients on corporate work. I have been with the firm for 18 years and the work has grown steadily.

Trade marks is the biggest focus, judged by the number of clients and fees, but we also cover copyright, designs and unfair competition. We also have two partners who do patent litigation.

So you have seen the evolution of the CTM?

OHIM opened its doors one year after I started so it was a good time to start. I am a lawyer but prosecution is also a big part of my practice. I work for national and US clients and we do national and Community trade mark work, which is becoming increasingly important. This includes opposition, cancellation and appeal proceedings as well as cases at the General Court of the EU.

It is becoming more important because more and more clients drop national marks as they have good protection in place at the EU level. National companies also apply more and more for Community trade marks. The CTM is very cost-effective and the other aspect is internationalisation: clients feel they can extend their business – the internet makes that easy – and they already have trade mark protection in place.

What do you think about the CTM system?

I have been chair of INTA's OHIM subcommittee for the past three years. It is one of INTA's trade mark office subcommittees and the main objective is to monitor the activities of OHIM and provide feedback and input.

In that position, I have attended the last three user group meetings in Alicante and we have regular meetings with OHIM representatives at the INTA Annual Meeting and Leadership Meeting, so I have ongoing contact with Antonio Campinos and his team. It is an excellent opportunity: at the last meeting for example we got the latest information on the new OHIM Guidelines and the new website.

The atmosphere of these meetings has always been very respectful and cooperative. From this experience I can say OHIM is excellent at what they do. I admire the determination and energy of Antonio Campinos and I think the Strategic Plan has been very successful so far. The tools under the Cooperation Fund are a big success, and the drafting of the new Guidelines has also been important. We are involved in this process and I believe they will be more useful for users and practitioners.

Members of our committee have been involved in many of the projects under the Cooperation Fund and the Convergence Programme. One of the most important led to the recently published Common Communications on IP Translator and the consequences for terms in the Nice Classification.

Harmonisation is the big issue in Europe, not just in the legislative process but also between offices, including WIPO. It will be really beneficial for users.

Do the two Common Communications address all the issues on classification?

I think they are clear. Where we want to see improvements is the involvement of WIPO. It is important from a user perspective for WIPO to adopt the same approach, but it is harder with a much larger number of member states. This will be an important issue. Hopefully they can at least publish the information on their website.

If all offices followed the same practice, that would make life easier for users. I think it's very good that all but three offices in Europe have said they will follow this immediately.

What did you think of the recent changes to the OHIM website?

We had the same problems as everyone. We even had to file a CTM application on paper on the first day. But I have never seen a software project that worked on day one! Now it is working well and many of the problems have been addressed.

What further progress would you like to see at OHIM?

There is still room for further convergence programmes. I have heard that OHIM is going to set some up dedicated to designs. But I also understand that the whole system needed testing to see how national offices would respond and that is why they started with just five convergence programmes.

How do you think OHIM works on a practical level?

I think it works very well. In our committee we have discussed one very minor issue, which affects a tiny number of CTMs. It is where an application encounters an objection on absolute grounds and also on classification. OHIM wants you to respond on both but as users we would prefer to deal with the absolute grounds issue first, before the classification issue. It is a minor issue but it is something we are discussing.

Tell me about the award you recently won?

INTA has set up several working groups to review the legislative proposal that started with the Max Planck Institute report and I received the Volunteer Service Award for my contribution to this process. INTA has established a group of six individuals to assist the INTA Brussels representatives in their lobbying activities and I am one of them. We help to shape INTA's position, for example by providing input to the amendments proposed by the legislative committee of the European Parliament led by Cecilia Wikstrom.

I have also travelled to Brussels on several occasions to attend hearings or meetings with the European Commission and Lithuanian presidency.

It has been a fascinating experience and I'm grateful to have had the opportunity to help shape trade mark practice in Europe. It has been a lot of work but it is a once-in-a-lifetime opportunity to be involved in this legislative process. It's beneficial at all levels: getting first-hand information, making personal contacts, and having an exchange with the subcommittee members.

I heard about the award in a call from INTA President Toe Su Aung one day and I was very surprised! It is a very big honour for me.

What do you think of the legislative reform proposals?

My view is that the Commission's proposals are generally very positive, in particular the proposal to allow the seizure of goods in transit. If that makes it to the final agreed text, that would be an important improvement in the fight against counterfeiting.

There are other questions under debate, such as what should happen to the OHIM surplus and delegated acts – that is which legal texts regarding the implementation of the Community Trademark Regulation can be adopted by the European Commission or need to be approved by the legislator.

The general effort to align national trade mark law is very positive, in particular the proposal to align basic procedures, including opposition and cancellation proceedings, and allowing non-use challenges in these proceedings. I think this is an important and positive development.

The German office still gets a lot of applications. Why do you think that is?

Germany is an important market. And we still recommend national applications to clients who don't have the budget to file on an EU level. There are also advantages to having a national mark and extending it through the Madrid System.

I may not be the right person to say how well the office works, but my feeling is they are a bit slower than OHIM for opposition and cancellation proceedings. But their responsiveness has improved in recent years, partly in response to OHIM. They have introduced e-filing so competition has been good.

What has been your experience of the EU General Court?

Overall it has been positive. But I think it is a pity they are restrictive as far as new evidence is concerned. I have taken cases from other lawyers where I would love to present new evidence on appeal or before the General Court. The facts are important but you are basically limited to what has been presented at first instance. But sometimes that is too limiting.

What interesting cases have you worked on?

One of the first cases I worked on was a case for Playboy where we were trying to cancel a trade mark registration for "Play Boy" for clothing. It went up to the Federal Court of Justice and back to the appeal court in Stuttgart. One of the crucial issues was genuine use. We were initially successful on appeal but the FCJ lifted the decision and we feared we would lose. But we won it after the last hearing before the court of appeal.

What are your plans for the future?

At the end of this year I will leave the OHIM subcommittee and I will join the legislation analysis committee, so I will continue to work on the legislative process in Brussels. I hope they will reach a consensus on the legislative proposals before the European Parliament elections in June next year.

Looking further ahead, globalisation and the internet will continue to be a challenge. But once the legislative package has been adopted that will strengthen the protection and effectiveness of trade marks in Europe.

Revision and changes of practice: absolute grounds

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

Brief description

The *Knowledge Circle Absolute Grounds* has revised part of the Guidelines on Article 7. In particular, the work focused on letters (a) to (e) of this provision.

The Office's practice has been revised in respect of some important topics, for example slogans, single letters and trade marks with figurative elements.

Changes

Slogans

The part of the Guidelines dealing with slogans has been revised, in particular as a consequence of a decision by the Court. In case C-398/08 '*Vorsprung durch Technik (innovation through technique)*', the CJ set out that slogans are objectionable if they are only perceived as a mere promotional formula. However, slogans are distinctive if, apart from their promotional function, they are perceived as an indication of the commercial origin of the goods.

This doctrine has been implemented into the Guidelines. In addition, some guidance is provided as regards the situations in which a slogan can be distinctive, for example when it has various meanings, constitutes a play on words or a conceptual surprise, or involves a mental effort.

Single letters

Trade marks consisting of a single letter in standard characters with no graphic modifications is another topic which has been revised as a consequence of a Court's decision. In case C-265/09P '(α)', the CJ ruled that those signs must be assessed in the context of an examination, based on the facts, focusing on the goods or services concerned. Moreover, it also stated that the 'distinctiveness test' to be applied to these signs is not different from that of other signs.

In that respect, the Guidelines explain that the examination of these signs must be based on the specific factual circumstances of the case. It is therefore not possible to rely on general assumptions, such as that consumers will not usually perceive them as distinctive signs. On the contrary, it is now for the Office to establish, on the basis of the case at issue, why the trade mark is not distinctive.

Abbreviations and acronyms

This type of trade mark can usually be grouped into two cases. Some of them consist of an acronym (e.g. 'TDI', as in case T-16/02). The Guidelines state that abbreviations of descriptive terms are in themselves descriptive if they are or could be used in that way, and the relevant public recognises them as being identical to the full descriptive meaning.

Some other trade marks consist of a descriptive expression conjoined with its acronym (e.g., 'Multi Markets Fund MMF', as in case C-90/11). Unlike under previous practice of the Office (which usually tended to accept them), these signs should be now objected to as descriptive because the acronym and word combination together are intended to clarify each other and to draw attention to the fact that they are linked.

Names of colours

As regards CTMs which consist of the name of a colour, in the past the Office usually objected to these only when the sign applied for sought protection for paints or similar colourant products.

Under the new Guidelines, a sign consisting exclusively of the name of a colour must be objected to under Article 7(1)(b) and (c) when the application claims any goods for which the colour can reasonably be perceived by the public as a description of one of its characteristics. For example, BLUE in relation to cheese or GREEN in respect of tea.

Shapes giving substantial value

Even though it is not as frequently raised as others, the Guidelines on the ground for refusal foreseen in Article 7(1)(e)(iii) has also been subject to revision. Following the Court's judgment in case T-508/08 ('loudspeaker'), the Guidelines underline that this ground for refusal will mostly apply to those goods where the shape of the object concerned is the main, although not necessarily exclusive, factor that determines the decision to buy it. For example, objects of art and items such as jewellery, vases and other objects that are bought primarily because of the aesthetic value associated with their shape.

Subject matter and titles of books

Part of the new Guidelines is dedicated to a related issue: trade marks which consist of the title of a book and those which are descriptive of the 'subject matter' of the goods or services.

Certain stories (or their titles) have become so well known that they have 'entered into the language' and are incapable of being ascribed any meaning other than that of a particular story. The Guidelines now provide specific instructions on this issue: trade marks consisting solely of a famous story or book title are non-distinctive under Article 7(1)(b) in relation to goods and services which could have that story as their subject matter. This would be the case of 'Cinderella' for products like books or films.

On the other hand, guidance is also given as regards those signs which are descriptive under Article 7(1)(b) and (c) of the subject matter or content of the goods or services, in particular in respect of the scope of the objection (i.e. the goods and services concerned and the way in which they are described, for example whether or not they refer to a specific subject matter).

Figurative elements

Another important issue dealt with in the new Guidelines refers to those trade marks which contain non-distinctive figurative elements. Part of this issue, moreover, is also the object of a Convergence Programme with the IP National Offices. The new Guidelines focus on providing instructions on how to assess the distinctive role, if any, that these elements may have within the overall assessment of the trade mark.

Knowledge Circle Absolute Grounds

Guidelines Work Package 1 adopted

OHIM's project in transforming its current Manuals and Guidelines into a new set of updated Guidelines, which will be a single source of reference for OHIM's practice, has taken another important step. On 4 December 2013, the President of the Office adopted the new Guidelines, Work Package 1 (WP1) (Decision No EX-13-5), which are equivalent to approximately half of OHIM's practice.

The Guidelines WP1 are being published in OHIM's five working languages in the OHIM Official Journal at the beginning of January 2014 and will come into force on 1 February 2014. WP 1 will now be translated into all remaining official EU languages.

The second half of OHIM's practice is currently still reflected in the Manual on Trade Mark Practice and the Manual on Registered Designs Practice. The Draft Guidelines for that half, Work Package 2 (WP2), were submitted at the beginning of January 2014 to EU IP Offices and User Associations for comments. Subsequently, after consultation of OHIM's Administrative Board, WP 2 is expected to be adopted by the President with a view to entering into force on 1 August 2014.

As from that date, all of OHIM's practice will be contained in the Guidelines which will be updated yearly and will be available in all official EU languages.

Set out below, you will find the aspects of practice covered in the recently adopted Guidelines WP1, a description of the yearly revision cycle as well as a description of the 2013 consultation of external stakeholders on WP1.

The January edition of Alicante News also contains articles by the Knowledge Circles responsible for the respective areas of practice, describing the main changes made in the WP1 revision.

1. WP1 – Areas of practice

The following areas of practice are covered by WP1.

A) COMMUNITY TRADE MARK

Part A, General Rules

- Section 3, Payment of Fees, Costs and Charges
- Section 5, Professional Representation

Part B, Examination

- Section 2, Examination of Formalities
- Section 4, Absolute Grounds for Refusal 7(1)(a), (b), (c), (d), (e)

Part C, Opposition

- Section 0, Introduction
- Section 1, Procedural Matters
- Section 2, Identity and Likelihood of Confusion
 - Chapter 1, General Principles and Methodology
 - Chapter 2, Comparison of Goods and Services
 - Chapter 3, Comparison of Signs
 - Chapter 4, Distinctiveness
 - Chapter 5, Dominant Character
 - Chapter 6, Relevant Public and Degree of Attention
 - Chapter 7, Other Factors
 - Chapter 8, Global Assessment

Section 6, Proof of Use

Part D, Cancellation

Section 1, Cancellation Proceedings

Section 2, Substantive Provisions (Revocation for Lack of Use; Invalidity on the Ground of Bad Faith and Invalidity Based on Relative Grounds for Refusal)

Part E, Register Operations

Section 2, Conversion

Section 4, Renewal

Section 5, Inspection of Files

Section 6, Other Entries in the Register

Chapter 1, Counterclaims

B) REGISTERED COMMUNITY DESIGN:

Examination of Design Invalidity Applications

2. Guidelines revision process

As the four sources of the Office's practice (case-law, user feedback, operational needs and outcome of the Convergence Programme) are evolving constantly, the Guidelines will also evolve. They will be adapted to reflect developments in Office practice on a yearly basis by means of an ongoing revision exercise.

They are revised by the cross-departmental Knowledge Circles of the Office in a cyclical and open process: 'cyclical' because practice is updated on a yearly basis by looking at the case-law of the preceding year and taking into account operational needs and the outcome of convergence initiatives, and 'open' because external stakeholders are involved in defining that practice.

The involvement of national offices and user associations not only benefits the quality of the Guidelines, but is also expected to facilitate convergence, that is, the process of exploring common ground on issues where there are diverging practices. Making the Guidelines available in all EU languages will raise awareness of Office practice amongst Member States and users and make differences in practice easier to identify.

The yearly work is split into WP1, which runs over a twelve-month period each year from January to December, and WP2, which runs over a twelve-month period each year from July to June.

The process involves the following phases:

a. Initiation of update by stakeholders

Having been made aware of the Office's revision plans, in particular what is to be revised and when, the national offices and user associations are welcome to submit comments before January (for WP1) and before July (for WP2). Comments not received on time will be taken into consideration during the next cycle or may be submitted during phase c.

b. Preparation of the draft Guidelines by the Office

During this phase, the draft Guidelines are produced by the Office's Knowledge Circles. The process starts each year in January (for WP1) and July (for WP2). Feedback and comments submitted in advance from users are taken into consideration. The three steps of the process – analysis, drafting and discussion – must be completed in a timely manner. Analysis involves the Knowledge Circles extracting trends from the preceding year's case-law, studying the conclusions of the convergence projects and taking into consideration the comments received from the Office's users and internal

stakeholders. As the next step, the Knowledge Circles draft the guidelines. Finally, the texts are discussed amongst the various units and departments of the Office.

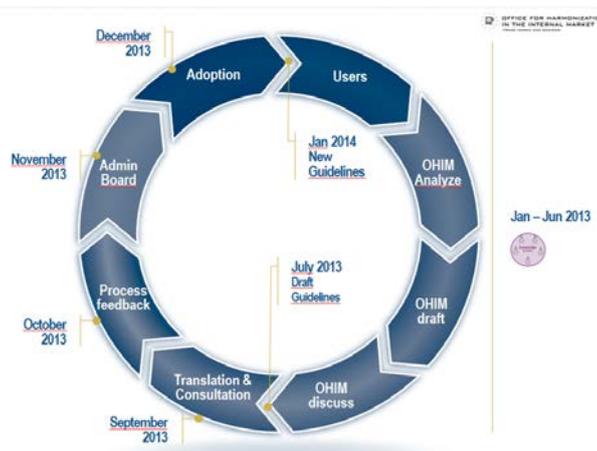
c. Adoption of the Guidelines

In the last phase, the draft Guidelines are sent for translation into the Office languages. The texts and translations are circulated amongst the user associations and the EU IP offices with a view to receiving feedback before the next meeting of the Office's Administrative Board (AB). After consulting the AB in accordance with Article 126(4) CTMR and Article 101(b) CDR, the President adopts the updated Guidelines. The versions in the five Office languages together make up the official text, which is intended to be published in January (WP1) and July (WP2) of each year, respectively. In the event of discrepancies between different language versions, the text in the drafting language (English) will prevail. Once adopted, the Guidelines will be translated into the remaining official languages of the European Union as a matter of courtesy and for transparency.

d. Fast-track procedure

Where a major external event has an immediate impact on Office practice (for example, certain judgments of the Court of Justice), the Office can amend the Guidelines in a fast-track procedure outside the normal time frame set out above. However, this procedure is the exception to the norm. As the process is cyclical, changes will always be open to comments and revision in the following cycle.

The cycle can be exemplified by the picture seen here, which shows the 2013 revision process of the recently adopted WP1.



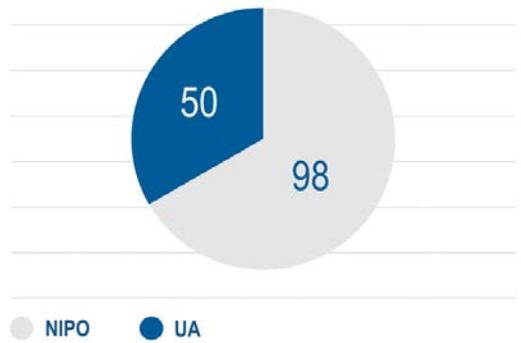
3. Consultation with external stakeholders on WP1 in 2013

The Guidelines WP1 were adopted after extensive consultation of both internal and external stakeholders as well as OHIM's Administrative Board.

The majority of comments submitted by external stakeholders were sent during phase c of the process described in point 2 above. On 4 July 2013, the Office published the draft WP1 on a dedicated OHIM website in their drafting language, English, for external consultation. Versions in the other Office languages were added as soon as they became available. At the same time, OHIM informed the members of the Administrative Board, the representatives of the Member States in the Liaison Meeting and 17 User Associations and invited them to comment on the drafts. The deadline for giving feedback on the texts expired ten weeks later, namely on 13 September 2013.

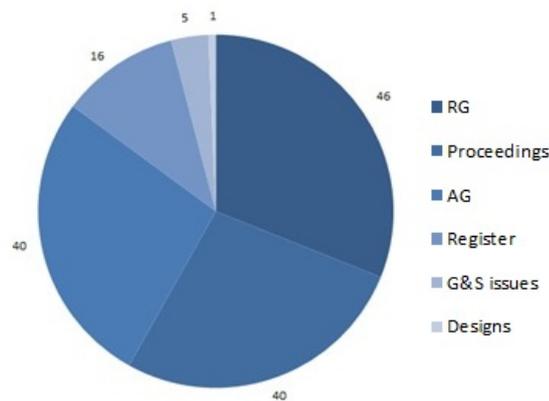
By that date OHIM had received twelve submissions, eight from EU IP Offices and four from User Associations. In general each submission contained more than one comment. Overall, 148 comments were made, 98 by EU IP Offices and 50 by User Associations.

Number of suggestions by UAs and NIPOs



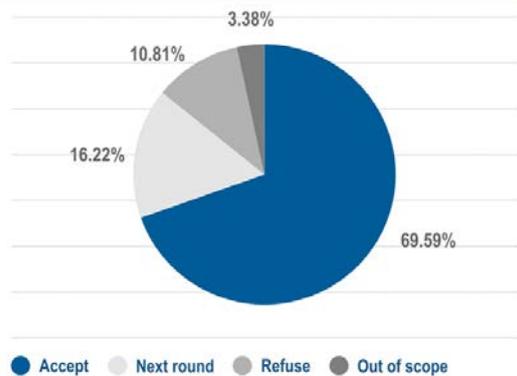
Submissions ranged from ideas in relation to one particular issue to wide-ranging contributions covering a number of issues. Most contributions covered a variety of topics and were, therefore, forwarded to more than one Knowledge Circle of the Office for careful consideration.

User comments submitted to KC

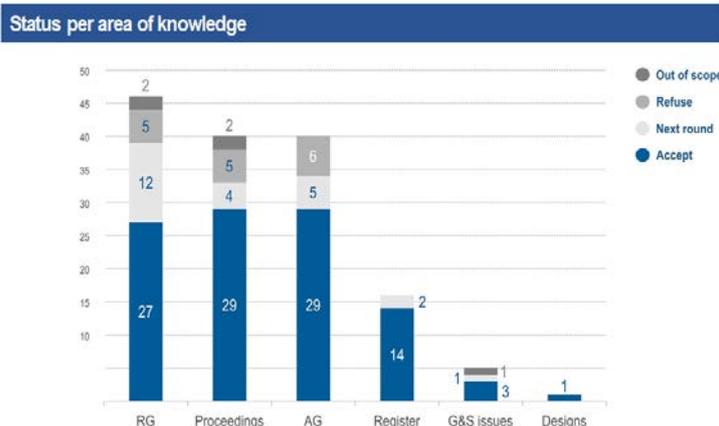


Overall, a total of 85% of all comments were (in the current cycle - 69.59%) or will be (in the next cycle – 16.22%) accepted.

Degree of acceptance



The vast majority of comments submitted and accepted by the Knowledge Circles in the 2013 WP1 cycle related to Part C of the Guidelines WP 1 (Opposition), with Part B (Examination) as the second largest group.



In the Trade Mark Liaison Meeting that took place on 7/8 October 2013 OHIM presented, through the respective Knowledge Circles, the most important issues addressed in the published draft Guidelines and invited National Offices to publicly share their views. The Liaison Meeting was a fruitful interchange of ideas and a second opportunity for some of our external stakeholders to give more feedback. After the meeting, the Knowledge Circles incorporated the changes that resulted from the discussions at the meeting into the draft Guidelines and produced the final version of WP1, which was the basis for consultation of OHIM's Administrative Board in its meeting on 19 November 2013. Subsequently, WP1 was adopted by the President of the Office on 4 December 2013.

4. Conclusion

The 2013 exercise of updating the practice covered in WP1 and transforming the Manual relating to this practice into Guidelines was a successful one. Both the thorough internal discussions and the fruitful consultation with external stakeholders have led to a detailed and up-to-date description of the practice contained in WP1, which comes into force on 1 February 2014. Together with the practice contained in WP2, which is expected to come into force on 1 August 2014, the Guidelines will create a single source of reference for OHIM practice, available in all official EU languages, which will improve consistency of OHIM decisions and foster their predictability. The yearly revision cycle increases the alignment of OHIM decisions with the most recent trends in the jurisprudence of the European Court of Justice and the case-law of the Office's Boards of Appeal as well as the outcome of convergence programmes between OHIM and the EU IP Offices.

Knowledge Circle 'Coordination'

Guidelines on procedural issues

During the first part of 2013 the KC Proceedings revised the Guidelines dealing with the procedural aspects Examination Proceedings/Formalities.

The main changes were:

Part B, Examination, Section 2, Formalities.

History

This part of the Guidelines is new since 2012. It contains parts that were dealt with at other places in the Manual as well as newly drafted parts.

Brief description

The Guidelines deal with all the issues that are contained in a CTM application, namely where a CTM can be filed, the fee issues concerning a CTM application, the requirements for a filing date, the languages of the application and when it is required to designate a professional representative. Furthermore, it gives information on what kind and what type of Community trade mark can be applied for and which graphical representation and eventual description is needed for these trade marks. On top of that, the Guidelines deal with the priority and seniority claims at the moment of filing or within the subsequent two months of filing.

Changes

As the text of the Guidelines only dates from 2012, no practice changes have been introduced during the 2013 revision by the KC proceedings.

The changes that have been introduced concern mostly linguistic issues, the improvement of the lay-out and the deletion of repeated parts.

Finally, examples of acceptable CTM representations for the different types of marks were added.

Knowledge Circle 'Proceedings'**Revision and changes of practice: parts A and E**

The Knowledge Circle Register and other issues has revised two different parts of the Guidelines, including 6 sections and chapters each covering a wide range of often quite different topics.

Part A, Section 3, Payment of Fees, Costs and Charges*Brief description*

The last Guidelines incorporating a chapter on Payment of Fees came into force in November 2005 and consisted of 2 pages of information contained within Part A, General Provisions.

We have come a long way since then with various updates of the Manual. The end product is a 14 page document explaining everything beginning with the different means of payment accepted by the Office, through when payment is deemed to have been made, when and how refunds are handled and ending with information on decisions on costs.

The guidelines give general information on the different terminology used, a definition of the differences between fees, costs and charges and provide very useful information on the kinds of indications recommended for payments by transfer in order for payments to be linked quickly and easily to the correct file.

Changes

The changes made since the last update of the Manual primarily serve to make the order followed logical, and to further clarify certain aspects.

In particular, the table of codes, descriptions and examples in relation to payments by transfer has been clarified; the reference to a refund of the surcharge under paragraph 5.2 has been amended to reflect current practice, and in accordance with the practice referred to in the Opposition Proceedings Manual; an additional paragraph (6) on decisions on costs has also been included, primarily because this section of the Guidelines is titled 'Payment of Fees, Costs and Charges' whereas, until now, it only contemplated costs.

Part A, Section 5, Professional Representation

Brief description

Once again, we have come a long way since the last update of this section of the Guidelines, which came into force in January 2000. Fortunately, due to the regular updates of the Manual, there have been no changes in terms of practice since the last version of the Manual, updated in December last year.

This section of the Guidelines gives a comprehensive overview of the different kinds of representatives, from lawyers, to professional representatives entered in the database of representatives maintained by the Office, to employees and associations of representatives, explaining how they are appointed and the different changes that can take place during the course of relations with the Office. The section goes into detail explaining how the Office interacts with representatives, explains about authorisations and how they no longer need to be actually filed at the Office, it includes a section on the implicit and explicit appointment of representatives and it ends with an explanation of the consequences of the death or legal incapacity of either the represented party or the representative.

Changes

The changes made since the last update of the Manual primarily serve to make the order followed logical, and to further clarify certain aspects.

The most important, and user-friendly update in this section has been the Annex of tables explaining the different terminology used in different countries and what qualifications representatives need in order to be included in OHIM's database of professional representatives. This annex has been reorganised to give it a more logical structure.

In addition, the paragraph on 'Implicit appointment or change of representative' has been moved to paragraph '3.4 Appointment of a representative' and has been reworded so that it is clear that the last paragraph is not an 'exception' but rather a specific example.

Part E, Section 2, Conversion

Brief description

The Guidelines on Conversion were last updated in 2004. As with the other parts of the Guidelines, however, the Office has kept the practice in this area up to date with its regular review of the Manual on trade mark practice. Therefore, there have been no changes in practice since the last version of the Manual which was updated in October 2012.

This section of the Guidelines goes into detail about the exact procedure for applying to convert either a CTM or an IR designating the EU into national applications or registrations. It starts by explaining the concept and when conversion is possible for CTMs and when it is possible for IRs. It also goes into detail explaining the two grounds precluding conversion: (1) when the mark has been revoked on the grounds of non-use and (2) when the decision of the Office expressly states that a particular ground for refusal applies in respect of a particular Member State. It then explains the exact procedure before the Office, from filing the application to its publication and transmission to designated offices and ends by explaining the effects of conversion: i.e. that the resulting national trade mark application/registration will maintain the filing date and (if applicable) the priority date of the CTM, as well as any seniority of an earlier trade mark with effect in that State.

Changes

The changes since the last update of the Manual primarily serve to make the order followed logical, and to further clarify certain aspects, in particular in relation to IRs, as well as including a cross-reference to the Manual on Enlargement where the effects of enlargement on applications for conversion is explained, i.e. that the filing date of the converted mark will be the date of accession, even if the filing date of the CTM is earlier than the date of accession.

Furthermore, specific reference has been made to the new practice identified in Part D, Section 1, Cancellation Proceedings in Relation to Surrenders and Withdrawals

Part E, Section 4, Renewal

Brief explanation

This section of the Guidelines is completely new and aims to give a detailed account of the steps involved in the renewal process. As such there are no major changes in practice; however, there are a few instances in which it has been judged necessary to fine-tune the practice in order to make it more coherent with the applicable provisions or to the practice of the Office in other areas.

Unfortunately, renewal is an area that is often targeted by fraudsters who send unsolicited mail to owners requesting payment for renewal services. The Office is aware of the situation and is working hard on a fraud strategy to fight the potentially misleading contact made by firms that have nothing to do with OHIM. This issue is also highlighted in the guidelines, the aim being to draw users' attention to this issue as much as possible.

Changes

The few changes made since the last update of the Manual primarily serve to make the order followed logical, to provide further examples and to quote case-law. Important to note is an updated practice, where previous practice had been to send a notification to the proprietor or its representative and any person recorded in the Register as having rights in the mark regarding the imminent expiry of the mark, the notification of a total or partial loss of right either due to non-payment, insufficient payment, insufficient clarification of the goods and services to be renewed in the event of partial renewal etc., was originally only sent to the proprietor or its representative, if one has been appointed. The change in practice consists of also sending the notification of the loss of right to the proprietor or its representative, if appointed, and any person recorded in the Register as having rights in the mark.

Part E, Section 5, Inspection of files

Brief explanation

The last update of the Guidelines on Inspection of Files came into force in 1998. It is indeed a historic document. Once again, and fortunately, the Office has kept an update of current practice in its Manual, and there have been no changes in practice since the last update of the Manual in December 2012, and the version of the Guidelines revised this year. The structure has been changed to make it clearer and more user-friendly and the relevant provisions have been updated. This section contains complete information on who can apply for inspection, when inspection is available and what the files contain. It also explains the different possibilities of accessing the files, including explaining the differences between online access to files, online applications for inspection and written applications for inspection. It also explains that the Office has made certified copies of the application form and the registration certificate available to download free-of-charge.

Changes

The few changes made since the last update of the Manual primarily serve to make the order followed logical and to clarify the differences between online access to files, online inspection of files and online certified copies.

Part E, Section 6, Chapter 1, Counterclaims

Brief explanation

This chapter of the Guidelines is completely new and aims to give a detailed account of the steps involved in recording a counterclaim before the Office.

Counterclaims, as ruled in Article 100 CTMR or Article 84 CDR, are defence claims brought by a defendant who is sued for the infringement of a CTM or RCD. By way of such a counterclaim the defendant asks the Community trade mark court or Community design court to declare the revocation or invalidity of the CTM or the invalidity of the RCD which he is supposed to have infringed.

The Regulations state that the Community trade mark court or Community design court shall inform the Office of the filing of a counterclaim and, in the case of a final judgment on it, provide the Office with a copy of the judgment.

However, the Office makes use of an extensive and non-restrictive interpretation and also allows the parties of the infringement procedure, in the context of which the counterclaim has been filed, to request that the filing of the counterclaim and the filing of the final judgment on the counterclaim be entered in the Register of the Office.

For this purpose the recordal applicant must provide the necessary information which is detailed in this new part of the Manual dealing with the entries in the Register of the filing and final judgment of counterclaims. In any event, in case of doubt or if information is missing, the Office will contact the Community trade mark or Community design court or the parties concerned.

The underlying idea for permitting the parties to request that the filing and final judgment of the counterclaim be entered in the Register of the Office lies in the general interest of making all the relevant information on counterclaims concerning CTMs and RCDs available in the Register of the Office, in particular the final judgments thereof. In this way the Office may implement these final judgments, in particular those which declare the total or partial revocation or invalidity of CTMs as well as the total invalidity of RCDs. This procedure ensures that where the Community trade mark court or Community design court does not inform the Office of the filing of a counterclaim or a final judgment thereof, this important information may still reach the Office and its Register through an application by another party. Consequently, the Register will reflect the CTMs or RCDs which have been declared to be totally or partially revoked or invalid, thus complying with the principles of conformity to truth, public faith and the legal certainty of a public Register.

Knowledge Circle 'Register'

Revision and changes of practice: cancellation

The Knowledge Circle Proceedings, the Knowledge Circle Absolute Grounds and the Knowledge Circle Relative Grounds have reviewed the parts of OHIM's Guidelines dealing with cancellation.

Part D, Section 1, Cancellation Proceedings

History

This part of the Guidelines was newly drafted in 2012. For the first time in 16 years the Office practice on Cancellation Proceedings was laid down in a Manual that will now be converted into Guidelines.

Brief description

The Guidelines lay out all procedural issues that are different from the procedural issues in opposition matters.

It deals with the application for cancellation, the admissibility check, the notification of the application to the CTM proprietor, the languages used in cancellation proceedings and other issues specific to cancellation proceedings, namely suspensions, surrender and withdrawals, and applications for revocation and invalidity against the same CTM.

Changes

The main changes are the following:

1. Further to the judgment in the “Redtube” case of the Court of Justice of the EU of October 2012, the notification sent to the parties after the admissibility check informing them that the cancellation proceedings are admissible constitutes a decision that may be appealed together with the final decision. Consequently, the Office is bound by it and may only revoke it at a later stage of the proceedings provided that the requirements stated in Article 80 CTMR for revocation of decisions are met.
2. In order to stop a practice that circumvents the effects of a revocation for conversion purposes, the Office will suspend the registration of the surrender of the CTM and inform the invalidity/revocation applicant of its intention to close these proceedings. The Office will invite the invalidity/revocation applicant to present its observations. In case the applicant does not react, it will receive a second letter from the Office closing the proceedings and drawing attention to a possible loss of rights.

Part D, Section 1, Cancellation Proceedings, Substantive Provisions

Brief description

The Knowledge Circle Relative Grounds is responsible for the revision of part of the Cancellation Guidelines affecting relative grounds for refusal, namely **revocation due to non-use** of the CTM (Article 51(1)(a) CTMR) and **relative grounds for invalidity** (Article 53 CTMR). The Cancellation Guidelines only include those aspects which are particular to Cancellation Proceedings. To the extent that the practice in cancellation cases is the same as the practice in oppositions, a cross-reference to the Oppositions Guidelines has been included. For instance, the section on revocation due to non-use cross-refers to the Section on Proof of Use and only includes specific aspects such as the calculation of time periods or provides specific revocation cancellation examples.

On the other hand, the Knowledge Circle Absolute Grounds has revised the part of the Guidelines concerning **bad faith as an absolute ground for invalidity** (Article 52(1)(b) CTMR). The new Guidelines are a complete re-elaboration of the existing one.

Changes

The changes on relative grounds are minor. They include: (i) additions intended to clarify the structure or language of the Guidelines; (ii) a case-law update regarding the ‘consent to registration’ argument; (iii) language clarifications as proposed by national offices to align the text to the text of the CTMR or clarify that the scope of protection of a right to a name/right of personal portrayal follows from national law.

As regards bad faith as an absolute ground for invalidity, the text provides guidance about the relevant point in time and the concept of bad faith, including the factors which are likely/unlikely to indicate the existence of bad faith. The extent of invalidity is also the object of a detailed analysis, following the Court’s judgment in case T-321/10 (‘GRUPPO SALINI / SALINI’).

Knowledge Circles: ‘Proceedings’, ‘Absolute Grounds’ and ‘Relative Grounds’

Revision and changes of practice: oppositions

The Knowledge Circle Proceedings, the Knowledge Circle Goods and Services and the Knowledge Circle Relative Grounds have reviewed a number of parts of the Guidelines dealing with oppositions.

Part C, Section 0, Introduction to Opposition

Brief description

'Introduction to Oppositions' is a new section of the Guidelines which has been drafted by the Knowledge Circle Relative Grounds with the intention of giving an overview on all the grounds for opposition, covering those general issues which are not ground specific and including some aspects related to the drafting of decisions (e.g. which is the earlier right which is normally addressed first in an opposition decision).

Moreover, the content of the 'Annex on Structure of Decisions on Likelihood of Confusion' included at the end of the former Chapter 1 'General Principles and Methodology' has now been transformed into an Annex to this Section. The new Annex includes a reference to the structure of decisions based on all the relative grounds.

Part C, Section 1, Procedural Matters

History

This part of the Guidelines was revised on two occasions by the Knowledge Circle Proceedings: once in 2012 and once in the first half of 2013. The last version of the Guidelines was published in OJ 12 of 2007 but all changes in practice as from that date were only reflected in the subsequent versions of the Manual that will now again be converted in Guidelines.

Brief description

This part of the Guidelines contains the practice of the Office regarding all steps in opposition proceedings such as the admissibility check, the cooling-off period, the adversarial stage, the different ways to terminate the proceedings (by friendly settlement, by restrictions and withdrawals or by a decision on the substance). Apart from these issues, this part of the Guidelines also deals with some particular procedural issues at opposition level such as correction of mistakes, time limits, suspension, multiple oppositions and change of parties.

Changes

The main changes that have been introduced are:

1. When an opposition is based on an earlier mark that is not earlier, this issue will be dealt with at admissibility level rather than at substantiation level where it is dealt with at the moment (p. 14-15).
2. If the opposition is directed against PART of the goods and services of the CTMA, the opponent no longer receives 2 rounds to determine which goods and services the opposition will be directed against (p. 29).
3. According to the judgment of the Court of Justice of 18/10/2012, the notification that is sent to the parties informing them that the opposition is admissible constitutes a decision that may be appealed together with the final decision on the case as stated in Article 58(2) CTMR. Consequently the Office is bound by the decision (p. 32).
4. The evidence of the existence of the converted CTMA needs to be filed at the substantiation stage (p. 92).

Furthermore, the structure of these Guidelines has been improved and clarifications of Office practice have been introduced where appropriate.

Part C, Section 2, Identity and Likelihood of Confusion

Brief description

This section of the Guidelines deals with the substantive aspects of the assessment of identity and likelihood of confusion in eight chapters.

Chapter 1 establishes the general principles and methodology followed by the Office in assessing identity and likelihood of confusion. In particular, as regards likelihood of confusion, according to the Office's practice, whether it exists depends on a *global assessment* of several interdependent *factors*. The first step in assessing whether likelihood of confusion exists is to establish these factors; the second step is to determine their relevance in a separate 'Global Assessment' in which a conclusion on likelihood of confusion is reached after balancing the variety of these different factors.

Chapters 2 to 7 deal with the relevant *factors* for the assessment of identity and likelihood of confusion:

- comparison of the goods and services: definition of the general principles for the comparison of goods and services in opposition proceedings and how they should be applied;
- comparison of the signs: guidance on establishing identity or similarity, explaining how to compare the signs visually, aurally and conceptually;
- distinctiveness: guidance on how to assess the distinctiveness of the signs in conflict (or their elements). Enhanced distinctiveness is also addressed;
- dominant character: guidance on what is considered to be a dominant element;
- relevant public and its degree of attention: guidance on how to define the relevant public and how to establish its degree of attention;
- other factors which have to be taken into account in assessing likelihood of confusion and which are mostly arguments raised by the parties such as coexistence or family of marks.

Finally, **Chapter 8** strictly deals with *the global assessment* of all the factors established in the previous Chapters. It deals with the most salient principles applicable to likelihood of confusion (e.g. interdependence principle) and with the assessment of likelihood of confusion in specific cases (e.g. names, short signs).

All of the abovementioned Chapters were reviewed by the Knowledge Circle Relative Grounds except Chapter 2 which was reviewed by the Knowledge Circle Goods and Services. The sections below will address the relevant changes introduced in these Chapters in 2013.

Changes to Chapter 1, General Principles and Methodology

The modifications to the text are very minor and do not constitute any practice change. As indicated above, Annex 1 on the content and structure of the decisions has been moved to Part C, Section 0, Introduction to Oppositions).

Changes to Chapter 2, Comparison of Goods and Services

The content of this chapter underwent a complete revision already in 2012. That previous revision mainly included a complete new structure incorporating the chapter on identity of goods and services, an extensive explanation of the 'Canon criteria', the addition of annexes with specific questions and answers, and a total refresh of decisions from the Boards of Appeal and judgments from the EU Courts.

Furthermore and following the ECJ judgment C-307/10 *IP Translator*, it included an important change in practice regarding the use of class headings and in particular how OHIM and each national Trade Mark Office interpret the scope of protection of their national trade marks and of Community trade marks containing all general indications of one or more classes of the headings of the Nice classification, filed before and after the judgment.

The changes made since the last update of the Manual primarily served to include more trends in case-law, to give some more relevant practical examples and to further clarify a few aspects. Due to the previously described significant updates, there have been no changes in terms of practice since the last version of the Manual.

Changes to Chapter 3, Comparison of Signs

This chapter contains three main sections: an introduction with general principles applicable to both identity and similarity; guidance on identity of the signs; and guidance on similarity of the signs.

Compared to the Manual of 2012, there has been some re-organisation of the **Introduction** of the Chapter with the intention of having an introduction which includes the general principles applicable both to identity and similarity and that the principles which only apply to 'identity' or 'similarity' are only included respectively in the section on 'identity' or 'similarity'.

The section on **Identity** has been substantially modified. It now contains sub-sections which develop the concept of identity and the threshold for finding identity. Moreover, it now gives guidance on identity depending on the type of signs which are compared (word marks/figurative). Importantly, as regards the threshold for finding identity, it is still considered that the concept should be interpreted strictly but the Guidelines introduce the caveat (following well-established case-law) that two signs can still be identical if the differences are so insignificant that they may go unnoticed by an average consumer.

The section on **Similarity** has also been restructured to mirror the section on identity with sub-sections on the concept of similarity and the threshold for finding similarity. 'Negligible elements' have now their own sub-section. As regards the three levels of comparison:

- visual and aural comparison: minor modifications in order to improve the wording and enhance clarity. Updated examples have been added;
- conceptual comparison: besides the modifications to clarify some parts of the text (e.g. how to make a conceptual comparison) or better align them with case-law (e.g. semantic content of words and understanding of languages), the Guidelines now include a new sub-section on the concept of single letters. Recent examples have also been added.

Changes to Chapter 4, Distinctiveness

This chapter contains numerous modifications. The changes on substance regard a practice change on the treatment of single letters/numerals. Previously it was indicated that they enjoy a minimum degree of distinctiveness. Now the Guidelines consider that their distinctiveness must be assessed according to the same criteria that apply to other word marks, based on a factual assessment which takes into account the goods and/or services concerned.

Other modifications include the addition of the C-196/11P '*F1-LIVE*' case-law (earlier trade marks enjoy a presumption of distinctiveness), the revision of the section on disclaimers, the addition of a section on collective trade marks and the addition of recent examples.

The remainder of the changes is intended to better explain the different aspects of distinctiveness that are examined (of the signs, of the elements of the signs) and add coherence to the terminology used throughout the text.

Changes to Chapter 5, Dominant Character

The only modification to the text is the addition of an example.

Changes to Chapter 6, Relevant Public and Degree of Attention

This chapter deals with the definition of the relevant public and with the establishment of its degree of attention. The main modification on the **definition of the relevant public** regards the rewording of this definition. Previously, the relevant public was defined as the consumers of the contested goods and services identical or similar to the ones protected by the earlier right. The relevant public is now defined as the consumers of the goods and services which have been found identical or similar.

In the section on the **degree of attention**, two practice changes are proposed. First, the text on degree of attention of the public when purchasing *basic foodstuffs* is reworded to not give the impression that it is always low. The examples of goods in Class 29 for which a low degree of attention was found have been deleted as this is not in line with the case-law. Only a general reference to basic foodstuffs as a possible example is included. The second change regards *pharmaceuticals*. In light of the trends in case-law, the Guidelines now indicate that the level of attention of the relevant consumer when purchasing pharmaceuticals is always high.

Changes to Chapter 7, Other Factors

The previous 'Chapter 7 Assessment of Factors' has been split into two chapters. The new Chapter 7 now only deals with other factors (besides those addressed in previous chapters) which have to be taken into account in assessing likelihood of confusion: among others, family of marks, coexistence, incidences of actual confusion prior decisions of the Office or of national authorities.

As regards changes on substance, it is worth noting that in the *Family of Marks* section, the concept of association has been clarified. When dealing with 'coexistence' of the conflicting trade marks on the market in the same territory, the impact of coexistence agreements on likelihood of confusion has been reworded and a reference to C-482/09 'BUD' on honest concurrent use has been added. Finally, the coexistence of trade marks not involved in the opposition proceedings has been moved to Chapter 4 Distinctiveness.

New Chapter 8, Global Assessment

This is a new chapter which strictly deals with the global assessment of all the factors established in the previous chapters (Chapters 2 to 7). The Chapter describes the most salient principles applicable to likelihood of confusion (e.g. interdependence principles) and gives guidance on the assessment of likelihood of confusion in specific cases (e.g. names, short signs).

Not all the content of the chapter is new. As regards the **principles section**, the imperfect recollection principle, the impact of the method of purchase of the goods and services, the impact of conceptual similarity of the signs were already included in the old Chapter 7. They have just been moved to Chapter 8. The sub-section on the interdependence principle however is new.

As regards guidance on **specific cases**, these were all included in the old Chapter 7. There are however a number of practice changes. In line with the changes introduced to the distinctiveness of *single letters and short signs*, the global assessment of the likelihood of confusion between signs consisting of a single letter/numeral follows the same rules as in respect of word signs. As regards *business names*, there is a practice modification following recent case-law from the Court and the Boards of Appeal: the rule that the business name is not the 'real' trade mark is abandoned. What is important is the overall assessment of the relevant factors.

Changes in structure have also been introduced. The section on 'Beginning of signs' has been reduced as some of the sub-sections had little added value. The section on 'Impact of enhanced distinctiveness on likelihood of confusion' has

been deleted and some parts have been moved to Chapter 4 Distinctiveness and some others to Section 0 Introduction to oppositions – Annex 1 Structure of Decisions. Finally, it is worth noting that recent examples have been added to this chapter.

Part C, Section 6 Proof of Use

Brief description

The Guidelines on Proof of Use are divided into three sections: an initial section on General Considerations, followed by a section on Substantive Law which describes in detail the fundamentals of genuine use. In particular, it contains practice guidance on the standard of proof applied by the Office, the assessment of the nature, time, extent and place of use. The closing section deals with Procedure.

Changes

The most relevant modifications regard the following aspects.

- Time of use: clarifications have been included regarding time of use of an international registration.
- Place of use: the findings in the judgment *Onel/Omel* were already included in the Manual under a fast-track procedure in May 2013. This section in the Guidelines has only been slightly modified following comments received from national offices.
- Justifications for non-use: clarifications regarding on-going litigation, threats to litigation and interim injunctions have been included.
- Recent case-law has been added: *Walzerträum* and extent of use, *Proti* and use of other registered marks, *MAD* and use of a black and white trade mark in colour; *Outburst* and probative value of declarations.
- Following comments from national offices, some unclear examples have been deleted or reworded and some drafting changes have been introduced to the sub-sections on standard of use, use for the relevant goods and services and the requirement of a request by the applicant.

Knowledge Circles: ‘Proceedings’, ‘Goods and Services’ and ‘Relative Grounds’

Registered Community Design **RCD**

Adoption of the Guidelines on the Examination of Design Invalidation Applications

As part of the Office's ongoing commitment to ensuring the best possible quality in the services provided to its users, the Guidelines on the examination of invalidity applications in respect of registered Community designs ('RCD') have been revised and updated. These Guidelines will become effective on 1 February 2014.

The purpose of the Guidelines is to make available to RCD applicants and legal practitioners a point of reference which reflects the practice of the Office. The revision focused on both procedural and substantive issues with the aim of aligning, where possible, the RCD invalidity proceedings with the CTM cancellation practice. The case-law of the Boards of Appeal and of the Luxembourg courts has also been integrated into the Guidelines in order to foster coherence and predictability with respect to RCD invalidity decisions.

The main innovations can be summarised as follows.

1. The Guidelines emphasise that the application for a declaration of invalidity of an RCD shall contain a clear and precise statement of the grounds relied on by the invalidity applicant. New grounds subsequently put forward before the Invalidity Division will be automatically declared inadmissible.
2. The exchange of the parties' submissions is in principle limited to one round except in limited circumstances. The applicant for invalidity will be allowed to reply to the holder's observations in the following circumstances:
 - where the holder's observations contain new facts, evidence and arguments which are *prima facie* relevant for a decision on the merits; or
 - where the holder requests to maintain the Community design in an amended form; or
 - where the holder requested proof of use of the earlier trade mark relied on under Article 25(1)(e) CDR.
3. In compliance with judgment of 12/05/2010, T-148/08, 'Instrument for writing', where the invalidity applicant claims that the RCD shall be declared invalid on the basis of a conflict with an earlier trade mark within the meaning of Article 25(1)(e) CDR, the RCD holder is entitled to request proof of use of the earlier trade mark in his/her first observations in reply to the application. In this respect the same rules as those applying to CTM opposition proceedings will apply.
3. Regarding substantive issues, the Guidelines mirror the position adopted by the Boards of Appeal with respect to the interpretation of the notion of functionality, within the context of Article 8(1) CDR. The approach adopted is one which does not look at alternative shapes, but rather considers only the design at issue. Article 8(1) CDR does not require that a given feature is the only means by which the product's technical function can be achieved, but rather requires an evaluation of whether the technical function in question was the only relevant factor in the selection of that given feature (the key word in Article 8(1) CDR being 'solely'). The fact that a particular feature of a product's appearance is denied protection by Article 8(1) CDR does not mean that the whole design must be declared invalid, pursuant to Article 25(1)(b) CDR. The design as a whole will be invalid only if *all the essential features* of the appearance of the product in question were solely dictated by its technical function.
4. Finally, it is recalled that when examining an application for an RCD, the Office does not verify whether the application concerns the 'same design or utility model' whose priority is claimed. However, the examination of a priority claim will be carried out by the Office if the invalidity applicant challenges the validity of this priority claim, or if the holder challenges the effects of the disclosure of a design for purposes of Articles 5, 6 and 7 CDR, where the disclosure occurred within the priority period.

In such a case, the Office will examine whether the priority claim is valid. A priority claim relating to the 'same design or utility model' requires identity with the corresponding RCD without addition or suppression of features.

Knowledge Circle 'Designs'

EUTMDN Updates

CP1 Harmonisation of Classification Meeting

OHIM hosted the last meeting of 2013, planned by the Convergence Programme on the harmonisation of classification.

Representatives from all national and regional EU IP offices were in attendance, as well as representatives from the user associations Marques and INTA.

Discussions focused, among other things, on the implementation of the Guidelines on the acceptability of classification terms as well as the creation of a list of non-acceptable terms, agreed by all parties present.

There was also a status update on the following initiatives: Inclusion of WIPO G&S Manager terms and Terminology Maintenance Console - Harmonised Workflow.

Finally, the common practice on the 11 non-acceptable general indications of the Madrid system were also discussed as participants agreed on the next steps for its implementation.

Cyprus and Estonia join Similarity

The Department of Registrar of Companies and Official Receiver of Cyprus and the Estonian Patent Office have joined Similarity.

Similarity is a common database of comparisons of goods and services that allows users to assess whether given goods or services are considered similar or dissimilar – and to what degree – according to the practice of the participating IP offices.

With these two new integrations, similarity already offers this information from 10 European IP Offices.

Czech Republic joins DesignView

The Industrial Property Office of the Czech Republic has joined the DesignView database, becoming the eleventh National Office to do so.

With the integration of almost 59 000 new designs from the Czech Republic, DesignView now boasts over 1.2 million designs in just one online database.

Czech Republic, Lithuania and Poland join e-Learning

The Industrial Property Office of the Czech Republic, the State Patent Bureau of the Republic of Lithuania and the Polish Patent Office have joined the e-Learning for SMEs tool.

The online tool informs users in a concise manner about the different types of IP rights applicable to the selected products or services and how to protect them effectively.

After these three new integrations, the tool is now available in 17 European languages.

E-services live in Slovakia

The Industrial Property Office of the Slovak Republic has implemented the e-Services project, developed by OHIM's Cooperation Fund.

The e-Services integration marks another success for the Slovak Office and the Cooperation Fund teams. In July e-filing for trademarks was implemented in the Slovak Office headquarters, a key milestone in the rollout of the Cooperation Fund projects across the European Trade Mark and Design Network.

Slovakia and Estonia are pilot offices for e-Services, which is being integrated in both sites thanks to the hard work of teams on the ground, in cooperation with OHIM staff.

The e-Services project aims to develop a set of web-based tools for national and regional EU IP Offices to facilitate the electronic filing of trade mark oppositions, trade mark and design registrations, trade mark and design renewals, trade mark cancellations and design invalidities.

More information on the Cooperation Fund tools can be found at www.tmdn.org, the online home of the European Trade Mark and Design Network.

Software Package Back Office in Poland

The Polish Patent Office (PPO) has completed the final stages of the parallel go-live of the Back Office project.

The Back Office, developed by OHIM's Cooperation Fund, is a workflow-based system for handling trade marks and designs throughout the whole lifecycle of the process, from application to registration and publication. It also streamlines the working process, by helping users to create and monitor correspondence with clients.

Its auto completion system automatically fills in trade mark and design data into letters. The tool calculates fees, holding all information on one single page, and handles files, organising notes and correspondence.

The PPO team has already begun to register trade marks through the system, and has migrated many more. The Back Office was implemented thanks to huge efforts from Warsaw-based IT and IP experts, with support from OHIM colleagues in Alicante and on the ground in Poland.

PPO staff members are now working towards a full go-live in 2014.

More News



Mexico joins TMclass

We are pleased to announce the integration of The Mexican Institute of Industrial Property (IMPI) into TMclass.

This latest addition brings the total to 35 national and regional IP Offices, including OHIM, into the classification of the goods and services tool.

The Mexican Institute of Industrial Property is the first Latin American National IP Office to be integrated into the tool.

OHIM Guidelines – Adoption of Work Package 1

OHIM's project in transforming its current Manuals and Guidelines into a new set of updated Guidelines, which will be a unique source of reference for OHIM's practice, has taken another important step.

On 4 December 2013, the President of the Office adopted the new Guidelines, Work Package 1.

They will be published in OHIM's five working languages in the Official Journal at the start of next year and enter into force on 1 February 2014. Subsequently, Work Package 1 will be translated into all remaining official EU languages.

The Guidelines, Work Package 1, were adopted after extensive consultation with both internal and external stakeholders as well as OHIM's Administrative Board. Work Package 1 covers approximately half of OHIM's practice. The other half is currently still reflected in the Manuals.

NEXT STEPS: The second half of OHIM's practice, Work Package 2, has already gone through the internal process and will be published for consultation with external stakeholders, namely IP Offices and User Associations, at the beginning of 2014. After the external consultation exercise, the final drafts will be presented to OHIM's Administrative Board for consultation.

Work Package 2 is expected to be adopted by the President with a view to entering into force on 1 August 2014.

As from that date, all of OHIM's practice will be contained in the Guidelines which will be updated yearly and will be available in all official EU languages.

Monthly statistical highlights* November 2013 compared to November 2012

	2013	2012
Community trade mark applications received	9 443	9 654
Community trade mark applications published	8 670	8 137
Community trade marks registered (certificates issued)	8 171	7 306
Registered Community designs received	7 148	7 113
Registered Community designs published	7 572	6 703

* 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

Case C-383/12 P; Environmental Manufacturing LLP / OHIM; Judgment of 14 November 2013; Language of the case: EN

KEYWORDS: Dissimilarity of signs, Lack of reasoning, Likelihood of confusion, Nice Classification

RESULT: Appeal upheld (GC judgment annulled and case is remitted back to GC)

FACTS: The Opposition Division (OD) had dismissed opposition under Article 8(1)(b) and (5) as the signs were not found to be sufficiently similar. The Board of Appeal (BoA) annulled the decision and found Article 8(5) applicable. BoA found a risk of dilution of the distinctive character of the earlier mark, as 'the use by third parties of a wolf's (or canine's) head in relation to similar goods could dilute the unique, 'one-off image' disseminated by the earlier trade marks'.

The General Court (GC) dismissed the appeal. It found that there is a 'link' between the marks given the similarity of the signs and the goods. The GC held that the earlier mark's proprietor is required to adduce evidence that use of the later mark would be detrimental to the distinctive character of the earlier mark but it considered that neither Article 8(5) CTMR nor the Judgment of 27 November 2008, Case C-252/07, Intel, Rec. I-8823, required 'the proprietor of the earlier mark to show an additional effect, caused by the introduction of the later mark, on the economic behavior of the average consumer of the goods or services for which the earlier mark was registered' (Para. 53 of the GC judgment).

At paragraph 54 of its judgment, the GC said the following:

So far as concerns paragraph 77 of *Intel Corporation*, cited above in paragraph 27, it is apparent from the choice of words 'it follows' and from the structure of paragraph 81 of that judgment that the change in the economic behavior of the consumer, to which the applicant refers in support of its claim, is established if the proprietor of the earlier mark has shown, in accordance with paragraph 76 of *Intel Corporation*, that the mark's ability to identify the goods or services for which it is registered and used as coming from the proprietor of that mark is weakened, since use of the later mark leads to dispersion of the identity and hold upon the public mind of the earlier mark.

The Court of Justice (CJ) annuls this judgment and finds that the GC should have examined, as a condition for dilution, whether a change (or the risk of a change) in the economic behavior of the consumer was established.

Contested CTMA (Class 7)	Earlier CTM (Class 7)
	

SUBSTANCE: In OHIM's submissions, the change in the economic behaviour of the relevant consumer (*Intel*, Para. 77) follows from the dispersion of the reputed mark's image and identity (*Intel*, Para. 76), with the result that the first requirement is not autonomous in respect of the second as the two sides of the same coin (Para. 29-30).

The CJ dismissed this argument and considered the requirement of proof of an economic change 'autonomous' (Para. 35). In consequence, without adducing evidence that that condition is met, dilution (that is, the detriment or the risk of detriment to the distinctive character of the earlier mark) cannot be established (Para. 36).

While the dispersion of the reputed mark's image and identity in the public's perception is a subjective condition, the change in the economic behaviour of this public is an objective one. The objective condition cannot be deduced from the mere fact that consumers note the presence of a new similar sign in a way which is likely to undermine the earlier mark's ability to identify the goods for which it is registered as coming from the proprietor of that mark (Para. 37 and 39).

A 'higher standard of proof' is required under Article 8(5) CTMR for a finding of dilution. The GC should have examined if actual change in the economic behaviour had occurred, or if a risk thereof was likely to occur on the basis of 'an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case' (Para. 43). Since it failed to do so, the GC violated Article 8(5) CTMR. The case is remitted back to the GC (Para. 49).

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

Case T-388/12; Daniel Singer, v OHIM; Judgment of 16 October 2013; Language of the case: EN

KEYWORDS: Admissibility, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Similarity of the goods and services, Specialised public, Visual similarity

RESULT: Action dismissed

FACTS: The CTM applicant sought to register the sign **CORDIO** as a CTM for *inter alia* services in Class 42. The opponent based its opposition on Article 8(1)(b) CTMR and the earlier CTM **CORDIA**, registered for services in Class 42. The Opposition Division (OD) upheld the opposition. The Board of Appeal (BoA) dismissed the applicant's appeal, finding that there was likelihood of confusion, taking into account, the identity and similarity of the services and the high visual and aural similarity of the signs. The applicant appealed to the GC, arguing an infringement of Article 8(1)(b) CTMR.

SUBSTANCE: The Court confirmed settled case-law stating that a general reference to documents filed during the administrative procedure, as done by the applicant, is inadmissible. While references to certain passages in extracts from documents annexed to it, are acceptable, a general reference to documents, even those annexed to the application, cannot make up for the absence of the essential arguments in the application, and it is not for the Court to place itself in the parties' position and seek the relevant information in the annexes (Para. 14-17).

The applicant requested the Court to appoint an expert to obtain evidence. The Court held that it has a wide discretion in that respect according to Article 70 of the Rules of Procedure, whereby the Court 'may' order an expert's report. In the case at hand the Court rejected the request because it had been done in an inordinately brief manner and secondly because the Court considered that it had sufficient information from the documents in the file (Para. 18-19).

The Court confirmed that the services to be compared are identical and similar. The different marketing intentions of the parties, as put forward by the applicant, are not relevant (Para. 36). The contested decision was right to conclude that the signs are visually and aurally highly similar. From a conceptual point of view the signs are different, but only for part of the relevant public (Para. 45). Finally, the Court held that even for professionals there would be likelihood of confusion between the marks (Para. 48).

Case T-451/12 Stromberg Menswear Ltd v. OHIM & Leketoy Sotrmberg Inter AS; Order of 24 October 2013; language of the case: EN

KEYWORDS: Admissibility, Adversely affected, Appealable decision, Lack of reasoning

RESULT: Action dismissed.

FACTS: The CTM applicant sought to register the figurative sign **STROMBERG** in Class 25. The opponent/intervener opposed the registration on the basis of its earlier CTM **STORMBERG** for goods in Class 25. The Opposition Division (OD) upheld the opposition. The applicant appealed before the Board of Appeal (BoA). In parallel, it also applied for revocation of the earlier CTM on the basis of Article 51(1)(a) CTMR. The opponent/intervener informed OHIM that it wished to surrender the CTM **STORMBERG**. The surrender was registered on 3 January 2011. On 11 January 2011 the opponent/intervener filed a request with OHIM for conversion of its CTM into 8 national trade mark applications. By decision of 11 January 2011, the Cancellation Division (CD) closed the revocation proceedings for lack of purpose. The CTM **STROMBERG** was registered on 2 May 2011. On 19 December 2011 the opponent/intervener submitted an application for a declaration that the CTM **STROMBERG** is invalid, relying on its national *converted* marks. On 17 February 2012, the applicant filed two notices of appeal with OHIM, the first against the CD's decision of 11 January 2011, the second against the decision whereby OHIM accepted the request for conversion filed by the opponent/intervener. In both appeals, the applicant relied on the provisions relating to *restitutio in integrum*. On appeal against the first decision (R 389/2012-4), the BoA rejected the request for *restitutio in integrum*, declared that the appeal should be deemed not to have been filed and ordered the reimbursement of the appeal fee.

Before the General Court, the applicant alleges three pleas: an infringement of the obligation to state reasons, a breach of Article 81(1) CTMR, and an infringement of Articles 58(1) and 76(1) CTMR.

SUBSTANCE: As the decision of the Board is sufficiently reasoned, the first plea is rejected as manifestly lacking any foundation in law (Para. 31). Also the alleged breach of Article 81(1) manifestly lacks any foundation in law. The applicant should not have excluded the possibility that the intervener would file a request for conversion of its CTM after it had surrendered it. A party who applies for revocation of a CTM on grounds of non-use has a legitimate interest in continuing the revocation proceedings in spite of the surrender of the CTM by its proprietor (Para. 48). Accordingly, the request for *restitutio in integrum* is not due to deficiencies on the part of OHIM, but to a lack of due care on the part of the applicant, who did not file a notice of appeal in due time against the CD decision, although nothing was preventing it from doing so (Para. 54). As to the alleged breach of Articles 58(1), the Court finds that there is no decision subject to appeal by which the CD authorised the conversion of the CTM into national marks. This plea is ineffective and lacks any foundation in law (Para. 57). Finally, the claim based on Article 76(1) CTMR is presented shortly. The way in which OHIM infringed the rules invoked is not clarified and the claim is rejected as manifestly inadmissible.

Case T-457/12 Stromberg Menswear Ltd v. OHIM & Leketoy Sotrmberg Inter AS; Order of 24 October 2013; language of the case: EN

KEYWORDS: Admissibility, Adversely affected, Appealable decision, Lack of reasoning

RESULT: The action is dismissed.

FACTS: The CTM applicant sought to register the figurative sign **STROMBERG** in Class 25. The opponent/intervener opposed the registration on the basis of the earlier CTM **STORMBERG** for goods in Class 25. The Opposition Division (OD) upheld the opposition. The applicant appealed before the Board of Appeal (BoA). In parallel, it also applied for revocation of the earlier CTM on the basis of Article 51(1)(a) CTMR. The opponent/intervener informed OHIM that it wished to surrender the CTM **STORMBERG**. The surrender was registered on 3 January 2011. On 11 January 2011 the

opponent/intervener filed a request with OHIM for conversion of its CTM into 8 national trade mark applications. By decision of 11 January 2011, the Cancellation Division (CD) closed the revocation proceedings for lack of purpose. The CTM STROMBERG was registered on 2 May 2011. On 19 December 2011 the opponent/intervener submitted an application for a declaration that the CTM STROMBERG was invalid, relying on its national *converted* marks. On 17 February 2012, the applicant filed two notices of appeal with OHIM, the first against the CD's decision of 11 January 2011, the second against the decision whereby OHIM accepted the request for conversion filed by the intervener. In both appeals, the applicant relied on the provisions relating to *restitutio in integrum*.

On appeal against the second decision (R 428/2012-4), the BoA dismissed the appeal relating to the request for conversion filed by the intervener as inadmissible. It found that no decision concerning that conversion had been notified to the applicant, who was not a party to those proceedings.

Before the General Court (GC), the applicant alleges three pleas. An infringement of the obligation to state reasons, a breach of Rule 48(1)(c) CTMIR, and an infringement of Article 81(1) CTMR.

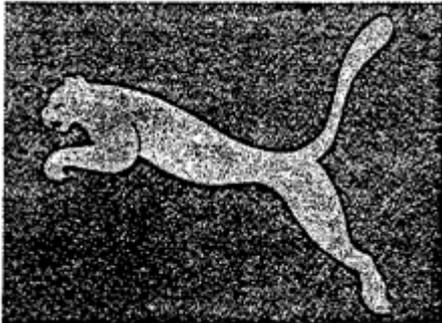
SUBSTANCE: As the decision of the Board is sufficiently reasoned, the first plea is rejected as manifestly lacking any foundation in law (Para. 30). The second plea, alleging infringement of Rule 48(1)(c) CTMIR and Article 57-60 CTMR, is also rejected as manifestly lacking any foundation in law (Para. 39). The request for conversion could only be filed by the proprietor of the CTM and there was no other party to the proceedings (Para. 34). Therefore, the applicant cannot challenge the outcome of such proceedings or any decision taken by OHIM in respect of the proprietor of the CTM. The plea alleging infringement Article 81(1) CTMR is ineffective. Even if it were to be assumed that OHIM erred in rejecting the request of *restitutio in integrum*, the fact remains that the appeal was inadmissible since there was no challengeable act (Paras. 44-46).

Case T-666/11; Danuta Budziewska v OHIM; Judgment of 7 November 2013; Language of the case: PL

KEYWORDS: Design: Informed user, Design: Overall impression, Individual character

RESULT: Action dismissed

FACTS: The contested Community design registered for 'logos' was declared invalid on grounds of Article 25(1)(b) in conjunction with Articles 4 and 6 CDR (lack individual character). The Board of Appeal rejected the appeal and took the view that the contested design and that contained in the earlier trade mark makes similar overall impression. The CD design owner filed an action before the Court.

Contested design	Earlier TM IR 369 072
	

SUBSTANCE: The first head of claim is directed against the decision of the Invalidity Division asking the Court to annul it. It follows from the statement of reasons that the claim encompass the annulment of the contested decision of the Board

and is therefore admissible (Para. 18). The design does not have the individual character that is required according to article 6 CDR (Para. 20). The assessment of the individual character should be carried in a four-step examination, comprising, first, the product in which the contested design is intended to be incorporated or to which it is intended to be applied, second, the informed user, their knowledge of the designs existing in the sector concerned and their level of attention, third, the degree of freedom of the designer and fourth, overall impression produced by the designs at issue on the informed user (Para. 21). Individual character is assessed on the basis of the overall impression made by the design on an informed user. The concept of the informed user refers to a legal fiction of a person who according to the case law is situated between the concept of the average consumer in trade mark law and an expert in patent law. The higher their knowledge and level of attention are, the more likely the individual character of a design will be acknowledged (Para. 32). Both designs in question corresponds in their overall impression of a jumping feline seen by side, directed to the left, with a lifted tail, presented in bright colour on dark background (Para. 36). The argument of the design owner that one design shows a wild puma, the other a house cat must be rejected. It is first, not well founded, since both animals have characteristic slim and elastically wild bodies. Secondly, the zoological qualification of the animals is not decisive for the overall impression (Para. 38).

T-533/12; IBSolution GmbH v OHIM ; Judgment of 7 November 2013; Language of the case: EN.

KEYWORDS: Acronym, Beginning of mark, Conceptual dissimilarity, Dominant element, Figurative trade mark, Likelihood of confusion

RESULT: Action dismissed

FACTS: The applicant sought to register the word mark 'IBSolution' as a CTM for services in Classes 35, 41 and 42. An opposition based on the earlier figurative mark depicted below registered for services in Classes 35, 41 and 42, was filed on the grounds of Article 8(1)(b) CTMR against all the above mentioned services. The Opposition Division upheld the opposition in its entirety. The Board of Appeal (BoA) dismissed the appeal. The applicant filed an action before the General Court (GC).

CTM applied for	Earlier CTM
IBSolution	

SUBSTANCE: The GC rejected the CTM applicant's plea alleging an infringement of Article 8(1)(b) CTMR so far as the Board found the marks overall similar. The GC confirmed in particular the finding of the contested decision that the dominant element of the earlier mark is the letter group 'ibs', which will more strongly attract the attention of the relevant public, in the light, first, of the size and position (in the beginning) of those letters and, secondly, of the fact that, in accordance with the case-law, consumers will more readily refer to the word element than to the figurative elements (Para. 33). On the other hand, since the mark applied for has a meaning (solution) and the earlier mark none, the GC considered that the BoA erred in finding that there was a conceptual similarity between the signs at issue (Para. 51). That error, however, is not such as to invalidate the Board's finding that the signs at issue are similar and that there is a likelihood of confusion, in the light of the existing visual and phonetic similarities (Para. 52). Finally, the applicant's arguments relating to the widespread use of acronyms consisting of the same letters as those making up the earlier mark was dismissed since the applicant has not shown that the letter combination 'ibs' was descriptive as regards both the services at issue and the relevant public's perception of them (Para. 59). Moreover, the GC reminded that, according to the case-law, even in a case involving an earlier mark of weak distinctive character, there may be a likelihood of

confusion on account, in particular, of a similarity between the signs and between the goods or services covered (Para. 57).

Case T-63/13; Three-N-Products v OHIM; Judgment of 7 November 2013; Language of the case: FR

KEYWORDS: Complementary goods and services, Identity of the goods and services, Likelihood of confusion, Relative grounds, Similarity of the goods and services, Similarity of the signs

RESULT: Action dismissed

FACTS: The CTM proprietor registered the word mark **AYUR** in Classes 3, 5 and 44. A cancellation request based on the earlier marks **AYUS**, registered in the Benelux for, goods in Classes 5, 29, 30 and 31, was filed on the grounds of Article 53(1)(a) in conjunction with Article 8(1)(b) CTMR. The Cancellation Division cancelled the registered CTM for all the products and services for which it was registered. The Board of Appeal confirmed the cancellation decision.

SUBSTANCE:

On the relevant public

The Court held that the Board of Appeal was correct in the finding that the level of attention of the relevant public will be normal for products and services of the earlier mark except for those related to medical care. For those ones the level of attention will be high.

On the comparison of the signs

The General Court confirmed the Board's assessment that the signs have an average/high degree of similarity from the visual and phonetical point of view but conceptually neither sign has a meaning for the relevant public.

Even if the relevant public or a part of this public namely those who like the alternative medicine or the professionals of beauty and health can associate the word AYUS with Ayurveda this public will also associate the term AYUR with Ayurveda and in this case the signs could be considered similar from the conceptual point of view.

On the comparison of goods and services,

The General Court confirmed the assessment of the cancellation division and of the Board of Appeal that the products of Class 5 are identical with the products of Class 5 in one of the earlier marks, the services of Class 44 of one of the earlier rights and the goods included in Class 5 products of the contested mark are complementary. Finally the products included in Class 3 of one of the earlier trademarks are similar to those included in Class 5 of the contested mark.

On the overall assessment, the General Court confirmed the conclusion of the Board that the earlier marks have a normal level of distinctiveness and that taking into account the identity or similarity of the goods and services and the similarity of the signs and having considered normal the level of distinctiveness of the earlier signs there is a risk of confusion between the signs. This conclusion is also valid for those products and services for which the relevant public will have a higher level of attention.

Case T-536/10; Kessel Marketing & Vertriebs GmbH v OHIM; Judgment of 8 November 2013; Language of the case: DE

KEYWORDS: Characteristics of the goods and services, Proof of use, Restriction of the list of goods and services

RESULT: Action upheld (BoA decision annulled)

FACTS: An opposition against the CTMA **Premeno** applied for 'vaginal ovules' in Class 5 was upheld on the basis of the earlier mark **Pramino**, registered in Germany for 'prescription medicines'. The use of the earlier mark was proven for 'prescription medicines', namely 'hormonal contraceptives'. The goods were considered identical, the marks similar and the likelihood of confusion was affirmed. In the appeal against this decision the CTM applicant requested a limitation of the goods applied for to 'non-prescription vaginal ovules against vaginal dryness and vaginal infections' When dismissing the appeal, the Board of Appeal (BoA) considered the limitation inadmissible and upheld the finding of likelihood of confusion.

SUBSTANCE: The Court annulled the decision due to an infringement of Article 43(1) CTMR. The case-law has recognized that a therapeutic indication is a relevant criterion for restriction of goods in Class 5 (with references to the cases **RESPICUR** and **ZUFAL**, Para. 44). The limitation is admissible as far as it concerns 'vaginal ovules against vaginal dryness and vaginal infections' (Para. 46). It is not admissible as far as the goods applied for were restricted to 'non-prescription' medicines. This criterion is not valid due to the lack of uniform rules governing sales of medicines requiring prescription within the EU (Paras. 47, 31 and 32). The inadmissibility of the limitation as far as it concerned the non-prescription medicines cannot lead to the conclusion that it was entirely irrelevant. The Board had to take into account the other part of the restriction which is based on the therapeutic indication (Para. 49). The decision has to be annulled on this reason (Para. 51). The claimed infringement of Article 42 CTMR - as far as it had not been found ill-founded - is therefore irrelevant, (Para. 34). Consequently, there is no need to decide on Article 8 (1)(b) CTMR.

Case T-377/10; Preparados Alimenticios, SA v OHIM and Rila Feinkost-Importe GmbH & Co. KG (intervener); Judgement of 18 November 2013; Language of the case: EN

KEYWORDS: Characteristics of the goods and services, Proof of use, Restriction of the list of goods and services

RESULT: ACTION DISMISSED

FACTS: The CTM applicant filed an application for registration of the word mark **JAMBO AFRICA** for the goods in Classes 29, 30 and 33. The opponent filed an opposition based on a number of previous CTMs and national Spanish figurative registrations, which included the word **JUMBO**. Jumbo was mainly represented on labels or product packages, and was a well-known mark for soups, broths, condiments and sauces. The Opposition Division upheld the opposition in part. The Board of Appeal (BoA) however rejected it, finding no likelihood of confusion on the part of the relevant public. The well-known mark was not considered, because non evidence of its use in the EU was submitted.

SUBSTANCE: On the admissibility of documents produced for the first time before the Court, The General Court (GC) ruled that as the purpose is to review the legality of decisions of the BoA, it is not the Court's function to review the facts in the light of documents produced for the first time before it (Para. 18). The GC confirmed the findings of the BoA as regards the relevant public, which consists of EU 'buyers', in particular Spanish 'buyers' of food products such as soups, broths, condiments and sauces (Para. 30). The applicant submissions that the public is made up of people particularly familiar with food from Africa and that the products can only be purchased in specialised shops were not accepted, because nothing in the wording of the marks suggests specific purpose of the goods (Para. 31). The presence of a description of an African foodstuff in one of the previous registrations and the word Africa in the application, are not sufficient to establish that a particular category of consumers is targeted by the mark applied for (Para. 32). The Court

also confirmed the reasoning of the Board as to the similarity of the goods, which vary from very high to low, according to the type of goods, as well as its assessment of the visual and conceptual dissimilarities. Phonetically however, the Board was wrong in finding identity. Considering the different number of words, letters and syllables, the signs have only slight degree of aural similarity (Para. 50). In view of the nature of the goods, which require visual perception by the relevant public (Para. 61), the phonetic similarity is of limited significance. In this regard, the visual and conceptual differences between the signs are sufficient to preclude likelihood of confusion on the part of the relevant consumer (Para. 62). The Court did not accept the claims of the applicant as regards the increased distinctive character of the previous trademarks, stating that the documents submitted (an excerpt from the applicant's Internet site displaying the mark JUMBO, a worldwide list of registrations of the earlier marks, catalogues of the products, a list of consolidated data relating to the monthly sales for a certain period in certain African countries, a list of expenses incurred in respect of advertising campaigns and local press reports also from Africa) did not indicate the market shares, the intensity, how geographically widespread and longstanding their use has been or the amount invested in promotion. (Para. 68). As regards the worldwide list of registrations of the earlier marks, the GC found that it could not by itself serve as proof not only for the reputation of the marks among the relevant consumers, but also for their actual use (Para. 69).

Case T-428/12 ; Banco Bilbao Vizcaya Argentaria, S.A.v OHIM; Judgement of 6 December 2013; Language of the case: ES

KEYWORDS: Absolute grounds, Descriptive element, Distinctive element, Laudatory mark, Slogan mark

RESULT: Action dismissed

FACTS: The CTM applicant requested the annulment of the decision of the Board of Appeal (BoA) dismissing the appeal against the Examiner's decision refusing to register the verbal sign **VALORES DE FUTURO** for services in Class 41.

SUBSTANCE: On Article 7(1)(c) CTMR, the Court notes that the applicant does not challenge the definition of the relevant public. Regarding the meaning of the expression **Valores de Futuro**, the Court confirms the validity of the assessment of the Second Board of appeal's decision (Paras. 18 and 19 of the contested decision) the expression is a meaningful expression in Spanish language. In relation with the descriptiveness of the sign for the services of 'education and training' in Class 41, the Court upheld the assessment of the Board of appeal when it said the expression VALORES de FUTURO is a sign capable of designating the type or the objectives of the services of 'education and training'. The relevant public will understand that the education and training services will pursue the objective of transmitting values. In relation with the allegation of the applicant that the expression is not used in the field of education and training the Court, referring to established case law (T-193/99 DOUBLEMINT), confirming that the fact that the expression may have other meanings is not relevant for the assessment that the sign is descriptive in relation with the type or the objectives of the services claimed for.

Even if the expression is not common in the Spanish market of education and training services the two elements that compose the expression: VALORES and FUTURO indicate firstly, the possible content of these services and the secondly makes reference to the moment in which this content may be obtained. Therefore the public who is familiar with these two concepts will, when confronted with the full expression make a concrete and direct link between the meaning of the sign and the services. As to the argument of the applicant that the Board did not motivate enough the decision the Court dismissed this argument as not correct. The Court confirms the correctness of the BoA's reference to the theory of 'education in values' to motivate and support its decision. The Board of appeal was not obliged to quote and cite concrete examples as the application of this theory and the meaning perceived by the relevant public for the expression VALORES de FUTURO is a question of public facts (Para. 31).

On Article 7(1)(b) CTMR, the applicant's allegation that the sign is distinctive for the other services of Class 41 claimed for (entertainment, sport activities, cultural activities, publishing of texts, publishing of books, organisation and direction of events and fairs, organisation and direction of workshops for training, vacations camps, videos renting and DVD) was rejected by the Court based on the case law applicable to slogans and advertising expressions (Paras. 44, 45). First of all

the Court rejected the claim of the applicant that the Board did not motivate its decision for each particular kind of service in Class 41. The Court maintained that the services applied for in Class 41 are sufficiently linked together. On the other argument, that the Board had made an incorrect assessment of the distinctiveness of the signs, the Court maintained that the relevant public, when confronted with the expression VALORES DE FUTURO, will perceive a laudatory promotional message, whose only objective is to give a positive view to the services involved (Para. 54).

Case T-361/12; The Premiere Polish Company Limited v OHIM; Judgment of 6 December 2013; Language of the case: EN

KEYWORDS: Admissibility, Colour mark, Conceptual similarity, Figurative trade mark, Infringement, Likelihood of confusion, Visual similarity

RESULT: Action dismissed

FACTS: The applicant sought to register the word **ECOFORCE**, shown below, as a CTM, *inter alia* for goods in Class 3. The opponent based an opposition on Article 8(1)(b) CTMR using the earlier figurative CTM, **ECO FORTE**, shown below, registered for goods in Classes 1, 3 and 5. The Opposition Division upheld the opposition, rejecting the CTM application in its entirety. The Board of Appeal (BoA) dismissed the appeal, finding that the Contested Goods were identical to goods of the earlier mark, that the signs display a low level of visual similarity, a high degree of phonetic similarity and are either conceptually similar, to the extent that meaning is accorded to 'ECO' and that the English and French publics perceive conceptual similarity between 'FORCE' and 'FORTE' (no similarity in Member States were there was no such understanding), and accordingly that there was likelihood of confusion. The applicant appealed to the General Court (GC), arguing an infringement of Article 8(1)(b) CTMR.

CTMA	Earlier CTM
<p style="text-align: center;">ECOFORCE</p>	

SUBSTANCE: Regarding admissibility, the GC confirmed that it is not for it to issue directions to OHIM, it is for OHIM to draw appropriate inferences from the operative part and grounds of judgments of the Courts of the EU. Thus, the head of claim requesting the GC issue directions to OHIM is inadmissible (Para. 17).

Substance: The relevant public tends to read from left to right, from top to bottom, and the size and configuration of the wording in the figurative mark creates no dominant word. 'ECO' may have conceptual links with 'ecological' but for the visual analysis it is a non-negligent element that cannot be ignored (Para-29). For the figurative element, the limited colours and banal arrangement of shapes with no distinctive character means that these elements have no semantic content, and are unlikely to make an impression or be remembered by consumers (Para. 35). Accordingly, there is low visual similarity (Para. 36). Conceptually, English and French may associate 'ECO' with ecological. There is a conceptual similarity between 'FORCE' and 'FORTE' ('strong point' and 'physical strength, respectively) (Para. 44). Moreover, the applicant did not contest the BoA assessment that the word elements in both signs would be perceived overall as invented words, as they have no inherent meaning in any EU language, and so the conceptual comparison remains neutral (Para. 43). In finding LOC, the BoA was not required to take into account the usual method of marketing of the goods in question – while OHIM may take this factor into account, in particular to determine the weight to accord the visual, phonetic and conceptual aspects of the marks, in this case the BoA rightly held that the visual differences are

insufficient to offset the other criteria correctly taken into account in the global assessment of LOC. In this case, the claim relating to the objective conditions under which the goods are marketed is irrelevant (Para. 52).

New Decisions from the Boards of Appeal

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

Please note that the full number including slash has to be entered in our database under 'Appeal N°', without the letter 'R'.

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

Decision of the Second Board of Appeal of 20 November 2013 in case R 127/2013-2 (FI)

Absolute grounds for refusal - Article 7(1)(b)CTMR - three dimensional mark – distinctiveness - goods in Classes 5, 32 and 33



The applicant sought to register the three dimensional mark consisting of a can for goods in Classes 5 (beverages for medical purposes, namely beverages that include substances for physical stress recovery. beverages for medical purposes, namely beverages that include substances for physical stress recovery), Class 32 (energy drinks, soft drinks, sports drinks) and 33 (alcoholic beverages (except beers)).

The examiner rejected the CTM application under Article 7(1)(b) mainly on the ground that it consisted of the representation of the goods applied for, hence consumers would not be able to identify it as a trademark as it lacks distinctive character.

Contrary to this, the Board believed that this three-dimensional can resembles a battery and is suggestive of more energy. The mark, as a whole, is original, stays in the consumer's memory and has at least the minimum amount of distinctive character. Consequently, the appeal was upheld and the Board concluded that, in the present case, the trade mark applied for was eligible for registration.

Decision of the First Board of Appeal of 6 November 2013 in case R 1745/2012-1 (ES)

Opposition proceedings - Rule 15 CTMIR – distinction between admissibility and substantiation – Infringement of Article 75 CTMR

The holder of the International Registration sought to register the mark  OMEGA for services in Class 42.

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

The Opposition Division upheld the opposition and rejected protection of the International Registration in the territory of the European Union for all the services at issue.

The Board underlined that in Opposition Proceedings, the relative ground on which the opposition is based (for example: 'Article 8(1)(b) CTMR' or 'Likelihood of Confusion') should not be confused with the reasoned statement of facts,

arguments and evidence that supports the opposition. The indication of the relative ground for refusal is required by Rule 15(2)(c) CTMIR and concerns, therefore, admissibility. The reasoned statement is required by Rule 15(3)(c) CTMIR and concerns, therefore, substantiation. It follows that if the opponent indicates, in the notice of opposition, the ground for refusal but submits no reasoned statement, the opposition is admissible but unfounded (see paragraphs 18 to 20). Moreover, according to the Board, the Opposition Division infringes Article 75 CTMR when it upholds an opposition on the basis of specific arguments that were made by the opponent but were not previously communicated to the applicant. The argument that the goods of the later mark are identical 'by inclusion' (in the sense that they are covered by the broader specification of the earlier mark) must be dismissed where the broader specification is imprecise (see paragraphs 34 to 35). Consequently, the Board decided to uphold the appeal, annul the contested decision and dismiss the opposition.

Decision of the Firth Board of Appeal of 23 October 2013 in case R 2106/2012-5 (EN)

Cancellation proceedings - Article 52(1)(a) CTMR – Article 7(1)(b) and (c) - distinctiveness - descriptiveness

The CTM proprietor registered the work mark EUROHEAT for goods in Classes 9 (thermostates) and 11 (apparatus for heating; this includes thermocables for floorheating and for protection from frost).

The cancellation applicant filed a request for a declaration of invalidity against the CTM registration in its entirety, within the meaning of Article 52(1)(a) CTMR, claiming that the CTM was registered in breach of Article 7(1)(b) and (c) CTMR.

The Cancellation Division rejected the request for a declaration of invalidity as being not well founded. It considered that the combination of the conjoined words 'EURO' and 'HEAT' does not create a purely descriptive message, but rather creates a neologism.

Contrary to this, the Board is of the opinion that the contested decision limited the examination of the mark to a certain perspective. However, it considers that both the first instance and the Board must examine all the possible meanings of a trade mark, as it will be (possibly) perceived by the relevant, in this case, professional public. The Board thus considers that the combination of the terms 'EURO' and 'HEAT' as EUROHEAT is quite specific, the goods are European heating devices and apparatus. Moreover, the Board considers that the expression applied for also conveys a laudatory or promotional message. Consequently, the Board declared the trademark EUROHEAT invalid.

The Registry also recommends

Decision of the Fifth Board of Appeal of 11 December 2013 in case R 1668/2013-5 (EN)

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

The applicant sought to register the word mark SUPEROLL for, *inter alia*, the following goods in Class 7 (tools and machines for metalworking; machines for burnishing; tools for burnishing; roller burnishing tools; centerless burnishing machines; micro dimple forming tools; deep rolling tools).

The examiner rejected the CTM application under Article 7(1)(b)(c) and 7(2) CTMR mainly on the ground that English consumers will perceive the expression SUPEROLL as meaning 'a thing that is rolled and that is of the highest quality'. The goods applied for are specialized products mainly aimed at the professional public. The expression SUPEROLL immediately informs consumers that the relevant goods are tools and machines, of outstanding quality, in the form of a roll.

The Board confirmed the examiner's decision. It considered that the mark is descriptive and was correctly rejected for all the contested goods. The expression 'SUPEROLL' immediately and directly informs the end-user of the kind and quality of the goods applied for in Class 7. End-users of the goods in question will immediately and without further reflection understand the abovementioned descriptive meaning of the expression SUPEROLL.

Consequently, the appeal was dismissed.

Decision of the First Board of Appeal of 24 October 2013 in case R 546/2013-1 (EN)

Opposition proceedings - Rule 19(2) CTMIR –substantiation of earlier rights –

The applicant sought to register the word mark PARFUMS LOVE for goods in Classes 3, 16 and 25.

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

The Opposition Division rejected the opposition in its entirety on the ground that with the evidence submitted, the opponent had not established that it was entitled to file the opposition.

According to the Board, the opposition cannot be rejected as unfounded because of the lack of substantiation since the opponent has filed, in due time, proof not only of the existence, validity and scope of protection of its earlier rights but also of its entitlement to file the opposition.

It considers that there is a (refutable) presumption of validity of the information recorded in a trade mark register. Whether there is a transfer of rights from one company to another or a mere change of the same company's name and address, depends upon the company and private international law applicable in the case at hand. Both the laws of Curaçao and of Switzerland allow a company to convert from a Curaçao NV into a Swiss AG without affecting its legal identity and continuity.

Consequently, the Board remitted the case to the Opposition Division for further examination of the opposition on its merits.