



Observatory Working Groups Meet in Brussels

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The Observatory's working groups meet in Brussels

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The Observatory was transferred to OHIM's Alicante headquarters on the 5th of June 2012, by virtue of Regulation 386/2012. Since its transfer, it's gained a new management team, with Paul Maier, the outgoing President of OHIM's Boards of Appeal, now serving as its first Director. The OHIM Academy, the Office's knowledge and learning repository, was also transferred to become part of the Observatory.

The Observatory held its first Plenary meeting, in September last year. There, stakeholders were presented with a draft Work Programme, which had been created on the basis of their own feedback, given to the Observatory just after its transfer to OHIM. That draft was then turned into a Work Programme for 2013.

The Observatory is platform-based, gathering stakeholders from the public and private sectors to exchange views and share experiences. And its stakeholders form part of its four working groups – in public awareness, legal affairs, enforcement and economics and statistics.

Last month, the working groups gathered for a series of meetings in OHIM's Brussels office. They heard updates from Observatory staff on the progress of key projects, including the IP Value Study and the IP Perception Study, both of which will be major outputs of the Observatory in 2013.

The IP Value Study was begun in 2012, and is being carried out by OHIM's Chief Economist in cooperation with the Chief Economist of the European Patent Office. The Study benefits from collaboration with other renowned European and international institutions, including the European Commission, Eurostat, the OECD, the US Patent and Trademark Office and the UK Intellectual Property Office.

The aim of the research is to analyse the contribution of IP to the EU economy, as measured by GDP, employment and other variables such as growth and trade. The study's scope includes trademarks, designs, copyright, patents and geographical indications.

Also during 2012, a study on European Citizens and Intellectual Property: Awareness, Understanding, Attitude and Care was launched. The study aims to build on existing work done in EU member states, and will be backed up by qualitative and quantitative research, including 26,500 telephone interviews in each of the 27 member states plus Croatia, as well as a detailed literature review.

The aim of the study is to establish a level of understanding about what European citizens know about IP value and infringements. Work on this study is well underway and preliminary results are expected during 2013.

The two studies will be important outputs for the Observatory during 2013, and will form the basis for a part of its future work.

Interview



The James Nurton Interview

This month James Nurton interviews Michiel Haegens of Vereenigde in The Netherlands about *IP Translator* and *One!*, trade mark reform in Europe – and protecting Einstein's brand.

How did you become involved in trade marks?

My background was studying law at university. I started with Vereenigde in 2001 and I have stayed here ever since. I became head of the trade marks department about three years ago.

One of our university professors (who is now an advocate general at the Dutch Supreme Court) was very active and positive about trade marks. That triggered me and I then wrote a thesis and became enthusiastic myself. That's why I started in IP and it went on from there.

How big is your trade mark department?

We have about 20 people including eight attorneys and we do mainly trade mark and design prosecution and enforcement, as well as copyright work and domain name infringement and registration.

Overall, Vereenigde employs about 65 patent and trade mark attorneys who focus on prosecution. Like in many other countries, the profession of trade mark and patent attorneys is divided, only a few people practise both: with the trade marks, we tend to stick to the work we do best!

How many applications do you file?

We file around 200 applications at OHIM each year and about 650 applications in total. For Dutch companies the EU is a very interesting field of business so clients are very often interested in the CTM.

Interest in the CTM has increased, though there are now a few things going on that may influence the popularity. It's so cost-efficient and swift compared to national systems so it is hard to find a reason not to use it.

The *IP Translator* and *Onel/Omel* cases may influence the popularity of the CTM, though I don't think they will influence the filing trends at OHIM that much.

The judgment in *Onel* said that use in one country may be sufficient depending on the circumstances. Most CTM applicants use their marks in at least a couple of countries so they should be ok. If the Court had said "you have to use your mark in a substantial part of the EU" that would have had a big impact and made national systems more attractive.

The *IP Translator* decision on class headings is of equal importance. The spin out in the next couple of years may influence the CTM system quite severely: it will be interesting to see how in the end it is dealt with by OHIM but also in the national offices. Will any right be nullified because the applicant used a more generic wording but used it only on very specific products?

You see all kinds of different interpretations, for example in the Benelux office you have to add a specific wording saying you want protection in all of the class and then they copy-paste the whole list. That's slightly different from the UK where you have to put the list in yourself.

It will be horrible for clearance searches if many people stick to that system and apply for all class headings. You will end up with very big results from searching.

What do you expect from the proposed changes to the Directive and Regulation?

It is expected very soon. I noticed from leaked documents that the European Commission took the possibility to update these laws to heart: I noticed the implementation of case law (removal of "graphic representation" and the outcome of the Philips/Nokia judgment), as well as a serious fee restructure in for example application and renewal fees and even a change of name!

In practice, the implementation of case law doesn't make much of a difference: it was applied already, but it is good to see that the legislator put it down on paper as well.

How well do you think the CTM works?

I think it's a good system. It's very user-friendly. Any complaints I have are more on a case-by-case basis. It is very popular and I'm glad to note the results of projects to benefit the trade mark community such as TMView and DesignView. I'm curious about how they will turn out.

Do you think OHIM and the national offices are coming closer together?

The Benelux office was one of the offices with quite a well-developed database and systems and worked a lot with OHIM. But the views often conflict on issues such as use in one country and the use of class headings. The Benelux office may be seen as a bit of a problem maker but on the other hand an office that has explored the borders of IP protection for a number of years. And that's good if it stimulates the IP community.

What are the main developments in the Benelux?

There are some changes coming in the Benelux opposition system, which was introduced about 10 years ago. It's expected that this year they will revise some of the regulations, for example the two-month publication period will start from the same day rather than the first day of the next month. So it will be shorter in practice.

Another thing is now you can request a two-month extension to the cooling off period per request but that will be extended to four months. It will also be possible to file oppositions in English as well as Dutch and French, which was something that Dutch and Belgian multinationals in particular wanted. These changes should be implemented in the middle of 2013.

The Benelux Court of Justice rules on cases arising from the Benelux Treaty like a High and Supreme Court and they will have some extra work because they will become the appeal court for refusals and oppositions of the Benelux office. Today you can go to three courts in The Hague, Brussels or Luxembourg. That change should harmonise judgments: there is a huge difference now because the court in The Hague almost always follows the office, and the Brussels court almost always doesn't follow. It is a strange situation. Once it's harmonised it will be better.

In the future there are plans that the Benelux office will be an office where you can file an action for cancellation due to non-use, rather than having to go to court. That will make requesting a cancellation much faster and easier. That may happen next year.

Does the opposition system work well?

The opposition system has been good but could be better. There have been some hiccups due to personnel problems, for example people leaving and then the office not having enough attorneys to write the decision. So the time for the decision is too long. It may take a year after the last round of arguments before you get a decision.

They seem to have responded to that criticism as they now seem to be issuing a number of decisions, which is welcome.

Are Benelux filings still popular?

The Benelux office is pretty busy but they do see problems with designs, which are right down.

With trade marks, if you are a regional entrepreneur you can encounter many objections with CTMs. Benelux countries are very involved in trade and a Benelux registration can be a good basis for an international registration – you can get a registration normally in less than six months and you are less likely to get objections than with a CTM.

They also have the super-fast registration system, but it's mainly used where people have a court case and need a registration very quickly.

What is the most interesting case you have worked on?

I had an infringement case where I was acting for Einstein's estate in a Dutch dispute where another party was using the Einstein marks. I got a copy of Einstein's will saying he assigned all his rights to a third party. It was very old from about the 1920s and it was interesting to see how it still applied. It was the equivalent to saying: "I assign my name, all my trade marks, service marks etc", but in those days it was much more simple. He just said something general, which was interpreted as referring to all the commercial rights arising from his name. For example, all the restaurants that use Einstein's name have a licence from the estate.

What do you expect for the future?

Trade marks will change to some extent. Things have become much faster in the past 10 years. We will see gradual changes due to legal reforms and case law but I don't expect so many major changes in the next 10 years. The biggest change was of course the introduction of the CTM and RCD and the changes coming up won't be half as severe.

Community Trade Mark

CTM

Mexico joins the Madrid Protocol

On 19th February 2013, Mexico joined the other 88 contracting parties of the Madrid System by signing the Madrid Protocol. The Madrid system for the international registration of marks established in 1891 functions under the Madrid Agreement (1891), and the Madrid Protocol (1989). It is administered by the International Bureau of WIPO located in Geneva, Switzerland.

OHIM, represented by KC Register and other issues, was honoured to be invited to the celebratory events held in Mexico City, Monterrey and Guadalajara from 19-22 February and organised by the Instituto Mexicano de la Propiedad Industrial (IMPI) during which the first International Application based on a Mexican trade mark was received.

Representatives from WIPO, OHIM, USPTO, INTA and private practice law firms gave presentations on their respective roles within the Madrid System.

As of 19th February, CTM proprietors wishing to extend their protection via the Madrid System, and using the OHIM as Office of Origin may designate Mexico as one of the designated countries using the MM2 and MM4 (subsequent designation) forms or the OHIM's own EM2 and EM4 forms which have been updated to include Mexico. Mexico is the fourth country after the Philippines, New Zealand and Colombia, to join the Madrid Protocol in the last year.

The Madrid System allows for proprietors of a CTM application or registration (the basic mark), who are nationals of, have their domicile in or a commercial establishment in the European Union to extend the protection of their CTM application or registration to other contracting parties of the Madrid Protocol by simply filing one application directly via the OHIM. An international mark is equivalent to an application or a registration of the same mark effected directly in each of the countries designated by the applicant. If the trade mark office of a designated country does not refuse protection within a specified period, the protection of the mark is the same as if it had been registered by that office. The Madrid system also simplifies greatly the subsequent management of the mark, since it is possible to record subsequent changes or to renew the registration through a single procedural step. Further countries may be designated subsequently.

More information on procedures before the OHIM in relation to international marks can be found in Part M of the Manual: International Marks.

Knowledge Circle “Register and other issues”

Registered Community Design RCD

Jurisdictional issues involving infringement of a design

Last year, two judgments handed down by the Court of Justice of the European Union (CJEU) dealt with jurisdictional issues arising from infringement of copyright and trade marks. In an intra-EU setting, jurisdiction is a recurrent ‘headache’. These judgments have ramifications for designs, where the same results should logically flow.

The judgments:

In its judgment of 21 June 2012 in Case C-5/11, *Donner*, the CJEU found that a Member State is entitled to bring an action under national criminal law against a carrier for the aiding and abetting the prohibited distribution of copyright-protected works on national territory, even where those works are not protected by copyright in the seller's Member State.

The background to this case was that Mr Donner, a German national, had been found guilty by the Landgericht München II (Regional Court, Munich II, Germany) of aiding and abetting the prohibited commercial exploitation of copyright-protected works. More particularly, he had distributed replicas of Bauhaus furnishings, originating in Italy (where they were not protected by copyright), in Germany. The replicas had been offered for sale in Germany by an Italian undertaking using advertisements and supplements in newspapers, direct publicity letters and a German-language internet website.

Carriage of the goods to Germany was recommended to be made through Mr Donner's transport company, which picked up the goods in Italy and collected the purchase price and freight charges from the customer on delivery in Germany. Legal title to the goods was transferred in Italy to the German customers but transfer of the power of disposal over the goods only took place when the goods were handed over to the purchaser in Germany, with the help of Mr Donner. Thus, the Regional Court, reasoned that the distribution for the purposes of copyright took place in Germany, where it was prohibited unless authorisation had been given by the copyright holders.

Mr Donner appealed on a point of law against the lower court's judgment to the Bundesgerichtshof (Federal Court of Justice, Germany). That court referred a preliminary reference to the CJEU on whether the applicable German criminal law led to an unjustified restriction on the free movement of goods.

The Court of Justice held:

1. For national criminal law to apply there must have been 'distribution to the public', on the national territory, within the meaning of Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society (OJ 2001 L 167, p. 10). A trader who directs his advertising at members of the public residing in a given Member State and creates or makes available to them a specific delivery system and payment method, or allows a third party to do so, thereby enabling those members of the public to receive delivery of copies of copyright protected works in that same Member State, makes a distribution in that Member State.

In its judgement of 19 April 2012, C-523/10, *Wintersteiger*, the CJEU held that "an action relating to infringement of a trade mark registered in a Member State because of the use, by an advertiser, of a keyword identical to that trade mark on a search engine website operating under a country-specific top-level domain of another Member State may be brought before either the courts of the Member State in which the trade mark is registered or the courts of the Member State of the place of establishment of the advertiser".

The facts of the case were that Wintersteiger, an Austrian producer of ski products, had registered the word mark, 'WINTERSTEIGER', in Austria and Germany. A German competitor, making accessories for Wintersteiger's tools, registered (without the trade mark owner's consent) 'Wintersteiger' as a Google AdWord for searches carried out using the top-level domain ".de" (Germany). This caused a sponsored link to the competitor's website to appear on the right-hand side of the page, every time 'Wintersteiger' was entered into "google.de" (for Germany but not for Austria).

Wintersteiger sought an injunction in Austria to stop the competitor using its trade mark as an AdWord on the google.de search engine.

The *Oberster Gerichtshof* (Austrian Supreme Court) was uncertain whether it was the court of the Member State where the harmful event had occurred and thus made a preliminary reference on this issue to the CJEU.

Conclusions

Where IP rights and Member State law have been violated, the Court seems willing to engage in a certain amount of flexible thinking. Imperatives of free trade cannot justify an abusive situation where counterfeit goods from a Member State in which there is a loophole in the law allowing them to be marketed there, are allowed to enter a Member State with tighter legal requirements. Similarly, an abusive AdWord must be stopped. Even if many Austrians would not use the .de to make Google searches, they could do and thus the Court seems to send a clear message that infringers cannot hide behind jurisdictional uncertainties to avoid liability.

The fact that the Court has demonstrated this flexibility in both copyright and trade mark cases, strongly suggests that similar results should flow in parallel situations involving designs. If this is so, it may offer some comfort to design holders who are caught up in the oftentimes complex imbroglio of jurisdictional rules.

Knowledge Circle "Designs"

10 Years Community Design Conference

As the date of the tenth anniversary RCD celebrations approaches, we took time out to speak with the co-chair of the international designs conference that will be held in Alicante on 8 and 9 April to commemorate the event, Mr Otero Lastres, professor of IP Law in Spain's prestigious Alcalá de Henares University.

In his short interview with us, he expressed his satisfaction at the evolution of the registered Community design right over the past decade and spoke with enthusiasm about the upcoming conference.

OHIM: What type of professionals do you expect to attend the forthcoming April design conference?

O.L.: The conference is an ideal event for people from three specific areas: the legal community, the business world and designers themselves. These three areas are the ones which are being targeted by the organisers of the event and discussions will be focused in these fields.

OHIM: What activities can attendees expect to see at the conference, and what's on the programme?

O.L.: The programme has been drawn up in a very balanced way and it will be taking a look into the history of designs in things like gastronomy, fashion and mobile technology, comparing it with how we think these areas will evolve in the future, with a view to preparing the way forward for the design world. It will also be a very interactive format, with round table discussions as opposed to monologue presentations.

OHIM: Who will we see giving the presentations?

O.L.: We have invited internationally renowned experts in the field of designs, from a variety of different countries, and some more locally, all experts in their chosen areas. The level is very high indeed and these are people who really have something to say about designs and a lot to offer the conference attendees.

OHIM: You have been in this for a long time, so perhaps you could tell us exactly what designs are all about?

O.L.: Yes, I've been studying designs since 1970, so more than four decades in the business should make me an expert. However, if I am honest, I have to say that I still don't really know what exactly a design is. It is such a subjective thing to grasp, so we are still all learning. The conference in Alicante is just one more stepping stone in that learning process.

OHIM: What advantages does an RCD offer companies and designers?

O.L.: Well, clearly the large geographical area covered by the right is highly attractive to companies using their designs in a number of different countries. National protection is, of course, still a valid option, but nowadays we see our innovative ideas growing and expanding beyond our control, and something we conceived to be merely local can suddenly be all over the world as people see it, so the EU wide option is very attractive. It is also quick and effective to get RCD registration, so that is another positive aspect of the right.

EUTMDN Updates**IPC&C out now!**

The Office has published its quarterly Cooperation Fund and Convergence Programme newsletter, IPC&C.

It contains all of the latest news from OHIM's Cooperation Fund and Convergence Programme, including an in-depth look at the November release of a wave of Cooperation Fund tools, a special feature on the Bulgarian Office, and what to look out for in 2013. Plus a special guide to all the huge network of "players" in the Cooperation Fund. Don't miss it!

[It is available for download on the OHIM website](#)

Latvia joins DesignView

The Latvian Office has been integrated into the DesignView database, becoming the ninth office to do so.

The other eight Offices that have integrated DesignView are: Portugal, Benelux, Estonia, Spain, Greece OBI, Bulgaria, Slovakia and OHIM.

More offices are expected to join in the coming months.

Romania joins Seniority

Romania has become the 13th EU National Office to implement the Seniority Project.

The Romanian office joins Lithuania, Estonia, Latvia, Sweden, the Slovak Republic, Bulgaria, Benelux, Slovenia, Ireland, Hungary, Portugal and the Czech Republic in implementation.

Having accurate seniority data is important for Community trade mark owners who have previously registered an identical mark in an EU member state which has been surrendered or allowed to lapse.

The project, a part of OHIM's Cooperation Fund, involves establishing links between entries in the national and Community databases and making the information accessible online.

More News



Internal Audit assessment

An independent external assessment of the OHIM's Internal Audit activity was carried out last year by SGS ICS España, in line with requirement of the International Standard 1312 and Practice Advisory 1312-1 which requires such a revision at least once every five years.

This is the first time ever the activities of the Internal Audit services have been assessed and five years since the appointment of Mr Javier Rujas as the OHIM Internal Auditor.

The results of the assessment reflect favourably on the Internal Audit Service and have been well received by the Office.

They can be accessed and downloaded on the [OHIM website](#).

OHIM on Twitter

The Office is an active user of Twitter and has almost reached the figure of 3.000 followers.

For daily updates on all things relating to #OHIM and the IP world, log on to Twitter and follow us at [@OAMITWEETS](#).

Monthly statistical highlights* January 2013 compared to January 2012

	2013	2012
Community trade mark applications received	9 212	7 771
Community trade mark applications published	11 742	10 266
Community trade marks registered (certificates issued)	7 384	7 472
Registered Community designs received	6 644	6 967
Registered Community designs published	7 987	7 607

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



Luxembourg Case Law

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

Case C-553/11; Bernhard Rintisch v Klaus Eder; Preliminary Ruling of 25 October 2012; Language of the case: DE

Keywords: Use not as registered

FACTS: The plaintiff, owner of the German marks **PROTI, PROTIPLUS and Proti Power**, sued the defendant, owner of the mark **Protifit**, for agreement to cancel Protifit. The plaintiff based itself mostly on its mark PROTI. The defendant argues that the plaintiff has not used PROTI. The plaintiff is of the view that its use of the terms PROTIPLUS and Proti Power constitutes use of PROTI in a form which does not alter its distinctive character. The Bundesgerichtshof asks the CJ various questions on the interpretation of use of the mark in a form which does not alter the mark's distinctive character, inter alia, whether it makes a difference if the sign that is used is itself also registered as a trade mark and the possible relevance if a mark has only been registered to secure or expand the protection of the mark which is actually used (defensive mark).

SUBSTANCE: The CJ found that Article 10(2)(a) TMD must be interpreted as meaning that the proprietor of a registered trade mark is not precluded from relying, in order to establish use of the trade mark, on the fact that it is used in a form which differs from the form in which it was registered, without the differences between the two forms altering the distinctive character of that trade mark, even though that different form is itself registered as a trade mark. There is nothing in the wording of Article 10(2)(a) TMD to suggest that the different form in which the trade mark is used cannot itself be registered as a trade mark (Para. 20). Furthermore, the purpose of Article 10(2)(a) TMD, namely to allow the trade mark owner, in the commercial exploitation of the sign, to make variations in the sign, which enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned, would be jeopardised, if, in order to establish use of the registered trade mark, an additional condition had to be met, namely that the different form in which that mark is used should not itself have been registered as a trade mark (Para. 22). The CJ considered that this finding was not incompatible with its findings in case C-234/06, *Il Ponte Finanziaria/OHIM*, which concerned the situation of a family or series of marks. The use of one trade mark cannot be relied on in order to prove the use of another trade mark where the aim is to establish use of a sufficient number of trade marks of a single family (Para. 29).

The CJ further found that Article 10(2)(a) TMD must be interpreted as precluding an interpretation of the national provision intended to transpose it into domestic law whereby Article 10(2)(a) does not apply to a 'defensive' trade mark which is registered only in order to secure or expand the protection of another registered trade mark that is registered in the form in which it is used. The subjective intention prevailing when it is sought to register a trade mark is wholly irrelevant for the purpose of applying that provision and, in this respect, there is no basis in the TMD or in any other provisions of European law for a concept of 'defensive' trade marks to which that provision does not apply (Para. 32).

Admissibility: The Court confirmed that the request for a preliminary ruling was admissible. Where the questions submitted concern the interpretation of EU law, the Court is in principle bound to give a ruling. The Court may refuse to rule on a question referred for a preliminary ruling by a national court only where it is quite obvious that the interpretation of EU law that is sought bears no relation to the actual facts of the main action or its purpose, where the problem is hypothetical, or where the Court does not have before it the factual or legal material necessary to give a useful answer to the questions submitted to it (Para. 16). These exceptions are not relevant in the case in issue.

Case C-149/11; Leno Merken BV v Hagelkruis Beheer BV; Preliminary Ruling of 19 December 2012; Language of the case: NL

Keywords: Place of use, genuine use, relevant territory

FACTS: The owner of the CTM **ONEL** opposed to the registration of the Benelux mark **OMEL**. The CTM owner had shown use of its mark in the relevant period in the Netherlands. The referring Court (Gerechtshof te 's-Gravenhage, Netherlands) asks the CJ various questions relating to genuine use of a CTM in the case of use in one Member State.

SUBSTANCE: The CJ found that Article 15(1) CTMR has to be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to 'genuine use in the Community' within the meaning of that provision. A CTM is put to 'genuine use' within the meaning of Article 15(1) CTMR when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.

The territorial scope of the use is not a separate condition for 'genuine use' but one of the factors determining 'genuine use', which must be included in the overall analysis and examined at the same time as other such factors (Para. 36). There is no reference in the text of Article 15(1) CTMR to the territories of the Member States (Para. 38). From the objectives pursued by the CTMR it is apparent that the CTMR seeks to remove the barrier of territoriality of the rights conferred on proprietors of trade marks by the laws of the Member States by enabling undertakings to adapt their activities to the scale of the Community and carry them out without restriction (Para. 40). The purpose of the CTM system is to offer on the internal market conditions which are similar to those obtaining in a national market (Para. 42). The systematic examination of the CTMR also supports that 'in the Community' does not refer to territories of Member States. From the examination of the text, objectives, purpose and the systematic examination, the CJ concludes that the territorial borders of the Member States should be disregarded in the assessment of 'genuine use in the Community' within the meaning of Article 15(1) CTMR.

The CJ does not consider that its interpretation is called into question by the Joint Statement No 10 regarding Article 15 CTMR, according to which '[t]he Council and the Commission consider that use which is genuine within the meaning of Article 15 in one country constitutes genuine use in the Community' or by OHIM's guidelines. A statement recorded in Council minutes, but not referred to in the wording of a provision of secondary legislation, cannot be used for the purpose of interpreting that provision (Para. 46). OHIM Guidelines are not binding legal acts for the purpose of interpreting provisions of European Union law (Para. 48).

The CJ considers that while there is some justification for thinking that a CTM should be used in a larger area than the territory of a single Member State in order for the use to be regarded as 'genuine use', it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a CTM has been registered is in fact restricted to the territory of a single Member State (Para. 50). It is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A de minimis rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot be laid down (Para. 55).

Case C-402/11 P; Jager & Polacek GmbH v OHIM; Judgment of 18 October 2012; Language of the case: DE

Keywords: Measure of organization of procedure, decision, communication, revocation of decision, admissibility

RESULT: Action upheld (GC judgment and BoA decision annulled)

FACTS: The opponent raised an opposition against the CTM application. It had ordered the payment of the opposition fee the day after the expiry of the opposition period and had paid the 10% surcharge. The opponent argued that the opposition had been duly entered as the surcharge had been paid. By letters of 20 May 2008 OD informed the opponent and the CTM applicant that the opposition was found to be admissible and notified the period within which the contentious part of the opposition proceedings was to commence. On 2 October 2008, OD sent a correction letter to the opponent, informing it that the letter of 20 May 2008 had been sent in error and that the opposition was considered as not having been duly entered. Upon the opponent's request for a formal decision, OD adopted a decision to that effect. The Board of Appeal dismissed the opponent's appeal, confirming that the opposition had not been duly entered. The Board considered that the OD's letter of 20 May 2008 did not constitute a decision capable of being revoked under Article 77a CTMR (now Article 80 CTMR), but only a measure of organization of procedure. In its judgment in T-488/09, the General Court took the same view, finding that the letter of 20 May 2008 (Rule 18(1) CTMIR) was simply a communication addressed to the opponent concerning the date on which the contentious part of the proceedings was to commence and that such a communication was not intended to produce legal effects. The GC dismissed the opponent's appeal. The opponent appealed to the Court of Justice, alleging a breach of Article 77a (1) and (2) CTMR (now Article 80 (1) and (2) CTMR).

SUBSTANCE: The CJ categorized the communication under Rule 18(1) CTMIR as a decision on the admissibility of the opposition. It considered that it is apparent from the wording of Rule 18 (1) CTMIR that the opposition proceedings themselves, i.e. the inter partes stage, commence only when OHIM has verified that the opposition is admissible and that none of the grounds set out in Rule 17 CTMIR precludes admissibility (Para. 49). Moreover, according to Article 57(2) (now 58 (2)) CTMR, there may be measures which, while they are adopted in the course of the proceedings and do not terminate them, nevertheless constitute decisions. The GC was wrong to hold that the letter of 20 May 2008 did not constitute the adoption of a definitive position by OHIM on the admissibility of the opposition (Para. 53). The categorisation of that communication as a decision on the admissibility of the opposition would not compromise the protection of the rights of the defence. The CTM applicant may submit to OHIM that an error has been made concerning the admissibility of the opposition and request that it withdraw the decision by which it found the opposition to be admissible, on the basis of Article 77a CTMR (now Article 80) (Para. 58). Secondly, it can seek annulment of the measure by an appeal against the decision adopted at the conclusion of the inter partes proceedings. In so far as that measure does not terminate the proceedings, it can be appealed together with the final decision on the substance of the opposition in accordance with Article 57(2) CTMR (now 58(2)) (Para. 63).

Case C-42/12 P; Václav Hrbek v OHIM; Order of 29 November 2012; Language of the case: EN

Keywords: Identity of the goods and services, similarity of the goods and services, dominant element, weak element, descriptive element, common element, similarity of the signs, complex mark

RESULT: Action dismissed

FACTS: The OD refused the CTMA in part under Article 8(1)(b) CTMR. It found that the goods were identical or similar, with the only exception of 'toys and games' in Class 28, and that the signs were similar, notwithstanding the low distinctive character of the word 'alpine'. The Board of Appeal dismissed the appeal. The GC dismissed the appeal (T-434/10). The GC endorsed both the comparison of goods and signs and confirmed that the term 'alpine' dominates the overall impression created by the signs, with the result that consumers retain it in their memory, whereas the other figurative and word elements are negligible for the relevant public. In its conclusion, the GC reiterated that, since the distinctive character of the earlier mark is only one factor among others which must be taken into account when assessing likelihood of confusion, the alleged weak distinctive character, or descriptive character, of the element 'alpine' cannot preclude a likelihood of confusion as, on the one hand, the goods covered by the two signs at issue are identical or have varying degrees of similarity and, on the other, the signs at issue are visually, phonetically and conceptually similar.

CTM applied for (Classes 18, 24, 25, 28)	Earlier Mark (Classes 18, 25)
	

SUBSTANCE: The CJ found that the GC had carried out a global assessment of likelihood of confusion (Para. 42) and considered that the findings regarding which element was dominant in the signs in conflict was essentially of factual nature – thus unsusceptible to be reviewed by the CJ (Para. 43). The CJ also reiterated that, as weak as an earlier mark may be, there is no principle according to which its scope of protection is only capable of preventing use, or registration of, a later identical or very similar mark covering identical goods (Paras. 61-62). The GC therefore committed no error in law in confirming a risk of confusion between the marks even if their only similarity derives from a common element which is largely evocative of the purpose of the goods (Para. 63).

Case C-261/12 P; Annunziata Del Prete v OHIM; Order of 17 January 2013; Language of the case: IT

Keywords: Competence of the Court, admissibility, reputation

RESULT: Action dismissed

FACTS: The CTM applicant sought the annulment of the General Court's judgment in Case T-420/10, which overturned the Board of Appeal's decision in R 1360/2009-2 that had allowed the CTM application to proceed to registration. The CTM applicant based the appeal on two pleas in law, namely the breach of Articles 8(1)(b) and 8(5) CTMR.

SUBSTANCE: As regards the first plea in law, the Court of Justice states that the CTM applicant seeks to substitute its own assessment of the facts for that carried out by the GC. The GC has exclusive jurisdiction to make findings of fact, save where a substantive inaccuracy in its findings is attributable to the documents submitted to it, and to appraise those facts. Therefore, that appraisal does not, save where the clear sense of the evidence before it has been distorted, constitute a point of law which is subject to review by the Court of Justice on appeal. Since the applicant did not claim that the evidence was distorted by the GC, the first plea in law was rejected as inadmissible (Paras. 27, 28). As regards the second plea in law, the applicant contends that the GC should not have considered the reputation of the earlier marks, since the appeal was based solely on Article 8(1)(b) CTMR and not on Article 8(5) CTMR, which had not been invoked (Para. 30). According to the Court of Justice, the likelihood of confusion is higher if the distinctive character of the earlier mark is higher, either inherently or because of its acquired reputation on the market. Therefore, the reputation of an earlier trademark may be relevant to assess the existence of a likelihood of confusion under Article 8(1)(b) CTMR. Since the opponent, Georgio Armani S.p.A., invoked the reputation of its trademarks before the Board of Appeal, and also presented evidence in that regard, the GC did not err in law when it held that the Board should have set out the reasons why it was concluded that the highly distinctive character of the earlier marks relied on in support of the opposition was linked exclusively to the element 'armani', while the opponent had relied on the reputation of those marks in their entirety. The second ground of appeal was rejected as manifestly unfounded (Paras. 37-39).

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

Case T-265/09; Enrique Serrano Aranda v OHIM; Judgment of 26 September 2012; Language of the case: NL

Keywords: Figurative trade mark, complex mark, similarity of the goods and services, complementary goods and services, visual similarity, phonetic similarity, conceptual dissimilarity

RESULT: Action dismissed

FACTS: The applicant sought to register the mark represented below as a CTM for goods within Classes 29 and 30. An opposition based on the earlier mark below, registered in Spain for goods in Classes 29, 30 and 31 was filed on the grounds of Article 8(1)(b)CTMR. The Opposition Division rejected the opposition. The Board of Appeal dismissed the opponent's appeal. The opponent filed an action before the General Court.

CTM applied for	Earlier Spanish Mark
LE LANCIER	

SUBSTANCE: The GC confirmed its jurisprudence in relation to Article 8(1)(b)CTMR and affirmed that there was no likelihood of confusion in Spain. It was not disputed by the parties that the relevant public was the average consumer in Spain. Regarding the comparison of the goods, the Court found, as the Boards did, that the goods of the earlier mark in Class 31 for which proof of use had been provided, were of a different nature, purpose and use than the goods applied for in Classes 29 and 30. The opponent argued that the goods were complementary, an argument that was not retained by the Boards. The GC admitted that there are some indications that the goods are complementary as pre-packaged vegetables, like prepared salads, are often sold together with dressings. However the Court specified that a certain degree of complementarity is not sufficient to conclude a high degree of similarity between the goods, as sustained by the

opponent. Moreover, the argument of the opponent that the goods were sold through the same distribution channels, namely department stores, is not considered relevant by the GC as a lot of different goods are sold through these distribution channels without the consumer thinking that they have the same origin. The GC concluded that given that there is a certain degree of complementarity between the goods they have a low degree of similarity. Visually, the GC found that the signs have a low degree of similarity. Phonetically the GC has concluded that the signs are almost identical. Conceptually, the GC has concluded that the average Spaniard only has a limited knowledge of French and that the expression 'le lancier' does not belong to the basic vocabulary of that language. Conceptually, the signs are not similar. Overall, the signs are similar to a low degree. As regards the likelihood of confusion, the GC has concluded that given the low degree of similarity of the goods and the low degree of similarity of the signs, no likelihood of confusion exists.

Case T-555/11; tesa SE v OHIM; Judgment of 13 November 2012; Language of the case: EN

Keywords: New evidence, first time on appeal, identity of the goods and services, similarity of the signs, figurative trade mark, common element, visual similarity, phonetic similarity, principle of legality, principle of non-discrimination

RESULT: Action dismissed

FACTS: The applicant sought to register the mark represented below as a CTM for 'self-adhesive products for office and household purposes' in Class 16. An opposition based, inter alia, on the earlier mark below, registered in Spain for 'bands, strips, sheets and adhesive matters for stationery or the household. Plastic sheets for packaging' in Class 16 was filed on the grounds of Article 8(1)(b)CTMR. The Opposition Division upheld the opposition. The Board of Appeal dismissed the applicant's appeal. The applicant filed an action before the General Court.

CTM applied for	Earlier Spanish Mark
	

SUBSTANCE: First of all, the GC rejected as inadmissible some documents which had been filed by the applicant for the first time before the Court.

The goods are identical (undisputed). The relevant consumer is composed, on the one hand, of the average Spanish consumer, reasonably well informed and reasonably observant and circumspect, and, on the other, of the professional Spanish user, who has a high degree of attention. As regards the comparison of the signs, the Court noted that the element 'tack' is important in the perception of the marks. Despite the differences (for example, that the common word element is reversed), there is a certain visual similarity between the signs. Moreover the Court also rejected the applicant's argument that 'tack' is considered by the relevant public to be descriptive. In view of a Commission survey which held that only 27% of the Spanish population has sufficient skills to have a conversation in English, the GC concluded that a large part of the relevant public does not have significant knowledge of English. Furthermore, the applicant failed to show that 'tack' is part of the basic English vocabulary with which the relevant public is likely to be familiar. Aurally, despite the fact that the element 'tack' is reversed, the GC confirmed the existence of a certain degree of aural similarity due to the common element 'tack', which is important from an aural point of view. Conceptually, given that the word 'tack' cannot be considered to be descriptive of the goods, the GC confirmed the Board's finding that the conceptual similarity is irrelevant.

As regards the assessment of the likelihood of confusion, the GC recalled that, if there is no likelihood of confusion, the degree of difference between the marks at issue must be high. However, in the present case there is a certain visual and aural similarity between the marks. The Court also dismissed the applicant's argument that there is case-law of marks sharing a common element without a likelihood of confusion. The applicant did not give precise details as to the specific guidance that such case-law could provide for the purposes of settling the present case. The GC also rejected the applicant's argument based on a decision of the Spanish Trademarks Office since, firstly, the CTM is an autonomous system and, secondly, the marks at issue are different from those examined by the Spanish Office. As a conclusion, the GC confirmed the Board's finding that there is a likelihood of confusion between the signs in dispute.

Case T-338/11; Getty Images (US), Inc v OHIM; Judgment of 21 November 2012; Language of the case: EN

Keywords: Distinctiveness acquired by use, non trade mark use, principle of non-discrimination, principle of legitimate expectations, principle of legality, function of a trade mark, internet

RESULT: Action dismissed

FACTS: The applicant sought to register the word mark **PHOTOS.COM** as a CTM for, among others, goods and services within Classes 9, 42 and 45. The examiner refused the application for registration on the ground that the mark applied for was descriptive and devoid of distinctive character. The Board of Appeal confirmed this decision. The applicant filed an action before the General Court.

SUBSTANCE: The Court agreed that the sign is devoid of distinctive character. It held that the relevant public is the average consumer in the European Union, drawn both from the general public and from professional circles, and deemed to be reasonably well-informed, observant and circumspect, although the level of attention which can be expected from a professional is inevitably higher. Furthermore, the Court confirmed that the mark applied for is composed of the term 'photos', which is an informal abbreviation of the word 'photographie' in French or 'photograph' in English, in its plural form, and the element '.com', which constitutes an extension of a domain name in so far as it is a generic TLD. The sign reproduces the characteristic structure of a domain name and will be perceived as such by the relevant public. The word 'photos', immediately informs the relevant public that the goods and services are related to photography or have photography as their subject matter. The element '.com', will immediately be recognised by the relevant public as referring to an internet site. It is a technical and generic element, the use of which is required in the normal structure of the address of a commercial internet site. Furthermore, the element '.com' may also indicate that the goods and services covered by the trade mark application can be obtained or viewed on-line, or are internet-related. On the assessment of Article 7(3) CTMR, the Court held that the evidence produced by the applicant relates almost exclusively to the use of the domain name 'photos.com'. However, use of the sign other than as a trade mark does not constitute proof of distinctive character acquired through use. Furthermore, the applicant has not demonstrated that the use made of the mark applied for has been representative, such as to show the market share held by the applicant, by virtue of that mark, in the English-speaking parts of the European Union. The Board of Appeal did not breach the principles of equal treatment and the protection of legitimate expectations by deciding differently than in other OHIM cases, including with regard to earlier registrations of two identical CTMs belonging to the applicant for other goods and services.

Case T-29/12; Erika Bauer v OHIM; Judgment of 28 November 2012; Language of the case: DE

Keywords: Transfer of a trade mark, party status, identity of the goods and services, visual similarity, phonetic similarity, similarity of the signs, general public, high level of attentiveness, beginning of mark, ending of mark

RESULT: Action dismissed

FACTS: The CTM applicant sought to register the word mark **Daxon** for goods in Classes 3, 5 and 10. The opponent based its opposition on the earlier CTM **DALTON**, registered for goods in Classes 3 and 5. The Opposition Division rejected the opposition due to a lack of likelihood of confusion. This decision was confirmed by the Board of Appeal. The CTM applicant appealed to the General Court. The CTM application was subsequently transferred to another party, which asked to have the party status before the GC transferred to it.

SUBSTANCE: The GC found that the change of party was admissible, since none of the parties to the proceedings objected to it and the transfer of the mark was registered in the CTM register (Para. 15). As regards Article 8(1)(b) CTMR, the Court confirmed that the relevant consumer of the goods in Class 3 is the general consumer of the EU and for Class 5 both the general and the professional consumer of the EU (not contested). The relevant consumer of the product 'artificial skin for surgical purposes' in Class 10 is a professional consumer (Paras. 21-23). The goods in Classes 3 and 5 are identical (not disputed). The goods in Class 10 could be similar to those of the earlier right. Both signs have an average level of distinctiveness (not disputed). The Board was correct in finding that the signs had only an average level of visual similarity and a relatively low level of phonetic similarity. Consumers will normally place more importance on the beginning of the sign. However, in comparatively short signs, the beginning, the end and the middle elements will have the same level of importance (Para. 28). The signs being compared consist of only one word each, composed of five or six letters respectively. The signs are made up of two syllables of which none is identical. The middle consonants, the letter 'x' on one hand and the letters 'l' and 't' on the other hand, are different and have a very different pronunciation (Para. 29). A conceptual comparison is not relevant as neither of the signs has a meaning (Para. 30). Even though the goods are identical (in case of Class 10 possibly similar), there is no likelihood of confusion, taking into account the average level of visual similarity, the low level of phonetic similarity, the average level of distinctiveness of the earlier right as well as the

fact that consumers have a high level of attention in the purchase of the products. The Court held this to be true not only for the goods in Class 5, but also for the goods in Class 3, stating that, although these products might be (bulk) commodities, consumers would be attentive in the purchase of products for personal hygiene (Para. 36). There is no likelihood of confusion.

Joined Cases T-537/10 and T-538/10; Ursula Adamowski v OHIM; Judgment of 29 November 2012; Language of the case: DE

Keywords: Agent mark, accession to the EU, consent of owner

RESULT: Action dismissed

FACTS: The CTM owner had a registration of two trade marks, namely one figurative mark shown below and a word mark **Fagumit**, for goods in Classes 12 and 17. The invalidity applicant claimed that the CTM was invalid on the basis of Articles 52(1)(b), 53(1)(b) and 53(1)(c) CTMR. It alleged that the CTM owner was acting in bad faith and that the applications were submitted without the consent of the invalidity applicant (owner of the Polish mark reproduced below registered for goods in Class 17). The CTM owner claimed that Article 165(4)(b) CTMR precluded the invalidity applicant from relying on Article 53(1)(b) CTMR. The Cancellation Division rejected the applications for invalidity. The Board upheld the appeal and declared the CTMs invalid. The CTM owner appealed to the GC.

Contested CTMs	Polish mark owned by the invalidity applicant
 <p data-bbox="336 1122 437 1151">Fagumit</p>	

SUBSTANCE: The Court held that the purpose of Article 165(4)(b) CTMR is not to preclude the proprietor of a mark from making an application for a declaration of invalidity where it has been possible to do so before the date of the accession to the EU (Para. 18). Unlike Articles 8(1), (2), (4) and (5) CTMR, Article 8(3) does not refer to marks registered or having effect in a Member State. Consequently, this ground may be relied upon even if that mark was registered only in a country outside the EU (Para. 19). Article 8(3) is designed to prevent the misuse of a mark by the trade mark proprietor's agent, as the agent may exploit the knowledge and experience acquired during its business relationship with the proprietor and therefore improperly benefit from the effort and investment which the trade mark proprietor himself made. The consent for the purposes of the registration of the mark in the name of the representative or agent must be clear, specific and unconditional (Paras. 22-23). The document relied upon by the CTM owner does not show consent within the meaning of Article 8(3) CTMR (Para. 28). The CTM owner was not mentioned in the document and it did not refer to the possibility of registration of the sign as a trade mark. The CTM owner cannot rely on the fact that the cancellation applicant did not object to the use of the sign by companies other than those referred to in the document. Use of the marks occurred during the course of marketing the goods produced by the cancellation applicant. However, such use is the logical consequence of the cooperation between the cancellation applicant and the distributors of its goods and does not show any abandonment of the sign, which would enable anyone to make an application for the registration of that sign – or its dominant element – as a CTM (Para. 27). The fact that the CTM owner's relationship with the invalidity applicant is not governed by formal requirements, with the result that the CTM owner is not mentioned in the document is irrelevant (Para. 29).

Case T-171/11; Hans-Jürgen Hopf v OHIM; Judgment of 29 November 2012; Language of the case: DE

Keywords: Descriptive mark, reasoning, category of goods and services, Nice Classification

RESULT: Action partly allowed (BoA decision partly annulled)

FACTS: The applicant sought to register the word mark **Clampflex** as a CTM for goods in Classes 5, 9, 10, 17 and 20. The examiner refused the application for registration for the majority of the goods on the ground that the mark applied for was descriptive (flexible clamp) and devoid of distinctive character. The Board of Appeal confirmed this decision. The applicant filed an action before the General Court.

SUBSTANCE: The Court agreed that the sign is descriptive, except for 'syringes'. The CG agreed that 'flex' could easily be linked to 'flexibility' and that the overall term was no more than the mere combination of its descriptive components (Para. 29). The applicant has not shown in what way the overall sign had a different meaning from that of its mere components (Para. 33). The meaning 'flexible clamp' is understood immediately and does not, contrary to what is argued by the applicant, necessitate several mental steps. There is a sufficiently direct and specific association between the sign and the goods (for example medical instruments in Class 10), with the exception of 'syringes' in Class 10. The Board has not sufficiently reasoned why the mark applied for should not be registered for 'syringes'. Although OHIM can use one reasoning for a group or category of goods or services, this must not lead to an impediment in the legal control of the decision. Even goods in the same class of the Nice Classification are not necessarily homogeneous enough to be eligible for such an all-inclusive reasoning (Para. 45). The Court examined the Board's lack of reasoning regarding 'syringes' ex officio (Para. 46). As regards the goods in Class 17, which are intermediate products used in the production of flexible clamps, the Court confirmed that the descriptive character of a mark in relation to the end product extends to the intermediate product (Para. 48).

Case T-143/11; Consorzio vino Chiantio Classico v OHIM; Judgment of 5 December 2012; Language of the case: EN

Keywords: Similarity of the signs, identity of the goods and services, visual similarity, phonetic dissimilarity, figurative element, complex mark

RESULT: Action partly upheld (BoA decision partly annulled)

FACTS: The applicant sought to register the figurative mark represented below as a CTM for 'alcoholic beverages except beers' in Class 33. An opposition based on the earlier marks (Italy, UK, France, Germany), some of which are shown below, registered for goods in Class 33, was filed on the grounds of Article 8(1)(b) and Article 8(5) CTMR. The Opposition Division upheld the opposition on the basis of the UK registration pursuant to Article 8(1)(b) CTMR. The Board of Appeal annulled that decision and rejected the opposition in its entirety. The opponent appealed to the General Court.

CTM applied for	Some of the earlier marks
	

SUBSTANCE: Article 8(1)(b) CTMR: The Court held that the Board of Appeal could not exclude a likelihood of confusion and allow registration of the mark applied for without taking account of the perception by the consumers in all of the territories in which the earlier marks are to be found (Italy, UK, France and Germany). The contested decision contains a degree of ambiguity with regard to the similarity of the signs. It states, on the one hand, that the mark applied for is 'sufficiently distant' from all of the earlier marks, but without explaining what is to be understood by the adjective 'distant'. On the other hand, the contested decision refers to a similarity of the marks. An assessment of likelihood of confusion would have made no sense in the absence of a similarity between the signs. The Court noted that the identical nature of the rooster, which is represented in a similar way and bears common physical characteristics, constitutes a factor of visual similarity, given that that element fulfils, in view of its size and central position, an important role with regard to how the marks at issue are perceived. The word elements of the marks are visually different. The mark applied for is in the

shape of a shield, whereas the earlier marks have concentric circles. However, the differences are not such as to eclipse the visual similarity. Phonetically, the signs are clearly dissimilar since the word elements are pronounced very differently in all the languages spoken by the relevant public. Conceptually, each of the word elements belongs to different languages and can therefore not be compared conceptually. The respective designs of the marks also introduce conceptual differences between them. The mark applied for resembles an armorial emblem recalling the distinctive symbol associated with nobility or guilds used to identify people or professions, whereas the earlier marks are more akin to a seal indicating the mark of a sovereign authority such as that of the State and are designed to certify, or even seal, a particular object. The Court concluded that there is a low degree of similarity between the signs. There is no likelihood of confusion between the marks.

Article 8(5) CTMR: The marks have a low degree of similarity. Consequently, the Board of Appeal erred in rejecting the ground of opposition based on Article 8(5) CTMR for the reason that the marks were not at all similar, without examining the other conditions governing the applicability of that provision. The contested decision must be annulled in so far as the Board of Appeal rejected the ground of opposition based on Article 8(5) CTMR.

Case T-42/09; A. Locker S.p.A. v OHIM; Judgment of 7 December 2012; Language of the case: IT

Keywords: Dissimilarity of the signs, conceptual dissimilarity, visual dissimilarity, phonetic dissimilarity, identity of the goods and services, well-known facts need no evidence

RESULT: Action dismissed

FACTS: The applicant sought to register the mark **QUADRATUM** as a CTM for goods within Class 30. An opposition based on the earlier CTM **LOACKER QUADRATINI** and also covering Class 30 goods was filed on the grounds of Article 8(1)(b) CTMR. The Opposition Division partly upheld the opposition. The Board of Appeal upheld the CTM applicant's appeal, considering that the signs were overall dissimilar under all respects and that, therefore, one of the basic requirements for a finding of likelihood of confusion had not been met. The opponent filed an action before the General Court. The General Court dismissed the appeal.

SUBSTANCE: The GC agreed with the Board that the signs are overall dissimilar and that, therefore, one of the basic requirements under Article 8(1)(b) is not met. It is not disputed that the goods concerned are identical and that the relevant public consists of the average European consumer of biscuits, snack, etc. The GC shared the Board's conclusion that the signs produce a different overall visual and phonetic impression. The fact that the marks share the sequence of letters 'quadrat' is offset by the difference in the number of words, syllables and characters as well as by the presence of a different, autonomous word at the beginning of the earlier mark (Para. 30). The GC also shared the Board's finding that the signs are not conceptually similar. The word 'QUADRATINI' (meaning 'small squares' in Italian, the word for 'square' being 'quadrato' and 'quadratini' being the corresponding diminutive) of the earlier mark would be seen as alluding to the shape of the goods. The word 'QUADRATUM', making up the contested mark, would not be seen as alluding to a square shape, since this word is neither an Italian word nor a diminutive and would rather be seen as a word of Latin origin (Para 45). It follows that the fact that both signs might be seen as alluding to the notion of 'square' is not sufficient for a finding of conceptual similarity (Para. 46). As regards this last point, it should be noted that the GC also confirmed that the Board was entitled to rely on the well-known fact that, in Italian, it is usual to use diminutives to refer to the shape of foodstuffs to reach the above mentioned conclusion on the likely perception of the term 'QUADRATINI' by the relevant public, at least in Italy (Para. 42). The GC, when referring to the well-known facts, stated that the Board can legitimately refer to well-known facts (as such) or to the particular knowledge of the Boards' members relating to such well-known facts.

Case T-136/11; pelicantravel.com s.r.o. v OHIM; Judgment of 13 December 2012; Language of the case: EN

Keywords: Bad faith, revocation grounds, evidence of use

RESULT: Action dismissed (CTM remains valid)

FACTS: A request for a declaration of invalidity was filed against the contested CTM registration on the basis of an absolute ground, namely that the CTM proprietor was acting in bad faith when filing the application for the contested CTM registration, within the meaning of Article 52(1)(b) CTMR. The request for a declaration of invalidity was directed against the services in Classes 35 and 39. The Cancellation Division and the Board of Appeal dismissed the request.

Pelikan 

Pelikan 

Contested CTM registration
Classes 1, 2, 9, 16, 18, 28, 35, 39, 41 and 42

Other CTM revoked on account of non-use
in Classes 35 and 39

SUBSTANCE: The General Court found that there was no positive evidence that the CTM application was made in bad faith in respect of services in Classes 35 and 39, even if such services exceeded the scope of the applicant's field of business on the date of filing, and even if this application followed the revocation of an almost identical CTM registration on account of non-use in respect of services belonging to the same classes. The General Court found that where the proprietor of a CTM makes repeated applications for the same mark with the effect of avoiding the consequences of revocation for non-use of earlier CTMs, whether in whole or in part, this can be held as an indication that the proprietor is acting in bad faith. The chronology of events may also be a relevant factor (Para. 27). However, the application for an *updated version* of the revoked CTM registration may be justified by legitimate considerations such as the intention to adapt to a new corporate identity by registering a modernised trade mark covering an updated list of services (Paras. 35-36), or the desire to merge the lists of a number of existing CTMs in order to avoid multiple renewals (Paras. 37-38). Neither the CTMR nor the case-law provides a basis for finding that there is bad faith in view of the size of the list of goods and services in the application for registration (Paras. 54-55).

Case T-568/11; Kokomarina, Vana Real State v OHIM; Judgment of 11 January 2013; Language of the case: EN

Keywords: Admissibility, request for proof of use, complex mark, visual similarity, phonetic similarity, identity of the goods and services, dominant element, letter mark

RESULT: Action dismissed

FACTS: The applicant sought to register the figurative mark **interdit de me gronder IDMG**, represented below, as a CTM for goods within Class 25. An opposition based on the earlier mark **DMG**, shown below, registered for, among others, goods in Class 25, was filed on the grounds of Article 8(1)(b) CTMR. The Opposition Division upheld the opposition. The Board of Appeal confirmed the decision and rejected the applicant's appeal, stating that there was likelihood of confusion. The applicant filed an action before the General Court.

CTM applied for	Earlier Benelux Mark
	

SUBSTANCE: The Court took note of the fact that the assessment concerning the relevant public (the general public of the Benelux) and concerning the identity of the goods was not contested. The argument of the applicant that the earlier mark was not seriously used was too late to be raised at this stage (Paras. 14 to 20). On the comparisons of the signs, the Court confirmed its judgment in 'La Victoria de Mexico' (T-205/10) that when a sign is a complex one, comprising verbal and figurative elements, the verbal ones are, generally, more distinctive than the others (Para. 38). In the present case, the dominant element of the complex sign is the letter combination IDMG in bold, in which the letters of the earlier mark, DMG, are contained. Therefore, it is correct to conclude that the signs share some visual similarity. Phonetically,

except for the letter 'l', all the letters of the earlier mark will be pronounced identically to those of the contested mark. Conceptually, neither sign has a meaning. The expression 'interdit de me gronder' will be understood only by the French speaking public in the Benelux. Bearing in mind that the goods are identical and that the signs share a visual and phonetic similarity the Board was correct in concluding that there is a risk of confusion between the signs.

Case T-451/11; Gigabyte Technology Co. Ltd. v OHIM; Judgment of 15 January 2013; Language of the case: EN

Keywords: New evidence, complementary evidence, first time on appeal, clarity of party submission, similarity of the signs, similarity of the goods and services

RESULT: Action dismissed

FACTS: The applicant sought to register the sign **Gigabyte** as a CTM for computer-related services in classes 37 and 42, specifically the ones set out below. An opposition based on the earlier CTM **GIGABITER**, covering 'obliterating electronically stored data to render such data unreadable and irretrievable from electronic equipment and components on which such data has been stored' in Class 42, was filed on the grounds of Article 8(1)(b) CTMR. The Opposition Division upheld the opposition and was confirmed by the Board of Appeal. The CTM applicant filed an action before the General Court.

CTM application: Class 37: 'Installation of computer and network systems; repair services for computers and computer peripherals, computer networks and associated peripheral devices; computer installation and maintenance services; repair and maintenance of motherboards, VGA cards, servers, personal computers and internet hardware equipment';

Class 42: 'OEM (Original Equipment Manufacturer) for motherboard software design; system tests and OEM for motherboards, VGA cards, servers, personal computers and internet hardware equipment; computer services, namely, designing, creating, implementing computer equipment and (global) networks for others; operational and technical support services relating to computers and computer peripherals, computer systems and computer network analysis, consulting and management services, computer information technology management and consulting'.

SUBSTANCE: The GC held that an applicant is entitled to produce new documents before the Court as evidence of the accuracy – or inaccuracy – of a matter of common knowledge relied upon by the applicant itself or the Board (Para. 22). The GC then - noting some confusion in the choice of the legal ground relied upon by the applicant - stated that it is not necessary for a party to expressly indicate the provisions under which it is entitled to bring its action, or, more generally, on which it is basing the pleas which it is raising. It is enough for the subject of that party's application and the main elements of fact and law on which it is based to be set out sufficiently clearly in the appeal (Para. 28). As to the comparison of the services, the GC started by referring to the contested services in Class 37 and held that repairing computers may involve destroying or obliterating data and that professionals and, in general, average consumers wishing to delete data electronically stored on their computers permanently, with a view, for example, to destroying them, recycling them, or putting them to another use, might well employ the data-obliterating and destroying services covered by the earlier trade mark and the installation, maintenance and repair services for computers and computer equipment covered by the mark applied for. The GC added that all of the services in question can be distributed using the same channels. The GC then held it to be a fact that was well known to any person with a basic level of understanding of computer related matters that it is common practice for providers of installation, maintenance and repair services connected with computers and computer equipment also to destroy data electronically stored on computers in order to repair them (Paras. 47-71). Turning to the contested services in Class 42 (listed above), the GC held that they are similar to the obliterating services covered by the earlier trade mark, given that they belong to the same area, namely computing, are addressed to the same public, are made available using the same channels and are provided by the same type of undertaking (Paras. 72-81). In light of the similarity of the signs (undisputed) and the similarity of the services, the GC confirmed the Board's finding as to the existence of a likelihood of confusion (Paras. 90-98).

Joined Cases T-225/06, T-256/06, T-257/06 and T-309/06; Budějovický Budvar, národní podnik v OHIM; Judgment of 22 January 2013; Language of the case: EN

Keywords: Sign of more than mere local significance, use in the course of trade, proof of use, invoice, extent of use, place of use

RESULT: Action dismissed

FACTS: The Board of Appeal had dismissed the four oppositions against the CTM applications BUD. The GC's ruling, which had annulled these BoA decisions, was in turn quashed by the CJ (Case C-96/09 P). The CJ ruled, first, that the significance of the sign concerned, which cannot be merely local, must be evaluated exclusively by reference to its use in that territory rather than by reference to the territorial extent of the protection. Second, it also found that that the relevant territory for the purpose of evaluating the use of that sign is exclusively the territory in which the sign is protected. Third, the use of the sign must be shown to have taken place before the date of the application for registration of the Community trade mark. In turn, the CJ dismissed the appeal on certain points of law and confirmed that: The Board of Appeal ought to have taken into account the claimed earlier rights without calling in question the validity and the actual classification of those rights; the words 'used in the course of trade' in Article 8(4) CTMR are to be understood as referring to use of an earlier right in a commercial activity with a view to economic advantage and not as referring to genuine use, by analogy with the provision made in Article 43(2) and (3) CTMR in relation to earlier trade marks relied on in support of an opposition; there was no evidence that the word 'BUD', displayed on the goods in question, referred to a greater degree to the commercial origin of the product than to its geographical origin; deliveries made without charge could be taken into account in order to ascertain whether the requirement for use of the earlier right in the course of trade was met; the opponent must only establish that he has available to him a right to prohibit use of a subsequent trade mark and he cannot be required to establish that that right has been used, in other words that the opponent has actually been able to prohibit such use; the Board of Appeal could not rely solely on national decisions that had not acquired the authority of *res judicata* as the basis for its conclusion. The case was remitted back to the GC for assessing whether, in the light of the above guidance, the oppositions could succeed.

 <p style="text-align: right;">BUD</p>	<p>BUD</p>
<p style="text-align: center;">CTMAs (Classes 16, 21, 25, 32, 33, 35, 38, 41 and 42)</p>	<p style="text-align: center;">Earlier sign relied under Art. 8(4) CTMR (protected under the Lisbon Agreement in France, and under bilateral treaties with effect in Austria)</p>

SUBSTANCE: Notion of use in the course of trade of a sign of more than mere local significance (Art. 8(4) CTMR): The appeal in Case T-309/06 RENV was dismissed as not a single proof of use of the earlier sign BUD had an earlier date than the date of filing of the CTMA (Para. 55). The three remaining appeals were dismissed given that the earlier rights had not been shown to have been used in the course of trade of a sign of more than mere local significance in France and in Austria. As far as use in France is concerned, the GC confirmed that use reflected by four invoices, for a very limited amount and in only three cities, without any advertisement, did not qualify the notion of use in the course of trade of a sign of more than mere local significance (Para. 56). As far as Austria is concerned, the same conclusion applied since the GC found that use was limited to deliveries amounting to 12-25 hectolitres per year, for a marginal turnover (around 1.200 €), almost exclusively in Vienna (Para. 59-61). The GC dismissed the opponent's argument that the lower amount of use was justified by the inherently limited production of a product covered by an appellation of origin in view of the fact that the opponent's yearly production is higher than 1 M. hectolitres of beers (Para. 65).

Case T-474/09; Fercal – Consultadoria e Serviços, L^{da} v OHIM; Judgment of 24 January 2013; Language of the case: PT

Keywords: Trade name, identity of the goods and services, similarity of the signs, use as a trade mark, coexistence of trade marks, new evidence, first time on appeal

RESULT: Action dismissed

FACTS: The cancellation applicant sought the invalidity of the CTM **JACKSON SHOES**, registered for shoes in Class 25, on the basis of its trade name **JACSON OF SCANDINAVIA AB** in accordance with Article 53(1)(c) in conjunction with Article 8(4) CTMR. The Cancellation Division cancelled the CTM. Its decision was confirmed by the Board of Appeal. The CTM owner appealed to the General Court.

SUBSTANCE: The GC rejected documents attempting to show that the name Jackson and its variations were commonly used as they had been submitted to it for the first time (Paras. 26-28). The CTM owner did not contest that the cancellation applicant was the owner of the trade name, that it made use of the trade name on a national level, that Swedish law gives the owner of a trade name the right to prevent the use of a later trade mark if there is a risk of confusion and that the signs in issue are similar. The GC rejected the CTM owner's argument that there was no risk of confusion as the relevant consumer would distinguish between trade names and trade marks due to their different functions (distinguishing the goods and services of one undertaking from those of another vs distinguishing a business from other businesses). Where the use of a company name, trade name or shop name is limited to identifying a company or designating a business, such use cannot be considered as being 'in relation to goods or services'. However, there is use in relation to goods where the owner of the trade name affixes it to the goods it commercialises or where, even if the trade name is not affixed to the goods, the owner uses the trade name in such a way that a connection will be made between the trade name and the goods and services (Para. 23). Moreover, even if the consumer in the present case would make a distinction according to the different functions of a trade mark and a trade name, this would not exclude the risk of confusion (Para. 24). The GC also rejected the CTM owner's argument of a co-existence of marks containing the name 'Jackson'. Although the possibility cannot be entirely dismissed that, in certain cases, the coexistence of earlier marks on the market could reduce the likelihood of confusion, that possibility can be taken into consideration only if it is duly demonstrated that such coexistence was based upon the absence of any likelihood of confusion on the part of the relevant public between the earlier marks to which the CTM owner refers and the cancellation applicant's trade name, and provided that the earlier marks and the signs in conflict are identical (Para. 31). In the present case, the earlier marks cited by the CTM owner and the signs in conflict are not identical. The CTM owner has not demonstrated that the earlier marks it referred to effectively co-exist on the market, nor has it shown a co-existence without risk of confusion (Para. 32). The Court also rejected the CTM owners argument based on a low level of distinctive character of the elements 'Jackson' and 'JACSON', stating that, even if this were so, in view of the similarity between the signs and the identity of the products, the Board was right to find for a risk of confusion (Para. 35).

T-189/11; Peter Yordanov v OHIM; Judgment of 24 January 2013; Language of the case: DE

Keywords: Identity of the goods and services, complex mark, figurative mark, figurative element, beginning of mark, dominant element, visual similarity, phonetic similarity, conceptual similarity, similarity of the signs

RESULT: Action dismissed

FACTS: The applicant filed a CTM application for the word mark **DISCO DESIGNER** for goods in Class 11. The opponent lodged an opposition against the application on the basis of its earlier figurative CTM **DISCO**, shown below, registered for identical goods in Class 11. The Opposition Division granted the opposition on the basis of Article 8(1)(b) CTMR. The Board of Appeal confirmed the OD's decision, considering that the goods were identical and that the signs were visually, phonetically and conceptually similar. The applicant appealed to the GC, claiming an infringement of Article 8(1)(b) CTMR.

CTM applied for	Earlier CTM
DISCO DESIGNER	

SUBSTANCE: The GC confirmed the view taken by the Board of Appeal that the relevant public consists of the general consumer (Para. 28). The attention of the public of the goods in Class 11 is of an average degree (Para. 32). The goods are identical. The applicant's claim that he is offering specialised products for night clubs under the contested mark is irrelevant. The goods have to be compared as reflected in the register and the earlier mark was not subject to the use requirement in the proceedings at hand (Para. 42). The signs at issue are visually similar (Para. 53). The earlier mark is visually dominated by the word element 'DISCO' which is also the first element of the contested mark. The identical beginning of the conflicting signs is relevant as consumers tend to focus on the beginning when being confronted with a trade mark (Para. 55). The signs are also phonetically similar due to the identical pronunciation of the first element 'DISCO' (Para. 57). Conceptually, the signs are also similar as far as the word 'Disco' is concerned. It will be understood as a music style or as an abbreviation for the word 'discotheque' (Para 58). Bearing in mind the identity of the goods and the similarity of the signs, the Board of Appeal correctly concluded that a likelihood of confusion in the meaning of Article 8(1)(b) CTMR existed (Para. 65).

Case T-54/12; K2 Sports Europe GmbH v OHIM; Judgment of 31 January 2013; Language of the case: EN

Keywords: Figurative element, dominant element, distinctive element, dissimilarity of the signs, visual dissimilarity, phonetic dissimilarity, conceptual similarity

RESULT: Action dismissed

FACTS: The opposition was dismissed under Article 8(1)(b) CTMR, both by the OD and the Board of Appeal, on account of the lack of similarity of the signs. The GC dismissed the appeal and confirmed the finding that the signs are globally dissimilar.

	K2 SPORTS
Contested CTMA (Cl. 18, 25, 28)	Earlier German + IR TM (Cl. 18, 25, 28)

SUBSTANCE: The GC found that the word 'SPORT' in the CTMA is descriptive or largely evocative of the goods in Classes 18, 25 and 28, in all languages of the Union concerned. As a result, the dominant element of the CTMA is the figurative element and the dominant element of the earlier sign is the element 'K2' (Paras. 29-32). The figurative element of the CTMA 'looks more like two dynamic, curved brush strokes than a letter of the alphabet'. 'The result is that the public will not associate it directly with the first letter of the earlier marks' (Para. 36), whether or not the CTM applicant's company name begins with the letter 'K' (Para. 39). Thus, the GC ruled out the application of the principle following which the word elements of a mark are, in principle, more distinctive than the figurative elements (Para. 40). The GC went on to say that 'the signs at issue, considered as a whole, are not visually similar because the term 'sport' at the end of the mark applied for is not decisive and will not attract the attention of consumers' (Para. 41). The signs are dissimilar on the phonetic level (Para. 44). On the conceptual level, the degree of similarity deriving from the descriptive word 'SPORT' is not decisive and remains insufficient to offset the dissimilarities noted on the visual and oral levels (Paras. 48-49). The GC concluded that Article 8(1)(b) CTMR cannot be applied since 'the overall impression created by the marks at issue is different, as they do not display sufficient visual, phonetic or conceptual similarities to be regarded as being similar' (Para. 50).

Case T-66/11; Present-Service Ullrich GmbH & Co. KG v OHIM; Judgment of 31 January 2013; Language of the case: EN

Keywords: Change in practice of the Office, Communication of the President, Nice Classification, identity of the goods, similarity of the signs

RESULT: Action dismissed

FACTS: The applicant sought to register the mark **babilu** as a CTM for services in Class 35. An opposition based on the earlier Community trade mark **BABIDU** and also covering services in Class 35 was filed on the grounds of Article 8(1)(b) CTMR. The Opposition Division upheld the opposition. The Board of Appeal dismissed the appeal. The applicant filed an action before the General Court.

SUBSTANCE: The GC found that, given the nature of the services in question, the relevant public has a higher than average level of attentiveness (Para. 25). As to the comparison of the services, it should be noted that the Board's decision was taken before the ECJ rendered its ruling in the by now famous *IP Translator* case. The earlier mark covered, in addition to some more specific services, the class heading of Class 35. The GC confirmed the Board's finding that the applicant's services described as 'advertising mail', 'dissemination of advertising', 'on line advertising on a computer network', 'advertising mail', 'advertising on the Internet, for others' and 'presentation of companies on the Internet and other media' are included in the broader category of 'advertising' services covered by the earlier trade mark and, accordingly, are identical (Para. 48).

In answer to a written question by the GC, the Office explained that both under the previous practice and under the new one implemented following the mentioned judgment, the Board's conclusion that the applicant's 'provision of auctioneering services on the Internet' is identical to the opponent's services in Class 35 cannot be called into question. The GC took note of this explanation and confirmed the above finding of identity, having regard both to the old practice and the current one. In particular, it held that, under the previous practice of OHIM described in Communication No 4/03 and which was not challenged by the applicant, the earlier trade mark, which contains all the general indications of the class heading of Class 35, entails a claim to all the services falling within that class, including the applicant's 'auctioneering' services'. On the other hand, the GC (taking note of the OHIM's above clarification) confirmed that 'auctioneering services' appear in the alphabetical list of Class 35 of the 8th edition of the Nice Classification in force at the time of filing of the earlier CTM and that, therefore, also under the new, post *IP Translator* practice the respective services are identical since the opponent's 'auctioneering' services clearly include the 'provision of auctioneering services on the Internet' covered by the mark applied for (Para. 49). The GC pointed out that, in its written pleadings, the opponent had confirmed that its intention when submitting its application for registration of the earlier trade mark was indeed to claim protection for all the services listed in the alphabetical list of Class 35.

The GC further confirmed the Board's finding that the signs were visually (Paras. 55-59) and aurally similar to a high degree (Paras. 60-66), whereas neither of them had a meaning, thus not being comparable conceptually (Paras. 67-72).

Finally, the GC confirmed the Board's conclusion that, in view of the fact that the services in question are identical, that there is a high degree of similarity overall between the marks and that the earlier trade mark has a normal degree of inherent distinctiveness, there is a likelihood of confusion, notwithstanding the fact that the relevant public has a higher than average level of attentiveness (Para. 78).

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

OPPOSITION – Article 8(1) CTMR

The Second Board of Appeal has taken a decision of 8 January 2013 in case R1109/2012-2 HIT THE SIX / HIT CASINOS – en- the applicant sought to register the contested mark 'HIT THE SIX' for goods and services in Classes 9, 28 and 41. The earlier mark, 'HIT CASINOS', is registered in Slovenia for identical or similar goods and services in the same Classes. The marks are similar visually and aurally in their beginning element, 'HIT'. Conceptually, they have no concept in common. The contested sign has no element which could be considered more distinctive in relation to the other elements, so it enjoys an average distinctive character. The element 'CASINO' in the earlier mark will be associated with a public building or website for gambling and due to its global use it will also be understood by the Slovenian-speaking public. Therefore, this element is weak. Considering all the above and taking into account the principle of interdependence of the different factors, the Board is of the opinion that it is likely that the average Slovenian consumer belonging to the general public could think that those identical goods and services bearing similar conflicting trade marks come from the same or economically-linked undertakings. As a consequence, there is likelihood of confusion including a likelihood of association.