

IPM

Intellectual
Property Mediation
Conference
29 - 30 MAY 2014 - ALICANTE SPAIN



IP Mediation Conference at OHIM May 29-30

Welcome to another edition of Alicante News. The 2014 conference season is well under way, and OHIM has recently announced that its first-ever IP Mediation Conference will take place in Alicante on May 29-30.

Mediation is a fast-growing discipline within IP, and for some years now, has been developing into an important instrument for settling disputes. The EU Mediation Directive (2008/52/EC), which aims to promote mediation, especially in the context of civil and commercial disputes, has already been transposed into national law in many Member States. ...Page 2

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This Conference focuses on mediation as a practical tool in day-to-day IP work and on how mediation is practised at international, EU and national level, with experts from WIPO, the EPO, OHIM, the UK IP Office and the Portuguese IP office, amongst others. There will also be input from key user associations such as ECTA and INTA, as well as experts from private practice, along with real-world examples of mediation in action.

Other issues covered are set to include the comparisons and synergies between mediation, negotiation and arbitration; how to maximise the mediation experience; psychology and mediation techniques and how to create value through mediation.

The conference features breakout sessions, which will concentrate on issues ranging from new technology to role-playing, allowing participants to fully engage with hands-on mediation practices and to learn about new ways of working.

Registration will open shortly through the OHIM website. In the meantime, if you'd like more details on the conference, please email ohimipmediationconference@oami.europa.eu

Interview



The James Nurton Interview

For this month's interview, James Nurton talks to Karel Čermák Jr about change in the Czech Republic, the impact of EU membership and the problems caused by too many trade marks.

What is your background?

Our firm has been a leading IP practice in the Czech Republic since it was established in 1990. We also have an office in Slovakia.

I finished my law studies in 1996 and in 1998 I obtained a PhD. Since that time with some interruptions I have been practising law, including in Germany. I returned to the firm as it is kind of a family firm for me – my father was one of the founding partners. Since 2010 I have been the managing partner of the firm.

In 1989 in Czechoslovakia following the Velvet Revolution the economy was set free. For the first time it was possible to found private enterprises. Our law office was founded by attorneys from one of the state-controlled agencies that had existed since the 1960s. In the socialist Czechoslovakia there wasn't a monopoly as there were several patent agencies, all controlled by the state, and clients could choose between them.

Did you always want to work in IP?

No, I started by specialising in private international law and resolving international disputes involving parties from various countries and arbitration. I did partially practise in this area but gradually became more involved in IP as that was the main area of practice of the firm. I practised in some other offices focusing on civil and commercial law and even criminal law.

IP finally attracted me and became my main area of focus. I like the intellectual quality of this legal discipline: there is lots of case law, and legislation with a long tradition. I also like the organisational aspect: IP is not only about disputes and two opposing parties but also involves a lot of organisation of filing strategies. That means it is more business-focused and you have to understand clients' commercial needs.

How big is the firm?

We have about 50 people. We have three departments – trade mark, patent and legal. In the trade mark department we have about seven people but many of the lawyers including me also specialise in trade mark disputes. So it is more than seven people who work in trade marks.

What is the split between prosecution and legal work?

It is about half-and-half. Before EU accession, there were no CTMs in the Czech Republic or Slovakia, prosecution was bigger as filings had to be done at the national level or through international trade marks. Today both areas have about the same weight.

What was the impact of joining the EU?

CTM filings are not as numerous as we expected 10 years ago when we joined the EU. Many foreign corporations file CTMs through other agents in other countries. Czech and Slovak clients still have limited interest in CTMs because they are focused on local brands in the local markets, or they may consider eastern European countries and Russia, which are not covered by the CTM. So they prefer to file national marks.

How many trade marks does the firm file?

We've been involved in some 10 CTM filings in 2013 for Czech clients – a fairly negligible number, although we do represent many big Czech companies. In total, we had 389 trade mark prosecution cases last year; that figure does not include opposition or litigation matters.

Most of our work is for international clients – the Czech Republic is a very open economy, with many investors particularly from Germany. They do national filings in the Czech and Slovak Republics to protect local brands or local variations of products using our languages for example. We are also involved in some CTM litigations for clients – we have may be four or five per year.

What unusual trade mark cases have you worked on?

I remember some interesting trade mark cases. For example I was involved in the filing of the first one-colour trade mark in the Czech Republic. It was for the colour magenta and it was already registered in Germany, Switzerland and some other countries.

The Czech office kept telling us to prove acquired distinctiveness and then after one year or so they changed their mind and decided it was inherently indistinctive and it would not be registered despite evidence of prior use. We went to the High Court and won and the Office was compelled to register it.

It was a key decision at the time but has become slightly less important following EU accession as one-colour trade marks are now provided for in the law.

How well does OHIM work?

I think the quality of decisions is very good. For me it's an inspiration to read the decisions, especially those of the Boards of Appeal.

What is more difficult are the practical issues, including the geographical distance from Prague to Alicante – about 3000km. Even with the internet and aeroplanes it's different to a local office. If we make a filing and have a lot of evidence we can send a courier or an assistant to the office in Prague in half an hour. We can attend an oral hearing at short notice.

But at OHIM you have a certain deadline, and the clients always leave it to the last minute, and it can be difficult to physically get material to Alicante. I remember one case where we had to fax hundreds of pages at short notice. It is a practical problem.

It might be a good idea for OHIM to have satellite offices in other parts of Europe where people can deposit documents.

What about the RCD?

I have been involved in some disputes. We don't see so many cases of filing of designs. Generally industrial designs are less numerous than trade marks or patents in Czech and Slovak Republics.

What is the situation in the Czech Republic today?

The IP Office has improved a lot in recent years. It certainly has a link with EU membership and membership of the EPC. The fall in applications created some space at the IP Office and they have become more focused on speed, efficiency

and quality. They have a lot of bright young lawyers who follow the European practice and case law and the quality of decisions has improved a lot.

In trade mark matters examination is very quick. Before EU accession, trade mark prosecution took a long time. Today, if there is no opposition it takes six months or even less.

There are many small local businesses that file trade marks without agents, and many of them are blocking trade marks: they have no real value. We experience this often in opposition matters: we often encounter local trade mark filings by businesses that are not well established and have no clear trade mark strategy. They are very numerous – maybe 10,000 filings a year.

The Registry is overburdened with some applications and registrations that are not really being used.

There is formal and substantive examination so they will check absolute grounds but not relative grounds. Trade mark filings are published for opposition so you may file oppositions on relative grounds.

Are there many cases before the courts?

They are becoming quite frequent. There has been a specialised court in Prague – the City Court – for IP matters for about 10 years and since that was set up the situation has gradually improved. More case law has been produced and the court system is working quite well in all IP matters. What is missing to some extent is case law but we have the European case law which may be applied by Czech courts.

The quality of decisions has improved. Many of the judges working in IP practised as general commercial law judges before. Over the years they obtained some qualification and expertise in IP matters. The Court has also been joined by some former examiners of the IP Office and their expertise is very good.

A simple matter can be done in a few months but some complex matters involving large corporations may take 10 to 12 years if they use all the possibilities of appeal and so on.

What has been the biggest change you have seen?

The EU membership was a turning-point. From the perspective of the state and the economy, it was a positive step. In IP, it is difficult to estimate the impact. Applicants gained access to the CTM. But in this particular area I don't think the impact was particularly important.

Another very important step was the establishment of the local IP court.

What do you think the future holds?

I don't expect fundamental changes. There are so many trade marks that in some cases are not used or not even meant to be used. Some businesses file trade marks without knowing how they will use them to benefit their business. This requires real trade mark owners to be more vigilant and to fight all possible conflicting applications and that may engender some problems later. Of course you can file non-use proceedings but these are not normally conducted ex officio in practice so it is up to trade mark owners to act: sometimes they are successful and sometimes not. After five years of registration, it is normally possible to file a request for invalidation. If some use can be evidenced, it may result in a difficult legal dispute.

In enforcement, there has been progress due to Customs seizures which are simple and efficient, but that also poses problems because the Customs authorities do not make any substantive examination of the seized goods so the process can be abused.

Surrender of a CTM in the event that an action for revocation or cancellation is pending before the Office

Part D of the Guidelines on Cancellation, Section 1 Cancellation Proceedings, page 15-17 describes the new practice.

Some CTM owners surrender their CTM when an action for revocation is pending against it in order to be able to request conversion at national level.

The effect is that they gain a further period of 5 years in which they can use their trade mark.

The effects of a revocation for conversion purposes are thereby circumvented, which is why the Office has changed its practice.

The new practice consists of the following:

The Office will suspend the registration of the surrender of the CTM, inform the invalidity/revocation applicant of its intention to close the proceedings and invite the invalidity/revocation applicant to present its observations. If the applicant does not react the Office will send a second letter, closing the proceedings and drawing the applicant's attention to a possible loss of rights. This is done in order to prevent the applicant's first silence from being interpreted as an agreement to drop the invalidity/revocation action.

The new text reads as follows:

- Surrenders covering all the contested goods and/or services

In principle, the consequences in cancellation proceedings of a total surrender of the contested CTM (or of a partial surrender covering all the goods and/or services against which the application for cancellation is directed) are similar to those of the withdrawal of a CTM application in opposition proceedings.

However, unlike what happens with the withdrawal of a CTM application, the effects of the surrender of a registered CTM are not the same as those of the decision on the substance terminating the proceedings in question. While the surrender of a CTM only becomes effective on the date on which it is registered, a decision cancelling the CTM produces its effects from an earlier date, be it the registration date of the CTM (in the case of invalidity) or the date on which the cancellation request was filed (in the case of revocation). Consequently, as a rule and despite the surrender of the contested CTM, the applicant is deemed to still have a legitimate interest in continuing the cancellation proceedings in order to obtain a decision on the substance (see judgment of 24/03/2011, C-552/09 P, 'TiMi KiNDERJOGHURT', para. 39 and decision of 22/10/2010, R 463/2009-4, 'MAGENTA', paras. 25-27).

In practice, when there is a surrender regarding a CTM which is subject to cancellation proceedings, the Office will suspend the registration of the surrender and, in parallel, the Cancellation Division will notify the cancellation applicant of the surrender, inviting it to present observations within two months and to indicate whether it wishes to continue the proceedings or whether it agrees to the closure of the proceedings without a decision on the substance. This letter will also inform the applicant that, if it does not reply, the cancellation proceedings will be closed without a decision on the substance.

If the applicant replies and expressly agrees with the closure of the proceedings, the surrender will be recorded and the cancellation action will be deemed to have been withdrawn and the proceedings will be closed without a decision on the substance. The costs will be awarded to the applicant (Article 85(3) CTMR).

If the applicant does not submit any observations on the closure of the cancellation proceedings, the Cancellation Division will send both parties a letter closing the proceedings and informing the applicant of its possible loss of rights for the purposes of Rule 54(2) CTMIR. If the applicant does not explicitly apply for a decision on the matter within the time limit established in said rule, the surrender will be recorded in the Register.

If the applicant does request the continuation of the cancellation proceedings (either in reply to the Office's invitation to submit observations or when applying for a decision under Rule 54(2) CTMIR), the cancellation proceedings will continue until there is a final decision on the substance. In these cases, the costs will be awarded to the winning party and not necessarily to the party terminating proceedings, as indicated in Article 85(3) CTMR. After the decision on the cancellation has become final, the surrender will be recorded only in respect of the goods and/or services for which the contested CTM has not been revoked or declared invalid, if any.

- Surrenders covering only part of the contested goods and/or services

The CTM proprietor may partially surrender its CTM for part of the contested goods and/or services. In such cases the Office will notify the cancellation applicant and will invite it to indicate if it wishes to maintain its cancellation application. If the cancellation applicant does request the continuation of proceedings and maintains its application for cancellation, proceedings will continue despite the partial surrender of the CTM in the Register. If the cancellation applicant does not wish to maintain its application for cancellation, the Office will close the proceedings and take a decision on costs indicating that each party will bear its own costs (Article 85 (2) CTMR).

- Withdrawals

The cancellation applicant can withdraw its application for cancellation at any time of the proceedings. The Office will inform the CTM proprietor about the withdrawal, close the proceedings and take a decision on costs, which will be awarded to the CTM proprietor (Article 85(3) CTMR), except in cases where the withdrawal immediately follows a surrender (see above).

The parties may indicate that surrender or a withdrawal is a consequence of an agreement they have reached and that a decision on costs is not necessary. The Office will not issue a decision on costs if such a request is received together with a request for surrender or withdrawal and is signed by both parties. Such a request can also be sent in two separate letters to the Office. In cases where no indication is given as to whether the parties have agreed on the costs, the Office will take a decision on costs immediately. The decision on costs already issued will not be revised by the Office in the event that the parties provide such information after the date of the decision. It is left to the parties to respect the agreement and not to 'execute' the Office's decision on costs.

This practice entered into force on 1 February 2014.

Registered Community Design RCD

Court of Justice: Preliminary ruling

Case C- 479/12; Request for a preliminary ruling under Article 267 TFEU from the Bundesgerichtshof (Germany), in the proceedings between H. Gautzsch Großhandel GmbH & Co. KG v Münchener Boulevard Möbel Joseph Duna GmbH.

Keywords: Unregistered Community design – Protection – Making available to the public – Novelty – Action for infringement – Burden of proof – Extinction of rights over time – Time-barring – Applicable law

FACTS:

The plaintiff in the national proceedings before the German Courts produced and sold a gazebo. The defendant started to sell its own gazebo, imported from China. The plaintiff brought infringement proceedings, claiming that the defendant's gazebo infringed its prior unregistered Community design rights. In support of its claim, the plaintiff claimed that it had sent several hundreds of leaflets to the sector's largest furniture retailers and to two German furniture-purchasing associations in April and May 2005.

The defendant claimed that the challenged design had been independently created in China at the beginning of 2005, that it was presented to European customers in March 2005 at the Chinese manufacturer's showrooms in China and that a model had been sent to a Belgian company in June 2005. Furthermore, the defendant contended that the plaintiff's rights had been extinguished over time and that the right to bring an action was time-barred, maintaining that the plaintiff had been aware of the existence of the defendant's gazebo since September 2005 and that it had known that it was being marketed since August 2006.

The case made its way up to the German Supreme Court, the Bundesgerichtshof (BGH), who turned to the CJEU for help in determining whether the designs would, in these circumstances, have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community.

SUBSTANCE:

The CJEU first addressed the issue of the *scope of the concept of 'disclosure'* in the context of the conflict between two *unregistered designs*. Referring to the need to prove that the earlier design has become known, in the normal course of business, to the members of the circles specialised in the sector concerned, operating within the European Union, the CJEU held that it was possible that an unregistered design might reasonably have become known in those circles if images of the design had been distributed to traders operating in that sector, this being a question of fact to be assessed by the national Court, having regard to the circumstances of the case before it. By this finding the CJEU endorses a broader notion of the relevant 'specialised circles', which are not to be construed as only including persons involved in creating designs and developing or manufacturing products based on those designs.

The CJEU then addressed the issue of *disclosure to one single undertaking* and held that it was possible that an unregistered design might not reasonably have become known to the relevant circles, even though it was disclosed to third parties without any explicit or implicit conditions of confidentiality, if it had been made available to only one undertaking in that sector or had been presented only in the showrooms of an undertaking outside the European Union, this also being a question of fact to be assessed by the national Court. This confirms that it might prove difficult to show that the prior art has been made available to the relevant specialised circles if the disclosure is limited to one single undertaking.

The CJEU then dealt with the issue of *the burden of proof* in demonstrating copying in unregistered Community design infringement proceedings and, while confirming the established principle that the burden of proof rests on the person seeking to assert his right, held that if it was likely to be "impossible or excessively difficult" for the right holder to come up with evidence of copying, the national Court had to use all procedures available to it to counter that difficulty, including any rules that provided for the burden of proof to be "adjusted or lightened". Thus, it would appear that, in certain circumstances, it might be sufficient for the right holder to establish facts from which copying might be reasonably inferred, before the burden shifts to the defendant to rebut those facts.

The CJEU then addressed the issue of the defences of the extinction of rights over time and of an action being time-barred that might be raised against an action brought on the basis of an alleged infringement of an unregistered Community design and held that these defences were governed by national law, which had to be applied in a manner that observed the principles of equivalence and effectiveness.

Finally, the CJEU held *that claims for destruction of infringing products* were governed by the law of the Member State in which the acts of infringement or threatened infringement had been committed. On the other hand, *claims for compensation for damage* resulting from infringement were governed by the national law of the Community design court hearing the proceedings.

EUTMDN Updates

The Republic of Korea joins TMview

On 12 February 2014, the Korean Intellectual Property Office (KIPO) made its trade mark data available in the TMview search tool.

The integration of KIPO is a concrete result of the International Cooperation programme managed by OHIM in collaboration with its international partners.

This last extension brings the total number of offices participating in TMview to 35 and, with the addition of more than 2.7 million Korean trade marks, TMview now provides information and access to more than 23 million trade marks in total.

Since the introduction of TMview on 13 April 2010, the tool has served more than 5 million searches from 205 different countries, with users from Spain, Germany and Italy among the most frequent visitors.

E-services live in Estonia and e-filing for designs in Greece

The Estonian Patent Office has gone live with the e-Services application, developed by the Cooperation Fund.

E-services is a comprehensive suite of solutions enabling users to file trade mark oppositions, trade mark and design renewals, trade mark and design transfers and changes to owner details and trade mark oppositions via the electronic route.

The service is currently on restricted go-live, and is being piloted by a group of invited key users, prior to the full go-live in the coming weeks. However the Estonian Patent Office has already received a number of electronic applications since the service was launched on 12 February.

This latest implementation is a result of close three-way collaboration between Estonian and OHIM technical experts, and colleagues from the Finnish IP Office.

At the same time the Greek industrial property office, OBI, went live with e-filing for designs.

While no first filings have been received yet, the system has been extensively tested and is now open to Greek users.

Third Common Communication released

On 20 February 2014, EU IP National Offices, participating user associations and OHIM published a third Common Communication on their websites in relation to the 'IP Translator' ruling to help provide clear, concise and consistent information on the acceptability of classification terms.

This particular Common Communication provides a set of guidelines that will help to identify when a classification term is sufficiently clear and precise.

This set of guidelines will also be reflected in Part B, section 3, of OHIM's Guidelines on examination of classification of goods & services.

Along with this Common Communication, prior Common Communications were updated and reissued today. This is to ensure that any developments since their initial publication are accurately and succinctly shared with stakeholders. [The Common Communication on Interpretation of 'IP Translator'](#) has been amended to reflect the recent changes in the classification practice introduced by the Finnish national office.

The implementation dates of the Common Practice explained in [the Common Communication on the Common Practice of the General Indications of the Nice Class headings](#) varies for each office; therefore this Communication has been updated to include an overview of implementation dates for each office.

More News



Guidelines webinar at OHIM

A live webinar on OHIM's updated Guidelines, open to all users, took place in OHIM on 18 February. The first set of OHIM's new guidelines entered into force on 1 February.

The revision is part of the process of replacing OHIM's Manual of Trade Mark Practice with a fully revised and updated set of Guidelines.

A recording of the webinar will be available for viewing in the coming weeks on OHIM's website.

OHIM ECTA link committee and Technical Cooperation Liaison Meeting

The annual European Communities Trademark Association (ECTA)-OHIM link committee meeting was held in Alicante in February. ECTA representatives and OHIM meet on a yearly basis to discuss matters of mutual interest.

The chair and vice-chair of the ECTA-OHIM link committee and members of other OHIM committees took part in the meeting.

Meanwhile, the ninth Technical Cooperation Liaison Meeting was held at OHIM on 20-21 February.

Representatives of EU national and regional IP offices were in attendance, with IP office representatives from non-EU countries, the EPO, WIPO and user associations acting as observers.

Delegates discussed a variety of topics of mutual interest, including developments in the Cooperation Fund, the Convergence Programme and OHIM's International Cooperation programme.

Monthly statistical highlights* January 2014 compared to January 2013

| | 2014 | 2013 |
|--|-------|--------|
| Community trade mark applications received | 8 522 | 9 123 |
| Community trade mark applications published | 9 755 | 11 734 |
| Community trade marks registered (certificates issued) | 8 788 | 7 379 |
| | | |
| Registered Community designs received | 5 491 | 6 822 |
| Registered Community designs published | 7 379 | 7 989 |
| | | |

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

Case law



Luxembourg Case Law

A: Court of Justice: Orders, Judgments

Case C-193/13 P; nfon AG v OHIM; Order of 16 January 2014; Language of the case: DE

KEYWORDS: Admissibility, Common element, Descriptive element, Distinctive element, Dominant element, Likelihood of confusion, Relative grounds, Similarity of the signs

RESULT: Action dismissed

FACTS: In the case T283/11, the Court overturned the decision of the Board of Appeal (BoA) and refused the CTMA 'nfon' for goods and services in Classes 9 and 38 on the basis of the earlier CTM 'fon' (figurative) and the UK mark 'fon' registered in the same Classes. The CTM applicant brought an appeal to the Court which was supported by the Office. The CTM applicant claimed an infringement of Article 8(1)(b) CTMR by three errors in the overall assessment of the likelihood of confusion. Namely, the assessment of the distinctive elements of the signs, the incorrect application of the interdependence theory and not taking into consideration the low distinctiveness of the common element "fon" and the enhanced degree of the attentiveness.

SUBSTANCE: In the first part of its claim the CTM applicant agreed with the judgement under appeal that the element 'fon' as a short form of 'telephone' is descriptive for the concerned products. It submitted, however, that as such it is devoid of a distinctive character and the coincidence in this element cannot cause the likelihood of confusion. The Court of Justice (CJ) recalled that the question what are the dominant elements of the marks as well as which is their impact on the overall impression, are questions of facts (Para. 28).

With the second part of the claim the CTM applicant challenged the judgment under appeal as far as it stated that in a case of an identity or high similarity between the products, the distance between the marks has to be significant in order to exclude the likelihood of confusion. The CJ took the position that no such a general rule was pronounced in the judgement under appeal (Para. 41).

The third part of the claim was concerned with the lack of consideration of the level of the distinctiveness of the common element, as well as the level of attention of the public in the overall assessment in the judgment under appeal. The CJ recalled that whereas the assessment of all factors within the global assessment of the likelihood of confusion is a question of fact, the failure of taking one of them into consideration is an error in law (Para. 52). It took, however, the position, that the Court implicitly considered all relevant factors (Paras. 54, 56).

Case C-558/12 P; Riha WeserGold Getränke GmbH & Co. KG v OHIM; Judgment of 23 January 2014; Language of the case: DE

KEYWORDS: Admissibility of defence, Dissimilarity of signs, Enhanced distinctiveness, Entitlement to appeal, Likelihood of confusion, Relative grounds, Substantial procedural violation

RESULT: Appeal upheld (GC judgment set aside)

FACTS: The applicant sought to register the word mark 'WESTERN GOLD' as a CTM for goods in Class 33. The opponent based its opposition on various earlier word marks, among them the earlier CTM 'WeserGold' (word) in respect of goods in Classes 29, 31 and 32. The Opposition Division upheld the opposition and rejected the application. The applicant filed a notice of appeal. The Board of Appeal (BoA) upheld the appeal and annulled the decision, finding that there was no likelihood of confusion. The opponent appealed to the GC. The GC upheld the action and annulled the decision of the BoA. The Court found that the BoA made an error in the application of Article 8(1)(b) CTMR as it did not examine the issue of distinctiveness enhanced through use. The Office filed an appeal to the Court of Justice (CJ). According to the Office, the GC misinterpreted Article 8(1)(b) CTMR, in so far as it held, notwithstanding a prior finding in the GC judgment that the marks in question were dissimilar overall, that the BoA should have examined the enhanced distinctiveness of the earlier marks, acquired through use.

SUBSTANCE: The CJ refers to the settled law, according to which the similarity or identity of the conflicting signs and the similarity or identity of the goods or services covered by the marks are cumulative conditions for finding a likelihood of confusion (Para. 41). Where there is no similarity between the earlier mark and the mark applied for, the enhanced distinctiveness of the earlier mark or the fact that the goods or services concerned are identical or similar are not sufficient to conclude that there is a likelihood of confusion between the marks at issue (Para. 42). The lack of similarity between the marks at issue renders Article 8 CTMR inapplicable (Para. 46).

In the case at hand, the GC had found that the signs at issue were dissimilar overall. In spite of this, the GC annulled the decision of the BoA emphasising that BoA should have examined the distinctiveness of the earlier marks, acquired through use. According to the GC, that error meant that the BoA had failed to examine a potentially relevant factor in the global assessment as to whether there was a likelihood of confusion and that such an error constituted a breach of essential procedural requirements (Para. 47). However, since the GC had already found that the marks at issue were dissimilar overall, any likelihood of confusion had to be ruled out and the possible enhanced distinctiveness of the earlier marks could not offset the lack of similarity between the marks at issue (Para. 48).

Accordingly, the CJ set the judgment under appeal aside, in so far as, by that judgment, the GC held that the BoA was required to examine the enhanced distinctiveness of the earlier marks, acquired through use, and annulled the decision of the BoA on that ground, notwithstanding a prior finding in the judgment under appeal that the marks at issue were dissimilar. Since the Office's first ground of appeal was successful it was not necessary to decide on the remaining grounds of appeal brought forward by the Office (Para. 50).

The claims alleged by the opponent seeking the substitution of grounds of the GC judgment were dismissed as inadmissible. None of the claims is a defence to the grounds of appeal put forward by the Office. The allegations are not capable of establishing a legal interest in submitting the claims (Paras. 55-59).

Case C-324/13 P; Fercal Consultoria e Servicos, Ld, v OHIM; Order of 30 January 2014; Language of the case: PT

KEYWORDS: Time limit, Admissibility, Ratio Legis, Statement of grounds

RESULT: Appeal dismissed as manifestly unfounded

FACTS: The applicant sought to set aside the judgment of the General Court (GC) of 10 April 2013 in case T-360/11 Fercal Consultoria e Servicos, Ld, v OHIM (Patrizia Rocha) by which the GC dismissed its action seeking the annulment of the decision of the Second Board of Appeal (BoA) of 8 April 2011 declaring the appeal inadmissible as the statement of grounds was filed outside the applicable time limit.

SUBSTANCE: On the admissibility of the appeal, in relation to Article 58 of the Rules of Procedure of the Court, the Court held that the appeal was, contrary to what the Office argued, admissible although the Appellant did not mention or quote any relevant extract of the judgment. In general it can be clearly extracted from the argumentations which are the elements under criticism allowing then the Court to exercise its control of legality.

On the substance and thereby interpretation of former Article 59 (now Article 60) CTMR, the Court of Justice (CJ) drew the following conclusions: On the first plea in law namely on the concept of filing, referring to the interpretation of Regulation 2868/95, the CJ confirmed the assessment of the GC at point 27 of the judgment when it held that, following the spirit of the law and from the provisions themselves, it is the date of reception of the statement of grounds by the Office which is relevant and not the date on which the statement was sent. This 'reception theory approach' is confirmed by section 2B of the decision of the Presidium, applicable in virtue of Article 1 paragraph 6 of Regulation n° 216/96 as modified by Regulation 2082/2004. This text uses the expression to 'communicate the appeal' and 'to present the statement of grounds'. Moreover Rule 62, paragraph 3 of Regulation 2868/95 provides that when the motivation is made by certified letter with or without receipt, the notification is deemed to be delivered to the addressee on the 10th day following that of its posting, so again the criteria is the reception date not the sending date.

On the second plea in law related to the determination of the day when the delay started to count, the CJ confirmed the interpretation of the GC of Rule 70 paragraph 4 CTMIR, as implying that the time limit started to count the day after the notification and expired on 27 January 2011. It is therefore not correct to argue, as the applicant did, that the time limit expired on 28 January 2011. The delay must be counted in months not in days.

Finally on the means of communication of Rules 61 to 65 CTMIR which was the third plea in law, the Appellant was wrong in its interpretation, even if the parties are free to choose the means of communication, the delays are not modified in accordance with these choices.

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

Case T-467/11; Colgate-Palmolive Company (Applicant) v OHIM; Judgement of 10 December 2013; Language of the case: EN

KEYWORDS: Admissibility, Conceptual similarity, Descriptive element, Distinctive element, Functional element, International registration, Likelihood of confusion, Phonetic similarity, Principle of legality, Restriction of the list of goods and services, Similarity of the signs, Visual similarity

RESULT: Action dismissed

FACTS: The CTM applicant sought to register the word mark **360° SONIC ENERGY** for toothbrushes in Class 21. The opponent challenged the application on grounds of likelihood of confusion with the previously registered international word mark **SONIC POWER** for goods in Classes 3 and 21, including toothbrushes. The Opposition Division (OD) upheld the opposition, finding likelihood of confusion. The Board of Appeal (BoA) dismissed the appeal, finding further that the word sonic is distinctive for the goods as applied for, since *toothbrushes* is too broad a category, not restricted to the electrical toothbrushes for which the word might be viewed as an descriptive term. The decision of the BoA was appealed. During the hearing the Applicant made a declaration with the purpose of restricting the goods applied for to only *electric toothbrushes*.

SUBSTANCE: Regarding the admissibility of the restriction, in certain circumstances such restriction could be viewed as a statement that the contested decision is challenged only as to the remaining goods, without changing the subject-matter and could be admissible (Para. 17). In the particular case however, it would have an impact on the assessment of the distinctive character of the element 'sonic' and ultimately affect the assessment of the likelihood of confusion (Para. 19). Consequently the declaration was disregarded.

The General Court (GC) confirmed the BoA's finding that the term 'sonic', when it is associated with the words 'energy' or 'power', could be considered as descriptive but only for *electronic toothbrushes* (Para. 45). The Court found further that the term 'sonic' is not descriptive of 'ordinary bristle' toothbrushes, That is to say, those which are not fitted with an electrical device generating ultrasounds (Para. 50). Without prejudice to the above findings, the Court acknowledged a certain degree of distinctiveness of the earlier sign based on the *Formula one* Case-Law according to which the Office and EU Courts may not reach a finding that a registered national or international trade mark lacks distinctive character since such a finding would not be compatible with the coexistence of CTMs and national trademarks and, would be detrimental to their protection as it would facilitate the registration of an identical or similar CTM (Para. 53).

As for the distinctiveness of the element '360°', the GC followed the reasoning of the BoA that this term, which is a mathematical concept, will be perceived as a technical specification evoking the idea of a complete and qualitative dental cleaning (Para. 58). Therefore, this element is not decisive for counteracting the existing similarity between the signs (Para. 60).

The Court confirmed the finding of a certain visual and phonetic similarity (Paras. 61- 62). As regards the conceptual comparison, the GC rejected the Applicant's claims as to the different scientific meanings of the terms 'energy' and 'power', confirming the possibility of a conceptual association between the signs (Para. 65). The certain visual and aural similarity, the high degree of conceptual similarity and the identity of the goods, leads to the conclusion of likelihood of confusion. The existence of other trademarks that include the term 'sonic' and are registered for goods in Class 21, to which the Applicant referred, were disregarded by the Court. Firstly, the cited marks were not identical to the conflicting signs (Para. 73). Secondly, the Applicant failed to prove that such existence was based on the absence of likelihood of confusion (Para. 74). As for the previous decisions of the Office, set forth by the Applicant, the Court confirmed the established principle, that the Office is not bound by its decisions, especially when the factual circumstances of the case are different (Paras. 76 and 77).

Case T-591/11; Przedsiębiorstwo Handlowe Medox Lepiarz Jarosław Lepiarz Alicja sp.j. v OHIM; Judgment of 11 December 2013; Language of the case: PL

KEYWORDS: Admissibility of defence, Conceptual similarity, Descriptive element, Dominant element, Figurative trade mark, Likelihood of confusion, Phonetic similarity, Relative grounds, Visual similarity

RESULT: Action dismissed

FACTS: The applicant sought to register the figurative mark represented below as a CTM for goods in Classes 1 and 16. The opposition was based on the trade marks 'SUPERGLUE' registered in Benelux for adhesive preparations. Upon the opposition the CTM application was rejected for 'adhesives' in Classes 1 and 16 pursuant to Article 8(1)(b) CTMR. The Board of Appeal (BoA) considered the earlier mark descriptive for the protected goods but confirmed the likelihood of confusion for these goods despite the limited distinctiveness of the earlier mark. The CTM applicant filed an action to the General Court (GC) claiming an infringement of Article 8(1)(b) CTMR.

| CTMA | Earlier Mark |
|---|---|
|  | <p style="text-align: center;">SUPERGLUE</p> |

SUBSTANCE: The Court confirmed the finding regarding likelihood of confusion. Regarding admissibility, the application is admissible even if the Office was not indicated as defendant. Pursuant to Article 44(1) GCRP the application has to contain the name of the defendant, but according to the Case-Law it is sufficient if this can be deducted from the content, e.g. if the challenged decision and the body that rendered it are indicated. The applicant made clear that it challenges a decision of the BoA of the Office (Paras. 18-21).

On the merits, the BoA did not breach the law when stating that the earlier mark is descriptive for the relevant goods on one hand and deciding that there was likelihood of confusion on the other hand. The Office and the Court have to assess the distinctiveness of the earlier mark. According to the judgment of 24 May 2012, Case C-196/11P, Formula One Licensing BV / OHIM, the coexistence between the CTM-system and national trade mark systems prohibits, the conclusion that an earlier national mark is not distinctive (Paras. 42-44). Despite its statement that the earlier mark was descriptive the BoA was allowed to decide that it had some distinctive character sufficient to fulfill the function of a trade mark (Para. 47).

The signs are visually and phonetically similar, because the dominant element of the CTM application coincide with the earlier mark (Paras. 52-53, 57). The BoA was right in concluding that the marks are conceptually identical for the part of the public which understands the meaning of 'super glue' (Paras. 59).

Case T-475/12 LaserSoft Imaging AG v OHIM; Judgment of 13 January 2014 Language of the case: DE

KEYWORDS: Absolute grounds, Descriptive element, Nature of the goods and services, Principle of legality, Purpose of the goods and services

RESULT: Action dismissed

FACTS: The CTM applicant brought an action for annulment of the decision of the Board of Appeal dismissing the appeal against the Examiner's decision partially refusing registration of the word mark 'WorkflowPilot' for goods and services in Classes 9, 41 and 42.

SUBSTANCE: The Court rejected the claim of infringement of Article 7(1)(c) and 7(1)(b) CTMR. It confirmed previous Case-Law regarding marks combined of two descriptive terms (Para. 17). The combination of the word workflow (with the meaning of a process) and pilot (designating a person who controls something) is descriptive of the nature or the purpose of the refused goods and services (Paras. 25 and 26). In connection with those goods and services the relevant public

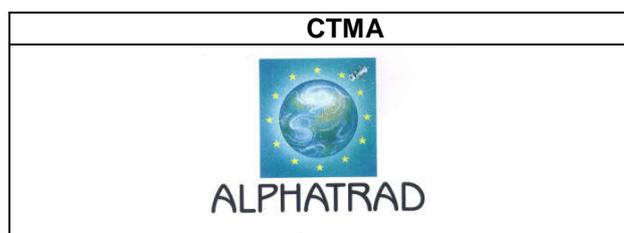
will understand that not a person but a computer program is meant (Para. 25). The combination of both words follows the rules of English syntax. Due to the use of the capital letter 'P', the words will be perceived separately even if they are written together without a space (Para. 29). The argument that similar marks were registered must be dismissed. The principle of equal treatment must be interpreted in the light of the principle of legality (Para. 31).

Case T-538/12; Optilingua Holding SA v OHIM; Judgment of 16 January 2014; Language of the case: FR

KEYWORDS: Admissibility of defence, Extent of use, Figurative trade mark, First time on appeal, Insignificant amount, Invoice, New evidence, Promotional material, Proof of use, Revocation grounds

RESULT: Action dismissed

FACTS: A request for a declaration of revocation for non-use was filed against the figurative CTM 'ALPHATRAD' registered for services in Classes 35, 38, 41 and 42. The Cancellation Division (CD) revoked the CTM in its entirety. The Board of Appeal (BoA) dismissed the CTM proprietor's appeal. The only proof of use consisted of 9 reminders to clients in respect of pending payments the amount of which is unknown (except one which refers to a pending payment of 338 €). The BoA considered that proof of the extent of use was missing. The CTM proprietor filed an action before the General Court (GC). The CTM proprietor only challenged the BoA's finding as regards 'commercial translation' services in Class 42, on the basis of additional material which was submitted for the first time before the GC.



SUBSTANCE: The GC dismissed the appeal. Since the BoA was not required to examine *ex officio* the genuine use of the contested mark, the new evidence of use provided for the first time before the GC is declared inadmissible (Para. 20). The CTM proprietor's argument that the BoA should have presumed the existence of other letters is unfounded (Para. 33). The 9 reminders to clients in respect of pending payments only show a sporadic and symbolic use which cannot be held as genuine (Para. 39). It does not appear that the letters are numbered upwards in chronological order, so that non conclusion on the extent of use can be drawn (Para. 42). The registration does not cover debt collection services but 'commercial translation' services, the use of which could have been easily proven by submitting invoices and brochures (Para. 43).

Case T-528/11; Aloe Vera of America, Inc. v OHIM; Judgment of 16 January 2014; Language of the case: EN

KEYWORDS: Conceptual similarity, Evidence of use, Identity of the goods and services, Invoice, Likelihood of confusion, Phonetic similarity, Ratio legis, Relevant territory, Similarity of the goods and services, Visual similarity

RESULT: Action dismissed

FACTS: The applicant sought to register the figurative sign **FOREVER**, shown below, as a CTM, *inter alia* for goods in Class 32 (juices, bottled fresh water). The opponent based an opposition on Article 8(1)(a) and 8(1)(b) CTMR and the earlier figurative CTM **4EVER**, shown below, registered for goods in Class 32 (juices). The Opposition Division upheld the opposition and rejected the application for registration of the CTM. The Board of Appeal (BoA) dismissed the appeal, finding that the earlier trade mark had been put to genuine use in the course of relevant period five years and that the goods were in part identical and in part similar. Phonetic identity, conceptual identity and low level of visual similarity between the signs were also found. In the light of those facts, the BoA stated that there was a likelihood of confusion. The opponent appealed to the General Court (CG), arguing infringement of Article 42(2) and (3) as well as of Article 8(1)(b) CTMR.

| CTMA | Earlier CTM |
|---|--|
|  |  |

SUBSTANCE: The GC rejected the applicant's argument based on Article 42(2) and (3). The fact that on the related invoices submitted by the opponent, the element '4ever' is written in ordinary characters and therefore is not an exact reproduction of the earlier mark, does not affect the function of identification (Para. 35). Although the related invoices were issued only to a limited number of customers, the period and frequency of use is not low enough for the conclusion that the use had only been symbolic, minimal or notional for the sole purpose of preserving the rights conferred by the mark. The evidence submitted by the opponent was sufficient for a finding of genuine use (Paras. 39-41). Concerning the Article 8(1)(b) CTMR the GC further stated that the attentiveness of relevant public was average and the concerned goods were in part identical and in part similar (Paras. 51-52). A low degree of visual similarity between the marks was also concluded as the visual differences were not significant enough to cancel out their slight visual similarity. Moreover, the applicant acknowledged that there are visually similar elements between those marks (Paras. 58-62). It is also clear that the part of relevant public, which has some knowledge of the English language, pronounces both marks identically. These marks will be phonetically similar for the part of relevant public with no knowledge of the English language as they comprise the same ending 'ever' (Paras. 70-71). Likewise, the marks were found conceptually similar for the part of relevant public, which has some knowledge of the English language, however conceptually neutral for the part of relevant public with no knowledge of the English language (Paras. 76-77). In the light of those facts, the GC considered that there was a likelihood of confusion (Para. 84). There is no infringement of Article (8)(1)(b) CTMR.

Case T-383/12; Ferienhäuser zum See GmbH v OHIM; Judgment of 16 January 2014; Language of the case: EN

KEYWORDS: Admissibility, Common element, Competence of the Boards, Competence of the GC/CJ, Conceptual similarity, Descriptive element, Dominant element, Figurative element, First time on appeal, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Relative grounds, Similarity of the signs, Visual similarity, Weak trade mark

RESULT: Action dismissed

FACTS: The applicant sought to register the figurative mark 'Sun park Holidays' as a CTM for services in Classes 39 and 43. The opponent lodged an opposition against the application on the basis of its registered CTM, 'Sunpark – Holiday Parks', for services in Classes 39, 41 and 43. The Opposition Division (OD) upheld the opposition in respect of all the services covered by the CTMA on the basis of Article 8(1)(b) CTMR. The appeal filed by the applicant was dismissed.

| CTM applied for | Earlier CTM |
|---|--|
|  |  |

SUBSTANCE: The General Court (GC) first rejected the Office's plea of inadmissibility in relation to the applicant's claim for annulment of the OD. The GC pointed out that such an annulment falls within the measures which may be taken by the GC in the exercise of its power to alter decisions (Para. 19).

The GC confirmed the reasoning of the Board of Appeal as to the existence of a likelihood of confusion between the marks in a part of the EU, namely in Germany. The services in Classes 39 and 43 are directed to the general public (Para. 33). The degree of attention is normal. The evidence submitted by the applicant for the first time before the GC, to show an enhanced degree of attention, was rejected by the GC as belated (Para. 36). The services covered by the marks are identical (Para. 39). As regards the similarity between the signs, the word element 'sunparks' is the dominant element

of the earlier mark taking into account the smaller size and lower position of the words 'Holiday Parks' and the negligible nature of the figurative element (Para. 58). The dominant elements of the mark applied for are the words 'Sun Park Holidays' in the centre of the sign (Para. 59). The signs are visually highly similar due to the similarity of the dominant elements 'Sunparks' and 'Sun Park Holidays' (Para. 62). Phonetically, the signs are similar to an average degree (Para. 63). Conceptually, the signs will be understood without difficulty by the relevant German-speaking public as referring to the ideas of sunny holidays and of leisure or holiday parks. The signs are therefore highly similar from a conceptual point of view (Para. 70).

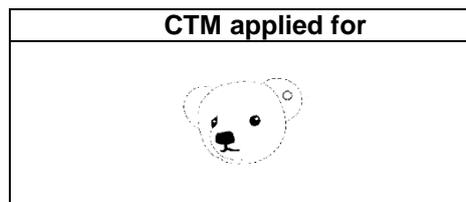
In view of, first, the high degree of conceptual and visual similarity and the average degree of phonetic similarity between the signs at issue and, secondly, the identity of the services at issue, the GC confirmed that there was a likelihood of confusion between the marks within the meaning of Article 8(1)(b) CTMR. The finding of a weak distinctive character for the earlier trade mark does not prevent that finding. 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. 76).

Case T-433/12; Margarete Steiff GmbH v OHIM; Judgment of 16 January 2014; Language of the case: DE

KEYWORDS: Absolute grounds, Admissibility, Complementary evidence, First time on appeal, Ornamentation, Position mark

RESULT: Action dismissed

FACTS: The applicant sought to register the figurative mark depicted below as a CTM. Protection was claimed for a metal button in the middle section of the ear of a soft toy for goods in Class 28. The sign was refused for lacking any distinctiveness under Article 7(1)(b) CTMR. The appeal filed by the applicant was rejected.



SUBSTANCE: The General Court (GC) accepted the documents submitted by the Office for the first time before the Court. It argued that the evidence only illustrates some obvious facts already contained in the contested decision (Para. 13). For reasons of equality the evidence submitted by the applicant for the first time before the Court was also accepted (Para. 14).

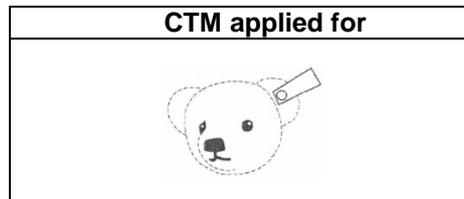
The GC confirmed the reasoning of the Board of Appeal as to the lack of inherent distinctiveness under Article 7(1)(b) CTMR. The GC referred to the established Case-Law, according to which the relevant public's perception is not necessarily the same in the case of a mark which consists of the appearance of the product itself. In those circumstances, only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) CTMR (Para. 20). That Case-Law, which was developed in relation to three-dimensional trademarks consisting of the appearance of the product itself, also applies where, as in the present case, the trade mark applied for is a position mark which merges with the appearance of the product it covers (Para. 21). In the case at hand, the firm connection of the metal button with the ear of the soft toy leads to the conclusion that the mark is merged with the appearance of the products (Para. 25). Moreover, the sign does not depart significantly from the norm or customs of the sector. First, buttons are common decorative elements of soft toys (Para. 29). Second, the button is a simple geometrical form which does not depart in any way from the norm or customs of the sector (Para. 31). Third, the soft toy sector is characterised by a wide variety of different designs (Para. 32). The evidence submitted by the parties shows that it is not uncommon to attach badges, rings, ribbons, loops and embroideries to the ears of a soft toy. The relevant public will therefore perceive the sign applied for as an ornamental element but not as an indication of commercial origin (Para. 47).

Case T-434/12; Margarete Steiff GmbH v OHIM; Judgment of 16 January 2014; Language of the case: DE

KEYWORDS: Absolute grounds, Admissibility, Complementary evidence, First time on appeal, Functional element, Ornamentation, Position mark

RESULT: Action dismissed

FACTS: The applicant sought to register the mark depicted below as a Community trade mark. Protection was claimed for a tag fastened by a metal button to the middle of the ear of a soft toy for goods in Class 28. The sign was refused for lacking any distinctiveness under Article 7(1)(b) CTMR. The appeal filed by the applicant was rejected.



SUBSTANCE: The General Court (GC) accepted the documents submitted by the Office for the first time before the Court. It argued that the evidence only illustrates some obvious facts already contained in the contested decision (Para. 13). For reasons of equality the evidence submitted by the applicant for the first time before the Court was also accepted (Para. 14).

The GC confirmed the reasoning of the Board of Appeal as to the lack of inherent distinctiveness under Article 7(1)(b) CTMR: The GC referred to the established Case-Law, according to which the relevant public's perception is not necessarily the same in the case of a mark which consists of the appearance of the product itself. In those circumstances, only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) CTMR (Para. 20). That Case-Law, which was developed in relation to three-dimensional trademarks consisting of the appearance of the product itself, also applies where, as in the present case, the trade mark applied for is a position mark which merges with the appearance of the product it covers (Para. 21). In the case at hand, the firm connection of the tag with the ear of the soft toy leads to the conclusion that the mark is merged with the appearance of the product (Para. 25). Moreover, the sign does not depart significantly from the norm or customs of the sector. First, tags and buttons are common decorative elements of soft toys (Para. 29). Second, the rectangular tag and the round button device are simple geometrical forms which do not depart in any way from the norm or customs of the sector (Para. 31). Third, the soft toy sector is characterised by a wide variety of different designs (Para. 33). Fourth, the sign applied for may serve a functional purpose insofar as the tag may include washing instructions or the name of the producer or it could be an anti-theft device (Para. 36). This functional character is confirmed by the evidence submitted by the parties (Para. 42). Finally, the documents submitted by the parties also show that it is not uncommon to attach badges, rings, ribbons, loops and embroideries to the ears of a soft toy. The relevant public will therefore perceive the sign applied for as an ornamental or functional element but not as an indication of commercial origin (Para. 55).

Case T-304/12; Message Management GmbH v OHIM; Judgment of 16 January 2014; Language of the case: DE

KEYWORDS: Admissibility, Common element, Conceptual similarity, Descriptive element, Dominant element, Emblem, Figurative element, First time on appeal, Likelihood of confusion, Minimum degree of distinctiveness, New evidence, Phonetic similarity, Relative grounds, Relevant territory, Similarity of the signs, Visual similarity, Weak trade mark

RESULT: Action dismissed

FACTS: The applicant sought to register the figurative mark '**ABSACKER of Germany**' as a CTM for goods in Classes 25, 32 and 33. The opponent lodged an opposition against the application on the basis of, *inter alia*, its registered German mark '**ABSACKER**' (fig.) for goods and services in Classes 25, 33 and 43. The Opposition Division rejected the opposition. The appeal filed by the opponent was upheld and the CTMA was rejected in its entirety. The Board of Appeal (BoA) found that a likelihood of confusion in the meaning of Article 8(1)(b) CTMR existed between the marks. The applicant filed an appeal before the General Court (GC).

| CTM applied for | Earlier German mark |
|---|--|
|  |  |

SUBSTANCE: The evidence submitted by the applicant for the first time before the GC was rejected by the GC as belated (Para. 17). The GC confirmed the reasoning of the BoA as to the existence of a likelihood of confusion between the marks in Germany, the territory in which the earlier mark was protected. The goods and services in Classes 25, 32, 33 and 43 are directed to the general public (Para. 28). The degree of attention is normal. The goods in Classes 25 and 33 are identical. The contested goods in Class 32 of the mark applied for are similar to the gastronomical services in Class 43 of the earlier mark (Para. 29). As regards the similarity between the signs, word elements are, in principle, more distinctive than figurative elements since the public tends to refer to the mark by its word elements (Para. 31). The signs are visually very similar, bearing in mind that the font of the dominant words 'ABSACKER' of the conflicting signs is almost identical (Para. 35 and 42). The signs are also phonetically similar due to the identical pronunciation of the common element 'ABSACKER'. In contrast, the additional words 'of Germany' of the contested mark are hardly legible and will therefore not be pronounced by the public (Para. 43). Conceptually, the German word 'Absacker' refers to the last glass of an alcoholic beverage after a meeting in a pub or before going to bed. The signs are therefore conceptually similar (Para. 45). The conceptual similarity between the signs is enhanced due to the fact that the figurative elements of both signs resemble an emblem or seal (Para. 46).

In view of, first, the high degree of visual similarity and the average degree of phonetic and conceptual similarity between the signs at issue and, secondly, the identity or similarity of the goods and services at issue, the GC confirmed that there was a likelihood of confusion between the marks within the meaning of Article 8(1)(b) CTMR. The finding of a weak distinctive character of the element 'ABSACKER' does not prevent that finding. First, one has to concede a minimum degree of inherent distinctiveness to a national mark which is valid and registered in a member state (Para. 52). Second, 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. 55).

Case T-113/12; Bial-Portela & C^a, SA v OHIM; Judgement of 21 January 2014; Language of the case: EN

KEYWORDS: Dissimilarity of signs, Dissimilarity of the goods and services, First time on appeal, Insignificant amount, International registration, Likelihood of confusion, Multiple applications, Proof of use, Relative grounds, Relevant territory, Reputation, Scope of proceedings, Sign of mere local significance, Sign used in the course of trade, Substantiation of earlier right, Well known trade mark

RESULT: Action dismissed

FACTS: The CTM applicant filed an application for a figurative CTM 'PROBIAL' (represented below) for *inter alia* goods in Class 5. The applicant filed an opposition based on a number of earlier rights, *inter alia*, the registered and well-known Portuguese word mark 'BIAL', the figurative black and white CTM and Spanish mark 'BIAL' (image represented below), the international word mark 'BIAL', registered for Benelux, Germany, France, Italy and Austria, emblem and logo (image represented below) and the business name 'BIAL' used in the course of trade in Portugal. Proof of use was requested for the earlier Portuguese, Spanish and International registrations. The Opposition Division (OD) upheld the opposition on grounds of likelihood of confusion with the earlier CTM. On appeal, the Boards of Appeal (BoA) rejected the opposition, finding that the signs are not similar and no likelihood of confusion could be established. The case was remitted back to the OD for ruling on the rest of the previous rights. The OD found the sign applied for overall dissimilar to the rest of the previous rights and rejected the opposition. On second appeal before the BoA the applicant claimed reputation and well-known character of the mark BIAL for the territory of Portugal, invoking Article 8(5) as well. In its decision, the BoA firstly

disregarded the earlier CTM since the decision rejecting the opposition had become final. Secondly, the claim regarding Article 8(5) was rejected, as it was brought for the first time before the BoA. The BoA further found that the evidence submitted were insufficient to prove genuine use, since they do not solidly indicate that the company sells pharmaceuticals under the trade mark BIAL. As regards the logo, business name and emblem, the applicant had failed to provide evidence that the signs were used in the course of trade of more than mere local significance. For the rest of the cited earlier rights, no likelihood of confusion was found.

| CTM applied for | Earlier rights |
|---|---|
|  | <p>BIAL (Portuguese word mark, well-known mark for the territory of Portugal, International trademark, Business name, used in the course of trade in Portugal)</p> <p> (CTM, Spanish trade mark, emblem and logo used in the course of trade in Portugal)</p> |

SUBSTANCE: The General Court (GC) confirmed the BoA's finding that the CTM must be excluded as basis of the opposition (Para. 34). The Portuguese and International registrations, for which proof of use had been requested, were also rejected, on the grounds of lack of sufficient evidence and the failure of the applicant to contest BoA's findings (Paras. 36-38). As for the claimed well-known mark in Portugal, the GC confirmed the findings of the BoA that the applicant had failed to substantiate that claim by submitting proof that the mark was well known in Portugal. Evidence of the acquisition, duration and scope of protection is to be submitted within two-month period for the date of initiation of the opposition proceedings (Para. 40). With regard to the earlier Spanish trade mark, since the applicant did not contest the conclusion of the BoA as to lack of similarity between the services of that mark and the goods of the sign applied for, the GC confirms those findings (Para. 42). The failure of the applicant to furnish proof of the acquisition, duration and scope of protection of the earlier signs claimed to be used in the course of trade in Portugal and having more than a mere local significance, resulted in the rejection of the claim invoking Article 8(4) as well (Para. 48).

Case T-221/12; The Sunrider Corporation v OHIM; Judgment of 23 January 2014; Language of the case: EN

KEYWORDS: Complementary goods and services, Dissimilarity of the goods and services, Labels, Likelihood of confusion, Nature of the goods and services, Purpose of the goods and services, Relative grounds

RESULT: Action dismissed

FACTS: The trade mark for which registration was sought is the word sign '**SUN FRESH**' in respect of 'beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages' in Class 32. An opposition was lodged under Article 8(1)(b) CTMR on the basis of several '**SUNNY FRESH**' fig. trade marks, in particular an earlier CTM covering 'herbal nutritional supplements' in Class 5 and earlier UK, Irish and Benelux trademarks covering 'herbal beverages; herbal teas; preparations, powders and essences for making beverages; non-alcoholic beverages; syrups for beverages' in Class 32. The applicant requested proof of genuine use and the opponent filed evidence in reply.

The Opposition Division (OD) upheld the opposition for all the contested goods and rejected the application for registration in its entirety. On appeal, the Fourth Board of Appeal (BoA) annulled the decision of the OD and rejected the opposition. The BoA found that the earlier mark '**SUNNY FRESH**' had been used in several Member States but only for a dietary supplement based on a herbal concentrate falling within Class 5, so that only the earlier CTM could be taken into account for the purpose of the opposition. On the substance, the BoA considered that 'nutritional dietary supplements' in Class 5 and the contested beverages in Class 32 are dissimilar and therefore excluded a likelihood of confusion.

SUBSTANCE: The GC confirmed the decision of the BoA. It found that the category of goods 'herbal nutritional supplements' in Class 5 had to be distinguished from the categories of goods 'herbal beverages; herbal teas; preparations and essences for making beverages; syrups for beverages' in Class 32, taking into account the main purpose of these goods, their liquid and edible nature not being the distinguishing criterion (Paras. 30-31).

The GC - in reply to the opponent's argument that its '**SUNNY FRESH**' nutritional supplement was not a product for medical use and that the BoA should have examined whether it could also be classified as a beverage in Class 32 - underlined that the title of Class 5 and the list of goods which it includes (such as 'food for babies' and 'herbal teas for medicinal purposes' in the English version) make it apparent that the medical or veterinary use which it refers to must be understood broadly, meaning that what is decisive is the fact that the opponent's nutritional supplement is primarily

meant to prevent or remedy medical problems in the broad sense of the term or to balance nutritional deficiencies (Para. 35).

In view of the fact that the opponent's products are presented and marketed with warnings about the recommended dosage and potential hazards of the product for young children, the GC confirmed the BoA's finding that the main purpose of the goods was not to quench thirst or to ensure standard human nutrition, as had been argued by the opponent (Para. 47).

Furthermore, given the nature of the goods at issue, the relevant public is reasonably well informed and reasonably observant and circumspect as regards the contested beverages in Class 32, whereas regarding nutritional supplements for medical use in the broad sense of the term included in Class 5, the relevant public displays a relatively high level of attention, insofar as those goods affect their health (Para. 64).

Thus, 'herbal nutritional supplements' in Class 5 cannot be regarded as similar to 'beverages' or to 'preparations for making beverages' in Class 32, even though some of these nutritional supplements are sold as liquids or liquid concentrates that can be mixed with water. The Court dismissed the argument of the opponent that these goods are in competition, holding that the average consumer does not consume nutritional supplements as ordinary food or to quench its thirst (Paras. 71-72). The GC also confirmed the BoA's finding that the goods in question are usually sold in different outlets (or in different aisles of large supermarkets and the like) and that it was clear that the BoA had relied, in order to come to that conclusion, on the well-known fact that nutritional supplements are generally offered for sale in pharmacies, drugstores or specialised departments (Para. 77). The GC further dismissed the opponent's argument that the goods are complementary, holding that 'herbal nutritional supplements' in Class 5 are not indispensable or important for the use of 'beverages' or 'preparations for making beverages' in Class 32. It specified that any combined consumption of those products is merely ancillary (Para. 84). The GC held that the opponent's reference to a previous judgment where similarity had been found between 'strengthening and refreshing health care products, namely vitamin preparations, mineral preparations, tonics' in Class 5 on the one hand and 'beverages' and 'preparations for making beverages' in Class 32 on the other, was not conclusive, since there is no equivalence between the above goods and the 'herbal nutritional supplement' involved in this case (Para. 87).

Finally, in reply to the opponent's argument that there are some manufacturers who produce both nutritional supplements and beverages, the GC found that a likelihood of confusion can exist only if a large part of the producers or distributors of the products in question are the same, and that it is only in such a case that the relevant public will perceive the goods or services as having a common commercial source. The mere fact that some manufacturers (including the opponent) produce both categories of goods is not sufficient to demonstrate that a large part of the manufacturers or distributors of the goods at issue are the same, which should be taken into account when assessing the likelihood of confusion (Paras. 90-91).

Thus, having regard to the different purposes of the goods at issue, the differences in their marketing and lack of substitutability or complementarity, the GC considered that a partial identity of the manufacturers of the contested goods is not sufficient to create a likelihood of confusion between those goods (Para. 92).

Case T-68/13; Novartis AG v OHIM; Judgment of 23 January 2014; Language of the case: EN

KEYWORDS: Absolute grounds, Burden of proof, Competence of the Boards, Distinctive element, Laudatory mark, Principle of legality, Principle of non discrimination, Slogan mark, Specialised public, Well known facts need no evidence

RESULT: Action dismissed

FACTS: The applicant sought to register the slogan '**CARE TO CARE**' for services in Classes 41 and 42. The Examination Division's decision, rejecting the CTM application based on Article 7(1)(b) CTMR, was confirmed by the Board of Appeal (BoA). The applicant appealed to the GC.

SUBSTANCE: The Court dismissed both pleas on which the action was based, the alleged infringement of Article 7(1)(b) CTMR and the breach of the principle of equal treatment.

On Article 7(1)(b) CTMR, marks that are also used as advertising slogans may be recognised as having distinctive character and the ability to indicate to the consumer the commercial origin of the goods or services in question where those marks are not merely an ordinary advertising message, but possess a certain originality or resonance, requiring at least some interpretation by the relevant public, or setting off a cognitive process in the minds of that public (Para. 16). According to Article 76(1) CTMR, examiners and the BoA are required to examine the facts of their own motion. Whilst it is in principle the task of the competent bodies to establish in their decisions the accuracy of such facts, such is not the

case where they rely on facts which are well known. Facts shown by practical experience generally acquired and likely to be known to anyone, including the relevant public, are well known (Para. 22).

In the case at hand, the relevant public is made up of professionals and of the families of patients suffering from Alzheimer's disease who are particularly well-informed as to the seriousness and effects of that disease (Para. 23). The facts concerning the need for a gradual adaptation and changes of care are *a fortiori* well-known to the relevant public, which is especially familiar with the effects of Alzheimer's disease. In relying on well-known facts, the BoA did not infringe the rules relating to apportionment of the burden of proof (Paras. 24-25). In that specific context and in respect of the relevant English-speaking public, the expression 'care to care' will be perceived as a reference to the change from one type of care to another and, therefore, as a banal expression alluding to an inherent characteristic of educational and medical services relating to Alzheimer's disease (Para. 37).

On the principle of equal treatment, the CTM applicant complained that the BoA infringed the principles of equal treatment not taking into account the decisions already taken in respect of similar applications. Although, in the light of the principles of equal treatment and sound administration, the Office must take into account the decisions already taken in respect of similar applications and must consider with special care whether it should decide in the same way or not. The way in which those principles are applied must, however, be consistent with respect for the principle of legality. Moreover, for reasons of legal certainty and, indeed, of sound administration, the examination of any trade mark application must be stringent and full, in order to prevent trade marks from being improperly registered. Accordingly, such an examination must be undertaken in each individual case. The registration of a sign as a mark depends on specific criteria, which are applicable in the factual circumstances of the particular case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal (Para. 51).

Case T-551/12; Copenrath-Verlag GmbH & Co KG v OHIM; Judgment of 23 January 2014; Language of the case: DE

KEYWORDS: Admissibility of defence, Ending of mark, Figurative element, First time on appeal, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Relative grounds, Relevant territory, Similarity of the goods and services, Similarity of the signs, Use not as registered, Visual similarity, Weak element

RESULT: Action dismissed

FACTS: The applicant sought to register the word sign 'Rebella' as a CTM, *inter alia* for goods in Classes 20 (furniture etc.) and 24 (textiles, blankets etc.). The opponent based an opposition on Article 8(1)(b) CTMR relying on the earlier word CTM, 'SEMBELLA', registered for goods in Classes 17, 20 and 22. The opponent had to prove use of his CTM. The Opposition Division partially allowed the opposition. The applicant as well as the opponent appealed to the Board of Appeal (BoA). The BoA found that the opponent had proved use through use in two forms differing from the CTM as registered. It found visual and phonetic similarity and conceptual neutrality between the signs and an enhanced level of distinctive character of the opposing right in Austria for 'slatted frames' and 'mattresses'. It concluded that there was likelihood of confusion for identical and similar goods. The applicant appealed to the General Court (GC), arguing an infringement of Article 42(2) in connection with Article 15 (1)(a) CTMR and an infringement of Article 8(1)(b) CTMR.

| CTMA | Earlier CTM | Forms in which earlier CTM was used |
|---------|-------------|--|
| Rebella | SEMBELLA |  |

SUBSTANCE: Regarding the use in a form differing from that registered, the GC confirmed the approach in C-12/12 (Colloseum Holding). Namely, that the condition of genuine use within the meaning of Article 15(1) CTMR may be satisfied where a registered trade mark is only used with another composite mark of which it constitutes one of the elements or where it is used only in conjunction with another mark, and the combination of those two marks is itself registered as a trade mark, provided the trade mark continues to be understood as a reference to the origin of the relevant goods (Paras. 39 et seq.). It confirmed that the figurative elements in the present case are only decorative and

negligible and that they do not affect the distinctive character of the word 'sembella' (Para. 43). Regarding likelihood of confusion, the relevant consumer is the average Austrian consumer with at least a normal – possibly even an enhanced – level of attention (not disputed). The goods are identical or similar (not disputed). The GC confirmed that the signs are visually similar, even though their first letters are different (Para. 57). They are also phonetically similar (strong similarity in the rhythm of pronunciation and intonation) (Para. 58). The decisions of the German DPMA (Deutsche Patent- und Markenamt) for the first time submitted by the applicant had been rendered before the appealed BoA decision and, therefore, have been submitted to the GC belatedly (inadmissible) (Para. 59).

Case T-216/11; Progust, SL & Soprallex & Vosmarques SA v OHIM; Judgment of 28 January 2014; Language of the case: ES

KEYWORDS: Complex mark, Distinctive element, Dominant element, Figurative trade mark, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Relative grounds, Similarity of the signs

RESULT: The action is dismissed

FACTS: The applicant sought to register the figurative mark represented below as a CTM for Classes 29, 30, 31 and 32. An opposition based on the earlier CTM below, registered for goods in Class 29, was filed on the grounds of Articles 8(1)(b) CTMR. The opposition was directed against *fish* in Class 29 of the CTM. The Opposition Division (OD) upheld the opposition and refused the registration of the mark for *fish* products in Class 29. The Board of Appeal (BoA) confirmed the decision of the OD and rejected entirely the appeal.

| CTM applied for | Earlier CTM |
|---|--|
|  |  |

SUBSTANCE: On the relevant public, the General Court (GC) held that the BoA was correct in concluding that the products were targeted to average general consumers and concerned the public of the European Union. On the comparison of products the GC confirmed also that the BoA was right when it held that the products were identical. On the comparison of signs the GC held that the BoA was right when it concluded that, visually, the signs had some similarity due to the fact that both comprise a unique verbal element, only differing in the final letter. Moreover the GC confirmed that both figurative signs had the representation of a bird an element that added to the similarity of the signs. There are few and small differences. On the aural comparison, the GC confirmed the assessment of the BoA when it held that both signs have a high degree of aural similarity with only the final letter differing. On the conceptual comparison, the GC confirmed the conclusion of the BoA when it held that the conceptual comparison was not relevant as the verbal element of the signs had no meaning in some parts of the European Union. As to the global assessment of the likelihood of confusion the GC held that the verbal element of both signs was the dominant one and that this element being very similar the conclusion of risk of confusion was right. The GC confirmed also that the distinctiveness of the earlier mark was normal and not weak as claimed by the applicant.

Case T-604/11; Mega Brands International & Diset, SA v OHIM; Judgment of 28 January 2014; Language of the case: EN

KEYWORDS: Conceptual dissimilarity, Dissimilarity of signs, Distinctive element, Dominant element, Figurative trade mark, Identity of the goods and services, Internet, Labels, Likelihood of confusion, Relative grounds, Relevant territory, Weak element

RESULT: Action upheld (BoA decision annulled)

FACTS: The applicant sought to register the figurative mark represented below as a CTM for Class 28. An opposition based on the earlier Spanish trade mark below, registered for goods in Class 28, was filed on the grounds of Articles 8(1)(b) CTMR. The opposition was directed against all goods in Class 28 of the CTM. The Opposition Division (OD) upheld the opposition. The Board of Appeal (BoA) confirmed the decision of the OD and rejected entirely the appeal.

| CTM applied for | Earlier Spanish Mark |
|---|----------------------|
|  | MAGNET 4 |

SUBSTANCE: The General Court (GC) took note of the fact that the applicant did not challenge the findings of the BoA concerning the definition of the relevant public, composed of average Spanish-speaking consumers who are reasonably observant and circumspect, and the partial identity of the products covered by the marks at issue (Para. 19). On the comparison of signs the GC held that that the figurative mark applied for has a very weak degree of visual and phonetic similarity to the earlier mark (Para. 24). In particular the GC points out (Paras. 22 - 23) that the figurative mark applied for is clearly divided into two parts: 'mag' and 'next'. The excessive size of the capital letter 'X' and its stylisation has the effect that the relevant public will retain the image of the English word 'next' as a separate element of the mark, which produces a specific visual impression not produced by the sign MAGNET 4. The word 'magnet', which dominates the latter sign, gives the visual impression of a single word, while the figure '4' is not present in the figurative mark applied for. The capital letter 'X' gives rise to a clear pronunciation of the second component of the figurative mark applied for, combined with the visual separation of the two elements 'mag' and 'next', is likely to result in a phonetic reproduction of that mark as two words, whereas the word 'magnet' in the earlier mark will be pronounced as a single word, which, moreover, does not include the sound produced by the letter 'X'.

As regards the comparison of the signs at issue from a conceptual point of view, the BoA was right when it concluded that there was no conceptual similarity between the figurative mark applied for and the earlier mark on the other, since the word 'magnext', which does not exist in Spanish and is not otherwise connected to any current concept, will be perceived as being fanciful. Furthermore, the mark MAGNET 4 does not contain any element that may be associated with the English word 'next' (Para. 26). It follows that, conceptually, the conflicting marks are different (Para. 28).

On the assessment that the earlier mark has an average distinctive character the GC held (Paras. 32 and 33) that, the relevant public will associate the earlier mark with objects with magnetic properties. The GC referred to documents produced by the applicant before the OD and before the BoA. The evidence consisted, in particular, of results of internet searches showing that the promotion of the magnetic properties of games and toys is a common practice among operators active in the sector, including the owner of the earlier mark, while the Commission adopted Decision 2008/329/EC of 21 April 2008 requesting Member States to ensure that magnetic toys placed or made available on the market display a warning about the health and safety risks they pose (OJ 2008 L 114, p. 90). According to recital 7 in the preamble thereto, magnets had already been used in toys for a long time.

The GC concludes that under those circumstances, it must be held that the earlier mark MAGNET4 sends a message that may be connected, in the mind of the relevant public, to the characteristics of the products for which they have been registered and which are identical to those covered by the figurative mark applied for, so that contrary to the finding made by the BoA, its distinctive character is not medium, but weak.

Concluding on the overall assessment of the likelihood of confusion the GC held that taking account of the very slight degree of similarity between the figurative mark applied for and the weak distinctive character of the earlier mark it must be held that the BoA has made an error of assessment by recognising a likelihood of confusion between them within the meaning of Article 8(1)(b). Even if the products covered by the marks in question are partly identical, the overall impression given to the consumer who is a member of the relevant public by each of those marks is sufficiently different to avoid such a risk, also taking account of the weak distinctive character of the earlier mark.

Case T-292/12; Mega Brands International & Diset, SA v OHIM; Judgment of 28 January 2014; Language of the case: EN

KEYWORDS: Conceptual dissimilarity, Distinctive element, Dominant element, Identity of the goods and services, Internet, Labels, Likelihood of confusion, Phonetic similarity, Relative grounds, Relevant language, Visual similarity, Weak element

RESULT: The action is dismissed

FACTS: The applicant sought to register the word mark represented below as a CTM for Class 28. An opposition based on the earlier Spanish trade mark seen below, registered for goods in Class 28, was filed on the grounds of Articles 8(1)(b) CTMR. The opposition was directed against all goods in Class 28 of the CTM. The Opposition Division (OD) upheld the opposition. The Board of Appeal (BoA) confirmed the decision of the OD and rejected entirely the appeal.

| CTM applied for | Earlier Spanish Mark |
|-----------------|----------------------|
| MAGNEXT | MAGNET 4 |

SUBSTANCE: The General Court (GC) took note of the fact that the applicant did not challenge the findings of the BoA concerning the definition of the relevant public, composed of average Spanish-speaking consumers who are reasonably observant and circumspect, and the partial identity of the products covered by the marks at issue (Para. 19).

On the comparison of signs the General Court (GC) held that that the word mark applied for differs from the dominant element 'magnet' of the earlier mark only by the capital letter 'X'. It must be held that it has an average degree of visual and phonetic similarity to the earlier mark (Para. 25).

As regards the comparison of the signs at issue from a conceptual point of view, the assessment set out in paragraph 19 of the contested decisions must be confirmed, implying that the existence in the Spanish language of the adjective 'magnético', commonly used by the relevant public to designate an article with magnetic properties, has the consequence that that public will associate the earlier mark with objects having such properties. In that context, the BoA rightly concluded that there was no conceptual similarity between the word mark applied on one hand, and the earlier mark on the other, since the word 'magnext', which does not exist in Spanish and is not otherwise connected to any current concept, will be perceived as being fanciful. Furthermore, the mark MAGNET 4 does not contain any element that may be associated with the English word 'next' (Para. 27). It follows that, conceptually, the conflicting marks are different (Para. 28).

On the assessment that the earlier mark has an average distinctive character the GC held (Paras. 32 and 33) that, the relevant public will associate the earlier mark with magnetic objects. The GC referred to documents produced by the applicant before the OD and BoA. The evidence consisted, in particular, of results of internet searches showing that the promotion of the magnetic properties of games and toys is a common practice among operators active in the sector, including the owner of the earlier mark, while the Commission adopted Decision 2008/329/EC of 21 April 2008 requesting Member States to ensure that magnetic toys placed or made available on the market display a warning about the health and safety risks they pose (OJ 2008 L 114, p. 90). According to recital 7 in the preamble thereto, magnets had already been used in toys for a long time.

The GC concludes that in those circumstances, it must be held that the earlier mark MAGNET 4 sends a message that may be connected, in the mind of the relevant public, to the characteristics of the products for which they have been registered and which are identical to those covered by the figurative mark applied for, so that contrary to the finding made by the BoA, its distinctive character is not medium, but weak.

Concluding on the overall assessment of the likelihood of confusion, the General Court (GC) confirmed however, the assessment of the BoA and held that taking account of the average degree of similarity between the word mark applied for and the earlier mark, the fact that the products covered by the marks are partly identical and in spite of the weak distinctive character of the earlier mark there is likelihood of confusion between them within the meaning of Article 8(1)(b)(Para. 35).

Case T-600/11; Schuhhaus Dielmann GmbH & Co. KG v OHIM; Judgment of 28 January 2014; Language of the case: EN

KEYWORDS: issibility of defence, Coexistence of trade marks, Conceptual similarity, Dominant element, Figurative element, First time on appeal, Identity of the goods and services, International registration, Lack of reasoning, Likelihood of confusion, Phonetic similarity, Principle of legality, Relative grounds, Relevant language, Similarity of the goods and services, Visual similarity

RESULT: The action is dismissed

FACTS: The applicant sought, by means of an International registration designating the EU, to register the word mark represented below as a CTM for goods in Classes 18 and 25. An opposition based on the earlier CTM below, registered for goods in Class 25, was filed on the grounds of Article 8(1)(b) CTMR. The Opposition Division (OD) partially upheld the opposition and refused the registration of the applied for mark for all the goods in Class 25 and part of those in Class 18. The Board of Appeal (BoA) confirmed the decision of the OD and rejected entirely the appeal, holding the goods to be partly identical and partly similar and the signs to be overall similar.

| CTM applied for | Earlier Mark |
|----------------------|--|
| Carrera panamericana |  |

SUBSTANCE: In first place, the GC declared certain documents inadmissible (extracts from websites and a newspaper article which had been printed after the adoption of the contested decision and another newspaper article which appeared before the adoption of the contested decision, but was printed from that magazine's website after the adoption of that decision) (Para. 13). Secondly, the GC declared inadmissible the applicant's argument alleging that the marks at issue had peacefully co-existed on the German market, on the ground that it was based on a fact which was submitted for the first time before the Court (Para. 16). Thirdly, the GC rejected the applicant's argument that the BoA would have failed to comply with its obligation to state the reasons for the contested decision (Paras. 19-28). Fourthly, the GC - having noted that the BoA's findings on the relevant public and the identity/similarity of the goods had not been disputed - turned to the comparison of the signs and endorsed the BoA's finding that the element 'carrera' constitutes the dominant element of the earlier mark both visually and phonetically, given that it is emphasised in white letters on a black background and that the figurative element of the earlier mark serves primarily as a background to highlight that word (Paras. 43-44). The GC further confirmed that the BoA was right to find that the marks at issue exhibit a high degree of conceptual similarity for Spanish-speaking consumers, given that the word 'carrera' means 'race' in Spanish, whereas, for the non-Spanish-speaking public, that word is purely fanciful (Paras. 55-59).

Finally, the GC confirmed the existence of a likelihood of confusion on part of the relevant public (Paras. 61-62) and dismissed the applicant's reference to a judgment of the Bundespatentgericht (German Federal Patents Court) which had excluded a likelihood of confusion between the same signs (Para. 63).

Case T-47/13; Goldsteig Käsereien Bayerwald GmbH v OHIM; Judgment of 29 January 2014; Language of the case: DE

KEYWORDS: Beginning of mark, Complex mark, Conceptual dissimilarity, Dominant element, Figurative element, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Relative grounds, Similarity of the goods and services, Visual dissimilarity

RESULT: Action dismissed

FACTS: The applicant sought to register the figurative sign 'goldstück', shown below, as a CTM for goods in Classes 29 and 30 (various foodstuff). The opponent based an opposition on Article 8(1)(b) CTMR using the earlier word CTM 'GOLDSTEIG', registered for goods and services in Classes 29 and 41. The Opposition Division (OD) allowed the opposition. The Board of Appeal (BoA) annulled the OD's decision, finding that there was no likelihood of confusion as

the differences between the signs outweigh their similarities. The opponent appealed to the General Court (GC), arguing an infringement of Article 8(1)(b) CTMR.

| CTMA | Earlier CTM |
|---|--|
|  | <p data-bbox="981 347 1141 380">GOLDSTEIG</p> |

SUBSTANCE: The GC confirmed the BoA was basing its decision on the average consumer with an appropriate level of attention (not a high level of attention) in the EU (Para. 23). The goods are in part identical in part highly similar and in part have some similarity (not disputed). The figurative element of the CTMA is not negligible. The word element in the CTMA is not dominant. Taking into account the overall impression created by the marks as a whole, they are visually dissimilar (Para. 30). The signs are not, as maintained by the opponent, highly phonetically similar. Although their beginning is pronounced identically, there are relevant differences in their latter parts (Para. 33). The signs are conceptually dissimilar for the German-speaking public and have no meanings for the non-German-speaking public (Paras. 34, 35). The GC did not pronounce itself on the differences in opinion regarding the level of distinctive character of the earlier mark (BoA – weak/ opponent – strong), but found that, as the signs are visually noticed when the goods are purchased, their visual dissimilarity was of greater relevance within the assessment of likelihood of confusion (LOC). There is no LOC.

Case T-495/11; Michael Streng v OHIM; Judgment of 30 January 2014; Language of the case: IT

KEYWORDS: Admissibility, Certificate of registration, Language of the proceedings, Relative grounds, Substantiation of earlier right, Time limit, Translation

RESULT: The action is dismissed

FACTS: The applicant sought to register the word mark 'PARAMETRICA' for services in Classes 36 and 42. An opposition was filed under Article 8(1)(b) CTMR on the basis German word mark 'parameta', registered for services in Classes 35, 38, 41 and 42. English was the procedural language. In order to substantiate the opposition, the opponent had submitted, along with the notice of opposition, an extract from the trade mark register kept by the German Patent and Trademark Office and a copy of the registration certificate, both in German. Following an admissibility deficiency notice issued by the Office, the opponent filed an online extract from the German trade mark register, worded in German where only the services relied upon had been indicated both in German and in English. The Opposition Division (OD) upheld the opposition, considering that the opponent had substantiated the earlier mark.

On appeal filed by the applicant, the Board of Appeal annulled the decision of the OD and rejected the opposition, considering that the opponent had failed to provide, within the time limit, a separate translation meeting the requirements laid down by Rule 98(2) CTMIR and containing all the essential elements and reflecting the structure of the German certificate and extracts filed in support of the opposition.

Substance: The GC dismissed the opponent's appeal and confirmed the contested decision.

The Court held, referring to previous Case-Law, that it follows from the combined provisions of Rule 19(3) and 98(2) CTMIR, that an opponent must submit, within the prescribed time limit, a full translation in the procedural language of the original document/s relied upon, this requirement being aimed at allowing the applicant as well as the bodies of the Office to readily and fully appreciate the content of the translation and its conformity to the original document/s and verify the existence, validity and scope of protection of the allegedly earlier mark.

The three documents mentioned above were written in German and only the services listed in the online extract (filed following the admissibility deficiency notice) had been translated into English. Such a limited translation of the goods/services of the earlier mark, while sufficient for admissibility purposes, cannot be considered an acceptable translation (complete and reflecting the structure) of the original document/s. It thus follows that the opponent failed to substantiate the existence, validity and scope of protection of the allegedly earlier German mark, with the result that the opposition must be rejected as unfounded under Rule 20(1) CTMIR.

In this respect, the GC noted that the opponent had failed to provide, in particular, the English translation of essential elements of the earlier mark. Such elements were the issuing authority, the type of mark and its legal status. The INID codes preceding those indications in the original document/s were not sufficient to compensate the lack of translation of the corresponding textual elements following those INID codes.

Case T-127/12; Free SAS & Noble Gaming Ltd v OHIM; Judgment of 4 February 2014; Language of the case: FR

KEYWORDS: Dominant element, graphic element, Competence of the GC, Principle of legality, Relative grounds, Relevant territory, Figurative mark, Likelihood of Confusion, Conceptual dissimilarity, Beginning of mark, Press articles, Reputation, Phonetic Dissimilarity, Visual dissimilarity.

RESULT: The action is dismissed

FACTS: The CTM applicant sought to register the figurative mark represented below for Classes 9, 41 and 42. An opposition based on the earlier French trademarks below, registered for goods and services in Classes 9 and 38 was filed on the grounds of Articles 8(1)(b) and 8(5) CTMR. The opposition was directed against some of the goods and services of the applied mark. The Opposition Division (OD) rejected the opposition. The Board of Appeal (BoA) confirmed the decision of the OD and rejected the appeal entirely.

| CTM applied for | Earlier Mark |
|--|---|
|  |  |

SUBSTANCE: Regarding 8(1)(b) CTMR, on the relevant public, the General Court (GC) held that the BoA was correct when it concluded that the relevant public is the average French consumer (Para. 23). Although the BoA's decision did not contain any reasoning on the goods, since the signs were not considered similar, the applicant requested the GC to examine this point. The GC confirmed its established Case-Law that as the control of legality of the BoA's decision is limited to the subject matter, the comparison of goods was not part of the contested decision therefore the GC could not decide on it (Paras. 28-29). On the comparison of signs the GC held that the BoA was right when it concluded that visually the earlier signs were dominated by the term FREE, while the contested sign had no dominant element. On the other side the words EVOLUTION or REVOLUTION were not visually present in any of the earlier signs (Para. 44). The graphics of the contested sign are different, the word is written in capitals and the first and fourth letter are not aligned with the rest of the letters which also are in different colours, therefore the overall visual impression is different (Para. 44). On the aural comparison, the GC held (Para. 46) that the verbal element FREE which has no meaning in French will be pronounced as an English term in the earlier signs, on the other side the element 'revolution' of the contested mark has a meaning in French and therefore the public will pronounce it as a French word. The GC concludes that the beginning of the signs will not be pronounced in a similar way. In relation with the French public that will pronounce the element FREE in the English way there is a play on words possibility between the concept of freedom and the French revolution, freedom being one of the ideals of the French revolution (Para. 49).

The applicant claimed that the press cuttings and the different documentation filed showed evidence of a conceptual link between the company FREE a major telecommunications operator in France and the concept of REVOLUTION because the company has changed radically the telecommunications market.

The GC rejected this argument and followed the assessment of the BoA when it held that both words EVOLUTION and REVOLUTION were currently used to write about technological changes in the telecommunication world and could not be attributed to a particular operator (Para. 51).

To conclude on the comparison of the signs the GC held that the signs have dissimilarities on the visual and phonetic side but major differences conceptually (Para. 53). Moreover the GC confirmed (Para. 55) that as the marks are not similar, the reputation of the earlier signs cannot be taken into account.

Regarding, 8(5) CTMR, as the first of the three cumulative conditions set out in Article 8(5) CTMR, the similarity of the signs, is not met, the BoA correctly rejected Article 8(5) violation's claim (Para. 66 and 73).

New Decisions from the Boards of Appeal

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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 28 November 2013 in case R 1208/2012-2 (EN)

Opposition proceedings – Article 7(4) of the Basic Decision of the President of the Office of 18 April 2011, EX-11-3 on Electronic Communication - Article 82 CTMR – Article 8(1)(b), 8(4) and 8(5) CTMR – Rule 71(2) CTMIR - procedural issues - admissibility of an appeal - admissibility of applicant's observations before the Board – non-distinctive elements in confronted signs



The CTM applicant sought to register the mark  'other type of mark' with the description: 'The trade mark is a position mark. The mark consists of two parallel lines positioned on the outside surface of the upper part of a shoe. The parallel lines run from the sole edge of a shoe and slope backwards to the middle of the instep of a shoe. The dotted line marks the position of the trade mark and does not form part of the mark' for goods in Class 25, namely footwear.

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

Admissibility of the appeal

The contested decision was notified to the opponent by means of the e-communication system set up by the Office and thus was deemed to have taken place on the fifth calendar day following the day on which the document was created by the Office's systems. For this reason, the opponent's statement of grounds was received within the relevant term.

The Board decided that the appeal was admissible.

Admissibility of the applicant's observations before the Board

The applicant was never informed that the contested decision was notified to the opponent by electronic communication and the Registry did not inform the applicant that the statement of grounds was admissible. Therefore, the applicant could have reasonably believed that the statement of grounds was belated and, considering the complexity of the case, it is logical that it did not file observations on the substance before being sure that the appeal was admissible. Its request for an extension of the time-limit to file observations on the substance is granted. The other party's consent is not a condition *sine qua non* under Rule 71(2) CTMIR for granting an extension.

The Board found the applicant's belated observations admissible.

Likelihood of confusion, Article 8(1)(b) CTMR

Regarding the substance, the Board confirms the rejection of the opposition filed against a position mark consisting of two parallel lines positioned on the outside surface of the upper part of a shoe, on the basis, among others, of earlier reputed Community and German marks consisting of three equally spaced stripes applied to a shoe (Article 8(1)(b), 8(5), 8(4) CTMR).

It is common knowledge in the European Union that stripes are banal decorative elements applied on many types of footwear and clothing. It is only the particular configuration and position of the stripes that may be seen as an indication of origin. Thus, inherently, all of the earlier marks with three stripes are only weakly distinctive, if distinctive at all.

Even taking into account the reputation of some of the earlier marks, the differences resulting from the number of stripes and their respective positions are sufficient to preclude any likelihood of confusion for the reasonably well-informed and reasonably observant and circumspect public, even for identical goods, and independently of the fact that the earlier signs can be considered to have, at least, a normal distinctive character taking their extensive use into consideration.

Consequently, the appeal was dismissed.

Decision of the Second Board of Appeal of 11 December 2013 in case R 463/2012-2 (EN)

Opposition proceedings - Article 8(1)(b) and 8(5) CTMR - Article 41 CTMR - Articles 75, 76(2) and 77CTMR - Rules 15(2)(c) (g) and 17(2)(c) CTMIR – procedural issues – belated evidence - oral proceedings – new ground claimed in the statement of grounds - similarity of marks



The CTM applicant sought to register the mark  represented in three perspectives of a jam jar with a blue gingham-patterned lid and the label 'MÜHLHÄUSER' depicted on the lid and on the front of the jar for, *inter alia*, 'marmalades, jellies' in Class 29.

The opponent filed an opposition on the basis of Article 8(1)(b) and 8(5) CTMR based on several earlier trade mark registrations, *inter alia*, a French mark in blue and white and a CTM in black and white, depicting a square with a gingham piece of cloth, and a French 3D mark in black and white for a jam jar with a gingham lid and the label 'Bonne Maman' on the front of the jar, for identical goods.

The Opposition Division took a decision according to which the evidence filed belatedly in order to prove use of some of the earlier rights was not taken into consideration. The opposition was rejected in its entirety.

The Board issued its decision which annulled the Opposition Division's above decision as it found that the evidence filed belatedly should have been taken into consideration. Consequently, the file was remitted to the Opposition Division for further processing on the merits of the case.

The Opposition Division issued a new decision rejecting the opposition in its entirety. It concluded that the opposition failed in relation to Article 8(5) CTMR, where reputation was proven but the findings arrived at were that the marks were not sufficiently similar, and that the relevant consumer would immediately call to mind the earlier mark. The Opposition Division considered that the opposition had also to fail under Article 8(1)(b) CTMR since there also had to be no likelihood of confusion.

The opponent requested an oral hearing. The request was rejected by the Board.

With reference to the opponent's new ground claimed in the statement of grounds, the Board refused it as inadmissible and focused the examination of Article 8(5) CTMR on the basis of the only earlier right duly claimed in the notice of opposition in this respect.

With reference to the new evidenced filed by the applicant, the Board considered it inadmissible as a result of the late stage of the proceedings and its relevance to the outcome.

The Board found that a gingham design is a basic pattern, widely used in relation to food products over the ages and that it conveys a sense of traditional 100% homemade goods. The gingham pattern, at least inherently, will be perceived as a purely decorative element. The earlier figurative mark's reputation for 'Bonne Maman', shown above, was recognized in France. However, the expression 'Bonne Maman' is the most distinctive and dominant element thereof. Furthermore, the opponent only demonstrated that the French consumer relates the red and white gingham design with 'Bonne Maman' jams and jellies. The opponent's figurative sign has only one element of similarity with the applicant's 3D mark, which is a gingham-patterned design on (part of) the lid. Even taking into account the earlier mark's reputation, the differences resulting from the word elements in the marks, which in the case of the mark applied for are also prominently positioned on the lid, are sufficient to preclude any likelihood of confusion for the reasonably well informed and reasonably observant and circumspect public, even for identical goods. This is independent of the fact that the gingham pattern on the lid of the earlier sign can be considered to have, at least, a normal distinctive character, taking its extensive use into consideration. There is also no such similarity as to give rise to a link. Consumers, even with imperfect recollection, will not make a link between two marks containing a gingham-patterned design on the lid when such designs are combined with distinctive verbal elements, namely, the words 'Bonne Maman' and 'MÜHLHÄUSER', respectively, and when the gingham pattern in the mark applied for is presented in blue and white. Therefore, use of the contested mark will not take advantage of, or be

detrimental to, the earlier trade mark's distinctive character or repute. The opposition is not well founded under Article 8(5) CTMR. In relation to the earlier CTM depicting a square with a gingham design in black and white, it was found that considering that the earlier trade mark has – at most – a low distinctive character and the gingham design on the mark applied for is not the dominant element in the trade mark applied for, the marks must be considered dissimilar.

Consequently, the appeal was dismissed.

Decision of the Second Board of Appeal of 28 November 2013 in case R 235/2013-2 (EN)

Absolute grounds for refusal - Article 7(1)(b) CTMR – figurative mark – distinctiveness



The applicant sought to register the figurative mark  for goods in Classes 9 and 25.

The examiner rejected the CTM application under Article 7(1)(b) CTMR mainly on the features of the representation of the mark applied for, taken alone or combined with each other, are not distinctive: the graphic representation depicts a banal image composed of two combined shapes: a square and a line connected to one of the square's edges. The representation in question cannot be sufficiently distinguished from others commonly used in the relevant sector and it will not enable the relevant public immediately and with certainty to distinguish the applicant's goods from those of another commercial origin.

The Board considered that the mark applied for cannot be seen to be a mere variation on a basic shape commonly used on the goods. Nor is it a well-known fact, derived from common knowledge or everyday experience, that such a mark is commonplace. It is also arguable whether the mark when seen as a whole could even be described as 'banal'. In the Board's opinion it is, at least to some degree, fanciful and hence distinctive. The mark applied for is a rhombus and a line, which could evoke a stylized key or perhaps even a stylized overturned traffic sign. These features collaborate to create the image of this particular sign for which protection is sought, which the applicant wishes to use as an identifier for all the goods in the specification. The mark applied for can indeed be perceived as an indication of origin, for example, when used as a logo mark on clothing such as jackets, trousers etc. Moreover, it is customary practice in the fashion sector to use, besides word marks, also even rather simple looking figurative marks, logos and symbols to indicate the product's origin. The mark applied for is simple; however, it is not commonplace for the goods in question. No sound reasons have been given as to why it might not be capable of distinguishing the applicant's goods from those of competitors.

Consequently, the appeal was upheld.

THE REGISTRY ALSO RECOMMENDS

Decision of the First Board of Appeal of 14 November 2013 in case R 781/2013-1 (EN)

Opposition proceedings Article 8(1)(b) CTMR – Article 8(3) BoA-RP -comparison of the goods – procedural issues – Ancillary appeal was upheld

The applicant sought to register the word mark 'LEGIO' for goods and services in Classes 19 and 37.

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

The Opposition Division upheld the opposition in part, namely for all the goods in Class 19 and for part of the services in Class 37.

The applicant filed an appeal against the contested decision insofar as the opposition was upheld. The opponent did not file an appeal according to Article 58 CTMR as such; however, in its observations in reply to the statement of grounds of appeal, the opponent filed an ancillary appeal in accordance with Article 8(3) BoA-RP, seeking an alteration of the contested decision, insofar as the opposition was rejected for some services.

The Board ruled that the opposition was well founded for all the goods and services applied for, and therefore, dismissed the appeal and upheld the ancillary appeal.