

# twentyyears

1994 - 2014



## Twenty years of the CTM

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After years of developing in the side lines, the harmonisation of intellectual property law in terms of trade marks took form in Regulation (CE) No 40/94, adopted on 20 December 1993... *Page 2*

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**Twenty years of the CTM**

Twenty years ago, the CTM system was set up. The CTM Regulation entered into force on 15 March 1994 and ushered in a system which has since become a true success story for the EU and the internal market.

After years of developing in the side lines, the harmonisation of intellectual property law in terms of trade marks took form in Regulation (CE) No 40/94, adopted on 20 December 1993. This provided Europe with a unitary trade mark coexisting alongside national-level trade mark right.

Early in 1994, official meetings laid the groundwork to establish OHIM in Alicante by nominating a President to the Administrative Board and approving a budget, including 22 staff posts, for that year.

Simultaneously, on 16 June 1994, COREPER approved the nominations of the President and Vice President, paving the way for the Office to open its doors to the public on 1 April 1996. The Office itself was established in OHIM in the autumn of 1994, with the staff preparing for the activation of the CTM system.

And, as they say, the rest is history.

The CTM system was enthusiastically welcomed by users from the day one. OHIM's first office – rented temporary headquarters in the centre of Alicante – was flooded with CTM applications as users immediately began to enter the system.

The most optimistic forecasts called for about 15 000 applications to the Office in its first year, but by the end of 1996, more than 43 000 had been received by the staff in the brand-new office.

The CTM was, of course, followed in 2003 with the Registered Community Design, another unitary title in the EU's IP system, which has also proved a success with users.

OHIM's 20th anniversary year will culminate with the opening of the Office's new wing at its Alicante headquarters. This will mark a new beginning for OHIM, after two decades of existence, and pave the way for more growth and expansion to come.

**Interview****The James Nurton Interview**

This month James Nurton talks to Yahel Contreras of ZBM Patents & Trademarks in Barcelona. She discusses the differences between Europe and Latin America, the CTM reform package and some unusual cases she has worked on.

**What is your background?**

I am from Venezuela and I have been working in IP for nearly 18 years.

I did a law degree in Venezuela and straight after that I applied to a major law firm that specialised in IP. That position offered me a wide range of IP cases, particularly in trade marks. I worked on preliminary searches, filing, nullity actions, oppositions etc and participated in very interesting projects. For example, I helped building up software for a docketing system and managing portfolios for big clients in America and Europe, such as Italian fashion designers and pharmaceutical companies.

When I realised IP was the field I wanted to work in, I came to Spain to do a postgraduate degree at the University of Santiago and then I came to Barcelona to the ESADE business school to do a masters. In 2005 I got in contact with ZBM, which was already recently established in the patent field. Some clients requested them to offer trade mark services too so I was invited to join the new trade mark department. We were in the same frame of mind regarding how to provide services to the clients and I fell in love with the project.

I have a Spanish law degree from the University of Alicante and I have qualified as a Spanish trade mark attorney. I have collaborated closely with building the firm's legal and international department. My contribution to our trade mark department has been more on general advice and support on complex cases.

**Is IP work in Spain very different from Venezuela?**

We have international agreements in the IP field like the Paris Convention and TRIPs so we have the same principles everywhere more or less. In Venezuela when I was there it was part of the Andean Community, though it is out now. At that stage the Andean Community issued a directive for a legal framework for all the countries to have the same rules for IP. But there was no Community trade mark or design, like there is in Europe.

When I came to Spain, I met the CTM system and the principles were similar but the concept of unity was very different. That would be the biggest change in my practice – coming from Latin America to Spain and embracing the whole European territory.

**Tell me a bit about your firm?**

ZBM is a young firm established in 2003. The trade mark department was created to offer complementary services to our patent clients. It is clear there is more competitiveness in the trade mark area. We are a small team but our volume of work has been growing and we have a flexible, collaborative approach.

We have three lawyers with more than 13 years of experience in the trade mark field and about 12 paralegals and three qualified Spanish trade mark attorneys. The head of our department will soon retire after 30 years of work so we will be reorganising and expanding in the future.

We have two offices in Barcelona, one in Madrid and one in Denmark. Our trade mark department is located in our head office in Barcelona, along with some of the patent departments.

We mainly focus on prosecution, including filing trade marks and searching, opposition and preliminary actions and filing in other countries. For litigation we work in cooperation with other law firms.

**What kind of clients do you have?**

It's a mixture. We have several Spanish clients but also clients from the USA, Middle East and Asia. Spanish clients often appoint us as a single firm for handling IP assets around the world, but for international clients we mainly do CTM and Spanish prosecution and watching services.

I think the split is about 60-40 Spanish-international. We have a lot of patent clients who request some trade mark services, and we have reciprocal relationships with other law firms around the world who send us patent and trade mark work.

**How many applications do you file?**

I don't have the exact figure but we have about 40 or 50 trade mark filings a year, but that is not representative of the daily work we do. We focus on creating the best strategy for our clients, even if that does not involve filing a large number of trade marks. We are proud to handle this work and provide a personalised service to our clients.

**Can you remember the first trade mark you worked on?**

I remember one case near the beginning of my career. A well-known company asked us to do a preliminary search and wanted to know if there were any similar brands. I found an identical trade mark registered by the distributor of the client. That was an education for me and I was embarrassed to tell the client bad news! Luckily the matter was simply solved because there was no bad faith – they had done it to protect the client's rights. That was about the first case I remember.

I thought it was a weird case but my boss told me it was not so unusual.

**What about the most unusual case?**

In the context of infringement, we work right up to judicial action including sending cease-and-desist letters. We had a well-known fashion designer as a client and he detected an infringer so we coordinated a market investigation to determine how much the product had spread and contact the infringer as a first step. Our client's position was that infringement was very clear.

The infringer agreed he was infringing our client's rights but at the same time he considered the quality of his product was good enough. After a long discussion, our client not only agreed with the infringer but also signed a distribution contract. So we had a double negotiation: first a cease-and-desist agreement and on the other hand drafting a licensing agreement. They got an amicable solution and we avoided going to court.

**What do you think about OHIM?**

The CTM has brought to Europe a flexible system covering all EU countries that complements the national systems, which are still used by many small companies.

Investment in a CTM may be more appealing depending on your expansion plans. Prosecuting a CTM is now relatively fast. Recently OHIM has become closer to clients with online services. They could be improved and they know it. I was at an AIPPI meeting recently and someone from OHIM acknowledged the mistakes with the website and said they are doing their best to fix it, which was very comforting.

There are plans to modernise the trade mark system in the trade marks package, which is interesting. I don't think that will change the CTM system deeply as I think they want to take the CTM system as a reference to promote harmonisation in Europe.

**What do you think of the changes proposed?**

We need to be aware that we have had several years without rules changes. So I trust that harmonisation will improve the service for the customer and make the process easier. It should also be cheaper.

It is also good to introduce the same level of protection in the whole European area. It is interesting to know the case law is being interpreted uniformly, such as the IP Translator case regarding the classification of goods.

The member states will have two years to transpose the rules so we will have to wait and be open to change when it comes. It may take many years.

**What is the most important change in your view?**

The change from the three-class fee to one fee per class is important for small companies to help them access the CTM. I think this change is important.

**What are the main IP issues in Spain?**

Companies are very carefully studying their portfolios. Some years ago we received orders for filing trade marks in a lot of classes and countries. Now clients look more at the state of the economy and you see when we talk about litigation companies that some years ago went to court to claim infringement now take more account of what is the real damage and only go after the infringements that could be really damaging.

Trade marks is still the most important field in IP litigation in Spain; figures show that trade marks make up more than 80% of the IP cases at the Spanish courts. In the past year in Spain we have some important developments in the judicial structure with courts specialising in IP and training for judges. This is important even though we are in a crisis. The aim is to improve the system and the judges.

**What about the IP office?**

The office is doing well I think. For some years they published a commitment and they have now delivered that. They have implemented some online services, which are good for customers, and anyone can get in contact with them.

In the patent field they offer some financial aid to Spanish companies for them to apply for more patents. You can see they are trying to improve their systems and it is good news.

**What has been the biggest change you have seen so far in your career?**

I think in the last few years the internet and globalisation have brought a new interesting scenario for trade mark owners. You have to analyse the e-presence of your brand and your competitors. Trade mark owners consider different IP and IT elements to get better protection and defend their rights properly.

It's not only about trade marks as such, but also domain names, design and online advertising. This means clients need comprehensive IP assistance from attorneys in issues such as IT and unfair competition at the same time. We need to work more in that area in the future. It's a challenging time.

### IP Translator – Clarity and precision: what is really meant?

In the already famous ‘[IP Translator](#)’ judgment (C-307/10 of 19 June 2012), the ECJ stated, inter alia, that goods or services are sufficiently clear and precise if they enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection sought.

Following several joint meetings on the interpretation of ‘IP Translator’, OHIM and the National Offices agreed that the **requirement of clarity and precision** is the consequence of two principles: firstly, according to the principle of speciality, trade marks can only be protected for certain goods or services; secondly, the principle of certainty requires that competitors and authorities be in a position to identify the goods or services covered by a mark with sufficient clarity and precision.

Although there is a difference between ‘classification’ and the ‘requirement of clarity and precision’, the concepts are related to each other: when examining the classification of a trade mark application, the examiner also considers whether the goods and services meet the requirement of clarity and precision.

The Trade Mark Offices have established common criteria in order to determine which terms are sufficiently clear and precise, available here: [Common Communication on the Acceptability of Classification Terms](#).

OHIM’s new guidelines on classification (forthcoming on 1 July) will also reflect these common criteria.

The central message of these new guidelines is the following:

- I. A description of goods and services is sufficiently clear and precise when its scope of protection can be understood from its natural and usual meaning.
- II. If this scope of protection cannot be understood, sufficient clarity and precision may be achieved by identifying factors such as characteristics, purpose and/or identifiable market sector.

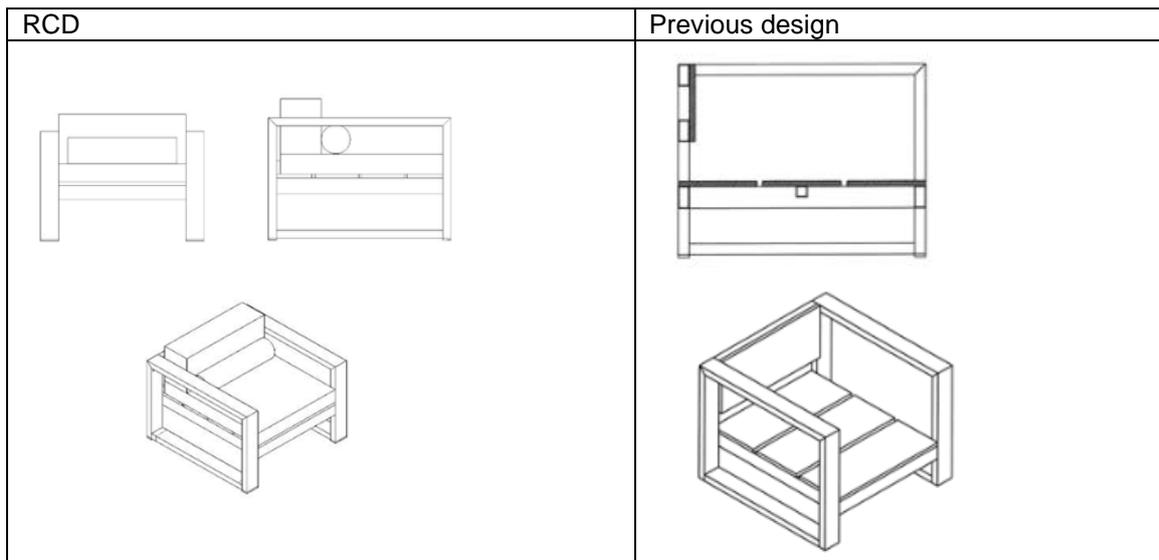
Tools such as TMclass are available on OHIM’s website at all times to assist in searching for and identifying acceptable terms.

**Knowledge Circle Goods & Services Issues**

### Case T-357/12; Sachi Premium-Outdoor Furniture, Lda v OHIM; judgment of 4 February 2014; language of the case: EN

#### RESULT: Action dismissed

**FACTS:** The RCD proprietor registered the design displayed below. The invalidity applicant applied for a declaration of invalidity based on Articles 4 to 9 CDR, relying on its previous RCD, seen below. The Invalidity Division rejected the application as it found the contested design was new and had individual character within the meaning of Article 25(1)(b) CDR. The Third Board of Appeal (BoA) annulled the decision, finding that it lacked individual character in the meaning of Article 6 CDR. The RCD proprietor appealed to the General Court (GC); the appeal was based on an alleged infringement of Article 6 CDR.

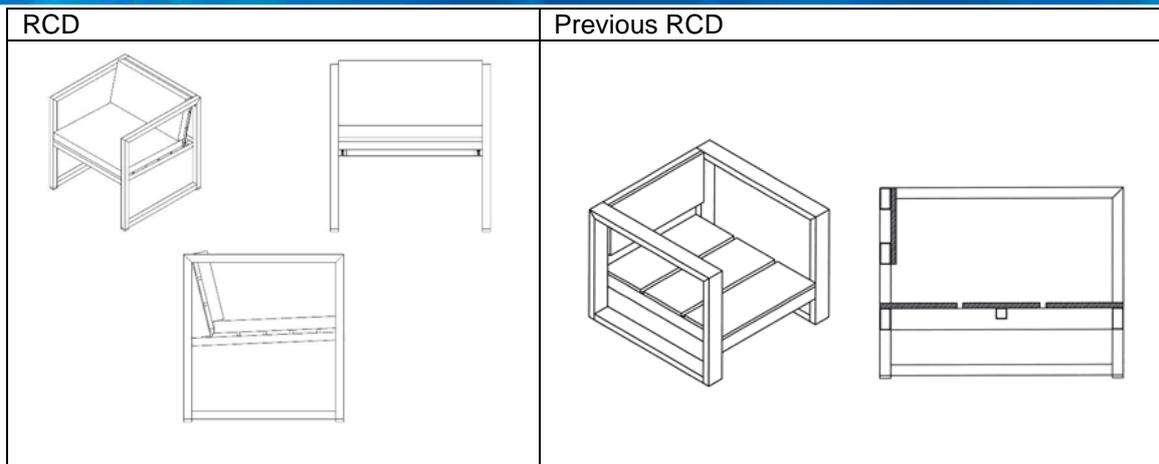


**SUBSTANCE:** The informed user is particularly observant, shows a relatively high degree of attention, is familiar with the product and possesses certain knowledge of the features which armchair designs normally include (not disputed) (paragraphs 15-18). The most significant difference between the designs is the cushions of the RCD. The cushions can be regarded as secondary elements as they are not fixed to the rest of the design. Differences derived from these secondary elements are irrelevant (paragraphs 36-38, 40-42). Regarding individual character, elements that are barely visible during use are of little importance to the assessment of the overall impression (paragraph 57). The designer's degree of freedom may be limited by, inter alia, the technical function of the product or by statutory requirements. However, a general design trend does not restrict this freedom (paragraph 24). The freedom of the designer is limited only by the fact that the armchairs have to be functional and include a seat, a backrest and two armrests. The RCD proprietor did not establish that parts claimed to be necessary are called for by stability and structural requirements (paragraph 58).

**Case T-339/12; Gandia Blasco, SA v OHIM; judgment of 4 February 2014; language of the case: EN**

**RESULT: Action dismissed**

**FACTS:** The RCD holder registered the contested design, as displayed below. The invalidity applicant filed for a declaration of invalidity based on Articles 4 to 9 CDR and its previous RCD, also displayed below. The Invalidity Division rejected the application, finding found that the contested design was new and had individual character within the meaning of Articles 5, 6 and 25(1)(b) CDR. The Board of Appeal dismissed the appeal as the overall impression produced by the earlier design did not deprive the contested design of its individual character. The invalidity applicant appealed, referring to an alleged infringement of Article 6 CDR.



**SUBSTANCE:** Informed users know the various designs which exist in the sector concerned and possess knowledge of the features which are normally included. Due to their interest in the products, they are particularly observant and show a relatively high degree of attention when using them (not disputed) (paragraphs 14-15, 20). Overall impression is to be determined in the light of how the product is used. The inclined backrest and seat will give rise to a different perception of comfort from that of a straight back and seat. The use made of that armchair by the circumspect user is liable to be affected by such a difference (paragraphs 30). Regarding parts that are outside the user's field of vision, these will have no great impact on how the design is perceived. Parts found underneath the cushion of an armchair seat fit this description (paragraphs 32-34).

## EUTMDN Updates

### Austrian Patent Office now part of the Harmonised Database

As of 17 March 2014, the [Austrian Patent Office and Trade Mark Office](#) (OPA) is a part of the Common Harmonised Database of Goods and Services for trade mark classification.

As a result, the German translations of the Harmonised Database set are now available to all users through the [TMclass](#) application. This successful harmonisation is the result of joint effort and collaborative work within the European Trade Mark and Design Network. The OPA's integration into the Harmonisation Project for Goods and Services marks yet another step forward in improving predictability, which in turn benefits users.

### France and Malta join DesignView

The French [National Institute of Industrial Property](#) (INPI) has been integrated into the [DesignView](#) database, making approximately 700 000 French designs, dating from 1910 to the present day, available to its users.

Meanwhile, the Maltese National IP Office, which forms part of the Maltese Commerce Department, has also been integrated into the DesignView database, adding 1 500 Maltese designs, dating from 1923 to the present day.

The French and Maltese offices are the 14th and 15th offices, respectively, to become part of DesignView, joining Benelux, Bulgaria, Czech Republic, Estonia, Greece, Spain, Latvia, Lithuania, Portugal, Slovenia, Slovakia, Sweden and OHIM.

After these latest integrations, the total number of designs in the tool stands at around 2 million.

## The UK IPO joins Similarity

The [UK Intellectual Property Office](#) has joined the [Similarity](#) tool.

Similarity is a common database of comparisons of goods and services that allows users to assess whether given goods or services are considered similar or dissimilar – and to what degree – according to the practice of the participating IP offices. Similarity benefits users by bringing more transparency to the decision-taking process of EU national offices and OHIM. Similarity also improves the predictability of opposition decisions.

With this new integration, Similarity integrates information from 11 European IP Offices into one single platform.

## Harmonised Classification Database updated

The Harmonised Classification Database, used and maintained with the cooperation of 22 EU IP Offices, was updated on 1 March. This marks the start of a monthly update cycle in the context of the Harmonised Workflow.

The Harmonised Workflow ensures that the database is up to date and meets the needs of users and participating offices thanks to a system of proposals and voting on any changes.

The first update saw the addition of four new concepts to the database and the removal of twelve outdated concepts.

More News



## New content available in the OHIM Academy learning platform

The OHIM Academy & Knowledge Repository is pleased to announce that new content, covering selected decisions of the Court of Justice/the General Court and the OHIM Boards of Appeal, is now available to watch via the OALP:

- Decisions of the Trimester – recorded on 21 January 2014  
Follow this link: <http://oami.europa.eu/knowledge/course/view.php?id=1723>
- Decisions of the Trimester – recorded on 22 November 2013  
Follow this link: <http://oami.europa.eu/knowledge/course/view.php?id=1722>

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

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

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

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

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

The survey will be one of the tools used to help improve the IPR-enforcement situation in non-EU countries, so the views of EU businesses and EU IP professionals with experience or interest in this area is particularly welcome.

We would be grateful if you could give us your views on countries for which you have a particular interest or of which you have special knowledge. The survey opens on 10 March and runs to 10 June at:

<https://www.tmdn.org/uss/index.php?sid=64891&lang=en>

The survey is easy to complete, but if you have any issues, please email us at:

[ObservatorySurvey@oami.europa.eu](mailto:ObservatorySurvey@oami.europa.eu)

### Memorandum of Understanding – OHIM and IPOM (Montenegro)

OHIM and the Intellectual Property Office of Montenegro (IPOM) have signed a Memorandum of Understanding, covering a range of cooperation activities, as part of the Office's International Cooperation Programme approved last February.

Under the agreement, Montenegro will work towards joining TMview, Designview and TMclass, as well as taking part in training activities organised by OHIM. A national expert from IPOM will also join OHIM to share best practices and exchange experiences.

### Monthly statistical highlights\* – February 2014 compared to February 2013

	2014	2013
Community trade mark applications received	9 655	9 483
Community trade mark applications published	7 313	8 212
Community trade marks registered (certificates issued)	7 978	6 198
Registered Community designs received	7 287	6 877
Registered Community designs published	6 721	5 800

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



## Luxembourg Case Law

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

**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 T-283/11, the GC overturned a decision of the BoA and refused the CTMA “nfon” for goods and services in Classes 9 and 38 on the basis of the earlier CTM “fon” and UK mark “fon” registered in the same classes. The CTM applicant brought an appeal to the Court which was supported by OHIM. The CTM applicant claimed an infringement of Article 8(1)(b) CTMR through three mistakes in the overall assessment of the likelihood of confusion: the assessment of the distinctive elements of the signs, a wrong 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 products concerned. It submitted, however, that as such it is devoid of distinctive character and the coincidence in this element cannot cause likelihood of confusion. The 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 case of an identity or high similarity between the products, the distance between the marks has to be significant in order to exclude likelihood of confusion. The CJ took the position that no such general rule was pronounced in the judgement under appeal (Para. 41). The third part of the claim regards the lack of consideration of the level of 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 GC implicitly considered all relevant factors (Paras. 54 and 56).

**Case C-65/12; Bulldog e.a. v. Red Bull; Preliminary Ruling of 16 January 2014 Language of the case: Dutch**

**KEYWORDS:** Preliminary ruling, reputation

**FACTS:** RED BULL is the owner of the Benelux word and figurative mark **RED BULL KRATING-DAENG** (registered 11/7/83, *inter alia* for ‘non-alcoholic drinks’). Mr de Vries is the owner of several Benelux marks for goods in Class 32: **THE BULLDOG** (word and figurative), registered on 14/7/83; **THE BULLDOG** (word), registered on 23/12/99; **THE BULLDOG ENERGY DRINK** (word and figurative), registered on 15/6/2000. Before RED BULL filed its mark in 1983, Mr de Vries was using the sign **THE BULLDOG** as a trade name for hotel, restaurant and café services. RED BULL brought an action requesting that Mr de Vries be ordered to cease production and marketing of energy drinks in packaging that displays the **BULL DOG** sign. Mr de Vries brought an appeal before the Dutch Supreme Court against a restrictive interpretation of the concept of **DUE CAUSE**. In his view, use in good faith of the sign **THE BULLDOG** as a trade name, before the mark **RED BULL KRATING DAENG** was filed, constitutes due cause. Question by the Supreme Court: Should Article 5(2) TMD be interpreted as meaning that the use by a third party of a sign that is similar to a trade mark with a reputation in relation to goods identical may be considered to be with ‘due cause’ if it is demonstrated that that sign was being used before that mark was filed?

**SUBSTANCE:** The CJ rejects a restrictive concept of due cause. Due cause may not only include objectively overriding reasons, but it may also relate to the subjective interests of a third party using a sign which is identical or similar to the mark with a reputation (Para. 45). The concept of due cause is intended to strike a balance between the interests in

question, by taking account of the interests of the third party using that sign (Para. 46). The proprietor of a trade mark with a reputation (*red bull*) may be obliged, pursuant to the concept of due cause, to tolerate the use by a third party of a sign similar (*the bulldog*) for an identical product, if that sign was being used before the mark was filed and the use in relation to the identical product was made in good faith. The national court must take account, in particular, of:

- The intention of the person using that sign (Para. 55).
- How that sign (*the bulldog*) has been accepted by, and what its *reputation* (Reputation' and 'repute' regarding the sign THE BULLDOG are not used by the CJ in the sense of Article 8(5) CTMR) is with, the relevant public.
- The degree of proximity between the goods and services for which that sign (*the bulldog*) was originally used and the product for which the reputed mark (*red bull*) was registered. Is it a natural extension of the range of services and goods for which the sign (*the bulldog*) already enjoys a certain *repute* with the relevant public? (Paras. 57-58)

The economic and commercial significance of the use for that product of the sign is similar to that mark. The greater the *repute* of the sign (*the bulldog*) used before, the more its use will be necessary for marketing a product identical to that for which the mark (*red bull*) was registered, a fortiori as that product is close to the range of g&s for which that sign was previously used (Para. 59)

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

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

**RESULT: Action upheld (GC judgment annulled)**

**FACTS:** The applicant sought to register the sign **WESTERN GOLD** (word) as a CTM for goods in Class 33. The opponent based its opposition on various earlier word marks, among them the earlier CTM **WeserGold** 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 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 Board of Appeal. The Court found that the Board made an error in the application of Article 8(1)(b) CTMR as it did not examine the issue of distinctiveness enhanced through use. OHIM filed an appeal to the CJ. According to OHIM, 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 Board of Appeal 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 Board of Appeal emphasising that Board of Appeal should have examined the distinctiveness of the earlier marks, acquired through use. According to the GC, that error meant that the Board of Appeal 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 Board of Appeal was required to examine the enhanced distinctiveness of the earlier marks, acquired through use, and annulled the decision of the Board of Appeal on that ground, notwithstanding a prior finding in the judgment under appeal that the marks at issue were dissimilar. Since OHIM's first ground of appeal was successful it was not necessary to decide on the remaining grounds of appeal brought forward by OHIM (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 OHIM. 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: Admissibility, Ratio Legis, Time Limits**

**RESULT: Action dismissed**

**FACTS:** The applicant sought to set aside the judgment of the General Court of 10 April 2013 in case T-360/11 by which the GC dismissed its action seeking the annulment of the decision of the Second Board of Appeal 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, interpretation of Article 58 Rules of Procedure of the Court: The Court held that the appeal was, contrary to what the Office argued, admissible. Although the applicant/appellant did not mention or quote any relevant extract of the GC's judgment, in general, it can be clearly extracted from the argumentation which are the elements under criticism, allowing then the CJ to exercise its control of legality. On the substance: Interpretation of former Article 59 (now Article 60) CTMR: On the first plea in law, namely on the concept of filing and referring to the interpretation of the CTMIR, the CJ confirmed the assessment of the General Court 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 OHIM 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 by virtue of Article 1 (6) of Regulation 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 (3) CTMIR provides that when the motivation is made by certified letter with or without receipt, the notification is considered done 10 days after the date of sending by post, 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 time limit started to run, the CJ confirmed the interpretation of the General Court of Rule 70 (4) CTMIR that the time limit started to run 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 time limit 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 applicant was wrong in its interpretation; even if the parties are free to choose the means of communication, the time limits are not modified in accordance with these choices.

**Case C-422/12P Industrias Alen SA de CV V OHIM; Order of 30 January 2014; Language of the case: ES**

**KEYWORDS: Admissibility, Common element, Conceptual similarity, Descriptive element, Error by OHIM, Infringement, Joined appeal, Likelihood of confusion, Phonetic similarity, Relative grounds, Relevant territory, Visual similarity, Weak element**

**RESULT: Action dismissed**

**FACTS:** The CTM applicant sought to register the word mark **CLORALEX** for goods in Classes 3 and 5 (inter alia bleaching products and disinfectants). The opponent based its opposition on word marks **CLOROX**, covering identical products. The Opposition Division upheld the opposition. The Board of Appeal annulled the OD decision and dismissed the opposition, considering that the signs were not similar enough for a likelihood of confusion to exist. Upon appeal from the opponent, the General Court (GC) annulled the Board's decision (T-135/11). It noted that Greek consumers will understand that the element CLOR- refers to chlorine and indicates a frequently used component of cleaning and disinfection products. However, the weak distinctive character of an element of a complex mark does not necessarily imply that that element will not be taken into account by the relevant public. The GC found that the common element CLOR- determines to a large extent the global impression that the two signs produce. The Board of Appeal erred in not

taking into account the element CLOR- when comparing the conflicting signs. The GC found that, due to a low visual and aural similarity and a high conceptual similarity between the signs, there is a likelihood of confusion. It annulled the contested decision.

**SUBSTANCE:** The CTM applicant alleged an infringement of Article 8(1)(b) CTMR because the GC took into account the descriptive element CLOR in the comparison of signs, even though it is perceived by the public as a reference to chlorine and not to a trade mark. It also contested the visual, aural and conceptual comparison of the signs, as well as the assessment of LOC. The Court of Justice found part of the applicant's arguments manifestly inadmissible and the remaining ones manifestly unfounded. The Office supported the appeal and raised new pleas, which amounted to a cross-appeal. As from 1 November 2012, Article 176(2) of the Rules of Procedure of the Court of Justice requests that cross-appeals be filed in a separate document. The Office did not do so. The cross-appeal is manifestly inadmissible.

**Case C-98/13; Martin Blomqvist v Rolex SA; Preliminary Ruling of 6 February 2014; Language of the case: DA**

**KEYWORDS:** Preliminary ruling, Infringement

**FACTS:** Martin Blomqvist, a resident of a Member State, ordered in 2010 a watch described as a Rolex from a Chinese on-line shop. The seller sent the watch in parcel from Hong Kong to Denmark by post, where it was inspected by the customs authorities on arrival. In accordance with the procedure laid down by the customs regulation (Council Regulation (EC) No 1383/2003 of 22 July 2003), Rolex then requested the continued suspension of customs clearance, having established that the watch was in fact counterfeit. Since Mr Blomqvist refused to consent to the destruction of the watch, Rolex brought an action before the Sø-og Handelsretten (Maritime and Commercial Court), seeking an order that he allow the destruction of the watch without compensation. That court granted Rolex's claim. Martin Blomqvist brought an appeal before the Højesteret (Danish Supreme Court). The Højesteret raised the question, whether the circumstances of the case constitute an infringement of intellectual property right, taking into consideration that for the customs regulation to apply 1) there must be a breach of copyright or of a trade mark right which is protected in Denmark and 2) the alleged breach must take place in the same Member State.

**SUBSTANCE:** The CJ replied to the questions as follows.

- 1) Term of 'distribution to the public' within the meaning of (a) Article 4(1) of the copyright directive (Directive 2001/29/EC) and term of 'use in the course of trade' within the meaning of Article 5(1) and (3) TMD (Directive 2008/95/EC) and Article 9(1) and (2) CTMR must be interpreted as meaning that the mere fact that the sale was made from an online sales website in a non-member country cannot have the effect of depriving the holder of an intellectual property right to the goods which were the subject of the sale of the protection afforded by the customs regulation, without it being necessary to verify whether such goods were, in addition, prior to that sale, the subject of an offer for sale or advertising targeting European Union consumers (Para. 34).
- 2) Article 2(1)(a) and Article 2(1)(b) of the customs regulation must be interpreted as meaning that the 'counterfeit goods' or 'pirated goods' coming from a non-member State which are imitations of goods protected in the EU by a trade mark right or copies of goods protected in the EU by copyright, a related right or a design can be classified as 'distribution to the public' or '[use] in the course of trade' where it is proven that they are intended to be put on sale in the EU, in particular, where it turns out that the goods have been sold, offered for sale or advertised to customers in the EU (Para. 33).

**RESULT:** The customs regulation grants to the holder of an intellectual property right in respect of goods sold to a resident of a Member State through an online sales website established in a non-member country, the protection at the time when those goods enter the territory of that Member State merely by virtue of the acquisition of those goods.

Case C-301/13P, El Corte Ingles, S.A. v OHIM, Order of 6 of February 2014, Language of the case: ES

**KEYWORDS:** Admissibility of defence, Competence of the GC/CJ, Infringement, Lack of reasoning, Principle of legal certainty, Principle of legitimate expectations, Relative grounds, Right to be heard, Scope of proceedings, Substantiation of earlier right

**RESULT:** Action dismissed

**FACTS:** The applicant sought to register the word mark '**CLUB GOURMET**' as a CTM for goods in Classes 16, 21, 29, 30, 32 and 33. An opposition was filed on the grounds of Article 8(1) (b) and Article 8(5) CTMR. It was based on the earlier Spanish figurative trade mark reproduced below, for services in Class 35. The Opposition Division rejected the opposition. The Board of Appeal dismissed the appeal which had been filed by the opponent. The General Court (GC) dismissed the appeal and upheld the decision of the Board of Appeal. It considered that the earlier right identified only one service of Class 35, without any reference to the products covered by other related trademarks. The GC also stated that the opponent had not alleged protection beyond the services of Class 35. Furthermore, it set out that the Office has the obligation to take into consideration the national law only if it previously had indications as regards such national law. Finally, the GC found that the description of the services covered by the earlier mark did not allow a comparison with the challenged goods.

CTMA	Earlier Marks
<p><b>CLUB GOURMET</b></p>	<p><b>CLUB DEL GOURMET,</b></p> 

**SUBSTANCE** The opponent alleged (i) the infringement of the principle of legitimate expectations and of the principle of legal certainty; (ii) that the GC had made an erroneous assessment of the facts; (iii) lack of reasoning; (iv) the infringement of the right of defense. As regards the first plea, the Court of Justice (CJ) considered that the opponent has made an erroneous interpretation of the GC's decision (Para. 30) and that the principles whose infringement is alleged cannot be applied in this case (Para. 32). Moreover, the CJ also set out that the opponent was not actually criticizing the GC's decision, but rather the decision of the Opposition Division. The second plea was refused as inadmissible since it refers to the assessment of the facts made by the GC, which is out of the scope of the appeal before the CJ (Para. 43). With respect to the third plea, the CJ considered that the GC had provided a sufficiently clear line of reasoning as regards the inapplicability of a particular case-law (Para. 54), as well as regards the reasons to refuse the opponent's claim (Para. 58). Finally, the CJ endorsed the analysis made by the GC with respect to the assessment of the comparison of the goods. In the CJ's view, the GC took into account the opponent's arguments and duly refused them. Therefore, the infringement of the right of defense must be excluded (Para. 68). The CJ accordingly dismissed the opponent's appeal in its entirety.

**Case C-409/12; Backaldrin Österreich The Kornspitz Company GmbH v Pfahnl Backmittel GmbH; Preliminary Ruling of 6 March 2014; Language of the case: DE**

**KEYWORDS:** Preliminary ruling, relevant public, Revocation grounds

**FACTS:** Backaldrin is the owner of the Austrian mark “KORNSPITZ” for bakery goods and baking mixes in Class 30. The company produces a baking mix which it supplies primarily to bakers. Those turn that mix into bread rolls with a specific shape. Backaldrin consented to the use of that trade mark by the bakers in the sale of that bread roll. Pfahnl, a competitor of Backaldrin, filed a revocation request against “KORNSPITZ” under Paragraph 33(b) of the Austrian TMA before the Austrian Patent Office (Österreichisches Patentamt), alleging that it has become the common name of the bread roll. The competitors of Backaldrin are aware that “KORNSPITZ” is a trade mark. However, according to Pfahnl, the end consumers perceive the sign as the common name for bread rolls which are oblong in shape and have a point at both ends. This perception is also due to the fact that the bakers do not inform the end consumers that “KORNSPITZ” is, in fact, a trade mark. The Cancellation Division of the Austrian Patent Office granted the application for revocation. Backaldrin appealed against that decision to the Supreme Patent and Trade Mark Court (Oberster Patent- und Markensenat). The Supreme Patent and Trade Mark Court referred three questions to the CJ concerning the interpretation of Article 12(2) (a) TMD. The first question relates to the relevant public for assessing whether a trade mark has become the common product name. The second question seeks guidance as regards the term “inactivity” in the meaning of Article 12(2) (a) TMD. The third question refers to the possible relevance of alternative names when applying this norm.

**SUBSTANCE:** The European Court of Justice (CJ) replied to the questions as follows.

- 1) Article 12(2) (a) TMD must be interpreted as meaning that, in a case such as that at issue in the main proceedings, a trade mark is liable to revocation in respect of a product for which it is registered if, in consequence of acts or inactivity of the proprietor, that trade mark has become the common name for that product from the point of view solely of end users of the product (Para. 30).
- 2) Article 12(2) (a) TMD must be interpreted as meaning that it may be classified as “inactivity” within the meaning of that provision if the proprietor of a trade mark does not encourage sellers to make more use of that mark in marketing a product in respect of which the mark is registered (Para. 36).
- 3) Article 12(2) (a) TMD must be interpreted as meaning that the revocation of a trade mark does not presuppose that it must be ascertained whether there are other names for a product for which that trade mark has become the common name in the trade (Para. 40).

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

**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 using 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 dismissed the appeal, finding that the earlier trade mark had been put to genuine use in the course of relevant five years and that the goods were in part identical and in part similar. The phonetic identity, conceptual identity and low level of visual similarity between the signs were also found. In the light of those facts, the Board of Appeal stated that there was a likelihood of confusion. The opponent appealed to the General Court, arguing an infringement of Article 42(2) and (3) CTMR and, secondly, an infringement of Article 8(1)(b) CTMR.

CTMA	Earlier CTM
	

**SUBSTANCE:** The GC rejected the applicant's argument based on Article 42(2) and (3). Despite the fact that on the related invoices submitted by the opponent, the element "4ever" is written in ordinary character and therefore it is not an exact reproduction of the earlier mark, these differences do 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 so low to be concluded that the use is merely token, minimal or notional for the sole purpose of preserving the rights conferred by the mark. The opponent's evidence was sufficient for a finding of genuine use (Paras. 39-41). Concerning Article 8(1)(b) CTMR, the GC further stated that the attentiveness of the 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 concluded too, because the visual differences were not so significant as to cancel out the slight visual similarity. Moreover, the applicant acknowledged that there are visually similar elements between the marks (Paras. 58-62). It is also clear that the part of the 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, because they contain the same ending "ever" (Paras. 70-71). Likewise, the marks were found conceptually similar for that part of the relevant public, which has some knowledge of the English language, however conceptually neutral for that part of the 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-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 revoked the CTM in its entirety. The Board of Appeal (R 444/2011-4) 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 Board of Appeal considered that proof of the extent of use was missing. The CTM proprietor filed an action before the General Court. The CTM proprietor only challenged the Board'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 General Court dismissed the appeal. Since the Board 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 General Court is declared inadmissible (Para. 20). The CTM proprietor's argument that the Board 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 use (Para. 39). It does not appear that the letters are numbered upwards in chronological order, so that no 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-113/12; Bial-Portela & C<sup>a</sup>, 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 applicant filed an application for a figurative CTM **PROBIAL** (represented below) for, inter alia, goods in Class 5. The opponent filed an opposition based on a number of previous rights, among which the Portuguese word mark **BIAL**, both registered and well-known, figurative black and white CTM and Spanish mark BIAL (image represented below), international word mark BIAL, registered for Benelux, Germany, France, Italy and Austria, emblem and logo (image represented below) and 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 opponent 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 on the basis of that right had become final. Secondly, the claim as per Article 8(5) was rejected, because it was brought for the first time before the Board. The BoA further found that the evidence submitted was insufficient to prove genuine use, since it does not solidly indicate that the company sells pharmaceuticals under the trade mark BIAL. As regards the logo, business name and emblem, the opponent had failed to provide evidence that the signs were used in the course of trade and had 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><b>BIAL</b> (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 opponent to contest the BoA's findings (Paras. 36-38). As for the claimed well-known mark in Portugal, the GC confirmed the findings of the Board that the opponent 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 opponent did not contest the conclusion of the Board 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 opponent 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-551/12; Coppentrath-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 using 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:** Use in a form differing from that registered: The GC confirmed the approach in C-12/12 (Colloseum Holding) 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). 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-221/12; The Sunrider Corporation v OHIM; Judgment of 23 January 2014; Language of the case: EN

**KEYWORDS:** Complementary goods and services, Labels, Likelihood of confusion, Nature of Dissimilarity of the goods and services, 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**’ figurative 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 upheld the opposition for all the contested goods and rejected the application for registration in its entirety. On appeal, the Board of Appeal annulled the decision of the Opposition Division and rejected the opposition. The Board 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 Board 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 Board. 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 Board 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 Board'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 Board'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 Board 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-600/11; Schuhhaus Dielmann GmbH & Co. KG v OHIM; Judgment of 28 January 2014; Language of the case: EN**

**KEYWORDS:** Admissibility of defence, Coexistence of trademarks, 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:** Action 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 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 confirmed the decision of the Opposition Division and rejected the appeal in its entirety, holding the goods to be partly identical and partly similar and the signs to be overall similar. The applicant appealed to the GC.

CTMA	Earlier Mark
Carrera panamericana	

**SUBSTANCE:** In first place, the GC declared inadmissible certain documents (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 Board failed to comply with its obligation to state the reasons for the contested decision (Paras. 19-28). Fourthly, the GC - having noted that the Board'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 Board'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 Board 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-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 CTMA. The Opposition Division upheld the opposition. The Board of Appeal confirmed the decision of the OD and rejected the applicant's appeal in its entirety.

CTMA	Earlier Spanish Mark
	MAGNET 4

**SUBSTANCE:** The GC took note of the fact that the applicant does not challenge the findings of the Board of Appeal 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 the CTMA has a very weak degree of visual and phonetic similarity to the earlier mark (Para. 24). In particular, the GC points out (Paras. 22 and 23) that the CTMA 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 CTMA. The capital letter 'X' gives rise to a clear pronunciation of the second component of the CTMA which, 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 conceptual point of view, the Board was right when it concluded that there was no conceptual similarity between the CTMA and the earlier mark, 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, as the Board of Appeal stated in paragraph 19 of the contested decision, the relevant public will associate the earlier mark with objects with magnetic properties. The GC referred to documents produced by the applicant before the Opposition Division and before the Board of Appeal. That evidence consists, 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 CTMA, so that, contrary to the finding made by the Board of Appeal, its distinctive character is not medium, but weak. Concluding on the overall assessment of the likelihood of confusion the General Court held that taking account of the very slight degree of similarity between the CTMA and the weak distinctive character of the earlier mark it must be held that the Board of Appeal 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, Dissimilarity of signs, Distinctive element, Dominant element, Identity of the goods and services, Internet, Labels, Likelihood of confusion, Relative grounds, Relevant territory, Weak element

**RESULT:** Action dismissed

**FACTS:** The applicant sought to register the word mark "MAGNEXT" as a CTM for Class 28. An opposition based on the earlier Spanish word mark "MAGNET 4", 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 CTMA. The Opposition Division upheld the opposition. The Board of Appeal confirmed the decision of the OD and rejected the applicant's appeal in its entirety.

**SUBSTANCE:** The GC took note of the fact that the applicant does not challenge the findings of the Board of Appeal 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 the CTMA 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 conceptual point of view, the assessment set out in paragraph 19 of the contested decisions must be confirmed, 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 Board of Appeal rightly concluded that there was no conceptual similarity between the CTMA and the earlier mark, since the word 'magnex', 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, as the Board of Appeal stated in paragraph 19 of the contested decision, the relevant public will associate the earlier mark with objects with magnetic properties. The GC referred to documents produced by the applicant before the Opposition Division and before the Board of Appeal. That evidence consists, 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 CTMA, so that contrary to the finding made by the Board of Appeal, its distinctive character is not medium, but weak. Concluding on the overall assessment of the likelihood of confusion the General Court confirmed however the assessment of the Board and held that taking account of the average degree of similarity between the CTMA 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-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 allowed the opposition.

The Board of Appeal (BoA) annulled the Operations Department (OD) 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="758 436 917 465"><b>GOLDSTEIG</b></p>

**SUBSTANCE:** The GC confirmed the Board 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:** Action dismissed

**FACTS:** The applicant sought to register the word mark '**PARAMETRICA**' for services in Classes 36 and 42 and an opposition was filed under Article 8(1)(b) CTMR on the basis of the allegedly earlier 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 and where only the services relied upon had been indicated both in German and in English. The Opposition Division upheld the opposition, considering that the opponent had substantiated the earlier mark. On appeal filed by the applicant, the Board annulled the decision of the Opposition Division 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 from the combined provisions of Rule 19(3) and 98(2) CTMIR it follows 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 OHIM 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. Given that the three documents mentioned above were written in German and that only the services listed in the online extract (filed following the admissibility deficiency notice) had been translated into English, and that 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 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 as those concerning the issuing authority, the type of mark and its legal status, the INID codes preceding those indications in the original document/s not being sufficient to compensate the lack of translation of the corresponding textual elements following those INID codes.

**Case T-216/11; Progust, SL & Sopralex & 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: Action 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 Article 8(1) (b) CTMR. The opposition was directed against *fish* in Class 29 of the CTMA. The Opposition Division upheld the opposition and refused the registration of the CTMA for *fish* products in Class 29. The Board of Appeal confirmed the decision of the OD and rejected the applicant's appeal in its entirety.

CTMA	Earlier CTM
	

**SUBSTANCE:** On the relevant public, the General Court held that the Board of Appeal was correct when it concluded that the products were targeted to average general consumers and concerned the public of the European Union. On the comparison of products, the General Court confirmed that the Board was right when it held that the products were identical. On the comparison of signs, the General Court held that the Board was right when it concluded that, visually, the signs had some similarity due to the fact that both have a unique verbal element very similar and only differing in the final letter. Moreover, the General Court confirmed that both figurative signs had the representation of a bird element that added to the similarity of the signs. The signs have little and minor differences only. On the aural comparison, the General Court confirmed the assessment of the Board of Appeal when it held that both signs have a high degree of aural similarity having only one final letter difference. On the conceptual comparison, the General Court confirmed the conclusion of the Board 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. Concluding on the overall assessment of the likelihood of confusion, the General Court held that the verbal element of both signs was the dominant one and as this element was very similar, the conclusion of risk of confusion was right. The General Court confirmed also that the distinctiveness of the earlier mark was normal and not weak as claimed by the applicant.

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

**KEYWORDS:** Principle of legality, Beginning of mark, Dissimilar signs, Press Articles

**RESULT:** Action dismissed

**FACTS:** The applicant sought to register the figurative mark represented below as a CTM 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 CTMA. The Opposition Division rejected the opposition. The Board of Appeal confirmed the decision of the OD and rejected the opponent's appeal in its entirety.

CTMA	Earlier French Marks
	 FREE FREE MOBILE FREE.FR

**SUBSTANCE:** On 8(1) (b) CTMR: On the relevant public, the GC held that the Board of Appeal was correct when it concluded that the relevant public is the average French consumer (Para. 23). On the comparison of products, the Board's decision did not contain any reasoning on it because the signs were considered not similar. The opponent requested the General Court to examine this point. At paragraphs 28 and 29, the GC confirmed its established case law that as the control of legality of the Board'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. On the comparison of signs, the GC held that the Board 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 global 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 to 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 opponent 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 Board 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. On 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 Board correctly rejected Article 8(5) (Paras. 66 and 73).

**Case T-26/13; dm-drogerie markt GmbH & Co, KG, v OHIM; Judgement of 12 February 2014; Language of the case: EN**

**KEYWORDS:** Conceptual dissimilarity, Dissimilarity of signs, Enhanced distinctiveness, Identity of the goods and services, International registration, Likelihood of confusion, Phonetic similarity, Principle of legal certainty, Relative grounds, Reputation, Visual dissimilarity

**RESULT:** Action dismissed

**FACTS:** The applicant sought to register a word sign CALDEA for goods and services in Classes 3, 35 and 44. The opponent opposed the trade mark application on grounds of likelihood of confusion with an earlier international trade

mark registration **BALEA** for goods in Classes 3, 5 and 8. The Opposition Division rejected the opposition. The Board of Appeal (BoA) dismissed the opponent's appeal, finding that the signs are overall dissimilar and no likelihood of confusion (LoC) is possible, even for identical goods in Class 3 and even if the earlier mark enjoyed reputation. In its decision, the Board made reference to a previous case between the same parties, where the Court had ruled out LoC between the same earlier mark **BALEA** and a Community figurative mark, which included the word "*caldea*". Before the General Court (GC), the opponent questioned the above findings of the BoA and also claimed that the reference made to the previous judgement is irrelevant, because the opposed sign in that case was figurative.

**SUBSTANCE:** The GC ruled on the relevance of the previous judgement, finding that it was applicable, because it had considered the similarity between the word elements, which are identical to the ones in the present case (Para. 20). The identification of the relevant public as the public at large was not disputed by the opponent. The Board's assessment relating to the comparison of the goods and services was not reviewed by the Court after the opponent withdrew its claim in this regard at the hearing. The GC confirmed the findings of the BoA as to the lack of visual similarity, making reference to the previous judgement, where it was noted that the differences between the signs are more easily grasped by the average consumer when they consist of limited number of letters, as in the case at hand (Para. 34). The findings of the Board as regards the low level of phonetic similarity were also upheld. In its reasoning the Court again made reference to the previous judgement, where it was found that the presence, in the signs, of letters belonging to the group of plosive consonants was not sufficient to make those signs similar, when the rest of the elements gave rise to distinct phonetic differences (Para. 40). The Court further confirmed that conceptually the signs are not similar. When assessing the overall impression, the GC confirmed the previous judgment's finding that the visual perception has more weight in view of the goods and the way they are usually purchased, compared to the phonetic similarity, which, in the case at hand, is even low (Para. 46). Consequently, the findings of the Board as regards the overall dissimilarity of the signs were confirmed. As one of the conditions for the establishment of LoC was not met, i.e. the similarity of the signs, the BoA was correct in finding no LoC, even if the goods and services were identical or similar and the earlier mark had acquired enhanced distinctiveness (Para. 54).

**Case T-380/12; Demon International LC v OHIM; Judgment of 13/02/14; Language of the case: IT**

**KEYWORDS:** Complementary goods and services, Complex mark, Conceptual similarity, Dominant element, Figurative element, International registration, Likelihood of confusion, Phonetic similarity, Relative grounds, Similarity of the goods and services, Similarity of the signs, Visual similarity, Weak element

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

**FACTS:** An application for invalidity of the CTM, registered for goods in Class 9 including "sunglasses; sports glasses; safety goggles; protective masks for sporting activities, except those adapted for a specific sport; ski masks; snowboard goggles" was filed on the basis of an earlier international word mark, registered, among other goods, for "snowboards" in Class 28. The Cancellation Division (CD) declared invalid the CTM for "sports glasses; safety goggles; protective masks for sporting activities, except those adapted for a specific sport; ski masks; snowboard goggles." The Board of Appeal annulled the CD's decision since it found no risk of confusion between the marks at hand. The cancellation applicant filed an action before the General Court (GC).

Registered CTM	Earlier Mark
	<p data-bbox="715 1742 815 1771"><b>DEMON</b></p>

**SUBSTANCE:** The General Court annulled the Board's decision to the extent that it excluded a likelihood of confusion in relation to the contested "ski masks; snowboard goggles". The GC found that these goods are similar to an average degree to "snowboards" and not to a low degree only as stated in the contested decision. In particular, they are complementary because the contested goods are important for the use of the goods covered by the earlier mark. In order

to find a complementarity between goods, it is not needed that the use of some goods is essential for the use of others. The GC confirmed that the signs are conceptually and phonetically identical but that they are visually similar to a high (not average) degree. To reach this conclusion, the GC argued that the word element is the dominant one in the visual impression of the contested sign since the figurative element merely represents the concept of the word element.

**Case T 232/12; Agroekola EOOD v OHIM; Judgment of 21 January 2014; Language of the case: EN**

**KEYWORDS: Admissibility, Fee, New evidence, Principle of legal certainty, Principle of legitimate expectations, Principle of non-discrimination, Relative grounds, Time limit**

**RESULT: Action dismissed**

**FACTS:** The applicant sought to register the word sign '**ULTRA CHOCO**'. An opposition was filed based on the earlier Singaporean word mark '**ultra choco**' based on Article 8(3) CTMR as well as on the unregistered mark '**ULTRA CHOCO**' based on Article 8(4) CTMR. The Opposition Division rejected the opposition. In its appeal, the opponent failed to prove that payment of the appeal fee had been transferred in time. The Board of Appeal (BoA) found that the fee had been paid on the 11<sup>th</sup> and not on the 10<sup>th</sup> of January 2012, which was the deadline. In accordance with Article 60 CTMR, the appeal was deemed not to have been filed. Relying on an alleged infringement of Article 60 CTMR, the opponent requested the General Court (GC) to order the BoA to accept the appeal and follow normal procedure.

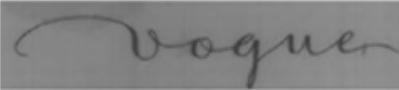
**SUBSTANCE:** New evidence proving that the bank transfer order was given on 10 January 2012 was presented before the GC. The evidence was inadmissible as it was not submitted to the BoA for examination and no explanation was given to why the information was not presented during the administrative procedure (Paras. 20-23). The opponent argued that the BoA should have assessed the documents at its disposal and deduced that the transfer order must have been given at least one day earlier than the transfer of the fee. It is however, up to the opponent to prove such orders are given before the deadline and not for the Office to make presumptions based on average transaction times. The opponent should have presented his transfer order to the Office (Paras. 25, 29-32). This approach promotes legal certainty and avoids discrimination as the same methods of calculating time-limits can be applied irrespective of the party's residence or nationality (Paras. 33-34). As to the argument that the Office had initially confirmed the regularity of the payment of the fees, the CG concludes that this does not breach the principle of the protection of legitimate expectations since the Office had not confirmed that the payment of the appeal fee had been made within the prescribed period, but merely acknowledged receipt of the opponent's observations and of the transfer order dated after the deadline (Paras 37-38).

**Case T-509/12; Advance Magazine Publishers & Nanso Group Oy v OHIM; Judgment of 27 February 2014; Language of the case: EN**

**KEYWORDS: Likelihood of confusion, Phonetic similarity, Principle of legality, Proof of use, Relative grounds, Similarity of the goods and services, Similarity of the signs, Visual similarity**

**RESULT: Action dismissed**

**FACTS:** The applicant sought to register the verbal signs represented below as a CTM for Class 25 (Clothing; footwear; headgear; parts and fittings for all the aforesaid goods). An opposition based on several Swedish and Finish earlier marks, registered for goods in Class 25 was filed on the grounds of Articles 8(1)(b) CTMR. The opposition was directed against all goods in Class 25 of the CTM. It was request that the opponent furnished proof of use for the two Swedish earlier marks. The Opposition Division upheld the opposition refusing registration of the mark applied for in relation to all the goods concerned. The Board of Appeal confirmed the decision of the OD and rejected the applicant's appeal in its entirety. It found that the Opposition Division had correctly upheld the opposition since a likelihood of confusion could not be excluded due to the identity or similarity of the goods covered by the mark applied for, namely, *clothing, footwear and headgear*, and of those protected by the earlier Swedish word mark VOGUE - the use of which it considered had been sufficiently proved but only for hosiery - and the average similarity of the signs at issue.

CTMA	Earlier Swedish and Finnish marks
TEEN VOGUE.	VOGUE  VO Gue.

**SUBSTANCE:** The GC took note of the fact that the applicant does not challenge the findings of the Board of Appeal concerning the definition of the relevant public, composed of the general public in Sweden (Para. 25). On the comparison of signs, the General Court held that the Board of Appeal was correct to conclude that the signs are visually similar to an average degree, due to the presence of the element 'vogue', common to those signs. Contrary to what was claimed by the applicant, the General Court found that the presence of the element 'teen' in the mark applied for undoubtedly contributes to differentiating the two marks at issue phonetically, nevertheless, it cannot be accepted that the element 'teen', in view of its shortness, outweighs, in that respect, the element 'vogue', common to both signs. Therefore, a certain phonetic similarity can be found between the two signs taken as a whole (Para. 43). In relation to the conceptual comparison, the General Court held that it was for the Board of Appeal to ascertain whether the general public in Sweden, many of whom speak English, was able to discern the meaning of those two elements, which it did not do. The arguments provided by the Office in its response cannot compensate for the Board of Appeal's lack of analysis concerning the Swedish general public's knowledge of the English language. For the General Court it is necessary to verify whether that incomplete examination by the Board of Appeal, which does not amount to a failure to provide reasons because it clearly stated the grounds on which it found that it was not possible to compare the signs conceptually, but to a partially erroneous assessment of the relevant public's abilities, affects the legality of the contested decision (Para. 44). For the part of that general public which has a command of the English language, the word 'vogue' would be understood as a word relating to fashion, the word 'teen' clearly indicating adolescents the expression 'teen vogue' would be perceived as a mere variation of 'vogue', since the concept of 'what is fashionable for adolescents' naturally comes from 'what is fashionable'. That clear conceptual similarity could therefore only bear out the Board of Appeal's conclusion in relation to, first, the similarity of the signs at issue and, next, the likelihood of confusion. As a result, that error regarding the knowledge of the relevant public does not affect the legality of the contested decision, it being borne in mind that, for the relevant non-English-speaking public, the Board of Appeal's conclusion regarding the lack of influence of the conceptual comparison on the assessment of the similarity of the signs remains true (Para. 45). On the comparison of products, the General Court held that notwithstanding the fact that "hosiery, footwear and items of headgear" are comprised of different textiles and materials and that they are sometimes sold in different retail outlets, the Board of Appeal was correct to find that they are similar within the meaning of Article 8(1)(b) CTMR (Para. 34). In relation to "hosiery and clothing", the General Court held (para. 26) that hosiery, consisted of clothing and was therefore identical to 'clothing' covered by the mark applied for. Finally, in the global assessment of the likelihood of confusion, the General Court concluded that in the light of the visual and phonetic similarities of the signs at issue and having regard to the fact that the goods designated by the earlier Swedish word mark VOGUE, on the one hand, and the mark applied for, on the other, are in part identical and in part similar, the Board of Appeal did not make an error of assessment in finding that there was a likelihood of confusion between those marks and, thus, it did not err in confirming the Opposition Division's decision refusing registration of the mark applied for as regards 'clothing; footwear; headgear; parts and fittings for all the aforesaid goods' in Class 25 (Para. 49).

Case T-229/12; Advance Magazine Publishers & Eduardo Lopez Cabré v OHIM; Judgment of 27 February 2014; Language of the case: EN

**KEYWORDS:** Likelihood of confusion, Phonetic similarity, Principle of legality, Proof of use, Relative grounds, Similarity of the goods and services, Similarity of the signs, Visual similarity

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

**FACTS:** The applicant sought to register the figurative sign represented below as a CTM for Class 18. An opposition based on a CTM and the earlier Spanish marks below, registered for goods in Class 18, was filed on the grounds of Articles 8(1)(b) CTMR. The opposition was directed against all goods in Class 18 of the CTM. The Opposition Division upheld the opposition in part, refusing registration of the mark applied for in relation to the goods ‘umbrellas, parasols, accessories’ in Class 18, on the ground that there was, in relation to those goods, a likelihood of confusion with the earlier CTM VOGUE. It rejected the opposition for the remaining goods. The Board of Appeal confirmed the decision of the OD and rejected the opponent’s appeal in its entirety.

CTMA	Earlier CTM and Spanish Mark
	<p data-bbox="676 741 775 768"><b>VOGUE</b></p> 

**SUBSTANCE:** The GC took note of the fact that the opponent does not challenge the findings of the Board of Appeal concerning the definition of the relevant public, composed of the average consumer of the goods at issue in the European Union. The average consumer must be deemed to be reasonably well informed and reasonably observant and circumspect (Para. 27). On the comparison of signs, the General Court held that, notwithstanding the specific presentation of the word in the mark applied for, the signs at issue are visually highly similar (Para. 45) and that the Board of Appeal was correct to conclude that the signs are phonetically identical (Para. 46). On the comparison of products, the finding of the Board was correct when it held that umbrellas, in Class 18, protected by the earlier Community word mark VOGUE, and the umbrellas, parasols and accessories covered by the mark applied for are ‘identical or similar’. There is no doubt that the goods at issue are identical as regards umbrellas (Para. 28). In relation to umbrellas protected by the earlier CTM and the parasols, the General Court held, contrary to the Board, that although umbrellas and parasols function according to the same type of mechanism, their end-users are not the same and the distribution channels frequently differ. The Board of Appeal was, entitled to find that umbrellas and parasols are similar but should have emphasised the low degree of that similarity, which it did not (Para. 32). On the comparison between umbrellas and accessories, the General Court concluded that accessories was not precise enough in the sense of judgment IP TRANSLATOR in case C- 307/10. The General Court added that it was not open to the Board of Appeal to allow the opposition, as regards accessories, only for ‘accessories for umbrellas’. The Board of Appeal was also incorrect, at paragraph 24 of the contested decision, despite having based its analysis on only the earlier CTMk VOGUE, to remark that the goods listed in the two Spanish marks did not cover a broader spectrum and did not therefore alter the scope of its assessment. That statement has no factual basis: it is clear that those marks were filed for “all kinds of umbrellas, sunshades, handles, ribs and canes for these’, in contrast to the earlier CTM VOGUE which was registered only for ‘umbrella” (Para. 41). Concluding on the comparison of goods, the General Court held that the goods are either identical (umbrellas) or have a low degree of similarity (parasols and umbrellas) or were not sufficiently identifiable (accessories) for the Board of Appeal to be able actually to assess their degree of similarity with the goods protected by the earlier CTM VOGUE, namely, umbrellas (Para. 42). On the assessment that the mark applied for has a distinctive character, the General Court held that the repute of a sign can be taken into consideration only if it has been invoked in support of the scope of protection of the earlier trade mark (Para. 50). Finally, in the global assessment of the likelihood of confusion, the Board of Appeal did not infringe Article 8(1)(b) CTMR as regards, first, umbrellas and, second, parasols. However, the

Board of Appeal was wrong to consider that there was a likelihood of confusion between the mark applied for and the earlier CTM VOGUE as regards accessories. For the purposes of applying Article 8(1)(b), a likelihood of confusion presupposes both that the marks at issue are identical or similar and that the goods or services which they cover are identical or similar. Consequently, the similarity or identical nature of the signs cannot offset the lack of any assessment of the similarity of the goods, namely, accessories and umbrellas, since it had not been sufficiently defined what was meant by 'accessories', for example by seeking to restrict the application for a CTM.

**Case T-25/13; Mäurer & Wirtz GmbH & Co. KG v OHIM; Judgment of 27 February 2014; Language of the case: DE**

**KEYWORDS:** Beginning of mark, Conceptual similarity, Distinctive element, 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 word mark "4711 Aqua Mirabilis" as a CTM for goods in Class 3. The opponent lodged an opposition against the application on the basis of its registered CTM "AQUA ADMIRABILIS" (word) for goods in Class 3. The Opposition Division upheld the opposition partly in respect of the goods "soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices" covered by the CTMA on the basis of Article 8(1) (b) CTMR. The appeal filed by the applicant was dismissed.

**SUBSTANCE:** The General Court (GC) confirmed the reasoning of the Board of Appeal as to the existence of a likelihood of confusion between the marks in at least a part of the EU. The goods in Class 3 are directed to the general public. The degree of attention is normal. The goods covered by the marks are identical or similar (Para. 17). The conflicting signs are visually and phonetically similar due to the highly similar word elements "AQUA MIRABILIS" and "AQUA ADMIRABILIS". The additional element "4711" is not sufficient to render the signs overall different despite its position at the beginning of the contested CTMA (Para. 27). Conceptually, the signs are similar for those consumers who understand the meaning of the Latin terms "aqua" and "admirabilis"/"mirabilis". On the other hand, the conceptual comparison is neutral for those customers in the EU who do not understand the words (Para. 31). The argument of the applicant that the earlier mark enjoyed only a low degree of inherent distinctiveness does not necessarily exclude a risk of confusion between the marks. The distinctiveness of the earlier mark is only one of various factors to be considered when assessing a likelihood of confusion. Even in cases where the distinctiveness of the earlier mark is low, a likelihood of confusion may exist due to the similarity between the marks and the goods or services (Para. 38). In view of the visual and phonetic similarity between the signs and the identity or similarity of the goods at issue, there is a likelihood of confusion between the marks within the meaning of Article 8(1) (b) CTMR (Para. 39).

**Case T-602/11 Pêra-Grave S.A.U. v. OHIM; Judgment of 27 February 2014; language of the case: EN**

**KEYWORDS:** Admissibility of defence, Conceptual similarity, Distinctive element, Enhanced distinctiveness, Figurative element, First time on appeal, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Weak element

**RESULT:** Action dismissed

**FACTS:** The applicant sought to register the figurative mark reproduced below for alcoholic beverages (except beers) in Class 33. The opponent opposed the registration on the basis of the three Portuguese figurative marks reproduced below, which cover wines or alcoholic beverages (except beers) in Class 33. Grounds: Article 8(1) (b) and 8(5) CTMR. OD dismissed the opposition and found that reputation of the earlier marks had not been substantiated, as the evidence had been submitted late. On appeal, the Board upheld the opposition pursuant to Article 8(1) (b) and rejected the CTM application for all the goods covered. Before the General Court, the applicant alleges an infringement of Article 8(1) (b) CTMR.

CTMA	Earlier marks: PT
	

**SUBSTANCE:** The Court examined LoC with the third earlier mark, which *prima facie* has the greatest similarity with the CTM applied for. The relevant public is the average Portuguese consumer of the relevant goods in Class 33. The goods are identical. The GC confirmed a low degree of phonetic similarity and some conceptual overlap, as well as a very low degree of visual similarity. Notwithstanding the differences due to the figurative elements and other word elements, PÉRA-MANCA or PERAMANCA is the most distinctive element in the overall impression of the signs. Besides, the figurative elements and the mention ‘Qta’ allude to the goods covered and have a weak distinctive character (Paras. 36-37). It is not inconceivable that certain elements (i.e. PERAMANCA) of a meaningful sequence of words (‘Qta S. José de Peramanca’) will attract more attention than the others (Para. 47). The allegedly enhanced distinctive character of the term QUINTA was not submitted to the BoA; therefore it is inadmissible before the GC. The GC points out an inconsistency in the applicant’s arguments. It submitted that PERAMANCA refers to a Portuguese region well-known for the quality of the wine produced there, but it also stated that such word is devoid of any meaning, contrary to Article 21 Statute of CJ and 44(1) Rules of Procedure (Para. 52). Consumers usually describe and recognise wine and alcoholic beverages by reference to the word element which identifies them. These goods are also sold in cafés, bars and restaurants, where the consumer’s choice is made through a menu, on which only the word element of the marks is reproduced. LoC is thus increased because the differences deriving from the presence of figurative elements cannot help the consumer to distinguish between those marks (Para. 58). In view of the identity of the goods, the very low degree of visual similarity and low degree of phonetic similarity, Loc cannot be ruled out.

**Case T-225/12; Judgment of 27<sup>th</sup> February 2014, Lidl Stiftung & Co. KG vs OHIM; Language of the case: EN**

**KEYWORDS:** Beginning of mark, Distinctive element, Dominant element, Figurative element, Identity of the goods and services, Invoice, Likelihood of confusion, Nature of use, Principle of legal certainty, Principle of legality, Proof of use, Relative grounds, Similarity of the signs, Visual similarity

**RESULT:** Action dismissed

**FACTS:** The applicant sought to register the figurative mark represented below as CTM for “musical instruments” in Class 15 (among other goods). An opposition was filed on the grounds of Article 8(1) (b) CTMR. It was based on the earlier Czech figurative mark registered for “musical instruments” in Class 15. The Opposition Division upheld the opposition for all the contested goods. The OD deemed that genuine use was proven for “flutes” and “harmonicas” in Class 15 and that there was a likelihood of confusion between the marks at issue. The Board of Appeal confirmed the decision. In particular, the Board considered that, even if the earlier mark was used in a different form than it was registered, the distinctive character was not altered according to Article 15(1) (a) CTMR. The applicant filed an action before the General Court arguing, in particular, an infringement of Articles 42(2)(3) in combination with 15(1)(a) and 8(1) (b) CTMR.

CTMA	Earlier Cz mark and the way it is used
	

**SUBSTANCE:** The General Court dismissed the appeal. In relation to Articles 42(2)(3) CTMR, the GC argued that the invoices and photographs, considered together, showed genuine use of the earlier mark for musical instruments. Since these goods are not everyday consumer goods, there is no need to show evidence of large-scale commercial use. In relation to Article 15(1)(a) CTMR, the GC upheld OHIM's argument that the figurative elements of the earlier mark, as registered, are limited to the stylistic presentation of the two word elements. Those decorative elements do not play any significant role in the overall impression of the sign and have no inherent semantic content of their own which would lend the mark distinctive character or designate the goods concerned. Therefore, the GC concluded that the form in which the mark was used did not alter the distinctive character of the registered mark (Paras. 52, 53). The GC further added that this conclusion is not undermined by the fact that, in two decisions between the same parties, the OD held that genuine use had not been established by the opponent regarding musical instruments. The GC noted that the lawfulness of the decisions of the Board must be assessed solely on the basis of the regulation, as interpreted by the European Union judicature and not on the basis of a previous decision-making practice. OHIM must however take into account the decisions already taken in respect of similar cases and consider with especial care whether it should decide in the same way or not. The way in which the principles of equal treatment and sound administration are applied must be consistent with respect for legality. To this respect, the GC argued that, since the evidence provided by the opponent was not the same as in the present case, the principle of equal treatment was not infringed (Paras. 54-57). In relation to Article 8(1)(b) CTMR, the GC confirmed that, under the case law, the attention of the relevant public at the time of purchasing musical instruments must be taken to be higher than usual (Para. 67). The GC further argued that, the elements 'music' in the earlier mark and 'express' in the contested one have only a weak distinctive character, since they simply designated the purpose or use of the goods on the one hand, and speed on the other. The common element "lidl" is highly distinctive since it bears no reference to the goods at hand and it is placed at the beginning of the signs. The figurative elements of the mark applied for and of the earlier mark will be perceived as decorative components. Therefore, the signs are visually similar. From an aural point of view, the marks are similar in so far as their distinctive element is the same. As regards the conceptual comparison, a comparison could not be made, since the word 'lidl' had no meaning for a Czech-speaking consumer. The meaning of the elements 'music' and 'express' is not of great relevance since consumers will not pay much attention to them (Paras. 74-81). Therefore, since the goods are identical and the marks are similar, the Board of Appeal was entitled to conclude that there was a likelihood of confusion.

**Case T-226/12; Judgment of 27<sup>th</sup> February 2014, Lidl Stiftung & Co. KG vs OHIM, Language of the case: EN**

**KEYWORDS:** Beginning of mark, Distinctive element, Dominant element, Figurative element, Identity of the goods and services, Invoice, Likelihood of confusion, Nature of use, Principle of legal certainty, Principle of legality, Proof of use, Relative grounds, Similarity of the signs, Visual similarity

**RESULT:** Action dismissed

**FACTS:** The applicant sought to register the figurative mark represented below as CTM for "musical instruments" in Class 15 (among other goods). An opposition was filed on the grounds of Article 8(1) (b) CTMR. It was based on the earlier Czech figurative mark registered for "musical instruments" in Class 15. The Opposition Division upheld the opposition for all the contested goods. The OD deemed that genuine use was proven for "flutes" and "harmonicas" in Class 15 and that

there was a likelihood of confusion between the marks at issue. The Board of Appeal confirmed the decision of. In particular, the Board considered that, even if the earlier mark was used in a different form than as it was registered, the distinctive character was not altered according to Article 15(1) (a) CTMR. The applicant filed an action before the General Court arguing, in particular, an infringement of Articles 42(2)(3) in combination with 15(1)(a) and 8(1) (b) CTMR.

CTMA	Earlier Cz marks and the way it is used
	

**SUBSTANCE:** The General Court dismissed the appeal. In relation to Articles 42(2)(3) CTMR, the GC argued that the invoices and photographs, considered together, showed genuine use of the earlier mark for musical instruments. Since these goods are not everyday consumer goods, there is no need to show evidence of large-scale commercial use. In relation to Article 15(1)(a) CTMR, the GC upheld OHIM's argument that the figurative elements of the earlier mark, as registered, are limited to the stylistic presentation of the two word elements. Those decorative elements do not play any significant role in the overall impression of the sign and have no inherent semantic content of their own which would lend the mark distinctive character or designate the goods concerned. Therefore, the GC concluded that the form in which the mark was used did not alter the distinctive character of the registered mark (Paras. 52, 53). The GC further added that this conclusion is not undermined by the fact that, in two decisions between the same parties, the OD held that genuine use had not been established by the opponent regarding musical instruments. The GC noted that the lawfulness of the decisions of the Board must be assessed solely on the basis of the regulation, as interpreted by the European Union judicature and not on the basis of a previous decision-making practice. OHIM must however take into account the decisions already taken in respect of similar cases and consider with especial care whether it should decide in the same way or not. The way in which the principles of equal treatment and sound administration are applied must be consistent with respect for legality. To this respect, the GC argued that, since the evidence provided by the opponent was not the same as in the present case, the principle of equal treatment was not infringed (Paras. 54-57). In relation to Article 8(1)(b) CTMR, the GC confirmed that, under the case law, the attention of the relevant public at the time of purchasing musical instruments must be taken to be higher than usual (Para. 67). The GC further argued that, the elements 'music' in the earlier mark and 'express' in the contested one have only a weak distinctive character, since they simply designated the purpose or use of the goods on the one hand, and speed on the other. The common element "lidl" is highly distinctive since it bears no reference to the goods at hand and it is placed at the beginning of the signs. The figurative elements of the mark applied for and of the earlier mark will be perceived as decorative components. Therefore, the signs are visually similar. From an aural point of view, the marks are similar in so far as their distinctive element is the same. As regards the conceptual comparison, a comparison could not be made, since the word 'lidl' had no meaning for a Czech-speaking consumer. The meaning of the elements 'music' and 'express' is not of great relevance since consumers will not pay much attention to them (Paras. 74-81). Therefore, since the goods are identical and the marks are similar, the Board of Appeal was entitled to conclude that there was a likelihood of confusion.

**Case T-520/11 Genebre S.A. v. OHIM; Judgment of 28 February 2014; Language of the case: ES**

**KEYWORDS:** Admissibility of defence, Figurative element, Identity of the goods and services, Likelihood of confusion, New evidence, Phonetic identity, Relative grounds, Similarity of the goods and services, Similarity of the signs, Visual similarity

**RESULT:** Action dismissed

**FACTS:** The applicant sought to register the figurative mark reproduced below for goods in Classes 6, 7, 9, 11 and 17. The opponent opposed the registration on the basis of the UK and CTM word and figurative marks reproduced below, which cover inter alia goods in Classes 6, 7, 9, 11 and 17. The grounds were those laid down in Article 8(1) (b) and 8(5) CTMR. The Opposition Division dismissed the opposition. On appeal, the Board of Appeal (BoA) upheld the opposition on the basis of the UK word mark GE and rejected the CTM application for all the goods covered. Before the General Court,

the applicant alleges an infringement of Article 8(1) (b) CTMR.

CTMA	Earlier marks: UK, CTM
	

**SUBSTANCE:** The relevant public is the average UK consumer of goods in Classes 6, 7, 9, 11 and 17, whose level of attention varies between average and high. The goods are identical or similar. The GC dismissed the applicant's claim that the earlier mark will be perceived as a fancy figurative element rather than as a stylised representation of the letters GE. It also confirmed the BoA finding of an average degree of visual similarity between the signs. Taking into account that the products are identical and that the signs are aurally identical and visually similar to an average degree, there is a likelihood of confusion even for the public whose level of attention is higher.

**Case T-71/13 Judgment of 6<sup>th</sup> March 2014, ANNAPURNA SpA / Anapurna GmbH: Language of procedure: EN**

**KEYWORDS:** Dilution of distinctiveness, Extent of use, Invoice, Labels, Nature of use, Proof of use, Revocation grounds

**RESULT:** Action dismissed

**FACTS:** The CTM owner was granted registration of the word mark **ANNAPURNA** for goods in Classes 3, 18, 24 and 25. The cancellation applicant submitted an application for revocation of the mark under Article 51(1) (a) CTMR. The Cancellation Division declared the mark to be revoked for part of the goods in Classes 3, 18, and 24. It maintained the validity of the registration in respect of the remaining goods in Classes 3, 18, and 24 and of all the goods in Class 25. The Board of Appeal partially upheld the appeal filed by the cancellation applicant. However, it maintained the registration of the mark at issue in relation to the following goods: – Class 18: 'Bags'; – Class 24: 'Bed covers and bed linen'; – Class 25: 'Clothing, slippers and headgear'. The cancellation applicant filed an action before the General Court arguing an infringement of 51(1) (a) CTMR to the extent that the use of the mark was not demonstrated in relation to the above mentioned goods. The cancellation applicant argued, in particular, that the Board: 1) failed to analyse specifically the evidence 2) failed both to identify the place and duration of the use 3) failed to check whether the mark was affixed to that evidence 4) failed in excluding any alteration of the distinctive character of the registered mark in relation to the signs 5+1\_ANNAPURNA and ANNAPURNAPULSE shown in the evidence.

**SUBSTANCE:** The General Court dismissed the appeal. In relation to the first point, the GC argued that an individual assessment of each item of evidence is not necessary since genuine use must be assessed globally. The GC confirmed the finding of the contested decision that the various items of evidence submitted (invoices, newspaper and magazine clippings, photographs, labels and packaging), taken as a whole, demonstrate the use of the mark in the European Union (Paras. 34-36). In particular, as far as the nature of the use is concerned, the GC stated that, according to the case law, a connection between the use of the mark at issue and the goods concerned can be established without it being necessary for the mark to be affixed on the goods (Para. 48). In this regard, the GC noted that the mark is affixed, in large letters and at the top of each of the invoices. Therefore, the invoices establish a clearly visible connection between the mark and the goods mentioned on the invoices (Para. 48). Furthermore, although the probative value of an item of evidence is not in itself decisive, it may nevertheless be taken into account in the overall assessment as to whether the use is genuine. That is also the case, for example, where that evidence corroborates the other relevant factors of the present case (Para. 45). As far as the claim of alteration of the distinctive character is concerned, the GC argued that the majority of the evidence represents the mark at issue in its registered form. Therefore, it is not necessary to assess if 5+1\_ANNAPURNA and ANNAPURNAPULSE are or not consistent with the mark as registered. The GC rejected the argument of the applicant that the Board extended the protection of the mark at issue to 'bed linen', for which the mark was not registered.

It pointed out that, since 'bed linen' can be considered to be part of a larger category of 'household linen', which is a category of goods in relation to which the mark was registered, the Board did not extend the protection of the mark beyond the list of registered goods (Para. 55). The GC finally found that the Board had correctly applied the Aladin case law in finding that the use shown for various single items of clothes would establish use for all the category of clothes (Paras. 61-68).

### New Decisions from the Boards of Appeal

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

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

#### Decision of the Second Board of Appeal of 13 February 2014 in case R 1260/2013-2 (EN)

*Opposition proceedings – Article 75 CTMR and Rule 51(b) CTMIR – procedural issues – substantial procedural violation (fraudem legis) – Article 42(2) (3) CTMR and Rule 22(2) CTMIR – proof of use*

The CTM applicant sought to register the trade mark 'KABELPLUS' for services in Class 38.

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

The Opposition Division denied the applicant's request for proof of use of the opponents' marks pursuant to Article 42(2) and 42(3) CTMR, on the grounds that they had been registered for less than five years, preceding the publication of the challenged CTM application.

In the statement of grounds, the applicant argued that the opponent must furnish proof of use, even though the marks had been registered for less than five years before the publication of the challenged application, since the opposing marks are identical re-filings of still earlier marks that are liable to the request for proof of use (R 1785/2008-4, 'PATHFINDER'). It alleged that a French trade mark was clearly filed with the purpose of artificially extending the grace period for use of earlier CTM.

The Board pointed out that, according to the Advocate-General Ruíz-Jarabo (preliminary ruling of 2 July 2002, C-40/01, 'Ajax/Ansul', para. 42), to register a trade mark and then to periodically register an identical mark can serve to improperly and fraudulently extend the five-year grace period indefinitely to evade the legal obligation of genuine use and the corresponding sanctions, which are to be applied in their full effectiveness required by the equal and uniform application of Union law. Consequently, these re-filings are made in *fraudem legis* (in fraud of the law), but they cannot be invoked to evade the corresponding sanctions according to the general principle of Union law by which fraud of law and abuse of rights are prohibited. Individuals must not improperly or fraudulently take advantage of Union law, that cannot cover abusive practices (see judgments of 5 of July 2007, C-321/05, 'Kofoed', para. 38; and the case-law cited), carried out under the formal observance of the Union or national rules (in this case, rules governing the filing of trade marks) but infringing or circumventing actually a serious legislative purpose such as that pursued by the provisions imposing the obligation of genuine use of the trade marks, the full effectiveness of which cannot be avoided. There is no legitimate reason to allow the extension of this grace period for the sole reason that the same mark now appears on a national or Union register under a different registration number ('see decision R 1785/2008-4 PATHFINDER', para. 20).

The Board recalled that EU legislators have not anticipated any renewal of the five-year grace period. On the contrary, a proper literal interpretation of the term 'the earlier (Community or national) mark' employed in Article 42(2) and (3) CTMR, must be adopted. In other words, an 'earlier mark' need not necessarily be understood as a mark bearing this or that particular registration number, but as the same mark (in the sense of the representation of the mark under Article 26 CTMR) 'for the same goods and services' and, of course, 'in the same territory' (see decision R 1785/2008-4 'PATHFINDER' para. 21).

The Board notes that the contested decision breached Article 75 CTMR, since it was taken precipitately without granting the applicant the opportunity to submit observations on its reasoning

Consequently, the Board annulled the contested decision and remitted the case to the Opposition Division for the opponents to file proof of use of the marks deemed identical re-filings.

### Decision of the Second Board of Appeal of 28 January 2014 in case R 254/2013-2 (EN)

*Opposition proceedings – Article 8(1)(b) and 8(5) CTMR – reputation*

The CTM applicant sought to register the mark  for goods and services in Classes 9, 35, 36, 38, 41, 42 and 45.

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

The Opposition Division partially upheld the opposition. It found that the opponent's 'FACEBOOK' trade mark enjoys reputation for social networking-related services in Classes 38, 41, 42 and 45.

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

The Board confirmed that the goods and services applied for in Classes 9, 35, 36, 41, 42 and 45 are so far removed from the opponent's reputed social networking-related services that the use of the CTM applied for in relation to these contested goods and services is highly unlikely to bring the earlier marks to the mind of the relevant public.

The Board found the opponent's claims based on the applicant's declared intentions, its political connotations or other similar factors unconvincing as to how these factors would influence the relevant consumer that it would perceive a connection between the marks when the CTM applied for is used on completely distinct goods and services.

With reference to the opponent's argument that the mark applied for may be exploited outside its natural market sector (due to its attractiveness by way of licensing and merchandising), the Board pointed out that none of the goods or services for which the ground under Article 8(5) CTMR did not succeed would be the object of licensing and merchandising from social network sites' trade marks owners.

Consequently, the appeal was dismissed.

### Decision of the Second Board of Appeal of 29 January 2014 in case R 676/2013-2 (EN)

*Absolute grounds for refusal - Article 7(1)(b) (c) and 7(2) CTMR — distinctiveness – descriptiveness*

The IR holder designated the European Union to claim protection for its international trade mark registration of **LEVEL (3)** for services in Classes 35, 37, 38 and 42.

The examiner rejected the IR under Article 7(1)(b) and (c) CTMR and reasoned that the expression 'LEVEL (3)', taken as a whole, immediately informs the relevant public, who is made up of professionals, that the services applied for are volume 3 or are related to it .

The Board considered that no professional would understand 'level 3' as indicating a measurement of 'volume'. This is because, in relation to the 'level in a circuit', the numeral '3' shorn of any reference to value units. Further, the Board agreed with the IR holder that none of the services applied for nor any of their essential characteristics, could ordinarily be described as 'volume 3'. The use of the word combination 'LEVEL (3)', even by the relevant public, in relation to the services at issue would be somewhat alien and strange. The Board pointed out that, in the sector which is relevant in this case, the relationship between the expression 'LEVEL (3)' and the services in question is, at most, only of an indirect, allusive nature. Moreover, the Board noted considerable significance to the similar registrations mentioned by the IR holder since they concern identical or highly similar services.

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

**Decision of the Grand Board of Appeal of 7 January 2014 in case R 1006/2012-G (ES)**

*Cancellation proceedings – Article 53(1)(a) CTMR – Article 8(1)(b) CTMR and 8(5) CTMR – comparison between ‘transportation of goods’ and ‘goods’ – Grand Board decision*



The CTM proprietor registered the trade mark  for goods and services in Classes 16, 35 and 39.

The cancellation applicant filed a request for a declaration of invalidity against the contested CTM in its entirety, on the basis that it is confusingly similar to the cancellation applicant's earlier rights, namely, earlier Spanish trade marks



, registered for goods in Class 30 and services in Class 42, according to Article 8(1)(b) CTMR, in conjunction with Article 53(1)(a) CTMR. Furthermore, it claimed Article 8(5) CTMR.

The Cancellation Division declared the challenged CTM invalid in respect of all similar services, namely those in Class 35, however, it refused the application for a declaration of invalidity as it found the remaining goods in Class 16 and services in Class 39 dissimilar. The Cancellation Division dismissed the ground of invalidity based on Article 8(5) CTMR since no evidence had been provided of the reputation of the earlier trade mark, i.e. the degree of recognition thereof on the part of the public.

The cancellation applicant argued that the use of the Community trade mark in relation to the goods in Class 16 and the services in Class 39 gives rise to a likelihood of confusion with its trade marks registered in Spain for the goods ‘pastry and confectionery and ices’ (Class 30) and the services ‘restaurants, confectionery shops and ice cream parlours’ (Class 42).

The Grand Board did not find any similarity between the contested goods in Class 16 and the earlier marks’ goods and services in Classes 30 and 42 respectively, in terms of nature, application and method of use. It reasoned that the mere fact that paper may be used in restaurants, for example for printing menus, making napkins and writing out bills does not render the ‘paper’ in Class 16 similar to the services offered by a restaurant. With reference to the challenged services in Class 39, the Grand Board found these services of a professional nature, carried out on behalf of others, offered by an undertaking to third parties – generally other undertakings. Furthermore, the transport of goods is performed on behalf of a third party; it is a professional activity which is subject to regulations and requires an official licence to be granted. Thus, there is no similarity between ‘transportation of goods’ and ‘goods’, even where the ‘goods’ in question are identical. Otherwise, the service of transport would always be similar to all the goods in the Nice Classification. It would consequently be sufficient for a trade mark to be registered in respect of transport services in order for it to be protected under all of the goods classes.

The Board rejected the ground for invalidity based on Article 8(5) CTMR as unfounded, in the absence of any evidence.

Consequently, the appeal was dismissed.