



OHIM Administrative Board and Budget Committee meetings

The Administrative Board and Budget Committee members, together with Commission representatives, as well as observers from WIPO, EPO, Croatia, the Benelux Office for Intellectual Property (BOIP) and several users associations attended the sessions of the Administrative Board, Budget Committee and a Joint meeting.

On the first day, the selection of the future President and the selection and appointment of Members of the Office's Boards of Appeal were discussed at the Administrative Board meeting

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In this month's interview, James Nurton speaks to Fabrizio Jacobacci of Jacobacci Avvocati in Turin about IP litigation in Italy, the proposed EU trade mark reforms and how to tackle counterfeiting.

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Editorial Team:

Etienne Sanz de Acedo, Mark Kennedy, Mikael Wesslegard

Contributors to this edition: *James Nurton, Alexandra Poch, María Gallar Ruiz, Knowledge Circles Coordination Team.*

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The Administrative Board and Budget Committee members, together with Commission representatives, as well as observers from WIPO, EPO, Croatia, the Benelux Office for Intellectual Property (BOIP) and several users associations attended the sessions of the Administrative Board, Budget Committee and a Joint meeting.

On the first day, the selection of the future President and the selection and appointment of Members of the Office's Boards of Appeal were discussed at the Administrative Board meeting.

The common practice on the acceptability for classification of the Nice class headings terms was endorsed at this meeting. The work on this common practice was initiated last year in June as a result of the IP translator judgement which made it necessary for all National Offices, BOIP and OHIM to review their practice. This big achievement is another important move to a harmonised classification practice.

The powers of the Administrative Board are defined in Section 3, Articles 126 to 129 of the Regulation on the Community trade mark.

At the joint Administrative Board and Budget Committee meeting of 22 May, the 2012 Annual Report was presented and an Overview of the Office's activities and its progress since the last meeting was also given. Other topics under discussion were the recent staff surveys and the new legislative proposals at EU level.

On the third day of activity, the Budget Committee of OHIM met and discussed the discharge of the year 2011. The budgetary results for the year 2012 were presented, along with an overview of the first quarter of 2013. An outlook on the estimated expenditure for 2014 was also on the agenda.

Interview



The James Nurton Interview

In this month's interview, James Nurton speaks to Fabrizio Jacobacci of Jacobacci Avvocati in Turin about IP litigation in Italy, the proposed EU trade mark reforms and how to tackle counterfeiting.

How did you get in to IP work?

My background is that of a lawyer – I went to law school in Italy and became interested in general commercial litigation. I then travelled outside of Italy and worked for the German firm Pünder, which later became Clifford Chance, in Frankfurt, and at Linklaters in London. This was where I became interested in IP.

What happened then?

For three generations my family had run an IP firm, specialising in patent filing, but I didn't really want to do that. I was working in a commercial litigation firm in Italy and after about two years I was offered the chance to join my family's firm and work in IP full-time. The structure of the firm was changing and it was an opportunity to be one of the managers.

This was in 1992 and we started the litigation practice as a separate legal entity, as was required under Italian law. About three-and-a-half years later I was joined by some other lawyers and we set up a partnership doing IP litigation.

We now have 12 partners and 40 associates, which is a nice size for an IP firm.

What kind of work do you do?

My practice covers the whole spectrum of IP litigation. Trade marks are still a good portion of my practice. We don't do any patent and trade mark office work in the firm, only litigation and some transactional work.

We still have a personal connection with the IP firm, which is called Jacobacci & Partners. Each firm has a separate structure, but we share some facilities. We do team up with them sometimes on patent litigation cases, but not exclusively.

Are there a lot of trade mark cases in Italy?

There is a substantial amount of litigation. About 600 patent cases are filed every year, and probably 10 times that number of trade mark cases. But the total number of IP decisions is probably about 250 to 300 so you can see that about 90% of cases are settled at different stages.

There used to be 12 courts hearing IP cases. Now that has been increased to 20, which I think is an error. The courts are also hearing other matters, and that's not been a welcome change. I think the aim should be to decrease the number of courts: there are about six that do 95% of the work.

Do you also do work on a European level?

We don't do trade mark filing but we do act for clients where they have complex litigation and we've had a few cases go to the General Court of the CJEU in Luxembourg. Occasionally we have had cases at the OHIM Boards of Appeal.

The General Court has not been a totally satisfactory experience. There are some good judges there but their origin is not good for the court as they are not IP specialists. However, there are some chambers that are doing most of the trade mark and design cases who are now becoming specialised.

I don't think the answer is to add a further instance. There are already four instances, if you count examination, Board of Appeal, General Court and Court of Justice, including three instances where they look at the facts. Is that really necessary? I think we need just one court deciding appeals from OHIM, or alternatively one dedicated chamber of the General Court.

What do you think of the EU trade mark system in general?

Overall it's been a thoroughly good thing. I don't think anyone can complain about OHIM. It's been a tremendous advantage for brand owners and I don't think anyone would want to go back to the old days before the CTM.

But of course there is always room for improvement. It seems like we are on the verge of substantial reform with many changes ahead. I'm not sure all of these are welcome.

One of the proposed changes will make it impossible to register descriptive terms in foreign languages. But which foreign languages will be considered? There are tens of thousands of languages spoken in the world, with many thousands just in Papua New Guinea.

The impact of this might be that if I want to challenge a mark I might try to find any descriptive meaning in any existing language, even those with a different alphabet or based on characters. There is a risk that I will transliterate to suit my own purpose.

This will add a layer of uncertainty to the system and it's not particularly smart. I'm sure they didn't have in mind a language spoken by a single tribe in Siberia, but how many speakers does a language need to be considered? The examiner needs to have a look and the application should be open to challenge, if the language is spoken by a group in the Community. But it is ridiculous to require this to be considered in examination.

There are other things in the proposals that I am not sure about yet, such as the change to the own-name defence. It's proposed that this only apply to personal names, not company names. I'm not sure why that is – I don't see why you would want to restrict that.

But I can also see the benefits of many of the changes proposed, as it will make the system more harmonised and predictable. Today you can exploit the differences between national offices.

Will the reforms lead to many changes in Italy?

We introduced an opposition system similar to the OHIM procedure a few years ago. It works fairly well, and there have been a few decisions so far. The office is very receptive to comments and suggestions from private practitioners, and they try to make it simple. But invalidation is only available as a judicial procedure.

Are there any interesting recent or pending cases in Italy?

There was a recent case between Gucci and Guess concerning the scope of protection for a one-letter trade mark and secondary meaning, but it has not been published yet. I understand it raises some interesting points.

In Turin, there have been some important improvements in the court system and the time taken to try cases has substantially decreased. It now takes less than two years, compared to three to four years before. The changes were

initiated by the President of the court, Mr Barbuto, who as it happens is an IP specialist. He said that, while judges must be independent, if a decision takes longer than two years they must explain why and also how they propose to remedy it.

What is the most interesting case you have worked on?

We have just started working on a case in the court in Florence, where we are acting for Inditex against Ferragamo. Ferragamo obtained a device mark in Italy and as a CTM for the clasp they use on their bags. We think that's a functional shape and have started a revocation case.

What do you think the future holds for IP?

There is constant change in IP, and I think there are some vital challenges in copyright and patents, which are quite serious. But in the short-term I don't see substantial changes affecting the way trade mark owners obtain and enforce their rights.

For trade mark owners, the biggest challenges are the internet and the spread of counterfeits sold online. That requires a complete revision of your enforcement strategy. You can't expect to seize thousands of goods at Customs now; production and distribution are so spread out and there are many different routes that counterfeits travel.

That means the bigger challenge is to convey the message to consumers: it's not just about respecting the law; counterfeiting is a major problem that impacts on companies, trade, employment and taxation. And the finance behind counterfeiting comes from the black market and organised crime.

So it is important to convey a cultural message besides just trying to stop counterfeits. You have to invest in educating consumers.

Community Trade Mark

CTM

Common Communication on the Implementation of IP Translator

Following the publication of the IP Translator judgment in June 2012, OHIM and the National IP offices of the EU have been discussing the interpretation of the Nice class headings in various meetings.

As a first result of those discussions, the National Offices and OHIM have recently published on their respective websites a Common Communication on the interpretation of the IP Translator judgment.

This Communication shows how each Trade Mark Office interprets the scope of protection of their national trade marks and of Community Trademarks containing all general indications of one or more classes, filed before and after the judgment, with the details displayed using an overview composed of six annexes.

At the same time, the Knowledge Circle G&S has included this approach in its Manual concerning Opposition, Part 2, Identity and Likelihood of Confusion, Chapter 2: comparison of goods and services.

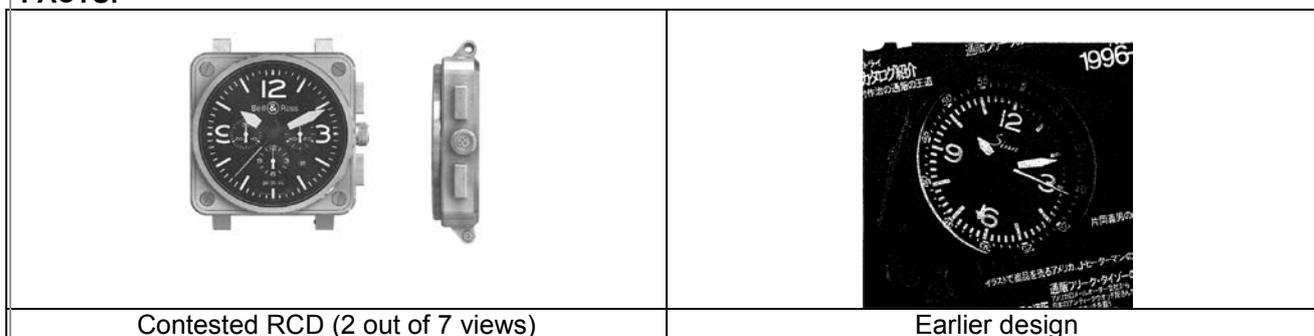
This change to the Manual has been made following a fast-track procedure, which is an exceptional procedure in order to have the newly adopted practice reflected immediately for our examiners and users.

Further revision of the Manual for adoption into Guidelines will follow the complete cycle of consultation rounds.

Knowledge Circle Goods & Services

Case T-80/10; Bell & Ross BV / OHIM; Judgment of 25 April 2013

The General Court confirms that individual character does not necessarily result from the transposition of an existing shape used in a specific field (e.g. a cockpit clock) to a RCD which is intended to be used in a different field (e.g. a wrist watch).

FACTS:

The request for a declaration of invalidity was based *inter alia* on the disclosure in Japan of a cockpit clock. Both the Invalidation Division and the Board of Appeal considered that the contested RCD lacked individual character, under Article 6 CDR. The Board of Appeal had also dismissed belatedly filed evidence, under Article 63(2) CDR. The evidence consisted, among others, of additional (profile and perspective) views of the earlier design in support of the claim that the overall impressions produced by the RCD and the earlier design are different when compared globally.

SUBSTANCE:

On the violation of Article 91(2) CDR (specific rules on related actions)

The Applicant before the General Court (RCD holder) had launched a court action in France against an alleged infringer (the Intervener before the General Court). The Intervener filed a counterclaim alleging that the earlier RCD was devoid of individual character.

The Applicant claimed that both the Invalidation Division and the Board of Appeal violated Article 91(2) CDR by failing to suspend the proceedings until the French court adopts a final ruling on the counterclaim.

The General Court confirms that the Board of Appeal was right not to suspend the proceedings in view of the fact that the French court had decided to stay such proceedings pending the decision to be taken by the Invalidation Division (para. 52-53).

On the violation of Articles 57 and 63 CDR and Article 6 ECHR

The Applicant claimed that the Board of Appeal was wrong to dismiss the additional evidence submitted for the first time on appeal.

The General Court notes that the Board of Appeal justified the dismissal of *some* of the evidence by the fact that the Applicant failed to give any reason as to why it could not have submitted at an earlier stage, and held that the additional evidence was in any event irrelevant. However, as regards the additional views of the earlier design, the General Court found that the Board of Appeal considered such evidence to be relevant and therefore admissible (para. 80).

The Applicant also complained that the representation of the earlier design had not been communicated by the Invalidation Division and that the Board of Appeal failed to sanction the violation of its right to be heard.

The General Court notes that the Appeal before it cannot be directed against the decision taken by the Invalidation Decision (para. 85). In any event, the Applicant's claim must be dismissed because, at least in the course of the appeal phase, the Board of Appeal had communicated the representation of the earlier design. Given the functional continuity between OHIM's first and second instance bodies, the fact that the Applicant was not in possession of such representation during

the first instance proceedings does not impact on the legality of the Board's decision (para. 88-90). The General Court goes on to suggest that the error committed by the Invalidity Division was in any event covered by the fact that the representation of the earlier design was communicated to the Applicant in the context of the procedure pending before the French court (para. 91).

On the violation of Article 6 CDR

On the definition of the informed user, the General Court observes that the informed user is the user of wrist watches and corrects the Board's finding that this user was all the more attentive given the price of the Applicant's products. The General Court notes that the price of the product in which a design is incorporated only depends on factors which are extraneous to the design itself and which depend ultimately on the Applicant's marketing strategy (para. 107-108). All in all the informed user's degree of attentiveness is relatively, though not particularly, high (para. 110).

On the assessment of the degree of freedom of the designer, the General Court considers that it was not proven that aeronautic watches would form a self-contained category of watches being subject to specific constraints compared to other watches (para. 118-119). This is further supported by proof on file that even aeronautic watches can have very different shapes (para. 120). Neither the price range of the product in which the design is incorporated nor the perception of the user affects the degree of freedom of the designer (para. 121 & 123). As a result, the General Court confirms that the degree of freedom of the design is quasi-unlimited in the field of watches (para. 125).

On the comparison of the designs, the Board of Appeal had found that both designs had a number of common features that is, a square frame with rounded angles equipped with screws, with a round black face which levels each side of the frame. The Applicant claimed that the Board of Appeal had failed to compare the RCD with the earlier design in all perspectives. Additional views submitted by the Applicant (in particular the view in profile) showed that the proportions and thickness of the products were different.

The General Court found in substance that the Board of Appeal was correct to find that, in spite of differences of proportions, the RCD left the impression of being a transposition of the earlier design to the size of a wrist.

The difference in the thickness has only a 'weak influence on the overall impression' given that a cockpit clock is designed to be inserted in the aircraft's dashboard, with the result that the profile view is mostly invisible during normal use thereof (para. 132-135). Likewise, the thickness of a wrist watch determines only to a marginal extent the impression left by this watch (para. 136). The General Court concludes that the elements which determine to a greater extent the impression left by a design for a watch are the features visible in the view from above that is, the face of the watch (para. 137). The Board of Appeal was therefore correct to give prevailing importance to such features and to give only secondary importance to the profile views of the compared designs (para. 138-139).

The General Court states that the process of creation, the commercial success and the degree of market recognition of the design among the public are irrelevant when comparing designs (para. 145-146).

The General Court concludes that the differences between the designs affects features having only secondary importance, such as the thickness of the watch and the lower part of the frame etc. (para. 150-151). Other elements of differentiation (such as buttons and the number of digits) are considered minor details on account of their small size compared to that of the frame of the clock/watch (para. 155 & 157). The RCD therefore lacks individual character.

Knowledge Circle Designs

Harmonisation milestone for BOIP and SKIPO

The CP1 harmonisation of Classification of G&S Project reached another important milestone by adding the Benelux Office for Intellectual Property (BOIP) and the Industrial Property Office of the Slovak Republic (SKIPO) to the list of harmonised Offices.

The technical implementation into TMclass will take place within the next few months.

Malta joins Seniority

Malta has become the 14th EU National Office to implement the Seniority Project.

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

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

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

Observatory stakeholders meeting

The European Observatory on the Infringements of Intellectual Property Rights held a private stakeholder meeting in Brussels on 29 April.

Information was provided on the initiatives undertaken to set up the Observatory operations and the on-going work in projects.

The agenda also included an introduction of the Advisory Board and an explanation of its role.

Further discussions centred on the scope and status of the two databases being developed to support right holders and enforcement authorities in the fight against counterfeiting and piracy.

Representatives were then invited to raise proposals for the next multiannual work plan for the Observatory.

President Campinos visits Slovakia

The President of OHIM, António Campinos, met the Slovakian Prime Minister, Robert Fico, the Minister of Economy Tomáš Malatinský and other representatives of government, industry and academia earlier this month to discuss how to further strengthen the intellectual property system to promote growth and innovation in Europe.

Mr Campinos stressed the vital role played by trademarks and designs in protecting European innovation and creativity, and the importance of developing business-centred systems to further enable users to avail of intellectual property protection.

The meetings were also attended by EPO President Benoît Battistelli, who spoke about the importance of patents to European competitiveness.

Mr Campinos joined the President of the Slovakian IPO, L'uboš Knoth, EPO President Benoît Battistelli, and Michal Švantner from WIPO at an event to mark the 20th anniversary of the Slovak IP Office, which took place in the City Hall in Banská Bystrica.

Mr Campinos said: "The Slovakian IP Office is an important partner in the European Trade Mark and Design Network, a very active office within the Cooperation Fund, and the input and expertise of their staff is vital in helping us develop our Cooperation Fund and Convergence Programme projects. They have been underpinning growth and innovation in Slovakia for twenty years now through their work, and I wish them all the best on this landmark anniversary".

L'uboš Knoth, President of the Slovak Industrial Property Office said: 'We are aware that besides good awareness raising, Slovakia needs to see examples of real success stories of individuals and companies in the IP field in order to support the importance of innovativeness for well-being as well as for business. That is why our office launched a new IP understanding concept last year for all school levels so that future generations are "IP literate and IP ready" when it comes to their business orientation and all-round innovation exploitation.'

Slovakia is a pilot office for OHIM's e-services project, which has been developed by the Cooperation Fund, and Slovakian experts take part in a wide range of working groups within projects under the European Trade Mark and Design Network. The Slovak IPO is also represented in the public sector stakeholder group of the EU Observatory on Infringements of Intellectual Property Rights, a part of OHIM since June 5 2012.

More News



KIPO joins TMclass

The Korean Intellectual Property Office (KIPO) has become the latest office to join TMclass.

TMclass is an online tool based on the Nice Classification system that helps users correctly classify goods and services when filing a trade mark. As well as KIPO's database, it also offers access to the databases of EU national IP offices and other major IP offices, including the United States Patent and Trade mark Office (USPTO), the Japan Patent Office (JPO) and the Swiss Federal Institute of Intellectual Property (IPI).

It allows users to search for terms in any of the 25 languages available – 22 EU languages, plus Croatian, as well as Japanese and Korean.

TMclass can also be used to verify lists of terms to check if they are acceptable to any of the participating IP offices. Additionally, the tool translates equivalent goods and services terms into all available languages.

TMclass is available for free, online to all users at <http://tmclass.tmdn.org/>

Morocco to join TMview

This month, an OHIM Delegation visited the Moroccan Industrial Property Office (OMPIC) in Casablanca to discuss their forth-coming integration into TMview and to prepare for the visit of Director General El Maliki on 21 June at OHIM when a Memorandum of Understanding will be signed.

One significant outcome of this visit was the decision to go live with OMPIC's data this summer.

OHIM at INTA

A delegation from OHIM, led by President Campinos, attended the INTA Annual Meeting in Dallas, USA, earlier this month.

OHIM's specially designed booth was extremely busy during the conference, with delegates trying out a range of IT tools, including TMview (which contains nearly ten million trade marks), TMclass, Taxonomy, Similarity and the Common Gateway. The tools were displayed on interactive contact points at the OHIM stand.

OHIM's Information Meeting, on May 5, attracted over a hundred delegates to hear updates on the Office's work and progress.

OHIM, along with colleagues from the German, UK and Bulgarian national IP offices, was representing the European Trade Mark and Design Network at INTA.

OHIM-ROSPATENT meeting

OHIM and ROSPATENT delegations, headed by OHIM President António Campinos and ROSPATENT Director General Boris Simonov, met in Barcelona on Monday 29 April.

OHIM and ROSPATENT collaborate through a Memorandum of Understanding between both offices, and through the framework of the "Modernisation of the IP System in the Russian Federation" (P4M-IP) Project. OHIM carries out activities under this project on behalf of the European Commission.

Mr. Campinos and Mr. Simonov highlighted the excellent relations that exist between both offices, and the progress of projects which will benefit business and IP users in general. One of the main points of attention was to increase efforts in accelerating the completion of a feasibility study due this month, focused on the integration of Russia into TMview before the end of 2013.

Other highlights of this meeting include the definition of the next steps to achieve integration of ROSPATENT into TMclass by July 2013 and the conclusion of technical arrangements, in terms of language and human resources, needed to facilitate work in the framework of the P4M-IP programme.

On April 30, both offices participated in a jointly organised "Trade Mark and Design Protection in the Russian Federation, and Related Issues" seminar.

Speakers from Russia's main IP institutions, OHIM and representatives of European business exchanged views on the practice and rules applicable to trade marks and designs, when seeking IP protection in the Russian Federation.

Publications of OHIM Decisions

OHIM will publish all non-confidential administrative decisions of the President taken on, or after, 15 May this year. Previously, such decisions were only published in exceptional cases.

In addition to these future Decisions, all past Decisions taken since the commencement of the Presidency of António Campinos on 1 October 2010 will also be published.

Signature of Cooperation and Bilateral Agreements with the Croatian office

On 21 May, alongside the ABBC meeting and as part of the preparatory work of the coming accession of the Republic of Croatia to the European Union, the President of OHIM and the Director General of the State Intellectual Property Office of the Republic of Croatia (SIPO), Ms Ljiljana Kuterovac, signed agreements which provide the basis for their full involvement in the financial and technical framework of the Cooperation Fund, Convergence Programme and CTM and RCD dissemination activities.

The Cooperation Agreement and the Bilateral Agreement on promotion and information services on CTM and RCD will come into force on 1 July, the day of accession of the Republic of Croatia. The same day, we expect that the Croatian trade mark data will be available in TMview, thanks to the great work of the IT experts from SIPO.

TM Seminar in Greece

The Piraeus Bar Association hosted a trade mark seminar in Greece on 13 May.

OHIM representatives in attendance discussed matters relating to the Community trade mark system, specifically its similarities to the Greek TM system and on the existing complementarity and coexistence between both.

The event took place within the framework of a bilateral agreement signed between OHIM and the Greek TM Office.

Pool of experts call for interest

OHIM is compiling a pool of experts to assist the EU Observatory, Academy and International Cooperation and Legal affairs Department, to carry out a range of reviews, studies, research and projects.

A call for interest has been published, aimed at individual experts in IP and IP enforcement.

On the basis of the responses received, a first pool will be created to last up to 31 December 2015.

The call for interest has been published at <http://oami.europa.eu/ows/rw/pages/OBS/callForExpressionOfInterest.en.do>

Monthly statistical highlights* April 2013 compared to April 2012

	2013	2012
Community trade mark applications received	9 377	8 216
Community trade mark applications published	9 330	7 544
Community trade marks registered (certificates issued)	8 206	7 490
Registered Community designs received	7 501	7 227
Registered Community designs published	8 036	6 484

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

Case law



Luxembourg Case Law

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

Case T-283/11; *Fon Wireless Ltd v OHIM*; Judgments of 29 January 2013; Language of the case: DE

Keywords: New grounds, new evidence, first time on appeal, claim for alteration of OHIM decision, identity of the goods and services, similarity of the goods and services, similarity of the signs, visual similarity, phonetic similarity, conceptual similarity, weak element, descriptive element

RESULT: Decision of the Board of Appeal altered in the way that the appeal is dismissed

FACTS: The CTM applicant sought to register the word mark 'nfon' as a CTM for goods within Classes 9 and 18. It was rejected upon opposition on the basis of an earlier Community and UK mark, shown below, protected for goods and services in Classes 9, 38, 42. The Board of Appeal annulled the decision of the Opposition Division and rejected the opposition. The Board excluded likelihood of confusion even for identical goods on the basis of the limited distinctive character of the earlier marks. It reasoned that 'fon' is a common misspelling or a reference to the word 'PHONE' whilst all the protected goods are phones or parts of it and the services are related thereto. The conflicting TM's coincide only in relation to this weak element. This can only lead to a remote visual and phonetic similarity. Conceptually, the marks are not similar. The opponent filed an action before the General Court based on Articles 8(1)(b) CTMR and 8(5) CTMR. It complained that the Board did not take into consideration the reputation of the earlier marks and filed documents to prove it.

CTM applied for	Earlier Marks
nfon	 (CTM) FON (UK)

SUBSTANCE: The Court (1) found the action based on Article 8(5) CTMR inadmissible, (2) refused to take into consideration the documents provided for the first time in the Court proceedings and (3) found Boards analysis on Article 8(1)(b) CTM erroneous, confirming likelihood of confusion. (1) On the admissibility of the 8(5) CTM claim raised for the first time in the Court proceedings: The Court recalled that the opposition was based only on Article 8(1)(b) and that Article 8(5) was not invoked before the Board either. The applicant to the Court does not have the power to alter the terms of the dispute as delimited in the respective claims and allegations it and the party opposing the trade mark application have submitted (Article 65(2) CTMR) (Para. 20). (2) On the documents provided for the first time before the Court: The Court rejected the documents related to the reputation of the earlier marks, which were not presented in the course of the administrative proceedings before OHIM. An action before the Court aims at the review of the legality of the Board's decision (Para. 23). (3) On the likelihood of confusion: The Court found the goods/services similar or identical (Para. 39). It found a high visual and phonetic similarity resulting from the fact that the signs coincide in the letter sequence 'fon' (Para. 52). Within the conceptual comparison, the Court confirmed the reasoning in the Board's decision that the word 'fon' will be understood as a reference /short form of the word 'telephone' throughout the European Union (Paras. 55-57) and found a 'certain degree' of conceptual similarity since the public will perceive the conflicting TMs as referring to 'phones' (Para. 61). In the global assessment, the Court recalled that the closer the products, the bigger the distance between the TMs should be in order to exclude LOC. The conflicting TMs do not keep that distance (Para. 69). This result cannot be called into question on the basis of the limited distinctiveness of the earlier trademarks or the fact that the conflicting trademarks coincide only in the descriptive element 'fon' (Para. 71). The limited distinctiveness of the earlier trademarks cannot exclude LOC (reference to T-134/06 Para. 70), nor will the public overlook that the marks coincide in the element 'fon' as it dominates the global impression of the conflicting signs (Para. 77).

Case T-553/10; Biodes, S.L. v. OHIM; Judgment of 13 March 2013; Language of the case: ES

Keywords: Clarity of party submission, figurative trade mark, similarity of the signs, visual similarity, phonetic similarity, conceptual similarity, ending of mark, identity of the goods and services, similarity of the goods and services

RESULT: Action dismissed

FACTS: The CTM applicant sought to register the figurative mark **FARMASUL**, reproduced below, for goods in Classes 5, 30 and 31. The opponent opposed the registration on the basis of several marks, including the Spanish figurative mark **MANASUL** for products in Classes 5, 30 and 31. The grounds were those laid down in Articles 8(1)(a), 8(1)(b) and 8(5) CTMR. The OD rejected the opposition. On appeal, the Board (R 1034/2009-1) allowed the appeal and upheld the opposition. The Board considered that there was a likelihood of confusion for the products found to be identical or similar. Before the General Court, the applicant claims that Article 8(1)(b) CTMR was incorrectly interpreted and applied.

CTM applied for	Earlier Spanish Mark
FARMASUL	

SUBSTANCE: The GC declares inadmissible the applicant's claim on the comparison of the products, as it lacks clarity. It further confirms the average visual and aural similarity of the signs (Paras. 50 and 54) and the impossibility to compare them conceptually (Para. 58). The GC declares that the evidence filed before OHIM did not prove the higher distinctive character of the earlier mark or that it is well-known. In view of the high similarity between the signs and the identity or similarity of the goods identified, there is likelihood of confusion.

Case T-409/10 and T-410/10; Bottega Veneta International Sàrl v OHIM; Judgment of 22 March 2013; Language of the case: IT

Keywords: Three dimensional mark, graphical representation, filing date, shape of the products, distinctiveness acquired by use, sales figures, press articles, place of use

RESULT: Action dismissed

FACTS: The applicant sought to register the shape of a bag shape as 3D marks for goods in Class 18, namely bags and handbags. The examiner objected that the applied-for trademark was devoid of any distinctive character as it was a mere three-dimensional reproduction of a bag available on the market. Moreover, the shape of the bag was not deemed to be unusual. In its observations, the applicant submitted a new graphic representation of the mark, claiming that the woven pattern that covered the bag contributed to its distinctiveness acquired through use under Article 7(3) CTMR. The examiner rejected the CTMA on the basis of Article 7(1)(b) and (3) CTMR. The Board of Appeal dismissed the appeal. It considered that the CTMA consisted of the overall shape of a bag and was not limited to its woven pattern.

CTM applied for	CTM applied for
	

SUBSTANCE: The applicant raised three pleas in law, namely infringement of Rule 9(3)(a) CTMIR, Article 7(1)(b) and 7(3) CTMR. The GC rejected the applicant's argument that the examiner had made an error in not taking into consideration the woven pattern of the bags' surface. The Court noted that Rule 9(3)(a) CTMIR enables the regularisation of a CTM which has been filed missing the minimum formal requirements for the granting of a filing date (Para. 23). In the present cases, no deficiencies were detected by the examiner (Para. 25). The representation of a mark must enable the sign to be precisely identified (Para. 37). The registration of a sign as a trademark is carried out on the basis and within the limits established by the applicant. In examining whether the CTMA is devoid of distinctive character, the examiner has to rely on the representation of the sign and on its description, if any. The Office cannot take into consideration characteristics of the sign which do not form part of the trademark application (Para. 38). Since the applicant filed no description in support of the marks' representations and it was not apparent from said representations that the trademarks were for a woven pattern rather than for the shapes of a bag as a whole, the Board's decisions were not vitiated by any error in law (Paras 40, 41).

As regards Article 7(1)(b) CTMR, the GC confirmed its settled case-law that the criteria for assessing the distinctive character of 3D marks consisting of the appearance of the product itself are no different from those applicable to other categories of trademarks. It is necessary to determine whether the mark will enable the targeted public to distinguish the goods or services of one undertaking from those of another when making a purchasing choice (Paras. 47 – 50). Extrinsic circumstances, such as the marketing levels and product prices cannot be taken into consideration in the assessment of

the distinctive character (Paras. 56, 57). In the cases at hand, the position of the handles in the one and the shape similar to that of a shopper in the other was deemed to be a mere variant of the traditional one and does not represent a characteristic capable of attributing a level of personalization which would be eye catching and which would attract the attention of the consumers (Paras. 62, 63).

As regards Article 7(3) CTMR, the GC confirmed its settled case-law regarding the test to check whether Article 7(3) CTMR can be applied, i.e., among others, that at least a significant part of the relevant public, thanks to the mark alone, identifies the commercial origin of the goods concerned in the territory where the sign was originally devoid of distinctive character (Paras. 74 – 78). The GC confirmed the assessment of the probative value of the evidence submitted by the applicant to show acquired distinctiveness, namely that it was insufficient. It is not clear whether the sales figures submitted by the applicant relate to the mark as applied for. The magazine excerpts are only in a limited number of EU languages (Para. 101).

Case T-571/10; Fabryka Łożysk Tocznych-Kraśnik S.A. v OHIM; Judgment of 22 March 2013; Language of the case: PL

Keywords: Complex mark, figurative trade mark, distinctive element, abbreviation, coexistence of trademarks, identity of goods and services, similarity of signs, visual similarity, phonetic similarity, specialised public

RESULT: Action dismissed

FACTS: The CTM applicant sought to register a figurative mark **FŁT-1** (represented below) as a CTM for goods in Class 7. The opponent filed an opposition invoking its earlier Community trade mark registration of the figurative mark **FŁT** (represented below). The opponent relied on Article 8(1)(b) CTMR. The Opposition Division partly allowed the opposition considering that there was a likelihood of confusion. The Boards dismissed the applicant's appeal. The applicant appealed to the GC.

CTM applied for	Earlier CTM
	

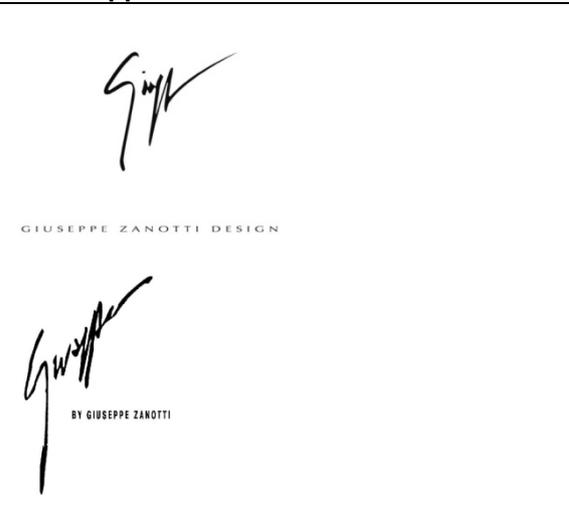
SUBSTANCE: The GC confirmed its jurisprudence in relation to Article 8(1)(b) CTMR. It found the goods at issue identical and directed at professionals in the EU. The marks, despite graphic differences between them, were considered similar as they coincided in the letters F, Ł, and T. The GC emphasized that where a trade mark is composed of verbal and figurative elements, the former are, in principle, more distinctive than the latter, because the average consumer will more readily refer to the goods in question by quoting their name than by describing the figurative element of the trade mark (Para. 34). Therefore, the Board was right to consider that the element FŁT-1 of the mark applied for would be more often used to refer to the mark (Para. 35). As to the applicant's argument that the letters FŁT, forming a part of its company name (acronym of Fabryka Łożysk Tocznych), is highly recognizable, the GC noted that such an argument would be in fact in favour of giving higher protection to the earlier mark. This is because the letters FŁT are protected in the earlier mark and constitute its dominant element. Therefore, by arguing that they are highly distinctive the applicant in fact argues in favour of enhanced distinctive character of the earlier mark whereas it obviously has no interest to do so (Paras. 44-49). Insofar as the applicant claimed that the letters FŁT are associated with the applicant, the claim was not supported by the evidence (Para. 53); it was solely based on the fact that the applicant produces and markets the goods at issue. Similarly, the applicant's argument of co-existence of the conflicting marks has to be rejected as the applicant only refers to the co-existence on the register and does not provide any evidence of peaceful co-existence on the market (Para. 60). There is a likelihood of confusion between the marks.

Cases T-336/11 and T-337/11; Società Italiana Calzature SpA v OHIM; Judgments of 9 April 2013; Language of the cases: IT.

Keywords: Name, figurative trade mark, dominant element, complex mark, visual dissimilarity, phonetic similarity, conceptual similarity, identity of the goods and services, similarity of the goods and services, distinctive element

RESULT: Actions dismissed

FACTS: The applicant sought to register the marks represented below as CTMs for goods within Classes 18 and 25. Two oppositions based (in Case T-336/11) on the two below trademarks, registered in the Community for goods in Class 25 and in Italy for goods in Classes 18 and 25 respectively, and only on the below CTM (in Case T-337/11) were filed on the grounds of Article 8(1)(b) CTMR. The Opposition Division upheld the oppositions partially. The Board of Appeal upheld the applicant's appeals, considering that the signs are visually and phonetically dissimilar, thus offsetting the existing degree of conceptual similarity due to the presence in the signs of the surname Zanotti. Thus, the Board held that one of the basic requirements for a finding of likelihood of confusion had not been met. The opponent filed an action before the GC.

CTMs applied for	Earlier marks
	<p data-bbox="815 842 935 902">ZANOTTI (CTM)</p>  <p data-bbox="815 1084 906 1115">(Italian)</p>

SUBSTANCE: The Court, in Case T-336/11, compared the CTMA and the earlier Italian mark and considered that they are visually dissimilar, given that in the CTMA the signature dominates the overall impression. The element 'ZANOTTI', given its position, is only a marginal element, devoid of any autonomous distinctive role, being placed between the remaining elements 'GIUSEPPE' and 'DESIGN' (Paras. 34-37). As to the phonetic comparison, the GC, while agreeing with the Board that the signature can only be read by referring to the element 'GIUSEPPE' placed in the lower part of the sign, held, contrary to the Board, that the signs have a slight degree of similarity (Paras. 38-40). The Court also found that, in the CTMA, the combination of the elements 'GIUSEPPE ZANOTTI DESIGN' informs the public as to the person responsible for the appearance of the goods and that, therefore, due to the common presence of surname 'ZANOTTI', the signs present a certain degree of conceptual similarity (Paras. 41-42). The signature (regardless of whether it can be read as being the name Giuseppe or not) is the dominant element of the CTMA, and the visual aspect is of particular importance for the marketing of the goods concerned. Given the different visual impression, there is no likelihood of confusion. The Court dismissed the opponent's argument that the surname 'ZANOTTI' is more distinctive than the name Giuseppe, which is widespread in Italy, and, referring to the ECJ's ruling in Becker/Harman International Industries, held that the element 'ZANOTTI' forms part of the verbal expression 'GIUSEPPE ZANOTTI DESIGN', which, as stated above, has a purely informative role and which is clearly secondary in the overall impression caused by the sign (Para. 53). The Court confirmed the findings of the Board also in respect of the earlier CTM, thus considering the signs to be visually dissimilar, a circumstance which offsets the existing phonetic and conceptual similarities (Para. 63). The Court followed the same reasoning and came to the same findings in Case T-337/11.

Case T-505/10; Höganäs AB, v. OHIM; Judgment of 10 April 2013; Language of the case: EN

Keywords: Clarity of party submission, specialised public, similarity of the goods and services, similarity of the signs, visual similarity, phonetic similarity, coexistence of trademarks, declaration

RESULT: Action dismissed

FACTS: The applicant sought to register as a CTM the word sign **ASTALOY** for 'iron-based metal powders for industrial use' in Class 6. An opposition was filed on the basis of the earlier CTM **HASTELLOY** covering goods in Class 6. The grounds were those laid down in Article 8(1)(b) CTMR. The OD upheld the opposition and rejected the application for a CTM. On appeal, the Board dismissed the appeal. It found that the goods were similar, that the signs were visually similar to a medium degree and phonetically similar to a high degree and that the coexistence of the marks at issue had not been established. Before the General Court, the applicant claimed that the Board of Appeal had infringed Articles 9 and 8(1)(b) of the CTMR.

SUBSTANCE : The GC declares inadmissible the applicant's claim based on Article 9 CTMR, as the applicant did not explain how that provision might have been infringed by the BoA. The BoA did not err in holding that the signs are visually similar to a medium degree. The GC also confirmed the finding of phonetic similarity. With regard to the alleged coexistence of the signs in the market, the GC notes that the presence and use of a mark in a particular market can be adduced by other evidence besides sales information (Para. 55), like technical and scientific articles or extracts of presentations at conferences and exhibitions in which that mark is mentioned (Paras. 56-58). The Court found that the applicant has shown to the requisite legal standard that the CTMA was present in all Member States before the date of the application. However, it failed to adduce conclusive evidence that the consumers of the products covered by each of the marks at issue did not confuse them prior to the filing of the application (Para. 62). Only two affidavits were submitted, one from a former executive of the applicant, the other from a professor and consultant in the relevant field. However, neither of them comes from one of the consumers of the products at issue (Para. 65). The GC confirmed the likelihood of confusion or association, even for a professional public which pays a high degree of attention.

Case T-360/11; Fercal Consultoria e Servicos, Ld, v OHIM; Judgment of 10 April 2013; Language of the case: PT

Keywords: Admissibility, statement of grounds, time limit, fax

RESULT: Action dismissed

FACTS: The applicant sought to register the word mark **PATRIZIA ROCHA** as a CTM for goods within Class 25. The application was opposed to by the opponent citing Article 8(1)(b) CTMR on the basis of a French national mark **ROCHAS**, registered for goods and services in Classes 2,3,14,18,21,25, 26 and 34. The Opposition Division accepted the opposition in its entirety and rejected the CTM application by decision of 27 September 2010, notified to the parties on the same day. The applicant filed an appeal against this decision. By decision dated 8 April 2011, the Board of Appeal declared the appeal inadmissible as the statement of grounds was filed outside the applicable time limit. The applicant filed an action before the General Court.

SUBSTANCE: The Court held that the event that starts the time limit for filing the statement of grounds is, in conformity with Article 60 CTMR, the day of the notification of the Opposition Division's decision, that is to say, 27 September 2010. In application of Rule 70 CTMIR, the time limit started to count the day after the notification and expired on 27 January 2011. It is therefore not correct to argue, as the applicant did, that the time limit expired on 28 January 2011. The fact that the statement of grounds was sent by post on 27 January does not count. The relevant date to be taken into account is the day on which the statement of grounds was received by OHIM, namely 2 February 2011. 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. The argument of the applicant explaining that when it wanted to send the statement of grounds by fax, the fax was not working and therefore it had to send the document by mail was not accepted. As the statement of grounds was received by OHIM after the expiration of the deadline for filing it, it is correct that the Board declared the appeal inadmissible based on Rule 49 (1) CTMIR. The action was dismissed in its entirety.

Case T-294/10 CBp Carbon Industries, Inc., v. OHIM; Judgment of 11 April 2013; Language of the case: EN

Keywords: Characteristics of the goods and services

RESULT: Action dismissed

FACTS: The applicant obtained an International Registration designating the EU in respect of the word sign **CARBON GREEN**. That registration was received at OHIM on 11 September 2008. Registration was sought for 'reclaimed rubber, namely recycled carbonaceous materials, namely, plastic, elastomeric, or rubber filled materials obtained from pyrolyzed tyre char and plastic, elastomeric, or rubber compounds formulated using such filler material' in Class 17. The examiner refused registration pursuant to Article 7(1)(b) and 7(1)(c) CTMR, as the sign conveys clear and obvious information to the consumer concerning the characteristics of the goods covered. On appeal, the Board dismissed the appeal. It found that the individual words CARBON and GREEN, as well as the sign CARBON GREEN as a whole, are descriptive of the relevant goods, i.e. goods manufactured from carbon obtained in an environmentally friendly manner. Before the General Court, the applicant claimed an infringement of Article 7(1)(c) and (b) CTMR.

SUBSTANCE: The GC declares that, although the combination of the words CARBON and GREEN may appear paradoxical, it corresponds precisely to the description of the characteristics of the goods which, although composed of a chemical element associated with detrimental effects on the environment, are developed from reclaimed and recycled materials. The alleged contradiction simply shows the direct and specific relationship between the sign CARBON GREEN and the goods concerned (Para. 27). The GC recalls that it is sufficient that the Board applied the descriptiveness test, as interpreted by case-law, in order to reach a decision. It was not obliged to justify its action by the production of evidence (Para. 39). The GC found that it is reasonable to envisage that the sign CARBON GREEN may, in the future, be associated in the mind of the relevant public with similar goods, so that they may immediately perceive, without further thought, a description of the characteristics of those goods (Para. 45).

Case T-454/11 Luna International Ltd. v. OHIM; Judgment of 19 April 2013; Language of the case: EN

Keywords: Figurative trade mark, proof of use, export document, labels, certificate of chamber of commerce, invoice, time of use

RESULT: Action dismissed

FACTS: The CTM owner was granted registration of the figurative CTM **Al bustan**, reproduced below, for goods in Classes 29 to 32. The invalidity applicant applied for a declaration of invalidity on the basis of the earlier figurative Greek mark **ALBUSTAN**, reproduced below, registered for tomato products in Class 29. The grounds were those in Article 52(1)(a) CTMR in conjunction with Articles 8(1)(a), (b) and 8(5) CTMR. The invalidity applicant was requested to furnish proof of use. The Cancellation Division granted the application for declaration of invalidity in respect of part of the goods covered by the contested CTM. The Board dismissed the CTM owner's appeal and confirmed that the invalidity applicant had proved genuine use. Before the General Court, the CTM owner claimed that the Board wrongly concluded that the invalidity applicant had established genuine use of the earlier trade mark.

Contested CTM	Earlier Greek mark
<p>Al bustan البستان</p>	

SUBSTANCE: The GC declares that, even if the (undated) photographs of tomato cans submitted as evidence of use were taken at a date subsequent to the expiry of the relevant period, they may still be taken into account in order to assess the genuine use of the earlier mark during the relevant period (Para. 46). Furthermore, although the earlier mark is not reproduced in the invoices, they contain, in addition to references to the ALBUSTAN mark, other details which enable the products to be identified in their packaging. Those details are the same as those that appear on the photographs of cans of tomato paste and on the reproduction of the label submitted by the invalidity applicant (Para. 55). With regard to the fact that none of the third party documents submitted confirmed that the product was sold in packaging

bearing the earlier mark during the relevant period, the GC notes that the third parties concerned were not asked to provide the documents in question specifically with a view to proving genuine use. The invalidity applicant chose to submit only documents dating from the relevant period. Such documents have a commercial or administrative purpose and they cannot be expected to reproduce the figurative mark (Paras. 56-57). The contested decision did not base its findings on mere probabilities or suppositions, but cross-checked the various items of evidence submitted, and deduced from that accumulation of items of evidence that there had been genuine use of the earlier mark during the relevant period.

Cases T-537/11; Hultafors Group AB v OHIM; Judgment of 19 April 2013; Language of the case: EN

Keywords: Figurative mark, complex mark, figurative element, dominant element, identity of the goods and services, similarity of the signs, visual similarity, phonetic similarity, conceptual similarity, ending of mark

RESULT: Action dismissed

FACTS: The applicant sought to register the figurative mark **Snickers**, represented below, as a CTM, inter alia, for goods in Class 25. An opposition based on the Italian trademark **KICKERS**, registered for goods in Class 25 and directed against Class 25 of the CTMA, was filed on the grounds of Articles 8(1)(b) and 8(5) CTMR. The Opposition Division upheld the opposition. The Board of Appeal dismissed the applicant's appeal. The applicant filed an action before the General Court.

CTM applied for	Earlier Italian mark
	KICKERS

SUBSTANCE: The relevant public is made up of average consumers with an average level of attention when purchasing those goods (Para. 23). The goods are identical (not disputed) (Para. 28). The word element 'snickers' is the dominant element of the CTMA. The figurative element, given its commonplace form, has a low degree of distinctiveness and will be perceived as a decorative element (Para. 36). The signs present an average degree of visual similarity, having the same number of syllables, their last six letters being identical and the vowels being the same (Paras. 37-38). Although in principle it is the beginning of marks which focuses the attention of the public, still the overall impression caused by the signs must be taken into account. In the present case, the difference between the letters 'sn' and 'k' cannot prevent the signs from being similar, since consonants are involved in both instances and the consumer will not stop at the first letter, but will consider at least the first syllable. The following letter of the respective syllables of the signs at issue is identical. Thus, the differences between the two marks cannot counteract the similarities (Para. 41). As regards the applicant's argument that words ending in 'ickers' are not uncommon in English, and that, therefore, the beginning of the signs is all the more important, the GC held that, although many Italian consumers have a sufficiently good knowledge of English, the fact remains that the ending 'ickers' does not exist in Italian and will appear unusual to the majority of the relevant consumers (Paras. 42-43). The signs are phonetically similar to an average degree, given that they contain the same number of syllables, the first of which are similar because of the presence of the vowel 'i', and the second of which are identical, that they share the same vowel order, that is to say, 'i', then 'e' and that the consonants 'k' and 'sn' are not significant in the overall pronunciation (Para. 44). As to the conceptual aspect, the Court endorses the Board's finding that, for the limited part of the relevant Italian public which understands the word 'kickers', the signs are not conceptually similar, while for the other part of that public the conceptual comparison is not possible (Para. 52). The GC dismissed the applicant's argument concerning the highly distinctive character of the CTMA, since it is not a relevant factor to be taken into account in the assessment of the likelihood of confusion (Para. 55).

Case T-109/11; Apollo Tyres AG / OHIM; Judgment of 23 April 2013; Language of the case: EN

Keywords: New evidence, first time on appeal, identity of the goods and services, similarity of the goods and services, complex mark, distinctive element, dominant element

RESULT: Action dismissed

FACTS: The Opposition Division upheld the opposition in part. It found that there was likelihood of confusion in the non-English speaking parts of the Union. It rejected the CTM application for the goods *'tyres, tubes and flaps for automobiles'* in Class 12 and the following services in Class 35: *'Retail and online retail services connected with tyres, tubes and flaps for automobiles'*. The Board of Appeal annulled this decision in part and refused the CTMA also in respect of *'repair; installation services, fitting services for tyres; repair and replacement for tyres'* in Class 37. The CTM applicant appealed to the GC.

Contested CTMA (Classes 12, 35, 37)	Earlier CTM (Classes 12)
ENDURANCE	 ENDURANCE

SUBSTANCE: Admissibility of evidence: New evidence presented for the first time before the Court is in principle inadmissible. However, the GC has a certain margin of discretion in this respect. In this case, the evidence is inadmissible as it aimed at supporting a claim which was pivotal in the dispute (that is, the understanding of the meaning of the French or English word 'endurance' throughout the Union) and which the applicant could have submitted evidence on at an earlier stage of the proceedings (Paras. 20-21). On Article 8(1)(b) CTMR: The GC confirms that the CTMA's *'tyres, tubes and flaps for automobiles'* in Class 12 are included in the broader category of the earlier mark's *'parts, fittings and accessories for land vehicles'* in Class 12. The latter category is not limited to metallic products (Para. 37) and current use of the opponent in respect of metallic spare parts is irrelevant (Para. 40). To the applicant's argument that the list of goods covered by the earlier mark is vague and imprecise, the GC replies that *'it cannot be considered that the category of goods "parts, fittings and accessories for land vehicles" of the earlier mark, the only one taken into consideration by the Board of Appeal in the context of the assessment of the similarity between the goods at issue, is too vague or imprecise'* (Para. 42). As the earlier mark is a CTM, the relevant public is the European public at large. It is not limited to consumers in France and the English-speaking parts of the Unions, for which the meaning of 'endurance' is clear (Paras. 49-50). This public includes, but is not limited to, consumers having a higher degree of attentiveness (Para. 56). The meaning of the word 'endurance' is likely to be unknown to the public outside the French and English-speaking parts of the Union, given the absence of close equivalents in other languages and the fact that 'endurance' does not belong to the basic English vocabulary (Paras. 66-67). The applicant's analogy with the *Cheapflight* judgment was not accepted because it was not established that 'endurance' was so commonly used that its meaning would be grasped throughout the Union (Paras. 68-69). The word 'endurance' will therefore be perceived as a distinctive word by the public located outside the French and English-speaking parts of the Union. This word element is dominant in the earlier sign (Paras. 70-72). The signs are visually similar (Para. 74) and even more similar aurally (Para. 76), while no conceptual difference can distinguish them (Para. 78). Likelihood of confusion therefore exists, even in the perception of a highly attentive public (Para. 78). The alleged weak distinctive character of the earlier mark does not allow another conclusion, since the mark is registered, it is worth protection (Para. 80).

Case T-284/11 Metropolis Inmobiliarias y Restauraciones, S.L. v. OHIM; Judgment of 25 April 2013; Language of the case: EN

Keywords: New evidence, complementary evidence, clarity of party submission, identity of the goods and services, similarity of the signs, visual similarity, phonetic similarity, conceptual similarity, figurative trade mark, principle of non-discrimination, right to be heard

RESULT: Action dismissed

FACTS: The applicant sought to register the word mark **METROINVEST** for services in Class 36. The opponent opposed the registration on the basis of a German and a Community figurative mark, **METRO**, which both covered services in Class 36. The grounds were those laid down in Article 8(1)(b) CTMR. The OD upheld the opposition. On appeal, the Board dismissed the appeal. Before the General Court, the applicant alleges an infringement of Article 8(1)(b) CTMR, as well as an infringement of Articles 6 and 14 of ECHR.

CTMA	Earlier marks: DE, CTM
METROINVEST	

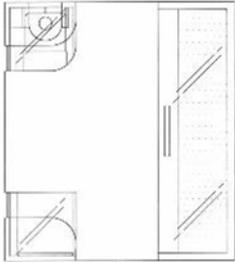
SUBSTANCE : The opponent alleged the inadmissibility of extracts from an on-line dictionary and of a translation of the word 'metro' included in an EN/DE dictionary, which had been lodged by the applicant for the purposes of disputing the Board's claim that the word METRO does not exist in German. The GC declared the documents admissible. Since the assessment that the word METRO does not exist in German appeared for the first time in the contested decision, the applicant cannot be prevented from disputing it (Para. 16) The GC confirms that there is some degree of visual and aural similarity. Contrary to the Board's view, the German public might be able to establish a link between the word METRO and a foreign underground railway system, therefore there is a certain conceptual similarity too (Para. 46). The services are identical. By merely claiming that there is no similarity between the services without putting forward any specific arguments on that point, the applicant has failed to satisfy the requirements of Article 44(1) of the Rules of Procedure. The objection of inadmissibility raised by OHIM against the applicant's complaint alleging lack of similarity between the services was upheld (Para. 34). There is LOC. The GC rejects the alleged infringement of Articles 6 and 14 ECHR (Paras. 61 et seq.)

Case T-55/12; Su-Shan Chen / OHIM; Judgment of 25 April 2013; Language of the case: EN

Keywords: Conflict of design with prior trade mark, similarity of the signs, identity of the goods and services, weak trade mark, likelihood of confusion, shape of design, distinctive element

RESULT: Action dismissed

FACTS: The request for a declaration of invalidity was based on Article 25(1)(e) CDR ('a distinctive sign is used in a subsequent design, and Community law or the law of the Member State governing that sign confers on the right holder of the sign the right to prohibit such use'). Both the Invalidity Division and the Board of Appeal declared the RCD invalid.

Contested RCD (1 out of 7 views)	Earlier CTM (Class 3)
	

SUBSTANCE: On the violation of Article 25(1)(e) CDR (the notion of 'use of a distinctive sign in a subsequent design'): The GC confirms the principle following which the application of Article 25(1)(e) CDR is not limited to cases in which the earlier distinctive sign is reproduced identically in the contested design. It is enough that the dominant features of the earlier sign be discernible in the contested design, in the perception of an average consumer having an imperfect recollection (Paras. 21-22). In this case, both shapes have a compact rectangular body rounded at the edges with a spray device attached on one side and a sponge on the other side. The differences between the shapes affect secondary elements and do not rule out the conclusion that 'the features of the earlier mark [are] discernible in the contested design' (Para. 28).

On the violation of Article 9(1)(b) CTMR (likelihood of confusion): The GC reiterates that a shape such as the contested RCD can be used 'for' or 'in relation to' goods, within the meaning of Article 9(1)(b) CTMR, even if consumers do usually

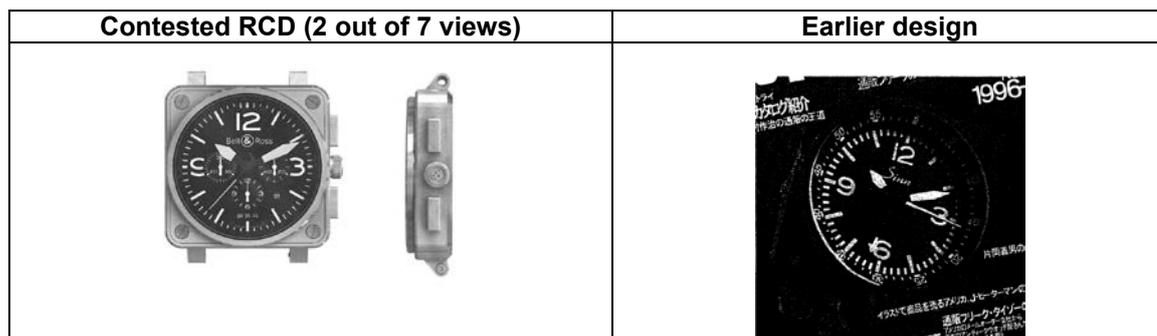
not perceive packaging to be trade marks (Paras. 38-39). In this case, the possibility that the contested RCD is perceived as a distinctive sign is supported by the fact that the shape is 'sufficiently striking' (Para. 40). The goods covered by the earlier mark in Class 3 are identical to those in which the design will be incorporated (Para. 47). Differences affecting secondary elements or word elements which are hardly legible must be ignored (Para. 52). Given the similarity of the signs and the identity of the goods, there is likelihood of confusion, even under the assumption that the earlier mark has only a weak distinctive character (Para. 64). Since the invalidity applicant has the right, under the CTMR, to prohibit the use of the contested RCD, the latter must be declared invalid under Article 25(1)(e) CDR.

Case T-80/10; Bell & Ross BV / OHIM; Judgment of 25 April 2013; Language of the case: FR

Keywords: Suspension of the proceedings, new evidence, right to be heard, principle of functional continuity, no bearing on decision, design: Informed user, freedom of designer, conflict of design with prior design, design: Overall impression, individual character

RESULT: Action dismissed

FACTS: The request for a declaration of invalidity was based, inter alia, on the disclosure in Japan of a cockpit clock. Both the Invalidity Division and the Board of Appeal considered that the contested RCD lacked individual character, under Article 6 CDR. The Board of Appeal had also dismissed belatedly filed evidence, under Article 63(2) CDR. The evidence consisted, among others, of additional (profile and perspective) views of the earlier design in support of the claim that the overall impressions produced by the RCD and the earlier design are different when compared on their whole. The RCD is invalid.



SUBSTANCE: On the violation of Article 91(2) CDR (specific rules on related actions): The RCD holder had launched a court action in France against the invalidity applicant as an alleged infringer. The invalidity applicant filed a counterclaim alleging that the earlier RCD was devoid of individual character. The RCD holder claimed that both the Invalidity Division and the Board of Appeal violated Article 91(2) CDR by failing to suspend the proceedings until the French court adopts a final ruling on the counterclaim. The GC confirms that the Board of Appeal was right not to suspend the proceedings in view of the fact that the French court had decided to stay such proceedings pending the decision to be taken by the Invalidity Division (Paras. 52-53).

On the violation of Articles 57 and 63 CDR and Article 6 ECHR: The RCD holder claimed that the Board of Appeal was wrong to dismiss the additional evidence submitted for the first time on appeal. The GC notes that the Board of Appeal justified the dismissal of *some* of the evidence by the fact that the RCD holder failed to give any reason as to why it could not have submitted at an earlier stage, and held that the additional evidence was in any event irrelevant. However, as regards the additional views of the earlier design, the GC found that the Board of Appeal considered such evidence to be relevant and therefore admissible (Para. 80). The RCD holder also complained that the representation of the earlier design had not been communicated by the Invalidity Division and that the Board of Appeal failed to sanction the violation of its right to be heard. The GC notes that the appeal before it cannot be directed against the decision taken by the Invalidity Decision (Para. 85). In any event, the RCD holder's claim must be dismissed because, at least in the course of the appeal phase, the Board of Appeal had communicated the representation of the earlier design. Given the functional continuity between OHIM's first and second instance bodies, the fact that the RCD holder was not in possession of such representation during the first instance proceedings does not impact on the legality of the Board's decision (Paras. 88-90). The error committed by the Invalidity Division was in any event covered by the fact that the representation of the earlier design was communicated to the RCD holder in the context of the procedure pending before the French court (Para. 91).

On the violation of Article 6 CDR: The informed user is the user of wrist watches. This user is not more attentive due to the price of the RCD holder's products. The price of the product in which a design is incorporated only depends on factors which are extraneous to the design itself and which depend ultimately on the RCD holder's marketing strategy (Paras. 107-108). The informed user's degree of attentiveness is relatively, though not particularly, high (Para. 110). On the assessment of the degree of freedom of the designer, the GC considers that it was not proven that aeronautic watches would form a self-contained category of watches being subject to specific constraints compared to other watches (Paras. 118-119). There is proof on file that even aeronautic watches can have very different shapes (Para. 120). Neither the price range of the product in which the design is incorporated nor the perception of the user affects the degree of freedom of the designer (Paras. 121 - 123). The degree of freedom of the design is quasi-unlimited in the field of watches (Para. 125). On the comparison of the designs, the Board of Appeal had found that both designs had a number of common features. The RCD holder claimed that the Board of Appeal had failed to compare the RCD with the earlier design in all perspectives. Additional views submitted by the Applicant (in particular the view in profile) showed that the proportions and thickness of the products were different. The GC found in substance that the Board of Appeal was correct to find that, in spite of differences of proportions, the RCD left the impression of being a transposition of the earlier design to the size of a wrist. The difference in the thickness has only a 'weak influence on the overall impression' given that a cockpit clock is designed to be inserted in the aircraft's dashboard, with the result that the profile view is mostly invisible during normal use thereof (Paras. 132-135). Likewise, the thickness of a wrist watch determines only to a marginal extent the impression left by this watch (Para. 136). The elements which determine to a greater extent the impression left by a design for a watch are the features visible in the view from above that is, the face of the watch (Para. 137). The Board of Appeal was therefore correct to give prevailing importance to such features and to give only secondary importance to the profile views of the compared designs (Paras. 138-139). The process of creation, the commercial success and the degree of market recognition of the design among the public are irrelevant when comparing designs (Paras. 145-146). The differences between the designs affect features having only secondary importance, such as the thickness of the watch and the lower part of the frame etc. (Paras. 150-151). Other elements of differentiation (such as buttons and the number of digits) are considered minor details on account of their small size compared to the frame of the designs (Paras. 155 - 157). The RCD lacks individual character.

Case T-145/12; Bayerische Motoren Werke AG v. OHIM; Judgment of 25 April 2013; Language of the case: EN

Keywords: Abbreviation, descriptive element, laudatory mark

RESULT: Action dismissed

FACTS: The applicant obtained an International Registration designating the EU in respect of the word sign **ECO PRO**. That registration was received at OHIM on 30 December 2010. Registration was sought for 'electric and electronic apparatus for controlling, indicating, accumulating and regulating, data processing apparatus and computers' in Class 9 and 'motor vehicles and parts thereof included in this class' in Class 12. The examiner refused registration pursuant to Article 7(1)(b) CTMR. On appeal, the Board dismissed the appeal. It found that the sign ECO PRO, considered as a whole, would mean, for the relevant public, 'ecological professional' or 'ecological supporting' and that it was therefore descriptive of goods either environmentally friendly or designed for professional use, the relevant consumer not perceiving it as an indicator of commercial origin.

SUBSTANCE: The GC confirmed the Board's finding about the meanings (from the standpoint of the English-speaking public) of 'eco', a common abbreviation for the word 'ecological' (Para. 25), and 'pro', which would be perceived as meaning 'professional' or 'favourable, positive or supportive' (Para. 27), and held that the lexical structure employed, which consists in placing a laudatory element after a descriptive element, is common in advertising language and in the commercial context at issue (Para. 29). The GC therefore confirmed the Board's finding that ECO PRO would be perceived by the relevant English-speaking public, in the field to which the application for registration relates, as an indication that the designated goods are intended for 'ecological professionals' or are 'ecological supporting' (Para. 31). That public will therefore perceive the semantic content of ECO PRO as providing information on certain characteristics of the goods concerned and not as indicating their origin. Accordingly, the applied for trade mark is necessarily devoid of any distinctive character with regard to those goods, within the meaning of Article 7(1)(b) (Para. 32). The GC stated that a word sign must be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned (it also referred to the Judgment of 29 April 2010 in Case T-586/08 *Kerma v OHIM (BIOPIETRA)*, Para. 35).

New Decisions from the Boards of Appeal

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

Article 8(1)(b) CTMR

Decision of the First Board of Appeal of 3 April 2013 in case R 54/2012-1 (EN)

The applicant sought to register the figurative mark below claiming the colours red, white and blue



for the following goods in Class 29: Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.

The opponent filed a notice of opposition against the contested mark directed against all the goods, on the grounds laid down in Article 8(1)(b) CTMR and based, *inter alia*, on the following earlier right:

International trade mark registration No 731 326 of the figurative mark below with effect in Austria, the Benelux countries, the Czech Republic, Denmark, Estonia, France, Finland, Hungary, Italy, Lithuania, Latvia, Poland, Romania, Slovenia, Slovakia and Spain

**BON
APPETIT**

for the following goods:

Austria, the Benelux countries, the Czech Republic, Denmark, Estonia, Finland, France, Italy, Lithuania, Latvia, Romania, Slovenia and Slovakia
Classes 29, 30 and 31;

Spain
Class 30;

Hungary
Classes 29 and 31;

Poland
Classes 30 and 31.

The applicant requested the opponent to submit proof of use of the earlier mark on which the opposition was based. The opponent submitted documents as evidence of use.

The Opposition Division rejected the opposition in its entirety. It stated that use of the mark was proven in France, Luxembourg and Poland during the relevant period in respect of preserved fish, which is part of the broad category of *fish* covered by the earlier trade mark. Nevertheless, fish is only covered in relation to the territories of France and the Benelux countries, but not Poland. The goods are identical, similar and dissimilar.

Visually, the signs are not similar. Aurally, the marks are identical. 'BON APPETIT' is a French expression which will probably also be understood by the relevant public who does not speak French. 'BON APPETIT' is weak for all the goods at stake, i.e. foodstuffs in Class 29. Consequently, the concepts of the two marks are identical.

The opponent filed a notice of appeal.

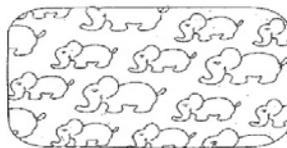
The Board concluded that 'BON APPETIT' will be perceived as a promotional message in relation to 'fish' which is covered by the earlier mark. The same applies to the other goods applied for (meat, poultry and game, etc.). 'BON APPETIT' expresses the wish that the consumer enjoys the food. Therefore, it will not be considered as an indication of origin, as was correctly stated in the contested decision.

Taking this into consideration, in the present case, the distinctive character of the earlier mark, as well as that of the mark applied for, lies in their special scripts and as regards the latter, also in its device elements. Visually, the marks have no similarity whatsoever, apart from the non-distinctive word combination 'BON APPETIT'. Phonetically, the marks do of course have the same pronunciation. However, as the word combination in the marks cannot be expected to be perceived as a trade mark, this is of little importance. Conceptually, the similarity lies in the non-distinctive common word combination 'BON APPETIT'. Little weight can be placed on this similarity as it cannot be expected to be perceived as an indication of origin. It should be noted that in relation to the goods in question it is concluded that the visual impression must be expected to be more important than the phonetic impression as the goods are normally bought in a grocery shop, and picked by the client from the shelf or handed over to the client by a sales person. Therefore, there is no likelihood of confusion.

Article 53(1)(a) CTMR- Article 8(1)(b) CTMR

Decision of the First Board of Appeal of 3 April 2013 in case R 1706/2012-1 (FR)

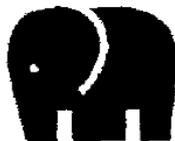
The applicant registered the following figurative mark:



for goods in Classes 24 and 25.

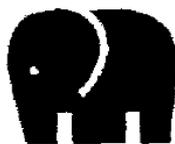
The cancellation applicant filed an invalidity application against the abovementioned registered CTM on the grounds of Article 53(1)(a) CTMR because there is a likelihood of confusion in the sense of Article 8(1)(b) CTMR with the following earlier marks:

- 1) International figurative mark No 715 019



with effect in the Czech Republic and registered for goods in Class 25

- 2) German figurative mark No 30 082 400



registered for goods in Classes 24 and 25.

- 3) German word mark No 1 133 678 **elefanten**, registered for goods in Class 25.

The CTM proprietor requested proof of use of the earlier marks.

The Cancellation Division rejected the invalidity request because there was no likelihood of confusion between the marks in conflict. The goods are identical, similar or dissimilar. The marks are visually totally different since the representation of the elephant is dissimilar in size, position, etc. Aurally the marks are dissimilar given that the figurative marks cannot be pronounced, and conceptually similar. It added that the cancellation applicant was not obliged to prove use of its earlier marks.

The cancellation applicant filed an appeal.

In appeal proceedings No R 1638/2008-4, the Fourth Board of Appeal took a decision by which it rejected the appeal.

By judgement in case T-424/10, the General Court of the European Union annulled the decision of the Fourth Board of Appeal.

It concluded that the requirements foreseen in Article 53(1)(a) CTMR are fulfilled in the present case because there is likelihood of confusion in the sense of Article 8(1)(b) CTMR between the contested CTM and the earlier marks claimed by the respondent, in relation to some of the goods they cover, namely:

Class 24: Textiles; elastic woven material; adhesive fabric for application by heat; fabric of imitation animal skins; woolen fabric; blankets; travelling rugs; table covers; textile articles; handkerchiefs of textile; serviettes of textile and non-woven textile fabrics; table mats of textile; table napkins of textile; synthetic fabrics for baby-changing;

Class 25: Clothing for gentlemen, ladies and children in general, including clothing in leather; shirts; blouses; skirts; suits; jackets; trousers; shorts; jerseys; t-shirts; pyjamas; stockings; singlets; corsets; suspenders; underpants; brassieres; slippers; hats; headscarves; ties; raincoats; overcoats; coats; swimming costumes; tracksuits; anoraks; ski pants; belts; fur coats; mufflers; gloves; dressing gowns; footwear in general, including slippers, shoes, sports shoes, boots and sandals; babies' napkins of textile; babies' bibs.

There is a visual dissimilarity between the signs in conflict and there is no phonetic similarity or dissimilarity between the contested CTM and the earlier marks. Conceptually, the CTM is identical to the earlier verbal mark since they both evoke the notion of 'elephant', and it is similar to the figurative marks because the concepts of 'elephant' and 'elephants' are very close.

Decision of the Fourth Board of Appeal of 15 April 2013 in case R 2049/2012-4 (DE)

The applicant sought to register the word mark

'FLASH POWER THE ULTIMATE ENERGY BOOST'

for the following goods: 'alcohol-free beverages' in Class 32.

The examiner refused the application on the grounds of Article 7(1)(b) and (c) CTMR, i.e. because the mark sought lacks distinctive character and it is descriptive of the goods in question.

The applicant filed an appeal.

The Board confirmed the examiner's decision and concluded that the English expression 'FLASH POWER THE ULTIMATE ENERGY BOOST' is descriptive of 'alcohol-free beverages' in Class 32, because it refers to a desirable characteristic of the goods, i.e. that it is a beverage which quickly gives the human body energy. The words 'power' and 'energy' only strengthen and make the descriptive meaning of the said expression clearer.