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Editor's note and general introduction		01.02.2014	New Guidelines
General rules		n.a.	Manual

### OHIM Guidelines for Examination

On August 1, the OHIM Manual will be phased out and all of OHIM's practice will be contained in its Guidelines. It will be the final step in a process which has involved OHIM legal experts, EU national and regional IP offices and user associations, in order to ensure that OHIM's practice rules are fully up to date.

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### Community Trade Mark

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## OHIM Guidelines for Examination

On August 1, the OHIM Manual will be phased out and all of OHIM's practice will be contained in its Guidelines. It will be the final step in a process which has involved OHIM legal experts, EU national and regional IP offices and user associations, in order to ensure that OHIM's practice rules are fully up to date.

The first set of the updated Guidelines came into force in February 2014, following a process which started in January 2013.

The Guidelines have been drawn up to reflect Office practice in the most frequent scenarios. They contain only general instructions, which have to be adapted to the particularities of a case. They are not legislative texts and, therefore, are not of a binding nature.

The task of revision was split into two work packages, and was an open process, in that those working on the Guidelines received feedback and suggestions from stakeholders. In total, 549 suggestions and comments were received, most of which were accepted.

The decision to revise the Guidelines was taken in the context of OHIM's Strategic Plan, and the Office's drive to improve the consistency and predictability of OHIM's decisions. They are the unique source of reference on Office practice for OHIM's examiners, and they are open and available to users, to allow them to predict the Office's response to their requests.

The Guidelines are currently available in the 5 languages used at OHIM – English, French, German, Italian and Spanish – and work is ongoing to translate them into 23 EU languages. They are regularly updated with the most recent trends in the jurisprudence of the European Court of Justice and the case-law of the Office's Boards of Appeal.

Following a positive opinion from OHIM's Administrative Board on May 20, the second part of the Guidelines have now been passed to OHIM's President for approval. The next edition of Alicante News, issued at the beginning of July, will contain a series of articles written by OHIM legal experts on the new Guidelines, to fully prepare users for its full introduction.

### Interview



#### The James Nurton Interview

As he takes over the ITMA Presidency, Chris McLeod of Squire Sanders tells James Nurton about his goals for the coming two years, and reveals how his trade mark career has been influenced by Beatrix Potter and Salman Rushdie

#### How did you get into working in trade marks?

I studied French and German at university and when I finished I found a job via the Holborn Job Centre doing translations for a company called Trade Mark Directory Services, which provides watching services.

The role involved a mixture of watching and translating. In those days, we used physical trade mark journals and were comparing published applications with marks on the books for clients. It was my first introduction to the world of trade marks. I also did some searching in the patent office part of the British Library, then in Southampton Buildings in London.

Later, I saw an advertisement in the Trade Mark Journal to become a trade mark assistant at the firm of Kilburn & Strode. While there I trained to become a trade mark attorney.

#### What attracted you to the work?

You would be doing lots of different things every day, for clients of varying sizes, and there was a lot of interaction with different clients and foreign associates. It meant you were gaining valuable experience on a daily basis.

I subsequently joined the law firm Hammonds, which later merged with Squire Sanders. Being in a very large firm now, we are increasingly dealing with colleagues in other countries and other departments. The contrast is we get to see a lot more work than would be incoming in a small firm.

**What kind of work do you do?**

Trade marks are still my priority. But we also have a designs practice and work closely with colleagues doing broader IP work and litigation. The split in my practice between Community and UK work is about 60-40 at the moment, and I have about 70% domestic clients. But the international side of the work is increasing as we bed in with overseas colleagues.

**What are the differences between the UK and OHIM?**

Often clients talk about covering the UK or the EU, as though they don't see the UK as part of Europe! If cost is the overriding issue, which is often the case, we will just go for the UK. If not, then we will go straight for a CTM. Also, for strategic considerations a UK mark can be registered a lot more quickly: particularly if you are planning to use the Madrid Protocol, it is important to have security in the base application rather than the uncertainty of a central attack.

The UK office has a good and justified reputation for robust examination. The quality and speed are really good. They've worked to maintain that as they realise OHIM is a direct competitor. But we'll always explain the options to clients: with a CTM you get the benefit of greater geographical coverage, but also the risk of a challenge.

Another difference is that in the UK absolute grounds are only considered from a UK perspective whereas of course OHIM has to consider absolute grounds for every EU member state. They also have a quota of employees from every member state.

**How well do you think OHIM works?**

OHIM is an incredible operation but to some extent it is a victim of its own success, and more staff might be needed to maintain the standards. But it has improved a lot since the early days in all senses. You can speak to the person you need to speak to which is good. But too often you may not know what the absolute grounds objection is, so your application ends up in a holding pattern, which is frustrating. I would like to see more flexibility from examiners on absolute grounds.

I'm interested in the suggestion of a fast-track CTM application, which would be closer to the speed of the RCD, which is the quickest property right you can get. Designs can be registered in just a day and that is a great example of what can be done.

Another issue is that the speed of examination has slowed down if you don't adopt the goods and services terms that are deemed acceptable. That is a problem particularly if you are filing based on instructions from the US, and you are not blessed with the taxonomy wand.

**What was the first trade mark you worked on?**

The first portfolio I handled was all the trade marks to do with the Beatrix Potter books. The works were about to come out of copyright and the publisher was looking to bolster the rights. We filed over 1000 applications relating to the books, characters and artwork. It was a global project, and this was in the early 1990s before the CTM and before the UK joined the Madrid Protocol. The works were heavily merchandised and were incredibly popular, particularly in Asia.

**What about the most unusual mark?**

One of the most unusual experiences was trying to register the Penguin mark for Penguin Books in Iran in the early 1990s. The Iranian agent kept sending cryptic responses, and it took a while to find out why it was being refused. Eventually, we understood that it was because Viking, which was part of Penguin, had published *The Satanic Verses* by Salman Rushdie. That was an eye-opening collision between the narrow world of trade marks and the wider world of global politics and religion. In the end we abandoned the application.

**You have just taken office as ITMA President. What does that involve?**

ITMA has a Board of Directors and there has historically been a structure where you become Treasurer, then Second Vice-President, First Vice-President and finally President, which makes you a spokesperson for the profession. It is both inward-facing – dealing with internal communications with members and potential members – and external, working with other bodies such as IPREG, the IPO and OHIM as well as other national and regional associations: we get together with them through the OHIM Users Group and the Sister Group Meeting.

**Is there a need for all these associations?**

I think so. Different organisations don't always have the same views. For example, a number of European organisations made a joint statement critical of what is happening with plain packaging. But ITMA took the view that at this point we can't sign up to that as we have members on both sides of the argument. At the moment there are no concrete proposals in the UK, so we will wait to see what if any changes are proposed to the Trade Marks Act.

**What are your aims as ITMA President?**

A primary concern is the diversity of the profession. This is a real issue in the UK generally, and particularly for the legal professions. ITMA has a pretty good female/male ratio but in other respects we need to promote greater diversity, so I will go out and bring to people's attention the roles that are available in our profession.

Another issue is the profile of the profession. We have arguably had a tendency to be too introspective so we want to raise our profile externally via the media. It is difficult because we are a relatively small organisation largely dependent on volunteers. But IP is now a familiar concept in the mainstream media and we should be speaking out about trade marks when the opportunity arises.

**Do you think there is a problem with anti-IP sentiment?**

To some extent, yes. Partly it is down to digitisation and the expectation that you can get things for nothing, even if they have required artistic efforts to be created. You used to have to go to a shop to buy a physical record or CD but that model has been broken, and it is very easy to get music free, legally or otherwise. Another thing is that you see David-and-Goliath type battles presented by the media. In the face of that, we have a duty to say that creativity should be rewarded and people have paid to have monopoly rights. It is a big educational battle and of course lawyers are easy to bash! So we need to emphasise the merits of IP.

**Are there any other priorities for your presidency?**

Internally, I want to engage with the membership and encourage people to become involved whatever their particular ability or interest. We want to emphasise that involvement doesn't necessarily have to tie them down to eight years of doing free work. There is now much more flexibility.

I also want to emphasise the benefits of membership, including to overseas practitioners and other professions. One of the benefits is that you can get all your CPD points at no additional cost and I think the quality of what we provide is very good, but we need to communicate that to members.

**What are the biggest changes in trade marks?**

The biggest change I have seen in my career is convergence. We are now competing with anyone who can file a CTM or Madrid Protocol application. That means we no longer have as much need for a network of external associates for the day-to-day work, but there is now much more contentious-type work, which still requires local expertise.

Another trend is the commoditisation of some trade mark work. Filings and renewals used to be done almost exclusively by professionals, but now unrepresented individuals can file applications, and renewals can be effectively automated.

In practical terms, that means we are often asked to quote fees for work before being instructed. Clients want to know: how much will it cost? We have to benchmark against other firms and hope that quality will win. There will always be cheaper alternatives but most clients know that cheaper is not always better.

**33rd ECTA Annual Conference, Alicante 18-21 June, 2014**

ECTA is casting its thoughts back over the past 20 years during its June annual conference in Alicante. What do you consider are the most important changes that have taken place since the adoption of the Community Trade Mark and Design Regulations?

The adoption of the Community Trade Mark and Design Regulations has significantly changed the world of trademarks and designs in the European Union. Applicants are able to file one single application, pay one fee and will receive protection in now 28 different countries with one single examination procedure. The right can be enforced in all EU member states without any further validation and the use of a trademark in a small part of the EU is already sufficient to maintain the right in all 28 member states. Applicants from all over the world have an easy and reliable access to the European Market and have used this system extensively.

The Max-Planck Study, which has been performed before the still ongoing Revision of the Community Trade Mark Regulation and Directive started, showed that the system works very well. Such success would not have been possible without the 'engine of the system', OHIM. The Office in Alicante and its employees have shown themselves to be very

efficient and have certainly become a benchmark among trademark offices globally. The CTM system and the Office have also become a 'harmonization motor' for the EU. The Trademark and Design Network has proven to be an effective tool for harmonizing practises and procedures in the national TM offices.

ECTA's meeting in Alicante will also turn its attention to the future. Perhaps the Association can give us an idea of what they think may lie in store?

The future will certainly be governed by the new European Union Trade Mark Regulation and Directive which we expect to be enforced in early 2016. However, ECTA expects this not to be a revolution but more an evolution of procedures and tools which are destined to serve both trade mark owners and consumers who both rely on trademarks and their 'branding capabilities'. ECTA has always fostered the necessity and usefulness of national trademarks which are the ideal tool for small and medium-sized corporations and larger corporations which need a more regional brand or which have goods and services which are destined for certain cultures or languages which make the European Union so attractive. There are still many questions to be resolved and as it can be seen, lots of them will not be solved by the new legislation such as the question of genuine use or the questions of ancillary claims in infringement proceedings.

In the long run, ECTA also expects WIPO to play a stronger role in the field of obtaining trademark protection, especially with regard to the still very different national examination procedures and the long term of up to and more than 18 months before protection is confirmed. Here, there is a certain imbalance in obtaining trademark protection between the EU, where the procedure is quite quick and very inexpensive for 28 countries, and other countries where the procedure, the timing and the objections are still quite different and sometimes cumbersome to overcome.

ECTA was formed in 1980 as an offshoot of the initial work done on a unitary tool by the then EEC. How has ECTA developed as a User Association serving its member's interests over the past three decades?

ECTA has developed quite strongly over the past 30 years of its existence. Nowadays ECTA members represent more than 50% of all CTM registrations. ECTA has always concentrated on the legal aspects of the system and on those issues where the interests of all members coincide and has refrained from taking a position on matters on which there is no common viewpoint.

The extensive work carried out by the Association so far, following the above guidelines, combined with the high degree of professionalism and recognised technical capabilities of its members, has established ECTA at the highest level and has allowed the Association to achieve the status of a recognised expert spokesman on all questions related to the protection and use of trade marks, designs and domain names in and throughout the European Union, and for example, in the following areas:

- Harmonization of the national laws of the EU member countries;
- Community Trade Mark Regulation and Directive;
- Community Design Regulation and Directive;
- Organisation and practice of the OHIM.

In addition to having close links with the European Commission and the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), ECTA is recognised by WIPO as a non-Government Organisation (NGO) and has frequent meetings with members of the European Parliament.

ECTA does also take into consideration all questions arising from the new framework affecting trade marks, including the globalization of markets, the explosion of the Internet and the changes in the world economy.

ECTA has been a long-term partner of the OHIM. What synergies are created by the close links between the two organisations?

ECTA firmly believes in a close partnership with OHIM as there are a lot of synergies between the two organisations. ECTA members have an insight into the matters of the OHIM from an outside, so called 'user' perspective which can be of utmost importance for the service quality of OHIM. Vice versa, OHIM can inform ECTA and its members about new practices, guidelines and case-law and both partners can discuss and work together on many subjects for the benefit not only of ECTA members but also for the industry and consumers, many of whom are either members of or are represented



through members of ECTA. Such a partnership has proved to be effective, especially when problems arise which can then be solved quickly with the expert advice of ECTA members.

### OHIM implements the agreed common practice on black and white trade marks in its Guidelines

In the framework of the European Trade Mark and Design Network the Office and a number of Trade Mark Offices in the European Union have agreed on a common practice with regard to black and white (B&W) or greyscale marks as compared with coloured versions of the same sign.

The participating offices closely analysed three important questions essential to handling trade marks in B&W and/or greyscale:

- Is a trade mark in B&W and/or greyscale from which priority is claimed identical to the same mark in colour?
- Is an earlier trade mark in B&W and/or greyscale identical to the same mark in colour when assessing relative grounds?
- Is the use of a colour version of a trade mark registered in B&W/greyscale (or vice-versa) acceptable for the purpose of establishing genuine use?

On 15/04/2014, the [Common Communication on the Common Practice](#) was published on the Office web site. The next step is to reflect the agreed principles in OHIM's Guidelines.

#### Impact on the Office practice

The Common Practice will not entail major changes for Office practice. With regard to Relative Grounds and Proof of Use it merely explicitly reflects prior Office practice. The major impact affects priority, as the Office in the future will accept priority claims that it previously would have objected to.

A preliminary overview of the impact of the agreed principles on the Office trade mark practice was included in the Alicante News [November 2013 issue](#).

The KC Relative Grounds and the KC Proceedings have worked together to reflect the agreed practice in the Office Guidelines. As a result, the following sections of the Guidelines have been updated:

- Part B, Examination, Section 2 Examination of formalities: the previous practice of the Office when assessing priority claims was to object if there was any difference in the appearance of the marks, including presentations in differing colours. Following the implementation of the Common Practice, the scope of what is considered 'identity' will be broader. A trade mark filed in B&W and/or greyscale, from which priority is claimed, will generally still not be considered identical to the same mark filed in colour. However, if the differences in colour or in the greyscale are so insignificant that they could go unnoticed by the average consumer, the marks will be considered identical. The Guidelines now include examples specifically created for the Common Principles. Furthermore, a reference to the recent judgment of 09/04/2014, T-623/11, 'Milanówek cream fudge', has been added.
- Part C, Opposition, Section 2 Identity and likelihood of confusion, Chapter 3 Comparison of Signs: this part of the Guidelines did not expressly address the issue of identity when the only difference between the signs regarded the change from B&W or greyscale to colour. Therefore, the amended Guidelines now include a new sub-section, which deals with the comparison of an earlier B&W or greyscale mark with a colour mark application.

As agreed in the context of the Convergence Programme, the Office will consider that the differences between an earlier B&W or greyscale mark and a coloured version of the same sign will normally be noticed by the average consumer with the consequence that the marks are not considered identical. It is only under exceptional

circumstances that the signs will be considered identical, namely where the differences in the colours or in the contrast of shades are so insignificant that a reasonably observant consumer will perceive them only upon side by side examination of the marks. In other words, for the finding of identity the differences in colour of the signs in question must be negligible and hardly noticeable to an average consumer. The Guidelines now also add some of the examples specifically created for the Common Principles.

Finally, a reference to the recent judgment of 09/04/2014, T-623/11, 'Milanówek cream fudge', has been added. In the context of an opposition case, the Court considered that a trade mark registered in B&W does not cover all colours and, thus, confirmed the findings of the Common practice.

- Part C, Opposition, Section 6 Proof of use: the section on 'use of the mark in forms different from the one registered' already gave guidance on whether use of a registered B&W and/or greyscale trade mark which was used in colour (or vice-versa) was acceptable under Article 15 CTMR. The agreed practice does not change the Office practice in this respect but only clarifies it further.

The amended Guidelines now refer to the agreed criteria that changes in colour must fulfil in order not to alter the distinctive character of the trade mark as registered (the word/figurative elements coincide and are the most distinctive, the contrast of shades is respected, the colour or combination of colours does not have distinctive character in itself, and colour is not one of the main contributors to the overall distinctiveness).

The revised version of the Guidelines will enter into force immediately after publication of the Guidelines (02/06/2014). The new practice will be applicable to pending and future proceedings where a final decision has not been adopted yet:

- Cases where a priority claim has not been treated yet;
- Cases where a decision on identity of trade marks in relative grounds has not been adopted yet;
- Cases where a decision on genuine use has not been adopted yet.

### OHIM changes its practice regarding the submission of additional evidence

In the second half of 2013, the Court of Justice delivered two judgments examining under which circumstances evidence of use filed after the date given by the Office ('additional evidence') should be accepted (judgment of 18/07/2013, C-621/11 P, 'Fishbone' and judgment of 26/09/2013, C-610/11 P, 'Centrotherm').

The KC Relative Grounds and the KC Proceedings have worked together to implement the guidance of the Court in the Office Guidelines. As a result, the following sections of the Guidelines have been updated:

- Part C, Opposition, Section 1, Procedural matters: The Guidelines on Procedural matters have been amended to reflect the Office's new practice on additional evidence relating to proof of use. To this extent, the Guidelines indicate that the opposition will be rejected if *inter alia* **no** proof of use has been submitted (see paragraph 4.3.4 Proof of use). Under paragraph 4.5. *Further exchanges*, a new subparagraph 4.5.1 *Additional evidence for proof of use* has been introduced. Finally, paragraph 6.2 *Time limits* has been updated to reflect the new practice.
- Part C, Opposition, Section 6, Proof of use: Changes have been made to clarify the nature and the extent of the discretionary powers of the Office in relation to additional evidence. In summary, it is confirmed that when **no relevant evidence or no evidence at all** has been submitted within the time limit, the opposition will be rejected with no exercise of discretionary powers of the Office. On the contrary, **additional** evidence may be accepted by the Office after the time limit has expired, if the following two conditions apply:
  - the additional evidence merely strengthens and clarifies the prior relevant evidence submitted within the time limit.
  - the opponent does not abuse the time-limits set by employing delaying tactics or by demonstrating manifest negligence.

The Office considers that it is particularly likely that the additional evidence is taken into account where the material produced late is, on the face of it, likely to be relevant to the outcome of the opposition and the stage of the proceedings at which that late submission takes place and the circumstances surrounding it do not preclude such matters being taken into account.

The revised sections of the Guidelines will enter into force immediately after publication (02/06/2014). National offices and users associations will be able to comment in any event in the framework of the normal revision cycle. The new practice will be applicable to pending and future proceedings where a final decision has not been adopted yet.

### What, How and When to file evidence of use

The Office's communication notifying to the opponent the request for proof of use (the so called letter 234-A) contains an annex with instructions on **what**, **how** and **when** to file the evidence of use.

- **What:** the opponent has to submit items and/or supporting documents (eventually with translations) which give indications concerning the place, time, extent and nature of the use. The Office [Guidelines on Proof of Use](#) provide ample information on the type of evidence that an opponent should submit in order to prove the genuine use of its trade mark. The most frequent types of evidence are packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements, and statements in writing.
- **How:** the evidence must be submitted in a structured manner with a numbered list of all pieces of evidence. The Office strongly recommends not exceeding a maximum of **110 pages**.
- **When:** the evidence must be submitted within the time-limit fixed by the Office. As explained above, there is a risk that the evidence filed after the deadline will not be accepted.

## Registered Community Design RCD

### Convergence Programme Projects on Designs

The first Work Package Group meetings (WPG) on the two new Convergence Programme projects on designs, CP6: Harmonisation of Graphical Representation and CP7: Harmonisation of Product Indications took place in the first week of May.

Since kick-off in January, the projects have both picked up steam with the help of the project teams and Work Package Group members from various IP offices. The WPG meeting for CP6 saw participation from 11 National Offices, WIPO (as observer) and OHIM. 11 National Offices, WIPO and OHIM participated in the CP7 WPG meeting.

While each project maintains different objectives, their first WPG meetings both focused on evaluating existing conditions, exchanging initial views and brainstorming for solutions.

- Discussions for CP6 were based on a second survey on office practices that was replied to by 30 National Offices (NOs). The results of this survey were fully analysed and presented during the meeting, overview of these survey results will soon be made available on the European Trade Mark and Design Network website. The complexity of the topics and the divergence in practices, called for extensive analysis by meeting participants. Conclusions regarding the project topics 'neutral background' and 'disclaimers' were proposed and illustrated using many examples from the survey.
- In CP7 the following topics were discussed: Creation procedure of the Harmonised database of product indications, where the process proposed was accepted by all of the WPG members; Guidelines for product indications acceptability: Several discussions took place during the meeting following examples prepared for review. A Common Practice document has been created based on decisions adopted during the meeting; GUIs (Graphical User Interface) where a set of mock-ups were presented to show how the future search tool could look



like when created next year and finally Taxonomy principles where three possible approaches for taxonomy were discussed. The approaches will be further analysed before a decision on the final option to be followed is made.

The conclusions of both meetings have been included in the minutes that were distributed for comment to the WPG. Once approved, the project Working Group will have the opportunity to provide their feedback. To continue this steady progress, the CP6 Work Package Group will meet again in June/July and the CP7 Work Package Group will meet again in September.

All User Association members are invited to review the CP6 and CP7 Project Briefs and submit feedback on or before July 15th. This initial phase of both projects is an opportune time to express opinions, provide suggestions and clearly outline expectations. This feedback will be closely evaluated by the Work Package Group and incorporated upon agreement.

## EUTMDN Updates

### **ETMDN e-filing: three out of four trademark applications now filed online in Finland**

Three quarters of all trade mark applications in Finland are now filed online, as a result of the new online service implemented in the Office. The online service is the result of an international project led by the Cooperation Fund at OHIM, with Finland as the pilot country.

At the beginning of 2014, 78% of national trademark applications in Finland were filed using the Office's online filing service. In 2013, 55% of all applications were filed online.

Additionally, from the beginning of 2014, it has been cheaper to file trademark applications online than to file them on paper. The basic fee for an online application is EUR 215, while the fee for a paper application is EUR 250. An online application is cheaper because the application details are automatically transferred to the new trademark application processing system, which reduces the Office's workload when recording and checking the information.

### **ETMDN tools presented at INTA (Hong Kong)**

A range of tools developed by and for the European Trade Mark and Design Network were exhibited at the INTA annual meeting in Hong Kong in May.

Live demonstrations of tools like TMview and DesignView were shown to delegates at the OHIM stand at the event.

The Network itself was represented by the heads of the Polish and the Spanish national IP offices.

## More News



### **OHIM's governing bodies, its Administrative Board and Budget Committee, met in Alicante from 20 to 22 May 2014.**

Members endorsed the Convergence Programme project 'Relative grounds - Likelihood of Confusion', and issued a favourable opinion on the second part of the proposed new OHIM guidelines, as well as amending OHIM Guidelines on the prevention and management of conflicts of interest. OHIM President António Campinos updated ABBC Members on the Annual Report of OHIM and of the EU Observatory on Infringements of Intellectual Property Rights, a department within OHIM.

Members granted budgetary discharge to the President in respect of the implementation of OHIM's budget and the financial year 2012 and were briefed on the budgetary results and key financial figures for 2013 and the estimate of revenue and expenditure for 2015.

Meeting in joint session, delegates welcomed the achievements of the ETMDN, including the rollout of tools and services in national and regional IP offices.

### **OHIM Enterprise Risk Management**

The yearly Office-wide risk assessment took place in the Office this month. The exercise covers all activities of the Office and it aims at identifying, assessing and managing the most significant risks to the achievement of the Office objectives. In addition, it addresses one of the observations from the 2013 ISO 9001 external audit. The risk assessment is part of the OHIM Enterprise Risk Management Framework, which was approved by the President in January 2014 and is being coordinated by the Quality Management Service and the Quality, Performance and Risk Network.

### **The Director General of the Mexican Office visited OHIM at the beginning of May.**

Miguel Angel Margáin, along with a delegation of senior directors from INPI, visited Alicante. In addition to meeting with President Campinos, the delegation heard updates on OHIM's work and discussed bilateral cooperation between the two offices. The Mexican Office has already implemented TMclass and TMview, becoming the first Latin American office to do so.

### **OHIM hosts the University Network Research and Coordination Sessions**

The Network, launched in 2008, brought together students and professors from 22 European universities for two days of research sessions on 7-8 May. Each student presented a master's thesis on a CTM or RCD-related topic which had been elaborated under the guidance of OHIM staff acting as research advisors. An evaluation coordination meeting between the Academy and the professors was also held.

### **TM5 website launched**

A new website dedicated to the Trade Mark 5 (TM5) offices and their joint activities, has been launched. The TM5 partner offices - the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), OHIM, the State Administration of Industry and Commerce of the People's Republic of China (SAIC) and the United States Patent and Trademark Office (USPTO) are the five largest trade mark offices in the world.

Through the TM5 framework, the offices exchange information on trade mark and design issues, and collaborate on joint projects for the benefits of their mutual users.

The website was developed by KIPO as one of the cooperative projects undertaken by the TM5 partners. It includes detailed information on projects, information resources and statistics, and can be found [here](#).

## New webinar on eCommunications: tips and tricks for electronic communications

One of the first things you encounter when signing up to OHIM's website is the question: "How we should communicate with you?" 73% of our users choose to communicate with us via the User Area instead of fax or post.

When and where?

The next webinar in our series will take place on June 11 from 12:30 to 13:00 CET and it will look at how the User Area's communication inbox works.

How?

The webinar will be held in English and it will last approximately 30 minutes. It will be available via this link.

Coming up

This is the second of a series of five webinars that will guide our Users through OHIM's new online presence.

- May 22: The User Area in short (link to webinar will be communicated shortly)
- June 11: eCommunications
- July 1: eSearch plus
- September 4: Change of name and representative
- October 7: Using alerts

## Monthly statistical highlights\* April 2014 compared to April 2013

	2014	2013
Community trade mark applications received	9 988	9 385
Community trade mark applications published	8 632	9 330
Community trade marks registered (certificates issued)	7 582	8 202
Registered Community designs received	7 147	7 898
Registered Community designs published	7 539	8 043

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

## Case law



## Luxembourg Case Law

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

**Case C-177/13P ; Marek Marszałkowski v OHIM; Order of 13 February 2014; Language of the case: PL**

**RESULT: Action dismissed**

**KEYWORDS: Admissibility, Likelihood of confusion, Dominant element, Relevant territory, Reputation, General reference to previous submissions**

**FACTS:** In Case T-159/11 the General Court (GC) confirmed the decision of the Board of Appeal (BoA) and refused the CTMA, WALICHNOWY MARKO, for goods in Class 29 on the basis of the earlier CTM, MARKO, registered in the same class. The CTM applicant brought an appeal to the European court of justice (CJ) claiming an infringement of Article 8(1) (b) CTMR and Article 48 (2) RoP.

CTM applied for	Earlier CTM
<b>WALICHNOWY MARKO</b>	<b>MARKO</b>



**SUBSTANCE:** The appeal was rejected as partly inadmissible and partly unfounded. The CTM applicant claimed an infringement of article 8(1) (b) CTMR by three mistakes in the overall assessment of the likelihood of confusion regarding the comparison of the trade marks, the overall assessment, the dominant character of the element "MARKO", the relevant public, the importance of the reputation the CTMA has in Poland and the level of attention of the relevant public. The trademark comparison, the relevant public and its level of attention are questions of facts and cannot be reviewed by the CJ within the appeal procedure (Para. 40 et seq.). The same applies to the claimed reputation of the CTMA in Poland (Para 64). Whereas the evaluation of all factors within the overall assessment of the likelihood of confusion is an issue of fact that cannot be reviewed by the CJ, failure to take all of those factors into account, on the other hand, constitutes an error of law (Para. 52). The related arguments of the CTM applicant are based, however, on a misunderstanding of the judgment under appeal (Para. 53). The claimed infringement of Article 48(2) RoP was rejected as unfounded as contrary to previous submissions of the CTM applicant.

**Case C-530/12; Appeal of the OHIM against the judgment of the General Court in case T-404/10; Judgment of 27 March 2014; Language of the case: EN.**

**RESULT: Action upheld (GC's judgment set aside)**

**KEYWORDS: Relative grounds, Copyright, Burden of proof, Right to be heard**

**FACTS:** On 2 October 2007, the CTM proprietor obtained the registration of the Community figurative mark represented below. On 20 November 2007, two applicants filed a joint invalidity request on the basis of Article 52(2) (c) CTMR, invoking a prior copyright, under the Italian law, in the figurative sign reproduced below. The invalidity applicants relied on an agreement dated 16 September 1986 (the date resulting from a post office stamp affixed to it) under which a third party purporting to be the author of the allegedly earlier copyright claimed that he had assigned to one of them his rights to reproduce and use the work in question. The CTM proprietor argued that the mentioned agreement presented certain anomalies that shed doubts as to the reliability of the date resulting from the post office stamp affixed to the document and, therefore, on whether an earlier copyright existed at all.

CTMA	Earlier Copyright
	

The Cancellation Division granted that application for a declaration of invalidity on the ground, in essence, that the applicants for a declaration of invalidity had demonstrated the existence of an earlier copyright protected by Italian legislation and which was virtually identical to the contested trade mark. The Board of Appeal (BoA) dismissed the CTM proprietor's appeal, holding that the anomalies invoked by the CTM proprietor did not give grounds for doubting the veracity of the content of the 1986 agreement. In that context, the BoA considered, in essence, that it was not competent to assess the validity of the 1986 agreement and that this could only be challenged by bringing a separate judicial proceedings for declaration of forgery. The CTM proprietor filed an action before the General court (GC). The General Court granted the appeal, holding on the one hand that the BoA had infringed Article 53(2)(c) CTMR in so far as it had found that the existence of an earlier copyright had been proved by the invalidity applicants and, on the other, finding that the BoA had incorrectly assessed its powers to determine whether that agreement was authentic. In particular, the GC referred to an article of the Italian Civil Code and a judgment of the Italian Supreme Court of Cassation interpreting that article - both of which had not been invoked and relied upon by the parties before the Office - and held that, in accordance with that judgment, it was open for the CTM proprietor, without it being necessary to bring separate proceedings for a declaration of forgery, to adduce proof that, in fact, the 1986 agreement had been drawn up on a date other than that shown on the post office stamp. The GC therefore inferred from this that the BoA had misinterpreted the national law applicable pursuant to Article 53(2) CTMR and therefore had failed to assess accurately the precise scope of its own powers. Had the BoA considered itself competent to assess the validity of the 1986 agreement, it might have come to a different conclusion. The Office filed an appeal to the European court of justice (CJ), raising three pleas in law and alleging (i) infringement of Article 76(1) CTMR and of Rule 37 CTMR; (ii) infringement of the right to be heard, insofar as Office's right to be heard regarding the judgment of 14 June 2007 was not observed; and (iii) manifest inconsistency and distortion of the facts which affect the reasoning followed and the conclusion reached by the GC. In particular, by its first plea, the Office submitted that the GC could not rely on an article of the Italian Civil Code and on the judgment of the Italian Supreme Court of Cassation, since those two factors had not been invoked by the parties and did not, therefore, fall within the subject-matter of the dispute brought before the Board. The Office argued that it read the judgment of the CJ in Case C-263/09 P *Edwin v OHIM* as confirming that it is for the party relying on national law to provide the Office not only with particulars showing that he satisfies the necessary conditions, in accordance with the national law of which he is seeking application, in order to be able to have the use of a Community trade mark prohibited by virtue of an earlier right, but also particulars establishing the content of that law. The CJ held that it is not apparent from the judgment in *Edwin v OHIM* that a rule of national law, made applicable by a reference such as that in Article 52(2) CTMR, should be treated as a purely factual matter, the existence of which the Office and the GC merely establish on the basis of the evidence before them (Para. 37). The review by the Office and by the GC must be conducted in the light of the requirement of ensuring the practical effect of the CTMR, which is to protect registered CTMs (Para. 40). The scope of the decision of the Office called to take in an invalidity scenario necessarily implies that the Office's role cannot be of mere validation of the national law as submitted by the invalidity applicant (Para. 43). The GC must be able to confirm, beyond the documents submitted, the content, the conditions of application and the scope of the rules of law relied upon by the applicant for a declaration of invalidity (Para. 44). The GC did not err by holding that the Office must — of its own motion and by whatever means considered appropriate — obtain information about the national law of the Member State concerned, where such information is necessary for the purposes of assessing the applicability of a ground for invalidity relied on before it and, in particular, for the purposes of assessing the accuracy of the facts adduced or the probative value of the documents submitted (Para. 45). Since the parties before the GC were not given the opportunity to submit their observations on the above mentioned judgment of the Italian Supreme Court of Cassation, the GC infringed the Office's right to be heard (Paras. 57-60). The CJ therefore set aside the judgment of the GC and referred the case back to the lower instance for a ruling on the merits of the action.



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

**Joined Cases T-102/11, T-369/12, T-370/12, T-371/12 American Express v. OHIM; Judgment of 12 March 2014; language of the case: EN**

**RESULT: Action dismissed**

**KEYWORDS: Absolute grounds, Specialized public, Acronym, Descriptive element**

**FACTS:** The examiner refused registration of the word signs **IP ZONE**, **EUROPE IP ZONE**, **IP ZONE EUROPE** and **EUROPEAN IP ZONE** for 'hosting an on-line portal for disclosing, selling, buying, licensing and general transactions for intellectual property', on the basis of Article 7(1) (b) and (c) and Article 7(2) CTMR. The Board of Appeal (BoA) dismissed the appeals.

**SUBSTANCE:** The services at issue are aimed at professionals in the field of intellectual property. The absolute ground of refusal has to be assessed in relation to the English-speaking public. The General court (GC) confirms that, from the point of view of the relevant public, there is a sufficiently direct and specific relationship between the signs and the services in respect of which registration is sought. The GC confirms that the possible meaning of the acronym IP should not be examined in the abstract, but in relation to the services covered by the marks applied for and to the consumers for whom they are intended (Para. 30). The signs at issue, taken as a whole, will be unequivocally understood by the relevant public as describing an area devoted to intellectual property. Even if this definition is not particularly precise, it clearly includes the services at issue, namely 'hosting an on-line portal for disclosing, selling, buying, licensing and general transactions for intellectual property' (Para. 34). Since the signs are not capable of registration pursuant to Article 7(1) (c) CTMR, it is not necessary to rule on the alleged infringement of Article 7(1) (b) CTMR.

**Case T-249/13; MHCS v OHIM; Judgment of 9 April 2014; Language of the case: EN.**

**RESULT: Action dismissed.**

**KEYWORDS: Relative grounds, Likelihood of confusion, Admissibility, New evidence, Visual dissimilarity, Phonetic dissimilarity, Conceptual dissimilarity, Weak trademarks**

**FACTS:** The applicant sought to register the figurative mark represented below as a CTM for goods in Class 33. An opposition based on the earlier figurative marks represented below, registered for goods in Class 33, was filed on the grounds of Article 8(1) (b) CTMR. The Opposition Division (OD) dismissed the opposition and the Board of Appeal (BoA) dismissed the appeal, considering the signs to be overall dissimilar.

CTMA	Earlier CTM and French Marks
	

**SUBSTANCE:** The applicant alleged that the BoA had infringed Rule 50(1) CTMIR and Article 76(2) CTMR firstly by rejecting the evidence filed for the first time at appeal stage and aimed at proving that the earlier marks had acquired enhanced distinctiveness and, secondly, by failing to state the reasons why it did not take that evidence into account. The General court (GC) held that, since the opponent had not, during the opposition proceedings, claimed that the earlier marks had acquired enhanced distinctiveness or submitted any evidence in that respect, the BoA had correctly rejected as inadmissible the evidence filed for the first time at the appeal stage and had also provided sufficient reasons for doing so (Paras. 19-20). The GC also noted that the Board, in the exercise of its broad discretion, had found that that belated evidence was in any case irrelevant to the decision, given that the figurative elements contained in the earlier marks were only weakly distinctive, and thus, even if they had been found to have acquired an additional degree of enhanced distinctiveness through use, their total distinctiveness would still not be high (Para. 34). As to the alleged breach of Article 8(1) (b) CTMR, the GC confirmed the findings of the BoA and made the following remarks. The opponent had not denied that affixing to a bottle of alcoholic beverage a label consisting of two bands intersecting at an angle with a circular element where the bands cross, is a practice which exists in the sector in question and that it was apparent from the administrative file that labels with that shape are not uncommon on bottles containing alcoholic beverages (Paras. 51-58). Coming to the comparison of the signs, the figurative elements contained in the mark applied for cannot constitute the dominant element. By contrast, on account, in particular, of its position, its size, the fact that it appears twice in the mark applied for and the contrast between its black letters and the white background on which it appears, the word element 'dorato' constitutes the dominant element of that mark (Para. 66). The signs are visually dissimilar overall, since the only element of similarity between them is that they have figurative elements representing a label for affixing to the neck of a bottle and that those elements are only weakly distinctive. Moreover, the signs have different structures and contain many differences (Paras. 71-72). The signs are phonetically dissimilar (Paras- 74-75). The mark applied for is dominated by the word element 'dorato', meaning 'gold' in Italian, whereas none of the word elements in the earlier marks conveys that concept. For non-Italian speaking consumers, the mark applied for has no meaning, whereas the earlier marks contain laudatory elements, such as 'brut', 'réserve' or 'impérial'. On the other hand, consumers will not therefore attribute any specific conceptual meaning to the presence of the label in the shape of a tie. It follows that the signs are conceptually different (Paras. 76-82). As to the overall assessment, given that there is no visual, phonetic or conceptual similarity between the signs, one of the conditions for the application of Article 8(1) (b) CTMR has not been satisfied in the present case. The GC added that, even if the signs were held to be conceptually similar, that would have no bearing on the above finding of no likelihood of confusion, since, on account of the circumstance that the earlier marks do not have a particularly distinctive character and consist of an image with little imaginative content, the mere fact that the marks might be held to be conceptually similar would not be sufficient to give rise to a likelihood of confusion (Paras. 86-87).

Case T-501/12; Farmaceutisk Laboratorium Ferring A/S v OHIM; Judgment of 9 April 2014; Language of the case: EN.

**RESULT:** Action upheld and BoA's decision annulled

**KEYWORDS:** Relative grounds, Likelihood of confusion, Identity of the goods and services, Relevant territory, Descriptive element, Internet, Ending of mark, Visual similarity, Phonetic similarity, Conceptual similarity

**FACTS:** The applicant sought to register the word mark OCTASA as a CTM for 'preparations and substances for preventing and treating diseases and disorders of the gastro-intestinal tract' in Class 5. An opposition based on a number of national trademarks for the word PENTASA and registered for 'pharmaceutical preparations' in Class 5 was filed on the grounds of Articles 8(1) (b) and 8(5) CTMR. The Opposition Division (OD) dismissed the opposition. The Board of Appeal (BoA) dismissed the appeal. The BoA held that the suffix 'asa' common to both signs was descriptive in relation to that active ingredient mesalazine, which is also known as '5-aminosalicylic acid' and '5-ASA'. The BoA therefore concluded that there was no similarity between the trademarks PENTASA and OCTASA and that one of the necessary conditions for finding that there is a likelihood of confusion had not been met. The General Court (GC) upheld the appeal and annulled the decision of the BoA.

**SUBSTANCE:** As to the relevant public and their level of attention, the GC held that all of the earlier trade marks (save one of them) cover pharmaceuticals in general and therefore also 'preparations and substances for preventing and treating diseases and disorders of the gastro-intestinal tract' which are the specific goods covered by the mark applied for. The relevant public consists of medical professionals and consumers of the above specific products, the level of attention of consumers purchasing medicines to treat such diseases being higher than the average (Paras. 24-32). Addressing the issue of the alleged descriptive nature of the suffix 'ASA', the GC made the following remarks: It is common ground that *mesalazine* is the active ingredient of the pharmaceutical products in respect of which the opponent is using its earlier trademarks PENTASA and that '*mesalazine*' is the only name for the active ingredient which appears on the packaging of the products sold under the trade mark PENTASA. The BoA failed to establish the descriptive character of the suffix 'asa' from the perspective of the end-users of the goods in question (Paras. 40-41). The evidence relied upon by the BoA and which consists of extracts, in English, from two online encyclopaedias, namely Wikipedia and The Free Dictionary concern only the English-speaking end-users of medicines and not non-English-speaking end-users (Paras. 45-47). It is settled Case-Law that an extract from Wikipedia lacks certainty as a source of information (Para. 48). There is no reason for concluding that the medical publications submitted by the CTM applicant and taken into account by the Board are read by the end-users of medicines which are designed to treat diseases of the gastro-intestinal tract and contain *mesalazine* as their active ingredient (Para. 49). There is no reason to conclude that those end-users will immediately interpret, without further thought, the suffix 'asa' as a description of that active ingredient. Rather, it is necessary to follow a complex line of reasoning which involves a number of stages in order to interpret the suffix 'asa' as a reference to *mesalazine* (Para. 50). Coming to the comparison of the signs, the GC stated that the principle that first component of word marks may be more likely to catch the consumer's attention than the following components cannot apply in all cases, what matters being the overall impression produced by the signs. The marks at issue display a certain degree of visual and phonetic similarity, given that they are of a similar length and have three syllables. Conceptually, from the perspective of the end-users of the goods in question who do not understand that the suffix 'asa' is a reference to *mesalazine*, neither of the signs at issue, taken as a whole has any meaning. For those end-users who are also unaware that the beginnings of the signs at issue, namely 'penta' and 'octa', refer to Greek numbers, the conceptual comparison is neutral. From the perspective of that part of the relevant public, neither of the signs refers to any concept whatsoever. However, some of the end-users will recognise that the beginnings of the signs at issue refer to Greek numbers. For those end-users, the signs at issue are conceptually similar in that they both refer to Greek numbers. Nonetheless, given that the signs at issue refer to different Greek numbers, that conceptual similarity must be held to be weak (Paras. 61-63). The BoA therefore erred by finding that the signs at issue were dissimilar and by holding that, as a result, one of the necessary conditions for finding that there is a likelihood of confusion had not been met. The Court therefore upheld the first plea in law and annulled the contested decision, stating that there was no need to examine the other arguments and pleas in law raised by the opponent (Para. 69).

Case T-502/12; Farmaceutisk Laboratorium Ferring A/S v OHIM; Judgment of 9 April 2014; Language of the case: EN.

**RESULT:** Action upheld and BoA's decision annulled

**KEYWORDS:** Relative grounds, Likelihood of confusion, Identity of the goods and services, Relevant territory, Descriptive element, Internet, Ending of mark, Visual similarity, Phonetic similarity, Conceptual similarity

**FACTS:** The applicant sought to register the word mark **OCTASA** as a CTM for 'preparations and substances for preventing and treating diseases and disorders of the gastro-intestinal tract' in Class 5. An opposition based on a number of earlier trademarks for the words **PENTASA** and **OCTOSTIM** and registered for 'pharmaceutical preparations' in Class 5 was filed on the grounds of Articles 8(1) (b) and 8(5) CTMR. The Opposition Division (OD) dismissed the opposition. The Board of Appeal (BoA) dismissed the appeal. As far as the opposition was based on the earlier marks PENTASA, it held that the opponent had shown genuine use of the earlier Benelux trademark PENTASA in respect of a certain pharmaceutical product. The Board then proceeded to examine the opposition as far as based on the earlier marks OCTOSTIM and held that proof of genuine use of the marks had been furnished only partially in respect of the relevant goods. The Board concluded that there was no likelihood of confusion between the trademarks OCTOSTIM and OCTASA. The General Court (GC) upheld the appeal and annulled the decision of the Board.

**SUBSTANCE:** The Court, following the Board's approach, began its assessment by analysing whether there was a likelihood of confusion between the Benelux word mark PENTASA and the mark OCTASA applied for. As to the relevant public and their level of attention, the Court held that all of the earlier trade marks (save one of them) cover pharmaceuticals in general and therefore also 'preparations and substances for preventing and treating diseases and disorders of the gastro-intestinal tract' which are the specific goods covered by the mark applied for. The relevant public consists of medical professionals and consumers of the above specific products, the level of attention of consumers purchasing medicines to treat such diseases being higher than the average (Paras. 30-38). Addressing the issue of the alleged descriptive nature of the suffix 'ASA', the Court stated that the BoA failed to establish the descriptive character of the suffix 'asa' from the perspective of the end-users of the goods (Paras. 47-48). The evidence relied upon by the Board and which consists of extracts, in English, from two online encyclopaedias, namely Wikipedia and The Free Dictionary concern only the English-speaking end-users of medicines and not non-English-speaking end-users (Para. 49). It is settled Case-Law that an extract from Wikipedia lacks certainty as a source of information (Para. 50). There is no reason for concluding that the medical publications submitted by the CTM applicant and taken into account by the Board are read by the relevant end-users (Para. 51). There is no reason to conclude that those end-users will immediately interpret, without further thought, the suffix 'asa' as a description of that active ingredient. Rather, it is necessary to follow a complex line of reasoning which involves a number of stages in order to interpret the suffix 'asa' as a reference to *mesalazine* (Para. 53). Coming to the comparison of the signs, the Court stated that the principle that first component of word marks may be more likely to catch the consumer's attention than the following components cannot apply in all cases, what matters being the overall impression produced by the signs. The marks at issue display a certain degree of visual and phonetic similarity, given that they are of a similar length and have three syllables (Paras. 58-62). Conceptually, from the perspective of the end-users of the goods in question who do not understand that the suffix 'asa' is a reference to *mesalazine*, neither of the signs at issue, taken as a whole, have any meaning. For those end-users who are also unaware that the beginnings of the signs at issue, namely 'penta' and 'octa', refer to Greek numbers, the conceptual comparison is neutral. From the perspective of that part of the relevant public, neither of the signs refers to any concept whatsoever. However, some of the end-users will recognise that the beginnings of the signs at issue refer to Greek numbers. For those end-users, the signs at issue are conceptually similar in that they both refer to Greek numbers. None the less, given that the signs at issue refer to different Greek numbers, that conceptual similarity must be held to be weak (Paras. 63-68). The GC concluded that the BoA erred by finding that the signs OCTASA and PENTASA were dissimilar and by holding that, as a result, one of the necessary conditions for finding that there is a likelihood of confusion had not been met. The GC therefore upheld the first plea in law and annulled the contested decision, stating that there was no need to examine the other arguments and pleas in law raised by the opponent (Para. 71). However, the GC stated that the findings that the BoA had not established the descriptive character of the suffix 'asa' from the perspective of the end-users of the goods in question and that there is a certain degree of visual and phonetic similarity between the signs at issue also apply to the relevant publics of the other Member States concerned (Para. 72).



**Case T-554/12: Oracle America, Inc. v OHIM; Judgment of 27 March 2014; Language of the case: EN.**

**RESULT: Action dismissed**

**KEYWORDS: Relative grounds, Likelihood of confusion, Identity of the goods and services, Descriptive element, Dissimilarity of signs, Visual dissimilarity, Phonetic dissimilarity, Conceptual dissimilarity**

**FACTS:** The applicant sought to register the word mark AAVA MOBILE as a CTM for goods and services within Classes 9, 38 and 42. An opposition based on the earlier word mark JAVA, registered for goods and services in Classes 9, 35, 37, 38 and 42 was filed on the grounds of Article 8(1) (b) and 8(5) CTMR. The Opposition Division (OD) dismissed the opposition. The Board of Appeal dismissed the opponent's appeal. The opponent filed an action before the General court (GC).

**SUBSTANCE:** The GC dismissed the appeal and made the following findings. The relevant public is made up of the general public and professionals in the fields of science, information technology and telecommunications across the European Union (Para. 25). The level of attention will vary between higher than average for those goods and services which are expensive or aim to meet a particular technological need such as the design and development of computer hardware and software, and average those other goods and services, such as apparatus for recording, transmission or reproduction of sound or images, which constitute goods of mass consumption and which do not necessarily require particular technical knowledge and may be of relatively little monetary value (Para. 27). As to the comparison of the signs, the word 'aava' (which means 'open', 'expansive' or 'wide' in Finnish) has no meaning for the majority of members of the relevant public and will be perceived by the majority of consumers as being distinctive. On the other hand, the word 'mobile' is not distinctive in respect of some of the goods and services covered by the mark applied for (Para. 33). Nevertheless, the word 'mobile', even if it were considered descriptive of most of the goods and services covered by the mark applied for, is not negligible in the overall impression produced by the mark (Paras. 35-38). The relevant public will note the difference between the first letter of those signs, that is to say the letter 'a' in respect of the mark applied for and the letter 'j' in respect of the earlier mark. That difference is intensified by the unusual repetition of the letter 'a' at the beginning of the word 'aava'. The signs, considered as a whole, are neither visually similar (Paras. 43-49), nor phonetically similar (Paras. 50-55). The signs at issue are conceptually different, having each a different meaning, since the mark applied for AAVA MOBILE will evoke, for the Finnish-speaking part of the relevant public, the words 'open', 'expansive' or 'wide' and telecommunications and mobile device hardware or services and, for the non-Finnish-speaking part of the relevant public, only the latter services and hardware. Moreover, the earlier mark, in all Union languages, will refer to the island of Java (Paras. 61-62). Thus, even if the goods and services covered by the signs in question are identical and the earlier mark JAVA has a massive reputation, given the absence of similarity between the signs in question, there is no likelihood of confusion between them (Paras. 67-70). As far as the claim under Article 8(5) CTMR is concerned, the fact that the signs are overall dissimilar is sufficient to dismiss the opposition as far as based on that ground (Paras. 76-78).

**Case T-37/12; Advance Magazine Publishers v OHIM; Judgment of 27 February 2014; Language of the case: EN.**


**RESULT: Action dismissed.**

**KEYWORDS: Relative grounds, Likelihood of confusion, Figurative trade mark, Proof of use, Evidence of use, Complementary evidence, Relevant territory, Time limit, Similarity of signs, Identity of the goods and services, Request of proof of use, Extent of use, Nature of use, Time of use, Place of use, First time on appeal, Declaration, Invoices, Catalogue, New Evidence, General reference to previous submissions.**

**FACTS:** The applicant sought to register the figurative mark represented below as a CTM for 'goods of leather and/or imitation leather; clothing, belts, collars and leads for animals; whips; harness and saddlery; umbrellas; parasols; walking sticks; animal skins, hides; luggage; bags; shopping bags; trunks; travelling bags; hand bags, shoulder bags, backpacks and rucksacks; bicycle bags; purses; wallets; key fobs and key cases; parts and fittings for all the aforesaid goods' in Class 18. An opposition based on the earlier word mark and figurative marks represented below and respectively registered for 'umbrellas' and 'all kinds of umbrellas, sunshades, handles, ribs and canes for these' in Class 18, was filed on the grounds of Article 8(1)(b) CTMR. Upon the request from the applicant, the opponent provided documents in order to show that the earlier marks had been put to genuine use. The examiner upheld the opposition in part and refused



registration of the mark applied for in relation to 'umbrellas; parasols; parts and fittings for all the aforesaid goods' in Class 18 on the ground that there was, in relation to those goods, a likelihood of confusion with the earlier Spanish word mark VOGUE. The examiner rejected the opposition for the remaining goods and ordered each party to bear its own costs. The Board of Appeal (BoA) dismissed the appeal, confirming the reasoning of the first instance.

CTM	Earlier Spanish Marks
TEEN VOGUE	<p>VOGUE</p> 

**SUBSTANCE:** Article 42(2) and (3) CTMR and Rule 22(3) CTMIR. The applicant alleged that the BoA had infringed Article 42(2) and (3) CTMR and Rule 22(3) CTMIR by finding genuine use of the earlier Spanish word mark VOGUE as regards 'umbrellas; parasols; parts and fittings for all the aforesaid goods' in Class 18 by (1) estimating that the documents submitted by the opponent, 'considered as a whole', proved that the earlier Spanish word mark VOGUE had been put to genuine use, whereas such use should have been shown by each of those documents, (2) improperly determining that each item of evidence submitted by the opponent includes necessary indications concerning the place, time, extent and nature of the use which had been made of the earlier national mark, (3) incorrectly taking into account a declaration filed by the director of the company and which had been belatedly filed for the first time before the Board. The GC rejected the first plea in law on the grounds that: (1) Rule 22(3) CTMIR does not provide that each item of evidence must necessarily contain all the information on the place, time, extent and nature of the use of the earlier mark. Whereas either one or more of those items of evidence, considered alone, may not provide indications in respect of all of the mentioned criteria, all the relevant requirements may be satisfied when considering the evidence as a whole (Para. 36); (2) in the present case, the invoices issued to Spanish buyers and the extracts from catalogues concerning the sale of the goods submitted by the opponent were sufficient to establish, as regards the place, time, extent and nature, genuine use of the earlier Spanish word mark VOGUE (Paras. 38-39); (3) the BoA correctly exercised its discretion under Article 76(2) CTMR and in accordance with established Case-Law by considering that the above mentioned declaration (confirming that the catalogues in the case-file had indeed been distributed to Spanish customers and to potential customers and that the codes on the invoices referred to goods bearing the earlier Spanish word mark VOGUE) was not a new item of evidence, but merely confirmed the documents previously filed within the time-limit, (Paras. 42-44). Article 8(1)(b) CTMR. The applicant alleged that the BoA had infringed Article 8(1) (b) CTMR by (1) erring in its comparison of the overall impression given by the marks at issue by not giving consideration, or giving inadequate consideration, to the element 'teen' and (2) failure to identify, in the contested decision, the relevant average consumer, which is relatively highly aware and able to perceive the differences between the marks at issue, thus avoiding any likelihood of confusion. The GC rejected the second plea in law on the grounds that: (1) the presence of the element 'teen' in the mark applied for does not introduce such a dissimilarity between the signs at issue as would lead to erasing their visual and phonetic similarities (Para. 78); (2) the BoA rightly held that, when it comes to everyday consumer goods, frequently bought and used, the level of attention of the relevant public is not, contrary to what argued by the applicant, above average (Para. 62). (3) In 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 Spanish word mark VOGUE, on the one hand, and part of those covered by the mark applied for, on the other, are identical, the Board did not make an error of assessment in finding that there was a likelihood of confusion between those marks (Para. 78).

Case T-209/13; Olive Line International, S.L. v OHIM; Judgment of 11/04/2014; Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Absolute grounds, Descriptive element, Distinctive element, Figurative trade mark, Dominant element

FACTS: The applicant sought to register the figurative mark represented below as a CTM for 'olive oil for food' within Class 29. The examiner refused to register it as a CTM on the ground that it was devoid of any distinctive character under Article 7(1) (b). The Board of Appeal (BoA) dismissed the appeal.

CTMA




**SUBSTANCE:** The General court (GC) recalled, first of all, that the Case-Law settled in respect of three-dimensional trademarks consisting of the shape of the product is also valid in respect of figurative signs consisting of a bi-dimensional representation of the product (Para. 23). Moreover, in the case at hand, being the products sold in a liquid form, the shape of the container (bottle) can be equated to the shape of the product (Para. 25). As regards the products, the GC underlined that the assessment of the distinctive character has to be made in respect of the list of goods as applied for, and not in respect of the particular goods which are actually sold by the applicant (Paras. 26-27). The GC endorsed the reasoning followed by the BoA, which analysed, first, the different constituent elements of the trademark (the shape of the bottle, the colour, and the verbal and the decorative elements) before concluding that the global impression produced by the sign did not differ from other similar bottles (Paras. 31-32). In that regard, the contested decision was sufficiently grounded (Para. 33). According to the GC, the shape in question (as well as its colour) is relatively banal and does not have any characteristic which makes it different from other bottles for olive oil (Paras. 43-44). As regards the descriptive character of the word element 'olive line', the fact that other registered figurative marks also include those words does not demonstrate that such element, considered on its own, is not descriptive (Para. 48). Finally, the GC stated that the public does not consider an element which is descriptive as being distinctive and dominant in the overall image conveyed by the sign (Para. 51).

Case T-47/12; Intesa Sanpaolo SpA v OHIM; Judgment of 27 March 2014; Language of the case: EN.

**RESULT:** Action upheld (BoA's decision annulled).

**KEYWORDS:** Relative grounds, Proof of use, Nature of use, Lack of reasoning

**FACTS:** The applicant sought to register the below figurative mark as a CTM for goods and services within Classes 9, 16, 35, 36, 38, 41 and 42. An opposition was filed against a part of the goods and services in Classes 9, 35, 36 and 38 on the grounds of Article 8(1) (b). The applicant requested proof of the genuine use of the earlier mark on the basis of Article 42(2) CTMR. The examiner rejected the opposition on the ground that, even if the evidence submitted by the opponent met the conditions relating to the place, time and extent of the use of the earlier mark, it did not meet the requirement relating to the nature of the use of that mark. The Board of Appeal (BoA) upheld the appeal lodged by the opponent, annulled the examiner's decision and remitted the case to the first instance. In particular, the BoA held that the opponent had proved genuine use of the earlier mark for the services in Classes 35, 36 and 38 by providing audited financial accounts, invoices, excerpts from the opponent's website and press clippings showing use of the earlier mark for 'financial services, valuation and research services, public relations services and business consultancy services and advisory services'. The BoA thus remitted the case to the examiner for the assessment of likelihood of confusion.

CTM Application	Earlier CTM
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**SUBSTANCE:** The applicant raised the plea that the BoA had infringed Article 42(2) and (3) CTMR. According to the applicant, the BoA's assessment was vitiated by errors relating to the place, time, extent and nature of use of the earlier mark, the link between its use and the services for which it was registered and, lastly, the link between the earlier mark as registered and the mark as used. The General Court (GC), after having heard the parties at the hearing, raised of its own motion the plea that the BoA's decision did not contain a (sufficient) reasoning in relation to the correspondence between the services in respect of which the BoA held that genuine use of the earlier mark was demonstrated and those in respect of which that mark is registered and which were cited as justification for the opposition. The GC pointed out that an absence of or inadequate statement of reasons constitutes an infringement of essential procedural requirements for the purposes of Article 263 TFEU and is a plea involving a matter of public policy which may, and even must, be raised by the European Union judicature of its own motion (Paras. 22-24). The GC noted that 'financial services, valuation and research services and public relations services' are not included as such among the services in respect of which the earlier mark is registered (Para. 27). In this respect, it rejected the Office's explanation, following a written question prior to the hearing, that the BoA's intention had been to determine only the services in respect of which the earlier mark had been used, whereas the issue of whether those services were included in the list of services in respect of which that mark was registered would be examined by the Opposition Division (OD), to which the case had been remitted (Para. 28). The GC expressed a concern that such an approach would lead to an increase in the number of procedures aimed at examining the existence of genuine use, in a way that is contrary both to the letter and to the spirit of Article 42(2) CTMR (Para. 29). The GC held that it is impossible to know, from the BoA's decision, whether, by referring to 'financial services', the BoA meant to designate all or even a part of the services in Class 36 in respect of which the earlier mark is registered, and that it is impossible in practice to ascertain for which services the earlier mark must be deemed to be registered for the purposes of the opposition, which is liable to prevent any subsequent assessment of the likelihood of confusion (Para. 32). Furthermore, as regards 'business consultancy and advisory services' in Class 35, although the BoA concluded that the earlier mark was put to genuine use with regard to such services, it did not refer to the evidence produced which would demonstrate that use (Para. 33). Therefore, the BoA's decision is vitiated by a failure to state reasons in so far as, first, it is not possible to identify from it the services, among those in respect of which the earlier mark is registered and which are cited as justification for the opposition, in connection with which that mark was put to genuine use and, second, it does not state the grounds on which the BoA held that genuine use of the earlier mark had been demonstrated in connection with business consultancy and advisory services, falling within Class 35 (Para. 38).

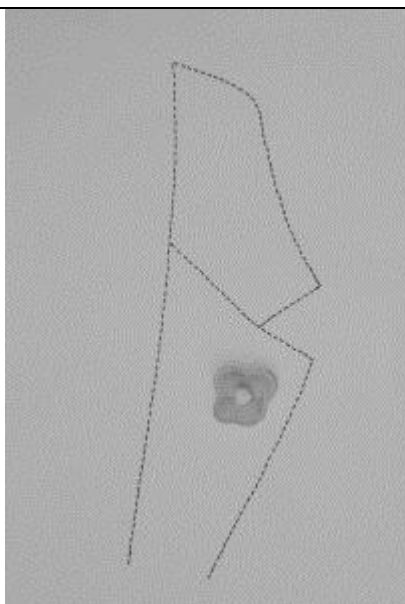
Case T-131/13; Lardini S.r.l. v OHIM; Judgment of 14 March 2014; Language of the case: IT.

**RESULT:** Action dismissed.

**KEYWORDS:** Absolute grounds, Three-dimensional mark, Position mark, Distinctive element, Ornamentation.

**FACTS:** The applicant sought to register the below three-dimensional mark as a CTM for 'jackets, coats, overcoats and trenches' in Class 25. The applicant described the mark as being 'a stylized three-dimensional flower affixed to the lapel of the clothing item. The dotted lines are meant to indicate the position of the mark and do not form part thereof'. The examiner refused the application under Article 7(1) (b) CTMR, considering that it would be perceived rather as an ornament than as a trademark. The Board of Appeal (BoA) dismissed the appeal, considering, on the one hand, that the sign was represented in too imprecise a manner for the relevant public to readily identify and memorize it and, on the other, that it represented an element commonly used to decorate the goods in question.

#### CTM Application




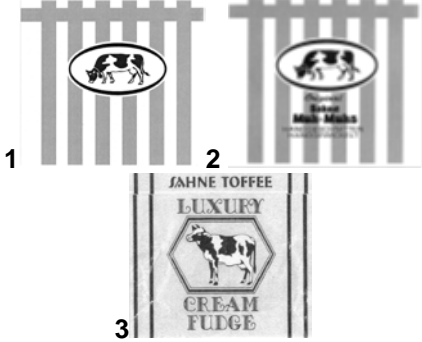
**SUBSTANCE:** The General Court (GC) dismissed the appeal and endorsed the BoA's findings. It held that the sign is very basic and does not present features that could identify it readily in the consumers' eyes as an indicator of origin. Even assuming it was perceived as a flower, given its position close to the buttonhole on the lapel of a clothing item, it is not sufficiently distinctive (Para. 23). The public are used to the presence of ornaments, including flowers, on the lapel of a jacket (Para. 24). The BoA rightly pointed out that brooches, flowers, medals and other such decorative items are affixed to the clothing item in correspondence of the buttonhole on a lapel, but that trademarks are not usually affixed in that specific position, such circumstance contributing to reduce the ability of the sign to perform a trademark function (Para. 26). Furthermore, the BoA had recalled the custom of placing a (natural) flower in the buttonhole of a jacket's lapel. The fact that the flower is not natural, but made of fabric does not change its likely perception as an ornament (Para. 30). It should be noted that ornaments affixed to the lapel of a clothing item such as those covered by the application tend to be seen as part of the visual aspect of such a product, such likely perception of the sign being enhanced by the fact that the ornament is made of the same material as the clothing items to which it is affixed (Para 31). The BoA correctly dismissed the argument of the applicant that the Office had accepted other similar trademarks, given that in those cases the signs concerned were sufficiently stylized and had at least a degree of inherent distinctiveness, contrary to the sign applied for, whose shape is not sufficiently defined (Para. 36).

Case T-623/11; Pico Food GmbH v OHIM; Judgment of 9 April 2014; Language of the case: EN

RESULT: Action dismissed

**KEYWORDS:** Relative grounds, Likelihood of confusion, Figurative trade mark, Identity of goods, Visual dissimilarity, Phonetic dissimilarity, Conceptual dissimilarity, Colour mark, Common element, Reputation, Figurative element, Relevant territory, Enhanced distinctiveness

**FACTS:** The applicant sought to register the figurative mark (in colour) represented below as a CTM for goods within Class 30 (i.a. Candy for food, pastry and confectionery, caramels, pralines, chocolate). An opposition based, amongst others, on the earlier figurative marks represented below, registered for goods in Class 30 (Chocolate bars, chocolate products; sweets, drops, toffees, in particular made by using milk, cream and/or butter), was filed on the grounds of Article 8(1) (b) and, only for marks 1+2, Article 8(5) CTMR. The Opposition Division (OD) rejected the opposition in its entirety. The Board of Appeal (BoA) dismissed the opponent's appeal. The opponent filed an action before the General Court (GC).

CTMA	Earlier Marks: DE
	

**SUBSTANCE:** Even if, as argued by opponent, a consumer were to make an impulse purchase of sweets in certain circumstances, there is nothing to suggest that that would be the case as a matter of course. Furthermore, the mere fact that the relevant public makes an impulse purchase does not, however, mean that that public's level of attention is lower than that of an average consumer (Para. 34). As to the comparison of the goods they were found identical. As to the comparison of the signs, visually, the opponent's argument that if a trade mark is registered in black and white it covers all the colour combinations which are included in the graphic representation was rejected. The GC ruled that: 1) The fact that a mark is registered in colour or, on the contrary, does not designate any specific colour, cannot be regarded as a wholly negligible element in the eyes of consumers (see i.a. Specsavers Case, C-252/12) and 2) The comparison must be made between the signs as they were registered or as they appear in the application for registration. As to the opponent's reference to LIBRO/LIBERO-case (T-418/07), this may be interpreted as meaning that if a Community trade mark is not registered in a specific colour, the proprietor of the mark may use it in a colour or a combination of colours and obtain for it, as the case may be, protection under the relevant applicable provisions, in particular if that colour or combination of colours has become, in the mind of a significant portion of the public, that associated with that earlier mark through the use which its proprietor has made of it (see Specsavers) (Para. 37 et seq). Even although the signs at issue shared a certain similarity having regard in particular to the presence of a figurative element representing a cow (which is allusive for the goods at issue), those signs contained significant visual differences. Phonetically and conceptually the signs are not similar. Even if, as the opponent submits, visual similarity were of greater importance in the present case, in view of the way in which the goods concerned are marketed, that would have no effect on the fact that the signs at issue exhibit significant visual differences. Consequently, even if the earlier marks possess an enhanced degree of distinctiveness through use in the relevant territory, the BoA did not err in finding, in the present case, that there was no likelihood of confusion on the part of the relevant public, in spite of the identity of the goods at issue.



## New Decisions from the Boards of Appeal

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

Please note that the full number including slash has to be entered in our database under 'Appeal N°', without the letter 'R'.  
e.g. Case R 219/2004-1 has to be entered under 'Appeal N°' as: 0219/2004-1

### Decision of the Second Board of Appeal of 14 March 2014 in case R 499/2013-2 (EN)


*Opposition proceedings – Article 8(1)(b) CTMR – comparison of the goods – IP translator*



The CTM applicant sought to register the figurative mark , for goods in Classes 29, 30 and 31.

The opponent filed an opposition on the basis of Article 8(1)(b) CTMR based on Romanian trade mark registration of the



figurative mark  for goods in Classes 29 and 30 covering the class headings in the relevant classes against the above CTM application, also covering the class headings in the relevant classes.

The contested decision considered the mark applied for to have been filed for all the goods appearing in the Alphabetical List, it proceeded in comparing additional goods to the earlier goods and considered some of them to be similar to the earlier goods and consequently rejected them, while allowing the contested sign to be registered for the other goods that were considered dissimilar. The methodology applied by the Opposition Division was based on the understanding, as set out in various Communications of the President of the Office regarding the use and scope of class headings and further to the Court's judgment in 'IP Translator', (see judgment of 19 June 2012, C-307/10), that a CTM covers all the goods in the same class that appear in the Alphabetical List.

The applicant requested that the opposition be rejected and the challenged trade mark application allowed in its entirety.

The Board found that the comparison of the goods in the contested decision went beyond the scope of the opposition as defined by the opponent in its notice of opposition, according to which the opposition was directed against all the goods in Classes 29 and 30 of the contested sign, as they were actually filed and then published in accordance with Article 39 CTMR. Thus, the goods of the CTM applied for are those which were actually filed and then published under Article 39 CTMR.

Consequently, the Board annulled the contested decision to the extent that it accepted or refused the CTM applied for, in respect of goods that were not expressly specified in the contested CTM application.

### Decision of the Second Board of Appeal of 31 March 2014 in case R 1958/2012-2 (EN)

*Cancellation proceedings – Article 52(1)(b) CTMR – bad faith – Article 53(2)(a) CTMR – right to a name according to German law*

The CTM proprietor registered the word mark 'WITTMANN PATCH' for goods in Class 10.

The cancellation applicant, Dietmar Wittmann, filed a request for a declaration of invalidity in respect of all of the goods covered by the CTM on the basis of Article 52(1)(b) CTMR, namely that the CTM proprietor had acted in bad faith when filing the application, and on the basis of Article 53(2)(a) CTMR, namely that use of the CTM may be prohibited pursuant to the cancellation applicant's right to the name 'Wittmann' in Germany under Section 12 of the German Civil Code.

The Cancellation Division rejected the request for a declaration of invalidity of both Community trade marks. It dismissed the ground of invalidity based on Article 52(1)(b) CTMR – bad faith – as it found that the cancellation applicant had not furnished any evidence to prove this claim. With reference to the ground of invalidity based on Article 53(2)(a) CTMR – right to a name according to German law – the Cancellation Division dismissed it as the cancellation applicant is still a co-owner of the CTM proprietor, and has admitted to consenting to use of the name in the USA, thus, it is doubtful whether filing the contested CTM could be considered unlawful.

The Board reasoned that from the circumstances of the case, it cannot be concluded that the CTM proprietor intended through registration, to 'lay its hands' on the trade mark of a third party with whom it has had a contractual relationship. Furthermore, it noticed that the cancellation applicant has not repudiated the fact that he is still a shareholder of the CTM proprietor. Consequently the Board concluded with reference to the claim under Article 52(1)(b) CTMR that the CTM proprietor did not act in bad faith at the time of applying for the registration of the contested mark.

Moreover, the Board found that the cancellation applicant is unsuccessful in invoking a right to a name pursuant to Section 12 of the German Civil Code (BGB) in conjunction with Article 52(2)(a) CTMR. Furthermore, it concurred with the Cancellation Division that the national law was not duly substantiated since the documents were not duly translated.

With reference to the new evidence filed, the Board, in exercising its discretion restrictively, considered that the circumstances surrounding the late submission of the evidence showing that the cancellation applicant is entitled under the national law applicable to lay claim to the right to the name 'Wittmann' against the registration of the CTM do not justify the cancellation applicant's delay in the submission of the proof required of him.

In any event, even if the applicability of the relevant German law were to have been correctly substantiated, the Board notes that the cancellation applicant's allegation that 'Prof. Dr. Dietmar Wittmann, is a German citizen and as such entitled to a right to the name 'Wittmann' under Section 2 German Civil Code is not substantiated as no birth certificate or identity card were submitted. Furthermore, it is highly doubtful that Section 12 BGB – which protects personality rights and not commercial rights – would be applicable to the present case because Prof. Dr. Dietmar Wittmann's identity was not denied by the CTM proprietor and was not misappropriated either because he consented to the commercial use of his name, the product commercialized under the sign 'Wittmann Patch' is the patch he invented and he is still a shareholder of the company commercialising it.

Consequently, the Board dismissed the appeal and confirmed the contested decision.

### Decision of the Fifth Board of Appeal of 27 March 2013 in case R 1200/2013-5 (EN)

*Cancellation proceedings – absolute grounds for refusal – Article 7(1)(g) and (k) CTMR, in conjunction with Article 52(1)(a) CTMR – relative grounds for refusal – Article 8(4) CTMR in conjunction with Article 53(1)(c) CTMR*



The CTM proprietor registered the figurative mark  for goods and services in Classes 30 and 43.

The cancellation applicant based its request on the protected geographical indication ('PGI') **Café de Colombia**, registered in the European Union in relation to *coffee*, applied for on 8 June 2005, published on 28 December 2006 and registered on 12 September 2007. The cancellation applicant invoked Article 53(1)(c) in conjunction with Article 8(4) CTMR, as well as Article 52(1)(a) CTMR in conjunction with Article 7(1)(g) and (k) CTMR.

The Cancellation Division rejected the request and reasoned that the contested CTM does not constitute misuse, imitation or evocation of the cancellation applicant's PGI, nor does it exploit the reputation of the cancellation applicant's PGI, nor is it shown that it would mislead consumers as to the true origin of the goods in relation to which it is used. The contested CTM is also not registered in breach of Article 7 CTMR, as explained earlier, and the application for cancellation also fails on these grounds.

The Board confirmed the decision in respect of the claims based on relative grounds. As regards the re-examination of absolute grounds, the Board concurred with the Cancellation Division stating that Article 7(1)(k) CTMR does not apply to

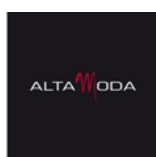
the case at issue. However, the Board accepted the arguments based on Article 7(1)(g) CTMR. It considered that the sign was capable of deceiving the general public about one of the properties (geographical origin) of part of the goods covered by the contested CTM, namely 'tea, cocoa' and 'sugar', and for those goods the CTM was declared invalid.

Consequently, the Board partly upheld the appeal and annulled the contested decision in so far as it did not allow the partial cancellation of the contested CTM on the basis of Article 7(1)(g) CTMR in respect of 'tea, cocoa' and 'sugar' in Class 30.

### The Registry also recommends

#### **Decision of the Fourth Board of Appeal of 20 March 2014 in case R 509/2013-4 (EN)**

*Absolute grounds for refusal – figurative mark – Article 7(1)(b)(c) and 7(2) CTMR – distinctiveness – descriptiveness – goods in Class 3*



The CTM applicant sought to register the figurative mark  for goods in Classes 3, 14 and 25.

The examiner rejected the mark applied for under Article 7(1)(b) and (c) CTMR in conjunction with Article 7(2) CTMR on the ground that that the expression 'ALTA MODA' has a clear and direct meaning for any Italian-speaking consumer as meaning 'high fashion, top fashion or haute couture'.

The contested goods, the subject-matter of the appeal proceedings were 'soaps; perfumery, essential oils, cosmetics' in Class 3. The Board concurred with the examiner's finding and stressed additionally that the figurative elements of the mark applied for are banal and cannot divert the relevant public's attention away from the descriptive message resulting from the expression 'ALTA MODA'.

Consequently, the Board dismissed the appeal.

#### **Decision of the Fifth Board of Appeal of 1 April 2014 in case R 2441/2013-5 (EN)**

*Absolute grounds for refusal – figurative mark – Article 7(1)(b), (c) and 7(2) CTMR – distinctiveness – descriptiveness*



The CTM applicant sought to register the figurative mark  for goods and services in Classes 29, 30 and 43.

The examiner rejected the application in respect of the Class 29 and 30 goods pursuant to Article 7(1)(b), (c), (g) and 7(2) CTMR on the ground that that the contested mark is made up of several components (a compound mark) and both the word and the figurative elements are descriptive and lack distinctiveness. Based on the wording and/or the image of the trade mark the consumer will assume that the goods distributed under this trade mark are actually, or are related to almonds or marzipan. The fact that the goods are not, or do not contain, these goods and/or ingredients results in the relevant consumer being deceived.

The Board concurred with the examiner's finding and reasoned that the two word elements describe two possible ingredients of the goods concerned and their combination is not uncommon, as marzipan is usually made out of almonds, thus, the combination of these words in one trade mark cannot create a different overall impression for the relevant public. Therefore, the expression 'ALMOND MARZIPAN' is also descriptive in relation to the goods at issue. With reference to the figurative element, the Board observed that the presentation made up of two almonds with leaves is, just


as the words 'ALMOND' and 'MARZIPAN', also descriptive for the relevant goods. Given the above, the trade mark applied for showing two almonds and two leaves plus a circle with the two words 'ALMONDS' and 'MARZIPAN' immediately informs consumers without further reflection that the goods applied for consist of almond marzipan or contain almonds and/or marzipan.

Consequently, the Board dismissed the appeal.

#### **Decision of the First Board of Appeal of 19 February 2014 in case R 950/2013-1 (EN)**

*Cancellation proceedings – Article 8(1)(b) CTMR in conjunction with Article 53(1) CTMR – procedural issue – Article 165(4)(b) CTMR*

The CTM proprietor registered the word mark 'mobile.de proMotor' for services in Classes 35, 38, 41 and 42.

The cancellation applicant filed a request for a declaration of invalidity against the Community trade mark based on Article 53(1), in conjunction with Article 8(1)(b), CTMR. The request for a declaration of invalidity relied on Bulgarian trade mark No 51 245 ('the earlier mark') for the figurative mark  which was filed on 27 June 2003 and registered on 20 April 2005 for services in Classes 35, 39 and 42.

The Cancellation Division rejected the request for a declaration of invalidity in its entirety. It reasoned that the documents filed did not provide the Cancellation Division with sufficient information concerning the commercial volume, the duration and the frequency of use. The cancellation applicant thus failed to prove that the earlier mark had been genuinely used in Bulgaria.

The cancellation applicant appealed. It argued that the Cancellation Division ignored the evidence presented, all of which together shows a certain degree and intensity of use of the earlier trade mark.

The Board pointed out that according to Article 165(4)(b) CTMR, a Community trade mark registered or applied for pursuant to the CTMR before the respective dates of accession of Bulgaria, the Czech Republic, Estonia, Cyprus, Latvia, Lithuania, Hungary, Malta, Poland, Romania, Slovenia and Slovakia may not be declared invalid pursuant to Article 53(1) and (2) CTMR if the earlier national right was registered, applied for or acquired in a new Member State prior to the date of their accession. Consequently, taking into account that the contested Community trade mark was applied for on 8 February 2006, that is, prior to the accession of Bulgaria to the European Union (1 January 2007), and that the cancellation applicant's earlier trade mark was registered on 20 April 2005, also prior to the date of accession, the Board concluded that the Community trade mark may not be declared invalid on the basis of this right.

Consequently, the Board dismissed the appeal.