



OHIM's new website experience

OHIM is preparing to launch its new website, in the biggest overhaul our internet presence has seen since the very first site went live fifteen years ago.

Incorporating the most modern technology available, the new site aims to provide users with a full electronic experience, offering them complete and simple solutions through a wide range of online tools and related services... [Page 2](#)

Interview



This month James Nurton talks to Nathalie Dreyfus of Dreyfus & Associés in Paris about new gTLDs, recent developments in France and launching her own firm ... [Page 3](#)

Community Trade Mark

CTM

- IP Translator agreement ... [Page 5](#)

Registered Community Design

RCD

- Case R 979/2011-3; Heijan Yu v Leina-Werke GmbH; BoA Decision of 11 June 2012; Language of the case: EN ... [Page 6](#)

EUTMDN Updates

- Hungary and Slovenia implement Common User Satisfaction Survey [Page 7](#)
- Community Trade Mark Court Meeting [Page 7](#)
- Convergence Programme Meetings at OHIM [Page 7](#)
- Cooperation and Convergence meetings at OHIM [Page 8](#)
- Cooperation Fund tool implementations gear up [Page 8](#)
- Trade mark liaison meeting [Page 8](#)
- Observatory Plenary Meeting [Page 8](#)
- Romania implements CESTO [Page 9](#)
- Spain implements Similarity [Page 9](#)
- Romania and the Czech Republic implement User Satisfaction Survey [Page 9](#)
- WIPO MGS integration into TMclass [Page 10](#)

More News



- Bilateral OHIM – SIPO meeting [Page 10](#)
- Korea-EU IPR Conference on Trade Marks [Page 10](#)
- New OHIM website workshops [Page 11](#)
- OHIM signs MoU with Icelandic Patent Office [Page 11](#)
- TM5 Classification Experts Meeting 2013 – Washington [Page 11](#)
- TMclass integration – Russia [Page 11](#)
- TMview sustainability [Page 12](#)
- Monthly statistical highlights September 2013 [Page 12](#)

Case law



- Luxembourg trade mark and design news [Page 13](#)
- New decisions from the Boards of Appeal [Page 25](#)

Editorial Team:

Mark Kennedy, Mikael Wesslegard

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

OHIM's new website experience

OHIM is preparing to launch its new website, in the biggest overhaul our internet presence has seen since the very first site went live fifteen years ago.

Incorporating the most modern technology available, the new site aims to provide users with a full electronic experience, offering them complete and simple solutions through a wide range of online tools and related services.

While the graphic design layout and aesthetic overhaul will be clear to see when the site goes live, the revamp is much more than just a cosmetic exercise. The online experience will provide easier access to all OHIM processes, including those related to CTMs and RCDs.

The web has been created with the user in mind at every stage of development, with user feedback being fundamental to the site's success. Usability tests were carried out with internal and external users to elicit feedback and in addition regular meetings were held with the user working group and there was a user survey to consolidate feedback.

With this as the backbone of the site's structure, users can now expect to find simple and practical information on the basics of trade marks and designs, as well as useful guidance on the registration procedures and post-registration possibilities once the rights have been granted.

The site will also offer a specific, tailor-made area for registered users, allowing them a wide range of options and possibilities when accessing the web for whatever transaction or consultation they may need to carry out.

A personalised dashboard will offer at-a-glance access to your files and portfolio, showing details such as user communications with OHIM, current account status, news, alerts and much more.

Search capabilities, both basic and advanced, have been enhanced and improved based on feedback from users, with no limitation to RCD or CTM results searched for and all information in 23 EU languages. Moreover, all CTM and RCD resources will now be accessible in a single database: CTM, RCD, Owners and Representatives.

As user anticipation increases in the run up to the go-live, a team of web specialists drawn from the most experienced staff at OHIM, all involved closely with the creation of the new web, will be hosting a number of workshops in cities across the EU, demonstrating to users the advantages and features of the new site.

The workshops are being organised in cooperation with national IP offices and user associations and will be held in the Benelux countries, France, Germany, Italy, Portugal, Spain, and the UK, with more set to be scheduled in 2014.

Another of the initiatives to promote the new site will be the hosting of a live webinar, organised by the OHIM Academy, focusing specifically on the new electronic filing tool.

OHIM's new e-filing system will introduce completely new navigation and filing features, including Taxonomy, new options for users requiring advanced functionalities and a wizard for first-time users which will guide them through the e-filing process.

The webinar will cover the new functionalities through the main e-filing steps: introduction of basic data of the application, navigation to build lists of goods and services, submission and payment.

It will take place at 14:00 CET on 27 November and is open to all users, so book the date and see what's on offer from OHIM's new website.



The James Nurton Interview

This month James Nurton talks to Nathalie Dreyfus of Dreyfus & Associés in Paris about new gTLDs, recent developments in France and launching her own firm

How did you become interested in IP?

I have been involved with trade marks for more than 20 years and have always done IP and IT law. I graduated from Strasbourg University where there is a strong emphasis on trade marks, because the CEIPI is located there. I enjoy the technical side, which is becoming more and more complex, and the creativity.

I worked as an associate for a patent and trade mark firm in Paris until 2004 when I decided to open my own law firm. I couldn't find in another firm the way I wanted to advise my clients, taking into account the explosion of the internet. We are now very involved in the protection of trade marks on the internet, such as in social media, Google AdWords and new gTLDs.

In 2004 companies needed advice in this area and it's still the case today. I started on my own from scratch but we are now 15 people, as well as an administrative team. We established the Dreyfus IPweb platform, which aims to consolidate and summarise all the information that we make available to our clients and has become a common reference. The tool is available as an extranet from a standard browser and the system consists of several modules.

How much trade mark filing do you do?

Last year we filed about 100 CTMs and about 200 French trade marks. We have developed expertise in handling trade mark prosecution at OHIM from the outset.

What do you think about OHIM?

Prosecution at OHIM becomes increasingly technical so we have to update our expertise. The case law and the formal rules are more complex which makes it harder to predict how examiners will decide distinctiveness. Also, you are not allowed any mistake on the formal level. If you forget something, you can lose your action.

It is much stricter than the French system, and it means you need technical people – attorneys – to develop the case law. The difficulty is it is very easy to file a CTM online and OHIM encourages people to file direct and that creates a problem because people think they don't need legal advice. That can be a source of conflicts.

What was the first trade mark you worked on?

I don't remember the very first but I do remember when I opened my law firm I registered the name Dreyfus just before we opened as both a French trade mark and a CTM. There were no oppositions and it was successfully registered.

How could the CTM be improved?

The OHIM website contains a lot of useful information, but it's not always easy to find. However the search engine has improved considerably in the past month.

Another drawback is that when you file oppositions online the number of annexes is limited. If you have many documents to add then it can be an issue because you have to fax everything and it's very time-consuming. When we can use the online system we do because it's very effective.

We had one recent issue where we were sent the wrong certificates and it took too long to send the correct one. That's a problem in providing certainty for the client.

I think OHIM is very strict on distinctiveness and that makes hard to predict whether an application will be registered. Sometimes the Court of Justice will reverse the findings so we have to advise clients to go to court when we think OHIM has been too strict. That is extra expense for the client. It is getting harder to get a semi-distinctive trade mark because the interpretation of the Court of Justice's position has changed. Examination is generally very fast, but perhaps the examiners need to spend some more time on the more difficult cases.

Do you use the registered Community design?

Yes, it's a very good system, maybe even more effective than the CTM system. The process is so quick – you can obtain the registration in a few days if there is no problem.

It's also interesting that we can designate the RCD through the international designs system, so we can get protection in Europe plus Switzerland.

What are the important recent developments in France?

In the courts, there have been some recent changes meaning files are processed more quickly, in about six months. There are fewer oral pleadings and fewer specialist judges for IP. We also have larger damages, as they are no longer awarded on principle. Each case is assessed on its own merits, which is very favourable to trade mark owners. That change to the law came in 2011 and we have seen the benefit in the last two years.

A drawback at INPI is that you cannot renew trade marks online, though we expect that to be possible from the beginning of 2014. That will be very important as INPI has moved outside of central Paris. That makes it less convenient to visit as it takes two and a half hours to get there and back, and there is no mailbox in the middle of Paris.

You have a lot of expertise in internet work. How did you get interested in that?

I became interested in how to defend trade marks on the internet. Ten years ago, a lot of companies were busy defending trade marks in countries where they didn't even have a business but they risked ignoring their domain names, which are seen worldwide. I was involved early on in the UDRP and we are one of the top filers of UDRP cases. It is a good system and we have more than 10 years of case law so it is quite predictable, and it is a good tool for trade mark owners as we know the decision will be enforced.

Now, with the launch of the new gTLDs, there is a new dispute procedure, the URS, which will be quicker and cheaper than the UDRP. But you cannot obtain the transfer or cancellation of the domain name so it is really for obvious cybersquatting cases. It will be a good opportunity for trade mark owners to defend themselves in the new gTLDs when it's really obvious, for example where the domain name is identical to the trade mark.

What do you think about the new gTLDs?

The new gTLDs will be a revolution on the internet. The biggest internet players are part of the project, such as Google and Amazon. I'm convinced the method of searching the web will evolve. One change is that the string will be meaningful. We actually have a recent UDRP case where Tesco filed a UDRP against the domain name tes.co and the question was: should the panellist take into account the ".co" when assessing similarity. That is interesting as it is one of the situations that will appear more often with the new gTLDs as many of them are meaningful words.

The panellist said there is nothing that precludes taking into account the string when assessing similarity, and decided to transfer the domain. If that is followed, it will be very good for brand owners.

The Trademark Clearinghouse can also be a good thing and we are accredited agents for that. Trade mark owners can use it to warn registrants if there is a conflict. It is useful because once you have filed you can use it for any registry and you are also eligible for the Domains Protected Marks List (DPML) that Donuts is planning for its domains. The TMCH is something that is really to be considered with attention.

What's been the biggest change in your career?

The growth of the internet is one thing. The other is the simplification of procedures: more and more countries have joined the Madrid Protocol and we are moving towards a more global trade mark. That has something that has really changed in prosecution. The two changes together mean prosecution work has completely changed in 20 years.

What about the future?

Trade marks will survive, but we will tend to have mega-trade marks with the international trade mark. When even more parts of the world join, it will be easier and cheaper to file a trade mark. Domain names are becoming as important as trade marks, and you also have to look at things like usernames on social media. But they will never compete with trade marks. The law is that you need a trade mark right if you want to file a UDRP, or recover a username on Facebook or twitter. So trade marks will never disappear but they will be tools for actions – the king of the distinctive sign.

IP Translator agreement

Following the publication of the IP Translator judgment in June 2012, OHIM and the EU National IP Offices have been discussing the interpretation of the Nice class headings in various meetings. In May 2013, in under a year, all general indications of the Nice class headings were reviewed and agreement was reached that 11 general indications do not follow the requirements of clarity and precision as set out in the IP Translator judgment. Those general indications will no longer be accepted without further specification. The remaining 186 general indications of the Nice class headings are considered acceptable for classification.

This new practice will soon be announced by way of a Common Communication and implemented in the coming months.

The general indications that were considered to lack the clarity and precision to specify the scope of protection are marked in bold in the following list:

- Cl. 6 – **Goods of common metal not included in other classes**
- Cl. 7 – **Machines** and machine tools
- Cl. 14 – Precious metals and their alloys and **goods in precious metals or coated therewith**, not included in other classes
- Cl. 16 – Paper, cardboard and **goods made from these materials [paper and cardboard]**, not included in other classes
- Cl. 17 – Rubber, gutta-percha, gum, asbestos, mica and **goods made from these materials [rubber, gutta-percha, gum, asbestos and mica]** and not included in other classes
- Cl. 18 – Leather and imitations of leather, and **goods made of these materials [leather and imitations of leather]** and not included in other classes
- Cl. 20 – **Goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics**
- Cl. 37 – **Repair**
- Cl. 37 – **Installation services**
- Cl. 40 – **Treatment of materials**
- Cl. 45 – **Personal and social services rendered by others to meet the needs of individuals**

This new practice has been reflected in OHIM's Manual on Trade Mark Practice, more specifically in the part on examination of classification, by way of a fast-track procedure and will be implemented by OHIM as soon as the new website and new e-filing tool are available to the users at the end of November.

Knowledge Circle Goods and Services

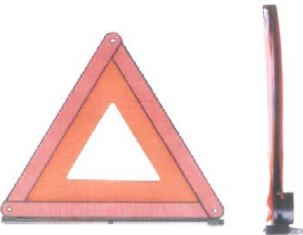
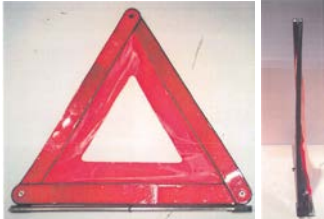
Case R 979/2011-3; Heijan Yu v Leina-Werke GmbH; BoA Decision of 11 June 2012; Language of the case: EN

Case dating from June 2012 but published in this issue of Alicante News because it is highly relevant.

KEYWORDS: Freedom of designer, individual character, novelty

RESULT: Action dismissed

FACTS: The appellant sought to register a design for 'portable traffic warning signs'. The design was published in the Community Designs Bulletin. An application for a declaration of invalidity based on, inter alia, Article 4 CDR was filed by the respondent. The Invalidity Division declared the contested RCD invalid due to lack of novelty, in accordance with Article 25(1)(b) CDR. The appellant requested the Board to annul the decision in its entirety.

CDR applied for	Prior design
	

SUBSTANCE: The Board considers professional drivers of road vehicles to constitute the category of informed users (paragraph 14). The appearance as well as most of the technical characteristics of the warning triangle are determined by Regulation No 27 of the United Nations' Agreement concerning the Adoption of Uniform Technical Prescriptions for Wheeled Vehicles, Equipment and Parts which can be fitted and/or be used on Wheeled Vehicles and the Conditions for Reciprocal Recognition of Approvals Granted on the Basis of these Prescriptions. Since all the Member States of the EU have signed the aforementioned Agreement, including the aforementioned Regulation No 27, also called 'Uniform Provisions for the Approval of Advance-Warning Triangles', the subject of the present invalidity proceedings, according to the Agreement, must look practically identical in all the Member States, as defined in Annex 3 of the Agreement: 'Shape and Dimensions of the Advance-Warning Triangle and of the support'. Any warning triangle, different from the prescribed details will be banned from production and sale by the national authorities (paragraph 19). The aforementioned Provisions leave a very low margin of freedom to 'design' this safety product, limited to the surface pattern of the retro-reflecting strip (outer triangle), the edging between the triangles (which can be less than 5 mm in width), the fluorescent coating of the inner triangle and the legs which should provide stability. However, none of these details appear to be clearly visible on the drawings and photographs submitted. There is no recognisable surface pattern on the photos submitted, the edgings are not visible either and even the back of both designs seems to follow the same technical solution, with only a slight difference in the width of the metallic frame. Under these circumstances it must be concluded that the contested design produces the same overall impression on the informed user as that produced by the earlier design, and that the contested design is not endowed with an individual character as required by Article 4(1) CDR (paragraph 20).

Comment: Previous judgments have established the notion that if the designer's freedom in developing the contested design is restricted, it is more likely that minor differences between the designs will be sufficient to produce a different overall impression on the informed user. Reversed, this implies that, if the designer enjoys a high degree of freedom in developing a design, the conclusion can be drawn that designs which do not have significant differences produce the same overall impression on an informed user (judgment of 18/03/2010, T-9/07, 'Metal rappers', paragraph 72 and judgment of 09/09/2011, T-10/08 'Internal combustion engine', paragraph 33). The designer's degree of freedom in developing their design is established, inter alia, by the constraints of the features imposed by the technical function of the product or an element thereof, or by statutory requirements applicable to the product. Such constraints result in a standardisation of certain features, which will thus be common to the designs applied to the product concerned.

Moreover, restraints such as that a product must be inexpensive, safe for children and fit to be added to the products which they promote (for promotional items) are factors capable of limiting the designer's freedom (judgments of 09/09/2011, T-10/08, 'Internal combustion engine', paragraph 32; and of 18/03/2010, T-9/07, 'Metal rappers', paragraphs 67, 70). See also the BoA decision in the case 'Rocking-Chairs' where the BoA concluded that the freedom of the designer when designing a rocking chair is only limited to the extent that the design must be functional, i.e. it must at least include a seat with a back rest and be constructed in a way that allows the user of the chair to rock. Thereby the functional requirement of a rocking-chair is, in principle, fulfilled by any structure that allows for the user of the chair to rock. This led the BoA to the conclusion that regarding size and shape of the seat, the construction of the chair and the materials used, the designer's freedom is almost unlimited (BoA decision of 14/06/2012, R 2194/2010-3 'Rocking-chairs').

In the light of the aforementioned cases, in the current case the designer's freedom must be considered to be limited to a very high degree and thus the Board might have come to a different conclusion if the design applied for had displayed only minor deviations visible in the application.

Knowledge Circle Designs

EUTMDN Updates

Hungary and Slovenia implement Common User Satisfaction Survey

The Common User Satisfaction Survey is a Cooperation Fund project, which allows for a common approach to carrying out surveys across participating offices. It also allows for the cross-linkage of other projects such as Quality Standards.

Hungary and Slovenia have now implemented the project, taking the number of integrated EU IP offices to 19.

Implementations are the result of onsite support from the USS integration team, in partnership with the project working group members.

Find more information about the Cooperation Fund projects at www.tmdn.org/

Community Trade Mark Court Meeting

The eighth meeting of the Community Trade Mark Court took place at OHIM on 24 and 25 October.

Judges, lawyers and other experts from the legal profession gathered in Alicante to discuss a range of issues relating to the Community trade mark, particularly recent case law and developments in this area.

Convergence Programme Meetings at OHIM

Members of the Absolute Grounds and Relative Grounds Working Package 1 of the Convergence Programme met at OHIM on 21 and 22 October.

Both projects aim to establish a common practice among EU IP Offices in those areas.

The Absolute Grounds project (CP3) focuses on the different interpretations of the examination of absolute grounds for refusal regarding figurative trade marks with purely descriptive words or expressions.

On the other hand, the objective of the Relative Grounds project (CP5) is to converge the interpretations on how to deal with non-distinctive or weak components of trade marks in the context of the examination of relative grounds for refusal (likelihood of confusion).

Cooperation and Convergence meetings at OHIM

A number of Cooperation Fund working groups met at OHIM between 9 and 11 October, with representatives of EU National Offices, User Associations and a dedicated User Group for the Software Package – Trade Mark e-filing project.

The working groups heard updates on the recent Cooperation Fund implementations and the status of the working group projects.

The Convergence Programme preparatory workgroup on Absolute Grounds – Figurative Marks also met, with participants from the UK, Danish and German national offices.

Cooperation Fund tool implementations gear up

The Cooperation Fund and EU national and regional IP offices have now carried out 176 implementations of the specially developed suite of IT tools across the European Trade Mark and Design Network.

The Finnish office became the first one to test the integration of trade mark e-filing with the Software Package Back Office systems. Finland was also the first office to implement e-filing in November 2012.

Meanwhile, a team of OHIM staff has visited the Polish Patent Office, implementing the Back Office systems there. The Back Office is by far the largest single project carried out by the Cooperation Fund to date

The total number of intents to implement the Cooperation Fund tools currently stands at 364.

Trade mark liaison meeting

The 10th Liaison Meeting on trade marks was held at OHIM between 7 and 8 October.

35 international Industrial Property Offices, including WIPO and all of the EU national offices, met in Alicante to discuss issues including Harmonisation of TM Classification practice of G&S and Convergence of Class headings.

The agenda also covered updates in the areas of Figurative Marks, the Scope of protection of B&W Marks and the Likelihood of Confusion.

Four User Associations were also present at the two-day meeting.

Observatory Plenary Meeting

On 28 and 29 October, the European Observatory on Infringements of Intellectual Property Rights held its annual plenary meeting.

Some 80 representatives from the Member States of the European Union and the European Commission services, as well as representatives from the private sector, civil society and international organisations, met on OHIM's premises in Alicante to participate in the event.

The plenary meeting gave an opportunity to present and discuss on-going work of the Observatory. It was also a chance for the Observatory stakeholders to agree on the future activities and deliverables for this network of experts.

Participants were able to share their views and experience in discussion panels. Specific exchanges were devoted to the results of two studies published by the Observatory: 'Contribution of IPR intensive industries to the economic performance and employment in the European Union' and 'European citizens and intellectual property: perception, awareness and behaviour'.

Similarly, discussions revolved around two database tools with information on counterfeit goods: Enforcement and ACIST databases.

Finally, specific attention was given to intellectual property (IP) in the digital world, as well as legal and international cooperation matters in IP.

Romania implements CESTO

The Romanian Office has implemented the Common Examiner Support Tool (CESTO). This brings to four the total number of tool implementations.

A total of 18 national and regional EU offices have expressed their intention to implement the tool.

CESTO enables examiners to carry out automatic searches in several databases to help them in gathering all relevant information for taking decisions on Absolute Grounds.

Spain implements Similarity

The Spanish IP office has implemented the Similarity tool.

This latest implementation brings the total number of offices using Similarity to eight, including OHIM.

Similarity is a search tool which allows users to assess whether specific goods and services are considered similar, and to what degree, or dissimilar according to the participating IP Offices.

Romania and the Czech Republic implement User Satisfaction Survey

The Romanian National Office and the Czech National Office have implemented the User Satisfaction Survey project.

The latest two integrations take the total number of national and regional EU IP offices using the tool to 14.

Prior to implementation, national offices received onsite training from the USS integration team, in partnership with the project working group members.

The project also allows for the cross-linkage of other Cooperation Fund projects, such as Quality Standards.

The User Satisfaction Survey tool, which allows for a common approach to carrying out surveys across participating offices, forms a key part of the European Trade Mark and Design Network.

This latest integration takes the total number of Cooperation Fund tool implementations to 179.

WIPO MGS integration into TMclass

On 14 October, OHIM and WIPO announced the integration of WIPO's Madrid Goods and Services Manager (MGS) data into TMclass, OHIM's free online goods and services classification tool.

The integration is a result of cooperative work between the two offices, in order to promote their common objectives and policy on trade mark information dissemination.

It will help to enhance the quality, value and flow of such information among WIPO and OHIM's respective member states, stakeholders and users.

Today's integration will facilitate transparent and comprehensive information useful to trade mark applicants and owners at global level.

TMclass is available in 26 languages, including Japanese, Korean and Turkish, and is available through <http://tmclass.tmdn.org/ec2/>.

MGS is WIPO's free online goods and services classification and translation tool, and is available in 15 languages at <http://www.wipo.int/mgs/index.jsp>.

More News



Bilateral OHIM – SIPO meeting

A high level meeting took place on 17 October in Munich between Commissioner Tian Lipu from the State Intellectual Property Office (SIPO) of China and OHIM's President, António Campinos.

They discussed bilateral cooperation activities between both organisations, such as the implementation of Designview, developments in the Search image project, and traineeships for SIPO staff at OHIM.

The role of the OHIM IP attaché in China was also discussed.

The Implementation Plan for those activities was signed at the meeting.

Korea-EU IPR Conference on Trade Marks

A conference co-organised by OHIM, KIPO (Korean Intellectual Property Office) and ECCK (European Chamber of Commerce in South Korea) took place in Seoul on 23 October and in Busan on 24 October.

The conference brought together IP specialists from OHIM, KIPO and the private sector to give presentations on trade mark and design related issues, ranging from registration to enforcement and litigation.

The event was aimed at companies seeking practical tools to protect their IP assets in Korea and internationally.

New OHIM website workshops

OHIM is preparing to launch its new website, providing better access for users and enhanced electronic services and search facilities.

In the run up to the go-live, a team of web specialists will be hosting workshops in cities across the EU, demonstrating to users the advantages and features of the new site.

The workshops are being organised in conjunction with national IP offices and user associations and will be held in Spain, France, Portugal, UK, Italy, Germany and the Benelux countries.

OHIM signs MoU with Icelandic Patent Office

OHIM has signed a Memorandum of Understanding with the Icelandic Patent Office.

The agreement was formalised in Alicante between Mrs Borghildur Erlingsdóttir of the Icelandic Patent Office and OHIM's President, António Campinos.

This MoU aims to strengthen the cooperation initiatives between both organisations in different fields of activity, namely the participation of Iceland in the TMview and Designview tools, TMclass, harmonisation of trade mark and design practice, training and enforcement related activities.

The International Cooperation Programme will be in charge of implementing this new cooperation framework.

TM5 Classification Experts Meeting 2013 – Washington

OHIM, as the leading office of the TM5 Taxonomy & TMclass link project, organised a meeting of the TM5 Classification Experts in Washington DC in October.

This was the first time that the classification experts from all the TM5 member offices, JPO, KIPO, OHIM, SAIC and USPTO, met to discuss common issues and interests concerning classification.

It marked a milestone in the progress of the TM5 Taxonomy & TMclass link project.

TMclass integration - Russia

OHIM has announced the integration of the Russian Federal Service for Intellectual Property (ROSPATENT) into TMclass.

This latest addition brings a total of 33 national and regional IP Offices, including OHIM, into the classification of goods and services tool.

TMclass now allows users to search for terms in any of the 27 available languages.

This integration has taken place within the framework of the EU-Funded P4M-IP Project between OHIM and Rospatent.

TMview sustainability

During the recent round of meetings with international IP offices and organisations in Geneva, President Campinos signed addenda to memorandums of understanding on the TMview cooperation project with the national offices of Korea, Mexico, Morocco, Norway, and Turkey. These are the offices which have triggered TMview's globalisation.

The aim of these addenda is to safeguard the timely provision and quality of their trade mark data in TMview from a long term perspective.

In practice, this means that participating office data will be updated on a daily basis. Moreover, regular reports will be exchanged to ensure data quality expectations are met.

All in all, this establishes regular interactions between the participating offices in relation to the TMview application and user feedback.

Monthly statistical highlights* September 2013 compared with September 2012

	2013	2012
Community trade mark applications received	9 153	8 336
Community trade mark applications published	8 270	7 179
Community trade marks registered (certificates issued)	8 389	8 162
Registered Community designs received	7 369	6 032
Registered Community designs published	6 354	5 667

* Statistical data for the current month are not definitive. Figures may vary subsequently.



Luxembourg Case Law

A: Court of Justice: Orders

Case C-479/12; H. Gautzsch Großhandel GmbH & Co. KG / Münchener Boulevard Möbel Joseph Duna GmbH; Opinion of Advocate General M. Wathelet, 5 September 2013, Language of the case: DE

KEYWORDS: Burden of proof, Circles specialized in the sector, Conflict of design with prior design, Corrective measures, Disclosure outside the EU, Disclosure within the EU, Individual character, Infringement, Normal course of business, Novelty, Permanent Injunctions, Preliminary ruling, Time limit, Unregistered Community design.

Factual background

Münchener Boulevard Möbel Joseph Duna GmbH ('the claimant') markets a garden pavilion developed during the fall of 2004. During April / May 2005 the (unregistered) design was published in the claimant's 'new products leaflet' which was printed in 300-500 copies and distributed to retailers, wholesalers and purchasing associations. This raises the question of whether such *intermediaries* are part of the relevant specialised circles in the sense of 11(2) CDR, in order to substantiate the disclosure of an UCD, or whether the relevant specialised circles consist exclusively of designers and manufacturers.

During 2006, Gautzsch Großhandel GmbH & Co. KG ('the defendant') started marketing the garden pavilion 'Athen' produced by the Chinese company Zhengte.

The claimant considered 'Athen' to be a copy of its garden pavilion and initiated an infringement action in Germany based on unregistered Community design rights, under Article 19(2) CDR. The claimant was also seeking pan-European coercive measures to accompany an injunction prohibiting any future of the infringing design, under 89(1)(a) and (d) CDR.

The defendant in turn claimed that the Chinese manufacturer had exhibited the design to European customers in a showroom in China during March 2005 and that a sample had been sent to a Belgian firm in June 2005. On the basis of these facts, the defendant challenged the novelty of the claimant's UCD, under Article 5 CDR.

Furthermore the defendant argued that the claimant had been aware of the existence of the 'Athen' model since September 2005 and of the fact that it had been sold by the defendant since August 2006. The defendant thus considered the claimant's claims to be time-barred and forfeited.

The first instance German court (*Landgericht*) upheld the claimant's action, but in part only. It considered the UCD to be valid, held that the contested design was infringing and ordered the payment of damages and communication of business documents. The requests for an order to prohibit future use of the contested design and the destruction of the specimens were however dismissed, having regard to the fact that the 3-year protection recognised to UCDs had lapsed in the meantime.

The German Court of Appeal dismissed the appeal. It considered that the UCD had been validly disclosed within the meaning of Article 11 CDR, and that its novelty could not be challenged on account of the mere exhibition of the 'Athen' design in the Chinese manufacturer's premises, given that such fact could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community (Article 7 CDR). The same reasoning applied to the communication of the 'Athen' design to one single European operator.

The German Court of Appeal held that the onus of proving that the contested design is a copy of the UCD lies on the claimant. The close similarity of the two designs was however an element which supported the presumption that the defendant had not developed its own design in an independent manner, within the meaning of Article 19(2) CDR.

Finally, the German Court of Appeal considered that the infringement action was not time-barred according to the German law.

A further appeal was brought before the *Bundesgerichtshof* ('the referring Court') which asked the Court of Justice the following questions:

1. Is Article 11(2) of Regulation (EC) No 6/2002 to be interpreted as meaning that, in the normal course of business, a design could reasonably have become known to the circles specialised in the sector concerned, operating within the European Union, in the case where images of the design were distributed to traders?
2. Is the first sentence of Article 7(1) of Regulation (EC) No 6/2002 to be interpreted as meaning that a design could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union, even though it was disclosed to third parties without any explicit or implicit conditions of confidentiality, in the case where:
 - a. it is made available to only one undertaking in the specialised circles, or
 - b. it is exhibited in a showroom of an undertaking in China which lies outside the scope of normal market analysis?
3. (a) Is Article 19(2) of Regulation (EC) No 6/2002 to be interpreted as meaning that the holder of an unregistered Community design bears the burden of proving that the contested use results from copying the protected design?

(b) If Question 3(a) is answered in the affirmative: Is the burden of proof reversed or is the burden of proof incumbent on the holder of the unregistered Community design eased if there are material similarities between the design and the contested use?
4. (a) Is the right to obtain an injunction prohibiting further infringement of an unregistered Community design, provided for in Article 19(2) and Article 89(1)(a) of Regulation (EC) No 6/2002, subject to limitation in time?
(b) If Question 4(a) is answered in the affirmative: Is the limitation in time governed by European Union law and, if so, by which provision?
5. (a) Is the right to obtain an injunction prohibiting further infringement of an unregistered Community design, provided for in Article 19(2) and Article 89(1)(a) of Regulation (EC) No 6/2002, subject to forfeiture?
(b) If Question 5(a) is answered in the affirmative: Is the forfeiture governed by European Union law and, if so, by which provision?
6. Article 89(1)(d) of Regulation (EC) No 6/2002 to be interpreted as meaning that claims for destruction, disclosure of information and damages by reason of infringement of an unregistered Community design which are pursued in relation to the entirety of the European Union are subject to the law of the Member States in which the acts of infringement were committed?

Summary of the Advocate General's Opinion

1. *The 'circles specialised in the sector concerned'*

The referring Court favoured a generous interpretation including not only designers and producers but also retailers and wholesalers in the circles specialised in the design in question. This standpoint was shared by the Advocate General (Para. 34-36), according to whom the notion of 'circles specialised in the sector concerned' encompasses all operators which take part in the trade of the goods at issue, including designers, advertisers, distributors and sellers (Para. 38). Thus a design can reasonably have become known to the circles specialised in the sector concerned during their normal course of business in accordance with 11(2) CDR, to the extent that such design has been made available to retailers and wholesalers (Para. 39).

2. *The notion of 'disclosure'*

The issue is whether communication of a design to a single European operator (by postage of a leaflet) or exhibition of a design to a limited number of European operators in the showroom of a manufacturer in China (that is, away from the normal focus of the operators in the European market) is a disclosure for the purpose of Article 7 CDR.

Regarding the communication of a design to a single European operator, the Advocate General noted that the legislator has chosen the plural wording 'circles specialised'. It thus cannot be deduced from the legislation that information to a single undertaking would suffice to make the design 'known in the normal course of business to the circles specialised in the sector concerned, operating within the Community' (Paras. 44-45).

Regarding the communication of a design in the showroom of a manufacturer in China, the Advocate General observed that 7(1) CDR provides for two requirements. One absolute, namely that a prior design has been made public anywhere

in the world and one relative, requiring that it should have come to the knowledge of the relevant specialised circles within the European Union (Para. 51). The geographic location as such does thus not affect this assessment (Para. 48). The relevant question is rather whether the addressees of the disclosure had a reasonable chance to have access to this disclosure (Para. 53).

On the facts of the case, the Advocate General considers that the presentation of a design in the showroom of a company located in China does not suffice, in itself, to qualify a disclosure within the meaning of Article 7 CDR. The Advocate General goes on to say that the situation would have been different had this presentation been made in an international fair in China, attended by European professionals of the sector concerned (Para. 55).

3. *Burden of proof*

Article 19(2) CDR requires the contested design to be a copy of the UCD in order for the holder to prevent a third party from using it. The question is whether the onus of proving that the contested design is a copy lies on the UCD holder.

The determination of the burden of proof is in principle a matter to be governed by the national law, as for all procedural aspects of litigation (Article 88(3) CDR). However, the Advocate General considers that this issue affects the substance of the right and is therefore governed by the law of the European Union. He thus made an analogy with the case-law concerning the exhaustion of trade mark rights.

In its Judgment of 18 October 2005, Case C-405/03, *Class International BV (AQUAFRESH)* ECR I-8735, the Court of Justice held that it was for the trade mark holder to substantiate the enforceability of the exclusive trade mark rights by establishing that the goods in transit were necessarily going to be put on the European market. The Advocate General is of the opinion that, due to the close similarity between the CTMR and the CDR, the solution adopted by the Court of Justice in *Class international* should be applied *mutatis mutandis* to the proof of the copy of an UCD (Para. 69-71).

The holder of an UCD must therefore bring evidence that the contested design is a copy of an UCD. The burden of proof can however be alleviated, according to the national law, where such proof is impossible to adduce. The national judge can thus make use of presumptions or of measures of enquiry, or decide that it is for the defendant to rebut the preliminary elements of proof submitted by the claimant (Para. 77).

4. *Prescription and forfeiture*

A Community design court having international jurisdiction pursuant to Article 82(1) CDR must in principle deliver an order prohibiting use of a later infringing design, such order may be effective in the entire area of the European Union (see by analogy Judgment of 12 April 2011, Case C-235/09, *DHL Express France (WEBSHIPPING)*, Para. 54).

There may however exist 'special reasons' for not adopting an order prohibiting use of the infringing sign (Article 89(1) CDR), in particular where further infringement or threatened infringement on the part of the defendant is no longer possible. This may be so where the earlier RCD or UCD has lapsed or has been revoked on the date of the adoption of the order (see by analogy Judgment of 14 December 2006, Case C-315/05, *Nokia*, Para. 35; of 27 April 2006, Case C-145/05, *Levis Strauss & CO. (LEVI STRAUSS/ARCUATE)*, Para. 36).

The Advocate General however notes that 'prescription' is not one of those 'special reasons' which only concern factual (rather than legal) circumstances surrounding a given case (Para. 85).

The Advocate General goes on to say that prescription and forfeiture are matters to be governed by the national law, as for all procedural aspects of litigation (Article 88(3) CDR), *provided* that the national provisions are not less favourable than those governing similar domestic situations (principle of equivalence) and that they do not render impossible in practice or excessively difficult the exercise of rights conferred by the Community legal order (principle of effectiveness). According to the principle of effectiveness, the period for prescription cannot start running before the design right holder has been made aware of the violation of its exclusive right. Moreover, the period prescription and forfeiture cannot expire before the violation of the exclusive right is put to an end (Para. 90).

5. *Applicable law*

Under Article 11 of Directive 2004/48/EC of 29 April 2004 on the enforcement of intellectual property rights, Member States shall ensure that, where an infringement of an intellectual property right, the judicial authorities may issue against the infringer an injunction aimed at prohibiting the continuation of the infringement.

The obligation to attach coercive measures (such as an injunction can be subject to a recurring penalty payment) to the order prohibiting infringing use does not allow for any exceptions. According to Article 89(2) CDR, coercive measures

must be ordered by applying the national law of the Member State in which the Community design court has its seat (Para. 98).

According to Article 89(1)(d) CDR, the Community design court should however apply the law of the Member State in which the acts of infringement or threatened infringement were committed in respect of measures other than the coercive ones including the right to information, corrective measures (recall from the channels of trade, destruction), award of damages, publicity measures etc. (Para. 99).

Case C-661/11; Martin y Paz Diffusion SA v David Depuydt, Fabriek van Maroquinerie Gauquie NV., Preliminary ruling of 19 September 2013, Language of the case: FR

KEYWORDS: Agreement, Infringement, Scope of proceedings

The preliminary ruling concerns the scope of protection of the exclusive right of the trademark holder as set down by Article 5 of Directive 89/104.

Factual background

The factual background relates to the deterioration of a contractual relationship between Martin y Paz and Gauquier, two companies with a long term agreement to exploit the same marks but for different leather products. The questions referred by the *Cour de Cassation de Belgique* ('the referring Court') are:

1. (a) Must Article 5(1) and Article 8(1) of [Directive 89/104] be interpreted as meaning that the exclusive right conferred by the registered mark can definitively no longer be asserted by its proprietor against a third party, in respect of all goods covered by it at the time of registration:
 - where, for an extended period, the proprietor has shared the use of that mark with that third party in a form of co-ownership for part of the goods covered;
 - where, when that sharing was agreed, the proprietor gave the third party its irrevocable consent to use of that mark by the third party in respect of those goods?

(b) Must those articles be interpreted as meaning that application of a national rule, such as that according to which the proprietor of a right cannot exercise that right in a wrongful or abusive manner, can lead to a definitive prohibition on the exercise of that exclusive right for part of the goods covered or as meaning that that application must be restricted to penalising the wrongful or abusive exercise of that right in another way?

2. (a) Must Article 5(1) and Article 8(1) of [Directive 89/104] be interpreted as meaning that, where the proprietor of a registered mark ends its undertaking to a third party not to use that mark for certain goods and thus intends to recommence that use itself, the national court can none the less definitively prohibit it from recommencing that use of the mark on the ground that it amounts to unfair competition because of the resulting advantage to the proprietor of the publicity previously made for the mark by the third party and possible confusion in customers' minds, or must they be interpreted as meaning that the national court must adopt a different penalty which does not definitively prohibit the proprietor from recommencing use of the mark?

(b) Must those articles be interpreted as meaning that a definitive prohibition on use by the proprietor is justified where the third party has, over a number of years, made investments in order to bring to the attention of the public the goods in respect of which the proprietor has authorised it to use the mark?

FINDINGS OF THE COURT

- 1) On article 8 of Directive 89/104 the Court Stated that an interpretation of that provision, which relates to licences, is irrelevant in regard to the resolution of the dispute in the main proceedings. The fact, that relations between the parties to the main proceedings were never governed by a licence, is referred to in the order for reference and was confirmed by Martin Y Paz's reply to the Court's questions during the oral procedure. In that regard, while it submitted that the shared use of the 'Nathan' goods and of the marks relating to those goods was similar to a contractual relationship in the nature of a licence, Martin Y Paz acknowledged that that use did not really have the characteristics of such a relationship. The Court therefore declared the request for a preliminary ruling inadmissible in so far as it relates to the interpretation of Article 8 of Directive 89/104 and admissible as to the remainder.

- 2) On the other questions related to Article 5 of Directive 89/104, the Court gives important guidance in terms of interpreting the concept of exclusive right conferred by a mark:
- Articles 5 to 7 of Directive 89/104 effect a complete harmonisation of the rules relating to the rights conferred by a trade mark and accordingly define the rights of proprietors of trade marks in the European Union (see, *inter alia*, Joined Cases C 414/99 to C 416/99 Zino Davidoff and Levi Strauss [2001] ECR I 8691, Para. 39; Case C 127/09 Coty Prestige Lancaster Group [2010] ECR I 4965, Para. 27; and Case C 482/09 Budějovický Budvar [2011] ECR I 8701, Para. 32).
 - Except for the specific cases governed by Article 8 *et seq.* of that directive, a national court may not, in a dispute relating to the exercise of the exclusive right conferred by a trade mark, limit that exclusive right in a manner which exceeds the limitations arising from Articles 5 to 7 of the directive.
 - Consent, such as that allowing person A to use signs which are identical to Person B's trade marks in respect of handbags and shoes, does indeed result in the exhaustion of the exclusive right within the meaning of Article 7 of Directive 89/104, but only in respect of the individual items of the product which were first put on the market in the European Economic Area (EEA) by the party who received the consent (see, to that effect, Case C 173/98 Sebago and Maison Dubois [1999] ECR I 4103, Paras. 19 and 20, and Coty Prestige Lancaster Group, Para. 31).
 - From that case-law and from the actual wording of Article 7 of Directive 89/104 it is clear that the third party who receives that consent and who may therefore invoke the exhaustion of the exclusive right in respect of all the individual items of the goods covered by that consent which it puts on the market in the EEA, may no longer invoke such exhaustion once the consent is withdrawn.
 - As regards the limitations on the exclusive right which inherently follow from Article 5 of Directive 89/104 as such, it is settled case-law that the exclusive right under that provision was conferred in order to enable the trade mark proprietor to protect his specific interests as proprietor of that mark, that is, to ensure that the trade mark can fulfil its functions. Therefore, the exercise of that right must be reserved to cases in which another party's use of the sign adversely affects or is liable adversely to affect one of the functions of the trade mark. Those functions include not only the essential function of the trade mark, which is to guarantee to consumers the origin of the goods or services in question, but also its other functions, in particular that of guaranteeing the quality of those goods or services or those of communication, investment or advertising (see, to that effect, Budějovický Budvar, Para. 71 and the case-law cited, and Case C 323/09 Interflora and Interflora British Unit [2011] ECR I 8625, Paras. 32 to 41).
 - It is for the referring court to examine, if Gauquie is to be regarded, since the expression by Martin Y Paz of its wish to exercise its exclusive right against it, as using signs which are identical to Martin Y Paz's trademarks without its consent, in accordance with what has been stated above, to assess whether, in the circumstances of the present case, that use adversely affects or is liable adversely to affect one of the functions of those marks. If it were established that such a detriment or risk of detriment exists, it would have to be held that depriving Martin Y Paz of the possibility of exercising its exclusive right against that use by Gauquie exceeds the limitations arising from Articles 5 to 7 of Directive 89/104.
 - A national court may impose a penalty on the proprietor of a trade mark or order it to pay compensation for the damage suffered if it finds that that proprietor has unlawfully withdrawn the consent by which it allowed a third party to use signs which are identical to its marks. However, as was stated by the Polish Government and by the Commission, as well as by the Advocate General in Paras. 78 to 83 of his Opinion, a finding that there has been such conduct cannot have the effect of prolonging, by a court decision and for an unspecified period, the shared use of those marks where the companies concerned no longer have the joint intention of sharing their use.
 - In conclusion the Court held that the answer to the questions referred is that Article 5 of Directive 89/104 precludes a proprietor of trademarks which, in a situation where there has been use shared with a third party, had consented to the use by that third party of signs which are identical to its marks in respect of certain goods in Classes for which those marks are registered and which no longer consents to that use, from being deprived of any possibility of asserting the exclusive right conferred upon it by those marks against that third party and of itself exercising that exclusive right in respect of goods which are identical to those of that third party.

Case C-168/09; Flos SpA v Semeraro Casa e Famiglia SpA and Assoluce – Associazione nazionale delle Imprese degli Apparecchi di Illuminazione acting as intervener; Preliminary Ruling of 27 January 2011; Language of the case: IT

This preliminary ruling concerns the interpretation of Article 17 of Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs ('Relationship to copyright').

FACTS: The plaintiff brought proceedings in a national court against the defendant, claiming that the latter had been infringing the plaintiff's rights by importing and marketing a lamp which imitated the stylistic and aesthetic features of the

plaintiff's lamp. The plaintiff's lamp was found to have copyright protection as an industrial design pursuant to national law. The national court ordered the defendant's lamps to be confiscated and prohibited the defendant from the continued marketing of those lamps. As regards the proceedings on the substance, the national court decided to stay the proceedings and refer to the CJ questions concerning the cumulation of protection, in essence, whether Article 17 of Directive 98/71/EC precludes legislation of a Member State which excludes from copyright protection designs which were in, or entered into, the public domain before the date of entry into force of the legislation that introduced such protection into the domestic legal order of that State.

SUBSTANCE: In its reasoning, the CJ identified two possible scenarios: 1) designs which, before the date of entry into force of the national legislation transposing Directive 98/71, were in the public domain because they had not been registered as designs and 2) designs which, before that date, were previously registered but entered the public domain because the protection deriving from registration ceased (Para. 29). If the design had not been previously registered, it does not fall under the provisions of Art. 17 (Para. 33), but may still be subject to protection by copyright if other Directives provide for it (Para. 34). If the design was protected by a design right in a Member State and met the conditions under which copyright protection is conferred by that Member State, then it is eligible for copyright protection in that Member State (Para. 41). The decision of whether the design had been registered under national law is to be made by the national court (Para. 31). Thus, the CJ held that if the design had been previously registered and entered the public domain before the national law transposing Directive 98/71/EC came into force, Article 17 precludes national legislation hindering copyright protection for ex-registered design meeting all the requirements for copyright protection. (Paras. 43-44).

Regarding the issue of revival of copyright protection for designs which were in the public domain at the entry into force of national legislation transposing Directive 98/71/EC, the interests of third parties who have in good faith relied on the availability of those designs to produce or market products on the basis of those designs must be balanced with the interests of the original right holders (Para. 57). Care must be taken to ensure that measures do not go beyond what is necessary to ensure that balance is struck (Para. 57). National legislation may be appropriate only if it is directed at a category of third parties entitled to rely on the principle of protection of legitimate expectations, that is, those who have already exploited designs in the public domain at the date of entry into force of the national legislation (Para. 58). The absence of a provision in national legislation expressly referring to the protection of third parties' acquired rights and legitimate expectations, both fundamental principles of EU law, does not preclude the application of those principles (Para. 50). The national legislation at issue, which provided for a 10 year period during which right holders are not permitted to enforce their revived copyright protection (deriving from a previous design registration) against third parties who were in good faith goes beyond what is necessary to ensure a balance of the competing rights, because it defers the revived copyright protection for a substantial period of time (Paras. 62-63). Article 17 precludes national legislation which either for a substantial period of 10 years or completely – excludes from copyright protection for designs which, although they meet all the requirements to be eligible for copyright protection, entered the public domain before the date of entry into force of the national legislation, that being the case with regard to any third party who has manufactured or marketed products based on such designs in that State – irrespective of the date on which those acts were performed.

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

Case T-599/10; Eurocool Logistik GmbH, v OHIM; Judgment of 6 September 2013; Language of the case: DE


KEYWORDS: Admissibility, Dissimilarity of goods, Likelihood of confusion, Right to be heard

RESULT: Decision PARTIALLY ANNULLED/REFORMED

FACTS: The applicant sought to register the word sign shown below as a CTM for services in Classes 39 and 42. The services consist basically in '*storage and transport services in particular for frozen goods and consultancy thereof*' (Class 39) and '*planning of logistic systems as well as development of software for the storage and transport off frozen goods*' (Class 42). The application was originally rejected as being devoid of distinctiveness (confirmed by the Boards). However, the GC annulled this decision, stating that the applied for sign has the minimum degree of distinctiveness (with reference to T-34/00). The CTMA was, therefore, published for opposition purposes.

The application received an opposition. The opponent based its opposition on Article 8(1)(b) CTMR using the earlier German figurative mark shown below, registered for services in Classes 35 and 39. The services in Class 39 include '*transport or conveyance services*'. The Opposition Division upheld the opposition. The Board of Appeal dismissed the applicant's appeal, finding that there was likelihood of confusion, taking into account, the identity and similarity of the

services and the similarity of the signs. The applicant appealed to the GC, arguing an infringement of Article 75 CTMR (right to be heard) and Article 8(1)(b) CTMR (likelihood of confusion). The applicant asked the GC, *inter alia*, to annul the contested decision and to refuse the opposition.

CTMA	Earlier German mark
EUROCOOL	

SUBSTANCE: The GC found that the refusal of the opposition falls within the competences of the Board. Consequently, the GC is also empowered to refuse the opposition according to Article 65 (3) CTMR (power of alteration). The applicant's plea to refuse the opposition is therefore admissible. The GC refers to established case-law according to which the infringement of procedural rules would be taken into account only in cases where the observance of these rules would have led to a different result (Para 51). The GC held that although the Opposition Division infringed clearly the applicant's right to be heard, because it had not given to it the opportunity to file any observations against the opposition, the applicant had the opportunity to comment on all legal and factual aspects of the case during the proceedings before the Board. Consequently, the claimed infringement of the right to be heard is unfounded (Paras. 59-63). As far as the comparison of the services is concerned, the GC confirmed the assessment in the contested decision, except for the opposed services, "*development of software for the storage, commissioning and transport of chilled and frozen goods*" (Class 42). The GC concluded that those contested services are targeted at business consumers as the providers of transport or storage services, whereas the earlier transport services are targeted at the clients of transport or storage providers (Para. 90). The purpose and method of use of the confronted services are different. The services may not be substituted by one another and, since the consumers are different, these services cannot be complementary (Para. 92 - 94). These services are dissimilar.

The GC agreed with the Board's finding that the earlier mark is dominated by the expression 'EUROCOOL'. Consequently, the contested decision rightly found a similarity between the signs. Taken into account, that the expression 'EUROCOOL' has an average distinctive character (Para. 140) the GC found that there is likelihood of confusion for the identical and similar services. Consequently, the GC partially annulled the contested decision and altered it by rejecting the opposition as far as the contested services "*development of software for the storage, commissioning and transport of chilled and frozen goods*" (Class 42), are concerned.

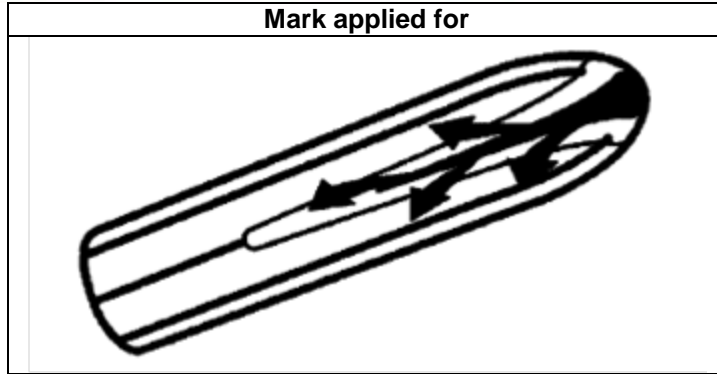
Case T-492/11; "Rauscher" Consumer Products GmbH v OHIM; Judgement of 12. September 2013; Language of the case: DE

KEYWORDS: Error by OHIM, Figurative trade mark, Functional element, Shape of the goods, Statement of grounds, Three dimensional mark

RESULT: Action dismissed

FACTS: The CTM Applicant requested the annulment of the decision of Board dismissing the appeal against the Examiner's decision refusing to register the figurative mark represented below for goods in Classes 3 and 5.

Mark applied for




SUBSTANCE: The Court referred to the case-law regarding the distinctiveness of three dimensional marks that resemble the form of the goods (C-136/02P) which is applicable also to figurative marks that depict the relevant goods (with reference to C-144/06P). The CTMA presents the usual form of a tampon whilst the arrows illustrate its way of functioning (Paras. 21 – 25). The level of attention of the relevant public will not enhance its ability to perceive the signs as a trade mark (Para. 26). As far as the Applicant referred to the registration of a very similar mark for the same goods, the Board examined it but the decision does not show that it considered with especial care whether it should decide in the same way as required by the Court of Justice in C-51/10P (Para. 75). This does not, however, influence the outcome of the decision.

Case T-97/11; Rovi Pharmaceuticals GmbH v. OHIM & Laboratorios Farmacéuticos Rovi S.A.; Judgment of 16 September 2013; Language of the case: EN

KEYWORDS: Admissibility, Distinctive element, Likelihood of confusion, Principle of non discrimination, Reference to briefs submitted in earlier proceeding, Relative grounds for refusal

RESULT: The action is dismissed

FACTS: Rovi Pharmaceuticals GmbH (the CTM applicant) sought to register the word mark ROVI Pharmaceuticals for goods in Classes 3, 5, and 44. Laboratorios Farmacéuticos Rovi S.A. (the opponent), opposed the registration on the basis of several marks, namely the Community figurative mark ROVI reproduced below for products in the Classes 3 and 5 and the Spanish word mark ROVIFARMA, covering goods and services in Classes 5, 39 and 44. The grounds were those laid down in Article 8(1)(b) CTMR. The OD upheld the opposition. On appeal, the Board (**R 500/2010-2**) dismissed the appeal and upheld the opposition. Before the General Court, the applicant alleges two pleas: An infringement of the principle of equal treatment and a breach of Article 8(1)(b) CTMR.

CTM applied for	Earlier rights
ROVI Pharmaceuticals	 ROVIFARMA

SUBSTANCE: Regarding Article 8(1)(b), most of the arguments on the comparison of goods and services are declared inadmissible, as the Applicant referred to its grounds of appeal before the Board without identifying the specific paragraphs of the contested decision and of its written submissions to OHIM to which it refers. For the rest, the GC confirms the comparison of the remaining goods and services as well as the comparison of the signs and the finding of likelihood of confusion. The GC dismisses the Applicant's claim that the distinctive character of ROVI is weakened because the relevant public is accustomed to the use of such word in trade marks. Quite on the contrary, the GC notes

that the relevant public's recognition of a mark is liable to confer a high distinctive character on that mark, and not to weaken its distinctive character.

Case T-200/10 Avery Dennison Corp. v. OHIM & Dennison-Hesperia S.A.; Judgment of 16 September 2013; Language of the case: ES

KEYWORDS: Admissibility, Declaration, Proof of use

RESULT: The action is dismissed.

FACTS: Avery Dennison Corp. (the CTM applicant) sought to register the word mark AVERY DENNISON for goods in Class 16. **Dennison-Hesperia S.A.** (the opponent), opposed the registration on the basis of the Spanish word mark DENNISON, which covers products in Class 16. The grounds were those laid down in Article 8(1)(a) and (b) CTMR. The CTM applicant requested the opponent to prove genuine use of the earlier mark. The OD found that genuine use of the earlier mark had been proven and upheld the opposition. The Board (R 798/2009-2) dismissed the appeal. Before the General Court, the applicant alleged two pleas: An infringement of Article 42(2) and (3) CTMR and a breach of Article 8(1)(b) CTMR.

SUBSTANCE: The GC confirms that the earlier mark was genuinely used in Spain. Whilst noting that the Board did not provide reasons as to why it considered that the documents ('certificaciones') produced by some companies were to be considered statements in writing ex Article 78(1)(f) CTMR (Para. 65), it found that they could still be taken into consideration in order to prove use of the earlier mark (Para. 66). The GC also stated that the fact that such documents might have been prepared following a draft provided by the opponent does not per se affect to their reliability and credibility. As indicated by the Office, the persons signing these documents did 'certify' their content, thereby assuming the true character of what is stated therein (Para. 73). Regarding Article 8(1)(b), the GC declares this plea admissible, even though the CTM applicant only dealt with proof of use and expressly refused to discuss the likelihood of confusion, since the contested decision ruled on LOC by expressly confirming and assuming the reasoning and conclusions of the Opposition Division decision (Paras. 91-97). The GC confirms the comparison of the goods and of the signs, as well as the finding of likelihood of confusion.

Case T-437/11; Golden Balls Ltd v OHIM; Judgment of 16 September 2013; Language of the case: EN

KEYWORDS: Conceptual similarity, Likelihood of confusion, Phonetic dissimilarity, Translation, Visual dissimilarity

RESULT: Action upheld / Cross-appeal dismissed / BoA decision annulled in part

FACTS: The CTM applicant sought to register the word mark 'GOLDEN BALLS' in the Classes 16, 21 and 24. Based on the earlier Community word mark 'BALLON D'OR', registered for goods in *inter alia* Class 16, the opponent opposed the registration on the grounds referred to in 8(1)(b) and 8(5) CTMR. The opposition division rejected the opposition in its entirety. The BoA upheld the appeal in part, namely for goods in Class 16, and dismissed it as for the rest. The decision was based on conceptual similarity and identity of the goods in question. The CTM applicant lodged an appeal and the opponent lodged a cross-appeal, claiming that the opposition should have been upheld under Article 8(5) CTMR in respect of goods other than those in Class 16.

SUBSTANCE: On Article 8(1)(b) CTMR. The goods in Class 16 are identical (not disputed) (Para. 31) whereas those registered for other Classes are different (Para. 30). The marks are visually and phonetically different (Paras. 38-39). For the relevant public to grasp the potential conceptual similarity, a certain linguistic knowledge must be presumed. Here the degree of relationship between the languages concerned and the actual words used by the signs at issue must be regarded (Para. 43). It cannot be assumed that the English and French speaking population will immediately make this connection (Para. 44). An average consumer, in particular a francophone one, who will have a limited knowledge of English who yet knows enough to understand the words 'golden' and 'balls' would also notice the use of the plural versus singular forms and the distinction this adds to the marks (Para. 47). The elements of the signs referring to 'golden' are placed in the beginning of the English mark and in the end of the French, making the discovery of the marks meaning more difficult for anglophone as well as francophone consumers (Para. 48). If a francophone consumers can translate the English mark and if he does so despite the fact that it concerns a simple purchase of everyday consumer goods, it is improbable that he would also analyse the results enough to connect the marks (Para. 49, 60). The Marks should thus be considered to have a weak or even very weak conceptual similarity and it should be noted that such similarity requires prior translation (Paras. 50-51). For a mark which is not especially well known, conceptual similarity may not be enough to

give rise to likelihood of confusion (Paras. 53-54). The earlier mark's alleged reputation has not been proven (Para. 59). Even if the Class 16 goods at issue are identical, the weak, or very weak, conceptual similarity which requires a prior translation cannot suffice to make up for the visual and phonetic dissimilarities which exist (Para. 58). The Board's decision is annulled as far as it found LoC in respect of the Class 16 goods.

On Article 8(5) CTMR. The Board of Appeal dismissed the opponent's claim under Article 8(5) CTMR without examining it into details. Such an error is however without effect in this case (Para. 69). Article 8(5) requires identity or similarity of the signs (Para. 70). The marks lack similarity and the BoA would thus, in any case, have had to reject the opposition under Article 8(5) regarding non similar goods (Paras. 72-73). The opponent's cross-appeal concerning the violation of Article 8(5) CTMR is therefore dismissed.

Case T-448/11; Golden Balls Ltd v OHIM; Judgment of 16 September 2013; Language of the case: EN

KEYWORDS: Conceptual similarity, Likelihood of confusion, Phonetic dissimilarity, Translation, Visual dissimilarity

RESULT: Action upheld / Cross-appeal dismissed / BoA decision annulled in part

FACTS: The CTM applicant sought to register the word mark 'GOLDEN BALLS' in the Classes 9, 28 and 41. Based on the earlier Community word mark 'BALLON D'OR', registered for goods in *inter alia* the Classes 9, 28 and 41, the opponent opposed the registration on the grounds referred to in 8(1)(b) and 8(5) CTMR. The opposition division rejected the opposition in its entirety. The BoA upheld the appeal in part, namely for goods and services in Classes 9, 28 and 41, and partially dismissed it, namely for 'apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity' in Class 9. The CTM applicant lodged an appeal and the opponent lodged a cross-appeal, claiming that the opposition should have been upheld under Article 8(5) CTMR in respect of goods other than those previously mentioned in Class 9.

SUBSTANCE: On Article 8(1)(b) CTMR. The relevant goods and services are identical or similar with the exception of the *supra* mentioned goods in Class 9, which are different (not disputed) (Paras. 30-31). The signs are visually and phonetically different (Paras 38-40). For the relevant public to grasp the potential conceptual similarity, a certain linguistic knowledge must be presumed. Here the degree of relationship between the languages concerned and the actual words used by the signs at issue must be regarded (Para. 43). It cannot be assumed that the English and French speaking population will immediately make this connection (Para. 44). An average consumer, in particular a francophone one, who will have a limited knowledge of English who yet knows enough to understand the words 'golden' and 'balls' would also notice the use of the plural versus singular forms and the distinction this adds to the marks (Para. 47). The elements of the signs referring to 'golden' are placed in the beginning of the English mark and in the end of the French, making the discovery of the marks meaning more difficult for anglophone as well as francophone consumers (Para. 48). If a francophone consumers can translate the English mark and if he does so despite the fact that it concerns a simple purchase of everyday consumer goods, it is improbable that he would also analyse the results enough to connect the marks (Para. 49, 60). The Marks should thus be considered to have a weak or even very weak conceptual similarity and it should be noted that such similarity requires prior translation (Paras. 50-51) For a mark which is not especially well known, conceptual similarity may not be enough to give rise to likelihood of confusion (Paras. 53-54). The earlier mark's alleged reputation has not been proven (Para. 59). That the earlier mark is well known has not been proven (Para. 59). Even for the goods that are identical, the weak, or very weak, conceptual similarity which requires a prior translation cannot suffice to make up for the visual and phonetic dissimilarities which exist (Para. 58). The Board's decision is annulled as far as it found LoC in respect of the similar goods.

On Article 8(5) CTMR. The Board of Appeal dismissed the opponent's claim under Article 8(5) CTMR without examining it into details. Such an error is however without effect in this case (Para. 69). Article 8(5) requires identity or similarity of the signs (Para. 70). The marks lack similarity and the BoA would thus, in any case, have had to reject the opposition under Article 8(5) regarding non similar goods (Paras. 72-73). The opponent's cross-appeal concerning the violation of Article 8(5) CTMR is therefore dismissed.

Case T-569/11; Gitana SA v OHIM and Teddy SpA (intervener); Judgement of 16 September 2013; Language of the case: EN

KEYWORDS: Additional proof of use, Admissibility, Distinctive element, Dominant element, Likelihood of confusion, Proof of use, Relevant public, Relevant territory, Reputation, Revocation

RESULT: ACTION DISMISSED



FACTS: The Applicant sought to register the figurative CTM 'GITANA' for *inter alia* goods in Classes 18 and 25. The opponent challenged the application, on grounds of likelihood of confusion with the previously registered CTM, and International Registration having effect in Germany, Spain, France, Austria and Portugal and Italian all for the figurative mark 'KITANA', for goods in Classes 18 and 25. The Opposition Division upheld the opposition in part, refusing registration of the trade mark sought in respect of the goods in Classes 18 and 25, with the exception of 'leather and imitations of leather' on the ground that there was a likelihood of confusion with the earlier Community mark

The applicant lodged an appeal. It also requested the suspension of the proceedings until the outcome of revocation proceedings against the earlier Community mark. Lastly, it requested that the opposing party provide proof of the genuine use of the earlier Community mark.

The Cancellation Division declared the earlier Community mark revoked so far as the goods in Class 18 were concerned, that mark remaining registered in respect of the goods in Class 25.

The opposing party brought an appeal against that decision, which was dismissed by the Board of Appeal (Case R 2/2009-1). Since that decision has not been appealed before the General Court, it has become definitive.

The Board of Appeal, in the main proceedings, upheld the opposition regarding goods in Class 25, as well as the goods 'leather and imitations of leather' in Class 18, which were found slightly similar to the earlier goods in Class 25.

CTM applied for	Earlier CTM
	

SUBSTANCE: On the admissibility of the additional evidence, the GC held that any additional evidence, presented for the first time in the proceedings, could not be taken into account (Para. 22). The documents intended to prove notoriety of the CTMA were disregarded, with the argument that only the reputation of the earlier mark is relevant when assessing the likelihood of confusion (Para. 72). Additionally, such evidence has to prove reputation for the goods referred to in the CTMA and not to goods which are not relevant in the case at issue (Para. 73). The applicant's allegation that the CTMA's goods are sold through specialised shops was rejected as LoC cannot be dependent on the marketing intentions of the mark's owners which are, by their very nature, subjective (Para. 74). The Court also found that the BoA did not err, when it considered the request for proof of use of the earlier CTM inadmissible, because by the time of publication of the CTM application, the earlier mark had not been registered for more than five years (Para. 31). As to the likelihood of confusion between the marks, the Court confirmed the analysis of the Board of Appeal as regard to the relevant public and territory - the average consumer in the EU- (Para. 37), the identity of the goods in Class 25 (Para. 38). As regards the comparison between Class 25 goods and 'goods made of these materials [leather and imitations of leather]' in Class 18 the GC has confirmed previous case-law, holding that these goods 'bear more than a slight degree of similarity' (Para. 45), the reason being the often identical distribution channels and the consumer's perception that the above goods in Class 18 are clothing accessories (Para. 46). The GC also confirmed the reasoning of the BoA as to the similarity of the signs. The identical length of the words, the fact that there are the dominant and more distinctive elements in the marks (Para. 54), the figurative ones being considered to have merely a decorative function (Para. 55), led to the conclusion of visual similarity. The syllables 'gi' and 'ki' were considered highly similar for part of the relevant public (Para. 63). Conceptually the marks could not be compared, because of the lack of meaning of one of the signs. Referring to the principle of interdependence between the relevant factors for the assessment of the likelihood of confusion (Para. 68), the Court confirmed the decision of the BoA.

Case T-338/09; Müller-Boré & Partner Patentanwälte. Rechtsanwälte v OHIM; Judgment of 16 September 2013; Language of the case: DE

KEYWORDS: Abbreviation, Distinctive element, Likelihood of confusion, Phonetic similarity, Relevant language, Similarity of the signs, Specialised public, Visual similarity, Weak element

RESULT: Action dismissed

FACTS: The applicant sought to register the word ‘MBP’ as a CTM for services in Classes 35 and 42. The opponent lodged an opposition against the application on the basis of its CTM ‘ip_law@mbp’, registered for services in Class 42 and its commercial designation “mbp.de”. The OD rejected the opposition in its entirety. The appeal filed by the opponent was partially successful: The BoA annulled the decision of the OD and rejected the contested CTMA for all services in Class 42 on the basis of the opponent’s earlier CTM.



SUBSTANCE: The GC confirmed the reasoning of the Board of Appeal as to the existence of a likelihood of confusion between the marks. The services of a lawyer or patent attorney are also directed at specialists with a high degree of attention. These specialists will perceive the element “ip_law” of the earlier mark as an abbreviation for Intellectual or Industrial Property Law (Para. 35 and 59). In particular, the public in the UK and in Germany will understand “ip_law” in such a way (Para. 36). The services in Class 42 of the conflicting marks are identical or highly similar (Para. 37). The earlier mark as a whole enjoys an average degree of inherent distinctiveness (Para. 51). The signs share visually and phonetic similarity due to the common element “MBP” (Para. 53). This identical element dominates the earlier mark whereas the part “ip_law” is hardly distinctive in relation to legal services and services of a patent attorney (Para. 57-59). The similarity between the signs cannot be called into question by their different length and the different position of the common element “MBP” (Para. 73). Referring also to the principle of interdependence between the relevant factors for the assessment of the likelihood of confusion (Para. 80), the GC confirmed the decision of the BoA.

Case T-249/11, Sanco S.A. v. OHIM & Marsalman S.L.; Judgment of 14 May 2013; Language of the case: ES

KEYWORDS: Complementary goods and services, Likelihood of confusion, Similarity of the goods and services

RESULT: The contested decision is annulled.

FACTS: Marsalman S.L. (the CTM applicant) sought to register a figurative mark for goods in the Classes 29, 35 and 39. **Sanco S.A.** (the opponent), opposed the registration on the basis of its Spanish figurative mark, covering goods in Classes 29 and 31. The grounds were those laid down in Article 8(1)(b) CTMR. The OD partially upheld the opposition, but rejected it for ‘advertising, commercial agencies, franchising, export and import’ in Class 35 and ‘transport, storage and distribution of chickens’ in Class 39. The Board (**R 1073/2010-2**) dismissed the appeal.

CTM applied for	Earlier Spanish mark
	
<ul style="list-style-type: none"> - Class 35: advertising, commercial agencies, franchising, export and import - Class 39: transport, storage and distribution of chickens. 	<ul style="list-style-type: none"> - Class 29: meat, poultry and game; meat extracts - Class 31: Live animals.

SUBSTANCE: The GC confirms that the relevant public was comprised of both the average consumer from the general public and the average consumer from a more specialised public (Para. 19 of the contested decision and Paras. 26-27 of the Judgment).

The GC found two errors, both relating to the *professional* (specialised) public of the relevant goods and services. Regarding services in Class 35, the existence of a complementarity cannot be rejected on the sole ground that there was no connection between the nature, the method of use and the distribution channels of the goods and services. According to the GC, the Board should have examined, *inter alia*, whether from the point of view of a professional purchaser of chickens or of meat, the services of advertising, commercial agencies, franchising or export and import were important during the purchase of chickens or meat to the extent that he would think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (Para 39). Regarding services in Class 39, some degree of complementarity must be found between at least chickens and the transport, storage and distribution of chickens (Para. 62). The professional consumer of those goods and services, being an undertaking purchasing chickens generally a wholesaler who also needs the services of transport, storage and distribution of chickens, is likely to think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (Para 53).

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 28 August 2013 in Case R0125/2013-2 - EN

Ex parte - Article 7(1)(b) CTMR

The applicant filed the figurative IR



with a designation to the EU, for 'footwear' in Class 25.

The examiner issued a notification of *ex officio* provisional total refusal. She stated that the mark was devoid of any distinctive character pursuant to Article 7(1)(b) CTMR.

The IR holder responded to the examiner's objection.

The examiner maintained her objection under Article 7(1)(b)CTMR and issued the contested decision, which refused protection of the international registration for the European Union because:

- A 'banal tag' on footwear is common in the footwear sector;
- Consumers are accustomed to seeing decorative elements on shoes. There is nothing 'unusual' about the mark;
- The mark ('the shield') cannot be distinguished from other geometrical elements;
- Consumers are not in the habit of making assumptions about origin based on a banal tag. It would be seen as functional or decorative.

The IR holder filed an appeal and the corresponding grounds of appeal. It is based on the following arguments:

- The mark is a so-called 'position mark'. It consists of a device element in the form of a shield, positioned on the shoe above the sole but beneath the laces. Therefore, it not only consists of a stylised shield, but also of a particular position;
- It is capable of being registered as a trade mark;

- The evaluation criteria for the distinctive character of a trade mark must be the same for all the different categories of trade marks;
- The figurative element of the stylised empty-pointed triple-bordered shield is undeniably an element entirely independent of the shape of the shoe. It is an additional element. The mark has a minimum degree of distinctiveness;
- An examination under absolute ground is not a test of novelty, in the sense of creativity;
- The device element is therefore not a 'banal tag', but a distinctive badge of trade origin.

The Board of Appeal found that the mark clearly stands out as a device of a shield positioned on the side of a sports shoe. Although not entirely clear in the representation, the shield is also enclosed within a three-parallel-lined border. It added that the mark is not a simple geometric shape like a rectangle or circle. On the contrary, it is a relatively complex structure comprising two curved sides with a bevelled pointed top. In other words, it appears as a 'shield'. In the Board's view, it cannot be dismissed as a mere 'banal tag'. Devices like the IR holder's have become increasingly common on clothing and particularly on footwear over many years. The public have become accustomed to identifying a particular brand of running shoe or sports shoe based only on a distinctive pattern or design.

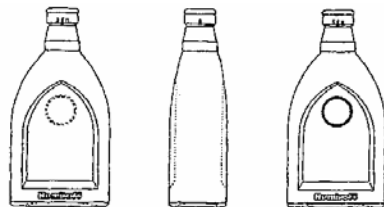
The Board concluded, contrary to what the examiner decided, that although the CTM applied for is not abundant in creative effects and it is not particularly original, for a mark to be registrable, it is not necessary that it be original or fanciful. All it needs to possess to act as a functioning trade mark is a minimum degree of distinctive character. Nothing more is required. In this respect, the mark displays that necessary minimum degree of distinctive character. As noted above, it does not consist of a common geometric shape; on the contrary, it is sufficiently eccentric in geometric terms to defy being described as a 'banal tag'. It is a pointed shield, positioned on the side of a shoe. The 'shield' possesses a triple-line border. Furthermore, the 'shield' does not give the impression of being a piece of functional stitching, or of being woven into the shoe as part of its necessary construction. On the contrary, it stands out as an independent design. Moreover, a shield has no particular significance for footwear and must be deemed fanciful.

For those reasons, the appeal was granted and the contested decision annulled.

Decision from the First Board of Appeal of 5 September 2013 in case R 210/2012-1 EN

Cancellation – Article 53(2)(c) CTMR, Article 53(1)(a) CTMR in conjunction with Article 8(1)(b) CTMR-

The IR holder is the owner of the following three-dimensional international trade



mark registration No 850 398 claiming the word 'Nemiroff' and designating the European Union. It covers the following goods: Class 33 - Alcoholic beverages, namely vodka.

The cancellation applicant filed a request for a declaration of invalidity against the contested IR based on the following grounds:

- Article 53(1)(a) CTMR in conjunction with Article 8(1)(b) CTMR. The contested IR is confusingly similar to its earlier three-dimensional Polish trade mark No 109 294 'CK VODKA'



registered for 'alcoholic beverages' in Class 33.

- Article 53(2)(c) CTMR. The cancellation applicant claimed to be owner of an earlier copyright in a three-



dimensional design of a bottle and that this work was protected in Poland and in all Member States through the Berne Convention for the Protection of Literary and Artistic Works of 9 September 1886 and relied on the Polish Copyright Act of 4 February 1994 which was submitted as evidence.

The IR holder filed a reply and required the cancellation applicant to prove genuine use of the earlier mark. The cancellation applicant filed further observations and submitted evidence of the earlier mark's use. The IR holder filed a rejoinder asserting that the cancellation applicant had failed to prove genuine use of the earlier mark due to the lack of translations of the documents submitted.

The Cancellation Division upheld the application for a declaration of invalidity for the contested goods on the grounds of Article 53(2)(c) CTMR. It based its decision, *inter alia*, on the following reasons:

- Use of the contested IR, according to Polish copyright law would infringe the cancellation applicant's earlier copyright.
- The cancellation applicant established that the Polish Copyright Act of 4 February 1994 admits that a work consisting of a three-dimensional design may be protected as a copyright, provided that it has 'individual character'... and grants to the author (or his/her successor in title) both the exclusive right to commercially exploit the creation and the power to prohibit unauthorised use thereof by third parties;
- The cancellation applicant has established that the ornamental design was filed prior to the contested IR. Particularly, according to the protection certificate issued by the Polish Patent Office, it was filed on 18 December 1996 and claimed a priority of 12 April 1995;
- The cancellation applicant successfully showed that is the entitled successor of the right given by the ornamental design's author;
- The ornamental design at issue has particular characteristics as its sides resemble the shapes of gothic windows, which meet the criterion of 'arbitrary';
- The shapes are visually similar overall as the bottles have a nearly identical body and slightly diverging form in the cylindrical cap, which only accounts for a negligible difference.
- Since the contested IR would not be distinguishable from the most relevant features of the cancellation applicant's shape, it would be considered as an imitation of that work protected by the earlier copyright.

In the present case, the bottles are used in connection with identical products and are, therefore, directed at the same public, even if Polish law does not require this condition.

The IR holder filed an appeal.

The Board states that the IR holder submits that at most the protection of the cancellation applicant's design of a bottle is regulated under the Law of 10 July 1952 on Copyright, which granted a different term of protection, namely only 25 years from the date of the design's creation. From that, it follows that even if the existence of copyright protection for the cancellation applicant's bottle were admitted, it should have already expired. The Board also finds that, indeed, the IR holder is right in stating that without indicating the exact date of creation of the prior design, it is impossible to understand whether the shape of the bottle at issue was commonplace and thus, whether or not it complies with the requirement of a certain copyright regime in Poland. As a result, the contested decision could be considered to be based on the wrong applicable law, and consequently be annulled.

Nevertheless, the Board declared the contested CTM invalid on the basis of Article 53(1)(a) CTMR in conjunction with Article 8(1)(b) CTMR because of a likelihood of confusion, given the identity of the goods and the high similarity between the marks.

Decision from the Second Board of Appeals of 6 September 2013 in Case R 1538/2012-2 101 / 501 – EN*Opposition – Article 8(1)(b) CTMR*

The applicant sought to register the word mark '101' for goods in Classes 13, 25 'clothing, footwear, headgear' and 28.

The opponent filed an opposition against the mark applied for based on earlier Community trade mark registration No 26 708 of the word mark '501,' registered for the following goods:

Class 16: Paper, cardboard and goods made from these materials (included in Class 16); printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; instructional and teaching material (except apparatus); plastic materials for packaging (included in Class 16); playing cards;

Class 18: Leather and imitations of leather, and goods made of these materials (included in Class 18); animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery;

and Class 25: Clothing, footwear, headgear.

The opponent invoked Article 8(1)(b) and 8(5) CTMR. It directed its opposition against part the goods of the mark applied for, namely 'clothing, footwear, headgear' and based it on all the goods of its earlier mark.

The Opposition Division issued a decision by which it rejected the opposition in its entirety and ordered the opponent to bear the costs.

The opponent filed an appeal against the contested decision.

The Board states that it is undisputed that the goods are identical. The signs are visually similar to the extent that they coincide in the digits '01'. On the other hand, a clear difference consists in that they differ in the first digit, '5' and '1', respectively. It adds that the length of the signs may influence the effect of differences between the signs. The shorter a sign, the more easily the public is able to perceive all its single elements. Thus, even small differences may frequently lead in short words (or numbers) to a different overall impression. Both signs are short marks in the case at hand. As such they are not difficult to read and each one is likely to be easy to recall. Further, the consumer's attention is usually directed at the beginning of the word. In the Board's opinion, the same would apply to marks consisting of a few numbers. As stated in the contested decision, the symmetry and asymmetry of the numbers '101' and '501', respectively, have such an impact on the overall impression that they clearly outweigh the common features, the digits '01', in the signs. The conclusion must, therefore, be that the signs are not visually similar overall.

Aurally, as correctly noted in the contested decision, irrespective of the different languages in different parts of the relevant territory, the pronunciation of the marks coincides to a varying degree depending on how the numbers '501' and '101' are pronounced. For example, in English: /five-hundred-one/ [US English], /five-hundred-and-one/ [UK English] or /five-o-one/ versus /a hundred-(and-) one/, /one-hundred-(and-)one/ or /one-o-one/. Thus, the pronunciation of the signs clearly differs in the sound of the number five versus one. Also in the aural impression the consumer's attention is usually directed at the beginning of the word. The difference at the beginnings of the marks has such an impact on the overall phonetic impression that it clearly outweighs the common features, the numbers '01', in the signs. The conclusion must, therefore, be that the signs are not aurally similar overall either. In addition, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods. This is the case with respect to the goods at issue.

Conceptually, the contested decision found that the signs have no concept in common, since according to Office practice, numbers as such have no concept. The Board notes that even if it were considered that numbers have a concept, in this case, as the marks consist of two different specific numbers, they are conceptually different.

Since overall the signs are not considered similar or identical, there can also be no likelihood of confusion in accordance with Article 8(1)(b) CTMR, even if the earlier mark were to enjoy enhanced distinctiveness.

The Board confirms that even if the goods are identical (Class 25 – Clothing, footwear, headgear), the clear differences between the marks suffice to conclude that they are dissimilar overall and to safely exclude a likelihood of confusion.

Article 8(5) CTMR

It follows from this provision that it must be determined, (a) whether the contested mark is identical to those earlier marks claimed by the opponent or is similar to them; (b) whether those marks have a reputation; and (c), whether the use without due cause of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade marks. Those conditions are cumulative; failure to satisfy one of them is sufficient to render inapplicable the provisions of Article 8(5) CTMR.

Due to the clear differences between the signs which have been discussed above, the Board is of the opinion that the marks are sufficiently dissimilar so that the degree of similarity is not such that the relevant public would establish a link between the two signs.

Thus, since one of the three cumulative conditions for the application of Article 8(5) CTMR are not satisfied, the appeal also has to be rejected insofar as it was based on Article 8(5) CTMR.