



Boards of Appeal



Yearly overview of decisions 2007



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I. INTRODUCTION

In 2007, the Boards of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs) rendered 1776 decisions on appeal cases. 1120 of these decisions were taken in *inter-partes* cases and 656 in *ex parte* proceedings. Taking into account the large number of decisions, keeping oneself informed about the development of case-law of the Boards of Appeal, can present a challenge. The 2007 overview of case-law, created by the Documentation and Support Service of the Boards of Appeal, is intended to help users in this task.

The overview is structured according to various legal criteria, such as procedural issues or grounds for refusal. It contains references to selected decisions of the Boards of Appeal which have been rendered in 2007 in these areas.

All decisions of the Boards of Appeal cited in the document can be found in the database of decisions of the Boards of Appeal at the following link: http://oami.europa.eu/search/LegalDocs/la/en_BoA_index.cfm .

THE PRESENT DOCUMENT WAS ESTABLISHED UNDER THE SOLE RESPONSIBILITY OF THE DOCUMENTATION AND SUPPORT SERVICE OF THE BOARDS OF APPEAL AND IS INTENDED FOR INFORMATION PURPOSES ONLY. NO STATEMENT CAN BE CONSIDERED AS BINDING ON THE BOARDS OR HAVE IMPACT ON ANY OF THE DECISIONS TAKEN BY THEM.



II. DECISIONS OF THE GRAND BOARD

The legal basis for a Grand Board of Appeal (formerly called the Enlarged Board) was laid down in Council Regulation (EC) No 422/2004 of 19 February 2004 amending Article 130 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community Trade Mark ('CTMR'). Commission Regulation (EC) No 2082/2004 of 6 December 2004 amending the Rules of Procedure of the Boards of Appeal, including the rules for a Grand Board, such as its composition and the rules of referral of cases to it.

In 2007, the Grand Board took the decision in case **R 667/2005-G CARDIOLOGY UPDATE**. It decided that the one-month deadline for supplying a translation according to Rule 96(1) CTMIR, which, according to constant practice of the Boards of Appeal is applicable to the statement of grounds of appeal, is also applicable to the notice of appeal. Clarification of this issue was the main purpose for referring the matter to the Grand Board of Appeal. See also Section IIIA1b.

III. PROCEDURAL MATTERS

A. *Admissibility*

1. **Admissibility of the appeal**

a) **Appealable decision/Affected Party**

Under Article 57 CTMR, a decision of an OHIM department can be appealed separately, if it terminates proceedings as regards one of the parties or if the decision allows a separate appeal. Whether a document constitutes a decision that terminates proceedings depends on its substance and not on its form or on the name of the department. Thus, in line with its previous case-law (see also R 0650/2005-4), the Board of Appeal found in **R 1448/2006-1 EVA 3000** that a decision taken by an employee of the department responsible for entries in the OHIM register is a decision subject to appeal pursuant to Article 57(1) CTMR even if the department bears a different name from that stated in Article 128(1) CTMR.

Under Article 58 CTMR, a decision may be appealed by any party to proceedings adversely affected by it. A person, against whom the contested decision was not directed, cannot appeal it. In **R 0500/2006-1 RELAX FORM BY CHATEAU D'AX (fig.) / RELAX et al** the appeal therefore had to be considered inadmissible since the opponent, who filed the notice of appeal, had previously requested not to appear as party to the proceedings any longer and had named its successor. The Opposition Division directed the contested decision to the successor and thus the opponent was not adversely affected by it.



b) Language of proceedings / Translation

In **R 667/2005-G CARDIOLOGY UPDATE** the Grand Board stated that, according to Article 115(4) CTMR, the language of proceedings in ex parte proceedings is the language used for filing the application for a CTM. Under Rule 48(2) CTMIR, the language of the appeal proceedings automatically follows the language of the examination proceedings (or the opposition proceedings) and does not allow the appellant a genuine choice of language. The Grand Board confirmed that the one-month deadline to file a translation into the language of proceedings also applies to the notice of appeal (Rule 96(19) CTMIR). If the notice of appeal or the statement of grounds is not filed in the language of the proceedings and no translation is supplied within one month from the date of the submission of the original document, the appeal is inadmissible. The Grand Board of Appeal thus confirmed earlier cases, for example R 0093/1998-1 'Not just Donuts/Donut' (see also **R 0005/2007-1 center modern liposuction**).

2. Admissibility of the invalidity/revocation

A request for declaration of invalidity is only admissible against a registered CTM. A request directed against an application which has not yet been registered is premature and cannot be converted into a request against the CTM once it has been registered. The Board confirmed this interpretation, which is the general practice of the Cancellation Division. It found the request for declaration of invalidity inadmissible when it was detected at the appeal stage that the request had been directed against a CTM application (**R 0284/2007-4 VISION / VISION**). It confirmed that such matter has to be taken into account *ex officio*. The rejection of a premature request does not acquire a *res iudicata* effect in the sense that a new request would be excluded.

A recurring admissibility issue is that of a change of parties during the proceedings. In the invalidity proceedings **R 0252/2006-1 TELESIS**, the Board found that the transfer of the rights to a trade name justified the change of the party. As regards the admissibility of a revocation request, the Board accepted in **R 1209/2005-1 Payless ShoeSource (fig.)** for a legal practitioner to make a revocation request in its own name and later transfer its position to its client. The Board found that even if the Regulations (CTMR, CTMIR) do not foresee a transfer of the status of a party to the proceedings, it is accepted practice¹. It saw no reason why such a transfer should not be possible for the revocation applicant.

To file an application for revocation, the applicant has to file a written reasoned statement in accordance with Article 55(2) CTMR. However, such statement does not necessarily need to be detailed. In **R 1209/2005-1 Payless ShoeSource (fig.)**, it was considered sufficient that the cancellation applicant specified the grounds for revocation, namely lack of use of the CTM. It was considered up to the CTM owner, who is in the best situation to give evidence on the use of its trade mark, to submit facts and evidence on use.

¹ See *inter alia* Orders of the Court in Cases T-94/02 Boss/Boss and T-131/03 Kerry Spring/Kerry; judgment of the Court of First Instance of 22 June 2005 in Case T-34/04 *Plus Warenhandels-gesellschaft mbH v OHIM* ('Turkish Power') [2005] ECR II-2401; decisions of the Boards in Case R 425/2000-3 *Sephora / Sephora*, and in Case R 710/2002-2 *TSM / TSM*.



In relation to proving the existence of earlier rights for relative grounds for invalidity, the Boards have considered it sufficient that the revocation applicant presented some initial evidence on the existence of the earlier right. Different from opposition proceedings, the existence of the earlier right is an issue of admissibility and not of substantiation (see **R 0300/2006-4 ACTILON / ACTELION**). A missing translation, for example of the goods and services mentioned in the registration certificate, does not automatically lead to the inadmissibility of the cancellation action as the Cancellation Division must ask the party to remedy the deficiency in accordance with Rule 39(1) CTMIR.

B. New facts, arguments, grounds or evidence

In March 2007, the ECJ ruled in Case C-29/05 P, *ARCOL / CAPOL*² that the Boards of Appeal, when assessing a case, have to carry out a new, full examination of the merits of the case, in terms of both law and fact. The continuity in terms of their functions between the first instance and the Boards of Appeal cannot be interpreted as starting a new time-limit for the appellant in which to submit facts and evidence in support of its pleadings. However, where the party submits such facts and evidence outside the original deadline, the Boards of Appeal are required to exercise their discretionary power under Article 74(2) CTMR to decide whether to take them into account.

According to the Court of Justice, when called upon to give judgment in the context of opposition proceedings, taking such facts or evidence into account is particularly likely to be justified where it is considered, first, that the material which has been produced late is, on the face of it, likely to be relevant to the outcome of the opposition and, second, that the stage of the proceedings at which that late submission takes place and the circumstances surrounding it, do not argue against it being taken into account.

1. Not accepted before the Board

Before *ARCOL/CAPOL*, the Boards of Appeal tended to accept new evidence on appeal where new factors emerged or where there was some factual or legal difficulty that made it impossible for the appellant to submit the evidence earlier. However, where the new evidence could already have been submitted before the first instance within the deadline (but was not) and the party does not provide convincing reasons why the evidence should be admitted, the Boards have tended to refuse it (see, for example, **R 1458/2005-2 Omi's (fig.) / OMA, OMA MARGARINE (fig.)**, **R 0564/2006-4 CRIMAR / CRISAMAR** and **R 0660/2006-2 Bio Visc / PROVISC et al.**).

The case-law following the *ARCOL/CAPOL* judgment was guided by the principles established in that judgment, applying them to the specific case situations at hand. The Boards rejected new evidence in various cases, such as, for example, Case **R 1157/2006-2 PUSH / PUTSCH**, in which the opponent submitted no explanation as to why it did not – or could not – submit the new evidence before the Opposition Division at the relevant time. The evidence of reputation filed on appeal was entirely new and did not build on anything previously submitted (see also **R 846/2006-4 800 FLOWERS / 800-FLOWERS** on completely new evidence on a non-registered

² Judgment of 13 March 2007 in Case C-29/05 P *OHIM v Kaul GmbH and Bayer AG* ('Arcol') [2007] [2007] ECR I-2213.



right). For cases where the party did not provide any good reason why the evidence was submitted late, see also **R 0477/2006-1 SHAPE OF BOTTLE (3D) / SHAPE OF BOTTLE (3D)** and **R 1468/2006-2 BUZZ! (fig.) / BUZZ!** as regards submission of a registration certificate of the earlier right and its translation on appeal and **R 0163/2006-4 DEKA / DETA** on the late submission of a renewal certificate. The Board also observed in the latter case that there was a genuine interest for the applicant to know against which earlier right it has to defend itself as early as possible. As an example for the rejection of proof of use, see **R 0993/2005-4 cosana / SONANA**).

As regards the ARCOL case itself, the Boards decided the matter upon its return from the ECJ. In **R 782/2000-2 ARCOL / CAPOL**, the Second Board of Appeal found that the late facts and evidence submitted by the opponent to show that the earlier mark had a highly distinctive character as a result of its use were irrelevant to the outcome of the opposition and thus inadmissible. According to the ECJ's ARCOL judgment a key factor to be considered by the Board in the exercise of its discretion is whether the new facts or evidence are, on the face of it, likely to be relevant to the outcome of the opposition. In the original case, the opposition was rejected due to a lack of similarity between the trade marks in issue. The failure of the opposition was due to the lack of that similarity, not due to a lack of distinctiveness of the earlier mark. The Board considered that, since the conflicting trade marks were not similar, the issue of whether the earlier mark was well known or not could not alter the global assessment of the likelihood of confusion. Even if the well known character could be established, this would have no bearing on the outcome as the marks would still be dissimilar.

The Board also considered that the infringement of Article 74(2) CTMR in the previous decision was not sufficient to warrant its annulment since annulment is not justified where it can only lead to the adoption of another decision identical in substance. The appeal was dismissed. The case has again been appealed at the Court of First Instance (T-402/2007).

2. Accepted before the Board

a) Additional or supplementary facts/evidence

Analyzing the criteria established in the 'ARCOL' judgment, the Board found in Case **R 0574/2006-2 PROTIDIET/PROTI *et al.*** that the additional evidence to prove genuine use of its earlier trade mark submitted by the opponent with the statement of grounds is complementary evidence and, consequently, can be taken into consideration. The opponent had made a serious attempt to prove genuine use in the opposition proceedings. The Board also accepted evidence of use which was submitted by fax partly out of time since the last of several hundreds of pages arrived at the Office after midnight (**R 299/2006-2 BUDWEISER / BUDWEISER *et al.***). It stated that the transmission commenced before the expiry of the time-limit, that the delay was insignificant, and that the evidence was received 35 months before the contested decision was issued.

According to the Board's decision in **R 1062/2006-2 micasa (fig.) / micasa (fig.)** the circumstances that surround the filing of the additional explanations and evidence can plead in favour of their admission in the appeal proceedings. In that case the opponent did not have the possibility of filing observations before the Opposition Division regarding the discrepancy between the information on the registration certificate and on the notice of opposition. Its additional explanations and evidence provided with the notice of the appeal eliminated any doubts regarding its ownership.



Other decisions in 2007 where the Boards admitted evidence which confirmed and completed evidence already submitted are: **R 674/2006-2 LASER / ME 33 – Laser**; **R 0570/2006-1 Eva Tomato Paste (fig.) / eva (fig.)**; **R 465/2006-2 KAJAANI PROCESS MEASUREMENTS (fig.) / KAJAANI et al.**; **R 209/2006-2 WATERCLEAN/CLEN et al.**; **R 1117/2005-1 redENVELOPE (fig.) / Redletter (fig.)**; **R 0993/2005-4 cosana / SONANA**; **R 0564/2006-4 CRIMAR / CRISAMAR**; and **R 31/2005-1 ER**.

b) New facts/evidence

Various Board of Appeal decisions have allowed the submission of new evidence based on the principles established by the ECJ in the ARCOL judgment: see e.g. case **R 0752/2006-4 TPGPOST (fig.) / POST et al.** and **R 0465/2006-2 KAJAANI PROCESS MEASUREMENTS (fig.) / KAJAANI et al.** The new facts or evidence accepted are usually such that could not be submitted at first instance, or that are submitted in response to an argument on which the party had no previous opportunity to express itself.

In **R 1084/2004-4 FLUGBÖRSE** the Board accepted new evidence attached by the respondent to its reply to the appeal, which were received three days after the expiry of the time-limit. Their content was clearly and precisely listed in the pleadings and as the documents were sent by post and arrived only with a short delay it can be assumed that they were posted within the time-limit (see also **R 0407/2006-2 maier sports (fig.) / David Mayer (fig.)**, where some translations of invoices which arrived at the Opposition Division a day late were accepted; their content was corroborated by other evidence).

Other factors in admitting new evidence can be for the sake of good administration and procedural economy (e.g. in **R 0246/2005-2 High Liner (fig.) / CAPTAIN (fig.) et al.**) or the fact that the information or content provided by the new submission is decisive and relevant for the final outcome of the case (**R 1536/2006-1 KOTI (fig.) / COTY (fig.) et al.** and **R 0465/2006-2 KAJAANI PROCESS MEASUREMENTS (fig.) / KAJAANI et al.**).

C. Restitutio in integrum (Article 78 CTMR)

In relation to *restitutio in integrum* according to Article 78(1) CTMR, the Boards considered that the concept contains an objective element relating to abnormal circumstances, unconnected with the party in question, that make up the impediment or cause of non-compliance with the missed time-limit and a subjective element involving the obligation, on the part of the party, to guard against the consequences of the abnormal event by taking appropriate steps without making unreasonable sacrifices (see **R 1044/2006-2 YORK (fig.) / VIYORK**; **R 613/2007-2 – BARNETT**; **R 0745/2006-1 OWACOUSTIC / CHOACOUSTIC**).

A professional representative has to take organisational measures capable of preventing errors that would lead to deadlines being missed (see **R 729/2007-2 doony's (fig.) / DONUT et al.**; **R 613/2007-2 BARNETT**; **R 787/2006-1 LAST MINUTE**; **R 0745/2006-1 OWACOUSTIC / CHOACOUSTIC**; **R 947/2007-1 NEWTON**). The Board found in **R 0413/2007-2 Corti / CORTTY CENTRO et al.** that overlooking a clear note put in the calendar of time-limits by a diligent and prudent person cannot be considered an excuse. For further cases in relation to organisational



measures, see **R 1044/2006-2 YORK (fig.) / VIYORK** and **R 1554/2006-2 REVERSE IN SAFETY**.

As regards the admissibility of the request for *restitutio*, the Board stated in **R 0866/2007-2 JURADO** that a licensee cannot ask for *restitutio in integrum* to be reinstated into the deadline for renewing a CTM. Only the CTM proprietor can request the renewal pursuant to Article 47(1) CTMR and only it, being a party to the renewal proceedings, is entitled to request *restitutio* if the deadline is missed. The licensee's lack of legal standing to apply for a CTM renewal is sufficient grounds for a refusal of the application for *restitutio in integrum* relating to the renewal.

D. Withdrawals

A Community trade mark application may be withdrawn at any time (Article 44 CTMR). In 2007, it is estimated that around 200 appeals ended through a withdrawal by one or both parties to the proceedings. Withdrawals can be the result of successful negotiations between the parties (in inter partes cases) or considerations of the applicant in view of a rejection of its CTM application (in ex-parte cases). Evidence encountered by the Board and submitted to the party can contribute to a withdrawal (see **R 0650/2007-4 ARTIC ROOT** where the Board informed the appellant of evidence confirming the descriptive character of the mark applied for).

In 2006, the Grand Board of Appeal confirmed that a CTM application may still be withdrawn during the appeal period without an appeal having been filed (R 00331/2006-G OPTIMA). In 2007, a Board also noted that a CTM application can be withdrawn within the appeal period, even if a notice of appeal has been submitted [see **R 0768/2007-1 A DEVICE OF ELLIPSE (fig.)**].

In principle, the party who terminates the proceedings by withdrawal bears the costs and fees incurred by the other party pursuant to Article 81(3) CTMR [see **R 0096/2007-2 FIRST UP / First Travel Management et al.**; **R 0004/2007-4 Alucolor / ALUCOLOR (fig.)**]. However, another apportionment of costs is possible, for example under Article 81(2) CTMR for reasons of equity. In **R 1167/2005-1 RELOVA / RALENOVA**, where the partial restriction of the list of goods and services by the applicant led to the withdrawal of the opposition, the Board considered it equitable that each party bear its own costs and fees (see also **R 1516/2006-4 EUROPUR / EUROPUR**).

E. Principle of non-discrimination

According to settled case-law, the Community trade mark system is autonomous and the distinctiveness of a sign is to be assessed purely by reference to the requirements of the CTMR. The merits must be in each case considered separately, irrespective of earlier registrations by the OHIM or by national offices (see *inter alia* **R 1658/2006-1 !**; **R 1144/2005-4 ADAPT**).

Nonetheless, where a previous OHIM decision exists which is legally substantially analogous to the case at hand, this might need to be taken into account. Thus, in a case where the OHIM had accepted an identical mark that merely had a special font or typeface for identical goods, the Board found that this previous decision should have been taken into consideration (see **R 0332/2007-2 NAUTICA**).



F. Notification

The Office can communicate with consenting addressees directly through a sub-system of MYPAGE. MYPAGE is a system providing direct electronic access to Office documents through the Internet. Within this system, the sub-system "MYMAILBOX" allows for the parties to proceedings to receive, view and save documents sent by the Office and to reply to notifications received³. The Board confirmed in **R 0130/2007-2 THE JOHN RITTER FOUNDATION FOR AORTIC HEALTH** that placing a communication in MYMAILBOX, is by analogy to Rule 64 CTMIR equivalent to notification, regardless of whether it is subsequently viewed or not by the addressee. The actual notification is deemed to have occurred on the fifth day following that on which the document was placed in MYMAILBOX. If the recipient claims to have had difficulties with the service, it should adduce evidence, for example copies of the log of e-mails sent and received relating to the days concerned.

G. Substantiation of (earlier) rights

1. Registration certificates / Extracts from databases

According to Rule 19(2)(a)(ii) CTMIR (as amended) to substantiate a trade mark, which is not a CTM, a registration certificate or 'equivalent documents emanating from the administration by which the trade mark was registered' is needed. This amendment is in force as from 25 July 2005.

In 2007, the Boards had to decide cases to which the provisions before the CTMIR amendment were still applicable, such as cases where the contested decision was taken after the amendment entered into force but the relevant procedural events occurred before that date (see **R 1110/2005-4 GASTROTIDINA RATIO / GASTRIDINA**; **R 0791/2006-2 DEITECH (fig.) / DEITEX (fig.)**).

The Boards continued to emphasize that both the registration certificate and, where the certificate is not in the language of proceedings, its translation need to be submitted to substantiate an earlier right. It is not sufficient to submit only the translation, especially because there is no certainty that it accurately reflects the actual state of the register (see **R 0351/2006-1 Rock & Rock (fig.) / ROCK**; **R 1144/2006-4 AGIS (fig.) / AGIT**).

As regards the submission of extracts from databases, the Boards in 2007 rejected extracts from databases, including the DEMAS database (see e.g. **R 1478/2005-4 AMVISC / AMIS**; **R 0260/2007-1 VIRACIL / VITASIL**).

³ See Decision No EX-07-4 of the President of the Office of 16 July 2007 concerning electronic communication with and by the Office (repealing, inter alia, Decision No EX-04-6 of the President of the Office of 14 December 2004 concerning notification by technical means).



Where the notice of opposition and the extract were filed before the amendment to the CTMIR came into force, certain database extracts were still accepted (see **R 0791/2006-2 DEITECH (fig.) / DEI-tex (fig.)** regarding DEMAS), but others rejected as not amounting to an official or public document (see **R 1419/2005-4 JAC / JAB** for the CATAMARAN database). In **R 0026/2006-2 ALPINA / ALPINA** an extract from SPTO's SITADEx database was accepted.

2. Renewal / Validity of earlier rights

With respect to renewals, the modified Rule 19(2)(a)(ii) CTMIR provides that within the time-limit specified by the Office, the opposing party has to, *inter alia*, file proof of the existence, validity and scope of protection of its earlier mark. As the case maybe, it might also have to provide a copy of the latest renewal certificate, namely one showing that the term of protection of the trade mark extends beyond the time-limit set by the Office.

In several cases in 2007, the Boards rejected the opposition because the renewal of the earlier trade mark has not been proved within the time-limit or not at all (see *inter alia* **R 0507/2006-4 BLACK CAT (fig.) / BLACKCAT**; **R 1128/2006-2 LAKOTA / DAKOTA**; **R 0633/2006-2 Device of a swallow (fig.) / SCHWÄLBCHEN et al.**; **R 0225/2005-4 roba (fig.) / RÖ WA (fig.) et al.** and **R 0163/2006-4 DEKA / DETA**).

3. Translations

Rule 19(3) CTMIR provides that the information and evidence necessary to substantiate the opposition has to be in the language of the proceedings or accompanied by a translation. The failure to provide a translation within the time-limit set by the Office leads to the rejection of the opposition (see **R 1419/2005-4 JAC / JAB**; **R 0615/2006-1 MAGNUM MARINE (fig.) / MAGNUM**; **R 1332/2006-2 VEGAS / AHLERS LAS VEGAS (fig.)**; **R 0477/2006-1 SHAPE OF BOTTLE (3D) / SHAPE OF BOTTLE (3D)**, **R 1304/2006-2 Gourmet-Card (fig.) / cheque gourmet (fig.)**, **R 972/2006-2 EVA / EVAX, EVA DE EVAX (fig.) et al** and **R 0633/2006-2 Device of a swallow (fig.) / SCHWÄLBCHEN et al.**).

H. Restriction of the list of goods and services

Under Article 44(1) CTMR, the applicant may at any time withdraw its Community trade mark application or restrict the list of goods or services contained therein. The rules allow only for the restriction of the list of goods and services, not for an extension (see example in **R 0829/2007-2 BALANCED CHOICES**).

According to the case-law of the Court of First Instance, a restriction must be made expressly and unconditionally. A proposal to withdraw part of the goods, if the Board of Appeal considers rejecting them, or an expression of 'willingness to limit the specification' are not made expressly



and unconditionally⁴. For an example in the Boards of Appeal case-law of 2007, see **R 1120/2006-1 BODY ACTIVE** where the applicant only made a proposal for restriction.

Applying the judgment of the Court of Justice in Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau*, 'Postkantoor', the Boards have refused restrictions where the applicant wanted to limit its list by excluding products with certain characteristics (see **R 1279/2005-4 XAL** 'excluding xenon arc lamps' from lighting equipment and **R 1194/2005-4 EDC**, *inter alia*, 'excluding parts for controlling diesel engines' from motor vehicles). For a case where the Boards have accepted a clearly defined group of goods being removed from a generic term for goods, see **R 0950/2006-1 PILOT**, where 'data carriers for aeronautics, aviation and shipping' were exempted from the generic term 'Data carriers with programs and software for cartography'.

In any restriction it should also be borne in mind that the new list of goods and services must indicate clearly the nature of the goods and services (Rule 2(2) CTMIR) (see **R 0950/2006-1 PILOT**).

IV. ABSOLUTE GROUNDS FOR REFUSAL / INVALIDITY

A. Absolute grounds for refusal – Articles 4 and 7(1)(a) CTMR

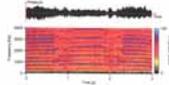
Article 4 CTMR lays down two conditions for a sign to be capable of constituting a Community trade mark: the substantive requirement of distinctive character and the formal requirement of a graphical representation.

The graphical representation should be clear, precise, self-contained, easily accessible, intelligible, durable and objective as stated by the ECJ in judgment C-273/00 'Sieckmann'⁵. This approach was confirmed for sound marks in the 'Shield Mark' case⁶ (ECJ Case C-283/01). In the case of sound marks, those requirements are not satisfied when the sign is represented graphically by means of a description using the written language, such as an indication that the sign consists of the notes of a musical work, or the cry of an animal, or by means of simple onomatopoeia, without anything else. Nor is a sequence of musical notes sufficient by itself. On the other hand, those requirements are satisfied where the sign is represented by a stave divided into measures and showing, in particular, a clef, musical notes and rests whose form indicates the relative value.

⁴ See *inter alia* judgments of the Court of First Instance of 27 February 2002 in Case T-219/00 *Ellos AB v OHIM* ('Ellos') [2002] ECR II-753; and, most recently, of 22 September 2005 in Case T-130/03 *Alcon Inc. v OHIM* ('Travatan') [2005] ECR II-3859.

⁵ Judgment of the Court of 12 December 2002 in Case C-273/00 *Ralf Sieckmann v Deutsches Patent- und Markenamt* ('Methylcinnamat') [2002] ECR I-11737.

⁶ See judgment of the Court of 27 November 2003 in Case C-283/01 *Shield Mark BV v Joost Kist h.o.d.n. Memex* ('Musical notation') [2003] ECR I-14313, at paragraph 56.



In Case **R 708/2006-4** (**TARZAN YELL**), the Board rejected the application since the graphic representation consisted of a spectrogram associated with a text description. The Board found that the application could not be given a filing date as it lacked the appropriate graphic representation. It was neither clear, nor self-contained nor easily accessible.

In 2007, the Boards decided the first case of a tactile mark. Tactile trade marks can be considered to be graphically represented if the Siekmann criteria are fulfilled. This was not the

case in **R 1174/2006-1** (**Car seat mechanism**), where the mark was represented by a picture and a description, since important elements which determine the tactile impression of the object's surface remained unknown (in particular the size, the state of the material and its flexibility). A sample was not accepted as a graphic representation. The Board considered it correct not to allow a filing date under Article 27 CTMR because of a lack of representation, and stated that the trade mark had to be rejected under Articles 7(1)(a) and 4 CTMR.

B. Absolute grounds for refusal / invalidity: Articles 7(1)(b)-(d)/ Article 51(1)(a) CTMR

1. **Word marks**

a) **Numbers**

Of the decisions rendered in 2007, the Boards of Appeal rejected all cases regarding marks made up purely of numbers as they were not perceived as an indication of commercial origin. The numbers '150', '250' and '350' for '*periodicals*' were rejected as they might be understood as a designation of the quantity of the information contained in the periodical, as a designation of content (as in '100 word searches', '500 challenging puzzles') or as a designation of the current issue (as in '150th issue') (see **R 1035/2006-4 '150'**; **R 1034/2006-4 '250'**; and **R 1033/2006-4 '350'**). Equally, the numbers '222', '333', and '555' were rejected for the same goods (see **R 1276/2006-4 '222'**; **R 1277/2006-4 '333'** and **R 1278/2006-4 '555'**). The number '140.6' was rejected for '*organizing athletic events*' since it makes reference to the length of a triathlon race (see **R 0534/2006-4**).

b) **Descriptive/non distinctive, laudatory marks v. allusive marks**

The vast majority of decisions on absolute grounds in 2007 dealt with the grounds for refusal under Article 7(1)(b) and (c) CTMR. Amongst these, the Boards have dealt with and refused laudatory terms, which serve to inform the relevant public about the intended purpose of the goods (**R 0950/2006-1 PILOT** for '*data carriers with software for cartography*'), of their characteristics, (**R 0165/2005-4 VISIBLE WHITE** whitening effect for '*toothpaste and mouthwash*') or of their high quality as in: **SUPREMO** for '*household appliances, installations*' (**R 0049/2007-1**); **TELIOS** for '*soaps; perfumery, pharmaceutical and veterinary preparations*' (**R 1433/2006-1**); **FIRST** for '*publications in electronic form*' (**R 1362/2006-1**); **OPTIMUM** for '*agricultural, horticultural, forestry products*' (**R 0624/2007-2**); **PLUS** for '*basins, washbasins and sink basins*' (**R 0435/2007-1**); **BRILLIANT** for '*computer software in the field of accommodation*'



and catering' (R 1186/2006-1) and **PRIVILEGE** for 'credit cards, air transport services' (R 0044/2007-2).

The '!' symbol with no additional feature or graphic elements that could be regarded as fanciful or arbitrary was found to be devoid of any distinctive character. Punctuation marks are very common and widely used (see R 1658/2006-1 ! and R 1134/2007-1 !⁷).

On the other hand, evocative or allusive marks have been accepted, for example **SHOCKING** for 'discotheque services' (R 1483/2006-2), **AROMA** for 'instructional and teaching material' (R 0619/2007-1), or **DIVINE** for tobacco products (R 0510/2007-4).

c) Geographical indications

In relation to geographical indications the ECJ has stated that the registration of geographical names as trade marks is prohibited where the names designate places which are, in the mind of the relevant class of persons, currently associated with the category of goods in question or are liable to be used in future by the undertakings concerned as an indication of the geographical origin of that category of goods (C-108/97 and C-109/97 *Windsurfing Chiemsee*⁸).

In line with this case-law, in 2007 the Boards refused applications consisting of a geographical indication on its own such as **SPEY** for 'whiskey' (R 0813/2006-4), known as the main whiskey-producing area of Scotland. Geographical indications in combination with descriptive terms were also rejected such as **NORTH SEA ASSET MANAGEMENT** for 'financial services' (R 917/2007-2) and **EUROPEAN POKER TOUR** for 'computer software' (R 0075/2007-4).

The Board considered that as the stainless steel industry in Aalborg is one of the leading ones on the world market, the term 'AALBORG' designates a place that may currently be associated with products and services which may be considered to belong to the stainless steel industry. There may be a public interest in Denmark to keep AALBORG available in relation to such products and services. AALBORG was considered to be devoid of distinctive character in respect of *inter alia* boilers and boiler building services (R 0056/2005-1 **AALBORG**).

d) Slogans and expressions

In several judgments, the Courts in Luxembourg have held that a trade mark which consists of signs or indications which are also used as advertising slogans, indications of quality or incitements to purchase is not excluded from registration simply because of such use. Slogans are not subject to stricter criteria than those applicable to other types of signs (T-138/00 and C-64/02 P 'Das Prinzip der Bequemlichkeit'⁹).

⁷ Decision appealed before the Court of First Instance under Case T-75/08.

⁸ See judgment of the Court of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehör Walter Huber and Franz Attenberger* ('Chiemsee') [1999] ECR I-2779.

⁹ See judgment of the Court of First Instance of 11 December 2001 in Case T-138/00 *Erpo Möbelwerk GmbH v OHIM* ('Das Prinzip der Bequemlichkeit') [2001] ECR II-3739 and judgment of the Court of 21 October 2004 in Case C-64/02 P *OHIM v Erpo Möbelwerk GmbH* ('Das Prinzip der Bequemlichkeit') [2004] ECR I-10031.



In 2007, the Boards have accepted slogans as distinctive at least for certain products or services like **Jack O'Lantern** for '*grave lights, electric lamps, garlands, decorative wall plaques, stockings and tights, toy masks; games*' (R 0549/2005-4) which only alludes indirectly to Halloween, **BUILT TO RESIST** for '*writing paper, postcards, magazines, newspapers, pamphlets, newsletters, forms*' (R 1090/2006-2) as it appeared fanciful where the durability is not required, or **SilentVent** for '*driving motors for land vehicles*' (R 0793/2006-1) and **PRO SEAL** for '*preparations for removal of binding-agents; fertilizers and educational tools*' (R 1634/2006-2) where there is no immediate or only a vague link to the respective products.

Among the cases where the Boards rejected the registration are also some of the slogans mentioned above, namely for goods and services in respect of which they were found to designate quality e.g. **BUILT TO RESIST** for *inter alia* '*clothing, headgear and footwear*' (R 1090/2006-2), or which established an immediate association like **Jack O'Lantern** for '*candles*' (R 0549/2005-4). Slogans that limit themselves to telling the consumer in clear and simple terms that an attractive offer is being made generally also lack distinctive character, see **SUBSTANCE FOR SUCCES** for '*chemicals used in industry*' (R 0816/2006-4), **MORE THAN JUST A HANGER** for '*hangers*' (R 1197/2006-2), **DRINK WATER; NOT SUGAR** for '*non alcoholic beverages; alcoholic beverages*' (R 0718/2007-2), **COOL & SLIM** for '*foodstuff and beverages*' (R 0159/2007-2) and **SUDDENLY SLIM** for '*swimwear*' (R 1397/2006-2).

2. Figurative marks

a) Words

The Courts in Luxembourg have held that where a sign in respect of which registration as a 'figurative mark' is sought consists merely of script in a normal, common font, the script will normally be devoid of any figurative character and therefore its registrability must be assessed in line with the principles governing word marks (see T-32/00 'Electronica'¹⁰).

Cases where the Boards considered the script normal (i.e. the script did not prevent the trade mark from being considered non-distinctive) include script in a black and white label

SmartHouse (R 0218/2007-2 for '*computer software relating to the control of home and office systems*'), capital letters and a simple border **KaufMarkt** (R 1176/2006-4 for *inter alia* '*paints; soaps and perfumery; pharmaceutical preparations; fireworks; furniture; alcoholic beverages*'), capital letters and colours **MADRIDEXPORTA** (R 0944/2006-1 for *inter alia* '*publications, magazines, commercial or industrial business management assistance, financial sponsorship*')

and hand written depictions, such as Style and more... (R 0056/2007-1 for '*light metal wheel rims*') and *Digi-tec* (R 1255/2005-4 for '*hardware and software for the tuning of motor vehicles; multi-media equipment*').

¹⁰ Judgment of the Court of First Instance of 5 December 2000 in Case T-32/00 *Messe München GmbH v OHIM* ('Electronica') [2000] ECR II-3829.



On the other hand, the figurative particulars of the sign  were regarded as sufficient to endow the mark with a minimum degree of distinctiveness (R 0512/2007-2 for ‘gymnastic, sporting, exercise, fitness and weight loss equipment and items’).

b) Images

According to the established decision-making practice of the Boards of Appeal and the Court, simple basic geometric shapes (e.g. squares, rectangles and ovals) are normally devoid of distinctive character (see cases R 330/2005-1 – Blue label, R 973/2005-4 – 4-step plan; likewise the Court of First Instance Case T-122/01 *Best Buy Concepts Inc. v OHIM*, ‘Best Buy’).

In 2007, the Boards allowed several marks to be registered on the basis that the illustration was not a realistic and faithful representation of the product itself, it did not depict the product itself or it did not merely consist of simple geometrical basic forms or of simple, commercially commonplace elements of design, see  (**FLEXIBLE SHAFT**) for ‘machines with flexible shafts for rotating and coating tools of all kinds... and tools’ (R 1243/2006-4);  (**PIPE JUNCTION**) for ‘metal, non-metal building materials’ (R 1363/2006-4);  (**WATER VALVE**) for ‘ironmongery; building materials of various kinds’ (R 1346/2006-4); and  (**TAP**) for *inter alia* ‘ironmongery; controls for central heating systems; apparatus and installations for heating; articles for use in building; goods of wood; etc’ (R 1345/2006-4). The Board also allowed the

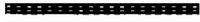
figurative depiction of the profile of a plastic hollow chamber in R 1187/2006-4  (**PROFILE OF PLASTIC HOLLOW CHAMBER**), finding that the schematic depiction of squares included in the upper part of the image was no longer a basic geometric shape and the lower and the upper parts must be considered as a whole.

The Boards rejected images as non-distinctive commonplace representations of the goods with no characteristics notably different from those commonly found in the particular commercial sector, such as  and  (R 1273/2005-4 and R 1274/2005-4 **Part of heating/air conditioning devices**);  (R 0108/2007-2¹¹ **Intelligent Voltage Guard** for goods *inter alia* ‘electric and electronic devices for the operation of lamps ...’ and ‘light-emitting diodes for lighting purposes...’) and  (R 2/2007-4 **Loudspeaker IV** for ‘bass cones sold as a component of audio speakers for electric bass guitars’).

In continuation of their practice, the Boards rejected several pocket design representations as non-distinctive, see *inter alia*  (R 0833/2005-4);  (R 0834/2005-4); and  (R 1205/2006-1) for ‘clothing, especially trousers’ on account of their simple symmetrical design which makes them incapable of being discerned on the goods in Class 25 (see R 0668/2006-1  and R 0669/2006-1 ) as well as being perceived as a decorative element which does not depart

¹¹ Decision appealed before the Court of first Instance under Case T-297/07.



significantly from the practices of the sector (see also **R 1107/2006-2**  (Strepen) for a stripes design on goods in classes 25 and 28).

c) Colours

In accordance with the case-law of the European Court of Justice (C-104/01 'Orange'), the reasons that may lead to the refusal of registrations of single colours include: (a) the limited number of shades of colour that the relevant consumer of the goods can actually distinguish because he is rarely in a position to compare directly products in various shades of colour with one another and (b) the general interest factor, in not unfairly limiting the availability of colours to others operating in the market.

In 2007, the Boards rejected **R 595/2007-4**  (**celeste**) for *race bicycles* and **R 1032/2006-4**  (**red**) for *cargo shipments*. In **R 917/2006-2**  (**Orange**), the colour was rejected for *inter alia 'retail services in the field of home improvements; installations of kitchens, warehousing...'* as it was considered that there was no reason to treat a secondary colour such as orange, and in particular the shade at issue which represented the colour orange in its 'purest' form, any differently from primary colours.

In relation to the combination of colours, the Boards rejected the combination **R 1432/2006-4**  (**yellow and brown**) for *bread or confectionery* (Class 30) and **R 0030/2007-4**  (**colours in squares**) for *scientific measuring; cash registers; paper; scientific and technological services* (Classes 9, 16 and 42).

The Board also found a particular colour pattern used for a 'tractor' to lack distinctive character (**R 1642/2006-1** ).

The Boards allowed the purple colour  for 'foodstuffs and milk for cats' based on distinctiveness acquired through use in fifteen Member States at the time of the filing of the application (**R 1620/2006-2**). See below Section IV E 'Distinctiveness acquired by use'.



d) Position marks

There are no special criteria applying to position marks. Case-law developed for three-dimensional marks¹² consisting of the shape and colours of the product itself may also be relevant if the trade mark applied for is a position mark reproducing elements of the shape of the product. In such cases, the trade mark does not consist of a sign which is independent from the appearance of the product it denotes.

To assess the distinctiveness of a position mark consisting of a geometrical shape placed on a shoe, the Board took into account the fact that such devices have become increasingly common on clothing and particularly on footwear and the public have become accustomed to identifying a particular brand based only on a distinctive pattern or design. The elements at issue in

R 0581/2007-2  and **R 0306/2007-1**  are found to possess distinctive character as they embody a number of geometrical shapes, none of which are common.

On the other hand, an illustration of a large circle, a small circle and a rectangle as common geometrical shapes positioned on the round face of a wristwatch  for 'luxury watches and chronometric instruments' is considered to lack distinctive character because the consumer will see it as a certain and maybe particularly successful design of the goods applied for (**R 1176/2005-1**). An essentially round spot on the centre of the back of a thumb cap of the piston

of a hypodermic syringe  for 'surgical, medical, dental and veterinary apparatus and instruments' (**R 0781/2006-1**) will be considered by the relevant consumer as a trivial marking and lacks the capability, solely on the basis of its shape, outline and positioning, of being

regarded as an indication of commercial origin [see also **R 437/2007-4**  (device of heel nail pattern) and **R 1506/2006-1**  (socks)].

3. Three-dimensional marks

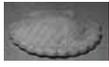
a) Shapes of products

There is in principle nothing to prevent a sign that consists exclusively of the shape of a product from constituting a Community trade mark provided that it is capable of being represented graphically and distinguishing the goods or services of one undertaking from those of other

¹² See *inter alia* judgments of the Court of Justice of 29 April 2004 in Joined Cases C-456/01 P and C-457/01 P *Henkel KGaA v OHIM* ('Tabs') [2004] ECR I-5089; of 12 January 2006 in Case C-173/04 P *Deutsche SiSi-Werke GmbH & Co. Betriebs KG v OHIM* ('Standbeutel') [2006] ECR I-551; 22 June 2006 in Case C-25/05 P *August Storck KG v OHIM* ('Bonbonverpackung') [2006] ECR I-5719; 25 October 2007 in Case C-238/06 P *Develly Holding GmbH & Co. Beteteiligungs KG v. OHIM* ('Plastikflaschenform') [2007] ECR publication pending and the judgment of the Court of First Instance of 12 September 2007 in case T-140/06 *Philip Morris products SA v OHIM* ('Paquet des cigarettes') [2007] ECR publication pending.



undertakings pursuant to Article 4 CTMR¹³. The Courts have stated that, while the public is used to recognizing word marks or figurative marks as signs identifying a product, this is not necessarily so when the sign is indistinguishable from the appearance of the product itself¹⁴.

In 2007, the Boards rejected three-dimensional marks which consist of the appearance of the actual product alone, for example the shell shape  for 'bakery products' (R 0530/2007-

1¹⁵), the key shapes  for 'keys' (respectively R 1414/2006-4 and R 1413/2006-4),

the shape of generators  for 'current generators' (respectively R 0414/2006-4,

R 496/2006-4 an R 498/2006-4), the shape of office chairs  for 'seating furniture' (respectively R 1161/2006-4, R 1162/2006-4 and 1163/2006-4) and the shape of a loudspeaker



for 'loudspeakers' (R 0243/2007-2).

However, the Board considered that the depicted shape  (**Heart**) departs significantly from the norms in the sector of frozen vegetables in shaped pieces since only square or cylindrical shapes are currently available. Thus, the mark applied for was considered sufficiently unusual to merit protection for 'frozen vegetables in shaped pieces, the shape of which is lost during defrosting and preparation to produce an edible meal' (R 0918/2005-4).

b) Bottles and containers

For goods which do not possess an intrinsic shape and must be packaged in order to be marketed, the packaging imposes its shape on the goods. Such is the case, for example, for goods manufactured in the form of granules, powder or liquid which, because of their very nature, lack a shape of their own. Only when the trade mark differs considerably from the norm or custom in the relevant sector can an average consumer distinguish the goods concerned from those of other undertakings (C-218/01 'washing detergent bottle'¹⁶, C-286/04 P 'Corona beer bottle'¹⁷). If the overall impression is that of one usually encountered in that area of commerce and departs

¹³ See, by analogy, judgment of the Court of Justice of 18 June 2002 in Case C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd.*, 'Remington', paragraph 73, [2002] ECR I-5475, and 8 April 2003 in Joined Cases C-53/01, C-54/01 and C-55/01 *Linde AG, Winward Industries Inc. and Rado Uhren AG v Deutsches Patent- und Markenamt*, 'Linde', paragraph 38, [2003] ECR I-3161.

¹⁴ Judgments of the Court of First Instance of 19 September 2001 in Cases T-335/99, T-336/99, T-337/99 *Henkel KGaA v OHIM* ('Tabs') [2001] ECR II-2581, 2589, 2597; of 31 May 2006 in Case T-15/05 *Wim De Waele v OHIM* ('Sausage') [2006] ECR II-1511; of 12 September 2007 in Case T-358/04 *Georg Neumann GmbH v OHIM* ('Mikrophon') [2007] ECR publication pending; judgments of the Court of 29 April 2004 in Joined Cases C-456/01 P and C-457/01 P *Henkel KGaA v OHIM* ('Tabs') [2004] ECR I-5089; of 12 February 2004 in Case C-218/01 *Henkel KGaA v Deutsches Patent- und Markenamt* ('Perwoll') [2004] ECR I-1725; of 7 October 2004 in Case C-126/02 P *Mag Instrument INC v OHIM* ('TORCHES'), ECR I-9165 and judgment of the Court of 22 June 2006 in Case C-24/05 P *August Storck KG v OHIM* ('Karamelbonbon') [2006] ECR II-5677.

¹⁵ Decision appealed before the CFI under Case T-8/08.

¹⁶ Judgment of the Court of 12 February 2004 in Case C-218/01 *Henkel KGaA v Deutsches Patent- und Markenamt* ('Perwoll') [2004] ECR I-1725.

¹⁷ Judgment of the Court of 30 June 2005 in Case C-286/04 P *Eurocermex SA v OHIM* ('Botella Corona') [2005] ECR I-5797.



from the norms of the sector only by secondary features, the sign is not distinctive (C-238/06 P ‘Shape of a Plastic Bottle’¹⁸).

In 2007, the Boards rejected the following shapes as classic or common shapes of bottles:  for ‘paints’ (R 1286/2006-4);  for ‘beers; mineral and aerated waters and other non-alcoholic drinks’ (R 1659/2006-1);  for ‘beers and alcoholic beverages’ (R 0893/2007-4);  for ‘bleaching preparations’ (R 0093/2007-2) and  for ‘coffee, beverages, alcoholic beverages’ (R 1093/2005-4).

The Boards allowed for the registration of the bottle shape  for, *inter alia*, ‘beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices’ for reasons of consistency – the applicant filed two other similar CTM applications on the same day which were accepted without objection – and because the bottle possesses a number of arbitrary features that can attract the consumer’s attention and help to identify the applicant’s products on a supermarket shelf (R 1206/2006-2).

In relation to containers, the Boards considered that the shape  for ‘pharmaceutical products for the treatment of rare diseases’, although it was quite basic and not very original in itself, significantly departs from the usual shape of packages for pharmaceutical products on the market (R 1546/2006-2).

C. Absolute grounds for refusal/invalidity – Article 7(1)(f)-(k) / Article 51(1)(a) CTMR

1. Art. 7(1)(g) CTMR

Article 7(1)(g) CTMR excludes from registration as a CTM those trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services.

In 2007, the Boards found that the mark **POLYblend** was deceptive for ‘raw natural resins’ (Class 2) because raw natural resins cannot be a mixture of polymers and the consumer may believe

¹⁸ Judgment of the Court of 25 October 2007 in Case C-238/06 P *Develey Holding GmbH & Co. Beteiligungs KG v OHIM* (‘Plastikflaschenform’) [2007] ECR publication pending.



that the product which is marketed under the trade mark 'POLYblend' is a mixture of polymers (see **R 0924/2006-1**).

In **R 1102/2005-4 SMARTSAUNA** the Board ruled that a danger of deception did not exist merely because present market conditions indicate that the goods are offered in close proximity to one another and are also used in combined installations, like saunas and solariums.

2. Art. 7(1)(h) CTMR

According to Article 7(1)(h) CTMR which relates to symbols which are protected under the Paris Convention, trade marks containing such symbols are to be refused if the owner has not been authorised by the competent authorities.

In 2007, the Boards refused signs where no authorisation had been granted by the competent authorities and the goods and services were considered capable of creating a reference to the

institutions of the European Community [see **R 0731/2007-2**   and

R 1048/2007-4 ].

Further development of case-law in relation to Article 7(1)(h) CTMR can be expected in view of the CFI's judgment in Case T-215/06¹⁹ *American Clothing Associates, naamloze vennootschap v OHIM* ('RW').

3. Art. 7(1)(i) CTMR

Article 7(1)(i) CTMR protects symbols of public interest other than those already protected by 7(1)(h) CTMR. Trade marks containing such symbols are to be refused if the owner has not been authorised by the competent authorities.

The Red Cross symbol is a symbol protected under Article 7(1)(i) CTMR. Nonetheless, the

Boards allowed the sign  for 'tools, car spare parts and accessories' in Classes 8, 11 and 12 (**R 315/2006-1 D&W Repair**). It was considered that the Red Cross emblem could not be said to be included in the contested CTM because of the difference in colour and because the cross of the contested CTM contains the word 'REPAIR'. This coupled with the goods concerned is likely to be associated with car and motorcycle repairs and not with the Red Cross.

In relation to the emblems protected under Article 6ter (a) and (b) of the Paris Convention, the prohibitions should not apply when the use or registration is not of such a nature so as to mislead the public as to the existence of a connection between the user and the organisation. Both Article 7(1)(h) CTMR and Article 7(1)(i) pursue the same objective; the prevention of use of specific emblems of public interest without the consent of the competent authorities. Therefore, the Board found that the provision of Article 6ter 1(c) of the Paris Convention applied by analogy to the symbol in R 315/2006-1.

¹⁹ See judgment of the Court of First Instance of 28 February 2008 in Case T-215/06 *American Clothing Associates SA v OHIM* ('RW') [2008] ECR publication pending.



4. Art. 7(1)(j) CTMR

In accordance with Article 7(1)(j) CTMR, a sign shall not be registered as a trade mark for wines if it contains or consists of a geographical indication identifying wines not having that origin. The same applies to spirits. According to the Boards' case-law²⁰ it is sufficient for the mark to contain a false geographical indication, e.g. applied to wines of a different origin, to be refused, without it being necessary to determine whether the trade mark as a whole is of such a nature as to deceive the public by misleading the consumers as to the geographical provenance. The Board also confirmed that the question of acquired distinctiveness is irrelevant in relation to Article 7(1)(j) CTMR [see **R 972/2007-2**  (**baron philippe de serres**)].

D. *Bad Faith - Article 51(1)(b) CTMR*

The Boards dealt with several decisions in 2007 regarding the declaration of invalidity of trade marks where the applicant was acting in bad faith according to Article 51(1)(b) CTMR when filing the application. Bad faith is interpreted by the Boards as unfair practices, including a lack of honest intention on the part of a CTM applicant at the time of filing either towards the Office (i.e. submitting wrong or misleadingly insufficient information) or towards a third person's right (see *inter alia* **R 0031/2005-1 ER** and **R 0268/2006-4 MURINA / MURINA**).

It is a general principle of law that good faith is presumed until the contrary is proved. Thus, the burden of proof of *mala fides* is placed on the cancellation applicant (see **R 0336/2007-2 CLAIRE FISHER / CLAIRE FISHER**; **R 255/2006-1 JOHNSON PUMP (fig.)**; **R 1264/2006-2 KRÉMOVÝ**; **R 1265/2006-2 SMETANOVÝ**; **R 1246/2005-1**, and **R 1247/2006-1**, **R 1248/2006-1**, **R 1249/2006-1**, **TRAXDATA et al. / TRAXDATA et al.**).

The Boards consider that bad faith of the person performing the action should be measured objectively on the basis of the information available, and not subjectively (see **R 1246/2005-1**, **R 1247/2006-1**, **R 1248/2006-1**, **R 1249/2006-1**, **TRAXDATA et al. / TRAXDATA et al.** and **R 1337/2005-1**, **R 1338/2005-1**, **R 1339/2005-1**, **R 1340/2005-1 TRAXDATA et al. / TRAXDATA et al.**).

The Board, finding that the concept of 'bad faith' does not require the existence of a registered earlier right of the cancellation applicant, annulled the decision of the first instance in **R 0031/2005-1 ER**. It was considered sufficient that the cancellation applicant is the owner of a sign used in commerce in a large number of countries, especially when the CTM proprietor has been well aware of this use. The Board further held that while the existence of an agency relationship is not a requirement under the bad faith provisions of Article 51(1)(b) CTMR, it can be an indication of a likelihood of bad faith. The Board came to the conclusion that the challenged CTM should be invalidated.

²⁰ See decisions of the BoA **R 1220/2000-2 DUQUE DE VILLENA**, **R 1221/2000-2 DUQUE DE PEÑAFIEL**, **R 946/2002-1 MANZANILLA GONZÁLEZ PALACIOS** and **R 1185/2006-1 CASABLANCA**.



The Boards rejected 'bad faith' in various cases. Negotiations between co-owners of an Argentinian trade mark and a third company to register the trade mark as a CTM did not prove bad faith on the part of the third company in case **R 0020/2006-1 LA MARTINA (fig.)**. Neither does a breach of contract necessarily constitute an act of bad faith [see **R 255/2006-1 JOHNSON PUMP (fig.)**]. The claim for bad faith is also unsubstantiated if the CTM proprietor acted with the cancellation applicant's consent when filing the CTM. The Board found in **R 0268/2006-4 MURINA / MURINA** that the many years which had elapsed before the filing of the invalidity action plead in favour of the existence of consent.

E. Distinctiveness through use: Article 7(3) CTMR

According to the case-law of the European Courts the acquisition of a distinctive character as a consequence of the use of a mark requires that at least a significant proportion of the relevant section of the public identifies products or services as originating from a particular undertaking because of the mark²¹ and that the use must be demonstrated in the substantial part of the Community where the mark is devoid of any inherently distinctive character under Article 7(1)(b) to (d) CTMR²² (**R 1128/2007-2 ALARM DEVICE FOR VEHICLES (3D)**; **R 595/2007-4 Colour celeste**).

In relation to non-verbal marks, it can be presumed that the assessment of their distinctive character is the same throughout the Community [see **R 1107/2006-2 Strepen (fig.)**], unless there are any specific indications to the contrary²³ [**R 1205/2006-1 CLOTHING POCKET DEVICE (fig.)**; **R 711/2006-4 Arrow clip (3D)**]. The Court of First Instance considered that proof must be produced in respect of a substantial part of the Community²⁴. For non-verbal marks, many decisions of the Boards consider that the trade mark has to have acquired distinctive character through use in the entire Community²⁵ [see **R 711/2006-4 Arrow clip (3D)**; **R 595/2007-4 Colour celeste**; **R 437/2007-4 Device of heel nail pattern (fig.)**]. Evidence relating to one Member State is not considered as representative of a substantial part of the Community [see **R 0530/2007-1 Shell (3D)**²⁶].

The Board accepted a purple colour mark based on extensive use all over the EU for 'foodstuffs and milk for cats' (see **R 1620/2006-2** ).

²¹ See judgment of the Court of First Instance of 29 April 2004 Case T-399/02 *Eurocermex v OHIM* ('Botella Corona') [2004] ECR II-1391, at paragraph 42; see also, by analogy, Joined Cases C 108/97 and C 109/97 *Windsurfing Chiemsee* [1999] ECR I 2779, paragraph 52; and Case C 299/99 *Philips* [2002] ECR I 5475, paragraph 61.

²² See judgments of the Court of First Instance of 30 March 2000 in Case T-91/99 *Ford Motor Company v OHIM* ('Options') [2000] ECR II-1925, paragraph 27, of 15 December 2005 in Case T-262/04 *BIC SA v OHIM* ('Briquet à pierre') [2005] ECR II-5959, paragraph 62 and of 5 March 2003 in Case T-237/01 *Alcon v OHIM– Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 52.

²³ Judgment of the Court of First Instance of 15 December 2005 in Case T-262/04 *BIC SA v OHIM* ('Briquet à pierre') [2005] ECR II-5959, paragraph 68.

²⁴ Judgment of the Court of First Instance of 15 December 2005 in Case T-262/04 *BIC SA v OHIM* ('Briquet à pierre') [2005] ECR II-5959, paragraph 69.

²⁵ Judgment of the Court of First Instance of 29 April 2004 in Case T-399/02 *Eurocermex SA v OHIM*, 'Botella Corona' [2004] ECR II-1391, paragraph 47 .

²⁶ Decision appealed before the Court of First Instance under Case T-8/08.



An example of a word mark accepted on the basis of distinctiveness acquired through use is the mark **MEMORY STICK** for ‘*data storage media*’. It was accepted based on the evidence submitted (e.g. sales turnover, extracts from Internet pages, extracts from the applicant’s websites, declarations from witnesses, press articles etc.) which was corroborated by the fact that the mark was registered in the UK on the basis of use and was also registered in Ireland (see **R 0291/2007-2**).

In case **R 667/2005-G** concerning the word mark **CARDIOLOGY UPDATE**, the Board considered that the applicant had not demonstrated that use inside the Community had occurred in such a way so as to allow for the registration of the CTM. The Board found, *inter alia*, that the only fact that had been proved was that professionals from the Community had taken part in conferences outside the territory of the Community (in Switzerland). The Board did not exclude the possibility that an event taking place outside the Community could, over time, acquire a reputation such as to establish its sign within the Community. However, this is provided that the sign is used as a trade mark inside the Community itself in the same fashion, a point which had not been proved. The Board decided that the Office could not base its decision on mere assumptions or probabilities, neither could it infer, from the participation of Community citizens in events organised outside the Community, that use in the Community had taken place. It is for the applicant to bring forward the elements that prove that effective use has occurred and that such use was of such a duration, intensity, nature and geographical scope that the absolute grounds for refusal in Article 7(1)(b) and (c) CTMR would be overcome.

V. RELATIVE GROUNDS FOR REFUSAL/INVALIDITY

A. Relative grounds for refusal: Art. 8(1)(a) CTMR

The Boards confirmed that the protection provided by an earlier trade mark is absolute where the two marks and the goods or services are identical²⁷ [see e.g. **R 0299/2006-2 BUDWEISER / BUDWEISER et al.** for ‘*beer*’ (Class 32), **R 1540/2006-2 ELAN / ELAN** where the applicant’s ‘*tissue heart valves for use in cardiovascular surgery*’ are included in the opponent’s more general category ‘*medical devices*’ and **R 0300/2003-1 PORQUOI PAS / PORQUOI PAS** for *inter alia* ‘*bleaching preparations and other substance...*’ (Class 3)].

B. Relative grounds for refusal / invalidity: Art. 8(1)(b) / Art. 52(1)(a) CTMR

1. Marks composed of letters / acronyms / numbers

²⁷ The Court of First Instance has ruled that goods or services can be considered identical when the goods or services designated by the earlier mark are included in a more general category, designated by the trade mark applied for (see judgment of the Court of First Instance of 23 October 2002 in Case T-388/00 *Institut für Lernsysteme GmbH v OHIM* (‘ELS’) [2002] ECR II-4301, at paragraph 53) or when the goods or services designated by the trade mark applied for are included in a more general category designated by the earlier mark (see judgments of the Court of First Instance of 23 October 2002 in Case T-104/01 *Claudia Oberhauser v OHIM* (‘Fifties’) [2002] ECR II-4359, at paragraphs 32 and 33; of 12 December 2002 in Case T-110/01 *Vedial S.A. v OHIM* (‘Hubert’) [2002] ECR II-5275, at paragraphs 43 and 44; and of 18 February 2004 in Case T-10/03 *Jean-Pierre Koubi v OHIM* (‘Conforflex’) [2004] ECR II-719, at paragraphs 41 and 42)



Letter combinations without figurative elements

The Boards found a likelihood of confusion in cases of identical or almost identical letters, where the goods and services were considered to be similar (see **R 0796/2006-2 IXI / ixi** and **R 0498/2004-1 ISH / ISH**); where the letters are the same although in different order and the goods are identical (see **R 1106/2006-1 LSB / LBS**); where the difference in one letter in the middle of a three-letter acronym cannot be sufficient to distinguish the marks visually and phonetically and the goods and services are identical or similar (see **R 1267/2006-4 R.U.N. / ran**); and where the differences would be seen as a misspelling which makes the signs visually similar and phonetically or conceptually identical (see **R 0292/2005-4 EXEL / XCEL**).

Sole letters with figurative elements

A letter and a simple combination of common letters, without particular figurative adornment, are generally of a rather low inherent distinctiveness. The inherent distinctiveness of such marks largely relies on their particular figurative representation, and thus the more adorned the letters or the more inventive their particular representation, the more distinctive the mark will be.

In 2007, the Boards, found no risk of confusion in case of inherently weak single letters as figurative marks, where the visual differences between the signs due to the figurative elements were capable of counteracting any phonetic or conceptual similarity, even where there was

identity of the goods [see **R 0878/2006-2**  (g) /  (g); **R 1655/2006-4**  (M) /  (M); **R 418/2007-1**  (X) /  (X); **R 1418/2006-2**  (F) / F; *et al.*].

However, where there are no such visual differences and the goods and/or services are identical or highly similar, the Boards have found a likelihood of confusion, see **R 0093/2006-1** and

R 0309/2006-1  (C) /  (C).

A good illustration of the above approach is that taken in **R 0258/2007-2** and **R 0254/2007-2** respectively. The signs  (as) /  (as) were found to be dissimilar due to the peculiar mirror-like graphical representation of the mark applied for (**R 0258/2007-2**), while in the case of  (as) /  (as dara) this unique representation is clearly detectable in both signs, making them confusingly similar irrespective of the additional elements (**R 0254/2007-2**).

Letter combinations with figurative elements

In 2007, the Boards, considered that a risk of confusion existed in situations where the signs being compared consisted of the same letter combination, provided that there was a similarity or

identity of the goods and services and the figurative differences (see **R 0201/2006-4**  (OCB) /  (O.C.B.) *et al.*) or the additional elements were minimal (see *inter alia* **R 1501/2006-2**  (ECS) /  ELITEGROUP; **R 1018/2006-2**  (A.D.S. ANGLOBL DESIGNERS' SHOP) /  (ADS); **R 1266/2006-2**  (G GLITZY) /  (G) *et al.*).



On the other hand, where there is at least similarity between the goods and services, letter combinations with a low distinctive character were found not to lead to a likelihood of confusion

[see *inter alia* R 1502/2005-4  (AD) /  (AD); R 1150/2006-2  (LG) /  (LG); R 0198/2007-1  (TTT) / TTT]. In the case of certain visual dissimilarities even identical goods did not lead to likelihood of confusion (see R 1233/2006-1  (BK) / **BK** (BK) *et al.*). Even assuming that the earlier mark would enjoy an enhanced degree of distinctiveness, the overall dissimilarity between the signs can still be sufficient to rule out a likelihood of

confusion [see R 0318/2006-4  (SL SOFIA LINES) /  (YSL)].

Numbers

Trade marks consisting only of a 'number' or of a combination of numbers might have a very low distinctive character as numbers are normally used to designate the quantity, weight, serial number, etc. of goods. This would argue against a likelihood of confusion. The addition of further elements, however, even if they have a low level of distinctive character themselves, may be

capable of removing a likelihood of confusion [R 1541/2006-4  (1) /  (1)].

2. Earlier mark included in the CTMA and vice versa

The comparison between marks must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32)²⁸.

For examples of likelihood of confusion in cases where one mark was included in the other see: R 0844/2006-1 *Ecoblue / BLUE et al.*; R 0706/2005-2 *WATER MOON / MOON, Moonlight*; R 0686/2006-2 *TBOOKER / TBOOK*; R 0528/2004-4 *YAHOO LIGANS! / Hooligan*; R 1083/2006-1 *Lapis Vitalis / VITALIS*, etc.

Cases, where the Boards considered that there was no likelihood of confusion included those where the common element had only limited distinctiveness. Thus, in R 0457/2004-4 *Douglas beauty spa / BEAUTY SPA*; R 0050/2007-2 *AMAZONIA VIVA / VIVA* and R 0982/2005-4 *IP MANAGER / MANAGER et al.*, the Boards found the non-common element to be the dominant one.

When it comes to the comparison of a verbal sign with a sign consisting of verbal and figurative elements, in principle, the average consumer will more easily refer to the mark in question by

²⁸ See judgment of the Court of First Instance of 23 October 2002 in Case T-6/01 *Matratzen Concord GmbH v OHIM* ('Matratzen') [2002] ECR II-4335. Also see the judgment of the Court of First Instance of 7 July 2005 in Case T-385/03 *Miles Handelsgesellschaft International mbH v OHIM* ('Biker Miles') [2005] ECR II-2665.



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quoting the word element rather than by describing the figurative elements²⁹. The decisions in 2007 where the Boards have decided that the dominant component is the common word element include:

R 0998/2006-2  (SANSON) /  (SANSON); R 0874/2006-1, R 0910/2006-1  (ARANDA) /  (ARANDA); R 1590/2006-2  (EARTH) /  (EARTH) *et al.*; R 1001/2006-4  (ASCOT) /  (ASCOT); R 0004/2006-2 SKIN DOCTOR /  (SKINDOCTORS); R 1164/2006-2  (EX) / EX; etc. .

Sometimes even the addition of further word elements are insufficient to outweigh the similarities created by the dominant word element, see e.g. R 1050/2006-4  (BOOMERANG) /  (BOOMERANG AVENTURA); R 0451/2006-4  (alma) /  (Alma Ducal); R 0033/2006-2  (CRYSTAL AUDIOVIDEO) /  (CRYSTAL SOUND); R 0337/2006-1 and R 0359/2006-1  (RAPPEL WEB.COM) / RAPPEL; R 0206/2005-2 H 15 Boswelan / H 15; etc.).

3. Names / surnames

In 2007, the Boards dealt with various cases concerning marks containing names for identical or highly similar goods and services where the earlier mark was in part reproduced in the CTM applied for. The Boards considered in the cases cited below that there was a likelihood of confusion as the consumer might perceive the marks as designating two different lines of products or sub-brands (in industries where product lines are usual, for example clothing) originating from the same or linked company. With regard to surnames see R 1381/2005-4 JOSE BARÓ / BARO LERIDDA *et al.*; R 1146/2006-2 ENZO CASTELLANO / CALZADOS CASTELLANO; R 0740/2006-2 ALVARO DOMEQ / DOMEQ. With regard to first names see R 0943/2006-2 TEXTURAS POR ALEXANDRA / ALEXANDRA; R 0121/2005-4 & R 0127/2005-4 MANOLO'S ELDA / MANOLO BLAHNIK, *et al.*

The appearance of a famous name affirms the risk of confusion due to conceptual identity, for example in case R 0231/2007-2  (da Vinci) / LeonardoDa Vinci, ,  (LEONARDO DA VINCI) R 0913/2006-1  (ΠΛΑΤΩΝ platon) / PLATO.

Applying the principle of interdependence, a high degree of similarity between the goods can outweigh minor dissimilarities in the names or in the signs, see R 0750/2006-1 CAROLE LITTLE

²⁹ See *inter alia* judgment of the Court of First Instance of 14 July 2005 in Case T-312/03 *Wassen International Ltd v OHIM* ('Selenium-Ace') [2005] ECR II-2897, at paragraph 50.



/ CAROL; R 0346/2006-1 **ADOM** (ADOM) / ADAM or R 1148/2006-1 TOMS / **Mr. Tom** (Mr. Tom).

If the first name is considered to be commonly used and therefore has little distinctive character, the Boards have rejected likelihood of confusion, see R 0836/2006-2 **JANE GRANVILLE** / JANE; R 0823/2006-2 **AMAYA** (AMAYA) / **amaya arzuaga** (AMAYA ARZUAGA) *et al.* and R 1110/2006-2 **ALFONSO** / **PRINCIPE ALFONSO**.

4. **Conceptual dissimilarity v. visual and phonetic similarity**

In 2007, the Boards rendered several decisions in which the fact that one of the marks at issue had a clear and specific meaning was sufficient – where the other mark did not have a clear meaning or a totally different meaning – to counteract to a large extent the visual and phonetic similarities between the marks³⁰ (see R 801/2006-1 **LINEO** / **LINEA et al.**, R 1595/2006-2 **MIMS** / **MIMO et al.**, R 867/2005-2 **NOLITA** / **Lolita**, etc.).

However, a conceptual difference might not always be sufficient to counteract the visual and aural similarities between the signs (R 253/2006-2 **ZOOMERANG** / **BOOMERANG**, R 1056/2006-4 **atraum** / **ATRIUM**, etc.).

5. **Figurative element v. figurative element**

Comparing marks composed of only figurative elements, the Boards decided that, where the goods and services were identical or similar and the differences between the signs could only be perceived when both marks were carefully examined side by side (the general visual impression of the marks being very similar), there was a likelihood of confusion (see R 0768/2006-1



). Special consideration is also given as to whether the earlier mark enjoys a relatively high degree of inherent distinctiveness or has acquired enhanced distinctiveness as a result of its long-standing presence on the market. For a case where the similarities outweighed

the differences, see R 0531/2006-2  (**POLAR BEAR DEVICE**) /  (**POLAR BEAR DEVICE**).

On the other hand, the Boards did not find a likelihood of confusion in case of a completely different graphical composition and impression given to the consumer by the figurative element

(see R 0441/2007-4  (**Apple**) /  (**Apple**); R 0764/2006-2 ). Especially relevant is also whether the figurative element has only a low degree of distinctive character, which focuses the consumer's attention on the differences between the respective shapes; see for

³⁰ Interesting in the context: see judgment of the Court of First Instance of 14 October 2003 in Case T-292/01 *Phillips-Van Heusen Corp. v OHIM* ('Bass') [2003] ECR II-4335; judgment of the Court of First Instance of 22 June 2004 in Case T-185/02 *Picasso estate v OHIM* ('Picaro') [2004] ECR II-1739; judgment of the Court of First Instance of 3 March 2004 in Case T-355/02 *Mülhens GmbH & Co. KG v OHIM* ('Zirh') [2004] ECR II-791 and judgment of the Court of 12 January 2006 in Case C-361/04 P *Picasso estate v OHIM* ('Picaro') [2006] ECR I-643.



example R 0679/2006-4  (HEART) /  (HEART) and R 195-2007-2  (XXX Baci Milano) /  (heart device).

6. Three-dimensional mark v three-dimensional mark

In 2007, the Boards were faced with cases where an opposition against a three-dimensional CTM application was based on a three-dimensional earlier right.

Comparing three-dimensional trade marks in R 182/2005-4  /  , the Board estimated that there was no likelihood of confusion between the earlier mark for a shape of a cigarette box, with a weak degree of distinctiveness, and the three-dimensional mark applied for comprising a cigarette box with a similar shape but in colour and containing the word elements 'Memphis Platinum'.

In Case R 1145/2006-2   /  , the Board did not find a likelihood of confusion between two three-dimensional trade marks consisting of bottle shapes. The differences between the bottles were considered sufficient to take the applicant's bottle outside the scope of protection of the opponent's earlier right. The Board noted that the scope of protection of the earlier right was in any event rather narrow.

Equally, in case R 1096/2006-4  (SHAPE OF BOTTLE) /  (SHAPE OF BOTTLE) the Board found that the average distinctiveness of an earlier trade mark, coupled with the significant differences between the trade marks, can safely exclude a likelihood of confusion in the mind of the average consumer even for identical goods.

C. Relative grounds for refusal/invalidity: Arts. 8(2)(c) and 8(5) / 52(1)(a) CTMR – Well-known marks and marks with reputation

In relation to Article 8(5) CTMR, the Boards have held in various cases, *inter alia* R 1578/2006-2 **JANE / jané (fig.) et al.** that unfair advantage or dilution seems improbable where the goods and/or services claimed in the CTM application are far removed from the goods and/or services for which the earlier right is protected (see also R 0038/2007-2 **Lemon & Soda (fig.) / LEMONSODA**). In line with the judgment of the CFI in Case T-67/04 'Spa-Finders'³¹ the Boards did not accept the contention that any trade mark which has a reputation is entitled to blanket protection against the use of an identical or very similar trade mark in relation to virtually any kind of product or service³². The burden to prove the unfair advantage or detriment is on the opponent

³¹ See judgment of the Court of First Instance of 25 May 2005 in Case T-67/04 *Spa Monopole, compagnie fermière de Spa SA/NV v OHIM* ('Spa-Finders') [2005] ECR II-1825, at paragraph 30 and judgment of the Court of 14 September 1999 in Case C-375/97 *General Motors v Yplon, General Motors v Yplon* ('Chevy') [1999] ECR I-5421, at paragraph 30.

³² See decision of the Boards of Appeal of 5 June 2000 in Case R 802/1999-1 DUPLO/DUPLO, at paragraph 23.



(see *i.a.* **R 1244/2006-1 MARTINI FRATELLI (fig.) / MARTINI**; **R 0198/2007-1 TTT (fig.) / TTT**; **R 0413/2006-1 RICORDI ARTE (fig.) / RICORDI**).

In 2007, the Boards accepted Article 8(5) CTMR where the earlier mark was universally recognised (**R 0371/2006-1 Popsy / PEPSI et al.**), was recognised only in one Member State but was inherently distinctive (**R 0376/2005-4 OPERACIÓN TRIUNFO / OPERACIÓN TRIUNFO**) or was highly distinctive and included in the CTM applied for (**R 1136/2006-2 LIFESPA / SPA et al.**).

Rejecting the application of Article 8(5) CTMR, the Board found that the use of the CTM applied for would be made with due cause in a case where the applicant's mark 'MARTINI' was the family name of the founder of the applicant's company (in Italy it is very usual for family businesses to be named after the founder) and the parties had signed a coexistence agreement (see **R 1244/2006-1 MARTINI FRATELLI (fig.) / MARTINI**).

D. Relative grounds for refusal/invalidity: Articles 8(4) / 52(1)(a) CTMR – Non-registered marks or other signs used in the course of trade

As regards the rights referred to in Article 8(4) CTMR, the onus is on the owner of the right to state which specific laws he relies on. Providing only a national court decision illustrating the interpretation instead of supplying the actual text of the legal provision led to the rejection of the opposition (see **R 0571/2006-2 DILLON'S / Dillons's, Edward Dillon & Co Limited**). Where the opponent did not at any time during the opposition procedure indicate a legal basis for the claim or give any other evidence regarding the protection of unregistered trade marks in the Member State concerned the Board rejected the opposition as unfounded (see **R 1446/2006-4 RM2000T / RM2000T**).

The owner of the right also has to provide the facts that are needed to establish that its right came into existence, was used and is still valid. Following the ruling of the Court of First Instance in Case T-191/04 'Metro/Metro'³³, the Boards found in **R 0163/2006-4 DEKA / DETA** that the right must continue to exist until the date of the decision on opposition or appeal. There is no difference in this regard to registered marks that have not been renewed or have been invalidated prior to the decision being taken. The Board clarified, though, that this does not mean that continuous evidence of use is required. Use prior to the filing date of the CTM was considered not having been proved in a case where the sale of the product bearing the earlier right started after the filing date of the CTM, even if it could be presumed that some advertising might have taken place before (see **R 0201/2007-2 ORACLE of the soil (fig.) / ORACLE**).

Article 8(4) CTMR provides that an opposition may be based on a sign whose use in the course of trade is of more than mere local significance. The Board considered that the application of this provision depends on proof of genuine use of the sign in a context that is not merely local. This condition applies independently of the conditions imposed by national law (see **R 0505/2006-1 Riva y García Fincas (fig.) / RIVA Y GARCIA et al.** where the area of application and protection of the sign was limited to a municipal district and therefore its protection restricted to local commercial use only. Given that the condition of 'more than merely local use' laid down in Article 8(4) CTMR was not met, the opposition was rejected).

³³ See judgment of the Court of First Instance of 16 September 2004 in Case T-342/02 *Metro-Goldwyn-Mayer Lion Corp. v OHIM ('MGM')* [2004] ECR II-3191.



E. Proof of use

The Court of First Instance has stated in several judgments that the request for proof of use must be made to the OHIM expressly and timely.³⁴ The Board considered in **R 0238/2007-2 INTERHOME / INTERHOME** that to formulate the request expressly does not mean that the applicant has to use a mandatory phrase or terminology ('I ask, I request').

The CFI has confirmed that proof of use of the earlier mark also includes use of the earlier mark in a form differing in elements which do not alter the distinctive character of the mark from the form in which it was registered³⁵. In 2007, the Boards considered in **R 0482/2007-2 PIK'OIUC /**

Pickwick COLOUR GROUP (fig.) that the use of the sign  does not alter the

distinctive character of the sign as it was registered  since the figurative element (boy) remains unchanged.

According to the previous decisions of the Boards, the absence [see **R 0650/2006-1 Serhos (fig.) / PODRAVKA VEGETA (fig.); R 1140/2006-2 SCORPIO / ESCORPION (fig.)**] or the presence of a figurative element [see **R 1124/2006-2 ECO-COOL / ECO COILS & COOLERS (fig.)**] having a significant impact on the mark might result in considering that the use made of the trade mark has altered its nature or its distinctive character.

According to the CFI in Case T-39/01, genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned³⁶.

An affidavit produced by a party might, on its own, not be sufficient to establish use, unless it is corroborated with other evidence such as invoices, consignment notes, product labels etc.³⁷, (see **R 0791/2006-2 DEITECH (fig.) / DEI-tex (fig.); R 0547/2006-2 ZERO / ZERNO** and **R 990/2006-1 alinghi (fig.) / ALLINI**, respectively). The Board found in **R 0993/2005-4 cosana / SONANA** that German affidavits, for instance, do not fall under Art. 76(1)(f) as there is no sanction under German law for a false affidavit presented in proceedings before the OHIM.

³⁴ See judgments of the Court of First Instance of 17 March 2004 in Joined Cases T-183/02 and T-184/02 *El Corte Inglés, SA v OHIM*, ('Mundicor'), [2004] ECR II-965, paragraph 38; of 16 March 2005 in Case T-112/03 *L'Oréal SA v OHIM*, ('Flexi Air'), [2005] ECR II-949, paragraph 24, confirmed by order of the Court of Justice of 27 April 2006 in Case C-235/05 P, not published in the ECR; of 7 June 2005 in Case T-303/03 *Lidl Stiftung & Co. KG v OHIM*, ('Salvita'), [2005] ECR II-1917, paragraph 77; and of 18 October 2007 in Case T-425/03 *AMS Advanced Medical Services GmbH v OHIM*, ('AMS'), paragraph 105, not yet published).

³⁵ See judgment of the Court of First Instance of 9 July 2003 in Case T-156/01 *Laboratorios RTB, SL v OHIM* ('Giorgio Aire') [2003] ECR II-2789.

³⁶ See judgment of the Court of First Instance of 12 December 2002 in Case T-39/01 *Kabushiki Kaisha Fernandes v OHIM* ('Hiwatt') [2002] ECR II-5233.

³⁷ Proof of use can be accepted by OHIM even if it was not filed in the language of the proceedings, see Rule 22(6) CTMIR.



The use proved has to be genuine use³⁸. Genuine use does not require economic success³⁹. In 2007, the Boards considered in **R 1370/2006-1 (Bono / Bonbo)** that the proof of use could not be dismissed by the argument that the sales were too few in the large territory concerned.

As a proper reason for non-use, in 2007 the Boards accepted the obligation to follow a specific administrative procedure for re-naming pharmaceuticals in order to be allowed to market a 'new' preparation (see **R 0155/2006-1 LEVENIA / LEVELINA**).

VI. REVOCATION

In 2007, the Boards rendered 8 decisions on revocation of a Community trade mark. Only in three of these cases did the Boards allow the application for revocation on the ground that the CTM owner did not prove the use of its CTM in the Community in connection with the registered goods

and services; see: **R 0523/2006-2 MOTOWN**, **R 561/2006-2**  (**F FORUM**) and **R 1168/2005-4**  (**CRUNCH**).

The Board dismissed the application for revocation, for example, in **R 1209/2005-1**  (**Payless ShoeSource**). In relation to the extent of use of the CTM, the Board considered that it was not necessary for the mark to be used everywhere in the Community. Also, on the extent of use, see **R 925/2006-2 ADDICTION** and **R 35/2007-2 DINKY**. As regard what constitutes 'use', the Boards confirmed in **R 1209/2005-1** that affixing the CTM to goods or to their packaging in the Community solely for export purposes nonetheless constitutes trade mark use.

³⁸ See judgment of the Court of 11 March 2003 in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* ('Minimax') [2003] ECR I-2439; judgment of the Court of 13 September 2007 in Case C-234/06 P *Il Ponte Finanziaria SpA v OHIM* ('Bainbridge') [2007] ECR publication pending, at paragraph 72. See also judgment of the Court of First Instance of 8 November 2007 in Case T-169/06 *Charlott SARL v OHIM* ('Charlott France entre Luxe et Tradition') [2007] ECR publication pending, at paragraphs 33 and 34.

³⁹ See judgment of the Court of First Instance of 8 July 2004 in Case T-203/02 *The Sunrider Corporation v OHIM* ('Vitafruit') [2004] ECR II-2811, at paragraph 48.



VII. DESIGNS

In 2007 the Third Board of Appeal, responsible for appeals on the Registered Community Design ('RCD'), rendered decisions dealing with procedural as well as substantial matters.

A. *Procedural matters*

In **R 0893/2006-3 CLEANING SHEET** the Board called attention to the fact that the failure to submit the application by the desired time is attributable solely to the applicant and in sending its application it should not have relied on the ordinary postal service. The Board rejected the applicant's allegation that the envelope was returned on account of the change of the postal code since the Office still maintains the PO Box address with the same postal code.

The importance of adequate reasoning by the Office has been relevant in some cases, for example where the Office gave a deadline to pay additional fees but failed to specify the amount, leaving letters asking for clarification unanswered (see **R 1125/2006-3 KEY RING**) or where the inconsistency between the reasoning and the conclusion makes it impossible for the concerned party to understand for what reason its RCD was declared invalid (see **R 1456/2006-3 Saucepan handles**).

B. *Notion of ornamentation – Article 3 CDR*

Article 3 CDR (Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs) establishes that the appearance of a product may result from the features of the product itself or from the features of the ornamentation of the product. Those features are, in particular, the lines, contours, colours, shape, etc. of the product or the lines, contours, colours, shape, etc. of the ornamentation of the product. A multiple application for registration of several designs is subject to the rule that the products must belong to the same class (Article 37 CDR).

In Case **R 1009/2006-3 Chapeau gâteau et sa boîte à chapeau**, the Board considered the notion of 'ornamentation'. In this particular case, the Board found that the features of shape, colour, etc. relate to the product *per se*, namely the chocolate hat, the cake and the packaging box and not to its ornamentation. The features claimed could therefore not come under the heading of 'ornamentation'. As the features of the designs did not consist of the 'ornamentation' of the product, acceptance of the multiple application for registration was subject to the rule that the products must belong to the same class (Article 37 CDR).

The Board considered in *inter partes* case **R 1310/2005-3**  (**biscuits**) /  (**biscuits**) that the Invalidity Division correctly limited the comparison to the surface of the two biscuits (the biscuit in the design and the biscuit in the earlier mark) and to exclude aspects depending on its properties (sandwich configuration, colours) or which are commonplace (such as the round shape of the biscuit). The striking ornamentation on the surface of the design biscuit gives a totally different overall impression. Accordingly, the earlier biscuit does not deprive the contested design of individual character.



C. Design versus trade marks - Article 25(1)(e) CDR

If a distinctive sign is used in a subsequent Community design and CTM law or the law of the Member State governing the distinctive sign gives the proprietor the right to prohibit such use, the Community design may be declared invalid.

The Third Board considered the RCDs  (containers) and  (containers) invalid. It decided that the use of the invalidity applicant's identical signs (the three-dimensional CTMs 'DANONE' and 'DANVIVA') in the RCDs on identical products was liable to jeopardise the guarantee of origin which constitutes the essential function of the earlier trade marks and amounted to an unauthorised use by the RCD proprietor which the trade mark owner is entitled to prevent under Article 5(1)(a) TMD (see **R 137/2007-3** and **R 267/2007-3 Containers**).

In Case **R 609/2006-3**  (midas Everything we touch is safer) / MIDAS, the Board found that the trade mark 'MIDAS' was used in the contested design. The Board also concluded that in their overall impression the signs were similar, MIDAS being the dominant element in the design. The two-dimensional figurative logo, which constitutes the contested RCD, may be applied to an infinite range of products and services, including the products covered by the invalidity applicant's international trade mark registration. It is conceivable that when the public encounters the contested RCD applied to products, their packaging or their get up, they will perceive that logo as an indication of the commercial origin of the products in question and not as a pure embellishment. The Board declared the RCD invalid.

D. Others

Further examples of design decisions in 2007: **R 266/2007-3 eliche per imbarcazioni**, concerning the notion of a 'symbol' that must not appear on the drawings, Article 4(1)(c) CDR; **R 250/2007-3 tavoli**, concerning the notion of informed user, Article 6 CDR; and **R 1482/2006-3 perfiles**, concerning the notion of divulgation of the earlier design (Article 7(1) CDR) and the evaluation of evidence of divulgation (catalogues, invoices, etc.). Several decisions dealt with "self-divulgation" that destroys novelty, for example, a catalogue having all the trappings of a 'real catalogue' (not a draft or a proof) is *prima facie* evidence of divulgation [see *inter alia* **R 1401/2006-3**  /  and **R 1405/2006-3** ].

The Board also found that small differences like the depth of the grooves, the number of stripes etc. will not confer individual character on a hamburger design [see **R 1214/2006-3**  (meat foodstuffs) and **R 1215/2006-3**  (meat foodstuffs)], and, similarly, that the overall impression of a highly technical apparatus (lawnmower) is influenced more by the general lay-out of the components than by relatively immaterial details of each component [see **R 1380/2006-3**  /  (Internal-combustion engine) and **R 1337/2006-3**  /  (Internal-combustion engine)].



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