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User satisfaction: A new approach

For the past two years, OHIM has been running a professionally-designed User Satisfaction Survey (USS), in order to get feedback on services and guidance on what users need. In January, the process starts again for the third time, with a change in emphasis in both the questions and the objectives.

The survey is carried out for OHIM by GfK Emer, which is part of the multinational GfK group, the fifth largest market research group in the world. GfK study manager Angeles Bacete says that the first two surveys were used to make an initial diagnosis of the quality of services provided in the Office's different areas of activity.

"Because the evaluation had no precedent and there were no studies available carried out by similar organisations that could be used as a reference, it seemed prudent to repeat the same analysis over two years to check the consistency of the diagnosis", says Bacete.

The first surveys were used to draw up the OHIM Service Standards, based on in-depth knowledge of the needs expressed by users. The new questions that users will be asked this year aim to establish how important they think it is for the Office to work to improve the key services, such as the e-business tools.

They will also be asked if they think the accessibility, timeliness and quality targets that the Office has set itself are reasonable, and if they have already noticed improvements compared to the previous year.

"If it is to continue to be useful, the USS must be a living resource and so this year we need to evaluate the measures adopted by the Office in each of the areas of activity", Bacete adds.

As study manager in GfK, Bacete has a wide professional experience of quality and user satisfaction studies in public and private sector bodies. She believes it is important that the results of these studies are used to stimulate a process of organisational change, so that a USS becomes a tool for improvement and not merely an information resource.

To ensure compatibility with the results of the previous surveys the next questionnaire will retain the questions used to draw up the Overall Satisfaction Index.

At the beginning of January, users will receive an e-mail invitation, containing a personal link, to take part in the study, and they will be given all month to answer the questionnaire. A report on the results is expected to be available at the end of February or the beginning of March 2008.

Bacete says that the USS is an open door allowing the expression of opinions. "It is an opportunity to orientate the office in the direction of its professional needs and concerns: the more users take part, the greater will be the general value and utility of the research and the benefits that will accrue", she adds.

The James Nurton interview with Verena von Bomhard, Lovells, Alicante

James Nurton is a specialist intellectual property journalist from the UK and is currently the managing editor of the leading global magazine for IP owners, Managing Intellectual Property.

When did you first start working in trade marks?

It was 1995. I became involved because I spoke Spanish. I was an environmental lawyer with Droste in Germany and we were looking to open a Spanish office when the Community trade mark launched. I had studied Spanish back in 1984, before studying law.

Was it a big change?

It was. Not that I disliked the other practice areas, but trade marks brought a very interesting clientele. There was international travel from day one and lots of contact with international clients. I did a crash course in Hamburg, which was the centre-of-gravity for our German trade mark practice.

I moved here before I had ever seen Alicante, with an initial three to four year secondment. I was my own boss from day one and for a time the office was just me and a secretary. But we have grown since and in 2000 another lawyer joined me. We now have 16 lawyers from seven jurisdictions in the group.

The majority of our clients are big global companies. About 70% are American, and we also have lots from Germany, Japan, the UK and Switzerland. Our firm adopts a centre-of-gravity approach so everything to do with Community trade marks goes through the Alicante office. We only file from other offices if using the Madrid Protocol. So here we advise exclusively on filing and accompany advice on enforcement.

**Is it an advantage to be in Alicante?**

Actually being able to visit OHIM and take things there by hand is only an advantage in exceptional cases. But being here has fostered our focus on the CTM and led to us becoming specialists. I think some agents argue national arguments before OHIM, but often the Office wants to hear about Community law and not necessarily what the member states have to say. It is a good thing to have lawyers from different member states with their different backgrounds. But we could be in Helsinki or Malta.

However, we have been able to follow OHIM very closely since it opened – we've had representatives in various associations and participated in users' meetings. And it is good on a social level too.

How many marks have you filed?

We've handled a little over 6,000 CTMs since the start. This year we have filed 470 so far; 500 is a pretty typical average per year.

What about Community designs?

That number is smaller. We find that more of that work goes to patent attorneys. But we have filed about 400 or so designs for Japanese applicants, many of whom were our existing clients who have been very loyal. A lot of these applications have been for electrical and electronic appliances.

We advise clients to consider designs especially given OHIM's stance towards three-dimensional trade marks which are very difficult to get. Designs are very easy to get but hard to defend, so at the application level there is little legal input but a lot more for enforcement.

What is the most unusual mark you have filed?

We filed a sound mark for just one tone and it was accepted. It was for insurance services and there was a lengthy description and a tone file. The client was Allianz and it was a very unusual tone. It was a straightforward application – good preparation led to success.

Do you think the practice on trade marks is too strict?

I don't think they have it quite right. They do for sounds: they are not strict for graphical representation or at all for distinctiveness. There is a sharp contrast with shape and colour marks, but the Office is bound by what the ECJ has said. The Board of Appeal once said that the average consumer does not consider shapes to be indicators of origin and that has been upheld by the ECJ in many cases. I don't think it's right; it could have been much more flexible.

But it is very difficult to get that changed, at least in the medium-term, unless a large number of applicants are willing to throw in more money to show how consumers see the shape of goods or signs. There are occasional exceptions, though, such as the Nestlé bottle and the Bang & Olufsen decision. But in general there is no real hope at the moment.

Do you use the electronic services?

We do and have done almost from the start. The problems were remedied very early and we were filing electronically even before the fees went down. I was a bit sceptical about online access to files, particularly about the briefs being

available. I've come round except where confidential information is disclosed, so I no longer have a problem with it.

How can OHIM improve?

The Office could throw more resources at internal legal training, to improve harmonization. It has recently focused on efficiency and quantity, which we welcome, but a refocusing on quality and giving guidance to other offices is needed. So I think they could increase the personnel on the legal side, both at the Boards and the operations level. There should be more time for internal discussion.

Another thing is the communication to the outside world of the evolving examination and opposition guidelines. Internal guidelines on major changes in practice are not always circulated.

What about the fees?

They're completely acceptable. For most clients, they're the last things to consider. At the moment the US dollar exchange rate is high but even so for most clients trade marks are by no means the largest part of the budget. Most of them are more concerned about quality, swiftness and efficiency. So we would like to see investment in additional personnel – we have had too much frustration from experiences especially at the middle and lower levels of work.

Do you recommend the Madrid Protocol?

We recommend it depending on the situation. Our German and Swiss clients have all switched to the Protocol, but it is a different issue for clients in the US : because of the specificity of the specification, there is a risk to the mark. But it is an excellent tool.

What has been your experience of enforcement?

We have seen a few differences between national courts, for example about what is reputation in one country rather than another, and we have received pan-European injunctions in one country but not in another. There is an ECJ reference from Austria about what is reputation in the Community, which I'm happy about as it absolutely needs to be clarified. And the ECJ must answer once and for all the question: what is a CTM?

We also need a case on whether use in one country will be enough to sustain a CTM. I think the threshold for genuine use should be based on quantity rather than trans-border. It shouldn't be necessary to cross borders to show use. The ECJ will eventually be asked to address that: how much use do you have to have to block one trade mark? These issues will become more important, but there is no need for panic.

What changes do you expect in the future?

I think there are two main issues for the CTM. First, how to continue the principle of a unitary right with equal effect throughout the Community, which will become difficult as the EU grows and we have different consumers and experiences.

Second, we have to consider minority languages in a global world. Languages such as Russian, Turkish and Arabic are widely spoken in Europe but are not taken into account. So there are cancellation issues: can you protect a term that is descriptive in one of those languages?



Community Trade Mark

Objecting to a CTM: The role of third party observations

In addition to the opposition procedure, which allows holders of prior rights to seek to prevent registration of a CTM during the three months after publication, OHIM accepts third party observations on applications after they have been published.

The procedure is used primarily by individuals and associations that are keen to protect the “purity” of the trade mark register, and sometimes as an alternative route for opposing a trade mark by owners of prior rights who have also filed an opposition.

Third party observations can only be made on absolute grounds, such as the argument that the mark is not eligible because it is “descriptive” or, for example, is contrary to public policy.

OHIM receives around 100 third party observations per year and, according to the director of the trade marks and cancellation department, Beate Schmidt, most do not succeed. “There are, however, some well-argued third party observations, which do lead to the re-examination of cases, and a changed decision”, says Schmidt.

In one case, an association connected to a wine-making area wrote to OHIM pointing out that an application for a wine trade mark incorporating the name did not specify that the wine was made in the area referred to.

Another case, involving a Spanish tile manufacturer, Tau, was published by OHIM and then refused following a third party observation that the word “tau” in Lithuanian meant “for you”, making the trade mark “descriptive” in that language, and therefore ineligible.

In a third case, the application for the trade mark “Not Made in China” was initially published by OHIM, but re-examined and then refused after an observer pointed out that the mark cast a slur upon the reputation of Chinese workmanship and was therefore “contrary to public policy or to accepted principles of morality”. This refusal was confirmed by the Boards of Appeal, albeit on a different ground. (Case R1454/2006-4 of 11 December 2007).

When a third party observation is made, the “observer” does not become a party to the proceedings before the Office, but the observations are copied to the applicant, who may then comment on them.

In all cases, the OHIM examiner considers whether the observations are well-founded – that is, whether an absolute ground for refusal exists – and if that is the case, issues an objection which may ultimately lead to a refusal.

If the observation covers matters that have already been considered by an examiner and no new facts or evidence is provided, it is unlikely to lead to serious doubts after publication. Nevertheless, the Office is obliged to inform the third party of the action taken and the outcome.

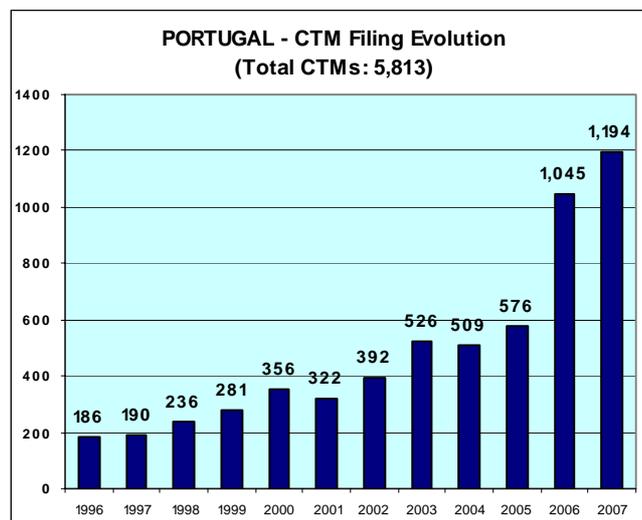
“Third party observations hold up our decisions on absolute grounds to public scrutiny. That means, they act as a valuable quality check for OHIM even though we get relatively few of them compared with the overall number of CTM applications”, says Schmidt.

Country overview: Portugal & the Community Trade Mark



Portugal joined the EU in 1986, and has a population of 10.6m. Economic performance is currently lagging behind the EU average, with GDP growth running at 1.8% higher in the third quarter compared with the same period in 2006. The service sector accounts for 66% of GDP, followed by industry (26%) and agriculture (8%).

Since 1996, Portugal has filed a total of 5 813 CTMs, with the numbers filed annually rising steadily year on year. This year is another record with almost 1 200 filed.



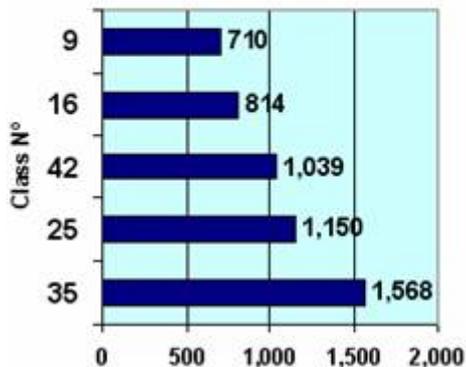
Word	Figurative	3-D	Colour	Other
54.26 %	45.1 %	0.48 %	0.07 %	0.09 %

More than 54% of trade mark applications by Portuguese enterprises are for word-based marks, with almost all the remainder figurative marks (45%).

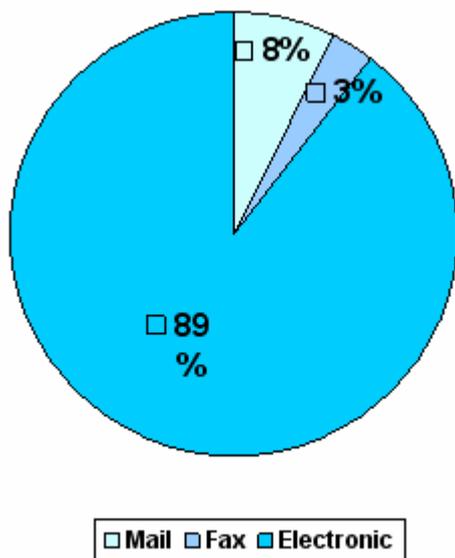
The most popular goods and services applied for by Portuguese businesses are in classes 35, 25 and 42.



PORTUGAL - Top Classes Filed
(Nice)



E-filing is by far the most popular route for Portuguese businesses and their intermediaries. This year, including International Registrations, 89% of all CTM filings were made electronically, while fax accounted for just 3%.



Top 10 Portugal-based owners by number of CTMs filed

Company	CTMs
Silva.	604
Sogrape Vinhos , S.A.	97
Portucel-Empresa Produtora de Pasta e Papel, S.A.	62
GALP ENERGIA (SGPS) SA	47
CAIXA GERAL DE DEPOSITOS, S.A.	33
Rodi-Metalúrgicas do Eixo, S.A.	33
SOGEVINUS FINE WINES, S.A.	32
COMPANHIA GERAL DA AGRICULTURA DAS VINHAS DO ALTO DOURO, S.A.	29
MELOPHONE CONSULTORES E SERVIÇOS LDA.	28
Petróleos de Portugal-Petrogal, S.A.	27

Top 10 representatives by number of CTMs received from Portugal-based applicants

Representative	CTMs
J. PEREIRA DA CRUZ, S.A.	861
RAUL CESAR FERREIRA (HERD.), LDA.	254
SIMÕES, GARCIA, CORTE-REAL & ASSOCIADOS - CONSULTORES, LDA.	240
FURTADO - GABINETE TEC. DE MARCAS E PATENTES	199
Da Silva Pelayo de Sousa Henriques	187
GASTÃO DA CUNHA FERREIRA, LDA.	173
A.G. DA CUNHA FERREIRA, LDA.	169
ALVARO DUARTE & ASSOCIADOS	167
GARRIGUES, CUNHA FERREIRA, LDA.	152
RUI PENA, ARNAUT & ASSOCIADOS	130

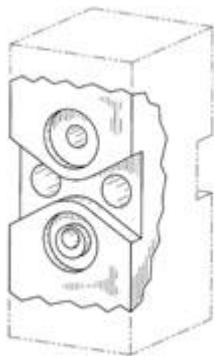
Community Design

“Must-fit” clause kills Community design

A Community design has been declared invalid for the first time on the grounds that its form and dimensions were necessary in order to make it fit with another product.

OHIM's Invalidity Division ruled on the basis of Article 8(2) CDR because the design subsisted in “features of appearance of a product which must necessarily be reproduced in the exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function.”

The contested Community design [000232996-0001](#) had been registered for the product “fluid distribution equipment” including 4 views, with the first one as follows:



The Office received an application for a declaration of invalidity in which the applicant argued that the product in which the RCD was incorporated was called a “module” which was fixed to the application head of a hotmelt application system.

The applicant observed that the RCD showed two bores which were necessary for fixing the module to the application head and two holes had to fit exactly with two corresponding holes in the application head in order to provide glue and compressed air to the module. Furthermore, there was a recessed area which must be the corresponding negative of an elevation area at the application head for there to be a perfect fit.

Defending the RCD, the holder denied that it was a “Must-Fit”-part, “since only the two bores for the screws and two further bores for the adhesive hotmelt channels have a technical function. Since the registered design also can be mounted in different ways to different manifolds or other devices, the ‘Must-Fit’-argument does not apply.”

When the module was connected to a flat surface, the recess had no technical function at all. Rather, it only had a design function. Thus, the “Must-Fit” criterion could be applied to the bores itself, but not to their positions and the shapes of the recess/elevations. There was no technical need to copy the exact shapes of the recess in order to achieve a similar technical function. Furthermore, the recess was not necessary to connect the product to another part.

In its decision of 20 November 2007 in case ICD 2970 the Invalidity Division rejected the argument of the holder because it “does not eliminate the fact that the features of the RCD must be reproduced in their exact form and dimensions to fit to a given device. The location and shape of the holes, bores and recess of the module are pre-defined by the corresponding parts of the head. In particular, a head with a specific elevation only allows the mounting of a module with a corresponding recess. The recess must fit to the elevation like a key to a keyhole.”

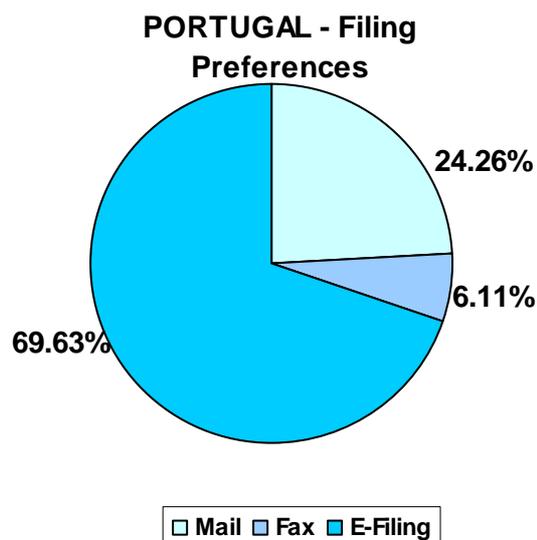
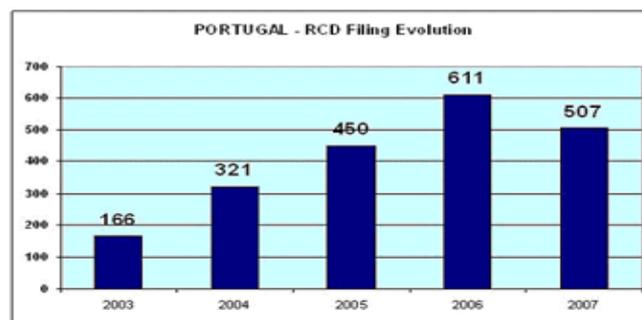
The Invalidity Division concluded that “the RCD subsists in features of appearance of a fluid distribution equipment which must necessarily be reproduced in the exact form and dimensions in order to permit the fluid distribution equipment in which the RCD is incorporated to be mechanically connected to the head of a hotmelt application system so that either product may perform its function. Therefore, the RCD is

to be declared invalid according to Article 25(1)(b) CDR in conjunction with Article 8(2) CDR.”

Country overview: Portugal & the Registered Community Design

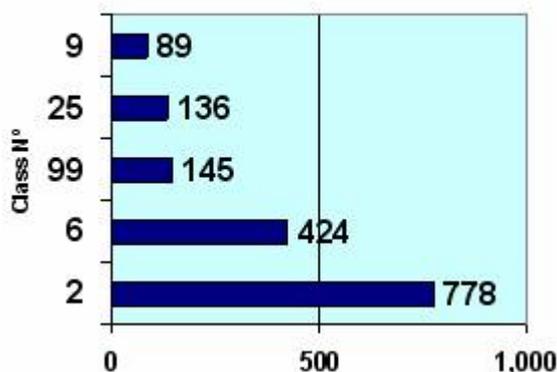
Portuguese filings of RCDs have been growing steadily since 2003 and reached over 600 in 2007. So far this year, around 507 applications have been made by Portuguese businesses.

The most popular classes for design owners are 2, 6, and 99. In common with other countries, there has been a big move to using the Internet to transact business, and this year e-filing accounts for over 70% of Portuguese RCDs. Mail, at 24%, is the second most popular route, and just under 6% of applications come by fax.





PORTUGAL - Top Classes Filed (Locarno)



Top 10 Portugal-based owners by number of RCDs filed

Owner	RCDs
ATLANTA - Componentes para Calçado, LDA	515
OAT-ORIGINAL AUTHENTIC TRENDS, S.A.	173
INVESTVAR INDUSTRIAL, S.G.P.S., S.A.	59
CASTROS, Iluminações Festivas, S.A.	50
PORTA XXI, L.DA	46
CAMPOS & FILHOS, S.A.	45
Melo e Silva	45
IETA - INDÚSTRIA DE ESTOFOS E TRANSFORMAÇÃO DE AUTOMÓVEIS, S.A.	40
RINO & RINO, LDA	37
VAPESOL-FABRICA DE COMPONENTES PARA CALÇADO, UNIPESSOAL, LDA	36

Top 10 representatives by number of RCDs received from Portugal-based applicants

Representative	RCDs
Afonso	174
GUIMARQUE GABINETE DE MARCAS E PATENTES, LDA	173
Da Silva Pelayo de Sousa Henriques	118
J. PEREIRA DA CRUZ, S.A.	108
ALVARO DUARTE & ASSOCIADOS	44
SIMÕES, GARCIA, CORTE-REAL & ASSOCIADOS - CONSULTORES, LDA.	43
RAUL CESAR FERREIRA (HERD.), LDA.	39
FURTADO - GABINETE TEC. DE MARCAS E PATENTES	37
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Case-law

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A-1: ECJ Judgments and Orders

Rockbass: C-307/05-P – Appeal from T-315/03; case closed; Order of 11 October 2007 (only FR, DE).

Keywords: CFI proceedings: impact of a withdrawal of the CTM at pending proceedings – Absolute grounds for refusal: distinctiveness.

The action had been directed against a decision of the CFI of 8.6.2005 in Case T-315/03 (2005) ECR II-1891, by which it had confirmed rejection of CTM application Rockbass (word mark), applied for for a range goods in Classes 9, 15 and 18 for, *inter alia*, musical instruments and related products. The 3rd Chamber of the ECJ (Löhmus; Cunha Rodrigues; Klucka (rapporteur); Arabadjiev; GA: Sharpston) held that, since the CTM applicant withdrew the application pending proceedings,

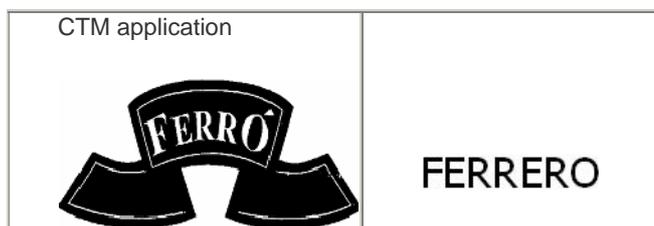


the case had to be closed because neither the plaintiff nor the Office had stated a legal interest in continuing proceedings.

Ferró/Ferrero: C-225/06-P – Judgment of 11 September 2007 (appeal from T-35/04; dismissed; Office practice confirmed).

Keywords: Opposition: likelihood of confusion (LOC).

The case had been an appeal from a judgment of the CFI of 15.3.2006 in Case T-35/05 (2006) ECR II-785, by which the CFI had rejected an appeal against a decision of the 1st Board of 1.12.2003 in R 0460/2002-1, partially refusing the application of FERRÓ (figurative mark) for a range of goods in Classes 29, 30 and 42.

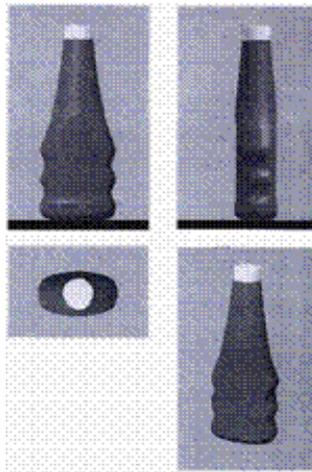


The goods in Class 30 had been: coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, biscuits, pastry and confectionery, ices, honey, syrup, yeast, baking powder, salt, mustard, all kinds of bread preparations, pepper, vinegar, sauces (condiments), ice and treacle. The CTM application had been rejected for certain goods in that class, namely: coffee, tea, cocoa, sugar, artificial coffee, flour and preparations made from cereals, bread, biscuits, pastry and confectionery, ices, syrup, yeast, baking powder, all kinds of bread preparations, honey and treacle. The 8th Chamber of the ECJ (Juhász; Arestis (rapporteur); Malenovsky; GA: Ruiz-Jarabo Colomer) confirmed these findings.

Develey bottle or Plastikflasche: C-238/06-P – Judgment of 25 October 2007 (appeal from T-129/04; appeal dismissed, Office practice confirmed)

Keywords: Absolute grounds for refusal: distinctiveness – Absolute grounds for refusal/distinctiveness: burden of proof – Absolute grounds for refusal: impact of the Paris Convention and Trips – Absolute grounds for refusal: impact of national practice; responsibility to apply the same standards? – Distinctiveness: 3D signs – 3D signs: shape of the product itself – 3D signs/shape of the product itself: perception of the target consumers.

The case had been an appeal from T-129/04, *Develey v OHIM*, of 15.3.2006 (2006) ECR II-811. By that judgment, the CFI had rejected an appeal against a decision of the 2nd Board of 20.1.2004 refusing registration of a 3D sign, a plastic bottle (shown above), which had been applied for for a range of goods in Classes 29, 30 and 32.



The 8th Chamber of the CFI (Arestis; Silva de Lapuerta; Juhász (rapporteur); AG: Ruiz-Jarabo Colomer) confirmed the rejection.

(a) *Absolute grounds for refusal: impact of the Paris Convention and Trips*

(37) As a preliminary point, it is necessary to examine whether the provisions of the TRIPs Agreement and the Paris Convention are directly applicable in the context of the present proceedings.

(38) With regard to the TRIPs Agreement, it must be recalled that, according to the final recital in the preamble to Decision 94/800, the Agreement establishing the World Trade Organisation, including the annexes thereto, is not susceptible to being directly invoked in Community or Member State courts.

(39) In addition, the Court has held that the provisions of that agreement are not directly applicable and are not such as to create rights upon which individuals may rely directly before the courts by virtue of Community law (see, to that effect, Case C-149/96 *Portugal v Council* [1999] ECR I-8395, paragraphs 42 to 48; Joined Cases C-300/98 and C-392/98 *Dior and Others* [2000] ECR I-11307, paragraphs 44 and 45, as well as Case C-245/02 *Anheuser-Busch* [2004] ECR I-10989, paragraph 54).

(40) The provisions of the Paris Convention also cannot be relied on directly in the present case.

(41) First of all, the Community is not a party to the Paris Convention, in contrast in fact to the TRIPs Agreement.

(42) Secondly, when the Community legislature considered it necessary to give some provisions of the Paris Convention direct effect, it expressly referred to them in Regulation No 40/94, in particular, in relation to absolute grounds for refusal, in Article 7(1)(h) and (i) of that regulation. By contrast, Article 7(1) makes no such reference in relation to the distinctive character of trade marks, and the Community legislature has in this respect created a separate provision in Article 7(1)(b) of Regulation No 40/94.



(43) Thirdly, while the direct effect of the Paris Convention could flow from the cross-reference made to it by Article 2(1) of the TRIPs Agreement, such a cross-reference cannot, in the absence of the direct applicability of the TRIPs Agreement, render the Paris Convention directly applicable.

(44) Consequently, in the present case, neither the TRIPs Agreement nor the Paris Convention is applicable and the Court will examine the grounds of appeal only in so far as they allege a breach by the Court of First Instance of Regulation No 40/94.

(b) Absolute grounds, Article 74(1) CTMR, and the issue of "burden of proof"

(45) Develey submits that the Court of First Instance failed to apply Article 74 (1) of Regulation No 40/94, concerning the burden of proof. In addition, according to Develey, the Court of First Instance should have annulled the contested decision, because that Court itself held that the mark applied for has distinctive character by admitting in paragraph 52 of the judgment under appeal that the mark sought stands out from the trade marks common in the trade.

(46) Develey submits further that the Court of First Instance's reasoning in relation to what guides consumers in making their choice is contrary to that Court's case-law (Case T-305/02 Nestlé Waters France v OHIM (Shape of a bottle) [2003] ECR II-5207, paragraph 34, and Case T-393/02 Henkel v OHIM (Shape of a white and transparent bottle) [2004] ECR II-4115, paragraph 34). The use of a shape as an indication of the origin of a product has more importance, because consumers make a preliminary choice on the basis of the shape of the packaging and only thereafter study the label.

(48) First of all, as the Court of First Instance recalled in paragraphs 15 and 16 of the judgment under appeal, in the context of an examination of the existence of absolute grounds for refusal under Article 7(1) of Regulation No 40/94, the role of OHIM is to decide whether the application for the trade mark falls under an absolute ground for refusal.

(49) Further, it must be added that, under Article 74(1) of Regulation No 40/94, OHIM must examine of its own motion the relevant facts that could lead it to apply an absolute ground for refusal.

(50) Finally, it must be stated that it was correctly pointed out in paragraph 21 of the judgment under appeal that, if an applicant claims that a trade mark applied for is distinctive, despite OHIM's analysis, it is for that applicant to provide specific and substantiated information to show that the trade mark applied for has either an intrinsic distinctive character or a distinctive character acquired by usage.

(51) Therefore, the Court of First Instance did not fail to observe the rules governing the burden of proof.

(c) Impact of national practices

(62) Develey submits that the judgment under appeal is inadequately reasoned in relation to the examination of the

earlier national registration. In addition, since trade mark law has been harmonised, OHIM and the national examiner should lay down the same requirements in relation to distinctive character.

(63) As regards the finding of facts, OHIM contends that the explanations which Develey's representatives provided during the proceedings before it were not very informative and were restricted to unverifiable assertions concerning the German registration. Since OHIM's Board of Appeal was never informed of the exact reasons that led to that registration being granted, the Court of First Instance cannot be accused of having distorted the facts in this respect. (64) As regards the failure to give reasons, OHIM points out that its duty to provide reasons for individual decisions has two purposes: to allow interested parties to know the justification for the measure taken so as to enable them to protect their rights and to enable the Community judicature to exercise its power to review the legality of the decision. OHIM contends that the fact that Develey does not agree with the reasons given by the Board of Appeal and their confirmation by the Court of First Instance is not enough to support a plea that the judgment under appeal failed to give reasons. According to OHIM, the Court of First Instance was correct in law to hold that the contested decision gave sufficient reasons; consequently, its judgment could in no way be challenged on the basis of Article 73 of Regulation No 40/94.

(Findings of the Court)

(65) As regards the decision of the Deutsches Patent- und Markenamt to which Develey refers, it suffices to recall – as the Court of First Instance did in paragraph 32 of the judgment under appeal – that the Community trade mark regime is an autonomous system with its own set of objectives and rules peculiar to it, and that that system applies independently of any national system.

(66) Consequently, the mark applied for must be assessed only on the basis of relevant Community rules and the national decision can under no circumstances call in question the legality of either the contested decision or the judgment under appeal.

Selezione Oro: C-245/06-P – Appeal from T-344/03, ECR (2006) II-1097; Judgment of 9 March 2007 (distributed end of October 2007; only in FR, IT; action dismissed; Office practice confirmed).

Keywords: Opposition: likelihood of confusion (LOC).

The action had initially been directed against a decision of the 4th Board of 18.7.2003 in R 0480/2002- 4 by which it had rejected an opposition, lodged by Saiwa SpA, against CTM application Selezione Oro Barilla (figurative mark), applied for





in Class 30. The CFI had confirmed the Board's decision.

It had been opposed on the basis of several earlier rights in the word ORO and ORO SAIWA, also registered in Class 30. The opposition had been rejected on the grounds that the marks are not sufficiently similar to give rise to LOC. The 7th Chamber of the ECJ (Klucka (rapporteur); Cunha Rodrigues; Arabadjiev) dismissed the action.

Torre Muga/Torres: C-405/06-P – Appeal from T-247/03; Judgment of 24 September 2007 (only in FR, ES; action dismissed, Office practice confirmed).

Keywords: Opposition: likelihood of confusion (LOC) – LOC: enhanced recognition of the earlier mark.

The action had initially been directed against a decision of the 1st Board of 7.4.2003 in R 0998/2001-1 by which it had rejected an opposition, initiated by Miguel Torres SA, against CTM application Torre Muga (figurative mark) which had been applied for in Class 33.



The opposition had been based on a range of earlier rights in the marks Torres and TORRES, all in Class 33. The opposition had been rejected on the grounds that the marks are not similar. In such a case the fact that the invoked mark enjoys high recognition on the market is irrelevant. The 7th Chamber of the ECJ (Klucka; Lindh; Arabadjiev, rapporteur) confirmed these findings.

A-2: ECJ: Developments in pending cases

Eurohypo: C-304/06-P – Appeal from T-439/04; Opinion of Advocate General Mrs. Verica Trstenjak of 8 November 2007 (not in EN).

Keywords: Absolute grounds for refusal: examination ex officio; scope – Article 7(1)(b) and (c) CTMR: relationship.

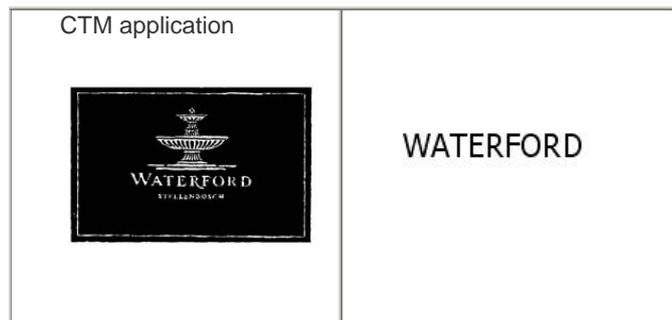
The case is an appeal from a decision of the CFI of 3.5.2006 in T-439/04 relating to CTM application Eurohypo (word mark) for a range of services in Class 36. It had been rejected for most of the claimed services on the grounds that the sign would be descriptive, relying in that respect also on Article 7(1)(b) CTMR. The CFI had confirmed these findings. Notwithstanding that the Advocate General concluded that the sign at issue is descriptive within the meaning of Article

7(1)(c) CTMR, she nonetheless proposed revoking the judgment of the CFI and also the decision of the Board because they had applied “descriptiveness” within the wrong absolute ground for refusal, namely within Article 7(1)(b) CTMR.

Waterford Stellenbosch: C-398/07-P – Appeal from T-105/05; Office response filed.

Keywords: Opposition: earlier right with reputation – Opposition: likelihood of confusion (LOC) – LOC: comparison of goods – Comparison of goods: glassware and wine (similar?).

The case is an appeal from a judgment of the CFI of 12.6.2007 in T-105/05 relating to an opposition case between CTM application Waterford Stellenbosch (figurative mark), applied for (after restriction): alcoholic beverages, namely wines produced in the Stellenbosch district, South Africa (in Class 33), and the invoked earlier CTM Waterford, word mark, registered for, inter alia, articles of glassware, earthenware, chinaware and porcelain in Class 21.



The opposition had been rejected by the Opposition Division but had subsequently been allowed by the 1st Board by its decision of 15.12.2005 on the grounds that there is similarity between glassware (wine glasses) and wine. On appeal, the CFI had revoked the Board decision.

Focus/Micro Focus: C-344/07-P – Appeal from T-491/04; Office response filed (DE).

Keywords: Opposition: likelihood of confusion (LOC).

The case is an appeal from a decision of the CFI of 16.5.2007 in T-491/04. It had concerned an opposition case between Focus Magazin Verlag, Munich, which had applied for the word mark FOCUS for a wide range of goods and services; at





issue here are Classes 9, 16, 41 and 42.

It had been opposed on the basis of Micro Focus (figurative mark), registered in the said classes. The Opposition Division had allowed the opposition but the 2nd Board subsequently had rejected it on the grounds that there would be no LOC. The CFI, in the judgment at issue here, had revoked the Board decision.

B: European Court of Justice: Preliminary Rulings

B-1: ECJ Preliminary Rulings

None

B-2: ECJ Preliminary Rulings: Developments in pending cases

None

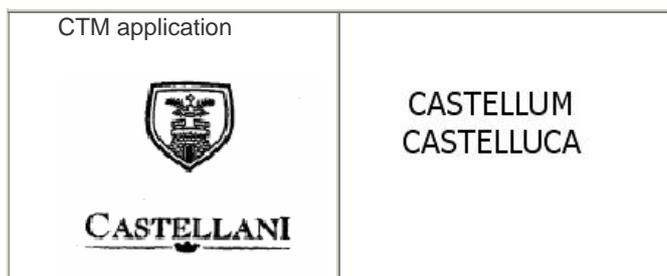
C:CFI Court of First Instance (CFI): Judgments and Orders on appeals against decisions of OHIM, Article 63 CTMR

C-1: CFI Judgments and Orders

Castellani: T-149/06 – Judgment of 20 November 2007 (action allowed; law of the case).

Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of marks – LOC: relevant public – Relevant German public: perception of an Italian name.

The action had been directed against a decision of the 1st Board of 22.2.2006 in R 0449/2005-1 relating to CTM application CASTELLANI (figurative mark), applied for for alcoholic beverages except for beer, liqueur, sparkling wine and champagne in Class 33. It had been opposed on the basis of earlier rights in the words Castellum and Castelluca, registered also in Class 33. Proof of use had been submitted for Castellum. However, the Opposition Division had not taken it into account but had rejected the opposition on the grounds that in any event the relevant German public would not confuse the brands at issue as to their origin.



In contrast, the Board did not consider Castellum because of insufficient proof of use. It held, however, that there was a risk of confusion on the grounds of identity of goods and relevant visual and phonetic similarity between Castellani and Castelluca. The 1st Chamber of the CFI (Cooke; Labucka; Prek) did not agree but followed, in essence, the line of thought of the Opposition Division.

(Findings of the Court)

(52) In the present case, as regards the visual comparison, the trade mark applied for is a compound mark, composed of a word element, 'castellani', and a figurative element, consisting of two horizontal lines with a turreted crown in the middle and a shield with a castle with two towers, surmounted by a crown with two palm branches and a Latin cross in the centre.

(53) With regard to the significance to be attached to the figurative element as a distinguishing feature, that cannot be the dominant element in the overall impression created by the trade mark applied for. In the present case, it is clear, as was stated by the Board of Appeal at point 19 of the contested decision, that the figurative elements of the mark in question will be perceived as an illustration of a castle and that those elements have but a weak distinctive character. In the case of a product like wine, a representation of a castle is not an element that allows the relevant public to perceive that figurative component as dominating the image they retain of the trade mark applied for. On the contrary, consumers usually describe and recognise wine by reference to the verbal element which identifies it, since this element designates in particular the grower or the estate on which the wine is produced (Case T-40/03 Murúa Entrena v OHIM – Bodegas Murúa (Julián Murúa Entrena) [2005] ECR II-2831, paragraph 56). Therefore, the dominant element of the contested trade mark is its verbal element, namely the word 'castellani'.

(54) The Board of Appeal also stated, at point 19 of the contested decision, that the first part of the signs, which in its view was visually the most prominent, namely 'castell', was identical. It is true that the word elements 'castellani' and 'castelluca' have a certain degree of visual similarity, since they are of the same length and the first seven letters are identical and placed in the same order ('c-a-s-t-e-l-l'). However, although the consumer's attention is often caught by the first part of words (MUNDICOR, paragraph 81), the applicant rightly points out that the use of the word 'castle' is very common for that particular category of goods. The consumer is presented with such a variety of names and goods containing a territorial designation associated with the words 'castello', 'castel', 'château', 'Schloss' or 'castle' that, in order to be able correctly to identify a wine whose name begins with one of those words, the consumer must examine the suffix attached to it very carefully. In the present case, the final letters of the conflicting signs, that is, 'a', 'n' and 'i' in the contested trade mark and 'u', 'c' and 'a' in the earlier mark, are different.

(55) Accordingly, in the overall visual assessment of the signs, the difference established between the word elements 'castellani' and 'castelluca' is sufficient to rule out any visual similarity between the competing signs.



(56) As regards the phonetic comparison, contrary to the Board of Appeal's finding at point 20 of the contested decision, the dissimilarities between the signs, due to the difference between the suffixes – 'ani' in the trade mark applied for and 'uca' in the earlier mark – are sufficient for them to be distinguished aurally in German, in spite of the fact that the prefixes ('castell') are the same. If the relevant public pronounces the suffixes in question in German, the element 'ani' will be pronounced [ani] and the element 'uca' pronounced [uka].

(57) As regards the conceptual comparison, the Court considers to be incorrect the Board of Appeal's finding, set out at point 21 of the contested decision, that the average German consumer is likely to associate the two marks in the same way with the word 'Kastell', which means castle in German, so that the competing signs are conceptually similar.

(58) In that regard, it should be noted, first, that the use of a word meaning 'castle' is common in the wine sector. Germany is the fourth biggest world market in terms of wine consumption. Although a large share of that market is covered by German wines, the predominant share consists of imports. Germany's main suppliers of wine are Italy, France and Spain. Consequently, the German consumer is accustomed to seeing a large number of trade marks for wine whose name begins with 'Schloss', 'castello', 'château', 'castel' or 'castle' when purchasing wine in a specialist shop, a supermarket or a hypermarket or when choosing a wine from a wine list in a restaurant. He will therefore attach less significance to the prefix and closely examine the suffix of the mark on the bottle label.

(59) Secondly, the trade mark applied for contains an Italian family name, which will be recognised as such by the target public. Since Italian food and wine and Italian goods are widely available throughout Germany, the average German consumer is accustomed to identifying an Italian name and associating it with a family. It is highly unlikely that the average German consumer will associate the trade mark applied for with the German word 'Kastellan'. The earlier mark suggests the Castle of Luca or is associated with the town of Lucca, the capital of the province of Lucca in Tuscany, Italy. It follows that there is a conceptual difference between the two signs.

(60) Thus, contrary to the finding in the contested decision, when making an overall assessment of the marks at issue, the visual, phonetic and conceptual differences between the conflicting signs are sufficient, in spite of the identical nature of the goods covered, to preclude the resemblances between them giving rise to a likelihood of confusion on the part of the average German consumer.

(61) It follows from all of the foregoing that the single plea raised by the applicant must be upheld and that the contested decision must therefore be annulled.

TEK: T-458/05 – Judgment of 20 November 2007 (dismissed; Office practice confirmed).

Keywords: CFI proceedings: subject matter – CFI procedural aspects: restriction of the list of goods after a decision had been taken – Procedural aspects: right of defense – OHIM proceedings: restriction of the list of goods and services at cancellation proceedings – Absolute grounds for refusal: distinctiveness – Absolute grounds for refusal: deceptive signs.

The action had been directed against a decision of the 2nd Board of 21.10.2005 in R 1063/2004-2 (decision rectified on 16.11.2005), a cancellation case based on Articles 51(1)(a); 7(1)(b),(c) and (g) CTMR. The proprietor of the challenged CTM TEK, registered for a range of goods in Classes 6 and 20, had restricted the list of goods in Class 20 pending invalidation proceedings. After restriction, the goods in Class 20 covered by the mark TEK had been the following: shelves and parts of shelves, in particular hanging baskets for shelves, all the aforesaid goods not of wood. Notwithstanding this, the 2nd Board had ordered the removal from the register of the mark, on the ground that the mark was descriptive for the purposes of Article 7(1)(c) CTMR and devoid of any distinctive character within the meaning of Article 7(1)(b) CTMR.

The Second Board essentially took the view, first, that, since the word 'tek' means teakwood in Italian and French, since it is undisputed that shelves and parts of shelves are made of teakwood and since it cannot be ruled out that shelves and parts of shelves of metal and of plastic could imitate teakwood, the word 'tek', used for shelves and parts of shelves of metal and not of wood, served 'to designate the appearance, the external aspect and, as the case may be, other qualitative aspects of teakwood'. Accordingly, it concluded that the mark TEK constituted a purely descriptive indication for the purposes of Article 7(1)(c) CTMR, which should remain available for competitors. Second, it took the view that since the word 'tek' is not capable of distinguishing the goods designated according to their origin, it was also necessary to exclude the mark from registration because it lacks distinctive character for the purposes of Article 7(1)(b) CTMR. On the other hand, it took the view that it was not required to consider whether the mark at issue was such as to mislead the public for the purposes of Article 7(1)(g) CTMR. On 29.12.2005, i. e. after the decision of the Board, the CTM proprietor and plaintiff in the action had stated, by letter to the Office, that it was restricting the list of goods covered by the mark TEK to the following (Class 6): Shelves and parts of shelves, in particular hanging baskets for shelves, all the aforesaid goods of metal and not of imitation wood; Class 20: Shelves and parts of shelves, in particular hanging baskets for shelves, all the aforesaid goods not of wood or imitation wood. The 5th Chamber of the CFI (Vilaras; Dehousse; Sváby) confirmed the Board's findings, leaving aside the subsequent restriction.

(a) Subject matter of the CFI proceedings

(15) The applicant submits that the restriction of its application for registration of 29 December 2005 in respect of goods in Classes 6 and 20 which are not of imitation wood must be taken into account by the Court in so far as that restriction is a new matter for the purposes of the second subparagraph of Article 48(2) of the Rules of Procedure of the Court of First Instance, which came to light only after the Second Board of Appeal had taken its decision. It follows, a contrario, from

Article 74(2) of Regulation No 40/94 in conjunction with Article 48(2) of the Rules of Procedure that, generally, new facts, evidence and arguments may be introduced in the context of invalidity proceedings (Case T-222/02 HERON Robotunits v OHIM (ROBOTUNITS) [2003] ECR II-4995, paragraph 50 et seq.).

(16) At the hearing, the applicant stated that that application to restrict the list of goods had been filed when the application initiating proceedings was lodged and that it had been registered by OHIM. It also claimed that Case C-363/99 Koninklijke KPN Nederland [2004] ECR I-1619 was not relevant in the present case, since negative restrictions are provided for in the classification established by the Nice Agreement.

(17) OHIM asserts that the applicant's statement of surrender concerning goods of imitation wood may not be taken into consideration since it brings about an unlawful alteration in the subject-matter of the proceedings under Article 135(4) of the Rules of Procedure (Case T-164/03 Ampafrance v OHIM – Johnson & Johnson (monBeBé) [2005] ECR II-1401, paragraph 21).

(18) OHIM also takes the view that the Cancellation Division was wrong to authorise the restriction of the list of goods of 3 February 2004, since that restriction of goods was unlawful in the light of the case-law (Koninklijke KPN Nederland, paragraphs 114 and 115). None the less, in OHIM's submission, even when that restriction is taken into account, the Board of Appeal correctly took the view that the relevant provisions on invalidity were applicable.

(Findings of the Court)

(19) Under Article 63(2) of Regulation No 40/94, the Court may annul or alter a decision of a Board of Appeal of OHIM only 'on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of [Regulation No 40/94] or of any rule of law relating to their application or misuse of power'. Article 74 of that regulation requires that that review of legality must be carried out in the light of the factual and legal context of the dispute as it was brought before the Board of Appeal (Case T-57/03 SPAG v OHIM – Dann and Backer (HOOLIGAN) [2005] ECR II-287, paragraph 17; Case T-320/03 Citicorp v OHIM (LIVE RICHLY) [2005] ECR II-3411, paragraph 16, and the order of 15 November 2006 in Case T-366/05 Anheuser-Busch v OHIM – Budejovický Budvar (BUDWEISER), not published in the ECR, paragraph 27).

(20) It follows that the Court may annul or alter a decision against which an action has been brought only if, at the time the decision was adopted, it was vitiated by one of those grounds for annulment or alteration. The Court may not, however, annul or alter that decision on grounds which come into existence subsequent to its adoption (Case C-416/04 P Sunrider v OHIM [2006] ECR I-4237, paragraph 55).

(21) Moreover, under Article 26(1)(c) of Regulation No 40/94 '[a]n application for a Community trade mark shall contain ... a list of the goods or services in respect of which the registration is requested'.

(22) Article 44(1) of Regulation No 40/94 states that '[t]he applicant may at any time withdraw his Community trade mark application or restrict the list of goods or services contained therein'.

(23) In the present case, it is undisputed that the applicant restricted the goods covered by its application for registration of a Community trade mark after the adoption of the contested decision. Accordingly, however OHIM deals with that application, the application cannot affect the legality of the contested decision, which is the only decision being challenged before the Court (see, to that effect, the order in BUDWEISER, paragraphs 40 to 48).

(24) Admittedly, in the case of a Community trade mark application covering a number of goods, the Court has interpreted a statement by the applicant for the trade mark made before the Court, and thus subsequent to the Board of Appeal's decision, to the effect that the applicant was withdrawing its trade mark application only in respect of some of the goods covered by the initial application, either as a statement that the contested decision is challenged only in so far as it refers to the remainder of the goods covered (see, to that effect, Case T-289/02 Telepharmacy Solutions v OHIM (TELEPHARMACY SOLUTIONS) [2004] ECR II-2851, paragraphs 13 and 14), or, if such a statement was made at an advanced stage of the proceedings before the Court, as a partial withdrawal of the action (see, to that effect, Case T-194/01 Unilever v OHIM (ovoid tablet) [2003] ECR II-383, paragraphs 13 to 17).

(25) However, if, by its restriction of the list of goods referred to in the Community trade mark application, the applicant for the trade mark is not seeking to withdraw from that list one or more goods, but to alter a characteristic, such as the intended purposes of all the goods on that list, it is possible that that alteration might have an effect on the examination of the Community trade mark carried out by the instances of OHIM during the administrative procedure. Accordingly, to allow that alteration at the stage of the action before the Court would amount to changing the subject-matter of the proceedings pending, which is prohibited by Article 135(4) of the Rules of Procedure. Such a restriction cannot therefore be taken into account by the Court in its examination of the substance of the action (see, to that effect, monBeBé, paragraphs 20 to 22).

(26) It is therefore necessary to establish whether the reference, in the application initiating proceedings, to the applicant's restriction on 29 December 2005 of the goods claimed in respect of the mark at issue may be interpreted as a statement by the applicant that it challenges the contested decision only in so far as it relates to the goods on the amended list.

(27) That is not the case. By that restriction, the applicant did not withdraw certain goods from the list of goods in respect of which registration of the mark in question is sought, but altered the characteristics of all the goods on that list, specifying that those goods must not be made 'of imitation wood'. As stated at paragraphs 11 and 25 above, such a restriction cannot be taken into account by the Court, since it would change the subject-matter of the proceedings.



(28) It must therefore be concluded that the goods to be taken into account in this action are those in the list of goods referred to in the applicant's initial trade mark application, as restricted on 3 February 2004 (see paragraphs 3 and 6 above).

(29) As regards the argument raised by OHIM that the Cancellation Division wrongly authorised the application for a restriction of the goods which are not of wood, of 3 February 2004, it must be pointed out that, even if that argument were admissible, that restriction of goods, as OHIM observes, did not have any effect on the Board of Appeal's analysis regarding the descriptive character and the lack of distinctiveness of the mark at issue. That argument must therefore be rejected as having no bearing at all on the outcome of these proceedings.

(b) Right to be heard, Article 73 CTMR

(32) The applicant submits that, throughout the administrative proceedings on invalidity, it was not able to express a view on whether the absolute ground for refusal of registration provided for in Article 7(1)(c) of Regulation No 40/94 was made out by the fact that the meaning 'teakwood' called to mind by the mark at issue could serve to describe goods made in imitations of that wood. Since there was no oral procedure, it submits that at no point did it have an opportunity to comment on the views expressed by the Board of Appeal, which appeared only in the Board's decision.

(33) In that regard, the applicant observes that the intervener pleaded before the Board of Appeal the absolute grounds for refusal based on Article 7(1)(b) and (c) of Regulation No 40/94 by submitting merely that the mark at issue could call to mind the words 'technology' or 'technical'. The applicant further states that the intervener relied exclusively on the ground for refusal based on Article 7(1)(g) of Regulation No 40/94 in submitting that the word mark TEK could mislead the relevant sections of the French- and Italian-speaking public by creating the impression that the applicant's goods could imitate teakwood.

(34) The applicant recalls that the right to be heard is infringed where the proprietor of the mark has not had an opportunity to express its views on the application of the absolute grounds for refusal which the Board of Appeal applied of its own motion (EUROCOOL, paragraph 21).

(35) It also observes that it was deprived of the possibility of expressing its views on the Board of Appeal's reasoning and in particular on the possibility of further restricting the list of goods in respect of which registration was sought.

(Findings of the Court)

(44) The general principle of protection of the right to defend oneself is enshrined in the law of Community trade marks by that provision (LIVE RICHLI, paragraph 21). According to that general principle of Community law, a person whose interests are appreciably affected by a decision taken by a public authority must be given the opportunity to make his point of view known (Case 17/74 Transocean Marine Paint v

Commission [1974] ECR 1063, paragraph 15, and LIVE RICHLI, paragraph 22).

(45) Furthermore, according to the case-law, although the right to be heard, as laid down by the second sentence of Article 73 of Regulation No 40/94, covers all the factual and legal factors and the evidence which forms the basis of the decision of the Board of Appeal, it does not apply to the final position which the administration intends to adopt (Case T-303/03 Lidl Stiftung v OHIM – REWE-Zentral (Salvita) [2005] ECR II-1917, paragraph 62, and judgment of 5 June 2006 in Case T-388/04 Kachakil Amar v OHIM (Longitudinal line ending with a triangle), not published in the ECR, paragraph 20). Accordingly, the Board of Appeal is not obliged to hear an applicant on a factual assessment which forms part of its final decision.

(58) Contrary to what the applicant claims, the circumstances of this case differ from those which gave rise to EUROCOOL. In that case, the Board of Appeal had applied of its own motion a new absolute ground for refusal without according the applicant for the mark the possibility to express its views on the application of that ground. In the present case, by contrast, the Board of Appeal considered each of the absolute grounds for refusal and in particular that based on Article 7(1)(c) of Regulation No 40/94, which had been examined by the Cancellation Division. The Board of Appeal based its reasoning on all the characteristics of the goods covering their quality as imitation wood, which are the criteria of analysis coming within the scope of Article 7(1)(c) of Regulation No 40/94.

(59) Furthermore, it is of little importance that that argument relating to imitations of wood was raised by the intervener in the context of an absolute ground other than that applied by the Board of Appeal. It is apparent from the case-law that assessment of the facts is a part of the decision-making act itself and the right to be heard does not extend to the final position which the administration intends to adopt. In those circumstances, the Board of Appeal was not obliged to hear the applicant in relation to the assessment of the facts on which it chose to base its decision (see, to that effect, Salvita, paragraph 62, and Longitudinal line ending with a triangle, paragraph 20).

ITT I.T.T.: T-231/07 – Case closed; Order of 5 November 2007 (Board decision stands; it contains information relating to formal requirements in proceedings before the OHIM).

Keywords: OHIM proceedings: formal requirements – Formal requirements: notice of opposition – Formal requirements: representation – Formal requirements: authorisation – Opposition: proof of use (POU) – POU: requirements ("organisation" of the evidence filed).

The action had been directed against a decision of the 1st Board of 25.4.2007 in R 0462/2005-1 which had found in favour of the CTM applicant concerned (sign applied for: I.T.T., in Classes 9 and 11) which had been opposed on the basis of "ITT" based on numerous national trade marks as well as signs and non-registered, well-known trade marks used in the course of trade in the Community. The opposition

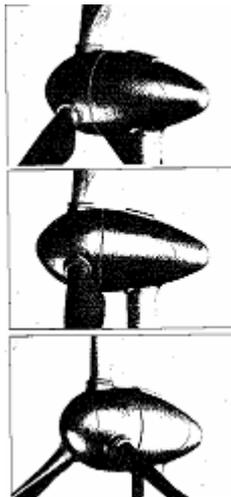
had been grounded on Articles 8(1)(a), (b), (4) and (5) CTMR. However, even though, inter alia, box 59 'Community trade mark' of the notice of opposition was ticked, and reference was made to some 'attachments 2.11.-2.51EN', no further indication of a number relating to a CTM could be found in the file in the 43 pages submitted with the opposition. Nor were there any pages marked as 'attachments 2.11.-2.51EN' but only an extract from some internal database entitled 'ITT registered marks in Europe', starting with Austria, reference number 4340AT102, and terminating with Italy, reference number 4340IT628.

In response, the CTM applicant had raised, inter alia, explicit doubts about whether 'Field Fisher Waterhouse' could have duly been authorised as an association of representatives to represent the opponent, a company having its seat outside the European Union. The opponent's representative filed on 20.10.2000 and on 25.1.2001 a general authorisation signed by a Mr. Johnson. The place of the signature was 'Secaucus, NJ, USA'. The document was not dated, nor did it contain any indication as to the position Mr. Johnson held in the opponent's company. Further, the CTM applicant raised the plea of non-use against all the opponent's earlier trade marks under Article 43(3) CTMR. The opponent then filed extensive material as POU and further documentation. In response, however, the CTM applicant rejected the documents supporting the opposition and the POU for inter alia the following reasons: the huge quantity of evidence was not sufficiently organized; the source and the authenticity of the documents often remained unclear; the evidence of registration or of proof was often not related to the opponent, but to other companies; trade marks on which the opposition had not been based (e.g. for the Community) cannot be taken into consideration; the validity of the trade marks, in particular the renewal, had not been proven for many trade marks, and the geographical scope of use could not be deduced from the documents. Notwithstanding this, the Opposition Division had then allowed the opposition. The 1st Board (Margellos; Kapff, rapporteur; Wennermark) had subsequently revoked the said decision. The opponent appealed but had later informed the Court that it did not wish to continue proceedings.

Windenergie-Konverter: T-71/06 – Judgment of 15 November 2007 (only in DE, FR; action dismissed; Office practice confirmed).

Keywords: Absolute grounds for refusal: distinctiveness – 3D signs: shape of the product itself or of a part of it – Distinctiveness: 3D signs/impact of relevant public (experts) – 3D signs/distinctiveness: impact of national design protection – Distinctiveness: acquired on the market, Article 7(3) CTMR.

The action had been directed against a decision of the 2nd Board of 30.11.2005 in R 0179/2005-2 relating to a 3D sign, a part of wind energy apparatus, applied for in Class 7. The product as such enjoys design protection at national level.

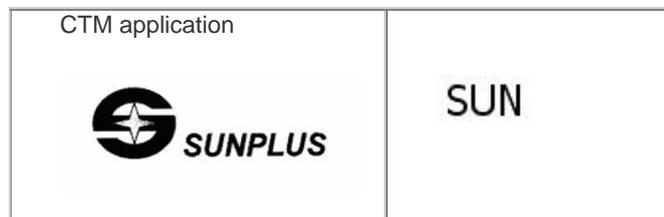


It had been rejected on the grounds that the shape of the product itself, if applied for as a trade mark, must be more creative in its design; i.e. it must comply with higher standards of distinctiveness than is required for non-3D signs. This is particularly so in the case where the target public consists of experts. The 5th Chamber of the CFI (Vilaras; Martin s Ribeiro; Jürimäe) agreed.

Sunplus: T-38/04 – Judgment of 15 November 2007 (dismissed; Office practice confirmed).

Keywords: Opposition: likelihood of confusion (LOC) – LOC: impact of identity of goods in relation to the comparison of marks.

The action had been directed against a decision of the 4th Board of 7.10.2003 in R 0642/2000-4 relating to CTM application SUNPLUS (figurative mark) which had been applied in Class 9 for: chips; semi-conductors; integrated circuits; electronic circuits; semi-conductor chips; semi-conductor elements; micro-processing chips; floating-point computing chips; super-large-scale integrated circuits; program cards; disks having computer program; magnetic disks.



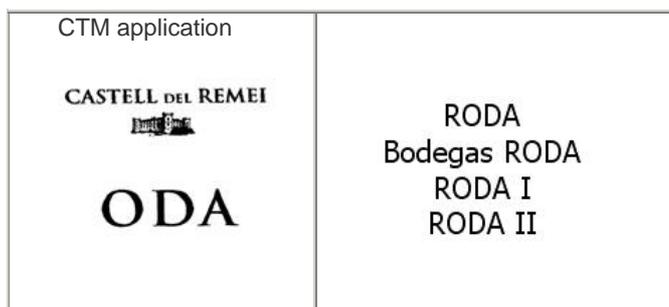
It had been opposed on the basis of various earlier rights in the word SUN (including a figurative mark containing SUN). The list of goods and services for which the invoked earlier rights are registered has not been set out in the judgment except for one, a Benelux mark, registered in Class 9 for: information and processing installations and apparatus, computers, personal computers, computer terminals, computer input and output devices, computer accessories, computer parts and computer memories, text processing

apparatus, computer software, magnetic and electronic data carriers, apparatus and instruments for recording and reproducing data. The opposition had been allowed in its entirety on the grounds that the identity of the goods would outweigh certain visual dissimilarities between the marks. The 5th Chamber of the CFI (Vilaras; Martins Ribeiro; Jürimäe) agreed.

Castell del Remei: T-101/06 – Judgment of 14 November 2007 (only in FR, ES; action dismissed; Office practice confirmed).

Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of marks.

The action had been directed against a decision of the 1st Board of 17.1.2006 in R 0263/2005-1 relating to CTM application “Castell del Remei/ODA” (figurative mark; as shown below), applied for in Classes 29, 30 and 33.

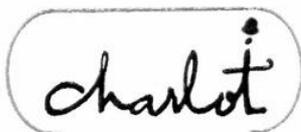


It had been opposed on the basis of various earlier rights, for wine, in the sign RODA and combinations thereof. The opposition had been allowed based on the earlier rights in RODA. The 4th Chamber of the CFI (Wisniewska-Bialecka; Vadapalas; Moavero Milanesi) agreed, relying on standard criteria as regards combination marks.

Charlott: T-169/06 – Judgment of 8 November 2007 (only in FR; action dismissed; Office practice confirmed).

Keywords: Opposition: proof of use (POU) – Opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 2nd Board of 24.4.2006 in R 0223/2005-2 relating to CTM application Charlott (figurative mark) which had been applied for for a range of goods in Class 25.



It had been opposed on the basis of “charlot” (figurative mark), registered for goods in Class 25. Whereas the Opposition Division had rejected the opposition on the grounds of non-genuine use, the Board had revoked that decision, had held that POU had been sufficiently shown, and had remitted the case back for the assessment of LOC. The 3rd Chamber of the CFI (Jaeger; Tiili; Tchipev) agreed, relying on standard criteria.

Manufacturing Score Card: T-459/05 – Judgment of 8 November 2007 (only in FR, DE; action dismissed; Office practice confirmed).

Keywords: Absolute grounds for refusal: distinctiveness.

The action had been directed against a decision of the 2nd Board of 19.10.2005 in R 1059/2004-2 relating to CTM application “manufacturing score card” (word mark), applied for in Classes 9 (hardware, software), 35 and 42 (inter alia, for consulting). The application had been rejected on the grounds that the sign would merely describe the intended purpose of the goods and services at issue. The 1st Chamber of the CFI (Cooke; Labucka, Prek) agreed, relying on standard criteria and standard case-law.

Topix: T-57/06 – Judgment of 7 November 2007 (only in FR; action dismissed; Office practice confirmed).

Keywords: Opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 2nd Board of 14.12.2005 in R 1147/2004-2 relating to CTM application Topix (figurative mark) applied for a range of goods in Class 3, for, inter alia, shoe cleaning preparations.



It had been opposed on the basis of several earlier rights in the word TOFIX, registered in Classes 3 and 4 for, inter alia, leather conservation preparations and for cleaning preparations. The opposition had been allowed in full. The 5th Chamber of the CFI (Vilaras; Martins Ribeiro; Jürimäe) confirmed the respective findings, relying on standard criteria.

Revian's/Evian: T-407/05 – Judgment of 6 November 2007 (action allowed; the judgment reinforces prior precedents)



stating that material filed for the first time at the appeal stage must in any event be weighed as regards relevance etc.).

Keywords: Opposition proceedings: evidence of earlier right – Evidence of earlier right: translation – Article 74(1) CTMR: scope of required examination.

The action had been directed against a decision of the 4th Board of 22.7.2005 in R 0082/2002-4 relating to opposition proceedings between SAEME, the manufacturer of Evian mineral waters, and the German beverages company A. Racke. The latter had applied for the figurative mark “REVIAN’S” (as shown below) for wine and sparkling wine in Class 33.

It had been opposed on the basis of several earlier rights in the word “evian” and in “evian plus a mountain motif” (not shown in the judgment). The invoked rights are registered in various Member States for mineral waters and for a range of other goods. The opponent, in addition, had claimed reputation in two EU Member States.

By its decision No 2754/2001 of 23.11.2001, the Opposition Division had rejected the opposition as unfounded in so far as it had been based on the French and international trade marks. It had refused to take into account the registration certificates produced, on the grounds of the late submission of the translation of those certificates into the language of the opposition proceedings, and had taken the view that the existence and legal validity of the two earlier trade marks had not been established. The opposition had also been rejected in so far as it had been based on the German trade mark, in particular because of the considerable disparity which, in the view of the Opposition Division, existed between the goods. Finally, the opposition had been rejected also in so far as it had been based on the well-known mark. The 4th Board had dismissed the respective appeal. It had approved the exclusion of the registration certificates for the French and international trade marks on the ground of the late submission of the translation of those certificates into the language of the opposition proceedings. It had gone on to find, as regards the likelihood of confusion with the German trade mark, that the Opposition Division had been right to conclude that no such likelihood existed, in view of the fact that there was sufficient difference between the goods concerned and between the opposing signs. The opponent had subsequently decided not to pursue further its opposition in relation to the French trade mark and the well-known trade mark. As a result, it had challenged the decision of the Board only on the basis of the international and the German trade marks.

Whereas the 1st Chamber of the CFI (Cooke; Labucka; Prek) did not put into doubt the relevance of time limits and the regular practice of the Office (standard letters setting deadlines for submitting evidence and additional remarks etc.), it stated that appeal decisions rejecting material as filed belatedly must be specifically reasoned (e.g. is the material relevant?; do specific circumstances exclude taking it into account?).

(Findings of the Court)

(46) It must be held that that standard letter complies with Article 42 of Regulation No 40/94 and with Rule 16(2) and (3) and Rule 17(2) of the implementing regulation inasmuch as those provisions provide that the facts, evidence and arguments to be presented in support of the opposition may be so presented within a period fixed by OHIM. Moreover, that letter is headed by a reference to Rule 19(1), Rule 16(3), Rule 17(2) and Rule 20(2) of the implementing regulation.

(47) However, the applicant [plaintiff in the action] failed to send the translation of the registration certificate for the international trade mark within the period specified by the Opposition Division in that letter. That translation was filed by the applicant only as an attachment to a letter of 22 November 2000, in response to the intervener's arguments specifically criticising the absence of the document in question, which were transmitted by the Opposition Division on 19 September 2000.

(48) The applicant claims, however, that the translation of that document was submitted before the Board of Appeal in due time, relying in that regard on Hi-FOCuS (paragraphs 37 and 38) in which the Court, on the basis of the continuity in terms of functions between the departments of OHIM, held that the translation of a registration certificate submitted when lodging an appeal before the Board of Appeal had not been out of time for the purposes of Article 74(2) of Regulation No 40/94, because it was submitted within the four-month time-limit for appeal laid down in Article 59 of Regulation No 40/94.

(49) Indeed, the established case-law shows that there is continuity, in terms of their functions, between the different departments of OHIM, namely the examiner, the Opposition Division, the Administration of Trade Marks and Legal Divisions and the Cancellation Divisions, on the one hand, and the Boards of Appeal, on the other (Case T-308/01 Henkel v OHIM – LHS (UK) (KLEENCARE) [2003] ECR II-3253, paragraph 25; Case T-323/03 La Baronia de Turis v OHIM – Baron Philippe de Rothschild (LA BARONNIE) [2006] ECR II-2085, paragraph 57; and Case T-252/04 Caviar Anzali v OHIM – Novomarket (Asetra) [2006] ECR II-2115, paragraph 30).

(50) It follows from that continuity in terms of functions between the departments of OHIM that, in the review of decisions taken by the departments of OHIM hearing the application at first instance that the Boards of Appeal must undertake, the Boards of Appeal are required to base their decision on all the matters of fact and of law which the parties concerned introduced either in the proceedings before the department which heard the application at first instance or in the appeal (KLEENCARE, paragraph 32; Case T-57/03 SPAG v OHIM – Dannand Backer (HOOLIGAN) [2005] ECR II-287, paragraph 18; Hi-FOCuS, paragraph 37; LA BARONNIE, paragraph 58; and Asetra, paragraph 31).

(51) Thus, the Boards of Appeal may, subject only to Article 74(2) of Regulation No 40/94, allow the appeal on the basis of new facts relied on by the party which has brought the appeal or on the basis of new evidence adduced by that party (KLEENCARE, paragraph 26, and Case T-16/02 Audi v OHIM (TDI) [2003] ECR II-5167, paragraph 81). The review



undertaken by the Boards of Appeal is not limited to the lawfulness of the contested decision, but, by virtue of the devolutive effect of the appeal proceedings, it requires a reappraisal of the dispute as a whole, since the Boards of Appeal must re-examine in full the initial application and take into account evidence produced in due time (LA BARONNIE, paragraph 59, and Asetra, paragraph 32).

Omega: T-90/05 – Judgment of 6 November 2007 (dismissed; Office practice confirmed).

Keywords: OHIM proceedings: impact of previous Board decisions – Opposition proceedings: impact of a delimitation agreement – Opposition proceedings: CTM applicant holding a national right predating opponent's mark – Opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 2nd Board of 10 December 2004 in R 0330/2002-2 relating to CTM application Omega (figurative mark) which had been applied for for a range of goods and services in Classes 3, 9, 14, 16, 25, 28, 35, 37, 38, 41 and 42.

<p>CTM application</p> 	<p>OMEGA</p>
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It had been opposed on the basis of several earlier rights in the word OMEGA, registered in, inter alia, Classes 9 and 42 which had been the scope of the opposition. The CTM applicant had stated that lodging the notice of opposition had been contrary to an agreement between the parties. The Board had not accepted that argument. It had stated, firstly, that it had to disregard the documents submitted by the applicant for the first time at the appeal stage. The Board had also considered that the effects of the agreement between the parties on the proceedings were not entirely clear. It had stated that, prima facie, it appeared that the applicant had acted in breach of the agreement by including in the application 'installation for checking, measuring time and distance, mainly for use in sporting, scientific and industrial fields'. In that regard, the Board had considered that 'time' and 'distance' were variable parameters and that it was not clear that the list of variable parameters cited in the agreement was exhaustive. The Board had finally stated that it was therefore doubtful whether the agreement could be relied on against the opponent. In addition, the CTM applicant had sought to rely on the fact that it owns several national earlier rights predating the invoked mark of the opponent, on the very territory where that mark is registered. This claim had also been rejected. Eventually, the opposition had been allowed. The 5th Chamber of the CFI (Vilaras; Dehousse; Sváby) agreed.

(a) CTM applicant owing a national right predating opponent's mark – Impact of previous

Board decisions

(Findings of the Court)

(45) In that regard, the Court notes that the mere fact that the applicant is already the proprietor of a national trade mark, assuming it to be identical to the Community trade mark applied for, cannot provide a basis for rejecting the opposition, even if the intervener's earlier mark was registered on a date later than that of the registration relied on by the applicant.

(46) It is evident from the case-law that the validity of a national trade mark, in this case the intervener's, may not be called in question in proceedings for registration of a Community trade mark, but only in cancellation proceedings brought in the Member State concerned. Moreover, although it is for OHIM to ascertain, on the basis of evidence which it is up to the opponent to produce, the existence of the national mark relied on in support of the opposition, it is not for it to rule on a conflict between that mark and another mark at national level, such a conflict falling within the competence of the national authorities (see Case T-269/02 PepsiCo v OHIM – Intersnack Knabber-Gebäck (RUFFLES) [2005] ECR II-1341, paragraph 26, and the case-law cited).

(47) The Court notes that, in the present case, the intervener's earlier United Kingdom trade mark was cancelled in respect of some of the goods concerned, that is to say 'period timers'. However, as OHIM rightly points out, that fact is irrelevant since the Board of Appeal found that the goods at issue were similar without taking account of period timers.

(48) In support of its argument relating to the relevance of the earlier registrations of which it is the proprietor, the applicant refers to the decision of the First Board of Appeal of OHIM of 12 September 2000 (Case R 415/1999-1) concerning opposition proceedings. In that regard, it should be observed that the legality of the decisions of Boards of Appeal must be assessed solely on the basis of Regulation No 40/94, as interpreted by the Community judicature, and not on the basis of a previous decision-making practice of those boards (Case T-106/00 Streamserve v OHIM (STREAMSERVE) [2002] ECR II-723, paragraph 66, and Case T-36/01 Glaverbel v OHIM (Surface of glass) [2002] ECR II-3887, paragraph 35). That reference is therefore irrelevant. In any event, it concerns a case completely different from the present case. In Case R 415/1999-1, the applicant for the Community trade mark, far from relying, as in the present case, on the mere existence of a right to an earlier national trade mark, had proved that right and its actual and peaceful coexistence with the opponent's trade mark in the national territory. It was, in particular, on that ground that the Board of Appeal found that there was no likelihood of confusion and rejected the opposition (see RUFFLES, paragraph 30). In the present case, however, the applicant has merely claimed that it was the proprietor of a number of registrations of its trade mark in respect of goods in Class 9.



(b) *Impact of a prior agreement between the parties*

(49) With regard, thirdly, to the agreement between the parties, it must be noted that by that agreement the applicant undertook, *inter alia*, not to seek registration of the trade mark OMEGA in respect of apparatus industrially or scientifically employed for measuring or controlling variable parameters such as temperature, pressure, force, load, vibration, electrical conductivity, liquid level, acidity, humidity, strain and flow. However, it is not apparent from the provisions of that agreement that the intervener undertook not to oppose registration of the trade mark OMEGA by the applicant. In any event, without its being necessary to consider the consequences of the agreement for the parties, the fact remains that the agreement is irrelevant to the assessment of the likelihood of confusion in the present case.

(50) In the light of the foregoing considerations, since it has been found that the goods and services at issue are similar and that there is a high degree of similarity between the trade marks, there is no reason to vary the finding of the Board of Appeal that there is a likelihood of confusion on the part of the United Kingdom and French public.

Vom Ursprung her vollkommen: T-28/06 – Judgment of 6 November 2007 (action dismissed; Office practice confirmed).

Keywords: Absolute grounds for refusal: distinctiveness – Distinctiveness: slogans – Distinctiveness: necessity to keep a sign free for the trade – Article 7(1)(c) CTMR: scope.

The action had been directed against a decision of the 2nd Board of 17.11.2005 in R 1179/2004-2 relating to CTM application “Vom Ursprung her vollkommen” (“perfect because of its origin”), applied for beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages; mixtures of these drinks falling within Class 32, and for alcoholic beverages (except beers) falling within Class 33. It had been rejected under Article 7(1)(c) CTMR, and the 1st Chamber of the CFI agreed (Cooke; Labucka; Prek).

(Findings of the Court)

(31) It must in addition be pointed out that the Court of Justice has ruled that the application of Article 3(1)(c) of First Council Directive 89/104/ EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), the wording of which is identical to that of Article 7(1)(c) of Regulation No 40/94, does not depend on there being a real, current or serious need for a sign or indication to remain free (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35; Case T-356/00 *DaimlerChrysler v OHIM (CARCARD)* [2002] ECR II-1963, paragraph 27). For the purpose of applying Article 7(1)(c) of Regulation No 40/94, it is necessary only to consider, on the basis of the relevant meaning of the word sign at issue, whether, from the viewpoint of the public addressed, there is a sufficiently direct and specific relationship between the sign and the goods or services in respect of which registration is sought (see Case T-311/02

Lissotschenko and Hentze v OHIM (LIMO) [2004] ECR II-2957, paragraph 30 and the case-law cited).

Caipi: T-405/04 – Judgment of 23 October 2007 (FR, DE only; action dismissed, Office practice confirmed).

Keywords: Absolute grounds for refusal: distinctiveness/descriptiveness.

The action had been directed against a decision of the 2nd Board of 6.8.2004 in R 0912/2002-2 relating to CTM application *Caipi* (word mark) which had been applied for for alcoholic beverages in Class 33. Seniority had been claimed for the identical German mark, registered on 3.5.1996. The application had been rejected on the grounds that *Caipi* is the common abbreviation for the well-known Brazilian drink *Caipirinha*, a cocktail. The 1st Chamber of the CFI (Cooke; Labucka; Prek) confirmed the rejection.

AMS Advanced Medical Services: T-425/03 – Judgment of 18 October 2007 (action dismissed; Office practice confirmed).

Keywords: CFI proceedings: admissible claims – CFI proceedings: impact of legal submissions made before the Board – Opposition: request for proof of use (POU): possible until what point in time? – Opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 4th Board of 12.9.2003 in R 0671/2002-4 relating to CTM application *AMS* (figurative mark)



The goods and services in respect of which registration had been sought are in Classes 5, 10 and 42, namely: Class 5: pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides; Class 10: surgical, medical, dental and veterinary apparatus and instruments; artificial limbs, eyes and teeth; orthopedic articles; suture materials; Class 42: accommodation and catering for guests; chemistry services; engineering services; hospitals, convalescent homes, sanatoriums; medical, hygienic and beauty care; medical research, bacteriology and chemical research; development of medicines, foodstuffs with pharmaceutical properties and other health care products, and conducting medical and clinical examinations, consultancy and support for others for these activities; scientific and industrial research, in particular



medical, bacteriological or chemical research; opticians' services; physics (research); interpretation; computer programming, in particular for medical purposes; providing of expert opinion; research (technical and legal) into industrial property matters; technical consultancy and providing of expertise; consultancy for health care professionals in the development, establishing and conducting of therapy programmes and the testing of the aforesaid therapy programmes by means of studies; animal breeding; translations; leasing of data-processing installations; leasing of vending machines; administration and exploitation of copyright; exploitation of industrial property rights; material testing; accommodation reservations.

The CTM application had been opposed on the basis of, inter alia, the word mark AMS, registered in several Member States in Class 10 for surgical, medical and veterinary apparatus and instruments; suture materials; medical devices for the control of urological disorders and impotence; prosthetic articles; penile prostheses; urinary prostheses; artificial sphincters; parts and fittings for all the aforesaid goods, all included in Class 10. The opposition had mainly been allowed. The plaintiff claimed, inter alia, revocation of the Board decision and, in the alternative, the remission of the case back to the Board. The 5th Chamber of the CFI (Vilaras; Martin s Ribeiro; Jürimäe) dismissed the action.

(a) CFI procedure: no claim as to remitting the case back to the Board

(Findings of the Court)

(14) By its third head of claim the applicant requests the Court to remit the case to the Board of Appeal for it to give a decision on its application for registration.

(15) In that regard, it should be recalled that, under Article 63(6) of Regulation No 40/94, OHIM is to take the measures necessary to comply with the judgment of the Community judicature. Accordingly, the Court is not entitled to issue directions to OHIM. It is for the latter to draw the consequences of the operative part of the judgment given by the Court and the grounds on which it is based. According to the case-law, that principle applies, in particular, where the head of claim concerns an application to remit the case to OHIM for it to give a decision on the application for registration (Case T-331/99 MitsubishiHiTec Paper Bielefeld v OHIM (Giroform) [2001] ECR II-433, paragraph 33; Case T-34/00 Eurocool Logistik v OHIM (EUROCOOL) [2002] ECR II-683, paragraphs 11 and 12; and Case T-216/02 Fieldturf v OHIM (LOOKS LIKE GRASS ... FEELS LIKE GRASS ... PLAYS LIKE GRASS) [2004] ECR II-1023, paragraph 15).

(16) The applicant's third head of claim is therefore inadmissible.

(b) Subject matter of a CFI appeal: impact of legal statements made before the Board

(18) OHIM points out that Article 135(4) of the Rules of Procedure of the Court of First Instance states that the

parties' pleadings may not change the subject-matter of the proceedings before the Board of Appeal, which is determined by the notice of appeal and the appellant's heads of claim.

(19) According to OHIM, it has not been definitively determined to what extent the respondent before the Board of Appeal may codetermine the subject-matter of the proceedings before that board by spontaneously challenging in its response findings made in the previous decision which have not been challenged by the appellant and, in particular, without having brought an appeal itself. Nor has it been definitively established whether the Board of Appeal must review the contested decision in its entirety or whether it can restrict itself to aspects of the decision which were explicitly referred to the reviewing body in the written statement setting out the grounds of appeal. OHIM refers, in that regard, to the contradictory findings set out in Case T-308/01 Henkel v OHIM – LHS (UK) (KLEENCARE) [2003] ECR II-3253, paragraph 29, and Joined Cases T-183/02 and T-184/02 El Corte Inglés v OHIM González Cabello and Iberia Líneas Aéreas de España (MUNDICOR) [2004] ECR II-965, paragraph 76.

(20) OHIM points out that findings made by the Opposition Division which were not contested by the defendant before the Board of Appeal cannot form part of the subject-matter of the proceedings for the first time before the Court.

(...)

(27) In any event, even assuming that the applicant did expressly acknowledge, in its statement of grounds of 13 February 2003, the similarity of the conflicting marks, it should be pointed out that according to settled case-law the purpose of actions before the Court under Article 63(2) of Regulation No 40/94 is to obtain a review of the legality of decisions of the Boards of Appeal (see Case T-247/01 eCopy v OHIM (ECOPY) [2002] ECR II-5301, paragraph 46, and Case T-311/01 Éditions Albert René v OHIM – Trucco (Starix) [2003] ECR II-4625, paragraph 70). In the context of Regulation No 40/94, under Article 74 thereof, the review must be carried out in the light of the factual and legal context of the dispute as it was brought before the Board of Appeal (Case T-194/01 Unilever v OHIM (ovoid tablet) [2003] ECR II-383, paragraph 16, and Case T-57/03 SPAG v OHIM – Dann and Backer (HOOLIGAN) [2005] ECR II-287, paragraph 17). In addition, under Article 135(4) of the Rules of Procedure, the parties' pleadings may not change the subject-matter of the proceedings before the Board.

(28) It is clear, in that regard, that, where it is based on Article 8(1)(b) of Regulation No 40/94, opposition to the registration of a Community trade mark requires OHIM to adjudicate on whether the goods and services covered by the conflicting marks are identical or similar and whether those marks are similar or not (see, to that effect, HOOLIGAN, paragraph 27 above, paragraphs 24 and 25).

(29) Consequently, the fact that the applicant did not dispute, before the Board of Appeal, the similarity of the conflicting marks cannot in any way divest OHIM of the power to adjudicate on whether those marks were similar or identical. Likewise, therefore, that fact cannot deprive the applicant of the right to challenge, in the factual and legal context of the

dispute before the Board of Appeal, the findings of that body on this point (see, to that effect, HOOLIGAN, paragraph 27 above, paragraphs 24 and 25).

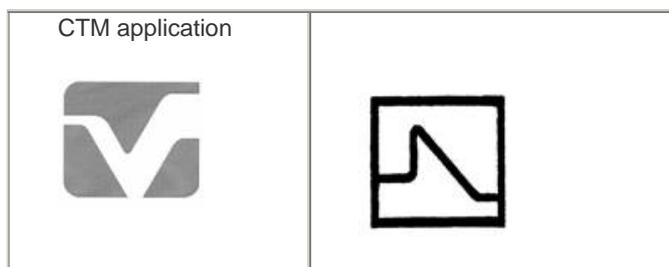
(30) It must be stated that the applicant's claims before the Court relating to the similarity of the conflicting marks do not depart from the context of the dispute brought before the Board of Appeal, which adjudicated, in particular, on the question of the similarity of the conflicting marks. The applicant merely questions that body's findings and its reasoning on this point. It follows that the applicant has not changed the subject-matter of the proceedings with those claims, which are therefore admissible before the Court.

C-2: CFI Judgments and Orders: Developments in pending cases

Letter V: T-229/07 – Office response filed (ES).

Keywords: Opposition: likelihood of confusion (LOC).

The action is directed against a decision of the 1st Board of 7.11.2006 in R 1363/2005-1 relating to CTM application 2 669 513, letter V (figurative mark). It had been applied for in Classes 1, 7, 8, 9, 11, 12, 16, 17, 19, 20, 21, 22, 27, 30, 35, 39, 40, 41, 42 and 43.



It had been opposed on the basis of a CTM which consists of a stylised V in a quadrangle and which is registered in Class 9. The opposition had been allowed against all claimed goods in Class 9.

Metronia/Metro: T-290/07 – Office response filed.

Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of marks.

The action is directed against a decision of the 2nd Board of 29.5.2007 in R 1315/2006-2 relating to CTM application 3 387 834, Metronia (figurative mark; shown below).



It had been applied for for the following goods and services (after restriction): Class 9: computer applications and identification systems for general use or which can be used directly or indirectly in any kind of game, whether for simple entertainment, betting or gaming, sound and video apparatus, computer programs, scientific apparatus and instruments, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, data processing equipment and computers; Class 20: amusement arcade furniture; Class 28: games, automatic and coin-operated games machines, automatic games not coin-operated and other than those adapted for use with television receivers only, electronic games other than those adapted for use with television receivers only, counters for games; Class 41: providing amusement arcade facilities, games provided on-line (from a computer network), gaming.

Metro Group Intellectual Property GmbH & Co. KG had filed an opposition in respect of all the goods and services covered by the CTM application, in accordance with Article 8(1)(b) CTMR, based on the earlier figurative mark shown above, registered in Class 9: data processing apparatus and computers, machine-readable data carriers with programs recorded thereon, data processing programs; Class 20: furniture; Class 28: games, in particular electrical and electronic games, and Class 41: public entertainment. Whereas the Opposition Division had allowed the opposition, the Board had rejected it on the grounds that the marks at issue are dissimilar.

PTR Professional Tennis Registry: T-168/07 – Office response filed.

Keywords: Opposition: likelihood of confusion (LOC).

The action is directed against a decision of the 1st Board of 28.2.2007 in R 1050/2005-1 relating to CTM application 2 826 709, PTR (figurative mark, shown below).



The CTM application had been filed in respect of the following goods and services in Classes 16, 25 and 41: Printed matter, instructional and teaching material, manuals, publications,



books, photographs, brochures, promotional material, stationery; clothing, footwear, headgear; education; providing of training; entertainment; sporting and cultural activities; teaching and training services relating to sporting and recreational activities; education and providing of training, all relating to tennis; organisation and management of sporting and recreational activities; organising and conducting conferences and seminars relating to sporting and recreational activities; providing tennis instruction; organising and conducting conferences and seminars for tennis teachers; organising and conducting tennis tournaments.

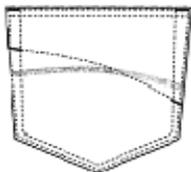
The Registro Profesional de Tenis, S.L. had filed a notice of opposition to the CTM application pursuant to Article 8 (1) (b) CTMR on the basis of several earlier rights, including a CTM, in the sign RpT (figurative mark, shown above) registered in respect of: ready-made clothing for women, men and children; footwear (except orthopedic), headgear, in Class 25, games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees, in Class 28 and educational services; training; entertainment; sporting and cultural activities, providing of training, in Class 41.

By its decision the Board had allowed the opposition for the goods and services in Classes 16 and 41 and had rejected it as to the remainder. The Board had held that there was an average degree of visual and phonetic similarity, as well as a conceptual identity, between the sign applied for and earlier Spanish trade mark registrations No 2 132 726 and No 2 132 727, which, in view of the interdependence principle, were sufficient to give rise to confusion on the part of the relevant public for the goods and services that were identical or similar.

Trouser Pocket-I or Gesäßtasche links: T-282/07 – Office response filed (DE).

Keywords: Absolute grounds for refusal: distinctiveness.

The action is directed against a decision of the 1st Board of 15.5.2007 in R 0669/2006-1 relating to CTM application 4 287 751.

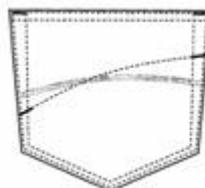


That application consists of the figurative representation of a rear trouser pocket (shown above). It had been applied for a range of products in Class 25. It had been rejected for textiles on the grounds that the sign will only be perceived as a decorative element and not as a badge of commercial origin.

Trouser Pocket-II or Gesäßtasche rechts: T-283/07 – Office response filed (DE).

Keywords: Absolute grounds for refusal: distinctiveness.

The action is directed against a decision of the 1st Board of 15.5.2007 in R 0668/2006-1 relating to CTM application 4 287 769.



That application consists of the figurative representation of a rear trouser pocket (shown above). It had been applied for a range of products in Class 25. It had been rejected for textiles on the grounds that the sign will only be perceived as a decorative element and not as a badge of commercial origin.

GlobalRemote: T-209/07 – Office response filed (DE).

Keywords: Absolute grounds for refusal: distinctiveness.

The action is directed against a decision of the 4th Board of 25.4.2007 in R 0272/2005-4 relating to cancellation proceedings initiated against CTM 1 466 499, GlobalRemote (see below).

GlobalRemote

The challenged CTM is registered for a range of goods and services in Classes 9, 38 and 42. The request for invalidation had been based on lack of distinctive character for the goods and services at issue. The cancellation request had been rejected on the grounds that the capital R in the middle of the word and the colours blue and red generate at least a minimum of distinctive character.

Budweiser/Budvar: T-191/07 – Office response filed.

Keywords: Opposition: likelihood of confusion (LOC).

The action is directed against a decision of the 2nd Board of 20.3.2007 in R 0299/2006-2 relating to CTM application 24 646, word BUDWEISER, which had been applied for by Anheuser Busch Inc. on 1.4.1996 for beers, ales, porter, malted alcoholic and non-alcoholic beverages in Class 32. After publication of the CTM application in June 1999,



Budejovický Budvar filed a notice of opposition against the registration of the Community trade mark application. The opposition had been based on the following earlier rights:

(1) International trade mark registration No R 238 203 of the word mark BUDWEISER with effect in Germany, Italy, Austria and the Benelux countries as from 5 December 1960 . The renewals of the international registration were published in the WIPO bulletin on 1 February 1981 and on 1 February 2001;

(2) International trade mark registration No 674 530 of the following figurative mark with effect in France, Italy, Austria and the Benelux countries as from 19 May 1997:



(3) International trade mark registration 614 536 of the following figurative mark with effect in France, Germany, Italy, Austria and the Benelux countries as from 11 March 1994:



(4) Appellations of origin No 49 (BUDWEISER BIER), No 51 (BUDWEISER BUDVAR), No 50 (BUDWEISER BIER – BUDVAR) and No 52 (BUDWEISER BIER) registered for 'beer' on 22 November 1967 under the Lisbon Agreement for the Protection of Appellations of Origin of 31 October 1958, with effect in France, Italy and Portugal;

(5) Appellations of origin 'Budejovické pivo', 'Budejovické pivo – Budvar' and 'Budejovický Budvar' protected in Austria under a bilateral agreement concluded between the Czechoslovak Socialist Republic and the Republic of Austria on 11 June 1976 . Appellations of origin 'Ceskobudejovické pivo' and 'Ceskobudejovický Budvar' are relied upon in Portugal where they are protected under a similar bilateral agreement.

The CTM applicant had requested proof of use. After the opponent had filed material, the Opposition Division had allowed the opposition in full. That decision had been annulled by the 2nd Board by decision of 11.7.2005 in R 0509/2004-2. The Board had found that the opposition division had wrongly upheld the opposition on the basis of international registration No 674 530 (i.e. earlier mark N° 2 here above) which had been registered on 19.5.1997 that is, later than the date of filing of the mark applied for. On 22.12.2005, the Opposition Division had issued a new decision whereby it upheld the opposition in its entirety but this time on the basis of the international trade mark registration No 614 536 (see earlier mark N° 3 here above).

The Opposition Division had considered that international trade mark registration No R 238 203 (see earlier mark N° 1 here above) had not been properly substantiated because the opponent had failed to submit the renewal certificate in due time. The subsequent appeal (against the second opposition decision) had been rejected.

Calvin Klein or CK Creacionnes Kenna: T- 185/07 – Office response filed (ES).

Keywords: Opposition: likelihood of confusion (LOC) – Earlier right: well-known mark in a Member State – Well-known mark: evidence – LOC: comparison of marks.

The action is directed against a decision of the 2nd Board of 29.3.2007 in R 0314/2006-2 relating to CTM application 3 386 604, "CK Creacionnes Kenna" (word mark), applied for in Classes 18 and 25 by Zafra Marroquinos S.L. of Murcia (Spain). It had been opposed on the basis of a range of earlier rights in the mark CK (fig; shown below) which are registered for a vast range of goods and services in, inter alia, Classes 18 and 25.



Opponent had relied on Article 8(1)(b) and 8(2)(c) CTMR. The opposition had been rejected. The Board had accepted as a "commonly known fact" that the invoked mark and also the denomination "CK Calvin Klein" are well-known in Spain within the invoked Article 8(2)(c) CTMR, notwithstanding that the practice of the Spanish office had not been coherent as regards the initials CK. The Board, however, had held that the marks at issue are dissimilar. The words "Creacionnes Kenna" in the subsequent sign are sufficient to explain the combination CK to which they are attached. In consequence, there would be no risk of confusion as regards the earlier mark CK Calvin Klein. The Board did not feel bound by a judgment of the Tribunal Superior de Justicia de las Islas Baleares which had held to the contrary, basing its decision on the consideration that CK as such would be a famous brand, commonly known on the relevant market (Spain).

Barbara Becker: T-212/07 – Office response filed.

Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of marks.

The action is directed against a decision of the 1st Board of 7.3.2007 in R 0502/2006-1, relating to CTM application 2 939 072, Barbara Becker, word mark, applied for for: scientific,

nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), lifesaving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data-carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers. It had been opposed on the basis of earlier Community trade marks BECKER and BECKER ONLINE PRO, registered for a range of goods in Class 9, for, inter alia, apparatus for recording, transmission or reproduction of sound and/or images. The opposition had been rejected.

The Board had held that there was a low degree of visual and aural similarity between the marks, and that there was a relevant degree of similarity between them only from a conceptual point of view, given that the element 'Becker' would be perceived as a surname. However, the surname 'Becker' could not be considered the dominant element of the CTM application, because the relevant public would see it in its entirety rather than a combination of 'Barbara' and 'Becker'. In making a global assessment of the marks, it had concluded that the differences were sufficiently significant to enable the marks to coexist on the market.

E-business at OHIM

OHIM's e-business roadmap

OHIM's commitment to extending e-business is taking another step forward with the drawing up of a staged programme of changes designed to make the Office's services faster, cheaper and more predictable for the customer.

Tools such as CTM-Online have been delivering electronic services to users since the late 1990s and the Office has had a coherent strategy to provide even more services via the Internet since 2002. Many of the projects integrating the first wave of e-business tools, such as e-filing, evolved during this period, and continue to be developed.

Now eight main groups of online activities with the goal of delivering improvements in the short, medium and long terms have been identified by a Future Working Methods steering committee, set up by OHIM earlier this year. The work programme, which extends over a three year period from 2008-10 has as its main goals to:

- Provide users with tools to enable them to evaluate in advance if their IP rights are registrable.
- Reduce to a minimum the information necessary to process applications, and provide electronic pre-checks to ensure forms are correctly filled in.
- Introduce electronic-only payment at the time of filing, with a simplified fee structure.
- Speed up the examination procedure, by providing examiners with more support from computer-based tools to help decision-making.
- Reduce the need for translation of applications.
- Speed up the publication of applications, accompanied by Online Access to Files and electronic certification.

- Speed up registration, by eliminating the delay between information being input and it being published.
- Deliver better electronic communication with the Office, and between parties in adversarial proceedings.

The combined effects of these goals, and around 30 separate actions, which are designed to deliver them, will be to give a better service to end users, reduce costs and increase productivity.

A "Laboratory" has been set up to develop prototypes in relation to some of these actions, in particular those dealing with leading edge technologies.

The director of OHIM's Quality Management Department, Juan Ramón Rubio Muñoz, says: "Most of the changes we are talking about are the natural extension of the previously announced e-business strategy. The Future Working Methods steering committee is simply helping to give greater coherence to our long-standing vision for a paperless office."

Next year will see improvements to some well-known tools: e-Communication will be expanded to include more official communications of OHIM; both CTM e-filing and RCD e-filing will be significantly improved; and MYPAGE will be extended to handle opposition proceedings electronically.

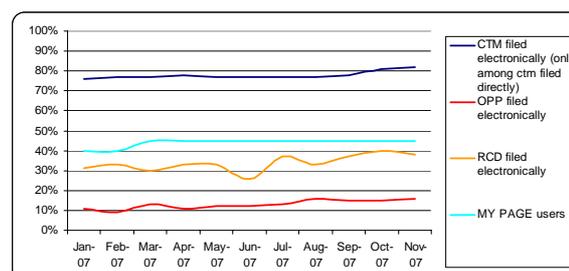
Some of the other benefits from the Future Working Methods programme will only be delivered further down the line. Overall, the goal is to reduce bureaucracy and develop more efficient working methods, with an emphasis on self-help tools which allow applicants to mimic the internal decision process in the office for individual applications, and predict the outcome in the majority of cases.

"OHIM is not unique in moving towards doing more business online, and arguably the pace of change elsewhere is even greater. We need to maintain our momentum, in an environment where demand for our services is increasing", says Rubio.

OHIM e-business roundup (2007)

Statistical summary

- The use of the CTM e-filing web form has increased above 80%.
- The use of RCD e-filing is around 40%
- 15% of oppositions against CTM applications are received electronically.
- MYPAGE users represent around 45% of CTM Applications filed.





State of play of future projects

Service - New version of e-Communication:

Electronic communication will be expanded to include more official communications of the OHIM.

Status - OHIM has started the testing phase

Service - New version of CTM E-filing:

The current [CTM e-filing](#) service will be significantly improved.

Status - Development phase is about to start.

Service - New version of electronic filing of RCD applications

The current [RCD e-filing](#) service will be significantly improved with a view to solving, inter alia, the problem of large attachments. RCD e-filing will also be accessible through MYPAGE and changes will be made to harmonize it with CTM e-filing.

Status - OHIM has completed the requirements.

CTM watch:

The objective is to provide an e-mail notification tool when specific CTM status changes.

Status - OHIM has started the development phase.

Service - Online handling of opposition procedures:

Opposition proceedings will be handled electronically via MYPAGE. It will be possible for the parties to exchange documents via this new tool.

Status - OHIM has completed the requirements.

More News

Design fees go electronic-only

From 1 January 2008 all design-related fees will have to be paid to OHIM by electronic means.

The move is in line with the Office's e-business strategy, which is designed to streamline both internal processes and OHIM's interaction with users. It also reflects the earlier change to electronic-only payment for Community Trade Marks, where OHIM stopped accepting cheques and cash in May 2007.

Users will benefit from faster processing of their payments, contributing to faster overall turnaround time, and from improved security, since the risk of a cheque being lost in the post or otherwise diverted is eliminated.

The use of cheques as a means of payment has declined significantly in recent years. Nevertheless, the small number of cheque payments that remains requires a disproportionate amount of processing work, which in turn also has an impact on the vast majority of users who already use bank transfers or current accounts.

Implementation of this policy change will be as follows: any cheques received after 1 January 2008, which are postmarked before that date will still be accepted. Any cheques postmarked after that date will be returned to the payer along with an explanatory note and instructions for paying by bank transfer and/or opening a current account.

Monthly statistical highlights November 2007

Community trade mark applications received	7.555
Community trade mark applications published	6.737
Community trade marks registered (certificates issued)	5.573
Community trade mark renewal applications	1.115
Registered Community designs received	3.038
Registered Community designs published	6.616

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