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## Keeping trade marks on track: OHIM's new "Manual of Trade Mark Practice"

OHIM is introducing a new and more flexible way of communicating changes in trade mark practice to users, via a regularly-updated Manual, which will complement the existing Guidelines.

At present, trade mark applicants must refer to a number of resources starting with the Guidelines, which are updated only intermittently, practice notes published on the website, and Communications from the President. In addition, some unpublished practice notes also exist for internal use.

From the end of this month, the new trade mark Manual, published on the "Trade Marks/Practical Aspects" section of the website, will incorporate the bulk of the existing Guidelines (more than 95% will be unchanged in the first version), the content of the current Draft Guidelines, and other changes reflecting current Office practice, which would previously have been published as practice notes or communicated in Alicante News.

For example, information on the streamlining of opposition procedures was published in Alicante News last September. The changes simplify the admissibility check process, and reduce the administrative burden of having to ask for repeated renewals of suspensions.

This information, which will be included in the Manual, is not yet reflected in the Guidelines, because the change took place while the Draft Guidelines were being translated in preparation for consultation of the Administrative Board.

The publication of the Manual will accelerate the gradual phasing out of practice notes, and will create a one-stop-shop containing the latest information drawn from the diverse sources currently used. The system for the updating of the Guidelines will remain unchanged. Formal amendments will be subject to the customary consultation and the revised draft will be translated into OHIM's five official languages and submitted to the Administrative Board for its opinion before adoption.

In future, the important changes in Office practice that take place in between the formal revision and adoption of the guidelines will be reflected in the Manual, updates to which will be communicated to users via the website. From a practical point of view, the Manual should be the first point of reference for users of the Community trade mark system and professional advisors who wish to make sure they are using the latest information.

Combining the previously available information in a single document will lead to a more efficient and transparent evolution of Office practice, and ensure that exactly the same guidance is made available internally to staff and externally to users.

## The James Nurton interview with Helmut Sonn, Sonn & Partner, Vienna, Austria

**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.**

This month James Nurton interviews Helmut Sonn, an Austrian patent and trade mark attorney, who discusses his experiences of the CTM system and also litigation in the European courts over issues to do with trade mark use.

### When did you become interested in trade mark law?

That is easy. My father was a patent attorney and was a specialist in trade mark law. In fact, he wrote a book in 1958 that was the leading publication for practitioners in Austria.

After the Second World War he had many meetings with clients at home and he explained things to me about get-up and packaging, and had examples. So I became interested at an early age. After finishing my studies, during my first five years of practice, I was constantly involved in trade mark and design matters, though designs were not so important then.

I have always liked trade marks. They are much nearer to the real commercial life of people whereas patents are more abstract and not so near to the market itself. Also, commercial life and activities constantly change with habits and behaviour so there are new challenges that are not in the law books. There are new and exciting questions, possibly more in trade marks than in other areas. I am interested in these down-to-earth commercial problems.

### How much of your work now is in trade marks?

At least 50% of my work involves legal questions including trade marks and designs. The other 50% is licensing and other business with granted patents and litigation. I also supervise all the trade mark and design work in our office, which involves about eight or nine people.

There is a lot of litigation now. In Austria, we [patent and trade mark attorneys] have to do some things together with a general lawyer, though we can testify and give legal opinions.



### Did the introduction of the Community trade mark make a big difference to your practice?

Yes of course. I'm a fan of the EU and I think in general it's a necessary thing to bring harmonization of the law and Community rights. Austria is a very old member of the Madrid system so we have long had national marks combined with Madrid marks.

Now we have the Madrid link with the CTM it is very beneficial and makes it cheaper and easier. We usually go for a national trade mark, then designate the CTM through Madrid. That is our preferred way. That way the application is not dependent on the fate of the CTM registration. Using a CTM is a much higher risk than using a national Austrian mark, not least because you could have an opposition from anywhere in the Community. In Austria, there is no opposition pre-grant, so 95% of cases are granted quickly. The CTM is also cheaper if you designate through Madrid.

### Do you think the CTM system works well?

In general, it is a good, sound system and a compromise between the different European traditions in trade mark law. I like the infringement system, where the basic idea is the free circulation of decisions, and infringement and validity are concentrated in some courts, which become specialized. The CTM is very successful and we use it extensively.

But some things could be better. The electronic system could be improved – we have experienced computer crashes or cases where the line hangs itself up, especially near the end of the month. Also, we don't always get certificates in good time and priority documents can take a long time even though everyone knows you need them urgently.

There are two important legal aspects that could be better. First, the appeal divisions want to be only a revision instance so you cannot file new matter. I can't understand that: of the four instances, two (the CFI and ECJ) are certainly only revision, so why do you need three? The first decision may show that you missed a point somewhere and it is then difficult to raise that on the appeal. So the boards of appeal should be more lenient in accepting new evidence.

The second aspect is, in general in two-sided proceedings, such as oppositions, it's normally the case that the defendant has the last word. From the beginning at OHIM, I always thought it was strange that the opponent, not the applicant, has the last word – particularly as the opponent has a second chance to file an invalidity action. But if you lose your trade mark, you don't get a second chance.

### What has been your experience of going to court over CTMs?

We had one case that went to the CFI, concerning similarity between the marks Shark and Hai. It didn't involve questions of oral or pictorial similarity but conceptual similarity. Hai means "shark" in many European languages, including German, and we thought it would be understood to a large extent in the Community. This was the only case where it was necessary to decide whether pure blatant conceptual similarity has to be judged. In my view the court did not take that into account and their reasoning was not satisfactory.

### You have also acted before the ECJ in cases regarding use of a trade mark.

One case was *Haupt v Lidl*, which concerned two issues. First, when does the five-year period in which you have to use your mark start? According to the law it is on the day when the registration procedure is finalized – which is a nightmare for Madrid marks. When is the registration procedure finalized? Countries have different solutions or none. But the court didn't say anything except that it was left to national laws. That didn't help us much.

The other question in this case was: what are the possible excuses if you do not use the mark for five years? With that the judges helped us a lot. We brought forward the commercial hindrances in our case. For our client, it was only viable to do business if there were sufficient stores and that was not possible at the time. The ECJ said you do not have to act contrary to normal business practices, and the national proceedings agreed. That was a positive effect, as it is a question that is often asked of trade mark practitioners: what would be a valid excuse if I do not use my mark for five years but only later?

### And now you are involved in another case about use?

I have filed my position paper to the ECJ in the *Wellness* case and we will soon find out if there will be an oral hearing. There is another referral from Austria in a similar case, which may be considered at the same time.

This is about the question of what is genuine use of a trade mark? How is that interpreted? In a previous case, *Ansul BV v Ajax*, the ECJ said you have to use the trade mark to establish or secure your market share on products for which the mark is registered. That's true for maybe 85% of trade marks, but there are hundreds of trade marks used on goods that are not given out to get market share for those particular goods.

In this case, the mark is registered for non-alcoholic drinks and water bottles were given out as gifts to people who bought pullovers. But the question arises where any merchandising articles, such as football club scarves or tee-shirts, are given out: the aim is to support the club by raising money not to sell more scarves or tee-shirts.

I think the ECJ has made a mistake on this question in its previous decision if you interpret the words literally. It may not need a 100% turn, but I hope they do change.

## Community Trade Mark

### CTM incorporating European emblem ruled invalid

OHIM's Cancellation Division has ruled that a Community trade mark, incorporating the European emblem of 12 stars on a blue background, is invalid, following an application by the European Commission.

The CTM, owned by Spanish proprietor Motorpress-Iberica, was registered in January 2006 for a range of goods and services relating to reports, studies or publications on cars, motorcycles and bicycles (Class 16 and Class 42).

The CTM, shown below alongside the European emblem, contains the words "MASTER-TEST INTERNATIONAL CAR MAGAZINES ASSOCIATION". The European Community, represented by the European Commission, argued that the European emblem was protected under the Paris Convention, and that the CTM Regulation prohibited the registration of protected emblems "either as trade marks or as elements of trademarks".



The Commission submitted that the owner of the "MASTER-TEST" CTM was not authorised to use the European emblem and that its inclusion rendered the mark descriptive of goods emanating from the European Union and also deceptive, if not used on goods emanating from the EU or guaranteed by the Commission or related bodies.

The proprietor of the "MASTER-TEST" CTM was notified of the Commission's request for a declaration of invalidity in May 2007, but did not file observations.

Ruling in favour of the European Commission, the Cancellation Division said in the light of the evidence before it, the CTM had been registered in breach of Article 7 (1) CTMR which prohibits the registration of trade marks which "have not been authorized by the competent authorities and are likely to be refused pursuant to Article 6ter of the Paris Convention".

Article 6ter (1)(a) of the Paris Convention prohibits the registration of signs that may only contain "elements" of protected emblems. Such elements need not be direct copies. The Cancellation Division said that the issue at stake could be clearly expressed as: "does the device or 12 gold stars set on a blue background ... include within it an 'imitation', from an heraldic point of view, of the 12 stars which form a part of the European Commission's protected emblem?"

The ruling concluded that the circle of 12 stars, regardless of their colour, on a blue background were discernable heraldic elements of the European emblem, and it followed that the representation within the proprietor's complex CTM constituted an imitation of this feature, regardless of the presence of any other material.

The Cancellation Division concluded that since the CTM contained an imitation of an heraldic element of the European emblem, it was likely that the public would assume that the proprietor's reports and studies on vehicles were connected with the EU. Consumers in this market were aware of the

importance of the credibility of companies providing surveys and reports on expensive and possibly dangerous goods like vehicles. Indeed consumers might be aware that the European Union itself was involved in this activity through its association with Euro NCAP, which provided motoring consumers with independent assessments of the safety and performance of cars sold on the European market.

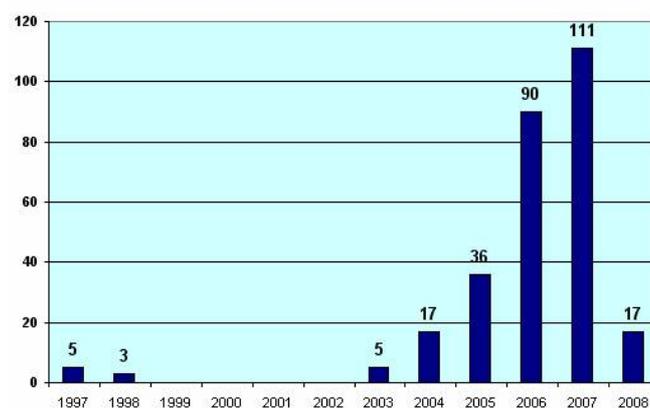
## Country overview: Slovakia & the Community Trade Mark



Slovakia joined the EU in 2004, and has a population of 5.4m. GDP growth is higher than the EU average at 3.1% higher in the final quarter of 2007 compared with the previous quarter. The service sector accounts for 64% of GDP, followed by industry (33%) and agriculture (3%).

The first few Slovakian CTMs were filed in 1997, but interest in CTMs remained low until EU membership. A total of 284 Slovakian CTMs have been registered and so far this year, there have been 17.

SLOVAKIA - CTM Filing Evolution  
(Total CTMs: 284)

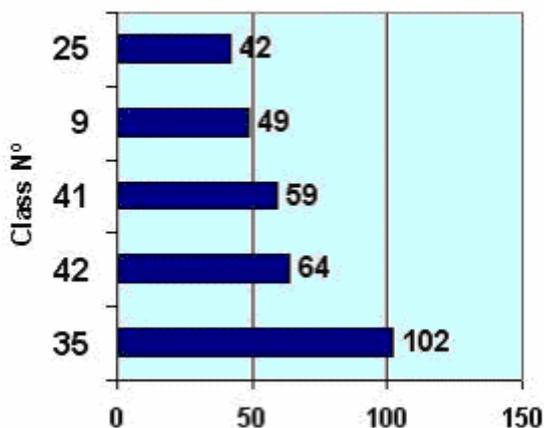


Word	Figurative	3-D	Colour	Other
47.18 %	51.76 %	0.7 %	0.00 %	0.35 %

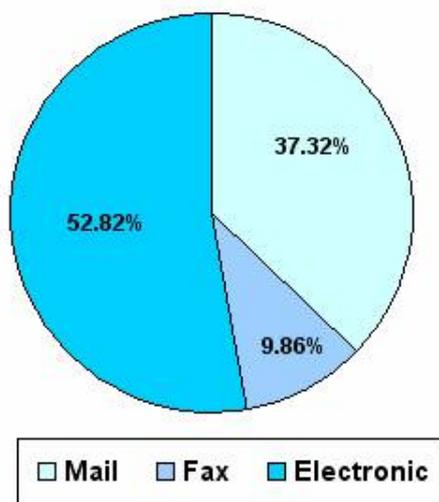
Figurative marks are the most popular with Slovakian enterprises and account for almost 52% of applications, followed by word-based marks (47%).

The most popular goods and services applied for by Slovakian businesses are in classes 35, 42 and 41.

**SLOVAKIA - Top Classes Filed (Nice)**



E-filing is the most popular route for Slovakian businesses and their intermediaries, but mail remains popular. This year, including International Registrations, 53% of all CTM filings were made electronically, 37% came by mail and almost 10% by fax.



**Top 10 Slovakia-based owners by number of CTMs filed**

Company	CTMs
GAS Familia, s.r.o.	8
DUSLO, A.S.	7
In Vino a.s.	7
OKLAMCAK PRODUCTION spol. s.r.o.	7
DREIM SK, s.r.o.	6
ESET Spol. s r.o.	6
M.O.C., s.r.o.	6
Compass Manufacturing Europe s.r.o.	5
EXIsport s.r.o.	5
IMUNA PHARM, a.s.	5

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

Representative	CTMs
BRICHTA & PARTNERS	18
LITVAKOVA A SPOL. PATENTOVA, ZNAMKOVA A ZNALECKA KANCELARIA	10
Bachrata	8
Belieka	8
HOLOUBKOVA Patent and Trademark Agency	8
UHRINA	7
IBeleseak	6
Benkóczy	6
Chmura	5
Mosa	5

## Community Design

### APPLE and L'OREAL enforce Community designs before Alicante courts

What do APPLE and L'OREAL have in common when it comes to protection of designs? Both companies are owners of Community designs and have successfully litigated during the second semester of 2007 to protect their rights before Alicante's Community designs courts ("Juzgado de lo mercantil número 1").

These cases show a trend of a pro-Community designs approach of the Alicante courts to grant interim measures of protection particularly in rather short time limits (the Apple case, for example, was filed on 11 July 2007 and an injunction was adopted on 25 July 2007).

#### APPLE vs Diario AS and others

APPLE requested the registration of the design of its MP3 reproducer iPod Nano on 19 December 2005 before OHIM. The design was granted and published in February 2006.



Apple's iPOD Defendant's player



The right holder argued that the Spanish sports newspaper "AS" was offering to its readers a MP3 reproducer which was substantially identical to the RCD. The player was imported from China into Spain by two local distributors. Readers, who bought the newspaper during June and July 2007, were offered the media player for free. APPLE requested interim measures in order to stop this distribution.

On 25 July 2007, Judge Fuentes Devesa adopted an injunction, which ordered the defendants to cease the distribution of the infringing goods. The judge found four common elements between both designs and only three differences. On this basis, there were sufficient elements to conclude, within the limited scope of interim measures proceedings that the external shape of the defendants' player did not determine a different overall impression compared to Apple's. The judge found that the Regulation did not require that there was identity between the protected design and the infringing good in order to conclude that there was an infringement. He found that the comparison must be made on the whole, not a simple comparison of elements.

Upon adoption of the interim measures by the court, the parties reached a settlement and no full judgment was adopted.

#### L'Oreal vs Yesensy España

L'OREAL sought a declaration of infringement and an order prohibiting the defendant from using its Registered Community Design ("RCD") 000077441-0001 for a "mascara" or eyelash curler, under Article 19 of the Community designs Regulation ("CDR"). The defendant being domiciled in Spain, the Community designs court in Alicante heard the case. L'OREAL also based its case on the infringement of its Community trade mark "DOUBLE EXTENSION".



L'OREAL design Defendant's product

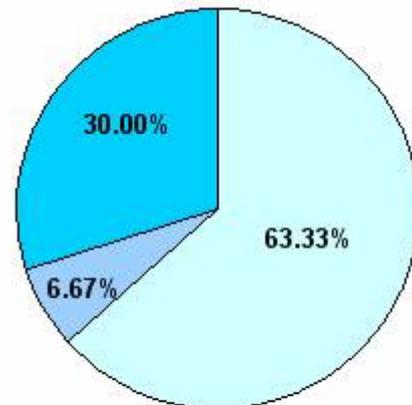
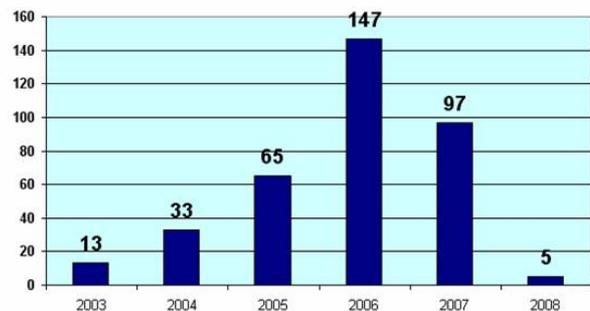
On 4 December 2007, Judge Fuentes Devesa adopted a judgment in full proceedings, according to which the defendant's eyelash curler constituted an infringement of the RCD, since due to the identical number of parts, distribution, configuration and shape of the curler, the overall impression determined by the infringing good was not different from L'OREAL's, bearing in mind that the degree of freedom of the designer was not particularly limited. The defendant was also found to have infringed the CTM and was ordered to withdraw the infringing goods and to pay €43 128 in damages to L'OREAL.

## Country overview: Slovakia & the Registered Community Design

The first few Slovakian filings of RCDs were made 2003 and to date there have been a total of just 360. Last year there were 97 filing, and there have been five so far this year.

The most popular classes for design owners are 8, 12, 6 and 20. Mail remains the most popular route for design filings, accounting for around 63% of the total, with Internet filing at around 30%.

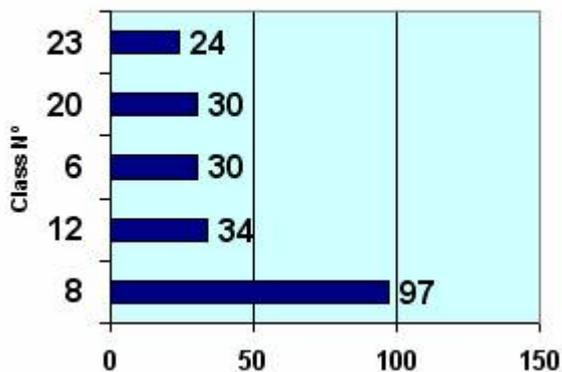
SLOVAKIA - RCD Filing Evolution



Mail Fax E-Filing



## SLOVAKIA - Top Classes Filed (Locarno)



## Top 10 Slovakia-based owners by number of RCDs filed

Owner	RCDs
Ďervenko	54
ZT Slovakia trading, a.s.	36
SEZ a.s.	20
Matador a.s.	17
XEDEX HOLDING, spol. s r.o.	16
Cramer SR s.r.o.	12
Biokamin s.r.o.	10
CMX Electronics, S.r.o.	10
Oprala	10
Kopiar	9

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

Representative	RCDs
Kastler	100
Belieka	30
PROTON Kancelaria pre patenty y znamky	25
Majlingova	20
GROSSE · BOCKHORNÍ · SCHUMACHER	12
Regina	12
Kubinyi	11
LITVAKOVA A SPOL. PATENTOVA, ZNAMKOVA A ZNALECKA KANCELARIA	11
Budz	10
Sujanova	10

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AirPlus : T-321/07

Kenitex : T-322/07

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Ecoblue : T-281/07

Patrick Exclusive : T-327/07

Buzz: T-302/07 PrimeCast: T-373/07

PrimeCast

## A: ECJ European Court of Justice (ECJ): Appeals from decisions of the Court of First Instance, Article 63 CTMR

## A-1: ECJ Judgments and Orders

**Metro/Metro:** C-493/06-P - Order of 11 December 2007 (appeal from T-191/04; case closed; CFI decision stands).

Keywords: Opposition formalities: validity of the earlier right – Validity of the earlier right: relevant point in time – Validity of the earlier right: renewal – Renewal: evidence at pending proceedings.

The action had been directed against the CFI Judgment of 13.9.2006 (Third Chamber) in Case T-191/04. The case had initially related to CTM application “METRO” (figurative mark), filed by MIP Metro, which had been opposed by Tesco Stores Ltd. on the basis of earlier rights in “Metro”, word mark, for goods not at issue in the action. The Opposition Division had rejected the notice of opposition and had allowed the registration of the mark applied for, on the grounds that Tesco had not proved, although duly invited to do so, that its earlier right had been renewed and was still in force after the date on which its term of protection expired pending proceedings. The 1st Board had upheld the opponent's appeal, considering that on the date on which the opposition had been filed and even on the date the evidence of validity had been requested, the earlier right had still been in force and that there was, accordingly, no need to prove renewal of the same upon its subsequent expiry. The CFI's Judgment of 13.9.2006 upheld the CTM applicant's appeal (which had been endorsed by the OHIM) and annulled the decision of the 1st Board. Tesco has



now withdrawn its further appeal to the ECJ and, in consequence, the case is closed.

## A-2: ECJ: Developments in pending cases

None

## B: European Court of Justice: Preliminary Rulings

### B-1: ECJ Preliminary Rulings

None

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

**Marca Mode-II or Adidas-III:** C-102/07: Opinion of the Advocate General of 16 January 2008 (NL, ES, DE, IT).

Keywords: European Trade Marks Directive 89/104/EEC: Article 3(1) – Absolute grounds for refusal: need to keep signs free – Distinctiveness: acquired on the market – Trade mark infringement: scope of protection (of the earlier trade mark) – Scope of protection: of a trade mark which had acquired distinctiveness on the market.

The case is a reference from the Hoge Raad of the Netherlands and can be summarised as “Three stripes (of Adidas) v Two Stripes”. Adidas BV, the exclusive licensee for the Benelux, had initiated actions against four retailing chains selling textiles with two stripes. There is a previous case, *Marca Mode-I*, ECJ Judgment of 22 June 2000, C-425/98 [2000] ECR I-4861. The core issue in the present case is the question whether the scope of protection of a trade mark which had acquired distinctiveness on the market would be less or more restricted as compared to an inherently distinctive trade mark, and whether there is, within this context, need to consider “a need to keep free (the category of signs at issue) for the trade”. Advocate General Ruiz Jarabo Colomer took the view that once a sign has acquired legal protection as a trade mark there is no room whatsoever for different treatment as regards assessment of its scope of protection, i.e. there is no basis for taking into account any “need to keep free (that type of sign) for the trade”.

## 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

**Marmara:** T-403/03 - Order of 7 January 2008 (DE; case closed; Board decision stands).

Keywords: Opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 1<sup>st</sup> Board of 1.10.2003 in R 0515/2002-1 relating to CTM application “Marmara” (figurative mark) which had been applied for for a range of goods in Classes 29, 30, 31, 32 and 33.



It had been opposed on the basis of “Marmarabirlik”, word mark, registered in Class 29. Whereas the Opposition Division had rejected the notice of opposition, the Board had allowed it. The opponent (the intervener in the present proceedings) informed the Court that it had withdrawn its opposition. In consequence, the case was closed.

**Safety 1st:** T-88/06 - Judgment of 24 January 2008 (action dismissed; Office practice confirmed).

Keywords: Absolute grounds for refusal: distinctiveness.

The action is directed against a decision of the 2<sup>nd</sup> Board of 11.1.2006 in R 0616/2004-2. Registration had been sought for the word mark “SAFETY 1 ST” in Classes 12, 20, 21 and 28, namely: bicycles, car seats, car beds, folding convertible car seats, car booster seats, child carriers, namely, strollers and carriages, in Class 12; furniture, namely, juvenile high chairs, folding play yards for children, cribs, bassinets, toddler and youth beds, booster seats, bed rails, head boards, mattress for cribs, juvenile dressing tables, cradles and rocking chairs, in Class 20; infant bath tubs, baby toilet trainers, in Class 21, and play and exercise equipment for children, namely, doorway jumpers, floor bouncers, floor exercisers, swings, and child walker/jumpers, in Class 28. It had been rejected on the grounds that it lacks distinctiveness for the goods applied for.

First, the Board had pointed out that the goods covered by the mark applied for are either explicitly aimed at children or, as in the case of bicycles, tend to be used by them. Therefore, the relevant public consists of the parents, family, or friends of children, in short, of average consumers. The Board had also decided to limit its examination to the English-speaking public. Secondly, the Board had observed that, contrary to the applicant's assertions, the relevant public did not need to make any intellectual effort in order to perceive ‘1st’ as a synonym for the English word ‘first’, especially in combination with the word ‘safety’. As that public is preoccupied with the safety of the users of the goods in question, it would immediately and unambiguously perceive the sign SAFETY 1ST as a laudatory expression informing the potential buyer of those goods that safety is a priority. Consequently, due to the impression produced by the mark as a whole, the connection between that mark and the relevant goods is not

sufficiently indirect to endow the mark with the minimum level of distinctiveness required. Moreover, the applicant had not claimed or submitted any evidence that the mark applied for had acquired distinctiveness through use in the relevant territory. The 5th Chamber of the CFI (Vilaras, rapporteur; Martin s Ribeiro; Jürimäe) confirmed these findings, relying on standard criteria.

**Bau How/Bauhaus:** T-106/06 – Judgment of 23 January 2008 (only in DE, FR; action dismissed, Office practice confirmed).

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

The action had been directed against the decision of the 4th Board of 31.1.2006 in R 0092/2004-4 relating to CTM application “BAU HOW” (figurative mark) which had been opposed on the basis of “BAUHAUS” (figurative mark). The goods and services are not at issue here.



The notice of opposition had been rejected on the grounds that the marks in question are visually clearly dissimilar; phonetically, they are dissimilar even on German-speaking markets, since the CTM application consists of a language mixture. Conceptually, BAU HOW was found not to have enough in common with BAUHAUS, the former German Academy for Construction and Design. The 4th Chamber of the CFI (Wisniewska-Bialecka; Vadapalas; Moavero Milanese) agreed with these findings.

**Idea/Ikea:** T-112/06 - Judgment of 16 January 2008 (action dismissed; Office practice confirmed).

Keywords: Invalidation/opposition: well-known marks within Article 6bis Paris Convention – Invalidation/opposition: marks with reputation – Invalidation/opposition: likelihood of confusion (LOC) – LOC: comparison of goods – Comparison of goods: ancillary goods and services – LOC: comparison of marks.

The action had been directed against a decision of the 1st Board of 10.2.2006 in R 0080/2005-1 relating to invalidation proceedings initiated against the CTM “idea” (figurative mark).



The goods and services for which registration of the contested mark had been obtained fall within Classes 16, 20 and 42, namely: Class 16: paper, cardboard and goods made from these materials; printed matter; photographs; stationery; artists' materials; typewriters and office requisites; instructional and teaching materials (except apparatus); plastic materials for packaging, playing cards; Class 20: furniture, including furniture of metal and/or plastic and/or glass; office furniture, in particular adapted for electronic data processing equipment; parts for furniture; goods of wood, cork, and/or reed, and/or cane, and/or ivory and/or plastics; Class 42: architectural and construction drafting and consultancy; architecture, computer programming; surveying; technical consultancy and providing of expertise; rental of data processing installations and technical furniture therefore; rental of vending machines, material testing.

The CTM had been contested on the basis of several earlier national rights and an earlier Community trade mark right in Ikea (figurative mark). The goods and services covered by the earlier rights fall within Classes 16, 20 and 42, respectively being: Class 16: paper and paper articles, cardboard and cardboard articles; stationery, adhesive materials; artists' materials, paint brushes; office requisites; playing cards; Class 20: furniture (also garden and office furniture); mirrors, picture frames; blinds; articles (not included in other Classes) of wood, cork, reeds, cane, wicker or plastic; Class 42: interior decoration services; computer services (rental and programming); architectural consultation and construction drafting; engineering services; management and exploitation of industrial property rights; (all the above related to purchase and sale of furniture, furnishings and articles for interior decoration, home and family); restaurant and catering services; lodging and boarding services.

In addition, the applicant for invalidation had submitted that there was a likelihood of confusion between the contested mark and another earlier word mark IKEA, well known within the meaning of Article 6bis of the Paris Convention as regards goods included within Classes 2, 6, 8, 9, 11, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30 and 31 and services included within Classes 35, 36, 37, 39, 41, 42 and 43. Further, the applicant had argued that the contested mark would take unfair advantage of the distinctive character or repute of the mark, within the meaning of Article 8(5) CTMR, or that it would be detrimental to it.

By its decision of 25 November 2004, the Cancellation Division had declared that the contested trade mark was invalid, pursuant to Article 52(1)(a) CTMR in conjunction with Article 8(1)(b) thereof, without stating any position in relation to the applicant's arguments concerning Article 8(5) CTMR. By the decision at issue in the action, the Board had upheld the appeal and had set aside the decision of the Cancellation Division. In essence, the Board had held that the contested



mark and the earlier marks were visually and conceptually dissimilar – in other words, by reference to two out of three possible bases for comparison – and that outweighed their aural similarity. The aural aspect would prevail only if aural perception were generally the means by which the public had contact with the goods and services concerned. In the present case, however, it was held that that is not the situation, because furniture is rarely ordered orally: consumers prefer to examine furniture visually before buying, since functional and aesthetic considerations play a decisive role in their choice. In addition, consumers tend to be observant, owing to the relatively high price of furniture and because of the aesthetic considerations. It follows, according to the Board, that the marks at issue are not similar and that there is no likelihood of confusion within the meaning of Article 8(1)(b) CTMR. According to the Board, that finding cannot be affected by the fact that the earlier marks have a reputation in Sweden. The 3rd Chamber of the CFI (Jaeger; Tiili; Czúcz) confirmed these findings.

*(a) Comparison of goods and services: ancillary goods and services*

“(28) First, it must be pointed out that the Board of Appeal restricted its examination to goods in Class 20, the contested decision stating only that the goods and services included within Classes 16 and 42 are ancillary to furniture. That statement is not disputed by either the applicant or the intervener, who moreover confine their observations before this Court exclusively to the goods falling within Class 20, including furniture.”

*(b) Visual comparison of marks*

“(54) As regards the visual comparison between the verbal element of the contested mark and the earlier word marks, the applicant claims that the only difference between them is the presence of the letter ‘d’ in the contested mark and the letter ‘k’ in the earlier word marks. However, the Court has already held in Case T-185/02 Ruiz-Picasso and Others v OHIM – DaimlerChrysler (PICARO) [2004] ECR II-1739, paragraph 54) that, in the case of word marks which are relatively short, even if two marks differ by no more than a single consonant, it cannot be found that there is a high degree of visual similarity between them.

(55) Accordingly, the degree of visual similarity of the earlier word marks and the verbal element of the contested mark must be described as low.

(56) According to the case-law, even in circumstances where two marks contain highly similar verbal elements – which is not the case here – that fact does not, by itself, support the inference that there is a visual similarity between the marks at issue. The presence, in one of the marks, of figurative elements set out in a specific and original way can have the effect that the overall impression conveyed by each mark is different (KINJI by SPA, paragraph 39 above, paragraph 48; see also, to that effect, Case T-156/01 Laboratorios RTB v OHIM – Giorgio Beverly Hills (GIORGIO AIRE) [2003] ECR II-2789, paragraph 74).

(57) In the present case, given, first, that there is only a low degree of visual similarity between the earlier word marks and

the verbal element of the contested mark, secondly, that the figurative element of the contested mark is individual and original and, thirdly, that the distinctiveness of the figurative component of the contested mark is at least as strong as that of the verbal element (with the consequence that the latter cannot be regarded as the dominant element), the conclusion of the Court is that the earlier word marks and the contested mark are visually dissimilar.

(58) Secondly, it is appropriate to examine whether there is a visual resemblance between the contested mark and the earlier figurative marks.

(59) It must be pointed out that the applicant does not challenge the assessment by the Board of Appeal that the figurative element of the contested mark and that of the earlier figurative marks are totally different.

(60) The Court considers that assessment to be well-founded, since, as was stated in paragraph 50 above, the figurative component of the contested mark consists of a grid with rounded corners – made up of 15 small squares, 14 white squares and 1 black square, presented diagonally, in the upper left corner – whereas the figurative component of the earlier figurative marks is a black frame, with a rectangular exterior contour and an ellipsoidal interior contour.

(61) It is appropriate to recall the conclusion, stated in paragraph 57 above, that the contested mark taken as a whole is visually dissimilar to the verbal element ‘ikea’ taken by itself. Given that the figurative components of the marks at issue are different, the effect of adding the figurative component of the earlier marks is to accentuate even further the existing visual difference between the contested mark and the verbal element ‘ikea’.

(62) In light of the foregoing, the Court concludes that the Board of Appeal rightly determined that the conflicting signs were visually dissimilar.”

**Amplitude:** T-9/05 - Judgment of 15 January 2008 (action dismissed; Office practice confirmed).

Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of marks – Comparison of word marks: impact of colour.

The action had been directed against a decision of the 1st Board of 3.11.2004 in R 0433/2004-1 relating to CTM application “Amplitude”, word mark, which had been applied for for a range of goods in Class 9, namely: eyeglasses; lenses for eyeglasses; frames for eyeglasses; sunglasses; contact lenses.

CTM application	
<b>Amplitude</b>	<b>A m p l y</b>



It had been opposed on the basis of “Amply” (turquoise-coloured figurative mark), registered in Spain in respect of goods in Class 9, namely: optical apparatus and instruments, in particular spectacles and sunglasses, sun lenses and ophthalmic lenses. Whereas the Opposition Division had rejected the opposition, the Board had allowed it. It had stated, inter alia, that the impact of the fact that the invoked earlier mark is in colour is marginal. The 3<sup>rd</sup> Chamber of the CFI (Jaeger; Azizi; Cremona ) confirmed these findings.

- *The consumers` level of attention*

“(28) According to settled case-law, the risk that the public might believe that the goods or services in question come from the same undertaking, or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion. According to the same line of case-law, the likelihood of confusion must be assessed globally, according to the perception which the relevant public has of the goods or services in question, taking into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the signs and that of the goods or services designated (see Case T-162/01 Laboratorios RTB v OHIM – Giorgio Beverly Hills (GIORGIO BEVERLY HILLS) [2003] ECR II-2821, paragraphs 30 to 33, and the case-law cited there).

(29) It should also be borne in mind that the consumer's level of attention is likely to vary according to the category of goods or services in question (judgment of 17 January 2006 in Case T-398/04 Henkel v OHIM (Red and white rectangular tablet with an oval blue centre), not published in the ECR; operative part published at [2006] ECR II-6, paragraph 28; see, by analogy, Lloyd Schuhfabrik Meyer, paragraph 22 above, at paragraph 26).”

(b) Comparison of marks

“(36) With regard to the visual comparison of the signs at issue, the Board of Appeal found, in the contested decision, that there was a clear similarity. It stated that the beginning of the two conflicting marks was practically identical and that the consumer's attention was particularly drawn to it. It considered that the differences stemming from the letters, the colour of the earlier mark and the length of the mark applied for (the additional ending ‘tude’), could not therefore diminish the overall visual similarity of the conflicting marks (see contested decision, paragraph 22).

(37) In that regard, the Court would point out, first, that the earlier mark is, with the exception of a single letter (‘y’ instead of ‘i’), included in its entirety in the mark applied for. Secondly, the part of the mark sought which corresponds to the earlier mark is at the beginning and that, as has been recognised by the case-law, particularly catches the consumer's attention (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 81), as the applicant admits.

(38) As regards the visual differences between the trade mark applied for and the earlier mark pointed out by the applicant, the Court finds, first, that the earlier mark primarily consists of a word element, ‘amply’, but that it also includes figurative

elements, in this case ordinary, turquoise-blue printed letters. By contrast, the mark applied for is a word mark consisting of the word ‘amplitude’.

(39) In that regard, as the Board of Appeal correctly found, the figurative elements of the earlier mark are marginal. The mere graphic representation of the earlier mark, consisting of printed characters, of a more or less commonplace and ordinary kind, even if they are turquoise-blue in colour, cannot draw the average consumer's attention to any figurative components other than the letters of which it consists (see, to that effect, Case T-186/02 BMI Bertollo v OHIM – Diesel (DIESELIT) [2004] ECR II-1887, paragraph 47).

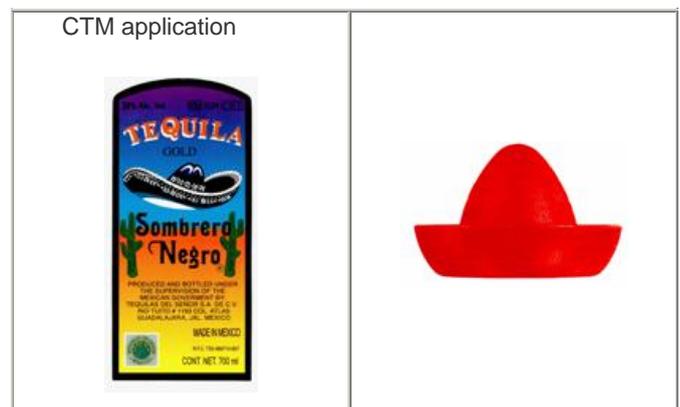
(40) The Court observes, secondly, that, apart from the difference between the letters ‘y’ and ‘i’ in the part which is common to both marks (see paragraph 37 above), the mark applied for can be distinguished from the earlier mark by the four additional letters forming the ending ‘tude’. Thus, the mark applied for, which is nine letters in length, is four letters longer than the earlier mark. The Court is of the opinion, however, that, contrary to the applicant's claims, the four additional letters of the mark applied for which form the ending ‘tude’ are, in relation to the beginning, which is practically identical to the earlier mark, only an insignificant suffix. The ending ‘tude’ is very closely related to the ending ‘tud’, which is extremely common in Spanish.

(41) Since the beginning of the element common to both marks plays a determinant role in the consumer's perception of the mark (see paragraph 37 above), the Board of Appeal was right to find that there was a visual similarity between the conflicting marks taken as a whole.”

**Sombrero Negro:** T-182/07 – Case closed; Order of 13 December 2007.

Keywords: Opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 1st Board of 7.3.2007 in R 1285/2005-1 relating to CTM application No. 2 722 122, “Tequila Sombrero Negro” (figurative mark), which had been applied for for the following goods in Class 33: alcoholic beverages, spirits and liquors, in particular tequila.





A notice of opposition had been filed against the above CTM application based on three earlier marks, "Red Sombrero" (figurative mark) registered in Class 33 for spirits and liquors, "Bottle with Sombrero" (figurative mark), registered for spirits of Mexican origin, including Tequila, and "Cactus Jack" for spirits and liquors. The opposition had been rejected on the grounds that there was no basis for assuming a risk of confusion. The plaintiff (opponent) informed the Court that it wished to discontinue proceedings.

**Teleselect:** T-202/06 – Case closed; Order of 13 December 2007.

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

The action had been directed against a decision of the 2nd Board of 18.5.2006 in R 0478/2005-2 by which it had revoked a decision of the Opposition Division which had found in favour of the opponent in a conflict between "Teleselect" and "Select". Manpower Inc. had sought to register the word mark TELESELECT for a range of services, namely: Class 35: assessment services in the field of telephone call handling, and Class 41: training services in the field of telephone call handling. It had been opposed on the basis of CTM No. 691 881, word mark "SELECT", which is registered for services in Class 35, namely employment agency services; employment consultancy services; employment counselling; information services relating to jobs and career opportunities; job advertising; personnel management services; personnel recruitment; information and advisory services relating to the aforesaid. Other earlier national and Community trade marks had been invoked which had not been listed for reasons of procedural economy. The Board had held that the conflicting services and marks are not relevantly similar for concluding LOC. The plaintiff informed the Court that it wished to discontinue proceedings.

**Estancia Piedra-II:** T-160/06 – Case closed; Order of 13 December 2007.

Keywords: Invalidation/opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 2nd Board of 28.3.2006 in R 0361/2005-2 by which it had confirmed invalidation of CTM No. 1 894 831, "Estancia Piedra" (figurative mark, same as below), registered for alcoholic beverages in Class 33. It had been challenged on the basis of CTM No. 961 391, "Estancia", word mark, registered for a range of goods in Classes 29, 30 and 33. The plaintiff informed the Court that it wished to discontinue proceedings on the grounds of an agreement reached out of court.

**Estancia Piedra-I:** T-159/06 – Case closed; Order of 13 December 2007.

Keywords: Invalidation/opposition: likelihood of confusion (LOC) – LOC: comparison of goods against services.

The action had been directed against a decision of the 2nd Board of 28.3.2006 in R 0363/2005-2 relating to (successful) invalidation proceedings initiated against CTM No. 2 127 868, "Estancia Piedra" (figurative mark), registered for information and consultancy services in relation to retailing via worldwide computer networks and import-export of wines (Class 35).



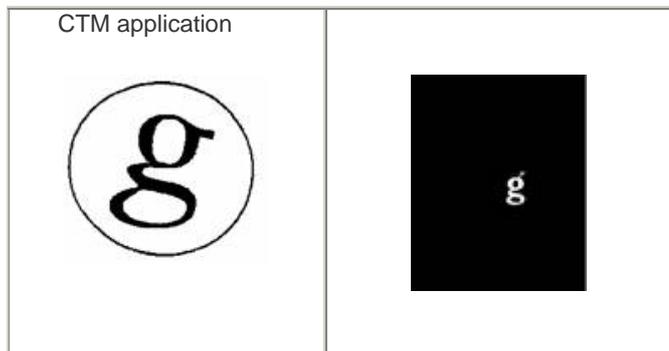
It had been challenged on the basis of the earlier CTM "Estancia", word mark, registered for: meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats, in Class 29; coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice, in Class 30, and for alcoholic beverages; wines, spirits and liqueurs, in Class 33. The request for invalidation had been successful. The plaintiff informed the Court that it wished to discontinue proceedings.

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

**Letter g or g/g:** T-310/07 - Office response filed.

Keywords: opposition/invalidation: likelihood of confusion (LOC).

The action is directed against a decision of the 2nd Board of 15.7.2007 in R 0878/2006-2 relating to CTM No. 1 153 741, stylised letter “g”, which is registered for the following goods: Class 9: phonograph records; audio and video tapes and cassettes; digital audio tapes; compact discs; video discs; Class 25: articles of clothing, and Class 41: entertainment and educational services.



It had been challenged by a request for invalidation on the basis of an earlier right in a mark consisting of a white letter g against a black background, registered for the following goods: Class 3: perfumery, essential oils, cosmetics, hair lotions, dentifrices, soaps; Class 18: leather and imitations of leather, and goods made of these materials, included in Class 18; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks, and Class 25: clothing, footwear, headgear. The request for cancellation had been dismissed, mainly on the following grounds: Given the nature of the goods and the fact that the earlier mark is a Community trade mark, the relevant public is the public at large in the Community; the earlier mark, which consists of a single stylised letter, has a limited degree of distinctiveness per se and thus a narrow scope of protection. The applicant for cancellation did not submit evidence that the earlier mark enjoys market recognition. The signs differ in their graphic presentation; given the limited scope of protection of the earlier mark, this is enough to exclude likelihood of confusion, all the more so because it is unlikely that a single letter would be pronounced by the purchasers when ordering clothing articles.

**Brilliant:** T-337/07 - Office response filed (DE).

Keywords: Absolute grounds for refusal: distinctiveness.

The action is directed against a decision of the 1st Board of 14.7.2007 in R 1186/2006-1 relating to CTM application No. 4 345 849, word mark “Brilliant”, applied for for a range of goods and services in Classes 9 and 42. It had been rejected under Article 7(1)(b),(c) CTMR on the grounds that the sign is a laudatory term for the claimed goods and services.

**Professional Tennis Registry:** T-168/07 - Reply of the Office to the intervener's remarks.

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

The action is directed against a decision of the 1st Board of 28.2.2007 in R 1050/2005-1 relating to CTM application No. 2 826 709, “PTR” (figurative mark).



The CTM application had been filed in respect of goods and services in Classes 16, 25 and 41. Class 16: printed matter, instructional and teaching material, manuals, publications, books, photographs, brochures, promotional material, stationery; Class 25: clothing, footwear, headgear, and in Class 41: 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.

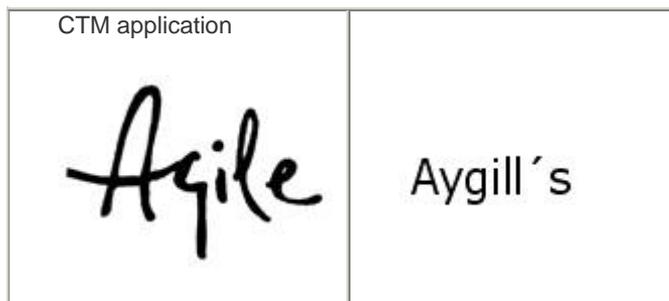
It had been opposed on the basis of several earlier rights, including a CTM, in “RPT” (figurative mark), which are registered in respect of: ready-made clothing for women, men and children; footwear (except orthopedic), headgear, in Class 25; games and playthings; gymnastic and sporting articles not included in other Classes; decorations for Christmas trees, in Class 28, and educational services; training; entertainment; sporting and cultural activities, in Class 41. Whereas the Opposition Division had rejected the notice of opposition, the Board had partially allowed it for the goods and services in Classes 16 and 41 and had rejected it as to the remainder. Contrary to the findings of the Opposition Division, the Board had held that there is 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 which, in view of the interdependence principle, were sufficient to give rise to a LOC on the part of the relevant public for the goods and services that are identical or similar.



**Agile:** T-386/07 - 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 26.7.2007 in R 1324/2006-2 relating to CTM application No. 2 659 456, “Agile” (figurative mark), applied for for the following goods: Class 18: bags, rucksacks; Class 25: sport footwear, shirts, vests, jackets, pullovers, socks, trousers, hats, berets, visors, and Class 28: golf bags, golfing gloves, golf clubs, games balls.



It had been opposed on the basis of an earlier CTM, “Aygill’s”, word mark, registered for a range of goods in Classes 3, 6, 8, 9, 11, 14, 16, 18, 20, 21, 24, 25, 26, 27 and 28 and national rights, registered for the same range of goods and in Class 25. Whereas the Opposition Division had allowed the opposition, the Board had rejected it on the grounds that the marks are dissimilar enough to exclude LOC.

The Board had essentially considered that despite the inherently distinctive character of the earlier mark and the identity of the conflicting goods, it could not be concluded that there is LOC solely on the basis of the aural similarities between the conflicting signs. That finding would only be reinforced in those language territories of the Community where at least one of the marks at issue has a clear and specific meaning so that the relevant public is capable of grasping it immediately, as is the case with the contested mark Agile, e.g., in the United Kingdom and France (c.f., Judgment in the Picasso case, of 12 January 2006, C-361/04-P, Claude Ruiz-Picasso and others / OHIM, [2006] ECR I-643, at paragraph 20). The Board had further stated that an examination of the phonetic and conceptual similarities in other Community languages would not alter this outcome. Regarding the phonetic aspects, in view of the evident visual dissimilarities and the greater role of the visual features over the aural ones, any potentially higher degree of phonetic similarity in other languages would not affect the final conclusion. From a conceptual point of view, the Board had considered that due to the fact that the earlier mark does not have any meaning in any of the Community languages, conceptual similarity could accordingly be ruled out throughout the Community.

**Tractor:** T-378/07 - Office response filed.

Keywords: Absolute grounds for refusal: distinctiveness – Distinctiveness: colours applied to a specific item – Distinctiveness acquired on the market: new Member States (as from 1 May 2004).

The action is directed against a decision of the 1st Board of 5.7.2007 in R 1642/2006-1 relating to CTM application No. 3 944 139, a device of a tractor featuring the colours red and black. It had been applied for in Class 12 for tractors.



The sign applied for had been described as follows: “ *The mark consists of the combination of the colours red, black and grey as applied to the exterior surfaces of a tractor, namely red as applied to the bonnet, roof and wheel arches, light and dark grey as applied to the bonnet in a horizontal stripe and black as applied to the front bonnet grill, chassis and vertical trim.*” It had been rejected on the grounds that the sign lacks distinctiveness for the goods at issue under Article 7(1)(b) CTMR. The claim that the sign had acquired distinctiveness on East European markets had been rejected for lack of significant quantity.

**Focus Radio:** T-357/07 - Office response filed.

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

The action is directed against a decision of the 4th Board of 30 7.2007 in R 0269/2005-4, relating to CTM application No. 2 340 289, word mark “FOCUS Radio”, which had been applied for for a range of goods and services in Classes 9, 16, 35, 38, 41 and 42, namely: Class 9: computers and data-processing apparatus; memories for data processing equipment; computer software, in particular for the scanning, displaying, processing and output of multimedia data on computer networks, including the Internet; machine-readable data carriers of all types containing information, and sound and image recording carriers, in particular floppy discs, CD-ROMs, DVDs, chip cards, magnetic cards, video cassettes, compact discs and video discs; collections of information recorded on data carriers; data banks - Class 16: printed matter, printed materials, periodicals, newspapers, books, bookbinding material, posters, stickers, calendars, signboards and models of paper, cardboard, photographs and photographic products; paper, cardboard, stationery and office requisites (except furniture), instructional and teaching material (except apparatus) - Class 35: database services, namely the collating (providing), storage, providing and updating of data and other information; e-commerce services, namely the arranging, concluding and handling of commercial transactions via online shops; advertising, including radio, print and Internet advertising; advertising agency services;

rental of advertising space on the Internet; marketing, for others, in particular on digital networks ("Webvertising"), market research and analysis; distributing goods for advertising purposes, sales promotion; public relations; arranging advertising events - Class 38: radio broadcasting; telecommunications; connecting computer systems to data networks, telephone installations and telephone networks; providing of information to others, broadcasting information via wireless or guided networks; online services, namely sending of messages and information of all kinds; e-mail data services (electronic mail); internet services, namely the providing of information on the Internet - Class 41: publication of printed matter, in particular newspapers, periodicals and books, and teaching and instructional material including stored sound and image information, also in electronic form; production of sound and image recordings on sound and image carriers; showing and rental of sound and image recordings; production of radio broadcasts, production of radio programmes; multimedia services, namely production of multimedia presentations; entertainment, among other radio entertainment; conducting entertainment events, live events, training events and cultural and sporting events - Class 42: computer programming and design of computer programs (computer software); maintenance and upgrading of computer programs, and on-line updating services; research and development in the field of data processing; design, development and consultancy in the field of computer hardware, consultancy in the field of computer hardware; network operator and provider services, namely the arranging and leasing access time to computer databases; creating, design and constructing of Internet presentations; planning, management, maintenance and care of Internet content; providing of documentation.

CTM application	
<b>FOCUS Radio</b>	<p>FOCUS MILENIUM PLANETA FOCUS</p> <p> PLANETA FOCUS 99</p>

That CTM application had been opposed on the basis of several earlier rights in "Focus Milenium" and "Planeta Focus" (word mark and figurative mark mark) which are registered for a range of goods and services in Classes 9, 16 and 41. Based on Focus Milenium, the CTM application had been rejected for part of the applied range of goods and services.

**Panorama** : T-339/07 - Office response filed (DE).

Keywords: Absolute grounds for refusal: descriptiveness.

The action is directed against a decision of the 1st Board of 28.6.2007 in R 0214/2006-1 relating to invalidation proceedings initiated against part of the list of goods and services covered by CTM No. 2 771 087, word mark "Panorama", registered *inter alia* for what may be summarised as aquarium equipment, a range of goods in Classes 11, 16 and 20. Whereas the Cancellation Division had rejected the

request, the Board had allowed it on the grounds that the term at issue describes a specific type of aquarium.

**Traxdata**: T-365/07 - Office response filed.

Keywords: Cancellation: application filed in bad faith – Invalidation/opposition: earlier rights within Article 8(4) CTMR.

The action is directed against a decision of the 1st Board of 23.5.2007 in joined cases R 1337/2005-1, R 1338/2005-1, R 1339/2005-1 and R 1340/2005-1 concerning Community trade mark registration Nos. 7 393, 877 779, 877 910, and 1 252 725 ("TRAXDATA" and "TEAM TRAXDATA"). On 1.4.1996, 9.7.1998 and 23.7.1999, respectively, the following CTM applications had been filed for various goods and services in Classes 9, 16, 36, 41 and 42:

TRAXDATA

**TRAXDATA**

**TEAM TRAXDATA**

**TRAXDATA**

The said applications had been filed in the name of Traxdata Limited (CTM No. 7 393), Edwards & Dent Holdings Limited (CTM Nos. 877 779 and 877 910) and Edwards Dent Partnership (CTM No. 1 252 725). The marks had subsequently been assigned to Ritrax Corporation Limited (actual registered owner and intervener in the proceedings pending) on 20.6.2001. On 14.3.2003 Traxdata France SARL had filed requests for a declaration of invalidity against the four CTM registrations. Two grounds for invalidity were relied on, namely: the actual CTM proprietor had been acting in bad faith and the applicant for cancellation holds earlier rights acquired on signs used in the course of trade in France, namely the corporate name ( *dénomination sociale* ) TRAXDATA FRANCE SARL and the trade name ( *nom commercial* ) TRAXDATA. The earlier rights used in the course of trade are claimed to be protected according to the French law in relation to services of consultancy, delivery and sale of computer consumables, hardware and accessories, and the French law confers on the applicant for cancellation the right to prohibit the use of subsequent trade marks.

The requests had been rejected, firstly, because of lack of substantiation as regards bad faith, and secondly, because Article 8(4) CTMR is not applicable (although for reasons that are different from those given by the Cancellation Division). Firstly, the requestor had failed to give evidence that the earlier signs continued to be used in the course of trade at the time the Office gave its decision. Secondly, Article L 711-4 of the French Intellectual Property Code protects corporate names and trade names against subsequent trade mark

provided there is a likelihood of confusion. The requests for a declaration of invalidity fail because such a likelihood of confusion does not exist from the view point of the relevant (professional) public. There is no likelihood of confusion because the earlier corporate name and trade name, on the one hand, and the later CTM registrations on the other hand, "point in fact to one and same business origin" that is, Traxdata Ltd.

**Homezone:** T-344/07 - Office response filed (DE).

Keywords: Absolute grounds for refusal: distinctiveness – Distinctiveness: through presence on the market, Article 7(3) CTMR (relevant point in time).

The action is directed against a decision of the 4th Board of 5.7.2007 in R 1583/2006-4 relating to CTM application No. 4 677 506, "Homezone", word mark, which had been partially rejected for a range of goods and services in Classes 9, 38 and 42, all mainly relating to telecommunications and mobile phone related issues. The CTM application had been filed in October 2005; pending proceedings the applicant had submitted a survey, dated September 2006, relating to an alleged acquired distinctiveness of the sign at issue. The rejection had been based mainly on the consideration that "home zone" is a standard term in the area of telecommunication and the mobile phone business for a sector within which other fees apply than outside the "home zone".

**Easyhotel:** T-316/07 - Office response filed (DE).

Keywords: Invalidation/Opposition: likelihood of confusion (LOC) – LOC: comparison of goods and services – LOC: comparison of marks.

The action is directed against a decision of the 2nd Board of 19.6.2007 in R 1295/2006-2 relating to CTM No. 1 866 706 "easyHotel" which had been challenged by way of a request for invalidation on relative grounds based on "EASYHOTEL". The challenged CTM is registered for a wide range of goods and services in Classes 16, 25, 32, 33, 35, 36, 39, 41 and 42. The earlier mark is registered in Classes 9, 38 and 42. The request had been directed against all goods and services of the challenged CTM. The invalidation request had been rejected on the grounds that the identity of the marks cannot overcome the existing dissimilarities between the goods and services.

**A+/Air Plus or Lufthansa AirPlus:** T-321/07 - 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 7.6.2007 in R 0310/2006-2 relating to CTM application No. 2 933 356, "A+" (figurative mark).



The CTM application had been filed in respect of the following goods and services in Classes 9, 35, 36, 37, 40, 41 and 42: scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving 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; publicity; business management; business administration; office functions; insurance; financial affairs; monetary affairs; real-estate affairs; building construction; repair; installation services; treatment of materials; providing of education; training; entertainment; sporting & cultural activities, and for scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computers and software; legal services.

It had been challenged on the basis of the earlier CTM "AirPlus International", word mark, registered for: computer programs recorded on data carriers, in particular for invoice and payment processing and for travel planning and travel costs processing; professions business and organisational consultancy; business advice; business marketing services, in particular the conducting of advertising initiatives, for others, mail advertising including mailing and compiling of mailing lists; processing of organisational procedures for others, in the fields of business and marketing; conducting and setting up billing systems for others, in particular billing systems for travel; financial services, including credit card company services, in particular the issuing of credit and service cards; concluding monetary transactions with credit cards; financial consultancy; processing of organisation procedures for others in the field of finance; invoicing and payment processing, in particular card billing for the services of others, including the gathering and evaluation of data on such services. The opposition had been rejected on the grounds that the marks in question are clearly dissimilar.

**Kenitex:** T-322/07 - Office response filed (PT).

Keywords: Cancellation/absolute grounds: bad faith application – Opposition/invalidation: likelihood of confusion (LOC).

The action is an invalidation case on absolute and relative grounds and concerns the decision of the 4th Board of 19.7.2007 in R 0330/2006-4 relating to CTM "Kenitex" (figurative mark), registered for a range of goods in Classes 1, 2 and 19.



The applicant for cancellation firstly argued that the CTM application had been filed in bad faith; in addition he invoked the earlier trade mark "Kenitex", registered in Classes 1, 2, 17 and 19. Both the Cancellation Division and the Board, for reasons of procedural economy, dealt only with the invoked earlier right. The CTM was invalidated.

**Easycover:** T-346/07 - Office response filed.

Keywords: Absolute grounds for refusal: distinctiveness.

The action is directed against a decision of the 4th Board of 3.7.2007 in R 1065/2005-4 relating to CTM application No. 4 114 567, word mark "Easycover", which had been applied for for: Class 19: building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal; Class 24: textile and textile goods, not included in other Classes, and in Class 27: mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile). It had been rejected on the grounds that the sign lacks distinctiveness for the claimed goods.

**Ecoblue:** T-281/07 - Office response filed.

Keywords: Opposition: likelihood of confusion (LOC).

The action is directed against a decision of the 1st Board of 25.4.2007 in R 0844/2006-1 relating to CTM application No. 2 871 598, word mark "ecoblue", which had been applied for for a range of services, namely: Class 35: business consultancy, organisation consultancy, professional business consultancy, arranging and concluding commercial transactions, for others; Class 36: financial affairs, monetary affairs, capital investment, credit consultancy, credit bureau; real estate affairs, real estate and mortgage brokerage, real estate management, consultancy with regard to the purchasing and financing of real estate, and Class 38: telecommunications services, except the transmission of radio and television programmes.



It had been opposed on the basis of various earlier rights in marks consisting of or containing "Blue" which are registered in Classes 9, 16, 35, 36 and 38. The opposition had been allowed on the grounds that there is LOC between the CTM application and the earlier marks "Blue" and "Blue Joven".

**Patrick Exclusive:** T-327/07 - Office response filed.

Keywords: Opposition: likelihood of confusion (LOC).

The action is directed against a decision of the 1st Board of 28.6.2007 in R 0727/2006-2 relating to CTM application No. 3 063 427, "Patrick Exclusive" (figurative mark). It had been applied for in Class 25. The application had been opposed on the basis of several earlier trade mark rights in the word "G. PATRICK" which are registered also in Class 25. The opposition had been allowed in full.



**Buzz:** T-302/07 - Office response filed.

Keywords: Opposition: formalities – Formalities: evidence of the existence and validity of the earlier right – Evidence: private database.

The action is directed against a decision of the 2nd Board of 29.6.2007 in R 1468/2006-2 relating to CTM application No. 4 441 044, "Buzz" (figurative mark)



The CTM application had been filed in respect of a range of goods and services in Classes 9, 16, 28 and 41. It had been opposed on the basis of the Austrian trade mark "BUZZ!", registered in Class 9 for hardware, software and data carriers, and in Class 16. Together with its notice of opposition, the opponent had filed an extract from a private database (Saegis). As matter of routine, the Office had subsequently informed the opponent that it had a certain time limit to furnish



further facts, evidence and arguments in support of its opposition. The opponent had also been informed of the following:

“Within the same period, you are required to prove the existence and validity of the earlier right invoked. Please refer to Rule 19 (2) IR. In particular, proof of the existence of an earlier registered trade mark (in the form of a registration certificate or other official document) must be filed and translated into the language of the proceedings. Please note that the Office will not inform you whether such evidence, or translations of it, is missing. It is your own responsibility to check whether this has been or must still be done. Please read carefully the attached information sheet about the evidence required to substantiate a notice of opposition”. Attached to the above-mentioned notification, the Office sent to the opponent (plaintiff in the present proceedings) a sheet entitled “ Information about evidence”, containing, inter alia, the following information:

“(Particulars to be proved /What to prove): Article 8(1) CTMR: Earlier registration or trade mark (other than CTM): all the formal and substantive particulars must be shown, namely (a) the issuing authority (b) the filing and registration number(s) (c) the territorial extent (for international registrations) (d) the filing, priority & registration dates (e) a representation of the sign as filed or registered (f) the goods/services covered (g) the expiry date of the registration (h) the opponent's ownership, as well as (i) any other inscription affecting the legal status or the scope of protection of the mark (disclaimers, limitations, renewals, transfers, pending actions etc.).

Means of evidence (How to prove it): Preferably registration certificates. The Office also accepts any other equivalent public document showing registration of the mark, such as extracts of records or official databases and official publications, provided they contain all the particulars of registrations. Extracts from private records or databases are not acceptable in opposition proceedings. If another public document is substituted for the registration certificate such as publications, extracts of records or official database printout, make sure that this document provides complete information about all the particulars of the registration.”

Since the opponent did not submit any further material, the opposition had been rejected on the grounds that the invoked earlier right had not been substantiated.

**PrimeCast:** T-373/07 - Office response filed (DE).

Keywords: Absolute grounds for refusal: distinctiveness.

The action is directed against a decision of the 4th Board of 20.7.2007 in R 0 333/2005-4 relating to CTM application No. 2 854 677, word mark “PrimeCast”, applied for for a range of goods and services in Classes 1, 19, 40 and 42. It had been partially rejected (as regards certain goods in Class 19 and certain services in Class 40).

## NEW DECISIONS FROM THE BOARDS OF APPEAL

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

Please note that the full number including slash has to be entered in our database under 'Appeal N°', without the letter 'R'.

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

### Index

**Revocation – Articles 50(1)(a) CTMR**  
R 0077/20006-1

**Absolute grounds of refusal – Articles 7(1)(b) and (c) CTMR**  
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### Revocation – Articles 50(1)(a) CTMR

*Revocation – trade mark not used – proper reasons for non-use*

**Decision of the First Board of Appeal of 11 December 2007 in Case R 77/2006-1**  
**MISS INTERCONTINENTAL (figurative mark) (German)**



**R 0077/20006-1** -  – it was not disputed that the CTM had not been put to genuine use within the last five years before the revocation action was filed. However, the owner claimed that bankruptcy proceedings which started during the relevant period were a proper reason for non-use. The Board considered that bankruptcy proceedings are not necessarily a proper reason for non-use. In the case at stake, however, the Court prohibited the owner of the CTM by order to dispose of its assets; consequently, the CTM could neither be sold nor licensed. The Board held that this Court order was a proper reason for non-use. The contested decision was annulled and the CTM remains in the register.

### Absolute grounds of refusal – Articles 7(1)(b) and (c) CTMR

*Examination proceedings – descriptive term – distinctive term – misspelling*

**Decision of the Fourth Board of Appeal of 18 January 2008 in Case R 607/2007-4 SIIMPLE (English)**

**R 0607/2007-4 – SIIMPLE (en)** – The Board held that a ny literate consumer would notice an obvious misspelling and in some cases the misspelling may attract their attention (disapproval) for a moment longer than would otherwise be the case. The idea of playing with the spelling of a word, or the grammar and syntax of a sentence, or adopting unorthodox punctuation, is a legitimate way of distinguishing a



sign from ordinary descriptive words and expressions. However, the Board stated that, in order to convert a descriptive or a non-distinctive term into a trade mark, the trader must cause the consumer to do more than merely notice the incorrect spelling or syntax; the consumer must perceive the sign as a trade mark. It held that doubling of the letter 'i' in this case only causes the sign to be understood as 'very simple', emphasising and even exaggerating the notion of 'simple'. The appeal was dismissed.

## E-business at OHIM

### Size and format of documents to attach to e-filings

Many queries received by the OHIM e-business hotline are related to problems when attaching documents to the CTM/RCD e-filing and electronic opposition systems.

OHIM has launched projects with the objective of making the attachments of documents more user-friendly and harmonizing the accepted formats and sizes.

Pending the outcome of these projects, the current sizes or formats of documents that can be attached to the e-filing systems are:

	Views/Graphic Representations	Other attachments	Maximum size of all attachments
CTM e-filing	Only JPG format  minimum 300 DPI resolution  Maximum size: 945x1899 pixels and 21.59 cm x 27.94 cm	PDF format	2 Mb
RCD e-filing	Only JPG format  minimum 300 DPI resolution  Maximum size: 2008 x 2835 pixels	PDF format	2 Mb
e-opposition	Only JPG format	PDF format	5 Mb
MyPage - Electronic communication	-	JPEG or PDF format	2 Mb

The size and format of an image is easy to verify and modify using some common pre-installed Microsoft Windows software:

1. Open the image with Microsoft Photo Editor
2. Go to Image - Resize
3. Change to the correct number of pixels and/or cms and save.

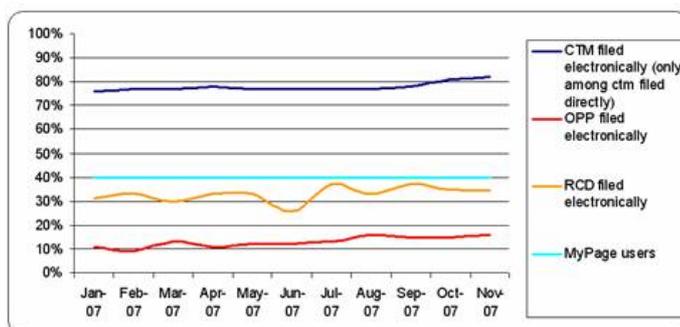
Users with another operating systems have similar software providing the same functionalities.

For further clarification on the formats and sizes of attachments or for troubleshooting please contact our e-business hotline at e-businesshelp@oami.europa.eu

## OHIM e-business roundup (2008)

### Statistical summary

- The use of the CTM e-filing web form has increased above 80%.
- The use of RCD e-filing is around 35%
- 14% of oppositions against CTM applications are received electronically.
- MyPage users represent around 40% 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 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* - OHIM has started the development phase

### 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* - DHIM has started the development phase

**CTM watch:**

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

*Status* - OHIM has started the development phase.

**More News****Electronic-only payments for design fees**

Since the beginning of this year, OHIM has only been accepting electronic payments for design-related fees. Applications containing cheque or cash payments are currently being returned to the payer with an explanatory note and instructions for paying by bank transfer or current account.

The change to electronic payment, which was announced on the website and in December's Alicante News, means faster and more secure processing of payments. It follows the earlier switch to electronic-only payments for Community Trade Marks and is in line with OHIM's e-business strategy. Users are urged to follow the new payment instructions in order to avoid delay and inconvenience.

**Monthly statistical highlights January 2008**

Community trade mark applications received	7.356
Community trade mark applications published	4.755
Community trade marks registered (certificates issued)	5.133
Community trade mark renewal applications	816
Registered Community designs received	3.344
Registered Community designs published	3.451

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