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## Consultation on trade marks in Europe

Around 400 European companies including a large number of SMEs have taken part in a European consultation on trade marks. The consultation, by the European Business Test Panel (EBTP) comes at a time when the European Commission is proposing a 40% cut in the cost of the Community trade mark, which is expected to be implemented in mid-2009.

This kind of consultation is designed to allow the European Commission to obtain direct feedback from businesses on Commission legislative proposals or initiatives likely to have an impact on businesses.

Introducing the consultation, the EBTP said: "Trade marks are an indicator of business origin, which distinguishes the products and services of one company from those of another. In 1989, the European Community harmonised national trade mark laws, and in 1994 it created the Community trade mark.

"The Community trade mark is in particular attractive to businesses as it gives its proprietor a right which is valid in the whole territory of the EU, as opposed to national marks which only cover their relevant national territory. This enables businesses to adapt their activities to the scale of the Community. More than 200,000 companies have now turned to the Office for Harmonization in the Internal Market (OHIM) in order to obtain EU-wide protection for their trade marks.

"The European Commission is currently evaluating the trade mark systems in Europe. The purpose is to provide an in-depth assessment of the functioning of the EU trade mark system with a view to identify potential needs for improvement and future developments. The evaluation includes issues such as the added value of a trade marks for companies, the awareness of the potential users, the costs of a trade mark, the relationship between the national and the Community trade mark systems, the efficiency of the systems and the protection of trade marks.

"The consultation aims at getting to know the views of companies, including small and medium sized businesses, about trade mark protection and the functioning of trade mark systems, as part of the overall evaluation."

The consultation's findings on the impact of the cost of trade marks and the associated administrative burden, on decisions taken on how to protect intellectual property rights make interesting reading.

Around one-quarter of the organisations said they did not currently sell outside their own countries. A significant proportion of respondents said they had not obtained a registered trade mark because it was either "too expensive", "too complicated" or they were "not convinced" of the added value.

Full details of the aggregate results of the consultation have now been published and are available at:

[http://ec.europa.eu/yourvoice/ebtp/consultations/2008\\_en.htm](http://ec.europa.eu/yourvoice/ebtp/consultations/2008_en.htm)



## **The James Nurton interview with Till Lampel, Partner, Harmsen Utescher, Hamburg**

**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. He speaks to Till Lampel of Harmsen Utescher about the growth in interest in the CTM in Germany and legal reforms in the country**

### **How long have you been working in trade marks?**

I started 17 years ago in May. I am an attorney working in trade marks, designs, unfair competition, copyright and patents. I like the fact that IP is intellectually challenging but also involves profound work. It is very fast and challenging and you deal with impressive and charismatic people – both clients and colleagues. It is also interesting to work with well-known marks.

I studied at the universities of Tübingen and Speyer and did the statutory clerkship for two-and-a-half years in Germany and the US. It was at this point that I was drawn to IP work.

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

Our law firm specialises in IP. We have 23 attorneys, all of whom handle trade mark issues, with almost 90 people in the firm in total. We have a broad mixture of international clients and German clients who we do international work for. So we have contacts with a lot of firms overseas. Personally, I handle both prosecution and litigation work in trade marks, with probably about a 40-60 split.

Altogether, we file between 19 and 25 CTMs per month, so up to about 300 a year. In the year to March 2008, according to published figures, we made 304 filings making us the top German firm filing CTMs. Filings from German clients have definitely increased, though of course it is hard to see what the economic changes will bring. The CTM is a lot more popular in Germany than it was back in the late 1990s, though it has always been popular with Japanese and US clients.

### **Why do you think interest from German companies has increased?**

The CTM system is not as difficult as perhaps some people thought in the beginning. They feared there would be a lot of oppositions, but we have found that while you may get a lot of those, normally things get sorted out in the end. And you get protection in 27 countries.

### **Do you think CTMs have taken over from national marks?**

If the client acts globally, I normally recommend having parallel applications – one for a CTM and one for a national mark on which to base the international registration. This is a good precaution as you're never quite sure what will happen to the CTM application. It provides a safe harbour. But of course sometimes clients only want a CTM.

### **Are you happy with the speed and quality of examination at OHIM?**

The speed of examination has increased further: we have seen some applications published in as little as two to three months.

The quality of examination is generally good, but sometimes you get different views from different examiners, even with

similar trade marks and a similar specification of goods. For example, some examiners might be more strict about formal documents or raising a substantive issue.

Also, the standards applied by the different boards of appeal regarding affidavits seem to vary considerably, and there is the question whether additional supplementary evidence is admissible at the appeal stage. It can be hard to understand the different kinds of standards.

But overall I think OHIM is doing a very good job. They are very user-friendly – if you telephone, they are always helpful and in this respect I would say they are probably more responsive than WIPO. Also, the website is brilliant and the texts and legal commentary are very good. Maybe they could do with more examiners to improve the standards.

### **Do you use electronic filing?**

We've used it from the start. We have used the new system since February 1 and it seems to work very well. It seems to be clearer, more user-friendly and quicker, which is a major step forward.

### **What was the first CTM you filed?**

Our firm filed dozens and dozens by fax on 1st April 1996 to get the priority date - this was before e-filing. One of the lowest numbers was VIVIL for confectionery. Personally, my first one was FUNNY-FRISCH, which was for crisps.

We have filed quite a lot of unusual trade marks. Out of the ones I filed the most interesting is probably a jingle mark that we filed in the food sector, which is still pending. It was interesting for me, as I also play the piano. The notes were all written in the application. I was surprised to see that not many sound marks have been filed.

### **Do you make use of the Community design right?**

Yes, we do. Designs are very useful. You can sue an infringer even if the design is used on completely different goods, whereas with a trade mark the goods have to be similar. But bringing infringement claims with design rights alone can be risky. Even if they are upheld as valid, the scope of protection may be narrow.

I particularly recommend the Community design for trade dress or shapes of goods where you sometimes have problems getting trade mark protection.

### **In Germany, a question has been referred to the ECJ regarding AdWords. What do you think of this?**

This is a very important question. The German Supreme Court rightly referred one of the three cases they had to decide to the ECJ and it will be interesting to see what the outcome will be. I'm inclined to think that use of trade marks in AdWords could be an infringement. It could be risky to use them for the time being. Recent decisions on meta-tags and AdWords have been very interesting and tended to go up and down, so it will be good to have some clarity.

### **What other changes have there been recently in Germany?**



We have new laws as a result of the Enforcement Directive with new measures such as the recall of infringing goods, presentation of documents, the right to obtain information from the other party, publication of judgments and a few elements of discovery. So that is a major change, which was implemented in September last year.

Also, on 1st January this year, the new Unfair Competition Law came into force, which implements the Unfair Commercial Practices Directive. Competition law is very highly developed in Germany, but this new law introduces a blacklist of things that are illegal in any form. We still have the broad clauses, so the list is not exclusive, but it provides a lot of detail.

#### Is the Unfair Competition Law good for trade mark owners?

With look-alikes, it's always been very helpful to have the trade mark and unfair competition law too. Sometimes it is easier to go after look-alikes in Germany than in other countries and this is one of the reasons why.

#### What do you think will be the challenges for trade mark owners in the future?

Counterfeits and look-alikes will continue to be big challenges. We know the dangers and health risks of counterfeit goods, and look-alikes are also a major commercial issue. You do not need just trade marks, but also design rights and unfair competition law to deal with it. With the economic situation, consumers might be even more tempted to buy counterfeits and look-alikes but that is not acceptable.

Clearly, issues arising from advertising on the internet such as AdWords and meta-tags will also be important. It is very hard for the law to keep up with the technical development of the internet.

### Community Trade Mark

#### Dietary biscuit trade mark cancelled

A Community trade mark granted to a Spanish company for dietary products has been cancelled following an invalidity application by the owner of a similar German trade mark covering the same type of products.

The 3D Community trade mark, which contains the word "MEMORY10" was registered in 2006 for a range of goods in Classes 5 and 30. The earlier German word trade mark "MEMORY" was registered in 1999 for goods in Classes 1, 5 and 30. The German company asked for a declaration of invalidity on the ground that there was a likelihood of confusion because of the similarity of the marks and because the goods covered by the marks were identical or similar. The relevant territory to be taken into account in assessing the likelihood of confusion was Germany.

OHIM's Cancellation Division found that the CTM proprietor's "dietetic substances adapted for medical use in class 5" was identical to the "dietetics foodstuffs adapted for medical use" covered by the German company's trade mark in the same class. In Class 30, the CTM proprietor's "dietetic biscuits" were also found to be "highly similar" to the German "dietetic

foodstuffs adapted for medical use." Both were foodstuffs for dietetic purposes, had points in common as regards their basic ingredients, and could often be found in similar commercial establishments. The method of use of the goods was also the same.



The Cancellation Division, comparing the marks, found that the word "MEMORY" formed an outstanding element within the CTM, because of its size in comparison with the other elements, its colour and central position within the wrapper. While the earlier trade mark was found to be only "weakly" distinctive in the relevant territory, consumers would make a conceptual link between the trade marks due to the presence of the identical word.

The Cancellation Division concluded: "In view of the fact that the goods in question are identical and highly similar and the signs present important similarities ... as well as with regard to the principle that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind, the Office concludes that it is likely that a significant part of the relevant public in Germany could think that the identical and highly similar goods in dispute, bearing the respective signs, originate from the same or economically linked undertakings. Therefore there is a likelihood of confusion including likelihood of association between the CTM and the earlier mark on the part of the public for the identical and highly similar contested goods. The request for a declaration of invalidity is fully upheld and the registration of Community trade mark No 2 776 524 is declared invalid in its entirety."



**Country overview: Estonia & the Community Trade Mark**



Estonia, with a population of 1.4m, joined the EU in 2004. The most northerly of the Baltic states, the country regained its independence from the Soviet Union in 1991. It is a mainly flat country on the eastern shores of the Baltic Sea, with many lakes and islands, and much of the land is farmed or forested.

The capital, Tallinn, is one of the best-preserved mediaeval cities in Europe, and tourism accounts for 15% of Estonian GDP. The economy is driven by engineering, food products, metals, chemicals and wood products.

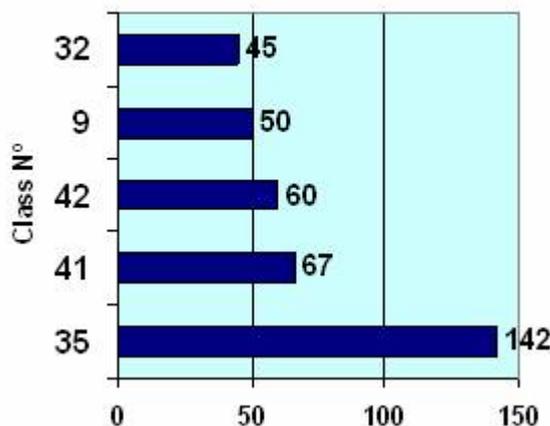
Estonian figures for GDP show that growth in the third quarter of 2008 was down by 0.9% compared with previous quarter.

The service sector overall, including tourism, accounts for 65% of GDP followed by industry (32%), and agriculture (3%).

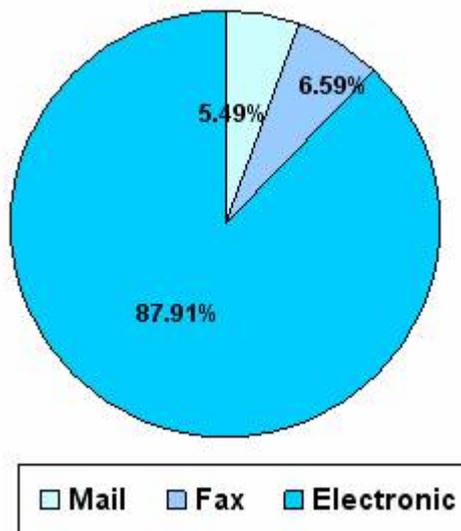
Estonian undertakings have so far not been large users of the CTM system, but registrations started to pick up just before entry into the EU in 2004. There have been just over 360 Estonian CTMs registrations to date, including 88 last year.

Figurative marks are the most popular with Estonian enterprises and account for 59% of applications, followed by word marks (40%). The most popular goods and services applied for are in classes 35, 41 and 42.

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

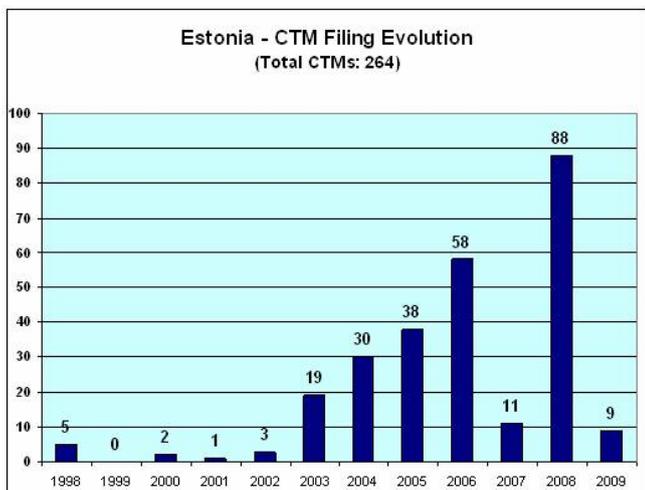


The vast majority of Estonian trade marks (88%) are filed electronically, with fax accounting for 7% and mail for 5%.



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

Company	CTMs
Dunkri Kaubanduse AS	15
Balti Investeeringute Grupi Pank AS	5
Coca-Cola HBC Eesti AS	5
Liviko AS	5
OÜ Friends Textile	5
AS GRAANUL INVEST	4
AS KALEV CHOCOLATE FACTORY	4
AS TALLINNA KARASTUSJOOGID (public limited company)	4
Scanfinest O	4
TERE AS	4



Word	Figurative	3-D	Colour	Other
40.11 %	59.07 %	0.82 %	0.00 %	0.0 %



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

Representative	CTMs
LASVET OÜ	70
PATENT AGENCY KÄOSAAR & CO	62
PATENDIBÜROO KOPPEL OU	54
PATENT & TRADE MARK AGENCY KOITEL	10
AAA PATENDIBÜROO O	5
ALBIHNS AB	4
Arula	4
Kauler	4
Kesna LLC	3
Koitel	3

## Community Design

### Change of practice on RCD priority documents

OHIM has changed the way in which it examines priority documents before the registration of Community designs meaning that the Design Department has stopped its previous practice of carrying out an examination of whether the subject matter of the priority application and the RCD application are the same.

In consequence, OHIM will now accept priority documents that do not include views of designs, such as German registration certificates. The change will help accelerate the registration process, and is in line with the practice in most EU member states.

For full details, see the Information Note below.

### Information Note on examination of priority documents

#### -Decision to Change Practice

OHIM's Design Department has ceased examining whether the subject matter of the priority application and the RCD application are the same.

The examination of priority documents before registration will be restricted to the following items as stated in the current Examination Guidelines<sup>1</sup>, namely whether

- (a) the file number of the earlier application is indicated;
- (b) the filing date of the application for a registered Community design falls within the period of six months of the claimed priority date;
- (c) the previous application(s) has/have been filed in or for a State on the Paris Convention list or the WTO list;
- (c) the time limit to file a declaration of priority is complied with.

The change of practice means that the part of the Examination Guidelines concerning *prima facie* examination of the subject-matter no longer applies.

As an immediate consequence of the present decision, the Design Department will accept priority documents which do not include views of designs, such as German design registration certificates ("Urkunde").

#### -Reasoning

With this decision OHIM follows the practice in the member states as it emerged during the 7<sup>th</sup> Liaison Meeting in October 2008. A majority of member states with a design registration system similar to OHIM's (i.e. no novelty examination before registration) was found not to examine the sameness of the designs in the earlier and the later applications, respectively.

The new practice further smoothes the link established in January 2008 between the registered Community design and the International registered design, since WIPO does not carry out any examination of priority documents. In fact, WIPO does not even require the submission of priority documents.

Reducing the scope of examination is in the interest of the users since it allows for an acceleration of the registration process.

#### -Legal basis

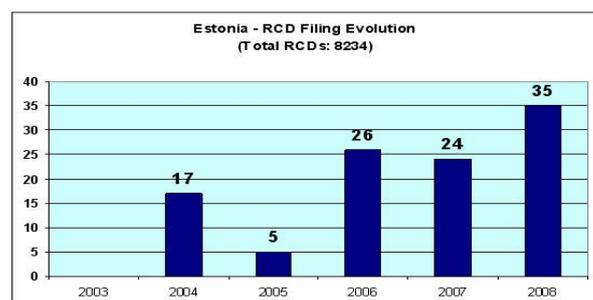
The scope of examination before registration is defined in Article 10 CDIR which stipulates the "examination of requirements for a filing date and of formal requirements." As regards priority claims, Article 10(3)(c) CDIR refers to the requirements of set out in Articles 8 and 9 CDIR. None of these provisions implicitly or explicitly obliges OHIM to enter into a comparison between the designs of the RCD application and priority application, respectively.

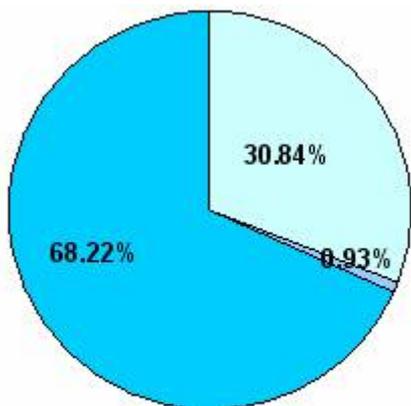
Decision of the President EX-03-09 of 9 December 2003

## Country overview: Estonia & the Registered Community Design

Just as with Community trade marks, Estonian companies have so far not been prolific users of Community designs. The first few Estonian filings of Community designs were made 2004, and there have been just 107 to date, including 35 last year.

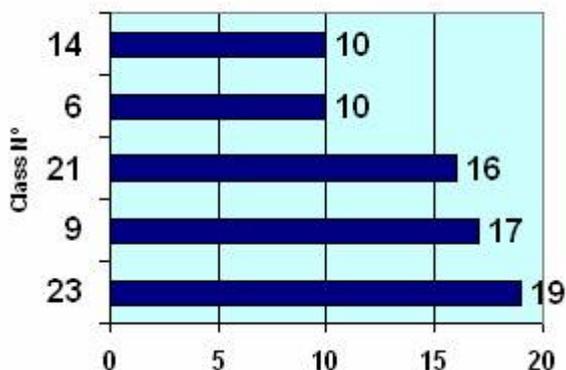
The most popular classes for RCDs are 23, 9 and 21. E-filing is the most popular filing route, accounting for 68%, with mail the next most popular at 31%. Filings by fax account less than 1% of the total.





□ Mail □ Fax □ E-Filing

**Estonia - Top Classes Filed (Locarno)**



**Top 10 Estonia -based owners by number of RCDs filed**

Owner	RCDs
AS Balteco	13
Scanfinest O	11
OÜ EASYFIT	10
AUDES LLC O	9
Tepet O	7
LUKEREN TRADING OÜ	6
Eelmets	5
AS Hallik	4
ME-SISUSTUS O	4
NEOQI AS	4

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

Representative	RCDs
PATENDIBUROO KOPPEL OU	16
SYNEST LIMITED	16
PAPULA OY	14
PATENT AGENCY KÄOSAAR & CO	8
PATENDIBÜROO TURVAJA O	7
PATENT & TRADE MARK AGENCY KOITEL	6
Puur	6
AAA PATENDIBÜROO O	5
Arula	4
Koppel	4

**E-business at OHIM**

**How to make the most of the new CTM E-Filing**

**1. Save/restore option**

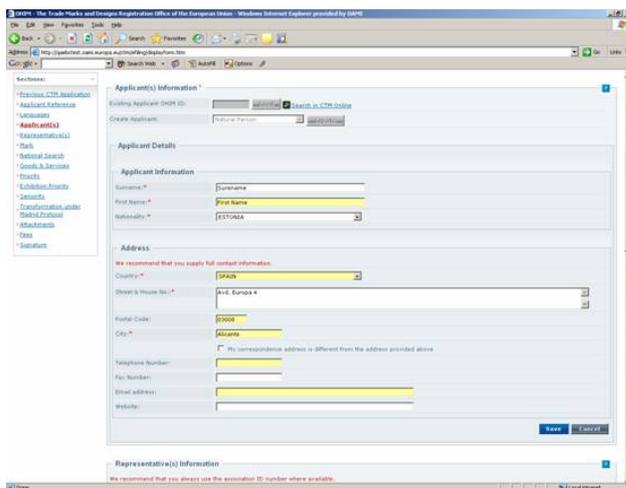
One of the most interesting features of the new CTM E-Filing is the possibility of saving a CTM application in form of an XML-file either to MyPage or to your local computer.

The main benefit of this feature is that it is not necessary to type all the information into the e-filing form each time we start a new e-filing. Once saved, the e-filing application can be easily restored from MyPage or on your own computer, and the data included in the saved form can than be used for filing new applications. The save/restore option is explained step-by-step through a set of online demonstrations in our Multimedia section on the OHIM website:

<http://oami.europa.eu/ows/rw/pages/OHIM/multimedia/CTM-E-Filing.en.do>

**2. Adding new representative/applicant**

One important thing to remember when adding or creating a new representative/applicant is that in order to keep the keyed in data it is necessary to press the “save” button in the lower right hand corner.



The screenshot shows the 'Representative Information' and 'Address' sections of the CTM E-Filing form. The 'Representative Information' section includes fields for 'Surname', 'First Name', 'Economic Connection', and 'Nature of economic connection'. The 'Address' section includes fields for 'Country', 'Street & House No.', 'Postal Code', 'City', 'Telephone Number', 'Fax Number', 'Email address', and 'Website'.

### 3. Character set for word trade marks

A specific innovation has been introduced for word marks, based on our experience that many word trade marks make use of characters from languages other than the application language. In order to display correctly characters from languages other than the application language users can now chose/change the character set for the representation of the mark. Example: the application is filed in English; however the word trademark includes Cyrillic characters. It is necessary to change the character set in the Mark section:

The screenshot shows the 'Mark' section of the CTM E-Filing form. It includes fields for 'Type of mark', 'Character set of the representation of the mark', and 'Representation of wordmark'. The 'Character set of the representation of the mark' is set to 'Cyrillic' and the 'Representation of wordmark' is 'trade mark - регистра знака'.

### 4. Attachments of three-dimensional marks

Attachments in JPEG format for the graphical representation of non-word marks are accepted in the "Mark" section. The representation of three-dimensional marks supplied in the attachment may now consist of up to six representations of the shape, however all representations must be uploaded in one single document.

### 5. Payment by current account

The Office has changed its practice regarding payment by current account. The option to select when the debit to the current account will be carried out has been removed. OHIM will debit the current account at the end of the first month period.

### 6. Compatibility with Internet Explorer 7 and Adobe Acrobat Reader

In order to ensure smooth running of the e-filing process we recommend that users add the CTM E-Filing form to their "trusted" sites. Instructions on "How to add/remove Websites" can be found on the Windows help-page at: <http://windowshelp.microsoft.com/Windows/en-US/Help/fd277a6b-3722-445b-b32e-1f8e925c385a1033.msp.x>.

With the new CTM E-Filing the Office has stopped sending printed receipts for applications filed online. For the correct display and generation of final receipts it is strongly advised that users obtain the latest version of Adobe Acrobat Reader, which is available free of charge on the [Adobe website](http://www.adobe.com).

### What's new in CTM-ONLINE?

During 20-26 February, OHIM will be improving its computer services for CTM management. On 6 March, CTM-ONLINE will be updated with data from this new service.

From the user's perspective, the search facilities and the information regarding CTM files will remain the same. However, one of the major changes brought about by the change in back office services will be an improvement in way the steps in the registration process are dealt with.

What is designated in the system currently as the "status" will be broken down in future into "milestones" and "tasks", in a move that will increase the flexibility in the way in which we process CTM applications. This should in turn be reflected in increased efficiency with all the attendant benefits to users.

The screenshot shows the CTM-ONLINE interface displaying detailed trade mark information for 'umbrella' (class 02/19/23). It includes a table for 'Trade mark status history' with columns for 'Trade mark status', 'Sub-status', and 'Status date'.

Trade mark status	Sub-status	Status date
CTM application published		15/12/2008
CTM application - translation & research		15/12/2008
CTM application - translation completed		15/12/2008
CTM application - research completed		15/12/2008
CTM application - classification completed		15/12/2008
CTM application - formalities completed		15/12/2008
CTM application - filing date provisionally granted		15/12/2008
CTM application reserved		05/12/2008

Therefore, a new transition diagram will be published and all CTM applications currently in the registration process will keep their historic statuses and have one of the new statuses allocated in terms of the new "milestones" and "tasks".

**Milestones:** These are the main steps in the registration process such as Examination of CTM application, Publication, etc.



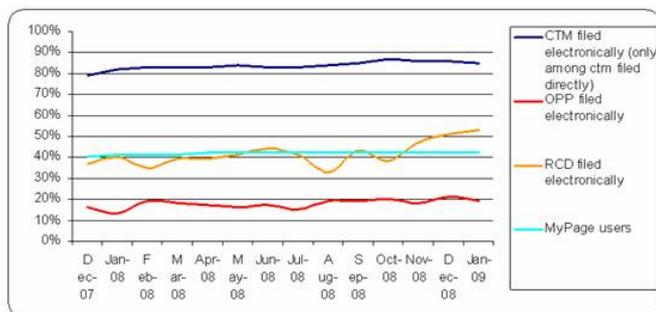
**Tasks:** Tasks always belong to milestones and indicate a job or action taken by OHIM. In CTM–ONLINE the tasks are displayed together with a tick box. When the tick box is marked as “un-ticked” it means that the task is currently being executed and when it is “ticked” it indicates that the tasks has been completed (usually showing the date recorded in the system.)

Further information will be available when the service is launched on 6 March and the new glossary webpage will explain the new milestone and tasks in further detail.

Should you require any further information, please contact us at [information@oami.europa.eu](mailto:information@oami.europa.eu).

## OHIM e-business roundup (2009) Statistical summary

- The use of the CTM e-filing web form is steady at above 80%.
- The use of RCD e-filing has increased to over 50%
- Oppositions against CTM applications received electronically is around 20%.
- MyPage users represent around 42% of CTM Applications filed.



## State of play of future projects

### Service - New version of CTM E-filing:

*Status* - It is live since 02 February

### 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 is testing the system

### CTM watch:

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

*Status* - OHIM is going to start the testing phase

## More News Service delays

Users may experience service delays in a number of areas from Friday 20 February at 5.00pm (CET) until Friday 6 March due to the installation of essential improvements to OHIM's back office services.

While all the eBusiness tools will be operating and provisional filing dates will be granted (users of eBusiness services will be able to do online filing for CTMs and RCDs, oppositions, and renewals, and use E-Communication and FindRep) a number of internal systems used to treat the files or answer customer queries or get information about the progress of files, will be out of service.

- Requests will not be treated by the Office until 26 February.
- Updates to our search tools CTM Online, RCD Online, Online Access to Files (including for MyPage users), will not be visible to users until Friday 6 March.
- There may also be delays in sending receipts for applications and oppositions sent by mail or fax.
- Publication of CTM Bulletins and RCD Bulletins will be affected:

### Revised publication schedule:

CTM Bulletin - Friday 20 February, Monday 2 March.  
RCD Bulletin - Friday 20 February, Friday 27 February.  
RCD Records - Friday 20 February.  
Public notifications - Friday 20 February.

OHIM apologies for any inconvenience caused to users due to this work. It forms an important part of our efforts to improve trade mark examination services and we are making every effort to keep the disruption to a minimum.

## Monthly statistical highlights January 2009

Community trade mark applications received	5 507
Community trade mark applications published	6 655
Community trade marks registered (certificates issued)	7 608
Community trade mark renewal applications	2 020
Registered Community designs received	3 597
Registered Community designs published	5 310

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



## Case-law

### Latest trade mark and design news from Luxembourg

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**ECJ Judgments and Orders**  
Mobilix/Obelix: C-16/06-P

**ECJ Developments in pending cases**  
Zipcar/Cicar: C-394/08-P

**ECJ Preliminary Rulings**  
Radetzky: C-442/07  
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**ECJ Preliminary Rulings: Developments in pending case**

NONE

#### CFI Judgments and Orders

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Metronia: T-290/07  
Cellutrim: T-169/07  
Visible White: T-136/07  
Sky/Skyrock: T-66/06  
Fun: T-67/07  
Barbara Becker: T-212/07  
Brillo's/Brillante: T-275/07  
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Anew Alternative: T-184/07  
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#### CFI Judgments and Orders: Developments in pending cases

Kiowa/Cohiba: T-207/08  
Wiener Werkstätte-I: T-230/08  
Wiener Werkstätte-II: T-231/08  
Citracal: T-277/08  
Executive Edition: T-310/08  
Natur-Aktien-Index: T-285/08  
Outburst: T-214/08  
Polar Ice: T-256/08  
Zydus-II or Zydus/Zimbus: T-288/08  
Zydus-I or Zydus/Cibus: T-287/08  
TIR: T-245/08  
Bahman: T-223/08  
Jose Padilla: T-255/08  
Alaska-II: T-226/08  
Alaska -I: T-225/08

in Classes 9, 16, 35, 37, 38 and 42. The invoked earlier rights in OBELIX are registered in Classes 9, 16, 28, 35, 41 and 42.

The Opposition Division had rejected the opposition. After finding that it had not been conclusively demonstrated that the earlier trade mark was well known, it had found that the trade marks were not similar overall, that there was a certain aural similarity but that that was offset by the visual appearance of the trade marks and, more particularly, by the very different concepts which they express. Moreover, the earlier registration is more associated with the famous comic strip, which distinguishes it even more, from the conceptual point of view, from the trade mark applied for. Upon appeal, the 4th Board had partially annulled that decision, stating, first of all, that the opposition should be regarded as being based exclusively on the likelihood of confusion.

Before the CFI, the plaintiff (opponent) had sought annulment of that decision, advancing three pleas in law alleging: first, infringement of Article 8(1)(b) and (2) CTMR, second, infringement of Article 8(5) thereof and, third, infringement of Article 74 CTMR. At the CFI hearing, the plaintiff had requested, in the alternative, that the court remit the case to the 4th Board so that it might demonstrate that its trade mark had a 'reputation' within the meaning of Article 8(5) CTMR.

The CFI, in paragraphs 15 and 16 of its judgment, had started by determining whether five documents attached to the application, and intended to prove that the word sign OBELIX is well known, were admissible. Having established that those documents had not been produced in the proceedings before OHIM, the court declared them to be inadmissible insofar as their admission was contrary to Article 135(4) of the Rules of Procedure. Then, referring to Articles 63 and 74 CTMR and Article 135 of its Rules of Procedure, the CFI had declared inadmissible the plea based on infringement of Article 8(5) CTMR.

The CFI had pointed out, *inter alia*, in paragraph 20 of the judgment, that at no time had the plaintiff requested the Board to apply Article 8(5) and that it therefore had not been examined. It declared that, although the appellant did invoke the reputation of its earlier trade mark in its opposition to the trade mark application and before the Board, this had exclusively been within the context of the application of Article 8(1)(b), that is to say, for the purpose of substantiating the likelihood of confusion in the mind of the relevant public. Lastly, the CFI, under Article 44(1) of its Rules of Procedure, declared inadmissible the head of claim submitted at the hearing.

As regards the substance, the CFI had gone on in paragraphs 32 to 36 of the judgment to examine Article 74 CTMR and the plaintiff's plea, according to which, in the absence of any challenge by Orange, the Board should have started from the principle that the OBELIX mark had a reputation.

The court held in paragraph 34 of the judgment under appeal that Article 74 of Regulation No 40/94 could not be interpreted to mean that OHIM is required to accept that points put forward by one party and not challenged by the other party to the proceedings are established. It stated in paragraph 35 of the judgment, that, in the present case, neither the Opposition Division nor the Board of Appeal had found that the appellant had substantiated conclusively by facts or evidence the legal

## 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

**Mobilix/Obelix** : C-16/06-P – Judgment of 18 December 2008 (appeal from Case T-336/03; action rejected = CFI confirmed; Board decision stands).

Keywords: General legal principles: *reformatio in peius* ('counteraction theory') – Procedural law: modification of the subject matter of the case – Opposition proceedings: Article 74(1) CTMR – Article 74(1) CTMR: scope (must a party challenge all submissions by the other party?) – Opposition: earlier right with reputation – Opposition: likelihood of confusion (LOC)

The case is an appeal against a judgment of the CFI of 27.10.2005 in Case T-336/03 *Les Éditions Albert René v OHIM – Orange (MOBILIX)* [2005] ECR II-4667, dismissing its action against the decision of the 4th Board 14.7.2003 in Case R 0559/2002-4, concerning the opposition filed by the plaintiff, the proprietor of the earlier marks "OBELIX", to the registration as a CTM of the word "MOBILIX". The CTM application had been filed for a range of goods and services



assessment it was putting forward, namely that the unregistered sign was well known and the registered sign highly distinctive. Therefore, in paragraph 36, the CFI had declared that plea to be unfounded. On substance, the CFI denied LOC as regards the goods and services at issue, i. e. under appeal, mainly holding, however, that the marks are sufficiently distinct. The appeal of the opponent had been rejected (which means that the Board decision containing a partial finding of LOC had nonetheless been standing).

The 1st Chamber of the ECJ (Jann; Tizzano; Borg Barthet; Ilešič; Levits, rapporteur) confirmed the CFI.

*(a) As regards entitlement of the CFI to analyse the similarity of the marks*

“(38) Pursuant to Article 63(2) CTMR, the CFI is called upon to assess the legality of the decisions of the Boards of Appeal of OHIM by reviewing their application of Community law, having regard, in particular, to the facts which were submitted to them (see, to that effect, judgment of 4 October 2007 in Case C-311/05 P Naipes Heraclio Fournier v OHIM, para 38 and the case-law cited).

(39) Thus, within the restrictions of Article 63 CTMR, as interpreted by the Court of Justice, the CFI can carry out a full review of the legality of the decisions of OHIM’s Boards, if necessary examining whether those boards have made a correct legal classification of the facts of the dispute (see, to that effect, Naipes Heraclio Fournier v OHIM, paragraph 39) or whether their assessment of the facts submitted to them was flawed.

(40) It should be recalled that the appellant argued before the CFI that the Fourth Board infringed Article 8(1)(b) and (2) CTMR.

(41) Under that plea, first, the appellant raised the question of the similarity of the signs at issue. In particular, as shown in paragraphs 8 and 47 to 49 of the judgment under appeal, whereas the Board had found that there was a certain similarity between those signs, the appellant submitted that they were in fact very similar and sought a finding that there was a higher degree of similarity than that found by the Board.

(42) Therefore, as the Advocate General also observes in point 41 of her Opinion, the appellant itself included the issue of the similarity of the signs at issue within the subject-matter of the proceedings.

(43) Secondly, the appellant also submitted that, as far as the likelihood of confusion is concerned, if account is taken of the interdependence between the similarity of the goods, the similarity of the signs and the distinctiveness of the earlier mark, the differences between the signs in the case of the identical goods and services and, to a large extent, in the case of the similar goods and services, are not enough to prevent, in particular, auditory confusion given that the earlier trade mark is well known.”

(47) Therefore, since the appellant called into question the Board of Appeal’s assessment relating to the likelihood of confusion by virtue of the principle of the interdependence of

the factors taken into account, in particular the similarity of the trade marks and that of the goods and services covered, the CFI was competent to examine the Board of Appeal’s assessment of the similarity of the signs at issue.

(48) Where it is called upon to assess the legality of a decision of the Board, the CFI cannot be bound by an incorrect assessment of the facts by that Board, since that assessment is part of the findings whose legality is being disputed before the CFI.

(49) Lastly, as regards the appellant’s reference to the principle prohibiting *reformatio in pejus*, even on the assumption that such a principle may be relied upon in proceedings for the review of the legality of a decision of a Board, it suffices to observe that, by finding that there was no likelihood of confusion and dismissing the appellant’s action, the CFI maintained in force the contested decision. Therefore, since the contested decision did not grant the appellant’s claims, the appellant is not, following the judgment under appeal, in a less favourable legal position than it was in before the action was brought.”

*(b) Article 74(1) CTMR – principle of party disposition?*

“(103) First, the appellant alleges that the CFI infringed Article 74 CTMR by rejecting, in para 36 of (its) judgment, its claim that the Board should have accepted that the OBELIX trade mark was well known, highly distinctive and had a reputation, the other party to the proceedings before the Board not having challenged those facts.

(104) The appellant submits that it is necessary to distinguish between a situation in which Orange did not take part in the opposition proceedings before the Board of Appeal, in which case OHIM could adopt its decision solely on the basis of the evidence produced by the appellant, the opponent in the proceedings, and a situation in which Orange took part in those proceedings. In the second case, since Orange did not challenge the appellant’s claims, it was absurd to require the appellant to provide all the evidence to support those claims, since there is no rule or principle of Community law which requires a party to produce evidence to prove something which is not contested by the other party.

(105) Secondly, the appellant submits that the CFI infringed Article 74 CTMR by itself refusing, like the Board, to accept that the OBELIX trade mark was well known, highly distinctive and had a reputation.”

“(107) It must be stated at the outset that the appellant’s claim that the CFI infringed Article 74 CTMR in refusing to accept that the OBELIX trade mark was well known, highly distinctive and had a reputation, is founded on a misinterpretation of paras 32 to 36 of the judgment under appeal and, as a result, is unfounded.

(108) In fact, in paras 32 to 36 of the judgment under appeal the CFI did not itself examine whether the OBELIX trade mark was well known, highly distinctive and had a reputation, but merely examined the merits of the appellant’s plea alleging infringement of Article 74(1) CTMR, namely that, in the absence of any challenge by Orange, the Board of Appeal



should have deemed the appellant's assessment concerning the OBELIX mark to have been established.

(109) As the appellant has submitted in this connection that, by declaring that the Board had not infringed Article 74(1) CTMR, the CFI itself infringed that provision, that head of claim should be rejected as inadmissible.

(110) Admittedly, provided that an appellant challenges the interpretation or application of Community law by the CFI, the points of law examined at first instance may be discussed again in the course of an appeal. Indeed, if an appellant could not thus base his appeal on pleas in law and arguments already relied on before the CFI, an appeal would be deprived of part of its purpose (see, in particular, Case C-41/00 P Interporc v Commission [2003] ECR I-2125, para 17, and Storck v OHIM, para 48).

(111) However, it follows from Article 225 EC, the first paragraph of Article 58 of the Statute of the ECJ and Article 112(1)(c) of the Rules of Procedure of the CFI, that an appeal must indicate precisely the contested elements of the judgment which the appellant seeks to have set aside and also the legal arguments specifically advanced in support of the appeal. That requirement is not satisfied by an appeal which, without even including an argument specifically identifying the error of law allegedly vitiating the judgment under appeal, merely repeats or reproduces verbatim the pleas in law and arguments previously submitted to the CFI (see, in particular, Case C-352/98 P Bergadermand Goupil v Commission [2000] ECR I-5291, paras 34 and 35, and Storck v OHIM, para 47).

(112) Having already argued before the CFI that, since Orange did not challenge its claims put forward during the opposition proceedings, OHIM should have started by assuming that the OBELIX mark was well known, the applicant is merely repeating in this ground of appeal the argument submitted before the CFI, without explaining on what grounds that court erred in law by rejecting that argument in paragraphs 32 to 36 of the judgment under appeal.

(113) The appellant's third ground of appeal, alleging an infringement of Article 74(1) CTMR, must therefore be dismissed as in part unfounded and in part inadmissible."

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

**Zipcar/Cicar** : C-394/08-P – Appeal from T-36/07; Office response filed.

Keywords: CFI proceedings: admissible pleas and arguments – Opposition: likelihood of confusion (LOC) – LOC: comparison of marks – Comparison of marks: impact of phonetic aspects.

The case is an appeal seeking the annulment of the judgment of 25.6.2008 of the CFI in Case T-36/07 relating to CTM application "ZIPCAR" which had been applied for in respect of the following goods and services in Classes 9, 39 and 42:

computer software; computer software to facilitate transportation reservation services and motor vehicle sharing services; computer software to facilitate scheduling, planning, organizing, managing and providing the temporary use of motor vehicles; electronic, encoded and magnetic cards; smart (programmable) cards; electronic key cards; smart (programmable) cards, encoded cards and electronic key cards to facilitate transportation reservation services and motor vehicle sharing services, namely scheduling, planning, organizing, managing and providing the temporary use of motor vehicles.

Further in Class 39 for: Arrangement of travel and transportation; transportation reservation services; motor vehicle sharing services; vehicle rental; arrangement of rental of vehicles; vehicle rental reservation services; scheduling, planning, organizing, managing and providing the temporary use of motor vehicles; information, advisory and consultancy services relating to the foregoing, and in Class 42 for licensing of computer software; licensing of intellectual property; licensing of technology; licensing of electronic apparatus; licensing of smart (programmable) cards, encoded cards, electronic key cards and related technology; information, advisory and consultancy services relating to the foregoing.

It had been partially opposed (Class 39) on the basis of a Spanish trade mark registration of the word mark "CICAR", registered in respect of 'vehicle rental reservation services' in Class 39. The opposition had been allowed. In essence, the Board had held that, considering the high degree of similarity between the conflicting services and the way these are usually provided in the marketplace, the close *phonetic* similarity between the words 'ZIPCAR' and 'CICAR' is sufficient to create a likelihood of confusion in Spain between the earlier mark and the sign applied for within the meaning of Article 8 (1) (b) CTMR. The CFI had confirmed the finding of LOC.

## B: European Court of Justice: Preliminary Rulings

### B-1: ECJ Preliminary Rulings

**Radetzky** : C-442/07 – Judgment of 9 Dezember 2008 (Grand Chamber).

Keywords: First Council Directive 89/104/EEC (TMD) Article 12, genuine use – Use: must it be for commercial purposes?

This Reference for a Preliminary Ruling had been made in the course of proceedings between the Verein Radetzky-Orden ('the Radetzky-Orden') and the Bundesvereinigung Kameradschaft 'Feldmarschall Radetzky' ('the BKFR') concerning the revocation, on grounds of lack of genuine use, of trade marks owned by the BKFR, which is a non-profit-making association.

The BKFR is dedicated, on one hand, to the preservation of military traditions, such as memorial services for those who have fallen in combat, remembrance services, military reunions and the upkeep of war memorials and, on the other, to charitable work, such as the collection of gifts in cash or in kind and their distribution to the needy. The BKFR is the



proprietor of figurative and word marks representing essentially badges of honour. Those marks were entered in the trade mark register of the Austrian Patent Office. Protection began on 8.1.1996. Each of the marks had been registered for Class 37 (in particular, for maintenance work), Class 41 (*inter alia*, for cultural activities), and Class 42 (now 45) (in particular for social services). The BKFR awards orders and decorations which correspond to the trade marks at issue in the main proceedings. Some BKFR members wear those orders and decorations at various events and when collecting and distributing donations. Finally, the marks are printed on invitations to forthcoming events, on stationery and on the association's correspondence.

On 17.8.2004, the Radetzky-Orden sought to have the trade marks cancelled on grounds of non-use, in accordance with Paragraph 33a of the MSchG. In support of its application, it argued that the BKFR had not used the trade marks commercially over the course of the preceding five years. The Cancellation Section of the Austrian Patent Office granted the Radetzky-Orden's application. The BKFR appealed against that decision to the Oberster Patent- und Markensenat. It had been in those circumstances that the Oberster Patent- und Markensenat decided to stay proceedings and to refer the following question to the European Court for a Preliminary Ruling:

*"Is Article 12(1) of [the TMD] to be construed as meaning that a trade mark is put to (genuine) use to distinguish goods and services of one undertaking from those of other undertakings in the case where a non-profit-making association uses the trade mark in announcements for events, on business papers and on advertising material and that trade mark is used by the association's members when collecting and distributing donations inasmuch as those members wear badges featuring that trade mark?"*

The ECJ (Grand Chamber, composed of V. Skouris, President, P. Jann, C.W.A. Timmermans, A. Rosas, K. Lenaerts; M. Ilešič, rapporteur; A. Ó Caoimh, G. Arestis, A. Borg Barthet, J. Malenovský, U. Löhmus, E. Levits; L. Bay Larsen) gave the following answer:

*"Article 12(1) of First Council Directive 89/104/EEC is to be construed as meaning that a trade mark is put to genuine use where a non-profit-making association uses the trade mark, in its relations with the public, in announcements of forthcoming events, on business papers and on advertising material and where the association's members wear badges featuring that trade mark when collecting and distributing donations."*

**Intel/CPM** : C-252/07 – Judgment of 27 November 2008 .

Keywords: First Council Directive 89/104/EEC ('TMD') Article 4(4)(a): TM with reputation – Reputation mark: risk of dilution.

This Reference for a Preliminary Ruling concerned the interpretation of Article 4(4)(a) of First Council Directive 89/104/EEC. It had been submitted by the Court of Appeal (UK) in proceedings in which Intel Corporation Inc. is applying for a declaration of invalidity against the registration of the mark "INTELMARK" owned by CPM United Kingdom Ltd. Intel

Corporation is, *inter alia*, the proprietor of the national word mark "INTEL", registered in the UK. The goods and services in respect of which those marks were registered are, essentially, computers and computer-linked goods and services in Classes 9, 16, 38 and 42. According to the Order for the Reference, the INTEL mark has a huge reputation in the UK for microprocessor products (chips and peripherals) and multimedia and business software.

CPM United Kingdom Ltd is the proprietor of the national word mark "INTELMARK", registered in the UK with effect from 31.1.1997 for 'marketing and telemarketing services' in Class 35. On 31 October 2003 Intel Corporation filed at the UK Trade Mark Registry an application for a declaration of invalidity against the registration of the INTELMARK trade mark on the basis of section 47(2) of the UK Trade Marks Act, claiming that the use of that mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier INTEL trade mark within the meaning of section 5(3) of that act. Its application had been dismissed by decision of the Hearing Officer of 1.2.2006. The appeal brought by Intel Corporation to the High Court had been dismissed on 26.7.2006.

Intel then appealed to the Court of Appeal before which it argued that both Article 4(4)(a) and Article 5(2) TMD seek to protect a proprietor of a trade mark with a reputation against the risk of dilution. Relying on the judgment in Adidas-Salomon and Adidas Benelux, it considers that, in order to enjoy the protection conferred by Article 4(4)(a) TMD, it is sufficient that the degree of similarity between the earlier mark with a reputation and the later mark has the effect that the relevant section of the public establishes a link between those two marks. A 'link' means any kind of mental association between those two marks, so a mere bringing to mind of the earlier mark is enough. Furthermore, relying on paragraph 30 of the judgment in General Motors, Intel submits that, where the earlier mark both is unique and has a strong distinctive character, it must be accepted that detriment to it will be caused by virtually any use for any other goods or services. It adds that, where the earlier mark is unique and well known, it is important to stop any encroachment at the outset, otherwise that mark will suffer a 'death by a thousand cuts'.

The national court stated, first, that 'Intel' is an invented word with no meaning or significance beyond the products which it identifies, that the INTEL mark is unique in the sense that the word of which it consists has not been used by anyone for any goods or services other than those marketed by Intel Corporation and, finally, that that mark has a huge reputation in the United Kingdom for computers and computer-linked products. Secondly, the national court considered that the INTEL and INTELMARK trade marks are similar, but started from the premiss that the use of INTELMARK does not suggest a trade connection with Intel Corporation.

Thirdly, the national court stated that the goods – essentially, computers and computer-linked products – and services for which Intel Corporation's national and Community marks consisting of or including the word 'Intel' were registered are dissimilar to the services covered by the registration of the INTELMARK trade mark. It is uncertain whether, in such factual circumstances, the proprietor of the earlier mark with a reputation is entitled to the protection provided for in Article 4(4)(a) TMD. More generally, it raises the question of the



conditions and scope of that protection. Accordingly, the referring court decided to stay the proceedings and to refer the following questions to the ECJ for a preliminary ruling:

“(1) For the purposes of Article 4(4)(a) of the [TMD], where:

(a) the earlier mark has a huge reputation for certain specific types of goods or services,

(b) those goods or services are dissimilar or dissimilar to a substantial degree to the goods or services of the later mark,

(c) the earlier mark is unique in respect of any goods or services,

(d) the earlier mark would be brought to mind by the average consumer when he or she encounters the later mark used for the services of the later mark,

are those facts sufficient in themselves to establish (i) “a link” within the meaning of paragraphs 29 and 30 of [Adidas-Salomon and Adidas Benelux], and/or (ii) unfair advantage and/or detriment within the meaning of that Article?

(2) If no, what factors is the national court to take into account in deciding whether such is sufficient? Specifically, in the global appreciation to determine whether there is a “link”, what significance is to be attached to the goods or services in the specification of the later mark?

(3) In the context of Article 4(4)(a) [TMD], what is required in order to satisfy the condition of detriment to distinctive character? Specifically, (i) does the earlier mark have to be unique, (ii) is a first conflicting use sufficient to establish detriment to distinctive character and (iii) does the element of detriment to distinctive character of the earlier mark require an effect on the economic behaviour of the consumer?”

The 1st Chamber of the ECJ (Jann; Ilesic, rapporteur; Tizzano; Borg Barthet; Levits) gave the following answer:

“1. Article 4(4)(a) of Directive 89/104/EEC must be interpreted as meaning that whether there is a link, within the meaning of Case C-408/01 Adidas-Salomon and Adidas Benelux, between the earlier mark with a reputation and the later mark must be assessed globally, taking into account all factors relevant to the circumstances of the case.

2. The fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link, within the meaning of Adidas-Salomon and Adidas Benelux, between the conflicting marks.

3. The fact that:

– the earlier mark has a huge reputation for certain specific types of goods or services, and

– those goods or services and the goods or services for which the later mark is registered are dissimilar or dissimilar to a substantial degree, and

– the earlier mark is unique in respect of any goods or services,

does not necessarily imply that there is a link, within the meaning of Adidas-Salomon and Adidas Benelux, between the conflicting marks.

4. Article 4(4)(a) of Directive 89/104 must be interpreted as meaning that whether a use of the later mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark, must be assessed globally, taking into account all factors relevant to the circumstances of the case.

5. The fact that:

– the earlier mark has a huge reputation for certain specific types of goods or services, and

– those goods or services and the goods or services for which the later mark is registered are dissimilar or dissimilar to a substantial degree, and

– the earlier mark is unique in respect of any goods or services, and

– for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark to mind,

is not sufficient to establish that the use of the later mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark, within the meaning of Article 4(4)(a) of Directive 89/104.

6. Article 4(4)(a) of Directive 89/104 must be interpreted as meaning that:

– the use of the later mark may be detrimental to the distinctive character of the earlier mark with a reputation even if that mark is not unique;

– a first use of the later mark may suffice to be detrimental to the distinctive character of the earlier mark;

– Proof that the use of the later mark is or would be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future.”



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

None

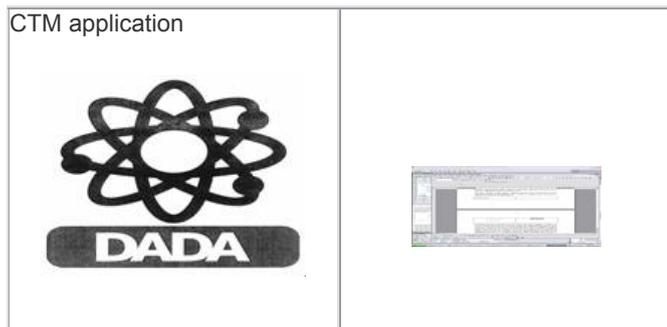
## C:CFI Court of First Instance (CFI): Judgments and Orders on appeals against decisions of OHIM, Article 63 CTMR

### C-1: CFI Judgments and Orders

**Dada** : T-101/07 – Judgment of 10 December 2008 (only in IT, FR; action dismissed, Office practice confirmed).

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

The case had been directed against a decision of the 1st Board of 12.1.2007 in Case R 1342/2005-1 relating to CTM application “DADA” (figurative mark) which had been applied for for a range of services in Class 42, mostly relating to the IT business.



It had been opposed on the basis of an earlier right in “DADA”, word mark, registered for goods and services in Classes 33, 37, 38 and 42. The opposition had been allowed, and the 7th Chamber of the CFI (Forwood; Moavero Milanesi, rapporteur; Truchot) confirmed these findings, relying on standard criteria.

**Metronia** : T-290/07 – Judgment of 10 December 2008 (action allowed; law of the case).

Keywords: CFI proceedings: costs – Opposition: likelihood of confusion (LOC) – LOC: comparison of signs.

The action had been directed against a decision of the 2nd Board of 29.5.2007 in Case R 1315/2006-2 relating to CTM application “METRONIA” (figurative mark) which had been applied for for a range of goods and services in Classes 9, 20, 28 and 41.



It had been challenged on the basis of an earlier German right in “METRO”, reproduced above, which is registered for a range of goods and services in Classes 9, 20, 28 and 41. Whereas the Opposition Division had allowed the opposition, the Board had rejected it on the ground that the marks are dissimilar. The 8th Chamber of the CFI (Martins Ribeiro, rapporteur; Papisavvas; Dittrich) confirmed the findings of the Opposition Division and revoked the Board’s decision.

**Cellutrim** : T-169/07 – Order of 2 December 2008 (action *a limine* dismissed; Office practice confirmed).

Keywords: CFI proceedings: authorisation of counsel – Opposition/invalidation: likelihood of confusion (LOC).

The action had been directed against a decision of the 1st Board of 7.3.2007 in Case R 1123/2006-1 relating to CTM No 3 979 036, “CELLUTRIM”, word mark, which had been registered in Classes 3, 5 and 35. It had been partially challenged by way of a request for invalidation based on the earlier German mark “CELLIDRIN”, word mark, registered in Class 5. The invalidation request had been successful in respect of all goods in Class 5 in the CTM concerned. The 8th Chamber of the CFI ( Martin s Ribeiro; Papisavvas; Dittrich, rapporteur) confirmed the findings in issue. Before the CFI, the Office had challenged a sub-authorisation issued by the initial attorney; the CFI subsequently accepted documents filed pending proceedings.

**Visible White** : T-136/07 – Judgment of 9 December 2008 (action dismissed; Office practice confirmed).

Keywords: Procedural law: invalidity request filed by a law firm – Absolute grounds for refusal: descriptiveness, Article 7(1)(c) CTMR.

The case had been brought against the decision of the 4th Board of 15.2.2007 in Case R 0165/2005-4 relating to invalidity proceedings between CMS Hasche Sigle (initially Norton Rose Vieregge) and Colgate-Palmolive Co. On 20.4.1998, Colgate-Palmolive Co. had filed a CTM application for “VISIBLE WHITE”, word mark, covering, in Class 3, toothpaste and mouthwash. It had been registered on 3.11.1999. On 8.10.2003, the law firm Norton Rose Vieregge had applied for a declaration that that CTM is invalid, claiming that it had been registered in breach of Article 7(1)(b) and (c) CTMR since it was non-distinctive and descriptive. On 10.12.2004, the Cancellation Division had dismissed the request for a declaration of invalidity on the basis that the juxtaposition of the words ‘visible’ and ‘white’ differed from the grammatically correct expressions used by the English-



speaking public to describe the results from using, or the intended purpose of, the goods in question. By its challenged decision, the 4th Board had allowed the appeal and had annulled the decision of the Cancellation Division. It had considered that the elements 'visible' and 'white' were individually descriptive, and that the combination of the two words was also descriptive in that it would be understood as a descriptive reference to the desirable result of using the toothpaste or mouthwash. The fact that a law firm had filed the invalidation request had not been put in issue at any stage in the proceedings; i. e. that formal question apparently is settled. The 6th Chamber of the CFI (Meij; Vadapalas, rapporteur; Labucka) confirmed the findings, relying on standard criteria.

**Sky/Skyrock** : T-66/06 – Case closed; Order of 2 December 2008 .

Keywords: General legal principles: impact of a delimitation agreement and *pactum de non petendo* – Opposition: likelihood of confusion (LOC).

The action had been brought against a decision of the 1st Board of 27.11.2007 in Case R 1167/2006-1 relating to CTM application "SKY", stylised, for a range of goods and services in Classes 9, 16, 18, 25, 28, 35, 38, 41 and 42.



It had been opposed on the basis of CTM "SKYROCK", word mark, registered in Classes 9, 38 and 41, a French right in the word 'SKYROCK', registered in respect of goods and services in Classes 9, 16, 18, 25, 28, 35, 38, 41, 42, French trade mark "SKYROCK", registered in respect of services in Classes 35, 38 and 42, and well-known trade mark "SKYROCK" in France, in respect of goods and services in Classes 9, 35, 38 and 41. In defense, the CTM applicant had argued, *inter alia*, that the opposition should be rejected because the parties to the proceedings were bound by a co-existence agreement dated 3 November 1988 , according to which the other party was precluded from opposing the registration of the sign applied for.

The Opposition Division had partially allowed the opposition, that is, for all the goods and services in Classes 9, 38 and 41, as well as for the services of 'advertising' in Class 35. As to the binding effect of the agreement, the Opposition Division had held that, regardless of its validity *inter partes*, it could not override Articles 8 and 42 CTMR which conferred on the other party the unrestricted right to oppose the CTM application. Accordingly, the question whether or not the filing of the opposition constituted a breach of contractual obligations was a private matter exclusively falling within the competence of the courts, over which the Office had no jurisdiction whatsoever. On subsequent appeal, the Board had rejected

the opposition in its entirety on the grounds that the differences between the signs were sufficient to eliminate all likelihood of confusion and/or detriment within the meaning of Article 8(1)(b) and (5) CTMR and ordered the other party to bear the costs. With regard to the agreement, the Board had found that its terms did not extend to the sign applied for, being confined to the trade marks expressly mentioned therein, namely "SKYROCK", "SKYZIN" and "SKY CHANNEL". Accordingly, the Board had held that it was not necessary to consider whether the agreement was binding, or whether it could be invoked by the applicant as a valid defense in opposition proceedings. Since the opponent (plaintiff) wished to discontinue proceedings, the case was closed.

**Fun** : T-67/07 – Judgment of 2 December 2008 (action allowed; law of the case).

Keywords: Absolute grounds for refusal: distinctiveness.

The case had been initiated against a decision of the 2nd Board of 20.12.2006 in Case R 1135/2006-2 relating to CTM application "FUN", word mark, applied by Ford Motor Co. for motor vehicles etc. in Class 12. It had been rejected. The Board had found that the relevant public was composed of average English-speaking consumers aged 18 to 70. For that public, the word 'fun' used in connection with a land motor vehicle was likely to be perceived as an indication that the vehicle had a quirky design and was particularly enjoyable to drive. Moreover, the word 'fun' was used by professionals – car dealers or leisure operators – to describe a category of vehicles (for example, quad bikes, rally carts, monster trucks) or vehicles that were simply 'fun to drive'. The Board had stated that the word 'fun' was a rather banal and basic English word and that there was therefore a clear public interest in keeping it available for other traders and competitors. As regards parts and accessories, the Board had stated that the word 'fun' could be perceived as identifying parts and fittings for 'fun vehicles' and that some parts or some accessories could themselves also be 'fun'. Therefore, the mark 'FUN' had to be considered to be descriptive within the meaning of Article 7(1)(c) CTMR and, for that reason, as not having distinctive character within the meaning of Article 7(1)(b) of that regulation.

The 1st Chamber of the CFI (Tiili; Dehousse; Wiszniewska-Bialecka, rapporteur) took a different view.

"(29) As the Board found, and the parties did not dispute, the English word 'fun' means 'amusement' and 'source of amusement'.

(30) However, the applicant submits that, in actual fact, the Board of Appeal relied on two other meanings, 'the car has a quirky design' and 'the car is particularly enjoyable to drive', which go well beyond the meaning of the mark for which registration has been requested.

(31) In this respect, the contested decision shows that the Board found that, used in connection with a land motor vehicle, the word 'fun' would be perceived by the relevant public as an indication that the car had a quirky design or was



enjoyable to drive. Contrary to what the applicant claims, the Board did not give another meaning to the word 'fun', but showed how the relevant consumer would understand that word used in connection with the goods covered by the application for registration.

(32) However, according to the case-law, to come within the scope of Article 7(1)(c) CTMR, a word mark must serve to designate in a specific, precise and objective manner the essential characteristics of the goods and services at issue (see, to that effect, Case T-334/03 Deutsche Post EURO EXPRESS v OHIM (EUROPREMIUM) [2005] ECR II-65, para 41 and the case-law cited).

(33) The fact that an undertaking wishes to give its goods a positive image, indirectly and in an abstract manner, yet without directly and immediately informing the consumer of one of the qualities or specific characteristics of the goods, is a case of evocation and not designation for the purposes of Article 7(1)(c) CTMR (see, to that effect, Case T-24/00 Sunrider v OHIM (VITALITE) [2001] ECR II-449, para 24; Case T-360/00 Dart Industries v OHIM (UltraPlus) [2002] ECR II-3867, paragraph 27; and EUROPREMIUM, para 32 above, paragraph 37).

(34) In connection with land motor vehicles, the sign 'FUN' may be understood as indicating that they can be amusing or that they can be a source of amusement. The sign 'FUN' can thus be viewed as giving the goods a positive image, like an image for promotional purposes, by giving the relevant consumer the idea that a car can be a source of amusement. None the less, although, in some cases, a land motor vehicle can be a source of amusement for its driver, the sign 'FUN' does not go beyond suggestion.

(35) Accordingly, it must be held that the link between the word 'fun', on the one hand, and land motor vehicles, on the other hand, is too vague, uncertain and subjective to confer descriptive character on that word in relation to those goods.

(36) Unlike some indications that are descriptive of the characteristics of a vehicle, such as 'turbo', 'ABS' or '4x4', the sign 'FUN' on the back of a vehicle cannot serve to designate directly a land motor vehicle or one of its essential characteristics. If the sign is placed in that position, the relevant consumer will perceive it as designating the commercial origin of the goods."

**Barbara Becker** : T-212/07 – Judgment of 2 December 2008 (action allowed; law of the case).

Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of marks – Relevant public: perception of names in the EU – Comparison of marks: personal names – Comparison of names: celebrity issue.

The case had been brought against a decision of the 1st Board of 7.3.2007 in Case R 0502/2006-1 relating to opposition proceedings between Harman International Industries, Inc. and Barbara Becker. The latter had filed a CTM application for registration of "Barbara Becker", word mark, for a range of goods in Class 9, namely 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 by Harman International Industries, Inc., pursuant to Article 8(1)(b) and (5) CTMR based on CTM "BECKER ONLINE PRO", word mark, and on CTM application "BECKER", word mark, No 1 944 578 (registered pending proceedings on 17 September 2004). The goods covered by the earlier trade marks are in Class 9 and have the following description: electric and electronic apparatus and instruments; apparatus for recording, transmission or reproduction of sound and/or images; magnetic data-carriers; recording discs; data processing equipment; teaching and instructional equipment; computers; computer software; computer hardware; computer peripherals; apparatus and instruments, all for recording, producing, transmitting, editing or processing audio and/or video signals; audio processing apparatus; high fidelity sound and video equipment; loudspeakers, transducers, radios, navigation systems and telematics; in-car audio apparatus and instruments; in-car radios incorporating telephone, navigation systems, telematics (electronic link between motor vehicle and satellite), CD players, MP3 players and/or Internet access; signal processing equipment; digital signal processing equipment; digital voice signal processors; sound processors, amplifiers, pre-amplifiers, power-amplifiers, receivers, audio video receivers; tuners; home cinema processors, DVD players, compact disc players, compact disc and DVD transports, optical disc players and transports; MP3 players; remote controls, sub woofers, microphones, headphones, integrated sound systems, televisions, video monitors, home theatre systems; audio mixing consoles; audio compressors and processors; equalisers; telephones; parts and fittings for all the aforesaid goods; none of the aforesaid goods being cables or parts and fittings for cables.

The Opposition Division had upheld the opposition on the ground that there was LOC because the goods covered by the marks were identical and the marks were similar overall, in that they had an average degree of visual and phonetic similarity and were identical at a conceptual level insofar as they refer to the same surname. In contrast, the Board had dismissed the opposition. As regards the signs at issue, the Board had taken into account for reasons of procedural economy, the earlier word mark BECKER, and had found that the signs at issue were visually and phonetically similar only to some extent, given that the first name Barbara is placed at the start of the trade mark applied for. Conceptually, the Board had considered that the signs at issue were clearly distinct in Germany and the other countries of the European Union. The Board, in that regard, had considered that the surname Becker was not the dominant and distinctive element of the trade mark applied for, on account of the fact that the relevant public would perceive the mark in its entirety, that is to say Barbara Becker, rather than as a combination of 'Barbara' and 'Becker'. It had also noted that Barbara Becker was a celebrity in Germany while the name Becker was generally recognised as an ordinary and widespread surname. Therefore, the Board had concluded that the





The earlier rights are registered for a range of goods in Class 29. Notwithstanding identity or close similarity of the goods at issue, the opposition had been rejected on the ground of clear dissimilarity of the marks. The 2nd Chamber of the CFI (Pelikánová, rapporteur; Jürimäe; Soldevila Frago) agreed, relying on standard criteria and case-law.

**New Look** : T-435/07 – Judgment of 26 November 2008 (action dismissed, Office practice confirmed).

Keywords: Absolute grounds for refusal: distinctiveness.

The case had been initiated against a decision of the 2nd Board of 3.9.2007 in Case R 0670/2007-2 relating to CTM application "NEW LOOK", word mark, which had been applied for in Class 3 for cosmetics and toiletries; soaps; perfumes, essential oils, shampoos and conditioners for the care of the hair; deodorants and dentifrices, in Class 9 for sunglasses, lenses and frames for sunglasses; in Class 14 for jewellery; articles of precious metal or coated therewith; bracelets, necklaces, brooches, rings and earrings; watches and clocks; watch straps; watch bracelets and watch chains; parts, fittings and accessories for the aforesaid goods; in Class 16 for paper, cardboard and goods made from these materials, not included in other classes; printed matter and printed publications namely in-store magazines and mail order catalogues for clothing articles; in Class 18 for articles made of leather or imitation leather; bags; handbags; rucksacks, shoulder bags, beach bags, athletic bags, tote bags, carry on luggage; clutch bags, travelling bags, wallets, purses, cheque book covers, briefcases, hip pouches, articles of luggage, parasols, umbrellas, canes and belts, in Class 25 for articles of clothing, footwear and headgear; in Class 26 for wigs, false hair, and in Class 35 for 'The bringing together for the benefit of others of ranges of clothing, footwear, headgear, fashion accessories and lifestyle items in a retail environment, so that others can conveniently view and purchase such goods'.

It had been rejected under Article 7(1)(b) and (c) CTMR, and the 8th Chamber of the CFI confirmed these findings, relying on standard criteria (Martins Ribeiro; Papasavvas, rapporteur; Wahl).

**Anew Alternative** : T-184/07 – Judgment of 26 November 2008 (action dismissed; Office practice confirmed).

Keywords: OHIM proceedings: impact of the Office's internal guidelines – Absolute grounds for refusal: distinctiveness.

The action had been brought against a decision of the 2nd Board of 22.3.2007 in Case R 1471/2006-2 concerning CTM application "ANEW ALTERNATIVE", word mark, which had been applied for for a range of cosmetics in Class 3. The application had been rejected on the grounds of lack of distinctive character notwithstanding the applicant's assertions as to holding a 'family' of ANEW marks at national level. The applicant had sought to rely on the OHIM's guidelines which, according to the applicant's view, contain a principle that phonetical identity with non-protectable words should not override visual differences. The 2nd Chamber of

the CFI (Pelikánová, rapporteur; Jürimäe; Soldevila Frago) confirmed rejection of the application.

"(22) Further, it must be observed that registration of a trade mark which consists of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by that mark is not excluded as such by virtue of such use. A sign which fulfils functions other than that of a trade mark in the traditional sense of the term is distinctive for the purposes of Article 7(1)(b) CTMR, however, only if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin (Case T-320/03 Citicorp v OHIM (LIVE RICHLI) [2005] ECR II-3411, paragraph 66).

(23) Since, in this case, the goods covered by the mark applied for are everyday consumer items and the existence of the absolute ground for refusal referred to in this case was raised only with respect to one of the languages spoken in the Community, namely English, the distinctive character of the mark applied for must be determined by reference to the perception of the average English-speaking consumer.

(24) It must also be observed that the goods covered by the mark applied for are sold in supermarkets, where visual communication takes precedence over oral communication, as well as in specialist shops, where the importance of those two means of communication is generally comparable, and by way of doorstep-selling, where the oral aspect is predominant. Consequently, the mark applied for will be used both in writing and orally.

(25) Next, contrary to the applicant's assertions, the rule laid down in the judgments in Koninklijke KPN Nederland and Campina Melkunie, that the registrability of a word mark which is intended to be heard as much as to be read is to be assessed as regards both the aural and the visual impression produced by it, is applicable by analogy to the present case. First, since that rule is generally concerned with the manner in which a word mark is perceived by the relevant public, its applicability is not limited to the absolute ground for refusal concerning the descriptive character of the sign at issue. Second, it also does not follow from the judgments cited above that the rule at issue merely refers to marks which produce the same impression visually and phonetically. In those circumstances, it must be held that, in order to avoid the application of the absolute ground for refusal laid down in Article 7(1)(b) CTMR, the mark applied for must have a distinctive character as regards both the aural and the visual impression which it produces (see, by way of analogy, Koninklijke KPN Nederland, paragraph 99, and Campina Melkunie, paragraph 40).

(26) As the Board stated, in paragraph 13 of the contested decision, the perception, on the phonetic level, by the relevant consumer of the mark applied for is the same as his perception of the sign 'a new alternative', since the combination of the elements 'a' and 'new' in 'anew' is not normally perceptible aurally, contrary to the applicant's assertions. In those circumstances, the relevant consumer will attribute a specific conceptual content to the mark applied, namely 'a new alternative' and thus will not interpret it as



'anew alternative', a construction devoid of meaning. The sign 'a new alternative' will be perceived from the outset as an advertising slogan indicating to the consumer that the product or service concerned offers an alternative to the existing goods or services, and not as an indication of its commercial origin. Consequently, in accordance with the case-law set out in paragraph 22 above, the mark applied for is devoid of distinctive character and its registration is for that reason impermissible on the ground for absolute refusal laid down in Article 7(1)(b) CTMR."

**Freshhh** : T-147/06 – Judgment of 26 November 2008 (only in DE, FR; action dismissed, Office practice confirmed).

Keywords: Types of signs: misspellings of descriptive words – Absolute grounds for refusal: descriptiveness.

The case had been initiated against a decision of the 4th Board of 7.3.2006 in Case R 0352/2005-4 relating to CTM application "FRESHHH", applied for for a range of goods in Classes 29, 30 and 32. It had been rejected on the ground that the descriptive character of the sign for foodstuff and beverages would be clearly recognizable. In its brief decision, the 2nd Chamber of the CFI agreed, relying on standard criteria (Pelikánová, rapporteur; Jürimäe; Soldevila Frago).

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

**Kiowa/Cohiba** : T-207/08 – Office response filed (ES).

Keywords: Opposition: likelihood of confusion (LOC) – LOC: attentiveness of the public in relation to tobacco products – LOC: comparison of marks.

The case is directed against a decision of the 2nd Board of 31.3.2008 in Case R 1189/2007-2 relating to CTM application No 3 963 931, "KIOWA" (figurative mark). It had been applied for for a range of tobacco products in Class 34.



It had been opposed on the basis of two earlier rights in "COHIBA" (figurative mark) registered in the name of Habanos S.A. Cuba for goods in Class 34. The opposition had been rejected on the ground that the marks are dissimilar, given the fact, inter alia, that in the sector of tobacco the public pays higher attention.

**Wiener Werkstätte-I** : T-230/08 – Office response filed (DE).

Keywords: Absolute grounds for refusal: descriptiveness – Descriptiveness in part of the EU: Article 7(2) CTMR.

The action is directed against a decision of the 4th Board of 10.4.2008 in Case R 1573/2006-4 relating to CTM application No 4 133 501, word mark "WIENER WERKSTÄTTE", which had been applied for for a range of goods in Classes 6, 11, 14, 16, 20, 21 and 34. It had been rejected on the ground that the sign would merely refer to the name of a group of artists and designers which had worked under that name in the first half of the 20 th century, i. e. that the sign would merely convey that the goods offered resemble the style of those artists.

**Wiener Werkstätte-II** : T-231/08 – Office response filed (DE).

Same situation as in case I above. The challenged Board decision is of 10.4.2008, Case R 1571/2006-4, and the CTM application number is 4 207 783. The goods claimed relate to jewelry in Class 14.

**Citracal** : T-277/08 – Office response filed.

Keywords: Opposition: likelihood of confusion (LOC).

The action has been initiated against a decision of the 4th Board of 5.5.2008 in Case R 0459/2007-4, relating to CTM No 1 757 855, "CITRACAL", word mark. The CTM application had been filed in respect of 'dietary supplements; including dietary supplements inclusive of calcium salt', in Class 5. On 1.10.2007, the above CTM application had been assigned to Bayer Healthcare LLC (the plaintiff). On 17.7.2008, the transfer had been recorded in the CTM register. On 26.6.2001, Laboratorios Diviser-Aquilea, S.L., the predecessor in title of Laboratorios ERN, S.A. (the other party) had filed a notice of opposition based on earlier Spanish trade mark "CICATRAL", word mark, which is registered in respect of 'chemical products and specialities' and 'pharmaceutical products and specialities of all types', in Classes 1 and 5. Proof of use had been requested and the respective material had been accepted following a request for restitutio in integrum. The opposition had been allowed.



**Executive Edition** : T-310/08 – Office response filed (DE).

Keywords: Absolute grounds for refusal: distinctiveness.

The case has been brought against a decision of the 1st Board of 5.6.2008 in R 0845/2007-1 relating to CTM application No 4 908 182, “Executive Edition”, word mark. It had been applied for for a range of goods in Classes 7, 9 and 11, and had been rejected as being a laudatory advertising phrase, i. e. on the ground of lack of distinctive character.

**Natur-Aktien-Index** : T-285/08 – Office response filed (DE).

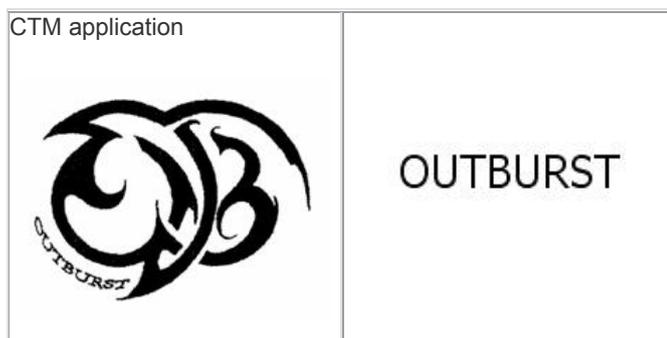
Keywords: Absolute grounds for refusal: distinctiveness/descriptiveness.

The action is directed against a decision of the 4th Board of 26.5.2008 in Case R 0525/2007-4 relating to CTM application No 4 861 175, “Natur-Aktien-Index”, word mark. It had been applied for in Class 16 for printed matter, and in Classes 36 and 42 for a wide range of financial, investment and other services. It had been rejected pursuant to Article 7(1)(b) CTMR on the ground that the sign would directly relate to the goods and services in that it would convey the meaning of services in relation to ecological and environment-friendly investment, and shares of companies involved therein.

**Outburst** : T-214/08 – Office response filed.

Keywords: Opposition: proof of use (POU).

The action is directed against a decision of the 2nd Board of 13.3.2008 in Case R 1261/2007-2, relating to CTM application No 4 318 333 for the figurative sign “Outburst”. The application had been filed in respect of goods in Classes 16, 18 and 25.



It had been partially opposed on the basis of an earlier German right in “OUTBURST”, word mark, registered in respect of clothing, footwear and headgear in Class 25. The opposition had been rejected on the ground that the opponent had failed to show genuine use.

**Polar Ice** : T-256/08 – Office response filed.

Keywords: Opposition: likelihood of confusion (LOC).

The action has been brought against a decision of the 2nd Board of 15.4.2008 in Case R 0845/2006-2 relating to CTM application No 2 558 575 for the word mark “POLAR ICE”. It had been applied for for a range of goods in Classes 3, 5 and 30: confectionery, namely chewing gum for cosmetic purposes; confectionery, namely chewing gum for medical purposes and for confectionery, namely chewing gum for non-medical purposes. It had been opposed on the basis of several earlier rights in “POLAR IS”, registered for a range of goods in Class 30, namely edible ices, confectionery, including frozen confectionery; desserts (not included in other classes); cakes and pastries, including frozen cakes and pastries; puddings and mousses and salad dressings. The opposition had been allowed in full.

**Zydus-II or Zydus/Zimbus**: T-288/08 – Office response filed.

Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of signs – Comparison of signs: impact of phonetic similarity.

The case is an appeal from a decision of the 2nd Board of 7.5.2008 in Case R 1092/2007-2 concerning CTM application No 3 277 662, ZYDUS, word mark, applied for for a range of goods in Classes 3, 5 and 10 (see Zydus-I below for the list of goods). It had been opposed on the basis of earlier CTM “ZIMBUS”, word mark, which is registered in Class 5 for pharmaceutical preparations. The opposition had been lodged in respect of ‘pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use; disinfectants; fungicides’ in Class 5.

By its decision of 31.5.2007, the Opposition Division had upheld the opposition in respect of some goods (that is, ‘pharmaceutical, veterinary and sanitary preparations; fungicides’) and rejected it in respect of other goods (that is, ‘dietetic substances adapted for medical use; disinfectants’). Upon appeal by the CTM applicant, the Board had upheld the appeal in part and had annulled the opposition decision insofar as it had refused the mark applied for in respect of ‘fungicides’.

**Zydus-I or Zydus/Cibus**: T-287/08 – Office response filed.

Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of signs – Comparison of signs: impact of phonetic similarity.

The case is an appeal from a decision of the 2nd Board of 5.5.2008 in Case R 1322/2007-2 concerning CTM application No. 3 277 662, “ZYDUS”, word mark, which had been applied for in respect of the following goods in Class 3: bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices;



in 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, and in Class 10: surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles and suture materials.

It had been partially opposed (Classes 3 and 5) on the basis of two earlier Spanish rights in "CIBUS", word mark, registered in Class 3 for soaps, perfumery, essential oils, cosmetics, hair lotions; dentifrices, and in Class 5 for 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.

The opposition had been allowed, in essence, on the following grounds: The goods are either identical or highly similar. The signs are visually dissimilar but aurally similar. The signs cannot be compared conceptually as they are meaningless. In this case, the aural similarities outweigh the visual dissimilarities because the goods can be sold in response to an oral order. The fact that the relevant public for health-related goods may display a higher degree of attentiveness does not obviate LOC because whether the goods may be assigned the same origin has to be examined in the light of the imperfect recollection of the public. Consumers do not possess a 'photographic memory'; they are not able to register and record all the details of a sign. In the consumer's memory, 'CI' and 'ZY', which are pronounced identically in Spanish, will leave an identical mental trace. Thus consumers will not remember if the first syllable of CIBUS was 'CI', 'CY', 'ZY' or 'ZI'. In this instance, the only perceptible difference lies with the central consonant 'B' in CIBUS and 'D' in ZYDUS which is insufficient to render the signs sufficiently dissimilar to avoid LOC.

**TIR** : T-245/08 – Office response filed (DE).

Keywords: Revocation: formal criteria – Revocation: entitlement to file a request.

The action is directed against a decision of the 1st Board of 11.4.2008 in Case R 0708/2007-1 relating to revocation proceedings C 1414, directed against CTM No 400 804 held by an Iranian tobacco company (shown below).

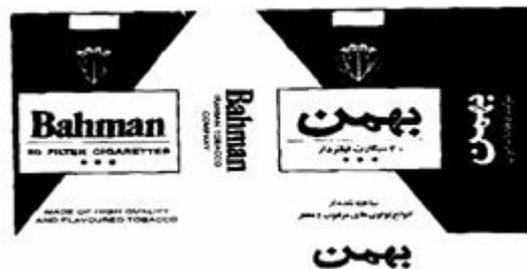


The revocation request had been brought by a Bulgarian tobacco company on 8.11.2005 and had been based on non-use. The challenged CTM had been revoked, based, as regards the formal issue of entitlement to file, on the consideration that a request for revocation can be initiated by anybody, not only by EU-domiciled persons or entities.

**Bahman** : T-223/08 – Office response filed (DE).

Keywords: Revocation: formal criteria – Revocation: entitlement to file a request.

The action is directed against a decision of the 1st Board of 10.4.2008 in Case R 0709/2007-1 relating to revocation proceedings C 1415, directed against CTM No 427 336 held by an Iranian tobacco company (shown below).



The revocation request had been brought by a Bulgarian tobacco company on 8. 11. 2005 and had been based on non-use. The challenged CTM had been revoked, based, as regards the formal issue of entitlement to file, on the consideration that a request for revocation can be initiated by anybody, not only by EU-domiciled persons or entities.

**Jose Padilla** : T-255/08 – Office response filed (ES).

Keywords: Opposition: formalities – Formalities: evidence of the invoked earlier right(s).

The case is an appeal from a decision of the 2nd Board of 1.3.2008 in R 0516/2007-2 relating to CTM application No 2 844 066, "JOSE PADILLA", word mark, which had been applied for for a range of goods and services in Classes 9, 25 and 41. It had been opposed on the basis of a Spanish application for "JOSE PADILLA", in relation to which the filing date, the file number and the Nice class, but no additional documentation, had been provided. The opponent further claimed to own a reputed brand, a notorious mark and a sign used in the course of trade. No further evidence had been provided. The opposition had been rejected on formal grounds.



**Alaska-II** : T-226/08 – Office response filed (DE).

Keywords: Absolute grounds for refusal: indication of geographical origin – Absolute grounds for refusal: deceptive sign.

The action is directed against a decision of the 4th Board of 8.4.2008 in Case R 1124/2004-4 relating to rejection of a request for a declaration of invalidity directed against CTM No 505 503, “ Alaska ”, word mark. It is registered for a range of goods in Class 32. In its proceedings No 329 C, the Cancellation Division had rejected the request on the ground that a geographical indication does not automatically make up a geographical indication of commercial origin within trade mark law. The target consumers would not assume that the non-alcoholic beverages at issue would originate from Alaska, and the Board had confirmed these findings.

**Alaska -I** : T-225/08 – Office response filed (DE).

Keywords: Absolute grounds for refusal: indication of geographical origin – Absolute grounds for refusal: deceptive sign.

The action is directed against a decision of the 4th Board of 8.4.2008 in Case R 0877/2004-4 relating to rejection of a request for a declaration of invalidity directed against CTM No 505 552, “ Alaska ” (figurative mark). It is registered for a range of goods in Class 32.



In its proceedings No 330 C, the Cancellation Division had rejected the request on the ground that a geographical indication does not automatically make up a geographical indication of commercial origin within TM law. The target consumers would not assume that the non-alcoholic beverages at issue would originate from Alaska , and the Board had confirmed these findings.

## NEW DECISIONS FROM THE BOARDS OF APPEAL

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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**

### Absolute Grounds – Article 7 CTMR

R 1033/2008-1 – Ω

### Relative Grounds – Articles 8, 43 CTMR

R 749/2007-4 – SWIFT GTi/GTI

R 0074/2008-2 – Easy CHIC (Fig. Mark)/BLOCO CHIC

### Absolute Grounds – Article 7 CTMR

*Absolute grounds – single letter – minimum degree of distinctive character*

### Decision of the First Board of Appeal of 7 January 2009 in Case R 1033/2008-1 – Ω (Figurative Mark) (French)

**R 1033/2008-1 – Ω (Fig. Mark)** - The Board noted that the trade mark is a figurative mark but obviously the upper case version of the Greek letter omega, moreover represented in a completely ordinary font. The Board had no evidence that the upper case letter omega would be understood by the Greek-speaking consumer interested in personal care products in Class 3 as the designation of the size, order number, ingredient, price or any other characteristic of those articles. Consequently, it was held that the consumer will understand it as the distinctive sign of a given manufacturer, especially when taking into consideration that the sign has been used, for a long time, for watches.

### Relative Grounds – Articles 8, 43 CTMR

*Relative grounds – likelihood of confusion – generic trade mark – weak element – dominate element – accession of new Member States*

### Decision of the Second Board of Appeal of 9 December 2008 in Case R 749/2007-4 – SWIFT GTi/GTI (English)

**R 749/2007-4 – SWIFT GTi/GTI** – The Board noted that the term 'GTI' is a well-known acronym in the car sector; even if average consumers are unaware of the precise meaning of the acronym or the precise technical characteristics it



indicates, they are unlikely to perceive it as anything more than it really is, namely a letter combination indicating certain technical characteristics of the car or its engine. Furthermore, the Board held that the term 'SWIFT', which is a synonym of 'fast' or 'quick', will not be understood as descriptive indication in Sweden.

Consequently, the more distinctive and dominant element of the mark applied for was held to be the word element 'SWIFT', which would be perceived as a fanciful term. Therefore, the Board concluded that the similarities between the signs, which are based on the common weak element 'GTI', are outweighed by the element 'SWIFT' which is placed at the beginning of the CTM applied for. It is highly unlikely that any professional in the car sector would ever confuse cars, car parts or accessories, originating from different car manufacturers, merely because they contain the acronym 'GTI', which any average professional in the car sector would immediately recognize as referring to specific technical features of the car or its engine. The average consumer's level of attention with respect to the goods at issue must be deemed to be higher than average. The Board held that the additional word element 'SWIFT', which would be perceived by the relevant public as a fanciful model name, clearly dominates the overall impression created by the mark applied for and clearly outweighs any similarity resulting from the overlap in the descriptive, or at most inherently weak, letter combination 'GTI'. Taking into account their distinctive and dominant elements of the trade marks, the Board concluded that there is no likelihood of confusion despite the identical goods.

With respect to the judgment of the ECJ in Case C-0120/04 Medion AG v Thomson multimedia Sales Germany & Austria GmbH ('Thomson Life'), the Board recalled that the test does not apply in cases where, as in the present case, the only element common to both marks has little *per se* distinctiveness and it is not established that the relevant public would attribute to the owner of the earlier mark the goods covered by the later mark on the basis of that element. Furthermore, the Board rebutted the argument of the opponent concerning its alleged series of marks, all consisting of the element 'GTI'. The Board held that the opponent has not shown that the consumer will understand the element 'GTI', allegedly used as the 'root element' of a family of marks.

Finally, the Board dismissed the opposition based on International Registrations with effect in the new Member States as inadmissible, since the CTM applied for was filed in October 2003, more than six months before the accessions of these Member States. The opposition based on a Spanish and a Portuguese International Registration was rejected as unfounded, since Spain and Portugal objected to the registration of that mark.

*Relative grounds – proof of use – belated facts and evidence*

### **Decision of the Second Board of Appeal of 15 January 2009 in Case R 0074/2008-2 – Easy CHIC (Figurative Mark)/BLOCO CHIC (English)**

**R 0074/2008-2 – Easy CHIC (Fig. Mark)/BLOCO CHIC –** The opponent submitted during the opposition proceedings, after being invited to do so, some proof of use. However, the Board held that the Opposition Division had correctly rejected the opposition since the opponent had not proven genuine use of its trade mark. Together with the statement of grounds, it submitted further evidence.

The Board considered that this evidence was admissible in accordance with the judgments in cases Case C-29/05 P *OHIM v Kaul GmbH and Bayer AG* ('Arco'), T-86/05 *K & LRuppert Stiftung & Co. Handels-KG v OHIM* ('Corpo Livre') and T-334/01 *MFE Marienfelde GmbH v OHIM* ('Hipoviton'). According to the Board, it is the main evidence which must be filed timely and which may be completed later by additional evidence. Furthermore, in accordance with the Office's Manual Concerning Oppositions, Part 6, Proof of use, and taking into account the amount of evidence provided, especially the fact that it also included evidence from outside sources, the opponent could reasonably have expected that if the evidence provided would still be found to be lacking in some respect, it would have had the chance to either discuss the possible objections or to remedy the deficiencies in the first instance proceedings. Therefore, the Board held that the stage of the proceedings at which the late submission takes place, and the circumstances surrounding it, did not argue against the evidence being taken into account.

The contested decision was annulled and the case remitted to the Opposition Division for further prosecution.