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Mapping the way to improved quality

The success of the Community trade mark and design systems has meant significant increases in the volume of registrations handled by OHIM. The Office is doing more, but it is also committed to maintaining quality standards. This year will see a new quality management system (QMS) being rolled out in all departments, and a change in emphasis on how quality issues are dealt with.

The new QMS builds upon earlier initiatives such as the introduction of the OHIM Service Charter last year, which sets concrete standards of performance on accessibility, timeliness and the quality of decisions. The performance measured against these standards is published each quarter on the website and the Charter is revised annually based on feedback from users and the results of a User Satisfaction Survey.

The success in reducing timescales has been striking, and there have also been improvements with regards to accessibility. However, the news has not been so good when it comes to other areas. Head of the service responsible for QMS implementation Andrea Di Carlo says that customers clearly want faster registrations, but they also want better quality at the various decision stages.

As a first important step, OHIM has defined the criteria that are used to define a good decision at the examination and opposition stages and has made them publicly available on the website. Checks are carried out on a weekly basis to verify the compliance of the decisions with those criteria and results are published as part of the Service Charter on a quarterly basis.

Says Di Carlo: "In 2008, the achievement of our standards of quality of decisions will be unquestionably one of OHIM's top priorities. We are confident that a transparent approach, which has proved to be useful for decreasing processing times and increasing accessibility to our services, will also help us to improve the quality of decisions. The QMS will provide the Office with a more planned and structured approach to managing quality and increase our capacity to achieve our ambitious service standards".

Based on the internationally recognised ISO 9001 standard, OHIM's QMS meticulously maps and documents each step of every process in order to ensure that it enables a consistent achievement of the established goals.

The QMS is easily accessed by all staff on the intranet and can be used as a reliable reference for new staff and existing employees, and as a tool for change management. Moreover, it facilitates the exchange of best practices and experiences with other offices. Last October, staff took part in an international benchmarking meeting held in Newport, Wales, which was attended by members from various national offices throughout Europe. The aim of this meeting was to share knowledge on how to improve both productivity and the quality of decisions.

The process has already been delivering tangible results in a number of areas. For example, in October 2006, it took on average of three months for the Office to issue a certified copy of CTM and RCD applications. Through mapping processes and re-engineering the processes, the Office is now able to deliver 90% of certified copies of applications in 14 days.

The James Nurton interview with David Musker, a partner of RGC Jenkins & Co in London

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

This month James Nurton speaks to David Musker, a partner of RGC Jenkins & Co in London, filer of the first Community design application and author of *Community Design Law – Principles and Practice*, about the Community design and recent developments that shed light on what constitutes prior art with regard to registered Community design applications.

As a patent attorney, when did you first become interested in design rights?

It was a hot topic in the UK when I entered the profession in the mid-1980s. I worked in the Ministry of Defence patent department and it was an interesting, exciting time. Copyright law had become tied up in knots following the 1986 *British Leyland v Armstrong Patents* case in the House of Lords, and legislative reform was in the air. This led to the Copyright Designs and Patents Act of 1988. With copyright protection reduced, we expected a lot more protection from designs.



How did things change with the introduction of the Community registered and unregistered design right?

That was the next step. We had our feet under the table and were comfortable with the 1988 Act when the Max Planck Institute proposed a draft Community design law. I started following it and I've been watching it since then.

It has certainly had an effect in some sectors. Design protection in the UK had got in a pretty poor state after the House of Lords had cut off protection for functional designs in *Amp v Utilux*, then they said "enough is enough" with copyright, and the 1988 Act made designs even harder to get. Designs were pretty much in decline. They had tightened up what you could register and not many people were bothering. The new law gave us an opportunity to go out to people and say: the case law has been swept away, there's a clean slate.

Now there is a greater emphasis on using designs to protect colour and packaging, and more brand-oriented sectors are thinking about design protection. There is also some interest in functional designs from engineering clients.

Are clients filing more designs now?

There is greater interest in designs from IP-savvy UK clients. Trade mark filers think about the possibility of getting design protection as well, and the cost advantages have also brought it in sight of people, for example some of our bigger Japanese clients. But I am less sure whether US applicants have changed their patterns of behaviour.

How well do you think the RCD works?

In terms of time and cost, it is pretty persuasive. We used to think in terms of years for registration of IP rights, but we're talking about weeks with Community designs. Clients like the idea that they can apply and have something within their lifetime. However, the production of certificates has resulted in difficulties. Errors are higher than expected, such as missing figures, names or classes.

How could it be improved?

Although designs are registered quickly, the certificates take a significant amount of time to arrive. Another thing is there has been fairly minimal link-up with the Hague Agreement. For Community trade marks, there is a shadow register but I don't believe they're going to do that for designs. So you have to go to two websites and consult two databases.

OHIM's database is useful with lots of ways to search and is better than WIPO's. For example, OHIM's database indexes textual elements, which is useful for trade mark proprietors. That doesn't happen in WIPO's database. We won't have that feature, which we like, if the Hague system is taken up.

Electronic filing is good, but we would prefer a B2B system rather than a web-based one. It would be better if we could export our records into it.

Do you think questions about design protection have been settled yet?

I don't think we've got anything finally clarified until the ECJ has chewed the issues around. As with the Community trade mark, anything can happen. We have clarification as to how OHIM views these issues but there is divergence in national case law.

For example, on the question of technical designs, the Dutch courts say they should be treated like trade marks following

the ECJ's *Philips* criteria. But in the UK the Court of Appeal followed the Advocate General in *Philips* and said the technical limitation bites less hard for designs. That's important for industry. Another question is about prior art availability.

On that point, how important do you think the *Green Lane v PMS* case in the UK's High Court [which concerned a dispute over whether massage balls constituted prior art that would invalidate a registered design for laundry balls] will be?

I think there are two important points addressed in this case, one direct and one indirect. The direct point is that it makes the novelty issue simple and not difficult. The question was: if the prior art's disclosed, is it only half-disclosed? Is it prior art for just one sector, or for everything?

I think the judge [Mr Justice Lewison] came up with the sensible answer: if you're disclosed, then you're prior art for everything. It is closer to the absolute novelty concept in patent law. The classic UK patent case on this was *Windsurfer*, where the invention was anticipated by a boy in Hayling harbour, as anyone could have watched him. However, some people felt that anticipation by something so obscure was unfair on the patentee.

Article 7(1) of the Community Design Regulation provides an exception for prior art that "could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community". This has some tricky issues in it: what is "reasonably", or the "normal course of business"? or the "specialised circles"? or the "sector concerned"? and how does "operating within the Community" impact on that? This case answered one of those questions. The argument followed by the judge is that as a design protects *all* products to which it's applied then the prior art logically ought to anticipate it for any product. For example, the shape of a cigarette lighter shaped like a golf ball is already known in the field of golf balls so you shouldn't subsequently be able to get protection that extends to cover them by registering that shape for a cigarette lighter. I think that's the correct and inevitable conclusion.

However, this decision seems to be directly at odds with a Dutch case – *Van den Berg Afvoerputten BV v Keizers Bouwmaterialen en Sanitair BV* – which was to do with gutters in houses versus industrial buildings. The Court here said the design was novel after following the opposite interpretation to the UK judge. But this seems like a bad decision on the facts to me.

We've got to wait for the ECJ to get its teeth into it. Lewison's point is that prior art and infringement have to be consistent. And that is the indirect point: it is good news for proprietors that Lewison has confirmed that the scope of infringement rights extends to all products.

Will that make it tougher for applicants?

In theory, but not in practice, except for "A shaped like B"-type designs. My advice to applicants is do a sensible cross-search analysis to cover other classes. If you want a plane design, look in toy planes too. But you would do that in a trade mark search too.



How do you approach classification?

You have to indicate products in the application. So you think about the level of generality or specificity. You have got to be specific enough to place it in one of the subclasses of the Locarno classification.

The indication of the product is the only part that has to be translated. If you use your own terminology, it will at least double the time for granting. Also, if you use your own term, the examiner may change that without asking you. There have been some situations where they've broadened up, such as replacing "digital keyboard" with "keyboard". I had a client who was unimpressed with this and the Board of Appeal told the examiners not to do it (Decision R1421/2006-3 Cash Registers).

The alternative is to use the terms from EuroLocarno. It's an ever-expanding database – it is better than it was before and will be better still.

I would say about 70% of what you want is in EuroLocarno, but it might vary in some industries. For example, I remember at the beginning of the system, with a design for a camcorder it wasn't clear which class it should go into – the camera class or the video recorder class. That is always going to be a problem with new products, such as MP3 players. Some things are well-classified, such as food in class 1 or clothes in class 2, but electronics for example is dotted around classes 14 and 18. So there are always going to be problems, but mainly for toys, novelty items or packaging/labelling. OHIM has sensibly put a lot into class 99 – that has logos, labelling and graphics that don't go anywhere else.

Community Trade Mark

Change in rules on national search reports for CTMs

A change in the rules covering applications for Community Trade Marks (CTMs) will make national searches - to check if the mark is identical or similar to one already registered in individual EU member states - optional from 10 March, 2008.

The new Article 39 of the CTM Regulation establishes that national search reports will be produced only on request of the applicant under an all-or-nothing principle, whereby searches will be done for a separate fee in all participating member states of the EU (17 national offices are taking part from March 2008). Community search reports and warning letters will continue to be delivered as before.

The request for national searches must be made when the application is filed. The fee to be applied is currently being reviewed and further information will be given on the OHIM website before the new system takes effect.

For trade marks with a filing date prior to 10 March 2008, the "old" system will apply, which means that Community and national searches will be carried out automatically in all cases without the obligation to pay a specific search fee. A period of three months is given to national offices to produce the search reports.

For marks filed from 10 March and onwards, the following will apply:

- A Community search report will be produced in all cases, whereas national search reports, in a harmonized format, will be prepared only on request by applicants.
- The period for producing searches given to the national offices taking part in the system is reduced from three to two months.
- A request for national searches means that all participating national offices will carry out the search, all of which must be paid for under the all-or-nothing policy. It will not be possible to select some countries for searches and leave out others.

Further details are available at:

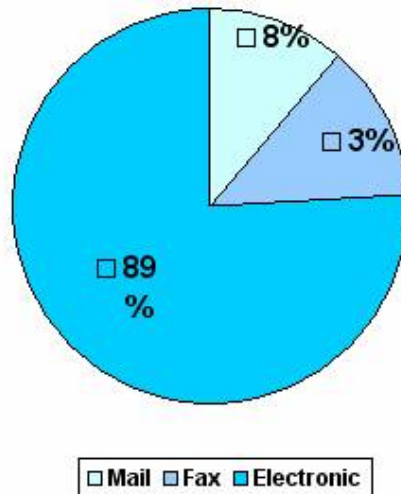
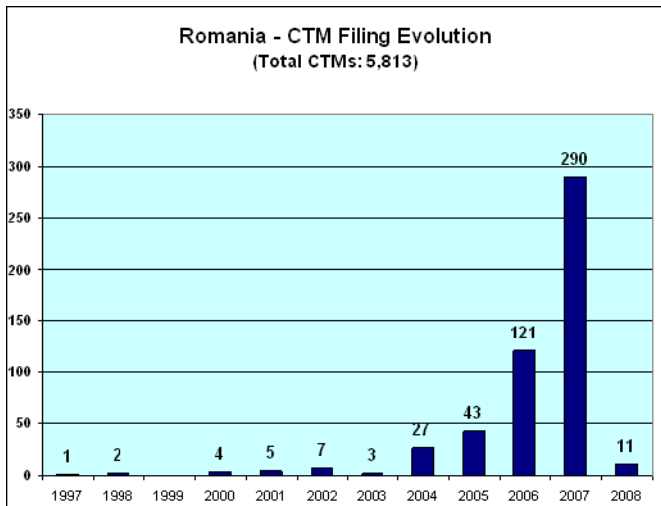
<http://oami.europa.eu/en/mark/marque/default.htm>

Country overview: Romania & the Community Trade Mark



Romania joined the EU in 2007, and has a population of 21.6m. GDP growth is higher than the EU average at 5.7% higher in the third quarter of 2007 compared with the same period in 2006. The service sector accounts for 56% of GDP, followed by industry (36%) and agriculture (8%).

The first Romanian CTM was filed in 1997, and interest in CTMs only really started to take off in the run-up to EU entry. A total of 514 Romanian CTMs have been registered – 290 of them last year. This year so far, there have been 11 Romanian CTMs.

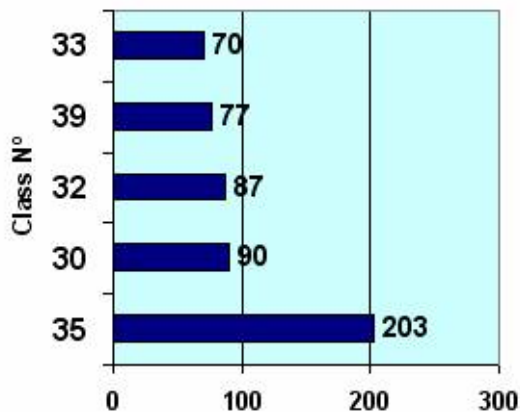


Word 39.11 % **Figurative** 60.51 % **3-D** 0.19 % **Colour** 0.00 % **Other** 0.19 %

Figurative marks are the most popular with Romanian enterprises and account for almost 61% of applications, followed by word-based marks (39%).

The most popular goods and services applied for by Romanian businesses are in classes 35, 30 and 32.

Romania - Top Classes Filed (Nice)



E-filing is the most popular route for Romanian businesses and their intermediaries. This year, including International Registrations, 76% of all CTM filings were made electronically. Fax accounted for 13% and mail for 11% of applications.

Top 10 Romania-based owners by number of CTMs filed

Company	CTMs
S.C. STANDARD SNACKS S.R.L..	54
ANTIBIOTICE SA	21
S.C.INTERMARK s.r.l.	21
SC PHOENIX SRL	8
ZAREA S.A.	8
GLOBAL SPIRITS COMPANY SRL	6
Romtelecom SA	6
S.C. BELLES MARKS CONSULTING S.R.L.	6
SC MURFATLAR ROMANIA SA	6
S.C. GALAXY TOBACCO S.A.	5

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

Representative	CTMs
Stypu ³ kowki	45
MEISSNER, BOLTE & PARTNER GbR	21
S.B.G. & K. ÜGYVEDI IRODA	19
ZIVKO MIJATOVIC & PARTNERS	17
ARIANA AGENTIE DE PROPRIETATE INDUSTRIALA SRL	16
CABINET ANI FUCIU SRL	16
INVENTA - AGENTIE DE PROPRIETATE INTELLECTUALA, SRL	16
Alecu	167
S.C. RODALL S.R.L. AGENTIE DE PROPRIETATE INDUSTRIALA	14
NOVAGRAAF BELGIUM S.A./N.V.	13



Community Design

European design policy

A new design policy for Europe is to be published by the European Commission as part of next year's proposed European Year of Creativity and Innovation. At a meeting with design industry representatives in Brussels, commission Vice-President Günter Verheugen stressed that design was a "very crucial element" for European competitiveness.

"Europe must maintain its position as the most competitive region in the world as far as design is concerned", he said.

Key actions agreed include: issuing a Commission "Communication on design" next year; reinforcing efforts to build up a knowledge base for design activity and policy; and supporting dialogue on design policy via a permanent body.

The Commission communication, a non-legislative policy document, will include guidance to EU member states on strategies to promote designs, in order to stimulate the wider adoption of design by smaller companies in particular.

Michael Thomson, president of the Bureau of European Design Associations BEDA, said after the meeting that the measures outlined by Commissioner Verheugen would "help grow and strengthen design in Europe".

Commenting on the actions planned, director of the OHIM's design department Pedro Rodinger said that initiatives would put a spotlight on a very important sector of European industry.

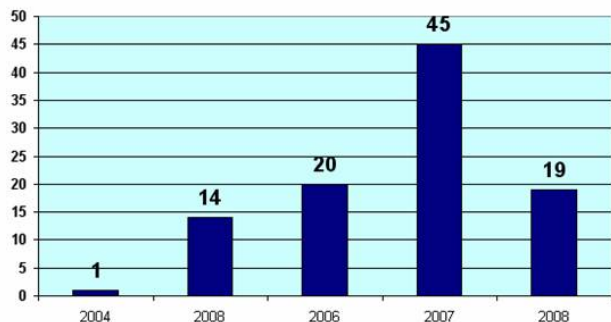
"The measures to promote the wider use of design in smaller companies, which are among the most important powerhouses of the European economy, are particularly welcome", he added.

Country overview: Romania & the Registered Community Design

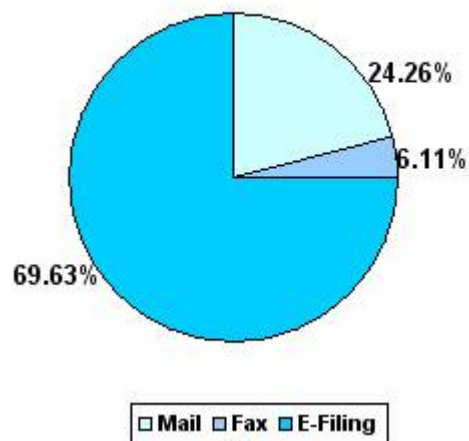
Romanian filings of RCDs started slowly in 2004, with one application and to date there have been just 99 filings in total. Last year saw 45 applications, which was more than double the number in 2006. In 2008, so far, there have been 11 applications.

The most popular classes for design owners are 28, 17, and 15. The Internet is the preferred route for most filings, accounting for just under 70% of the total. Mail, at 24%, is the second most popular route, and around 6% of applications come by fax.

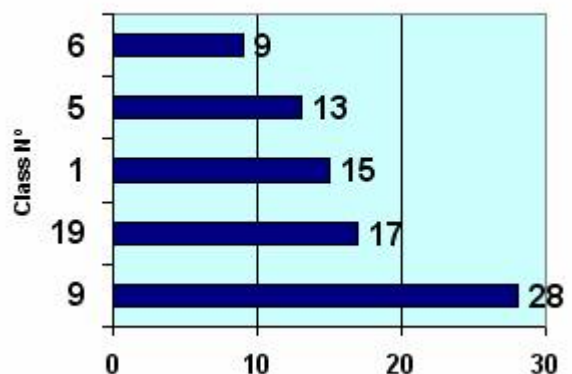
Romania - RCD Filing Evolution



Romania - Filing Preferences



Romania - Top Classes Filed (Locarno)





Top 10 Romania-based owners by number of RCDs filed

Owner	RCDs
S.C. STANDARD SNACKS S.R.L.	14
FLOKSER COMIMPEX SRL	13
SC SENSIBLU SRL	13
Moldoveanu	8
S.C.INTERMARK s.r.l.	7
S.C. ARAS S.R.L.	6
SC MOLDACOM GRUP S.R.L	5
CASCO Group Societate in Comandita Simpla (SCS)	4
S.C. CALIPRIX SRL	4
S.C. NEGRO 2000 SRL	4

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

Representative	RCDs
INVENTA - AGENTIE DE PROPRIETATE INTELECTUALA, SRL	18
HELPA Patent and Trade Mark Bureau	14
CABINET M. OPROIU	13
BRIFFA	8
BALLESTER I ASOCIADOS	6
S.B.G. & K. ÜGYVEDI IRODA	6
Alagem Modiano	5
KAILUWEIT & UHLEMANN	4
Meszarosne Dónusz	4
Puluca	4

Case-law

Latest trade mark and design news from Luxembourg

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ECJ PR Pending Cases
Radetzky: C-442/97

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El Charcutero Artesano:
T-242/06
Saw Blade: T-127/06
Suchen.de: T-117/06
Corpo Livre: T-86/05
Bial: T-10/06
Activity Media Gateway:
T-434/05
Vitalfit: T-111/05

CFI Pending Cases

Offshore Legends: T-305/07
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Secureos: T-277/07
Surfcad: T-325/07
Atoz/Artoz: T-100/06
Patentconsult: T-335/07
Monkey Puzzle: T-303/07
Faces: T-301/07
Q2Web/QWeb: T-242/07
Carport: T-351/07
Cellutrim/Cellidrin: T-169/07
Principe Alfonso: T-291/07
Coyote Ugly: T-161/07
Airshower: T-307/07
PharmaCheck: T-296/07
Arc Noir (Black Arch):
T-304/07
Torres de Anguiz/Torres
Torregazate/Torres
Intelligent Voltage Guard
Vitro/Vitral
Coco Rico

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

Map&Guide: C-512/06-P – Appeal from T-302/03; Order of 26 October 2007 (DE; appeal dismissed as partially inadmissible and partially unfounded; Office practice confirmed).

Keywords: ECJ proceedings: admissible claims – ECJ admissible claims: assessment of distinctiveness an issue of fact – Absolute grounds for refusal: distinctiveness.

The case is an appeal from a judgment of the CFI of 10.10.2006, PTV v OHIM, in Case T-302/03 ([2006] ECR II-4039) by which the CFI had confirmed rejection of CTM application “map&guide” in Classes 9, 41 and 42 on the grounds that the sign lacks distinctiveness for the goods and services at issue. The 5th Chamber of the ECJ (Tizzano; Ilesic (rapporteur); Levits) agreed.

A-2: ECJ: Developments in pending cases

Mobelix/Obelix: C-16/06-P – Appeal from T-336/03; Opinion of Advocate General Trstenjak of 29 November 2007 (proposed: dismissal of the action).

Keywords: CFI proceedings: material submitted for the first time before the CFI – CFI proceedings: assessment of LOC: principle of “reformatio in peius”? – CFI proceedings: change to the subject-matter of proceedings – Opposition proceedings: Article 74 CTMR: scope – Opposition: likelihood of confusion (LOC) – LOC: comparison of goods – LOC: comparison of marks – Comparison of marks: doctrine of “counteraction”.

The plaintiff – Les Éditions Albert René SARL – is requesting the ECJ to set aside the judgment of the CFI (Third Chamber) in Case T-336/03 Les Éditions Albert René v OHIM – Orange [2005] ECR II-4667, by which the CFI had dismissed its appeal against the decision of the 4th Board of 14.7.2003 (R 0559/2002-4) relating to opposition proceedings between the appellant and Orange A/S concerning the opposition by the plaintiff, proprietor of the earlier trade mark OBELIX, to the registration as a CTM of the sign MOBILIX. The Opposition Division had dismissed the opposition; the 4th Board had allowed the appeal in part. The plaintiff considers principally that, in the Judgment, the CFI had failed to take account of the principle of the prohibition on reformatio in peius and had mechanically applied the doctrine of “counteraction” when assessing LOC between the goods and services covered by two similar marks.

The Board had stated, first of all, that the opposition should be regarded as being based exclusively on LOC. It then had stated that it was possible to detect a certain similarity between the trade marks. In comparing the goods and services, the Board had found that ‘signalling and teaching apparatus and instruments’ in the CTM application and



'optical and teaching apparatus and instruments' in the earlier registration in Class 9 were similar. It had reached the same conclusion in respect of the Class 35 services referred to as 'business management and organisation consulting and assistance, consulting and assistance in connection with attending to business duties' in the CTM application and 'marketing and publicity' in the earlier registration. The Board had found that, given the degree of similarity between the signs in question and between these particular goods and services, there was a likelihood of confusion in the mind of the relevant public. It therefore had refused the CTM application in respect of 'signalling and teaching apparatus and instruments', and services described as 'business management and organisation consulting and assistance, consulting and assistance in connection with attending to business duties', and granted it in respect of the other goods and services.

In its Judgment, the CFI had first examined the admissibility of five documents appended to the action and produced for the first time before the CFI in order to prove that the sign OBELIX was well known. Having found that those documents had not been produced in the context of the procedure before the OHIM, the CFI, referring to Article 63 CTMR, had declared them inadmissible inasmuch as to admit them would be contrary to Article 135(4) of the Rules of Procedure of the CFI (paragraphs 15 and 16 of the Judgment under appeal). In this context, the CFI had referred to the characteristics of annulment proceedings, in which the legality of a measure before the court must be assessed on the basis of the elements of law and fact existing at the time when the measure was adopted.

The CFI had then gone on to consider the merits of the substance of the pleas. With regard to the plea of infringement of Article 74 CTMR, according to which, in the absence of a challenge by the other party to the proceedings, the Board ought to have assumed that the opponent's OBELIX mark had a reputation, the CFI had found in paragraphs 34 and 35 of the Judgment under appeal that Article 74 CTMR cannot be interpreted as meaning that the OHIM is required to accept that points put forward by one party and not challenged by the other party to the proceedings are established. In this case, neither the Opposition Division nor the Board had considered that the appellant had substantiated conclusively, on the facts or evidence adduced, the legal assessment advocated by it, namely that the unregistered sign was well known and that the registered sign was highly distinctive. Accordingly, in paragraph 36 of its Judgment, the CFI had declared that plea unfounded.

As regards comparison of signs, the CFI had found that that, at most, they are only slightly similar. Further, the CFI had held that the signs had a certain aural similarity (paragraphs 77 and 78). As regards the conceptual comparison, the CFI had found that, even if the term OBELIX had been registered as a word mark, it would readily be identified by the average member of the public with the popular character from the comic strip, which makes it extremely unlikely that there could be any confusion in the public mind between words which are more or less similar (paragraph 79 of the Judgment). Since the word sign OBELIX had, from the point of view of the relevant public, a clear and specific meaning so that the public was capable of grasping it immediately, the conceptual differences between the signs were such as to counteract the

aural similarities and any visual similarities (paragraphs 80 to 81 of the Judgment).

Before the ECJ, the plaintiff claims that the Judgment of the CFI infringed Article 63 CTMR as well as the general principles of Community administrative and procedural law in that it found, contrary to the contested decision of the Board, that the conflicting marks, OBELIX and MOBILIX, were not similar, thus ruling to the detriment of the plaintiff on a question which had not been raised in a formally correct manner, thus exceeding its jurisdiction in the review of decisions of the Boards of the OHIM in a case such as this one. Further, the plaintiff observes that the issue of the similarity of the marks in no way formed the subject-matter of the action to the CFI and ought therefore not to have formed part of the proceedings before it. Even though the question of the similarity of the marks was not raised by any party to the proceedings in accordance with the required conditions, the CFI none the less had ruled on this point to the appellant's detriment and therefore in fact disregarded the prohibition on *reformatio in peius*.

The Advocate General proposed dismissal of the action based, *inter alia*, on the following considerations:

(a) "Under the general principle of procedural law known as the prohibition on *reformatio in peius*, a higher court competent to rule on a remedy, for example an appeal, cannot vary a contested decision of a lower court to the appellant's detriment, if the appellant is the only party to have sought that remedy. Also under the principle of the prohibition on *reformatio in peius*, in general, the worst outcome of the remedy applied for by the appellant must be the dismissal of the application and the simple upholding of the contested decision. That applies in the case. The Judgment under appeal places the plaintiff in the same position as before it brought its application before the CFI. From that point of view it is difficult to see how this can be regarded as a case of *reformatio in peius*."

(b) "(In that context,) the complaint relating to the issue of whether the CFI was entitled to conclude, in paragraph 81 of its Judgment, that the conceptual differences separating the signs at issue are, in the present case, such as to counteract the aural similarities and any visual similarities noted above, must be rejected. First of all, it must be pointed out that the CFI correctly applied, in paragraphs 72 and 74 to 80, the criteria set out in the case-law. Secondly, it is also clear from paragraph 79 of the Judgment under appeal relating to the words MOBILIX and OBELIX that the CFI made certain factual findings therein and that the appellant is seeking to challenge the assessment of the facts made by the CFI and is in reality requesting that the Court substitute its own assessment of the facts for the findings of the CFI."

(c) "(Furthermore,) in the context of the annulment proceedings regarding the decision referred to the Community courts, the legality of the contested measure must be assessed on the basis of the elements of fact and of law existing at the time when the measure was adopted. The same is true of the proceedings under Article 63 CTMR. In fact it is settled case-law that an appeal under that article relates to the legality of the decisions of the Boards of the OHIM within the meaning of Article 63(3) CTMR. Indeed, whereas under Article 63(3) CTMR, the CFI 'has jurisdiction



to annul or to alter the contested decision', that paragraph must also be read in the light of the previous paragraph under which '[t]he action may be brought on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of this Regulation or of any rule of law relating to their application or misuse of power', and in the context of Articles 229 EC and 230 EC. The Court's review of the legality of a decision by a Board of Appeal must therefore be carried out with regard to the issues of law raised before the Board. It is common ground that Article 8(5) CTMR was not one of the issues of law raised before the Board."

B: European Court of Justice: Preliminary Rulings

B-1: ECJ Preliminary Rulings

Fincas Tarragona: C-328/06 – Judgment of 22 November 2007.

Keywords: Well-known marks within Article 6bis Paris Convention – Well-known mark: territorial scope – Article 4 Trade Marks Directive 89/104 – Marks with local recognition: Article 6 Directive 89/104 – Article 16 TRIPS.

The case is a reference from the Juzgado Mercantil 3 de Barcelona in an infringement action initiated by Mr. Nuno who holds Spanish trade mark Fincas Tarragona for real estate services, against Mr. Monleó Franquet, of Tarragona, a real estate agent. The latter brought a counterclaim for cancellation on the grounds that he owns an earlier right in the mark "Fincas Tarragona" since he is trading under that sign, in the said area of business, and has been since 1978. He further claimed that the sign is well known in the region of Tarragona. The referring judge had asked the ECJ whether the respective wording of Article 4 Directive 89/104 (well known "in" a Member State) would also apply to a region or a city. Advocate General Paolo Mengozzi had suggested answering in the affirmative ("also applicable in a territorially restricted manner"). The 2nd Chamber of the ECJ (Timmermanns; Bay Larsen (rapporteur); Makarczyk; Küris; Bonichot) did not agree and handed down the following Judgment:

"Article 4(2)(d) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks is to be interpreted as meaning that the earlier trade mark must be well known throughout the territory of the Member State of registration or in a substantial part of it."

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

Radetzky: C-442/97 – Office contribution filed (internal document).

Keywords: Trade Marks Directive 89/104, Article 12 (interpretation of genuine use).

On 27 September 2007, the Supreme Patent and Trade Mark Senate (Oberster Patent- und Markensenat) of Austria referred the following question to the European Court of Justice for a preliminary ruling:

"Is Article 12 of the First Council Directive 89/104/EEC of 21 December 1988 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 marks 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 referred question arises in cancellation proceedings brought against a charitable association which is the proprietor of trade marks for services in Classes 37, 41 and 45, namely: the upkeep of war memorials (Class 37); education, training, entertainment, sporting and cultural activities, organisation of military reunions (Class 41); and charitable work for the needy (Class 45). The association has founded a Radetzky Order within which orders and decorations are awarded which correspond to the trade marks described above. Members of the association wear the decorations at various events and when collecting and distributing money and donations in kind. The marks are printed on invitations, on stationary and the association's advertising material. The applicant for revocation claims that the proprietor has not used the trade marks commercially over the course of the previous five years. The question thus arises whether a trade mark used in such a manner as to safeguard the rights attached to it when it serves to identify a charity organisation in its fundraising and distribution activities.

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

Pagesjaunes.com: T-134/06 – Judgment of 13 December 2007 (action dismissed; Office practice confirmed).

Keywords: Appeal proceedings: interlocutory revision under Article 60 CTMR – Opposition: earlier trade mark right and parallel domain name – Opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 1st Board of 15.2.2006 in R 0708/2005-1 relating to CTM application "pagesjaunes.com" (word mark: in fact a domain name owned by the CTM applicant) applied for for a range of goods in Class 16, namely printed matter, newspapers, periodicals and directories. Initially, the application had been rejected but further to an appeal had subsequently been allowed following interlocutory revision pursuant to Article 60 CTMR.



CTM application



It had been opposed on the basis of an earlier Spanish trade mark right in "El Charcutero" (figurative mark, with the word 'charcutero' meaning 'butcher' in English) registered in Class 29. The opposition had been rejected on the grounds that the marks at issue are sufficiently dissimilar to exclude LOC. The 3rd Chamber of the CFI (Jaeger; Azizi; Cremona) confirmed these findings.

Saw blade: T-127/06 – Order of 5 December 2007 (action dismissed as manifestly lacking any foundation in law; Office practice confirmed).

Keywords: Absolute grounds for refusal: distinctiveness.

The action had been directed against a decision of the 2nd Board of 10.2.2006 in R 0303/2004-2 relating to CTM application 2 532 497, a figurative sign in the colour blue representing a saw blade. It had been applied for saw blades for hand-operated tools in Class 8.



The application had been rejected on the grounds that the sign is devoid of distinctive character for the goods in question. The 1st Chamber of the CFI (Cooke; Labucka; Prek) dismissed the action *limine* as manifestly unfounded.

Suchen.de: T-117/06 – Judgment of 12 December 2007 (DE, FR; action dismissed, Office practice confirmed.)

Keywords: Absolute grounds for refusal: distinctiveness.

The action had been directed against a decision of the 1st Board of 30.1.2006 in R 0287/2005-1 relating to CTM application "suchen.de" (word mark) for a range of goods and services in Classes 9, 16, 35, 36, 38 and 42, *inter alia* for telecommunications (suchen = to search, to look for). It had been rejected except for vending machines in Class 9, stationery in Class 16 and business administration in Class 35, on the grounds that the sign merely describes the functioning or intended purpose of the goods and services in question. The 2nd Chamber of the CFI (Forwood; Pelikánová; Papasavvas) confirmed these findings.

Corpo Livre: T-86/05 – Judgment of 12 December 2007 (DE, FR, ES, IT; action dismissed; Office practice confirmed).

Keywords: Opposition: proof of use (POU) and time limits – Opposition proceedings: formalities – Formalities: extension of a time limit.

The action had been directed against a decision of the 1st Board of 7.12.2004 in R 0328/2004-1 relating to an opposition case between CTM application "CORPO livre" (figurative mark, shown below), applied for a range of goods in Classes 18 and 25, and two earlier rights in the word mark Livre, registered in Class 25, namely a German trade mark and an international registration with effect in Austria, France and Italy.

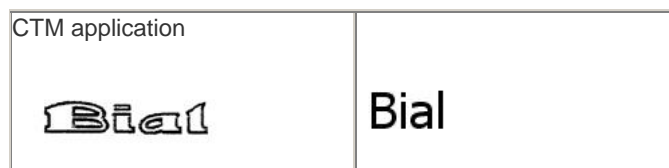


The opponent's representative - who had to show proof of use - had requested an extension on the very last day of the respective time limit which had been rejected by the Opposition Division. Notwithstanding this, material had subsequently been filed (some 10 weeks later), as had a brief protesting against the rejection of the request for an extension of the time limit. The opposition had been rejected on the grounds of lack of POU of the invoked earlier rights. The 2nd Chamber of the CFI (Meij; Pelikánová; Papasavvas) confirmed these findings.

Bial: T-10/06 – Judgment of 11 December 2007 (only in PT, FR; action partially allowed as regards apportionment of costs; law of the case).

Keywords: Opposition proceedings: costs – Opposition: likelihood of confusion (LOC) – LOC: assessment in the case of prior co-existence of the marks on the market.

The action had been directed against a decision of the 1st Board of 14.9.2005 in R 0897/2004-1 relating to CTM application 'Bial' (figurative mark) which had been applied for for a range of goods and services in Classes 3, 5 and 42.



It had been opposed on the basis of an earlier Spanish trade mark right in the word 'Bial', registered inter alia in Classes 5 and 42. The CTM applicant sought, inter alia, to rely on the fact that it had been using its business identifier Bial on the Spanish market alongside the opponent's brand. The opposition had been partially allowed. Apart from challenging the findings as to LOC, the CTM applicant also challenged the apportionment of costs. The 5th Chamber of the CFI (Vilaras; Martin s Ribeiro; Jürimäe) rejected the action as regards the findings in relation to the assessment of LOC; it allowed it in relation to the apportionment of costs.

Activy Media Gateway: T-434/05 – Judgment of 27 November 2007 (action dismissed; Office practice confirmed).

Keywords: Opposition proceedings: scope of examination – Opposition: earlier right with reputation – Opposition: likelihood of confusion (LOC) – LOC: comparison of marks – Comparison of marks: global assessment – Comparison of marks: assessment “in the light of LOC”.

The action had been directed against a decision of the 1st Board of 14.9.2005 in R 1068/2004-1 relating to CTM application **ACTIVY Media Gateway**, word mark, applied for for a range of goods and services in Classes 9, 35, 38 and 42.

CTM application	  Gateway Gateway.Net Gateway Profile Gateway Astro
ACTIVY Media Gateway	

It had been opposed on the basis of a range of earlier CTM rights and national rights in “Gateway” and combinations therewith, registered in Classes 9, 35, 36, 37 and 38. Reputation had been claimed for the UK and Ireland. By the challenged decision, the 1st Board had dismissed the appeal. It had thereby confirmed the decision of the Opposition Division by holding, in essence, first, that, given the absence of identity or similarity between the conflicting marks, there was no LOC between them under Article 8(1)(b) CTMR, whatever the reputation of the earlier marks and irrespective of the degree of identity or similarity of the goods or services concerned. Secondly, on the same grounds, the Board rejected the opposition based on the provisions of Article 8(5) CTMR. The 5th Chamber of the CFI (Vilaras; Martin s Ribeiro; Jürimäe) confirmed rejection of the opposition.

(a) Argument of the plaintiff relating to a relationship between similarity examination and LOC

“(21) Fifth and finally, the applicant submits that, as required by the seventh recital in the preamble to Regulation No 40/94, the Board of Appeal should have treated the concept of similarity in relation to the likelihood of confusion and not separately. As a result, the Board of Appeal did not give sufficient weight to the interdependence between the factors relevant to the global assessment of the likelihood of confusion. In that regard, the applicant recalls that case-law provides that the more distinctive the earlier mark, the greater the likelihood of confusion and that trade marks with a highly distinctive character enjoy greater protection than those with a less distinctive character. Equally, the Board of Appeal should have taken into consideration the fact that a high degree of similarity between the relevant goods and services may offset a lesser degree of similarity between the conflicting marks.”

(b) Assessment of similarity of marks

Findings of the court

“(35) Case-law also provides that two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects (Case T-6/01 *Matratzen Concord v OHIM – Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 30; Case T-34/04 *Plus v OHIM – Bälz and Hiller (Turkish Power)* [2005] ECR II-2401, paragraph 43; and Case T-317/03 *Volkswagen v OHIM – Nacional Motor (Variant)* [2006] ECR II-12, paragraph 46).

(36) Lastly, it is a result of the unitary character of the Community trade mark, laid down in Article 1(2) of Regulation No 40/94, that an earlier Community trade mark has identical protection in all Member States. Earlier Community trade marks may therefore be relied upon to challenge any subsequent application for a trade mark which would prejudice their protection, even if this is only in relation to the perception of consumers in part of the European Community. It follows that the principle laid down in Article 7(2) of Regulation No 40/94, which provides that it is sufficient that an absolute ground for refusal obtains in only part of the Community for a trade mark application to be refused, applies, by analogy, also in the event of a relative ground for refusal under Article 8(1)(b) of Regulation No 40/94 (*MATRATZEN*, paragraph 35 above, paragraph 59, and Joined Cases T-117/03 to T-119/03 and T-171/03 *New Look v OHIM – Naulover (NLSPOORT, NLJEANS, NLACTIONE and NLCollection)* [2004] ECR II-3471, paragraph 34; see also to that effect Case T-355/02 *Mühlens v OHIM– Zirh International (ZIRH)* [2004] ECR II-791, paragraphs 35 and 36, confirmed on appeal in Case C-206/04 *P Mühlens v OHIM* [2006] ECR I-2717).

(37) In the present case, the Board of Appeal was correct to hold that the relevant public was made up of consumers in the Community who purchase computer goods and services (paragraph 23 of the contested decision). In fact, the earlier trade marks relied on by the applicant in support of its opposition are protected on the one hand, for the most part, throughout the Community and/or, on the other, in France, Ireland or the United Kingdom. Therefore, the target public is the European consumer.”



“(48) In the present case, the Court finds that both the element ‘media gateway’ and the element ‘gateway’ in the trade mark applied for directly evoke, in the mind of the relevant consumer, the concepts of a media gateway and a gateway, which are commonly used in the computing sector. Those elements of the trade mark applied for are therefore highly descriptive of the goods and services covered by that trade mark. By contrast, since the first element of that mark, ‘activy’, is devoid of any conceptual meaning in the mind of the relevant consumer, the Board of Appeal was lawfully able to consider that it constitutes the dominant element and to conclude that there is no conceptual similarity between the conflicting signs.

(49) For the sake of completeness, even if it were possible to hold that the ‘gateway’ element, without necessarily constituting the dominant element of the trade mark applied for, holds the attention of the relevant public, it cannot be concluded that it has, as the applicant submits, an independent distinctive role. Besides the descriptive character that the word ‘gateway’ has in itself in the trade mark applied for, the applicant has yet to prove that the overall impression produced by that trade mark might lead the public to believe that the goods and services at issue derive, at the very least, from companies which are linked economically (see, to that effect, Case C-120/04 Medion [2005] ECR I-8551, paragraphs 30 and 31).

(50) Accordingly, given that the conflicting signs, following a global assessment, cannot, from the visual, phonetic and conceptual points of view, in any way be considered to be either identical or similar, the Board of Appeal rightly concluded that they were different.”

Vitalfit: T-111/06 – Judgment of 21 November 2007 (FR, DE only; action dismissed, Office practice confirmed).

Keywords: Board proceedings: formalities; invoking of decisions of national offices at the appeal stage – Opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 2nd Board of 16.2.2006 in R 0003/2005-2 relating to CTM application Vitalfit (figurative mark, see below) which had been applied for for a range of beverages in Class 32. It had been opposed on the basis of German word mark Vitafit, registered also in Class 32.



The opposition had been allowed by the Opposition Division. At the appeal stage, the CTM applicant filed two decisions of

the German office of 2003 and 2004 relating to the same conflict at the national level. The German office had denied LOC and had rejected the opposition. Notwithstanding this, the Board confirmed the decision of the Opposition Division. The 3rd Chamber of the CFI (Jaeger; Azizi; Cremona) confirmed the Board's decision, adding that the said decisions of the German Office had been subsequently revoked by the German Patent Court.

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

Offshore Legends: T-305/07 and T-306/07 – Office response filed (FR).

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

The actions are directed against two decisions of the 2nd Board of 29.5.2007 in R 1031/2006-2 and in R 1038/2006-2 relating to two CTM applications (CTMA) set out below (“Offshore Legends”; figurative marks) which had been applied for for a variety of goods and services in Classes 3, 9, 14, 18, 20, 24, 25, 28 and 35.



The said applications had been opposed on the basis of an earlier French trade mark right in “Offshore One” (figurative mark; shown below).



The invoked mark is registered for a range of goods in Classes 16, 18 and 25. The oppositions had been partially allowed.

Secureos: T-277/07 – Office response filed (DE).

Keywords: Opposition: likelihood of confusion (LOC).

The action is directed against a decision of the 1st Board of 25.4.2007 in R 1063/2006-1 relating to CTM application 2 659 944, Secureos (word mark), which had been applied for for



goods in Class 9. It had been opposed on the basis of CTM 2 126 290, Secureuro (word mark), and CTM 2 418 135, Secureuro (figurative mark), also registered in Class 9. Given the identity of the goods in question, the opposition had been allowed in full.

Surfcard: T-325/07 – Office response filed (FR).

Keywords: Absolute grounds for refusal: distinctiveness.

The action is directed against a decision of the 1st Board of 14.7.2007 in R 1130/2006-1 relating to CTM application 3 837 564, Surfcard (word mark), which had been applied for for a range of goods and services in Classes 9, 36 and 38, *inter alia* for telecommunications. It had been partially rejected under Article 7(1)(c) CTMR on the grounds that “to surf” is a standard term in the telecommunications area, in particular the internet, and, thus, the sign does no more than describe the intended purpose of the goods and services at issue.

Atoz/Artoz: T-100/06 – Office response filed.

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

The action is directed against a decision of the 2nd Board of 11.1.2006 in R 1126/2004-2 relating to CTM application 1 319 961, Atoz (word mark), for the following services relevant to these proceedings: Class 35: Drawing up of statements of accounts; auctioneering; advertising agencies; advertising; updating of advertising material; direct mail advertising; distribution of samples and updating of advertising material; dissemination of advertising; rental of advertising space; publicity material rental; book-keeping; business investigation; business management consultancy and assistance; business management and organisation consultancy; business research and business appraisals; services of inquiries, information, investigation, research, organisation consultancy and appraisals especially in the area of business; professional business consultancy, business organisation consultancy; document reproduction; commercial information agencies; computerized file management; systemization, updating, compilation, of information into computer databases; cost price analysis; employment agencies; import-export agencies; commercial or industrial management assistance; marketing; marketing studies; arrange newspaper subscriptions for others; opinion polling; organisation of trade fairs and exhibitions for commercial or advertising purposes; public relations; personnel recruitment; personal management consultancy; payroll preparation; publication of publicity texts; secretarial services; statistical information; word processing. Class 41: Exhibitions for particular purposes and in the nature of specific events especially in the area of education, culture, sports and entertainment; cultural & club services; educational and entertainment services; electronic publishing services; news shows (entertainment, namely, television); organisation of shows events; congress; symposiums and conferences; television programs and production; lottery services; conducting workshops and seminars; providing

facilities for recreational activities; publication of books and magazines.

It had been opposed on the basis of the word mark Artoz, protected in Germany, Spain, France, Italy, Austria, Portugal and the Benelux by an international registration, for *inter alia* the following services: Class 35: Advertising, divulging, renting and distribution of advertisements, of advertising material, of leaflets, prospectus, printed matter, samples: demonstration of goods, distribution of samples for advertising purposes, advertising by mail, document reproduction, publication of publicity texts, window displays, business, business management consultancy and necessary means for business organisation; marketing research, public relations. Class 41: Teaching, entertainment and education. The opposition had been allowed in full.

Patentconsult: T-335/07 – Office response filed (DE).

Keywords: Absolute grounds for refusal: distinctiveness.

The action is directed against a decision of the 4th Board of 25.6.2007 in R 0299/2007-4 relating to CTM application 4 439 774, Patentconsult (word mark), applied for for a range of services in Classes 35, 41 and 42. It had been refused on the grounds that the sign merely describes the services at issue.

Monkey Puzzle: T-303/07 – Office response filed (DE).

Keywords: Opposition: likelihood of confusion (LOC).

The action is directed against a decision of the 2nd Board of 5.6.2007 in R 0911/2006-2 relating to CTM application 3 674 561, Puzzle (word mark), applied for for a range of goods in Classes 16, 32 and 33. It had been opposed on the basis of “Monkey Puzzle”, a CTM registered in Class 33. The opposition had been partially allowed, namely as regards “alcoholic beverages” in the CTM application.

Faces: T-301/07 – Office response filed.

Keywords: Absolute grounds for refusal: descriptiveness.

The action is directed against a decision of the 2nd Board of 1.6 2007 in R 1532/2006-2 relating to international registration W 0 874 799, Faces (word mark), covering a range of goods in Class 10, *inter alia* technology for medical and aesthetic skin treatments. It had been rejected on the grounds that the sign would merely describe a sector of application of the goods at issue, namely facial treatment.



Q2Web/QWeb: T-242/07 – Office response filed (DE).

Keywords: Opposition/cancellation on earlier rights: likelihood of confusion (LOC) – LOC: comparison of goods on the one side and services on the other.

The action is directed against a decision of the 1st Board of 29.3.2007 in R 0893/2005-1 relating to CTM Q2WEB (word mark) registered in Classes 9, 35, 38 and 42. It had been challenged on the basis of a request for invalidation based, *inter alia*, on the earlier CTM QWEB (word mark), registered in Class 42, and on CTM QWEBMARK in Classes 35, 38 and 42. The invalidation request had been allowed for all goods and services in the challenged CTM.

Carport: T-351/07 – Office response filed (IT).

Keywords: Absolute grounds for refusal: 3D signs – 3D signs: shape of the good – 3D shape of the good: level of distinctiveness.

The action is directed against a decision of the 1st Board of 28.6.2007 in R 1653/2006-1 relating to CTM application 4 837 746, a 3D application, for a range of goods in Classes 6 and 19. It had been rejected on the grounds that the sign applied for does not consist of more than an ordinary shape for the goods at issue.



The core findings can be summarised as follows: where the sign applied for consists of the shape of the product itself, the shape must stand out from the average in order to be able to serve as a source indicator.

Cellutrim/Cellidrin: T-169/07 – Office response filed (DE).

Keywords: Opposition/cancellation on relative grounds: likelihood of confusion (LOC) – LOC: relevant public (pharmaceutical goods) – LOC: pharmaceutical products.

The action is directed against a decision of the 1st Board of 7.3.2007 in R 1123/2006-1 relating to CTM 3 979 036, Cellutrim (word mark), which had been registered for a range of goods in Class 5. A request for partial invalidation had been filed based on Cellidrin, a German mark, registered also in Class 5. The request had been successful, based mainly on the significant phonetical similarity of the marks in German.

Principe Alfonso: T-291/07 – Office response filed (ES).

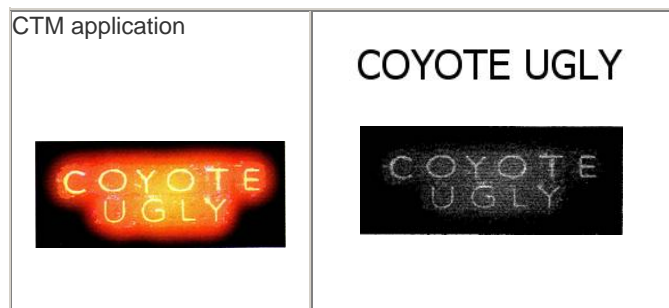
Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of marks – Comparison of marks: personal name.

The action is directed against a decision of the 2nd Board of 29.5.2007 in R 1110/2006-2 relating to CTM application 3 398 278, Alfonso (word mark), which had been applied for for a range of goods in Classes 30, 32 and 33. It had been opposed on the basis of two earlier rights in the word mark Principe Alfonso, a CTM and a Spanish mark, registered in Class 33. Whereas the Opposition Division had partially allowed the opposition, the Board had rejected it on the grounds that the marks at issue are not similar in a trade mark related sense. Alfonso is a common first name; the title Principe, thus, would suffice to distinguish the two marks from each other.

Coyote Ugly: T-161/07 – Office response filed (ES).

Keywords: Opposition: earlier rights – Earlier right: well-known within Article 6bis Paris Convention. – Earlier right: acquired by use in the course of trade – Opposition: likelihood of confusion (LOC) – LOC: comparison of goods.

The action is directed against a decision of the 2nd Board of 2.3.2007 in R 0165/2006-2 and R 0194/2006-2 relating to CTM application 2 428 795, Coyote Ugly (figurative mark, in colour). It had been applied for for a range of goods and services in Classes 9, 41 and 42.



It had been opposed on the basis of various earlier rights, amongst which a CTM, Coyote Ugly (word mark), registered in Classes 14, 16, 21, 25, 32 and 34. Further, the opponent had invoked signs used in the course of trade, allegedly well known, which are identical with the CTM application, except for the colours. The opposition had been partially allowed.

Airshower: T-307/07 – Office response filed (DE).

Keywords: Absolute grounds for refusal: descriptiveness.

The action is directed against a decision of the 1st Board of 31.5.2007 in R 1281/2006-1 relating to CTM 4 869 319, Airshower (word mark), applied for for a range of goods in Class 11, mainly shower systems and parts thereof. It had been rejected on the grounds that the sign merely describes

the specific functioning of the products, namely mixing water with air.

PharmaCheck: T-296/07 – Office response filed (DE).

Keywords: Absolute grounds for refusal: descriptiveness.

The action is directed against a decision of the 4th Board of 5.6.2007 in R 0358/2007-4 relating to CTM 5 310 214, PharmaCheck (word mark), which had been applied for for a range of goods in Class 9. It had been refused on the grounds that the sign merely describes the intended purpose of the goods at issue.

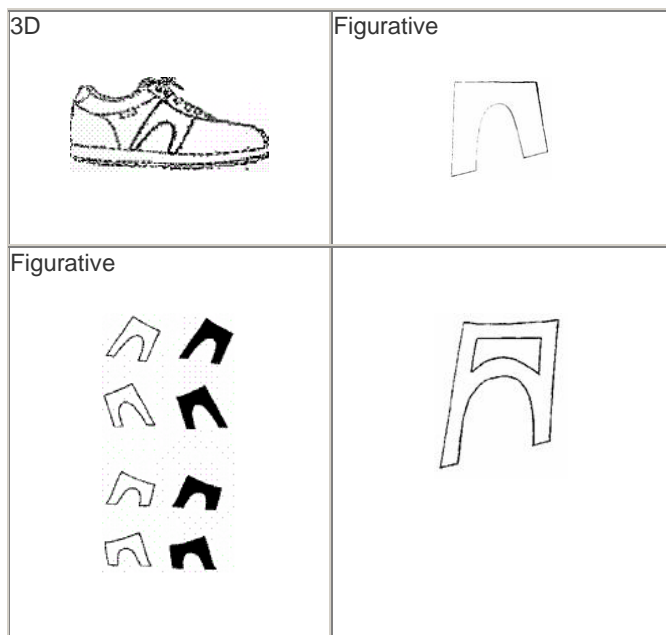
Arc Noir or Black Arch: T-304/07 – Office response filed (IT).

Keywords: Opposition: Likelihood of confusion (LOC) – LOC: comparison of goods.

The action is directed against a decision of the 1st Board of 14.6.2007 in R 0768/2006-1 relating to CTM application 3 388 097 which had been applied for for a range of goods in Class 18, *inter alia*, for leatherwear. The sign applied for is shown below.



It had been opposed on the basis of several rights registered in Classes 18 and 25.



Whereas the Opposition Division had rejected the opposition on the grounds that the goods at issue are dissimilar enough to exclude LOC, the Board had held differently and had allowed the opposition in full.

Torres de Anguiz/Torres: T-2865/07 – Office response filed (ES).

Keywords: Opposition: earlier right with reputation – Opposition: likelihood of confusion (LOC) – LOC: comparison of marks.

The action is directed against a decision of the 2nd Board of 2.5.2007 in R 0707/2006-2 relating to CTM application 3 283 652, Torres de Anguiz (figurative mark), which had been applied for for wine and certain services in Classes 33, 35 and 39.



It had been opposed on the basis of several earlier rights in the word Torres, registered for wines etc. in Class 33. The opposition had been dismissed on the grounds that there is no relevant similarity between the marks. Whereas the Opposition Division had allowed the opposition, the Board disagreed on the grounds that there were no relevant similarities between the marks.

Torregazate/Torres: T-273/07 – Office response filed (ES).

Keywords: Opposition: earlier right with reputation – Opposition: likelihood of confusion (LOC) – LOC: comparison of marks.

The action is directed against a decision of the 2nd Board of 2.5.2007 in R 0610/2006-2 relating to CTM application 3 134 665, Torregazate (word mark), applied for for certain alcoholic beverages including wine in Class 33. It had been opposed on the basis of several earlier rights in the word Torres, registered for wines etc. in Class 33. The opposition had been dismissed on the grounds that there is no relevant similarity between the marks.

Intelligent Voltage Guard: T-297/07 – Office response filed (DE).

Keywords: International registration (IR) – IR: extension to the Community – Absolute grounds for refusal: distinctiveness.



The action is directed against a decision of the 2nd Board of 31.5.2007 in R 0108/2007-2 relating to international registration W 00 874 778 which covers a range of goods in Classes 9 and 11.



It had been rejected on the grounds of lack of distinctiveness in relation to the claimed goods. The sign would simply convey the meaning of "a system or device that operates with a high degree of sophistication and independence, in a manner regarded as comparable to human intelligence". The figurative element would solely represent an ordinary voltage meter.

Vitro/Vitral: T-295/07 – Office response filed (ES).

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

The action is directed against a decision of the 2nd Board of 31.5.2007 in R 1640/2006-2 relating to CTM application 2 669 497, Vitro (figurative mark), which had been applied for in Classes 1, 7, 8, 9, 12, 16, 17, 19, 20, 21, 22, 27, 30, 35, 39, 40, 41, 42 and 43.

CTM application	
Vitro	VITRAL

It had been partially opposed on the basis of several earlier rights in Vitral (word mark) registered for a range of goods in Class 19. The opposition had been allowed.

Coco Rico: T-126/07 – Office response filed.

Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of goods – LOC: envisaged use to be considered?

The action is directed against a decision of the 2nd Board of 16.2.2007 in R 1047/2006-2 relating to CTM application 2 949

899, Coco Rico (word mark). It had been applied for for chocolate bars produced from organic food in Class 30.

CTM application	
Coco Rico	KOKORIKO

It had been opposed on the basis of several earlier rights in KOKORIKO (word marks as well as figurative marks) registered for a range of goods in the same area. The Spanish office had already rejected national applications, by the present CTM applicant, on the basis of the same earlier rights. In consequence, the CTM applicant restricted its claim to the niche market as set out above. Notwithstanding this, the opposition had been allowed.

The reasoning of the Board had been the following: (a) Considerations about the actual or current use of the earlier marks are not to be taken into account; (b) Furthermore, the product 'confectionery' protected by the earlier right does not exclude confectionery made of organic food and sold through health food shops, which confirms the contested decision's conclusion that the products identified by the conflicting signs are identical; (c) The applicant's comments about its efforts to reach an agreement with the opponent are not pertinent; (d) As regards the CTM applicant's argument that it is the owner of German trade mark No. 39 511 801.8 for the word mark 'Coco Rico' for chocolate bars in Class 30, registered on 30 August 1995, several years before either of the opponent's CTMs were registered, and its claim that the opponent's reliance upon its two earlier rights is an abuse of process, the Board considered that the opponent is just exercising its right to file an opposition against a CTM application, based on its two earlier CTMs. This cannot be qualified as an abuse of process. If, as it appears, the applicant could have filed an opposition in due time against the opponent's rights, but failed to do so, that is a matter entirely for that party. In any case, Articles 50 and 52 CTMR offer the applicant other means to defend its earlier right; and (e) Given that the applicant has not contested the evaluation of the likelihood of confusion made by the Opposition Division, the Board found it sufficient to expressly refer to that decision in order to avoid unnecessary repetitions.

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

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Ex-parte – Articles 4 and 7(1)(a) CTMR

Examination proceedings – graphical representation – tactile mark – filing date

Decision of the First Board of Appeal of 30 October 2007 in Case R 1174/2006-1 (German)



R 1174/2006-1 (part of motor vehicle) – (de) – tactile trade marks can be represented graphically if the representation and/or description fulfil the relevant criteria. This was not the case here, since important elements which determine the tactile impression of the surface of the object that was represented by a picture and a description, remained unknown. A sample was not accepted as a graphical representation. The Board did not accord a filing date under Articles 27 and 26 CTMR, and also stated that Articles 7 and 4 CTMR were not fulfilled either. The appeal was dismissed.

Ex-parte – Article 7(1)(b) and (c) CTMR

Examination proceedings – distinctive character – descriptive character

Decision of the First Board of Appeal of 4 December 2007 in Case R 786/2007-1 – Werksclub (German)

R 0786/2007-1 – Werksclub – it is common that undertakings have their own sports clubs. The sign in question describes, in German, such a sports club. The application was made for goods and services offered by a football club. In accordance with the ECJ 'Chiemsee' judgment (Case C-108/97 & C-109/97), the public interest requires that geographical names in particular remain free from registration, since they may influence consumer tastes in various ways, for instance, by creating a favourable association between the goods and a certain place. The Board applied this principle in the present case since the goods are likely to help to build up a special relationship between the supporters and the club. Since the sign was descriptive, it also lacked distinctive character. The CTM application was rejected.

Inter-partes – Articles 8(1)(b), 8(4) and 8(5) CTMR

Opposition proceedings – relative grounds for refusal – likelihood of confusion – common element – weak element – visual dissimilarity – phonetic dissimilarity – conceptual dissimilarity – reputation – failure to provide evidence – use by third party – passing off – non registered trade mark – proof of use – press articles - use not as registered – affidavit – invoice - label

Decision of the First Board of Appeal of 9 October 2007 in Case R 486/2006-1 (English)

R 0486/2006-1 ASTON MARTIN HERITAGE / HERITAGE – (en) – the Board came to the conclusion that the use requirement had been fulfilled in relation to vehicle parts and fittings, covered by the opponent's trade mark registrations HERITAGE in the United Kingdom (No 1 119 854 and No 1 443 279), but had not been fulfilled in relation to the other goods and services covered by the earlier marks on which the opposition is based (such as 'motoring films and videos; all included in Class 9'; 'printed matter, photographs, pictures, manuals, decals, calendars and post cards; all relating to motor vehicles or motoring; all included in Class 16' etc). As far as the opposition was based on other trade marks in the UK and other countries, it was rejected because use of these had not been documented. Merely mentioning the existence of 'HERITAGE specialists' could not be considered as fulfilling the use requirement. Thus, the evidence regarding use in other countries, including for Class 12, was deemed by the Board to be insufficient.

Comparing the signs, the first two words in the mark applied for are distinctive words, with no corresponding element in the earlier mark. Based on this difference in the beginning of the marks and on the evidence of the extensive use of ASTON MARTIN, the Board held that the public will not find the marks visually similar. It stated that it must be expected that phonetically the relevant public will also perceive the difference between the marks. Consequently, the marks only have a low aural similarity. Conceptually, the Board held that the mark applied for will be perceived by the relevant public as a combined mark which refers to the tradition of ASTON MARTIN, and therefore that not much weight can be put on the common element HERITAGE. In the light of the weakness of the word HERITAGE, it was held that the similarity between the marks based on this common element is outweighed by the differences especially visually and orally between the two



marks. Thus, the Board concluded that even in respect of identical goods – parts and fittings – there is no likelihood of confusion.

In relation to Article 8(4) CTMR the opponent had also claimed that its trade mark 'HERITAGE' had been shown to enjoy a reputation and hence goodwill in respect of the goods in Class 12 in its earlier British registrations, and it had alleged passing off. Taking the extensive use of the word HERITAGE by third parties in the field of vehicles into consideration as well as the intrinsic weakness of the earlier trade mark in relation to the goods in question here, the Board did not agree that the use of the mark applied for with its combination of different elements would be seen as a misrepresentation by the applicant, leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponent. The Board came to the same conclusion in relation to Article 8(5) CTMR, and, taking the same factors into account, did not agree that that the use of the mark applied for with its combination of different elements would take unfair advantage of, or be detrimental to, the distinctive character or the claimed repute of the earlier trade mark. The requirements for the application of Article 8(5) CTMR had not been fulfilled. The appeal was allowed and the contested decision was annulled (see also in **Decision of the First Board of Appeal of 9 October 2007** in

Case R 485/2006-1 (English) R 0485/2006-1 (HERITAGE ASTON MARTIN) / HERITAGE)



Inter-partes – Articles 8(1)(b) and (5) CTMR

Opposition proceedings – likelihood of confusion – dilution

Decision of the First Board of Appeal of 8 November 2007 in Case R 198/2007-1 (English)

R 0198/2007-1 - TTT/TTT – one precondition for likelihood of confusion is that the goods and services in question are similar at least to some extent; consequently, no likelihood of confusion can exist if the goods and services are considered dissimilar. In such a case, the opponent can invoke Article 8(5) CTMR. However, it has to be explained how the CTM applied for could damage the distinctive character or the reputation of the earlier mark. Since the opponent did not submit any arguments as to why or how use of the applicant's sign would damage the distinctive character or reputation of its mark, that claim was rejected as unfounded. The opposition was therefore rejected.

Inter-partes – Article 8(4) CTMR

Opposition proceedings – relative grounds for refusal – likelihood of confusion – non-registered trade mark – national law – failure to provide evidence – bad faith

Decision of the Fourth Board of Appeal of 5 November 2007 in Case R 1446/2006-4 (English)

R 1446/2006-4 RM2000T / RM2000T – (en) – the grounds for opposition were Article 8(4) CTMR. The sole earlier right invoked in this opposition was an earlier Belgian unregistered trade mark. The opponent at no time during the opposition procedure indicated a legal basis for this claim nor did it give any other evidence regarding the protection of unregistered trade marks in the Member State concerned. Rather, it indicated throughout the opposition proceedings that the applicant had breached a contractual agreement and had acted in bad faith. The Board held that neither of these allegations is a ground for opposition. The opponent did not invoke a trade name or Article 8(3) CTMR. Bad faith as such does not constitute a ground for opposition but only an absolute ground for declaration of invalidity under Article 51(1) (b) CTMR. Unregistered trade marks under Belgian law do not exist. Trade mark protection in Belgium may only be acquired through a registered Benelux trade mark or by a CTM. The exclusive right of a trade mark is thus acquired there by registration alone. The opposition was rejected as unfounded without a need to assess the ample evidence filed by the parties. The appeal was unsuccessful.

Opposition Proceedings – sign used in trade – use of more than mere local significance

Decision of the Second Board of Appeal of 22 November 2007 in Case R 201/2007-2 (English)



R 0201/2007-2 – (ORACLE of the soil) /ORACLE – Guidance can be drawn from the European case-law on the requirement of genuine use contained in Article 43(2) CTMR in order to interpret 'use of more than local significance', bearing in mind that, although minimal use can be sufficient to be deemed genuine use of an earlier *registered* mark, such minimal use is unlikely to be considered sufficient to create a right which is not registered and which is completely founded on use. No such use was shown in this case, and the opposition was therefore rejected.

Procedural issues

Opposition proceedings – assessment – likelihood of confusion – comparison of goods and services – interdependence principle – substantial procedural violation – reimbursement

Decision of the First Board of Appeal of 26 September 2007 in Case R 587/2006-1 (English)



R 0587/2006-1 FEV (FEV) / FEV (FEV) et al. – (en) – the applicant requested proof of use of the earlier



marks. The opponent submitted some documents as evidence of use. The Opposition Division considered that as the goods and services were dissimilar the opposition must fail, regardless of the similarity between the signs and irrespective of the degree of reputation the earlier marks may enjoy. As a consequence of this, the Opposition Division found it unnecessary to consider the evidence of proof of use that the opponent had supplied in this regard. The Board decided that in order to rule out a likelihood of confusion solely on the basis of the comparison of the contested goods and services, these must be clearly dissimilar. In the case at hand, there was at least a high degree of similarity between some of the opponent's goods and the applicant's screws and bolts. The Board found it necessary in this case to continue with an examination of the signs, while also taking into account their inherent and enhanced distinctiveness. The Board stated that the Opposition Division had been incorrect not only in disregarding the examination of proof of use, but also in not analyzing the signs concerned, thereby failing to appreciate the criterion of the interdependence between the various relevant factors. The appeal was allowed, the contested decision annulled and the appeal fee reimbursed.

Opposition proceedings – admissibility – formal requirement – grounds of opposition – interpretation

Decision of the First Board of Appeal of 17 October 2007 in Case R 160/2007-1 (German)

R 0160/2007-1 QUART / Quarto – (de) – in this case, the Board recalled that any opposition must be first interpreted before it is rejected because of formalities. The Boards have already decided on a number of occasions in cases in which the opponent did not furnish information on the grounds of opposition in all the relevant fields provided on the official forms. In this regard, the Boards of Appeal have always emphasised that the interpretation of the opposition depends on the specific circumstances of the individual case. In the present case, it was the view of the Board that the opposition ground of likelihood of confusion with the earlier German trade mark within the meaning of Article 8(1)(b) CTMR was sufficiently clear from the information provided in the opposition within the meaning of Article 42(3) CTMR in conjunction with Rule 15(2) CTMIR. Since the opponent based its case on a national trade mark registration (Quarto), which was described in greater detail and which is obviously not identical to the trade mark applied for (QUART), the grounds of opposition of identical trade marks (Article 8(1)(a) CTMR) and non-registered trade marks or other signs (Article 8(4) CTMR) were excluded from the outset. The Board held that as a result the opposition could not reasonably have been interpreted to mean anything other than that it is based on likelihood of confusion. This accorded with the opponent's response to the invitation by the Opposition Division to submit observations on the inadmissibility of the opposition. The Board held that the opposition was admissible in this respect, and that the contested decision must be annulled and the case remitted to the Opposition Division.


Opposition proceedings – request of proof of use



Decision of the Second Board of Appeal of 5 November 2007 in Case R 238/2007-2 (French)

R 0238/2007-2 INTERHOME / INTERHOME – (fr) – contrary to the apparent reasoning of the contested decision, the Board held that neither Article 43 CTMR nor Rule 22 CTMIR oblige the applicant to use specific terminology ('I request', 'I require') in order to request proof of use of the earlier trade mark. It noted that there are several ways to ask someone to do something, for example, by using a verb which expresses a request in the first person (I ask, I demand, I require, I apply, I solicit, I invite, etc.), or by using a verb that expresses an obligation or an invitation in the third person (the person in question must, should, is under obligation to, it is his responsibility to, it is his duty to, is invited to, is required to, etc.) and the same can also be demanded by using a double negation (cannot abstain from, cannot avoid, etc.). The Office should not have limited itself to a mere 'automatic reading' (i.e. by a 'key word' search) of one isolated phrase, but should rather have examined all of the statements and requests of the applicant as a whole. Where, in view of the express statements of the applicant, there can be no reasonable doubt that the applicant positively and unambiguously requests the proof of use of the earlier mark, pursuant to Article 43 CTMR, the Opposition Division cannot refrain from inviting the opposing party to provide such proof, in accordance with Rule 22 CTMIR, merely because the applicant did not use a specific term, such as 'I request', 'I solicit', etc., to formulate its request. The Board allowed the appeal, annulled the contested decision and remitted the case to the Opposition Division for further prosecution.

Opposition Proceedings – proof of use – sign used which differs from that registered

Decision of the Second Board of Appeal of 12 November 2007 in Case R 482/2007-2 (English)

R 0482/2007-2 – PIK'OIUC/  (Pickwick COLOUR GROUP) – Article 15 CTMR allows the use of a sign which differs from that registered if the distinctive character is not altered. In the case at stake, the Board held that the use of

neither the sign  nor  altered the sign as registered since the figurative element (the boy) remained unchanged. The earlier trade mark was used for (children's) clothing. Such clothing are identical to clothing in general and highly similar to 'footwear' and 'headgear'. The signs were held to be visually similar, since the figurative element would be considered as a decorative feature. The signs were aurally similar. Consequently, it was held that a likelihood of confusion exists.



Design cases

Invalidity design proceedings – individual character – publication – designer freedom – overall impression – specialised circles – relevant territory

Decision of the Third Board of Appeal of 9 November 2007 in Case R 103/2007-3 (Spanish)



R 0103/2007-3 (bottle) / (bottle) – (es) – in this case, the Board held that the appeal was unfounded because the contested design lacked individual character as it did not produce a different overall impression on the informed user from that produced by the earlier US design. This design was registered as a design patent under US law. The significance of Article 7 CDR is that publication, even outside the Community, has the consequence, as a general rule, that the design can be considered to have been divulged; however, that consequence does not arise where it is shown that it was not reasonable that specialised circles operating within the Community could have become aware of the publication.

In the present case, the Board held that it was reasonable to consider that specialised circles operating within the Community had become aware of the publication of the US design. The general impression was produced by the physical appearance of the product that the technical drawing is meant to represent, not the one produced by the drawing (informed users see products, not drawings). In the Board's view, the Community design produced the same overall impression on the informed user as the earlier US design. Both designs represented a container which is stood upside down – i.e. on the lid – and were produced in an almost identical manner. In respect of designer freedom, the Board considered that there is a certain degree of freedom even when designing containers of this type – i.e. bottles which stand upside down. The shape does not necessarily have to be conical or cylindrical, the rectangular section at the bottom of the container may have a different thickness, etc. The degree of freedom of the designer should be deemed to be limited by functional constraints, not by existing earlier rights. The appeal was dismissed.

Invalidity design proceedings – novelty – individual character – divulgation

Decision of the Third Board of Appeal of 22 October 2007 in Case R 1401/2006-3 (Spanish)

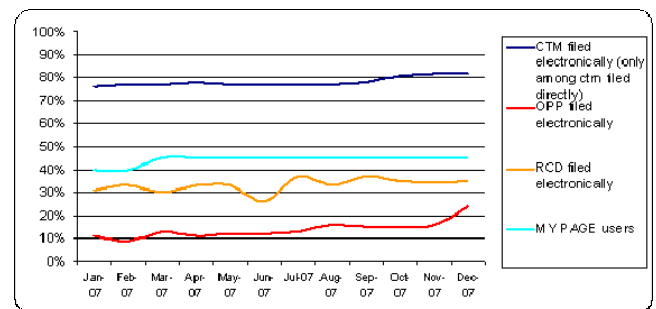
R 1401/2006-3 (ornamentación) – according to Article 5 CDR, a design must have novelty. A catalogue, provided it has all the trappings of a 'real catalogue' (not a draft or a proof), is *prima facie* evidence of divulgation. Divulgation destroys novelty. The RCD was declared invalid (see also R 1405/2006-3, R 1406/2006-3, R 1410/2006-3 and R 1411/2006-3).

E-business at OHIM

OHIM e-business roundup (2007)

Statistical summary

- The use of the CTM e-filing web form has increased above 80%.
- The use of RCD e-filing is around 35%
- More than 20% of oppositions against CTM applications are received electronically.
- MYPAGE users represent around 45% of CTM Applications filed.



State of play of future projects

Service - New version of e-Communication:

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

Status - OHIM has started the testing phase

Service - New version of CTM E-filing:

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

Status - OHIM has started the development phase

Service - New version of electronic filing of RCD applications

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

Status - Development phase is about to start.

CTM watch:

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

Status - OHIM has started the development phase.

**Service - Online handling of opposition procedures:**

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

Status - OHIM has completed the requirements.

More News**Chinese cooperation trip**

A delegation from OHIM has taken part in a fact-finding trip to China, as part of the Office's participation in IPR 2, the EU-China cooperation project to help improve the effectiveness of intellectual property rights in China.

The IPR 2 project, which is costing €16m over a four-year-period, is being jointly funded by the EC and the Chinese, with two-thirds coming from the European partners. OHIM is participating in the team in charge of the implementation of the project, which is being managed by the European Patent Office in Munich.

OHIM, which has already built up a good relationship with the Chinese trade mark and design bodies through various bilateral activities, will be contributing expertise in a number of areas including: helping to improve the Chinese legal framework in trade marks and designs; capacity building to enhance the performance of the IP Registration Offices; and supporting China's efforts to build up efficient internal and inter-agency systems and procedures for the effective protection of trade marks and designs.

Director of OHIM's General Affairs and External Relations Department João Miranda de Sousa, who led the OHIM delegation, says the trip put in place some important groundwork. "It is absolutely necessary to reach a perfect understanding of the needs of the Chinese institutions who will be the beneficiaries of IPR 2. They are keen to cooperate and treated us as colleagues who, having faced similar problems in the past, were well placed to offer help, advice and even inspiration."

Monthly statistical highlights December 2007

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

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